

Morgan Lewis

***Design Around and Licensing Strategies  
in the Global IP environment***  
在全球知识产权环境下的规避设计及许可策略

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# *Presentation Outline* 纲要

- Sources of licensing offers 许可要约的来源
  - Patent trolls 专利投机者
  - Corporate licensing programs 公司许可计划
  - Patent pools 专利池
- Licensing strategies 许可策略
- The design around option 进行规避设计的选择权

# Trolls--怪物

- **Troll** - (in Scandinavian folklore) any of a race of supernatural beings, sometimes conceived as giants and sometimes as dwarfs, inhabiting caves or subterranean dwellings.
- 怪物：来自斯堪的纳维亚传说中的一种超自然生物，有时是巨怪有时是矮人，居住在山洞或者地下洞穴中



# *Patent Trolls* 专利投机者

- “Patent troll” is a controversial new word having multiple definitions. Among them is a party that: “专利投机者”是一个有争议的新词，它有很多定义。其中一些定义将之称为这样的一方当事人
  - Purchases a patent, often from a bankrupt firm or individual inventor, and then sues another company by claiming that one of its products infringes on the purchased patent;通常从破产公司或者个人发明人那里购买专利，然后通过诉称其他公司产品侵犯了他所购买的专利而提起诉讼

Source: Wikipedia 来源: 维基百科

# *Patent Trolls* 专利投机者

- Enforces patents against purported infringers without itself intending to manufacture the patented product or supply the patented service; 反对有意向的侵权者实施专利，而其本身并不制造专利产品或者提供专利服务
- Enforces patents but has no manufacturing or research base; or 实施专利，但是并没有生产或者研究基地；或者
- Focuses its efforts solely on enforcing patent rights. 仅将其努力集中在实施专利权上

**Orion IP LLC**  
**Patent Troll Asserting Internet-based Patents**  
**宣称基于互联网的专利的专利投机者**

- **Orion IP LLC - Patent holding company incorporated in Texas, 在德克萨斯成立的专利持有公司**
  - **March 2007 - Orion filed two suits the U.S. District Court for the Eastern District of Texas against 80 companies for allegedly violating two patents for online sales methods; 2007年3月, Orion在德州东区法院提起两个诉讼, 起诉80家公司侵犯了其在线销售方法的两个专利**
    - **One patent is for a computerized system that assists a salesperson in selecting appropriate parts needed by customers; 一个专利是帮助销售人员选择客户所需的适当部件的计算机化系统**
    - **The other patent involves an electronic system that creates customized product proposals; 另一个专利涉及产生定制产品方案的电子系统**

*Orion IP LLC*  
*Successful Assertion of Internet-based Patents*  
*成功主张了基于互联网的专利*

- Many companies settled with Orion IP by taking a license, including Philips Electronics North America Corp. Office Depot, AT&T Inc., LG Electronics MobileComm USA Inc., Pioneer Electronics (USA) Inc., Eastman Kodak Co., Casio Inc., Isuzu Motors America Inc., Maytag Corp, Whirlpool Corp., Nike Inc., Adidas America Inc. and Best Buy Co. Inc. ;
  - 许多公司通过接受许可与Orion IP 达成和解, 包括Philips Electronics North America Corp. Office Depot, AT&T Inc., LG Electronics MobileComm USA Inc., Pioneer Electronics (USA) Inc., Eastman Kodak Co., Casio Inc., Isuzu Motors America Inc., Maytag Corp, Whirlpool Corp., Nike Inc., Adidas America Inc. and Best Buy Co. Inc.

## Orion IP LLC

### Successful Assertion of Internet-based Patents

### 成功主张了基于互联网的专利

- May 2007 - a jury found that Hyundai Motor America willfully infringed one of the sales method patents. They ordered the company to pay \$34 million; 2007年5月—陪审团认为Hyundai Motor America 故意侵犯了其中一个销售方法，要求该公司支付3千4百万美元赔偿金
- 19 other motor vehicle sales companies settled before trial, including. 在审判之前其它19家汽车销售公司与其达成和解，包括Mercedes Benz, Rolls Royce, Maserati and Porsche

# Alliacense

- Alliacense claims that “[v]irtually every product manufactured utilizing microprocessors or embedded processors requires a license.”  
Alliacense 诉称“利用微处理器或者嵌入式处理器制造的每个产品都需要其授权许可”
- Patents allegedly describe the principal means used by the microprocessor industry to increase internal modern microprocessor operating speeds. 诉称的专利描述了一种微处理器工业中使用的主要装置，用于提高内置现代微处理器的操作速度

