



Licensing

in 30 jurisdictions worldwide

Contributing editor: Bruno Floriani

2011



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Peru

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Overview

- 1 Are there any restrictions on the establishment of a business entity by a foreign licensor or a joint venture involving a foreign licensor and are there any restrictions against a foreign licensor entering into a licence agreement without establishing a subsidiary or branch office? Whether or not any such restrictions exist, is there any filing or regulatory review process required before a foreign licensor can establish a business entity or joint venture in your jurisdiction?

No, there are no restrictions on the establishment of a business entity by a foreign licensor or a joint venture involving a foreign licensor, nor any restrictions against a foreign licensor entering into a licence agreement without establishing a subsidiary or branch office; except for certain restrictions in the right of property. In these cases, article 71 of the Peruvian Constitution provides that within 50 kilometres of the border, foreigners cannot acquire or possess, under any title, mines, lands, forests, water, fuel and energy sources, directly or indirectly, individually or in partnership, under penalty of forfeiture to the state, the right thus acquired.

A regulatory review process is required before a foreign licensor can establish a business entity or joint venture does not exist. In some cases, the regulatory review process takes place after a business has been established, for example in the case of post office services, aviation, health services, banking and insurance, telecommunications, and the exploration of natural resources.

Nonetheless, such limitations do not affect the establishment of a business entity by a foreign licensor.

Kinds of licences

- 2 Identify the different forms of licence arrangements that exist in your jurisdiction.

The Peruvian Civil Code does not define licensing, but it is generally understood as an agreement between two or more persons (natural or moral, national or foreign, private or public) in order to grant authorisation to use some goods or rights, for a determined period of time and within a determined territory, without an effective transfer of ownership or property, on either a remunerated or free of charge basis. In this sense the following types of licence exist in Peru:

- Licensing of invention patents, including those that have been already granted and those whose grant is still pending. In these cases, it is necessary to indicate that at the expiry of a period of three years following a patent grant, or of four years following the application for a patent (whichever is longer) the competent national office may grant a compulsory licence mainly for the industrial manufacture of the product covered by the patent, or for full use of the patented process, at the request of any interested party, but only if, at the time of the request, the patent had not been exploited in Peru, or if the exploitation of the invention had been suspended for more than one year, as stated in article 61 of Decision 486 – Common Industrial Property Regime.

- Licensing of utility models or industrial designs, or both, that have been granted or are pending. Registration with the Patent Office of INDECOPI is compulsory under Law No. 27811 – the law establishing the system of protection of the collective knowledge of indigenous peoples linked to biological resources.
- Licensing of collective knowledge of indigenous peoples. Agreements concluded between the representative organisation of indigenous peoples possessing collective knowledge and a third party that incorporates terms and conditions on the use of that collective knowledge. Registration with the Patent Office of INDECOPI is compulsory under Law No. 27811 (see above).
- Licensing of exploitation of new plant varieties. In exceptional cases of national security or public interest, national governments may declare it freely available (compulsory licensing) on the basis of fair compensation to the breeder, which is determined after hearing both the parties and an expert.
- Licensing of registered or registration-pending trademarks, and other distinctive signs (certification mark, trade name, etc).
- Licensing of transfer of technology.
- Licensing of software and other copyright material. In this theme, the economic rights of the author may be wholly or partly transferred by means of a licence agreement. In contrast, the moral rights of the author are inalienable and irrevocable, meaning they cannot be transferred, licensed or waived.
- Licensing of franchise agreements.
- Licensing of the name, voice and image of a person.

All licences of intellectual property right, except the licensing of the collective knowledge of indigenous peoples, must be registered with INDECOPI – the National Institute for the Defence of Competition and Protection of Intellectual Property – in order for them to be opposable to third parties. However, failure to register with INDECOPI does not invalidate or affect the licence agreement.

Law affecting international licensing

- 3 Does legislation directly govern the creation, or regulate the terms, of an international licensing relationship? Describe any such requirements.

