

## In this Issue

2

*In re Bilski*: Will The Supreme Court Change The New Rules for Patenting Business Methods Established By The Federal Circuit?

8

Federal Circuit Deals Blow to Qualcomm and Adds to the Law Governing Standard-Setting Organization Participants

12

In the Eye of the Beholder: The Essentiality Analysis and the Patent Misuse Defense

16

Impact Looms Large in Federal Circuit Decision: USPTO and Patent Applicants Still Locked in Showdown Following *Tafas v. Doll*

22

Intellectual Property Practice News

## 目錄

3

*Bilski*案：最高法院是否會修改聯邦巡迴上訴法院為商業方法專利制定的新規則？

9

美國聯邦巡迴上訴法院：高通公司敗訴—標準制定組織成員面臨新增法律

13

仁者見仁，智者見智：必要性分析以及專利權濫用之抗辯

17

美國聯邦巡迴上訴法院的判決影響巨大：*Tafas*對*Doll*案後，美國專利商標局和專利申請人仍處於一決雌雄的僵局狀態

23

智慧產權業務新聞

## Note from the Managing Editor

With this inaugural issue, we introduce our Taiwan Intellectual Property Quarterly Newsletter. In this and future editions, we will share with you trends and important court decisions that impact companies, like yours, that compete in IP-intensive industries. We hope that you find our newsletter helpful as you guide your own company's legal and business strategies.

As a global law firm with an unparalleled presence in Asia and technology clients throughout the world, Morrison & Foerster is particularly well-positioned to provide counsel and information to Taiwanese companies.

While these are trying times for many industries, we know that the world economy will recover. Technology, as the backbone of the international economy, will lead the way. We hope that this information will help Taiwanese companies to be well-informed to continue compete in the global economy and benefit when the recovery comes.

In this issue, we discuss three recent Federal Circuit decisions. We address the *Bilski* decision and its affect on software patents. We also discuss a decision from the Broadcom/Qualcomm litigation that defines the scope of remedies available when companies fail to disclose their IP to standard setting organizations. Finally, we address the *Tafas* opinion on the U.S. Patent Office's rulemaking authority.

Further, we are happy to report four recent victories secured by Morrison & Foerster LLP. Two before the U.S. International Trade Commission, on behalf of clients Spansion and Funai, one in the District of Connecticut for our client Evapco, and another major victory in the Eastern District of Texas on behalf of our client Pioneer.

We hope you will find Morrison & Foerster's Taiwan IP Quarterly Newsletter informative. We will continue to monitor the latest developments to keep you updated.

Best wishes,

Alexander J. Hadjis, Morrison & Foerster LLP

## 主編按

我們在此向大家推出《2009年夏季臺灣智慧產權通訊》創刊號。在本期及今後的通訊中，我們將與您分享美國智慧產權法律的發展動態及重要法院判決，這些判決將影響所有在智慧產權密集型行業中競爭的公司（如貴公司）。我們希望本所的《通訊》能協助您指導貴公司的法律及商務戰略決策。

作為一家在亞洲擁有強大經營規模且科技企業客戶遍佈全球的國際性律師事務所，美富毫無疑問具有為臺灣公司提供法律顧問和相關資訊的明顯優勢。

儘管當前許多行業舉步維艱，但我們堅信全球經濟終將復甦。作為國際經濟支柱的科技產業將在這條復甦之路上起主導作用。我們希望本所通訊能為臺灣公司提供實用資訊，使其在復甦到來之時不但能繼續參與全球經濟的競爭，而且可以從競爭中獲利。

在本期通訊中，我們首先討論最近由聯邦巡迴上訴法院頒佈的三項判決。我們將先談*Bilski*案的判決及其對軟體專利的影響。然後我們會論及博通/高通訴訟案的判決。當一公司沒有將其智慧產權即時披露給相關標準制定組織，該判決對公司在其智慧產權遭受侵權時可獲得的救濟的範圍進行了限制。最後，我們將討論法院在*Tafas*一案中關於美國專利局之規章制定權的判決意見書。

除此之外，我們很慶幸彙報美富最近取得的四次勝訴，分別為：代表客戶Spansion和Funai在美國國際貿易委員會取得的兩次勝訴；為客戶Evapco在康涅狄格州地方法院取得的一次勝訴；以及為客戶Pioneer在德克薩斯州東區法院取得的一次重大勝訴。

我們期許美富的《2009年夏季臺灣智慧產權通訊》能為您提供有用資訊。我們將繼續追蹤智慧產權領域的最新發展，並即時為您提供最新動態。

順致商祺！

美富律師事務所合夥人韓明山

## *In re Bilski*: Will The Supreme Court Change The New Rules for Patenting Business Methods Established By The Federal Circuit?

On June 1, the Supreme Court granted *certiorari* to review the Federal Circuit's decision in *In re Bilski*<sup>1</sup>. One of the certified issues was whether "a 'process' must be tied to a particular machine or apparatus, or transform a particular article into a different state or thing ('machine-or-transformation' test), to be eligible for patenting under 35 U.S.C. § 101."<sup>2</sup> Last year, this issue of patentable subject matter was before the Federal Circuit in the context of the so-called "business method patent." In its 132-page *In re Bilski* opinion, the Federal Circuit articulated a "machine-or-transformation" test, arguably putting most business method patents to rest.

### THE BACKDROP OF FEDERAL CIRCUIT DECISION IN *BILSKI*

Many scholars view the patent system as a necessary evil: a limited monopoly is available to create the incentive for innovation. Needless to say, the monopoly has its boundaries. In terms of subject matter eligible for patent protection, it has long been established that natural phenomenon and abstract ideas cannot be patented.

The last time the U.S. Supreme Court touched on this issue was almost 30 years ago in the context of software patents. In a "trilogy" of cases relating

to algorithm and computer software,<sup>3</sup> the Supreme Court made it clear that abstract algorithms cannot be patented by themselves, but the existence of an algorithm in a claim does not automatically render otherwise-patentable subject matter ineligible for patent protection.

In 1998, the Federal Circuit issued a long-awaited decision regarding the patentable-subject-matter issue in the context of business method patents in *State Street Bank v. Signature Financial Group*.<sup>4</sup> According to the *State Street* court, anything that "produces a useful, concrete and tangible result" is eligible subject matter for patent protection.

In the wake of the *State Street* decision, the USPTO saw a flood of business method patent applications, a trend that continued up until last year.<sup>5</sup> All of these patents are more or less related to a method of operating some aspect of an economic enterprise.

The flood was believed to be triggered not by any major innovation, but simply by the new intellectual property market prompted by *State Street*. Against this backdrop, the Federal Circuit issued *In re Bilski* last year. In the opinion, the Federal Circuit

explicitly replaced the "tangible result" test adopted in *State Street* with the "machine-or-transformation" test.<sup>6</sup>

Under the "machine-or-transformation" test, a claimed process is patent-eligible if: "(1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing."<sup>7</sup> Applying the test to the business method patent application at issue in *In re Bilski*, the Federal Circuit affirmed USPTO's rejection.

The *Bilski* decision, however, left a fundamental question unanswered: What machine or what transformation is enough to transform an abstract method into a patentable subject matter? Would the combination of a method with a general computer suffice? If a patent claim is drafted with some additional elements that are indisputably a "machine" but those machine elements do not go to the heart of the innovation or change the scope of the claim in any meaningful way, would those claims survive a patentable subject matter challenge?

Déjà vu? Indeed, the "machine-or-transformation" test was initially established in the Supreme Court trilogy. After the trilogy, many patent

## *Bilski*案：最高法院是否會修改聯邦巡迴上訴法院為商業方法專利制定的新規則？

6月1日，最高法院批准了調卷令申請，將對聯邦巡迴上訴法院關於*Bilski*案所做判決進行復審<sup>1</sup>。被列為將由最高法院解決的問題之一是：一項“工序”（process）若根據《美國法典》第35篇第101條申請專利，是否必須與某特定機器或設備關聯，或可將某特定物品轉變至不同形態或轉變為不同物品<sup>2</sup>。去年，聯邦巡迴上訴法院曾就所謂的“商業方法專利”審理過其專利適格性問題。在長達132頁的*Bilski*案判決意見書中，聯邦巡迴上訴法院明確提出“機器或轉變”的檢驗標準，有可能導致大多數商業方法專利無效。

### 聯邦巡迴上訴法院對*Bilski*案所做判決的背景

許多學者都認為專利制度有其本身無法革除的弊病，但依然期望專利制度所賦於的有限壟斷會促發創新發明。當然，壟斷是有一定範圍的。就有資格獲得專利保護的標的物而言，自然現象和抽象概念不具有專利適格性在美國法律中由來已久。

美國最高法院最近一次就軟體專利涉及上述話題已是30年前的事。在與演算法及電腦軟體相關的“三部曲”案件中<sup>3</sup>，最高法院明確表示，抽象演算法本身不具專利申請資格，但如果運算法則在權利要求中，它並不會導致權利要求中其他具備專利適格性的標的物自動喪失獲得專利保護的資格。

1998年，在*State Street Bank*訴*Signature Financial Group*案<sup>4</sup>中，聯邦巡迴上訴法院就商業方法專利頒佈了一項期待已久的專利適格性判決。根據*State Street*案的法庭意見，任何能“產生有用、具體且有形結果”的方法均具有專利適格性。

