君合专题研究报告 JUNHE

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现有技术抗辩审查中涉案专利权利要求如何为确定比对技术方案提供参照

最高人民法院在申请再审人盐城泽田机械有限公司与被申请人盐城市格瑞特机械有限公司侵犯实用新型专利权纠纷案[（2012）民申字第 18 号民事裁定书]中指出，“在审查现有技术抗辩时，比较方法应是将被诉侵权技术方案与现有技术进行对比，而不是将现有技术与专利技术方案进行对比。审查方式则是以专利权利要求为参照，确定被诉侵权技术方案中被指控落入专利权保护范围的技术特征，并判断现有技术中是否公开了相同或者等同的技术特征。现有技术抗辩的成立，并不要求被诉侵权技术方案与现有技术完全相同，毫无区别，对于被诉侵权产品中与专利权保护范围无关的技术特征，在判断现有技术抗辩能否成立时应不予考虑”。

根据前述判例，在比对被诉侵权技术方案与现有技术的技术方案时，并不是将被诉侵权产品或者方法中所涉及的所有技术特征构成的技术方案与现有技术进行比较，而只是将被诉侵权技术方案中被指控落入专利权保护范围的技术特征构成的技术方案与现有技术进行比较。被诉侵权产品中或者方法中，与涉案专利权保护范围无关的技术特征，在确定被比对被诉侵权技术方案时，不予考虑。这样，涉案专利权利要求就为确定比对技术方案提供了参照。

专利侵权判定的一般原则是所谓全面覆盖原则，要审查被诉侵权产品或者方法的技术特征是否覆盖了发明或者实用新型专利权利要求记载的全部技术特征（以技术特征相同方式覆盖或者以技术特征等同方式覆盖）。其判断的规则是：被诉侵权产品或者方法的技术特征与专利权利要求记载的技术特征恰好全部相同或者等同，落入专利权利要求的保护范围；被诉侵权技术方案除了包含专利权利要求记载的全部相同或者等同技术特征外，还包含有其他技术特征，仍然落入专利权利要求的保护范围。

现有技术抗辩成立的标准是：被诉落入专利权保护范围的全部技术特征，与一项现有技术方案中的相应技术特征相同或者无实质性差异（等同）；或者该领域普通技术人员认为被诉侵权技术方案是一项现有技术与所属领域公知常识的简单组合。

如果被诉侵权技术方案的技术特征与专利权利要求记载的技术特征恰好全部相同或者等同，构成被诉侵权产品或者方法技术方案的技术特征全部都是被诉侵权技术方案中被指控落入专利权保护范围

的技术特征。例如，专利权利要求的技术方案由 a1、b1 构成，被诉侵权技术方案由 a2、b2 构成，如果 a1、b1 与 a2、b2 分别构成相同或者等同，则落入由 a1、b1 构成的专利权利要求保护范围的被诉侵权技术方案的技术特征为 a2、b2。在进行现有技术抗辩审查时，就应将由技术特征 a2、b2 构成的被诉侵权技术方案与现有技术进行比较。

如果被诉侵权技术方案除了包含专利权利要求记载的全部相同或者等同技术特征外，还包含有其他技术特征，仍然落入专利权利要求的保护范围。但在进行现有技术抗辩审查时，比对的技术方案并不是构成被诉侵权技术方案的所有技术特征，而是由落入专利权利要求保护范围的技术特征构成的技术方案。例如，专利权利要求的技术方案由 a1、b1 构成，被诉侵权产品或者方法的技术方案由 a2、b2、c2 构成，如果 a1、b1 与 a2、b2 分别构成相同或者等同，则落入由 a1、b1 构成专利权利要求保护范围的被诉侵权技术方案的技术特征仍为 a2、b2。在进行现有技术抗辩审查时，仍应将由技术特征 a2、b2 构成的技术方案与现有技术进行比较，而非是将由 a2、b2、c2 构成被诉侵权的技术方案与现有技术进行比较。

在前述第二种情况下，假设现有技术由 a3、b3 构成，且 a2、b2 与 a3、b3 分别构成相同或者等同。如果将由 a2、b2、c2 构成的被诉侵权技术方案与现有技术比较，即使在由 a1、b1 构成的涉案专利技术方案相对于由 a3、b3 构成的现有技术方案没有新颖性的情况下（实质是涉案专利不应当被授权，在这样情况下，审理侵权案件的法院不评价专利权的有效性，而通过现有技术抗辩制度的适用判决不构成专利侵权），也有可能认为由 a3、b3 构成的现有技术方案加公知常识的简单组合，得不到由 a2、b2、c2 构成的被诉侵权技术方案，由此就可能认为现有技术抗辩不成立。这样的结论是错误的，出现错误的原因就是比较对象的确定不恰当。

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SPECIAL REPORT

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How Does Claims of the Infringed Patent Determine Selection of Technical Features to Be Compared with Those of the Prior Art