Peruvian legislation does not directly govern the creation, or regulate the terms, of an international licensing relationship. However, in the case of licensing of ‘collective knowledge’ of indigenous peoples the following applies:

- the indigenous peoples possessing collective knowledge may grant licences to third parties to use such knowledge only by contract written in the native language and Castilian, and for a renewable period of not less than one year or more than three years; and
- the beneficiary of the licence must pay a percentage of not less than 10 per cent of gross sales, before taxes, resulting from the commercialisation of products developed from collective

knowledge, to the Fund for the Development of Indigenous Peoples.

- 4 Are there any pre-contractual disclosure requirements imposed on a licensor in favour of its licensees, or any requirements to register a grant of international licensing rights with authorities in your jurisdiction? If so, do these requirements still apply if your jurisdiction forms part of a multi-jurisdictional territory in respect of which rights are being granted?

The rights under licensing must be registered or have registration pending in the corresponding office of INDECOPI. The validity of licensing depends on the actual granting of the right pending.

- 5 Are there any statutorily or court-imposed implicit obligations in your jurisdiction that may affect an international licensing relationship, such as good faith or fair dealing obligations or the obligation to act reasonably in the exercise of rights?

The Peruvian Constitution provides that contractual terms cannot be changed by legislation or other provisions of any kind (article 62). In this sense, the Peruvian Civil Code provides that a legally executed contract is regarded as binding the contracting parties, and cannot be invalidated except with their consent or with legal cause in judicial process; and the contract must be construed in accordance with what has been expressed in it and the principle of good faith (article 1362).

- 6 Does the law in your jurisdiction distinguish between licences and franchises? If so, under what circumstances, if any, could franchise law or principles apply to a licence relationship?

No, our jurisdiction does not distinguish between licences and franchises. The franchise does not have a specific regulation, so it is an atypical contract. In this sense, directly applicable legislation is the civil code, rules of competition law, intellectual property and labour and tax law, among others.

Intellectual property issues

- 7 Is your jurisdiction party to the Paris Convention for the Protection of Industrial Property? The Patent Cooperation Treaty (PCT)? The Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs)?

Yes. Peru is party to the Paris Convention for the Protection of Industrial Property, the Patent Cooperation Treaty (PCT) and the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs).

- 8 Can the licensee be contractually prohibited from contesting the validity of a foreign licensor's intellectual property rights or registrations in your jurisdiction?

Yes, it is possible to establish a contractual prohibition for the licensee to contest the validity of a foreign licensor's intellectual property rights (IPR) or registrations in Peru. But a contractual disposition that limits the exercise right to legal action, for example, nullity of trademark or patent, might not be considered by the authority in question.

- 9 What is the effect of the invalidity or expiry of registration of an intellectual property right on a related licence agreement in your jurisdiction? If the licence remains in effect, can royalties continue to be levied?

The invalidity or expiry of registration of an Intellectual Property Right (IPR) is cause for the termination of the licence.

However, if the parties agree that the licence remains in force, notwithstanding the invalidity or revocation of the right, the royalties may still be received; but the Tax Authority (The National Superintendency of Tax Administration) may observe this payment, because there would not be support of royalty payments over invalid or expired IPR.

- 10 Is an original registration or evidence of use in the jurisdiction of origin, or any other requirements unique to foreigners, necessary prior to the registration of intellectual property in your jurisdiction?

In Peru, it is not necessary to have evidence of an original registration or use of the IPR in the jurisdiction of origin, or any other requirements unique to foreigners; except for rights over commercial names. In this case, such rights are acquired by public use and continuous and good faith in Peru, as long as such use does not affect the rights of third parties.

- 11 Can an unregistered trademark be licensed in your jurisdiction?

No. Pursuant to Peruvian law only registered trademarks, or trademarks that are in the process of being registered in Peru, may be licensed.

- 12 Are there particular requirements in your jurisdiction: for the validity of an intellectual property licence; to render an intellectual property licence opposable to a third party; or to take a security interest in intellectual property?

