

Session 1

Recent Trends in Global IP Trials

**Patent Litigation in
The Central District and Beyond:
Statistics and Changes in the Law
presented to
THE PATENT COURT OF KOREA
October 17 – 18, 2018**



**Judge Andrew J. Guilford
United States District Court
Central District of California
(Southern Division)**

**캘리포니아 중부연방지방법원을 중심으로 한
미국의 특허 소송 실무:
통계와 법개정
한국 국제특허법원컨퍼런스 발표자료
2018년 10월 17 - 18일**



**앤드류 J. 길포드 판사
미국 캘리포니아 연방중앙지방법원
(남부지원)**



EXCITING TIME FOR PATENT LAW!
We are defining property rights, like on Blackacre
delivering Seisin in 1518.



Let's all do it together!



특허법의 활발한 발전기
점유권(seisin) 이전이 있었던 1518년과 같이
재산권을 정의해 나가는 시기



협력과 협동의 시기



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My home court in Orange County, California
is dealing with many exciting issues on Patent Law



오렌지카운티에 소재한 캘리포니아 중앙지방법원
남부지원은 특허법 관련 흥미로운 문제를 많이
취급함





The Central District




캘리포니아 연방중앙지방법원



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Central Calif. Tops Eastern Texas As Patent Hot Spot

By Erin Coe

Law360, New York (July 07, 2010) -- The U.S. District Court for the Central District of California has surpassed the Eastern District of Texas as the No. 1 spot for patent infringement suits, according to new statistics, and experts attribute the California court's rise in popularity to its sticking power and the greater flexibility it offers litigants.

After serving as the leading forum for patent filings — with 370 cases in 2007 and 307 actions in 2008 — the Eastern District of Texas was bumped from the top spot in 2009 by the West Coast court, its 249 cases eclipsed by the Central District of California's 276 suits, according to litigation analysis firm LegalMetric.





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캘리포니아 연방중앙지방법원이 텍사스 동부지방법원을 앞질러 특허중심지로 부상

Law360, 뉴욕(2010년 7월 7일) - 통계에 따르면, 캘리포니아 연방중앙지방법원이 특허침해 사건에서 텍사스 동부지법을 누르고 제1의 핫스팟으로 등극했다. 전문가들은 당사자들이 누리는 판결의 지속성과 유연성을 그 이유로 분석했다.

텍사스 동부지법은 특허소송의 선도적인 장의 역할을 해왔으나(2007년 370건, 2008년 307건) 소송분석전문기업인 리걸메트릭에 의하면 2009년 캘리포니아 연방중앙지방법원에 1위 자리를 뺏겼다. 텍사스 동부지법은 249건을, 캘리포니아 중부지법은 276건을 취급하였다.





TC Heartland And the Venue Dilemma Background Statistics: E.D. Tex. v. The Nation!

Motion	Win Rate or Time to Grant
Transfer Venue	Time to grant: <u>100 more days</u> than the national average. Love & Yoon, at 16.
Early Stage <i>Alice</i>	Win rate: <u>ten percentage points below</u> the national average. Love & Yoon, at 31.
Stay Pending Inter Partes Review	Win rate: as of August 31, 2015, <u>15.6% - 4.65 times less</u> than the national average of 72.5%. Douglas B. Wentzel, Stays Pending Inter Partes Review: Not In The Eastern District Of Texas, 98 J. Pat. & Trademark Off. Soc'y 120, 137 (2016) (emphasis added).
Summary Judgment in Favor of Defendant	Win rate: about <u>half</u> the national average. Love & Yoon, at 17.
All Summary Judgment	Time to grant: more than <u>100 days slower</u> than the national median. Love & Yoon, at 17.



TC Heartland판결과 재판지의 딜레마 통계자료: 텍사스 동부지법과 전국 비교

신청	승인율 /승인까지의 소요시간
재판지 변경	승인 시간: 전국 평균보다 100일 이상 소요 Love & Yoon, 16페이지
<i>Alice</i> 초기단계	승인율: 전국 평균보다 10%p 낮음 Love & Yoon, 31페이지
IPR로 인한 소송중지	승인율: 2015년 8월 31일 현재 전국 평균 72.5% 보다 4.65배 낮은 15.6% 더글라스 B. 웬첼, Stays Pending Inter Partes Review: Not In The Eastern District of Texas, 98 J. Pat and Trademark Off. Soc'y 120, 137(2016) (emphasis added)
피고승소 약식판결	승인율: 전국 평균의 절반 정도
전체 약식판결	승인 시간: 전국 중간값보다 100일 이상 소요 Love & Yoon, 17 페이지



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New Supreme Court Case Changes Venue Rules

In *TC Heartland LLC v. Kraft Foods Group Brands LLC*, 137 S. Ct. 1514 (2017), the Supreme Court changed venue laws and thus patent plaintiffs can't always choose to sue in the eastern District of Texas.

CREDIT: www.scotusblog.com



미국 연방대법원의 재판지 법리 변경 판결

TC Heartland LLC vs. Kraft Foods Group Brands LLC, 137 S. Ct. 1514 (2017)에서 미연방대법원은 재판지 관련 법리를 변경했고, 따라서 특허소송의 원고는 소를 제기할 때 텍사스 동부지법을 마음대로 선택할 수 없게 되었음.

CREDIT: www.scotusblog.com





Changing Venues

- In 2017, 21.57% of all new patent cases were filed in the TXED.
- This contrasts with 2015, a record year for patent litigation, when 44.2% of new cases were filed in the TXED.
- After changes to the patent litigation venue landscape, Delaware remains an active district for cases, parties, and accusations alike, even overtaking TXED in accusations.



재판지 변경

- 2017년, 신규 특허소송의 21.57%가 텍사스 동부지법에 제기되었음.
- 특허 소송이 가장 많았던 2015년과 대조를 이룸. 당시에는 신규 소송의 44.2%가 텍사스 동부지법에 제기됨.
- 특허재판지 관련 지형 변화 이후 델라웨어는 계속해서 사건, 소송당사자, 침해에 대한 구제청구 사건수 기준으로 활발한 지방법원으로 되어 있으며 심지어 구제청구 사건수에서는 텍사스 동부지법을 앞지름.

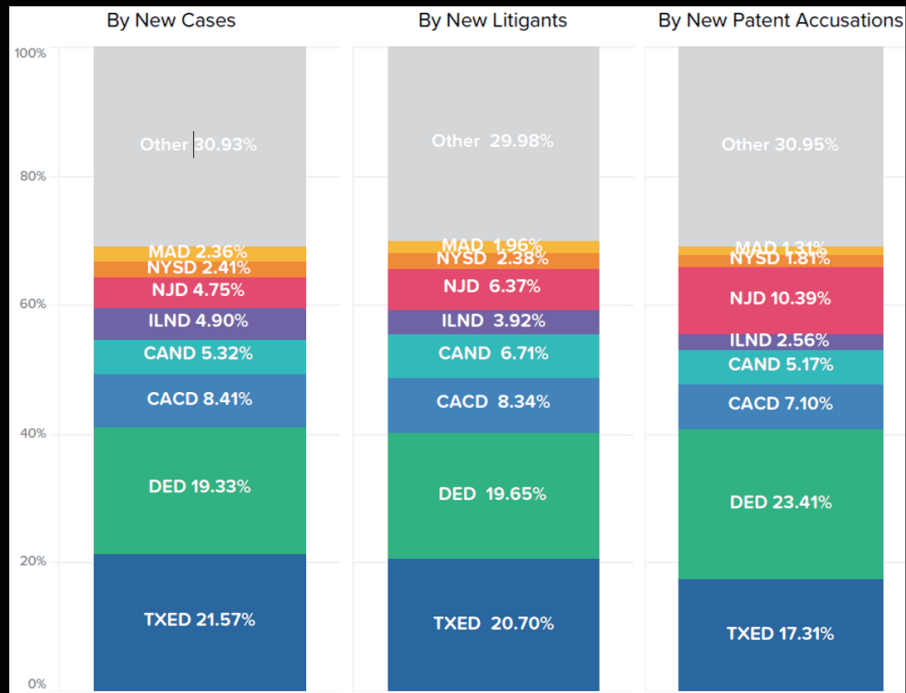


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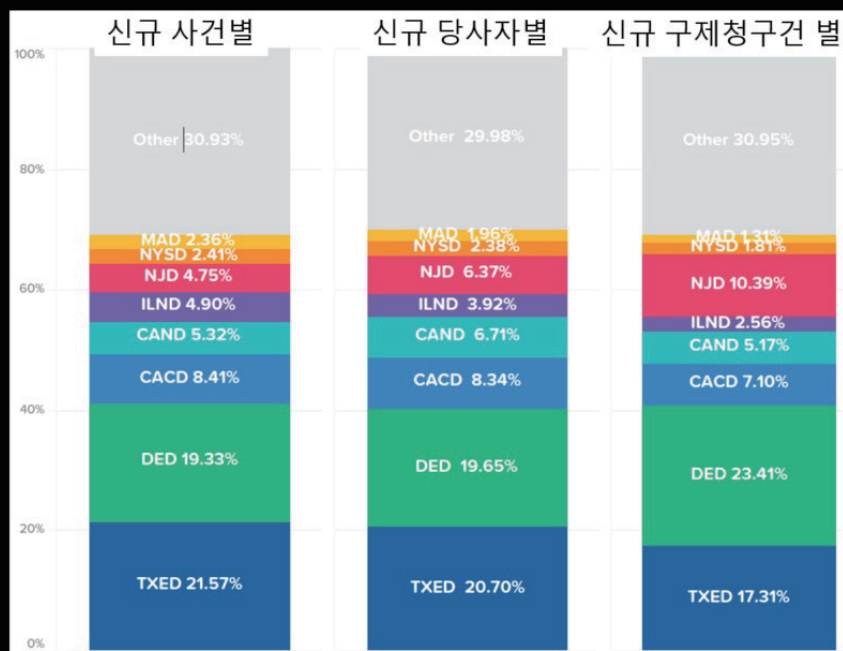
The Leading Patent Districts

