

China Intellectual Property Quarterly News

2010年春季中国知识产权通讯

Note from the Editors

The year of 2010 has a very different feel than 2009. After a year of consolidation and cutbacks, companies are again looking for growth opportunities and are willing to invest to achieve that growth. A new era of economic recovery means that IP protection will again come to the fore, especially for high-tech companies. We hope the information in this issue will help guide your own company's growth in both China and the rest of the world.

In this issue we first discuss China's confidentiality review requirement for foreign patent filing, and we are happy to report that filing directly overseas is now an option for some applicants. We then discuss China's new statutory rewards and remuneration requirements for service inventions, and recommend that companies operating in China include specific provisions for rewards and remunerations for service inventions in their employment contracts. Lastly, we discuss some recent legal developments in the United States that make it considerably more likely for Chinese defendants to transfer their cases out of the Eastern District of Texas.

We are also happy to report on recent rankings listing the firm among the most active in a number of intellectual property categories and on recent victories on behalf of our clients, including a trial victory with important ramifications for the open-source software community.

编者按

2010年和2009年非常不一样。经过一年多的调整和紧缩,许多公司又都在寻找增长的机会,并愿意为增长而投资。经济的复苏意味着知识产权的保护又将成为企业的一个中心议题,尤其是对高科技企业来说。我们希望本通讯中的资讯能帮您指导贵公司在中国和世界市场上的增长。

在通讯中,我们首先讨论在中国向国外申请专利的保密审查,并高兴地汇报对少数申请人来说,直接向国外提出专利申请是一种可能性。我们然后讨论中国对职务发明奖励和报酬的新规定,并建议在中国经营的公司雇用合同中明确规定对职务发明的奖励和报酬。最后,我们讨论一些最新的美国法律动态,这些最新的美国法律动态使中国公司更有可能将案件移出德州东区法院。

我们也十分高兴地汇报本所在多个知识产权领域中被评为最为活跃的律所之一和最近代表客户取得的胜利,包括一个对开源软件行业非常重要的胜诉裁决。

顺致商祺!

美富律师事务所

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Confidentiality Review for Foreign Patent Filing

By Harris Gao

Before the Third Amendment to the Chinese Patent Law ("Third Amendment") took effect on October 1, 2009, whenever a Chinese entity or individual intended to file a patent application in a foreign country for an invention made in China, the entity or individual was required to file an application in China first. The Third Amendment removed this "first filing in China" requirement, but it also added a new requirement of confidentiality review. An applicant must now submit a request for confidentiality review by SIPO before filing overseas. This confidentiality review requirement applies to all inventions made in China. Failure to comply with this requirement would result in the loss of the right to patent in China.

Whether it is practical to directly file patent applications overseas depends largely on how SIPO implements the confidentiality review. In particular, people are interested in knowing how long it takes SIPO to conduct the confidentiality review. On January 18, 2010, the State Council released the Revised Chinese Patent Law Enforcement Regulation ("Revised Patent Regulation"), effective on February 1, 2010. The Revised Patent Regulation addresses some of the practical issues underlying the confidentiality review, and lays out detailed procedures for confidentiality review.

The Confidentiality Review Process

Under Article 8 of the Revised Patent Regulation, an applicant must request a confidentiality review before filing a patent application in a foreign country for an invention made in China. This would include all inventions in which "the substance of the technical solution was completed in China." The request may be filed separately, or in conjunction with a patent application filed in China. If the request is filed separately, it must include a detailed description of the technical solution provided by the invention.

Under Article 9 of the Revised Patent Regulation, upon receiving such a request, SIPO shall "promptly" send the applicant a notice of confidentiality review if SIPO determines that the invention could possibly be related

to national security or the national interest such that there might be a need to maintain its confidentiality. If the applicant does not receive a notice of confidentiality review within 4 months of the request, the applicant can file the patent application overseas. On the other hand, if SIPO decides to conduct a confidentiality review, it should "promptly" notify the applicant once it completes the confidentiality review. If, within 6 months of its request, the applicant does not receive a decision that its invention needs to be kept confidential, the applicant can file the patent application overseas.

Under the Revised Patent Regulation, SIPO will conduct two types of reviews: (1) an initial review to determine whether a further confidentiality review is warranted for an invention; and (2) a further review to determine whether the invention needs to be kept confidential, and thus is not eligible for foreign filing. If an invention passes the initial review, SIPO will notify the applicant that the invention is cleared for foreign filing. On the other hand, if an invention fails the initial review, SIPO will conduct the further review.

The First Three Months of Confidentiality Review at SIPO

SIPO has been conducting confidentiality reviews since the Third Amendment took effect on October 1, 2009. According to data provided by SIPO, the vast majority of the inventions will pass the initial review. During the first three months (October, November and December of 2009), 92% of the total requests passed the initial review, and only 1 percent of the requests did not pass the initial review (the rest of the requests were deemed to be not submitted due to formality issues).

Also according to data provided by SIPO, it will not take very long for the vast majority of the inventions to pass the initial review. If the request for confidentiality review is filed with a Chinese patent application, SIPO will send the applicant the result of the initial review at the same time as the official receipt of the patent application. During the last three months of 2009, where the request was filed separately or after the filing of a Chinese patent application, it took

SIPO an average of 27 days to notify the applicant of the result of the initial review.

Thus, for the vast majority of the inventions, one should expect to receive an approval for foreign filing within about a month. It will be longer for the small minority of inventions where a further confidentiality review is needed, but in any event no more than six months. To prevent a significant loss of priority, an applicant who received a notice of confidentiality should consider filing a corresponding patent application in China immediately.

Direct Foreign Filing Is an Option in Limited Circumstances

The Third Amendment, as implemented by the Revised Patent Regulation, does give applicants the option of filing directly overseas; but exercising that option has its cost. During the last three months of 2009, that cost was generally the delay of about 1 month in priority. For many applicants, this delay in priority may make it inadvisable to file directly overseas. Instead, these applicants should consider filing a Chinese patent application or a PCT application in China first.

On the other hand, if the applicant is only interested in filing in the United States, direct filing can be a viable option. The United States is a first-to-invent system, so it is less important to have the earliest filing date. What is more important is to have the earliest invention date. Since the applicant needs to submit a detailed description of his technical solution in the request of confidentiality review, it should be feasible to use the confidentiality review request to establish an invention date that is no later than the request date, and the delay in filing date caused by the confidentiality review should not have much impact on its patentability in the United States.

Conclusion

The Revised Patent Regulation lays out a fairly well-organized confidentiality review process, and filing directly overseas now is an option for a small number of applicants whose primary interest is to obtain a U.S. patent. ■

¹ The author would like to thank Ms. Li Li of the State Intellectual Property Office for her kind assistance.

