GLOBAL MARKETPLACE — EYE ON CHINA: SEMINAR SERIES

美国专利法改革
Patent Reform Legislation in the US

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美国专利法改革
United States Patent Reform

- 有关专利法的重要变革，在美国已经争议了将近半个世纪之久
  The most significant changes to patent law in half a century are being debated in the US.
- 因为这影响着所有商业模式和所有工业领域
  They affect every business model and every industry.

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行政上的首要问题：资金和权力
Administration Primary Issues Funding and Authority

- 美国专利局的资金问题在行政观察信中显现
  The first issue raised in the Administration views letter was funding for the USPTO.
  - 支持美国专利局的设定费用权力
    Supports fee-setting authority for the USPTO
  - 支持增加15%的临时费用
    Supports 15% interim fee increase
- 寻求实质的规则制定权力机关
  Seeks substantive rulemaking authority

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关于损害赔偿的争论
The Damages Debate

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- 损害赔偿的计算方式（的争论）足以成为阻碍此次法律通过的核心要件。
  The calculation of damages has been the key reason for the hold-up of the legislation.
- 损害赔偿条款在法院认定专利有效并且存在侵权行为之前没有任何意义。
  Damages provisions do not become relevant until the court has determined that a patent is valid and has been infringed.

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损害赔偿争论的焦点
Damages Debate Key Concerns

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- 不同行业领域对于使用其专利战略的方式是不同的——进攻或是防守
  Different industries use patents in strategically different ways—offense and defense.
- 由陪审团确定赔偿已与由法官确定赔偿大相径庭
  Jury awards have moved away from bench trial awards.

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审团对损害赔偿金的决定权日益扩大
Juries are Increasingly Deciding Damages Awards

- 现在的审判趋势逐渐倾向于由陪审团来确定损害赔偿金而非法官
  The trend is increased use of juries, rather than bench trials, to determine damages.
  - 二十世纪八十年代——陪审团确定金额案例占14%
  - 二十世纪九十年代——陪审团确定金额案例占22%
  - 进入二十一世纪——陪审团确定金额的案例占43%
  - 1980s—Jury decided awards in 14% of cases
  - 1990s—Jury decided awards in 22% of cases
  - 2000s—Jury decided awards in 43% of cases

引自PricewaterhouseCoopers 2008年专利诉讼研究
PricewaterhouseCoopers 2008 Patent Litigation Study

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陪审团确定的赔偿金额较高，通常高于法官做出的数额
Juries Award Higher Damages and More Often than Judges

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- 从二十世纪九十年代中期开始，陪审团倾向于原告的比例就普遍高于法官
  Since the mid-1990's, juries have consistently found for plaintiffs at a higher rate than bench trials
- 进入二十一世纪，陪审团所做裁决的赔偿金数额已经高出法官裁决的九倍
  Since 2000, jury awards have been more than *nine times* higher than bench trial awards

引自 PricewaterhouseCoopers 2008年专利诉讼研究
PricewaterhouseCoopers 2008 Patent Litigation Study

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现行法下的损害赔偿计算
Damages Under Current Law

- 基于现行法，法官可以给予很少的指导，而陪审团有较大的自由裁量权，从而他们可以基于合理的使用费来决定损害赔偿的数额
  Under current law, judges may give little direction and wide latitude to juries to determine a damages award based upon reasonable royalty.
- *Georgia-Pacific* (美国损害赔偿金额第一案), 列举了15项需要考虑的因素
  Georgia-Pacific (the primary damages case in the US), lists 15 factors for consideration.

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损害赔偿的争议:众议院法案
Damages Debate: House Bill

- 一般通过以下三种方式来确定基于合理使用费的损害赔偿：
  Reasonable royalty damages are directed to three specific methods:
  （1）“整体市场价值”
  Entire “market value
  （2）“经营许可”
  “Marketplace licensing”
  （3）“价值计算”
  “Value calculation”
- 法院也会适当考虑“其它相关因素”
  Courts may also consider “other relevant factors,” where appropriate.

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损害赔偿的争议:参议院妥协
Damages Debate: Senate Compromise

法官作为“把关”者
Judge serves as the “Gatekeeper”

- 双方向陪审团陈述损害赔偿所应考虑的法律问题
  Parties present what legal bases for the jury to consider for damages.
- 法官必须明确陪审团需要考虑哪些因素
  The judge must specify what factors the jury may consider
- 陪审团*仅需*考虑这些因素
  The jury may consider *only* those factors

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地域管辖
Venue

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问题/The Problem:

怎样才可以避免只在中国经营的公司或者例如加州的公司被告到德州?

What can be done to stop parties with business *only* in China and a few US states from being sued in Texas?

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地域管辖(现行法)
Venue (Current US Law)

- 基于现行法，原告对起诉法院的选择范围很广
  Under current law, plaintiffs have wide latitude to choose the jurisdiction of their lawsuits.
- 现行地域管辖的相关法律已经导致那些会倾向原告的法院案如潮涌，尤其是德州东区法院
  Current venue law has led to a flood of cases being filed in jurisdictions considered to be “plaintiff friendly,” particularly the Eastern District of Texas.

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地域管辖(众议院观点)
Venue (House Version)

- 专利侵权诉讼地被限制在被告：
  Patent infringement suits limited to a state where the defendant:
  - 公司所在地
    is incorporated
  - 主要营业地
    has a principal place of business, or
  - 具有“实体设施”并构成公司业务“实质部分”
    has an “established physical facility” that constitutes a “substantial portion” of its operations.

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地域管辖：参议院法案的妥协
Venue: Senate Bill Compromise

- 当法官决定该案件由有司法利益的法院审理明显可使双方和证人更加便利时，管辖权转移是需要的。

  A transfer is required where the judge determines that the case is clearly more convenient for the parties and witnesses and is in the interest of justice.

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行政挑战途径：授权后审查
Administrative Challenges Post-Grant Review

- 向美国专利局挑战专利权的一种新的行政途径被提议写入立法：
  A new administrative challenge to a patent before the USPTO is proposed in the legislation:
  - 更大的可能性
    Broader possibility of
  - 挑战必须在12个月内提出
    Challenge must be within 12 months
  - 允许有限的发现
    Limited discovery allowed
  - 由美国专利局复审委员会听证
    Heard by USPTO Board of Appeals
  - 支持禁止反言
    Estoppel for claims held valid
  - 12个月完成
    12 months to complete

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谢谢！ Thank you!

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美国专利复审制度
U.S. Patent Reexamination

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美国专利复审制度
Reexamination of U.S. Patents

- 什么是美国专利复审制度
  What is Reexamination of a U.S. Patent
- 复审的种类
  Types of Reexamination
- 可提起专利复审请求的要求
  Reexamination eligibility requirements
- 复审请求的内容
  Contents of a reexamination request
- 专利局复审程序
  PTO procedures during reexamination
- 复审成功的概率
  Statistics on Reexamination success
- 对于诉讼可能产生的影响
  Possible Impact on litigation
- (第三者的)介入权
  Intervening Rights

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什么是美国专利复审制度
What is Reexamination of a U.S. Patent

- 于美国专利局对已授权专利有效性提起争议的程序。
  U.S. Patent Office procedure to contest validity of an issued patent.
- 可以由任何第三方提起
  Can be filed by any 3rd party
- 在专利可执行期限内任何时间都可以提起
  At any time during the enforceable lifetime of the patent.
- 在首次提起专利复审请求时，至少提出一个新的针对“专利性”的实质性质疑
  Initiated by filing a Request for Reexamination stating at least one Substantial New Question of Patentability
  - 仅仅基于专利以及公开出版物
    Based ONLY on patents and printed publications.
- 提供挑战专利有效性的低成本的途径
  Can provide lower cost alternative for validity challenge

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复审的种类
Types of Reexamination

- 两种类型 Two types
  - 单方复审 Ex Parte
    - 请求人可以匿名提出
      Requester can remain anonymous.
    - 请求人在提交复审申请后可以不参与后续过程
      Typically, the requester can not participate once the request is filed.
    - 如果专利权人在审查员受理了复审请求后提交答复声明，该复审申请的请求人可以针对该答复声明提出意见
      If the patent owner files a patent owner’s statement in response to the Examiner’s order granting reexamination, the requester may file one comment.
    - 该项制度只适用于1999年11月29日以前提交的专利申请
      Only available avenue for patents with a filing date earlier than November 29, 1999

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复审的种类
Types of Reexamination

- 两种类型 Two types
  - 双方复审 Inter Partes
    - 第三方请求人不可以匿名提出
      3rd Party Requester may not remain anonymous.
    - 该项制度适用于1999年11月29日以后提交申请且已授权的专利
      Available for Patents issuing from applications filed after November 29, 1999
    - 第三方可参与全部过程
      3rd party may participate throughout the proceeding
    - 任何一方都可以向联邦巡回法院提起上诉
      Either party may appeal to the Federal Circuit
    - 对第三方的限制：禁止反言制度
      Gives rise to 3rd party estoppel
      - 复审申请的请求人向复审委员会提起复审之后，不能再以同样的理由或同样的依据向地区法院就该项专利的“有效性”提起诉讼。
        Requester may not later challenge the validity of the patent in District Court on the same basis or basis that could have been raised

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可提起专利复审请求的要求
Reexamination Eligibility Requirements

- 任何一方均可提起复审请求
  Reexamination is available to any Party
- 单方复审对于任何已授权专利的可执行期限内均可适用
  Ex Parte reexamination is available for any issued patent during its term of enforceability.
- 双方复审只适用于2009年11月29日以后提交的且已授权的美国专利
  Inter Parties reexamination is only available for U.S. Patents issuing from an application with a filing date after November 29, 1999.
- 专利的可执行期限延长至专利保护期限满后6年
  Term of enforceability extends for 6 years after the patent term expires.

