

美国律师协会反垄断法部、知识产权法部和国际法部关于
《最高人民法院关于审理侵犯专利权纠纷案件应用法律若干问题的解释
(二)》
(公开征求意见稿)
的意见与建议

2014年8月29日

声明：本意见书仅代表美国律师协会反垄断法部、知识产权法部和国际法部的观点，没有经过美国律师协会会员代表大会或理事会的批准，因此不应被视为代表美国律师协会的立场。

美国律师协会反垄断法部，知识产权法部和国际法部（“我们”）感谢此次就《最高人民法院关于审理侵犯专利权纠纷案件应用法律若干问题的解释（二）》（公开征求意见稿）（“《征求意见稿》”）提交意见的机会¹。我们赞赏最高人民法院（“最高院”）为提高司法透明度、指导司法实践而做出的努力，也感谢此次提交意见的机会。第一条、第十条和第二十四条的相关意见代表且仅代表知识产权法部和国际法部的观点，不代表反垄断法部和美国律师协会的观点。反垄断法部仅联合其他两部门就第二十七条和第三十条提出意见与建议。我们提交的意见反映了本部门成员在美国和其他法域知识产权法和竞争法方面的专业知识和实践经验。

第一条

第一条规定，权利要求书有两项以上权利要求的，权利人应当在起诉状中载明据以起诉被诉侵权人侵犯其专利权的权利要求。起诉状对此未记载或者记载不明的，人民法院应当要求权利人明确；经释明，权利人不予明确的，人民法院可以推定权利人选择全部的独立权利要求。要求权利人明确被侵犯的权利要求的做法在美国尚存在争议。知识产权法部和国际法部建议，如果不这样要求的话，可能会鼓励滥诉，从而浪费有限的司法资源，而如果强制增加此项要求，则会阻碍正常的诉讼，尤其是侵权相关的细节通常由被诉侵权人掌握。²美国的证据开示规则尚较为开明，在证据开示规则远比美国封闭的法律体系中，上述要求引发的担忧可能会进一步加剧。³另一方面，只要有理由相信发生侵权，专利权人就可以声称所有权利要求被侵犯，本条规定也就没有实际作用了。如果坚持施行此项规

¹我们的意见与建议以《征求意见稿》的非官方翻译版为基础。《征求意见稿》非官方翻译版详见附件一。2014年8月15日，我们提交了关于最高人民法院关于修改《最高人民法院关于审理专利纠纷案件适用法律问题的若干规定》的决定（公开征求意见稿）的意见书，详见附件二。

²关于专利案件中释明权利要求争议的讨论，参见 M. Andrew Holtman 等, *Avoiding Dismissal in Patent Infringement Cases: An Update on the Twombly/Iqbal Pleading Standard*, No. 5 26 *Intell. Prop. & Tech. L.J.* 10 (2014) 及 Jonathan L. Moore, *Particularizing Patent Pleading: Pleading Patent Infringement in A Post-Twombly World*, 18 *Tex. Intell. Prop. L.J.* 451, 453 454, 469-506 (2010)。

³即便在美国，相关争议在于难以知晓哪些权利要求被侵犯了。如果一个产品涵盖了几项权利要求，专利权人可以购买该产品，在提起诉讼前对其进行检验。但是，仅仅是简单地观察一个产品，基本无法确定制造该产品所使用的权利要求是否被侵犯。证据开示允许更进一步的事实调查。见 M. Andrew Holtman, et al., 26 *Intell. Prop. & Tech. L.J.* 第 14 页。

定，那么为实现有序的司法管理，应当规定权利人没有正当理由拒绝明确被侵犯的权利要求的法律后果。因此，如果保留此项要求，知识产权法部和国际法部建议，除非权利人证明因不可控的因素导致其在诉讼的特定阶段无法明确被侵犯的权利要求，否则应当驳回诉讼。但权利人能够明确被侵犯的权利要求的，可以再次起诉。⁴如若不然，权利人就可以在没有正当理由下无视此项要求以及法院的要求，继续诉讼。这样的话，建议不设置此项规定。

第十条

第十条提供了有关功能性特征的规定。第十条第二款规定了以专利申请日为时间节点判断相应技术特征是否相同的标准，规定与专利的技术特征相比被诉侵权技术方案的相应技术特征是以基本相同的手段，实现相同的功能，达到相同的效果，人民法院应当认定该相应技术特征与功能特征相同。该条款似乎为确定功能性特征直接侵权设置了一个标准，即以专利申请日为时间节点进行判断，以与专利复审委员会保持一致。第十条第三款规定当与专利的技术特征相比被诉侵权技术方案的相应技术特征是以基本相同的手段，实现基本相同的功能，达到基本相同的效果时，法院应当以专利申请日后、被诉侵权行为发生日以前为时间节点认定等同。该款似乎为功能性权利要求设立等同原则。是否需要以及如何为功能性权利要求划定标准存在着很大的争议。⁵如果为功能性权利要求设立一个标准，那么怎样的标准才是合适的也是一个具有争议的问题。第十条的两款规定提供了一种异于美国和其他发达专利司法体系的方法，这些司法体系在处理功能性权利要求问题时，会审查专利本身，根据发明主题、新颖性、非显而易见性/创新性以及实用性的通用标准对其进行考量。⁶第十条第三款设立的标准可通过判定以基本相同的手段，实现基本相同的功能，达到基本相同的效果的技术特征侵权来促进侵权诉讼的审理。此外，第二款和第三款中“本领域普通技术人员无需经过创造性劳动就能够联想到”的判断标准涉及非显而易见性进而涉及有效性问题，这两个问题本不应在此涉及。

第二十四条

第二十四条规定，对于将依照专利方法直接获得的产品进一步加工、处理而获得的后续产品，进行再加工、处理的，人民法院应当认定该行为不属于专利法第十一条所称的使用依照该专利方法直接获得的产品。⁷该条规定似乎是为了与 2010 年实施的《最高人民法院关于审理侵犯专利权纠纷案件应用法律若干问题的解释》第十三条第二款规定的行为

⁴为了体现美国法院在专利纠纷案件中如何处理此类问题，参见 *Actus, LLC v. Bank of Am. Corp.*, No. 2-09-cv-102-TJW, 2010 WL 547183 (E.D. Tex. 2010 年 2 月 10 日); *Teirstein v. AGA Med. Corp.*, No. 6:08cv14, 2009 WL 704138, at *3 (E.D. Tex. 2009 年 3 月 16 日); 和 *K-Tech Telecomms., Inc. v. Time Warner Cable, Inc.*, 714 F.3d 1277 (Fed. Cir. 2013) (根据最高法院在 *Iqbal* 和 *Twombly* 案中规定的标准讨论表 18)。

⁵见 Mark A. Lemley, *Software Patents and the Return of Functional Claiming*, 2013 Wis. L. Rev. 905 (2013); Stephen Winslow, *Means for Improving Modern Functional Patent Claiming*, 98 Geo. L.J. 1891 (2010).

⁶见 John F. Triggs, *Functional Claiming: § 112 ¶ 6 Still Difficult After All These Years*, 3 *Landslide* 30 (2011); Winslow, 98 Geo. L.J. 1891. 见前注 5。

⁷《专利法》第十一条定义了“依照该专利方法直接获得的产品”。《专利法》（中华人民共和国全国人民代表大会常务委员会于 2008 年 12 月 27 日公布，2009 年 10 月 1 日生效）为本文所指《专利法》。

相区分，即“对于将上述原始产品进一步加工、处理而获得后续产品的行为,人民法院应当认定属于专利法第十一条规定的使用依照该专利方法直接获得的产品”。

然而，第二十四条规定的行为是否间接侵犯了专利方法尚存在疑问。⁸此外，尽管第二十四条没有提及销售，但是根据权利利用尽原则，可以将该条款解释为对依照专利方法直接获得的产品进行进一步加工或处理的行为已经耗尽了专利权，专利权不再覆盖对于后续产品进行进一步加工或处理的行为。因此，如果最高院认为对后续产品进行处理或加工的行为既不直接也不间接侵犯专利权利要求，知识产权法部和国际法部建议应当修改第二十四条，明确规定该等行为不构成侵权。

第二十七条

自愿的、行业主导的、达成一致意见的标准制定活动在推动创新、提高效率、丰富消费者选择、降低价格、提高产出方面起到重要的作用。然而，集体性的标准制定并非没有风险。尤其是，为了减少标准制定后市场力机会主义发挥作用所带来的风险，很多标准制定组织要求希望加入标准制定过程的主体披露他们拥有的对执行标准必不可少的专利并且自愿承诺将其标准必要专利按照公平、合理和非歧视（F/RAND）原则进行许可。自愿的 F/RAND 承诺通过确保标准实施者在不受专利许可费挟持情况下能够被允许制造采用标准的产品并且专利权人能够为其创新收取基于市场的合理补偿，从而平衡集体标准制定过程中参与者之间的利益。专利权人能够通过将标准必要专利按照 F/RAND 原则进行许可获得利益，因为如果专利权人的专利技术被标准采纳并且该标准得以广泛采用，那么专利权人便可通过更高的销售量收取许可费。而从另一个角度看，基于 F/RAND 原则的技术许可促进了标准的采用，这推动了进一步的创新和提高了消费者福利。然而，无论美国还是欧盟的法律都没有对未参加标准制定过程的公司提出基于 F/RAND 原则进行许可的要求。考虑到在专利期间排除他人使用其发明是专利权人最基本的权利，F/RAND 承诺只限于专利权人自愿加入并服从标准制定过程的情形至关重要。与之相反的规定将破坏专利权人发明的价值并且打击创新。

第二十七条第一款第一句规定非强制性国家、行业或者地方标准明示“所涉专利”的信息，被诉侵权人以其实施该标准而无需专利权人许可为由主张不构成专利侵权的，人民法院一般不予支持。我们建议对该句进行修改，明确“所涉专利”是指经专利权人自愿同意被标准采纳的“标准必要专利”。此外，我们建议修改第一句规定由法院确定专利是否事实上对标准是必不可少的，同时规定被诉侵权人有机会提供证据证明不侵权。

第二十七条第一款第二句规定专利权人违反 F/RAND 原则，就专利实施许可条件恶意与被诉侵权人协商，被诉侵权人据此主张不停止实施行为的，人民法院一般应予支持。对此，我们建议对该款第二句作出如下修改：

⁸根据美国法律 35 U.S.C. §271(g)，使用依照专利方法直接获得的产品构成侵权，因此销售依照专利方法直接获得的产品可构成间接侵权。

- (1) 明确该规定仅适用于专利权人已经明确自愿承诺按照 F/RAND 原则许可其标准必要专利；
- (2) 明确专利权人有权就被诉侵权人使用其专利技术获得适当赔偿；
- (3) 规定当被诉侵权人拒绝符合 F/RAND 原则的实施许可要约，或者无正当理由推迟协商而导致与拒绝要约同样的后果时，法院应当禁止被诉侵权人继续实施标准；并且
- (4) 明确被诉侵权人对专利权人恶意协商负有举证责任，并明确哪些情况属于专利权人违反 F/RAND 原则进行恶意协商，使得如果同意人民法院或者双方确定的仲裁庭裁决 F/RAND 许可条件，则标准必要专利持有人不会被认定为“恶意”。

对于确保标准实施活动不会导致未经专利权人同意而侵犯专利技术，以及避免造成专利权人在中国的义务与在其他法域的义务严重不一致而言，上述第一条修改建议十分必要。⁹例如，欧盟委员会关于对纵向协议适用《欧盟运行条约》第 101 条指南（“第 101 条指南”）中规定，标准制定组织的知识产权政策应当包含 F/RAND 原则，但同时强调加入标准制定组织是自愿行为，第 101 条指南明确指出专利权人有权将其专利排除在标准制定过程之外，从而无需就其专利的许可作出任何承诺。¹⁰美国的反垄断机构同样鼓励但并不强迫标准制定组织采纳 F/RAND 原则，以利用标准促进后续创新。¹¹与之相反的政策则会阻碍企业在中国境内的国际投资和创新。

对通过保护创新人员从其研发投入和新产品商品化中获得利益的能力来推动创新而言，第二条修改建议至关重要。如果剥夺一个标准必要专利权利人就其发明获得利益的权利，将使其丧失参与标准制定过程的动力并损害创新，例如，限制了标准的稳健性和技术进步。

第三条修改建议对于解决反向挟持(又名 hold-out)问题十分必要，例如，使用标准必要专利的一方无正当理由拖延 F/RAND 原则实施许可的善意协商的情形。正如美国和欧盟反垄断机构所解释的那样，禁令性救济在某些情形下是一种适当的救济方式，例如当被诉

⁹我们建议强制适用 F/RAND 承诺与中国专利法的基本原则不符。根据《专利法》第十一条，专利权人有权决定如何行使其专利权。

¹⁰见 Guidelines on the Applicability of Article 101 of the Treaty on the Functioning of the European Union to Horizontal Co-operation Agreements, 2011, O.J. (C 11) 1, 第 285 段; 原文见 <http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:C:2011:011:0001:0072:EN:PDF>; 见 Competition Directorate-General, European Commission, Standard-essential patents, COMPETITION POLICY BRIEF 第 3, 5 页(2014 年 6 月), 原文见 http://ec.europa.eu/competition/publications/cpb/2014/008_en.pdf.

