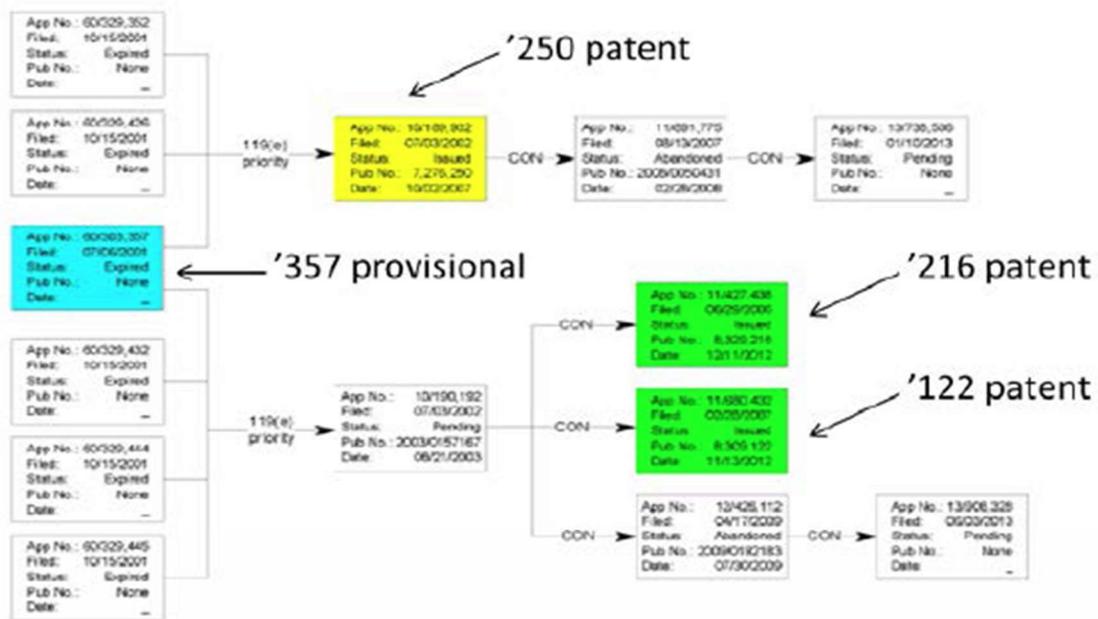


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1. License 대상특허 범위 쟁점: 미국 Endo Pharm Opana® ER 특허분쟁 판결

특허 license에서 자주 쟁점이 되는 사항이고 실제 발생할 수 있는 사안입니다. 아래 그림에서 표시한 각 특허 사이의 관계와 License Agreement 조항의 문언표현을 살펴보시기 바랍니다.



JA05132

(1) license 대상특허 범위 및 쟁점

License 계약서에 라이선스 대상특허 '250 및 그 후속특허 "including any continuation, continuation-in-part and divisional patent applications that claim priority to Opana® ER Patents"로 표현되어 있습니다. 여기서 '250 특허가 Opana® ER Patents에 해당합니다.

계약체결 후 등록된 위 '216 특허와 '122 특허가 위와 같은 계약문언의 범위에 해당하는지 여부가 쟁점입니다. 그림에서 보듯 노란색 '250 특허와 녹색의 쟁점 특허 2건은 직접 연결된 관계가 아닙니다.

다만, 청색으로 표시한 '357 출원이 중간에 개입되어 있습니다. 그것을 매개로 녹색표시 특허들도 노란색 특허와 동일하게 license 대상특허로 해석할 수 있는지 문제됩니다.

(2) 미국법원 판결

CAFC 판결은 위와 같은 상황에서 '216 특허와 '122 특허는 license 대상 특허범위에 포함되지 않는다고 판결하였습니다. 기타 묵시적 license도 인정하지 않았습니다. 즉, licensor Endo는 licensee Actavis, Roxane의 generic 제품 발매에 대해 기존 등록특허에 관하여 체결한 license의 존재에도 불구하고 다시 추가 등록한 '216 특허와 '122 특허에 기초한 특허권을 행사할 수 있다고 보았습니다.

