

職務發明人獎勵報酬制度及其施行¹

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隨着中國《專利法》及其實施細則的第三次修改,中國的職務發明人獎勵報酬制度在獎勵支付主體、獎勵方式和獎勵數額方面均發生了重大的變化,引起了廣泛關注。本文結合中國現行法律規範的有關規定,嘗試分析外國單位因發明人獎勵糾紛被訴至中國法院後,法院在管轄的建立和法律的適用上的可能做法,並通過研究先前有關獎勵糾紛案例,介紹法院在獎勵支付主體和獎勵數額的確定以及當事人舉證責任的分配上所採用的判定方式。另外,文中也介紹了近年來外國出現的數起有重大影響的發明人獎勵糾紛案件,以供參考。

一、專利法及其實施細則關於職務發明人獎勵報酬的規定

2009年10月1日開始施行的《專利法》(以下簡稱“新專利法”)第16條對於中國的發明人獎勵制度作出了一般性的規定:“被授予專利權的單位應當對職務發明創造的發明人或者設計人給予獎勵;發明創造專利實施後,根據其推廣應用的範圍和取得的經濟效益,對發明人或者設計人給予合理的報酬。”

2010年2月1日開始施行的《專利法實施細則》(以下簡稱“新實施細則”)第76-78條對於發明人獎勵制度作了更具體的規定:

第76條 被授予專利權的單位可以與發明人、設計人約定或者在其依法制定的規章制度中規定專利法第十六條規定的獎勵的方式和數額。

企業、事業單位給予發明人或者設計人的獎勵,按照國家有關財務、會計制度的規定進行處理。

第77條 被授予專利權的單位未與發明人、設計人約定也未在其依法制定的規章制度中規定專利法第十六條規定的獎勵的方式和數額的,應當自專利權公告之日起3個月內發給發

明人或者設計人獎金。一項發明專利的獎金最低不少於3000元;一項實用新型專利或者外觀設計專利的獎金最低不少於1000元。

由於發明人或者設計人的建議被其所屬單位採納而完成的發明創造,被授予專利權的單位應當從優發給獎金。

第78條 被授予專利權的單位未與發明人、設計人約定也未在其依法制定的規章制度中規定專利法第十六條規定的報酬的方式和數額的,在專利權有效期限內,實施發明創造專利後,每年應當從實施該項發明或者實用新型專利的營業利潤中提取不低於2%或者從實施該項外觀設計專利的營業利潤中提取不低於0.2%,作為報酬給予發明人或者設計人,或者參照上述比例,給予發明人或者設計人一次性報酬;被授予專利權的單位許可其他單位或者個人實施其專利的,應當從收取的使用費中提取不低於10%,作為報酬給予發明人或者設計人。

二、新實施細則中值得注意的要點

對比修訂前,新實施細則對於獎勵支付主體的範圍作了較大擴張,由僅適用於國有企事業單位擴大到被授予專利權的單位;在職務發明獎勵的方式、數額上,不僅法律規定了一般的數額下限,還同時允許單位與職務發明人之間通過合同約定、或通過其內部規章制度確定獎勵的方式、數額,這種做法保證了職務發明人所應享有的基本經濟權益,也從一定程度上促使單位積極地通過簽訂事前協議和完善內部規章等方式維護自身利益,規避可能出現的被訴求償付高額獎勵的風險。具體來說,新實施細則有以下幾個值得注意的要點。

1. 獎勵支付主體

舊實施細則關於職務發明獎勵的規定適用於國有企事業單位,對中國其他單位僅為“可參照執行”,而未提及外國單位。

新實施細則規定發明人獎酬支付主體為被授予中國專利權的單位,但新專利法及其實施細則在條文中對“單位”的國籍、所有制形式均未作特別限定。

在新專利法及其實施細則頒佈後,多數觀點認為:新法中規定的“被授予專利權的單位”是指依照中國法律在中國設立的企業、事業單位,包括國有企業、集體企業、私營企業、“三資企業”等。這一觀點符合“鼓勵自主創新、提高國際競爭力”的立法宗旨。而按照一般的理解,《專利法》及其實施細則屬於國內法並不具有域外效力,在中國被授予專利權的外國單位並不負有依據中國法向其本國發明人發放獎酬的義務。

但是,從字義上分析,新法有關獎酬支付主體的“被授予專利權的單位”並未直接排除對“外國單位”的適用。而且,在需要明確國籍的情況下,《專利法》的條文以“中國單位”的表述加以具體區分²。但在涉及發明人獎酬支付主體的規定中,未明確“被授予專利權的單位”的國籍,意味着在中國申請並被授予專利權的中國單位和外國單位均納入到獎酬支付的主體範圍。而通過對有關立法參與者觀點³的解讀也很難確定獎酬支付的主體是否包括外國單位。但可以設想的是,隨着新《專利法》及其實施細則的實施,外國單位,尤其是在中外合作開發、委託開發或技術轉讓中其發明創造在中國申請並獲得專利的外國單位,因發明人獎酬糾紛被訴至中國法院的情況將有可能發生。如果將來出現了以在中國取得專利授權的外國單位為被告的職務發明獎酬案件,則在解決糾紛時會遇到較複雜的局面。

在法院管轄問題上,依據中國《民事訴訟法》的一般性規定,案件的地域管轄以被告所在地法院為原則,以原告所在地、權利義務履行地法院為例外;對於專利案件的級別管轄,也以中級法院受理作為一般性規定。對於特殊的涉外案件,《民事訴訟法》第241條規定了法院管轄的基本原則,即“因……其他財產權益糾紛,對在中華人民共和國領域內沒有住所的被告提起的訴訟,如果……訴訟標的物在中華人民共和國領域內,或者被告在中華人民共和國領域內有可供扣押的財產,或者被告在中華人民共和國領域內設有代表機構,可以由……訴訟標的物所在地、可供扣押財產所在地、侵權行為地或者代表機構住所地人民法院管轄。”參照這一規定,對於在中國設立了代表機構或存在財產的外國單位,即可以其財產所在地、代表機構住所

地法院作為管轄法院受理職務發明獎酬糾紛。而對於在中國既無其他財產亦未設立代表機構的外國單位,因為實務中存在着將專利權作為財產予以扣押的做法,是否可以依據上述“可供扣押財產所在地”的規定,或參照專利權屬糾紛和發明人資格糾紛管轄的規定,以國家知識產權局所在地的中級法院即北京市第一中級人民法院作為管轄法院提起職務發明獎酬糾紛訴訟,有待今後司法實踐的澄清。

在法律適用問題上,將於2011年4月1日生效的《中華人民共和國涉外民事關係法律適用法》對於涉外的知識產權的歸屬、內容、轉讓、許可、侵權五類糾紛的法律適用問題作了具體規定,但並未涉及職務發明獎酬糾紛。如果在中國沒有住所地的當事人被訴至中國法院,在處理此類涉外職務發明糾紛時,需要法院根據具體案情運用衝突法規範發現法律和解釋法律,並將發現的法律及其解釋最終適用於案件的審理,此時存在運用衝突法規範發現並適用外國法律的可能。當然對於糾紛中,在認定權利效力、內容等只涉及專利權本身的問題時,則自然應直接適用中國《專利法》的規定,這也符合有關地方性司法審判指導意見的觀點⁴。

2. 獎酬的確定方式、數額

(1) 法定模式

關於獎酬的確定方式和數額,新實施細則規定,被授予專利權的單位可以與職務發明人約定或者在規章制度中規定職務發明獎酬的方式和數額。對於當事人未約定或在規章制度中未作出規定的,獎酬的數額則需按照法定標準,即發明專利獎勵為每項不少於3000元,實用新型專利或者外觀設計專利每項獎勵不少於1000元;對於報酬,規定為每年從實施發明、實用新型的營業利潤中提取不低於2%,或者從實施該項外觀設計專利的營業利潤中提取不低於0.2%,作為報酬給予發明人或者設計人,或者參照上述比例,給予發明人或者設計人一次性報酬;被授予專利權的單位許可他人實施專利,應當從收取的許可費中提取不低於10%,作為報酬給予職務發明人。

(2) 合同約定模式

新實施細則允許單位與職務發明人約定獎酬的方式和數額。根據該規定,被授予中國專利權的單位可以依法與職務發明人在職務發明創造完成之前或者之後明確約定獎酬的方式

和數額；如果沒有約定或者約定不明確（其應包括明顯違反合同締結地或當事人選擇法律的禁止性規範或者顯失公平的約定），則會導致上述法定模式的適用。在專利技術得以實際應用的情況下，法定模式的獎酬數額往往要比當事人約定的數額更大些，更傾向發明人。所以，單位可利用約定優先的機制，事先達成對獎酬的合法、合理約定。

