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Intellectual Property License Contracts: Reflections on a Prospective UNCITRAL Project

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INTELLECTUAL PROPERTY LICENSE CONTRACTS: REFLECTIONS ON A PROSPECTIVE UNCITRAL PROJECT

Andrea Tosato*

Abstract
IP licenses are the leading lady of the information age. The economic and strategic significance of this contract archetype have grown exponentially over the past 40 years. Under this glaring spotlight, it has become increasingly apparent that the legal framework governing these voluntary exchanges is not supportive of the role they play in the modern digital environment. At the domestic level, the applicable rules are often lacunose and suffer from doctrinal underdevelopment; moreover, they are scattered throughout diverse areas of the law, yielding legal uncertainty and rendering a holistic appraisal onerous. Internationally, a comparative analysis of IP licensing regimes reveals a jarring lack of alignment across jurisdictions that severely hinders cross-border transactions. For over a decade, the United Nations Commission on International Trade Law (“UNCITRAL”) has been contemplating the possibility of a project to promote the modernization and harmonization of IP licensing law. During this time, UNCITRAL Member States have continued to grapple with lingering reservations, yet support has grown steadily among practitioners and academics, and is verging on achieving critical mass. This paper provides the theoretical infrastructure for such a project by expounding its possible scope, content and form. The objective of the present enquiry is not

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to articulate or advocate a single, concrete proposal. Rather, its aim is to identify the policy choices and legal issues that UNCITRAL Member States would face in the elaboration of this project, and coextensively lend color to the decision-making processes that would be required to attain consensus solutions.

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INTRODUCTION

The sale of goods contract archetype has played a cardinal socio-economic role since the adoption of currency.¹ Throughout history, this prominence has prompted numerous legal systems to develop bespoke rules for such transactions, supplemental to general contract law.² Their

¹ For an analysis of the impact of currency on both private bargains and the broader economy in ancient civilizations, including Mesopotamia under the Code of Hammurabi (2123-2081 BCE), and ancient Egypt see PAUL EINZIG, PRIMITIVE MONEY (1949). For a rich analysis also considering religious ancient sources see Benjamin Geva, From Commodity to Currency in Ancient History—On Commerce, Tyranny, and the Modern Law of Money, 25 OSERODE HALL L. J. 115 (1987).

² On the development of the law of sales throughout history see generally JAMES MACKINTOSH, ROMAN LAW OF SALE (1892) (on the history and development of Roman law of sale); JOHN BARON MOYLE, THE CONTRACT OF SALE IN THE CIVIL LAW (1892) (for a rich comparative analysis between Roman law and 19th century English law); Alan Rodger, The Codification of Commercial Law in Victorian Britain, 108 L. Q. REV. 570, 574 (1992) (charting the history of the English commercial law codifications of the 18th century); Mary Arden, Time for an English Commercial Code, 56 CAMB. L.J.
purpose is to address the issues germane to these voluntary exchanges, enhance legal certainty and ultimately facilitate dealings between sellers and buyers. From a comparative perspective, national laws governing sales have become increasingly aligned over the course of time. Concurrently, intergovernmental initiatives have progressively crafted a legal framework for international sale contracts, culminating in the United Nations Convention on Contracts for the International Sale of Goods (Vienna, 1980) (“CISG”).

In the information age, intellectual property (“IP”) licenses have become ubiquitous and their economic significance has burgeoned. Digital technologies have disrupted numerous commercial sectors and

516, 518–22 (1997) (reflecting on the possibility of a modern codification of English commercial law); ROBERT JOSEPH POTHIER, TREATISE ON THE CONTRACT OF SALE (Luther S. Cushing tran., 1839) (on the birth and development of the French law of sale); Ernst Freund, The New German Civil Code, HARV. LAW REV. 627 (1990) (discussing the history of commercial and civil law in Germany); REINHARD ZIMMERMANN, THE NEW GERMAN LAW OF OBLIGATIONS, HISTORICAL AND COMPARATIVE PERSPECTIVES (2006) (analysing the most recent developments in German commercial law); BASIL S. MARKESINIS ET AL., THE GERMAN LAW OF CONTRACT: A COMPARATIVE TREATISE (2006) (comparing German civil and commercial law to the common law).


enabled new business models that depend on IP license agreements rather than sale of goods contracts. As the world advances towards an ever more digital future, such trends will only amplify and proliferate. This forecast is further supported by recent attempts to commoditize non-exclusive license contracts and publicly trade them on regulated exchanges.

At the domestic level, the regime governing IP licenses typically stems from the intersections between multiple legal streams, including contract law, IP law, labor law, competition law, and consumer law. Notably, the

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applicable rules and principles are difficult to appraise holistically, as they are scattered throughout diverse areas of the law. Identifying precisely all the tesserae of this mosaic, deciphering the order in which they come together, and comprehending the picture that they create can be extremely challenging. As a result, the prevailing view is that the resulting normative framework is fettered by substantive lacunae and suffers from doctrinal underdevelopment.\(^\text{10}\)

A comparative analysis of the national regimes for IP licenses reveals marked divergences. Across jurisdictions, there is a jarring lack of alignment of both the relevant branches of the law and the manners in which they intersect.\(^\text{11}\) Moreover, while multiple international projects have harmonized the foundational tenets of national legislations regulating the most prominent IP rights archetypes,\(^\text{12}\) similar initiatives

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\(^{11}\) See generally de Werra, supra note 8; Michael Anthony C. Dizon, The symbiotic relationship between global contracts and the international IP regime, 4 J. INTELL. PROP. L. PRAC. 559, 564 (2009).

devoted to the law governing contractual dealings involving IP rights and license agreements have borne meagre fruit.\textsuperscript{13}

Legal practitioners, academics, non-governmental entities, and international organizations alike have long mooted ameliorations to the legal framework governing IP licenses, both nationally and internationally.\textsuperscript{14} In some jurisdictions, this has led to government-commissioned reviews, which have scrutinized the extant body of rules and recommended legislative interventions.\textsuperscript{15} Among international organizations, the United Nations Commission on International Trade Laws (“UNCITRAL”)\textsuperscript{16} has cautiously yet persistently expressed interest in a future work addressing the legal framework of IP license contracts.\textsuperscript{17}

\textsuperscript{13} For one of the few examples of intergovernmental initiatives focused on licensing law see the WIPO SUCCESSFUL TECHNOLOGY LICENSING GUIDE (http://www.wipo.int/edocs/pubdocs/en/licensing/903/wipo_pub_903.pdf).


\textsuperscript{15} For example, in the United Kingdom see ANDREW GOWERS, GOWERS REVIEW OF INTELLECTUAL PROPERTY (2006); IAN HARGREAVES, DIGITAL OPPORTUNITY: A REVIEW OF INTELLECTUAL PROPERTY AND GROWTH: AN INDEPENDENT REPORT (2011), http://dera.ioe.ac.uk/16295/7/ipreview-finalreport_Redacted.pdf (last visited Sep. 7, 2017). The British Government broadly accepted these recommendations, yet has been slow in implementing them (see http://www.ipo.gov.uk/ipresponse-full.pdf).


\textsuperscript{17} At the time of its foundation, UNCITRAL identified nine subject matters for its future endeavors, including Intellectual Property; see U.N. GAOR, 23rd Sess., at ¶ 40 and 48, supp. 16 A/7216 (1968). Future work on the legal framework of IP licenses at both national and international level has been under consideration at UNCITRAL for some time: see U.N. Comm’n on Int’l Trade L., UNCITRAL Report of Working Group VI (Security Interests) on Its Fourteenth Session Comm’n Doc. A/CN.9/667, at ¶ 141; U.N. Comm’n on Int’l Trade L.,141; Report of Working Group VI (Security Interests) on Its Fifteenth Session Comm’n Doc. A/CN.9/670, at ¶ 123-26: “With respect to a contractual guide on intellectual property licensing, it was observed that it would be an extremely important project, which
Despite this, none of the UNCITRAL Member States ("Member States") have yet explicitly championed such an initiative nor shown willingness to submit an official proposal for the consideration of the UNCITRAL Commission.  

At the UNCITRAL Fourth Colloquium on Secured Transactions, panelists discussed the topic of "IP licensing" examining the problems afflicting the law regulating these agreements in many jurisdictions and focusing on the oft-fraught dialogue between contract and IP law. This was followed by a debate on a hypothetical UNCITRAL project on the law of voluntary IP licenses ("Project"), which would be aimed at fostering improvements to national legal regimes and stimulating international harmonization. This paper aspires to advance the aforementioned discourse.

It would be entirely premature to formulate a complete and detailed proposal for the Project at this stage. This paper instead ventures to examine methodically three salient points that are logical prerequisites to crafting a conscientiously-formed proposal. First, attention will be devoted to the potential scope of the Project. Secondly, a comparative analysis of the substantive rules governing IP license contracts will be conducted, for the dual purpose of providing representative examples of the types of legal conundrums that Member States would have to tackle at the heart of the Project and expounding the decision-making processes required to conceive "consensus" solutions. Thirdly, an assessment will be performed of the possible, alternative forms that the Project could assume and their associated ramifications. Lastly, concluding observations will recommend a strategy for the advancement of the Project to its next phase.

18. For an examples of recent Member State proposals see Proposal by Switzerland on possible future work by UNCITRAL in the area of international contract law Comm’n Doc. A/CN.9/758; Proposal by the Government of the United States regarding UNCITRAL future work Comm’n Doc. A/CN.9/789.


20. The panelists were Jeff Dodd (Chair), Lorin Brennan, Thilo Agthe and Andrea Tosato. All materials are available at http://www.uncitral.org/uncitral/en/commission/colloquia/colloquia_security.html.

I. THE SCOPE OF THE PROJECT

As a logical antecedent to any foray into matters of substance, Member States would be required to define the scope of the Project. As IP license contracts are a vast and diverse archetype, this determination would be demanding. It is submitted that a scrupulous decision-making process would involve an assessment of two distinct legal dimensions.

First, IP licenses impact a sweeping range of socio-economic interests, giving rise to legal issues that differ in nature and are governed by rules stemming from diverse areas of the law. Structurally, IP licenses are binding promises between persons; they generate private law questions that are answered by contract law. Functionally, they are dealings for the purpose of exploiting IP rights; they engender issues that are proprietary in nature and fall within the realm of IP law. Concurrently, IP licenses can also attract the attention of competition law, labor law, consumer protection law and international private law, depending on the content of the undertakings stipulated by the parties.

In approaching this dimension, it would be for Member States to decide whether the Project should engage with all these branches of the law or rather concentrate on a narrower selection. At first glance, it might appear unproblematic to exclude delimited areas a priori, such as consumer protection or unfair competition. A more rigorous analysis, however, reveals that compartmentalizing IP license contracts is conceptually Gordian, as issues pertaining to discrete branches of the law can be closely intertwined and difficult to resolve in isolation. This would be especially true with regard to contract law and IP law, as license agreements are often characterized by a coalescence of obligatory and proprietary profiles, owing to the nature and function of these transactions.

Secondly, IP licenses cannot be described as a homogeneous category. These contracts all share a functional core: the licensor grants to the licensee a form of permission to perform actions that would otherwise be an infringement of the licensed IP. Nevertheless, the rights and obligations of the parties vary markedly depending on multifarious elements. The nature and quantity of the licensed IP rights, the breadth and limitations of the grant, the compensation structure, and the legal status of the parties, can all profoundly affect the respective legal spheres of the licensor and licensee.

