

Interpretation of the Supreme People's Court on Issues Concerning the Application of Law in the Trial of Disputes over Infringement of Patent Rights

Adopted at the 1480th meeting of the Judicial Committee of the Supreme People's Court on 21 December 2009, and came into force on 1 January 2010

Fa-Shi No.21 (2009)

For the purpose of adjudicating appropriately disputes over the infringement of patent rights, this Interpretation is formulated in accordance with the Patent Law of the People's Republic of China, Civil Procedure Law of the People's Republic of China and other relevant legal provisions, in combination with trial practices.

Article 1. The courts shall, pursuant to Article 59.1 of the Patent Law, determine the scope of protection of the patent right in accordance with the assertion made by the patentee. Changes introduced by the patent holder to the claims asserted prior to the close of the oral hearing before a court of the first instance shall be allowed by the courts.

Where the patent holder asserts that the scope of protection of the patent right is to be determined on the basis of the dependant claims, the courts shall determine the scope of protection of the patent right on the basis of both the additional technical features of such dependent claims and the technical features of the claims being referred to.

Article 2. The courts shall determine the content of a claim as prescribed in Article 59.1 of the Patent Law on the basis of the recitations of the claim in combination with the understanding by a person of ordinary skill in the art after reading the description and the appended drawings.

Article 3. The courts may interpret a claim using the description and the appended drawings, relevant claim(s) in the claims set, and patent prosecution history. Where the description has specifically defined an expression in the claim, such specific definition shall be adhered to.

In case the application of the above-mentioned method still fails to clarify the meaning of the claim, interpretation may be made in combination with such published documents as reference books, textbooks, and common understanding of the meaning by a person of ordinary skill in the art.

Article 4. For a technical feature in a claim represented by function or effect, the courts shall determine the content of such technical feature by reference to the specific embodiment and its equivalent embodiment(s) of the function or effect as depicted in the description and the appended drawings.

Article 5. For a technical solution which is only depicted in the description or the appended drawings but not recited in the claims, the incorporation of such technical solution by the patent holder in a patent infringement lawsuit into the scope of protection of the patent right shall not be supported by the courts.

Article 6. In the procedure leading to a grant or an invalidation of a patent right, where the patent applicant or the patentee abandons a technical solution by amendments to the claims, the description or via the observations, the incorporation of the abandoned technical solution into the scope of protection of the patent right by the patent holder in a patent infringement lawsuit shall not be supported by the courts.

Article 7. The courts, in determining whether the technical solution alleged for infringement falls into the scope of

protection of the patent right, shall examine all the technical features recited in the claim claimed by the patent holder. Where a technical solution alleged for infringement comprises technical features identical or equivalent to all the technical features recited in the claim, the courts shall determine that such technical solution falls into the scope of protection of the patent right; where by comparison with all the technical features recited in the claim, the technical solution alleged for infringement lacks more than one technical features, or more than one technical features of the claim are neither identical nor equivalent, the courts shall determine that the technical solution alleged for infringement does not fall within the scope of protection of the patent right.

Article 8. Where a product of the same or similar classification with the product incorporating the design uses a design identical or similar to the patented design, the courts shall determine that the design alleged for infringement falls within the scope of protection of patent right for the design as prescribed in Article 59.2 of the Patent Law.

Article 9. The courts may determine whether products are of the same or similar classification based on the use of the products incorporating the design. In determining the use of the products, reference may be made to the brief description of the designs, International Classification for Design, functions, as well as sales and practical usages of the products.

Article 10. The courts, in judging whether designs are identical or similar, shall base on the knowledge level and understanding of the general consumers of the products incorporating the designs.

Article 11. The courts, in judging whether designs are identical or similar, shall consider in a comprehensive manner according to the overall visual effect of the designs on the basis of the design features of the patented design and the design alleged for infringement, and shall not take into consideration the design features determined mainly by the technical functions and those features such as materials and internal structures of a product which have no influence on the overall visual effect.

The overall visual effect of a design is generally more susceptible to influence in cases of the following:

- (1) the portion of a product which is easily exposed to direct observation during normal use of the product, relative to other portions of the product;
- (2) the design features of the patented design as distinguished from the prior design, relative to other design features of the patented design.

Where there is no difference in overall visual effect between the design alleged for infringement and the patented design, the courts shall determine that the two designs are identical; where there is no substantial difference in overall visual effect, the two designs shall be determined as similar.

