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Note from the Editors

First, we would like to thank the many readers who provided feedback on our inaugural issue of the Morrison & Foerster China Intellectual Property newsletter. We are glad that you found the articles informative, and appreciate your comments on making the information as relevant to Chinese companies as possible.

In this issue, we first discuss the Third Amendment to the Chinese Patent Law ("Third Amendment") and the High Court's recent Comments on implementing the National IP strategy. We also discuss some strategic uses of continuation patent applications made possible by the Third Amendment.

This issue of the newsletter also discusses the implications of *Chint v. Schneider*, a case that has received worldwide attention, and what the ruling means for both Chinese companies that hold intellectual property assets and multinational companies accused of infringement in China.

We are also happy to report two recent victories secured by Morrison & Foerster LLP for Acon Laboratories, which has operations both in the U.S. and China; and Evapco, Inc, a U.S. manufacturer of water treatment devices.

We hope you find Morrison & Foerster's China IP Quarterly Newsletter informative, and we will continue to monitor the latest developments to keep you informed. ■

编者按

首先，我们想对众多就美富中国知识产权通讯创刊号给予反馈的读者表示感谢。如果我们的文章让您有所收益，我们将感到欣慰；对于您的“应尽量提供与中国企业有关的信息”的评论我们深表赞赏。

在本刊中，我们首先讨论中国《专利法》第三次修正（“《第三次修正》”），以及中国最高法院最近有关国家知识产权战略实施的意见。此外，我们讨论了《第三次修正》生效后中国公司可以采取的一些新的专利申请策略。

本刊还分析了倍受世界关注的“正泰诉施耐德案”的意义，及此案判决对作为知识产权所有人的中国公司和在中国被控侵权的跨国公司带来的深远影响。

最后，我们很高兴介绍美富最近分别为在美国和中国均有分部的艾康公司和美国水处理设施生产商益美高（Evapco）公司赢得的胜诉。

我们希望美富中国知识产权季度通讯能为您提供有用信息，而且我们将继续追踪知识产权领域的最新发展，为您提供最新资讯。■

Recent Developments in Chinese Intellectual Property Law

Janet Xiao and Harris Gao

On June 5, 2008, China's State Council issued the "Outline of National Intellectual Property Strategy," which set forth a strategic goal that, by 2020, China will become a country with a comparatively high level of creation, utilization, protection, and administration of intellectual property rights. As steps towards implementing this strategy, the National People's Congress approved a Third Amendment to the Chinese Patent Law (the "Third Amendment") on December 27, 2008, and the People's Supreme Court published "Comments of the People's Supreme Court on Implementing the National Intellectual Property Rights Strategy" (the "Comment") on March 30, 2009.

This article discusses the key changes introduced by the Third Amendment and the key points raised by the Comment.

KEY CHANGES INTRODUCED BY THE THIRD AMENDMENT TO CHINESE PATENT LAW

The Third Amendment, which will come into effect on October 1, 2009, reflects China's desire to bring the Chinese patent law into closer conformity with international standards. It specifically recognizes that the patent system promotes not only "the development of science and technology," but also "the development of economy and society." The Third Amendment has introduced significant changes that will impact procurement and scope of patent protection, and enforcement of patent rights.

Higher patentability standard

The Third Amendment has raised the patentability standard by broadening the definition of prior art. Under the current law, the fact that an invention was publicly used or known to the public in countries other than China does not affect the patentability of the invention. The Third Amendment has removed this territory restriction, and defines prior art as "any technology known to the public in this country or abroad before the date of filing." Thus, an invention that was made, publicly known, or used outside China can no longer be patented in China. Public use or knowledge outside China may also be relevant to the determination of inventiveness.

The Third Amendment has also raised the standard with regard to conflicting applications. A "conflicting application" refers to an application that was filed before but published later than the filing date of the subject application. Under the current law, an earlier filed application can destroy the novelty (but not inventiveness) of later patent applications filed by a different applicant. On the other hand, an earlier filed application does not constitute prior art against a later patent application filed by the same applicant. The Third Amendment has eliminated this difference, making the earlier filed application prior art regardless of the identity of the applicant. Applicants who file multiple applications with overlapping subject matter should pay particular attention to this provision, and should carefully analyze the different applications to ensure that the earlier filed patent applications do not destroy the novelty of the later filed applications.

Removing "first filing in China" requirement

Under the current law, whenever a Chinese entity or individual intends

中国知识产权法的最新发展

作者：肖捷和高焕勇

2008年6月5日，中国国务院发布了《国家知识产权战略纲要》，明确到2020年把中国建设成为知识产权创造、运用、保护和管理水平较高的国家。为实施这一战略，全国人民代表大会于2008年12月27日批准通过《中国专利法第三次修正》（“《第三次修正》”），最高人民法院于2009年3月30日公布了《最高人民法院关于贯彻实施国家知识产权战略若干问题的意见》（“《意见》”）。

本文讨论了《第三次修正》提出的修改要点及《最高法院意见》提出的主要问题。

《第三次修正》对中国《专利法》提出的修改要点

《第三次修正》将于2009年10月1日生效，它反映了中国希望中国《专利法》与国际接轨的愿望。《第三次修正》特别提出，专利制度不仅能促进“科学技术进步”，还能推动“经济社会发展”。《第三次修正》做出的重大修改将给专利保护的取得、范围以及专利权的实施带来影响。

更高的可专利性标准

通过扩大现有技术的定义，《第三次修正》提高了可专利性的标准。根据现行法律，在中国以外的其他国家公开使用或为公众所知并不会影响发明的可专利性。《第三次修正》取消了上述地域限制，而将现有技术定义为“指申请日以前在国内外为公众所知的技术”。因此，如一项发明已在中国境外为公众所知或使用，则不能在中国获得专利权。在中国境外使用或为公众所知还可能会影响对创造性的确定。

此外，《第三次修正》还提高了与冲突申请有关的标准。“冲突申请”是指一项在标的申请的申请日之前提出但在标的申请的申请日之后公布的申请。根据现行法律，在先提出的申请会破坏由不同申请人在后提出的申请的新颖性（但并非创造性）。但另一方面，一项在先提出的申请对于同一申请人后来提出的专利申请并不构成现有技术。《第三次修正》消除了该等差异，规定在先提出的申请即可构成现有技术，而无须考虑申请人的身份。如申请人提出多项申请且该等申请的标的有重叠的，其应特别注意上述条款，并应对不同的申请进行认真分析，以确保在先提出的专利申请不会破坏在后提出的申请的新颖性。

to file a patent application in a foreign country for an invention made in China, it or he must first file an application in China. The Third Amendment has now removed this requirement, and provides that "any entity or individual may file a patent application in a foreign country for its/his invention-creation made in China."

