[특허분쟁] 미국특허법 신규성 조항 102(a)(1) 중 "on sale" bar – secret sale 포함: Helsinn Healthcare v. Teva Pharma. 미연방대법원 2019. 1. 22. 선고 판결

미국 특허법 조항 102(a)(1) "A person shall be entitled to a patent unless the claimed invention was patented, described in a printed publication, or in public use, **on sale**, or otherwise available to the public before the effective filing date of the claimed invention."

쟁점: "on sale" bar 적용 시 public sale에 제한되는지, 공개되지 않은 secret sale이 적용범위에서 제외되는지 여부

미연방대법원 판결요지

(1) unanimous decision - 당사자 사이 비밀 판매행위 (secret sale) 및 발명의 기술적 내용에 관한 비밀유지 의무를 부담하는 판매행위에 적용됨.

(2) 원심 CAFC 판결도 동일한 입장, 미연방대법원에서 원심 지지

"The Federal Circuit has made explicit what was implicit in our precedents. It has long held that **"secret sales" can invalidate a patent**. E.g., Special Devices, Inc. v. OEA, Inc., 270 F. 3d 1353 (2001) (invalidating patent claims based on "sales for the purpose of the commercial stockpiling of an invention" that "took place in secret"); Woodland Trust v. Flowertree Nursery, Inc., 148 F. 3d 1368 (1998) ("Thus an inventor's own prior commercial use, albeit kept secret, may constitute a public use or sale under §102(b), barring him from obtaining a patent"). . . .

Given that the phrase "on sale" had acquired a well-settled meaning when the AIA was enacted, we decline to read the addition of a broad catchall phrase to upset that body of precedent."

첨부: 미연방대법원 Helsinn vs Teva 판결

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