



二零二零年六月十五日

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

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**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》
(公开征求意见稿) 的反馈意见**

致最高人民法院:

美国知识产权所有人协会(下称“IPO 协会”)感谢中华人民共和国最高人民法院(下称“最高院”)提供了对 2020 年 4 月 28 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》(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。它拥有一百七十五家公司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。

2018 年 6 月 30 日, IPO 协会曾经对最高院于 2018 年 6 月 1 日发布的《规定》征求意见稿提交过反馈意见。我们高兴地看到最高院在这几次征求意见稿中注重了为专利授权确权案件提供清晰的指引,并有助于更加统一的司法判决。

以下是我们对《规定》的具体反馈意见。

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第三条

第三条是关于在专利授权确权行政案件中权利要求中用语的含义。IPO 协会建议在确定用语的含义时，需要专注于内部证据（即：说明书、权利要求和审查档案）进行全面考虑，必要时，可以参考外部证据（即：其他来源的），前提是该等外部证据与内部证据所提供的清楚明确的权利要求含义不相冲突。应当从提交专利申请时的本领域技术人员的角度来解释用语。不应当推定用语的通常含义（例如技术词典中的定义）优先于内部证据，这些内部证据清楚明确的界定或解释了发明人给出用语的含义。因此我们谨建议对第三条做出如下修改以反映上述意见：

人民法院审理专利授权确权行政案件，一般应当以考虑提交专利申请时本领域技术人员所理解，且符合发明目的的通常含义界定权利要求的用语。也应当参考权利要求采用自定义词且说明书及、附图以及专利审查档案中的用语界定和解释。有明确定义或者说明的，~~从其界定。~~

对于前款规定的通常含义，可以结合本领域技术人员通常采用的技术词典、技术手册、工具书、教科书、国家或者行业技术标准等界定，但通常含义不应当优先于说明书、附图及专利审查档案中提供的明确的用语界定和解释。

~~解释权利要求的用语时，可以参考专利审查档案。~~

第四条

建议2018年征求意见稿中的第四条应该重新恢复并扩大其适用范围。2018年征求意见稿中规定：

人民法院在确定权利要求用语的含义时，可以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。

在确定权利要求用语的含义时，先前的第四条允许参考专利权人在专利侵权诉讼程序中做出的关于权利要求用语解释的陈述。IPO 协会谨建议这一条对保证法律规则的实施是必要的，有助于防止法庭上的不实陈述，否则可能会发生一方在另外的程序中做出相反陈述的情形。这一条对于保证国际司法标准的一致性也是必要的。事实上，在其他的司法管辖区，例如美国，在一些案件中进一步判决在其他程序做出的陈述不仅是可接受的，而且对这一方还具有约束力。

IPO 协会进一步建议扩大这一条的适用范围，在解释权利要求用语时，应当考虑专利权人在所有的相关程序中对于权利要求用语做出的陈述，这些程序包括但不限于专利侵权和无效程序。也就是说，没有理由把权利要求的解释限定在相应的专利侵权诉讼程序中所做出的陈述。此外，专利权人以外的其他诉讼方在专利侵权诉讼和其他程序中所做出的陈述在反对这一方对权利要求用语解释采取了不同的立场时也要考虑。当专利权人以外的其他诉讼方试图对权利要求用语采取不一致的立

场时（如：在侵权诉讼程序中和无效程序中），其所做出的陈述可有助于正确的解释权利要求用语。

因此 IPO 协会建议恢复这一条并做出如下修改：

人民法院在确定权利要求用语的含义时，可以参考当事人专利权人在专利侵权诉讼其他程序中对权利要求内容的陈述。

第五条

第五条的规定是当有证据证明专利申请人或专利权人伪造或者变造“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”时，人民法院将支持第三方当事人所主张的说明书不符合专利法第二十六条第三款的规定，并且与此相关的权利要求应当被宣告无效。与其宣告相关权利要求无效，IPO 协会谨建议不如将相关的权利要求在那些情形下视为对第三方当事人不可执行。通过这种方式，原始的但后来不可执行的专利权利要求连同相应的原始公开内容（以及任何改动过的并公开的专利申请）依然是现有技术的一部分，可以在以后有需要的时候依据例如说明书未能充分公开等理由被挑战无效。