在*State Street*案的判決頒佈後，美國專利商標局收到了如潮水般的商業方法專利申請，直至去年這一趨勢方才告一段落<sup>5</sup>。所有這些專利或多或少與金融類企業某些方面的經營方式有關。

人們認為，導致商業方法專利申請大量湧現的原因並不是任何重大創新的出現，而

僅僅是由*State Street*案所激發的智慧產權市場產生的效果。聯邦巡迴上訴法院就在這種形勢下去年頒佈了*Bilski*案的判決。判決意見書中，聯邦巡迴上訴法院明確地以“機器或轉變”檢驗標準取代*State Street*案採納的“有形結果”檢驗標準<sup>6</sup>。

根據“機器或轉變”檢驗標準，所主張的方法如能滿足以下要求，即具有專利適格性：（1）與某特定機器或設備相關聯，或（2）該方法可將某特定物品轉變至不同形態或轉變為不同物品<sup>7</sup>。聯邦巡迴上訴法院然後將該檢驗標準應用於*Bilski*案中的商業方法專利申請，維持了美國專利商標局駁回專利申請的裁定。

不過，*Bilski*案的判決留下了一個尚無答案的基本問題：何種機械或轉變才能足以將某種抽象方法轉變為具有專利適格性的標的物？是否只要將方法與通用電腦相結合就足以證明該方法具有專利適格性？如所起草的專利權利要求包含有一些毋庸置疑屬於“機械”的成份，那麼該等權利要求是否就

prosecutors inserted tangentially relevant physical elements into software claims to avoid the patentable subject matter problem. It is expected that they would do the same thing again after *Bilski* – this time in connection with business method claims. After all, the methods are typically implemented in computers, such as methods for e-commerce, banking, tax compliance, etc. Some of the broader methods do not even rely on computers.

The Federal Circuit and the USPTO, however, are starting to move in a different direction. In less than two months after *Bilski*, the Board of Patent Appeals and Interferences rejected claims in no less than four software patents relying on *Bilski*. In addition, the ramification of *Bilski* does not seem to stop in computer-related patents. The Federal Circuit, relying on its own *Bilski* decision, recently invalidated a medical diagnostic method claim in *Classen Immunotherapies, Inc. v. Biogen IDEC*.<sup>8</sup>

### THE FEDERAL CIRCUIT EN BANC DECISION IN *BILSKI*

Writing for the en banc Court, Chief Judge Michel's opinion focused on the proper standard for determining whether a process is patent-eligible subject matter under § 101.

#### A Process Is Patent-Eligible Subject Matter If It Is Tied to a Particular Machine or Transforms a Particular Article into a Different State or Thing.

The Federal Circuit began by noting that the Supreme Court has narrowed

the term “process” in § 101 by excluding laws of nature, natural phenomena, and abstract ideas from patent-eligibility. These “fundamental principles,” as the Federal Circuit called them, are part of the “storehouse of knowledge” to which no person can claim an exclusive right. As a result, process claims that pre-empt substantially all uses of a fundamental principle are not patent-eligible, but process claims that only foreclose particular applications of these fundamental principles are patent-eligible under § 101.

In perhaps its clearest statement, the Federal Circuit held:

The Supreme Court, however, has enunciated a definitive test to determine whether a process claim is tailored narrowly enough to encompass only a particular application of a fundamental principle rather than to pre-empt the principle itself. A claimed process is surely patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing.

The Court rejected qualifying language in earlier Supreme Court decisions, which Judge Newman relied on in dissent, that would leave the door open for patent-eligibility for some processes that did not meet this test. Instead, the Court, relying on the absence of

such qualifiers in later Supreme Court opinions, held that the “machine-or-transformation test” was the sole test for determining patent-eligibility of a process under § 101, at least until the Supreme Court “decide[s] to alter or perhaps even set aside this test to accommodate emerging technologies.”

In limiting patent-eligibility to processes that satisfy the “machine-or-transformation test,” the Federal Circuit overruled or rejected several other tests. Most importantly, the Federal Circuit held that the “useful, concrete, and tangible result” test adopted by *State Street* did not adequately restrict the patent-eligibility for processes under § 101, even if the test was helpful in indicating whether a claim was drawn to a fundamental principle or practical application of such a principle.

Further, the Court rejected various categorical restrictions on patent-eligibility for processes. The Court refused to adopt the position that would limit patent eligibility to processes representing “technology” or the “technological arts,” concluding that these terms were too ambiguous and ever-changing.

Finally, the Court refused to adopt per se rules advocated by various amici that would exclude software, business methods, and other categories of processes from patent-eligibility.

毫無疑問取得了專利適格性—即使那些機械成份與發明核心無關，也沒有以任何有意義的方式改變權利要求的範圍？

似曾相識？確實，“機械或轉變”檢驗標準最初是由最高法院的三部曲確立的。在三部曲之後，為避免出現軟體專利適格性的問題，許多專利代理人將無關緊要的相關物理成分插入軟體權利要求中。在*Bilski*案後，專家預期專利代理人會繼續這麼做—只不過這次是針對商業方法權利要求。這些商業方法畢竟主要是通過電腦實施的，例如與電子商務、銀行交易、稅務合規等相關的方法。有些涉及範圍較廣的方法甚至無須依賴電腦。

不過，聯邦巡迴上訴法院和美國專利局似乎與專利代理人觀點相反。在*Bilski*案後不到兩個月內，以*Bilski*案為依據，專利局的復審委員會至少駁回了四項軟體專利。此外，*Bilski*案所影響的範圍也似乎超出了電腦類專利。日前，聯邦巡迴上訴法院根據*Bilski*案判決*Classen Immunotherapies, Inc.*訴*Biogen IDEC*一案<sup>8</sup>中的醫療診斷方法權利要求無效。

### 聯邦巡迴上訴法院全院庭審對*Bilski*案的判決

Michel首席法官為全院庭審起草了判決意見書，該意見書主要關注的問題是在確定某

種方法是否具有專利適格性時，應採用何種適當標準。

**如果某種方法是與某特定機器關聯的，或可將某特定物品轉變至不同形態或轉變成不同物體，該方法即系具有專利適格性的標的物。**

聯邦巡迴上訴法院首先指出，最高法院將自然規律、自然現象和抽象概念排除在具有專利適格性的標的物之外，縮小了第101條中“工序”（process）一詞的範疇。聯邦巡迴上訴法院將此稱為“基本原理”，指任何人不得對於自然規律、自然現象和抽象概念主張專有權，它們是公有“知識庫”的一部分。因此，實際會涵蓋某項基本原理全部用途的方法類權利要求不具有專利適格性，但僅涵蓋這些基本原則某些特定應用的方法類權利要求在第101條項下具有法律適格性。

在其做出的或許是最為明確的聲明中，聯邦巡迴上訴法院認為：

為確定方法（工序）類權利要求範圍是否僅限於某基本原理的特定應用，而非涵蓋該項原理本身，最高法院已闡明確切的檢驗標準。在下列情況下，所主張的方法肯定具有第101條項下的專利適格性：(1) 該方法是與某特定機器或設備關聯的，或

(2) 該方法可將某特定物品轉變至其他形態或轉變成其他物體。

聯邦巡迴上訴法院否定了最高法院以往判決中對此標準使用的限制性用語。這些用語可能會使某些不符合該檢驗標準的方法具有專利適格性，而Newman法官正是根據此類用語提出異議的。鑒於最高法院後來做出的判決意見書中沒有任何限定條件，聯邦巡迴上訴法院認為，至少在最高法院“為適應新興技術而決定修改，甚至取消該檢驗標準”之前，“機器或轉變檢驗標準”是確定一項方法是否具有第101條項之專利適格性的唯一檢驗標準。

在將方法專利適格性限於滿足“機器或轉變檢驗標準”的過程中，聯邦巡迴上訴法院駁回或否定了若干其他檢驗標準。最重要的是，聯邦巡迴上訴法院認為，*State Street*案所採用的“有用、具體且有形的結果”之檢驗標準，並未充分限制第101條項下方法專利的適格性，即使該檢驗標準有助於說明某一權利要求涉及的是某項基本原理還是該項原理的實際應用。

此外，聯邦巡迴上訴法院否定了對各種方法專利適格性的各類絕對限制。法院拒絕採納將專利適格性限於代

## The Scope and Application of the Machine-or-Transformation Test Remains Unclear.

The *Bilski* decision clarifies the patent-eligibility of processes under § 101 by adopting a single test and explicitly rejecting a variety of other tests. However, it also raises many questions about how this test should be applied in practice.

The opinion makes clear that a process that is tied to a machine or that transforms an article into a different state or thing is patent-eligible under § 101. However, the Court proceeded to further limit patent-eligibility by noting that “the use of a specific machine or transformation of an article must impose meaningful limits on the claim’s scope” and “must not merely be insignificant extra-solution activity.” The Court failed to explain what it meant by imposing “meaningful limits” or “insignificant extra-solution activity.”

Moreover, because *Bilski* admitted that his claim did not require any specific machine or apparatus, the Court left “to future cases the elaboration of the precise contours of machine implementation,” including “whether or when recitation of a computer suffices to tie a process claim to a particular machine.” This open question is particularly significant, since most “business methods” of any value are computer-implemented.