In approaching this second dimension, it would be for Member States to deliberate whether the Project should encompass all license agreements.

22 This common functional core is recognized ubiquitously; Guibault and Hugenholz, supra note 9 (for a European law perspective) 3.2.2; NIMMER & DODD, supra note 8, at § 1:2 (for United States perspective); Xue, supra note 9 (for a Chinese law perspective); Krishnamurthy, supra note 9 (for an Indian law perspective); in Japanese law Teramoto, supra note 9.
without exception, or rather delve into a sub-group of this category. In the former case, the Project would seek to articulate a ruleset that concentrates on the functional core of IP licenses, yet eschew delving into the singularities of the many existing incarnations of these contracts. Its emphasis would be on pinpointing problems and elaborating solutions that apply to all types of IP licenses uniformly. Coextensively, caution would be required to ensure that unintended consequences were not inflicted on the regime of any one type of license agreement.

Alternatively, if Member States decided that the scope of the Project should be confined to licenses with particular attributes, the objective would be to conduct an exhaustive study into the designated subject matter. For example, Member States might elect to focus exclusively on licenses that involve a certain type of IP – such as copyrights, patents or trademarks – are international in nature, are entered into by legal persons, or have a specific commercial structure. The notable advantage of limiting the categories of licenses encompassed by the Project is that it would mitigate the risk of unintended consequences arising from the broad-brush strokes required when addressing all these transactions as a unitary subject matter. Nevertheless, it would be challenging to identify a sub-group of licenses characterized by socio-legal singularities sufficient to merit its own set of rules and the associated systemic fragmentation cost.

Thus, the determination of the scope of the Project would present Member States with a vast spectrum of options. At one extreme, a wide remit embracing all license types and the totality of legal issues that they elicit, regardless of the area of the law to which they pertain. At the other, a narrow scope, comprising only licenses with very peculiar attributes and only tackling profiles that relate to one branch of the law. This would be a cardinal policy choice with far-reaching ramifications, as will be shown in subsequent paragraphs devoted to substantive rules.

II. THE SUBSTANCE OF THE PROJECT

It would be beyond the editorial limits of this contribution to explore exhaustively all facets of the body of rules governing IP license agreements that the Project may investigate.

Attention will be directed, however, to seven problematic areas that possess doctrinal complexity, carry commercial relevance and are indicative of the conceptual challenges faced by Member States. For each area, this paper will conduct a tripartite analysis: first, describing briefly the current state of the law across jurisdictions; secondly, scrutinizing the substance of these rules and appraising the degree of international dissonance; thirdly, theorizing the methodological approaches that Member States might adopt to confront these issues and, to a lesser extent,
the type of substantive solutions they might consider.

A. Licensing of jointly-owned IP rights

It is uniformly accepted that rights-holders can license their IP. However, the legal regime for the licensing of jointly-owned rights varies markedly across jurisdictions. From a systemic perspective, most states provide special IP rules to regulate the licensing of jointly-owned IP rights; however, in some, this matter is subject to general property law. In similar vein, these rules are typically derogable in nature, yet there are exceptions. With regard to substance, most jurisdictions lack a unitary approach, adopting heterogeneous regimes for jointly-owned copyright, patents, trademarks and design rights. In some, licenses can be granted by one co-owner, absent the consent or knowledge of the other joint-owners. In others, the consent of all co-owners is a validity

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23. IP licensing has ancient roots, dating back to the Venetian Patent Statute of 1474; see generally Joanna Kostylo, Commentary on the Venetian Statute on Industrial Brevets (1474), in PRIMARY SOURCES ON COPYRIGHT (1450-1900) (Lionel Bently & Martin Kretschmer eds., 2008) (detailing the 1474 Venetian patent system and its embryonic licensing rules). For a historical analysis of copyright licensing predating the statutory introduced in the 18th Century starting with the watershed of the Copyright Act 1710 8 Ann C. 19, see HARRY HUNTT RANSOM, THE FIRST COPYRIGHT STATUTE: AN ESSAY ON AN ACT FOR THE ENCOURAGEMENT OF LEARNING, 1710 (1956).


29. In the United States, this is the regime applicable to jointly owned patents under 35 U.S.C. § 262 (2017).
requirement.\textsuperscript{30} In others still, unanimous assent is only necessary for exclusive licenses.\textsuperscript{31} The resulting legal landscape is disjointed and beset with legal uncertainty,\textsuperscript{32} inflating transaction costs, elevating market-access barriers, and obstructing innovation.\textsuperscript{33}

The Project should consider advocating a uniform approach for the licensing of jointly-owned IP rights. It would be for Member States to consider two distinct, yet logically contiguous issues. First, they would have to decide whether a right-holder can ever grant a license without the consent of their joint-owners. The cardinal query is whether it is acceptable for a joint owner to suffer a detrition of their exclusive right without their consent, even at the hands of one of their fellow co-owners. Systemically, the competing legal interests are the \textit{erga omnes} nature of IP and the right to exploit and dispose of these rights.\textsuperscript{34} If an affirmative answer were provided to this cardinal query, Member States would be faced with the task of defining precisely the circumstances in which a right-holder is at liberty to grant licenses of jointly-owned IP rights. As national laws lack alignment on this matter, compromise would not be easy.

Secondly, it would be for Member States to regulate the position of a person who enters into a license agreement with a right-holder who failed to obtain the required consent of their joint-owners. Here, the tension is

\textsuperscript{30} For example, in the United Kingdom, the consent of all co-owners is required for the granting of patent licenses under United Kingdom Patents Act 1977, c. 37 (Eng) [henceforth UK PA], § 36; the same is true under section UK Copyright Designs and Patents Act 1988, c.48 (Eng) [henceforth CDPA] § 173(2); the same is true under the India Patents Act 1970 § 50 and the Australia Patents Act 1990 § 16.

\textsuperscript{31} This is the regime governing licenses of jointly-owned copyrights in the United States, under 17 U.S.C. § 201(d) (2010), as held in \textit{Sybersound Records, Inc. v. UAV Corp.}, 517 F.3d 1137 (9th Cir. 2008); see \textit{MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT §§ 6.10-611 (2013) (“one joint owner may grant a nonexclusive license in the entire work without consent of the other joint owners”). This is also the principle governing the licensing of jointly-owned patents in China under Art 15 Chinese Patent Act (2009); for an in-depth analysis see Yunling Ren & Yan Hong, \textit{Rights of Joint Patent Owners in China}, 11 J. MARSHALL REV. INTELL. PROP. L. 601, 622 (2012).

\textsuperscript{32} This sentiment was strongly voiced in several AIPPI Q194 national reports, supra note 24.


between co-owners unwilling to suffer a deterioration of their exclusive right and licensees who have legitimate expectations of exploiting the permission they have contractually obtained. In this context, the rival legal interests are, on one hand, upholding the “certainty” of the absolute nature of IP rights and, on the other, ensuring the “certainty” of commercial dealings. 35 *Mutatis mutandis* this is a conundrum analogous to that faced when elaborating principles to adjudicate conflicts stemming from transfers of title by non-owners (*traditio a non domino*); 36 with the crucial distinction that a licensee in this position cannot acquire material and exclusive control of the subject matter of a license due to its intangible nature but merely venture to perform activities falling within the scope of the improperly licensed IP. 37

In principle, there is an ample spectrum of possible solutions. At one end of this spectrum, unreserved protection of the property rights of the non-consenting joint-owner, directing the licensee to take action against their injudicious licensor; at the other, unexempted upholding of the granted license, eroding the breadth of the proprietary right of the non-consenting joint-owners and granting them recourse against the licensors. Amid these extremes lie a multitude of intermediate solutions, allowing for exceptions in scenarios in which, for example, the non-consenting

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35. The dichotomy between ‘certainty of rights’ and ‘certainty of transactions’ has been explored thoroughly in German legal scholarship; see Victor Ehrenberg, *Rechtssicherheit und Verkehrssicherheit*, 47 JHERINGS JAHRB. 273 (1904) (who first framed this contraposition); Mitchell Franklin, *Security of Acquisition and of Transaction: La Possession Vaut Titre and Bona Fide Purchase*, 6 TUL. L. REV. 589 (1931) (highlighting that common law jurisdictions have historically favored the certainty of rights over that of transactions).


joint-owner failed to act promptly, the licensee was misled, the license was not granted for value, or the licensee had knowledge of the existence of the joint-owners.38

Faced with such a broad variety of alternative solutions, it is submitted that a two-stage decision-making process would be appropriate to steer Member States towards a consensus. At the outset, a fundamental decision would be required, deliberating whether the interest of the licensee or that of the non-consenting co-owner should be favored as a general rule. This would be followed by the careful integration of exceptions aimed at mitigating the inflexibility that would otherwise flow from an unrestricted application of the adopted general norm. In making these choices, Member States would greatly benefit from both *ex ante* agreement on the normative objectives to be pursued and a comparative assessment of the positive law in force across different jurisdictions.

Interestingly, the licensing of jointly-owned IP rights furnishes a felicitous example of the type of issue that would lie at the heart of a broadly-scoped Project. Member States, fueled by frustration with present levels of national fragmentation and international disharmony,39 might find a unitary approach to this matter singularly palatable.

### B. Pre-contractual negotiations

Private law has traditionally taken a keen interest in pre-contractual negotiations, yet the approaches adopted vary markedly, both methodologically and substantively, across jurisdictions.40 Historically,
IP legislation has not introduced special rules for the negotiations of license contracts; even in legal orders with a propensity to scrutinize these interactions closely, IP law has not strayed from the general contract law regime.

In the past, IP license negotiations predominantly took place either between businesses, or individual IP rights holders and businesses. These transactions were largely domestic, featured grants over a small number of IP rights, and involved a linear compensation structure; typically, such agreements were preceded by discussions of limited profundity that involved insubstantial exchanges of information.1

Over the past fifty years, the landscape of IP license negotiations has evolved. In the high-volume, low-value market segment, the mass distribution of digital products and services has irreversibly brought consumers into the factual matrix of IP license negotiations;42 the feverish propagation of the internet of things will further promulgate this trend, as


sales contracts for tangible goods will be increasingly coupled with grants of licenses over the associated IP.\textsuperscript{43} In the low-volume, high-value market segment, international licensing and cross-licensing deals of entire IP portfolios have acquired substantial strategic significance. Parties’ interactions preceding these transactions involve exchanges of large quantities of information, and can give rise to confidentiality issues.\textsuperscript{44}

In recent past, European jurisdictions have begun to recalibrate their consumer protection legislation to address this new environment, also reviewing pre-contractual interactions preceding IP licenses.\textsuperscript{45} Concurrently, academics have begun to query more insistently whether extant private law rules possess sufficient elasticity to accommodate these developments.\textsuperscript{46}

Thus, the Project may consider whether the legal framework of IP licenses might benefit from special rules governing pre-contractual negotiations. It is submitted that this determination would be buttressed by a decision-making process divided into two logically-distinct stages. In the first, it would be for Member States to ascertain the existence of


untoward conduct patterns during negotiations of IP licenses that are inadequately regulated by typical private law safeguards; for example, especially uneven bargaining positions or idiosyncratic information asynchronies that fundamentally skew the balance of the ensuing agreement, encouraging rent seeking and engendering market failures.\(^47\)

If this enquiry were answered in the affirmative, the subsequent step would be to identify normative interventions capable of remedying these mischiefs and ultimately, a selection of the preferable options.\(^48\)

Notably, the scope of the Project would markedly affect the palatability of a set of special rules governing negotiations of IP licenses. If its remit were broad, both in terms of relevant areas of the law and license types, the magnitude and diversity of the subject matter under consideration would render the recognition of common issues challenging. A wide range of transactions would need to be parsed, alongside extensive empirical evidence from an array of subjects and economic sectors. In similar vein, the divergences that exist between the legal approaches adopted across jurisdictions to regulate negotiations would render agreement on the substantive rules to be adopted by the Project arduous to achieve.