Importantly, the Third Amendment has also added a new requirement for national security review. Before a party can file a patent application first in a foreign country for an invention made in China, it needs to obtain clearance from the State Intellectual Property Office ("SIPO") for a national security review. Notably, the requirement of national security review applies not only to a Chinese entity or individual, but also to foreign entities or individuals who made their inventions in China. Foreign entities having research centers in China should pay particular attention to this provision, as the consequence of not complying with the national security review requirement will be the loss of the right to patent in China. SIPO will promulgate detailed regulations on national security review in the near future. However, based on our conversation with Chinese patent law experts and SIPO officials, we believe that, for most applicants, the national security review probably will only pose a procedural, rather than substantive, hurdle for filing overseas. In particular, the review is likely to focus more on the field of the invention rather than the invention itself.

Clarifying patent rights of co-owners

The current law is silent on whether and how a patent co-owner can individually exploit co-owned patents or patent applications. The Third Amendment has clarified that, where a patent application or patent is co-owned by two or more parties, any of the co-owners could individually exploit or authorize others to exploit the patent right through nonexclusive licensing agreements. However, the royalty obtained from the license of the patent right must be shared by all of the co-owners. However, consent from all co-owners is needed for any other ways of exploiting the co-owned patent rights, such as exclusive licenses and patent assignments.

Codifying prior art defense

The Third Amendment has introduced for the first time the concept of prior art as a defense to infringement under the Chinese patent law.

Under the current law, a defendant in a patent infringement case cannot assert invalidity as a defense in court, but needs to file an invalidation petition with the Patent Reexamination Board. The patent infringement and invalidation proceeding typically run in parallel to each other. Such a parallel system frequently results in a prolonged infringement proceeding, and inconsistent results.

Under the Third Amendment, there can be no infringement if an alleged patent infringer can show that the allegedly infringing technology was known before the filing date of the patent. The alleged infringer may assert the prior art as a statutory defense to infringement, by showing that its technology or product "belongs to prior art." This prior art defense would not invalidate the patent. To invalidate the patent, the alleged infringer would still need to file an invalidity petition with the patent office.

Introducing a prior art defense reflects a first step towards taking the strength of the patent into account in a patent infringement proceeding. Nevertheless, it should be noted that, the comparison in the prior art defense is carried out between the accused technology and the prior art, rather than between the claim scope of the allegedly infringed patent and the prior art as in a patent invalidation proceeding.

取消了“首先在中国提出专利申请”的要求

根据现行法律，如果中国单位或个人想将一项在中国完成的发明向外国申请专利，其应首先在中国提出申请。《第三次修正》取消了上述要求，并规定“任何单位或个人可将其在中国完成的发明创造向外国提出专利申请。”

重要的是，《第三次修正》还增添了一项新的国家保密审查规定。在当事人将一项在中国完成的发明首先向外国提出专利申请之前，需从国家知识产权局获得有关国家保密审查的批准。须引起注意的是，国家保密审查要求不仅适用于中国单位或个人，还适用于在中国完成其发明的外国单位或个人。在中国设有研究中心的外国单位应特别注意上述规定，因为不遵守国家保密审查规定的后果是其将无法在中国获得专利权。国家知识产权局很快便会颁布有关国家保密审查的具体规定。不过，根据我们与中国专利法专家及国家知识产权局官员的交流，我们认为，对大多数申请人而言，国家保密审查可能只是在海外申请形式上而非实质的障碍。特别是，审查很可能更多地关注发明所属的领域而不是发明本身。

阐明了专利共有人的权利

对于专利共有人是否能够以及如何单独实施共有专利或专利申请，现行法律未做出任何规定。《第三次修正》明确规定，如果一项专利申请或专利为两个或以上当事人共有，任何共有人均可单独实施或通过非排他性许可协议授权他人实施专利权。不过，因许可专利权而取得的使用费必须由所有共有人共享。但是，以任何其他方式实施共有的专利权（如独家许可和专利转让）应当取得全体共有人的同意。

将现有技术抗辩事由正式纳入法律

《第三次修正》首次将现有技术作为中国《专利法》项下的一项抗辩事由。 根据现行法律，专利侵权案的被告无法将无效性作为法庭抗辩事由，而需要向专利复审委员会提交无效宣告请求。专利侵权诉讼和无效宣告程序一般并行进行。这种并行机制经常导致侵权诉讼程序历时较长以及诉讼结果不一致。

根据《第三次修正》，如果被控专利侵权人能够表明被控侵权的技术在专利申请日之前就已为人所知，则不存在侵权。通过表明其技术或产品“属于现有技术”，被控侵权人可将现有技术作为法定的侵权抗辩事由。此项现有技术抗辩不会使专利无效。要使专利无效，被控侵权人仍需向专利局提交无效申请。

在专利侵权诉讼中引入现有技术抗辩事由表示已开始在专利侵权诉讼程序中考虑到专利的效力。但是应注意到，提出现有技术抗辩事由时是将被控技术与现有技术作比较，而不是象在专利无效宣告程序中，将涉嫌被侵权技术的权利要求范围与现有技术作比较。

Strengthening enforcement of patent rights

The Third Amendment significantly strengthened enforcement of patent rights in several ways. First, the Third Amendment explicitly states that the damages for patent infringement shall include reasonable expenses incurred by the patent owner for stopping the infringement activities. It also provides statutory damages from 10,000 RMB to 1,000,000 RMB (approximately from US$1,500 to US$150,000). Second, the Third Amendment also explicitly states that, where the evidence may be lost or it may be difficult to obtain later on, the patentee or interested party may petition the court to provide evidence preservation before instituting a lawsuit.

