

SLOVAK UNIVERSITY OF AGRICULTURE IN NITRA

Faculty of European Studies and Regional Development

Department of Law



# EU INTELLECTUAL PROPERTY

Innovations and Intellectual Property  
in various fields of human life



Proceedings of papers from an International Scientific Conference

**DEPARTMENT OF LAW  
FACULTY OF EUROPEAN STUDIES AND REGIONAL DEVELOPMENT  
SLOVAK UNIVERSITY OF AGRICULTURE IN NITRA**

*International Scientific Conference*

**EU INTELLECTUAL PROPERTY**

(Innovations and Intellectual Property in various fields of human life)



With the support of the  
Erasmus+ Programme  
of the European Union



*April 30th 2021 in Nitra*

**Title:** EU Intellectual Property  
(Innovations and Intellectual Property in various fields of human life)

**Publication type:** Conference Proceedings

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The international scientific conference is funded from the European Union Project Jean Monnet Module EU Intellectual Property no. 599683-EPP-1-2018-1-SK-EPPJMO-MODULE, and supported by World Union of Agricultural Law - Union Mondiale des Agraristes Uniersitaires (UMAU).

This publication was approved by the Rector of the Slovak University of Agriculture in Nitra on 3rd June, 2021 as a proceedings of papers from a scientific conference on a CD.

**ISBN 978-80-552-2339-1**

## **CONTENT**

FOOD AND COPYRIGHT IN THE EU AND US LAW .....	4
THE LEGAL FRAMEWORK FOR COPYRIGHT PROTECTION IN KENYA, IN DIGITAL AGE.....	15
THE EUROPEAN COMMISSION EXPERT GROUP'S TAKE ON STANDARD- ESSENTIAL PATENTS: A SHORT COMMENTARY FOR A LONG REPORT .....	32
SELECTED LEGAL AND ECONOMIC ASPECTS OF PROTECTING OF BIOTECHNOLOGICAL INVENTION FROM THE PERSPECTIVE OF POLISH LAW ...	50
PLACE BRANDING AND REPUTATION - A CASE OF THE POLONINY NATIONAL PARK .....	58
DIGITAL REGENERATION OF VILLAGES AND URBAN AREAS IN EUROPE: THE ITALIAN PERSPECTIVE.....	67
REINFORCEMENT THE POSITION OF AN AGRICULTURAL PRODUCER IN THE FOOD SUPPLY CHAINS ON THE BASIS OF INTELLECTUAL PROPERTY LAW INSTRUMENTS .....	75
LICENSE AGREEMENTS.....	86
THE TRIPS CONVENTION AND ITS CURRENT IMPORTANCE FOR THE PROTECTION OF INTELLECTUAL PROPERTY RIGHTS .....	98
DEVELOPMENT OF COWORKING CENTERS IN THE REGIONS OF SLOVAKIA....	109
INNOVATIVE POSSIBILITIES OF USING MEDIUM AND LESS PRODUCTION SOILS IN SLOVAKIA AS SUPPORT FOR REGIONAL BIOENERGETICS .....	121
NEGATIVE PHENOMENON OF THE LAND GRABBING? ASSUMPTIONS, CAUSES AND POSSIBLE IMPACTS OF ITS EXISTENCE, LITERATURE REVIEW .....	129
INNOVATION ACTIVITIES OF SMALL AND MEDIUM ENTERPRISES AND ITS PROTECTION IN THE SLOVAK REPUBLIC .....	141
SOME KEYS OF READING TO INTERPRET THE EU-MERCOSUR AGREEMENTS ON GEOGRAPHICAL INDICATIONS/ .....	150
APPLICABLE LAW IN INFRINGEMENTS OF THE RIGHT TO A TRADE NAME.....	155

# **FOOD AND COPYRIGHT IN THE EU AND US LAW**

## **JEDLO AKO PREDMET AUTORSKÉHO PRÁVA V EU A USA**

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### **Abstract**

Copyright protection is also important in the field of gastronomy. However, this area is not examined in detail, in particular by European legal doctrine and the case law of the European courts, including the Court of Justice of the EU. The aim of the article is to summarize the areas of gastronomy in which copyright can be applied and to point out the views of copyright protection in the case of recipes, cookbooks, serving food and finally their taste and odour. The case law of the American and European courts, as well as the legal doctrine of both continents, show that most recipes, unlike cookbooks, do not enjoy legal copyright protection, unless they are expressed as literary works in a description that meets the conditions of originality and creativity of the author. However, if the author of the recipe wants to protect its composition and production process, it is appropriate to use patent protection or protection of know-how. Food photos, in most cases, enjoy copyright protection. The food plating itself may be considered a work of applied art, provided that, in addition to its utility function, it also has an artistic expression which, in the case of European copyright protection, need not be strictly separated from the utility function of the food. On the European continent, the time has not yet come for the odour and taste of food to be considered a separate object of copyright protection.

### **Key words**

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copyright, patent, recipe, odour, taste, food plating

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### **Introduction**

The Slovak Copyright Act provides legal protection for any copyrighted work in the field of literature, art or science, which is original result of the author's creative intellectual activity perceptible to the senses, regardless of its form, content, quality, and purpose, form of expression or degree of completion. It then presents an exemplary list of the most common types of works such as a literary work, a verbal work, a theatrical work, a musical work, an audiovisual work, a work of fine art, an architectural work, a work of applied art, a cartographic work or another type of work of art or scientific work if it meets the conditions of above mentioned definition. There is a question if food works are capable to be protected as copyrighted work, mainly the food recipes, food taste and odour and food plating. There are usually refused the legal protection for such food attributes; however, there are few judgments of foreign national courts which are willing to protect the food by the Copyright Act if the legal definition of work is fulfilled, mainly the originality, creativity, perceptibility to the senses and a work belongs to the area of literature, science or art.

The objective of the paper is to discuss the protection of copyright for food, mainly for food ingredients and food processing including in the recipes, food plating and attributes of food such as taste and odour and try to give some answers to the questions to what extent the copyright law provides food protection. The paper is organised as follows: First, the author

describes the copyrightability of food recipes and collections of recipes. Second, the author discusses the copyrightability of food attributes such as taste and odour. Third, the author discusses the copyrightability of food plating as the results of the process of arranging and decorating food to enhance its presentation. Finally, the author draws conclusions on the extent of food copyrightability in the Slovak national law and in the EU law.

## Material and methods

The paper used the normative national and EU legal acts, the explanatory reports, relevant judgements of the national courts and the Courts of Justice of the EU and opinions from the scientific publications of lawyers and relevant public bodies.

There are used the methods of jurisprudence such as logical methods and formal legal methods, which are necessary for the interpretation of normative legal acts of the EU and sociological methods, especially methods of examining various documents that preceded or accompanied the emergence of normative legal acts as well as documents resulting from application practice in this area.

## Results and discussion

### 1. Copyrightability or patentability of food recipes

In generally, the food recipes are not protected by Copyright Act. A food recipe is usually a procedure according to which a dish can be prepared. A recipe usually consists of several components, such as the name of the food, information on the amount of ingredients, a description of the preparation from the ingredients, images of ingredients and illustrations of the prepared food. According to the Slovak Copyright Act, there is protected any copyrighted work in the field of literature, art or science, which is original result of the author's creative intellectual activity perceptible to the senses, regardless of its form, content, quality, and purpose, form of expression or degree of completion.<sup>1</sup> However, an idea, procedure, system, method, concept, principle, discovery, or information that has been expressed, described, explained, illustrated, or incorporated into a work is not considered to be the subject of copyright.<sup>2</sup> It is also a trend of other national legal copyright acts<sup>3</sup> and international treaties.<sup>4</sup> Therefore, most recipes containing a number of ingredients and the way they are processed are not subject to copyright protection, which could otherwise be considered a literary work.

The ingredients themselves and the amounts used cannot be subject to copyright protection, as they do not meet the criteria of originality and creativity required for works protected by copyright law.

A more complicated question arises in the way they are processed, but even here most recipes do not meet the requirement of originality and creativity if the processing of ingredients into a ready meal consists only of calculating the ingredients that need to be processed in a certain order. However, if the author of the recipe uses an artistic description of the recipe to describe the processing of the individual ingredients, then this process will also be covered by copyright. By the US judgments the recipes are copyrightable if the authors lace their directions for producing dishes with musing about the spiritual nature of cooking or reminiscences they associate with the wafting odors of certain dishes in various stages of preparation.<sup>5</sup>

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<sup>1</sup> § 3 of the Slovak Copyright Act no. 185/2015 Coll.

<sup>2</sup> § 5 (a) of the Slovak Copyright Act no. 185/2015 Coll.

<sup>3</sup> e.g. 17 U. S. Code § 102

<sup>4</sup> e.g. article 2 of WIPO Copyright Treaty (WCT)

<sup>5</sup> Publ'ns Int'l, Ltd. v. Meredith Corp., US Court of Appeals for 7th Circuit, February 21, 1996, Argued; July 8,

Although the Court of Justice of the EU has not ruled on this issue, it can be relied on by analogy in its judgment C-833/18, in which it set out the criteria for determining whether a product shape can benefit from copyright protection. According to the Court of Justice of the EU where the shape of the product is solely dictated by its technical function, that product cannot be covered by copyright protection.<sup>6</sup> It can be deduced that if a recipe consists only of ingredients and a simple procedure for processing them, the recipe will not be covered by copyright protection. THE Court of the Justice of the EU added that in order to establish whether the product concerned falls within the scope of copyright protection, it is for the referring court to determine whether, through that choice of the shape of the product, its author has expressed his creative ability in an original manner by making free and creative choices and has designed the product in such a way that it reflects his personality.<sup>7</sup> By analogy, if the author expresses his creativity in the form of a description of the processing of individual ingredients and describes the recipe process in an original way to reflect his personality, the recipe can be protected by copyright. It follows that each recipe must be assessed in the light of all the relevant aspects of the present case, as they existed when that subject matter was designed, irrespective of the factors external to and subsequent to the creation of the product.<sup>8</sup>

Finally, the subject of copyright may also be images and illustrations, which are usually presented together with recipes. However, the subject of copyright protection is not any photographs, but only photographic works. According to the case law of the Court of Justice, a photograph can be protected by copyright if such photograph is an intellectual creation of the author reflecting his personality and expressing his free and creative choices in the production of that photograph.<sup>9</sup> It follows that it is not easy to distinguish whether a given photograph is a work. An expert opinion is usually required. As it is not possible to determine with certainty without an expert opinion whether a work is a photographic work, no photographs should be published, whether in books, magazines or on websites, without the permission of their authors.

While recipes usually do not enjoy copyright protection, recipe collections or cookbooks, on the other hand, are copyrightable in most cases, despite the fact that they are not characterized by great originality and creativity. According to European law and thus also Slovak copyright law, a cookbook is a database, which represents a set of mutually independent works, data or other mutually independent materials systematically or methodically arranged and individually accessible by electronic or other means, regardless of the form of its expression.<sup>10</sup> If the method of selecting or arranging the contents of the database is the result of the author's creative intellectual activity, it is an author's work, which is also referred to as a collective work.

Finally, we can conclude that even if the recipe is the subject of copyright protection, this applies only to the manner of its expression; i. e. copyright protects its description in the form of a literary work, not the very composition and process of food production. It is sufficient for another entity to take over the ingredients and the processing them will describe in its own words and the copyright will be not infringed because an idea, procedure, system, method, concept, principle, discovery, or information that has been expressed, described, explained, illustrated, or incorporated into a work is not considered to be the subject of copyright.

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<sup>6</sup> 1996, Decided, No. 95-3485, 95 -3530

<sup>7</sup> Judgement of the ECJ, June, 11, 2020; C-833/18 SI a Brompton Bicycle Ltd v Chedech/Get2Get, point 33

<sup>8</sup> Judgement of the ECJ, June, 11, 2020; C-833/18 SI a Brompton Bicycle Ltd v Chedech/Get2Get, point 34

<sup>9</sup> Judgement of the ECJ, June, 11, 2020; C-833/18 SI a Brompton Bicycle Ltd v Chedech/Get2Get, point 37

<sup>10</sup> Judgement of the ECJ, December, 1, 2011; C- 145/10 Eva-Maria Painer v Standard Verlags GmbH and others

<sup>10</sup> § 130 of the Slovak Copyright Act no. 185/2015 Coll.

If the author of the recipe wants to protect the composition and process of food preparation, it is appropriate to consider legal protection in the form of industrial property rights. Legal protection for inventions or know-how is possible.

According to the Slovak Patent Act patents are granted for inventions in all fields of technology that are new, involve an inventive step and are industrially applicable.<sup>11</sup> The object of patent protection can be not only the product itself, in which the invention is embodied, but also the method of its production.<sup>12</sup> An example of legal protection granted to the composition of a food product and the method of its production is the European patent for long-lasting pastries for special nutritional purposes and the method of its production granted by European Patent Office.<sup>13</sup> From the above, it could seem as a viable solution to protect the composition and the method of preparation of various recipes in the form of a patent.

However, in European countries, all the above criteria are required in order for the invention to be patentable. We believe that it will be particularly difficult to carry out the inventive step in order to be able to patent the recipe. According to the Slovak Patent Act, an invention is considered to be the result of an inventive step if it does not follow from the state of the art in a obvious manner for the person skilled in the art.<sup>14</sup> A combination of generally known and highly authoritative sources, such as textbooks, manuals, monographs of important experts, patent literature, etc., is usually considered to be obvious.<sup>15</sup> If such a combination is not found, it is an inventive step. On the contrary, such a solution is considered to be obvious if the effect achieved by the new use of a known object for a purpose for which it has not been used so far results only from the known properties of this object, such as simple material replacement.<sup>16</sup> It follows from the above that by adding a new ingredient to the recipe, although we get a new recipe, a new taste and possibly a new effect (the food will be healthier), it will not result in a generally unexpected result, i.e. a result that would not be apparent by the use of this new ingredient (e.g. the use of white yoghurt instead of mayonnaise to prepare a salad).

The US Court of Customs and Patent Appeals decided that “new recipes or formulas for cooking food which involve the addition or elimination of common ingredients, or for treating them in ways which differ from the former practice, do not amount to invention merely because it is not disclosed that, in the constantly developing art of preparing food, no one else ever did the particular thing upon which the applicant asserts his right to a patent. In all such cases, there is nothing patentable unless the applicant by a proper showing further establishes a coaction or cooperative relationship between the selected ingredients which produces a new, unexpected, and useful function.”<sup>17</sup> If the recipes lack creative results, it will not be patented.<sup>18</sup>

The disadvantage of patent protection is its duration compared to copyright. While in the case of copyright, the term of protection is for the life of the author and 70 years after his death, patent protection lasts only 20 years from the filing date of the application. Therefore, it is appropriate to consider the protection of recipes in the form of know-how or with the combination with know-how. However, know-how has no legal regulation. The most commonly used definition is in Commission Regulation No 330/2010 on the application of Article 101 (3) of the Treaty on the Functioning of the European Union to categories of

<sup>11</sup> § 5 (1) of the Act no. 435/2001 Coll. Patent Act

<sup>12</sup> § 13 (3) of the Act no. 435/2001 Coll. Patent Act

<sup>13</sup> European Patent granted by EPO to Slovak University of Agriculture in Nitra, no. EP3491925 Long Life Pastry for Specific Nutritional Purposes and Method of its Production (September, 28, 2020)

<sup>14</sup> § 8 of the Act no. 435/2001 Coll. Patent Act

<sup>15</sup> Industrial property Office of the Slovak Republic. Procedure methodology – patents, p. 55

<sup>16</sup> Industrial property Office of the Slovak Republic. Procedure methodology – patents, p. 56

<sup>17</sup> Application of Levin, 178 F.2d 945 (C.C.P.A. 1949)

<sup>18</sup> see e.g. Arons, 2015

vertical agreements and concerted practices. According to this know-how' means a package of non-patented practical information, resulting from experience and testing by the supplier, which is secret, substantial and identified: in this context, 'secret' means that the know-how is not generally known or easily accessible; 'substantial' means that the know-how is significant and useful to the buyer for the use, sale or resale of the contract goods or services; 'identified' means that the know-how is described in a sufficiently comprehensive manner so as to make it possible to verify that it fulfils the criteria of secrecy and substantiality.<sup>19</sup> In the protection of know-how, preventive legal protection is appropriate, which may be reflected in the obligation to maintain the confidentiality of the recipe, which can be appropriately regulated in the organization's internal regulations, employment contracts with employees or license agreements with business partners.

## 2. Taste and odour of food

According to the Slovak Copyright Act, there is protected any copyrighted work in the field of literature, art or science, which is original result of the author's creative intellectual activity perceptible to the senses, regardless of its form, content, quality, and purpose, form of expression or degree of completion.<sup>20</sup> There is a question as to whether the taste or odour of food, which are perceptible to the human senses, could be protected by copyright. The case law of the European courts is not uniform in this respect. For example, the French Court of Cassation does not grant copyright protection to the odour of perfume, from which it can be inferred by analogy that even the odour of food will not be eligible for copyright protection. According to the French Court of Cassation, odour of perfume, which is based on the simple implementation of know-how, does not constitute a form of expression which could benefit from the protection of intellectual works protected by copyright.<sup>21</sup> On the contrary, the Netherlands court, the Hoge Raad, acknowledged in its judgment that an odour, including a combination of odours, may qualify for copyright protection. In addition to the incomplete designation of the types of works, the (Dutch) Copyright Act also contains a general description of what should be understood as a "work" within the meaning of this Act, and does not prevent subsumption of odour under the notion "work." When asked whether the odour is eligible for copyright protection, the decisive factor is whether it is a work that is perceptible to the human senses and whether it has its original character and contains the author's personality. Circumstances in which the characteristics of the human sense of odour limit the ability to distinguish odours, and that the degree to which individual odours differ vary from person to person, do not alter this statement, nor does the fact that a particular odour means that not all provisions and restrictions in copyright law may apply in full.<sup>22</sup>

The different views of national courts on the position of copyright protection were a purpose to start a preliminary ruling before the Court of Justice of the EU in case Levola.<sup>23</sup> In this case, however, the odour of the food was not addressed, but its taste. In that situation, the Court examined whether the taste of a food fell within the concept of a work within the meaning of Directive 2001/29. In that regard, two cumulative conditions must be satisfied first, the originality of the work in the sense that it represented the author's own intellectual creation and, second, the elements which are an expression of such creative intellectual activity of the author of the work.<sup>24</sup> It is the expression and not the idea, procedure, method

<sup>19</sup> Article 1 (g) of Commission Regulation No 330/2010 on the application of Article 101 (3) of the Treaty on the Functioning of the European Union to categories of vertical agreements and concerted practices

<sup>20</sup> § 3 of the Slovak Copyright Act no. 185/2015 Coll.

<sup>21</sup> Cour de Cassation, civile, Chambre commerciale, 10 décembre 2013, 11-19.872, Inédit; FR:CCASS:2013:CO01205

<sup>22</sup> ECLI:NL:HR:2006:AU8940 Hoge RaadC04/327HR

<sup>23</sup> Judgement of the ECJ, November, 13, 2018; C-310/17 Levola Hengelo BV v. Smilde Foods BV

<sup>24</sup> Judgement of the ECJ, November, 13, 2018; C-310/17 Levola Hengelo BV v. Smilde Foods BV, points 35-37

that may be the subject of copyright.<sup>25</sup> The Court of the Justice of the EU inferred from this that a work must necessarily be expressed in a manner which makes it identifiable with sufficient precision and objectivity, even though that expression is not necessarily in permanent form.<sup>26</sup> The taste of a food product cannot, however, be pinned down with precision and objectivity. Unlike, for example, a literary, pictorial, cinematographic or musical work, which is a precise and objective form of expression, the taste of a food product will be identified essentially on the basis of taste sensations and experiences, which are subjective and variable since they depend, *inter alia*, on factors particular to the person tasting the product concerned, such as age, food preferences and consumption habits, as well as on the environment or context in which the product is consumed.<sup>27</sup> Moreover, it is not possible in the current state of scientific development to achieve by technical means a precise and objective identification of the taste of a food product which enables it to be distinguished from the taste of other products of the same kind.<sup>28</sup> On that ground, the Court refused to grant copyright protection to the taste of food. We would expect the Court to examine the originality of the work and the creativity of the author in relation to the taste of the food and also whether the taste can be perceived as a literary, scientific or artistic work. Instead, it requires the precise and objective identification of the taste of a food, which lacks the technical means. The Berne Convention for the Protection of Literary and Artistic Works includes that the term "literary and artistic works" includes all works of literary, scientific and artistic character, whatever may be the mode or form of its expression. It shall, however, be a matter for legislation in the countries of the Union to prescribe that works in general or any specified categories of works shall not be protected unless they have been fixed in some material form.<sup>29</sup> Similarly, the Slovak Copyright Act requires a protected work in the field of literature, art or science is original result of the author's creative intellectual activity perceptible to the senses, regardless of its form, content, quality, and purpose, form of expression or degree of completion.<sup>30</sup> No legal norm, including European Union law,<sup>31</sup> requires the condition of precise and objective identification of the work, but instead states "regardless of the form of its expression." Rather, we tend to believe that the taste of food is only a way or the form of expression of the work that can be perceived by the human senses, not the work itself, therefore it cannot be the subject of copyright and neither the taste nor the odour of the food, regardless the precise and objective identification of the taste or odour. Moreover, the need for such identification by technical means goes beyond the interpretation of what is required by national and international legal standards defining the work and its attributes. The concept of a work is also not defined in Union law and in the case law of the Court of Justice we find only the attributes that a work worthy of copyright protection should meet, such as intellectual creations,<sup>32</sup> original in the sense that they are their author's own intellectual creation.<sup>33</sup> The Court thus had a unique opportunity to clearly define the work in order to be covered by copyright protection in the EU law.

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<sup>25</sup> article 2 of WIPO Copyright Treaty (WCT); article 9 (2) of Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS)

<sup>26</sup> Judgement of the ECJ, November, 13, 2018; C-310/17 Levola Hengelo BV v. Smilde Foods BV, point 40

<sup>27</sup> Judgement of the ECJ, November, 13, 2018; C-310/17 Levola Hengelo BV v. Smilde Foods BV, point 42

<sup>28</sup> Judgement of the ECJ, November, 13, 2018; C-310/17 Levola Hengelo BV v. Smilde Foods BV, point 43

<sup>29</sup> Article 2 of The Berne Convention for the Protection of Literary and Artistic Works

<sup>30</sup> § 3 of the Slovak Copyright Act no. 185/2015 Coll.

<sup>31</sup> e. g. C-5/08, points 33-37; C-393/09; C-403 / 08, points 97 and 155; C-145/10, point 87

<sup>32</sup> e. g. Judgement of the ECJ, July, 16, 2009, C-5/08 Infopaq International A/S v Danske Dagblades Forening, point 34

<sup>33</sup> e. g. Judgement of the ECJ, July, 16, 2009, C-5/08 Infopaq International A/S v Danske Dagblades Forening, point 35

### **3. Food plating and copyright**

Many gastronomy experts can serve and arrange food on a plate really unusually. Many restaurant visitors have recently become accustomed to photographing more and more often the food they bring, for example, to preserve the gourmet holiday experience. The question arises as to whether these proceedings do not infringe copyright by making copies of a work without the consent of its author. In other words, the question is whether the food served on a plate can be considered a work within the meaning of copyright law. This issue is being addressed by a more American professional community from a variety of scientific disciplines, particularly philosophy, aesthetics, and law, compared to the European scientific and artistic spheres.

According to the US Copyright Law a work is copyrightable if it includes original works of authorship, artistic aspects separable from utilitarian function and the work of art is fixed in a tangible medium.<sup>34</sup> On the other hand, under Slovak law and in accordance with the case law of the Court of Justice<sup>35</sup> and international treaties<sup>36</sup> a property is considered to be a work if it meets the attributes of the work. First, the work should be in the field of literature, art or science. Second, the work is original result. Third, it is a result of the author's creative intellectual activity. Fourth, the work is perceptible to the senses, regardless of its form, content, quality, and purpose, form of expression or degree of completion. Unlike US law, the fixation of a work on a tangible medium is not required, nor is there a condition for the separation of artistic and utilitarian aspects of the work of art. In our conditions, it is sufficient if the intangible asset falls within the field of art (or literature or science), regardless of the separation of the utility and artistic function of the work. The question arises if the food plating is a work in the field of art because we can exclude without further analysis the field of literature and science.

As with recipes and food plating, most meals served will not enjoy copyright protection as they will not be considered a work of art. The question is whether food plating can be included in the field of art at all.

However, culinary “art” is not usually mentioned among the branches of arts. The three classical branches of art are painting, sculpture and architecture; moreover, music, theatre, film, dance and other performing arts together with literature are included in a broader definition of art. However, it is not possible to find universal definition of art. Ruckstuhl defined work of art as every human work made, in any language, with the purpose of expressing, or stirring, human emotion; and a work of art is great in ration of its power of stirring the highest emotions of the largest number of cultured people for the longest period of time.<sup>37</sup> Robert Belton concluded that “all the definitions offered over the centuries include some notion of human agency, whether through manual skills (as in the art of sailing or painting or photography), intellectual manipulation (as in the art of politics), or public or personal expression (as in the art of conversation).<sup>38</sup> Some American philosophers explain how the food can be considered as art. Elizabeth Telfer wrote in her work *Food for Thought: Philosophy and Food* that a piece of art should be an object capable of eliciting a disintegrated or non-instrumental reaction via the human senses and food can elicit aesthetic reactions in tastes and smells. She added that food is art when it is “intended or used wholly or largely for aesthetic consideration.”<sup>39</sup> It means, the food is art if the food is intended not only to just to fill the basic human needs (such as to appease hunger) but also to savour,

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<sup>34</sup> 17 U. S. Code § 101

<sup>35</sup> e.g. C-5/08, points 33-37; C-393/09; C-403/08, point 97, 155; C-145/10, point 87

<sup>36</sup> Berne Convention, TRIPS, WCT

<sup>37</sup> Ruckstuhl, 1916.

<sup>38</sup> Belton, 1996

<sup>39</sup> Telfer, 2012

appraise or think about the food. However, Telfer added that art of food is simple and minor one because of three major limitations of food: food is necessarily transient (a work of food art will no longer be around very long to be contemplated), it cannot have meaning (painting and literature tell us something about the world and ourselves and we can see the world and ourselves in the light of ways in which they have been depicted in the arts but we cannot do either of these things with food; however, art of food creates its own world of tastes and smells; another kind of meaning is expressed emotion; whereas in music the emotion is expressed in the product itself, in food the emotion is only the motive behind the product) and it cannot move us (she added that good food can excite us, cheer us with a kind of warmth and joy but cannot shake us in that way of which the symptoms are tears or fear).

Caroline Korsmeyer added one more limitation that precludes development of medium of food into an art. The formal arrangements and expressive range possible are far more restricted in food than in the fine art. She agrees with the other three limitations introduced by Telfer. She explained that food is transient. While recipes may linger, actual meals are consumed and their remnants disposed of and therefore food cannot garner the studied appreciation over time. The third limitation is that foods do not have meaning. Finally, food cannot express emotion.<sup>40</sup> Caroline Korsmeyer comes to the conclusions that food does not qualify as a fine art, however, culinary art can still be considered a minor or a decorative art or perhaps a functional or applied art.<sup>41</sup> The fine achievements of the cook need to be understood in related and overlapping ways that also acknowledge and preserve the distinctive roles that foods, tastes, and eating may assume.<sup>42</sup> Douglas observes that because food has a practical function, nourishment, it is appropriately grouped with the applied arts such as clothing, architecture, and utensils, rather than with the fine arts.<sup>43</sup> She believes the display function of food and its occasional dissociation from nourishment is reason to class certain types of foods with the decorative arts.<sup>44</sup> Caroline Korsmeyer added that “hence the aesthetic elements in food are those that are distinct from nutrition and are subject to pattern-making rules just like the fine arts. The sensory qualities of food are a big part of its aesthetic aspect. Food can have its own distinctive patterns of acceptable textures, smells, tastes, and colours.”<sup>45</sup> The food plating or dishes are regarded as works of applied art or works of artistic craftsmanship that encompass all original works that are intended to be or have been embodied in useful articles. They perform a dual function: expressing aestheticism and functioning as utilitarian objects to be used for some purpose.<sup>46</sup> According to Telfer, the distinction between art and craft is basically not between people but between different aspects of their work, which may be blended in different proportions; if the work contains a good deal of creativity it will be thought as art, if it contains a modest amount it will be thought as craft, but there is no sharp distinction.<sup>47</sup> Copyright protection extends to applied art only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.<sup>48</sup> In US, in an attempt to distinguish those creative works that rightly fall under the copyright law, the “useful articles” doctrine was developed by courts. The useful articles can be protected by the copyright law only if they include “features that can be identified separately from, and are capable of existing

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<sup>40</sup> Korsmeyer, 1999

<sup>41</sup> Korsmeyer, 1999

<sup>42</sup> Korsmeyer, 1999

<sup>43</sup> Douglas, 1982

<sup>44</sup> Douglas, 1982

<sup>45</sup> Korsmeyer, 2002

<sup>46</sup> Broussard, 2008

<sup>47</sup> Telfer, 2012

<sup>48</sup> 17 U.S.C. § 101 and 102

independently of, the utilitarian aspects of the article,” and courts have developed a number of tests for whether a useful article’s aesthetic features are “physically” or “conceptually” separable from its function.<sup>49</sup> According to the test of separately the object is copyrightability only if there is an aesthetic elements that can be separately identified from the useful article. It also indicates that copyright protection extends only to those expressive elements of a useful article, not to the entire object.<sup>50</sup> “The expressive features of an original dish should therefore qualify for protection under the doctrine if the dish’s design or composition incorporates expressions that can be conceptually identified as separate from the dish’s basic utilitarian identity as a repository of calories.”<sup>51</sup> Therefore, in order for a chef to claim copyright over food presentation, the chef would need to prove that his creation can be identified separately from, and is capable of existing independently of, the utilitarian aspects of his food design.<sup>52</sup> Buccafusco argues that the proper area for analysis of the copyrightability of dishes is new culinary creations however the necessary requirements of copyright law are no different than it would be for literary or musical works.<sup>53</sup> Culinary dishes possess the expressive potential to convey meaning like other traditionally protected works of art<sup>54</sup> and therefore they should be protected by the copyright law.

Compared to the American development of legal doctrine regarding food plating, this issue is much less discussed in Europe. One of the few examples on this topic is the case of applied art, the object of which was a birthday train "Geburtstagzug," made of wood, which was dealt with by the German Federal Court.<sup>55</sup> According to the Bundesgerichtshof even if works of applied art do not have higher requirements for the level of design than for works of non-purpose art, when assessing whether such a work reaches the level of design required for copyright protection, it must be taken into account that the aesthetic effect of the design can only justify copyright protection insofar as it is not due to the intended use but is based on an artistic achievement.<sup>56</sup> The author's own intellectual creation presupposes that there is room for manoeuvre and is used by the author to express his creative spirit in an original way. In the case of everyday objects that have to have design features due to their intended use, the scope for artistic design is regularly limited.<sup>57</sup>

It follows from the above opinions that food plating can be considered as one of the works of applied art if it expresses not only a useful function, but also expressing aestheticism, while meeting the requirements of uniqueness and creative activity of the author. The condition of expression in the form perceptible to the senses is observed in food plating, while food plating makes it possible to involve most of the human senses in its perception.

## Conclusions

Copyright is gradually finding its application in gastronomy, both in the protection of recipes, cookbooks and in the food plating. While recipes can be protected as literary works, food plating is considered more of a work of applied arts. Both for recipes and food plating, it must be true that they must meet all the attributes of the work defined by law; it must be in the field of art, science or literature, the work must be original and be the result of the author's creative activity and finally expressed in such a way that we can perceive it with the

<sup>49</sup> Buccafusco, 2006

<sup>50</sup> Broussard, 2008

<sup>51</sup> Broussard, 2008

<sup>52</sup> Smith, 2014

<sup>53</sup> Buccafusco, 2006

<sup>54</sup> Broussard, 2008

<sup>55</sup> Judgement of The German Federal Court of Justice on November 13, 2013, no. I ZR 143/12

<sup>56</sup> Judgement of The German Federal Court of Justice on May 12, 2011, no. I ZR 53/10

<sup>57</sup> Judgement of The German Federal Court of Justice on November 13, 2013, no. I ZR 143/12

human senses. Recipes can be protected as literary works, where the subject of protection is not an idea, procedure or method, but their description, which the author of the recipe will use to formulate it. If the description is original as a result of the author's creativity, then it may be object to legal protection by copyright. Nevertheless, most recipes do not meet these conditions. But the cookbooks are the object of the copyright as collections of recipes, which represent a creative database (often referred to as a collective work) and regardless the recipes included in the book are considered as works. In each case, recipes and cookbooks protected by copyright are also called works by "Kleine Münze," as described in German legal doctrine. Thus, these are works in which a low degree of originality of the work is manifested. On the other hand, the composition and method of food preparation itself is not the subject of copyright law, but it is appropriate to consider patent protection or protection by know-how.

In addition, pictures published together with recipes generally enjoy a higher degree of respect than works, as in most cases it is not possible to determine without an expert opinion whether photography of food plating is a work of art. However, if photographs of meals served on a plate can be the subject of copyright law, then the question arises as to whether the food served on the plate itself can be considered copyrightability. The critical question is whether food plating can be included in the field of art. Both American legal doctrine and case law, as well as German case law, suggest that food plating can be considered a work if certain conditions are met. While in European conditions it is sufficient if food plating fulfills not only a useful function, which is a nourishment, but also artistic achievement, in American judicature only the part of food plating which represents the article's aesthetic features and which can be physically or conceptually separated from utilization function is copyrightability.

Moreover, it is not yet time to include the taste and odour of food under copyright protection as separate subjects of copyright law. The Court of Justice of the EU justifies this by the impossibility of precise and objective identification of the taste of a food. However, we believe that the odour and taste of food are in a way a form of expression of the work, which should be copyrighted.

## Acknowledgment

This publication was supported by the European Union Project of Jean Monnet Module no. 599683-EPP-1-2018-1-SK-EPPJMO-MODULE, "EU Intellectual Property" and Operational program Integrated Infrastructure within the project: Demand-driven research for the sustainable and innovative food, Drive4SIFood 313011V336, co-financed by the European Regional Development Fund.

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# THE LEGAL FRAMEWORK FOR COPYRIGHT PROTECTION IN KENYA, IN DIGITAL AGE

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## Abstract

The explosive growth in Internet penetration and use, together with the ever-increasing uptake of emerging technology, has presented fresh and unprecedented obstacles for the global creative industries. Copyrighted works can now conveniently be transferred to digital forms; complete digital versions of works can be replicated and distributed via digital networks at a minimum cost without the consent of copyright owners of works. This condition has sparked a worldwide outbreak of internet piracy in all types of copyrighted works. Even in jurisdictions where Internet access remains expensive, cyber piracy is the ultimate conduit of illegal physical distribution networks for pirated works in an informal ecosystem.

On the other hand, the Internet and related media networks offer new ways for copyright owners to share and transmit their works; as well as opportunities for policymakers to promote cost-effective access to information and education through digital networks.

This thesis examines whether or not Kenya's new legislative and operational system for the security and regulation of copyright in the digital world will fulfil its purpose adequately. Starting with a general evaluation of the threats and opportunities raised by emerging technology and digital networks to the creative industries, this study assesses whether Kenya's legal and institutional structure is up to date with the challenges and opportunities of the digital age.

The results of this study suggest that, while the system has undergone some changes to enhance it, there is a need to further reinforce the framework to ensure the security of copyrighted works in the digital environment; and to exploit the benefits of digital spaces to encourage and enable access to information.

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## Key words

Copyright, Intellectual Property, Digital, Internet

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## Introduction

Kenya has been left behind in the digital revolution, Kenya has fully embraced the business of the internet through mobile technologies, which has been attributed to economic development in the country,<sup>58</sup> the technological venture in Kenya,<sup>59</sup> have led to appreciable development in almost all sectors of the economy, including the services offered by the

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<sup>58</sup> World Bank, World Development Report 2016: Digital Dividends (The World Bank 2016) <[http://www-wds.worldbank.org/external/default/WDSContentServer/WDSP/IB/2016/01/13/090224b08405ea05/2\\_0/Rendered/PDF/World0developm0000digital0dividends.pdf](http://www-wds.worldbank.org/external/default/WDSContentServer/WDSP/IB/2016/01/13/090224b08405ea05/2_0/Rendered/PDF/World0developm0000digital0dividends.pdf)> accessed 18 January 2016.

<sup>59</sup> Communications Authority of Kenya, 'Quarterly Sector Statistics Report; Second Quarter of the Financial Year 2015/16' (CAK 2016) <[http://ca.go.ke/images/downloads/STATISTICS/Quarterly%20Sector%20Statistics%20Report%20for%20Second%20Quarter%20FY%202015-2016%20\(October-December%202015\)%20Final.pdf](http://ca.go.ke/images/downloads/STATISTICS/Quarterly%20Sector%20Statistics%20Report%20for%20Second%20Quarter%20FY%202015-2016%20(October-December%202015)%20Final.pdf)> accessed 10 April 2016.

public service sector and has brought people together breaking the geographical boundaries across the world, which make the passage of information faster than before.<sup>60</sup>

Investment in Digital has spurred growth in the creative industry in Kenya, there is an influx of information being shared online, either in the form of video or literary (the blog and vlog), and the copyright laws plays an important role in protecting the creative work and guaranteeing the copyright holders exclusive rights over the use of their creation, for either a determinate or indeterminate period.<sup>61</sup> The rights guaranteed are, the right to reproduce, distribute, public performance, broadcast, and even moral rights aimed at protecting the creator's reputation.<sup>62</sup>

The availability of the internet has made it easier for creators to sell their copyrighted work globally without geographical limitations, this has also considerably reduced the cost of production and distribution since sharing of material online is a matter of a minute and without heavy cost, but then at the same time, the downside of the internet is the ease of illegal reproduction of copyrighted work, which denies the copyright holder the full enjoyment of the benefits of their creations.<sup>63</sup> The infringement of copyright- based work with such ease, has led to the questioning of the sufficiency of traditional copyright laws and principles.<sup>64</sup>

Digital access has hastened the piracy level in Kenya, it has been reported that musical work is pirated at 98%<sup>65</sup>, for software, the percentage is at 83%,<sup>66</sup> books,<sup>67</sup> films, television series/ programs<sup>68</sup>, etc., are not left behind in piracy business. In almost all urban centers in Kenya, the number of shops selling illegal copyrighted work, illegally downloaded online has increased,<sup>69</sup> there is a need to police the internet to prevent illegal downloading of copyrighted work and at the same time find a way to distribute copyrighted materials away from the potential pirates.<sup>70</sup> The existing copyright Act<sup>71</sup> in Kenya does not fully deal with digital copyright-based materials, the internet providers should be roped in, to help in dealing with cases of copyright infringement.

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<sup>60</sup> World Bank (n 1).

<sup>61</sup> Lionel Bently and Brad Sherman, *Intellectual Property Law* (4th ed, Oxford University Press 2014) 31; Paul Goldstein and P Bernt Hugenholtz, *International Copyright: Principles, Law and Practice* (2nd ed, Oxford University Press 2010) 4–5.

<sup>62</sup> Bently and Sherman (n 5) 140–177.

<sup>63</sup> Eric Schlachter, ‘The Intellectual Property Renaissance in Cyberspace: Why Copyright Law Could Be Unimportant on the Internet’ (1997) 12 Berkeley Technology Law Journal 15.

<sup>64</sup> Peter K Yu, ‘P2P and the Future of Private Copying’ (2005) 76 University of Colorado Law Review <[http://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=578568](http://papers.ssrn.com/sol3/papers.cfm?abstract_id=578568)> accessed 17 October 2015.

<sup>65</sup> Dickson Nyariki and others, ‘The Economic Contribution of Copyright-Based Industries in Kenya’ (WIPO 2009) <[http://www.wipo.int/copyright/en/performance/pdf/econ\\_contribution\\_cr\\_ke.pdf](http://www.wipo.int/copyright/en/performance/pdf/econ_contribution_cr_ke.pdf)> accessed 16 December 2014.

<sup>66</sup> Business Action to Stop Counterfeiting and Piracy and Kenya Anti-Counterfeit Agency, ‘Promoting and Protecting Intellectual Property in Kenya’ (International Chamber of Commerce 2013) <<http://www.iccwbo.org/Data/Documents/Bascap/International-engagement-and-advocacy/Country-Initiatives/Kenya/Value-of-IP-in-Kenya/>> accessed 15 April 2015.

<sup>67</sup> Michela Wrong, ‘A Letter from Michela Wrong - It’s Our Time to Eat.’ (Storymoja, 20 September 2010) <<http://storymojafrica.wordpress.com/archives-20092010/politics/a-letter-from-michela-wrong-its-time-to-eat/>> accessed 5 October 2015

<sup>68</sup> Vincent Matinde, ‘Photography Theft Growing in Kenya amid Greater Connectivity’ (IT Web Africa, 6 May 2014) <<http://www.itwebafrica.com/ict-and-governance/256-kenya/232846-photography-theft-growing-in-kenya-amid-greater-connectivity>> accessed 5 March 2015.

<sup>69</sup> &Innovation Consulting, ‘Competing With Piracy: Understanding and Redefining Consumer Perception of Value in Developing Markets’ <[http://www.slideshare.net/And\\_Innovation/competing-with-piracy-can-video-on-demand-beat-pirated?from\\_action=save](http://www.slideshare.net/And_Innovation/competing-with-piracy-can-video-on-demand-beat-pirated?from_action=save)> accessed 9 October 2015.

<sup>70</sup> Amal Mohamed, ‘Economics of the Kenyan Music Industry’ (UP Nairobi, 29 May 2014) <[http://www.upnairobi.com/dt\\_portfolio/kenyan-music-industry/](http://www.upnairobi.com/dt_portfolio/kenyan-music-industry/)> accessed 20 October 2015.

<sup>71</sup> Part III to VI of the Copyright Act 2001, Chapter 130 Laws of Kenya

Copyright is a branch of intellectual property, dealing with the protection of copyright-based material in the line of literary, musical, films, etc.,<sup>72</sup> in Kenya, the Copyright Act of 2001 is the main law in place beside other laws, dealing with copyrighted work, section 22(1) of Kenya's Copyright Act defines copyright-based work to include *audiovisual, literary works, musical works, artistic works, sound recordings, and broadcasts, and entrepreneurial works.*<sup>73</sup> The protection guaranteed by the Copyright Act is automatic, there is no need for official registration even though it is highly recommended, the protection is granted to the creator or copyright holder in cases where the right has been transferred or was created for the benefit of a third party.<sup>74</sup>

It is important to note that, what is protected by the Act is the expression of the idea and not the idea itself, and the protection is granted if the work is original,<sup>75</sup> in case of computer-generated work, the creator, must have applied A great deal of talent, labor and commitment for its creation. The protection is denied to works that are considered to be good for public policy, decency, and protection of cultural and social concern.<sup>76</sup> Kenya's copyright Act, permit fair dealing/ use of copyrighted materials specifically for, Scientific analysis, private usage, critique or review, or reporting of current affairs subject to source identification.<sup>77</sup>

The embracement of digital technologies by both the creators and the consumer signals a positive attitude towards copyright development, this has made it easier for the information to be available for consumption, but this has also limited the authors' control of their work, because of the derivative work, such remixing of songs has taken over the social culture.<sup>78</sup>

Advances of emerging technology and the usage of digital networks such as the Internet have posed a range of possibilities and threats for the creative industry and copyright regimes, as discussed in more depth below.

## Results and discussion

### 1 The revolution in digital creative industries

These are industries that use intellectual property to create wealth and employment majorly through skills and talents,<sup>79</sup> and they include the *Advertising, architecture, the arts, and antique industry, crafts, design, fashion design, film and video, digital recreation software, music, performing arts, publishing, software, and electronic services, television and radio, as well as research and development;*<sup>80</sup> and the huge part of the creative industry is under copyright protection which involves cultural industries such as creation and mass production for commercialization of creativities of the humans. Mass production further include *printing, publishing, multimedia, audiovisual, photographic, and cinematographic productions; crafts; and design,* this research is about copyrighted works for economic exploitation<sup>81</sup>

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<sup>72</sup> Bently and Sherman (n 5) 31; William Cornish, David Llewelyn and Tanya Aplin, Intellectual Property: Patents,Copyright, Trade Marks and Allied Rights (8th ed, Sweet & Maxwell 2013) 8.

<sup>73</sup> Bently and Sherman (n 5) 32, 117.

<sup>74</sup> ibid 31; Cornish, Llewelyn and Aplin (n 74) 8–9.

<sup>75</sup> Bently and Sherman (n 5) 93–94.

<sup>76</sup> ibid 122–123

<sup>77</sup> Copyright Act (n 75), Section 26(1) (a).

<sup>78</sup> Chander and Sunder (n 31).

<sup>79</sup> Jason Potts and Stuart Cunningham, 'Four Models of the Creative Industries' (2008) 14 International Journal of Cultural Policy 233.

<sup>80</sup> UK Department of Culture, Media and Sport (n 85) 5; John Howkins, The Creative Economy: How People Make Money from Ideas (Penguin Group 2013) Chapter 3.

<sup>81</sup> Nyariki and others (n 10) 32.

The world has moved to the information age or digital era; the global economy is driven by the availability of information and the ease of access to that information online, this has been due to the digital revolution of the internet across the world,<sup>82</sup> this age began in the 1970s, with the commercial use and availability of computers and telecommunication to the common man.<sup>83</sup> In the 1980s, the computers were improved to a chip-based, which help in the storage of data in a centralized manner, and in the 1990s, the networking technology and the global diffusion of technology came to fruition and it was completed with the creation of the internet.

The first type of internet was developed by the USA Defense department in 1969 known as ARPANET<sup>84</sup> and in 1990 it changed to NSFNET. The creation of the communication language for the internet called TCP/IP and HTTP protocol utilizing the Uniform Resource Locator (URL) brought the internet as we know it, to existence.

With the development of computer and creation of internet and making them available for the consumption by common man, creation of other means of communication like emails and social media platforms like (*Facebook, Twitter, WhatsApp, Instagram etc.*) became easy and hasten the digital revolution, this has even made it easier, faster and cheaper to dispense information beyond geographical boundaries and in turn, this has made global economy to move faster than before to accommodate people from all walk of life, with the creation of business to business and business to consumer and consumer to consumer websites and applications like *Amazon, Alibaba, wish, eBay* etc., this has also led to new socio-technical and techno-economic patterns, The main indicators of such a new paradigm are information-based technologies; the prevalence of the effects of new technologies; the increasing complexity and flexibility of technology interaction; and the convergence of specific technologies into a highly integrated system.<sup>85</sup>

The digital economy is driven generally by cloud computing, Big Data, artificial intelligence, the Internet, and e-commerce.<sup>86</sup> E-commerce is about doing business of buying, selling, and distribution, online; Big Data is about Identification, collection, and analysis of data to collect business information used to enhance performance, output, sales, and marketing while cloud computing provides centralized data storage, extraction, processing, and analysis solutions.<sup>87</sup> Social interaction technologies are different platforms that promote corporate practices that have become socialized, such as social media networks, websites, wikis, and e-Portfolios.<sup>88</sup> The Internet of Things includes connectivity between devices through cloud computing and data-gathering sensor networks,<sup>89</sup> and artificial intelligence is the science and engineering of making intelligent machines.<sup>90</sup>

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<sup>82</sup> Castells (n 34) 28–38.

<sup>83</sup> Manuel Castells 39–45.

<sup>84</sup> ibid 45–51

<sup>85</sup> ibid 69–76.

<sup>86</sup> Kachina Shaw, ‘What Makes Up the Digital Economy - TechBytes Blog’ (Webopedia, 16 September 2015) <<http://www.webopedia.com/Blog/the-digital-economy.html>> accessed 27 September 2016.

<sup>87</sup> Shaw (n 98).

<sup>88</sup> Teófilo Redondo, ‘The Digital Economy: Social Interaction Technologies – an Overview’ (2015) 3 International Journal of Interactive Multimedia and Artificial Intelligence 17.

<sup>89</sup> Daniel Burrus, ‘The Internet of Things Is Far Bigger Than Anyone Realizes’ (WIRED, 21 November 2014) <<https://www.wired.com/insights/2014/11/the-internet-of-things-bigger/>> accessed 27 September 2016; Daniel Burrus, ‘The Internet of Things Is Far Bigger Than Anyone Realizes (Part 2)’ (WIRED, 26 November 2014) <<https://www.wired.com/insights/2014/11/iot-bigger-than-anyone-realizes-part-2/>> accessed 27 September 2016.

<sup>90</sup> John McCarthy, ‘What Is Artificial Intelligence?’ (Stanford University, 12 November 2007) <<http://www-formal.stanford.edu/jmc/whatisai/>> accessed 10 June 2016.

## 2 Prospects and Barriers Set by the Digital Age

The digitalization of the major copyright-based work such as sounds, literary, images, etc., is a stride in the right direction and they digitized work, can easily be transmitted through the use of the internet, this gives the copyright-holders the easiest opportunity to grant a license for them to be used anywhere in the world, which has resulted to the development of online market place (like iTunes, Spotify, eBay, tidal, etc.,) for buying and selling such like products.

The online platform as a means of sharing digitized work is advantageous to both buyer and sellers; some of the advantages are as follows; the product can be easily reduced to a single copy, the cost of producing the digitized product is very low in comparison to others,<sup>91</sup> the online market is accessible to anyone anywhere, giving the product a very wide market.<sup>92</sup> With the elimination of unnecessary paperwork, the date required for the study of the market is easily available. The online platform is advantageous to consumers because they can check the product in the comfort of their home, check the rating done by the previous buyers, and by a click of a button, purchases it.<sup>93</sup>

Several online transmission channels have sprung up, making it easy for copyrighted work to be shared, and granting blanket right to use has been made easy, which can be provided by collection societies or by the individual copyright holder. The digital work can be transmitted by; the following online services, *SoundCloud, Spotify, Deezer, or Tidal; video-on-demand (VOD) services like Netflix, Hulu, YouTube Red, or Amazon Prime; and e-book rental services like Book Renter or Chegg*. With the availability of affordable internet to almost every corner of the consumption of digitized material has gone online through streaming platforms.<sup>94</sup>

Licensing of digitized work by the copyright holder to the online streaming platform either directly or through their agents has helped reduce the burden that used to be borne by the user because digitization has brought about a centralized licensing system, this has, in turn, allowed greater efficiency, transparency, accountability in the administration of copyright work, and the copyright holder can easily monitor their work and calculate the royalty they are likely to get, the best example is the YouTube video streaming where the number of viewers can be easily seen, this can be easily dealt with in Africa, because, the rights of entrepreneurial work is not as complex as in Europe or the USA.<sup>95</sup>

As advantageous and profitable it is to transmit digitized material online, in the same breadth it has its disadvantages; it is hard to regulate the number of illegal copies that can be made from when a digital work is downloaded, transmitted, and distributed without the loss of the original quality, this hurts the pocket of the copyright holder.<sup>96</sup> The online file sharing platform has worsened the situation because this has made it easy to access a file on a computer within the same network, this is heightened piracy of online work.<sup>97</sup>

Online copyright infringement can be done anonymously and without leaving behind any trace of the activities user, the anonymity has been enabled by the use of *virtual private*

<sup>91</sup> Ethan Lieber and Chad Syverson, ‘Online versus Offline Competition’ in Martin Peitz and Joel Waldfogel (eds),

The Oxford Handbook of the Digital Economy (Oxford University Press 2012) 200–205.

<sup>92</sup> Sihanya, ‘Copyright in E-Commerce and the Music Industry in Kenya’ (n 59) 135.

<sup>93</sup> ibid 135–136; Lieber and Syverson (n 105) 200–205.

<sup>94</sup> Hargreaves (n 104) 28.

<sup>95</sup> Roya Ghafele and Benjamin Gibert, ‘Counting the Costs of Collective Rights Management of Music Copyright in Europe’ 11–12 <<https://mpra.ub.uni-muenchen.de/34646/>> accessed 10 June 2016.

<sup>96</sup> Schlachter (n 7); Barbara Cohen, ‘A Proposed Regime for Copyright Protection on the Internet’ (1996) 22 Brooklyn Journal of International Law 401, 401–414; World Intellectual Property Organization, IntellectualProperty on the Internet: A Survey of Issues (WIPO 2002) 30.

<sup>97</sup> Brett Robert Caraway, ‘Survey of File-Sharing Culture’ (2012) 6 International Journal of Communication 575.

*network (VPN) services, seedboxes, encrypted web browsing software like Tor, and anonymity is driven operating systems like Tails or Whonix.*<sup>98</sup> According to Alexander Peukert some internet users, do not understand the distinction between tangible and intangible properties, so they do not understand that the free sharing of online content is a violation of copyright holders rights.<sup>99</sup> While according to Peter Yu, the internet illiteracy of the elder has led to failure by them to educate the generation Y, about the appropriate internet etiquette.<sup>100</sup>

The internet intermediaries are also to blame for the rampant copyright infringement, the intermediaries are responsible for bringing the third party and the internet together, by giving access to a host, transmitting services created by the third party to the internet, and vice versa.<sup>101</sup> The internet intermediaries are like the internet provider, data processing and web hosting services, internet payment system, e-commerce, etc. The intermediaries are no longer a passive and neutral channel for the passage of information, but a very important conduit for creating space for human interaction, the internet intermediaries have turned into retailers of contents.<sup>102</sup>

The infringement of copyrighted-based works/ material, occurs in copying the material or information, possessing it, and transmitting it. The intermediaries are involved in the infringement of copyrighted material in the following way; when it gets a piece of information, it transmits new copies to the next host in the line of communication or copies are made by it at the request of the operator, this is known as packet switching.<sup>103</sup> It is a given that software works at the command of a third party, but the fact that copies are made by the intermediaries, still constitutes an infringement of the copyright, because it reproduces and distributes the materials.<sup>104</sup>

Generally, copyright-holders goes after the intermediaries, in filing judicial petitions, because through them (the intermediaries like mp3skull.com) a huge number of copyrighted materials can be transmitted, the example is given, is as a result of a website where songs can be illegally downloaded, and the intermediaries being the owners of the website, they are presumed to have ‘deep pocket’ and easily reachable as opposed to individual copyright infringer who are many and are hard to track all over the world in many jurisdictions, so it makes economic sense to go after the owners of the websites perpetuating the infringement of copyrighted work.<sup>105</sup>

Intermediaries like the internet service providers can stop access to a website that promotes infringements, and so their failures to do so also attracts lawsuits from the copyright holders.<sup>106</sup>

In the case of *Playboy Enterprises, Inc. v. Frena*<sup>107</sup>, the court held the intermediaries liable for perpetuating the hosting and transmission of copyrighted-work. The Bulletin Board System was held liable for the promotion of infringement of copyrighted materials by the people accessing their system, this decision was based on the tort of strict liability which has

<sup>98</sup> ibid 576; Schlachter (n 7) 20.

<sup>99</sup> Peukert (n 42).

<sup>100</sup> Yu (n 9) 756–763.

<sup>101</sup> Karine Perset, ‘The Economic and Social Role of Internet Intermediaries’ (OECD 2010) 9 <[http://www.oecd-ilibrary.org/science-and-technology/the-economic-and-social-role-of-internet-intermediaries\\_5kmh79zzs8vb-en](http://www.oecd-ilibrary.org/science-and-technology/the-economic-and-social-role-of-internet-intermediaries_5kmh79zzs8vb-en)> accessed 4 March 2016.

<sup>102</sup> Niva Elkin-Koren, ‘After Twenty Years: Revisiting Copyright Liability of Online Intermediaries’ in Susy Frankel and Daniel Gervais (eds), *The Evolution and Equilibrium of Copyright in the Digital Age* (Cambridge University Press 2014) 39.

<sup>103</sup> Chris Reed, *Internet Law: Text and Materials* (2nd ed, Cambridge University Press 2004) 96

<sup>104</sup> Reed (n 124) 96–97.

<sup>105</sup> ibid 89–90; Elkin-Koren (n 121) 31–33.

<sup>106</sup> Reed (n 124) 89–90; Elkin-Koren (n 121) 31–33.

<sup>107</sup> 839 F Supp 1552 (MD Fla. 1993).

since been abandoned, and nowadays, the intermediaries are held liable only when they encourage their users to illegally download copyrighted materials, and this can also be in cases where the website owners are aware of the use of their platform to sell and buy illegally acquired copyrighted work and they (intermediaries) fails to do anything to stop it.<sup>108</sup> A different decision was made by a court in the case of *Religious Technology Center v. Netcom On-Line Communications Services, Inc.*,<sup>109</sup> the intermediary was not held liable for a fault of the subscriber who published infringing materials on their website. In the case of CoStar Group Inc. v. Loop-Net Inc.,<sup>110</sup> the matter of holding the intermediaries liable was further presented for trial and it was held that internet service providers are not liable for the fault of their user/ customer, because the ISPs are simply providing the internet and the people at fault are the user who uses the service to publish, download and transmit copyrighted materials.

In *A&M Records, Inc. v. Napster*,<sup>111</sup> Inc., the court was presented with a case on file sharing and whether intermediaries are liable or not, Napster necessitated the allocation and download of material through the use of their website, the user of their website were illegally downloading music and the copyright holder took notice and file a suit in the USA's court. Napster's defense was that it was just a conduit for file-sharing by the users of their websites, the plaintiffs argued that Napster was encouraging infringement of their copyright work. The district court sided with the plaintiff and issued an injunctive order against Napster and stated that Napster could be vicariously infringing copyrighted work. When the matter was appealed to the Ninth Circuit Court of Appeal, Napster was held responsible and the fair use defense by Napster was also rejected.

Legislative actions have been taken to deal with copyright and the freedom of internet use which sometimes get abused by the user, and area such as sharing of obscene materials, cybercrimes, and defamation perpetuated online have been covered as well. *The Digital Millennium Copyright Act, 1998* by USA is meant to deal with the infringement of copyrighted materials, done online, the USA act, provides some immunities to the intermediaries since they are just a way through with access to information and communication can be done, which at times involves the use of copyrighted work by the user without knowledge of the intermediaries.<sup>112</sup> However, the moment they (intermediaries) notices an infringement of the material, they are expected to remove them immediately.

The works created by a computer in which the creator cannot be easily found, is an issue that is coming up, the area is different from the cases where the creator of certain materials, use a computer to create them and the authors can be easily ascertained, the examples of work that is emerging are like the ones created by translation software, search engines like 'chrome', algorithms and natural language generated for the online content creation,<sup>113</sup> they are considered to lack originality hence not copyright protected.<sup>114</sup> In the United Kingdom, under the UK's Copyright Designs and Patent Act, the copyright holders of such works are given to the person who is considered to have created them, which fits the definition assigns to the creation of audio-visual and sound recording materials.<sup>115</sup>

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<sup>108</sup> Reed (n 124) 100.

<sup>109</sup> 907 F Supp 1361 (ND Cal. 1995).

<sup>110</sup> 373 F 3d 544 (4th Cir. 2004).

<sup>111</sup> 114 F Supp 2d 896 (ND Cal. 2000), 239 F 3d 1004 (9th Cir. 2001).

<sup>112</sup> Bently and Sherman (n 5) 175.

<sup>113</sup> See for example Shelley Podolny, 'If an Algorithm Wrote This, How Would You Even Know?' *The New York Times* (7 March 2015) <<http://www.nytimes.com/2015/03/08/opinion/sunday/if-an-algorithm-wrote-this-how-would-you-even-know.html>> accessed 10 June 2016.

<sup>114</sup> Bently and Sherman (n 5) 116–117.