另外，我们认为应该提供机制使得人民法院能够获取证据来帮助法院判定说明书中的技术内容是否为“虚构、编造”的。据此，我们建议第十二条所提供的机制（并进行下述建议的修改）也应当适用于法院对本条的情形做出判定时，在第五条中增加如下表述：

当人民法院怀疑或当事人质疑专利说明书中的技术内容是虚构、编造的，人民法院可以参考第十二条要求专利权人提供证据，或人民法院可委托具有相应资质的机构或当事人均认可的第三方，对实验数据进行检测或者验证。

第九条

我们注意到，《规定》的第九条旨在解决一方当事人依据专利文件中出现的相互矛盾的技术内容，主张权利要求限定的技术方案能否解决说明书中记载的技术问题的情形。第九条规定“说明书、附图记载的技术内容相互矛盾……”

我们关注到第九条的上述语句可能被解读为：第九条所述的“相互矛盾的技术内容”仅是指说明书的主题与附图的主题产生相互矛盾的这一类型。我们注意到，第九条进一步规定：“当事人依据该相互矛盾的技术内容主张相关权利要求符合专利法第二十六条第四款规定的‘权利要求书应当以说明书为依据’的，人民法院不予支持。”

专利法第二十六条第四款提到的“书面描述”可能包含了专利文件的说明书和附图。由此可推导出，上述“相互矛盾的技术内容”可能在第二十六条第四款所规定的“书面描述”中的任何地方存在。换句话说，似乎可以恰当地理解：第九条所述的

“相互矛盾的技术内容”可能仅在说明书中存在，仅在附图中存在，或在说明书和附图中都存在。因此，我们谨建议修改第九条，从而与对专利法第二十六条第四款“书面描述”的理解保持一致。具体地，我们对第九条的修改意见如下：

说明书、附图的任何地方书面记载的技术内容相互矛盾，导致本领域技术人员无法确认权利要求限定的技术方案能否解决说明书记载的其所要解决的技术问题，当事人依据该相互矛盾的技术内容主张相关权利要求符合专利法第二十六条第四款规定的“权利要求书应当以说明书为依据”的，人民法院不予支持。

第十二条

第十二条是关于实验数据和人民法院要求专利权人提供支持性证据的机制。当事人质疑实验数据的真实性时，第十二条规定人民法院可以委托具有相应资质的机构或当事人均认可的第三方对实验数据进行检测或验证。

IPO 建议，上述机制不仅应适用于诉讼过程中提交的实验数据，还应当适用于记载在说明书中的实验数据。因此，我们谨建议对第十二条做如下修改：

对于当事人在诉讼过程中提交或记载在说明书中的实验数据，人民法院可以要求其举证证明实验数据的来源和形成过程，包括实验原料及其来源，实验步骤、条件、环境或者参数，以及完成实验的人员、机构等足以影响其真实性、关联性和证明力的因素。

当事人对在诉讼过程中提交或记载在说明书中实验数据的真实性有争议的，人民法院可以依法委托具有相应资质的机构或者当事人均认可的第三方，对实验数据进行检测或者验证。

第十三条


IPO 感谢最高院在第十三条（原 2018 年《规定》讨论稿的第十七条）加入了“在国内外为公众所知的”这一语句，进一步澄清了为公众所知的背景技术在本条上下文中的含义。按照我们的理解，“国内外”指国内或国外，但也有人将“国内外”理解为国内和国外。为避免歧义，IPO 谨建议将“国内外”修改为“国内或国外”，具体修改如下：

说明书记载的背景技术不视为专利法第二十二条第五款所称的现有技术，但有证据证明其在申请日以前在国内或国外为公众所知的除外。

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。

随信附上本信的翻译版本。

此致

A handwritten signature in black ink, appearing to read 'Daniel J. Staudt', with a horizontal line drawn through the middle of the signature.

