



## US Patent Litigation & Response Strategies

### 美国专利诉讼及应对策略

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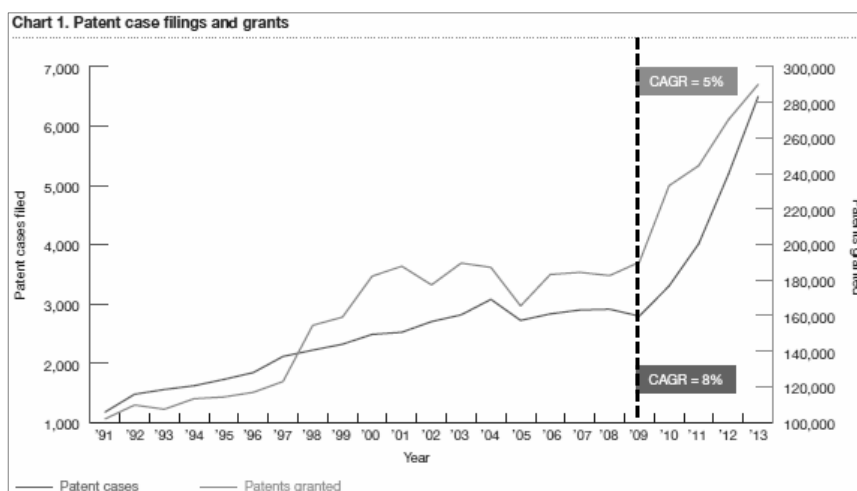
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## Overview 概览

- Increasing Risks of US Patent Case Involving Chinese Companies
  - Growth of Patent Litigation
  - Hot Areas of US Patent Litigation
  - Growth of Patent Litigation involving Chinese Companies
- Preparing for Potential Patent Battles
- 正在增加的涉及中国企业的美国专利案件风险
  - 专利诉讼增长
  - 美国专利诉讼中的热点
  - 涉及中国企业的美国专利诉讼增长
- 备战潜在专利战斗

## Patent War Arises 专利战随专利数量逐年增加



Source: PwC - 2014 Patent Litigation Study

## Top 10 Largest Damage Awards 10个最高的专利侵权赔偿案

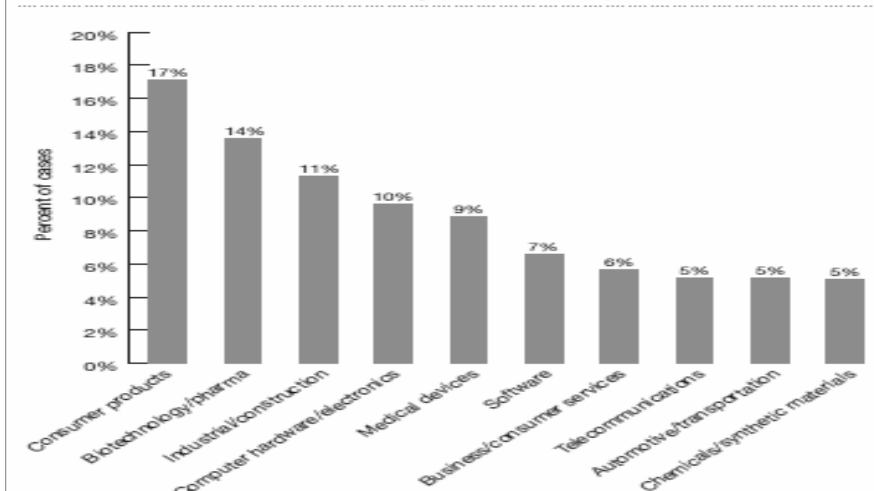
Figure 26: Largest Damages Awards\*

Rank	Case	Damages	Against	To	Subject
1	Monsanto v. Dupont	\$1,000,000,000	DuPont	Monsanto	GMO Seed
2	Apple v. Samsung	\$598,908,892	Samsung	Apple	Software
3	Apple v. Samsung	\$290,456,793	Samsung	Apple	Software
4	Stryker v. Zimmer	\$228,326,677	Zimmer	Stryker	Medical Device
5	Tyco Healthcare v. Ethicon Endo-Surgery	\$140,080,000	Ethicon Endo-Surgery	Tyco Healthcare	Medical Device
6	Syntrix v. Illumina	\$95,795,507	Illumina	Syntrix	BioTech
7	Astrazeneca v. Apotex	\$76,021,994	Apotex	Astrazeneca	Pharma
8	Two-Way Media v. AT&T	\$27,500,000	AT&T	Two-Way Media	Telecom
9	Pact XPP v. Xilinx	\$23,099,850	Avnet, Xilinx	Pact XPP	Processor
10	Tomita v. Nintendo	\$15,100,000	Nintendo	Tomita	Camera