# Alliacense

- Alliacense claims that portfolio patents are essential to the design of advanced microprocessors, digital signal processors, embedded processors and system-on-chip devices. Alliacense诉称，其专利包对于设计先进的微处理器、数字信号处理器、嵌入式处理器和芯片系统装置是至关重要的
- The portfolio allegedly covers most end-user electronics. 该诉称的专利包覆盖了大多数终端用户电子产品

# Alliacense

## *Allegedly Infringing Products* 宣称的侵权产品

- Home appliances 家电
- Remote controls 遥控设备
- Smart cards 智能卡
- Digital cameras 数码相机
- Desktop personal computers 桌上个人电脑
- Portable computers and devices 便携式电脑和装置
- Workstations 工作站
- Video game players 视频游戏机
- Servers or Routers 服务器或者路由器
- Printers 打印机
- Home theater systems 家庭影院系统
- Digital televisions 数字电视机
- DVD recorders/players; DVD 录像机/播放器
- Portable media players 便携式媒体播放器
- Mobile handsets 移动手持装置
- Cellular phones 蜂窝电话

## *Alliacense Negotiation Style* *Alliacense*的谈判风格

- Alliacense seeks licenses by industry field and offer incentives to companies who take a license early. Thus, effectively penalizing those that wait. Alliacense根据行业领域寻求许可，并且给较早接受许可的公司以激励，这样有效地惩罚了那些观望的公司
- Alliacense proposes multi-tier royalty rates with steep discounts to early licensees and progressively higher rates to follow. Alliacense提出多级许可费率，对较早的被许可人给予很多折扣，然后费率逐步提高

## *Alliacense Negotiation Style* *Alliacense*的谈判风格

- Royalty base is based on average company sales over the entire life of the portfolio. 许可费基础建立在专利包整个寿命期内的平均公司销售额的基础上
- Alliacense negotiates aggressively once a company agrees to meet with them. 一旦某个公司同意与之会晤，Alliacense就开始咄咄逼人的谈判
- Alliacense gives companies little time to respond to an offer. Alliacense几乎不给别的公司反应其要约的时间

## *Alliacense*

### *400 Warning Letters and 20 Licensees*

*Alliacense*发出400封警告函获得20个被许可人

- Advanced Micro Devices
- Intel
- Hewlett-Packard
- Casio Computers
- Fujitsu
- Sony
- Nikon
- Seiko Epson
- Pentax
- Olympus
- Kenwood
- Agilent
- Lexmark
- Schneider Electric
- NEC
- Funai
- SanDisk

## *Alliacense Licensing Revenue* *Alliacense* 许可回报

- HP: \$20 – 26.4 M
- Casio: \$2.0 M
- Fujitsu: \$31.6 M
- Sony: \$19.4 M
- Nikon: \$1.9 M
- Seiko Epson: \$4.0 M
- Pentax: \$0.3 M
- Olympus: \$5.8 M
- Kenwood \$1.0 M
- Intel: \$10 M
- AMD: \$4.0 M
- NEC: undisclosed 未公开

**Sources:** Patriot SEC filings (SB-2, 10QSB, and 8-K (2005 – 2007))

来源 <http://www.nanalyze.com/forums>

<http://www.agoracom.com/ir/patriot>

# Alliacense Litigation

## Alliacense 诉讼

### The Complaint 诉状

- Filed 10/24/2005 in the Eastern District of Texas; 10/24/2005提交到德州东区法院
- Accuses the defendants of direct, contributory, and induced infringement; 诉称被告直接、共同并且诱发侵权
- Requests damages, enhanced damages, a permanent injunction, and attorneys' fees ; 要求支付赔偿金、提高的赔偿金、发出永久禁令，并且支付律师费