向国外申请专利的保密审查

作者：高焕勇

在专利法第三次修正于2009年10月1日生效之前，如果中国单位或个人想将一项在中国完成的发明向外国申请专利，其应首先在中国提出专利申请。专利法第三次修正取消了首先在中国提出专利申请的要求，但增添了一项新的保密审查规定。在当事人向外国提出专利申请之前，必须先向国家知识产权局提出保密审查请求。保密审查要求适用于所有在中国完成的发明。不遵守保密审查规定的后果是丧失在中国获得专利的权利。

直接向外国提出专利申请在实践中是否可行取决于国家知识产权局如何进行保密审查。大家特别关心的是国家知识产权局需要多少时间来完成保密审查。2010年1月18日，国务院公布了修改后的《中华人民共和国专利法实施细则》，于2010年2月1日生效。修改后的专利法实施细则处理了保密审查中的一些问题，并具体规定了保密审查的流程。

保密审查流程

根据修改后的专利法实施细则第8条，当事人将一项在中国完成的发明向外国提出专利申请之前，必须先向国家知识产权局提出保密审查请求。在中国完成的发明是指“技术方案的实质性内容在中国境内完成”的发明。保密审查请求可以单独提交，也可以与中国专利申请一起提交。单独提交的保密审查请求必须包括其技术方案的详细说明。

根据修改后的专利法实施细则第9条，国家知识产权局收到保密审查请求后，经过审查认为该发明可能涉及国家安全或者重大利益需要保密的，应当“及时”向申请人发出保密审查通知。若申请人未在其请求递交日起4个月内

收到保密审查通知，可以就该发明向外国申请专利。另一方面，如国家知识产权局通知进行保密审查，则应当“及时”作出是否需要保密的决定，并通知申请人。若申请人未在其请求递交日起6个月内收到需要保密的决定，可以就该发明向外国申请专利。

根据修改后的专利法实施细则的规定，国家知识产权局将进行两类审查：

(1) 通过首次审查决定是否需要进一步审查；(2) 通过进一步审查决定是否需要保密而不得向外国提交专利申请。如果一项发明通过了首次审查，国家知识产权局将通知申请人可以就该发明向外国申请专利。反之，如果一项发明没有通过首次审查，国家知识产权局则将进行进一步审查。

保密审查头三个月的实施情况

国家知识产权局于2009年10月1日开始实施保密审查。根据国家知识产权局提供的数据¹，绝大多数的发明均可以通过首次审查。在专利法第三次修正生效后的三个月内（2009年10月到12月），92%的申请通过了首次审查，只有1%的申请没有通过首次审查（其他的申请因格式问题视为未提出）。

同时，国家知识产权局提供的数据表明，绝大多数的发明可以很快通过首次审查。如果保密审查请求是连同中国专利申请一起提出的，国家知识产权局将把首次审查的结果和专利申请受理通知书同时发出。如果保密审查请求是单独提出的，或是在中国专利申请提交后提出的，在2009年10月到12月期间，国家知识产权局首次审查结果的平均发送时间为27天。

因此，绝大多数的发明会在一个月左右获准向外国提交专利申请。对需要进一步审查的一小部分发明来说，时间会更长，但最多是六个月。为避免优先

权日的严重拖后，需要进一步审查的申请人在收到保密审查通知的时候应考虑马上提交中国专利申请。

直接向国外提出专利申请在很有限的情况下是一种可能性

专利法第三次修正和修改后的专利法实施细则使直接向外国提出专利申请成为可能。但是直接向外国提出专利申请也有它的代价。2009年10月到12月期间，这个代价一般表现为优先权日拖后一个月。因为直接向外国提出专利申请会导致优先权日的拖后，所以我们认为对大部分申请人来说是不合适的。申请人应考虑首先在中国提交中国专利申请或PCT国际申请。

另一方面，如果申请人只想在美国申请专利，直接申请是有一定可行性的。美国采用的是先发明先保护的原则，所以先申请不是最重要的。重要的是要有最早的发明日。由于保密审查请求必须详细说明其发明的技术方案，申请人应该可以确定一个不晚于保密审查请求提出日的发明日，由保密审查所造成的申请日延迟不应该对是否能在美国取得专利产生太大影响。

总结

修订后的专利法实施细则制订了一个相当有组织的保密审查流程；对少数只想获得美国专利的申请人来说，直接向国外提出专利申请是一种可能性。■

¹ 作者在此感谢国家知识产权局的李莉女士。

More Good News for Chinese Patent Defendants Seeking to Transfer Their Cases Out of the Eastern District of Texas

By Michael Vella, Jason A. Crotty and J. Manena Bishop

In our Fall 2009 Newsletter, we reported on some recent legal decisions regarding transferring patent cases out of the Eastern District of Texas to a more convenient and favorable court. In December 2009, the Federal Circuit Court of Appeals (the Court responsible for all patent appeals in the U.S.) issued two more cases, *In re Hoffman-La Roche Inc.* and *In re Nintendo Co., Ltd.*, which have changed the legal landscape even more — making it considerably more likely that Chinese defendants can transfer their cases out of the Eastern District of Texas.¹ Indeed, it appears that a plaintiff's chances of successfully opposing a transfer motion out of the Eastern District of Texas are lower than ever before.

In recent years, the Eastern District of Texas developed a reputation for being a desirable forum for plaintiffs, attracting numerous patent owners and making the district famous for patent litigation involving multi-million dollar verdicts. Moreover, because motions to transfer appeared to be routinely denied, defendants found themselves required to litigate in the Eastern District of Texas, even when virtually no connection existed between the dispute and the venue.

The Fifth Circuit's *en banc* decision in *Volkswagen*, an auto injury case, started a significant change in transfer law. *In re Volkswagen of America, Inc.*, 545 F.3d 304 (5th Cir. 2008) (*en banc*). In ordering the case transferred from the Eastern District to the Northern District of Texas, the appellate court held that the district court could not disregard the physical location of evidence simply because modern technology makes it easier to transport certain forms of evidence. *Id.* at 316, 322-23. Virtually all of the evidence in *Volkswagen* stemmed from or was located in Dallas, including all of the witnesses, documents, and physical evidence. *Id.* at 316-18. Additionally, the

Northern District had absolute subpoena power over all of the witnesses. *Id.* at 316. The appellate court concluded that the district court had erred in failing to properly consider the actual location of evidence, the availability of the compulsory process, and the local venue's interest in deciding the case "at home." *Id.* at 317-18. The Fifth Circuit granted Volkswagen's petition and ordered the case transferred to the Northern District of Texas. *Id.* at 319.

Soon after *Volkswagen*, a patent infringement defendant, TS Tech, filed a petition in the Federal Circuit Court of Appeals,

public interest in having localized decisions decided "at home." *Id.* at 1320-21. Accordingly, the Federal Circuit granted TS Tech's writ and ordered the district court to transfer the case. *Id.* at 1322-23.

Initial district court rulings following *Volkswagen* and *TS Tech* suggested that more cases would be transferred from the Eastern District of Texas, particularly when the physical evidence and witnesses were centralized at or near the proposed transferee courts and when the alternate forum was "clearly more convenient." *Id.* at 1319 (quoting *Volkswagen*, 545 F.3d at 315). However, defendants in "decentralized" cases involving multiple defendants (*i.e.*, cases in which the evidence, witnesses, and parties were located throughout the country or overseas) seemed to have a more difficult time winning transfer motions. Indeed, several cases supported the notion that "centralized" cases, where the physical evidence was confined to a "limited region," were distinguishable from "decentralized" national cases, where no single venue would clearly be more convenient. See, *e.g.*, *Novartis Vaccines & Diagnostics, Inc. v. Hoffman-La Roche Inc.*, No. 2:07-CV-507, Order, slip op. at 5 (E.D. Tex. Feb. 3, 2009).

The rationale for decentralized, multi-party cases, however, was short lived. The Federal Circuit again exercised its power to review district court decisions — this time ordering the transfer of a decentralized case out of the Eastern District of Texas. See *In re Genentech, Inc.*, 566 F.3d 1338 (Fed. Cir. 2009). Several months later, the Federal Circuit issued two more transfer decisions involving decentralized evidence, parties, and witnesses. See *Nintendo*, 2009 WL 4842589, at *4-5; *Hoffmann-La Roche*, 2009 WL 4281965, at *4. The *Genentech*, *Hoffman-La Roche*, and *Nintendo* decisions made clear that the Federal Circuit was willing to review and reverse district court venue transfer rulings, even in decentralized cases.

