



二零一八年六月三十日

100745
中国北京市东城区东交民巷 27 号
中华人民共和国最高人民法院
知识产权审判庭（专利授权确权司法解释）
宋晓明 庭长

电子邮件信箱: spcpatent@163.com

主题: 《最高人民法院关于审理专利授权确权行政案件若干问题的规定
(一)》(公开征求意见稿) 反馈意见

尊敬的宋庭长您好:

美国知识产权所有人协会(下称“IPO 协会”)盛赞最高人民法院为澄清知识产权法律原则所作的努力,并感谢对 2018 年 6 月 1 日发布的《最高人民法院
关于审理专利授权确权行政案件若干问题的规定(一)》(公开征求意见稿)(下称“《规定》”)提交意见的机会。

IPO 协会是一家代表各行业、各技术领域内拥有知识产权或相关权益的公司和个人的国际性行业协会。它拥有大约两百家会员以及超过一万两千多名个人会员。这些个人会员有些从属于公司会员或律所成员,有些是发明人、作者或律师会员。IPO 协会的会员遍及三十多个国家。

IPO 协会提倡有效和实惠的知识产权,为会员提供广泛的服务,包括支持会员在立法和国际事务中的利益、分析当前知识产权问题、提供教育和信息服务、以及向公众传播知识产权的重要性。

IPO 协会对《规定》的反馈意见如下:

第三条

《规定》第三条第一款规定:

“人民法院审理专利授权行政案件,一般应当以本领域技术人员所理解的通常含义界定权利要求的用语。权利要求采用自定义词且说明书及附图有明确定义或者说明的,从其界定。”

President
Henry Hadad
Bristol-Myers Squibb Co.
Vice President
Daniel J. Staudt
Siemens
Treasurer
Karen Cochran
Shell International B.V.

Directors
Brett Alten
Hewlett Packard Enterprise
Ronald A. Antush
Nokia USA Inc.
Estelle Bakun
Exxon Mobil Corp.
Scott Barker
Micron Technology, Inc.
Edward Blocker
Koninklijke Philips N.V.
Amelia Buharin
Intellectual Ventures
Management, LLC
John Cheek
Tenneco Inc.
John Conway
Sanofi
William J. Coughlin
Ford Global Technologies LLC
Robert DeBerardine
Johnson & Johnson
Buckmaster de Wolf
General Electric Co.
Anthony DiBartolomeo
SAP AG
Daniel Enebo
Cargill, Incorporated
Louis Foreman
Enventys
Scott M. Frank
AT&T
Darryl P. Frickey
Dow Chemical Co.
Gary C. Ganzi
Evoqua Water
Technologies LLC
Tanuja Garde
Raytheon Co.
Krish Gupta
Dell Technologies
Heath Hognlund
Dolby Laboratories
Thomas R. Kingsbury
Bridgestone Americas
Holding Co.
William Krovatin
Merck & Co., Inc.
Michael C. Lee
Google Inc.
Peter Lee
Thermo Fisher Scientific
Elizabeth Ann Lester
Equifax Inc.
Thomas P. McBride
Monsanto Co.
Steven W. Miller
Procter & Gamble Co.
Kelsey Milman
Caterpillar Inc.
Micky Minhas
Microsoft Corp.
Lorie Ann Morgan
Gilead Sciences, Inc.
Ted Naccarella
InterDigital Holdings, Inc.
Douglas K. Norman
Eli Lilly and Co.
Dana Rao
Adobe Systems Inc.
Kevin Rhodes
3M Innovative Properties Co.
Paik Saber
Medtronic, Inc.
Matthew Sarboraria
Oracle Corp.
Manny Schecter
IBM, Corp.
Jessica Sinnott
DuPont
Thomas Smith
GlaxoSmithKline
Todd N. Spalding
Alexion Pharmaceuticals
Brian R. Suffredini
United Technologies, Corp.
James J. Trussell
BP America, Inc.
BJ Watrous
Apple Inc.
Stuart Watt
Amgen, Inc.
Mike Young
Roche Inc.
General Counsel
Michael D. Nolan
Milbank Tweed
Executive Director
Mark W. Lauroesch

