SQUIRE PATTON BOGGS

如何创建全球专利布局
A Guide to Developing an International Patent Portfolio

2015年，中国以16.8%的专利申请量增幅成为国际专利申请数量排名第三的国家，推动了亚洲（申请量）的上涨。同年，中国占到了世界专利申请总量的近14%。中国公司愈来愈意识到良好的国际专利布局可以带来的价值。在全球舞台上创造这样的布局需要的是谨慎。

In 2015, China ranked third in the number of international patent filings by country[1], driving growth in Asia with a 16.8% increase in filings. In the same year, Chinese were responsible for making nearly 14% of the world's total patent filings.[2] Chinese firms have a growing awareness of the value that a well-developed international patent portfolio can bring. Creating such a portfolio for the global arena requires care.

虽然专利提供的保护有国别之分，但它们保护的商业或可能出现的纠纷在范围上往往是域外的。中国公司如何有效地取得并使用专利以推进它们的商业目标？以下是为具有全球性思维的实务者提供的一些关于专利布局、专利实施以及处理国际专利纠纷的选择相关的标准。

While patents provide protection nation by nation, the businesses they protect and the disputes that may arise are often extraterritorial in scope. How can Chinese companies effectively obtain and use patents to advance their business goals? Here are some criteria for practitioners that are thinking globally about a patent portfolio, its enforcement and the options for handling global patent disputes.

创建全球专利布局

Developing a Global Patent Portfolio

为了取得全球范围内的专利保护，通常需要在每一个想要获得保护的国家取得专利，但这既困难又昂贵。为了简化这一程序，《专利合作条约》（“PCT”）规定了在其150个成员国取得专利的统一程序。在提交一项PCT 申请时，需事先进行作品检索并提供意见，然后专利权人选择申请专利的国家。《欧洲专利公约》为欧洲专利局的专利颁发提供的类似规定，该规定在38个欧洲国家生效适用。

In order to get worldwide patent protection, it is necessary to get patents in every nation where protection is desired, which is both difficult and expensive. To simplify the process, the Patent Cooperation Treaty (PCT) provides a unified procedure for obtaining patents in its 150 nation members. A single PCT application is filed, a prior art search and opinion are provided, and the patentee then chooses the nations in which to pursue patents. The European Patent Convention similarly provides for issuance of a European Patent Office patent, which can be put into effect in any of 38 European countries.

这些程序有助于最大程度地减少在欧洲的专利准备以及实施的费用。但是，这些费用仍然是很高的。在美国，一项专利的总费用通常相当于人民币200,000 至400,000元，包括了申请的起草、提交和实施，以及专利的维护。如果需在五个法域内——美国、中国、印度、欧洲和日本申请PCT专利的颁发，费用通常是人民币1.4至2百万元。因此，在五个法域内的相对小的10个专利的布局需要上百万元的费用。

These procedures help minimize the costs of patent preparation and, in Europe, prosecution. But costs are still high. In the US, total cost for one patent is usually the equivalent of RMB 200,000 to 400,000. This includes drafting, filing and prosecuting the application, as well as maintaining the patent. For a PCT application that issues in just five jurisdictions – US, China, India, Europe and Japan – the cost is usually RMB 1.4-2 million. Thus, a relatively small portfolio of 10 patents in five jurisdictions can cost millions.

随着专利费用的不断升级，即使是财力雄厚的公司也需要对申请哪种专利、申请哪里的专利以及专利颁发后的维护时间等予以决策。专利预算和委员会为该等决策的做出提供了机制以及控制成本的有效途径。但是战略性的决策将会最大化专利布局的价值。

Given the escalating nature of patent costs, even well-funded companies need to make decisions about which patent applications to pursue, where to pursue them and, if issued, how long to maintain them. Patent budgets and committees can provide the mechanism for such decision-making, and are effective means to control costs. But strategic decision-making will maximize the value of a patent portfolio.

