

专利许可谈判五大陷阱破解之道

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Agenda 议题

- Introduction
- Five Major Pitfalls (五大陷阱)
 - Not Knowing What You Are Licensing (不了解你所许可的事项)
 - Does Not Understand What Happens After Termination or Expiration (不清楚合同提前解除或期限届满后可能发生的问题)
 - Does Not Recognize U.S. Law on Implied Licenses (未意识到与“默示许可”有关的美国法规定)
 - Failure to Distinguish a “Covenant Not To Sue” from a “License” (未能区别“保证不诉”与“许可”)
 - Mistakenly Assume All Terms Are Valid and Enforceable (错误地假定所有的条款都有效并具有可执行力)

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- “50位45岁以下的知识产权律师顶尖人物之一” -- 《知识产权法与商务》杂志
- 担任过超过30件诉讼案的首席律师
- 兼任台湾国立交通大学的助理教授

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Why is a Patent License Agreement Complicated? 为什么专利许可合同具有复杂性？

- Patent Law (专利法)
- Trade Secrets Law (商业秘密法)
- Contract Law (合同法)
- Antitrust Law (反垄断法)
- Laws Governing Import/Export (规制进口/出口的法律)
- Federal and State Competition Laws (联邦和州关于竞争的法律)
- Procedural Law (程序性的法律)
- Property Law (财产法)
- Tax Law (税法)
- Bankruptcy Law (破产法)
- International Law (国际法)

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One Issue to Keep in Mind in License Negotiations With a U.S. Company 在与美国公司进行许可谈判时应谨记的一个问题

- U.S. representative is likely a “licensing professional” (美国方面的谈判代表通常会是一个“许可专家”)
 - U.S. lawyer (美国律师)
 - Patent Lawyer/patent agent (专利律师/专利代理人)
 - Non-lawyer but with extensive training in and experience with patent licenses (不是律师但在专利许可方面接受过大量的训练并具有丰富经验)
 - Deep understanding of U.S. laws (对美国法律的深刻理解)

5

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THE PITFALLS (陷阱)

6

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Not Knowing What You Are Licensing 不了解你所许可的事项

- **Case One: *Aronson v. Quick Point Pencil Company***
 - Inventor agreed to disclose and license a design in exchange for royalties - higher royalties if a patent issued and lower royalties if not. (发明人同意披露及许可一项设计并收取许可费—如果被授予专利适用较高的许可费, 如果未授予专利则适用较低的许可费)
 - The design remained secret only until the product was sold because the design was evident from the product (no reverse engineering necessary) (由于此项设计从产品本身已显而易见(无需反向工程分析), 因此其“秘密性”仅可持续至产品被出售之前)
 - Both parties knew trade secret would be destroyed once the product is sold. (双方均了解一旦产品被出售其商业秘密性即消失)
 - Patent did not issue. (专利最终未被授予)

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Not Knowing What You Are Licensing

- ***Aronson v. Quick Point Pencil Company (Continued)***
 - Licensee (Quick Point Pencil) refused to pay royalties. (被许可人(Quick Point Pencil) 拒绝支付许可费)
 - U.S. Supreme Court held Licensee must pay. (美国最高法院判决被许可人必须支付)
 - that because the royalty obligation was for the disclosure and use of the design, licensee had to continue to pay royalties despite the fact that Licensor (Aronson) never obtained a patent and its trade secret was extinguished. (由于许可费支付的义务是就该项设计的披露和使用而设定, 尽管许可人(Aronson)未就此获得专利并且商业秘密亦“不复存在”, 被许可人仍必须继续支付许可费)
 - Quick Point Pencil's competitors are free to use the design without having to pay any money to Aronson. (但Quick Point Pencil的竞争对手们可免费使用该项设计并且无需向Aronson支付任何费用)

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Not Knowing What You Are Licensing

- *Aronson v. Quick Point Pencil Company (Continued)*
 - Lesson (教训):
 - The agreement may seem to be a good deal for Quick Point Pencil at first (这份合同看上去最初对Quick Point Pencil是不错的交易)
 - Quick Point Pencil did not realize, if the patent did not issue, it would essentially be licensing a trade secret (Quick Point Pencil 未意识到, 如果专利未被授予, 实际上会是就商业秘密获得许可)
 - a trade secret that may be reverse engineered. (一项可被反向工程解析的商业秘密)

