

공동발명자 성립의 입증책임 및 기준 - corroboration 인정 판결문 인용 : PD-1/PD-L1

항체 면역 항암제 신약, 옵디보 Opdivo 특허발명의 공동발명자 분쟁 - 미국법원 판결

Dana-Farber Cancer Institute vs Ono Pharmaceutical & BMS 사건



실무적으로 매우 중요한 쟁점입니다. 공동발명자로 주장하는 측에 그 주장을 구체적 증거로 입증해야 하는 책임이 있습니다. 미국법원은 그 입증책임을 corroborating evidence, 즉 구체적 증거로 상세하게 입증할 것을 요구합니다. 위 사안에서 공동발명 여부를 입증하는 방법과 정도를 어떻게 판단했는지 판결문에서 해당 부분을 인용하면 다음과 같습니다.

Courts use a “rule of reason” analysis to determine if a putative joint inventor has

sufficiently corroborated his testimony.

This analysis requires considering "all pertinent evidence" to judge "**the credibility of the inventor's story.**" There is no particular formula that an inventor must follow in providing corroboration of his testimony.

"Records made contemporaneously with the inventive process" are the most reliable corroborating evidence, but courts also consider "circumstantial evidence of an independent nature" and "oral testimony from someone other than the alleged inventor."

Oral testimony of one putative joint inventor is not enough on its own to corroborate the oral testimony of another.

"We have generally been most skeptical of oral testimony that is supported only by testimonial evidence of other interested persons." But such testimony can help to corroborate along with other evidence.

The record includes agendas from all but one of the three scientists' collaboration meetings, slides from the meetings, numerous emails and letters exchanged by the three scientists in 1999 and 2000, and published journal articles. These documents explain Dr. Freeman's and Dr. Wood's hypotheses, experimental results, and conclusions and are alone sufficient to constitute corroborating evidence.

In addition to the plethora of documents, Dana-Farber provided corroboration from a number of witnesses. Dr. Brown corroborated Dr. Freeman's testimony about his antibody and IHC work. Dr. Carreno, a former GI scientist, confirmed that the trio met in May 2000 in Seattle. Dr. Collins at GI testified that Dr. Freeman reached out about finding 292's receptor and that Dr. Wood discovered that 292 is a ligand for PD-1.

Especially significantly, Dr. Honjo, who was present for the trial, confirmed most of the events to which Dr. Freeman and Dr. Wood testified. The "cohesive web of allegedly corroborative evidence" leaves no doubt that Dr. Freeman and Dr. Wood testified truthfully about the experiments they conducted, the communications they exchanged, and the

substance of the meetings they attended.

변리사 24년/변호사 16년, 특허심판소송, 민형사소송, 손해배상, One-Stop Service

T. 02-591-0657 E. kkh@kasanlaw.com H. www.kasanlaw.com