On the “transformation” prong of the “machine-or-transformation test,” the Court’s discussion still left many open questions. The Court first noted that the “transformation must be central to the purpose of the claimed process,” though it did not explain what it meant to be “central” to the process. The Court also held that processes that transform physical objects or substances, as well as electronic data that represent physical and tangible objects, are patent-eligible. By contrast, the Court held that processes that transform “abstract constructs such as legal obligations, organizational relationships, and business risks” are not patent-eligible. The Court did not address where the line fell between these two categories of transformations.

The Court concluded that *Bilski*’s process only involved “ineligible transformations,” such as the transformation of legal obligations. Because the process did not result in “the transformation of any physical object or substance, or an electronic signal representative of any physical object or substance,” it was not patent-eligible under § 101.

## WILL THE SUPREME COURT CHANGE THE RULES ESTABLISHED BY THE FEDERAL CIRCUIT?

Earlier this year, the Federal Circuit had the chance to apply the newly established *Bilski* test to another

business method patent application. However, *In re Ferguson* led to a split opinion. The majority affirmed that the machine-or-transformation test established by *Bilski* is the only dispositive test in deciding the patentability, while Judge Newman disagreed that test was the only applicable test on this issue. According to Judge Newman, a broadside overturning all relevant precedents, as the majority did, was not warranted. She concurred in the judgment on a different ground.

Let’s hope when the Supreme Court issues its opinion in *Bilski*, it will shed more light on the patentability issue. ■

<sup>1</sup> *In re Bilski*, 545 F.3d 943 (Fed. Cir. 2008).

<sup>2</sup> *Bilski v. Doll*, No. 08-964 (Granted June 1, 2009).

<sup>3</sup> The three cases are *Gottschalk v. Benson*, 409 U.S. 63 (1972), *Parker v. Flook*, 437 U.S. 584 (1978), and *Diamond v. Diehr*, 450 U.S. 175 (1981).

<sup>4</sup> *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368 (Fed. Cir. 1998).

<sup>5</sup> The number of official business method patent in Class 705 at USPTO has been tripled in the last decade while the total number of patent applications remained roughly the same. However, the total number of business method patent applications constitutes merely about 1% of all patent applications.

<sup>6</sup> *Bilski*, 545 F.3d at 954 (citing *Benson*, 409 U.S. at 70, *Diehr*, 450 U.S. at 192, *Flook*, 437 U.S. at 589 n.9, as well as *Cochrane v. Deener*, 94 U.S. 780, 788 (1876)).

<sup>7</sup> *Id.*

<sup>8</sup> *Classen Immunotherapies, Inc. v. Biogen IDEC*, docket no. 2006-1634.

表“技術”或“科技”方法的觀點，斷定這些用詞太過模糊且變幻不定。

最後，法院拒絕採用各法庭顧問主張的單獨定性規則—即禁止軟體、商業方法以及其他門類方法具有專利適格性。

### “機器或轉變檢驗標準”的範圍及其應用仍不明確。

通過採用單一檢驗標準並明確否決其他各種檢驗標準，*Bilski*案的闡明了第101條項下“方法”的專利適格性。不過，對於在實踐中如何應用該檢驗標準，該項判決也引起了許多問題。

法院的判決意見書表明，與某機器關聯或可將某項物品轉變至其他形態或轉變成其他物體的方法，將具有第101條項下的專利適格性。但是，法院指出“對某特定機器的使用或對某項物品的轉變必須對權利要求的範圍施加有意義的限制”，並且“不得僅為無關緊要的，與解決困難無關的額外活動”，進而對專利適格性做了進一步限制。法院沒有解釋其提出的“有意義的限制”或“無關緊要的，與解決困難無關的額外活動”究竟是什麼意思。

另外，因為*Bilski*承認其權利要求不需要任何具體機器或設備，法院將“機器實

施的精確範圍”留待“在以後案件中詳加說明”，包括“在權利要求中，僅僅將方法與電腦關聯是否及如何能滿足將某項方法與某特定機器關聯的要求”。這個有待解決的問題尤為重要，因為多數具有任何價值的“商業方法”均是通過電腦實施的。

就“機器或轉變檢驗標準”的“轉變”方面而言，法院的討論結果亦留下了許多有待解決的問題。法院首先指出，“對於所主張的方法而言，轉變必須是該方法之核心內容”，但其並未解釋方法的“核心”究竟指什麼。法院還認為，如同可轉變有形物體或物質的方法，可轉變代表有形物體的電子資料之方法也具有專利適格性。反之，法院認為用於轉變“法律義務、組織關係和商業風險等抽象概念”的方法不具有專利適格性。法院沒有說明兩類轉變之間的明確界限。

法院的結論為，*Bilski*的方法僅包含“無適格性的轉變”，如對法律義務的轉變。因為該方法沒有導致“任何有形物體或物質的轉變，或導致代表任何有形物體或物質的電子信號的轉變”，所以該方法不具有第101條項下的專利適格性。

### 最高法院是否會改變聯邦巡迴上訴法院確立的規則？

今年初，聯邦巡迴上訴法院有一個機會將新確立的*Bilski*檢驗標準應用於另一起商業方法專利申請。不過，*Ferguson*案卻導致法官們意見出現分歧。多數意見認為由*Bilski*案確立的機器或轉變檢驗標準系確定方法專利適格性的唯一決定性檢驗標準，但Newman法官不認為該檢驗標準是確定專利適格性問題的唯一適用標準。根據Newman法官的意見，法庭沒有充分的根據推翻所有以往相關判例（而多數派正是那樣做的）。基於不同的理由她在判決中表示同意判決結果。

讓我們一起期待最高法院對*Bilski*案做出最終判決時，能闡明方法專利之適格性問題。■

<sup>1</sup> *Bilski*案，《聯邦判例彙編》第三輯第545卷第943頁（聯邦巡迴上訴法院2008年）。

<sup>2</sup> *Bilski*訴*Doll*，訴訟記錄第08-964號（2009年6月1日准予）。

<sup>3</sup> 這三起案件分別為*Gottschalk*訴*Benson* [409 US 63 (1972)]、*Parker*訴*Flook* [437 US 584 (1978)]以及*Diamond*訴*Diehr* [450 US 175 (1981)]。

<sup>4</sup> *State Street Bank & Trust Co.*訴*Signature Financial Group, Inc.*，《聯邦判例彙編》第三輯第149卷第1368頁（聯邦巡迴上訴法院2008年）。

<sup>5</sup> 過去十年裡，儘管在美國專利商標局進行的專利申請總量大致與十年前相同，第705類正式商業方法專利的數量卻增加了兩倍。不過，商業方法專利申請總量仍僅佔所有專利申請的1%。

<sup>6</sup> *Bilski*案：《聯邦判例彙編》第三輯第545卷第954頁（引證了*Benson*案(409 US at 70)、*Diehr*案(450 US at 192)、*Flook*案(437 US at 589 n.9)以及*Cochrane*訴*Deener*(94 US 780, 788 (1876))）。

<sup>7</sup> 同上。

<sup>8</sup> *Classes Immunotherapies, Inc.*訴*Biogen IDEC*（訴訟記錄第2006-1634號）。

## Federal Circuit Deals Blow to Qualcomm and Adds to the Law Governing Standard-Setting Organization Participants

The Federal Circuit recently concluded that the actions of a participant in a standard-setting organization may give rise to implied waiver and equitable estoppel as defenses to accusations of patent infringement. The court further developed and confirmed the jurisprudence surrounding standard-setting activity based estoppel, and held that participants in standard-setting organizations may have a duty to disclose their patent rights during the standard-setting process; that silence constitutes a breach of this duty; and that undisclosed patents may be deemed unenforceable against any adopters of the standardized technology, even if the adopter did not participate in the standard-setting activities. This is a significant development in the law that any party must consider in its litigation strategy.

In *Qualcomm Inc. v. Broadcom Corp.*, 548 F.3d 1004 (Fed. Cir. 2008), the Federal Circuit upheld the unenforceability of two Qualcomm patents due to Qualcomm's failure to disclose its patent rights while participating in the Joint Video Team (JVT) standards discussions.

The JVT was a standard-setting organization (SSO) created as a combined effort of the International Organization for Standardization, the International Electrotechnical Commission (ISO/IEC), and the International Telecommunication Union Telecommunication Standardization Sector (ITU-T) with the directive of creating a single royalty-free baseline standard for video compression technology. *Qualcomm*, 548 F.3d 1008, 1013. The standard was eventually referred to as H.264.

The Federal Circuit determined that Qualcomm had contravened its duty to disclose its intellectual property rights (IPR) because it failed to disclose them during the standard-setting process. Due to this conduct, the court held that Qualcomm's patents were unenforceable against any H.264 compliant devices.

Expanding on the analysis set forth in *Rambus Inv. v. Infineon Technologies AG*, 318 F.3d 1081 (Fed. Cir. 2003), the Federal Circuit concluded that the genesis of Qualcomm's duty

to disclose its IPR could originate from three independent sources: (1) the clear language of the SSO's IPR policy, (2) ambiguity in the language of the IPR policy coupled with the general understanding of the participants, or (3) the IPR policies of the parent organizations that created the SSO at issue. *Qualcomm*, 548 F.3d at 1012-1017. Of particular note, the Federal Circuit agreed with the district court's conclusion that even if the language of the JVT's IPR policy did not unambiguously create the disclosure obligation, the language of the IPR coupled with the JVT participants' understanding of the policies imposed a duty to disclose on all participants. *Qualcomm*, 548 F.3d at 1016.