<sup>115</sup> Jani McCutcheon, 'Curing the Authorless Void: Protecting Computer-Generated Works Following IceTV and Phone Directories' (2013) 37 Melbourne University Law Review.

### 3 The Kenyan Digital Copyright Protection

The journey of digitalization in Kenya began in the 1970s and 1980s with the transformation and extension of telecommunication services, which was under the management of the Kenya Posts and Telecommunications Corporation (KP&TC),<sup>116</sup> during this period, telephone through landline was the major means of communication apart from the postal service, but at the same time, Kenya was developing fax and telefax as other means of communication.<sup>117</sup> In 1991, Kenya allowed the entry of other players in the market such as the terminal equipment or customer premises equipment market.<sup>118</sup> During that period, privately owned and operated networks also came to the forefront,<sup>119</sup> which brought with them paging services, electronic mail, and data transfer through modems like Kenpac.<sup>120</sup>

The development in technology in the 1990s brought with a new way of doing business, tourism industries started using a computer for bookings and reservation, agricultural marketers and farmers were using computers to get a better price for their products, electric payment was also introduced in the market.<sup>121</sup> Educational and research areas were not left out, the *East and Southern African Network (ESANET)*, digitalized education, the *University of Nairobi*, in Kenya in conjunction with *Kenya Medical Research Institute*, through Green-Net, also digitalized the education.<sup>122</sup> FidoNet was introduced in 1994, in Kenya, a date storing and forwarding technology was providing the platform for accessing data and bulletin boards and emails in Kenya.<sup>123</sup>

In 1995, a data connection that could access the internet was introduced in Kenya which further revolutionized digital in the country, this brought about over 10 internet service providers in Kenya which by the end of 1995, had over 5000 users, by 1998, the number had increased with over 600 dial-up lines, working, 458, internet host and 292 domain names with .ke.<sup>124</sup> But, the cost of the internet was too high for many Kenyans and they could access it only through the cybercafé, which was majorly found in the urban centers.<sup>125</sup>

With the arrival of the mobile *telecommunications services companies* and the *fiber optic cable networks*, which in turn brought about the M-Pesa; which is the mobile money transfer in 2008, the digitalization in Kenya, gained traction, and the use of mobile among citizens increased.<sup>126</sup> Fibre Optic Cable brought third-generation (3G) mobile technology which led to the increased use of the mobile network.<sup>127</sup> As of 2015, the number of mobile internet users in Kenya was at 35.5 million which is 82.6% of internet penetration in Kenya, as reported by the Communication Authority in Kenya.<sup>128</sup>

Some public and private services in Kenya, have moved online and can be accessed from anywhere, the examples are e-government through e-citizen facilities, e-commerce, like

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<sup>116</sup> Tyler, Hughes and Renfrew (n 36) 81–84.

<sup>117</sup> ibid 91–93.

<sup>118</sup> Bernard Sihanya, ‘Infotainment and Cyberlaw in Africa: Regulatory Benchmarks for the Third Millennium’ (2000) 10 *Transnational Law & Contemporary Problems* 583, 606.

<sup>119</sup> Tyler, Hughes and Renfrew (n 36) 87.

<sup>120</sup> ibid 91–93; Muriuki (n 37) 32.

<sup>121</sup> Tyler, Hughes and Renfrew (n 36) 99–106.

<sup>122</sup> ibid 105; Muriuki (n 37) 32.

<sup>123</sup> Tyler, Hughes and Renfrew (n 36) 106; Muriuki (n 37) 28.

<sup>124</sup> Muriuki (n 37) 33, 37.

<sup>125</sup> Mark Kaigwa, ‘From Cyber Café to Smartphone: Kenya’s Social Media Lens Zooms In on the Country and Out to the World’ in Bitange Ndumo and Tim Weiss (eds), *Digital Kenya: An Entrepreneurial Revolution in the Making* (Palgrave Macmillan UK 2016) 188.

<sup>126</sup> William Jack and Tavneet Suri, ‘Mobile Money: The Economics of M-PESA’ (National Bureau of Economic Research 2011) 4–5 <<http://www.nber.org/papers/w16721>> accessed 12 October 2016.

<sup>127</sup> Kaigwa (n 152) 189.

<sup>128</sup> Communications Authority of Kenya, ‘Quarterly Sector Statistics Report; Second Quarter of the Financial Year 2015/16’ (n 3) 20–25.

mobile money borrowing, e-banking, eLimu- for educational purposes, and even in Agricultural areas.<sup>129</sup>

The growth of the internet in the country has led to an increase in copyright work, which has employed many people, as in 2015, that area had employed over 65,000 people and contributed to the GDP of Kenya, amounting to Kshs.85.21 billion.<sup>130</sup> The industries are using various online platforms to promote their brands and expanding their networks beyond the boundaries of Kenya. Many music and video distribution websites and apps<sup>131</sup> are operating in Kenya. Television channels and radio stations are also operating online, digital books<sup>132</sup> are also having a platform online in Kenya as other parts of the world. Video games on mobile phones<sup>133</sup> in Kenya have gain traction too and doing business online as well. Copyright materials have been extended to other areas as well, there is a caller ring back tone, which mostly uses copyrighted music and audio materials. In the business of television network, digitalization has taken over as well, in Kenya, there has been a shift from an analog television network to a digital television network, so by this, Kenya has fully complied with the United Nations Member states agreement on International Telecommunication Union,<sup>134</sup> this has led to the growth of television network in Kenya, Kenya has over 100 television channels operating in the country, this has also improved the quality of broadcast which can be as a result of stiff competition.<sup>135</sup>

The protection of copyrighted work has become a bit harder, about 98% of the revenue generated from music in Kenya, goes to the pirates,<sup>136</sup> the business of pirates have been largely moved online from the bootlegging of CDs and DVD, this has affected other copyrighted materials like illegally downloading books, photographs, and other materials online.<sup>137</sup> Television shows and series have not been spared either, the piracy of them are hurting the network economically.<sup>138</sup>

The easy availability of the internet has not only helped but at the same time hurt the film industry in Kenya, it has made it easy to pirate movies online and accesses the Hollywood /

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<sup>129</sup>James Manyika and others, 'Lions Go Digital : The Internet's Transformative Potential in Africa' (McKinsey Global Institute 2013) 9 <[http://www.mckinsey.com/~media/mckinsey/dotcom/insights/high%20tech%20internet/lions%20go%20digital/mgi\\_lions\\_go\\_digital\\_full\\_report\\_nov2013.ashx](http://www.mckinsey.com/~media/mckinsey/dotcom/insights/high%20tech%20internet/lions%20go%20digital/mgi_lions_go_digital_full_report_nov2013.ashx)> accessed 11 August 2020.

<sup>130</sup> Nyariki and others (n 10).

<sup>131</sup> Examples include Waabeh (<http://waabeh.com/>), Mdundo (<http://mdundo.com/>), Mziiki (<https://www.mziiki.com/>) and A Kenyan Voice (<http://www.akv.co.ke/>). See Balancing Act Africa Issue No. 658, 'Music to the Ears – African Online Mobile Music Platforms Break out All over the Continent' (Balancing Act Africa, 7 June 2013) <<http://www.balancingact-africa.com/news/en/issue-no-658/top-story/music-to-the-ears-af/en>>

<sup>132</sup> Njeri Wangari, 'E-Kitabu; Kenya's First EBook Store Launches at the Nairobi International Book Fair' (Kenyan Poet, 30 September 2012) <<http://www.kenyanpoet.com/2012/09/30/e-kitabu-digital-book-store-launches-at-the-nairobi-book-fair/>> accessed 22 December 2019.

<sup>133</sup> See iHub, African Tech Bits Episode 3: Gaming in Kenya (2014) <[https://www.youtube.com/watch?v=\\_SvhF2FCdyQ&feature=youtu.be](https://www.youtube.com/watch?v=_SvhF2FCdyQ&feature=youtu.be)> accessed 4 October 2015; Richard Moss, 'Big Game: The Birth of Kenya's Games Industry' (Polygon, 3 July 2013) <<http://www.polygon.com/features/2013/7/3/4483276/kenya-games-industry>> accessed 4 October 2015

<sup>134</sup> Michael M Ndonye, Josephine Khaemba and Phylis Bartoo, 'Digital Migration and the Battle of Terrestrial Titans in Kenya: Issues and Prospects' (2015) 2 International Research Journal of Engineering and Technology 2303 <<https://www.irjet.net/archives/V2/I3/Irjet-v2i3375.pdf>> .

<sup>135</sup> Ndonye, Khaemba and Bartoo (n 166) 2305–2306.

<sup>136</sup> Nyariki and others (n 10) 85.

<sup>137</sup> See Victor Nzomo, ““Sue, Baby, Sue!”: Miguna’s Peeling Back the Mask and the Digital Copyright Infringement Debate” (IP Kenya, 20 July 2012) <<http://ipkenya.wordpress.com/2012/07/20/sue-baby-sue-migunas-peeling-back-the-mask-and-the-digital-copyright-infringement-debate/>> accessed 5 October 2014; Victor Nzomo, ‘Election Campaigns and Copyright Infringement’ (IP Kenya, 5 January 2012)

<sup>138</sup> Philip Mwaniki, ‘Online Pirates Engage Local TV Stations in Battle of Dramas’ (Daily Nation, 5 December 2009) <<http://www.nation.co.ke/magazines/lifestyle/-/1214/817826/-/7altpz/-/index.html>>

international movies giving the local creators a hard time selling their products.<sup>139</sup> The majority of creators of movies and films have been pushed out of the market because of the inability to sell their product and earn revenue when the very same product is being sold at a much lower price by the pirate along the street.<sup>140</sup> Kenya is leading in terms of the sale of pirate material, in Africa, according to the research done by the *International Intellectual Property Alliance* in 2006.<sup>141</sup> Research done by the *Business Software Alliance*, states that a huge number of software sold in Kenya are not genuine about 78% of them are fake.<sup>142</sup>

Other factors fronted for the infringement of copyrighted work in Kenya, is mistrust of the online payment system and the delay in the delivery of a material order online and sold across the board, these make the traders in pirated properties thrives because they can sell them directly to consumers and at a cheap price, be it books, music, movies, etc.,<sup>143</sup> majority of creators in Kenya, are not aware of their rights of exclusive use of their copyrighted materials, this stops them from fully exploiting their copyrighted material and the channels to follow to get the materials protected.<sup>144</sup>

In 2001, Copyright Act, which operates in Kenya, covers a huge part of rights and other areas of copyright material including the digital ones, it has failed to fully define and align itself with the growing digital creativities and has in turn left a huge part of it unprotected and vulnerable to violators/ infringers, especially the areas that deal with the rights of the creators and the period for the protection of those rights. The Kenyan government has made some appreciable strides in extending protection to digital creativities by passing policies and creation of institutions, for example, the *National ICT Masterplan*;<sup>145</sup> the *Ministry of Information, Communications and Technology Strategic Plan*;<sup>146</sup> and the *National Broadband Strategy*.<sup>147</sup> However, these policies in place have largely ignored to recognize the online creativities as a source of income to many Kenya and they collectively have failed to provide the solution to problems facing online activities.

The *Ministry of Sports, Culture and the Arts ICT Strategic Plan*,<sup>148</sup> which should have been about protecting the rights of online creatives, has, in turn, ignored that area. However, The *National Music Policy*,<sup>149</sup> has recognized the rights of music creators and the benefits the society gets, this policy recognize the digital space for creativity and the contribution they make to society, the policy also recognizes only piracy as a threat to creativity in Kenya, its

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<sup>139</sup> See Riaga (n 54); Konstantaras (n 55).

<sup>140</sup> Paul Wafula, 'Theatre to Close Shop as Sales Plunge' (Business Daily, 5 October 2010) <<http://www.businessdailyafrica.com/Corporate-News/Theatre-to-close-shop-as-sales-plunge//539550/1026178/-/6c5g1jz/-index.html>> accessed 20 September 2015; Frankline Sunday, 'Piracy Eats Away Movie Rentals and Cinema Revenues' (Business Daily, 27 July 2010) <<http://www.businessdailyafrica.com/Piracy-eats-away-movie-rentals-and-cinema-revenues/-/539444/965112/-/qf84kqz/-index.html>> accessed 1 October 2015.

<sup>141</sup> International Intellectual Property Alliance, '2006 Special 301 Report: Special Mention - Kenya' (Office of the US Trade Representative) <[http://www.iipa.com/special301\\_TOCs/2006\\_SPEC301\\_TOC.html](http://www.iipa.com/special301_TOCs/2006_SPEC301_TOC.html)>

<sup>142</sup> Business Software Alliance (n 46) 9.

<sup>143</sup> See Manyika and others (n 156) at 47–48; Josephine Opar, 'Kenya's Film Distribution Problem' (This Is Africa, 19 June 2014) <<http://thisisafrica.me/lifestyle/kenyas-film-distribution-problem/>> accessed 28 October 2015.

<sup>144</sup> Cominos (n 64) 14.

<sup>145</sup> ICT Authority (n 72).

<sup>146</sup> Ministry of Information Communications and Technology (n 72).

<sup>147</sup> Ministry of Information Communications and Technology, 'National Broadband Strategy' <<http://www.ca.go.ke/images//downloads/PUBLICATIONS/NATIONAL%20BROADBAND%20STRATEGY/National%20Broadband%20Strategy.pdf>> accessed 27 September 2015.

<sup>148</sup> Ministry of Sports, Culture and the Arts (n 72).

<sup>149</sup> Ministry of Sports, Culture and the Arts, 'National Music Policy' <<http://musicinafrica.net/sites/default/files/national-music-policy-revised-26-february-2015.pdf>> accessed 27 September 2020.

aim at the modernization of copyright registration and protection, however, the National Music policy is not enough to effect real change to the protection of rights of copyright holders in the online realm.

## **4 Kenya's law & administrative structure for the defence & regulation of copyright in the digital space**

### **4.1 Legal Framework**

#### *The 2010 Constitution*

Being the *grund norm*, it binds everyone and state organs in the country.<sup>150</sup> Article 40(5) protects and promotes the intellectual property and put the responsibility on the state to do so, the High Court of Kenya, has been given the power to hear and decide cases involving failure by the state or anybody to protect and promote the intellectual property.<sup>151</sup> The importance of Article 165 is in the case of *Bernsoft Interactive & 2 Others v. Communications Authority of Kenya & 9 Others*,<sup>152</sup> the High Court was moved to declare failure by the state organs like Kenya Copyright Board, the Communication Authority of Kenya, and the office of the attorney general, to protect the intellectual property rights of Kenyans, by pushing for laws in that line and the organs were accused of sleeping on the job while copyright infringement in the country was going unchecked.

### **4.2 The provisions of Kenya's Copyright Act**

It can be traced to the days of the British Protectorate and colony in Kenya from 1920.<sup>153</sup> With the re-enactment of section 3 of the Judicature Act in 1967, the Copyright Act was amended to agree with the changes taking place in the country. From 1966 to 2012, Kenya's Copyright Act has undergone changes that extended the rights of copyright to computer program creators.<sup>154</sup> The current Copyright Act applicable in Kenya is following the agreement under Berne Convention 2000<sup>155</sup>, which extends the protection of copyright-materials of member states in another country that is a member of the convention.

#### *Rights Included in the Digital Transmission of Works*

Section 26(1) of Kenya's Copyright Act, guarantees protection of copyrighted work, and the rights guaranteed include broadcasting and communicating either a substantial part of a whole of it to the public. The rights are given by the Act are divided so it can be easily determined when the rights occur either in full or part of the creation.<sup>156</sup>

Even though Kenya's Copyright Act agrees with the WIPO internet treaties, it does not fully take in to account the making of copyrighted work easily available to the public by electronic means in such a way that they can enjoy it at the comfort of their homes as opposed to communication to the public. The WIPO Internet treaties purposes to distinguish the communication from the transmission from the creator to the consumers by making it

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<sup>150</sup> Constitution of Kenya, 2010, Article 2(1).

<sup>151</sup> Constitution of Kenya, 2010, Article 165

<sup>152</sup> Petition No. 600 of 2014; Nzomo, 'Test Case on Liability for Online Copyright Infringement' (n 69).

<sup>153</sup> Ben Sihanya, 'Copyright Law in Kenya' <<http://innovativelawyering.com/attachments/article/26/Copyright%20Law%20in%20Kenya%20-%20Prof%20Ben%20Sihanya.pdf>>

<sup>154</sup> The Copyright (Amendment) Act, 1989, Act No. 14 of 1989.

<sup>155</sup> The Copyright (Amendment) Regulations; 2000 Legal Notice 125 of 2000.

<sup>156</sup> Bently and Sherman (n 5) 159.

available to the public to enjoy, but again the way the treaty is drafted confuses the intended distinction.<sup>157</sup>

Section 30(1)(g) of Kenya's Copyright Act, (amendment of 2012) grant the performers, the right to decide when their work is to be made available to the public for consumption, the right that is somehow denied to the authors.

#### *Amendments through the Statute Law (Miscellaneous Amendments) Act 2012*

This amendment has brought forth important sections dealing with copyrighted materials in the digital platform, especially in dealing with the performers' rights and their compensation, this has come about by the amendment of section 30(1) of Kenya's copyright work, which protects the rights for transmission of work on video on demand, sharing of material on peer to peer file transmission networks.<sup>158</sup> By amending section 30 (6) and adding subsection (7) and (8), they brought in the exception of a single copy of the act performed for personal use or broadcasting at a fee. The section 30A, added by the 2012 amendment, making it compulsory for payment of the performer's work licensed to the broadcasting organization or other ways of making the work available for public enjoyment, this has created the collective management Organization (CMOs) to collect the royalties on behalf of the creators and performers, but section 30A<sup>159</sup> is not clear on the digital transmission network like webcasting in regards to equality in payment rights.

In the matter of *David Kasika & 4 Others v. Music Copyright Society of Kenya & Another*<sup>160</sup>, section 30A was judicially tested; composers and performance of musical work challenged the CMOs granting rights to caller ring-back tone companies to use the musical workson a platform known as sikiza tune by Safaricom.<sup>161</sup> The court rules that it was not a violation of section 30A, because it provided an opportunity to the public to buy music and use it for public consumption. In the petition of *Mercy Munee Kingoo & Another v.Safaricom Limited & Another*.<sup>162</sup> The court held that giving CMOs the sole authority for receiving the royalty from the money gotten from call ring-back tone was a violation of the copyright holder's freedom of association and hence section 30A was declared unconstitutional.

#### *Exceptions and Limitations*

Section 26 (1), provides the exception of fair dealing under Kenya's Copyright Laws, but it fails to provide a clear definition of what should be considered as fairness.<sup>163</sup> The same section goes ahead to not allow the inclusion of short passages on literary or musical materials used in educational purposes, which is hard to apply in Kenya's education setup which relies on the documents already in existence, and in most cases rely on either the use of the whole work or part of it for educational purposes which should be the reason for this section.<sup>164</sup> In modern times, the digital or e-learning/ distance learning programs use the

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<sup>157</sup> Article 8 of the WIPO Copyright Treaty provides that "...authors of literary and artistic works shall enjoy the exclusive right of authorizing any communication to the public of their works, by wire or wireless means, including the making available to the public of their works in such a way that members of the public may access these works from a place and at a time individually chosen by them." .

<sup>158</sup> Bently and Sherman (n 5) 163.

<sup>159</sup>Kenya's Copyright laws, Section 3.2.2.1.

<sup>160</sup> Petition No. 350 of 2015 [2016] eKLR.

<sup>161</sup> Safaricom Limited, 'Skiza FAQ' <<http://skiza.com/wap2/common/safaricomhelp.ftl>> accessed 20 May 2016.

<sup>162</sup> [2016] eKLR.

<sup>163</sup> Ouma and Sihanya (n 56) 92.

<sup>164</sup> Ouma and Sihanya (n 56) 92.

copyrighted materials, which the section is not clear on, and the need to convert the work into braille form for the visual challenge is another area that the section is not clear on.<sup>165</sup>

Section (26), has failed to take into consideration the movement from analog to digital, which has come with a way to record a broadcast in a digital format and store it on a device like USB or personal video recorder (PVRs) for later use, and the with the approval of set-top boxes<sup>166</sup> the transmission of information has taken a different course, which has also made it possible for reproducing of a large amount of broadcast which is not in agreement with section 29 of the Act.

The shifting to a digital platform has categorized those involved into a group of a broadcaster or rather the creators of the contents and the broadcast signal distributors, in the case of *Communications Commission of Kenya & 5 Others v. Royal Media Services Limited & 5 Others*<sup>167</sup>, the matter in question was granted permission to pay to air broadcasters, permission to air the contents of the petitioners without the consent of the creators, the court relied on the case of *ABS-CBN Broadcasting Corporation v. Philippine Multi-Media System, Inc. & 6 Others*<sup>168</sup> and the court held that Pay Tv broadcasters were not re-broadcasting as it is defined under the Act because they did not take any financial duties as a result of the transmitted products.

The 2014 Amendment of the Act, introduced section 33A, compels a competent authority to give a compulsory license to use of copyrighted materials, this is in response to the provision for developing countries to translate copyrighted work for dispensation of knowledge under the appendix to the Berne Convention for the Protection of Literary and Artistic Works.<sup>169</sup> The 2014 amendment has been hailed as a great step towards helping the marginalized group, realize their potential by translating copyrighted work to help in the provision of education.

#### *Technological Protection Measures and Digital Rights Management*

Kenya's Copyright Act, under section 35(3), guarantees protection of technological protection measures (TPMs) and the removal or alteration of digital rights information (DRMs) in works; the said section states that *copyright is infringed by anyone who circumvents any technical measure designed to protect works; manufactures or distributes devices primarily designed to circumvent these technical measures; removes or alters any electronic rights management information; or distributes, imports, broadcasts or makes available to the public protected works from which electronic rights management information has been removed or altered without the authority of the right holder*. The protection granted to TPMs is preventing the free flow of information in digital format, which makes material such as e-book, journals, etc. not easily accessible for use as outline in section 26, which forces the potential users to either rely on hard copies or find ways to obtain permission to use the work, which could be proving to be not easy, especially where the intended user is visually challenged, and this is the case even if the use falls within the ambit of fair use.<sup>170</sup>

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<sup>165</sup> Denise Rosemary Nicholson, 'Copyright - Are People with Sensory-Disabilities Getting a Fair Deal?', The Fourth Pan-Commonwealth Forum on Open Learning (PCF4). (Commonwealth of Learning and the Caribbean Consortium 2006) <<http://pcf4.dec.uwi.edu/viewpaper.php?id=379&print=1>>

<sup>166</sup> Communications Authority of Kenya, 'Minimum Specifications for DVB-T2 Digital Set Top Boxes for the Kenyan Market' (n 71).

<sup>167</sup> Petition No. 14, 14A, 14B and 14C (Consolidated) of 2014, [2014] eKLR.

<sup>168</sup> G.R. No. 175769-70 (2009).

<sup>169</sup> Berne Convention, 1971 Paris Text, Appendix.

<sup>170</sup> Ouma and Sihanya (n 56) 95.

### *Authentication Devices*

The copyrighted- materials in the line of audiovisual or sound recording are required under 36(1) to have affixation in the form of barcode sticker showing that they are recognized by the Kenya Copyright Board; this section assumes that these products are only available physically, however, this barcode is no longer in existing, it has been replaced by a managed database application.<sup>171</sup>

### **4.3 Enforcement Mechanisms**

The copyright holders are guaranteed protection in the line of civil and criminal justice in case of infringement. If the right holder moves the court for civil remedy, the following can be granted, injunction, damages, an account of profit, and confiscation of the material and product of infringement.<sup>172</sup> The copyright holder can ask the court to take over the management of online platforms used to perpetuate the infringement most so if they are used for commercial gain.<sup>173</sup>

Copyright is no longer consider to be just private property, it is in some circumstances public property as well, hence the criminal remedy involved in its infringement, especially as away to deter the would-be infringers.<sup>174</sup> Kenya's Copyright Act under section 38 prescribes criminal liability to infringers, the punishment ranges from Kshs. 400,000 to Kshs.800,000 fine and imprisonment for a term, not more than ten years.<sup>175</sup> The Act also punishes, unauthorized possession of a security device or machine intending to use it to reproduce security deice with a fine of up to two million shillings or up to ten years in prison or both<sup>176</sup>

## **Conclusions**

The study aimed to highlight the legal and institutional frameworks in Kenya, in place to protect and deal with copyright work and if they are enough to ensure property exploitation of the copyrighted work to the benefit of the holder, the public, and the government.

Based on the above summary, it shows that there exist lacunae in Kenya's Copyright Act, the Act should be clarified and some additional protection for copyrighted- material added, especially in the line of digital work. The point of intermediary liability should be expanded and further studied in comparison with other jurisdictions. The enforcement mechanism and institutional framework must be revamped in the Kenyan system to cater to the changing times and need, especially now that the infringement of copyrighted materials is getting done, online. CMOs must get involved in the collection of royalties online on behalf of the copyright holders, who are getting short changed.

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<sup>171</sup> Kenya Copyright Board, 'Phase Out of the Physical Barcode Sticker' (Kenya Copyright Board, 10 August 2016) <<http://www.copyright.go.ke/media-gallery/news-and-updates/290-phase-out-of-the-physical-barcode-sticker.html>>

<sup>172</sup> Copyright Act (n 75), Section 35; Moni Wekesa and Bernard Sihanya, Intellectual Property Rights in Kenya (Konrad Adenauer Stiftung : SportsLink 2009) at 168 – 169.

<sup>173</sup> Business Action to Stop Counterfeiting and Piracy, 'Roles and Responsibilities of Intermediaries: Fighting Counterfeiting and Piracy in the Supply Chain' at 66 <<http://www.iccwbo.org/Data/Documents/Bascap/International-engagement-and-advocacy/Roles-and-Responsibilities-of-Intermediaries-BASCAP-Report-2015---Low-Resolution/>

<sup>174</sup> Wekesa and Sihanya (n 244) at 169 – 170.

<sup>175</sup> Copyright Act (n 75), Section 38(4) (5)(6)(7)

<sup>176</sup> Kenya's Copyright Act (n 75), Section 36(8).

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# THE EUROPEAN COMMISSION EXPERT GROUP'S TAKE ON STANDARD-ESSENTIAL PATENTS: A SHORT COMMENTARY FOR A LONG REPORT

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## Abstract

European policymakers are seeking to improve the legal certainty, reliability and transparency of the standard-essential patent (“SEP”) licensing framework, as evidenced by several reports and communications over the recent years. In 2017, the European Commission committed to setting up an expert group (“EG”) to monitor SEP licensing markets and gather information on the internet of things (“IoT”) industries practices. In January 2021, the EG published a Report examining the challenges of SEP licensing in the IoT. This paper analyses the EG proposed reforms and comments on their suitability in the IoT licensing context. Overall, two major trends could be identified. One is the move towards greater clarity on the SEP landscape by knowing the number of truly essential SEPs, having more detailed and specific SEP disclosure and ensuring stronger validity chances of granted SEPs. The second is the move towards greater collective industry actions – from agreeing on aggregate royalty rates for a standard for different product categories, agreeing on the levels in the supply chains for licensing SEPs to formation of patent pools and implementer licensing platforms. While these are steps in the right direction, the implementation in practice remains contested. Following the Report structure, this paper first sketches the hotly debated IoT SEP licensing issues. Second, it addresses the EG’s SEP transparency proposals and advanced value chain licensing principles. Then, it reviews the structural reforms on FRAND terms and conditions and on SEP licensing negotiation. Last, the paper deals with patent pools and other collective SEP licensing negotiation proposals before concluding by summing up the findings and paving the way for future discussion.

## Key words

Intellectual Property; FRAND; Antitrust; Innovation; Standardisation

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## Introduction

Back in 2017, the European Commission, in its Communication Setting out the EU approach to Standard-Essential Patents ('SEPs'), committed setting up an expert group ('EG') to monitor SEP licensing markets and gather information on the internet of things ('IoT') industries practices.<sup>1</sup> It followed suit with a Decision of 5 July 2018, two months after which it appointed 15 experts asking them to identify SEP licensing and valuation challenges and possible solutions primarily for the IoT and small and medium-sized enterprises' needs.<sup>2</sup>

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<sup>1</sup>Commission, “Setting Out the EU Approach to Standard Essential Patents,” [Communication] COM(2017) 712 Final, 8.

<sup>2</sup> The individual experts appointed in their personal are: Justus Baron from Northwestern University, Damien Geradin from Tilburg University/Geradin Partners, Sam Granata from Antwerp Appeal Court/EPO, Bowman Heiden from Center for Intellectual Property Gothenburg/University of California Berkeley, Matin Heinebrodt from Bosch (replacing since November 2018 Axel Waltz), Fabian Hoffmann from the German Federal Court of Justice, Aleksandra Kuźnicka-Cholewa from CMS, TaranehMaghame from Via Licensing Corp., Monica Magnusson from Ericsson, Jorge Padilla from Compass Lexecon, Ruud Peters from Peters IP Consultancy,

Although all but one expert acted in their personal capacity, after seven closed-doors meetings, the report delivered in January 2021 is very much polarised along with the patent hold-up and hold-out campaigns of the stakeholders several experts work for.<sup>3</sup>

The expectations on the SEP EG were great since its establishment recognised the Commission's need for external specialist advice as a basis of sound policymaking in the ever more prominent industrial policy area of standardised ICT technologies. At least five European circumstances added suspense on the EG's outcome:

- i) A pending antitrust complaint before the European Commission by automotive firms Continental, Valeo, Gemalto, Daimler and Bury Technologies against Nokia's SEPs licensing practices since late 2018;<sup>4</sup>
- ii) Ongoing evaluation of the Art. 101 TFEU horizontal agreements block-exemption regulation expiring on 31 December 2022, whose guidelines address standardisation and FRAND-licensing commitments;<sup>5</sup>
- iii) Advancing patent law reform in Germany, the busiest patent litigation forum in Europe, that would introduce a 'disproportional hardship' defence for infringers against otherwise justified cease-and-desist orders;<sup>6</sup>
- iv) The Commission's IP Action Plan of 25 November 2020 stating that the Commission will *improve transparency and predictability in SEP licensing via encouraging industry-led initiatives ... combined with possible reforms, including regulatory if and where needed...*;<sup>7</sup>
- v) The 26 November 2020 preliminary ruling referral by the Düsseldorf Regional Court in the Nokia v Daimler case calling the CJEU to indicate whether SEP-holders can choose whom to license their patents in the supply chain and to elucidate further the timing of the Huawei v ZTE negotiating framework.<sup>8</sup>

Policymakers, courts, and standard-development organisations ('SDOs') expecting to copy-paste SEP solutions from the EG will be disappointed. The non-binding, consulting 230-page report advances 79 interlinked and high-level structural reforms, of which 36 main proposals, 40 sub-proposals and three sub-sub-proposals, none of which all members fully endorse. When members anonymously rated each proposal through a one-to-five Trip Advisor-like star-rating system, not only they reached no consensus on any single proposal,

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Matthias Schneider from Audi. The individual expert appointed as representative of a common interest is Sebastiano Toffaletti from European Digital SME Alliance. In November 2020, Roya Ghafele from OxFirst left the group.

<sup>3</sup>J. Baron et al, "Group of Experts on Licensing and Valuation of Standard Essential Patents - Contribution to the Debate on SEPs," (January 2021) (SEPs Expert Group Report) <https://ec.europa.eu/transparency/regexpert/index.cfm?do=groupDetail.groupDetailDoc&id=40990&no=5>.

<sup>4</sup><https://mlexmarketinsight.com/news-hub/editors-picks/area-of-expertise/antitrust/nokia-daimler-fight-could-stall-licensing-talks-if-lawsuit-goes-to-eu-court>

<sup>5</sup><https://ec.europa.eu/info/law/better-regulation/have-your-say/initiatives/11886-EU-competition-rules-on-horizontal-agreements-between-companies-evaluation>

<sup>6</sup><https://www.bundestag.de/recht?url=L2Rva3VtZW50ZS90ZXh0YXJjaGl2LzIwMjEva3cwOC1wYS1yZWNoDC1wYXRlbnRyZWNoDC04MjAwODY=&mod=mod539670> ; Katrin Cremers et al, 'Patent Litigation in Europe' (2017) European Journal of Law and Economics 1, 6.

<sup>7</sup>Commission, "Making the most of EU's Innovative Potential: An Intellectual Property Action Plan to Support the EU's Recovery and Resilience," [Communication] COM(2020) 760 final, 14.

<sup>8</sup> For the questions referred for a preliminary ruling, see, in German, Landgericht Düsseldorf, 'Vorlagebeschluss an den Europäischen Gerichtshof in der patentrechtlichen Verletzungsklage Nokia/Daimler' (Press release, 26 November 2020) <<https://www.lg-duesseldorf.nrw.de/behoerde/presse/Pressemitteilungen-2020/22-20.pdf>>; for an English paraphrasis, see Léon Dijkman, 'Breaking: Düsseldorf Court Refers Questions on Component-Level SEP Licensing to CJEU in Nokia/Daimler' (The IPKat, 26 November 2020) <<https://ipkitten.blogspot.com/2020/11/breaking-duesseldorf-court-refers.html>>. In preliminary ruling proceedings, the enlightenment from Luxembourg takes on average 14.4 months, while the eventual Attorney General's opinion intervenes sometime earlier; see

but sometimes they did not even establish majority support (i.e. 3/5 stars). The star-rating system even has the illogical result that some sub-proposals have more support than the main proposal (e.g. proposal 1 with 3.5/5 and 2 with 4/5, proposal 7 with 4/5 and 13 with 4.5/5, proposal 52 with 3.5/5 and 53 with 4.5/5). Two members publicly regretted the lack of common ground, Monica Magnusson inserting a dissenting opinion in the report itself and Damien Geradin posting his observations on SSRN.<sup>9</sup> As the report itself puts it, one of the *main objectives is to generate ideas for a further debate.*<sup>10</sup>

This paper analyses the EG proposed reforms and comments on their suitability in the IoT licensing context. Overall, two major trends could be identified. One is the move towards greater clarity on the SEP landscape by knowing the number of truly essential SEPs, having more detailed and specific SEP disclosure and ensuring stronger validity chances of granted SEPs. The second is the move towards greater collective industry actions – from agreeing on aggregate royalty rates for a standard for different product categories, agreeing on the levels in the supply chains for licensing SEPs to formation of patent pools and implementer licensing platforms. While these are steps in the right direction, the implementation in practice remains contested.

The paper's structure follows the one from the Report. Section 1 sketches the IoT SEP licensing issues that triggered the EG itself. Section 2 deals with SEP transparency proposals, while Section 3 with value chain licensing principles. Sections 4 and 5 review structural reforms on FRAND terms and conditions and on SEP licensing negotiation, respectively. Section 6 addresses patent pools and other collective SEP licensing negotiation proposals. The conclusion sums up the findings and paves the way for future discussion.

## Results and discussion

### 1 Why an Expert Group on SEPs? The IoT FRAND Licensing Chaos

The need for advice from the SEP EG stems from the commendable realisation that licensing of standardised technologies will scramble with the IoT, involving many more SMEs and industries than now. Four factors synthesise the report's shareable premises on the root causes for the foreseeable increasing complexity of SEP licensing: the multiplicity of IoT verticals, the array of IoT-relevant standards, the manifold IoT business models and the lack of SEP-exposure transparency.

First, communication standards once applied in a few personal devices, such as phones, faxes, pagers, computers and tablets, are turning any everyday object into a *smart something* and will evermore find application in every industrial and consumer sector under the sun (i.e., *smart everything*). So far, IoT verticals, namely the value chains whose ‘things’ become connected and interoperable with anything else, span automotive, agriculture, energy and healthcare industries, among the others. Though licensing demand for the connectivity and interoperability SEPs will skyrocket since such standard technologies have innovation potential for any industry in terms of new products, services and business models.

Second, as the EG correctly notes,<sup>11</sup> communication standards are just a small piece of the IoT puzzle. IoT ecosystems also rely on various, at times complementary or alternative, standardised technologies such as those relating to interoperability (e.g., APIs), quality, cyber security, and all the previously developed industry-specific standards. IoT implementers must in-license all intellectual property for any applicable standard.

<sup>9</sup> Damien Geradin, ‘The European Commission’s expert group Report on SEP licensing and valuation: What did we achieve? What did we miss?’ (2021) [https://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=3783710](https://papers.ssrn.com/sol3/papers.cfm?abstract_id=3783710)

<sup>10</sup> SEPs Expert Group, *Contributions to the Debate on SEPs* (EC, 2021), 17.

<sup>11</sup> SEPs Expert Group, *Contributions to the Debate on SEPs* (EC, 2021), 37–38.

Third, the diversity of IoT verticals' value-chain constituencies disrupts one-size-fits-all SEP licensing customs. During the '90s, within the telecommunication and semiconductor industries, globalisation and economic specialisation added novel R&D-only (fabless) and manufacturing-only (foundries) firm to old-school vertically-integrated firms, both developing their proprietary technologies and selling implementing products. As a result, freedom-to-operate on products markets depend no longer on cross-licensing alone but also on one-way licensing whereby R&D firms are net licensors, and final implementers are net licensees. Now, the IoT brings new business models, such as multisided platforms connecting different customer groups and cloud firms providing software- and analytics-as-a-service, on top of all IoT vertical-specific satellite industries. Where to license SEPs within IoT verticals, therefore where to exhaust patent rights, and how much to charge for it, given the contextual value of SEPs linked to each IoT product, clearly becomes chaotic.<sup>12</sup>

Fourth, the SEP implementers population flooded by SMEs belonging to every IoT vertical, together with any IoT company potentially declaring SEPs to SDOs, fragment the SEP licensing landscape and therein exacerbate transaction costs. The resulting lack of both SEP-exposure transparency and predictability for stakeholders risk escalating into patent and competition law litigation to the detriment of innovation diffusion and R&D investments rewards. In Europe, empirical studies found that SEPs are already more litigated than non-SEPs, Patent-Assertion Entities accounting for most SEP litigation instances.<sup>13</sup> Opposing SEP-holders and implementers factions undoubtedly welcome policy guidance to smoothen SEP licensing for IoT, though the risk of regulatory capture by either faction looms large.

## 2 Increasing SEP Licensing Transparency

One of the Commissions' main objectives highlighted in its 2017 Communication on SEPs is to increase transparency on SEP exposure.<sup>14</sup> Current SDO databases of declared SEP are seen as unreliable as they do not convey the full picture of SEP landscape – many declared SEPs turn out to be non-essential due to widespread over-declaration,<sup>15</sup> the use of blanket disclosures clouds the true number of SEP, and the lack of detail in SEP declarations makes it hard to verify their essentiality and the use by potential implementers. The reason for this unclear SEP picture is because SDO databases were primarily designed to be over-inclusive. Over-inclusion facilitates standard development by guaranteeing openness of standards and assuring SDOs and implementers that licences to SEP will be available on FRAND terms. SDO databases were not intended to advance successful licensing negotiations. The current system, therefore, increases transaction costs both to SEP owners and implementers.

The SEP Expert Groups notes that calls for greater transparency regarding the SEP landscape are generally not controversial and are beneficial to both sides. So far, nothing has been done to change the system primarily because of high initial costs of setting up a new system, mutual concerns of SEP owners and implementers that greater transparency could lead to opportunistic behaviour of the other side, and because sophisticated parties have found a way to "muddle through".<sup>16</sup> However, with the IoT we will expect to see many new

<sup>12</sup>Ibid, 21 and 43.

<sup>13</sup>Ibid, 30-31.

<sup>14</sup> Commission, 'Setting out the EU Approach to Standard Essential Patents' COM(2017) 712 final 3-5.

<sup>15</sup> SEPs Expert Group Report, 35 (noting the average essentiality ratio between 25-40%). This is confirmed by studies, Cyber Creative Institute, Evaluation of LTE Essential Patents Declared at ETSI (2013) (56% of sampled 4G LTE SEP were truly essential); Amplified, GreyB, 'Exploration of 5G Standards and Preliminary Findings on Essentiality' (2020) (19%-34% essentiality ratio for 5G SEPs per different company). Court cases also confirm that many declared SEPs are not truly essential with essentiality rates between 26% to 39% see *Unwired Planet v Huawei* [2017] EWHC 2988 (Pat) and *TCL v Ericsson*, 2017 WL 6611635 (C.D. Cal. 2017).

<sup>16</sup> SEPs Expert Group Report, 48.

standard implements using different business models and lacking a deep understanding of connectivity standards and SEP licensing, thus intensifying licensing disputes and transaction costs related to unclear SEP landscape. The SEP Expert Group makes three large proposals: i) improving SEP declarations, ii) introducing essentiality checks and iii) increasing the likelihood that SEP will be found valid in court.<sup>17</sup>

## 2.1 SEP disclosures

The main idea is to incentivise specific SEP declarations and require SDOs to offer a platform for posting additional information regarding declared SEPs.<sup>18</sup> Specific declarations should identify individual patents, or preferably patent claims, that are believed to be essential, as well as an explanation of standards or parts or standards where SEPs read on. Blanket disclosures would be reserved only for early stages in the standardisation process, while specific disclosure would be required at a later stage once the information on the scope of the final standard and granted patents becomes available. Next, SDOs should offer SEP owners a platform to provide additional and updated information regarding their declared SEPs. Such platform can include information on whether the SEP owner continues to believe that patent is essential, the results of essentiality evaluation, court rulings regarding validity and essentiality, the information on the outcome of patent application and the information on patent's expiry.<sup>19</sup>

While these proposals will certainly make the SEP landscape more transparent and will spur future SEP licensing, the main obstacle is the costs of implementation that will primarily fall on SEP owners. They would have to initiate lengthy patent searches of their portfolios to identify individual patents and parts of standard they relate to and continuously provide such information for different future standard releases. Also, further clarifications are required on when is the cut-off date to make specific disclosure and what happens if some SEPs are not disclosed in time? A study for the European Parliament recommends requiring undisclosed SEPs to be licensed royalty-free.<sup>20</sup> Such a recommendation displaces para 286 of the EC's horizontal-cooperation guidelines, according to which SEP declaration obligations are fungible for the design of SDOs' IPR policies with royalty-free licensing commitments, and it would be unduly harsh to SEP owners, clearly disincentivising participation by vertically-disintegrated R&D firms in European SDOs. Standard implementers are already protected by a blanket commitment to license any SEPs on FRAND terms, and adding a royalty-free penalty on SEP owners may tilt the balance too much in the opposite direction. Moreover, the SEP database would include information that will be available only late in the standardisation process, after the standard has been approved and possible licensing contract concluded, casting doubt on the usability of such an additional database.<sup>21</sup> There is also concern that some SEP owners may submit biased and unreliable information.<sup>22</sup> Therefore, a balancing exercise needs to be undertaken before implementation to assess whether the costs do not outweigh the benefits and risk European SDOs becoming less attractive than other SDOs, which might shift innovation and standardisation away from Europe toward less regulated non-EU SDOs.

Rather than putting the SEP transparency burden on SDO databases, the EC could venture whether better-funded patent offices could chip in. To date, patent offices have official registers that record legal events on their patents and applications, as well as databases (bi-

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<sup>17</sup> Ibid, 49.

<sup>18</sup> Ibid, 50-52.

<sup>19</sup> Ibid, 52-53.

<sup>20</sup> Luke McDonagh and Enrico Bonadio, 'Standard Essential Patents and the Internet of Things' (2019) 7.

<sup>21</sup> SEPs Expert Group Report, 54.

<sup>22</sup> Ibid.

annually published PatStat) and web portals (ESPACENET) that are vastly more sophisticated, speedy and reliable than SDOs' offerings. Patent office's already monetise their patent data products with annual subscription fees. Reductions of patent renewal fees could incentivise SEP-holders to supply information to patent offices, as foreseen for Unitary patents.

## 2.2 Essentiality checks

The SEP Expert Group recommends introducing independent essentiality checks for those SEPs that SEP owner intends to commercialise.<sup>23</sup> The SEP EG's proposals seem largely in line with a separate Commission's study on essentiality checks for SEPs.<sup>24</sup> Essentiality checks would resolve the over-declaration problem and convey an accurate picture of truly essential patents, resulting in smoother licensing negotiations as it would provide a better estimate of the size and value and of SEP owner's portfolio. Ideally, essentiality check should be done as quickly as possible after the approval of a standard and before a SEP owner starts licensing its SEPs. To lower the costs, which are estimated on average to be at least EUR 4,000-5,000 per patent,<sup>25</sup> but could go as high as EUR 10,000 per patent,<sup>26</sup> the SEP owner need not test its whole declared SEP portfolio but only those SEP it believes are still essential at the time of the adoption of the final version of the standard (the estimate is that the SEP owner would filter out 60%-75% of declared SEP by himself) and then only one patent per patent family in a major market country.<sup>27</sup> Such limitations should make essentiality tests more affordable and usable by SEP owners. Patent offices are seen as the preferred bodies to perform essentiality checks or, in the alternative, a supervised network of certified European patent law firms could be used. If possible, essentiality check could also indicate the type of invention that SEP covers (i.e. 'fundamental', 'key') which could be used to assess the underlying value of SEPs better. Finally, SEP owners could submit essentiality confirmation and relevant claim charts to be recorded in SDO SEP databases.<sup>28</sup>

Some more controversial measures also suggested with the aim to incentivise the use of independent essentiality procedure. One option is to allow SEP owners to demand royalties only for confirmed essential SEPs from the date the SEPs were submitted for essentiality checks or, alternatively, allow substantially reduced royalties until SEPs are submitted for essentiality test.<sup>29</sup> However, precluding royalties on untested SEP would go against, TRIPS the IPR Enforcement Directive and national patent laws, which provide patent remedies, including damages, to any patent that is proven valid and infringed by the court. Additionally, a fast-track third-party essentiality challenge procedure was considered to be introduced.<sup>30</sup> The idea is to incentivise third parties to use this faster process, anticipated to last no longer than six months, instead of lengthy and expensive litigation. In order not to discourage SEP owners from using the essentiality process further compensation to SEP owners could be provided if the implementer did not use the essentiality fast track procedure and later loses on essentiality grounds before court, and challenges for all or a substantial number of SEPs of one SEP owner should be prevented. However, while a third-party challenge procedure sounds good in theory as an alternative to litigation, it has a great potential for misuse, imposing additional delays and costs to licensing. Namely, there is nothing to stop implementers from using both this and court procedures to further to stall

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<sup>23</sup> Ibid, 56.

<sup>24</sup> R Bekkers et al, 'Pilot Study for Essentiality Assessment of Standard Essential Patents' (2020).

<sup>25</sup> SEPs Expert Group Report, 61.

<sup>26</sup> R Bekkers et al, 'Pilot Study for Essentiality Assessment of Standard Essential Patents' (2020) 15.

<sup>27</sup> SEPs Expert Group Report, 56, 59.

<sup>28</sup> Ibid, 65.

<sup>29</sup> Ibid, 66

<sup>30</sup> Ibid, 67.

negotiations, and it is unclear how to prevent challenges to the whole or large part SEP owner's portfolio.

Overall, the idea of having some form of voluntary essentiality test sounds reasonable and could be a valuable mechanism to increase the transparency of SEP landscape, facilitating licensing negotiations. However, we should be cautious with its implementation, not to impose unreasonably high costs to SEP owners and provide recalcitrant implements with another venue for delaying negotiations. Thus, any essentiality mechanism should remain strictly voluntary and available to those SEP owners that intend to monetise SEPs.

### 2.3 Validity

The last set of proposals relates to increasing the chances of SEP's validity. One proposal requires SDOs to use existing ETSI's example of making daft standards, written contributions, studies and other submissions to SDOs in standard development process available to patent offices to be identified more easily as prior art in patent examination.<sup>31</sup> For example, the EPO, on top of being an ETSI member since 2003, has memoranda of understanding providing for information sharing and linking of patents and SDO databases with ETSI, IEEE-SA, ITU and IEC, among the others.<sup>32</sup> Proposals to enhance cooperation between SDOs and patent offices have received wide support within the SEP Expert Group and indeed represent a simple measure that would significantly strengthen the validity of granted patents.

Other proposals, however, are more contentious. One that did not appear to have received large support is for SDOs to encourage their members to use opposition proceedings before patent offices to oppose the granting of potential SEPs.<sup>33</sup> The concern is that the collaborative atmosphere within SDO members would be affected, discouraging members from contributing their technologies to standardisation. Furthermore, private ordering solutions to challenging invalid SEPs already exist, Unified Patents being a prominent US example that since 2020 has also ventured EPO oppositions on behalf of its clients.<sup>34</sup>

Another suggestion is to introduce fast-track third-party validity challenge procedure before arbitration panels.<sup>35</sup> Like proposed third-party essentiality challenge, this option is intended to provide a cheaper and faster alternative to lengthy and costly court challenges, which often span multiple jurisdictions. However, arbitration also carries a great potential for misuse, as the validity of a patent can only ultimately be resolved by a court, and the new procedure may add another venue for delaying licensing. Even if arbitral awards would be binding before parties (which is not a given unless parties agree to arbitration), every most prominent European patent litigation venue recognise that patent validity determinations by arbitration have only inter-partes effect, meaning that they are not binding on other implementers who can still challenge the same patent before courts. Therefore, the SEP validity arbitration should remain a strictly voluntary option to parties that genuinely accept to use this process instead of courts, mandating its use might turn into another venue for hold-out.

## 3 Value Chain Licensing

The SEP Expert Group Report has a dedicated section on where to license in the supply chain, which became central in the recent SEP litigation. Tensions arise from a clash of

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<sup>31</sup> Ibid, 70.

<sup>32</sup> Niccolo Galli, Standard Essential Patents Litigation and Abuse of a Dominant Position: The FRAND Defense in the EU Competition Law Context (Master Thesis University of Florence, 2016), 145-146.

<sup>33</sup> SEPs Expert Group Report, 72.

<sup>34</sup> [https://www.unifiedpatents.com/search?q=EPO&f\\_collectionId=5709e539ab48de716450c0ea](https://www.unifiedpatents.com/search?q=EPO&f_collectionId=5709e539ab48de716450c0ea)

<sup>35</sup> SEPs Expert Group Report, 73.

different IoT industry practices - in the telecommunication industry the prevailing practice is to license at the end-device level, while in the automotive industry licensing is done at a component level where it is customary to obtain components clear of all third-party rights. In the recent SEP disputes in Germany, Nokia, Sharp and Conversant sued Daimler for SEP infringement and obtained injunctions after Daimler refused to take a licence and pointed to its suppliers as the appropriate licensee.<sup>36</sup> As a retaliation, Daimler and its component supplier Continental complained to the European Commission that Nokia's practice of licensing SEPs only to car manufacturers and refusing to license component makers is anti-competitive.<sup>37</sup> Recently, the Dusseldorf Regional Court referred to the ECJ the question of the compatibility of Nokia's practice of licensing SEPs only to car manufacturers with Article 102 TFEU.<sup>38</sup>

Against his background, the SEP Expert Group proposes three guiding principles for finding a solution to the question of where to license in the supply chain: i) licensing at a single level in the value chain for a particular product or application; ii) a uniform FRAND royalty for a particular product irrespective of the level of licensing; iii) FRAND royalty is a cost element in the price of a non-finished product (component) and should be passed on downstream.<sup>39</sup> These are sound principles that recognise the efficiencies of licensing only at a single point in the production chain and the fact that royalty should not vary depending on where the SEP is licensed in the value chain. The main argument for component-level licensing is to drive down royalties by capping them at a fraction of current profit margins of unlicensed components, which does not reflect the true value that standardised technology brings to end-products and consumers. For example, assuming the aggregate royalty for cellular standards to be \$15,<sup>40</sup> the royalty can easily exceed current profit margins or even the price of unlicensed components. Thus principles correctly recognise that the price of the IP is an input cost that ultimately needs to be passed on further downstream, making it price-wise irrelevant whether a component or end-device manufacturer pays a royalty.

The implementation of principles is left to collective negotiations between SEP owners and implementers before an independent facilitating body (that can be a body formed specifically for that purpose, or existing licensing administrators or SDOs).<sup>41</sup> It is first suggested that SEP owners internally agree on where they would like to license in the value chain and then hold discussion with implementers to agree on the proposal. The novelty is the recognition that collective negotiations, in this case, should be permitted by antitrust rules going a step further than the acceptance by para. 299 of the EC's horizontal-cooperation guidelines of ex ante disclosures of most restrictive licensing terms by SEP holders. Importantly, the report does not bind or represent the view of the EC and it is also external to the work of DG COMP, the EC department responsible for competition law enforcement, which simply attended most EG meetings. Leaving a fragmented landscape where different SEP owners would license at different supply chain levels will cause tensions, litigation and inefficiencies to implementers that cannot plan their licensing costs. Ideally, an agreement

<sup>36</sup> District Court of Mannheim, 20 34/19 *Nokia v Daimler* (18 August 2020); Mathieu Klos, 'Setback for Daimler in Connected Cars Dispute Against Avanci Pool Members' (11 September 2020) *JUVE Patent*; Konstanze Richter, 'Daimler Loses to Conversant Over Connected Cars SEP' (28 October 2020) *JUVE Patent*.

<sup>37</sup> See Foo Yun Chee, 'Continental, Valeo seek EU antitrust action against Nokia' (17 April 2019) *Reuters*; Scott Graham, 'Nokia, Daimler, Continental Ramp up global patent chess match' (14 June 2019) *Law.com*.

<sup>38</sup> Regional Court Dusseldorf, 'Order for Reference to the European Court of Justice in the Patent Infringement Suit Nokia/Daimler' [Press Release] (26.11.2020).

<sup>39</sup> SEPs Expert Group Report, 84-85.

<sup>40</sup> Which is not unrealistic, patent pool Avanci gathering the largest cellular SEP portfolio charges \$15 per connected car. See <https://www.avanci.com/marketplace/#li-pricing>

<sup>41</sup> SEPs Expert Group Report, 86-88.

should be reached, but if it fails, a hope is that the large number of SEP owners will follow an agreed licensing position which may pressure other companies to accept the outcome.

There are further recommendations on how to facilitate the implementation of value chain licensing models. If licensing at the end-product level is adopted, component manufacturers need to be sufficiently protected to produce their components lawfully. A novel proposal is to grant component suppliers royalty-free licences that are dependent on the existence and payment of a downstream licence.<sup>42</sup> This would prevent exhaustion on the downstream level as upstream licences are dependent on downstream ones and would, at the same time, provide legal certainty to component makers. The applicability of this proposal would need to be further clarified by the Commission. On the other hand, if licensing at a component level is adopted, SEP owners should be allowed to charge different royalties for different downstream applications reflecting the SEP value contributed to final products. A radical option is to change patent laws to provide field-of-use specific exhaustion, so licensing at a component level would not automatically lead to an exhaustion with respect to all downstream uses.<sup>43</sup> More practical suggestions are to use various technical measures, such as software codes, enabling the component to be used in a particular type on end-product. This would permit easier tracking of which component goes to what end-product and allow differential pricing. Alternatively, SEP owners could charge different royalties depending on connectivity rates if chips for different applications use different connectivity rates.<sup>44</sup>

Overall, the value chain licensing principles are sound and represent a move in the right direction. Of course, the implementation remains problematic, but the recognition of the benefits of collective negotiations and industry-wide agreement on licensing levels and principles might lead to optimal solutions. Any collective licensing negotiations need to be first endorsed by the Commission from the perspective of competition law.

#### 4 Clarifying FRAND terms

With respect to FRAND terms and conditions, the SEP Expert Group aims to introduce more transparency into the aggregate price of the standard. Currently, the overall price of connectivity standards is unknown, each SEP owner is responsible for individually licensing and enforcing its SEPs. This creates tensions as implementers cannot plan in advance the cost of IP and leads to disputes over the reasonableness of SEP owners' individual royalties.

Some unilateral and collective measures by SEP owners are considered to increase clarity on the aggregate price of the standard. First, SEP owners could unilaterally announce their most restricting licensing terms, preferably before the standard is set, and declare their views on the reasonable aggregate royalty got standard.<sup>45</sup> However, the ex-ante announcements of most restrictive licensing terms are nothing new, the idea has been around for years,<sup>46</sup> even endorsed by the EC in its horizontal-cooperation guidelines, and many companies are already posting their maximum prices.<sup>47</sup> The problem with unilateral price announcements is that it is

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<sup>42</sup> Ibid, 92.

<sup>43</sup> Ibid, 93.

<sup>44</sup> Ibid, 94.

<sup>45</sup> Ibid, 101.

<sup>46</sup> See See Gil Ohana, Marc Hansen, Omar Shah, 'Disclosure and Negotiation of Licensing Terms Prior to Adoption of Industry Standards: Preventing Another Patent Ambush?' (2003) 24 *European Competition Law Review* 648; Robert Skitols, 'Concerted Buying Power: Its Potential for Addressing the Patent Hold-up Problem in Standard Setting' (2005) 72 *Antitrust Law Journal* 727; Mark Lemley, 'Ten Things to Do About Patent Holdup and Standards (and One Not To)' (2007) 48 *Boston College Law Review* 149; US Department of Justice and the Federal Trade Commission, Antitrust Enforcement of Intellectual Property Rights: Promoting Innovation and Competition (2007) 49-50.

<sup>47</sup> For example for 5G, Ericsson announced that it would license its 5G SEP portfolio between \$2.5 and \$5 per device, Nokia up to EUR 3 per device, up to \$1.2 for Interdigital, 3.25% of the end-device price by Qualcomm. See Eric Stasik, David Cohen, 'Royalty Rates and Licensing Strategies for Essential Patents on 5G

impossible to precisely estimate ex-ante the value that the standard will bring to different devices and applications. To be on the safe side, companies would simply announce the maximum possible rate, but in practice, these maximum prices will not be used and concrete licensing offers will be made once more information on the standard and downstream products is known.<sup>48</sup> Thus having mandatory ex ante maximum price announcement would not add anything useful to SEP licensing. Additionally, unilateral views on a standard's aggregate royalty will not provide a clear picture to standard implementers. For example, consider if one SEP owner announces an aggregate rate of \$10 per product, other 5% of end-product price, while a third SEP owner would prefer a lower \$1 per rate product. Implementers would still be left with unclear and conflicting information on standard's aggregate price.

Recognising these shortcomings, the SEP expert group also considers a collective action where SEP owners would agree on a reasonable aggregate royalty for a standard for different product categories.<sup>49</sup> The proposed aggregate royalty would then be reviewed together with implementers. This would be a better option than unilateral announcements, as it provides an agreed price of the standard that implementer can take into account in their business plans and enables better estimation of the value of individual SEP portfolios. However, a collective price-setting needs to be endorsed by competition authorities, to whom the SEP Expert Group suggest a more lenient attitude via-à-vis industry-wide price negotiations. Nevertheless, the implementation of joint price negotiations must include appropriate competition safeguards. Implementers may act as buyers cartel and collectively exert anti-competitive pressure to depress royalties below a reasonable level.<sup>50</sup> While implementers should be consulted about the reasonableness of standard's aggregate price, the final pricing decision might better be left to SEP owners.

Finally, the SEP Expert Group tries to clarify the non-discrimination requirement of FRAND commitment. It noted the well-established principle that ND does not mean that SEP owner must offer same terms to all (so-called hard-edged non-discrimination), but it requires the SEP owner to treat similarly situated licensees similarly (so-called general or soft-hedged non-discrimination). The Report brings much-needed clarity by listing some practices that are not seen as discriminatory, such as volume discounts, annual royalty caps, agreeing on lump sum payments instead of running royalties, giving preferential terms to incentivise licensing (early bird discounts) and selective enforcement of patents, unless there is clear anti-competitive intent.<sup>51</sup>

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'Telecommunication Standards: What to Expect' (2020) *les Nouvelles* 176.

