



美国专利诉讼的最新发展趋势 和应对要领

U.S. Patent Litigation:
New Developments, Trends, and
Essentials You Must Know

主办单位
HOSTED BY



清华大学法学院
TSINGHUA UNIVERSITY SCHOOL OF LAW

协办单位
CO-HOSTED BY

PERKINScoie
博钦律师事务所



模拟法庭
MOOT COURT

前言 / PREFACE

近年来，随着越来越多的中国企业走出国门，这些企业也屡屡成为美国专利诉讼案的对象。为解决广大企业在此方面的困扰，美国博钦律师事务所和清华大学法学院特联合举办此次讲座，邀请美国政府人士、美国执业律师，以及中国知识产权法界的学者来共同讲解美国专利诉讼发展的最新趋势与应对要领，并着重介绍337类案件和最近广受业界关注的“双方参与专利行政诉讼（IPR）”。

Recently, as more and more Chinese companies entered international markets, they also became common targets for patent litigations in the U.S. To address these concerns, Perkins Coie LLP and Tsinghua University Law School are pleased to co-host a symposium on U.S. Patent law, and invited key figures from the U.S. Government, practicing U.S. attorneys, and Chinese academics in the intellectual property law field, to discuss the new trends in U.S. patent litigation and strategies for litigating patent cases in the U.S., especially for the 337 Investigations at the U.S. International Trade Commission and the Inter Partes Review proceeding at the U.S. Patent and Trademark Office.

主讲人 / PRESENTED BY

- 美国国际贸易委员会委员 David S. Johanson先生
Commissioner of the U.S. I.T.C. Mr. David Johanson
- 清华大学法学院知识产权法研究中心主任 崔国斌副教授
Tsinghua Univ. Law School Assoc. Prof. Cui Guobin, director of intellectual property law center
- 北京大学法学院 杨明教授
Peking Univ. Law School Prof. Ming Yang
- 美国驻华大使馆知识产权专员 Joel B. Blank先生
Intellectual Property Attach é at U.S. Embassy in Beijing Mr. Joel B. Blank
- 美国博钦律师事务所律师
Perkins Coie LLP attorneys Messrs. J. Coughlan, B. Ai, K. Patariu and D. Zhang



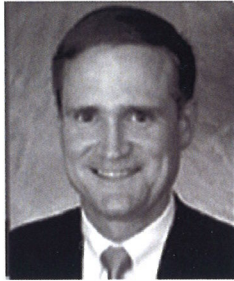
研讨会主题与安排 / Seminar Topics & Schedule

13:00 - 13:30	签到 Registration
13:30 - 13:40	开幕致辞 Opening Remarks 清华大学法学院知识产权法研究中心主任 崔国斌副教授 Assoc. Prof. Cui Guobin
13:40 - 14:10	美国国际贸易委员会概况 An Overview of the International Trade Commission 美国国际贸易委员会Johanson委员 Commissioner Johanson
14:10 - 14:30	中美知识产权领域内的争端与合作 Disputes & Cooperation between U.S. and China in the IP Field 美国驻华大使馆知识产权专员Blank先生 IPR Attach é Mr. Blank
14:30 - 15:15	美国专利诉讼的最新趋势 New Trends in U.S. Patent Litigation 美国博软律师事务所律师 <i>Perkins Coie Panel</i> · 联邦地方法院与国际贸易委员会诉讼的最新趋势 Litigation Trends in the District Courts and the ITC · 最近广受业界欢迎的“双方参与专利行政诉讼 (IPR)” The New and Popular Inter Partes Review Proceeding at the US Patent Office



15:15 - 15:30	茶歇 Tea Break
15:30 - 16:00	337调查的法律适用问题及中国企业的应对 The application of law in 337 cases and Chinese enterprises' reply 北京大学法学院杨明教授 Prof. Ming Yang
16:00 - 16:30	如何在ITC为自己证实或击败对方的“国内产业”要件 Establishing & Defeating Domestic Industry in the ITC 美国博钦律师事务所律师 Perkins Coie Panel
16:30 - 17:00	ITC可提供的救济方式：禁止进口令、禁制令及其他 ITC Remedies: Exclusion Orders, Cease & Desist Orders, & etc. 美国博钦律师事务所律师 Perkins Coie Panel
17:00 - 17:30	近期有影响力的美国法院知识产权判例一览 Recent Court Cases Affecting Your IP Strategy 美国博钦律师事务所律师 Perkins Coie Panel
17:30 - 17:45	问答环节 Q&A

演讲者介绍 / ABOUT THE SPEAKERS



David S. Johanson
US ITC Commissioner
美国国际贸易委员会委员

David S. Johanson, a Republican of Texas, was nominated to the USITC by President Barack Obama on April 8, 2011, and confirmed by the U.S. Senate on October 31, 2011. He was sworn in as a member of the Commission on December 8, 2011, for a term expiring on December 16, 2018.