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复审请求的内容
Contents of a Reexamination Request

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- 必须对专利性提出一项新的实质性质疑
  Must present a Substantial New Question (SNQ) of patentability
  - 仅仅基于现有专利和出版物
    Based only on prior patents and publications.
  - 不能基于专利性的其他条件
    Not on other conditions for patentability
- 考虑分析现有技术以提出新的质疑
  To be considered for a SNQ the prior art
  - 美国专利局之前没有考虑过的新的现有技术
    New art not previously considered by the PTO
  - 虽然某在先技术曾被考虑过，但通过另一种方式提出该在先技术，而审查员之前并不了解该种方式
    Art previously considered if presented in a new manner that the Examiner did not understand
  - 不是专利局早前考虑过的在先技术的重复
    Not duplicative of art previously before the patent office.
  - 不需要使其完全无效，只需对专利性提出新的争议点即可
    Need not be completely invalidating but only raise a new issue of patentability.

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复审请求的内容
Contents of a Reexamination Request

- 请求包括 Requests Include.
  - 明确提出复审请求所指向的专利
    Identification of the patent for which reexamination is requested
  - 明确第三方请求人（仅限双方复审）
    Identification of 3rd party requester (inter partes only)
  - 声明第三方对提出的复审请求不会反复(禁止反言)(仅限双方复审)
    Statement that the 3rd party is not estopped from filing the request (inter partes only)
  - 审查受争议的技术
    Review of the technology at issue
  - 审查申请历史
    Review of the file history
  - 审查现有技术已发掘新的实质性质疑
    Review of the prior art constituting a SNQ
  - 审查与此项专利有关的正在进行过着之前提起过的诉讼
    Review of Concurrent or Prior Litigation of the patent
  - 明确提出新的实质性质疑并加以解释为何其符合要求
    Explicit statement of Substantial New Questions with explanation of why they meet the requirements.
  - 基于相关现有技术准备权利要求关系表(Claim Charts)以及对权利要求的驳回意见
    Proposed Rejections of claims and claim charts applying the art

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专利局复审程序
PTO Procedures During Reexamination

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- 专利初审办公室审查复审请求是否符合要求
  Office of Initial Patent Examination (OPIE) review the request for compliance with requirements
- （把复审请求）交给复审中心(CRU)
  Sent to the Central Reexamination Unit (CRU)
- 专利局在90天之内给予受理或者驳回的答复
  PTO has 90-days by stature to either grant or deny the request.
  - 很多复审请求由于缺少材料被发回，其请求日作废
    Many requests returned for procedural deficiencies and filing dates vacated.
  - 给予时间以完善复审请求
    Time given to perfect the request.
- 如果复审请求被受理，审查将进入到下一步
  If granted, examination proceeds with “special dispatch”
- 如果是单方复审，专利权人有权在复审申请被受理之日起30天内提交一份专利权人声明
  If Ex Parte, patent owner is given 30-days from the grant date to file a patent owners statement.
  - 通常状况下，不会提交
    Typically not done
  - 会给与提起复审申请的请求人以评议的机会（自声明送达之日起30日内）
    Gives requester an opportunity to comment (30-days from service of comment.

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专利局复审程序
PTO Procedures During Reexamination

- 允许修改权利要求，但只允许缩小范围，不能扩大范围
  Claim amendments allowed but must narrow not broaden the scope.
- 对于保护期满的专利，不允许修改
  No amendments allowed in expired patents.
- 不允许续展和分案申请
  No Continuation or Divisional applications allowed.
- 只有单方复审里会有审查员会见程序（只会见专利权人）
  Examiner interviews allowed only in Ex Parte reexaminations (only the patentee)
- 当双方复审初步程序结束的时候，无论是专利权人还是复审申请的第三方都可向专利上诉与争议委员会提起上诉
  When Initial Inter Partes Reexamination Prosecution terminates both the patent owner and the 3rd party may appeal to the Board of Patent Appeals and Interferences.
- 任何一方都可以向联邦巡回上诉法院提起上诉
  Either Party can appeal to the Court of Appeals for the Federal Circuit.

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单方复审 EX PARTE / 双方复审 INTER PARTES

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单方复审 EX PARTE	双方复审 INTER PARTES
提交请求之后可以不用参与（除非专利权人提交声明），但可以提交多个请求 May not participate after request (unless patent owner statement filed), but may file multiple requests	请求人需要全程参与 Full participation by requester
可以匿名提交 May be anonymous	申请人必须明确身份 Must identify requester
较便宜 Cheap	较贵（但是远比诉讼便宜） Expensive (but far less than litigation)
不要求"禁止反严言"，但是就已考虑过的现有技术而言，提高了有效性假设门槛 No estoppel, but heightened presumption of validity as to considered prior art	禁止反言，就已考虑过的现有技术和其他本应提出的[现有技术]而言 Estoppel as to considered prior art and anything that could have been raised

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双方复审成功的统计数据
Statistics on Inter Partes Reexamination Success

- 从1999年到2009年七月份 From 1999 to June 2009
  - 583件复审申请，有95%被受理
    583 decisions on requests, 95% granted*
  - 77件双方复审发出了通知
    77 inter partes reexamination certificates issued
  - 4件维持了所有的权利要求（5%）
    4 confirming all claims (5%)
  - 46件无效掉了全部权利要求（60%）
    46 all claims canceled (60%)
  - 27件修改了权利要求（35%）
    27 with claim amended (35%)
  - *大多数双方复审开始都被退回其申请日缺省，第三方请求者会有机会更正，并重新申请。再重新提交申请后，大约95%的请求都会被受理。
    * Most inter partes requests are initially returned with vacated filing dates with the 3rd party requester given time to correct and re-file. 95% of re-filed requests are granted.

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对于诉讼的影响
Impact on Litigation

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- 双方复审禁止当事人反言
  Estoppel from Inter Partes Reexamination
  - 美国第35法案315（c）
    35 U.S.C. 315(c)
    - 如果权利要求具有专利性，请求人不能在向法院提起对该专利无效的请求
      If claim found patentable, requester can not claim invalidity of claim in court
    - 只适用于复审中涉及的现有技术，或者那些“本应出现的”现有技术
      Only applies for prior art that is in reexam, or that “could have been raised”
    - 只适用在复审通知发出后
      Only applies after reexam certificate

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对诉讼的影响
Impact on Litigation

- 双方复审禁止当事人反言
  Estoppel from Inter Partes Reexamination

  美国第35法案317条
  35 U.S.C. 317
- 请求人在第一个复审请求进行中，不能再申请第二个双方复审的请求
  Requester may not file second inter partes reexam request while the first is active
  - 例外：美国专利局局长认为有很合理的理由而批准的
    Exception: permission of USPTO Director, for good cause
- 如果法院裁定权利要求不是"无效，"，那么将终止该权利要求的复审
  If claim found "not invalid" in court, reexam must end for that claim
- 只适用于法院程序中涉及的现有技术，或者那些"本应出现的"现有技术
  Only applies for prior art that is in court, or that "could have been raised"
- 只适用于所有上诉提出后
  Only applies after all appeals

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对诉讼的影响
Impact on Litigation

- 中止诉讼而先实施复审的动议
  Motion to Stay litigation pending reexamination
  - 来自美国第35法案308 Stems from 35 U.S.C. 308
  - 由法院作出裁定 At the Courts discretion
- 有些法院会对这些动议做出裁决，有些则不会，法院会考虑：
  Some courts responsive to these motions, others not. Courts consider:
  - 简易程度 Simplification
  - 诉讼中提起复审的时机 Timing of reexam relative to litigation
  - 倾向性因素 Prejudice

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法院中止审理的比例

STAY GRANT RATES FOR COURTS

地区District	授权中止的比例Approx. Grant %
德州东区法院 E.D. Tex.	20%
加州北区法院N.D. Cal.	65%
加州中心区法院C.D. Cal.	35%
特拉华州地区法院D.Del.	30%
乔治亚州北区法院N.D.Ga.	85%
加州南区法院S.D. Cal.	85%
佛罗里达州南区法院S.D.Fl.	70%
纽约南区法院S.D.N.Y.	40%
佛罗里达州中区法院M.D.Fl.	100%
弗吉尼亚州东区法院E.D. Va.	50%
伊利诺伊州北区法院N.D. Ill.	85%
佛罗里达州北区法院N.D.Fl.	NA
威斯康星州西区法院W.D. Wis.	NA

