CERC IP Workshop
中美清洁能源联合研究中心知识产权研讨会

Managing Patents
管理专利

Hainan Haikou 海南海口

5-6 March 2012

2012年3月5-6日

TEE & HOWE
Intellectual Property Attorneys

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北京天昊联合知识产权代理有限公司

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Major Differences Between CN and US Patent Laws
中国与美国专利法的主要区别

CN 中国	US美国
Prior art base – publications before the patent application date, and prior-use in anywhere of the world 现有技术 – 所有在申请日前公开的出版物，和在任何地方的在先使用	Prior art base – publications before the patent application date, and prior-use in the US [Note 1] 现有技术 –所有在申请日前公开的出版物，和在美国的在先使用 [附注1]
No grace period of disclosure except for non-prejudice disclosure 没有公开的宽限期，除了特殊的不丧失新颖性公开以外	1-year grace period of self-disclosure 针对发明人的公开，有1年的宽限期
No continuation or continuation-in-part 没有继续或部分继续申请机制	Continuation or continuation-in-part available 有继续或部分继续申请机制

Note 1: will change to prior-use in anywhere of the world when the AIA comes into force in 2013

附注1: 将在2013年在美国发明法案生效后改为在任何地方的在先使用

Major Differences Between CN and US Patent Laws
中国与美国专利法的主要区别

CN 中国	US美国
Joint-ownership → by default, each patentee can grant non-exclusive license without consent of other patentee(s), unless otherwise agreed 多人共同拥有专利 → 除非另外有协议，否则默认为每个专利权人都可以在没有其他专利权人同意下，授予非独占性许可	Joint-ownership → by default, each patentee can only grant non-exclusive license with consent of other paten tee(s), unless otherwise agreed 多人共同拥有专利 → 除非另外有协议，否则默认为每个专利权人都只可以在有其他专利权人同意下，授予非独占性许可
Any one can apply for a compulsory license 任何人都可以申请强制许可	Compulsory license only granted to the US government 强制许可只授予美国政府
Utility model available in addition to invention patent and design patent 除了发明专利和外观专利以外，还有实用新型	No utility model (utility patent = invention patent) 没有实用新型

Major Differences Between CN and US Patent Laws

CN	US
No patent term adjustment 没有专利期限调整	Patent term adjustment available 有专利期限调整
Two-track litigation – infringement and invalidation are separated 双轨诉讼制 – 侵权和无效分开处理	Infringement and invalidation are typically trialed together 侵权和无效通常会一起审讯
Company or inventor can be applicant 单位或发明人都可以作为申请人	Only inventor can be applicant 只有发明人可以作为申请人
First to file 先申请	First to invent [Note 2]先发明 [附注2]
More non-patentable subject matters 比较多不受专利保护的客体	Fewer non-patentable subject matters 比较少不受专利保护的客体
Invalidation at SIPO, appeal at court SIPO处理无效，法院处理对无效的上诉	Invalidation at USPTO or court 美国专利局或法院处理无效

Note 2: will change to first to file when the AIA comes into force in 2013
附注 2:将在2013年在美国发明法案生效后改为先申请

Major Differences between CN and US Patent Laws - In Practice
中国与美国专利法的主要区别- 在实践中。。。。

- US is much more patentee/applicant friendly 美国对专利权人/申请人更有利
  - 1-year grace period 1年宽限期
  - Much broader scope of amendments更宽的申请后修改范围
  - Various mechanisms to “fix” a patent application → continuation多种补救有问题的专利申请的机制 → 继续申请
  - Patent term adjustment专利期限调整
  - May face difficulties when prosecuting a US patent specification in China但是，美国的专利说明书在中国申请时经常遇到困难
- Solution – involve Chinese patent attorney during drafting of patent specification解决方案 – 让中国专利代理人参与专利说明书的撰写

Major Differences between CN and US Patent Laws - In Practice
中国与美国专利法的主要区别- 在实践中。。。。

- Utility model实用新型
  - Quick grant 快授权
  - Short protection term 保护期限短
  - Limited to mechanical inventions限制于机械类发明
  - Can apply in parallel with invention patent可同时与发明专利同时申请
  - Not used by foreign entities外国企业没有采用