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- Case Two: *Warner-Lambert Pharmaceutical Co. v. John J. Reynolds*
 - Dr. Joseph Lawrence invented a formula for antiseptic liquid compound (Joseph Lawrence博士发明了一项具有杀菌效果的液体化合物配方)
 - Dr. Lawrence licensed his invention to J. W. Lambert in 1881 and again to Lambert Pharmacal Company in 1885 (Lawrence博士于1881年将其发明许可给J. W. Lambert, 并于1885年又许可给Lambert Pharmacal Company)
 - Lambert (later became Warner-Lambert, now Johnson & Johnson(强生)) sold “Listerine” brand mouthwash (Lambert(后来成为Warner-Lambert, 即现在的强生公司)销售“Listerine”牌漱口水)



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- **Case Two: Warner-Lambert Pharmaceutical Co. v. John J. Reynolds**
 - Warner-Lambert paid royalties for over 75 years under license to use secret formula for Listerine brand mouthwash, but formula eventually became public knowledge (Warner-Lambert为“Listerine”牌漱口水的秘密配方使用权支付了75年的许可费用, 但配方最终成为公知信息)
 - Warner-Lambert sought a declaratory judgment that it no longer needed to pay royalties (Warner-Lambert要求获得其无需再支付许可费的确认判决).
 - Court found that Licensee (Warner-Lambert) was bound by the agreement (法院判决被许可人(Warner-Lambert)仍受合同义务约束)
 - Lambert agreed to pay royalties for as long as it made the product based on the original formula (Lambert同意只要基于该原始配方生产产品其就会支付许可费).

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Not Knowing What You Are Licensing

- **Case Two: Warner-Lambert Pharmaceutical Co. v. John J. Reynolds**
 - Court held: “One who acquires a trade secret or secret formula takes it subject to the risk that there be a disclosure.” (法院认为: “任何购买商业秘密或秘密配方的人都将承担秘密被公开的风险”)

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Does Not Understand What Happens After Termination or Expiration of a License 不清楚合同提前解除或期限届满后可能发生的问题

- Case One: *Nova Chemicals, Inc. v. Sekisui Plastics Co., Ltd.*
- Parties entered into License Agreement for a ten year term on a new process to produce a Styrofoam-type product. (双方就生产一种聚苯乙烯泡沫塑料类产品的新技术订立了为期十年的许可协议)
- The agreement did not specify that secrecy obligation survived beyond the term of the license. (协议中未规定保密义务在协议到期后继续存在)
- Court held that under the terms of the Agreement, Licensee NOVA was not required to maintain the confidentiality of the trade secret after ten years (after agreement term expired). (法院认定, 根据协议的规定, 被许可人NOVA在十年(即协议期限届满)后不再承担保密义务)

13

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Does Not Understand What Happens After Termination or Expiration of a License

- Case One: *Nova Chemicals, Inc. v. Sekisui Plastics Co., Ltd. (Continued)*
- Court therefore assumed that the purpose of the Agreement was to convey access to the secrets and the information lost its trade secret status, at least as to NOVA. (法院由此假定协议的目的在于允许使用相关秘密信息, 并且该等信息已失去其所具有的“商业秘密”特征--至少是对NOVA而言)
- Lesson: Licensor should require licensee to maintain secrets in perpetuity or for the life of the trade secret
(教训: 许可人应要求被许可人永久性地守密, 或至少持续至商业秘密的秘密性丧失时止)

14

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Does Not Understand What Happens After Termination or Expiration of a License

- Case Two: *Universal Gym Equipment v. EWRA Exercise Equipment*
- A License Agreement on manufacture of exercise equipment (有关运动器械生产的许可协议)
- EWRA agreed in the Licensee that it would *not* use features or designs of licensor's (Universal Gym) products after termination (EWRA在许可协议中同意其在协议终止后不会使用许可人 (Universal Gym) 产品的特征或设计)
- After termination, Licensee obtained a Universal machine on the open market and reverse-engineered the machine (协议终止后, 被许可人在市场上获得了一个Universal的产品并对该机器进行了反向工程解析).

15

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Does Not Understand What Happens After Termination or Expiration of a License

- Case Two: *Universal Gym Equipment v. EWRA Exercise Equipment (Continued)*
- Universal Gym sued for breach of contract (Universal Gym以违约为由起诉).
- EWRA's defense is that it was free to purchase products in the open market and reverse engineer the machine and sell the same machine if the only intellectual property protection is trade secret (EWRA的抗辩理由是: 如果在此唯一受保护的知识产权是商业秘密, 则其有权从市场上购买产品、对机器进行反向工程分析并出售相同的机器.)
- The Court affirmed breach of contract and award of damages (法院确认存在合同违约并判给赔偿金).
 - The issue is one of simple contract dispute (这只是一个简单的合同争议问题).

