

## Beschränkung der immaterialgüterrechtlichen Ausschliesslichkeitsrechte durch das Wettbewerbsrecht (Q 187)

### BERICHT DER SCHWEIZERISCHEN LANDESGRUPPE\*\*

#### I. Zusammenfassung

Der Konflikt zwischen den immaterialgüterrechtlichen Ausschliesslichkeitsrechten und dem Kartellrecht wurde mit dem Erlass eines neuen Artikels 3 Absatz 2 Kartellgesetz teilweise geregelt. Der Grundsatz, wonach Wettbewerbswirkungen, die sich ausschliesslich aus der Gesetzgebung über das geistige Eigentum, namentlich aus dem Patent- und Designrecht, worin die natio-

nale Erschöpfung gilt, ergeben, nicht unter das Kartellgesetz fallen, wurde dadurch eingeschränkt, dass Einfuhrbeschränkungen gestützt auf die ausschliesslichen Rechte des Patent- und Designinhabers nun der wettbewerbsrechtlichen Beurteilung unterstellt sind. Diese Gesetzesrevision, welche unter der Berücksichtigung der bundesgerichtlichen Rechtsprechung erfolgte, stellt eine Konkretisierung des Rechtsgrundsatzes von Artikel 2 Zivilgesetzbuch dar, wonach jedermann in der Ausübung seiner Rechte nach Treu und Glauben zu handeln hat. Im schweizerischen Recht finden Zwangslizenzen und weitere Beschränkungen der immaterialgüterrechtlichen Ausschliesslichkeitsrechte nur dort eine Rechtfertigung, wenn überwiegende öffentliche Interessen vorliegen. Die schweizerische AIPPI-Gruppe plädiert für die Beibehaltung der Beschränkung der immaterialgüterrechtlichen Ausschliesslichkeitsrechte durch das Wettbewerbsrecht nach dem Grundsatz von Treu und Glauben.

#### II. Introductory remarks

Swiss law governs a liberal economy in a liberal way – the economic players are relatively free to set their own rules, within reason.

One of the basic principles of Swiss law is that each person must exercise his rights in a reasonable manner and in good faith.

Art. 2 of the Civil Code reads: “Each person is bound to exercise his rights and fulfil his obligations according to the principles of good faith. The blatant abuse of a right is not protected by law”.

Furthermore, a person may not become bound in such a way as to jeopardise his personal development and progress.

Art. 27.2 of the Civil Code provides: “No person may alienate his personal liberty or impose restrictions on the enjoyment of his liberty to the extent that it is contrary to law and morality”.

The exercise of intellectual property rights may therefore be limited in certain ways by these general principles.

Swiss Competition Law may be better understood from this angle. The underlying rationale behind Swiss Cartel Law is not to achieve freedom of competition (even though such freedom is – to some extent – a welcome consequence of the restrictions imposed by that law on certain monopolistic behaviours), but to establish a well-balanced market, ban abusive behaviour and give producers, merchants and consumers the best possible compromise between a fair remuneration and a reasonably-priced product or service.

#### III. Questions

##### 1. State of substantive law

a) *The Groups are requested to indicate if the law of their country knows rules governing in general the relationship between the rules of competition and the intellectual property rights.*

As a principle, the Swiss Law on Cartels allows limitations resulting directly and exclusively from IP rights.

Art. 3.2 of the Cartel Law (CL) provides:

“Restrictions on competition, which result exclusively from the legislation on Intellectual Property are not subject to this law. However, limitations on imports which are based on IP rights, fall under this law”.

The last sentence was introduced in the 2003 amendment to the Cartel Law and applies to parallel imports.

Prior to that amendment, however, the Swiss Supreme Court had already established the rules applicable to parallel imports. In matters of trademarks and copyright, the Court had ruled in favour of applying the international exhaustion principle; i.e. if the goods had previously been commercialised anywhere outside Switzerland with the consent of the trademark owner, he was not entitled to prevent their import into Switzerland.

Concerning the import of patented goods, the Supreme Court had ruled that the national exhaustion principle should apply, so that the patent owner was entitled to prevent the unauthorized import of those goods into Switzerland.

The new Design Law does not set forth any rule regarding the exhaustion of rights; since the right holder controls any use of a registered design, and since the import of goods is part of the uses mentioned in the law, one may reasonably conclude that the national exhaustion rule should apply. The same reasoning can be relied upon with respect to Layout Designs (Topographies) of Integrated Circuits.

