

아마존 판매제품에 대한 특허침해 및 판매중지 여부 판단 간이절차 - Amazon Utility

Patent Neutral Evaluation Procedure (파일 첨부) + Agreement (파일 첨부)



1. Starting an Evaluation.

To request an Evaluation, a Patent Owner submits an Amazon Utility Patent Neutral Evaluation Agreement (“Agreement”) to Amazon, with all information requested in its Exhibit 1. Amazon then sends that Agreement to each Seller listing Accused Products and gives each the option of: (i) executing and returning the Agreement within three weeks, with all information requested in its Exhibit 2; or (ii) having their listings on Accused Products removed from www.amazon.com. If a Seller does not participate in the Evaluation or does not comply with the Agreement, Amazon intends to remove its listings of Accused Products. After receiving a completed Agreement from one or more Sellers, Amazon will

use the information in Exhibits 1 and 2 of the Agreement to select a neutral individual from a list of attorneys experienced in U.S. patent disputes ("Evaluator").

- 특허권자는 특허평가계약서(Amazon Utility Patent Neutral Evaluation Agreement), 해당 특허정보, 판매자의 특허침해 주장 근거 등 간단한 정보를 Amazon에 제공.
- Amazon에서 판매자에게 사실 통보 후 특허평가 계약서에 서명하도록 요청
- 양측의 동의 후 Amazon은 지정한 평가자(evaluator)가 중립적으로 특허침해 판단
- 판매자가 Agreement에 서명하지 않으면, Amazon은 해당제품을 Amazon.com에서 삭제

2. Payment and Schedule.

Once selected, the Evaluator will contact the Patent Owner and each Seller with instructions to wire \$4,000 to the Evaluator. If the Patent Owner does not submit \$4,000 to the Evaluator within two weeks, no Evaluation will occur and any money submitted by Sellers will be returned. If a Seller does not submit **\$4,000** within two weeks, the Evaluator will notify Amazon, who will then remove that Seller's listings of Accused Products. If no Seller submits

\$4,000, Amazon will remove all participating Sellers' listings of the Accused Products and the Evaluator will return the Patent Owner's payment.

- 특허권자와 판매자 - 각각 평가자에게 4천불씩 지급 + Amazon 비관여
- 특허권자 4천불 미지급 시 해당 제품 계속 판매
- 판매자 4천불 미지급 시 판매중지

3. Submission of Written Arguments.

After the Patent Owner and a Seller have timely submitted \$4,000, the Evaluator will set a schedule for submission of written arguments ("Schedule"). In general, the Schedule will provide: (i) the Patent Owner with 21 days for its initial arguments; (ii) Sellers with 14 days to respond; and (iii) the Patent Owner with 7 days to reply. No modifications to the schedule can be requested. The Patent Owner may use a total of 20 double-spaced 8.5 x 11" pages between its two submissions. Each Seller may use 15 double-spaced pages in its response. Claim charts and exhibits are not counted against page limits. Each submission must be in English and emailed to the Evaluator and to the opposing Participants in the same email; physical exhibits cannot be submitted. Failure to timely make a submission by a Participant

will generally result in a finding by the Evaluator against that Participant and forfeiture of its payment, except that the Patent Owner may waive reply.

- 양측 각 4천불 입금 후 평가자 특허평가 일정 지정
- 특허권자 21일 내 서면으로 특허침해주장(initial arguments) 제출
- 판매자는 그로부터 14일 이내 답변서 제출
- 특허권자는 판매자의 답변에 대하여 다시 7일 이내 반박서면 제출 가능

4. Evaluation is a Limited Procedure.

To make the Evaluation fast, efficient, and relatively low-cost, it is limited to one claim from one unexpired U.S. utility patent. Design, non-U.S., and expired patents are not eligible.

The Patent Owner may include multiple ASINs in an Evaluation, but Amazon or the Evaluator may exclude ASINs of products not physically identical for purposes of the Evaluation. The Evaluation will address only Products sold by third-party sellers on www.amazon.com. The Evaluator will consider whether a Product likely infringes. Only two defenses other than non-infringement based on failure to meet one or more claim

limitations will be considered by the Evaluator. First, Sellers can defend on the basis of invalidity and/or unenforceability of the asserted patent claim by providing a finding by a court of competent jurisdiction, or by the U.S. Patent Office or U.S. International Trade Commission ("ITC"), that the asserted patent claim is invalid or unenforceable. Arguments regarding, for example, invalidating prior art will not be accepted; the only way Sellers can show invalidity/unenforceability is by presenting a court, Patent Office, or ITC order finding an asserted patent claim invalid or unenforceable. Second, Sellers may show that the Accused Products (or physically identical products) were on sale one year or more before the asserted patent's earliest effective filing date, only by using credible evidence that the Evaluator can independently observe (such as a date of first sale on amazon.com, or on the Wayback Machine). The Evaluator will not accept affidavits, declarations, or mere arguments about the date of first sale; the Seller must come forward with independently verifiable objective evidence that the Evaluator can confirm.

