

특허라이선스, 기술이전 계약서에서 대가지급, Royalty 구성, 산정기준 등 판단기준, 미국
판결 사항, 체크포인트, 계약조항 샘플 등 실무적 포인트 몇 가지



- **Types of Royalties :**
 - **Lump Sum, 분할불**
 - ✓ Net Present value (현가율(WACC), 이자율 등 적용)
 - **Running Royalties**
 - ✓ 정율 (%)
 - ✓ 정액 (\$ per unit)
 - ✓ Sliding scale
- **Minimum Royalty vs Maximum Royalty**
- **Gross Sales Price vs Net Sales Price**
 - 공제항목 (할인, 반품, tax, 수수료, 광고료, 설치비, 포장, 운송비 ...)
- **Royalty Bearing Product**
- **Tax**

➤ Report & Audit

Royalty Basis – 미국판결

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- “Where small elements of multi-component products are accused of infringement, it is generally required that royalties be based **not** on the entire product, **but** instead on **the smallest salable patent practicing unit.**”
- “when small elements of multi-component products are accused of infringement, a patentee may assess damages based on the entire market value of the accused product **only where** the patented feature creates the basis for customer demand or substantially creates the value of the component parts.” *Uniloc v. Microsoft* (Fed. Cir. 2011) *LaserDynamics v. Quanta Computer* (Fed. Cir. 2012).

Smallest Saleable Patent Practicing Unit - SSPPU

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Cornell v HP (Judge Rader, NDNY 2009)

- Patent directed to Instruction Reorder Buffer (IRB)
- Cornell could prove IRB was basis for demand (no EMVR)
- SSPPU was CPU
- IRB was only a feature of the CPU



특허발명의 기술적 기여범위로 추가 적용

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- ◆ **Even when** the accused infringing product is “the smallest salable unit,” the patentee “must do **more** to estimate what portion of the value of that product is attributable to the patented technology”
- ◆ if the accused unit is “a multi-component product containing several non-infringing features with no relation to the patented feature.”
VirnetX v. Cisco (Fed. Cir. 2014).

공지기술 포함 + 결합 특허

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- ◆ “When a patent covers the infringing product as a whole, and the claims recite both conventional elements and unconventional elements, the court must determine how to account for the relative value of the patentee’s invention in comparison to the value of the conventional elements recited in the claim, standing alone.”
- ◆ “It is not the case that the value of all conventional elements must be subtracted from the value of the patented invention as a whole when assessing damages. For a patent that combines “old elements,” removing the value of all of those elements would mean that nothing would remain. In such cases, the question is how much new value is created by the novel combination, beyond the value conferred by the conventional elements alone.” AstraZeneca v. Apotex (CAFC 2015)

4.1 **License Fees**. On or before the Effective Date, the Licensee Kite shall pay to the Licensor Cabaret a one-time upfront license fee of twenty-five thousand United States dollars (US\$25,000). On or before each anniversary of the Effective Date until First Commercial Sale of the first Licensed Product, Kite shall pay to Cabaret an annual license fee of thirty thousand dollars (US\$30,000).

4.3 Royalties.

4.3.1 **Royalty Rate**. During the applicable Royalty Term for a Licensed Product, subject to the terms and conditions of this Agreement, Kite shall pay to Cabaret royalties, with respect to each Licensed Product, equal to [*] percent **([*]%) of Net Sales of such Licensed Product** by the Licensee Kite, its sublicensees and their respective Affiliates; provided, however, if the Licensed Product is made, used, or sold in such country where such Licensed Product would not infringe a Valid Claim, then the applicable royalty rate for such Licensed Product in such country shall be reduced to [*] percent ([*]%) of Net Sales of such Licensed Product. Only one royalty shall be owing for a Licensed Product regardless of how many Valid Claims cover such Licensed Product.

4.3.2 **Third Party Royalties.** If the Licensee Kite, its Affiliate or Sublicensee is required to pay royalties in consideration for a license to such Third Party IP to any Third Party in order to exercise its rights hereunder to make, have made, use, sell, offer to sale or import any Licensed Product, then Kite shall have the right to credit [*] percent ([*]%) of such Third Party IP royalty payments against the royalties owing to Cabaret under Section 4.3.1 with respect to sales of such Licensed Product in such country; provided, however, that Kite shall not reduce the amount of the royalties paid to Cabaret under Section 4.3.1 by reason of this Section 4.3.2, with respect to sales of such Licensed Product in such country, to less than [*] percent ([*]%) of Net Sales of such Licensed Product in such country.

4.3.3 **Generic Product.** On a country-by-country and Licensed Product-by-Licensed Product basis, if at any time during the applicable Royalty Term, one or more Generic Products are commercially launched by a Third Party (other than a Third Party sublicensee) in a country, then the applicable royalty rate for such Licensed Product in such country shall be reduced to [*] percent ([*]%) of Net Sales of such Licensed Product beginning from the launch of such Generic Product and continuing so long as such Generic Product is being sold in such country. Notwithstanding anything to the contrary set forth in this Agreement, to the extent that Kite has entered into a Sublicense Agreement pursuant to

which Kite is not entitled to receive royalties in a country in which a Generic Product has been commercially launched, Kite shall have no obligation to pay, and Cabaret shall have no right to receive, royalties with respect to sales of Licensed Product in such country.

4.3.4 Combination Products. If a Licensed Product either (a) is sold together with another active ingredient product or device product which is not covered by a Valid Claim for a single price, or (b) consists of components that are covered by a Valid Claim and an active ingredient or device component that is not covered by a Valid Claim, then (except in the case where (i) the other active ingredient or device product or component which is not covered by Valid Claim also is not covered by any other valid patent claim, and (ii) a sublicensee pays to Kite a royalty which is not subject to an adjustment for such other active ingredient or device product or component) for purposes of the royalty payments under Section 4.3 for Net Sales of such Licensed Products, such Net Sales, prior to the royalty calculation set forth in Section 4.3, first shall be multiplied by the fraction $A/(A+B)$, where A is [*], and B is [*]. If the parties cannot reach an agreement as to the Value of each of the products or components then a Third Party arbitrator who is an industry expert shall be appointed to provide such determination which shall be binding on the parties. The parties shall equally share all costs associated with such determination. Until such

determination is made Kite shall make payment under Section 4.3 to Cabaret in accordance with its own determination and if following the Third Party arbitrator's decision an increase in payments is required Kite shall make such adjustment payments retroactively.

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

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