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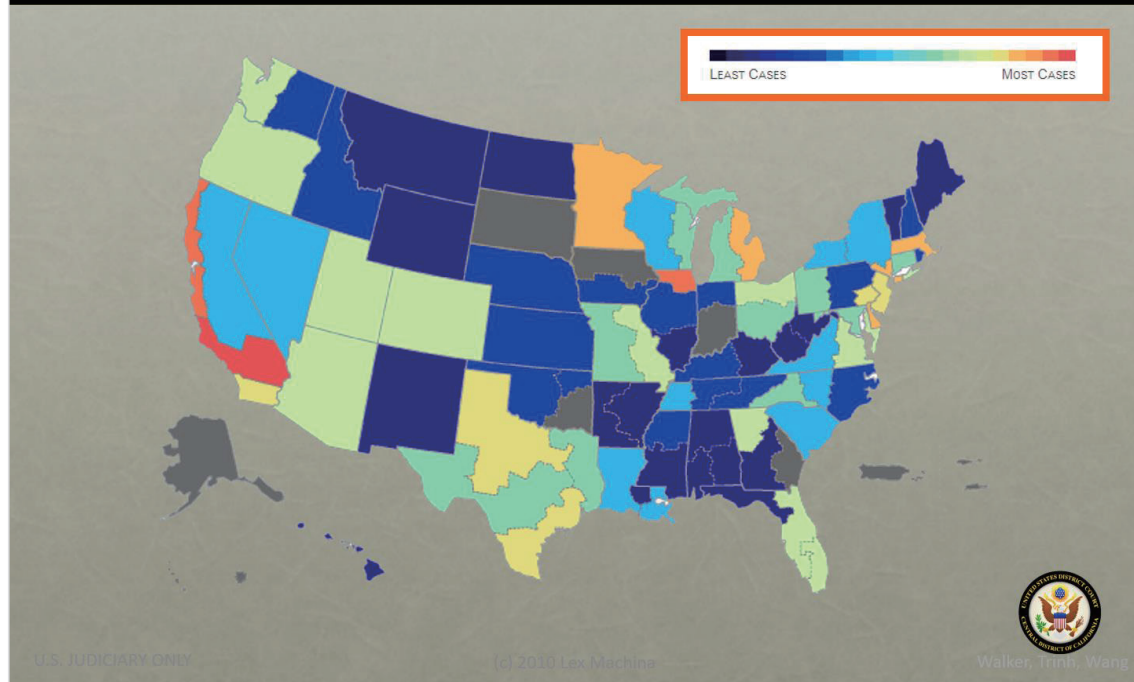
특허소송 주요 지방법원

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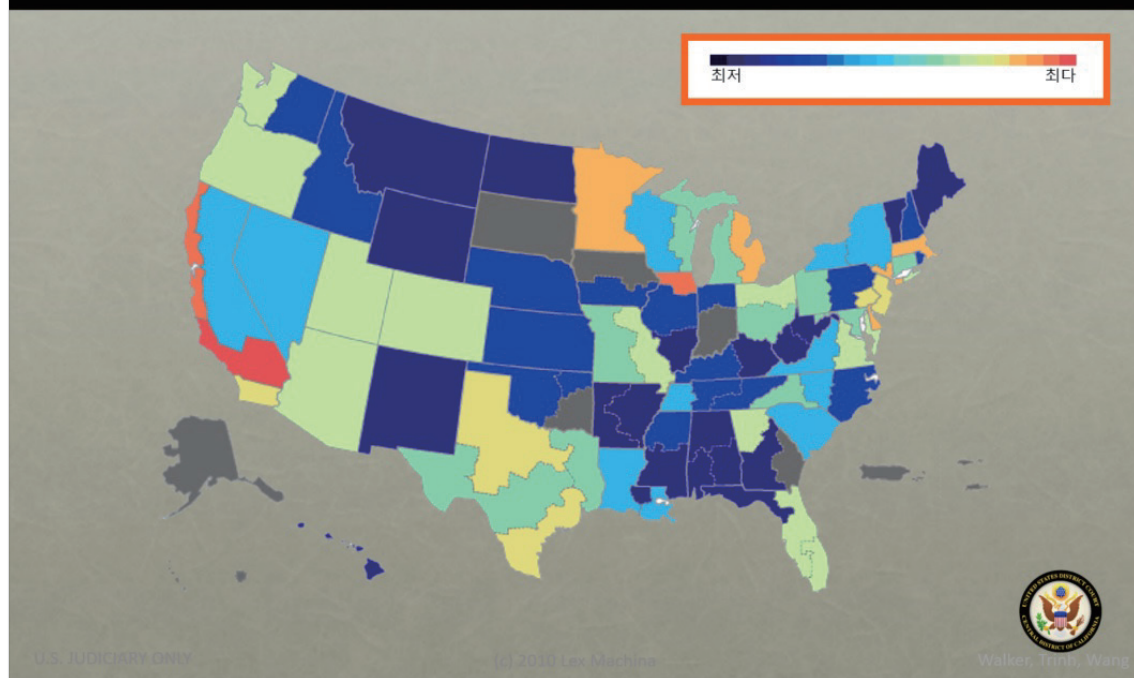




Heat Map of U.S. Patent Litigation in 2000



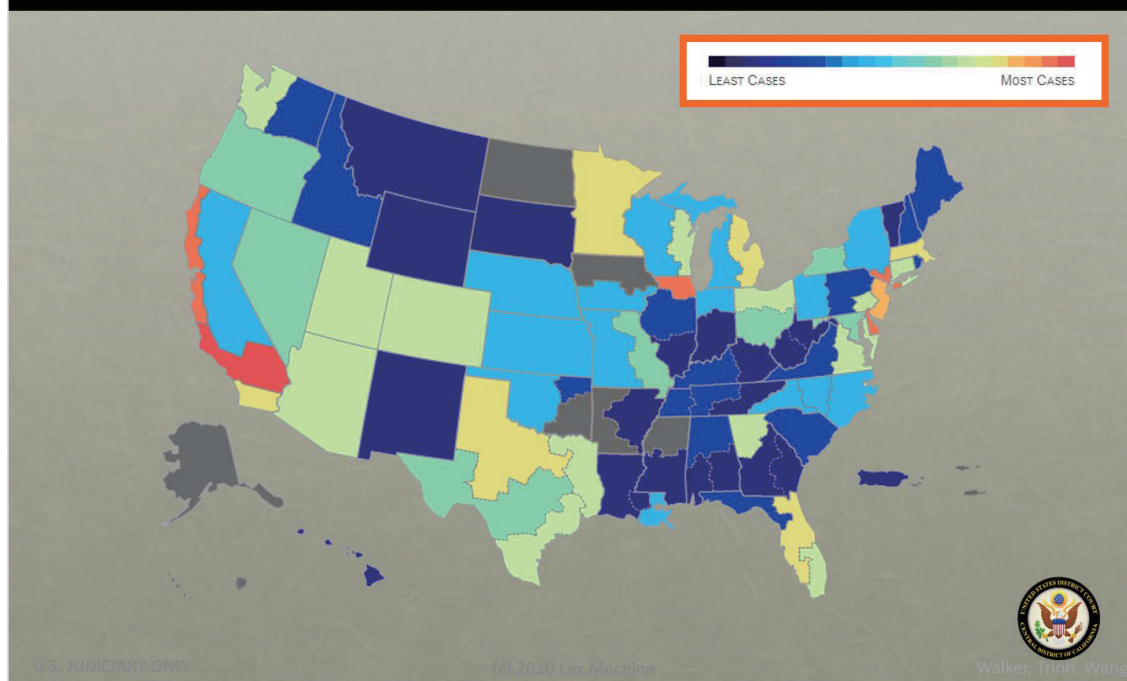
2000년 미국 특허소송 히트맵(Heat Map)



