

最高人民法院知识产权法庭

裁判要旨(2021)

**Judgment Digests of the Intellectual Property Court  
of the Supreme People's Court (2021)**

最高人民法院知识产权法庭 编

Edited by the Intellectual Property Court of the Supreme  
People's Court

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为集中展示最高人民法院知识产权法庭在技术类知识产权和垄断案件中的司法理念、审理思路和裁判方法，法庭从2021年审结的3460件案件中，精选48个典型案例，提炼55条裁判要旨，形成《最高人民法院知识产权法庭裁判要旨（2021）》，现予发布，供社会各界研究和参考。

*The Judgment Digests of the Intellectual Property Court of the Supreme People's Court (2021) (the Digests) is hereby released to the public for research and reference. The Digests include 55 judgment digests extracted from 48 typical cases selected from a total of 3,460 cases concluded by the Intellectual Property Court (the IPC) of the Supreme People's Court (the SPC) in 2021. The Digests collectively demonstrate the judicial philosophy, ideology and methods of the IPC in dealing with technology-related intellectual property cases and monopoly cases.*

## 一、专利行政案件

### I. Administrative Patent Cases

#### 1. 权利要求用语解释的合理性

#### **Reasonable interpretation of the terms in a patent claim**

#### **【裁判要旨】**

## **[Judgment Digest]**

在专利授权确权案件中，应当以本领域技术人员在阅读权利要求书、说明书及附图后所理解的通常含义，界定权利要求的用语。在此过程中，应当以合理解释为出发点和落脚点，确定权利要求用语的最大含义范围。

In a dispute over patent granting and validity affirmation, terms of a patent claim shall be given their plain and ordinary meaning apprehended by a person skilled in the art after reading the claims, description and drawings. In this process, the court shall determine the broadest scope of the terms sticking to reasonable interpretation.

## **【关键词】**

### **[Keywords]**

发明专利 无效宣告程序 权利要求的解释 最大合理解释

invention patent; invalidation procedure; claim interpretation;

broadest reasonable interpretation

## **【案号】**

### **[Case Number]**

(2019) 最高法知行终 61 号

(2019) SPC IP Admin. Final 61

## **【基本案情】**

### **[Case Facts]**

在上诉人西门子（深圳）磁共振有限公司（以下简称西门子公

司) 与上诉人国家知识产权局、上诉人上海联影医疗科技有限公司(以下简称联影公司) 专利权无效行政纠纷案中, 联影公司是专利号为 201310072198.X、名称为“平面回波成像序列图像的重建方法”的发明专利(以下简称本专利) 的专利权人。西门子公司以本专利不具备实用性、新颖性、创造性以及权利要求得不到说明书支持为由, 向国家知识产权局提出无效宣告请求。国家知识产权局作出第 33719 号无效宣告请求审查决定(以下简称被诉决定) 维持本专利权有效。西门子公司不服, 向北京知识产权法院(以下简称一审法院) 提起诉讼。一审法院认为本专利权利要求 1 不具备新颖性, 判决撤销被诉决定, 国家知识产权局重新作出决定。西门子公司、国家知识产权局、联影公司均不服, 向最高人民法院提起上诉。最高人民法院于 2021 年 5 月 21 日判决撤销原判, 驳回西门子公司诉讼请求。

In the administrative dispute over patent invalidation between the appellants Siemens (Shenzhen) Magnetic Resonance Ltd. (Siemens), the China National Intellectual Property Administration (the “CNIPA”) and Shanghai United Imaging Healthcare Co., Ltd. (“UIH”), UIH owns an invention patent No. 201310072198.X, titled "Echo planar imaging sequence image reconstruction method" (the involved patent). Siemens filed a request for invalidation at the CNIPA on the grounds that the involved patent was lack of utility, novelty, and inventive step, and that the claims were not supported by the description. The CNIPA

made the No. 33719 Decision on the Invalidation Request (the Disputed Decision) to maintain the validity of the involved patent. Not satisfied with the Disputed Decision, Siemens filed a lawsuit in the Beijing Intellectual Property Court (the Court of First Instance). The Court of First Instance held that claim 1 of the involved patent was lack of novelty and made a judgment to annul the Disputed Decision and ordered the CNIPA to redecide. Not satisfied with the first-instance judgment, Siemens, CNIPA and UIH all appealed to the SPC. On May 21, 2021, the SPC vacated the first-instance judgment and rejected Siemens' pleadings.

### **【裁判意见】**

#### **[Judge's Opinion]**

最高人民法院二审认为，人民法院应当以本领域技术人员在阅读权利要求书、说明书及附图后所理解的通常含义，界定权利要求的用语。权利要求的用语在说明书及附图中有明确定义或者说明的，按照其界定。即便在适用所谓的最大合理原则解释权利要求时，亦应当在权利要求用语最大含义范围内，以“合理”解释为出发点和落脚点。本案中本专利权利要求1中“计算”一词的解释，不应当简单以其字面含义为准，而应当以本领域技术人员阅读权利要求书和说明书及附图后的理解为准。结合本专利发明目的、说明书及附图对“计算”的解释与说明可知，本专利中的“计算”并不包括所有可能的计算方式，而是有其特定含义。

首先，本专利在背景技术及发明内容部分指出，现有技术通过第一个和第二个回波信号计算出相位差异，把这些相位差作为校正量来校正采集到的图像数据，并不能有效消除  $N/2$  伪影；二维相位校正法消除  $N/2$  伪影的效果虽比较好，但序列采集时间延长，平面回波成像序列失去了快速成像的优点。本专利为了克服上述缺陷，意在提供一种更为精准的平面回波成像序列的图像重建方法。可见，本专利的发明目的已经明确排除了两个回波信号计算相位差异因而损失相位信息的计算方法。其次，本领域技术人员通过阅读说明书及附图能够理解，本专利权利要求 1 中的“计算”是不损失相位以及其他信息情况下的直接计算，不应当将“计算”一词根据字面含义进行解释。对比文件 1 的计算方式将损失第一参考回波  $S1+$  和第三参考回波  $S3+$  中的部分信息，导致校正的精准度有所欠缺，而这正是本专利所要避免的。可见，对比文件 1 中的“计算”与本专利权利要求 1 中的“计算”并不相同。对比文件 1 并没有公开本专利权利要求 1 中不损失相位信息及其他信息情况下的直接计算方式。因此，本专利权利要求 1 具备新颖性。

In the second instance, the SPC held that people's court should define the terms used in the claims based on the plain meaning apprehended by a person skilled in the art after reading the claims, description and drawings. If terms of the claims are explicitly defined or described in the description and drawings, such definition or

description should apply. Even when the claims are interpreted in the principle of broadest reasonable interpretation, the "reasonable" interpretation should always be the purpose within the maximum scope of meaning of the terms of the claims. In this case, the word "calculation" used in claim 1 of the involved patent should be the meaning given by a person skilled in the art after reading the claims, description and drawings, not the meaning simply interpreted based on its literal meaning. Seen from the invention purpose as well as interpretation and explanations of the word "calculation" in the description and drawings, the "calculation" in the involved patent has a specific meaning, not includes all possible calculation methods. Firstly, according to the background art and summary of the involved patent, the prior art calculates phase differences with the first and second echo signals and uses such phase differences as the correcting value to correct the collected image data, but it fails to effectively eliminate  $N/2$  Ghost; the two-dimensional phase correction method does rather well in eliminating  $N/2$  Ghost, but it takes more time for sequence acquisition. As a result, the echo planar imaging sequence loses its advantage of fast imaging. To address the above shortcomings, the involved patent intends to provide a more accurate image reconstruction method for echo planar imaging sequences. Obviously, the invention purpose of the involved patent has expressly excluded the

method of calculating the phase difference with two echo signals that causes the loss of phase information. Secondly, a person skilled in the art can understand by reading the description and drawings that the “calculation” in claim 1 of the involved patent refers to the direct calculation without loss of phase information and other information, so the word "calculation" should not be interpreted literally. The calculation method in reference document 1 will lose part of the information in the First Reference Echo S1+ and the Third Reference Echo S3+, resulting in a decrease in correction accuracy, which is what the involved patent intends to avoid. It can be seen that the "calculation" in reference document 1 differs from that in claim 1 of the involved patent. reference document 1 does not disclose the direct calculation method without loss of phase information and other information in claim 1 of the involved patent. Therefore, claim 1 of the involved patent is of novelty.

## 2. 限定机械部件数量的数值范围技术特征的新颖性评价

### **Novelty of a technical feature with numerical range limiting**

#### **the number of mechanical parts**

#### **【裁判要旨】**

#### **[Judgment Digest]**

限定机械部件数量的数值范围是自然数区间，其区别于长度等具有连续性物理量的数值范围；限定机械部件数量的数值范围技术特征原则上应当视为并列技术手段的集合而非一个技术手段，当对比文件仅公开其中一个或者部分数量时，不足以认定该对比文件已经直接公开了该技术特征所限定的其余并列技术手段。

As an interval of natural numbers, the numerical range limiting the number of mechanical parts differs from the numerical range of continuous physical quantities such as length. The numerical range limiting the number of mechanical parts as a technical feature should in principle be regarded as a collection of parallel technical solutions rather than a single technical solution. Where only one number or part of the aforesaid numerical range is disclosed in a prior art reference, it is not adequate to determine that the prior art reference has directly disclosed the rest parallel technical solutions limited by the technical feature.

**【关键词】**

**[Keywords]**

发明专利 驳回复审程序 新颖性 数值范围技术特征  
并列技术手段

invention patent; reexamination procedure of rejection; novelty;  
numerical range as a technical feature; parallel technical solution

**【案号】**

## **[Case Number]**

(2021) 最高法知行终 349 号

(2021) SPC IP Admin. Final 349

## **【基本案情】**

### **[Case Facts]**

在上诉人苏社芳与被上诉人国家知识产权局发明专利申请驳回复审行政纠纷案中，涉及申请号为 201410141800.5、名称为“三轮摩托车、电动三轮车及柴油三轮车辆的人力制动构造”的发明专利申请（以下简称本申请），申请人为苏社芳。经实质审查，国家知识产权局原审查部门作出驳回本申请的决定。针对苏社芳提出的复审请求，国家知识产权局作出第 183664 号复审请求审查决定（以下简称被诉决定），维持原驳回决定。被诉决定认为，权利要求 1、3、4、5、7、9 的全部技术特征均被对比文件 1 公开，不具备新颖性；权利要求 2、6、8、10 不具备创造性。苏社芳认为，本申请明确限定“至少包含二个杠杆”，对比文件 1 限定的技术方案杠杆数量为四个，其不包括二个杠杆也不包括三个或四个以上的杠杆的技术方案，两者的技术方案不相同，在此基础上本申请各项权利要求应具备新颖性和创造性，故向北京知识产权法院（以下简称一审法院）提起诉讼，请求撤销被诉决定。一审法院判决驳回苏社芳的诉讼请求。苏社芳不服，向最高人民法院提起上诉，主张本申请与对比文件 1 在包含的杠杆数量等技术特征方面存在不同，不能依照数值和数值范围的审查原则来判断本申请的新颖性。最

高人民法院于 2021 年 6 月 27 日在纠正一审法院的新颖性判断思路的基础上，判决驳回上诉，维持原判。

The administrative dispute over the reexamination of rejected invention patent application between the appellant Su Shefang and the appellee China National Intellectual Property Administration (the “CNIPA”) involves an application for patenting the invention (the involved patent application) No. 201410141800.5 and titled "Manual braking's structure of motor-tricycle, electro-tricycle and diesel oil powered three-wheeled vehicle" filed by Su Shefang. Upon substantive examination, the examination department of the CNIPA made a decision to reject the involved patent application. The CNIPA made the No. 183664 Reexamination Decision on the Request (the Disputed Decision) to remain the foresaid decision. According to the Disputed Decision, all the technical features of claims 1, 3, 4, 5, 7, and 9 are not novel because they are disclosed in reference document 1, and claims 2, 6, 8, and 10 are not inventive. According to Su Shefang, this application offers a technical solution that "uses at least two levers", while the technical solution in reference document 1 uses four levers and excludes the usage of two, or three or more than four levers. In this case, this application differs from reference document 1 in the technical solution, so the claims of this application should be deemed novel and inventive. Su Shefang filed a lawsuit in Beijing Intellectual

Property Court (the Court of First Instance) on these grounds to revoke the Disputed Decision. The Court of First Instance rejected Su Shefang's pleadings. Not satisfied with the first-instance judgment, Su Shefang appealed to the SPC on the grounds that the involved patent application differs from reference document 1 in technical features such as the number of levers and that whether the involved patent application is novel should not be determined according to the reexamination principles of numerical values and numerical ranges. On June 27, 2021, the SPC rejected the appeal and upheld the first-instance judgment while correcting the view of the Court of First Instance on novelty assessment.

### **【裁判意见】**

#### **[Judge's Opinion]**

最高人民法院二审认为, 机械部件的数量是自然数, 这与长度、温度、压力、含量、时间等具有连续性的物理量存在区别, 故对于限定机械部件数量的数值范围技术特征的理解, 应当区别于限定具有连续性的物理量的数值范围技术特征。对于后者, 其应视为一个技术特征, 当对比文件公开的数值或者数值范围落在上述限定的技术特征的数值范围内, 即可认定对比文件已经公开了该技术特征。但是对于限定机械部件数量的数值范围技术特征, 应当视为并列技术手段的集合, 当对比文件仅公开其中一个或者部分数量时, 不足以认定该对比文件已经公开了该技术特征所限定的

其余并列技术手段。

In the second instance, the SPC held that being a natural number, the number of mechanical parts differs from continuous physical quantities such as length, temperature, pressure, content, and time, so the understanding of the numerical range limiting the number of mechanical parts as a technical feature should be differentiated from that of the numerical range limiting a continuous physical quantity as a technical feature. The latter should be regarded as a single technical feature. When the numerical value or numerical range disclosed in the prior art reference falls within the aforesaid numerical range of the limited technical feature, it should be determined that the prior art reference has disclosed the technical feature. But the numerical range limiting the number of mechanical parts as a technical feature should be regarded as a collection of parallel technical solutions. When only one or part of the number is disclosed in the prior art reference, it is not adequate to determine that the prior art reference has disclosed the rest parallel technical solutions limited by the technical feature.

本申请权利要求中“至少包含二个杠杆”数值范围技术特征限定的对象是杠杆数量，故该技术特征应当视为并列技术手段的集合。就本申请权利要求 1、3、4、5、7、9 中采用四个杠杆的技术方案而言，对比文件 1 公开的杠杆数量为四个，四个杠杆的技术方案已经被对比文件 1 直接公开，不具备新颖性。但在无证据证明

本申请权利要求 1、3、4、5、7、9 中非四个杠杆的技术手段与四个杠杆的技术手段之间存在惯用手段直接置换关系的情况下，本申请权利要求的非四个杠杆技术方案与最接近的现有技术公开的四个杠杆技术方案之间存在明显区别。被诉决定和一审判决忽略了杠杆数量技术特征的区别，认为对比文件 1 已经公开本申请权利要求 1、3、4、5、7、9 的所有技术特征，从而认定不具备新颖性，本质上属于遗漏区别技术特征，或者是将本申请的“至少包含二个杠杆”的技术特征，等同于限定具有连续性物理量的数值范围技术特征，从而认定现有技术的“四个杠杆”公开了本申请“至少包含二个杠杆”的技术特征，并最终作出非四个杠杆的技术方案不具备新颖性的不当认定，应予纠正。鉴于该不当认定并未影响到本申请不应予以授权的最终结论，故被诉决定以及一审判决可予以维持。

The object limited by the numerical range as a technical feature – “at least two levers” – in the claims of the involved patent application is the number of levers, so the technical feature should be regarded as a set of parallel technical solutions. As the technical solution with four levers are already disclosed in reference document 1, the technical solution with four levers in claims 1, 3, 4, 5, 7 and 9 of the involved patent application are not novel. But if there is no evidence showing that there is a direct substitution relationship between the technical solutions that do not use four levers and that use four levers in claims

1, 3, 4, 5, 7 and 9 of the involved patent application, there is a remarked difference between the technical solution not using four levers as stated in claims of the involved patent application and that using four levers disclosed in the closest prior art. The Disputed Decision and the first-instance judgment should be corrected because they do not take into consideration differences in the number of levers as a technical feature. According to them, the involved patent application is not novel because reference document 1 has disclosed all the technical features as stated in claims 1, 3, 4, 5, 7 and 9 of the involved patent application. In nature, they omit distinguishing technical features or equate the technical feature of "at least two levers" in the involved patent application with numerical range limiting continuous physical quantities as a technical feature. On such bases, they determine that the prior art of "four levers" disclosed the technical features of "at least two levers", and inaccurately determine that the technical solution not using four levers is not novel, which should be corrected. Considering that the improper determination did not affect the final conclusion that the involved patent application should not be granted, the Disputed Decision and the first-instance judgment were upheld.

### 3. 新颖性单独比对原则

## **The principle of single prior art reference to determine**

### **novelty**

#### **【裁判要旨】**

#### **[Judgment Digest]**

如果本领域技术人员对一份现有技术文献作整体性解读后可以直接地、毫无疑义地确定，记载于该文献不同部分的技术内容之间存在属于同一技术方案的逻辑关系，将该不同部分的技术内容共同构成的技术方案作为新颖性判断的比对对象，不违反单独比对原则。

Where after reading a prior art document as a whole, a person skilled in the art can directly and unambiguously derives that there is a logical relationship attributable to the same technical solution between the technical content in different sections of the document, taking the technical solution composed of the technical content in different sections as the object of comparison for novelty determination is in line with the principle of separate comparison.

#### **【关键词】**

#### **[Keywords]**

发明专利申请 驳回复审程序 新颖性 单独对比

invention patent application; reexamination procedure of rejection; novelty; separate comparison

## 【案号】

### [Case Number]

(2021) 最高法知行终 83 号

(2021) SPC IP Admin. Final 83

## 【基本案情】

### [Case Facts]

在上诉人巴斯夫涂料有限公司（以下简称巴斯夫公司）与被上诉人国家知识产权局发明专利申请驳回复审行政纠纷案（以下简称“次硝酸铋”专利授权行政纠纷案）中，涉及申请号为 201510452769.1、名称为“次硝酸铋在电泳漆中的应用”的发明专利申请（以下简称本申请）。巴斯夫公司认为，国家知识产权局作出的第 183507 号复审请求审查决定（以下简称被诉决定）在评述本申请权利要求 1 的新颖性时，引用了对比文件 1 说明书多个段落的内容进行评述，上述内容既涉及产品又涉及方法，且涉及不同可选项的多种组合，因此上述内容应属于多项技术方案，不符合新颖性的单独对比原则；虽然对比文件 1 公开了水不溶性的碱式硝酸铋在阴极电泳漆中的应用，但根据对比文件 1 所记载的发明目的，对比文件 1 的技术方案是用水溶性金属硝酸盐替换其背景技术中使用的水不溶性硝酸盐而实现粘合力的改善，故对比文件 1 关于水不溶性的碱式硝酸铋的公开内容违反了其发明目的，不能以错误公开的内容评价本申请的新颖性。故向北京知识产权法院（以下简称一审法院）提起诉讼，请求判令撤销被诉决定，国

家知识产权局重新作出决定。一审法院认为被诉决定对比方式符合单独对比原则；对比文件 1 对于水溶性硝酸盐范围的理解包括碱式硝酸铋，虽然该理解不同于本领域对碱式硝酸铋是非水溶性的理解，但其可理解为对比文件 1 的重新定义，并不会因为该定义与本领域常规解释不一致就认为对比文件 1 并未公开碱式硝酸铋。对比文件 1 公开了本申请权利要求 1 的全部技术特征，二者的技术方案相同，技术领域相同，能解决相同的技术问题并产生相同的技术效果。因此，本申请权利要求 1 不具备新颖性。一审法院判决驳回巴斯夫公司诉讼请求。巴斯夫公司不服，向最高人民法院提起上诉。最高人民法院认定上述对比方式符合单独对比原则，但基于一审法院关于新颖性的认定错误，于 2021 年 11 月 2 日判决撤销原判和被诉决定，国家知识产权局重新作出决定。

The administrative dispute over the reexamination of rejected invention patent application between the appellant BASF Coatings Co., Ltd. ("BASF") and the appellee China National Intellectual Property Administration (the "CNIPA") involves an application for invention patent (the involved patent application) No. 201510452769.1, titled "Use of bismuth subnitrate in electro-dipping paints" ("the Bismuth Subnitrate" patent authorization case). BASF held that CNIPA's No. 183507 Reexamination Decision on the Reexamination Request (the Disputed Decision) commented on the novelty of claim 1 of the involved patent application by citing several

paragraphs in the description of reference document 1. These paragraphs cover products, methods as well as various combinations of different options, so they should be deemed as multiple technical solutions. Therefore, the Disputed Decision does not conform to the principle of separate comparison in determining the novelty. Although reference document 1 discloses the application of water-insoluble bismuth subnitrate in cathodic electrophoretic paints, according to the purpose specified in reference document 1, the technical solution disclosed in reference document 1 is designed to replace the water-insoluble nitrate used in its background art with water-soluble metal nitrate for better adhesion. Therefore, the disclosure of the water-insoluble bismuth subnitrate in reference document 1 is against the purpose and the novelty of the involved patent application cannot be determined with the wrong disclosure. Given the above, a lawsuit was filed with the Beijing Intellectual Property Court (the Court of First Instance) to revoke the Disputed Decision and to order the CNIPA to make a new decision. The Court of First Instance held that the comparison method applied in the Disputed Decision complies with the principle of separate comparison. The scope of water-soluble nitrate interpreted in reference document 1 covers bismuth subnitrate. Although such interpretation is different from the understanding in the art that bismuth subnitrate is water-insoluble, but it can be seen as a

redefinition specific to reference document 1. reference document 1 should not be deemed to have not disclosed bismuth subnitrate due to the inconsistency between the redefinition and the conventional interpretation in the art. reference document 1 discloses all the technical features of claim 1 in the involved patent application. reference document 1 and the involved patent application offer the same technical solution in the same technical field to solve the same technical problems and achieve the same technical outcomes. Therefore, claim 1 of the involved patent application is deemed not to be novel. The Court of First Instance hence rejected BASF's pleadings. Not satisfied with the first-instance judgment, BASF appealed to the SPC. The SPC determined that the above-mentioned comparison method conforms to the principle of separate comparison. But given the wrong determination of novelty by the Court of First Instance, on November 2, 2021, the SPC decided to revoke the first-instance judgment and the Disputed Decision and order the CNIPA to redecide.

### **【裁判意见】**

#### **[Judge's Opinion]**

最高人民法院二审认为，在新颖性判断中遵循单独对比原则的意义在于，能够确保与专利要求保护的技术方案进行对比的现有技术属于申请日之前已客观存在的技术方案。如果用于与专利技术方案对比的技术方案是由若干个现有技术组合而得到的、仅

存在于观念中的技术方案，则这种对比方式及其判断结论的性质，已经超出新颖性判断的范畴，而属于创造性判断的范畴。基于此，新颖性判断过程是否遵循单独对比原则，取决于与专利技术方案进行对比的技术方案是否确属于申请日前已经公开并客观存在的技术方案，而不在于该技术方案在现有技术文献中的记载方式。如果本领域技术人员对一份现有技术文献进行整体性地解读后可以直接地、毫无疑义地确定，那些记载于该文献不同部分的各项技术内容之间存在着归属于同一技术方案的逻辑关系，则可以认定由前述各技术内容共同构成的整体技术方案即为该现有技术文献公开的技术方案，将专利权利要求与上述各技术内容共同构成的整体技术方案相比较，不违反单独对比原则。

In the second instance, the SPC held that the significance of following the principle of separate comparison in the determination of novelty is to ensure that the prior art compared with the technical solution disclosed in the patent is a technical solution that exists objectively before the date of application. If the technical solution used to compare with the technical solution to be patented is a combination of several prior arts and only exists as a concept, then the comparison method and the nature of the determination conclusion are beyond the determination of novelty, but fall into the determination of inventive step. In view of this, whether novelty determination follows the principle of separate comparison depends on whether the technical

solution compared with the technical solution to be patented has been disclosed and objectively exists before the date of application, rather than how the technical solution is disclosed in prior art documents. Where after interpreting a prior art document as a whole, a person skilled in the art can directly and unambiguously derives that there is a logical relationship attributable to the same technical solution between the technical content recorded in different sections of the document, it can be determined that the overall technical solution composed of the aforementioned technical content is the technical solution disclosed in the prior art document, and comparing patent claims with the overall technical solution composed of the above technical content is in line with the principle of separate comparison.

本案中，对比文件 1 系一份欧洲专利文献，该专利文献所记载的是一种“通过阴极电沉积涂覆在导电基材上制备涂层的方法”。被诉决定所引用对比文件 1 的说明书第[0015][0016][0020][0034][0038]段中的相关内容，系该专利方法实施过程中所涉及的涂料组合物的成份、配比、制备过程以及涂料如何形成涂层的工艺方法等技术内容，这些技术内容没有在对比文件 1 中予以集中记载，属于从各具有可选步骤中分别择取的部分技术内容，但本领域技术人员在系统性地解读对比文件 1 后容易理解，上述分散在各段中的技术内容，系对比文件 1 所要保护的专利技术方案的各组成部分，彼此之间存在着归属于同一技术方案的逻辑关系。

因此，被诉决定所引用的对比文件 1 说明书前述各段落公开的相关内容所共同构成的整体技术方案，应认定为属于在本申请优先权日前即已被对比文件 1 公开的技术方案，而非在多个现有技术方案的基础上重新组合而成的新的技术方案，被诉决定将其与本申请权利要求 1 相比较，不违反新颖性判断所要求的单独对比原则。

In this case, as a European patent document, reference document 1 describes a "Process for producing coatings on electrically conductive substrates by cathodic electrodeposition coating". The content in paragraphs [0015][0016][0020][0034][0038] of the description of reference document 1 cited in the Disputed Decision is the technical content involved in the implementation of the method to be patented, such as components, proportions and preparation process of the coating compound and the process of producing coatings with coating materials. Such technical content does not appear in reference document 1 in a concentrated manner, but it is part of the technical content selected from each optional step. However, a person skilled in the art, after systematically interpreting reference document 1, can easily understand that the above technical content in different paragraphs are components of the patented technical solution in reference document 1, and that there is a logical relationship attributable to the same technical solution between them. Therefore,

the overall technical solution composed by the relevant content disclosed in the foresaid paragraphs of the description in reference document 1 cited in the Disputed Decision should be regarded as the technical solution disclosed in reference document 1 before the priority date of the involved patent application, rather than a new technical solution that is formed based on multiple existing technical solutions. Hence, the Disputed Decision complies with the separate comparison principle required by novelty determination when comparing it with claim 1 of the involved patent application.

#### 4. 同一现有技术文献中存在矛盾记载时公开内容的认定

### **Identification of the content disclosed with inconsistent records in the same prior art document**

#### **【裁判要旨】**

#### **[Judgment Digest]**

同一现有技术文献所记载的特定技术方案内容与其所记载的其他关联内容存在矛盾，本领域技术人员完整阅读文献后，结合公知常识亦不能作出合理解释或者不能判断其正误的，可以认定该现有技术文献未公开上述特定技术方案。

If there is an inconsistency between the specific technical solution and other related content in the same prior art document, if a person

skilled in the art cannot make a reasonable interpretation or decide whether it is correct or not, even with reference to common knowledge after reading the document thoroughly, it can be determined that the aforementioned specific technical solution is not disclosed in the prior art reference.

### **【关键词】**

#### **[Keywords]**

发明专利申请 驳回复审程序 新颖性 现有技术 矛盾记载

invention patent application; reexamination procedure of rejection; novelty; prior art; inconsistent record

### **【裁判意见】**

#### **[Judge's Opinion]**

在前述“次硝酸铋”专利授权行政纠纷案件中，最高人民法院指出，以出版物公开方式公开的现有技术，其技术方案的内容以该出版物的客观记载为准。但是，如果该出版物关于该技术方案的记载内容与其他关联内容存在明显前后矛盾，且本领域技术人员根据该出版物记载的其他内容以及其掌握的本领域的公知常识无法给出合理解释的，则不能认定该技术方案被该出版物所公开，即不能构成《中华人民共和国专利法》（以下简称专利法）意义上的现有技术。

In the aforementioned administrative dispute over the patent authorization related to "bismuth subnitrate", the SPC held that the

technical solution of the prior art disclosed in a publication is subject to the objective record of the publication. But if there is apparent inconsistency between the content of the technical solution and other related content in the publication, and a person skilled in the art cannot give a reasonable interpretation based on the rest content in the publication and their common knowledge in the field, it cannot be determined that the technical solution is disclosed in the publication. In other words, it is not the prior art as defined in the *Patent Law of the People's Republic of China* (the "Patent Law").

本案中，根据对比文件 1 说明书第[0007]-[0010]段关于发明背景部分的记载内容，对比文件 1 所记载的专利技术方案所采用的金属硝酸盐添加剂，应当理解为其具有水溶性的物理性质。相应地，作为记载在对比文件 1 的说明书第[0015][0016][0020][0034][0038]段中，用于具体说明对比文件 1 所记载的专利技术方案的具体实施方案，也应当理解为采用的是具有水溶性的金属硝酸盐。然而，在对比文件 1 的说明书第[0020]段中却记载了采用碱式硝酸铋这一水不溶性的金属硝酸盐的技术方案，明显与对比文件 1 第[0010]段所记载的技术构思存在矛盾。由于对比文件 1 的其他部分并没有就碱式硝酸铋这一水不溶性的金属硝酸盐也能够实现对比文件 1 所记载的专利技术方案的发明目的作出特别说明（事实上，从对比文件 1 记载内容来看，对比文件 1 将碱式硝酸铋当做水溶性的金属硝酸盐予以对待），亦无其他证据能够对上述明显

的矛盾作出合理解释，故对比文件 1 记载的采用碱式硝酸铋添加剂的技术方案，应当被排除在对比文件 1 公开的范围之外，不应当被认定为属于现有技术。被诉决定和一审判决均以客观公开为由，在没有给出足够的合理解释的情况下，将对比文件 1 中相关段落记载的、与同记载在对比文件 1 中的其他关联内容存在明显前后矛盾的技术方案认定为现有技术，系对出版物公开这种公开方式的机械理解，应予纠正。

In this case, according to the description on the background of the invention in paragraphs [0007]-[0010] of the reference document 1, the metal nitrate additive used in the patented technical solution in reference document 1 should be interpreted to be water-soluble in terms of physical property. Correspondingly, recorded in paragraphs [0015][0016][0020][0034][0038] of the description of reference document 1, the specific implementation plan used to specify the patented technical solution disclosed in reference document 1 should also be interpreted to use water-soluble metal nitrate. However, the paragraph [0020] of the description of reference document 1 describes the technical solution that uses the water-insoluble metal nitrate – bismuth subnitrate, which obviously contradicts with the technical concept in paragraph [0010] of reference document 1. The rest sections of reference document 1 do not specify that the water-insoluble metal nitrate (bismuth subnitrate) can also achieve the purpose of the

patented technical solution disclosed in reference document 1 (in fact, as recorded in reference document 1, bismuth subnitrate is treated as water-soluble metal nitrate in reference document 1), and there is no other evidence to reasonably explain the above apparent inconsistency. So the technical solution that makes use of bismuth subnitrate additive disclosed in reference document 1 should be excluded from the scope of disclosure of reference document 1 and should not be regarded as the prior art. Without sufficient reasonable explanation and on the ground of objective disclosure, both the Disputed Decision and the first-instance judgment identify the technical solution as prior art, even though its content in relevant paragraphs in reference document 1 contradicts with other related content also in reference document 1. They interpreted this disclosure method in a mechanical way, so they should be corrected.

## 5. 中药发明专利创造性判断中最接近的现有技术的选择

### **Selection of the closest prior art in determining inventive step of a traditional Chinese medicine (TCM) invention patent**

#### **【裁判要旨】**

#### **[Judgment Digest]**

中药发明专利创造性判断中，对于最接近现有技术的选择，

不宜过度关注现有技术披露的发明技术特征数量, 如药味重合度而应当根据中药领域技术特点, 特别是配伍组方、方剂变化、药味功效替代等规律, 综合考虑发明技术方案和现有技术方案的适应症及有关治则、治法、用药思路是否相同或者足够相似。

In determining the inventive step of a traditional Chinese medicine (TCM) invention patent, the selection of the closest prior art should not pay much attention to the number of technical features of the invention disclosed in the prior art, such as the percentage of the same herbal medicines. Instead, it is necessary to comprehensively consider whether the indications as well as relevant treatment principles, treatment methods and medication ideas of the technical solution described in the invention are the same as or sufficiently similar to those of the prior art, based on the technical features of the TCM field, especially the compatibility and composition of medicines, changes in prescription and efficacy substitution of herbal medicines.

**【关键词】**

**[Keywords]**

发明专利申请 驳回复审程序 中药 创造性  
最接近的现有技术

invention patent application; reexamination procedure of rejection; TCM; inventive step; the closest prior art

## **【案号】**

### **[Case Number]**

(2021) 最高法知行终 158 号

(2021) SPC IP Admin. Final 158

## **【基本案情】**

### **[Case Facts]**

在上诉人罗世琴与被上诉人国家知识产权局发明专利申请驳回复审行政纠纷案（以下简称药磁贴专利授权行政纠纷案）中，涉及申请号为 201410046681.5、名称为“用于治疗肿瘤的药磁贴”的发明专利申请（以下简称本申请）。国家知识产权局作出第 182491 号复审请求审查决定（以下简称被诉决定），认为本申请权利要求 1 请求保护用于治疗肿瘤的药磁贴的制备方法，对比文件公开了一种用于肿瘤消肿镇痛的纳米药磁贴及其制备方法，本领域技术人员根据“方从法出”的原则，能够在对比文件的基础上进行调整得到本申请的技术方案，且本申请对于中药材、制备方法、药磁贴具体组成和结构的选择均为本领域的常规选择，在对比文件的基础上结合常规选择能够得到本申请的技术方案，因此本申请不具备创造性。罗世琴不服，诉至北京知识产权法院（以下简称一审法院），请求撤销被诉决定，判令国家知识产权局重新作出决定。一审法院判决驳回罗世琴的诉讼请求。罗世琴不服，向最高人民法院提起上诉，称一审判决错误认定本申请权利要求 1 相对于最接近现有技术的区别技术特征，本申请与对比文

件比较，二者之间明显存在药物配伍不同、构造结构不同、形成剂型类别不同等区别，本申请具备创造性。最高人民法院于 2021 年 10 月 20 日判决驳回上诉，维持原判。

The administrative dispute over the reexamination of rejected invention patent application between the appellant Luo Shiqin and the appellee China National Intellectual Property Administration (the “CNIPA”) involves an application for invention patent No. 201410046681.5, titled "Medicinal magnetic plaster for treating tumors" (the involved patent application) (the “magnetic therapy plaster patent authorization case”). The CNIPA made the No. 182491 Reexamination Decision on the Reexamination Request (the Disputed Decision). According to the Disputed Decision, the patent application at issue does not involve an inventive step on the following grounds: claim 1 of the involved patent application requests for protecting the method to prepare a therapy plaster for tumor treatment, while the prior art reference discloses a nano medicine magnet therapy plaster for relieving swelling and easing pain and its preparation process. A person skilled in the art can produce the technical solution disclosed in the involved patent application by making adjustments to the prior art reference in the principle of "prescription stems from treatment rules". Furthermore, traditional Chinese medicinal materials, preparation method and the

specific composition and structure of the magnetic therapy plaster described in the involved patent application are all conventional in the art. The technical solution disclosed in the involved patent application can be produced based on both conventional choices and the prior art reference. Not satisfied with the Disputed Decision, Luo Shiqin filed a lawsuit in the Beijing Intellectual Property Court (the Court of First Instance), requesting the Court of First Instance to revoke the Disputed Decision and order the CNIPA to amend its decision. The Court of First Instance rejected Luo's pleadings. Not satisfied with the first-instance judgment, Luo appealed to the SPC, arguing that the involved patent application should be deemed inventive because the first-instance judgment erroneously determined the technical features distinguishing claim 1 of the involved patent application from the closest prior art and there are obvious differences in the medicinal compatibility, composition and dosage form between the involved patent application and the prior art reference. On October 20, 2021, the SPC rejected the appeal and upheld the first-instance judgment.

### **【裁判意见】**

#### **[Judge's Opinion]**

最高人民法院二审认为，最接近的现有技术是指现有技术中与要求保护的发明最密切相关的一个技术方案。针对中药领域的

发明，特别是在药物有效成分涉及几味、十几味甚至几十味中药材时，不宜过度关注现有技术披露发明的技术特征的数量，而应更多从发明的实质出发，以发明目的、技术领域、技术问题、技术效果或用途的相似度作为确定最接近现有技术的关键因素。本案中，对比文件公开了一种用于肿瘤消肿镇痛的纳米药磁贴及其制备方法，采用行气活血、通络散结、消肿止痛为治则，发挥治疗作用的药物有效成分主要由 23 种中药材按重量份数制备而成，使用时根据肿瘤不同循经取穴在穴位上贴敷。本申请是一种用于治疗肿瘤的药磁贴的制备方法，采用通络散瘀，祛痰利湿，拔毒止痛化痞消积等消积导滞法，发挥治疗作用的药物有效成分主要由 22 种中药材按重量份数制备而成，使用时贴于肿瘤病灶的经络或有关穴位。可见，对比文件和本申请的发明目的、技术领域、技术问题和用途都具有高度相似性，尽管两种技术方案选所用的中药材存在 10 味以上不同，但由于具有相同功能的中药材相互之间具有可替代性是本领域的公知常识，故被诉决定将对比文件作为最接近的现有技术并无不当。

In the second instance, the SPC held that the closest prior art refers to the technical solution in the prior art that is the most relevant to the invention to be patented. For inventions in the TCM field, especially when active medicinal ingredients involve several, a dozen or even dozens of Chinese herbal medicines, it is not appropriate to pay too much attention to the number of technical

features of the invention disclosed in the prior art, but to start from the essence of the invention. In other words, it is necessary to regard the similarity of the purpose, technical field, technical problem, technical effect or use of the invention as key factors to determine its closest prior art. In this case, the prior art reference discloses a nano medicine magnet therapy plaster for relieving swelling and easing pain together with its preparation process. It follows the treatment rules of invigorating Qi and activating blood circulation, dredging collaterals and eliminating stagnation, reducing swelling and relieving pain. Its active medicinal ingredients are primarily prepared from 23 Chinese herbal medicines by weight and portion. It is applied to acupoints that are selected along the meridians according to different tumors. While the involved patent application discloses a preparation method of a medicinal magnetic plaster for treating tumors. It employs approaches of stagnation eliminating and dredging, such as dredging collaterals and dissipating blood stasis, removing phlegm and dampness, removing toxins and relieving pain, and dissolving and eliminating accumulation. It is mainly prepared from 22 Chinese medicinal materials by weight and portion and applied to the meridians or related acupoints of tumor lesions. It can be seen that the prior art reference and the involved patent application are highly similar in the aspects of the purpose, technical

field, technical problem and usage. Although compared with the prior technical solution, the technical solution to be patented makes use of more than 10 different Chinese medicinal materials, it is the common knowledge in the art that Chinese medicinal materials with the same efficacy can substitute with each other. Therefore, it is not inappropriate to deem the prior art reference as the closest prior art in the Disputed Decision.

## 6. 创造性判断中对具有协同关系的区别技术特征的考量

### **Consideration on synergetic distinguishing technical features in determining inventive step**

#### **【裁判要旨】**

#### **[Judgment Digest]**

创造性判断中，对于紧密联系、相互依存、具有协同作用、共同解决同一技术问题、产生关联技术效果的区别技术特征，可以作整体考虑，而不宜简单割裂评价。

In terms of determination on inventive step, those distinguishing technical features, which are closely related, interdependent, synergetic, solve the same technical problem and bring about mutually-related technical effects, could be considered as a whole, rather than simply split for separate evaluation.

## 【关键词】

### [Keywords]

发明专利 无效宣告程序 创造性 协同关系 关联技术效果  
区别技术特征

invention patent; invalidation procedure; inventive step;  
synergetic relationship; mutually-related technical effect;  
distinguishing technical feature

## 【案号】

### [Case Number]

(2020) 最高法知行终 155 号

(2020) SPC IP Admin. Final 155

## 【基本案情】

### [Case Facts]

在上诉人国家知识产权局（以下简称国家知识产权局）与上诉人卡西欧计算机株式会社（以下简称卡西欧株式会社）、被上诉人深圳光峰科技股份有限公司（以下简称光峰公司）发明专利权无效行政纠纷案中，光峰公司针对卡西欧株式会社拥有的专利号为 201010293730.7、名称为“光源装置、投影装置及投影方法”的发明专利（以下简称本专利）提出无效宣告请求。国家知识产权局经审查作出第 34530 号无效宣告请求审查决定（以下简称被诉决定），维持本专利权有效。光峰公司不服，向北京知识产权法院（以下简称一审法院）提起诉讼。一审法院认为，本专利权利要求 1

相对于对比文件 1 的区别技术特征在于将发光期间较短的特定颜色光的光源驱动电力设定较大，要解决的技术问题是调整不同荧光体的驱动电力以获得更好的发光效果。本领域技术人员在对比文件 1 的基础上，结合对比文件 2、3 以及本领域公知常识，得到本专利权利要求 1 的技术方案是显而易见的，权利要求 1 不具备创造性，故判决撤销被诉决定，国家知识产权局重新作出决定。国家知识产权局、卡西欧株式会社均不服，向最高人民法院提起上诉主张本专利权利要求 1 与最接近现有技术对比文件 1 的整体构思不同，一审判决对区别技术特征认定错误。最高人民法院于 2021 年 7 月 28 日判决撤销原判，驳回光峰公司的诉讼请求。

In the administrative dispute over invention patent invalidation between the appellants China National Intellectual Property Administration (the “CNIPA”) and Casio Computer Co., Ltd. (“Casio”) and the appellee Appotronics Corporation Limited (“Appotronics”), a request was filed by Appotronics to invalidate Casio's invention patent No. 201010293730.7, titled "Light source device, projection apparatus, and projection method" (the involved patent). Upon examination, the CNIPA made the No. 34530 Reexamination Decision on Invalidation Request (the Disputed Decision) to maintain the validity of the involved patent. Not satisfied with the Disputed Decision, Appotronics filed a lawsuit in the Beijing Intellectual Property Court (the Court of First Instance). The Court of

First Instance held that the technical feature distinguishing claim 1 of the involved patent from reference document 1 is that the driving power of the light source of a specific colored light with a shorter light emission period is set larger, and the technical problem to be addressed is to adjust the driving power of different phosphors for better illumination. It is obvious for a person skilled in the art to make the technical solution in claim 1 of the involved patent based on reference document 1 as well as document D2 and D3 and common knowledge in the field. So claim 1 does not have non-obviousness. Therefore, a decision was made to revoke the Disputed Decision and order the CNIPA to redecide. Not satisfied with the first-instance judgment, both the CNIPA and Casio appealed to the SPC, arguing that the overall conception in claim 1 of the involved patent differs from that in reference document 1 of the closest prior art, and the first-instance judgment wrongly identified the distinguishing technical features. On July 28, 2021, the SPC ruled to revoke the first-instance judgment and rejected Appotronics' pleadings.

### **【裁判意见】**

#### **[Judge's Opinion]**

最高人民法院二审认为，本专利与最接近现有技术之间的区别技术特征的认定，应当建立在充分理解发明和现有技术的技术方案基础上。在此过程中，应当准确把握发明构思，对具有协调配

合关系的技术内容的技术特征予以确定，准确理解技术方案各部分内容与发明为解决技术问题采用的发明构思以及产生的技术效果之间的关系。对于技术方案中存在紧密联系、相互依存、通过协同作用共同解决同一技术问题、产生关联技术效果的技术特征，在发明与最接近现有技术进行对比时，应当将其作为一个或一组技术特征予以整体考虑，不应机械地将构成整体技术方案中的技术特征割裂评价。发明实际解决的技术问题，应当基于整体发明构思的区别技术特征，并根据区别技术特征给整个发明带来的技术效果予以确定。本专利权利要求 1 请求保护一种光源装置，该技术方案针对不同荧光体的饱和特性不同、发光效率存在差异，在技术构思上采取“光源控制部件，其控制上述光源和上述光源光发生部件的驱动定时，将发光效率较高的至少 1 种颜色的光源光的发光期间设定得比其他颜色的光源光的发光期间短”的同时，设定“将已把该发光期间设定得较短的颜色的光源光发生时的上述光源的驱动电力设定得比其他颜色的光源光发生时的上述光源的驱动电力大”，二者在技术方案中通过协调配合、协同发挥作用共同解决荧光体饱和及绝对光量不足的技术问题，产生图像尽可能明亮且颜色再现性高的关联技术效果，应当作为一个或一组技术特征整体予以考虑，不应割裂该技术特征予以评价。对比文件 1 虽然在色轮上设置荧光材料，进而调整发光期间，但其系利用光源中的紫外光，提高光源利用效率的技术方案，与本专利发明构思不同，解决的技术问题不同，没有公开上述协调配合的区别技

术特征。对比文件 2、3 亦没有公开该区别技术特征的整体技术手段，本领域技术人员在不付出创造性劳动的前提下，难以通过简单地结合对比文件的技术方案来显而易见地得到权利要求 1 限定的技术方案，本专利权利要求 1 具备创造性。

In the second instance, the SPC held that the identification of the distinguishing technical features between the involved patent and the closest prior art should be based on a thorough understanding of the technical solutions in the invention patent and the prior art. In this process, it is necessary to accurately apprehend the invention concept, identify the technical features with coordinated and cooperative technical content, and precisely understand the relationship between the content of each section of the technical solution and the concept adopted by the invention to address technical problems and resultant technical effect. At the time of comparing the invention with the closest prior art, the technical features in the technical solution, which are closely related, depend on each other, address the same technical problem through synergy and produce related technical effects, shall be regarded as one technical feature or a set of technical features and considered as a whole, and the technical features that make up an overall technical solution should not be mechanically split for separate evaluation. The technical problem practically addressed by the invention should be determined based on the distinguishing technical

features of the overall invention concept and the technical effect made by the distinguishing technical features on the entire invention. Claim 1 of the involved patent requests to protect a light source device. Considering the different saturation characteristics and luminous efficiency of different phosphors, the technical solution employs a "light source control component, which controls the above light source and the drive timing of the above light source light generating unit, and sets the light emission period of the light source light of at least one color and with higher luminous efficiency to be shorter than the light emission period of the light source light of other colors"; meanwhile, sets "the driving power of the above light source when the light source light of the color whose light emission period is set to be shorter is generated to be larger than the driving power of the above light source when the light source light of other colors is generated". In the technical solution, the two work together through coordination and synergy to address the technical problems of phosphor saturation and insufficient absolute light quantity and produce the related technical effect that the images are as bright as possible, with high color reproducibility. Therefore, the two should be regarded as one technical feature or a set of technical features and considered as a whole, rather than being evaluated separately. Although in reference document 1, a fluorescent material is set on the color wheel to adjust the light

emission period, it is a technical solution to improve the utilization efficiency of the light source by using the ultraviolet light in the light source. It is different from the involved patent in terms of invention concept and technical problems to be addressed. The above synergetic distinguishing technical features are not disclosed in reference document 1. The overall technical solution for the distinguishing technical features is not disclosed in prior art references 2 and 3 too. It is difficult for a person skilled in the art to obviously obtain the technical solution defined in claim 1 by simply combining the technical solutions in the prior art references without inventive work. Therefore, claim 1 of the involved patent is deemed non-obvious.

## 7. 已知化合物药用发明的创造性判断

### **Determination on inventive step of medicinal invention of**

#### **known compounds**

##### **【裁判要旨】**

##### **[Judgment Digest]**

已知产品的用途发明中, 该产品用途能否从产品本身已知的活性性质以及现有用途中显而易见地得出, 是创造性判断的关键。如果该已知产品的用途发明是从现有技术概括的用途中选择其中一种适应症且并未取得预料不到的技术效果, 则其不具备创造

性。

In the usage-oriented invention of a known product, whether its usage can be obviously perceived from the known active properties of the product and its existing usages is the key to determining its inventive step. If the aforementioned invention selects one of the indications from the usages summarized in the prior art and fails to achieve an unexpected technical effect, it shall not be deemed inventive.

**【关键词】**

**[Keywords]**

发明专利申请 驳回复审程序 创造性 已知产品的用途发明  
invention patent application; reexamination procedure of rejection; inventive step; usage-oriented invention of known products

**【案号】**

**[Case Number]**

(2020) 最高法知行终 558 号  
(2020) SPC IP Admin. Final 558

**【基本案情】**

**[Case Facts]**

在上诉人诺华股份有限公司（以下简称诺华公司）与被上诉人国家知识产权局发明专利申请驳回复审行政纠纷案中，涉及申请号为 201410286316.1、名称为“癌症的治疗”的发明专利申请

(以下简称本申请)。诺华公司认为,第 162306 号复审请求审查决定(以下简称被诉决定)关于对比文件 1 公开内容认定错误,对比文件 1 公开了化合物 A 为免疫抑制剂,可用于移植排斥、自身免疫性疾病和炎性病征,从未公开化合物 A 可用于治疗肿瘤。本领域技术人员基于对比文件 1 无法想到将化合物 A 用于治疗肾实体瘤,本申请权利要求 1 具备创造性。故向北京知识产权法院(以下简称一审法院)提起诉讼。一审法院认为,本申请权利要求 1 与对比文件 1 相比的区别技术特征为本申请权利要求 1 中化合物 A 用于治疗除淋巴瘤以外的肾实体瘤,而对比文件 1 中化合物 A 用于治疗包括肿瘤在内的多种疾病。本申请实际解决的技术问题是提供化合物 A 治疗一种具体肿瘤的用途。本领域技术人员基于对比文件 1 公开的内容,有动机将其中的优选化合物 A 用于抗肿瘤,而肾实体瘤是常见的肿瘤类型,本领域技术人员对于化合物 A 治疗肾实体瘤的效果有合理的成功预期,即使验证该治疗效果需要一定的累积性实验劳动,亦无需付出创造性劳动。故判决驳回诺华公司的诉讼请求。诺华公司不服,向最高人民法院提起上诉,主张本领域技术人员基于对比文件无法想到将化合物 A 用于治疗肾实体瘤;本申请的化合物 A 用于治疗晚期肾癌比现有药物更有效,具有预料不到的技术效果,本申请具备创造性。最高人民法院于 2021 年 12 月 2 日判决驳回上诉,维持原判。

The administrative dispute over the reexamination of rejected invention patent application between the appellant Novartis Co., Ltd.

("Novartis") and the appellee China National Intellectual Property Administration ("CNIPA") involves an application for invention patent No. 201410286316.1, titled "Cancer treatment" (the involved patent application). According to Novartis, the No. 162306 Reexamination Decision on the Reexamination Request (the Disputed Decision) wrongly determined the disclosure of reference document 1, because reference document 1 discloses that as an immunosuppressant, Compound A can be used for transplant rejection, autoimmune diseases and inflammatory diseases, but it has never disclosed that Compound A can be used to treat tumors. A person skilled in the art will not use Compound A for the treatment of solid renal tumors based on reference document 1, so claim 1 of the patent application in question should be deemed to be involving an inventive step. Not satisfied with the Disputed Decision, Novartis filed a lawsuit in the Beijing Intellectual Property Court (the Court of First Instance). The Court of First Instance held that the technical feature distinguishing claim 1 of the involved patent application from reference document 1 is that, according to claim 1 of the involved patent application, Compound A is used for treating solid renal tumors other than lymphoma, while according to reference document 1, Compound A is used for treating a variety of diseases, including tumors. The technical problem to be practically addressed by the involved patent application is

to be solved by offering the use of Compound A in the treatment of a specific tumor type. Based on the disclosure in reference document 1, a person skilled in the art are motivated to use the preferred Compound A for anti-tumor purposes, and solid renal tumors are a common type of tumor. So, a person skilled in the art have reasonable expectations for the successful treatment of solid renal tumors with Compound A, even if the verification of the therapeutic effect requires certain experimental work over time, but no inventive work is required. On these grounds, the Court of First Instance rejected Novartis' pleadings. Not satisfied with the first-instance judgment, Novartis appealed to the SPC, arguing that the involved patent application involves an inventive step because a person skilled in the art will not use Compound A for treating solid renal tumors based on the prior art references, and according to the involved patent application, Compound A works better than existing drugs for the treatment of advanced renal cancer and will have unexpected technical effect. On December 2, 2021, the SPC rejected the appeal and upheld the first-instance judgment.

### **【裁判意见】**

#### **[Judge's Opinion]**

最高人民法院二审认为，用途发明的本质在于产品性能的应用，不在于产品本身。用途发明是在对医药化学产品进行研究过

程中,发现其具有本质上不同于现有技术应用的某种或某些特有的性质。用途发明可以分为新产品的用途发明和已知产品的用途发明。对比文件 1 公开了化合物 A,已经教导了化合物 A 可以用作抗肿瘤的药物,本申请权利要求限定的肾实体瘤是肿瘤的一种因此本申请属于已知产品的用途发明。对于已知产品的用途发明该用途是否能从产品本身已知的活性性质以及现有用途中显而易见的得出是判断该技术方案是否具备创造性的关键。当发明是从现有技术概括的用途中选择其中一种适应症时,因现有技术的技术教导较强,发明是否非显而易见还要考虑其是否取得了预料不到的技术效果。如果技术效果是从现有技术中可以合理预见到的,则该用途发明不具备创造性。根据本申请说明书关于实施例 A.2、实施例 B.6 和实施例 B.7 的记载,本申请仅仅是验证了化合物 A 治疗肿瘤的作用机理,并根据该机理推测其可对多种具体肿瘤产生治疗效果,而这一效果,本领域技术人员在对比文件 1 的启示下存在合理的预期。本申请推断出化合物 A 能够治疗包括肾实体瘤在内的多个肿瘤的效果,与在对比文件 1 公开内容基础上对化合物 A 治疗肿瘤的活性的预期效果是一致的,属于对比文件 1 的验证,未超出本领域技术人员的预期。本申请权利要求虽然存在肾实体瘤的限定,但并未在说明书中记载与此限定相关的创造性的贡献。在对比文件 1 公开的抗肿瘤以及记载有抗肿瘤检测方案的基础上得到本申请所限定的肾实体瘤的技术方案,对本领域技术人员而言,并未取得预料不到的技术效果。综上,

本申请不具有突出的实质性特点和显著的进步，不具备创造性。

In the second instance, the SPC held that the essence of usage-oriented invention of known products lies in the application of product performance, but not the product itself. Use invention aims to discover a medicinal chemical product's one or more unique properties that are essentially different from its application in the prior art in the course of study. Use invention can be divided into two categories – use invention of new and known products. The involved patent application is the use invention of a known product, as according to reference document 1, Compound A can be used as an anti-tumor drug, and the solid renal tumor defined in the claims of the involved patent application is a type of tumor. For the use invention of a known product, whether the use can be obviously derived from the known active properties of the product and its existing uses is the key to determining whether the technical solution has an inventive step. If the invention selects one of the indications from the uses summarized in the prior art, since the technical instruction of the prior art is strong, it is necessary to consider whether it has achieved an unexpected technical effect in order to determine whether the invention is nonobvious. If the technical effect can be reasonably expected from the prior art, the use invention should be deemed not inventive. According to Example

A.2, Example B.6 and Example B.7 as shown in the description of the involved patent application, the involved patent application only verifies the mechanism of action of Compound A in treating tumors and speculates that it may work well in treating various specific tumors based on such mechanism. In this case, such effect is reasonably expected by a person skilled in the art if inspired by reference document 1. The involved patent application deduces that the effect of Compound A of treating a variety of tumors (including solid renal tumors) is consistent with the expected activity of Compound A in treating tumor based on the disclosure in reference document 1. That is the verification of reference document 1 and is not beyond the expectations of a person skilled in the art. Although there are limitations to solid renal tumors in claims of the involved patent application, but there is no inventive contribution related to such limitation in the description. From the perspective of a person skilled in the art, developing a technical solution for solid renal tumors as limited by the involved patent application on the basis of the anti-tumor and anti-tumor detection solutions disclosed in reference document 1 does not achieve an unexpected technical effect. In conclusion, the involved patent application does not have outstanding substantive features and not make a significant progress, so it does not involve an inventive step.