Source: Lex Machina – 2013 Patent Litigation Year in Review

## Top 10 Industries of Patent Litigation 专利诉讼的10大行业

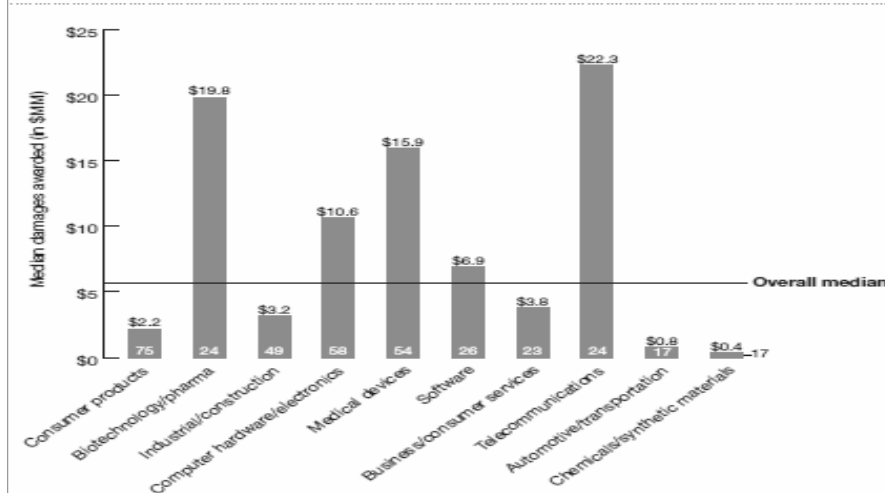
Chart 7a. Distribution of cases: top ten industries, 1995–2013



Source: PwC - 2014 Patent Litigation Study

## Top 10 Industries of High Damage Awarded 专利诉讼高额侵权赔偿的10大行业

Chart 7b. Median damages awarded: top ten industries, 1995–2013



Source: PwC - 2014 Patent Litigation Study

## Top 5 Most Active District Courts 5大最活跃的地区法院

Figure 3: Districts With Most New Cases Filed

Rank	District	2013	2012	Net Change
1	Eastern District of Texas	1,495	1,247	+248
2	District of Delaware	1,336	1,002	+334
3	Central District of California	399	499	-100
4	Northern District of California	249	260	-11
5	Southern District of California	227	141	+86

Source: Lex Machina – 2013 Patent Litigation Year in Review

## New Battle Front: Challenge Patents in the PTO

### 新的诉讼前线：在美国专利局挑战专利的有效性

#### NUMBER OF AIA PETITIONS

FY	Total	IPR	CBM	DER
2012	25	17	8	-
2013	563	514	48	1
2014	1,153	1,008	140	5
Cumulative	1,741	1,539	196	6

#### AIA PETITION TECHNOLOGY BREAKDOWN

Technology	Number of Petitions	Percentage
Electrical/Computer	1,251	71.9%
Mechanical	266	15.3%
Chemical	123	7.1%
Bio/Pharma	93	5.3%
Design	8	0.4%

Source: [http://www.uspto.gov/ip/boards/bpai/stats/aia\\_statistics\\_072414.pdf](http://www.uspto.gov/ip/boards/bpai/stats/aia_statistics_072414.pdf)

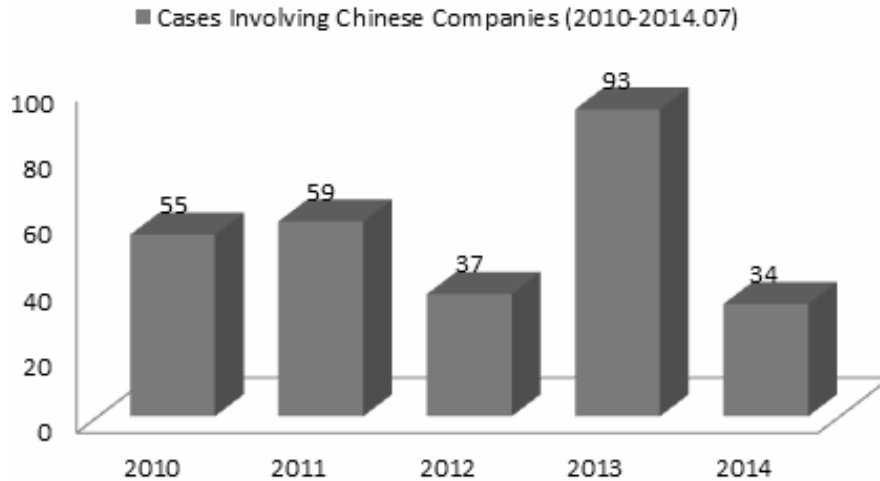
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## US District Court IP Cases re Chinese Companies