<sup>48</sup> Based on early announcements by nine SEP owners, an aggregate royalty burden for 4G LTE standard consisted of 14.8% of the end-product price, but in practice it seems that the cumulative SEP royalty yield is only 3.4% of the smartphone's average selling price, see Erik Stasik, 'Royalty Rates and Licensing Strategies for Essential Patents on LTE (4G) Telecommunications Standards' (2010) *Les Nouvelles* 114; Alexander Galetovic, Stephen Haber, Lew Zaretzki, 'An Estimate of the Average Cumulative Royalty Yield in the World Mobile Phone Industry: Theory, Measurement and Results' (2018) 42 *Telecommunications Policy* 263). Also Jorge Contreras, 'Technical Standards and Ex Ante Disclosure: Results and Analysis of an Empirical Study' (2013) 53 *Jurimetrics* 163, 178-179 (illustrating how the Next Generation Mobile Network consortium required members to disclose their maximum SEP royalty rates and for some standards the aggregate royalty rate was 130% of the relevant product price).

<sup>49</sup> SEPs Expert Group Report, 105-107.

<sup>50</sup> Gregory Sidak, 'Patent Holdup and Oligopsonistic Collusion in Standard-Setting Organizations' (2009) 5 *Journal of Competition Law & Economics* 123; Richard Gilbert, 'Deal or No Deal? Licensing Negotiations in Standard Setting Organizations' (2011) 77 *Antitrust Law Journal* 855, 866-68; Anne Layne-Farrar, Gerard Llobet, Jorge Padilla, 'Preventing Patent Hold Up: An Economic Assessment of Ex Ante Licensing Negotiations in Standard Setting' (2009) 37 *AIPLA Quarterly Journal* 445.

<sup>51</sup> SEPs Expert Group Report, 118-119.

The Report suggests some principles to promote non-discriminatory licensing, acknowledging that all provisions of a license contribute to define the value exchanged by the parties. It recommends SEP owners to make and publish standard licensing offers available to all potential licensees, and disclose a list of SEPs and the information on existing licensees, if confidentiality obligations permit.<sup>52</sup> Accepting these principles would go a long way in making SEP licensing market more transparent and resolving disputes where implementers claim they are being offered discriminatory terms. Indeed, there is no reason to keep draft licensing terms secret – other than SEP holders thriving on information asymmetries. Especially in the IoT where mass SEP licensing is anticipated, both implementers and SEP owner would benefit in having published standard SEP licensing terms.

Additional measures were also proposed. The establishment a confidential repository of SEP licensing agreements received wide acceptance.<sup>53</sup> The repository would be accessed only by courts, competition authorities, arbitrators or trusted persons for verifying the compliance with ND requirement. The report also suggests a methodology to assess the compliance with ND obligation where key terms and conditions of compared licence will be benchmarked against all other licensing agreements with similarly situated licensees. However, much of the problem with the compliance with ND obligation would disappear if SEP owners would simply publish their standard licensing offers. Offering the same standard licensing offer to all similarly situated licensees would dispense with ND obligation.<sup>54</sup> In individual negotiations royalty may be adjusted downwards, but no implementer would be offered harsher terms than those provided in the standard offer.

## 5 Smoother Conclusion of FRAND Licenses (Negotiations and Disputes): Punishment and Repentance

The report recognises that bilateral FRAND licenses require complex negotiation over standard-essentiality, patent validity, the scope licensed products (i.e. infringement), the consideration due through monetary and non-monetary means, and the compliance of the license with FRAND commitments.<sup>55</sup> Expanding the *Huawei/ZTE* framework, several proposals aim for a smoother conclusion of FRAND licenses and resolution of their disputes striving to impose good faith obligations on both SEP-holders and implementers. A proportionality rationale between SEP-holders' diligence in demonstrating standard-essentiality plus disclosing draft licenses and implementers' pro-activeness in seeking licenses underlies most proposals.

The overarching structural reform, endorsed by a scarce majority of EG members, is a commission-led co-regulation framework that facilitates the conclusion of IoT licenses putting the most burden on SEP holders.<sup>56</sup> Albeit the reform itself concedes that *it is hard to give more detail as to exactly how to do this*,<sup>57</sup> in practice, the Commission should induce global commitments by major SEP holders to publish more licensing information across multiple standards, provide more in depth patent data under NDA and abide by dispute resolution mechanisms tailored to IoT licensing. The proposal stretches the territorial reach

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<sup>52</sup> Ibid 120.

<sup>53</sup> Ibid 121.

<sup>54</sup> A view shared by the UK Supreme Court in *Unwired Planet v Huawei* 114 [2020] UKSC 37 (“the terms and conditions on offer should be such as are generally available as a fair market price for any market participant, to reflect the true value of the SEPs to which the licence relates and without adjustment depending on the individual characteristics of a particular market participant. Put another way, there is to be a single royalty price list available to all.”).

<sup>55</sup> Niccolò Galli, ‘Patent Aggregation in Europe: The Spotlight on Patent Licensing by Patent Aggregators’ (2020) EIPIN-IS Research Paper no. 20-03, 4-7.

<sup>56</sup> SEPs Expert Group Report, 123.

<sup>57</sup> Ibid.

of the Commission-led co-regulation beyond the EU, while the Commission would spot bad market players because either SEP holders do not commit to the Commission's principles or implementers do not comply with them. Despite the vagueness of such an overarching structural reform, it might turn out to be feasible since the EC, through its antitrust branch, has already obtained voluntary licensing commitments by SEP holders.<sup>58</sup> However, any EC's effort to agree with all stakeholders suitable and effective IoT-vertical-specific licensing frameworks might be in vain if it does not precede the CJEU ruling in the *Nokia/Daimler* case or at least the Advocate General's desirable opinion.

After the overarching reform, the proposals address SEP holders' negotiating behaviour, which under the *Huawei/ZTE* framework must make the first FRAND negotiation move and not exploit the surprise effect of preliminary injunctions. The EG suggests that without the need of an NDA, SEP holders must provide their assertion targets with both detailed machine-readable lists of all to-be-licensed patents, evidence of standard-essentiality documents for at least a representative sample of SEPs and inventories of already licensed implementers without infringing confidentiality obligations.<sup>59</sup> More specific claim charts of at least a sample of SEPs, evidencing their infringement, should become available under NDAs, conceding that such documents are costly to prepare and in the wrong hands could backfire against the SEP holder.<sup>60</sup> Such a property notice burden seems reasonable and proportional. On the one hand, patent data are in any case public on patent offices' official registers, evidence of standard-essentiality documents often ground previously-made standard-essentiality declarations and lists of existing licensees determine implementers' need and urge of closing a license. On the other hand, the two-tiered nature of SEP holders' information provision accommodates both situations where implementers are cooperative and sign NDAs and situations whereby implementers' contracts with suppliers preclude them from signing NDAs. Perhaps, it is puzzling what the proposals add to current SEP licensing customs.

Then the EG focuses on implementers' pro-active negotiation behaviour, though leaving it open the fundamental question of which implementers within IoT verticals should engage in negotiations and licensing. The departure point acknowledges that under *Huawei/ZTE*, implementers can wait and see (read infringe) until SEP holders make their first FRAND move and have no incentive to take a license beforehand. Such a circumstance tilts the level playing field not just for implementers, as the report states, but also for SEP holders. The EG notes that until SEP holders' first move, implementers might inadvertently accumulate past due royalties from the commercialisation of their standard-compliant products until the conclusion of a license, which may also distort downstream competition among licensed implementers and infringers.<sup>61</sup> The EG forgets that SEP holders, especially those without a foothold on standard-compliant product markets, often have no means of assessing their SEPs' implementation and even if they do, they might lack enforcement capabilities and resources. To resolve the first move issue, the Commission or an EU reform, could require implementers to seek SEP licenses pro-actively prior to product commercialisation from *diligent* SEP holders, under penalty of being considered holding-out infringers, paying a higher than FRAND royalty for past unlicensed use and risking patent infringement

<sup>58</sup> Commission, Press Release 10 December 2009 MEMO/09/549, Case COMP/39615 IPCom; Rambus (Case COMP/38.636) Commission Decision 9 December 2009 (Summary 2010/C 30/09 OJ C/30/17) [2009]; Google/Motorola Mobility (Case COMP/M.6381) Commission Decision 13 February 2012 (C(2012)1068) OJ C75/1; Mario Mariniello, 'Fair, Reasonable and Non-Discriminatory (FRAND) Terms: A Challenge for Competition Authorities' (2011) 7(3) Journal of Competition Law and Economics 523, 524-525.

<sup>59</sup> SEPs Expert Group Report, 125-126.

<sup>60</sup> Ibid, 126.

<sup>61</sup> Ibid, 126-127.

remedies.<sup>62</sup> In this sense, diligent SEP holders benefitting of implementers' pro-activeness would be just those who publish their draft licenses and either comply with the proposed enhanced SDOs' disclosure and database transparency obligations or publish claim charts of essentiality-checked SEPs.<sup>63</sup> Making such information public would qualify as putting all implementers on notice, shifting the FRAND negotiation burden to them.<sup>64</sup>

The EG then goes a step further in implementers' pro-activeness and suggests that if SEP holders do not publish draft contracts, implementers must be obliged to record standard-compliant products in SDOs' databases. In turn, just essentiality-checked SEP-holders would access such recordings.<sup>65</sup> Again the penalty for non-compliant implementers would be a higher than-FRAND royalty for past unlicensed use that should not be passed on along the value chain like a normal FRAND royalty.<sup>66</sup> It is difficult to see how such a recording obligation would be administrable in the IoT, with myriads of implementers of even the smallest size and manifold business models.

The reforms on SEP disputes overall aim at re-establishing implementers' incentives to seek FRAND licenses without the need for SEP-holders' first enforcement move while discouraging SEP-holders' strategic negotiation tactics. On the one hand, courts should impose a penalty on top of FRAND royalties for holding-out implementers, evidenced by delayed response to license offers or consciously initiating declaratory litigation on standard-essentiality, validity or non-infringement against litigation-tested patents.<sup>67</sup> Further, in case of a Mexican stand-off between rejected FRAND offer and counteroffer not triggering arbitration, implementers should start paying into escrow at least their FRAND counteroffer.<sup>68</sup> Implementers' obligation to behave as if licensed goes back to the 2009 *Orange-Book* German case law and is a good tool to prevent intentional holdout strategies. The *Huawei/ZTE* minimum requirement of implementers' security deposit for past acts of use just preserves SEP holders' interest for damages compensation and allows implementers to impair the future conclusion of a FRAND license after a final court adjudication.<sup>69</sup> On the other hand, courts finding that SEP-holders engaged in bad-faith negotiation tactics should award diligent licensees a FRAND royalty discount for both past un-licensed use and time-limited licensed use. In this sense, far-reaching NDAs, refusal to provide patent lists and claim charts, no royalty formula specification and no grounds for rejecting the FRAND counteroffer would prove SEP-holders' bad faith.<sup>70</sup>

Taking inspiration from the German competition case-law on utility service providers, a scarce majority of the EG also proposes that courts in front of a FRAND royalty range of offer and counteroffer, solve the rebus by picking through their independent experts the royalty closer to the weighted mean value between the parties' FRAND royalty rates. As a second-best solution, adjudicating courts should pick the mean royalty rate itself whether both parties' FRAND royalty rates deviate by more than 3% from it.<sup>71</sup> Clearly, the proposal downplays the non-price value exchanged through FRAND licenses. Moreover, it also exacerbates the prisoner's dilemma setting of FRAND negotiations, whereby the opposing

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<sup>62</sup>Ibid, 127-128. Proposal 66 superfluously asks to clarify that under the *Huawei/ZTE* framework, SEP holders can get injunctions lawfully if implementers do not sufficiently rebut their FRAND offers nor make FRAND counteroffers.

<sup>63</sup>SEPs Expert Group Report, 129-130.

<sup>64</sup>Ibid, 131.

<sup>65</sup>Ibid, 132-133.

<sup>66</sup>Ibid, 133.

<sup>67</sup>Ibid, 134-135.

<sup>68</sup>Ibid, 136.

<sup>69</sup>Ibid, 131.

<sup>70</sup>Ibid, 136.

<sup>71</sup>Ibid, 137-138.

rational SEP-holder and implementer acting in their self-interest ensure a negative outcome for both by betraying each other.<sup>72</sup> Expecting that the court will ultimately ‘split the baby’, the parties have no incentive to make a reasonable offer that will be inevitably discarded. Thus, the escalation of the prisoner’s dilemma would make both patent hold-up and hold-out systemic and, most importantly, jeopardise trust in the patent system and standardisation as fundamental pillars of the open innovation paradigm. The side effect of imposing courts to pick the mean value of a FRAND range could be directing reasonable SEP holders and implementers towards alternative dispute resolution avenues.

Always on litigation, a strong majority of the EG advances that EU regulations should set up new tools to ease FRAND dispute resolution. First, an ad hoc market transparency office should maintain a confidential repository of SEP licenses for use in FRAND disputes by courts, competition authorities and ADR boards.<sup>73</sup> Perhaps, the proponents had in mind something similar to the EUIPO European Observatory on the enforcement of intellectual property rights, which since 2009 provides data, tools and databases to support IP infringement countermeasures. Second, alternative dispute resolution service providers or the EUIPO should host new independent expert boards specifically established to determine FRAND royalties.<sup>74</sup> From the report, it is not easy to see how the new FRAND independent expert boards differentiate from commonly appointed independent court experts or current expert adjudication procedures of ADR-service providers.

Finally, the EG calls for more ADRs for FRAND licensing disputes, throwing out two proposals at the end of the dispute section. On the one hand, a specialised FRAND mediation institute should be created, though not specifying by whom.<sup>75</sup> On the other hand, parties to FRAND licenses should always submit their breach of contract issues to expedited arbitration,<sup>76</sup> as if license parties do not already assess such an opportunity in the customary compromissory clauses. Surprisingly, the two reforms do not even mention that WIPO already has FRAND-specific alternative dispute resolution rules and that any adjudicator can freely use the FRAND ADR Case Management Guidelines by the Munich IP Dispute Resolution Forum. Equally overlooked are existing arbitration clauses in SDOs’ by-laws such as those of DVB Project, Blue-Ray Association and VITA.<sup>77</sup>

## 6 Joint Licensing Actions for the IoT

After a comprehensive overview of patent pools’ functioning the last set of proposals advance collective mechanisms to solve SEP licensing issues.<sup>78</sup> In brief, the EG recognises that the IoT needs patent pools and similar joint initiatives to overcome the transaction costs of licensing in the IoT.<sup>79</sup> At least initially, patent pools offer a better IoT freedom-to-operate proposition than cross-licensing since SEPs become general-purpose technologies applicable beyond their industry of origin and used by different business models with a removed technology background.<sup>80</sup>

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<sup>72</sup> Joseph Siino, ‘Escaping the prisoner’s dilemma: towards a new transparency in patent licensing’ (July/August 2017) 84 Intellectual Asset Management 58, 64.

<sup>73</sup> SEPs Expert Group Report, 144.

<sup>74</sup> Ibid, 145-146.

<sup>75</sup> Ibid, 147-148.

<sup>76</sup> Ibid, 148.

<sup>77</sup> Jorge Contreras and David Newman, ‘Developing a Framework for Arbitrating Standards-Essential Patent Disputes’ (2014) Journal of Dispute Resolution 23, 47-49.

<sup>78</sup> SEPs Expert Group Report, 150-157.

<sup>79</sup> Ibid, 158-161.

<sup>80</sup> Ibid, 157-158 and 160.

The first suggestion is that EC guidelines or a communication induce SDOs to foster the external formation of patent pools already during the final phase of standardisation.<sup>81</sup> The independence of SDOs from the patent pools reassures antitrust hub-and-spoke collusion concerns and ensures that licensing negotiation do not delay standardisation. Anticipating pool formation before the standard adoption realigns the commercialisation of standard-implementing products with the availability of a license for the relevant SEPs, avoids past-due royalties for un-licensed use and clears uncertainties over a reasonable estimate of the aggregate FRAND royalty burden. The example SDOs should follow is DVB, a consortium developing digital TV standards, which fosters voluntary, yet external, joint licensing programmes. The DVB FRAND IPR policy foresees that within two years after adopting a specification, at least 70% of all relevant SEP holders must establish a patent pool or disputes between DVB members are subject to mandatory arbitration.<sup>82</sup> As of February 2021, Sisvel acts as patent pool administrator for seven DVB standard specifications.<sup>83</sup> More engagement by SDOs for the smooth uptake of their IoT standards is welcome, as evidenced by the alleged interaction on the issue between ETSI and DVB, as declared by an ETSI representative during the first DG GROW online seminar after the publication of the SEP EG report. The desirable forthcoming revision of the Art. 101 TFEU horizontal cooperation guidelines comes handy for the EC to foster SDOs' patent pool fostering.

It is less feasible to amend national patent laws to provide non-exclusive patent licensees with full infringement standing. In fact, patent pools mostly aggregate SEP portfolios through non-exclusive licenses with sublicensing rights, which preserves pool contributors' independent licensing rights yet precludes patent pools from suing infringers directly. On top of the legislative hurdles to change national patent laws and rules of civil procedure, the antitrust concerns are high against patent pools acting as the litigation hub on behalf of colluding SEP-holders spokes.<sup>84</sup> Furthermore, patent pools already employ private ordering solutions to ease the collective action problems of pool members' individual infringement actions that antitrust agencies did not challenge in the most recent occasions. The US Department of Justice, when reviewing the proposed formation of the Avanci 5G patent pool, did not question either the fact that enforcement support by individual pool members against unwilling licensees counts for the pool royalty distribution scheme nor that Avanci reimburses litigation costs if sued infringers sign pool licenses.<sup>85</sup> The US DOJ, even disavowed the long-standing requirement of pool members' retention of independent licensing rights for the University Technology Licensing Program, which is the first non-SEP patent pool that exclusively in-licenses the pooled patents and enforces them though upon the individual patent owner's determination.<sup>86</sup>

As the ultimate solution the EG considered establishing a pool of pools that would aggregate and license in one package all standards for a particular product category, like the One-Blue pool which licenses different standards for Blu-ray disks players and recorders.<sup>87</sup> The suggestion is ambitious since it would increase licensing transaction-cost savings yet much to be desired. . In fact, patent pools have rarely succeeded gathering all

<sup>81</sup>Ibid, 162.

<sup>82</sup>Ibid, 163.

<sup>83</sup><https://dvb.org/about/policies-procedures/licensing-programmes/>

<sup>84</sup>SEPs Expert Group Report, 177-178.

<sup>85</sup>Mark Hamer, 'Letter of Request for Business Review of Avanci's Proposed 5G Patent Platform for Connected Transportation Vehicles' (21 November 2019), 6; MakanDelrahim, 'Letter to Mark Hamer: Avanci Business Review Letter' (28 July 2020), 6.

<sup>86</sup>Micheal Murray, 'Letter to Garrard Beeney: UTLP Business Review Letter' (13 January 2021), 9; Garrard Beeney, 'Letter of Request for Business Review of University Technology Licensing Program' (14 August 2020), 7.

<sup>87</sup>SEPs Expert Group Report, 173-174.

relevant SEP holders even for individual standards, sometimes even competing over the same standards and always coexisting with some degree of external SEP licensing. It remains to be seen if the IoT will bring greater convergence among SEP owners towards larger pool solutions.

Until patent pools are established, the EG considered that a public agency may grant SEP licenses. Such SEP licensing agency would resemble a copyright collective management organisation being mandatory for SEP holders.<sup>88</sup> Perhaps, the geopolitical difficulty of implementing a SEP licensing agency in at least the medium term, the scepticism against an additional regulatory layer for already complex standardisation or collective management organisations' many challenges made the proposal one of the least supported by the EG.<sup>89</sup>

Finally, the EG remembered that FRAND licenses are tales of two protagonists, where SEP holders and implementers are not leading and supporting actors, respectively, but rather co-protagonists. Specularly to SEP holders' patent pool efforts, implementers should form collective licensing negotiation groups whose licensing determinations bind participating implementers.<sup>90</sup> A single patent pool for all standards applicable to a given IoT product together with a single licensing negotiation group of all relevant IoT product implementers would bring the benefit of a one-stop-shop for both SEP holders and licensees, minimising overall transaction costs. In this sense, an example exists of a one-to-one transaction between a patent-pool and a group of licensees. Early in 2019, the patent pool administrator Sisvel and the defensive patent aggregator RPX concluded a contract providing a subset of RPX clients with a license for the Wi-Fi patent portfolio managed by Sisvel.<sup>91</sup> Again, the next Art. 101 TFEU horizontal cooperation guidelines are a convenient venue to incentivise collective actions by SEP implementers while keeping monopsony risks, in the form of collective patent hold-out, under competition law check.

## Conclusions

The SEP EG provides a valuable collection of proposals for the future of SEP licensing in the IoT. While many are often conflicting and some are ideal world aspirations, two common unifying themes can be identified. One is the move towards greater clarity on the SEP landscape by knowing the number of truly essential SEPs, having more detailed and specific SEP disclosure and ensuring stronger validity chances of granted SEPs. The second is the move towards greater collective industry actions – from agreeing on aggregate royalty rates for a standard for different product categories, agreeing on the levels in the supply chains for licensing SEPs to formation of patent pools and implementer licensing platforms. All these collective actions are followed with the recognition that competition authorities should take a more lenient approach and acknowledge the pro-competitive potential collective industry negotiations in the SEP licensing environment in the IoT. These two trends are commendable and represent a step in the right direction, although the devil is in the details and the successful implementation of these proposals is something to be worked out in the years to come.

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<sup>88</sup>Ibid, 167-168.

<sup>89</sup>Such a structural reform is attributable to the expert Fabian Hoffmann, who previously introduced the idea during a 2019 conference at the German patent office in Munich. <https://www.ipdr-forum.org/events/gema-type-frand-agencies/>

<sup>90</sup>SEPs Expert Group Report, 169-171.

<sup>91</sup><https://www.sisvel.com/news-events/news/sisvel-and-rpx-conclude-licensing-agreement-for-wi-fi-standard-essential-patents>

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# **SELECTED LEGAL AND ECONOMIC ASPECTS OF PROTECTING OF BIOTECHNOLOGICAL INVENTION FROM THE PERSPECTIVE OF POLISH LAW**

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## **Abstract**

The study covers selected issues in the field of biotechnology, including issues related to patenting of solutions included in the framework of intellectual property protection. The considerations are based on Polish legislation on the protection of intellectual property, doctrinal and case law views. Terminology in the field of biotechnology, the specificity of its subject matter, i.e. living matter undoubtedly, apart from legal problems, also generates moral, ethical and social controversies. Thus, the discussion on the patenting of intangible goods in this field remains open. A positive phenomenon is the fact that its scope is expanding to include more and more new solutions subject to patent protection. The trend is towards ‘protecting everything under the sun created by man’. Strong economic arguments are no less important. Business trading requires effective means of protecting innovative activities. So far, patent protection, although imperfect, has been the most common way of both determining ownership rights to a solution and bringing it into production exclusively.

## **Key words**

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patent protection, biotechnology, business transactions, innovations, Polish law

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## **Introduction**

Progress in the biotechnology industry is opening up new economic, social and legal opportunities. Biotechnology solutions have been differentiated as a separate technological products for a long time. Entrepreneurs are increasingly willing to use such solutions as part of their business. They are often used to develop an innovative product and its commercialisation. The multifaceted application of biotechnological solutions in modern economic relations not only justifies the discussion, but also the need for effective legal protection of such innovations at each stage of their production. At the national and international level, typical protection can be obtained by getting a patent.

Apart from the controversy and factors determining the obtaining of a patent for a biotechnological invention, a patent obtained for a biotechnological solution guarantees a time-limited economic monopoly on the use of the solution subject to the patent.

The process of defining biotechnology is very dynamic. In Poland and in the world it is assumed that ‘biotechnology is an interdisciplinary field of science and technology dealing with changes in living and non-living matter through the use of living organisms, their parts or products derived from them, as well as models of biological processes in order to create knowledge, goods and services’<sup>92</sup>. The complexity of biotechnological solutions and the open debate on their patentability as intangible property results directly from the general way in which biotechnology is defined as the ability to exploit living organisms, including their

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<sup>92</sup> <https://stat.gov.pl/metainformacje/slownik-pojec> [Access: 25.04.2021].

elements and processes, in order to achieve man-made results<sup>93</sup>. Biotechnological solutions, like other goods of a technological nature, are often based on scientific discoveries. Nevertheless, the patenting of a biotechnological invention, which is difficult and for many reasons, has not received so far a separate and specialised regulation.

Despite the dynamic development and complexity of the processes characterising solutions in the field of biotechnology, the decision to grant a patent is still based on a vague reference to the principles of ethics, morality or public order. From a moral and social point of view, such reference to extra-legal norms is intended to prevent, *inter alia*, the patenting of certain hybrids created, for example, by implanting human genetic material in animal embryos, including experiments involving the ‘humanisation’ of animals, for example by injecting human stem cells into the brains of monkeys. There is no doubt that some of the problems are rooted in the traditional, conservative belief that certain activities, even technical ones, should not be undertaken by human beings, because they do not fall within the competence of human beings<sup>94</sup>.

## Material and methods

The basic research method was the dogmatic analysis of normative texts, characteristic for the work of a scientist in the field of law. The study has also been supported by the views of doctrine and judicature of the relevant subject. To some extent the statistical method has also been used, in order to show the importance of biotechnological inventions to the economy.

## Results and discussion

Some authors maintain that such variability introduced into the animal world by man can have a destructive effect on intra- and interspecies transformations developed over years of evolution. Human impact often leads to habitat loss and degradation, pollution, the introduction of new species or climate change. This can result in a noticeable decline in populations and in ever-increasing selection pressures that lead to evolutionary reactions, which in turn can have a negative impact on the future stability, productivity and persistence of species<sup>95</sup>.

It should be noted that normative definitions do not always allow for patent protection of a particular biotechnological solution. In the past and at present, the patentability of individual solutions in the field of biotechnology was and is also subject to a court decision which determines the granting of protection. The time, complexity and outcome of court proceedings in turn affect the motivation to try and obtain legal protection for a particular solution.

The procedure within the Patent Office itself constitutes often a barrier. As an example, in case no. P. 306805 the Polish Patent Office refused to grant patent protection for a new variety of mushroom, arguing that the new variety of mushroom constitutes a new plant variety. Another example is an application for a patent for a strain of *Tolypocladium* disclosed by an appropriate depository, registered under No. 309613. The Office refused to grant patent protection, pointing out, *inter alia*, that the strain *Tolypocladium* was isolated from a soil sample from Russia, from the vicinity of Moscow, and therefore it is an

<sup>93</sup> J. Głowacz, *Zdolność patentowa nowopowstałych zwierząt – przyczynek do dyskusji* in: *Zeszyt naukowy Naukowego Koła Cywilistów. Prawo autorskie i własność przemysłowa*, D. Nawieśniak, M. Nitkowski, A. Pietraszewska, M. Szczepaniak (ed.), Wrocław 2015, p. 20.

<sup>94</sup> H. Żakowska-Henzler, *Wynalazek biotechnologiczny. Przedmiot patentu*, Warszawa 2006, p. 14.

<sup>95</sup> M. Pfenniger, M. Bálint, & S.U. Pauls, *Methodological framework for projecting the potential loss of intraspecific genetic diversity due to global climate change*. *BMC Evolutionary Biology* 2012, no. 12, p. 224.

objectively existing phenomenon in the nature surrounding man, a discovery enriching knowledge and not an invention.

The wide application of biotechnological solutions in the field of environmental protection should be emphasised. In particular, the use of bacteria which remove pollutants or in agriculture, e.g. transgenic plants and animal breeding, should be pointed out too<sup>96</sup>.

In economic terms, on the other hand, the appropriate protection of biotechnological inventions influences the market advantage of a company and is an important element in its commercial success<sup>97</sup>. A patent constitutes an asset for a company and therefore increases its value. In real terms, it increases the possibility of capital accumulation, which is important for dynamically growing companies<sup>98</sup>. This is important for dynamically growing companies, especially those focused on obtaining external funding. Nevertheless, the tendency for companies and inventors to use patents to limit competition on the market is clearly visible. So-called artificial monopolies are created using patent law provisions, which constitute a negative economic phenomenon<sup>99</sup>.

It is vital to mention now the modifications which have occurred to Polish law in relation to these issues. In this context, particular reference shall be made to the issuance of the amendment<sup>100</sup> to the Act of 30 June 2000 - Industrial Property Law<sup>101</sup>. added a new chapter entitled ‘Specific provisions concerning biotechnological inventions’. It is essential to mention, that the common principles of patentability were included in par. 24 and the following ones of this Act. The above-mentioned sanctioning of patent protection of biotechnological solutions occurred at the time of transposition of the EU Directive 98/44/EC of 6 July 1998 on the legal protection of biotechnological inventions<sup>102</sup>. Adjusting national regulations to the provisions of the European Law, Chapter 9 containing specific provisions concerning biotechnological inventions was added to the Industrial Property Law. This matter is regulated from Article 93<sup>1</sup> to Article 93<sup>7</sup>. Implementing provisions are also included in several regulations. In that context it shall be emphasized that some provisions concerning these issues are stipulated in the Act of June 23, 2003 on legal protection of plant varieties<sup>103</sup>.

In accordance with the provisions of par. 93<sup>1</sup>, by ‘biotechnological invention’ - within the meaning of its par. 24, we shall concern a product consisting of or containing biological material, or a process by means of which biological material is produced, processed or used: to ‘biological material’ shall mean any material containing genetic information and capable of reproducing itself or being reproduced in a biological system and to “microbiological process” shall mean any process involving or performed upon or resulting in microbiological material.

Pursuant to Article 93<sup>2</sup> of the Industrial Property Law Act, biotechnological inventions which can be patented are in particular the following inventions eligible for patent protection: inventions, the subject of which is biological material which is isolated from its natural

<sup>96</sup> See. I. Hasińska I., Lipińska, *Z problematyki hodowli zwierząt gospodarskich w świetle nowych regulacji prawnych*, Przegląd Prawa Rolnego no 2 (27)/2020, p. 101-114.

<sup>97</sup> See. I. Hasińska, Prawno-ekonomiczne aspekty wynalazku biotechnologicznego, Poznań 2019, Intercathedra, 2(39), 2019, p. 133–140.

<sup>98</sup> J. Chakma, S.M. Sammut, A. Agrawal, Life Sciences Venture Capital in Emerging Markets, „Nature Biotechnology” 2013, vol. 31, p. 195-201.

<sup>99</sup> See: J. Prokop, A. Karbowski, Kontrowersje związane z ekonomicznym uzasadnieniem ochrony patentowej. Przyczynek do dyskusji in: Konkurencyjność podmiotów gospodarczych w Polsce, W. Jarecki (ed.), Wydawnictwo Naukowe Uniwersytetu Szczecińskiego, Szczecin 2012, p. 29-48.

<sup>100</sup> Amendment of 6 June 2002, Journal of Laws 2002, No. 108, item 945.

<sup>101</sup> Journal of Laws 2001, no. 49, item 508 as amended.

<sup>102</sup> EU Directive 98/44/EC of 6 July 1998 on the legal protection of biotechnological inventions, European Journal of Laws, 213, 30.7.1998, p. 13–21.

<sup>103</sup> Journal of Laws 2003, No. 137, item 1300 as amended.

environment or produced by means of a technical process, even if it previously occurred in nature, elements isolated from the human body or otherwise produced by means of a technical process, including the sequence or partial sequence of a gene, even if the structure of that element is identical to that of a natural element, inventions which concern plants or animals, if the technical feasibility of the invention is not confined to a particular plant or animal variety. In a patent application containing a sequence or a partial sequence of a gene, the industrial application of the sequence shall be disclosed in the description of the patent, while an independent patent claim shall indicate the function performed by the sequence. In order to fulfil the industrial application criterion in the case of the sequence or a partial sequence of a gene being used to produce protein or protein component, the description of the invention shall determine which protein or which protein component is produced and what functions it performs. If the patent application referred to in paragraph 2 discloses nucleotide or amino acid sequences, the applicant shall submit the sequence listing electronically.

The legislator also specified which solutions in the field of biotechnology shall not constitute inventions. This group does not include: the human body, at the various stages of its formation and development, and the simple discovery of one of its elements, including the sequence or partial sequence of a gene<sup>104</sup>. Moreover, as ‘biotechnological inventions, whose exploitation would be contrary to public order or morality within the meaning of Article 29<sup>1</sup>, or with public morality’ shall be considered: processes for cloning human beings; processes for modifying the germ line genetic identity of human beings; uses of human embryos for industrial or commercial purposes; processes for modifying the genetic identity of animals which are likely to cause them suffering without any substantial medical benefit to man or animal, and also animals resulting from such processes<sup>105</sup>.

The doctrine has also expressed the view that the statutory refusal of patent protection to activities generally regarded as morally unacceptable and unethical does not constitute a prohibition to perform them. Thus, conducting research in the field of solutions subject to statutory exclusions should not be perceived as conducting illegal activity or threatened with criminal liability. The purpose of the Act is not to restrict implementations of a biotechnological nature. It is the results of long-term research that have led to the successive introduction of complex biotechnological solutions into the market<sup>106</sup>.

It should be noted that a frequent reason for refusal to grant patent protection for solutions in the field of biotechnology is the lack of novelty of the claimed invention. Thus, a publication, prior to the date of filing the patent application, containing information on the essence of the solution may prevent it from obtaining patent protection. Another reason is inaccurate disclosure of a given solution and formulation of patent claims in the invention description. Moreover, applications in this field often include various solutions formulated in the form of numerous independent claims. Leaving them within one application, in order to meet the requirement of unity, will be possible when they clearly constitute a single invention idea<sup>107</sup>.

Despite these and ongoing legal amendments, the institution of the patent itself remains unchanged in national law. Any solution, regardless of the field of technology, including agriculture, requires three features, namely, novelty, inventive step and industrial applicability. Protection by patent means the acquisition of the right to use the invention exclusively for profit or for professional purposes within the territory of the country in which

<sup>104</sup> Par. 93<sup>3</sup> point 1 Industrial Property Law Act.

<sup>105</sup> Par. 93<sup>3</sup> point 2 Industrial Property Law Act.

<sup>106</sup> See: M. Smycz, Komentarz do ustawy z dnia 6 czerwca 2002 r. o zmianie ustawy – Prawo własności przemysłowej, P. J. of L. no. 02.108.945, LEX/el. 2002.

<sup>107</sup> D. Puślecki, *Rozważania nad swoistością i prawnym pojęciem wynalazku biotechnologicznego*, „Roczniki Naukowe Stowarzyszenia Ekonomistów Rolnictwa i Agrobiznesu” 2011, vol. XIII, iss.. 1, p.. 311.

the rights are obtained. The subject-matter boundaries of a patent are determined by the claims included in the patent description of the invention. The term of protection is 20 years from the date of filing an application with the patent office.

The Industrial Property Law Act also provides for the possibility of the holder obtaining a supplementary patent. It has to be stressed, however, that the protection by means of an additional patent concerns solutions which constitute a certain improvement of the invention for which the main patent was granted. Supplementary patents may only be granted to the holder of the main patent. It is also possible to obtain a supplementary patent to an already obtained supplementary patent. Thus, in order to obtain an additional patent for an already patented solution, such a solution must be an improvement or supplementation of the invention, meet the features of patentability, i.e. be a new solution of the required inventive step and the solution cannot be used on its own. The national legislator does not impose limits on the number of additional patents. However, not every improvement or addition to an invention will constitute grounds for applying for protection as an additional patent. This right may only be granted to solutions, which cannot be used on their own without the simultaneous use of the invention covered by the main patent. Furthermore, the wording of the patent documentation, and above all the claims, of the supplementary patent refers in the first part to the main patent, indicating in the non-substantive part its technical features and the assigned patent number.

The term "inventor's right" to patent protection is sometimes described in four ways<sup>108</sup>, which are the following ones:

1. a right naturally associated with the mind of human being, because human being is the natural owner of his ideas. In turn, unauthorised appropriation of ideas that are not one's own can be regarded as theft and thus the injured party obtains the right to claim both civil and criminal protection. In addition, national laws regulating industrial property do not differentiate between inventions depending on their field of origin and contain the same principles of criminal liability. Therefore, the protection of biotechnological inventions is identical to the protection of solutions from other fields of science and technology. Material and subjective features of a prohibited act infringing such rights are subject to the same evaluation and interpretation as in the case of all other crimes<sup>109</sup>;
2. the setting up of a market position, since by means of a patent the inventor acquires a monopoly position on the market. Such a position presupposes that, in the name of social justice, everyone should be paid for the services rendered and that this should be proportional to the benefits obtained by society through such a service. An adequate way of social compensation is granting the creator of the solution a temporary monopoly in the form of exclusive rights to the invention<sup>110</sup>.
3. successive pursuit of economic development as a socially desirable phenomenon. Economic progress should be driven by inventions and their industrial applications. For proper development of such a process it is necessary to guarantee tangible benefits, the so-called windfall profits, to both inventors and investors. The most effective way for society to ensure a proper system of economic incentives for both

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<sup>108</sup> See: F. Machlup, *An Economic Review of The Patent System*, United States Government Printing Office, Washington 1958.

<sup>109</sup> M. Pietrzak, A. Wszołek, Szczególny zakres ochrony patentowej wynalazku biotechnologicznego w kontekście strony podmiotowej przestępstwa przywłaszczenia projektu wynalazczego, „Internetowy Przegląd Prawniczy TBSP UJ” 2017, no. 9 (39), p. 213.

<sup>110</sup> A. Karbowski, *Kontrowersje związane z moralnym uzasadnieniem ochrony patentowej w biotechnologii*, „Annales. Etyka w życiu gospodarczym” 2017, vol. 20, no. 1, p. 84 and the publications which are mentioned there.

groups would be to grant them a temporary monopoly in the form of exclusive rights to the invention.

4. It is still necessary to note the approach based on remuneration for the disclosure of secrets. According to this view, a business transaction takes place between the creator of a solution and the public. Within this framework, the creator informs the public about the results of his work and thus obtains temporary protection for their use. On the one hand, by disseminating new technologies, such a transaction supports economic progress. On the other hand, it is supposed to prevent the loss of technological secrets caused, for example, by the death of the inventor. Society should therefore offer the inventor an appropriate price for disclosing his secret. A tangible benefit may be the granting of a patent on the inventor's solution in exchange for making the invention public<sup>111</sup>.

It should be emphasised that one of the basic aims of protecting an invention from the economic point of view is to ensure a monopolistic position on the market. However, this exclusive use of the invention is limited to the sphere of commercial and professional use. Personal use or use of the invention for nonprofessional purposes, not aimed at substantial economic benefits, remains outside its scope. Profitable use means use for economic purposes and does not always mean direct profit. It is important that the use is related to an economic activity, i.e. has an economic value. The actual profit in the process of use is irrelevant. On the other hand, professional activity should be understood as taking up professional activities connected with work, both within the framework of the so-called free professions, with the reservation that such activity should be regarded both as economic activity, i.e. gainful activity, and within the framework of hired work.

Debates related to patentability and the specific nature of solutions in the field of biotechnology are not only conducted at the doctrinal level. They often involve issues which are ultimately resolved by the judiciary. Although it can be marginally added here that for a long time both among practitioners acting in the field of intellectual property, business representatives and partners on the legal side, postulates have been raised concerning the need to adjust Polish courts to the realities of often technically complicated issues concerning protection of such a platform. As it was indicated, many judges who every day deal with more "traditional" forms of business activity did not deal with them as efficiently as the parties to such proceedings would like, which resulted in long-lasting and imprecise court proceedings<sup>112</sup>.

In response to the reported requests, and first of all, due to the complexity and difficulty of the subject matter of the trial, which are the issues concerning the protection of intellectual property, the Polish legislator adopted the Act of 13 February 2020 amending the Act - the Code of Civil Procedure and certain other acts<sup>113</sup>. New provisions regulating a new separate proceeding - proceedings in intellectual property cases. took effect as of 1 July 2020. The appointed judges who adjudicate in such created divisions of the courts designated by the legislator are experts versed in both the legislation and the business specifics of this field of law. Intellectual property cases are heard by the district courts in the first instance and the courts of appeal in the second instance, with cases to be concentrated in five jurisprudence centres.

As an example from the national administrative case law, one can point to the decision of 15 June 2016, in which the Supreme Administrative Court in Warsaw, indicated that , 'making an invention known to a marked (closed) circle of persons, especially those bound

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<sup>111</sup> Ibidem.

<sup>112</sup> <https://www.parp.gov.pl/component/content/article/62535:wyspecjalizowane-sady-do-spraw-wlasnosci-intelektualnej> [access:: 26.04.2021].

<sup>113</sup> Journal of Laws of 2020, item 288, Journal of Laws 875, of 2021, item 187).

by the duty of professional secrecy, is not considered as making the invention available to the public. Also limiting this circle to the employees of a manufacturing company does not meet the prerequisite in question, even taking into account the possibility of communicating the information to other persons. Thus the fact whether the information about the invention was communicated only to individuals or to a narrow circle of persons, with or without an obligation to keep it confidential, does not lead to the invention losing its novelty, if it is not made available to the public within the meaning of Article 25, paragraph 2 of the Act of 30 June 2000. - Industrial Property Law. An invention is disclosed when an indefinite circle of persons could (although not necessarily had to) become acquainted with it<sup>114</sup>.

In contrast, in the ruling of 30 March 2009 The Voivodship Administrative Court in Warsaw stated that "due to the limitation of the general freedom to use a disclosed technical solution, which is the essence of the exclusive subjective right granted by a patent, a patent should be granted only for such a technical solution which represents a qualified inventive step. This does not mean, however, that only epoch-making inventions, revolutionising technology, may be the subject matter of a patent. It is sufficient for an invention to be something more than a mere routine knowledge of a mechanic or engineer"<sup>115</sup>. In turn, in the judgment of 19 February 2009 it was indicated that "a technique is a set of methods and ways of influencing the matter - inanimate and animate - serving to satisfy human needs. A solution is technical in nature, if it determines the way in which a human uses matter (human impact on matter). An invention requires that it can be reproduced in accordance with all its characteristic features, unequivocally determined from a technical point of view"<sup>116</sup>.

In the doctrine, the view has been expressed that the statutory refusal of patent protection to activities generally regarded as morally unacceptable and unethical does not constitute a prohibition to perform them. Thus, conducting research in the field of solutions subject to statutory exclusions should not be perceived as conducting illegal activity or threatened with criminal liability. The purpose of the Act is not to restrict implementations of a biotechnological nature. It is the results of long-term research that have led to the successive introduction of complex biotechnological solutions into the market.

## Conclusions

Innovations in the field of biotechnology are subject to the same requirements with regard to patentability as solutions in other fields of science and technology, so that patents are granted - irrespective of the field of technology - for inventions that are new, have an inventive step and are suitable for industrial application. This study shows that the constant progress of solutions in the field of biotechnology makes the legal issues of their protection and marketing more complex.

The terminology of biotechnology and the specific nature of its subject matter, i.e. living matter undoubtedly generate moral, ethical and social controversies, in addition to legal problems. Thus, the discussion on the patenting of intangible goods in this field remains open. A positive phenomenon is the fact that its boundaries are expanding to include more and more new solutions subject to patent protection. The trend is towards "protecting everything under the sun created by man". Strong economic arguments are no less important. Business trading requires effective means of protecting innovative activities. So far, patent protection, although imperfect, has been the most common way of both determining ownership rights to a solution and bringing it into production exclusively.

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<sup>114</sup> System of Legal Information: Legalis no. 1537336; GSK 2854/14.

<sup>115</sup> System of Legal Information: Legalis no. 237542, IV SA/Wa 1837/08.

<sup>116</sup> System of Legal Information: Legalis no. 177137, IV SA/Wa 2241/08.

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# **PLACE BRANDING AND REPUTATION - A CASE OF THE POLONINY NATIONAL PARK**

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## **Abstract**

At a present, it is also necessary in the tourism market the specialization of the destination and thus distinguish it from other destinations and the products that the destinations offer.

The article deals, within selected destinations, with strategic and conceptual focus primarily on the development of nature tourism, its infrastructure and products that externally operate under single brand. The choice of nature tourism as an integrating element of the brand system also has the advantage that this form is tied to the territory not only in terms of natural, but also social and cultural values, such as are the traditions, customs and values of the local community.

The destination brand system is also a quality system for agricultural products and food products, handicrafts and other consumer products, accommodation, catering and ancillary services and services of other attractions.

The aim of the article is to propose a procedure for building a destination brand to help facilities gradually increase the quality of their services and, in particular, introduce the principles of nature tourism into operational activities, so that providers are ready to participate fully in the quality product of the destination as a whole. Poloniny National Park was chosen as an example of a protected area and the creation of a destination brand.

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## **Key words**

Destination branding, Image, Protected areas, Quality, Agricultural Product

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## **Introduction**

Protected areas with their beauty, richness and diversity represent the core value and one of the most important natural values of every country. Protected areas represent not only important instruments for preserving biodiversity, but they also contain enormous potential for social and economic development. However, these potentials are not yet sufficiently recognized. Nowadays, the key issue in managing protected natural areas is to define and choose the most favorable natural resource management strategy that will at the same time satisfy all development criteria. In that sense, the marketing issue is one of the most crucial ones, having in mind the fact that protected areas represent very specific tourist destinations that have to be adequately preserved, protected, valorized and promoted.

Sustainability is critical as it denotes the environmental, economic, and socio-cultural facets of tourism development, and thus it is vital that a suitable balance must be established among its various dimensions so as to assure its enduring sustainability. This implies that optimum use be made of environmental resources that constitute a significant components in tourism development, and which preserve indispensable ecological processes which support the conservation of natural heritage and wide ranges of biodiversity.

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<sup>1</sup> Domenico Viti is the author of the part „Place marketing, legislation and local legitimacy“

## Material and methods

### National park of Poloniny – a protected area

National Park of Poloniny, it is a unique international biosphere reservation, situated in three states - Ukraine, Poland and Slovakia. It contains original extensive beech and fir-beech forest and the **primeval forests of Stužica, Rožok and Havešová**, which were put on the UNESCO list of world natural heritage in 2007. It was added to the list of National Parks of Slovakia in 1997.

The area of national park is 29 805 ha and acreage of protected area is 10 973 ha. It is situated at the point where **three frontiers meet: Slovak, Polish and Ukrainian**. The Park immediately neighbours with the Polish Bieszczadski Park Narodowy and ukrajinský Užansky národný prírodný park. **In the Slovak part there is nationally varied population as Ruthenians and Slovaks live there.**

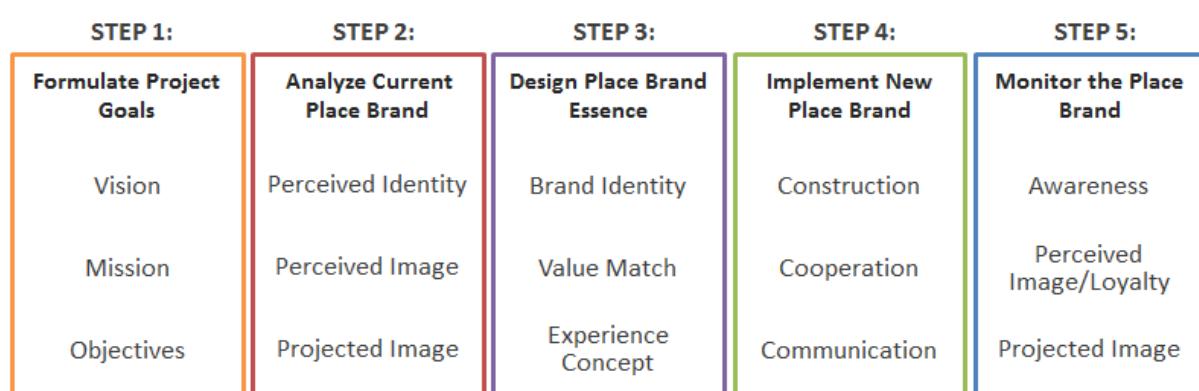
The mountain area where the Park was established is also known under the Slovak name, the **Bukovské vrchy** Mts. The name of the Park derives from the Slovak term for special and unique alpine meadows – **poloniny** - which spread here above the upper timberline.

The **UNESCO** in the framework of the Man and Biosphere Programme defined the territory as the Biosphere Reserve of Východné Karpaty in 1993. The **primeval forests of Stužica, Rožok and Havešová** in the **Bukovské vrchy** Mts. were added to the UNESCO list of world natural heritage in June 2007 together with the Kyjov primeval forest in the **Vihorlatské vrchy** Mts. in CHKO Vihorlat near Poloniny and with the primeval forests in the Ukraine.

Almost 80 % of the forest area consists of rounded ridges and waterlogged valleys. Sharp stones are less frequent. Particularity of the territory is the occurrence of the largest complexes of original, in places virgin, **beech-fir woods** in Europe and the rare concentration of threatened animal and plant species. The land is characterized by the occurrence of **game** - brown bear, wolf, lynx ostrovid, catamount as well as a wisent that only occurs open in NP Poloniny. <https://slovakia.travel/en/national-park-of-poloniny>

### Place branding of a protected areas

Figure 1. Key aspect of the place branding process



Source: Govers & Go (2009)

Five steps according to Govers & Go (2009) who identified key aspects of the place branding process are: formulate goals; analyze the current location; design of the essence of the placemark; applying a placemark; and tracking a placemark (Fig. 1)

Step 1: Branding sites combines vision, mission and goals. Ideally, the placemark aims to build an overall picture and set priorities in the areas of tourism, investment, export and talent acquisition. In reality, however, many cities have different agencies that try to apply their own priorities and goals, while having their own brands. Such a fragmented approach tends to become ineffective in perceiving the external environment. It is for this reason that it is necessary to create a single brand through the organization that will manage the whole process. It is important to act synergistically in every aspect of branding. It is necessary to start creating a common vision, which will then be transformed into a mission and will contain the specific objectives of the project.

Step 2: Analyze the perception of the place. In order to be able to fully decide what the brand of the place will be, it is necessary to find out the current reputation of the place. In order to have a complete picture of a place, you need to analyze three categories: the current way of presenting the place, the perceived picture of the place, and the assumed picture of the place. After thorough analysis, it is necessary to determine the positioning of a consistent placemark.

Step 3: Design a new placemark essence. Creation of a trade name, valuable story, visual identity (if necessary) and communication frameworks. At the end of this step, the essence of the brand is similar to any other brand and covers the services it offers and the economic opportunities associated with it. Often this step is reduced only to the visual level (creation of a logo), but it is necessary to pay particular attention to the emotional side in connection with the experience of the place. It is important to create an essence that represents the match between the value of the identity of the place and the type of audience it is trying to reach and gain.

Step 4: Implementation is based on three activities. The first of them is the concept of adventure attractions that need to be exhibited or modified according to the desired effect. Subsequently, the site must create sufficient infrastructure for the audience it wants to reach. And create supportive policies with symbolic actions. Another part of the triangle is communication, which is key. At the tip of the imaginary triangle, the cooperation of all stakeholders.

Step 5: Brand monitoring is the last step of the whole process. It is important to continuously measure the perception of the brand and its value. A strong brand is also built on brand awareness, location.

## **Results and discussion**

### **Place marketing, legislation and local legitimacy**

Communities in areas of top-down legislation for protected areas often have to comply with rules not related to their tradition. They must adapt anyway to inclusive attitude, respecting both nature and people not belonging to their cultural background. The legal legitimacy, based on a superior power which decide rules and aims of the parks, can create a gap between decisions of the political bodies and the acceptance by the local stakeholders; for instance the limitations to property rights and to farming (related especially to grazing and forestry) must be understood through techniques of cultural consensus seeking.

Therefore place branding, to enhance the reputation of a protected area to promote a sense of communitarian identity, anyway place branding to get high reputation must be integrated with local branding. Local branding means to have the local communities to endorse the aim

of Institutions which are often very far away from the specific places, like it happens for the UNESCO sites. Local people, who seldom know how a Park or UNESCO site work, must be culturally attracted by a project: substantial legitimacy must substitute formal legitimacy. Reputation without social consensus in vast area can bring conflicts between environmentalists & tourists & local rural inhabitants.

Communitarianism, a political and economic theory with a strong presence in the USA Universities is also a tool to understand a free market activity rooted in inside a culture and a historical and even environmental context. That is especially relevant where minorities like Ruthenian people live. Because starting up a Park can become an elitist act, often driven by urban culture and not rural culture, to develop strategies to involve the local people goes together to activate an innovative place branding.

Using collective trademark which belong to the public entity which manages the Park can be combined with direct benefits to local communities, especially the minority ones. Sharing common economic and environmental goals all the values of the Park can have the Ruthenian minority deeply dedicated to the park, to preserve their cultural identity. Place branding and local branding should be strictly linked to create reputation and meantime social involvement of local population.

The question of preserving a territory, in particular a UNESCO site, through the active involvement of local populations, often means recovering the Genius Loci, the spirit of the place; often ancient cultural traditions have been shaped by the morphological and even pedagogical characteristics of the environment. Forest areas have provided local populations for millennia with most of the necessities for living, material culture has often turned into a higher culture, in architecture, in myths and legends, in local poems.

The post-World War II modernization process has, in a few years, created a split between the needs of the populations and the capacity of the territory to support growing needs. In the case of the Poloniny Park area, this identification between culture and nature was strong for centuries, even before the political borders divided a territory that had represented a homogeneous area since the Middle Ages. Since the time of the domination of the Drugeth family, the Poloniny both on the Slovak and Ukrainian sides had had a unified history. The part currently Ukraine continued to belong to the Kingdom of Hungary after the Trianon Treaty, and then became part of the Soviet Union.(Armiero-Barca, 2004)

Therefore, the current political-administrative situation of the area is relatively recent and has contributed to determining a situation of progressive loss of identity culture, especially as regards the Ruthenian populations, who in fact have found in emigration a possibility of escaping from marginalization. and the loss of shared memory. For example, the Poloniny had a unified culture of the use of the forest, in some places almost impenetrable, with customary rules voluntarily accepted by the local population. The incredible botanical and fauna specificity of the area had led to the development of elaborate capacities of community governance of the territory, which was suddenly broken by the modernization processes and by the legal events of the territory. The establishment of the Park is an opportunity to restore the potential of the area to combine ancient ancestral knowledge with the resources of one of the best preserved European areas from an environmental point of view. The integration of innovative forms of nature management and restoration of largely lost traditions can also be the result of a progressive integrated action of place marketing and local marketing.

The term marketing may seem reductive, because it seems too tied to economic typologies; however, marketing involves a multidisciplinary activity in which legal, economic, social, anthropological and social psychology research offer the tools of analysis to reactivate from below the processes of identity harmony that would otherwise remain latent but not expressed. Legal research, for example, could re-appropriate the community logic of enjoyment of common goods, eradicated first by the communist regime and subsequently by

the loss of memory. The legal culture of common goods expressed in the legal and managerial elaboration expressed by the theory of Common Pool Resources. Undoubtedly, the dismemberment of the Poloniny area and the progressive loss of identity has caused problems in the self-government of the territory, also because the customary rules have been lost. Artificially reviving, with an operation carried out by the central power, this self-propelling capacity is neither simple nor taken for granted in the results.

To the study and recovery of ancestral forms voluntarily accepted by local communities for the recovery of a shared culture of the territory. In the case of the Poloniny, the famous concept of the "metabolic rift" theorized by John Bellamy Foster in the reinterpretation of Marxian theories, fortunately did not translate into degradation. Other theories are also to be analyzed. For example, a young and brilliant Italian scholar, who works in Portugal, Stefania Barca, is analyzing the multiple political implications brought about by environmental policies. Environmental policy was essentially understood as an institutional policy; however, in situations where the old rules have now broken down and the new ones tend to be projected from above, tools must be sought to accelerate the positive latencies present in well-preserved but fragile contexts such as Poloniny. (Barca, 2020)

The classical theory of Siegfried von Ciriacy Wantrup it was rightly stated that the real institutional key for environmental policies was to be found at the sub-constitutional level; since the problems arise at the level of actual implementation of rights. In her famous conceptual reply to the problems posed by the tragedy of common goods identified by Garret Hardin, Elinor Ostrom identified in the rules of self-government the possibility of a rational and sustainable use of shared goods. However, in the phases of reconstruction of customary forms of self-government, the function of motivational and pedagogical campaigns becomes an integral part of the reconstruction of the sense of shared rules. (Ostrom, 1992)

### **Poloniny brand system**

The mission of the Poloniny brand system is to contribute to the sustainable development of the region through marketing support the potential of the territory and its product (attractions, services and quality regional products), including the promotion of their sales and interconnection of production systems in the region. The system networks entities in the territory concerned that directly or indirectly contribute to the development of the unique potential of the destination by contributing to the development natural, cultural and rural tourism. The system uses the Poloniny brand as its main tool. This brand presents the destination Poloniny, its values, attractions and products. At the same time it allows to the consumer resp. the visitor to identify regional products and distinguish them from other goods on the market.

The integrating element of the Poloniny brand system is natural tourism, which is connected to other carriers forms of sustainable tourism for which the destination Poloniny has potential.

The general objectives of the system are:

- ✓ protection and preservation of the natural heritage (natural potential) as a major element of development the potential of the territory;
- ✓ protection, preservation and restoration of the cultural values of the area;
- ✓ the social and economic development of the territory through its contribution to the development of sustainable forms tourism, in particular:
  - nature tourism and its products. This form of tourism is given the potential territories identified as a key and very promising activity of the brand system;

- cultural and cognitive tourism connected mainly with cultural-historical attractions, educational activities and events supporting the sale of traditional craft products and culture presentation;
- rural tourism, linked to the provision of rural services and sales regional products;
- ✓ support for the sale of local products and services, support for cooperation between producers and service providers;
- ✓ support for the development of the infrastructure and facilities of the destination for the visitor's stay and the creation of a comprehensive one tourism product (including quality improvement activities).

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## **Use of the brand and entities in the Poloniny brand system**

The subjects in the Poloniny brand system are all users of the brand. The brand is used in marketing tools (including online marketing, printed presentation and information materials that accompany product, service, or attractiveness as well as materials that present the destination itself), on packaging, in offer or marketing of products and products (in accordance with Act no. 506/2009 Coll.)

The main user of the brand is the owner of the brand, who he is also the coordinator of its system. Other users of the brand use the brand only with the consent of and according to the conditions of the brand owner (on the basis of a license or contract).

***The owner of the brand and the coordinator of the brand system*** (which is the Aevis Foundation – described below) uses the brand in connection with all marketing and information activities that it carries out in order to fulfill the mission of the brand. It uses it primarily as a destination sign when placing the destination Poloniny and its product on tourism market (in the presentation of its attractions, regional producers and service providers and their certified products and services).

***Producers and producers*** (agricultural and food producers, producers of traditional handicraft and other consumer products, artists) use the brand only on products or products, for which the trademark owner consents to. At the same time, producers and products must meet the award criteria and use of the Poloniny brand, which determines:

- basic requirements for the producer resp. manufacturer (eligibility for placing products on the market, place implementation of activities);
- criteria of uniqueness - requirements for the product resp. product (origin, method of processing, etc.). Assessment of compliance with the criteria and granting of consent is included in the product quality management processes and products, which is part of the brand system and is provided by the brand coordinator.

***Service providers***(accommodation, catering and ancillary services in tourism) an operators resp. managers of natural and cultural attractions (e.g. cultural institutions - museums, galleries, sacral monuments, cultural and historical objects, events, etc.) which are part of the development potential of the destination Poloniny, contribute to the creation of a product in the development of sustainable tourism and to building awareness of the destination. Equipment resp. objects must meet the award criteria and use of the Poloniny brand, which determines:

- basic requirements for the provider resp. facility operator (eligibility to provide services, place resp. device location resp. object);
- uniqueness criteria - service requirements resp. device or object. Assessment of compliance with the criteria for awarding the label and the conditions for granting consent are

included in the processes quality management system, which is part of the brand system and is provided by the brand coordinator.