Generic 제품발매 회사로서는 불의타에 해당하는 황당한 상황을 맞았습니다. CAFC 3인 합의재판부 중 1명의 소수의견 Dissent Opinion에서는 license 대상을 특허로 표현한 것과 제품으로 표현한 것을 엄격하게 구별해야 하고, 적어도 제품을 기준으로 라이선스 계약을 체결한 경우 위 특허도 라이선스 대상특허에 해당한다는 의견 설시가 흥미롭습니다. 공감할 내용이 많은데도 불구하고 아쉽게도 소수의견에 그쳤습니다. 특허 라이선스 실무 공부 삼아 읽어 보시기 바랍니다.

(3) No Implied License 조항

CAFC 판결에서는 계약서의 다음과 같이 묵시적 라이선스를 허용하지 않는다는 계약조항을 중요한 판단근거로 삼았습니다. 라이선스 계약 실무상 매우 중요한 포인트입니다.

"Endo does not grant to Actavis [or Roxane] . . . any license, right or immunity, whether by implication, estoppel or otherwise, other than as expressly granted herein."

참고자료로 다른 계약서에서 표준형식의 조항을 인용합니다. "No Other Rights. No rights, other than those expressly set forth in this Agreement are granted to either Party hereunder, and no additional rights will be deemed granted to either Party by implication, estoppel, or otherwise. All rights not expressly granted by either Party to the other hereunder are reserved."

Licensee의 묵시적 라이선스 주장은 부제소조항(not to sue)에도 근거를 두고 있습니다. licensee에 대한 소송을 제기하지 않는다는 계약조항은 곧 후속 등록 특허권에 대한 license 합의로도 해석할 수 있다는 주장입니다.

그러나, CAFC 판결은 위와 같이 묵시적 허락을 배제하는 명시적 계약조항을 우선해야 한

다고 명확하게 밝혔습니다. 묵시적 라이선스 이론이 적용될 수 있고, 따라서 상충되는 해석이 가능한 상황에서도, 처분문서에 해당하는 계약서에 명시적으로 기재된 묵시적 라이선스를 배제한다는 문언이 훨씬 더 강력한 효력을 발휘한다는 점을 명확하게 판시하였습니다.

위 판결은 Licensee 입장에서 조금 억울한 면이 있을 것입니다. 실무적 대응방안으로는 특허만을 라이선스 대상범위의 기준으로 설정하는 것보다 여기에 더하여 제품기술을 라이선스 범위설정의 기준으로 함께 설정한다면 안정할 것입니다.

기술이전이나 license 당시에는 등록되지 않았고 독립된 특허출원도 아니었으나 그 후 분할출원, 연속출원 등을 통해 등록되는 특허문제는 매우 중요합니다. 관련 쟁점에 관한 좋은 참고가 될 분쟁사례와 판결입니다. CAFC 판결문을 소수의견까지 모두 꼼꼼하게 살펴보시길 권합니다.

2. 영문계약조항 사례 샘플

(1) Example – Definition, 계약대상 특허정의 조항

“Patent Rights” means, with respect to each country in the Territory (except as otherwise stated to be with respect to any country in or outside the Territory), (a) patent applications

(including provisional applications) pending in such country, (b) any patents issuing in such country from such patent applications (including certificates of invention), (c) all patents and patent applications issued or pending, as applicable, in such country based on, corresponding to or claiming the priority date(s) of any of the foregoing, (d) rights in such country derived from any of (a), (b) or (c), including any substitutions, extensions (including supplemental protection certificates), registrations, confirmations, reissues, divisionals, continuations, continuations in part, reexaminations, renewals, revalidations, revivals, patents of addition, and (e) all patents and patent applications issued or pending, as applicable, in such country claiming overlapping priority therefrom.

(2) Example – 라이선스 계약조항 샘플

9. INTELLECTUAL PROPERTY MATTERS.

9.1 Existing Intellectual Property.

(a) Other than as provided in this Agreement, neither Party grants any right, title, or interest in any Patent Right, information, or other intellectual property right Controlled by such Party to the other Party.

