

## Targeted to handle IPR disputes overseas

阿里巴巴在美遭遇专利诉讼, 专家建议——

# 中企“走出去”应对专利纠纷当有的放矢

Express Mobile Inc., an enterprise mobility solutions developer in the U.S., recently announced the filing of a patent infringement lawsuit against the Alibaba Group, a Chinese e-commerce company, in the United States District Court for the Eastern District of Texas, Marshall Division. In the statement, Express Mobile accused Alibaba for infringing its patent related to the development of web-sites.

The case has attracted worldwide attention. According to an insider-watcher, the patent is probably a fundamental patent in platform technology and it will probably extend to 100 more patents. “Nowadays, more and more Chinese companies have listed in the US, while enjoying relative accommodative financial environment in U.S., they also have to face IPR risks.” Says this anonymous analyst. He suggests to Chinese that extreme thorough preparatory works should be made before IPO. Firstly, plan ahead. Always be ready to deal with possible patents litigations. Secondly, face it actively. Conduct further analysis on the extent of protection of the patent right and make preliminary estimation whether or not infringement is constituted. Meanwhile, they should also figure out what they really want.

On September 19th, 2014, Alibaba's shares began trading on the

NYSE at an opening price of \$92.70 at 11:55 am EST. Alibaba's market value was measured as US \$231 billion on its first trading day, and became world second largest internet company, topping Facebook.

However, Alibaba's IPR troubles follow up and it has to deal with frequent IPR disputes since then. “Alibaba's troubles are not exception, most of the Chinese companies listed in U.S. have the same troubles.” Says Zhao Chengwei, an IPR attorney from Beijing-based law firm. Zhao analyzes that there are two reasons for this. Firstly, Chinese companies have broken the traditional pattern of U.S. market and the patent litigations have been regarded as important commercial competitive factors and marketing means by the rivals. Secondly, some patent operating companies want to obtain higher patent licensing fees by means of patent lawsuits.

“To answer the question mentioned above, Chinese companies should make thorough preparatory works. First and most importantly, no fear of lawsuits, hire at least one professional lawyer team as soon as possible. Secondly, make thorough investigation and analysis of the extent of protection of the patent rights and patent right stability. If infringement is constituted, never give up easily and prepare for the lawsuit actively.” Says

Zhao Chengwei.

Meanwhile, He Jing, an attorney from a law firm named Anjie, suggests that in case of infringement, Chinese companies should negotiate with the plaintiff before litigation. Also, they should strengthen communication with other defendants to share the information and exchange coping strategies. “Attack is the best method of defense. Chinese companies could also file patent cases against the rivals.” Says He Jing.

To those who prepare to be listed in U.S., Zhao suggests that two aspects of preparatory works should be made. Firstly, establish corporate patent early warning mechanism. Carry out patent retrieval in the shortest time and set up the corresponding countermeasures in case infringement constituted. Secondly, Chinese companies should establish patent layout strategy actively.

“Of course, to win the final dispute, Chinese companies should strengthen R&D investment and focus on technology upgrade. To avoid disputes, Chinese companies can sign patent cross-licensing agreements with the rivals or establish joint patent defense fund.” Says He Jing.

(by Feng Fei)

本报记者 冯飞

近日, 美国 IT 公司 Express Mo-

bile 在美国德克萨斯州东区法院向阿里巴巴提起专利诉讼。记者在采访中了解到, 此次阿里巴巴在美国被诉专利侵权, 涉案专利内容涉及网站开发技术, 其保护范围涵盖电商平台搭建和应用, 从该专利引申的后续专利多达 100 多件。有专家指出, 该专利很有可能属于电商平台技术领域的基础专利。

近年来, 越来越多的中国企业选择在美国上市, 其在享受美国宽松融资环境的同时也面临诸多知识产权风险。有专家表示, 中国企业赴美上市前, 要做好知识产权规划, 针对有可能出现的专利诉讼提前做好准备; 专利诉讼来临时, 应积极应对, 深入分析涉诉专利的权利保护范围、是否侵权等, 同时研究对手的诉讼目的, 只有做到有的放矢, 应对专利诉讼时才能游刃有余。

阿里巴巴于 2014 年 9 月 19 日登陆美国纽约证券交易所, 首个交易日, 阿里巴巴市值超过 2300 亿美元, 超越美国脸谱公司成为全球市值排名第二的互联网公司。在迎来鲜花和掌声的同时, 阿里巴巴面临的知识产权风险也引发业界关注。