IN RECENT YEARS, THE EASTERN DISTRICT OF TEXAS DEVELOPED A REPUTATION FOR BEING A DESIRABLE FORUM FOR PLAINTIFFS, ATTRACTING NUMEROUS PATENT OWNERS AND MAKING THE DISTRICT FAMOUS FOR PATENT LITIGATION INVOLVING MULTI-MILLION DOLLAR VERDICTS.

challenging a decision by the Eastern District of Texas denying transfer of a case. *In re TS Tech USA Corp.*, 551 F.3d 1315, 1318 (Fed. Cir. 2008). Following Fifth Circuit law, the Federal Circuit held that the district court clearly abused its discretion by: (1) giving too much weight to plaintiff's choice of venue; (2) ignoring Fifth Circuit precedent requiring an assessment of costs for attendance of witnesses; (3) marginalizing the factor concerning the relative ease of access to sources of proof; and (4) disregarding Fifth Circuit law in analyzing the

寻求将案件移出德州东区法院的中国专利被告迎来了更多好消息

作者：魏迈克、Jason A. Crotty
和J. Manena Bishop

在本所发布的2009年秋季通讯中，我们报告了一些最近做出的，关于将专利案件从德州东区法院移送到某更便利、更有利于被告之法院的法律判决。2009年12月，联邦巡回上诉法院（美国负责所有专利上诉的法院）又宣布了两起案件，即霍夫曼·罗氏公司案和任天堂株式会社案，这两起案件进一步地改变了法律格局——中国被告将其案件移出德州东区法院的可能性更大了。实际上，对于原告反对将案件移出德州东区法院的移送申请而言，原告获得成功的机会似乎比以前更低了。

近年来，德州东区法院因成为案件原告的理想法庭而闻名，不仅吸引了众多专利所有者，还以多项涉及数百万美元的专利诉讼裁决使该区声名远扬。此外，由于移送申请通常都是被拒绝的，被告发现即使争议和诉讼地之间实际上不存在联系，但他们仍被要求在德州东区法院进行诉讼。

第五巡回法院对大众汽车案（一起关于汽车伤害的案件）的全院庭审判决开始了移送法律的重大改变。（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））。在责令将案件从德州东区法院移送到德州北区法院时，上诉法院认为地区法院不能仅因为现代技术使得传送某些形式的证据更加容易而忽视证据的实际所在地因素。（同上第316页，322-23页。）实际上，在大众汽车案中，所有证据均来自

于或位于达拉斯（位于德州北区），包括所有证人、文件以及实物证据。（同上，第316-18页。）此外，北区法院对所有证人均享有绝对传唤权。（同上，第316页）上诉法院认为地区法院对此问题的裁决存在错误，因为其未能适当考虑证据的实际所在地、强制法律程序的可用性以及地方利益地方裁决的因素。（同上，第317-18页。）第五巡回法院同意了大众汽车公司的申请，责令将案件移送德州北区法院。（同上第319页。）

大众汽车案后不久，专利侵权被告台思公司在联邦巡回上诉法院提起诉讼，对德州东区法院驳回移送的判决提出异议。（美国台思技术公司案，

《联邦案例汇编》第3辑第551卷第1315页，1318页（2008年联邦巡回法院））。根据第五巡回法院法律，联邦巡回法院裁定地区法院显然滥用了其裁量权，因地区法院（1）过多考虑了原告的诉讼地选择；（2）忽视了第五巡回法院要求评估证人出庭成本的判决先例；（3）对与证据来源取得的相对容易性相关的因素，没有给与充分的重视；以及（4）忽视了第五巡回法院对地方利益地方裁决所涉公共利益进行分析时的相关法律。（同上，第1320-21页）因此，联邦巡回上述法院向台思准予了执行令并责令地区法院移送。（同上第1322-23页。）

大众汽车案和台思案后，地区法院的对这一问题在类似案件中的初步裁决意味着从德州东区法院移送的案件数量将会增多，尤其是在实物证据和证人均集中或邻近拟议接受移送的法院的区域，以及候选法庭“明显更加便

利”的情况下。（同上第1319页）（引自大众汽车案，《联邦案例汇编》第3辑第545卷第315页）。但是，在涉及多个被告的“分散型”案件中（例如，证据、证人以及当事人遍及国内外的案件），被告赢得移送申请似乎更加困难了。实际上，不少案件都在支持可将“集中型”案件（实物证据局限在“有限的区域”）与“分散型”国家案件（没有哪个审判地是明显更加便利的）区分对待的主张。参见案例：诺华疫苗与诊断试剂公司对霍夫曼·罗氏公司等公司案（编号：2:07-CV-507，判决号：slip op. 第5页）（2009年2月3日德州东区法院）。

然而，属于分散型、多个当事人案件的理论依据存在较短时间后，就被否定了。联邦巡回法院再次行使其复审权——此次责令将一分散型案件移出德州东区法院。（参见基因技术公司案，《联邦案例汇编》第3辑第566卷第1338页（2009年联邦巡回法院））。几个月后，联邦巡回法院又公布了两项涉及分散证据、当事人和证人的移送判决。参见任天堂株式会社案（2009 WL 4842589第4-5页）；霍夫曼·罗氏公司案（2009 WL 4281965第4页）。基因技术公司案，霍夫曼·罗氏公司案以及任天堂株式会社案的判决明确了联邦巡回法院乐于复审并推翻地区法院的审判地转移判决，即使是分散型案件。

在基因技术公司案中，一家德国制药公司 Sanofi在德州东区法院向基因技术公司（位于加州北区）和Biogen公司（位于加州南区）提起专利侵权诉讼。（基因技术公司案，《联邦案例汇编》5

Transfer Out of EDTX

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In *Genentech*, Sanofi, a German pharmaceutical firm, filed a patent infringement action against Genentech (located in the Northern District of California) and Biogen (located in the Southern District of California) in the Eastern District of Texas. *Genentech*, 566 F.3d at 1340-41. The witnesses and evidence were located in multiple geographic regions, and none were located in Texas. *Id.* The district court based its ruling on its determination that the Eastern District of Texas was as good a central location for a decentralized case as any other venue. *Id.* at 1342. The Federal Circuit rejected this “central location rationale” and set forth several instances in which the district court failed to properly assess the relevant factors under Fifth Circuit law. *Id.* at 1342-49. After considering all of these factors, the Federal Circuit granted the petition and ordered the district court to transfer the case to the Northern District of California. *Id.* at 134849.

The first of the Federal Circuit’s two most recent transfer opinions, *Hoffmann-La Roche*, extended this ongoing shift in transfer law. *Hoffmann-La Roche*, 2009 WL 4281965, at *4. In *Hoffmann-La Roche*, Novartis Vaccines and Diagnostics, Inc., a company headquartered in California, brought suit in the Eastern District of Texas against Hoffmann-La Roche Inc., Roche Laboratories Inc., Roche Colorado Corp., and Trimeris, Inc. *Id.* at *1. Novartis alleged that Fuzeon®, a commercial HIV inhibitor drug, infringed its patent. *Id.* Fuzeon® was developed at Trimeris’ labs in North Carolina where certain documents were maintained. *Id.* Roche’s manufacturing and processing facilities were located in Colorado, Michigan, and Switzerland. *Id.* The company packaged the drug at its New Jersey headquarters and marketed Fuzeon® nationwide. *Id.* Only a handful of 25 potential witnesses lived in North Carolina. *Id.*

Defendants moved to transfer, contending that there were no witnesses or evidence

within 100 miles of the Eastern District of Texas. *Id.* Additionally, defendants argued that most of the relevant evidence, a number of Trimeris’ employee witnesses, and four non-employee witnesses were located in North Carolina. *Id.* Novartis opposed, arguing that the case involved multiple parties from across the country, and that sources of proof and witnesses were located throughout the United States. *Id.* Consequently, transferring the case to North Carolina would merely rearrange the inconveniences. *Id.*

The Eastern District of Texas court agreed with Novartis and denied the motion to transfer, finding that: (1) four non-party witnesses in North Carolina did not constitute a substantial number of witnesses; (2) Novartis’ documents had been transferred to Texas; and (3) the district court had subpoena power over one of the witnesses who lived in Houston. *Id.* at *2. The district court concluded that “the Eastern District of North Carolina had no more of a local interest in deciding this matter than the Eastern District of Texas” because the accused product was offered for sale nationwide. *Id.* at *4. Defendants petitioned the Federal Circuit for a writ of mandamus. *Id.* at *2.

