

통상의 Term & Termination 아닌 Term 없는 Termination 조항만 있는 공동연구개발계약 Collaboration Agreement – 특허소멸 후에도 Royalty 계속지급의무 인정 미국판결



미국법원의 2015. 6. 3. 선고 MEDIMMUNE v. UNIVERSITY OF MASSACHUSETTS 사건의 항소심 판결입니다.

Licenser 특허권자 Massachusetts 대학측 교수들과 Licensee Medimmune사측은 1980년대 후반 바이러스(Respiratory Syncytial Virus, RSV) 치료제 연구개발에 관한 R&D Collaboration Agreement를 체결하였습니다. 그 후 특허등록을 받았고, 세월이 흘러 해당 특허는 존속기간만료로 이미 소멸하였습니다. 현재 Licensee Medimmune사는 해당 의약품 Synagis®을 판매하고 있습니다.

Licensee는 특허만료 후 Royalty 지급의무가 없고, 비록 Collaboration Agreement에 명시

적으로 계약의 Term이 규정되어 있지 않지만 여러 이유로 해당 계약은 Termination 되었  
다고 주장하면서 Royalty 지급을 거절합니다.

그러나 Licensor 대학은 위 계약은 25년이 지난 후에도 유효하게 존속 중이고, Licensee  
가 해당 제품을 판매하는 이상 특허소멸과 관계 없이 계속하여 Royalty를 지불해야 한다  
는 입장입니다.

미국 항소심 법원은 Collaboration Agreement의 다음과 같은 계약 문언을 중시하여, 위  
계약은 특허소멸과 무관하게 유효하게 존속하고 Royalty는 특허실시 대가만으로 제한되  
지 않기 때문에 Licensee는 특허소멸 후에도 약정된 Royalty를 지급해야 한다고 판결하  
였습니다.

Collaboration Agreement 계약조항: “[MedImmune] agrees to pay [UMass] a royalty of  
three percent (3%) of Net Sales of any Royalty Bearing Product which is sold by  
[MedImmune] or its affiliates, including uses outside of the Field.” “Royalty Bearing  
Product” (without limiting the scope to patented technology) is defined as “any  
immunoglobulin product or any monoclonal antibody (including but not limited to  
Licensed Product) used for the treatment or prevention of [RSV], influenza or

parainfluenza virus infection." "Licensed Product," included as part of the definition of "Royalty Bearing Product," is defined as "any product, composition, chemical, machine, apparatus, etc. which incorporates or utilizes Technology."

다른 중요한 쟁점으로는, Collaboration Agreement에 다음과 같은 Termination 조항만 있을 뿐, 정작 Term or Duration 조항이 없습니다. Termination 조건을 충족하지 않은 한 기간만으로 계약종료를 할 수 없습니다. 표준 형식으로 Term & Termination 조항을 통상 활용하는 실무와 다른 상황입니다.

아무리 Termination 조건이 상세하게 규정되어 있다고 하더라도, Term 조항 자체가 없는 상황을 해결할 수는 없습니다. 이에 Licensee는 기한 없는 계약은 불합리하므로 법원에서 그 기간을 정해달라고 주장하였지만 받아들여지지 않았습니다. 장기간을 상정하더라도 통상의 실무와 같이 자동연장을 포함한 계약기간 규정을 두는 것이 안전합니다.

## Article 9 Termination

9.1 In the event that within two (2) years from the effective date of this Agreement, a clinical trial has not been instituted with respect to a Royalty Bearing Product, [UMass] or [MedImmune] shall have the right but not the obligation to terminate this Agreement

upon sixty (60) days' prior written notice.

9.2 Upon breach of any provisions of this Agreement or the Research Agreement attached as Exhibit A by either party to this Agreement, in the event the breach is not cured within sixty (60) days after written notice to the breaching party by the other party, in addition to any other remedy it may have, the other party at its sole option may terminate this Agreement.

9.3 [UMass] may terminate this agreement if [MedImmune] becomes insolvent, files for protection under any bankruptcy law, makes an assignment for the benefit of creditors or seeks relief generally from its debts and obligations in accordance with a similar or analogous procedure.

9.4 Upon any termination of this Agreement, [MedImmune] shall be entitled to finish any work-in-progress and to sell any completed inventory of a Licensed Product covered by this Agreement which remains on hand as of the date of the termination, so long as [MedImmune] pays to [UMass] the royalties applicable to said subsequent sales in accordance with the same terms and conditions as set forth in this Agreement.

9.5 In the event that this Agreement is terminated, [UMass] agrees that any sub-license then in existence shall remain in effect in accordance with the terms and conditions thereof, provided that such sub-licensee is not then in breach of such sublicense agreement and such sub-licensee agrees to be directly obligated to [UMass] under the terms and conditions of such sublicense agreement.

9.6 (a) In the event that [UMass] terminates this Agreement under the provisions of Section 9.2 and the license between [MedImmune] and [Henry Jackson Foundation] with respect to Royalty Bearing Product is still in effect, [MedImmune] shall continue to make payments to [UMass] in accordance with Sections 3.1 and 3.2 of this Agreement for as long as the [sic] such agreement between [MedImmune] and [Henry Jackson Foundation] remains in effect.

(b)(i) In the event that [MedImmune] declines to provide the funds for, or perform the laboratory work required by the [FDA] to bring any Royalty Bearing Product to licensure, the licenses and rights granted hereunder for such product shall be converted from exclusive to nonexclusive status and [UMass] may seek other funds for continuation of

the research.

(ii) In the event that [UMass] declines to conduct the research required by the [FDA] to bring any Royalty Bearing Product to licensure, [UMass] shall forfeit its right to royalties from sale of such product by [MedImmune].

9.7 In the event that [MedImmune] decides to discontinue all sales of Royalty Bearing Product for an Indication, then [UMass] by written notice may terminate [MedImmune]'s rights and licenses for such Indication, and the covenants of Sections 5.3 and 5.4 shall terminate with respect to such Indication.

국제계약, 영문계약, 계약분쟁, 손해배상, 민형사소송, Claim, License, R&D 제휴계약

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