¹¹见美国司法部和美国专利商标局颁布的 Policy Statement on Remedies for Standard Essential Patents Subject to Voluntary F/RAND Commitments, 第 5-6 页, 2013 年 1 月 8 日, 原文见 <http://www.justice.gov/atr/public/guidelines/290994.pdf> (“DOJ-PTO Policy Statement”)。

侵权人拒绝或事实上拒绝接受根据 F/RAND 原则的实施许可，或者拒绝就 F/RAND 条款进行善意协商。¹²

第四条修改意见就何种行为构成 F/RAND 许可条款的恶意协商，为标准必要专利权利人提供了必要的指引。据我们所知，目前还没有法院或竞争执法机构试图定义何为 F/RAND 下的恶意协商，但是法院和政府机构已经确定了何为有意愿的被许可方。这些为确定哪些情形不构成“恶意”提供了指引。例如，欧盟在禁令性救济中创造了“安全港”方法，根据该方法，如果标准实施者同意，当协商失败时，由法院或者经双方同意的仲裁员判定 F/RAND 条款，即证明了自己是有意愿的被许可人。¹³根据上述规则，我们建议修改第二十七条，至少应当明确，当标准必要专利权利人同意由法院或者双方当事人同意的仲裁员决定 F/RAND 条款时，该标准必要专利权利人不当被认定为存在“恶意”。

第二十七条第二款规定经充分协商仍无法达成一致的，可以请求法院确定专利许可条件。首先，我们请求最高院认可，专利许可条件通常应当通过当事人协商决定。然而，正如第二十七条中所提到的，这种协商可能会失败。为了解决这种有限的情形，我们建议修改第二款，明确规定在标准必要专利权利人没有就其标准必要专利主张权利或者没有做出此类威胁的情况下，标准实施者无权单方面请求法院决定 F/RAND 许可费率或者其他 F/RAND 许可条款。如果不这样修改，标准实施者将缺乏就 F/RAND 条款进行私下协商的动机，反而更有动机直接请求法院决定 F/RAND 许可条件作为其首选的救济措施。

我们还建议在第二十七条中明确规定判断是否构成“充分协商”的客观标准。鉴于善意协商应当是解决此类问题的首选方案，这样的标准十分重要。否则，专利人和侵权人均有动机在耗尽协商方案之前即过早地直接采用诉讼方式，这种行为即等同于挟持，相应地也增加了司法系统的负担。因此，该术语的明晰可确保善意协商被充分利用。我们建议修改第二十七条以要求法院在决定许可条件时重造当事人之间的假想的协商并且考虑市场因素的证据，例如，具有合理许可费的类似可比的实施许可（同样的专利或者其他类似的专利）。¹⁴

¹²同上，第 7 页（涉及“事实上拒绝谈判”的行为类型）。见 Decision and Order at 8 § II.E, In the Matter of Motorola Mobility LLC, and Google Inc., FTC Docket No. C-4410 § II.E (2013 年 7 月 23 日)，原文见 <http://ftc.gov/os/caselist/1210120/130724googlemotorolado.pdf> (该等行为被称为“事实上拒绝谈判”或者“不愿意接受根据 F/RAND 原则进行许可”)。国际贸易委员会的意见第 63 页，关于某些电子设备，包括无线通信设备，便携式音乐和数据处理设备以及平板电脑，Inv. No. 337-TA-794，USITC Pub. 512742 (2013 年 6 月 5 日)将反向挟持定义为，当标准实施者假装专利权人的要约不公平或者不合理，使用声称是必要的专利却拒绝向专利权人支付费用时的一种昂贵诉讼)。

¹³Memorandum from the European Commission MEMO/14/322, “Antitrust decisions on standard essential patents (SEPs) - Motorola Mobility and Samsung Electronics - Frequently asked questions” (2014 年 4 月 29 日)，原文见 http://europa.eu/rapid/press-release_MEMO-14-322_en.htm。另见 DOJ-PTO Policy Statement 见前注 11; Brief for FTC as Amicus Curiae Supporting Neither Party, Apple Inc. and NeXT Software, Inc. v. Motorola, Inc. and Motorola Mobility, Inc., Nos. 2012-1548, 2012-1549 at 7-9 (Fed. Cir. Dec. 4, 2012), available at http://www.ftc.gov/sites/default/files/documents/amicus_briefs/apple-inc.and-next-software-inc.v.motorola-inc.and-motorola-mobility-inc./121205apple-motorolaamicusbrief.pdf。

¹⁴参见我们关于最高人民法院关于修改《最高人民法院关于审理专利纠纷案件适用法律问题的若干规定》的决定（公开征求意见稿）的意见书（2014 年 8 月 15 日），附件二。

第三十条

第三十条在侵权人停止实施相关专利会（1）损害社会公共利益；或者（2）导致当事人之间的利益严重失衡的情况下，为权利人设置了强制许可义务。

强制许可义务极有可能抑制创新，损害消费者和社会整体的利益。例如，如果剥夺发明人排除他人使用专利技术的权利，强制许可规定很可能导致发明人停止投入高风险和高成本的研究开发。那些原本可以使用专利技术的产品的技术质量将会降低，基于该技术的产品的制造和销售的竞争将被制止，而对该种产品的需求也将减少。

我们请求最高院删除施加强制许可的第二种情形（即，删除“或导致当事人之间的利益严重失衡”），并且明确对“损害社会公共利益”的判定应当谨慎并基于与商业利益无关的具体列举的因素。¹⁵此外，为履行《与贸易有关的知识产权协定》（“《知识产权协定》”），我们建议最高院对第三十条进行修改，明确“除非处于国家紧急状态，或在其他极端紧急情况下，或为非商业性公共用途”，只有“在实施相关专利前，意图实施者已经努力向权利持有人请求按照合理的商业条款和条件获得许可，但在合理期限内未能成功”的情形下，未经权利人同意的专利实施行为才被允许，即强制许可。¹⁶最后，为了履行《知识产权协定》第三十条（c）项，我们建议最高院对《征求意见稿》第三十条进行修改，明确“该实施行为的范围及期限应当以授权目的允许的范围为限；如果实施的是半导体技术，则仅允许公共非商业使用，或者为经司法或行政程序确认的反竞争行为提供救济的实施行为”。¹⁷

关于合理许可使用费的确定，我们建议最高院修改第三十条，明确规定人民法院将重造双方当事人间假想的谈判，并且考虑具有合理许可费的市场因素的证据，如我们对最高院关于修改《最高人民法院关于审理专利纠纷案件适用法律问题的若干规定》的决定（公开征求意见稿）的意见书中详细阐述的建议（见附件二）。此外，为履行《知识产权协定》第三十一条（h）项，我们建议修改《征求意见稿》第三十条，规定“在考虑相关授权的经济价值的前提下，权利人应根据具体案件的情况获得充分的补偿。”

结论

我们非常荣幸有机会提交我们的意见，在合适的情况下，我们愿意随时为最高院提供补充意见或者与最高院进行进一步的磋商。

¹⁵ 《1883年保护工业产权巴黎公约》第五条为强制许可的有限合理使用提供了指引，中国是该公约成员国。

¹⁶ 如果特定实施行为是经司法或行政程序确认的反竞争行为的救济方式，从而允许该特定实施行为的，成员没有义务适用第三十一条(b)项的规定。同上，第三十一条（k）项。

¹⁷ 此外，我们请求为履行《知识产权协定》，应当修改第三十条，明确“任何根据第三十条授权的实施行为，应当主要用于满足国内市场的供应需求”。《知识产权协定》第三十一条（f）项。

附件

- 1、《最高人民法院关于审理侵犯专利权纠纷案件应用法律若干问题的解释（二）》（公开征求意见稿）非官方翻译版
- 2、美国律师协会反垄断法部，知识产权法部和国际法部关于最高人民法院关于修改《最高人民法院关于审理专利纠纷案件适用法律问题的若干规定》的决定（公开征求意见稿）的意见书（2014年8月15日）

COMMENTS OF THE AMERICAN BAR ASSOCIATION’S SECTIONS OF
ANTITRUST LAW, INTELLECTUAL PROPERTY LAW, AND
INTERNATIONAL LAW ON DRAFT FOR PUBLIC COMMENT OF THE
INTERPRETATIONS OF THE SUPREME PEOPLE’S COURT ON CERTAIN
ISSUES CONCERNING THE APPLICATION OF LAW IN THE TRIAL OF
PATENT INFRINGEMENT CASES (II)

August 29, 2014

The views stated in this submission are presented only on behalf of these Sections of the American Bar Association. These comments have not been approved by the ABA House of Delegates or the ABA Board of Governors, and therefore may not be construed as representing the policy of the Association.

The Sections of Antitrust Law, Intellectual Property Law, and International Law (together the “Sections”) of the American Bar Association (“ABA”) welcome the opportunity to provide comments on the Draft for Public Comment of Interpretations of the Supreme People’s Court on Certain Issues Concerning the Application of Law in the Trial of Patent Infringement Cases (II) (the “Consultation Draft”).¹ The Sections appreciate the Supreme People’s Court’s (“SPC”) efforts to provide increased transparency and guidance, and the opportunity to provide comments. The comments on Articles 1, 10, and 24 are the views of the Sections of Intellectual Property Law (“SIPL”) and International Law (“SIL”) only and do not reflect the views of the Section of Antitrust Law (“SAL”) or the ABA as a whole. SAL joins only the comments on Articles 27 and 30. The Sections’ comments reflect the expertise and experience of its members with intellectual property and competition law in the United States and other jurisdictions.

Article 1

Article 1 provides that when there are two or more claims in the patent, a patentee shall specify in the complaint the infringed claim, and that when a patent holder fails to specify the claim that is infringed despite the court’s instruction to do so, the court may presume that all independent claims are alleged to be infringed. The wisdom of such a requirement is the subject of debate in the United States. SIPL and SIL advise that, while the lack of such a requirement may encourage frivolous infringement claims and waste scarce judicial resources, imposing such a requirement may deter meritorious claims, especially since the details regarding infringement may be in the control of the alleged infringer.² The concerns about such a requirement may be

¹ The Sections’ Comments on the Consultation Draft are based on an unofficial translation, which is appended to these Comments as Appendix 1. On August 15, 2014, the Sections submitted comments on the Public Comment Draft of the Supreme People’s Court’s Decision on Revising Application of the Law in the Hearing of Patent Dispute Cases (“Sections’ JI (I) Comments”), appended as Appendix 2 for ease of reference.

² For discussions of the controversies over the need for specificity in pleading patent cases, *see* M. Andrew Holtman, et al., Avoiding Dismissal in Patent Infringement Cases: An Update on the Twombly/Iqbal Pleading Standard, 26 No.

exacerbated in legal systems where discovery is much more limited than in the United States, which provides expansive discovery.³ On the other hand, a patent holder could specify that every claim has been infringed as long as there is some basis for believing there is infringement, so that a specificity requirement may have little practical effect. If such a requirement is nonetheless imposed, then the orderly administration of justice suggests that there should be consequences for non-compliance that is without justification. Therefore, if such a requirement is imposed, SIPL and SIL respectfully recommend that, unless the patent holder shows that for reasons beyond its control it cannot at that stage of the lawsuit specify the claims infringed, the complaint may be dismissed with the opportunity to file a complaint that does specify the claims infringed.⁴ Otherwise, the patent holder will be permitted to proceed with the lawsuit despite ignoring without any justification the requirements and instructions of the court and it may be better not to establish the requirements to begin with.

Article 10

Article 10 is directed to functional claims. The second paragraph of Article 10 sets forth standards for determining whether the technical features at issue are “identical” at the time of the filing of the patent application, providing that the court should find identity when the allegedly infringing feature “performs the same function in substantially the same way and achieves the same effects” as the patented feature. It appears to establish a standard for finding direct infringement of functional claims, setting the time of filing of the patent application as the reference point for the determination to ensure consistency with the actions of the Patent Examination Office. The third paragraph of Article 10 provides that the court should find equivalence after the filing of the application and before the occurrence of an alleged infringing act, when an allegedly infringing feature “performs substantially the same function in substantially the same way and achieves substantially the same effects” as the patented feature. It appears to establish the doctrine of equivalence for functional claims. The need and wisdom of establishing distinct standards for functional claims is the subject of much debate.⁵ If a distinct standard for functional claims is established, the question of what would be the appropriate distinct standard is

⁵ *Intell. Prop. & Tech. L.J.* 10 (2014), and Jonathan L. Moore, *Particularizing Patent Pleading: Pleading Patent Infringement in A Post-Twombly World*, 18 *Tex. Intell. Prop. L.J.* 451, 453-54, 469-506 (2010).