### 涉及中国企业的美国联邦地区法院IP诉讼

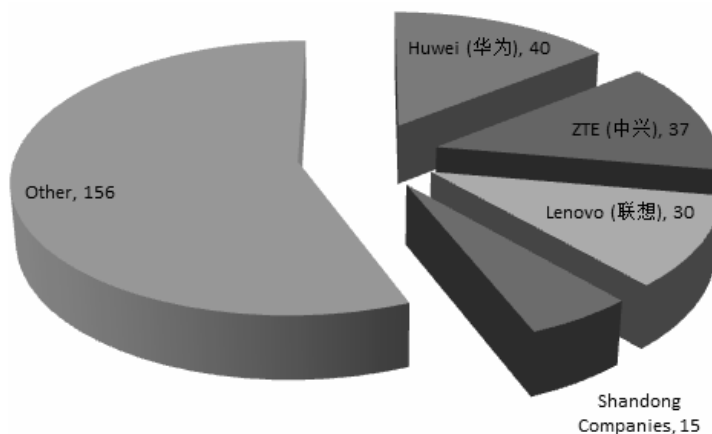


Source: Finnegan Collected Data for 2010-2014.07

## US District Court IP Cases re Chinese Companies

### 涉及中国企业的美国联邦地区法院IP诉讼

#### ■ Cases Involving Chinese Companies (2010-2014.07)



Source: Finnegan Collected Data for 2010-2014.07

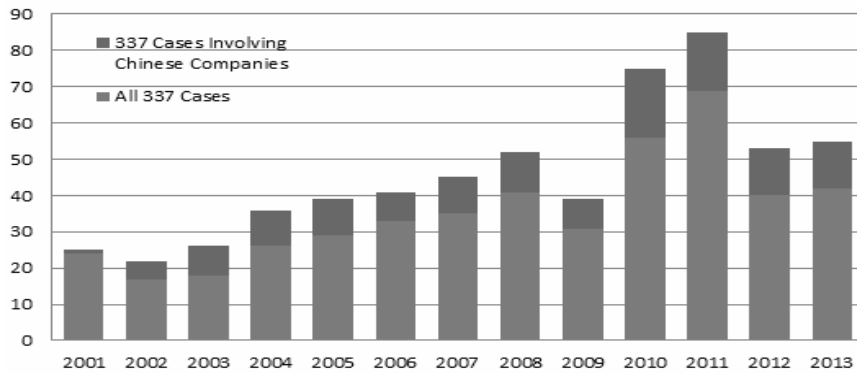
## ITC IP Cases involving Chinese Companies

### 涉及中国企业的ITC知识产权诉讼

- ITC Cases vs. Those Involving Chinese Companies

ITC诉讼与涉及中国公司的ITC专利诉讼

ITC Cases

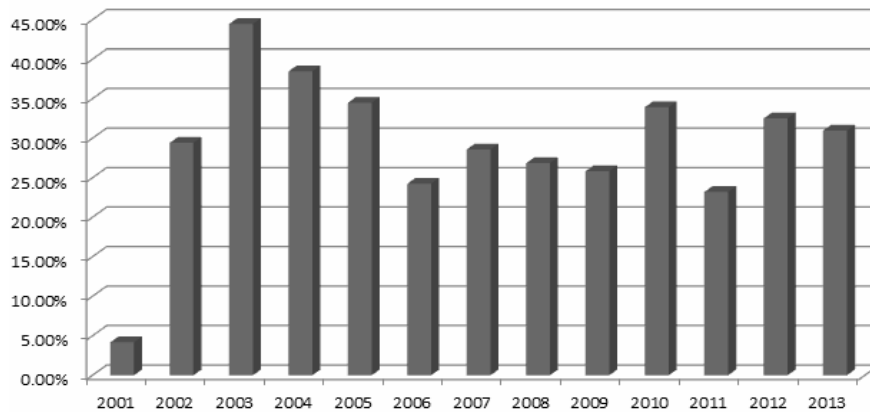


## ITC IP Cases involving Chinese Companies

### 涉及中国企业的ITC知识产权诉讼

- ITC Cases (ITC知识产权诉讼)