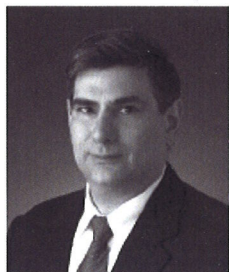
Commissioner Johanson served as International Trade Counsel on the Republican staff of the Committee on Finance of the U.S. Senate from 2003 until his appointment. While on the staff of the Committee on Finance, he was responsible for legislative and policy matters involving negotiations of the World Trade Organization, the Free Trade Area of the Americas, the Trans-Pacific Partnership, and numerous free trade agreements. He assisted in the passage of implementing legislation for free trade agreements between the United States and Australia, Bahrain, Chile, Colombia, Costa Rica, the Dominican Republic, El Salvador, Guatemala, Honduras, Morocco, Nicaragua, Oman, Panama, Peru, Singapore, and South Korea. He also worked on legislative matters concerning trade preference programs (the Generalized System of Preferences, the African Growth and Opportunity Act, the Caribbean Basin Initiative, and the Andean Trade Preference Act), Miscellaneous Tariff Bills, Trade Adjustment Assistance, and the trade-related provisions of the 2008 Farm Bill.

Prior to his employment at the Committee on Finance, he practiced international trade law for six years at the law firm of Stewart and Stewart in Washington, D.C. Earlier in his career, he worked for Senator Phil Gramm (R-TX), Representative Wally Herger (R-CA), and Representative George Radanovich (R-CA).

David S. Johanson委员于2011年4月8日由奥巴马总统提名，2011年10月31日被美国参议院批准，担任美国国际贸易委员会委员。他于2011年12月8日宣誓就职，任期至2018年12月16日。

此前，**Johanson**委员于2003年起担任美国参议院金融委员会国际贸易律师。在此任上，他负责与WTO、北美自由贸易区、跨太平洋伙伴关系等自由贸易协议相关的立法与政策工作。他帮助美国完成了与多个国家的自由贸易协议立法工作，包括澳大利亚、巴林、智利、哥伦比亚、哥斯达黎加、多米尼克、萨尔瓦多、危地马拉、洪都拉斯、摩洛哥、尼加拉瓜、安曼、巴拿马、秘鲁、新加坡与韩国。他也参与了许多贸易特惠项目，关税法案，以及其他与贸易相关的法案的立法工作。

在从事参议院金融委员会的工作之前，**Johanson**委员曾在华盛顿的一家律所执业6年，方向是国际贸易法。**Johanson**委员也曾为美国国会的多位参议员及众议员工作过。



James Coughlan

Partner 合伙人
Washington DC Office, U.S.A.
Chicago Office, U.S.A.
Perkins Coie LLP
博钦律师事务所
U.S. Tel: +1-202-434-1670
+1-312-324-8537
JCoughlan@perkinscoie.com

James Coughlan is a partner in the firm's Patent Litigation group and co-chair of the firm's Section 337 investigation practice. Jim has extensive patent litigation experience before the U.S. International Trade Commission both as a partner in private practice and in his former position as a lead staff attorney at the ITC's Office of Unfair Import Investigations. Jim has served as lead ITC counsel in over 40 ITC investigations, has litigated 14 actions through to trial at the ITC and has also litigated 4 ITC actions on appeal before the U.S. Court of Appeals for the Federal Circuit. Jim served as lead ITC counsel in a major dispute involving two well-known, competing smart phone operating systems, and represented two cell phone manufacturers in one of the largest and most significant ITC actions on record which resulted in the Federal Circuit's Kyocera decision. He has represented clients before the U.S. Department of Customs and Border Protection and the Office of the U.S. Trade Representative after the conclusion of the ITC proceedings to obtain approval for design around devices and a delay in the imposition of ITC remedial orders.