The Federal Circuit compared the case’s connection to the Eastern District of Texas and its connection to the Eastern District of North Carolina and held that there was “a stark contrast in relevance, convenience, and fairness between the two venues.” *Id.* The appellate court held that the district court clearly abused its discretion by failing to give proper weight to the meaningful connection that the patent infringement dispute had to North Carolina but did *not* have to the Eastern District of Texas. *Id.* at *4. In its decision granting the petition to transfer the case, the Federal Circuit analyzed relevant factors under Fifth Circuit law and made the following conclusions:

- The “sources of proof” related to the development and testing of the infringing product were located in North Carolina (the location where the accused drug was developed). *Id.* at *2.
- The district court had no basis to conclude that documents that were electronically transferred from California to Texas supported rejection of the

transfer motion. The law prohibits “attempts to manipulate venue in anticipation of litigation or a motion to transfer.” *Id.* at *3.

- The district court disregarded precedent by holding that North Carolina had no more of a local interest than Texas. On the contrary, the “local interest in this case remains strong because the cause of action calls into question the work and reputation of several individuals residing in or near that district.” *Id.* at *2.
- The matter had “no relevant factual connection to the Eastern District of Texas.” In contrast, North Carolina’s interest in the matter was “self-evident.” *Id.* at *4.
- The district court overlooked the importance of the “absolute subpoena power,” which permits a court to compel a witness to attend depositions and trial. In doing so, the district court gave too much weight to its ability to compel one witness at trial, noting that because the witness lived more than 100 miles away, the district court would not be able to compel her to attend a deposition. The district court also failed to consider the fact that the Eastern District of North Carolina had absolute subpoena power over at least four non-party witnesses, which favored transfer. *Id.*
- The less-congested docket of the district court of North Carolina indicated that the court “may be able to resolve this dispute more quickly.” *Id.* at *2.
- The second of the Federal Circuit’s two recent decisions further confirmed this ongoing shift in the law. See *Nintendo*, 2009 WL 4842589, at *4-5. In *Nintendo*, the Eastern District of Texas had denied Nintendo’s motion seeking to transfer the case to the Western District of Washington, where Nintendo was incorporated and had its principal place of business. *Id.* at *1. Motiva opposed transfer, arguing that Eastern District of Texas was the proper venue for such a decentralized case. *Id.* The Federal Circuit again rejected the “decentralized” argument for maintaining a case in Texas that lacks any connection to the venue and reminded the district court

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第3辑第566卷第1340-41页)。证人和证据位于多个地理区域,而且没有一个是在德州的。(同上。)地区法院根据其确定德州东区法院与任何其他审判地一样对于分散型案件而言均是较好的中心位置这一理由做出裁决。(同上第1342页)。联邦巡回法院推翻了这一“中心位置理论依据”并提出了几个地区法院未能依据第五巡回法院法律适当考虑相关因素的例子。(同上,第1342-49页。)对这些因素进行考量后,联邦巡回法院准予了移送申请并责令地区法院将案件移送加州北区法院。(同上第1348-49页。)

联邦巡回法院最近宣布的两个移送判决中的第一个,即霍夫曼·罗氏公司案继续并扩大了移送法律的转变。霍夫曼·罗氏公司案(2009 WL 4281965第4页)。在霍夫曼·罗氏公司案中,总部位于加州的诺华疫苗与诊断试剂公司在德州东区法院向霍夫曼·罗氏公司、Roche Laboratories Inc.、Roche Colorado Corp.和Trimeris, Inc.提起诉讼。(同上第1页。)诺华公司主张商业HIV抑制因子药物Fuzeon®侵犯了其专利。(同上。)Fuzeon®是在Trimeris设在北加州的实验室开发的,那里也保存着相关的文件。(同上。)Roche的生产和加工设备位于科罗拉多州、密歇根州和瑞士。(同上。)该公司在其新泽西总部对药物进行包装,并在全美进行Fuzeon®营销。(同上。)仅有较少的25个潜在证人居住在北卡罗来纳州。(同上。)

被告提议移送案件,声称在德州东区法院100英里以内没有相关证人或证据。(同上。)此外,被告辩称大部分有关

证据、许多Trimeris的雇员证人及四名非雇员证人均位于北卡罗来纳州。(同上。)诺华提出反对,声称该案涉案多方来自全国各地,而证据来源及证人分部在全美各地。(同上。)因此,将案件移送至北卡罗来纳州,不过是重整了这些不便因素。(同上。)

德州东区法院同意诺华的意见,驳回了移送申请,做出如下裁决:(1)四名

近年来,
德州东区法院因成为
案件原告的理想法庭
而闻名,不仅吸引了众多
专利所有者,还以多项
涉及数百万美元的
专利诉讼裁决使该区
声名远扬。

位于北卡罗来纳州的非当事方证人并不构成多数证人;(2)诺华的文件已被移送至德州;且(3)地区法院对居住在休斯顿的一名证人享有传唤权。

(同上,第2页)地区法院裁定“就判决本案而言,北卡罗来纳州东区法院与德州东区法院的地方利益没有差异”,理由是被告产品系在全国范围内均有销售。(同上,第4页)被告请求联邦巡回法院下发令状或书面命令。(同上,第2页)

联邦巡回法院将该案与德州东区法院及北卡罗来纳州东区法院的关联进行了比较并认定“这两个审判地点在相关性、便利性及公平性上存在鲜明对比。”(同上。)上诉法院认为地区法院不能就专利侵权诉讼与北卡罗来纳州东区法院存在有意义的关联而与德州东区法院不存在该等关联这一点给予

适当重视,显然滥用了其裁量权。(同上,第4页。)在做出同意移送案件的申请的判决时,联邦巡回法院根据第五巡回法院法律分析了相关要素并做出如下结论:

- 与侵权产品研发和测试有关的“证据来源”位于在北卡罗来纳州(即被控药物研发所在地)(同上,第2页。)
- 地区法院没有依据判定通过电子形式从加州移送至德州的文件支持推翻移送申请。法律禁止“试图在诉讼或移送申请前操纵审判地的选择。”(同上,第3页。)
- 地区法院判定北卡罗来纳州与德州在地方利益上无二致时,无视先例。相反,“本案中的地方利益非常明显,因为诉由质疑了居住在或邻近该地区的某些个人的工作和声誉。”(同上,第2页。)
- 本案与“德州东区法院不存在相关的实际关联。”相反,北卡罗来纳州在本案中的利益可谓“不证自明”。(同上,第4页。)
- 地区法院疏忽了“绝对传唤权”的重要性,该等权利允许法院可强行要求证人出席听审及审讯。地区法院过于强调其强制要求证人出席审讯的能力,在注意到由于证人居住在100多英里开外之地后,地区法院将无法要求证人出席听审。此外,地区法院没有考虑到北卡罗来纳州东区法院对至少四名非当事方的证人享有绝对传唤权的事实,而这对移送有利。
- 根据诉讼事件表的记录,北卡罗来纳州地区法院待处理事务较少,这表示该法院“能更快地解决该等争议。”(同上,第2页。)
- 联邦巡回法院最近所做两项判决