Major Differences between CN and US Patent Laws - In Practice
中国与美国专利法的主要区别- 在实践中。。。。

- Joint ownership of patent **NOT** recommended in China
  在中国，不建议多方共同拥有专利
- Unless otherwise specified, all co-owners can practice and license the patent without each other's consent → possible for partner to give license to competitor除非另有协议，否则默认为每个专利权人都可以在没有其他专利权人同意下，行使和授予许可 → **伙伴可能会授予竞争对手许可**
- Enforcement requires consent from both parties诉讼需要其他专利权人同意
- Suggested solution → form a JV and transfer the patent to the JV 解决方案 → 成立合资企业并将专利转移到该合资企业

Major Differences between CN and US Patent Laws - In Practice
中国与美国专利法的主要区别- 在实践中。。。。

- Compulsory license - provisions similar to those in other countries 强制许可 – 条例与其他国家类似
- Grounds to apply for compulsory license in China在中国可以申请强制许可的理由
  - The invention is not practiced or practiced within China sufficiently within 3 years from grant without justification 无正当理由没有在授权后三年内在中国行使或足够地行使发明
  - The enforcement of the patent is judged to be against anti-trust law行使专利权被认定为垄断行为
- Not granted in practice实践中，没有被授予过

Major Differences between CN and US Patent Laws - In Practice

中国与美国专利法的主要区别- 在实践中。。。。

- Two-track litigation system in China中国实行双轨诉讼制
- Similar to that in Germany, infringement and invalidation are trialed separately和德国类似，侵权和无效分开审理
- Preliminary injunction not granted easily诉前禁止令不容易得到

Invention from joint development 共同开发的发明

- Ownership 拥有权
  - Agreement between parties prevails 优先考虑参与者之间的协议
  - Otherwise, inventorship has to be first determined, and based on the identified determine the ownership → who invents, who owns the rights 没有协议的话，需要先确定发明人，然后确定拥有权 → 谁发明，谁拥有
- Various terms in agreements 多种不同的协议

Invention from joint development 共同开发的发明

- Various terms than can be considered in agreements 协议可以考虑的多种不同条款
  - Patent rights transferred to one party with remuneration, subject to further conditions 权利权可以在有偿的情况下有一方转移到另一方，可以受限于更多条件
  - License
    - License fee – free? Lump sum? Based on sales? 许可费 – 免费？ 一笔？基于销售？
    - Rights to sub-license 再许可的权利
    - Exclusive独占性

Handling of new IP 处理新产生的IP

- New IP arises from development during cooperation, e.g. improvements on products在合作时发展的新IP，例如新产品的开发
- Clauses prohibiting tech development in contract violates the Chinese Contract Law 在合约中阻止技术研发的条款违反中国合同法
- Should consider 应该考虑:

Mechanisms for good recordkeeping, for indentifying inventors → determination of ownership 好的记录机制，以识别发明人 → 确定拥有权
If ownership distribution cannot be decided at the start of the project, mechanisms for discussion of ownership and costs for establishing IP should be established 如果拥有权的分配不能在合作计划开始时决定，那应该考虑讨论拥有权和建立IP的费用的机制

Handling of new IP, special points to be noted in China
处理新产生的IP，在中国需要注意的特别事项

- Inventions completed in China must obtain clearance before filing patent applications elsewhere.在其他地方申请专利权前，在中国完成的发明必须通过在中国的保密审查

Handling of new IP, special points to be noted in China
处理新产生的IP，在中国需要注意的特别事项

- If IP is completed by more than one entity, for example A and B, then unless otherwise specified如果发明是由多个单位完成的，比如说由A和B完成，没有其他协议的话
  - A and B are co-owners of the invention A 和 B 是发明的共同拥有人
  - If B declares giving up patent application rights and A eventually obtains the patent, B is entitled to practice the invention for free 如B声明放弃专利申请权而A最终获得专利权，B有权免费施行该发明
  - If A or B disagrees to apply for patent, then the remaining party cannot apply for patent on its own 如A或B不同意申请专利，余下的一方不可以申请专利