If the scope of Project were narrow, by contrast, the aforementioned difficulties would be materially reduced. Analyzing a subset of transaction archetypes would simplify the task of identifying legal wrongs and the agreement of substantive rules to resolve them. However, it should be noted that introducing special rules that only regulate negotiations of a small group of IP licenses would carry a hefty price for systemic fragmentation.

\(^47\) For empirical research into the problems experienced by European consumers in the digital services market see EUROPE ECONOMICS, DIGITAL CONTENT SERVICES FOR CONSUMERS: ASSESSMENT OF PROBLEMS EXPERIENCED BY CONSUMERS (LOT 1), REPORT 4: FINAL REPORT (July 16, 2011), http://www.europe-economics.com/publications/cahc_final_report+_appendices.pdf

C. Formation

Contract formation is shaped by private law tenets. Though there are differences between common and civil law systems, a degree of conceptual uniformity does pervade across jurisdictions.\(^{49}\) IP law establishes but few exceptions to this body of rules, otherwise conforming to it unreservedly.\(^{50}\)

In this brief contribution, it is not possible to conduct an exhaustive inquiry into all facets of the formation of IP license contracts that Member States could explore. The following analysis will concentrate on two topics: consent in standard form IP license agreements and form requirements. The former involves exploring a thorny intersection between IP law and contract law, and affords the opportunity to revisit a well-trodden issue with fresh eyes. By contrast, form requirements present legislative policy challenges in the broader context of international harmonization.

1. Consent: standard form IP contracts

Consent\(^{51}\) lies at the heart of modern contract law theory.\(^{52}\) In the eyes


\(^{50}\) See Nimmer and Dodd, supra note 8 at Ch 3 (for United States law); Guibault and Hugenholtz, supra note 9 (for a comparative study of copyright laws in Europe).

\(^{51}\) Since the times of Aristotle, consent is seen as a combination of knowledge and reasonable alternatives see Kenneth A. Telford, Commentary on Aristotle’s Nicomachean Ethics III, 1 (2013).

\(^{52}\) Despite growing in importance in the late empire, consent was not at the heart Roman contract law; see Reinhard Zimmermann, The Law of Obligations: Roman Foundations of the Civilian Tradition 560–65 (1990) (observing, however, that most “individual parts” of modern contract law theory were present in the Corpus Juris Civilis); David J. Ibbetson, A Historical Introduction to the Law of Obligations 7–10, 71–76, 130–35 (2001). The idea of consent as the cardinal element of a contract flourished with natural lawyers, see Samuel Pufendorf, On the General Duties of Humanity, III in The Political Writings of Samuel Pufendorf, 166 (Craig L. Carr ed., Michael J. Seidler tran., 1994) (“But the things which I owe another from pacts and agreements, these I owe for the reason that he has acquired a new right against me from my own consent.”); Jean Domat, Les Loix Civiles Dans Leur Ordre Naturel; Le Droit Public, Et Legum Delectus, livre preliminaire, introduction (1777); Pothier, supra note 2 at 17. On consent in modern contract law theory, see generally AW Brian Simpson, Innovation in Nineteenth-Century Contract Law, 91 L. Q. Rev. 247 (1975) (detailing the historical evolution of consent in English law during the 19th century); Patrick S. Atiyah, Promises, Morals, and Law (1981) (for a modern English law perspective); James Gordley, The Philosophical Origins of Modern Contract Doctrine (1993) (for a philosophical analysis); Joseph M. Perillo, The Originus
of the law, an agreement is binding only if the parties have assented\(^{\text{53}}\) to
its terms and thus their minds are *ad idem*. Private law establishes the
criteria pursuant to which the presence of consent is ascertained.\(^{\text{54}}\) Historically, IP law has not sought to depart from these general rules.

Over the course of the 20\(^{\text{th}}\) century, standard form contracts have
permeated almost every facet of commerce.\(^{\text{55}}\) In the realm of IP, this trend
has been especially apparent in the technology sector.\(^{\text{56}}\) Among legal
scholars, one long-held thesis contends that standard form contracts sit
uneasily with the consent paradigm as formulated by classical contract
law theory.\(^{\text{57}}\) This submission has its roots in the empirical observation
that offerees generally do not read the terms of standard form contracts
and offerors do not expect them to do so.\(^{\text{58}}\) From this premise, proponents
of this view posit that offerees cannot be held to have consented to
undertakings the content of which was unknown to them\(^{\text{59}}\) and conclude

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\(^{\text{53}}\) The words “consent” and “assent” are used synonymously throughout this paragraph.

\(^{\text{54}}\) For a comparative overview of both common and civil law jurisdictions see FORMATION OF
CONTRACTS: A STUDY OF THE COMMON CORE OF LEGAL SYSTEMS, supra note 49. For an overview of
the approaches to ascertaining consent in European civil law jurisdictions see D.C.F.R, supra note 40 at
Art II – 4:102; Timothy A.O. Endicott, Objectivity, Subjectivity, and Incomplete Agreements, in OXFORD
ESSAYS IN JURISPRUDENCE 151–171 (2000) (for an English law perspective); Perillo, supra note 52 (for
the United States perspective).

\(^{\text{55}}\) The body of scholarship on standard form contracts is vast. See generally Karl N. Llewellyn,
*What price contract? An essay in perspective*, 40 YALE L.J. 704 (1931); OTTO PRAUSNITZ,
*STANDARDIZATION OF COMMERCIAL CONTRACTS IN ENGLISH AND CONTINENTAL LAW*, (1937); Heinz
Hildebrandt, *Das Recht der allgemeinen Geschäftsbedingungen*, 143 ARCH. FÜR CIVILISTISCHE PRAX.
326 (1937); Friedrich Kessler, *Contracts of Adhesion—Some Thoughts About Freedom of Contract*, 43
COLUM. L. REV. 629 (1943); Todd D. Rakoff, *Contracts of adhesion: An essay in reconstruction*, 96
Harv. L. Rev. 1173 (1983). For a European perspective STANDARD CONTRACT TERMS IN EUROPE: A
BASIS FOR AND A CHALLENGE TO EUROPEAN CONTRACT LAW, (Hugh Collins ed., 2008) (providing an
exhaustive analysis of the European normative landscape).

\(^{\text{56}}\) Focusing specifically on IP standard form contracts, see generally Robert W. Gomulkiewicz &
Mary L. Williamson, *A Brief Defense of Mass Market Software License Agreements*, 22 RUTGERS
71 FORDHAM L. REV. 743 (2002); Elizabeth MacDonald, *Incorporation of Terms in Website Contracting –

\(^{\text{57}}\) See seminalley Edwin W. Patterson, *The Interpretation and Construction of Contracts*, 64
COLUM. L. REV. 833 (1964) (who imported into American scholarship both the qualified “adhesion” and
the notion that these contracts require special rules of interpretation owing to their peculiar formation
process); Kessler, supra note 55 (denouncing form contracts as affording private parties de facto law-
making powers and warning that American contract law lacked the doctrinal tools to regulate them).

\(^{\text{58}}\) Arthur Allen Leff, *Contract as Thing*, 19 AM. U. L. REV. 131, 143–147 (1970); Andrew
observation on an empirical enquiry).

\(^{\text{59}}\) This argument bears the influence of subject consent theory; see Perillo, supra note 52 at 429–
that standard form contracts are unenforceable.  

Though lingering notes of discontent have continued to chime, the largely prevailing stance among courts and commentators internationally is that standard form contracts are binding. Two arguments are advanced in support of this conclusion. The first is that offerees who “manifest” their assent to be legally bound by the terms of a standard form contract are deemed to have consented from an objective perspective, even if they failed to read them in fact. The second is that offerees who accept a standard form contract are deemed to have given “a blanket assent . . . to any not unreasonable or indecent terms . . . which do not alter or eviscerate the reasonable meaning of the dickered terms.”

This debate has resurfaced with renewed fervor in respect of IP licenses, owing to the widespread use of “shrinkwrap,” “clickwrap” and “browsewrap” standard forms for these agreements (“Wrap Licenses”). Legal scholars have emphasized that the idiosyncratic formation process

60. For a detailed explanation of this argument see Barnett, supra note 59 at 628–29; Perillo, supra note 52.

61. An example is found in Rakoff, supra note 55 (highlighting that conceptual infrastructure of general contract law struggles to accommodate comfortably the realities of standard form contracts).


63. See Barnett, supra note 59 at 634–636; Bix, supra note 52 at 264–65. Seminally on the notion of “manifest” consent JUDAH PHILIP BENJAMIN, A TREATISE ON THE LAW OF SALE OF PERSONAL PROPERTY: WITH REFERENCE TO THE FRENCH CODE AND CIVIL LAW 357–58 (1868).


65. There is no longer reason to treat these three contracts as distinct archetypes, as in current online practice they have become a single model; see Juliet M. Moringiello & William L. Reynolds, From Lord Coke to Internet Privacy: The Past, Present, and Future of the Law of Electronic Contracting, 72 MD. L. REV. 452 (2012) (who cogently argue that differences between these types of licenses have disappeared). For a thorough analysis of Wrap Licenses see Michelle Garcia, Browsewrap: A Unique Solution to the Slippery Slope of the Clickwrap Conundrum, 36 CAMPBELL L. REV. 31, 34–54 (2014); Elizabeth Macdonald, When Is a Contract Formed by the Browse-Wrap Process?, 19 INT’L J. L. INF. TECHNOL. 285 (2011) (for an English law perspective on the formation of these contracts); Hillman and Rachlinski, supra note 56 (describing the peculiarities of Wrap Licenses and concluding that Llewellyn’s thesis adequately accommodates with minor adjustments); NANCY S. KIM, WRAP CONTRACTS: FOUNDATIONS AND RAMIFICATIONS (2013) (providing a systematic account of this topic).
of Wrap Licenses greatly magnifies the consent dilemma afflicting traditional standard form contracts. They observe that the terms of these agreements raise grave systemic concerns, as they confer far-reaching rights to the offeror that are often entirely unanticipated by the offeree. Moreover, these same scholars question whether traditional theories and doctrines designed for paper-based standard form contracts can be adapted to accommodate Wrap licenses adequately. Though they ultimately concede that the presence of consent in these agreements cannot be called into question, proponents of this view strongly advocate in favor of the introduction of special rules regulating either the negotiations preceding these contracts or their substance, especially if consumers are involved.

