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"The Law Governing Patentability in International Private Law"

Dr. Raghad Abdulameer Madhloom

College of Law and Political Sciences, Diyala University ,

Raghadabed333@gmail.com

Abstract:

Patentability is an important legal concept in the field of industrial property, which requires providing legal and international protection for patents. Intellectual property is a crucial and effective domain that plays a vital role in the economic development of countries. The technological and economic advancements experienced by most advanced nations necessitate a focus on the field of patentability. Inventors are entitled to obtain patents for their intellectual, industrial, and technical creations. However, this right may be infringed upon by other parties belonging to different countries, leading to conflicts between the laws of nations. Consequently, determining which law should be applied to patents becomes essential. With the progress and development, the need for patents has increased, making them susceptible to exploitation, infringement, and misrepresentation. As a result, many countries have dedicated efforts at the domestic and international levels to protect patents by establishing protective regulations that specify the applicable law for patents through specific assignment rules. International agreements, starting with the Paris Convention of 1883, have provided a foundation for international patent protection. These agreements have established comprehensive international provisions and principles that determine the applicable law for patents. All these protective regulations are solutions to the conflicts of laws in the field of patents.

Keywords: Applicable law, patents, international private law, international agreements.

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Introduction:

Due to the importance of inventions and innovations, which are the result of human thought in finding solutions to meet the needs of society and the state, the natural state of innovation is to be used and disseminated, which may expose it to some attacks. It becomes a subject of dispute in a foreign legal relationship in which the inventor is a part. This requires determining the applicable law. Protecting inventions through patent protection, as regulated by patent laws, is the primary task of these laws in every country that grants patents, which are a document of ownership of the invention. Business entities and major industrialized countries consider patents as one of their most valuable assets, and they include them in their budgets[1].

Secondly, determining the rules of assignment in those laws, which determine the applicable law in disputes that may arise in determining the law applicable to patent relationships involving a foreign element. This type of protection, recognized by law, grants the patent owner the exclusive right to use and exploit the invention. This right is guaranteed to the patent owner and prevents others from using or infringing upon it, which may be the subject of a dispute requiring the determination of the applicable law.

[1] BasemAbdulrazak Mohammed Al-Sheikh, the article discusses patents and their protection under international law. It was published in the Journal of Sharia and Law, Issue 38, Volume 1/2, in 2023, on page 501.

Significance of the study:

The significance of the study lies in the existence of a system of national legal rules (assignment rules) and international rules stipulated in international agreements that provide the necessary legal protection for patents. They surround the inventor with the legal framework that encourages creativity and encourages more efforts to provide the best service for all of humanity. This is especially important given the increased awareness among members of society to reduce intellectual property violations. Patents are considered one of the most important types of intellectual property rights, which provide a certain degree of protection for these rights and help limit the infringements that occur among them, thus protecting the interests of the rights holders, serving society, and promoting its development. These inventions and innovations are the foundation of development and progress, and they are a measure of the wealth and advancement of nations, making advanced countries rank first in terms of the abundance of innovative inventions they possess[2].

Research problem:

One of the prominent problems that may arise in this study is: What is the solution if a patent is issued in one country and is attacked? What is the applicable law? What is the rule of assignment applicable to a patent if it is issued by the country that provides protection? What is the applicable law for patents if there is a dispute between parties to the patent and they are from different countries? What is the applicable law if there are no local assignment rules that determine the applicable law for the patent? Do countries or judges in this case resort to the assignment rules of an (international) agreement in which they are a party, or is the matter left unresolved?

To answer all these questions, we will address them through the content of the study.

Research methodology:

The methodology followed in this study is the analytical methodology, through analyzing the texts and assignment rules contained in local laws and presenting the most important proposals and solutions adopted in local assignment rules. It also involves analyzing the treaty texts contained in international global agreements, including the TRIPS Agreement, the Paris Convention, and the WIPO Agreement, which referred to the international protection of disputes related to the rights of inventors or innovators and determine the applicable law**.**

Research Method:

Intellectual property rights are governed by personal standards, which grant the author the right, and objective standards, which grant patent rights. These rights are nothing but the result of human minds. Those who provide an invention enjoy a special right known as the right of invention or patent right. Similarly, those who create a project and give it a specific trade name are known by that name during their business activities[3].

Intellectual property, industrial property, and commercial property are among the issues that fall within the scope of patent protection regulated by many international agreements. The most important of these agreements is the Paris Convention of 1883, which was amended several times under the Brussels Convention of 1900, the Washington Convention of 1911, and the Stockholm Convention of 1968. The Paris Convention and its amendments provided international legal protection for member states' intellectual property rights, including patent rights, whether claimed by nationals or foreigners. However, the increase and development in the field of technology, invention, and progress have rendered the Paris Convention ineffective in effectively protecting patent rights. This led the international community to turn towards the Washington Treaty on the Cooperation for the Protection of Inventions in 1970. This recent

2 According to the World Intellectual Property Organization's (WIPO) Global Innovation Index 2023, Switzerland, Sweden, and the United States topped the global innovation ranking. However, funding for startups is becoming increasingly volatile.

3 Dr. Emad El Sherbiny, Commercial Law and Business – The Merchant – Commercial Establishment and Companies, No publisher, No date, p. 178.

treaty stands out from other agreements in the field of intellectual property rights as it facilitates and expedites the necessary procedures for obtaining patent protection through a single application filed with any member state of the treaty[4]. This filing has an effect on protecting the invention in all member states of the treaty. In addition to international protection for patent rights, there is internal protection within the boundaries defined by the domestic laws governing intellectual property[5].