Although the JVT IPR policy referred to the disclosure of intellectual property rights "associated with" any standardization proposal or "affecting the use" of JVT work, the Federal Circuit concluded that Qualcomm's duty to disclose only extended to those rights that "reasonably might be necessary" to practice the standard. *Qualcomm*, 548 F.3d at 1017-18. The Federal Circuit explained that



## 美國聯邦巡迴上訴法院: 高通公司敗訴 —標準制定組織成員面臨新增法律

美國聯邦巡迴上訴法院最近作出決定，認為標準制定組織成員（包括所有參與者）的某些行為可能導致默示棄權（implied waiver）及衡平禁反言（equitable estoppel），從而使侵犯專利權一方可以對指控作出有效抗辯。法院進一步闡述並確立了以標準制定行為為基礎的禁反言法律體系，並且認為標準制定組織的各個成員可能在制定標準的過程中，有責任主動披露其專利權；亦認為緘默則構成違反此責任；還認為，無論該使用者當初是否參與標準制定，未被披露的專利將不可對任何使用標準技術者強制執行。這樣重大的法律變化對任何企業的訴訟策略都將有很大影響。

在美國高通公司 (*Qualcomm Inc.*) 訴美國博通公司 (*Broadcom Corp.*) 一案中 (《聯邦判例彙編》第三輯第548卷第1004頁) (聯邦巡迴上訴法院2008年)，聯邦巡迴上訴法院確認高通公司的兩項專利不可強制執行，原因是高通公司在參與視頻聯合工作組 (Joint Video Team) 的標準討論時

未能披露其專利權。視頻聯合工作組是由國際標準化組織 (International Organization for Standardization)、國際電子技術委員會 (International Electrotechnical Commission) 及國際電信聯盟電信標準化部門 (International Telecommunication Union Telecommunication Standardization Sector) 共同設立的標準制定組織，旨在設立統一的、並免除專利金的視訊壓縮技術基準。高通公司案 (《聯邦判例彙編》第三輯第548卷第1013頁)。該基準後來被稱為H.264標準。

聯邦巡迴上訴法院做出判決，認為高通公司未能在制定標準的過程中披露其智慧產權，該行為已經抵觸其披露責任。由此，法院認為高通公司不可對任何符合H.264標準的裝置強制執行其專利。

通過對 *Rambus Inv. 訴 Infineon Technologies AG* 一案 (《聯邦判例彙編》第三輯第318卷第1081頁) (聯邦巡迴上訴法院2003年) 的分析進行擴充與詳

細說明，聯邦巡迴上訴法院決定，高通公司披露其智慧產權的責任起源於下列三個獨立的原因：(1) 標準制定組織的智慧產權書面政策清楚說明了該責任，(2) 智慧產權書面政策表述的模糊語意連同參與者的一般理解，或 (3) 標準制定組織之上級組織的智慧產權政策。高通公司案 (《聯邦判例彙編》第三輯第548卷第1012至1017頁)。須特別注意的是聯邦巡迴上訴法院同意地區法院的以下意見：即使視頻聯合工作組的智慧產權書面政策表述沒有清楚地設定披露義務，智慧產權的文字表述連同視頻聯合工作組參與者對政策的理解，亦可對所有參與者加諸披露責任。高通公司案 (《聯邦判例彙編》第三輯第548卷第1016頁)。

視頻聯合工作組的智慧產權政策提到：任何參與者都必須披露與任何標準化建議“有關”的、或“影響使用”其工作成果的智慧產權。雖然該政策使用了“有關”、“影響使用”的詞語，但聯邦巡迴上訴法院決

the “reasonably might be necessary” standard is “an objective standard, which applies when a reasonable competitor would not expect to practice the H.264 standard without a license under the undisclosed claims.” *Id.* at 1018. Additionally, this standard does not require that a patent “must ‘actually be necessary’ to practice the H.264 standard.” *Id.* In fact, the court held that Qualcomm had breached its duty of disclosure even though the jury returned a verdict that the products at issue did not infringe the patents by virtue of practicing the H.264 standard. *Id.* at 1018-19.

In this case, in addition to the theories of equitable estoppel and common law fraud that can be used to challenge a patentee’s actions before an SSO, the Federal Circuit validated the use of implied waiver as a theory for challenging the enforceability of patents in the context of standard-setting organizations. Due to the lower court’s decision, the Federal Circuit conducted its full analysis regarding the enforceability of the patents under the theory of implied waiver. That is, Qualcomm’s conduct was “so inconsistent with an intent to enforce its rights as to induce a reasonable belief that such right has been relinquished.” *Id.* at 1020 (citation omitted). But the court clearly noted that the scope

of Broadcom’s remedy would be the same under either implied waiver or equitable estoppel. *Id.* at 1023-24.

As a remedy, the district court held that the patents, including their continuations, continuations-in-part, divisions, reissues, and any other derivatives thereof, were completely unenforceable. *Id.* at 1024. Analogizing the present case to unenforceability due to patent misuse, the Federal Circuit reviewed and modified the scope of the unenforceability remedy. It stated that “the remedy for waiver in the SSO context should not be automatic, but should be fashioned to give a fair, just, and equitable response reflective of the offending conduct.” *Id.* at 1026. The Federal Circuit held the patents unenforceable against any products that practiced the H.264 standard. Notably, the Federal Circuit’s remedy is not contingent on a defendant’s participation in the standard-setting organization, either during the process that resulted in the standard or after the standard was enacted.

While the Federal Circuit somewhat limited the scope of the remedy, the loss to Qualcomm is still severe. Qualcomm’s implied waiver rendered the two patents at issue, and their derivatives, unenforceable as they

apply to any products that conform to the H.264 standard. This is a significant remedy, as the H.264 standard is becoming a universal standard for video compression technology that will be employed in most, if not all, of the products that also practice the Qualcomm patents.

As a result of the Federal Circuit’s decision in *Qualcomm*, any participant in an SSO must be aware that it may have a duty to disclose its IPR even if the language of the SSO’s IPR policy is ambiguous. A participant must observe the actions and understanding of other participants and the IPR policies of any parent organizations, which may create a duty to disclose. Further, any party in a patent infringement action involving patents that relate to a standardized technology should consider carefully pursuing and developing evidence regarding the understanding of the participants and the patentee’s actions before the SSO, as a breach of a duty to disclose may play a pivotal role in deciding the outcome of the action. During this analysis, parties should keep in mind that the Federal Circuit has affirmatively approved the theories of fraud, equitable estoppel, and implied waiver to attack the enforceability of the patents. ■

定，高通公司的披露責任僅限於在實施標準時，在合理狀況下有可能必須被用到的智慧產權。高通公司案（《聯邦判例彙編》第三輯第548卷第1017至18頁）。聯邦巡迴上訴法院解釋道，“合理狀況下可能必須”的標準是“一項客觀的標準，是指行業競爭對手在合理實施H.264標準時，不會預料到該實施沒有獲得那些未披露的智慧產權之許可”。（同上第1018頁）。此外，此標準沒有規定專利“必須是為實踐H.264標準所‘實際必須’的。”（同上）。事實上，法院認為，雖然陪審團決定被控產品沒有由於實踐H.264標準而侵犯高通公司專利權，但高通公司已經違反其披露責任。（同上第1018-19頁）

在本案中，除了衡平禁反言及普通法下的欺詐等理論可用於質疑專利權人與標準制定組織相關的行為外，聯邦巡迴上訴法院亦確認在涉及標準制定組織的情況下，默示棄權理論也可用於質疑專利的可執行性。由於下級法院做出的判決，聯邦巡迴上訴法院就根據默示棄權理論對專利進行了全面分析，認為高通公司的作為“與其強制執行其權利之意圖非常之不一致，以致於誘導他人

合理地相信該權利已經被放棄。”（同上第1020頁（省略引證））。法院同時清楚地指明，博通公司的救濟範圍無論根據默示棄權或者衡平禁反言，都是一樣的。（同上第1023-24頁）。

作為救濟方法，地區法院認為，所有相關專利，包括其延續子專利、部分延續子專利、部分子專利、重審核頒佈之專利，以及任何其他衍生專利，都是完全不可強制執行的。（同上第1024頁）。聯邦巡迴上訴法院將本案模擬於不當使用專利導致的不可執行情況，審議並修改不可執行的救濟範圍，說道：“在涉及標準制定組織的情況下，棄權的救濟不是自動的，而必須參照相關違法行為，給予相對應的以及公平、正確和公正的救濟。”（同上第1026頁）。聯邦巡迴上訴法院認為，專利對實施了H.264標準的任何產品均不可執行。特別值得一提的是，聯邦巡迴上訴法院的救濟不以被告人正式加入標準制定組織為前提，不論是在標準制定的過程中還是在標準通過之後。

雖然聯邦巡迴上訴法院在某程度上限制了救濟範圍，高通公司的損失仍然嚴重。高

通公司的默示棄權使得其相關的兩項專利及其衍生專利均不可對任何符合H.264標準的產品強制執行。這是一項重大的救濟，原因是H.264標準將成為視訊壓縮技術之全球標準，大部分（甚至全部）相關產品在實施標準時，亦將使用高通公司的專利。

由於聯邦巡迴上訴法院對高通公司作出的決定，標準制定組織的所有參與者必須知道，就算標準制定組織的智慧產權書面政策表述可能含糊，他們依然可能有責任披露其智慧產權。有關參與者必須關注其他參與者的法律行為和他們對政策的理解，以及任何上級組織的智慧產權政策。這些都可能產生參與者的披露責任。從另一角度，在涉及標準化技術的專利侵權訴訟中，違反披露責任可能對訴訟結果有十分重要的影響。因此，任何一方必須小心考慮並追蹤所有參與者對政策的理解以及專利權人在標準制定組織中的行為，並取得證據。在進行此分析時，各方應注意：聯邦巡迴上訴法院已經肯定表示欺詐、衡平禁反言、以及默示棄權的理論，都可以用於攻擊專利的可執行性。■

## In the Eye of the Beholder: The Essentiality Analysis and the Patent Misuse Defense

For the second time in connection with an ongoing investigation before the U.S. International Trade Commission (ITC), the Federal Circuit has addressed the applicability of the patent misuse defense with respect to patent pools. In its most recent decision, *Princo Corp. v. Int'l Trade Comm'n*, No. 2007-1386 (Fed. Cir. 2009) (*Princo*), the Federal Circuit has made it more difficult for alleged infringers to prove that pooled patents are impermissibly “tied” together.

