

Special Rules Governing the Rights of the Parties to the Results of Scientific and Technical Activities Obtained in the Performance of Research, Development and Technological Works at the Expense of the Russian Federation

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ABSTRACT

The article analyzes the special rules governing the legal relations between state customers and contractors on the distribution of the rights of the parties to the results of scientific and technical activities obtained in the performance of research, development and technological works at the expense of the Russian Federation. It is shown that, in general, the evolution of the regulatory framework in this area has both positive and negative trends. Conclusions are drawn that the system of legal regulation of legal relations concerning distribution of the rights to the results of scientific and technical activity received at performance of research, developmental and technological works at the expense of the Russian Federation, developing, being improved, is still in a formation stage, it cannot be considered complete.

Keywords: intellectual property, the results of scientific and technical activities, contracts for the implementation of research, development and technological works, the state customer

The need for special regulation of legal relations in this area is determined by the need to specify the general provisions of the law in special regulatory legal acts, since one of the parties in the legal relations is a special entity that has a special legal status, namely the Russian Federation represented by its representatives.

The issues of regulating relations regarding the results of intellectual activity created at the expense of the state arouse the interest of researchers and practitioners, and have repeatedly become the subject of scientific research, as well as separate articles, which indicates the relevance of the topic under consideration. In this regard we should note the works of A.V. Atamas, E.G. Baklanova, V.F. Evstafiev, D.V. Orekhov, L.N. Khitrova, and Yu.A. Kovalev.

As a general rule (articles 1298, 1373, 1432, 1464, 1471 of the Civil Code of the Russian Federation), the rights to results of intellectual activities created at the expense of the Russian Federation shall belong to a company that perform government contract (to the contractor), unless the state contract stipulates that this right belongs to the Russian Federation on behalf of which the state customer acts, or jointly to the contractor and the Russian Federation.

Special regulations governing legal relations between state customers and contractors regarding the distribution of the rights of the parties to the results of scientific and technical activities obtained during the study, development and technological work at the expense of the Russian Federation are reflected in a number of by-laws.

A systematic analysis of laws in this area revealed that these norms are contained in more than fifty regulatory acts, including acts of ministries and departments, which, of course, creates difficulties in law enforcement.

Decrees of the President of the Russian Federation No. 556 of March 14, 1998 "On Legal Protection of Results of Military, Specialty, and Dual Purpose Research and Development, and Technological Works"¹ laid the foundation for the formation of the system of special regulations in the field under consideration (became void due to the issuance of the Decree of the President of the Russian Federation No. 673 of May 24, 2011) and No. 863 of July 22, 1998 "On the State Policy on Involvement in Economic Turnover of Results of Scientific and Technical Activity and Objects of Intellectual Property in the Field of Science and Technologies".² These decrees, the Government of the Russian Federation instructed to ensure the implementation of organizational measures aimed at the implementation of legal protection of the state interests in the process of economic and civil law circulation of the results of intellectual activity obtained in the performance of state contracts (agreements); determine the procedure for using the results of

¹ Russian Newspaper [Rossiyskaya Gazeta]. 19.05.1998, No. 94.

² Russian Newspaper [Rossiyskaya Gazeta]. 28.07.1998, No. 141.

scientific and technical activities obtained when conducting research, development and technological work for state needs under state contracts.

Also, when implementing the state policy on involvement the results of scientific and technological activities and intellectual property in the economic circulation, the following directions in science and technology have been prioritized: those providing a balance of rights and legitimate interests of legal entities, including the state, in the field of creation, legal protection and use of the results of scientific and technological activities and intellectual property in science and technology.

Of course, these decrees became a significant guide for public authorities, as concerns about the state of affairs in this area were expressed and the vector of development of the legal framework was set.

A regulatory act expressing the state's policy on the regulation of relations related to the implementation of scientific and technical solutions created at the expense of the federal budget is the Order of the Government of the Russian Federation No.1607-r of November 30, 2001 "On the Main Directions of the Implementation of the State Policy on Involving Results of Scientific and Technical Activities in Economic Circulation".³

The Order determined the direction of state regulation of legal relations in the field of the circulation of rights to the results of scientific and technical activities obtained under state contracts and agreements for the implementation of research, development and technological work for federal state needs.