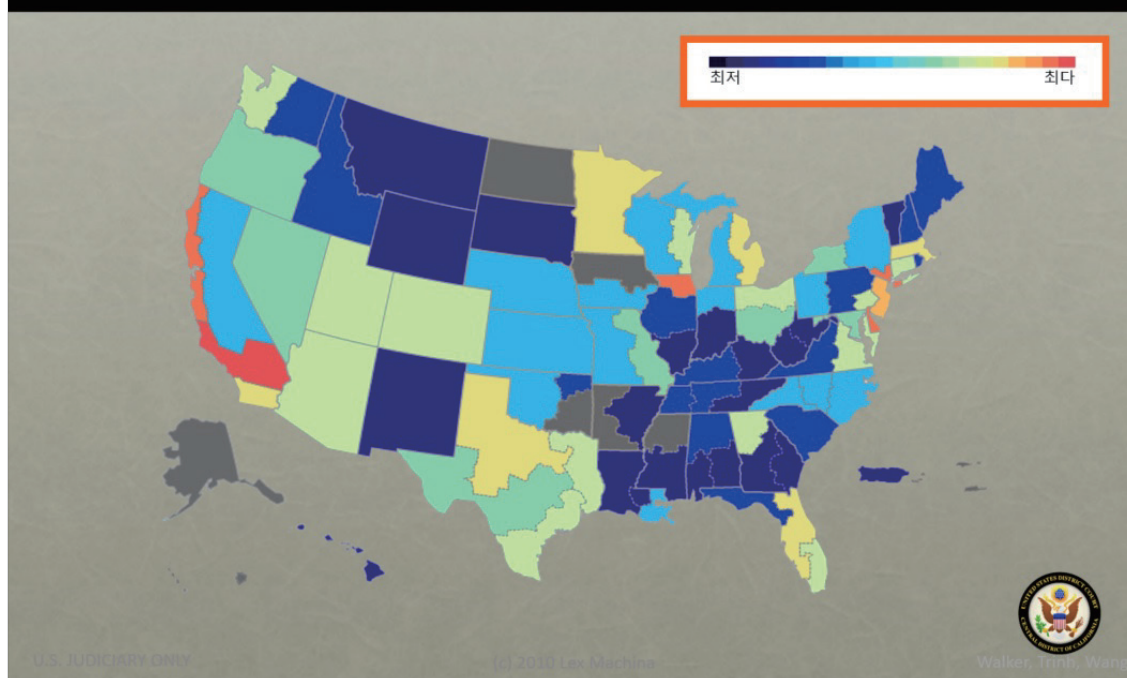
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Heat Map of U.S. Patent Litigation in 2001

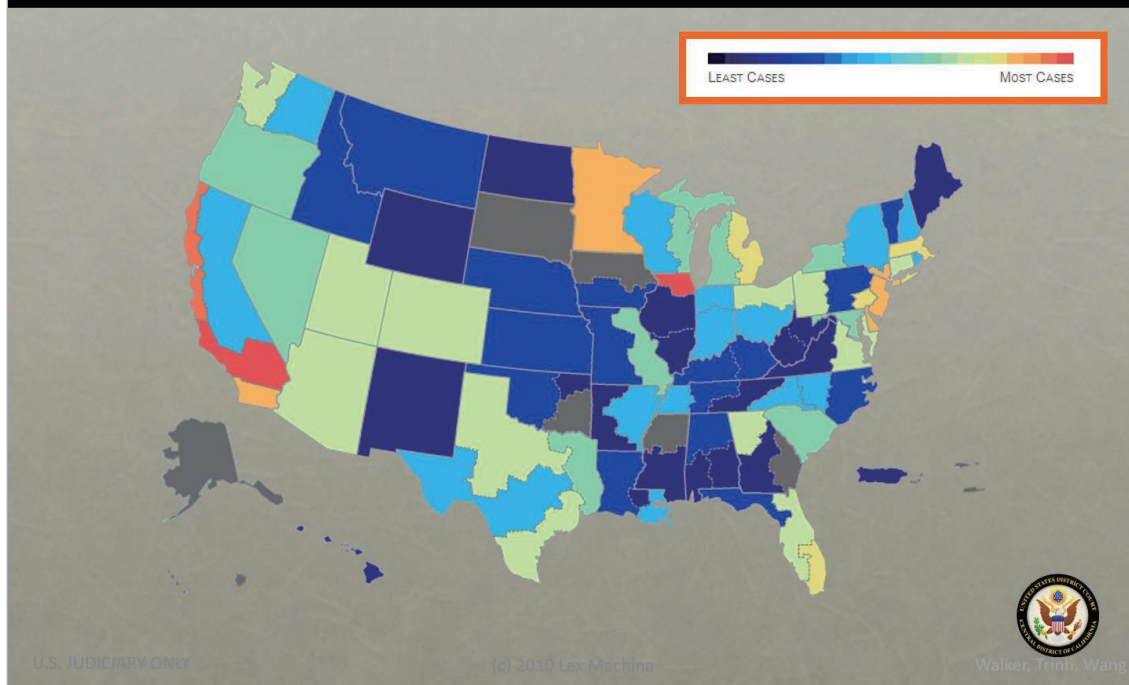


2001년 미국 특허소송 히트맵(Heat Map)

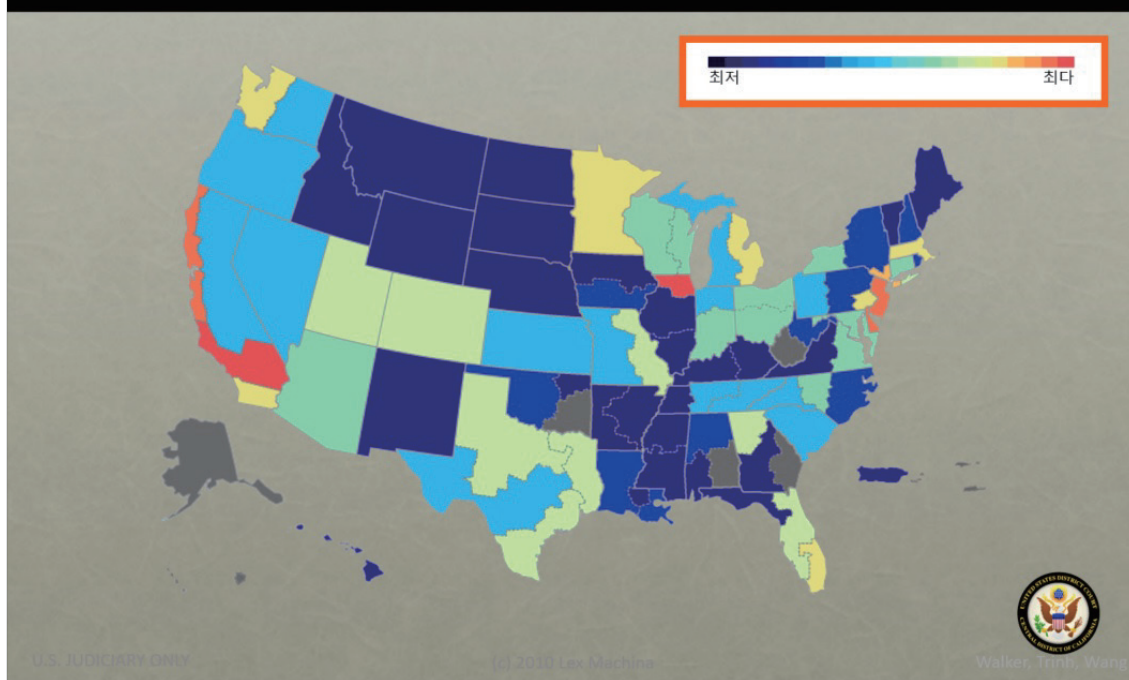




Heat Map of U.S. Patent Litigation in 2002



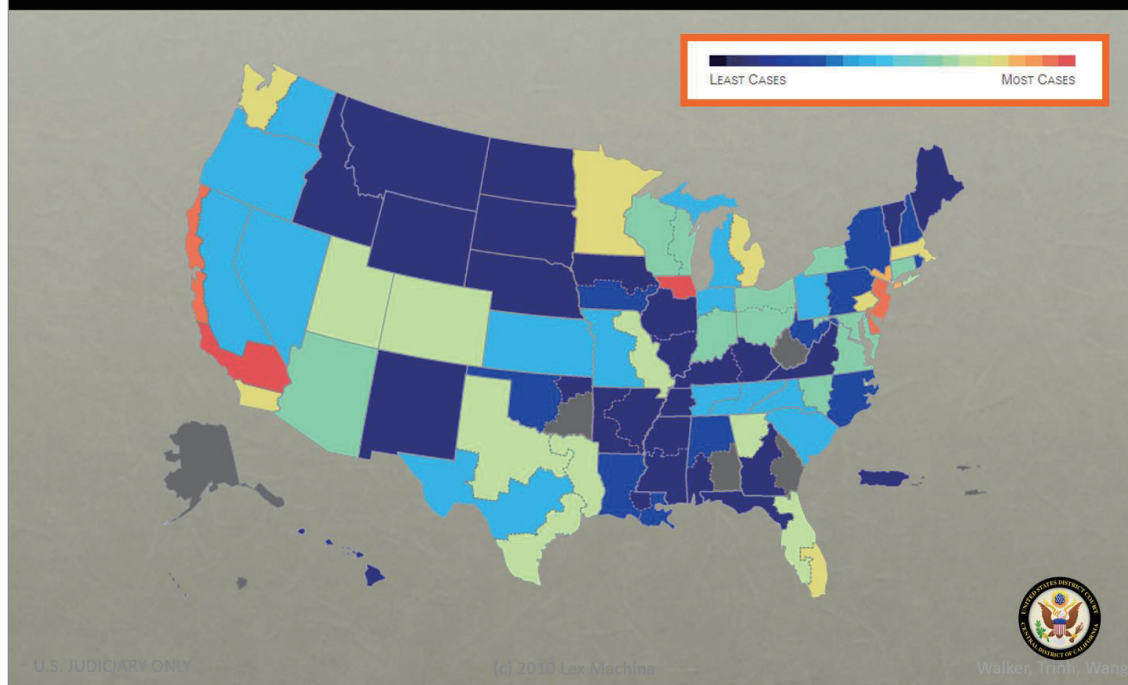
2003년 미국 특허소송 히트맵(Heat Map)



