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Note from the Editors

As economic signs point to a recovery from the severe global downturn, many companies are positioning themselves for growth. Chinese companies that protect and assert their intellectual property in China and abroad stand to benefit as they market their products globally. We hope the information in this issue will help keep you informed as you guide your own company's business and legal strategies.

In this issue, we share good news for Chinese contract research organizations: a recent federal circuit decision places limits on patent infringement liability for method patents. In other IP legal news, we discuss the success of companies seeking to transfer cases out of the Eastern District of Texas — and the challenges that remain. In addition, we summarize the important efforts to harmonize Chinese patent litigation among the Chinese courts.

We are also happy to report a recent victory by Morrison & Foerster for firm client, AMEC, as well as rankings listing the firm as among the most active in patent litigation cases in the U.S. We hope that you find the Morrison & Foerster China IP Quarterly Newsletter informative, and we welcome your feedback on these issues. A list of the members of our editorial board and their contact information is included on the back page. ■

编者按

随着经济形势显露出从严重全球危机中复苏的迹象，许多公司都在为实现增长进行自我定位。在国内外保护并主张其知识产权的中国公司一定能在全球市场上受益。我们希望本期提供的信息有助于您指导贵公司的业务和法律策略。

在本期通讯中，我们与您分享一则对中国合同研究组织有利的消息：美国联邦巡回上诉法院最近做出的判决对方法专利侵权责任加以了限制。在另一则知识产权法律新闻中，我们讨论了数家公司成功地将案件移出德州东区法院的案例——以及仍然存在的挑战。另外，我们还概述了为在中国各法院间协调中国专利诉讼所采取的一项重要举措。

我们还很高兴向您汇报美富最近为本所客户中微半导体设备有限公司赢得的一场胜利，以及本所被列为美国专利诉讼案中最活跃的律师事务所之一。

我们希望您能从美富《中国知识产权季度通讯》中获得有用的信息，并欢迎您就上述问题提供反馈意见。本季度通讯封底提供有本所编辑委员会成员的名单及其联系方式。■

Federal Circuit Ruling Spells Good News for Chinese CROs

By Janet Xiao and Kun Wang

In an en banc decision, *Cardiac Pacemakers, Inc. v. St. Jude Medical, Inc.*, 2007-1296 (Fed. Cir. Aug. 19, 2009), the Court of Appeals for the Federal Circuit in the United States overruled a previous Federal Circuit panel decision and held that Section 271(f) of the U.S. Patent Law, which provides a form of offshore patent infringement liability against persons who supply “components” of a patented invention in the U.S. for assembly abroad, does not apply to method claims. This bright-line rule eliminates an uncertainty faced by U.S. companies outsourcing research, development, and manufacture activities overseas, and significantly reduces their risks of patent infringement liability. For Chinese contract research organizations (“CROs”), the *Cardiac Pacemakers* decision should be particularly welcome news, since U.S. companies may now be even more willing to outsource their research, development, and manufacturing processes to China.

BACKGROUND AND PRIOR JUDICIAL INTERPRETATION OF § 271(F)

35 U.S.C. §271(f) provides that one who “supplies [] in or from the United States all or a substantial portion of the components of a patented invention, where such components are uncombined

in whole or in part, in such manner as to actively induce the combination of such components outside of the United States” shall be liable for patent infringement. 35 U.S.C. § 271(f)(1) (emphasis added). It was enacted in response to the Supreme Court case *Deepsouth Packing Co., Inc. v. Laitram Corp.*, which held that shipment of unassembled parts of a patented shrimp deveining machine for assembly abroad did not constitute patent infringement in the United States. 406 U.S. 518, 527, 531 (1972). To close a loophole created by *Deepsouth Packing* that allowed U.S. companies to circumvent the reach of U.S. patent law by shipping components of infringing products offshore and assembling them outside of the U.S., the Congress enacted § 271(f) to make it a patent infringement to supply components of a patented invention outside of the United States.

In 2005, a Federal Circuit panel held that § 271(f) applied to method claims. *Union Carbide Chemicals & Plastics Technology Corp. v. Shell Oil Co.*, 425 F.3d 1366 (Fed. Cir. 2005). *Union Carbide* involved exportation of a catalyst for performing a patented method of producing ethylene oxide outside of the United States. Finding the catalyst to be a “component” under § 271(f), the three-judge panel found that exportation of the catalyst and use of the patented

method abroad implicated § 271(f). The court stated that “because 271(f) governs method/process inventions, [defendant’s] exportation of the catalysts may result in liability” under that section. *Id.* at 1380.

In 2007, the Supreme Court in *Microsoft Corp. v. AT&T Corp.*, 550 U.S. 437 (2007), examined § 271(f) in a different context. The patent at issue in *Microsoft* involved a computer for processing speech. Microsoft shipped master computer disks abroad. Copies of the master disks were subsequently installed abroad into computers; upon installation of the master disks, the computers would fall within the scope of the patent. The Supreme Court found that Microsoft did not supply combinable components of a patented computer when it shipped the master disks abroad to be copied. Because the foreign-made copies of the master disk that were installed on computers were supplied from places outside of the United States, the Court held that Microsoft had not supplied components from the United States and thus could not be found liable for patent infringement under § 271(f).

The Supreme Court noted that “[a]ny doubt that Microsoft’s conduct falls outside §271(f)’s compass would be resolved by the presumption against extraterritoriality.” *Id.* at 454. The

联邦巡回上诉法院判决给中国合同研究组织带来佳音

作者：肖荐、王堃

在一次经全院合议庭庭审后做出的判决中 (*Cardiac Pacemakers, Inc. 对 St. Jude Medical, Inc.* (备案号2007-1296, 联邦巡回上诉法院2009年8月19日)), 美国联邦巡回上诉法院推翻了其先前做出的一项判决, 并认定美国专利法第271(f)条关于为在海外组装供应美国专利发明“构件”的人应承担的海外专利侵权责任的规定不适用于方法专利。上述明确规则排除了往海外外包研发和制造活动的美国公司面临的不确定性, 并大大降低了他们在专利侵权责任方面的风险。对于中国合同研究组织而言, *Cardiac Pacemakers*案的判决应为一大喜讯, 因为美国公司现在可能会更愿意将其研发和制造流程外包给中国公司。

第271(f)条的背景及其先前的司法解释

《美国法典》第35编第271(f)条规定, 任何人“在或从美国提供... 一项专利发明的全部或绝大部分构件, 并积极引导该等全部或部分拆分的构件在美国境外进行组装”, 则其应承担专利侵权责任(见《美国法典》第35编第271(f)条)(本文提供加重)。该条规定是针对最