Clarifying compulsory license requirement

The Third Amendment provides that a compulsory license may be granted where: 1) the patentee, three years after the grant of the patent right and four years after the date of filing of the patent application, has not exploited the patent or has not sufficiently exploited the patent without any justified reason; and 2) the patentee's use of the invention constitutes monopolistic behavior. The Third Amendment further gives the SIPO the authority to grant compulsory licenses, for the purpose of public health, to manufacture a patented drug and export the drug to countries or regions in conformity with the provisions of relevant international treaties in which China participates. This amendment brings China into conformity with the Declaration on the TRIPS Agreement and Public Health of 2001 and the WTO Decision of 2003 on the Doha Declaration with respect to compulsory licensing.

Other changes

The Third Amendment also introduced some additional changes to which close attention should be paid. For example, the Third Amendment introduced a "Bolar" exception, which exempts from patent infringement the manufacture, import, or use of a patented drug or patented medical device by any person in order to acquire information necessary for regulatory approval. The Third Amendment also introduced an "international patent exhaustion" provision, which provides that, after a patented product was sold by the patentee or an individual authorized by the patentee, its importation into China shall not be deemed an infringement.

In addition, the Third Amendment requires that, for an invention created using genetic resources, the initial and direct origins of the genetic resources should be disclosed in the patent description. The Third Amendment also contains many provisions that will significantly impact the scope, strength, and enforceability of design patents.

Finally, the Third Amendment provides that only one patent may be granted for one invention, but implicitly confirms that it is acceptable to simultaneously file applications for utility model and invention patents for the same technology, so long as one abandons the utility model patent upon grant of the invention patent. This is significant for many, primarily domestic, applicants, who frequently take the strategic approach of securing a quick but limited patent protection on a utility model patent (which only undergoes formality examination) while the invention patent application is still going through substantive examination.

KEY POINTS RAISED BY THE SUPREME COURT'S COMMENT

The Supreme Court's Comment set out a series of goals toward implementing China's national intellectual property strategy. Provided herein are some key points raised in the Comment.

Promoting guiding roles of Chinese courts on intellectual property cases

Underscoring the importance of intellectual property to the establishment of an innovative country and development of the national economy, the Comment

加强了专利权实施

《第三次修正》通过多种方式显著加强了专利权实施。首先，《第三次修正》明确规定，专利侵权的赔偿数额应当包括专利权人为制止侵权行为所支付的合理开支。《第三次修正》还规定了一万元以上一百万元以下（约为一千五百美元以上十五万美元以下）的法定赔偿。其次，《第三次修正》还明确规定，在证据可能灭失或者以后难以取得的情况下，专利权人或者利害关系人可以在起诉前向法院申请保全证据。

阐明了强制许可要求

《第三次修正》规定，可在下列情况下给予强制许可：（一）专利权人自专利权被授予之日起满三年，且自提出专利申请之日起满四年，无正当理由未实施或者未充分实施其专利的；（二）专利权人行使专利权的行为被依法认定为垄断行为的。《第三次修正》还规定，为了公共健康目的，对取得专利权的药品，国家知识产权局可以给予制造并将其出口到符合中国参加的有关国际条约规定的国家或者地区的强制许可。此项修订使中国在强制许可方面符合了“2001年关于TRIPS协议与公共健康的宣言”和“2003年世贸组织关于多哈宣言的决定”。

其它修改

《第三次修正》还做了其它一些应予以密切关注的修改。例如，《第三次修正》引入了“Bolar”例外，规定为提供行政审批所需要的信息制造、使用、进口专利药品或者专利器械的，不视为专利侵权。《第三次修正》还引入了“国际专利权穷竭”条款，规定专利产品由专利权人或者经其许可的个人售出后进口该产品的，不视为侵权。

另外，《第三次修正》要求，对于利用遗传资源完成的发明创造，应当在专利申请文件中说明该遗传资源的直接来源和原始来源。《第三次修正》还包括许多会显著影响外观设计专利范围、效力和可实施性的条款。

最后，《第三次修正》规定，对同样的发明创造只能授予一项专利权，但明确确认，允许同一申请人同日对同样的发明创造既申请实用新型专利又申请发明专利，前提是申请人要在授予发明专利权后放弃该实用新型专利权。因为许多公司（主要是国内公司）经常采用的策略是，在发明专利申请接受实质审查的同时取得快速但有限的实用新型专利保护（仅需要接受形式审查），对于这些公司而言，上述规定具有重要意义。

《最高法院意见》提出的主要问题

《最高法院意见》为贯彻实施中国国家知识产权战略设定了一系列目标。以下为《意见》中提出的若干主要问题。

提升中国法院对知识产权案件的指导作用

为突出强调知识产权对建设创新型国家和发展国民经济

discusses extensively the guiding role of Chinese courts on intellectual property cases and the importance of establishing an efficient and comprehensive legal environment for intellectual property protection.

In particular, the Comment calls for studying the feasibility of setting up unified intellectual property tribunals and intellectual property appeal courts in China. According to the Comment, a unified intellectual property tribunal system will ensure efficiency and consistency, as well as allow integration of all IP-related civil, criminal, and administrative proceedings. Similarly, an effective IP appeal court is expected to effectively streamline the procedure for appeals and enhance efficiency and consistency in making decisions and judgments. The precise mechanisms of setting up such unified courts are not yet clear; neither is a timeline provided in the Comment.

The Comment also stresses the necessity for a unifying legal standard for intellectual property cases and discusses the possibility of establishing a Chinese case law guiding system. The Comment urges that courts promptly issue decisions with clear explanations and reasoning, ensure consistency in applying the legal standards, and make the judicial proceedings and issued decisions publicly available. Although the Comment does not clearly delineate the means for establishing a case law guiding system, it is clear that more importance will be attached to the guiding roles of prior intellectual property cases.

Enhancing intellectual property protection against infringers

Determined to strengthen the protection of intellectual property rights in China, the Comment stresses the importance of more severe sanctions against intellectual property infringers, particularly for malicious infringement, repeat infringement, and large-scale infringement. The Comment calls for the courts to use all means, including damages compensation, injunctive relief, mitigation, and seizing goods, to ensure that infringers are effectively deterred and that damaged parties are fully compensated.

With regard to injunctive relief, the Comment states that preliminary injunctions should be actively granted for trademark and copyright infringement cases, especially for intentional infringement such as counterfeiting and pirating. In patent cases, on the other hand, preliminary injunctions should be granted more prudently.

Improving jurisprudence on monopoly act and unfair competition

The Comment clarifies that, for a competitive activity that is not specifically regulated by anti-unfair competition law, it can only be identified as unfair competition if such activity is not in accordance with publicly recognized business standards and common understanding. The Comment cautions that, in areas where there is no business standard and no trade secret involved, unfair competition should not be determined merely on the basis that the activity utilizes or damages a particular competitive advantage.