16

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Does Not Recognize U.S. Law on Implied Licenses 未意识到与“默示许可”有关的美国法规定

- In the Patent Law context, a patentee has the rights to exclude “making,” “selling,” “using,” and “importing”（在专利法框架下，专利权人有权限制“制造”、“销售”、“使用”和“进口”）
 - To Make Implies “To Have Made”（“有权制造”意味着“可以安排第三方制造”）
 - To Make Implies To Use or Sell（“有权制造”意味着可以使用或销售）
 - To Make and Sell Implies To Use（“有权制造和销售”意味着可以使用）
 - To Make and Use Does Not Imply To Sell（“有权制造和使用”并不意味着可以销售）
 - To Sell Does Not Imply To Make（“有权销售”并不意味着可以制造）
 - If Product Otherwise Available（如果产品通过其他来源可以获得）

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Does Not Recognize U.S. Law on Implied Licenses

- Implied in Fact（事实上默示）
 - Arise From Facts Inferring Mutual Consent（基于可推断出双方同意的事实而产生）
 - i.e., Payment and Acceptance of Royalty（即，支付和接受许可费）
 - May be specifically disclaimed（可被特别排除）
 - in Written Agreement（通过书面合同）
- Equitable Estoppel (based on conduct)（禁止反言（基于行为））
 - Conduct of Patent Owner Inducing “Detrimental Reliance”（专利所有人的行为诱使“信赖损害”产生）

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Does Not Recognize U.S. Law on Implied Licenses

- Implied from License “to Make” (因“有权制造”的许可而产生的默示含义)
 - Must Be Specifically Excluded (必须特别予以排除)
 - “But Not Have Made” (“但不可安排他人制造”)
 - *CoreBrace LLC v. Star Seismic LLC* (Fed. Cir. May 22, 2009)
 - Clauses in the license agreement (在许可协议中的条款)
 - The license granted to Star the non-exclusive right to “make, use, and sell” the patented building brace (该项许可赋予Star从事“生产、使用和销售”受专利保护的**建筑支架**的非排他性的权利).
 - The license further contained a provision that Star *could not* “assign, sublicense, or otherwise transfer” its rights to any party except to an affiliated, parent or subsidiary company (该项许可还包含了一项规定, 即Star **不能**将其获得的权利许可给除其关联企业、母公司或子公司以外的其他任何主体).

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Does Not Recognize U.S. Law on Implied Licenses

- Federal Circuit held that the rights granted in the license to “make, use, and sell” a product *inherently included* the right to have the product made by a third party, *absent a clear indication of intent to the contrary* (联邦巡回法院认定, **在没有清楚表示相反意愿的情况下**, 该项许可所授予的“**从事生产、使用和销售**”产品的权利 **已自然地包括了**安排第三方生产产品的权利).

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“To Have Made” vs. “Sublicense”

- “Have Made” **Not** a “Sublicense” (“安排生产” **不等于** “再许可”)
 - Have Made = Subcontract (安排生产=合同分包)
 - Subcontractor Cannot Act Independently (分包商不能独立行事)
 - Subcontractor Can Only “Sell” the Licensed Products Back to the Licensee (分包商仅能将许可产品“售回”给被许可人)
- “Sublicense” Must Be Specifically Granted (“再许可” 必须特别授予)
 - May Not Be Less Restrictive Than Main License -- May Be More Restrictive (不能比“主许可”受到的限制少—还有可能受到更多的限制)
 - Will Continue After Early Termination of License -- Will Expire With License (在“主许可”提前终止的情况下仍然持续—但会在“主许可”期限届满时一同到期)
 - May Be Modified by Contract (可通过合同进行修改)

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Fails to Distinguish a “Covenant Not To Sue” from “License” 未能区别“保证不诉”和“许可”

- Covenant Not to Sue (保证不诉)
 - Personal Promise (个人保证)
 - May Not Run With Patent on Sale (不能附随于售出的专利)
 - No Implied Representations (不存在默示的陈述)
 - No Exhaustion by Sale Under Covenant (在保证之下不因销售而权利用尽)
- Non-exclusive License (非排他性许可)
 - Promise Not to Sue Licensee (不诉被许可人的保证)
 - Runs With Patent (附随于专利)
 - Implied Representation of Power to Grant Sublicense (表明有权进行再许可的默示陈述)
 - Implied License on Other Patents (对其他专利的默示许可)