## 8. 化合物组合产品权利要求中的用途限定对创造性判断的影响

### **Influence of usage-related restriction in the claims**

### **concerning combined compound products on determining**

### **inventive step**

#### **【裁判要旨】**

#### **[Judgment Digest]**

化合物组合产品权利要求中的用途限定通常不会影响或者改变化合物组合的组分、配比、理化性质等，故在对化合物组合产品权利要求的创造性判断中，原则上无需考虑用途限定。

The usage-related restriction in the claims concerning combined compound products usually does not affect or alter the components, composition, and physicochemical properties of such compound, so in principle, it is not necessary to consider usage-related restriction when determining the inventive step of such claims.

#### **【关键词】**

#### **[Keywords]**

发明专利申请 驳回复审程序 创造性 化合物组合  
用途限定

invention patent application ; reexamination procedure of

rejection; inventive step; compound combination; usage-related restriction

**【案号】**

**[Case Number]**

(2020) 最高法知行终 286 号

(2020) SPC IP Admin. Final 286

**【基本案情】**

**[Case Facts]**

在上诉人拜耳知识产权有限责任公司（以下简称拜耳公司）与被上诉人国家知识产权局发明专利申请驳回复审行政纠纷案中，涉及申请号为 201280014014.8、名称为“活性化合物组合”的发明专利申请（以下简称本申请）。拜耳公司认为本领域技术人员根据对比文件 1 无法预料到氟吡菌胺和氰霜唑的组合在控制晚疫病方面能取得协同效应，本申请的说明书及补充数据可以得出上述组合物针对晚疫病的协同效应起到了预料不到的技术效果，本申请具备创造性，故向北京知识产权法院（以下简称一审法院）提起诉讼，请求判令撤销第 162438 号复审请求审查决定（以下简称被诉决定），国家知识产权局重新作出决定。一审法院认为，本申请不具备创造性，判决驳回拜耳公司的诉讼请求。拜耳公司不服，向最高人民法院提起上诉。最高人民法院于 2021 年 9 月 28 日判决驳回上诉，维持原判。

The administrative dispute over the reexamination of rejected

invention patent application between the appellant Bayer Intellectual Property GmbH (“Bayer”) and the appellee China National Intellectual Property Administration (“CNIPA”) involves an application for invention patent (the involved patent application) No. 201280014014.8, titled "Active compound combinations" . Bayer filed a lawsuit in the Beijing Intellectual Property Court (the Court of First Instance) to revoke the No. 162438 Reexamination Decision on the Reexamination Request (the Disputed Decision) and order the CNIPA to redetermine, on the grounds that a person skilled in the art can not predict that the combination of fluopicolide and cyazofamid can achieve a synergetic effect in controlling late blight according to reference document 1, and the description and supplementary data of the involved patent application can arrive at a result that the above combination has an unexpected technical effect on the synergetic control of late blight, so the involved patent application should be deemed inventive. The Court of First Instance held that the involved patent application was not inventive and rejected Bayer's pleadings. Not satisfied with the first-instance judgment, Bayer appealed to the SPC. On September 28, 2021, the SPC rejected the appeal and upheld the first-instance judgment.

### **【裁判意见】**

### **[Judge's Opinion]**

最高人民法院二审认为，拜耳公司在复审阶段增加用途限定在修改没有超范围的情况下，被诉决定针对该审查文本进行了审查，其修改后的本申请权利要求 1 的主题为用于控制晚疫病的活性化合物组合。用途限定在确定产品权利要求保护范围时应当予以考虑，其实际的限定作用取决于对所请求保护的产品本身带来何种影响。本申请权利要求 1 是产品权利要求，用于控制晚疫病的活性化合物组合的用途对于化合物组合是否具有限定作用，在于该限定对所请求保护的产品是否带来了影响，氟吡菌胺与氰霜唑为已知化合物，对其用途限定不会改变组合物的成分，在其化合物结构固定的情况下，该用途限定只是对产品的用途或使用方式的描述，没有影响化合物的结构组成，对该化合物组合是否具备创造性并不当然产生作用。

In the second instance, the SPC held that Bayer added a use restriction in the reexamination procedure. Considering that the revision did not go beyond the scope, related text was reviewed. Upon the revision, the subject of claim 1 of the involved patent application is changed to be "Active compound combinations for controlling late blight". Considerations should be given to use restriction in determining the protection scope of a claim, and its actual restricting effect depends on how it affects the product to be patented. Claim 1 of the involved patent application is a product claim. Whether the use of active compound combinations for controlling late blight has a restricting

effect on compound combinations depends on whether the restriction has an impact on the product to be patented. Restricting the use of known compound Fluopicolide and cyazofamid will not change the composition of these two compounds. As long as their compound structures are invariable, the use restriction is merely a description of the use or usage of the product and does not affect the structural composition of the compound. Therefore, it surely does not play a role in determining the inventive step of the compound combination.

## 9. 实用新型专利创造性判断中对于非形状构造类特征的考量

### **Consideration on non-shape/structure features in**

### **determining the inventive step of a utility model patent**

#### **【裁判要旨】**

#### **[Judgment Digest]**

实用新型专利权的保护对象是由形状、构造或者其结合所构成的技术方案。如果权利要求中非形状构造类特征对产品的形状、构造或者其结合不具有影响，则其通常对于该权利要求的创造性不产生贡献。

A utility model patent protects the technical solution composed of shape, structure or the combination thereof. If a non-shape/structure feature in a claim does not influence the shape, structure or the

combination thereof, it generally does not contribute to the inventive step of the claim.

**【关键词】**

**[Keywords]**

实用新型专利 无效宣告程序 创造性 非形状构造类特征  
技术贡献

utility model patent; invalidation procedure; inventive step; non-shape/structure feature; technical contribution

**【案号】**

**[Case Number]**

(2021) 最高法知行终 621 号

(2021) SPC IP Admin. Final 621

**【基本案情】**

**[Case Facts]**

在上诉人浙江莎普爱思药业股份有限公司（以下简称莎普爱思公司）与被上诉人国家知识产权局、原审第三人李春成实用新型专利权无效行政纠纷案中，涉及专利号为 201420651984.5、名称为“一次性单剂量药用低密度聚乙烯滴眼剂瓶”的实用新型专利（以下简称本专利），专利权人为莎普爱思公司。经审查，国家知识产权局作出第 34330 号无效宣告请求审查决定（以下简称被诉决定），认为本专利不具备创造性，宣告本专利权全部无效。莎普爱思公司向北京知识产权法院（以下简称一审法院）提起诉讼。一

审法院认为，本专利不具备创造性，判决驳回莎普爱思公司的诉讼请求。莎普爱思公司不服，向最高人民法院提起上诉，主张不同材质的容器与滴眼液的化学成分有关联性，本专利申请日前，市面上均未出现利用低密度聚乙烯容器盛装苜达赖氨酸滴眼液的技术方案，莎普爱思公司为此付出创造性劳动，本专利具备创造性。最高人民法院在纠正关于创造性判断思路的基础上，于2021年12月9日判决驳回上诉，维持原判。

The administrative dispute over the utility model patent invalidation between the appellant Zhejiang Shapuaisi Pharmaceutical Co., Ltd. (Shapuaisi Pharma), and the appellee China National Intellectual Property Administration (“CNIPA”), and Li Chuncheng (the third party in the first instance) involves an application for invalidating Shapuaisi Pharma's patent No. 201420651984.5, titled "The medicinal Low Density Polyethylene eye drop bottle of disposable single dose" (the involved patent). Upon examination, the CNIPA made the No. 34330 Reexamination Decision on Invalidation Request (the Disputed Decision) to totally invalidate the involved patent on the ground of lack of inventive step. Not satisfied with the Disputed Decision, Shapuaisi Pharma filed a lawsuit in the Beijing Intellectual Property Court (the Court of First Instance). The Court of First Instance decided to reject the claims made by Shapuaisi Pharma on the same ground. Not satisfied with the first-instance judgment,

Shapuaisi Pharma appealed to the SPC, arguing that the involved patent should be deemed inventive and Shapuaisi Pharma has spared inventive efforts for the involved patent, because containers made from different materials are relevant to the chemical composition of eye drops, and before the application date of the involved patent, no low-density polyethylene containers for bendazac lysine eye drops appear in the market. On December 9, 2021, the SPC rejected the appeal and upheld the first-instance judgment on the basis of correcting the idea of inventive step determination.

### **【裁判意见】**

#### **[Judge's Opinion]**

最高人民法院二审认为，实用新型专利保护的是产品的形状、构造或者其结合所提出的适于实用的新的技术方案。在实用新型专利创造性的审查中，对于材料特征和方法特征，应当主要考虑其对产品的形状、构造或者其结合是否产生影响；如果其没有对产品的形状、构造或者其结合产生影响，则未对产品的形状、构造或者其结合作出技术贡献，通常不会为实用新型专利带来创造性。

In the second instance, the SPC held that a utility model patent protects a new practically applicable technical solution developed for the shape, structure, or the combination thereof of a product. In the examination of the inventive step of a utility model patent, the key should be to determine whether material and method features influence

the shape, structure or the combination thereof of the product, and if not, such material and method features should be deemed have not made technical contributions to the shape, structure or combination thereof of the product. Under this circumstance, they generally do not generate an inventive step for the utility model patent.

本案中，本专利权利要求 1 限定的滴眼剂瓶的材质与瓶内盛装的滴眼剂具体药物组合物的相容性问题，是否会为本专利带来创造性，主要取决于二者的改进是否会对本专利要求保护的滴眼剂瓶产品的形状、构造或者其结合产生影响。从本专利权利要求及说明书的记载内容来看，本领域技术人员无法确定，权利要求 1 限定的滴眼剂瓶的材质与瓶内盛装的滴眼剂具体药物组合物的相容性问题，将会对本专利的形状、结构或者其结合产生何种影响，故上述区别技术特征对本专利的技术方案并未产生创造性贡献。一审判决对创造性判断的最终结论正确。

In this case, whether the compatibility between the material of the eye drop bottle as defined in claim 1 of the involved patent and the specific pharmaceutical composition of the eye drop contained in the bottle generates an inventive step for the involved patent primarily depends on whether the improvement of the two influences the shape, structure or the combination thereof of the eye drop bottle in the involved patent. According to the claims and description of the involved patent, a person skilled in the art cannot determine how the com

patibility between the material of the eye drop bottle as defined in claim 1 and the specific pharmaceutical composition of the eye drop contained in the bottle will influence the shape, structure or the combination thereof of the involved patent, so the above distinguishing technical feature has not made inventive contributions to the technical solution of the involved patent. Therefore, the final conclusion in the first-instance judgment on the determination of inventive step is correct.

## 10. 现有技术对中药发明技术启示的判断

### **Determining the technical inspiration of traditional Chinese medicine (TCM) inventions by prior art**

#### **【裁判要旨】**

#### **[Judgment Digest]**

中药发明创造性判断中,关于现有技术是否给出将区别技术特征用于最接近现有技术以解决技术方案实际要解决的技术问题的启示,应当基于中医药传统理论,结合中医辨证施治的基本治疗原则,从治则、治法、配伍、方剂、效果等方面全面分析。

In determining the inventive step of a traditional Chinese medicine (TCM) invention, to confirm whether the prior art gives the inspiration to use the distinguishing technical features for the

closest prior art to solve the technical problem that the technical solution actually intends to solve should be based on the traditional theory of TCM, combined with the basic therapeutic principles of TCM diagnosis and treatment, and comprehensively analyzed from the aspects of treatment principle, treatment method, compatibility, prescription and effect.

### **【关键词】**

#### **[Keywords]**

发明专利申请 驳回复审程序 中药 创造性 技术启示

invention patent application; reexamination procedure of rejection; TCM; inventive step; technical inspiration

### **【裁判意见】**

#### **[Judge's Opinion]**

在前述药磁贴专利授权行政纠纷案中，最高人民法院指出，判断本申请所请求保护的发明对本领域技术人员来说是否显而易见，需要在最接近的现有技术的基础上，判断为了解决本申请所要解决的技术问题而采用的技术方案对于本领域技术人员而言是否容易想到。针对中药领域的发明，在判断一项发明对于本领域技术人员否显而易见时，需要以中医药传统理论为指导，结合中医辩证施治的基本治疗原则，对发明和现有技术的技术方案从中医理论、诊法治法、方剂和药物等多方面进行分析和比较，从而确定现有技术整体上是否提供了某种技术启示，使本领域技

术人员用以解决本发明所要解决的技术问题。如果现有技术存在这种技术启示，则发明是显而易见的。

In the aforementioned administrative dispute over patenting the medicinal magnetic patch, the SPC pointed out that to determine whether the invention to be patented in the application is obvious for a person skilled in the art, it is necessary to determine whether the technical solution used to solve technical problems that the involved patent application intends to solve is readily conceivable to a person skilled in the art on the basis of the closest prior art. For inventions in the field of TCM, in determining whether an invention is obvious for a person skilled in the art, it is necessary to analyze and compare the technical solutions of the invention and the prior art from various aspects, such as Chinese medical theory, diagnosis and treatment method, prescriptions and drugs, guided by the traditional theory of TCM and combined with the basic treatment principles of dialectical treatment in TCM, so as to determine whether the prior art as a whole provides some kind of technical inspiration for a person skilled in the art to solve the technical problem of the invention. If such technical inspiration exists in the prior art, the invention is obvious.

本案中，本申请要求保护的是一种用于治疗肿瘤的药磁贴的制备方法，对比文件公开了一种用于肿瘤消肿镇痛的纳米药磁贴

及其制备方法，两者所属的技术领域相同，所要解决的技术问题亦相同。本申请权利要求 1 与对比文件相比，区别技术特征在于：

(1) 原料中减去雪莲等原料，加入血竭等原料并限定了用量；(2) 增加热熔压敏胶加热混匀的步骤、包装前制成药膏贴等后加贴永磁体并限定磁场强度、增加加盖医用胶带、保护层步骤、限定药磁贴治疗肿瘤的作用途径和使用方式。关于区别技术特征 1，根据公知常识性证据林丽珠主编的《肿瘤中西医治疗学》，中医肿瘤治法主要归纳为两类：扶正培本类治法和祛邪抗癌类治法，主要包括理气活血、祛湿化痰、清热解毒、软坚散结、以毒攻毒等。根据对比文件，本领域的技术人员可以清楚地知道从活血化瘀、消肿止痛、通络行气等角度选取中药材进行组合，并辅之以养阴扶正、升阳行气的中药材可以有效消除肿块，缓解肿瘤病人的疼痛。本申请基于相同的中医治疗理论，从具有类似功效的中药材中进行选择并组合获得的疗效相当的中药组合物，由此可知，对比文件给出了相应的技术启示，对于本领域技术人员来说，无需付出创造性劳动即可获得本申请的技术方案。而从本申请说明书记载的内容中也看不出所作出的中药材替换、增加以及用量的限定产生了预料不到的技术效果。关于区别技术特征 2，该区别技术特征均属于本领域的常用辅料、常规操作、常规选择和常规技术等。因此，本申请要求保护的技术方案对于本领域技术人员而言是容易想到的，相对于现有技术是显而易见的。

In this case, the involved patent application requests for

protecting the preparation method of a medicinal magnetic plaster for treating tumor, and the prior art reference discloses a nano medicinal magnetic plaster for tumor swelling and pain relief and its preparation method, in the same technical field and with an aim to solve the same technical problems. Compared with the prior art references, the distinguishing technical features of claim 1 in the involved patent application are as follows: 1. removing such raw materials as snow lotus from the raw materials, adding such raw materials as Draconis Sanguis and limiting the dosage; 2. adding the step of heating and mixing the hot-melt pressure-sensitive adhesive, adding the permanent magnet and limiting the magnetic field strength after making the ointment paste before packaging, adding the step of covering the medical tape and protective layer, and limiting the pathway and mode of action of the medicinal magnetic patch for tumor treatment. Regarding distinguishing technical feature 1, according to the commonsense evidence, *i.e. The Chinese and Western Medical Treatment of Tumor* edited by Lin Lizhu, there are mainly two ways to treat tumor in the field of the TCM: Fuzheng Peiben therapy and Quxie Kangai therapy, mainly including the treatments of invigorating Qi and activating blood circulation, removing phlegm and dampness, clearing heat and detoxifying, softening and dispersing hard mass, and attacking poison with

poison. According to the prior art references, it is clear for a person skilled in the art that the combination of Chinese herbs selected from the perspectives of promoting blood circulation and removing blood stasis, relieving swelling and easing pain, and promoting the circulation of Qi can effectively eliminate lumps and relieve the pain of tumor patients, supplemented by the Chinese herbs that nourish Yin and support righteousness and promote Yang and move Qi. Based on the same TCM treatment theory, the involved patent application provides Chinese medicine composition with comparable efficacy by selecting and combining Chinese herbal medicines with similar efficacy. Thus, it can be seen that the prior art references give the technical inspiration, and for a person skilled in the art, the technical solution disclosed in the involved patent application can be obtained without creative labor. It cannot be seen from the description of the involved patent application that the substitution, increase and limitation of the dosage of the Chinese herbal medicines have produced an unexpected technical effect. Regarding distinguishing technical feature 2, such features all are conventional excipients, operations, choices and techniques in the art. Therefore, the technical solution to be patented is readily conceivable to a person skilled in the art and it is obvious relative to the prior art.

## 11. 创造性判断的直接证据与“三步法”的关系

## **The relationship between the direct evidence and the “three-step” method in the determination of inventive step**

### **【裁判要旨】**

#### **[Judgment Digest]**

专利创造性判断中广泛使用的“三步法”是具有普适性的逻辑推演方法；基于解决长期技术难题、克服技术偏见、实现预料不到的技术效果、获得商业成功等直接证据判断创造性的方法则属于经验推定方法，两者都属于创造性判断的分析工具。运用“三步法”判断的结论是技术方案具备创造性时，一般无需再审查有关创造性直接证据；运用“三步法”判断的结论是技术方案不具备创造性时，应当审查有关创造性的直接证据，并根据基于创造性直接证据的经验推定结论复验“三步法”分析，综合考虑逻辑推演和经验推定两方面结论作出判断。

The "three-step" method as widely used in determining the inventive step of a patent is a universal logical deduction method, while the method of determining inventive step based on direct evidence such as solving long-standing technical problems, overcoming technical bias, achieving unexpected technical effects, and achieving commercial success is an empirical presumption method. They are both analytical tools for determining inventive step. If the conclusion of the "three-step" method is that a technical

solution involves an inventive step, there is generally no need to examine the aforesaid direct evidence of inventive step, and if the conclusion of the "three-step" method is that a technical solution is not inventive, the direct evidence of inventive step shall be examined, and the "three-step" analysis shall be retested according to the empirical presumption conclusion based on the direct evidence of inventive step, and the judgment shall be made by comprehensively considering the conclusions of logical deduction and empirical presumption.

**【关键词】**

**[Keywords]**

发明专利 无效宣告程序 创造性 “三步法” 直接证据  
invention patent; invalidation procedure; inventive step; “three-step” method; direct evidence

**【案号】**

**[Case Number]**

(2021) 最高法知行终 119 号  
(2021) SPC IP Admin. Final 119

**【基本案情】**

**[Case Facts]**

在上诉人耐玩专利博物馆有限公司（以下简称耐玩公司）与被上诉人国家知识产权局、原审第三人浙江天猫网络有限公司

(以下简称天猫公司)、苹果电子产品商贸(北京)有限公司(以下简称苹果商贸公司)、中国工商银行股份有限公司(以下简称工商银行)发明专利权无效行政纠纷案(以下简称耐玩公司等专利确权行政纠纷案)中,涉及专利号为97121280.5、名称为“一种多元置信度适配系统及其相关方法”的发明专利(以下简称本专利)。针对天猫公司、苹果商贸公司、工商银行先后分别针对本专利权提出的无效宣告请求,国家知识产权局作出第36402号无效宣告请求审查决定(以下简称被诉决定),认为本专利不具备创造性,宣告本专利权全部无效。耐玩公司不服,向北京知识产权法院(以下简称一审法院)提起诉讼,请求撤销被诉决定,判令国家知识产权局重新作出决定。一审法院认为本专利不具备创造性驳回耐玩公司的诉讼请求。耐玩公司不服,向最高人民法院提起上诉,并提出本专利与最接近的现有技术证据A4相比具有的简化输入、简化权重、简化需求、简化检索等四个预料不到的技术效果,具备创造性。最高人民法院于2021年12月20日判决驳回上诉,维持原判。

The administrative dispute over the invention patent invalidation between the appellant Naiwan Patent Museum Co., Ltd. (“Naiwan”) and the appellee China National Intellectual Property Administration (the “CNIPA”), the third parties in the first instance Zhejiang Tmall Network Co., Ltd. (“Tmall”), Apple Electronic Products Commerce (Beijing) Co., Ltd (“Apple”) and the Industrial

and Commercial Bank of China Limited (“ICBC”) involves the patented invention No. 97121280.5, titled "A multivariate confidence adaptation system and its related methods" (the involved patent) (the administrative dispute over patent confirmation involving Naiwan and others). In response to the requests for invalidating the involved patent filed by Tmall, Apple and ICBC successively, the CNIPA made the No.36402 Examination Decision on Invalidation Request (the Disputed Decision) to totally invalidate the involved patent on the ground that the involved patent was not inventive. Not satisfied with the Disputed Decision, Naiwan filed a lawsuit in the Beijing Intellectual Property Court (the Court of First Instance) to revoke the Disputed Decision and order the CNIPA to make a new decision. The Court of First Instance rejected Naiwan's claims on the same ground. Not satisfied with the first-instance judgment, Naiwan appealed to the SPC on the grounds that compared with the closest prior art (evidence A4), the involved patent had four unexpected technical effects, such as simplified input, weighting, demand and retrieval, so the involved patent should be deemed inventive. On December 20, 2021, the SPC rejected the appeal and upheld the first-instance judgment.

### **【裁判意见】**

### **[Judge's Opinion]**

最高人民法院二审认为，司法审判和行政审查实践中关于权利要求所限定的技术方案是否属于显而易见的判断，通常需要借助分析工具。常见的创造性判断分析工具一般有两类：一类是逻辑推演工具。如专利审查实践中运用最为广泛的所谓的“三步法”，即“问题—解决方案”思路，通过确定最接近的现有技术确定发明的区别技术特征和发明实际解决的技术问题、判断要求保护的发明对本领域技术人员而言是否显而易见三个步骤，完成创造性判断。其实质是通过还原发明场景、模拟发明过程，以本领域技术人员视角对技术方案是否显而易见作出的逻辑推演。另一类是经验推定工具。如解决了一直渴望解决但始终未能解决的技术难题、克服了技术偏见、取得了预料不到的技术效果、获得了商业上的成功等（为方便起见，以下简称为经验推定因素），其是通过认定技术方案具备创造性的直接证据，并基于这些直接证据与技术方案本身的对应性或者因果关系，在适当考虑获得该技术方案困难程度的基础上，最终对技术方案是否显而易见作出的经验推定。原则上，对于同一技术方案的创造性问题，从逻辑角度和经验角度的分析应当殊途同归。技术方案的创造性未必来源于解决长期技术难题、克服技术偏见、实现预料不到的技术效果，未必带来商业成功；但解决了长期技术难题、克服了技术偏见、实现了预料不到的技术效果、获得了商业成功却是技术方案具备创造性的重要标志。逻辑推演工具的适用具有普适性，而经验推定工具则因仅涵盖了有限的几种典型情形而适用场景有限。故仅在有关创

创造性判断涉及前述经验推定因素时，才涉及逻辑推演和经验推定结论的协调问题。逻辑推演和经验推定结论不一致的情形一般有两种：一是“三步法”认定具备创造性，但并不存在经验意义上能够充分体现发明创造价值和效果的创造性直接证据，或者虽然存在创造性直接证据但其与有关区别技术特征缺乏对应性或者因果关联；二是“三步法”认定不具备创造性，但存在经验意义上能够充分体现发明创造价值和效果的创造性直接证据，且其与有关区别技术特征具有对应性或者因果关联。对于第一种情形而言，如前所述，因技术方案的创造性未必来源于经验推定因素，故不具备经验推定因素不足以否定技术方案的创造性，可以直接基于“三步法”结论认定技术方案具备创造性。对于第二种情形而言，则需要对“三步法”的结论进行复验。根据有关直接证据的不同，复验的重点也会有所不同：技术方案解决了长期技术难题、克服了技术偏见、获得了商业上的成功的，要重点考察“三步法”分析中，是否未充分考虑技术发展的阶段性和局限性进而错误判断了结合启示；技术方案取得了预料不到的技术效果的，则要重点考察是否错误认定了区别技术特征的技术效果，进而错误归纳了技术方案实际要解决的技术问题。如果复验结论是原先基于“三步法”的分析有误，则实现了分析结论的校准；如果复验结论是原先基于“三步法”的分析无误，则有必要再次审视，关于创造性直接证据的认定，及其与区别技术特征的对应性和因果关系认定是否有误，以及是否存在其他难以基于创造性直接证据认定创

造性的情形。据此,原则上,当“三步法”结论是技术方案具备创造性时,无需再审查有关创造性直接证据;当“三步法”结论是技术方案不具备创造性时,应当审查有关创造性直接证据,并根据基于创造性直接证据的经验推定结论复验“三步法”分析,综合考虑逻辑推演和经验推定两方面结论,作出判断。

In the second instance, the SPC held that, in judicial and administrative practice, analytical tools are usually used to determine whether the technical solution defined in the claims is obvious. Generally speaking, there are two types of analytical tools for determining the inventive step. One is the logical deduction tool. For example, the so-called "three-step" method (*i.e.*, the "problem - solution" idea), which is the most widely used in patent examination, determines the inventive step by identifying the closest prior art, determining the distinguishing technical features of the invention and the technical problem actually solved by the invention, and determining whether the invention to be patented is obvious to a person skilled in the art. In essence, it logically deduces whether the technical solution is obvious from the perspective of a person skilled in the art by restoring the invention scenario and simulating the invention process. The other is the empirical presumption tool, such as solving technical problems that people have been eager to solve but have never solved, overcoming technical bias, achieving

unexpected technical effects, and achieving commercial success (for convenience, hereinafter referred to as "empirical presumption factors"). It experientially presumes whether the technical solution is obvious by identifying the direct evidence to the effect that the technical solution is non-obvious on the basis of taking into consideration the level of difficulty of obtaining the technical solution based on the correspondence or causal relationship between such direct evidence and the technical solution. In principle, the analysis on the inventive step of the same technical solution should arrive at the same conclusion both from the logical and empirical points of view. The inventive step of the technical solution does not necessarily come from solving long-standing technical problems, overcoming technical biases, achieving unexpected technical effects, and it may not achieve commercial success, but successfully solving long-standing technical problems, overcoming technical biases, achieving unexpected technical effects and achieving commercial success are important signs that the technical solution is non-obvious. The logical deduction tool is generally used, while the empirical presumption tool is used only in certain cases because it only covers a limited number of typical situations. Therefore, the coordination of logical deduction and empirical presumption appears only when the determination of inventive step involves the

aforementioned empirical presumption factors. The logical deduction and the empirical presumption will arrive at a different conclusion under the following two circumstances. First, in case of "three-step" method, the invention is non-obvious, but there is no direct evidence in the empirical sense that can fully reflect non-obviousness of the value and effect of the invention, or there is direct evidence related to non-obviousness but it lacks correspondence or causal relationship with relevant distinguishing technical features. Second, in case of the "three-step" method, the invention is obvious, but there is direct evidence in the empirical sense that can fully reflect non-obviousness of the value and effect of the invention, and it has correspondence or causal relationship with relevant distinguishing technical features. In the first case, as mentioned above, since the inventive step of the technical solution does not necessarily come from empirical presumptions, the absence of empirical presumptions is insufficient to deny the inventive step of the technical solution and the technical solution can be determined inventive directly based on the conclusion of the "three-step" method. In the second case, there is a need to review the conclusion of the "three-step" method. The focus of the review will vary due to different direct evidence. If the technical solution has solved long-standing technical problems, overcome technical biases and

achieved a commercial success, the focus should be put on whether the "three-step" analysis has taken into full consideration the stages and limitations of technical development and thus misjudged the combination inspiration. If the technical solution has achieved unexpected technical effects, the focus should be put on whether the technical effects of distinguishing technical features are incorrectly identified and thus the technical problems actually solved by the technical solution are incorrectly summarized. If the review concludes that the original analysis based on the "three-step" method is wrong, the conclusion of the analysis is corrected. If the review concludes that the original analysis based on the "three-step" method is correct, it is necessary to re-examine whether the determination of direct evidence and its correspondence and causal relationship with the distinguishing technical features are wrong, and whether there are other situations under which it is difficult to determine the inventive step based on direct evidence. Accordingly, in principle, when the "three-step" method concludes that the technical solution is inventive, there is no need to review the direct evidence of inventive step, while when the "three-step" method concludes that the technical solution is not inventive, it is necessary to review the direct evidence of inventive step, and reexamine the "three-step" method analysis based on the empirical presumption conclusion to make a

decision by taking into account the conclusions drawn through logical deduction and empirical presumption.

## 12. 创造性判断中对预料不到的技术效果的考虑

### **Consideration on unexpected technical effect in determination of inventive step**

#### **【裁判要旨】**

#### **[Judgment Digest]**

基于预料不到的技术效果认定专利创造性时，专利权人应当对存在该预料不到的技术效果且其来源于相关区别技术特征承担举证责任。该预料不到的技术效果应当足以构成技术方案实际要解决的技术问题的改进目标。如果某一技术方案是解决技术问题的必然选择，即便有关技术效果难以预料，其也仅为本领域技术人员均可作出的必然选择的“副产品”，仅此尚不足以证明该技术方案具备创造性。

When determining the inventive step of a patent based on an unexpected technical effect, the patentee should bear the burden of proof that the unexpected technical effect exists and such effect is because of the relevant distinguishing technical features. The unexpected technical effect should be sufficient to constitute the improvement target of the technical problem that the technical

solution actually intends to solve. If a technical solution is an inevitable choice to solve a technical problem, even if the technical effect is unexpected, it is only a "by-product" of the inevitable choice that can be made by a person skilled in the art, and such a technical effect alone is not enough to prove that the technical solution involves an inventive step.

### **【关键词】**

#### **[Keywords]**

发明专利 无效宣告程序 创造性 预料不到的技术效果

invention patent; invalidation procedure; inventive step; unexpected technical effect

### **【裁判意见】**

#### **[Judge's Opinion]**

在前述耐玩公司等专利确权行政纠纷案中，最高人民法院指出，基于预料不到的技术效果认定专利创造性而言：首先，有关证明责任应当由专利权利人或者申请人承担，其至少应当证明存在预料不到的技术效果，且该预料不到的技术效果来源于有关区别技术特征。其次，预料不到的技术效果认定中的判断时点应当是申请日或者优先权日，比对基准应当是最接近现有技术而非现有技术整体，判断主体应当是本领域技术人员。最后，预料不到的技术效果应当足以构成技术方案实际要解决的技术问题的改进对象。换言之，该预料不到的技术效果应当构成技术方案选择

的重要考量或者重要目标。如果某一技术方案是解决技术问题的必然选择，即便有关技术效果难以预料，该技术效果也仅为本领域技术人员均可作出的必然选择的副产品，其不能成为必然选择技术方案的创造性来源。

In the aforementioned administrative dispute over patent confirmation involving Naiwan and others, the SPC pointed out that to determine the inventive step of the patent based on unexpected technical effects, firstly, the burden of proof should be on the patentee or the applicant, who should at least prove that there is the unexpected technical effect and such effect is derived from relevant distinguishing technical features. Secondly, the time of determining the unexpected technical effect should be the filing date or the priority date, the benchmark should be the closest prior art instead of the prior art as a whole, and the subject of determination should be a person skilled in the art. Finally, the unexpected technical effect should be sufficient to constitute the improvement object of the technical problem that the technical solution actually intends to solve. In other words, the unexpected technical effects should constitute an important consideration or important goal of the technical solution selection. If a technical solution is an inevitable choice to solve a technical problem, even if the technical effect is unexpected, it is only a "by-product" of the inevitable choice that

can be made by a person skilled in the art, and it cannot be an inventive source of the inevitable choice of technical solution.

本案中，耐玩公司作为专利权利人主张本专利权利要求1所限定的技术方案因取得了简化输入、简化权重、简化需求、简化检索等预料不到的技术效果而具备创造性，其应就存在上述技术效果、上述技术效果达到不可预料的程度，以及上述技术效果与有关区别技术特征之间的对应关系承担证明责任。对上述技术效果及其与区别技术特征的对应关系，专利说明书中没有明确具体的记载，耐玩公司在本案行政审查阶段和一审期间均未提出此主张，只是在上诉理由和二审庭审中才提出有关主张，但并未举证证明其所主张的技术效果确实存在，更未能够证明所谓的技术效果与最接近的现有技术相比达到了本领域技术人员不可预料的程度。

In this case, as the patentee, Naiwan claims that the technical solution defined in claim 1 is inventive because it achieves unexpected technical effects such as simplified input, weighting, demand and retrieval. Naiwan should bear the burden of proof on the existence of the above-mentioned technical effects, the unexpected extent of the above-mentioned technical effects as well as the correspondence between the abovementioned technical effects and relevant distinguishing technical features. The abovementioned technical effect and its correspondence with distinguishing technical

features are not clearly and specifically described in the description, and Naiwan does not put forward this claim at the stage of administrative review and in the first instance. It only puts forward the claim as the ground in the second instance, but it fails to prove that the claimed technical effect actually exists and that the so-called technical effect reaches an unexpected extent compared with the closest prior art in the field.

### 13. 说明书是否充分公开的审查

#### **Examination on whether the description is sufficiently disclosed**

##### **【裁判要旨】**

##### **[Judgment Digest]**

关于专利说明书是否充分公开的判断，应当以权利要求限定的技术方案及其所要解决的技术问题为对象，以本领域技术人员阅读说明书后能否实现该技术方案和解决该技术问题为标准。说明书中与权利要求限定的技术方案及其所解决的技术问题无关的内容，对于说明书公开是否充分的判断一般不产生影响。

To determine whether the description gives a full disclosure should take the technical solution defined in the claims and technical problems that such technical solution intends to solve as the object

and take the fact whether a person skilled in the art can realize such technical solution and solve such technical problems after reading the description as the standard. The contents of the description that are not related to the technical solution defined in the claims and the technical problem that the technical solution intends to solve shall not have an effect on determining whether the description gives a full disclosure.

**【关键词】**

**[Keywords]**

实用新型专利申请 驳回复审程序 说明书充分公开  
审查对象

utility model patent application; reexamination procedure of rejection; full disclosure in the description; object of examination

**【案号】**

**[Case Number]**

(2020) 最高法知行终 520 号  
(2020) SPC IP Admin. Final 520

**【基本案情】**

**[Case Facts]**

在上诉人宋章根、宋苏炜、宋治承与被上诉人国家知识产权局实用新型专利申请驳回复审行政纠纷案中，涉及申请号为

201620402906.0、名称为“高效转盘式水力发电机组”的实用新型专利申请（以下简称本申请）。宋章根、宋苏炜、宋治承认为，本申请说明书及附图结合现有技术已经对本实用新型作出了清楚、完整的说明，本领域技术人员能够实现本申请，本申请符合专利法第二十六条第三款的规定，故向北京知识产权法院提起诉讼，请求撤销第 126394 号复审请求审查决定（以下简称被诉决定），判令国家知识产权局重新作出决定。一审法院认为，本申请说明书中关于“圆形支承墙”以及通过配重调节止水板角度的记载是含糊不清的，根据说明书记载的内容无法实现，附图中也缺少实施该设想的具体产品结构，使得说明书及附图所记载的内容不能构成一个清楚完整的技术方案，因而不符合专利法第二十六条第三款的规定。宋章根、宋苏炜、宋治承不服，向最高人民法院提起上诉。最高人民法院于 2021 年 12 月 3 日判决撤销原判、被诉决定，国家知识产权局重新作出决定。

The administrative dispute over the reexamination of rejected utility model application between the appellants Song Zhanggen, Song Suwei and Song Zhicheng and the appellee China National Intellectual Property Administration ( the CNIPA) involves an application of utility model patent ( the involved application) No. 201620402906.0, titled "High-efficiency turntable hydro generator set". According to Song Zhanggen, Song Suwei and Song Zhicheng, combined with the prior art, the description and the drawings of the involved patent application

has clearly and fully described the utility model and a person skilled in the art could implement the involved patent application, so the involved patent application complies with the provision of Article 26(3) of *the Patent Law*. Therefore, they filed a lawsuit in the Beijing Intellectual Property Court (the Court of First Instance) to revoke the No. 126394 Reexamination Decision (the Disputed Decision) and order the CNIPA to make a new decision. The Court of First Instance held that the involved patent application does not comply with the provision of Article 26(3) of *the Patent Law* because (1) its description ambiguously describes the "circular supporting wall" and the adjustment of the angle of the water barrier by means of counterweights, which could not be implemented according to the description, and (2) the drawings do not present a specific product structure to implement the idea, causing the description and the drawings to fail to disclose a clear and complete technical solution. Not satisfied with the first-instance judgment, Song Zhanggen, Song Suwei and Song Zhicheng appealed to the SPC. On December 3, 2021, the SPC decided to revoke the first-instance judgment and the Disputed Decision and order the CNIPA to make a new decision.

### **【裁判意见】**

#### **[Judge's Opinion]**

最高人民法院二审认为，专利说明书应该清楚、完整地描述

发明或者实用新型的技术方案，使本领域技术人员能够理解和实施技术方案。专利说明书记载的内容并非必然针对权利要求所要求保护的内容，其可能承载超出权利保护范围的技术方案及其技术效果，实践中也普遍存在当事人基于同样的说明书分别要求多项权利的保护的情形。要求说明书充分公开，是因为专利权需要以技术方案的公开换取专有权的保护，由于授权的对象是权利要求所要求保护的技术方案，故判断说明书是否公开充分也应当针对权利要求所要求保护的技术方案及其所要解决的技术问题。对于说明书中虽有记载，但并非权利要求限定的技术方案及其所解决的技术问题，本技术领域技术人员能否实现该技术方案，解决该技术问题，不应当影响专利申请的授权。

In the second instance, the SPC held that the description should clearly and completely describe the technical solution of the invention or utility model, so that a person skilled in the art can understand and implement the technical solution. The contents of the description are not necessarily about the content of the claimed protection, which may carry technical solutions and technical effects beyond the scope of the right protection. In practice, it is also common for the parties to request for multiple rights protection based on the same description. The reason that the description is required to be fully disclosed is that the technical solution is disclosed in exchange for obtaining exclusive right to be protected. Because the technical solution in the claims to be

protected is the object to be patented, determining whether the description gives a full disclosure should place an eye on the technical solution in the claims and the technical problem to be solved. As to the technical solution and the technical problem to be solved disclosed in the description but not defined in the claims, whether a person skilled in the art can implement such technical solution and solve such technical problem should not affect the authorization of the involved patent application.

本案中，尽管本申请整体要解决提高电能转换效率、减少能耗的问题，但系通过不同技术手段在不同层面解决减少能耗的问题，相互之间亦不存在协同作用的关系。宋章根、宋苏炜、宋治承在提交复审请求时修改的权利要求中，删除了原从属权利要求 3-6 中关于圆形支撑墙及通过配重调节止水板角度的技术特征，该修改已经被国家知识产权局接受。就修改后保留的权利要求 1、2 而言，其并未涉及圆形支撑墙及通过配重调节止水板的角度等技术特征，相应的技术效果亦并非本申请权利要求 1、2 限定的技术方案所要解决的技术问题，不应成为评价本申请说明书是否公开充分的对象。被诉决定的决定理由部分及一审判决仅以本领域技术人员不能清楚地知晓圆形支撑墙的具体结构及通过配重调节止水板的角度如何实现为由认为本申请说明书公开不充分有所不当。申请人放弃在本申请中保护形成圆形支撑墙及通过配重调节止水板的技术手段后，本申请要求保护的技术方案不再要解决减少阻

力杆转动过程中的阻力这一技术问题，说明书中仅清楚地记载通过安装减摩机构提高电能转换效率的实施方式并不会导致说明书公开不充分。因此，针对宋章根、宋苏炜、宋治承修改后的权利要求，本申请说明书公开充分，符合专利法第二十六条第三款的规定

In this case, although the involved patent application as a whole seeks to solve the problem of improving electrical energy conversion efficiency and reducing energy consumption, it solves the problem of reducing energy consumption at different levels by different technical means, and there is no synergistic relationship among them. At the time of submitting the request for reexamination, Song Zhanggen, Song Suwei and Song Zhicheng deleted the technical features of the circular support wall and the adjustment of the angle of the water barrier by means of counterweight in the original dependent claims 3-6. Such amendment was accepted by the CNIPA. As for the modified claims 1 and 2, they do not include the technical features of the circular support wall and the adjustment of the angle of the water barrier by means of counterweight, and the corresponding technical effects are not the technical problems to be solved by the technical solutions defined in claims 1 and 2 of the involved patent application, so such modified claims 1 and 2 should not be the object of evaluating the fullness of the disclosure of the description in the involved patent application. According to the Disputed Decision and the first-instance

judgment are not appropriate, as they consider the disclosure of the description of the involved patent application is not sufficient because a person skilled in the art could not clearly know the specific structure of the circular support wall and how to adjust the angle of the water barrier by means of a counterweight. After the applicant gave up the technical means to protect the formation of circular support wall and adjust the water barrier by counterweight in the involved patent application, the technical solution to be protected requested in the involved patent application would no longer solve the technical problem of reducing the resistance during the rotation of the resistance rod, so only clearly describing the implementation method of improving the electric energy conversion efficiency by installing the friction reducing structure in the description would not lead to inadequate disclosure. Therefore, as for the claims revised by Song Zhanggen, Song Suwei and Song Zhicheng, the description of the involved patent application gives a full disclosure and the application conforms to the provision of Article 26(3) of *the Patent Law*.

#### 14. 外观设计专利申请文件修改是否超范围的判断

### **Determination of whether the design patent application documents are modified beyond the scope**

## **【裁判要旨】**

### **[Judgment Digest]**

对外观设计专利申请文件的修改是否超出原图片或者照片表示的范围的认定，应当审查“修改后示出的外观设计”与“修改前示出的外观设计”是否属于相同设计。删除外观设计专利申请文件中存在明显错误的图片或者照片，未导致原申请文件中其他图片或者照片表示的外观设计发生变化的，该删除一般不构成修改超范围。

To determine whether the modification in the design patent application documents exceeds the scope represented by the former picture or photograph, whether the "design after modification" is the same as the "design before modification" should be examined. Where the deletion of a picture or photo with obvious errors in the design patent application documents does not lead to changes in the design represented by other pictures or photos in the original application documents, it should be allowed.

## **【关键词】**

### **[Keywords]**

外观设计专利 无效宣告程序 专利申请文件 修改超范围

design patent; invalidation procedure; patent application document; modification beyond the scope

## **【案号】**

## **[Case Number]**

(2021) 最高法知行终 9 号

(2021) SPC IP Admin. Final 9

## **【基本案情】**

### **[Case Facts]**

在上诉人上海帛琦婴童用品有限公司（以下简称帛琦公司）与被上诉人国家知识产权局、原审第三人米玛国际控股有限公司（以下简称米玛公司）外观设计专利权无效行政纠纷案中，涉及专利号为 200930190393.7、名称为“婴儿手推车”的外观设计专利（以下简称本专利），现专利权人为米玛公司。帛琦公司认为，本专利的申请人在授权阶段对本专利外观设计申请文件所作修改不符合 2000 年修正的专利法第三十三条的规定，国家知识产权局驳回帛琦公司的无效宣告请求，在认定事实和适用法律方面均存在错误，故向北京知识产权法院（以下简称一审法院）提起诉讼，请求撤销国家知识产权局作出的第 37801 号无效宣告请求审查决定（以下简称被诉决定），国家知识产权局重新作出决定。一审法院判决驳回帛琦公司的诉讼请求。帛琦公司不服，向最高人民法院提起上诉。最高人民法院于 2021 年 11 月 30 日判决驳回上诉，维持原判。

The administrative dispute over the invalidation of design patent between the appellant Shanghai Pouch Baby Products Co., Ltd. (“Pouch”) and the appellee China National Intellectual Property

Administration (the “CNIPA”), the third party in the first instance, Mima International Holdings Co., Ltd. (“Mima”) involves Mima's design patent (the involved patent) No. 200930190393.7, titled "baby stroller". Pouch filed a lawsuit in the Beijing Intellectual Property Court (the Court of First Instance) to revoke the No. 37801 Examination Decision on Invalidation Request made by the CNIPA (the Disputed Decision) and order the CNIPA to make a new decision on such grounds that modifications made by the applicant to the design application documents at the granting stage do not comply with the provision of Article 33 of *the Patent Law* amended in 2000 and the CNIPA rejected the invalidation request filed by Pouch based on wrong determination of facts and application of law. The Court of First Instance ruled to reject Pouch's claim. Not satisfied with the first-instance judgment, Pouch appealed to the SPC. On November 30, 2021, the SPC rejected the appeal and upheld the first-instance judgment.

### **【裁判意见】**

#### **[Judge's Opinion]**

最高人民法院二审认为, 对于 2000 年修正的专利法第三十三条规定的申请人对外观设计专利申请文件的修改“不得超出原图片或者照片表示的范围”, 可以作如下理解: 首先, 修改是否超范围, 审查对象是“修改后的图片或照片所表示的外观设计”, 参

照对象是“修改前的外观设计专利申请文件中图片或照片所表示的外观设计”。其次，修改是否超范围，判断标准的核心在于“修改后的外观设计”与“修改前的外观设计”是否属于相同设计。再次，判断“修改后的外观设计”与“修改前的外观设计”是否属于相同设计，应当遵循两条判断规则：一是修改后的外观设计内容是否在修改前的外观设计专利申请文件的图片或照片中已经体现；二是修改后的外观设计内容是否可以直接地、毫无疑问地从修改前的外观设计专利申请文件的图片或照片中得到确定。根据上述两条判断规则，修改后的图片或照片所示出的外观设计特征与修改前的外观设计申请文件中的图片或照片所直接表示或者可以直接地、毫无疑问地示出的相应外观设计特征相比，既不能多也不能少，同时也不允许对相应外观设计特征进行实质性的改变。最后，针对外观设计专利申请文件的具体修改方式，可以进一步细化“修改是否超范围”的判断方法，即：1.如果采用的是“增加视图”的修改方式，应当重点审查修改后新增加的视图连同原有视图所共同示出的外观设计，有无增加原始申请文件所未直观表示或者从原始申请文件中难以直接地、毫无疑问地确定的设计特征，如果没有增加新的设计特征，则说明修改不超范围，反之则说明修改超范围。2.如果采用的是“删除视图”的修改方式，应当重点审查修改后剩余的视图所示出的外观设计有无继续保留原始申请文件所表示的外观设计特征，如果继续保留，则说明修改不超范围，反之则说明修改超范围。3.如果对原始申请文件采用的是

“修改特定视图”的修改方式，应当重点审查针对该特定视图修改前后所示出的全部外观设计特征是否相同，如果相同则说明修改不超范围，反之则说明修改超范围。

In the second instance, the SPC held that, as for the Article 33 of the *Patent Law* amended in 2000 stipulating that the applicant's modifications to the design patent application document "should not exceed the scope represented by the former picture or photograph", we should understand this article as follows: Firstly, as to whether the modification is beyond the scope, the object of examination is "the design represented by the modified picture or photograph", and the reference object is "the design represented by the picture or photograph in the design patent application filed before the modification". Secondly, as to whether the modification is beyond the scope, the key of the determination standard is whether the "design after modification" is the same as the "design before modification". Thirdly, to determine whether the "design after modification" is the same as the "design before modification" should follow the following two rules. The one is whether the content of the modified design is already reflected in the pictures or photographs of the design patent application documents before modification. The other is whether the content of the modified design can be directly and unambiguously derives in the pictures or photographs of the

design patent application documents before modification. According to the above-mentioned two rules, the design features shown in the modified picture or photograph should be exactly the same as corresponding design features directly represented or directly and unquestionably shown in the picture or photograph in the design application documents before modification, and meanwhile, any substantial change made to the corresponding design features should not be allowed. Finally, as for the specific modifications made to the design patent application documents, the way of determining whether "modification is beyond the scope" could be further detailed. Namely: 1. If the modification is made by "adding views", the examination should focus on the design shown by the new views together with the former views and whether or not there is any new design feature that is not visually represented in the original application documents or difficult to derive directly and unambiguously from the original application documents. If without new design features, it means that the modification is within the scope. Otherwise, the modification is out of the scope. 2. If the modification is made by "deleting the view", the examination should focus on whether the design features shown in the modified view have the design features as shown in the original application documents. If with design features as shown in the original

application document, it means that the modification is within the scope. Otherwise, the modification is out of the scope. 3. If the modification is made by "modifying a specific view", the examination should focus on whether all the design features are the same before and after the modification to the specific view. If they are the same, it means that the modification is within the scope. Otherwise, the modification is out of the scope.

本案中，帛琦公司主要上诉理由为，本专利要求保护的是一种座椅朝向可变化的婴儿手推车的外观设计，本专利申请文件删除“另一角度立体图”导致其保护范围扩大。然而，本专利申请人删除的是“另一角度立体图”，而非“另一使用状态立体图”，结合其他七幅图片中婴儿车的座椅均是朝向前方，以及本专利申请文件并无“简要说明”记载“座椅朝向可变化”等情况，可以认定本专利申请人在提起本专利申请之初，并非针对“座椅朝向可变化的婴儿手推车”申请外观设计专利，而仅是针对“座椅朝向前方的婴儿手推车”申请外观设计专利。在此情况下，名为“另一角度立体图”的图片中却出现了“座椅朝向后方”的情形，与其他七幅图片所示出的“座椅朝向前方”的外观设计明显存在冲突，故属于“绘制视图中的错误”。本专利申请人根据前述补正通知书的建议，删除该“另一角度立体图”，一方面是对绘制视图中的错误所作的修正；另一方面，该修正亦未导致原申请文件中其他七幅图片所示出的外观设计发生变化。因此，本专利申

请人删除“另一角度立体图”的修改符合 2000 年修正的专利法第三十三条的规定。

In this case, Pouch appealed mainly on the grounds that the involved patent aims to protect the design of a baby stroller with a changeable seat orientation, and the deletion of "three-dimensional view from another angle" in the application documents expands the scope of protection. However, the applicant deleted the "three-dimensional view from another angle", not "three-dimensional view of another state of use". After taking into accounts other seven pictures showing that the seats of the stroller are all facing forward and the fact the application document does not include "a brief description" that describes the "changeable seat orientation", it can be determined that at the beginning of filing the application, the applicant applies to involved patent only "a baby stroller with a seat facing forward", not "a baby stroller with a changeable seat orientation". In this case, the picture named "three-dimensional view from another angle", shows the "seat facing backward", which is clearly in conflict with the design of "seat facing forward" shown in other seven pictures, so it is an "error in drawing view". The applicant, in accordance with the aforementioned notice of correction, deleted the "three-dimensional view from another angle",

which, on the one hand, was a correction of the error in the drawing view, and on the other hand, such correction does not lead to any change in the design shown in other seven pictures in the original application document. Therefore, deleting the "three-dimensional view from another angle" by the applicant is in accordance with the provision of Article 33 of *the Patent Law* as amended in 2000.

## 15. 对依据生效裁判所作行政决定的司法审查

### **Judicial review over administrative decisions based on binding judgments**

#### **【裁判要旨】**

#### **[Judgment Digest]**

当事人对依据在先生效裁判重新作出的行政决定提起诉讼的，人民法院应当审查该被诉决定是否全面、准确履行了在先生效裁判以及是否增加了新的事实或理由；被诉决定未全面、准确履行在先生效裁判或者增加了新的事实或理由的，人民法院应予受理并对其中不受在先生效裁判羁束的内容予以审理；被诉决定全面、准确履行在先生效裁判且未增加新的事实或理由的，当事人对该行政决定不再享有诉权，人民法院不予受理。

Where a party files a lawsuit against an administrative decision re-issued based on a prior binding judgment, the people's courts

should examine whether the disputed decision has fully and accurately performed the prior binding judgment and whether there are new facts or reasons. Where the Disputed Decision has not fully and accurately performed the prior binding judgment or there are new facts or reasons, the people's court should put the lawsuit on file and try the content that is not subject to the prior binding judgment. Where the Disputed Decision has fully and accurately performed the prior binding judgment and there are no new facts or reasons, the party involved shall no longer have the right to file a lawsuit against the disputed decision and the people's courts shall not put such a lawsuit on file.

**【关键词】**

**[Keywords]**

实用新型专利 无效宣告程序 生效裁判 既判力

utility model patent; invalidation procedure; binding judgment;  
res judicata

**【案号】**

**[Case Number]**

(2021) 最高法知行终 199 号

(2021) SPC IP Admin. Final 199

**【基本案情】**

**[Case Facts]**

在上诉人湖南华慧新能源股份有限公司（以下简称华慧公司）与被上诉人国家知识产权局、原审第三人东莞市力源电池有限公司（以下简称力源公司）实用新型专利权无效行政纠纷案中，涉及专利号为 201020545242.6、名称为“一种正负极同向引出圆柱形锂离子电池的封口胶塞”的实用新型专利（以下简称本专利），共有两项权利要求。国家知识产权局专利复审委员会（以下简称专利复审委员会）作出第 29237 号无效宣告请求审查决定（以下简称第 29237 号决定），维持本专利权有效。针对第 29237 号决定，北京市高级人民法院经二审审理，作出（2018）京行终 288 号生效判决认为本专利权利要求 1 相对于对比文件 1 和对比文件 2 的结合不具备创造性，故判决要求国家知识产权局重新作出决定。2018 年 9 月 19 日，专利复审委员会根据前述（2018）京行终 288 号生效判决作出第 37286 号无效宣告请求审查决定（以下简称被诉决定），宣告本专利权全部无效。华慧公司不服，向北京知识产权法院（以下简称一审法院）提起诉讼，一审法院经审查判决驳回华慧公司的诉讼请求。华慧公司不服，向最高人民法院提起上诉。最高人民法院于 2021 年 6 月 7 日判决驳回上诉，维持原判。

The administrative dispute over the invalidation of the utility model patent between the appellant Hunan Huahui New Energy Co., Ltd. (Huahui) and the appellee China National Intellectual Property Administration (the “CNIPA”), the third party in the first instance Dongguan Liyuan Battery Co., Ltd. (“Liyuan”) involves the utility

model patent No. 201020545242.6, titled "a kind of sealing rubber plug for cylindrical lithium-ion batteries with positive and negative terminals leading in the same direction" (the involved patent) with two claims. The Patent Reexamination Board of CNIPA (the Patent Reexamination Board) made the No. 29237 Examination Decision on Invalidation Request (No. 29237 Decision) to maintain the validity of the involved patent. In response to No. 29237 Decision, the Beijing High People's Court rendered the binding judgment [(2018) Jing Admin. Final 288], which ordered the CNIPA to make a new decision, holding that claim 1 of the involved patent was not inventive with respect to the combination of reference document 1 and D2. On September 19, 2018, the Patent Reexamination Board made the No. 37286 Examination Decision on Invalidation Request (the Disputed Decision) based on the aforementioned binding judgment [(2018) Jing Admin. Final 288] to totally invalidate the involved patent. Not satisfied with the Disputed Decision, Huahui filed a lawsuit in the Beijing Intellectual Property Court (the Court of First Instance). The Court of First Instance rejected Huahui's claims. Not satisfied with the first-instance judgment, Huahui appealed to the SPC. On June 7, 2021, the SPC rejected the appeal and upheld the first-instance judgment.