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中止诉讼还是中止复审—为什么时机至关重要

Litigation Stay Or Reexam Suspension – Why Timing Is Critical

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- 专利局可能会因合理的理由延长双方复审的时间，这样，法院可能比专利局更早做出决定（如果专利局赶不上法院的进度，那么需要调整复审的目的）
  PTO may suspend inter partes reexamination for “good cause”, which can be that the court is closer to a final decision than the PTO (if PTO can’t catch up, then reexam objectives should be adjusted)
- 如果双方复审被中止，则双方可以待法院的对于是否有效做出最终判决后，申请终止复审程序
  If inter partes reexam is suspended, then parties can wait for final decision of validity or invalidity in court and file a petition to terminate the reexam
- 相反的：诉讼也可能会因为提起复审而被中止
  Flip side: litigation may be stayed based on reexam
- 如果诉讼被中止，那么复审的最终结论将决定诉讼程序中专利有效性的结果
  If litigation stayed, then final decision in reexam ends validity determination in litigation

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诉讼与复审并行——相互制约的复杂策略
Parallel Litigation & Reexamination – Complex Strategy Implications

- 争议的范围可以扩大到“可能会出现的”（现有技术），但是在诉讼中可以提出的法律理由比复审中的多（例如，在复审中不会有112法令下专利权有效性的问题，也不会有因为销售导致专利无效的问题）
  Scope extends to arguments which “could have been raised”, but more issues can be raised in litigation than in reexam (e.g., no 112 issues or on-sale bars in reexam)
- 制定的策略就是各方为了得到自己最满意的结果，尝试选择在法院，或者是专利局提交请求，然后利用禁止反言规定，去阻止另一个程序的进行
  Strategy is for each party to try to get close to a final favorable decision in one or the other forum, either in litigation or in the PTO, then use the estoppel provision to stop the other proceeding
- 单方复审可以在任何时候提起，且没有禁止反言的限制，但是必须提出一个与任何现存的复审相关的实质性的新的问题
  Ex parte reexam may be filed at any time and no estoppel applies, but it must raise a substantial new question relative to any existing reexamination

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（第三方的）介入权
Intervening Rights

GLOBAL MARKETPLACE — EYE ON CHINA: SEMINAR SERIES

- 法规：经过重新授权的/复审的权利要求，必须在本质上与原始权利要一致
  PROVISIONS: CLAIM IN REISSUE/REEXAM MUST BE SUBSTANTIALLY IDENTICAL TO ORIGINAL CLAIM
- 影响：过去所有的赔偿将由于权利要求的修改而消失
  EFFECT: ALL PAST* DAMAGES ERASED BY CLAIMS AMENDMENT
- 也可能会包含预期的权利（相当于第三方的介入权）
  PROSPECTIVE RIGHTS ALSO POSSIBLE (EQUITABLE INTERVENING RIGHTS)
- 截止到专利重新授权或者复审受理通知发出之日起
  *before date of reissue patent or reexam certificate

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谢谢！ Thank you!

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GLOBAL MARKETPLACE — EYE ON CHINA: SEMINAR SERIES

美国专利诉讼变迁概览：管辖权转移、复审及近期判决
The Changing Landscape of U.S. Patent Litigation: Venue Changes, Reexamination, and Recent Decisions

David E. Kleinfeld, Foley & Lardner LLP
Kurt M. Kjelland, Foley & Lardner LLP

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概述
Overview

GLOBAL MARKETPLACE — EYE ON CHINA: SEMINAR SERIES

- 管辖权转移的动议
  Motions to Transfer Venue
- 加州地方法院
  California District Courts
  - 圣地亚哥——一个“新”的专利诉讼地
    San Diego – A “New” Patent Venue
- 复审
  Reexamination
- 近期典型案例
  Important Recent case law
  - *Lucent Technologies, Inc. v. Gateway, Inc.*, 580 F.3d 1301 (Fed. Cir. Sept. 11, 2009)
  - *Bilski v. Kappos*, No. 08-964 (U.S.) – *cert. granted* 6/1/2009, *oral argument* 11/9/2009

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管辖权转移的动议

Motions to Transfer Venue

材料引用经授权，来自09年10月研讨会上富理达Matt Lowrie律师和Debbie Nye律师，伯斯公司的David Schuler律师，百特国际有限公司James Smith律师，以及美国银行Michael Springs律师的发言

Information taken with permission from a seminar presented in October 2009 by Matt Lowrie and Debbie Nye of Foley & Lardner LLP, David Schuler of Bose Corp., James Smith of Baxter International Inc., and Michael Springs of Bank of America Corp.

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管辖权转移的动议——背景

Motions to Transfer Venue –Background

- 从历史角度来讲，一些地区法院很倾向于支持专利权人：
  - 如德州东区法院，弗州东区法院以及特拉华地方法院
- Historically, Several districts have tended to favor patentees:
  - E.D. Texas, E.D. Virginia, and Delaware
- 德州东区法院很抵触将专利的案子转移
  - 通常情况下，专利权人来自德州东区的有限责任公司和或者在该地区寻找至少一个被告
  - 法院是很抵触将案件转移出该地区法院的
- E.D. Texas has resisted transferring patent cases
  - Oftentimes patentees form LLC's in E.D. Texas and/or name at least one defendant in the district
  - Court has resisted transferring cases out of the district
- 如Volkswagen of Am., Inc., 545 F.3d 304 (5th Cir. 2008)，非专利案件设立了分析转移法院请求的规则。
- In re *Volkswagen of Am., Inc.*, 545 F.3d 304 (5th Cir. 2008): non-patent case setting rules for analyzing transfer requests
- 最近，联邦巡回法院已经开始动用强制命令来将案件转移
  - 联邦巡回法院已经在德州东区法院推行第五巡回上诉法院关于管辖权的标准
  - 德州东区法院已经开始遵循上诉法院的管辖权标准
- Recently, Federal Circuit has used mandamus power to transfer cases
  - Federal Circuit has enforced 5th Circuit venue tests in the E.D. Texas
  - E.D. Texas has begun to follow the appellate venue tests

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管辖权转移的动议—法律标准
Motions to Transfer Venue –Legal Standards

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- 美国法28 U.S.C. § 1404(a) 转移事由：
  28 U.S.C. § 1404(a) Transfer Factors:
  - 私人利益事由：
    - 证人的便利和接触证据材料的相对容易行
    - 为了确保证人顺利出庭的可以使用的一种必须程序
    - 证人愿意接受的出席成本
    - 其他能够使审判容易、快速且经济的实践问题
  - Private Interest Factors
    - Convenience of witnesses and the relative ease of access to sources of proof
    - The availability of compulsory process to secure the attendance of witnesses
    - The cost of attendance for willing witnesses
    - Other practical problems that make a trial easy, expeditious and inexpensive.
  - 公众利益事由（法院不便于审理）：
    - 法院案件拥挤导致行政管理上的困难
    - 地方利益在本地解决
    - 法院对适用法律的熟悉程度
    - 防止适用外国法律造成的冲突
  - Public Interest Factors (*Forum Non Conveniens*)
    - Administrative difficulties flowing from court congestion
    - The interest in having localized interests decided at home
    - The familiarity of the forum with the governing law
    - Avoiding conflicts of laws or problems in applying foreign law

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管辖权转移的动议—法律标准
Motions to Transfer Venue –Legal Standards

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- 原告对法院的选择通常是有意义的
  Plaintiff’s choice of forum is always relevant
  - 原告的选择会被尊重
    Plaintiff’s choice is given deference
  - 选择转移管辖法院的一方需要清楚的举证说明选择另一法院管辖会更加便利
    Choice of venue corresponds to the burden that a moving party must meet to show that another forum is clearly more convenient

- 关键还是与纠纷之间的联系。如果专利权人只是较少的被牵扯入纠纷中（例如是被许可人），那么就较为容易获得管辖权转移。
  The key though is contact with the dispute. If the patentee has little involvement with the dispute (*e.g.*, is a licensee), transfer is more attainable.

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管辖权转移的动议—近期联邦巡回法院判例
Motions to Transfer Venue –Recent Federal Circuit Case Law

GLOBAL MARKETPLACE — EYE ON CHINA: SEMINAR SERIES

- In re *TS Tech USA Corp*, 551 F.3d 1315 (Fed. Cir. 2008)
  - 地方法院(德州东区)非常偏重原告的选择
  - 地方法院忽视有关证人差旅的"100英里"规则
  - 地方法院未能考虑证据所在地
  - 地方法院不重视地方利益的影响
  - District court (E.D. Tex.) gave too much weight to plaintiff's choice
  - District court ignored "100-mile" rule regarding witness travel
  - District court failed to consider the location of evidence
  - District court gave no weight to localized interests
- In re *Genentech, Inc.*, 566 F.3d 1338 (Fed. Cir. 2009)
  - 地方法院(德州东区)忽视"100英里"规则
  - 地方法院未能考虑证据所在地
  - 地方法院对被告在同一地区的在先诉讼给予了不公平的重视
  - 地方法院不重视地方利益的影响
  - District court (E.D. Tex.) ignored the "100-mile" rule
  - District court failed to consider the location of evidence
  - District court gave unfair weight to defendant's prior litigation in the same district
  - District court gave no weight to localized interests

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管辖权转移的动议—弗州东区到加州南区
Motions to Transfer –E.D. Va. to S.D. Cal.