**Operators of product points of sale, service providers, resellers combinations** (product + service) that contribute to the promotion of the sale of labeled products and services (e.g. retail outlets, market places, travel agencies, tourist information centers...). Point of sale operators and service providers shall use the mark only in connection with products and services to which the trademark owner has granted rights to use it. Sales operators sites use the mark in such a way that it is in no way associated with such a product or a service for which the rights to use the mark have not been granted to its owner.

**Other entities that contribute to the presentation of the region's traditions and the dissemination of the brand's reputation** - in particular cooperating entities that are not primarily established for the purpose of doing business or carrying out economic activity, do not benefit financially from the use of the brand, are not directly involved in the product tourism destinations Poloniny, but contribute to the presentation of traditions and the region itself. Collaborating entities use the brand only in a way that is not associated with products and services which the brand coordinator has not granted the rights to use the brand or does not present them himself ([https://regionpoloniny.sk/wp-content/uploads/2020/12/koncept\\_a\\_zasady\\_znacky\\_2020\\_v2\\_final.pdf](https://regionpoloniny.sk/wp-content/uploads/2020/12/koncept_a_zasady_znacky_2020_v2_final.pdf))

## **Poloniny destination and quality brand – purpose and graphic designs**

Process management in the Poloniny brand system is provided by the brand coordinator Aevis Foundation. The Aevis Foundation (<https://www.aevis.org>), as a professional guarantor and coordinator in cooperation with partners, brings the Poloniny destination brand within the Snina region. Its mission is to support the sustainable development of the region and the more responsible use of its exceptional potential. The brand is part of a marketing strategy aimed at improving the promotion of the area, its natural and cultural wealth, services offered and regional products. The Poloniny brand presents various specifics that can be seen, experienced or tasted in the north-eastern corner of Slovakia. It supports the preservation and maintenance of the original nature, culture, traditions and crafts. It brings together entities that value and protect the unique heritage of this region and use it responsibly.

The author of the graphic design of the destination brand and at the same time the Poloniny quality brand is the renowned Slovak designer Jozef Dobrík. Its intention was to reach and attract visitors through an attractive brand, for whom the uniqueness of the region should be the main motivation to visit it repeatedly, spend more days in it, try local services and products and thus support local people. <https://regionpoloniny.sk/znacka>

The Poloniny brand is also a quality system that allows visitors to identify quality products and services that are unique, directly from the region, grown or produced by local people with love and respect for nature and traditions. It helps to raise the profile of local producers and service providers. At the same time, it supports their activities and the sale of their products and services, especially in tourism and emerging nature tourism. The quality brand can be obtained for agricultural and food products, traditional handicrafts and other consumer products, accommodation services, catering facilities and experience services. Local producers, producers and service providers may apply for a quality label on the basis of a published call.

**Figure 2. Poloniny – a graphic design with a slogan**



Source: [https://regionpoloniny.sk/wp-content/uploads/2020/12/koncept\\_a\\_zasady\\_znacky\\_2020\\_v2\\_final.pdf](https://regionpoloniny.sk/wp-content/uploads/2020/12/koncept_a_zasady_znacky_2020_v2_final.pdf)  
Translate: Poloniny - incredibly real

## Conclusions

In branding, we are in the business of creating ideas. And intellectual property is what protects these ideas. It is considered a category of property that contains intangible assets / creations of the human intellect. There are many categories of intellectual property, such as copyrights, patents, brands, trademarks and trade secrets. The main purpose intellectual property serves is to encourage inventions of intellectual goods. The law protects these ideas for a period of time, while it offers economic incentive for their creations for it can ultimately become profitable ideas. These economic incentives are expected to stimulate innovation and contribute to the technological progress of countries, which depends on the extent of protection granted to innovators. Balancing rights so that they are strong enough to encourage the creation of intellectual goods but not so strong that they prevent the goods' wide use is the primary focus of modern intellectual property law.

Place branding is not about just a good slogan, logo and nice promotional campaigns. In the experience economy an integrative place branding strategy is needed to capture the hearts and attention of visitors. This means that the place brand should be supported by policies, innovations, events, structures, investments and symbolic actions.

Protected area brands can engage emotions, evoke personal beliefs and prompt the behaviors managers prefer when the brand's core values are appropriately expressed.

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# DIGITAL REGENERATION OF VILLAGES AND URBAN AREAS IN EUROPE: THE ITALIAN PERSPECTIVE

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## Abstract

The issue of regeneration of villages and rural areas became central after the outbreak of the Covid-19 pandemic. The issue had also arisen in previous years, for various reasons, particularly depopulation dynamics. Italy is characterized by about 17% of its population living in rural areas, equal to 10 million people (compared to 51 million Italians living in urban areas). This situation calls for the implementation of specific "digital strategies" to enhance the productive capacity of these areas. One of the main strategies is that linked to brands, both of European origin and of national origin (for example geographical identification marks for products, such as DOC, DOP, "Made in Italy", but also various types of certification such as "Borgo sostenibile", "Borgo Autentico Certificato", etc.), and to international standards (like ISO 9001). They are: i) forms of legal design, because they convey legal contents, and increasingly they assume this function from the point of view of communication with the user/consumer; ii) fundamental elements of the economy of reputation (brand reputation) that characterizes the technological transformation of communities and territories. The main legal profiles connected to this type of tools in the Italian experience will be analyzed, and it will be assessed whether a "brand reputation and legal design strategy" could also be adopted in other territories and regions, with a European coordination of local identities enhancement.

## Keywords

Legal design; Villages; Inner areas; Reputation economy; Digitalization

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## Introduction

The topic of village and rural regeneration has become central since the outbreak of the Covid-19 pandemic, but the issue had arisen in previous years as well. The reasons behind this need are many and an exhaustive treatment would not be possible. Having to choose a particular point of view, highlighted starting from the trends of the last two years, it becomes interesting to talk about the "valorization" of Italian villages and inner areas starting from the digital strategies that are now in front of everyone's eyes to feed, manage or contain the digital transition and the ecological transition of territories and society as a whole.

The interest in villages and inner areas is, indirectly, also a bridge towards the enhancement of the agricultural sector, which is historically connected with the production of food and services related to them in all areas of the country, and the manufacturing sector and micro, small and medium enterprises that constitute, in Italy, the main national production fabric. Also indirectly, but with a very strong connection, it is also one of the vectors of the entire national economy for the increasingly close link with tourism, both for the development of catering services and temporary accommodation based on the enhancement of the "village" and quality agricultural production, and for the enhancement of the international image of Italy in a dynamic of "brand reputation" and, consequently, of "reputation economy".

Among the triggers for the need to adopt strategies to enhance rural areas is their depopulation. The trend is underway throughout Europe and in almost all territories, and will

not be stopped even by the Covid-19 pandemic that has heavily affected some cities. Italy is characterized by about 17% of the population living in rural areas, compared, therefore, with an absolute majority of people living in urban areas. All in all, this is a population of around 10 million people, which as a whole is equivalent to that of a large European metropolis or the population of a small state. The remaining part of the population (around 51 million), lives, therefore, in Italian cities, Rome and Milan above all, including the declared and undeclared suburbs, which at times extend well beyond the already ample boundaries of the respective “metropolitan cities”<sup>1</sup>. With such a marked urbanization, the problem arises of continuing to generate economic and social value in the so-called inland areas, in a specific and broad sense, so that they do not become mere dependencies of the cities and dormitories of the same<sup>2</sup>.

With the Covid-19 pandemic, there has been a certain return to villages and inland areas (for example, for “second homes”, but also as a result of historical internal movements of the population in search of work, from the South to the North, and generalized fears of remaining in the city). Opportunities and offers have been proposed to entice and attract those leaving the urban area in search of alternative solutions, in which they could continue to lead a satisfying lifestyle made up of smart working and interpersonal relationships at a distance mediated by technology. This escape from the cities does not constitute, at the moment, a reversal of trend with respect to the more general trend of urbanization and does not resolve, therefore, the problem of the valorization of villages and internal areas.

For this reason, it becomes necessary, therefore, the implementation of specific “strategies” to maintain an agri-food production, enhance it on the national and international markets, enhance villages and towns in the inland areas not to consign them to abandonment and not to leave large portions of the national territory in situations of neglect and potential danger, including hydrogeological. These strategies, of necessity, must include an important use of digital technology, which cannot remain confined to urban areas, and the issue of intellectual property becomes central. Also starting from the Italian experience, these strategies can become the common framework for the enhancement of human, social and economic capital of all internal, rural and peripheral areas of European territories.

## Material and methods

The great theme of the present, as described by the main social, economic and technological trends we are witnessing, is that of the implementation of an economy of data and platforms that can enrich the European market, without depending on services, software, cloud and other people's numbers (often mendacious) without giving up welfare and services. As for villages and internal areas, not directly touched and involved by digitalization, as well as generally excluded from its benefits, the challenge is particularly challenging and necessary. The call for awareness and media literacy is necessary, but not sufficient to redefine rights in the digital age (such as, for example, the right to “reduce or eliminate the digital divide” and harmonize the concrete reality of the territories with the most recent EU Directives and Regulations).

In the Italian experience, the valorization of the areas that most need strategic intervention in order to be attractive takes place through the fundamental contribution, and support, of ad

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<sup>1</sup> The institution, for major cities, between the local administrative level (the Municipality) and the regional administration (the Region), as a result of Legge 7 aprile 2014, n. 56 (cd. “legge Delrio”).

<sup>2</sup> Commuting, in Italy concerns about 33 million people in 2019, of which 22 million are workers and 11 million are students (Istat data). In areas such as those of the Milanese hinterland, this causes a population of at least twice the size of the resident population to flow into the city. Similar dynamics can be found in many European cities.

hoc brands, quality certifications and recognized international standards. These are elements that, on their own, could be irrelevant in the process of valorizing an area, but which become central when encountering today's world of communication, characterized by its own dynamics that are still, despite not being "new", to be understood.

Together with the digitalization of the Public Administration and a -in evolution-redefinition of the administrative competences, with dynamics both of administrative centralization (union of municipalities, basin authorities, regional and local parks), and of decentralization (greater devolution of subject matter and competence to regions and local authorities), there are in fact, for some years now, more and more relevant:

*i)* Brands. These can be for individual products or groups of products, as well as for quality and geographical identification (among the main ones are brands such as DOC, DOP, "Made in Italy", but also the lesser-known DOT - denomination of territorial origin, DOS - denomination of historical origin);

*ii)* various types of certification, both for products and, increasingly, for "intangible realities" such as villages and beaches (the main ones include certifications such as "Borgo sostenibile", "Borgo Autentico Certificato", "Bandiera blu").

*iii)* international standards, in their various forms and verticality, for the specific sectors to which they refer (among the main ones we find the ISO 9001 certification, a series of regulations and guidelines developed by the International Organization for Standardization (ISO) that define the requirements for the implementation within an organization of a quality management system, in order to conduct business processes, improve the effectiveness and efficiency in the realization of the product and in the delivery of the service, obtain and increase customer satisfaction).

The value of these tools is twofold and, as far as it is relevant here, must be analyzed for the legal scope that is connected. In particular, they can be read as:

*i)* forms of legal design, insofar as content and symbols intended to convey legal content and increasingly take on this function with a view to communication with the user/consumer. Legal design is characterized as a new branch of law aimed at encouraging the design and display of legal content in a form that is as consumer-readable, or client-readable, as possible. Born in the negotiation field, the legal design can be effectively applied also in the phase of ideation of the normative text.

*ii)* fundamental elements of the reputation economy, as a phenomenon that increasingly characterizes the technological transformation of communities and territories. The reputation economy, in principle, is characterized by the presence of trademarks, which are recognized as having a deposit of value, transferred from the product they distinguish. From the brands born to differentiate the owners of certain objects from each other, today we are fully in an economy in which the value of the product is recognized by the reputation of the brand that produces it. This is, of course, a "perception" of value, which must be built up and protected against brand counterfeiting phenomena that are much easier to achieve than the counterfeiting of the product itself. In this economy, users and consumers play a key role, especially through reviews and the use of social media.

As far as villages and territories are concerned, the use of identifying marks began several years ago and this leads to a condition whereby it becomes fundamental to have marks and certifications of quality in order to be able to compete in the global dynamics of both the production of goods and tourism. It could also be considered that in the absence of a brand that indicates an area or a village, one is in the condition of not being able to know and correctly measure its "value", with the risk of not being considered<sup>3</sup> (due to non-presence in guides, reviews and sites such as TripAdvisor and the like). This is marketing, but not only.

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<sup>3</sup> See Z. BAUMAN, D. LYON, *Sesto potere. La sorveglianza nella modernità liquida*, Laterza, 2015.

In the Italian experience, “brand identity” is one of the pillars of communication for the valorization of areas and products, and aims to involve tourists and consumers with an active role thanks to social networks. This is fundamental in order to build a strong “brand identity” that is not just the extension of an idea of a few, or dropped from above, but is the result of the involvement of multiple stakeholders. Similar constructions of identity, even in much more enhanced and effective ways, are present in some particularly worthy European projects, even if they are still little valued. Thanks to the enhancement of the relationship between digital and community, in fact, there are experiences of construction from below and aimed at specific objectives of coexistence and improvement of the quality of life, with the involvement of “pivot groups” and new forms of widespread planning<sup>4</sup>. These projects, and other possible projects still to be invented, will bring people closer to a better interaction, and coexistence, with the digital.

The protection of intellectual property is, therefore, fundamental to cover these brands and certifications, but also the solutions proposed and to be proposed in the coming years. From the outset, several critical issues are noted. On the one hand, if the protection of intellectual property is so important for the protection of villages and inland areas, it should become central at European level, in a coordinated perspective. On the other hand, many of the indications that can be read about certifications concern, today, the product being certified. It should not be forgotten, however, that equally important is the process that culminates in the product, as is evident in some Italian situations through “specifications”. This is a form of protection of intellectual property that does not limit, theoretically, the knowability of the process, but protects in cascade the brands connected to it and protects producers and stakeholders (therefore, also consumers) from falsification and counterfeiting. The certification of processes, however, is still in an initial phase, in some ways embryonic, of its development. If, on the one hand, great prospects are opening up to explore this possibility, it is also necessary to remember that protection of the product alone today constitutes an important risk for companies: the know-how of the producer is today one of the main targets of IT attacks and the pervasiveness of these attacks cannot leave indifferent the producer who relies solely on a formal protection of the name and brand of his product, in which the substantial quality of the product is not taken into consideration and not protected in any way (if not by brand reputation, but this can be very volatile). To overcome this risk, it is certainly appropriate to “certify” the processes followed, in place of product certification. These processes can flow into management policies, both company-wide and extended to all producers who wish to operate under the shelter of a common quality certification.

In the Italian experience, both the legal design, the experiences of building local brand identities, and the implementation of legal design in regulation are underway. Today, these challenges are intertwined with the need to have an increasingly consumer-readable legislation, but without trivializing the legal text and without losing the protections, such as those of consumer law, which are instead essential. In this sense, legal design should not be reduced to the mere inclusion of graphic elements in the text, nor should it be a sort of “QR code” that provides a summary of the legal content, but it should refer to a traditional legal text for detailed regulations. In this capacity, the mark or symbol may even become an element that goes on to create legal liability in the case of those who issue, authorize or manage the mark. The challenge is, instead, to have a more streamlined legal text, able to be generated, understood, used and, potentially, even improved by the experience of dozens and dozens of stakeholders in various capacities and ways involved in the process of regulatory design thinking.

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<sup>4</sup> See one among all, the example of Smart Kalasatama, in Finland, at: <https://fiksukalasatama.fi/en/>.

The challenge mentioned, however, is twofold: alongside a text that must be increasingly consumer-readable, there is also the need for it to be machine-readable, that is, intelligible and interoperable by algorithms for the provision of additional services.

In the Italian experience, legal design is coming into common use thanks to GDPR and the Italian Authority for the Protection of Personal Data, as well as thanks to several other frontier projects<sup>5</sup>. In particular, we can recognize in art. 12, par. 7-8 of the GDPR<sup>6</sup> one of the main “sources”, both direct and indirect, of entry of legal design in the system, where the article provides for the use of “standardized icons” for the display of rights, duties and regulatory provisions regarding the protection of personal data. The Italian Authority has also launched a public competition in recent months to collect proposals<sup>7</sup>, and similar initiatives can certainly be adopted in the future, even in other fields, to bring citizens back to the center of management and government of the territories and their specific areas of activity.

Among the areas of intervention that the Italian authorities are called upon to protect, there is the fight against the so-called “Italian sounding” and the counterfeiting of typical Italian products, the possible counterfeiting of company and non-company brands, the fight against the possible importation of products from outside the EU where the national or intra-EU alternatives are not adequately valued.

On the other hand, certification procedures that formally recognize some products as “national”, or quality, can be critical, where, however, there are flaws and vulnerabilities in the certification procedures themselves. In the experience of recent years, in fact, some certifications have proved substantially inadequate to recognize the reality of the facts, with foreign products certified as domestic and other similar cases. In this case, although these marks have all the formal requirements to be affixed, as well as to be protected, there is a real possibility that the continuation of such situations will generate mistrust in certifications, if the mark or certification is no longer representative of value.

Positive notes seem to come from the most recent allocations of resources. The main “engine” of future economic recovery will be, the Recovery and Resilience Facility (under the Next Generation EU) will make available €672.5 billion in loans and grants to make the economies and societies of European countries more sustainable and prepared for the challenges and opportunities of the green and digital transition. Digital agenda, together with innovation, research and support to small and medium enterprises (SMEs) are precise objectives of the European Regional Development Fund<sup>8</sup>, while the European Social Fund (ESF) has, among its main focuses, the delivery of better services to European citizens and not only from an economic or quantitative point of view (since the reference to efficiency should not be, reductively, linked to mere accounts and data).

## Results and discussion

In the light of the Italian experience, there are certainly reasons to believe that a strategy of “brand reputation and legal design” can also be adopted in other territories and regions of the European Union, with a European coordination that takes care of the valorization of local

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<sup>5</sup> See *ex multis*, the project LeDiBank - Legal Design in Banking Law, by UNISOB Naples with Bank of Italy, available at: [https://www.unisob.na.it/ateneo/c008\\_e5.htm?vr=3&lg=en](https://www.unisob.na.it/ateneo/c008_e5.htm?vr=3&lg=en) (link consulted on April 29, 2021).

<sup>6</sup> See EU Regulation n. 2016/679 (GDPR).

<sup>7</sup> See the ‘legal design’ initiative of the Italian Authority for clear policies, at: <https://www.garanteprivacy.it/temi/informativechiare> (link consulted on April 29, 2021).

<sup>8</sup> See at the link: [https://ec.europa.eu/info/strategy/recovery-plan-europe\\_it#nextgenerationeu](https://ec.europa.eu/info/strategy/recovery-plan-europe_it#nextgenerationeu) (link consulted on April 29, 2021).

identities without dispersing their forces and following isolationist paths that are anachronistic with the reality we find ourselves living.

There are, however, some caveats that must be well considered.

First of all, a real strategy aimed at improving legislation and freeing it from the trappings of technicalities, should seriously confront the meaning that we must attribute to legal design today. As design historians teach, there is no design without utopia. This means that brands, symbols and icons, in addition to being effectively protected from an intellectual property point of view, must also possess and transmit a fundamental vision of the identity and functioning of society. On pain of their ineffectiveness and early obsolescence. Such a vision requires the definition of principles, such as the fundamental principles of our institutions and societies, but also the principles that underlie our relationship with technology and algorithms. These are legal principles, but also ethical<sup>9</sup> and economic principles.

The task of an open and frank dialogue between scholars of all disciplines should be to identify possible mismatches between the world of technology and the world of law. For the purposes of this paper, however, four points can already be highlighted that deserve further investigation in the near future. These are “vulnerabilities” which, as such, are not exclusive to the new technologies or to information technology in particular, but which arise with particular incisiveness in relation to these subjects. It is opportune to analyse them and know how to correct them, before they are used through Taylor-made attacks to cause damage (economic, reputational, etc.) to our society and alter its environment.

These vulnerabilities, to date, are:

*i)* The absence of precise definitions. The absence of precise definitions creates legal grey-zones in which the law cannot move, or moves with difficulty, and where, above all, it loses predictability. A precise definition of “artificial intelligence” is still lacking, i.e. all those methodologies and disciplines that aim at using digital technologies to create systems capable of reproducing in full autonomy the cognitive functions of human beings, including, in particular, data acquisition and a form of understanding and adaptation (problem solving, reasoning and automatic learning). By way of example only, unambiguous definitions, legal frameworks and applicable regulations are still absent for a whole range of new jobs created by the so-called Industry 4.0: data managers, data analysts, data explorers, etc.

*ii)* The problem of balancing with fundamental rights. Recent EU positions on AI and robotics call for principles of participation, responsibility and ownership of production processes so that “the human being is never the executor of the machine”<sup>10</sup>. Additionally, these systems should ensure plurality, non-discrimination and fairness. In light of the recent doctrine regarding the use of algorithms for criminal trials in the US, the world of work also lends itself to an analysis in terms of the impact of algorithms in the immediate future where choices, promotions and decisions could be entrusted to machines. All this is already happening in some cases of application selection, personnel selection, decision of promotions, leaves, dismissals. The effects of artificial intelligence on employment and labor require a surplus of attention at the political level, “as institutions have in particular the task of making processes of economic transformation socially sustainable”<sup>11</sup> and not “explorable” in terms of hybrid threats and unconventional methodologies of conflict. In contrast, one of the EU Guiding Principles for Artificial Intelligence states that “Artificial Intelligence systems should be used to enhance positive social change and improve sustainability and ecological

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<sup>9</sup> See “Algoretic”, in P. BENANTI, *Oracoli. Tra algoretica e algocrazia*, Luca Sossella editore, 2018.

<sup>10</sup> European Commission, “White Paper on Artificial Intelligence - A European approach to excellence and trust”, 2019.

<sup>11</sup> European Economic And Social Committee (EESC), Parere del Comitato economico e sociale europeo su «L’intelligenza artificiale: anticipare i suoi effetti sul lavoro per assicurare una transizione equa», 2018.

responsibility”<sup>12</sup>. A lack of precision in the regulation of AI can easily allow, instead, the exploration of this vulnerability with the aim of damaging the economic and social fabric of European countries; draining technological know-how from Europe to abroad; creating a sense of distrust in institutions.

*iii) AI regulation and robotics in the absence of sufficient data.* Again, according to the EESC<sup>13</sup>, “the EU lacks sufficient data on the digital economy and the resulting social transformation.” For some time now, the EESC has been recommending that statistical tools and research be improved, in particular on AI, the use of industrial and service robots, the Internet of Things and new economic models (the platform economy, new forms of employment and work), as well as calling for the European Commission to promote and support the conduct of studies (at the level of European sectoral social dialogue committees) on the sectoral impacts of artificial intelligence and robotics and, more generally, of the digitization of the economy.

*iv) A multifaceted legislative landscape.* The complexity of the digital society is leading to a world increasingly regulated by soft law and, as seen, guidelines. Even in the oft-cited “principle of algorithm transparency,” reference is made not so much to the disclosure of source codes, but to making transparent, understandable, and clear the principles, parameters, and criteria used to develop the algorithm and guide its future decisions. However, the use of this approach is problematic for continental European law since it is based on regulations that aspire to be precise, mandatory and binding (while it is more natural for common law regimes). The real novelty, however, lies in the fact that Europe must “open up” to emerging norms that originate elsewhere, think of China. These regulations present ethical principles and socio-cultural references that are different, inapplicable or inadmissible in Europe. Particular complexity is brought about by the fact that, alongside documents of public origin, documents, guidelines and private policies are also becoming increasingly relevant.

In light of these problems, the scenario that emerges risks proving destructive.

The legal response seems to rely more and more on the soft law that our institutions can still effectively deploy. The principles referred to are, in the first instance, certainly those expressed in Western Constitutions, but increasingly today also in recitals, guidelines, opinions and working papers - such as the increasingly important ones adopted by the European Commission. Soft law becomes the most widely used tool to regulate technology, since, as illustrated in the previous paragraph, it is becoming (increasingly) difficult to manage to adopt detailed legislation quickly in step with the technological state of the art.

Some of these principles are not newly developed, but they still have to reckon with the digital society and the concrete applicability in it. Sometimes, they are sufficiently “known” to suggest a semblance of precision: interpretations, however, are often a harbinger of differences and localism. It is clear, at this point, that recourse to “principles” and soft law can only be a temporary expedient in view of new and more stable determinations. If this does not happen, we will be faced with a progressive detachment of reality from the “principles” that are called upon to regulate it. The risk is, quite evidently, that of damaging the principles and all that is positive in them.

## Conclusions

In highlighting the key points of this contribution, it is necessary to consider:

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<sup>12</sup> European Commission, “White Paper on Artificial Intelligence - A European approach to excellence and trust”, 2019

<sup>13</sup> European Economic And Social Committee (EESC), Parere del Comitato economico e sociale europeo su «L’intelligenza artificiale: anticipare i suoi effetti sul lavoro per assicurare una transizione equa», 2018.

*i)* that we find ourselves in a technological paradigm, that of the infosphere<sup>14</sup>, in which the dynamics of brand reputation involve all subjects, starting from private individuals up to territories and even institutions. From this point of view, those who do not have these tools run the risk of not being seen and of not obtaining sufficient value, remaining marginal and indeed facing increasingly significant devaluation and depopulation dynamics.

*ii)* in order to respond to the challenges of the digital society today, the role of trademarks and certifications is fundamental, with the attention that must be shifted to the protection of legal property and the independence and efficacy of certifying bodies, on pain of the progressive devaluation of the entire system and distrust in it.

*iii)* Legal design is characterized by being the fundamental opportunity to rethink legislation, to make it both consumer-readable and machine-readable. However, it should not only be an effort to simplify the “visualization” of the legal content, but should become an opportunity to innovate / renew the core values of social cohesion, enhancing the identities of the territories in a common European coordination.

From this point of view, what is a fundamental component of the Italian strategy for the valorization of villages and inland areas can become a model and an example to be applied throughout Europe, since it lends itself well to being a framework that takes into account local specificities and enhances them for their inalienable specificity.

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<sup>14</sup> See L. FLORIDI, Pensare l'infosfera, Raffaello Cortina, 2020.

# **REINFORCEMENT THE POSITION OF AN AGRICULTURAL PRODUCER IN THE FOOD SUPPLY CHAINS ON THE BASIS OF INTELLECTUAL PROPERTY LAW INSTRUMENTS**

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## **Abstract**

The subject of considerations is the issues related to the role played by particular instruments of intellectual property law in relation to food products in the food supply chain. The products in question have particular quality characteristics associated with their area of production, and these consist of designations of origin and geographical indications. Their protection gives these products a special value. In the supply chain, they are more recognizable, have a certain reputation and are authentic. These features, on the one hand, enable agricultural producers to place them on the market using dedicated designations and, on the other hand protect them against product counterfeiting and abuse. The aim of this paper is to answer the question whether legal regulations proposed at the level of the European Union within the framework of the CAP 2021-2027 are conducive to the application of indicated instruments of the intellectual property law and, in this way, protect agricultural producers against placing counterfeited products on the market.

## **Key words**

designation of origin, geographical indication, food supply chain, quality schemes

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## **Introduction**

The subject of the article are the issues related to the possibility of application selected instruments of intellectual property rights by agricultural producers in the process of marketing agri-food products. It relates to such use which will contribute to strengthening their bargaining position in the food supply chain. A special role is played here by the possibility to apply specific ‘indications’ that confirm the fact of possessing specific features by the agri-food products. These characteristics are linked to their area of production, and consist of designations of origin and geographical indications. The right to use of such indications provides the products a reputation and at the same time gives certain protection.

It is worth emphasizing that properly functioning food supply chain is an essential factor of food economy development. It should be treated as a certain system of connections between particular entities (organizations), which are in different ways involved in processes and activities leading to obtaining specific value for the consumer (final customer) in the form of products and services<sup>1</sup>.

The food supply chain is characterized by a large diversity of actors. Its participants include farmers, food processors, traders, wholesalers and retailers, including large and small and medium-sized enterprises. Individual entities may play different roles in relation to each other, e.g. suppliers, buyers, and often their mutual relations consist of rivalry. It can take

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<sup>1</sup> STADTLER H., C. KILGER C. 2008. Supply Chain Management and Advanced Planning, Concepts, Models, Software and Case Studies. Berlin, Heidelberg, p. 11.

different forms, including for example adulteration of products. Competition plays an extremely important role in the market and its essential aim is to obtain benefits from economic activity, in this case, from agricultural activity. In order to strengthen the position of agricultural producers who produce agri-food products of specific quality values, the legislator has adopted distinct normative solutions, including in the field of intellectual property, which are analyzed in this article.

The choice of the discussed topic is justified by many reasons, including cognitive and socio-economic ones. As far as the former is concerned, it should be noted that the issues related to the application of intellectual property instruments dedicated to apply to agri-food products with specific characteristics have been addressed at the EU level for three decades. Nevertheless, they are undergoing a certain evolution all the time, which corresponds both to the adopted directions of successive agricultural reforms and to the possibilities of adaptation and regulation in individual Member States. However, as far as socio-economic considerations are concerned, the application of the discussed instruments is accompanied by specific public support determined by the EU legislator. It plays a very important role in planning agricultural activity and, consequently, in designing a specific income. It should be emphasized that in accordance with the Resolution of the European Parliament of 2009, it is necessary to ensure appropriate remuneration for the producers for their outlays. At the same time, it is argued that consumers should also be protected against counterfeiting or any other form of fraud<sup>2</sup>.

Although the issues raised in the paper are not new, they are still valid. They have already been discussed in connection with various fields, such as economics or management and even sociology. Most often in the literature in this scope, authors analyze some mechanisms of isolation of particular products, issues of their production profitability, marketing or the need to maintain local traditions<sup>3</sup>.

## Material and Methods

Successive stages in the evolution of the Common Agricultural Policy (CAP) have led not only to an extension of its original objectives, but also to its orientation towards sustainability. This has implied an increased emphasis on environmentally sustainable production methods, including agricultural and food product quality issues. It should be noted that such a direction of changes takes into account the expectations of European consumers, who report a demand for high quality products, which undoubtedly include regional and traditional products protected under quality systems in the European Union. The production of such products reflects a unique combination of natural resources specific to the area (e.g. climate, soil, local

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<sup>2</sup> European Parliament resolution of 10 March 2009 on ensuring food quality, including harmonisation or mutual recognition of standards (2008/2220(INI)) (2010/C 87 E/09), P6\_TA(2009)0098, OJ C 87 E/35 z 1.04.2010, p. 35-43. See: CAŁKA A. 2015. Zakres zastosowania przepisów ustawy o zwalczaniu nieuczciwej konkurencji dotyczących ochrony geograficznych oznaczeń pochodzenia. Draft Paper, I Polski Kongres Prawa Konkurencji, p. 5.

<sup>3</sup> See KRAWCZYK W. et al. 2019. The pros and cons of systemic solutions for the production, certification and distribution of PDO, PGI and TSG products in EU countries. Rzeszów; BAER-NAWROCKA A., SUCHÓŃ A. 2014. Ochrona produktów regionalnych i tradycyjnych w Unii Europejskiej. Wybrane zagadnienia ekonomiczne i prawne. Wieś i Rolnictwo. No 4(165), pp. 115–130; BROUDE T. 2005. Taking “Trade and Culture” Seriously: Geographical Indications and Cultural Protection in WTO Law. Journal of International Economic Law. Vol. 26(4), pp. 18–40.; GÓRSKA-WARSEWICZ H., ŚWIĄTKOWSKA M., KRAJEWSKI K. 2013. Marketing żywności. Warszawa; VATS N.K. 2016. Geographical Indication – the Factors of Rural Development and Strengthening Economy. Journal of Intellectual Property Rights. No 21(5–6), pp. 347–354; LIPIŃSKA I. 2010. Oznaczenie geograficzne produktów żywnościowych– wybrane aspekty prawno-ekonomiczne. Roczniki Naukowe Stowarzyszenia Ekonomistów Rolnictwa i Agrobiznesu. Vol. XII, No 1, pp. 104–109.

animal and plant species, traditional tools) and cultural factors (e.g. know-how and skills, traditions, often handed down from generation to generation). Therefore it is very important to provide producers with a certain legal protection of their activity, including agricultural products of particular value.

The aim of this paper is to answer the question whether the legal regulations proposed at the level of the European Union within the framework of the CAP 2021-2027 are conducive to the application of indicated instruments of the intellectual property law and, in this way, protect agricultural producers against placing counterfeited products on the market.

Due to its nature, the paper is based on a dogmatic analysis of normative texts, a historical and a descriptive method. The paper is based on the survey of legislations, legislative documents accompanying their creation, and professional articles and publications of experts focusing on the legal aspects of food quality systems in EU, with particular reference to designations of origin and geographical indications agri-food products.

## **Results and discussion**

### *I. The concept of geographical indication*

Geographical indication, which in common language means a certain image of a given good, based on its connection with a specific place in the world, is a broad concept. It allows for a quick, positive or negative individualization of a product in the minds of consumers. It serves as a carrier of information about the product through the prism of a specific place, region or country in which it was produced. Moreover, it usually determines its quality or taste values.

Geographical indications play an important role in the value creation process differentiating origin-linked products from others of the same category<sup>4</sup>. Yet this reputation can be subject to abuse. For this reason, the application of the geographical indications are the subject to the influence of certain legal norms. They aim to improve coherence between different producers and avoid unfair practices and misleading consumers regarding the use of such indications.

The signs in question are subject to intellectual property and legal protection<sup>5</sup>. They are similar to trademarks, which are distinguished as part of industrial property. However, they differ in that marks distinguish the goods of individual companies, while signs inform about their physical origin. From the point of view of trademarks, the place of physical origin of goods is not important. The goods covered by a trade mark can be produced anywhere in the world. In the case of geographical indications, the origin of goods from a specific geographic location is of primary importance. If the goods are manufactured outside the geographical area indicated by the geographical indication, the use of the indication in relation to such goods is prohibited<sup>6</sup>.

### *II. Historical aspects of geographical indications*

It should be noted that the issues of protection of geographical indications are shaped on several levels. It is affected by international, European Union's, and national regulations.

<sup>4</sup> VANDECANDELAERE, E.; ARFINI, F.; BELLETTI, G.; MARESCOTTI, A. 2009–2010. Linking People, Places and Products. A Guide for Promoting Quality Linked to Geographical Origin and Sustainable Geographical Indications, 2nd ed. FAO: Rome, Italy, p. 29.

<sup>5</sup> SZYMANEK T. 2008. Prawo własności przemysłowej. Podręcznik akademicki. Warszawa: EWSPA, p. 37.

<sup>6</sup> ĆALKA E. 2008. Geograficzne oznaczenia pochodzenia. Studium z prawa wspólnotowego i prawa polskiego. Warszawa: Oficyna, p. 32.

The concept of geographical indications was mentioned for the first time in the Paris Convention of 1883, but without elaborating on its definition<sup>7</sup>. However, Article 10 sets out its scope of protection, according to which it is prohibited to use, directly or indirectly, false indications of geographical origin in the course of trade. Another one was the Madrid Agreement on combating false or fraudulent indications of origin, which was concluded in 1891. Pursuant to Article 1 thereof, it is unlawful to use, directly or indirectly, a false indication of origin designating, as the place of origin of goods, one of the countries signatory to the agreement or a place situated in one of these countries. In 1958, in turn, the Lisbon Agreement on the Protection of Appellations of Origin and their International Registration was signed. The main objective of this agreement was to ensure a higher standard of international protection for geographical indications than that provided for by the Paris Convention and the Madrid Agreement. The scope of the Lisbon Agreement covers only designations of origin, and this agreement introduced, for the first time internationally, a definition of these designations. It is worth mentioning that both agreements were special consents within the meaning of Article 19 of the Paris Convention.

Currently, the most important piece of international law in the field of geographical indications of origin is the TRIPS Agreement ((Agreement on Trade Related Aspects of Intellectual Property Rights), which is an annex to the WTO Agreement<sup>8</sup>. This instrument introduced the concept of ‘geographical indications’ into international law for the first time<sup>9</sup>. Under Article 22(2) of TRIPS, with respect to geographical indications, signatory countries shall provide interested parties with the legal means to prevent the use of any means for the designation or representation of a good which, in such a manner as to mislead the public as to the geographical origin of that good, indicates or implies that the good originates from a geographical area other than the actual place of origin, or to prevent any use which is an act of unfair competition within the meaning of Article 10bis of the Paris Convention.

As far as EU legislation is concerned, it should be noted that the official definition of a geographical indication was not adopted until the early 1990s<sup>10</sup>. The need to specify its scope resulted, as indicated in the preamble to Council Regulation No. 2082/1992, from the fact that: ‘consumers favour quality over quantity, and this interest in products with specific characteristics is expressed in particular in the increasing demand for agricultural products or foodstuffs with an identifiable geographical origin’.

Regulation 2081/92 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs introduced a specific system of protection for geographical indications in the European Union<sup>11</sup>. This regulation was adopted in the framework of the Common Agricultural Policy. However, due to the fact that in the WTO forum the provisions of this regulation were found to be incompatible with international law, the European Community undertook to make appropriate legal amendments. These changes were introduced by adoption of a new regulation 510/2006 on protection of geographical indications and designations of origin for agricultural products and foodstuffs<sup>12</sup>. In 2012, Regulation 510/2006 was replaced by Regulation 1151/2012 on quality schemes for

<sup>7</sup> LEPUTA D., WRÓBEL W., ZELEK M. 2010. Rys historyczny i źródła prawa własności intelektualnej (in:) Prawo własności intelektualnej. Repetytorium. ZAŁUCKI M. (eds.). Warszawa: Difin, p. 33.

<sup>8</sup> Polish Journal of Law. 1996. No 32, item 143.

<sup>9</sup> CAŁKA E., NOWIŃSKA E., SKUBISZ R.. 2017. Prawo własności przemysłowej. System Prawa Prywatnego. Vol. 14 C. Warszawa: C.H. Beck, p. 14.

<sup>10</sup> LIPIŃSKA I. 2008. The system of the protection of geographical indications and designations of origin for agricultural products. Journal of Agribusiness and Rural Development. Vol. 4(10), pp. 37-46.

<sup>11</sup> Council Regulation (EEC) No 2081/92 of 14 July 1992 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs, OJ L 208, 24.7.1992, p. 1-8.

<sup>12</sup> Council Regulation (EC) No 510/2006 of 20 March 2006 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs, OJ L 93, 31.3.2006, p. 12-25.

agricultural products and foodstuffs. Currently, this regulation is the basic act of EU law on the protection of geographical indications<sup>13</sup>. It applies only to agricultural products and foodstuffs<sup>14</sup>.

In Poland, geographical indications have long been protected under the Act of 2 August 1926 on Combating Unfair Competition<sup>15</sup>. The protection, linked to their registration, was introduced only in 2000 by the Act of 30 June 2000 on Industrial Property Law<sup>16</sup>. This act, still in the pre-accession period, initially reflected certain solutions adopted in the EU acts, including the basic Regulation 2081/92.

It should be emphasized that among the designations one may distinguish those referring to designations of industrial products and those referring to agricultural products and foodstuffs. The latter were excluded from the jurisdiction of the above-mentioned IPL act and replaced with the Act of 17 December 2004 on registration and protection of names and designations of agricultural products and foodstuffs, as well as traditional products<sup>17</sup>.

The scope of this national legal act includes:

- Tasks and competence of authorities within the scope of evaluation of applications for registration of designations of origin, geographical indications and names of specific character of agricultural products or foodstuffs,
- Terms of temporary protection of designations of origin and geographical indications of agricultural products and foodstuffs in the territory of the Republic of Poland,
- Tasks and competence of authorities and organizational units within the scope of control and certification of agricultural products and foodstuffs bearing the protected designation of origin, protected geographical indication or certificate of specific character,
- Principles and procedures of control of agricultural products and foodstuffs with protected designation of origin, protected geographical indication or certificate of specific character,
- The conditions for maintaining the list of traditional products.

The act was passed in order to implement the objectives of the EU legislator, including in particular the creation of national procedures enabling the registration of Polish geographical indications by the Commission.

### *III. Geographical indications in the EU law*

Currently, the basic legal act shaping the issues of geographical indications is Regulation 1151/2012 of the European Parliament and of the Council of 21 November 2012 on quality schemes for agricultural products and foodstuffs<sup>18</sup>. It aims at ensuring protection of the names as an intellectual property right and at providing clear information on the product to consumers. The legal solutions adopted in it are to help producers of agricultural products and foodstuffs to communicate the product characteristics and farming attributes of those products and foodstuffs to buyers and consumers.

The solutions adopted in the regulation are intended to contribute to several specific objectives, such as ensuring fair competition for farmers and producers of agricultural products and foodstuffs having value-adding characteristics, the availability to consumers of reliable information pertaining to such products, respect for intellectual property rights, and the integrity of the internal market (Article 1). The regulation applies to agricultural products

<sup>13</sup> Regulation (EU) No 1151/2012 of the European Parliament and of the Council of 21 November 2012 on quality schemes for agricultural products and foodstuffs, OJ L 343, 14.12.2012, p. 1-29.

<sup>14</sup> CAŁKA E., NOWINSKA E., SKUBISZ R. 2017. Prawo własności..., op. cit., p. 5.

<sup>15</sup> Polish Journal of Law. 1926. No 96, item 559.

<sup>16</sup> Polish Journal of Law. 2000. No 49, item 508.

<sup>17</sup> Polish Journal of Law. 2021. Item. 224.

<sup>18</sup> OJ L 343, 14.12.2012, p. 1-29.

intended for human consumption that are listed in Annex I to the TFEU and others indicated in Annex I to this act.

It is worth noting that in Article 3(1) the legislator indicates the so-called quality schemes for agricultural and food products of high quality and specific value, for which it distinguishes separate legal categories of products<sup>19</sup>. From the point of view of producers, their launch is supposed to constitute a certain remuneration for the work put into their production. The term 'quality scheme' itself is not new and has already appeared, *inter alia*, in the European Commission's Green Paper of 15 October 2008, which referred to 'specific schemes to ensure the quality of agricultural products', in particular products with geographical indications and traditional specialities guaranteed and products from the European Union's outermost regions<sup>20</sup>.

Accordingly, the legislator distinguishes the system of geographical indications, in addition to the system of traditional specialities guaranteed, for which it has set some common objectives. Under the former, it lists protected designations of origin and protected geographical indications. According to Article 5(1) of Regulation 1151/2012, a 'designation of origin' is 'a name designating a product: originating in a specific place, region or, in exceptional cases, country, whose quality or characteristics are essentially or exclusively due to a particular geographical environment with its inherent natural and human factors and of which all stages of production take place in the defined geographical area'. On the other hand, according to Article 5(2), a 'geographical indication' is 'a name that identifies a product: originating from a specific place, region or, in exceptional cases, country, whose specific quality, reputation or other characteristic is essentially due to that geographical origin; and of which at least one stage of production takes place in that defined geographical area'.

#### *IV. Protection of geographical indications*

As noted above, Regulation 1151/2012 specifies that the object of the regulation is the legal protection of the indications and symbols inherent in the various quality schemes.

The system of protected designations of origin and protected geographical indications aims to help producers of products related to a given geographical area by: ensuring fair remuneration for the qualities of their products, ensuring uniform protection of the names as an intellectual property right within the territory of the European Union, and providing consumers with clear information on the value-adding characteristics of the product (Article 4).

Protected designations of origin and protected geographical indications primarily emphasize a product's link to a given geographical area. Traditional specialities guaranteed, on the other hand, indicate the traditional character of the composition or production process of a given agricultural product<sup>21</sup>. The latter refer to agricultural products or foodstuffs having a specific name or character. The name should indicate its specific character resulting from traditional production or processing methods or traditional composition<sup>22</sup>.

The designations of origin and geographical indications to be protected in the territories of Member States are registered at EU level.

An essential role in the application process for their registration, as well as in the amendment of specifications and cancellation requests play producers' groups. It shall mean

<sup>19</sup> Zob. LEŚKIEWICZ K. 2013. Systemy jakości produktów rolnych i środków spożywczych w świetle nowej regulacji prawnej. *Przegląd Prawa Rolnego*. No 1(12), p. 120.

<sup>20</sup> Green Paper on agricultural product quality: product standards, farming requirements and quality schemes, Brussels, 15.10.2008, COM(2008) 641 final.

<sup>21</sup> DOBIEŻYŃSKI K. Ewolucja podejścia..., op. cit., p. 71.

<sup>22</sup> GRĘBOWIEC M. 2010. Rola produktów tradycyjnych i regionalnych w podejmowaniu decyzji nabywczych przez konsumentów na rynku dóbr żywnościowych w Polsce. *Zeszyty Naukowe Szkoły Głównej Gospodarstwa Wiejskiego w Warszawie Problemy Rolnictwa Światowego*. Vol. 10(XXV), pp. 22-31.

any association, irrespective of its legal form, mainly composed of producers or processors working with the same product (Article 3(2)). Only a "group", i.e. an organization of producers or processors of the same agricultural product or foodstuff is entitled to submit an application for registration. Individual natural or legal persons may submit an application exceptionally, provided that they are the only producers or processors in a given area.

The group can develop activities related to the surveillance of the enforcement of the protection of the registered names, the compliance of the production with the product specification, the information and promotion of the registered name as well as, in general, any activity aimed at improving the value of the registered names and effectiveness of the quality schemes.

As far as protection is concerned, registered names are protected against: a) any direct or indirect commercial use of a registered name in respect of products not covered by the registration where those products are comparable to the products registered under that name or where using the name exploits the reputation of the protected name, including when those products are used as an ingredient; b) any misuse, imitation or evocation, even if the true origin of the products or services is indicated or if the protected name is translated or accompanied by an expression such as 'style', 'type', 'method', 'as produced in', 'imitation' or similar, including when those products are used as an ingredient; c) any other false or misleading indication as to the provenance, origin, nature or essential qualities of the product that is used on the inner or outer packaging, advertising material or documents relating to the product concerned, and the packing of the product in a container liable to convey a false impression as to its origin; (d) any other practice liable to mislead the consumer as to the true origin of the product (Article 13).

The appropriate administrative and judicial steps to prevent or stop the unlawful use of protected designations of origin and protected geographical indications, have to be taken by Member States. They have to designate the authorities that are responsible for taking these steps in accordance with procedures determined by them.

Within the framework of the imposed obligation to indicate appropriate sanctions, the Polish legislator specified them in the previously mentioned Act of 17 December 2004 on registration and protection of names and designations of agricultural products and foodstuffs, as well as traditional products<sup>23</sup>. Duly, in the event of a breach of a registered right of PDO or PGI Polish law provides for fines. They vary depending on the offence and may be, for example, up to ten times the average salary (Article 58b). The legislator specifies 5 types of offences concerning the wrongful use of the registered name, violating the scope of protection as defined in Articles 13(1), 24(1), 44 (1), 12(3) or 23(3) of Regulation No 1151/2012.

As noted by E. Całka, the protection of geographical indications is exhaustive. It means that designations covered by the provisions of this regulation ('protected designations of origin' and 'protected geographical indications') enjoy only the EU protection provided for in the regulation and are not subject to protection under any provisions of national law of the EU Member States (with the exception of temporary national protection)<sup>24</sup>.

## V. Protection of geographical indications in the light of the CAP reform 2021-2027

In 2018, the assumptions of the new CAP were presented<sup>25</sup>. Regarding the solutions for geographical indications, the legislator referred to the 2017 Communication The Future of Food and Farming<sup>26</sup>.

<sup>23</sup> Polish Journal of Law. 2021. Item. 224.

<sup>24</sup> CAŁKA E. 2015. Zakres zastosowania..., op. cit., p. 3.

<sup>25</sup> See Proposal for a Regulation of the European Parliament and of the Council amending Regulations (EU) No 1308/2013 establishing a common organisation of the markets in agricultural products, (EU) No 1151/2012 on quality schemes for agricultural products and foodstuffs, (EU) No 251/2014 on the definition, description,

In the text, the Commission recognised the need to make geographical indications more attractive to buyers, who are increasingly interested in them. In order to meet their needs, it is necessary to strengthen the position of farmers producing products with specific characteristics. This is about extending special protection to them as well as improving the management of such products. In addition, the Commission saw a need for some modernisation of the approach to products with these designations. As a result, the CAP reform proposes to simplify the geographical indications system by shortening the registration process and making it more efficient to approve changes to the product specification. Consumers are to a large extent the indirect recipients of these changes. The new protection system is to be more comprehensible to consumers, and at the same time easier for farmers to promote their products. Its simplification will contribute to streamlining its operation while reducing the administrative costs of managing it.

While performing a certain review of the proposed legal solutions, it should be noticed that the above mentioned postulates were taken into account. Among other things, the draft provides for certain unification of regulations for quality systems, including in one act legal solutions concerning both food products and wines. At the same time, it allows faster and more efficient registration of geographical indications by separating the assessment of compliance with regulations concerning intellectual property rights from the assessment of compliance of product specifications with requirements specified in commercial standards and regulations concerning labelling<sup>27</sup>. Also, it is envisaged to simplify certain procedures, such as the objection procedure, which is expected to make their approval process more efficient.

## *VI. Supporting the functioning of food systems*

In order to further improve the efficiency of the CAP and the sustainability of agriculture, food and rural areas, appropriate support is still necessary. Its assumptions were proposed in the document ‘Proposal for a Regulation of the European Parliament and of the Council establishing rules on support for strategic plans to be drawn up by Member States under the Common agricultural policy (CAP Strategic Plans) and financed by the European Agricultural Guarantee Fund (EAGF) and by the European Agricultural Fund for Rural Development (EAFRD) and repealing Regulation 1305/2013 of the European Parliament and of the Council and Regulation 1307/2013 of the European Parliament and of the Council’<sup>28</sup>.

Under Article 5 of the draft, the legislator formulated, *inter alia*, the need to promote a smart, resilient and diversified sector while ensuring food security, which undoubtedly includes the issue of the use of geographical indications within food systems. In order to meet the adopted assumptions, nine specific objectives have been formulated, including the improvement of the position of farmers in the value chain (Article 6(c)).

They are to be implemented on the basis of strategic plans to be drawn up by Member States and approved by the Commission. The CAP strategy plans will cover most of the support instruments financed by the EAGF (including sectoral programmes, which have so far been established under the CMO Regulation) and the EAFRD.

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<sup>26</sup> presentation, labelling and the protection of geographical indications of aromatised wine products, (EU) No 228/2013 laying down specific measures for agriculture in the outermost regions of the Union and (EU) No 229/2013 laying down specific measures for agriculture in favour of the smaller Aegean islands, COM/2018/394 final/2.

<sup>27</sup> Communication from the Commission to the European Parliament, the Council, the European Economic And Social Committee and the Committee of the Regions: The Future of Food and Farming. Brussels. COM/2017/0713 final.

<sup>28</sup> See Plot No 14 of the draft.

<sup>28</sup> COM/2018/392 final - 2018/0216 (COD).

Accordingly, Member States shall choose in their CAP Strategic Plans one or more types of intervention among them is boosting products' commercial value and quality, including improving product quality and developing products with a protected designation of origin, with a protected geographical indication or covered by a national quality schemes; those objectives relate to the specific objective set out in point (b) of Article 6 (1) (Art. 59 f).

It is worth noting that in Poland there are currently 44 products registered under food systems (PGI 25, PDO 9, TSG 10). And in the years of implementation of the previous CAP, i.e. 2014-2020, support was provided for producers of such products, as submeasure 'Support for accession to quality schemes'. Its specific objective was to improve the competitiveness of agricultural producers by better integrating them into the agri-food chain through quality systems, adding value to agricultural products, promotion on local markets and short supply cycles, producer groups and organizations and inter-branch organizations. The aid took the form of reimbursement of part of the eligible costs of the project (e.g. costs of certification, membership of a producer group, cost of specialised controls), whereas the total aid could not exceed the equivalent of 2 000 euro per holding per year<sup>29</sup>. By the end of 2018, 2,679 operations were completed under the support discussed, under which the total aid of PLN 2 805 307.85 was received by 1 648 unique beneficiaries. Definitely, the participation in national rather than EU food schemes was more frequent (2 375 vs. 305 participations). Taking into account the structure of agricultural production according to quality systems, the EU systems were dominated by Protected Geographical Indications (82.6%). Apart from them, under the discussed EU and national schemes, aid was also dedicated to Protected Designation of Origin (PDO), Traditional Specialities Guaranteed (TSG), Organic Farming, System for the Protection of Appellations of Origin and Geographical Indications of Wine Products<sup>30</sup>.

## Conclusions

Official EU documents and the proposed CAP regulation express the will of the EU legislator to strengthen the bargaining power of farmers through their participation in food quality schemes. Undoubtedly, the competition for both agricultural commodities and value-added food products is increasing all the time. So the quality of these particular protected products is very important.

Decision makers believe that special attention should be paid to improve the functioning of the food chain by encouraging producer cooperation, which should be constantly complemented by financial support for the creation of producer groups. Thus, the legislator only provides for the participation of groups in food quality schemes.

It is also worth emphasizing that geographical indications, considered as intellectual property, play an increasingly important role in trade negotiations between the EU and other countries<sup>31</sup>.

Within the framework of the reformed CAP, it is proposed to simplify and accelerate the registration of geographical indications by separating the assessment of compliance with intellectual property law, which should be assessed positively.

<sup>29</sup> Rozporządzenie Ministra Rolnictwa i Rozwoju Wsi z 6 sierpnia 2015 r. w sprawie szczególnych warunków i trybu przyznawania, wypłaty oraz zwrotu pomocy finansowej w ramach poddziałania "Wsparcie na przystępowanie do systemów jakości" objętego Programem Rozwoju Obszarów Wiejskich na lata 2014-2020. Polish Journak of Law. 2019. Item 449.

<sup>30</sup> DZIELNICKA E. et al. 2019, Ocena rezultatów wdrażania i oddziaływanie Programu Rozwoju Obszarów Wiejskich na lata 2014-2020 w latach 2014-2018: Konkurencyjność, innowacja, transfer wiedzy Raport końcowy. Ministerstwo Rolnictwa i Rozwoju Wsi. Warszawa: Ecorys, p. 79-76.

<sup>31</sup> See: Agreement between the European Union and the Government of the People's Republic of China on cooperation on, and protection of, geographical indications, Brussels, 9 July 2020, 2020/0088 (NLE).

The proposed legislative solutions, on the one hand, allow for durability of protection, and on the other hand, it seems that they should encourage new agricultural producers to participate in quality systems.

However, how this participation will develop depends largely on the forms of support dedicated at the national level, which have not yet been specified.

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# LICENSE AGREEMENTS

## LICENČNÍ SMLOUVY

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### Abstract

It is possible to conclude so-called unnamed contracts, company contracts and licence agreements, or contracts for the transfer of rights. The author analyzes agreements in connection with the transfer of the results of research and development. At the same time, author analyzes the regulation of the licence agreement according to the new civil law regulation with comparison with the commercial law regulation.

### Keywords

Commercial law, civil law, agreement, license, license agreement, company agreement, unnamed agreement, provider, acquirer

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## Úvod

Univerzitní výzkum je za časté financován subjekty z podnikatelské sféry. V našem níže uvedeném přehledu smluvních alternativ vědomě užíváme obecný, vědeckovýzkumnou komunitou zaužívaný pojem smlouvy o spolupráci, nicméně uvádíme, že povahu smlouvy bude vždy nutné hodnotit podle jejího skutečného obsahu.

Analogická situace jako České republice je i ve Slovenské republice, a to i ve smluvním řešení, zejména při uzavírání licenčních smluv a tzv. nepojmenovaných smluv. V České republice se soukromoprávní úprava řídí zákoníkem občanským. Ve Slovenské republice se podle povahy vztahu řídí buď občanským, nebo obchodním zákoníkem.

## Výsledky

### 1 Smlouva o spolupráci při výzkumu, ve které univerzita vlastní práva duševního vlastnictví a poskytuje následně podnikateli „nevýhradní licenci - oprávnění k užití“ výsledků v uvedeném oboru

Jako u všech pojednaných smluv, i zde jsou kladený vysoké nároky na kontrahenty, neboť na nich bude v první řadě záviset správné nastavení smlouvy buď jako smlouvy licenční nebo jako smlouvy o společnosti, na jejichž výsledcích se podílí podnikatel formou určitého oprávnění k užití, zatímco vlastnictví si ponechá univerzita. Druhý uvedený případ se však týká pouze situací, kdy se podnikatel přímo podílí i na vývoji.

V úvodních partiích je též vhodné **definovat i pojmy**, které smlouva dále používá a uvést i výchozí údaje.

Jedná se zejména o uvedení (definici) těchto pojmu: akademická publikace (tj. publikace nikoli ke komerčnímu, ale k akademickému účelu), smlouva (vč. uvedení konkrétních příloh, které jsou součástí smlouvy), výchozí podklady, externí finanční zdroje (různé podpory, kterých bude využito), finanční příspěvek (poskytnutý sponzorem a specifikovaný v příloze smlouvy, tj. vlastně licenční odměna), zásady získávání a využití dat (specifikované v příloze smlouvy), tzv. přidružené společnosti (mateřské i dceřiné společnosti sponzora nebo společnosti v jeho podnikatelském seskupení), duševní vlastnictví (práva chráněná patenty a

vynálezy, užitné vzory, průmyslové vzory, ochranné známky, topografie polovodičových prvků, nové odrůdy rostlin a plemena zvířat, autorská práv a práva k databázím, důvěrné informace a aplikace uvedených práv, obdobná práva, vč. práv provádět úkony a jednání v případě porušení uvedených práv).

Dále zde budou uvedeni klíčoví zaměstnanci, tj. hlavní řešitel a další klíčové osoby uvedené se svými charakteristikami v příslušné příloze smlouvy. Bude zde rovněž definováno know-how, tj. zejména nepatentované technické informace vč. informací vztahujících se ke konceptům, metodám, modelům, testovacím procesům, výsledkům experimentů, zkouškám, výrobním procesům, specifikacím, výsledkům kontrol kvality, analýzám, zprávám apod. Bude definováno místo (místa), ve kterých bude projekt probíhat podle podrobnějšího členění v příloze smlouvy.

Bude definován i projekt, program a doba trvání a způsob provádění upřesnění se specifikací v odpovídající příloze.

Charakterizovány budou rovněž předpokládané výsledky, výsledné informace, know-how, vynálezy, software a další identifikované duševní vlastnictví nebo taková vlastnictví, která jsou poprvé uváděná do praxe nebo písemně zaznamenaná v průběhu projektu.

Vymezeno musí být i území, na kterém půjde o vztah k výsledkům duševního vlastnictví i jiným výsledkům.

Budou uvedeny i osoby, které jednají za účastníky smlouvy a osoby „dozorující“ probíhající projekt.

Další údaje smlouvy se vztahují k dalšímu **vymezení projektu**. Je třeba vymezit poskytnutí lidských zdrojů a materiální vybavení i podrobné otázky placení.

Sjednáno bude též zajištění mlčenlivosti všech zaměstnanců zúčastněných osob.

Ujednání bude též o postupném předávání výsledků a zpráv o průběhu.

Část smlouvy bude věnována **finančním příspěvkům a externím finančním zdrojům**.

Finanční příspěvky poskytne sponzor. Další externí finanční zdroje budou podléhat podmínkám sjednaným s osobami, které je poskytnou.

Strany sjednají, že každá z nich poskytne druhé straně oprávnění ujednaná v části nazvané **Používání a využívání duševního vlastnictví**.

Strany si navzájem udílí nevýhradní oprávnění využívat její podklady pro účely realizace projektu, nikoli však pro jiné účely. Žádná ze stran nesmí toto oprávnění poskytovat dalším stranám. Výjimku tvoří oprávnění sponzora využít toto pro svoje přidružené osoby, avšak jen pro účely realizace projektu.