³ Even in the United States, the controversy over specificity in pleading is based on the difficulty of knowing at the outset what claims are infringed. If the claims cover a product, the patent owner can buy the product and examine it before bringing a complaint. But simply inspecting a product cannot in general detect whether process claims have been infringed. Discovery allows for further factual examination. *See* M. Andrew Holtman, et al., 26 *No. 5 Intell. Prop. & Tech. L.J.* at 14.

⁴ For illustrations of how U.S. courts deal with pleading in patent cases, see *Actus, LLC v. Bank of Am. Corp.*, No. 2-09-cv-102-TJW, 2010 WL 547183 (E.D. Tex. Feb. 10, 2010); *Teirstein v. AGA Med. Corp.*, No. 6:08cv14, 2009 WL 704138, at *3 (E.D. Tex. Mar. 16, 2009); and *K-Tech Telecomms., Inc. v. Time Warner Cable, Inc.*, 714 F.3d 1277 (Fed. Cir. 2013) (discussing Form 18 in regards to the standards set forth in the Supreme Court’s decisions in *Iqbal* and *Twombly*).

⁵ *See* Mark A. Lemley, *Software Patents and the Return of Functional Claiming*, 2013 *Wis. L. Rev.* 905 (2013); Stephen Winslow, *Means for Improving Modern Functional Patent Claiming*, 98 *Geo. L.J.* 1891 (2010).

also subject to debate. These two paragraphs indicate an approach to functional claims that appears inconsistent with that of the U.S. and other developed patent jurisdictions, which address functional claims questions in the reviewing the patent and consider them in light of the common criteria of subject matter, novelty, non-obviousness/inventiveness, and usefulness.⁶ The standard apparently established by the third paragraph of Article 10 may facilitate infringement claims by determining that a technical feature that performs substantially the same function in substantially the same way with substantially the same effects infringes. Moreover, the reference in both paragraphs to “is obvious to an ordinary person skilled in the art without creative efforts” potentially raises the issues of obviousness and therefore validity in a context that would not appear to involve them.

Article 24

Article 24 states that “[w]here a subsequent product derived from the further processing or treatment of a product that is directly derived from the patented method is further processed or treated, a people’s court shall find that the act is not using a product that is directly derived from the patent method as specified in Article 11 of the Patent Law.”⁷ Article 24 appears to be intended to distinguish such acts from those addressed in Article 13.2 of the SPC’s 2010 Interpretations on Certain Issues Concerning the Application of Law in the Trial of Patent Infringement Cases, which provides that “[t]he act of further processing or treatment of a product that is directly derived from a patented method to obtain a subsequent product shall be found by a people’s court as the act of using a product that is directly derived from the patent method as specified in Article 11 of the Patent Law.”

However, it is unclear whether or not the act described in Article 24 indirectly infringes the patented process.⁸ Further, although Article 24 makes no reference to sale, the provision might be interpreted to refer to the exhaustion doctrine, to provide that the further processing or treatment of a product that is directly derived from the patented method exhausts the patent right, and the patent will not cover the further processing or treatment of the subsequent product. Therefore, if SPC considers the act of the processing or treatment of the subsequent product not to infringe the patented claim either directly or indirectly, SIPL and SIL respectfully recommend that SPC revise Article 24 and expressly clarify that this act does not infringe.

⁶ See John F. Triggs, Functional Claiming: § 112 ¶ 6 Still Difficult After All These Years, 3 No. 2 *Landslide* 30 (2011); Winslow, *supra* note 5.

⁷ Article 11 of China’s Patent Law defines direct infringement of a patent. Patent Law (promulgated by the Standing Comm. Nat’l People’s Cong., Dec. 27, 2008, effective Oct. 1, 2009), art. 11 (China) (“Patent Law”).

⁸ Under U.S. law, use of an item created by a patented process may be infringement, so that the sale of an item produced by a patented process may be indirect infringement. 35 U.S.C. § 271(g).

Article 27

Voluntary, industry-led, consensus-based standards setting can play an important role in promoting innovation, increasing efficiency and consumer choice, and leading to lower prices and greater output. However, collaborative standard setting is not without risks. In particular, to mitigate the risks of opportunistic exercise of market power after the standard is set, many standard-setting organizations (“SSOs”) require those wishing to participate in the standard-setting process to disclose the existence of any patented technology they own that may be essential to implement the standard and voluntarily commit to license their standard-essential patents (“SEPs”) on fair, reasonable and non-discriminatory (“F/RAND”) terms. This voluntary F/RAND commitment balances the interests of those participating in the collaborative standard-setting process by ensuring that implementers will be permitted to produce standard-compliant products without the threat of royalty “hold-up” and a patent holder will receive reasonable, market-based compensation for its innovation. A patent holder benefits from licensing its SEPs on F/RAND terms because, if its patented technology is adopted and the standard is widely adopted, the patent holder has the potential to earn royalties on a larger volume of sales. On the other hand, the F/RAND licensing of the technology facilitates adoption of the standard, which leads to further innovation and increases consumer welfare. Neither U.S. nor EU law, however, requires companies that do not participate in an SSO to license on F/RAND terms or at all. Given the fundamental right of a patent holder to exclude others from using its invention during the period of the patent, it is essential that the F/RAND commitment be limited to situations in which the patent holder voluntarily participates in and subjects itself to the SSO process. A contrary rule risks confiscating the value of a patent holder’s invention and discouraging innovation.

The first sentence of the first paragraph of Article 27 provides that when non-compulsory national, industrial, or local standards explicitly disclose information of a patent that is “relevant to such standards,” the accused infringer will not be permitted to allege non-infringement by arguing that no license from the right holder is required for implementing such standards. We respectfully recommend that this sentence be revised to clarify that patents “relevant to such standards” refers to patents “essential to such standards” that the right holder voluntarily offered for inclusion in the standard. We further recommend that the first sentence be revised to provide that the court will make a determination whether the patent is in fact essential to the standard, and that the accused infringer will have the opportunity to prove non-infringement.

The second sentence of the first paragraph of Article 27 provides that when a patent holder violates F/RAND principles by negotiating license terms in bad faith, the court generally shall allow the accused infringer to continue implementing the standard. We respectfully recommend that the second sentence of the first paragraph of Article 27 be amended as follows:

- (1) To clarify that it will apply only to situations in which the patent holder has made an unambiguous voluntary commitment to license its SEPs on F/RAND terms;
- (2) To clarify that the patent holder is entitled to appropriate compensation for the accused infringer’s use of its patented technology;
- (3) To provide that the court will not permit the accused infringer to continue implementing the standard when the accused infringer refuses a F/RAND royalty license offer or unreasonably delays negotiations to the same effect; and

- (4) To clarify that the accused infringer bears the burden of proving that the patent holder has negotiated in bad faith, and clarify the circumstances under which a patent holder will be found to violate F/RAND principles by negotiating in bad faith, so that “bad faith” by a SEP holder will not be found when a SEP holder agrees that a court or mutually agreed arbitrator shall adjudicate F/RAND terms.

The first revision is necessary to ensure that standards development activity does not lead to the misappropriation of technologies without the patent holder’s consent, and to avoid creating a substantial inconsistency between a patent owner’s obligations in China and in other jurisdictions.⁹ For example, the European Commission’s Guidelines on the Applicability of Article 101 of the Treaty on the Functioning of the European Union (“Article 101 Guidelines”) to horizontal co-operation agreements state that Intellectual Property Rights policies of SSOs should incorporate F/RAND principles, but they also reinforce that participation is voluntary by making it clear that patent owners may exclude technology from the standard-setting process and thus from any commitment to license.¹⁰ Antitrust authorities in the United States similarly encourage (but do not compel) the adoption of F/RAND policies by SSOs as contributing to follow-on innovation utilizing standards.¹¹ A contrary policy could discourage international investment and innovation by entities in China.

The second revision is crucial to promote innovation by protecting innovators’ ability to reap benefits from their investments in research and development and commercialization of new products. Depriving a SEP holder of its ability to recoup the value of its invention risks discouraging participation in standards-setting and harming innovation in general, e.g., through limiting standards’ robustness and technological sophistication.

The third revision is necessary to address reverse hold-up (also known as hold-out), i.e., the situation in which a firm using the SEP unreasonably delays good faith negotiations towards a F/RAND license. As the U.S. and EU antitrust agencies have explained, injunctive relief may be an appropriate remedy in certain circumstances such as when an accused infringer refuses or constructively refuses to take a F/RAND license, or refuses to negotiate in good faith to determine F/RAND terms.¹²

⁹ The Sections suggest that a mandatory imposition of a F/RAND commitment is inconsistent with the general principle of China’s Patent Law, that a patent owner should have discretion as to how to exercise its patent rights. Patent Law, art. 11.

¹⁰ See Guidelines on the Applicability of Article 101 of the Treaty on the Functioning of the European Union to Horizontal Co-operation Agreements, 2011 at O.J. (C 11) 1, para. 285, available at <http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:C:2011:011:0001:0072:EN:PDF>; see also Competition Directorate-General, European Commission, Standard-essential patents, COMPETITION POLICY BRIEF at 3, 5 (June 2014), available at http://ec.europa.eu/competition/publications/cpb/2014/008_en.pdf.

¹¹ See U.S. DEP’T OF JUSTICE & U.S. PATENT AND TRADEMARK OFFICE, *Policy Statement on Remedies for Standard Essential Patents Subject to Voluntary F/RAND Commitments* at 5-6 (Jan. 8, 2013), available at <http://www.justice.gov/atr/public/guidelines/290994.pdf> (“DOJ-PTO Policy Statement”).

¹² *Id.* at 7 (referring to these types of conduct as a “constructive refusal to negotiate”); see also Decision and Order at 8 § II.E, *In the Matter of Motorola Mobility LLC, and Google Inc.*, FTC Docket No. C-4410 (July 23, 2013), available at <http://ftc.gov/os/caselist/1210120/130724googlemotorolado.pdf>; Commission Opinion at 63, *In re Certain Electronic Devices, Including Wireless Communication Devices, Portable Music and Data Processing Devices*, and

The fourth revision is necessary to provide SEP holders with guidance on what conduct constitutes “bad faith” negotiation of F/RAND terms. While no court or competition agency to our knowledge has attempted to define what constitutes bad faith negotiation in the F/RAND context, courts and agencies have made determinations on what constitutes a willing licensee. Such determinations provide useful guidance on what does not constitute bad faith. The European Commission, for example, has created a “safe harbour” approach from injunctive relief, under which an implementer can demonstrate that it is a “willing licensee” by agreeing that a court or, if both parties agree, an arbitrator shall adjudicate the F/RAND terms in the event that negotiations fail.¹³ Based on these determinations, we recommend that Article 27 be revised to clarify that, at the very least, “bad faith” by a SEP holder will not be found when a SEP holder agrees that a court or a mutually agreed arbitrator shall adjudicate the F/RAND terms.

The second paragraph of Article 27 provides that when negotiations between the parties fail, a court may decide the licensing terms. We first commend the Supreme People’s Court for recognizing that licensing terms should normally be determined through private negotiations between the parties. However, as Article 27 recognizes, those negotiations may be unsuccessful. To address those limited circumstances, we respectfully recommend that the second paragraph be revised to clarify that an implementer may not unilaterally seek a court determination of a F/RAND royalty rate or other F/RAND terms in the absence of an assertion or threatened assertion of the SEP by the SEP holder. Without this revision, implementers may have less incentive to privately negotiate F/RAND terms and greater incentive to instead seek court adjudication of F/RAND terms as a first resort.

The Sections also respectfully recommend that Article 27 be clarified to provide objective criteria for what constitutes “sufficient negotiation.” Such clarification is especially important given the recognition that good faith negotiations are the preferred method of resolving these issues. Without such clarification, both the patent holder and the infringer may have an incentive to turn to litigation prematurely, before exhausting negotiations. Such behavior may amount to hold-out or hold-up, and institutionally can over-burden the judicial system. Conversely, clarification of this term may ensure that good-faith negotiation is fully explored. Lastly, the Sections recommend that Article 27 be revised to require courts, when determining licensing terms, to recreate a hypothetical negotiation between the parties and to consider evidence of market

Tablet Computers, Inv. No. 337-TA-794, USITC Pub. 512742 (July 5, 2013) (defining reverse hold-up as an “expensive litigation” scenario under which “an implementer utilizes declared-essential technology without compensation to the patent owner under the guise that the patent owner’s offers to license were not fair or reasonable”).