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- *SPH v. Kyocera*, No. 08CV702 (E.D. Va.)

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专利诉讼趋势—加州地方法院
Patent Litigation Trends in California District Courts

- 三大重要专利诉讼区
  Three Significant Patent Districts
  - 加州北区和南区有地方专利规定
    Northern and Southern Districts of California have Patent Local Rules
  - 加州中区
    Central District of California
    - 2007年9月30日-2008年9月30日，该区提交的专利案件和未决专利案件数量排名全美第二
      Had the second highest number of patent cases filed and pending between 9/30/2007 and 9/30/2008 in the U.S.
    - 该区去年专利案件数量有望排名第一
      Looks to have the highest number of patent cases in the last year
  - 目前为止，三个加州地方法院合计的专利提交案件、审结案件和未决案件数量为全美数量最高州。
    Combined, the three California District Courts had by far the highest number of patent cases filed, terminated and pending of any state in the U.S.

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加州南区

Southern District of California

一个新的管辖地——提供专家技术意见、判决统一、提供详细时间表

A New Venue That Offers Expertise, Consistency, and a Defined Timetable

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加州南区
Southern District of California

- 包括
  Encompasses
  - 圣地亚哥
    San Diego County
  - 因皮里尔
    Imperial County
- 南区法院位于
  Court for the Southern District is held in
  - San Diego
  - El Centro

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加州南区的概况和统计数据
Southern District of California - Overview and Statistics

- 16位地区法官
  16 District Judges
- 10位治安法官
  10 Magistrate Judges
- 2007年9月30日 – 2008年9月30日
  Between 9/30/2007 – 9/30/2008
  - 递交专利案件92件
    92 patent cases filed
  - 审结专利案件62件
    62 patent cases terminated
  - 未决专利案件98件
    98 patent cases pending

Source: Office of Judges Programs Statistical Tables for the Federal Judiciary12/31/08

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加州南区 – 法官司法经验丰富
Southern District of California - Widespread Judicial Experience

Historical Division of Cases
案件分配回顾

Judge	Number of Patent Cases	Number of Active Patent Cases
Moskowitz	118	35
Gonzalez	82	10
Lorenz	77	10
Houston	65	6
Huff*	61	8
Miller	56	3
Burns	45	4
Whelan	45	5
Hayes	26	4
Sammartino**	25	9
Sabraw	24	7
Benitez	19	2
Anello**	18	13

*Huff法官主持了朗讯科技（Lucent）案件中的陪审团的审讯，这一案件后面还将讨论。

*Judge Huff presided over the jury trial in the *Lucent* case to be discussed later in this presentation.

**Samartino法官和Anello法官分别在2007年底和2008年底成为审判法官，他们正在进行的案件比例较高是因为当他们开始被分配案件时从其他法官"继承"了些案件

**Judge Samartino joined the bench in late 2007 and Judge Anello in late 2008, so the higher rate of active patent cases is likely due to cases "inherited" from other judges when their dockets were first assigned.

Thanks to Barry J. Tucker, Foley Senior Counsel, for compiling this data.

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加州南区—统一&详细时间表
Southern District of California – Consistency & Defined Timetables

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- 所有民事案件从提交诉状至庭审平均需要22个月
  All civil cases are averaging 22 months from filing of complaint to trial.
- 2006年4月专利规定生
  Patent Rules went into effect in April 2006.
- 依据专利规定，法官通常将马克曼听证（Markman hearing）设在被告答辩后9个月，并将庭审前的最终会议设在马克曼听证后的9-12个月
  Pursuant to the Patent Rules, the judges are generally calendaring *Markman* hearing 9 months after the defendant answers and then setting the final pre-trial conference about 9-12 months after that.
  - 在专利规定生效后，Whelan法官在其唯一的专利案件中，设定了一个6个月后的马克曼听证和其之后8个月的庭审。该案中，被告进行了答辩且在案件被撤销前签发了进程安排令。
    Judge Whelan set a 6-month *Markman* schedule and trial 8 months after that in his only patent case after the patent rules went into effect where an answer was filed and a scheduling order issued before the case was dismissed.
  - Benitez法官从未在其处理的任何专利案件中签发正式的马克曼听证进程令，虽然他看起来设定了激进的庭审前最终会议日期（约为答辩提交后的15个月）
  - Judge Benitez has not entered a formal *Markman* scheduling order in any of his patent cases, though he seems to be setting aggressive final pre-trial conference dates (about 15 months after the answer is filed).

Thanks to Barry J. Tucker, Foley Senior Counsel, for compiling this data.

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重要专利诉讼地区
Significant Patent Districts

GLOBAL MARKETPLACE — EYE ON CHINA: SEMINAR SERIES

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加州中区
Central District of California

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加州中区的概况和统计数据
Central District of California - Overview and Statistics

GLOBAL MARKETPLACE — EYE ON CHINA: SEMINAR SERIES

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- 2007年9月30日 – 2008年9月30日
  Between 9/30/2007 – 9/30/2008
  - 递交专利案件244件244
    patent cases filed
  - 审结专利案件307件307
    patent cases terminated
  - 未决专利案件262件262
    patent cases pending
- 在该时间段内，仅有德州东区法院在递交案件和未决案件数量上超过了该区法院
  The only district court with more patent cases filed and pending in the same time period was the Eastern District of Texas

Source: Office of Judges Programs Statistical Tables for the Federal Judiciary12/31/08

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加州中区的概况和统计数据
Central District of California – Overview and Statistics

GLOBAL MARKETPLACE — EYE ON CHINA: SEMINAR SERIES

- 包括
  Encompasses
  - Los Angeles
  - Orange County
- 中区法院位于
  Court for the Central District is held in
  - Los Angeles,
  - Riverside,
  - Lompoc,
  - Pasadena,
  - Santa Ana and
  - Santa Barbara

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加州中区的概况和统计数据
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- 首席法官Audrey B. Collins
  Chief Judge Audrey B. Collins
- 34位地区法官
  34 District Judges
- 23位治安法官–包括首席治安法官 Stephen J. Hillman
  23 Magistrate Judges – including Chief Magistrate Stephen J. Hillman

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加州中区的概况和统计数据
Central District of California – Overview and Statistics

GLOBAL MARKETPLACE — EYE ON CHINA: SEMINAR SERIES

案件分配回顾
Historical Division of Cases

Judge	Number of Patent Cases	Number of Closed Patent Cases
Anderson	56	52
Carney	93	74
Carter	157	149
Collins	107	100
Cooper	70	67
Fairbank	22	14
Feess	67	59
Fischer	60	56
Guilford	31	20
Gutierrez	20	11
Hatter	78	78
Keller	28	28
King	108	104
Klausner	124	106
Larson	4	4
Letts	49	49
Lew	60	60
Marshall	55	55
Matz	114	107
Morrow	96	93
Otero	71	66
Pfaelzer	109	103
Phillips	74	70
Pregerson	101	88
Rafeedie	62	62
Real	143	135
Schiavelli	33	33
Selna	106	90
Snyder	89	77
Stotler	309	296
Takasugi	21	21
Timlin	80	80
Walter	62	58
Wilson	105	102
Wright	21	15
Wu	20	14

- 每位法官平均专利案件：78件
  Average patent cases per judge: 78
- 每位法官的实际数字会有很大不同
  Actual number varies significantly from judge to judge
- 超过100件专利案件的法官：11位
  Number of judges with more than 100 patent cases: 11
- 超过100件专利结案的法官：9位
  Number of judges with more than 100 closed patent cases: 9

Source: *Legal*Metric, LLC

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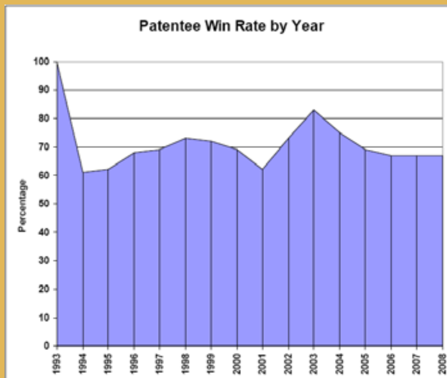
Central District of California – Overview and Statistics

GLOBAL MARKETPLACE — EYE ON CHINA: SEMINAR SERIES

Patentee Win Rate By Year
专利权人每年胜诉率



- 1993年
  - 仅一件判决
    Only one decision
- 1994-2008年
  - 专利权人胜诉率较为平稳
    Relatively even patentee win rates
  - 高于全国水平59%的胜诉率
    Above national average win rate of 59%

Source: *Legal*Metric, LLC

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Central District of California – Overview and Statistics