事实上, 赴美上市的中国企业在美国遭遇专利诉讼, 阿里巴巴并非个例。宽松的入市制度、成熟的资本市场吸引着越来越多的中国企业赴美上市, 但为何中国企业频频遭遇专利诉讼? “中国公司之所以成为‘靶子’, 究其原因, 一是中国公司打破了美国市场原有的利益格局, 竞争对手将专利诉讼作为一种商业竞争手段;



二是专利运营公司通过向上市公司提起专利诉讼, 希望上市公司能够向他们支付更高的专利许可费或从和解中获益。”北京市盈科律师事务所知识产权专业委员会主任赵成伟在接受中国知识产权报记者采访时表示。

“中国上市公司遭遇涉外专利诉讼时, 不要有畏惧心理, 应选择专业的律师团队, 深入分析涉诉专利的稳定性 and 权利保护范围, 如果构成侵权, 则积极应对。”赵成伟向本报记者表示, 只有做到有的放矢, 在应对专利诉讼时才能游刃有余。

安杰律师事务所合伙人何菁在接受中国知识产权报记者采访时表示, 中国企业在应对涉外专利诉讼时, 如果涉诉专利构成侵权, 应在开庭前, 积极与原告进行诉前谈判; 同时, 中国企业还应与其他涉诉企业加强沟通, 可以信息共享、共商对策。

“进攻是最好的防御。”在何菁看来, 中国上市公司应不断提升自身实力, 在遭遇专利诉讼时, 也向对方发起专利诉讼。

对于赴美上市的国内企业来说, 为避免专利诉讼, 如何做到未雨绸缪? 赵成伟表示, 中国企业在赴美上市前, 首先要进行专利预警分析, 对要进入国际市场的产品的专利情况进行检索, 针对有可能出现的专利侵权, 尽快制定相应对策; 其次, 中国企业应积极在美国进行专利布局, 储备自己的专利“武器”, 以免在遭遇专利战时被动挨打。

“中国企业要做好知识产权规划, 注重技术研发, 加强专利布局。在具备一定专利实力后, 中国公司可以与国外竞争对手进行专利交叉许可, 并共同出资建立联合专利防御基金, 保护共同利益, 避免潜在的专利诉讼。”何菁建议。

## NUMBERS

94,501

In 2014, the courts all over China received 95,522 intellectual property civil cases, and 94,501 cases of them were concluded, respectively up 7.83% and 7.04%.

9.4501 万件

2014 年, 中国各地地方人民法院共新收和审结知识产权民事一审案件 9.5522 万件和 9.4501 万件, 比 2013 年分别上升 7.83% 和 7.04%。

48.9 billion Yuan

In 2014, China secured 48.9 billion Yuan credit with patent right pledge, up 92.5%; secured 51.9 billion Yuan credit with 8,721 trademark pledge; secured 2.625 billion Yuan credit with copyright pledge.

489 亿元

2014 年, 中国专利权质押融资金额达 489 亿元, 同比增长 92.5%; 商标质押 8721 件, 融资金额 51.9 亿元; 版权实现质押融资 2.625 亿元。

4,859

In 2014, all the Procurator Organs of China arrested 4,859 suspects in 2,924 intellectual property cases. 8,834 suspects in 5,156 intellectual property cases were prosecuted.

4859 人

2014 年, 中国各级检察机关共批准逮捕涉及侵犯知识产权犯罪案件 2924 件, 4859 人, 提起公诉 5156 件, 8834 人。

(摘自《2014 年中国知识产权保护状况》)

## SIPO patent search and service system added seven languages versions

### 中国专利检索与服务系统新增 7 种语言版本

Based on the Chinese and English versions, SIPO patent search and service system has made a major upgrade recently, adding seven other foreign language versions, namely Russian, Spanish, Portuguese, German, Arabic, Japanese and French, for users abroad. New system has been in operation on April 27th.

The patent search and service system was successfully initiated on April 26, 2011. This system is similar to the digital search system of libraries

which can provide comprehensive patent search services for users all over the world, thus it has an intelligent feature. In efforts to provide convenient service and favorable experience for users abroad, SIPO has re-designed the UI and added seven other foreign language versions, based on usage habits by users from different language zone and the languages characters themselves. Users from abroad now enjoy the same operation experience and service with the Chinese-language users, and can update the system and data timely.

Up to now, the patent search and service system has released several major upgrades, and has added several functions, such as one-stop search, medicine search, structured search, data mining analysis, patent utilization platform and multi-language etc.