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that it had “already questioned this type of reasoning in another case involving the Eastern District of Texas.” *Id.* at *4 (citing *Genentech*, 566 F.3d at 1344). In holding that “the district court clearly abused its discretion in denying transfer from a venue with no meaningful ties to the case,” *id.* (citing *TS Tech*, 551 F.3d at 1322-23), the Federal Circuit reached the following conclusions:

- Although the district court “correctly assessed the local interest of the Western District of Washington as high” and “candidly observed that the Eastern District of Texas has little relevant local interest in the dispute,” it “gave the plaintiff’s choice of venue too much deference.” *Id.* at *3-4.
- The district court also improperly failed to give proper weight to the fact that “[a]ll of the identified key witnesses in this case [we]re in Washington, Japan, Ohio, and New York” and “[n]o witnesses live[d] in Texas.” *Id.* at *3.
- The fact that Nintendo’s products are sold nationally did not justify keeping the case in Texas. “The Fifth Circuit has unequivocally rejected the argument that citizens of the venue chosen by the plaintiff have a ‘substantial interest’ in adjudicating a case locally because some allegedly infringing products found their way into the Texas market.” *Id.* (citing *Volkswagen*, 545 F.3d at 317-18).
- The district court “glossed over a record without a single relevant factor favoring the plaintiff’s chosen venue” and incorrectly “hypothesized that the Eastern District of Texas could serve as a centralized location” despite the fact that neither party had evidence in Texas, and the majority of Nintendo’s evidence was located in Washington. *Id.* at *4-5.

Because all of the relevant factors favored transfer, the Federal Circuit held that the district court’s result was “patently erroneous” and ordered the case transferred to

the Western District of Washington.

These recent Federal and Fifth circuit venue decisions indicate that the trend continues to favor parties seeking to transfer cases out of the Eastern District of Texas. Moreover, it appears that the Federal Circuit is paying close attention to newly issued district court transfer rulings and will not hesitate to find an abuse of discretion when lower courts fail to balance the trans-

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fer factors in a manner that conforms to its recent decisions. *Genentech* and *Nintendo* indicate that transfer is appropriate in decentralized cases if there are no witnesses in the district where the case is filed and a significant number of witnesses would benefit from a change of venue. *Hoffman-La Roche* and *Nintendo* suggest that district courts must evaluate whether the patent dispute’s connection to a plaintiff’s selected venue is more meaningful than the connection to any one alternative local venue. All of these cases highlight the importance of witness convenience, location of evidence, and a connection between the dispute and the district. Additionally, the fact that a case involves a product that is sold nationwide no longer means that any venue in the country is appropriate. Consequently, even decentralized cases now appear to have a high probability of being transferred if the dispute does not have any meaningful connection to the Eastern District of Texas and an alternate jurisdiction with such a connection exists.

For Chinese companies, the Federal Circuit’s recent decisions are particularly good news. First, these decisions may cause patent plaintiffs to rethink their strategy of suing Chinese companies in the Eastern District of Texas in an effort to make the case as inconvenient and threatening as possible. Second, if Chinese companies are sued in the district, the odds of obtaining transfer to a forum with a more significant connection to the case are much better than they were just a year ago. Finally, if a case is successfully transferred out of Texas, the case will lose some of its momentum, and Chinese companies will have more leverage in settlement discussions and a more favorable venue if trial should become necessary. ■

1 *In re Hoffmann-La Roche Inc.*, --- F.3d ---, Misc. No. 911, 2009 WL 4281965 (Fed. Cir. Dec. 2, 2009); *In re Nintendo Co., Ltd.*, --- F.3d ---, Misc. No. 914, 2009 WL 4842589 (Fed. Cir. Dec. 17, 2009). The earlier decisions from the Federal Circuit that we discussed in our Fall 2009 Newsletter are: *In re Genentech, Inc.*, 566 F.3d 1338 (Fed. Cir. 2009); *In re TS Tech USA Corp.*, 551 F.3d 1315 (Fed. Cir. 2008); *In re Volkswagen of America, Inc.*, 545 F.3d 304 (5th Cir. 2008) (*en banc*).

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的第二项进一步证明上述转移的合法性。(参见任天堂案, 2009 WL 4842589第4-5页。)在任天堂案中, 德州东区法院驳回了任天堂寻求将案件移送至其成立所在地华盛顿西区法院的申请, 任天堂正是在该区成立而且主要营业场所也位于此。(同上, 第1页) Motiva反对移送, 辩称德州东区法院是该分散型案件的适当审讯地。

(同上。)联邦巡回法院再次拒绝以“地域分散”为由将案件继续在德州审讯, 认为这一理由与审讯地没有任何关联, 并提醒地区法院其已经“在德州东区法院的另一桩案件中对这类推理提出过质疑。”

(同上, 第4页。)(摘自基因技术公司案, 联邦案例汇编》第3辑第566卷第1344页)联邦巡回法院判定“地区法院拒绝将案件从与之没有重要关联的审讯地转移显然滥用了其裁量权”, 并做出如下判决:

- 尽管地区法院“做出了正确评估, 认为华盛顿西区法院的地方利益较大”并“坦率地认为德州东区法院在该争议中没有相关的地方利益”, 但其“过于顺从原告的审讯地选择。”(同上, 第3-4页。)
- 此外, 地区法院错误地未能重视“本案中所有已确定的关键证人居住在华盛顿、日本、俄亥俄州及纽约”及“没有证人居住在德州”这一事实。(同上, 第3页。)
- 任天堂的产品在全国范围内销售的事实不能证明将案件在德州审

讯系正当的。“第五巡回法院已明确驳回了以下理由, 即以某些据称造成侵权的产品在德州市场销售为由而认为原告所选审讯地的居民会对裁定这类所谓当地案件时有“重大利益。”(同上。)(摘自大众案, 联邦案例汇编》第3辑第545卷第317-18页。

- 地区法院“掩盖了没有任何有关因素有利于原告所选审讯地的记录”, 并错误地“假定德州东区法院可作为中心地区被选为审讯地”, 无视任何一方在德州均没有证据, 而任天堂的大部分证据来自华盛顿这一事实。(同上, 第4-5页。)

由于所有相关因素有利于移送案件, 联邦巡回法院认定地区法院的判决系“明显错误的”, 并责令将案件移送至华盛顿西区法院。

联邦巡回法院及第五巡回法院日前就审讯地所做的判决表明未来的趋势将有利于寻求将案件转出德州东区法院的当事人。而且联邦巡回法院看起来日益关注地区法院新颁布的移送裁决, 并在低级法院不能遵循联邦巡回法院日前所做判决平衡移送因素时, 联邦巡回法院将毫不犹豫判定地区法院滥用其裁量权。基因技术公司与任天堂案表明如果没有证人居住在提交案件所在地以及更改审讯地对大多数证人有利, 案件移送适合于该等分散型案件。霍夫曼·罗氏公司与任天堂案表明地区法院必须评估专利争议与原告所选审讯地的关联是否比与任何其它备选审讯地的关联更有影响力。所有这些案件均强调了证人便利性、证据所在地及争议与地区的关联性的重要性。此外, 案件涉及在全国范围出售的产品不再意味着国内任何地区均为合适的审讯地。因此, 即使分散型案件目前被准予移送的可能性也显得有所提