In particular, the Order noted that developments containing protected intellectual property objects and other results of scientific and technical activities that provide the greatest socio-economic efficiency, as well as solving problems of strengthening the country's defense capability, are the priority for the state. In conditions of limited budget resources, the state can bear the costs associated mainly with the first stage — the creation of results of scientific and technical activities in priority areas of science and technology.

The Order stipulates that the state must be guaranteed rights to intellectual property objects and other results of scientific and technical activities created at the expense of the Federal budget, which, first, are directly related to ensuring the country's defense and security, and secondly, the state is responsible for bringing them to the stage of industrial application.

The Order also contains an important statement about the need to introduce the rights of the state to the results of scientific and technical activities in the economic circulation by transferring them either to the developing organization, or to the investor, or to another business entity.

It was noted that when transferring to business entities the rights to the results of scientific and technical activities created at the expense of the federal budget, the state does not consider the reimbursement of the costs of financing this activity as the main goal. Issues related to the regulation of the state's rights to the results of scientific and technical activities should be defined in state contracts for the performance of works for state needs, and other contracts (agreements) provided for by law. Moreover, contracts and agreements, one of the parties to which is the state and which provide for the subsequent transfer of rights to the results of scientific and technical activity, should provide the state with the opportunity to receive a non-exclusive, irrevocable and free license to use the results of scientific and technical activity for state needs.

These contracts and agreements should provide for specific obligations of organizations to which the state's rights to ensure that the developments are brought to the stage of industrial application and sale of finished products are transferred, the procedure for material incentives for contracting organizations, the procedure for paying remuneration to authors, as well as specific obligations of the party implementing the result of scientific and technical activities in the production practice, and sanctions for failure to fulfill these obligations.

The significance of Order No.1607-r is that the government proposed mechanisms for introducing the state's rights to the results of scientific and technical activities in the circulation. The Decree of the Government of the Russian Federation No. 982 of September 02, 1999 "On the Use of Scientific and Technical Activities"⁴ defines the basic provisions governing the activities of state customers in resolving issues related to the use of the deliverables.

Firstly, the decision entrusts state customers under state contracts and agreements for the performance of research, development and technological works for federal state needs, while securing to the Russian Federation the rights to the results of scientific and technical activities obtained during the implementation of these state contracts and agreements, disposal of these rights on behalf of the Rus-

³ Collection of Legislative Acts of the Russian Federation, 10.12.2001, No. 50, art. 4803.

⁴ Russian Newspaper [Rossiyskaya Gazeta]. 17.09.1999, No. 183.

sian Federation. Secondly, it is established that the use of intellectual property in the field of science and technology for Federal state needs is usually carried out on the basis of a free non-exclusive license provided by the state customer.

Under the Decree of the Government of the Russian Federation No. 342 of April 22, 2009 "On Certain Questions of Securing the Exclusive Rights to the Results of Scientific and Technical Activities" (as amended by Decree of the Government of the Russian Federation No. 1024 of December 8, 2011), federal executive bodies and organizations acting as state customers for research, development and technological works under state contracts for state needs (hereinafter referred to as the "state contracts") on behalf of the Russian Federation, when concluding state contracts, shall provide conditions for securing exclusive rights to inventions, utility models, industrial designs, selection achievements, integrated circuit topologies, programs for electronic computers, databases and production secrets (know-how) (hereinafter — "the results of scientific and technical activities") under the established procedure:

- for the Russian Federation, if:
 - 1) the results of scientific and technical activities are withdrawn from the circulation;
 - 2) The Russian Federation took the responsibility for the financing of work to bring the results of scientific and technical activities to the stage of practical application, culminating in the stage of launching products into production, including preparation of production, production of the installation series and qualification tests;
 - 3) the contractor did not ensure the completion of all the measures necessary for him to recognize or acquire exclusive rights to the results of scientific and technical activities until six months after the end of scientific research, experimental design and technological work;
 - 4) the results of scientific and technical activities were created in the course of research, development and technological work carried out in compliance with the international obligations of the Russian Federation;
- for the Russian Federation or, by decision of the state customer, jointly for the Russian Federation and the organization performing research, development and technological work (the contractor):
 - 1) if these results are directly related to the defense and security of the state;
- for the contractor on the terms determined by the state contract, in other cases.