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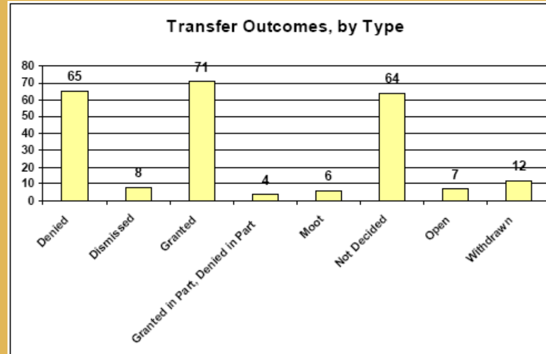
- 转移管辖权？ 相比德州东区，更愿意转移管辖权
  Transfers Out? More willing to transfer than E.D. Texas



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Source: *Legal*Metric, LLC

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Central District of California – Overview and Statistics

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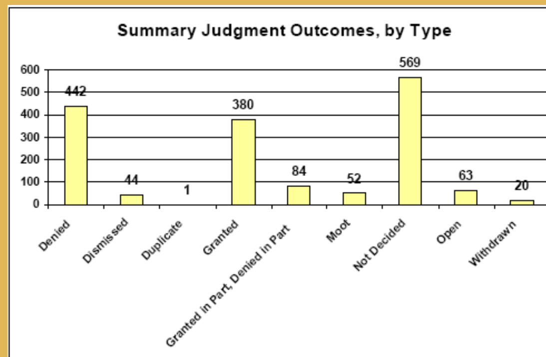
简易判决
Summary Judgment Outcomes



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重要专利诉讼地区
Significant Patent Districts

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加州北区
Northern District of California

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Northern District of California

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- 包括
  Encompasses
  - San Francisco
  - Silicon Valley
- 加州北区法院位于
  Court for the Northern District is held in
  - San Francisco,
  - San Jose,
  - Oakland, and
  - Eureka (part-time court site, cases not assigned there)

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加州北区的概况和统计数据
Northern District of California- Overview and Statistics

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GLOBAL MARKETPLACE — EYE ON CHINA: SEMINAR SERIES

- 2007年9月30日 – 2008年9月30日
  - 递交专利案件169件
  - 审结专利案件184件
  - 未决专利案件235件
- Between 9/30/2007 – 9/30/2008:
  - 169 patent cases filed
  - 184 patent cases terminated
  - 235 patent cases pending

Source: Office of Judges Programs Statistical Tables for the Federal Judiciary12/31/08

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加州北区的概况和统计数据
Northern District of California – Overview and Statistics

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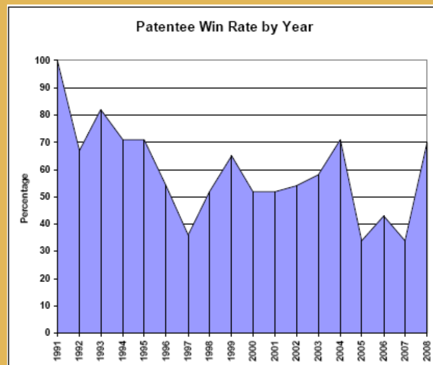
GLOBAL MARKETPLACE — EYE ON CHINA: SEMINAR SERIES

专利权人胜诉率
Patentee Win Rate



- 90年代
  - 专利权人胜诉率较高 Higher patentee win rates
- 近期Recently
  - 较为平稳 Relatively even
  - 稍微低于全国水平 Slightly below national average

Source: *Legal*Metric, LLC

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加州北区的概况和统计数据 Northern District of California – Overview and Statistics

- 什么使加州北区不同？
  What sets apart the Northern District of California?
  1. **经验**——近十年间，许多法官处理过多余100起专利案件。专利规定带动了德州东区专利规定。
     Experience. A large number of judges with 100 or more patent cases in the last ten years. Patent Rules gave rise to E.D. Texas Patent Rules.
  2. **陪审团**——硅谷的自由软件文化。奥克兰可能会影响较小。
     Juries. Silicon Valley free-software culture. Oakland may be less so.
  3. **可变性**——许多法官的案件进度表和途径相比德州更具不确定性。法官对于专利案件的倾向各不相同。
     Variability. Large number of Judges makes schedule and approach less predictable than in Texas. Judges vary in their fondness for patent cases.

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加州北区的概况和统计数据 Northern District of California – Overview and Statistics

- 地方规定 Local Rules
  - 同德州东区相似的专利规定
    Patent Rules similar to E.D. Texas
  - 加州北区规定是德州东区专利规定的起源
    N.D. Cal. rules were the origin of the E.D. Texas Patent Rules
- 发现程序——依法官而定
  Discovery – Judge-dependent
  - 发现程序期限规定在专利规定中
    Discovery deadlines set in Patent Rules
  - 对个别问题的处理取决于治安法官
    Handling of individual matters dependent on magistrates
- 管辖权转移Transfers Out
  - 相比德州东区，更愿意转移管辖权
    More willing to transfer than E.D. Texas
  - 全国平均水平或偏低
    National average or slightly below

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加州北区的概况和统计数据
Northern District of California – Overview and Statistics

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- 被控侵权人在简易判决上具有较高的胜率——通常为不侵权
  Alleged infringers have high victory rate on summary judgment – usually noninfringement
- 专利权人在庭审中具有稍高的胜率
  Patent owners have slightly more wins at trial

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加州北区的概况和统计数据
Northern District of California – Overview and Statistics

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- 进行确认之诉的较佳管辖地之一
  One of the better jurisdictions for Declaratory Judgment actions
  - 法院具有专利案件经验
    Court experienced with patent cases
  - 陪审团教育水平相对较高且对专利态度并非非常友好
    Jury pool relatively well-educated and relatively less patent friendly
  - 获得不侵权的简易判决是现实、可能的
    Summary Judgment of non-infringement a realistic possibility

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复审：随后的两年

Reexamination: The Next Two Years

With acknowledgement to Matthew A. Smith, Esq. of Foley & Lardner, LLP

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United States Patent and Trademark Office

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Inter Partes Reexamination Filing Data - June 30, 2009

1. Total requests filed since start of *inter partes* reexam on 11/29/99 .... 671[1]
2. Number of filings by discipline

a. Chemical Operation	142	21%
b. Electrical Operation	293	43%
c. Mechanical Operation	225	34%
d. Design Patents	11	2%

3. Annual Reexam Filings

Fiscal Yr	No.	Fiscal Yr	No.	Fiscal Yr	No.	Fiscal Yr	No.
2000	0	2003	21	2006	70	2009	195 YTD
2001	1	2004	27	2007	126		
2002	4	2005	59	2008	168		

4. Number known to be in litigation .... 446 .... 66%
5. Decisions on requests 583
   a. No. granted .... 556 .... 95%
      (1) By examiner 555
      (2) By Director (on petition) 1
   b. No. not granted .... 31 .... 5%
      (1) By examiner 27
      (2) Reexam vacated 4
6. Overall reexamination pendency (Filing date to certificate issue date)
   a. Average pendency 36.1 (mos.)
   b. Median pendency 33.0 (mos.)
7. Total inter partes reexamination certificates issued (1999 - present) 77

a. Certificates with all claims confirmed	4	5%
b. Certificates with all claims canceled (or disclaimed)	46	60%
c. Certificates with claims changes	27	35%

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7.	Total inter partes reexamination certificates issued (1999 - present)		77
a.	Certificates with all claims confirmed	4	5%
b.	Certificates with all claims canceled (or disclaimed)	46	60%
c.	Certificates with claims changes	27	35%

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双方复审申请—按年份
Inter Partes Reexam Filings By Year

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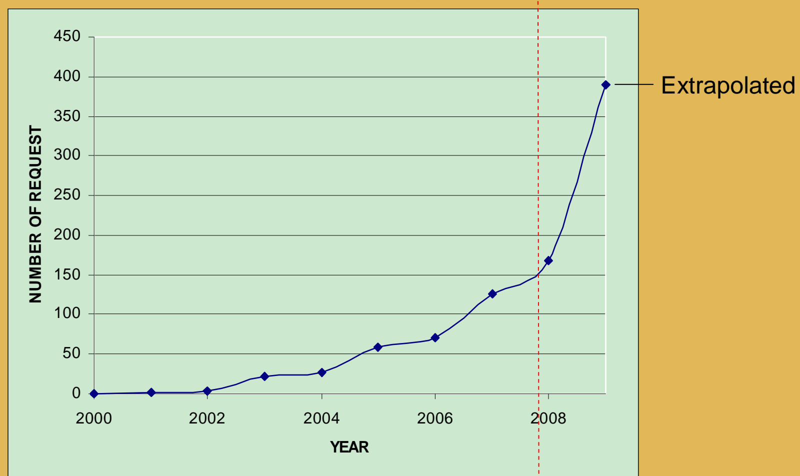

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Judicial

GLOBAL MARKETPLACE — EYE ON CHINA: SEMINAR SERIES

地区 District	大约授予百分比 Approx. Grant %
德州东区E.D. Tex.	20%
加州南区N.D. Cal.	65%
加州中区C.D. Cal.	35%
特拉华州区D. Del.	30%
乔治亚州北区N.D. Ga.	85%
加州南区S.D. Cal.	85%
佛罗里达南区S.D. Fl.	70%
纽约南区S.D.N.Y.	40%
佛罗里达中区M.D. Fl.	100%
弗吉尼亚东区E.D. Va.	50%
伊利诺斯北区N.D. Ill.	100%
佛罗里达北区N.D. Fl.	NA
威斯康星西区W.D. Wis.	NA

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倾向性（类型1）
Prejudice, Type I

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- 在此，假设Wave Loch最终胜诉，Wave Loch除了指明对其在获得金钱赔偿和制止AWM继续侵犯其专利权方面有耽搁外， Wave Loch并没有指出任何具体损害。Wave Loch并没有说明法律上不能给予足够的赔偿，例如过去针对任何侵权行为的金钱赔偿不能完全弥补Wave Loch的损害。虽然Wave Loch合理的认为复审将会严重耽搁其侵权权利要求的审查时，该复审程序内在的耽搁"自身不会构成不适当的倾向"（Wave Loch 加州南区）

- "Here, Wave Loch does not specify any particular injury aside from a delay in collecting monetary damages and excluding AWM from further infringement of its patents, assuming it ultimately wins. Wave Loch has made no showing that there is no adequate remedy at law, i.e. that past monetary damages for any infringing activity could not fully compensate Wave Loch. While Wave Loch has a legitimate concern that reexamination will delay significantly the prosecution of its patent infringement claims, the delay inherent in the reexamination process 'does not constitute, by itself, undue prejudice.'" (*Wave Loch*, S.D. Cal.)