(b) Except as otherwise provided herein, Licensor shall be responsible for the preparation, filing, prosecution (including, without limitation, any interferences, inter partes proceedings, reissue proceedings, cancellations, oppositions, and reexaminations), and maintenance of any and all Licensed Serenity Patent Rights. Licensor shall consult with Licensee, and consider Licensee's comments, in good faith with respect to the preparation, filing, prosecution, and maintenance of any Licensed CPEX Patent Rights or Licensed Reprise Patent Rights to the extent that Licensor has the right, under any agreement with any applicable licensor, to file, prosecute, and maintain such Licensed Patent Rights.

(c) Licensee agrees and acknowledges that Licensor intends to continue to use, in Licensor's discretion, patent counsel currently retained by Licensor to prosecute and maintain the Licensed Serenity Patent Rights. Licensee shall execute, acknowledge and deliver any instruments, and to do all such other acts, as may be necessary or appropriate in order to enable such patent counsel to continue to prosecute and maintain such Licensed Serenity Patent Rights. The Parties shall reasonably consult with each other, and shall consider any comments from each other in good faith, with respect to the preparation, filing, prosecution, and maintenance of such Licensed Serenity Patent Rights and patent strategy for the Licensed Serenity Patent Rights. Licensee shall reimburse Licensor for all

costs and expenses incurred by Licensor after the Effective Date in the preparation, filing, prosecution, and maintenance of any Licensed Serenity Patent Rights in the Territory, up to an amount not to exceed [*] Dollars (\$[*]), which is the estimated cost set forth on Schedule 9.1(c). Licensor shall provide to Licensee copies of any papers relating to the filing, prosecution or maintenance of the Licensed Serenity Patent Rights promptly upon their being filed or received. Licensee shall not knowingly take any action during prosecution and maintenance of the Licensed Serenity Patent Rights.

(d) Licensor shall not knowingly permit any of the Licensed Serenity Patent Rights to be abandoned in any country in the Territory without Licensor first giving Licensee an opportunity to assume full responsibility for the continued prosecution and maintenance thereof. In the event that Licensee decides not to continue the prosecution or maintenance of a Licensed Serenity Patent Rights in any country in the Territory, Licensor will provide Licensee with notice of this decision at least thirty (30) days prior to any pending lapse or abandonment thereof. In the event that Licensee elects to assume responsibility for such prosecution and maintenance within thirty (30) days of Licensor's notice, Section 9.1(c) shall thereafter apply to such Licensed Serenity Patent Rights except that the role of Licensee and Licensor shall be reversed thereunder (except further that Licensee will

continue to be responsible for all costs and expenses thereafter incurred in the preparation, filing, prosecution, and maintenance of any Licensed Serenity Patent Rights). Any such Serenity Patent Right that is subject to such election by Licensee shall otherwise continue to be subject to all of the terms and conditions of the Agreement in the same way as the other Licensed Serenity Patent Rights.

9.2 **Inventions by Licensee.**

(a) **Disclosure.** Licensee shall promptly disclose to Licensor the invention of any Licensee Inventions.

(b) **Ownership.** As between the Parties, all Licensee Inventions will be owned and Controlled by Licensee.

(c) **Patent Filings.**

(i) Licensee, at its expense, will have sole discretion and responsibility to prepare, file, prosecute, and maintain any patent applications and patents claiming Licensee Inventions.

The Parties' respective patent counsel shall meet no fewer than once per Calendar Year to

discuss strategies for the preparation, filing, prosecution, and maintenance of any such patent applications and patents claiming Licensee Inventions. Licensee shall consider in good faith any comments provided by Licensor with respect to the foregoing. In the event of any dispute between Parties with respect to such strategies, either Party may notify the Alliance Managers for purposes of resolving such dispute; provided, however, that Licensee shall have the final decision-making authority with respect to any such dispute.