高法院审理的 *Deepsouth Packing Co., Inc. 对 Laitram Corp.* 一案制定的, 该案判定将拆装的专利去虾肠机器运输至国外进行组装的行为在美国不构成专利侵权(见《美国案例汇编》第406卷第518, 527, 531页(1972年))。 *Deepsouth Packing* 案允许美国公司通过将侵权产品的构件运输至海外并在美国境外对其进行组装, 从而逃避美国专利法的管辖。为终止由该案造成的上述漏洞, 国会制定了第271(f)条, 规定向美国境外供应专利发明的构件应属专利侵权行为。

2005年, 联邦巡回上诉法院审判庭认定第271(f)条适用于方法专利 (*Union Carbide Chemicals & Plastics Technology Corp. 对 Shell Oil Co.*, 《联邦案例汇编》第3辑第425卷第1366页, (联邦巡回上诉法院2005年))。 *Union Carbide* 涉及出口催化剂以便在美国境外实施能产生环氧乙烷的专利方法。在判定催化剂属于第271(f)条项下的“构件”后, 由三名法官组成的审判庭认定出口催化剂和在国外使用专利方法牵涉到第271(f)条。法院判定

“由于第271(f)条适用于方法/程序发明, [被告]出口催化剂可以”依照该条款“导致相关责任”(同上第1380页)。

2007年, 最高法院在 *Microsoft Corp. 对 AT&T Corp.* (《美国案例汇编》第550卷第437页(2007年))一案中根据稍有差异的背景对第271(f)条进行了考究。 *Microsoft* 案中的专利涉及处理语音的计算机。微软将主计算机磁盘运输至海外。随后在海外将主计算机磁盘的拷贝安装入计算机, 该等计算机在安装上述拷贝后将落入专利保护范围。最高法院认定微软在将主磁盘运输至海外进行拷贝时没有供应可组装的专利计算机的构件。由于在计算机上安装的海外制造的主磁盘拷贝是从美国境外供应的, 法院认定微软没有从美国供应构件, 因此不应判决其承担第271(f)条项下的专利侵权责任。

最高法院做出注解, 认为“对微软产品在第271(f)条管辖范围之外这一点存在的任何疑虑可通过对治外法权的无效假定予以解决”(同上第454页)。不过, 法院没有裁定“无形的的方法或程序.....是否有资格

Court, however, refrained from deciding whether “an intangible method or process . . . qualifies as a ‘patented invention’ under § 271(f).” *Id.* at 452, fn 13. It thus remained unclear whether § 271(f) applies to method patents.

CARDIAC PACEMAKERS’ INTERPRETATION OF THE STATUTE

Cardiac Pacemakers provided the Federal Circuit an opportunity to address the issue of whether § 271(f) applies to method patents. The case concerned a patented method for heart stimulation using an implantable heart stimulator, which includes the steps of determining a heart condition, selecting cardioversion as the appropriate therapy, and executing a cardioverting shock. St. Jude sold implantable cardioverter defibrillators (“ICDs”) that were allegedly capable of practicing Cardiac’s patented method. Relying on *Union Carbide*, the district court found that § 271(f) applied to method claims, and that St. Jude’s shipment of ICDs abroad could result in patent infringement under the statute. On appeal, a three-judge panel at the Federal Circuit affirmed the district court’s decision.

Rehearing the § 271(f) issue en banc, the Federal Circuit in an 11-1 decision overruled *Union Carbide* and held that § 271(f) does not apply to method claims.

In reaching its conclusion, the court rejected Cardiac’s definition of “component” in the statute which would encompass “the apparatus that performed the process.” *Id.* at

25. Rather, the court found that a “component” of a product, device, or apparatus is a tangible part of the product, device, or apparatus, whereas a “component” of a method or process is a step in that method or process, which is intangible. *Id.* at 23-25. The court found support for such interpretation in 35 U.S.C. § 271(c), which contrasts “a component of a patented machine, manufacture, combination, or composition” with a “material or apparatus for use in practicing a patented process.” *Id.* at 25-26.

The court further noted that § 271(f) requires that components of the patented invention be “supplied.” Because the ordinary meaning of “supply” implies the transfer of a physical object, and supplying an intangible step is a “physical impossibility,” the court concluded that the steps of a method claim cannot be “supplied” as required by § 271(f). *Id.* at 26.

The court found its interpretation of the statute to be consistent with the legislative history of § 271(f), which was “almost completely devoid of any reference to the protection of method patents.” *Id.* at 27. The court further noted that the Supreme Court in *Microsoft* “took a narrow view of § 271(f) by stating that presumption against extraterritoriality still applies to § 271(f), even though that section specifically extends the reach of U.S. patent law in a limited manner.” *Id.* at 28-29. The court concluded that the presumption of extraterritoriality “compel[led]” the court

not to extend the reach of § 271(f) to method patents. *Id.* at 29.

BUSINESS IMPLICATIONS OF CARDIAC PACEMAKERS

Cardiac Pacemakers makes it clear that U.S. companies that ship goods overseas for practicing a method covered by a U.S. patent cannot be held liable for infringing the method patent. The court’s ruling has profound implications for companies conducting business in the U.S. and overseas.

Over the years, particularly in the wake of economic recession, it has become a common business arrangement for U.S. companies to export materials to China and other offshore locations where research, development, and manufacturing processes take place. This is evidenced by the booming CROs in the biotech/pharmaceutical industry in China. Over the years, China has become one of the most attractive destinations for pharmaceutical outsourcing for various reasons such as large patient pools, low cost, relatively relaxed regulatory requirements, and rich expertise and infrastructure. *Cardiac Pacemakers* makes it clear that offshore CROs conducting activities that would have been infringing upon a method claim if performed in the United States would not expose U.S. companies outsourcing the activities to patent infringement liabilities under § 271(f). It is thus foreseeable that U.S. companies would be more willing to outsource their research, development, and manufacturing processes to China. ■

被视为第271(f)条项下的‘专利发明’”（同上第452页，第13号注释）。因此仍不确定第271(f)条是否适用于方法专利。

CARDIAC PACEMAKERS案 对法规的解释

*Cardiac Pacemakers*案为联邦巡回上诉法院提供了解决第271(f)条是否适用于方法专利这一问题的机会。该案涉及一项利用植入式心脏刺激器进行心脏起搏的专利方法，其步骤包括确定心脏状况、选择电复律作为适用疗法并执行复律电击。St. Jude出售植入式心脏复律除颤器（ICD），依其申述ICD能实施Cardiac的专利方法。根据*Union Carbide*案，地区法院认定第271(f)条适用于方法专利的权利要求，且St. Jude向国外运输ICD将导致该法条项下的专利侵权行为。上诉时，联邦巡回上诉法院的由三名法官组成的审判庭维持地区法院的判决。