IPO 协会谨建议，在专利授权行政案件中，专利审查档案也可以用来帮助解释权利要求中的术语含义。专利审查档案常常包括专利申请人关于如何解释权利要求的表述。为了法院审理的连贯性和一致性，第三条第一款应与第二款一致，表明法院可以参考专利审查档案用于解释权利要求。

#### 第四条

《规定》第四条允许法院在确定权利要求用语的含义时参考专利权人在专利侵权诉讼程序中对权利要求内容的陈述。IPO 协会谨建议，确定权利要求用语的含义时，的确应考虑专利权人所作出相关的陈述，但应该包括(但不限于)专利侵权以及无效诉讼。也就是说，没有理由仅限于参考相应的专利侵权诉讼程序中的陈述。此外，也应考虑其他诉讼方在侵权和其他诉讼程序中作出的陈述。除专利权人以外的其他诉讼方提供的陈述也可能对确定权利要求用语的含义有帮助。

#### 第六条

《规定》第六条提出，有证据证明专利申请人、专利权人违反诚实信用原则，恶意伪造、变造说明书及附图中的具体实施方式、数据、图表等有关技术内容，当事人据此主张说明书不符合专利法第二十六条第三款的规定，相关权利要求应当宣告无效的，人民法院应予支持。

IPO 协会谨建议，在这种情况下，与其直接宣告相关权利要求无效，不如将相关专利权利要求视为不可对第三方执行。通过这种方式，原始的但不可执行的专利权利要求以及相应的公开(包括改动过的申请说明书公布)仍然能作为现有技术的一部分，而该现有技术在以后有需要的时候可以基于例如未能提供充分公开而被挑战无效。

#### 第七条

《规定》第七条规定：

“说明书、附图未充分公开特定的技术内容，导致本领域技术人员不能实施权利要求限定的技术方案，或者经过有限的试验仍不能确认权利要求限定的技术方案能够解决专利所要解决的技术问题的，…”

IPO 协会谨建议将“经过有限的试验”改为“经过非过度的劳动”，以提供更大的清晰度，避免对具有专利性的主题的不必要拒绝或宣告无效。

#### 第九条

《规定》第九条规定：

“本领域技术人员阅读说明书及附图后，不能直接得到或者合理概括得出权利要求限定的技术方案的，人民法院应当认定该权利要求不符合专利法第二十六条第四款关于权利要求书以说明书为依据的规定。

本领域技术人员阅读说明书及附图后，无法合理预见权利要求所涵盖的所有实施方式均能够解决说明书记载的所要解决的技术问题的，人民法院应当认定属于前款所称的不能合理概括得出。”

IPO 协会谨建议将第二款与第一款合并以使本条款更紧凑，即在第一款的“本领域技术人员阅读说明书及附图后，不能直接得到或者合理概括得出权利要求限定的技术方案的”之后加上“，以及无法合理预见权利要求所涵盖的实施方式能够解决说明书记载的所要解决的技术问题的”，并且删除第二款。

## 第十条

《规定》第十条规定：

“说明书记载的部分具体实施方式不能解决专利所要解决的技术问题，但本领域技术人员阅读说明书及附图后，在申请日无需经过过度劳动即可合理预见权利要求涵盖的其他所有具体实施方式均能够解决专利所要解决的技术问题，并达到相同的技术效果，当事人据此主张该权利要求符合专利法第二十六条第四款关于权利要求书以说明书为依据的规定的，人民法院一般应予支持。”

IPO 协会谨建议将“其他所有具体实施方式均能够解决”改为“其他具体实施方式能够解决”。

## 第十三条

《规定》第十三条对接受审查申请日后提交的补充实验数据用于以下两种目的规定了不同的标准，即第一款中的用于进一步证明说明书记载的技术效果已经被充分公开和第二款中用于证明与对比文件不同的技术效果。为确保一致性，IPO 协会谨建议将第十三条的第一二款合并如下段所述。另外，应该澄清“化学发明专利”也包括生物发明专利。此外，如下建议更改所示，补充实验数据也应可用于证明技术方案。