Jim's representations have involved patents relating to various technologies including wireless communication devices, 4G communication technologies, streaming video software, portable digital media players, integrated circuits, jet engines, hardware logic emulation devices, adhesives, biotechnology methods for producing growth hormones, smoke suppressants and welding wire. Jim belongs to the ITC Trial Lawyers Association.

In addition to his experience before the ITC, Jim served as legal counsel for U.S. Senator Carl Levin and as judicial law clerk for the Hon. Marion T. Bennett, U.S. Court of Appeals for the Federal Circuit.

James Coughlan 律师是博钦律师事务所专利诉讼业务组的合伙人以及本所的 337 调查类案件组的主管人之一。他曾在美国国际贸易委员会反不正当竞争调查处任首席律师，也曾以个人执业律师身份代理过大量的美国国际贸易委员会专利案件。James Coughlan 律师曾在超过 40 宗美国国际贸易委员会调查案件中担任首席律师，并全程处理过其中的 14 宗，包括 4 宗上诉至美国联邦巡回法院的案件。James Coughlan 律师曾为许多大型的手机厂商代理过美国国际贸易委员会的调查案，包括著名的 Kyocera 案。

在美国国际贸易委员会的调查案结案之后，James 也处理过在美国海关和美国贸易代表处的衍生案件，以帮助客户合理的规避美国国际贸易委员会的不利判决。

James 处理过各技术领域的专利案件，包括无线通讯技术，4G 网络，流媒体视频软件，可携带数码产品，集成电路，喷射式发动机，硬件模拟器，粘合剂，生物技术，戒烟产品，焊接产品，等等。James 是国际贸易委员会诉讼律师协会会员。

除了代理美国国际贸易委员会案件之外，James 也曾是美国 Carl Levin 参议员的律师，并为美国联邦巡回上诉法院的 Marion T. Bennett 法官做过法律助理。



Bing Ai, Ph.D. 艾兵 博士
Partner 合伙人
San Diego Office, U.S.A.
Perkins Coie LLP
博钦律师事务所
U.S. Tel: +1-858-720-5707
ai@perkinscoie.com

Bing Ai, Ph.D. (艾兵 博士) is a partner in the firm's Intellectual Property practice and was a physicist before entering law practice. His practice emphasizes patent prosecution, patent counseling and strategy, patent portfolio management, freedom to operate analyses, patent validity and infringement issues, patent re-examinations and post-grant proceedings, patent due diligence and support for patent litigation, and patent due diligence for corporate financing, investments, mergers and acquisitions.

One particular area of Bing's patent practice is patent post-grant proceedings before the U.S. Patent Office under 2011 Leahy-Smith America Invents Act (AIA) and covers post-grant review (PGR), covered business method (CBM) patent review, inter partes review (IPR), patent reexamination, supplemental examination and reissue proceedings.

Bing practices in a wide range of technology fields, including electronics, semiconductors, wireless technologies, telecommunications, computer hardware, software, Internet-based technologies, display technologies, medical devices and surgical instrument, biomedical diagnostic technologies, biochemical sensors, energy-related technologies including batteries and fuel cells, lasers and optics, and nanotechnology.

艾兵博士是博钦知识产权业务组的合伙人以及该所的专利复核业务组的主管人之一。他在从事法律业务以前是一名物理学家。艾兵律师的执业方向侧重于专利申请，专利规划与咨询，专利组合管理，自由使用权分析，专利有效性及适用性研究，专利复审，专利尽职调查，专利诉讼支持，以及融资与并购中的专利尽职调查。

艾兵律师尤其擅长处理美国2011年专利改革法案中制定的专利复审类案件，包括covered business method (CBM), inter partes review (IPR), 专利复审, 专利补充审查, 以及专利补发类案件。

艾兵律师涉及的技术领域十分广泛，包括电子产品，半导体，无线技术，电子通讯，计算机软硬件，互联网技术，显示屏技术，医疗与外科仪器，生物医疗诊断，生物化学传感器，能源技术（如干电池与燃料电池），激光仪器，以及纳米技术等等。



Kevin Patariu

Counsel 资深律师
San Diego Office, U.S.A.
Perkins Coie LLP
博钦律师事务所
U.S. Tel: +1-858-720-5726
KPatariu@perkinscoie.com

Kevin Patariu is a counsel with the firm's Patent Litigation practice. Kevin's practice includes U.S. District Court patent litigation and International Trade Commission Section 337 investigations. He has successfully tried two patent cases before the ITC.