The law governing Wrap Licenses is in a state of flux across jurisdictions. In some, courts do not admit challenges to their enforceability based on a lack of consent, only timidly contemplating the possibility of invalidating individual terms, based on doctrines governing substantive fairness. In others, Wrap Licenses can be successfully challenged for lack of consent and the substance of the stipulations therein can be questioned penetratingly. The resulting international legal

66. See generally Batya Goodman, Honey, I Shrink-Wrapped the Consumer: The Shrink-Wrap Agreement as an Adhesion Contract, 21 CARDOZO L. REV. 319 (1999) (ultimately holding that shrinkwrap licenses are adequately governed by the framework for contracts of adhesion); Richard H. Stern, Shrink-Wrap Licenses of Mass Marketed Software: Enforceable Contracts or Whistling in the Dark, 11 RUTGERS COMPUT. TECH. L.J. 51 (1985) (describing as “unsettling” the notion that opening a package manifest consent to terms inside of it); Katy Hull, The Overlooked Concern with the Uniform Computer Information Transactions Act, 51 HASTINGS L.J. 1391 (1999) (emphasizing how all these contract forms place offerees in a “take-it-or-leave-it” predicament); Kim, supra note 56 at 35–87 (providing an extensive account of the history and development of these licenses); Mark A. Lemley, Intellectual Property and Shrinkwrap Licenses, 68 S. CAL. L. REV. 1239 (1995) (providing a map of the conceptual problems raised by these licenses). For a European perspective see Natali Helberger et al., Digital Content Contracts for Consumers, 36 J. CONSUMER POLICY 37 (2013); Lucie Guibault, Copyright Limitations and Contracts: Are Click-Wrap Licenses Valid? 2 Journal of Digital Property Law 144 (2002).

67. See Kim, supra note 65 at 44–53; Robert L. Oakley, Fairness in Electronic Contracting: Minimum Standards for Non-Negotiated Contracts, 42 HOUS. L. REV. 1041 (2005) (suggesting that the doctrine of unconscionability is not adequate to redress these imbalances); Ronald J. Mann & Travis Siebeneicher, Just One Click: The Reality of Internet Retail Contracting, 108 COLUM. L. REV. 984 (2008) (offering an empirical analysis of such terms); Robert W. Gomulkiewicz, Getting Serious About User-Friendly Mass Market Licensing for Software, 12 GEO. MASON L. REV. 687 (2003) (articulating steps that might render these contracts more user friendly).

68. For a comprehensive analysis of the case law in the United States see NIMMER AND DODD, supra note 6 §§ 3:32–3:34.

69. See supra note 47 on the pre-contractual disclosure for digital, standard form IP licenses; on substantive controls on the terms of IP licenses see infra Part II.D.

70. Following initial uncertainties, this is the position in the United States, see NIMMER AND DODD, supra note 6 § 3:33 (providing a detailed analysis of the relevant judicial authorities).

71. For a comparative analysis see Jane K. Winn & Brian H. Bix, Diverging Perspectives on Electronic Contracting in the US and EU, 54 CLEV. ST. L. REV. 175 (2006) (comparing the normative approaches in the United States and EU); James R. Maxeiner, Standard Terms Contracting in the Global
framework is piecemeal and riddled with uncertainty. This is particularly problematic at a time when standard form terms are offered to a global audience of potential licensees over the internet, at an ever-accelerating pace and in a growing number of sectors.

The Project might consider addressing this contentious matter. It is submitted that it would be for Member States to initially agree whether standard form IP licenses are capable of being vitiated by a lack of consent. If such a concern were unanimously shared by Member States, the circumstances in which acceptance of a standard form IP license gives rise to concerns regarding the consent of the licensee would have to be defined precisely; for example, it could be agreed that this is only the case if the license is entered into remotely or if a consumer were involved. The final step would be for Member States to elaborate substantive rules to resolve the aforementioned deficit of consent.

Notably, the scope of the Project would once more be of decisive importance in shaping this discussion. Though imperfect assent beleaguers Wrap licenses generally, the intensity of this issue varies markedly depending on the subjects involved in the transaction and the type of IP licensed.

2. Form requirements

Private law establishes tenets that govern form requirements for all contracts.\(^\text{72}\) IP law commonly provides supplementary rules for

\(^{72}\) Form requirements were paramount in ancient legal cultures and Roman law, see ZIMMERMANN, supra note 52 at 546–49. Over the centuries, however, mandatory formalities have become exceptional in nature, yielding to the principle that parties are free to choose the expression they prefer for their agreement. For a primer on form requirements in European contract law see D.C.F.R., supra note 40 at Art II. – 4:101 (as a general rule there are no form requirements, yet most jurisdictions contemplate exceptions for special contracts). For an Anglo-American perspective, see generally Joseph M. Perillo, The Statute of Frauds in the Light of the Functions and Dysfunctions of Form, 43 FORDHAM L. REV. 39 (1974); Eric A. Posner, The decline of formality in contract law in THE FALL AND RISE OF FREEDOM OF CONTRACT 61–77 (Frank Buckley ed., 1999); Patrick S. Atiyah & Robert S. Summers, Form and Substance in Anglo-American Law a Comparative Study of Legal Reasoning, Legal Theory, and Legal Institutions, (1987).
assignments, licenses, and other contractual dealings.

The intersection of these two streams produces a distinctly different landscape across jurisdictions.\textsuperscript{73} In some, strict and onerous formalities are required: IP contracts are void unless in writing and signed.\textsuperscript{74} In others, form requirements are entirely absent.\textsuperscript{75} In others still, formalities are only required \textit{ad probationem}.\textsuperscript{76} License agreements for different IP rights are often subject to contrasting form requirements within the same jurisdiction.\textsuperscript{77} Additionally, a veritable cacophony of rules, regulations and standards surround electronic documents and signatures.\textsuperscript{78}

This cacophony can be explained by the profoundly conflicting attitudes that exist towards form requirements internationally, both in contract law and IP law. Regardless, legal scholars have been unequivocal in denouncing the extant legal framework for its high transaction costs and legal uncertainty.\textsuperscript{79}

\begin{itemize}
\item \textsuperscript{73} See generally Guibault and Hugenholtz, \textit{supra} note 9 § 3.3 (providing an overview of the European landscape); \textsc{Nimmer and Dodd}, \textit{supra} note 8 §§ 3:44-3:49 (offering a primer of the law in the United States).
\item \textsuperscript{74} For example, this is the case in the United Kingdom for patent (section 30 UK PA), trademarks (section 28 United Kingdom Trade Marks Act 1994) [henceforth UK TMA], and copyright licenses (sections 92, 101A CDPA). The same is true in Spain for patent article 74 Ley N° 24/2015, de 24 de julio, de Patentes [henceforth Spanish Patent law], and article 46 of Ley N° 17/2001, de 7 de diciembre de 2001, de Marcas [henceforth Spanish Trademarks law]; notably, registration in the patent registered is contingent on the license being in the form of a deed under article 74 Spanish Patent law.
\item \textsuperscript{75} This is the case in Austria, Denmark, Finland, and Sweden; see Guibault and Hugenholtz, \textit{supra} note 9 § 4.1.3.
\item \textsuperscript{76} For example, this is the case in Belgium (Article XI.167 Belgian Code of Economic Law), Italy (article 110 Italian Copyright Law) and Luxembourg (Article 12 Loi du 18 avril 2001 sur les droits d’auteur, les droits voisins et les bases de données) [henceforth Luxembourg Copyright and Related Rights Act]
\item \textsuperscript{77} For example, in the United States exclusive licenses must be in writing, while non-exclusive licenses do not; see generally \textsc{Nimmer and Nimmer}, \textit{supra} note 32 § 10.03; \textsc{Nimmer and Dodd}, \textit{supra} note 8 §§ 3:44-3:49, 5:59; it should be noted however that written form is relevant for non-exclusive copyright licenses to resolve priority disputes under 17 U.S.C. § 205(e) (2010). In the Netherlands copyright licenses need not be in writing, while a written instrument is required for a license of neighboring rights (article 9 of the Act of March 18, 1993, containing Rules on the Protection of Performers, Phonogram Producers and Broadcasting Organizations and Amending the Copyright Act 1912) [henceforth Dutch Neighboring Right Act]. In France articles L131-2, L-132-7, L212-3 Code de la propriété intellectuelle (version consolidée au 17 mars 2017) [henceforth French Intellectual Property Code] establish variable set of formalities for copyright related contracts. See generally Guibault and Hugenholtz, \textit{supra} note 9 §§ 4.2.3, 4.3.3.
\item \textsuperscript{78} This an area in which the United States benefits from a degree of clarity from The Electronic Signatures in Global and National Commerce Act (E-Sign) 15 U.S.C. 96; on this statute see generally Robert A. Wittie & Jane K. Winn, \textit{Electronic Records and Signatures under the Federal E-SIGN Legislation and the UETA}, \textsc{Bus. Lawyer} 293 (2000) (providing an analysis of this statutory instrument). Across the world, however, there is substantial disharmony. See generally Donnie L. Kidd Jr. & William H. Daughtrey Jr., \textit{Adapting Contract Law to Accommodate Electronic Contracts: Overview and Suggestions}, \textsc{26 Rutgers Computer Tech. L.J.} 215 (1999) (suggesting that often adapting existing contract law doctrines is sufficient to accommodate the needs of electronic transactions).
\end{itemize}
The Project should consider recommending a uniform legal regime for the form requirements, to promote international harmonization. Member States would undertake to seek equilibrium between two polarized impulses. At one extreme, the impetus to expedite contract formation and reduce transaction costs by minimizing form requirements. At the other, the desire to augment standardization and foster transparency by imposing formalities that require extensive disclosure of information.

It is submitted that this balancing assessment and the ensuing policy decision would be best informed by a comparative appraisal of the current state of the law across multiple jurisdictions and empirical data collected from stakeholders. Notably, the scale and complexity of this inquiry would differ substantially depending on the scope of the Project.

D. Content: rights and obligations of the licensor and licensee

It is a widely-accepted principle that persons can freely decide whether to enter into a contract, with whom and under which terms. Nevertheless, the content of the synallagmatic nexus agreed by the parties does not exist in a vacuum but is rather affected by two distinct categories of legal rules.

The first are mandatory rules (“MRs”). MRs curtail party autonomy by imposing non-derogable rights and obligations on contracting parties; they are typically either prescriptive or proscriptive in nature. The second category consists of default rules (“DRs”). DRs establish rights and obligations that apply to the contracting parties only in so far as they have not agreed otherwise; the defining feature of these rules is that they are presumptive. Both MRs and DRs can originate from many sources.


82. These are sometimes alternatively referred to as “immutable” or “coercive”.

83. In this paragraph, the expression “freedom of contract” and “party autonomy” are used as synonymy.

84. See Kennedy, supra note 81 at 595–96; Philippe Aghion & Benjamin Hermelin, Legal Restrictions on Private Contracts Can Enhance Efficiency, 6 J. L. ECON. ORGAN. 381 (1990) (arguing that certain mandatory rules can enhance efficiency).