In regard of the retrial case instituted through adjudicatory supervision procedure on utility model patent infringement between the retrial applicant Yancheng Zetian Machine Co., Ltd. and the opposing party Yancheng Greater Machinery Manufacturing Co., Ltd., the Supreme People's Court found in its judgment (Supreme People's Court Civil Judgment (2012) Min Shen Zi No.18):

"With respect to examination of the legal basis for prior art defense, the appropriate comparison method is comparing the accused infringing technical plan with the prior art instead of comparing the prior art with the technical plan of the claimed infringed patent. As for examination details, the people's court shall, in reference to the claims of patent protection, determine what technical features of the accused infringing technical plan falls within the scope of patent protection, and then decide whether or not the prior art includes technical features identical with or equivalent to those of the accused infringing technical plan. A tenable defense of prior art dose not require all technical features of the accused infringing technical plan are identical with or exactly the same to all the technical features of the prior art. On the contrary, if the accused infringing technical plan contains one or more technical features that do not fall within the scope of patent protection as stated in the claims, such technical features shall be dismissed from further consideration for prior art defense.

"As the case mentioned above shows, while comparing the accused infringing technical plan with the prior art, the people's court do not compare a technical plan constituted by all technical features of the accused infringing product or process with the prior art, instead, the court shall compare the technical plan only constituted by technical features which are accused to fall within the scope of patent protection with the prior art. In other words, any technical feature included in the accused infringing product or process, if it is beyond the scope of patent protection, shall be excluded from comparison with those of the prior art. Thus it can be seen that to select the appropriate technical features to compare with the prior art, the people's court shall refer to the claims of patent protection.

"The so-called Principle of Full Coverage is a general criterion to determine a patent infringement, and it requires the people's court to examine whether the technical features of the accused infringing product or process cover (that is, are identical with or equivalent to) all the technical features stated in the claims of patent protection for the claimed infringed invention or utility model. This criterion goes as

follows: if all technical features contained in the accused infringing technical product or process are identical with or equivalent to all those stated in the claims, the people's court shall determine that the accused infringing technical plan constituted by the said technical features falls within the scope of patent protection; if the accused infringing technical plan includes one or more technical features in addition to those identical with or equivalent to all the technical features of the claims, the people's court shall also determine that such technical plan falls within the scope of patent protection.

“Rationale of prior art defense is that all technical features of the accused infringing technical plan which fall within the scope of patent protection are identical with or similar to (equivalent to) a corresponding technical feature of the prior art, or that the accused infringing technical plan, as deemed by the ordinary technological personnel in the pertinent field, are an simple combination of the prior art with common knowledge in this field.

“Where all technical features of the accused infringing technical plan are identical with or equivalent to all those stated in the claims of patent protection, the people’s court shall determine that all technical features contained in the accused infringing product or process are those contained in the accused infringing technical plan that fall within the scope of patent protection. For example, the technical features stated in the claim of patent protection are a1 and b1, and the technical features of the accused infringing technical plan are a2 and b2. If a2 and b2 are separately identical with or equivalent to a1 and b1, a2 and b2 are the technical features of the accused infringing technical plan that fall within the scope of patent protection provided by a1 and b1. To examine the legal basis of the prior art defense, the people’s court shall compare the accused infringing technical plan constituted by technical features a2 and b2 with the prior art.

“Where the accused infringing technical plan includes but without limitation to technical features that are identical with or equivalent to those stated in the claim, such technical plan still falls within the scope of patent protection; however, while comparing with the prior art, the people’s court shall include in the technical plan to be compared not all the technical features of the accused infringing technical plan but those falling within the scope of patent protection. For example, technical features stated in the claim of patent protection are a1 and b1, and technical features of the accused infringing product or process are a2, b2 and c2. If a2 and b2 are separately identical with or equivalent to a1 and b1, a2 and b2 are the technical features contained in the accused infringing technical plan which fall within the scope of patent protection provided by a1 and b1. To examine the legal basis of the prior art defense, the people’s court shall compare not the accused infringing technical plan constituted by a2, b2 and c2 but the technical plan constituted only by a2 and b2 with the prior art.”

Let’s premise the second example that the technical features of the prior art are a3 and b3, and a2 and b2 are separately identical with or equivalent to a3 and b3. There is a possibility that the accused infringing technical plan constituted by a2, b2 and c2 is different from the prior art constituted by a3 and b3, even though the claimed infringed technical plan constituted by a1 and b1, as compared with the prior art constituted by a3 and b3, lacks novelty (In fact, claims of such patent shall not be granted. But in this case, the court in charge shall not decide the validity of the infringed patent rights; instead, it shall determine the accused infringing product or process has not infringed its patent rights by defense of prior

art.), and therefore it can be concluded that the defense of prior art is not tenable. However, such conclusion is erroneous due to inappropriate selection of technical plan to be compared with the prior art.

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