Vlastníkem všech práv duševního vlastnictví se stává univerzita.

Univerzita pak udílí sponzorovi nevýhradní licenci s právem využití pro přidruženou společnost.

Další části smlouvy se zaměřují na podrobné otázky **akademických publikací, důvěrnosti informací, limitace odpovědnosti** v rámci příslušného režimu daného právního řádu a **ukončení smluvního vztahu**.

Smlouvou uzavírají **závěrečná ustanovení** věnovaná otázkám doručování, výkladu textu smlouvy a **sjednávání dodatků smlouvy**. Je zde též dohodnuto **rozhodné právo** (pokud by smlouva byla uzavřena jako mezinárodní a jinak než podle dohodnutého národního práva) a způsob **řešení případných sporů**, např. před rozhodčím soudem.<sup>1</sup>

Ke smlouvě jsou připojeny přílohy, které jsou součástí smlouvy.

## 2 Smlouva o spolupráci při výzkumu, ve které univerzita vlastní práva duševního vlastnictví a poskytuje podnikateli „nevýhradní licenci - oprávnění k užití“ výsledků v uvedeném oboru. Podnikatel je dále oprávněn případně sjednat si licenci výhradní

<sup>1</sup> Kubíček, P.; Marek, K.: Teschechische a Slowakische Republik: Schiedsgesetze, WiRO, 3-5/ 2020

Dané smluvní řešení v zásadě obsahově řešení prezentovanému ve smlouvě uvedené ad 1). Obsahuje však příslušná ujednání o případné výhradní licenci (tzv. opcí).

Pokud sponzor provede univerzitě notifikaci, a to kdykoli během trvání projektu a v další dohodnuté době, sjednají univerzita a sponzor výhradní licenci k využívání výsledků výzkumu vč. příp. oprávnění k poskytování licence dalším osobám.

Během této doby nesmí univerzita jednat s jakoukoli jinou osobou za účelem udělení licence nebo postoupení práv duševního vlastnictví.

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I u této smlouvy je obsah smlouvy uvedené ad 1). Od předcházejících smluv se liší opcí o postoupení práv.

Pokud sponzor univerzitě provede oznámení v průběhu řešení projektu nebo v další ve smlouvě dohodnuté době, bude univerzita a sponzor sjednávat postoupení, tedy translativním převodu, práv duševního vlastnictví k výsledkům výzkumu, event. jen některých z nich.

I zde platí, že během této doby nesmí univerzita jednat s jakoukoli jinou osobou za účelem udělení licence nebo postoupení práv duševního vlastnictví.

U smlouvy uvedené ad 2) i u této smlouvy má univerzita, každý její zaměstnanec a student ujednané bezplatné právo využívat výsledky pro účely výuky a výzkumu (případně u lékařských a zdravotních oborů klinické péče o pacienty).

**4 Smlouva o spolupráci při výzkumu, podle které podnikatel vlastní práva k duševnímu vlastnictví k získaným výsledkům a univerzita má právo výsledky užívat pro účely univerzitní výuky a výzkumu**

Kromě obsahově obdobných ujednání, jaká jsou u dříve pojednaných smluv, je u této smlouvy speciální úprava týkající se používání a využívání práv duševního vlastnictví. Svou podstatou se jedná o ujednání o translativním převodu se zpětnou licencí.

Každá strana udílí též druhé smluvní straně nevýhradní oprávnění využívat její podklady pro účely realizace projektu. Žádná ze stran nesmí oprávnění k využití podkladů druhé smluvní strany poskytnout dalším osobám s výjimkou přidružených osob sponzora a příp. dodavatelů sponzora.

Sponzor je zde vlastníkem práv duševního vlastnictví k výsledkům. Univerzita zajistí, aby její zaměstnanci, kteří se podílí na vytváření výsledků, poskytli sponzorovi veškerou součinnost.

Pokud jsou jakákoli práva k výsledkům způsobilá k postoupení, postoupí univerzita tato práva duševního vlastnictví sponzorovi.

Pokud by sponzor výsledky neužíval, poskytl by sponzor výsledky zpět univerzitě.

Univerzita neprodleně oznámí sponzorovi dosažení jakéhokoli výsledku, o kterém se domnívá, že může být patentován či jinak chráněn.

Sponzor bez poplatků udělí univerzitě nevýhradní licenci opravňující k využívání výsledků, avšak jen pro účely projektu. Univerzita a každý její zaměstnanec a student má právo výsledky využívat pro výuku a výzkum.

**5 Smlouva o spolupráci při výzkumu, podle které podnikatel vlastní práva duševního vlastnictví k výsledkům a univerzita nemá žádná práva využívat výsledky pro akademické účely**

V tomto případě se jedná o obdobu předchozí smlouvy převodu práv, ovšem bez zpětné licence univerzitě.

Smlouva obsahuje mj. toto následující ujednání: Sponzor bude vlastníkem práv duševního vlastnictví k výsledům a může na základě svého uvážení uplatňovat patentovou a jinou ochranu ve vztahu k výsledkům. Zaměstnanci a studenti poskytnou sponzorovi plnou součinnost.

I u tohoto smluvního řešení univerzita neprodleně oznámí sponzorovi dosažení jakéhokoli výsledku, o kterém se domnívá, že může být patentován či jinak chráněn.

## **6 Další smlouvy (dohody) uzavírané k výsledům duševního vlastnictví**

Lze však uzavírat i další smlouvy, které níže uvádíme. Nejsou však pochopitelně vylooučena ani jiná smluvní řešení.

- a) Smlouva o spolupráci na výzkumném projektu, ve které každá osoba vlastní duševní vlastnictví k výsledkům, které vytvořila a poskytuje každé z dalších osob nevýhradní licenci využívat tyto výsledky pro účely projektu a pro jakýkoli další účel (křížové licence), takže kterákoli ze zúčastněných osob může využívat kterékoli výsledky. Smluvními stranami může být i více univerzit a dalších osob.
- b) Smlouva o spolupráci s hlavním uživatelem. Zde je určena jedna strana, která má nejlepší podmínky - hlavní uživatel k využití výsledků. Ostatní strany smlouvy převedou svá duševní vlastnictví k výsledkům (nebo mu poskytnou výhradní licenci) a hlavní uživatel se stará o jejich využití. Protiplněním ze strany hlavního uživatele jsou sjednané platby a podíl na výnosech.
- c) Smlouva o spolupráci pro osoby, které mají různé podmínky pro použití výsledků. Každá strana využívá ty výsledky, které jsou podstatné pro její výzkum a její podnikání, příp. provádí platby dalším stranám, a naopak se podílí na výnosech.
- d) Smlouva o spolupráci, podle které každý účastník vlastní duševní vlastnictví pro výsledky, které vytvořil a poskytuje nevýhradní licenci dalším smluvním stranám pouze pro účely řešeného projektu (křížové licence, ovšem omezené účelem).

## **7 K licenčním smlouvám**

Nejčastěji se v dané tématice uzavírají licenční smlouvy. Proto se jím v tomto pojednání věnujeme speciálně.

Chceme-li se dále zabývat nadepsanou tematikou, pojednáme nejprve o dřívější české úpravě obchodněprávní, která koresponduje s právní aktuální úpravou platnou ve Slovenské republice, a posléze o úpravě občanskoprávní, která nyní platí v ČR.

Přitom dnešní ustanovení § 3028 občanského zákoníku v ČR určuje, že se tímto zákonem řídí práva a povinnosti vzniklé ode dne nabytí účinnosti. Tento zákon č. 89/2012 Sb. přitom nabyl účinnosti dne 1. 1. 2014.

Ustanoveními tohoto zákona se zásadně řídí i právní poměry týkající se práv osobních, rodinných a věcných; jejich vznik, jakož i práva a povinnosti z nich vzniklé přede dnem nabytí účinnosti tohoto zákona se však posuzují podle dosavadních právních předpisů.

Právní poměry vzniklé přede dnem nabytí účinnosti občanského zákoníku, jakož i práva a povinnosti z nich vzniklé, včetně práv a povinností z porušení smluv uzavřených přede dnem nabytí účinnosti občanského zákoníku, se zásadě řídí předchozími právními předpisy. To nebrání ujednání stran, že se tato jejich práva a povinnosti budou řídit občanským zákoníkem ode dne nabytí jeho účinnosti.

To zásadně znamená, že licenční smlouvy k předmětům průmyslového vlastnictví (které se obecně neuzavírají na krátkou dobu) uzavřené do 31. 12. 2013 se v ČR řídí obchodním zákoníkem,<sup>2</sup> a to případně ještě i poměrně dlouho, a teprve smlouvy uzavřené od 1. 1. 2014

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<sup>2</sup> Zákon č. 513/1991 Sb., obchodní zákoník.

se budou řídit zákoníkem občanským. Proto pojednáváme i o úpravě obchodněprávní, která je přitom v SR stále součástí platného práva.

Důvodová zpráva k občanskému zákoníku v ČR uvedla, že práva a povinnosti z licenčních smluv byla v dřívějším právu upravena nejednotně. Ustanovení o licenci k předmětům průmyslového vlastnictví obsahovalo obchodní zákoník (v ustanoveních § 508 a násl.), ustanovení o licenci k předmětům chráněným autorským právem, právy souvisejícími a zvláštním právem pořizovatele databáze obsahovalo zákon autorský<sup>3</sup> (§ 46 a násl.). Obě tyto úpravy byly speciální.

Podle důvodové zprávy se to jevilo jako nedostatek, který bylo vhodné odstranit, a to tak, že se obě speciální úpravy spojily do jednoho institutu v občanském zákoníku, přičemž jsou respektovány zvláštnosti licence k předmětům chráněným autorským zákonem. Nová úprava „sleduje především naplnění systematického hlediska..., právní úpravu v obou speciálních zákonech přejímá, aniž ji podstatně mění.“ Práva a povinnosti z licenční smlouvy přecházejí na právního nástupce osoby, které byla licence udělena. Licenční smlouva může takový přechod práv a povinností na právního nástupce vyloučit.

Důvodová zpráva pak považovala za důležité uvést, že nabyvatel podlicence může dále poskytovat další podlicenci jen tehdy, bylo-li tak ujednáno mezi ním a poskytovatelem podlicence.

## **8 Úprava obchodního zákoníku (v ČR výchozí úprava pro dnešní úpravu v občanském zákoníku, v SR úprava dnes účinná)**

Aby byla produkce zboží na potřebné úrovni, je nutné provádět výzkumné a vývojové práce. Obecně však není nutné vyvijet všechno to, co je již objeveno. Je možno - v souladu s právem - využívat výsledků činností jiných subjektů, dobré pozice jejich označení na trhu i jiných práv. Přitom lze tyto výsledky a práva na označení, jakož i jiná práva, současně poskytovat. K tomu slouží uzavírání licenčních smluv.<sup>4</sup>

Licenční smlouvou k předmětům průmyslového vlastnictví

- opravňuje poskytovatele nabyvatele ve sjednaném rozsahu a na sjednaném území k výkonu práv z průmyslového vlastnictví (dále též "právo")
- nabyvatel se zavazuje k poskytování určité úplaty nebo jiné majetkové hodnoty.

Smlouva vyžaduje písemnou formu.

Tak zní text základního ustanovení licenční smlouvy k předmětům průmyslového vlastnictví podle § 508 obchodního zákoníku, který byl s modifikacemi (z důvodu zevšeobecnění a sjednocení s autorskoprávní úpravou) převzat do § 2358 OZ. Ustanovení bylo kogentní (§ 263 odst. 2 obchodního zákoníku).

Smluvní typ licenční smlouvy k předmětům průmyslového vlastnictví byl tzv. relativním obchodem, který bylo možné použít na případy splňující podmínky stanovené v § 261 odst. 1 a odst. 2 obchodního zákoníku. Přitom i zde bylo možné pochopitelně podle ustanovení § 262 obchodního zákoníku dohodnout, že vztah, který nespadá pod vztahy uvedené v § 261, se též obchodním zákoníkem řídí.

Základní ustanovení určovalo podstatné části smlouvy, kterými jsou - vedle konkretizace smluvních stran (poskytovatele a nabyvatele): specifikace předmětu ochrany, rozsahu jeho užití<sup>5</sup> a určení úplatnosti (dle obchodního zákoníku byla úplatnost pojmovým znakem licence k průmyslovým právům, tak tomu však již není).

<sup>3</sup> Zákon č. 121/2000 Sb., o právu autorském, o právech souvisejících s právem autorským a o změně některých zákonů (autorský zákon).

<sup>4</sup> Viz např. MAMOJKA, M., ZAJAC, P.: Obchodné právo, Akadémia policejného zboru SR, Bratislava, 1996, 153 s., MAREK, K.: Smluvní obchodní právo, Kontrakty, 4. aktualizované a rozšířené vydání, MU Brno, 2008, s. 212 – 219.)

<sup>5</sup> A to včetně území, u něhož absence sjednání vedla k neplatnosti smlouvy (rozsudek Nejvyššího soudu sp. zn.

Přitom je nutno si uvědomit, že použití smlouvy bylo možné jen pro "práva z průmyslového vlastnictví". Použití smlouvy je sice široké, ale je vymezené právě určením této smlouvy.

Podle této právní úpravy bylo možné smlouvu použít jen pro předměty průmyslového vlastnictví, tj. zásadně pro práva chráněná patenty na vynálezy, pro užitné vzory, pro průmyslové vzory, ochranné známky, topografie polovodičových výrobků, nové odrůdy rostlin a (pokud byla v českém právu chráněna) plemena zvířat.

Sjednání licence přitom nepřichází v úvahu (vzhledem ke speciální povaze vázané jen na příslušné území) u označení původu a zeměpisných označení.

V jednom z komentářů textu obchodního zákoníku se objevil tento názor: "Poskytovatel licence podle § 508 až 515 může být jen majitel, popř. přihlašovatel výlučného práva k některému z uvedených nehmotných statků. Úpravu § 508 až 515 nelze použít na smlouvě o sublicenci."<sup>6</sup>

Citovaný názor je plně v souladu s ustanovením § 511 odst. 2 obchodního zákoníku. Text ustanovení § 511 byl však dispozitivní. Dohodou stran bylo možno jej buď vyloučit, anebo ujednat jinak. Proto se domníváme, že v těch případech, kdy smluvní strany takové odchylné ujednání provedly, nic obecně nebránilo uzavření sublicenční smlouvy, a nebylo to v rozporu se základním ustanovením tohoto smluvního typu.

Poskytovatel byl podle § 511 obchodního zákoníku nadále oprávněn k výkonu práva, jež je předmětem smlouvy, a k poskytnutí jeho výkonu jiným osobám a nabyvatel nebyl oprávněn přenechat výkon práva jiným osobám.

Vzhledem k dispozitivnosti tohoto ustanovení je zde ovšem možnost sjednat jiná řešení. Jsou pochopitelně možná řešení, že je poskytovatel nadále oprávněn k výkonu práva, nesmí však poskytnout výkon jiným osobám apod.

Podle obchodního zákoníku se tedy sjednávala licence jako nevýhradní, bylo však možno též sjednat ji jako výhradní.

Podle obchodněprávní úpravy nebylo možné licenční smlouvu - smluvní typ upravený obchodním zákoníkem - uzavírat jinak než k předmětům průmyslového vlastnictví. Jiné smlouvy tohoto druhu poskytující práva k jiným předmětům než k předmětům průmyslového vlastnictví bylo možné uzavírat v režimu autorského zákona nebo v režimu smlouvy nepojmenované podle § 269 odst. 2 obchodního zákoníku. V takové situaci se na tyto nepojmenované smlouvy (viz text § 269 odst. 1 obchodního zákoníku) nevztahovala ustanovení obchodního zákoníku upravující licenční smlouvu, ledaže by si to smluvní strany ujednaly.

Na podporu tohoto právního stavu se argumentovalo takto: "Licenční smlouvy mají mnoho typů s velmi rozdílným obsahem. Není proto snadné (ani vhodné) stanovit v zákoně jednotný režim, vyhovující licencím všech typů na všechny druhy nehmotných statků. Společná úprava licenční smlouvy jako takové by byla příliš obecná. Omezení úpravy § 508 až 515 obchodního zákoníku pouze na licence k předmětům průmyslového vlastnictví vyplývá ze společných prvků, např. jejich ochrany na základě rozhodnutí státního orgánu (např. registrace), což další nehmotné statky nemají."<sup>7</sup>

Podle našeho názoru bylo možno zvážit, zda by bylo možno tehdejší licenční smlouvu upravit tak, aby zahrnovala širší okruh vztahů (s výjimkou autorských licenčních smluv podle autorského zákona) včetně licenční smlouvy na know-how, zahrnující např. technologické

<sup>6</sup> Cdo 1321/2010 ze dne 28. 6. 2012). Podle úpravy nového občanského zákoníku sjednání území již mezi podstatné náležitosti smlouvy nepatří.

<sup>7</sup> ŠVARC, Z. a kol.: Úplné znění zákona č. 513/1991 Sb., obchodní zákoník s výkladem, Ekonomický a právní poradce podnikatele č. 12-13/1996, s. 174.

<sup>7</sup> ŠVARC, Z. a kol.: Úplné znění zákona č. 513/1991 Sb., obchodní zákoník s výkladem, Ekonomický a právní poradce podnikatele č. 12-13/1996, s. 174.

postupy či materiálové složení příslušného zboží, které nejsou chráněné průmyslovými právy. Právní úprava v osmi paragrafech obchodního zákoníku byla tak obecná (s výjimkou základního ustanovení), že vyhovovala univerzálnímu použití. Ostatně tam, kde se jedná o práva zapisovaná do příslušného rejstříku, bylo na to pamatováno v kogentním ustanovení § 509 odst. 1 obchodního zákoníku. Po vydání obchodního zákoníku jsme se domnívali, že pro případné budoucí obecné použití licenční smlouvy není nutno v ustanoveních § 509 až 515 obchodního zákoníku změnit vůbec nic. Změny by si vyžádalo jen ustanovení § 508 odst. 1. Nový občanský zákoník tyto potíže odstranil a licenční smlouvu koncipoval univerzálně pro všechny případy licencí k předmětům duševního vlastnictví.

Sjednání smlouvy umožňovalo výkon práva, nikoli jeho převod. Pokud by strany chtěly sjednat převod práva, vzhledem k tomu, že obchodní zákoník takový smluvní typ neupravoval, nezbývalo jim než volit kontrakt inominální, u něhož snad bylo možno uvažovat o analogickém použití občanskoprávní úpravy o koupě věci (spíše než obchodněprávní úpravy použitelné toliko na kupu zboží).

Smlouvou o převodu práva bylo možno sjednat jen tam, kde ji zvláštní právní úprava nezakazovala. Zákaz převodu práva je např. stanoven podle právní úpravy u tzv. kolektivních ochranných známek. Pro tyto známky byl rovněž stanoven zákaz uzavřít licenční smlouvu.

Obchodní zákoník upravoval též otázku zápisu do rejstříku práv: "Stanoví-li tak zvláštní předpis, vyžaduje se k výkonu práva poskytnutého na základě smlouvy zápis do příslušného rejstříku těchto práv." Uvedené kogentní ustanovení se uplatňovalo například podle českého práva u ochranných známek.

Licenční smlouva k ochranné známce nabývá účinnosti vůči třetím osobám zápisem do rejstříku ochranných známek, který vede Úřad průmyslového vlastnictví.

Přitom je třeba respektovat, že pokud jde o průmyslové vlastnictví a jeho ochranu, uplatňuje se zde princip teritoriality. Výkon práva je tedy v souladu s tímto principem nutno zajistit ve všech zemích, kde je podmínka zápisu daným právem stanovena.

Ustanovení, které jsme uvedli v uvozovkách (viz výše) bylo kogentní (viz § 509 odst. 1 a § 263 obchodního zákoníku). Bylo to jediné ustanovení tohoto druhu - kromě základního ustanovení - v právní úpravě této smlouvy, nový občanský zákoník však v této podobě ustanovení nepřebírá.

Ostatní ustanovení obchodního zákoníku u této smlouvy byla dispozitivní a ujednání stran v těchto případech měla přednost před textem zákona.

V jednotlivých případech bylo dispozitivnosti textu zákona bohatě využíváno. Pro potřeby právní praxe však nezřídka nestačilo pouze učinit dohody odlišné od zákona, ale bylo vhodné upravit smluvně řadu otázek, které v obchodním zákoníku nejsou zmíněny. Ve smlouvě mohla být - podle povahy daného případu - mj. sjednána odborná pomoc poskytovatele, odborné vzdělávání příslušných pracovníků, podrobnosti o předávané dokumentaci a o obsahu příslušných předávacích zápisů, platební podmínky atd. Protože se jednalo o předmět průmyslového vlastnictví, bylo nutné seznámit se přitom se speciální právní úpravou, která se na takový předmět vztahuje.

Při uzavírání smlouvy musel přitom poskytovatel též respektovat ustanovení zákona na ochranu hospodářské soutěže. Dohody o převodu práv nebo o poskytnutí licencí na vynálezy, průmyslové vzory, ochranné známky, topografie polovodičových výrobků, užitné vzory a chráněné odrůdy rostlin nebo části dohod mohou totiž být neplatné, jestliže nabyvatelům ukládají v hospodářském styku omezení, která přesahují předmět a rozsah průmyslově právní ochrany těchto předmětů.

Neplatnost se však nebude vztahovat zejména na omezení nabyvatele práva nebo licence, jestliže jsou odůvodněna zájmem převodce práva či poskytovatele licence na řádném užití předmětu ochrany; dále též na závazky nabyvatele práva nebo licence k výměně zkušeností nebo k poskytnutí licence k patentům na zlepšení či na užití předmětu ochrany, pokud to

odpovídá vzájemným závazkům převodce práva či poskytovatele licence; stejně jako na závazky nabyvatele práva nebo licence vztahující se na hospodářskou soutěž na trzích mimo oblast platnosti zákona na ochranu hospodářské soutěže.

Příslušná ustanovení zákona na ochranu hospodářské soutěže se použijí obdobně na převod nebo poskytnutí výkonu práva na předměty plnění, které nelze podřadit do průmyslového vlastnictví.

Závisí-li trvání práva poskytovaného licenční smlouvou na jeho výkonu, je nabyvatel pode předchozí i nynější úpravy k tomuto výkonu povinen. Například u ochranných známek se užívání práva pro jeho zachování vyžaduje. Z rejstříku by byla vymazána známka, která by nebyla po dobu pěti let užívána a majitel ochranné známky by její užívání rádně nezdůvodnil. U ochranných známek platí tedy úprava o užívání kogentní úprava podle zvláštního předpisu.

Předpisy týkající se průmyslového vlastnictví však v konkrétním případě mohou být jiné než české, eventuálně je třeba mít na zřeteli i mezinárodní úmluvy.

Navazující ustanovení obchodního zákoníku určila poskytovateli povinnost po dobu trvání smlouvy udržovat právo, pokud to povaha tohoto práva vyžaduje. To se týká především placení poplatků, případně zajišťování činností souvisejících například s obnovou zápisů v rejstřících apod. Protože se může jednat i o jiné území než Českou republiku, platí zde opět poznámka o důležitosti sjednání území a o případném respektování právních předpisů jiných států a mezinárodních úmluv.

Podle obchodního zákoníku byl poskytovatel povinen bez zbytečného odkladu po uzavření smlouvy poskytnout nabyvateli veškeré podklady a informace, jež jsou potřebné k výkonu práva podle smlouvy. Nebylo-li mezi poskytovatelem a nabyvatelem dohodnuto jinak, bylo plnění této zákonné povinnosti často vlastně jedním z předpokladů úspěšného výkonu práva.

Zákonnou povinností nabyvatele je utajovat poskytnuté podklady a informace před třetími osobami, ledaže ze smlouvy nebo z povahy poskytnutých podkladů a informací vyplývá, že poskytovatel nemá zájem na jejich utajování. Za třetí osoby se nepovažují osoby, jež se účastní na podnikání podnikatele a které podnikatel zavázal mlčenlivostí.

Po zániku smlouvy je nabyvatel povinen poskytnuté podklady vrátit a dále utajovat poskytnuté informace do doby, kdy se stanou obecně známými. To upravovalo ustanovení § 513 obchodního zákoníku, které tak rozšiřovalo úpravu § 17 až 20 o obchodním tajemství a § 271 o důvěrných informacích poskytnutých při jednání o uzavření smlouvy.

Je-li nabyvatel omezován ve výkonu práva jinými osobami nebo zjistí-li, že jiné osoby toto právo porušují, je povinen bez zbytečného odkladu podat o tom zprávu poskytovateli. Jinak při porušení této povinnosti, nebude-li sjednána specifická sankce, přichází v úvahu uplatnění odpovědnosti za škodu jako při porušení povinnosti obecně. Nepodání zprávy by též mohlo být ve smlouvě označeno za podstatné porušení smlouvy s důsledky z toho plynoucími.

Poskytovatel je povinen bez zbytečného odkladu učinit potřebná právní opatření k ochraně výkonu práva nabyvatelem. Při těchto opatřeních je nabyvatel povinen poskytnout poskytovateli potřebné spolupůsobení. Vzhledem k tomu, že "výkon práv" je důležitou částí smlouvy, museli bychom i bez smluvního ujednání o tom, že takové porušení smlouvy je podstatným porušením smlouvy, hodnotit případné porušení této povinnosti poskytovatelem jako podstatné. Nabyvatel je zde odkázán na aktivitu poskytovatele.<sup>8</sup>

Smlouva mohla být sjednána na dobu určitou i neurčitou. Zákon stanovil, že nebyla-li sjednána smlouva na dobu určitou, bylo možno ji vypovědět. Jde ovšem opět o dispozitivní ustanovení, není tedy vyloučeno sjednání výpovědi i u smlouvy na dobu určitou. Nestanoví-li

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<sup>8</sup> Viz též PELIKÁNOVÁ, I.: Komentář k obchodnímu zákoníku, Linde, Praha 1997, s. 435.

smlouva jinou výpovědní lhůtu, nabývá výpověď účinnosti uplynutím jednoho roku od konce kalendářního měsíce, v němž byla výpověď doručena druhé straně.

Vzhledem k tomu, že byla právní úprava zásadně dispozitivní, bylo možno konkrétní smlouvu "ušít na míru", bylo však třeba nepostupovat povrchně a respektovat i speciální tuzemské právní úpravy, v daných případech i speciální právní úpravy v jiných právních rádech (zejména tzv. imperativní normy mezinárodního práva, jako např. zákaz převodu některých práv apod.) a mezinárodní úmluvy.

## 9 Dnešní občanskoprávní úprava v ČR

Česká právní úprava občanskoprávní podle zák. č. 89/2012 Sb. není příliš rozsáhlá. V tom se nijak neodchyluje od někdejší úpravy obchodněprávní. Pod rubrikou Licence najdeme obecnou úpravu v ustanovení § 2358 – 2370.

Navazují pak zvláštní ustanovení pro licenci k předmětům chráněným autorským zákonem a zvláštní ustanovení pro licenční smlouvu nakladatelskou. Tato ustanovení však nejsou předmětem našeho pojednání.

Přitom řada poznámek, které jsme učinili v části věnované někdejší obchodněprávní úpravě, má platnosti i pro novou úpravu občanskoprávní. Půjde-li o shodný dílčí problém, pak v takovém případě nebudeme již naše vyjádření v této části práce uvádět znova. To se týká zejména příkladů využití smluvní volnosti a odkazů na zvláštní úpravy.

Občanskoprávní úprava je zásadně dispozitivní. Ustanovení § 1 odst. 2 totiž určuje: Nezakazuje-li to zákon výslovně, mohou si osoby ujednat práva a povinnosti odchylně od zákona; zakázána jsou ujednání porušující dobré mravy, veřejný pořádek nebo právo týkající se postavení osob, včetně práva na ochranu osobnosti.

Respektovat je však třeba základní ustanovení tohoto smluvního typu, které obsahuje podstatné náležitosti smlouvy. Licenční smlouvou podle tohoto základního ustanovení § 2358 poskytuje poskytovatel nabyvateli oprávnění k výkonu práva duševního vlastnictví (licenci) v ujednaném omezeném nebo neomezeném rozsahu a nabyvatel se zavazuje, není-li dohodnuto jinak, poskytnout poskytovateli odměnu.

Podstatné náležitosti licenční smlouvy tvoří:

- vymezení příslušného práva duševního vlastnictví
- poskytovateľovo poskytnutí oprávnění nabyvateli k výkonu práva a jeho rozsah (v ujednaném omezeném nebo neomezeném rozsahu)
- určení zda je smlouva úplatná či bezúplatná, typicky tedy nabyvatelův závazek zaplatit odměnu (není-li dohodnuto jinak, např. při tzv. křížových licencích, kdy nabyvatel jako poskytovatel poskytuje místo peněžité odměny oprávnění k výkonu jiného práva nebo je poskytuje bezúplatně).

Přitom není možné odchylné ujednání od odst. 2 základního ustanovení, které zde určuje: Smlouva vyžaduje písemnou formu,

- poskytuje-li se licence výhradní, nebo
- má-li být licence zapsána do příslušného veřejného seznamu.

Odchylné ujednání zde není možné s ohledem na ustanovení § 559 občan. zák., které vymezuje: Každý má právo zvolit si pro právní jednání libovolnou formu, není-li ve volbě formy omezen ujednáním nebo zákonem.<sup>9</sup>

Pro vymezení kogentních a dispozitivních ustanovení je pak třeba zkoumat ustanovení § 2360 odst. 1 a odst. 2. Odstavec 1 určuje, že je-li ujednána výhradní licence, poskytovatel nemá právo poskytnout tutéž licenci třetí osobě po dobu, co výhradní licence trvá. Není-li výslovně ujednán opak, zdrží se i poskytovatel výkonu práva, ke kterému udělil výhradní licenci. Zde chápeme první větu odst. 1 jako nikoli dispozitivní vymezení, zatímco druhá věta

<sup>9</sup> Blíže viz TICHÝ, L. in ŠVESTKA, J.; DVOŘÁK, J.; FIALA, J.: Občanský zákoník, komentář, Svazek I, Wolters Kluwer, Praha 2014, s. 1380 - 1384, ISBN 978-80-7478-370-8.

umožnuje (jde-li o výhradní licenci v obvyklém významu tohoto pojmu) výslovně ujednání odchylného řešení.

Ustanovení § 2360 odst. 2 přitom určuje, že poskytne-li poskytovatel za trvání výhradní licence nabyvatele bez jeho souhlasu uděleného v písemné formě licenci třetí osobě, licence nevznikne. Byla-li však nevýhradní licence poskytnuta před poskytnutím výhradní licence, zůstává zachována. Podle našeho názoru pak znění odst. 2 první věty neumožnuje jiné ujednání za trvání výhradní licence, ledaže by nabyvatel poskytl souhlas v písemné formě. Podle druhé věty odst. 2 půjde pak o výhradní licenci podle jejího označení, avšak dřívější poskytnutá nevýhradní licence zůstane zachována.

Za kogentní přitom považujeme i ustanovení § 2358 odst. 3, které je součástí základního ustanovení. Pro licence k předmětům průmyslového vlastnictví zapsané do veřejného seznamu je určeno, že jsou účinné vůči třetím osobám zápisem do tohoto seznamu. Je zde tedy zvoleno obvyklé řešení; případné nezapsání má význam ve vztahu ke třetím osobám, strany smlouvy však smluvní ujednání zavazuje.

Jak vidíme, zatímco úprava v obchod. zák. vyžadovala obecně pro licenční smlouvou k předmětům průmyslového vlastnictví písemnou formu vždy, občanský zákoník tak činí jen pro vymezené případy.

Občanský zákoník přitom nevymezuje území, na kterém je možno licenci vykonávat. Ujednání o této otázce je však vhodné. Jinak by se muselo při výkladu zřejmě vycházet z teritoria, na kterém je dané právo chráněno, případně i z jiných skutečností.

Po sjednání licence není nabyvatel povinen licenci využít, ledaže trvání práva závisí na jeho výkonu (§ 2359 odst. 1). Dle obsahu druhé části věty tohoto odstavce si nebudou zásadně moci strany smlouvy dohodnout jinak, a to vzhledem k jiné právní úpravě, ve které bude povinné užívání práv určeno (např. u ochranných známek).

Ustanovení § 2359 odst. 2 ukládá poskytovateli povinnost udržovat právo po dobu licence, vyžaduje-li to jeho povaha. Jedná se o obnovu zápisů v příslušných rejstřících (tam, kde to ukládají jiné právní předpisy).

Podle dispozitivního ustanovení § 2361, je-li sjednána nevýhradní licence, je poskytovatel oprávněn k výkonu práva, ke kterému udělil nevýhradní licenci a může poskytnout licenci i další osobě. K této otázce je ovšem možno ujednat různá smluvní řešení, např. takové, že výkon práva poskytovatele bude nadále možný, avšak další licenci již nebude moci udělit. Pokud bude moci být další licence udělena, je pak v zájmu nabyvatele, aby případně byla ve smlouvě taková možnost vymezena.

Bude-li pak nabyvatel chtít poskytnout oprávnění tvořící součást licence k poskytnutí licence zcela nebo z části třetí osobě, může tak učinit, jen bylo-li to sjednáno ve smlouvě (§ 2363). Pak je podlicence možná.

Není-li výslovně ujednaná výhradní licence, pak platí, že jde o licenci nevýhradní.

Kromě problematiky podlicence řeší občanský zákoník (§ 2364) i případné postoupení licence třetí osobě. Toto postoupení je zcela nebo z části možné jen se souhlasem poskytovatele. Pro udělení souhlasu je předepsána písemná forma. Méně přísnou formu dohodnout nelze.

Nabyvatel - postupitel pak po udělení souhlasu sdělí bez zbytečného odkladu, že licenci postoupil a sdělí i osobu postupníka (§ 2364 odst. 2). Tuto dílčí otázku je však možno dohodnout jinak.

Občanský zákoník (v § 2365) řeší i licenci ve vztahu k převodu závodu (dříve podle obchod. zák. „převodu podniku“) nebo jeho části. Byl-li převeden závod nebo jeho část, která tvoří jeho samostatnou složku, souhlas poskytovatele k převedení licence se vyžaduje jen bylo-li to zvlášť ujednáno.

Protože z příslušné smlouvy nemusí být zřejmé, zda se jedná o licenci výhradní či nevýhradní, snaží se občanský zákoník pomoci řešit tuto situaci a upravuje: Není-li výslovně sjednána výhradní licence, platí, že se jedná o nevýhradní licenci.

Problematika **podkladů** je v občanském zákoníku upravena obsahově shodně s dřívější úpravou obchodněprávní (v § 2367 – 2369).

Poskytovatel poskytne nabylvateli bez zbytečného odkladu po uzavření smlouvy veškeré podklady a informace potřebné k výkonu licence. Jak jsme již uvedli v části věnované obchodněprávní úpravě, plnění této povinnosti bude předpokladem k výkonu práva.

Po zániku licence nabylvatelu poskytnuté podklady vrátí; sdělení utají až do doby, kdy se stanou obecně známými.

Nabylvatel utají před třetími osobami podklady a sdělení, jichž se mu od poskytovatele dostalo, ledaže ze smlouvy nebo z povahy podkladů a sdělení vyplývá, že poskytovatel nemá na jejich utajování zájem. Za třetí osobu se nepovažuje zaměstnanec ani ten, kdo se na podnikání podnikatele účastní, byl-li podnikatelem zavázán k mlčenlivosti.

Jinak (shodně s úpravou obchodněprávní) zde podle ustanovení § 2369 platí, že je-li nabylvatel omezován ve výkonu práva jinými osobami nebo zjistí-li, že jiné osoby toto právo porušují, je povinen bez zbytečného odkladu podat o tom zprávu poskytovateli. Jinak při porušení této povinnosti (shodně jako podle dřívější úpravy), nebude-li sjednána specifická sankce, přichází v úvahu uplatnění odpovědnosti za škodu jako při porušení povinnosti obecně. Nepodání zprávy by též mohlo být ve smlouvě označeno za podstatné porušení smlouvy s důsledky z toho plynoucími.

Významným smluvním ujednáním je ujednání o odměně. Rozhodující je zde to, co si strany dohodly. Většinou bude dohoda sjednána. Může být přitom sjednána různými způsoby. Může být pevná jednorázová, měsíční, výpočtem podle objemu produkce licencovaného zboží, v závislosti na výnosech apod.

Není-li ujednána výše odměny nebo způsob jejího určení, je smlouva přesto platná, pokud

- z jednání stran o uzavření smlouvy vyplývá jejich vůle uzavřít uplatnou smlouvu i bez určení výše odměny; v takovém případě nabylvatelu poskytovateli zaplatí odměnu ve výši, která je obvyklá v době uzavření smlouvy za obdobných smluvních podmínek a pro takové právo, nebo
- strany ve smlouvě ujednají, že se licence poskytuje bezúplatně.

Jestliže by tedy nebyly dodrženy tyto podmínky určené podle § 2366 odst. 1 nebylo by možno hodnotit smlouvu jako platnou.

Je-li výše odměny ujednána v závislosti na výnosech z využití licence, umožní nabylvatelu poskytovateli kontrolu příslušných účetních záznamů nebo jiné dokumentace ke zjištění skutečné výše odměny.

Poskytnuté informace mohou být označeny za důvěrné. Poskytne-li takto nabylvatelu poskytovateli informace označené nabylvatelem jako důvěrné, nesmí je poskytovatel prozradit třetí osobě ani je použít pro své potřeby v rozporu s účelem, ke kterému mu byly poskytnuty.

Plnění této povinnosti může být utvrzeno příslušnou konkrétní sankcí, a jestliže by tomu tak nebylo, bylo by při porušení povinnosti i v těchto případech možno postupovat podle ustanovení o náhradě škody.

Nabylvatel předloží poskytovateli pravidelná vyúčtování odměny podle v ujednaných časových obdobích; není-li ujednáno jinak, je povinen tak učinit alespoň jednou ročně.

K **trvání** smlouvy lze uvést, že pojednané licenční smlouvy se začasté uzavírají na dobu určitou. I v takových případech je však možné podle našeho názoru dohodnout, jak lze ukončit smluvní vztah v průběhu doby určité.

Platí zde pochopitelně i obecné způsoby ukončení tohoto vztahu, tj. dohodou, odstoupením atd. To platí pochopitelně i pro smlouvy uzavřené na dobu neurčitou.

Při uzavření smlouvy na dobu neurčitou platí podle § 2370, není-li dohodnuto jinak, ustanovení o výpovědi. Je-li smlouva uzavřena na dobu neurčitou, nabývá výpověď účinnosti uplynutím jednoho roku od konce kalendářního měsíce, v němž výpověď došla druhé straně. Zákonná výpovědní doba se zde může jevit dlouhá. Je však odůvodněná potřebou opatření, která bude třeba ve většině případů učinit, a ty nebudou mít začasté krátkodobou povahu.

Pro případ ukončení smluvního vztahu je pak možné dohodnout i případné uhrazení další části odměny a otázky využívání či nevyužívání získaných poznatků. Je též možné dohodnout i ujednání obsahově odpovídající konkurenční doložce.

## Závěr

K realizaci výzkumných projektů před uzavíráním licenčních smluv (a případných smluv o převodu a postoupení práv) může přispět i různé smluvní řešení vztahů univerzit a subjektů poskytujících finanční prostředky.

Tyto smlouvy budou komponovány jako tzv. smlouvy nepojmenované. Takovou smlouvu dokáže připravit zkušený právník (advokát, podnikový právník nebo právník univerzity). Po sjednávání takových smluv lze celospolečensky využít potenciálních kapacit (akademických pracovníků, výzkumníků a studentů), kterými univerzity (vysoké školy) disponují. Studentům přitom mohou podnikatelé poskytovat stipendia a sjednat si s nimi jejich další pracovněprávní působení v daném podnikatelském subjektu po dohodnutou dobu. Této možnosti je využíváno.

V závěru našeho pojednání můžeme potvrdit, že nová právní úprava licenční smlouvy v ČR vychází (a zásadně se shoduje) z úpravy obchodněprávní. Novinkou je skutečnost, že není smlouva vázaná na předměty průmyslového vlastnictví a je také možnost sjednání této smlouvy jako bezplatné. Široce je možno využít smluvní volnosti.

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# THE TRIPS CONVENTION AND ITS CURRENT IMPORTANCE FOR THE PROTECTION OF INTELLECTUAL PROPERTY RIGHTS

PRÁVA DUŠEVNÍHO VLASTNICTVÍ VE SVĚTOVÉM OBCHODU:  
JE DOHODA TRIPS NÁSTROJEM PROTEKCIJONISMU VE SVĚTOVÉM  
OBCHODU?

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## Abstract

The author seeks to clarify two aspects of the of TRIPS and character of its provisions: on the one hand, he analyses the question of whether trips should generally be rejected from a regulatory political point of view, on the other hand, it outlines some urgent current needs for revision and completion of certain provisions of TRIPS connected with vital needs of the developing countries and their interest to be involved more in implementation of TRIPS and sharing of benefits following thereof.

## Keywords

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Intellectual Property Rights, Public Goods, World Trade Organisation, TRIPs

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## Úvod

V roce 1995 byla při zakládání Světové obchodní organizace (WTO) přijata Dohoda o obchodních aspektech práv k duševnímu vlastnictví (dále jen „dohoda TRIPS“ či „TRIPS“). Dohoda TRIPS je součástí celkového právního rámce WTO, jehož stěžejními součástmi jsou dále Všeobecná dohoda o cílech a obchodu (GATT) a Všeobecná dohoda o obchodování se službami (GATS). K začlenění dohody TRIPS do práva WTO došlo na popud industriálních zemí a z velké části proti vůli rozvojových zemí. V konečné fázi rozvojové země dohodu podepsaly pod značným tlakem a hrozbou sankčních opatření ze strany vyspělých zemí. Kritikové dohody TRIPS obviňují vyspělé země, že ustanovení Dohody formulovaly záměrně jako nástroj protekcionismu proti rozvojovým zemím a že je jako takové používají.<sup>1</sup> Jako hlavní cíl vidí záměr vyloučit rozvojové země z účasti na šíření nových poznatků, tak aby potenciální noví konkurenti se nemohli technologicky rozvíjet a byli tak handicapováni ve světovém obchodu. Tyto kritické argumenty jsou zdrojem napětí mezi vyspělými a rozvojovými zeměmi i v současnosti, při uzavírání dvoustranných obchodních dohod, které, vycházejíce z práva WTO jako základního právního rámce, obsahují rovněž rozšířená ustanovení na ochranu IPR.<sup>2</sup>

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<sup>1</sup>Viz např. KRISHNA R., SINGH, R.(2018),TRIPS Agreement: A CriticalAnalysis.Society of International Law and Policy, National University of Juridical Sciences,. <https://silpnus.wordpress.com/2018/06/05/trips-agreement-analysis/>

<sup>2</sup> MORIN, J.- F., SURBECK,J(2020), Mapping the New Frontier of International IP Law: Introducing a TRIPs-plus Dataset. World Trade review, Volume 19, Issue 1, January , str. 109-122

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## Materiál a metody

V tomto příspěvku se snažíme prozkoumat, zda jsou uvedené výtky oprávněné a zda je skutečně třeba dohodu TRIPS hodnotit jako ochranný nástroj industriálních zemí, nebo zda se jedná o vyvratitelné nařčení. Po stručném nastínění vlastnosti IPR si v následující části objasníme význam IPR pro světový obchod. Další část se zaměřuje ustanovení dohody TRIPS z hlediska jejich možného protekcionistického obsahu a v závěru jsou předkládána doporučení k revizím textu dohody, odpovídajícím aktuálním potřebám ochrany IPR v zájmu vyspělých i rozvojových zemí. Za tímto účelem je použito metody analytické, komparativní a historické.

## Výsledky a diskuse

### 1 Charakteristika práv duševního vlastnictví

Existují různé typy práv duševního vlastnictví. Jejich rozlišení vychází z předmětu ochrany. V následující tabulce uvádíme přehled kategorií práv duševního vlastnictví (dále též "IPR").<sup>3</sup>

Tabulka 1. Kategorie práv duševního vlastnictví

Typ IPR	Předmět ochrany	Praktické příklady
Patent	technologické inovace využitelné komerčně	průmyslové výrobky, farmaceutické výrobní procesy
Autorská práva a práva související	umělecká, vědecká nebo literární díla	obrazy, hudba, filmy, knihy, počítačové programy
Obchodní známky	firemní známky, loga, slogany	spotřební a průmyslové zboží, společnosti ze všech odvětví
Užitné vzory	dekorativní prvky vzhledu výrobku, design, topografie integrovaných obvodů	automobilový průmysl, textilní průmysl
Zeměpisná označení	objekty z určitých oblastí nebo umístění	vína, destiláty, sýry

Zdroj: vlastní

Stručná charakteristika v této části se vztahuje na všechny zmíněné kategorie IPR. Nutno však předeslat, že největší ekonomický (potažmo i obchodní) význam mají nepochyběně patenty a s nimi související licence. Držitele práv možno označit též jako "inovátora", neboť je tvůrcem nových vědomostí nebo inovací. Inovátorovi je formou patentu uděleno výlučné právo na užívání své inovace prostřednictvím udílení licence na jeho využití jiným subjektům. Toto právo je nicméně časově omezené vzhledem k příslušné době trvání ochrany.<sup>4</sup> Držitel IPR se tak stává po dobu trvání ochrany dočasným monopolistou. Za touto koncepcí se skrývá idea, že vědomosti a inovace jsou sice veřejným statkem, ale současně je vytváření nových vědomostí spojeno s náklady, například ve formě výdajů na výzkum a vývoj.<sup>5</sup> Bez výslovné právní ochrany by jiné subjekty měly pro účely jejich komerčního využití možnost kopírovat nebo napodobovat inovace bez jakýchkoliv zábran. Mohli by je získat mnohem levněji než původní inovátor, protože by do svých kalkulací nemuseli zahrnout náklady na výzkum a

<sup>3</sup> Klasifikace kategorií je založena na konceptu WIPO – viz WIPO IntellectualProperty Handbook (2001), Policy, Law and Use. WIPO PublicationNr. 489(E), Genéve.

<sup>4</sup> Doba trvání práv duševního vlastnictví závisí na příslušné kategorii. U patentů jsou práva duševního vlastnictví obvykle 20 let.

<sup>5</sup> srov. MASKUS, K.E. (2000): IntellectualPropertyRights in theGlobalEconomy. Washington 2000., str. 27.

vývoj.<sup>6</sup> Časově omezený monopol by proto měl inovátorovi umožnit amortizovat náklady na výzkum a vývoj, které mu vznikly. Bez právní ochrany by rozvoj nových vědomostí z ekonomického hlediska pro inovátora již nebyl užitečný a v dlouhodobém horizontu by ustal. Absence tohoto právního rámce by proto měla negativní dopad na technický pokrok obecně a tím i na hospodářský růst.

## 2 Význam práv duševního vlastnictví pro mezinárodní obchod

V minulosti podléhala rozhodnutí o rozsahu IPR a jejich zákonné ochraně výlučně suverénní pravomoci jednotlivých států. Každá země mohla v této době samostatně rozhodovat o intenzitě ochrany IPR ve své vlastní zemi.

Liberalizace volného obchodu však v tomto ohledu přinášela stále větší problémy, neboť dosažením jisté úrovně liberalizace se vědomosti stávají veřejným statkem s přeshraničními dopady. To umožňuje zemím se slabší úrovní, resp. menší intenzitou ochrany IPR napodobovat a přebírat vědomosti a inovace z jiných zemí, aniž by se podílely na nákladech na výzkum a vývoj, které ve spojitosti s nimi vznikají. Stávají se uživateli veřejného statku, aniž by přispívali k jeho vytvoření (v ekonomickém žargonu jsou označováni jako tzv. *free-riders* či *Trittibrettfahrer*). Následkem takového vývoje vznikají konflikty mezi dotčenými zájmovými skupinami.

### 2.1 Zájmy průmyslových zemí

Přibližně 81 % všech celosvětových výdajů na výzkum a vývoj pochází z vyspělých zemí, i když tyto představují jen asi 21 % světové populace.<sup>7</sup> Vyspělé či industriální země mají proto velmi silný zájem na efektivních pravidlech ochrany IPR s univerzálním působením. Argumentují přitom, že pro zajištění udržitelné vysoké úrovně aktivit v oblasti výzkumu a vývoje jsou odpovídající práva na ochranu duševního vlastnictví nezbytná. Bez odpovídající právní ochrany nových vědomostí a vytvářených inovací výzkumné činnosti soukromého sektoru v dlouhodobém horizontu zaniknou. Díky vysokým standardům ochrany IPR chtějí vyspělé země zabránit tomu, aby jejich inovace napodobovali výrobci v méně vyspělých zemích, v nichž existuje nízká úroveň ochrany IPR.

### 2.2 Zájmy rozvojových zemí

Zájmy rozvojových zemí jsou ze své podstaty zcela odlišné. Díky svým dotacím zdrojů se mohou rozvojové země v celosvětovém měřítku podílen jen na velmi malé části aktivit v oblasti výzkumu a vývoje. Rozvojové země například vydávají jen asi 19% globálních investic do výzkumu a vývoje, přestože reprezentují cca. 79% světové populace.<sup>8</sup> Z těchto 19 % globálně vynakládaných investic do výzkumu a vývoje pochází většina z vyspělejších rozvojových ekonomik, tedy ze zemí, které se nacházejí na přechodu od rozvojových zemí k industriálním (příkladem lze uvést Mexiko či Čínu). Velká část méně vyspělých rozvojových zemí mnohdy není schopna inovovat sama, protože nemá k dispozici potřebné zdroje. A jsou to právě tyto zaostalejší rozvojové země, jež požadují suverenitu, pokud jde o rozsah a kontrolu právní ochrany IPR v národní úpravě, kterou si přejí udržet pokud možno na nízké úrovni. Tvrdí, že pouze nejnižší možná ochranná IPR umožní rychlé šíření vědomostí v rozvojových zemích. Od přístupu k novým vědomostem a souvisejících procesů napodobování si rozvojové země slibují možnost rozvíjet také procesy jejich osvojování a s

<sup>6</sup> Ty se také nazývají chování free-rider. K tomu srov. např. ABBOTT, F.M. (1998): The Enduring Enigma of TRIPs: A Challenge for the World Economic System. In: Journal of International Economic Law, Bd. 1/4, 1998, str. 29.

<sup>7</sup>UNESCO (2018): World expenditure on Research & Development (R&D). UNESCO Fast Facts 2018-10. Online-Quelle: [http://www.uis.unesco.org/ev.php?ID=5142\\_201&ID2=DO\\_TOPIC](http://www.uis.unesco.org/ev.php?ID=5142_201&ID2=DO_TOPIC)

<sup>8</sup>tamtéž

nimi v dlouhodobé perspektivě i rozvoj lidského kapitálu, tak aby se v určitém okamžiku mohli samy stát inovátory.<sup>9</sup> Jako příklad jsou často zmiňovány současné industriální státy Japonsko a Jižní Korea, které byly po druhé světové válce průkopníky imitace a napodobování a dnes představují přední industriální země.<sup>10</sup>

Dalším argumentem rozvojových zemí proti účinné mezinárodní ochraně IPR je možné zneužití tržní síly držitelem IPR jako dočasným monopolistou. Rozvojové země se obávají, že držitelé IPR mohou využít tohoto svého postavení a požadovat podobu trvání ochrany jejich IPR přemrštěné ceny za možnost jejich využití.

### 3 Úprava globálně pojímaných práv duševního vlastnictví v dohodě TRIPS

Deklarovaným účelem dohody TRIPS je zajistit jednotnou minimální úroveň ochrany IPR na celém světě, kterou musí všechny zúčastněné země právně garantovat. Realita implementace TRIPS vypadá tak, že na úrovni rozvojových zemí dochází k celosvětové harmonizaci norem na ochranu IPR. Před vznikem WTO v roce 1995 byla ke globální koordinaci a sladování národních úprav ochrany IPR oprávněná pouze organizace WIPO. Tato organizace však nemá žádnou sankční pravomoc a její vliv byl a nadále je relativně malý. Jednotlivé státy tak byly víceméně schopny nastavit své vnitrostátní normy k ochraně IPR jak samy chtěly.<sup>11</sup> V důsledku postupné liberalizace mezinárodního obchodu však existující pravidla úmluv spravovaných WIPO již nesplňovala požadavky industriálních zemí na zaručení ochrany IPR. Na jejich popud tak byla do rámce vytvářeného práva WTO zahrnuta rovněž dohoda TRIPS. Tato Dohoda, stejně jako všechny ostatní součásti práva WTO, podléhá takzvanému „*single package*“ přístupu. To znamená, že každý stát při přistoupení k WTO musí bez výjimky přijmout všechny dohody tvořící právo WTO a zajistit jejich implementaci a kontrolu provádění. Rozvojové země tak neměly na výběr – pokud se chtěly stát členy WTO a těžit z výhod působení jejího právního rámce, musely rovněž přijmout dohodu TRIPS a recipovat její normy do vnitrostátního práva.

Klademe-li si otázku, proč rozvojové země při schvalování balíku dohod vůbec přistoupily na zavedení dohody TRIPS v této pro ně mnohdy nevýhodné podobě, když v rámci vyjednávacích kol disponovaly jako celek silným hlasovacím právem, je nutno si uvědomit, že i když se rozvojové země skutečně stavěly proti přijetí dohody TRIPS a strukturování jejich závazků, industriální země na ně vyvíjely při prosazování svých zájmů značný tlak. Zejména USA před ratifikací dohod WTO přijímaly citelné jednostranné sankce vůči nespolupracujícím rozvojovým zemím. Hrozily zablokováním přijetí ostatních součástí balíku dohod, v nichž byla obsažena práva a závazky, přinášející rozvojovým zemím naopak značné výhody.<sup>12</sup> Mimo jiné činily rozvojovým zemím sliby, že jim bude výměnou za schválení dohody TRIPS usnadněno obchodování v sektoru zemědělství a textilu a oděvů, což pro ně bylo nesmírně důležité.<sup>13</sup> Pod tímto tlakem rozvojové země nakonec souhlasily s Dohodou TRIPS a tuto ratifikovaly jako součást balíku dohod WTO bez prosazení významnějších

<sup>9</sup> Pokud jde o vztah mezi možnostmi napodobování rozvojových zemí a jejich tempem růstu, viz CONNOLLY, M. (2003): The Dual Nature of Trade: Measuring Its Impact on Imitation and Growth. In: Journal of Development Economics. Bd. 72, 2003 zejm. str. 45 ad.

<sup>10</sup> SrovMAZZOLENI, R.; NELSON, R.R. (1998): The Benefits and Costs of Strong Patent Protection: A Contribution to the Current Debate. In: Research Policy, Bd. 27, 1998., str. 281.

<sup>11</sup> Srov. PRIMO BRAGA, C.A. (1995), Trade-Related Intellectual Property Issues: The Uruguay Round Agreements and Its Economic Implications. In: MARTIN, W.; WINTERS, L.A. (Hrsg.): The Uruguay Round and the Developing Economies. World Bank Discussion Paper Nr. 307, Washington 1995., str. 382

<sup>12</sup> Srov. ADOLF, H.(2001), Trade-Related Aspects of Intellectual Property Rights and Developing Countries. In: The Developing Economies, Bd. 39/1., str. 53 ad.

<sup>13</sup> PANAGARIYA, A.(1999), TRIPs and the WTO: An Uneasy Marriage. In: BHAGWATI, J. (vyd.): The Next Trade Negotiating Round: Examining the Agenda for Seattle. Proceedings of the Conference held at Columbia University July 23 & 24, str. 92ad..

změn. Rozvojovým zemím, a zejména pak nejméně rozvinutým zemím (LDC), však bylo k implementaci pravidel TRIPS poskytnuto mimořádně dlouhé přechodné období – v délce trvání až deseti let. Následně poté bylo pro všechny členy LDC toto „adaptační“ období ještě dvakrát prodlouženo v reakci na jejich vlastní žádost.<sup>14</sup>

Odpůrci dohody TRIPS však stále trvají na tom, že industriální země sledují jejím prováděním zejména protekcionistické zájmy vůči rozvojovým zemím.<sup>15</sup>

### 3.1 Posouzení dohody TRIPS z regulačně politického hlediska

Cílem dohody TRIPS je dosažení celosvětové harmonizace ochrany IPR. Celkově vzato lze takovou harmonizaci uskutečnit dvěma způsoby: na jedné straně může být podřízena vlivům trhu, na druhé straně politickým vlivům.

V případě vlivu trhu je ponecháno na působení trhu, aby ovlivnilo započetí harmonizačních procesů a určilo tempo jejich provádění.<sup>16</sup> V souvislosti s IPR by bylo možné si představit, že rozvojové země s pomalým stupněm inovací by zpočátku zakotvily ve svém národním právu velmi nízkou úroveň ochrany IPR s cílem vytvořit v dlouhodobém horizontu lidský kapitál při využití imitace či napodobování a s tím a souvisejících procesů osvojení vědomostí. Časem se zvýší inovační schopnost těchto zemí, stejně jako potřeba přísnější, tj. restriktivnější ochrany IPR v národním právu. Tímto způsobem, tj. působením tržních sil, by tak bylo možné postupně směřovat k celosvětové harmonizaci IPR.

Druhá cesta je cestou harmonizace prostřednictvím politického působení. Zde je cílové řešení pro všechny účastníky definováno "shora" ve formě nařízení či zákonů, aniž by byly detailně zohledněny jednotlivé národní preference. Nedochází tedy k postupnému sbližování na základě národních preferencí, ale k jednorázové unifikaci IPR na základě právních předpisů.<sup>17</sup> Takovou formu harmonizace představuje i dohoda TRIPS.

Otázkou nyní je, jaký postup je vhodné preferovat z hlediska politického uspořádání. V tomto ohledu lze nejprve konstatovat, že cesta působení trhu je obecně efektivnější, neboť vychází z volby příslušných participujících stran a vede tak k maximalizaci prospěchu. Naproti tomu politicky determinované řešení je často založeno na mimotržních zájmecích jednotlivých aktérů a na asymetrickém rozdělení moci a informací mezi subjekty, jež jsou nositelem rozhodovacích pravomocí. Tyto okolnosti vedou ke ztrátě prosperity následkem neefektivních rozhodnutí ve srovnání s tržně determinovaným rozhodnutím. Existují však situace, kdy tržně determinovaným rozhodováním nelze dosáhnout optimálních výsledků. Je tomu tak vždy tehdy, pokud existuje nějaká forma selhání trhu. Mezi tři formy selhání trhu patří tržní síla (monopoly), externality a veřejné statky.<sup>18</sup> V námi analyzované situaci představují vědomosti veřejný statek působící vně hranic státu. Pokud by se v takovém případě ponechalo formování IPR v jednotlivých zemích na působení trhu, docházelo by k efektu chování „volného jezdce“ (*free rider*): země s nízkou mírou inovací, s největší pravděpodobností rozvojové země, by záměrně udržovaly ochranu IPR v dlouhodobém

<sup>14</sup> Rada TRIPS ve svém rozhodnutí ze dne 29. listopadu 2005 prodloužila lhůtu do 1. července 2013 a dne 11. června 2013 toto období dále prodloužila do 1. července 2021 – vyjma pokud určitá země přestane být v kategorii LDC před koncem roku 2021.(viz [https://www.wto.org/english/tratop\\_e/trips\\_e/ldc\\_e.htm](https://www.wto.org/english/tratop_e/trips_e/ldc_e.htm))

<sup>15</sup> Mezi hlavní kritiky dohody TRIPS stále patří mnoho nevládních organizací (NGO's), jako je ATTAC(*Association pour une Taxation des Transactions financières pour l'Aide aux Citoyens*). Ekonomové jako SOROS však také kritizují práva duševního vlastnictví jako "překážku obchodu",(srov.SOROS, G.(2013), Der Globalisierungs-Report. Weltwirtschaft auf dem Prüfstand. Reinbek bei Hamburg, 2003, str. 55).