“化学及生物发明专利申请人、专利权人在申请日以后提交实验数据，用于进一步证明说明书记载的技术方案或技术效果已经被充分公开，或用于证明专利申请或专利具有与对比文件不同的技术方案或技术效果，且该技术方案或技术效果是本领域技术人员在申请日根据说明书、附图以及公知常识能够确认的，人民法院一般应予审查。”

## 第十九条

《规定》第十九条规定：

“说明书、附图未明确记载区分技术特征所产生的技术效果的，可以结合本领域的公知常识、区别技术特征与其他技术特征的关系、区别技术特征在专利技术方案中的作用等认定。”

IPO 协会谨建议，专利审查档案也可与说明书和附图一样作为参考。专利申请人在专利审查文件档案中的陈述也可能为专利审查员理解和确定本专利技术效果并区分现有技术提供指导。

## 第二十条

《规定》第二十条第一款规定：

“对于权利要求实际解决的技术问题，现有技术整体上给出技术启示的，人民法院应当认定该权利要求不符合专利法第二十二条第三款的规定。”

第二十条进一步部分规定：

“有以下情形之一的，人民法院可以认定存在前款所称的技术启示：

……

（二）区别技术特征属于本领域的公知常识的，但有相反证据证明本领域技术人员不容易想到将该公知常识应用于最接近的现有技术的除外；

…… ”

为了避免以“本领域的公知常识”为由不合理地拒绝专利权利要求，也为了向公众提供更大的透明度，IPO 协会谨建议，第二十条应进一步要求提供证据以表明区别技术特征已经是本领域公知常识。这一要求也与第三十七条要求的提交证据证明属公知常识相符。另外，IPO 协会谨建议在第一款中的“现有技术整体上给出技术启示”之后加上“并可合理预见成功”。

## 第二十九条

《规定》第二十九条第二款规定：

“无效宣告请求人提交的证据能够证明存在专利法第二十三条第三款规定的权利冲突的情形，专利权人以其并非在先合法权利人或者利害关系人为由，主张其无权提出无效宣告请求的，人民法院不予支持。”

第二十九条第二款之方案二则为：

“无效宣告请求人提交的证据不能证明其系专利法第二十三条第三款规定的在先合法权利人或者利害关系人，专利权人据此主张其无权提出无效宣告请求的，人民法院应予支持。”

IPO 协会谨此推荐第二款的原始方案而非方案二。第三方根据在先合法权利而对设计专利提出的无效宣告请求不应当只限制于基于属于自己的合法权利。

### 第三十五条

《规定》第三十五条规定：

“专利复审委员会的决定认定事实或者适用法律存在错误，但对专利权效力的认定结论正确的，人民法院可以根据行政诉讼法第六十九条的规定判决驳回原告的诉讼请求，但不撤销决定。”

IPO 协会谨建议在此条中加上“人民法院应指出专利复审委员会的错误所在”，这样可以避免将来再次发生同样的错误。

### 对《规定》的非特定条款的总体建议

根据我们的理解，《规定》旨在建立一套统一、一致、透明的指导方针来评估发明相对于现有技术的进步。因此，IPO 协会谨建议，用与拒绝或无效权利请求的“公知常识”一定需要足够的证据证明它属于本领域普通技术人员的常识。

IPO 协会再次感谢贵院给予此次机会提出反馈意见。我们也非常愿意与贵院进一步交流或能有机会为贵院提供更多的信息。

此致

美国知识产权所有人协会谨启



Mark Lauroesch 马克·劳勒施  
执行理事



30 June 2018

Intellectual Property Tribunal  
Supreme People's Court  
27 Jiaomin Alley  
Dongcheng District  
Beijing, P.R.China

VIA EMAIL: [spcpatent@163.com](mailto:spcpatent@163.com)

**Re: *Supreme People's Court Provisions on Several Issues Concerning the Trial of Administrative Cases Involving the Granting and Affirmation of Patent Right***

Dear Honorable Justice Song:

We appreciate the opportunity to provide comments with respect to the Supreme People's Court Provisions on Several Issues Concerning the Trial of Administrative Cases Involving the Granting and Affirmation of Patent Right posted for public comment on 1 June 2018 (hereinafter referred to as the "Provisions"). IPO commends the Supreme People's Court for its efforts in clarifying principles of intellectual property law in the People's Republic of China.

