Intellectual Property, Innovation and Investment in Clean Energy: Exploring US-China Perspectives

Toby Mak, 26 & 27 Feb 2013

关于清洁能源的知识产权、创新和投资：探索中美合作的前景

麦善勇，2013年2月26日、27日

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About the Speaker
作者简介

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.

麦善勇博士是拥有化学博士学位的执业中国专利代理人。他生于香港，毕业于香港科技大学。在加入北京天昊之前，曾在香港最大的律师事务所之一从事知识产权事务8年。

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About the Speaker
作者简介

Before obtaining the Chinese qualification, he was trained under the UK system and took the UK CIPA examinations, and passed some of the papers. He is frequently invited by various organizations to speak on Chinese IP, including the USPTO, the EPO, the LES, the European Chamber of Commerce, and the Canadian Embassy. He also actively publishes articles on Chinese IP in various IP journals including the UK CIPA Journal and the Intellectual Property Magazine.

在获得中国专利代理人资格之前，他曾学习英国专利制度，参加了英国CIPA考试并且通过了其中一些考试。他经常受邀到一些机构就中国知识产权事宜发表演讲，其中包括美国专利局、欧洲专利局、国际许可贸易工作者协会、欧盟商会和加拿大大使馆等。此外，他积极在英国CIPA期刊和知识产权杂志等多个知识产权期刊上发表论文探讨中国知识产权相关的问题。

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Using IP in China effectively
在中国有效使用知识产权

- **Different kinds of tech transfers & practical notes**
  技术转让的不同方式&实践中的注意事项
- Take away message
  结论
- Q&A
  问与答

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Tech transfer into/out of China
中国技术进出口

- Governed by the Chinese Patent Law and the “Administrative Regulations on Export and Import of Technologies”

  由《中国专利法》和《中华人民共和国技术进出口管理条例》监管

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Tech transfer into/out of China
中国技术进出口

- Three categories（三个类别）:
  - “forbidden technologies”
    “禁止进出口的技术”
  - “restricted technologies”
    “限制进出口的技术”
  - “free technologies”, which include all other technologies that do not belong to the above two categories
    “自由进出口的技术”，包括除以上两个类别之外的其他所有技术

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Tech transfer into/out of China
中国技术进出口

- "Restricted technologies" and "forbidden technologies"

  "限制进出口的技术" 和 "禁止进出口的技术"
- Lists maintained by the Chinese State Council and updated occasionally (export – 2008; import - 2007)

  中国国务院颁发以及修正限制进出口和禁进止出口技术目录（出口-2008； 进口-2007）

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Tech transfer into/out of China
中国技术进出口

- Very specific
  非常具体
  - “Forbidden technologies” are not allowed to be transferred
    “禁止进出口的技术”不允许转让
  - “Restricted technologies” must obtain special approval before transfer
    “限制进出口的技术”需要经过有关部门批准才允许转让

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Examples of forbidden tech
禁止进出口技术的实例

- Import (进口)
  - Phosphorous and organic phosphorous formulations of water treatment uses in petrochemical industry

    石化工业用水处理药剂磷系和有机膦系配方
  - Automobile engine manufacturing technology: manufacturing technology for gasoline engine having volume power below 50KW and diesel engine having swept volume of below 3 liter and volume power of below 40KW

    汽车发动机产品技术: 升功率低于50KW汽油机制造技术，升功率低于40KW的3升以下柴油发动机制造技术
  - Battery manufacturing technology: equipment and technology for battery containing mercury, alkali and manganese

    电池制造技术: 含汞碱锰电池设备和技术

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Examples of restricted tech
限制进出口技术的实例

- Import （进口）
  - Petroleum processing, coking and nuclear fuel processing industries: half-regeneration reforming technology

    石油加工、炼焦及核燃料加工业: 半再生重整技术
  - Sewage disposal technology: 1. technology for disposing primary and secondary sewage using activated sludge process, biofilm process and anaerobic biological method 2. sewage disposal technology using conventional chemical and physical methods

    常规污水处理技术: 1. 常规活性污泥法、生物膜法和厌气生物法泥Ⅰ、Ⅱ级污水处理工艺技术; 2. 常规化学法、物理法污水处理工艺技术

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Examples of restricted tech
限制进出口技术的实例

- Import （进口）
  - Aerobic biological treatment (compost) technology used in disposing household garbage : 1. when referring to aerobic biological treatment (compost) technology used in disposing household garbage, manufacturing technology for key equipment like turns mow machine and garbage crushing equipment is not included; 2. compost technology used in disposing mixed household garbage; 3. “zero pollution” treatment technology for disposing household garbage.