Daniel J. Staudt

美国知识产权所有人协会主席

附件：IPO 协会对《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》（公开征求意见稿）的反馈意见（英文版）



**Intellectual
Property
Owners
Association**

15 June 2020

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

VIA EMAIL: spcip1@163.com

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

To the Supreme People's Court:

The Intellectual Property Owners Association (IPO) wishes to thank the Supreme People's Court (hereinafter referred to as the "SPC") for the opportunity to respond to the request for comments on the draft "Supreme People's Court Provisions on Several Issues Concerning the Trial of Administrative Cases Involving the Granting and Affirmation of Patent Right" (hereinafter referred to as the "Provisions") published on April 28, 2020.

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 175 companies and close to 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.

On 30 June 2018, IPO submitted its comments on an earlier draft of the Provisions posted by the SPC for comments on 1 June 2018. We are pleased to see the attention being given by the SPC, through these drafts, to providing clarity and facilitating more uniform judicial decisions pertaining to the granting and affirmation of patent rights.

We provide below comments on certain Articles in the Provisions.

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GlaxoSmithKline
John Stewart
Intellectual Ventures
Management, LLC
Gillian Thackray
Thermo Fisher Scientific
Joerg Thomaier
Bayer Intellectual Property GmbH
Mark Wadzyk
Qualcomm, Inc.
Stuart Watt
Amgen, Inc.
Ariana Woods
Capital One

General Counsel
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Article 3

Article 3 refers to terms in the claims in administrative cases of granting and determination of patent rights. IPO submits that determining the meaning of a term requires a comprehensive review focused on the intrinsic evidence (*i.e.*, the specification, claims and prosecution history) and, as necessary, extrinsic evidence (*i.e.*, other sources) provided that such extrinsic evidence is not used to contradict the unambiguous claim meaning provided by the intrinsic evidence. Construction of the term should be taken from the perspective of a person of ordinary skill in the art at the time of filing. There should be no presumption of the ordinary meaning (e.g., as defined in a dictionary definition) over the unambiguous intrinsic evidence that defines or explains how the inventor meant the term to be construed. Therefore, we respectfully suggest that Article 3 be modified to reflect the above as follows:

When hearing an administrative case of granting and determination of patent rights, the people's court generally should define the terms in the claims by reviewing using the ordinary meanings understood by the persons skilled in the art and in the line with the purpose of the invention at the time that the application was filed. The review also should take into account definitions or explanations of the ~~If a claim uses self-defined terms provided in the and its description, and—attached drawings and the patent examination files have clear definitions or explanations, such definitions shall apply.~~

The ordinary meanings stipulated in the preceding paragraph can be defined from the technical dictionaries, technical manuals, reference books, textbooks, technical standards of the state or the industry that are normally used by persons skilled in the art but the ordinary meanings should not preempt the clear definitions or explanations of the terms provided in the description, drawings and patent examination files.

~~Patent examination files may be referred when explaining the terms in the claims.~~

Article 4

Article 4 in the 2018 draft of the Provisions should be restored and extended. In the 2018 draft, the article stated:

When determining the meanings of a term in a claim, the people's court may consult the statement made by the patentee about the claim in patent infringement proceedings.

In determining the meaning of a claim term, previous Article 4 permits reference to the patentee's statements in a patent infringement litigation proceeding as to the interpretation of a claim term. IPO respectfully suggests that this article is necessary for the proper functioning of the rule of law, by helping to prevent a fraud on the court that may otherwise occur if a party makes a contrary representation in another proceeding. This article is also necessary for harmony with international standards of jurisprudence. In fact,

other jurisdictions, such as the United States, go further and in some cases hold that such statements in other proceedings are not only admissible — they are also binding upon the party.

IPO further suggests extending this article, so 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 a party other than the patentee in infringement and other proceedings should also be considered in construing patent claim terms against any contrary positions taken such a party. Statements provided by a party other than the patentee might be helpful in properly construing the claim terms in situations where such a party attempts to take inconsistent positions (e.g., in an infringement proceeding versus in an invalidation proceeding).

IPO therefore proposes restoring and amending this article as follows:

When determining the meanings of a term in a claim, the people’s court may consult ~~the statements~~ made by ~~the patentee~~ a party about the claim in ~~patent infringement~~ other proceedings.

Article 5

Article 5 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 support 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 of, for example, failing to provide an enabling disclosure.