The Comment further emphasizes the need for active initiation of trials in anti-monopoly cases, including anti-monopoly cases involving misuse of intellectual property rights. The Comment provides that courts should improve the quality of investigation during the trials of anti-monopoly cases and learn to build on previous trial experience. The Comment also calls for prompt clarification of judicial principles, judgment standards, and procedural rules relating to anti-monopoly trials.

CONCLUSION

The Third Amendment and Supreme Court's Comment reflect significant steps China has taken to improve its intellectual property protection. We expect these provisions will have significant impacts down the road. ■

的重要性，《意见》广泛探讨了中国法院对知识产权案件的指导作用以及建立高效、全面知识产权保护司法环境的重要性。

尤其是，《意见》要求研究在中国设置统一的知识产权审判庭和知识产权上诉法院的可行性。《意见》指出，统一的知识产权审判庭体制将确保高效性和一致性，并实现所有与知识产权相关的民事、行事和行政诉讼程序的整合。同样，高效的知识产权上诉法院将有效简化上诉程序并提高裁决和判决的效率和一致性。设置该等统一法院的机制尚不明确，《意见》中亦没有具体的时间安排。

《意见》还强调了统一知识产权案件司法标准的必要性，并探讨了建立中国案例司法指导制度的可能性。《意见》要求法院及时做出解释和说理清晰的裁判，确保法律适用标准的统一，并公开司法程序和所做的裁判。尽管《意见》并未明确阐述建立案例司法指导制度的方法，但显然将更加重视以前知识产权案件的指导作用。

加强知识产权保护，应对侵权人侵权

为了加强对中国知识产权的保护，《意见》强调了对知识产权侵权人进行更加严厉制裁的重要性，尤其是对恶意侵权、重复侵权和规模化侵权。《意见》要求法院运用一切手段，包括损害赔偿、禁止令救济、消除影响以及没收产品，确保有效地制止侵权人侵权，保障受害方获得充分的赔偿。

就禁止令救济而言，《意见》规定应对商标和版权侵权案件积极地授予初步禁止令，尤其是假冒和盗版等故意侵权。而另一方面，在专利案件中，应当谨慎地授予初步禁止令。

加强对垄断行为和不公平竞争的审判

《意见》明确指出，对于反不正当竞争法未作特别规定的竞争行为，只有当不符合公认的商业标准和普遍认识时，才可将该等行为认定为不公平竞争行为。《意见》警示称，在不存在商业标准和不涉及商业秘密的领域，不能简单地以利用或损害特定竞争优势为由，认定构成不正当竞争。

《意见》进一步强调了积极开展反垄断审判的必要性，包括涉及滥用知识产权的反垄断案件。《意见》规定法院应提高反垄断案件审判过程中调查的质量，并学习借鉴先前的审判经验。《意见》还要求及时明确与反垄断审判相关的司法原则、裁判标准和程序规则。

总结

《第三次修正》和《最高法院意见》反应了中国为加强知识产权保护采取的重要步骤。我们认为这些规定将对未来知识产权工作产生重要的影响。■

Patent Filing Strategy for Chinese Companies After the Third Amendment: U.S. Provisional Patent Application

By Harris Gao

Under the current law, where a Chinese entity or individual intends to file a patent application in a foreign country for an invention made in China, it or he shall first file an application in China. This "first filing in china" requirement is being removed by the Third Amendment to the Chinese Patent Law (the "Third Amendment"). Thus, effective on October 1, 2009, "any entity or individual may file a patent application in a foreign country for its/his invention-creation made in China."

This change in law gives Chinese companies more flexibility in obtaining patent protection. In particular, it enables Chinese companies to take advantage of favorable patent practices existing in other counties. This article will discuss one particular procedure that is unique to the United States: Provisional Patent Applications, and how Chinese companies can use this procedure to obtain better patent protection.

As Chinese patent law has required first filing in China, the common practice for Chinese applicants has been to file in China first, then in the U.S. or other countries within one year of the original filing date. When filing in the U.S. or other countries, translation is required.

Another popular practice is to file a PCT application (either in Chinese or English) using SIPO as the PCT receiving office first. The applicant then needs to apply for patents in individual countries (national stage) within 30 months of the original filing date.

Under the Third Amendment, starting on October 1, 2009, Chinese applicants will have more flexibility, and can first file their patent applications in any countries (after passing a national security review). Among the many new possibilities, the option of first filing a provisional patent application in the United States is particularly interesting. It is an easy, effective and low-cost way to establish priority, and can defer the patenting process and its associated fees for up to a year. Also, as explained below, it pushes the patent term back for up to a full year. While it may not be suitable for all applicants, it offers some distinct advantages in certain circumstances.

The United States established the provisional patent application procedure on June 8, 1995. The basic requirement for filing a provisional patent application is a cover sheet identifying the application as a provisional application, and a current basic filing fee of $220 ($110 for small entity). There is no formal requirement for a provisional application except that: it may be filed in a language other than English; it does not need to include any particular section; it does not require formal drawings; and it does not require any claims. In fact, the USPTO does not conduct any substantive examination of the provisional application. Rather, the provisional application establishes an official U.S. filing date. It will not mature into a patent by itself, but must be converted into a nonprovisional patent application within a year after the original filing date.

