[특허분쟁] 미국내 부품 제조 및 수출 + 국외 완성품 조립 및 사용 + 국외행위로 인한 Lost Profit 근거 손해배상 인정: 미연방대법원 WesternGeco v. ION Geophysical 판결

1. 사실관계의 개요

(1) 특허권자 WesternGeco – 선발회사, 미국특허 6건 보유, technology for surveying the ocean floor

(2) 침해혐의자 ION – 후발회사, 특허제품의 경쟁품 미국내 부품제조 및 수출, 해외고객사에서 부품을 조립하여 완성품 사용, 특허제품과 구별되지 않는 경쟁제품, 특허권자 시장 잠식

(3) 1심 법원 : ION의 특허침해 인정 + royalty 상실 근거 손해 $12.5 million 및 lost profit 근거 손해 $93.4 million 배상책임 인정

(4) 2심 CAFC : 특허침해 인정 + 손해배상 범위에서 royalty 손해만 인정 but 해외 lost profit 근거 손해배상 불인정

(5) 쟁점: Whether a patent owner may recover lost foreign profits for infringement under 35 U. S. C. 271(f)(2)

2. 미국 특허법 규정

Section 271(f)(1) addresses the act of exporting a substantial portion of an invention's components:

"Whoever without authority supplies or causes to be supplied in or from the United States all or a substantial portion of the components of a patented invention, where such components are uncombined in whole or in part, in such manner as to actively induce the combination of such components outside of the United States in a manner that would infringe the patent if such combination occurred within the United States, shall be liable as an infringer."

Section 271(f)(2), the provision at issue, addresses the act of exporting components that are specially adapted for an invention:

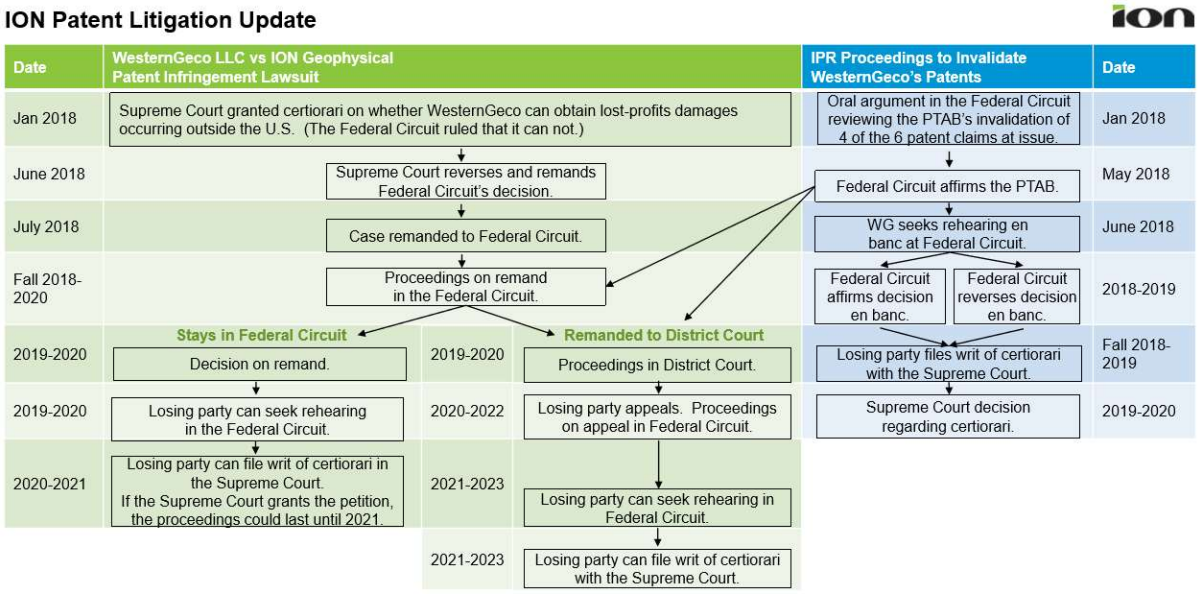
"Whoever without authority supplies or causes to be supplied in or from the United States any component of a patented invention that is especially made or especially adapted for use in the invention and not a staple article or commodity of commerce suitable for substantial noninfringing use, where such component is uncombined in whole or in part, knowing that such component is so made or adapted and intending that such component will be combined outside of the United States in a manner that would infringe the patent if such combination occurred within the United States, shall be liable as an infringer."

3. 미국연방대법원 판결요지 – 미국내 부품제조 및 수출의 경우 해외 Lost Profit 근거 손해배상 인정함

"Section 271(f)(2) focuses on domestic conduct. It provides that a company "shall be liable as an infringer" if it "supplies" certain components of a patented invention "in or from the United States" with the intent that they "will be combined outside of the United States in a manner that would infringe the patent if such combination occurred within the United States." The conduct that §271(f)(2) regulates—i.e., its focus—is the domestic act of "suppl[ying] in or from the United States." As this Court has acknowledged, §271(f) vindicates domestic interests: It "was a direct response to a gap in our patent law," Microsoft

Corp., 550 U. S., at 457, and "reach[es] components that are manufactured in the United States but assembled overseas," Life Technologies, 580 U. S., at ___ (slip op., at 11). As the Federal Circuit explained, §271(f)(2) protects against "domestic entities who export components . . . from the United States." 791 F. 3d, at 1351."

4. 참고자료 – ION 입장에서 작성된 자료



첨부: 미국연방대법원 WesternGeco v. ION Geophysical 판결

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