In addition, we believe that mechanisms should be provided to enable the People’s Court to obtain evidence to aid in its determination of whether technical contents in the specification are “fabricated and made-up.” To that end, we recommend that the mechanisms provided in Article 12 (with amendments as proposed herein) be applicable to this determination, with an additional paragraph inserted in Article 5 as follows:

Where the People’s Court suspects or a party challenging the patent asserts that the technical contents in the specification is “fabricated and made-up,” the People’s Court may refer to Article 12 to require the patent owner to provide evidence, or the People’s Court may entrust an institution with corresponding qualifications or a third party recognized by the parties to test or verify the relevant experimental data.

Article 9

We note that Article 9 of the Provisions addresses the situation where a party makes an assertion as to whether technical solutions defined in the claims solve problems set forth in the description on the basis of contradictory technical content appearing in the patent document. Proposed Article 9 states “If the technical contents recorded in the description and drawings are contradictory...”

We are concerned that the above language in Article 9 might be interpreted to mean that the type of “contradictory technical content” addressed by Article 9 entails only a contradiction between subject matter in the specification and subject matter in the drawings. We note that Article 9 further states “the People’s Court shall not support the assertion made by the parties on the basis of the contradictory technical content that ‘the claims should be based on the description’ as provided in Article 26, Paragraph 4 of the Patent Law.”

Article 26, Paragraph 4 mentions a “written description” which would appear to include both the specification and the drawings of a patent document. It would follow that the “contradictory technical content” might be found anywhere in the “written description” as contemplated by Article 26, Paragraph 4. Stated another way, it seems appropriate that “contradictory technical content” mentioned in Article 9 might be found in the specification alone, the drawings alone, or in both the specification and drawings. Accordingly, we suggest that Article 9 be amended to accord with the understanding of the “written description” mentioned in Article 26, Paragraph 4 of the Patent Law. Specifically, we suggest Article 9 be amended as follows:

If the technical contents recorded anywhere in the written description ~~and drawings~~ are contradictory, thereby those skilled in the art cannot confirm whether the technical solutions defined in the claims can solve the technical problems described in the description, the People’s Court shall not support the assertion made by the parties on the basis of the contradictory technical content that “the claims should be based on the description” as provided in Article 26, Paragraph 4 of the Patent Law.

Article 12

Article 12 is directed to experimental data and mechanisms for the People’s Court to require the patentee to provide supporting evidence. Where the parties challenge the truthfulness of the experimental data, Article 12 provides that the People’s Court may entrust an institution with corresponding qualifications or a third party recognized by the parties to test or verify the experimental data.

IPO submits that these mechanisms should be available not only for experimental data submitted during litigation, but should also apply to experimental data that is contained in the specification. Accordingly, we recommend that Article 12 be amended as follows:

If the parties submit experimental data during litigation or as contained in the specification, the People's Court may require them to provide evidence to prove the source and formation process of the experimental data, including the factors that are sufficient to influence the truthfulness,

relevance and probative force thereof, e.g. experimental raw materials and the source thereof, experimental steps, conditions, environment, parameters, as well as the personnel and institutions that completed the experiment.

If the parties challenge the truthfulness of the experimental data submitted during litigation or as contained in the specification, the People's Court may entrust an institution with corresponding qualifications or a third party recognized by the parties, to test or verify the experimental data.

Article 13

IPO thanks the Supreme People's Court for adding to Article 13 (formerly Article 17 of the 2018 draft Provisions) the clarification "known to the public domestically abroad" which provides added clarity regarding what it means for background art to be publicly disclosed in the context of this article. It is our understanding that "domestically abroad" means domestically or abroad, although some may interpret "domestically abroad" to mean domestically and abroad. To clarify this point, IPO respectfully suggests changing "domestically abroad" to "domestically or abroad" as follows:

The background art recorded in the descriptions generally is not deemed as the prior art mentioned in Article 22.5 of the Patent Law, unless there are evidences proving that it has been known to the public domestically or abroad before the application date.

We thank the Supreme People's Court for the opportunity to provide IPO's comments, and we welcome further dialogue and opportunity to provide additional comments.

We have enclosed this letter as translated herewith.

Sincerely,



Daniel J. Staudt
President

Attachment