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State Intellectual Property Office  
Legislative Affairs Department  
People's Republic of China  
E-Mail: [tiaofasi@sipo.gov.cn](mailto:tiaofasi@sipo.gov.cn)  
Fax: +86 10 6208 6550

中华人民共和国国家知识产权局条法司  
电子邮件: [tiaofasi@sipo.gov.cn](mailto:tiaofasi@sipo.gov.cn)  
传真: +86 10 6208 6550

**Subject: Comments on Draft Amendments to the PRC Patent Law**

**主题: 对中国专利法修改草案的意见**

The American Intellectual Property Law Association ("AIPLA"), located in Arlington, Virginia, close by the United States Patent and Trademark Office ("USPTO"), is the largest association of intellectual property ("IP") practitioners in the United States. We have approximately 14,000 members from law firms, government agencies, the judiciary, and academia, including many foreign members from China and other countries.

美国知识产权法协会（AIPLA），位于弗吉尼亚州阿灵顿，相距美国专利和商标局（USPTO）不远，是美国规模最大的知识产权从业者协会，拥有会员大约14,000多名，会员来自律师事务所、政府机构、司法机构和研究所，其中许多会员为来自中国及其他国家的外国成员。

AIPLA commends the State Intellectual Property Office ("SIPO") for its tremendous efforts and significant progress on patent issues in China over the years. SIPO's efforts have contributed to the promulgation of the third amended Patent Law of the People's Republic of China ("PRC Patent Law," effective as of October 1, 2009), the revised Implementing Regulations of the PRC Patent Law (effective as of February 1, 2010), and the revised Guidelines for Patent Examination (effective as of February 1, 2010), just to name a few achievements. We also commend SIPO on providing the domestic and foreign public with the opportunity to comment on the recently-released draft fourth amendments to the PRC Patent Law ("Draft Amendments"), which, although much more limited than the third amendments, are of great significance to stakeholders in the Chinese patent system, including most if not all of AIPLA's members.

对于国家知识产权局（“贵局”）多年来在中国专利事务方面的重大投入及取得的巨大建树，AIPLA十分赞赏。《中华人民共和国专利法》第三次修订版（“中国专利法”，自2009年10月1日生效）、《中华人民共和国专利法实施条例》修订版（自2010年2月1日生效）、《专利审查指南》（自2010年2月1日生效）等法规颁布，实为国家知识产权局之功。我们也十分赞赏贵局给予国内外公众就最近发布的中国专利法第四次修订草案（“修订草案”）发表意见的机会。虽然相较第三次修订更为有限，但对中国专利体制的相关利益方（包括AIPLA大部分会员，即使并非全部会员）来说，此次修订依然意义重大。

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AIPLA appreciates the opportunity to provide the attached comments on the Draft Amendments for SIPO's consideration, and we hope this is just the start of a transparent and productive exchange of views on improving the PRC Patent Law to the benefit of all legitimate patent rights holders, domestic and foreign alike.

AIPLA 很高兴有机会提交其对修订草案的意见（随附）供贵局审议。为国内外所有合法专利权持有人利益，希望这只是我们透明、建设性地交换有关中国专利法改进意见的一个开端。

If SIPO has any questions, requires further information, or wants to discuss AIPLA's comments or other patent issues, please let us know.

贵局如有任何疑问，需要进一步信息或与AIPLA讨论我们的意见或其他专利事务，敬请告知我们。

Sincerely,



William G. Barber  
President  
American Intellectual Property Law Association

Attachment: AIPLA'S COMMENTS ON DRAFT AMENDMENTS TO PRC PATENT LAW

附件：AIPLA对中国专利法修订草案的意见

# AIPLA 对专利法修改草案（征求意见稿）的意见

## AIPLA'S COMMENTS TO DRAFT AMENDMENTS TO PRC PATENT LAW

<p>专利法修改征求意见稿 Proposed Amendments to Patent Law (粗体部分系修改征求意见稿) (boldface portions represent proposed amendments)</p>	<p>AIPLA 对专利法修改征求意见稿的意见 AIPLA Comments to Proposed Amendments</p>
<p><b>第四十六条</b> <b>Article 46</b></p> <p>专利复审委员会对宣告专利权无效的请求应当及时审查和作出决定，并通知请求人和专利权人。</p> <p>The Patent Reexamination Board shall examine the request for invalidation of the patent right promptly, make a decision on it and notify the person who made the request and the patentee.</p> <p>宣告专利权无效或者维持专利权的决定作出后，国务院专利行政部门应当及时予以登记和公告。该决定自公告之日起生效。</p> <p><b>After the decision declaring a patent right invalid or affirming the patent right is made, the patent administration department under the State Council shall promptly register and announce the decision. The decision shall become effective as of the</b></p>	<p>AIPLA 同意修改征求意见稿中关于要求国家知识产权局对专利复审委员会的专利无效或者有效决定“及时予以登记和公告”的规定。AIPLA 恳请国家知识产权局考虑如下：(1) 明确规定应在<u>专利登记簿</u>中登记相关决定并予以公告；以及(2) 加入决定必须予以登记和公告的具体时间，例如“在十(10)个工作日内”。专利的状态及其任何变更，应尽快告知公众。</p> <p>AIPLA agrees with the proposed amendment insofar as it requires SIPO to "promptly register and announce" decisions of the Patent Reexamination Board ("PRB") declaring a patent valid or invalid. AIPLA respectfully suggests that SIPO consider (1) expressly requiring decisions to be registered and announced <u>in the record of the patent</u> and (2) including a specific period of time within which the decision must be registered and announced, for example, "within ten (10) working days." The status of a patent, and any changes thereto, should be made available to the public as soon as practicable.</p>