(ii) Licensee shall not knowingly permit any Patent Rights with claims to any Licensee Inventions to be abandoned in any country without Licensee first giving Licensor an opportunity to assume full responsibility for the continued prosecution and maintenance thereof. In the event that Licensee decides not to continue the prosecution or maintenance of any Patent Right claiming a Licensee Invention in any country, Licensee will provide Licensor with notice of this decision at least thirty (30) days prior to any pending lapse or abandonment thereof. In the event that Licensor elects to assume responsibility for such prosecution and maintenance within thirty (30) days of Licensor's notice, Section 9.1(c) shall thereafter apply to such Patent Right claiming such Licensee Invention except that the role of Licensee and Licensor shall be reversed thereunder.

9.3 **Infringement, Violation, or Misappropriation by Third Parties.**

(a) **Notice.** Each Party shall promptly notify the other Party in writing of any alleged or threatened infringement, violation, or misappropriation by any Third Party of the Licensed Rights or the Sublicensed Rights of which it becomes aware, and following such notification, the Parties shall confer as to any response thereto. The notice shall set forth the facts of such infringement, violation, or misappropriation in reasonable detail.

(b) **Response to Infringement, Violation, or Misappropriation by Third Parties.**

(i) If a Third Party is infringing, violating, or misappropriating, or either Party reasonably believes a Third Party may be infringing, violating, or misappropriating any Enforceable IP Right in any country in the Territory, Licensee shall have the first right, but not the obligation, to institute, prosecute, and control any action or proceeding with respect to such infringement, violation, or misappropriation by counsel of its own selection, at its expense. Licensor shall have the right to participate in such action and be represented, if it so desires, by counsel of its own selection and at its own expense. To the extent required

by Applicable Laws, Licensor agrees to be joined as a party plaintiff (with Licensor having the right to be represented, if it so desires, by counsel of its own selection and at its own expense) if necessary for Licensee to bring and prosecute such action or proceeding, and to give Licensee reasonable assistance and authority to bring and prosecute such action or proceeding. If Licensee fails to bring an action or proceeding within ninety (90) days after receiving or giving written notice pursuant to Section 9.3(a), then Licensor shall have the right, but not the obligation, to bring and control any such action by counsel of its own selection, at its expense (with Licensee having the right to participate in such action and be represented, if it so desires, by counsel of its own selection and at its own expense).

To the extent required by Applicable Laws, Licensee agrees to be joined as a party plaintiff (with Licensee having the right to be represented, if it so desires, by counsel of its own selection and expense therein) if necessary for Licensor to bring and prosecute such action or proceeding, and to give Licensor reasonable assistance and authority to bring and prosecute such action or proceeding. No settlement of any such action or consent judgment or other voluntary final disposition which restricts the scope, or adversely affects the enforceability, of an Enforceable IP Right may be entered into by either Party without the prior written consent of the other Party, which consent shall not be unreasonably withheld, delayed or conditioned.

(ii) Each Party shall share in any recoveries obtained in connection with any action or proceeding described in Section 9.3(b)(i) as follows:

(A) each Party's costs and expenses incurred in connection with bringing and prosecuting any such action or proceeding, including without limitation attorneys' fees, first shall be reimbursed from such recoveries, and if such recovery is insufficient to cover all such costs and expenses of both Parties, it shall be shared in proportion to the total of such costs and expenses incurred by each Party, and

(B) if Licensee controlled such action or proceeding Licensee shall receive one hundred percent (100%) of such remaining recoveries, provided that such recoveries shall be deemed Net Sales for purposes of Section 8.3(a)(i); and if Licensor controlled such action or proceeding, each Party shall receive fifty percent (50%) of such remaining recoveries, provided that Licensee's portion shall not be deemed as Net Sales for purposes of Section 8.3(a)(i) in such case.

(c) Withdrawal. If either Party brings an action or proceeding under Section 9.3(b)(i) and subsequently ceases to pursue or withdraws from such action or proceeding, it shall

promptly notify the other Party and the other Party may substitute itself for the withdrawing Party under the terms of Section 9.3(b)(i).

(d) **Oppositions by Parties.** If either Party desires to bring an opposition, action for declaratory judgment, nullity action, interference, reexamination, inter partes proceeding, or other attack upon the validity, title, or enforceability of any intellectual property right Controlled by a Third Party that Covers the Product in the Field in any country in the Territory, such Party shall so notify the other Party and the Parties shall promptly confer to determine whether to bring such action or the manner in which to settle such action. Each Party shall be entitled to separate representation in any such action by counsel of its own choice and at its own expense, and shall cooperate fully with the other Party. The costs of any such action shall be borne by the Party bringing the action, and such Party shall retain any recoveries obtained in connection therewith.