85. These are sometimes alternatively referred to as “non-mandatory”, “presumptive” or “terms implied in law”.

branches of the law and express a broad range of policy concerns; some apply to all contracts homogenously, while others only extend to voluntary exchanges with determinate features.87

IP licenses are subject to MRs and DRs that apply to all binding pacts generally, as well as those specifically crafted for these agreements. The latter group of rules stems primarily from IP laws, yet can also emerge from other branches of the law, such as competition law and consumer law. A comparative analysis of the rules impacting the content of IP licenses reveals significant differences in their prevalence, substance and intensity across jurisdictions. Notably, disharmony is most pronounced in relation to copyright licenses.88

With regard to MRs, some jurisdictions establish a thicket of rules that severely limit the freedom of the parties to architect their own agreement. Others contemplate but few MRs of proscriptive nature, allowing ample space for the parties’ contractual creativity. These conflicting approaches are an external manifestation of both the proclivity of the legal order in question to encroach on private transactions and, more generally, the value attributed to freedom of contract. By contrast, across jurisdictions there is a relative paucity of DRs specifically addressing IP licenses; when they are present, they tend to concentrate on matters of secondary importance. Notable in its absence is a discernible systemic approach.89

It is almost a foregone conclusion that Member States would devote significant attention to the consideration of possible MRs and DRs that would affect the content of IP license agreements. Negotiations would likely be challenging, owing to the substantially different approaches that...
exist at national level. Though MRs and DRs combine to create a unitary body of rules, it is submitted that Member States would benefit from adopting distinct decision-making processes for their formulation, owing to their profound ontological and functional differences.

1. Decision-making process for mandatory rules

In principle, there are two bases of adoption for a MR: protection of an interest of either one or both the contracting parties; and protection of an interest of persons not privy to this contract—society at large or a segment thereof. Crucially, the threshold of adoption is high: the interest under consideration must be deemed of such systemic importance as to warrant the introduction of a non-derogable rule that either restricts or completely precludes the parties’ autonomy to stipulate otherwise in their agreement.

A comparative analysis reveals that MRs applicable to all contracts typically protect general interests such as legality, the integrity of consent, and reliance. By contrast, MRs that apply to determinate contracts safeguard interests that are vital to their designated context of application. In the realm of copyright, non-derogable rules that nullify any attempt of an author to assign or license their moral rights are a revelatory example of an MR aimed at protecting an interest deemed to be of critical importance to this branch of IP law.

Thus, in formulating MRs, it would be for Member States to define first which normative objectives the Project should seek to pursue when regulating IP license contracts, and their respective order of priority. Thereafter, Member States should dissect the structure of IP license agreements to ascertain which segments lend themselves to stipulations capable of undermining the objectives that have been identified as worthy of protection, if left entirely to unrestricted party autonomy. This decision-making process would involve legal, political, social, and economic considerations. It should, however, be shaped by the observation that the function of MRs is to protect interests deemed systemically significant.

Any excursion that sought to venture beyond methodological observations would be premature if conducted prior to deliberations

90. For a detailed analysis see Storme, supra note 86 at 244–51.

establishing which normative objectives Member States wish to shield from absolute freedom of contract, and their respective order of priority. Nevertheless, based on a comparative analysis of IP-specific MRs presently in force across jurisdictions, it is submitted that the following are examples of types of norms that Member States might consider: limitations to the breadth and depth of the license grant that the parties can agree, a standard of conduct in performance for the rights and obligations stipulated under the IP license, a warranty regarding the quality and title of the licensed IP right, and restrictions on terms the effect of which is to magnify the scope of protection of the licensed IP right beyond statutory confines.

2. Decision-making process for default rules

The bases for the adoption of DRs are highly contentious spawning vivacious discussions and vast literature. Legal scholars, philosophers and economists are deeply divided with regard to the policy aims that should inform these rules.

The most widely-supported theory is that DRs should promote economic efficiency. Among its proponents, however, there is disagreement concerning the manner in which these rules should achieve this objective. Alternative views have been posited, including

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92. For example, in many European jurisdictions, copyright laws contain MRs limiting the licensing of future rights, for a comparative analysis see Guibault and Hugenholtz, supra note 9.

93. For example, many European jurisdictions contain a general MR that applies to all contract, requiring parties to perform their contract in good faith; for a comparative European analysis see REINHARD ZIMMERMANN & SIMON WHITTAKER, GOOD FAITH IN EUROPEAN CONTRACT LAW (2000) (providing both a theoretical analysis and case studies). In similar vein, albeit with substantial differences, the Uniform Commercial Code establishes a duty to perform contracts in good faith, see generally Robert S. Summers, “Good Faith” in General Contract Law and the Sales Provisions of the Uniform Commercial Code, VA. L. REV. 195 (1968); Atiyah and Summers, supra note 72; Steven J. Burton, Breach of Contract and the Common Law Duty to Perform in Good Faith, HARV. L. REV. 369 (1980); Steven J. Burton, Good Faith Performance of a Contract Within Article 2 of the Uniform Commercial Code, 67 IOWA L. REV. 1 (1981). Notably, the ALI Principles of Software Contracts chose to retain the general UCC obligation to perform contractual obligations in good faith; for commentary see Hillman and O’Rourke, supra note 48 at 1533–34 (providing an overview of this issue).

94. For example, see ALI Software Contracts Principles § 3.05b; for a detailed commentary Hillman and O’Rourke, supra note 49 at 1534–35; NIMMER AND DODD, supra note 8 §§ 8:5-8:30.


96. The bibliography on this topic is vast. See generally Ayres and Gertner, supra note 86 arguing that in specific situations, it is efficient to impose a penalty default rule to discourage strategic information withholding; Eric A. Posner, There Are No Penalty Default Rules in Contract Law, 33 FLA. ST. U. L. REV. 563 (2005) (arguing that penalty default rules don’t exist).

97. For an overview of the theories that have been advanced over the course of time see Craswell, supra note 86 at 3-4; RICHARD A. POSNER, ECONOMIC ANALYSIS OF LAW 434 (1992) (for an explanation
suggestions that DRs should be grounded in the customs, usages and practices of the parties’ community (‘Conventionalism’),
formalities, the consent of the contracting parties or morality. Recently, two further foundations for DRs have been proposed: the history of the legal order in question and its constitution.

In light of such profoundly diverging stances, Member States would face a schismatic decision in electing the bases of adoption for the DRs to be included in the Project. One possibility might be to embrace one of the aforementioned theories. In principle, such a choice would be elegant and offer consistency; in practice, it would be both politically and substantively problematic to realize, as reaching a consensus on the principle to be followed would be wearying. Alternatively, Member States could opt for an “eclectic” method that takes into account multiple bases concurrently. This strategy would make allowances for a range of views and sensitivities, though it would saddle Member States with the heavy burden of formulating an order of priority among the chosen principles.

Nevertheless, it should be noted that the intergovernmental and international nature of the Project would intrinsically simplify this decision-making process. In the ambit of negotiations involving a large number of sovereign actors with profoundly different histories, social norms, and traditions, striving to ground DRs in historical, constitutional or moral considerations would be unrealistic. Accordingly, the most viable bases of adoption to be considered by Member States would likely be a combination of economic efficiency and Conventionalism.


99. See generally, Lon L. Fuller, Consideration and Form, 41 COLUM. L. REV. 799 (1941) (suggesting that default rules should induce parties to express their intentions in a manner that could be recognized by courts easily).

100. For an explanation of this thesis and a cogent critique, see Christopher A. Riley, Designing Default Rules in Contract Law: Consent, Conventionalism, and Efficiency, 20 OXF. J. LEG. STUD. 367, 370–75 (2000).

101. See Burton, supra note 98 (default rules should be based on the coordinating principle of fairness). For a comprehensive bibliography see Craswell, supra note 86 at 12-13.


103. See Riley, supra note 100 at 389–90; Hesselink, supra note 87 at 69.
E. Canons\textsuperscript{104} of interpretation\textsuperscript{105}

In every legal system, private law establishes principles and rules of construction that apply to all contracts.\textsuperscript{106} In many jurisdictions, IP law provides ulterior hermeneutical canons specific to assignments, license agreements and other dealings involving these assets.

The ubiquitously-recognized aim of contract construction is to establish the intention of the parties.\textsuperscript{107} Despite this, there is imperfect alignment between the rules, principles and processes that jurisdictions apply in pursuit of this core objective. \textit{Inter alia}, the extent to which the common intention of the parties is construed subjectively or objectively varies significantly,\textsuperscript{108} as do the precepts guiding completive interpretation\textsuperscript{109} and recourse to good faith as a hermeneutical device.\textsuperscript{110}

\begin{enumerate}
\item[104.] The words canon is used here to include both rules and principles of interpretation.
\item[105.] For present purposes, the words construction and interpretation are used as synonyms. The terminological convention according to which “interpretation” designates the operation to discern meaning, while “construction” identifies process to establish legal effects is not accepted in this paper; see \textit{RESTATEMENT (SECOND) OF CONTRACTS} §200, 201-03 (1981).
\item[108.] See Vogenerauer, Burrows, and Peel, \textit{supra} note 106 at 124–28 (explaining the underlying theoretical differences and comparing the law in England, France and Germany); D.C.F.R, \textit{supra} note 40 at II-8:101 (for a primer of the different hermeneutical matter in European jurisdictions); Perillo, \textit{supra} note 52 (explaining the trajectory of objective interpretation in United States contract law); David McLauchlan, \textit{Common Assumptions and Contract Interpretation} (1997), 113 L. Q. REV. 237.
\item[110.] On good faith as an interpretation prism, see Franz Wieacker, \textit{Zur rechtstheoretischen Präzisierung des §§ 242 BGB} (1956) (who drew an analogy with Papinianus’ conception of the \textit{ius honorarium} (or \textit{ius praetorium}) as \textit{adiuvandi vel supplendi vel corrigendi iuris civilis}). For a European
\end{enumerate}
Even where jurisdictions share common principles and rules of construction, their method of application can differ meaningfully.\footnote{111} Moreover, while interpretation is a matter of law in some legal orders, it is one of fact in others.\footnote{112}

IP law canons of construction for license agreements are supplementary in nature, as they complement the general rules and principles laid out by contract law.\footnote{113} Notably, their scope of application varies. Some apply horizontally to all licenses regardless of the type of IP involved. For example, there are jurisdictions where a principle has emerged which suggests that both ambiguous and unclear terms in such contracts should be interpreted in favor of the licensor.\footnote{114}

By contrast, in most jurisdictions, the vast majority of established IP canons of construction have a narrower scope, confined to agreements that involve a particular form of IP. This is especially apparent in the realm of copyright. For example, in France,\footnote{115} Belgium,\footnote{116}

\begin{footnotesize}
\item[111] See Vogenauer, Burrows, and Peel, supra note 106 at 129–36; Burton, supra note 97 at 1.
\item[112] For a thorough explanation of this topic and a comparative analysis across jurisdictions see Vogenauer, Burrows, and Peel, supra note 106 at 129–30; D.C.F.R, supra note 40 at II-8:101 (providing a comparative overview of European jurisdictions).
\item[113] In the United States, alongside contract law principles of individual states, the Uniform Commercial Code Art. 2 has also influenced the interpretation of IP licenses; see Gomulkiewicz, supra note 9 at 5–6; Nimmer and Dodd, supra note 8 § 4.2.
\item[114] Notably, in the United States, contract law of individual states typically holds that ambiguous terms must be construed contra proferentem; see Restatement (Second) of Contracts § 206 (1981). However, this canon is often disregarded in IP licenses following the principle that such stipulations should be construed in favor of the licensor, see Gomulkiewicz, supra note 9 at 12–13 analyzing this principle of construction and the relevant case law.
\item[115] Article L122-7(-4 French Intellectual Property Code; notably, the Cour de Cassation Cass. 1re civ., 30 Sept. 2010, CCE, 2010, comm: 199, held that this interpretation rule is non-derogable for the parties.
\item[116] Article XL167 Code de droit économique (version consolidée de 2016) [henceforth Belgian Code of Economic Law].
\end{footnotesize}
Luxembourg and Spain, ambiguous terms must be interpreted in favor of the author (in dubio pro autore). In France, Belgium and, to a lesser degree, the United States, the scope of copyright licenses is interpreted strictly and limited to the rights expressly mentioned in the agreement. Germany, Greece and Italy have established a construction rule according to which the scope of copyright licenses must be determined in light of the purpose of the transaction. In Hungary, if stipulations on this matter are unclear, licenses to produce a copyright-
protected work are construed expansively to include permission to distribute copies. Conversely, there are also jurisdictions in which no such special canons of construction have emerged for IP license contracts and general contract law principles and rules of construction apply almost unwaveringly.\textsuperscript{128}

Thus, the international legal landscape regarding the interpretation of IP license agreements displays a distinct lack of uniformity, which can be a source of costly uncertainty. To some extent, market participants can overcome this obstacle by way of dexterous drafting and by taking advantage of choice of law rules, yet such workarounds are inherently suboptimal.

