

美国律师协会反托拉斯法部、知识产权法部和国际法部  
对于最高人民法院  
关于修改审理专利纠纷案件适用法律意见征求稿的  
意见书

二零一四年八月十五日

本意见书仅代表美国律师协会反托拉斯法部、知识产权法部和国际法部的观点，没有经过美国律师协会会员代表大会或理事会的批准，因此不应被视为代表美国律师协会的政策。

美国律师协会反托拉斯法部、知识产权法部和国际法部（简称“三部门”）。很高兴提交对于最高人民法院关于修改审理专利纠纷案件适用法律意见征求稿（简称“征求意见稿”）的意见书。三部门提交的意见反映了其成员在竞争法与知识产权法等领域的专业知识和经验。

三部门欢迎最高人民法院（简称“最高院”）通过修改意见征求稿在提高透明度和指导方面的成就，并且感激能够有机会提供意见。三部门的意见集中在对第二十一条关于计算专利许可费损失的讨论。

### 总体意见

创新者从他们对新产品的研发和商业化所作出的投资中获取利益，而针对专利侵权的有效的救济措施对于通过保护创新者能获取利益而促进创新与竞争至关重要。<sup>1</sup>为了能够充分的保护创新的动力，救济措施应当补偿过去的侵权行为，禁止未来的侵权行为，并且在第一时间遏制侵权行为。在美国，专利救济措施提供了三种补救途径以达到上述目的：（一）损失赔偿，寻求将专利权人的财政恢复到若侵权行为没有发生而本应有的状况；（二）提高赔偿，为遏制蓄意侵权行为而设计；以及（三）在合适的时候使用禁止令，寻求维护专利权人的排他性以及在第一时间遏制侵权行为。

与市场回报相比，对专利权人赔偿不足或者赔偿过多的专利救济措施，没有侵权行为的存在，会对消费者造成损害。持续的对专利权人赔偿不足的救济措施会削减创新的动力。在所有情况下全面否定寻求禁止令的诉求会削减专利权人通过其发明的商业化获得全部市场回报的能力。救济措施对专利权人赔偿过多时，如果过多的损害赔偿转嫁给了消费者，则会导致价格上涨。因此，试图使损害赔偿能够准确反映一项发明在没有侵权行为的情况下所能获得的市场回报是很重要的。

<sup>1</sup>参见，例如，美国联邦贸易委员会，《演变中的知识产权市场：专利声明与救济和竞争的协调》，第140-141页（二零一一年三月），原文见  
<http://www.ftc.gov/sites/default/files/documents/reports/evolving-ip-marketplace-aligning-patent-notice-and-remedies-competition-report-federal-trade/110307patentreport.pdf>。

## 第二十一条

第二十一条列出了法院在先前许可费的基础上评估合理的专利许可费损害金额时会参照的因素。本条规定了在过往专利许可费“明显不合理”时，法院可以不对其进行考虑。

计算合理的专利许可费损害金额的目的是反映没有侵权行为存在时该项发明的市场回报。因此它应该取决于有意向的许可人和被许可人在假想的谈判中本应该达成的合意。在美国具有开创性的案件，乔治太平洋公司诉美国胶合板公司（*Georgia-Pacific Corp. v. United States Plywood Corp.*）案中，阐述了损害金额的合理测量办法为“如果许可人（例如专利权人）与被许可人（例如侵权行为人）双方合理且自愿的试图达成合约，那么双方本应达成合意的（在侵权开始的时候）数额。”<sup>2</sup>这一框架的核心原则是有意向的许可人和有意向的被许可人模式，在此模式下被授予的数额必须双方都能接受。专利许可费必须充分补偿专利权人的授权使用，同时为侵权行为人使用该项发明保留适当的预期利润。

美国法院运用两种假定来落实假想的谈判。第一，事实裁定人必须假定该假想谈判的开始时间为侵权行为发生时。这一时间点决定了双方在谈判时所掌握的信息。因此，在设定合理的专利许可费用时，关于侵权行为人的预期利润以及可用的替代品的考量“在假想的许可谈判双方本应该会考虑哪些事项的基础上决定，而非取决于实际发生情况的事后评价。”<sup>3</sup>

第二，法院要求事实裁定人假定在谈判时双方明确知晓该专利是有效的并且受到了被告产品或者在加工过程中的侵权损害。该假定保证了专利权人在承担了庭审的风险和责任并取胜后能购获得全数赔偿。