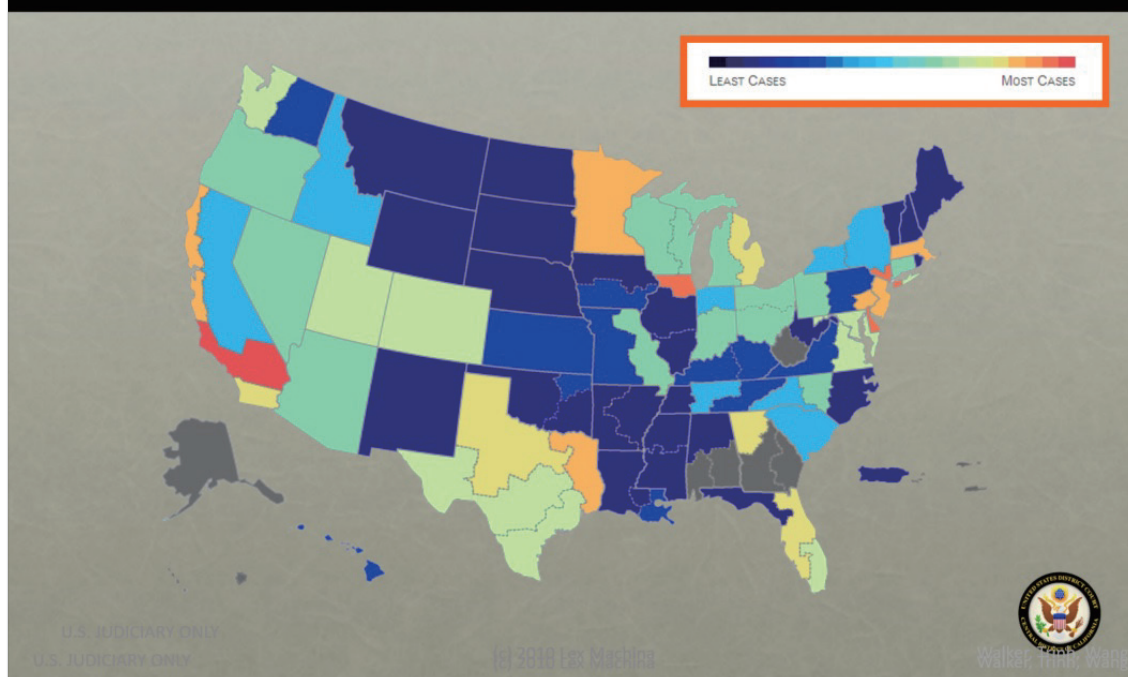
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Heat Map of U.S. Patent Litigation in 2003

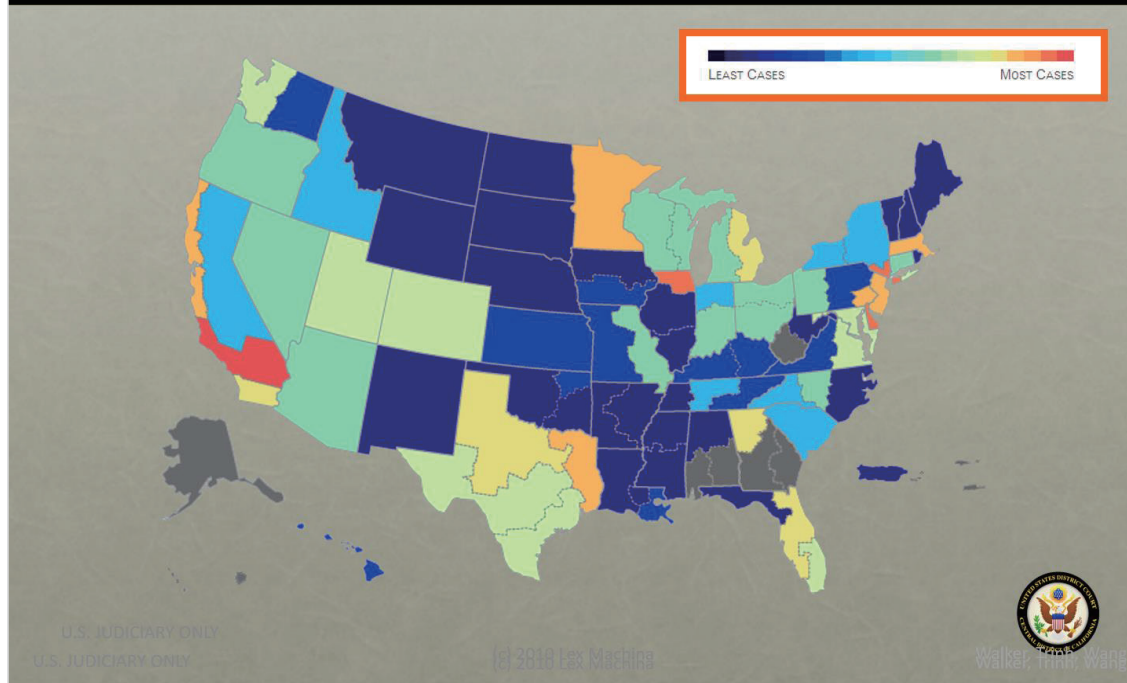


2004년 미국 특허소송 히트맵(Heat Map)

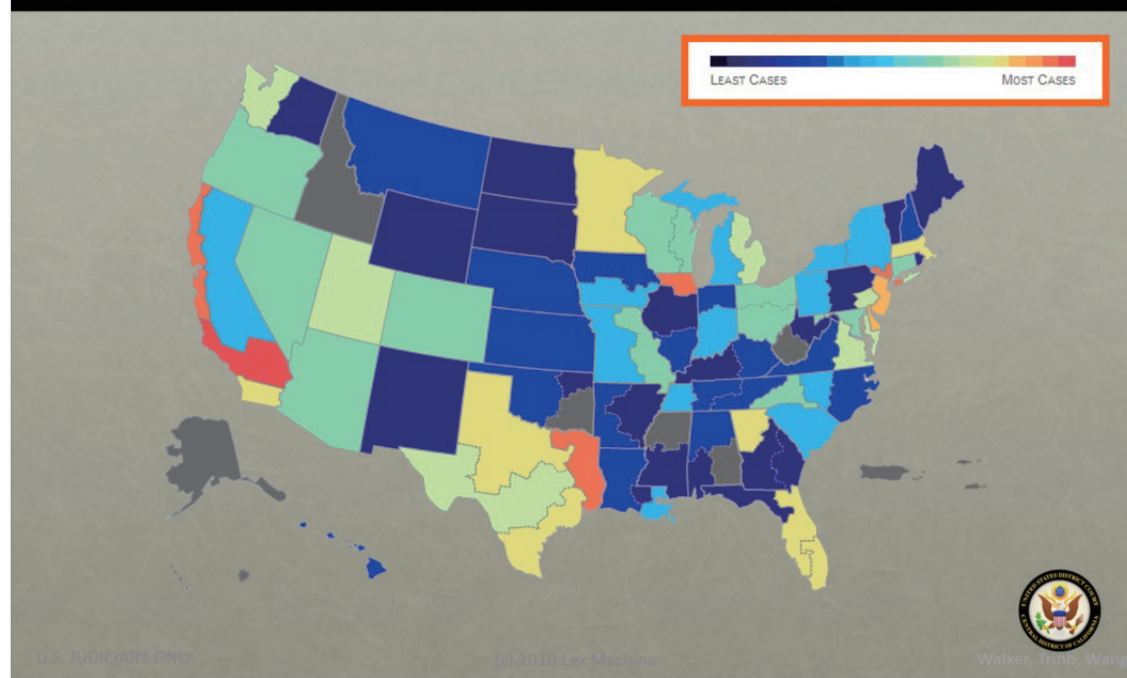




Heat Map of U.S. Patent Litigation in 2004



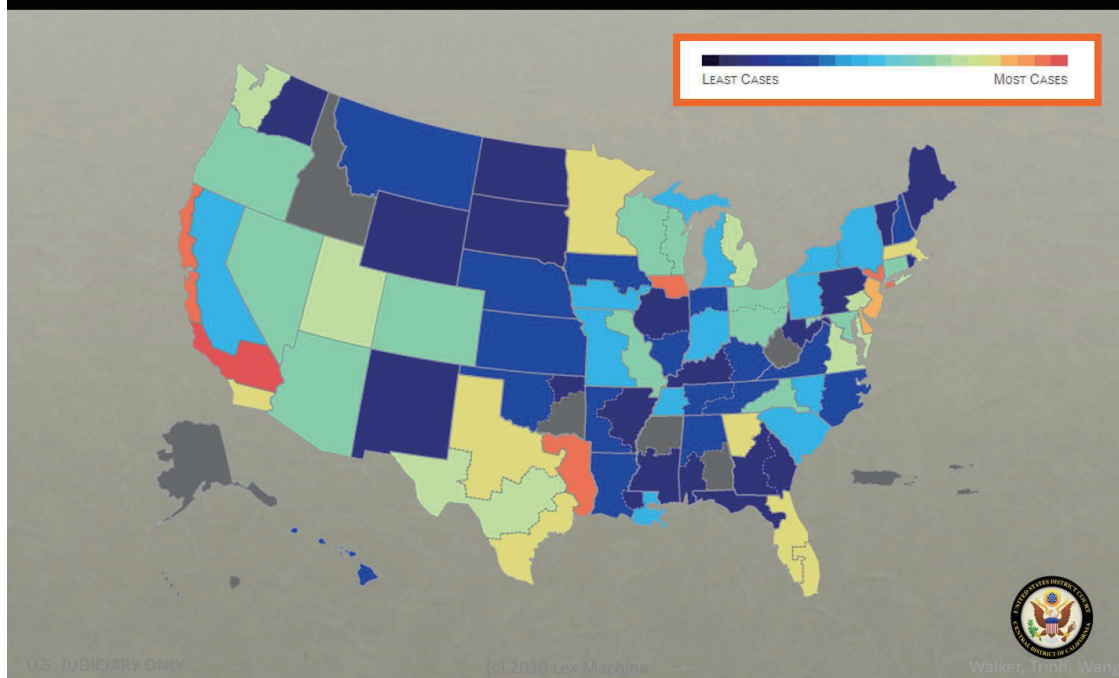
2005년 미국 특허소송 히트맵(Heat Map)