（3）“依法”制定的規章制度模式

對於新實施細則第 77、78 條規定的以規章制度確定獎酬方式、數額的模式，以單位需“依法”制定規章制度為適用前提。依此理解，如果規章制度違法則存在不能適用規章制度而直接適用法定模式的可能。由於規章制度通常由雇主依據其所在地法制定，在是否“依法”的判斷標準上，對於中國單位，其規章制度的內容、制定程序應當符合例如合同法、勞動法的規定；對於外國單位，其規章制度則可參照其所在國法律認定。

總的來講，由於民事法律關係以當事人意思自治為基礎，當事人最好能夠事先通過合同約定、訂立規章制度的方式對職務發明的重要事項作好總體的設計，對獎酬的方式、數額、糾紛解決方式等進行合法、合理的設定。

三、對兩例中國職務發明人獎勵報酬案件的分析

如前所述，修改之前的《專利法》及其實施細則僅將支付獎酬的主體限定為被授予專利權的國有企事業單位。在現實中，許多地方政府以鼓勵專利申請為目的以地方條例、意見⁵等形式頒佈了一些規範性文件，對本區域內的發明人獎酬的方式、數額作出規定、指導，其獎酬數額大多比法定標準高，也允許當事人自行約定獎酬方式。在實踐中，受多種因素的影響，發明人獎酬糾紛被訴至法院的數量並不多。通過對“北大法實數據庫”⁶的檢索發現，在新《專利法》及其實施細則生效之前，已公佈的中國法院有關職務發明人獎酬的案例均為中國公民身份的職務發明人起訴中國單位的案件。這些案例中糾紛產生的原因多為當事人事先未對獎酬發放的方式、數額通過合同、規章制度予以規定，或約定不明。對當事人就獎酬事宜事先有約定的情形下，在檢索發現的案件中，法院對該類合同均給予了尊重。在

這類案件中，職務發明人勝訴的佔大多數，但平均賠償數額偏低。

1. 翁立克與上海浦東伊維燃油噴射有限公司（簡稱“伊維公司”）、上海柴油機股份有限公司（簡稱“上柴公司”）職務發明人報酬糾紛案⁷

原告翁立克長期擔任伊維公司的總工程師，2005年3月退休，上柴公司是伊維公司的股東之一，其出資佔伊維公司註冊資本的90%。2001年4月，上柴公司申請兩項涉及噴油泵設備的實用新型專利並獲授權，專利證書上所列設計人均為翁立克。2003年9月，兩項專利權被無償轉讓給伊維公司。2003年11月，伊維公司將兩項專利許可給上海電裝燃油噴射有限公司（簡稱“電裝公司”）。電裝公司作為被許可方已向伊維公司支付了約定的入門費以及2003-2007年度的技術提成費。翁立克退休後將兩被告訴至法院，請求支付報酬數額為人民幣200萬元。一審法院判定伊維公司從實施兩項專利而收取的許可費中提取人民幣27萬餘元作為報酬支付給原告翁立克。二審法院維持了一審判決。

本案中值得關注的問題有兩個：一是在專利權發生轉讓後如何確定應當向發明人支付獎酬的“被授予專利權的單位”、原專利權人是否應當承擔連帶責任，二是法院在計算職務發明人獎酬時會考慮哪些因素。

（1）關於原專利權人是否應當承擔連帶責任。本案中上柴公司是持有伊維公司90%股份的母公司，也是原專利權人，而原告翁立克做出涉案職務發明時是伊維公司的雇員。翁立克向法院起訴時要求伊維公司與上柴公司承擔連帶責任。對於該項訴訟請求，一審法院基於以下兩點考慮，其一，涉案職務發明創造是原告在伊維公司任職期間完成，而上柴公司與伊維公司簽訂的專利無償轉讓協議實質是解決專利權的實際歸屬問題；其二，在後續實施專利過程中，許可人及許可費的收取方都是伊維公司，認定伊維公司是唯一應支付獎酬的單位，而上柴公司無需承擔連帶責任。二審法院對此予以了確認。

本文中職務發明人請求母子公司承擔連帶責任，對這一訴訟請求的判決所引申出的問題是：如果上柴公司作為母公司無償取得專利申請權，獲得授權後以該專利權為基礎對外簽訂技術許可協議並獲益，此時原告能否向上柴公司主張報酬？在這

種情況下,做出職務發明的雇員受雇於子公司,而專利權人以及實際獲益的主體卻是母公司。有學者認為,對於單位無償向母公司或子公司轉移技術的,由於轉移雙方存在關聯關係,職務發明創造的發明人、設計人可以向本單位或者獲得、實施該專利的關聯母子公司提出享有獎勵或報酬的權利。⁸這就涉及對《專利法》第16條的解釋——職務發明人的獎勵請求是否以請求人與被請求人之間存在雇傭關係為要件?發明人獎勵請求權的實現是否可以在此類情況下作出特殊的安排?

另一種更為複雜情況的情況是,當上柴公司與伊維公司訂立了技術開發合同:上柴公司向伊維公司支付一定費用,委託伊維公司進行技術開發,並約定開發出的技術成果的申請專利的權利歸上柴公司享有,此後原告作為伊維公司的雇員接受了此項工作任務並完成了職務發明創造。這種情況下,原告可以根據《合同法》第326條的規定⁹請求伊維公司支付獎勵或報酬,但《合同法》條文中對於獎勵或報酬的支付使用了表示選擇關係的“或”;這與《專利法》規定的在專利授權後支付獎勵,在專利實施後支付報酬是否完全對應並不明確。

(2)法院在計算職務發明獎勵時會考慮哪些因素。該案審判所依據的舊實施細則第76條規定,“被授予專利權的國有企業事業單位許可其他單位或者個人實施其專利的,應當從許可實施該項專利收取的使用費納稅後提取不低於10%作為報酬支付發明人或者設計人。”基於伊維公司與電裝公司簽訂的專利許可協議以及本案的其他情況,一審法院將計算報酬的時間段、基數和提取比例作為確定獎勵數額的計算因素。

關於計算報酬的時間段,原告翁立克主張自涉案專利被許可實施開始至2007年4月的報酬。對此,法院認為,涉案兩項專利權已於2005年12月被宣告無效,原告只能要求被告伊維公司支付專利權被宣告無效前基於專利許可使用費而應提取的相應報酬。

關於基數,法院依據專利許可協議相關條款及司法鑒定機構的鑒定結論認為,專利產品在伊維公司收取的總許可費中所佔比重為70%左右(其餘30%為管理體系所佔比例),並計算了兩項專利在產品中的貢獻率。因此,獎勵的計算基數應為被告收取許可費的稅後數額乘以70%,再乘以專利在產品中的技術貢獻率。

關於提取比例,舊實施細則確定的最低比例為10%,而法院注意到,原告提起本案訴訟不久,被許可人電裝公司即向專利複審委員會請求宣告涉案專利權無效,且所依據的證據由本案兩被告持有。法院認為,從被告伊維公司在收到無效宣告請求審查決定後3個月內未能採取有效措施挽救專利權的消極行為來看,無效宣告事實的發生顯然事出有因,其後果直接導致原告根據涉案專利在專利權期限屆滿之前繼續被推廣應用所產生的經濟效益而主張報酬的權利行使不能,因此,法院將提取比例調高至30%。

2、朱瑞震與東莞威霸清潔器材有限公司(簡稱“威霸公司”)職務發明報酬糾紛案¹⁰

原告朱瑞震於1998年7月進入威霸公司工作,並曾擔任該公司工程部經理。2006年2月朱瑞震辭職離開威霸公司,其在職期間參與發明設計的16項成果被分別授予8項實用新型專利和8項外觀設計專利,朱瑞震作為共同發明人、設計人在該16項專利上署名。在本案中,朱瑞震向法院提供了威霸公司網站宣傳資料、產品宣傳冊、實用新型和外觀設計技術資料圖片等證據,證明威霸公司實施了涉案專利,同時提交了該公司2004年度年檢報告書,主張以威霸公司2004年度稅後利潤總額1454.71萬元作為計算職務發明創造發明人、設計人報酬的稅後利潤,並根據《民法通則》有關訴訟時效的規定要求向前推算兩年作為支付年限。一審法院認定威霸公司實施了7項涉案外觀設計專利,且威霸公司在實施專利後未能向朱瑞震支付合理報酬,因此判決威霸公司應支付朱瑞震職務發明報酬人民幣101829.7元(稅後利潤14547100元 \times 0.2% \times 7項外觀設計專利 \times 2年 \div 4人=101829.7元),二審法院確認了一審法院查明的事實並維持了一審判決。

本案的關鍵在於以下三個舉證問題:

(1)威霸公司是否實施了涉案專利。本案中,原告朱瑞震提交的證據包括網站產品展示資料、產品宣傳冊、實用新型和外觀設計技術資料圖片,被告威霸公司對這些證據的真實性沒有異議。法院將以上證據中相關圖片進行比對,認定被告實施了涉案16項專利中的7項外觀設計專利。被告威霸公司對7項外觀設計專利的實施情況和事實予以否認,但是未能提供有效證據進行反駁。

(2)威霸公司是否已經向朱瑞震支付了報酬。法院認為應當由威霸公司對此承擔舉證責任。儘管威霸公司主張原告朱瑞震離職時已經向其支付了10萬元經濟補償，並認為該筆經濟補償已涵蓋了職務發明報酬。但是法院認為，威霸公司提交的收據和匯款憑證上並無說明其支付給朱瑞震的10萬元離職經濟補償中包括職務發明報酬，無法證明該款項的性質，因此，認定威霸公司未向朱瑞震支付合理的職務發明報酬。

(3)威霸公司實施涉案專利的稅後利潤是多少。對於朱瑞震參照威霸公司2004年度年檢報告主張實施專利一年的稅後盈利總額為1454.71萬元，威霸公司認為，原告以企業整體盈利為基礎計算實施專利所獲稅後利潤的做法缺乏事實和法律依據。一審法院認為，被告威霸公司作為實際生產銷售主體，自主掌握產品的生產銷售情況，故威霸公司應當承擔證明專利產品所獲稅後利潤的舉證責任，威霸公司對此不舉證則應承擔舉證不能的後果。一審法院根據《最高人民法院關於民事訴訟證據的若干規定》第75條¹¹，對朱瑞震以人民幣1454.71萬元作為專利產品稅後利潤計算職務發明報酬的主張予以支持。二審法院認為，這一計算方法雖然不符合有關行政法規的規定，但在被告舉證不能也無其他數據可供法院參考的情況下，根據《民法通則》第4條規定的公平原則，一審判決威霸公司支付朱瑞震10萬元的數額尚屬合理，因此對一審判決結果予以維持。

從本案對幾個重要爭議問題的舉證責任分配來看，一旦發生職務發明報酬糾紛，雇主將承擔更多的證明責任。因此，雇主應當在單位內部建立完善的職務發明獎酬制度，積極履行法定義務，以避免訴訟的發生。特別注意的是，雇主不僅應當與雇員約定合理的獎勵與報酬，更應當注意保存相關證據，以便在發生訴訟時支持相關主張。同時，值得注意的是，本案中在被告不舉證的情況下，法院引用《最高人民法院關於民事訴訟證據的若干規定》，將原告所舉有效證據中被告的年度稅後盈利總額推定為其實施專利的稅後利潤。

四、近年來其他國家和地區 職務發明獎酬制度變化及案例

1. 日本

日本的中村修二“藍色發光二極管”職務報酬訴訟案對職務發明報酬的確定產生重大影響。

中村修二曾是日本日亞化學工業公司(簡稱“日亞公司”)的半導體發光元件研發人員,1990年在日亞公司完成了有關藍色發光二極管技術的發明;1993年在該技術的基礎上研發了具有突破意義的雙重異型結構的藍色發光二極管,解決了電子屏幕等設備無法顯示全部色彩的技術問題,使電子屏幕顯示出豐富的色彩,擁有更長的使用壽命,同時降低電力消耗約90%。中村修二的發明由其雇主日亞公司申請專利並獲得授權。日亞公司於1993年起開始實施中村修二職務發明的技術,並獲得了巨額利潤,但中村修二所得的報酬數額較少。2001年8月,中村修二向東京地方法院起訴,要求法院確認其在日亞化學公司所完成的有關藍色發光二極管的發明是非職務發明,要求追加其為共同專利權人以分享專利所得經濟收益。另外,中村修二還提出,如果法院認定上述發明屬於職務發明,則應當根據日本特許法的規定,判決日亞公司支付合理報酬200億日元(約1.8億美元)。

根據當時日本特許法第35(1)條的規定,雇員應就職務發明獲得“相當對價”。法院認為計算“相當對價”(報酬)時應考慮“專利壟斷帶來的利益”和“該技術開發階段公司和發明人的貢獻大小”。法庭對涉案技術的價值評估為:自專利實際實施至權利保護期屆滿,在該領域佔壟斷地位の日亞公司銷售總額將達到12085億日元(約110億美元)。另外,其他公司從日亞公司獲得專利使用許可之後,日亞公司得到的專利使用許可費約合1208億日元(約11億美元)。因此,法院在認定該發明屬於職務發明的基礎上,認為報酬的計算應當綜合考慮“日亞公司與發明者在發明階段所作貢獻的程度”,日亞公司只是提供了發明所需設備的費用3億日元以及中村修二赴美留學的費用等;而中村修二“身處小企業,在艱苦的研發環境下,卻依靠個人能力,完成了先進的發明”,因此,法庭認定他在此發明中作出了50%的貢獻,判決中村修二就該職務發明應得的報酬為604億日元。但由於中村修二的訴求僅僅是200億日元,根據“請求原則”判決日亞公司支付200億日元的職務發明報酬。日亞公司認為一審判決數額過高,向東京高等法院提出上訴。2005年,雙方最終在法院主持下達成了和解,由日亞公司向中村修二支

付共計 8.4 億日元(約 767 萬美元)的發明補償金。

“藍色發光二極管”案在日本及世界範圍內都引起了極大的關注,可以說正是此案使人們意識到曾被長期忽視的職務發明人獎酬機制的重要性。在日本國內,在此案的影響下,日本特許法有關發明人獎酬的規定也進行了修改¹²。原有的日本特許法第 35 條中規定的對於職務發明,雇員應獲得“相當對價”。很多企業對於日本特許法中“相當對價”一詞該如何理解感到困惑,要求立法機關能夠通過修改法律作出明確限定,以減少對於技術研發投資的不確定性。修改後的日本特許法仍然使用“相當對價”一詞,但通過增加條款予以進一步限定。現行日本特許法第 35 條第 4 款規定,以契約、工作規則或其他規定訂立……相當對價時,應考慮到下列的因素:訂立相當對價之標準時雇用人等和受雇者等之協商之狀況、已訂立標準之公開狀況、決定具體報酬金額時徵求受雇人等意見之狀況等。依已訂立標準計算出來之相當對價金額,不得被認為不合理;第 5 款,沒有前款所稱有關對價之約定或從其約定認定相當對價為不合理時,……對價之數額、應考慮該發明使雇用人等取得利益之數額、對於造成該發明雇用人等之負擔、貢獻等內容及受雇人等之待遇等其他因素而定之。即首先判定企業制定的報酬標準是否合理,如不合理則須依照法定標準確定。

2. 英國

英國專利法規定了法院評估雇主支付合理報酬給職務發明人的要件,使職務發明人在雇主因其發明獲得商業上成功後,可以按比例取得報酬金。英國 1977 年專利法 40(1)條規定,根據雇員提出的一項申請,法院認為該雇員所做的已獲授權專利的發明是屬於雇主的,此專利(關係到雇主事業的大小和性質)對雇主具有顯著的收益,則可以根據這個理由認定雇主應向雇員付給報酬。在 2005 年的修改中將對雇主具有顯著的收益的專利申請也納入職務發明人可取得報酬的範圍。對於雇主和雇員雙方就報酬進行約定的情形,該法進一步規定,法院認為雇員從轉授或贈授合同(即雇員將其職務發明轉讓與雇主的合同)或任何的補充合同中獲得的利益與雇主從此專利中獲得的利益相比是不夠的,或者在補充合同中規定給予的利益之外,根據其他理由雇主還應付雇員報酬,此時法院或專利局局長可判給付補充報酬。就報酬的數額,英國專利法 41(1)條

進一步規定,為雇員的發明專利給予其報酬時,凡雇主從該專利取得利益,或可望取得利益,或因雇主有關係的人通過轉讓、轉授接受該發明的產權或其他權利,或該專利申請案的產權,或該申請案中的直、間接權利而使雇主獲益,或可望使他取得利益,則應使雇員從雇主所得利益或可望取得的利益中取得合理的份額。通過以上條文,英國構建了職務發明人報酬制度的法律基礎。

2009 年 2 月 11 日,英國高等法院針對 Kelly and Chui v. GE Healthcare Limited 一案¹³,判決 GE Healthcare 公司(雇主)應將該公司因其 MYOVIEW(Tc99m 替曲膦注射液)專利所獲利益共 5000 萬英鎊的 3%,即 150 萬英鎊支付給發明人。本案是英國法院首次判決雇主向職務發明人支付報酬,且數額較高,其判決理由可歸納為:原告是專利技術的職務發明人;職務發明人已舉證其發明使雇主獲得極為顯著且非屬平常的利益;職務發明人所發明的專利,是雇主獲利的原因之一,但不是其獲利的唯一原因;如雇主亦因其他原因而獲利,將影響受雇人能向雇主取得的報酬數額;法院因此綜合考慮職務發明人對該發明的貢獻度、參與該發明的其他人的技術協助與付出、雇主本身對於涉案發明的貢獻度諸因素,判定雇主給予發明人合理公平的補償比例為 3%。對於英國專利法中“顯著的收益”的理解,本案主審法官認為,“顯著的”意味着特別的、超乎尋常的,因此“顯著的收益”應當是超出人們通常可以預期的收益,其數額應當遠高於雇主所付給發明人的薪水相對應工作所產生發明的經濟收益。