¹³ Memorandum from the European Commission MEMO/14/322, Antitrust decisions on standard essential patents (SEPs) - Motorola Mobility and Samsung Electronics - Frequently asked questions (Apr. 29, 2014), *available at* http://europa.eu/rapid/press-release_MEMO-14-322_en.htm. *See also* DOJ-PTO Policy Statement, *supra* note 11; Brief for FTC as Amicus Curiae Supporting Neither Party, Apple Inc. and NeXT Software, Inc. v. Motorola, Inc. and Motorola Mobility, Inc., Nos. 2012-1548, 2012-1549 at 7-9 (Fed. Cir. Dec. 4, 2012), *available at* http://www.ftc.gov/sites/default/files/documents/amicus_briefs/apple-inc.and-next-software-inc.v.motorola-inc.and-motorola-mobility-inc./121205apple-motorolaamicusbrief.pdf.

factors, for example, comparable licenses (for the same patent and other similar patents) that would bear on the appropriate royalty.¹⁴

Article 30

Article 30 appears to impose compulsory licensing obligations when an alleged infringer ceasing to practice the relevant patents would either (1) damage the “social public interest” or (2) cause “serious interest imbalance between the parties.”

Imposing a compulsory licensing obligation creates a significant risk of reducing incentives for innovation and implementation to the detriment of consumers and society as a whole. For example, a compulsory licensing requirement is likely to deter inventors from investing in risky and costly research and development if they are deprived of the right to exclude others from using their patented technology. The technical quality of products that would otherwise have used the patented technology will diminish, competition for making and selling products based on such technology will be deterred, and demand for such products will be lessened.

The Sections respectfully request that the SPC delete the second ground for imposing compulsory licensing (i.e., delete “or cause serious interest imbalance between the parties”), and specify that a finding of “damage to the social public interest” will be rare and based on specific enumerated factors that are unrelated to commercial interests.¹⁵ In addition, to comply with the World Trade Organization’s Agreement on Trade-Related Aspects of Intellectual Property Rights (“TRIPS”), the Sections recommend that the SPC revise Article 30 to specify that, “except in cases of national emergency or other circumstances of extreme urgency or in cases of public non-commercial use,” use without authorization of the right holder (i.e., a compulsory license) will “only be permitted if, prior to such use, the proposed user has made efforts to obtain authorization from the right holder on reasonable commercial terms and conditions and that such efforts have not been successful within a reasonable period of time.”¹⁶ Lastly, to comply with TRIPS Article 31(c), the Sections recommend that Article 30 of the Consultation Draft be amended to specify that “the scope and duration of such use shall be limited to the purpose for which it was authorized, and in the case of semi-conductor technology shall only be for public non-commercial use or to remedy a practice determined after judicial or administrative process to be anti-competitive.”¹⁷

With respect to the determination of a reasonable royalty rate, the Sections respectfully recommend that the SPC revise Article 30 to specify that courts will seek to recreate

¹⁴ See Sections’ JI (I) Comments (Appendix 2).

¹⁵ The Paris Convention for the Protection of Industrial Property of 1883, to which China is a party, provides guidance in Article 5 on the limited appropriate use of compulsory licensing.

¹⁶ TRIPS Art. 31(b). Members are not obliged to apply the conditions set forth in Article 31(b) when such use is permitted to remedy a practice determined after judicial or administrative process to be anticompetitive. *Id.* Art. 31(k).

¹⁷ Moreover, the Sections respectfully request that, to comply with TRIPS, Article 30 be revised to specify that any use permitted under Article 30 shall be “predominantly for the supply of the domestic market.” TRIPS Article 31(f).

a hypothetical negotiation between the parties and consider evidence of market factors that would bear on the appropriate royalty, as explained in detail in the Sections' JI (I) Comments (attached as Appendix 2). In addition, to comply with Article 31(h) of TRIPS, the Sections respectfully recommend that Article 30 of the Consultation Draft be revised to provide that "the right holder shall be paid adequate remuneration in the circumstances of each case, taking into account the economic value of the authorization."

Conclusion

The Sections appreciate the opportunity to provide comments and are available to provide additional comments or to participate in any further consultations with the SPC, as it deems appropriate.

Appendices

1. Unofficial Translation of Interpretations of the Supreme People's Court on Certain Issues Concerning the Application of Law in the Trial of Patent Infringement Cases (II) (Draft for Public Comment)
2. Comments of the American Bar Association's Section of Antitrust Law, Section of Intellectual Property Law and Section of International Law on the Public Comment Draft of the Supreme People's Court's Decision on Revising Application of the Law in the Hearing of Patent Dispute Cases (Aug. 15, 2014)

Interpretations of the Supreme People's Court on Certain Issues Concerning the Application of Law in the Trial of Patent Infringement Cases II” (For Public Comments)

《最高人民法院关于审理侵犯专利权纠纷案件应用法律若干问题的解释（二）》（公开征求意见稿）

Publication Date: July 31st, 2014
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Deadline for Commenting: September 1st, 2014
征求意见截止日期：2014年9月1日

<p>《最高人民法院关于审理侵犯专利权纠纷案件应用法律若干问题的解释（二）》（公开征求意见稿）</p>	<p>Interpretations of the Supreme People's Court on Certain Issues Concerning the Application of Law in the Trial of Patent Infringement Cases II (For Public Comments)</p>
<p>为正确审理侵犯专利权纠纷案件，根据《中华人民共和国专利法》、《中华人民共和国民事诉讼法》等有关法律规定，结合审判实际，制定本解释。</p>	<p>For the purpose of properly hearing patent infringement cases, the Interpretations are formulated in accordance with the Patent Law of the People's Republic of China, the Civil Procedure Law of the People's Republic of China and other relevant laws and regulations and by taking into account the judicial practice.</p>
<p>第一条</p> <p>权利要求书有两项以上权利要求的，权利人应当在起诉状中载明据以起诉被诉侵权人侵犯其专利权的权利要求。起诉状对此未记载或者记载不明的，人民法院应当要求权利人明确；经释明，权利人不予明确的，人民法院可以推定权利人选择全部的独立权利要</p>	<p>Article 1</p> <p>Where there are two or more claims in the patent claims, a patentee shall state clearly which claim is infringed by an accused infringer in the complaint. Where the complaint does not have such statement or the statement is not clear, a people's court shall require the patentee to</p>

<p>《最高人民法院关于审理侵犯专利权纠纷案件应用法律若干问题的解释（二）》（公开征求意见稿）</p>	<p>Interpretations of the Supreme People's Court on Certain Issues Concerning the Application of Law in the Trial of Patent Infringement Cases II (For Public Comments)</p>
<p>求。</p>	<p>make clarification; in case that the patentee refuses to do so after the people's court explains its requirement, the people's court may presume that the patentee chooses to assert all independent claims.</p>
<p>第二条</p> <p>权利人主张被诉侵权技术方案落入独立权利要求及其从属权利要求限定的保护范围，经审查，被诉侵权技术方案已落入独立权利要求限定的保护范围的，人民法院应当对被诉侵权技术方案是否落入其从属权利要求限定的保护范围作出认定；被诉侵权技术方案未落入独立权利要求限定的保护范围的，人民法院可以径行认定被诉侵权技术方案未落入其从属权利要求限定的保护范围。</p> <p>被诉侵权技术方案落入权利人主张的一项以上权利要求限定的保护范围的，人民法院应当认定被诉侵权技术方案落入专利权的保护范围。被诉侵权技术方案落入两项以上权利要求所限定的保护范围的，不影响人民法院对赔偿数额的认定。</p>	<p>Article 2</p> <p>Where a patentee alleges that an accused infringing technical solution falls within the protection scope of an independent claim and a dependent claim thereof, in case that the accused infringing technical solution is found to fall within the protection scope of the independent claim, a people's court shall find whether or not the accused infringing technical solution falls within the protection scope of the dependent claim; in case that the accused infringing technical solution does not fall within the protection scope of the independent claim, the people's court may directly find that the accused infringing technical solution does not fall within the protection scope of the dependent claim.</p> <p>Where the accused infringing technical solution falls within the protection scope of one or more claims asserted by the patentee, the people's court shall find that the accused infringing technical solution</p>

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	<p>falls within the protection scope of the patent right. That the accused infringing technical solution falls within the protection scope of two or more claims shall not affect the people's court to determine the amount of damages.</p>
<p>第三条</p> <p>权利人在专利侵权诉讼中主张的权利要求被专利复审委员会宣告无效的，审理专利侵权纠纷案件的人民法院可以裁定驳回权利人基于该无效权利要求的起诉；有证据证明专利复审委员会宣告专利权无效的决定被生效行政裁判撤销的，权利人可以重新起诉。</p>	<p>Article 3</p> <p>Where a claim asserted by a patentee in a patent infringement lawsuit is declared invalid by the Patent Reexamination Board, a people's court adjudicating the patent infringement lawsuit may dismiss the lawsuit brought by the patentee based on the invalidated claim; in case that there is evidence to prove that the Patent Reexamination Board's decision of declaring the patent right invalid is revoked by an effective administrative case judgment, the patentee may file a new lawsuit again.</p>
<p>第四条</p> <p>对于权利要求书、说明书及附图中的语法、文字、标点、符号、图形等错误，本领域普通技术人员通过阅读权利要求书、说明书可</p>	<p>Article 4</p> <p>For grammar, letter, punctuation, symbol, graphic and other errors in claims, specification and drawings, where an ordinary person skilled in</p>

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<p>以清楚地得出唯一理解的，人民法院应当根据该唯一理解予以认定。</p>	<p>the art can clearly derive a sole understanding by reading the claims and specification, a people's court shall affirm the sole understanding.</p>
<p>第五条</p> <p>权利要求记载的文字含义清楚，但说明书的相应描述与其根本冲突，且不属于本解释第四条规定的情形的，人民法院应当根据权利要求的记载确定专利权的保护范围。</p> <p>权利要求含义不明，运用法定的解释方法仍无法确定其限定的专利权保护范围，且不属于本解释第四条规定的情形的，人民法院可以裁定驳回起诉。</p> <p>当事人举证证明在专利侵权诉讼的裁判作出前无效宣告请求人基于上述事由请求专利复审委员会宣告该专利权无效的，人民法院可以裁定中止诉讼。</p>	<p>Article 5</p> <p>If the textual meaning of the claim is clear but is in fundamental conflict with the relevant descriptions of the written description of the patent and does not belong to the circumstances as prescribed by Article 4, the people's court shall determine the scope of patent protection based on the recitations of the claim.</p> <p>If the meaning of the claim is not clear and the scope of patent protection based on the claim cannot be determined by any statutory interpretation methodology and does not belong to the circumstances as prescribed by Article 4, the people's court may dismiss the lawsuit.</p> <p>If a party to the litigation proves that an invalidation petitioner requests the Patent Reexamination Board to declare the patent right invalid based on the above-mentioned grounds before the issuance of the judgment of the patent infringement litigation is made, the people's court may stay the action.</p>

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<p>第六条</p> <p>人民法院对于权利要求的解释，应当符合专利的发明目的。被诉侵权技术方案具有专利所要克服的现有技术的缺陷的，人民法院应当认定其未落入专利权的保护范围。</p>	<p>Article 6</p> <p>The claim construction made by a people's court shall be consistent with the invention purpose of the patent. Where an accused infringing technical solution has the technical defects of prior art that the patent is intended to overcome, a people's court shall find that the accused infringing technical solution does not fall within the protection scope of the patent right.</p>
<p>第七条</p> <p>人民法院判定被诉侵权技术方案是否落入专利权的保护范围，一般应当对专利技术方案以及被诉侵权技术方案进行技术特征的分解，并在此基础上进行相应技术特征的对比。</p> <p>技术特征，是指技术方案中能够相对独立地实现一定的技术功能，并产生相对独立的技术效果的最小技术单元。</p>	<p>Article 7</p> <p>In determining whether or not an accused infringing technical solution falls within the protection scope of a patent right, a people's court usually shall decompose the patented technical solution and the accused infringing technical solution into technical features, and compare the corresponding technical features based on the outcome of the decomposition.</p> <p>A technical feature refers to a minimum technical unit that can relatively independently perform a certain technical function and achieve relatively independent effects in a technical solution.</p>