Article 12. Where a product infringing upon the patent right for an invention or a utility model is used as a component for the production of another product, the courts shall determine this as an act of "use" prescribed in Article 11 of the Patent Law; where such another product is sold, the courts shall determine this as an act of "sell" prescribed in Article 11 of the Patent Law.

Where a product infringing upon the patent right for a design is used as a component for the production and sale of another product, the courts shall determine this as an act of "sell" prescribed in Article 11 of the Patent Law, with the exception of the product infringing upon the patent right for a design performing merely a technical function in such another product.

Regarding the circumstances prescribed in the preceding two paragraphs, where the accused infringers cooperate and share work among themselves, the courts shall determine this as a contributory patent infringement

Article 13. Where an original product is obtained by a patented process, the courts shall determine this as "the product directly obtained by the patented process" as prescribed in Article 11 of the Patent Law.

Where a follow-up product is obtained by further processing or disposing of the original product, the courts shall determine the act as "use the product directly obtained by the patented process" as prescribed in Article 11 of the Patent Law.

Article 14. Where all the technical features alleged to fall within the scope of protection of the patent right are identical to or of no substantial difference from the corresponding technical features of a single existing technical solution, the courts shall determine the technical solution implemented by the accused infringer as a prior art as prescribed in Article 62 of the Patent Law.

Where a design alleged for infringement is identical to or of no substantial difference from a prior design, the courts shall determine the design implemented by the accused infringer as a prior design prescribed in Article 62 of the Patent Law.

Article 15. Where an accused infringer asserts prior user rights for an illegally acquired technical solution or design, the assertion shall not be granted by the courts.

Under either of the following circumstances, the courts shall determine the circumstance as "already made necessary preparations for its making or using" as prescribed in Article 69(2) of the Patent Law:

- (1) the main technical drawings or technique documents for implementing an invention-creation have been finished;
- (2) the main facilities or raw materials for implementing an invention-creation have been made or purchased.

The "original scope" prescribed in Article 69(2) of the Patent Law includes the existing scale of production as of the date of filing an application for the patent, and the scale of production achievable from making use of existing production facilities or based on existing production preparation.

Where the owner of the prior user right, after the date of filing an application for the patent, transfers or licenses others to implement the technology or design which has been implemented or for which necessary preparation for implementation has been made, the assertion by the accused infringer that the act of implementation belongs to a continuous implementation within the original scope shall not be supported by the courts, except that such technical solution or design is transferred or inherited along with the original company.

Article 16. The courts, in determining pursuant to Article 65.1 of the Patent Law the gains acquired by the infringer from the infringement, shall restrict the gains to those acquired by the infringer from the infringement upon the patent right itself, and those gains generated from other rights shall be reasonably deducted.

Where the product infringing upon the patent right for an invention or a utility model is a component of another product, the courts shall reasonably determine the amount of damages according to such factors as the value of the component itself and its role in achieving the profits of the finished product.

Where the product infringing upon the patent right for a design is a package, the courts shall reasonably determine the amount of damages according to such factors as the value of the package itself and its role in achieving the profits of the packaged product.

Article 17. Where a product or the technical solution for producing a product is unknown to the public in the country or abroad as of the date of filing an application for the patent, the courts shall determine that such product is a "new product" prescribed in Article 61.1 of the Patent Law.

Article 18. Where a patent holder sends a warning to others for infringing a patent right and where the patent holder neither withdraws the warning nor files a lawsuit within one month upon receiving a written reminder in which the person warned or the interested party urges the patent holder to exercise the right of action, or within two months upon issuing the written reminder, the courts shall accept the case if the person warned or the interested party files a request for a declaratory judgment action for non-infringement.

Article 19. Where the act alleged for infringement upon a patent right occurs before 1 October 2009, the courts shall apply the Patent Law before revision; where such act occurs after October 1, 2009, the courts shall apply the revised Patent Law.

Where the act alleged for infringement upon a patent right occurs before 1 October 2009 and continues after 1 October 2009, the infringer shall assume responsibility for damages in accordance with the Patent Law both before and after revision, and the courts in determining the amount of damages shall apply the revised Patent Law.

Article 20. Where there is discrepancy between relevant Interpretations promulgated by the Supreme People's Court and this Interpretation, this Interpretation shall prevail.