(by Wu Yan)

本报讯 为了满足国外用户的使用需求, 中国国家知识产权局专利检索与服务系统在原有中英文版本的基础上, 新增了 7 种语言版本, 分别为俄文、西班牙文、葡萄牙

文、德文、阿拉伯文、日文、法文, 这 7 种语言版本的系统已于 4 月 27 日正式上线运行。

据了解, 专利检索与服务系统是中国国家知识产权局为方便公众了解专利的相关信息, 更好地向公众提供专利信息服务而建设的一套集专利检索与分析于一体的综合性专利服务系统。该系统自 2011 年上线以来, 深受用户欢迎。基于国外用户的使用需求, 中国国家知识产权局在充分分析国外用户的使用习惯以及各个语种特点的基础上, 对系统功能进行了全新的 UI 设计, 在

保障功能应用的前提下, 进一步完善了用户体验。7 种语言版本的系统上线后, 使用这些语言的国外用户通过该系统, 可以使用系统中提供的所有专利检索与专利分析功能, 并随时掌握系统版本升级和数据更新的最新情况。

据悉, 经过近期的不断丰富和完善, 目前专利检索与服务系统已经在原有功能基础上增加了一站式检索、药物专题检索、钻取检索、钻取分析、专利运用平台以及多国语言版本等多项业务功能。

(吴艳)



## “Taikuli Sanlitun” trademark was rejected

### “三里屯太古里”商标注册被驳

John Swire & Sons Limited (here in after as JSSL) in China applied for the registration of “Taikuli Sanlitun” trademark in education and teaching services. The Trademark Review and Adjudication Board (hereafter as TRAB) under State Administration for Industry and Commerce of China rejected the application followed by administrative stage of the case proceedings. Recently, Beijing No.1 Intermediate People's Court maintained the decision made by TRAB.

It is told that the No. 10344459 trademark application “Taikuli Sanlitun” was applied by JSSL in December in 2011, used on specify type of organization in the 41st classification for performances (shows), education, lectures, teaching and other services.

After the Trademark Office decided to reject the trademark registration, JSSL applied for a review to

TRAB. TRAB held that the applied trademark “Taikuli Sanlitun” was a famous commercial street in Beijing, and its use as a trademark could easily lead to confusion among the relevant public, and if the text is exclusively used by only one subject, it is easy to cause adverse effects. So TRAB decided to reject the trademark registration application.

JSSL refused to accept the decision, and then filed the administrative lawsuit to the Beijing No.1 Intermediate People's Court.

The Court held that, the word in the application for trademark “Taikuli Sanlitun” was a commercial street in Beijing, and had a certain reputation, and should not be used exclusively; the trademark application for registration specifically on the use of a organizational performances (shows), education, lectures, teaching and other

services, was easy to lead to the confusion of relevant public on services and its source, thus it should not be used as a trademark; the trademark examination was for the individual case review; the registered trademark JSSL offered could not be the basis for other trademark registration application.

(by Zhang Ling)

本报讯 英国太古集团有限公司(下称太古公司)在中国欲将“三里屯太古里”商标注册在教育、教学等服务上, 被中国国家工商行政管理总局商标评审委员会(下称商评委)以申请商标易造成不良影响为由, 驳回太古公司的注册申请, 随后该案进入行政诉讼阶段。日前, 北京市第一中级人民法院一审判决维持了商评委被诉决定。

据了解, 申请商标为第 10344459 号“三里屯太古里”商标, 由太古公司于 2011 年 12 月提出注册申请, 指定使用在第 41 类组织表演(演出)、教育、讲课、教学等服务上。



在中国国家工商行政管理总局商标局决定对申请商标予以驳回后, 太古公司向商评委申请复审。

商评委经审理认为, 申请商标“三里屯太古里”是北京著名的商业街, 作为商标使用易造成相关公众混淆误认, 且该文字若为一家所独占, 易造成不良影响, 据此决定对申请商标予以驳回。太古公司不服商评委决定, 随后向北京市第一中级人民法院提起行政诉讼。

法院经审理认为, 申请商标的文字“三里屯太古里”系北京商业街, 具有一定的知名度, 不应被独占使用。

申请商标指定使用在组织表演(演出)、教育、讲课、教学等服务上, 容易使相关公众对其服务的来源产生误认, 故申请商标不得作为商标使用。而商标审查为个案审查, 太古公司所提相关商标已获注册不能作为该案申请商标的审查依据。

(张玲)

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