

바이오벤처 미국회사 SGI, Licensor vs 대기업 일본회사 Daiichi-Sankyo, Licensee 사이  
체결된 항암제 바이오신약 ADC 관련 공동연구개발 계약 종료 후 특허권리 귀속분쟁 발  
생 미국소송 제기 - 소장 및 공동연구결과의 권리관계 조항



1. 공동연구계약 당사자 벤처기업 - 공동연구결과의 개량발명 및 공동소유 주장

*SGI Alleges that the Patents and Patent Applications at Issue  
Fall Within the Scope of the Collaboration Agreement and Are Therefore Owned by SGI*

38. SGI alleges that unrelated ADC technology developed by Daiichi Sankyo—*e.g.*, technology that does not use or relate to the Drug Conjugation Technology as defined by the Collaboration Agreement—is an Improvement under the Collaboration Agreement.

2. 대기업 주장요지 - 공동연구계약 범위에 포함되지 않음

***Daiichi Sankyo's Patents and Patent Applications at Issue Are  
Not Improvements of Drug Conjugation Technology Under the Collaboration Agreement***

42. Daiichi Sankyo protects its innovative research and development through intellectual property, including patents and patent applications. Those innovative research and development efforts, including, among other things, the Patents and Patent Applications at Issue, are distinct and independent from the technology covered by the Collaboration Agreement, and, as such, are not Improvements of Drug Conjugation Technology.

**3. 청구취지 - 특허발명의 권리귀속 확인 판결 청구**

B. The entry of a declaratory judgment pursuant to 28 U.S.C. § 2201, declaring that Daiichi Sankyo has ownership rights of the Patents and Patent Applications at Issue and SGI has no ownership interest in the Patents and Patent Applications at Issue as they do not constitute Improvements of Drug Conjugation Technology as defined in the Collaboration Agreement;

**4. 공동연구개발계약서 조항**

**9.1 Ownership of Inventions.**

**9.1.1 Disclosure of Inventions.** Each Party shall promptly disclose to the other Party, including without limitation at the joint meetings provided in Section 5.2, the making, conception or reduction to practice of any inventions directly arising out of activities conducted under this Agreement ("Program Inventions").

**9.1.2 Ownership of Program Inventions.** All right, title and interest in all Program

Inventions that are discovered, made or conceived as part of the activities conducted under this Agreement shall be owned as follows:

(a) [\*\*\*] shall own all Program Inventions that (i) are invented solely by one or more employees, agents or consultants of [\*\*\*] and do not primarily relate to the [\*\*\*] or (ii) are invented solely or jointly by employees, agents or consultants of [\*\*\*] and/or [\*\*\*] and primarily relate to the [\*\*\*]. To the extent that any such Program Inventions relating primarily to the [\*\*\*] shall have been invented by [\*\*\*] and are owned by [\*\*\*], [\*\*\*] hereby assigns all of its right, title and interest therein to [\*\*\*];

(b) [\*\*\*] shall own all Program Inventions that (i) are invented solely by one or more employees, agents or consultants of [\*\*\*] and do not primarily relate to the [\*\*\*] or (ii) are invented solely or jointly by employees, agents or consultants of [\*\*\*] and/or [\*\*\*] and primarily relate to the [\*\*\*]. To the extent that any Program Inventions relating primarily to Drug Conjugation Technology shall have been invented by [\*\*\*] and are owned by [\*\*\*], Licensee hereby assigns all of its right, title and interest therein to [\*\*\*]; and

(c) Except as set forth in Sections 9.1.2(a) and 9.1.2(b), Licensee and SGI shall jointly own all other Program Inventions. For purposes of clarification and notwithstanding anything to the contrary set forth herein, all Program Inventions that relate primarily to ADCs, including without limitation, patents or patent applications claiming compositions of matter or methods of use of Licensed Products, shall be jointly owned.

(d) Inventorship, for purposes of this Agreement, shall be determined in accordance with applicable national patent laws. To the extent permissible under applicable national patent laws, each Party will cause each employee and contractor conducting work on such Party's behalf under this Agreement to be subject to a contract that (a) compels prompt disclosure to the Party of all inventions and other intellectual property conceived, created or reduced to practice by such employee or contractor during his or her performance under the Research Program and (b) assigns to such Party all right, title and interest in and to all

such inventions and other intellectual property and all related Patents. Each Party will require each employee and contractor conducting work on such Party's behalf under this Agreement to maintain records in sufficient detail and in a good scientific manner appropriate for patent purposes to properly reflect all work done. To the extent any royalties are owed to an employee or contractor of a Party relating to an invention, that Party shall be solely responsible for such royalties.

첨부: 미국소장

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

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T. 02-591-0657 E. [kkh@kasanlaw.com](mailto:kkh@kasanlaw.com) H. [www.kasanlaw.com](http://www.kasanlaw.com)