Patent rights are considered one of the most important types of intellectual property rights in general, and industrial property rights in particular. Industrial property rights have significant importance in various areas of life in modern societies. Patents have become relevant to decision-makers worldwide[6]

Patents serve as a strategic tool in managing and developing projects, whether they are large, medium, or small in size. This is especially true in light of technological advancements resulting from innovation, production, and exploitation. One of the sciences that represents a fertile field for modern technology in the technological revolution is applied sciences, industry, medicine, and agriculture. Therefore, countries, especially industrially advanced ones, have worked to provide the necessary protection to encourage scientific research and serve humanity. Patent protection safeguards the inventor's right to innovation, creativity, industrial secrets, and exclusive economic exploitation. The inventor's right poses not only a problem in providing domestic protection, as it is one of the financial rights at the national level, but also at the international level with an international character[7]. Determining the applicable law in the event of a dispute over a patent infringement involving a foreign element requires finding a solution. To answer this question, the solutions can be divided into the following two cases:

1- In a situation where a patent is granted in a single country: In such a case, the dispute can be resolved by applying the law of the country that granted the patent. The judge in this country does not face any problem in resolving the dispute, as this country grants the patent only after registration and deposit procedures. These procedures are carried out by the public authority of that country, which operates according to its local regional law. Furthermore, the country granting the patent is the country where the innovative idea originated, and it is where the patent's actual monopoly and economic exploitation are implemented[8].

Secondly, the situation of granting a patent in the country of origin, and the inventor obtaining a patent in another country or countries where protection is desired, and the applicable law in such a case is the law of the original country that granted the patent for the first time. However, this view has become obsolete due to its conflict with the principle of regional patent protection, which is applied in all countries and has been established by the majority of international agreements that address this issue.

But the question that arises in this regard is what is the solution if there is a conflict between the law of the granting country and the law of the country of origin? The answer to this question is the application of the law of the country from which the patent protection is sought by the patent holder. The justification for this is that the inventor has filed the patent in that country. There is a prevailing opinion that justifies giving jurisdiction to this country as the territory and law of the country required to provide protection. This law ensures or achieves the legal protection of the exclusive rights in the patent and its economic exploitation[9].

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4 Ahmed Khalil Ibrahim Al-Sakr, Conflict of Laws in Intellectual Property Investment Contracts (Comparative Study), PhD thesis at the University of Babylon, College of Law, 2022, p. 53.

5 Dr. Fouad Abdel-Monem Riyad, Summary on Nationality and the Status of Foreigners in Egyptian and Comparative Law, Cairo, Dar El Nahda Al Arabiya, 1984, p. 244. And Dr. Salah El-Din Gamal El-Din, Brief on Private International Law, No publisher, 2011, p. 242.

6 Dr. Omar Fouad Omar, The Mediator in Commercial Law, Vol. 2, Dar El Nahda Al Arabiya, Cairo, 2007, p. 385. And Dr. Mohamed Ali El-Arian, Innovation as a Requirement for Granting a Patent Between the Self-Standard and the Objective Standard, Dar El Gamia Al Jadeed, 2011, p. 2.

7 Is abelle wekstein driot voisins dudvoitd outeur et numevique, litec, Paris, 2002, No.1 P.20.

8 Dr. Ahmed Abdel Karim Salama, The Science of Conflict and Choice between Legal Systems, 1st edition, Mansoura, Al-Galaa Al-Jadeeda Library, 1996, p. 790.

9 Dr. Abdel-Monem Hafez, The Summary of Provisions on the Regulation of International Conflict between Laws, 1st edition, Law Fulfillment Library, Alexandria, 2018, p. 429.

After discussing the most common solutions for determining the applicable law in the two previous cases, it is necessary to clarify the applicable law in terms of patent holders and the resulting effects of granting a patent.

1- The applicable law to the parties of the patent:

The original patent holders are the ones who constitute an essential element in the formation of the patent. They represent the patent grantor and the patentee. It is necessary to obtain a document called a "patent document." To obtain it, the person applying for the patent, called the "patentee," submits an application for the grant of the patent to the other party called the "patent grantor" for the purpose of protecting the invention and arranging the legal effects resulting from the opening of this patent to the person applying for the patent. Therefore, most national legislations have resorted to enacting legal provisions that regulate the conditions for filing a patent application and determine who has the right to grant a patent. The patent grantor can be an official person representing the state. In turn, it works to designate specific entities or offices to which the application for the grant is submitted. The names of these entities vary from one country to another, and usually, these entities are related to or affiliated with official ministries and authorities. Each country has enacted internal laws that stipulate the protection of patents as a form of intellectual property rights due to its impact, i.e., inventions in the development of societies and the achievement of welfare sought by countries for their individuals[10].

Now that a patent is only protected within the limits of the country in which it was granted without extending beyond the territory of another country, this rule itself poses a danger to the rights of the patent holder. This has led countries to expand the scope of this protection in order to guarantee the rights of the patent holder more effectively through the establishment of international agreements to expand the scope of protection. These agreements include the Paris Convention of 1983 and its amendments[11]. The Washington Treaty of 1970 and its amendments, which stipulate cooperation among member states in the field of patent protection, are referred to as the "Patent Cooperation Treaty." The TRIPS Agreement of 1994 and other international agreements for the protection of patent rights that provide international protection for this right at the international level[12].