<p style="text-align: center;"><b>专利法修改征求意见稿</b> <b>Proposed Amendments to Patent Law</b> (粗体部分系修改征求意见稿) <b>(boldface portions represent proposed amendments)</b></p>	<p style="text-align: center;"><b>AIPLA 对专利法修改征求意见稿的意见</b> <b>AIPLA Comments to Proposed Amendments</b></p>
<p><b>announcement date.</b></p> <p>对专利复审委员会宣告专利权无效或者维持专利权的决定不服的，可以自收到通知之日起三个月内向人民法院起诉。人民法院应当通知无效宣告请求程序的对方当事人作为第三人参加诉讼。</p> <p>Where the patentee or the person who made the request for invalidation is not satisfied with the decision of the Patent Reexamination Board declaring the patent right invalid or upholding the patent right, such party may, within three months from receipt of the notification of the decision, institute legal proceedings in the people's court. The people's court shall notify the person that is the opponent party of that party in the invalidation procedure to appear as a third party in the legal proceedings.</p>	<p>同样，由于当事人可就专利复审委员会的决定在人民法院对专利复审委员会提起行政诉讼，国家知识产权局应考虑要求该等上诉及时地或在特定的时间内在专利登记簿中予以登记和公告。</p> <p>Similarly, since the decision of the PRB may be appealed to the People's Court in an administrative lawsuit against the PRB, SIPO should consider requiring such appeals to be registered and announced in the record of the patent promptly or within a specified time period.</p> <p>原则上，AIPLA 对修改征求意见稿有关专利复审委员会决定“自公告之日起生效”并无异议。但是，AIPLA 恳请国家知识产权局考虑明确规定如下：在专利复审委员会作出宣告专利权有效决定情况下，如果被控侵权人上诉至人民法院，则在法院作出维持专利权的最终决定之前，被控侵权人没有义务支付损害赔偿金。这一点尤为重要，因为中国专利法第四十七条规定，宣告无效的专利权视为自始即不存在，且该决定“对在宣告专利权无效前人民法院作出并已执行的专利侵权的判决……不具有追溯力”。在宣告专利权无效的决定不具有追溯力情况下，要求被控侵权人就其侵犯一项最终裁定为无效的专利而支付损害赔偿金，实为不当。</p> <p>AIPLA has no issue in principle with the proposed amendment making PRB decisions "effective as of the announcement date." However, AIPLA respectfully requests that SIPO consider expressly</p>

<p style="text-align: center;"> <b>专利法修改征求意见稿</b>  <b>Proposed Amendments to Patent Law</b>                      (粗体部分系修改征求意见稿)  <b>(boldface portions represent proposed amendments)</b> </p>	<p style="text-align: center;"> <b>AIPLA 对专利法修改征求意见稿的意见</b>  <b>AIPLA Comments to Proposed Amendments</b> </p>
	<p>providing that where the PRB has decided a patent is valid and the accused infringer has appealed that decision to the People's Court, the infringer will not be liable to pay damages until there is a <u>final</u> decision upholding the validity of the patent. This is especially important because Article 47 of the PRC Patent Law provides that, although a patent that is declared invalid is deemed to be non-existent from the beginning, the decision "shall have no retroactive effect on any judgment ... with respect to patent infringements which has been delivered and enforced by a People's Court ..." It would not be proper to require an accused infringer to pay damages for infringement of a patent that is later finally determined to be invalid, where the invalidity decision has no retroactive effect.</p>
<p><b>第四十七条</b> <b>Article 47</b></p> <p>宣告无效的专利权视为自始即不存在。</p> <p>Any patent right which has been declared invalid shall be deemed to be non-existent from the beginning.</p> <p>宣告专利权无效的决定，对在宣告专利权无效前人民法院作出并已执行的专利侵权的判决、调解书，已经履行或者强制执行的专利侵权纠纷处理、<b>处罚</b>决定，以及已经履行的专利实施许可合同和专利权转让合同，不具有</p>	<p>修改征求意见稿在宣告专利权无效的决定不具有追溯力的项目清单上增加了“处罚决定”一项。“处罚决定”一词涵盖何种类型的决定，须予以澄清。例如，“处罚决定”是否仅限于地方知识产权局所厘定的罚款，或者还包括损害赔偿金等其他项目？</p> <p>The proposed amendment adding "penalty decisions" to the list of items on which invalidity decisions have no retroactive effect requires clarification as to what types of decisions this term is meant to cover. For example, are "penalty decisions" limited to fines assessed by local IP offices or do they include other items such as damages?</p>