3. 法國

法國的職務發明獎酬制度較注重保護職務發明人的權益,法國知識產權法典 L 611-7 條規定,工作合同中明確規定了雇員的發明職責,則雇員在履行此工作合同過程中作出的相應發明屬於職務發明,歸雇主所有。雇員可得到補充報酬,根據集體合同、企業規定和個人工作合同的約定或者依雇員月工資的 1-3 倍確定。法國也曾出現過高額職務發明報酬的案件,在 2000 年曾出現作為雇主的一件抗癌藥物職務發明的所有人被法院判令依據專利實施後所獲收益的比例向發明人支付補充報酬 400 萬法郎(約 83 萬美元)¹⁴。在 2005 年判決的另一案件中,發明人 Ray 在職期間就其一項藥品職務發明僅獲得了雇

主 6631 歐元的報酬。離職後, Ray 將前雇主訴至法院, 請求高額報酬。巴黎高等法院認定 Ray 對於涉案發明的貢獻度為 70%, 進而判決前雇主支付補充報酬 60 萬歐元。前雇主上訴後, 巴黎上訴法院最終判決的補充報酬數額為 30 萬歐元。在判決中, 巴黎上訴法院認為, 對於補充報酬的計算應當綜合考慮發明產生的經濟利益、實現發明的難度和發明人的貢獻度等多種因素。

4. 美國

在美國的專利制度中, 發明人的權益得到特殊的保護, 實行“發明歸屬於發明人本人所有的原則”, 除了事先約定發明歸雇主所有或雇傭目的是專門為了從事發明之外, 原則上職務發明的所有權歸屬於發明人。申請職務發明專利, 也必須以雇員的名義申請, 授權後再轉讓給雇主。根據這一原則, 同時受到合同自由理念的影響, 絕大多數美國公司都會很重視與雇員事先約定發明的歸屬權, 制定詳細、繁雜的合同, 強調雇傭的目的是專門從事發明。總體來看, 美國職務發明獎酬的數額並不高, 通常會事先約定為每件專利幾千美元, 因為雇主會認為其支付給雇員的日常工資應當足以滿足職務發明獎酬的需要。

結語

新《專利法》及其實施細則關於職務發明人獎酬制度的規定已經生效, 在中國獲得專利權的單位有義務向發明人支付獎酬; 獎酬的支付方式、數額可以通過合同約定, 或通過其內部規章制度規定, 否則依照法律規定的數額支付。雖然先前中國法院作出裁判的發明人獎酬案件數量不多, 獎酬數額也不高, 但由於受到鼓勵發明創造、加強保護發明人權益的立法指引, 以及國外出現一些“高數額”報酬案件的影響, 可以預見未來此類案件的數量和獎酬數額會有所增加。值得注意的是, 同處東亞的日本, 自“藍色發光二極管”案後, 研發人員在離職、退休後對任職期間產生的發明報酬提起訴訟的情況增多, 這種趨勢對於在中國申請專利的企業應當有所警示。

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¹ 如無特別註明, 本文中的“職務發明人”均指“職務發明創造的發明人或者設計人”。

² 例如, 新《專利法》第 45 條規定的可提起專利無效宣告請求的主體為“任何單位或者個人”, 第 19 條有關“中國單位或者個人在國內申請專利……, 可以委託……專利代理機構”的規定等。

³ 見國務院法制辦教科文衛司副司長劉曉霞在國新辦就專利法實施細則修改有關情況舉行的新聞發佈會上的講話: “獎勵報酬標準的適用範圍, 由原來的僅適用於國有企業單位, 擴大到所有的單位, 包括了所有企業類型”, http://www.chinataiwan.org/xwzx/xwfbh/gxbxwfbh/201002/t20100204_1247816.htm, 2010 年 11 月 30 日最後訪問。

⁴ 2004 年《北京市高級人民法院關於涉外知識產權民事案件法律適用若干問題的解答》中規定: “審理外國人主張我國專利權、商標權、著作權的民事案件, 僅涉及專利權、商標權、著作權問題的, 應適用我國相關法律, 不存在適用外國法律的可能, 故無需引用衝突規範。”

⁵ 如《北京市專利管理保護和促進條例》、上海市《關於進一步加強本市知識產權工作的若干意見》。

⁶ 北大法寶數據庫: <http://vip.chinalawinfo.com/case/>, 2010 年 11 月 21 日最後訪問。

⁷ 詳見上海市第一中級人民法院(2005)滬一中民五(知)初字第 220 民事判決書以及上海市高級人民法院(2008)滬高民三(知)終字第 23 號民事判決書。

⁸ 詳見陶鑫良主持的上海大學知識產權學院研究報告: “專利申請權與專利權歸屬及職務發明創造完成人獎酬制度”, 摘自《<專利法>及<專利法實施細則>第三次修改專題研究報告》(中卷), 國家知識產權局條法司編, 知識產權出版社, 2006 年 4 月第一版, 928 頁。

⁹ 《合同法》第 326(1)條: 職務技術成果的使用權、轉讓權屬於法人或者其他組織的, 法人或者其他組織可以就該項職務技術成果訂立技術合同。法人或其他組織應當從使用和轉讓該項職務技術成果所取得的收益中提取一定比例, 對完成該項職務技術成果的個人給予獎勵或報酬。法人或者其他組織訂立技術合同轉讓職務技術成果時, 職務技術成果的完成人享有以同等條件優先受讓的權利。

¹⁰ 詳見廣東省東莞市中級人民法院(2006)東中法民三初字第 33 號民事判決書, 以及廣東省高級人民法院(2007)粵高法民三終字第 229 號民事判決書。

System of Reward and Remuneration for Service Inventors and Implementation Thereof

Legal Affairs Department of China Patent Agent (H. K.) Ltd.

The third amendment to the Patent Law and the Implementing Regulations of the Patent Law has brought about great changes with regard to entities liable for paying reward and remuneration, manner and amount of reward and remuneration within the framework of the system of reward and remuneration for service inventors¹ in China, which has drawn wide attention. This article is meant to present a tentative analysis, on the basis of the current laws and regulations in China, of the possible practice of the courts in establishing jurisdiction and application of law when foreign entities are sued in the courts in China for disputes over service inventors' reward and remuneration, and, through case study, give an account of the ways courts make their decisions in relation to determination of entities liable for paying reward and remuneration and the amount of reward and remuneration to be paid and distribution of burden of proof to the parties. In addition, as a reference, an overview is given of the several lawsuits of great impact directed to disputes over reward and remuneration for inventors in foreign nations in the recent years.

I. Provisions concerning reward and remuneration for service inventors as set forth in the Patent Law and Implementing Regulations of the Patent Law

In Article 16 of the Patent Law as of 2009 (the new Patent Law) has been set forth the general provision on the system of reward and remuneration for inventors that "the entity that is granted a patent right shall award to the inventor or creator of a service invention-creation a reward and, upon exploitation of the patented invention-creation, shall pay the inventor or creator a reasonable remuneration on the basis of the extent of spreading and application and the economic benefits yielded".

Rules 76-78 of the Implementing Regulations of the Patent Law as of 2010 (the new Implementing Regulations) have spelt out more specific provisions regarding the system.

Rule 76: "The entity to which a patent right is granted may, on the manner and amount of the reward and remuneration as prescribed in Article 16 of the Patent Law, enter into a contract with the inventor or creator, or provide it in its rules and regulations formulated in accordance with the laws.

The reward and remuneration awarded to the inventor or creator by any enterprise or institution shall be handled in accordance with the relevant provisions of the State on financial and accounting systems."

Rule 77: "Where the entity to which a patent right is granted has not entered into a contract with the inventor or creator on the manner and amount of the reward as prescribed in Article 16 of the Patent Law, nor has the entity pro-

¹¹ 《最高人民法院關於民事訴訟證據的若干規定》第 75 條：有證據證明一方當事人持有證據無正當理由拒不提供，如果對方當事人主張該證據的內容不利於證據持有人，可以推定該主張成立。

¹² Japan Patent Office: "The Case Studies of the Procedures under the New Employee Invention System", <http://www.jpo.go.jp/index.htm>, 2010 年 11 月 21 日最後訪問。

¹³ James Duncan Kelly and Kwok Wai Chiu v GE Healthcare Limited, [2009] EWHC 181 (Pat) (Floyd J), 11 February 2009.