The inventor is the only person authorized to exploit his invention and exercise this right through all legal means. The duration of the patent is twenty years, starting from the date of filing the patent application or from the date of completion of the official documents, and it is renewed annually by paying the prescribed fees[13].

2- The resulting effects of granting the patent:

One of the most important effects resulting from granting a patent based on the inventor's request are the effects related to the establishment of the patent and other effects related to patent rights. The first effect is related to the establishment of the patent, and it may be subject to legal disputes between the laws of the granting state and the laws of the patent owner's state. The second effect may be subject to disputes between the law of the patent owner and the law of the state that invests in patent rights, in addition to the law of the granting state. The duration of the patent, as an effect of granting the patent, which we have previously discussed, is recorded outside the granting state and is equivalent to the duration of the patent in the foreign country, provided that the registration period within the inventor's country does not exceed twenty years. Here, the disputes arise in procedural matters, as the subject of the patent witnesses disputes between laws from an objective perspective[14].

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10 Joseph, Straus, genomics and the food, Industry: out look from an intellectual, property, prospestive, intellectual in the new, millen nium, edied by d. vaver and L. Bently, Cambride, 2004, P. 45.

11 Giovanna modiano, international patent licensing Agreements and Agreewent and can flict of lows, 2nw. J.Int'l, 1980, P.89.

12 Ahmed Ali Omar, Industrial Property and Patent, Al-Helmeya for Printing and Publishing, Alexandria, 1997, p. 51.

13 Dr. Jalal Wafa Mohammadin, Legal Protection of Industrial Property According to the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS), Dar El Gamia Al Jadeed, 2004, p. 94.

14 Dr. Hala Hathal Hadi, International Protection of Intellectual and Literary Property Rights, Iraqi Comparative Law Journal, Issue 57, 2008, p. 6.

There are some countries that rely on the substantive examination system and the evaluation of patent applications submitted under this system. The competent administrative body receives the applications, examines them from both formal and substantive aspects, clarifies the required data to be recorded, and ensures the availability of substantive requirements. The invention is then presented to specialized experts to determine the industrial validity of the invention. The applicable law in case of disputes regarding the validity of the applications is the law of the judge who considers the validity of these applications as the original basis for resolving disputes related to this matter[15].

One of the advantages of this system is that it sets a limit from the beginning to non-serious inventions, reduces disputes in courts after the issuance of the patent, and gives legal value to the patent while achieving the interests of others by relying on the administration's examination of its validity and industrial exploitation. Despite its advantages, this system has some flaws, the most important of which is that it delays the decision on patent applications due to the lengthy scientific experiments and objective studies required by this system[16].

At the international level, the granting of a patent to the patent applicant takes place through international patent filing offices established under an international agreement to protect patent rights. The patent applicant submits the application to the headquarters of the agreement, which is approved according to the conditions and laws set by that agreement, and the laws of the agreement apply to all member countries. The applicant for patent grant submits a request to the international office, which is the office of the World Intellectual Property Organization (WIPO), as well as the United Patent Offices for the protection of intellectual property rights[17].

One of these offices is the European Patent Office, which is an international office, and the World Intellectual Property Organization (WIPO). The purpose of these offices is to protect patent rights, especially intellectual property rights, at the international level. Intellectual property agreements are subject to frequent amendments, and the purpose of these amendments is to keep up with the specific developments that patent rights may undergo. The World Intellectual Property Organization (WIPO) is an international body responsible for managing international agreements and is one of the agencies affiliated with the United Nations[18].

However, it is not always a requirement for the patent grantor to be an official person. The patent grantor may be an unofficial person. For example, certain institutions have been granted the authority to grant patents by governments, such as (gov.uk), which is a British institution that provides access to government services and information in the simplest, clearest, and fastest way to know about current events[19]. The World Intellectual Property Organization (WIPO) has defined the assignment contract when the meaning of the unofficial person overlaps with the inventor as the grantor, after obtaining the patent. If it is disposed of through assignment, with or without consideration, it is considered (the permission granted by the intellectual property rights holder to another to use it based on agreed-upon conditions and for a specific purpose in a specific area and for an agreed-upon period of time. A patent is one of the most important of these rights, and it is subject to the provisions applicable to rights, including this convention[20]).

Results and Discussion: Based on the research conducted on determining the applicable law for patent infringement in the case of its issuance in one or multiple countries, along with identifying the granting

15 Dr. Zuhair Al-Bashir, Literary and Artistic Property (Copyright), Ministry of Higher Education and Scientific Research, Baghdad, 1989, p. 73.

16 Dr. Sameer Jameel Al-Fatlawi, Exploitation of Patents, Dar Al-Hurriya for Printing, Baghdad, 1978, p. 65.

17 Hunbbz Gorda, Kristan Ablat, The Scientific Guide to the European Patent Convention, translated by Raya Al-Qalyubi, Dar Al-Thaqafa for Publishing and Distribution, Amman, No publication year, p. 76.

18 Dr. Mohamed Daghsh, Intellectual Property between the GATT Agreement and WIPO, International Political Magazine, 1989, p. 97.

19 Alian beltran & sophie chauveau Gabriel galvez behar, patent cultures : piversity and harmonization in historical, Paris, 2001 , P. 298.