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<p>追溯力。但是因专利权人的恶意给他人造成的损失，应当给予赔偿。</p> <p>The decision declaring the patent right invalid shall have no retroactive effect on any judgment of or mediation document on patent infringement which has been pronounced and enforced by the people's court, on any decision concerning the handling of a dispute over patent infringement or any <b>penalty decision</b> which has been complied with or compulsorily executed, or on any contract of patent license or of assignment of patent right which has been performed prior to the declaration of the patent right invalid; however, the damage caused to other persons in bad faith on the part of the patentee shall be compensated.</p> <p>依照前款规定不返还专利侵权赔偿金、专利使用费、专利权转让费，明显违反公平原则的，应当全部或者部分返还。</p> <p>If, pursuant to the provisions of the preceding paragraph, no repayment to the fee for compensation for the patent infringement, to the fee for the exploitation of the patent or to the price for the assignment of the patent right is made, which is obviously contrary to the principle of equity, the whole or part of the fee shall be repaid.</p>	<p>AIPLA 另外恳请国家知识产权局考虑明确规定如下：在“处罚决定”要求被控侵权人支付罚款而被控侵权人已在专利复审委员会提出宣告专利无效请求的情况下，在作出维持专利权的最终决定之前，被控侵权人没有义务支付罚款。和损害赔偿金一样，在宣告专利权无效的决定不具有追溯力情况下，要求被控侵权人就其侵犯一项最终裁定为无效的专利而支付罚款，实为不当。</p> <p>AIPLA also respectfully requests SIPO to consider expressly providing that where there is a "penalty decision" requiring the accused infringer to pay a fine and the infringer has started an invalidation action at the PRB, the infringer will not be liable to pay the fine until there is a <u>final</u> decision upholding the validity of the patent. Similar to damages, It would not be proper to require an accused infringer to pay a fine for infringement of a patent that is later finally determined to be invalid, where the invalidity decision has no retroactive effect.</p> <p>第四十七条规定，因专利权人的“恶意”给他人造成的损失应当给予赔偿，对此 AIPLA 表示赞同，但认为，为所有人的最佳利益，“恶意”一词须予以界定，或至少予以澄清。AIPLA 提议，最低限度上，“恶意”一词应当明确包括专利权人在知道专利权为无效的情况下提起主张的情况。这将有助于遏制持有无效专利的专利权人随意提起诉讼和请求行政处理。</p>

<p>专利法修改征求意见稿 Proposed Amendments to Patent Law (粗体部分系修改征求意见稿) (boldface portions represent proposed amendments)</p>	<p>AIPLA 对专利法修改征求意见稿的意见 AIPLA Comments to Proposed Amendments</p>
	<p>AIPLA recognizes that Article 47 requires a patentee to compensate others for any damage caused by its "bad faith," but believes that it would be in everyone's best interest to have the meaning of "bad faith" defined or at least clarified. AIPLA suggests that at a minimum, it should be made clear that "bad faith" includes the assertion of a patent that the patentee knows is not valid. This will help deter patentees who hold invalid patents from bringing frivolous lawsuits and administrative actions.</p> <p>AIPLA 另外还建议在修改征求意见稿中加入以下内容：(1) “恶意” 的确立标准；以及 (2) 从专利权人处取得赔偿的程序。在本法当前规定下，如果宣告专利权无效的最终决定在侵权诉讼结案后作出，实际操作中如何处理这一问题并不明确。</p> <p>AIPLA also suggests incorporating into the amendments (1) a standard for establishing "bad faith" and (2) a procedure for obtaining compensation from the patentee. It is not clear how this would work in practice under the current law if a final invalidity decision comes after an infringement action has ended.</p> <p>第四十七条规定，如果不返还专利侵权赔偿金、专利使用费、专利权转让费，“明显违反公平原则的”，应当全部或者部分返还，AIPLA 对此表示赞同，但认为“明显”一词应予以删除，且“违反公平原则”一词也需加以界定或至少予以澄清。何种情形属于“违反公平原则”的情况？</p>

<p>专利法修改征求意见稿 Proposed Amendments to Patent Law (粗体部分系修改征求意见稿) (boldface portions represent proposed amendments)</p>	<p>AIPLA 对专利法修改征求意见稿的意见 AIPLA Comments to Proposed Amendments</p>
	<p>AIPLA recognizes that Article 47 allows for the return of damages and other payments made if not returning such payments "is obviously contrary to the principle of equity," but believes that the term "obviously" should be deleted and the term "contrary to the principle of equity" needs to be defined or at least clarified. What would qualify as "contrary to the principle of equity"?</p> <p>AIPLA 另外还建议在修改征求意见稿中加入以下内容：(1) 确立不归还宣告专利权无效的决定作出前所支付的费用“违反公平原则”的标准；以及(2) 取得归还该等费用的程序。在本法当前规定下，如果专利权无效最终决定在侵权诉讼结案后作出，实际操作中如何处理这一问题并不明确。</p> <p>AIPLA also suggests incorporating into the amendments (1) a standard for establishing that not returning payments made before the invalidity decision is "contrary to the principle of equity" and (2) a procedure for obtaining the return of such payments. It is not clear how this would work in practice under the current law if a final invalidity decision comes after an infringement action has ended.</p>
<p>第六十条 Article 60</p>	<p>修改征求意见稿 (1) 在认定侵犯专利权行为成立的情况下，允许管理专利工作的部门责令给予专利权人损害赔偿金；(2) 对涉嫌“扰乱市场秩序”的侵权专利权行为，给予管理专利工作的部门调查权的权力。对于修改征求意见稿的意图，AIPLA 表示赞赏，并尤其赞同强化专利</p>