¹⁴ Hoechst Marion Roussel/Raynaud, La Cour de Cassation, Chambre Commerciale, November 21, 2000; Arrêt n° 2086. Rejet.; Pourvoi n° 98-11.900; and GRUR Int. 2001, 785.

vided for it in its rules and regulations formulated in accordance with the laws, it shall, within three months from the date of the announcement of the grant of the patent right, award to the inventor or creator of a service invention-creation a sum of money as prize. The sum of money as prize for a patent for invention shall not be less than RMB 3,000 yuan; the sum of money prize for a patent for utility model or design shall not be less than RMB 1,000 yuan.

Where an invention-creation is made on the basis of an inventor's or creator's proposal adopted by the entity to which he belongs, the entity to which a patent right is granted shall award to him a money prize on favorable terms."

Rule 78: "Where the entity to which a patent right is granted has not entered into a contract with the inventor or creator on the manner and amount of the remuneration as prescribed in Article 16 of the Patent law, nor has the entity provided for it in its rules and regulations in accordance with the laws, it shall, after exploiting the patent for invention-creation within the duration of the patent right, draw each year from the profits from exploitation of the invention or utility model a percentage of not less than 2%, or from the profits from exploitation of the design a percentage of not less than 0.2%, and award it to the inventor or creator as remuneration. The entity may, as an alternative, by making reference to the said percentage, award a lump sum of money to the inventor or creator as remuneration once and for all. Where any entity to which a patent right is granted authorises any other entity or individual to exploit its patent, it shall draw from the exploitation fee it receives a percentage of not less than 10% and award it to the inventor or creator as remuneration."

II. Major issues of the Implementing Regulations of the Patent Law that are worth our attention

Compared with the former Implementing Regulations of the Patent Law, the new Implementing Regulations have broadened the scope of entities to pay reward and remuneration from the former applicable state-owned enterprises to any entities that are granted the patent right; as for the manner and amount of reward and remuneration for service inventions, the new Implementing Regulations not only provide for the minimum amount, but also allow determination of the manner and amount of reward and remuneration through contracts between entities and service inventors or through

corporate rules and regulations, which ensures that service inventors may enjoy their basic economic rights and interests, and, to an extent, urges entities to safeguard their own rights and interests by virtue of conclusion of agreements in advance and improvement of their internal rules and regulations, and averts potential risks of claim for enormous reward or remuneration. To be specific, the new Implementing Regulations have these major issues that are worth our attention as follows.

1. Entities to pay reward and remuneration

Provisions of the former Implementing Regulations of the Patent Law concerning reward and remuneration for service inventions were applicable to state-owned entities, and could apply to other entities in China by way of reference, without mentioning foreign entities. The new Implementing Regulations provide that entities to pay reward and remuneration are entities which have been granted the Chinese patent rights, without specially defining the nationality and form of ownership of such entities.

After promulgation of the new Implementing Regulations, many believe that "the entity to which a patent right is granted" under the new Implementing Regulations refer to enterprises, institutions set up under the Chinese laws, including state-owned entities, enterprises of collective ownership, private businesses and the "three types of foreign funded (i.e. contractual joint ventures, cooperative ventures and solely foreign funded enterprises) enterprises". This view seems to conform to the legislative aim of "encouraging our own innovation and improving international competitiveness". Meanwhile, according to the general understanding, the Patent Law and its Implementing Regulations are domestic law and regulations having no extra-territorial force, and foreign entities granted the Chinese patent are not obliged to award or remunerate inventors of their own countries under the Chinese patent law and regulations.

However, literal analysis shows that the provision on entities having been granted the Chinese patent right that should pay reward and remuneration does not rule out its applicability to "foreign entities". Besides, where it is necessary to specify nationality, the Patent Law provisions make specific distinction using the expression of "Chinese entities" in other situations². But in the provision regarding entities for paying reward and remuneration for inventors is not specified the nationality of entities having been granted the Chinese patent right, which means that both the Chinese and foreign entities that file applications for and are granted the

patent right are entities that should pay reward or remuneration. Reading of the view of the relevant law makers³ does not make it easier to determine whether the entities for paying reward and remuneration also include foreign entities. It may be assumed, however, that, along with the implementation of the new Patent Law and its Implementing Regulations, foreign entities, especially those that have filed applications for, and been granted patents for the inventions-creations obtained from development of Chinese and foreign joint investment, commissioned development, or through technical transfer, are possible to be sued in the courts in China for disputes over reward or remuneration for inventors. In future lawsuit against foreign entities granted the patent right in China relating to service inventor reward or remuneration, complicated situation would occur during resolution of such dispute.

In terms of jurisdiction, under the general provisions of the Chinese Civil Procedure Law, the lawsuit is under the jurisdiction of the court of the place where the defendant is domiciled, with that of the place where the plaintiff is domiciled or the right or obligation is enforced as the exception. Jurisdiction over patent cases generally rests with the intermediate courts. As for special cases involving foreign parties, Article 241 of the Civil Procedure Law provides for the rudimental rules of jurisdiction, namely, "in the case of an action concerning ... other disputes over property rights and interests brought against a defendant who has no domicile within the territory of the People's Republic of China, if ... the object of the action is located within the territory of the People's Republic of China, or if the defendant has detainable property within the territory of the People's Republic of China, or if the defendant has its representative office within the territory of the People's Republic of China, the People's Court of the place where ... the object of the action is located, or where the defendant's detainable property is located, or where the infringements took place, or where the defendant's representative office is located, shall have jurisdiction". With reference to the provision, as for foreign entities setting up their representative office or having property in China, the courts of the place where it has their representative office or property have the jurisdiction over dispute over reward or remuneration for service inventors. As for those having no representative office, nor property in China, due to the practice of taking the patent right as property for detension, it is a matter worth in-depth theoretical exploration and further attention in practice that the intermediate court of the place

where the State Intellectual Property Office is located, namely the Beijing No.1 Intermediate People's court, is the forum to sue for dispute over reward or remuneration for service inventions according to the above provision that "where the defendant's detainable property is located" or with reference to the provision on jurisdiction over patent right ownership as well as inventorship dispute.

On the matter of application of law, the Law of the People's Republic of China on Application of Law Regarding Foreign-related Civil Relationship which will come into force on April 1, 2011 specifically provides for the issue of application of law to five categories of disputes over the ownership attribution, content, assignment, license and infringement of foreign-related IP rights, without mentioning disputes over reward and remuneration for service invention. If a party having no domicile in China is sued in a court in China, the court, when handling the dispute over service invention, needs to find out the law through conflicting rules and interpret it according to the specific circumstances, and finally apply the law found out and the interpretation thereof to the case; therefore, there is the possibility for finding out and applying the foreign laws by using conflict rules. Of course, when determination is made as to the issues that relate only to the patent right *per se*, such as the validity, content of the right, it is natural to directly apply the provisions of the Chinese Patent Law, a practice conforming to the view of the guiding opinions on local jurisdiction.⁴

2. Manner for determining reward and remuneration, and amount thereof

(1) Statutory mode

As for the manner for determining reward and remuneration, and the amount thereof, the new Implementing Regulations provide that "the entity to which a patent right is granted may enter into a contract with the inventor or creator on , or provide in its rules and regulations for the manner and amount of the reward or remuneration, and in the absence of such agreement, or rules and regulations to this effect, the amount of reward or remuneration needs to be determined according to the statutory standards, that is, the reward for an invention patent should not be less than RMB 3,000 Yuan, that for a utility model or design should not be less than RMB 1,000 Yuan; as for the remuneration, it is provided that an inventor or creator should be annually remunerated no less than 2% of the business profit made from exploitation of an invention, or utility model, or no less than 0.2% in case of design, or pays him a lump sum according to this standard;

where an entity to which a patent right is granted licenses the patent to another party, the service inventor should be remunerated no less than 10% of the royalties.

(2) Agreement

The new Implementing Regulations allow an entity and service inventor to conclude an agreement on the manner and amount of reward or remuneration. Under the provision, an entity granted a Chinese patent right may enter into an agreement with a service inventor before or after completion of a service invention on the specific manner of payment and amount of reward or remuneration; absence of such an agreement or in cases of unclear agreement (including agreements concluded against the provisions on place of conclusion and on selection of law and those that are obviously unfair), would result in the application of the statutory mode. Where a patented technology is put to practical use, the amount of the reward or remuneration of the statutory mode is usually larger than what has been agreed between parties in favour of the inventors. For that matter, the entity may use the mechanism of priority of agreement, and reach, beforehand, a legitimate, fair agreement on matter of reward and remuneration.