Trademark and copyright owners cannot rely upon their IP rights to prevent imports – therefore, art. 3.2 CL cannot be invoked against them.

Where patent or design owners try to prevent parallel imports on the basis of their registered rights, they fall under the scrutiny of the Cartel Law. Thus, in case they have a dominant position on the relevant market, they must ensure that they do not abuse such dominant position.

The Swiss Cartel Law also contains a list of agreements which are permissible notwithstanding the fact that they restrict competition. These include exclusive license agreements (art. 6,1, lit. d CL), in respect of which art. 3.2 CL limits the exemption – the licensor may impose certain restrictions to the licensee concerning the export to Switzerland of goods manufactured by the latter, within the limits imposed by the principle of non-abuse of a possible dominant position.

*b) The Groups are invited to indicate if previous to the adoption of the TRIPS, the legislation of their country knew the exceptions in particular founded on article A.4 of the Paris Union Convention, to the exclusive rights of patents, designs and models or copyright. The Groups must also describe the conditions and the effects of these exceptions. Finally, do the Groups have to indicate the justification of these exceptions and in particular if these exceptions were justified by requirements of the freedom of competition?*

Before the TRIPS Agreement came into effect in Switzerland, compulsory licensing was already well-recognised.

With regard to patent matters, the Swiss Patent Law (PL) not only set forth a rule corresponding to art. 5 A. 4 of the Paris Convention (art. 37 PL), but also granted the right for the inventor of a dependent invention to obtain a license from the owner of the basic patent, provided that the newer invention showed considerable technical progress or served a totally different purpose than the older one. The PL also granted the possibility to obtain further licenses if the existing ones did not allow sufficient supply in order to fulfil market needs (art. 38 PL) or to obtain a license if there was sufficient public interest (art. 40 PL).

Whilst these limitations on the patent holder's sovereignty had a positive influence on market competitiveness, this was not their principal justification – instead, the rationale for granting such compulsory licenses was of a technical (dependent invention) and macro-economic nature (market needs and public interest).

In addition to the Patent Law, the Law on Plant Varieties foresees the possibility of obtaining compulsory licenses provided there is public interest (art. 22).

The Law on Layout Designs (Topographies) contains an express provision authorizing copies for research and teaching purposes (art. 7) and for the commercial use of semiconductor products which contain an illegal copy of the topography, but were acquired in good faith (art. 8).

The 1993 Swiss Trademark Law introduced the so-called “guarantee mark”, i.e. trademark used by several (independent) undertakings for the purpose of designating products or services of a certain quality or origin. The owner of that mark is obliged to grant a license to any party who can offer products or services corresponding to the required characteristics (art. 21.3).

In many instances, the Copyright Law limits the owner’s right to directly collect payment for the use of his audio or visual work by third parties, favouring instead the use of copyright collecting societies – in particular for rental fees payable by video libraries, libraries, and the like (art. 13), fees payable for private use (art. 20), broadcast re-transmissions (art. 22), broadcast or re-transmission or public representation of records or videos (art. 35). A specific compulsory license is foreseen for record producers having a place of business in Switzerland with respect to recordings which are available on the Swiss market (art. 23).

*c) The Groups are invited to indicate if articles 13, 30 and 31 of the treaty TRIPS gave place to the establishment of legal rules defining the exceptions being able to be brought to exclusive rights of copyright, patent, designs. The Groups should in this case indicate the conditions for application of these exceptions and their consequences. And the groups should indicate the justification of these exceptions and in particular if these exceptions were justified by requirements of the freedom of competition.*

As previously explained in the introductory remarks, art. 13 and 30 TRIPS did not require Switzerland to make any fundamental amendments to its competition laws, which are per se aimed at a well-balanced market economy.

Art. 31 TRIPS, however, led to some amendments to the compulsory licensing provisions of the Patent Law. Art. 36–40 PL were slightly modified and two new provisions, art. 40a and 40b, were introduced.

Pursuant to art. 40a PL, a compulsory non-exclusive license for inventions in the field of semiconductor technology may only be granted in order to remedy certain practices which have been held as anti-competitive following a judicial or administrative process (art. 31 lit. k TRIPS).

As for Art. 40b PL, it reflects the provisions of art. 31 TRIPS.

The new Design Law, which entered into force in July 2002, does not contain any stipulation regarding compulsory licensing or any other limitation on the rights holder.