In Peru there are no specific requirements for the validity of an IPR licence. The general requirements for any agreement are:

- the complete data of the parties;
- the object of agreement, in this case, IPR licensing;
- the term, royalties and other clauses; and
- it must be in writing.

The licences of IPR must be registered with the INDECOPI in order for them to be opposable to third parties and to guarantee the licensed rights.

- 13 Can a foreign owner or licensor of intellectual property institute proceedings against a third party for infringement in your jurisdiction without joining the licensee from your jurisdiction as a party to the proceedings? Can an intellectual property licensee in your jurisdiction institute proceedings against an infringer of the licensed intellectual property without the consent of the owner or licensor? Can the licensee be contractually prohibited from doing so?

A foreign owner or licensor of IPR (patent and trademark) may freely exercise its rights and institute proceedings against a third party for infringement of IPR. In cases of joint ownership of IPR, any of the joint owners may bring action for infringement without the consent of others, unless otherwise agreed between the joint owners.

However, in cases of infringement of rights pertaining to audiovisual works and other copyrighted materials, both the owner and producer may exercise their rights, like the producer and the assignee or licensee of the rights, as stated in articles 67 and 138, of Legislative Decree 822 – Law on Copyright, unless otherwise agreed.

The licensee may be contractually prohibited from initiating actions against third parties for violation of the IPR.

14 Can a trademark or service mark licensee in your jurisdiction sub-license use of the mark to a third party? If so, does the right to sub-license exist statutorily or must it be granted contractually? If it exists statutorily, can the licensee validly waive its right to sub-license?

Yes, in Peru a trademark may be sub-licensed to a third party, and must be granted contractually. The right to sub-license does not exist statutorily.

15 Is your jurisdiction a 'first to file' or 'first to invent' jurisdiction? Can a foreign licensor license the use of an invention subject to a patent application but in respect of which the patent has not been issued in your jurisdiction?

Peru is a 'first to file' jurisdiction. Pursuant to Peruvian law, only registered patents, or patents that are in the process of being registered in Peru may be licensed.

16 Can the following be protected by patents in your jurisdiction: software; business processes or methods; living organisms?

No, none of the above are subject to patents in Peru.

The following shall not be considered inventions:

- discoveries, scientific theories, and mathematical methods;
- any living thing, either complete or partial, as found in nature, natural biological processes, and biological material, as existing in nature, or able to be separated, including the genome or germ plasm of any living thing;
- literary and artistic works or any other aesthetic creation protected by copyright;
- plans, rules, and methods for the pursuit of intellectual activities, playing of games, or economic and business activities;
- computer programs and software, as such; and
- methods for presenting information.

17 Is there specific legislation in your jurisdiction that governs trade secrets or know-how? If so, is there a legal definition of trade secrets or know-how? In either case, how are trade secrets and know-how treated by the courts?

Peru does not have specific legislation for trade secrets or know-how, but Decision 486 – Common Industrial Property Regime, provides that an industrial secret shall be considered to be any undisclosed information within the lawful control of an individual person or legal entity that may be used for any productive, industrial, or commercial activity and that is capable of being transmitted to a third party, so long as that information:

- is secret in the sense that it is not, as a body or in the precise configuration and assembly of its components, generally known among, or readily accessible to persons within the circles that normally deal with the kind of information in question;
- has commercial value because it is secret; and
- has been the subject of reasonable steps by the person lawfully in control of the information to keep it secret.

The INDECOPI Office of Free Competition has established guidelines about confidential information received in the administrative procedures known by this state entity; and in administrative procedures, the confidentiality is respected and protected by the authorities.

18 Does the law allow a licensor to restrict disclosure or use of trade secrets and know-how by the licensee or third parties in your jurisdiction, both during and after the term of the licence agreement? Is there any distinction to be made with respect to improvements to which the licensee may have contributed?

Yes. Peruvian legislation allows a licensor to restrict the disclosure or use of trade secrets and know-how by the licensee or third parties, both during and after the term of the licence agreement.