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<p>第八条</p> <p>涉案专利与另一专利之间存在分案申请等直接关联关系的，人民法院可以运用该另一专利及其专利审查档案、生效的专利授权确权纠纷裁判文书解释涉案专利的权利要求。</p> <p>专利审查档案，包括专利审查、复审、无效过程中专利申请人或者专利权人提交的书面材料，国务院专利行政部门及其专利复审委员会作出的审查意见通知书、会晤记录、口头审理记录、生效的专利复审请求审查决定书和专利权无效宣告请求审查决定书等。</p>	<p>Article 8</p> <p>Where a patent at issue has direct relationships with another patent such as divisional application, a people's court may carry out the claim construction of the patent at issue by using this directly related patent, the prosecution history documents, and the effective judgment in the prosecution and invalidation proceedings of the directly related patent.</p> <p>Prosecution history documents include the written materials filed by a patent applicant or a patentee in the course of patent examination, reexamination and invalidation actions, notifications of examination, interview records, oral hearing records, effective decisions of the reexamination and invalidation issued by the Patent Administration Department under the State Council and the Patent Reexamination Board.</p>
<p>第九条</p> <p>人民法院在确定专利权的保护范围时，独立权利要求的前序部</p>	<p>Article 9</p> <p>In determining the protection scope of a patent right by a people's</p>

<p>《最高人民法院关于审理侵犯专利权纠纷案件应用法律若干问题的解释（二）》（公开征求意见稿）</p>	<p>Interpretations of the Supreme People's Court on Certain Issues Concerning the Application of Law in the Trial of Patent Infringement Cases II (For Public Comments)</p>
<p>分、特征部分以及从属权利要求的引用部分、限定部分记载的技术特征均有限定作用。</p>	<p>court, the preamble portion and the characterizing portion of an independent claim, and the reference portion and the limiting portion of a dependent claim all have limiting function.</p>
<p>第十条</p> <p>权利要求中以功能或者效果表述的技术特征，即功能性特征，是指对于结构、组分、步骤、条件或其之间的关系等，仅通过其在发明创造中所起的功能或者效果进行限定的技术特征。但是，当事人举证证明技术术语系本领域约定俗成的或者本领域普通技术人员可以仅通过权利要求即可直接、明确地确定其技术内容的除外。</p> <p>与说明书及附图记载的实现上述功能或者效果不可缺少的技术特征相比，被诉侵权技术方案的相应技术特征是以基本相同的手段，实现相同的功能，达到相同的效果，且本领域普通技术人员在专利申请日无需经过创造性劳动就能够联想到的，人民法院应当认定该相应技术特征与功能性特征相同。</p> <p>与说明书及附图记载的实现上述功能或者效果不可缺少的技术特征相比，被诉侵权技术方案的相应技术特征是以基本相同的手</p>	<p>Article 10</p> <p>A technical feature as stated in terms of functions or effects thereof in a claim, i.e. a functional feature, refers to a technical feature in which the structures, compositions, steps, or the relations therebetween are defined only through their functions or the effects achieved in an invention, except that a party proves with evidence that the technical term is a conventional one in the art or the technical content can be directly and unambiguously derived merely from the claim itself by an ordinary person skilled in the art.</p> <p>Where being compared with a technical feature that is necessary to achieve the above mentioned function or effect and is recited in the specification or drawings, the corresponding technical feature of an accused infringing technical solution can perform the same function in substantially the same way and achieve the same effects and is obvious</p>

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<p>段，实现基本相同的功能，达到基本相同的效果，且本领域普通技术人员在专利申请日后、被诉侵权行为发生日以前无需经过创造性劳动就能够联想到的，人民法院应当认定该相应技术特征与功能性特征等同。</p>	<p>to an ordinary person skilled in the art without creative efforts at the filing date of the patent, a people's court shall find that the corresponding technical feature is identical to the functional feature.</p> <p>Where being compared with a technical feature that is necessary to achieve the above mentioned function or effect and is recited in the specification or drawings, the corresponding technical feature of an accused infringing technical solution can perform substantially the same function in substantially the same way and achieve substantially the same effects and is obvious to an ordinary person skilled in the art without creative efforts after the filing date of the patent and before the occurrence date of an accused infringing act, a people's court shall find that the corresponding technical feature is equivalent to the functional feature.</p>
<p>第十一条</p> <p>对于组合物的封闭式权利要求，被诉侵权技术方案在包含权利要求全部技术特征的基础上增加其他技术特征的，人民法院应当认定被诉侵权技术方案未落入专利权的保护范围，但该增加的技术特</p>	<p>Article 11</p> <p>For a closed claim of a composition, where an accused infringing technical solution has other technical features in addition to all technical features of the claim, a people's court shall find that the</p>

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<p>征属于不可避免的常规数量杂质的除外。</p>	<p>accused infringing technical solution does not fall within the protection scope of a patent right, except that the added other technical features are of the conventional amount of inevitable impurities.</p>
<p>第十二条</p> <p>被诉侵权技术方案不能适用于产品权利要求中使用环境特征限定的使用环境的，人民法院应当认定被诉侵权技术方案未落入专利权的保护范围。</p>	<p>Article 12</p> <p>Where an accused infringing technical solution cannot be fit in the use environment that is specified by the use environment feature of a product claim, a people's court shall find that the accused infringing technical solution does not fall within the protection scope of a patent right.</p>
<p>第十三条</p> <p>对于产品权利要求中以制备方法界定产品的技术特征，被诉侵权产品的制备方法与其不相同也不等同的，人民法院应当认定被诉侵权技术方案未落入专利权的保护范围。</p>	<p>Article 13</p> <p>With respect to a technical feature in which the product is defined by the preparation method in a product claim, where the preparation method of an accused infringing product is neither identical nor equivalent, a people's court shall determine that the accused infringing technical solution does not fall within the protection scope of a patent right.</p>

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<p>第十四条</p> <p>对于方法权利要求中的步骤顺序特征，人民法院应当根据权利要求的记载，结合说明书及附图，确定步骤顺序的变换对技术效果是否产生实质性影响，并在此基础上认定被诉侵权技术方案是否落入专利权的保护范围，但属于本解释第十五条规定的情形的除外。</p>	<p>Article 14</p> <p>With respect to a sequential step feature of a method claim, a people's court shall find whether or not the change of the sequential step has substantial impacts on the technical effects based on the claim, and by taking into account the written description and drawings, and then based on all the above determine whether or not the accused infringing technical solution falls within the protection scope of the patent right, except for the circumstance as prescribed in Article 15 of the Interpretations.</p>
<p>第十五条</p> <p>权利要求采用“至少”等用语对数值特征或者采用“首先”等用语对步骤顺序特征进行界定，且本领域普通技术人员认为权利人特别强调该用语对技术特征的严格限定作用，权利人主张与其不相同的技术特征属于等同特征的，人民法院不予支持。</p>	<p>Article 15</p> <p>Where a claim uses words like “at least” for a numerical feature or uses words like “firstly” to specify a sequential step feature, and an ordinary person skilled in the art would believe that the patentee specifically emphasizes the strict limiting function of these words to a technical feature, if the patentee alleges that a non-identical technical feature is an equivalent feature, a people's court shall not support such allegation.</p>

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<p>第十六条</p> <p>专利申请人、专利权人在专利授权确权程序中修改权利要求书、说明书或者陈述意见，被诉侵权人主张上述情形下放弃的技术方案不属于专利权保护范围，权利人举证证明该修改或者陈述未被审查员采信或者与专利授权确权条件无因果关系的，人民法院应当认定该修改或者陈述未导致技术方案的放弃。</p>	<p>Article 16</p> <p>Where a patent applicant or a patentee amends a claim, a written description or a response during the prosecution or invalidation proceedings of a patent, an accused infringer contends that a technical solution abandoned under the above circumstances does not belong to the protection scope of the patent, and a right holder proves with evidence that the amendment or statement is not accepted by an examiner or has no causality with the result of the prosecution or invalidation proceedings, a people's court shall find that the amendment or the statement does not cause the abandonment of the technical solution.</p>
<p>第十七条</p> <p>人民法院认定外观设计是否相同或者近似，应当从一般消费者的角度全面观察设计特征，综合判断整体视觉效果。被诉侵权设计未包含授权外观设计区别于现有设计的全部设计特征的，人民法院可以推定被诉侵权设计与授权外观设计不近似；被诉侵权设计包含授权外观设计区别于现有设计的全部设计特征的，人民法院可以推</p>	<p>Article 17</p> <p>In determining whether or not designs are identical or similar, a people's court shall make an overall observation of the design features, and make a holistic judgment of the overall visible effects from the view of an average consumer. Where the accused infringing design does not contain all of the design features of the patented design that</p>

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<p>定该设计特征对整体视觉效果更具有影响。但是，当事人提出反证推翻上述推定的除外。</p> <p>一般消费者，是指被诉侵权产品的直接购买者。人民法院在认定一般消费者对于外观设计所具有的知识水平和认知能力时，应当考虑授权外观设计的设计空间，即设计者在创作特定产品外观设计时的自由度。设计空间较大的，一般消费者通常不容易注意到不同设计之间的较小区别；设计空间较小的，一般消费者通常更容易注意到不同设计之间的较小区别。</p>	<p>distinguish the patented design from prior designs, the people's court may presume that the accused infringing design is not similar to the patented design; where the accused infringing design contains all of the design features of the patented design that distinguish the patented design from prior designs, the people's court may presume that such design features have more impacts on the overall visible effects, except that a party provides evidence to the contrary to overturn such presumptions.</p> <p>An average customer refers to a direct purchaser of the accused infringing product. In determining the knowledge and cognitive capability of an average customer about a design, the people's court shall consider the design space of the patented design, that is, the degree of freedom for a designer in creating the design of the particular product. In general, where there is a larger design space, it is not easy for an average customer to notice a relatively minor difference between different designs; where there is a smaller design space, it is easier for an average customer to notice a relatively minor difference between different designs.</p>

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<p>第十八条</p> <p>被诉侵权设计与授权外观设计的差异不足以使一般消费者将两者区分或者两者的差异属于惯常设计或由技术功能唯一决定的设计的，人民法院应当认定两者在整体视觉效果上无实质性差异。</p>	<p>Article 18</p> <p>Where the difference between an accused infringing design and a patented design is not sufficient to enable an average customer to distinguish from each other, or such difference is of a customary design or is dictated solely by the technical functions, a people's court shall find that there is no substantive difference between the two designs in the overall visible effects.</p>
<p>第十九条</p> <p>对于成套产品的外观设计专利，被诉侵权设计与其一项外观设计相同或者近似的，人民法院应当认定被诉侵权设计落入专利权的保护范围。</p>	<p>Article 19</p> <p>With respect to a design patent of a set of products, where an accused infringing design is identical or similar to one of designs of the set of products, a people's court shall find that the accused infringing design falls within the protection scope of the patent right.</p>
<p>第二十条</p> <p>对于组装关系唯一的组件产品的外观设计专利，被诉侵权设计</p>	<p>Article 20</p> <p>For a design patent of an assembled product in which there is an</p>

<p>《最高人民法院关于审理侵犯专利权纠纷案件应用法律若干问题的解释（二）》（公开征求意见稿）</p>	<p>Interpretations of the Supreme People's Court on Certain Issues Concerning the Application of Law in the Trial of Patent Infringement Cases II (For Public Comments)</p>
<p>与该组件产品在组合状态下的整体外观设计相同或者近似的，人民法院应当认定被诉侵权设计落入专利权的保护范围。</p> <p>对于各构件之间无组装关系或者组装关系不唯一的组件产品的外观设计专利，被诉侵权设计与其全部单个构件的外观设计均相同或者近似的，人民法院应当认定被诉侵权设计落入专利权的保护范围；被诉侵权设计缺少部分单个构件的外观设计或者与其不相同也不近似的，人民法院应当认定被诉侵权设计未落入专利权的保护范围，但该部分单个构件的外观设计对于全部单个构件的外观设计整体视觉效果未产生显著影响的除外。</p>	<p>exclusive assembly relationship, where an accused infringing design is identical or similar to the overall design of the assembled product in the assembly state, a people's court shall find that the accused infringing design falls within the protection scope of the patent right.</p> <p>For a design patent of an assembled product which there is no fixed assembly relationship or exclusive relationship among the constituent parts, where accused infringing designs are identical or similar to the designs of all of individual parts of the design patent, a people's court shall find that the accused infringing designs fall within the protection scope of the patent right; where the accused infringing designs do not have a design of any individual parts of the assembled product, or are neither identical nor similar thereto, an people's court shall find that the accused infringing designs do not fall within the protection scope of the patent right, except that the design of such individual parts thereof does not have substantive impact on the overall visible effects of the designs of all individual parts thereof.</p>