(3) Mode of internal regulations formulated under law

As Rules 77 and 78 of the new Implementing Regulations provide, the rules and regulations of an entity can be used for determining the manner and amount of reward or remuneration on the premise that the entity needs to formulate regulations in accordance with the laws. Accordingly, if its rules and regulations are contrary to the laws, it is possible that the rules and regulations are not applicable and the statutory mode has to be directly applied. Since the rules and regulations are formulated by an employer under the laws of the place where it is domiciled, any Chinese entity's rules and regulations and the procedure for formulating them should conform to the provisions of the laws, including the Contract Law and Labour Law; and a foreign entity's rules and regulations may be determined with reference to the laws of the country where it is domiciled.

In conclusion, since the civil legal relationship is based on the autonomous will of the parties, it is the best for the parties to be able to come up with a general arrangement with regard to the important matters of a service invention by way of prior agreement and regulations, and set, in a lawful and fair manner, the manner and amount of reward and remuneration, and the way for resolving disputes.

III. Analysis of two cases involving reward and remuneration for service inventors in China

As mentioned above, the former Patent Law and its Implementing Regulations merely limited the entities paying reward and remuneration to state-owned enterprises and institutions that had been granted the patent right. Besides, many local governments promulgated local regulations and opinions⁵ for the purpose of encouraging patent application, and formulated stipulations and gave guidance with regard to the manner and amount of reward and remuneration, with the amount of the prescribed reward and remuneration larger than that in the statutory standard and with the interested parties being allowed to conclude contract on the matter of reward and remuneration. Under the impact of the above and other factors, lawsuits filed by inventors in the courts for reward or remuneration dispute were not many. As the search of the website www.chinalawinfo.com⁶ shows, before the new Patent Law and its Implementing Regulations went into force, all the released lawsuits of the courts in China involving service inventors' reward and remuneration were those filed by service inventors of the Chinese nationals against Chinese entities because, in many of these disputes, the interested parties failed, in advance, to conclude contract or formulate rules on the manner and amount of reward and remuneration, or their agreements were not clear. In the presence of prior contracts between the interested parties on matters of reward and remuneration, the courts respected them as shown in the search of the cases. In such cases, most of the results were in favor of the inventors, but the average amount of compensation is rather low.

1. Weng Like v. Shanghai Pudong EV Fuel Injection Co., Ltd. (EV) and Shanghai Diesel Engine Co., Ltd. (SDE), a case of dispute over remuneration for the service inventor⁷

Weng Like, plaintiff, had long been General Engineer of EV, and was retired in March 2005. SDE was one of the share holders of EV, and its investment took up 90% of EV's registered capital. In April 2001, SDE filed two patent applications for the utility models of fuel injection pumps with, and was granted the patents by, the SIPO, with Weng Like indicated as the inventor on the Patent Certificates. In September 2003, the two patents were assigned to EV free. In November 2003, EV, licensed them to the Shanghai Dianzhuang Fuel Injection Co., Ltd. (SDFI), and the latter, as the licensee, paid

EV the agreed fee for using said patents and the royalties for the years from 2003 to 2007. After he was retired, Weng Like sued the two defendants in the court, claiming a remuneration at the amount of RMB two million yuan. The court at first instance ordered EV to pay Weng Like RMB 270,000 yuan out of the royalties it had received for exploiting the two patents in suit, and the court at second instance supported the decision.

There are two issues in the case that are worth our attention: one is, after the patents are assigned, how to determine “the entity having been granted the patent right” that should pay the inventor reward and remuneration, and whether the former patentee should be severally and jointly liable; and the other is what factors the court would consider in calculating the reward and remuneration due to the service inventor.

(1) As for whether the former patentee should be severally and jointly liable. In the case, SDE was the parent corporation holding 90% of EV's share, and former patentee. Weng Like was an employer of EV when he made the service inventions in suit. He requested EV and SDE to be severally and jointly liable when he filed the lawsuit in the court. The court at first instance made the decision that EV was the sole entity that should pay for the claimed reward or remuneration while SDE needed not to bear the several and joint liability based on the following two considerations. One, the said service invention was made by the plaintiff during his service to EV, and the free assignment concluded between SDE and EV was essentially to address the matter of ownership of the patents; two, during the follow-up exploitation of the patents, it was EV that was the licensor and the party to which the royalties were paid. It was then decided that EV was the sole entity that should pay for the claimed reward and remuneration, and SDE did not need to bear the several and joint liability. The court at second instance maintained the decision.

The decision on the service inventor's claim that both EV and SDE be severally and jointly liable triggered the issue that if SDE, as the parent corporation, obtained the right to file application for the patents free, and benefited from concluding a technology license with another party in connection with the patents after granting of the rights, was it possible for the plaintiff to claim reward and remuneration from it? Under this circumstance, the one making invention was employed by EV, a subsidiary corporation, and the entity that was the patentee and benefited from the license was the parent corporation. Some scholars believe that where an en-

tity assigns a technology to a parent or subsidiary corporation, since the two corporations were related to each other, the service inventor or creator was entitled to reward and remuneration from the entity or the related two corporations that had exploited the patent⁸. This involves the interpretation of Article 16 of the Patent Law: whether the service inventor's claim to reward and remuneration is based on the employment of the claimant and the respondent. Is it possible to make a special arrangement to satisfy the inventor's claim to the reward and remuneration under the above circumstance?

Another more complicated situation is: when SDE and EV concluded a technology development contract, the former paid some fees to the latter as commission for it to develop the technology, and they agreed that the right to apply for a patent for the technology developed was to be owned by the former. Later, the plaintiff, an employee of EV undertook the development and came up with the service invention. Under the circumstance, the plaintiff may, under Article 326 of the Contract Law⁹, claim reward or remuneration from EV. But in the provision of the Contract Law concerning payment of reward or remuneration is used the word “or”, and it is not clear whether the provision fully corresponds to the provision of the Patent Law on paying reward after grant of the patent right and remuneration after exploitation of the patent.

(2) What factors would the court consider in calculating the reward and remuneration? The case was heard under Rule 76 of the former Implementing Regulations of the Patent Law that “where any state-owned enterprise or institution to which a patent right is granted authorises any other entity or individual to exploit its patent, it shall draw from the profits it receives for exploitation of the said patent after taxation a percentage of not less than 10% and award it to the inventor or creator as remuneration.” According to the patent license concluded between EV and SDFI and other circumstances of the case, the court considered the time frame, base and percentage deducted for calculating remuneration as the factors for computing reward and remuneration.

As for the timeframe, the plaintiff argued that he should be remunerated from the time of execution of the patent license up to April 2007. Regarding this, the court took the view that the two patents in suit were invalidated in December 2005, so the patentee could only ask EV to pay him the corresponding remuneration based on the patent royalties before the invalidation of the patents.

As for the base: the court believed, according to the

patent license and the appraisal made by the judicial appraising organisation, that the patented products took up about 70% of all the royalties received by EV (the management system took up the remaining 30%), and calculated the rate of contribution the patents made in the products. Accordingly, the basic amount should be the after-tax amount the defendant received from the license royalties times 70%, and then multiplied by the rate of technical contribution of the patent to the products.

As for the percentage drawn, the former Implementing Regulations of the Patent Law specified that the minimum was 10%. But the court noted that soon after the plaintiff sued, SDFI, the licensee, requested the PRB to have invalidated the patents in suit, and the evidence on which the request was based was held by the two defendants. The court took the view that as EV failed to take effective measures to save the patents within three months after receipt of the PRB's invalidation decision, there were obviously reasons for the fact of invalidation to have arisen, and it directly made it impossible for the plaintiff to claim reward and remuneration from the economic benefits generated from the further spread and exploitation of the patents in suit before they expired. Hence, the court increased the percentage of the reward and remuneration to 30%.

2. Zhu Ruizhen v. Dongguan Viper Cleaning Equipment Co.,Ltd. (Viper), another case of a dispute over remuneration for service invention¹⁰

Zhu, the plaintiff, began to work for Viper in July 1998, and served as manager of its Engineering Department for a time. In February 2006, he left Viper. When he worked for Viper, he participated in R&D of 16 technical achievements, for which 8 utility model patents and 8 design patents were granted. Zhu signed his name on the 16 patents as a joint inventor or creator. In the case, Zhu presented to the court the evidence of material of advertisement on Viper's website, its product brochure, and technological data and photographs of the utility models and designs to show that Viper had exploited the patents. He also furnished Viper's 2004 Annual Inspection Report to claim that the Viper's after-tax profits of RMB 14.5471 million yuan in total in 2004 should be the profits on the basis of which to calculate the remuneration due to the service inventors and/or creators. He also asked that the remuneration should be calculated from two years earlier under the provision on limitation of action of the General Principles of the Civil Law. On the basis of the evidence from the plaintiff, the court at first instance decided that Viper had ex-

ploited 7 design patents in suit, and it failed to reasonably remunerate Zhu after its exploitation; hence it should pay Zhu RMB 101,829.7 yuan as remuneration (the after-tax profits of RMB 14.5471 million yuan times 0.2% times 7 design patents times 2 years and divided by 4 persons amount to RMB 101,829.7 yuan); the court at second instance confirmed the facts as ascertained by the former court, and upheld its decision.