20 Dr. Majid Ammar, Industrial Licensing Contract and Its Importance in Developing Countries, Dar El Nahda Al Arabiya, Cairo, 1987, p. 30.

authority of the patent, we can discuss a highly important topic, which is the principle of applicable law assignment. This principle guides the judge in determining the applicable law in situations where the laws of two or more countries conflict, or when there is imitation, counterfeiting, or violation of the patent, and one of the parties involved in these actions is a foreign entity. In such a conflict, what is the principle of applicable law assignment? Is it the law of the place where the monetary transaction occurred, the law of the nationality of the patent holder, or the law of the country consulted? To answer these questions and understand the most important solutions or principles of assignment that determine the applicable law, we will address these two sections:

1- Legislative (Domestic) Assignment Rules.

The assignment rule here is a tool that guides the judge to the applicable law in disputes related to patent infringement. It does not provide an objective solution to the dispute concerning the legal relationship tainted with a foreign element. The provision of this objective solution falls within the jurisdiction of the substantive rules in the applicable law referred to by the assignment rule. This means that the right to a patent is governed by the assignment rules, and the will can play a role in determining the legislative jurisdiction[21]. One of the most important solutions introduced by the internal assignment rules is the original assignment rules, which are designed to resolve disputes related to patents with a foreign element. These rules include a single connecting factor or several criteria that indicate the law of the state to which the inventor belongs by nationality or country of origin or use. For example, an invention generates an intellectual right for the inventor, and this right is subject to the rules of the state where it is first registered. It can be described as the law of the country of origin[22]. This rule applies when the right to a patent is described as a financial right that has an economic value. However, this rule does not apply in all cases. If there is an infringement of a patent, and this infringement is committed by one of the parties to the contractual relationship, then this right can be described as a proprietary right (contractual relationship). The law of will can be applied to it, which means that the will of the parties, as determined by this law, directs its application to the dispute that may arise between the parties to the contract. These provisions must be agreed upon by both parties and cannot be violated. However, the question here is what assignment rule can be applied if there is an infringement of a patent by a party outside the contractual relationship that has no connection to the parties to the patent right (the owner of the results or the investor)? In this case, the judge can apply the rule of the law of the country where the commitment was made, meaning that the judge can apply the assignment rules for non-contractual obligations. Therefore, the right to a patent has a diverse assignment rule depending on the nature of this right. The assignment rule is a legal principle that undertakes the task of determining the best and most appropriate legal rules to govern legal relationships tainted with a foreign element, which can be described as foreign relationships[23]. But if the right to a patent is considered a personal right that is connected to the patent holder, then the latter becomes the center of gravity in the relationship. The question here is what assignment rule can be applied to a patent as a personal right? The best personal criterion that can be applied to a patent is the law of nationality as the most appropriate assignment rule for resolving disputes related to a patent tainted with a foreign element. The patent holder has the right to their scientific and innovative product and to attribute this work to themselves, which is reflected in determining the law that should be applied when the inventor is part of the legal relationship subject to the dispute. Therefore, the assignment rules related to personal rights are better than the assignment rules related to proprietary rights[24]. However, the nationality rule has faced criticism from opponents of this rule based on a set of criticisms. Relying on nationality law leads to a change in the country of origin and the loss of the relative stability advantage guaranteed by the first-to-file principle if the patent is registered in a country other

21 Dr. Hashem Ali Sadik, Private International Law, Dar Al-Fikr Al-Jame'i Al-Jadeed, Alexandria, 2005, p. 169.

22 Eskil Waage, I. application de principes generaux de procedure en droit Europeen de brevets, ed litec , 2000, P.190.

23 Dr. Ghaleb Ali Al-Dawoodi, International Jurisdictional Conflict in Private International Law: A Comparative Study, Al-Wajiz in Private International Law, 1st edition, Al-Sanhouri Library, 1996, p. 76.

24 Dr. Yabiton Halim Dos, The Role of Public Authority in the Field of Patents, Manshurat Al-Ma'arif, Alexandria, 1983, p. 46.

than the nationality of the patent holder[25]. After it was unregistered, it is determined within the country of origin by nationality. The country of origin can also be changed for unregistered inventions by changing the nationality of the inventor or the difficulty of determining the country of origin due to the absence or dual nationality of the inventor[26].