<p>《最高人民法院关于审理侵犯专利权纠纷案件应用法律若干问题的解释（二）》（公开征求意见稿）</p>	<p>Interpretations of the Supreme People's Court on Certain Issues Concerning the Application of Law in the Trial of Patent Infringement Cases II (For Public Comments)</p>
<p>第二十一条</p> <p>对于变化状态产品的外观设计专利，被诉侵权设计与变化状态图所示的各种使用状态的外观设计均相同或者近似的，人民法院应当认定被诉侵权设计落入专利权的保护范围。</p> <p>被诉侵权设计缺少部分使用状态的外观设计或者与其不相同也不近似的，人民法院应当认定被诉侵权设计未落入专利权的保护范围，但该部分使用状态的外观设计对于全部使用状态的外观设计整体视觉效果未产生显著影响的除外。</p>	<p>Article 21</p> <p>For a design patent of a product that has variable states, where an accused infringing design is identical or similar to the design of all usage states shown in the drawings of variable states, a people's court shall find that the accused infringing patent falls within the protection scope of the patent right.</p> <p>Where the accused infringing design does not have a design of any of the usage states, or is neither identical nor similar thereto, a people's court shall find that the accused infringing design does not fall within the protection scope of the patent right, except that the design of such usage states does not have substantive impact on the overall visible effects of the design of all of the usage states.</p>
<p>第二十二条</p> <p>权利人诉请在发明专利申请公布日至授权公告日期间实施该发明的单位或者个人支付适当费用的，人民法院可以参照适用有关</p>	<p>Article 22</p> <p>Where a right holder claims appropriate fee for a company or an individual implementing the invention during the period from the publication date of the invention patent application to the</p>

<p>《最高人民法院关于审理侵犯专利权纠纷案件应用法律若干问题的解释（二）》（公开征求意见稿）</p>	<p>Interpretations of the Supreme People's Court on Certain Issues Concerning the Application of Law in the Trial of Patent Infringement Cases II (For Public Comments)</p>
<p>专利侵权赔偿数额确定的法律规定。</p> <p>专利申请公布时的申请人请求保护的范围与专利公告授权时的专利权保护范围不一致，被诉侵权技术方案均落入上述两种范围的，人民法院应当认定被诉侵权人在上述期间内实施了该发明；被诉侵权技术方案仅落入其中一种范围的，人民法院应当认定被诉侵权人在上述期间内未实施该发明。</p> <p>在发明专利授权公告日以后，未经专利权人许可，使用、许诺销售、销售上述期间内已制造、进口的产品，权利人依据专利法第十一条主张停止上述实施行为的，人民法院应予支持。但是，实施人举证证明上述制造者、进口者依据专利法第十三条的规定已支付适当费用的除外。</p>	<p>announcement date of patent issuance, a people's court may refer to laws and regulations about the determination of damages of patent infringement.</p> <p>Where the protection scope claimed for by an applicant at the time of the publication of a patent application is different from the protection scope of a patent right at the time of the announcement of patent issuance, in case that an accused infringing technical solution falls within both scopes thereof, a people's court shall find that an accused infringer has practiced the invention during the above period; in case that an accused infringing technical solution only falls within one of the scopes thereof, a people's court shall find that the accused infringer did not practice such invention during the above period.</p> <p>Where using, offering for sale or selling, without the authorization of a patentee, already manufactured or imported products after the announcement date of patent issuance, and the patentee asks for stopping the above mentioned acts in accordance with Article 11 of the Patent Law, a people's court shall support such claim, except that the implementer proves with evidence that the manufacturer or the</p>

<p>《最高人民法院关于审理侵犯专利权纠纷案件应用法律若干问题的解释（二）》（公开征求意见稿）</p>	<p>Interpretations of the Supreme People's Court on Certain Issues Concerning the Application of Law in the Trial of Patent Infringement Cases II (For Public Comments)</p>
	<p>importer has already paid appropriate fee in accordance with Article 13 of the Patent Law.</p>
<p>第二十三条</p> <p>产品销售合同依法成立的，人民法院应当认定属于专利法第十一条所称的销售。</p>	<p>Article 23</p> <p>Where a product sales contract is concluded according to laws, a people's court shall find that it is the "sales" specified in Article 11 of the Patent Law.</p>
<p>第二十四条</p> <p>对于将依照专利方法直接获得的产品进一步加工、处理而获得的后续产品，进行再加工、处理的，人民法院应当认定该行为不属于专利法第十一条所称的使用依照该专利方法直接获得的产品。</p>	<p>Article 24</p> <p>Where a subsequent product derived from the further processing or treatment of a product that is directly derived from the patented method is further processed or treated, a people's court shall find that the act is not using a product that is directly derived from the patent method as specified in Article 11 of the Patent Law.</p>

<p>《最高人民法院关于审理侵犯专利权纠纷案件应用法律若干问题的解释（二）》（公开征求意见稿）</p>	<p>Interpretations of the Supreme People's Court on Certain Issues Concerning the Application of Law in the Trial of Patent Infringement Cases II (For Public Comments)</p>
<p>第二十五条</p> <p>明知有关产品系专门用于实施发明创造的原材料、零部件、中间物等，未经专利权人许可，将该产品提供给无权实施该专利的人或者依法不承担侵权责任的人实施，权利人主张该提供者的行为属于侵权责任法第九条规定的帮助侵权行为的，人民法院应予支持。</p> <p>明知有关产品、方法可以用于实施发明创造，未经专利权人许可，通过提供图纸、传授技术方案等方式积极诱导无权实施该专利的人或者依法不承担侵权责任的人实施，权利人主张该诱导者的行为属于侵权责任法第九条规定的教唆侵权行为的，人民法院应予支持。</p>	<p>Article 25</p> <p>Where a party that knows that its products are raw materials, parts or intermediary items dedicated to practicing an invention, without the authorization of a patentee, provides such products to a party that is not authorized to practice such patent or to a party that is legally exempt from infringement liability according to laws, if a right holder alleges that the provider's act is contributory infringement as specified in Article 9 of the Tort Law, a people's court shall sustain such allegation.</p> <p>Where a party that knows that its products and methods can be used to practice an invention, without the authorization of a patentee, actively induces another party that is not authorized to practice such patent or to another party that is legally exempt from infringement liability according to laws, by ways of providing drawings or passing on technical solutions etc., if a right holder alleges that the inducer's act is of the inducement infringement act as specified in Article 9 of the Tort Law, a people's court shall sustain such allegation.</p>

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<p>第二十六条</p> <p>被诉侵权人一般只能依据一项现有技术或者现有设计主张不侵权抗辩。但是，被诉侵权人举证证明被诉侵权技术方案属于一项现有技术或者与公知常识在专利申请日前是显而易见的组合的，或者被诉侵权设计属于一项现有设计与惯常设计在专利申请日前是显而易见的组合的，人民法院可以认定被诉侵权人的不侵权抗辩成立。</p> <p>对于被诉侵权人主张的上述抗辩，人民法院应当依照专利申请日时施行的专利法界定现有技术或者现有设计。</p>	<p>Article 26</p> <p>In general, an accused infringer is allowed to assert non-infringement defense based on only one prior technical solution or one prior design. However, where the accused infringer proves with evidence that the accused infringing technical solution is an obvious combination of a prior technical solution and common knowledge before the filing date of the patent application, or the accused infringing design is an obvious combination of a prior design and a customary design before the filing date of a patent application, a people's court may conclude that the non-infringement defense is established.</p> <p>With respect to the above defense as alleged by the accused infringer, the people's court shall make a finding about the prior technical solution or prior design based on the patent law that was in effect at the time of the application date of the patent.</p>

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<p>第二十七条</p> <p>非强制性国家、行业或者地方标准明示所涉专利的信息，被诉侵权人以其实施该标准而无需专利权人许可为由主张不构成专利侵权的，人民法院一般不予支持。但是，专利权人违反公平、合理、无歧视的原则，就标准所涉专利的实施许可条件恶意与被诉侵权人协商，被诉侵权人据此主张不停止实施行为的，人民法院一般应予支持。</p> <p>标准所涉专利的实施许可条件，应当由专利权人、被诉侵权人协商确定；经充分协商，仍无法达成一致的，可以请求人民法院确定。人民法院应当根据公平、合理、无歧视的原则，综合考虑专利的创新程度及其在标准中的作用、标准所属的技术领域、标准的性质、标准实施的范围、相关的许可条件等因素，确定上述实施许可条件。</p> <p>法律、行政法规对实施标准中的专利另有规定的，从其规定。</p>	<p>Article 27</p> <p>Where non-compulsory national, industrial or local standards explicitly disclose the information of a patent that is relevant to such standards, if an accused infringer alleges non-infringement defense by arguing that no license from the right holder is required for implementing such standards, a people's court shall not sustain such allegation. However, where the patentee violates the principle of fair, reasonable and non-discrimination and negotiates in bad faith with the accused infringer regarding licensing terms for the patents relevant to the standards, if the accused infringer asserts that it shall not stop the act of implementation of standards based on such grounds, a people's court generally shall sustain such assertion.</p> <p>The licensing terms of patents relevant to the standards shall be decided through the negotiation between the patentee and the accused infringer; where no agreement is reached after sufficient negotiation, the parties may ask a people's court to decide. In the determination of the licensing terms, the people's court shall apply the principle of fair, reasonable and non-discrimination, and make comprehensive consideration of the degree of innovativeness of the patent and the</p>

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	<p>utility of the patent in the standard, the technical area of the standard, the nature of the standard, the implementation scope of the standard, relevant licensing terms and other factors.</p> <p>Where any law or administrative regulation specifies otherwise with regard to a patent in a standard, such other provisions shall prevail.</p>
<p>第二十八条</p> <p>被诉侵权人为私人消费目的实施发明创造的，人民法院应当认定不属于专利法第十一条、第七十条所称的为生产经营目的。</p>	<p>Article 28</p> <p>A people's court shall find that the practicing of an invention by an accused infringer for the purpose of private consumption is not done for the business purpose as specified in Article 11 and Article 70 of the Patent Law.</p>
<p>第二十九条</p> <p>为生产经营目的使用、许诺销售或者销售不知道是未经专利权人许可而制造并售出的专利侵权产品，且能证明该产品合法来源的，对于权利人要求上述许诺销售者、销售者停止侵权行为的诉讼请求，人民法院应予支持；上述使用者举证证明专利侵权产品的制</p>	<p>Article 29</p> <p>Where an infringing product is used, offered for sale or sold for business purpose without knowing that such product is manufactured and sold out without the authorization of a patentee, and the legitimate source of such products can be proved, a people's court shall sustain the patentee's legal claims of ordering above mentioned one offering</p>

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<p>造者赔偿权利人因被侵权所受到的实际损失的，对于权利人要求该使用者停止使用行为的诉讼请求，人民法院不予支持，但该使用者应当支付专利侵权产品与专利产品的差价。</p> <p>不知道，一般是指实际不知道。但是，权利人举证证明上述侵权人应当知道的，对于该侵权人不知道的主张，人民法院不予支持。</p> <p>合法来源，是指通过正当的商业行为购买专利侵权产品。正当的商业行为包括合法的进货渠道、通常的买卖合同、合理的价格等。对于合法来源，使用者、许诺销售者或者销售者应当提供符合交易习惯的相关证据，仅以合同中的权利瑕疵担保条款证明合法来源的，人民法院不予支持。</p>	<p>for sale or selling the infringing product to stop such infringement acts; where above mentioned user can prove the manufacturer of the infringing product has compensated the right holder for the actual loss caused by the infringement, a people's court shall not sustain the right holder's claim of stopping the user's act of use, but the user shall pay for the price difference between the infringing product and the patented product.</p> <p>“Without knowing” generally refers to that the party actually does not know. However, where a right holder proves with evidence that the infringer should have known, a people's court shall not sustain the infringer's assertion of “without knowing”.</p> <p>“Legitimate source” refers to purchasing the infringing product through legitimate business activities. The legitimate business activities include a legitimate purchasing channel, sales contract in normal practice, a reasonable price, and so on. With respect to legitimate source, the user, the party offering for sale or the seller shall provide relevant evidence that complies with business practice and custom, and if the proof of legitimate source is only the warranty of defects of right in the contract, a people's court shall not sustain.</p>

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<p>第三十条</p> <p>侵权人停止实施相关专利会损害社会公共利益或者导致当事人之间的利益严重失衡的，人民法院可以判令侵权人不停止实施行为，并代以支付合理的使用费。</p>	<p>Article 30</p> <p>Where the infringer stops practicing relevant patents and it will damage the social public interest or will cause serious interest imbalance between the parties, a people's court may rule that the infringer shall not stop the act of practicing the patent, but shall pay reasonable royalty instead.</p>
<p>第三十一条</p> <p>根据权利人的申请，人民法院可以判令侵权人将侵权产品以及专门用于制作侵权产品的材料和工具等交由权利人处理，但该处理会严重损害他物的价值或者侵权产品已经附着于他物而难以替换的除外。上述物品由权利人处理的，人民法院在确定赔偿数额时，应当扣除该物品的相应价值。</p>	<p>Article 31</p> <p>Upon a right holder's application, a people's court may rule that the infringer shall hand over infringing products and materials and tools that are dedicated to manufacturing of the infringing products to the right holder for disposal, except that such disposal will seriously damage the value of other items, or the infringing products have been attached to other items and is difficult to be substituted. Where the right holder disposes the above items, a people's court shall deduct the corresponding value of such items when determining the amount of damages.</p>