在以全院合议庭的方式复审有关第271(f)条的问题时，联邦巡回上诉法院以十一对一的判决推翻了*Union Carbide*案的判决，并判定第271(f)条不适用于方法专利。

在做出其结论时，法院驳回了Cardiac对法条中“构件”所做的释义，根据该释义，“构件”包括“实施方法的设备”

（同上第25页）。与该释义相反，法院认定某项产品、设备或仪器的“构件”是该产品、设备或仪器的有形组成部分，而方法或程序的“构件”是该方法或程序的一个步骤，是无形的（同上第23-25页）。法院在《美国法典》第35篇第271(c)条中为上述解释找到了法律支持，第271(c)条将“专利机械、产品、组合物或合成物的构件”与“实施一项专利方法时使用的材料或仪器”进行了对比（同上第25-26页）。

法院进一步做出注解，认为第271(f)条规定应当“供应”专利发明的构件。由于“供应”的通常含义暗含移交某项有形物品，而供应无形的步骤则是“物理上不可行”的事情，因此法院认定一项方法的权利要求的步骤不能根据第271(f)条予以“供应”（同上第26页）。

法院认定其对该法条所做解释与第271(f)条的立法历史记录一致，立法历史记录“几乎没有提及对方法专利的保护”（同上第27页）。法院进一步做出注解，认为最高法院在*Microsoft*案中“通过声明针对治外法权的无效假定仍适用于第271(f)条（即使该条规定以有限的方式明确超出了美国专利法的管辖范围）而对第271(f)条做出了狭义的解释”（同上第

28-29页）。法院认定对治外法权的无效假定“迫使”法院没有将第271(f)条的管辖权延伸至方法专利（同上第29页）。

CARDIAC PACEMAKERS案 的商业意义

*Cardiac Pacemakers*案明确表明，对于向海外运输货物以实施美国专利包含的方法的美国公司，不应判定其承担侵犯该方法专利的责任。法院的判决对于在美国及海外开展业务的公司来说有着深刻的意义。

在过去几年，尤其是在经济衰退之后，美国公司向中国及其他海外地区出口材料并在这些地方开展研发和生产已成为一种常见的商业做法，在中国大量涌现生物技术/制药行业的合同研究组织即为证明。过去的几年里，中国已成为制药外包最有吸引力的目的地，个中理由众多，如病患资料多、成本低、相对较为宽松的管理要求以及充足的技术和基础设施等。*Cardiac Pacemakers*案明确表明，海外合同组织开展那些在美国进行可能会侵犯方法专利的活动不会使外包这些活动的美国公司承担第271(f)条项下的侵权责任。因此，可以预见的是美国公司会更愿意将其研发和制造流程外包给中国公司。■

Supreme People's Court Seeks to Harmonize Chinese Patent Litigation

By Michael Vella and Harris Gao

On June 18, 2009, the Supreme People's Court released for public comment its draft Interpretation of Several Legal Issues Regarding the Handling of Patent Infringement Cases (the "Interpretation"). When finalized, the Interpretation (consisting of 25 articles) will be the first national-level judicial interpretation regarding the handling of the common issues arising in Chinese patent litigation. The intent of the Interpretation is to harmonize the application of patent law and procedure among the Chinese courts. This article briefly summarizes some of the more significant articles in the Interpretation.

CLAIM CONSTRUCTION

Articles 1-5 of the Interpretation clarify the court's role in ascertaining the scope of the patent claims. The scope of patent protection is to be determined with reference to the understanding of the claims by persons of ordinary skill in the art after reading the specification and drawings. Where the claim meaning understood by a person of ordinary skill differs from the literal claim language,

The intent of the Interpretation is to harmonize the application of patent law and procedure among the Chinese courts.

the understanding of the person of ordinary skill shall govern.

Similar to the law in the United States, the intrinsic evidence governs claim construction. To interpret the claims, the court must refer to the disclosure in the patent's specification, drawings, other claims, and file history. Definitions of terms of phrases provided in the specification shall govern the construction of those terms and phrases. Only if the claim scope cannot be ascertained from the intrinsic evidence may the court consider extrinsic evidence including technical literature and the understanding of persons of ordinary skill in the art.

Where a patentee asserts that its claim scope covers technical features equivalent to those defined in the claims, the court shall determine the proper scope of equivalents. The "equivalent technical features" are those that perform basically the same function, in the same way to achieve the same result, and that, at the time of infringement, can be conceived by persons of ordinary skill without further innovation.

Where a claim is expressed in terms of functions or effects, the court shall determine the content of the technical features based on the specific implementation disclosed in the specification and drawings, including equivalents.

UNCLAIMED ELEMENTS

Article 6 provides that any technical solution disclosed in the claims or specification but not recited in the claims shall not be included in the claim scope.

PROSECUTION HISTORY ESTOPPEL

Article 7 expressly endorses the principal of prosecution history

最高人民法院试图协调中国的专利诉讼

作者：魏迈克、高焕勇

2009年6月18日，最高人民法院发布了《最高人民法院关于审理侵犯专利权纠纷案件应用法律若干问题的解释（“解释”）（征求意见稿）》，向社会公开征求意见。一旦定稿，解释（共计25条）将成为对处理中国专利诉讼中的常见问题首次作出的国家级司法解释。制定解释的目的是为了在中国各法院之间对专利法及诉讼程序的应用进行协调。本文简要概述了解释中的一些较为重要的条款。

权利要求的解释

解释的第1-5条阐述了法院在确定专利权利要求的范围时的职责。专利权的保护范围应参考本领域普通技术人员阅读说明书及附图后对权利要求的理解予以确定。本领域普通技术人员理解的权利要求的含义与权利要求的字面含义不同的，以该普通技术人员理解的权利要求的含义确定专利权的保护范围。与美国法律类似，权利要求的解释应以内部证据为准。

制定解释的目的是为了在中国各法院之间对专利法及诉讼程序的应用进行协调。

法院必须参照在专利说明书、附图、其他权利要求及专利审查档案中披露的内容解释权利要求。专利说明书中对相关用语和措辞做出的界定应用来解释该等用语和措辞。只有在无法根据内部证据确定权利要求范围的情况下，法院方可考量外部证据，包括技术文献和本领域普通技术人员理解的通常含义。

专利权人主张权利要求范围包括与权利要求中界定的技术特征等同的技术特征的，法院应当确定该等同技术特征的适当范围（注：解释中文原文为“专利权人主张权利保护范围包括等同的技术