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Mistakenly Assume All Terms Are Valid and Enforceable

错误地假定所有的条款都有效并具有可执行力

- Term(条款规定): Licensee cannot challenge validity of a patent(被许可人不能质疑专利的有效性)
 - Case: *Lear, Inc. v. Adkins*
 - A Licensee Can Challenge Validity of Licensed Patent (被许可人可以质疑被许可专利的有效性)
 - Strong Public Interest in Free Competition in Ideas in Public Domain (确保在公共领域内进行思想的自由交流具有重要的公共利益)
 - Licensee Has Greatest Economic Incentive to Challenge Validity of Licensed Patent (被许可人具有很强的商业动机质疑被许可专利的有效性)
 - Licensee Not Required to Pay Royalties During Challenge of Validity (被许可人不需要在专利有效性被质疑期间支付许可费)

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Mistakenly Assume All Terms Are Valid and Enforceable

- Effect of Express No-Challenge Clause (“不允许质疑”条款的效力)
 - Not Enforceable (不具可执行力)
 - Not Patent Misuse (不属于专利权滥用)

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Mistakenly Assume All Terms Are Valid and Enforceable

- Liability for Royalties (支付许可费的义务)
 - Non-contesting Licensee Must Pay During Challenge and Cannot Recoup Royalties (无异议的被许可人必须在“质疑”期间支付许可费并且不能要求退回许可费)
 - Contesting Licensee May Pay During Challenge to Maintain License and Recoup Royalties from Challenge on Invalidity (提出异议的被许可人可以在“质疑”期间支付许可费以维持许可；但如果专利确实无效则可以退回许可费)
- Protection of Lear Cannot be Invoked Until Licensee (对Lear的保护无法启动，直至被许可人：)
 - Stops Paying Royalties (停止支付许可费)；and
 - Provides Notice that it has Stopped Payment Because Relevant Claims are Invalid (发出通知，即被许可人由于有关专利权的无效已停止付款)。

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Recent Trend Re Patent Validity Challenges

- Patent validity challenge(对专利有效性的质疑)
 - Reexamtion through USPTO(要求USPTO(美国专利商标局)进行复审)
 - Declaratory judgment action through the federal court(在联邦法院提起确认之诉)
 - “reasonable-apprehension-of-suit” test(“对诉讼发生的合理预期”标准)
- Before *MedImmune, Inc. v. Genentech, Inc.* (January 9, 2007), Federal Circuit’s strict jurisprudence (在*MedImmune, Inc. v. Genentech, Inc.* (2007年1月9日)之前, 联邦巡回法院的严格判决)
 - Licensee would have to surrender its license (through breach or otherwise) to challenge validity(被许可人要质疑专利有效性就必须放弃相关许可(通过违约或是其他方法))
- In *MedImmune* case, the US Supreme Court held that “...[the licensee] was not required, insofar as Article III is concerned, to break or terminate its 1997 license agreement before seeking a declaratory judgment in federal court that the underlying patent is invalid, unenforceable, or not infringed...” (在*MedImmune* 一案中, 美国最高法院裁定“...[被许可人]在向联邦法院就有关专利无效、不具可执行力或未被侵权等寻求确认判决之前, 不需(在与第III款有关的范围内) 终止其1997年的许可协议...”)

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Other Issues With an International License Agreements 与跨境许可协议有关的其他问题

- Choice of Law, Choice of Forum (法律的选择/法院的选择)
 - Absent Choice, Law of Forum (未进行选择的情况下, 依法院地法律)
 - Consider Where Assets Are, Forum Bias (考虑资产所在地以及法院可能持有的偏见)
 - Arbitration Forum, choice of Law (仲裁所在地, 法律的选择)
- Governing Language (适用语言)
 - Better to Resolve During Negotiations (最好在谈判时解决)
- Termination Upon Significant Change (在发生重大变更时终止)

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Other Issues With an International License Agreements

- Governmental Approval (政府的批准)
 - U.S. Export Control Laws (美国出口控制的法律)
 - Foreign Government Approval/Registration (外国政府的批准/登记)
 - Local Party to Bear Responsibility (当地一方承担责任)
 - Condition Performance on Approval (将批准作为合同履行的前提条件)
 - Avoids Premature Disclosure of Know-how (避免过早披露技术诀窍)
- Payment Provisions (支付条款)
 - Currency, Time and Method of Conversion (币种、时间和兑换方式)
 - Place and Method of Payment (支付地点和方式)
 - Tax Treatment (税收安排)

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QUESTIONS?

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