<sup>16</sup> K tomušrov. LUCKENBACH,H (1997).,Theoretische Grundlagen der Wirtschaftspolitik. Franz Vahlen Verlag,str. 222f

<sup>17</sup> ACOCELLA, N., Di BARTOLOMEO, G.,HALLET, A.H.(2012), The Theory of Economic Policy in a Strategic Context ., Cambridge University Press, str. 222.

<sup>18</sup> Ke třem formám tržního selhání viz např. MUSGRAVE, R.A.,MUSGRAVE, P.B (1989): Public Finance in Theory and Practice, McGraw-Hill College; 5<sup>th</sup> ed., str. 7ad.

horizontu na nízké úrovni, aby mohly bezplatně využívat a přebírat inovace ze zemí vyspělých. Vzhledem k fenoménu *free rider* proto nelze předpokládat, že tyto země postupně zvýší úroveň ochrany IPR, tak jak jsme předpokládali výše. Nepřispívají proto na náklady poskytování nových vědomostí jako veřejného statku, nezbytných zejména ve formě úhrady výdajů na výzkum a vývoj. V důsledku toho by nebyla, v dlouhodobé perspektivě, ani v industriálních zemích podporována ze strany podnikatelského sektoru nabídka veřejných statků ve formě nových vědomostí nebo inovací. Problémy s veřejnými statky by vedly k úplnému zhroucení alokační funkce trhu, z finančních důvodů by z privátního sektoru nebyly poskytovány žádné nové poznatky.<sup>19</sup>

Proto musí být provedení harmonizace ochrany IPR vlivem působení trhu, často požadované rozvojovými zeměmi, odmítnut oz důvodů politického uspořádání mezinárodního společenství. Trh zde není schopen efektivně zajistit vyvážené řešení. Nic na tom nemění ani zdánlivě úspěšné příklady zemí, jako je Japonsko nebo Jižní Korea, které ve své době tuto strategii přebíráni imitací prosazovaly. Přechod těchto zemí mezi industriální státy proběhnul z velké části na úkor tehdejších vyspělých zemí, jejichž inovace byly přebírány a imitovány. Je však třeba také poznamenat, že za situace odstranění jedné formy selhání trhu prosazením politického řešení, dojde k vytvoření formy nové: prostřednictvím politicky determinované harmonizace získává příslušný držitel IPR dočasné monopolní postavení. Problém veřejných statků tímto způsobem sice byl odstraněn, avšak zároveň vede ke vzniku tržní síly s přeshraničními dopady. Nicméně pokud porovnáme důsledky obou těchto selhání trhu, můžeme vidět, že veřejné statky pravidelně vedou k úplnému zhroucení trhu, což znamená, že již nedochází k nabídce těchto statků z privátního sektoru, zatímco tržní síla narušuje pouze alokační funkci trhu v důsledku zkreslených cen. Trh však zůstává nadále vhodný jako koordinační nástroj.<sup>20</sup> Rovněž je třeba mít na paměti, že tržní síla je obvykle pouze dočasná, časově omezená dobou trvání ochrany IPR. Můžeme tedy uzavřít, že dohodu TRIPS musíme z regulačně politického hlediska považovat za principiálně akceptovatelnou. Politicky determinovaná harmonizace je v dlouhodobém horizontu nezbytná k zajištění podnikatelských investic v oblasti výzkumu a vývoje. Proti tomu postavené názory, argumentující proti dohodě TRIPS jako čistě protekcionistickému nástroji, lze z regulačně politického hlediska přesvědčivě vyvrátit.

### 3.2 Oblasti potřebných změn dohody TRIPS

Ačkoli je možné dohodu TRIPS z regulačně politického hlediska podpořit, nelze zpochybnit, že se v některých jejích formulacích či ustanoveních projevují významné protekcionistické tendence. Ty však nevyplývají z účelu Dohody jako takové, nýbrž z jejího strukturování. Při formulování jednotlivých ustanovení byly zohledněny téměř výhradně zájmy vyspělých industriálních zemí.

Na základě zhodnocení realizace záměrů dohody TRIPS je možno vymezit tři oblasti, v nichž se reforma Dohody jeví jako žádoucí či dokonce nezbytná k tomu, aby se zajistila její dlouhodobá stabilita a větší míra akceptace ze strany rozvojových zemí.<sup>21</sup>

- a) Dostupnost základních léků v rozvojových zemích
- b) IPR ve vztahu ke genetickým zdrojům
- c) IPR k tradičním vědomostem

#### *Ad a) Dostupnost základních léků rozvojových zemích:*

Jedná se v současné době o nejnaléhavější problematickou oblast, v níž však bylo od uzavření dohody TRIP na druhé straně dosaženo nejvýznamnějšího pokroku. U esenciálních

<sup>19</sup>Tamtéž, s. 75

<sup>20</sup>Srov. LUCKENBACH, H., op.cit. in 16, str. 168

<sup>21</sup> STOLL, P.-T.; SCHORKOPF, F.( 2012.): WTO – Welthandelsordnung und Welthandelsrecht. Köln - Berlin - Bonn - München, s. 223 ad.

léků se odráží již zmíněný problém tržní síly, kterým jsou v důsledku globální unifikace patentových pravidel postiženy rozvojové země. Držitelé patentů na potřebné léky (např. proti AIDS nebo antimalarika)mohou v důsledku své tržní síly požadovat monopolistické ceny léků, které rozvojové země nejsou schopny zaplatit. Pro zajištění své národní zdravotní péče požadují rozvojové země volný nebo s garantovanými slevami umožněný přístup k lékům, které nutně potřebují. K dosažení tohoto cíle existují principiálně tři možná řešení<sup>22</sup>:

1. Dodavatelé příslušných léků budou provádět **cenovou diferenciaci**. V rozvojových zemích bude v tomto případě za léky účtována mnohem nižší cena než v zemích vyspělých. Tímto způsobem bude zachována patentová ochrana a náklady na výzkum a vývoj budou z velké části pokryty příjmy z prodeje léků ve vyspělých zemích.
2. Rozvojovým zemím bude poskytnuta **nucené licence**, která je budou opravňovat napodobovat patentově chráněný lék pro vlastní potřeby. Od držitele patentu k tomu není požadováno výslovné povolení.
3. Pokud nejméně rozvinuté země ani nejsou schopné vyrábět zmíněné napodobeniny (tzv. generika) samy, stále existuje možnost **paralelních dovozů**. To znamená, že jsou léky vyráběny ve třetí zemi a poté vyváženy do dotčených zemí. Toto je také možné bez formálního souhlasu majitele patentu.

Zhodnotit dopady cenové diferenciace je poměrně obtížné. Na jedné straně je tento postup zcela v rozporu s článkem 4 dohody TRIPS (doložka nejvyšších výhod), v němž se uvádí, že jakákoli výhoda či právo přednosti přiznané členským státem občanům kterékoli jiné země, bude přiznána ihned a bezpodmínečně občanům všech ostatních členských zemí WTO. Kromě toho se praktické uplatňování strategie diferenciace cen jeví jako velmi obtížné, a tudíž i otázka její proveditelnosti zůstává spornou.

Další dvě cesty se zdají být schůdnější. Články 30 a 31 dohody TRIPS stanoví za určitých podmínek výjimky z udělených práv patentové ochrany. Problém je však v tom, že formulace, zejména v případě článku 30, jsou dosti obecné a na základě toho je možné je vykládat široce: „*Clenovémohouposkytovatvýjimkyvýlučnýchprávudělenýchpatentemzapředpokladu, že akovévýjimky nebudou nepřiměřeně v rozporu s běžným využíváním patentu a že nebudou nepřiměřeně na úkor oprávněných zájmů majitele patentu s tím, že bude brán zřetel na oprávněné zájmy třetích stran.*“<sup>23</sup>

S ohledem na možnosti interpretace tohoto ustanovení se vyspělé země v praxi snažily vykládat jeho obsah ve svůj prospěch a omezit poskytování nucených licencí všeobecně. Výsledkem byly vleklé konflikty mezi rozvojovými a vyspělými zeměmi, k nimž docházelo, ale i výklad článku 30 v tom smyslu, že nucená licence je v rozvojových zemích pro základní léky přípustná, s sebou přináší významné problémy. Zejména nejméně rozvinuté země, které nemají možnost vyrábět léky na základě získání nucené licence samy, by byly závislé na paralelních dovozech. A ty jsou v zásadě zakázány článkem 31 dohody TRIPS, pokud k nim držitel patentu neudělí souhlas. Takže i když nejméně rozvinuté země mají nucenou licenci, nepomůže jim to, pokud nebudou moci vyrábět léky samy.<sup>24</sup> Zakotvení pravidla, připouštějící v takovém případě výjimky, je však zejména pro tyto země mimořádně důležité.

Rozvojové země doufaly, že celý problém vyřeší v souvislosti s kolem jednání WTO zahájeným v Dohá roku 2001. Problém byl zde sice nanesen a definován, ale nebyl vyřešen

<sup>22</sup>BEYER P. (2013). :Developing socially responsible intellectual property licensing policies: non-exclusive licensing initiatives in the pharmaceutical sector. In: de Werra J, editor. Research handbook on intellectual property licensing. Cheltenham: Edward Elgar; str. 227 ad.

<sup>23</sup>Český překlad čl. 30 TRIPS viz online <https://cppt.cuni.cz/CPPTN-287-version1-trips.pdf>

<sup>24</sup>Srov. FORD, S.M.(2000), Compulsory Licensing Provisions Under theTRIPs Agreement: Balancing Pills and Patents, American University International Law Review., Volume 15, Issue 4, Article 5 [https://digitalcommons.wcl.american.edu/cgi/viewcontent.cgi?article=1278&context=aulr&httpsredir=1&refere\\_r=](https://digitalcommons.wcl.american.edu/cgi/viewcontent.cgi?article=1278&context=aulr&httpsredir=1&refere_r=)

do konce. Vzhledem k rostoucím masovým veřejným protestům proti chování vyspělých zemí přijala Generální rada WTO dne 20.08.2003 dlouho požadované rozhodnutí zaměřené na zlepšení stavu méně rozvinutých zemí.<sup>25</sup> Rozhodnutí výslově umožňuje za určitých podmínek potřebné paralelní dovozy a roku 2005 bylo formálně začleněno jako změna dohody TRIPS. Teprve roku 2017, po získání souhlasu dvoutřetinové většiny všech členů WTO, se však stalo formální součástí článku 31 Dohody.<sup>26</sup> Mezitím však opět nabyla na hlasitosti kritika upozorňující na skutečnost, že zmíněné podmínky jsou velmi složité a s nimi související postup je poměrně těžkopádný. Například rozvojové země musí předem určit, jaké množství léku potřebují, a jsou povinné dodržovat řadu formalit. Držiteli patentu musí být navíc poskytnuta přiměřená náhrada. Kritici proto tvrdí, že situace je nyní horší než dříve, protože mnoho rozvojových zemí není schopno tyto požadavky administrativně splnit.<sup>27</sup>

Zda se přijaté řešení ukáže jako vhodné, se projeví teprve tehdy, až vyprší poslední přechodné období pro nejméně rozvinuté země. V každém případě po letech patové situace byl v této oblasti přijat velmi důležitý krok správným směrem, což jistě významně přispívá ke stabilizaci dohody TRIPS i samotné WTO.

#### ***ad b) IPR ve vztahu ke genetickým zdrojům:***

Problematika genových patentů byla vyvolána speciální úpravou genetických zdrojů v dohodě TRIPS. Obecně jsou existující přírodní zdroje vyloučeny z patentovatelnosti, což platí zejména pro odrůdy rostlin a živočišné druhy. Geny, resp. genové sekvence, však mají zvláštní postavení, tím že podle dohody TRIPS patentovatelné jsou.<sup>28</sup> To je nicméně v rozporu s Úmluvou o biologické rozmanitosti (CBD).<sup>29</sup> Tato úmluva, na rozdíl od dohody TRIPS, potvrzuje svrchované právo států k jejich vlastním genetickým zdrojům.<sup>30</sup> Dohoda TRIPS však tuto úmluvu obchází a v čl. 27 odst. 3 (b) patentovatelnost genetických sekvencí připouští. Rozvojové země, které nejsou schopny provádět vlastní genetický výzkum, se na případném budoucím komerčním využívání vlastních genetických zdrojů nebudou moci podílet. To platí zejména pro státy v tropických oblastech, kde nalezneme extrémně vysokou biologickou diverzitu. Společnosti z vyspělých zemí si mohou tyto zdroje patentovat, což znamená, že skuteční vlastníci, jimiž jsou rozvojové země, o všechna zákonné práva příjdou. Tato situace odporuje právnímu vnímání mnoha rozvojových zemí, které se považují za "přirozené" majitele genetických zdrojů. Na druhé straně je třeba mít na paměti, že bez patentové ochrany by výzkumné úspěchy v této oblasti pravděpodobně nebyly reálné, protože samotné rozvojové země obvykle nejsou schopny výzkumu v této oblasti samy realizovat.

Rada TRIPS si je vědoma těchto problémů a v tomto smyslu i probíhají diskuse. Zatím však nebyla definována potřeba jednat o rozšíření pravidel TRIPS a tyto změny nejsou v současné době ani považovány za aktuální.<sup>31</sup> Je však třeba poznamenat, že v praxi uskutečnitelné a přijatelné řešení se jeví pro všechny zúčastněné strany poměrně obtížné. Jako možné řešení si je možné představit, že by "přirození" vlastníci mohli být zapojeni přinejmenším do obchodních přínosů z využívání svých genetických zdrojů prostřednictvím

<sup>25</sup>viz.WTO 2020 - online [https://www.wto.org/english/tratop\\_e/trips\\_e/factsheet\\_pharm02\\_e.htm](https://www.wto.org/english/tratop_e/trips_e/factsheet_pharm02_e.htm) .

<sup>26</sup>Viz WTO 2020, online [https://www.wto.org/english/tratop\\_e/trips\\_e/public\\_health\\_e.htm](https://www.wto.org/english/tratop_e/trips_e/public_health_e.htm)

<sup>27</sup>Podrobnosti o procesních pravidlech viz BEYER, A., op. Cit. V pozn. 22, s. 59

<sup>28</sup>Unter genetische Ressourcen ist hierbei biologisches Material zu verstehen, das Erbinformationen enthält. Vgl. Art. 27 odst. 3 (b)

<sup>29</sup>Úmluva o biologické rozmanitosti (CBD) byla přijata v roce 1992 na konferenci OSN o životním prostředí a rozvoji v Riu de Janeiru a podepsána 157 zeměmi

<sup>30</sup>Srov. Čl. 15 CBD – český překlad online <http://chm.nature.cz/umluva-o-biologicke-rozmanitosti-cbd/o-umluve-cbd/>

<sup>31</sup> WTO(2018), The Relationship Between the TRIPs Agreement and the Convention on Biological Diversity. WTO-Dокумент IP/C/W/368, 08. August

vhodné úpravy v dohodě TRIPS, a to podle definovaného klíče. Za tímto účelem by žadatel o patentování genetické sekvence musel prokázat, odkud příslušný materiál pochází.<sup>32</sup>

### ***ad c) IPR k tradičním vědomostem***

Tato oblast je mnohem abstraktnější, než předcházející dva problémy. Jedná se o tradiční vědomosti a tradiční životní styl některých skupin obyvatelstva. Obyvatelstvo z méně vyspělých zemí má často hluboké vědomosti o udržitelném využívání stávajících zdrojů, což může být důležité zejména pro biotechnologie (známé jako "*learning by nature*"). Podle úmluvy CBD by držitelé tradičních vědomostí měli mít právo na úplatný převod těchto vědomostí. Ostatním zájmovým skupinám, jako jsou např. výzkumní pracovníci z vyspělých zemí, by nemělo být dovoleno bez dalšího čerpat z těchto vědomostí a i zde by se mělo rozvojovým zemím umožnit podílet se na případném profitu z komerčního využívání.<sup>33</sup>

Tato oblast není v dohodě TRIPS dosud zohledněna, ale pro ochranu zájmů rozvojových zemí by vhodná právní ochrana byla namísto. Rada TRIPS i v této oblasti zahájila diskuse, ale nedospěla k žádnému konkrétnímu závěru.<sup>34</sup> Důvodem je fakt, že tuto oblast je obtížné zahrnout do některé ze stávajících kategorií IPR, protože možná práva nakládat s nimi by musela být zařazena na pomezí autorských práv a patentů, když nemohou být ani do jednoho z nich zařazena jednoznačně.

## **Závěry**

Z provedené analýzy vyplynulo, že i když dohoda TRIPS musí být z regulačně politického hlediska jako celek podpořena, vykazuje v parciálních oblastech jisté protekcionistické tendence ve prospěch vyspělých zemí a na úkor zemí rozvojových, jež jsou tímto znevýhodněny. V oblasti dostupnosti esenciálních léků již byly uskutečněny některé potřebné změny. Další dvě zkoumané oblasti žádoucích změn dosud nebyly do ustanovení dohody TRIPS zahrnuty.

Rozvojové země proto na jedné straně naléhají na to, aby stávající dohoda TRIPS zaslabila svá protekcionistická ustanovení ve vztahu k vyspělým zemím a více se adaptovala k oprávněným zájmům zemí rozvojových. Zejména je žádoucí do této adaptace zahrnout tři výše uvedené oblasti ustanovení. Na druhé straně rozvojové země současně usilují o provádění liberalizace, která jim byla v návaznosti na akceptaci TRIPS jako součásti balíku dohod WTO přislíbena v oblasti obchodu se zbožím, zejména v sektorech zemědělství a textilu. Pokud nedojde ke sblížení zájmů vyspělých zemí s potřebami zemí rozvojových, mohlo by to v dlouhodobé perspektivě ohrozit stabilitu dohody TRIPS jako celku, a tím i samotné WTO.

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<sup>34</sup>Viz WTO: IP/C/W/370 – dostupné online [https://www.wto.org/english/tratop\\_e/trips\\_e/ta\\_docs\\_e/W370.pdf](https://www.wto.org/english/tratop_e/trips_e/ta_docs_e/W370.pdf)

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# DEVELOPMENT OF COWORKING CENTERS IN THE REGIONS OF SLOVAKIA

## ROZVOJ COWORKINGOVÝCH CENTIER V REGIÓNOCH SLOVENSKA

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### Abstract

Coworking is one of the most modern ways of sharing office space for small businesses in the world. The increasing trend of using such space is also noticeable in Slovakia. The aim of the work is to map and compare public and private coworking centers at the level of NUTS 2 regions and to identify similarities and differences between coworking centers in Slovakia. Most coworkings in Slovakia are operated with the legal form of a private company and thus the operation of coworking serves the operator to generate a profit. The mapping of coworking spaces with a sample of 39 entities shows that the average rental price for a fixed place ranges from € 99 to € 198 per month and various coworkings offer separate meetings, events or advice. This amount can mean significant start-up savings for a small business. A total of 39 entities provide up to 20,377m<sup>2</sup> of shared workspace in Slovakia. The results of the comparison of coworkings in Slovakia show that on average is paid more for a place in private coworkings than in public ones. The higher fee for a place in coworkings with the legal form of a private company is associated with a higher share of benefits and services provided to its members.

### Keywords

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Coworking, Small and medium enterprises, Shared economy, Freelancing and Open space

### Introduction

Podľa internetovej encyklopédie Wikipedia (2021) a Deskmag (2010) predstavuje coworking štýl práce a podnikania vo flexibilnom kancelárskom prostredí zdieľanom s ďalšími nezávislými pracovníkmi. Je to taktiež komunita nezávisle pracujúcich ľudí, ktorým spoločné priestory umožňujú zdieľať hodnoty, skúsenosti, nápady a profitovať zo synergického efektu, ktorý prináša sústredenie talentovaných pracovníkov na jednom mieste. To znamená, že nepracujú na jednom jedinom projekte alebo v jednej firme. Skôr naopak, ide o samostatné osobnosti, ktoré by inak pracovali z domu alebo ľudí, ktorí sú často na cestách a potrebujú priestor len dočasne“ (Tomek, 2014). Koncept a hlavná myšlienka coworkingu je jednoduchá, keďže iba reagoval na potreby ľudí, ktorí chceli podnikať, ale nemali dostatok prostriedkov na vlastný pracovný priestor. Takisto pomohol ľuďom, ktorí už doma pracovali, ale nemohli sa v tomto prostredí sústredit' alebo im chýbal sociálny kontakt. Môžeme ho tiež definovať ako systém práce, pri ktorom si miesto v spoločnom priestore prenajímajú jednotlivci pracujúci sami pre seba – grafici, freelanceri, programátori, malé startupy, ľudia pracujúci na diaľku. Využívajú spoločné technické vybavenie poskytované prevádzkovateľom coworkingu a tvoria komunitu, v rámci ktorej funguje výmena nápadov a vzájomná podpora. Cieľom príspevku je zmapovať a preskúmať vývoj coworkingových centier na Slovensku. Na naplnenie hlavného cieľa práce sme sa bližšie zamerali na nasledovné parciálne ciele: (i) zmapovať a komparovať verejné coworkingové centra na

úrovni NUTS 2 regiónov; (ii) identifikovať zhody a rozdiely medzi coworkingovými centrami na Slovensk a (iii) komparovať fungovanie a poskytovanie benefitov coworkingových centier podľa ich právnej formy.

## Material a metódy

V súčasnosti neexistuje jednotná metodika kategorizácie a hodnotenia coworkingov podobne ako je to pri hodnotení hotelov, reštaurácií a podobne. Zaviedli sme preto vlastné hodnotenie, ktoré reflektovalo získané vedomosti a skúsenosti. Hodnotenie sa zakladá na kvantitatívnych parametroch. Pri mapovaní coworkingových centier na Slovensku sme sa zamerali na verejné a súkromné coworkingy a neuvádzame tie, ktoré sú prevádzkované ako časť firemného pracoviska alebo univerzity. Celkové zmapovanie coworkingov sa realizovalo na úrovni regiónov NUTS 2 za Východné Slovensko, Stredné Slovensko, Západné Slovensko a v hlavnom meste Bratislava.

Medzi hlavné parametre porovnania sme zahrnuli prevádzkovú plochu coworkingu, cenu za fixný stôl, ponúkané benefity a služby ako:

- Neobmedzený prístup – možnosť využívať priestory coworkingu 24/7.
- Zasadačka – miestnosť, kde je možné vodiť si návštevy, stretnávať sa s klientom,
- „Telefonovačka“ – izolovaná miestnosť s možnosťou viest' telefonické či video rozhovory,
- Eventy – organizovanie stretnutí, prednášok, či workshopov,
- Vlastné zázemie – týmto označením uvádzame súhrn benefitov ako „vlastná skrinka“, či osobný priestor pre subjekty.
- Poradenstvo

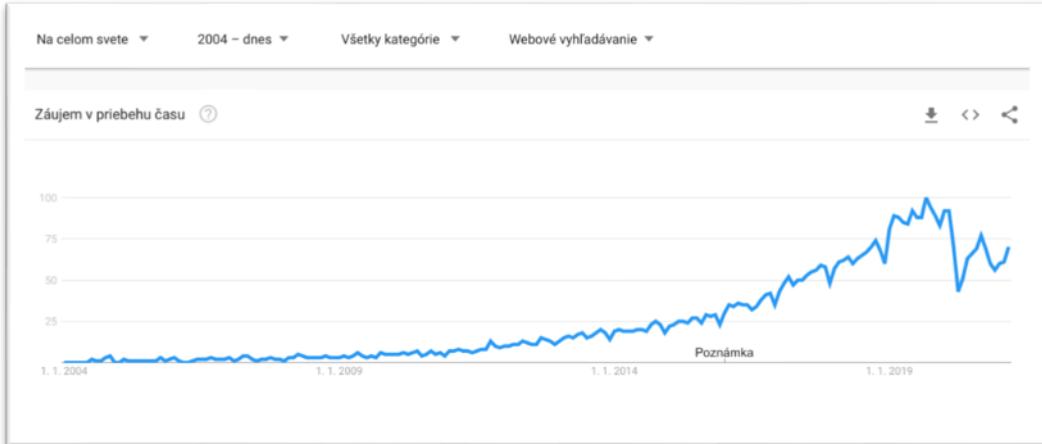
Benefity vo forme internetu a „Wifi siete“, tlačiarne, či kuchynky neuvádzame, pretože považujeme pripojenie na internet či možnosť vytlačenia dokumentu ako štandard nie ako benefitom. Treba však podotknúť, že ak by si mal samostatný podnikateľ prenajať vlastnú kanceláriu, zriadenie týchto štandardných vecí by tvorilo významné náklady či už na mesačnej báze (poplatky za internet), alebo ako fixné vstupné náklady začiatí podnikania (zriadenie kancelárie, tlačiareň, kuchynka, mikrovlnka, kávovar a pod.).

V mapovaní uvádzame cenu za fixný stôl. Predpokladáme, že coworking slúži malým podnikateľom ako alternatíva prenájmu a kúpy vlastnej kancelárie. Z parametrov boli vyňaté typy čiastočného prenájmu. Porovnanie poskytovaných benefitov a cien pre malých podnikateľov bolo realizované aj podľa právnej formy coworkingu.

## Výsledky a diskusia

Coworkingové priestory sa v ich súčasnej podobe zrodili po globálnej finančnej kríze a slúžili aj ako domov pre „nadbytočných“ podnikateľov. Neboli to však start-upy a freelanceri, ktorí hnalí globálny sektor flexibilného priestoru k medziročnému rastu o 31 percent medzi rokmi 2015 a 2019. Podniky sa začali sťahovať do flexibilných priestorov spočiatku preto, aby profitovali z horúčkovitej výmeny nápadov, a potom v oveľa väčšom rozsahu začali ťažiť z krátkodobých prenájmov a bezproblémových priestorov v rámci modelu coworkingových služieb (Puckett, 2021).

Obrázok 1: Vyhľadávanie coworkingu ako témy vo svete



Zdroj: <https://trends.google.com>, vlastné spracovanie

Tento boom spomalila v roku 2020 pandémia COVID-19 a spôsobila obrovský pokles využívania coworkingu. Ako dôkaz poklesu záujmu nám môže poslúžiť globálne vyhľadávanie pojmu coworking ako témy v Google za obdobie od roku 2004. Tam vidíme značný pokles vo svete, najviac klesajúca časť je obdobie február-marec 2020 (obrázok 1), a taktiež aj na Slovensku (obrázok 2), kde vyhľadávanie kleslo na začiatku pandémie na úplné minimum.

Obrázok 2: Vyhľadávanie coworkingu ako témy na Slovensku



Zdroj: <https://trends.google.com>, vlastné spracovanie, 2021

Aj keď protipandemické opatrenia spôsobili obrovský pokles využívania coworkingových priestorov, očakáva sa, že bude v blízkej budúcnosti nadálej prosperovať. Vo svete post-COVID sa očakáva, že dopyt po coworkingových priestoroch vzrastie, pretože veľa spoločností sa presunie do vzdialeného pracovného prostredia. Predpokladá sa teda, že veľké percento používateľov budú veľké korporácie a spoločnosti, ktoré chcú fragmentovať svoju obrovskú pracovnú silu do vzdialených tímov, ktoré budú môcť ľahko ovládať (Catalano, 2020). Značný vplyv na prosperitu bude mať aj zmena návykov zamestnancov, ktorú vyvolali nútené home-office ale i prispôsobenie interných procesov spoločností práve presunom základných pracovných nástrojov do cloudu.

## 1 Coworkingy v Bratislave

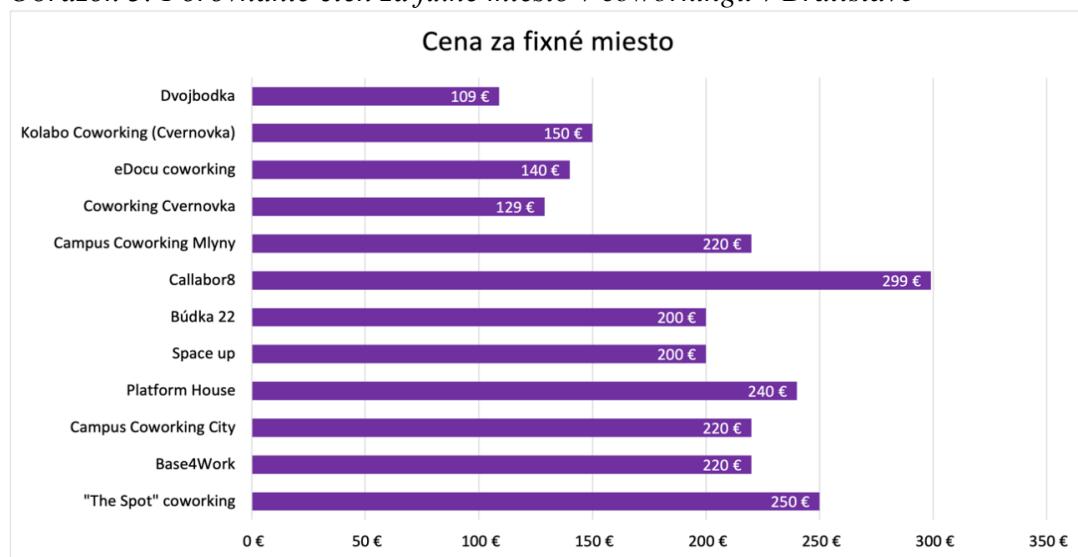
V meste Bratislava sme zmapovali 12 coworkingov, kde najväčším „The Spot Coworking“ ktorý disponuje 4200m<sup>2</sup> priestoru, kaviarňou, fitness zariadením a 39 zasadačkami. Priemerná plocha jedného coworkingu v Bratislave je 1247m<sup>2</sup>. Najdrahším coworkingom je Collabor8, ktorý poskytuje svoj priestor za 299€ mesačne. Priemerná cena za fixné miesto je 198€ mesačne. Najmenším coworkingom je „Dvojbodka“ na 90m<sup>2</sup> priestoru. Tá je zároveň aj najlacnejším coworkingom v Bratislave.

*Tabuľka 1: Prehľad coworkingov v Bratislave*

Bratislava	Názov	Mesto	Cena za fixné miesto	Plocha	Občianske združenie	Súkromné vlastníctvo	Neobmedzený prístup	Zasadačka	Telefonovačka	Events	Vlastné zážemie	Poradenstvo
					A	A	A	A	A	A	A	N
	„The Spot“ coworking	Bratislava	250 €	4 200m <sup>2</sup>								
	Base4Work	Bratislava	220 €	3 500m <sup>2</sup>			A	A	A	A	A	A
	Campus Coworking City	Bratislava	220 €	1 295m <sup>2</sup>			A	A	A	A	A	A
	Platform House	Bratislava	240 €	1 200m <sup>2</sup>			A	N	A	N	A	N
	Space up	Bratislava	200 €	1 100m <sup>2</sup>			A	A	A	A	A	N
	Búdka 22	Bratislava	200 €	1 000m <sup>2</sup>			A	A	A	A	A	N
	Collabor8	Bratislava	299 €	900m <sup>2</sup>			A	A	A	N	N	N
	Campus Coworking Mlyny	Bratislava	220 €	663m <sup>2</sup>			A	A	A	A	A	A
	Coworking Cvernovka	Bratislava	129 €	420m <sup>2</sup>	A		A	A	A	A	N	N
	eDocu coworking	Bratislava	140 €	398m <sup>2</sup>			A	A	A	N	N	N
	Kolabo Coworking (Cvernovka)	Bratislava	150 €	200m <sup>2</sup>	A		A	N	A	A	A	N
	Dvojbodka	Bratislava	109 €	90m <sup>2</sup>			A	A	A	N	N	N
	Priemer/Počet		198 €	1 247m <sup>2</sup>	3	11	10	12	8	9	7	3

Zdroj: Vlastné spracovanie, 2021

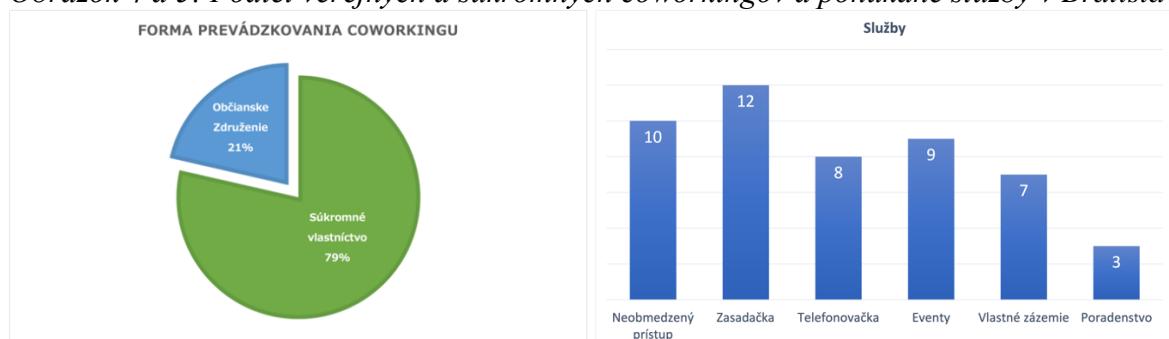
*Obrázok 3: Porovnanie cien za fixné miesto v coworkingu v Bratislave*



Zdroj: Vlastné spracovanie, 2021

V Bratislave je najviac coworkingov v súkromnom vlastníctve a teda jednotliví prevádzkovatelia prevádzkujú coworking za účelom zisku. Dva z nich, Kolabo Coworking a Coworking Cvernovka prevádzkujú hybridný model a fungujú ako občianske združenie aj ako spol. s ručením obmedzeným.

Obrázok 4 a 5: Podiel verejných a súkromných coworkingov a ponúkané služby v Bratislave



Zdroj: Vlastné spracovanie, 2021

Všetky coworkingy v Bratislave poskytujú zasadáčku, 10 z 12tich aj neobmedzený prístup. Podľa telefonických vyjadrení prevádzkovateľov zvyšných dvoch ide o obmedzenie času ktoré vyplýva z toho, že sú umiestnené vo veľkých obchodných centrach (Avion shopping center), či v priestoroch ktoré majú iné všeobecné pravidlá. Medzi ďalšie poskytované benefity patria eventy, telefonovačka a vlastné zázemie. Poradenstvo pre podnikateľov poskytujú 3 z nich.

## 2 Coworkingy na západnom Slovensku

Na západnom Slovensku sme zmapovali 9 coworkingov, najväčším je „Steel tower“ v Leviciach s rozlohou 260m<sup>2</sup> a najmenším je Coworking FSH v Trenčíne s rozlohou 40m<sup>2</sup>. Priemerná procha je 142m<sup>2</sup>.

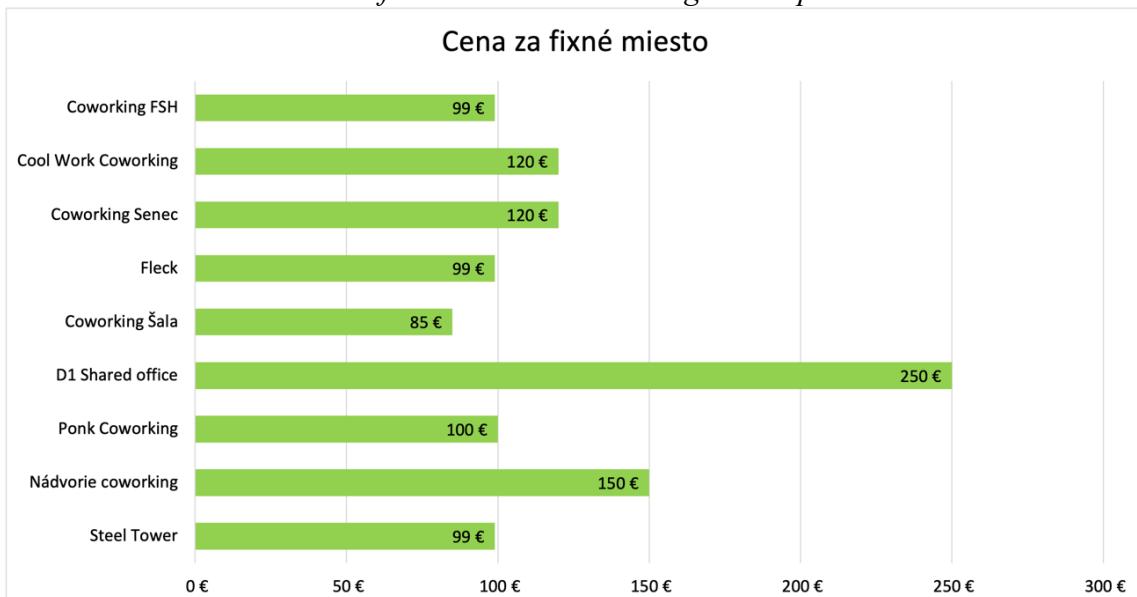
Tabuľka 2: Prehľad coworkingov na Západnom Slovensku

Západné Slovensko	Názov	Mesto	Cena za fixné miesto	Plocha	Občianske združenie	Súkromné vlastníctvo	Neobmedzený prístup	Zasadačka	Telefonovačka	Eventy	Vlastné zázemie	Poradenstvo
	Steel Tower	Levice	99 €	260m <sup>2</sup>		A	N	N	A	N	N	N
	Nádvorie coworking	Trnava	150 €	251m <sup>2</sup>	A		A	A	N	A	A	N
	Ponk Coworking	Nitra	100 €	200m <sup>2</sup>	A		A	A	N	A	A	A
	D1 Shared office	Senec	250 €	168m <sup>2</sup>		A	N	A	A	N	N	N
	Coworking Šala	Šaľa	85 €	160m <sup>2</sup>	A		A	A	N	A	N	N
	Fleck	Trenčín	99 €	100m <sup>2</sup>	A		A	A	A	A	N	N
	Coworking Senec	Senec	120 €	50m <sup>2</sup>		A	N	N	N	N	N	N
	Cool Work Coworking	Komárno	120 €	50m <sup>2</sup>		A	N	N	N	N	N	N
	Coworking FSH	Trenčín	99 €	40m <sup>2</sup>		A	N	A	N	N	A	N
	Priemer/Počet		125 €	142m <sup>2</sup>	4	5	4	6	3	4	3	1

Zdroj: Vlastné spracovanie, 2021

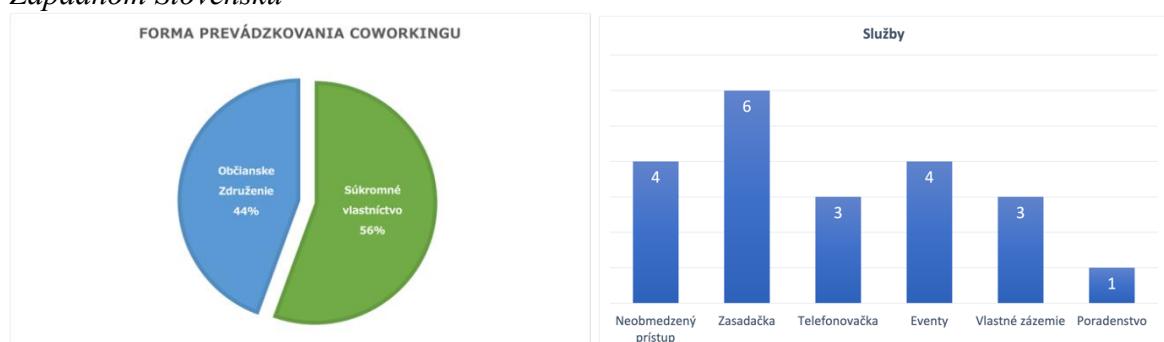
Najdrahším coworkingom je „D1 Shared office“ so sumou 250€/mesačne a najlacnejší mesačný poplatok je v Coworkingu Šaľa za 85€/mesiac. Priemerná cena je 125€/mesiac.

Obrázok 6: Porovnanie cien za fixné miesto v coworkingu na Západnom Slovensku



Zdroj: Vlastné spracovanie, 2021

Obrázok 7 a 8: Podiel verejných a súkromných coworkingov a ponúkané služby na Západnom Slovensku



Zdroj: Vlastné spracovanie, 2021

Neobmedzený prístup do coworkingu na Západnom Slovensku poskytuje iba necelá polovica coworkingov, 6 z 9tich disponujú zasadáčkou. Pomer medzi prevádzkovaním súkromnou spoločnosťou a občianskym združením je 5:4 v prospech súkromných spoločností.

### 3 Coworkingy na strednom Slovensku

Na Strednom Slovensku sme zaradili do nášho mapovania celkovo 8 coworkingov, najväčším z nich je 365.lab s rozlohou 1000m<sup>2</sup>, čo sa v jedinom prípade aspoň trochu približuje k priemernej rozlohe v Bratislave. Priemerná plocha je 265m<sup>2</sup> a cena 107€ mesačne.

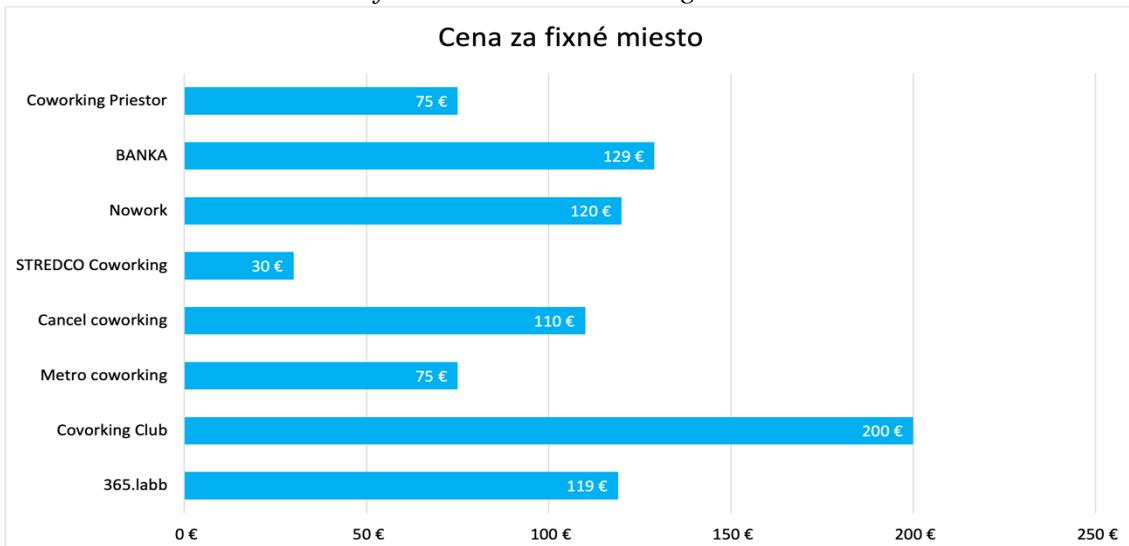
Tabuľka 3: Coworkingy na Strednom Slovensku

Stredné Slovensko	Názov	Mesto	Cena za fixné miesto	Plocha	Občianske združenie	Súkromné vlastníctvo	Neobmedzený prístup	Zasadáčka	Telefonovačka	Events	Vlastné zázemie	Poradenstvo
	365.lab	Banská Bystrica	119 €	1 000m <sup>2</sup>	A		A	A	N	A	N	A
	BANKA	Žilina	129 €	260m <sup>2</sup>		A	A	A	N	N	N	N
	STREDCO Coworking	Dolný Kubín	30 €	200m <sup>2</sup>	A		N	N	N	N	N	N
	Coworking Priestor	Lučenec	75 €	180m <sup>2</sup>	A	A	A	A	N	A	A	N
	Coworking Club	Banská Bystrica	200 €	130m <sup>2</sup>		A	A	A	N	N	N	N
	Nowork	Námestovo	120 €	120m <sup>2</sup>		A	N	A	N	N	-	-
	Cancel coworking	Martin	110 €	116m <sup>2</sup>	A		A	N	N	N	N	N
	Metro coworking	Martin	75 €	110m <sup>2</sup>	A		N	A	N	N	N	N
	Priemer/Počet		107 €	265m <sup>2</sup>	5	4	5	5	0	2	1	1

Zdroj: Vlastné spracovanie, 2021

Na Strednom Slovensku sa nachádza najlacnejší coworking na Slovensku, STREDCO Coworking v Dolnom Kubíne, ktorý ponúka miesto za 30€ mesačne. Najdrahším coworkingom na Strednom Slovensku je Coworking Club v Banskej Bystrici.

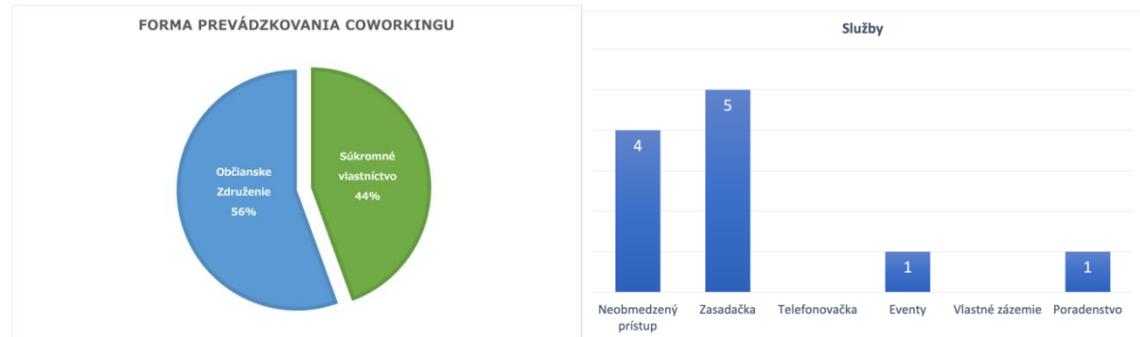
Obrázok 9: Porovnanie cien za fixné miesto v coworkingu na Strednom Slovensku



Zdroj: Vlastné spracovanie, 2021

Neobmedzený prístup poskytuje polovica coworkingov na Strednom Slovensku, žiadnen z nich nedisponuje vlastným zázemím a ani miestnosťou určenou primárne na telefonovanie. V tomto regióne je prevádzkovaných viacero coworkingov občianskymi združeniami ako súkromnými spoločnostami v pomere 5:4. Treba však uviesť že jeden z nich a to „Coworking Priestor“ v Lučenci je prevádzkované hybridnou formou.

Obrázok 10 a 11: Podiel verejných a súkromných coworkingov a ponúkané služby na Strednom Slovensku



Zdroj: Vlastné spracovanie, 2021

#### 4 Coworkingy na východnom Slovensku

Na východnom Slovensku sme sa zamerali na 10 coworkingov, najväčším z nich je Eastcubator v Košiciach, najmenším „Baňa Coworking“ s rozlohou 60m<sup>2</sup>. Priemerná plocha coworkingu na Východnom Slovensku je 202m<sup>2</sup>.

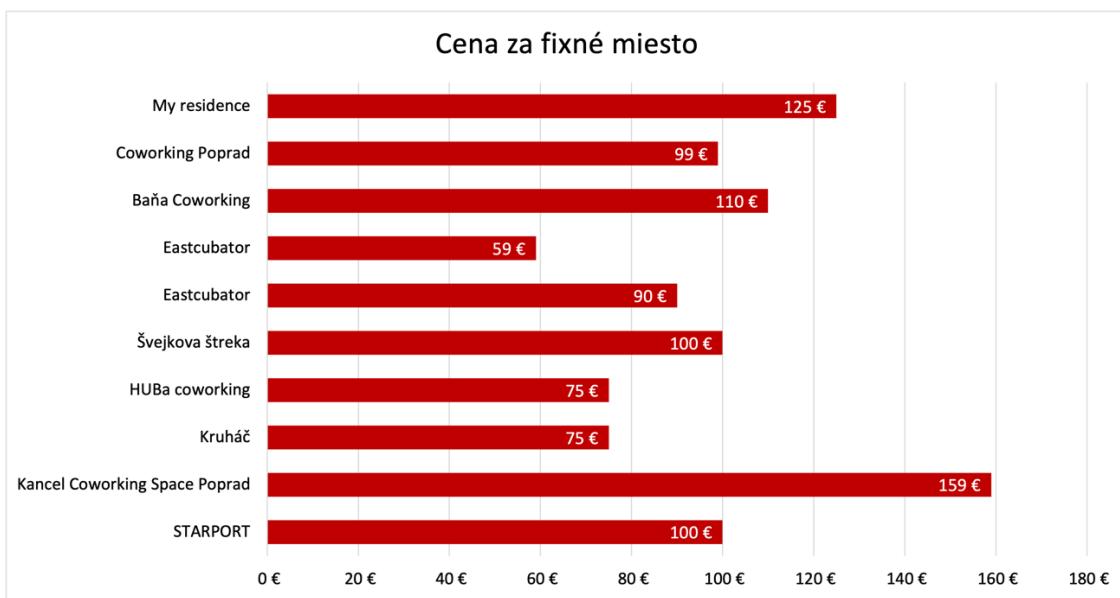
Tabuľka 4: Coworkingy na Východnom Slovensku

Východné Slovensko	Názov	Mesto	Cena za fixné miesto	Plocha	Občianske združenie	Súkromné vlastníctvo	Neobmedzený prístup	Zasadáčka	Telefonovačka	Eveny	Vlastné zázemie	Poradenstvo
	Eastcubator	Košice	59 €	386m <sup>2</sup>	A		A	A	N	A	N	A
	Kruháč	Rimavská Sobota	75 €	300m <sup>2</sup>	A			N	A	N	N	N
	STARPORT	Košice	100 €	210m <sup>2</sup>		A	A	A	A	N	N	N
	Eastcubator	Prešov	90 €	200m <sup>2</sup>	A			A	N	A	N	N
	Coworking Poprad	Poprad	99 €	200m <sup>2</sup>		A	A	A	N	N	N	N
	My residence	Prešov	125 €	200m <sup>2</sup>		A	A	A	N	A	A	N
	Kancel Coworking Space	Poprad	159 €	180m <sup>2</sup>		A	A	A	A	A	A	N
	HUBa coworking	Košice	75 €	180m <sup>2</sup>	A		A	A	N	N	N	N
	Švejkova štreka	Humenné	100 €	100m <sup>2</sup>	A		A	A	N	N	N	N
	Baňa Coworking	Spišská Nová Ves	110 €	60m <sup>2</sup>	A		A	N	N	N	N	N
	Priemer/Počet		99 €	202m <sup>2</sup>	6	4	9	8	3	3	2	1

Zdroj: Vlastné spracovanie, 2021

Najdrahším coworkingom je „Kancel Coworking Space“ v Poprade so sumou 159€/mesiac, najlacnejší je Eastcubator za 59€ mesiac. Priemerná cena za fixný stôl je 99€/mesiac, najmenej na celom Slovensku.

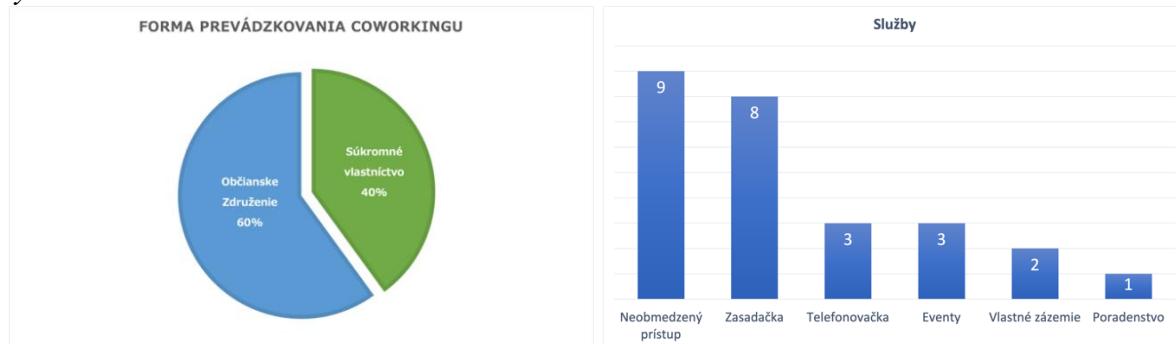
Obrázok 12: Porovnanie ceny za fixné miesto na Východnom Slovensku



Zdroj: Vlastné spracovanie, 2021

Neobmedzený prístup poskytujú všetky coworkingy s výnimkou „Kruháč“ coworkingu v Rimavskej sobote. Ďalej medzi najviac poskytované benefity patrí zasadačka. Na východnom Slovensku prevažujú coworkingy s právnou formou občianskeho združenia v pomere 6:4.

Obrázok 13 a 14: Porovnanie coworkingov podľa právnej formy a ponúkaných služieb na Východnom Slovensku



Zdroj: Vlastné spracovanie, 2021

## 5 Porovnanie coworkingových centier na Slovensku

V článku sme zmapovali celkovo 39 coworkingov, podľa ceny za miesto, benefitov a právnej formy fungovania. Priemerne najväčšie coworkingy sa nachádzajú na území Bratislavu, potom na Strednom, Západnom a Východnom Slovensku. Priemerná veľkosť plochy coworkingového centra v Bratislave ( $1247\text{m}^2$ ) je viac ako šesťkrát väčšia ako v ostatných regiónoch Slovenska ( $203\text{ m}^2$ ). Medzi vlastnosti s najväčším zastúpením v coworkingoch patrí možnosť zasadačky, potom neobmedzený prístup, organizovanie eventov, miestnosť na telefonovanie, vlastné zázemie a na poslednom mieste poradenstvo v oblasti podnikania. V Bratislave poskytujú jednotlivé coworkingy pre svojich nájomníkov najviac služieb v jednom balíčku.

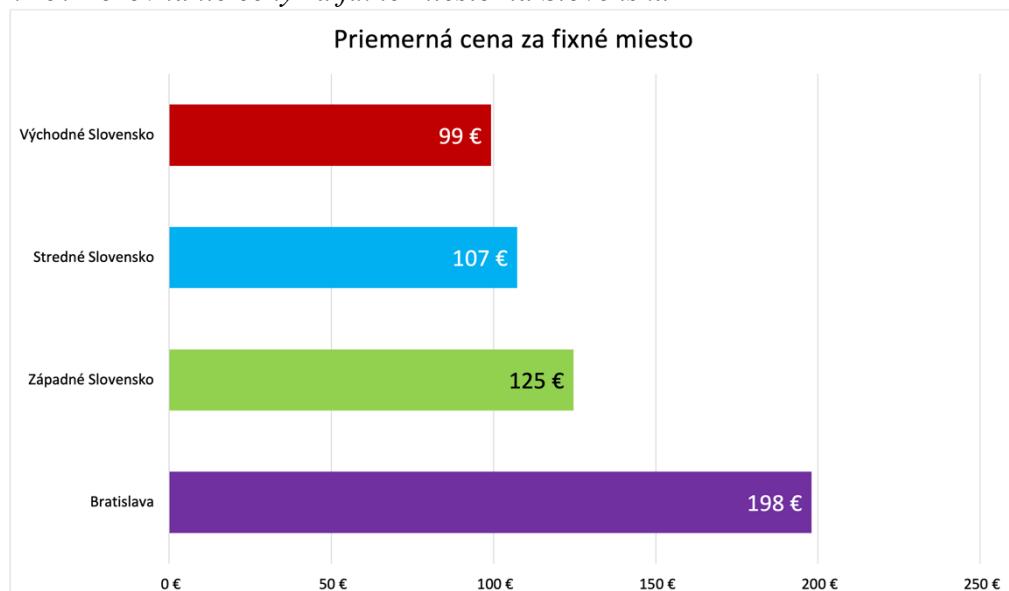
Tabuľka 5. Komparácia coworkingov podľa regiónov NUTS2 na Slovensku

Súhrn	Názov	Mesto	Priemerná cena za fixné miesto	Priemerná Plocha	Občianske združenie	Súkromné vlastníctvo	Neobmedzený prístup	Zasadáčka	Telefonovačka	Eventy	Vlastné zázemie	Poradenstvo
Bratislava			198 €	1 247m <sup>2</sup>	3	11	10	12	8	9	7	3
Západné Slovensko			125 €	142m <sup>2</sup>	4	5	4	6	3	4	3	1
Stredné Slovensko			107 €	265m <sup>2</sup>	5	4	5	5	0	2	1	1
Východné Slovensko			99 €	202m <sup>2</sup>	6	4	9	8	3	3	2	1
	Priemer/Počet		132 €	464m <sup>2</sup>	18	24	28	31	14	18	13	6

Zdroj: Vlastné spracovanie, 2021

Z výsledkov porovnania coworkingových centier na Slovensku vyplýva, že cena za fixné pracovné miesto sa znižuje kontinuálne čím sme ďalej od hlavného mesta. Priemerné ceny sú 199€ mesačne v Bratislave a 110€/mesačne vo zvyšku Slovenska. Priemerná suma za fixné miesto je v Bratislave skoro dvojnásobne vyššia v porovnaní s ostatnými regiónmi Slovenska.

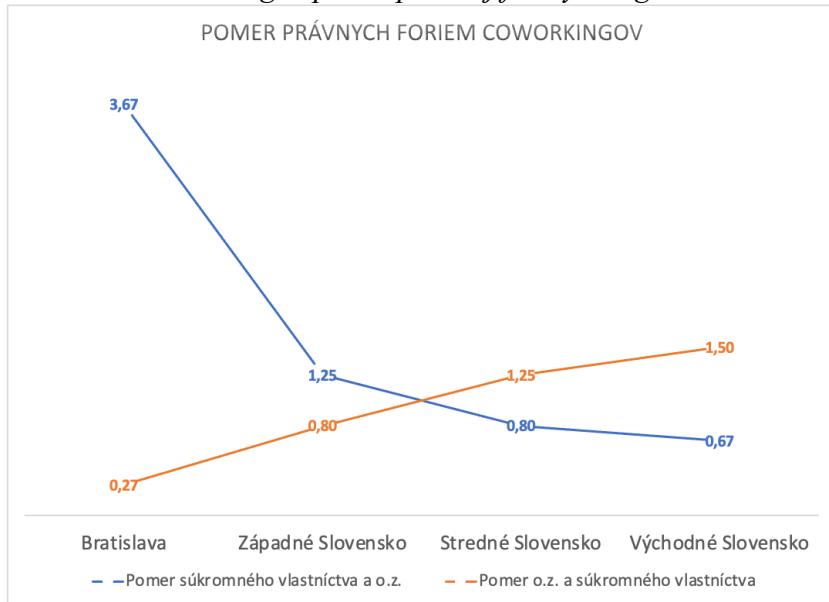
Obrázok 15: Porovnanie ceny za fixné miesto na Slovensku



Zdroj: Vlastné spracovanie, 2021

Väčšina coworkingov na Slovensku je prevádzkovaných s právnou formou súkromnej spoločnosti a teda prevádzkovanie coworkingu slúži prevádzkovateľovi na generovanie zisku. Celkovo je pomer 24:18 v prospech súkromných spoločností, a 3 coworkingy majú hybridný model. Z výsledkov porovnania coworkingov vyplýva, že v priemere sa platí viac za miesto v coworkingoch s právnou formou súkromnej spoločnosti ako pri coworkingu s právnou formou občianského združenia resp. neziskovej organizácie. Vyšší poplatok za miesto v coworkingoch s právnou formou súkromnej spoločnosti je spojený s relatívne vyšším podielom poskytovaných benefitov a služieb pre svojich členov. Z výsledkov tiež vyplýva, že cena za fixné pracovné miesto sa geograficky znižuje čím ďalej od Bratislavы sa coworking nachádza a zároveň sa znižuje podiel coworkingov prevádzkovaných formou súkromných spoločnosti a rastie podiel coworkingov s právnou formou občianskych združení.