IN THE UNITED STATES DISTRICT COURT  
FOR THE EASTERN DISTRICT OF TEXAS  
MARSHALL DIVISION

FILED-CLERK  
U.S. DISTRICT COURT  
05 OCT 24 PM 4:43  
TX EASTERN-MARSHALL

Technology Properties Limited, Inc.,  
Plaintiff,  
vs.  
Fujitsu Limited, Fujitsu General America, Inc.,  
Fujitsu Computer Products of America, Inc.,  
Fujitsu Computer Systems Corp., Fujitsu  
Microelectronics America, Inc., Fujitsu Ten  
Corporation of America, Matsushita Electrical  
Industrial Co., Ltd., Panasonic Corporation of  
North America, JVC Americas Corporation,  
NEC Corporation, NEC Electronics America,  
Inc., NEC America, Inc., NEC Display  
Solutions of America, Inc., NEC Solutions  
America, Inc., NEC Unified Solutions, Inc.,  
Toshiba Corporation, Toshiba America, Inc.,  
Toshiba America Electronic Components, Inc.,  
Toshiba America Information Systems, Inc. and  
Toshiba America Consumer Products, LLC,  
Defendants

Civil Action No **2-05CV-494**  
BY \_\_\_\_\_  
**Jury Trial Demanded**

**COMPLAINT FOR PATENT INFRINGEMENT**

Plaintiff Technology Properties Limited, Inc., for its complaint against defendants Fujitsu Limited, Fujitsu General America, Inc., Fujitsu Computer Products of America, Inc., Fujitsu Computer Systems Corp., Fujitsu Microelectronics America, Inc., Fujitsu Ten Corporation of America, Matsushita Electrical Industrial Co., Ltd., Panasonic Corporation of North America, JVC Americas Corporation, NEC Corporation, NEC Electronics America, Inc., NEC America, Inc., NEC Display Solutions of America, Inc., NEC Solutions America, Inc., NEC Unified Solutions, Inc., Toshiba Corporation, Toshiba America, Inc., Toshiba America Electronic Components, Inc., Toshiba America Information Systems, Inc. and Toshiba America Consumer Products, LLC, alleges:

# *Accused Defendants* 被告

## Original defendants

最初的被告

- Fujitsu
- Matsushita
- Panasonic
- JVC
- NEC
- Toshiba

## Current defendants

目前的被告

- Matsushita
- Panasonic
- JVC
- NEC (chip making division only, 只是芯片制造部门)
- Toshiba
- ARM (intervened as defendant, 作为被告介入)

## Reexaminations 再审

- Multiple reexamination requests filed by NEC, Toshiba and an industry group for all three patents in litigation. NEC, Toshiba 和全部三个涉案专利的行业团体提交了多个再审请求
- US 5,784,584. The examiner has entered nine rejections under 35 U.S.C. §102(b), one rejection under 35 U.S.C. §102(a), and one rejection under 35 U.S.C. §102(e), relying on different prior art references for each rejection. US 5,784,584, 审查员依据每个驳回所对应的不同现有技术, 发出9个35 U.S.C. §102(b) 驳回和1个35 U.S.C. §102(b)驳回
- Reexaminations pending for US 5,809,336 and US 6,598,148. US 5,809,336 和 US 6,598,148的再审还处于待决状态

# HOW TROLLS THINK

## 专利投机者的想法

## *Trolls' Strategies* 专利投机者的策略

- Find patents that are applicable to the products or services of many companies; 找到能够应用到多个公司的产品和服务的专利
  - US legal system permits patent owner to sue hundreds of companies in the same lawsuit; 美国的司法系统允许专利权人在同一个诉讼中起诉数百家公司
    - No increase in the nominal court fee for filing a lawsuit (total court fee can be less than 1,000 RMB). 起诉费不会增加（整个法院收费会少于1000元人民币）

# *Alliacense Negotiation Style*

## *Alliacense*的谈判风格

- Complaint makes only general allegations for each defendant, such as the location of principal place of business and whether defendant is doing business in the court's district. 诉状可以只包括适用于每个被告的通用主张，例如主要营业地的地点和是否被告在法院辖区内从事了商业行为
- Defendant is making, using, selling, or importing infringing products in the jurisdiction. 被告在辖区内制造、使用、销售或者进口了侵权产品
- Defendant is willfully infringing so damages should be enhanced. 被告故意侵权，因此赔偿金应当增加

## *Trolls' Strategies* 专利投机者的策略

- **Pay as little legal fee as possible.** 支付尽可能少的诉讼费
  - Hire lawyer on “contingency basis” -- lawyer will be paid from legal judgment or settlement payments, e.g., typically 20% - 40%. 在“有条件付费”(风险诉讼)的基础上聘请律师—从法院判决或者和解的费用中支付律师费用，例如比例通常是20% - 40%.
- **Hire technical experts on contingency basis.** 在有条件付费的基础上聘请技术专家
- **Proceed with uniform discovery plan so that discovery requests can be used for each defendant.** 执行统一的取证计划，因此对于每个被告可以应用相同的取证请求

