



## Question Q228

**National Group:** BELARUS

**Title:** Prior User Rights

**Contributors:** Diana IVANOVA

**Reporter within Working Committee:**

**Date:** 30 April 2014

## Questions

### I. Analysis of current law and case law

1. Is there a provision in your national patent law that makes an exception to the exclusive right of a patent holder for parties who have used the invention before the filing/priority date of the patent ("prior user rights")?

*There are provisions in Law No. 160-Z "On Patents for Inventions, Utility Models and Industrial Designs" of December 16, 2002 that makes an exception to the exclusive right of a patent-owner for prior users.*

2. How frequently are prior user rights used in your country? Is there empirical data on how often prior user rights are asserted as a defense in negotiations or court proceedings?

*Prior user rights aren't used frequently in our country. One case is known when the defendant tried to approve his prior user rights as a defense in court proceeding.*

*Apparently there is no other empirical data on prior use applying as a defense in negotiations or court proceedings.*

3. To what degree must someone claiming a prior user right have developed the embodiment which is asserted as having been used prior to the filing/priority date of the patent? Is it sufficient to have conceived of the embodiment, or must it have been reduced to practice or commercialized?

*It is not sufficient to have conceived of the embodiment, the latter has to be used before the priority date or the preparations for such use have to be made.*

4. Does it make a difference in your country if

- the prior use occurred before the priority date; or
- it occurred after the priority date, but before the filing date?

*In our country the only option is the prior use that occurred before the priority date. If the use or the preparations to use the invention occurred after the priority date a person hasn't prior user rights.*

5. Is there a territorial limitation with regard to the scope of prior user rights in your country? In other words, if a party has used the patented invention before the filing/priority date in a foreign country, can it then claim a prior user right in your country?

*We have territorial limitations: a person can claim a prior user right if it has used a solution on the territory of the Republic of Belarus. It is confirmed by court practice in the case mentioned above. The defendant has been denied in prior user right because the patented invention was used in a foreign country.*

6. Is there a provision that excludes prior user rights for those who have derived their knowledge of the invention from the patent holder and/or the inventor?

*The provision of Law sounds as follows: "Any natural or legal person who, before the priority date of a patented invention, utility model or industrial design and independently of the author, has devised and used in good faith on the territory of the Republic of Belarus a solution..." So, it is excluded that the knowledge of the invention can be derived from the patent holder and/or the inventor. A prior user has to invent a solution independently of the author.*

7. Is it necessary that the prior user has acted in good faith to be granted a prior user right?

*Yes, it is necessary that the prior user has used the invention in good faith.*

8. Is there a material limitation with regard to prior user rights in your country? More specifically, if someone has used an embodiment of a patented invention before the filing/priority date of the patent, can he then claim a prior user right to anything covered by the patent? In particular, is the owner of a prior user right entitled to alter/change the embodiment of the patented invention used before the filing/priority date of the patent to other embodiments that would also fall within the patent's scope of protection or is he strictly limited to the concrete use enacted or prepared before the patent's application or priority date? In the event that changes/alterations are permitted by your national law, to what degree?

*There is some material limitation with regard to prior user rights in Belarus. If someone has used an embodiment of a patented invention before the priority date of the patent, he can't then claim a prior user right to anything covered by the patent. He has right only to continue using the solution that he has invented and that is the same as the patented invention.*

*Law doesn't entitle the owner of a prior user right to alter/change the embodiment of the patented invention used before the priority date of the patent to other embodiments that would also fall within the patent's scope of protection. Prior user*

*continues using the solution free of charge, provided that the scope of the use is not extended. The literal interpretation of this provision of Law results in a conclusion that he is strictly limited to the concrete use enacted or prepared before the priority date. Nevertheless there is a practical problem of interpretation of the phrase “the scope of the use is not extended”. Does it mean quantitative or qualitative indicators? There is no official position.*

9. Does a prior user right in your country require the continued use (or the necessary preparations of the use) of the invention claimed by the patent at the moment in which the objection of the prior user right is asserted or is it sufficient if the invention claimed by the patent has been used before the priority/filing date of the patent but has been abandoned at a later stage?

*Legislation doesn't include concrete requirements to the limits and duration of use. It is established that prior user is a person who has invented a solution and used or has made preparations for such use before the priority date of a patented invention.*

10. Is a prior user right transferable and/or licensable in your country? If yes, under what circumstances?

*The right of prior user may only be transferred to another natural or legal person together with the production unit in which use of the identical solution has taken place or in which the necessary preparations for use were made (Art. 39-(2) Law).*

11. Does your national law provide any exceptions or special provisions with regard to a prior user right owned by a company within a corporate group? In particular, can a prior user right be transferred or licensed to another group company?

*We haven't any special provisions with regard to corporate groups. It makes no difference from the standpoint of the law.*

12. Are there any exceptions for any specific fields of technology or types of entity with regard to prior user rights in your country?

*There are no exceptions for any specific fields of technology. Any natural or legal person can enjoy the prior user rights.*

13. The Groups are invited to explain any further requirements placed on prior user rights by their national law.

*Prior user rights are placed by Art. 39 of the Law, all the provisions are explained earlier. No further requirements are to be explained.*

## **II. Policy considerations and proposals for improvements to your current system**

14. Should a prior user right exist in any legal system? If yes, what is the main legal justification for a prior user right?