联邦巡回法院及第五巡回法院日前就审讯地所做的判决表明未来的趋势将有利于寻求将案件转出德州东区法院的当事人。

高, 只要争议并未与德州东区法院有着任何有意义的关联且另外存在一个与争议有着重要关联的管辖地。

对于中国公司而言, 联邦巡回法院最近所做判决尤其是好消息。首先, 这些判决可能促使专利案原告重新考虑在德州东区法院起诉中国公司的策略, 以使中国公司尽可能更加不便且更具有威胁性。其次, 如中国公司在该地区被起诉, 则较之一年前将案件移送至与案件更具有关联性的审判地的可能性大大提高。最后, 如某案件成功地被转出德州, 则该案将丧失其势头, 且如果有必要对案件进行审判, 中国公司将在和解讨论中拥有更多的影响力和更为有利的审讯地。■

1 霍夫曼·罗氏公司案 - 《联邦案例汇编》第3辑 - Misc. No. 911, 2009 WL 4281965 (2009年12月2日联邦巡回法院); 任天堂株式会社案 - 《联邦案例汇编》第3辑-Misc. No. 914, 2009 WL 4842589 (2009年12月17日联邦巡回法院)。我们在2009年秋季通讯中讨论的联邦巡回上诉法院更早做出的判决是: 基因技术公司案, 《联邦案例汇编》第3辑第566卷第1338页 (2009年联邦巡回法院); 美国台思技术公司案, 《联邦案例汇编》第3辑第551卷第1315页 (2008年联邦巡回法院); 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)。

Employees' Rights to Inventions and Rewards under the Revised Patent Law

By Gordon Milner and
Claire Robley

The Implementing Regulations of the PRC Patent Law ("Implementing Regulations") were recently revised to implement the Third Amendment to the PRC Patent Law. The revised Implementing Regulations came into effect on 1 February 2010, and contain new provisions with respect to the reward regime for employee inventions, an area of law that has been watched with keen interest by both Chinese and foreign companies involved in research and development (R&D) activities in China.

In the past, many employers have tended to disregard the general requirements under the Patent Law for a PRC employer to pay a financial reward to its employees upon the grant of a patent and subsequent licensing or transfer. However, the revised Implementing Regulations now explicitly extend these requirements to all employers in China and impose specific rewards which will be payable to employees as a default position if the relevant employment contracts are silent. As a result, the risk of enforcement in China is now far greater.

In practice, the default arrangements may be somewhat un-commercial. Employers should therefore consider overriding the default arrangements by express alternative provisions in the relevant employment contracts, provided that such alternative provisions are reasonable.

The recent changes to the reward regime in China are discussed in more detail below.

General Provisions under the Patent Law

Articles 6 and 16 of the Patent Law (which are not changed by the Third Amendment) set out the general position with regard to

ownership of patent rights and remuneration of inventors in the PRC.

Article 6 of the Patent Law provides that a "service invention" is an invention made in the course of employment duties or mainly using the material and technical resources of the employer. Although the default position under Article 6 is that the right to apply for a patent over a service invention belongs to the employer, whereas the right to apply for a patent over a non-service invention remains with the inventor or designer, companies can expressly override the default rules and determine the ownership of patent rights and the right to apply for patents by contract.

Article 16 of the Patent Law provides that a company that obtains a patent over a service invention must, upon exploitation of the patent, pay the inventor a reasonable remuneration taking into account the extent to which the patent is exploited and the income earned from such exploitation.

New Implementing Regulations

The previous version of the Implementing Regulations already provided for a detailed reward payment system applicable only to State-Owned Enterprises (SOEs), under which employees were entitled to payment of a lump sum upon grant of a patent and a percentage of the annual revenue and licensing royalties generated by the patent. For example, the original Implementing Regulations provided the following default arrangements: (1) a minimum reward of RMB 2,000 to be paid within three (3) months from the date on which a patent is granted, and (2) a "reasonable remuneration" upon exploitation of an employee's invention patent amounting to no less than 2% of the after-tax profit generated from implementation of the patent, or 10% of the fee generated from the licensing of the patent.

The new Implementing Regulations contain a number of amendments as follows:

- The reward provisions now apply to all entities in China, not just SOEs.
- The minimum amount of reward, which must be paid within three (3) months from the date on which a patent is granted, has been increased from RMB 2,000 to RMB 3,000 for an invention patent and from RMB 500 to RMB 1,000 for a utility model or design patent.
- The detailed provisions above will only apply in the absence of specific reward provisions in company regulations or employment contracts (i.e. employers are free to implement their own reward system).

Although some Chinese companies appear to have voiced concern with the default arrangement in the original Implementing Regulations requiring a "reasonable remuneration" of no less than 2% of the after-tax profit generated from implementation of the patent, or 10% of the fee generated from the licensing of the patent, that provision remains unchanged in the new Implementing Regulations. Consequently, absent an agreement to the contrary, this default arrangement now applies to all employers in China.

Dealing with the New Implementing Regulations

If employers are to take advantage of the ability to formulate and document their own reward system in respect of employee inventions, they must be careful to ensure that any remuneration paid to an employee upon exploitation of a patent is reasonable.

Not only is this reasonableness requirement specifically contained in Article 16 of the Patent Law (which states that the

依照修改后的专利法员工对发明享有的权利和奖励

作者：**Gordon Milner**和**罗恺莉**

《中国专利法实施细则》（“实施细则”）应中国专利法第三次修正而于最近被修改。新的实施细则于2010年2月1日起生效，并包含了一些关于员工发明奖励方式的新规定，这是在中国进行研究和开发（研发）活动的中外企业一直密切关注的法律领域。

过去，许多雇主通常忽视中国专利法中，对中国雇主需基于的专利授权以及后续进行的许可或转让向其员工进行财政奖励的规定。

过去，许多雇主通常忽视中国专利法中，对中国雇主需基于的专利授权以及后续进行的许可或转让向其员工进行财政奖励的规定。但现在新实施细则明确扩大了该等规定的适用范围，规定其适用在中国的所有雇主，并且强制规定了相关雇用合同没有约定奖励数额时，作为默认标准应向员工支付的具体奖励金额。因此，现在在中国以上条款的执法风险更大了。

实际上，默认安排在某种程度上可能是不利的。因此，雇主应考虑在相关雇用合同中规定明确的替代条款，从而使默认安排失效，但前提是该等替

代条款是合理的。以下更详尽的讨论了中国奖励方式最近发生的变化。

专利法的一般规定

专利法第6条和第16条（在第三次修正中未改变）规定了关于中国发明人专利所有权和报酬的一般标准。

专利法第6条规定“职务发明”系指在执行本单位的任务过程中或主要利用本单位的物质技术资源实现的发明。尽管第6条的默认标准是申请职务发明专利的权利属于雇主，申请非职务发明专利的权利属于发明人或设计人，但公司可明确不考虑默认规则，而通过合同的方式确定专利所有权和申请专利的权利。

专利法第16条规定，获得职务发明专利的公司必须在专利实施后，根据其实施应用的范围以及从该等实施中取得的经济效益，对发明人给与合理的报酬。

新实施细则

原实施细则已经详细规定了仅适用于国有企业（国有企业）的奖励支付制度，据以，员工有权根据专利授权获得一次性付款以及按百分比获得该专利实现的年收入和许可使用费。例如，原实施细则规定了以下默认安排：（1）：自授予专利日起三（3）个月内，支付不少于2,000元人民币的奖励金额，以及（2）在员工发明专利实施后，支付“合理的报酬”，报酬的金额不得低于实施专利所得的税后利润的2%，或者许可专利所得的费用的10%。