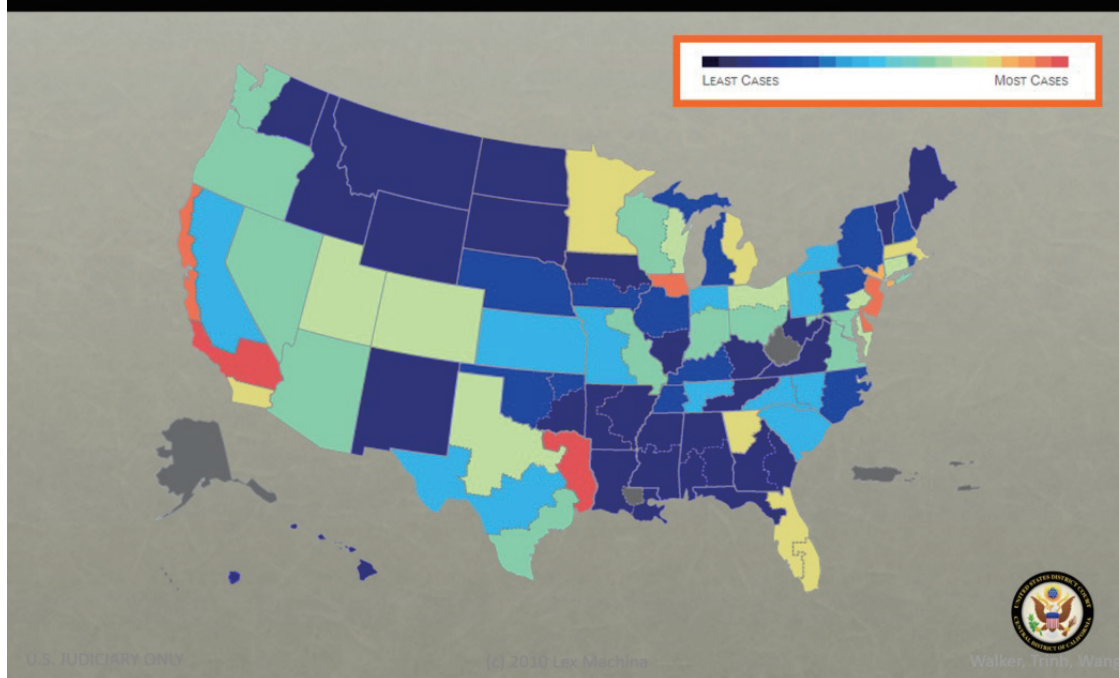
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Heat Map of U.S. Patent Litigation in 2005

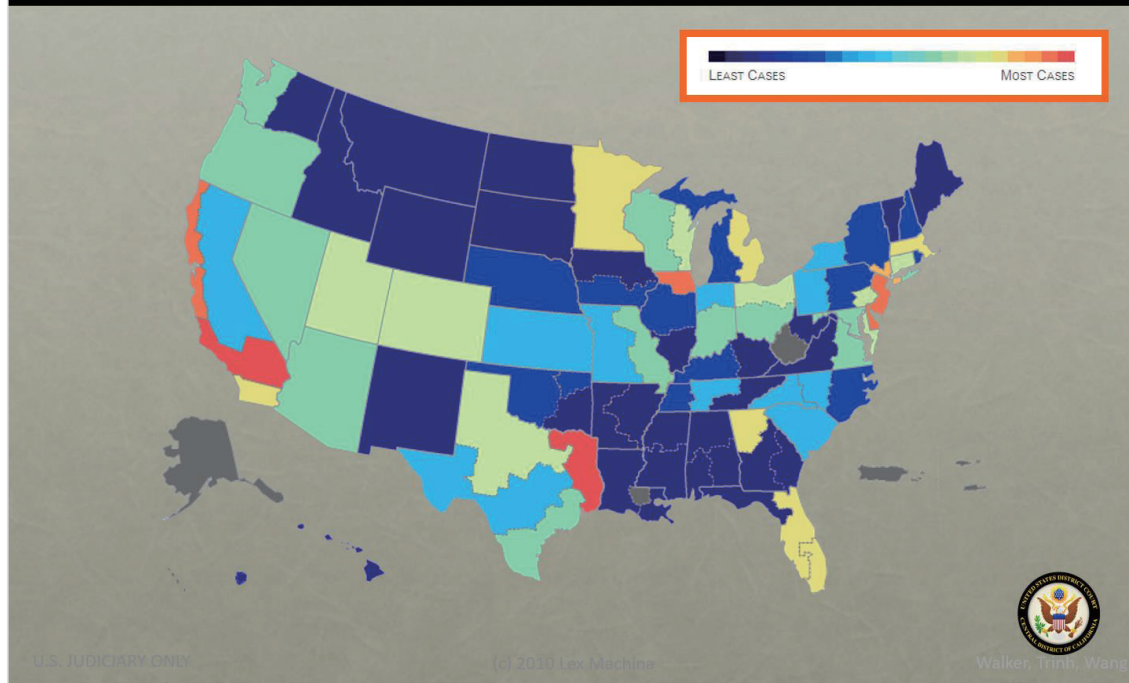


2006년 미국 특허소송 히트맵(Heat Map)