<p style="text-align: center;"><b>专利法修改征求意见稿</b> <b>Proposed Amendments to Patent Law</b> (粗体部分系修改征求意见稿) <b>(boldface portions represent proposed amendments)</b></p>	<p style="text-align: center;"><b>AIPLA 对专利法修改征求意见稿的意见</b> <b>AIPLA Comments to Proposed Amendments</b></p>
<p>未经专利权人许可，实施其专利，即侵犯其专利权，引起纠纷的，由当事人协商解决；不愿协商或者协商不成的，专利权人或者利害关系人可以向人民法院起诉，也可以请求管理专利工作的部门处理。</p> <p>Where a dispute arises as a result of the exploitation of a patent without the authorization of the patentee, that is, the infringement of the patent right of the patentee, it shall be settled through consultation by the parties. Where the parties are not willing to consult with each other or where the consultation fails, the patentee or any interested party may institute legal proceedings in the people's court, or request the administrative authority for patent affairs to handle the matter.</p> <p>管理专利工作的部门处理时，认定侵权行为成立的，可以责令侵权人立即停止侵权行为、<b>赔偿损失</b>；当事人不服的，可以自收到处理通知之日起十五日内依照《中华人民共和国行政诉讼法》向人民法院起诉；侵权人期满不起诉又不停止侵权行为的，管理专利工作的部门可以申请人民法院强制执行。</p> <p>When the administrative authority for patent affairs handling the matter considers that the infringement is established, it may order the infringer to stop the infringing act immediately and <b>compensate for losses</b> suffered. If any interested party is not satisfied with the order, he may, within 15 days from the date of receipt of the notification of the order, institute legal proceedings in the people's court in accordance with the Administrative Procedure Law of the People's Republic of China. If,</p>	<p>执法遏制侵犯专利权行为的规定，但 AIPLA 认为这些规定应确保无人滥用相关体制。在此方面，AIPLA 对修改征求意见稿以下几个方面尚存有疑虑。</p> <p>The proposed amendments would allow administrative patent authorities to award damages to a patentee upon a finding of infringement and would give the administrative patent authorities the power to investigate cases of patent infringement "disrupting the market order." While AIPLA appreciates the intent behind the proposed amendments, and strongly favors provisions that would strengthen patent enforcement and deter infringement, AIPLA believes that this should be done in a way that avoids abuse of the system. In this spirit, there are several aspects of the currently proposed amendments that are of concern to AIPLA.</p> <p>AIPLA 主要的疑虑在于在未确保管理专利工作的部门拥有相关专业知识和资源以强化知识产权体制前，便向其授予责令侵权人赔偿损失之权力。这一权力早已授予了人民法院，AIPLA 担心，损害赔偿金裁定权的“双重管辖权”可能导致：(i) 随意请求行政诉讼处理的增加（例如由有效性存疑的实用新型或外观设计专利权人所提起的）；(ii) 随着地方专利局试图处理大量的专利案件，而其中大量案件涉及损害赔偿金计算这一难题，行政开支亦随之增加；(iii) 不同地方专利局之间、地方专利局和人民法院之间决定不一致，将导致商业混乱和法律上的不确定性；以及 (iv) 随着愈来愈多的行政决定（包括关于损害赔偿金</p>

<p style="text-align: center;">专利法修改征求意见稿 <b>Proposed Amendments to Patent Law</b> (粗体部分系修改征求意见稿) <b>(boldface portions represent proposed amendments)</b></p>	<p style="text-align: center;"><b>AIPLA 对专利法修改征求意见稿的意见</b> <b>AIPLA Comments to Proposed Amendments</b></p>
<p>within the said time limit, such proceedings are not instituted and the order is not complied with, the administrative authority for patent affairs may approach the people's court for compulsory execution.</p> <p>对涉嫌扰乱市场秩序的专利侵权行为，管理专利工作的部门有权依法查处；在全国有重大影响的，由国务院专利行政部门组织查处。管理专利工作的部门认定侵权行为成立且扰乱市场秩序的，责令停止侵权行为，没收违法所得，并可没收、销毁侵权产品或者用于实施侵权行为的专用设备，并处违法所得四倍以下的罚款，没有违法所得或者违法所得难以计算的，可以处二十万元以下的罚款。</p> <p><b>The administrative authority for patent affairs shall have the right to investigate and handle the alleged patent infringer disrupting the market order in accordance with the law; the patent administration department under the State Council shall organize the investigation of suspected patent infringement activity which has significant impact on the country. If the administrative authority for patent affairs finds that the infringement is established and disrupts the market order, it shall order the infringing party to stop the infringement activity, confiscate the illegal earning, and may seize and destroy the infringing products or special equipment used for infringement, it may also impose a fine of not more than four times of the illegal earning, or may impose a fine of no more than RMB 200,000 if there is no illegal earning or if the illegal earning is difficult to be calculated.</b></p>	<p>的) 上诉至人民法院，司法机构的工作量和开支亦随之增加。</p> <p>AIPLA's primary concern relates to granting the administrative patent authorities the power to award damages, without assuring that those authorities will have both the expertise and resources to carry out this mandate in a way that would strengthen the IP system. The power to award damages is already granted to the People's Courts, and AIPLA is concerned that providing such "dual jurisdiction" to award damages may result in (i) an increase in frivolous administrative actions (for example, by holders of utility model or design patents of questionable validity); (ii) an increase in administrative expenses as local patent offices try to cope with the flood of patent cases, many of which will include the difficult task of calculating damages; (iii) inconsistent decisions among the various local patent offices and between the local patent offices and the People's Courts, which will cause business confusion and legal uncertainty; and (iv) an increase in judicial workload and expenses as more administrative decisions, including for damages, are appealed to the People's Court.</p> <p>AIPLA 另外还担心地方专利局尚不具有计算专利损害赔偿金的法律及技术知识。</p> <p>AIPLA is also concerned that local patent offices may not yet have the legal nor technical knowledge to calculate patent damages.</p>

