



American Intellectual Property Law Association

June 14, 2020

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Via email zxzhengqiuyijian@163.com

**Re: Regulations of the Supreme People's Court on Issues in Hearing
Administrative Cases of Granting & Determination of Patent Rights**
《最高人民法院关于审理专利授权确权行政案件若干问题的规定（征求意见稿）》

Dear Sir or Madam,

The American Intellectual Property Law Association (AIPLA) appreciates the opportunity to comment on the Draft Regulations of the Supreme People's Court (SPC) on Issues in Hearing Administrative Cases of Granting & Determination of Patent Rights published on April 28, 2020 for public comments (the "Draft Regulations"). Our comments are presented in the enclosed comment table and are also summarized below for your consideration. We invite you to contact us without hesitation if there are any questions.

AIPLA is a national bar association of approximately 12,000 members engaged in private or corporate practice, in government service, and in the academic community. AIPLA members represent a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, trade secret, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property. Our mission includes helping establish and maintain fair and effective laws and policies that stimulate and reward invention while balancing the public's interest in healthy competition, reasonable costs, and basic fairness.

Turning now to the Draft Regulations, AIPLA commends the SPC's efforts in revising the previous draft regulations based on collected comments, and is glad to see several suggestions from AIPLA have been adopted. AIPLA welcomes another opportunity to comment on the revised regulations. Below is a summary of our comments. Due to time constraints, AIPLA

focuses its comments on a few specific articles in the Draft Regulations. The absence of comments on other articles does not necessarily reflect AIPLA's support of these articles or lack thereof.

Article 2

Article 2 of the Draft Regulations provides that a People's Court can examine facts and rule on issues not raised by the plaintiff when it deems that the relevant identification and decision of the patent administrative department of the State Council are inappropriate. However, Article 2 allows the court to make the decision only after the parties have "made statements." AIPLA is concerned about the fairness of the proceeding in which a People's Court is given the discretion to raise issues and grounds that are not presented by the plaintiff. This may be problematic if the parties are only allowed to "make statements," but not given opportunities to present evidence and rebut the other side's arguments. In addition, the parties' decisions to not raise an issue or rely on a particular ground may be mutually agreed upon and should be given deference by an appeals court.

Article 3

Article 3 governs what evidence can be relied on by a People's Court when construing a claim. Article 3 provides that the court may rely on intrinsic evidence, extrinsic evidence, and file history during claim construction. AIPLA commends the claim construction guidelines provided in this Article. However, AIPLA is concerned that the Article does not clearly state the different priorities a court should give to these three types of evidence. Patents serve an important public notice function to competitors. Reliance on extrinsic evidence that was not available and formed no part of the intrinsic record may undermine the public's ability to predict what the claims mean. When the different types of evidence listed in Article 3 are inconsistent or in conflict, clear guidance from the SPC on how to resolve the conflict is needed to ensure uniformity among court decisions. Specifically, AIPLA recommends that extrinsic evidence should not be relied on if it conflicts with the intrinsic record based on the specification and file history.

AIPLA is also concerned that Article 3 is silent on when a People's Court should rely on the claim construction adopted by the patent administrative department of the State Council and when the court should construe the claim de novo. Clearer guidance from the SPC would improve uniformity and consistency among cases decided by different courts and different judges.

Article 6

AIPLA respectfully suggests that Article 6 be revised to recite that the evaluation should be based on the original disclosure, instead of just the description, which includes the description, claims, and drawings, so as to be consistent with the definition of "original disclosure" given in the Patent Examination Guidelines and consistent with the international norm.

AIPLA's comment on Article 6 is also applicable to Articles 7-10.

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Article 12

Article 12 provides that if a party challenges the truthfulness of the experimental data submitted in the application, the People's Court may entrust an institution or a third party to test or verify the experimental data. AIPLA is concerned that appropriate measures are in place to protect the confidentiality of proprietary information. Particularly if confidential or proprietary information is needed or helpful in conducting these evaluations, the third party should be required to preserve the confidential or proprietary rights in this additional information. The evaluation should be only for purpose of verifying the data and the information and data should not be used by or shared with others. AIPLA is also concerned about the qualifications used by the court in selecting an institution to test or verify experimental data when the parties cannot agree on the third party. AIPLA recommends that the SPC set forth reasonable limitations how the third-party evaluators may use any confidential or proprietary information provided by a party that is not publicly available and specify standards on how to select a qualified institution to test experimental data.

Article 15

Article 15 requires that a People's Court determine the technical problem or problems solved by the claims based on common knowledge, the technical features in the claims, and the technical solutions defined in the claims. AIPLA suggests that when formulating the technical problem that the claims actually solve, the court rely specifically on the original disclosure, in addition to common knowledge and claims, and consider the applicant/patentee's own description of the technical problem. This echoes our comments on Article 6 of these Draft Regulations, which recommend giving weight to the technical problem disclosed in the original disclosure.

We appreciate the opportunity to provide comments and would be happy to answer any questions that our comments may raise.

Sincerely,



Barbara A. Fiocco

President

American Intellectual Property Law Association