    生活垃圾好氧生物处理(堆肥)工艺技术: 1. 常规生活垃圾好氧生物处理（堆肥）工艺技术，但不包括翻堆机、垃圾破碎设备等关键设备的生产技术; 2. 混合生活垃圾堆肥技术; 3. 生活垃圾“零污染”处理技术

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Examples of restricted tech
限制进出口技术的实例

- Export （出口）
  - Preparation and processing technology for functional high polymer material with bioactivity

    带生物活性的功能性高分子材料制备和加工技术
  - Combustion technology for boiler making: 1. software technology for coal characteristic test and research used to provide coal quality information for boiler design; 2. reliability assessment for subcritical circulation (consisting of control circulation and natural circulation) coal-fired boilers

    锅炉制造的燃烧技术: 1. 为锅炉设计提供煤质资料的煤特性试验研究软件技术; 2. 亚临界循环（包括控制循环和自然循环）燃煤锅炉的可靠性评价

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Examples of restricted tech
限制进出口技术的实例

- Wire and cable manufacturing technology: manufacturing technology for electric cable of oil submerged pump with aluminum jacket at high temperature (120℃)
  电线、电缆制造技术:高温（120℃）铝护套潜油泵电缆的制造技术

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Approval for restricted tech
批准限制进出口的技术

- The competent commercial authorities of provinces, autonomous regions, and municipalities (hereinafter the local competent commercial authorities) are the review authorities of restrict technologies, and are responsible for granting licensing for import and export of restrict technologies in their respective jurisdictions

  各省、自治區、直轄市商務主管部門（以下簡稱地方商務主管部門）是限制進出口技術的審查機關，負責本行政區域內限制進口技術的許可工作

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Approval for restricted tech
批准限制进出口的技术

- The local competent commercial authorities shall organize technology and trade experts to conduct technical and trade examination and review on the technology under application for import within 30 working days upon receipt of the Application and determine whether or not to approve the import/export thereof.

  地方商務主管部門自收到《申請書》之日起30個工作日內，組織技術和貿易專家對申請進口的技術進行技術和貿易審查，並決定是否準予進口/出口。

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Approval for restricted tech
批准限制进出口的技术

- The local competent commercial authorities organize technology and trade experts to conduct examination and review on the technology under application for import within 30 working days upon receipt of the application documents, and determine whether or not to approve import.

  收到申请文件之日起30個工作日內，組織技術和貿易專家對申請進口的技術進行技術和貿易審查，決定是否準予進口
- Trade examination and review

  貿易審查
- Technical examination and review

  技術審查

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Different kinds of “exclusivity” in Chinese license

Exclusive licensee

独占被许可人 → Truly exclusive (also exculde patentee)

排他独占被许可人 → Only exclude 3rd party (does not exclude patentee)

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Assignment in China – Patent
中国专利权转让

- Co-ownership of patent **NOT** recommended

  不建议共同拥有专利权

- 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

  除另有规定外，专利的任一专利权人可以在不经过其他专利权共有人同意的情况下实施专利、许可专利→ 有可能出现合伙人许可竞争对手享有专利权的情况

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Licensing in China- handling disputes
中国的专利许可- 处理纠纷

- Chinese judges “strongly” encourage mediation
  中国法官“强烈”鼓励调解
- If disputes are specified to be handled outside of China, be careful that Chinese courts are not obliged to honor the outcome of such foreign proceedings.
  如果按照规定在中国以外的国家处理纠纷，那么中国法院没有责任采用国外诉讼的结果。

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Licensing in China – Monitoring licensee activities
中国的专利许可-监管被许可方行为

- Excess products/over-runs produced
  过剩产品/ 超额生产
  - Licensee has to find a way to dispose excess products while recovering cost → leak to the market
    被许可方需要想办法处理过剩产品，收回成本→ 流出市场
  - Buy-back mechanism may avoid these from leaking to the market
    返销机制可以防止过剩产品流出市场

