

ABSTRACT
THESIS IN PRIVATE LAW
CONTRACTS FOR THE TRANSFER OF TECHNOLOGY
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This thesis discusses the various issues related to technology transfer contracts. In the first chapter it is recognized the complexity of the research. This complexity can be traced back to five different types: qualitative complexity, inherent in the various forms of research undertaken; subjective complexity, inherent in the different types of actors in the field of research; institutional-organizational complexity, inherent in the different types of public entities dealing at Community or national level, to coordinate the research activities; programmatic complexity, inherent in the different levels of programming research; financial complexity, represented by the wide regulations on research funding. We distinguish between "virtuous" and "non virtuous" forms of complexity. It is hoped a simplification and rationalization, through legislative action, of the subjective and financial complexity. In the second chapter, the basic constitutional and European principles of the research are exposed. We explain the difference between scientific and technical research and the consequent implications on the constitutional level. We examine the implications of the research on employment and we hope the move to stronger forms of participation of workers in basic choices inherent in the business activities, such as the introduction of technological innovations in the production process. We note that, beyond the constitutional provisions specifically related to the research activities, the latter has so many constitutional references as there are subjects in which it is expressed.

In the third chapter we discuss three questions.

Preliminarily we examine the possibility of considering the new intangible resources such goods in a legal sense. After taking note of the various thesis on the subject, we adhere to the setting that considers everything well qualified to meet interest worthy of protection under the legal system. The adherence to this setting allows to overcome the problems related to the immateriality of new goods, which becomes irrelevant to the legal classification. In this context, characters such as materiality, net-worth, and the limited appropriability become only indices revealing the existence of a right in a legal sense, not of the requirements necessary for the existence of an asset.

We examine the possibility that the right to property must relate to the new intangible assets. We believe that the right of ownership are not related necessarily to an immediate and direct relationship with the "res". Similarly the exclusivity enjoyed by the owner is not connected to the physicality of the thing, but at the same utility that can be drawn. It does not extend it to the thing as such, but in the ownership right on the res. In this context it is possible to conclude that the right of ownership may well be designed to the new intangible assets. The peculiarities of such goods, however, necessarily conform the right to property.

We assess the ability to assimilate the profiles of a financial nature relating to the copyright law of property. After taking note of the various claims made regarding the status of copyright we conclude for the opportunity of splitting sharply moral and patrimonial rights of the author. While the moral right of the author is similar to the rights of personality, property rights are easily comparable to the property.

The fourth chapter discusses the different forms of technology transfer. We distinguish between horizontal and vertical forms of transfer and between voluntary, involuntary and compulsive forms of technology transfer. We examine the different types of negotiating technology transfer, distinguishing between stores that have as their main or exclusive purpose the technology transfer (sale, licensing, material transfer agreement) and forms that only incidentally result in a transfer of technology (franchising, industrial subcontracting). We examine the specific object of the implications they have on contract negotiation structure (in terms of spatial, temporal and faculties related to the situation of belonging). Particular emphasis is given to the collaborative structure of the research and the resulting co-ownership of the results arising from it. There is no clear laws governing the matter, since the choice of law reference to the rules on communion is concretely unsatisfactory. We examine the effects on the legal transaction of the patent invalidation, addressing the issues related to the "equitable reimbursement" under art. 77 of the Code. With specific reference to the license agreement, we examine the different types of compensation, which may be non-monetary and monetary field, the latter are in turn divided into fixed or variable fees. Particular attention is devoted to the royalties and costs of monitoring that the licensor must support in order to avoid opportunistic behavior (under reporting) of the licensee. We also examine the issues on the admissibility of post-expiration royalties. We conclude for the full eligibility of post-expiration royalties, in fact capable of facilitating the transfer of technologies. With regard to material transfer agreement, we examine the issues related to the transfer of risk and the ownership of the results achieved by experimenting on the material licensed for use.

In the fourth chapter we also examine the issues related to ownership of inventions and intellectual property carried out as part of the employment relationship, with particular attention to cases of autonomous work. We examine the legislative changes made in 2001 about the inventions of university researchers. We found that the choice for the individual ownership is not aligned with legislation in other European countries and with U.S. practice. We examine the issues related to recognition of the individual academic inventions.

We also examine some tools, widely used by universities, in order to ensure the transfer of technology: these are the spin-off and industrial liaison office. On this point, we make a comparison between the situation in Europe and in the U.S. We examine the forms of financing and the recovery, by the University, of the licensed technology in the event of failure of the spin-off.

After a quick pass on the determination of fees in contracts for the transfer of technology, we examine the relationship between competition law and research contracts. We remark the general incompatibility with the European Treaty of agreements which exclude or restrict competition. We examine the block exemption provided for the research sector, by Regulation No 772/2004. We envision limitations of the Community Regulation, in particular with respect to the quantification and excessive rigidity of market thresholds, and also with regard to the inapplicability of the rules to agreements between more than two companies.

We also analyze the different forms of collective societies and, in particular, the patent pools, the standard-setting organizations and collective rights organizations. We examine, in a continuous comparison with the U.S. and Japanese legal systems, the implications on competition of the aforementioned types of agreements, as well as investigating the conventional remedies and case law developed to counter the opportunistic behavior of the parties.

In the conclusion of the thesis we hope for a more streamlined regulatory approach of the research. Such intervention should take into account the concrete problems of the sector. In particular, it will be necessary to reform the national law in the field of academic inventions and read, in the light of competition law, the technology transfer contracts. The legislator will have to take note that intellectual property and competition law, converge towards a single result: the efficiency of the market. Through contracts for the transfer of technology, in fact, a competitor in the market is created, resulting in a positive effect on business and economy.