The Project may consider exploring this nuanced facet of the legal framework governing IP licenses. It would be for Member States to develop bespoke hermeneutical rules and principles that would be conducive to reconstructing the intention of parties to IP licenses. Regrettably, in light of the profoundly diverging national approaches to contract construction generally and IP licenses specifically, it is submitted that agreeing both the approach and substance of such canons would be challenging. Additionally, Member States would face one particularly significant conceptual obstacle: any rule or principle of interpretation developed would need to be compatible or at least not at odds with general contract law canons of interpretation from across a vast number of jurisdictions.

Notably, the scope of Project would decisively affect endeavors addressing canons of construction for IP licenses. If its remit were broad, Members States would face a uniquely demanding challenge, as they would have to elaborate high-level construction principles, focusing on the interpretation of the functional core of IP licenses. If the scope of the Project were narrow, Member States might encounter fewer difficulties in crafting canons of interpretation that target precisely-delimited issues of construction germane to the type of license under consideration.

\textit{F. Registration}

Registration systems are a staple of most legal orders. Typically, they record information such as the existence of goods deemed to be of elevated socio-economic importance,\textsuperscript{129} the identity of persons, both legal and natural. See generally Guibault and Hugenholtz, supra note 9 § 4.9.6; COPINGER AND SKONE JAMES ON COPYRIGHT, supra note 9 §§5-233-5-240.

\textsuperscript{129} For example, throughout history, ship registration systems have been ubiquitous, owing to their economic, commercial and military importance; see generally ROBERT DAWSON CAMPBELL, THE SHIP’S REGISTER: A HISTORY OF BRITISH SHIP STATUS AND REGISTRATION PROCEDURES INCLUDING THEIR ADOPTION IN NEW ZEALAND (1980); Ray Bergsma, \textit{Shipping Registrations}, 3 AustL. NZ. Mar.
and natural, and systemically relevant transactions. Their social, economic and political purposes, can be immensely diverse, as can be their legal nature and function.

IP legislation has a long history of establishing registration systems, tailored to the needs of the intangible goods in question. These systems have not remained static over the course of time, as the policy objectives and legal function attributed to registration have evolved. New registers have been created to accommodate novel forms of intellectual property and technologies, whereas registers that were once pivotal have been

130 For natural persons, beyond the obvious example of birth registers, it should be noted that registration systems have been instrumental to operating ad hoc legal regimes for special groups of individuals; outlaws registers are a pertinent example, see Ralph B. Pugh, Early Registers of English Outlaws, 27 AM. J. LEG. HIST. 319 (1983); Jane Y. Chong, Targeting the Twenty-First-Century Outlaw, 122 YALE L.J. 724, 743–50 (2012) (for a schematic and precise historical account).


135 For example, registration systems for plant varieties have been introduced worldwide over the
In the 19th and 20th centuries, multilateral conventions both ushered in the creation of international IP registration mechanisms and promoted the harmonization of fundamental aspects of national registers. Notably, these initiatives did not extend to the rules governing the registration of contracts involving IP rights and, thus, the international landscape remains profoundly disjointed. These discrepancies are especially evident when comparing the legal regimes applicable to license agreements. In some jurisdictions, registration of these contracts is optional and purely carries a function of public notice. In others, past thirty years, see Margaret Llewelyn & Mike Adcock, European Plant Intellectual Property (2006) (for the EU legal framework); Mark D. Janis & Jay P. Kesan, U.S. Plant Variety Protection: Sound and Fury...?, 39 HOUST. L. REV. 727, 739–45 (2002) (for the United States registration system); Sanjeet K. Verma, TRIPS and Plant Variety Protection in Developing Countries, 17 EUR. INTELLECT. PROP. REV. 281 (1995) (for a comparative international perspective).

136. A pertinent example is the copyright register that used to be held at Stationers’ Hall in England. It ceased to function in its legal capacity in February 2000, after almost three centuries of service. On its history see generally Cyprian Blagden, The Stationers’ Company. A History 1403-1959 (1960); John Feather, A History of British Publishing (1988); Sherman and Bently, supra note 41 at 71, 181, 184. Notably, for a brief time, Stationers’ Hall also served as a “quasi-official” register for trademarks, see Trueman Wood, The Registration of Trade Marks 21-22 (1875).


138. On these international conventions see Ricketson and Ginsburg, supra note 12; Reinboth and Von Lewinski, supra note 12; Von Lewinski, supra note 12; Ricketson, supra note 12; Stauder, supra note 12; Nelson, supra note 12; Winner and Denberg, supra note 12; Beier and Schicker, supra note 12; Malbon, Lawson, and Davison, supra note 12; for a recent systemic overview Caliboli and Werba, supra note 12; for critical reflections on the harmonization of substantive IP law in the European Union see Pila and Ohly, supra note 12.


registration is required for licenses to be effective against third parties.\footnote{141} and may also serve as a priority point in the resolution of conflicts between competing \textit{ayants cause}.\footnote{142} In others still, registration is required for a licensee to be able to bring actions against infringers.\footnote{143} Adopting yet another normative approach, a small number of jurisdictions establish that a sub-set of licenses with defined attributes must be registered to be effective between contracting parties.\footnote{144}

Academics, practitioners, and international organizations concur that this legislative discord is a source of both uncertainty and elevated transaction costs. However, opinions are deeply divided regarding the legal function that should be attributed to the registration of IP contracts generally, and of license agreements in particular.

One view is that registration should be required in order for IP licenses to be effective against third parties. The rationale is that documenting these transactions and the associated interests enhances legal certainty systemically; moreover, it promotes the commercial exploitation of IP rights, by enhancing the amount of information available to the public and facilitating regulatory supervision.\footnote{145}

A different view is that registration of IP licenses should be optional. Proponents of this thesis suggest that such filings are time-consuming, costly and a source of administrative complications. They suggest that

\footnote{141}{For example, this is the case in the United Kingdom for patents and trademarks licenses under UK PA § 33 and UK TMA § 25. The same is true in Spain under article 79 Spanish Patent Law, article 46 Spanish Trademarks Law, article 59 Ley 20/2003, de 7 de julio, de Protección Jurídica del Diseño Industrial [henceforth Spanish Design Law], and in Italy articles 138-140 Codice della proprietà industriale (decreto legislativo 10 febbraio 2005, n. 30, as modified by decreto-legge 24 gennaio 2012, n. 1, and adopted by legge 24 marzo 2012, n. 270] [henceforth Italian Industrial Property Code].}

\footnote{142}{An important distinction needs to be drawn between two different approaches. Some legal systems set the priority point at the time of registration; for example, this the case under articles 138-140 Italian Industrial Property Code. Other jurisdictions establish that the priority point for third party effectiveness is the moment when the license agreement was concluded, provided that the agreement in question has been subsequently registered; this is the case under section UK PA § 33 and section UK TMA § 25. In the United States, there is no mandatory registration for copyright licenses, both non-exclusive and exclusive; however, under 17 U.S.C. § 205 (2010) recording of an exclusive license serves as constructive notice to third parties; moreover, under 17 U.S.C. § 205(d) (2010) it is held that between conflicting transferees (including exclusive licensees) a later recorded interest prevails over a prior unrecorded interest, provided that the latter has not been registered within one month after its execution. See generally NIMMER AND DODD, supra note 8 § 5:59; Tosato, \textit{Secured Transactions and IP licenses}, supra note 139 at 164-167.}

\footnote{143}{For example, registration is required in Spain, see AIPPI, \textit{Spain: Report Q 190}, https://aippi.org/download/committees/190/GR190spain.pdf.}


\footnote{145}{This is the view espoused in AIPPI, \textit{Resolution: Q190}, (Oct. 8-12, 2006), http://aippi.org/wp-content/uploads/committees/190/RS190English.pdf.}
registration often fails to provide reliable information, as parties limit their disclosures or take steps to conceal their identity to keep their dealing confidential. Furthermore, they argue that the negative effects stemming from innocent failure to register IP licenses vastly outweigh the alleged benefits of compulsory registration.146

The Project should consider formulating recommendations to harmonize this legal framework. It is submitted that conventional thinking is unlikely to garner consensus among Member States, as existing views are profoundly divergent and deeply entrenched. The Project should be mindful of the history of registration systems, yet should strive to look beyond the orthodoxy surrounding this topic. The operation and legal function of IP license registration would have to be considered prospectively. Crucially, in an increasingly digital economy, transaction-recording systems could be built on decentralized, automated ledgers populated by self-executing contracts.147 This type of registration system would introduce dynamics and mechanisms that differ profoundly from those associated with paper and electronic registers presently in operation. Legal thinking should not lap erratically at the coat-tails of technological innovation, but rather harness it resolutely to leverage its potential.

G. Private international law: applicable law rules148

Across jurisdictions, domestic laws that establish private international law rules are largely influenced by multilateral conventions.149 In the past,
these international instruments did not dedicate special attention to IP contracts, including licenses; by contrast, in recent times, legislatures, legal scholars, governmental and non-governmental organizations have reversed this trend, striving to develop the private international law legal framework for these agreements.\textsuperscript{150}

IP licenses are not ontologically transnational. The licensor, licensee, licensed IP rights, and contract performance can all be tied to a single jurisdiction and thus subject to its law. Historical sources indicate that the overwhelming majority of transactions adhered to this paradigm throughout the 18\textsuperscript{th} and 19\textsuperscript{th} centuries.\textsuperscript{151} However, the past fifty years have heralded a progressive internationalization of these agreements. Increasingly, IP licenses involve parties located in distant jurisdictions, multiple IP rights protected by different States, and cross-border performance.\textsuperscript{152} The concurrence of these features breeds conflicts of laws, the disentanglement of which can be laborious.