No distinction is to be made with respect to improvements to which the licensee may have contributed. Trade secrets and know-how, even with improvements, shall be confidential, and the licensee cannot disclose the secret without the consent of the owner or authorised user.

19 What constitutes copyright in your jurisdiction and how can it be protected?

Copyright in Peru is protected by law from the time of creation and falls under two different categories, namely: moral rights (rights that are inalienable, unattached, imperceptible and unrenounceable); and economic rights (rights of use, publication, reproduction, translation, etc, over their works).

Copyrights may be registered in the Copyright Office of INDECOPI, but do not have to be registered to be protected. Protected works include, but are not limited to:

- works expressed in writing, that is, books, pamphlets and any other kind of work expressed in letters, signs or conventional marks;
- lectures, addresses, sermons and other works of the same nature;
- musical compositions with or without words;
- dramatic and musical works;
- choreographic and mimed works;
- cinematographic works and other audiovisual works expressed by any process;
- works of fine art, including drawings, paintings, sculptures, engravings and lithographs;
- works of architecture;
- photographic works and works expressed by processes analogous to photography;
- works of applied art;
- illustrations, maps, sketches, plans, diagrams and three-dimensional works relating to geography, topography, architecture or science;
- computer programs;
- anthologies or compilations of assorted works and also data bases, which, by the selection and arrangement of their contents, constitute personal creations.

20 Is it advisable in your jurisdiction to require the contractual assignment of copyright by the licensee to the licensor for any artwork, software improvements and other works that the licensee may have contributed to?

Yes. It is advisable to require such assignment by the licensee to the licensor, because any such authorised contributions will be regarded as a licensee's copyright. Such contractual assignment must be in writing. Article 76 of Legislative Decree No. 822 – Copyright Law, provides:

The consent of the author shall not be required for the reproduction of a program code and the translation of the form thereof when such action is essential to achieve the inter-operability of an independently created program with other programs, provided that the following requirements are met:

- (a) *the acts must be performed by the lawful licensee or by any other person empowered to use a copy of a program, or in their name by a person duly authorized by the owner;*
- (b) *the information essential for inter-operability to be achieved must not have been previously, or must not be readily and rapidly in the light of all the circumstances subject to a reasonable request made to the owner, available to the persons referred to in the foregoing sub paragraph;*
- (c) *the acts must be confined strictly to those parts of the original program that are essential to the achievement of inter-operability.*

In no event may this information be used for purposes other than those mentioned in this article, or for the development, production or marketing of a program that is substantially similar in expression, or for any other act in violation of the author's rights.

Software licensing

21 Does the law in your jurisdiction recognise the validity of 'perpetual' software licences? If not, or if it is not advisable for other reasons, are there other means of addressing concerns relating to 'perpetual' licences?

In Peru, the law does not recognise the validity of 'perpetual' software licences. Legislative Decree No. 822 – Copyright Law limits the duration of the protection to the life of the author plus 70 years following the author's death.

22 Are there any legal requirements to be complied with prior to granting software licences? In particular, are there import or export restrictions on software?

Legislative Decree No. 822 does not provide any legal requirements to be complied with prior to the granting of software licences. There are no restrictions for the import or export of legally produced software.

However, the following must be noted according to the applicable law:

- assignment shall be limited to the right or rights assigned and to the contractually agreed time and territorial scope. All rights not expressly assigned remain reserved to the author;
- contracts for the assignment of economic rights, contracts licensing use and any other authorisation granted by the owner of rights shall be evidenced in writing, except where the law presumes the transfer of such rights to be *inter vivos*;
- it shall be presumed, unless otherwise agreed, that the authors of the computer program have assigned to the producer, exclusively, without limitation and for the entire duration thereof, the economic rights recognised in the law; and
- unless otherwise agreed, the authors may not object to the making or authorisation by the producer of alterations to or successive versions of the program, or of programs derived therefrom.

23 Who owns improvements and modifications to the licensed software? May a software licensee obtain bug fixes, upgrades and new releases from the licensor in the absence of a contractual provision to that effect?