*d) The Groups are invited to indicate if such limitations apply as regards to trademarks and which are the conditions, the consequences and the possible justification.*

As previously explained, there is an obligation for the holder of a so-called “guarantee mark” to allow that mark to be used by certain parties (see question 3.2 above).

The primary purpose of that stipulation is not the freedom of competition, but equal treatment of all competitors.

*e) The Groups are invited to inform if the existence of intellectual property rights constitutes a justification to some practise regarded in general as anticompeting, such as the refusal to sell or others?*

Under Swiss law, the refusal to sell is a citizen’s constitutional right; he may freely chose to contract (or not) with whoever he wishes.

If, however, the refusal to sell emanates from a very powerful undertaking holding a dominant market position, such refusal may constitute an abusive behaviour within the meaning of art. 7 CL.

Nonetheless, the refusal to sell may be admissible within the framework of selective distribution systems, even if declared by a dominant undertaking.

As already stated, exclusive license agreements are allowed – within the framework of such exclusivity, either party may refuse or be prohibited from selling certain materials or objects which are directly related to the patented invention, or may be prohibited from selling the licensed products in certain territories, etc.

*f) The Groups are invited to indicate if some of the attributes of the intellectual property rights, such as the duration of these rights, are considered in their country as raising problems from the point of view of the exercise of the freedom of competition.*

In Switzerland, the attributes of IP rights, such as duration, are not considered to be impediments to freedom of competition.

*g) The Groups are finally invited to formulate any other observation concerning the relationship which may exist in the substantive law of their country between the exclusive rights of the intellectual property and the rules relating to the respect of the freedom of competition.*

Certain observations are already contained in our introductory remarks.

The exercise of rights – be the monopolies – is subject to the prohibition of abusive behaviour, the requirement for good faith and balanced markets. These principles apply equally to the use of IP rights and to the right to freely compete.

## 2. Proposals for the future

*a) The Groups are invited to indicate if any modifications of the exclusive rights of patent rights are desirable in aim to reinforce the freedom of competition. On which attributes of the exclusive rights of intellectual property these modifications should carry (duration, exclusiveness, specific evidence etc. ...)? How then it would be advisable to preserve the monopoly resulting from the exclusive rights of intellectual property?*

The Swiss legislator intends on amending the present Patent Law. The suggested amendments include a series of limitations on the patent owner's right to freely exploit the patent. According to art. 9 of the proposed amendment, the patent would not have any effect with respect to:

- *the use of the patented invention for:*
- *private, non- commercial purposes,*
  - *research and experiments,*
  - *teaching and schooling purposes,*
  - *the use of biological material for breeding purposes or for the development of new plants,*
  - *the use of biological material accidentally harvested in agriculture,*
  - *the multiplication of biological material if it results from a normal application of the patented invention (art. 9 lit. b 3 PL amended),*
  - *the use of a patented invention in connection with products, which are covered by other IP rights, if the patented part only fulfils a subordinate function (e.g. the patented locking device on a perfume bottle) (art. 9 lit. b 2 PL amended).*

The proposed amendment grants a compulsory non-exclusive license to the scientist who uses a patented process or instrument as a mean for research (art. 9 lit. a PL amended).

It also grants a non-exclusive license for the production and export of certain pharmaceutical products in countries where there is an insufficient supply of medication for certain diseases, but only in quantities sufficient to cover that country's needs (art. 40 lit. c PL amended).

The Swiss group of AIPPI, whilst not being opposed to these amendments, is of the opinion that they are not necessary to ensure free competition.

*b) The Groups are also invited to wonder about the possible application of the concept of compulsory licence, licence ex-officio or improvement licence as regards patents, copyright, designs and models or the trademarks.*

The existing restrictions on a patent holder's monopoly are either standard and well-recognized practices (private use or research) or justified by the humanitarian mission of developed countries (export of medications to certain countries); they are not introduced in order to promote freedom of competition, even if they do have such an effect.

*c) The Groups are requested to also formulate any other suggestion concerning the Question.*

The Swiss AIPPI Group is not of the opinion that compulsory licensing is the most appropriate means to enhance free competition.

The Swiss way of banning market behaviours which are contrary to good faith is in our opinion more efficient and allows a more suitable repression of abusive behaviour.

\* Kamen Troller (Vorsitzender), Lorenz Ehrlé, Lorenza Ferrari Hofer, Christoph Gasser, Urs Hess-Odoni, Pierre-Alain Killias, Georg Rauber, Rainer Schalch, Egbert Wilms.