\textsuperscript{151} See generally Seville, supra note 41 (providing insights into copyright licenses); Oren Bracha, United States Copyright, 1672-1909, in \textit{Research Handbook on the History of Copyright Law} 335–72 (Isabella Alexander & H. Tomás Gómez-Arostegui eds., 2016) (offering an insight into copyright and licensing in the United States, prior to the twentieth-century).

\textsuperscript{152} See generally Sherman and Bently, supra note 41; Seville, supra note 41; Granstrand, supra note 41; Aoki, supra note 41; William R. Cornish, The International Relations of Intellectual Property, 52 Camb. L.J. 46 (1993); David, supra note 41.
It is an established private international law tenet that a distinction must be drawn between proprietary and contractual matters when determining the law applicable to IP contracts. Proprietary matters are those that concern the IP right itself, including its existence, validity, scope of protection, duration, whether it can be assigned and licensed, and the registration requirements for these dealings. The orthodox position is that the law applicable to these issues is that of the State protecting the IP right object of the contract ("lex loci protectionis"); parties are not at liberty to postulate otherwise.

Contractual matters are those that concern the mutual rights and obligations stipulated by the parties, and the constituent elements of their agreement, including formation, interpretation, performance, breach, nullity and remedies. It is generally accepted that the law applicable to these facets is that governing the contract ("lex contractus"). Save for international mandatory provisions, parties can elect for their contract to be governed by their law of choice. In the absence of such a designation, lex contractus is established.


154. See generally CHESHIRE, NORTH & FAWCETT: PRIVATE INTERNATIONAL LAW, supra note 150 at 10; Torremans, Licenses and assignments, supra note 150 at 400–402; De Miguel Asensio, supra note 150 at 320. Notably, lex loci protectionis does not apply ubiquitously to the taking of security in IP licenses. The private international law framework governing these transactions varies across jurisdictions and raises a variety of complex issues; see Tosato, Secured Transactions and IP licenses, supra note 139 at 167-172 (highlighting the deficiencies of approaches currently adopted across jurisdictions and suggesting legal reform strategies).

155. Formal validity of the contract must be distinguished from form requirements specifically established by IP law. The former is a matter for contract law governed by lex contractus, the latter is an IP law issue to which lex loci protectionis applies.

156. The remedies referred to here are those available for breach of an IP license under contract law; they are ulterior and distinct from the remedies available for infringement, under IP or criminal law. Notably, contract law remedies fall under lex contractus, whereas remedies stemming from IP law and criminal law, are subject to lex loci protectionis.

157. Examples of such provisions include rules stemming from labor law, consumer law, competition law and restrictions on trade in dual-use technology, see Haimo Schack, Internationally Mandatory Rules in Copyright Licensing Agreements, in INTELLECTUAL PROPERTY IN THE CONFLICT OF LAWS 115 (Jürgen Basedow et al. eds., 2005).

158. The principle that parties are free to choose the law applicable to their contract is acknowledged across jurisdictions. For example, in the United States see the Restatement (Second) of Conflicts § 187; in the EU, see Article 3 Rome I; in Japan Article 7 of the Japanese Private International Law Act (2006). For a detailed critical analysis in the context of IP licenses see Torremans, Licenses and assignments, supra note 150 at 399–401; De Miguel Asensio, supra note 150 at 318–19; INTELLECTUAL PROPERTY AND PRIVATE INTERNATIONAL LAW: COMPARATIVE PERSPECTIVES (Toshiyuki Kono ed., 2012); SYMEON C. SYMEONIDES, AMERICAN PRIVATE INTERNATIONAL LAW §§ 484–85 (2008).
pursuant to the presumptive rules of the jurisdiction in question.\textsuperscript{159} Crucially, this is a source of divergences internationally, as shown by the following examples.

In the United States, private international law rules are established at the federal level.\textsuperscript{160} Thus, the law applicable to a contract in which the parties have not stipulated a choice-of-law clause is determined pursuant to the rules of each individual state. States do not share a unitary approach in regulating this issue. A minority of states\textsuperscript{161} adhere to the \textit{lex loci contractus} rule,\textsuperscript{162} largely following the principles established in sections 325-326 of the Restatement (First) of Conflicts.\textsuperscript{163} By contrast, a larger group of states\textsuperscript{164} have adopted rules that follow section 188 of the Restatement (Second) of Conflicts.\textsuperscript{165} This provision establishes that the applicable law to determine the rights and obligations of the parties “with regard to contractual issues” is governed by the law of the state which has “the most significant relationship” with that issue.\textsuperscript{166} Such a relationship should be assessed taking “into account” the following non-exclusive list of “contacts”: “(a) the place of contracting; (b) the place of negotiation of a contract; (c) the place of performance; (d) the location of the subject matter of the contract; and (e) the domicile, residence, nationality, place of incorporation, as well as place of business of the parties.”\textsuperscript{167} As a final principle, this section provides that if a contract is negotiated and performed in one state “the local law of this state will usually be

\textsuperscript{159} See Torremans \textit{Licenses and assignments}, \textit{supra} note 150 at 401–04; De Miguel Asensio, \textit{supra} note 150 at 320–21; SYMEONIDES, \textit{supra} note 158 at §§ 484–85; INTELLECTUAL PROPERTY, \textit{supra} note 158 at 13.1.2.


\textsuperscript{161} For the complete list and a granular analysis of the approach of each state see SYMEONIDES, \textit{supra} note 158 § 485.

\textsuperscript{162} Under Restatement (First) of Conflicts of Laws § 332, the scope of the \textit{lex loci contractus} rule covered the following issues: the form of a contract, contractual capacity, mutual assent, consideration, fraud, illegality and other grounds for avoiding the contract; in depth \textit{Id.} at § 485; INTELLECTUAL PROPERTY, \textit{supra} note 158 at 13.1.2.

\textsuperscript{163} For an analysis of these sections and the process that led from the Restatement (First) of Conflicts to the Restatement (Second) of Conflicts see Syeone C. Syeoneides, \textit{The Judicial Acceptance of the Second Conflicts Restatement: A Mixed Blessing}, 56 Md. L. Rev. 1248 (1997) (providing an exhaustive bibliography on this topic); SYMEONIDES, \textit{supra} note 158 §§ 484-485.

\textsuperscript{164} For the complete list see SYMEONIDES, \textit{supra} note 158 §§ 488-97.

\textsuperscript{165} For the complete list, \textit{Id.} §§ at §§ 498-99.

\textsuperscript{166} Section Restatement (Second) of Conflicts of Laws § 1881(1). Notably, this section also states that this assessment must be generally guided by the principles listed in § 6(2): “the needs of an interstate system; the relevant policies of the forum and other interested forums; the justified expectations of the parties; the basic foundational principles of the area of law at issue; the uniformity and predictability of the result; and the ease in determination and application”.

\textsuperscript{167} Restatement (Second) of Conflicts of Laws § 188(1).
In the European Union, the relevant rules are found in the Rome I Regulation. Art 4(1) establishes fixed rules to ascertain the applicable law for a list of nominate contracts. Art 4(2) holds that the applicable law to all other contract archetypes is that of the country where the party required to effect the characteristic performance has its habitual residence. Art 4(3) completes this provision, establishing an escape route: if the contract manifestly exhibits a “closer connection” with another country, its law will apply. In practice, the intricate nature of modern IP licenses results in the frequent application of the closest connection rule.

In Switzerland, the law applicable to IP contracts is that of the “place of habitual residence” of the transferor or licensor. In Japan, absent a choice-of-law clause agreed by the parties, the law applicable to an IP license agreement is that of the state with which there is the closest connection; however, neither rules nor guidance are supplied for the execution of this assessment.

In light of this fragmented international legal framework, the Project may consider examining conflict of law rules applicable to IP license contracts. Member States would indubitably accept axiomatically the

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168. Restatement (Second) of Conflicts of Laws § 188(3). Notably, §§ 189-99 & 203 of the Restatement (Second) of Conflicts of Laws establish special rules applicable to nominate contracts. However, IP license contracts are not included.

169. Interestingly, under Article 4(1) of an early draft proposal of the Rome I Regulation (COM(2005) 650 final) IP contracts were subjected to the law of the country in which “the person who transfers or assigns the rights has his habitual residence”. For an exegesis of this provision, see Torremans Licenses and assignments, supra note 150 at 403–04.

170. Article 4(4) of the Rome I Regulation establishes that the “closer connection” criterion also applies if the applicable law cannot be determined pursuant to either article 4(1) or 4(2).


174. In depth see Intellectual Property, supra note 158 at 13.2.2.

175. Historically, UNCITRAL has primarily focused its efforts on modernizing and harmonizing substantive rules. Nevertheless, in recent past, Member States have shown growing sensitivity towards private international law profiles. For example, see UNCITRAL “Supplement on Security Rights in
principle that proprietary matters are governed by *lex loci protectionis*, while contractual issues are regulated by the *lex contractus*. Similarly, they would accept unquestioningly that the parties are free to designate a law of their choosing for their agreement. Attention may instead be gainfully directed to two contentious problems that beset the application of these principles.

First, the Project could elaborate guidelines to streamline and rationalize the process of characterization required to distinguish between matters that are deemed proprietary and those which are deemed contractual in IP license contracts. Though this distinction appears pellucid in theory, its clarity can be fatally wounded in the maws of a complex transaction.  

Secondly, Member States could consider developing a special rule for IP license agreements to determine the law governing contractual matters, absent a choice-of-law clause. In this task, they would have the opportunity to benefit from the conceptual arsenal developed by several academic endeavors that have already preceded them on this journey over the past two decades: the American Law Institute (“ALI”) Intellectual Property Principles,  the European Max Planck Group on Conflict of Laws in Intellectual Property (“CLIP”) Principles,  the Korean Private International Law Association (KOPILA) Principles,  the Joint Japanese-Korean (“J-K”) Principles and the Transparency Proposal.

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Each of these academic endeavors contains a bespoke provision for the determination of the law applicable to IP contracts bereft of a choice-of-law clause. On the surface, they all accept the closest connection rule as the solution best suited to resolve the private international law conundrum under consideration.\textsuperscript{181} Alas, for the operation of this principle they rely on presumptions and interpretative factors that are not aligned and thus can yield diverging outcomes.\textsuperscript{182}

Ultimately, it would be for Member States to decide whether to espouse one of the approaches developed by any of these academic endeavors or ambitiously attempt to craft an alternative ruleset that bridges the chasms dividing them. It is submitted that this would not be a challenging decision in terms of its process; all attention could be devoted to substantive discussion. Regrettably, it is hard to imagine that consensus would be easily won on a battlefield upon which positions have been entrenched for the past two decades.

Notably, the scope of the Project would decisively influence the approach to the present topic. An applicable law rule for IP licenses would not even be considered if private international law issues were out of scope. Furthermore, if the Project had a narrow scope, the palatability of this topic would be significantly reduced, as the notion of developing an applicable law rule restricted to a sub-group of all IP license agreements would imply additional fragmentation in an area where harmonization is desired above all.

III. THE FORM OF THE PROJECT

The preceding discussion on scope and substance offers a robust foundation from which to consider the form that the Project might assume and the associated implications.