# *Trolls' Strategies* 专利投机者的策略

- Approach defendants for settlement immediately after filing of lawsuit; 起诉之后马上联系被告要与之和解
  - Propose settlement amount that is significantly less than the \$2M - \$5M+ fees and costs of litigation. 提出的和解数额大大低于 \$2M - \$5M+ 诉讼费用和支出
  - Offer much better terms to defendants that settle early to create momentum for other defendants to settle. 对与之较早达成和解的被告提供比较优惠的条件, 以便对其它要和解的被告提供动力
    - Settle with famous defendants that are known to potential jurors to create belief that patents must be strong. 与为潜在陪审员所知悉的著名被告达成和解, 以便给人以该专利很强的印象

## *Trolls' Strategies* 专利投机者的策略

- Keep some defendants in the lawsuit through trial to try to ‘hit the jackpot’ (Hyundai Motors suffered \$34M jury award when almost all other motor vehicle companies settled for 95% less). 保持在审判过程中有一些被告，以便“博头彩”（Hyundai Motors被陪审团要求支付3千4百万美元的赔偿金，而几乎所有其它汽车公司只支付了约5%的和解费用）
- Immediately inform other targets of companies that have taken licenses. 立刻通知已经接受许可的其它目标公司
  - Alliacense licensed Intel and AMD early to try to create industry recognition of its microprocessor portfolio. Alliacense先授权给Intel和AMD，以试图使业界认可其微处理器专利包

## *Trolls' Strategies* 专利投机者的策略

- Always emphasize that the “big” companies are making huge money by using the technology of the “small innovator” and refusing to pay for it. 总是强调，“大”公司正在利用“弱小发明人”的技术赚得大量金钱却不肯为该技术付费
  - Jury often does not recognize that the troll did not develop the patents and exists only to assert patents for money. 陪审团通常不会认识到专利投机者并不研发专利，且其存在只是为了通过宣告专利权而获利
- Pre-litigation licensing – frequently correspond and offer to meet with any target that shows willingness to discuss a license. 诉前许可—通常与表示出愿商讨许可的任何目标公司联系并且提出与之会晤
  - ‘Make the deal’. “达成协议”



# Corporate Licensing Programs

公司许可计划

# Corporate Licensing Programs

## 公司许可计划

- Companies with large patent portfolios offer competitors licenses in return for royalties 具有大专利包的公司向竞争者提供许可以获得专利费
- IBM
  - Reportedly receives \$1.5B(US) in annual licensing revenues, 据报道, 每年的许可费收益为15亿美元
  - Rate structure encourages package license; 许可费率结构鼓励打包许可
    - 1 patent = 1%; 1件专利= 1%
    - 2 patents = 2% ; 2件专利= 2%
    - 3 or more patents (frequently hundreds) = 3%;  
3件或更多 (通常是数百件) 专利= 3%

# Corporate Licensing Programs

## 公司许可计划

- Texas Instruments 德州仪器
  - Granted Samsung a 10 year patent license for \$1B(US); 给予三星10年10亿美元的专利许可
- Kodak
  - Actively pursuing industry-wide licensing program in digital still cameras; 在业界范围内积极进行数码相机的许可计划
- Thomson, Funai Electric, Zenith and others are actively licensing digital television patents; Thomson, Funai Electric, Zenith 和其它公司积极许可数字电视专利

# Corporate Licensing Programs

## 公司许可计划

- Corporate licensors usually know the industry situation very well; 公司许可者通常熟知业内状况
  - Familiar with technology and future trends; 熟悉技术和未来趋势
  - Know past market share and projections for the future; 了解过去的市场份额和未来规划
  - Will give credit for targets portfolio to the extent licensor is still active in the relevant fields; 在许可人在相关领域仍然积极发挥作用的程度内，目标专利包具有信誉
  - Frequently focus on maintaining a royalty rate structure; 常集中在如何维持许可费率结构上

# Patent Pools

## 专利池

## *Patent Pool Defined* 专利池定义

- Group of patents licensed from two or more companies agreeing to jointly license patents relating to particular technology 一组由两个或多个公司许可的专利，这些公司同意共同许可涉及特定技术的专利
  - Licensing agent may be either a new party responsible for licensing pooled patents or one of the patent holders; 许可方代表可以是对许可池专利负责的新成员或者是其中一个专利持有人