### 【裁判意见】

## **[Judge's Opinion]**

最高人民法院二审认为，《关于审理专利授权确权行政案件适用法律若干问题的规定（一）》第二十六条规定，审查决定系直接依据生效裁判重新作出且未引入新的事实和理由，当事人对该决定提起诉讼的，人民法院依法裁定不予受理；已经受理的，依法裁定驳回起诉。为维护生效裁判既判力、避免循环诉讼，对于依据生效裁判重新作出的被诉行政决定，应当区分其是否忠实履行了生效裁判所确定的法律义务且未增加新的事实和理由，作出处理：未忠实履行生效裁判所确定的法律义务，或者增加了新的事实和理由的，当事人仍可以对相关行政决定提起诉讼，人民法院应予以审理；忠实履行生效裁判所确定的法律义务的，当事人对相关行政决定不再享有诉权，人民法院不应再予审理。本案中，一审庭审中，华慧公司明确表示本案中未提出新的证据和理由，其主张的具体事实和理由与前一轮程序相同；国家知识产权局明确表示被诉决定系按照（2018）京行终 288 号生效判决的相关认定而作出被诉决定关于本专利权利要求 1 与对比文件 1 的区别特征、认定要解决的技术问题、认定本专利权利要求 1 无创造性的理由与生效判决认定一致。由此可见，有关本专利权利要求 1 的创造性已经北京市高级人民法院二审终审，华慧公司在本次诉讼中所针对的被诉决定有关权利要求 1 的创造性评述系依照生效判决所作出；国家知识产权局在第二次无效宣告请求审查决定中评述权利要求 1 的创造性时并未引入新的事实和理由，其为忠实履行生效裁判

所确定的法律义务，该部分行政行为已受生效判决所拘束，故华慧公司无权对被诉决定中有关本专利权利要求 1 的创造性提出主张，一审法院亦不应再对本专利权利要求 1 的创造性进行评述。鉴于前一轮程序的生效判决未对本专利权利要求 2 创造性进行评述，本案被诉决定对本专利权利要求 2 创造性进行评述属于“引入新的理由”，故华慧公司可针对被诉决定中有关权利要求 2 的创造性提起诉讼。本专利权利要求 2 的附加技术特征为封口胶塞采用橡胶材料，而对比文件 1 公开了橡胶塞 2，故而对对比文件 1 公开了权利要求 2 的附加技术特征，权利要求 2 亦不具备创造性。一审法院虽对本专利权利要求 1 创造性再次评述有所不当，但其裁判结果正确，故对一审判决予以维持。

In the second instance, the SPC held that Article 26 of *the Provisions of the Supreme People's Court on Several Issues concerning the Application of Law in the Trial of Administrative Cases Involving the Grant and Confirmation of Patents (I)* stipulates that if a examination decision is made directly based on the binding judgment and there are no new facts and reasons and the party involved files a lawsuit against such decision, the people's court should make a ruling not to put such lawsuit on file, and if such lawsuit has been put on file, the people's court should rule to dismiss the lawsuit. In order to protect the res judicata of the binding judgment and avoid circular litigation, the disputed administrative

decision that is re-made in accordance with an binding judgment should be addressed based on whether such decision has faithfully performed legal obligations as stated in the binding judgment and there are no new facts and reasons. Where such decision does not faithfully perform legal obligations as stated in the binding judgment or there are new facts or reasons, the party involved still can file a lawsuit against such decision and the people's court should try such lawsuit; and where such decision faithfully performs legal obligations as stated in the binding judgment, the party involved will not have the right to file a lawsuit against such decision and the people's court should not try such lawsuit. In this case, Huahui made it clear that no new evidence and reasons were put forward in this case, and the specific facts and reasons of its claim were the same as those in the preceding procedure, and the CNIPA made it clear that the Disputed Decision was made in accordance with the relevant findings of the binding judgment [(2018) Jing Admin. Final 288] and it is the same as the judgment in the aspects of identifying the distinguishing features of claim 1 of the involved patent and reference document 1, the technical problem to be solved, and the reasons for determining claim 1 of the involved patent obvious. It can be seen that the non-obviousness of claim 1 of the involved patent has been finally examined by the Beijing High People's Court

in the second instance, and the comments on the non-obviousness of claim 1 in the Disputed Decision against which this lawsuit was filed by Huahui was made in accordance with the binding judgment; the CNIPA did not introduce new facts and reasons at the time of examining the non-obviousness of claim 1 in its second examination decision on invalidation request, showing that it has faithfully fulfilled its legal obligations as stated in the binding judgment, so this part of its administrative acts was bound by the binding judgment. Therefore, Huahui has no right to assert the non-obviousness of claim 1 of the involved patent in the Disputed Decision and the Court of First Instance should no longer comment on the non-obviousness of claim 1 of the involved patent. In view of the fact that the binding judgment made in the preceding procedure does not comment on the non-obviousness of claim 2 of the involved patent, the comments on the non-obviousness of claim 2 of the involved patent in the Disputed Decision are seen as "introducing new reasons", so Huahui can file a lawsuit against the non-obviousness of claim 2 in the Disputed Decision. The additional technical feature as stated in claim 2 of the involved patent is that the sealing plug is made of rubber material, and the rubber plug 2 is disclosed in reference document 1, so the additional technical feature of claim 2 is disclosed in reference document 1 and claim 2 is

obvious. Although it is not appropriate for the Court of First Instance to comment on the non-obviousness of claim 1 of the involved patent again, its decision was correct, so the first-instance judgment was upheld.

## 16. 专利授权确权行政案件起诉期限起算点的确定

### **Determination of the starting point of the time limit to litigate against an administrative decision on patent authorization and confirmation**

#### **【裁判要旨】**

#### **[Judgment Digest]**

专利授权确权行政案件起诉期限的起算点是收到被诉决定之日。在案证据能够证明行政相对人实际收到被诉决定时间的，以实际收到之日为准；在案证据难以证明行政相对人实际收到被诉决定时间的，或者国家知识产权局对于行政相对人实际收到被诉决定的时间另有规定或约定，且该规定或约定有利于行政相对人，也不违反法律、行政法规禁止性规定的，为保护行政相对人的信赖利益，可以根据具体案情对“收到有关决定之日”作出有利于行政相对人的解释。

The time limit to file a lawsuit against an administrative

decision on patent authorization and confirmation starts from the date of receipt of the Disputed Decision. If documented evidence can prove the date on which the administrative counterpart actually received the Disputed Decision, the date of actual receipt should prevail; if documented evidence fails to prove, or if the CNIPA has other provisions or agreements on the date when the administrative counterpart actually received the Disputed Decision, and such provisions or agreements are in favor of the administrative counterpart and do not violate the prohibition of laws and administrative regulations, "the date of receipt of the decision" should be interpreted in favor of the administrative counterpart as the case may be in order to protect the reliance interests of the administrative counterpart.

**【关键词】**

**[Keywords]**

专利授权确权行政决定 起诉期限 起算点 收到有关决定之日 信赖利益

administrative decision on patent authorization and confirmation; time limit to file a lawsuit; starting point; the date of receipt of the decision; reliance interests

**【案号】**

**[Case Number]**

(2021) 最高法知行终 278 号

(2021) SPC IP Admin. Final 278

### **【基本案情】**

#### **[Case Facts]**

在上诉人叶露微与被上诉人国家知识产权局专利行政纠纷案中，国家知识产权局于 2020 年 3 月 24 日作出专利申请驳回复审决定，于 2020 年 4 月 7 日向叶露微即专利申请人电子申请客户端发送该复审决定，又于 2020 年 4 月 14 日向叶露微联系电话发送短信提醒其于 15 日内通过电子申请客户端接收该复审决定。叶露微主张其于 2020 年 4 月 29 日下载了该复审决定。后于 2020 年 7 月 11 日向北京知识产权法院（以下简称一审法院）提起行政诉讼。一审法院根据《中华人民共和国电子签名法》（以下简称电子签名法）第十一条第二款规定，认定叶露微收到复审决定的时间为 2020 年 4 月 7 日，其于 2020 年 7 月 11 日提起诉讼超过了专利法第四十一条第二款规定的三个月起诉期限，故对叶露微的起诉不予立案。叶露微不服，向最高人民法院提起上诉，认为根据国家知识产权局《关于专利电子申请的规定》第九条第二款规定，叶露微收到复审决定的时间应为 4 月 22 日（4 月 7 日+15 日），且即使以国家知识产权局短信提示时间 4 月 14 日或者叶露微下载复审决定时间 4 月 29 日为起算点，其 7 月 11 日提起诉讼均未超过起诉期限。最高人民法院于 2021 年 6 月 22 日裁定撤销原裁定，本案指令北京知识产权法院立案受理。

In the administrative patent dispute between the appellant Ye Luwei and the appellee China National Intellectual Property Administration (the “CNIPA”), the CNIPA issued a reexamination decision on the rejection of the patent application on March 24, 2020, sent the decision to Ye Luwei's electronic application client on April 7, 2020, and sent a text message to Ye Luwei's contact number on April 14, 2020 to remind him of receiving the reexamination decision through the electronic application client within 15 days. Ye Luwei asserted that he downloaded the reexamination decision on April 29, 2020. Later, he filed an administrative lawsuit with the Beijing Intellectual Property Court (the Court of First Instance) on July 11, 2020. The Court of First Instance held, in accordance with Article 11(2) of *the Electronic Signature Law of the People's Republic of China* (“*the Electronic Signature Law*”), that the date on which Ye Luwei received the reexamination decision is April 7, 2020, and that the lawsuit filed on July 11, 2020 exceeded the three-month period as stipulated in Article 41(2) of *the Patent Law*, so Ye Luwei's lawsuit was not filed. Not satisfied with the first-instance ruling, Ye Luwei appealed to the SPC, arguing that according to Article 9(2) of *the Provisions on Electronic Patent Application* made by the CNIPA, the date when Ye Luwei received the reexamination decision should be April 22 (April 7 + 15 days), and that even if the

starting point is the date of April 14 when Ye Luwei received the message from the CNIPA, or the date of April 29 when Ye Luwei downloaded the reexamination decision, his lawsuit filed on July 11 also does not exceed the deadline for filing a lawsuit. On June 22, 2021, the SPC ruled to revoke the first-instance ruling and ordered the Beijing Intellectual Property Court to put the case on file.

### **【裁判意见】**

#### **[Judge's Opinion]**

最高人民法院二审认为，根据专利法第四十一条第二款的规定，专利申请人提起行政诉讼的期限是自收到专利复审决定之日起三个月，起诉期限的起算点是收到有关专利复审决定之日。一般而言，根据案件有关证据能够证明专利申请人实际收到专利复审决定时间的，以实际收到之日为专利申请人提起行政诉讼期限的起算点；而当有关证据难以证明专利申请人实际收到专利复审决定的时间，或者国务院专利行政部门对于专利复审决定收到时间另有规定或与专利申请人另有约定，且该规定或约定有利于专利申请人，也不违反法律、行政法规禁止性规定的，人民法院可以根据该规定或约定确定专利复审决定收到时间，以充分保障行政相对人的诉权。同时，专利复审决定收到时间的确定还应符合行政相对人信赖利益保护原则，即行政相对人基于对行政机关行政行为合法性及有效性的信赖利益受到法律保护，应充分考虑该行政行为给予行政相对人的合理信赖，根据具体案情对收到专利复

审决定的时间作出有利于行政相对人的解释。

In the second instance, the SPC held that according to the provisions of Article 41(2) of the Patent Law, the time limit for filing an administrative lawsuit by a patent applicant is three months as of the date of receipt of the patent reexamination decision, and the prosecution term starts from the date of receipt of the said patent reexamination decision. Generally speaking, if documented evidence can prove the date on which the administrative counterpart actually received the patent reexamination decision, the date of actual receipt is the starting point of the prosecution term; if documented evidence cannot prove the date on which the administrative counterpart actually received the Disputed Decision, or if the Patent Administration Department of the State Council has other provisions or make agreements with the counterpart on the time when the patent reexamination decision is received, and such provisions or agreements are in favor of the administrative counterpart and do not violate the prohibition of laws and administrative regulations, the people's court can determine the time of the receipt of the patent reexamination decision in accordance with such provisions or agreements, so as to fully protect the administrative counterpart's right of action. Meanwhile, the determination of the time when the patent reexamination decision is received should also conform to the

principle of protection of the administrative counterpart's reliance interests. In other words, the administrative counterpart's reliance interests based on the legality and validity of the administrative act of the administrative agency should be protected by law. Full consideration should be given to the reasonable trust of the administrative counterpart in the administrative act, and the time of receipt of the patent reexamination decision should be explained in favor of the administrative counterpart as the case may be.

本案中，国家知识产权局在以电子文件形式发送被诉决定的情形下，虽然根据电子签名法第十一条第二款“收件人指定特定系统接收数据电文的，数据电文进入该特定系统的时间，视为该数据电文的接收时间”的规定，起诉期限的起算点原则上应为被诉决定电子文件进入收件人叶露微指定的特定系统之日。但是，国家知识产权局颁布了《关于专利电子申请的规定》，该规定第九条第二款载明“对于专利电子申请，国家知识产权局以电子文件形式向申请人发出的各种通知书、决定或者其他文件，自文件发出之日起满 15 日，推定为申请人收到文件之日”。同时，叶露微与国家知识产权局签订的《专利电子申请系统用户注册协议》中明确以该规定为依据。因此，根据电子签名法第十一条第三款“当事人对数据电文的发送时间、接收时间另有约定的，从其约定”和第三十五条“国务院或者国务院规定的部门可以依据本法制定政务活动和其他社会活动中使用电子签名、数据电文的具体

办法”等规定，本案被诉决定电子送达时间应适用《关于专利电子申请的规定》第九条第二款的规定，同时结合叶露微对国家知识产权局有关行政行为的合理信赖予以确定。

In this case, when the CNIPA sends the Disputed Decision in the form of an electronic document, according to Article 11(2) of *the Electronic Signature Law*, “if the addressee designates a specific system to receive electronic data, the time when the electronic data enters the specific system should be deemed to be the time when the electronic data is received”, in principle, the prosecution period should start from the date when the electronic reexamination decision enters the specific system designated by the addressee Ye Luwei. But according to Article 9(2) of the *Provisions on Electronic Patent Application Filed*, as for electronic patent applications, it should be presumed that the applicant receives notices, decisions or other documents fifteen days after the date when the CNIPA sends such notices, decisions or other documents to the applicant in the form of an electronic document. At the same time, the User Registration Agreement of Electronic Patent Application System signed between Ye Luwei and the CNIPA clearly states that this provision is applied. Therefore, according to Article 11 (3) of *the Electronic Signature Law* that stipulates that if the party involved agrees otherwise on the time of sending and receiving electronic

data, the agreement should prevail and Article 35 of *the Electronic Signature Law* that stipulates that the State Council or the departments prescribed by the State Council can formulate specific measures for the use of electronic signatures and electronic data in government affairs and other social activities in accordance with this Law, the time of electronically delivering the Disputed Decision should be determined in accordance with the provisions of Article 9(2) of the *Provisions on Electronic Patent Application*, combined with Ye Luwei's reasonable reliance in the relevant administrative actions of CNIPA at the same time.

根据审理查明的事实，国家知识产权局于 2020 年 4 月 7 日向叶露微电子申请客户端发送被诉决定，并于 2020 年 4 月 14 日向叶露微发送短信，提醒其于 15 日内下载被诉决定。该发送短信行为属具体行政行为的过程性行为，不构成独立的行政行为，应认定属于本案专利复审决定行政行为的组成部分。对于专利申请人叶露微而言，无论是基于对国家知识产权局制定的规范性文件的遵循，还是基于对《专利电子申请系统用户注册协议》的遵守，抑或基于对国家知识产权局所作有关短信通知行为的信赖，其都能够合理预期以 2020 年 4 月 7 日（发文日）加 15 日或者 2020 年 4 月 14 日（短信提醒日）加 15 日作为起诉期限的起算点，其于 7 月 11 日起诉均未超过专利法第四十一条第二款规定的法定期限。在对被诉决定送达时间存在多种理解的情形下，为保护行政相对人

的信赖利益，充分保障其诉权行使，宜作出有利于行政相对人的解释，认定本案期限利益归于专利申请人，即应以被诉决定发出后国家知识产权局专门发送短信提醒日加 15 日即 2020 年 4 月 29 日作为计算叶露微提起行政诉讼期限的起点。叶露微于 2020 年 7 月 11 日向一审法院提起诉讼未超过三个月起诉期限，且符合《中华人民共和国行政诉讼法》第四十九条所规定的起诉条件，本案应当立案受理。

According to the facts ascertained in the hearing, the CNIPA sent the Disputed Decision to Ye Luwei's electronic application client on April 7, 2020 and sent a text message to Ye Luwei on April 14, 2020 to remind him of downloading the Disputed Decision within 15 days. As a procedural behavior of a specific administrative act, sending text message does not constitute an independent administrative act and should be identified as an integral part of the reexamination decision. As for the patent applicant Ye Luwei, whether based on the compliance with the normative documents formulated by the CNIPA, or based on the compliance with the User Registration Agreement of Patent Electronic Application System, or based on the reliance on the text message sent by the CNIPA, he can reasonably expect that April 7, 2020 (the date of issuance) plus 15 days or April 14, 2020 (the date when the text message is sent as a reminder) plus 15 days is the starting point for the prosecution term,

and when he files a lawsuit on July 11 does not exceed the statutory term stipulated in Article 41(2) of the Patent Law. Under the circumstance that there are multiple interpretations of the time when the Disputed Decision is served, in order to protect the reliance interests of the administrative counterparty and fully safeguard the exercise of his litigation right, it is advisable to make an explanation in favor of the administrative counterparty and to determine that the benefit of the time limit in this case belongs to the patent applicant. That is, the starting point for calculating the time limit for Ye Luwei to file an administrative lawsuit should be the date when CNIPA sent the text message as reminder after the Disputed Decision is issued plus 15 days (i.e., April 29, 2020). Ye Luwei filed a lawsuit in the Court of First Instance on July 11, 2020, which does not exceed the three-month period and meet the filing conditions stipulated in Article 49 of *the Administrative Procedure Law of the People's Republic of China*. Therefore, the case should be put on file.

## 二、专利民事案件

### II. Civil Patent Cases

#### 17. 权利要求和说明书已明确界定的技术特征的解释

## **Interpretation of technical features explicitly defined by claims and descriptions**

### **【裁判要旨】**

#### **[Judgment Digest]**

对于权利要求和说明书已有明确界定的技术特征, 不能脱离其所界定的明确含义对其作抽象解释, 进而不适当地扩大专利权的保护范围。

The technical features explicitly defined by claims and description shall not be abstractly construed beyond their explicit definitions, thus inappropriately expanding the protection scope of the patent.

### **【关键词】**

#### **[Keywords]**

发明专利 侵权 权利要求解释 明确界定

invention patent; infringement; claim construction; explicitly defined

### **【案号】**

#### **[Case Number]**

(2020) 最高法知民终 1742 号

(2020) SPC IP Civil Final 1742

### **【基本案情】**

## **[Case Facts]**

在上诉人叶帅（系原武汉九万里科技有限公司的股东，该公司以下简称九万里公司，在二审程序中被核准注销）、深圳市福田区嘉乐装饰五金商行（以下简称嘉乐五金商行）与被上诉人深圳前海火树星桥科技有限公司（以下简称前海公司）侵害发明专利权纠纷案中，前海公司认为，九万里公司制造、销售、许诺销售以及嘉乐五金商行销售、许诺销售的 W300、W500 两种型号智能锁，侵害了其专利号为 200910300458.8、名称为“电子锁系统及其电子锁和解锁方法”发明专利（以下简称涉案专利）权，故向广东省深圳市中级人民法院（以下简称一审法院）提起诉讼。一审法院认为，被诉侵权产品落入涉案专利权利要求 6、10 的保护范围。判决嘉乐五金商行、九万里公司停止侵害，嘉乐五金商行赔偿经济损失 2 万元，九万里公司赔偿经济损失 100 万元和维权合理开支 18982 元。九万里公司、嘉乐五金商行不服，向最高人民法院提起上诉。最高人民法院于 2021 年 12 月 16 日判决撤销原判驳回前海公司的诉讼请求。

In the case concerning infringement of an invention patent between the appellants Ye Shuai, the shareholder of the former Wuhan Jiuwanli Technology Co., Ltd (“Jiuwanli”, which was approved for cancelation in the second instance) and Shenzhen Futian District Jiale Decoration Hardware Store (“Jiale Hardware”), and the appellee Shenzhen Qianhai Huoshu Xingqiao Technology

Co., Ltd (“Qianhai”), Qianhai filed a lawsuit in Shenzhen Intermediate People’s Court (the Court of First Instance), arguing that the W300, the W500 smart lock manufactured, sold and offered for sale by Jiuwanli and sold and offered for sale by Jiale Hardware infringed its invention patent No. 200910300458.8, titled “Smart Electronic Lock System and Smart Electronic Locking and Unlocking Method” (the involved patent). The Court of First Instance held that the disputed infringing product was within the protection scope defined in claims 6 and 10. Therefore, it ruled that Jiale Hardware and Jiuwanli should cease the infringement, Jiale Hardware should pay CNY 20,000 in compensation for economic losses, and Jiuwanli should pay CNY 1,000,000 in compensation for economic losses and CNY 18,982 for reasonable rights protection expenses. Jiale Hardware and Jiuwanli refused to accept the decision and appealed to the SPC. On December 16, 2020, the SPC reversed the original judgment and rejected the claims of Qianhai.

### **【裁判意见】**

#### **[Judge’s Opinion]**

最高人民法院二审认为，关于权利要求的解释，人民法院应当根据权利要求的记载，结合本领域技术人员阅读说明书及附图后对权利要求的理解，确定专利法第五十九条第一款规定的权利要求的内容。对于权利要求和说明书已有明确界定的特定技术特

征，原则上不能脱离说明书对其作抽象解释，进而不适当地扩大专利权的保护范围。具体到本案，涉案专利权利要求 6 和 10 明确记载了“预设的通知信息”内容。根据专利说明书第[0020]段关于“……所述密码、通知信息、验证信息为文字或者数字。所述用户密码、通知信息和验证信息也可以是同一个数据”的记载，本领域技术人员可知电子锁“预设的通知信息”应为具体的数据信息，其内容特定，从而可以预设于电子锁存储单元中，并发送给通讯设备使电子锁与通讯设备之间实现特定通知信息的传输，通讯设备根据该特定通知信息输出提示信息供用户选择确认。故涉案专利权利要求 6 和 10 记载的“预设的通知信息”相关技术特征，限定了电子锁与通讯设备之间传输预设于锁体存储单元中的特定通知信息的通信方式。虽然该特定的通知信息的具体内容不必然为用户所感知，但其应具有特定性和可识别性，能够与其他信息区别开。据此，不能将所有电子锁与通讯设备之间进行通信的技术方案均纳入涉案专利权的保护范围，而应将其限定在传输预先设定的特定通知信息范畴。

In the second instance, the SPC held that in terms of claim construction, the people's court should determine the content of the claims provided in Article 59(1) of the Patent Law, in accordance with the terms in and the understanding of claims after a person skilled in the art had seen the description and the appended drawings. In principle, the technical features explicitly defined by

the claims and the descriptions should not be abstractly interpreted beyond the description, thus inappropriately expanding the protection scope of the patent right. Specifically in this case, claims 6 and 10 of the involved patent explicitly recorded “predetermined notification information”. Subject to the record in paragraph [0020] of the description that the “...aforementioned password, notification information and verification information are words or numbers. The aforementioned user password, notification information and verification information may also be the same data”, a person skilled in the art can know that the “predetermined notification information” of the electronic lock should consist of specific data information with particular content, which can be preset in the storage unit of the electronic lock and sent to the communication device to transfer specific notification information between the electronic lock and the communication device. Then, on the basis of this specific notification information, the communication device can output an information message for the user to select and confirm. Therefore, the relevant technical features of “predetermined notification information” recorded in claims 6 and 10 of the involved patent restricted the communication method in which the specific notification information preset in the storage unit of the lock was transferred between the electronic lock and the communication

device. Although it is unnecessary for users to know the specific content of the particular notification information, it should be particular and identifiable enough to be distinguished from other information. Accordingly, not all technical solutions for communication between electronic locks and communication devices can be included in the scope of the claims of the involved patent, which should be restricted to transmission of particular preset notification information.

经比对，被诉侵权产品在手机安装 APP 后，访客触发门铃，智能锁与手机通过视频通讯的方式建立连接，传输实时采集的视音频数据以帮助用户作出是否开锁的决定。被诉侵权产品开锁过程中的来电显示界面系由手机安装的 APP 基于视频通话请求生成，而该视频通话请求形成于建立通话连接的动态指令交互过程而非来源于智能锁中预存的特定通知信息，故难以认定智能锁中预设有通知信息，以及智能锁与手机之间传输该预设的通知信息。虽然被诉侵权产品用户可以根据指令提示选择进行视频通话、挂断、开锁等多种操作，但上述过程与涉案专利权利要求 6 和 10 限定的基于“预设的通知信息”的协同处理过程不同。即，被诉侵权产品与涉案专利技术方案相比，二者在电子锁和通讯设备之间采用的通信方式不同，被诉侵权产品智能锁不需要传输“预设的通知信息”，而是建立视频通讯传输通道以传输动态信息，手机基于视频通讯实时获取智能锁门前访客信息并即时确认是否开

锁，二者实现的技术功能和技术效果也不同。综上，被诉侵权产品智能锁不存在“预设的通知信息”及相应的信息传输技术特征，未落入涉案专利权利要求6和10的保护范围。

By comparison, after the app of the disputed infringing product is installed on a cell phone, when a visitor triggers the doorbell, the smart lock is connected to the cell phone via video to transmit video and audio data collected in real time to help the user decide whether to unlock the door. The caller ID interface used in the unlocking process of the disputed infringing product is generated by the app installed on the cell phone based on the video call request, which is formed in the dynamic command interactive process of establishing a call connection, rather than from the particular notification information preset in the smart lock. For this reason, it is difficult to determine that the notification information is preset in the smart lock, and this preset notification information is transmitted between the smart lock and the cell phone. Although the user of the infringing product at issue can choose to make video calls, hang up, unlock the door and perform other operations on command, the above process is different from the collaborative process based on “predetermined notification information” defined in claims 6 and 10 of the involved patent. This means that when comparing the infringing product with the technical solution for the involved patent, they used different

methods of communication between the electronic lock and the communication device. The smart lock of the infringing product does not need to transmit “predetermined notification information”, but instead establishes a video communication transmission channel to transmit dynamic information, and cell phones receive information about visitors in front of the smart lock door in real time via video so that the user can instantly confirm whether to unlock the door. Therefore, the two devices are also different in terms of technical functions and technical effects. In conclusion, as the infringing product “smart lock” does not have “predetermined notification information” or the corresponding technical features for information transmission, it is beyond the protection scope defined in claims 6 and 10 of the involved patent.

## 18. 使用环境特征的认定

### **Identification of usage environment features**

#### **【裁判要旨】**

#### **[judgment Digest]**

使用环境特征系权利要求中用来描述发明创造的使用背景或者条件的技术特征, 其并不限于与被保护对象的安装位置或者连接结构等相关的技术特征, 在特定情况下还包括与被保护对象

的用途、适用对象、使用方式等相关的技术特征。

Usage environment features are technical features used to describe the application backgrounds or conditions of inventions in claims. They are not limited to technical features related to the installation position or connection structure of the protected object. In specific circumstances, usage environment features also include technical features relating to usage, applicable objects, methods of use and other elements.

**【关键词】**

**[Keywords]**

发明专利 侵权 使用环境特征

invention patent; infringement; usage environment  
features

**【案号】**

**[Case Number]**

(2020) 最高法知民终313号

(2020) SPC IP Civil Final 313

**【基本案情】**

**[Case Facts]**

在上诉人ALC粘合剂技术责任有限公司（以下简称ALC粘合剂公司）与上诉人温州市星耕鞋材有限公司（以下简称星耕鞋材公司）侵害发明专利权纠纷案中，涉及专利号为200780032234.2、

名称为“在例如鞋的内鞋底的物体的表面上施加粘合剂层的机器和相关方法”的发明专利（以下简称涉案专利）。ALC粘合剂公司认为，星耕鞋材公司销售的“烫底机”及“烫底胶”涉嫌侵害ALC粘合剂公司涉案专利权，故向浙江省宁波市中级人民法院（以下简称一审法院）提起诉讼。一审法院认为，被诉侵权技术方案落入涉案专利权的保护范围，酌定星耕鞋材公司赔偿经济损失6万元（包含维权合理开支）。ALC粘合剂公司、星耕鞋材公司均不服，向最高人民法院提起上诉。ALC粘合剂公司主张，一审判决判赔金额过低，不足以弥补其经济损失。星耕鞋材公司主张，被诉侵权产品不具备涉案专利权利要求1中的多个技术特征，不构成专利侵权。最高人民法院于2021年4月8日判决维持原判关于停止侵害的判项，改判星耕鞋材公司赔偿经济损失20万元和维权合理开支5万元。

The case concerning infringement of an invention patent between the appellant ALC Adhesive Technology Co., Ltd. (“ACL Adhesive”) and the appellee Wenzhou Xinggeng Shoes Materials Co., Ltd. (“Xinggeng Shoes Material”) involves invention patent No. 200780032234.2, titled “Machine and Related Methods of Applying an Adhesive Layer to a Surface of an Object, such as the Inner Sole of a Shoe” (the involved patent). ACL Adhesive filed a lawsuit in Ningbo Intermediate People’s Court (the Court of First Instance), arguing that the “ironing machine” and “ironing glue” sold by

Xinggeng Shoes Material infringed the involved patent of ACL Adhesive. The Court of First Instance held that the technical solution for the disputed infringement was within the protection scope of the involved patent, and Xinggeng Shoes Material was ordered to pay damages of CNY 60,000 for economic losses (including reasonable expenses for rights protection) at the court's discretion. Both ACL Adhesive and Xinggeng Shoes Material refused to accept the decision and appealed to the SPC. ACL Adhesive claimed that the amount of compensation it received in the first instance was too low to compensate for its economic losses. Xinggeng Shoes Material alleged that the infringing product did not have several technical features in claim 1 of the involved patent, and thus did not constitute a patent infringement. On April 8, 2021, the SPC upheld the original judgment on the cessation of infringement and amended it, ordering Xinggeng Shoes Material to pay damages of CNY 200,000 for economic losses and CNY 50,000 for reasonable rights protection expenses.

### **【裁判意见】**

#### **[Judge's Opinion]**

最高人民法院二审认为, 关于被诉侵权产品是否具有“第一带”“第二带”“所述物体”等技术特征。“第一带”“第二带”“所述物体”构成涉案专利被保护主题对象“机器”的使

用环境特征。所谓使用环境特征，是指权利要求中用来描述发明所使用的背景或条件的技术特征。按照技术特征所限定的具体对象的不同，技术特征可分为直接限定专利保护主题对象本身的技术特征以及通过限定保护主题对象之外的技术内容来限定保护主题对象的技术特征。前者一般表现为直接限定专利保护主题对象的结构、组分、材料等，后者则表现为限定专利保护主题对象的使用背景、条件、适用对象等，进而间接限定专利保护主题对象因而被称为“使用环境特征”。常见的使用环境特征多表现为限定被保护主题对象的安装、连接、使用等条件和环境。但鉴于专利要求保护的技术方案的复杂性，使用环境特征并不仅仅限于那些与被保护主题对象安装位置或连接结构直接有关的结构特征。对于产品权利要求而言，用于说明有关被保护主题对象的用途、适用对象、使用方式等的技术特征，虽对产品的结构并不具有直接限定作用，也属于使用环境特征。

In the second instance, regarding to whether the infringing product was characterized by the “first tape”, “second tape”, “aforementioned object” and other technical features, the “first tape”, “second tape”, and “aforementioned object” constituted usage environment features for the protected object “machine” of the involved patent. Usage environment features are technical features used to describe the usage background or conditions of the claimed invention. In terms of different specific objects defined by technical

features, technical features can be divided into those that directly define the patent subject matter itself and those that define the patent subject matter by defining its external technical content. The former is generally manifested as directly limiting the structure, components, materials, etc. of the subject matter of patent protection, while the latter is manifested as limiting the usage background, conditions, and applicable objects of the patent subject matter, etc., and is therefore known as “usage environment features”. Common usage environment features are mainly manifested as limitation of the installation, connection, usage and other conditions and environments of the protected object. However, due to the complexity of technical solutions for patent claim protection, usage environment features are not only limited to structural features directly related to the installation position or connection structure of the protected object. In view of product claims, although the technical features designed to illustrate the usage, applicable object, method of use and other aspects of the protected object cannot directly define the structure of the product, they are classified as usage environment features.

本案涉案专利权利要求1的被保护主题对象是“一种能够施加粘合剂层到一物体表面的机器”，根据说明书第[0007]、[0008]段记载，本发明的目的是提供一种用于给物体表面施加粘合剂层

的机器，该机器高效、自动、快速，并仅执行少量的操作，其设计确保操作者的高度安全。通过阅读说明书和附图，本领域技术人员可以理解，本发明中，机器是涉案发明的保护主题对象，通过机器的第一进料装置输送“第一带”、第二进料装置输送“第二带”，并利用机器剥离装置的共同作用，可实现在“所述物体”一表面上施加粘合剂并剥离多余粘合剂的功能。当事人双方均认可，涉案专利技术方案中所述“第一带”相当于胶带、“第二带”相当于薄膜。“所述物体”实际只要具备两个相反表面即可在此，“第一带”“第二带”及“所述物体”均不是机器本身的组成部件，“第一带”“第二带”是机器运转过程中必备的物料。“所述物体”是机器的加工对象，系用于说明被保护主题对象的用途、适用对象、使用方式等的技术特征，属于使用环境特征。被诉侵权机器可以适用于“第一带”“第二带”“所述物体”等使用环境，具有与之相应的涉案专利技术特征。

The protected object defined in the claim 1 of the involved patent is “a machine capable of applying an adhesive layer to the surface of an object”. According to the record in paragraph [0007] and [0008] of the description, the invention aims to provide a machine that is efficient, automatic, fast, and designed to ensure a high degree of safety for the operator when applying an adhesive layer to the surface of an object in only a few steps. By looking at the description and drawings, a person skilled in the art can

understand that, in this invention, the machine is the protected object of the involved patent and it is possible to apply adhesive to one surface of “the aforementioned object” and to peel off the excess adhesive using the machine’s first feeding device to deliver the “first tape”, the second feeding device to deliver the “second tape”, and the machine’s peeling device. Both parties agreed that the said “first tape” in the technical solution for the involved patent was equivalent to tape and the “second tape” was identical to membrane. It is, in fact, sufficient for the “aforementioned object” to have two opposite surfaces. Here, the “first tape”, “second tape” and “aforementioned object” are not components of the machine itself. The “first tape” and the “second tape”, as necessary materials in the process of the machine’s operation, and the “aforementioned object”, as the processing object of the machine, are the technical features used to explain the usage, applicable object and the method of use of the protected subject matter, making them usage environment features. With the corresponding technical features of the involved patent, the disputed infringing machine can be applied to the “first tape”, “second tape”, “aforementioned object” and other application environments.

## 19. 存在多种使用环境时功能性特征内容的认定

## **Identification of the content of functional features in multiple usage environments**

### **【裁判要旨】**

#### **[Judgment Digest]**

在专利技术方案存在多种使用环境的情况下，结合说明书记载的具体实施方式确定功能性特征的内容时，应当从本领域技术人员角度，区分具体实施方式中为实现该功能性特征限定的功能或者效果不可缺少的技术特征和因使用环境不同而产生的适应性技术特征，适应性技术特征通常并不属于功能性特征的内容。

In the case where the patented technical solution can be implemented in multiple usage environments, a distinction, from the perspective of a person skilled in the art, should be made between the technical features that are indispensable for realizing the function or effect defined by the functional features in the specific embodiment on one hand, and the adaptive technical features arising from different usage environments, when determining the content of functional features in view of the specific embodiment in the description. In general, adaptive technical features cannot be classified as content of functional features.

### **【关键词】**

#### **[Keyword]**

发明专利 侵权 功能性特征 使用环境 适应性技术特征

invention patent; infringement; functional features; usage environment; adaptive technical features

### **【案号】**

#### **[Case Number]**

(2019) 最高法知民终 409 号

(2019) SPC IP Civil Final 409

### **【基本案情】**

#### **[Case Facts]**

在上诉人苏州云白环境设备股份有限公司（以下简称云白公司）与被上诉人苏州泰高烟囱科技有限公司（以下简称泰高公司）吴江市宝新金属制品有限责任公司（以下简称宝新公司）侵害发明专利权纠纷案中，涉及专利号为 201010160845.9、名称为“内外筒型自立式钢烟囱”的发明专利（以下简称涉案专利）。云白公司认为，泰高公司、宝新公司共同制造了侵害涉案专利权的烟囱，故向江苏省苏州市中级人民法院（以下简称一审法院）提起诉讼。一审法院认为，被诉侵权产品不具有与涉案专利权利要求 1 中“横向固定纵向滑动结构”相同或等同的技术特征，未落入涉案专利权的保护范围，判决驳回云白公司的诉讼请求。云白公司不服，向最高人民法院提起上诉。最高人民法院于 2020 年 6 月 19 日改判侵权成立，并判决泰高公司、宝新公司停止侵害，泰高公司赔偿经济损失 100 万元以及维权合理开支 12 万余元。

The case concerning infringement of an invention patent between the appellant Suzhou Rainbow Environmental Equipment Co., Ltd. (“Rainbow”) and the appellees Suzhou Taigao Chimney Technology Co., Ltd. (“Taigao”) and Wujiang Baoxin Metal Products Co., Ltd. (“Baoxin”) involves invention patent No. 201010160845.9, titled “Inner and Outer Barrel Type Free-standing Steel Chimney” (the involved patent). Rainbow filed a lawsuit in Suzhou Intermediate People’s Court (the Court of First Instance), arguing that Taigao and Baoxin jointly manufactured the chimney that infringed the involved patent. The Court of First Instance held that the infringing product at issue did not have technical features that were the same as or equivalent to the “transverse-fixed longitudinal-sliding structure” in claim 1, and was beyond the protection scope of the involved patent. Hence, the Court of First Instance rejected the claims of Rainbow. Rainbow refused to accept the judgment and appealed to the SPC. On June 19, 2020, the SPC reversed the original judgment and determined that infringement had taken place, ruling that Taigao and Baoxin should cease the infringement, and Taigao should pay damages of CNY 1 million yuan for economic losses and over CNY 12 thousand for reasonable rights protection expenses.

### 【裁判意见】

## **[Judge's Opinion]**

最高人民法院二审认为，对于权利要求中以功能或者效果表述的技术特征，应当结合说明书和附图描述的该功能或者效果的具体实施方式及其等同的实施方式，确定该技术特征的内容。在说明书记载的专利技术方案存在多种使用环境的情况下，专利权人通常无须一一列举说明各种使用环境下的具体实施方式。当说明书仅给出了一种使用环境下的实施例但又明确记载了该技术方案可适用于多种使用环境时，本领域技术人员通过阅读专利权利要求书，并根据已知实施例可以直接、明确获得的在其他使用环境下的实施方式，应当属于该功能性限定技术特征的内容。换言之，对于本领域技术人员而言，该实施方式是其在阅读说明书所记载的实施例后根据公知常识和常规技术手段很容易获得的。在此过程中，本领域技术人员根据权利要求书和说明书的记载，基于对功能性限定的技术特征的理解，能够明确获悉已知实施例中该功能性限定技术特征的基本特征与适应性特征，很容易即可获得其他使用环境下的实施方式。其中，基本特征为实现该功能效果必不可少的特征，是功能性限定的技术特征的本质特征，在各种使用环境下均不可或缺；适应性特征是因不同使用环境而具有的适应特定使用环境的特征，是在各种使用环境下起到适应、配合作用的辅助性、非本质、可变化的特征。

In the second instance, the SPC held that the content of the technical features described as function or effect in claims should be

determined in combination with the specific method of implementation or the equivalent implementation method illustrated in the description and drawings. When a patent technical solution recorded in description includes several usage environments, it is unnecessary for the patentee to enumerate and explain the specific method of implementation in each usage environment. When the description only provides one implementation in one usage environment, but explicitly records that when this technical solution can be applied in several usage environments, if a person skilled in the art, by reading the claims and in accordance with the known implementation cases, can directly and explicitly obtain the implementation method in other usage environments, it should be recognized as content of these technical features that are defined in function. In other words, for a person skilled in the art, it is easy to obtain the aforementioned implementation method on the basis of common general knowledge and regular technical means after they have read the implementation cases recorded in the description. In this process, a person skilled in the art, in accordance with the records in the claims and description, and based on understanding of technical features defined in function, can be explicitly informed of the essential and adaptive features of these technical features in the known implementation cases. Among them, basic features, as the

essence of the technical features that are defined in function, are essential to achieve the functional effect and are indispensable in all kinds of usage environments; adaptive features are features that are able to adapt to different specific usage environments. They are auxiliary, non-essential and changeable features that play an adaptive and cooperative role in various usage environments.

就本案涉案专利而言, 仅凭权利要求 1 中“横向固定纵向滑动结构”的文字表述, 本领域技术人员显然无法直接、明确地确定实现上述功能或者效果的具体实施方式, 因此该项技术特征为功能性限定的技术特征, 应当结合说明书和附图描述的该功能或者效果的具体实施方式及其等同的实施方式, 确定该技术特征的内容。首先, 涉案专利说明书具体实施方式部分的实施例记载了一种双内筒烟囱的实施方法, 由此可知, 在双内筒情形下, “横向固定纵向滑动结构”主要通过“滑动套筒”“套筒固定板”“若干滑动支点”以及该三者之间的相应位置和连接关系来实现内筒横向不晃动、纵向可滑动的功能。本领域技术人员在阅读上述实施例后, 可明确知晓“滑动支点”系实现该横向固定纵向滑动功能效果的基本特征; 而在双内筒烟囱的使用环境下, “滑动支点”的固定定位是需解决的技术问题, 涉案专利通过将“滑动支点”与“滑动套筒”“套筒固定板”及“外筒”的固定连接实现了“滑动支点”在双内筒环境下的固定定位, “滑动套筒”“套筒固定板”作为适应特定使用环境的适应性特征起到

了固定连接“滑动支点”的作用。其次，涉案专利权利要求1并未限定“横向固定纵向滑动结构”仅适用于双内筒式烟囱，且根据涉案专利权利要求10及说明书[0034]段的记载，该技术方案同样适用于单内筒式。在涉案专利说明书并未直接记载单内筒实施方式的情况下，本领域技术人员在阅读说明书记载的相对复杂的双内筒实施方式后，基于对权利要求及说明书的理解，根据公知常识和常规技术手段对“横向固定纵向滑动结构”特征中基本特征与适应性特征的分解，可直接、明确地获得横向固定纵向滑动功能在更为简单的单内筒环境下的实现方式。由于在单内筒环境下，单内筒外直接套有外筒，“滑动支点”与“外筒”的连接已无需通过其他连接单元即可直接固定连接，从而实现“横向固定纵向滑动”的功能和效果。也即双内筒环境下所需的“滑动套筒”与“套筒固定板”该两项适应特定使用环境的特征，在单内筒情况下，并非必备技术特征。被诉侵权产品为单内筒式烟囱，其下段内筒外壁顶部设有六个长梯形部件，中间段内筒外壁顶部交叉设置有三长三短梯形部件，其中上述长梯形部件的端部设有便于滑动摩擦的塑料块，与外筒内壁距离较近。上述长梯形部件均布于内筒外壁，相当于涉案专利的“滑动支点”，与套设于内筒外面的外筒相配合，可以保证内筒横向不晃动、纵向可滑动。该单内筒实施方式属于本领域技术人员在阅读涉案专利权利要求书和说明书所记载的实施例后很容易获得的。因此，被诉侵权产品的上述特征与涉案专利权利要求中“横向固定纵向滑动结

构”特征构成相同的技术特征。

In terms of the involved patent, it is evident that a person skilled in the art cannot directly and explicitly determine implementations to realize the aforementioned function or effect only based on the written description of “transverse-fixed longitudinal-sliding structure” in claim 1. Therefore, the technical features are defined in function, and should be determined in combination with the specific method of implementation of the function or effect described in the description and drawings, as well as the equivalent implementation method. Firstly, the implementation method of a double inner barrel chimney is recorded in the implementation cases of the specific method of implementation section described in the description. This demonstrates that in the case of the double inner barrel, the “transverse-fixed longitudinal-sliding structure” makes it possible for the inner barrel not to sway in the transverse direction and to slide in the longitudinal direction, mainly through the “sliding sleeve”, “sleeve fixing plate” and “a number of sliding pivot points” and their corresponding position and connection. By reading the aforementioned implementation cases, a person skilled in the art can be explicitly informed that the “sliding pivot point” is the basic feature conducive to realizing the function and effect of fixing in the

transverse direction and sliding in the longitudinal direction, while in the usage environment of the double inner barrel chimney, the fixed position of the “sliding pivot point” remains a technical problem that must be solved. Based on this, the involved patent realizes the fixed position of the “sliding pivot point” in the case of the double inner barrel by fixedly connecting the “sliding pivot point” with the “sliding sleeve”, “sleeve fixing plate” and “outer barrel”, while the “sliding sleeve” and “sleeve fixing plate”, as adaptive technical features that adapt to their specific usage environment, contribute to fixedly connecting the “sliding pivot point”. Secondly, subject to claim 1, the “transverse-fixed longitudinal-sliding structure” is not limited to application in the double inner barrel chimney. In addition, in accordance with claim 10 and the record of paragraph [0034] of the description, the technical solution is also applicable to the single inner barrel chimney. In the event that the implementation method of the single inner barrel is not directly recorded in the claims of the involved patent, by reading the relatively complicated implementation method of the double inner barrel recorded in the description, on the basis of understanding of the claims and description, a person skilled in the art can directly and explicitly obtain the implementation method of fixing in the transverse direction and sliding in the longitudinal

direction in the easier circumstance of the single inner barrel, based on the decomposition of the basic and adaptive features of the “transverse-fixed longitudinal-sliding structure” in combination with common general knowledge and regular technical means. In the case of the single inner barrel, since the single inner barrel is directly connected to the outer barrel, the “sliding pivot point” and the “outer barrel” can be directly fixed without other connection units, thus realizing the function and effect of “transverse-fixed longitudinal-sliding”. In other words, the “sliding sleeve” and “sleeve fixing plate”, as features that are adapted to the specific usage environment in the double inner barrel, are not essential technical features in the case of a single inner barrel. The infringing product is a single inner barrel chimney with six long-trapezoid parts at the top of the outer wall of the lower inner barrel, and three long-trapezoid parts and three short-trapezoid parts at the top of the outer wall of the middle inner barrel, where the ends of the above long-trapezoid parts are equipped with plastic blocks for sliding friction and are closer to the inner wall of the outer barrel. The aforementioned long-trapezoid parts are all distributed on the outer wall of the inner barrel, which is equivalent to the “sliding pivot point” of the involved patent, and cooperate with the outer barrel set on the outside of the inner barrel to ensure that the inner barrel does not sway in the transverse

direction and can slide in the longitudinal direction. The implementation method of the single inner barrel is easily available to a person skilled in the art by reading the implementation cases recorded in the claims and description. Hence, the aforementioned feature of the infringing product constitutes the same technical feature as the “transverse-fixed longitudinal-sliding structure” in the claims.

## 20. 实用新型专利中功能性特征内容的认定

### **Identification of the content of functional features in a utility model patent**

#### **【裁判要旨】**

#### **[Judgment Digest]**

实用新型专利中，说明书及附图所载、为实现功能性特征所限定的功能、效果不可缺少的形状构造类特征和非形状构造类特征，均对该功能性特征具有实质限定作用，均构成功能性特征的内容，在侵权判定时均应予以考虑。

In cases concerning utility model patents, the shape-construction features and non-shape-construction features as contained in the description and drawings, which are indispensable for realizing the function and effect as described by the functional

features, shall both have substantial limitation on such functional features and both constitute the content of such functional features, and shall both be taken into account when judging whether there is infringement.

**【关键词】**

**[Keywords]**

实用新型专利 侵权 功能性特征 非形状构造类特征 实质限定作用

utility model patent; infringement; functional features; non-shape construction features; substantial restrictive effect

**【案号】**

**[Case Number]**

(2021) 最高法知民终411号

(2021) SPC IP Civil Final 441

**【基本案情】**

**[Case Facts]**

在上诉人胡雪辉与被上诉人岳霞侵害实用新型专利权纠纷案中，涉及专利号为201020293455.4、名称为“一种多功能塑料书写纸板及书写工具”的实用新型专利（以下简称涉案专利）。胡雪辉认为，岳霞在其阿里巴巴店铺内销售侵害涉案专利权的商品，给其造成重大损失，故向浙江省杭州市中级人民法院（以下简称一审法院）提起诉讼，请求判令岳霞停止侵害并赔偿经济损

失及维权合理开支3万元。一审法院认为，涉案专利要求保护的“显影层”系功能性技术特征，被诉侵权产品的显影面层是否通过一层或两层石粉混合层粘结后再与基料连接，以及被诉侵权产品的显影面层是否采用涉案专利显影层的组成方式，仅凭被诉侵权产品现状无法确定。故判决驳回胡雪辉的诉讼请求。胡雪辉不服，向最高人民法院提起上诉。最高人民法院于2021年10月25日判决驳回上诉，维持原判。

The case concerning infringement of a utility model patent between the appellant Hu Xuehui and the appellee Yue Xia involves utility model patent No. 201020293455.4, titled “Multi-function Plastic Writing Paper Board and Writing Tools” (the involved patent). Hu Xuehui filed a lawsuit in Hangzhou Intermediate People’s Court (the Court of First Instance), arguing that Yue Xia sold goods infringing the involved patent in her Alibaba store, causing him significant losses, and requesting that the Court of First Instance ordered Yue Xia to cease the infringement and to pay damages of CNY 30,000 for economic losses and reasonable right protection expenses. The Court of First Instance held that, since the “development layer” required to be protected by the involved patent was a functional technical feature, whether the development layer of the infringing product was connected to the base material with one or two mixed layers of stone powder, and whether the development

layer of the infringing product adopted the composition of the development layer of the involved patent, could not be determined by the status quo for the infringing product alone. Hence, the Court of First Instance rejected the claims of Hu Xuehui. Hu Xuehui refused to accept the judgment and appealed to the SPC. On October 25, 2021, the SPC rejected the appeal and upheld the original judgment.

### **【裁判意见】**

#### **[Judge's Opinion]**

最高人民法院二审认为，关于显影层的组成方式，其争议实质是实用新型是否只保护产品的形状、构造或者其结合，说明书第[0054]、[0057]-[0061]段关于显影层的物质组分、配方等非形状、结构或其组合的技术特征，是否应当解释为“显影层”技术特征所确定的内容。

In the second instance, the SPC held that, regarding the composition of the developing layer, the essence of the dispute was whether the utility model only protected the shape, structure or combination of the product, and whether the technical features in the paragraph [0054], [0057]-[0061] of the description concerning the material component, formula and other non-shape, non-structure or their combination of the developing layer should be interpreted as content determined by the technical features of the “developing

layer”.

根据专利法第二条第三款的规定，实用新型只保护产品的形状、构造或者其结合，产品的形状是指产品所具有的、可以从外部观察到的确定的空间形状，产品的构造是指产品的各个组成部分的安排、组织和相互关系。物质的组分、配方等不属于产品的构造。在专利授权确权中，针对实用新型新颖性、创造性评价时，对权利要求中物质的组分、配方等不属于产品的构造的内容不予考虑。但是，在侵权纠纷中，已经记载在权利要求中的有关物质的组分、配方等内容对该权利要求保护范围具有限定作用。对于权利要求中以功能或者效果表述的技术特征，人民法院应当结合说明书和附图描述的该功能或者效果的具体实施方式及其等同的实施方式，确定该技术特征的内容。是否为实现所称功能、效果不可缺少的技术特征，是判断说明书及附图记载的内容中有关技术特征具有限定作用的标准。实用新型专利中，功能性特征有关实施例中非形状、构造、或其结合的技术特征，如系实现所称功能、效果所不可缺少，仍构成对该功能性特征保护范围的限定。实用新型专利保护形状、构造或者其结合的专利类型定位，并不足以成为排除实现所称功能、效果不可缺少的实施例中非形状、构造、或其结合技术特征限定作用的充分理由。否则，反而会形成含有功能性特征的实用新型专利权利要求保护范围大于具有相同权利要求的发明专利保护范围的窘况。

Subject to Article 2 and Article 3 of the Patent Law, the utility

model only protects the shape, structure or their combination of the product. The shape of the product refers to the definite spatial shape of the product visible from the outside, while the structure of the product refers to the arrangement, organization and relationship of the components of the product. Since the components, formula and other elements of the material are not classified as part of the structure of the product, when evaluating the novelty and inventive step of the utility model in the patent grant and affirmation, the components, formula and other elements of the material in the claim that are not classified as part of the structure of the product should not be taken into account. However, in the dispute over infringement, the components and formulas of the material that have been recorded in claims have a restrictive effect on the protection scope of the claims. For the technical features expressed as function or effect in claims, the people's court shall determine the content of technical features in combination with the specific method of implementation and its equivalent implementation method of the function and effect described in the description and drawings. Whether the technical feature is indispensable in achieving the claimed function and effect is the criterion for determining the technical features recorded in the description and the drawings play a restrictive role. In terms of the utility model patent, if the non-

shape, non-structure, or the non-combination thereof technical features incorporated in the implementation cases related to functional features is indispensable in achieving the claimed function or effect, it still constitutes restriction of the protection scope of the functional feature. The type of patent position of a utility model patent protecting shape, structure or their combination is not sufficient to exclude the restrictive effect of non-shape, non-structure or the non-combination thereof technical features that is indispensable in the implementations to achieve the claimed function and effect. Otherwise, the protection scope of the utility model patent claims containing functional features is wider than the protection scope of an invention patent with the same claims.