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<p>宣告专利权无效或者维持专利权的决定生效后，管理专利工作的部门和人民法院应当根据该决定及时审理、处理专利侵权纠纷。</p> <p><b>After the decision of declaring the concerned patent right invalid or affirming the patent right becomes effective, the administrative authority for patent affairs or the people's court shall, based on the decision, timely hear and resolve the patent infringement dispute.</b></p>	<p>因此，AIPLA 恳请国家知识产权局仔细研究向管理专利工作的部门授予责令侵权人赔偿损失之权的影响，并重新审议这项修改。</p> <p>AIPLA, therefore, respectfully requests that SIPO carefully study the implications of granting administrative patent authorities the power to award damages and reconsider this proposed amendment.</p> <p>对于修改征求意见稿允许地方专利局查处“扰乱市场秩序的”专利侵权行为，或要求对“在全国有重大影响的”专利侵权行为进行查处，并对之处以“违法所得四倍以下的罚款，没有违法所得或者违法所得难以计算的，可以处二十万元以下的罚款”，AIPLA 亦存有疑虑。根据美国和欧洲的相关经验，将“四倍以下的罚款”这一救济措施评定标准用于所有案件中似乎并不妥当，在某些情况下，这可能会导致极不公平的评定结果。我们十分赞同向相关当事人给予较有意义的救济措施之意图，但我们认为这些救济措施必须有原则上的依据，且不应允许对合法商业机构不公平地适用体制。</p> <p>AIPLA is also concerned with the proposed amendment allowing local patent offices to investigate patent infringement that "disrupts the market order" or "has significant impact on the country" and impose fines of "not more than four times of the illegal earning" or "no more than RMB 200,000 if there is no illegal earning or if the illegal earning is difficult to be calculated." United States and European experience seem to indicate that the calculation of "four times the illegal earning" is not an appropriate model for assessing remedies in all cases, and</p>

<p style="text-align: center;"> <b>专利法修改征求意见稿</b>  <b>Proposed Amendments to Patent Law</b>                      (粗体部分系修改征求意见稿)  <b>(boldface portions represent proposed amendments)</b> </p>	<p style="text-align: center;"> <b>AIPLA 对专利法修改征求意见稿的意见</b>  <b>AIPLA Comments to Proposed Amendments</b> </p>
	<p>in some cases could result in highly unfair assessments. While we applaud the intention to provide more meaningful remedies, we believe that they should be doctrinally well-founded, and should not permit an unfair application of the system against legitimate businesses.</p> <p>另外，何种类型的专利侵权行为属“扰乱市场秩序的”或“在全国有重大影响的”侵权行为尚不清楚，可以说一宗简单专利侵权案件就可能符合这一规定，使侵权人被处以高额罚款。这一不明确的规定，不应留待地方部门来解释或受之影响，尤其是在可能处以高额罚款的情况下。因此，AIPLA 提议，这一项修改应全部删除，或至少应对措辞加以澄清，并确定指引以确定何种类型的活动（并佐以例举）属于这一范畴。对于罚款，AIPLA 建议对“违法所得”一词作出界定或澄清，并应确立“违法所得”计算指引。AIPLA 另外还建议确立“违法所得四倍以下的罚款”及“二十万元以下的罚款”的计算指引。哪些因素将确定处以违法所得一倍还是四倍的罚款呢？哪些因素将确定处以十万元还是二十万元的罚款呢？</p> <p>In addition, it is not clear what type of infringing activity would qualify as "disrupting the market order" or "having a significant impact on the country," and arguably a simple patent infringement could qualify and subject the infringer to a significant fine. This ambiguity should not be left to local interpretation and influence, especially given the potentially large fines. AIPLA, therefore, suggests that this amendment be omitted in its entirety or at least that the terms be</p>