% of Cases Involving Chinese Companies

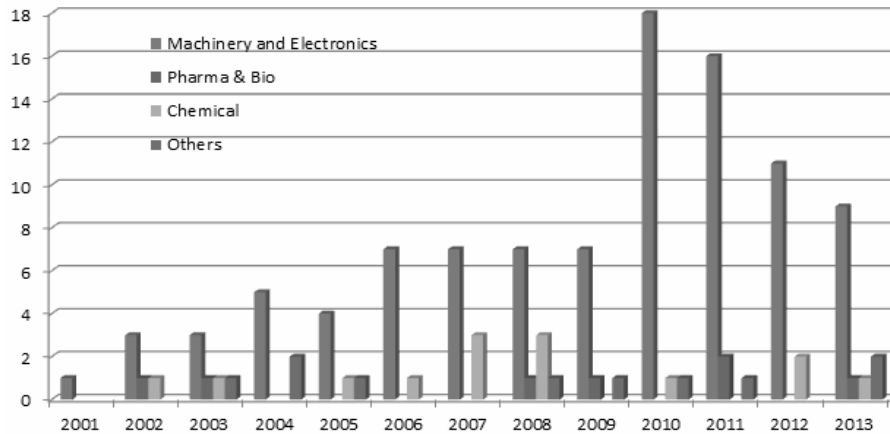


## ITC IP Cases involving Chinese Companies

### 涉及中国企业的ITC知识产权诉讼

#### ITC Cases Involving Chinese Companies: Industries

涉及中国公司的ITC知识产权诉讼: 行业领域

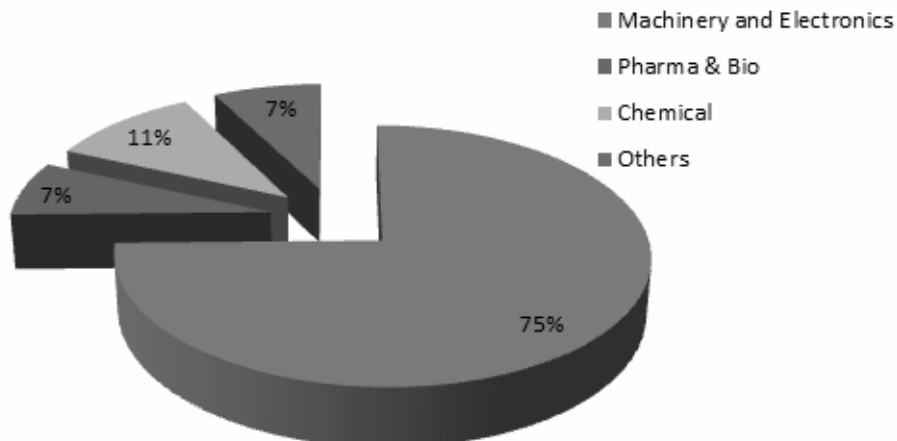


## ITC IP Cases involving Chinese Companies

### 涉及中国企业的ITC知识产权诉讼

#### ITC Cases Involving Chinese Companies: Industry Percentile

涉及中国公司的ITC知识产权诉讼: 行业领域比重

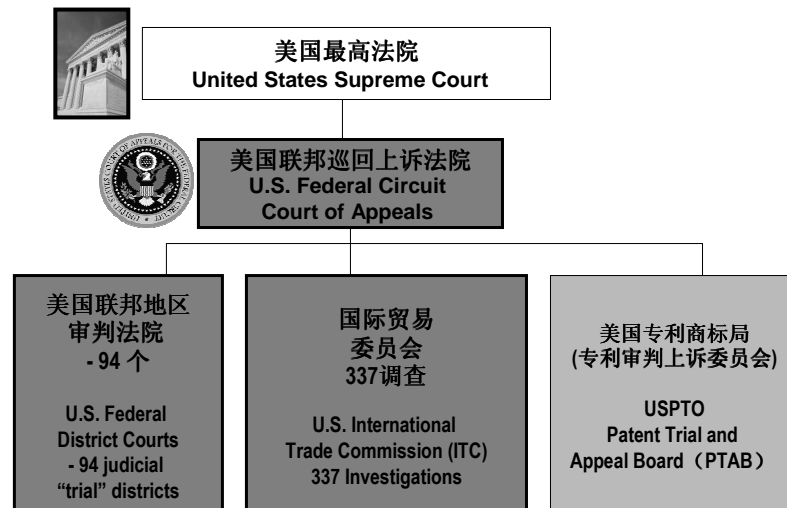




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  - 进行美国专利侵权诉讼的策略
  - 降低被诉专利侵权风险的策略
  - 谈判专利许可的策略

