Introduction to U.S. Intellectual Property Law

专利，商标，版权和商业秘密概述

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反垄断法在知识产权相关条例中的应用

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Today's Topics 今天的主题

- US IP basics refresher 美国知识产权基础知识温顾
  - Sources of law 法的渊源
  - Types of IP 知识产权的种类
  - US Administering Agencies 美国的管理部门

- Some IP considerations for R&D in the US system
  美国体系中关于研发的一些知识产权考虑
  - Private contracts vs. US govt contracts
  私人合同和美国政府合同
  - Additional patents, software, and trade secrets concepts
  另外的专利，软件和商业秘密概念

United States Constitution (1787)
美国宪法（1787）

- Article 1, Section 1, Clause 8
- 第一条，第一章，第八款
- “Congress shall have Power . . . To promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.”
- 国会有权…为促进科学和实用技艺的进步，对作者和发明者的著作和发明，在一定期限内给予专有权利的保障。

US IP Basics --- Patents
美国知识产权基础知识 – 专利

PATENT: Protects an invention, design, or plant.

专利：保护发明，外观设计，或植物。

- Term of protection (non-renewable): 20 years from application filing date for invention and plant patents; 14 years for design patents.

  保护期限（不可续展的）：从申请发明和植物专利之日起日20年，外观设计14年。
- US Patent and Trademark Office issues all patents in the US. All types are substantively examined prior to grant.
- 在美国美国专利商标局负责所有专利的授权。所有类型的专利在授予前都要进行实质审查。
- Title 35, US Code; Title 15, Chapter 63 US Code; many others, including laws governing DOE activities
- 美国法典标题35；美国法典63章标题15；其他很多，包括调整能源部活动的法律

US IP Basics – Patents
美国知识产权基础知识 – 专利

- Unlike China, the US system does not have utility *model* patents at all.

不像中国，美国体系中根本没有实用新型专利

- US “invention” patents are sometimes collectively called “utility” patents.

美国的发明专利有时会被统称为“实用”专利

US IP Basics -- Patents
美国知识产权基础知识 – 专利

Statutory Categories of Inventions
发明的法定类型

- Process
程序
- Machine
- 机械
- Manufacture
- 产品
- Composition of matter, and
- 组成
- Improvements thereof
- 对以上任何一项所作的改进

US IP Basics—Patents
美国知识产权基础知识 – 专利

- An invention must be “eligible” for patenting based on its subject matter, and it must also meet the following criteria:

  一项发明的可专利性一定是基于它的内容，还必须符合下列条件：

  – Novelty 新颖性
  – Usefulness 实用性
  – Nonobviousness (to one skilled in the relevant particular art)

    非显而易见性（对一个熟知有关的特别技术的人而言）

US IP Basics---Patents
美国知识产权基础知识 – 专利

Nonpatentable Subject Matter
非法定的类型

- Laws of Nature 自然规律
- Natural Phenomena 物理现象
- Abstract Ideas 抽象观念
- Unapplied mathematical algorithms 未应用的数学算法
- Products of Nature 天然存在的物质

US IP Basics – Trademark
美国知识产权基础知识 – 商标

- TRADEMARK: A word, phrase, symbol, or design, or a combination of words, phrases, symbols, or designs, that identifies the source of goods or services of one party from those of another.

  商标：用于识别商品或服务来源于一方而非其他方的一个单词，短语，符号或图样以及单词、短语、符号或图样的组合。
- Trademarks can acquire localized (state-based) common law legal rights through use over time

  通过使用一段时间商标能够获得地方的（州一级）普通法法律权利
- Main law: Title 15, Chapter 22, US Code

  主要法律：美国法典22章标题15

US IP Basics---Trademark
美国知识产权基础知识 – 商标

- National protection is obtained through federal registration with the USPTO, via examination.

  通过在美国专利商标局的联邦注册并通过审查来获得国家的保护

- Term of protection (renewable): 10 years *(The term "counterfeiting" is used with trademark matters.)*

  保护期限（可续展）：10年（“假冒”一词用于商标事务）

- In contrast to China, the US has a "use-based" TM system, rather than a "first to file" system.

  相对于中国，美国商标体系奉行先使用原则，而中国则奉行先申请原则。

US IP Basics---Copyright
著作权是什么

Copyright protects “original works of authorship,” including computer software

著作权是对作者原创身份的一种法律保护，包括计算机软件

Copyright protection is secured automatically upon creation; in the US, a work is “created” when it is fixed in a tangible medium for the first time.