特征所界定的范围的，法院应当以该等同的技术特征确定专利权的保护范围”）。上述“等同的技术特征”是指以基本相同的手段实现基本相同的功能并达到基本相同的效果，并且本领域普通技术人员在侵权行为发生时无需创造性劳动即可联想到的特征。

权利要求以功能或者效果表述技术特征的，法院应根据说明书及附图描述的具体实施方式（包括等同的实施方式）确定该技术特征的内容。

在权利要求书中未记载的要素

第6条规定，仅在权利要求或说明书中披露而在权利要求中没有陈述的任何技术方案不应包括在专利权的保护范围中（注：解释中文原文为“仅在说明书或附图中描述而在权利要求书中未记载的技术方案不应包括在专利权的保护范围中”）。

禁止反悔原则

第7条明确认可禁止反悔原则，即使专利法中没有规定

estoppel, even though no such principal is recited in the Patent Law. Specifically, where a patentee has made a narrowing amendment or argument either voluntarily or in response to a patent examiner's request, the court shall not accept any assertion by the patentee that its claim scope covers the broader subject matter abandoned during prosecution. In short, despite the absence of any statutory support, the court should now uniformly recognize both argument-based and amendment-based prosecution history estoppel.

ALL ELEMENTS RULE

Article 8 adopts the All Elements Rule by providing that no technical feature disclosed in the claims shall be ignored in determining infringement. Previously, the Chinese courts were inconsistent in applying the All Elements Rule. Indeed, it was common practice for the courts to apply the "Redundant Elements Rule," which allowed a court to ignore certain claim elements as redundant instead of giving meaning to each claim limitation. See Beijing High Court's Opinion on Several Issues Regarding Patent Infringement Determination, September 2001. The adoption of the All Elements Rule by implication eliminates the Redundant Elements Rule.

Although the Patent Law does not address the principal of contributory infringement, the Interpretation now provides an explicit legal basis for this principal to be applied consistently in Chinese patent litigation.

CONTRIBUTORY INFRINGEMENT

Although the Patent Law does not address the principal of contributory infringement, the Interpretation now provides an explicit legal basis for this principal to be applied consistently in Chinese patent litigation. Thus, Article 16 provides that where an accused infringer provides an article to a third party knowing that the article can be used by the third party only as raw material, an interim product, a component, or equipment to practice a patented invention, the accused

infringer and the third party shall be jointly liable for the infringement. However, where the direct infringer's practice of the invention is not for business purposes, the accused infringer shall be solely liable.

PRIOR ART AS A DEFENSE

Consistent with the recent Amendment to the Patent Law, Article 17 of the Interpretation provides that an accused infringer may assert the prior art as a defense. Specifically, the defense may be established by showing that the accused technology is the same or equivalent to the technology in the prior art. Notably, this defense is one of non-infringement, not invalidity. Therefore, the comparison made for purposes of this defense is between the prior art and the accused product, not between the prior art and the patent claims.

NO DEFENSE OF PRIOR USER RIGHTS OR ILLEGALLY OBTAINED TECHNOLOGY

The Interpretation also expressly precludes the court from accepting two defenses that previously might have been considered in Chinese patent litigation. First, Article 19 states that the court shall not accept any defense based on prior user rights. Thus, as in the United States, even if a defendant can establish that it independently developed the accused technology before the patent became public

该等原则。特别是，专利权人主动或者应专利审查员的要求对权利要求进行限缩性修改或者陈述，专利权人在诉讼中主张专利权保护范围包括被放弃的标的物的，法院应不予支持。简言之，尽管没有任何法令上的支持，法院当前应一律认可基于陈述和修改内容的禁止反悔原则。

所有要素原则

第8条采纳了所有要素原则，规定在判定是否侵权时不应当省略在权利要求书中记载的任何技术特征。之前，中国法院在适用所有要素原则时存在不统一现象。事实上，法院通常适用“多余指定原则”是，应用该项原则允许法院省略权利要求书中的某些要素，将其视为多余内容，而不必对每一项权利要求的限定作出解释。参见2001年9月北京市高级人民法院《专利侵权判定若干问题的意见（试行）》。采用所有要素原则含蓄地淘汰了多余指定原则。

尽管专利法没有就帮助侵权原则进行说明，但现在解释为拟在中国专利诉讼中统一应用该项原则提供了明确的法律依据。

帮助侵权

尽管专利法没有就帮助侵权原则进行说明，但现在解释为拟在中国专利诉讼中统一应用该项原则提供了明确的法律依据。因此，第16条规定，被控侵权人知道有关产品只能被第三人用于实施获得专利保护的发明的原材料、中间产品、零部件或设备等，仍然将其提供给该第三人，被控侵权人与第三人应就侵权承担连带责任。不过，如该第三人对发明的实

施不是为经营目的，则被控侵权人应独自承担责任。

现有技术抗辩

根据最新修正的专利法，解释的第17条规定，被控侵权人可以主张现有技术抗辩。特别是，该等抗辩可在证明被诉侵权技术特征与一项现有技术的相应技术特征相同或者等同后予以成立。须注意的是，该等抗辩属于与不侵权而不是无效性有关的抗辩。因此，就该等抗辩而言，进行比较的是现有技术与被控产品而不是现有技术与专利权利要求。

不支持以先用权或非法获得的技术进行抗辩

解释还明确规定法院不应支持先前在中国专利诉讼中可能被考量的两种抗辩方式。首先，第19条规定法院不应支持基于先用权进行的任何抗辩。因此，正如在美国一样，即使被告能证明其在专利成为公共知识之前独立开发了被诉侵权技术，这仍不能胜过原告的专利权。排除上述抗辩方式这一规定向中国公司及跨国公司强调了尽早获得专利权的重要性。

The Interpretation also recognizes the possibility of suits for declaratory judgment under limited circumstances.

knowledge, that fact will not prevail over the plaintiff's patent rights. The exclusion of this defense highlights for both Chinese and multinational companies the importance of securing early patent rights.

Second, Article 19 also precludes any defense based on the allegation that the technology or designs of the patent were illegally obtained. In this respect, the Chinese patent litigation process differs from U.S. patent litigation, which permits the defenses of unclean hands and inequitable conduct.

STANDARDS-BASED WAIVER AND ESTOPPEL

Perhaps reflecting the challenges faced by Chinese companies that only recently began participating in the standard-setting organizations, the Interpretation provides specific guidelines for litigation involving patents necessary to implement an

industry standard. Similar to the U.S. law, the Interpretation recognizes a defense to patent infringement where the patentee knowingly fails to disclose the asserted patent during the standard-setting process. In such cases, the court may find that the patentee has authorized the public to practice the patent when the standard is implemented. This defense, however, does not apply if the patent is not necessary to implement the standard.