Thus, although provisional application has no formal requirements, the applicant still needs to include all the essential technical details in the provisional application. Otherwise, the provisional application would not be effective in securing priority. Thus, it is important not to "jump the gun" by

第三次修正后的专利申请策略：美国临时专利申请

作者：高焕勇

根据现行法律，如果中国单位或个人想将一项在中国完成的发明向外国申请专利，其必须首先在中国提出申请。《中国专利法》第三次修正（“《第三次修正》”）取消了上述“首先在中国提出申请”的要求。因此，自《第三次修正》生效日2009年10月1日起，“任何单位或个人可将其在中国完成的发明创造向外国提出专利申请。”

上述法律修改使中国公司在取得专利保护时有了更多的灵活性。尤其是，该等修改使中国公司能利用其他国家有利的专利申请业务。本文将讨论美国专利申请的一项独特程序，即“临时专利申请”，以及中国公司如何利用此项程序获得更好的专利保护。

由于现行中国专利法要求首先在中国提出申请，因此，中国申请人通常首先在中国提出申请，然后在最初申请日后一年内在美国或其他国家提出申请。在美国或其他国家申请专利时，要求对相关申请文件进行翻译。

人们普遍接受的另一种做法是首先提交《专利合作条约》（PCT）专利申请（可以以中文或英文提交），并将中国国家知识产权局列为PCT专利申请受理局。此后，申请人需在最初申请日后30个月内在各个国家申请专利（进入国家阶段）。

根据《第三次修正》，自2009年10月1日起，中国申请人将有更多的灵活性，其可在任何国家首次提出专利申请（但此前须通过国家保密审核）。在许多新的可选方案中，首先在美国提交临时专利申请的方案尤其具有吸引力。这是一个简便、有效且低成本的确定优先权的方式，并且能使专利申请过程及其相关费用的缴纳最多延期一年之久。同时，如下文所说，临时专利申请能使专利期最多延长一年整。尽管这种方式未必适合所有申请人，但在某些特定情况下，临时专利申请能提供一些特殊的优势。

美国于1995年6月8日建立了临时专利申请程序。提出临时专利申请的基本要求是提交将申请认定为临时专利申请的封页；目前的基本申请费用为220美元（小规模单位只须缴纳110美元）。临时专利申请不需要特定格式：可以用英语以外的其他语言提交申请；不需撰写任何详细的说明；不要求提交正式的制图；且不要求提交任何权力要求书。事实上，美国专利商标局不对临时专利申请进行任何实质审查。但临时专利申请可确立一个法定的美国申请日。临时专利申请不会自动发展成为专利，而必须在最初申请日后一年以内转换为非临时专利申请。

为确立有效的优先权日，临时专利申请必须符合《美国法典》第35章第112条的规定，包括提交书面说明、使用发明的方法和程序（使其

filing a provisional application before the invention is ready for patenting.

Since the provisional application does not have formal requirements, the costs for filing a provisional U.S. application can be much less than filing for a nonprovisional application. In particular, the provisional U.S. application can be filed in Chinese, so translation costs can be deferred as well. See 37 CFR 1.52(d)(1) ("If a provisional application is filed in a language other than English, an English language translation of the non-English language provisional application will not be required in the provisional application."). "An English-language translation of the prior-filed provisional application and a statement that the translation is accurate" is required when filing a nonprovisional application claiming the benefit of such provisional application. 37 CFR § 1.78(a)(5)(iv).

The filing of the provisional patent application does not start the 20-year patent term. Rather, the patent term starts only when the provisional application is converted into a nonprovisional application. Thus, a provisional patent application effectively extends the patent term for up to a whole year. This is particularly useful for pharmaceutical inventions where the life of the technology is long. If a provisional application is filed primarily for the purpose of lengthening the patent term, it should be prepared as if it is a nonprovisional application to avoid any challenge of the priority date on disclosure grounds.

A provisional U.S. application establishes an international priority date with minimum cost. This priority date is recognized around the globe, and the applicant may claim the benefit of this priority date when filing in the United States, in other countries, or under the PCT.

A provisional U.S. application offers applicants more flexibility in seeking patent protection. It gives applicants up to one whole year to determine whether or not to invest the money and time to seek a nonprovisional patent. This is useful when a company has a lot of technologies on which it may seek patent protection, but has not decided which ones are valuable. This could be important where the life of the technology is very short and it is hard to predict the direction of the technology, such as the telecommunication industry.

Provisional U.S. applications are particularly useful when a company makes incremental improvements in a particular field over time. For example, the company may make an improvement every two months, and it would be burdensome and costly to file nonprovisional application every two months. One common practice in this kind situation is to file a provisional application whenever an improvement is made, and to combine several provisional applications into a nonprovisional patent within one year after the filing date of the first provisional application.

The provisional application procedure has becoming increasingly popular in the United States. Currently, 1/3 of all patent applications filed in the United States are provisional applications. It is an easy, effective and low-cost way to establish priority, and offers a very flexible path to obtain patent protection, but it is only suitable in certain circumstances. Chinese companies can take advantage of this unique procedure after the Third Amendment takes effect on October 1, 2009, but should carefully weight its potentials against its limitations. ■

他人能依此方法和程序使用该等发明）以及实施发明的最佳模式。因此，尽管临时申请没有格式上的要求，申请人仍需要在临时专利申请中将所有基本技术细节包括在内。否则，临时专利申请将不会有效地确立优先权。因此，在发明准备就绪可申请专利之前不要“提前起跑”提交临时专利申请。

由于临时专利申请不需要特定格式，美国的临时专利申请费用远比非临时专利申请的费用低。尤其是，美国的临时专利申请可以用中文提交，因此也可以延缓支付翻译费。参见《美国联邦法规》第37卷第 1.52条(d)项(1)款（“如果临时专利申请以英文以外的语言提交，则在临时专利申请中无需提供非英文临时专利申请的英文译本。”）。“在提出非临时专利申请并要求获得该临时专利申请之利益时，须提供“之前提交的临时专利申请之英文译本及该译本与原文完全相符的声明。”《美国联邦法规》第37卷第 1.78条(a)项(5)(iv)款。

提交美国临时专利申请有几个优点。首先，其延长专利期至一年之久。提出临时专利申请不会开始20年的专利期。更确切的说，专利期仅在临时专利申请转为非临时专利申请时才开始计算。因此，临时专利申请有效地将专利期延长了一年整。这对技术生命周期较长的医药发明尤其有用。 如果提出临时申请主要是为了延长专利期，则提出临时专利申请，就应向提出非临时专利申请一样做准备，从而避免以披露为由对优先权日提出的任何质疑。

其次，美国的临时专利申请以很少成本确立国际优先权日。全球均认可这一优先权日，而且在美国、其他国家或者根据PCT提交申请时，申请人可要求获得与优先权日相关的利益。

再之，美国的临时专利申请为申请人寻求专利保护提供了更多的灵活性。临时专利申请为申请人提供一整年的时间决定是否投入金钱和时间去获得非临时专利权。当公司有大量技术可供寻求专利保护，但不肯定哪一项是有价值时，临时专利申请就很有用。当技术生命周期非常短，而且很难预计技术方向时，例如电信业，临时专利申请就比较重要。

当公司在某个特定领域不断地做出改进时，美国的临时专利申请就尤为有用。例如，公司可能每两个月就做出一次改进，而每两个月提交一次非临时专利申请既繁琐又耗资。在这种情况下，一个很好的做法就是每做出一项改进便提交一次临时专利申请，然后在提交首次临时专利申请的申请日一年内将几项临时专利申请合并成一项非临时专利申请。

临时专利申请程序在美国越来越受欢迎。目前，临时专利申请约占在美国提交的专利总申请量的三分之一。临时专利申请是一个建立优先权的简便、高效、低成本的方式，为获得专利保护提供了十分灵活的途径，但是它仅适用于某些情况。当《第三次修正》于2009年10月1日生效时，中国公司可受惠于此项独特程序，但应认真权衡其优点和局限性。■

Chint v. Schneider $23 Million Aberration or the Future of Chinese Patent Litigation?