## *Patent Pool Defined* 专利池定义

- Patent Pool of Essential Patent vs. Rival Patents; 关键专利的专利池 v. 竞争专利
  - Pool should include patents on complementary technology; 专利池应当包括补充技术的专利
  - Pool should not include patents on competitive technologies; 专利池不应当包括竞争技术的专利

# History of Patent Pools

## 专利池的历史

- Sewing Machine Combination; 缝纫机的组合
  - Walter Hunt built America's first sewing machine in 1834, but declined to patent fearing it would cause unemployment; 1834年Walter Hunt 制造了美国第一台缝纫机，但是由于害怕导致失业而拒绝申请专利
  - Elias Howe received sewing patent in 1846, and sued others for using his invention; 1846年Elias Howe 获得缝纫机专利，然后起诉别人使用了他的发明
  - Isaac Singer patents improvement to designs by others; Isaac Singer 对其他人的设计改进而获得专利
  - Through the 1850s, a substantial number of patents were issued relating to sewing machines; 到1850年代，有大量关于缝纫机的专利获得授权
  - Companies started to sue each other over sewing machine patents; 这些公司互相之间开始就缝纫机专利提起诉讼
  - In 1856, the Sewing Machine Combination was formed from four companies: Signer, Howe, Wheeler and Wilson, and Grover and Baker; 1856年，由四家公司，Signer, Howe, Wheeler and Wilson, and Grover and Baker，成立缝纫机联合会
  - Combination lasted until 1877, when the last of the patents in pool expired; 该联合会持续到1877年专利池内最后一件专利届满

## *Patent Pools Overcome Problems*

### 专利池解决的问题

- **Blocking Patents** - multiple patents that are indispensable to make a product; 阻挡专利—对于制造一件产品互不可缺的多个专利
- **Stacking Licenses** – multiple licenses required because several companies own patents essential to the product; 架构许可—因为数家公司拥有对某产品很关键的专利因此需要多个许可
- **One stop source of license for patents owned by different entities**; 对于由不同实体拥有的专利，这是一站式许可来源



- “By balancing patent users’ interest in reasonable access with patent owners’ interest in reasonable return, MPEG LA creates the opportunity for adoption of new technologies and fuels innovation. Today MPEG LA clears patent thickets in licensing programs consisting of essential patents in 57 countries (<http://www.mpegla.com>).” “通过平衡专利使用者的合理利用途径和专利所有者的合理利益回报，MPEG LA创造了接纳新技术和促进创新的机会。今天，MPEG LA清除了在美国57个国家包括关键专利的许可项目中的专利“灌木丛”。”

# Licensing Strategies

## 许可策略

# *The Trolls* 专利投机

- **Make an informed decision; 基于可靠信息做出决定**
  - Evaluate the strength of the threat; 评估威胁的强度
    - Do you infringe?是否侵权
    - Is the patent valid?专利是否有效
    - Are there other defenses?是否存在其它抗辩
    - What are your current sales?目前的销售状况如何
    - What are plans for market growth and the possibility that products will change significantly?市场增长计划如何以及可以明显修改产品的可能性如何
    - What does your affected business group want to do?受到影响的业务团体打算做什么

# *The Trolls* 专利投机

- Try to work with other defendants or interested parties; 尽量与其他被告或者利益相关方合作
  - Join or establish a Joint Defense Group (JDG) ; 加入或者建立共同防卫体 (JDG)
    - If done properly, no waiver of attorney/client privilege; 如果这样做, 不会放弃律师/客户特权 (信息披露豁免权)
    - Allows to share the work of investigating prior art ; 允许分享现有技术调查的工作
      - » Reduces cost; 减少支出
      - » Better results; 效果更好
    - Discuss with other defendants filing an earlier reexamination request and moving to stay the litigation; 与其他较早提交了再审查请求并且要求中止审理的被告讨论

## *The Trolls* 专利投机

- Can you involve your component supplier? 能否将部件供应商引入诉讼中?
  - Are you indemnified? 你是否被赔偿?
  - Have you indemnified others? 你是否赔偿了他人?