The Interpretation recognizes that, as part of the standard-setting process, patentees may disclose the terms under which others are licensed to use a patent adopted as an industry standard. The court will therefore entertain cases alleging infringement based on the allegation that the defendant did not comply with the disclosed license terms. However, where the disclosed terms are obviously unreasonable, the court may adjust the license terms in the litigation. Where no license terms are disclosed or the terms are imprecise, the court may resolve the situation if the parties are unable to do so through negotiation.

DAMAGES

In determining damages based on the infringer's profits, the court must limit the damages to the portion of the profit attributable to the use of the patent.

Any profits earned by the infringer due to other factors are excluded from the damages calculation.

Where an infringing product is a component of a final product, the court shall reasonably determine damages based on a variety of factors, such as the value of the component and the function of the component in creating profit for the final product. If the court finds that the value of the final product is mainly attributable to the component, it may award damages based on the profit of the final product.

DECLARATORY JUDGMENT JURISDICTION

The Interpretation also recognizes the possibility of suits for declaratory judgment under limited circumstances. Specifically, the court may accept such suits where a patentee who issues a warning letter to an alleged infringer fails to withdraw its warning letter or file a lawsuit within one month of the date it receives a written request from the alleged infringer demanding that it enforce the patent right.

The Interpretation includes a variety of other provisions, including several provisions regarding the procedure governing the litigation of design patents. For more information, our readers are encouraged to contact the authors. ■

此外，解释认可在有限的情况下就宣判式判决可能提起的诉讼。

其次，第19条还排除了基于专利技术与设计系非法所得的主张提起的任何抗辩。就此而言，中国专利诉讼过程与美国专利诉讼过程不同，后者允许为不干洁之手和不正当行为进行抗辩。

基于标准的弃权 and 禁止反悔

也许为了反映目前才开始加入标准制定组织的中国公司面临的挑战，解释为涉及实施某个行业标准所必需的专利的诉讼特别规定了指导方针。见第20条。与美国法律类似，解释认可针对在专利权人有意未在标准制定过程中披露主张的专利的情况下发生的专利侵权进行的抗辩。在此情况下，法院可以认定专利权人在标准实施时

已授权公众实施其专利。不过，在专利并非为实施标准所必需时这类抗辩将不予适用。

解释认可以下事宜，即作为标准制定过程的一部分，专利权人可以披露许可他人使用被纳入行业标准中的专利的条件。因此，法院将受理基于被告未能遵守披露的许可实施条件而主张侵权的案件。但是，披露的条件明显不合理的，法院可在诉讼中适当调整该等许可条件。未披露许可实施条件或者披露的许可实施条件不明确的，法院可在当事人不能通过协商解决的情况下解决相关问题。

赔偿数额

在根据侵权人所获得的利益确定赔偿数额时，法院必须将损害赔偿仅限于侵犯专利本身所获得的那部分利益。见第21条。在计算赔偿数额时应将侵权人因其他因素获得的任何利益排除在外。

侵权产品系另一成本的零部件的，法院应根据该零部件本身的价值及其在实现成品利润中的作用等多种因素合

理确定赔偿数额。如法院认定成品的价值主要归功于该零部件，其可以按照成品的利润计算赔偿数额。

宣告式判决的管辖权

此外，解释认可在有限的情况下就宣判式判决可能提起的诉讼。特别是，专利权人向涉嫌侵权人发出警告信，但在收到涉嫌侵权人发出的催告专利权人行使专利权的书面催告之日起一个月内既不撤回警告也不提起诉讼的，法院应当受理该案。

解释涵盖多种其他规定，包括与适用于外观设计专利诉讼的诉讼程序有关的若干规定。如您需了解其他信息，请与本文作者联系。■

Can Chinese Companies Transfer Their Patent Cases Out of the Eastern District of Texas?

By Michael Vella and Wang Yan

If a successful Chinese high-tech company is doing business in the United States, that company may one day find itself a defendant in a patent case before the U.S. District Court for the Eastern District of Texas. In recent years, the Eastern District of Texas has become a popular destination for patent holders to file their complaints due to its quick time to trial and its reputation as a venue favorable to plaintiffs. Furthermore, plaintiffs who filed cases in the Eastern District felt confident their case would stay there because the court rarely granted defendants' motions to transfer - even in cases where the only connection to the district was the sale of an accused product that was sold nationwide.

But two recent appellate decisions have changed the legal landscape regarding motions to transfer patent cases in the Eastern District of Texas. The Eastern District's initial opinions following these two appellate decisions suggest that more cases will be transferred from the Eastern District. As discussed below, a Chinese company may be able to transfer the case out of the Eastern District if it can prove the case has more connection with another district court.

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In recent years, the Eastern District of Texas has become a popular destination for patent holders to file their complaints due to its quick time to trial and its reputation as a venue favorable to plaintiffs.

The broad outlines of the governing law on motions to transfer are well established: in assessing a motion to transfer, the court must consider "the convenience of parties and witnesses." 28 U.S.C. § 1404(a). The convenience determination involves both public and private interest factors. Altogether, there are approximately 10 factors that are considered by the court.¹ However, there is no simple recipe prescribing the result if the factors are pointing in different directions. Recently, both

the Fifth Circuit (the appellate court of the Eastern District) and the Federal Circuit (appellate court for patent cases) applied this multiple-factor test in Eastern District cases. Both cases suggest a trend lowering the threshold for transfer.

The first appellate case to significantly influence transfer law in the district was not a patent case, but instead a case relating to a car accident. *In re Volkswagen of America, Inc.*, 545 F.3d 304 (5th Cir. 2008) (en banc). In *Volkswagen*, an accident in Dallas - which is located in the Northern District of Texas - led to a product liability case filed in the Eastern District of Texas. Volkswagen moved to transfer the case to the Northern District, arguing that the vehicle was purchased in Dallas, the accident occurred in Dallas, the witnesses were Dallas residents, and Dallas police and paramedics responded to the accident. *Id.* at 315-16. Volkswagen asserted that no parties, no witnesses, and no sources of proof were located in the Eastern District. *Id.* The trial judge denied transfer, and the case was appealed.