By Michael Vella

On April 15, 2009, in a moment of rare drama in the world of patent litigation, the Zhejiang High People's Court halted the appellate hearing in the case of *Chint Group v. Schneider Electric* just ten minutes after the hearing began. The Court had just received a notice that the parties had reached a mediated agreement, which was even then on its way to the Court. Under the settlement, Schneider, a French company and global leader in the low voltage electronics industry, agreed to pay Chint, a Chinese electronics company, the sum of RMB 157 million (approximately US $23 million) as part of a global resolution of their disputes. The settlement leaves many wondering whether *Chint v. Schneider* represents a watershed moment of change in Chinese patent litigation or is merely a $23 million aberration.

Schneider and Chint had been litigating in various countries since the 1990s when Schneider first sued Chint in Europe. It appears that Chint learned the lessons of high-stakes litigation well. In August 2006, Chint filed a counter-lawsuit in its home forum of Wenzhou, asserting patent infringement against Schneider's 75%-owned joint venture, Schneider Electric Low-Voltage (Tianjin) Co. and its authorized distributor, Leqing Branch of Star Electric Equipment Co. Ltd. Chint asserted that 5 of Schneider's products infringed a utility model patent for a "miniature circuit breaker" issued by the State Intellectual Property Office (SIPO) in 1999.

In response, Schneider filed an invalidity proceeding with the Patent Reexamination Board (PRB) of SIPO, claiming that the miniature circuit breaker claimed in Chint's patent had previously been disclosed in China and abroad. In April 2007, the PRB rejected Schneider's petition and affirmed the validity of the patent. Although Schneider filed an action in September 2007 requesting that the Beijing No. 1 Intermediate People's Court overturn the PRB's decision, that was filed too late to make a difference.

In September 2007, the Wenzhou Intermediate People's Court had ruled that Schneider infringed the utility patent and ordered the company to pay Chint RMB 334.8 million (approximately US $45 million) as compensation for Chint's lost profits. The damages judgment is believed to be the highest ever in a Chinese patent case. Schneider appealed the case to the Zhejiang High People's Court, where it remained until the parties settled at the April 15 hearing.

In one respect, *Chint v. Schneider* is unquestionably a sign of things to come in China. Chinese companies are increasingly aware of the strategic value of China as forum to assert their IP rights, especially in response to litigation brought by their foreign competitors in the courts of other countries. In *Chint v. Schneider*, Chint filed its case in China after it had learned the painful lessons of patent litigation brought by Schneider in other foreign jurisdictions. Other Chinese companies involved in foreign patent litigation are bound to take

“正泰诉施耐德案”两千三百万美元的反常现象还是中国专利诉讼的未来?

作者：魏迈克

2009年4月15日，专利诉讼领域发生了戏剧性的一幕：浙江高级人民法院在开始审理后仅10分钟，便中止了对“正泰集团诉施耐德电气公司案”的上诉审理。原因是法院刚刚收到通知，表示当事人已达成调解协议，而且调解协议正在送往法院的路上。根据和解书，作为双方全球性争议解决的一部分，在全球低压电器行业占据领导地位的法国公司施耐德同意向中国电器公司正泰支付1.57亿元人民币（约合2,300万美元）。这次和解留下了许多悬念，人们都在猜测“正泰诉施耐德案”究竟表示中国专利诉讼领域将发生分水岭式的变革，抑或该案只是一个价值两千三百万美元的反常现象。

自20世纪90年代施耐德在欧洲首次起诉正泰以来，双方在各国便诉讼不断。正泰似乎充分吸取了高案值诉讼的经验教训。2006年8月，正泰向其所在地温州的法院提出了反诉，诉称由施耐德持有75%股权的合营企业施耐德电气低压（天津）有限公司及其授权经销商斯达电气设备有限公司乐清分公司存在专利侵权行为。正泰诉称，施耐德的5个型号的产品侵犯了国家知识产权局于1999年授予正泰的“小型断路器”实用新型专利。

在应诉过程中，施耐德向国家知识产权局专利复审委员会提出了专利无效申请，宣称正泰专利适用的微型断路器以前已在中国和国外披露过。2007年4月，专利复审委员会驳回了施耐德的申请，认定专利有效。尽管施耐德于2007年9月提起诉讼，要求北京市第一中级人民法院推翻专利复审委员会的裁定，但为时已晚。

2007年9月，温州中级人民法院裁定，施耐德侵犯了上述实用新型专利，责令施耐德向正泰支付3.348亿元人民币（约合4,500万美元）的利润损失赔偿。该次判决的赔偿金据信是中国历次专利案中数额最高的。施耐德将该案上诉至浙江高级人民法院，之后案件便一直停留在该法院，直到双方在4月15日审理时达成和解。

一方面，“正泰诉施耐德案”无疑代表着中国的某种发展趋势。中国公司越来越多地认识到，作为诉讼地，中国对维护其知识产权具有战略价值，特别是针对外国竞争者在其他国家法院提起的诉讼。在“正泰诉施耐德案”中，因为施耐德在外国司法管辖区提起专利诉讼曾给正泰带来了惨痛的教训，正泰这次在中国提起了诉讼。其他涉及外国专利诉讼

notice of Chint's success. Chint's Chairman, Nan Cunhui, made this very point when, according to China Daily, he said that "Chint's success will spur Chinese enterprises to pay closer attention to protecting their intellectual property rights and using recourse to law to protect themselves."

