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## §101 专利保护客体的确定标准：澄清 *In re Bilski* 决定

*In re Ferguson*, \_\_\_ F.3d \_\_\_, No. 2007-1232 (Fed. Cir. Mar. 6, 2009)

在今年 3 月 6 日做出的 *In re Ferguson* 决定中，联邦巡回法院对 §101 专利保护客体问题给出了另外一种意见。该案中的技术涉及一种将产品推向市场的销售模式。合议庭由 Mayer，Gajarsa 和 Newman 三位法官组成，他们维持了专利局冲突暨上诉委员会（BPAI）的终局决定，支持审查员驳回 Ferguson 专利申请中包括方法权利要求和“模式”权利要求在内的 68 项权利要求。

首先，对于方法权利要求，联邦法院认为，尽管它们名义上落入方法权利要求的范畴，但是并不符合 *In re Bilski* 中确立的标准，既没有与任何特定的设备或装置进行结合，也没有将任何事物转变成另一种状态或其它事物。申请人提出，这些方法需要由营销人员使用，因此满足 *In re Bilski* 中的要求，联邦法院认为，销售人员不是 *In re Nuijten* 案件中定义的设备或装置，故此驳回申请人的抗辩。尽管 Ferguson 申请中的方法权利要求涉及在构建销售队伍（或营销公司）中组织商业或者法律关系，但是联邦法院裁定，这种“带有目的的转化或者操作……不符合要求，因为它们不是实体或者物质，也不代表实体或者物质”。

其次，联邦法院对其最近的 *In re Bilski* 决定做出澄清，该案中的“有用、具体并且有形的结果”测试标准无效。

最后，对于模式权利要求，法院认为没有必要判断 Ferguson 中的模式权利要求具体落入哪一类法定专利保护客体，而且这些权利要求也无法满足任何一类保护客体的条件。申请人辩称，它将公司限定为“物质”并且将其比拟为一台设备而要求保护，联邦法院对此予以驳回，因为模式权利要求没有引用“具体的东西，构成部件，或者特定的装置及其组合”。此外，这些权利要

求要求保护的是抽象的想法，即，用于无形的营销公司的商业模式，因此不应该得到专利保护。

此处可获得本案意见书：<http://www.cafc.uscourts.gov/opinions/07-1232.pdf>。

**A case regarding the standards for patentable subject matter under Section 101 of the U.S. Patent Laws, clarifying the Federal Circuit’s *In re Bilski* decision**

*In re Ferguson*, \_\_\_ F.3d \_\_\_, No. 2007-1232 (Fed. Cir. Mar. 6, 2009)

In *In re Ferguson*, on March 6, 2009, the Federal Circuit issued another opinion concerning patentable subject matter under 35 U.S.C. § 101. The technology at issue in this case was a marketing paradigm for bringing products to market. The Federal Circuit (Judges Mayer and Gajarsa with Judge Newman concurring in the judgment) affirmed the Board of Patent Appeals and Interference’s final decision sustaining the examiner’s rejection of all 68 claims of the Ferguson patent application, which included method claims and “paradigm” claims.

First, as to the method claims, the Federal Circuit found that they at least nominally fell into the category of process claims, but ruled that these claims were not tied to any particular machine or apparatus and did not transform any article into a different state or thing, as require under *In re Bilski*. The court rejected the argument that the method claims satisfied this test because they were tied to the use of a shared marketing force, finding that a marketing force is not a machine or apparatus as defined in its *In re Nuijten* decision. Although the Ferguson application’s method claims were directed to organizing business or legal relationships in the structuring of a sales force (or marketing company), the Federal Circuit held that such “[p]urported transformations or manipulations . . . cannot meet the test because they are not physical objects or substances, and they are not representative of physical objects or substances.”

Next, the Federal Circuit clarified its recent decision in *In re Bilski*, noting that it held in *Bilski* that the “useful, concrete, and tangible result” test is *not* valid.

Finally, regarding the paradigm claims, the court stated that it was unnecessary to determine the particular class of statutory subject matter into which Ferguson’s paradigm claims fell; these claims did not satisfy *any* of the categories. The applicants had characterized a company as “a physical thing” and claimed it therefore was “analogous to a machine,” but the Federal Circuit rejected this argument because the paradigm claims did not recite “a concrete thing, consisting of parts, or of certain devices and combination of devices.” Rather, they did no more than provide an abstract idea—a business model for an intangible marketing company—and were thus unpatentable.

A copy of the opinion may be found at <http://www.cafc.uscourts.gov/opinions/07-1232.pdf>.