A patent pool is a type of “tying” arrangement in which patents are licensed together as a package. U.S. Dep't of Justice & Federal Trade Comm'n, Antitrust Guidelines for the Licensing of Intellectual Property (1995) (Antitrust Guidelines) at 26-27. A “tying” arrangement is one of the activities that courts have found can “impermissibly broaden[] the scope of the patent grant leading to the unenforceability of the tied patents under the doctrine of patent misuse.” *U.S. Philips Corp. v. International Trade Comm'n*, 424 F.3d 1179, 1184 (Fed. Cir. 2005) (quoting *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1372 (Fed. Cir. 1998)). Whether a tying arrangement such as a patent pool is permissible

or impermissible depends on the exact nature of the tie: some tying arrangements are beneficial and pro-competitive, whereas other tying arrangements are anticompetitive. Antitrust Guidelines at 26-27.

Whether a tying arrangement such as a patent pool is permissible or impermissible depends on the exact nature of the tie: some tying arrangements are beneficial and pro-competitive, whereas other tying arrangements are anticompetitive.

At issue are the CD-R and CD-RW patent pools administered by Philips, which include patents owned

by, inter alia, Philips and Sony. During the ITC investigation, the Administrative Law Judge (ALJ) found that Philips had committed patent misuse by including patents in the patent pool that were “not essential for manufacturing compact discs compliant with the Orange Book standards, because there were commercially viable alternative methods of manufacturing CD-Rs and CD-RWs that did not require the use of technology covered by those patents.” *U.S. Philips Corp. v. Int'l Trade Comm'n*, 424 F.3d 1179, 1183 (Fed. Cir. 2005); *Princo* at 5-6. In other words, the ALJ found that the CD-R and CD-RW patent pools impermissibly tied patents that were essential to manufacturing CD-Rs and CD-RWs to those that were not. The ITC affirmed the ALJ's finding that four patents were non-essential and that their inclusion in the patent pools had an anticompetitive effect. On review, the Federal Circuit reversed finding that the accused infringers had failed to prove that (1) the four patents were in fact non-essential and (2) their inclusion in the pools had any anticompetitive effect. *Philips*, 424 F.3d at 1198. The case

## 仁者見仁，智者見智：必要性分析以及專利權濫用之抗辯

針對美國國際貿易委員會（ITC）進行的持續調查，美國聯邦巡迴上訴法院第二次詳細闡述了關於專利權濫用之抗辯是否適用於專利聯盟（patent pool）的問題。在其最近做出的判決中，*Princo Corp.*對國際貿易委員會案，案件號2007-1386（美國聯邦巡迴上訴法院 2009年）（*Princo*），美國聯邦巡迴上訴法院的判決使得涉嫌侵權人更難證明聯盟的專利是不允許被“捆綁”在一起的。

專利聯盟是一種“搭售”協定，根據該協定，專利可作為一個整體一同進行專利許可交易。美國司法部和聯邦貿易委員會，《與智慧產權許可有關的反托拉斯指南》（1995年）（《反托拉斯指南》）第26至27頁。“搭售”協議是一種由法院已經認定的，有可能“導致依照專利權濫用原則，使搭配在一起的專利不具執行性”的活動，因為該類活動“以法律不允許的方式擴大

了專利授予範圍”。美國飛利浦公司對國際貿易委員會案，（《聯邦判例彙編》第三輯第424卷第1179頁，1184頁）（美國聯邦巡迴上訴法院2005年）（引用*C.R. Bard, Inc.*對 *M3 Sys.*,

**允許或不允許諸如專利聯盟這樣的搭售協議嚴格取決於搭配的性質：某些搭售協議是有益、並能促進競爭的，而有些則是反競爭的。**

*Inc*案，《聯邦判例彙編》第三輯第157卷第1340頁，1372頁，美國聯邦巡迴上訴法院1998年）。允許或不允許諸如專利聯盟這樣的搭售協議嚴格取決於搭配的性質：某些搭售協議是有益、並能促進競爭的，而有些則是反競爭的。《反托拉斯指南》第26至27頁。涉案問題是飛利浦公司管理的可錄式（CD-R）和可讀寫光碟（CD-RW）專利聯盟，該專利聯盟包括飛利浦和SONY

公司等擁有的專利。在美國國際貿易委員會調查中，行政法官（ALJ）判決飛利浦的行為構成專利權濫用，理由是其其在專利聯盟中包括了“對生產符合橘皮書標準的壓縮碟片而言，系屬不必要的專利，因為在商業上存在可行的替代方法用於生產可錄式和可讀寫光碟，無需使用這些非必要專利中包含的技術。”美國飛利浦公司對國際貿易委員會案，（《聯邦判例彙編》第三輯第424卷第1179頁，1183頁）（美國聯邦巡迴上訴法院2005年）；*Princo*第5-6頁。換言之，行政法官判決：可錄式和可讀寫光碟專利聯盟不允許將生產可錄式和可讀寫光碟的必要專利和非必要專利進行搭配。隨後，美國國際貿易委員會維持了行政法官的判決：認為有四項專利是非必要的，而且認為專利聯盟中其包含的技術內容具有反競爭效果。但是，在復審中，美國聯邦巡迴上訴法院駁回了判決，因為被控侵權人未能證明（1）四

was remanded back to the ITC for further proceedings.

On remand, the ITC considered and rejected the accused infringers' patent misuse defense based on a fifth patent, Sony's U.S. Pat. No. 4,942,565 (Lagadec). Philips argued that claim 6 of the Lagadec patent was necessarily infringed by CD-Rs and CD-RWs because it covered both analog and digital implementations, while the

implementations, the Federal Circuit broadened the definition of essentiality. In *Philips*, the Federal Circuit had found that the patents-in-question were essential because "the record showed that those patents in fact had 'no practical or realistic alternative.'" *Princo* at 13 (quoting *Philips*, 424 F.3d at 1194, 1198). In *Princo*, however, the Federal Circuit expanded essentiality to encompass

prove the existence of nonessential patents in a patent pool, it has made the essentiality standard far more subjective. In order to determine essentiality, courts cannot simply construe patents correctly, but must now first stand in the shoes of a licensee and determine whether that licensee would believe that the patent "reasonably might be" essential. *Princo* at 18-19.

**By broadening of essentiality to encompass patents that are not in fact necessary to practice a standard, the Federal Circuit has not only made it correspondingly more difficult to prove the existence of nonessential patents in a patent pool, it has made the essentiality standard far more subjective.**

---

Separate from the analysis above, the Federal Circuit remanded the case back to the ITC in order to make additional findings on whether Philips and Sony had entered into an agreement in which Sony agreed not to license its patents for use with competing technologies. This theory is separate from and unrelated to the alleged infringers' tying theory. Although such an agreement would constitute patent misuse, *Princo* at 23, n. 11, the Federal Circuit found that the record was unclear as to whether Philips and Sony had in fact entered into such an agreement. *Princo* at 33-36. When remanding, the Federal Circuit emphasized that if there is insufficient evidence showing the agreement preventing licensing individual patent to be used with competing technologies, there cannot be any patent misuse under this theory. *Id.* at 36. ■

alleged infringers argued that, properly interpreted in light of the specification, claim 6's scope was limited to digital implementations and therefore would not be infringed by CD-Rs and CD-RWs. *Princo* at 15-16.