Obrázok 16: Porovnanie coworkingov podľa právnej formy v regiónoch NUTS2



Zdroj: Vlastné spracovanie, 2021

Záverom z porovnania môžeme zhrnúť, že malý podnikatelia si na Slovensku môžu nájsť vlastné pracovné miesto v coworkingu už od 30€ za mesiac (STREDCO Coworking na Strednom Slovensku), priemerne je to však 130€/mesiac a to v mnohých prípadoch so zasadačkou, neobmedzeným prístupom a vzdelávaním vo forme eventov. Ako základ dostane pripojenie k internetu, kuchynku či iné benefity ktoré poskytujú prevádzkovatelia coworkingov. To že na Slovensku funguje viac ako 39 coworkingov svedčí o tom, že existuje záujem samostatných podnikateľov o zdieľané pracovné miesto. Výhody plynúce z úspor na mesačných nákladoch, vybudovaného zázemia a komunity vytvárajú vhodné podmienky pri začiatku podnikania na Slovensku.

## Záver

Coworking je v súčasnej dobe jeden z oblúbených nástrojov zdieľanej ekonomiky. Okrem toho, že môžu malé podnikateľské subjekty ušetriť náklady na prevádzku kancelárie, získavajú aj podporu okolia a poradenstvo či kooperáciu pri svojej činnosti. Z historického hľadiska sa jedná o model fungovania, ktorý funguje približne 15 rokov, no vo svojej krátkej histórii sa stihol sformovať do viacerých foriem a modelov. Prevádzka, ponúkané benefity pre členov coworkingu a jeho fungovanie závisí od prevádzkovateľa.

Z mapovania coworkingových priestorov kde so vzorkou 39 subjektov vyplýva, že priemerná cena nájmu fixného miesta je na úrovni regiónov NUTS 2 celého Slovenska od 99€ po 198€ za mesiac a rôzne coworkingy ponúkajú oddelené zasadačky, eventy či poradenstvo. Táto suma môže pre malý podnikateľský subjekt znamenať značné úspory pri začiatkoch. Spolu 39 subjektov poskytuje na Slovensku až 20.377m<sup>2</sup> zdieľaného pracovného priestoru.

Coworking s právnou formou súkromnej spoločnosti inklinujú skôr k tvorbe zisku pre vlastníka a prevádzkovateľa coworkingu a naopak coworking s právnou formou občianskeho združenia a neziskovej organizácie sa primárne zameriava na vnútorný rozvoj komunity a kvalitu ponúkaných služieb pre svojich členov.

Možnosti a budúcnosť zdieľaných kancelárií na Slovensku, zdieľanej ekonomiky a zdieľaného ľudského potenciálu má nepochybne svoj význam a zastúpenie mladej generácie podnikateľov. Ich rast, budovanie know-how a vytváranie inovatívneho prístupu by

malo byť klúčové v ďalšom smerovaní Slovenska a otváraní sa ďalším príležitostiam kde bude hrať primárnu úlohu nie masová výroba ale výnimočný potenciál myse.

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# **INNOVATIVE POSSIBILITIES OF USING MEDIUM AND LESS PRODUCTION SOILS IN SLOVAKIA AS SUPPORT FOR REGIONAL BIOENERGETICS**

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## **Abstract**

The Slovak Republic, as an EU Member State, is committed to fulfilling the strategy of diversifying the resources needed for energy and possibly other uses in the framework of ensuring energy sufficiency and industrial processing. Targeted grown biomass of fast-growing plants is one of the possibilities for diversification of agricultural production. The advantage is that the technological processes of growing fast-growing plants can be located on temporarily or permanently unusable areas, which cannot be used for the primary production of commodities intended for food purposes. At the same time, the diversification of agricultural production provides an opportunity to manage the land directly in specific regions actively. An important aspect is the increasing economic self-sufficiency and social status of the population of individual regions of Slovakia.

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## **Key words**

biomass, fast growing plants, innovations, renewable resources, bioenergy

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## **Úvod**

V súčasnej dobe je biomasa považovaná za dôležitý zdroj obnoviteľnej energie. Napriek všeobecne deklarovanej podpore je celkový rozvoj bioenergetiky na Slovensku pomalý a postupne dochádza k zaostávaniu za rozvinutými krajinami Európy. Záväzok postupného zvyšovania podielu obnoviteľných zdrojov energie je zakotvený v dokumente Národný akčný plán pre energiu z obnoviteľných zdrojov energie, ktorý vláda SR schválila dňa 6. októbra 2010 uznesením vlády SR č. 677/2010. Tento dokument predpokladal dosiahnuť 15,3 % využitie obnoviteľných zdrojov energie v pomere ku hrubej konečnej energetickej spotrebe v roku 2020. Okrem iného sa v týchto strategických vládnych dokumentoch píše aj o potrebe zvyšovania výroby bioplynu, resp. biometánu (upravený bioplyn na kvalitu zemného plynu), ako perspektívnych alternatívnych palív z biomasy a to ako z odpadovej, tak aj zámerne pestovanej.

Na úrovni krajín EÚ v roku 2018 bola dosiahnutá dohoda pre novú Smernicu o energii z obnoviteľných zdrojov na nasledujúce desaťročie. Nové predpisy obsahujú právne záväzný cieľ pre celú EÚ týkajúci sa energie z obnoviteľných zdrojov do roku 2030 vo výške 32% (Smernica EP a Rady (EÚ) 2018/2001 o podpore využívania energie z obnoviteľných zdrojov (prepracované znenie)).

Rozvoj pestovania rýchlorastúcich rastlín je naviazaný na rozvoj bioplynových staníc. Intenzívny rozvoj budovania bioplynových zariadení na Slovensku zaznamenávame až od januára 2010, kedy nadobudol účinnosť zákon 309/2009 Z. z. o podpore obnoviteľných zdrojov energie a vysoko účinnej kombinovanej výrobe a o zmene a doplnení niektorých zákonov. V súčasnosti je na Slovensku približne 111 aktívnych bioplynových staníc.

Cielené pestovanie biomasy je zakladanie porastov rýchlorastúcich rastlín, ktoré sú prioritne určené na energetické využitie. Cielené pestovanie môžeme považovať za konvenčný, no zároveň inovatívny spôsob pestovania s presmerovaním tokov energie na priamu energetickú spotrebu (Gielen et al., 2019).

V zmysle legislatívnych opatrení je možné rýchlorastúce rastliny pestovať na sekundárnom poľnohospodárskom fonde. Ide o poľnohospodárske pôdy s bodovou hodnotou 1-55 bodov (kvalitatívne hodnotenie pôdy na základe typologicko-produkčných kategórií pôd) a tieto sú dočasne alebo trvalo nevyužívané na potravinárske, prípadne krmovinárske spracovanie. Medzi ďalšie obmedzenia patrí skutočnosť, že minimálna výmera plochy pre pestovanie rýchlorastúcich rastlín je  $1000 \text{ m}^2$  na dobu najviac 20 rokov. Porasty rýchlorastúcich rastlín je možné zakladat' na poľnohospodárskej pôde, ktorá je zaradená podľa kódu BPEJ do 5. až 9. skupiny kvality, ktorá je kontaminovaná, ktorá je zaradená podľa kódu BPEJ do 3. alebo 4. skupiny kvality, ak sa pôda nachádza v záplavovom území, je zamokrená alebo je vystavená veternej erózii a na pôde, ktorá sa nachádza mimo 3. až 5. stupňa ochrany prírody a krajiny.

Je veľmi dôležité rešpektovať ekologické funkcie pôdy, ako schopnosť akumulovať vodu, imobilizovať a transformovať cudzorodé látky. Potenciál konkrétnej pôdnej jednotky plniť vybrané ekologické funkcie sa hodnotí cez tzv. Index environmentálneho potenciálu pôd. Priemerná bodová hodnota vyjadrujúca schopnosť poľnohospodárskych pôd Slovenska zabezpečovať ekologické funkcie je 55,3 bodov (Vilček, 2014).

Zaznamenávame výrazný tlak na optimalizáciu usporiadania a obhospodarovania pôdy v kultúrnej poľnohospodárskej krajine, a to najmä z ohľadom na teritoriálnu (vonkajšiu) štruktúru poľnohospodárskeho systému. Z tohto vyplýva skutočnosť, že práve v oblastiach, kde sa nachádzajú stredne a menej produkčné pôdy je dôležité uplatňovanie princípov udržateľného rozvoja so zameraním poľnohospodárstva na mimoprodukčné funkcie vo väzbe na tvorbu krajiny. Jednou z možností je zavádzanie alternatívnych foriem hospodárenia spojené s diverzifikáciou rastlinnej výroby, so zvýšením druhovej rozmanitosti pestovaných plodín, so zavedením pestovania liečivých rastlín, technických plodín, energetických rastlín, so zostavením exaktnejších osevných postupov a celkovou ekologizáciou poľnohospodárskych postupov (Grausová, Čižmárik, 2007).

Je potrebné stanovovať environmentálne riziká a rešpektovať environmentálny potenciál územia, jeho produkčnú schopnosť a celkový bioenergetický potenciál územia (pôdy) (Smernica MŽP SR č.1/2015-7 na vypracovanie analýzy rizika znečisteného územia).

Cieľom predloženého príspevku je predstaviť možnosti pestovania rýchlorastúcich rastlín v jednotlivých regiónoch Slovenska na základe rešpektovania vybraných klimatických a pôdných faktorov.

## Materiál a metódy

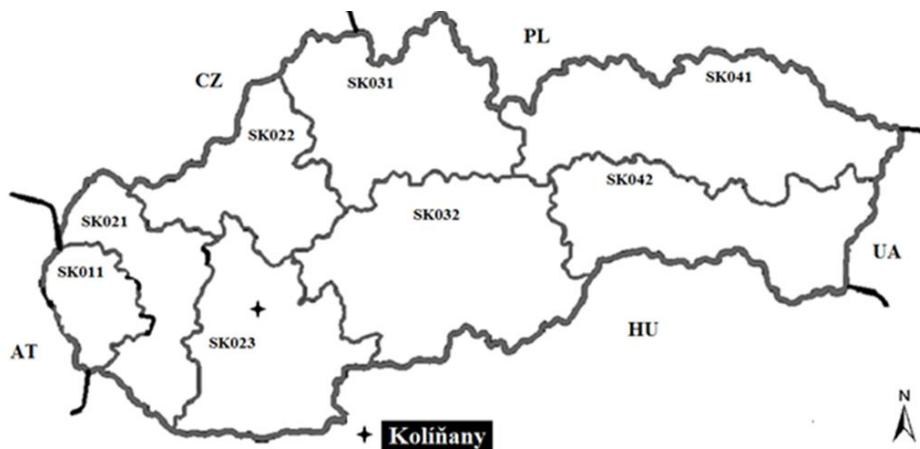
Výskum zameraný na analýzu vhodnosti pestovania rýchlorastúcich rastlín na úrovni regiónov Slovenska sa realizoval z pohľadu abiotických faktorov limitujúcich pestovanie rýchlorastúcich rastlín v jednotlivých regiónoch.

Významným faktorom rastu a tvorby biomasy sú pôdne a klimatické podmienky. Klimatické faktory v regiónoch Slovenska sú vyjadrené ako priemerné mesačné teploty vzduchu a priemerné úhrny zrážok za celé vegetačné obdobie – apríl až október. Údaje boli spracované podľa databázy Slovenského hydrometeorologickeho ústavu za roky 2010 až 2015.

Pôdny faktor bol vyjadrený ako výmera poľnohospodárskej pôdy vhodnej na pestovanie rýchlorastúcich rastlín. Údaje boli spracované podľa databázy Výskumného ústavu pôdoznalectva a ochrany pôdy SR. Výmery o registrovaných plochách porastov rýchlorastúcich rastlín pestovaných na poľnohospodárskej pôde boli spracované podľa

databáz z jednotlivých regiónov Slovenska k 1.9.2016. Bolo použité rozdelenie plochy Slovenska na základe NUTS 3 (*Nomenclature of Territorial Units for Statistics*). Na základe použitia tejto metodiky bolo územie Slovenska rozdelené na 8 regiónov (rešpektujúcich regionalizáciu na základe VÚC - 8 krajov).

Obrázok 1. Regióny Slovenska na základe NUTS 3

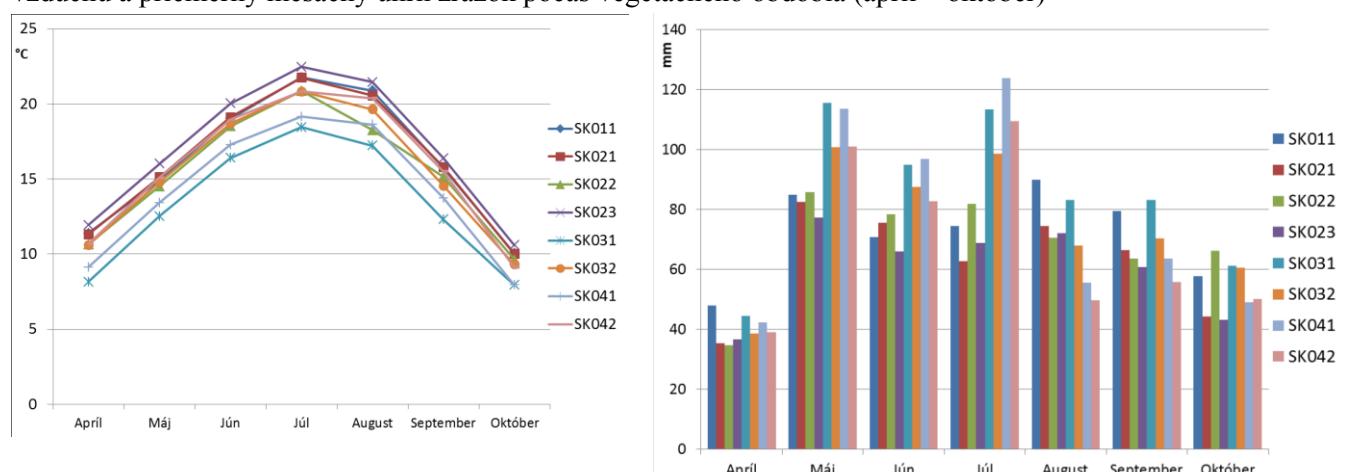


*Legenda: SK011 – Bratislava, SK021 – Trnava, SK022 – Trenčín, SK023 – Nitra, SK032 – Banská Bystrica, SK031 – Žilina, SK042 – Košice, SK041 – Prešov, AT – Rakúsko, HU – Maďarsko, UA – Ukrajina, PL – Poľsko, CZ – Česká republika*  
Zdroj: Nomenclature of Territorial Units for Statistics

## Výsledky a diskusia

Teplotné podmienky pre rast a tvorbu biomasy nadzemných orgánov energetických rastlín sú v regiónoch na Slovensku priaznivé (obrázok 2). Limitujúcim klimatickým faktorom pre aktiváciu rastu rastlín je začiatok vegetačnej doby a jej dĺžka.

Obrázok 2 Regionálne disparity vybraných klimatických ukazovateľov – priemerné mesačné teploty vzduchu a priemerný mesačný úhrn zrážok počas vegetačného obdobia (apríl – október)



Zdroj: vlastné spracovanie na základe databáz SHMU

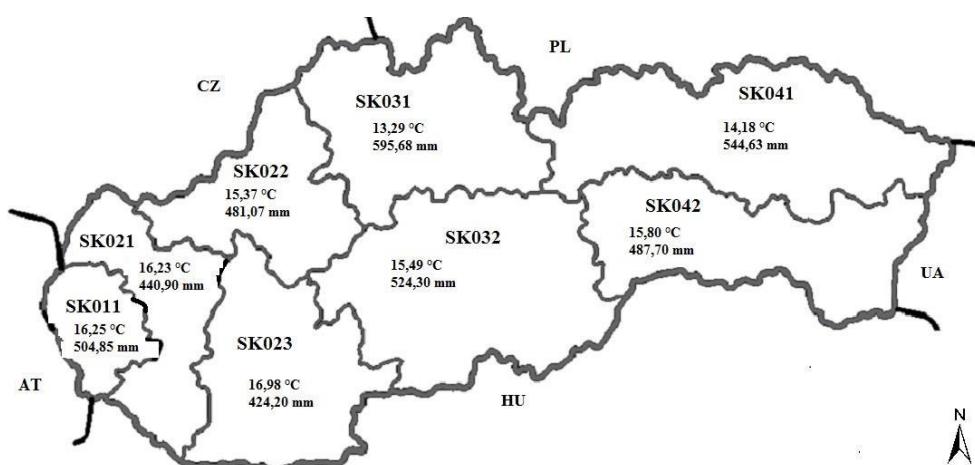
Podobnú priestorovú diferenciáciu regiónov vhodných pre pestovanie rýchlorastúcich drevín na základe klimatických parametrov riešili Xue et al. (2016) v Číne. Ako limitujúci faktor brali pri hodnotení klimatických podmienok dĺžku vegetačnej doby definovanú ako

obdobie rastu biomasy so začiatkom priemernej dennej teplote  $\geq 10^{\circ}\text{C}$  a úhrne zrážok počas vegetačnej doby  $\geq 400$  mm.

V regiónoch na Slovensku (okrem SK031 a SK041) dosiahli priemerné teploty vzduchu hodnotu nad  $10^{\circ}\text{C}$  už v polovici apríla. To je začiatok aktivácie rastu. Zrážková činnosť počas vegetačnej doby je v jednotlivých regiónoch porovnateľná. Pre vyprodukovanie dostatočného množstva biomasy potrebujú rýchlorastúce rastliny okrem priaznivých teplotných podmienok aj dostatok vlahy počas vegetačnej doby (precipitation  $\geq 400$  mm). Na základe analýzy úhrnu mesačných zrážok nebol zaznamenaný výrazný deficit zrážok počas vegetačnej doby.

Limitujúcim faktorom pre dostatočnú produkciu nadzemnej biomasy týchto rastlín je dĺžka vegetačnej doby. Na obrázku 3 sú vyjadrené priemerné teploty a úhrny zrážok počas celej vegetačnej doby (apríl až október) v rokoch 2010 - 2017. V regiónoch Slovenska sú klimaticky najpriateľnejšie regióny situované v južných a juhovýchodných regiónoch. Naopak severné regióny (SK031 a SK041) sú z pohľadu klimatických faktorov menej vhodné – kratšia vegetačná doba a vysoký úhrn zrážok. Aj tu však sú lokálne výnimky, v súvislosti s nadmorskou výškou konkrétneho stanovišťa.

Obrázok 3 Vybrané klimatické ukazovatele – priemerná teplota vzduchu a priemerný úhrn zrážok za celé vegetačné obdobie (apríl – október) v regiónoch Slovenska



Zdroj: vlastné spracovanie na základe databáz SHMU

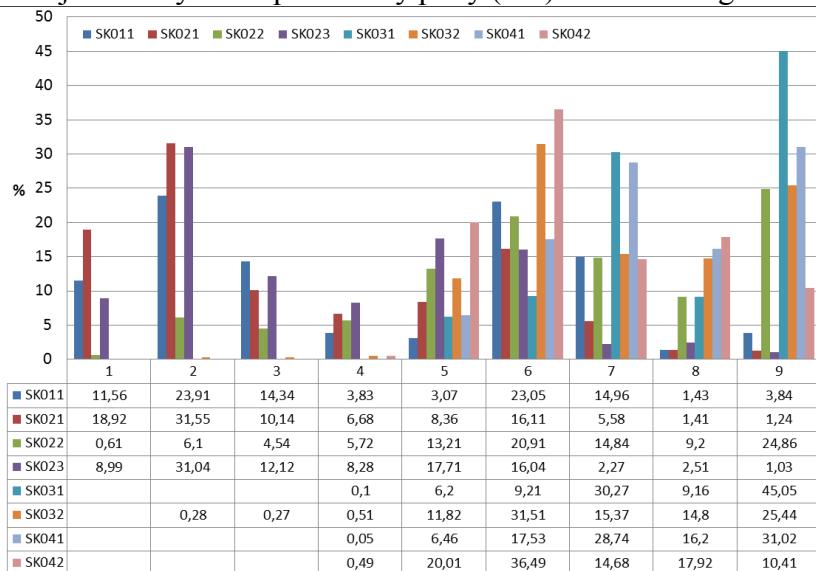
Pri určení vhodnej lokalizácie energetických rastlín na poľnohospodárskej pôde v regiónoch Slovenska sa vychádza z analýzy produkčného potenciálu BPEJ a typologicko-produkčných kategórií poľnohospodárskej pôdy.

Najvhodnejšie ekologické podmienky sa nachádzajú v nížinách, pahorkatinových a vrchovinových oblastiach Slovenska. Medzi vhodné môžeme zaradiť regióny s dominanciou pôd typu čierica, smonica a fluvizem s hlbšou hladinou podzemnej vody. Rýchlorastúce rastliny môžeme pestovať aj na výrazných a strmých svahoch, tam však majú viac pôdoochranný ako produkčný charakter. Kontaminované pôdy môžu byť taktiež vhodnou voľbou pre pestovanie rýchlorastúcich rastlín z dôvodu, že takéto plochy by mali byť vyradené z pestovania plodín, ktoré sú používané v potravinovom reťazci a teda mali by byť využívané skôr pre pestovanie technických plodín.

Podľa zákona č. 220/2004 Z.z. o ochrane a využívaní poľnohospodárskej pôdy a zmene zákona 245/2003 Z.z. o integrovanej prevencii a kontrole znečisťovania životného prostredia a o zmene a doplnení niektorých zákonov sú všetky poľnohospodárske pôdy podľa príslušnosti do BPEJ zaradené do 9 skupín kvality pôdy. Najkvalitnejšie pôdy patria do 1.

skupiny a najmenej kvalitné do 9. skupiny. Pre pestovanie rýchlorastúcich rastlín v podmienkach Slovenska sú vhodné pôdy zaradené do 5 – 9 skupiny kvality pôdy.

Obrázok 4 Výmera jednotlivých skupín kvality pôdy (1-9) na úrovni regiónov Slovenska

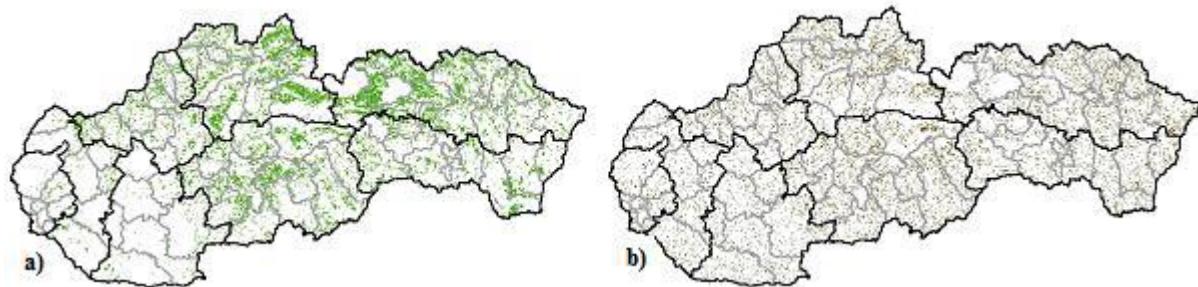


Zdroj: Mandalová, Kotrla, Prčík, 2017

Na obrázku 4 je uvedená analýza výmery jednotlivých skupín pôdy (1-9) na úrovni regiónov Slovenska. Výmera skupiny kvality pôd 5-9 je zastúpená na úrovni všetkých regiónov Slovenskej republiky. Najvyšší potenciál v pestovaní energetických rastlín vzhladom ku konkrétnym výmerám pôd na úrovni regiónov je v Prešovskom (99,95 %), Žilinskom (99,89 %), Košickom (99,51 %), Banskobystrickom (98,94 %) a Trenčianskom regióne (83,02 %). K regionom s výmerou skupiny kvality pôd 5 až 9 pod 50 % z celkovej výmery poľnohospodárskej pôdy patrí Bratislavský (46,35 %), Nitriansky (39,56 %) a Trnavský (32,7 %) región.

Slovensko musí k potravinovej sebestačnosti disponovať minimálnou výmerou poľnohospodárskej pôdy 1 367 853 ha, čo predstavuje asi 56 % v súčasnosti evidovaných poľnohospodárskych pôd Slovenska (Vilček, 2011). Na týchto pôdach je možné z pestovania poľných plodín dosiahnuť najlepšie ekonomicke výsledky, a preto je zo strategického dôvodu potrebné ich ponechať na priame poľnohospodárske využitie. Ide o primárnu poľnohospodársku pôdu. Pôdný fond ďalej tvorí sekundárna pôda, najmä orná pôda, na ktorej je ešte predpoklad rentabilného pestovania poľnohospodárskych plodín. Ide o pôdu, ktorú pri predpokladanom záujme spoločnosti možno dočasne použiť na iné ako potravinové účely. Túto pôdu je možné vyčleniť na alternatívne poľnohospodárske využitie napríklad na výrobu bioenergie. Sekundárny poľnohospodársky pôdný fond zaberá 696 038 ha, čo predstavuje asi 29 % v súčasnosti evidovaných poľnohospodárskych pôd Slovenska. V rámci poľnohospodárskych pôd existuje aj tzv. ostatná pôda, ktorá by mala byť prednostne využívaná na alternatívne poľnohospodárske využitie, na pestovanie rýchlorastúcich rastlín, na rôzne nebiologické účely (športové, turistické a rekreačné). Ostatný poľnohospodársky pôdný fond zaberá 368 587 ha, čo predstavuje asi 15 % v súčasnosti evidovaných poľnohospodárskych pôd Slovenska. Priestorové vymedzenie sekundárnej a ostatnej poľnohospodárskej pôdy v regiónoch Slovenska dokumentuje obrázok 5.

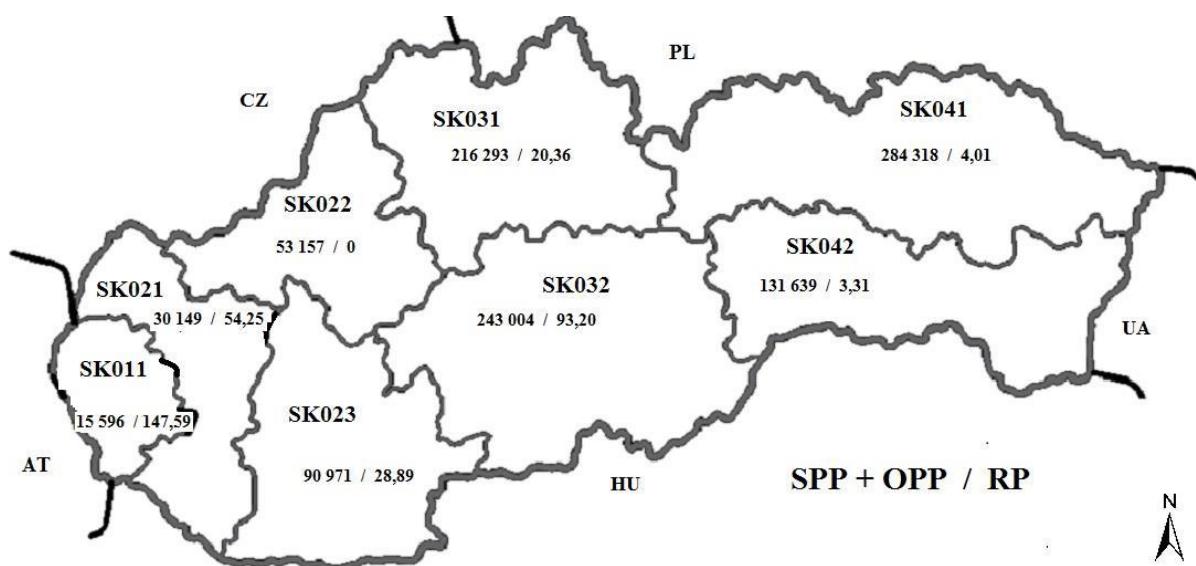
Obrázok 5 Lokalizácia sekundárnej (a) a ostatnej (b) poľnohospodárskej pôdy v regiónoch Slovenska



Zdroj: [poldnemapy.sk](http://poldnemapy.sk)

Pestovanie rýchlorastúcich rastlín v regiónoch Slovenska je možné na sekundárnej a ostatnej pôde. Primárny pôdny fond je viazaný na zabezpečenie potravinovej sebestačnosti krajiny. Regionálne rozdiely vo výmerach pôd vhodných na pestovanie rýchlorastúcich energetických rastlín dokumentuje obrázok 6.

Obrázok 6 Výmera poľnohospodárskej pôdy vhodnej na pestovanie rýchlorastúcich rastlín a reálna výmera registrovaných plôch rýchlorastúcich rastlín vyjadrená v hektároch v regiónoch Slovenska



Legenda: SPP – sekundárna poľnohospodárska pôda; OPP – ostatná poľnohospodárska pôda; RP – registrovaná pôda rýchlorastúcich rastlín na poľnohospodárskej pôde, vyjadrená v ha

Zdroj: Vlastné spracovanie na základe databáz VUPOP

Najväčší podiel výmery vhodných pôd pre pestovanie rýchlorastúcich rastlín je lokalizovaný v regiónoch SK031 (88 %), SK041 (74 %) a SK032 (58 %). Najnižší podiel je v regiónoch SK021 (10 %), SK011 (17 %) a SK023 (22 %).

Reálna výmera registrovaných plôch rýchlorastúcich rastlín v regiónoch Slovenska je len 351,7 ha (0,03% z celkovej možnej výmery pôd). Najväčšie výmery v súčasnosti obhospodarovaných plantáží rýchlorastúcich rastlín sú v regiónoch SK011 (147,59 ha), SK032 (93,20 ha), SK021 (54,25 ha) a SK023 (28,89 ha). Ide o menšie plochy, ktoré zabezpečujú produkciu biomasy pre lokálne energetické zhodnotenie.

## Závery

Analýza vhodnosti pestovania rýchlorastúcich rastlín v poľnohospodársky využívanej krajine poukázala na fakt, že limitujúcim faktorom pre dostatočnú produkciu nadzemnej biomasy je aj dĺžka vegetačnej doby. V regiónoch Slovenska sú klimaticky najpriateľnejšie regióny situované v južných a juhovýchodných regiónoch. Tieto regióny dosiahli priemerné teploty vzduchu s hodnotou nad 10°C už v polovici apríla (začiatok aktivácie rastu). Naopak severné regióny SK031 (Žilinský región) a SK041 (Prešovský región) sú z pohľadu klimatických faktorov menej vhodné. V týchto regiónoch bola zaznamenaná kratšia vegetačná doba, nižšia teplota počas vegetačnej doby a vysoký úhrn zrážok. Komparácia úhrnu mesačných zrážok v sledovanom období nepotvrdila výrazný deficit zrážok počas vegetačnej doby v regiónoch.

V zmysle zákona 220/2004 Z.z. o ochrane a využívaní poľnohospodárskej pôdy a o zmene zákona č. 245/2003 Z. z. o integrovanej prevencii a kontrole znečisťovania životného prostredia a o zmene a doplnení niektorých zákonov pre pestovanie rýchlorastúcich rastlín v podmienkach Slovenska sú vhodné pôdy zaradené do 5 – 9 skupiny kvality pôdy. Výmera týchto pôd je zastúpená na úrovni všetkých regiónov. Najvyšší potenciál v pestovaní rýchlorastúcich rastlín vzhľadom ku konkrétnym výmerám pôd na úrovni regiónov je v Prešovskom (99,95 %), Žilinskom (99,89 %), Košickom (99,51 %), Bansko bystrickom (98,94 %) a Trenčianskom regióne (83,02 %). Ide o regióny pre pestovanie poľných plodín menej vhodných a v regiónoch s vyššou členitostou reliéfu. K regiónom s výmerou kvality pôdy 5 až 9 pod 50 % z celkovej výmery poľnohospodárskej pôdy patrí Bratislavský (46,35 %), Nitriansky (39,56 %) a Trnavský región (32,70 %). Najväčší podiel výmery vhodných pôd pre pestovanie rýchlorastúcich rastlín je lokalizovaný v regiónoch Žilinský (88 %), Prešovský (74 %) a Bansko bystrický (58 %). Najnižší podiel je v regiónoch Trnavský (10 %), Bratislavský (17 %) a Nitriansky (22 %). V súčasnosti tvorí reálnu výmeru registrovaných plôch rýchlorastúcich rastlín v regiónoch Slovenska len 0,03 % z celkovej možnej výmery pôd (351,7 ha).

## Acknowledgment

Táto publikácia vznikla vďaka podpore v rámci Operačného programu Integrovaná infraštruktúra pre projekt: Dopytovo-orientovaný výskum pre udržateľné a inovatívne potraviny, Drive4SIFood 313011V336, spolufinancovaný zo zdrojov Európskeho fondu regionálneho rozvoja.

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ZÁKON 220/2004 Z.z. o ochrane a využívaní poľnohospodárskej pôdy a o zmene zákona č. 245/2003 Z. z. o integrovanej prevencii a kontrole znečisťovania životného prostredia a o zmene a doplnení niektorých zákonov pre pestovanie rýchlorastúcich rastlín

ZÁKON 309/2009 Z. z. o podpore obnoviteľných zdrojov energie a vysoko účinnej kombinovanej výrobe a o zmene a doplnení niektorých zákonov

**Korešpondenčná adresa:** Martin Prčík, Katedra environmentálneho manažmentu, Fakulta európskych štúdií a regionálneho rozvoja, Slovenská poľnohospodárska univerzita v Nitre, Tr. A. Hlinku 2, 949 74, Nitra, Slovensko, martin.prcik@uniag.sk

# **NEGATIVE PHENOMENON OF THE LAND GRABBING? ASSUMPTIONS, CAUSES AND POSSIBLE IMPACTS OF ITS EXISTENCE, LITERATURE REVIEW**

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## **Abstract**

The development of agriculture in connection to the protection of agricultural land is currently a discussed topic worldwide. Agricultural land is a significant natural resource which represents one of the conditions for the quality of life of the individuals. It fulfills many key ecological (base of biodiversity, biomass, food production, etc.) and non-ecological (base for human activity, source of minerals, etc.) functions in society.

From the point of view of its preservation, the protection is therefore important, both in terms of quantitative and qualitative attributes of agricultural land. Due to many factors such as inappropriately set of legislation or national strategies, it may be devalued, resulting in a decline or complete loss of the soil quality. There are many authors who examine the causes or consequences of these phenomena in their studies. One of them is the increased concentration of land owned by legal entities or large foreign companies, who do not always use the land only for agricultural purposes. This phenomenon, known as "land grabbing", is increasingly the subject of interest not only of the EU bodies. Due to the fact that there is no internationally accepted definition or global patterns for the analysis of this term, which complicates the availability of data and the realization of research in this area, the paper aims to summarize the relevant researches and literature on the phenomenon, based on the analysis of available secondary sources with the intention to provide a comprehensive and objective evidence of current knowledge in the field of land grabbing. The result is a general literature review providing the views on definition of the term land grabbing, as well as scientifically formulated assumptions and causes of its origin or possible impacts of existence. In general, land grabbing is defined by the authors as the process of large-scale investment to acquire the agricultural land by legal entities, large companies, governments or individuals, especially in order to meet global requirements such as growing demand for food, biofuels, industrial commodities, urban development and, last but not least, to gain a competitive advantage in the land market. This means it may not be a problem only in developing countries, but is also increasingly occurring in other Member States of EU, especially those characterized by a complicated land ownership structure, a cheap purchase price of agricultural land or inefficient systems of institutions on the field of soil protection. These assumptions offer the mentioned subjects in the land market certain possibilities for the so-called "speculative purchases". Studies show that land grabbing in some ways may lead to the creation of positive effects supporting the development of rural and backward areas, such as increasing productivity, creating new jobs or supporting the creation of innovation in agriculture. Ultimately, it needs to be understood primarily in the terms of negative consequences, as many authors emphasize that land grabbing is realized in most cases without taking into account its social or environmental impacts, and often leads to the human rights conflict. Increased concentration of agricultural land ownership in the hands of small quantities of owners leads to the conflicts in access and land use, causing a wide range of negative impacts.

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## **Keywords**

agricultural land, land concentration, land grabbing

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## Úvod

Poľnohospodársky sektor je v súčasnosti považovaný za stagnujúce obdobie. Kým v minulosti predstavoval bezkonkurenčne najsilnejšie odvetvie s produkčnými i mimoprodukčnými outputmi, v mnohých krajinách ho z tejto pozície vytlačil práve sektor priemyselného spracovania (Szabo a kol., 2015).

Mnohé faktory ako situácia v oblasti energetiky, finančné problémy, rozsiahle celosvetové klimatické zmeny, pokles biodiverzity a s tým spojené výkyvy v poľnohospodárskej produkcii viedli k vzniku potravinovej a v konečnom dôsledku hospodárskej krízy datovanej v období rokov 2007-2009, ktorá masívne zasiahla viaceré krajinu (Borras a kol., 2011; De Schutter, 2011; Leacha kol., 2012; McMichael, 2012).

Následkom krízy bolo okrem iného zvýšenie cien energie a obavy z nedostatku potravín v dôsledku zvýšeného dopytu. Tak vzniklo prostredie, v ktorom poľnohospodárstvo a jeho komodity čoraz viac priťahovali investičný záujem. Vo výsledku sa celosvetovo dramaticky zvýšili investície do poľnohospodárskej pôdy. Ich cieľom bolo prvorado uspokojiť globálny dopyt po potravinách prostredníctvom kommerčnej rastlinnej i živočíšnej výroby, zvýšiť výrobu biopalív a iných priemyselných komodít (Gardner, 2012; Holmes, 2014; Bluwstein, 2017). Ochrana biodiverzity, povodí či zmierňovanie celkových zmien v podnebí boli a stále sú až druhoradými cieľmi (Leach a kol., 2012; Tienhaara a kol., 2012; Scheidel a kol.; 2018).

V priebehu pár rokov bolo na globálnom trhu prenajatých desiatky miliónov ha poľnohospodárskej pôdy (Cotula, 2012; Hall a kol., 2015), pričom podľa celosvetových odhadov bolo po roku 2008 predmetom investícií a pozemkových obchodov približne 45 až 227 miliónov hektárov poľnohospodárskej pôdy (Deininger, 2011). Najvýraznejšie sa tento trend prejavil a dosiaľ prejavuje na územiaciach Južnej Ameriky (Borras a kol., 2012).

Vzhľadom na svoju rozsiahlosť pritiahlí investície do pôdy globálnu pozornosť, pričom široká verejnosť ich začala označovať pojmom "land grabbing". Vyjadrovala predovšetkým obavy z ich dopadov, nakoľko bolo preukázané, že mnohé pozemkové transakcie sú nedostatočne konzultované a tým pádom nereflektujú záujmy obyvateľov daného územia či predovšetkým samotných pôvodných užívateľov pôdy. To vedie k porušovaniu základných ľudských práv (právo vlastníctva) a následne negatívnym sociálnym či environmentálnym dopadom (Selfa a kol., 2018; Dwyer, 2015; Oberlack a kol., 2016; Thuon, 2018; Fujiwara, 2020).

Je potrebné zdôrazniť aj nedostatočnú transparentnosť či demokratické rozhodovanie čo sa týka transakcií s poľnohospodárskou pôdou, v dôsledku čoho verejnosť nie je s existenciou či rozsahom danej situácie dostatočne oboznámená (International Land Coalition, 2011). Ďalšie výskumy tiež poukazujú na to, že investori vystupujúci ako aktéri pôdnych transakcií pochádzajú prevažne zo zahraničia a predmetom ich investícií je v priemere viac ako 200 ha na obchod (Rullia kol., 2013).

S vzrástajúcimi investíciami v oblasti poľnohospodárskej pôdy boli zaznamenané aj početné vedecké výskumy mnohých odborných pracovníkov v tejto oblasti. Vzhľadom na to, že ako Európska únia tak aj mnohé štáty sa začali problematikou land grabbingu ako environmentálnej hrozby zaoberať len v nedávnej minulosti, prevažná väčšina štúdií či výskumov je tak limitovaná geografickým územím a dostupná literatúra v tejto oblasti je považovaná za značne fragmentovanú, pričom absentujú globálne vzorce vymedzujúce jednotnú definíciu či charakteristiku skúmaného javu, v dôsledku čoho sú realizované kvantitatívne a kvalitatívne výskumy v oblasti danej problematiky skreslené (Edelman a kol., 2016).

Prostredníctvom systematického výskumu literatúry v tejto oblasti je preto potrebné vytvoriť objektívny prehľad, ktorý zosúladí a poukáže na aktuálny stav empirických poznatkov v oblasti zaberania pôdy.

## Materiál a metódy

Príspevok si kladie za cieľ analyzovať a zosumarizovať príslušnú literatúru výskumníkov k aktuálnemu fenoménu land grabbing. Predmetom výskumu bude najmä:

- pohľad autorov, štátnych či medzinárodných orgánov a inštitúcií na definíciu pojmu land grabbing,
- sumár najčastejších predpokladov a príčin vedúcich k vzniku či podnecujúcich existenciu land grabbingu,
- diskusiu o možných dopadoch spojených s existenciou land grabbingu.

Vzhľadom na značnú fragmentáciu skúmanej problematiky a nedostatok sekundárnych či primárnych dát, ktoré do veľkej miery limitujú výskum v tejto oblasti, bude príspevok konštruovaný ako prehľad literatúry so zámerom poskytnúť komplexnú a objektívnu analýzu súčasných poznatkov na tento aktuálny fenomén.

Pracovať budeme len so sekundárnymi zdrojmi, najmä zahraničnými, ale aj slovenskými štúdiami a výskumami, legislatívnymi aktami či správami orgánov a medzinárodných inštitúcií.

Z metodického hľadiska budú v príspevku použité metódy obsahovej analýzy a ľažby textu. Na získanie informácií o dostupnej literatúre v oblasti skúmanej problematiky využijeme webový vyhľadávací nástroj vedeckej literatúry Google Scholar a jeho možnosti filtrovania. Výsledky vyhľadávania budú následne individuálne skúmané a triedené podľa obsahových kritérií kľúčových slov ako: land grabbing, large-scale acquisitions of agricultural land, speculative purchases of agricultural land, assumptions and causes of land grabbing, impact/s of land grabbing. Celkovo bude preskúmaná vzorka 49 zdrojov.

## Výsledky a diskusia

### 1. Teoretické prístupy k definovaniu land grabbingu

Nakoľko samotný termín land grabbing nie je v mnohých štátoch zaužívaný, označujú ho niekoľkými príbuznými pojмami. Býva používaný najmä v súvislosti s problematikou land concentration, akvizíciemi pozemkov či tzv. špekulatívnymi nákupmi pôdy alebo ľudovo povedané zaberaním či zhabávaním polnohospodárskej pôdy (Burja a kol., 2020).

Sústrediac sa tak na príbuzné pojmy, ktorými mnohé štáty najčastejšie nahrádzajú termín land grabbing, považujeme za dôležité definovať najmä pojmy koncentrácia vlastníctva a špekulatívne nákupy polnohospodárskej pôdy.

Koncentrácia vlastníctva je zvyčajne definovaná ako nadobúdanie vlastníctva veľkého počtu polnohospodárskych pozemkov jedným či niekoľkými vlastníkmi resp. skupinou majetkovo prepojených vlastníkov. Tí sú vo väčšine prípadov rezidentmi iných štátov, prípadne ich charakterizuje prevažujúca až absolútна majetková účasť s pôvodom v inom štáte. Jav koncentrácie pozemkov je spojený s narušením rovnosti šancí účastníkov trhu s polnohospodárskymi pozemkami, nakoľko dominantní vlastníci majú na danom trhu monopolné až bezkonkurenčné postavenie, čím znemožňujú príležitosti menej solventných účastníkov k nadobudnutiu polnohospodárskych pozemkov (Ministerstvo pôdohospodárstva a rozvoja vidieka SR, 2020).

Špekulatívnosť nákupu poľnohospodárskych pozemkov spočíva v tom, že nadobúdateľ v prvom rade do takto získanej komodity deponuje svoj kapitál s cieľom dodatočne ho zhodnotiť, pričom nie je primárne motivovaný poľnohospodárskym ani iným praktickým využitím poľnohospodárskeho pozemku. Takto špecifikovaní nadobúdatelia – predovšetkým právnické osoby vlastníctvo kumulujú s cieľom posilniť svoju konkurenčnú pozíciu v lokálnom a regionálnom rámci či dokonca ovládnuť ekonomický reťazec (Ministerstvo pôdohospodárstva a rozvoja vidieka SR, 2020).

Výraz land grabbing v negatívnej konotácii začali prvotne využívať aktivistické skupiny, bojujúce za environmentálne či agrárne práva, ktoré tak protestovali proti alarmujúcim investíciám do poľnohospodárskej pôdy. Pojem sa následne uchytí aj v médiách, až ho začala ako termín univerzálne pomenúvajúci veľkorozsiahle pozemkové transakcie používať široká verejnosť, vedeckých pracovníkov nevynímajúc (Borras a kol., 2011).

Jednotná definícia pojmu však doposiaľ nebola prijatá. Mnohí autori ho používajú univerzálne, označujúc akékoľvek pozemkové transakcie, iní zas len v súvislosti s tými zahraničnými. Mnohé publikácie s pojmom land grabbing operujú v súvislosti s akvizíciami poľnohospodárskej pôdy výlučne na nepoľnohospodárke účely. Trhové investície do pôdy totiž vyvolávajú koncentráciu vlastníctva poľnohospodárskej pôdy, t.j. akumuláciu vlastníctva pôdy v rukách malého počtu vlastníkov, najmä tých, ktorí nie sú poľnohospodári alebo poľnohospodárstvo nie je ich hlavnou činnosťou (Borras a kol., 2011; De Schutter, 2011; Aabo, 2012; Ruli a kol., 2013; Bunkus a kol., 2018; Marcello, 2019; Burja a kol., 2020; Yang a kol., 2021).

Čo sa týka svetových organizácií, Organizácia pre výživu a poľnohospodárstvo definuje land grabbing ako rozsiahle akvizície pôdy za účasti zahraničných aktérov, ktoré spôsobujú ďalekosiahle negatívne následky v oblasti potravinovej bezpečnosti (Smith a kol., 2016).

K jednej z najčastejšie využívaných definícií land grabbingu, z ktorej vychádzajú i mnohí autori patrí tá, ktorú uvádzajú Tiranská deklarácia, v zmysle ktorej k land grabbingu dochádza v prípadoch, kedy je zaberanie pôdy v rozpore s ľudskými právami alebo keď dotknutí užívateľia pôdy neboli s touto skutočnosťou vopred oboznámení, resp. záber bol realizovaný bez ich predchádzajúceho súhlasu. Takisto pri land grabbingu dochádza k významným sociálnym, hospodárskym a environmentálnym vplyvom, transakcie nie sú založené na transparentných zmluvách, ktoré by jasne vymedzovali záväzky či výhody z nich vyplývajúce pre všetky zúčastnené strany. Z toho vyplýva že land grabbing je v prvom rade zásahom do ľudských práv, ako je právo na vlastníctvo pôdy, právo na informácie a kvalitu života, a pod. Závažným problémom je tiež netransparentnosť konania vládnych orgánov či samotných aktérov voči verejnosti a predovšetkým vo vzťahu k dotknutým osobám (International Land Coalition, 2011).

Pojmu land grabbing sa venuje niekoľko autorov či vedeckých výskumníkov ako Borras a kol., 2011; Bunkus a kol., 2018; Lazíková a kol., 2019; Palšová, 2020; Burja a kol., 2020; Yang a kol., 2021, ktorí sa zhodujú v tom, že na špecifikáciu definíciu pojmu je potrebné objektívne preskúmať viacero príbuzných pojmov, čít a javov. Zdôrazňujú, že land grabbing zahŕňa okrem spomínaných akvizícií pozemkov aj tzv. snahu o získavanie kontroly, a teda moci kontrolovať pôdu, jej zdroje a ich užívanie. Zaberanie pôdy tak predstavuje kontrolu nad množstvom pôdy, ktorá je významnejšia, akoukoľvek osobou alebo subjektom (t.j. verejným alebo súkromným, zahraničným alebo domácim), akýmkoľvek prostriedkami (t.j. „legálnymi“ alebo „nezákonnými“) na účely špekulácií, ťažby, kontroly zdrojov alebo komodifikácie na úkor roľníkov, a pod.

Autori takisto uvádzajú, že je potrebné komplexne preskúmať historický vývoj súvislostí spojených s existenciou land grabbingu a najmä využiť širokospektrálny pohľad zahŕňajúci všetkých aktérov.

## **2. Aktéri, predpoklady a príčiny vzniku a existencie land grabbing**

Nakoľko skúmané štúdie poukazujú na to, že aktérmi záberov poľnohospodárskej pôdy označovanými ako kupujúci či pôžičky poskytujúci investori sú vo väčšine prípadov štaty či medzináročné spoločnosti, noví inštitucionálni vlastníci pôdy, ako sú dôchodkové fondy alebo hedzové fondy alebo súkromné kapitálové spoločnosti, je potrebné skúmať predovšetkým ich motiváciu ako hnaciu silu v súvislosti s akvizíciami pôdy (Gunnoe a kol., 2014).

V tomto procese celkovo vystupuje množstvo aktérov, počnúc miestnymi aktérmi, ako sú národné elity nevynímajúc podnikové osobnosti, štátnych zamestnancov, politikov a vedúcich spoločenstiev alebo lídrov, až po nadnárodné spoločnosti, ktoré mobilizujú finančný kapitál (Burja a kol., 2020).

Politické argumenty štátov prostredníctvom prijímania nových politík podporujúcich a umožňujúcich investície do pôdy poukazujú na širokú distribúciu vlastníctva poľnohospodárskej pôdy ako na základ či hnací motor blahobytu miestnych ekonomík a vidieckych spoločností. Štaty však nedostatočne zohľadňujú všetky možné dopady a následky týchto rozhodnutí. Problémom sa tak javí dostupnosť pôdy súvisiaca s neefektívou správou vecí verejných či absenciou miestnych práv na ochranu pôdy (Angelo, 2017; Azadi a kol., 2019).

Pre investorov s poľnohospodárskym ale i nepoľnohospodárskym zázemím sa dopyt po pôde zvýšil najmä v súvislosti s potrebou kontroly trhu vyvolanou následkami potravinovej krízy v rokoch 2007 – 2008, ktorá spôsobila zvýšený dopyt až závislosť po potravinách, energiách, atď. (Holmes, 2014; Bluwstein, 2017).

Další spúšťač pozemkových transakcií vychádza priamo zo strany súčasných vlastníkov pôdy a ich podnikov. Príkladom sú družtvá, ktoré vzhľadom na svoju veľkosť a počet zamestnancov potrebujú na zabezpečenie svojej hospodárskej a produkčnej činnosti financie akcionárov. Tými sú často zahraniční investori, ktorí tak následne získajú určitý podiel a rozhodovaciu moc v oblasti poľnohospodárskej pôdy týchto družstiev. Mnohí vlastníci poľnohospodársku pôdu predávajú či prenajímajú aj z toho dôvodu, že ich potomkovia ako mladá generácia nemajú motiváciu obrábať pôdu, resp. pracovať v poľnohospodárstve v dôsledku nízkej súčasnej atraktívnosti tohto sektora (Bunkus a kol., 2018).

Akvizície do poľnohospodárskej pôdy sú tak podporované aj častými štrukturálnymi zmenami, ktoré majú za cieľ zvýšiť atraktívnosť poľnohospodárskeho sektora. Moderné agropodnikanie však pôdu vníma skôr ako ekonomický zdroj dôležitý predovšetkým z hľadiska produkcie a zabezpečovania potravinovej sebestačnosti než socioekologický zdroj zabezpečujúci základné ľudské potreby a reprezentujúci ľudské práva v súvislosti s udržateľnosťou a tvorbou krajiny (Aabo, 2012).

Autori sa zhodujú v tom, že zaberanie pôdy vo všeobecnosti podporuje niekoľko faktorov ako napríklad rozdielne ceny pôdy v štátoch, špekulácie s pôdou, v dôsledku ktorých sa mení charakter využívania pôdy z poľnohospodártva na účely rozširovania miest v dôsledku urbanizácie, výstavbu nehnuteľností či rozvoja priemyslu. Významnú rolu ako motivátor land grabbingu predstavuje aj rozdrobená štruktúra pozemkov, samotné procesy privatizácie a scel'ovania pozemkov, poľnohospodárske, potravinové a energetické politiky, ale aj obchodná, finančná a investičná politika a dotácie EÚ, ktoré viedli k zvýšenému záujmu o poľnohospodársku pôdu (Kay a kol., 2015; Bunkus a kol. 2018; Azadi a kol., 2019; Burja a kol., 2020).

Nejednotné ceny poľnohospodárskej pôdy vedú k špekuláciám, z ktorých nepochybne prosperujú subjekty disponujúce finančnými zdrojmi (Burja a kol., 2020).

Z konkrétnej prípadovej štúdie Kaya a kol. (2015) vyplýva, že zaberanie poľnohospodárskej pôdy je v Európe vzrástajúcim, no stále menej bežným javom v porovnaní so situáciou v Afrike, Južnej Amerike alebo Ázii. Autori prezentovali údaje z rôznych zdrojov

vrátane LandMatrix a anekdotických dôkazov o Rumunsku, Bulharsku, Maďarsku, Poľsku, Slovensku, Českej republike, Litve a Lotyšsku. Land grabbing sa vo väčšej miere teda týka hlavne bývalých transformujúcich sa krajín, v ktorých dochádza k rozsiahlemu nákupu poľnohospodárskej pôdy, nakoľko prestavujú investičné príležitosti vyplývajúce najmä z dôvodu nízkych úrokových sadzieb, relatívne lacných cien pôdy (ale súčasne cien, ktoré si miestni drobní poľnohospodári nemôžu dovoliť) a platieb na plochu EÚ (Marcello, 2019; Burja a kol., 2020). V rámci Európskej únie existuje voľný vnútorný trh umožňujúci okrem iného aj nadobúdanie pôdy. Zároveň ceny pozemkov vo východnej Európe sú v porovnaní s cenami v západnej Európe oveľa nižšie, v dôsledku čoho dochádza k nákupom a predajom poľnohospodárskej pôdy naprieč rôznymi krajinami (Bunkus a kol., 2018).

### **3. Dopady spojené s existenciou land grabbingu**

V súčasnosti vzhľadom na verejné znepokojenie vyplývajúce zo situácie, že počet nadnárodných investícií do pozemkov a rozsiahlych pozemkových akvizícií vzrástol na bezprecedentnú úroveň, fenomén land grabbing pritahuje veľkú pozornosť zo strany medzinárodných rozvojových organizácií, agentúr OSN či občianskej spoločnosti a zároveň vyvoláva vedecké diskusie (Marcello, 2019).

Dopady land grabbingu považujú mnohí autori za náročne predvídateľné, nakoľko závisia od mnohých faktorov ako je geografická poloha, rozsah zaberanej pôdy, účely jej ďalšieho využívania, transparentnosť takejto činnosti, atď. Názory na efekty a vplyvy tohto fenoménu sa tak v mnohých prípadoch rozchádzajú, nakoľko je preukázateľné, že land grabbing v istej miere na celkový rozvoj krajiny či spoločnosť pôdobí tak pozitívne ako aj negatívne (Azadi, a kol., 2019).

Medzi pozitívne efekty land grabbingu, najmä čo sa týka rozvoja krajiny z ekonomickejho hľadiska patrí napríklad vyššia nákladová efektívnosť výroby, produktivita, zamestnanosť a rozvinutá infraštruktúra. Investície do pôdy tak môžu mať rôzne potenciálne pozitívne vplyvy. Za primárne výhody sa často označujú skôr rozvojové príležitosti ako pôžičky a iné druhy finančných prevodov spojených s akvizíciami. Autori poukazujú aj na to, že mnohé hostiteľské vlády prvotne umožňujú investorom zaberáť pôdu s vidinou ekonomickejho posunu krajiny spojeného s prílivom finančných príležitostí na rozvoj infraštruktúry a tvorbu pracovných príležitostí. Výnimcočnú príležitosť predstavujú záväzky v oblasti prenosu know-how spojené s financiami, ktoré umožnia poľnohospodárom implementovať popredné technologické inovácie, ako sú napríklad drony, pokrytie polí širokopásmovým internetom či monitorovanie vlastností pôdy prostredníctvom satelitných systémov a v neposlednom rade tiež ekologické investície ako je inteligentné šľachtiteľstvo, technológie push-pull so systémom hnojenia založeným na biodiverzite, atď. (Vasile a kol., 2015; Bunkus a kol., 2018; Yang a kol., 2021).

Medzi potenciálne sociálne prínosy land grabbingu vzhľadom na cielovú skupinu chudobných obyvateľov na vidieku patria najmä výstavba vidieckej infraštruktúry, škôl a zdravotných miest, nové pracovné miesta a pracovné príležitosti, poľnohospodárske a mimopoľnohospodárske činnosti, šírenie nových technológií a zvýšená výroba potravín, čo vedie k väčšej dostupnosti na miestnych trhoch a potravinovej sebestačnosti (De Schutter, 2011; Azadi a kol., 2019; Burja a kol., 2020; Yang a kol., 2021).

Väčšinový podiel recenzovaných publikácií (De Schutter, 2011; Angelo, 2017; Azadi a kol., 2019; Burja a kol., 2020; Yang a kol., 2021) na túto tému často hovorí výslovne o negatívnych konotáciách zaberania pôdy, pričom zdôrazňuje sociálne, ekonomicke a environmentálne dopady land grabbingu, ktoré negatívne ovplyvňujú rozvoj územia. Štúdie dokonca hovoria o tom, že akvizície pôdy by mali byť označené pojmom land grabbing až v prípade, kedy nastanú negatívne dopady, tzn. že by nemal byť v žiadnom rozsahu spájaný

s pozitívnymi účinkami, ktoré môžu v niektorých prípadoch akvizície pôdy nastať (Gunnoe, 2014; Bunkus a kol., 2018).

Rozsah tohto javu vzbudzuje značné etické obavy týkajúce sa predovšetkým vyvlastňovania spoločného majetku a s tým spojeného porušovania ľudských práv, vplyvov na životné prostredie a celkovej nerovnováhy sín orgánov štátnej správy a verejnosti pri rokovaniach o pozemkových dohodách (Angelo, 2017).

Rozsiahle nadobúdanie pôdy viedie k existencii a koncentrácií malého počtu poľnohospodárskych podnikov, ktoré tak vlastnia, spravujú a kontrolujú obrovské plochy pôdy. Tieto akvizície reštrukturalizujú tradičné rodinné modely podnikov do veľkých poľnohospodárskych výrobných systémov založených na komerčných technológiách, čo následne môže viest' k tomu, že malí poľnohospodári sa vzdajú pozemkových vlastností a v konečnom dôsledku vzniká na trhu s poľnohospodárskou pôdou nízka konkurencieschopnosť či monopol (De Schutter, 2011). Veľké poľnohospodárske podniky následne predstavujú hrozbu pre európsku potravinovú bezpečnosť, potravinovú suverenitu a miestne potravinové kultúry, zo sociálneho hľadiska zapríčinujú nezamestnanosť a chudobu na vidieku či emigráciu a z environmentálneho hľadiska stoja za degradáciou a celkovým úpadkom poľnohospodárskej pôdy (European Commission, 2016).

Medzi socio-ekonomicke negatívne dôsledky, ktoré sa vo väčšine prípadových štúdií spomínajú, patrí rozsiahla strata zamestnania a príležitostí v oblasti agrosektora a s tým spojené vysídlenie, nakoľko si pôvodní poľnohospodári musia na vlastné náklady zabezpečiť náhradné zamestnanie. Mnohé prípady poukazujú na rozsiahle vyvlastňovanie zo strany štátu, ktorý si poľnohospodársky pozemok nárokuje, pričom poukazuje na neformálne práva prístupu k nemu. Tieto prípady sú často sprevádzané nulovou kompenzáciou majiteľom zo strany štátu (Beekman a kol., 2012; Ansoms, 2013).