**如何认定共同发明人资格**

*Nartron Corp. v. Schukra U.S.A., Inc.*, \_\_\_ F.3d \_\_\_, No. 2008-1363 (Fed. Cir. Mar. 5, 2009)

在题述案件中，地区法院在一审简易审理中判决，起诉状中的当事人一方缺少必要的原告。地区法院认为，上述案件中的一位当事人，Joseph Benson 先生，没有作为涉案美国专利 6,049,748 的一位共同发明人加入到诉讼中，所以撤销该案。2009 年 3 月 5 日，联邦法院二审时驳回地区法院的判决。联邦法院认为，Benson 对该专利申请的贡献实在是太微不足道，没有资格作为共同发明人，所以此案不需要 Benson 加入进来，地区法院可以继续审理。

Schukra 委托 Nartron 设计用于车座按摩的控制系统。Benson 是 Schukra 的一位雇员，向 Nartron 的项目组建议采用“用于腰部支持调节装置的延伸杆”，在从属权利要求 11 中包括了这项方案。但是，该专利并没有将 Benson 列为其中一位发明人。

联邦法院认为，Benson 对权利要求 11 的贡献很小，不足以使它成为这项专利的一位共同发明人。首先，与权利要求 11 的发明广度相比，Benson 建议的延伸杆仅是其中一小部分，而且从已知技术和现有车座的结构中均可以找到这种方案。换言之，联邦法院认为 Benson 的提议仅仅是从本领与普通技术人员角度出发。其次，'748 专利的重点并不在于 Benson 所提议的延伸杆结构上，而在于用来操作座椅的控制模块。

从属权利要求 11 包括权利要求 1，5 和 6 的全部技术特征，但是 Benson 并没有对这些特征做出任何贡献。联邦法院的结论是，仅仅因为对从属权利要求 11 中的思想作出贡献，却没有对权利要求 1，5 和 6 有任何贡献，所以 Benson 没有资格成为一名共同发明人。

简而言之，在评估项目组成员对权利要求的贡献时，要对其在各项权利要求中的贡献进行分析，并不是每个成员都需要作为发明人。仅仅对发明提出显而易见的建议的人，可能不会在专利申请中作为共同发明人。

此处可以获得判决意见书：<http://www.cafc.uscourts.gov/opinions/08-1363.pdf>.

### **A case further defining the requirements for co-inventorship in the United States**

*Nartron Corp. v. Schukra U.S.A., Inc.*, \_\_\_F.3d \_\_\_, No. 2008-1363 (Fed. Cir. Mar. 5, 2009)

On March 5, 2009, the Federal Circuit reversed a District Court's conclusion on summary judgment that the plaintiff had not joined a necessary party to the complaint. The District Court had dismissed the case because one of the parties, Mr. Joseph Benson, had not been "joined" in the litigation as a co-inventor to the patent at issue in the case. In reversing the district court's decision, the Federal Circuit concluded that Benson's contribution to the patent application had been too insignificant to sustain him

as a co-inventor and, therefore, there was no need to “join” Benson in the case and the case could proceed in the District Court.

Schukra contracted with Nartron to design a control system for car seat massages. Benson, a Schukra employee, provided the Nartron project team the idea of an “extender for a lumbar support adjustor” that eventually found its way into a third-level dependent claim in U.S. Patent 6,049,748. However, Benson was not listed as an inventor on the patent.

The Federal Circuit held that Benson’s contribution to claim 11 was insignificant to establish him as a co-inventor to the patent application. First, Benson’s idea of the extender for a lumbar support adjustor was insignificant when measured against the full dimension of the invention of claim 11, because it was both in the prior art and a part of existing car seats. In other words, the Federal Circuit found that Benson’s suggestion was merely an exercise of ordinary skill in the art. Second, the focus of the ’748 patent was not so much on the structure of the seat with Benson’s extender, but on the control module to operate the seat.

Finally, Benson was not entitled to co-inventorship because he did not contribute any ideas to the claims from which claim 11 depended. Dependent claim 11 included all features of claims 1, 5, and 6 and Benson did not contribute to any features of these claims. The Federal Circuit concluded that Benson was not entitled to co-inventorship simply by contributing an idea expressed in dependent claim 11 without any contribution to any of claims 1, 5, or 6.

In summary, it is important to evaluate the project team members’ respective contributions on a claim-by-claim basis because not every project team member is necessarily an inventor. Those who merely suggest obvious applications for the team’s inventions may not be entitled to co-inventorship status in the patent application.

The opinion may be obtained at <http://www.cafc.uscourts.gov/opinions/08-1363.pdf>.

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