## US Courts/Agencies Handling Patent Disputes 美国处理专利纠纷的法院/机构



## Goal of Litigation: Win

### 诉讼目标：胜诉

- What is a win?
  - Depends on the case and business objectives
- Learn the case
- Understand the business objectives
- Develop a case strategy that has the highest chance of achieving the business objectives
- A good settlement can be a “win”
  
- 什么是胜诉？
  - 取决于具体的案件和商业目标
- 熟悉案情
- 了解商业目标
- 制定最有可能实现商业目标的案件策略
- 有利的和解也可以理解为“胜诉”

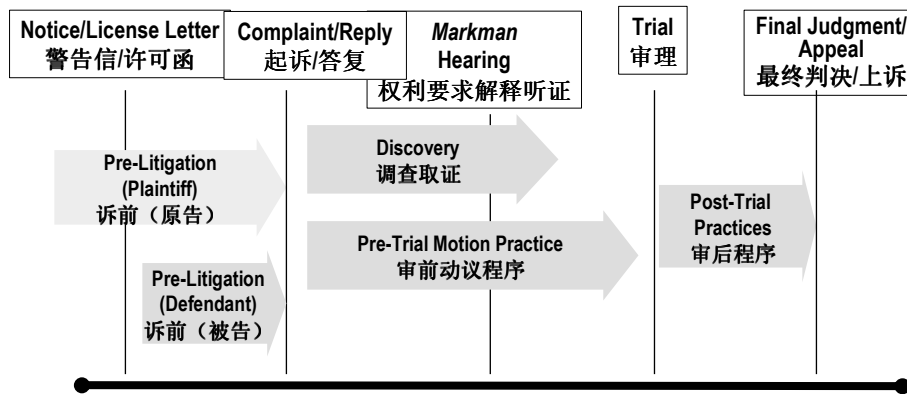
## Develop Winning Strategy

### 制定胜诉策略

- Start focusing on winning from day one
- Maintain focus on winning throughout the entire case
- Develop strategy early
- Modify strategy as needed during the case
- Determine what is an achievable goal for the case
- Develop strategy to meet that goal
  
- 从第一天开始便致力于取得胜诉
- 在整个案件过程中，始终将重点放在取得胜诉上
- 尽早制定策略
- 在案件过程中，根据需要对策略进行修改
- 确定可实现的目标
- 制定实现该目标的策略

## Pre-Litigation Strategy—Plaintiffs

### 诉前策略—原告



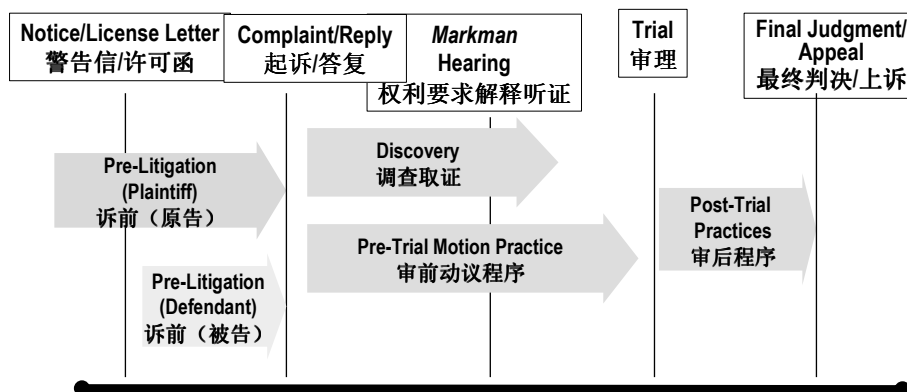
## Pre-Litigation Strategy—Plaintiffs

### 诉前策略—原告

- Reasons for Suit
  - Benefits vs. Risks: Business, IP
- Strategies:
  - Notice/Licensing Letter vs. Suit
  - Suit: Where, Whom, What
- 诉讼原因
  - 利益与风险分析：商业、知识产权
- 策略
  - 警告信（许可函）或诉讼
  - 诉讼：在哪里诉？诉谁？诉什么？