# The Trolls 专利投机

- **Licensing Strategies; 许可策略**
  - **Be among the first to sign; 首先签约**
    - **When risk level is high – resolve quickly to reduce legal costs, protect market/customers, make deal before troll learns more about your business and wants more money; 当风险程度高时—迅速解决以降低诉讼支出，保护市场/用户，在投机者更多了解你的业务并索要更多的钱之前达成协议**
    - **When the risk is low – negotiate to a minimal payment to avoid legal fees ; 当风险程度低时---进行谈判获得最小的支付费用，以避免法律支出**

- **When you need to make customers feel protected; 当你需要使客户感觉到自己受到保护时**
  - US mobile phone service providers frequently pressure phone suppliers to settle quickly when the service provider has been sued and liability is largely based upon cell phone features; 当美国的移动电话服务提供商被诉而且责任主要建立在移动电话特征的基础上时，服务提供商经常给电话供应商施加压力要求尽快和解
  - Threaten to move orders to licensed phone suppliers; 威胁要向授权的电话供应商发订单、购买产品
- **When troll needs licensees to get momentum behind its licensing program and offers deep discount to settle early; 当投机者需要被许可人在其许可计划之后获得动力并且给予先和解的公司很大的折扣**

# **The Trolls 专利投机**

- **Licensing Strategies; 许可策略**
  - **Wait and see; 等待并且观望**
    - **When the court moves the litigation slowly with the result that legal fees are delayed; 当法院的审理进行得很慢导致法律费用被延期时**
    - **When the troll demands high royalties as they will likely come down over time; 当专利投机者由于随时间延长而可能失去地位而要求很高的许可费时**
    - **When there is little movement by others to settle (Membership in JDG helps you to know attitudes of other defendants); 当其他公司几乎没有要和解的行动时 (JDG成员身份帮助你了解其他被告的态度)**
    - **When customers are not concerned by the litigation and the market is not key to your company's success; 当用户不关心这个诉讼而且这个市场对你公司的成功不重要时**

# *The Trolls* 专利投机

- When the cost of litigation is less than 50% of the projected damages exposure or license offer; 当诉讼费用小于预计赔偿损失或者许可要约的50%时
  - Threat of injunction when plaintiff is a troll has been reduced by recent change in US case law; 由于最近美国案例法修改而降低了作为专利投机者的原告施加的禁令威胁
  - Fighting now may deter other trolls in the future and may lead the current troll to lower its demands; 现在做反击可以阻止未来的专利投机者的骚扰并且可以使目前的专利投机者降低要求
  - Provides some time to explore possible designs around the asserted patents; 提供一些时间去围绕涉案专利进行可能的设计

# The Trolls 专利投机

- **Licensing Strategies; 许可策略**
  - Hold out to trial; 阻止审判
    - When the defenses are good and settlement amount is high compared to legal fees and costs; 当抗辩理由很好而且和解数额与法律费用支出相比很高时;
    - When reexamination is proceeding unfavorably to the troll (Alliacense); 当再审不利于专利投机者时( Alliacense)
    - When the troll's legal team is weak and would not be effective before a jury; 当专利投机者的法律团队较弱而且在陪审团面前可能无效时
    - When the judge has issued a favorable Markman (claim construction) ruling and there is a good chance to dispose of the claims or major issues through summary judgment motions; 当法官发出有利的Markman命令（权利要求解释）并且有很好的机会通过简易判决请求来处理权利要求或者主要问题时

## *The Trolls* 专利投机

- But don't get caught being the last defendant in the litigation; 但是不要被作为诉讼中最后一个被告而被逮到
  - Hyundai Motors failed to follow 17 competitors and many other major companies in the Orion IP litigation and was assessed over \$34M in past damages: 在Orion IP 一案中, Hyundai Motors 没能跟随17个竞争者和其他许多主要的公司, 而被要求支付超过3千4百万美元的过去损失赔偿
  - Jury and judge may punish a defendant that does not settle when it learns that the troll successfully settled with many other defendants; 当被告知道专利投机者与许多其他被告成功和解却没有和解时, 陪审团和法官有可能会惩罚这个被告

# Corporate Licensing Programs

## 公司许可计划

- If there is a strong imbalance in the size and strength of patent portfolios in favor of the licensor, the chance is high that there will be litigation if no agreement is reached; 如果在专利包的规格和强度方面很不平衡，有利于许可人，如果不能达成协议那么出现诉讼的可能性就会很高
  - Corporate licensor has a good chance of getting an injunction (LG Philips v. CPT in afternoon session); 公司许可人获得禁令的可能性就大
  - Normally, corporate licensor's management has already approved and budgeted for litigation if no agreement is reached; 通常，公司许可人的管理层已经批准并且给出如果不能达成协议而要进行诉讼的预算
  - Other royalty paying licensees that compete in the market will pressure the licensor to make all companies pay their fair share; 其他在市场上进行竞争的付费被许可人会给许可人施加压力，要求所有的公司支付他们的合理份额