9.4 **Infringement of Third Party Rights.**

(a) **Notice.** If the Exploitation of the Product pursuant to this Agreement results in a claim, action, suit, or proceeding that such activity infringes or misappropriates the

intellectual property rights of a Third Party ("Third Party Infringement Claim"), the Party first receiving notice thereof shall promptly notify in writing the other Party thereof. The notice shall set forth the facts of the Third Party Infringement Claim in reasonable detail.

(b) **Litigation.**

(i) Licensee shall have the sole right, but not the obligation, to defend, at its expense, against any Third Party Infringement Claim. Licensee shall have full control over the defense and settlement of such Third Party Infringement Claim, provided that Licensee shall not settle any Third Party Infringement Claim that is subject to indemnification pursuant to Section 11.1 without the prior written consent of Licensor, which consent shall not be unreasonably withheld, delayed, or conditioned. Licensor shall cooperate with Licensee, at Licensee's expense and reasonable request, in such defense and shall have the right to be represented by counsel of its own choice, at Licensor's expense. Licensee will pay any losses incurred in defense or settlement of, or imposed pursuant to settlement of or judgment on, such Third Party Infringement Claim.

(ii) If Licensee decides not to commence a defense against any Third Party Infringement

Claim pursuant to Section 9.4(b)(i), then Licensee will promptly notify Licensor of such decision in a timely manner so as to allow Licensor, who shall have the right, but not the obligation, to commence such a defense by counsel of its own selection, at its expense (with Licensee having the right to participate in such defense and be represented, if it so desires, by counsel of its own selection and at its own expense). Licensor shall thereupon have full control over the defense and settlement of such Third Party Infringement Claim, provided that Licensor shall not settle any Third Party Infringement Claim without the prior written consent of Licensee, which consent shall not be unreasonably withheld, delayed, or conditioned. Licensee shall cooperate with Licensor, at Licensor's expense and reasonable request, in such defense and shall have the right to be represented by counsel of its own choice, at Licensee's expense. Licensor will pay any losses incurred in defense or settlement of, or imposed pursuant to settlement of or judgment on, such Third Party Infringement Claim, subject to Section 11.1.

(iii) Notwithstanding any provisions set forth herein to the contrary, Licensor shall be responsible for continuing to manage, at Licensor's expense, that certain litigation with Ferring Pharmaceuticals that is described in Schedule 10.2. Notwithstanding the foregoing, any settlement of any such action or consent judgment or other voluntary final disposition

with respect to the litigation with Ferring Pharmaceuticals described in Schedule 10.2, which restricts the scope, or adversely affects the enforceability, of an Enforceable IP Right may not be entered into by Licensor without the prior written consent of the Licensee, which consent shall not be unreasonably withheld, delayed or conditioned.

(c) **Oppositions by Third Parties.** If any patent, trademark, copyright, or other intellectual property right within the Licensed Rights or the Sublicensed Rights becomes after the Effective Date the subject of any proceeding commenced by a Third Party in connection with an opposition, reexamination request, action for declaratory judgment, nullity action, interference, inter partes proceeding, or other attack upon the validity, title, or enforceability thereof, then Licensee shall control such defense at its sole cost. Licensee shall permit Licensor to participate in the proceeding to the extent permissible under Applicable Laws, and to be represented by its own counsel in such proceeding, at Licensor's expense. If Licensee elects not to defend against such action with respect to any such intellectual property right with the Licensed Rights or the Sublicensed Rights within ninety (90) days after first receiving notice or otherwise becoming aware of such action or proceeding, then Licensor shall have the right to assume defense of such Third Party action at its own expense. Any awards or amounts received in bringing any such action shall be

first allocated to reimburse the Parties' expenses in such action, and any remaining amounts shall be retained by the Party defending against such proceeding.

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

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