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<p>第三十二条</p> <p>权利人主张依据专利法第六十五条第二款确定赔偿数额，侵权人提供证据证明权利人因被侵权所受到的实际损失、侵权人因侵权所获得的利益或者合理的专利许可使用费，且权利人不能提供反证推翻的，人民法院可以根据侵权人提供的证据确定赔偿数额；侵权人未提供上述证据的，人民法院可以依照专利法第六十五条第二款的规定确定赔偿数额。</p>	<p>Article 32</p> <p>Where the right holder claims to determine the amount of damages according to Article 65.2 of the Patent Law, the infringer proves with evidence actual loss of the right holder due to the infringement, profits obtained by the infringer due to the infringement, or reasonable patent license royalty, and the right holder cannot provide evidence to the contrary to overturn, a people's court may determine the amount of damages based on such evidence provided by the infringer; where the infringer fails to provide such evidence, the people's court may decide the amount of damages according to Article 65.2 of the Patent Law.</p>
<p>第三十三条</p> <p>人民法院为确定赔偿数额，在权利人已经尽力举证，而与专利侵权行为相关的账簿、资料主要由侵权人掌握的情况下，人民法院可以责令侵权人提供与专利侵权行为相关的账簿、资料；侵权人无正当理由拒不提供或者提供虚假的账簿、资料的，人民法院可以参考权利人的主张和提供的证据认定赔偿数额。</p>	<p>Article 33</p> <p>In determining the amount of damages, where the right holder has tried the best to fulfill the burden of proof, but the account books and materials related to infringement acts are primarily controlled by the infringer, a people's court may order the infringer to provide such account books and materials related to the infringement acts; where the infringer refuses to provide without justified reasons or provides falsified ones, the people's court may refer to the claim and submitted evidence of the right holder to determine the amount of damages.</p>

<p>《最高人民法院关于审理侵犯专利权纠纷案件应用法律若干问题的解释（二）》（公开征求意见稿）</p>	<p>Interpretations of the Supreme People's Court on Certain Issues Concerning the Application of Law in the Trial of Patent Infringement Cases II (For Public Comments)</p>
<p>第三十四条</p> <p>权利人与侵权人约定专利侵权的赔偿数额或者赔偿计算方法，权利人在专利侵权诉讼中主张按照该约定确定赔偿数额的，人民法院应予支持。</p>	<p>Article 34</p> <p>Where the right holder and the infringer have agreed on the amount of damages or the calculation method of the damages of patent infringement through agreement, if the right holder asks to determine the amount of damages based on such agreement in a patent infringement lawsuit, the people's court shall sustain.</p>
<p>第三十五条</p> <p>专利法第四十七条第二款所称的在宣告专利权无效前，是指在专利权无效宣告请求审查决定书载明的决定日前；该款所称的已执行、已经履行或者强制执行，是指已经实际执行、实际履行或者强制执行的部分；该款所称的恶意，包括专利申请人、专利权人明知其拟申请专利的技术方案属于现有技术或者现有设计等不应当被授予专利权的情形，仍将该技术方案申请专利并获得专利权。</p>	<p>Article 35</p> <p>“Before declaring a patent right invalid” as specified in Article 47.2 of the Patent Law refers to before the decision date as shown on the decision of the request for a patent invalidation; the “already executed, already implemented or compulsory executed” in this provision refers to the part that has been actually executed, actually implemented or compulsorily executed; the “bad faith” in this provision includes the situation in which the patent applicant or the patentee knows that the technical solution to be applied for a patent is prior art or prior design and so on that shall not be granted for a patent right, but still applies for a patent for such technical solution and obtains the patent right.</p>

<p>《最高人民法院关于审理侵犯专利权纠纷案件应用法律若干问题的解释（二）》（公开征求意见稿）</p>	<p>Interpretations of the Supreme People's Court on Certain Issues Concerning the Application of Law in the Trial of Patent Infringement Cases II (For Public Comments)</p>
<p>第三十六条</p> <p>人民法院裁定准许当事人基于和解协议提出的撤诉申请，宣告专利权无效的决定对在宣告专利权无效前该和解协议已经履行的部分，不具有追溯力；尚未履行的，不再履行。但是，该和解协议损害社会公共利益或者第三人利益的除外。</p> <p>和解协议对宣告专利权无效的决定的追溯问题另有约定的，从其约定。</p>	<p>Article 36</p> <p>Where a people's court rules to approve the parties' application for the withdrawal of a case based on a settlement agreement, the decision of declaring a patent right invalid shall not be retroactively applied to the relevant portion of the settlement agreement that has been performed before the declaration of the invalidation of the patent; and the unperformed portion shall not be performed, except that the settlement agreement is against the social and public interests or the third party interests.</p> <p>If the settlement agreement specifies otherwise with regard to the retroactivity of the decision of declaring the patent right the invalid, such other provisions shall prevail.</p>
<p>第三十七条</p> <p>对于专利复审委员会作出的宣告专利权无效的决定，无效宣告请求人或者专利权人未在法定期间内向人民法院起诉或者该无效宣告决定被人民法院的生效裁判维持，当事人依据该无效宣告决定</p>	<p>Article 37</p> <p>With respect to a decision of declaring a patent right invalid issued by the Patent Reexamination Board, where an invalidation requestor or the patentee does not appeal before a people's court within the statutory</p>

<p>《最高人民法院关于审理侵犯专利权纠纷案件应用法律若干问题的解释（二）》（公开征求意见稿）</p>	<p>Interpretations of the Supreme People's Court on Certain Issues Concerning the Application of Law in the Trial of Patent Infringement Cases II (For Public Comments)</p>
<p>申请再审，请求撤销专利权无效宣告前人民法院作出但尚未执行或者尚未执行完毕的专利侵权的判决、调解书的，经审查属实，人民法院应当再审；当事人依据上述无效宣告决定，申请终结执行专利权无效宣告前人民法院作出但尚未执行或者尚未执行完毕的专利侵权的判决、调解书的，经审查属实，人民法院应当裁定终结执行。</p> <p>对于专利复审委员会作出的宣告专利权无效的决定，无效宣告请求人或者专利权人已在法定期间内向人民法院起诉而未终审，当事人依据该无效宣告决定申请再审，请求撤销专利权无效宣告前人民法院作出但尚未执行或者尚未执行完毕的专利侵权的判决、调解书的，经审查属实，人民法院应当裁定中止再审审查，并中止原判决、调解书的执行。</p>	<p>period or the invalidation decision is affirmed by an effective judgment of a people's court, if a party applies for a retrial based on the invalidation decision requesting for the revocation of a patent infringement judgment or a consensual judgment which has been issued but has not yet been executed or has not been completely executed by a people's court before the declaration of invalidation of the patent right, a people's court shall rehear the case after the verification of the relevant facts; if a party applies for terminating the execution of a patent infringement judgment or a consensual judgment which has been issued but has not yet been executed or has not been completely executed by a people's court before the declaration of invalidation of the patent right, a people's court shall rule to terminate the execution of the judgment after the verification of the relevant facts.</p> <p>With respect to a decision of declaring a patent right invalid issued by the Patent Reexamination Board, where an invalidation requestor or a patentee has appealed before a people's court within the statutory period and the appeal is not completed, if a party applies for a retrial based on the invalidation decision, requesting for the revocation of a patent infringement judgment or a conciliation statement which has</p>

<p>《最高人民法院关于审理侵犯专利权纠纷案件应用法律若干问题的解释（二）》（公开征求意见稿）</p>	<p>Interpretations of the Supreme People's Court on Certain Issues Concerning the Application of Law in the Trial of Patent Infringement Cases II (For Public Comments)</p>
	<p>been issued but has not yet been executed or has not been completely executed by a people's court before the declaration of invalidation of the patent right, a people's court shall rule to stay the rehearing review and to stay the execution of the judgment or the consensual judgment, after verification of the relevant facts.</p>

美国律师协会反托拉斯法部、知识产权法部和国际法部
对于最高人民法院
关于修改审理专利纠纷案件适用法律意见征求稿的
意见书

二零一四年八月十五日

本意见书仅代表美国律师协会反托拉斯法部、知识产权法部和国际法部的观点，没有经过美国律师协会会员代表大会或理事会的批准，因此不应被视为代表美国律师协会的政策。

美国律师协会反托拉斯法部、知识产权法部和国际法部（简称“三部门”）。很高兴提交对于最高人民法院关于修改审理专利纠纷案件适用法律意见征求稿（简称“意见征求稿”）的意见书。三部门提交的意见反映了其成员在竞争法与知识产权法等领域的专业知识和经验。

三部门欢迎最高人民法院（简称“最高院”）通过修改意见征求稿在提高透明度和指导方面的成就，并且感激能够有机会提供意见。三部门的意见集中在对第二十一条关于计算专利许可费损失的讨论。

总体意见

创新者从他们对新产品的研发和商业化所作出的投资中获取利益，而针对专利侵权的有效的救济措施对于通过保护创新者能获得利益而促进创新与竞争至关重要。¹为了能够充分的保护创新的动力，救济措施应当补偿过去的侵权行为，禁止未来的侵权行为，并且在第一时间遏制侵权行为。在美国，专利救济措施提供了三种补救途径以达到上述目的：（一）损失赔偿，寻求将专利权人的财政恢复到若侵权行为没有发生而本应有的状况；（二）提高赔偿，为遏制蓄意侵权行为而设计；以及（三）在合适的时候使用禁止令，寻求维护专利权人的排他性以及第一时间遏制侵权行为。

与市场回报相比，对专利权人赔偿不足或者赔偿过多的专利救济措施，没有侵权行为的存在，会对消费者造成损害。持续的对专利权人赔偿不足的救济措施会削减创新的动力。在所有情况下全面否定寻求禁止令的诉求会削减专利权人通过其发明的商业化获得全部市场回报的能力。救济措施对专利权人赔偿过多时，如果过多的损害赔偿转嫁给了消费者，则会导致价格上涨。因此，试图使损害赔偿能够准确反映一项发明在没有侵权行为的情况下所能获得的市场回报是很重要的。

¹ 参见，例如，美国联邦贸易委员会，《演变中的知识产权市场：专利声明与救济和竞争的协调》，第 140-141 页（二零一一年三月），原文见 <http://www.ftc.gov/sites/default/files/documents/reports/evolving-ip-marketplace-aligning-patent-notice-and-remedies-competition-report-federal-trade/110307patentreport.pdf>.