## Pre-Litigation Strategy—Defendants

### 诉前策略—被告



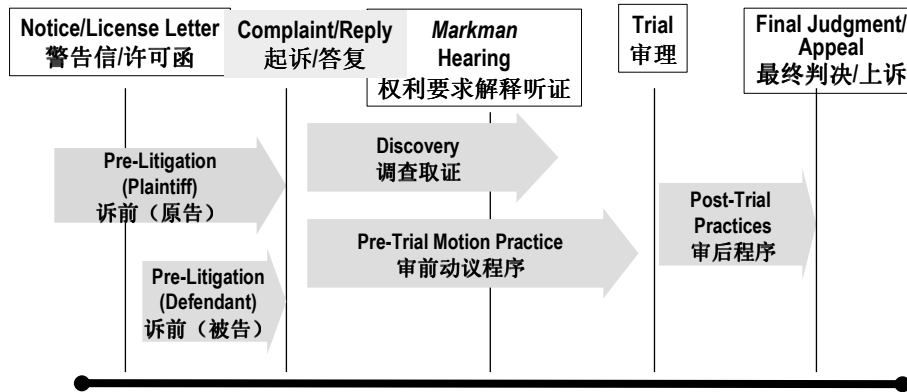
## Pre-Litigation Strategy—Defendants

### 诉前策略—被告

- Response to the Notice/Licensing Letter
  - Notify U.S. litigation counsel immediately
  - Respond quickly to show attention
  - Issues to explore: Indemnity, validity, infringement, risks of damages and injunction, own patents to leverage
  - Response tone and content
- 对警告信（许可函）进行回应
  - 立即通知美国诉讼律师
  - 快速回应以显示重视程度
  - 探究问题：补偿、有效性、侵权、损害、自己可抗衡的专利
  - 回应的语气、内容

## Complaint and Reply Strategies

### 起诉与应诉策略



## Strategy for Filing of Complaint—Plaintiff

### 提交诉状的策略—原告

- Goals
  - Settlement with license
  - Settlement with cross-license
  - Business arrangement
  - Removal of competitors from market
- 目标
  - 达成许可协议
  - 达成交叉许可协议
  - 业务安排
  - 把竞争对手踢出市场

## Strategies to Respond to Complaint—Defendants

### 应诉策略—被告

- Choose and engage a reputable US law firm
- Analyze the complaint
- Develop strategy: aggressive, passive, joint defense, tender to supplier or customer
- Develop defense
- Consider your options based on your business needs
  
- 选择和委托美国知名律师事务所
- 分析诉状
- 制定辩护策略：进攻、消极、联合抗辩、交给供应商或客户
- 研究抗辩理由
- 根据商业需求考虑您可以采取的应对措施

## Strategies to Respond to Complaint—Defendants

### 应诉策略—被告

- Options (examples)
  - Not to respond (default judgment)
  - Enter a Consent Order
  - Negotiate for settlement
  - Defend aggressively
  
- 应诉方案（举例）
  - 不应诉（自动败诉）
  - 同意命令书
  - 庭外调解
  - 积极应诉



## Strategies to Respond to Complaint—Defendants

### 应诉策略—被告

- Options (examples)
  - Assert your own IPR in China or the U.S.
  - Ask for indemnification by suppliers (if available)
  - Design Around
- 应诉方案（举例）
  - 在中国或美国反告人家侵权
  - 要求部件供应商担保
  - 设计不侵权的新产品



## Strategies to Respond to Complaint—Defendants

### 应诉策略—被告

- Negotiate for Settlement (examples)
  - License the Complainant's IPR
  - Become the Complainant's OEM
  - Enter a joint venture with the Complainant
  - Cross license each other's IPR
- 庭外调解（举例）
  - 接受许可
  - 成为海外制造商
  - 联合办厂
  - 交叉许可



## Strategies to Respond to Complaint—Defendants

### 应诉策略—被告

- Defend Aggressively (examples)
  - Noninfringement
  - Patent invalidity
  - Patent misuse & antitrust theories
  - Patent unenforceability
  - Post-grant challenges to patent validity at USPTO

- 积极应诉（举例）
  - 不侵权
  - 专利无效
  - 专利滥用及反垄断
  - 专利无执行性
  - 专利授权后在美国专利局挑战其有效性



## Post-Grant Challenges to Patents in the PTO

### 专利授权后挑战其有效性

	Ex Parte Reexam 单方复审	Post-Grant Review 授予后复议	Inter Partes Review 多方复议
When? 时间	After grant 授予后	No more than 9 months after grant (Sept. 16, 2012, but of a patent with an effective filing date of the claimed invention on or after March 16, 2013) 授予后不超过9个月（2012年9月16日，但是对于具有主张发明的有效申请日的专利，在2013年3月16日当天或之后）	After 9 months from grant 授予后9个月后
Threshold Showing 门槛	SNQP 专利性实质性新问题	"more likely than not that at least 1 of the claims challenged in the petition is unpatentable" or important novel/unsettled legal question “请愿书中至少一条被异议权利要求更可能具有不可专利性”或重要的新的/没有解决的法律问题	Reasonable likelihood of success 成功的合理可能性
Anonymity 匿名	Yes 是	No 否	No 否
Estoppel 禁反言	None 无	Issues raised or reasonably could have been raised by the petitioner: PTO, district court, and ITC 被请愿人提起或可合理地提起的问题：专利商标局、联邦地区法院与美国国际贸易委员会	Issues raised or reasonably could have been raised by the petitioner: PTO, district court, and ITC 被请愿人提起或可合理地提起的问题：专利商标局、联邦地区法院与美国国际贸易委员会