Sociálne efekty land grabbingu ako je vyhostenie či vysídlenie obyvateľov v konečnom dôsledku môže viest' k sociálnym nepokojom a protestom dotknutých skupín obyvateľov, no odchod obyvateľov predovšetkým spôsobuje tzv. „vymazanie kultúrnych praktík či spomienok“ v danom území (Burja a kol., 2020).

Za určitých podmienok môže land grabbing viest' k potravinovej sebestačnosti, avšak negatívnym dôsledkom je, že z tejto skutočnosti profitujú predovšetkým skupiny obyvateľstva vo vyšších ekonomických triedach na úkor ostatných (Rietberg a kol., 2018; Bottazzi a kol., 2018).

Environmentálnym vplyvom land grabbingusa v porovnaní s ekonomickými venovalo výrazne menej štúdií. Celoplošne však ako najvýznamnejšie problémy v súvislosti s týmto fenoménom opisujú degradáciu či kontamináciu pôdy najmä v dôsledku masívneho používania chemických hnojív a pesticídov (Friis a kol., 2016; Adams a kol., 2019).

Zaberanie pôdy v blízkosti obývaných oblastí preukazne spôsobovalo vážne znečistenie vody, stratu biodiverzity a ekosystémov (Lagerkvist a kol., 2014; Chilombo a kol., 2019).

Zaberanie pôdy na nepoľnohospodárske účely ako je priemysel, infraštruktúra či bývanie spôsobuje azda najvýraznejšie environmentálne problémy, kedy okrem vyššie spomínaných dochádza aj k zmenám druhov pozemkov či znečisteniu ovzdušia (Milgroom, 2015; Lunstrum, 2016). V konečnom dôsledku tak dochádza k nezanedbateľnému znečisťovaniu či poškodzovaniu životného prostredia, čo ovplyvňuje kvalitu ľudských životov (Sanchez-Ayala a kol., 2019).

## Záver

Dôsledkom nejednoznačnej definície a značnej fragmentovanosti literatúry v oblasti land grabbingu sú protichodné názory inštitúcií, výskumníkov či iných autorov. Preto bolo cieľom príspevku analyzovať a zosumarizovať príslušnú literatúru k aktuálnemu fenoménu so

zámerom poskytnúť tak komplexnú a objektívnu analýzu súčasných poznatkov, ktorá by uľahčila realizovanie výskumov v oblasti danej problematiky.

Sumár literatúry bol rozdelený do troch častí, zaobrajúc sa tak pohľadmi organizácií, inštitúcií či samotných vedeckých autorov na definovanie termínu land grabbing, na odhalenie aktérov, ktorí v rámci problematiky priamo operujú či faktorov, ktorými sú motivovaní a poháňaní. V neposlednom rade sme tiež pracovali s publikáciami, ktoré priamo diskutujú o možných, ale aj reálnych následkoch existencie land grabbingu.

Čo sa týka označovania rozsiahlych pôdnich akvizícií pojmom land grabbing, mnohé štaty sú v tomto smere stále opatrné. Vo veľkej miere sú využívané príbuzné pojmy ako land concentration, špekulatívne nákupy či dokonca zhabávanie pôdy, čo je jedným z dôvodov, prečo doposiaľ nebola prijatá jednoznačná medzinárodne uznávaná definícia uvedeného termínu. Po analýze príslušnej literatúry môžeme vo všeobecnosti zhrnúť, že land grabbing je organizáciami, inštitúciami ale aj autormi definovaný prevažne ako proces rozsiahlych pôdnich akvizícií a nákupov, realizovaný rôznymi subjektmi ako sú veľké národné i medzinárodné, štátne či neštátne spoločnosti, právnické osoby ale aj jednotlivci, s cieľom získať kontrolu nad vlastníctvom a trhom s pôdou. Jav je sprevádzaný mnohými sociálnymi, ekonomickými či environmentálnymi negatívnymi efektmi, ako je predovšetkým vyvlastnenie pôvodných vlastníkov pôdy hraničiace s porušovaním základných ľudských práv.

Samotný vznik či existencia fenoménu land grabbing je podmienená najčastejšie problémami štátov s transformujúcim sa politickým systémom, rozdrobenou pozemkovou štruktúrou, komplikovanými vlastníckymi vzťahmi a tým pádom aj prístupom k pôde, lacnou nadobúdacou cenou pôdy, atď. V niektorých prípadoch sú to samotní vlastníci pôdy, ktorí ju ponúknu silným spoločnostiam či inštitúciám, v dôsledku súčasnej neatraktívnosti poľnohospodárskeho sektora sprevádzanej vyššou nezamestnanosťou, nízkymi mzdami, sezónnosťou práce a celkovou neochotou mladej generácie obrábať pôdu.

Pojednávania autorov o dopadoch land grabbingu na sektor poľnohospodárstva či celkovú krajinu sa tiež v mnohých pohľadoch rozchádzajú. Niektorí hovoria o pozitívnych efektoch, či už na ekonomiku, životné prostredie ale aj samotných obyvateľov územií v podobe znížených prevádzkových a produkčných nákladov, prílevu zahraničných investícií, rozvoja infraštruktúry, rastu zamestnanosti či zavádzania inovácií. Ďalšie publikácie pojednávajú o land grabbingu v negatívnej konotácii, spájajúc ho s vyvlastňovaním a stratou zamestnanosti, čo hraničí s emigráciou a sociálnymi nepokojmi, či stratou "kultúrnej hodnoty" danej krajiny, ale aj s degradáciou či úplnou stratou poľnohospodárskej pôdy a iných nežiaducích vplyvov na životné prostredie.

Názory autorov sú protichodné aj v zmysle konkrétnych špecifikácií a vlastnosti geografických lokalít, ktoré skúmali. To, čo možno z kritického hľadiska považovať za prípad vyvlastnenia tradičných používateľov pôdy, z iného pohľadu možno považovať za nevyhnutnú príležitosť pre rozvoj krajiny.

Vo všeobecnosti však možno zhrnúť, že land grabbing je rozsiahly fenomén, ktorý v dôsledku zvýšenej úrovne akvizícií poľnohospodárskej pôdy v predchádzajúcich rokoch vzbudil veľkú pozornosť. Napriek tomu, že medzinárodné organizácie ako Organizácia OSN pre výživu a poľnohospodárstvo (FAO), Medzinárodný fond pre poľnohospodársky rozvoj (IFAD), Konferencia OSN o obchode a rozvoji (UNCTAD) a skupina Svetovej banky presadzujú dobrovoľné prístupy k riadeniu rozsiahlych investícií do pôdy, je zrejmé, že tento jav si vyžaduje nepretržitú kontrolu a výskum, najmä čo sa týka na úrovni štátov s predikciou jeho vzniku (Burja a kol., 2020).

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# **INNOVATION ACTIVITIES OF SMALL AND MEDIUM ENTERPRISES AND ITS PROTECTION IN THE SLOVAK REPUBLIC**

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## **Abstract**

SME accounted for 99.9% of the total number of business enterprises in the Slovak Republic. The aim of the study is to analyze the implementation of SME innovative activities and to point out the need and barriers by the use of intellectual property rights protection in innovative activities of SME in the Slovak republic. Intellectual property in connection with the realization of research and development results is considered to be an important factor of innovation potential.

## **Keywords**

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SME, innovation, intellectual property rights

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## **Introduction**

Innovation and technology pose a tremendous opportunity for SMEs to increase global market access, succeed past the startup phase, aim for and achieve high growth, and better engage with international and environmental standards. SMEs are more innovative than larger firms, due to their flexibility and their ability to quickly and efficiently integrate inventions created by the firms' development activities (Qian and Li 2003, Verhees and Meulenbergh 2004.). Research supports the statement that SMEs engaged in innovation activities are better performers (Westerberg and Wincent 2008, Qian and Li 2003, Verhees and Meulenbergh 2004). Innovation in SME is introduced to play an essential role to meet the new requirement or existing market needs. It takes place through the provision of new products or processes, new service, advanced technologies, modern idea, creative thoughts, research and development with more powerful versions to organize the business (Nzove, 2013). Nowadays, innovation has been considered a driving force behind firm dynamics (Coad and Rao, 2008). There are different types of innovation. Innovation can come in various forms, including product innovation, organizational innovation, management innovation, production innovation, commercial/marketing innovation, and service innovation (Trott, 2008). Mazzarol and Reboud (2008) considered innovation to be related to new products or services, new production processes, new marketing techniques, and new organizational or managerial structures. Innovation may also involve technology, intellectual property, business, or physical activity (Sundbo 1998). Freeman and Soete (1997) emphasized the role played by the entrepreneur in the innovation process. OECD (2004) defined innovation as, the introduction of new or improved processes, products or services based on new scientific or technical knowledge and/or organizational know-how. Mazzarol and Reboud (2008) identified innovation as the realization of new products or services, new production processes, new marketing techniques, and new organizational or managerial structures.

Innovative SMEs which introduce new products or process have a higher demand for finance compared to other businesses; however, they have to face difficulties to receive the loan (Hall et al. 2016). Innovative firms are more likely to have better firm performance on the basis of higher profits and revenues (Asia Pacific Foundation of Canada, 2017). The first reason of innovative SMEs' restricted credit accessibility is the uncertain success of the

innovative activity (Coad and Rao, 2008). Investing in innovation becomes urgent in upgrading product quality, services, and cost savings, which are the core conditions for boosting competency. Innovative SMEs have been entitled as the motivation of boosting the economy and equal growth. Additionally, it has a great impact on expanding SMEs' competitive position. However, despite the noticeable performance of SMEs, there are a lot of barriers that prevent firms from innovation, such as high costs, the high uncertainty of success, weak authorization, etc. Among them, lack of external finance becomes a main obstacle that SMEs have to confront in their innovative operations (Nguyen et al., 2020).

The aim of the study is to analyze the implementation of SME innovative activities and to point out the need and barriers by the use of intellectual property rights protection in innovative activities of SME in the Slovak republic.

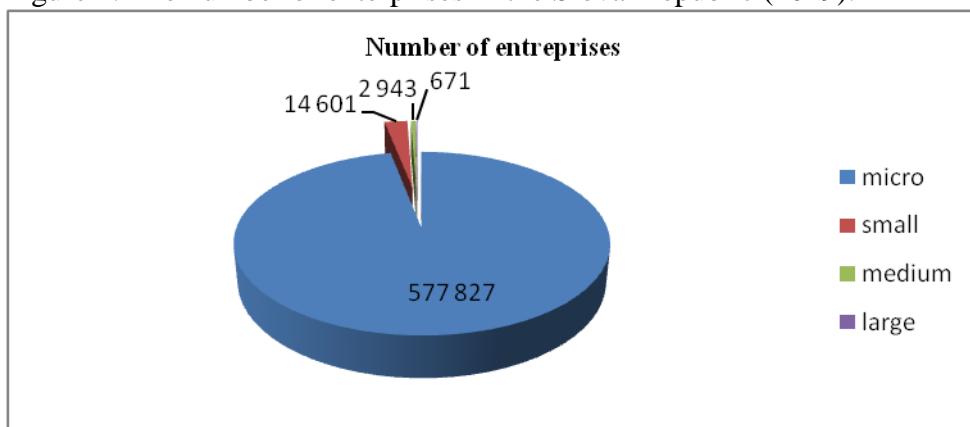
## Material and methods

This study used data from the Statistical Office of Slovak republic, Data based on Survey on the Access to Finance of Enterprises, 2019, data obtained from the Survey realized via Questionnaire, secondary data sources, professional literature, EU information sheets. The Questionnaire was realized among a group of 450 micro, small and medium enterprises in the Slovak Republic during the period of January 2019 until December 2019. Mathematical-statistical data analysis, method of comparison, analysis and scientific abstraction were used in the processing of the paper. The method of scientific abstraction applies to the area of the whole study, both in the theoretical and analytical part.

## Results and discussion

The importance of small and medium-sized enterprises (SME) in the Slovak economy is described by several indicators. In the monitored year 2019, small and medium-sized enterprises accounted for 99.9% of the total number of business entities in the Slovak economy. The number of active business entities registered by the Statistical Office of the Slovak Republic in 2019 reached 596,042, of which 595,371 represented SMEs. In a year-on-year comparison, their number increased by 6.3%. Of the total number of enterprises, 96.9% were micro-enterprises (577,827), 2.4% (14,601) small enterprises and 0.5% (2,943) medium-sized enterprises and 0.1% (671) large enterprises (Figure 1).

Figure 1. The number of enterprises in the Slovak republic (2019).



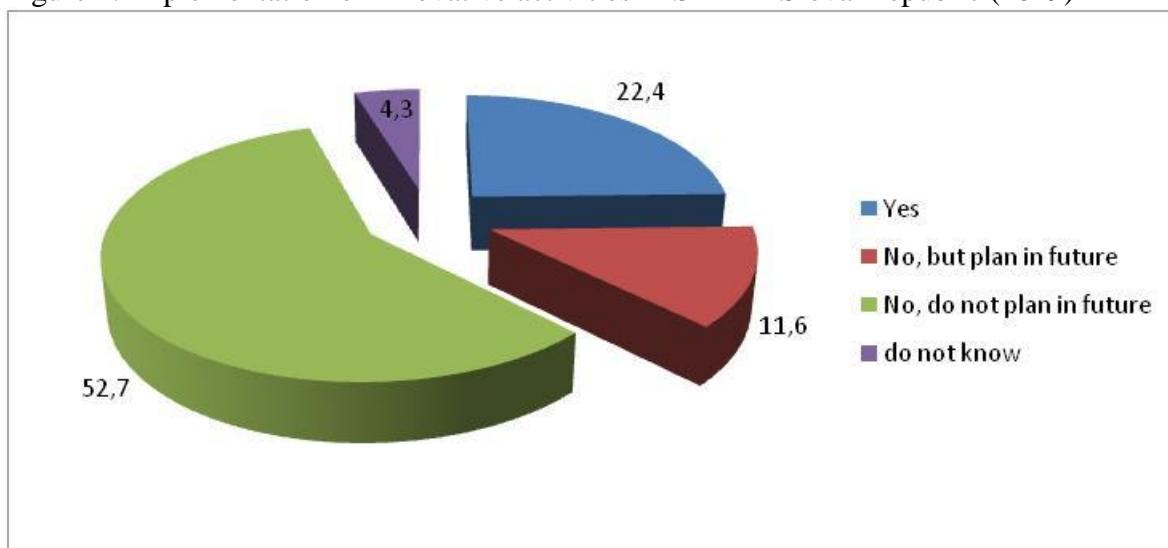
Source: Data source based on Statistical Office of the Slovak Republic, 2019

SMEs accounted for 73.8% of employment in the corporate economy and contributed more than half (54.9%) to total value added. The slowdown in the growth of the Slovak economy was also reflected in the economic performance of the small and medium-sized enterprise sector. The volume of SME exports decreased by 2.5% year-on-year. Despite the reduced volume of SME exports, the share of SMEs increased year-on-year, which was due to the fact that in the observed year 2019 there was a more significant decrease in the volume of exports of large enterprises compared to small and medium-sized enterprises (Statistical Office of the Slovak Republic, 2019).

The position of the size category of micro-enterprises in Slovakia is more significant due to their achieved share in the total number of business entities (compared to EU countries). Due to the increase in the number of small and medium-sized enterprises, the rate of business activity of SMEs also increased to 21.6% in 2019. Slovakia is also one of the EU countries with the highest number of small and medium-sized enterprises in relation to the total population (EU survey on SME, 2019).

As shown in Figure 2, based on realized Survey, only 22,4% of all SME implement different forms of innovations. 11,6% do not implement now but plan to implement innovations in future. The relatively high percentage (52,7%) of surveyed SME in the Slovak republic do not implement innovations, nor does it plan in the future. This finding may have a negative impact for the future performance of small and medium enterprises in the Slovak republic.

Figure 2. Implementation of innovative activities in SME in Slovak republic (2019)



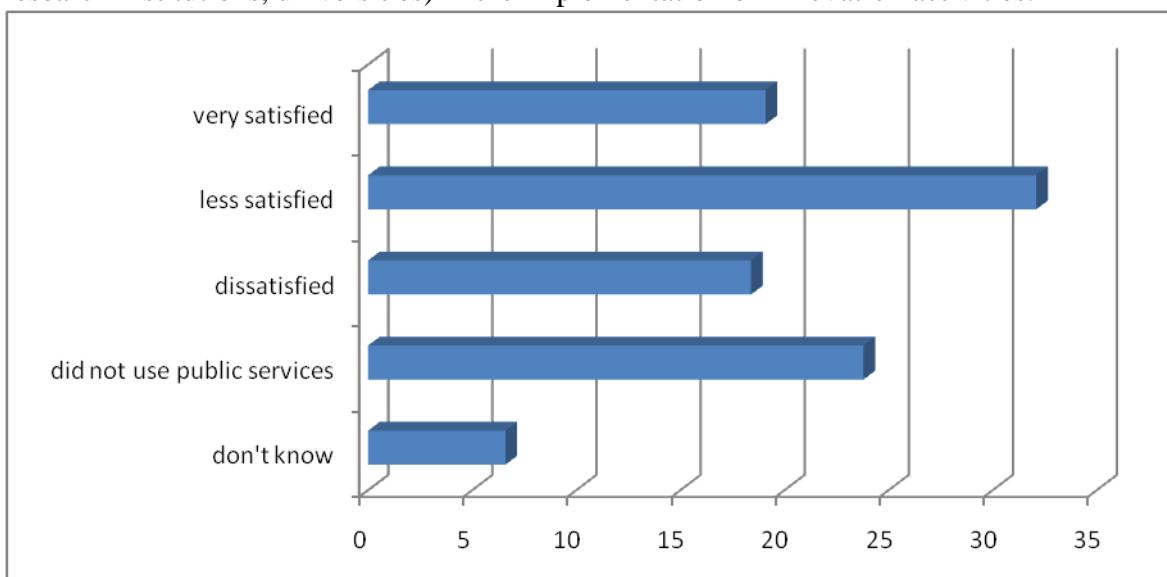
Source: Data based on realized Questionnaire, 2019

From the group of surveyed entities performing innovation, respectively planning to implement them a large part (70%) consider the implementation of innovative activities to be important, or very important. 30% of the subjects surveyed consider innovation activities to be important, or very important, especially with regard to increasing competitiveness, improving its market position and building its name, respectively brands, one of which pointed to the importance of providing fast and reliable services, the need to improve and streamline communication with clients and better informational technologies. Almost 40% consider innovations to be important, but their implementation depends on several factors, and it is not always possible to implement them. According to them, the main factor is the advantage of innovation, i.e. invested funds and time versus profit from innovation. Some of

the participants in the Survey also stated that it is necessary to look for a compromise between the survival and growth of the company that the implemented innovations are more of a procedural and organizational nature. Another of the participants expressed the opinion that it is necessary to look for a suitable form of financing innovations and emphasized the need for more financial support in this area, for example, in the form of supportive measures available for SME.

One of the supportive measures in the implementation of innovation activities by SME is also the cooperation with entities like state administration, research institutions and universities. Figure 3 shows the results of the Survey connected to the level of SME satisfaction with mentioned cooperation in the Slovak republic. Less satisfied (31,2%) was the dominant surveyed group of SME and very satisfied SME represented 20,6%. This group of SME was mainly represented by medium enterprises in agriculture and services, with the dominance of young entrepreneurs (under 29 years). The group of dissatisfied SME (17,1%) was represented mainly by small and medium enterprises in construction. Mostly the micro enterprises did not use the cooperation with other entities (23,4%).

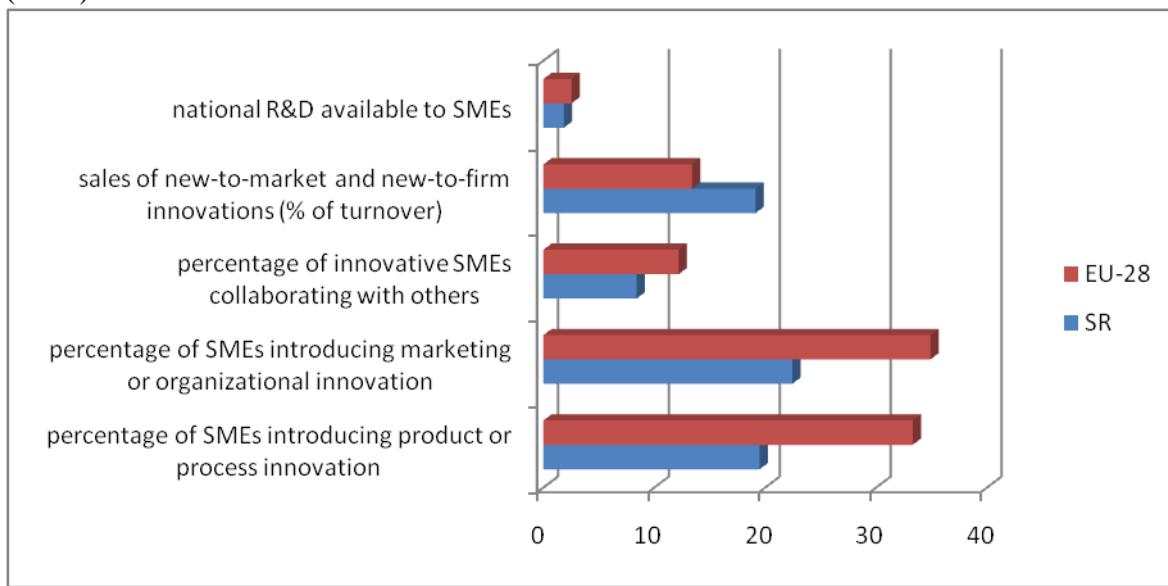
Figure 3. Satisfaction with the level of cooperation with other entities (state administration, research institutions, universities) in the implementation of innovation activities.



Source: Data based on realized Questionnaire, 2019

From the comparison of innovation activities of SME in the Slovak Republic and the average of EU-28 (Figure 4), we can assume that SME in the Slovak republic performs below the EU-28 average in skills and innovations, mainly by the collaboration with other entities, the introduction of a product or process innovation and by introducing marketing or organizational innovation. Above EU-28 average indicator was monitored by the percentage of turnover of sales of new-to-market and new-to-firm innovations. Innovation is essential for economic growth, and the majority of SMEs in EU proclaim to be innovative.

Figure 4. Comparison of SMEs innovation activities in the Slovak Republic and the EU-28 (2019)



Source: Data based on Survey on the Access to Finance of Enterprises (SAFA) and Slovak statistical Office, 2019

Promoting innovation and innovative solutions to support SMEs is particularly crucial. Innovation allows small businesses to strengthen and grow and to employ more people, which will ultimately lead to a larger and stronger EU economy. Therefore, innovation within SMEs needs to be encouraged in order to support the Commission's drive for smart, sustainable economic growth (EUIPO, 2019).

To the support mechanism of the European Commission for innovative SME was introduced Horizon 2020. This mechanism provides opportunities to support small and medium-sized enterprises, which have ambitions to grow and develop at a transnational level, not only through direct financial support but also through indirect means, with the primary objective of the challenge being to increase their innovation capacity. A specific tool was created to support SME innovation; the so-called SME Instrument focuses on the financial needs of internationally oriented companies in the implementation of high-risk ideas with high commercial potential. The SME Instrument is intended for all innovative SMEs that can enter new markets, grow to a transnational level and achieve a high return on investment.

However, under the Innovation in SMEs program is not only meant direct support through the mentioned instrument but also indirect support in the form of tailor-made projects and services, building partnerships and initiating the transfer of knowledge and experience from various areas needed for quality innovation capabilities of SMEs. At the same time, Horizon 2020 provides direct support to the Enterprise Europe Network, which is a key facilitator of better access to finance for SMEs. The access to finance for SME is crucial, mainly for innovative SME. As stated in several studies, SMEs have limited resources at their disposal, but the lack of resources in SMEs can be compensated for by flexibility, agility, and innovativeness (Qian and Li 2003, Acs and Yeung 1999). In developed countries, the scientific-research and innovation system is completed by a network of business centers and incubators; in Slovakia, this area is still less developed.

In the long term view is the position of small and medium-sized enterprises in the national economy important, especially in terms of contributions to total employment, added value and support economic development. Despite their key importance, SMEs have difficulties in implementing innovative activities and lag far behind in the field of intellectual property

protection. This situation is not only characteristic of Slovakia, as are other EU countries, including countries considered to be innovative leaders.

It is widely recognized that firms of all sizes find it difficult to appropriate the returns to innovation, leading to under-investment in research and development and innovation. One element of the policy response to this problem has been the development of legal forms of intellectual property protection such as patents and trademarks. In each case, the main objective is to limit imitation and help innovating firms appropriate the returns to their investment. (Athreye, Fassio, Roper, 2020). The subject of the realized Survey was also the use of elements of intellectual property (patents, trademarks, designs, etc.) in Slovakia. Slovakia lags far behind in this area, compared to EU average, a minimum number of patent applications have been filled in Slovakia, only less than 1% to EU average. In Slovakia, the most used registered intellectual property rights are trademarks, which are a reflection of rather non-technological innovations. The most important reason for the protection of intellectual property for most survey participants (70%) was to build their name, respectively brand, or striving for market visibility and differentiation from the competition. They consider the protection of their intellectual property to be important to very important, especially as a means of differentiating themselves from their competition and a way to protect their diversity. At the same time, however, some of them stated that it was necessary to consider whether such protection was financially advantageous. These entrepreneurs indicated that they were more interested in building their brand and trade name and therefore decided to register trademarks as a form of protection for their brand. At the same time, they were of the opinion that the protection of the intellectual property is probably more important in other sectors. They also stated (56%) that they do not have enough experience in this area and therefore do not know how to evaluate the importance of intellectual property as such. About 19% of enterprises in the Survey consider the protection of intellectual property to be important, but only in relation to selected own products. These participants also expressed the view that they did not consider this area to be vital or relevant in the current situation. 11% of entities stated that they did not see the need to protect their intellectual property for most of their products, given the nature and object of their business. Intellectual property rights play an important role in promoting innovation and investment protection, and Slovak legislation is in line with EU legislation. The European Commission also continues to support the unification and simplification of intellectual property legislation, including with a view to involving small and medium-sized enterprises in innovation activities.

Intellectual property provides a framework to support innovation and can help achieve all of these objectives. Indeed, recent studies have found that SMEs that have filed at least one intellectual property right are 21 % more likely to experience subsequent growth and 10 % more likely to become high-growth firms. However, many innovative SMEs do not protect their innovative assets through intellectual property rights (EUIPO, 2019).

Many SMEs fail to consider their intellectual property in their early stages and overlook the fact that it is one of their most valuable assets. Incorporating intellectual property in a business strategy not only distinguishes from competitors but also creates brand identity by giving the product a fiscal value. As an entrepreneur, it is the key element to identify how to envision the brand developing in the future. The focus should be on brand logo, slogans, and physical inventions such as prototypes or unique software codes. Identifying, protecting, and maintaining intellectual assets through a well-devised portfolio will boost the overall commercial value by potential investors or strategic partnerships. Defining the intellectual assets will help to determine the needs to be protected as a trademark or a patent.

Registering the brand as a trademark will give the entrepreneur the right to enforce legal action against anyone who infringes his intellectual assets. Businesses that use industrial property rights are more successful in terms of competitiveness. SMEs and their successful

growth are often driven by the capacity for international development within and outside the EU internal market. SMEs with intellectual property rights have been shown to perform better in economic performance than those without such rights. The owners of these intellectual property rights have 28% higher earnings per employee and are able to pay their employees 20% higher wages compared to those who do not own them. SMEs with intellectual property registration also tend to be bigger and generate higher profits (EUIPO, 2019).

## Conclusions

Based on the results, in the monitored year 2019, small and medium-sized enterprises accounted for 99.9% of the total number of business entities in the Slovak economy. From the comparison of innovation activities of SME in the Slovak Republic and the average of EU-28 we can assume that SME in the Slovak republic performs below the EU-28 average in skills and innovations. It can be assumed that SME are interested in the implementation of innovations (positive results in terms of introducing new innovations as well as in the field of mutual cooperation of SMEs) and at the same time achieving certain positive results, which could be reflected in employment and turnover. Slovakia therefore might have the potential to become an innovator in the region, but it is necessary to create a suitable innovation and business environment, as well as to support financing and investment in innovative projects and the improvement of SMEs' access to finance.

Nevertheless, SMEs in the Slovak republic continue to lag behind EU countries in the use of grants or venture capital. Finally, it is also necessary to raise awareness on how to protect innovation and intellectual property rights. SMEs in the Slovak Republic mostly do not use intellectual property rights because they think that the products and services they provide do not require such protection, but also because SMEs do not see the benefits of intellectual property protection, especially compared to the costs and time involved in securing this protection. Another reason is that SMEs' products are not always suitable for protection (depending on the industry).

In line with the conclusions, the following facts can be considered as the main barriers to the use of intellectual property rights by SMEs:

- the products provided by the companies are not suitable for protection,
- companies do not see the added value of protecting intellectual property,
- lack of knowledge about protection options and procedures for obtaining protection,
- insufficient understanding of application and registration procedures,
- financial complexity,
- the length and administrative complexity of the application process,
- distrust of SMEs in the effectiveness of protection and the complexity of enforcement.

Through effective industrial rights, companies can innovate their processes and technologies, making them more competitive and, ultimately, having a positive effect on a job promotion, which is a prerequisite for sustainable development and economic progress. Intellectual property in connection with the realization of research and development results is considered to be an important factor of innovation potential.

## Acknowledgment

This publication was supported by the Operational program Integrated Infrastructure within the project: Demand-driven research for the sustainable and innovative food, Drive4SIFood 313011V336, co-financed by the European Regional Development Fund.

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# SOME KEYS OF READING TO INTERPRET THE EU-MERCOSUR AGREEMENTS ON GEOGRAPHICAL INDICATIONS/

## ALGUNAS CLAVES DE LECTURA PARA INTERPRETAR EL ACUERDO UE-MERCOSUR EN MATERIA DE INDICACIONES GEOGRÁFICAS

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### Resumen

El presente trabajo, más que ser exhaustivo y reiterar conceptos y explicaciones respecto al tema que he ido desarrollando en diferentes estudios<sup>1</sup>, intenta puntualizar algunas observaciones personales para contribuir a interpretar los aspectos jurídicos del Acuerdo de Asociación Estratégica entre la Unión Europea y el Mercosur y el grado de conveniencia económica que puede tener la aprobación y puesta en vigencia del mismo.

En primer lugar, vale la pena puntualizar que la regla base que rige la materia de las indicaciones geográficas (a partir de ahora las llamaremos IG)<sup>2</sup> que involucra a las partes y que rige actualmente para ellas, aunque éste acuerdo no se ratifique o entre en vigencia y que también seguirá siendo norma supletoria de todo lo no acordado si el mismo sí entra en vigor, son las disposiciones de alcance multilateral dispuestas en el Acuerdo sobre los Aspectos de los Derechos de Propiedad Intelectual relacionados con el Comercio (ADPIC, también citado o conocido muchas veces por su acrónimo en inglés: TRIPS), incluido en los llamados acuerdos de Marrakech que, entre otras cosas, dieron nacimiento a la Organización Mundial del Comercio (OMC o WTO en inglés) que tiene, por otra parte, la función de seguimiento de dicho acuerdo y en cuyo ámbito se negocian sus modificaciones. De igual modo, puede decirse que todos los acuerdos que forman el sistema de la OMC son marco jurídico referencial para interpretar el pilar vinculado al comercio del Acuerdo entre la Unión Europea y el Mercosur.

En segundo lugar, como también sucedió al acordar en Marrakech donde la mayoría de los acuerdos se aceptaron bajo la cláusula de compromiso único, es decir, pudiéndose aceptarse o

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<sup>1</sup> Pastorino, Leonardo Fabio, *Derecho agrario argentino*, AbeledoPerrot, Buenos Aires, 2da. ed., 2011, Décimo Módulo, Capítulo IV, « Nombres geográficos » ; Pastorino, Leonardo, *La política europea de desarrollo rural sostenible : ¿Obstáculo o modelo para el Mercosur*, AlMargen, La Plata, 2005, Parte III, « El rol de los productos agrícolas de ‘calidad territorial’ en la política de desarrollo rural sostenible » ; Pastorino Leonardo, « Las indicaciones geográficas en el Acuerdo ADPIC y las negociaciones en curso » en Pastorino, Leonardo (director), *La agricultura en el ámbito internacional*, Ediciones Cooperativas y Facultad de Ciencias Jurídicas y Sociales de la Universidad Nacional de La Plata, Buenos Aires, 2007, ps. 211 y ss ; Pastorino Leonardo, La Justicia Argentina resuelve el caso de la indicación geográfica « La Rioja – Argentina » ante el reclamo del Consejo Regulador de la Denominación de Origen Controlada « Rioja » de España, Revista Iberoamericana de Derecho Agrario, Nº 7, marzo 2018, <https://ar.ijeditores.com/pop.php?option=publicacion&idpublicacion=75&iddedicion=1526>.

<sup>2</sup> Usaremos este nombre para incluir todo nombre geográfico protegido que pueda incluirse en la definición dada por el Acuerdo ADPIC de la OMC, incluyendo tanto indicaciones geográficas protegidas en sentido más específico como denominaciones de origen protegidas o controladas que son nombres usados en la normativa europea y argentina. Quedan en cambio excluidas las indicaciones de proveniencia porque en las normas internas estas no conectan la calidad del producto con el origen geográfico como si lo recepta el ADPIC para el que “indicaciones geográficas son las que identifiquen un producto como originario del territorio de un Miembro o de una región o localidad de ese territorio, cuando determinada calidad, reputación, u otra característica del producto sea imputable fundamentalmente a su origen geográfico (parag. 1, art. 22).

rechazarse en su conjunto y no aisladamente y no pudiéndose formular reservas, los acuerdos comerciales como el que referimos contienen una cantidad de aspectos y capítulos y la lógica negocial indica que algunos son propuestos o sugeridos con más énfasis por una parte y otros por la otra y luego al interior de cada uno también existe una lógica negocial para reglamentar o limitar las pretensiones de la contraria. Así, en este caso, tenemos el capítulo de comercio de bienes con lo relativo al acceso al mercado o eliminación o reducciones tarifarias donde los productos agrícolas son el punto generalmente impulsado por los países del Mercosur y los industriales por los europeos, aunque debería mirarse casos en concreto donde esa regla no se da, por ejemplo el de las aceitunas o aceite de oliva que podría interesar más a los países mediterráneos que a los del cono sur, que por eso buscaron protegerse al respecto. También tenemos servicios, compras gubernamentales, inversiones, normas sanitarias y tantos más todo lo que obliga a analizar en detalle la conveniencia o no de cada uno de ellos pero también en relación al resto de los acuerdos.

Las IG están incluidas en el capítulo de la propiedad intelectual, donde ya existen otros muchos temas a analizar y forman una bandera irrenunciable de la Unión Europea como lo acreditan todas las negociaciones multilaterales o bilaterales donde es parte y también los documentos, normas y jurisprudencia que regulan las indicaciones geográficas protegidas, las denominaciones geográficas protegidas, las especialidades tradicionales y las menciones tradicionales de los órganos de la Unión. Por lo tanto, vale la pena considerar que el tema estará siempre en la mesa de negociación y que condiciona cualquier acuerdo global.

Ahora entrando al contenido específico de la materia en el Acuerdo, vale la pena indicar que es complejo y está minuciosamente tratado y que resulta difícil de sintetizar para quien no se encuentra familiarizado con el mismo, pero en un esfuerzo de resumir se puede decir que:

1) Se establece automáticamente con el Acuerdo la protección de una cantidad de IG de cada parte sin necesidad de recurrir a presentaciones y registraciones en la contraparte. Con el Acuerdo ADPIC ya valía la protección de las indicaciones reconocidas por los estados miembros de la OMC pero no existía un registro multilateral y cada parte podía exigir la presentación para evaluar si cada indicación geográfica protegida por un estado respondía a la definición dada por el mismo ADPIC<sup>3</sup>. De hecho, existe una disputa entre UE que busca un registro multilateral constitutivo para las IG de vinos y bebidas espirituosas y posiciones como las de Argentina que opinan que el mismo debería ser voluntario y serviría para consultar antes de reconocer una indicación o marca en los restantes países<sup>4</sup>.

2) El número de IG que entran en el Acuerdo en su Anexo II es desproporcionado entre las partes porque históricamente se trata de un instituto muy usado en ciertos países europeos y poco usado en los nuestros y porque, como se dijo, para la Unión Europea se trata de una institución clave de su sistema agroalimentario para cumplir objetivos de calidad, de ordenamiento territorial, de política de estructuras y también útil para el desarrollo rural. Las IG europeas son 350 y no son todas las existentes, ni mucho menos. Es decir, el juego negocial implica que el Mercosur ha buscado limitar una protección que como se intuye del punto 1) y de otras cuestiones que se verán luego, constituiría una suerte de mayor protección o protección facilitada al ADPIC o un ADPIC plus. Al contrario y como sucede en otros Acuerdos celebrados por la Unión Europea, muchos europeos sienten esto como una pérdida. Del lado del Mercosur se citan 220, número que resulta un poco artificial a primera vista si se consideran la cantidad de verdaderas indicaciones geográficas o denominaciones de origen ya protegidas por las normas nacionales de los cuatro países involucrados. Es una impresión personal pero creo que para acercar los números entre ambas contrapartes se aceptaron

<sup>3</sup> Incluso, la exigencia de registración con el Acuerdo queda expresamente ratificada en el art. 33 parág. 3.

<sup>4</sup> Pastorino, Leonardo, « Las indicaciones geográficas en el Acuerdo ADPIC y las negociaciones en curso », ya citado, p. 217.

nombres que tienen potencialidad o pueden estar en vías de reconocimiento o, quizás, estén reconocidos por leyes provinciales, que en el caso argentino también existen. Incluso se aceptaron nombres de enteras provincias que sabemos que por la extensión de las nuestras poseen características poco homogéneas como para brindar una calidad también homogéneas a sus productos e, incluso, nombres de provincias en cuyo interior ya se identificaron IG más específicas. Si es más claro en el Acuerdo que tanto Paraguay como el Brasil incluyeron y, por ende, se le reconocen, algunas IG que no son de vinos o bebidas espirituosas ni de otros productos agroalimentarios (las que se adicionan a las 220 ya citadas) y esto porque si bien en la tradición europea y en nuestra legislación argentina parece que el sistema está previsto para estos productos de origen agrario, lo cierto es que la definición dada en el ADPIC no restringe sólo a ellos<sup>5</sup>.

El listado incluido en el Anexo II puede ser ampliado con posterioridad en base a lo dispuesto en el art. 34.

Debe quedar claro también que no se trata de hacer una evaluación cuantitativa, sino también comercial o cualitativa del significado que estas indicaciones geográficas puedan tener en los países de donde no son originarias. Seguramente la Unión Europea ha seleccionado entre sus 350 IG aquellas que sabe que ya son utilizadas en los países del Mercosur y busca con eso evitar que se propague ese uso y, seguramente, también ha tratado de hacer un equilibrio entre los países miembro de la UE en su selección. En cambio, el “alcaucil platense” o cualquiera de las 8 IG reconocidas en Argentina por la ley 25.380 no representan nombres de interés comercial en el mercado europeo como para que un operador quiera utilizarlas en ese continente. Obviamente, existen otros casos de IG propuestas por el Mercosur que sí tienen potencial interés para usuarios europeos<sup>6</sup> pero entiendo que puesto este aspecto en la balanza, esta cuestión se inclina a favor del lado europeo.

3) El listado incluye tanto vinos y bebidas alcohólicas como productos agroalimentarios (y como vimos, también otros que no lo son como algunas piedras e, incluso, la hamaca paraguaya). No es un elemento menor. En el Acuerdo ADPIC siempre se distinguió entre un régimen más débil de protección para los productos que no son vinos o bebidas espirituosas y otro más fuerte para éstos que, incluso, eran destinatarios de un compromiso multilateral para ser ampliado. Por eso al hablar del registro multilateral se hizo mención que se proponía solo para vinos y espirituosas y el tema siempre implicó otro gran contrapunto entre la política europea que pregonaba llevar a los productos agroalimentarios al mismo nivel que los vinos y la de Argentina y otros países del nuevo mundo que se negaban haciendo hincapié en que en el ADPIC sólo se comprometieron a negociar para mejorar la protección de los vinos y bebidas espirituosas<sup>7</sup>. Entre las diferencias más notorias es que en el ADPIC la protección es objetiva y basta que exista la IG para hacerla valer mientras que en los otros productos, además, el uso de la IG fuera de su lugar de origen por quien no produjo en él debe, además, llevar a confusión al público. También, en el caso de vino la protección vale aún si la IG va acompañada de palabras que intenten aclarar que el origen real no es el de la mención, tales como “tipo”, “estilo” o “imitación”.

4) Se regulan muchos aspectos que quedan abiertos a la interpretación y donde la jurisprudencia europea o el entero sistema europeo que siempre es referencia en la materia podría orientar una protección cada vez más amplia de las IG con pérdidas de posibilidad de uso de muchas palabras de variado tipo. Por ejemplo, en la jurisprudencia francesa se impide

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<sup>5</sup> De hecho, el art. 33, parág. 5 admite que el acuerdo contempla la protección de indicaciones geográficas referidas a estos otros bienes aplicándose las normas específicas para ellos en cada parte.

<sup>6</sup> Brasil, por ejemplo, logró introducir en el listado la cachaça.

<sup>7</sup> Pastorino, Leonardo, « Las indicaciones geográficas en el Acuerdo ADPIC y las negociaciones en curso », ya citado, p. 216.

el uso de “champagne” incluso para productos de otra categoría como perfumes<sup>8</sup> u otros que en principio no llevarían a confusión pero que la jurisprudencia entiende que si provocan la banalización de la indicación asimilándola a un adjetivo genérico de calidad superior por el solo interés de querer aprovecharse de su notoriedad. Una interpretación claramente más restringida sería pensar que sólo se prohíba el uso para productos del mismo género, en este ejemplo, vinos espumantes. En el Acuerdo entre la UE y el Mercosur se limita a “productos comparables” que, entiendo, sería una forma un poco más laxa aunque no tanto (ej. que alcance la protección de una indicación geográfica de un vino a un “aceto balsámico”).

Hay que mirar con atención un extensísimo y variado “código” de usos permitidos y alcances de la protección previstos en el Apéndice del Anexo II. Como también integraría un capítulo de este derecho de las palabras, y a las palabras, el uso de las traducciones que debe mirarse igualmente con cada caso concreto. La regla general es que están prohibidas (art. 35, parágrafo 2, pto. B), pero en ciertos casos se permite lisa y llanamente usarlas en idioma extranjero y bajo algunas condiciones. Por ejemplo, “Českobudějovické pivo” (una cerveza) solo se prohíbe en checo en Uruguay y ginebra (en lugar de “genièvre” o “jenever”) se permite a usuarios anteriores y reconocidos pero no se lo permitirá a nuevos usuarios.

También se reconoce la posibilidad de usar un gran número de palabras que sin el Acuerdo podrían discutirse, como es el caso de “aceto balsámico” siempre que no vaya acompañado de “Modena” u otro nombre geográfico protegido, por eso vale la pena ver el Apéndice del Anexo II que es por demás asombroso y colmado de ejemplos que permiten dimensionar lo que se discute en esta temática y porqué uso la palabra “código” entre comillas para ver la regulación de las palabras que juegan en el límite del llamado uso común y la reserva protegida para ciertos usuarios y casos. Pero al respecto vale la pena recordar la regla del art. 35 parágrafo 5 que además permite cualquier término multicomponente que esté protegido como indicación geográfica, si dicho componente individual es un término habitual en el lenguaje común como el nombre común del asociado, lo que sucede cuando la IG protegida se compone de un tipo de producto y el nombre geográfico y el nombre es de uso común, v. gr. “jamón ibérico” no podría impedir en Argentina el uso de la palabra jamón.

5) También en algunos casos más significativos (gruyère, fontina, parmigiano reggiano, grappamiel, gorgonzola, grana, queso manchego, genièvre o Jenever y steinhäger) se regulan con mayor precisión y también amplitud los derechos adquiridos de usuarios de esas IG en países del Mercosur. También corresponde mirarlas en su individualidad porque cada una tiene una regulación específica pero van desde la posibilidad de usar leche de vaca para el queso manchego en Uruguay, cuando en el reglamento europeo es con leche de oveja a regular en qué casos podrá continuar el uso del “Reggianito” o a permitir el uso de algunas de las IG citadas en paréntesis cuando fueron utilizadas de buena fe y de forma continuada durante los cinco años previos a la publicación de la oposición de dichas indicaciones según las leyes de Argentina, Brasil, Paraguay o Uruguay y siempre que estos productos se comercialicen sin utilizar gráficos, nombres, fotografías o banderas que puedan hacer referencia al lugar de origen europeo y siempre que el nombre de la IG se escriba en caracteres más pequeños que los que se usan para indicar la marca (ver el pto. 9 del art. 35).

Y ya que dos veces citamos la diferencia que en ciertos casos se plantea entre usuarios previos y futuros, también hay que estar atento a este tema ya que podría estar creando una situación de exclusividad dentro de los países del Mercosur con beneficios económicos que puede estar legitimada en principios jurídicos pero que también puede estar poniendo a favor o en contra del Acuerdo a ciertos productores en relación a otros.

6) También se regulan aspectos que quedaban en duda respecto a la relación entre IG y marcas. A favor de la posición europea se establece que deberá reconocerse la protección

<sup>8</sup> CA Paris, 15 déc. 1993, n° 93/25039. Lire en ligne : <https://www.doctrine.fr/d/CA/Paris/1993/U31441C730D40C882FC67>.

aunque exista una marca registrada y que ambas deberán convivir, cosa que la ley argentina hasta ahora no permitía. En cambio, no se obliga a proteger la IG cuando la marca tiene fama, reputación o notoriedad y el uso de la IG pueda inducir a error al consumidor, aspecto no previsto en el Acuerdo ADPIC. Habrá que ver cuáles casos concretos podrían entrar en esta posibilidad.

7) El artículo 35, parágrafo 3 extiende los plazos para hacer valer los derechos adquiridos en el uso de indicaciones geográficas con relación a los términos fijados en el Acuerdo ADPIC, lo que beneficia mayormente o casi exclusivamente a usuarios de los países del Mercosur que venían utilizando las nombres geográficos protegidos produciendo fuera del territorio de origen.

No es todo lo tratado y, de nuevo, hay que mirar en los detalles, anexos, apéndices y asteriscos cada uno de los cuales puede ser poco significativo para una exposición académica pero bastante valioso desde el punto de vista económico de los usuarios de indicaciones geográficas y marcas con nombres geográficos protegidos.

**Palabras clave:** Indicaciones Geográficas, MERCOSUR, la Unión Europea, Acuerdo de Asociación Estratégica entre la Unión Europea y el Mercosur

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# APPLICABLE LAW IN INFRINGEMENTS OF THE RIGHT TO A TRADE NAME

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## Resume

Establishing a strong trade name (aword signused by an entrepreneur identifying his business in a particular area)<sup>1</sup> costs the entrepreneur effort, time, and money. Its unlawful use by other entrepreneurs (free riders) is thus, of course, unwelcome, and in a situation when the entrepreneur's right to his trade name is violated, it is significant to know especially the precise answers to the questions of(i)which national legal order shall be applicable for the claims of entrepreneur harmed by the afore-mentioned activity (which has given rise to a non-contractual obligation)<sup>2</sup>and(ii) what is the scope of thus determined applicable law.

Apart from that, the first crucial thing to be solved is the question of classifying an alleged infringement(theexamined conduct) in law. The reason for that lies within the importance of knowing if such an illegal behaviourwould be classified under *lex forias* anillegal act giving riseto a non-contractual obligation on the basis of (i) an infringement of the right to trade name (an infringement of an unregistered intellectual property right),or (ii)violation of the prohibition of unfair competition.Answering this question then serves as the pre-requisite for determining the correct applicable law, as mentioned above.

The protection of rights to entrepreneurs' trade names is the question of national legal orders and applies to all the entrepreneurs within the national territory.Moreover, the two afore-mentioned options of the classification of examined conduct is possible due to disharmonized interpretation ofArt. 8 of the Paris Convention for the Protection of Industrial Property<sup>3</sup>("Paris Convention").<sup>4</sup>

Nonetheless, if we assume that the right to trade name of the harmed entrepreneur isclassified as an (absolute) intellectual property right,<sup>5</sup> and an infringement of it is giving

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<sup>1</sup>For definition of the right to trade name, see para. 21 of Judgement of the Court (Grand Chamber) of 11 September 2007. *Céline SARL v Céline SA*. Case C-17/06.

<sup>2</sup>For the autonomous definition of a non-contractual (tort) obligation, see the Judgement of the Court (Fifth Chamber) of 27 September 1988. *Athanasis Kalfelis v BankhausSchröder, Münchmeyer, Hengst and Co. and others*. Case C-189/87.

<sup>3</sup> Which binds not only its contracting states but in addition the WTO members (see Art. 2 of the TRIPS Agreement which is the Annex 1C to the WTO Agreement).

<sup>4</sup>In favorofprotectionbyindustrialpropertylaw cf. ASCENSAO, J. O. Die Anwendung von Art. 8 der Pariser Verbandsübereinkunft auf Länder, in denen der Handelsname eintragungspflichtig ist. *GRUR International*. 1996, Vol. 45, No. 4, pp. 413–424, (para. 12–15, 19). Contrary to that, cf. the Judgement of the Federal Supreme Court of Switzerland of 1 January 1953. *Interchemical Corporation v Interchemie A.-G.* Case 79 II 305; TROLLER, A. Der Schutz des ausländischen Handelsnamen nach schweizerischem Recht. *GRUR Internationaler*. 1957, Vol. 6, No. 8–9, pp. 336–341.

<sup>5</sup> For illustration, it can be stated that in Slovakia (§ 8 and § 12 of the Act No. 513/1991 Coll., the Commercial Code; the Judgement of the Supreme Court of the Slovak Republic of 13 December 2019, CaseNo. 1 Ndob 12/2019) and Germany [Art. 5 and Art. 15 Gesetzesüber den Schutz von Marken und sonstigenKennzeichen (Markengesetz); BGBI. I S. 3082] protection to the rights to trade names of foreign entrepreneurs is provided as to the rights to industrial property. However, it does not preclude the possibility to seek the protectionfor the rights to trade names of foreign entrepreneurs through the prohibition of unfair competition or through the protection of personal rights. *Vice versa*, in Switzerland [Art. 157 Abs. 2 Bundesgesetzesüber das Internationale Privatrecht (IPRG); AS 1988 1776] and Austria [Art. 34 Abs. 1 Bundesgesetzesüber dation International Privatrecht (IPR-Gesetz); BGBI. No. 304/1978, and Art. 9 Bundesgesetzesgegen den

riseto a non-contractual obligation among the infringer andthe harmed entrepreneur, the applicable law for that kind of dispute should be determined [at the courts of EU states (except Denmark)] in accordance withthe Regulation (EC) No 864/2007 of the European Parliament and of the Council of 11 July 2007 on the law applicable to non-contractual obligations (“Rome II Regulation”). The main rulefor determining the applicable law is then covered by Art. 8(1) of the Rome II Regulationas “*the law of the country for which protection is claimed*”(*lex loci protectionis*). In the situations like this, theapplication of rules contained in Art. 4 (2) [in cases when both parties of the dispute have its habitual residence in the same state],Art. 4 (3) [in cases when the dispute is closer connected to another country], and Art. 6 (for the restrictionsof free competition)is prohibited as well as the choice of law in the meaning of Art. 8 (3) in connection with Art. 14 of the Rome II Regulation.<sup>6</sup>

The scope of the applicable law is also decisive for many related questions. For example, the applicable law shall be usedforanswering the question of the basis and extent of infringer’s liability, the existence, the nature, and the assessment of the remedy claimed, the transferability of the right to claim a remedy, the rules of prescription and limitation of the right to claim a remedy, the rules which raise presumptions of law, and the rulesdeterminingthe burden of proof (see Art. 15 and Art. 22 of the Rome II Regulation).

Nowadays, the rights to trade names are violated quite often via theInternetleading to infringement of these rights with effects inthe territory of several states. However, according to the main rule (*lex loci protectionis*), the individualclaims arising from such activitiesmust be assessed“separately”, i.e.claims arising from the infringement which have caused injuries (has effects) in the territory of one state need to be assessed under the law of thatstate.<sup>7</sup>This way of the claims assessment is called a mosaic way of determining the application law (the *dépaçage*principle).<sup>8</sup>

But when the right to trade name istruly infringed with the effects in the territory of a certain state?To answer this question, it is useful to start with thepurpose of the right to trade name itself, i.e. to distinguish an entrepreneur(a legal entity) from other entrepreneurs in a particular market. It is quite same as the purpose of the right to trademark<sup>9</sup>.Therefore, the scope of protection of the right to trade nameshould be similarly limited as the right totrademark, i.e. only for the situation that the sign is “used in commerce”.<sup>10</sup> This could lead to the conclusionthat the right to trade name will be truly infringed with the effects in the

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unlauterenWettbewerb 1984 – UWG; BGBI. No. 448/1984] the rights to trade names of foreign entrepreneurs are protected only on the basis of unfair competition law or through the personal rights protection (if they are not registered in the respective Commercial Register).

<sup>6</sup>[in Czech] TICHÝ, L. Nařízení č. 864/2007 o právu rozhodném pro mimosmluvní závazkové vztahy (Řím II). Komentář. 1<sup>st</sup> ed. Praha: C. H. Beck, 2018, pp. 100, 117–119; STONE, P. Private International Law in the European Union. 4<sup>th</sup> ed. Cheltenham: Edward Elgar Publishing Limited, 2018, p. 566; HANH, C.; TELL, O. The European Commission’s Agenda: The Future “Rome I and II” Regulations. In: BASEDOW, J.; DREXL J.; KUR A.; METZGER A. (eds.) Intellectual Property in the Conflict of Law.Tübingen: Mohr Siebeck, 2005, p. 16; KONO, T.; PAULIUS, J. General Report. Part III – Choice-of-Law Issues in Intellectual Property Disputes. In: KONO, T. (ed). Intellectual Property and Private International Law. Comparative Perspectives. Efrod and Portland: Hart Publishing, 2012, p. 152.

<sup>7</sup>[in Czech] KYSELOVSKÁ, T.; KOUKAL, P. *Mezinárodní právo soukromé a právo duševního vlastnictví–kolizní otázky*. Brno: Masarykova univerzita, 2019, pp. 234–235. KESSEDJIAN, C. Current International Developments in Choice of Law: An Analysis of the ALI Draft. In: BASEDOW, J.; DREXL J.; KUR A.; METZGER A. (eds.) *Intellectual Property in the Conflict of Law*. Tübingen: Mohr Siebeck, 2005, pp. 23–25.

<sup>8</sup>Ibid.

<sup>9</sup>A trademark is an object designation, not a subject designation likea trade name.

<sup>10</sup>Cf. KUR, A. Trademark Conflicts on the Internet: Territoriality Redefined? In: BASEDOW, J.; DREXL J.; KUR A.; METZGER A. (eds.).*Intellectual Property in the Conflict of Law*. Tübingen: Mohr Siebeck, 2005, pp. 185–187.

territory of a certain state only if trade name (sign) is (unrightfully) “used” there “in commerce”<sup>11</sup>. Given the above, there may not be so many situations where the proceedings will be paralyzed by a multiplicity of “applicable laws”.

In case of the Czech law as the law applicable for the disputes related to the infringement of the right to trade name, the rights to trade names are protected accordingly as (absolute) intellectual property rights<sup>12</sup> only if trade names are registered in the Czech Commercial Register (§ 423 *et seq.* of the Act No. 89/2012 Coll., the Civil Code); otherwise, the rights to trade names are protected only through the unfair competition law [§ 2976 (1) and § 2981 (1) of the Civil Code]. In relation to the first group of rights, the applicable law for their infringement will be determined in accordance with the basic *lex loci protectionis* rule (§ 80 of the Act No. 91/2012 Coll., Governing Private International Law). Nevertheless, entrepreneurs can voluntarily apply for the entry in the Czech Commercial Register and gain a better level of protection of their rights based on that.<sup>13</sup>

Finally, if we compare the criteria formulated in the Rome II Regulation with the criteria listed in the Principles on Conflict of Laws in Intellectual Property (“CLIP Principles”)<sup>14</sup> as the universally recognized soft law written by the *European Max Planck Group on Conflict of Laws in Intellectual Property* (2011), it may be found that the (European) academic point of view differs from the European Union (especially the Rome II Regulation) point of view for example in the opportunity to use in cases of intellectual property rights infringements (i) a *de minimis clause* in order to not apply the applicable law based on the *lex loci protectionis* rule [Art. 3:602 (2) CLIP Principles], or (ii) an *escape clause* based on the closest connection to another state (in cases when the infringement is committed via an ubiquitous media) [Art. 3:603 (1) CLIP Principles], or choice of law for issue of remedies arising from this kind of infringements [Art. 3:606 (1) in connection with Art. 3:103 CLIP Principles].

It shows that the CLIP Principles treat the *lex loci protectionis* rule much more flexibly comparing to the Rome II Regulation which meets the need of an effective respond to challenges arising in nowadays globalized business relationships much better.

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<sup>11</sup> The question of “How to interpret the term use in commerce” is a question of substantive law of the individual states. For a conceivable way of interpretation, see Joint Recommendation Concerning Provisions on the Protection of Marks, and Other Industrial Property Rights in Signs, on the Internet (WIPO, 2001). [online] Available from: [https://www.wipo.int/edocs/pubdocs/en/wipo\\_pub\\_833-accessible1.pdf](https://www.wipo.int/edocs/pubdocs/en/wipo_pub_833-accessible1.pdf)

<sup>12</sup> Cf. the Judgement of the Civil and Commercial Chamber of the Supreme Court of the Czech Republic of 8 March 2017, Case No. 31 Cdo 3375/2015.

<sup>13</sup> Cf. [in Czech] PULLMANNOVÁ, H. Právo k obchodnímu jménu zahraničního podnikatele na území České republiky v mezinárodních souvislostech. *Právní rozhledy*, Praha: Nakladatelství C. H. Beck, 2020, Vol. 28, No. 6, pp. 216–222.

<sup>14</sup> Available from: [https://www.ipmpg.de/fileadmin/ipmpg/content/clip/Final\\_Text\\_1\\_December\\_2011.pdf](https://www.ipmpg.de/fileadmin/ipmpg/content/clip/Final_Text_1_December_2011.pdf)



**Title:** EU Intellectual Property  
(Innovations and Intellectual Property in various fields of human life)

**Editors:** doc. JUDr. Ing. Jarmila LAZÍKOVÁ, PhD.  
Dr. habil. Ľubica RUMANOVSKÁ, PhD.

**Publisher:** Slovak University of Agriculture in Nitra

**Form:** electronic document (PDF) on a CD-ROM media

**Edition:** 1<sup>st</sup>

**Pages:** 157

**Copies:** 50

Not edited at the Publishing Centre of the Slovak University of Agriculture in Nitra.

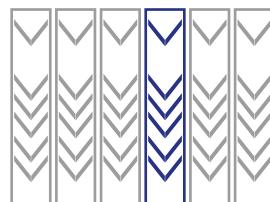
**ISBN 978-80-552-2339-1**



## Nitra 2021



With the support of the  
Erasmus+ programme  
of the European Union



FACULTY OF EUROPEAN STUDIES  
AND REGIONAL DEVELOPMENT  
OF SUA IN NITRA