The Application of the Theory of Fundamental Breach in Technology Licensing Contracts

Mohammad Hassan Sadeghi Moghadam[1*]| Reza Arabzadeh[2]| Azadeh Shams[3]

1. Professor, Department of Law, University of Tehran, Iran
2. Ph.D Candidate in Private Law, Shahid Beheshti University, Tehran, Iran
3. Master's student in Private Law, University of Tehran, Iran

[*] Corresponding Author Email: mhsadeghy@ut.ac.ir

Abstract

Technology license agreements are pivotal instruments for the transfer of technical knowledge and intellectual property rights in international commerce. The inherently complex, continuous, and often cross-border nature of these contracts exposes them to various types of contractual breaches. Within this context, the "theory of fundamental breach" serves as a key doctrine in contract law, providing a criterion to identify instances where a breach is so severe that it undermines the very foundation of the contract and grants the aggrieved party the right to terminate it. The central question this article addresses is whether and how this theory, primarily developed within the framework of traditional contracts, can be applied to the complex realm of technology licensing. To answer this, the authors examine international instruments (such as the CISG and UNIDROIT Principles) and analyze case law (primarily from the United States).

Theoretical Foundations of Fundamental Breach

A fundamental breach is defined in Article 25 of the CISG and other authoritative documents as a breach which results in such detriment to the other party as to substantially deprive him of what he is entitled to expect under the contract, provided that the breaching party foresaw, or a reasonable person of the same kind in the same circumstances would have foreseen, such a result. The common core of all definitions is the "substantial deprivation of the aggrieved party's contractual expectations." Ascertaining this depends on the contract's terms, surrounding circumstances, and the governing law, and ultimately often falls to the court's interpretation.

Specific Characteristics of License Agreements and Their Relation to Fundamental Breach Applying this theory to license agreements is complicated by several inherent characteristics:

1. Continuous Nature of Obligations: Unlike one-off contracts, performance in technology licenses occurs over time. Consequently, repeated or cumulative minor breaches can aggregate into a fundamental breach.
2. Interdependence of Performance: The licensee's success is directly dependent on the licensor's full and proper performance of its obligations (e.g., complete transfer of know-how). A failure in this performance can completely deprive the licensee of the contract's benefits.

3. Irreversible Nature of Some Breaches: Breaches such as the disclosure of confidential information are often irreparable. Even monetary compensation cannot fully restore a lost competitive advantage.
4. International Dimensions: The cross-border nature of these contracts means that a breach in one jurisdiction can have legal and economic repercussions in others.
5. Direct Impact on Innovation and Competitiveness: Since the primary objective of these agreements is to foster innovation and enhance competitive position, any breach can seriously undermine these fundamental goals.

Criteria for Establishing a Fundamental Breach in License Agreements

1. Motive of the Breaching Party: Courts view intentional or grossly negligent breaches as indicative of bad faith more severely than unintentional ones. A series of minor but chronic breaches accompanied by bad faith can collectively constitute a fundamental breach.
2. Core Obligations and Contractual Terms: The best way to prevent disputes is to explicitly stipulate instances of fundamental breach within the contract itself. However, courts interpreting these terms, especially in adhesion contracts, consider all circumstances and principles of fairness.
3. Foreseeability of Harm: The breaching party must have been able to foresee the detrimental consequences of its breach, or a reasonable person in its position should have foreseen them.

Instances of Breach in Technology License Agreements and Judicial Approach
An analysis of case law highlights the following common instances assessed by courts against the criterion of fundamental breach:

- Non-Payment of Royalties: This is the most common source of dispute.
  - Complete Non-Payment: Generally considered a fundamental breach.
  - Partial Non-Payment: Jurisprudence is inconsistent. It may not be fundamental if the unpaid amount is negligible or if the licensee has paid a substantial portion while receiving fewer services.
  - Payment into an Escrow Account: Depositing funds into a court-supervised account instead of paying the licensor is usually not a fundamental breach. However, a licensee cannot unilaterally withhold payment without authorization.
- Breach of Territorial or Temporal Terms: Breaching these clauses is not necessarily fundamental unless explicitly defined as such in the contract. Courts, considering the principle of good faith, examine whether the breach frustrates the contract's main purpose.
- Use After Expiration or Termination: This action is typically treated not as a “breach of contract” but as an “infringement” of the IP owner's exclusive rights, pursued under intellectual property laws outside the contractual framework.

- Breach of Confidentiality Obligations: Unauthorized disclosure of confidential information and trade secrets, due to the irreparable nature of the harm, is a classic example of a fundamental breach.
- Failure to Comply with Agreed Standards: If the final product or service does not conform to the agreed technical standards and this undermines the contract's primary objective, a fundamental breach has occurred.
- Unauthorized Grant of Sublicenses: Whether this action is fundamental depends on its impact on the licensor's control over the technology and the contract's objectives. If it leads to a complete loss of control, it is likely fundamental.
- Unjustified Cessation of Production or Distribution: A sustained and unjustified halt that causes significant harm to the licensor's economic interests can be a fundamental breach.
- Alteration of Technical Specifications: Unauthorized changes to technical specs that lead to quality degradation or functional problems are often deemed a fundamental breach.

Non-Compliance with Governing Laws/Regulations: Breaching national or international laws or regulations (e.g., export controls) that have severe consequences for the other party can constitute a fundamental breach.

Keywords: Intellectual property rights, sanctions, Technology Licensing Contracts, License, Fundamental breach.

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