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Licensing in China – Monitoring licensee activities
中国的专利许可-监管受让人行为

- IP filings
  知识产权申请
  - Bad-faith registrations
    恶意注册
  - Developments
    进展

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Licensing in China – Challenge on validity from licensee
中国的专利许可- 被许可方挑战有效性

Clause NOT allowed 不允许的条款	Allowed clause 允许的条款
Forbid licensee to challenge validity 禁止被许可方质疑有效性	Immediate termination upon challenge 如遭挑战立即终止合同
	Increases license fee upon challenge如遭挑战即增加许可费
	Request for a lump sum upon challenge to defend validity 为辩护有效性，遭挑战时被许可方支付一笔费用

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Licensing in China – Handling new IP
中国的专利许可- 处理新的知识产权

- New IP arises from development during cooperation, e.g. improvements on products

  双方合作时由开发产生新的知识产权，例如对产品的改进

- Clauses prohibiting tech development in contract violates the Chinese Contract Law

  合同中禁止技术开发的条款违反中国合同法的规定

- Should consider:

  应该考虑：

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Licensing in China – Handling new IP
中国的专利许可-处理新的知识产权

- Should consider:
- 应该考虑：

Mechanisms for good recordkeeping, for indentifying inventors → determination of ownership
良好的记录机制，用于确认发明人的身份→ 确定所有权

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
如果在开始阶段无法决定所有权的分配，应建立相应机制以便探讨所有权的分配和取得知识产权的成本

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Licensing in China – Handling new IP
中国的专利许可- 处理新的知识产权

- Inventions completed in China must obtain clearance before filing patent applications elsewhere.

  在中国完成的发明如果在国外申请专利需要获得政府批准

- Covers only invention patent and utility model

  只涉及发明专利和实用新型

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Licensing in China – Handling new IP
中国的专利许可- 处理新的知识产权

- Failure to comply with will result in:

  不遵守以上规定会导致：

  – Refusal of grant and/or invalidation of patent rights in China

    在中国无法获得授权和/或专利权无效

  – Criminal charges if invention concerns national security

    如果发明涉及国家安全将面临刑事起诉

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Licensing in China – Noteworthy and changeable default clauses
中国的专利许可- 值得注意的和可变的违约条款

- If *new IP is completed by more than one entity*, for example A and B, then

  如果新的知识产权是由多方共同完成的，例如A和B，那么
  - A and B are co-owners of the invention

    A和B是此项发明的共同所有人
  - If B declares giving up patent application rights and A eventually obtains the patent, B is entitled to practice the invention for free

    如果B宣布放弃专利申请权并且A最终取得了专利授权，B拥有免费实施此项发明的权利
  - If A or B disagrees to apply for patent, then the remaining party cannot apply for patent on its own
  - 如果A或B不同意申请专利，那么另一方无权单独申请专利。

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Licensing in China – Noteworthy and changeable default clauses
中国的专利许可- 值得注意的和可变的违约条款

- when selling the new IP, *default first-right-of-refusal* to:
  转让新的知识产权时，以下各方有默认优先权：
  - Inventor(s)
    发明人
  - Client of contracted research
    合同研究的委托人
  - Co-owner of invention
    发明的共同所有人

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Licensing in China – Noteworthy and changeable default clauses
中国的专利许可-值得注意的和可变的违约条款

- *Contracted research*
  合同研究
  - entity completing the invention owns the patent application right
    完成发明的一方拥有专利申请权
  - However, client of the contracted research is entitled to practice the invention for free
    然而，合同研究的委托人拥有免费实施发明的权利

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Licensing in China – default implicit clause in patent license

中国的专利许可- 不履行专利许可中的隐含条款

- For a patent license, Chinese Contract Law:

  关于专利权许可，中国合同法规定：

  – requires licensor to provide necessary information, guidance and assistance to the licensee to practice the invention → includes trade secret?

    许可方应当提供被许可方实施专利有关的技术资料、必要的技术指导和帮助→包括商业秘密？

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– unless otherwise specified, licensee is forbidden to sub-license without licensor's consent

除另有规定外，被许可方不经许可方同意不得许可约定以外的第三人实施该专利

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Questions & Answers
问与答

Any Questions?

欢迎大家提问

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