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	<p>clarified and guidelines be established that specifically identify the types of activity (with examples) that would fall within their scope. Regarding the fines, AIPLA suggests that the term "illegal earning" be defined or clarified and that guidelines for calculating "illegal earning" be established. AIPLA also suggests that guidelines for calculating "a fine of not more than four times of the illegal earning" and "a fine of not more than RMB 200,000" be established. What factors will determine whether a fine is one time or four times the illegal earning? What factors will determine whether a fine is RMB 100,000 or RMB 200,000?</p>
<p><b>第六十一条</b> <b>Article 61</b></p> <p>专利侵权纠纷涉及新产品制造方法的发明专利的，制造同样产品的单位或者个人应当提供其产品制造方法不同于专利方法的证明。</p> <p>Where any infringement dispute relates to a patent for invention for a process for the manufacture of a new product, any entity or individual manufacturing the identical product shall furnish proof to show that the process used in the manufacture of its or his product is different from the patented process.</p> <p>专利侵权纠纷涉及实用新型专利或者外观设计专利的，人民法院或者管理</p>	<p>AIPLA 强烈支持修改征求意见稿明确规定，人民法院应经原告人要求从侵权人处收集侵权行为相关证据。在许多情况下，专利侵权行为证据及计算损害赔偿金所需的证据均掌握在侵权人手中或为侵权人所控制。修改征求意见稿对取得该等证据的机制作出了规定。然而，AIPLA 建议，如作如下修订，则该项修改将更为全面、有效：</p> <p>AIPLA strongly supports the proposed amendment expressly requiring the People's Courts, at the plaintiff's request, to collect evidence regarding infringement from the infringer. In many cases, evidence of infringement and evidence necessary to calculate damages are in the possession or under the control of the infringer. The proposed amendment provides a mechanism for obtaining such evidence. AIPLA, however, respectfully suggests that the</p>

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<p>专利工作的部门可以要求专利权人或者利害关系人出具由国务院专利行政部门对相关实用新型或者外观设计进行检索、分析和评价后作出的专利权评价报告，作为审理、处理专利侵权纠纷的证据。</p> <p>Where the dispute of patent infringement relates to a patent for utility model or design, the people's court or the administrative authority for patent affairs may ask the patentee or interested party to furnish an appraisal report of the patent right made by the patent administration department under the State Council after conducting search, analysis and appraisal of the relevant utility model or design as evidence for trial and handling of the patent infringement disputes.</p> <p>专利侵权诉讼中，对于由被控侵权人掌握的涉嫌侵权的产品以及账簿、资料等证据，人民法院应当根据原告或者其诉讼代理人的申请依法调查搜集。被控侵权人不提供或者转移、伪造、毁灭证据的，人民法院依法采取制止妨害民事诉讼的强制措施；构成犯罪的，依法追究刑事责任。</p> <p><b>In the litigation of patent infringement, the people's court shall, at the request of the plaintiff or the agent of the plaintiff, investigate and collect the evidence including the alleged infringement products, the accounting books, materials etc. which are under the control of the accused infringer. Where the alleged infringer refuses to provide the evidence or move, forge or destroy the evidence, the people's court shall take, according to the law, compulsory measures against the obstruction of the civil actions;</b></p>	<p>amendment can be made more comprehensive and effective if it:</p> <p>(1) 包括为专利权人及侵权人所占有或控制的证据；</p> <p>Includes evidence in the possession or under the control of the patentee as well as the infringer;</p> <p>(2) 规定当事各方所出示信息的保密机制，无论该等信息系自愿出示还是人民法院收集得来的；</p> <p>Provides a mechanism for maintaining the confidentiality of information produced by the parties, whether voluntarily or through evidence collection by the People's Courts;</p> <p>(3) 明确人民法院应收集与下列事项相关的证据：(i) 专利，例如发明的构思及付诸实施和发明的在先技术；(ii) 涉嫌侵权产品，例如产品描述文件及资料，或证明产品设计及开发的文件及资料；以及(iii) 损害赔偿金，例如发票、生产及销售记录、合同及许可；以及</p> <p>Specifies that the People's Courts shall collect evidence that <u>relates to</u> (i) the patent, such as the conception and reduction to practice of the invention and prior art to the invention; (ii) the alleged infringing products, such as documents and materials describing the products or that show the design and development of the products; and (iii) damages, such as invoices, manufacturing and sales records, contracts, and</p>

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<p>where a crime is committed, the criminal liabilities shall be prosecuted according to law.</p>	<p>licenses; and</p> <p>(4) 在当事一方无合理理由或理由拒绝出示所规定证据情况下，允许人民法院作出负面的推论。</p> <p>Allows the People's Courts to impose a negative inference when a party refuses to produce requested evidence without good cause or reason.</p>
<p><b>第六十三条</b> <b>Article 63</b></p> <p>假冒专利的，除依法承担民事责任外，由管理专利工作的部门责令改正并予以公告，没收违法所得，可以并处违法所得四倍以下的罚款；<b>没有违法所得或者违法所得难以计算的</b>，可以处二十万元以下的罚款；构成犯罪的，依法追究刑事责任。</p> <p>Where any person passes off the patent, he shall, in addition to bearing his civil liability according to law, be ordered by the administrative authority for patent affairs to amend his act, and the order shall be announced. His illegal earnings shall be confiscated and, in addition, he may be imposed a fine of not more than four times his illegal earnings and, <b>if there are no illegal earnings or if the illegal earnings are difficult to be calculated</b>, he may be imposed a fine of not more than RMB</p>	<p>AILPA 认为，所有损害赔偿金、罚款及其他金钱性质的处罚的计算均应明确、透明。因此，正如我们在第六十条的意见中所述，AIPLA 建议对“违法所得”一词作出界定或澄清，并确立“违法所得”的计算指引。AILPA 另外还建议确立“违法所得四倍以下的罚款”及“二十万元以下的罚款”的计算指引。</p> <p>AIPLA believes that the calculation of all damages, fines, and other monetary penalties should be clear and transparent. Thus, as also mentioned above for Article 60, AIPLA suggests that the term "illegal earnings" be defined or clarified and that guidelines for calculating "illegal earnings" be established. AIPLA also suggests that guidelines for calculating "a fine of not more than four times his illegal earnings" and "a fine of not more than RMB 200,000 yuan" be established.</p>