In response to these criticisms, supporters of the nationality rule have provided the following justifications: The nationality of the inventor has become familiar in legal thinking, as there are more complex problems that can be solved through the nationality criterion, and there are no alternative solutions to these problems other than considering the nationality law of the inventor.Doubling the nationality of the inventor can be resolved by considering the actual or effective nationality of the inventor and taking into account the law of the domicile or habitual residence in the case of the absence of nationality. These solutions have become the ones that can be resorted to in cases of absence or dual nationality, not only at the domestic level but also at the international level[27]. Supporters also argue against the claim that the nationality of the inventor has no effect on changing the country of origin, stating that determining the country of origin remains linked to the nationality of the producer at the time of creating the invention due to the connection of this law to that country[28]. In conclusion, the assignment rule for a patent as a personal right can be best determined by the law of nationality. However, there are criticisms and debates regarding this rule, and alternative solutions are proposed to address the complexities that may arise from issues such as dual nationality or the absence of nationality. From this, we can conclude that the inventor's right comes into existence at the moment of registration, and the patent is a means of disseminating the invention to the public. This leads to the argument that the law of the registering country is the most relevant law to intellectual property if the intellectual right is related to the patent and not necessarily the law of nationality. The law of nationality plays a significant role in determining the eligibility of the patent holder. The eligibility to perform certain actions, apart from the eligibility of obligation, is governed by the nationality law of the country to which the person belongs. The nationality law has a significant impact on personal status matters, and it provides appropriate solutions within its scope. However, patent rights, the relationships arising from them, and the consequences resulting from these rights cannot be described as personal status matters. They are subject to the law of nationality, which does not provide solutions to disputes that may arise in patent rights. Nevertheless, there is a jurisprudential trend that argues for the necessity of giving jurisdiction to the nationality law in cases where the patent is not published, meaning the nationality law of the patent holder[29]. Supporters of this opinion highlight that the patent is the product of the inventor's mind and has a close connection to its creator, which justifies the application of the nationality law. They argue that the right to patent an invention, as a form of intellectual property and artistic creativity, is the result of human thought, and the human has a parental right over what they have created and invented. In the case of non-publication, there is nothing preventing the association of that idea with the inventor, except that this trend has also been criticized due to the possibility of changing the country of origin based on the change of nationality of the patent holder and the difficulty of determining the state due to the absence or dual nationality of the patent holder. However, a problem may arise in the absence of a governing law provision that can be applied to a dispute regarding the right to a patent as a vested right in an international contract. If the contract does not specify the applicable law, and the patent right is violated either by the other party to the contract or by an external party, what is the internal connecting factor that the judge can rely on in the

25 Dr. Jabir Abdul Rahman, Private International Law, Conflict of Laws, Dar El Nahda Al Arabiya, Cairo, 1969, p. 279.

26 Dr. Sami Badi Mansour, The Mediator in Private International Law, Dar Al-Alam Al-Arabiya, Beirut, Lebanon, 1st edition, 1974, p. 270.

27 Dr. Hassan Al-Haddawi and Dr. Ghaleb Al-Dawoodi, Private International Law, Vol. 2, Conflict of Laws, Jurisdictional Conflict, and Enforcement of Foreign Judgments, Dar Al-Kutub Al-Ta'awun, Mosul, 1988, p. 53.

28 Dr. Ahmed Ali Omar, Industrial Property and Patents, Al-Helmeya Printing Press, Alexandria, Egypt, 2006, p. 85.

29 Dr. Hashem Ali Sadik, Conflict of Laws, 2nd edition, Nasr Printing Press, Alexandria, Egypt, 1972, p. 814.

Dr. Mamdouh Abdel Rahim, Private International Law, Conflict of Laws, Amman, Dar Al-Thaqafa wa Al-Nashr, 2005, p. 157.

absence of their choice?[30] This issue is one of the most debated topics in private international law, and there are multiple solutions. However, the best solution is to adopt the concept of the distinctive performance. This concept is based on the idea that the law most closely related to the contractual relationship is the law of the habitual residence of the debtor at the time of the contract's conclusion. The advantages of this idea are that it provides flexible solutions and considers the diversity of international contracts. It respects the legal security principle for transactions that transcend borders and respects the legitimate expectations of the parties. Many domestic legislations have adopted this idea, which relies on the distinctive performance as the main and essential performance of one of the parties in the contract.

The judge or arbitrator can rely on the concept of the distinctive performance to determine the applicable law in cases where there is no governing law provision, whether explicitly or implicitly, through the performance of the inventor (right holder). The patent holder is the one who performs the distinctive performance, and they exercise their work and have knowledge and legal expertise regarding the issue of the applicable law by following several legal procedures to obtain the patent[31].

Some argue that determining the place of distinctive performance through the inventor and the original patent holder makes the applicable law the law of the inventor's country of residence or the place of habitual residence or the place of patent registration as the place of distinctive performance, representing the center of gravity in the relationship. In the case of infringement of the inventor's rights, this criterion can be relied upon in distributing the elements of the harmful act, which constitutes the infringement of the patent holder, and the uncertainty of knowing the exact place of harm. Knowing the law of the debtor in the distinctive performance is easy compared to the difficulty of determining the place of harm[32]. Thus, the concept of the distinctive performance remains important in determining the applicable law while maintaining the role of the law of habitual residence and its role in determining the applicable law for contracts entered into within the framework of patent rights.

One practical application of the concept of distinctive performance and its role in determining the applicable law is the case of a patent contract (decision of the French Court of Cassation on October 19, 2010, issued by the Commercial Chamber).

We make a summary of the judgment in the dispute between a Dutch company and a French factory, where the French factory requested the Dutch company to repair the ship's deck (pont de naviv), which was designed in France and sold to the Dutch company. The Dutch company did not comply with the factory's request and the factory resorted to legal action, seeking the application of French law as the law of the debtor's habitual residence due to the distinctive performance being closely linked to France since the ship was designed there. However, the Dutch company argued for the application of Dutch law as the law of the company's central location, and that there was no evidence to support the application of French law. It was mentioned that the court's interpretation in this judgment is based on Article 4(2) of the Rome Convention of 1980 on the applicable law to contractual obligations, which states that "the law applicable to a contract shall be the law of the country in which the party who is to perform the characteristic performance has his habitual residence at the time of conclusion of the contract." The court noted that this solution was incorporated into Regulation Rome (1) (953/2008) issued on July 17, 2008, which replaced the Rome Convention and applies to contracts concluded after December 17, 2008. The court emphasized the need to refer to the approach followed by the European Court of Justice in its judgment of October 6, 2009, which states that the law applicable to international contracts in the absence of a choice of law by the parties is the law of the debtor's habitual residence with regard to the distinctive performance. The court affirmed that the judge must ensure the connection between the contract and the law of that place. The French Court of Cassation applied French law considering that the factory is the debtor of the

30 Schnitzer: Ie droit international prive suisse en matiere d'obligation Rec. des cours, 1968, tom1, P. 547.

31 Dr. Khaled Abdel Fattah, Problems of Enforcement and Conflict of Intellectual Property Laws, Faculty of Law, Helwan University, Dar Al-Jame'a Al-Jadeeda, 2017, p. 115.