新实施细则包括了若干修订，具体如

下所示：

- 现在，奖励适用于中国的所有实体，不仅仅是国有企业。
- 自授予专利之日起三（3）个月内必须支付的奖励金额，发明专利由原来的最低2,000元调整为最低3,000元，实用新型或设计专利由原来的最低500元调整为最低1,000元。
- 上述具体规定仅在公司规章制度或雇用合同中未做具体奖励规定（即：雇主可自由执行其自己的奖励制度）时适用。

尽管某些中国公司就原实施细则中要求从实施专利所得税后利润中提取不低于2%，或者从许可专利所得费用中提取不低于10%的“合理报酬”这一默认安排十分关注，但是在新实施细则中这一规定并未改变。因此，若不存在相反规定，目前该默认安排适用中国所有的雇主。

应对新实施细则

如果雇主想要根据法律确定自己的关于员工发明的奖励制度，则雇主必须注意确保其就专利实施后向员工支付的任何报酬是合理的。

该合理性规定不仅仅包含在专利法第16条中（其中规定，奖励必须是根据专利应用的范围和雇主就专利取得的经济效益而言是合理的），国家知识产权局在其草案修正解释（国家知识产权局解释）中对此也进行了强调。国家知识产权局解释规定，无论雇主和雇员间是否有明确约定，如果约定被认为是“不合理的”，实施细则

Employees' Rewards

(Continued from Page 10)

reward must be reasonable based upon the scope and extent of application of the patent and the economic benefits it yields to the employer), but it has also been emphasized by the State Intellectual Property Office (SIPO) in its Explanation of the Draft Amendments (SIPO Explanation). The SIPO Explanation states that the detailed provisions in the Implementing Regulations (which were in draft form at the time the SIPO Explanation was issued but have since come into force) may still apply despite an express agreement between the employer and the employee, if that agreement is held to be "unreasonable".

Although a definitive interpretation of this reasonableness requirement has not yet been issued by the relevant PRC authorities and/or courts, given the attention focused upon the requirement within the legislation itself, it is questionable whether a scheme under which employees receive the same level of compensation regardless of the value of their inventions, would satisfy the new Implementing Regulations. Employers should therefore consider more sophisticated reward mechanisms to reduce the risk of claims from dissatisfied employees. Possibilities include:-

- Payment of different levels of reward, for example, a certain fixed lump sum payable for standard patents and a larger lump sum payable in respect of 'blockbuster patents' of significant economic value; and/or
- Payment of certain sums against certain triggering events, such as: (i) the filing of a patent application; (ii) the grant of a patent; (iii) the first transfer of the patent to a party outside the company group following its grant in China; and (iv) the commercial exploitation of the patent.

Whilst there is no guarantee that such mechanisms would be completely immune to challenge as each case will depend on the specific circumstances, the risk would be greatly reduced where employers can demonstrate that they have specifically addressed the issue of employee rewards and formulated a scheme that is based upon clear and objective criteria.

Such reward scheme should be documented in a company's employment agreements and set out in the Employee Handbook which should expressly state that the scheme addresses, supersedes and is in lieu of all rights of the employee to receive compensation under the Patent Law.

Provided that employees are satisfactorily rewarded for their technological achievements in accordance with the Patent Law and Implementing Regulations, it will still be possible going forward for companies to require employees to assign to them all patent rights and waive any moral rights they may have in their inventions. As a practical measure to reinforce such assignment obligation, employers should also make sure that their employment contracts contain clear disclosure obligations requiring an employee to notify the employer of all inventions (and other works) created during the course of employment that (i) are relevant to the employer's business; (ii) arise out of tasks or assignments that are part of the employee's job responsibilities; and (iii) were created using any of the company's resources (such as time, materials or space). It may also be sensible to request a list of inventions created by the employee prior to his employment to avoid any disputes over whether or not such inventions were created during the employment.

Conclusion

Following recent developments, the PRC Patent Law now requires all companies in China to compensate their employees for their inventions in accordance with specific levels of reward. Companies should note, however, that the statutory rewards are

applicable only in the absence of express provisions in the employment contracts dealing with compensation for inventions. It is highly recommended, particularly in light of significant intellectual property infringement and high turn-over of staff in China, that companies clearly document all of the respective rights of the employer and employees within the employment contracts, including provisions on rewards for employee inventions. ■

员工奖励

(Continued from Page 11)

(在国家知识产权局解释发布时，实施细则还是草案，后来才生效)中的具体规定可能仍适用。

尽管中国有关权威机构和/或法院尚未发布关于该合理性规定的最终解释，但鉴于立法本身对该规定的关注，无论发明的价值是多少，员工均获得同样补偿的方案是否符合新实施细则，这是值得探究的问题。因此，雇主应考虑更为复杂的机制以降低不满意员工进行索赔的风险。可能的方式包括：

- 针对不同的奖励等级付款，例如：对标准专利进行金额固定的一次性付款，就具有重要经济价值的‘畅销专利’进行较高额度的一次性付款；和/或
- 对若干触发事件进行付款，例如：(i) 提交专利申请；(ii) 授予专利；(iii) 在中国授权后，首次将专利转让给不属于公司的其他方；以及(iv) 对专利进行商业化实施。

虽然以上机制并不能保证该等机制完全不会遭到反对，因为每个案件都需要根据具体情况而定。但如果雇主可以表明其已明确处理了员工奖励问题并根据明确客观的标准制定了计划，则风险将被大大的降低。

该等奖励计划应写入公司的雇用协议中，并在员工手册中载明，其中应明确阐明该计划、取代并代替了员工根据专利法获得的所有补偿。

如果根据专利法及其实施细则对员工的技术成果做出了足够的奖励，则公司可要求员工向其转让所有专利权并放弃其在专利中可能享有的任何精神权。作为增强转让义务的实用方法，

雇主还应确保其雇用合同中包含明确的披露义务，要求员工向雇主通知其在受雇过程中实现的下述发明（以及其它成果），即 (i) 与雇主业务有关的发明；(ii) 因作为员工工作职责一部分的任务或委任而产生的发明；以及 (iii) 因使用公司的任何资源（例如时间、物质或空间）而创造的发明。明智的做法是向员工索要一份其受雇前实现的发明清单，从而避免出现该等发明是否是在受雇期间完成的争议。

总结

根据最近的发展，中国专利法目前要求中国的所有公司根据具体的奖励等级就员工的发明向员工做出补偿。但是，公司应注意，法定奖励仅在雇用合同中没有对发明补偿做出明确规定的情况下适用。尤其鉴于中国的众多知识产权侵权案件以及员工流动性较大，大力建议公司在雇用合同中明确规定雇主和雇员各自的权利，包括关于员工发明奖励的规定。■

IP Practice News

Recent Awards & Accolades

Morrison & Foerster's intellectual property group achieved rankings in ten categories in the annual "World IP survey" by Managing Intellectual Property. The issue, "2010 Patent Firms Of The Year," includes the World IP Survey in which the firm is ranked in ten categories, and moved higher in two categories: ITC practice and Patent Contentious (West) for which the firm earned the highest Tier 1 ranking. Our group also received the Tier 1 ranking in Copyright (West). We have also been shortlisted for Managing IP's North America Awards 2010 in the areas of United States: National: ITC Litigation, United States: West: Patent Prosecution, and United States: West: Patent Contentious.

The World IP Survey is a qualitative ranking of the leading firms in each category and reveals which

firms are rated by their peers for the strength of their expertise and the depth of their ability to service clients, according to the magazine. The survey, in its 14th year of publication, is based on hundreds of conversations with clients and practitioners worldwide.