首先，专利应当覆盖公司产品或竞争对手产品中使用的或考虑使用的技术。专利指向的特征对于产品功能或最为公司所重视的吸引力方面是极为重要的。发明的难度、所涉及的技术水平和/或发明人的资历都不应确定哪些发明能被授予专利。

1 以在《专利合作条约》（PCT）项下的申请量为准。
As measured by filings under the Patent Cooperation Treaty (PCT).

2 美国的国际专利和商标申请占据领先地位，WIPO, PR/2016/788（2016年3月16日），http://www.wipo.int/pressroom/en/articles/2016/article_0002.html.
US Extends Lead in International Patent and Trademark Filings, WIPO, PR/2016/788 (March 16, 2016), http://www.wipo.int/pressroom/en/articles/2016/article_0002.html.

First, patents should cover technologies being used – or contemplated for use – in the company's products or, alternatively, in competitor products. Patents directed to the features that are important for the products' function or appeal will be most valuable to the company. The difficulty of the invention, level of skill involved and/or the qualifications of the inventors should not determine which inventions are patented.

其次，关于获取哪里的专利的决策与以什么去申请专利的决策是同等重要的。此处需考虑三个“C”：竞争对手（competitor）、顾客（customer）以及法院（court）。在竞争对手拥有专利的情况下获得专利有助于在可能出现争议的领域内公平竞争。在竞争对手拥有的业务活动或设施方面获得专利可以使你从源头上影响它们的业务。在你的客户所处的国家获得专利可以确保你保有客户，因为你可以排他地抵制源自该市场的产品。

Second, decisions about where to get patents are as important as decisions about what to patent. The three "Cs" should be considered: competitors, customers and courts. Getting patents where your competitors have patents helps level the playing field should disputes arise. Getting patents where your competitors have business activities or facilities means you can affect their business at its source. Getting patents in nations where your customers are located helps ensure they remain your customers because you can exclude copycat products from that market.

尤其重要的是，在有良好法院（或其他执行机关）的国家获得专利意味着你的专利得以利用，且如有必要，得以强制执行。

Importantly, getting patents in nations with good courts (or other enforcement bodies) means your patents can be leveraged and, if necessary, enforced.

在全球范围内的利用和实施专利

Leveraging and Enforcing Patents on a Global Scale

当考虑在全球范围内实施专利时，公司应当根据公司的期望和目标，对在哪里提起诉讼做出一项关键评估。

When considering enforcement of patents on a global scale, companies should make a critical assessment of where to bring suit given the company's expectations and goals.

评估在哪里实施专利时，用于考量获得专利的三个“C”因素同样适用。在竞争对手开展业务的国家或可能客户所处的具有最大业务利益的国家提起诉讼——因为可以禁止竞争对手的活动并可以获得赔偿。在理想情况下，竞争对手不会有可以作为回应的专利。

The same three "C" factors considered in getting patents are useful in assessing where to enforce them. Litigation in countries where competitors are doing business and where customers are located may have the greatest benefit for the business – as the competitors' activities can be stopped and damages can be obtained. Ideally, competitors will not have patents that could be asserted in response.

不同国家法院的经验、实务和在该等案件上花费的时间都不同。德国法院通常可以在数月之内完成对专利侵权和技术优势的有效性诉讼（尽管是单独的诉讼）的裁决。相反，美国陪审团的裁决是很难预料且用时很长的。

Courts across nations vary in their experience, practices and the time it takes them to decide such cases. German courts are accomplished in deciding patent infringement and validity actions on technical merits (albeit in separate actions), usually within months. By contrast, decisions by juries in the US can be unpredictable and slow to receive.

