

Supreme People's Court Patent Infringement Enforcement Guidance: The "Draft" Published for Comments by the Patent Community*

Yan Zhao, Alex Y. Nie & Yang Tang**

Supreme People's Court Justice HE Zhonglin of the People's Republic of China introduced the *draft of Several Provisions of the Supreme People's Court on Issues Concerning Applicable Laws to the Trial of Patent Infringement Controversies* (the "*Judicial Interpretations*"). The *Judicial Interpretations* keyed to parallel the implementation of the recent Third Amendment to the Patent Law. Justice He announced that the Court would welcome comments concerning the draft guidance, including comments from interested observers from the United States and other overseas countries.

Speaking at a seminar *Cutting Edge Intellectual Property Issues between US & China* held on June 19, 2009, at the State Intellectual Property Office Training Center in Beijing, Justice He shared the stage with several other Chinese experts as well as former Under Secretary of Commerce Jon W. Dudas and several of his partners from Foley & Lardner LLP.

The *Judicial Interpretations* is a particularly important document as it comes from the Supreme People's Court and, when finalized, will represent a powerful interpretative tool for Chinese patent law and practice. Justice He emphasized that his Court will welcome suggestions concerning the draft version which addresses a number of complex issues in patent infringement cases such as claim construction, standards for determining patent infringement and calculation of damages.

Scope of Protection

The first twelve of twenty-five sections of the *Judicial Interpretations* concern determination of scope of patent protection:

(i) Level of Skill in the Art

Specifically, the *Judicial Interpretations* sets forth that the scope of protection is determined by how one of ordinary skill in the art would construct the claims in light of the specification and drawings (Section 2).

(ii) Equivalents

The scope of claim protection shall also include technologies that use substantially the same means to implement substantially the same functions and to achieve substantially the same goals and that can be perceived by one of ordinary skill in the art without creative work at the time of infringement (Section 4).

(iii) Design Patent Infringement

For design patents, identicalness or similarity of designs shall be determined in accordance with the knowledge and cognition of relevant public, which relevant public is defined as a person who has general knowledge of the concerned patented design, who has certain capacity of distinguishing shapes, patterns, or colors of different designs, and who does not usually notice trivial variances in the shapes, patterns or colors (Section 11).

(iv) Narrow Interpretation for “Means” Claims

The *Judicial Interpretations* also provides for narrow interpretation of means plus function claims, similar to the US (35 USC §112, ¶ 6).

However, during prosecution, it is the current practice that most Patent Examiners read the means-plus-function claims broadly to cover all possible mechanisms that perform the same function. Such examination practice is likely to change in light of the *Judicial Interpretations*.

(v) All Elements Rule

The *Judicial Interpretations* also explicitly requires that all technical features or their equivalents shall be present in the accused infringing product for a finding of patent infringement (Section 8). This is to essentially abandon the widely criticized “superfluity establishing principle” which was adopted by the Beijing High People’s Court in an earlier decision. In that decision, the court considered a feature of an independent claim apparently “non-essential” and removed it from consideration when determining infringement.

(vi) Prosecution History Estoppel (Narrowing Amendments)

The *Judicial Interpretations* indicates that, if during prosecution or invalidity proceedings, a patent applicant or patent holder abandoned or narrowed the scope of certain claims, the scope of protection shall exclude such abandoned subject matter (Section 7).

Prior Art Defense

The Third Amendment to the Patent Law codifies the doctrine of prior art defense, under which the People's Court may find no infringement if the defendant has evidence to prove that his technology or design is covered by or performed in accordance with prior art or prior art design. The *Judicial Interpretations* requires the reliance upon one piece of prior art (or design) in such a defense, but also allow certain changes from the cited prior art. For example, with respect to invention or utility model patents, the features of the accused infringing product can be “equivalents” to those of the prior art; with respect to design patent, the design of the accused infringing product can be “similar” to that of the prior art.

Cease and Desist Letters

The *Judicial Interpretations* sets forth that the accused infringer is entitled to file a declaratory judgment, if the patentee, within one month after receipt of written notice from the accused infringer who has received a cease and desist letter therefrom, urging the patentee to take legal actions, fails to withdraw this letter or to bring a lawsuit. Such an additional procedural requirement may give the patentee significant advantages over the accused infringer in terms of forum shopping.

Comments to the Court

The deadline for Comments is July 10, 2009, which may either be mailed or transmitted via email to:

Intellectual Property Tribunal
The Supreme People's Court of China
No. 27 Dong Jiao Min Xiang
Dongcheng District
Beijing, P.R.C

<http://www.chinacourt.org/wsdc/> .

Endnotes

* This paper benefits from the views expressed in the Question and Answer period of the seminar *Cutting Edge Intellectual Property Issues between US & China* held on June 19, 2009, at the State Intellectual Property Office Training Center in Beijing, particularly the comments by Supreme People's Court Justice HE Zhonglin of the People's Republic of China .

** The authors are members of Foley & Lardner LLP. Mr. Zhao is an Attorney in the Shanghai office admitted in China and the State of New York [Peking University (LL.B.); George Washington University Law School (LL.M.)]; Dr. Nie practices in the Silicon Valley office [Rutgers School of Law- Newark (J.D.); Rutgers – New Brunswick (Ph.D. biochemistry; M.S. computer science); University of Science and Technology of China (M.S.); Wuhan University (B.S.)]; Ms. Tang is a Patent Agent in the San Diego/Del Mar Office [Case Western Reserve University (M.S. Biochemistry) and Xiamen University (B.S. Biochemistry)].

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