블록버스터 바이오신약 PD-1/PD-L1 면역항암제 옵디보 Opdivo 특허발명의 공동발명 성립요건 corroboration 입증책임: 미국법원 Dana-Farber Cancer Institute vs Ono Pharmaceutical & BMS 사건 판결

실무적으로 공동발명자 판단은 매우 중요합니다. 공동발명자라고 주장하는 측에 그 주장을 구체적 증거로 입증할 책임이 있습니다. 미국법원은 그 입증책임을 corroborating evidence, 즉 구체적 증거로 상세하게 입증할 것을 요구합니다. 위 사건에서 공동발명 여부를 입증하는 방법과 정도를 어떻게 판단했는지 판결문 중 해당 부분을 인용합니다. 한 번 읽어 보시기 바랍니다.

미국 특허법 공동발명자 규정 - 35 U.S.C. § 116(a) - Joint Inventorship

"When an invention is made by two or more persons jointly, they shall apply for patent jointly and each make the required oath, except as otherwise provided in this title. Inventors may apply for a patent jointly even though (1) they did not physically work together or at the same time, (2) each did not make the same type or amount of contribution, or (3) each did not make a contribution to the subject matter of every claim of the patent."

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An individual qualifies as a joint inventor **only if he contributes to the conception of the claimed invention**. Conception requires a **'definite and permanent idea of an operative invention**, including every feature of the subject matter sought to be patented.' An idea is definite and permanent when the inventor has a specific, settled idea, a particular solution to the problem at hand, not just a general goal or research plan.

Conception is complete when only ordinary skill would be necessary to reduce the invention to practice, without extensive research or experimentation.

A conception is not complete if the subsequent course of experimentation, especially experimental failures, reveals uncertainty that so undermines the specificity of the inventor's idea that it is not yet a definite and permanent reflection of the complete invention as it will be used in practice.

There is no explicit lower limit on the quantum or quality of inventive contribution required for a person to qualify as a joint inventor.

In particular, a putative joint inventor "need not demonstrate that he made a contribution equal in importance to the contribution made by the listed inventors." Instead, courts ask whether the contribution is "not insignificant in quality, when . . . measured against the dimension of the full invention."

Inventorship is determined on a claim-by-claim basis, and a putative co-inventor need only show that he contributed to the conception of one claim.

A joint inventorship analysis proceeds in two steps. **First**, a court must construe the claims to determine the subject matter encompassed thereby.

Second, a court must compare the alleged contributions of each asserted co-inventor with the subject matter of the correctly construed claim to determine whether the correct inventors were named.

To meet the clear and convincing evidence standard, **putative joint inventors must provide some corroborating evidence instead of relying solely on their own testimony**. This requirement for corroboration addresses the concern that a party claiming inventorship might be tempted to describe his actions in an unjustifiably self-serving manner in order to obtain a patent.

Courts use **a "rule of reason" analysis to determine if a putative joint inventor has sufficiently corroborated his testimony**.

This analysis requires considering all pertinent evidence to judge "**the credibility of the inventor's story**." There is no particular formula that an inventor must follow in providing corroboration of his testimony.

"Records made contemporaneously with the inventive process" are the most reliable corroborating evidence, but courts also consider "circumstantial evidence of an independent nature" and "oral testimony from someone other than the alleged inventor."

Oral testimony of one putative joint inventor is not enough on its own to corroborate the oral testimony of another. Courts have generally been most skeptical of oral testimony that is supported only by testimonial evidence of other interested persons. But such testimony can help to corroborate along with other evidence.

The record includes agendas from all but one of the three scientists' collaboration meetings, slides from the meetings, numerous emails and letters exchanged by the three scientists in 1999 and 2000, and published journal articles. These documents explain Dr. Freeman's and Dr. Wood's hypotheses, experimental results, and conclusions and are alone sufficient

to constitute corroborating evidence.

In addition to the plethora of documents, Dana-Farber provided corroboration from a number of witnesses. Dr. Brown corroborated Dr. Freeman's testimony about his antibody and IHC work. Dr. Carreno, a former GI scientist, confirmed that the trio met in May 2000 in Seattle. Dr. Collins at GI testified that Dr. Freeman reached out about finding 292's receptor and that Dr. Wood discovered that 292 is a ligand for PD-1.

Especially significantly, Dr. Honjo, who was present for the trial, confirmed most of the events to which Dr. Freeman and Dr. Wood testified. The "**cohesive web of allegedly corroborative evidence**" leaves no doubt that Dr. Freeman and Dr. Wood testified truthfully about the experiments they conducted, the communications they exchanged, and the substance of the meetings they attended.

지재권분쟁, 침해대응, 형사/민사소송, 손해배상, 심판소송, One-Stop 대응, A~Z 수행

T. 02-591-0657 E. kkh@kasanlaw.com H. www.kasanlaw.com