Over the past fifty years, UNCITRAL has developed and adopted “texts” that can be divided into three distinct form-categories: legislative, contractual and explanatory. The first, UNCITRAL texts in legislative form, are addressed to legislatures and are designed to be adopted by states through the enactment of domestic legislation. The three most common incarnations of UNCITRAL texts in legislative form are: conventions, model laws and legislative guides.\textsuperscript{183} The trait that

\textsuperscript{181} See:\textsuperscript{181} \textsuperscript{181} See §\textsuperscript{181} 315(2) ALI Principles, Article 3:502 (1) CLIP Principles, Article 23.1 Kopila Principles, Article 306 (3) Transparency Proposal, and Article 20.2 Waseda Principles.

\textsuperscript{182} See:\textsuperscript{182} See:\textsuperscript{182} \textsuperscript{182} See De Werra, supra note 8 at 332–33; Otero García-Castrillón, supra note 153 at 442–45 (accepting De Werra’s analysis and expanding it).

\textsuperscript{183} UNCITRAL has also adopted model provisions, albeit infrequently; see for example
distinguishes them is their manner of interaction with the legal order of states.

If the Project were conceived as a convention, it would be configured as a multilateral instrument establishing a set of binding rules across ratifying states. Its function would be to repeal the rules currently governing IP license agreements at national level, replacing them with an internationally uniform legal regime.\textsuperscript{184}

If Member States opted for a model law instead, the Project would be developed as a soft law instrument setting out a “pattern”\textsuperscript{185} for a domestic statute.\textsuperscript{186} It would serve as a prefabricated template that states could unilaterally inject into their legal orders, according to their own timetable and priorities. Even for states not interested in adopting the entirety of this hypothetical model law, such a document would yield useful points of reference for less ambitious reform interventions.\textsuperscript{187}

Alternatively, the Project could take the form of a legislative guide. Such a text would table a reasoned commentary on the legal issues presently affecting IP license agreements, consider alternative normative approaches, and articulate principles and recommendations to overcome them. If the Project were realized as a legislative guide, it would serve as

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a comprehensive source of information for states considering legal reform initiatives and facilitate international harmonization.\textsuperscript{188}

Looking to the second form-category, UNCITRAL texts in contractual form are addressed to contracting parties, providing them with model contract clauses or special rules.\textsuperscript{189} Texts in this form rely entirely on party autonomy: they offer model terms or rules that can be directly or indirectly incorporated into contracts without modification.

If Member States chose this form for the Project, they would craft model clauses, based on recognized international best practices, which licensors and licensees could include in their contracts to govern specific issues.\textsuperscript{190}

The third form-category, UNCITRAL texts in explanatory form, expressly target contracting parties and aim to provide them with actionable indications regarding select international trade law transactions. Texts in this form typically appear in one of two\textsuperscript{191} possible embodiments: legal guides or practice guides. The primary difference between them lies in the type of information that they include.

If the Project were structured as an explanatory legal guide, it would offer a comprehensive analysis of the negotiation, drafting and performance of IP license agreements based on the extant legal framework. By contrast, if it were fashioned as a practice guide, the emphasis of the Project would be on elucidating practical aspects of these transactions, such as detailing conduct that parties can follow to expedite negotiations and simplify contract performance.

Having reviewed the different forms that can be assumed by UNCITRAL texts, attention can turn to the process for their selection. Member States are not bound by established rules or a mandatory procedure; their decision is customarily based on a plethora of considerations that includes social, political, economic and legal factors.


\textsuperscript{191} A third type of explanatory text are interpretative declarations. These instruments provide the official interpretation of a previously adopted UNCITRAL instrument. To date, none have been adopted.
Though any prediction regarding the dynamics of this decision-making process is necessarily conjectural, one might speculate that it would break down into two stages.

Member States would be required to choose which form-category would be best suited to the Project. It is submitted that a rigorous decision-making process would be contingent on two connected factors.

First, UNCITRAL texts in legislative form differ ontologically from those in a contractual and explanatory form. The former are addressed to institutions that hold legislative power. Their purpose is to inspire law reform across jurisdictions, achieving both amelioration of national legal frameworks and international harmonization. This nature is shared by all incarnations in which UNCITRAL texts in legislative form are expressed, despite the differences in the manners in which they pursue law reform. By contrast, UNCITRAL texts in contractual and explanatory forms accept the existing national legal frameworks and refrain from attempting to amend them. Their purpose is to influence both the manner in which private parties structure and perform their transactions, and how the judiciary approaches their enforcement. The ultimate ambition is to improve and harmonize business practices.

It would be for Member States to appraise where the greater benefit might lie: in an UNCITRAL text addressed to legislatures and focused on legislative reform, or on one directed to private parties and aimed at influencing their market behavior. At first glance, it might be tempting to favor a form-category that does not require legislative reform, owing to the well-documented difficulties associated with such processes. Nevertheless, a Project concentrated on influencing how parties structure and perform their IP licenses might have limited traction due to the varying limitations imposed by national legislations on the initiatives of licensors and licensees. Accordingly, heedful consideration of the intended scope of the Project would be paramount to any discussion on its form.

Secondly, once agreement had been reached on the form-category for the Project, it would be for Member States to assess which incarnation would be best suited for its purposes. If they opted for a text in legislative form, it is submitted that neither a convention nor a model law would be an adequate choice. These instruments do not afford the degree of flexibility that Member States would require to arrive at compromise solutions bridging the divergences that presently characterize the

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international landscape for IP licensing.

Only a legislative guide would offer the necessary elasticity for a positive outcome. Notably, the legislative recommendations enshrined in instruments of this type are expressed in looser terms than those demanded by the articles of a model law or a convention; similarly, a legislative guide can recommend a range of alternative normative solutions to confront contentious policy choices, rather than having to establish a single rule, as is the case in conventions and model laws. A model law, and perhaps even a convention, might follow in the future, but a legislative guide would have to serve as a bridgehead towards consensus.

By contrast, if Member States decided that the Project should not take a legislative form, it is submitted that a text in explanatory form structured as a legal guide would be the preferable option. The rationale is similar to that previously offered in support of a legislative guide. The Project would greatly benefit from assuming a form that allowed for flexibility, favored compromise solutions and offered Member States the opportunity to explain their policy choices in accompanying commentary. Neither a contractual text nor an explanatory practice guide would satisfy these requirements.

IV. CONCLUSION

IP licenses are the leading lady of the information age. The strategic and economic significance of this contract archetype have grown exponentially over the past 40 years. Under this glaring spotlight, it has become increasingly apparent that the legal framework governing these voluntary exchanges is not supportive of the role that they play in the modern digital environment. As the world becomes ever more connected, the shortcomings of this body of rules will grow ever more apparent, and calls for reform ever louder.

UNCITRAL has been quietly appraising and evaluating the international legal framework governing IP license contracts for the past ten years, with Member States pondering the features that a project in this area of commercial law might assume.

At present, this initiative remains at an early stage of its gestation. In the hope of nurturing its growth, this paper has ventured to explore its possible scope, content and form. The objective has not been to articulate or advocate a single, concrete proposal, but rather to first identify the categories of legal issues that Member States would face in the elaboration of this project, then lend color to the types of decision-making processes required for consensus solutions.

In charting the hypothetical scope of such a project, it was submitted
that Member States should assess two legal dimensions coextensively. One would involve electing either to examine all rules governing IP licenses holistically, or to limit the ambit of the analysis to those stemming from predetermined branches of the law. The other would require choosing whether to bring all license types into scope, or merely those with a predetermined set of features.

Subsequently, attention shifted to substance. Select facets of the legal regime governing IP licenses were reviewed, ranging from the norms regulating the licensing of jointly-owned IP rights to the conflict of law rules that apply to these agreements, encountering pre-contractual negotiations, formation, content, contract construction and registration along the way.

Three issues emerged consistently. First, the body of rules governing licenses suffers from a degree of under-elaboration, as the intersections of IP and contract law frequently fail to generate norms that adequately cater to the peculiarities of these transactions. Secondly, national laws governing different types of IP rights establish licensing rules that diverge far more than can be justified by underlying distinctions in the protected immaterial goods. Thirdly, crucial aspects of IP licensing agreements are regulated heterogeneously across jurisdictions, severely hindering international transactions.

Two indications surfaced in the appraisal of the types of decision-making processes that would be conducive to the elaboration of unanimously-agreed solutions. First, the scope of the project would profoundly affect the types of issues confronted by Member States and the range of available normative solutions. Secondly, as Member States would often be grappling with issues that arise at the intersection of multiple branches of the law, substantial effort should be devoted to isolate the conceptual formants of the matters under consideration.

The lattermost element of this inquiry analyzed the possible alternative forms that this project might assume. The three form-categories developed by UNCITRAL for its texts were expounded in turn. It was posited that the main hurdle for Member States to overcome would be reaching a consensus on the angle from which they wish to approach the legal regime for IP license contracts. This issue is one of reform strategy. It would be for Member States to establish whether it would be more palatable to tackle the extant shortcomings of the framework for IP licensing by advocating legal reform, or rather through the development of model license agreements that rely on private law-making.

The preceding analysis provides fertile ground for reflection on potential future developments. It is submitted that the next step to advance the cause of an UNCITRAL project on the law of IP licensing is to articulate a concrete proposal. Ideally, it should be jointly authored by a
group of Member States; alternatively, it could be prepared by NGOs or a group of academics and practitioners, then submitted for the attention of UNCITRAL Member States.

Based on the findings of this paper, such a proposal should be built on two pillars. First, it should incisively delineate a scope that is both precisely defined from a legal perspective, and socio-economically palatable. As this would be UNCITRAL’s first foray into the law of IP licensing, temptations to cast this net too broadly should be resisted staunchly. Crucially, with regard to the areas of the law to be covered, it might be advisable to focus solely on contract law, IP law, and international private law; areas such as competition law, consumer law and labor law might be best left aside, owing to the elevated number of additional variables that they would bring to the fore. Equally, it might be advisable to exclude licenses which carry features that are treated in multifarious, manifestly different ways at a national level, as to include them would create difficulties irreconcilable a priori.

Secondly, this proposal should state lucidly the form-category that this project should assume, and substantiate its choice robustly. Based on the level of disharmony that presently characterizes national legal framework governing IP licenses, a text in legislative form might be the preferable option. It seems unlikely that an explanatory or contractual UNCITRAL initiative would successfully circumvent the obstacles raised by the numerous mandatory rules presently characterizing the law of several jurisdiction.

This proposal should also devote attention to substance. At this stage, it would be adequate to confine discussion to simply identifying the relevant subject matter to be covered within the suggested scope. The aspiration would be to express a level of detail sufficient to describe the key matters that would be covered, yet without depriving Member States of the necessary maneuvering space during subsequent negotiations.

Finally, as ever in international legal projects of this nature, political will and conviction would be integral to the favorable reception of this proposal by UNCITRAL. Any project seeking to address the law of IP licensing would inevitably encounter thorny negotiations, as it would be impossible to circumvent historically contentious legal postulates. This may at first glance render this project unappealing, particularly for those Member States that may be bruised by past, failed attempts to reform domestic IP licensing laws. Nevertheless, complexity alone should not deter Member States from striking boldly down this path, as the anticipated benefits of a coherent legal regime in this space would by far outweigh the hardships encountered in their pursuit.