在构建假想的谈判时，美国法院会考虑谈判双方在决定专利许可费时本应会考虑的有关市场因素的证据。因为每一项技术和市场都不相同，考虑的证据及其在每一个因素中发挥的力量会根据情况而不同。<sup>4</sup>

我们建议修改第二十一条并明确说明法院寻求重新创立假想的谈判并且以有意愿的许可人和被许可人模式做为决定合理专利许可费用的概念性框架。其后法院可以考虑与适合专利许可费用相关的市场因素证据。这种方法可以保护创新的动力并且避免赔偿不足或者赔偿过多。

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<sup>2</sup> 乔治太平洋公司诉美国胶合板公司案，318 F. Supp. 1116, 第 1120 页（美国地区法院纽约州南区，一九七零年），修正并维持原判（第二巡回法院，一九七一年）。

<sup>3</sup> 汉森诉高山峡谷滑雪场有限公司案，718 F.2d 1075, 第 1081 页（联邦巡回法院，一九八三年）。

<sup>4</sup> 乔治太平洋案的法院列出了包含十五项非穷尽因素的清单。第十五项是假想谈判金额，其他十四项列出了证据的类别。乔治太平洋公司案。318 F. Supp. 第 1120 页。

关于标准必要专利，标准必要专利的持有人自愿作出了按照合理非歧视的条件进行许可的承诺。美国法院考虑了特定的因素重建双方的假想谈判。例如，法院判定“假想谈判的双方本应会考察该标准必要专利对争议产品的重要性来决定合理非歧视的专利许可费率。”<sup>5</sup>而且，“一项合理非歧视承诺应该被理解为将一名专利持有人获得的专利许可费限定于其专利技术本身的经济价值，除去与将专利技术纳入标准相关联的价值。”<sup>6</sup>

最后，第十二条禁止使用先前与被许可人在市场中商定的许可费，如果该费用明显不合理。这一标准中关于什么是“明显不合理”的模糊不清会导致决定偏离以市场为基础的方法。<sup>7</sup>为促进创新和市场增长，应该总体上允许一名专利持有人收取市场可以负担的任何费用。<sup>8</sup>在没有证据证明先前的许可费用是违反竞争行为的产物的情况下，这笔通过条件对等的谈判所得出的费用表明了（而且是最佳证据）专利的市场价值。

在某种程度上，第二十一条指的是能够与被侵权专利许可进行比较的许可，这种证据可以在发明专利及其侵权使用与可对比的许可充分相似的情况下，为事实裁定人提供可靠的帮助。评估相似性的关键因素包括该技术，许可的权利（一项专利或是专利组合），专利许可费类型（提成性计费或是一次性计费），以及许可条件（一类产品或是多类）。当认定一项许可具有可比性并且经历过条件对等的谈判时，应该认定它为证据，而不考虑这些条件是否“明显不合理”。

因此，应该修改第二十一条，删除这项禁止并且允许法院考虑所有先前以及具有可比性的许可费并且不排除那些被认定为“明显不合理”的。

## 总结

三部门很感激能有机会对最高院的意见征求稿提供意见。如果最高院对我们的意见书有任何疑问，我们很高兴作出回应，或者提供能协助最高院的补充意见或者信息。

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<sup>5</sup> 参见，例如，微软公司诉摩托罗拉公司案，2013 WL 2111217，第三页（美国地区法院华盛顿州西区，二零一三年四月二十五日）。

<sup>6</sup> 同上，第十二页。

<sup>7</sup> Daniel F. Spulber, 《当发明面向市场时，竞争压力如何影响创新的动力？》政治经济学杂志第 121 期第 1007 页，第 1040 页，（二零一三年）。（“削弱知识产权的反托拉斯和知识产权政策使参与市场的发明减少。因此反托拉斯政策应该避免通过限制专利许可费，技术标准和知识产权的市场转让来限制知识产权。通过制约发明市场来限制知识产权的独占，模仿和征用会减弱竞争的动力，产生竞争压力。”）。

<sup>8</sup> 参见，例如，Mark A. Lemley, 《区分利润损失和合理的专利许可费》，威廉玛丽大学法律评论，第 51 期第 655 页，第 657 页，（二零零九年）。（“专利保护的传统概念是给与专利持有人通过出售专利产品排除竞争的途径，由此增长他们的利润，并且因此增加潜在专利持有人的发明动力。这一传统概念要求排他性；一项专利的价值因此与市场上或者它所控制的市场缝隙的价值相称。”）。