## Post-Grant Challenges to Patents

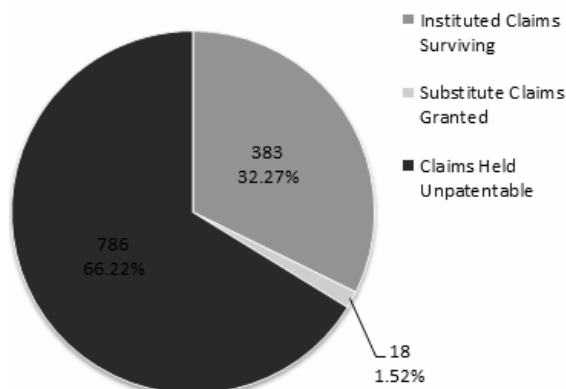
### 专利授权后挑战其有效性

	Ex Parte Reexam 单方复审	Post-Grant Review 授予后复议	Inter Partes Review 多方复议
Grounds	102, 103	101, 102, 103, 112	102, 103
Before Whom?	CRU中央审查部	PTAB专利审理和上诉委员会	PTAB专利审理和上诉委员会
Discovery/Evidence?	Declaration 证言书	Declaration and discovery 证言书和证据收集	Declaration and discovery 证言书和证据收集
Speed 专利 商标局的速度	Many Years 很多年	1 to 1½ years 一年至一年半	1 to 1½ years 一年至一年半
Appeal 上诉	Only patentee can appeal to Board and then Federal Circuit 仅专利权人可上诉至委员会，而后是联邦巡回上诉法院	Both parties can appeal to Federal Circuit 双方均可上诉至联邦巡回上诉法院	Both parties can appeal to Federal Circuit 双方均可上诉至联邦巡回上诉法院

## Post-Grant Challenges to Patents

### 专利授权后挑战其有效性

#### IPR Claim Disposition (July 2, 2014)



## Develop Theme

### 确定主题

- Develop a consistent theme to fit the facts
- Know the whole story
- Find theme that appeals to judge/jury—no technical training required
- Keep it simple and interesting
- Give judge/jury a reason to want you to win
  
- 确定与案情相符的主题
- 了解整个案件
- 找到可以打动法官/陪审团的主题-没有技术背景要求
- 主题应简单有趣
- 给法官/陪审团一个足以让你胜诉的理由

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  - 降低被诉专利侵权风险的策略
  - 谈判专利许可的策略

## Making Your Game Rules by Patenting

### 通过专利制定您的游戏规则

- Inventing-around valid and enforceable patents
- Fencing-in competitors by barring improvements
- Building a toll-bridge to the future
- Changing the relative cost of doing business
- Collecting bargaining chips for deals
- Invalidating others' patents that impede your business

- 发明规避有效且可执行的专利
- 通过阻止改进来限制竞争对手
- 建立通向未来的收费通道
- 改变业务运营的相对成本
- 收集用于交易的谈判筹码
- 使妨碍您业务的他人专利失效



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  - 谈判专利许可的策略

## Strategies for Negotiating Licenses

### 谈判许可的策略

- Know your and your adversary's strengths/weaknesses
- Understand your adversary's needs
- Know your options
- Build your strategies

- 了解你和你对手的优点/弱点
- 了解你对手的需要
- 了解你的选择
- 构建你的战略



## Strategies for Negotiating Licenses

### 谈判许可的策略

- Strengths/weaknesses
  - Legal
    - Jurisdiction
    - Infringement
      - Comparison of claims and products/processes
      - Direct vs. indirect infringement
    - Validity & Enforceability
    - Damages
      - Reasonable royalty vs. lost profits
      - Damage period
    - Injunction



## Strategies for Negotiating Licenses 谈判许可的策略

- 优点/弱点
  - 法律
    - 司法管辖区
    - 侵权
      - 权利要求和产品/工艺的比较
      - 直接与间接侵权
    - 有效性及强制执行性
    - 损害赔偿金
      - 合理许可使用费对损失利润
      - 损害期间
    - 禁止令