本案中，“显影层”属于功能性特征。涉案专利说明书给出四个具体实施例，并记载了涉案专利书写纸板的制作方法，其中第[0054]、[0057]-[0061]段详细说明了显影层的原料、配比等，权利人也主张以上述说明书的记载确定“显影层”技术特征的内容。据此，上述说明书的内容是实现显影功能不可缺少的技术特征，对权利要求保护范围具有限定作用。与之相比，被诉侵权产品的浅三色网格表面构成的显影层由粘接剂和石粉组成，但是该粘接剂和石粉是否具有上述说明书所述“显影层”的具体实施方式及其等同的实施方式相同的技术特征，胡雪辉并未予以证明应当承担相应的不利后果。

In this case, the “development layer” pertains to functional features. The claims of the involved patent provide four specific implementations and record the manufacturing method of the writing paper board concerning the involved patent, paragraph [0054] and [0057]-[0061] of which describe feature such as the raw materials and ratio of the development layer. The right holder also claims to determine the content of the technical feature of the “developing layer” through the aforementioned description. It is evident that the content of the aforementioned description is an indispensable technical feature in achieving development function, having a restrictive effect on the protection scope of the claims. On the contrary, the development layer constituted by the light tricolor grid surface of the infringing product is composed of adhesive and stone powder, but Hu Xuehui did not prove whether the adhesive and stone powder had the same technical feature of the specific method of implementation and its equivalent implementation method of “development layer” mentioned in the aforementioned description, and shall therefore bear the corresponding adverse consequences.

## 21. “保藏号”限定的微生物发明专利的侵权认定

### **Determination of invention patent infringement concerning**

## **microorganism restricted by “Preservation Number”**

### **【裁判要旨】**

#### **[Judgment Digest]**

关于被诉侵权菌株是否落入以“保藏号”限定的微生物发明专利权利要求的保护范围，一般可以借助一种或者多种基因特异性片段检测方法，并结合形态学分析等予以认定。检测微生物菌株的基因特异性时，并非必须采用全基因序列检测方法，如果以“保藏号”限定的菌株具有特有特定序列扩增标记（SCAR）的分子标记片段，则可以该分子标记为检测指标，结合基因序列以及形态学分析，对被诉侵权菌株作出认定。

Whether the infringing strains are within the protection scope of the microorganism invention patent restricted by the “preservation number” can generally be determined by one or more gene specific fragment detection methods, combined with methods such as morphological analysis. When testing the gene specificity of microorganism strains, it is not necessary to apply the whole genome sequencing method. If the strains restricted by the “preservation number” have the molecular marker fragment of Sequence-characterized Amplified Region (SCAR) marker, then the infringing strains can be determined by taking the molecular marker as the test indicator and applying the genetic sequence and morphological

analysis.

### **【关键词】**

#### **[Keywords]**

发明专利 侵权 微生物 保藏号 保护范围 SCAR分子标记

invention patent; infringement; microorganism; preservation number; protection scope; SCAR molecular marker

### **【案号】**

#### **[Case Number]**

(2020) 最高法知民终1602号

(2020) SPC IP Civil Final 1602

### **【基本案情】**

#### **[Case Facts]**

在上诉人天津绿圣蓬源农业科技开发有限公司（以下简称绿圣蓬源公司）、天津鸿滨禾盛农业技术开发有限公司（以下简称鸿滨禾盛公司）与被上诉人上海丰科生物科技股份有限公司（以下简称丰科公司）侵害发明专利权纠纷案中，丰科公司系专利号为201310030601.2、名称为“纯白色真姬菇菌株”的发明专利（以下简称涉案专利）的专利权人。涉案专利的权利要求为：“一种纯白色真姬菇菌株Finc-W-247，其保藏编号是CCTCC NO：M2012378。”丰科公司认为绿圣蓬源公司、鸿滨禾盛公司在北京新发地农产品批发市场销售的菌类产品侵害涉案专利权，故向北京知识产权法院（以下简称一审法院）提起侵权诉讼。一审法院

经审理认为，由于涉案专利要求保护的是一种微生物，判断被诉侵权产品是否落入涉案专利权的保护范围，形态学特征判断和分子生物学特征判断缺一不可，而分子生物学特征判断必须借助相关的方法、试剂、仪器在实验室中才能完成。经委托鉴定，鉴定机构出具的鉴定意见显示，基于纯白色真姬菇的性状、基因间隔序列（ITS）和所述特异975bpDNA片段的特点，根据比对结果可以判断出鸿滨牌白玉菇与涉案专利所要求保护的纯白色真姬菇属于同一种菌株。一审法院据此认定被诉侵权产品落入了涉案专利权的保护范围，判决绿圣蓬源公司、鸿滨禾盛公司停止侵害并各自赔偿经济损失100万元。绿圣蓬源公司、鸿滨禾盛公司不服，向最高人民法院提起上诉，认为本案鉴定中对于分子生物学特征的检测，应当采用全基因序列检测方法而非采用涉案专利说明书中记载的基因特异性片段检测方法，采用后者将会扩大涉案专利权的保护范围。最高人民法院于2021年8月19日判决驳回上诉，维持原判。

In the patent infringement case between the appellants Tianjin Lvshengpengyuan Agriculture Technology Development Co., Ltd. (Lvshengpengyuan) and Tianjin Hongbin Hesheng Agricultural Technology Development Co., Ltd. (Hongbin Hesheng), and the appellee Shanghai Finc Bio-Tech Inc. (Finc), Finc is the patentee of invention patent with patent No. 201310030601.2, titled “New Pure White *Hypsizygus Marmoreus* Strain” (the involved patent). The

claim is a new pure white *hypsizygus marmoreus* strain Finc-W-247, with preservation no. CCTCC NO:M2012376. Finc filed a lawsuit in Beijing Intellectual Property Court (the Court of First Instance), claiming that the fungi products sold by Lvshengpengyuan and Hongbin Hesheng in Beijing Xinfadi Agricultural Products Wholesale Market infringed the involved patent. The Court of First Instance held that, since the involved patent was a microorganism, both morphological features and molecular biological features were indispensable in determining whether the infringing product was within the protection scope, while the molecular biological features had to be determined in the laboratory using relevant methods, reagents and instruments. After entrusting testing, the Expertise Institution issued an expert opinion which showed that, on the basis of the traits of the pure white *hypsizygus marmoreus*, the features of the internal transcribed spacer (ITS) and the aforementioned specific 975bp DNA fragment, in accordance with the comparison results, it could be determined that the Hongbin shimeji mushroom was the same strain as the pure white *hypsizygus marmoreus* claimed to be protected by the involved patent. Based on this, the Court of First Instance held that the infringing product was within the protection scope, and ruled Lvshengpengyuan and Hongbin Hesheng to cease the infringement and each pay damages of CNY 1 million for

economic losses. Lvshengpengyuan and Hongbin Hesheng refused to accept the decision and appealed to the SPC, claiming that the detection of molecular biological features involved in the testing should apply the whole genome sequencing method instead of the gene specific fragment detection method recorded in the description on the grounds that application of the latter would expand the protection scope. On August 19, 2021, the SPC rejected the appeal and upheld the original judgment.

### **【裁判意见】**

#### **[Judge's Opinion]**

最高人民法院二审认为，由于本领域公知，SCAR分子标记技术是在RAPD基础上发展起来的，其结果不受外界环境因素和生长发育阶段的影响，直接反映被鉴定菌株的遗传本质。SCAR分子标记可以通过获得某个菌株的“株特异性”标记来实现菌株的鉴定。本案中，涉案专利说明书明确记载了与市场上主要栽培品种并且是亲本之一的白玉菇H-W，市场购买的真姬菇G-W、以及日本葛城新育成的白玉菇GC-W菌株相比，所述保藏菌株具有特有的SCAR分子标记975bp片段。因此，利用该菌株特异性975bp片段，并结合形态学以及ITS序列分析对被诉侵权菌株进行鉴定的方法是合理且可信的。

In the second instance, the SPC held that, in light of the common general knowledge in the art, SCAR molecular marker

technology is developed on the basis of RAPD, the result of which is independent of external environmental factors and growth and development stages, and can directly reflect the genetic nature of the tested strain. SCAR molecular markers can test a strain by obtaining the “strain-specific” marker of a certain strain. In this case, the description of the involved patent explicitly records that the preservation strain has a unique SCAR molecular marker 975bp fragment compared to shimeji mushroom, one of the parents, that is mainly cultivated on the market, *hypsizygus marmoreus* G-W that is purchased on the market, and the shimeji mushroom GC-W strain that is newly bred in Katsuragi, Japan. Hence, it is reasonable and credible to determine the infringing strain by applying the strain-specific 975bp fragment, in combination with morphology and ITS sequence analysis.

关于绿圣蓬源公司、鸿滨禾盛公司提到的仅采用975bp片段对菌株进行鉴定，扩大了涉案专利权保护范围的问题。由于已经证明SCAR分子标记975bp片段是涉案专利保藏菌株的特异性标记，其他同种不同株的菌株并不含有该特异性片段，因此，以该SCAR分子标记作为检测指标，并结合形态学以及ITS序列分析可以反映待测菌株与专利保藏菌株是否相同，该判断方法并没有扩大涉案专利权的保护范围。

With respect to the issue that only using the 975bp fragment to

determine the strain would expand the protection scope of the involved patent as mentioned by Lvshengpengyuan and Hongbin Hesheng, since it was proved that the 975bp fragment of the SCAR molecular marker was specific to the preservation strain of the involved patent, while other strains of the same species and different strains do not contain this specific fragment, it can be concluded that taking the SCAR molecular marker as test indicator and applying morphology and ITS sequence analysis can reflect whether the strain to be tested is identical to the preservation strain. This does not expand the protection scope of the involved patent.

关于绿圣蓬源公司、鸿滨禾盛公司主张涉案专利没有充分论证975bp片段是该菌株的特异性片段，一审中提交的证据表明全国各地多家企业的白玉菇以及韩国某白色真姬菇均含有975bp片段的问题。由于涉案专利说明书中已经针对保藏菌株与其他同种不同株的真姬菇进行了RAPD和SCAR分子标记分析，并提供实验数据（参见附图7）证明975bp片段是保藏菌株所特有的，绿圣蓬源公司、鸿滨禾盛公司并没有提供证据证明涉案专利说明书的实验结果有误，或提供证据证明在涉案专利申请日前，其他不同于保藏菌株的真姬菇也包含所述975bp片段，或者经过检索发现了其他真姬菇的基因序列中含有所述975bp片段，根据现有证据无法证明涉案专利说明书的数据不真实有效。且全国存在多家企业以及韩国某白玉菇包含所述975bp片段的情况，亦不能证明其

在涉案专利申请日前就存在与市场, 同样不能证明涉案专利说明书不真实有效。绿圣蓬源公司、鸿滨禾盛公司的该项上诉主张不能成立, 不予支持。

Regarding the claim of Lvshengpengyuan and Hongbin Hesheng that the involved patent did not sufficiently prove that the 975bp fragment was specific to the strain, the evidence submitted in the first instance showed that the shimeji mushroom from many enterprises across the country as well as a certain white *hypsizygus marmoreus* from Korea contained the 975bp fragment. Since RAPD and SCAR molecular marker analysis has been conducted in the description of the involved patent for the preservation strain and other *hypsizygus marmoreus* of the same species and different strains, and experimental data (see Figure 7) has been provided to prove that the 975bp fragment is unique to the preservation strain, while Lvshengpengyuan and Hongbin Hesheng did not provide evidence to prove that the experimental results of the description were incorrect, or prove that other *hypsizygus marmoreus* different from the preservation strain also contained the aforementioned 975bp fragment before the date of application for the involved patent, or found that the gene sequences of other *hypsizygus marmoreus* contained the aforementioned 975bp fragment upon retrieval, the data of the description could not be proved untrue and

invalid in accordance with the available evidence. Moreover, although there are several enterprises across the country and a certain shimeji mushroom in Korea that contains the aforementioned 975bp fragment, this does not prove that it appeared on the market before the date of application of the involved patent, nor that the description of the involved patent is untrue and invalid. Therefore, the claim of Lvshengpengyuan and Hongbin Hesheng was rejected by the SPC.

## 22. 未将明确知晓的技术方案写入权利要求对等同侵权判断的影响

### **Impact of failure to include an explicitly known technical solution in claims on determination of equivalent infringement**

#### **【裁判要旨】**

#### **[Judgment Digest]**

专利权利人在撰写专利申请文件时未将其明确知晓的技术方案写入权利要求，本领域技术人员在阅读权利要求书、说明书后认为专利权利人明确不寻求保护该未写入权利要求的技术方案的，一般不应再通过等同侵权将该技术方案纳入专利权保护范围。

If the patentee does not include the technical solution explicitly known to him in the claim when writing the patent application documents, and a person skilled in the art, through reading claims and the description, believes that the patentee explicitly does not seek to protect such technical solution, the technical solution should generally not be included in the protection scope of the patent through equivalent infringement.

**【关键词】**

**[Keywords]**

发明专利 侵权 等同 适用限制 保护意图

invention patent; infringement; equivalent; application restriction; intention of protection

**【案号】**

**[Case Number]**

(2021) 最高法知民终 192 号

(2021) SPC IP Civil Final 192

**【基本案情】**

**[Case Facts]**

在上诉人常州格瑞德园林机械有限公司（以下简称格瑞德公司）、宁波昂霖智能装备有限公司（以下简称昂霖公司）与被上诉人徐州中森智能装备有限公司（以下简称中森公司）侵害发明专利权纠纷案中，涉及专利号为 201610201500.0、名称为“电动绿

篱机”的发明专利（以下简称涉案专利）。中森公司向江苏省苏州市中级人民法院（以下简称一审法院）提起诉讼，主张格瑞德公司未经其许可，擅自生产、销售侵害其涉案专利权的“宽带修剪机”，昂霖公司为格瑞德公司生产、销售的上述被诉侵权产品提供零部件。一审法院经审理认定被诉侵权产品落入涉案专利权保护范围，判令格瑞德公司、昂霖公司停止侵害、赔偿损失。格瑞德公司、昂霖公司不服，向最高人民法院提起上诉，主张涉案专利保护主题是电动绿篱机，专利权人在专利申请时明确排除了“燃油驱动”的技术方案，不应当再将涉案专利的驱动方式扩张到“燃油驱动”予以保护，被诉侵权产品是燃油驱动的修剪机，未落入涉案专利权保护范围。最高人民法院于2021年7月19日判决撤销原判，驳回中森公司的诉讼请求。

The patent infringement case between the appellants Changzhou Great Garden Machinery Co., Ltd. (“Glade”) and Ningbo Anglin Intelligent Equipment Co., Ltd. (“Anglin”), and the appellee Xuzhou Zhongsen Intelligent Equipment Co., Ltd. (“Zhongsen”), involves an invention patent with patent No. 201610201500.0, titled “Electric Hedge Trimmer” (the involved patent). Zhongsen filed a lawsuit in Suzhou Intermediate People’s Court (the Court of First Instance), claiming that Glade manufactured and sold the “broadband hedge trimmer” which infringed the involved patent without its permission, and that Anglin

provided parts for the alleged infringing product manufactured and sold by Glade. The Court of First Instance held that the infringing product was within the protection scope, and ordered Glade and Anglin to cease the infringement and pay damages. Glade and Anglin refused to accept the decision and appealed to the SPC, claiming that the object of the involved patent was the electric hedge trimmer, and the patentee explicitly excluded the technical solution of “fuel-driven” from the patent application, so the driving mode of the involved patent should not be expanded to “fuel-driven” for protection. Since the infringing product was a fuel-driven trimmer, it does not fall under the protection scope. On July 19, 2021, the SPC reversed the original judgment and rejected the claims of Zhongsen.

### **【裁判意见】**

#### **[Judge’s Opinion]**

最高人民法院二审认为，专利权保护范围的确定，既要严格保护专利权人的利益，又要维护权利要求书的公示作用和社会公众对专利文件的信赖，平衡专利权人与社会公众之间的利益。如果专利权人在撰写专利申请文件时已明确地知晓相关技术方案，但并未将其纳入权利要求保护范围之内的，则在侵权诉讼中不得再适用等同理论将该技术方案纳入保护范围。确定专利权人在专利申请时是否明确知晓并保护特定技术方案，可结合说明书及附图内容予以认定，并应将说明书及附图作为整体看待，判断的标

准是本领域技术人员阅读权利要求书与说明书及附图之后的理解。

In the second instance, the SPC held that the determination of the protection scope of the patent should not only strictly protect the interests of the patentee, but also maintain the publication function of the claims and the public reliance on the patent documents, so as to balance the interests between the patentee and the public. If the patentee explicitly knows about the relevant technical solution when writing the patent application documents but does not include it in the protection scope, the equivalent theory shall not be applied to include the aforementioned technical solution in the protection scope in the infringement litigation. Whether the patentees explicitly know about and protect a specific technical solution when they apply for a patent can be determined by reading the description and the drawings, which should be considered as a whole. The criterion for judgment is the understanding of a person skilled in the art after reading the claims, description and drawings.

专利主题名称一般而言具有限定作用，它限定了技术方案所适用的技术领域。涉案专利权利要求前序部分的主题名称已载明为“一种电动绿篱机”，在前序的特征部分亦有关于“电机”的明确记载。通过前述记载可知，专利权人在撰写涉案专利权利要求书和说明书时，即已明确知晓现有技术中存在电机驱动和燃油

发动机驱动两种方式,且“环保无污染”是本专利相较于现有技术的新增技术效果,但专利权人在涉案专利权利要求中仅强调电机驱动,即明确表示涉案专利的驱动方式仅限于电机驱动,而非燃油发动机驱动。从说明书的相关内容可以看出,专利申请人在撰写涉案专利权利要求时,基于对环保效果的追求,申请人并不寻求保护以燃油发动机作为动力源的绿篱机技术方案。换言之,本领域技术人员基于对权利要求所限定的“电动绿篱机”、说明书背景技术部分对存在电机驱动和燃油发动机驱动两种方式的介绍以及发明目的部分关于“环保无污染”效果的强调等,完全可以理解为申请人明确不寻求保护以燃油发动机作为动力源的绿篱机技术方案。在此情况下,若在判断被诉侵权产品是否落入涉案专利权保护范围时,将燃油发动机驱动与电机驱动认定构成技术特征等同,则不利于专利权利要求公示作用的发挥和社会公众信赖利益的保护。综上,一审法院对于被诉侵权产品和涉案专利的驱动方式技术特征构成等同的认定结论不当,依法予以纠正。

In general, the subject of the patent has a restrictive effect on the technical field which is the technical solution applicable to. The subject defined in the preamble of claims is recorded as “an electric hedge trimmer”, and “motor” is also explicitly recorded in the feature section of the preamble. It can be seen from the aforementioned records that the patentee, when writing the claims

and description, was clearly aware of two driving modes in the prior art, i.e., motor-driven and fuel engine-driven, and that “environmental protection without pollution” is a new technical effect of the involved patent compared with the prior art. However, the patentee only emphasizes motor-driven in claims of the involved patent, which explicitly means that the driving mode of the involved patent is limited to motor-driven, rather than fuel engine-driven. From the relevant content of the description, it is evident that the patent applicant did not seek to protect the technical solution of hedge trimmers with fuel engines as the driving force due to the pursuit of environmental effects when writing claims of the involved patent. In other words, a person skilled in the art, based on the “electric hedge trimmer” restricted by claims, the introduction to the two driving modes incorporated in the background technology part of the description, namely, motor-driven and fuel engine-driven, as well as the emphasis on the effect of “environmental protection without pollution” in the invention purpose section, can completely understand that the patent applicant explicitly does not seek to protect the technical solution of hedge trimmers with fuel engines as the driving force. In these circumstances, when judging whether the infringing product is within the protection scope, if the fuel engine-driven and the motor-driven are identified to be identical in technical

features, this is not conducive to emphasizing the publication function of claims and protecting public reliance. In conclusion, the first-instance court's improper conclusion that the technical features of the driving method of the infringing product and the involved patent are equivalent shall be corrected according to law.

### 23. 先用权抗辩中原有范围的证明标准

#### **Standard of proof for the original scope in a prior use**

#### **defense**

#### **【裁判要旨】**

#### **[Judgment Digest]**

先用权抗辩中“原有范围”的证明标准不宜过高。被诉侵权人已经尽力举证，所举证据能够初步证明其所主张的原有范围具有合理性，专利权利人没有提供充分反证予以推翻的，一般可以认定被诉侵权人系在原有范围内实施。

The standard of proof for the “original scope” in a prior use defense should not be overly strict. If the alleged infringer has made every effort to preliminarily prove that the original scope as claimed by the defendant is reasonable, while the patent holder has not provided sufficient evidence to disprove it, generally, it can be identified that the alleged infringer is implemented within the

original scope.

**【关键词】**

**[Keywords]**

实用新型专利 侵权 先用权抗辩 原有范围 举证责任

utility model patent; infringement; prior use defense; original scope; burden of proof

**【案号】**

**[Case Number]**

(2021) 最高法知民终508号

(2021) SPC IP Civil Final 508

**【基本案情】**

**[Case Facts]**

在上诉人东莞市乐放实业有限公司（以下简称乐放公司）与被上诉人深圳市赛源电子有限公司（以下简称赛源公司）、原审被告广州晶东贸易有限公司侵害实用新型专利权纠纷案中，涉及专利号为201920113995.0、名称为“一种条形音箱”的实用新型专利（以下简称涉案专利）。赛源公司认为乐放公司制造、销售的被诉侵权产品落入涉案专利权的保护范围，故向广州知识产权法院（以下简称一审法院）提起诉讼。乐放公司提出先用权抗辩并提交了相关证据。一审法院认为，即便乐放公司的证据可予采信其证据限于证明其在专利申请日前已做好制造被诉侵权产品的准备及进行制造，未对其制造范围以及仅在原有范围内继续制造

进行举证。因此，乐放公司提交的证据不足以证明先用权抗辩成立。一审法院判决乐放公司停止制造、销售被诉侵权产品，赔偿经济损失及维权合理开支。乐放公司不服，向最高人民法院提起上诉，主张其未变更厂房地址、未扩大厂房面积，仅持有一套生产模具，无法扩大原有生产范围，先用权抗辩成立。最高人民法院认定乐放公司先用权抗辩成立，于2021年8月19日判决撤销原判，驳回赛源公司的诉讼请求。

The patent infringement case between the appellant Dongguan Loyfun Industrial Co., Ltd. (“Loyfun”), the appellee Shenzhen Saiyuan Electronics Co., Ltd. (“Saiyuan”), and the first-instance defendant Guangzhou Jingdong Trading Co., Ltd. involves a utility model patent with the patent No. 201920113995.0, titled “Soundbar” (the involved patent). Saiyuan filed a lawsuit in Guangzhou Intellectual Property Court (the Court of First Instance), claiming that the alleged infringing product manufactured and sold by Loyfun was within the protection scope of the involved patent. Loyfun proposed the prior use defense and submitted the relevant evidences. The Court of First Instance held that even if the evidence provided by Loyfun was accepted, it was limited to proving that Loyfun had prepared to manufacture and had manufactured the alleged infringing products before the application date , without providing evidence on its manufacturing scope and continuing to manufacture

only within original scope. Loyfun refused to accept the decision and appealed to the SPC, claiming that the prior use defense was established on the grounds that it did not alter the address of the plant or expand the area of the plant, and that it only held one production mold and could not expand the original scope of production. The SPC affirmed Loyfun's prior use defense and ruled on August 19, 2021, to revoke the first-instance judgment and rejected the claim of Saiyuan.

### **【裁判意见】**

#### **[Judge's Opinion]**

最高人民法院二审认为，由于原有范围的认定往往涉及过去某一时点之前存在的生产模具、生产数量、厂房面积等客观情况故对“仅在原有范围内继续制造、使用”相关事实查明，应结合双方当事人的诉辩主张以及案件的具体情况，灵活适用举证责任转移。在先用人已经尽力举证、所举证据能够初步证明“原有范围”存在合理性且专利权人没有提供相反证据予以推翻的情况下，可以认定先用人并未超出原有范围制造、使用。若后续专利权人有证据证明先用人超出原有范围制造、使用的，专利权人有权另行主张其合法权益。本案中，乐放公司提交的订单评审表、预测订单等证据，可以证明乐放公司在涉案专利申请日以前已经具备制造涉案产品的一定生产规模和生产能力。而模具厂报价单、模具验收单、二审中的证人证言等证据互相结合，可以

初步证明乐放公司仅持有1套生产模具。《厂房租赁合同书》则可以初步证明其厂房面积从2013年起至今未曾改变。因此，乐放公司提交的证据相互印证，能够形成证据链，初步证明乐放公司在涉案专利申请日前的生产规模和生产范围，并且其未扩大生产规模。乐放公司在本案中提交的关于原有范围的证据具有一定合理性，并初步达到了高度盖然性的证明标准。在赛源公司没有提交相反证据证明乐放公司超出了涉案专利申请日前的生产规模的情况下，应认定乐放公司并未超出原有范围制造涉案产品。乐放公司的先用权抗辩成立。

In the second instance, the SPC held that since the determination the original scope often involved production molds, production quantities, plant area and other objective circumstances up to a certain point in the past, the parties' claims and the specific circumstances of the case should be taken into account and the burden of proof should be shifted in a flexible manner in finding out the relevant fact of "only continuously manufacturing and using within the original scope". In the event that the priority right holder has made every effort to preliminarily prove that the original scope of their claim is reasonable, and the patentee has not provided opposing evidence to disprove it, it can be determined that the priority right holder's manufacturing and use of the alleged infringing product is within the original scope. If the patentee

subsequently has evidence to prove that the priority right holder's manufacturing and use of the infringing product is beyond the original scope, the patentee is entitled to claim their legitimate rights and interests. In this case, the evidence submitted by Loyfun, such as the order review form and estimated order, can prove that Loyfun has been equipped with a certain production scale and production capacity to manufacture the alleged infringing product prior to the date of patent application of the involved patent. However, the quotation form of the mold factory, the acceptance list for molds, the testimony in the second instance and other evidence can preliminarily testify that Loyfun only holds 1 set of production molds. The *Plant Lease Agreement* can preliminarily prove that the area of its plant has not been altered since 2013. Therefore, the pieces of evidence submitted by Loyfun corroborate each other and form a chain of evidence, which preliminarily proves the production scale and production scope of Loyfun before the date of patent application of the involved patent, and that it has not expanded its production scale. The evidence submitted by Loyfun concerning the original scope in this case is reasonable, and preliminarily clear and convincing. In the absence of any evidence submitted by Saiyuan to prove that Loyfun went beyond its production scale before the date of patent application of the involved patent, it should be concluded

that Loyfun did not manufacture the alleged infringing product beyond the original scope. The defense of priority right of Loyfun was established.

## 24. 许诺销售行为的损害赔偿

### **Damages caused by offering for sale**

#### **【裁判要旨】**

#### **[Judgment Digest]**

许诺销售行为侵权民事责任的承担不以销售实际发生为前提。许诺销售行为一经发生，即可能造成影响专利产品合理定价减少或者延迟专利权利人商业机会等损害，因此，许诺销售行为实施者不仅应当承担停止侵害、支付维权合理开支的民事责任，还应当承担损害赔偿 responsibility。侵权人仅实施了许诺销售行为，专利权利人难以举证证明其因此遭受的具体损失的，可以基于具体案情，着重考虑在案证据反映的侵权情节等，以法定赔偿方式计算损害赔偿数额。

The civil liability on offering for sale is independent of the actual occurrence of the sale. Once the offering for sale occurs, it may cause damages such as affecting the reasonable pricing of the patented products and reducing or delaying the commercial opportunities of the patent holder. Therefore, the perpetrator of the

offering for sale shall not only bear the civil liability of ceasing infringement and paying the reasonable expenses, but also be liable for damages. When the infringer only offers to sell the infringed products and the patent holder has difficulty in proving the specific loss suffered as a result, the amount of damages can be calculated in accordance with statutory compensation based on the specific circumstances of the case, especially the infringement circumstances reflected in the evidence on file.

**【关键词】**

**[Keywords]**

实用新型专利 侵权 许诺销售 损害赔偿 责任

utility model patent; infringement; offering to sell; liability for damages

**【案号】**

**[Case Number]**

(2020) 最高法知民终 1658、1659 号

(2020) SPC IP Civil Final 1658 and 1659

**【基本案情】**

**[Case Facts]**

在上诉人青岛晨源机械设备有限公司（以下简称晨源公司）与被上诉人青岛青科重工有限公司（以下简称青科公司）侵害实用新型专利权纠纷案中，涉及专利号 201721357125.5、名称为

“立式二次构造柱泵”的实用新型专利（以下简称涉案专利）。青科公司以晨源公司制造、许诺销售、销售被诉侵权产品侵害其涉案专利权为由，向山东省青岛市中级人民法院（以下简称一审法院）提起诉讼，要求晨源公司停止侵害、赔偿损失。一审法院认为，晨源公司在网站上展示被诉侵权产品的行为构成许诺销售，侵害了涉案专利权，应当承担停止侵害、赔偿损失的民事责任。晨源公司不服，向最高人民法院提起上诉，对其许诺销售行为侵害了涉案专利权并无异议，但认为其只需承担赔偿维权合理开支的责任，而不应赔偿损失。最高人民法院于2021年3月22日判决驳回上诉，维持原判。

The patent infringement case between the appellant Qingdao Chenyuan Machinery Co., Ltd. (“Chenyuan”) and the appellee Qingdao Qingke Heavy Industry Co., Ltd. (“Qingke”) involves the utility model patent with the patent No. 201721357125.5, titled “Vertical Secondary Constructional Column Pump” (the involved patent). Qingke filed a lawsuit in Qingdao Intermediate People’s Court (the Court of First Instance), claiming that Chenyuan infringed the involved patent right as it manufactured, offered to sell and sold the alleged infringing product, and requested that Chenyuan be ordered to cease the infringement and bear civil liability for damages. The Court of First Instance held that Chenyuan’s exhibition of the alleged infringing product on the website

constituted the offering to sell, infringing the involved patent right, and ruled Chenyuan to cease the infringement and bear civil liability for damages. Chenyuan refused to accept the decision and appealed to the SPC. Although Chenyuan committed that its offering to sell infringed the involved patent, it claimed that it should only be liable for reasonable expenses, rather than damages. On March 22, 2021, the SPC rejected the appeal and upheld the original judgment.

### **【裁判意见】**

#### **[Judge's Opinion]**

最高人民法院二审认为，许诺销售行为客观上会给专利权人造成损害。许诺销售行为既可能发生在产品制造完成之后，也可能发生在产品制造完成之前，既可能发生在产品销售之前，也可能发生在销售过程中。许诺销售行为的目的虽指向销售行为，但许诺销售行为是一种法定的独立的侵权行为方式，许诺销售侵权行为的民事责任承担不以销售是否实际发生为前提。许诺销售行为一旦发生，因被诉侵权人许诺销售的价格通常低于专利产品的价格，会对潜在消费者产生心理暗示，影响专利产品的合理定价；或导致消费者放弃购买专利产品转而考虑与被诉侵权人联系，造成延迟甚至减少专利产品的正常销售。此外，被诉侵权人许诺销售行为还可能对专利产品的广告宣传效果造成不利影响。可见，许诺销售行为的存在，将会给专利权人造成专利产品的价格侵蚀商业机会的减少或者延迟等损害，这种损害是可以合理推知的结

果。权利有损害必有救济，除非法律另有特殊规定，该救济即应当至少包括承担停止侵害和赔偿损失这两种最基本的侵权民事责任形式，而不是只承担其中一种形式。判令侵权人就其许诺销售行为承担损害赔偿 responsibility，更有利于保护和激励创新，更有利于实现专利法的立法目的，营造良好营商环境和创新环境。未经专利权人许可，许诺销售专利产品或者依照专利方法所直接获得的产品行为不仅具有侵权的可责性，也具有实际损害后果。如果仅仅因为许诺销售行为造成的具体损害后果难以准确证明，就免除侵权人的损害赔偿 responsibility，仅承担停止许诺销售行为、支付专利权人维权合理开支的民事责任，既不符合权利有损害必有救济的民法原则，也不利于充分实现专利法的立法目的。专利权人难以举证证明其因许诺销售行为遭受的具体损失时，可以法定赔偿方式计算损害赔偿数额。在侵权人仅实施了许诺销售行为的情况下，其侵权损害后果可能轻于实际销售的损害后果。因此，在确定被诉侵权人就许诺销售行为应当承担的具体赔偿金额时，应着重考虑在案证据反映的侵权恶意与侵害情节，基于案情予以区分。本案中，在青科公司未举证证明其实际损失、晨源公司侵权获利涉案专利许可使用费的情况下，一审法院综合考虑涉案专利的类型、晨源公司的主观过错、晨源公司侵权行为的情节以及青科公司的合理开支等因素，酌定晨源公司赔偿青科公司经济损失3万元，基本适当。

In the second instance, the SPC held that the act of offering to

sell would objectively cause damages to the patentee. The act of offering to sell may occur either before or after the completion of the manufacture of the product, before or during the sale of the product. Although the purpose of the act of offering to sell is selling goods, it is a statutory and independent infringement act, and the civil liability of the act of offering to sell is not based on whether the sale actually takes place. Once the offering to sell occurs, since the price promised by the alleged infringer is usually lower than the price of the patented product, it may have a psychological implication to potential consumers and affect reasonable pricing of the patented product; or cause consumers to give up on purchasing the patented product and consider contacting the alleged infringer instead, thereby delaying or even reducing the normal sale of the patented product. In addition, the act of offering to sell may also have an adverse impact on the advertising effect of the patented product. It can be seen that the offering to sell will cause damage to the patentee such as price erosion for the patented product, or reduction or delay of commercial opportunities, which can be reasonably inferred. Where there is a damage to rights, there is a remedy, unless otherwise specifically stipulated by law. The remedy at least includes two of the most basic forms of civil liability for infringement, namely, cessation of infringement and compensation

for damages, instead of bearing just one of these. The infringer was ordered to be liable for damages of the act of offering to sell which was more conducive to protecting and stimulating innovation, and more beneficial in achieving the legislative purpose of the patent law and creating a sound business and innovation environment. Without the permission of the patentee, offering to sell the patented product or a product directly obtained in accordance with the patented method is not only culpable for infringement but also will cause actual damage. If the infringer is exempt from liability for damages and only bears the civil liability of ceasing the infringement and compensating the reasonable expenses of the patentee for right protection due to difficulty accurately proving the specific damage caused by offering to sell, it is not in line with the principle of civil law which is there must be a remedy for the damage to rights and is not conducive to realizing the legislative purpose of the patent law in full. When it is difficult for the patentee to prove the specific loss resulting from the act of offering to sell, the amount of damages may be calculated in accordance with statutory compensation. In the case that the infringer only offer to sell the product the infringement damage may be less than the damage caused by actual sale. Hence, in determining the specific amount of damages to be borne by the alleged infringer for the act of offering to sell, the malice and

circumstances of the infringement reflected by the evidence should be taken into account and distinguished based on the circumstances of the case. In this case, in the absence of evidence submitted by Qingke to prove its actual loss, the infringement profit of Chenyuan and the licensing fee of the involved patent, the judgment given by the Court of First Instance to order Chenyuan to compensate CNY 30,000 for Qingke's economic loss, in consideration of the type of the involved patent, the subjective fault of Chenyuan, the circumstances of Chenyuan's infringement and the reasonable expenses of Qingke and other factors, was basically appropriate.

## 25. 涉信息网络专利侵权行为地的判断及法律适用

### **Determination and application of law on the place of infringement on patents concerning information networks**

#### **【裁判要旨】**

#### **[Judgment Digest]**

涉信息网络侵害专利权纠纷案件中，被诉侵权行为的部分实质环节或者部分侵权结果发生在中国领域内的，即可以认定侵权行为地在中国领域内。被诉侵权网站服务器所在地并非判断侵权行为实施地的唯一因素，被诉侵权人仅以该服务器位于中国域外为由，抗辩其行为不侵害中国专利权的，一般不予支持。

In cases of infringement on patents concerning information network, if substantial part of the alleged infringement or part of the result of such infringement occurs within China, it could be deemed that the place of infringement is within China. The location of the server for the infringing website is not the only or key factor for ascertaining the location where the infringement is committed. If the alleged infringer argues that his or her acts do not infringe Chinese patents solely on the ground that the server is located outside of China, such defense opinion shall generally not be supported.

**【关键词】**

**[Keywords]**

发明专利 侵权 涉信息网络专利 侵权行为地

invention patent; infringement; patent concerning information network; place of infringement

**【案号】**

**[Case Number]**

(2020) 最高法知民终 746 号

(2020) SPC IP Civil Final 746

**【基本案情】**

**[Case Facts]**

在上诉人深圳市东方之舟网络科技有限公司（以下简称东方之舟公司）与被上诉人深圳市帝盟网络科技有限公司（以下简称

帝盟公司) 侵害发明专利权纠纷案中, 涉及专利号为 201210003858.4、名称为“一种国际物流信息跟踪方法及其系统”的发明专利(以下简称涉案专利)。帝盟公司以东方之舟公司经营的物流信息查询网站(以下简称被诉侵权网站)侵害涉案专利权为由, 诉至广东省深圳市中级人民法院(以下简称一审法院)。一审法院认定被诉侵权技术方案落入涉案专利权保护范围, 据此判令东方之舟公司停止侵害并赔偿经济损失 200 万元及维权合理开支 54620 元。东方之舟公司不服, 向最高人民法院提起上诉。东方之舟公司主张, 被诉侵权技术方案所使用的服务器位于中国境外及中国香港, 故被诉侵权行为实际发生在中国境外, 未落入涉案专利权效力的地域范围, 不构成专利法第十一条第一款项下的使用行为。最高人民法院于 2021 年 5 月 25 日判决驳回上诉, 维持原判

The case of patent infringement between the appellant Shenzhen Dongfangzhizhou Network Technology Co., Ltd. (“Dongfangzhizhou”) and the appellee Shenzhen Dimeng Network Technology Co., Ltd. (“Dimeng”) concerning dispute over an invention patent with patent No. 201210003858.4, titled “International Logistics Information Tracking Method and System” (the involved patent). Dimeng filed a lawsuit in Shenzhen Intermediate People's Court (the Court of First Instance), claiming that the logistics information tracking website operated by Dongfang Zhizhou Company (the alleged infringing website) infringed the

involved patent. The Court of First Instance held that the alleged technological solution fell within the protection scope of the involved patent, and ruled that Dongfangzhizhou should cease the infringement and compensate CNY 2 million for financial losses and a further CNY 54,620 for reasonable expenses for right protection. Dongfangzhizhou refused to accept the result and appealed to the SPC, claiming that the server used by the alleged technological solution was located outside of China and in Hong Kong, thus the alleged infringement occurred outside of China, beyond the territorial scope of the involved patent, and did not constitute the act of use citing Article 11(1) of the Patent Law . On May 25, 2021, the SPC rejected the appeal and upheld the original judgment.

### **【裁判意见】**

#### **[Judge's Opinion]**

最高人民法院二审认为，服务器所在地仅仅是判断侵权行为地的因素之一而非唯一因素。侵权行为地包括侵权行为实施地和侵权结果发生地。对于受中国法律保护的专利权而言，侵害该专利权的行为的实质环节或者部分侵权结果发生在中国领域内的，即可认定侵权行为地在中国领域内。因此，判断侵权行为地时，存在多个考虑因素，服务器所在地仅仅是判断侵权行为地的因素之一。必须指出的是，仅仅以服务器所在地为标准确定判断侵权行为地存在一定的局限性。互联网的全球通达与覆盖特性

决定了网络数据传输与交互具有国际性, 对于涉互联网计算机程序的方法与系统专利而言, 如果仅以数据载体即被诉侵权网站服务器所处位置来确定被诉侵权行为实施地将会严重限制此类专利权的保护范围, 使得实质实施此类专利的侵权人极易逃避侵权责任, 最终可能致使此类专利权的法律保护落空, 故东方之舟公司的上述主张并不合理, 不应将服务器所在地作为被诉侵权行为实施地的唯一或核心判断要素。另外, 被诉侵权网站的运营主体东方之舟公司处于中国, 被诉侵权技术方案实施过程的触发地点多位于中国, 诉侵权网站数据传输与交互全部或部分发生在中国, 被诉侵权网站与中国大陆在地理意义上具有多个连结点, 据此可认定被诉侵权技术方案的实施地位于中国境内, 故应当认定东方之舟公司的被诉侵权行为构成专利法第十一条第一款项下的使用行为。

In the second instance, the SPC held that the location of the server is one of the factors used in determining the place of infringement but not the only factor. Locus delicti includes the place where the infringement is committed and the place where the result of the infringement occurs. For a patent protected under Chinese law, if substantial part of the infringement or part of the result of the infringement occurs within China, the locus delicti is deemed to be within China. Therefore, several factors are considered in determining the locus delicti, and the location of the server is only

one such factor. It must be noted that there are limitations in determining the locus delicti by only considering the location of the server. The global accessibility and coverage of the Internet constitutes the international nature of network data transmission and interaction. For the patent concerning online computer programs and systems, if the data carrier, i.e. the location of the server of the alleged infringing website, is recognized as the sole factor used to determine the place where the infringement is committed, the scope of protection for such patent will be significantly restricted. It will easily allow the infringers who substantially exploit such patent to be exempted from infringement liabilities, which may further lead to the failure of the legal protection of such patent. Hence, the aforementioned claim of Dongfangzhizhou is not reasonable on the grounds that the location of the server should not be deemed as the sole or major judging factor in determining the place where the infringement is committed. In addition, Dongfangzhizhou, the operating entity of the alleged infringing website, is located in China; the exploitation of the alleged infringing technical solution is mostly triggered in China; the data transmission and interactivity of the infringing website occurs in whole or in part in China and the infringing website has multiple geographical connection points with mainland China. According to which, it can be determined that the

place where the alleged infringing technical solution is exploited is within China. Therefore, it shall be found that the alleged infringement of Dongfangzhizhou constitutes an act of using that falls under Article 11(1) of the Patent Law.

## 26. 主要是利用本单位物质技术条件完成的发明创造的认定

### **Identification of invention accomplished by mainly using the material and technical resources of the inventor's employer**

#### **【裁判要旨】**

#### **[Judgment Digest]**

关于“主要是利用本单位的物质技术条件”所完成发明创造的认定中，“物质技术条件”包括资金、设备、零部件、原材料等物质条件和未公开的技术信息和资料等技术条件；“主要”是对前述物质技术条件在发明创造研发过程中所起作用的限定，系指单位物质技术条件是作出发明创造不可缺少的条件，相对于发明人使用的其他来源的物质技术条件而言，单位物质技术条件在重要性上胜过其他来源的物质技术条件，居于主要地位。

In the identification of inventions accomplished by “mainly using the material and technical resources of the inventor's employer”, the so-called “material and technical resources” include funds, equipment, parts and components, raw materials and other

material resources and technical information and materials which have not yet been disclosed to the public. “Mainly” refers to the limitation on the function of aforementioned material and technical resources in the process of the invention’s research and development, which means that the material and technical resources of the employer are indispensable to said inventions. The material and technical resources of the employer are in the dominant position in facilitating the invention, and are far more important than other material and technical resources used by the inventor.

**【关键词】**

**[Keywords]**

专利权权属 职务发明 本单位物质技术条件

patent ownership; service invention; material and

technical resources of the employer

**【案号】**

**[Case Number]**

(2020) 最高法知民终 1848 号

(2020) SPC IP Civil Final 1848

**【基本案情】**

**[Case Facts]**

在上诉人郑州新材科技有限公司（以下简称新材公司）与被上诉人宋军礼专利权权属纠纷案中，宋军礼于 2018 年 11 月 14

日申请专利号为 201821872940.X、名称为“一种圆环形高温微波膨化炉”实用新型专利(以下简称涉案专利),并获得授权。宋军礼于 2018 年 4 月 23 日进入新材公司工作,岗位为设备维护与管理。新材公司为实现石墨的连续微波膨化和石墨烯的产业化生产,于 2017 年 5 月从外购入一台微波石墨膨化设备。涉案专利与该设备均属于石墨烯生产设备领域,均是为解决石墨的连续化微波膨化制备问题。新材公司向河南省郑州市中级人民法院(以下简称一审法院)提起诉讼,主张宋军礼系履行本职工作或工作任务,研发过程中也使用了新材公司的微波膨爆设备、石墨原材料设备改造方案和设备实验数据等物质技术条件,故涉案专利权应归单位所有。一审法院判决驳回新材公司的诉讼请求。新材公司不服,向最高人民法院提起上诉。最高人民法院于 2021 年 4 月 20 日判决驳回上诉,维持原判。

In the patent ownership dispute between the appellant, Zhengzhou New Material Technology Co., Ltd. (“New Material”) and the appellee Song Junli, Song Junli applied for a utility model patent with patent No. 201821872940.X, titled “A Ring-Shaped High Temperature Microwave Expansion Furnace” (the involved patent) on November 14, 2018, and was authorized. Song Junli joined New Material on April 23, 2018, responsible for maintenance and management of equipment. In order to achieve continuous microwave expansion of graphite and industrial production of

graphene, New Material purchased microwave graphite expansion equipment in May 2017. The involved patent and said equipment are both considered graphene production equipment that ensure continuous microwave expansion preparation of graphite. New Material filed a lawsuit in Zhengzhou Intermediate People's Court (the Court of First Instance), contending that the involved patent shall be owned by the employer on the grounds that Song Junli performed his own work and tasks wherein he used microwave expansion equipment, graphite raw materials, the equipment maintenance scheme and equipment experimental data and other material and technical resources owned by the employer throughout the process of research and development. The Court of First Instance ruled to reject the claims of New Material. New Material rejected the decision and appealed to the SPC. On April 20, 2021, the SPC rejected the appeal and upheld the original judgment.

### **【裁判意见】**

#### **[Judge's Opinion]**

最高人民法院二审认为，依据《中华人民共和国专利法实施细则》（以下简称专利法实施细则）第十二条第二款、《最高人民法院关于审理技术合同纠纷案件适用法律若干问题的解释》第四条规定，物质技术条件可以具体划分为发明创造的物质条件、技术条件。在特定情形下，单一元素如设备可以兼具物质与技术条

件属性。这其中，物质条件一般包括资金、设备、零部件、原材料等，其用途为直接或间接用于开展研发活动并在分析、验证、测试之后得到发明技术方案，包括在研发过程中对特定技术手段所产生的技术功能和效果或专利技术方案的实用性等技术内容的分析、验证、测试，对于形成发明具有实质性的影响；而技术条件则指未公开的技术信息和资料，包括尚未公开的技术成果、阶段性技术成果等，对于形成发明的实质性特点具有技术启示。专利法第六条第一款对于“主要是利用本单位的物质技术条件”的条件规定，是对前述物质、技术条件在发明创造作出过程所起作用的限定，对此应理解为，其一，单位物质、技术条件的存在是该发明创造作出过程中不可缺少的必要条件，在没有该物质、技术条件参与的情况下，该发明创造的成就无法实现；其二，相对于发明人使用的其他来源的物质、技术条件而言，单位物质、技术条件在重要性上居于主要地位，足以胜过其他来源的物质、技术条件，从而可以据此决定争议专利的权属。

In the second instance, the SPC maintained that material and technical resources can be divided into material and technical resources of invention pursuant to Article 12(2) of *Detailed Rules for the Implementation of the Patent Law of the People's Republic of China* (Detailed Rules for the Patent Law) and Article 4 of *Interpretation of the Supreme People's Court Concerning Issues on Application of Law for the Trial of Cases on Disputes over*

*Technology Contracts.* Under certain circumstances, a single element, such as equipment, can be considered as both material and technical resources. Among them, material resources, generally including funds, equipment, parts, raw materials, etc., are directly or indirectly used to conduct research and development and to complete production of the invention after the analysis, verification and testing phases, which includes testing of technical components, such as their functionality and effects produced by specific technological methods or the practicality of the technical solution for the patent within the process of research and development, which has a substantial impact on the development of the invention; while technical resources refers to technical information and data which are not to be disclosed to the public, including undisclosed technical results, phased technical results, etc., which technically inspires the substantial features of inventions. “Mainly using the material and technical resources of the employer” provided in the Article 6(1) of the Patent Law restricts the function of the aforementioned material and technical resources in the process of invention. It shall be understood that, firstly, the material and technical resources of the employer are indispensable to the invention, and the achievement of the invention cannot be realized without them; secondly, the material and technical resources of the employer are of primary importance compared other sources

used by the inventor, and outweigh them, according to which, the disputed patent ownership in question can be determined.

就本案物质条件来看，新材公司并无用于涉案专利研发的专门资金投入，其石墨烯微波膨化炉的生产、调试、传送带用高温毡的采购和替换等物质条件的提供和消耗，并非因为宋军礼的意志而进行，而是在新材公司组织的生产测试过程中被消耗，新材公司并无为宋军礼的科研活动提供物质条件的意思表示；相关物质条件的消耗过程并未指向宋军礼的科研活动，涉案专利较现有技术改进的主要创新在于“圆环形物料输送结构”，新材公司的相关设备、零部件不包括“圆环形物料输送结构”，亦无物质条件因指向涉案专利技术方案的研发过程中的分析、验证、测试而被使用，未对发明的取得产生实质性的影响。新材公司的现有证据不足以证明其为涉案专利的研发提供了主要物质条件。

In terms of the material resources of this case, no special funding has been invested in New Material for the research and development of the involved patent. The production and testing of its graphene microwave expansion furnace and the purchase and replacement of high-temperature felt for the conveyor belt and other material resources provided and consumed throughout the production and testing processes organized by New Material instead of relying on Song Junli's will. New Material has no intention of providing material resources for Song Junli's research activities. The

use of the relevant material resources does not concern Song Junli's scientific research, since the main innovation of the involved patent compared with the existing technologies lies in the "ring-shaped material conveying structure". While the relevant equipment and parts belonging to New Material do not include the "ring-shaped material conveying structure", and no material resources were used as these focus on the analysis, verification and testing phases of the research and development process for the technical solution of the involved patent; it has not had material impact on the achievement of the invention. The existing evidence of New Material is not sufficient to prove that it provides the main material resources for the research and development of the involved patent.

就本案技术条件来看, 新材公司提出宋军礼并无专业背景和从业经验、系接触到新材公司石墨烯微波膨化炉设备才产生发明创意、涉案专利的技术方案的部分内容与该设备相同。对于单位来说, 其不对外公开的技术资料属于单位的技术储备, 对于单位来说具有潜在的无形财产价值。但应注意的是, 不宜将发明人在涉案专利的发明创造过程中所处的技术环境或者所掌握的公司技术资料, 与法律规定的技术条件相混淆。如果相关技术资料对于涉案专利技术方案的实质性特点不能提供技术启示, 则原则上不应对专利权属产生影响。本案中, 新材公司所使用的石墨烯微波膨化炉系自微朗公司购入, 新材公司并未有效证明该设备系新

材公司提供技术方案、且技术方案未对外公开的事实，亦未证明宋军礼的发明创造使用了新材公司的设备改造方案和设备实验数据，故不足以认定新材公司为涉案专利的研发提供了主要技术条件。

In terms of the technical details of this case, New Material claimed that Song Junli had no professional background and relevant work experience. He only had the idea for the invention after he used the graphene microwave expansion furnace equipment of New Material, and part of the technical solution for the involved patent was identical to this equipment. For the employer, its undisclosed technical information belongs to the technical reserve of the employer, and is of potential intangible property value to the employer. However, it should be noted that it is not appropriate to confuse the technical environment in which the inventor was involved in the process of the invention of the involved patent with the technical information of the company in his/her possession with the technical conditions stipulated by the law. If the relevant technical information does not provide technological inspiration to substantial features of the involved patent's technical solution, it shall not, in principle, affect the patent ownership. In this case, the graphene microwave expansion furnace used by New Material is purchased from Wavelane Company. New Material has failed to

effectively prove that the equipment was provided by New Material and the technical solution was not disclosed to the public, nor that Song Junli's invention uses the equipment maintenance scheme and equipment experimental data belonging to New Material. Therefore, it is not sufficient to identify that New Material has provided the main technical conditions for the research and development of the involved patent.

## 27. 单位负责人执行本单位工作任务完成的发明创造的认定

### **Identification of inventions completed by the person in charge of the employer in performing work assignment of the employer**

#### **【裁判要旨】**

#### **[Judgment Digest]**

发明人是可以调动单位有关资源的单位负责人时, 可以综合考虑其日常工作内容、知识背景以及单位的性质、主营业务等与诉争专利的关联性, 判断专利是否为其“执行本单位的任务”所完成的发明创造。

In cases where the inventor is the person in charge of the **employer** that deploys the relevant resources of the **employer**, the

court could comprehensively consider the relevance of the content of his/her daily work, knowledge background, as well as the nature of the **employer** and its main business with the disputed patent, to determine whether the invention was completed while “executing the tasks of the **employer**”.

**【关键词】**

**[Keywords]**

专利权权属 职务发明创造 本单位工作任务

patent ownership; service invention; work tasks of the **employer**

**【案号】**

**[Case Number]**

(2021) 最高法知民终 403 号

(2021) SPC IP Civil Final 403

**【基本案情】**

**[Case Fact]**

在上诉人楚雄彝族自治州彝族医药研究所（以下简称彝族医药研究所）与被上诉人杨本雷专利权权属纠纷案（以下称“彝族医药”专利权权属纠纷案）中，涉及专利号为 201710157080.5、名称为“一种治疗失眠的药物组合物及其制备方法、制剂与应用”的发明专利（以下简称涉案专利）。彝族医药研究所向云南省昆明市中级人民法院（以下简称一审法院）提起诉讼，主张杨

本雷作出的发明创造是在本职工作中完成的发明创造, 并且是主要利用本单位的物质技术条件完成的发明创造, 请求判决涉案专利权归彝族医药研究所。一审法院认为, 彝族医药研究所提交的证据不能证明杨本雷作出的发明创造是在本职工作中完成的发明创造或是主要利用本单位的物质技术条件完成的发明创造, 判决驳回彝族医药研究所的诉讼请求。彝族医药研究所不服, 向最高人民法院提起上诉。最高人民法院于2021年12月6日判决撤销原判, 确认涉案专利权归属于彝族医药研究所。

The case of the patent ownership between the appellant Chuxiong Research Institute of Yi Ethnic Medicine (Research Institute of Yi Ethnic Medicine) and the appellee Yang Benlei (the case of “Yi Ethnic Medicine” patent ownership) involves an invention patent with patent No. 201710157080.5, titled “A Pharmaceutical Composition for Treating Insomnia and Its Production, Preparation and Application” (the involved patent). The Research Institute of Yi Ethnic Medicine filed a lawsuit in Kunming Intermediate People's Court (the Court of First Instance), claiming that Yang Benlei’s invention was conducted during the course of performing his duties and with the majority use of the material and technical resources of the employer, and requested a judgment determining that the involved patent was owned by the Research Institute of Yi Ethnic Medicine. The Court of First Instance

determined that the evidence submitted by the Research Institute of Yi Ethnic Medicine could not prove that the invention of Yang Benlei was completed through the course of performing his own duties or with the majority use of the material and technical resources of the employer. Hence, it rejected the claims of the Research Institute of Yi Ethnic Medicine. The Research Institute of Yi Ethnic Medicine refused to accept the decision and appealed to the SPC. On December 6, 2021, the SPC reversed the original judgment and declared that the involved patent was owned by the Research Institute of Yi Ethnic Medicine.