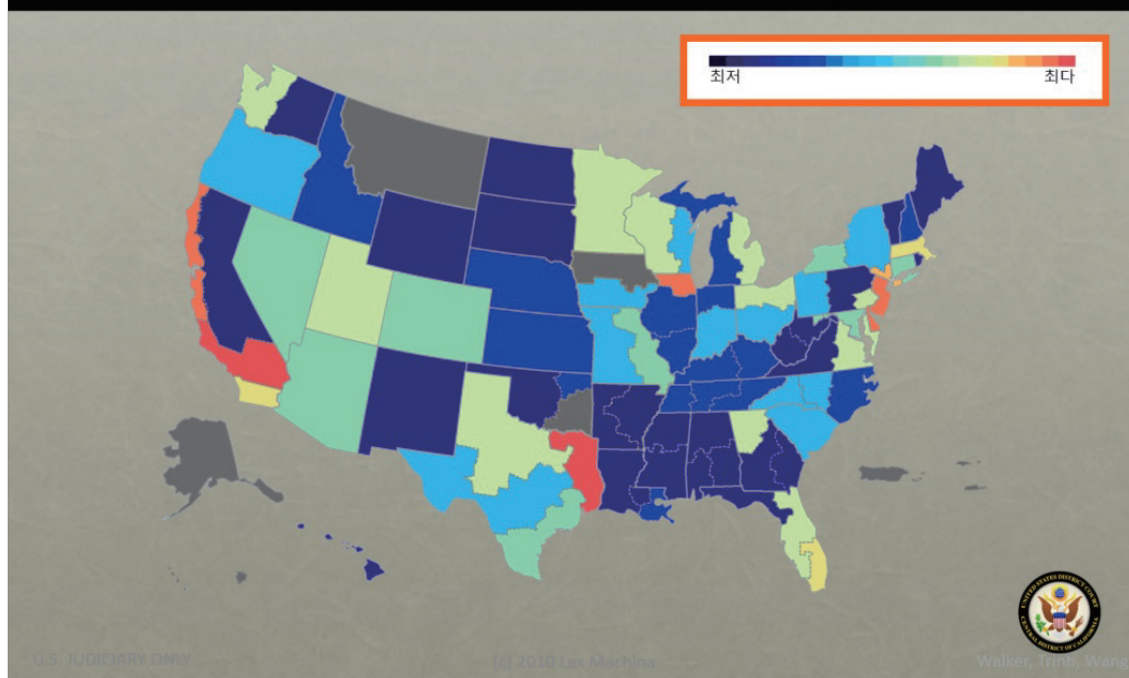




Heat Map of U.S. Patent Litigation in 2006



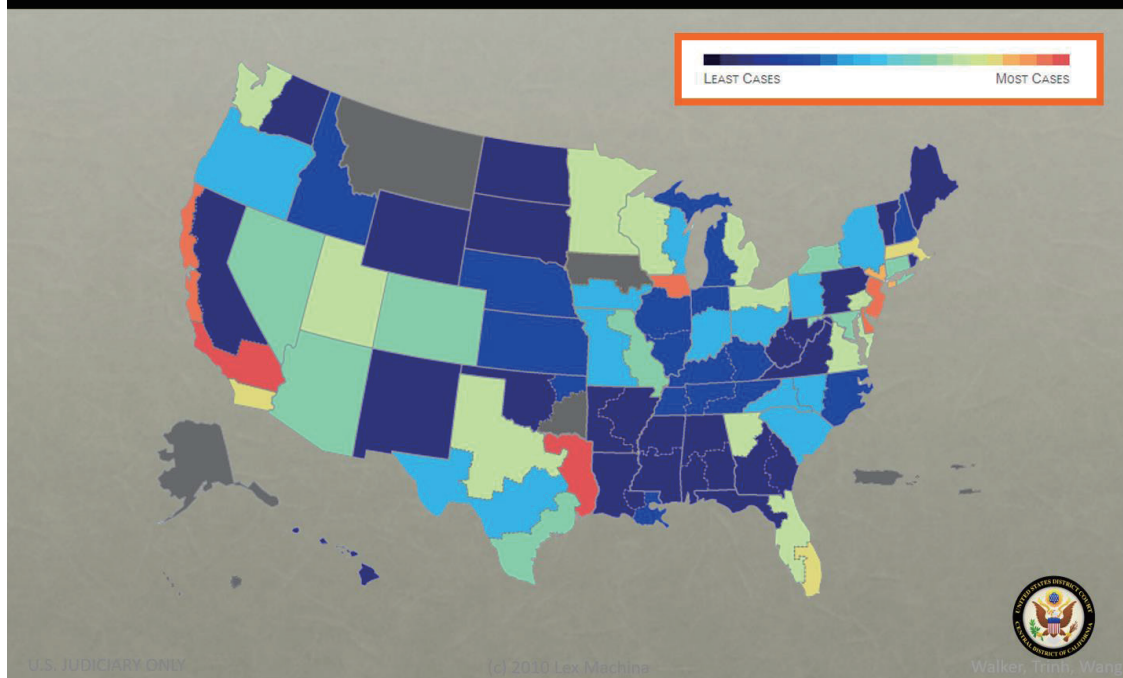
2007년 미국 특허소송 히트맵(Heat Map)



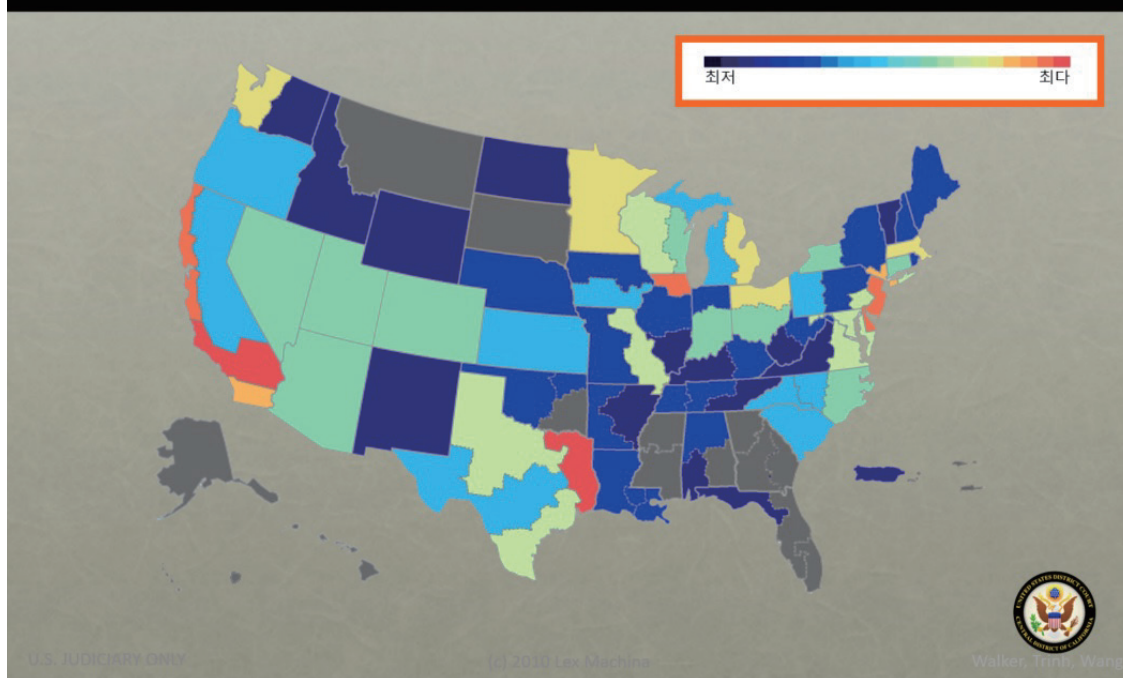
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Heat Map of U.S. Patent Litigation in 2007

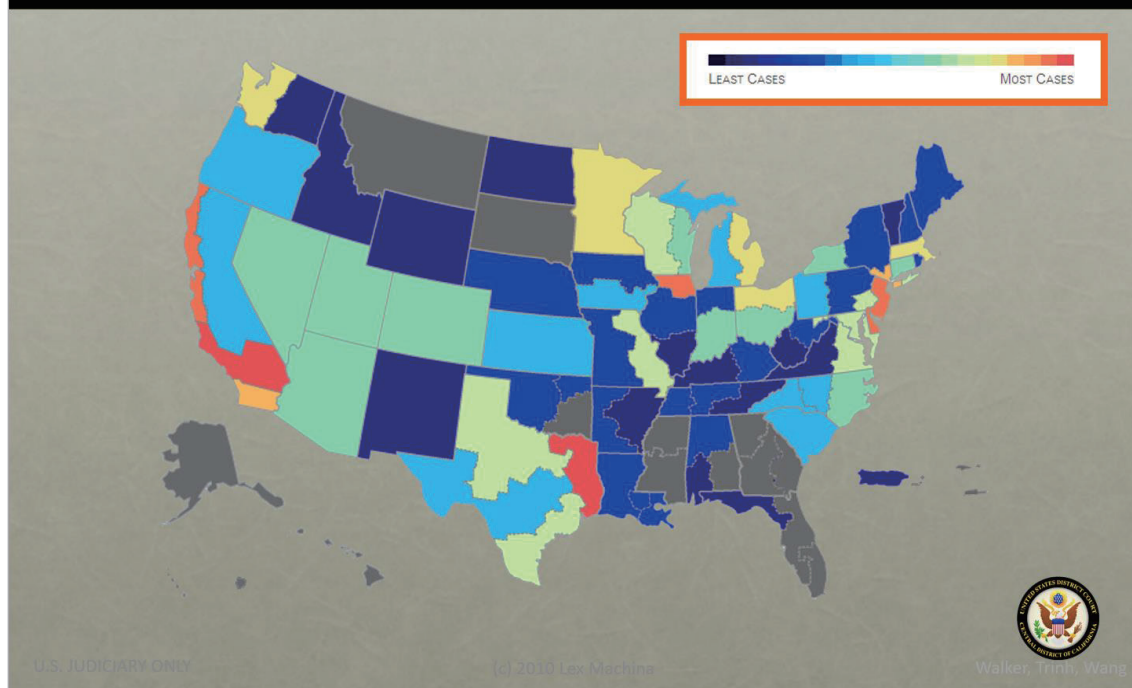


2008년 미국 특허소송 히트맵(Heat Map)