Kevin also has significant expertise in patent post-grant proceedings before the U.S. Patent Office under the 2011 Leahy-Smith America Invents Act (AIA) which covers post-grant review (PGR), covered business method (CBM) patent review, inter partes review (IPR), patent reexamination, supplemental examination, and reissue proceedings. Kevin is counsel on more than ten IPR petitions, and has prepared and prosecuted numerous inter partes and ex parte reexamination requests. Kevin has also successfully argued before the USPTO Board of Patent Appeals and Interferences (BPAI) in connection with an inter partes reexamination proceeding.

Kevin also practices in the areas of due diligence and freedom to operate investigations, patent prosecution and counseling, and preparation of infringement and validity opinions.

Prior to law school, Kevin worked as an electrical engineer for eight years, designing integrated circuits for a variety of applications, including copier/printer/scanner products, satellite and digital cable set top boxes, removable media card interfaces, and forward looking infrared array (FLIR) sensors. Kevin is the co-inventor of seven U.S. patents in the field of data encryption/decryption.

Kevin Patariu 律师是博钦律师事务所专利诉讼业务组的资深律师。他的业务范围包括美国地方法院诉讼以及美国国际贸易委员会 (ITC) 的 337 调查类案件。他曾在两起 337 调查类案件中担任出庭律师并成功的赢得了案件。

Kevin Patariu 律师在处理美国 2011 年专利改革法案中制定的专利复审类案件中拥有丰富的经验, 包括 covered business method (CBM), inter partes review (IPR), 专利复审, 专利补充审查, 以及专利补发类案件。Kevin Patariu 律师曾代理超过十宗 IPR 案件, 并处理过许多专利单方与双方复审案, 包括在美国专利与商标局的上诉案。

Kevin Patariu 律师的执业范围也包括专利尽职调查、专利自由使用权调查、专利申请、专利侵权与有效性分析。Patariu 律师熟悉的技术领域包括: 半导体仪器设计、半导体制造与调试、软件设计与测试、电脑架构与嵌入式系统、电脑图像系统、数码相机与图像处理、自动机械传导系统、无线通讯以及活性炭处理。

在从事法律工作以前, Kevin Patariu 是一名电子工程师, 并在数据加密与解密领域拥有 7 项美国专利。



Di Zhang 张钧
Associate 律师

San Diego Office, U.S.A.
Perkins Coie LLP

博钦律师事务所

U.S. Tel: +1-858-720-5744

DZhang@perkinscoie.com

Di Zhang (张钧) is an associate with the firm's Patent Litigation practice, whose experience includes U.S. District Court patent litigation and International Trade Commission Section 337 investigations. He has extensive experience in litigating patent cases in the areas of digital cameras and image processing, cloud-based products and services, smartphone related technologies, and audiovisual player devices.

Di also has experience in patent post-grant proceedings before the U.S. Patent Office. He has filed multiple requests for *inter partes* review (IPR) and obtained strategic stay of the district court litigation based on the IPRs filed.

In the areas of due diligence investigation and patent counseling, Di has reviewed patent portfolios for multiple Fortune 500 companies in various technical areas, such as semiconductor devices, software design and testing, LED and OLED manufacturing, and wireless communication devices and systems.

Di is named in the *Super Lawyers* magazines as a "San Diego Rising Star" in 2015.

张钧是博钦专利诉讼业务组的律师。他代理过多宗美国联邦地方法院和美国国际贸易委员会的专利案件，并在数码相机，图像处理，云计算，智能手机，音像产品等领域有丰富的经验。

张律师也处理过多宗在美国专利商标局的专利复审案件，并成功地利用专利复审为客户中止了联邦地方法院案件的审理。

在专利尽职调查与专利咨询领域，张律师曾为多家财富500强企业审阅过各技术领域的专利，包括半导体器件，软件设计与测试，LED和OLED产品的制造，以及无线通讯系统等等。

张钧律师于2015年被美国Super Lawyers杂志评选为“圣地亚哥律师新星”之一。

2015年3月13日，星期五，下午 1:00至下午5:45

Friday, March 13, 2015 (13:00–17:45)

清华大学法学院明理楼模拟法庭

Tsinghua University Law School, Mingli Building, Moot Court