Handling of new IP, special points to be noted in China
处理新产生的IP，在中国需要注意的特别事项

- Unless otherwise specified, when selling the new IP, default first-right-of-refusal to:没有其他协议的话，在售卖新发明专利权的时候，默认的有优先购买权属于：
  - Inventor(s) 发明人
  - Client of contracted research 合约发明的顾客
  - Co-owner of invention 发明的共同拥有人

Handling of new IP, special points to be noted in China
处理新产生的IP，在中国需要注意的特别事项

- Contracted research 合约发明
  - Unless otherwise specified, entity completing the invention owns the patent application right没有其他协议的话，完成发明的单位拥有发明的专利申请权
  - However, client of the contracted research is entitled to practice the invention for free 但是，合约发明的顾客有权免费施行该发明

Licensing – some special points about China
许可 – 在中国需要注意的特别事项

- For a patent license, Chinese Contract Law :在专利许可中，中国合同法：
  - requires licensor to provide necessary information, guidance and assistance to the licensee to practice the invention → includes trade secret?要求许可方提供需要的资料、指导和帮助以实施发明 → **包括商业秘密？**
  - unless otherwise specified, licensee is forbidden to sub-license without licensor's consent 没有其他协议的话， 禁止被许可方在没有许可方同意下再颁发许可

Trade secrets – characteristics 商业秘密 – 特点

- Any information not available to the public 所有公众不知道的资讯

Advantages	Disadvantages
• No registration required 无需登记 • Protection can last forever as long as secret is maintained 只要保持秘密，保护可以持续到永远	• Non-exclusive → can be circumvented by independent development 非排他性 → 可以被独立钻创作绕过 • Need to take substantive measures to maintain the secret 需要采取实际行为保持秘密 • Once breached, the public is free to use 一旦暴露，公众可以免费使用 • Only can target and claim damages from the person who made the breach 只可以追究泄露秘密的人

Trade secrets in China
商业秘密在中国

- **Typical scenario** – an ex-employee joins a competing company, or even forms his own company using trade secrets from ex-employer
- 典型的情节 – 前员工利用前雇主的商业秘密加入竞争对手，或甚至成立自己的公司

To successfully sue for breach of trade secret by a person, need to prove:

要成功的起诉一个人侵犯商业秘密，需要证明：

- the information is indeed qualified as secret资讯真正地符合秘密的资格
- that person does not have the right to breach那个人没有权利泄露秘密
- that person did know and breach那个人的确知道并泄露秘密
- the damages suffered by the petitioner请求人承担的损失
- independently verify the above 独立的证实以上的事项

Background IP – 3rd party licensing
背景IP – 第三方许可

- Study scope of patent and activities to know whether 3rd party licensing is required 需要研究比较专利范围和自身行为，以知道是否需要第三方许可
- Once necessity is determined一旦决定需要第三方许可
  - Has the license been obtained?许可已经得到了吗？
  - Can the license be involved in the transfer? 许可可以在以后技术转移中一起被转移吗？
  - Is a sub-license required?需要再许可吗？

Note

- These materials are public information and have been prepared solely for educational purposes to contribute to the understanding of Chinese intellectual property law.
- These materials reflect only the personal views of the author and are not individualized legal advice.
- It is understood that each case is fact-specific, and that the appropriate solution in any case will vary. Please seek specific advise for each of your IP matters.
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- While every attempt was made to insure that these materials are accurate, errors or omissions may be contained therein, for which any liability is disclaimed.

Q&A

Thank you for your participation.

Any Questions?

About the Speaker

Dr. Toby Mak is a registered Chinese Patent Attorney and has a PhD degree in Chemistry. Toby was born in Hong Kong and graduated from the Hong Kong University of Science and Technology. Toby worked at one of the largest law firm in Hong Kong for 8 years before joining Tee & Howe.

Toby has over 10 years of experience in patents and designs. He has substantive experiences in handling both contentious and non-contentious matters, including prosecution, invalidation and enforcement. He has drafted numerous patent specifications and prosecuted relevant applications to grant in various countries including China, the USA, Europe, Japan, and so on.

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