The Fifth Circuit reversed the trial judge's decision, finding several errors

中国公司能否将专利案件移出德州东区法院？

作者：魏迈克、王焱

如果一家成功的中国高科技公司在美国开展业务，该公司某一天可能会发现，自己成了美国德州东区地区法院受理的某个专利案的被告。因为德州东区法院享有审理案件速度快以及偏向专利案原告的名声，该法院近年来成了广受专利权人欢迎的起诉地点。此外，在德州东区法院提起诉讼的原告曾确信他们的案件不会被移出该法院，因为该法院极少批准被告之移送其它法庭的申请——即使案件与德州东区的唯一联系只是被告在该区出售了在全美国范围内普遍销售的被控产品。

但最近做出的两项上诉判决改变了与德州东区法院专利案件移送申请有关的法律图景。上述两项上诉判决做出之后，东区法院提出的初步意见暗示从东区法院移送的案件数量将会增多。如下所述，如果中国公司能证明案件与其它地区法院联系更密切，则该公司有可能将案件转出东区法院。

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因为德州东区法院享有审理案件速度快以及偏向专利案原告的名声，该法院近年来成了广受专利权人欢迎的起诉地点。

关于移送申请的适用法律，要点已比较完善：在评估移送申请时，法院必须考虑“对当事人和证人的便利性。”（《美国法典》第28篇第1404(a)条。）便利性的确定同时涉及公益和私益因素。总的说来，法院考虑的因素大约有十个。¹ 但是，没有任何简单法则说明当这些因素存在冲突时会发生什么结果。最近，第五巡回法

院（东区上诉法院）和联邦巡回法院（专利案件上诉法院）均在东区法院审理的案件中采用了该项多因素评估标准。两个案件均暗示了移送门槛降低的趋势。

将对该地区移送法律产生重大影响的第一个上诉案件并非专利案件，而是一个与汽车事故有关的案件。（“美国大众汽车公司案”，《联邦案例汇编》第3辑第545卷第304页（2008年第五巡回法院）（全院庭审））。“大众汽车案”是关于一起在德州北区达拉斯市发生的事故，受害人在德州东区提起了对大众的产品责任诉讼。大众汽车认为汽车是在达拉斯买的，事故是在达拉斯发生的，证人是达拉斯居民，并且达拉斯警方和医护人员也对事故做出了反应，因此提出将案件移送到北区。

（同上第315-16页。）大众汽车声称没有任何当事人、证人或证据来源位于东区。（同上。）因承审法官拒绝移送，大众汽车遂对案件提起了上诉。

第五巡回法院推翻了承审法

in the district court's reasoning. *Id.* at 316-18. The court held that the district court did not give sufficient importance to the factor of "accessibility and location of sources of proof" when it held that the advances in copying technology and information made the Eastern District as convenient as Dallas. The Fifth Circuit explained that this factor is still relevant despite technological advances. Because all of the documents and physical evidence were in Dallas, that factor favored transfer. *Id.* at 316. As to the cost of attendance for willing witnesses, the court emphasized the importance for the witnesses' convenience. This factor also favored transfer. Finally, the court held that the factor of "having localized interests decided at home" strongly favored transfer, as virtually everything relating to the accident was in Dallas. *Id.* at 317-18. As a result, the court ordered the transfer. *Id.*

It did not take long for a patent infringement defendant to take the issue to the Federal Circuit. In *In re TS Tech USA Corp.*, 551 F.3d 1315 (Fed. Cir. 2008), Lear Corporation sued TS Tech in the Eastern District, alleging that certain automobile headrest assemblies infringed its patent. *Id.* at 1318. Lear asserted that TS Tech sold its products to Honda, which in turn sold its cars throughout the United States, including in the Eastern District. *Id.* TS Tech moved

to transfer to the Southern District of Ohio, arguing that all of the physical and documentary evidence and the witnesses were located in Ohio, in nearby Michigan, or in Canada. *Id.* The district court denied the motion, and TS Tech filed a petition for a writ of mandamus in the Federal Circuit.

The Federal Circuit found that TS Tech had met the standard for a writ and found that the district court had clearly abused its discretion. Applying Fifth Circuit law, the Federal Circuit found several key instances in which the district court's order did not comply with *Volkswagen*.

First, the district court gave too much weight to Lear's choice of venue, finding that the plaintiff's choice is not a distinct factor but instead is simply related to the defendant's burden of proof in seeking transfer. *Id.* at 1320. Second, the district court ignored the Fifth Circuit hundred-mile rule regarding cost of attendance of witnesses. Because all of the key witnesses were more than a hundred miles away in Ohio, Michigan, or Canada, this factor strongly favored transfer. *Id.* Third, the district court erred by not giving enough importance to the factor regarding the relative ease of access to sources of proof. *Id.* at 1320-21. Because the vast majority of the physical and documentary evidence was in Ohio, Michigan, or Canada, the factor favored transfer, even if some electronic documents could be easily

transported. *Id.* at 1321. Fourth, the district court disregarded Fifth Circuit law in analyzing the public interest in having localized decisions decided at home. On the other hand, there were no meaningful connections between the case and the Eastern District - none of the parties had an office in Texas, no witnesses resided in Texas, and no evidence was in Texas. Accordingly, the Federal Circuit granted the writ and ordered transfer to Ohio.

There have been just a few decisions in the Eastern District on motions to transfer in the few months since *TS Tech* issued. Although it is difficult to speculate based on these decisions, the cases suggest trends, and it is clear that *Volkswagen* and *TS Tech* have changed the way transfer motions are decided in the Eastern District.

In *Odom v. Microsoft* Magistrate Judge Love (of Tyler) transferred a case to the District of Oregon, where the plaintiff resided. As to the relative ease of access to the sources of proof, the court held that Texas and Oregon were "equally convenient" venues with respect to electronic information. Nevertheless, the court found that the convenience of the witnesses - almost all of whom were in the Pacific Northwest - favored transfer. *Id.* The court specifically noted that it was "not a case where witnesses are spread out all over the country or the world," suggesting that the outcome might

官的判决，认定地区法院的推理存在若干错误。（同上第316-18页。）第五巡回法院认为，当地区法院认为复制技术和信息的进步使东区和达拉斯一样便利时，它没有充分重视“证据来源的可及性和所在地”因素。第五巡回法院解释说，技术进步并不妨碍该项因素的重要性。因为所有文件和实物证据均在达拉斯，该项因素支持移送案件。（同上第316页。）对于自愿作证者的出庭成本，第五巡回法院强调了法庭地点对证人的便利性。此项因素也支持移送。最后，第五巡回法院认为，由于与事故有关的所有东西实际上均在达拉斯，因此“地方利益地方裁决”因素也有力地支持移送。（同上第317-18页。）结果，第五巡回法院责令移送案件。（同上。）