Peruvian law provides that improvements and modifications to copyrighted software must be authorised by licensor, and that the authorised improvements and modifications belong to the licensee.

However, the lawful user of a computer program may make a copy or adaptation of the said program provided that:

- it is essential for the use of the program; and
- it is intended exclusively as a reserve copy to replace a legitimately acquired copy where the latter cannot be used on account of damage or loss.

Also, the adaptation of a program by the lawful user, including the correction of errors, shall not constitute adaptation or transformation unless it has been expressly prohibited, except in the case of express prohibition by the owner of the rights, provided that the adaptation is intended solely for personal use, as stated in article 75 of Legislative Decree No. 822. Question 20 should also be noted.

24 May a software licensor include a process or routine to disable automatically or cause unauthorised access to disable, erase or otherwise adversely affect the licensed software?

Peruvian legislation allows the use of an 'effective technological measure', defined as any technology, device or component that in the normal course of its operation, controls legal access to a work, performance or phonograph, or protects any copyright or related right.

The licensor must to inform the licensee of the effective technological measure (process or routines) in order to avoid any complaints.

25 Have courts in your jurisdiction recognised that software is not inherently error-free in determining the liability of licensors in connection with the performance of the licensed software?

We have no knowledge of any Peruvian court ruling that software is or is not inherently error-free; but the Peruvian Civil Code provides the seller's liability for any errors or defects, even hidden, in the goods transferred.

26 Have courts in your jurisdiction restricted in any manner the enforceability or applicability of the terms and conditions of public licences for open source software (ie, GNU and other public licence agreements)? Have there been any legal developments of note in your jurisdiction concerning the use of open source software?

No, the Peruvian courts do not restrict in any manner the enforceability or applicability of the terms and conditions of public licences for open source software such as GNU, Creative Commons, Colors Juris, etc.

Peruvian legislation allows the use of free software in Peruvian public institutions, according the Law 28,612, which regulates the use, acquisitions and adaptation of software in the public administration.

Royalties and other payments, currency conversion and taxes

27 Is there any legislation that governs the nature, amount or manner or frequency of payments of royalties or other fees or costs (including interest on late payments) in an international licensing relationship, or require regulatory approval of the royalty rate or other fees or costs (including interest on late payments) payable by a licensee in your jurisdiction?

No, all licensing terms are freely set by the contracting parties, including payment of royalties, fees or costs in connection with international licence agreements.

28 Are there any restrictions on transfer and remittance of currency in your jurisdiction? Are there any associated regulatory reporting requirements?

No, but the remittance of money from Peru to foreign jurisdictions is taxed.

29 In what circumstances may a foreign licensor be taxed on its income in your jurisdiction?

Income generated in Peru and which is payable to foreign non-residents is taxed with 30 per cent income tax of the total payable amount. The Peruvian legislation provides that it is mandatory for licensees to withhold this income tax and transfer it to the local tax authorities.

The double taxation is avoided pursuant to any applicable double taxation treaties with other countries. Peru has signed treaties to avoid double taxation with countries of the Andean community

(Ecuador, Colombia and Bolivia), Canada, Chile and Brazil. Countries in the process of negotiations are Sweden, France, Italy, the UK and Thailand.

- 30** Can a judgment be rendered by courts in a foreign currency in your jurisdiction? If not, would a contractual indemnity for any shortfall to a foreign licensor due to currency exchange fluctuations be enforceable?

No, Peruvian judgments must be in local currency. If the contractual indemnity is in foreign currency, it must be quoted in local currency at the exchange rate.

Competition law issues

- 31** Are practices that potentially restrict trade prohibited or otherwise regulated in your jurisdiction?

Yes. Legislative Decree 1034 – Repression of Anti-competitive Conducts Law – prohibits and sanctions behaviours in restraint of free competition.

The Defence of Free Competition Commission of INDECOPI is the authority legally responsible for examining the behaviours in restraint of free competition.