No discovery (e.g., depositions, document requests, etc.) will occur in the Evaluation, nor will there be a trial or hearing. The Patent Owner and Sellers may not contact the Evaluator, unless by email in response to an inquiry from the Evaluator, while copying the other parties. The Evaluator may consider any information submitted, giving any weight to that

information the Evaluator believes appropriate.

- 소송절차와 같은 디스커버리(discovery), 변론(hearing), 재판(trial) 없음 - 간략한 제한

된 평가절차

- 특허권자의 침해주장 범위 - 1개 제품(Amazon 제품분류 기준상), 1개 특허, 1개 청구항

으로 제한

- 판매자의 대응수단 - (1) 비침해주장, (2) 무효, 행사불가능(unenforceability) 주장, (3)

선사용주장

5. Decision.

Within 14 days of the reply date, the Evaluator will announce a decision, choosing between:

(i) the Patent Owner is likely to prove that the Accused Product infringes the asserted claim;

or (ii) the Patent Owner is not likely to prove that the Accused Product infringes the

asserted claim. The Evaluator will not provide reasoning if the Evaluator decides that the

Patent Owner is likely to prove that the Accused Product infringes the asserted claim. If

the Evaluator decides that Patent Owner is not likely to prove that the Accused Product

infringes, the Evaluator shall provide a brief explanation of why the Patent Owner is unlikely

to prove infringement. The Participants will not contact or question the Evaluator regarding his or her decision. There is no process for appeal or reconsideration of the decision.

- 모든 및 증거자료 제출 후 14일 이내 평가결정
- 특허침해 입증 개연성 또는 특허침해 입증 실패 개연성 판단, 판단 근거 공개

6. Disposition of Payments Following Evaluation.

If the Evaluator decides the Patent Owner is likely to prove that all Accused Products infringe, the Evaluator will return the Patent Owner's \$4,000 and retain a total of \$4,000 divided evenly among the participating Sellers. If more than one Seller has participated and is found to infringe, the Evaluator will give any amount of Seller-deposited money in excess of \$4,000 to an Amazon Smile charity chosen by the Patent Owner. If the Evaluator decides the Patent Owner is not likely to prove that any Accused Product infringes, the Evaluator will return participating Sellers' payments and retain the Patent Owner's \$4,000.

If the Evaluator decides the Patent Owner is likely to prove that some Accused Products infringe and not likely to prove that other Accused Products infringe, the Evaluator will: (i) retain \$2,000 from the Patent Owner's payment and return the remainder; (ii) return in full

payments of participating Sellers whose Accused Products were found not to infringe; and (iii) retain \$2,000, divided evenly among participating Sellers of Accused Products found to infringe. Any excess funds from Sellers of Accused Products found to infringe shall be given to an Amazon Smile charity chosen by the Patent Owner. In no case may the Evaluator retain more than \$4,000 after making a merits decision in an evaluation.

- 특허권자 승소한 경우 선납 4천불 환불, 평가자는 판매자가 선납한 4천불을 비용으로 수취

7. Settlement.

If the Patent Owner and a Seller notify the Evaluator they have settled their dispute prior to the date of Patent Owner's reply, the Evaluator will terminate the Evaluation as to that Seller, or terminate the Evaluation entirely if there is only one participating Seller. The Evaluator may retain up to \$1,000 to cover the Evaluator's efforts, equally divided from the Participants' payments when settlement results in termination of the entire Evaluation. If the settlement occurs after the Patent Owner's reply but before the Evaluation is completed, the Evaluator may retain up to \$2,000, \$1,000 from the Patent Owner and a total of \$1,000

from the participating Sellers, if the Evaluation is terminated in its entirety. The Evaluator will return the remainder of each Participant's payment to that Participant.

- 당사자 화해하는 경우 절차 종료
- 평가자는 화해 시 비용으로 1천불 또는 최대 2천불 받음

8. Effect of Evaluation on Accused Products.

If the Evaluator finds the Patent Owner is likely to prove that an Accused Product infringes, Amazon will remove that Accused Product from www.amazon.com as soon as practicable, but generally within 10 business days of Amazon's receipt of the decision. If the Evaluator finds that the Patent Owner is not likely to prove that an Accused Product infringes, Amazon will have no obligation to take any action as a result of the Evaluation. No other action is contemplated or required as a result of the Evaluation and no damages, attorney's fees or costs may be awarded. If any Participant obtains a judgment or order in litigation or an arbitration that an Accused Product does not infringe or that the Patent is invalid or unenforceable, that Participant may submit it to Amazon, and Amazon may allow relisting of the Accused Product, in accordance with Amazon's policies and procedures. When a

patent expires or is found invalid or unenforceable, Amazon may restore a removed listing.

If the Evaluator finds that the Patent Owner is not likely to prove an Accused Product infringes, and the Patent Owner subsequently obtains an order or judgment finding that the Accused Product infringes, the Patent Owner may submit that judgment or order to Amazon, and Amazon will remove the Accused Product, in accordance with Amazon's policies and procedures.

- 특허권자 승소 시 늦어도 10일 이내 해당제품 listing 삭제
- 특허권자 패소 시 판매 계속

변리사 24년/변호사 16년, 특허심판소송, 민형사소송, 손해배상, One-Stop Service

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