Instead of construing claim 6 to determine whether it was limited to non-infringing digital

a patent that "reasonably might be" essential. *Princo* at 18-19. In other words it does not matter whether a patent is in fact essential, only that a licensee might reasonably believe it to be. By broadening of essentiality to encompass patents that are not in fact necessary to practice a standard, the Federal Circuit has not only made it correspondingly more difficult to

項專利實際上是不必要的以及  
(2) 專利聯盟中包含的技術內容具有任何反競爭效果。飛利浦案，《聯邦判例彙編》第三輯第424卷第1198頁。該案被發回美國國際貿易委員會進行進一步審理。

案件被發回後，美國國際貿易委員會根據第5項專利（SONY

美國聯邦巡迴上訴法院沒有通過分析權利請求6來決定其是否僅限於數字實施方法，而是放寬了對必要性的定義。在飛利浦案中，美國聯邦巡迴上訴法院判決涉案專利是必要專利，因為“案件宗卷顯示這些專利實際上‘沒有可行的或實際的替代品’。” *Princo*案第13頁

存在非必要專利變得相對更加困難，還使得必要標準更加具有主觀性。為了確定必要性，現在法院不能只是簡單的正確解釋相關專利，還必須首先站在被許可人的立場，確定被許可人是否認為專利“合理並有可能是”必要的。*Princo*第18-19頁。

獨立於上述分析，美國聯邦巡迴上訴法院亦將案件發回美國國際貿易委員會，責令其判定飛利浦和SONY是否已經達成協議，若該專利已被包括在專利聯盟中，規定SONY不可向任何競爭技術發佈使用其專利的許可。該理論與涉嫌侵權人的搭售理論獨立，並毫無關係。儘管該等協議將構成專利權濫用，*Princo*第23頁注釋11，但聯邦巡迴上訴法院判定此案宗卷關於飛利浦和SONY是否已實際簽署該等協定，記錄並不清楚。*Princo*第33-36頁。在發回案件時，美國聯邦巡迴上訴法院強調，如果證據無法充分表明協議禁止向任何競爭技術發佈使用單個專利的許可，則在本理論項下，無任何專利權濫用問題。同上第36頁。■

## 通過將必要專利拓展為包括對執行標準無需是實際必要的專利，美國聯邦巡迴上訴法院不僅使得證明專利聯盟中存在非必要專利變得相對更加困難，還使得必要標準更加具有主觀性。

公司的美國專利號4,942,565（Lagadec），考慮並駁回了被控侵權人的專利權濫用抗辯。飛利浦辯稱可錄式和可讀寫光碟對Lagadec專利的權利要求6造成了必要的侵權，因為其包括仿真和數字實施方法。而涉嫌侵權人辯解道，根據規範的適當解釋，權利要求6的範圍僅限於數字實施方法，因此可錄式和可讀寫光碟未對其侵權。*Princo*第15-16頁。

（引用飛利浦，《聯邦判例彙編》第三輯第424卷第1194頁，1198頁）。但是在*Princo*案中，美國聯邦巡迴上訴法院將必要專利拓展為包括“合理並有可能是”必要的專利。*Princo*第18-19頁。換句話說，一項專利實際上是否必要無所謂，只要被許可人可能合理認為其必要就行。通過將必要專利拓展為包括對執行標準無需是實際必要的專利，美國聯邦巡迴上訴法院不僅使得證明專利聯盟中

## Impact Looms Large in Federal Circuit Decision: USPTO and Patent Applicants Still Locked in Showdown Following *Tafas v. Doll*

On March 20, 2009, in a split decision including three separate opinions, a panel of the Federal Circuit issued its long-awaited decision on the USPTO's attempted implementation of four new rules on continuation applications, number of claims, and requests for continued examination ("RCE"). In *Tafas v. Doll*, the majority found that the four new rules are within the scope of the USPTO's rulemaking authority. The majority also affirmed the district court's decision that the rule on continuation applications (Final Rule 78) was invalid on the ground that it was inconsistent with 35 U.S.C. § 120, but vacated the district court's invalidation of the remaining rules, and remanded the case for further proceedings. Judge Rader, in his dissent, found all four rules invalid. Although it remains to be seen how the issues left open with respect to rules that were upheld will be decided on remand, and it is not known whether rehearing en banc will be requested, any implementation of the new rules will create challenges for patent applicants.

### BACKGROUND

In January of 2006, the USPTO published two notices proposing limits on continuation applications, RCE practice, applications containing patentably indistinct claims, and examination of claims in patent applications. The goal of these proposed rules, according to the USPTO, was to "reduce the large and growing backlog of unexamined applications while maintaining or improving the quality of issued patents." After receiving and analyzing more than 500 comments, many of which opposed these proposed rules, the USPTO made minor modifications and issued the final rules on August 21, 2007. These new rules (collectively known as the "Final Rules") were to become effective on November 1, 2007, and four of the main rules (Final Rules 75, 78, 114, and 265) were at issue in litigation.

Final Rules 78 and 114, also known collectively as the "2 + 1 Rule," are directed to continuation applications and RCEs, respectively. Under Final Rule 78, an applicant is entitled to file two continuation or continuation-in-

part applications as a matter of right. Additional continuation applications may be filed only if the applicant files a petition "showing that the amendment, argument, or evidence sought to be entered could not have been submitted during the prosecution of the prior-filed application." Similarly, Final Rule 114 provides that an applicant is allowed one RCE as a matter of right *within an application family*. A petition similar to Final Rule 78 must also be filed if an applicant seeks to file any additional RCEs.

Final Rules 75 and 265 impose obligations on applicants when the number of claims filed in a set of related copending applications exceeds 5 independent and 25 total claims (the "5/25 Rule"). Final Rule 75 requires a submission of an Examination Support Document ("ESD") before the first Office action on the merits, if these limits are exceeded. The 5/25 claim threshold does not count withdrawn claims, but does count all of the claims present in other co-pending applications having a patentably indistinct claim. Up to 15 independent claims and 75 total claims via an initial



## 美國聯邦巡迴上訴法院的判決影響巨大： *Tafas*對*Doll*案後，美國專利商標局和專利申請人仍處於一決雌雄的僵局狀態

2009年3月20日，在包括三種單獨意見的非一致決定中，美國聯邦巡迴上訴法院的合議庭發佈了令人期待已久的，有關美國專利商標局嘗試執行的四項新規則的決定。這四項新規則則是關於繼續申請類專利（continuation application）、權利請求項數和請求繼續審查（“RCE”）。在*Tafas*對*Doll*案中，多數法官裁決四項新規則未逾越美國專利商標局的規則制定權力範圍。多數法官也以抵觸《美國法典》第35篇第120條的理由維持地區法院做出的“繼續申請規則（最終規則第78條）無效”的判決，但是推翻了地區法院認定其餘規則也無效的判決，並將案件發回做進一步審理。Rader法官在其異議書中裁決4項規則全部無效。儘管還需等待在發回重審中初審法官是如何裁定有爭議規則，而且也不知道聯邦巡迴上訴法院是否需要全體法官出庭重審，但任何新規則的實施都將給專利申請人帶來挑戰。

### 背景

2006年1月，美國專利商標局發佈兩個通知，提議限制專利申請中的繼續申請、請求繼續審查、含有可專利性無法區分的權利請求的申請、以及權利請求審查。美國專利商標局稱，提議這些規則的目的是“減少大量的並且不斷增多的未審查申請遺案，同時維持並提高已公佈專利的品質。”在接受並分析了500多份意見後（其中多數意見反對這些提議規則），美國專利商標局進行較小修改後於2007年8月21日公佈了最終規則。這些新規則（統稱“最終規則”）於2007年11月1日生效，但主要規則中有4條（第75條、78條、114條和265條）仍是訴訟爭議項。

被統稱為“2 + 1規則”的是最終規則第78條和114條。它們是分別針對繼續申請和請求繼續審查的。根據最終規則第78條，申請人有權提交兩件繼續申請或部分繼續申請，作為一項權利。僅當申請人提交

請求“表明尋求執行的修改、答辯或證據無法或本不應該在之前提交的申請的審查過程中予以提交”時，方可提交更多的繼續申請。與之類似，最終規則第114條規定，申請人允許在一個申請族（patent family）中提交一次請求繼續審查，作為一項權利。如果申請人尋求提交更多次的請求繼續審查，也必須提交與最終規則第78條類似的請求。

當一系列相關的未結申請，總共擁有獨立權利請求項項數超過5項或者總項數超過25項（“5/25”規則）時，最終規則第75條和265條要求申請人承擔相關義務。最終規則第75條要求，如果超出上述限制，則需在第一次實質性審查意見通知做出之前提交審查支持檔（ESD）。5/25權利請求項限制不包括撤回的權利請求，但是包括所有相關未結申請中，具有可專利性無法區分的權利請求，無論它們是否處在不同相關未結申請中。申

application and 2 continuation applications, but only when prosecuted *serially*, can be presented by an applicant. Final Rule 265 sets out the requirements for ESDs, which include a preexamination search statement, a list of relevant references, identification of claim limitations disclosed by each reference, detailed explanation of patentability of each independent claim, and identification of support in the specification under 35 U.S.C. § 112, ¶ 1.

Shortly after the publication date of the new final rules in the Federal Register, first Triantafyllos Tafas, and then SmithKline Beecham Corporation, and Glaxo Group (“Tafas”) filed suit against the USPTO on the grounds that the Final Rules violate the Constitution, the Patent Act, the Administrative Procedure Act, and the Regulatory Flexibility Act. In *Tafas v. Dudas*, 511 F. Supp. 2d 652 (E.D. Va. 2007) (“*Tafas I*”), the district court preliminarily enjoined enforcement of the Final Rules. Tafas subsequently moved for summary judgment on the ground that the Final Rules were invalid and sought a permanent injunction. In *Tafas v. Dudas*, 541 F. Supp. 2d 805 (E.D. Va. 2007) (“*Tafas II*”), the district court granted Tafas’ motion for summary judgment, on the grounds that the Final Rules were inconsistent with

the Patent Act and the precedents from the Federal Circuit; that the USPTO lacked substantive rulemaking authority; and that the Final Rules exceeded the USPTO’s statutory authority and were invalid. The USPTO appealed to the Federal Circuit. Among the issues before the Federal Circuit were whether the USPTO has substantive rulemaking authority, whether the Final Rules are substantive or procedural, and whether these four new rules are valid.