### **【裁判意见】**

#### **[Judge's Opinion]**

最高人民法院二审认为，根据专利法及其实施细则的规定，单位在职人员“执行本单位的任务”所完成的职务发明创造，包括该在职人员“在本职工作中作出的发明创造”和“履行本单位交付的本职工作之外的任务所作出的发明创造”这两种较为具体的情形。如果涉案专利的发明人并非普通在职人员，而是可以调动单位所有资源的单位负责人，则涉案专利是否为该负责人“执行本单位的任务”所完成的职务发明创造，还应结合该负责人的日常工作内容、知识背景以及该单位的根本性质和主营业务等与涉案专利的关联性予以综合判断。

In the second instance, the SPC held that, in accordance with the Patent Law and its Detailed Rules for Implementation, service inventions made by the incumbent employee of the employer “while performing the tasks of the employer” include two specific circumstances: the inventions made by the incumbent employee “while performing his/her duties” and “in execution of any task, other than his/her duties required of him/her by the employer to which he belongs”. If the inventor of the involved patent is not an ordinary employee, but is the person in charge of the employer who deploys all resources of the employer, the court shall comprehensively consider whether his/her daily work, knowledge background, the nature of the employer, its main business and other factors are related to the involved patent in order to determine whether the involved patent of the service invention was made by the person in charge while executing the tasks of the employer.

本案中，涉案专利说明书明确记载：“发明人通过 8 年来的临床用药进行观察，共通过 110 例失眠症患者进行临床观察，该药治疗总有效率 90%”。在涉案专利申请日前的 8 年内，杨本雷均在楚雄州中医院及其“加挂牌子”的彝族医药研究所工作，其对患者临床用药进行观察的行为既是其履行本职工作的行为，又是完成涉案专利的中药复方产品研发的重要环节。另外，彝族医药研究所的宗旨和业务范围包括开展彝族医药研究，彝族医药知识

和彝族药单方验方收集、整理、开发。可见，研究开发彝族医药是彝族医药研究所的核心工作内容。杨本雷作为具有研发能力的研究所所长，不能因其亦承担研究所的管理职责，就否定其研究人员的身份。况且，虽然杨本雷强调其承担的是研究所的管理职责但现有证据已经显示其参与了该研究所的研发工作。综合以上因素，杨本雷在彝族医药研究所工作期间完成的彝族医药领域的发明创造，与其本职工作具有高度关联性，涉案专利应认定为杨本雷在本职工作中作出的发明创造。

In this case, the description of the involved patent explicitly states that the inventor had observed the clinical use of the drug for eight years, and conducted clinical observation on a total of 110 insomnia patients, concluding the total efficiency rate of the drug treatment to be 90%. During the eight years prior to the date of patent application of the involved patent, Yang Benlei worked at the Chuxiong Hospital of Traditional Chinese Medicine and the hospital's associated Research Institute of Yi Ethnic Medicine. His observation of the clinical medication of patients was not only part of the execution of his duties, but also an important part of the research and development of the traditional Chinese medicine compound product of the involved patent. In addition, the purpose and scope of business of the Research Institute of Yi Ethnic Medicine includes conducting research on Yi ethnic medicine,

collecting, organizing and developing medical knowledge, folk and medicinal prescriptions of Yi ethnic medicine. It is clear that the research and development of Yi ethnic medicine is the core work of the Research Institute of Yi Ethnic Medicine. As the director of the institute with research and development capabilities, Yang Benlei's status as a researcher cannot be denied due to his management duties of the institute. Moreover, although Yang Benlei emphasized that he was responsible for the management of the institute, the existing evidence has shown that he also participated in the research and development work of the institute. Based on the factors mentioned above, the invention concerning Yi ethnic medicine made by Yang Benlei during his work at Research Institute of Yi Ethnic Medicine is highly relevant to his duties, and the involved patent shall be recognized as an invention made by Yang Benlei during the course of performing his duties.

## 28. 因职务发明专利获得的侵权损害赔偿能否构成发明人报酬的

计算基础

**Whether the infringement damages obtained from the service invention patent constitute the basis for calculating**

## remuneration for the inventor

### 【裁判要旨】

#### [Judgment Digest]

单位基于职务发明专利权获得的侵权损害赔偿，系禁止他人未经许可实施专利而获得的收入，在扣除必要的维权开支后，可以视为专利法实施细则第七十八条规定的营业利润，发明人可以据此主张合理报酬。

The infringement damages for the employer from the service invention patent refer to the income obtained by prohibiting others to exploiting the patent without consent. After deducting the necessary rights protection expenses, it can be regarded as business profit under Article 78 of the Detailed Rules for the Implementation of the Patent Law, and the inventor can claim reasonable remuneration accordingly.

### 【关键词】

#### [Keywords]

实用新型专利 发明人报酬 职务发明创造 侵权损害赔偿  
营业利润

utility model patent; remuneration for the inventor; service  
invention; infringement damages; business profit

### 【案号】

## **[Case Number]**

(2019) 最高法知民终 230 号

(2019) SPC IP Civil Final 230

## **【基本案情】**

## **[Case Facts]**

在上诉人东莞怡信磁碟有限公司（以下简称怡信公司）与被上诉人曾永福、原审第三人许贻明、王智职务发明创造发明人、设计人奖励、报酬纠纷案中，涉及专利号为 200720051806.9、名称为“便携可充式喷液瓶”的实用新型专利（以下简称涉案专利）。曾永福主张，其原系怡信公司员工，是怡信公司享有专利权的涉案专利发明人之一，怡信公司应当支付而未支付有关职务发明创造报酬，故向广州知识产权法院（以下简称一审法院）提起诉讼，请求判令怡信公司支付其职务发明创造发明人报酬 100 万元。一审法院经审理查明，怡信公司曾以涉案专利权被侵害为由提起多起侵权诉讼，获得判决支持的侵权赔偿数额合计 112.5 万元，故判决怡信公司向曾永福支付报酬 20 万元。怡信公司不服，向最高人民法院提起上诉，主张其并未实施涉案专利，也未因维权获益。最高人民法院于 2020 年 7 月 21 日判决驳回上诉，维持原判。

The case of awarding bonuses or remuneration for the inventor and designer of the service invention between the appellant Dongguan Yixin Ceramic Dish Co., Ltd. (“Yixin”), the appellee

Zeng Yongfu and the original trial third parties Xu Yiming and Wang Zhi, involves a utility model patent with patent No. 200720051806.9, titled “Portable Rechargeable Spray Bottle” (the involved patent). Zeng Yongfu filed a lawsuit in Guangzhou Intellectual Property Court (the Court of First Instance), claiming that he was an employee of Yixin as well as one of the inventors of the involved patent by Yixin, such that Yixin should have paid the remuneration for the service invention. He requested a judgment ordering Yixin to pay the remuneration for the inventor of CNY 1 million for his service invention. The Court of First Instance found that Yixin had filed several lawsuits on the grounds that the involved patent rights were infringed, and the total infringement damages supported by the judgment totaled CNY 1.125 million. Therefore, Yixin was ordered to pay remuneration of CNY 200,000 to Zeng Yongfu. Yixin rejected the decision and appealed to the SPC, claiming that it neither exploited the involved patent nor benefited from right protection. On July 21, 2020, the SPC rejected the appeal and upheld the original judgment.

### **【裁判意见】**

#### **[Judge’s Opinion]**

最高人民法院二审认为，根据专利法第十六条的规定，发明创造专利实施后，根据其推广应用的范围和取得的经济效益，对

发明人或者设计人给予合理的报酬。被授予专利权的单位应当向职务发明人或者设计人支付报酬，其原因在于被授予专利权的单位实施该专利并从实施中获得了经济效益，在专利被实施利用从而产生经济效益的情况下，获得该经济效益的单位应当给予发明人或者设计人合理的报酬。本案中，怡信公司作为被授予专利权的单位，基于涉案专利的维权行为获得的损害赔偿款，系专利权人禁止他人未经许可实施专利而获得的收入，在扣除必要的维权成本及支出后，该经济效益应当视为专利法实施细则第七十八条规定中所指的营业利润，据此基础给予发明人合理的报酬，于法有据。

In the second instance, the SPC held that, pursuant to Article 16 of the Patent Law, after exploitation of the invention patent, the inventor or designer shall be paid a reasonable remuneration on the basis of the scope of its popularity and application as well as the economic benefits obtained. The employer to which the patent right was granted shall pay remuneration to the inventor or designer of the service invention on the grounds that it has gained economic benefits by exploiting the patent. In the event that the patent is exploited and creates economic benefits, the employer which has gained such economic benefits shall pay reasonable remuneration to the inventor or designer. In this case, the employer was granted the patent right and since the infringement damages based on the rights protection of

the involved patent refer to the income obtained by the patentee from prohibiting others from exploiting the patent without consent, and after deducting the necessary rights protection expenses, the economic benefit can be deemed as business profit under Article 78 of the Detailed Rules for the Implementation of the Patent Law. Accordingly, Yixin shall pay reasonable remuneration to the inventor in accordance with the law.

因此, 综合考虑涉案专利类型为实用新型专利、涉案专利涉及三位发明人、涉案专利权的有效期、涉案专利对于怡信公司相关技术产品的研发和改进具有的影响和价值、怡信公司在维权诉讼中必然存在的费用支出、怡信公司获得判决支持的侵权损害赔偿款经过执行实际到账的情况等多项因素, 一审法院酌定怡信公司应当支付曾永福职务发明报酬 20 万元, 基本适当。

Therefore, after comprehensively considering the type of the involved patent being utility model patent, the three inventors concerned in the involved patent, the validity period of the involved patent, the impact and value of the involved patent on the research and development and improvement of Yixin's related technical solutions, the inevitable expenses of Yixin in the lawsuit, and Yixin's actual infringement damages supported by judgment upon enforcement, it is appropriate for the Court of First Instance for holding that Yixin shall pay the appropriate remuneration amount of

CNY 200,000 to Zeng Yongfu for his service invention.

## 29. 公司董事、高管违反忠实义务无偿受让公司专利权的后果

### **Consequences of free transfer of a patent owned by a company to its director or senior manager violating the duty of Fidelity**

#### **【裁判要旨】**

#### **[Judgment Digest]**

公司董事、高级管理人员将公司专利权无偿转让至其个人名下，且未能提交充分证据证明该转让行为符合公司章程的规定或者经股东会、股东大会同意的，构成对公司忠实义务的违反，有关专利权转让行为无效，专利权仍然应归公司所有。

Where any director or senior manager of a company transfers the patent owned by the company to himself/herself with no charge, and fails to submit sufficient evidence to prove that such transfer is in compliance with the Articles of Association or has been agreed on by the shareholders' meeting, such transfer constitutes a breach of his or her duty of fidelity. The patent transfer shall be null and void and the patent shall still belong to the company.

#### **【关键词】**

## **[Keywords]**

专利权权属 董事 高管 忠实义务 转让

patent ownership; director; senior manager; duty of fidelity;  
transfer

## **【案号】**

### **[Case Number]**

(2021) 最高法知民终 194 号

(2021) SPC IP Civil Final 194

## **【基本案情】**

### **[Case Facts]**

在上诉人李敏与被上诉人滕州市绿原机械制造有限公司（以下简称绿原公司）专利权权属纠纷案中，涉及专利号为 200710015109.2、名称为“高分子复合波纹膨胀节”的发明专利（以下简称涉案专利）。绿原公司认为，李敏在担任绿原公司法定代表人期间，利用职务之便，在公司不知情的情况下，擅自将涉案专利权过户至其个人名下，故向山东省济南市中级人民法院（以下简称一审法院）提起诉讼，请求判令确认涉案专利权归绿原公司所有。一审法院认为，涉案专利权转让行为违反了《中华人民共和国公司法》（以下简称公司法）的强制性规定，应属无效判决涉案专利权归绿原公司所有。李敏不服，向最高人民法院提起上诉。最高人民法院于 2021 年 6 月 17 日判决驳回上诉，维持原判。

The case of the patent ownership between the appellant Li Min and the appellee Tengzhou Lvyuan Machinery Manufacture Co., Ltd. (“Lvyuan”) involves an invention patent with patent No. 200710015109.2, titled “Polymer Composite Corrugated Expansion Joint” (the involved patent). Lvyuan filed a lawsuit in Jinan Intermediate People's Court (the Court of First Instance), claiming that while Li Min served as the legal representative of Lvyuan, he took advantage of his position to get the involved patent without the knowledge of the company, and requested a judgment to confirm that the involved patent rights were owned by Lvyuan. The Court of First Instance held that the transfer of the involved patent rights shall be null and void in violation of the mandatory provisions of *Company Law of the People's Republic of China* (Company Law) and ordered that the involved patent is owned by Lvyuan. Li Min rejected the decision and appealed to the SPC. On June 17, 2021, the SPC rejected the appeal and upheld the original judgment.

### **【裁判意见】**

#### **[Judge's Opinion]**

最高人民法院二审认为，2013年修正的公司法第一百四十七条规定，董事、监事、高级管理人员应当遵守法律、行政法规和公司章程，对公司负有忠实义务和勤勉义务。董事、监事、高级管理人员不得利用职权收受贿赂或者其他非法收入，不得侵占公司

的财产。本案中，李敏在其担任绿原公司执行董事兼经理期间，于2018年8月29日签署涉案专利权转让声明，将涉案专利权的一切权利无偿转让给自己，并到国家知识产权局办理了相应变更手续。虽然李敏在一审庭审中陈述，其代表公司将涉案专利权转至自己名下时，曾口头通知另一股东，但李敏未提供相应证据加以证明，且该股东在一审中表示其对此转让并不知情，亦不同意。因此，虽然在涉案专利权转让时李敏系占绿原公司三分之二以上股权的股东，但涉案专利权的转让系李敏利用职务之便将绿原公司的专利权无偿转让到个人名下，且李敏未提供充分证据证明其代表绿原公司转让涉案专利权时按照公司章程的规定履行了合法手续，也未提供充分证据证明该转让行为系为绿原公司利益所为，故这一转让行为违反了李敏对公司的忠实义务，应属无效。涉案专利权转让声明及所办理的变更手续并不能产生转让专利权的法律效力，涉案专利权仍应归绿原公司所有。

In the second instance, the SPC held that subject to Article 147 of Company Law (2013 Amendment), the directors, supervisors and senior managers shall comply with the laws, administrative regulations, and the Articles of Association, and shall bear the duty of fidelity and diligence to the company. No director, supervisor or senior manager shall take advantage of their power to accept any bribe or other illegal gains, nor misappropriate the property of the company. In this case, during Li Min's tenure as the executive

director and manager of Lvyuan, he signed a declaration for transfer of the involved patent on August 29, 2018, transferring all rights of the involved patent to himself gratuitously, and conducted the corresponding change procedures with the Chinese National Intellectual Property Administration. Although Li Min stated in the first instance that he had vocally notified another shareholder when he transferred the involved patent to himself on behalf of the company, he failed to provide corresponding evidence to prove this statement. Moreover, this shareholder stated in the first instance that he neither knew about the transfer nor did he agree to it. Hence, although Li Min held more than two-thirds of the equity interests of the company when transferring the involved patent, he exploited his position and made the transfer gratuitously. He fails to provide sufficient evidence to prove that he has fulfilled legitimate procedures in accordance with the Articles of Association when he transferred the involved patent on behalf of Lvyuan and that the transfer was for the benefit of the company. Therefore, the transfer is null and void in violation of Ling Min's duty of loyalty to the company. The declaration of transfer of the involved patent and the change procedures conducted are not of legal validity, and the involved patent shall continue to be owned by Lvyuan.

### **30. 通过改进他人非公开技术方案获得专利时的权属证明责任**

**The burden of proof on the patent ownership when such patent is obtained through improving undisclosed technical solutions owned by others**

**【裁判要旨】**

**[Judgment Digest]**

原告以涉案专利系被告将原告的非公开技术方案申请专利为由，主张涉案专利权归其所有的，应当举证证明涉案专利来源于其在先完成的非公开技术方案，并且被告在涉案专利申请日前能够获知该技术方案；被告主张其对原告的技术方案进行了改进并据此享有涉案专利权的，至少应当证明或者合理说明涉案专利相对于原告的技术方案存在区别，且该区别构成涉案专利的实质性特点和进步。

In cases where the plaintiff claims that the involved patent is owned by him/her on the grounds that the defendant filed a patent application with the plaintiff's undisclosed technical solution, he/she shall prove that the involved patent derives from his/her prior undisclosed technical solution and that the defendant had the access to the technical solution before the date of patent application. Where the defendant claims that he has improved the plaintiff's technical solution and is entitled to the involved patent accordingly, he shall at

minimum prove or reasonably explain that there is a difference between the involved patent and the plaintiff's technical solution and that the difference constitutes substantial features and progress of the involved patent.

**【关键词】**

**[Keywords]**

专利权权属 非公开技术方案 证明责任 实质性特点和进步  
patent ownership; undisclosed technical solution; burden of  
proof; substantial features and progress

**【案号】**

**[Case Number]**

(2020) 最高法知民终 1293 号

(2020) SPC IP Civil Final 1293

**【基本案情】**

在上诉人聊城市鲁西化工工程设计有限责任公司（以下简称聊城鲁西化工公司）与被上诉人航天长征化学工程股份有限公司（以下简称航天长征公司）专利权权属纠纷案中，涉及专利号为 201720586771.2、名称为“一种气化炉出口气体喷淋装置”的实用新型专利（以下简称涉案专利）。航天长征公司主张，聊城鲁西化工公司申请涉案专利的技术方案均源于航天长征公司在 30 万吨尿素项目中交付给其母公司鲁西化工集团股份有限公司的技术资料、图纸及设备实物，涉案专利权应归属于航天长征公司。

航天长征公司向山东省济南市中级人民法院（以下简称一审法院）提起诉讼，请求确认涉案专利权属于航天长征公司。一审法院认为，涉案专利是聊城鲁西化工公司在接触并借鉴航天长征公司在先技术方案的前提下取得，且涉案专利与航天长征公司的在先技术相比不具备实质性特点，其对涉案专利并未作出创造性贡献，涉案专利应为航天长征公司所有。聊城鲁西化工公司不服，向最高人民法院提起上诉。最高人民法院认定涉案专利权属于航天长征公司，于2021年12月20日判决驳回上诉，维持原判。

The case of patent ownership between the appellant Liaocheng Luci Chemical Engineering Design Co., Ltd. (Liaocheng Luci Chemical Engineering) and the appellee Changzheng Engineering Co., Ltd. (“Changzheng”) involves a utility model patent with patent No. 201720586771.2, titled “A Gasification Furnace Outlet Gas Spray Equipment” (the involved patent). Changzheng alleged that the involved patent shall be owned by Changzheng on the grounds that the technical solutions applied by Liaocheng Luci Chemical Engineering for the involved patent were all derived from the technical data, drawings and equipment delivered by Changzheng to its parent company, Luci Chemical Group Co., Ltd., in the 300,000-ton urea project. Changzheng filed a lawsuit in Jinan Intermediate People's Court (the Court of First Instance), requesting the court confirm that the involved patent rights were owned by themselves.

The Court of First Instance held that the involved patent was obtained by Liaocheng Luci Chemical Engineering under the premise of accessing and learning from the prior technical solutions of Changzheng, and the involved patent lacked substantial features compared with the prior technology of Changzheng, so it did not make any inventive contribution to the involved patent, and the involved patent shall continue to be owned by Changzheng. Liaocheng Luci Chemical Engineering rejected the decision and appealed to the SPC. On December 20, 2021, the SPC rejected the appeal and upheld the original judgment that the involved patent right was owned by Changzheng.

### **【裁判意见】**

#### **[Judge's Opinion]**

最高人民法院二审认为，航天长征公司主张聊城鲁西化工公司将航天长征公司非公开的技术方案申请涉案专利，对于该种类型的专利权权属纠纷，一般首先应由原告举证证明涉案专利技术方案来源于其在先完成的技术方案，并且被告在涉案专利申请日前能够获知该技术方案；如果被告主张涉案专利技术方案系对现有技术而非对原告技术方案的改进，应当举证证明；在已确认涉案专利技术方案来源于原告的情况下，被告应说明涉案专利技术方案与原告技术方案的区别，并在此基础上就其对发明创造的实质性特点作出创造性贡献进行证明或合理的说明；若双方主张对

方各自完成的部分属于公知常识、现有技术或现有技术已给出明确的技术启示，应对此进行举证。人民法院根据双方当事人针对上述内容提交的证据确定专利权归属。

In the second instance, the SPC held that, for the case of patent ownership in which Changzheng claimed that its undisclosed technical solution applied by Liaocheng Luci Chemical Engineering for the involved patent, the plaintiff shall prove that the technical solution of the involved patent is derived from its prior technical solution and that the defendant can be informed of the technical solution before the application date of the involved patent. Where the defendant claims that the technical solution of the involved patent is an improvement of the existing technology rather than the technical solution of the plaintiff, the defendant shall prove it. Where it has been confirmed that the technical solution of the involved patent is derived from the plaintiff, the defendant shall explain the difference between the technical solution of the involved patent and the technical solution of the plaintiff and, on this basis, prove or reasonably explain its inventive contribution to the substantial features of the invention. Where each party claims that the part completed by the other party is common general knowledge, or that the existing technology has given explicit technical inspiration, proof shall be submitted. The people's court determines the patent

ownership based on the evidence submitted by the parties in response to what has been mentioned above.

本案中，聊城鲁西化工公司认可其确系在该图纸的技术方案的基础上得到涉案专利的技术方案，但主张其作出了具有实质性特点的改进。与专利授权确权程序中对发明创造是否具有实质性特点的判断不同，在以非公开的技术方案作为主张权利基础的专利权属纠纷中，关于“对发明创造的实质性特点作出创造性贡献”的判断，建立在作为专利来源的非公开的技术方案基础之上。在这种情况下，对他人非公开技术方案作出改动并申请专利的一方要单独或共同拥有专利权，至少应当通过体现研发过程、技术效果等内容的证据或理由，证明或合理说明其在他人非公开技术方案基础上，进一步作出了实质性的技术贡献。涉案专利权利要求1、2仅仅是在航天长征公司的技术方案的基础上具体选择了喷淋管口与气化炉合成气出口管道之间倾斜连接的方式，并具体限定了倾斜的角度。虽然说明书也记载了其可以获得有益的技术效果，但设置喷淋装置本身即是为了去除合成气中的煤灰，喷淋管口与气化炉合成气出口管道之间连接的角度不同必然导致喷淋位置不同。在聊城鲁西化工公司既无实际研发记录，亦无验证技术效果的证据的情况下，难以说明其通过该点改动对发明创造的实质性特点作出了创造性贡献，故聊城鲁西化工公司不应因此改动而对该技术方案拥有专利权。

In this case, Liaocheng Luci Chemical Engineering admitted

that it had obtained the technical solution of the involved patent on the basis of the technical solution of the drawings, but claimed that it had made substantial feature improvements. Unlike the judgment on whether the invention has substantially changed features within the process of patent authorization and affirmation, in the case of patent ownership based on an undisclosed technical solution, the judgment of “creative contribution to substantive features of the invention” is based on the undisclosed technical solution as the source of the patent. Under such circumstance, if the party who modifies others’ undisclosed technical solutions and files a patent application, wishes to own the patent right solely or jointly, he/she shall at minimum prove or reasonably explain that he/she has made further substantial technical contribution based on the other person’s undisclosed technical solution using evidence or reasoning that reflects the process of research and development, technical effect etc. Claims 1 and 2 of the involved patent only specify the inclined connection mechanism between the spray nozzle and the gasification furnace syngas outlet pipeline of the technical solution of Changzheng, and specifically the inclination angle. Although the description records that useful technical outcome can be achieved, the spray device removes the coal ash in syngas, so the different connection angle between spray nozzle and the gasification furnace syngas outlet

pipeline will inevitably result in the different spraying positions. In the event that neither record of the actual research and development nor evidence to verify the technical outcome is submitted by Liaocheng Luci Chemical Engineering, it is difficult to prove that it has made inventive contribution to substantial features of the invention through improving the device. Therefore, the patent for the said technical solution shall not be owned by Liaocheng Luci Chemical Engineering due to this improvement.

### 31. 擅自转移、处分保全证据的法律后果

#### **Legal consequences of unauthorized transfer and disposal of preserved evidence**

##### **【裁判要旨】**

##### **[Judgment Digest]**

侵害专利权纠纷案件中，被诉侵权人擅自转移、处分人民法院已经依法采取证据保全措施的被诉侵权产品，致使有关侵权事实无法查明的，构成对诚信诉讼原则的违反，可以推定被诉侵权产品落入涉案专利权保护范围，并可以对被诉侵权人采取罚款等民事强制措施。

In the case of patent infringement, where the alleged infringer transfers and disposes of the disputed infringing product that has

been preserved by people's courts, which leads to failure of infringement-related facts finding and violation of the principle of good-faith litigation, people's courts can presumed that the infringing product falls within the protection scope of the involved patent, and fines or other compulsory measures in civil litigation could be imposed on the alleged infringer.

**【关键词】**

**[Keywords]**

发明专利 侵权 擅自转移处分证物 不利事实推定 民事强制措施

invention patent; infringement; unauthorized transfer and disposal of evidence; adverse presumption of fact; civil compulsory measures

**【案号】**

**[Case Number]**

(2021) 最高法知民终 334 号

(2021) SPC IP Civil Final 334

**【基本案情】**

**[Case Facts]**

在上诉人无锡瑞之顺机械设备制造有限公司（以下简称瑞之顺公司）与被上诉人周勤侵害发明专利权纠纷案中，涉及专利号为 201110375874.1、名称为“排水板成型机”的发明专利（以下

简称涉案专利)。周勤认为,瑞之顺公司未经许可,制造、销售、许诺销售落入涉案专利权保护范围的产品,侵害其涉案专利权,故向江苏省苏州市中级人民法院(以下简称一审法院)提起诉讼,请求判令瑞之顺公司停止侵害并赔偿经济损失。一审法院认为,瑞之顺公司擅自转移、处分被一审法院诉前保全的证物的行为,已经构成妨害民事诉讼并直接影响侵权判断的有效进行,决定对其罚款 20 万元,并依法认定瑞之顺公司制造、销售、许诺销售的被诉侵权产品落入涉案专利权的保护范围,构成专利侵权,判决瑞之顺公司停止侵害并赔偿经济损失及维权合理开支共计 100 万元。瑞之顺公司不服,向最高人民法院提起上诉。最高人民法院于 2021 年 6 月 23 日判决驳回上诉,维持原判。

The case of infringement of invention patent between the appellant Wuxi Ruizhishun Machinery Equipment Manufacturing Co., Ltd. (“Ruizhishun”) and the appellee Zhou Qin involves an invention patent with patent No. 201110375874.1, titled “Drain Board Forming Machine” (the involved patent). Zhou Qin filed a lawsuit in Suzhou Intermediate People's Court (the Court of First Instance), claiming that Ruizhishun manufactured, sold and offered to sell the product that is incorporated in the protection scope of the involved patent without its consent, infringing the involved patent. He requested that Ruizhishun shall be ordered to cease the infringement and pay damages for financial losses. The Court of

First Instance held that Ruizhishun's unauthorized transfer and disposal of the evidence preserved by the Court of First Instance before trial constituted an obstruction of civil litigation and directly affected the binding judgment of the alleged infringement. Therefore, the Court of First Instance decided to fine CNY 200,000, and found that the disputed infringing product manufactured, sold and offered to sell by Ruizhishun is within the protection scope of the involved patent, and constituted patent infringement in accordance with the law. Ruizhishun was ordered to cease the infringement and pay damages totaling CNY 1 million for financial losses and reasonable rights protection expenses. Ruizhishun refused to accept the decision and appealed to the SPC. On June 23, 2021, the SPC rejected the appeal and upheld the original judgment.

### **【裁判意见】**

#### **[Judge's Opinion]**

最高人民法院二审认为，根据《中华人民共和国民事诉讼法》（以下简称民事诉讼法）第十三条第一款、《最高人民法院关于知识产权民事诉讼证据的若干规定》第一条、第十四条、第二十五条第一款的规定，对于被人民法院采取保全措施的被诉侵权产品或者其他证据，被诉侵权人擅自实施毁损、转移证据等行为致使是否侵权无法查明的，人民法院可以依法推定权利人就该证据所涉证明事项的主张成立。本案中，涉案专利权利要求1限定

了诸多技术特征，且部分技术特征涉及产品内部结构及位置连接关系，故如果无法接触、观察被诉侵权产品实物，显然不易查明被诉侵权产品实施的技术方案是否全面覆盖涉案专利权利要求 1 所限定的全部技术特征。一审法院在对被诉侵权产品采取证据保全时已明确告知瑞之顺公司不得擅自改变被保全证物的现状，瑞之顺公司的法定代表人在保全笔录上亦签字确认。但瑞之顺公司此后不但实施了擅自转移、处分被诉侵权产品的行为，而且在一审法院组织双方委托代理人进行现场勘验时仍拒不告知被诉侵权产品的准确去向，导致一审法院的勘验目的落空，无法组织双方当事人围绕被诉侵权产品实物展开技术特征比对。瑞之顺公司实施的上述妨害民事诉讼行为，严重悖离诚信原则，且人为加大了人民法院查明技术事实的难度，理应为此承担相应不利的法律后果。一审法院基于瑞之顺公司实施的妨害民事诉讼行为，依法推定被诉侵权产品实施的技术方案落入涉案专利权利要求 1 的保护范围，并无不当。瑞之顺公司擅自实施转移、处分证据保全证物的行为构成妨害民事诉讼，一审法院对其采取罚款的强制措施，属于公法层面的制裁，体现的是法律对于瑞之顺公司妨害民事诉讼、破坏诉讼秩序的否定性评价。人民法院对于被诉侵权人实施的妨害民事诉讼行为，分别对其课以公法层面的制裁和私法层面的不利事实推定，两项举措各司其职，并行不悖。

In the second instance, the SPC held that, pursuant to Article 13(1) of *Civil Procedure Law of the People's Republic of China*

(Civil Procedure Law) and Articles 1, 14 and 25(1) of *Provisions of the Supreme People's Court on Evidence in Civil Procedures Involving Intellectual Property Rights*, as for the disputed infringing product or for other evidence to which the people's court has taken preservation measures, if the infringement cannot be identified on the grounds that the alleged infringer destroys or tampers with the evidence without approval, the people's court can presume that the right holder's claims on the matters proved by the evidence are tenable in accordance with the law. In this case, since claim 1 of the involved patent defines many technical features, some of which involve the internal structure and the position connection relationship of the product, it is obviously not easy to identify whether the technical solution exploited by the infringing product comprehensively covers all the technical features defined in claim 1 of the involved patent without exposure to and observation of the infringing product itself. The Court of First Instance has explicitly informed Ruizhishun that it shall not arbitrarily change the current situation of the preserved evidence when taking evidence preservation measures for the infringing product, and the legal representative of Ruizhishun has signed on the preservation transcript to confirm acknowledgement of this. However, Ruizhishun not only tampered with and disposed of the infringing

product without authorization, but has also refused to inform the Court of First Instance of the exact whereabouts of the infringing product when the court organized authorized agents of both parties to conduct an on-site investigation, which subsequently led to the failure of the Court of First Instance's investigation and the inability to organize the parties to carry out a comparison of the technical features of the contested products. Since the aforementioned obstruction of civil litigation committed by it seriously violates the principle of good faith and increases the difficulty of the people's court to identify the technical truths, Ruizhishun shall bear the corresponding adverse legal consequences. The Court of First Instance, based on the obstruction of civil litigation conducted by Ruizhishun, presumed that the technical solution exploited by the alleged infringing product was within the protection scope of claim 1 of the involved patent in accordance with the law, which was not improper. Ruizhishun's unauthorized tampering with or disposal of the preserved evidence constitutes obstruction of civil litigation, and the Court of First Instance consequently can impose a fine, which is a valid sanction in public law, reflecting the negative evaluation of Ruizhishun's obstruction of civil litigation and disruption of litigation order. Upon the obstruction of civil litigation committed by the alleged infringer, the people's court imposes sanctions from the

perspective of public law and took adverse presumption of facts from the perspective of private law. Each of the two measures performs their respective duties and does not contradict each other.

### 三、植物新品种案件

#### III. New Plant Variety Cases

##### 32. 涉“信息匹配平台”销售种子行为的认定

##### **Determination of the sale of seeds concerning “Information Matching Platform”**

##### **【裁判要旨】**

##### **[Judgment Digest]**

被诉侵权人通过网络交易平台以“信息匹配”名义组织被诉侵权种子买卖交易，并实际主导确定交易价格、交易数量、履行时间等具体交易条件的，可以认定其实施了销售被诉侵权种子的行为。

Where the alleged infringer organizes the sale and purchase of the infringing seeds through the online trading platform in the name of “information matching” and actually plays a dominant role in determination of the transaction price, quantity, performance time and other specific transaction conditions, it can be determined that

the infringer has sold the disputed infringing seeds.

**【关键词】**

**[Keywords]**

植物新品种 侵权 信息匹配平台 销售

new plant variety; infringement; information matching platform; sale

**【案号】**

**[Case Number]**

(2021) 最高法知民终 816 号

(2021) SPC IP Civil Final 816

**【基本案情】**

**[Case Facts]**

在上诉人江苏亲耕田农业产业发展有限公司（以下简称亲耕田公司）与被上诉人江苏省金地种业科技有限公司（以下简称金地公司）侵害植物新品种权纠纷案中，金地公司为水稻新品种“金粳 818”的独占实施被许可人，其主张亲耕田公司未经许可，以微信群内发布“农业产业链信息匹配”方式，对外销售白皮袋包装的“金粳 818”稻种，构成侵权，向江苏省南京市中级人民法院（以下简称一审法院）提起诉讼，请求判令亲耕田公司停止侵害并赔偿经济损失 300 万元。亲耕田公司辩称其仅是向种子供需双方提供自留种子信息，由供需双方自行交易，并未销售被诉侵权“金粳 818”稻种。一审法院认为涉案侵权种子系案外人销售，亲

耕田公司对案外人的侵权行为提供了帮助，故判决支持了金地公司全部诉讼请求。亲耕田公司不服，向最高人民法院提起上诉。最高人民法院二审查明，亲耕田公司在涉案交易中实施了下列行为：通过微信发布种子供应信息；金地公司取证人员从亲耕田公司处得知有白皮包装的“金粳 818”出售，在金地公司取证人员签署《亲耕田联合农场加盟协议》并付款后，亲耕田公司将所谓“供方”信息提供给金地公司；金地公司按照亲耕田公司的安排取得被诉侵权种子，金地公司取证人员获得被诉侵权种子的交易过程中，种子的数量、价格、大致交货时间等均由亲耕田公司与其确认。遂于 2021 年 8 月 25 日判决驳回上诉，维持原判。

In the case of infringement of new plant variety rights between the appellant Jiangsu Qingengtian Agricultural Industry Development Co., Ltd. (“Qingengtian”) and the appellee Jiangsu Jindi Seed Technology Co., Ltd. (“Jindi”), Jindi, the exclusive licensee of the new rice variety “Jinjing 818”, filed a lawsuit in Nanjing Intermediate People's Court (the Court of First Instance), claiming that Qingengtian publicly sold the seed of the rice variety “Jinjing 818” packaged in white bags through posting “agricultural industry chain information matching” in WeChat groups without permission. This constituted infringement, and so a judgment was requested ordering Qingengtian to cease the infringement and pay damages of CNY 3 million for financial losses. Qingengtian argued

that they themselves only provided information on the seeds to seed suppliers and buyers, and that the suppliers and buyers traded on their own, such that it did not sell the disputed infringing seed of the rice variety “Jinjing 818”. The Court of First Instance held that the involved infringing seeds were sold by a person external to all parties involved in the case, but that Qingengtian provided assistance to its infringement, so it ruled in favor of the claims of Jindi. Qingengtian rejected the decision and appealed to the SPC. In the second instance, the SPC found that Qingengtian committed the following acts in the involved transaction: first, publishing seed supply information through WeChat; second, providing the so-called “supplier” information to Jindi after the evidence collector of Jindi had found that Qingengtian had been packaging “Jinjing 818” in white bags to be sold, and had signed the “Qingengtian Joint Farm Franchise Agreement” and making a payment; thirdly, arranging Jindi to obtain the disputed infringing seeds by confirming the quantity, price and approximate delivery time of the seeds and other elements with the evidence collector of Jindi during the transaction of obtaining the disputed infringing seeds. Therefore, on August 25, 2021, the SPC rejected the appeal and upheld the original judgment.

### **【裁判意见】**

### **[Judge’s Opinion]**

最高人民法院二审认为，一般而言，买卖双方就标的物买卖条件的意思表示达成一致，销售合同依法成立，则构成法律意义上的销售行为。同时，参照《最高人民法院关于审理侵害植物新品种权纠纷案件具体应用法律问题的若干规定（二）》第四条的规定，以广告、展陈等方式作出销售授权品种繁殖材料的意思表示的，人民法院可以以销售行为认定处理。即销售合同成立前的广告、展陈等行为已足以认定为销售行为，销售者是否亲自实施标的物的交付和收款行为，不影响其销售行为性质的认定。亲耕田公司实施了发布被诉种子销售具体信息，与金地公司取证人员协商确定种子买卖的包装方式、价款和数量、履行期限等交易要素，其行为对于被诉侵权种子的交易不仅具有肇始意义，而且金地公司依据与亲耕田公司约定的交易条件，已产生据此取得被诉侵权种子所有权的确定预期，销售合同已经依法成立。可见，亲耕田公司系被诉侵权种子的交易组织者、决策者。后续交易履行过程中货物交付和收款的主体的变化，并不影响认定亲耕田公司的销售主体地位。故根据上述事实，可以认定亲耕田公司直接实施了被诉侵权种子的销售行为。

In the second instance, the SPC held that, in general, when the buyer and seller agree on the transaction conditions of the concerned product, and the sale contract is established in accordance with the law, a sales act has been constituted in the legal sense. At the same time, Article 4 of *Provisions of the Supreme People's Court on the*

*Specific Application of Law in the Trial of Cases Involving Disputes over Infringement upon Rights of New Plant Varieties (II)* stipulates that where a declaration of intention to sell propagating materials of an authorized variety is made by such means as advertisement and exhibition, the people's court may determine and handle such activity as a sales act. That means advertisement, exhibition and other acts prior to the establishment of the sales contract are sufficient to be determined as a sales act. Whether the delivery of the product and payment is completed by the seller themselves has no impact on the judgment of the nature of the sales act. Qingengtian has released specific information on the sale of the infringing seed and had determined the packaging methods, prices, quantity, time limit for completion and other elements involved in transaction of the sale of seed by negotiating with the evidence collector personnel of Jindi. Its behaviours can be deemed as the start of the transaction of the disputed infringing seeds and Jindi, based on the transaction conditions agreed with the Qingengtian, has determined the definite expectation of acquiring the ownership of the disputed infringing seeds, such that the sales contract had been established in accordance with the law. It can be seen that Qingengtian is the organizer of and decision-maker in transactions with respect to the disputed infringing seed. The change to the goods delivery and payment in

the course of the subsequent transaction has no impact on the status of Qingengtian as the sales subject. Therefore, based on the aforementioned facts, it can be found that Qingengtian directly implemented the sale of the disputed infringing seeds.

### 33. 单方委托的检验报告的证据性质和证明力

#### **The nature of evidence and the probative value of the unilaterally-submitted inspection report**

##### **【裁判要旨】**

##### **[Judgment Digest]**

侵害植物新品种权纠纷案件中，一方当事人就专门性问题自行委托有关机构或者人员出具的意见，在法律性质上虽非鉴定意见，但仍具备证据资格，一般可以参照法律和司法解释关于鉴定意见的审查规则和准用私文书证的质证规则，结合具体案情，对其证明力适当从严审查。自行委托取得的书面意见由具有相应资格的机构和人员作出、检测程序合法、对照样品来源可靠、检测方法科学，经质证对方当事人未提出足以推翻意见的相反证据或者足以令人信服的质疑的，一般可以确认其证明力；存在程序严重违法、对照样品来源不明等重大错误，或者对方当事人提交了足以推翻意见的相反证据或者足以令人信服的质疑的，不予采信

In the case of infringement on new plant variety rights, the

opinion on a specialized issue from a relevant institution or person engaged by a party on its own cannot be regarded as an expert opinion in a legal context, but it is still qualified as evidence. In general, the people's court can refer to the legal and judicial interpretation of rules regarding use of expert opinion and can cross-examine with the rules for providing private documentary evidence, to properly and strictly review the probative value of such opinion in an appropriate manner in combination with specific case facts. In terms of written opinions submitted by a party on its own, if the opinion is released by a qualified institution or person, with legal testing procedures followed, the source of control samples being reliable and testing methods being scientific and if the other party fails to submit counter evidence that suffices to overturn the opinion or pose a convincing challenge upon cross-examination, its probative value can generally be affirmed. Where there is serious procedural violation, control samples of unknown sources and other major errors, or the other party submits evidence that suffices to overturn the opinion or poses a convincing challenge, the opinion shall not be accepted.

**【关键词】**

**[Keywords]**

植物新品种 侵权 单方鉴定 证据性质 证明力

new plant variety; infringement; unilateral appraisal; nature of evidence; probative value

### **【案号】**

#### **[Case Number]**

(2021) 最高法知民终 732 号

(2021) SPC IP Civil Final 732

### **【基本案情】**

#### **[Case Facts]**

在上诉人山西诚信种业有限公司（以下简称诚信公司）与被上诉人山东登海先锋种业有限公司（以下简称登海公司）、原审被告和顺县玉丰农业生产资料销售有限公司（以下简称玉丰公司）侵害植物新品种权纠纷案中，登海公司为玉米新品种“先玉 508”的被许可人，登海公司发现和玉丰公司对外销售外包装为“诚信 1 号”而实际为“先玉 508”的玉米种子，该产品由诚信公司生产，故向山西省太原市中级人民法院（以下简称一审法院）提起诉讼。登海公司委托河南中农检测技术有限公司对经公证购买的“诚信 1 号”与“先玉 508”进行品种真实性比对，做出《检验报告》（NO.D2004058），检验结论为：该样品与对照样品经用 40 对 SSR 引物进行 DNA 谱带数据对比，差异位点数为 0，判定为极近似或相同品种。诚信公司和玉丰公司对其检测结论、方法以及证明的目的不予认可，认为该对照样品检测所依据的对照样品“先玉 508”的样品状态是包衣，该样品来源不明。一审法院采信了

河南中农检测技术有限公司上述检验报告，据此认定诚信公司生产涉案种子侵害登海公司涉案植物新品种权，判决诚信公司停止侵害并赔偿 20 万元。诚信公司不服，向最高人民法院提起上诉，主张标准样品系登海公司提供，鉴定意见不足采信，应使用农业部植物新品种保藏中心保存的标准样品；山西省种子管理站委托农业部植物新品种测试中心所作《农业植物品种特异性鉴定报告》证明被诉侵权的“诚信 1 号”与“先玉 508”属不同品种，一审法院忽略该证据而直接采信登海公司 DNA 测试结果，导致认定事实不清；一审法院不准许司法鉴定，剥夺了诚信公司的权利。最高人民法院于 2021 年 10 月 21 日裁定撤销原判，本案发回重审。

In the case of the disputed infringement of new plant variety rights between the appellant Shanxi Integrity Seed Industry Co., Ltd. (hereinafter referred to as Integrity), the appellee Shandong Denghai Xianfeng Seed Co., Ltd. (“Denghai”), and the first-instance defendant Heshun County Yufeng Agricultural Production Materials Sales Co. Ltd. (“Yufeng”), Denghai, the licensee of the new corn variety “Xianyu 508”, filed a lawsuit in Taiyuan Intermediate People's Court (the Court of First Instance), finding that Yufeng sold corn seeds produced by Integrity as “Integrity No.1” package, that actually were “Xianyu 508”. Henan Zhongnong Testing Technology Co., Ltd. was commissioned by Denghai Company to conduct the variety authenticity comparison between “Integrity 1” and “Xianyu

508” purchased upon notarization, and produced Test Report (No. D2004058), which concluded that the sample and the control sample were very similar or the same variety compared by 40 SSR primers for DNA spectrogram data, with difference loci being 0. Integrity and Yufeng did not recognize the test conclusion, method and findings, and believed that the state of the control sample “Xianyu 508” was coated, and that the source of the sample was unknown. The Court of First Instance accepted said test report released by Henan Zhongnong Testing Technology Co., Ltd., according to which, it held that the involved infringing seeds produced by Integrity infringed the involved new plant variety rights of Denghai, and ordered Integrity to cease the infringement and pay damages of CNY 200,000. Integrity rejected the decision and appealed to the SPC, claiming that the identification opinion was not credible on the grounds that the standard sample was provided by Denghai, and requested instead that the standard sample kept by the Seed Storage Center of the Ministry of Agriculture and Rural Affairs shall be applied. The *Identification Report on Agricultural Plant Variety Distinctness* commissioned by the Shanxi Seed Management Station to the DUS Headquarters of the Ministry of Agriculture and Rural Affairs proved that the disputed infringing “Integrity No.1” and “Xianyu 508” were different varieties, but the Court of First Instance

ignored this evidence and directly accepted the DNA test results presented by Denghai, which led to unclear facts. Judicial review was not allowed by the Court of First Instance, depriving the rights of Integrity. On October 21, 2021, the SPC reversed the original judgment and remanded for retrial.

### **【裁判意见】**

#### **[Judge's Opinion]**

最高人民法院二审认为，当事人就专门性问题单方自行委托专业机构或者个人出具的书面意见，虽然不属于民事诉讼法所称的由人民法院经由司法鉴定程序所获得的鉴定意见，但法律并未排除其作为证据的资格。对一方当事人就专门性问题自行委托有关机构或者人员出具的意见，一般可参照法律和司法解释关于鉴定意见的审查规则和准用私文书证的质证规则，结合具体案情，对其证明力从严进行审查。依据《最高人民法院关于知识产权民事诉讼证据的若干规定》第二十三条以及《最高人民法院关于民事诉讼证据的若干规定》第四十条第一款、第四十条第四款、第四十一条的规定，如自行委托取得的书面意见由具有相应资格的机构和人员作出、检测程序合法、对照样品来源可靠、检测方法科学，经质证对方未提出足以反驳的相反证据，一般可以确认其证明力。但是如果经审查，该意见存在程序严重违法、对照样品来源不明等重大错误，或者当事人提交了足以推翻意见的相反证据的，人民法院可不予采信。

In the second instance, the SPC held that although the written opinion on specialized matters issued by professional institutions or individuals unilaterally commissioned by the party is not recognized as expert opinion obtained by the people's court through judicial review procedures as referred to in the Civil Procedure Law, it still qualifies as evidence in law. For the opinion on specialized matters issued by a relevant institution or individual that a party has commissioned unilaterally, generally, the review rule in the law and judicial interpretation regarding testing opinions and cross-examination rule with respect to the use of private documentary evidence, consists of a strict review of the probative value of the opinion in combination with specific case facts. Pursuant to Article 23 of the *Provisions of the Supreme People's Court on Evidence in Civil Procedures Involving Intellectual Property Rights*, and Articles 40(1), 40(4) and 41 of the *Provisions of the Supreme People's Court on Evidence in Civil Procedures*, where written opinion is made by an institution or individual in possession of corresponding qualifications, with legal testing procedures, and control samples of reliable sources, and the other party fails to submit rebuttal evidence upon cross-examination, its probative value can generally be affirmed. However, if after examination, in the event that there is serious procedural violation, control samples of unknown sources or

other major errors in the opinion, or the other party submitted evidence that suffices to overturn the opinion, the opinion can not be accepted by the people's court.

本案中,登海公司单方委托河南中农检测技术有限公司出具的检验报告存在对照样品无样品编号、未注明对照样品来源等问题,无法确认是否为审定品种的标准样品,检验结论存在明显疑点。诚信公司、玉丰公司一审中已明确对此提出异议,主张涉案检验报告不能作为认定事实的依据。一审法院未就此进行核实而径行确认该证据效力,在此基础上作出的一审判决属认定基本事实不清,应在重新审理中予以纠正。

In this case, in the inspection report released by Henan Zhongnong Testing Technology Co., Ltd. unilaterally commissioned by Denghai, there are some problems causing obvious doubts to the test conclusion. It cannot be determined whether the control sample is a standard example of the approved variety as there is no sample number given and no indication of the source of the control sample. In the first instance, Integrity and Yufeng raised objection, claiming that the involved test report could not be used as the basis for determining the facts. The Court of First Instance directly confirmed the validity of the evidence without verification. A judgment made on unclear basic facts should be corrected in a retrial.

## 四、集成电路布图设计案件

### IV. Integrated Circuit Layout-Design Cases

#### 34. 集成电路布图设计专有权被撤销时侵权案件的处理

##### **Treatment of infringement cases when exclusive rights to integrated circuit layout designs are revoked**

##### **【裁判要旨】**

##### **[Judgment Digest]**

侵害集成电路布图设计专有权纠纷案件中，涉案集成电路布图设计专有权被撤销，权利人据以提起诉讼的权利基础处于不确定状态的，人民法院可以裁定驳回起诉，并允许权利人在有证据证明撤销涉案集成电路布图设计专有权的行政决定被生效判决撤销后另行起诉。

In the case of infringement on exclusive rights to integrated circuit layout designs, wherein the exclusive rights to integrated circuit layout designs are revoked, and the basis of the rights enjoyed by the right holder to file a lawsuit is uncertain, people's courts may rule to dismiss the lawsuit and allow the right holder to file a separate lawsuit after providing evidence to prove that the administrative decision to revoke the involved exclusive rights to

integrated circuit layout designs is rescinded by an binding judgment.

**【关键词】**

**[Keywords]**

集成电路布图设计 侵权 专有权撤销 裁定驳回起诉  
另行起诉

integrated circuit layout designs; infringement;  
revoke of exclusive rights; rule to reject the lawsuit;  
separately file a lawsuit

**【案号】**

**[Case Number]**

(2021) 最高法知民终 1313 号  
(2021) SPC IP Civil Final 1313

**【基本案情】**

**[Case Facts]**

在上诉人深圳市天微电子股份有限公司（以下简称天微公司）与被上诉人深圳市鑫天胜科技有限公司（以下简称鑫天胜公司）、无锡中微爱芯电子有限公司（以下简称中微爱芯公司）侵害集成电路布图设计专有权纠纷案中，天微公司是登记号为BS.095006249的集成电路布图设计（以下简称涉案布图设计）专有权的权利人。天微公司调查发现鑫天胜公司销售的采购自中微爱芯公司的芯片，复制了天微公司的涉案布图设计，故诉至广东

省深圳市中级人民法院（以下简称一审法院），要求鑫天胜公司、中微爱芯公司停止侵害并赔偿损失。一审法院经审理认为，天微公司请求保护的涉案布图设计专有权已被国家知识产权局撤销，天微公司丧失了提起本案诉讼的权利基础，故裁定驳回天微公司的起诉。天微公司不服，向最高人民法院提起上诉。最高人民法院于2021年9月7日裁定驳回上诉，维持原裁定。

In the case of infringement of exclusive rights to integrated circuit layout designs between the appellant Shenzhen Titan Micro Electronics Co., Ltd. (“Titan Micro”), the appellee Shenzhen Xintiansheng Technology Co., Ltd. (“Xintiansheng”) and Wuxi I-core Electronics Co., Ltd. (“I-core”), Titan Micro is the right holder of the exclusive rights to integrated circuit layout designs (the involved layout designs) with registration no. BS.095006249. Titan Micro filed a lawsuit in Shenzhen Intermediate People's Court (the Court of First Instance), finding that chips sold by Xintiansheng, which were purchased from I-core, copied the involved layout designs, and so requested Xintiansheng and I-core to cease the infringement and pay damages. The Court of First Instance maintained that the exclusive rights to integrated circuit layout designs that Titan Micro claimed to protect had been revoked by China National Intellectual Property Administration, so Titan Micro lost the basis of rights to file this lawsuit. Hence, it ruled to reject

Titan Micro's lawsuit. Titan Micro rejected the decision and appealed to the SPC. On September 7, 2021, the SPC rejected the appeal and upheld the original judgment.

### **【裁判意见】**

#### **[Judge's Opinion]**

最高人民法院二审认为，首先，天微公司以其享有的涉案布图设计专有权向人民法院提起诉讼，但本案一审期间，该集成电路布图设计专有权已被国家知识产权局撤销。尽管天微公司在法律规定期限内就国家知识产权局的行政决定提起诉讼，但其权利基础仍处不确定状态，如该行政决定最终未被生效裁判撤销，则涉案布图设计专有权将被视为自始不存在，从而丧失起诉的权利基础。其次，天微公司起诉鑫天胜公司、中微爱芯公司侵害其集成电路布图设计专有权，在权利基础状态不确定的情况下，若中止侵权诉讼，该案可能长期处于悬而未决的状态。最后，侵害集成电路布图设计专有权纠纷亦属知识产权纠纷范畴，在涉案布图设计专有权被撤销的情况下，可参照专利侵权诉讼中专利权被宣告无效后的处理方式，裁定驳回天微公司的起诉。如果撤销涉案布图设计专有权的行政决定随后被生效的行政判决撤销，涉案布图设计专有权的权利状态明确稳定，则天微公司可另行起诉，并不会对天微公司的合法权利造成严重损害。

In the second instance, the SPC held that, firstly, Titan Micro filed a lawsuit in the people's court for its exclusive rights to the

involved layout design, but at the time of the first instance of this case, the exclusive rights to the integrated circuit layout designs had been revoked by China National Intellectual Property Administration. Although Titan Micro filed a lawsuit against the administrative decision made by China National Intellectual Property Administration within the time limit prescribed by law, the basis of its rights is still uncertain. If the administrative decision is not eventually revoked by binding judgment, the exclusive rights to the involved layout design is void ab initio, thus losing the basis of its right to prosecution. Secondly, Titan Micro filed a lawsuit against Xintiansheng and I-core for infringement of its exclusive rights to the integrated circuit layout designs. In the case of uncertain basis of the rights, if the infringement lawsuit is suspended, the case may be pending for a long time. Finally, since the dispute over the infringement of the exclusive rights of circuit layout design is also recognized as an intellectual property rights dispute, in the case where the exclusive rights of the involved layout design are revoked, the lawsuit of Titan Micro is rejected due to the handling of the patent infringement lawsuit, in which the patent right has been declared to be void. If the administrative decision to revoke the exclusive rights of the involved layout design is subsequently revoked by valid administrative judgment, and the status of the

exclusive rights of the involved layout design is clear and stable, Titan Micro can file a separate prosecution, which will not cause serious damage to the legitimate rights of Titan Micro.

### 35. 芯片量产技术委托开发合同中开发方履约情况的认定

#### **Assessment on developers' performance of the technology**

#### **development contracts on mass production of chips**

#### **【裁判要旨】**

#### **[Judgment Digest]**

涉及芯片量产的技术委托开发合同纠纷案件中，应当根据合同约定，结合量产芯片研发领域的技术研发特点和产业实践惯例认定开发任务完成情况。有关合同明确约定以量产芯片为研发目标，但未明确约定全部研发任务详细内容的，原则上应当以完成晶圆材料制造、集成电路制造、芯片封装测试，且晶圆测试、封装测试合格，作为认定完成全部研发任务的标准。鉴于集成电路制造是整个技术开发流程中难度最高、步骤最多、投资最大的主要环节，亦鉴于晶圆测试合格后，有关芯片封装测试可以另行开展故开发方完成了集成电路设计、样片制造且晶圆测试合格，但未完成芯片封装测试的，可以认定其完成了主要研发任务。

In the case of technology development contract on mass production of chips, completion of development shall be determined

in accordance with the contract, in combination with the technical research and development aspects in the field of mass production of chips. Where the relevant contract explicitly agrees that mass production of chips is the goal of the research and development process, but does not explicitly determine the details of all of the research and development phases, in principle, completion of wafer fabrication, integrated circuit manufacturing, and final stage testing, as well as passing chip probing, shall be identified as the standard for completing all research and development phases. Given that integrated circuit manufacturing is the most difficult and complicated part and the largest investment in the entire technology development process, and also given that final stage testing can be carried out separately after passing chip probing, the developer who has completed the integrated circuit design, prototype manufacturing and passed chip probing but has not completed final stage testing, can be considered to have completed the main research and development phase.