There are three key issues as follows.

(1) Whether Viper exploited the patents in suit. In the case, the evidence from Zhu included material of advertisement on Viper's website, its product brochure, and photographs of the utility model and design technologies, and Viper raised no objection to the truthfulness of the evidence. The court compared the relevant photographs, and found that the defendant exploited 7 design patents of the 16 patents. Viper denied the exploitation of the 7 patents, without basing any rebuttal on effective evidence.

(2) Whether it remunerated Zhu for the service inventions. For the court, Viper should be under the burden of proof. While Viper said that it paid Zhu RMB 100,000 Yuan as economic compensation when he left, and said that the money had covered the remuneration due for the service inventions. But the receipt and evidence of remittance from Viper did not show that its payment to Zhu covered the remuneration due for the service inventions, nor prove the nature or purpose of the payment. Therefore, the court decided that Viper did not pay Zhu the reasonable the remuneration due for the service inventions.

(3) How much its after-tax profits made from the exploitation was. As regards Zhu's claim based on the Viper's 2004 Annual Inspection Report that the profits for the one-year exploitation of the patents amounted to RMB 14.5471 million yuan, Viper argued that it was not based on the facts and law for the plaintiff to have requested to calculate the after-tax benefits on the basis of the corporate's overall benefits. The court at first instance took the view that Viper, as a business of practical manufacture and sales, controlled all the production and sales of its various products; hence it should meet its burden to prove its after-tax profits from the patented products. It should bear the consequence of its failure to meet the burden of proof. The court supported Zhu's claim that the Viper's after-tax profits of RMB 14.5471 million yuan be the after-tax benefits on the basis of which to calculate the remuneration due for the service inventions under Article 75 of the Supreme People's Court's Several Provisions

Relating to Evidence in Civil Procedure¹¹. The court at second instance held that while the calculation was contrary to the relevant administrative regulations, in a case where the defendant could not present to the court any other evidence or date for its reference, under the fairness doctrine set forth in Article 4 of the General Principles of Civil Law, it was justifiable for the former court to have decided that Viper pay Zhu RMB 100,000 Yuan, and the court of appeal supported the decision.

As the distribution of burden of proof in connection with the important issues involved in the case shows, once a dispute arises over reward or remuneration for service invention, an employer will be under more burden of proof. For that matter, any employer should set up good internal or corporate system of reward and remuneration for service inventions, and be proactive in performing its statutory obligations, to avoid possible lawsuits. The matter requiring specially attention is that an employer should not only conclude an agreement with its employees on reasonable reward and remuneration, but also make efforts to keep relevant evidence to support its argument or defence when a lawsuit is brought. Meanwhile, it should be given attention to the fact that with the defendant's failure to produce evidence in the present case, the court presumed that all the annual after-tax profits shown in the plaintiff's valid evidence as the profits made from the exploitation of the patents in suit by citing the Supreme People's Court's Several Provisions Relating to Evidence in Civil Procedure.

IV. Changes in the system of reward and remuneration for service inventions and cases in recent years in other countries and regions

1. Japan

The lawsuit involving remuneration for Shuji Nakamura's service invention of blue light luminescent diode had important impact on the system of reward and remuneration for service inventions in Japan.

Shuji Nakamura used to work for Nichia Corporation as a technician. In 1990, Shuji Nakamura made the invention of technology of blue light luminescent diode when working for the Nichia Corporation; in 1993, he developed blue light luminescent diode of double heterotypic structure on the basis of it. Before that, there had existed the relevant technology of

red and green luminescent diodes; but without bluelight luminescent diode, it was impossible for electronic screen to display full colours. This was exactly the technical problem Shuji Nakamura had resolved, allowing richer colours to be displayed on electronic screen, making it more durable, and in the meantime lowering power consumption. Shuji Nakamura's employer applied for, and was granted, a patent for his invention. Nichia began to exploit the technology of Shuji Nakamura's service invention, and made enormous profits, but Shuji Nakamura was not remunerated much. In August 2001, Shuji Nakamura sued in a local court in Tokyo, requesting the court to determine that Nichia's bluelight luminescent diode invention made when working for the Nichia Corporation was a non-service invention and claiming that he should be added as a joint patentee to share more profits. Besides, Shuji Nakamura argued that if the court found that said invention was a service invention, it should then decide, under the Japanese Patent Law, that Nichia Corporation would pay him the reasonable amount of 20 billion Japanese yen (approximately 180 million US dollars).

Under Article 35 (1) of the Japanese Patent Law in force at the time, an employee was entitled to the "reasonable remuneration" for a service invention. For the court, the "reasonable remuneration" should be calculated with account taken of the benefits made from the monopoly of the patent and the contribution made by a business and inventor during the R&D of the technology. The court made the evaluation of the technology in suit that from the exploitation to expiration of the patent, Nichia, the market dominator, made its sales turnover of 1.2085 trillion Japanese yen (approximately 11 billion US dollars). Besides, after licensing the patent to other businesses, Nichia received the royalties amounting to 120.8 billion Japanese yen (approximately 1.1 billion US dollars). Accordingly, finding it a service invention, the court concluded that the remuneration should be calculated with full account taken of "the amount of contribution Nichia and the inventor made to the making of the invention". Nichia paid 300 million Japanese yen needed for the equipment for making the invention and paid for the tuition for Shuji Nakamura to study in the United States. But Shuji Nakamura, working for a small business in a very hard R&D condition, relied on his own capability to have made the advanced invention"; hence the court decided that he made 50% of the contribution to the making of the invention, and was entitled to 60.4 billion Japanese yen as remuneration. But, since Shuji Nakamura only claimed 20 billion Japanese yen, the court decid-

ed that Nichia pay him 20 billion Japanese yen as his remuneration for the service invention. Believing that the amount of remuneration was too much, Nichia appealed to the Tokyo High Court. In 2005, both parties settled their dispute before the court, and Nichia paid Shuji Nakamura 840 million Japanese yen (approximately 7.67 million US dollars) as the compensation for the invention.

The case drew great attention in Japan and in the world. It may well be said that it is exactly because of this case that people have begun to be aware of the importance of the long-disregarded service inventors' reward and remuneration system. In Japan, the provisions of the Japanese Patent Law on inventors' reward and remuneration were changed under the impact of the case¹². Under Article 35 of the former Japanese Patent Law, an employee was entitled to the reasonable remuneration for a service invention. Many a business has found the term "reasonable remuneration" confusing, and asked the legislators to clarify it through amendment of law, so as to make R&D investment a matter of less uncertainty. The term was still used in the amendment of Japanese Patent Law, with a paragraph added to further define it. Article 35, paragraph four, of the Japanese Patent Law provides that where the reasonable remuneration is specified in an agreement, employment regulation or any other stipulation, following factors should be considered: a negotiation between the employer, etc. and the employee, etc. had taken place in order to set standards for the determination of the said value, the set standards had been disclosed, the opinions of the employee, etc. on the calculation of the amount of the value had been received and any other relevant circumstances. The payment of reasonable remuneration in accordance with the said provision(s) shall not be considered unreasonable. Paragraph five: where no provision setting forth the reasonable remuneration as provided in the preceding paragraph exists, or where it is recognised under the preceding paragraph that the amount of the remuneration to be paid in accordance with the relevant provision (s) is unreasonable, the amount of the remuneration shall be determined by taking into consideration the amount of profit to be received by the employer, etc. from the invention, an employer's burden, contribution, and treatment of the employee, etc. and any other circumstances relating to the invention. That is, it is first to determine whether the reward and remuneration standards of a business are reasonable. If not, they should be set under the law.

2. United Kingdom

The UK Patent Act provides for the element that a court evaluates the reasonable remuneration due to an employee to enable a service inventor to be remunerated at a given rate once his invention is commercially successful. Article 40 (1) of the UK Patent Act as of 1977 provides that: "Where it appears to the court or the comptroller on an application made by an employee within the prescribed period that the employee has made an invention belonging to the employer for which a patent has been granted, that the patent is (having regard among other things to the size and nature of the employer's undertaking) of outstanding benefit to the employer and that by reason of those facts it is just that the employee should be awarded compensation to be paid by the employer". Under the amendment as of 2005, patent application with which an employer makes notable benefits falls within the scope of those from which service inventors are entitled to be remunerated. In the presence of agreement between them regarding the matter, the Act further provides that: "Where it appears to the court or the comptroller on an application made by an employee within the prescribed period that — (c) the benefit derived by the employee from the contract of assignment, assignation or grant or any ancillary contract ("the relevant contract") is inadequate in relation to the benefit derived by the employer from the patent; and (d) by reason of those facts it is just that the employee should be awarded compensation to be paid by the employer in addition to the benefit derived from the relevant contract; the court or the comptroller may award him such compensation of an amount determined under section 41 below. As for the amount of remuneration, section 41 (1) of the UK Patent Act further provides: "An award of compensation to an employee under section 40(1) or (2) above shall be such as will secure for the employee a fair share (having regard to all the circumstances) of the benefit which the employer has derived, or may reasonably be expected to derive, from ... the patent for the invention". By virtue of these provisions, a law basis has been put in place for the system of reward and remuneration for service inventors in the United Kingdom.