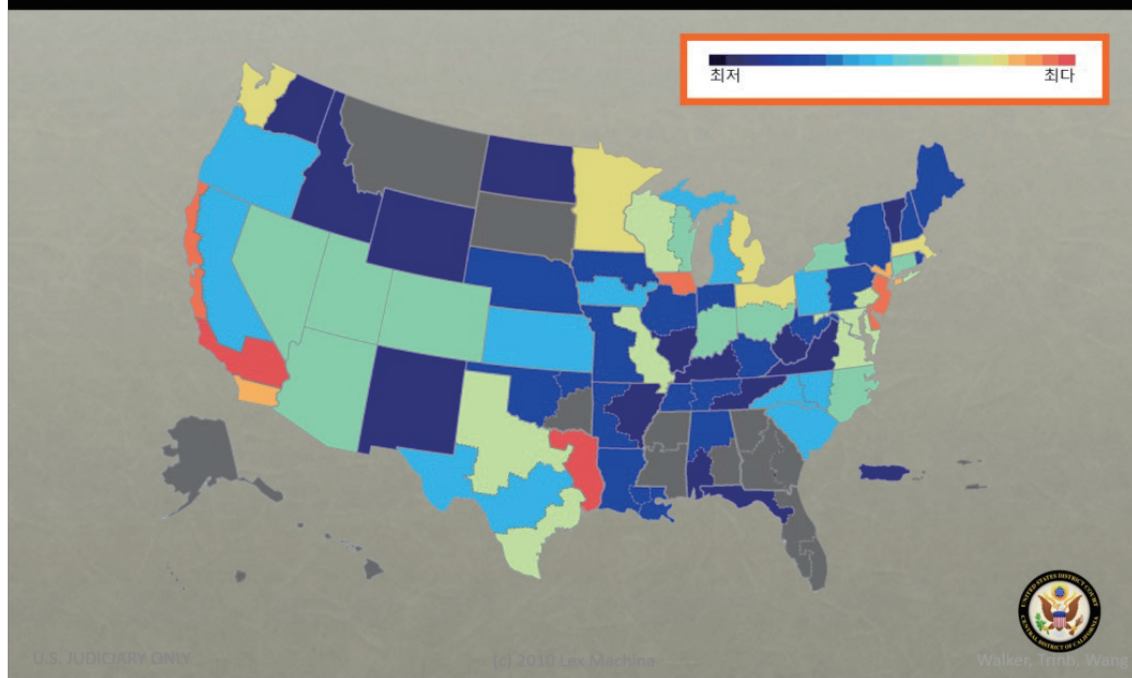




Heat Map of U.S. Patent Litigation in 2008



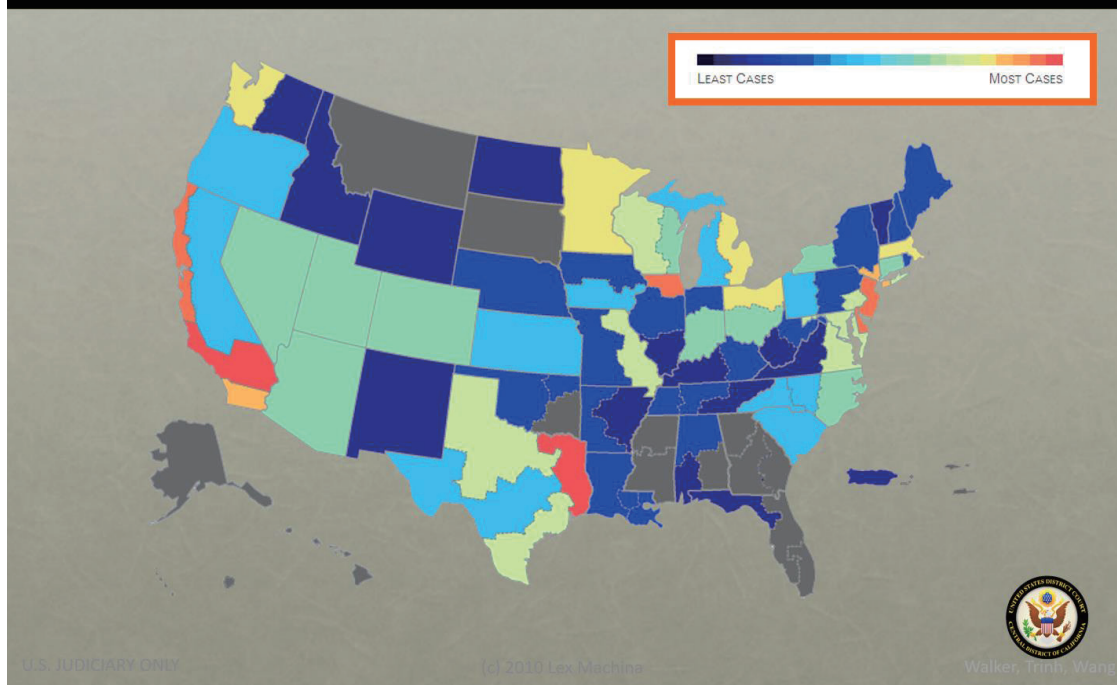
2009년 미국 특허소송 히트맵(Heat Map)



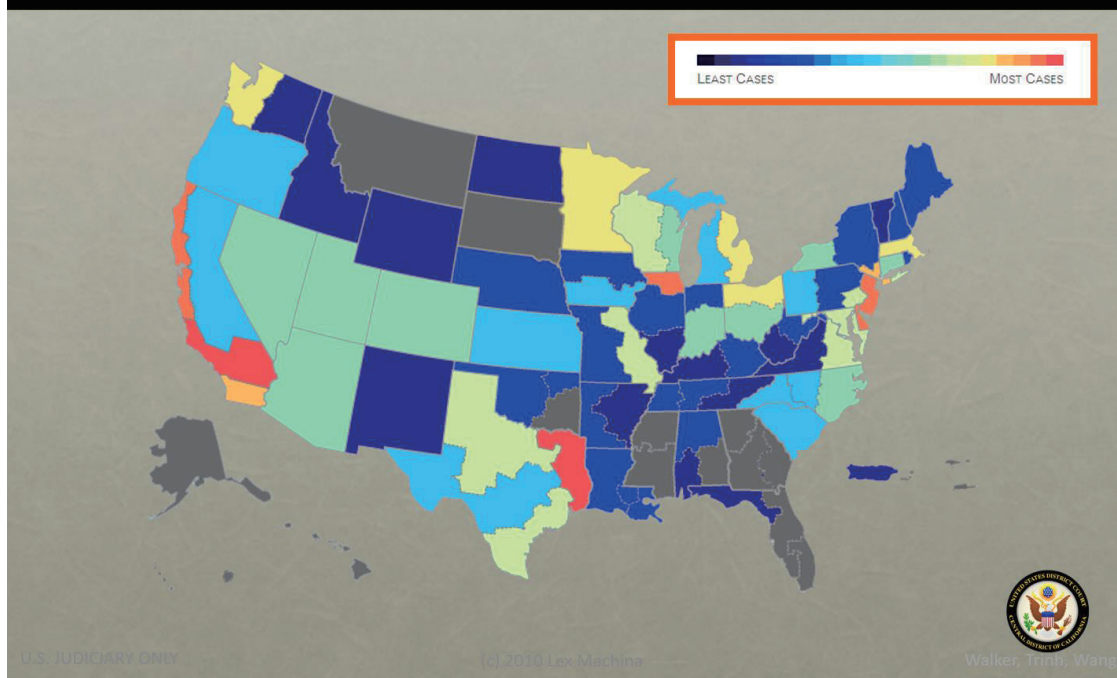
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Heat Map of U.S. Patent Litigation in 2009



2009년 미국 특허소송 히트맵(Heat Map)





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Calif. Judge Sets Sights On Patent Local Rules

By Erin Coe

Law360, New York (March 23, 2011) -- While the U.S. District Court for the Central District of California remains a popular spot for patent litigation, it has not adopted local rules for patent cases like many other courts across the U.S. — and one district judge may be looking to change that.

When Judge Andrew J. Guilford is not hearing cases in the Central District's Santa Ana courthouse or writing 123-page opinions, he is considering formulating rules for his court that would aim to streamline often complex disputes over patents and give greater certainty to the parties involved.

Currently, judges in the district each handle patent cases in their own way, and some even decide to follow the patent local rules of the Northern District of California or another court. But Judge Guilford sees advantages to putting a set of rules in place that would lay out a schedule for when parties have to file their infringement, invalidity and claim construction contentions and address other issues unique to patent suits.

Patent local rules would provide a level of standardization so that each judge would administer patent cases in the same way and would help litigants know what to expect when filing or defending against suits in the Central District of California, he said.

"I like the idea of considering the unique needs of our patent bar and writing rules for our community rather than adopting the rules of another court," Judge Guilford said. "Most of the leading districts for patent law have patent local rules, so maybe there is a good reason to have them."

Although the Central District of California nudged aside the Eastern District of Texas as the top forum for patent filings in 2009, with 276 suits compared with the Texas court's 249, the Eastern District of Texas regained the lead by a huge margin in 2010, with 636 patent filings, many of which were likely false patent marking suits, according to Greg Upchurch, director of research at litigation analysis firm LegalMetric.



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캘리포니아 판사의 특허규칙(로컬룰) 제정 노력

Law360, 뉴욕(2011. 3. 23.) 미 캘리포니아 연방중부지방법원은 특허소송법원으로 여전히 인기를 유지하고 있지만 다른 주들과 같이 특허규칙을 채택하지는 않고 있다. 어쩌면 지법판사 1명은 이를 바꾸려고 하는지 모른다.

앤드류 J. 길포드 판사는 중부지법의 산타 아나 법원에서 사건 심리를 하거나 123 페이지에 달하는 판결문을 쓰고 있지 않을 때는 소송 법원에서 특허관련 복잡한 분쟁을 간소화하고 당사자에게 더 명확함을 줄 수 있는 규칙 마련을 위해 힘쓰고 있다.

현재 법원의 판사들은 각자의 방식으로 특허사건을 처리하고 있고, 일부는 캘리포니아 북부지법 또는 여타 법원의 특허규칙을 따르기도 한다. 하지만 길포드 판사는 일련의 규칙을 마련하면 당사자들이 특허침해, 무효주장, 청구항 해석 관련 소를 제기할 때 일정을 정할 수 있으며 특허소송 특유의 문제에도 대응할 수 있는 장점이 있다고 보고 있다.

법원별 특허규칙은 일정 수준의 표준을 제공하여 해당 판사들이 동일한 방식으로 소를 관리할 수 있고, 당사자들은 캘리포니아 중부지방법원에서 소가 진행될 때 진행과정을 예상할 수 있을 것이라고 길포드 판사는 말했다.

또한 "특허사건에 특수한 필요를 충족하면서 다른 법원의 규칙을 가져다 쓰기보다는 우리만의 규칙을 정하고 싶습니다. 특허법 관련 주요 법원들은 대부분 특허규칙을 가지고 있는 만큼, 규칙이 필요한 이유가 있을 거라고 봅니다."라고 덧붙였다.

캘리포니아 중부지방법원이 2009년 특허소송에서 276건으로 249건을 처리한 텍사스 동부지법을 앞서는 하였지만 2010년에는 텍사스 동부지법이 큰 차이로 다시 원래 자리를 찾았다. 소송분석기업인 리컬메트릭의 조사국장 그렉 업처치에 따르면 텍사스 동부지법의 636건 중 상당수는 특허 허위표시사건일 가능성이 높다고 한다.