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倾向性（类型2）
Prejudice, Type II

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法院进一步认为，在PTO复审未决阶段，被告继续从事诉称的侵权行为，若在此中止案件将使LG遭受实质性的伤害。（LG 特拉华州区）

"The Court further finds that to impose a stay at this juncture would subject LG to substantial prejudice during the pendency of the PTO reexamination in the form of continuing, allegedly infringing activity by the Defendants." (*LG*, D. Del.)

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简单化（类型1）
Simplification, Type I

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- 从统计上讲，至少一些诉求的专利权利要求被复审撤销的可能性较大。PTO在大约64%的专利复审中至少修改了一些权利要求。在大约11%的案件中，PTO撤销了全部权利要求。在大约25%的案件中，PTO维持了全部的权利要求。虽然法院并不受PRO决定的约束，但是PTO的专业意见是有说服力的，并能在解决该问题的过程中节省双方和法院的时间、人力和花费。
- "Statistically, the odds favor at least some of the asserted claims being cancelled by reexamination. The PTO changes at least some claims in approximately 64% of patent reexaminations. It cancels all claims in approximately 11% of the cases and only confirms all claims in 25% of the cases. And while the Court is not bound by the PTO's determination, its expertise is persuasive, and would likely save the parties and the Court considerable time, effort, and expenditure in resolving this matter." (*Yodlee*, N.D. Cal.)

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Simplification, Type II

At Wilmington this 18th day of February, 2009, having considered defendants' motion to stay and the papers submitted in connection therewith;

IT IS ORDERED that said motion (D.I. 46) is denied. It is the rare case[1] in which a reexamination proceeding concludes in a reasonable time and actually changes the character of the case. There is nothing about the reexamination proceeding referenced in the above motion that indicates this is that rare case. Of course, the motion is denied

[1] I cannot recall having experienced such a case, despite my 18 years on the bench.

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简单化（类型2）

2009年2月18日，在Wilmington, 已经考虑了被告的中止请求及其所提交文件。

法院裁定动议（D.L.46）被拒绝。一项专利法复审程序在一个合理的时间内结束并实际上改变了案件的性质是非常少见的案件。（我虽然有18年的法官经验，但从未经历此类案件。）上述提及的动议与专利复审程序无关，仅用于指明该类案件非常少见。当然，动议被拒绝。

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时间（类型1）
Timing, Type I

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- 当法院第一次得知原告意图依靠四项在先技术的参考文献后，法院陷入了麻烦。......被告等待了15个多月才基于这些参考文献提起复审，而在设定双方关于责任的决定性动议听证之前一周内才提出中止请求。这些行为是有目的性的，即使不能完全证实，也可指其为拖延战术。虽然存在这样的看法，但是事实上损害的发现程序没有开始，庭审日期也没有设定，这样，依据上述列举的法律方面的考虑，这一情况会对有利于中止的准许。（Speedtrack 加州北区）

- "...the court is troubled that after first learning of plaintiff's intention to rely on the four prior art references at issue. . . defendants waited more than 15 months to request reexamination based on those references, and filed their request for a stay a mere week prior to the date set for hearing on the parties' dispositive motions as to liability. These actions are suggestive, even if not conclusive proof, of dilatory tactics. Notwithstanding this observation, however, the fact remains that neither the commencement of damages discovery nor the setting of a trial date has yet occurred, and pursuant to the legal considerations outlined above, this factor tips in favor of granting a stay." (*Speedtrack*, N.D. Cal.)

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时间（类型2）
Timing, Type II

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- 虽然早在2008年6月前，被告就得知了原告的侵权指控，但是被告并没有提起对涉案专利复审的必要，直到原告不愿意许可其专利且专利诉讼不可避免变得很明显的时候。此外，被告直到对方采取行动的三个月后，并且是在PTO发出了其第一次审查意见通知书后，才提交其中止动议。

- "[a]lthough Defendant has been aware of Plaintiff's infringement accusations since at least June 2008, it made no effort to seek reexamination of the patents-in-suit until it became apparent that Plaintiff was unwilling to license its patents and that litigation was inevitable. In addition, Defendant waited until three months after the action was commenced, and after the PTO issued its First Office Actions, before filing its motion for stay." (*Esco*, N.D. Cal.)

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行政管理
Administrative

- 2006年3月前，15%的双方复审请求会收到“请求不完全通知”
  Prior to March 2006, 15% of all *inter partes* requests were met with a “notice of incomplete request”
- 2006年3月后，超过50%的双方复审请求会收到“请求不完全通知书”
  After March 2006, over 50% of all *inter partes* requests were met with a “notice of incomplete request”
- 现在，该比例大约在70%
  Today the number is probably around 70%

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近期重要案例
Recent Significant Case Law

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概览
Overview

- *Lucent Technologies, Inc. v. Gateway, Inc.*, 580 F.3d 1301 (Fed. Cir. Sept. 11, 2009)
- *Bilski v. Kappos*, No. 08-964 (U.S.) – *cert. granted* 6/1/2009, *oral argument* 11/9/2009
  美国联邦最高法院09年6月1日受理, 09年11月9日口头审理

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Lucent Technologies, Inc. v. Gateway, Inc., 580 F.3d 1301 (Fed. Cir. Sept. 11, 2009)

- 专利覆盖了企业邮件日历中数据采集工具的一个特征
  Patent covered a minor feature incorporated into Outlook－data-picker tool used in the calendar feature
- 地方法院（加州南区） Lower court (S.D. Cal.):
  - 被诉产品：windows outlook
    Accused product was Windows Outlook
  - 陪审团认为微软对间接侵权负有责任
    Jury found Microsoft liable for indirect infringement
  - 基于合理的许可费，应当支付358，000美元损害赔偿金
    Awarded $358 Million in damages, based on reasonable royalty
  - 陪审团没有明确给出该判决基于赔偿率或者许可费率
    Jury did not identify base or royalty rate figure underlying its award decisions
- 联邦巡回上诉法院庭审意见Federal Circuit Panel Opinion
  - **确认了**专利有效并且基于实质性证据做出了侵权判决
    Affirmed patent validity and infringement judgments as supported by substantial evidence
  - **驳回了** 358,000的损害赔偿，因为陪审团对损害赔偿的计算缺乏足够的证据支持
    Vacated $358 million award, ruling that jury's damages calculation lacked sufficient evidentiary support
  - **发回重审** 重新组织合议庭对损害赔偿作出判决
    Remanded case for new trial on damages

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共同侵权
Contributory Infringement

§ 271. 专利侵权

(c) 任何在美国境内销售或许诺销售，或进口已经取得专利权的装置、制成品、组合物、合成物的部件，或用于实施已经取得方法专利权的材料或者设备（属于该方法发明的主要组成部分）的，而且明知上述物品是故意为侵犯专利权而专门制造或者改造的，也明知上述物品不属于基本上不构成专利侵权用途的生活必需品或商品的，应当承担共同侵权责任。

§ 271. Infringement of Patent.

(c) Whoever offers to sell or sells within the United States or imports into the United States a component of a patented machine, manufacture, combination or composition, or a material or apparatus for use in practicing a patented process, constituting a material part of the invention, knowing the same to be especially made or especially adapted for use in an infringement of such patent, and not a staple article or commodity of v commerce suitable for substantial non-infringing use, shall be liable as a contributory infringer.