*In our opinion the existence of a prior user right is justified. In the field of technical creativity there are objective cases of creation of the identical inventions by various persons independently. Entity has the right to choose the legal patent protection or simply use its development without obtaining a patent. Each of these entities*

*behaves in good faith and is entitled to the protection of their interests by the state. The public policy objective for providing the exception is protection of the interests of the person who without obtaining a patent uses or prepares to use its decision, identical to the patented by another person. Since the former behaved in good faith, and his pursuit by the patentee for patent infringement may be assessed as patent misuse and deviation from the principle of justice, granting the right of prior use excludes civil liability of entity.*

*Prior user right as well as other limitations of exclusive right promotes maintenance of the fragile balance between the absolute right of patent holder and the society at large.*

15. What is the perceived value of prior user rights in your country?

*It is difficult to estimate the value of prior user rights in Belarus. Still it is the important limitation of the patent owner rights.*

16. Are there certain aspects that should be altered or changed with regard to the existing implementation of the prior user right in your country? In particular, are there certain measures or ways that could lead to an improvement and/or strengthening of your current system?

*It is obvious that certain measures are desirable to be taken in order to strengthen current system. In particular the provisions of Law should be improved. The following provisions require clarification: the notion "use" and especially the notion "preparation to such use"; interpretation of the phrase "the scope of the use can not be extended". If possible it would be nice to develop formal recommendations on the quantitative and/or qualitative indicators of use; on interpretation of the phrase "extension of the scope of use" and some others. There is a proposal to formalize in writing the prior user right of natural or legal person by issuing special document.*

### **III. Proposals for harmonization**

Groups are invited to put forward proposals for the adoption of harmonized rules in relation to prior user rights. More specifically, the Groups are invited to answer the following questions:

17. Is harmonization of "prior user rights" desirable?

*Harmonization of "prior user rights" has more advantages than disadvantages. Despite of the territorial nature of exclusive right and independence of patents granted by different countries the harmonized provisions in the sphere of intellectual property promote the development of economic relations, has a positive effect on investment activity and so on.*

18. What should be the standard definition of "use" in relation to prior user rights? Must the use be commercial?

*In relation to prior user rights "use" means any use of the embodiment that is identical to the patented invention. It can be either commercial or non-commercial. It doesn't matter for the purposes of the prior user rights.*

19. What should be the definition of “date” (or “critical date”) for prior user rights? (i.e. when must the invention have been used to establish a prior user right?)

*Though legislations of different countries mostly propose the priority or filing date, we propose the date from which the invention essentials become open for public – the date of the publication of application essentials. If the application essentials weren't published the definition of the date should be as follows: the priority date.*

20. Should a prior user right persist in the event that the use and/or preparation for use of the invention has already been abandoned at the time of the patent application/priority date or should the prior user right lapse upon the termination of the use and/or preparation of use?

*Approach to this issue has to be delicate. If we abolish prior user rights in the case when the use and/or preparation for use of the invention has already been abandoned before the priority date, we have to take into account reasons of such abandonment and future intentions of a prior user. The right of prior use shouldn't depend on the fact whether at the moment of the patent application/priority date a person operates actively or he suspended his actions for uncertain time. The main purpose of granting prior user right is to protect conscientious person who has invented a solution and used it or made some preparations. Make the grant of prior user right dependent not only on the facts mentioned above alone but also on duration of use and other additional time factors means make prior user more slighted.*

21. What should be the territorial scope of a prior user right? In particular, if a party has used the patented invention before the decisive date in a foreign country, should it then be entitled to claim a prior user right?

*Following the nature of patent rights the right of prior user should have similar characteristics in order to establish a balanced system. The territorial scope of a prior user right should be identical to the territorial scope of the patent holder right – the territory of the country that grants these rights.*

22. Should there be a provision that excludes prior user rights for those who have derived their knowledge of the invention from the patent holder and/or the inventor? If yes, should it be necessary that the prior user has acted in good faith to be granted a prior user right?

*Such provision should be adopted. It should be necessary that the prior user has acted in good faith. It is not only the common principle of the person's conduct but it is also the evidence that the rights of the author of the patented invention or the rights of the applicant – future patent owner were not infringed.*

23. Should there be material limitation with regard to prior use rights? In particular, if someone has used an embodiment of a patented invention before the filing/priority date of the patent, should he then be entitled to claim a prior user right to anything covered by the patent?

*Material limitations should exist with regard to prior use. The scope of the prior user right has to be limited by the embodiment which prior user has devised and used. Patent in question can cover much more separate solutions united in one patent*

*according to the rule “one application – one invention”. There are no grounds to extend the privilege of prior user to solutions which he hasn’t devised and used.*

24. Should a prior user right be transferable and/ or licensable?

*A prior user right can be transferable but only under strict conditions. For instance a prior user right should be transferable only with enterprise as a property complex.*

25. Should there be any exceptions for any specific fields of technology or types of entity with regard to prior user rights?

*No.*

26. The Groups are also invited to present all other suggestions which may appear in the context of the possible international harmonization of “prior user rights”.

*Successful experience of some countries can be used, for ex., written clearance of the relationships between patent holder and prior user.*