In addition, *Managing IP* has named Morrison & Foerster's managing partner Harold McElhinny one of five finalists for its prestigious "IP Practitioner of the Year" award. The nomination recognizes Mr. McElhinny's work as among the top five IP practitioners in the U.S., and is based on the exceptional feedback *Managing IP's* journalists received from clients and colleagues while researching this year's award finalists. ■

MoFo Wins Important Open Source Jury Verdict for Novell

On March 30, 2010, a jury in federal district court in Salt Lake City, Utah returned a decisive verdict in favor of our client Novell in its seven-year dispute with The SCO Group involving the copyrights for the core UNIX computer operating system. After approximately seven hours of deliberation, the jury found that, contrary to SCO's claims, the UNIX copyrights were not transferred from Novell in a 1995 Asset Purchase Agreement. This factual determination was fatal to SCO's claim that Novell was liable to SCO for between \$115 million and \$200 million for Novell's alleged slander of SCO's claim to ownership of the UNIX copyrights.

The jury verdict confirms Novell's ownership of the UNIX copyrights and rejects SCO's claim to damages of hundreds of millions of dollars. In Novell's press release, Novell's president and CEO says: "This decision is good news for Novell, for Linux, and for the open source community. We have long contended that this effort against Linux has no foundation, and we are pleased that the jury, in a unanimous decision, agrees. I am proud of Novell's role in protecting the best interests of Linux and the open source community."

Morrison & Foerster is proud to have represented Novell, and the interests of the open source software industry, throughout this seven year dispute. ■

Morrison & Foerster Represents Yahoo! in Sale of HotJobs

On January 5, Yahoo! announced its sale of the assets of Yahoo! HotJobs (a leading online recruitment website) to Monster Worldwide, Inc. for \$225 million. A team of MoFo TTG attorneys in the San Francisco office led negotiations on the intellectual property and commercial aspects of the deal. The team also led negotiations on a three-year

commercial traffic agreement in which Monster will become Yahoo!'s provider of career and job content on the Yahoo! homepage in the United States and Canada. The transaction is expected to close sometime during the third quarter of 2010, subject to regulatory review. ■

知识产权业务新闻

最近所获奖励和荣誉

在知识产权管理杂志进行的年度“世界知识产权调查”中，美富律师事务所的知识产权部门荣登10个类别的排行榜。期刊“2010年年度专利领域最佳律所”发布了世界知识产权调查结果。本所获得其10个类别排名，并在两个排名中名次上升（ITC业务和专利诉讼（西部），名列一级）。本所知识产权部门还获得版权（西部）领域的一级排名。本所还入围知识产权管理杂志评选的2010年北美奖，具体包括以下奖项：美国（全国）：ITC诉讼，美国（西部）：专利申请以及美国（西部）：专利诉讼领域。

世界知识产权调查是对领先律所在各个类别中的定性排名，

美富为Novell公司取得对开源软件非常重要的胜诉裁决

于2010年3月30日，美国犹他州盐湖城联邦地区法院的陪审团签发了决定性的判决书，裁定本所的客户Novell公司在与SCO集团之间的争议中胜诉，该争议长达七年之久，有关核心UNIX计算机操作系统的版权。在大约七小时的论证后，陪审团的裁决与SCO提出的主张相反，Novell公司没有在1995年的资产购买协议中转让UNIX的版权。这个事实认定是对SCO主张的致命一击，SCO须向Novell公司支付1.15亿至2亿美元以赔偿由于SCO声称拥有UNIX版权而对Novell公司构成的诽谤。

陪审团的判决确定Novell公司拥有UNIX版权的所有权，并且否决SCO索取数亿美元的损害赔偿。

美富律师事务所代表雅虎！出售HotJobs

1月5日，雅虎公司宣布向Monster Worldwide, Inc.出售其资产Yahoo! HotJobs（一家领先的招聘网站），金额为2.25亿美元。美富三藩市办事处的TTG律师团队领导了此次知识产权和商业方面问题的谈判。律师团队还领

揭示了哪些律所凭借其专业技术实力以及客户服务能力而受到同行的推崇。在14年的出版发行中，该调查均是基于与世界范围内的客户和从业者进行数百次的访谈。

此外，知识产权管理杂志提名美富律师事务所的管理合伙人Harold McElhinny为“知识产权从业者年度奖”的五个入围者之一。该提名表明Harold McElhinny是美国前5名的知识产权从业者，并且是基于知识产权管理杂志记者在调研今年的年度奖入围者时从客户和从业者接受到的非同寻常的反馈。■

在Novell公司的新闻稿中，Novell公司的总裁兼首席执行官说：「这个决定对Novell、Linux和开源软件社区来说是个好消息。我们一直坚决认为对Linux操作系统的起诉是没有根据的，我们非常高兴陪审团的一致决定肯定了这一点。Novell公司在保护Linux操作系统和开源软件行业的利益中发挥了重要作用，对此我感到非常骄傲。」

美富律师事务所对能够在这七年的争议中代表Novell公司及开源软件行业的利益感到十分荣幸。■

导了三年商业业务协定的谈判，在该协议中，Monster将成为雅虎公司美国和加拿大主页上职业和工作内容的提供商。受限于监管审查，此次交易预计在2010年第三季度交割。■

IP Practice News

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Morrison & Foerster Launches iPhone Mobile Application “MoFo2Go”

Continuing the firm’s tradition of innovation, Morrison & Foerster has launched one of the first iPhone applications created by a major law firm. MoFo2Go is a multi-function app designed for on-the-go professionals and is available for free through iTunes. To download, go to the app store in iTunes and search “MoFo2Go.”

The app’s four functional areas are “People,” “News,” “Locations,” and “Play.” “People” allows users to view short bios of all attorneys who are on the MoFo website and is searchable by practice/industry, office location,

or law school. In the “News” section, users can view our client alerts, press releases and newsletters — plus special content from our award-winning magazine *MoFo Tech*. “Locations” has important information about our offices and includes handy guides to the nearest transportation hubs, hotels, and restaurants. Then there’s the “Play” function — MoFo Maze — a game that challenges users to progress through four levels of increasing difficulty. ■

知识产权业务新闻

(Continued from Page 15)

美富律师事务所推出iPhone 移动应用程序 “MoFo2Go”

秉承本所创新的传统，美富推出了最早由大型律所创建的iPhone应用程序之一。MoFo2Go是一款为移动工作的专业人士设计的多功能应用程序，可以通过iTunes免费获得。欲下载，需进入iTunes的应用程序保存页面，然后搜索“MoFo2Go。”

此应用程序的4个功能为“人员”、“新闻”、“地点”以及“游戏”。“人员”可以让用户浏览美富网站上所有律师的简介，而且可以通过业务/行业、办公

地点或者法学院等关键字进行搜索。在“新闻”区，用户可以浏览我们的客户提示、新闻发布以及通讯—以及本所获奖杂志美富技术（MoFo Tech）中的具体内容。“地点”拥有关于本所办事处的重要资讯并包括最近交通枢纽、酒店和饭店的便利指南。“游戏”功能—MoFo Maze—是一款通过4个不同难易程度的等级来挑战用户的游戏。■

This newsletter addresses recent intellectual property updates. Because of its generality, the information provided herein may not be applicable in all situations and should not be acted upon without specific legal advice based on particular situations. If you wish to change an address, add a subscriber, or comment on this newsletter, please email Michael Zwerin at mzwerin@mofo.com in Palo Alto, David Harvey at dharvey@mofo.com in Washington, D.C. or Priscilla Chen at priscillachen@mofo.com in Greater China.

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