版权保护自作品生成时自动获得。一个作品自第一次被固定下来时生成。

US IP Basics --- Copyright
著作权是什么

- Term of protection (non-renewable): Life of the author plus 70 years in most cases. *(The term "piracy" is used with copyright issues.)*

  保护期限（不可续展）：大多数情况下作者终身加70年。*（"盗版"一词用于版权事务）*

- US Copyright Office, part of the Library of Congress, registers all copyright applications.

  美国版权局是国会图书馆的一部分，登记所有的著作权申请。

- Registration is required before filing suit for infringement.

  在起诉侵权前著作权登记是必须的。

Copyright – What is not protected?
著作权——什么是不被保护的

- Non-original works 非原创作品
- Facts (e.g., phone books, standard calendars, tape measures and rulers, height and weight charts, etc.) 事实（如电话簿，标准日历，卷尺和统治者，身高和体重图表等）
- Ideas themselves 思想（理念 / 表达二分法）
- Useful Articles (e.g) 实用品（如时装，家具）fashion, furniture
- Main law: Title 17, US Code 主要法律： 美国法典标题17

US IP Basics --Trade Secrets 商业秘密

- Protects proprietary information or portions of technology that meet certain criteria
- 保护满足特定标准的专有信息或技术片段
  - Formulae 公式
  - Manufacturing processes 制造方法
  - Business strategies 经营策略
  - Business management information 经营管理信息
  - Customer lists 顾客名单
  - Design concepts 设计概念

US IP Basics--Trade Secrets
商业秘密法

- Developed mainly through state, not federal, law and varies from state to state

州与州之间法律不同, 每个州承认一些商业秘密保护的形式

- Uniform Trade Secrets Act has helped create a more uniform body of law from state to state

  统一的商业秘密法案有助于创立一个州与州之间的更统一的法律体系。

- Most state trade secrets law is civil law (noncriminal), but the main federal statute for trade secrets is a criminal law

  大部分州商业秘密法是民法（非刑事的），但是主要的联邦商业秘密成文法却是刑事法律。

- Trade secrets “theft” refers to criminal law; “misappropriation” often refers to civil (noncriminal) litigation context.

  盗取商业秘密是针对刑事法律而言，滥用通常是民事（非刑事）诉讼用语。

- Main laws: 18 USC 1831-9, Uniform Trade Secrets Act, state laws
- 主要法律：美国法典，同一商业秘密法，州法律

Trade Secrets Law: Basic Concepts
商业秘密法：基本概念

Two fundamental concepts:

两个基本概念

1) The trade secret must be economic or business-related information kept secret by the owner and that gives the owner a competitive advantage by reason of its secrecy 商业秘密必须是可以用于经营并能够给所有者带来竞争优势

2) The owner of a trade secret must take reasonable measures to maintain its secrecy 商业秘密所有者必须采取了合理措施保有其秘密

Protection lasts as long as the information is kept secret.

保护持续的时间应于信息保持秘密状态的时间一样长

Some IP Considerations for R&D in the US system
在美国体系中关于研发的一些知识产权考虑

- Private contracts vs. US govt contracts
  私人合同与美国政府合同
- Some additional patents, software, and trade secrets considerations
  一些另外的专利，软件和商业秘密考虑因素

Private vs. US Govt Contracting
私人与美国政府签订合同

- US: Two contracting schemes, both of which affect CERC activities

  美国：两个签订合同的方案，影响CERC的活动
- "Private" or "commercial" contracts

  "私人的"或"商业的"合同

  – USG is not a party to the contract

  美国政府不是合同方

  – Commercially bargained-for terms, incl IP rights

  商业上谈判条款，包括知识产权

  – No illegal terms (antitrust, etc), coercion/duress

  没有非法条款（反垄断等），强迫/胁迫

Private vs. US Govt Contracting
私人与美国政府签订合同

- Government contracts 政府合同
  - USG is a party to the contract
  美国政府是合同一方
  - Fixed statutory IP rights scheme
  固定的法定知识产权方案
    - Generally little flexibility to change IP ownership and rights allocation通常在改变知识产权权属和权利分配方面只有很少灵活性
    - Rights expectations are predictable and consistent, esp re patents 权利预期是可预测的和持续的，特别就专利而言

Private vs. US Govt Contracting
私人与美国政府订立合同

- Software and Technical Data rights

  软件和技术数据的权利

  – More complicated but somewhat more room to negotiate rights with contracting officer