32 Dr. Ahmed Abdul Karim Salama, International Contract Law, Dar Al-Nahda Al-Arabia for Publishing and Distribution, 2008, p. 295.

distinctive performance and that France is the habitual residence, and that the place of manufacturing the ship is France, which is the place of contract performance[33]. From the above, it can be concluded that applying the concept of distinctive performance based on the debtor's habitual residence in the contract and considering France as the place of invention (the ship) and the owner of the invention, the judge, when applying the concept of distinctive performance, must consider flexibility in its application to patents since it combines the attribution principle on one hand and the objective principle on the other hand, taking into account the stronger connection between the contract and the law.

2- The rules of the Convention on the Assignment of Rights (International):

Perhaps the most important rules of the Convention on the Assignment of Rights, which provide international solutions to disputes that may arise regarding patents with a foreign element, are unified international rules agreed upon under an international convention concluded between the member states of the convention. The purpose of such a convention is to guide the determination of the law applicable to patent issues, and some refer to them as private international law agreements[34].

These rules establish indirect solutions that resolve conflicts of laws by specifying the law that should be applied to legal relationships arising from patents. However, these convention rules do not reach the level of unifying substantive provisions regarding patent issues[35].

Many attempts have been made to unify international rules of assignment and give them a global character. However, unification is a challenging matter, especially for countries with conflicting interests and different legal systems. Nevertheless, there are international agreements that have worked to unify the rules of assignment within the framework of their member states. These agreements focused on specific subjects within the scope of the agreement. Some of these agreements include the Montevideo Convention of 1889 on the unification of conflict of laws, civil and commercial matters, literary and artistic property, and patents, which was concluded among South American countries, as well as the Rome Convention of 1980. The purpose of these agreements, among others, is to address the deficiencies of substantive rules in regulating and protecting the rights of inventors in their inventions. The Bern Convention and the Paris Convention are examples of these agreements, which clarify the establishment of assignment rules that determine the applicable law, and where they rely on the law of the country seeking protection[36].

One of the prominent forms of assignment rules outlined in international agreements that provide legal and international protection for patents against infringement are as follows:

1- Bern Convention:

This convention, dated 1886 and amended in 1979, aims to protect creators, thinkers, and inventors. It provides inventors with a way to use and control their scientific innovations, as well as determining the conditions under which others can use them. These conventions also include a set of provisions related to the minimum level of protection and certain special provisions that were developed for the benefit of developing countries. Some of the assignment rules included in this convention are:

Law of the Country Requesting Protection: The convention stated that the protection of inventor's rights is subject to the law of the country where protection is sought. The exercise or request for such protection is not subject to any formal procedure, but rather, it is subject to the law of the country of origin[37].

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33 According to Ahmed Khalil Ibrahim Al-Sukkar, the previous source, p. 161.

34 Dr. Ahmed Abdul Karim Salama, Private International Law of Intellectual Property, Study of International Agreements and Approaches to Intellectual Property Rights Protection, 1st edition, Dar Al-Nahda Al-Arabia, 2019, p. 25.

35 Dr. Sami Badi Mansour, The Mediator in Private International Law, Dar Al-Alam Al-Arabiya, Beirut, Lebanon, 1st edition, 1974, p. 15.

36 Dr. Hisham Sadik, The Law Applicable to International Commercial Contracts, Manshurat Al-Ma'arif, Alexandria, 1995, p. 549.

37 Article (5/2) of the convention

1- Law of the Country of Origin: The Berne Convention included assignment rules that indicate that the applicable law is the law of the country of origin in certain matters. This means that the duration of protection is determined by the law of the country requesting protection, provided that the duration in the law of the country requesting protection does not exceed the duration in the law of the country of origin. In other words, the law of the country of origin is followed if the law of the country requesting protection indicates a duration that exceeds the duration specified in the law of the country of origin[38].

2- Nationality Law: The Berne Convention referred to the law of the country of nationality of the scientific inventor as the authority responsible for representing the inventor in relation to their unpublished and unknown invention, with some indications that the inventor is a citizen of one of the union's countries. The application of the nationality law requires that the subject of protection for this scientific output is unpublished, not in circulation, and the identity of the author is unknown, with the belief that the author is a citizen of one of the union's countries[39].

Secondly, Paris Convention:

The Paris Convention is one of the agreements that deals with the field of industrial property rights, which is an important aspect of intellectual property due to its vital and central role in the development of countries' economies. Through the examination of the convention, we focus on a specific field within industrial property, namely patent protection. This convention indicated the important basic rules for international protection of patents, which are comprehensive international provisions and principles, including:

1- Law of the Country Requesting Protection: The Paris Convention referred to an assignment rule that determines the applicable law for patents. This rule is the international protective scope for the inventor through the law of the country requesting protection by the right holder. The convention stated that "the grant of a patent shall not be refused, nor shall a patent be invalidated, on the ground that the sale of the patented product or the use of the patented process is prohibited by the national law of the country where the patent is applied for or granted, provided that the product or process is capable of being patented." Although this text does not explicitly require the law of the country requesting protection, it implicitly indicates that the applicable law is the law of the country requesting protection[40].