- 32** Are there any legal restrictions in respect of the following provisions in licence agreements: duration, exclusivity, internet sales prohibitions, grant-back provisions and non-competition restrictions?

Yes, non-competition restrictions (restrictive practices) are prohibited per se by Peruvian law.

The practices of abuse of dominance should be considered on a case by case basis, under the rule of reason, and will only be prohibited if they restrict competition. These issues are applicable even to licensing agreements of IPR.

However, internet sale prohibitions and grant-back provisions can be applied to the law of consumer protection.

Indemnification, disclaimers of liability, damages and limitation of damages

- 33** Are indemnification provisions commonly used in your jurisdiction and, if so, are they generally enforceable? Is insurance coverage for the protection of a foreign licensor available in support of an indemnification provision?

Peruvian law allows parties to stipulate indemnification provisions. Insurance coverage for damages (damnum emergens and lucrum cessans) is provided by the Peruvian Code Civil.

- 34** Can the parties contractually agree to waive or limit certain types of damages? Are disclaimers of liability generally enforceable? What are the exceptions, if any?

The parties may contractually agree to waive or limit certain types of damages; but article 1968 of the Peruvian Civil Code provides that the agreement is null if, in advance, liability by malice or inexcusable negligence is excluded or limited.

Also, abusive provisions that waive or limit the liability of a supplier of goods or services, for defects or damages of any nature could be declared null, in accordance with the Peruvian legislation on consumer protection.

Termination

- 35** Does the law impose conditions on, or otherwise limit, the right to terminate or not to renew an international licensing relationship; or require the payment of an indemnity or other form of compensation upon termination or non-renewal? More specifically, have courts in your jurisdiction extended to licensing relationships the application of commercial agency laws that contain such rights or remedies or provide such indemnities?

Peruvian law does not limit or impose conditions for terminating or not renewing licence agreements.

- 36** What is the impact of the termination or expiration of a licence agreement on any sub-licence granted by the licensee, in the absence of any contractual provision addressing this issue?

The termination or expiration of a licence agreement would also cause the cessation of the sub-licences granted by the licensee.

Bankruptcy

- 37** What is the impact of the bankruptcy of the licensee on the legal relationship with its licensor; and any sub-licence that licensee may have granted? Can the licensor structure its international licence agreement to terminate it prior to the bankruptcy and remove the licensee's rights?

The Peruvian regulation on bankruptcy provides that the contracts are not automatically terminated by bankruptcy. The bankruptcy administrator may continue the performance of the agreement when necessary to maintain and preserve the assets of the bankrupt estate.

Governing law and dispute resolution

- 38** Are there any restrictions on an international licensing arrangement being governed by the laws of another jurisdiction chosen by the parties?

No. The contracting parties may freely agree that the licence agreement be governed by the laws of a foreign jurisdiction.

- 39** Can the parties contractually agree to arbitration of their disputes instead of resorting to the courts of your jurisdiction? If so, must the arbitration proceedings be conducted in your jurisdiction or can they be held in another?

Yes. Peruvian law allows for the use of arbitration to resolve parties' disputes. In this case, the arbitration proceedings may be conducted in Peru or abroad.

- 40** Would a court judgment or arbitral award from another jurisdiction be enforceable in your jurisdiction? Is your jurisdiction party to the United Nations Convention on the Recognition and Enforcement of Foreign Arbitral Awards?

Court judgments or arbitral awards from other jurisdictions are enforceable in accordance with local norms and international treaties signed by Peru. For recognition and execution in Peru, foreign judgments or arbitral awards must be approved by the Peruvian Tribunals. Peru is a party to the United Nations Convention on the Recognition and Enforcement of Foreign Arbitral Awards.

41 Is injunctive relief available in your jurisdiction? May it be waived contractually? May the parties waive their entitlement to claim specific categories of damages in an arbitration clause?

Yes. Admission should be granted on the probable success and merit (*fumus boni juris*), the risks that the delay would deprive the legitimate exercise of the violated right and cause irreparable harm (*periculum in mora*), and present a warranty for the injunctive relief.

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