By way of background, IPO is an international trade association representing companies and individuals in all industries and fields of technology who own, or are interested in, intellectual property rights. IPO's membership includes about 200 companies and more than 12,000 individuals who are involved in the association either through their companies or as inventor, author, law firm, or attorney members. IPO membership spans over 30 countries.

IPO advocates for effective and affordable IP ownership rights and offers a wide array of services, including supporting member interests relating to legislative and international issues; analyzing current IP issues; providing information and educational services; and disseminating information to the public on the importance of IP rights.

In the following paragraphs, we provide comments with respect to various Articles in the Provisions.

**Article 3**

First, Article 3, 1<sup>st</sup> Paragraph, states that:

When a People's Court tries an administrative case involving the granting of a patent right, the term of the claim shall

1501 M Street, NW, Suite 1150 • Washington, DC 20005  
T: 202-507-4500 • F: 202-507-4501 • E: [info@ipo.org](mailto:info@ipo.org) • W: [www.ipo.org](http://www.ipo.org)

President  
**Henry Hadad**  
Bristol-Myers Squibb Co.

Vice President  
**Daniel J. Staudt**  
Siemens

Treasurer  
**Karen Cochran**  
Shell International B.V.

Directors  
**Brett Altan**  
Hewlett Packard Enterprise  
**Ronald A. Antush**  
Nokia USA Inc.  
**Estelle Bakun**  
Exxon Mobil Corp.  
**Scott Barker**  
Micron Technology, Inc.  
**Edward Blocker**  
Koninklijke Philips N.V.  
**Amelia Buharin**  
Intellectual Ventures  
Management, LLC  
**John Cheek**  
Tenneco Inc.  
**John Conway**  
Sanofi  
**William J. Coughlin**  
Ford Global Technologies LLC  
**Robert DeBerardine**  
Johnson & Johnson  
**Buckmaster de Wolf**  
General Electric Co.  
**Anthony DiBartolomeo**  
SAP AG  
**Daniel Enebo**  
Cargill, Incorporated  
**Louis Foreman**  
Enventys  
**Scott M. Frank**  
AT&T  
**Darryl P. Frickey**  
Dow Chemical Co.  
**Gary C. Ganzl**  
Evoqua Water  
Technologies LLC  
**Tanuja Garde**  
Raytheon Co.  
**Krish Gupta**  
Dell Technologies  
**Heath Hoglund**  
Dolby Laboratories  
**Thomas R. Kingsbury**  
Bridgestone Americas  
Holding Co.  
**William Krovatin**  
Merck & Co., Inc.  
**Michael C. Lee**  
Google Inc.  
**Peter Lee**  
Thermo Fisher Scientific  
**Elizabeth Ann Lester**  
Equifax Inc..  
**Thomas P. McBride**  
Monsanto Co.  
**Steven W. Miller**  
Procter & Gamble Co.  
**Kelsey Milman**  
Caterpillar Inc.  
**Micky Minhas**  
Microsoft Corp.  
**Lorie Ann Morgan**  
Gilead Sciences, Inc.  
**Ted Naccarella**  
InterDigital Holdings, Inc.  
**Douglas K. Norman**  
Eli Lilly and Co.  
**Dana Rao**  
Adobe Systems Inc.  
**Kevin Rhodes**  
3M Innovative Properties Co.  
**Paik Saber**  
Medtronic, Inc.  
**Matthew Sarboraria**  
Oracle Corp.  
**Manny Schecter**  
IBM, Corp.  
**Jessica Sinnott**  
DuPont  
**Thomas Smith**  
GlaxoSmithKline  
**Todd N. Spalding**  
Alexion Pharmaceuticals  
**Brian R. Suffredini**  
United Technologies, Corp.  
**James J. Trussell**  
BP America, Inc..  
**BJ Watrous**  
Apple Inc.  
**Stuart Watt**  
Amgen, Inc.  
**Mike Young**  
Roche Inc.  
  
General Counsel  
**Michael D. Nolan**  
Milbank Tweed  
  
Executive Director  
**Mark W. Lauroesch**

generally be construed by the ordinary meaning understood by those skilled in the art. Where the claims use a custom term which is clearly defined or described in the description and drawings, the term shall be construed thereupon accordingly.