**【关键词】**

**[Keywords]**

集成电路 委托开发合同 芯片量产 履约认定 违约责任

integrated circuit; commissioned development contract; mass production of chips; identification of performance; liability for

breach of contract

**【案号】**

**[Case Number]**

(2020) 最高法知民终 394 号

(2021) SPC IP Civil Final 394

**【基本案情】**

**[Case Facts]**

在上诉人泰凌微电子（上海）股份有限公司（以下简称泰凌公司）与被上诉人深圳市星火原光电科技有限公司（以下简称星火原公司）集成电路委托开发合同纠纷案中，星火原公司与泰凌公司于 2014 年 6 月 5 日签订了《技术开发合同》，约定星火原公司委托泰凌公司通过 COMS 技术设计空调专用微处理器控制芯片。2014 年 6 月 9 日，双方签订补充协议《专用集成电路产品委托开发设计合同》（以下简称涉案合同），约定合同金额总计 441 万元，其中包括设计开发费用 386 万元，星火原公司支付 265 万元后，泰凌公司交付流片，经检测星火原公司认为其不符合产品规格定义书要求。星火原公司向上海知识产权法院（以下简称一审法院）提起诉讼，请求解除星火原公司与泰凌公司签订的涉案合同，泰凌公司返还星火原公司产品开发费用，泰凌公司赔偿星火原公司高价采购其它替代芯片损失。泰凌公司一审反诉请求，星火原公司向泰凌公司支付应付而未付的阶段性合同款及其利息。一审法院认定，泰凌公司交付的阶段性成果不符合相应阶段

开发需求的约定，构成根本违约，一审法院判决解除涉案合同，泰凌公司返还已支付合同款并赔偿经济损失。泰凌公司不服，向最高人民法院提起上诉。最高人民法院于 2021 年 11 月 1 日判决驳回上诉，维持原判。

In the case of the commissioned development contract for integrated circuit between the appellant Telink Microelectronics (Shanghai) Co., Ltd. (“Telink”) and the appellee Xinghuoyuan Photoelectric Technology Co., Ltd. (“Xinghuoyuan”), Xinghuoyuan and Telink signed the *Technology Development Contract* on June 5, 2014, agreeing that Xinghuoyuan commissioned Telink to design a microprocessor control chip for air conditioners using COMS technology. On June 9, 2014, the parties signed a supplemental agreement, *Commissioned Development Design Contract for Specialized Integrated Circuit Products* (the involved contract), agreeing that the total contract value was CNY 4.41 million, including design and development costs of CNY 3.86 million. After being paid for CNY 2.65 million, Telink delivered Tape Out. Upon testing, Xinghuoyuan determined that they failed to meet the requirements of the product description. Xinghuoyuan filed a lawsuit in Shanghai Intellectual Property Court (the Court of First Instance), requesting to rescind the involved contract with Telink, and requested that Telink shall return product development expenses of

Xinghuoyuan and pay damages for its losses in purchasing other replacement chips at a higher price. In the first instance, Telink counterclaimed that Xinghuoyuan shall pay its overdue contract progress payments with interest. The Court of First Instance held that the phased achievements delivered by Telink were not in line with the agreement as they did not meet the development needs of the corresponding phases, constituting a fundamental breach of contract. Therefore, it ruled to rescind the involved contract and ordered Telink to return the completed contract payments and compensate for financial losses. Telink rejected the decision and appealed to the SPC. On November 1, 2021, the SPC rejected the appeal and upheld the original judgment.

### **【裁判意见】**

#### **[Judge's Opinion]**

最高人民法院二审认为，集成电路与集成电路布图设计的法律内涵并不相同，在集成电路技术领域，集成电路、半导体集成电路与集成电路布图设计涵义亦不相同，半导体集成电路中包含的知识产权客体除了集成电路布图设计外，还包括因基片生产、电路集成等而获得的技术秘密或者专利权等。而集成电路布图设计的法律内涵系专指体现在集成电路中的三维配置或者为制造集成电路而准备的三维配置。由于在半导体集成电路领域，研发能够实现量产的芯片技术成果，需要经过集成电路设计、制造

(包括硅片制造、晶圆制造)、封装测试等才能最终应用到终端产品中。集成电路芯片并不是一个可以独立存在的元件个体，其必须经过与其它元件系统互连，才能发挥整体系统功能，集成电路封装作为半导体开发的最后一个阶段，不仅起着物理包裹、固定密封、保护芯片和增强电热性能的作用，而且还是芯片内部世界与外部电路沟通的桥梁。因此，开发方应当完成集成电路设计、制造、封装测试各阶段研发任务，晶圆测试(Chip Probing)、封装测试(Final Test)均符合合同约定后，才能实现委托方芯片量产的合同目的，任何一个阶段的任务未能完成，均应当认定开发方未能交付符合合同目的芯片技术成果。对于开发方是否完成阶段性研发任务的认定，要考量集成电路制造作为芯片研发过程中技术最复杂且资金投入最多的制程，包含了集成电路设计、样片制造主要研发任务，此阶段任务完成，晶圆测试合格，意味着主要的芯片制造流程结束，而之后的封装测试，属于可以独立于集成电路制造单独进行研发的技术阶段，封装测试亦属于芯片进入量产前的独立测试内容。因此，如果开发方完成了集成电路设计、样片制造相关研发任务，委托方已经具备了单独或者委托他人继续完成封装测试阶段研发任务的技术条件，开发方应当向委托方支付相应的研发费用。由于专用集成电路委托开发合同的研发内容中既包括常规技术参数要求，又包括委托方为解决专门技术问题而设定的特定技术参数要求，如果特定技术参数未能达到产品规格定义书的要求，应当首先审查特定技术参数是否满足要求，

如果特定技术参数未能达到产品规格定义书的要求, 开发方通过后续改进仍然不能达到要求, 意味着开发方没有完成主要研发任务, 此时, 可以直接认定开发方未能完成相关集成电路制造阶段研发任务; 如果特定技术参数已经达到产品规格定义书的要求, 仅是常规技术参数未能满足产品规格定义书要求, 说明开发方已经具备完成主要研发任务的技术条件, 那么应当根据未达标常规技术参数所占产品规格定义书技术参数的比例、通过金属层修改解决的难易程度等, 综合判断开发方是否实质完成相关集成电路制造阶段研发任务。

In the second instance, the SPC held that the legal connotation of integrated circuits is not identical to that of integrated circuit layout designs. Integrated circuits, semiconductor integrated circuits and integrated circuit layout designs each have different meanings in the field of integrated circuit technology. In addition, intellectual property contained in semiconductor integrated circuits not only include integrated circuit layout designs, but also technical secrets or patent rights obtained from substrate production, and circuit integration, etc. However, the legal connotation of the integrated circuit layout designs refers exclusively to either the three-dimensional configuration embodied in the integrated circuits or the three-dimensional configuration prepared for the integrated circuit manufacturing. In the field of semiconductor integrated circuits, the

research and development of technology for the mass production of chips can eventually be achieved through integrated circuit design, which includes manufacturing (including silicon wafer manufacturing and wafer fabrication), packaging and final stage testing of integrated circuit chips before they can be applied to the final product. Integrated circuit packaging, as the final stage of semiconductor development, not only plays a role in physically wrapping, fixing, sealing, protecting the chip and enhancing the electrical and thermal properties, but also acts as bridge between the internal world of the chip and the external circuit. Hence, after the integrated circuit design, manufacturing, final stage testing and other research and development phases are completed, and chip probing and final stage testing are conducted in line with the contract, the developer can achieve the contractual purpose of mass production of chips as commissioned by the client. Where there is failure to complete any phases of the task, the developer shall be determined as having failed to technically deliver the chip in line with the contractual purpose. When determining whether the developer has completed the research and development phases, it shall be considered that integrated circuit manufacturing, as the most complicated manufacturing process with the largest investment in research and development, includes the main research and

development tasks, namely, integrated circuit design and prototype manufacturing. The completion of this phases and the passing of chip probing marks the end of the main chip manufacturing process, while the subsequent final stage testing is a technical stage independent of integrated circuit manufacturing, and is an independent test before mass production. Therefore, if the developer has completed the research and development tasks related to integrated circuit design and prototype manufacturing, the client has the technical conditions to complete the final stage testing phase of research and development individually or by commissioning others, then the client shall pay the corresponding research and development fees to the developer. As the commissioned development contract for specialized integrated circuit includes both conventional technical parameter requirements and further specific technical parameter requirements set by the client for the purpose of solving the specialized technical problems, if the specific technical parameters fail to meet the requirements of the product description, whether the specific technical parameter meets the requirements shall be examined first; and if the developer still cannot meet the requirements through subsequent improvements, the developer has not completed the main research and development stage. At this point, it can be directly determined that the developer has failed to

complete the research and development for relevant integrated circuit manufacturing. If the specific technical parameter has reached the requirements of the product description, but the regular technical parameter fails, the developer has the technical conditions to complete the main research and development stage, and it shall be comprehensively determined whether the developer has substantially completed the research and development phase of relevant integrated circuit manufacturing, on the basis of the proportion of the regular technical parameter that fails to meet the requirements to the technical parameters defined in the product description, the difficulty of solving the problem through metallic layer modification, etc.

本案中，泰凌公司作为开发方仅向星火原公司交付了涉案合同约定的第3阶段技术成果，即用于进行检测的流片。星火原公司经过检测提出存在的问题后，泰凌公司仅认可相关问题通过金属层修改可以解决，但是没有进一步提交金属层修改之后的样片后双方成讼。显然，泰凌公司并未履行完成涉案合同约定的第5、6阶段工作任务，即涉案集成电路设计、封装测试阶段研发任务均未完成，星火原公司无法通过其提交的流片实现芯片量产，故应当认定泰凌公司未能交付符合合同约定的最终技术成果。泰凌公司交付的流片未能满足涉案合同规格定义书约定的LCD特定技术参数要求，而实现上述LCD特定技术参数要求是星火原公

司委托研发涉案空调专用集成电路的主要目的,应当认定泰凌公司没有完成涉案合同的主要研发任务。

In this case, Telink, as the developer, only delivered the technical achievement of the third stage stipulated in the contract, i.e., the Tape Out for test, to Xinghuoyuan. After Xinghuoyuan raised the issues upon testing, Telink only recognized that the relevant problems could be solved through metallic layer modification, but did not submit a further prototype after the metallic layer modification, resulting in the two sides filing a lawsuit. Obviously, Telink failed to complete work tasks of the fifth and sixth stages defined in the contract, i.e., the integrated circuit design and final stage testing, and Xinghuoyuan failed to realize the mass production of chips through the Tape Out submitted by Telink, thus it shall be determined that Telink failed to deliver the final technical achievement in compliance with the contract. The Tape Out delivered by Telink fails to meet LCD-specific technical parameters defined in the description of the involved contract, and the research and development commissioned by Xinghuoyuan aimed at realizing the LCD specific technical parameters is the main purpose of the involved specialized integrated circuit for air conditioners. Hence, it shall be deemed that Telink has failed to

complete the main research and development stage of the involved contract.

## 五、技术秘密案件

### V. Technical Secret Cases

#### 36. 计算机软件技术秘密的保护对象及其证明

##### **Subject matter of technical secrets concerning computer software and its standard of proof**

##### **【裁判要旨】**

##### **[Judgment Digest]**

计算机软件的源代码与流程、逻辑关系、算法等内容一般构成相对独立的技术信息。当事人主张计算机软件的源代码和与源代码对应的流程、逻辑关系、算法均构成技术秘密的，应当分别明确请求保护的具体技术信息并分别证明其符合法律保护条件。

In general, the source code and such factors as process, logic relation and algorithm of computer software constitute mutually independent technical information. Where a party claims that the source code of computer software and its corresponding process, logic relation and algorithm both constitute technical secrets, it

should separately specify the specific technical information for protection and present different sets of evidence to the effect that each of such information meets the legal conditions for protection.

**【关键词】**

**[Keywords]**

技术秘密 侵权 计算机软件 源代码 流程 逻辑关系 算法

technical secrets; infringement; computer software; source code; process; logic relation; algorithm

**【案号】**

**[Case Number]**

(2020) 最高法知民终 1472 号

(2020) SPC IP Civil Final 1472

**【基本案情】**

**[Case Facts]**

在上诉人北京龙软科技股份有限公司（以下简称龙软公司）与被上诉人北京元图智慧科技有限公司（以下简称元图公司）、刘桥喜、卢本陶、王平、熊伟、贲旭东侵害商业秘密纠纷案中，龙软公司认为，刘桥喜、熊伟、王平、贲旭东、卢本陶曾于 2004 年至 2013 年 9 月期间在龙软公司任职，均在任职期间参与了部分关键软件技术的研发，接触到了龙软公司的核心技术秘密和经营秘密后上述员工陆续从龙软公司处离职，加入元图公司。龙软公司注意到元图公司在一些矿山软件招投标项目中利用了上述员工从

龙软公司处获取的技术秘密和经营秘密,致使龙软公司遭受了重大的经济损失和名誉损失,故向北京知识产权法院(以下简称一审法院)提起诉讼,请求判令被诉侵权人停止侵害、消除影响、赔偿损失 100 万元。一审法院认为,在案证据不足以证明被诉侵权人实施了侵害涉案商业秘密的行为,驳回龙软公司的诉讼请求。龙软公司不服,向最高人民法院提起上诉,主张一审法院遗漏龙软公司请求鉴定的第三至二十二项秘密点的流程、逻辑关系、算法等比对内容,比对方法有误,请求撤销原判,支持龙软公司的全部诉讼请求或者发回重审。最高人民法院于 2021 年 12 月 20 日判决驳回上诉,维持原判。

In the case over the infringement of trade secrets between the appellant Beijing Longruan Technologies Inc. (“Longruan”) and the appellees Beijing Yuantu Smart Technology Co., Ltd. (“Yuantu”), Liu Qiaoxi, Lu Bentao, Wang Ping, Xiong Wei and Ben Xudong, Longruan claimed that Liu Qiaoxi, Xiong Wei, Wang Ping, Ben Xudong and Lu Bentao participated in the research and development of some key software technologies and were accessible to its core technical and trade secrets when they worked for Longruan from 2004 to September of 2013. Later, they left Longruan one after another and joined Yuantu. Longruan found that Yuantu had made use of the technical and trade secrets obtained from Longruan by the aforesaid employees in some bidding projects concerning mining

software, as a result, Longruan suffered a significant loss to its economy and reputation. Hence, Longruan filed a lawsuit in Beijing Intellectual Property Court (the Court of First Instance), requesting that the accused infringer be ordered to cease the infringement, eliminate the influence and pay damages of CNY 1 million for losses. The Court of First Instance held that the current evidence was insufficient to prove that the accused infringer infringed the disputed trade secrets and rejected Longruan's pleadings. Not satisfied with the first-instance judgment, Longruan appealed to the SPC to revoke the first-instance judgment and support its claims or send the case back to the first-instance court for a retrial on the grounds that the Court of First Instance omitted the process, logic relation, algorithm and other comparative contents incorporated in the 3rd to 22nd secret points that Longruan requested to identify and adopted the wrong comparison method. On December 20, 2021, the SPC rejected the appeal, and upheld the original judgment.

### **【裁判意见】**

#### **[Judge's Opinion]**

最高人民法院二审认为，从技术秘密角度而言，计算机软件的流程、逻辑关系、算法和计算机软件源代码存在如下关系：首先计算机软件的流程、逻辑关系、算法是计算机软件源代码的基础，源代码是对流程、逻辑关系、算法内容的具体实现和表达。

同一流程、逻辑关系、算法可通过不同的编程语言的源代码甚至同一编程语言的不同源代码进行表达。正因为如此，对源代码本身采取保密措施并不一定意味着该源代码所包含的流程、逻辑关系、算法信息必然也被采取了保密措施；在计算机技术领域中，大量经典算法对技术人员而言是一般常识，源代码具有秘密性也不必然推知其承载的“流程、逻辑关系、算法”信息一定不为公众所知。其次，一段软件源代码所包含的流程、逻辑关系可能是纷繁复杂的，也可能涉及多个逻辑关系、多个算法，甚至可能是多流程、多逻辑相互嵌套的，加之流程、逻辑关系、算法本身是高度抽象的，故即使一段软件源代码承载了特定流程、逻辑关系、算法信息，该源代码本身也并不一定能直观地体现该流程、逻辑关系、算法信息。总之，技术秘密的本质是技术信息，在计算机软件中，虽然流程、逻辑关系、算法等内容与软件源代码本身在一定程度上存在相互表征的关系，但从技术角度而言，二者依旧是互为独立的技术信息。

The SPC held in the second instance that, in terms of the technical secrets, the relationship among the process, logic relation, algorithm and source code of the computer software is described as follows: firstly, the process, logic relation and algorithm of the computer software are the basis of the source code of the computer software, and such source code is the concrete realization and expression of that process, logic relation and algorithmic. The same

process, logic relation and algorithm can be expressed through source code of different programming languages or even through different source codes of the same programming language. For this reason, taking measures to keep secret the source code does not mean that same measure have been taken for the process, logic relation and algorithm as contained in the source code, and in the field of computer technology, a large number of classical algorithms are common knowledge to technicians. So, reference is not inevitably made that the "process, logic relation and algorithm" as contained in the confidential source code is not known to the public. Secondly, the process and logic relation as contained in a piece of software source code is likely to be complicated, involve multiple logic relations or algorithms, and even nested one with another process and logic. In addition, the process, logic relation and algorithm are highly abstract in themselves. Therefore, even if a piece of software source code contains a specific process, logic relation and algorithmic information, it might not reflect the process, logical relation and algorithmic information directly in itself. In conclusion, the essence of technical secrets is technical information. Although, to some extent, the process, logic relation and algorithm of the computer software and the software source code can mutually characterize each other, from the technical perspective, they are still

**independent technical information.**

作为商业秘密的技术信息必须具有商业价值,能够为权利人带来竞争优势。对计算机软件的“流程、逻辑关系、算法信息”技术秘密而言,这些信息虽不能像源代码一样直接复制、使用,但能够用来指导软件开发工作。精心设计的“流程、逻辑关系、算法信息”能够降低软件中的运算量,占用更少计算机系统资源有效提高软件系统稳定性及运行维护效率。正因为“流程、逻辑关系、算法”信息的价值体现在它作为具体软件开发的基础和指导,故商业秘密侵权纠纷案件中,对此类信息具体内容的说明需要达到对所属技术领域的人或者说对软件设计和开发人员而言足够清楚,能够依据其设计开发对应软件功能的程度,否则无法知晓权利人主张的具体权利对象。同时,权利人还应当对相关信息的来源承担举证责任。就计算机软件的“流程、逻辑关系、算法”信息而言,权利人可以提供直观的证据,如己方工作中形成开发设计文档、软件设计说明书等。权利人也可以提供软件源代码作为信息载体证据,但由于源代码本身并不一定能直观地体现该“流程、逻辑关系、算法”信息,此时则需要权利人具体说明“流程、逻辑关系、算法”信息如何从源代码中得以体现,以完成其举证责任,否则无法证明相关信息的来源和权属。本案中,龙软公司始终未对其所称秘密点三至二十二所涉及的流程、逻辑关系、算法进行过明确、具体的说明,未明确其主张的权利对象;更未对相关技术信息的来源进行初步举证,故相关鉴定结论及一

审判决未涉及上述流程、逻辑关系、算法并无不当。

Technical information as a trade secret must have commercial value and can offer competitive advantages to its owner. With respect to the technical secrets of computer software, such as process, logic relation and algorithmic information, although such information cannot be directly reproduced and used like source code, it can be used to guide the software development. Well-designed "process, logical relation and algorithm" can reduce the amount of computation in the software, occupy fewer computer system resources and effectively improve the stability of the software system and the efficiency of operation and maintenance. As the value of "process, logic relation and algorithm" is to be the basis and guidance of specific software development, in the case over infringement of trade secrets, it is expected to illustrate such information to the extent that it is clear enough for those in the filed orthose of software designers and developers and such information can be used as the basis of designing and developing corresponding software functions. Otherwise, it is impossible for others to know the rights claimed by the owner. At the same time, the right holder should bear the burden of proof on the sources of relevant information. Regarding the "process, logic relation and algorithm" of the computer software, the right holder can present direct evidence,

such as development and design documents formed in the course of its own work, software design descriptions and others. The right holder can also present the evidence to the effect that the source code is the information carrier. But since the source code cannot visually reflect the "process, logic relation and algorithm", the right holder needs to specify how they are reflected in the source code to support its claims. Otherwise, the source and ownership of relevant information cannot be proved. In this case, Longruan fails to explicitly and specifically explain the process, logic relation and algorithm in the claimed 3rd to 22nd secret points and to clarify the subject of the claimed right, and it also fails to offer preliminary evidence to prove the source of relevant technical information. Therefore, it is appropriate that the relevant identification conclusion and the original judgment do not involve the aforementioned process, logic relation and algorithm.

### 37. 约定保密期限届满后的保密义务

#### **Confidentiality obligation after expiration of the agreed**

#### **confidentiality period**

#### **【裁判要旨】**

#### **[Judgment Digest]**

技术秘密许可合同约定的保密期限届满, 除非另有明确约定一般仅意味着被许可人的约定保密义务终止, 但其仍需承担侵权法上普遍的消极不作为义务和基于诚实信用原则的后合同附随保密义务。

Unless otherwise expressly agreed, the expiration of the confidentiality period agreed upon in a technical secret licensing contract generally only means that the licensee's agreed confidentiality obligation has come to an end, but the licensee still bears the obligation under the tort law to refrain from certain acts and the post-closing confidentiality obligation under good-faith principle.

**【关键词】**

**[Keywords]**

技术秘密 侵权 约定保密期限届满 保密义务

technical secrets; infringement; expiration of the agreed confidentiality period; confidentiality obligations

**【案号】**

**[Case Number]**

(2020) 最高法知民终 621 号

(2020) SPC IP Civil Final 621

**【基本案情】**

**[Case Facts]**

在上诉人石家庄泽兴氨基酸有限公司（以下简称泽兴公司）河北大晓生物科技有限公司（以下简称大晓公司）与被上诉人北京君德同创生物技术股份有限公司（以下简称君德同创公司）侵害技术秘密纠纷案中，君德同创公司就其研发的饲料级胍基乙酸产品的生产工艺即“甘氨酸-单氰胺法”采用技术秘密予以保护，且与可以接触相关技术信息的员工签订了《保密协议》。2010年6月，君德同创公司与泽兴公司分别签订《关于北京君德同创与石家庄泽兴氨基酸公司联合开发胍基乙酸项目的战略合作协议》（以下简称战略合作协议）、《委托加工协议》（以下简称加工协议），约定泽兴公司为君德同创公司加工饲料级胍基乙酸产品，未明确约定泽兴公司使用相关技术信息的期限，但约定了合同期限和保密期限，即合同有效期三年，双方协商同意，可以书面补充协议方式延长协议期限；合作期内及双方合作结束后三年内，泽兴公司必须对双方合作有关的销售数据、技术信息等进行保密不得向任何人泄漏任何相关资料。2014年6月，君德同创公司委托泽兴公司生产最后一批饲料级胍基乙酸，双方合作终止。2016年3月10日，君德同创公司发现泽兴公司将胍基乙酸作为饲料添加剂生产、经营、使用、宣传并销售给用户。2016年下半年始，君德同创公司发现大晓公司在对外宣传、参加展会，销售饲料级胍基乙酸产品时，宣称其生产工艺来自于君德同创公司、泽兴公司或者与之有关。君德同创公司认为泽兴公司、大晓公司侵害其技术秘密，故向河北省石家庄市中级人民法院（以下简称一审法

院) 提起诉讼, 请求判令其停止侵害并赔偿经济损失及维权合理开支 1067 万元。一审法院认为, 泽兴公司、大晓公司的行为均构成对君德同创公司涉案技术秘密的使用和披露, 判决泽兴公司、大晓公司停止侵害并共同赔偿经济损失及维权合理开支共计 50 万元。泽兴公司、大晓公司不服, 向最高人民法院提起上诉。最高人民法院于 2021 年 12 月 18 日判决维持原判关于损害赔偿的判项, 改判原判关于停止侵害的判项。

In the case on technical secrets misappropriation between the appellants Shijiazhuang Zexing Amino Acid Co., Ltd. (“Zexing”), Hebei Daxiao Biotechnology Co., Ltd. (“Daxiao”) and the appellee Beijing Gendone Biotechnology Co., Ltd. (“Gendone”), the production process of its independently developed feed-grade glycoamine products (namely, "glycine-cyanamide method") is protected by Gendone as the technical secrets and the Non-disclosure Agreement with the employees who were accessible to relevant technical information is also signed. In June 2010, Gendone and Zexing signed the *Strategic Cooperation Agreement on the Joint Development of Glycoamine Project by Beijing Gendone and Shijiazhuang Zexing Amino Acid Co., Ltd.* (the Strategic Cooperation Agreement) and the *Commissioned Processing Agreement* (the Processing Agreement), stipulating that Zexing would process feed-grade glycoamine products for Gendone. Such agreements did not

state the period of allowing Zexing to use relevant technical information, but state the term of validity and confidentiality. In other words, the term of validity of such agreements is three years and it could be extended by signing another written agreement. During the period of cooperation and within three years after the end of such period, Zexing must keep in secrecy the sales data, technical information and others in relation to the mutual cooperation and should not disclose any relevant information to anyone. In June 2014, Gendone commissioned Zexing to produce the last batch of feed-grade glycoyamine, and their cooperation came to an end. On March 10, 2016, Gendone found that Zexing produced, operated, used, advertised and sold glycoyamine to users as a feed additive. As from the second half of 2016, Gendone found that Daxiao claimed that its production process originated from or was related to Gendone and Zexing at the time of promoting, participating in exhibitions and selling feed-grade glycoyamine products. Gendone filed a lawsuit in Shijiazhuang Intermediate People's Court of Hebei province (the Court of First Instance) on the grounds that Zexing and Daxiao infringed its technical secrets, requesting the court to order Zexing and Daxiao to cease the infringement and compensate damages of CNY 10.67 million for economic losses and reasonable expenses for protection of rights. The Court of First Instance held

that the act committed by Zexing and Daxiao constituted the use and disclosure of the disputed technical secrets of Gendone, so it ordered Zexing and Daxiao to cease the infringement and jointly pay damages of CNY 500,000 for economic losses and reasonable expenses for protection of rights. Not satisfied with the first-instance judgment, Zexing and Daxiao appealed to the SPC. On December 18, 2021, the SPC upheld the amount of damages and dismissed the cessation of the infringement as contained in the original judgment.

### **【裁判意见】**

#### **[Judge's Opinion]**

最高人民法院二审认为，对于技术许可使用合同约定的保密期限届满后，被许可人是否仍负有保密义务的问题，由于技术许可合同首先遵循当事人意思自治原则，如果合同中明确约定保密期限届满后，被许可人可以许可他人使用、披露相关商业秘密，则被许可人实施上述行为不构成侵害商业秘密；如果技术许可合同并未明确约定保密期限届满后，被许可人可以许可他人使用、披露相关商业秘密，则需要根据双方签订合同的目的、双方的权利义务、合同对价、合同履行情况、商业惯例及诚信原则等，综合判断保密期限届满后，被许可人是否可以许可他人使用、披露相关商业秘密。首先，包括技术秘密在内的商业秘密是民事主体依法享有的知识产权，任何人未经许可不得披露、使用和允许他人使用权利人的商业秘密。商业秘密自产生之日就自动取得，并具

有相对排他性，即同一商业秘密可能由多个权利主体占有；同时商业秘密的保护期限具有不确定性，只要商业秘密不被泄露，就一直受法律保护。技术许可合同约定保密期间，仅代表双方当事人对该期间的保密义务进行了约定，该保密期间届满，虽然合同约定的保密义务终止，但被许可人仍需承担除自己使用以外的保密义务。其次，法律规定的保密义务既包括侵权法意义上的、普遍的消极不作为义务，也包括基于诚实信用原则的合同前、合同中、合同后的保密义务。对于当事人在订立合同过程中知悉的商业秘密，无论合同是否成立，都不得泄露或者不正当地使用，泄露或者不正当地使用该商业秘密给对方造成损失的，应当承担损害赔偿赔偿责任；合同终止后，当事人仍然有保密义务，未尽到保密义务的，应当向对方承担赔偿责任。再次，按照技术许可合同的性质，被许可人仅是获得了使用相关商业秘密的权利，合同中约定有保密期限，也不应当解释为保密期限届满后，受让人和被许可人可以许可他人使用、甚至披露相关商业秘密。因披露商业秘密属于放弃商业秘密民事权利的行为，除非合同中有明确约定，否则该行权处分行为不能由非权利主体作出。技术许可合同中被许可人应当承担的保密义务至少包括：未经许可人同意，不得擅自许可第三人使用相关商业秘密；应当按照合同约定采取保密措施，不应故意或者过失泄露相关商业秘密；对许可人提供或者传授的技术和有关技术资料，应当按照合同约定的范围和期限承担保密义务；对超过合同约定范围和期限仍需保密的技术，应当遵

循诚实信用的原则，履行合同保密的附随义务。

The SPC held in the second instance that, as to the issue of whether the licensee still bears the confidentiality obligations after the confidentiality period as stated in the technology licensing contract expires, since technology licensing contract follows the principle of autonomy of will, if it is explicitly agreed that the licensee can permit others to use and disclose relevant trade secrets after the confidentiality period expires, the aforementioned act committed by the licensee does not constitute the infringement of trade secrets; if it is not explicitly agreed that the licensee can permit others to use or disclose relevant trade secrets after the confidentiality period expires, whether the licensee can permit others to use or disclose relevant trade secrets after the confidentiality period expires should take into considerations the contractual purpose, rights and obligations, consideration, performance, commercial practices and the principle of good faith. Firstly, trade secrets (including technical secrets) are legitimate intellectual property rights owned by civil subjects and their unauthorized disclosure, use and permission to others for use should not be allowed. The right holder automatically owns such trade secrets as of the date of generation and relatively excludes others from owning them. In other words, one trade secret might be owned by more than

one right holder. At the same time, the protection period of trade secrets is uncertain. As long as the trade secrets are not disclosed, they will be protected by law. The agreement on the confidentiality period only means that the confidentiality obligations during the period are mutually agreed upon. Although the mutually agreed-upon confidentiality obligations comes to an end after the confidentiality period expires, the licensee still needs to bear the confidentiality obligations except for its own use. Secondly, the legal confidentiality obligations include the general negative obligation of omission in the sense of tort law and the confidentiality obligations originated based on the principle of good faith before the conclusion, during the performance and after the termination of a contract. Whether the contract is established or not, any contracting party should not disclose or improperly use the trade secrets gained in the course of the conclusion of the contract, and it should be liable for damages if it discloses or improperly uses such trade secret and causes a loss to the contracting counterparty. Thirdly, according to the nature of the technology licensing contract, the licensee is only authorized to use relevant trade secrets, even if the confidentiality period is agreed upon, it should not be interpreted that the assignee and the licensee can permit others to use or even disclose relevant trade secrets after the confidentiality period expires. Unless

otherwise explicitly agreed in the contract, as the disclosure of trade secret means to waive its civil rights, such act cannot be committed by those who are not subjects of rights. According to the technology licensing contract, the licensee should at least bear the following confidentiality obligations: (1) the licensee should not permit a third party to use relevant trade secrets without the consent of the licensor; (2) the licensee should take agreed confidentiality measures and should not intentionally or negligently disclose relevant trade secrets; (3) the licensee should bear the obligation of keeping confidential technologies and technical materials provided or taught by the licensor in accordance with the agreed scope and period; (4) as for the technologies exceeding the agreed scope and period but that still need to be kept in secrecy, the licensee should follow the principle of good faith and fulfill the subordinated confidentiality obligations.

本案中，战略合作协议、加工协议均没有授权泽兴公司在合同约定的保密期限届满后可以许可他人使用、披露涉案技术秘密且根据战略合作协议、加工协议对泽兴公司保密义务和保密期限的约定，泽兴公司未经君德同创公司许可，不得将胍基乙酸出售给除君德同创公司之外的任何第三方，显然，君德同创公司作为涉案技术秘密的权利人通过签订战略合作协议、加工协议，允许泽兴公司使用涉案技术秘密，旨在充分利用涉案技术秘密商业价

值，与泽兴公司实现合作共赢。而泽兴公司提供的在案证据不能证明，战略合作协议、加工协议约定的保密期限届满后，君德同创公司具有允许泽兴公司许可他人使用、披露涉案技术秘密的任何意思表示；亦不能证明泽兴公司为了在保密期限届满后享有与君德同创公司同等的涉案技术秘密权利人权益，支付了相当于涉案技术秘密价值的合理对价。故，泽兴公司在战略合作协议、加工协议约定的保密期限届满后，即 2014 年 6 月君德同创公司与泽兴公司合作终止三年后（2017 年 6 月 30 日后），仅能自己使用涉案技术秘密，不能许可他人使用、披露涉案技术秘密。

In this case, according to *the Strategic Cooperation Agreement* and *the Processing Agreement*, Zexing is not authorized to permit any other parties to use or disclose the disputed technical secrets after the expiration of the mutually agreed-upon confidentiality period, and Zexing should not sell glycoamine to any third party other than Gendone without the authorization of Gendone, so obviously, as the right holder of the disputed technical secrets, Gendone permits Zexing to use the disputed technical secrets by signing *the Strategic Cooperation Agreement* and *the Processing Agreement* with an aim to make full use of the commercial value of the disputed technical secrets and achieve the win-win cooperation with Zexing. The current evidence presented by Zexing fails to prove that Gendone has the intention to allow Zexing to permit any

other parties to use or disclose the disputed technical secrets after the expiration of the confidentiality period mutually agreed-upon in *the Strategic Cooperation Agreement* and *the Processing Agreement* and that Zexing has paid reasonable consideration equivalent to the value of the disputed technical secrets in order to have the same rights and interests in the disputed technical secrets as Gendone after the expiration of the confidentiality period. Therefore, after the confidentiality period mutually agreed-upon in *the Strategic Cooperation Agreement* and *the Processing Agreement* expires (namely three years after the termination of cooperation between Gendone and Zexing in June of 2014 (after June 30, 2017)) Zexing can only use the disputed technical secrets by itself and cannot permit any other parties to use or disclose the disputed technical secrets.

### 38. 非法获取全部技术秘密后对使用技术秘密行为的推定

#### **Presumption on using the technical secrets after the illegal acquisition of all technical secrets**

##### **【裁判要旨】**

##### **[Judgment Digest]**

权利人举证证明被诉侵权人非法获取了完整的产品工艺流

程、成套的生产设备等技术秘密信息或者技术秘密载体，且被诉侵权人已经实际生产出相同产品的，可以根据优势证据规则和日常生活经验，推定被诉侵权人使用了全部技术秘密。

Where the right holder presents evidence to the effect that the accused infringer has illegally acquired the technical secrets or its carrier such as the whole production process or the whole set of production equipment, and the accused infringer has actually produced the same product, it can be presumed according to preponderance of the evidence and daily life experience that the accused infringer has used all technical secrets.

**【关键词】**

**[Keywords]**

技术秘密 侵权 完整工艺流程 成套生产设备 非法获取  
全部使用 事实推定

technical secrets; infringement; complete process; whole set of  
production equipment; illegally acquire; use all; presumption of fact

**【案号】**

**[Case Number]**

(2020) 最高法知民终 1667 号

(2020) SPC IP Civil Final 1667

**【基本案情】**

**[Case Facts]**

在上诉人嘉兴市中华化工有限责任公司（以下简称嘉兴中华化工公司）、上海欣晨新技术有限公司（以下简称上海欣晨公司）与上诉人王龙集团有限公司（以下简称王龙集团公司）、宁波王龙科技股份有限公司（以下简称王龙科技公司）、喜孚狮王龙香料（宁波）有限公司（以下简称喜孚狮王龙公司）、傅祥根、被上诉人王国军侵害技术秘密纠纷案（以下简称香兰素技术秘密侵权案）中，嘉兴中华化工公司、上海欣晨公司向浙江省高级人民法院（以下简称一审法院）提起诉讼，认为王龙集团公司、王龙科技公司、喜孚狮王龙公司、傅祥根、王国军侵害其享有的“香兰素”技术秘密，请求判令被诉侵权人停止侵害并赔偿经济损失和维权合理开支共计 5.02 亿元。一审法院判令被诉侵权人停止侵害王龙集团公司、王龙科技公司、傅祥根连带赔偿经济损失 300 万元、维权合理开支 50 万元，共计 350 万元；喜孚狮王龙公司对其中 7%即 24.5 万元承担连带赔偿责任。除王国军外，本案各方当事人均不服，向最高人民法院提起上诉。二审中，嘉兴中华化工公司、上海欣晨公司将其赔偿请求降至 1.77 亿元（含维权合理开支）。最高人民法院于 2021 年 2 月 19 日判决撤销原判，五被诉侵权人停止侵害，王龙集团公司、王龙科技公司、傅祥根、王国军连带赔偿经济损失和维权合理开支共计 1.59 亿元，喜孚狮王龙公司对其中 7%即 1115 万元承担连带赔偿责任。

**In the case on technical secrets misappropriation among the**

appellants Jiaxing Zhonghua Chemical Co. Ltd. (“Jiaxing Zhonghua Chemical”), Shanghai Xinchun New Technology Co., Ltd. (“Shanghai Xinchun”), Wanglong Group Co., Ltd. (“Wanglong Group”), Ningbo Wanglong Technology Co., Ltd. (“Wanglong Technology”), Xifu Lion King Dragon Spices (Ningbo) Co., Ltd. (“Xifu Lion King Dragon”), Fu Xianggen and the appellees Wang Guojun (the vanillin technical secrets infringement case), Jiaxing Zhonghua Chemical and Shanghai Xinchun filed a lawsuit in High People's Court of Zhejiang Province (the Court of First Instance) to claim for ceasing the infringement and compensating the economic losses and reasonable expenses of CNY 502 million incurred thereof by the accused infringer on the grounds that Wanglong Group, Wanglong Technology, Xifu Lion King Dragon, Fu Xianggen and Wang Guojun infringed its vanillin technical secrets. The Court of First Instance ordered the accused infringer to cease the infringement

and Wanglong Group, Wanglong Technology and Fu Xianggen to jointly and severally compensate the economic losses of CNY 3 million and reasonable expenses of CNY 500,000 incurred thereof, totaling CNY 3.5 million; and Xifu Lion King Dragon was jointly and severally liable for 7% of the amount (*i.e.*, CNY 245,000). Except for Wang Guojun, all the parties involved were not satisfied with the first-instance judgment and appealed to the SPC. In the second instance, Jiaxing Zhonghua Chemical and Shanghai Xinchun reduced their claims for the compensation to CNY 177 million (including reasonable expenses incurred therefor). On February 19, 2021, the SPC revoked the original judgment and ordered the five accused infringers to cease the infringement, Wanglong Group, Wanglong Technology, Fu Xianggen and Wang Guojun to jointly and severally pay CNY 159 million for economic losses and reasonable expenses for protection of rights, and Xifu Lion King

Dragon to jointly and severally take liability for 7% of the amount (i.e., CNY 11.15 million).

### **【裁判意见】**

#### **[Judge's Opinion]**

最高人民法院二审认为，涉案技术秘密的载体为 287 张设备图和 25 张工艺管道及仪表流程图，王龙集团公司等被诉侵权人非法获取了其中的 185 张设备图和 15 张工艺流程图。王龙集团公司等被诉侵权人已经实际制造了香兰素产品，故其必然具备制造香兰素产品的完整工艺流程和相应装置设备。王龙集团公司等被诉侵权人拒不提供有效证据证明其对香兰素产品的完整工艺流程和相应装置设备进行了研发和试验或者其通过其他正当途径获得相关技术，且其在极短时间内建成香兰素项目生产线并实际投产，同时考虑王龙科技公司的环境影响报告书及其向案外公司购买设备的过程中均已使用了其非法获取的设备图和工艺流程图等事实，在一审法院认定王龙集团公司等四上诉人使用的技术秘密包括 17 个设备的设计图和 5 张工艺流程图的基础上，二审进一步认定，王龙集团公司、王龙科技公司、喜孚狮王龙公司、傅祥根从嘉兴中华化工公司处非法获取的涉案技术秘密，即 185 张设备图和 15 张工艺流程图均已被实际使用。

According to the SPC, the carrier of the disputed technical secrets is 287 equipment diagrams and 25 piping and

instrumentation diagrams, of which 185 equipment diagrams and 15 process flow diagrams were illegally obtained by other accused infringers including Wanglong Group. Since other accused infringers including Wanglong Group have actually produced vanillin, they must have the whole process and corresponding equipment for producing vanillin. Considering that the accused infringers including Wanglong Group refuse to present evidence to the effect that they have developed and tested the whole process and corresponding equipment of vanillin or obtain the relevant technical secrets by other appropriate means and they created the production line and actually produced the vanillin within an extremely short period of time, and that Wanglong Technology used the illegally obtained equipment diagrams and process flow diagrams in its environmental impact report and in the course of buying equipment from an outsider, on the basis of the decision made by the Court of First Instance that the technical secrets used by four accused infringers including Wanglong Group contains 17 equipment design diagrams and 5 process flow diagrams, the SPC further ascertains that the disputed technical secrets illegally obtained by Wanglong Group, Wanglong Technology, Xifu Lion King Dragon and Fu Xianggen from Jiaxing Zhonghua Chemical (*i.e.*, 185 equipment diagrams and 15 piping and instrumentation diagrams, has all been actually put

into use.

### 39. 公司法定代表人或者实际控制人与公司共同侵权的认定

#### **Identification of joint infringement by a company and its legal representative or actual controller**

##### **【裁判要旨】**

##### **[Judgment Digest]**

被诉侵权企业系其法定代表人或者实际控制人专门为从事侵权而登记设立, 该被诉侵权企业的生产经营主要系实施被诉侵权行为, 且该法定代表人或者实际控制人自身积极参与侵权行为实施的, 可以认定该法定代表人或者实际控制人与该被诉侵权企业共同实施了侵权行为, 并应当依法承担连带法律责任。

Where the accused company is established by its legal representative or actual controller only for the purpose of infringement, its main business is to commit the disputed act of infringement, and the legal representative or actual controller himself actively engages in the infringement, then it can be determined that the legal representative or actual controller and the company has jointly committed the infringement and hence should bear joint and several liabilities in accordance with the law.

##### **【关键词】**

## **[Keywords]**

技术秘密 侵权 法定代表人 实际控制人 共同侵权

责任承担

technical secrets; infringement; legal representative; actual controller; joint infringement; bear the liability

## **【裁判意见】**

### **[Judge's Opinion]**

在前述香兰素技术秘密侵权案中，最高人民法院指出，傅祥根实施了获取涉案技术秘密、将涉案技术秘密披露给王龙集团公司和王龙科技公司并允许其使用涉案技术秘密的行为，并且傅祥根利用涉案技术秘密为王龙科技公司和喜孚狮王龙公司生产香兰素提供帮助，亦构成使用涉案技术秘密的侵权行为。王龙集团公司以向傅祥根、案外人冯家义等支付报酬的方式直接获取嘉兴中华化工公司的技术秘密，并披露给王龙科技公司使用，王龙科技公司雇佣傅祥根并使用其非法获取的技术秘密进行生产，之后又通过设备出资方式将涉案技术秘密披露并允许喜孚狮王龙公司继续使用，以上行为均侵害了嘉兴中华化工公司与上海欣晨公司的技术秘密，王龙集团公司、王龙科技公司构成共同侵权。喜孚狮王龙公司自成立起持续使用王龙科技公司作为技术出资的香兰素生产线，构成侵害涉案技术秘密。王国军是王龙科技公司的法定代表人，其自身积极参与本案被诉侵权行为，其实施的被诉侵权行为既体现了王龙科技公司的意志，也体现了王国军的个

人意志。也就是说，王国军个人直接实施了被诉侵权行为，被诉侵权行为也体现了王国军的个人意志。同时，鉴于王国军专门为实施被诉侵权行为成立王龙科技公司，该公司已成为王国军实施被诉侵权行为的工具，且王国军与王龙集团公司、王龙科技公司喜孚狮王龙公司、傅祥根存在密切的分工、协作等关系，可以认定王国军个人亦实施了被诉侵权行为，具体包括以不正当手段获取、披露、使用及允许他人使用涉案技术秘密，并与王龙集团公司王龙科技公司、喜孚狮王龙公司、傅祥根构成共同侵权。

In the aforesaid the vanillin technical secrets infringement case, the SPC pointed out that Fu Xianggen committed the act of obtaining the disputed technical secrets, disclosing the disputed technical secrets to Wanglong Group and Wanglong Technology and permitting them to use the disputed technical secrets and Fu Xianggen has used the disputed technical secrets to help Wanglong Technology and Xifu Lion King Dragon produce vanillin, which also constitutes the infringement of using the disputed technical secrets. Wanglong Group and Wanglong Technology commits the infringement together because Wanglong Group directly obtains the technical secrets owned by Jiaxing Zhonghua Chemical by paying money to Fu Xianggen and the outsider Feng Jiayi and discloses the secrets to Wanglong Technology, and Wanglong Technology hires Fu Xianggen and uses the disputed technical secrets illegally obtained

by him for production and then discloses the disputed technical secrets and permits Xifu Lion King Dragon to continue to use such technical secrets in the form of investment with the equipment, which all infringes the disputed technical secrets owned by Jiaxing Zhonghua Chemical and Shanghai Xinchun. Since its establishment, Xifu Lion King Dragon has continuously used the production line of vanillin, which is seen as the technical investment made by Wanglong Technology, so it infringes the disputed technical secrets. Wang Guojun, the legal representative of Wanglong Technology, actively engages the disputed infringement, which embodies both the will of Wanglong Technology and his personal will. In other words, Wang Guojun has directly committed the act of infringement as an individual and the disputed act of infringement reflects his own will. Meanwhile, considering that Wang Guojun establishes Wanglong Technology specially for the purpose of committing the infringement at issue, causing the company to be the tool for Wang Guojun to commit the disputed infringement, and there is a close relationship of division of labor or collaboration among Wang Guojun and Wanglong Group, Wanglong Technology, Xifu Lion King Dragon and Fu Xianggen, it can be determined that Wang Guojun has individually committed the disputed infringement, including illegally obtaining, disclosing, using and permitting other

to use the disputed technical secrets, and jointly committed the infringement with Wanglong Group, Wanglong Technology, Xifu Lion King Dragon and Fu Xianggen.

#### 40. 以侵权为业时侵权获利的计算

### **Calculation of infringement profits in case of committing**

#### **infringement as main business**

#### **【裁判要旨】**

#### **[Judgment Digest]**

侵害技术秘密纠纷案件中，被诉侵权人以侵权为业的，可以被诉侵权行为相关产品的销售利润为基础计算损害赔偿数额；被诉侵权行为相关产品的销售利润难以确定的，可以被诉侵权行为相关产品的销售量乘以权利人相关产品的销售价格及销售利润率为基础计算损害赔偿数额。

In the case of technical secrets misappropriation, where the defendant commits such misappropriation as its main business, the amount of damages can be calculated on the basis of the sales profits of the products associated with the misappropriation; where it is difficult to determine such profits, the amount of damages can be calculated on the basis of the sales volume of the aforesaid products

multiplied by the sales price and sales profit rate of the corresponding products of the right holder.

**【关键词】**

**[Keywords]**

技术秘密 侵权 损害赔偿 侵权获利 销售利润 侵权为业

technical secrets; infringement; damages; profits originating from infringement; sales profits; infringement-oriented business operation

**【裁判意见】**

**[Judge's Opinion]**

在前述香兰素技术秘密侵权案中，最高人民法院指出，王龙集团公司等被诉侵权人非法获取并持续、大量使用商业价值较高的涉案技术秘密，手段恶劣，具有侵权恶意，其行为冲击香兰素全球市场，且王龙集团公司等被诉侵权人存在举证妨碍、不诚信诉讼等情节，王龙集团公司、王龙科技公司、喜孚狮王龙公司、傅祥根拒不执行一审法院的生效行为保全裁定，二审法院根据上述事实依法决定按照销售利润计算本案侵权损害赔偿数额。由于王龙集团公司、王龙科技公司及喜孚狮王龙公司在本案中拒不提交与侵权行为有关的账簿和资料，二审法院无法直接依据其实际销售数据计算销售利润。考虑到嘉兴中华化工公司香兰素产品的销售价格及销售利润率可以作为确定王龙集团公司、王龙科技公司及喜孚狮王龙公司相关销售价格和销售利润率的参考，为严厉惩

处恶意侵害技术秘密的行为，充分保护技术秘密权利人的合法权益，二审法院决定以嘉兴中华化工公司香兰素产品 2011-2017 年期间的销售利润率来计算本案损害赔偿数额，即以 2011-2017 年期间王龙集团公司、王龙科技公司及喜孚狮王龙公司生产和销售的香兰素产量乘以嘉兴中华化工公司香兰素产品的销售价格及销售利润率计算赔偿数额。

In the aforesaid vanillin technical secret infringement case, the SPC pointed out that the accused infringers including Wanglong Group illegally obtains and continuously and widely uses the disputed technical secrets of higher commercial value, showing their malicious means and intent of infringement and affecting the global market of vanillin and they refuse to present evidence and take part in the lawsuit in an dishonest way, and Wanglong Group, Wanglong Technology, Xifu Lion King Dragon and Fu Xianggen refuse to implement the ruling of preservation of act made by the Court of First Court in effect and force, therefore, the Court of Second Instance, on the basis of the aforesaid facts, decides to calculate the amount of damages by the sales profits according to law. Since Wanglong Group, Wanglong Technology and Xifu Lion King Dragon refuse to present the accounting records and materials in relation to the infringement in this case, the Court of Second Instance fails to calculate the sales profits directly by the actual sales

data. Considering that the sales price and sales profit rate of vanillin produced by Jiaxing Zhonghua Chemical can be used as a reference to determine relevant sales price and sales profit rates of Wanglong Group, Wanglong Technology and Xifu Lion King Dragon, with a view to severely punishing the malicious misappropriation of technical secrets and fully protecting the legitimate interests of the right holders of technical secrets, the Court of Second Instance decides to calculate the amount of damages by the sales profit rate of vanillin produced by Jiaxing Zhonghua Chemical from 2011 to 2017. In other words, the amount of damages is calculated by the sales volume of vanillin produced and sold by Wanglong Group, Wanglong Technology and Xifu Lion King Dragon multiplied by the sales price and sales profit rate of vanillin produced by Jiaxing Zhonghua Chemical from 2011 to 2017.

#### 41. 技术秘密侵权赔偿数额的考量因素及计算方法

### **Considerations and calculation method of the amount of damages for technical secret misappropriation**

#### **【裁判要旨】**

#### **[Judgment Digest]**

确定技术秘密侵权损害赔偿数额时, 可以考虑技术秘密的性

质、商业价值、研究开发成本、创新程度、能带来的竞争优势、技术贡献度和侵权人的主观过错、侵权情节，以及现有证据能证明的部分侵权损失或者侵权获利情况等因素。

When determining the amount of damages for technical secret misappropriation, factors to be considered include the nature, commercial value, research and development costs, the degree of innovation, competitive advantages and technical contribution to profitability of the technical secrets, the subjective fault of the infringer, infringement circumstances, as well as some losses incurred from or profits originating from the infringement that can be proved with current evidences.

**【关键词】**

**[Keywords]**

技术秘密 侵权 赔偿数额 考量因素 计算方法

technical secrets; infringement; the amount of damages; considerations; method of calculation

**【案号】**

**[Case Number]**

(2019) 最高法知民终 7 号

(2019) SPC IP Civil Final 7

**【基本案情】**

**[Case Facts]**

在上诉人优铠（上海）机械有限公司（以下简称优铠公司）与被上诉人曹坤、李守保、周华、上海路启机械有限公司（以下简称路启公司）、寿光市鲁丽木业股份有限公司（以下简称鲁丽公司）侵害技术秘密纠纷案（以下简称“优选锯”技术秘密侵权案）中涉及“边测量边锯切的设计”的技术秘密（以下简称涉案技术秘密）。2015年5月6日，优必选（上海）机械有限公司（优铠公司前身）以曹坤、李守保、周华、路启公司侵害其商业秘密为由提起诉讼，2017年2月15日，上海市高级人民法院经二审审查作出（2016）沪民终470号民事判决（以下简称第470号判决），认定李守保、周华向路启公司披露了涉案技术秘密；曹坤未实施向路启公司披露涉案技术秘密的行为。2017年，优铠公司向上海知识产权法院（以下简称一审法院）提起本案诉讼，主张李守保、周华、曹坤向路启公司披露了涉案技术秘密，路启公司使用优铠公司的技术秘密制造了优选锯产品，构成侵权。鲁丽公司购买并使用了路启公司制造的侵权设备亦构成侵权。一审法院经委托鉴定后认为，没有证据表明被诉侵权产品使用了涉案技术秘密，判决驳回优铠公司的诉讼请求。优铠公司不服，向最高人民法院提起上诉。最高人民法院对公证封存的机器进行现场勘验，推翻了一审鉴定结论，于2021年4月22日判决撤销原判，路启公司停止侵害并赔偿经济损失500万元及维权合理100万元，驳回优铠公司其余诉讼请求。

The case on misappropriation of technical secrets (the

"optimizing saws" technical secrets infringement case) between the appellant Union Brother Shanghai) Co., Ltd. ("Union Brother") and the appellees Cao Kun, Li Shoubao, Zhou Hua, Shanghai Luqi Machinery Co., Ltd. ("Luqi") and Shouguang Luli Wood Co., Ltd. ("Luli") involves the technical secrets of the "Design for Simultaneous Measuring and Cutting" (the disputed technical secrets). On May 6, 2015, Youbixuan (Shanghai) Machinery Co., Ltd. (the predecessor of Union Brother) filed a lawsuit on the grounds that Cao Kun, Li Shoubao, Zhou Hua and Luqi infringed its technical secrets. On February 15, 2017, Shanghai High People's Court rendered (2016) Hu Min Civil Final 470 judgment (No. 470 judgment), identifying that Li Shoubao and Zhou Hua disclosed the disputed technical secrets to Luqi, and that Cao Kun did not disclose the disputed technical secrets to Luqi. In 2017, Union Brother filed a lawsuit in Shanghai Intellectual Property Court (the Court of First Instance), arguing that Li Shoubao, Zhou Hua and Cao Kun disclosed the disputed technical secrets to Luqi, and Luqi manufactured optimizing saws with the use of the technical secrets owned by Union Brother, which constituted an infringement. In addition, Luli purchasing and using the infringing equipment manufactured by Luqi also constituted an infringement. The Court of First Instance held that, upon commissioned identification, there is

no evidence to the effect that the disputed infringing product used the disputed technical secrets. Hence, the Court of First Instance rejected all the claims made by Union Brother. Not satisfied with the first-instance judgment, Union Brother appealed to the SPC. The SPC conducted a scene investigation on the notarized sealed machine and overturned the conclusion of the first-instance identification. On April 22, 2021, the SPC revoked the first-instance judgment, ordered Luqi to cease the infringement and pay damages of CNY 5 million for economic losses and CNY 1 million for reasonable expenses for protection of rights, and rejected other pleadings raised by Union Brother.