2- Law of the Country of Origin: The Paris Convention also stated that patent protection is granted by subjecting it to the law of the country of origin. It indicated that if a product is imported into a country that has a patent protecting the method of manufacturing that product, the owner of the patent has all the rights granted by the law of the importing country in relation to the products manufactured in that same country based on the patent[41].

The Patent Cooperation Treaty (PCT) is an international agreement on patents that was concluded in 1970 and underwent several amendments in 1984. It entered into force in 1999. The PCT referred to the same assignment rules as the previous patent protection agreements. However, it introduced direct provisions for protecting patents by stating that any citizen or resident of a member state of the treaty has the right to file a single application for patent protection in any of the member countries. This greatly simplifies and facilitates protection in multiple foreign regions simultaneously[42]. The PCT works to simplify the formal requirements for seeking patent protection and reduces the significant costs associated with patent protection. It establishes strong foundations for granting patents. It is a procedural agreement that deals with procedures and applications submitted by the patent applicant, rather than

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38 Dr. Khaled Abdel Fattah Mohammed, Problems of Enforcement and Conflict of Intellectual Property Laws, the previous source, p. 78.

39 Ahmed Mohamed Youssef, Conflict of Laws in the Field of Copyright, Master's thesis, Faculty of Law, Cairo University, 2009, p. 45, according to Article (15/4).

40 According to the text of Article 4 of the Paris Convention for the Protection of Industrial Property.

41 Article (5/4) of the Paris Convention.

42 Ulf, Ander felt, international patent-legislation and developing contries printed by martinus Nijhoff, the Hague, 2018, P.18

being an international agreement that specifies the applicable law for patents. It sets out the procedures for obtaining international patents.

Conclusion:

From the above, it can be concluded that a patent is a strategic tool in managing and developing projects, whether they are large, medium, or small in size. Especially in light of the technological advancements resulting from the diversity of innovation and production waves, as well as the technological revolution that encourages scientific research for the benefit of humanity. It has become a subject of legal conflict, as the inventor's right to innovation and creativity is subject to external infringement. This makes patent law a subject of legal conflict, and the legal relationship is influenced by foreign elements, which requires determining the applicable law through either internal legislative solutions known as national assignment rules, or by establishing an international legal framework for patent protection through rules specified in international agreements that determine the applicable law. Therefore, the intensity of conflict appears within the framework of patent law as a type of intellectual property rights. To resolve this conflict, most countries have resorted to filling this legislative gap by concluding international agreements related to patents, as they play an important role in resolving conflicting laws concerning the rights of inventors by including international assignment rules. These rules have become the basis for determining the applicable law in patent disputes, and internal assignment rules are no longer the only solution to the problem of conflict, starting from the Paris Convention to the Patent Cooperation Treaty. Providing this legal protection for patents and their owners encourages the promotion of creative and innovative capacities, with legal guarantees for such protection, and drives the industrial and economic development process. As for the recommendations:

Based on this study, we propose committing to international specifications and standards in production, which support the competitive capabilities between countries within the framework of patent protection, and which enable the absence of conflicts in laws within the framework of international patents. Member states of international agreements such as the General Agreement on Tariffs and Trade (GATT) of 1994 should commit to fulfilling the commitments and obligations they made when joining the World Trade Organization, and join international agreements related to patents in order to create a legislative environment that aligns with the requirements of these agreements. This will lead to reducing the occurrence of conflicts between laws within the framework of patent protection by specifying assignment rules that determine the applicable law, ensuring an appropriate solution to disputes that may arise among member states of the agreement. Additionally, international guidance should be directed towards holding specialized seminars at international commercial arbitration centers in countries that have specialized offices in the field of patents.

Sources:

1- Dr. Ahmed Abdel Karim Salama, "Science of Conflict and Choice between Laws," 1st Edition, Mansoura, Al-Galaa Al-Jadeeda Library, 1996.

2- Dr. Ahmed Abdel Karim Salama, "International Contract Law," Dar Al-Nahda Al-Arabiya for Publishing and Distribution, 2008.

3- Dr. Ahmed Abdel Karim Salama, "International Intellectual Property Law: Study of International Agreements and Approaches to Intellectual Property Rights Protection," 1st Edition, Dar Al-Nahda Al-Arabiya, 2019.

4- Dr. Ahmed Ali Omar, "Industrial Property and Patents," Halimia Printing Press, Alexandria, Egypt, 2006.

5- Basim Abdul Razzaq Mohammed Al-Sheikh, "Patents and their Protection within the Framework of International Law," Journal of Sharia College for Law, Issue 38, No. 1/2, 2023.

6- Dr. Jabr Abdul Rahman, "Private International Law: Conflict of Laws," Dar Al-Nahda Al-Arabiya, Cairo, 1969.

7- Dr. Jalal Wannamahmoudin, "Legal Protection of Industrial Property According to the TRIPS Agreement," Dar Al-Jamea Al-Jadeed, 2004.

8- Dr. Hassan Al-Hadawi and Dr. Ghaleb Al-Dawoodi, "Private International Law, Volume 2: Conflict of Laws, Jurisdictional Conflicts, and Enforcement of Foreign Judgments," Dar Al-Kutub for Obedience, Mosul, 1988.