IPO respectfully suggests the patent examination file wrapper may also be helpful in construing the meaning of terms in the claims in an administrative case involving the granting of a patent right. Often the patent examination file wrapper includes statements by the patent applicant providing greater insight as to how a claim is to be construed. For purposes of consistency and uniformity by all courts, language indicating that courts may consult the patent examination file wrapper should be explicitly included within Article 3, Paragraph 1 in a manner similar to Article 3, Paragraph 2.

#### **Article 4**

In determining the meaning of a claim term, Article 4 of the Provisions permit reference to the patentee's statements in a patent infringement litigation proceeding as to the interpretation of a claim term. IPO respectfully suggests that in construing a claim term statements made by a patentee regarding the claim term should take into account all relevant proceedings including, but not limited to, patent infringement and invalidity proceedings. That is, there is no reason to limit the claim construction inquiry to only statements made in a corresponding patent infringement litigation proceeding. Furthermore, statements made by those other than the patentee in infringement and other proceedings should also be considered in construing patent claim terms. Statements provided by others than the patentee might be helpful in properly construing the claim terms.

#### **Article 6**

Article 6 of the Provisions currently proposes that where there is evidence of forgery or alteration by a patent applicant or patentee of "specific embodiments, data, diagrams, or other technical contents in the description and drawings," the People's Court will affirm a third-party assertion that the description does not conform with Article 26, Paragraph 3 of the Patent Law and the relevant claims shall be declared invalid. Rather than invalidating the relevant claims, IPO respectfully suggests that the relevant patent claims be deemed unenforceable against third parties under those circumstances. In this way, the original but later unenforceable patent claims as well as the corresponding original disclosure (as well as any altered published patent application) remain part of the prior art, but may later be challenged when appropriate, on grounds, for example, of failing to provide an enabling disclosure.

#### **Article 7**

Article 7 of the Provisions states, in part, that:

Where the description and drawings do not sufficiently disclose the particular technical content, resulting in that those skilled in the art cannot carry out the technical solution as defined in the claims, or cannot confirm that the technical solution as defined in the claims can solve the technical problems to be solved by the patent after limited tests.

IPO suggests that the terminology “after limited tests” be changed to “without undue experimentation” to provide both greater clarity and avoid unnecessary rejection or invalidation of patentable subject matter.

### **Article 9**

Article 9 of the Provisions states:

Where after reading the description and drawings, those skilled in the art cannot directly obtain or reasonably generalize the technical solution as defined in the claims, the People's Court shall determine that the claim is not in conformity with the provision under paragraph 4 of Article 26 of the Patent Law that the claims should be supported by the description.

Where after reading the description and drawings, those skilled in the art cannot reasonably predict that all the embodiments covered by the claims can solve the technical problems to be solved as stated in the description, the People's Court shall determine that it belongs to the situation "cannot reasonably generalize" as mentioned in the preceding paragraph.

IPO suggests adding “and, if applicable, cannot reasonably anticipate the technical effect of the technical solutions of the claims” to the first paragraph, immediately after the language that states “those skilled in the art cannot directly obtain or reasonably generalize the technical solution as defined in the claims,” and as a result, remove the second paragraph, to make Article 9 more cohesive.

### **Article 10**

Article 10 of the Provisions states:

Where part of the specific embodiments in the description did not solve the technical problems to be solved by the patents, but after reading the description and drawings, those skilled in the art can reasonably predict, without undue work at the filing date, that all other specific embodiments covered by the claims could solve the



technical problems to be solved by the patent and achieve the same technical effect, if the party accordingly contends that the claim is in conformity with the provision under paragraph 4 of Article 26 the Patent Law that claims should be supported by the description, the People's Court shall generally support it.

IPO suggests removing the word “all” from “all other specific embodiments.”

