

## 토론문 3

표준필수특허보유자의 특허권 남용에 대한

법적, 경제적 분석 :

IEEE의 Patent Policy Update 관련 논의를 중심으로

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## ◆ 주요 학력

1982 - 1986	서울대학교 무역학과 학사
1986 - 1988	경상대학교 대학원 경제학과 석사
1990 - 1996	미국 University of Texas at Austin(경제학 박사)



## ◆ 주요 경력

1995 - 1996	University of Western Ontario 교수
1996 - 2005	정보통신정책연구원 연구위원, 신산업연구실장
2005 - 2014	김&장 법률사무소 고문
2007 - 2009	정부투자기관 경영평가단 평가위원
2007 - 현재	한국산업조직학회 이사
2009 - 현재	한국법경제학회 이사 공정거래위원회 정책자문위원, 한국공정거래협회 Compliance Program 평가위원 역임

## ◆ 주요 상훈

1999	정보통신부장관 표창
2000	외교통상부장관 표창

## ◆ 주요 논문 및 저서

2007	최소가격 재판매가격유지에 합리성 원칙을 적용한 미국 대법원 판결, 경쟁저널
2007. 11	단독행위의 위법성 판단기준, 경쟁저널
2008	손해배상액 추정방법론에 대한 경제학적 검토: 미국의 사례를 중심으로, 법경제학 연구, 제5권 제2호
2008	특허소송 합의에 대한 경쟁법 적용, 한국공정거래조정원, LEG Working paper series, NO.2009-03
2009	특허소송 합의에 대한 경쟁법 적용: reverse payment를 중심으로, 법경제학연구, 제6권 제2호
2010	기업결합심사에서 효율성 효과를 판단하는 정성적, 정량적 방법론, 한국공정거래 조정원, LEG Working paper series, No.2010-05
2010	기업결합심사에서의 효율성 효과 판단: 방법론과 정책적 함의(공저), 경쟁법 연구, 제22권
2014. 1	지식재산권 취득과 경쟁법 위반, 경쟁저널
2014. 7	구매전환율을 이용한 수직형 기업결합의 시장분쇄 동기 분석, 경쟁저널

표준필수특허보유자의 특허권 남용에 대한  
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Backgrounds for Update

- The inherent ambiguity in the meaning of the terms 'reasonable' and "non-discriminatory" can limit the originally designed benefits of RAND licensing commitment.
- Greater clarity and transparency to IEEE RAND Commitment may facilitate further the adoption and implementation of standards, thereby increasing the benefits that consumers derive from standards.
- ✓ Provide better ex ante knowledge about licensing term and potentially broaden ex ante competition among technologies for inclusion in a standard,
- ✓ Facilitate both ex ante and ex post licensing negotiations and reduce patent infringement litigation.
- ✓ Help to mitigate hold up, ensure access to technologies necessary to implement IEEE standard and eliminate certain potentially anti-competitive practices.

## Prohibitive Orders

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- SEP holders agreeing to RAND Commitment shall neither seek nor seek to enforce a Prohibitive Order against willing licensees
- ✓ Unless the implementer fails to participate in, or to comply with the outcome of, an adjudication, including an affirming first-level appellate review, ... ; adjudicate patent validity, enforceability, essentiality and infringement ; award monetary damages ; and resolve any defenses and counterclaims.