Thus, Decree No. 342 defined the criteria for securing exclusive rights to the subjects of legal relations, which was an important step in the development of legal regulation in this field.

Of particular importance is the Decree of the Government of the Russian Federation No. 233 of March 22, 2012 "About Approval of Rules of Implementation by the State Customers of Management of the Rights of the Russian Federation to Results of Intellectual Activities of Civil, Military, Special and Dual Purpose"⁵ (as amended by the Decree of the Government of the Russian Federation No. 384 of March 30, 2019), which determined what shall be included in the management of the rights of the Russian Federation to the results of intellectual activity, namely:

- a) the implementation of measures to formalize the rights of the Russian Federation to the results of intellectual activity used and (or) created under the state contracts;
- b) state registration of results of research, development and technological works of civil, military, special and dual-use purposes;
- c) the organization of work on the valuation and adoption of accounting rights to the results of intellectual activity;
- d) disposal of the rights of the Russian Federation to the results of intellectual activity;
- e) the organization of the use of the results of intellectual activity.

A significant contribution to the regulation of issues related to the use of the results of scientific and technical activities obtained at the expense of the Russian Federation was made by Decree of the Government of the Russian Federation No. 9⁶ of January 26, 2012 (as amended by Decree of the Government of the Russian Federation No. 1397 of November 18, 2017)

"On Monitoring and Supervision of the Sphere of Legal Protection and Use of the Results of Intellectual Activity of a Civil Purpose, Created at the Expense of the Budget Allocations of the Federal Budget, as well as Control and Supervision in the Established Field of Activity in and Government Customers and Organizations — Public Contracts Involving Conduct Research, Development and Technological Work."

The resolution approved the "Regulation On Monitoring and Supervision of the Sphere of Legal Protection and Use of the Results of Intellectual Activity of a Civil Purpose, Created at the Expense of

⁵ Collection of Legislative Acts of the Russian Federation, 02.04.2012, No. 14, art. 1637.

⁶ Russian Newspaper [Rossiyskaya Gazeta]. 01.02.2012, No. 20.

the Budget Allocations of the Federal Budget, as well as Control and Supervision in the Established Field of Activity in and Government Customers and Organizations — Public Contracts Involving Conduct Research, Development and Technological Work".

In accordance with the decree, federal state supervision refers to the activities of the Federal Service for Intellectual Property aimed at preventing, detecting and suppressing violations of requirements established by the legislation of the Russian Federation in the field of intellectual property by state bodies, governing bodies of state extra-budgetary funds, and federal treasury institutions, or other recipients of federal budget funds placing orders for the implementation of science but research, development and engineering works under civil government contracts, and organizations implementing government contracts and agreements, which are financed at the expense of federal budget allocations.

To develop the regulatory framework on introducing into the economic circulation of the results of scientific and technical activities obtained at the expense of the Russian Federation, the Decree of the Government No. 1275 of December, 26, 2013 (as amended by the Decree of the Government of the Russian Federation No. 1465 of December, 02, 2017) "On Approximate Terms and Conditions of State Contracts under the State Defense Order", the "Regulation on the Model Terms of State Contracts under the State Defense Order" was approved. Clause 22 of the Decree determined that the state contract for the performance of research and development works may include conditions for securing the right of ownership of the results of research and development works, including in relation to the results of intellectual activity obtained during the performance of the state contract, the distribution and procedure for securing rights to the created protected results of intellectual activity. Also, under clause 22, the following conditions may be included in contracts:

- 1) the responsibility of the chief contractor to ensure legal protection of the created results of intellectual activity in accordance with the decision of the state customer, by:
 - performing legally significant measures on registration of rights to the created results of intellectual activity on the territory of the Russian Federation and on the territories of foreign states;
 - taking measures to preserve the confidentiality of information that constitutes the secret of production (know-how);
- 2) the obligation of the state customer to provide the head contractor with a free simple (non-exclusive) license to use the results of intellectual activity, the exclusive right of which belongs to the Russian Federation, to perform work under the state contract.