### **Article 13**

Article 13 of the Provisions sets forth different standards for accepting and reviewing post-filing experimental data for purposes of determining whether the technical effects have been sufficiently disclosed in the description (Article 13, Paragraph 1) or establishing patentability over prior art references (Article 13, Paragraph 2). To ensure consistency, IPO suggests combining the first and second paragraphs of Article 13 as in the paragraph found directly below. Also, it should be clarified that "chemical invention patents" also cover biological invention patents. In addition, technical solutions should be included as an alternative to technical effect as indicated in the suggested changes below:

Where the patent applicant or patentee of chemical or biological invention submits experimental data after the filing date to further demonstrate that the technical solution or technical effect recited in the description has been sufficiently disclosed or to further demonstrate the different technical solution or technical effect of the invention claimed in the patent application or the patent over prior art references, and the technical solution or technical effect of said invention claimed in the patent application or patent can be determined based on the description, drawings and common knowledge by a person skilled in the art on the filing date, the court shall consider such data.

### **Article 19**

Article 19 states in part:

Where the description and drawings do not expressly describe the technical effects brought about by the distinguishing technical feature(s), the technical problem actually solved by the claim can be determined in the light of the common knowledge in the art, the relationship between the distinguishing technical feature(s) and other technical features, and the function of the distinguishing technical features in the claimed technical solution.

IPO respectfully suggests that the patent examination file wrapper may also be consulted along with the “description and drawings.” Statements by the patent applicant in the patent examination file wrapper may provide further guidance to the patent examiner in understanding, construing, and differentiating the technical effects of the invention from the prior art.

### **Article 20**

Under Article 20, Paragraph 1:

Regarding the technical problem actually solved by the claims, if the prior art as a whole provides the technical inspiration, the People’s Court shall determine that the claim does not comply with the provisions of paragraph 3 of Article 22 of the Patent Law.

Article 20 further provides, in part, that the People’s Court can determine there is technical inspiration provided in the prior art if:

(2) The distinguishing technical feature(s) belong to common knowledge in the art, unless there is evidence to the contrary that it is not easy for those skilled in the art to think of applying the common knowledge to the closest prior art.

In order to avoid unwarranted rejection of patentable claims under the guise of “common knowledge in the art” and otherwise to provide greater transparency, it is respectfully suggested that Article 20 further require evidence be presented to support the position that the distinguishing technical feature(s) is (are) already common knowledge in the art. Such amendment would also be consistent with the requirements of proof necessary to establish common knowledge under Article 37.

Also, IPO suggests adding “and success can be reasonably expected” immediately after “if the prior art as a whole provides the technical inspiration.”

### **Article 29**

IPO notes that Article 29 includes a second paragraph that states:

Where the evidence submitted by an Invalidation Petitioner can prove the presence of the instance of conflicting rights as prescribed in Article 23.3 of the Patent Law, if the patentee contends that the Invalidation Petitioner has no right to raise the invalidation request for not being an owner of prior legal right or an interested person, the People’s Court shall not support the patentee’s contention.

Article 29 further provides “Option II” to the second paragraph which states:

[W]here the evidence submitted by an Invalidation Petitioner cannot prove that the Invalidation Petitioner is an owner of prior legal right or an interested person as prescribed in Article 23.3 of the Patent Law, if the patentee accordingly contends that the Invalidation Petitioner has no right to raise the invalidation request, the People's Court shall support the patentee's contention.

IPO prefers the original second paragraph rather than the Option II of the second paragraph for Article 29. A third party should not be limited to relying solely on its own designs when challenging a design patent.

### **Article 35**

Article 35 states:

Where there[ ] [is] an error in the decision of the Patent Reexamination Board in terms of the fact finding or application of laws, but the conclusion of the determination of the validity of the patent right is correct, the People's Court may, in accordance with the provisions of Article 69 of the Administrative Litigation Law, decide to reject the plaintiff's claim but not to revoke the decision.

Regarding Article 35, IPO suggests adding that the People's Court shall describe the particular error, so that the error can be avoided in the future.

### **General Comment**

It is understood that the Provisions are intended to establish a uniform, consistent, and transparent set of guidelines in evaluating the advancement of a claimed invention over the prior art. Accordingly, it is respectfully suggested that the use of "common knowledge" as a basis for rejecting or invalidating a claim always require proof sufficient to establish common knowledge by one of ordinary skill in the art.

Attached please find this letter as translated. We again thank you for permitting IPO to provide comments and would welcome any further dialogue or opportunity to provide additional information.

Sincerely,



Mark Lauroesch 马克·劳勒施  
Executive Director