# Corporate Licensing Programs

## 公司许可计划

- Design around is usually not feasible; 规避设计通常是不可行的
  - Portfolios are usually extensive in scope; 专利包通常覆盖面广
  - Too costly and too expensive to evaluate all the patents that are relevant; 评估所有相关专利的费用高昂
- Can argue that your company should be considered fairly and individually; 可以就你的公司应当被公平、个别对待来进行争辩
  - Every situation is different so licensor's reliance on most favored licensee clauses in earlier agreements deserves little weight; 每个情况都是个案，因此应当较少看重许可人对早期协议中的最优惠被许可人条款的依赖
  - If you are a new entrant in market, the licensor will be better off if it offers terms that will permit your business to be profitable and to grow ; 如果你是市场上的新到者，如果许可人提供的条款允许你的公司有利可图而且成长，许可人则会获利较多

# Corporate Licensing Programs

## 公司许可计划

- **Must think long term; 必须考虑长远**
  - **Licensors are likely continuing to build their patent portfolio and will be back to renew license and royalty obligation after agreement expires ; 许可人可能持续构建其专利包，然后在许可协议到期后返回来更新其协议和许可费义务**
  - **Best defense is to invest to build your patent portfolio; 最好的防卫是构建自己的专利包**
    - **Cost to secure patent protection is a small fraction of the amount spent on R&D; 专利保护的费用仅相当于研发费用的一小部分**
    - **If R&D is too weak, then buy good patents in any technical field and use to increase offset for cross license; 如果研发能力弱小，那么在任一技术领域购买好的专利并且用来提高交叉许可的相互抵消能力**

# Corporate Licensing Programs

## 公司许可计划

- Is there any no monetary value you can offer to lower the license cost, such as a joint venture, product supply, cooperation in introduction to new market ; 是否你可以提供非金钱方面的出价，例如合资、提供产品、在新市场进入方面进行合作，以降低许可费
  - Creates a win-win situation; 创造双赢局面
- If product is covered by standard, unlikely to escape payment of royalties to patent pool relevant to the standard; 如果一件产品被该领域技术标准所覆盖，则无法避免地要去为该标准相关的专利池支付许可费
- Royalty setting and agreement terms should be transparent so that licensee can verify that they are reasonable and non-discriminatory as required by the antitrust laws; 许可费设定和协议条款应当透明，从而被许可人可以查证它们是否合理、无歧视，符合反垄断法的要求

# Patent Pools

## 专利池

- Consider purchasing a patent that can be included in the patent pool to benefit from lower royalty rates to pool members; 考虑购买能被包括到专利池中的专利，以便从专利池成员享有的低费率中获益
  - One company paid over \$20M for standards patents but has saved many times that amount in royalties; 为标准专利支付2千万美元的公司已经成倍节省了许可费
- Do not ignore because a patent covering a standard will be viewed as an important and valuable patent by a jury making it very difficult to successfully against the patent in court; 不要置之不理，因为陪审团认为覆盖标准的专利是重要、有价值的专利，从而很难在法院成功推翻该专利

# Designing Around Patents

## 专利规避设计

# Patent Design Around

## 专利规避设计

- Object is to develop a legal reason that a design cannot be covered by a patent claim; 目的是找出该设计没有为专利权利要求所覆盖的合法理由
  - Patent owner disclaimed the design to get its patent; 专利所有人放弃该设计以获得专利
  - Design comes from prior art to the patent; 该设计来自专利的现有技术
  - Claim is narrow so that new design does not include one of the claim elements; 权利要求范围窄，因此新设计不包括权利要求的一项特征
  - New design is described but not claimed in the patent; 该新设计在专利说明书中有描述但是没有被权利要求所覆盖
- Barring a fundamental change in technology it is difficult and expensive to develop an incremental change in the product design which would avoid a large number of patents; 除非是技术上的一个基本改变，否则在产品设计上发展出能够避开大量专利的递增改变是非常困难而且花费巨大的