But even without the example of *Chint v. Schneider*, increased IP litigation in China is inevitable. Litigation is a natural byproduct of patent acquisition. Chinese companies have been aggressively acquiring Chinese patents for the last decade and the numbers are increasing each year. When you combine the growing number of Chinese patents with the competitive fire of Chinese companies, patent litigation will assuredly be a staple product of the litigation system in China for the foreseeable future.

The more difficult question is whether the size of the judgment in *Chint v. Schneider* represents an increased willingness by Chinese courts to award substantial damages in patent cases or is simply the aberrational verdict of a local court in favor of a local company. The fact that such high damages were awarded for a utility model patent suggests that the damages may have been excessive. As a general matter, utility model patents are deemed to be less valuable than utility patents, since they are not substantively examined by SIPO and often claim only incremental improvements. Furthermore, given the technical nature of the products in this case, it is hard to understand how infringement of a utility model patent could be the cause of significant lost profits. Viewed in this light, the damages verdict in *Chint v. Schneider* provides questionable precedent for future cases.

The truth as to whether the Chinese patent litigation system is fundamentally changing will be revealed as more Chinese and foreign companies seek substantial damages in patent cases.

On the other hand, the high damages in the *Chint v. Schneider* award could be explained by the fact that the judgment was issued after the PRB had rejected Schneider's invalidity action and in the wake of the State Council's "outline of National Intellectual Property Strategy." Moreover, since that judgment, the People's Supreme Court has published its Comments on Implementing the National Intellectual Property Rights Strategy. Those Comments emphasize the importance of full compensation for patentees and severe sanctions on infringers, particularly in cases of malicious infringement, repeat infringement, and large scale infringement. Viewed in this context, the judgment in *Chint v. Schneider* may not be an aberration, but simply the natural result of China's increasingly sophisticated handling of IP litigation.

The truth as to whether the Chinese patent litigation system is fundamentally changing will be revealed as more Chinese and foreign companies seek substantial damages in patent cases. If not only Chinese but also foreign IP plaintiffs are able to secure full compensation for infringement, *Chint v. Schneider* may indeed mark a turning point in the protection of intellectual property in China. ■

的中国公司必定会注意到正泰的胜利。据《中国日报》报道，正泰董事长南存辉也强调了这一点，他说：“正泰的成功将激励中国企业更注意保护知识产权，并利用法律武器保护自身利益。”

但是，即使没有“正泰诉施耐德案”作榜样，中国的知识产权诉讼也必然会增多。诉讼是取得专利的自然行为。过去十年来，中国公司在申请中国专利方面一直很积极，中国专利数量逐年增加。如果将日益增加的中国专利数量和中国公司的竞争激情结合在一起，在可预见的将来，专利诉讼肯定会成为中国诉讼制度的司空见惯的一个组成部分。

比较难以解答的问题是，对“正泰诉施耐德案”判赔的数额究竟表示中国法院现在倾向于在专利案中判定高额赔偿，抑或只是当地法院在偏袒当地公司的情况下做出的反常裁决？对实用新型专利判定那么高的赔偿显得有些过分。一般来讲，实用新型专利的价值比发明专利低，因为实用新型专利无须国家知识产权局进行实质审查，并且通常仅适用于非突破性的改进。另外，鉴于该案所涉产品的技术特性，很难理解对实用新型专利的侵权会导致重大利润损失。从这方面来看，对“正泰诉施耐德案”的赔偿判决为将来的案例提供了一个值得怀疑的先例。

随着更多中国和外国公司在专利案中寻求高额赔偿，中国专利诉讼制度是否真的发生了根本变化将被最终揭示。

另一方面，因为对“正泰诉施耐德案”的判决是在专利复审委员会驳回施耐德的专利无效申请以及国务院刚刚发布《国家知识产权战略纲要》之后做出的，这或许能够解释对该案判定的赔偿为何那么高。另外，在该项判决做出以后，最高人民法院公布了其《关于贯彻实施国家知识产权战略若干问题的意见》。《意见》强调了全面赔偿专利权人以及严厉制裁侵权人的重要性，特别是对于恶意侵权、重复侵权和规模化侵权案件。根据这种情况，对“正泰诉施耐德案”的判决可能并非反常现象，而是中国在处理知识产权诉讼方面越来越老练的必然结果。

随着更多中国和外国公司在专利案中寻求高额赔偿，中国专利诉讼制度是否真的发生了根本变化将被最终揭示。如果中国知识产权原告和外国原告均能够取得充分的侵权赔偿，则“正泰诉施耐德案”确实会成为中国知识产权保护的转折点。■

Intellectual Property Practice News

AWARDS & ACCOLADES

Morrison & Foerster's IP practice continued to garner recognition in the first quarter of 2009, capturing major honors from **Chambers & Partners**, **Asia Pacific Legal 500**, and **Managing IP**. **Chambers Global**, awarding the firm's IP practice more top rankings than any other firm in the world, bestowed upon our IP practice *Band One* rankings for *Global IP*, *Global IP Life Sciences*, and *USA IP*. One client was quoted by Chambers Global as saying: "*this firm constantly exceeds our every expectation – it is absolutely one of the best firms out there.*" The new **Chambers Asia** survey further honored us with a *Band One* ranking for *Japan IP*. The **Asia Pacific Legal 500** ranked us *Band One* in *Japan for IP International Firms and Joint Ventures*. **Managing IP** honored our *Patent Prosecution*, *ITC Section 337*, and *Trademark* practices with *Tier 2*, *Tier 3*, and *Tier 4* rankings, respectively.

FROM THE DOCKET

Reexamination Victory for Acon Laboratories

In the latest success story for Morrison & Foerster's Patent Litigation and Reexamination practice, we successfully terminated a patent lawsuit brought against our client Acon Laboratories, Inc., after we achieved a favorable ruling for Acon in a three-year patent reexamination proceeding.

Acon is a leading provider of high-quality rapid diagnostic test products. The company has its U.S. operations in San Diego, but also operates a large manufacturing facility in Hangzhou, China, which was the first US FDA-licensed manufacturer of rapid diagnostic products in China.

In 2005, Acon was sued by Zyon International, Inc., for alleged infringement of two U.S. patents, both directed to assaying devices for in-field urine analysis. Acon retained Morrison & Foerster to defend the patent infringement action in court, and to initiate in the U.S. Patent Office a reexamination proceeding to invalidate Zyon's patents. The court stayed the infringement action in early 2006 pending the patent reexamination proceeding, finding that the reexamination "will simplify the issues in [the] litigation."