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Districts with Patent Local Rules

- 2001 California Northern*
- 2004 Georgia Northern
- 2005 Texas Eastern*
- 2005 Pennsylvania Western
- 2006 Minnesota
- 2006 California Southern*
- 2007 Texas Northern (Dallas Only)
- 2008 Texas Southern
- 2008 North Carolina Eastern
- 2008 Indiana Southern
- 2008 Massachusetts*
- 2009 New Jersey*
- 2009 Washington Western
- 2009 Illinois Northern*
- 2009 Ohio Northern
- 2009 Idaho
- 2010 Ohio Southern
- 2011 Missouri Eastern
- 2011 North Carolina Western
- **???? California Central District***

*Districts in the "Top 15" of New Patent Cases filings in 2009.



특허규칙(로컬룰)을 둔 지방법원

- 2001 캘리포니아 북부*
- 2004 조지아 북부
- 2005 텍사스 동부*
- 2005 펜실베이니아 서부
- 2006 미네소타
- 2006 캘리포니아 남부*
- 2007 텍사스 북부 (달라스 만 해당)
- 2008 텍사스 남부
- 2008 노스캐롤라이나 동부
- 2008 인디애나 남부
- 2008 매사추세츠*
- 2009 뉴저지*
- 2009 워싱턴 서부
- 2009 일리노이 북부*
- 2009 오하이오 북부
- 2009 아이다호
- 2010 오하이오 남부
- 2011 미주리 동부
- 2011 노스캐롤라이나 서부
- **???? 캘리포니아 중앙지방법원***

*2009년 신규특허사건 제기 기준 상위 15위 지방법원.





SPECIALIZATION AND ARTICLE THREE

- Local Patent Rules
- Federal Circuit Court of Appeal
- Districts that support specialization
- Patent Pilot Program
- America Invents Act and the Patent Trial and Appeal Board ("PTAB")



Article III Creates the Judicial Branch

- Article III Section:
 - 1 - Establishes the Supreme Court and defines the terms of service of all U.S. federal judges
 - 2 - Defines the jurisdiction of the Supreme Court and lower federal courts, and guarantees trial by jury in criminal courts
 - 3 - Defines the crime of treason

전문화 및 연방헌법 제3조

- 지방특허규칙
- 연방순회항소법원
- 전문화에 찬성하는 지방법원
- 특허시범프로그램
- 개정특허법과 특허심판원("PTAB")



제3조 사법부의 설립

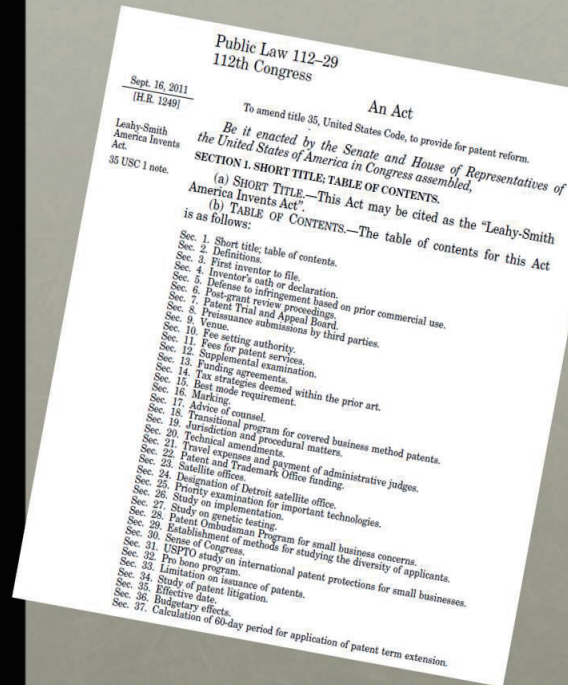
- 제3조
 - 1- 연방대법원을 설립하고 모든 연방판사의 업무요건을 정한다.
 - 2- 대법원과 하위연방법원의 관할을 정하고 형사재판에서 배심원에 의한 재판을 보장한다.
 - 3- 반역죄를 정의한다.

Session 1

Recent Trends in Global IP Trials

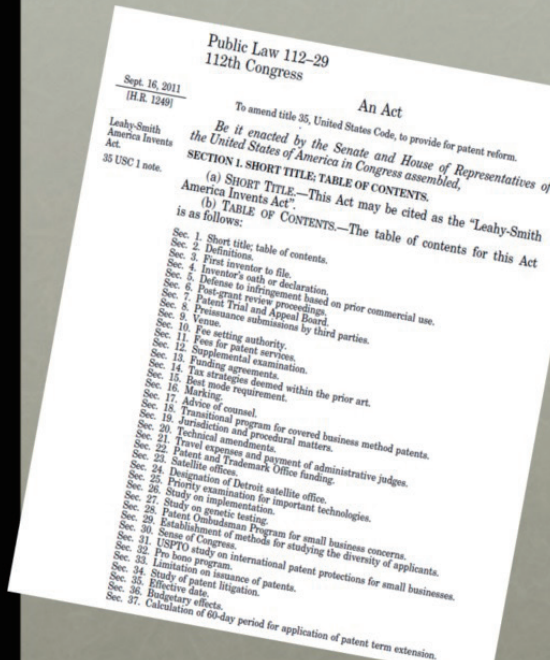
THE AMERICA INVENTS ACT

- Harmonizes patent laws internationally
- Improves quality of patents granted
- Reduces patent litigation costs
- Changes the U.S. to the world standard of "first inventor to file"
- Creates the PTAB and agency power



개정특허법

- 특허법의 국제적 조화
- 등록특허의 품질 개선
- 특허소송비용 절감
- '선발명주의'에서 세계 기준에 맞게 미국 기준 변경
- PTAB의 권한 신설





New Supreme Court Case Preserves PTAB

In *Oil States Energy Services, LLC v. Greene's Energy Group LLC*, 138 S. Ct. 1365 (2018), the Supreme Court preserved PTAB agency action finding invalidity without a jury

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Allyson N. Ho at lectern for petitioner (Art Lien)

새로운 대법원 판례로 PTAB 보전

Oil States Energy Services, LLC v. Greene's Energy Group LLC, 138 S. Ct. 1365 (2018) 사건에서 대법원은 배심원 없이 특허무효판단을 한 PTAB의 심결을 보전함.

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Allyson N. Ho at lectern for petitioner (Art Lien)

Session 1

Recent Trends in Global IP Trials

Recent Supreme Court Case Limits Patentability

In *Alice Corp. v. CLS Bank International*, 134 S. Ct. 2347 (2014), the Supreme Court limited the extent of patent rights, using a two step analysis.

In the first step, the court must determine whether the patent claim under examination contains an abstract idea, such as an algorithm, method of computation, or other general principle. If not, the claim is potentially patentable. If the answer is affirmative, the court must proceed to the next step.¹

In the second step, the court must determine whether the patent adds to the idea "something extra" that embodies an "inventive concept."

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최근 대법원 판례의 특허요건 제한 경향

Alice Corp. v. CLS Bank International, 134 S. Ct. 2347 (2014)에서 대법원은 특허권의 범위를 2단계 분석을 통해 제한했다.

먼저, 법원은 검토 중인 특허 청구항에 알고리즘이나 전산 방식, 또는 다른 일반 원칙 등 추상적인 아이디어가 포함되어 있는 지 판단해야 한다. 추상적 아이디어가 포함되어 있지 않으면, 해당 청구항은 특허 대상이 될 수 있다. 만약 포함되어 있다면 법원은 다음 단계를 밟아야 한다.¹

2단계에서 법원은 특허발명이 그 추상적 아이디어에 "창의적 개념"을 구현하는 "그 이상의 무엇"을 추가하는 지 여부를 판단해야 한다.

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Recent Supreme Court Case Strengthens “Loser Pay” Rules

In *Octane Fitness, LLC v. ICON Health & Fitness, Inc.*, 134 S. Ct. 1749 (2014), the Supreme Court held that the loser in a patent case must pay the winner’s attorney fees in a case found to be “exceptional” under 35 USC §285, which is simply a case that stands out from others with respect to the substantive strength of a party’s litigating position (considering both the governing law and the facts of the case) or the unreasonable manner in which the case was litigated.”

“Section 285 discourages certain ‘exceptional’ conduct by imposing the cost of bad decisions on the decision maker.” *Cambrian Sci. Corp. v. Cox Commc’ns, Inc.*, 79 F. Supp. 3d. 1111 (2015).

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Rudolph A. Telscher for petitioner (Art Lien)

최근 대법원 판례로 “패소자 부담” 원칙 강화

Octane Fitness, LLC v. ICON Health & Fitness, Inc., 134 S. Ct. 1749 (2014) 에서 대법원은 35 USC §285에 해당하는 “예외적인” 경우 특허소송의 패소자는 승소자의 법률비용을 부담하여야 하고, 이는 단순히 증거 및 해당 사건의 사실관계를 고려할 때 당사자의 실제적인 승소가능성 또는 사건이 불합리한 방식으로 진행되었는지 등을 기준으로 다른 사건들과 확연히 다른 경우를 가리킨다고 하였다.

“285조는 의사결정자의 부당한 결정에 비용을 부과함으로써 특정한 “예외적인” 행위를 하지 못하도록 한다”. *Cambrian Sci. Corp. v. Cox Commc’ns, Inc.*, 79 F. Supp. 3d. 1111 (2015).

CREDIT: www.scotusblog.com



Rudolph A. Telscher for petitioner (Art Lien)