## Strategies for Negotiating Licenses 谈判许可的策略

- Strengths/weaknesses
  - Business
    - Market share
    - Customers
    - Own IP
    - Own technology
      - Same product line
      - Complementary products
- 优点/弱点
  - 业务
    - 市场份额
    - 客户
    - 拥有知识产权
    - 拥有技术
      - 相同产品线
      - 互补性产品



## Strategies for Negotiating Licenses

### 谈判许可的策略

- Adversary's needs
  - Business needs
    - Maintain market share
    - Protect profitability
    - Maintain customers
    - Keep current with technology
    - Provide full product line
    - Have access to other geographical or vertical markets
- 对手需求
  - 业务需求
    - 保持市场份额
    - 产品赢利性
    - 保留客户
    - 保持同步技术
    - 提供全面产品线
    - 进入其它地理或垂直市场



## Strategies for Negotiating Licenses

### 谈判许可的策略

- Adversary's needs
  - Licensing needs
    - Express requirements to license all competitors
    - Practical need to license all competitors
    - Need to protect royalty stream
    - Most-favored-licensee obligations
- 对手需求
  - 许可需求
    - 向所有竞争者许可的明确要求
    - 向所有竞争者许可的实际需要
    - 保护许可使用费源流的需要
    - 最被看好被许可人的义务



## Strategies for Negotiating Licenses

### 谈判许可的策略

- Your options
  - Warrantee/ Indemnity obligations of third parties
  - Business alternatives
    - Purchase of components from licensed providers
    - Abandonment of business or product line
    - Abandonment of U.S. market

- 你的选择
  - 第三方保证/ 补偿义务
  - 商业替代方案
    - 从被许可提供商那里采购部件
    - 弃置业务或产品线
    - 弃置美国市场



## Strategies for Negotiating Licenses

### 谈判许可的策略

- Your options
  - Technical alternatives to license
    - Technological limitations
      - Cost
      - Delays
    - Business limitations
    - Standards
      - De jure
      - De facto

- 你的选择
  - 许可的技术替代方案
    - 技术限制
      - 成本
      - 延期
    - 商业限制
    - 标准
      - 法律上
      - 事实上



## Strategies for Negotiating Licenses 谈判许可的策略

- Strategy
  - Type of acceptable royalty
    - One-time fee
      - Minimize record keeping
      - Assumes success
      - Immediate effect on profits/cash flow
    - Running royalty
      - Record keeping
      - Tracks success
    - Hybrid
- 战略
  - 可接受许可使用费类型
    - 一次性费用
      - 最大限度地减少记录保存
      - 假定成功
      - 对利润/现金流的即时效应
    - 连续许可使用费
      - 记录保存
      - 跟踪成功
    - 混搭



## Strategies for Negotiating Licenses 谈判许可的策略

- Strategy
  - Maximum acceptable royalty
    - Need to maintain profit margin
    - Need to justify maintaining business
    - Should be less expensive than alternative
      - Must consider manufacturing costs
      - Must also consider business costs
- 战略
  - 最大限度可接受许可使用费
    - 保持利润率的需要
    - 合理保持业务的需要
    - 比替代方案代价更小
      - 必须考虑制造成本
      - 还必须考虑商业成本





## Strategies for Negotiating Licenses 谈判许可的策略

- Strategy
  - Negotiation plan
    - Separate negotiable terms from non-negotiable terms
    - Understand limits to acceptable terms
    - Determine opening offer based on limits
- 战略
  - 谈判计划
    - 将可协商同不可协商条款分离
    - 理解对可接受条款的限制
    - 基于限制，确定报价



## Strategies for Negotiating Licenses 谈判许可的策略

- Strategy
  - Negotiation plan
    - Keep business options (e.g., manufacturing, distribution, etc.) out of initial offer, unless they are the essential part of the deal
    - If so, move this quickly to a business discussion
- 战略
  - 谈判计划
    - 确保商业选择（即制造，经销等等）不在首次报价内，除非它们构成交易的核心部分
    - 如果这样，迅速进入商业讨论



## Strategies for Negotiating Licenses 谈判许可的策略

- Strategy
  - Negotiation plan
    - Choose negotiating team
      - Should be knowledgeable
      - Should be at same level as adversary
      - Should have authority to settle on certain terms
    - Choose negotiating venue
      - Alternate between your and adversary's locations
      - Choose a neutral site
- 战略
  - 谈判计划
    - 选择谈判团队
      - 应当博学
      - 当应与对手处于同一水平
      - 有权敲定一些条款
    - 选择谈判地点
      - 在你和对手地点之间轮替
      - 选择中立场所



## Questions? Please Contact Us 有问题请联系我们



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