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## Smallest Saleable Patent Practicing Unit (SSPPU) Rule

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- The value that the functionality (of the claimed invention or inventive feature within the SEP claim) contributes to the value of ... the Smallest Saleable Compliant Implementation that practices the SEP Claim.
- Better methodology for Reasonable Royalty, especially when product is complex and incorporates many patented technologies
- ✓ "the smallest salable unit approach was intended to produce a royalty base much more closely tied to the claimed invention than the entire market value of the accused products." (Virmetx Inc. v. Cisco Sys., 767 F.3d 1308, 1327 (Fed. Cir.2014), )
- ✓ "Courts should identify as the appropriate base that which the parties would have chosen in the hypothetical negotiation as best suited for accurately valuing the invention. The practical difficulty of identifying a royalty rate that accurately reflects the invention's contribution to a much larger, complex product often counsels toward choosing the smallest priceable component that incorporates the inventive feature." (DOJ/FTC(2011), The Evolving IP Marketplace: Aligning Patent Notice and Remedies with Competition)
- ✓ the entire market value rule (EMVR) is a narrow exception to the general rule that royalties are awarded based on the smallest salable patent-practicing unit. (Versata Software, Inc. v. SAP America, Inc., 717 F.3d 1255, 1268 (Fed. Cir. 2013))

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## Smallest Saleable Patent Practicing Unit (SSPPU) Rule

- The Courts has employed a heightened evidentiary standard for consumer demand test necessary to apply the entire market value rule (EMVR)
  - ✓ Application of EMVR has provoked arguments that monetization, not restitution, is a motivating factor behind many infringement claims
  - ✓ '상당한(substantial) 고객수요가 있어야 한다' Lucent Techs. v. Gateway 판결 (Fed. Cir. 2009)
  - ✓ '가장 중요한(paramount) 고객수요가 있어야 한다' IP Innovation L.L.C. v. Red Hat 판결 (E.D. Tex. 2010)
  - ✓ '유일한 고객 수요의 근거 (only basis for consumer demand)' Inventio AG v. Otis Elevator 판결 (S.D.N.Y. 2011)
  - ✓ 최소판매가능부품원칙(SSPPU)이 기본이고 EMVR은 예외이므로 그 예외를 적용하기 위해서는 엄격한 기준이 책정되어야 할 것이고 ... 전체시장가치원칙을 적용하기 위해서는 단순히 어느 정도의 고객수요만으로는 부족하고 높은 수준의 고객수요가 있어야 한다. (정차호/정태미(2014))

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## Royalty stacking

- The value that the SEP Claim contributes to the smallest Saleable Compliant Implementation that practices that claim, in light of the value contributed by all SEP Claims
- Purposes of the RAND obligation is to prevent hold-up and royalty stacking. (In re Innovatio IP Ventures LLC Patent Litig., (N.D. Ill. Oct. 3, 2013))
  - ✓ The court applied SSPPU not EMVR : use WiFi chip, not system, as a royalty base.
- Appropriately apportioning the value of all SEP claims addresses royalty stacking, which may hamper implementation of a standard.

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## Level Discrimination

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- Level Discrimination
    - ✓ Patent Holders unilaterally select the appropriate level of the value chain at which to license their IP while refusing licenses to all other applicants.
  - Pros and Cons
    - ✓ All parties bear a share of the financial burden proportional to the benefits they derive.
    - ✓ Patent owners are more likely to be compensated for the full value of their patents.
- vs
- ✓ Level discrimination can threaten continuity of supply and demand : implementers lose the ability to control their own fates, which they could control if permitted to pay the patent holder a RAND rate directly for the right to make, use and sell their products.
  - ✓ Level discrimination threatens standard promulgation.

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## Level Discrimination

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- IEEE RAND Commitment obligates a patent holder to make available a license "to make, have made, use, sell, offer to sell, or import any Compliant Implementation. (DOJ, Business Review Letter, page 14)
  - ✓ Patent holder making an IEEE RAND Commitment cannot refuse to license it's patents for use at any levels of production.
  - ✓ Defining "Compliant Implementation" as "any product (e.g. components, sub-assembly, or end-product) or service
- Adds clarity as to who is entitled to a license under IEEE RAND Commitment and has the potential to facilitate implementation of IEEE standard.
  - ✓ Parties manufacturing products conforming to an IEEE standard, or investing in R&D, will know that they will have access to necessary technology, thereby facilitating implementation of these standards, to the benefit of others.

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