The Decree of the Government of the Russian Federation No. 606 of July 2, 2014 "About Procedure for Development of Standard Contracts, Standard Conditions of Contracts, and also About Cases and Conditions of their Application"⁷ (as amended by the Decree of the Government No. 663 of May 30, 2017), the Rules for developing standard contracts, standard terms of contracts were approved, according to which the state contract must provide for conditions on the rights of the parties to the results of intellectual activity created during the performance of works.

We should also mention "Guidelines for Reflecting in State Contracts of Issues of Legal Protection and Use of Results of Scientific and Technical Activities"⁸ approved by Rospatent on March 02, 2006, which set out recommendations on the issue of implementing provisions in state contracts that establish the rights and obligations of the parties to secure the rights, legal protection and use of the created results of scientific and technical activities.

The Guidelines indicate that the following provisions must be settled by the parties:

1. Securing rights to the results of scientific and technical activities obtained during the performance of works under the contract.
2. Obligations of the contractor to ensure state interests.
3. Obligations to ensure legal protection of the results obtained by issuing patents or using the trade secret regime.
4. Obligations of the contractor to conduct patent research in full under GOST R 15.011-96.
5. Obligations of the state customer and the contractor regarding the use of previous intellectual property or rights and information owned by third parties.
6. Obligations of the owner of the rights to created intellectual property objects to pay remuneration to their authors.

⁷ Collection of Legislative Acts of the Russian Federation, 14.07.2014, No. 28, art. 4053.

⁸ Guidelines for Reflecting in State Contracts of Issues of Legal Protection and Use of Results of Scientific and Technical Activities [Metodicheskie rekomendatsii po otrazheniyu v gosudarstvennykh kontraktakh voprosov pravovoi okhrany i ispol'zovaniya rezul'tatov nauchno-tekhnikeskoi deyatel'nosti] // Patents and licenses. Intellectual Rights [Patenty i litsenzii. Intellektual'nye prava]. No. 5, 2006. P. 47. (In rus)

The procedure for using the results of work obtained under the state contract. The decision on the distribution of rights between the state that finances intellectual activity and the performer of works must be made under the state contract (agreement).

A full and accurate indication of the rights and obligations of the state customer and the contractor in state contracts in relation to the created results of scientific and technical activities should contribute to further improvement of the contract system for the fulfillment of state orders, increase the responsibility of state customers for legal protection and the use of scientific and technical results created due to federal budget, protecting the interests of the state while involving the results of scientific and technical-economic activity and increase the efficiency of legal use of the created results of scientific and technical activities.

In general, the evolution of the regulatory framework in this area has, in our opinion, both positive and negative trends. The positive trend is that the state clearly expresses concern about the preservation of rights to results obtained at the expense of the budget, while striving to ensure a balance of rights and interests of participants in legal relations. As a negative trend, we should note the declarative nature of the norms available in legal acts, since the mechanism for their implementation is not defined. In particular, having determined that developments containing the safeguarding results of scientific and technical activities that provide the greatest socio-economic efficiency are priority for the state in securing their rights, the legislator did not disclose the mechanism for implementing this norm, and did not define efficiency criteria, therefore, of course, such standards do not work in practice. And there is an objective situation when, in the presence of a large array of regulatory acts, it is necessary to introduce new acts in order to explain the mechanism for implementing the previous ones. Of course, this situation does not ensure the sustainability of law enforcement in this area.

Summing up, we should note that the system of legal regulation of rights to the results of scientific and technical activities obtained during research, development and technological works at the expense of the Russian Federation, while developing and improving, is still in its infancy, and it cannot be considered complete.