On 11 February 2009, the UK High Court decided, in *Kelly and Chui v. GE Healthcare Limited*¹³, that GE Healthcare Limited (the employer) pay the inventor, 3%, namely 1.5 million pounds, out of the 50-million-pound revenue it had made from its patent of MYOVIEWTM (99Tcm-tetrofosmin injection). This was the first case in which the UK court awarded a large sum in favour of the service inventor on the ground that the plaintiffs were the service inventors of the

patented technology, and they had adduced evidence proving that their employer had derived significant and extraordinary benefits; and the patent for the invention they had made was one of the reasons, though not the sole one, for the employer's benefits. For example, the employer derived the benefits also for other reasons, which affected the amount the employees would obtain from their employer. Accordingly, the court considered the service inventors' amount of contribution to the making of the invention, and the technical assistance given and efforts made by others involved in the making of the invention, and the employer's contribution to the invention in suit, and decided that the remuneration due to the inventors was at the rate of 3%. As for the understanding of the "significant revenue" in the UK Patent Act, the judge noted that "significant" meant "special", "extraordinary"; hence, "significant revenue" should be revenue going beyond what is commonly expected, with the amount far more than the economic revenue in correspondence to which the employer had paid the inventors for their salary.

3. France

Within the French service invention reward and remuneration system, importance has been attached to the protection of service inventors' rights and interests. Article L 611-7 of the French Intellectual Property Code (IPC) sets forth that: "inventions by an employee under an employment contract where the employee has a specific duty to invent... belong to the employer. The conditions under which the employee who created the invention receives additional remuneration are determined one to three times the employees' salary by collective bargaining agreements, works council agreements and individual employment contracts." There were cases involving large amounts of remuneration for service inventions in France. In 2000, the owner of a service invention of an anti-cancer medicament was adjudged, as the employer, to pay the inventor 4 million Francs (approximately 830,000 US dollars) according to the benefits made after exploitation of the patent¹⁴. In another case as decided in May 2005, Ray, the inventor, was remunerated only 6,631 Euro from his employer for his service invention of a drug. After leaving his employer, he sued the former employer in the court claiming a larger amount of remuneration. The Paris High Court decided that Ray made 70% contribution to the making of the invention in suit, and ordered the former employer to pay him additional 600,000 Euro. After the employer appealed, the Paris Court of Appeals finally decided on additional remuneration of 300,000 Euro. In the decision, the

Paris Court of Appeals noted the additional remuneration should be calculated with full account taken of many factors, such as the economic benefits generated from the invention, the difficulty in making the invention and the contribution made by the inventor.

4. United States of America

Under the patent system in the United States of America, inventors' interests are accorded special protection, following the "doctrine that invention is owned by the inventor himself". Except that it is agreed in advance that an invention is to be owned by the employer or that one is employed solely for making inventions, a service invention is, in principle, owned by the inventor himself. As for a service invention, a patent should be applied for in the name of the employee, and then assigned to the employer. According to this doctrine and under the impact of the concept of free contract, most US businesses attach great importance to conclusion of agreement with its employees on matters of ownership of invention, working out detailed, complicated contracts, and stressing that the employment is solely for the purposes of making invention. On the whole, the amount of reward and remuneration for service inventions is not large in the U.S., and is usually fixed at several thousands a patent because employers think the salary paid to an employee is enough to cover the reward and remuneration for service inventions.

Conclusion

The provisions of the amended Patent Law and its Implementing Regulations for the system for reward and remuneration for service inventors are now in force, and entities having been granted the patent right in China are obliged to pay inventors reward and remuneration. The manner of payment and amount of reward and remuneration may be decided on by virtue of contract or under the corporate regulations, otherwise reward and remuneration are to be paid at the amount provided for in laws. While there have not been many cases where the courts awarded inventors in China, and the amount of reward and remuneration was not large, under the guidance of legislation to encourage invention and enhance protection of the rights and interests of inventors and the impact of foreign lawsuits awarding "large amount of reward and remuneration", it is expected that there will be increase in the number of such cases and in the amount of the reward and remuneration awarded. It is worth noting that in Japan, also an east Asian nation, there are more lawsuits in-

stituted by R&D employees for award of reward and remuneration for their invention made during their employment for to their employers when they leave their job or retire. This tendency signals a warning to enterprises having patent filings in China. 註

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¹ Without special indication otherwise, the “service inventors” here refer to “inventors or creators of service invention-creations”.

² For example, Article 45 of the new Patent Law provides that “any entity or individual” may request the Patent Reexamination Board to declare the patent right invalid, and Article 19: “where any Chinese entity or individual applies for a patent, may appoint a patent agency”.

³ See the speech by Li Xiaoxia, Deputy General Director of the Education, Science, Culture and Health Department of the Legal Affairs Office of the State Council at the press conference held by the Information Office of the State Council on Amendment of the Implementing Regulations of the Patent Law: “the scope of application of the standards for reward and remuneration have extended from all state-owned enterprises to all entities, including enterprises of all sorts”, http://www.chinataiwan.org/xwzx/xwfbh/gxbxwfbh/201002/t20100204_1247816.htm as last visited on 30 November 2010.

⁴ The Beijing Higher People’s Court’s Answers to Several Questions Regarding Application of Law to Civil IP Cases Involving Foreign Parties as of 2004 provide: “The relevant laws apply to the trial of civil cases where foreigners enforce their patent rights, trademark rights or copyrights. It is not possible to apply laws of any foreign country; hence there is no need to recite conflicting regulations.”

⁵ For example, the Beijing Municipality’s Regulations for Administration, Protection and Promotion of Patent; and the Shanghai Municipality’s Several Opinions on Further Enhancement of IP-related Work.

⁶ <http://vip.chinalawinfo.com/case/>, last visited on 21 November 2010.

⁷ See the Shanghai No.1 Intermediate People’s Court’s Civil Judgment No. Huyizhongminwu (zhi) chuzi 220/2005 and Shanghai Higher People’s Court’s Civil Judgment No. Hugaominsan(zhi)zhongzi 23/2008.

⁸ For details, see Tao Xinliang, Research Report of the IP School of Shanghai University: Attribution of the Ownership of Patent Application Right, Patent Right and System of Reward and Remuneration for Service Inventors or Creators, excerpts of Special Research Report on the Third Amendment to the Patent Law and Its Implementing Regulations, (Volume Two), compiled by the Legal Affairs Department of the State Intellectual Property Office, the Publishing House of Intellectual Property, 2006, P.928.

⁹ Article 326 (1) of the Contract Law: Where the right to use or transfer a service-related technological result belongs to a legal person or any other organisation, the legal person or that organisation may conclude a technology contract on the said service-related technological result. The legal person or that organisation shall deduct a certain percentage of the benefits from using and transferring the service-related technological result so as to award reward and remuneration to the person(s) achieving the service-related technological result. Where the legal person or organisation is to enter into a technology contract for the transfer of the service-related technology, the person(s) achieving the service-related technological result shall have the priority to be the transferee under the same conditions.

¹⁰ For details, see Guangdong Province Dongguan City Intermediate People’s Court’s Civil Judgment No. Dongzhongfaminsanchuzi 33/2006 and Guangdong Province Higher People’s Court’s Civil Judgment No. Yuegafaminsanzhongzi 229/2007.

¹¹ Article 75 of the Supreme People’s Court’s Several Provisions on Evidence in Civil Procedure: Where a party having evidence refuses to present it without good reason, if the other party claims that the evidence is unfavourable to the holder of the evidence, the claim may be presumed tenable.

¹² The Japanese Patent Office: “The Case Studies of the Procedures under the New Employee Invention System”, <http://www.jpo.go.jp/index.htm>, last visited on 21 November 2010.

¹³ James Duncan Kelly and Kwok Wai Chiu v GE Healthcare Limited, [2009] EWHC 181 (Pat) (Floyd J), 11 February 2009.

¹⁴ Hoechst Marion Roussel/Raynaud, La Cour de Cassation, Chambre Commerciale, November 21, 2000; Arrêt n° 2086. Rejet.; Pourvoi n° 98-11.900; and GRUR Int. 2001, 785.

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