**COMMENTS OF THE AMERICAN BAR ASSOCIATION'S  
SECTION OF ANTITRUST LAW, SECTION OF INTELLECTUAL PROPERTY  
LAW, AND SECTION OF INTERNATIONAL LAW ON THE PUBLIC  
COMMENT DRAFT OF THE SUPREME PEOPLE'S COURT'S DECISION ON  
REVISING APPLICATION OF THE LAW IN THE HEARING OF PATENT  
DISPUTE CASES**

**August 15, 2014**

*The views stated in this submission are presented on behalf of the Sections of Antitrust Law, Intellectual Property Law, and International Law of the American Bar Association. They have not been approved by the House of Delegates or the Board of Governors of the American Bar Association and therefore may not be construed as representing the policy of the American Bar Association.*

The Sections of Antitrust Law, Intellectual Property Law, and International Law of the American Bar Association ("the Sections") are pleased to submit comments on public comment draft of the Supreme People's Court's Decision on Revising Application of the Law in the Hearing of Patent Dispute Cases ("the Consultation Draft"). The Sections' comments reflect the expertise and experience of its members with competition and intellectual property law.

The Sections welcome the Supreme People's Court's ("SPC") efforts to provide increased transparency and guidance through amending the Consultation Draft and appreciate the opportunity to provide comments. The Sections' comments focus on discussion in Article 21 regarding the calculation of royalties damages.

**General Comments**

Effective remedies for patent infringement are crucial to promote innovation and competition by protecting innovators' ability to reap benefits from their investments in research and development and commercialization of new products.<sup>1</sup> In order to adequately protect incentives to innovate, remedies should compensate for past infringement, prohibit future infringement, and deter infringement in the first instance. In the United States, patent remedies provide three types of redress to achieve these goals: (1) compensatory damages, which seek to return the patentee to the financial condition it would have been in but for the infringement; (2) enhanced damages, which are designed to deter willful infringement; and (3) injunctive relief where appropriate, which seeks to preserve the patentee's exclusivity and deter infringement in the first instance.

Patent remedies that undercompensate or overcompensate patentees compared to the market reward, absent infringement, can harm consumers. Remedies that

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<sup>1</sup> See, e.g., FED. TRADE COM., *The Evolving IP Marketplace: Aligning Patent Notice and Remedies with Competition* at 140-41 (Mar. 2011), available at <http://www.ftc.gov/sites/default/files/documents/reports/evolving-ip-marketplace-aligning-patent-notice-and-remedies-competition-report-federal-trade/110307patentreport.pdf>.

systematically undercompensate patentees reduce incentives to innovate. Denying the ability to seek injunctions in all circumstances can undermine the ability of patentees to obtain the full market reward from the commercialization of their inventions. Remedies that overcompensate patentees beyond the market reward can result in price increases if excessive damages awards are passed on to the consumer. Thus, it is important that damage awards attempt to accurately replicate the market reward an invention could have earned absent infringement.

## Article 21

Article 21 identifies factors courts may consider when they assess reasonable royalties damages based on prior licensing fees. It provides that when prior licensing fees are “manifestly unreasonable,” the court can disregard them.

The goal of a reasonable royalty damages calculation is to replicate the market reward for the invention in the absence of infringement. It accordingly should depend on what a willing licensee and a licensor would have agreed to in a hypothetical negotiation. The seminal case in the United States, *Georgia-Pacific Corp. v. United States Plywood Corp.*, describes the proper measure of damages as “[t]he amount that a licensor (such as the patentee) and the licensee (such as the infringer) would have agreed upon (at the time the infringement began) if both had been reasonably and voluntarily trying to reach an agreement.”<sup>2</sup> The central tenet of this framework is the willing licensor/willing licensee model, under which the awarded amount must be acceptable to both parties. The royalties must adequately compensate the patentee for permitting the use while leaving the infringer an appropriate level of anticipated profits from using the invention.

U.S. courts apply two assumptions when implementing the hypothetical negotiation. First, the finder of fact must assume that the hypothetical negotiation takes place at the time the infringement began. This timing determines the information available to the parties during the negotiation. Thus, in setting a reasonable royalty rate, considerations such as the infringer’s expected profit and available alternatives are “to be determined not on the basis of the hindsight evaluation of what actually happened, but on the basis of what the parties to the hypothetical license negotiations would have considered at the time of the negotiations.”<sup>3</sup>

Second, courts require the fact-finder to assume that at the time of the negotiations the parties know with certainty that the patent is valid and infringed by the defendant’s product or process. This assumption ensures that the patentee, having incurred the risk and burden of trial and prevailed, is fully compensated.