第二十一条

第二十一条列出了法院在先前许可费的基础上评估合理的专利许可费损害金额时会参照的因素。本条规定了在过往专利许可费“明显不合理”时，法院可以不对其进行考虑。

计算合理的专利许可费损害金额的目的是反映没有侵权行为存在时该项发明的市场回报。因此它应该取决于有意向的许可人和被许可人在假想的谈判中本应该达成的合意。在美国具有开创性的案件，乔治太平洋公司诉美国胶合板公司

(*Georgia-Pacific Corp. v. United States Plywood Corp.*) 案中，阐述了损害金额的合理测量办法为“如果许可人（例如专利权人）与被许可人（例如侵权行为人）双方合理且自愿的试图达成合约，那么双方本应达成合意的（在侵权开始的时候）数额。”²这一框架的核心原则是有意向的许可人和有意向的被许可人模式，在此模式下被授予的数额必须双方都能接受。专利许可费必须充分补偿专利权人的授权使用，同时为侵权行为人使用该项发明保留适当的预期利润。

美国法院运用两种假定来落实假想的谈判。第一，事实裁定人必须假定该假想谈判的开始时间为侵权行为发生时。这一时间点决定了双方在谈判时所掌握的信息。因此，在设定合理的专利许可费用时，关于侵权行为人的预期利润以及可用的替代品的考量“在假想的许可谈判双方本应该会考虑哪些事项的基础上决定，而非取决于实际发生情况的事后评价。”³

第二，法院要求事实裁定人假定在谈判时双方明确知晓该专利是有效的并且受到了被告产品或者在加工过程中的侵权损害。该假定保证了专利权人在承担了庭审的风险和责任并取胜后能购获得全数赔偿。

在构建假想的谈判时，美国法院会考虑谈判双方在决定专利许可费时本应会考虑的有关市场因素的证据。因为每一项技术和市场都不相同，考虑的证据及其在每一个因素中发挥的力量会根据情况而不同。⁴

我们建议修改第二十一条并明确说明法院寻求重新创立假想的谈判并且以有意愿的许可人和被许可人模式做为决定合理专利许可费用的概念性框架。其后法院可以考虑与适合专利许可费用相关的市场因素证据。这种方法可以保护创新的动力并且避免赔偿不足或者赔偿过多。

² 乔治太平洋公司诉美国胶合板公司案，318 F. Supp. 1116，第1120页（美国地区法院纽约州南区，一九七零年），修正并维持原判（第二巡回法院，一九七一年）。

³ 汉森诉高山峡谷滑雪场有限公司案，718 F.2d 1075，第1081页（联邦巡回法院，一九八三年）。

⁴ 乔治太平洋案的法院列出了包含十五项非穷尽因素的清单。第十五项是假想谈判金额，其他十四项列出了证据的类别。乔治太平洋公司案。318 F. Supp. 第1120页。

关于标准必要专利，标准必要专利的持有人自愿作出了按照合理非歧视的条件进行许可的承诺。美国法院考虑了特定的因素重建双方的假想谈判。例如，法院判定“假想谈判的双方本应会考察该标准必要专利对争议产品的重要性来决定合理非歧视的专利许可费率。”⁵ 而且，“一项合理非歧视承诺应该被理解为将一名专利持有人获得的专利许可费限于其专利技术本身的经济价值，除去与将专利技术纳入标准相关联的价值。”⁶

最后，第十二条禁止使用先前与被许可人在市场中商定的许可费，如果该费用明显不合理。这一标准中关于什么是“明显不合理”的模糊不清会导致决定偏离以市场为基础的方法。⁷为促进创新和市场增长，应该总体上允许一名专利持有人收取市场可以负担的任何费用。⁸在没有证据证明先前的许可费用是违反竞争行为的产物的情况下，这笔通过条件对等的谈判所得出的费用表明了（而且是最佳证据）专利的市场价值。

在某种程度上，第二十一条指的是能够与被侵权专利许可进行比较的许可，这种证据可以在发明专利及其侵权使用与可对比的许可充分相似的情况下，为事实裁定人提供可靠的帮助。评估相似性的关键因素包括该技术，许可的权利（一项专利或是专利组合），专利许可费类型（提成性计费或是一次性计费），以及许可条件（一类产品或是多类）。当认定一项许可具有可比性并且经历过条件对等的谈判时，应该认定它为证据，而不考虑这些条件是否“明显不合理”。

因此，应该修改第二十一条，删除这项禁止并且允许法院考虑所有先前以及具有可比性的许可费并且不排除那些被认定为“明显不合理”的。

总结

三部门很感激能有机会对最高院的意见征求稿提供意见。如果最高院对我们的意见书有任何疑问，我们很高兴作出回应，或者提供能协助最高院的补充意见或者信息。

⁵ 参见，例如，微软公司诉摩托罗拉公司案，2013 WL 2111217，第三页（美国地区法院华盛顿州西区，二零一三年四月二十五日）。

⁶ 同上，第十二页。

⁷ Daniel F. Spulber, 《当发明面向市场时，竞争压力如何影响创新的动力？》政治经济学杂志第121期第1007页，第1040页，（二零一三年）。（“削弱知识产权的反托拉斯和知识财产政策使参与市场的发明减少。因此反托拉斯政策应该避免通过限制专利许可费，技术标准和知识财产的市场转让来限制知识产权。通过制约发明市场来限制知识财产的独占，模仿和征用会减弱竞争的动力，产生竞争压力。”）。

⁸ 参见，例如，Mark A. Lemley, 《区分利润损失和合理的专利许可费》，威廉玛丽大学法律评论，第51期第655页，第657页，（二零零九年）。（“专利保护的傳統概念是给与专利持有人通过出售专利产品排除竞争的途径，由此增长他们的利润，并且因此增加潜在专利持有人的发明动力。这一传统概念要求排他性：一项专利的价值因此与市场上或者它所控制的市场缝隙的价值相称。”）。

**COMMENTS OF THE AMERICAN BAR ASSOCIATION'S
SECTION OF ANTITRUST LAW, SECTION OF INTELLECTUAL PROPERTY
LAW, AND SECTION OF INTERNATIONAL LAW ON THE PUBLIC
COMMENT DRAFT OF THE SUPREME PEOPLE'S COURT'S DECISION ON
REVISING APPLICATION OF THE LAW IN THE HEARING OF PATENT
DISPUTE CASES**

August 15, 2014

The views stated in this submission are presented on behalf of the Sections of Antitrust Law, Intellectual Property Law, and International Law of the American Bar Association. They have not been approved by the House of Delegates or the Board of Governors of the American Bar Association and therefore may not be construed as representing the policy of the American Bar Association.

The Sections of Antitrust Law, Intellectual Property Law, and International Law of the American Bar Association (“the Sections”) are pleased to submit comments on public comment draft of the Supreme People’s Court’s Decision on Revising Application of the Law in the Hearing of Patent Dispute Cases (“the Consultation Draft”). The Sections’ comments reflect the expertise and experience of its members with competition and intellectual property law.

The Sections welcome the Supreme People’s Court’s (“SPC”) efforts to provide increased transparency and guidance through amending the Consultation Draft and appreciate the opportunity to provide comments. The Sections’ comments focus on discussion in Article 21 regarding the calculation of royalties damages.

General Comments

Effective remedies for patent infringement are crucial to promote innovation and competition by protecting innovators’ ability to reap benefits from their investments in research and development and commercialization of new products.¹ In order to adequately protect incentives to innovate, remedies should compensate for past infringement, prohibit future infringement, and deter infringement in the first instance. In the United States, patent remedies provide three types of redress to achieve these goals: (1) compensatory damages, which seek to return the patentee to the financial condition it would have been in but for the infringement; (2) enhanced damages, which are designed to deter willful infringement; and (3) injunctive relief where appropriate, which seeks to preserve the patentee’s exclusivity and deter infringement in the first instance.

Patent remedies that undercompensate or overcompensate patentees compared to the market reward, absent infringement, can harm consumers. Remedies that

¹ See, e.g., FED. TRADE COM., *The Evolving IP Marketplace: Aligning Patent Notice and Remedies with Competition* at 140-41 (Mar. 2011), available at <http://www.ftc.gov/sites/default/files/documents/reports/evolving-ip-marketplace-aligning-patent-notice-and-remedies-competition-report-federal-trade/110307patentreport.pdf>.

systematically undercompensate patentees reduce incentives to innovate. Denying the ability to seek injunctions in all circumstances can undermine the ability of patentees to obtain the full market reward from the commercialization of their inventions. Remedies that overcompensate patentees beyond the market reward can result in price increases if excessive damages awards are passed on to the consumer. Thus, it is important that damage awards attempt to accurately replicate the market reward an invention could have earned absent infringement.

Article 21

Article 21 identifies factors courts may consider when they assess reasonable royalties damages based on prior licensing fees. It provides that when prior licensing fees are “manifestly unreasonable,” the court can disregard them.

The goal of a reasonable royalty damages calculation is to replicate the market reward for the invention in the absence of infringement. It accordingly should depend on what a willing licensee and a licensor would have agreed to in a hypothetical negotiation. The seminal case in the United States, *Georgia-Pacific Corp. v. United States Plywood Corp.*, describes the proper measure of damages as “[t]he amount that a licensor (such as the patentee) and the licensee (such as the infringer) would have agreed upon (at the time the infringement began) if both had been reasonably and voluntarily trying to reach an agreement.”² The central tenet of this framework is the willing licensor/willing licensee model, under which the awarded amount must be acceptable to both parties. The royalties must adequately compensate the patentee for permitting the use while leaving the infringer an appropriate level of anticipated profits from using the invention.

U.S. courts apply two assumptions when implementing the hypothetical negotiation. First, the finder of fact must assume that the hypothetical negotiation takes place at the time the infringement began. This timing determines the information available to the parties during the negotiation. Thus, in setting a reasonable royalty rate, considerations such as the infringer’s expected profit and available alternatives are “to be determined not on the basis of the hindsight evaluation of what actually happened, but on the basis of what the parties to the hypothetical license negotiations would have considered at the time of the negotiations.”³

Second, courts require the fact-finder to assume that at the time of the negotiations the parties know with certainty that the patent is valid and infringed by the defendant’s product or process. This assumption ensures that the patentee, having incurred the risk and burden of trial and prevailed, is fully compensated.

In constructing the hypothetical negotiation, U.S. courts consider evidence of market factors that the negotiating parties would consider in determining the royalty

² *Georgia-Pacific Corp., v. U.S. Plywood Corp.*, 318 F. Supp. 1116, 1120 (S.D.N.Y. 1970), *modified and aff’d*, 446 F.2d 295 (2d Cir. 1971).

³ *Hanson v. Alpine Valley Ski Area, Inc.*, 718 F.2d 1075, 1081 (Fed. Cir. 1983).

rate. Because each technology and market is different, the evidence considered and the weight placed on each factor will vary based on the circumstances.⁴

We recommend that the SPC consider amending Article 21 to specify that courts seek to re-create the hypothetical negotiation and willing licensor/willing licensee model as the conceptual framework for determining a reasonable royalty. The courts would then consider evidence of market factors that would bear on the appropriate royalty. This approach would serve to protect incentives to innovate and guard against under- or overcompensation.

With respect to standard-essential patents (“SEPs”) on which the SEP holder has made a voluntary commitment to license on reasonable and nondiscriminatory (“RAND”) terms, U.S. courts have considered specific factors to re-create a hypothetical negotiation between the parties. For example, courts have held that “the parties in a hypothetical negotiation would set RAND royalty rates by looking at the importance of the SEPs to the standard and the importance of the standard and the SEPs to the products at issue.”⁵ Furthermore, “a RAND commitment should be interpreted to limit a patent holder to a reasonable royalty on the economic value of its patented technology itself, apart from the value associated with incorporation of the patented technology into the standard.”⁶

Lastly, Article 21 prohibits the use of licensing fees previously agreed to in the market with licensees if those fees are “manifestly unreasonable.” The vagueness of the standard for what is “manifestly unreasonable” could lead to decisions that deviate from a market-based approach.⁷ To induce innovation and market growth, a patent holder should generally be permitted to charge whatever price the market will bear.⁸ Absent evidence that the prior licensing fees were the result of anticompetitive conduct, such fees that are negotiated at arms-length provide an indication (and may be the best available evidence) of the market value of the patent.

To the extent that Article 21 refers to licenses that are comparable to licenses for the infringed patent, such evidence may reliably assist the trier of fact when

⁴ The *Georgia-Pacific* court identified a list of 15 non-exhaustive factors. Factor 15 is the hypothetical negotiation amount and the other 14 factors list categories of evidence. *Georgia-Pacific Corp.*, 318 F. Supp. at 1120.

⁵ See, e.g., *Microsoft Corp. v. Motorola, Inc.*, 2013 WL 2111217, *3 (W.D.Wash. Apr. 25, 2013).

⁶ *Id.* at *12.

⁷ Daniel F. Spulber, “How Do Competitive Pressures Affect Incentives to Innovate When There Is a Market for Inventions?,” 121 J. POL. ECON. 1007, 1040 (2013) (“[A]ntitrust and IP policies that weaken IP rights reduce participation in markets for inventions. Antitrust policies thus should avoid restricting IP rights through limits on royalties, technology standards, or market transfers of IP. Limiting appropriability of IP, by constraining markets for inventions, generates competitive pressures from imitation and expropriation that decrease incentives to innovate.”).

⁸ See, e.g., Mark A. Lemley, “Distinguishing Lost Profits from Reasonable Royalties,” 51 WILLIAM & MARY L.R. 655, 657 (2009) (“The traditional conception of patent protection is to give patent owners a means of excluding competitors from selling the patented product, thereby increasing their profits and therefore the incentive of putative patent owners to invent. This traditional conception requires exclusivity; the value of a patent is accordingly commensurate with the value of the market or market niche it controls.”).

the patented invention and its infringing use are sufficiently similar to those of the comparable license. Key attributes for evaluating similarity include the technology, the rights licensed (one patent or a portfolio), royalty type (running royalty or lump sum), and terms of the license (one product or many). When a license is found comparable and negotiated at arms length, it should be considered as evidence without regard to whether the terms are “manifestly unreasonable.”

Thus, we respectfully suggest that Article 21 be amended to delete this prohibition and permit courts to consider all prior and comparable licensing fees and not exclude those deemed to be “manifestly unreasonable.”

Conclusion

The Sections appreciate the opportunity provided by the SPC to comment on its Consultation Draft. We would be pleased to respond to any questions the SPC may have regarding these comments, or to provide additional comments or information that may be of assistance to the SPC.