### **【裁判意见】**

#### **[Judge's opinion]**

最高人民法院二审认为，在权利人的损失难以准确计算的情况下，人民法院将综合考虑涉案技术秘密的性质、创新程度、研究开发成本、商业价值、能带来的竞争优势、技术贡献度以及侵权人的主观过错、侵权情节等因素酌情确定。具体来说，考虑了以下因素：一是涉案技术秘密的性质和创新程度。涉案技术秘密不是简单的技术组合，不同于常规的测量与锯切分开进行的锯切工艺，而是为了提高优选锯锯切效率和加工精度而专门设计，需要配合专门设计的软件，电控硬件以及相关机械结构，并经本领域的技术人员研究、反复试验才能实现，是优选锯实现边测量边

锯切的核心关键信息。二是涉案技术秘密的研究开发成本。根据在先生效判决, 涉案技术秘密项目研发费用为 52 万余元。三是涉案技术秘密的商业价值及带来的竞争优势。涉案优选锯产品单价高, 无论优铠公司还是路启公司, 平均销售单价都在 30-50 万元每台。根据在先生效判决, 2008 年 5 月至 2013 年 12 月期间, 优铠公司共计销售使用涉案技术秘密的优选锯 82 台, 销售收入高达 3923 万余元, 毛利率为 55.43%。四是涉案技术秘密的贡献度。经过勘验, V200 优选锯的长度模式和系数模式使用了涉案技术秘密, 而 V200 和其他型号的优选锯还具有其他锯切模式。五是侵权人的主观过错和侵权情节。路启公司明知其使用的是李守保、周华未经许可向其披露的优铠公司的涉案技术秘密, 仍然在第 470 号判决认定其构成侵权之后, 在本案的 V200、S200、F308、H18 优选锯产品中予以使用。侵权时间长、涉及的被诉侵权产品多, 主观恶意明显。综合上述因素, 酌情确定路启公司向优铠公司赔偿经济损失 500 万元。

According to the SPC in the second instance, when it is difficult to accurately calculate the losses suffered by the right holder, the people's court should take into consideration the nature, the degree of innovation, research and development costs, commercial value, competitive advantages and technical contributions of the technical secrets, as well as the subjective fault of the infringer and circumstances of infringement. Specifically speaking, the following

factors should be considered: (1) the nature and the degree of innovation of the disputed technical secrets. The disputed technical secrets are not simple combinations of technology. Different from the traditional cutting process that separates measuring and cutting, it is specifically designed to improve the cutting efficiency and processing accuracy of optimizing saws, not just the technical combination. It can be realized with specially designed software, electronically controlled hardware and relevant mechanical structure as well as study and repeated test by a person skilled in the art. It is the key information for the optimizing saws to achieve simultaneous measuring and cutting. (2) the research and development costs of the disputed technical secrets. According to the precedent judgment in effect, the research and development cost of the disputed technical secrets is over CNY 520,000. (3) the commercial value of the disputed technical secrets and competitive advantages arising from it. With a high unit price, the optimizing saws involved are on average sold by Union Brother or Luqi at a unit price of from CNY 300,000 to CNY 500,000. According to the precedent judgment in effect, from May of 2008 to December of 2013, Union Brother sold a total of 82 optimizing saws using the disputed technical secrets, with the sales revenue of more than CNY 39.23 million and a gross profit margin of 55.43%. (4) the degree of contribution of the

disputed technical secrets. Upon investigation, the length mode and coefficient mode of the V200 optimizing saw use the disputed technical secrets, while the V200 and other models of the optimizing saws also have other cutting modes. (5) the subjective fault of the infringer and the infringing facts. Luqi, with the knowledge that what it uses is the disputed technical secrets that Li Shoubao and Zhou Hua disclosed to it without the authorization of Union Brother, still uses the disputed technical secrets in V200, S200, F308 and H18 optimizing saws after the No. 470 judgment decided that it constituted an infringement. Moreover, the infringement period is long, various products are involved and the subjective malice is obvious. Therefore, the SPC ordered Luqi to pay damages of CNY 5 million to Union Brother for economic losses at its discretion.

#### 42. 针对披露技术秘密行为的重复诉讼认定

### **Determination on repetitive litigations against disclosure of technical secrets**

#### **【裁判要旨】**

#### **[judgment Digest]**

技术秘密的披露是一次性行为, 权利人已就同一主体向另一主体披露同一技术秘密信息的行为提起诉讼, 又在诉讼过程中或者裁判生效后再次就此提起诉讼的, 构成重复诉讼。

Since the disclosure of technical secrets is a one-time act, if the right holder has filed a lawsuit against the same entity for the disclosure of the same technical secrets, and then files another lawsuit in the course of the former litigation or after the judgment of the former litigation come into effect, the latter lawsuit constitutes a repetitive litigation.

**【关键词】**

**[Keywords]**

技术秘密 侵权 披露行为 重复诉讼

technical secrets; infringement; disclosure; repetitive litigation

**【裁判意见】**

**[Judge's Opinion]**

在前述“优选锯”技术秘密侵权案中, 最高人民法院指出, 在第 470 号案中, 优铠公司主张曹坤、李守保、周华未经许可向路启公司披露优铠公司涉案技术秘密, 该案判决认定李守保、周华系优铠公司前员工且能够接触到优铠公司的涉案技术秘密, 并向路启公司披露了涉案技术秘密; 曹坤系优铠公司的销售经理, 无证据表明其可以接触到优铠公司的涉案技术秘密, 其未实施向路启公司披露涉案技术秘密的行为, 据此判决李守保、周华承担相

应的法律责任。鉴于针对同一技术秘密的披露行为系一次性的侵权行为，在前案对该行为已经审理并作出相应判项的情况下，优铠公司在本案中再次主张曹坤、李守保、周华未经许可向路启公司披露优铠公司涉案技术秘密，属于重复起诉。

In the aforementioned the "optimizing saws" technical secrets infringement case, the SPC pointed out that, in the No. 470 case, Union Brother alleged that Cao Kun, Li Shoubao and Zhou Hua disclosed its disputed technical secrets without permission, and the Court of First Instance ascertained that as former employees of Union Brother, Li Shoubao and Zhou Hua were accessible to the disputed technical secrets owned by Union Brother, and they disclosed the disputed technical secrets to Luqi; Cao Kun, the sales manager of Union Brother, does not disclose the disputed technical secrets to Luqi because there is no evidence to the effect that he was accessible to the disputed technical secrets of Union Brother. Therefore, the decision was made to order Li Shoubao and Zhou Hua take legal liabilities. Considering that the disclosure of the same technical secrets is a one-time act, when such an act has been heard and the sentence has been made in a case, Union Brother filed another lawsuit on the ground that Cao Kun, Li Shoubao, and Zhou Hua disclosed its disputed technical secrets to Luqi without permission, which constitutes repetitive litigation.

## 六、计算机软件案件

### V. Computer Software Cases

#### 43. 计算机软件著作权侵权认定中的举证责任

##### **Burden of proof in determination of copyright infringement concerning computer software**

##### **【裁判要旨】**

##### **[Judgment Digest]**

著作权人已经举证证明被诉侵权软件与主张权利的在先软件界面高度近似，或者被诉侵权软件存在相同的权利管理信息、设计缺陷、冗余设计等特有信息，能够初步证明被诉侵权软件与主张权利软件构成实质性近似且被诉侵权人接触主张权利软件的可能性较大的，举证责任转移至被诉侵权人，由其提供相反证据证明其未实施侵权行为。

Where the copyright owner has presented evidences proving that the interface of the accused infringing software is highly similar to that of the prior software, or the accused infringing software has the same unique information such as right management information, design defects and redundant design, which can preliminarily prove that the accused infringing software is substantially similar to the

prior software and there is a great possibility that the accused infringer is accessible to the prior software, then the burden of proof should be shifted to the accused infringer who should present counter evidence to disprove the infringement.

**【关键词】**

**[Keywords]**

计算机软件著作权 侵权 举证责任

computer software copyright; infringement; burden of proof

**【案号】**

**[Case Number]**

(2020) 最高法知民终1138号

(2020) SPC IP Civil Final 1138

**【基本案情】**

**[Case Facts]**

在上诉人新思科技有限公司（以下简称新思公司）与上诉人武汉芯动科技有限公司（以下简称芯动公司）侵害计算机软件著作权纠纷案中，新思公司主要为全球集成电路设计提供电子设计自动化（EDA）软件工具，此前研发完成了包含IC Compiler软件在内的多项电子设计自动化软件，并应用于芯片系统开发。新思公司经调查发现，芯动公司未经许可，复制、使用新思公司享有著作权的计算机软件“IC Compiler”，侵害了其计算机软件著作权，故诉至湖北省武汉市中级人民法院（以下简称一审法院）。一

审法院经审理认定芯动公司存在侵害新思公司计算机软件著作权的行为,判令芯动公司停止侵害、赔偿损失。新思公司、芯动公司均不服,向最高人民法院提起上诉。最高人民法院于2021年2月25日判决驳回上诉,维持原判。

In the dispute over the infringement of computer software copyright between the appellant Synopsys Inc. (“Synopsys”) and the appellee Innosilicon Technology Inc. (“Innosilicon”), mainly providing EDA software tools for the global integrated circuit design, Synopsys previously developed several EDA software (including IC Compiler software) and applied them to the development of chip system. Upon investigation, Synopsys found that Innosilicon infringed its computer software copyright by reproducing and using computer software "IC Compiler" owned by Synopsys without the permission from Synopsys. Because of this, Synopsys filed a lawsuit in Wuhan Intermediate People's Court (the Court of First Instance). The Court of First Instance ascertained that Innosilicon infringed the computer software copyright of Synopsys, so it ordered Innosilicon to cease the infringement and pay damages. Not satisfied with the first-instance judgment, Synopsys and Innosilicon appealed to the SPC. On February 25, 2021, the SPC rejected the appeal and upheld the first-instance judgment.

### 【裁判意见】

## **[Judge's Opinion]**

最高人民法院二审认为，根据《计算机软件保护条例》第三条的规定，计算机软件程序包含源程序和目标程序，同一计算机程序的源程序和目标程序为同一作品。同时根据该条例第二十四条的规定，计算机软件程序或文档存在相同或实质性相似是判断是否构成侵权的基础。但应注意的是，对软件相同或实质相似既要尽力查明客观事实，同时也需充分考虑当事人的举证能力，根据个案具体情况进行区别处理，不能将源程序的比对作为确定软件相同或实质相似的唯一标准。如果权利人已经举证证明被诉侵权软件与主张权利的软件界面高度近似，或者被诉侵权软件存在相同的权利管理信息、设计缺陷、冗余设计等特有信息，可以认为权利人完成了初步举证责任，此时举证责任转移至被诉侵权人应由其提供相反证据以证明其未实施侵权行为。本案中，新思公司向一审法院申请诉前证据保全，并使用命令探查方式固定芯动公司相关计算机和服务器的使用状态。根据保全结果可知，芯动公司的电脑中存在与新思公司涉案计算机软件的名称、目录结构错误信息等方面均相同的软件信息，显示芯动公司存在侵害新思公司计算机软件著作权的可能。芯动公司虽否认其使用新思公司软件，但一审及二审期间均未能对命令探查中发现的计算机软件标注的著作权人为新思公司作合理解释。此外，芯动公司对其未使用新思公司的软件而是使用其他软件进行相关芯片设计的主张，并未提交其实际安装使用其他软件的确凿证据。综上，可以

认定芯动公司复制并使用了新思公司享有权利的软件。

According to the SPC in the second instance, pursuant to Article 3 of the *Regulations on Protecting Computer Software*, a computer software program contains the source program and the object program, and the source program and the object program of a computer program should be deemed as one work. Meanwhile, according to the Article 24 of the said Regulation, the fact that the computer software programs or documents are identical or substantially similar is the basis for determining whether there is an infringement. But it should be noted that, not only efforts should be spared to ascertain the objective facts in determining whether the software is identical or substantially similar, but also consideration should be given to the capacity of burden of proof of every party, in order to deal with every case based on its situation and not take the comparison of the source program as the only standard for determining whether the software is identical or substantially similar. If the right holder presents evidence to the effect that the interface of the accused infringing software is highly similar to that of the prior software, or the accused infringing software contains the same unique information such as right management information, design defects and redundant design, it can be determined that the right holder has sustained the preliminary burden of proof, then the

burden of proof should be transferred to the accused infringers, who should present evidence to the contrary to prove that it has not committed infringement. In this case, Synopsys applied to the Court of First Instance for temporary preservation of evidence and used probe command to fix the use status of relevant computers and servers of Innosilicon. It can be seen from the result of preservation that Innosilicon's computer has the same name, directory structure and error information as Synopsys' computer software, showing that there is a possibility that Innosilicon infringes the computer software copyright owned by Synopsys. Although Innosilicon denies that it uses Synopsys' software, it fails to give a reasonable explanation to the finding of probe command that the computer software is marked with the Synopsys as the copyright owner in the first and the second instances. Moreover, Innosilicon fails to present conclusive evidence to the effect that it conducted chip design with the use of other software than Synopsys' software and it actually installed and used other software. In conclusion, it can be determined that Innosilicon reproduced and used the software to which Synopsys enjoyed rights.

#### 44. 计算机软件委托开发合同中未履行权利瑕疵担保责任对合同目的实现的影响

#### **Impact of failure to perform the warranty against defects of**

## **right in commissioned contracts for computer software**

### **development**

#### **【裁判要旨】**

#### **[Judgment Digest]**

计算机软件委托开发合同约定开发方负责开发源代码、委托方享有源代码著作权的，开发方负有权利瑕疵担保责任，即保证第三人不就该源代码享有任何权利。开发方违反权利瑕疵担保责任的，可以认定委托方取得软件著作权的合同目的不能实现，委托方有权解除合同。

If a contract on computer software development provides that the developer, i.e. the software development service provider is responsible for developing the source code while the client obtains the copyright to such source code, the developer should be liable for warranty against defects of right, namely, guaranteeing that no third party has any right to the source code. Where the developer violates such warranty, it can be determined that the client has the right to rescind the contract due to deprivation of the fundamental purpose under the contract to obtain the aforesaid copyright.

#### **【关键词】**

#### **[Keywords]**

计算机软件开发合同 合同解除 合同目的 权利瑕疵担保责

任

contract for computer software development; rescission of contract; purpose of contract; warranty against defects of right

**【案号】**

(2021) 最高法知民终 677 号

(2021) SPC IP Civil Final 677

**【基本案情】**

**[Case Facts]**

在上诉人济南国迅信息科技有限公司（以下简称国迅公司）徐欣欣、王建与被上诉人欧弗瑞环保科技有限公司（以下简称欧弗瑞公司）计算机软件开发合同纠纷案中，欧弗瑞公司认为，国迅公司交付的涉案软件与案外人所有的“好商城 shopnc”软件高度相似，侵害他人著作权，存在权利瑕疵，欧弗瑞公司无法依照其与国迅公司签订的涉案合同约定取得涉案软件的著作权，不能实现合同目的，国迅公司构成根本违约，故向山东省济南市中级人民法院（以下简称一审法院）提起诉讼，请求判令解除涉案合同国迅公司返还欧弗瑞公司报酬及费用并赔偿利息损失等，徐欣欣王建承担连带赔偿责任。一审法院认为，涉案软件存在权利瑕疵且欧弗瑞公司也无法依照涉案合同约定取得涉案软件的著作权，不能实现合同目的，国迅公司构成根本违约，故判决解除涉案合同，国迅公司返还欧弗瑞公司合同款项并赔偿利息损失等。国迅公司、徐欣欣、王建不服，向最高人民法院提起上诉，主张本案不

是侵权案件，在没有其他第三方向欧弗瑞公司或国迅公司主张权利的情况下，本案无权对涉案软件是否侵害第三人著作权作出认定；即便欧弗瑞公司有损失风险，根据合同相对性原则，欧弗瑞公司可通过追究国迅公司违约责任予以救济，无权解除合同。最高人民法院于2021年6月22日判决驳回上诉，维持原判。

In the computer software development contract case between the appellants Jinan Guoxun Information Technology Co., Ltd. (“Guoxun”), Xu Xinxin, Wang Jian, and the appellee Oufurui Environmental Technology Co., Ltd. (“Oufurui”), Oufurui argued that the disputed software delivered by Guoxun was highly similar to the "Haoshoping.com shopnc" software owned by an outsider, so it infringed the copyright owned by others and had a defect of right, making it impossible for Oufurui to obtain the copyright to the disputed software in accordance with the contract signed with Guoxun and to achieve the purpose of the contract. In this case, Guoxun constituted a fundamental breach of contract. Therefore, Oufurui filed a lawsuit in Jinan Intermediate People's Court (the Court of First Instance) to request for rescinding the contract, ordering Guoxun to return the remuneration and expenses to Oufurui and compensate the interest and other losses, and ordering Xu Xinxin and Wang Jian to bear joint and several liabilities for compensation. The Court of First Instance made the decision to

rescind the contract, order Guoxun to return the remuneration to Oufurui and compensate the interest on the grounds that the disputed software had defects of rights, Oufurui could not obtain the copyright of the disputed software in accordance with the contract and there was no possibility that the purpose of the contract was achieved, and in this case, Guoxun constituted a fundamental breach of contract. Not satisfied with the first-instance judgment, Guoxun, Xu Xinxin and Wang Jian appealed to the SPC on the grounds that this case did not concern the infringement and the first-instance court should not identify whether the disputed software infringed the copyright of a third party in the absence of other third parties claiming rights against Oufurui or Guoxun, and that even if Oufurui was at the risk of losses, based on the principle of relativity of contract, Oufurui could seek for remedies by making Guoxun hold responsible for its default and the contract should not be rescinded. On June 22, 2021, the SPC rejected the appeal and upheld the first-instance judgment.

### **【裁判意见】**

#### **[Judge's Opinion]**

最高人民法院二审认为，计算机软件开发合同约定开发方向委托方交付源代码，委托方取得源代码的著作权，则开发方不仅负有开发符合约定软件的义务，而且应交付源代码并就其交付的

源代码负有保证第三人不享有任何权利的义务，即权利瑕疵担保责任。在此情况下，如果开发方对成果无法尽到权利瑕疵担保责任，则委托方取得开发成果著作权的合同目的不能实现，其有权解除合同。本案中，按照涉案合同第七条关于“网络平台项目中相关程序、文件源码的版权归甲方所有”的约定，国迅公司在涉案合同项下的交付义务具体包括将源代码交付欧弗瑞公司，且对交付的源码负有权利瑕疵担保责任。涉案软件包括了“shopncb2b2c”“本演示来源于好商城”“33hao”“好商城V3”“33hao.com”“33haologo”的图片内容，以及脐带血、医院等无关的系统内容。与shopnc软件的比对来看，两者不仅在前端、后台、目录中存在大量相似内容，而且更为重要的是，欧弗瑞公司通过公证方式由 <http://123.129.248.82/ekouq/> 进入“e口气首页”取得的base-记事本中包含了“author: 33hao, Copyright: www.haoid.cn”等内容，与shopnc官网“B2B2C”商城系统软件base-记事本内容包含部分相同代码。国迅公司对此没有作出具有说服力的合理解释。从上述事实来看，国迅公司开发的涉案软件中相似部分系来源于案外人具有更高可能性。据此，可以认定国迅公司对其开发的软件也没有尽到权利瑕疵担保责任。在此情况下，开发方国迅公司不能保障委托方欧弗瑞公司在约定期限内稳定使用涉案已开发软件，影响欧弗瑞公司取得开发软件著作权的合同目的的实现，欧弗瑞公司有权解除合同。

According to the SPC, if the contract for computer software

development states that the developer should deliver the source code to the client and the copyright of the source code should belong to the client, then the developer should be under the obligation of not only developing the software as agreed upon, but also delivering the source code and guaranteeing that any third party will not enjoy any right to the source code (*i.e.*, the warranty against defects of right). Under such circumstance, if the developer fails to fulfill the warranty against defects of right to the delivered work, it is impossible for the commissioning party to achieve the purpose of obtaining the copyright to the delivered work and then the commissioning party is entitled to rescind the contract. In this case, subject to Article 7 of the contract that says that the copyright of relevant programs and source code of the online platform project should belong to Party A, Guoxun's obligation of delivery thereunder specifically include the delivery of the source code to Oufurui and Guoxun should be liable for warranty against defects of right of the delivered source code. The disputed software includes photos from "shopncb2b2c", "the demo from Haoshoping", "33hao", "good mall V3", "33hao.com", "33haologo" as well as such irrelevant system contents as umbilical cord blood or hospitals. Compared with shopnc software, they have a lot of similar contents in the front-end, back-end and directories, and more importantly,

that notarized base-notepad Oufurui obtained by entering "e-breath home page" through [http: //123.129.248.82/ekouq/](http://123.129.248.82/ekouq/) includes "author: 33hao, Copyright: [www.haoid.cn](http://www.haoid.cn)" which contains part of the same code as the base-notepad of shopnc official website "B2B2C" mall system software. Guoxun fails to provide a convincing and reasonable explanation for this. Seen from the aforesaid facts, the similar part in the disputed software developed by Guoxun is more likely to come from the outsider. Accordingly, it can be determined that Guoxun fails to fulfill its warranty against defects of right to the software developed by it. Under such circumstance, Guoxun cannot guarantee the stable use of the disputed software by Oufurui within the agreed-upon period, affecting the realization of the purpose of the contract of Oufurui to obtain the copyright to the disputed software, so Oufurui is entitled to rescind the contract.

## 七、垄断案件

### VII. Monopoly Cases

#### 45. 药品专利侵权案件中对“药品专利反向支付协议”的反垄断审查

#### **Anti-monopoly review of “reverse payment settlement for**

## **drug patent” in drug patent infringement cases**

### **【裁判要旨】**

#### **[Judgment Digest]**

“药品专利反向支付协议”是药品专利权利人承诺给予仿制药申请人直接或者间接的利益补偿（包括减少仿制药申请人不利益等变相补偿），仿制药申请人承诺不挑战该药品相关专利权的有效性或者延迟进入该专利药品相关市场的协议。在涉及药品专利权利人和仿制药申请人的药品专利侵权案件中，作为当事人主张依据或者作为法院裁判依据的有关协议具有“药品专利反向支付协议”外观的，人民法院一般应当对其是否违反反垄断法进行一定程度的审查。

A "reverse payment settlement for drug patent" is an agreement whereby a drug patent holder commits to granting direct or indirect benefit compensation to a generic drug applicant (including disguised compensation such as reduction of the generic drug applicant's disadvantage) and the generic drug applicant commits to not challenging the validity of patent rights related to the drug or delaying its entrance into market. In drug patent infringement cases involving holders of drug patents and generic drug applicants in which the agreement serving as the basis for the litigation claim or the courts' decision appears to be a "reverse payment settlement for

drug patent", people's courts shall generally conduct judicial review, to a certain extent, on whether it is in violation of the Anti-monopoly Law.

对于以不挑战专利权有效性为主要内容的“药品专利反向支付协议”是否涉嫌构成垄断协议的判断，核心在于其是否涉嫌排除、限制专利药品相关市场的竞争，一般可以通过比较签订并履行有关协议的实际情形和未签订、未履行有关协议的假定情形重点考察在仿制药申请人未撤回其无效宣告请求的情况下，药品相关专利权因该无效宣告请求归于无效的可能性，进而以此为基础分析对于专利药品相关市场而言有关协议是否以及在多大程度上造成了竞争损害。原则上，专利权利人为使仿制药申请人撤回无效宣告请求，无正当理由给予高额利益补偿的，可以作为认定专利权因仿制药申请人提出的无效宣告请求归于无效的可能性较大的一个重要考量因素，同时一般还要对假定仿制药申请人未撤回其无效宣告请求情况下相关审查结果进行预测判断。

In terms of whether a "reverse payment settlement for drug patent" that does not challenge the patent's validity is suspected to constitute a monopoly agreement, it is most important to determine whether it is suspected of eliminating or restricting competition in the market of the patented drug. This can generally be achieved by comparing the actual situation in which the agreement has been signed and fulfilled and the hypothetical situation in which the

agreement has not been signed or fulfilled, focusing on the possibility that the patent rights of the drug will be invalidated on the basis of an invalidation request if this request is not withdrawn by the generic drug applicant, before analyzing whether and to what extent the agreement has harmed competition in the market of the patented drug. In principle, the fact that the patent holder offers high interest compensation without justifiable reasoning in return for the generic drug applicant's withdrawal of the invalidation request can be taken as an important and highly possible consideration in affirming the strong possibility that the patent right will be invalidated based on the invalidation request from the generic drug applicant. Meanwhile, a prediction of the outcome of the review is generally required, assuming that the generic drug applicant does not withdraw its invalidation request.

**【关键词】**

**[Keywords]**

专利 侵权 药品专利反向支付协议 反垄断审查

patent; infringement; reverse payment settlement for drug  
patent; anti-monopoly review

**【案号】**

**[Case Number]**

(2021) 最高法知民终 388 号

(2021) SPC IP Civil Final 388

## 【基本案情】

### [Case Facts]

在上诉人阿斯利康有限公司（以下简称阿斯利康公司）与被上诉人江苏奥赛康药业有限公司（以下简称奥赛康公司）侵害发明专利权纠纷案中，涉及专利号为 01806315.2、名称为“基于环丙基稠合的吡咯烷二肽基肽酶 IV 抑制剂、它们的制备方法及应用”的发明专利（以下简称涉案专利）。案外人江苏威凯尔医药科技有限公司（以下简称 Vcare 公司）曾针对涉案专利提起无效宣告请求，涉案专利原权利人布里斯托尔-迈尔斯斯奎布公司（Bristol-Myers Squibb Company，以下简称 BMS 公司）为使专利权免受挑战，与 Vcare 公司签订了《和解协议》。双方约定：Vcare 公司立即撤回无效宣告请求，BMS 公司承诺其及涉案专利的继受权利人不追究 Vcare 公司及其关联方在 2016 年 1 月 1 日后实施涉案专利的行为。Vcare 公司遂撤回了无效宣告请求。之后，奥赛康公司作为 Vcare 公司的关联方，于上述约定日期后实施了研制、注册、制造、使用、许诺销售、销售沙格列汀片剂的行为。涉案专利权的继受人阿斯利康公司遂诉至江苏省南京市中级人民法院（以下简称一审法院），主张奥赛康公司构成对涉案专利权的侵害。一审法院认为，根据涉案《和解协议》，奥赛康公司作为 Vcare 公司的关联方有权实施被诉侵权行为，故判决驳回阿斯利康公司的诉讼请求。阿斯利康公司不服，向最高人民法院提起上

诉, 在本案二审审理期间又以与奥赛康公司达成和解为由申请撤回上诉。最高人民法院在对涉案和解协议进行反垄断等审查后, 于2021年12月17日裁定准予撤回上诉。

The case concerning a dispute between the appellant AstraZeneca PLC (“AstraZeneca”) and the appellee Jiangsu Aosaikang Pharmaceutical Co., Ltd. (“Aosaikang”) for infringement of invention patent No. 01806315.2, titled "Cyclopropyl Thickened Pyrrolidine Dipeptidase IV Inhibitors and their Preparation Methods and Uses" (the involved patent). The outsider Jiangsu Vcare Pharmatech Co., Ltd. (“Vcare”) filed an invalidation request against the involved patent. In order to prevent the patent rights from being challenged, the original right holder of the involved patent, Bristol-Myers Squibb Company (“BMS”) entered into a “Settlement Agreement” with Vcare. The parties agreed that Vcare would immediately withdraw its request for invalidation and BMS pledged that it and the successive right holder of the involved patent would not prosecute Vcare or its affiliates for enforcing the involved patent since January 1, 2016. Vcare withdrew its request for invalidation. Later, Aosaikang, as an affiliate of Vcare, developed, registered, manufactured, used, offered for sale and sold saxagliptin tablets from the date agreed above. AstraZeneca, the successor of the involved patent, then filed a suit with Jiangsu, Nanjing Intermediate

People's Court (the Court of First Instance), claiming that Aosaikang had infringed the involved patent. The Court of First Instance held that, according to the Settlement Agreement of the case, as an affiliate of Vcare, Aosaikang was entitled to take the action alleged to be an infringement, and therefore rejected AstraZeneca's claim. AstraZeneca was unsatisfied and appealed to the Supreme People's Court, before applying for withdrawal of the appeal during the trial of second instance as it had reached a settlement agreement with Aosaikang. The Supreme People's Court approved the withdrawal of the appeal on December 17, 2021 after conducting anti-monopoly and other reviews of the Settlement Agreement involved in the case.

### **【裁判意见】**

#### **[Judge's Opinion]**

最高人民法院二审认为，在涉及药品专利权利人和仿制药申请人的药品专利案件中，作为当事人主张权利或和解依据或者作为法院裁判依据的有关协议或者合同，包括当事人申请撤回起诉或者上诉的和解协议，或者申请撤回上诉情形下作为一审裁判依据的合同，具有所谓的“药品专利反向支付协议”外观的，人民法院一般应当对有关协议或者合同是否违反《中华人民共和国反垄断法》（以下简称反垄断法）进行一定程度的审查。因是否违反反垄断法的判断具有很强的专业性和高度的复杂性，对于非垄断案由案件中当事人申请撤回起诉或者上诉时垄断违法事由的审

查，一般仅限于初步审查。在当事人申请撤回起诉或者上诉的案件中，经初步审查，和解协议或者涉案合同未明显涉嫌违反反垄断法或者即使涉嫌违反反垄断法但无需作出进一步审查和处理的，如亦不存在其他依法不应予以准许的情形，则可以准许撤回起诉或者上诉；经初步审查，和解协议或者涉案合同涉嫌违反反垄断法的，应当视情依法作出相应处理，包括可以根据个案情况准许撤回起诉或者上诉，或者不准许撤回起诉或者上诉并继续审理，也可以在必要时向反垄断执法机构移送涉嫌违法线索。

In the trial of second instance, the Supreme People's Court held that in drug patent cases involving drug patent holders and generic drug applicants, if an agreement or contract acting as the basis for parties' assertion of rights or settlement or for the court's decision, including settlement agreements for the parties to apply for withdrawal of prosecution or appeal, or the contract acting as the basis for the first instance decision in the case of application for withdrawal of appeal, appears to be a so-called "reverse payment settlement for drug patent", the people's court shall generally review, to a certain extent, whether the agreement or contract concerned violates the *Anti-monopoly Law of the People's Republic of China* (the Anti-monopoly Law). As determining whether the Anti-monopoly law has been violated is highly professional and complex, reviews of monopoly violation causes are only limited to

preliminary review when the parties apply for withdrawal of prosecution or appeal in a non-monopoly case. In the case where the parties apply for withdrawal of a prosecution or appeal, if, upon preliminary review, the settlement agreement or the contract in question is not explicitly suspected of violating the Anti-monopoly Law, or even if it is, no further review or processing is required, and if there are no other circumstances under which the withdrawal of prosecution or appeal should not be permitted according to law, it may be permitted; if, in the preliminary review, the settlement agreement or the contract in question is suspected of violating the Anti-monopoly Law, it shall be handled as appropriate according to law, including permitting the withdrawal of the prosecution or appeal, or dismissing withdrawal of the prosecution or appeal and proceeding with the trial, and the suspected illegal clues can be transferred to an anti-monopoly enforcement agency if necessary.

所谓的“药品专利反向支付协议”，是药品专利权利人承诺给予仿制药申请人直接或者间接的利益补偿（包括减少仿制药申请人不利益等变相补偿），仿制药申请人承诺不挑战该药品相关专利权的有效性或者延迟进入该专利药品相关市场的协议。该类协议的安排一般较为特殊，也往往较为隐蔽，可能会产生排除、限制竞争的效果，有可能构成反垄断法规制的垄断协议。对于以不挑战专利权有效性为目的的“药品专利反向支付协议”是否

涉嫌构成反垄断法规制的垄断协议的判断，核心在于其是否涉嫌排除、限制相关市场的竞争。对此，一般可以通过比较签订并履行有关协议的实际情形和未签订、未履行有关协议的假定情形，重点考察在仿制药申请人未撤回其无效宣告请求的情况下，药品相关专利权因该无效宣告请求归于无效的可能性，进而以此为基础分析对于相关市场而言有关协议是否以及在多大程度上造成了竞争损害。其中，仿制药申请人如未撤回其无效宣告请求，专利权因之归于无效的可能性是首要问题。原则上，专利权利人为使仿制药申请人撤回无效宣告请求，无正当理由给予高额利益补偿的，可以作为认定专利权因仿制药申请人提出的无效宣告请求归于无效的可能性较大的一个重要考量因素，同时一般还要对假定仿制药申请人未撤回其无效宣告请求情况下相关审查结果进行预测判断。有关协议的竞争损害，一般应当主要考察其是否实质延长了专利权利人的市场独占时间、是否实质延缓或者排除了实际的和潜在的仿制药申请人的市场进入。如果专利权因该无效宣告请求归于无效的可能性较小，那么有关协议的签订和履行对于相关市场上专利权人的市场独占和仿制药申请人的市场进入一般不会产生实质影响，进而可以初步认定其对于相关市场具有排除、限制竞争效果的可能性较小，一般不会构成反垄断法所规制的垄断协议。如果专利权因该无效宣告请求归于无效的可能性较大，那么应当进一步考察有关协议的竞争损害：如果有关协议的签订和履行实质延长了专利权利人的市场独占时间，或者实质

延缓、排除了实际的和潜在的仿制药申请人的市场进入，且缺乏正当理由，则一般可以认定该协议具有排除、限制相关市场竞争的可能性较大，其涉嫌构成反垄断法所规制的垄断协议。

The so-called "reverse payment settlement for drug patent" is an agreement in which a drug patent holder commits to granting direct or indirect benefit compensation to a generic drug applicant (including disguised compensation such as reduction of the generic drug applicant's disadvantage) and the generic drug applicant pledges not to challenge the validity of the patent rights of the drug or delaying generic drug's entrance into market. The arrangement of this kind of agreement, which is rather extraordinary and often less explicit, may have the effect of eliminating or restricting competition, thus constituting monopoly agreements subject to Anti-monopoly Law. In terms of whether a "reverse payment settlement for drug patent" concluded for the purpose of not challenging the validity of patent rights is suspected to constitute a monopoly agreement subject to Anti-monopoly Law, it is most important to determine whether it is suspected of excluding or restricting competition in the patented drug-related market. In general, this can be achieved by comparing the actual situation in which the agreement is signed and fulfilled and the hypothetical situation in which the agreement has not been signed or fulfilled, focusing on the

possibility that the drug-related patent rights will be invalidated on the basis of an invalidation request if the generic drug applicant does not withdraw this request, and then analyzing whether and to what extent the agreement has caused harmed competition in the patented drug-related market. If the generic drug applicant does not withdraw its request for invalidation, priority should be given to the possibility that the patent rights will be invalidated on this basis. In principle, the fact that the patent holder offers high interest compensation without justifiable reasoning in return for the generic drug applicant's withdrawal of the invalidation request can be an important consideration in affirming the high possibility that the patent right will be invalidated on the basis of the generic drug applicant's invalidation request. Meanwhile, a prediction of the outcome of the review is generally required, assuming that the generic drug applicant does not withdraw its invalidation request. Regarding the competition harm resulting from the agreement, it is generally necessary to consider whether it substantially prolongs the patent holder's market exclusivity and substantially delays or excludes the entry of actual and potential generic drugs applicants into the market. If the patent rights are less likely to be invalidated on the basis of the invalidation request, then the signing and fulfillment of the agreement will not have a substantial impact on the

market exclusivity of the patent holder and the entry of the generic drug applicant into the market, and it can thus be preliminarily concluded that it is less likely to have the effect of excluding or restricting competition in the relevant market, in which case, the agreement will not generally constitute a monopoly agreement subject to Anti-monopoly Law. If the patent rights are more likely to be invalidated on the basis of the invalidation request, then the competition harm resulting from the agreement should be further examined: if the signing and fulfillment of the agreement substantially prolongs the market exclusivity of the patent holder, or substantially delays or excludes the entry of actual and potential generic drug applicants into the market without justifiable reasoning, then the agreement can generally be determined to have had the effect of excluding or restricting market competition and is suspected of constituting a monopoly agreement subject to the Anti-monopoly law.

本案中，涉案《和解协议》的主要内容是，Vcare 公司承诺不挑战涉案药品专利权的有效性、BMS 公司及继受专利权人（在本案中阿斯利康公司即为该继受专利权人）承诺不追究 Vcare 公司及其关联方（在本案中奥赛康公司即为该关联方）于 2016 年 1 月 1 日后实施涉案专利行为的侵权责任。该协议基本符合所谓的“药品专利反向支付协议”的外观。但是，考虑到涉案专利保护

期已经届满，有关可能构成的垄断违法状态已不复存在，涉案药品相关市场的进入已不存在基于涉案专利权的障碍，本案已无进一步查明涉案《和解协议》是否确定涉嫌违反反垄断法的必要性和紧迫性。经初步审查，目前难以得出涉案《和解协议》明显涉嫌违反反垄断法的结论，且无进一步审查之必要，也未发现本案存在其他可能损害国家利益、社会公共利益、他人合法权益的事由故准许撤回上诉。

The Settlement Agreement in this case mainly concerns the commitment of Vcare to not challenge the validity of patent rights of the drug in this case, and the promise of BMS and its successive patent holder (AstraZeneca in this case) not to prosecute Vcare or its affiliate (Aosaikang in this case) for their infringement of the involved patent since January 1, 2016. The agreement fundamentally appears to be a so-called "reverse payment settlement for drug patent". However, as the protection period of the involved patent has already expired, the potentially-constituted monopoly violation no longer exists and there are no longer any obstacles related to the involved patent preventing the drug from entering the market in this case, leaving no further necessity or urgency to discover whether the Settlement Agreement involved is suspected of violating the Anti-monopoly Law. After the preliminary review, the withdrawal of the appeal was approved as it was difficult to conclude that the

Settlement Agreement was suspected of violating the Anti-monopoly Law, and there is no need for further review, nor are there any other causes that may harm national interests, public interests or the legitimate rights and interests of others.

#### 46. 垄断协议豁免的证明责任

##### **Burden of proof for monopoly agreement exemption**

###### **【裁判要旨】**

###### **[Judgment Digest]**

被诉垄断协议实施者主张涉案协议具有反垄断法第十五条第一款第一项至第五项情形之一，不构成垄断协议的，应当提供充分证据证明：该协议具有前述五项法定情形之一所称积极的竞争效果或者经济社会效果；该协议为实现上述效果所必需，因而不会严重限制相关市场的竞争；该协议能够使消费者分享由此产生的利益。被诉垄断协议实施者不能仅仅依赖一般性推测或者抽象推定有关积极的竞争效果或者经济社会效果，而应当提供证据证明有关效果是具体的、现实的。

When the sued implementer of the monopoly agreement claims that the agreement at issue does not constitute a monopoly agreement as it is under one of the five circumstances in Article 15, Para. 1, Items 1 to 5 of the Anti-monopoly Law, it should provide

sufficient evidence to prove that: the agreement has positive competition or economic and social results as specified in one of the five statutory circumstances mentioned above; the agreement is necessary for realizing the aforementioned results and thus does not seriously restrict competition in relevant markets; the agreement allows consumers to share the benefits arising therefrom. The implementer of the monopoly agreement shall provide evidence demonstrating the specific and real competition results or economic and social results rather than simply generally speculating over or abstractly presuming such effects.

**【关键词】**

**[Keywords]**

横向垄断协议 豁免 证明责任

horizontal monopoly agreement; exemption; burden of proof

**【案号】**

**[Case Number]**

(2021) 最高法知民终 1722 号

(2021) SPC IP Civil Final 1722

**【基本案情】**

**[Case Facts]**

在上诉人台州市路桥吉利机动车驾驶培训有限公司（以下简称吉利公司）、台州市路桥区承融驾驶员培训有限公司（以下简

称承融公司) 与被上诉人台州市路桥区东港汽车驾驶培训学校等十三家驾培单位(以下简称东港公司等十三家被诉驾培单位)、原审第三人台州市路桥区浙东驾驶员培训服务有限公司(以下简称浙东公司) 横向垄断协议纠纷案(以下简称驾校联营垄断纠纷案) 中, 吉利公司和承融公司以其与东港公司等十三家被诉驾培单位达成的联营协议及自律公约构成垄断经营为由, 向浙江省宁波市中级人民法院(以下简称一审法院) 提起诉讼, 请求确认联营协议及自律公约无效。一审法院认为, 同在浙江省台州市路桥区的涉案十五家驾培单位签订联营协议及自律公约, 约定共同出资设立联营公司(即浙东公司), 固定驾驶培训服务价格、限制驾驶培训机构间的教练车辆及教练员流动, 构成横向垄断协议。但涉案十五家驾培单位原先分散的辅助性服务(如报名、体检、制卡等) 均由浙东公司统一在同一现场处理, 此举确可提高服务质量、降低成本、增进效率, 浙东公司所对应收取的服务费 850 元可依法豁免。据此, 一审法院判决确认案涉联营协议及自律公约中构成横向垄断协议的相关条款无效。吉利公司、承融公司不服, 向最高人民法院提起上诉, 请求改判确认联营协议中股本结构条款无效, 东港公司等十三家被诉驾培单位提出的固定价格协议豁免理由不能成立。最高人民法院于 2021 年 12 月 22 日判决撤销原判, 确认联营协议及自律公约全部无效。

In the case of a dispute over a horizontal monopoly agreement between the appellants (Taizhou Luqiao Jili Motor Vehicle Driving

Training Co. Ltd. (“Jili”) and Taizhou Luqiao District Chengrong Driver Training School (“Chengrong”) and the appellees (thirteen driving training institutions including Taizhou Luqiao District Donggang Automobile Driving Training School (the Thirteen Driver Training Institution Defendants including Donggang) and the third party of first instance Taizhou Luqiao District Zhedong Driver Training Service Co., Ltd. (“Zhedong”) ( the Dispute over Driving Schools' Monopoly Operation), Jili and Chengrong filed a lawsuit in Ningbo Intermediate People's Court (the Court of First Instance) on the grounds that the association agreement and self-disciplinary convention concluded with the Thirteen Driver Training Institution Defendants including Donggang constituted a monopoly operation, requesting that the association agreement and self-disciplinary convention be deemed invalid. The Court of First Instance held that the fifteen driver training institutions in Luqiao District, Taizhou City, Zhejiang Province signed an association agreement and a self-discipline pact, agreeing to jointly fund the establishment of an associated company (“Zhedong”) to fix the price of driver training services and restrict the flow of coach vehicles and instructors among driver training institutions, which constituted a horizontal monopoly agreement. However, as all auxiliary services (such as registration, medical examinations and card production) originally

separated among the fifteen driver training institutions involved in the case were all handled on one site by Zhedong, which could indeed improve service quality, reduce costs and increase efficiency, the service fee of CNY 850 charged by Zhedong could be made exempt according to law. On these grounds, the Court of First Instance ruled that the provisions in the association agreement and the self-disciplinary convention constituting a horizontal monopoly agreement were invalid. Jili and Chengrong were not satisfied and appealed to the Supreme People's Court, requesting that the judgment be revised to confirm the invalidity of the equity structure clauses in the association agreement and that the reasons for exemption of the fixed price agreement given by the Thirteen Driver Training Institution Defendants including Donggang were not established. On December 22, 2021, the Supreme People's Court ruled that the original judgment was reversed, confirming the invalidity of both the association agreement and the self-discipline pact.

### **【裁判意见】**

#### **[Judge's Opinion]**

最高人民法院二审认为，根据反垄断法第十三条、第十五条的规定，在认定被诉垄断协议行为是否应当适用豁免时，首先应当界定被诉行为的具体内容，判断被诉行为是否属于反垄断法第

十三条规定所禁止的行为，然后认定被诉行为实施主体提供的证据能否证明该行为存在反垄断法第十五条规定的豁免情形。在具体认定时，如果具有竞争关系的经营者达成固定价格协议、限制产量或者销量协议、划分市场协议等，落入反垄断法第十三条第一款规定的横向垄断协议范围，经营者欲以有关协议具有反垄断法第十五条第一款第一项至第五项规定情形为由主张豁免，则其应当举证证明三项重要事实：第一，有关协议具有上述五项法定情形之一；第二，有关协议为实现上述五项法定情形之一所必需因而不会严重限制相关市场的竞争；第三，有关协议能够使消费者分享由此产生的利益。对于上述三项重要事实，经营者应当提供充分证据证明相关协议具有上述五项法定情形之一项下所指积极的竞争效果或经济社会效果，且该效果是具体的、现实的，而不能仅仅依赖一般性推测或者抽象推定。就本案中东港公司等被诉十三家驾培单位所援引的反垄断法第十五条第一款第二项规定的豁免情形而言，首先，该经营者需要提供相关证据（例如达成固定价格等垄断协议之前与之后相关市场的服务质量、驾驶培训成本、驾驶培训效率情况等），以对比说明其通过统一服务规范、标准或者实现专业化分工等手段，切实达到提高服务质量降低服务成本、增进效率的实际效果；其次，该经营者需要提供相关证据证明为实现提高产品质量、降低成本、增进效率所必需且并未严重限制台州市路桥区为中心的机动车驾驶培训服务市场的竞争；最后，该经营者还需要提供相关证据（例如垄断协议

达成之前与之后消费者交费标准、参加培训服务的成本以及便利程度等)证明消费者确实从中受益。就本案中东港公司等被诉十三家驾培单位所援引的反垄断法第十五条第一款第三项规定的豁免情形而言,该经营者需要提供证据证明其作为中小企业相对于某些大企业处于弱势,在竞争中处于不利地位,其签订垄断协议增强了中小企业的竞争力,提高了中小企业的经营效率;同时该经营者也应当举证证明消费者从中受益的情况。

In the trial of second instance, the Supreme People's Court held that, according to the provisions of Article 13 and Article 15 of the Anti-monopoly Law, in determining whether the exemption should be applied to the behavior accused of concluding the monopoly agreement, the court shall first make clear the specific content of the accused behavior to determine whether it is prohibited under Article 13 of the Anti-monopoly Law, and then determine whether the evidence provided by the subject of the behavior being accused can support its exemption under Article 15 of the Anti-monopoly Law. In the specific determination, in the event that competing undertakings enter into an agreement on fixed price, limiting production/sales volume, market division, and so on, which falls within the scope of horizontal monopoly agreement in Article 13(1) of the Anti-monopoly Law, the undertakings shall prove three important facts if they intend to claim exemption on the grounds that the agreement is

under any of the circumstances stipulated in Article 15(1)(1) to (5) in the Anti-monopoly Law: firstly, the agreement falls under one of five statutory circumstances above; secondly, the agreement is necessary for materializing one of the five statutory circumstances and thus does not seriously restrict competition in relevant markets; thirdly, the agreement allows consumers to share the benefits arising therefrom. In terms of the three important facts above, undertakings shall provide sufficient evidence to prove that the agreement creates positive competition or has economic and social results as specified in the provisions listed in one of the five statutory circumstances, and demonstrate the specific and actual competition results or economic & social results rather than simply generally speculating or abstractly presuming such effects. With regard to the exemptions under Article 15(1)(2) of the Anti-monopoly Law invoked by the Thirteen Driver Training Institution Defendants including Donggang in this case, first of all, the undertakings shall provide supporting evidence (such as information about the quality of service, cost of driver training, efficiency of driver training in the relevant market before and after the conclusion of the monopoly agreements including the fixed-price agreement) to explain by way of comparison that they have effectively enhanced service quality, reduced service costs and improved efficiency by means of common

service descriptions and standards or professional division of responsibilities; secondly, the undertakings shall provide evidence establishing the necessity of enhancing product quality, reducing costs and improving efficiency without seriously restricting competition in the motor vehicle driving training service market centered in Luqiao District of Taizhou; finally, the undertakings shall also provide relevant evidence (e.g., charges to consumers, cost and convenience of access to the training services before and after the conclusion of the monopoly agreement) to prove that consumers do indeed benefit from the agreement. With regard to the exemptions under Article 15(1)(3) of the Anti-monopoly Law invoked by the Thirteen Driver Training Institution Defendants including Donggang in the case, the operators shall provide evidence proving that, they, as small and medium-sized enterprises, are in a weaker position than some large enterprises and are at a competitive disadvantage, while the monopoly agreement has enhanced the competitiveness of the small and medium-sized enterprises and improved their operational efficiency; in addition, the undertakings shall provide evidence that consumers have benefited from the agreement.

本案中, 浙东公司统一向消费者(驾驶学员)收取的 850 元服务费中包括制卡费 200 元, 余下 650 元对应的服务包括统一为驾驶学员提供报名、体检、理论学习培训以及模拟器学习培训等。

在浙东公司成立前，上述费用均由涉案十五家驾培单位自行收取。浙东公司统一收取服务费的行为实质性地将上述服务价格予以固定，该部分服务费与涉案十五家驾培单位自行收取的费用共同构成本案中固定价格的横向垄断协议，根据其性质和一般市场规律，该类横向垄断协议一般具有排除、限制竞争的效果。东港公司等被诉十三家驾培单位依据反垄断法第十五条第一款第二项、第三项的规定提出豁免主张，其应当提供证据具体证明该横向垄断协议所产生的积极效果，但其未提供证据证明在浙东公司成立前，涉案十五家驾培单位在学员报名、体检、理论学习等服务项目中收费的具体价格，未提供证据证明浙东公司成立后其统一提供服务的行为如何以及在何种程度上实际降低了成本并提高了服务质量、增进了效率，也没有提供证据证明浙东公司固定收取的 850 元费用相比此前各驾校在相关服务项目上自行收取的费用更为低廉。因此，根据东港公司等十三家被诉驾培单位提供的证据，尚不足以认定浙东公司针对统一提供的辅助性服务固定收取 850 元费用的行为构成反垄断法第十五条规定的豁免情形。一审法院在经营者没有提供真实、有效证据支持其豁免主张情况下主要根据一般经验推定浙东公司统一提供服务将带来有利于降低成本、提高质量、增进效率等效果，直接认定该项统一收费符合垄断协议豁免情形，不符合反垄断法第十五条关于经营者应当证明垄断协议豁免情形及条件的规定，应予纠正。

In this case, Zhedong charged consumers (learner drivers) a

uniform service fee of CNY 850, including a card production fee of CNY 200 and the remaining CNY 650 for services such as registration, medical examinations, and theoretical and simulation training for learner drivers. Before the establishment of Zhedong, all fees mentioned above were separately collected by the fifteen driver training institutions involved in the case, before being all solely collected by Zhedong, which substantially fixed the prices of the above services. These service fees and those collected by the fifteen driver training institutions involved in the case constituted a fixed-price horizontal monopoly agreement that had the general effect of excluding and restricting competition through its nature and general market rules. The Thirteen Driver Training Institution Defendants including Donggang, if requesting exemptions under the provisions of Article 15(1)(2) and (3) of the Anti-monopoly Law, shall provide specific evidence of the positive effects results produced by the horizontal monopoly agreement. However, they failed to provide evidence demonstrating the specific prices charged by the fifteen driver training institutions involved in the case for services such as learner drivers' registration, medical examinations and theoretical training before the establishment of Zhedong, and evidence demonstrating how and to what extent Zhedong's unified service provision upon its establishment actually reduced costs and

improved service quality and efficiency. They also failed to provide evidence that the fixed fee of CNY 850 charged by Zhedong was lower than those previously charged by each separate driving school for the same services. Therefore, the evidence provided by the Thirteen Driver Training Institution Defendants including Donggang was not sufficient to determine that Zhedong's sole collection of the fixed fee of CNY 850 for auxiliary services constituted an exemption under Article 15 of the Anti-monopoly Law. In the absence of the operators' authentic and valid evidence supporting their exemption claim, the Court of First Instance directly ruled that the unified collection of fees qualified for an exemption of monopoly agreement mainly based on the presumption from general experience that the unified services provided by Zhedong would have the effects of reducing costs and improving quality and efficiency, which was not in line with Article 15 of the Anti-monopoly Law stating that the operators shall prove their exemption from the monopoly agreement and its conditions. Therefore, the ruling shall be corrected.

#### 47. 垄断行政处罚的司法审查

### **Judicial review on anti-monopoly administrative penalty**

#### **【裁判要旨】**

## **[Judgment Digest]**

对于垄断行政处罚的合法性与合理性的审查,应当重点考量该行政处罚是否在法律规定的处罚标准和范围之内;该行政处罚是否具有足够的威慑作用,能够实现反垄断法关于预防和制止垄断行为的立法目的;该行政处罚是否符合过罚相当原则。具体审查时,应当结合垄断行为的危害性程度、经营者的主观恶意、经营者在违法行为中所处的地位和作用、是否已经并处没收违法所得、经营者是否存在抗拒行政查处或者主动停止违法行为的情节等个案具体情况,以有利于实现反垄断法预防和制止垄断行为的立法目的和确保个案处理结果公正为指引,进行综合判断。

The review on the legality and rationality of an anti-monopoly administrative penalty shall focus on: whether the administrative penalty is consistent with the standard and scope of the penalty prescribed by law; whether the administrative penalty is deterrent enough to achieve the legislative purpose of the Anti-monopoly Law to prevent and suppress monopolistic acts; and whether the administrative penalty is in line with the principle of commensurate punishment. In specific reviews, all-round judgments shall be made on a case-by-case basis with reference to the degree of harm of a monopoly, the subjective malice of the operator involved, the position and role of the operator in illegal acts, whether the illegal income has been confiscated, whether the undertakings have resisted

administrative investigations or voluntarily stopped the illegal act, and other specific circumstances, on the principle of facilitating the legislative purpose of the Anti-monopoly Law to prevent and stop monopolistic acts and ensuring the fairness of the results of each case.