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<p>200,000 yuan. Where the infringement constitutes a crime, he shall be prosecuted for his criminal liability.</p>	
<p><b>第六十四条</b> <b>Article 64</b></p> <p>管理专利工作的部门根据已经取得的证据，对涉嫌<b>侵犯专利权行为和假冒专利行为</b>进行查处时，可以询问有关当事人，调查与涉嫌违法行为有关的情况；对当事人涉嫌违法行为的场所实施现场检查；查阅、复制与涉嫌违法行为有关的合同、发票、账簿以及其他有关资料；检查与涉嫌违法行为有关的产品，对有证据证明是<b>侵权产品或者假冒专利的产品</b>，可以查封或者扣押。</p> <p>In handling the act suspected of <b>infringing patent right or passing off of the patent</b>, administrative authority for patent affairs may, based on the evidence collected, make inquiries of the relevant persons, investigate into the matters pertinent to the act suspected of violation of laws; conduct on-spot inspection of the place where the act of the relevant persons is suspected of violation of laws; examine and make copy of the contract, invoices, accounting books and other materials relating to the act suspected of violation of laws; inspect the product relating to the act suspected of violation of laws, and may seal and detain the products as proved by evidence to be</p>	<p>AIPLA 支持将侵犯专利权行为加入修改征求意见稿，但前提是应对管理专利工作的部门行使第六十四条所赋予的广泛权力予以程序保障措施。尤其是，<b>AIPLA</b> 建议对管理专利工作的部门可以“查封或者扣押”“有证据证明是侵权产品的产品”的情况加以澄清，和 / 或确立相关指引。扣押公司的产品自然会对其业务产生严重负面影响，因此未经适当保障措施不应扣押产品，例如，除非专利权人提供保证金和 / 或专利最终被裁定为有效（假定侵权人向专利复审委员会提出专利无效申请），否则不应扣押产品。</p> <p>AIPLA supports the inclusion of the act of patent infringement in the proposed amendment, subject to procedural safeguards on the administrative patent authorities' exercise of the broad powers granted to them under Article 64. In particular, AIPLA suggests that the circumstances under which the administrative patent authorities may "seal and detain the products as proved to be infringing products" be clarified and/or that guidelines for doing so be established. Detaining a company's products will naturally have a serious negative impact on its business, and thus should not be done without appropriate safeguards, for example, unless the patentee posts a bond and/or until the patent is finally determined to be valid (assuming the infringer has filed a request for invalidation with the</p>



<p style="text-align: center;"><b>专利法修改征求意见稿</b> <b>Proposed Amendments to Patent Law</b> (粗体部分系修改征求意见稿) <b>(boldface portions represent proposed amendments)</b></p>	<p style="text-align: center;"><b>AIPLA 对专利法修改征求意见稿的意见</b> <b>AIPLA Comments to Proposed Amendments</b></p>
<p><b>infringing products or counterfeits.</b></p> <p>管理专利工作的部门依法行使前款规定的职权时，当事人应当予以协助、配合，不得拒绝、阻挠。<b>被调查的当事人拒绝、阻挠管理专利工作的部门行使职权的，由管理专利工作的部门予以警告；情节严重的，依法给予治安管理处罚。</b></p> <p>The relevant persons shall help and cooperate with the administrative authority for patent affairs exercising the authorities as provided in the preceding paragraph and must not make any rejection or obstacles. <b>In case the relevant persons refuse or obstruct the administrative authority for patent affairs from exercising the authorities, the administrative authority for patent affairs shall give a warning; if the circumstances are serious, the administrative penalties for public security shall be imposed.</b></p>	<p>PRB).</p>
<p><b>第六十五条</b> <b>Article 65</b></p> <p>侵犯专利权的赔偿数额按照权利人因被侵权所受到的实际损失确定；实际损失难以确定的，可以按照侵权人因侵权所获得的利益确定。权利人的损失或者侵权人获得的利益难以确定的，参照该专利许可使用费的倍数合理确定。赔偿数额还应当包括权利人为制止侵权行为所支付的合理开支。</p>	<p>专利权人能否从侵权人处取得具有实际意义的损害赔偿金，这是国内外公司一直以来共同关心的问题。即使判得损害赔偿金，获判的数额通常无法完全弥补专利权人的损失，或无法遏制侵权行为。因此，<b>AIPLA 支持修改征求意见稿允许<u>人民法院</u>对“故意”侵犯专利权行为裁定惩罚性损害赔偿金。</b>然而，正如我们在第六十条的意见中所述，<b>AIPLA 对在管理专利工作的部门没有所需的专业知识的情况下向其授予裁定损害赔偿金之权力感到不安，对于惩罚性损害赔偿金，AIPLA</b></p>