During the reexamination, the patent examiners rejected the claims of Zyon's patents based primarily on obviousness as set forth in the 2007 Supreme Court decision in *KSR v. Teleflex*. Zyon appealed the examiner's final rejection, but the Board of Patent Appeals and Interferences affirmed the examiner" final rejection in February 2009. Zyon can still appeal the Board's decision to the Federal Circuit.

As a result of the PTO's ruling, the pending litigation was terminated at an early stage, saving our client the time and expense associated with patent litigation. These decisions show that reexamination, even ex parte reexamination, can be a powerful tool to invalidate patents at a much lower cost than litigation. This strategy could be of particular interest to the many Chinese companies who have IP issues in the United States. Morrison & Foerster Partner **Peng Chen** led the preparation of the request for reexamination. Dr. Chen, who was born in China, is a leading U.S. patent attorney who represents Chinese life sciences companies on their U.S. patent issues. Dr. Chen was selected by his peers for inclusion in the 2009

知识产权业务新闻

奖励和赞誉

美富的知识产权业务在2009年第一季度继续获得认可，获得《Chambers & Partners》、《亚洲法律500强》以及《管理知识产权》等杂志的主要嘉奖。《钱伯斯环球指南》授予美富知识产权业务全球知识产权、全球知识产权生命科学领域以及美国知识产权业务一级排名的荣誉；美富知识产权业务从《钱伯斯环球指南》获得的顶级排名超出其它任何律师事务所。《钱伯斯环球指南》引用客户的评价："该律师事务所总是超出我们的期望 – 它毫无疑问是知识产权业务最佳律所之一。"另外，在《钱伯斯亚洲指南》新近举行的调查中，美富的日本知识产权业务荣获一级排名。《亚太法律500强》将美富评为日本一级知识产权国际律师事务所和合营企业。美富的专利申请、国际贸易委员会337条款和商标业务分别荣获《管理知识产权》的2级、3级和4级排名。

诉讼记录摘要

为艾康公司（*Acon Laboratories*）赢得了复审胜诉

在最近美富专利诉讼和专利复审业务的胜诉中，我们就一项延续三年之久的专利复审程序为客户艾康公司获得了有利裁决，成功地终止了向该公司提起的一项专利诉讼。

艾康是一家快速诊断检测产品的主要供应商。公司在美国圣地亚哥，但公司在中国杭州经营着一家大型制造工厂，这是中国第一家获得美国食品药品管理局许可的快速诊断产品制造商。

2005年，Zyon国际公司（"Zyon"）起诉艾康，称艾康侵犯了其两项涉及体内尿分析化验仪器的美国专利。艾康聘请美富担任其法律顾问，为其在法庭上就该专利侵权诉讼进行抗辩，并向美国专利局提起复审程序申请，以证明Zyon的专利无效。2006年初，法院在专利复审程序开始之前中止了侵权诉讼，并判定专利复审"将简化诉讼中的问题"。

在复审过程中，专利审查员驳回了Zyon的专利的权利要求，主要基于显而易见性（见2007年美国最高法院就"KSR诉Teleflex案"所做判决）。Zyon遂就审查员的最终驳回裁定提起上诉，但专利上诉和争议委员会于2009年2月作出了维持审查员的最终驳回裁定的裁决。不过Zyon仍可就委员会的裁定向联邦巡回上诉法院提起上诉。

美国专利商标局的裁决使上述诉讼在初期便终结，为客户节省了时间及专利诉讼支出。上述裁决表明，复审（甚至单方复审）是使专利

edition of *The Best Lawyers in America* in the specialties of Biotechnology Law and Intellectual Property Law.

Evapco Wins Summary Judgment

In a victory for our client Evapco, Inc., on January 8th, a district court judge granted summary judgment for Evapco and dismissed patent infringement claims made by Clearwater in *Clearwater Systems Corp. v. Evapco, Inc.* The ruling in the District Court of Connecticut follows the issuance of a favorable *Markman* order for Evapco and hearings last fall at which arguments were heard on two patent infringement claims as well as a claim for breach of contract.

Clearwater Systems and Evapco are both manufacturers of non-chemical water treatment devices. Clearwater first filed suit in 2005, alleging theft of trade secrets and other business law torts. Clearwater also alleged that Evapco infringed two Clearwater patents, one claiming a device for non-chemical water treatment and the other claiming a method for non-chemical water treatment.

The winning MoFo team was led by partner **Alexander Hadjis**, associates **Matt Vlissides**, **Yan Wang**, and **Paul Kletzly**, and legal analyst **Vivian Lei**. ■

无效的有效手段，且所需成本远远低于诉讼费用。对于许多在美国存在知识产权问题的中国公司而言，此项策略尤其具有吸引力。美富的专利复审申请准备工作主要由合伙人陈朋负责。陈博士出生于中国，是一名顶级美国专利律师，为很多中国生命科学公司处理美国专利事务。经同行评选，陈博士入选2009年版《美国最佳律师》生物技术法和知识产权法最佳律师。

益美高（*Evapco*）赢得简易判决

我们于1月8日为客户益美高获得胜诉，地区法院做出了有利于益美高的简易判决，并撤销了由Clearwater在“Clearwater系统有限公司诉益美高公司案”中提出的专利侵权索赔。继发布有利于益美高的马克曼命令以及于去年秋天就两项专利侵权索赔及一项违约索赔进行的审理后，康涅狄格地区法院作出了上述判决。

Clearwater系统公司和益美高均为非化学水处理设施制造商。2005年，Clearwater首次提起诉讼，诉由为盗窃商业秘密和其他商法侵权。另外，Clearwater诉称益美高还侵犯了其两项专利，其中一项的权利要求有关非化学水处理设施，另一项的权利要求有关非化学水处理方法。赢得胜诉的美富团队的负责人包括合伙人**Alexander Hadjis**、律师**Matt Vlissides**、王焱、**Paul Kletzly**以及法律分析员**Vivian Lei**。■

This newsletter addresses recent intellectual property updates. Because of its generality, the information provided herein may not be applicable in all situations and should not be acted upon without specific legal advice based on particular situations. If you wish to change an address, add a subscriber, or comment on this newsletter, please email Michael Zwerin at mzwerin@mofo.com for the U.S. and Priscilla Chen at priscillachen@mofo.com for China.