## THE FEDERAL CIRCUIT’S DECISION

### Rulemaking Authority

In setting out the analytical framework, Judge Prost, writing for the majority, agreed with the district court that the USPTO is not vested with any general substantive rulemaking power under § 2(b)(2) of the Patent Act, but is vested only with the authority to establish regulations that govern “the conduct of proceedings.” See 35 U.S.C. § 2(b)(2) (giving USPTO authority to “establish regulation, not inconsistent with law, which . . . (A) shall govern the conduct of proceedings in the office; . . . (C) shall facilitate and expedite the processing of patent applications, particularly those which can be filed, stored, processed, searched, and retrieved electronically . . . (D) may govern the recognition and conduct of agents, attorneys, or other

persons representing applicants or other parties before the Office . . .”)

More specifically, Judge Prost’s opinion rejected the USPTO’s argument that the substantive or procedural distinction is immaterial, because Congress has not vested the USPTO with any general substantive rulemaking power and that the language of “the conduct of proceedings in the Office” in § 2(b)(2) is “indicative that Congress did not intend to give the USPTO substantive rulemaking authority.” This opinion also rejected the USPTO’s argument that “*Chevron* deference should have been extended to the issue of whether § 2(b)(2) provides substantive rulemaking authority,” because the cases that were given *Chevron* deference, as relied on by the USPTO, involved judicial review of procedural rules and therefore were within the scope of the USPTO’s rulemaking authority. *Chevron U.S.A., Inc. v. Natural Resources Defense Council, Inc.*, 467 U.S. 837, 866 (1984) (“When a challenge to an agency construction of a statutory provision, fairly conceptualized, really centers on the wisdom of the agency’s policy, rather than whether it is a reasonable choice within a gap left open by Congress, the challenge must fail.”). However, the Federal Circuit agreed with the USPTO that *Chevron* deference

請人可通過最初申請和兩件繼續申請（但僅限於在相繼審查時）提出最多15項獨立權利請求和總計75項權利請求。最終規則第265條對審查支持檔做出了要求，包括《美國法典》第35篇第112條1款項下的審查前檢索聲明、相關參考檔列表、確認各參考檔披露的權利請求限制、各獨立權利請求項可專利性的詳細解釋、以及專利說明中對權利請求的支持（指第35篇第112條1款項下的支援）。

新最終規則在《聯邦紀事》上公佈後不久，Triantafyllos Tafas、SmithKline Beecham Corporation和Glaxo Group (“Tafas”)以最終規則違反了憲法、專利法、行政程式法和美國管制靈活性法為由先後起訴美國專利商標局。在Tafas對Dudas案中，（《聯邦補充判例彙編》第二輯第511卷第652頁）（弗吉尼亞州東區法院，2007年）（“Tafas I”），地區法院初步命令執行最終規則。隨後Tafas以最終規則無效為由尋求簡易判決並尋求永久禁止令。在Tafas對Dudas案中，（《聯邦補充判例彙編》第二輯第541卷第805頁）（弗吉尼亞州東區法院，2007年）（“Tafas II”），地區法院基於下述理

由同意Tafas的簡易判決申請，即通過簡易判決程式，判決最終規則與專利法和美國聯邦巡迴上訴法院的判決先例相抵觸；美國專利商標局缺少實質性法規制定權；最終規則超出了美國專利商標局的法規制定權力範圍，從而無效。美國專利商標局向美國聯邦巡迴上訴法院提起上訴。美國聯邦巡迴上訴法院面臨的問題是：美國專利商標局是否有實質性的法規制定權、最終規則是實質性的還是程式性的以及這四項新規則是否有效。

### 美國聯邦巡迴上訴法院的判決

#### 法規制定權

在制定分析框架時，Prost法官代表多數法官，在法庭意見書中同意地區法院的裁決：美國專利商標局未被授予專利法第2(b)(2)條項下任何通常的實質性的法規制定權，而僅被授予制定管理“程式列為”之法規的權力。參見《美國法典》第35篇第2(b)(2)條（賦予美國專利商標局制定不與法律相抵觸之法規的權力…（A）應當管理當職者的程式列為；…（C）應當方便並加速處理專利申請，尤其是那些可以通過電子方式提交、

儲存、處理、檢索及恢復的專利申請…（D）可以管理代理、律師、或其他在專利局代表申請人、或其他當事人的身份和行為…”）

更具體而言，Prost法官的意見否定了美國專利商標局所謂的實質性與程式性之區分是無關緊要的辯論，因為美國國會未授予美國專利商標局任何通常的實質性的法規制定權，第2(b)(2)條中的語言表述“在專利局中，程式列為”表示出“美國國會無意向美國專利商標局授予實質性的法規制定權。”該意見還駁回了美國專利商標局的辯論“法庭尊重政府行政機構（Chevron deference）應對2(b)(2)條是否規定了實質性的法規制定權適用，”駁回的原因是美國專利商標局所依賴的應用Chevron deference原則之案例，都只涉及程式規則的司法審查，因此那些案例中法規制定都在美國專利商標局的法規制定權範圍內。Chevron U.S.A., Inc.對美國自然資源保護委員會, 467 U.S. 837, 866 (1984)（“當對某行政機構對有關法律條款解釋質疑時，如果公正地看，只是關注該機構政策是否明智，而不是其是否在填補立法空白，這樣質疑是站不住腳的”）。但是，美國聯邦巡迴上訴法院在以

can be given to the USPTO's interpretation of statutory provisions in relation to its rulemaking within its delegated authority.

### **Final Rules Are Procedural**

According to the majority opinion, the Final Rules are procedural because they “govern the timing of and materials that must be submitted with patent applications . . . [t]he Final Rules may ‘alter the manner in which the parties present . . . their viewpoints’ to the USPTO, but they do not, on their face, ‘foreclose effective opportunity’ to present patent applications for examination.” The requirement of providing all then available amendments, arguments, and evidence by the second continuation application or the first RCE under Final Rules 78 and 114 was considered not a significant burden that would “foreclose effective opportunity” from an applicant, and it was asserted that the courts “will be free to entertain challenges to the USPTO’s application of the Final Rules, including its view of when amendments, arguments, and evidence could not have been submitted earlier.” With respect to Final Rules 75 and 265, while an increased burden of production may be placed on the applicant, the examiner still has the burden of

persuasion in denying patentability. Further, the majority held that the ESD requirement, on its face, does not require a “world-wide search of prior art without regard to scope, time, or cost”; that the concern for inequitable conduct allegations is too speculative to void these rules; and that the practice of limiting the length of prosecution history to broaden the scope of the claims is not a right that can be invoked to void the Final Rules.

### **Final Rule 78**

The Federal Circuit affirmed the district court’s holding that Final Rule 78 is invalid, but on different grounds. At the Federal Circuit, invalidity was based on the conclusion that the rule is inconsistent with 35 U.S.C. § 120. Because § 120 unambiguously and plainly states that an application meeting the requirements of the statute shall have the “same effect” as if filed on the date of the priority, adding an additional requirement (i.e., amendments, arguments, or evidence that could not have been submitted earlier) to these requirements is foreclosed by the statute.

### **Final Rule 114**

The majority reversed the district court’s holding that Final Rule 114 was inconsistent with 35 U.S.C. § 132(a) and (b), including

arguments that § 132 should be interpreted on “per application” basis and that Congress intended RCEs to be unlimited in number at applicant’s discretion. The opinion deferred to the USPTO’s reasonable interpretation of the statute, which allows the USPTO to “‘prescribe regulations’ to govern the applicant’s ability to request continued examination, which must, in some circumstances, be granted.” Accordingly, the majority held that Final Rule 114 can be applied on a per-family basis and that it is not required by the statute to grant unlimited RCEs.

### **Final Rules 75 and 265**

Similarly, the majority reversed the district court’s holding that Final Rules 75 and 265 violated 35 U.S.C. §§ 102, 103, 112, and 131. While the opinion made clear that any rule setting an absolute limit on the number of claims perused would be invalid, it did not find Final Rules 75 and 265 to do so. The additional burden of providing an ESD can be met by applicants, and such submission does not change the standards by which the application is examined. Concerns regarding exposure to inequitable conduct allegations based on any inadequacy in an ESD were considered not to be germane. ■

下這點上同意美國專利商標局的說法，即針對其法規制定權相關法條司法解釋而言，美國專利商標局在其被授權範圍內將享有 *Chevron* deference。

### 最終規則是程式性的

根據多數法官的意見，最終規則是屬於程式性的，因為其“管理著必須與專利申請一同提交的資料以及提交時間…最終規則可能會‘改變當事人向美國專利商標局提出……其觀點的方式’，但是並不直接了當‘妨礙當事人提出專利審查申請之有效機會’”。正式規則第78條和第114條規定，在第二件繼續申請之前，或首次請求繼續申請之前，當事人必須提交所有屆時可用的修改、答辯以及證據。法院認為這一要求並不對申請人獲得“有效機會”造成巨大負擔，而且法院亦宣稱“當事人盡可以在法院對美國專利商標局最終具體規則的應用提出質疑，包括對何為無法在先前的申請中提交修改、答辯以及證據，專利商標局所採納的觀點。”就最終規則第75條和第265條而言，雖然給申請人造成需要提供更多資料的負擔，審查人員在拒絕可專利性時，依然面臨說服負擔（burden of

persuasion）。此外，多數法官認為：ESD要求並沒有直接強求“不考慮範圍、時間或費用進行世界範圍內檢索”；這些法規將製造申請人不公平行為的觀點過於臆測，從而無法使這些法規無效；以及限制審查時間的長度以拓展權利請求範圍的做法，也不是一項可以用來使最終法規無效的權利。