In constructing the hypothetical negotiation, U.S. courts consider evidence of market factors that the negotiating parties would consider in determining the royalty

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<sup>2</sup> *Georgia-Pacific Corp., v. U.S. Plywood Corp.*, 318 F. Supp. 1116, 1120 (S.D.N.Y. 1970), *modified and aff’d*, 446 F.2d 295 (2d Cir. 1971).

<sup>3</sup> *Hanson v. Alpine Valley Ski Area, Inc.*, 718 F.2d 1075, 1081 (Fed. Cir. 1983).

rate. Because each technology and market is different, the evidence considered and the weight placed on each factor will vary based on the circumstances.<sup>4</sup>

We recommend that the SPC consider amending Article 21 to specify that courts seek to re-create the hypothetical negotiation and willing licensor/willing licensee model as the conceptual framework for determining a reasonable royalty. The courts would then consider evidence of market factors that would bear on the appropriate royalty. This approach would serve to protect incentives to innovate and guard against under- or overcompensation.

With respect to standard-essential patents (“SEPs”) on which the SEP holder has made a voluntary commitment to license on reasonable and nondiscriminatory (“RAND”) terms, U.S. courts have considered specific factors to re-create a hypothetical negotiation between the parties. For example, courts have held that “the parties in a hypothetical negotiation would set RAND royalty rates by looking at the importance of the SEPs to the standard and the importance of the standard and the SEPs to the products at issue.”<sup>5</sup> Furthermore, “a RAND commitment should be interpreted to limit a patent holder to a reasonable royalty on the economic value of its patented technology itself, apart from the value associated with incorporation of the patented technology into the standard.”<sup>6</sup>

Lastly, Article 21 prohibits the use of licensing fees previously agreed to in the market with licensees if those fees are “manifestly unreasonable.” The vagueness of the standard for what is “manifestly unreasonable” could lead to decisions that deviate from a market-based approach.<sup>7</sup> To induce innovation and market growth, a patent holder should generally be permitted to charge whatever price the market will bear.<sup>8</sup> Absent evidence that the prior licensing fees were the result of anticompetitive conduct, such fees that are negotiated at arms-length provide an indication (and may be the best available evidence) of the market value of the patent.

To the extent that Article 21 refers to licenses that are comparable to licenses for the infringed patent, such evidence may reliably assist the trier of fact when

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<sup>4</sup> The *Georgia-Pacific* court identified a list of 15 non-exhaustive factors. Factor 15 is the hypothetical negotiation amount and the other 14 factors list categories of evidence. *Georgia-Pacific Corp.*, 318 F. Supp. at 1120.

<sup>5</sup> See, e.g., *Microsoft Corp. v. Motorola, Inc.*, 2013 WL 2111217, \*3 (W.D.Wash. Apr. 25, 2013).

<sup>6</sup> *Id.* at \*12.

<sup>7</sup> Daniel F. Spulber, “How Do Competitive Pressures Affect Incentives to Innovate When There Is a Market for Inventions?,” 121 J. POL. ECON. 1007, 1040 (2013) (“[A]ntitrust and IP policies that weaken IP rights reduce participation in markets for inventions. Antitrust policies thus should avoid restricting IP rights through limits on royalties, technology standards, or market transfers of IP. Limiting appropriability of IP, by constraining markets for inventions, generates competitive pressures from imitation and expropriation that decrease incentives to innovate.”).

<sup>8</sup> See, e.g., Mark A. Lemley, “Distinguishing Lost Profits from Reasonable Royalties,” 51 WILLIAM & MARY L.R. 655, 657 (2009) (“The traditional conception of patent protection is to give patent owners a means of excluding competitors from selling the patented product, thereby increasing their profits and therefore the incentive of putative patent owners to invent. This traditional conception requires exclusivity; the value of a patent is accordingly commensurate with the value of the market or market niche it controls.”).

the patented invention and its infringing use are sufficiently similar to those of the comparable license. Key attributes for evaluating similarity include the technology, the rights licensed (one patent or a portfolio), royalty type (running royalty or lump sum), and terms of the license (one product or many). When a license is found comparable and negotiated at arms length, it should be considered as evidence without regard to whether the terms are “manifestly unreasonable.”

Thus, we respectfully suggest that Article 21 be amended to delete this prohibition and permit courts to consider all prior and comparable licensing fees and not exclude those deemed to be “manifestly unreasonable.”

### **Conclusion**

The Sections appreciate the opportunity provided by the SPC to comment on its Consultation Draft. We would be pleased to respond to any questions the SPC may have regarding these comments, or to provide additional comments or information that may be of assistance to the SPC.