在单个法域内，通常会有多种渠道，在中国企业制定最佳布局之前，每一渠道都需要经过仔细审查。例如，具有处理专利诉讼经验的美国联邦地区法院通常是首选，但是它们在做出裁决或审判的时间上以及如何处理某些问题上有所不同。位于华盛顿特区的美国国家贸易委员会（ITC）是另一选择，提供了侵权产品的进口禁令。在任何裁决中，被告在专利上诉委员会（PTAB）挑战专利效力的可能性都应当予以考虑，因为这可能给地区法院的诉讼造成拖延。 这些决定都应当基于公司对于诸如争议解决、禁令和损害赔偿的期望和目标而做出。

Even within a single territory, there are often various approaches, each of which must be diligently scrutinized before a Chinese enterprise can craft the optimal portfolio. For example, US federal district courts that have experience handling patent litigations are usually preferred, but they differ in how long it takes to get a decision or a trial and how they handle certain issues. The US International Trade Commission (ITC) in Washington DC is another option, offering bans on importation of infringing products. In any decision, the likelihood that the defendant will challenge the validity of the patent before the new Patent Trial and Appeal Board (PTAB) should be considered, as this may stall litigation in a district court. These decisions should be made in view of the company's expectations and goals, such as settlements, injunctions and damages.

成本也是重要因素，且各国之间差距很大。在中国法院的专利诉讼成本通常少于人民币1百万元，德国法院的专利诉讼成本通常为人民币2700万元，美国联邦地区法院的专利诉讼成本通常为人民币1170至2800万元。

Costs are also important, and vary dramatically among nations. While costs in the China IP Court are usually less than RMB 1 million, patent actions in a German court are usually RMB 2.7 million, and patent litigation in a US federal district court usually costs RMB 11.7 to 28 million.

谨记这些因素，在各国对相应专利提出多项诉讼具有战略性的挑战和机会，以最大限度地发挥执法活动的价值。

With these factors in mind, filing multiple actions across countries on corresponding patents presents strategic challenges and opportunities for maximizing the value of enforcement activities.

协调这些行动是至关重要的。例如，在美国，在一项诉讼中提供的证据通常不能在该事项之外使用，律师必须非常谨慎以免违反保护令。 但是， “第1782款”项下的传票可用于获得非美国程序目的的发现。 此外，为一项诉讼程序进行的内部研究和调查可用于该诉讼程序而分享给律师。 此外，在一个程序中提出的论据和辩护可以预见在另一个程序中提出的论据和辩护。 最后，一个法庭的裁决可以提交给另一个法庭，并可以提供信息或说服力。

Coordination of such actions is the key. For example, in the US, evidence provided in one action typically cannot be used outside of that matter, and counsel must be very careful that they do not violate protective orders. However, “section 1782” subpoenas can be used to obtain discovery for purposes of a non-US proceedings. Also, internal research and investigation done for one proceeding can be shared among counsel for use in the proceedings. In addition, arguments and defences raised in one proceeding may preview the arguments and defences to be made in another. Finally, decisions of one tribunal may be submitted to another, and may be informative or persuasive.

一国的裁决并不对另一国产生约束，即使争议的是相同的专利和产品，它们（的裁决）仍可能不同。但至少，多项诉讼可能为一个有利的结果提供很多机会。

Decisions of one nation are not binding on another and they may differ, even when the same patents and products are at issue. But at the very least, multiple actions can offer multiple chances for a favourable outcome.

全球性思维

Think Globally

考虑竞争对手、顾客和法院因素的基础上创建的国际专利布局为中国公司提供了在全球范围内以成本效益和价值驱动的方式战略性地利用和实施专利的机会。 这种协调的专利布局和实施策略也可以在全球范围内解决专利纠纷，这对中国企业来说是日益重要的，因为他们希望在国外建立品牌。

Developing an international patent portfolio that considers competitors, customers and courts provides Chinese companies with opportunities to strategically leverage and enforce patents in a cost-effective and value-driven manner on a global scale. Such coordinated patent portfolio and enforcement strategies may also enable resolution of patent disputes on a global basis, which is of ever-increasing importance for Chinese businesses as they look to build brands beyond their borders.

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