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Lucent Techs. v. Gateway – Contributory Infringement

- 共同侵权Contributory Infringement
  - 争议焦点： 该"产品"是全部的打包软件还是仅仅是一个执行权利要求所述方法的特定工具
    Issue: whether the "product" is the entire software package or just the particular tool that performs the claimed method
  - 支持观点： 法院驳回了微软的辩驳理由：即出售的产品具有实质的非侵权用途
    Holding: Court rejects Microsoft's argument that the products sold have substantial noninfringing uses
    - 法院解释说：不应当因为"侵权人'在其进口和销售前，将[侵权部件]加在很大的产品中而该产品具有其他额外的，可分离的特征，而允许其逃避作为共同侵权人应当承担的责任'" *Lucent*, 580 F.3d at 1320.
      Court explains that "an infringer 'should not be permitted to escape liability as a contributory infringer merely by embedding [the infringing apparatus] in a larger product with some additional, separable feature before importing and selling it." *Lucent*, 580 F.3d at 1320.
    - 法院认为侵犯的技术特征仅适用于侵权行为，将其包含在一个很大的程序里，未未对该特征的侵权性作任何改变。*Id.* at 1321.
      Court finds that the infringing feature is only suitable for an infringing use and inclusion of the infringing feature within a larger program does not change the feature's ability to infringe. *Id.* at 1321.

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Lucent Techs. v. Gateway – One Lingering Issue 遗留问题

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- 确定显而易见性的标准，其中现有技术是专利局从来没有考虑过的
  Standard to establish obviousness where prior art was never considered by the PTO
  - 微软请求联邦巡回上诉法院全体法官对一项专利的显而易见性的通过标准进行审查，寻找优势证据标准以设定显而易见性，从而取代现在的"清楚且令人信服"的标准
    Microsoft has petitioned for *en banc* Federal Circuit review of the standard to prove obviousness of an invention, seeking a preponderance of the evidence standard to establish obviousness instead of the current "clear and convincing" standard
  - 这个问题最终可能要到美国最高院才能有结论
    This issue may ultimately find its way to the U.S. Supreme Court.

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Lucent Techs. v. Gateway – 损害赔偿

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- 损害赔偿
  - 合理的许可费分析
    - 法院陈述了他的对*Georgia-Pacific相关因素的*分析过程
    - 因素2: 实际许可费率——是否足够相似从而可以适用？
      - Lucent没有证明他们依赖的（其他）许可足以用作类比从而支持3.58亿美元的赔偿额
    - 因素10和13: 双方在模拟谈判中如何确定专利价值？
      - 法院： 专利仅覆盖了一个很大程序的很少一部分，并且可被归因于侵权使用的利益部分是非常小的。
    - 因素11： 专利发明的得到多大的使用？
      - 法院： 侵权后的证据可以体现损害赔偿的计算，Lucent负有举证责任，证明侵权方法多大程度上得到使用以支持他的损害赔偿请求。从某种角度说，损害赔偿应与消费者使用侵权方法的程度相关。

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Lucent Techs. v. Gateway – Damages

- Damages
  - Reasonable royalty analysis
    - The Court performed a thorough analysis of the relevant *Georgia-Pacific* factors
    - Factor 2: actual license rates – similar enough to apply?
      - Lucent did not prove that the licenses relied on were sufficiently comparable to sustain the $358 million award.
    - Factors 10 & 13: how would parties have valued the patented feature during the hypothetical negotiation?
      - Court: patent covers a minor aspect of a much larger software program and the portion of the profit that can be attributed to the infringing use is exceedingly small.
    - Factor 11: how much has the patented invention been used?
      - Court: post-infringement evidence can inform the damages calculation, Lucent has the burden of providing the extent to which the infringing method has been used to support its damages calculations. The damages award should be correlated, in some respect, to the extent the infringing method is used by the consumers.

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*Lucent Techs. v. Gateway - EMV*规则

- 整体市场分析
  Entire market value analysis
  - 从理论上讲，只有当专利特征构成消费者需求的基础时（该方法）才适用: "一方面讲，我们的法律对整体市场价值的规定非常清晰。若想使用整体市场价值规则，专利被许可人必须证明'专利相关的特征是消费者需求的基础'" *Lucent*, 580 F.3d at 1336.
    In theory, can only be used when the patented feature constitutes the basis for customer demand: "In one sense, our law on the entire market value is quite clear. For the entire market value rule to apply, the patentee must prove that 'the patent-related feature is the "basis for customer demand."'" *Lucent*, 580 F.3d at 1336.
  - 但是，只要许可费率是在"可以接受的范围"内，可以使用全部商业产品的价值: "对使用产品的全部市场价值没有问题，尤其是当侵权元素或特征的市场价格尚未设定的时候，只需要相关的系数体现了侵权元素或特征在基数中的比例即可" *Id.* at 1339.
    But, so long as the royalty rate is in an "acceptable range," the value of the entire commercial embodiment can be used: "There is nothing inherently wrong with using the market value of the entire product, especially when there is no established market value for the infringing component or feature, so long as the multiplier accounts for the proportion of the base represented by the infringing component or feature." *Id.* at 1339.

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Lucent Techs. v. Gateway - Ramifications意见分歧

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- 许多产品是有很多项组成的，意味着将有上千件专利
  Many products comprise multiple components implicating thousands of patents
- 使用其中一项，其侵权使用仅仅适于在一个大的产品中，也会导致共同侵权的认定
  Use of one component that is only suitable for infringing use within a larger product can result in a finding of contributory infringement.
- 但是，如果法院继续推行专利元素得推动消费需求的原则，获得较大的损害赔偿会相对较难
  But, large damages awards will be more difficult if the courts continue to enforce the requirement that the patented component must drive demand.

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Bilski v. Kappos

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- *Bilski v. Kappos*, No. 08-964 (U.S.)
  - 最高院2009年6月1日受理此案
    - 除了申请人提交的简述外还有60份简述建议
    - 2009年11月9日举行口审
  - <u>拟澄清的问题</u>：
    1. 联邦巡回法院是否错误的认为方法必须与特定设备或器材结合，或将特定物质由一个形态转变到另一形态（设备或转化测试法）才符合美国专利法101项可专利性的要求，尽管近期本法院的判决除了对自然规律、物理现象和抽象概念外，拒绝对法定可专利性的范围作限制。
    2. 联邦巡回法院的"设备或转化测试"的可专利性测试法，其实际上将很多具有影响的商业方法专利排除在保护范围之外，这一测试法是否与国会的专利保护从事商业的方法的意向相抵触。' 35 U.S.C. § 273."

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Bilski v. Kappos

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- *Bilski v. Kappos*, No. 08-964 (U.S.)
  - Supreme Court granted *cert*. on 6/1/2009
    - Petitioner's brief and more than 60 additional amicus briefs filed.
    - Oral argument is heard on 11/9/2009.
  - Questions Certified:
    1. "Whether the Federal Circuit erred by holding that a 'process' must be tied to a particular machine or apparatus, or transform a particular article into a different state or thing ('machine-or-transformation' test), to be eligible for patenting under 35 U.S.C. § 101, despite this Court's precedent declining to limit the broad statutory grant of patent eligibility for 'any' new and useful process beyond excluding patents for 'laws of nature, physical phenomena, and abstract ideas.'"
    2. "Whether the Federal Circuit's 'machine-or-transformation' test for patent eligibility, which effectively forecloses meaningful patent protection to many business methods, contradicts the clear Congressional intent that patents protect 'method[s] of doing or conducting business.' 35 U.S.C. § 273."

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Bilski v. Kappos
Petitioner's Brief请求人意见

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- 诉称联邦巡回法院的强制性"设备或转化"测试，与专利法第101条、最高法院判例以及专利法273条立法意图相抵触。
  Argues that the Federal Circuit's mandatory "machine-or-transformation" test conflicts with 35 U.S.C. § 101, Supreme Court precedents, and legislative intent of 35 U.S.C. § 273.
- 宣称"设备或转化"测试是了一个跟不上时代的测试，其设立了的新政策不再站在技术中立的立场。
  Asserts that the "machine-or-transformation" test legislates new policy by embracing an anachronistic test that no longer holds a technology-neutral position
  - 关于可能模糊或者微不足道的商业方法专利，最好由专利性的其他要求进行规范
    Concerns over potentially vague or trivial patents for business methods are better addressed by the other requirements for patentability
- 促使最高法院重新确立对涉及基本原理的发明（可专利性）的"实践应用"规则
  Urges the Supreme Court to reaffirm the "practical application" rule for inventions involving fundamental principles
- 诉称最高法院应该推翻联邦法院的决定，因为Bilski的方法权利要求是可专利的客体，其援引了一个数学方程式的实际应用。
  Argues that the Supreme Court should reverse the Federal Court decision because the Bilski method claim is patentable subject matter which recites a practical application of a mathematical equation.

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Bilski v. Kappos
Government's Brief政府意见

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- 专利法101条保护工业和技术工艺，将人类活动的方法排除在外 § 101 protects industrial and technological processes but excludes methods directed to organizing human activity.
  - 101条，虽然被广泛的应用，却对专利保护范围上具有有意义的限制 § 101, though broadly applied, imposes meaningful limits on scope of patent protection.
  - 专利法101条所说的"工艺"，包括了工业和技术工艺，但将人类活动的方法排除在外。Term "process" in § 101 encompasses technological and industrial processes, but excludes methods of organizing human activity.
- 专利法101条中的可专利工艺，涉及的是一项特定设备或器材的运行或产生将物质有一种状态转变到另一种状态的效果Patent-eligible "process" under § 101 concerns the operation of a particular machine or apparatus or effects a transformation of matter into a different state or thing.
- 专利法273条并没有暗示扩大专利法101条可专利性客体的种类 § 273 does not implicitly expand the categories of patent-eligible subject matter in § 101.
- 联邦巡回法院正确地根据专利法101条拒绝了申请人的对冲金融风险的方法专利申请
- Federal Circuit correctly rejected petitioner's claimed method of hedging financial risk under § 101.