  更复杂但是有多一点的空间可与合同官员谈判

- Main law source: Federal Acquisition Regulation(FAR)/agency FARs

  主要法律渊源：联邦采购条例

Private vs. US Govt Contracting
私人与美国政府订立合同

- Trade secrets is not an available protection form for IP created under most US govt contracts

  在多数美国政府合同中商业秘密不适用于创建知识产权的保护模式

- But trade secrets may be one component of a party's background IP that is necessary to the research effort

  但是商业秘密可能是合同一方的对研究工作来说是必要的背景知识产权的一个组成部分

- Parties have a MUTUAL interest in full protection of background IP

  双方有共同的利益充分保护背景知识产权

Private vs. US Govt Contracting
私人与美国政府订立合同

- Compulsory licensing or “march-in” rights in US government contracts (35 USC 203)

  在美国政府合同中强制许可或“march-in”的权利
- Has never been exercised by USG

  美国政府还从未行使过
- Still controversial after 30 years in our law

  存在于我们的法律中有30年了但仍有争议
- Can sometimes make govt contract negotiations difficult, esp with SMEs

  有时会使政府在合同谈判中遭遇困难，尤其是与中小企业的谈判

Additional Patents, Software and Trade Secrets Considerations
另外的专利，软件和商业秘密考虑

- Patents 专利
  - License for filing patent applications in foreign countries for inventions made in the US (35 USC 184) 美国国内的发明在外国申请专利的许可
  - Secrecy orders (35 USC 181 et seq) 保密要求
  - Inventor remuneration---applies to federal employees only 发明人的报酬 – 只适用于联邦雇员

Additional Considerations: Software
另外的考虑：软件

- Federal regulations relating to software and technical data ownership and licensing are complicated and, where applicable, participants should make sure they clearly understand their rights in advance

  关于软件和技术数据所有权和许可的联邦法规是复杂的，并且在适用时参与者应当事先就清楚的了解他们的权利

- Software identified as background IP must be clearly identified from the outset---program, name or identifying designation, version #, etc.

  被看做是背景知识产权的软件必须从一开始就被明确 – 程序，名称或标识命名，版本等

Additional Considerations: Trade Secrets
另外的考虑：商业秘密

- Federal prosecutions have increased in recent years—TS theft is a growing intl issue

  联邦检控在近年开始增加 – 窃取商业秘密是一个不断增长的国际问题

- Section 337 litigation before the International Trade Commission---an alternative to criminal action for trade secrets theft and misappropriation

  由国际贸易委员会审理的337条款诉讼 – 一个窃取和滥用商业秘密的除刑事诉讼外的另一选择

- A federal civil cause of action for trade secrets coming? Stay tuned

  一个关于商业秘密的联邦民事诉讼的起诉理由来了？别走开

Federal Trade Secret Protection
联邦商业秘密保护

Economic Espionage Act of 1996 (18 USC 1831-9)

1996年经济间谍法案

- Criminal Statute, two sections: 刑事规定，两节

  1) Economic espionage: knowingly stealing or misappropriating a trade secret for the benefit of a foreign government or instrumentality or agent

  间谍活动：为外国政府或机构或代理故意窃取或滥用商业秘密

  – Penalty: up to15* years in prison and/or $500,000 fine

  - 处罚：15年以下徒刑和/或50万美元的罚款

Federal Trade Secret Protection
联邦商业秘密保护

2) Theft of trade secrets: knowingly stealing or misappropriating a trade secret related to a product in interstate/foreign commerce with intent to harm the owner and give economic benefit to someone else

窃取商业秘密：故意窃取或滥用有关州际的/国外的商务活动中的产品的商业秘密意图损害所有人并给予他方以经济利益

Penalty: up to 10 years in prison and/or fine

处罚：10年以下徒刑和/或罚款

Penalties are higher for entities under both sections

在这两节下对单位的处罚更重

THANK YOU!
谢谢！

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Backup Slides

US trade secrets litigation (noncriminal)
美国商业秘密诉讼（非刑事）

- Broad discovery availability

  广泛的发现可用性

- TROs and preliminary injunctions “freeze” the TS leakage situation at status quo throughout the litigation period; permanent injunctions often readily available if case is successfully proven

  TROs和临时禁令将商业秘密泄露的当时状态在诉讼期间冻结；而如果案件被成功证明则经常能很容易的施用永久禁令

US trade secrets litigation (noncriminal)
美国商业秘密诉讼（非刑事）

- In camera and attorney restrictions--special procedures available to prevent further disclosure of TS to respondent, 3d parties

  不公开审判和律师限制 – 对被告，第三方
  适用特别的程序以防止商业秘密的进一步泄露