9- Dr. Khaled Abdel Fattah, "Enforcement and Conflict Problems of Intellectual Property Laws," Faculty of Law, Helwan University, Dar Al-Jamea Al-Jadeed, 2017.

10- Dr. Zuhair Al-Bashir, "Literary and Artistic Property (Copyright)," Ministry of Higher Education and Scientific Research, Baghdad, 1989.

11- Dr. Sami Badee Mansour, "Mediator in Private International Law," Dar Al-Ulum Al-Arabiya, Beirut, Lebanon, 1st Edition, 1974.

12- Dr. Sameer Jameel Al-Fatlawi, "Exploitation of Patents," Dar Al-Hurriya for Printing, Baghdad, 1978.

13- Dr. Salah El-Din Gamal El-Din, "Concise Guide to Private International Law," Unpublished, 2011.

14- Dr. Abdel Monem Hafez, "Summary of the Provisions of International Conflict Regulation," 1st Edition, Al-Wafa Legal Library, Alexandria, 2018.

15- Dr. Emad El-Din Al-Sharbini, "Commercial Law and Business Transactions - Merchant - Commercial Establishment and Companies," No Publishing House, No Date.

16- Dr. Omar Fuad Omar, "Mediator in Commercial Law, Volume 2," Dar Al-Nahda Al-Arabiya, Cairo, 2007.

17- Dr. Ghaleb Ali Al-Dawoodi, International Jurisdictional Conflict in Private International Law, Comparative Study, Al-Wajiz in Private International Law, 1st edition, Al-Sinhouri Library, 1996.

18- Dr. Fouad Abdul-Munim Riad, Summary in Nationality and the Status of Aliens in Egyptian and Comparative Law, Cairo, Dar Al-Nahda Al-Arabiya, 1984.

19- Dr. Majid Ammar, Industrial Licensing Contracts and Their Importance in Developing Countries, Dar Al-Nahda Al-Arabiya, Cairo, 1987.

20- Dr. Mohammed Dghish, Intellectual Property between the GATT Agreement and the World Intellectual Property Organization, International Political Journal, 1989.

21- Dr. Mohammed Ali Al-Aryan, Innovation as a Condition for Granting Patents between the Self-Standard and the Objective Standard, Dar Al-Jamea Al-Jadeed, 2011.

22- Dr. Mamdouh Abdel Rahim, Private International Law, Conflict of Laws, Amman, Dar Al-Thaqafa wa Al-Nashr, 2005.

23- Dr. Hashem Ali Sadik, Private International Law, Dar Al-Fikr Al-Jameed, Alexandria, 2005.

24- Dr. Hashem Ali Sadik, Conflict of Laws, 2nd edition, Nasr Printing Press, Egypt, Alexandria, 1972.

25- Dr. Hala Huthail Hadi, International Protection of Intellectual and Literary Property Rights, Iraqi Comparative Law Journal, Issue 57, 2008.

26- Dr. Hisham Ali Sadik, The Law Applicable to International Trade Contracts, Ma'aret Al-Ma'arif, Alexandria, 1995.

27- Hanspup Jorda, Christian Appleton, The Scientific Guide to the European Patent Convention, Translation: Raya Al-Qilubi, Dar Al-Thaqafa for Publishing and Distribution, Amman, no publication year provided.

28- Dr. Ybiton Halim Dos, The Role of Public Authority in the Field of Patents, Ma'aret Al-Ma'arif, Alexandria, 1983.

International Conventions:

1- Paris Convention of 1883.

2- Montevideo Convention of 1889.

3- Brussels Convention of 1900.

4-Washington Convention of 1911.

5- Stockholm 1968.

6- Patent Cooperation Treaty (PCT) of 1970.

7- Budapest Convention of 1979.

8- Paris Convention of 1983.

9- Washington Convention of 1970.

10-Trade-Related Aspects of Intellectual Property Rights (TRIPS) Agreement of 1994.

11-Patent Cooperation Treaty (PCT) of 1999.

Theses and Dissertations:

1- Ahmed Khalil Ibrahim Al-Sikar, Conflict of Laws in Intellectual Property Investment Contracts (Comparative Study), Ph.D. thesis at the University of Babylon, Faculty of Law, 2022.

2- Ahmed Mohammed Youssef, Conflict of Laws in Copyright, Master's thesis, Faculty of Law, Cairo University, 2009.

Foreign Sources: Unfortunately, without specific details or titles of the foreign sources, I cannot provide translations or additional information. If you can provide more specific information, I'll be glad to assist you further.

1- Alian beltran & sophie chauveau Gabriel galvez behar, patent cultures : piversity and harmonization in historical, Paris, 2001 .

2- Eskil Waage, I. application de deprincipes generaux de procedure en droit Europeen de brevets, ed litec , 2000.

3- Giovanna modiano, international patent licensing Agreements and can flict of lows, 2nw. J. Int'l, 1980.

4- Is abelle wekstein driot voisins dudvoited outeur et numeviq ue, litec, Paris, 2002 .

5- Joseph, Straus, genomics and the food, Industry: out look from an intellectual, property, prospestive, intellectual in the new, millen nium, edied by d. vaver and L. Bently, Cambride, 2004.

6- Schnitzer: Ie droit international prive suisse en matiere d'obligation Rec. des cours, 1968 .

7- Ulf, Ander felt, international patent-legislation and developing contries printed by martinus Nijhoff, the Hague, 2018.