专利侵权被告将类似问题提交联邦巡回法院需要的时间并不长。在“美国台思技术公司案”（《联邦案例汇编》第3辑第551卷第1315页）（联邦巡回法院，2008年）中，美国李尔公司在东区法院对台思提起诉讼，宣称台思的某些汽车头枕组件侵犯了其专利。（同上，第1318页。）李尔认为台思将其产品出售给了本田，而本

田又在整个美国（包括东区）销售汽车，所以东区法庭是合适的审判庭。（同上。）被告台思则提出将案件移送至俄亥俄州南区法院，其理由是所有实物证据、书面证据及证人均位于俄亥俄州、邻近的密歇根州或加拿大。（同上。）地区法院拒绝了该申请，于是台思向联邦巡回上诉法院提出申请，请求上诉法院下达执行令，责令东区法院同意移送案件。

联邦巡回上诉法院裁定台思符合申请上述执行令的标准，并判定地区法院显然滥用了其裁量权。依据第五巡回法院的相关法律，联邦巡回法院裁定地区法院的命令在若干主要方面与“大众汽车案”之判决不符。

首先，地区法院过多考虑了李尔的诉讼地选择，并裁定在寻求移案方面，原告的选择并非特殊因素，而仅仅与被告的举证责任相关。（同上，第1320页。）其次，地区法院忽视了第五巡回上诉法院有关证人出庭成本的100英里规则。所有关键证人均位于100多英里以外的俄亥俄州、密歇根州或加拿大，这一因素为移送案件提供了有力支持。（同上。）第三，地区法院错误地忽略了与证

据来源取得的相对容易性相关的因素，没有给予充分的重视。（同上，第1320-1321页。）尽管有些电子文件的传送甚为便利，但绝大多数实物证据及书面证据均位于俄亥俄州、密歇根州或加拿大，这一因素亦为移送案件提供了有力支持。（同上，第1321页。）第四，地区法院对地方利益地方裁决所涉公共利益进行分析时，忽视了第五巡回法院的相关法律。此外，该案与东区法院并无任何有意义的联系——当事人均未在德州设立办事处，无任何证人在德州居住，也无任何证据源自德州。因此，联邦巡回上诉法院准予下达执行令，并责令将案件移送至俄亥俄州。

在台思一案判决后短短几个月内，东区法院只有少数判决涉及移案申请。尽管很难根据这些判决对长期影响进行推测，但该等案件仍然暗示着某些趋势，并且，“大众汽车案”和“台思案”显然已经改变了东区法院裁定移案申请的方式。

在“Odom对微软案”中，初级法院法官Love（泰勒分区）将一个案件移送至原告居住所在地俄勒冈州的地区法院。就证据来源取得的相对容易性而言，法院认为德

While these three cases offer only a limited perspective, the cases suggest several potentially important changes in Eastern District transfer practice.

have been different if that had been the case. *Id.* at 8. The court found most of the other factors neutral.

In *PartsRiver v. Shopzilla* Judge Folsom granted a motion to transfer the case to the Northern District of California. The court noted the “regional nature” of the case and found that California would clearly be more convenient for the parties and the potential witnesses. The court also found “that the overall nature of this case, considering all of the involved parties, is regional and would therefore be more conveniently handled by the Northern District of California.” *Id.*

In *Novartis v. Hoffman-La Roche, et al.*, Judge Folsom denied transfer in a case where the parties were distributed across the country. The court explained, “Plaintiff points out that the relevant proof in this case is spread throughout the nation — as

[the accused product] was developed in North Carolina, was approved by the FDA in Washington D.C., is presently manufactured in Colorado and Michigan (and Switzerland), and is sold throughout the United States.” *Id.* at 4. Moreover, the plaintiff was located in California, and the defendants were located in Colorado, North Carolina, and New Jersey. *Id.* at 4-5. The North Carolina defendant had moved to transfer the case there.

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While these three cases offer only a limited perspective, the cases suggest several potentially important changes in Eastern District transfer practice. First, where none of the parties have a connection to the Eastern District and there is another jurisdiction that plainly has a substantial connection to the case or is far more convenient, the case has a high probability of being transferred. Second, where the parties are from multiple geographic regions across the country and no single venue would clearly be more convenient, transfer is less likely. Third, in assessing whether transfer is appropriate, electronic evidence appears to be less significant than physical evidence and the location of the witnesses.

Whether Chinese companies will be able to take advantage of these new case developments to transfer their cases out of the Eastern District will

largely depend on the facts of their particular case. For example, in a single defendant case, where the Chinese company’s U.S. operations and the plaintiff’s headquarters are both located outside of Texas in near proximity to each other, it may be possible to secure transfer by demonstrating the convenience of a nearby jurisdiction to both parties. However, in a multi-defendant case, the analysis will be more complicated. In that case, a transfer may be more difficult, given a transfer would normally make the case more convenient for some defendants while making it more difficult for others. Chinese companies, therefore, should consider the facts of their particular case carefully before filing a motion to transfer in the Eastern District of Texas. ■

¹ Courts balance the following “public” interest factors: (1) the administrative difficulties caused by court congestion; (2) the local interest in adjudicating local disputes; (3) the unfairness of burdening citizens in an unrelated forum with jury duty; and (4) the avoidance of unnecessary problems in conflict of laws. The “private” factors are: (1) the plaintiff’s choice of forum; (2) the convenience of the parties and material witnesses; (3) the place of the alleged wrong; (4) the cost of obtaining the attendance of witnesses and the availability of the compulsory process; (5) the accessibility and location of sources of proof; and (6) the possibility of delay and prejudice if transfer is granted.

尽管这三个案件仅产生了有限的影响，但其暗示了东区法院移案惯例可能发生的几个重要变化。

州和俄勒冈州在电子信息方面属于“同样便利的”审判地。不过，法院裁定证人出庭的便利性这一要素——几乎所有证人都居住于太平洋西北部地区——支持移送案件。（同上。）法院特别指出，即该案并非“一宗其证人分布在全国或世界各地的案件”，暗示如该案证人分布在全国或世界各地，则结果将会有所不同。（同上，第8页。）法院判定其它大多数因素属于中立性质。

在“PartsRiver对Shopzilla案”中，法官Folsom批准了将案件移送到加州北区法院的申请。法院强调了案件的“地方特征”，裁定加州显然对当事人和可能的证人更加便利。法院还裁定，“考虑所