# *Designing Around Strategies*

## 规避设计策略

- Strategy 1: Adopting technology disclaimed by the patent owner to get its patent ; 策略1: 采用专利权人为获得专利而放弃的技术
  - Prosecution history estoppel prevents a patentee from recapturing protection of subject matter disclaimed by argument or amendment to a claim made during prosecution; 禁止反悔原则防止专利权人将他在申请过程中争论放弃的主题或者对权利要求所做的修改拿回来要求保护
  - A competitor desiring to design around a patent should carefully review the prosecution history of the patent before the Examiner at the United States Patent Office; 欲进行专利规避设计的竞争者应该仔细了解美国专利商标局审查员那里的专利申请历史

# *Designing Around Strategies*

## 规避设计策略

- Strategy 2: Adopting technology described in the prior art ; 策略2 : 采用现有技术中描述的技术
  - Limitations in a claim cannot be interpreted so broadly as to cause the claim to encompass subject matter in the prior art; 权利要求中的限制不能被解释太宽, 否则会使权利要求包括现有技术的内容
  - A competitor may practice an invention fully disclosed in an expired patent or described in a printed publication more than one year prior to the filing date of the patent at issue; 竞争者可能在涉案专利申请日的一年以前, 实践在届满专利中充分公开或者在印刷出版物中描述的发明

# Designing Around Strategies

## 规避设计策略

- Strategy 3: Eliminating a claim element and its function under the all elements rule ; 策略3: 根据全部要素原则, 省略部分要素及相应性能
  - All elements Rule: if an element of a claim and the function of the element are not present in an accused device, the device does not infringe the claim; 全部要素原则: 如果一个权利要求中的一个要素及其功能在被控装置中没有出现, 则该装置没有侵犯该权利要求
  - A competitor should look at the patented claims to see if there is a structural element and its corresponding function that can be eliminated from the design of a device; 竞争者应当阅读授权权利要求, 看看是否可以从该装置设计上去除一个结构要素及其对应的功能
  - This arises when the patent claims were made too narrow during prosecution before the Examiner; 当一个专利权利要求在审查员审查过程中被限制过窄, 则会出现此问题

# *Designing Around Strategies*

## 规避设计策略

- Strategy 4: Adopt technology described in the patent specification but not claimed; 策略4：采用说明书及附图中记载,但未反映在权利要求书中的技术方案
  - Subject matter disclosed but not claimed in a patent application has been held by the courts to be dedicated to the public; 法院已经认为，说明书中公开却没有在权利要求中要求的内容视为被贡献给了公众
  - Must check further to determine that there is no other pending application of the patent owner that does claim the previously unclaimed subject matter; 必须查核以便进一步确认，该专利权人没有就他之前放弃的内容申请专利

# Designing Around Strategies

## 规避设计策略

- Designing around problem patents can be an effective way to eliminate the need for licenses and; 规避设计问题专利是消除许可需要的有效方法
- Since patent trolls usually own and assert only a relatively few patents, designing around is a viable strategy to avoid taking licenses from trolls. 因为专利投机者通常拥有相对少的专利并且仅对此提出要求，规避设计是一个避免从投机者那里获得许可的有效策略
- It is more difficult to avoid large patent portfolios of corporations because they usually include multiple patents directed to a technology and claim many different designs for the technology; 避免公司的大专利包比较困难，因为这些专利包包括一项技术的多个专利并且要求保护该技术的许多不同设计

# ***Designing Around Strategies***

## **规避设计策略**

- Very difficult to design around a true Essential patent covering a Standard because the manufacturer must design its product to comply with the Standard; 很难对覆盖标准的关键专利进行规避设计，因为制造者必须设计符合该标准的产品
- A licensee's strategy must depend upon the nature of the licensor with different strategies being adopted for trolls, corporations, and patent pools; 被许可人的策略必须取决于许可人的特点，对专利投机者、公司和专利池要采取不同的策略

## Summary

### 总结

- License targets should remain flexible during the period of a negotiation or litigation and change strategies to reflect changes in circumstances; 在谈判或者诉讼过程中许可目标应当保持灵活，随时改变策略以适应情况的变化
- The most important consideration of a license target is to keep its management and affected business division continually and fully advised of the magnitude of the risk presented by a patent assertion and the options available to the company to address that risk; 许可目标的最重要考虑是，保持管理层和受到影响的业务部门连续且充分地了解涉案专利能够带来的风险，以及该公司针对该风险能够采用的方案

Morgan Lewis

***Design Around and Licensing Strategies  
in the Global IP environment***  
**在全球IP环境下规避设计和许可策略**

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北京东方灵盾科技有限公司承办