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Bilski v. Kappos
Oral Arguments: Bilski & Warsaw

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- The "machine-or-transformation" test has no basis in the statute and is inconsistent with Supreme Court precedent.
  - "Section 101 should be read broadly to accommodate unforeseen advances in the useful arts."
  - Congress carved out defenses to infringement:
    - § 273 (prior user rights for **business methods**) and
    - § 287(c) (medical activities)
- Patent-eligible subject matter should be very broadly defined based on the statute and Congressional intent.

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Bilski v. Kappos
Oral Arguments: Bilski & Warsaw

- The machine-or-transformation test is too rigid:
  - It fails to consider future innovations by limiting patent eligibility to things that are physical.
  - The transformation debate places form over substance. The innovative process is "rooted in the real world" as long as it involves physical steps.
- Other bars to patentability (*i.e.*, novelty, non-obviousness, usefulness) exist.

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Bilski v. Kappos
Summary of Oral Argument

- The Court should decide this case narrowly by
  - Approving the machine-or-transformation test, which "doesn't solve all the hard questions,"
  - But "leave open the possibility" that a new invention could create an exception.
  - The Court should not "in the area of software innovations or medical diagnostic techniques [try] to use this case as the vehicle for identifying the circumstances in which innovations of that sort would and would not be patent eligible. . . ."

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Bilski v. Kappos
Oral Arguments: Appropriate Test?

- Justices' questions suggest skepticism about business method patents
  - Questions suggest view that not all business processes should be patentable (e.g., tax strategies, insurance tables, teaching approaches, alphabets, fine arts, speaking, jury selection, corporate takeovers, etc.)
- Tests discussed
  - Machine or transformation test
  - "Useful arts" (invention must be technological)
  - Useful, concrete, tangible result
- Justices appeared concerned about a test that would leave a back door open to business method patents
  - Predicated on the notion that business method patents would be found ineligible?
- Novelty in the machine/transformation as a requirement?
  - Cf. Alapatt

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Bilski v. Kappos
Conclusions

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- Justices expressed strong skepticism about patent eligibility of pure business methods (e.g., Bilski type claims)
  - Some Justices that previously supported broad reading of Section 101 seemed critical of pure business method patents
- Views on patent eligibility of software less clear
  - Appears to be some support for broad patent eligibility of software and medical innovations
  - Appears to be little support for patent eligibility of business methods
  - Concern about software patents as back door for business method patents
  - To what extent is implementation in a general purpose computer sufficient to satisfy Section 101?

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谢谢！ Thank you!

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企业知识产权的策略与保护

主讲：温旭 教授

▪ 中国律协知识产权专业委员会	副主任
▪ 中国高校知识产权研究会	副理事长
▪ 国务院授予有突出贡献的	中青年专家
▪ 美国西雅图华盛顿大学法学院	访问学者
▪ 台湾政治大学科技法律研究中心	客座研究员
▪ 北京大学知识产权学院	客座研究员
▪ 中山大学知识产权学院	教授
▪ 暨南大学知识产权学院	研究员
▪ 重庆邮电大学法学院	特聘教授
▪ 三环知识产权集团	董事长

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新专利法实施对知识产权保护环境的影响

如何应对新专利法框架下知识产权保护的挑战

知识产权保护案例分析（创造性）

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新专利法实施对知识产权保护环境的影响:

机遇：创新成果得到有力保护
专利的价值进一步得到体现

挑战：跨国公司进一步构建专利壁垒
技术突破变得更加困难

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如何应对新专利法框架下知识产权保护的挑战:

增强专利保护意识
熟悉国内外专利游戏规则
加大研发投入，合理布局专利
积极应对专利纷争

典型案例分析:
(一) 眼镜案

专利名称：眼镜附属镜框结合构造

专　利　号：97106767.8

上　诉　人：国家知识产权局

赵浩志

被上诉人：黄炳焯

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主权项：

一种眼镜附属镜框结合构造，包含有一主镜框（１０），其两侧可供枢接脚架（１２），以及一附属镜框（２０）系结合至主镜框（１０）上，主镜框（１０）和附属镜框（２０）的中间各设一桥接元件（１３、２０）可供将镜片环框或直接将镜片连结在一起；其特征在于：在主镜框（１０）的桥接元件（１３）设有至少一第一磁性元件（１４），该附属镜框（２０）亦在其桥接元件（２０）上设有至少一第二磁性元件（２４）而可和主镜框（１０）的第一磁性元件（１４）相互吸引，使得该附属镜框（２０）可以利用单一只手即可快速又稳固地吸附固定至该主镜框（１０）上。

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争议焦点：

多点式结合变一点式结合是否具有创造性？

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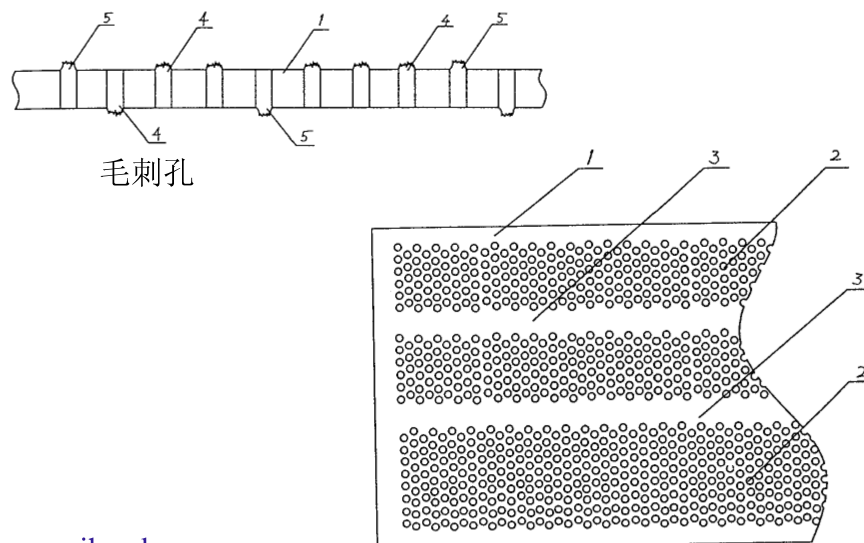
(二) 电池案

权利要求1:
一种电池极板用穿孔钢带，为带状结构，带面上具有穿孔带面上的穿孔纵向成组分布，每组穿孔间为带状过渡区每组穿孔为圆形或异形孔纵向、横向穿孔交错排列，每组穿孔的孔径范围为Φ0.5～4.0毫米，穿孔的纵向与纵向间距为1.0～4.0毫米，横向与横向间距为1.0～5.0毫米，所用钢带厚度为0.01～0.1毫米，宽度为10～350毫米，穿孔口具有毛刺孔（4）。



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(三) 东鹏洞石案

具有特殊结构产品的专利创造性的判断

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捍卫智慧-没有硝烟的战场

—近几年十大诉讼成功案例简析

（一）“索尼”诉“步步高”**DVD**外观专利侵权案
成功要点：抢回诉权， 击中要害

（二）“晶艺”诉“深圳机场”、“白云机场”、“西安机场”
专利侵权案
成功要点：经营使用，构成侵权

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（三） 组合眼镜发明专利是否具有创造性无效案
成功要点：反向思维，有论有据

（四）“无锡电池”与“深圳电池”专利侵权与无效案
成功要点：重点突破，全面突围

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（五）北京某博士诉广州某博士“博士论文”侵权案
成功要点：证据反用，巧破死结

（六）“佛山日丰”与“上海日丰”商标侵权之诉
成功要点：企业名称，突出使用

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（七）广州星群与广东星群企业名称之诉

成功要点：曾经合作，具有恶意

（八）“诸葛酿”与“诸葛亮”酒谁是谁非

成功要点：在先权利，依法保护

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（九）“广州立白”购买“重庆奥妮”商标独立许可纠纷案

成功要点：未曾备案，合同存假

（十）“香港荣华”与“苏氏荣华”荣华品牌争夺战

成功要点：诚实信用， 皇帝条款

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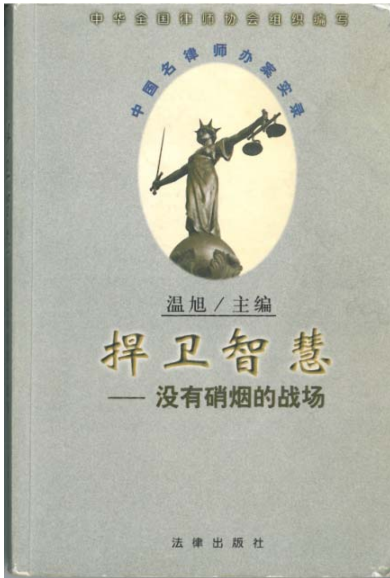

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