涉及的全部当事人，本案件的整体特征是地方性的，因此由加州北区法院受理更为方便。”（同上。）

在“诺华公司对霍夫曼·罗氏公司等公司案”中，北卡罗来纳州被告曾提出将案件移送到北卡罗来纳州。法官Folsom拒绝移案，因为该案件的当事人分布在全国各地。法院解释称，“原告指出本案的相关证据分散在全美各地——因为[被控产品]是在北卡罗来纳州开发的，是由华盛顿特区的美国食品药品监督管理局批准的，目前在科罗拉多州和密歇根州（和瑞士）制造，并且在美国全国销售。”（同上第4页）。此外，原告位于加州，而被告位于科罗拉多州、北卡罗来纳州和新泽西州。（同上第4-5页。）

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尽管这三个案件仅产生了有限的影响，但其暗示了东区法院移案惯例可能发生的几个重要变化。首先，如果当事人均与东区法院没有联系，而且存在很明显与案件有实质联系或者更加方便的其它司法管辖区，则案件被移送的可能性就很大。第二，如果当事人来自全国多个不同地区，而且对案件

而言没有哪个审判地是明显更加便利的，则移案的可能性就很小。第三，在评估是否适合移案时，与实物证据和证人所在地相比，电子证据似乎不那么重要。

中国公司是否能利用这些新的案件进展情况将其案件移出东区法院很大程度上取决于其具体案情。例如，在仅有一个被告的案件中，如果中国公司的美国运营地和原告的总部位置彼此临近，但均不位于德克萨斯州，则可以通过证明附近司法管辖区对双方均方便的方式实现移案。但是在有多个被告的案件中，进行分析可能就更复杂了。在该等案件中，移案可能更加困难，因为移案通常会在使案件对某些被告更加方便的同时，对其他被告造成更多麻烦。因此，中国公司在向德州东区法院提交移案申请前，应认真考虑其具体的案情。■

¹ 法院会权衡下列“公共”利益因素：(1) 法院案件堵塞造成的管理困难；(2) 地方争议裁定过程中的地方利益；(3) 使无关诉讼地的公民承担陪审义务的不公平性；以及(4) 避免不必要的法律冲突问题。

“私人”因素包括：(1) 原告的诉讼地选择；(2) 对当事人和重要证人的便利性；(3) 涉嫌侵权行为的地域；(4) 使证人出庭的成本以及强制程序的可行性；(5) 证据来源的可及性和所在地；以及(6) 批准移送后发生延误和歧视的可能性。

Intellectual Property Practice News

RECENT AWARDS & ACCOLADES

MoFo's Patent Litigation practice was ranked as the 7th most active practice in IP Law & Business's 2009 survey of new engagements in U.S. district court patent cases filed last year. The practice jumped from the 11th spot in the 2007 survey. The survey also ranked the firm as the 3rd most active representing defendants for the same time period. For this survey, the publication counted cases that were filed in U.S. federal district courts in 2008 and were active as of February 1, 2009.

MORRISON & FOERSTER WINS SUMMARY JUDGMENT FOR AMEC

Morrison & Foerster obtained a summary judgment for its client AMEC that the employment agreements at the center of a trade secrets dispute between AMEC and its rival, Applied Materials

Inc. ("Applied"), are invalid and constitute unfair competition under California law.

Applied sued AMEC in October 2007 after several of Applied's former employees went to work for AMEC. The suit claims the former employees filed patent applications in China, Japan and the U.S. that disclosed Applied's trade secrets to the public and violated the employment agreements.

Under the Applied employment agreement, it was assumed that any patent application a former Applied employee filed within a year of leaving the company relates to an invention he or she created during his time with the company, and the application was deemed assigned to Applied.

AMEC argued that the agreements constituted unenforceable non-compete agreements under California

law because they restricted employee mobility, requiring former Applied employees to sign over inventions even if they resulted from independent research. In his May 20 ruling, Judge Ware sided with AMEC, finding that the agreements were unenforceable and constituted unfair competition under California law.

Harold McElhinny, a partner with Morrison & Foerster and lead attorney for AMEC, said it was common for employers in California to attempt to circumvent the state's restrictions on noncompete agreements by putting provisions in their employment agreements similar to Applied's IP restriction, and that "it is really important" for the courts to strike down these provisions. Gerald Yin, AMEC's chief executive officer, said the decision marked a victory for innovators, entrepreneurs, and all high-tech workers in California. ■

If you have questions or would like to discuss any of the articles contained in this issue of Morrison & Foerster's China IP Newsletter, please feel free to contact any of the following authors:

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知识产权业务新闻

最近取得的奖项和荣誉

对于去年在美国地区法院提起的专利案件，美国《知识产权法律与业务》(IP Law & Business)杂志于2009年对新近受聘处理该等案件的情况进行了调查。调查结果显示，在专利诉讼业务最活跃的律师事务所排名中，美富名列第7，比2007年调查中的第11位上升了4位。在同期最活跃的被告代理律师事务所中，本所在该项调查中排名第3。为进行调查，《知识产权法律与业务》杂志统计了于2008年在美国联邦地区法院提起并且截至2009年2月1日尚未结案的案件。

诉讼记录摘要

美富赢得有利于中微半导体设备有限公司的简易判决

美富为客户中微半导体设备

有限公司(“中微”)赢得了简易判决，判定中微与其竞争对手应用材料公司(“应用材料”)的商业秘密争议之核心中的雇用协议无效，并构成加州法律项下的不正当竞争行为。

2007年10月，应用材料在其若干前任雇员离职后赴中微工作向中微提起诉讼。诉讼称前任雇员在中国、日本和美国提交了专利申请，从而将应用材料的商业秘密公之于众并且违反了雇用协议。

根据应用材料雇用协议的规定，如应用材料的前任雇员在离开公司后一年内提交的任何专利申请与其在为该公司工作期间完成的发明相关，则该申请被视为转让给应用材料。

中微认为上述协议构成加州

法律下的不可执行的竞业禁止协议。该等协议要求应用材料的前任雇员即使发明系因其独立研究所得也要移交发明，从而限制了雇员的流动性。法官Ware在其于5月20日所做判决中同意中微的抗辩，判决协议不可执行并构成加州法律项下的不正当竞争行为。

美富合伙人Harold McElhinny是中微案的主导律师，他表示，雇用单位经常在加州为规避加州对竞业禁止协议的限制而在其雇用协议中设定与应用材料雇用协议类似的条款，法院能明确宣布这些条款不合法“确实很重要”。中微的首席执行官尹志尧表示，本次判决是加州的发明人、创业者和所有高新技术工作人员的胜利。■

欲了解更多信息，请与以下人员联系：

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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 J. David Harvey at dharvey@mofoco.com (East Coast, U.S.), Michael Zwerin at mzwerin@mofoco.com (West Coast, U.S.) or Priscilla Chen at priscillachen@mofoco.com (China).



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