### 最終規則第78條

美國聯邦巡迴上訴法院維持了地區法院做出的最終規則第78條無效的判決，但是是基於不同的理由。美國聯邦巡迴上訴法院判決的無效是以該規則與《美國法典》第35篇第120條相抵觸這一結論為基礎的。因為第120條明確且簡明的表述稱，符合法規要求的申請應具有與在優先權日提交之申請有“同等的效力”，法規禁止對這些要求添加附加要求（例如：無法在早些時候提交相關修改、答辯或證據的要求）。

### 最終規則第114條

多數法官推翻了地區法院做出的最終規則第114條與《美國法典》第35篇第132（a）和（b）條相抵觸的判決，地區法院的那些判決包

括需以“每個申請”為基礎來解釋第132條，以及美國國會打算不加限制地讓申請人自行決定請求繼續審查的次數。法庭意見書尊重美國專利商標局對法令的合理解釋，該法令允許美國專利商標局“‘制定法規’從而管理申請人請求繼續審查的能力，只要在某些情況下，專利商標局必須同意所提出的繼續審查請求”。相應的，多數法官裁決最終規則第114條可以按申請族予以適用，法令無需授予無限次數的繼續審查請求。

### 最終規則第75條和第265條

如此，多數法官也推翻了地區法院做出的最終規則第75條和第265條違反了《美國法典》第35篇第102條、103條、112條和131條的判決。意見明確表示對權利請求項數設定絕對限制的任何規則均將無效，但其未發現第75條和第265條存在上述情況。申請人可以滿足提供ESD的額外負擔，而且進行該等提交並未改變審查申請的標準。針對以ESD中存在任何不足，從而會導致不公平行為的主張，法庭認為其無足輕重。■

## Intellectual Property Practice News

### RECENT 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**. In awarding the firm's IP practice with more top rankings than any other firm in the world, **Chambers Global** 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 firm was further honored with a *Band One* ranking for *Japan IP* in the new **Chambers Asia** survey. The Asia Pacific Legal 500 ranked us *Band One* in *Japan for IP International Firms and Joint Ventures*. Our *Patent Prosecution*, *ITC Section 337*, and *Trademark* practices were also honored in *Managing IP*, earning *Tier 2*, *Tier 3*, and *Tier 4* rankings, respectively.

### FROM THE DOCKET

#### East Texas Jury Awards Pioneer \$60 Million

Morrison & Foerster secured a major victory in October 2008 for

Pioneer Corporation in a patent infringement suit against Samsung Electronics Co., Ltd. and its affiliates. After an eight-day trial, and only four hours of deliberation, a jury in the Eastern District of Texas decided three Samsung entities had willfully infringed the patents in suit and awarded \$59.3 million in compensatory damages to Pioneer. The two parties settled soon after the verdict. Filed in the fall of 2006, the suit asserted that plasma televisions manufactured by Samsung infringed two plasma display technology patents held by Pioneer.

In a press release announcing the outcome of the trial, Pioneer stated: "This significant decision in favor of Pioneer represents recognition of the strength of Pioneer's intellectual property rights in the field of plasma displays." The winning team was led by **Harold McElhinny** (San Francisco office), **Karen Hagberg** (New York office), and **Andrew Monach** (San Francisco).

#### Evapco Wins Complete Summary Judgment Defense

In a defense victory for Evapco, Inc., on January 8 a district

court judge granted summary judgment of non-infringement and invalidity, and dismissed all patent infringement claims stemming from two patents 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 the summary judgment motions.

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. Evapco has prevailed on all of Clearwater's claims.

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

## 智慧產權業務新聞

### 最近所獲獎勵和榮譽

美富智慧產權業務在2009年第一季度不斷榮獲嘉獎，取得了《錢伯斯&合夥人》、《亞太法律500強》以及《管理智慧產權》授予的主要榮譽。與世界上任何其他律所相比，《錢伯斯環球指南》向本所智慧產權業務授予了更多的頂級排名，《錢伯斯環球指南》將本所智慧產權業務列為全球智慧產權、全球智慧產權生命科學和美國智慧產權領域的1級律所。《錢伯斯環球指南》引用一位元客戶的話說“美富不斷超越我們的預期，的確是最傑出的律所之一。”在最新進行的錢伯斯亞洲調查中，本所憑藉日本智慧產權業務又一次被授予1級榮譽。《亞太法律500強》將本所譽為日本地區智慧產權國際公司和合資公司業務領域的1級律所。《管理智慧產權》還將本所的專利審查、美國國際貿易委員會第337條、以及商標業務分別排為2級、3級和4級。

### 案件

#### 德州東區法院陪審團裁決先鋒公司獲得6000萬美元賠償

在向三星電子及其關聯公司提起的專利侵權訴訟中，美富律師事務所在2008年10月為先鋒公司贏得了巨大勝利。經過8天的審判，以及僅僅4個小時的商議，德克薩斯州東區法院的陪審團判決3家三星實體曾故意侵犯訴訟專利，並裁決向先鋒公司支付5930萬美元作為損失賠償金。在裁決後雙方很快達成了和解。該訴訟是在2006年秋季提起的，訴訟指控三星公司生產的等離子電視侵犯了先鋒公司持有的兩項等離子顯示器技術專利。

在宣佈審判結果的一篇新聞稿中，先鋒公司表示：“本次有利於先鋒公司的重大判決認可了先鋒公司在等離子顯示器領域擁有的智慧產權實力。”美富取得案件勝利的團隊由**Harold McElhinny**（舊金山市辦事

處）、**Karen Hagberg**（紐約辦事處）和 **Andrew Monach**（舊金山辦事處）領導。

#### Evapco在簡易判決中全面辨訴成功

美富為Evapco, Inc贏得辯護勝利。1月8日，在*Clearwater Systems Corp*對*Evapco, Inc*案中，地區法院法官授予Evapo未侵權和無效簡易判決，並駁回Clearwater基於兩項專利提出的所有專利侵權權利主張。康涅狄格州地區法院做出的這項有利於Evapo的裁決，是在宣佈有利於Evapco的**Markman**令，以及去年秋季舉行的聽證（在此次聽證上審理了有關簡易判決申請的爭議）後而決定的。

Clearwater Systems 和Evapco均是非化學水處理設備的生產商。Clearwater首先在2005年提起了訴訟，其主張包括盜取商業秘密和其他商業法侵權。Clearwater還主張Evapco侵犯了Clearwater的

### MoFo Achieves ITC Win for Funai in Patent Infringement Suit

On April 10, the U.S. International Trade Commission (ITC) issued a final determination and remedy order finding that the respondents infringe Funai Electric Co., Ltd.'s digital television patent and that their products shall be barred from importation or sale in the U.S.

The victory for Japan-based Funai Electric and its affiliate, U.S.-based Funai Corporation, Inc., comes against 14 respondents, including Vizio, TPV, Amtran, Proview, and Syntax-Brilliant. The Investigation before the ITC began in November 2007, after Funai filed a formal complaint alleging violations of Section 337 of the Tariff Act of 1930.

The Morrison & Foerster winning team was led by partner **Karl Kramer**, with assistance from partners **Harold McElhinny, Hector Gallegos, Brian Busey, Louise Stoupe, Moto Araki, Nicole Smith, Mark Danis**, and **Anthony Press**. ■

兩項專利，其中一個是針對非化學水處理設備提起的侵權主張，另外一個是針對非化學水處理方法提出的。針對Clearwater的所有侵權主張，Evapco均取得了勝利。

美富取得案件勝利的團隊由合夥人 **Alexander Hadjis**（韓明山）、律師 **Matt Vlissides, Yan Wang**（王焱）、**Paul Kletzly**和技術顧問 **Vivian Lei**（雷以書）領導。

### 美富在國際貿易委員會為船井公司贏得專利侵權訴訟

4月10日，美國國際貿易委員會（ITC）宣佈正式判決和救濟令，判決被告侵犯了船井電機株式會社的數位電視專利，以及被告的產品被禁止向美國進口或在美國銷售。

此次為位於日本的船井電機株式會社和其位於美國的關聯公司船井有限公司取得的勝利是針對14家被告的，其中包括 Vizio, TPV, Amtran,

Proview, and Syntax-Brilliant。美國國際貿易委員會的調查是在船井公司提交正式訴狀，主張違反1930年《關稅法》第337條後於2007年11月開始的。

美富取得案件勝利的團隊由合夥人 **Karl Kramer** 領導，由合夥人 **Harold McElhinny、Hector Gallegos、Brian Busey、Louise Stoupe、Moto Araki、Nicole Smith、Mark Danis** 和 **Anthony Press** 提供協助。■

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@mofocom](mailto:mzwerin@mofocom) in Palo Alto, David Harvey at [dharvey@mofocom](mailto:dharvey@mofocom) in Washington, D.C. or Priscilla Chen at [priscillachen@mofocom](mailto:priscillachen@mofocom) in Greater China.

©2009 Morrison & Foerster LLP. All Rights Reserved.