**【关键词】**

**[Keywords]**

垄断协议 反垄断行政处罚 上一年度销售额 司法审查  
monopoly agreement; anti-monopoly administrative penalty;  
sales in the previous year; judicial review

**【案号】**

**[Case Number]**

(2021) 最高法知行终 880 号  
(2021) SPC IP Admin. Final 880

**【基本案情】**

**[Case Facts]**

在上诉人海南省市场监督管理局与被上诉人海南盛华建设股份有限公司（以下简称盛华公司）反垄断行政处罚纠纷案中，盛华公司于 2017 年起在海南省消防协会消防维保检测行业分会组织下达成并实施消防安全检测价格的横向垄断协议，该公司经营业务范围有 20 余项，其 2018 年年度销售额 1 亿元，其中开展消防安全检测业务的经营收入为 93.9 万元。海南省市场监督管

理局于 2019 年 9 月对盛华公司进行垄断立案调查，于 2020 年 11 月作出处罚决定，对盛华公司处以 2018 年销售额 1 亿元 1% 的罚款即 100 万元。盛华公司不服处罚决定，向海南省第一中级人民法院（以下简称一审法院）提起行政诉讼。一审法院认为，海南省市场监督管理局以盛华公司实施横向垄断协议所取得的销售收入和正常业务中未实施价格垄断行为所取得的销售收入一并作为处罚基数来计算处罚金额，属于对反垄断法第四十六条第一款中“上一年度销售额”的错误理解。故判决撤销上述行政处罚，责令海南省市场监督管理局对有关垄断行为重新作出处理。海南省市场监督管理局不服，向最高人民法院提起上诉。最高人民法院于 2022 年 1 月 26 日判决撤销原判，驳回盛华公司的诉讼请求

In the dispute over an anti-monopoly administrative penalty between the appellant Administration for Market Regulation of Hainan Province and the appellee Hainan Shenghua Construction Co., Ltd. (“Shenghua”), Shenghua reached a horizontal monopoly agreement on the price of fire safety inspections as organized by the Branch of Fire-related System Maintenance and Inspection Industry under Hainan Provincial Association of Fire Protection in 2017 and has been implementing it ever since. The business scope of Shenghua covers more than 20 items and reported its annual sales volume of CNY 100 million in 2018, of which the operating income from fire safety inspection business was CNY 939,000. The

Administration for Market Regulation of Hainan Province initiated a monopoly investigation against Shenghua in September 2019 and made a penalty decision in November 2020, imposing a fine of 1% of Shenghua's 2018 annual sales of CNY 100 million, i.e. CNY 1 million. Shenghua challenged the penalty decision and filed an administrative lawsuit with the First Intermediate People's Court of Hainan Province (the Court of First Instance). The Court of First Instance held that it was an incorrect interpretation of the "sales in the previous year" in Article 46(1) of the Anti-monopoly Law that the Administration for Market Regulation of Hainan Province calculated the penalty amount without separating the sales revenue obtained by Shenghua from the performance of the horizontal monopoly agreement from the sales revenue obtained in the ordinary course of business without monopoly pricing. Therefore, the Court of First Instance ruled that the above administrative penalty should be revoked, and the Administration for Market Regulation of Hainan Province was ordered to make a new decision on the monopolistic act. The Administration for Market Regulation of Hainan Province was unsatisfied and appealed to the Supreme People's Court. On January 26, 2022, the Supreme People's Court reversed the original judgment and rejected Shenghua's claim.

### 【裁判意见】

### **[Judge's Opinion]**

最高人民法院二审认为，就本案争议的反垄断行政处罚的合法性与合理性而言，应当重点审查考量三个层面的问题：第一，系争反垄断行政处罚是否在反垄断法第四十六条针对达成并实施垄断协议所规定的处罚幅度之内，以确定行政执法机构裁量具体罚款数额是否超出法定标准和范围。第二，系争反垄断行政处罚是否具有足够的威慑作用，以实现反垄断法第一条确立的预防和制止垄断行为等立法目的。第三，系争反垄断行政处罚是否符合《中华人民共和国行政处罚法》（以下简称行政处罚法）第四条第二款及反垄断法第四十九条的规定所体现的过罚相当原则，以避免对轻微违法行为给予过重的处罚或者对特别严重的违法行为给予过轻的处罚。

In the trial of second instance, the Supreme People's Court held that the legality and rationality of the anti-monopoly administrative penalty at issue in this case should be reviewed and considered at three levels: firstly, whether the anti-monopoly administrative penalty at issue was within the limit of penalties provided for in Article 46 of the Anti-monopoly Law for the conclusion and implementation of monopoly agreements, for the purpose of determining whether the specific amount of the fine imposed by the administrative enforcement agency was beyond the legal standard and limit; secondly, whether the administrative anti-monopoly

penalty at issue was enough of a deterrent to achieve the legislative purpose of preventing and suppressing monopolistic acts as established in Article 1 of the Anti-monopoly Law; thirdly, whether the anti-monopoly administrative penalty at issue was in accordance with the principle of commensurate punishment as embodied in Article 4(2) of the *Law of the People's Republic of China on Administrative Penalty* (the Law on Administrative Penalty Law) and Article 49 of the Anti-monopoly Law, so as to avoid the imposition of excessive penalties for minor violations or lesser penalties for particularly serious violations.

根据反垄断法第四十六条第一款的规定, 经营者违反本法规定, 达成并实施垄断协议的, 由反垄断执法机构责令停止违法行为, 没收违法所得, 并处上一年度销售额百分之一以上百分之十以下的罚款。首先, 从文义解释的角度看, 该条款规定计算罚款基数时仅表述为“上一年度销售额”而没有作进一步限定。对该“销售额”的含义实践中可能存在多种理解, 包括: 全部产品或者服务的销售额、涉案产品或者服务的销售额、中国境内涉案产品或者服务销售额、相关市场销售额、全球销售额等。在“上一年度销售额”存在多种理解情况下, 需要结合立法目的和一般法律适用原则探究其合理含义。其次, 从法律目的解释的角度看, 反垄断法的直接立法目的是预防和制止垄断行为。鉴于垄断行为的危害不仅限于其违法经营的范围, 还损害市场竞争机制和经济

运行效率，垄断行为通常对市场经济的危害性较大，总体上对垄断行为应当处以较为严厉的处罚，方能起到有效的威慑作用，否则难以实现反垄断法预防和制止垄断行为的立法目的，因此，将反垄断法第四十六条第一款规定的“上一年度销售额”原则上解释为全部销售额具有合理性。最后，从过罚相当的角度看，行政处罚法第四条第二款规定，设定和实施行政处罚必须以事实为依据，与违法行为的事实、性质、情节以及社会危害程度相当；反垄断法第四十九条规定，反垄断执法机构确定具体罚款数额时，应当考虑违法行为的性质、程度和持续的时间等因素。据此，审查反垄断执法机构确定的具体罚款数额是否合法适当，需要结合个案具体情况，以有利于实现反垄断法预防和制止垄断行为的立法目的和确保个案处理结果公正为指引进行综合判断。具体可以考虑如下因素：垄断行为的危害性程度，如垄断行为的性质（横向垄断协议通常比纵向垄断协议对市场竞争的危害性更大）、持续时间、所涉及的市场范围、违法销售额及对经营者全部业务的影响等；经营者的主观恶意，如是否明知故犯、恶意违法；经营者在违法行为中所处的地位和作用，如是否属于垄断行为组织者或者主导者等；是否已经并处没收违法所得；经营者是否存在抗拒行政查处或者主动停止违法行为的情节；等等。

According to Article 46(1) of the Anti-monopoly Law, if an operator enters into and implements a monopoly agreement in violation of the provisions of this Law, the anti-monopoly

enforcement agency shall order the cessation of the illegal act, confiscate the illegal income, and impose a fine of no less than one percent and no more than ten percent of the undertakings' sales in the previous year. Firstly, from the perspective of textual interpretation, this provision only states that the basis for calculating the fine is the "sales in the previous year" without further definition. In practice, the meaning of "sales" may be understood in various ways, including: sales of all products or services, sales of products or services involved in the case, sales of products or services involved in China, sales in the relevant market, and global sales. As the "sales in the previous year" could be interpreted in various ways, its rational meaning must be considered based on the legislative purpose and general principles of legal application. Secondly, from the perspective of legal purpose, the direct legislative purpose of the Anti-monopoly Law is to prevent and stop monopolistic acts. As monopoly not only causes harm within the scope of its illegal operation but also impairs the market competition mechanism and the efficiency of economic operations, and is usually more harmful to the market economy, and in general, the monopoly shall generally be subject to more severe penalties for the effect of deterrence, otherwise it will be difficult to achieve the legislative purpose of the Anti-monopoly Law to prevent and suppress monopoly. To this end,

it is reasonable to interpret the "sales in the previous year" in Article 46(1) of the Anti-monopoly Law as all sales in principle. Finally, from the perspective of commensurate punishment, Article 4(2) of the Law on Administrative Penalty states that the administrative penalty must be set and imposed based on facts and be commensurate with the facts, nature, circumstances and degree of social harm of the violation; Article 49 of the Anti-monopoly Law states that the anti-monopoly enforcement agency shall take into account the nature, extent and duration of the violation when determining the amount of a specific fine. In the review of whether the specific amount of a fine determined by the anti-monopoly enforcement agency is lawful and appropriate, all-round judgments shall be made on a case-by-case basis on the principle of facilitating the legislative purpose of the Anti-monopoly Law to prevent and stop monopolistic acts and ensuring the fairness of the results of each case. In particular, the following can be considered: the degree of harm of the monopoly, such as the nature of the monopoly (horizontal monopoly agreements are usually more harmful to market competition than vertical monopoly agreements), its duration, the scope of the market covered, volume of illegal sales and the impact on the operator's entire business; the subjective malice of the operator, such as whether the operator has knowingly

and maliciously violated the law; the position and role of the operator in the illegal act, such as whether they are the organizer or leader of the monopoly; whether the illegal income has been confiscated; whether the operator has resisted administrative investigation or voluntarily stopped the illegal act, and other circumstances.

就本案盛华公司从事的涉案垄断行为而言，海南省市场监督管理局已经考虑了盛华公司的垄断违法经营销售额情况，且原本应当根据其垄断违法销售情况计算其违法所得予以没收，并同时处以罚款，但该局并没有直接没收违法所得，而是笼统按其 2018 年度销售额 100734213.88 元百分之一处以罚款 1007342.13 元。海南省市场监督管理局作出该罚款处罚时，已经考虑盛华公司达成并实施垄断协议的主观意愿不强、部分检测业务未严格按照垄断协议执行等较轻违法情节，但是盛华公司垄断业务一年的相关销售额已达 939218.43 元，且该违法行为持续时间超过两年。综合考虑最终处罚数额应当包含没收违法所得和罚款两项处罚，并结合涉案垄断行为的危害性及持续时间等因素，上述处罚结果在反垄断行政处罚的法定幅度内，符合反垄断法预防和制止垄断行为的立法目的，也并未明显违反过罚相当原则。一审法院在综合考量被诉处罚决定的合法性与合理性方面有所欠妥，予以纠正。

Regarding the monopolistic act committed by Shenghua in this case, the Administration for Market Regulation of Hainan Province

were of the opinion that the sales generated from the monopolistic illegal operation of Shenghua and the illegal income should have been calculated from its monopolistic illegal sales and confiscated, with a fine imposed at the same time; however, the Administration did not directly confiscate the illegal income, instead imposing a general fine of CNY 1,007,342.13, equal to one percent of its annual sales (100,734,213.88) in 2018. When the Administration for Market Regulation of Hainan Province imposed the fine, it had already considered the lesser illegal circumstances of Shenghua such as a weaker subjective will to reach and implement the monopoly agreement and part of the testing business not having strictly been completed in accordance with the monopoly agreement. Nevertheless, the one-year sales related to Shenghua's monopoly business produced an amount of CNY 939,218.43, and the illegal act lasted for more than two years. On the overall consideration of the fact that the final penalty amount should include the confiscated illegal income and the fine, and also of the harmfulness and duration of the monopolistic acts involved, the above penalty is within the statutory limit of anti-monopoly administrative penalties and in line with the legislative purpose of the Anti-monopoly Law to prevent and stop monopolistic acts, and demonstrates no obvious violation of the principle of commensurate punishment. The Court of First

Instance failed to consider the legality and rationality of the penalty decision in an appropriate manner, and the decision shall thus be corrected.

#### 48. 涉及垄断协议的合同效力认定

### **Determination on the validity of contracts concerning monopoly agreements**

#### **【裁判要旨】**

#### **[Judgment Digest]**

反垄断涉及国家整体经济运行效率和社会公共利益，反垄断法关于禁止横向垄断协议行为的规定原则上属于效力性强制性规定，违反该规定的合同条款应属无效。为降低和消除经营者继续实施垄断协议行为的风险，实现反垄断法预防和制止垄断行为的立法目的，与横向垄断协议条款具有紧密关系、与之脱离即不再具有独立存在意义的合同条款，以及实质上服务于横向垄断协议行为实施的合同条款，亦应属无效。

Anti-monopoly Law enforcement concerns the efficiency of the entire economy operation and the public interest of the society. The provisions of the Anti-monopoly Law regarding the prohibition of horizontal monopoly agreements are, in principle, compulsory regulation on contractual validity, and contract clauses in violation

of such provisions shall be null and void. To reduce and eliminate the risk of undertakings' further implementation of monopoly agreements and to fulfill the legislative purpose of the Anti-monopoly Law to prevent and stop monopolistic acts, the contract clauses that are closely related to the provisions of a horizontal monopoly agreement and would have no independent meaning if isolated from the same, as well as the contract clauses that substantially serve the implementation of a horizontal monopoly agreement, shall also be null and void.

**【关键词】**

**[Keywords]**

横向垄断协议 举证责任 合同效力

horizontal monopoly agreement; burden of proof; validity of contracts

**【裁判意见】**

**[Judge's Opinion]**

在前述驾校联营垄断纠纷案中，最高人民法院指出，反垄断涉及国家整体经济运行效率和社会公共利益，原则上应当将反垄断法关于禁止垄断行为的规定作为效力性强制性规定，违反该规定的合同条款无效。根据《中华人民共和国合同法》第五十六的规定，合同部分无效，不影响其他部分效力的，其他部分仍然有效。该条法律规定意味着，如果合同内容可分且相互不影响的

合同部分无效不导致其他部分无效；如果合同无效部分会影响其他部分效力的，其他部分也应无效。合同内容可分一般是指将无效部分分离出来，还能够使一项可以有效的行为继续存在，且不与当事人的行为意图或者目的相悖。同时，判断合同或者合同条款是否因违反反垄断法而无效时，还应该考虑消除和降低垄断行为风险的需要，有利于实现反垄断法预防和制止垄断行为的立法目的。首先，综观涉案十五家驾培单位签订联营协议及自律公约的动因、目的、主要内容和实际履行等情况，联营协议第三条关于股本结构的条款并无独立有效的意义和价值。该十五家驾培单位本为处于激烈竞争中的经营者，其以“防止恶性竞争”等为由共同协商设立联营公司固定价格、限制数量等，其行为的实质和目的主要在于合谋排除、限制竞争；而涉案十五家驾培单位在联营协议第三条中约定各自出资共同设立联营公司，是其实施上述横向垄断协议、实现市场垄断目的的主要手段。从浙东公司作为联营公司根据联营协议所承担的管理职能、设立后实际从事的业务看，其是涉案十五家驾培单位实施横向垄断协议的中枢和关键环节，除此之外，难以看出联营协议第三条关于注册资本与股本结构的约定在协议各方（即涉案十五家驾培单位）之间还有其他独立存在的意义和价值。其次，为预防和制止涉案垄断行为之目的，联营协议第三条关于股本结构的条款亦应认定无效。如果认定联营协议第三条仍然有效而继续约束各方，则实际上为被诉十三家驾培单位保留了信息沟通、协调一致行动的渠道，存在未来

再次实施横向垄断协议的风险和可能,不利于预防和制止涉案垄断行为。故联营协议第三条是与联营协议及自律公约中有关横向垄断协议条款密不可分而无独立存在意义的条款。为消除有关经营者再次实施横向垄断协议的风险,联营协议第三条应当随同有关横向垄断协议条款一并认定无效。联营协议及自律公约中有关横向垄断协议条款和联营协议第三条关于浙东公司注册资本与股本结构的约定基本上构成联营协议及自律公约的主要内容乃至全部内容,认定上述条款均无效即相当于认定联营协议及自律公约全部无效,故直接判决确认联营协议及自律公约全部无效。

In the above case of a dispute over monopoly of driving schools through associated operations, the Supreme People's Court noted that the prevention of monopoly concerns the operation efficiency of the entire economy and the public interest of a country, and in principle, the provisions of the Anti-monopoly Law on the prohibition of monopolistic acts shall be regarded as compulsory regulation on validity, and contract clauses that violate the same shall therefore be null and void. According to Article 56 of the *Contract Law of the People's Republic of China*, if a contract is invalid in part, other parts shall not be affected and will remain in force. This legal provision means that if the content of a contract is divisible and sections do not affect one another, the invalidity of any part of the contract will not cause the invalidity of any other part; if

the invalid part of the contract will affect the validity of the other parts, the other parts shall also be invalid. That the contract content can be divided generally means that the invalid part can be excluded without affecting the survival of a valid act or conflicting with the intention or purpose of the parties acting in this way. Meanwhile, to determine whether a contract or contract clause is invalid due to the violation of the Anti-monopoly Law, it is necessary to consider the need to eliminate and reduce the risk of monopolistic acts, which will facilitate the legislative purpose of the Anti-monopoly Law to prevent and stop monopolistic acts. Firstly, from a general view of the motive, purpose, main content and actual performance of the association agreement and the self-disciplinary convention concluded by the fifteen driver training institutions, Article 3 of the association agreement regarding the share capital structure has no independent or actual significance or value. The fifteen driver training institutions, which operated in fierce competition, jointly negotiated the establishment of an associated company to fix prices and limit quantity on the grounds of "preventing vicious competition", etc., with the actual intention of conspiring to exclude and restrict competition in essence; and the fifteen driver training institutions involved in the case agreed in Article 3 of the association agreement that each of them would make a capital contribution to

establish an associated company which actually served as a major vehicle for them to implement the above horizontal monopoly agreement and achieve the goal of market monopoly. From the management functions undertaken by Zhedong as an associate company under the association agreement and the actual business engaged in after its establishment, it played a pivoting role and acted as a key link for the fifteen driver training institutions involved in the case to implement the horizontal monopoly agreement. However, it is difficult to discover the significance and value of the independent existence of the provisions in Article 3 of the association agreement regarding the registered capital and share capital structure among the parties (i.e. the fifteen driver training institutions involved in the case). Secondly, for the purpose of preventing and stopping the monopolistic acts involved in the case, the provisions on the share capital structure in Article 3 of the association agreement shall also be found invalid. If Article 3 of the association agreement is further determined valid and binding on the parties, it in fact maintains a channel for the thirteen driver training institutions to communicate and coordinate their actions, creating a risk and possibility that the horizontal monopoly agreement will be implemented again in the future, adversely affecting the prevention and suppression of the monopolistic acts involved. Therefore, Article

3 of the association agreement is inseparable from the provisions of the association agreement and the self-discipline pact concerning the horizontal monopoly agreement and has no significance of independent existence. To eliminate the risk of the operators implementing the horizontal monopoly agreement further, Article 3 of the association agreement shall be considered invalid together with the provisions concerning the horizontal monopoly agreement. The provisions of the association agreement and the self-discipline pact regarding the horizontal monopoly agreement and Article 3 of the association agreement on the registered capital and share capital structure of Zhedong constitute the main content or even the entire content of the association agreement and the self-discipline pact, and determining the above provisions invalid is equivalent to determining the association agreement and the self-discipline pact invalid as a whole. Therefore, the SPC ruled that the association agreement and the self-discipline pact should be confirmed invalid as a whole.

#### 49. 反垄断执法机构行政不作为的认定

Determination on administrative omission of anti-monopoly enforcement agencies

## 【裁判要旨】

### [Judgment Digest]

法律、法规和规章未对反垄断书面举报的调查设定期限的，可以综合考虑作为调查对象的涉嫌垄断行为的行为性质、调查难度、调查范围等因素确定反垄断执法机构履行法定职责的合理期限。当事人于反垄断执法机构履行法定职责的合理期限内提起行政诉讼，主张反垄断执法机构构成行政不作为的，不予支持。

When no time limit is set in laws, regulations or rules for the investigation on written anti-monopoly reports, such factors as the nature of the suspected monopolistic acts under investigation, the difficulty and scope of investigation may be considered to determine a reasonable period for the anti-monopoly enforcement agency to perform its statutory duties. When a party files an administrative lawsuit within the aforementioned reasonable period, asserting there is administrative omission of the anti-monopoly enforcement agency, the court shall not support such assertion.

## 【关键词】

### [Keywords]

反垄断执法 行政不作为 合理期限

anti-monopoly enforcement; administrative omission;  
reasonable period

## 【案号】

### [Case Number]

(2021) 最高法知行终 112 号

(2021) SPC IP Admin. Final 112

## 【基本案情】

### [Case Facts]

在上诉人杭州格凯商贸有限公司（以下简称格凯公司）与被上诉人国家市场监督管理总局（以下简称市场监管总局）其他知识产权行政纠纷案中，2020年1月8日，市场监管总局收到格凯公司的《履行法定职责申请书》，格凯公司认为广西玉柴机器专卖发展有限公司（以下简称玉柴专卖公司）滥用市场支配地位，达成并实施垄断协议，其行为严重侵害格凯公司合法权益，请求市场监管总局依法查处。2020年5月15日，格凯公司认为市场监管总局未在两个月的法定期限内履行查处职责，已构成行政不作为，严重侵害其合法权益，向北京市第一中级人民法院（以下简称一审法院）提起诉讼，请求判令市场监管总局履行法定职责，对格凯公司的申请作出处理并回复。一审法院经审理认为，对于本案涉及的对垄断协议及滥用市场支配地位等两类行为的反垄断执法的办案期限，反垄断法及市场监管总局制定的《禁止垄断协议暂行规定》《禁止滥用市场支配地位行为暂行规定》等规章均未作明确规定；考虑到反垄断执法的特殊复杂性，法律、法规及规章并未明确规定市场监管总局对涉嫌垄断行为进行查处的

期限，且市场监管总局答辩称，针对格凯公司提供的举报线索，已决定由市场监管总局直接办理并开展核查，应认定格凯公司提起本案诉讼时，市场监管总局对格凯公司的举报事项处于正在履责状态之中；格凯公司关于市场监管总局未在两个月的法定期限内履行法定职责的主张，没有事实及法律依据，遂判决驳回格凯公司的诉讼请求。格凯公司不服，向最高人民法院提起上诉。最高人民法院于 2021 年 12 月 16 日判决驳回上诉，维持原判。

In the case of **administrative dispute** between the appellant Hangzhou Gekai Trading Co., Ltd. (“Gekai”) and the appellee State Administration for Market Regulation (“SAMR”), SAMR received an Application for Performance of Statutory Duties from Gekai on January 8, 2020, in which Gekai argued that Guangxi Yuchai Machinery Group Co., Ltd. (“Yuchai Company”) abused its market dominance and reached and implemented a monopoly agreement, which seriously infringed on the legitimate rights and interests of Gekai, and requested that SAMR investigate and punish Yuchai Company according to the law. On May 15, 2020, Gekai filed a lawsuit in Beijing No.1 Intermediate People's Court (the Court of First Instance) against SAMR, asserting that SAMR's failure to fulfill its duty to investigate the case and impose penalties within the legal deadline of two months constituted an administrative omission and seriously infringed Gekai’s legitimate rights and interests, and

requesting that SAMR be ordered to perform its statutory duties and respond to the application of Gekai. The Court of First Instance held that the deadline of anti-monopoly enforcement against the monopoly agreement and abuse of market dominance involved in the case was not stipulated in the Anti-monopoly Law, or the regulations formulated by SAMR including the Interim Provisions on Prohibiting Monopoly Agreements and the Interim Provisions on Prohibiting Abuse of Dominant Market Positions; given the extraordinary complexity of anti-monopoly enforcement, no deadline is set in laws, regulations, or rules for SAMR to investigate and punish suspected monopolistic acts; in addition, SAMR held that it had decided to directly handle and verify the reported clues provided by Gekai. On these grounds, SAMR shall be found to have been performing duties regarding the issues reported by Gekai at the time that Gekai's filed this lawsuit; as Gekai's claims that SAMR did not perform its statutory duties within the statutory period of two months had no factual or legal basis, the claims of Gekai were rejected in the judgment. Not satisfied with the first-instance judgment, Gekai appealed to the Supreme People's Court. On December 16, 2021, the Supreme People's Court rejected the appeal and affirmed the judgment of the first instance.

【裁判意见】

### [Judge's Opinion]

最高人民法院二审认为，根据格凯公司提交的《履行法定职责申请书》，格凯公司请求市场监管总局依法查处的事项涉及玉柴专卖公司滥用市场支配地位、达成并实施垄断协议等两类涉嫌垄断行为的调查。行政处罚法、反垄断法以及市场监管总局的部门规章对本案所涉及的反垄断调查行为未设定法定期限。但是，这并不意味着市场监管总局不需要在一个合理期限内履行法定职责。对于合理期限的确定，要根据涉嫌垄断行为的性质、相关调查行为的难易程度、影响范围等因素综合考量。本案中，关于涉嫌垄断行为的性质，格凯公司举报的垄断行为涉嫌滥用市场支配地位以及达成并实施垄断协议，反垄断执法机构需要经过必要的调查，决定是否立案。关于相关调查行为的难易程度，根据市场监管总局陈述，由于本案举报线索发生地涉及广西、浙江、江苏等多个省、自治区，市场监管总局已决定由该局直接办理并开展核查；且认定某一行为是否构成垄断行为，需要经过复杂审慎的取证、评估及论证。关于相关调查行为的影响范围，由于反垄断调查对企业经营活动和社会经济秩序都将造成影响，为提高执法的准确性、严肃性，防止权力不当行使甚至滥用，反垄断法对调查行为采取的措施以及相关行政程序作出了更加审慎的规定。反垄断法第三十九条要求，采取相应调查措施的，“应当向反垄断执法机构主要负责人书面报告，并经批准”。上述因素都导致反垄断调查所需的时间通常远多于一般的行政执法。

In the trial of second instance, the Supreme People's Court held that the matters that Gekai requested SAMR to investigate according to law in the Application for Performance of Statutory Duties submitted by Gekai involved the investigation of two types of suspected monopolistic acts, including the abuse of market dominance and the conclusion and implementation of monopoly agreements by Yuchai Company. The deadline of anti-monopoly investigation actions involved in the case was not stipulated in the Administrative Penalty Law, Anti-monopoly Law, or the regulations of SAMR. However, this does not mean that SAMR is not required to perform its statutory duties within a reasonable period. This reasonable period shall be determined based on the nature of the suspected monopoly act, the difficulty of the investigation actions, the scope of influence and other general factors. In this case, regarding the nature of the suspected monopolistic acts, the anti-monopoly enforcement agency shall conduct necessary investigations before deciding whether to open a case for the monopolistic acts reported by Gekai which were suspected of abuse of market dominance and the conclusion and implementation of monopolistic agreements. Regarding the difficulty of the investigation actions as stated by SAMR, since the reported clues in this case occurred in several provinces (including Guangxi, Zhejiang

and Jiangsu) and autonomous regions, SAMR has decided that it will directly handle and perform the verification; in addition, determining whether a certain act constitutes a monopoly act, would be a complex and prudent process of evidence collection, evaluation and demonstration. Regarding the scope of influence of relevant investigation actions, as anti-monopoly investigations have an impact on business activities and social & economic order, the Anti-monopoly Law contains more prudent provisions concerning the measures and administrative procedures used in investigation actions in order to improve the accuracy and seriousness of law enforcement and to prevent the improper exercise and even abuse of power. Article 39 of the Anti-monopoly Law requires that the adoption of corresponding investigation measures "shall be reported in writing to and approved by the head of the anti-monopoly enforcement agency". All the above factors lead to a longer period usually consumed by anti-monopoly investigations than that of general administrative enforcement.

本案中，格凯公司于 2020 年 1 月 8 日向市场监管总局提交书面举报，于 2020 年 5 月 15 日向一审法院起诉。根据反垄断法对涉嫌垄断行为调查的程序规定和实体判断标准，以及市场监管总局的相关部门规章和其内部案件处理规则，至格凯公司起诉时市场监管总局对举报事项仍处于合理的调查期限内。结合市场监

管总局已就举报事项与格凯公司进行联系，并综合考虑格凯公司所举报查处的事项以及其所提供相关事实和证据，市场监管总局不构成行政不作为。一审法院认定格凯公司提起本案诉讼时，市场监管总局对举报事项处于正在履责状态之中，并无不当。

In this case, Gekai submitted a written report to SAMR on January 8, 2020 and filed a lawsuit in the Court of First Instance on May 15, 2020. According to the procedural provisions and substantive judgment standards for the investigation of suspected monopolistic acts under the Anti-monopoly Law, as well as applicable regulations of SAMR and its internal rules for handling cases, SAMR was still in a reasonable period of investigation on the reported matters at the time of the lawsuit filed by Gekai; in addition, given these matters reported by and the supporting facts and evidence provided by Gekai as well as the fact that SAMR had contacted Gekai on the reported matters, SAMR did not commit an administrative omission. It is not inappropriate that the Court of First Instance found that SAMR did not act improperly as it was in the process of performing its duties when Gekai filed the lawsuit.

## 50. 涉及同一合同的合同之诉与垄断协议之诉的重复诉讼认定

### **Determination of repetitive litigations concerning a**

**contractual lawsuit and a monopoly agreement lawsuit based  
on the same contract**

**【裁判要旨】**

**[Judgment Digest]**

涉及同一合同的合同之诉和垄断协议之诉，分别涉及合同法律关系和反垄断法律关系，诉讼标的不同，即便所涉当事人相同或者后诉的诉讼请求实质否定前诉裁判结果，其亦不构成重复诉讼，但原则上宜由一个法院合并审理为宜。

A contractual lawsuit and a monopoly agreement lawsuit based on the same contract respectively concern contractual legal relation and anti-monopoly one. Lawsuits with different subject matters, even if involving the same parties or the claims in the latter lawsuit essentially negate the outcome of the former one, do not constitute repetitive litigation on the same dispute. However, in principle, it is appropriate for a court to adjudicate the separate cases together.

**【关键词】**

**[Keywords]**

垄断协议 管辖 重复诉讼

monopoly agreement; jurisdiction; repetitive litigations on the same dispute

**【案号】**

## **[Case Number]**

(2021) 最高法知民辖终 187 号

(2021) SPC IP Civil Jurisdiction Final 187

## **【基本案情】**

### **[Case Facts]**

在上诉人商丘市龙兴制药有限公司（以下简称龙兴公司）与被上诉人湖北拓思医药有限公司（以下简称拓思公司）垄断协议纠纷管辖权异议案中，龙兴公司与拓思公司于 2019 年 2 月 25 日签订《代理协议》，约定龙兴公司将其生产的奥硝唑原料药授权拓思公司全国独家经销。另约定，该协议在履行过程中发生争议应首先通过协商的方式解决，协商不成，向拓思公司所在地人民法院起诉。双方在履行《代理协议》过程中发生争议，拓思公司先向湖北省咸宁市咸安区人民法院（以下简称咸安区法院）提起合同违约之诉，要求龙兴公司承担违约责任并继续履行《代理协议》案号为（2020）鄂 1202 民初 3390 号。龙兴公司以本案涉及垄断纠纷为由提出管辖权异议，咸安区法院驳回其管辖权异议。龙兴公司不服，上诉至湖北省咸宁市中级人民法院，但未获支持。后龙兴公司向湖北省武汉市中级人民法院（以下简称一审法院）提起垄断之诉，请求判令双方签订的《代理协议》为垄断协议并认定拓思公司相关行为构成滥用市场支配地位行为。拓思公司提出管辖权异议，主张本案诉讼已经由咸安区法院依法受理，龙兴公司为规避管辖和拖延诉讼，就同一事实向一审法院提起诉讼属于重

复起诉，本案应由咸安区法院管辖。一审法院认为，本案系合同纠纷案件，《代理协议》的主要内容为龙兴公司就其生产的奥硝唑原料药授权拓思公司全国独家经销的相关事宜所作约定，其不具备法律所禁止的垄断协议的性质，本案不属于垄断纠纷案件，拓思公司提出的管辖权异议成立。据此，裁定将本案移送咸安区法院处理。龙兴公司不服，向最高人民法院提起上诉。最高人民法院于2021年8月19日裁定撤销原裁定，本案由湖北省武汉市中级人民法院审理。

In the case of jurisdictional objection over a monopoly agreement dispute between the appellant Shangqiu Longxing Pharmaceutical Co., Ltd. (“Longxing”) and the appellee Hubei Tuosi Pharmaceutical Co., Ltd. (“Tuosi”), Longxing and Tuosi signed an “Agency Agreement” on February 25, 2019, agreeing that Longxing would authorize Tuosi to exclusively distribute the ornidazole API produced by Longxing all over China. It was also agreed that disputes arising in the performance of the agreement should first be resolved by way of consultation, and should the consultation fail, the parties may file a lawsuit with the people's court in the place where Tuosi is located. In the performance of the Agency Agreement, a dispute arose between the parties. Tuosi first filed a lawsuit for breach of contract in Xian'an District People's Court of Xianning City, Hubei Province (Xian'an District Court) in case number (2020)

E 1202 Civil 3390, requesting that Longxing assume liability for breach of contract and continue the performance of the Agency Agreement. Longxing raised an objection to jurisdiction on the grounds that the case involved a monopoly dispute, and Xian'an District Court rejected its objection to jurisdiction. Longxing appealed to the Intermediate People's Court of Xianning City, Hubei Province, but the appeal was rejected. Thereafter, Longxing filed a monopoly lawsuit with the Intermediate People's Court of Wuhan City, Hubei Province (the Court of First Instance), requesting that the Agency Agreement between the parties be determined a monopoly agreement and relevant behaviors of Tuosi constitute an abuse of market dominance. Tuosi raised an objection to jurisdiction, claiming that the lawsuit had been accepted by Xian'an District Court and that Longxing filed a lawsuit in the Court of First Instance on the same fact to avoid jurisdiction and delay the lawsuit shall constitute a repetitive litigation on the same dispute, and the case should be under the jurisdiction of Xian'an District Court. The Court of First Instance held that the case concerned a contract dispute, and the Agency Agreement mainly set forth the terms and conditions based on which Longxing authorized Tuosi to exclusively distribute the ornidazole API produced by Longxing all over China, without any properties of a monopoly prohibited by law, so the case was not

a monopoly dispute case, and the jurisdictional objection raised by Tuosi was established. On this basis, it was ruled that the case should be transferred to Xian'an District Court. Longxing was unsatisfied and appealed to the Supreme People's Court. On August 19, 2021, the Supreme People's Court ruled that the original judgment was revoked and the case should be heard by the Intermediate People's Court of Wuhan City, Hubei Province.

### **【裁判意见】**

#### **[Judge's Opinion]**

最高人民法院二审认为，判断是否构成重复诉讼应当比较当事人、诉讼标的、诉讼请求三个构成要素，是否存在当事人相同、诉讼标的相同、诉讼请求相同或者后诉的诉讼请求实质上否定前诉裁判结果的情形。就本案双方当事人之间的纠纷而言，（2020）鄂1202民初3390号案为合同之诉，双方当事人争议的是涉案合同当事人是否构成违约、涉案合同是否应当继续履行的问题；本案为垄断之诉，双方当事人争议的是涉案协议是否构成垄断协议的问题。两案纠纷所涉诉讼标的不同，不满足《最高人民法院关于适用〈中华人民共和国民事诉讼法〉的解释》（以下简称民事诉讼法司法解释）第二百四十七条第一款第二项关于后诉与前诉诉讼标的相同这一要件，因而本案不构成重复诉讼。

In the trial of second instance, the Supreme People's Court held that, to determine whether there is a repetitive litigation, the three

constituent elements, i.e. the parties, the objects of actions and the claims, should be respectively compared to find out if they were the same, or if the latter claims substantially negated the judgment entered in the former lawsuit. In terms of the dispute between the two parties in this case, the lawsuit numbering (2020) E 1202 Civil 3390 concerned a contract, and the parties had a dispute over whether the party of the contract in question committed a breach of contract, and whether the contract involved should be further upheld; while this case is about a monopoly lawsuit and the parties had a dispute over whether the agreement involved constituted a monopoly agreement. The two cases are about disputes over different objects of lawsuits, which is inconsistent with the requirement in Article 247(1) (2) of the *Interpretation of the Supreme People's Court on the application of the Civil Procedure Law of the People's Republic of China* (the Judicial Interpretation of the Civil Procedure Law) that the latter and the former lawsuits should be about the same objects. Therefore, this case does not constitute a repetitive litigation.

## 八、技术类知识产权合同案件

### VIII. Technology-related Intellectual Property Contract cases

#### 51. 合同订立是否存在虚假意思表示的认定

##### **Determination of false expression of intent to conclude a contract**

##### **【裁判要旨】**

##### **[judgment Digest]**

关于当事人是否以虚假意思表示订立合同的判断，一般可以按照如下步骤认定：一是审查合同主给付义务是否具备特定类型合同项下主给付义务的基本特征；如不具备，则可以初步认定订立合同时存在虚假意思表示。二是根据当事人订立合同前后的情况和实际履约行为等事实，进一步认定订立合同时所隐藏的真实意图。三是综合全案案情，如果上述两个方面的认定可以相互吻合并能够排除合理怀疑，则可以最终认定当事人以虚假意思表示订立合同。

Whether parties conclude a contract based on a false expression of intent can generally be determined by the following steps: first, reviewing whether the main obligation of payment under the

contract has the basic characteristics of the main obligation of payment under a particular type of contract; if not, the contract can initially be found to be concluded with a false expression of intent; second, further determining the true intent hidden at the time of concluding the contract based on the circumstances, actual performance and other facts existing before and after the parties entered into the contract; third, considering the overall facts of the case, i.e. if the above two determinations are consistent with each other and can eliminate reasonable doubt, then the parties can finally be found to have concluded the contract with a false expression of intent.

**【关键词】**

**[Keywords]**

技术秘密 许可协议 虚假意思表示 合同无效

technical secrets; license agreement; false expression of intent;  
invalidity of a contract

**【案号】**

**[Case Number]**

(2021) 最高法知民终 809 号

(2021) SPC IP Civil Final 809

**【基本案情】**

**[Case Facts]**

在上诉人江苏中关村科技产业园控股集团有限公司（以下简称中关村公司）与上诉人斯太尔动力（江苏）投资有限公司（以下简称斯太尔江苏公司）、被上诉人斯太尔动力（常州）发动机有限公司（以下简称斯太尔常州公司）、原审第三人斯太尔动力股份有限公司（以下简称斯太尔股份公司，斯太尔江苏公司、斯太尔常州公司、斯太尔股份公司以下统称三斯太尔公司）技术秘密许可使用合同纠纷案中，斯太尔股份公司与江苏中关村科技产业园洽谈在当地投资建厂事宜。根据当地的招商引资政策以及斯太尔股份公司计划投资的项目规模，该公司预计可获得2亿元综合奖励。双方的关联公司签订涉案技术许可协议，由中关村公司支付2亿元许可使用费获得斯太尔股份公司柴油发动机的全部商业秘密和核心技术，中关村公司将该笔款项打入其指定的账户并对该笔资金进行监管。上述合同签订4个月后斯太尔股份公司出具回购方案，承诺以2亿元价格回购合同约定的商业秘密和核心技术。该笔交易披露后，中国证监会予以关注并开展调查。斯太尔股份公司后续未在当地投资建厂。中关村公司向江苏省高级人民法院（以下简称一审法院）提起诉讼，主张涉案技术许可协议是为招商引资需要签订，并非双方真实意思表示，应当无效，斯太尔股份公司及关联公司应当返还2亿元资金。一审法院认为，涉案技术许可协议应系当事人为先行兑现2亿元投资奖励资金而签订，双方以虚假的意思表示实施的民事法律行为，故涉案技术许可协议系无效合同，故判决斯太尔江苏公司应向中关村公司返

还2亿元资金。中关村公司、斯太尔江苏公司均不服，向最高人民法院提起上诉。最高人民法院于2021年7月7日判决驳回上诉，维持原判。

In the dispute over the contract for licensed use of technical secrets between the appellants Jiangsu Zhongguancun Science And Technology Industrial Park Holding Group Co., Ltd. (“Zhongguancun Company”) and Steyr Motors (Jiangsu) Investment Co., Ltd. (“Steyr Jiangsu Company”) and the appellee Steyr Motors (Changzhou) Engine Co., Ltd. (“Steyr Changzhou Company”) and the third party in the trial of first instance Steyr Motors Corp. (Steyr Corp., together with Steyr Jiangsu Company and Steyr Changzhou Company, collectively referred to as Three Steyr Companies), Steyr Corp. negotiated with Jiangsu Zhongguancun Science And Technology Industrial Park about its investment in the construction of a factory there. According to local investment attraction policies and based on the size of the project in which Steyr Corp. planned to invest, the company expected to receive a comprehensive incentive of CNY 200 million. The affiliates of the parties signed the technology license agreement involved in the case, under which Zhongguancun Company paid royalties of CNY 200 million in return for all trade secrets and core technologies of Steyr Corp. related to the diesel engines to its designated account and placed the

fund under supervision. Four months after this contract was signed, Steyr Corp. issued a repurchase plan, promising to repurchase the trade secrets and core technologies agreed in the contract at a price of CNY 200 million. After the disclosure of the transaction, the CSRC paid attention to it and initiated an investigation. Steyr Corp. did not invest in the construction of a local factory thereafter. Zhongguancun Company filed a lawsuit in the Higher People's Court of Jiangsu Province (the Court of First Instance), claiming that the technology license agreement involved in the case was concluded for the purpose of attracting investment other than an expression of true intent of the parties and should be invalid, and that Steyr Corp. and its affiliates should return the amount of CNY 200 million. The Court of First Instance held that the technology license agreement was signed by the parties for the purpose of cashing in the investment incentive of CNY 200 million, which was a civil legal act committed by the parties with a false expression of intent, so the technology license agreement shall be an invalid contract. On these grounds, it was ruled that Steyr Jiangsu Company should return the amount of CNY 200 million to Zhongguancun Company. Zhongguancun Company and Steyr Jiangsu Company were unsatisfied and appealed to the Supreme People's Court. On July 7, 2021, the Supreme People's Court rejected the appeal and affirmed

the original judgment.

【裁判意见】

[Judge's Opinion]

最高人民法院二审认为，在我国法律体系中，对典型合同分类定性的基本依据是合同项下的主给付义务（含给付标的）。对于双方当事人签订合同是否存在虚假意思表示，首先可以根据主给付义务的真实情况进行判定。就一般技术许可协议而言，有关主给付义务为两项：一是许可方向被许可方提供约定的技术，被许可方获得技术后可以在约定期限按照约定方式使用；二是被许可方向许可方支付约定的许可使用费，许可方收取许可使用费后一般可自由支配。本案中，涉案技术许可协议项下，两项主给付义务均不具备上述一般技术许可协议项下主给付义务的基本特征，主要表现为两方面：一是许可方斯太尔江苏公司不仅不能自由支配被许可方中关村公司支付的许可使用费 2 亿元，而且其全资子公司斯太尔股份公司还要如数返还中关村公司；二是中关村公司并不能在合同约定有效期 10 年内实际使用约定技术，而是在订约后 11 个月内拟由斯太尔股份公司以 2 亿元“回购”涉案技术。基于涉案技术许可协议项下两项主给付义务均不具备一般技术许可协议项下被许可方可依约使用技术、许可方可自由支配许可使用费的基本特征，可以初步认定双方当事人并无签订法律意义上的技术许可协议的真实意思表示。其次，根据双方当事人订立合同前后的情况和履约行为等相关事实，一审法院认定中关

村公司与斯太尔江苏公司签订涉案技术许可协议所隐藏的真实意图是配合斯太尔股份公司利用江苏省溧阳市人民政府的有关招商政策获得政府先行兑现的2亿元招商奖励金，并无不当。最后，综合全案案情，本案上述根据中关村公司与斯太尔江苏公司双方主给付义务对其意思表示虚假性的认定，与根据双方当事人订立合同前后的情况和履约行为等相关事实对双方订立合同所隐藏的真实意图的认定，可以相互吻合，并能够排除合理怀疑。据此，本案有充分事实和法律依据最终认定该双方当事人以虚假的意思表示订立合同。

In the trial of second instance, the Supreme People's Court held that in China's legal system, the basic basis for classifying and determining the nature of a typical contract is the main obligation of payment under the contract (including the subject matter of the payment). Whether there is a false expression of intent in the contract signed by the parties can be determined firstly according to the actual circumstance concerning the main obligation of payment. For a general technology license agreement, there are two main payment obligations: one is that the licensor provides the agreed technology for the licensee, and the licensee can use the technology in the agreed manner within the agreed period; the other is that the licensee pays the agreed royalties to the licensor, and the licensor is generally free to use the royalties received. In this case, neither of

the two main obligations to pay under the technology license agreement in question have the basic characteristics of the main obligation of payment under the general technology license agreement mentioned above, mainly in two respects: firstly, the licensee Steyr Jiangsu Company is not entitled to freely dispose of the royalties paid by the licensee Zhongguancun Company, and its wholly-owned parent company Steyr Corp. shall return the amount to Zhongguancun Company in full; secondly, Zhongguancun Company cannot actually use the technology agreed within the 10 years' contract term which would be "repurchased" by Steyr Corp. within 11 months after signature of the contract at CNY 200 million. Based on the fact that neither of the two main obligations to pay under the technology license agreement have the basic characteristics of the licensee's use of the technology and the licensee's free disposal of the royalties as agreed under the general technology license agreement, it can be preliminarily concluded that the parties did not have true intent to conclude a technology license agreement in the legal sense. In addition, based on the facts before and after the conclusion of the contract and the performance of the parties, the Court of First Instance found that the true intent of Zhongguancun Company and Steyr Jiangsu Company in signing the technology license agreement involved in the case was to assist

Steyr Corp. in receiving the investment incentive of CNY 200 million from the government first according to the investment attraction policies of the People's Government of Liyang City, Jiangsu Province, which was not inappropriate. Finally, given all the facts of the case, the above determination that Zhongguancun Company and Steyr Jiangsu Company had a false expression of intent based on their main obligations of payment, and the determination of the true intent concealed beneath this contract in line with the facts before and after their conclusion of the contract and the performance of the parties are consistent with each other and can eliminate reasonable doubt. On these grounds, there is a sufficient factual and legal basis in this case to ultimately conclude that the parties entered into the contract with a false expression of intent.

## 52. 管辖争议中履行地点无约定或约定不明时合同履行地的认定

### **Determination of jurisdictional contract performance place**

#### **where no place is agreed or such an agreement is ambiguous**

#### **【裁判要旨】**

#### **[Judgment Digest]**

民事诉讼法司法解释第十八条第二款关于“合同对履行地

点没有约定或者约定不明确，争议标的为给付货币的，接收货币一方所在地为合同履行地”之规定所称“争议标的”，是指当事人诉讼请求所指向的具体合同义务。诉讼请求为给付金钱的，不应简单地以诉讼请求指向金钱给付义务而认定争议标的即为给付货币，而应当根据合同具体内容明确其所指向的合同义务。

For the purpose of Article 18(2) of the Judicial Interpretation of the Civil Procedure Law which stipulates that "if the place of performance is not agreed in the contract or such an agreement is ambiguous, and the object of dispute is the payment of money, the location of the party receiving the money shall be the place of performance of the contract", the "object of dispute" refers to the specific contractual obligation as referred to in the litigant's pleadings. When a claim concerns the payment of money, the object of dispute shall not be determined as the payment of money simply on the grounds that the claim concerns an obligation to pay money. Instead, it is required to identify the contractual obligation to which the dispute relates according to specific contractual terms.

**【关键词】**

**[Keywords]**

劳务派遣合同 管辖连结点 合同履行地

接收货币一方所在地 争议标的 给付金钱

labor dispatch contract; jurisdictional connection; place of

contract performance; location of the party receiving money; object of dispute; payment of money

### **【案号】**

#### **[Case Number]**

(2021) 最高法知民辖终 73 号

(2021) SPC IP Civil Jurisdiction Final 73

### **【基本案情】**

#### **[Case Facts]**

在上诉人航电建筑科技（深圳）有限公司（以下简称航电公司）与被上诉人上海盖讯信息技术有限公司（以下简称盖讯公司）劳务派遣合同纠纷管辖权异议案（以下简称航电公司等管辖权异议案）中，盖讯公司认为航电公司未按照约定支付服务费，故向上海知识产权法院（以下简称一审法院）提起诉讼，请求判令航电公司支付服务费及违约金。一审法院认为，虽然涉案合同的名称为《劳务派遣协议书》，但该协议约定航电公司委托盖讯公司提供软件开发服务，双方的合作模式为人员外派和项目程序开发服务外包相结合，人员派遣业务亦包含了技术开发服务，故本案属于计算机软件开发合同纠纷；盖讯公司因计算机软件开发合同纠纷向一审法院起诉请求判令航电公司支付服务费及违约金，为金钱给付之诉，而盖讯公司住所地位于上海市长宁区，属一审法院辖区，一审法院据此对本案享有管辖权。故裁定驳回航电公司提出的管辖权异议。航电公司不服，向最高人民法院提起

上诉，主张撤销一审裁定，将本案移送至广东省深圳市福田区人民法院审理。最高人民法院于2021年8月12日裁定撤销原裁定，本案移送上海市长宁区人民法院审理。

In the case of a jurisdictional objection to disputes under a labor dispatch contract between the appellant Avionics Construction Technology (Shenzhen) Co., Ltd. (“Avionics”) and the appellee Shanghai Gaixun Information Technology Co., Ltd. (“Gaixun”) (the Case of Avionics' Jurisdictional Objection), Gaixun argued that Avionics failed to pay the agreed service fee and therefore filed a lawsuit in Shanghai Intellectual Property Court (the Court of First Instance), requesting that Avionics be ordered to pay the service fee and liquidated damages. The Court of First Instance held that despite the fact that the contract was entitled "Labor Dispatch Agreement", the case shall be determined as a dispute over a computer software development contract as the parties agreed therein that Avionics commissioned Gaixun to provide software development services under a cooperation model combining personnel dispatch with outsourcing of project program development services, and the personnel dispatch service also included technology development services; Gaixun filed a lawsuit in the Court of First Instance for the dispute over a computer software development contract, requesting Avionics be ordered to pay the service fee and liquidated damages,

constituting a monetary payment lawsuit, while Gaixun is located in Changning District, Shanghai, which is a jurisdiction of the Court of First Instance, meaning that the Court of First Instance have jurisdiction over the case. On these grounds, it was ruled that the jurisdictional objection raised by Avionics was rejected. Avionics was unsatisfied and appealed to the Supreme People's Court, claiming that the first-instance ruling should be revoked and that the case should be transferred to the People's Court of Futian District, Shenzhen, Guangdong Province for trial. On August 12, 2021, the Supreme People's Court ruled that the original ruling should be reversed, and the case was transferred to Changning District People's Court of Shanghai for trial.

### **【裁判意见】**

#### **[Judge's Opinion]**

最高人民法院二审认为，涉案协议为派遣能够提供专业开发和技术顾问服务人员的劳务派遣协议，并非具体的计算机软件开发协议，故本案纠纷不是计算机软件开发合同纠纷，而是劳务派遣合同纠纷。民事诉讼法第二十三条规定：“因合同纠纷提起的诉讼，由被告住所地或者合同履行地人民法院管辖。”民事诉讼法司法解释第十八条第二款规定：“合同对履行地点没有约定或者约定不明确，争议标的为给付货币的，接收货币一方所在地为合同履行地。”该规定所称“争议标的”是指当事人诉讼请求所

指向的具体合同义务。诉讼请求为给付金钱的，不应简单地以诉讼请求指向金钱给付义务而认定争议标的即为给付金钱，而应根据合同具体内容明确其所指向的合同义务。本案系劳务派遣合同纠纷，当事人在本案中诉请履行的义务是支付劳务派遣服务费，故可以以此确定合同履行地为接收货币一方所在地。盖讯公司住所地位于上海市长宁区，上海市长宁区人民法院作为接收货币一方所在地的合同履行地法院，对本案具有管辖权。

In the trial of second instance, the Supreme People's Court held that the agreement involved in the case constituted a labor dispatch agreement on dispatching competent professional developers and technical consultants, rather than a specific computer software development agreement, meaning that the dispute involved in the case was not a dispute over a computer software development contract, but over a labor dispatch contract. Article 23 of the Civil Procedure Law stipulates that "an action involving a contractual dispute shall come under the jurisdiction of the people's court of the place where the defendant is domiciled or where the contract is performed". Article 18(2) of the Judicial Interpretation of the Civil Procedure Law stipulates that "if the place of performance is not agreed in the contract or such an agreement is ambiguous, and the object of dispute is the payment of money, the location of the party

receiving the money shall be the place of performance of the contract". The "object of dispute" therein refers to the specific contractual obligation for which the parties file a claim. When a claim is for the payment of money, the object of dispute shall not be determined as the payment of money simply on the grounds that the claim concerns an obligation to pay money. Instead, it is required to identify the contractual obligation to which the dispute is related according to specific contractual terms. The case concerns a labor dispatch contract issue, and the obligation requested by the parties for performance in this case is to pay the labor dispatch service fee so that the place where the receiving party is located can be determined as the place of performance of the contract. As Gaixun is domiciled in Changning District, Shanghai, Changning District People's Court of Shanghai, as the court in the place where the receiving party is located can be determined as the place where the contract is performed, and has jurisdiction over this case.

### 53. 劳务派遣合同与技术开发合同的区分认定

#### **Distinction between a labor dispatch contract and a technical development contract**

#### **【裁判要旨】**

### **[Judgment Digest]**

合同主要条款为派遣人员要求、派遣工作期间、人员级别评估、人员费用结算，且人员费用结算的主要依据为人员级别评估而非技术开发成果，合同亦未明确约定技术开发有关具体权利义务的，一般可以认定该合同属于劳务派遣合同而非技术开发合同

When a contract mainly sets forth requirements for dispatching personnel, the dispatch work period, personnel level evaluations, and the settlement of payments for personnel which is generally based on personnel level evaluations rather than technology development results, and no specific rights and obligations related to technology development are clearly agreed upon in the contract, the contract can generally be considered a labor dispatch contract rather than a technology development contract.

### **【关键词】**

#### **[Keywords]**

技术开发合同 劳务派遣合同 管辖 案由

technical development contract; labor dispatch contract; jurisdiction; causes of action

### **【裁判意见】**

#### **[Judge's Opinion]**

在前述航电公司等管辖权异议案中，最高人民法院指出，双方签订的《劳务派遣协议书》虽然约定由盖讯公司为航电公司提

供软件开发服务, 但是合同的主要条款约定的是关于委托派遣人员、派遣期间、派遣人员的级别评估及结算单价等内容, 并未对软件开发的相关权利义务作出明确约定。该协议项下的费用支付以航电公司所确认的派遣人员的实际评估及级别为主要依据, 而非以某个软件开发完成作为结算条件, 显然该协议未涉及到具体的软件开发任务, 系劳务派遣协议。因此, 涉案协议为派遣能够提供专业开发和技术顾问服务人员的劳务派遣协议, 并非具体的计算机软件开发协议, 故本案纠纷不是计算机软件开发合同纠纷而是劳务派遣合同纠纷。劳务派遣合同纠纷不属于知识产权法院管辖的第一审民事案件, 本案移送上海市长宁区人民法院审理。

In the aforementioned case on dispute over Avionics' jurisdictional objection, the Supreme People's Court pointed out that although the parties agreed in the "Labor Dispatch Agreement" that Gaixun would provide software development services for Avionics, the main terms of the contract concerned the entrustment of dispatching personnel, the dispatch period, evaluations on the levels of the dispatched personnel and the unit price of settlement, and so on, without any explicit agreements on the rights and obligations related to software development. The payment under the agreement was mainly based on the actual evaluations and levels of the dispatched personnel as confirmed by Avionics, rather than on the condition of completing a certain software development. Obviously,

the agreement involved no specific software development task and was a labor dispatch agreement. Therefore, the agreement involved in the case constituted a labor dispatch agreement on dispatching personnel competent to provide professional development and technical consultancy services, rather than a specific computer software development agreement. Therefore, the dispute involved in the case was not a dispute over a computer software development contract, but a dispute over a labor dispatch contract. As cases of labor dispatch contract disputes are not civil cases of first instance within the jurisdiction of intellectual property courts, this case was transferred to Changning District People's Court of Shanghai for trial.