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<p>The amount of compensation for the damage caused by the infringement of the patent right shall be assessed on the basis of the actual losses suffered by the patentee; where the actual losses are difficult to be determined, it may be assessed on the basis of the profits which the infringer has earned through the infringement. If it is difficult to determine the losses which the patentee has suffered or the profits which the infringer has earned, the amount may be assessed by reference to the appropriate multiple of the amount of the exploitation fee of that patent under contractual license. The amount of compensation shall include the reasonable expenses incurred to the patentee for handling the infringement.</p> <p>权利人的损失、侵权人获得的利益和专利许可使用费均难以确定的，<b>管理专利工作的部门或者</b>人民法院可以根据专利权的类型、侵权行为的性质和情节等因素，确定给予一万元以上一百万元以下的赔偿。</p> <p>In case it is difficult to calculate the losses of the patentee, the profits which the infringer has earned, and the amount of the exploitation fee of that patent under contractual license, <b>the administrative authority for patent affairs</b> or the people's court may, on the basis of such factors as the type of the patent, nature and circumstances of the infringement etc., determine the amount of the compensation from RMB 10,000 yuan to RMB one million yuan.</p> <p>对于故意侵犯专利权的行为，<b>管理专利工作的部门或者</b>人民法院可以根据</p>	<p>同样也感到疑虑：管理专利工作的部门是否具有法律及技术方面的能力或资源来计算该等损害赔偿金。因此，AIPLA 恳请国家知识产权局重新审议授予<b>管理专利工作的部门</b>裁定损害赔偿金之权力。</p> <p>The ability of patentees to recover meaningful damages from infringers has been an ongoing concern for both domestic and foreign companies alike. Even when damages are awarded, the amount generally does not fully compensate patentees for their loss or act as a deterrent to infringement. Thus, AIPLA supports the amendment allowing for the imposition of punitive damages for "willful" infringement <u>by the People's Courts</u>. Nevertheless, as discussed above with respect to Article 60, AIPLA is concerned with granting administrative patent authorities the power to award damages without the necessary expertise, and has the same concerns with respect to punitive damages, including whether the administrative patent authorities have the legal and technical ability to calculate such damages or sufficient resources to do so. AIPLA, therefore, respectfully asks SIPO to reconsider the amendment granting <u>administrative patent authorities</u> the power to award damages.</p> <p>AIPLA 另外还建议，“故意”侵犯专利权的行为应予以界定或至少予以澄清。公众和人民法院均应有某种指引来了解：何种行为属于“故意”侵犯专利权并使当事方被处以损害赔偿金数额最高三倍的严重处罚之行为。</p>

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<p>侵权行为的情节、规模、损害结果等因素，将根据前两款所确定的赔偿数额最高提高至三倍。</p> <p><b>For the willful act of patent infringement, the administrative authority for patent affairs or the people’s court may increase the damages up to three times of the amount that is decided according to the first two paragraphs, based on the circumstances, the scale of the infringement and damages caused by the infringement.</b></p>	<p>AIPLA also suggests that "willful" infringement be defined or at least clarified. Both the public and the People's Courts should have some guidance as to what types of behavior qualify as "willful" infringement and subject a party to the severe penalty of up to three times the amount of damages.</p> <p>AIPLA 另外还建议，修改征求意见稿应加入以下内容：(1) 确定“故意”侵犯专利权的行为的标准；以及(2) 厘定惩罚性损害赔偿金的程序。当前修改征求意见稿仅规定，对于“故意侵犯专利权的行为”，“根据侵权行为的情节、规模、损害结果等因素”，损害赔偿金数额最高提高至三倍。如对专利权人如何证明“故意”侵犯专利权的行为提供指引，并澄清惩罚性损害赔偿金计算中所考虑的因素，则将大有裨益。</p> <p>AIPLA also suggests incorporating into the amendments (1) a standard for establishing "willful" infringement and (2) a procedure for assessing punitive damages. The current proposal merely states that for "willful acts of patent infringement," damages may be increased up to three times the amount "based on the circumstances, the scale of the infringement and damages caused by the infringement." It would be useful to have guidelines on what a patentee needs to show to establish "willful" infringement and clarification on what factors should be considered when calculating punitive damages.</p> <p>为进行有效的专利执法，所裁定的损害赔偿金的金额，应既能赔偿专</p>

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	<p>利权人，又能遏制侵权人。虽然第六十五条允许专利权人根据专利权人的损失、侵权人获得的利益和适当的专利许可使用费挽回损害，但是专利权人要取得证明该等损害的必要信息异常困难，而人民法院通常不愿意或者无法通过证据保全程序取得该等信息。通常导致的结果是，裁定的法定损害赔偿金，既无法全面赔偿专利权人，也无法有效地遏制侵权人。因此，AIPLA 建议在修改征求意见稿中明确规定如下：经专利权人提出要求，人民法院应取得侵权人的账簿及其他有助于计算损害赔偿金的财务信息（类似于上文第六十一条修改所包含的内容。）</p> <p>In order to have <u>effective patent enforcement</u>, damages should be awarded in amounts that serve both to compensate the patentee and to deter the infringer. Although Article 65 allows patentees to recover damages based on the patentee's losses, the infringer's profits, or an appropriate licensing fee, it is extremely difficult for patentees to obtain the information necessary to prove such damages, and the People's Courts are often unwilling or unable to obtain such information through evidence preservation procedures. This often results in an award of statutory damages that fails to either fully compensate the patentee or effectively deter the infringer. Therefore, AIPLA suggests incorporating into the amendments express provisions requiring the People's Courts, upon the patentee's request, to obtain an infringer's accounting books and other financial information that would help calculate damages (similar to what is included in the proposed amendments to Article 61 above).</p>

