U.S. CHAMBER OF COMMERCE

# U.S.-CHINA IP COOPERATION DIALOGUE

2013

# U.S.-China IP Cooperation Dialogue
## 2013

*"The Dialogue itself is an innovation. It creates a new opportunity for a wider and deeper Sino-US dialogue in the IPR area. And it also provides a multi-dimensional insightful framework for bilateral IPR cooperation between the governments."*

-Professor Liu Chuntian, Renmin University of China, Chairman of China IP Law Association

*"This has been a truly unique collaborative undertaking of individuals from China and United States each of whom has vast knowledge and experience in the field of intellectual property rights and enforcement. This group has developed a set of ideas that I hope will be examined intensively and acted on by our two governments."*

-Joseph Papovich, Co-chair of the U.S.-China IP Cooperation Dialogue

In 2013, IP experts from the U.S. and China engaged in-depth discussions on the most complex and challenging IP issues facing China.

### Background

Following the acceleration of new scientific and technological developments and the transformation to global industries, intellectual property rights (IPR) are playing an increasingly important role as a strategic resource in international competition. Both U.S. and China IP systems need to be adjusted to adapt to the new realities. China is implementing an innovation-driven development strategy targeted at building China into a true innovation-oriented country by 2020, and unquestionably, IPR protection will play an important role during this process.

The experts unanimously agree the Dialogue is an important part of the bilateral exchanges between the United States and China on IPR matters, and will help the two countries address the new challenges together, deepen mutual understanding, and promote cooperation.

The experts conducted effective discussions on a wide range of topics relating to the protection and enforcement of IPR. Consensus emerged that effective IP enforcement must be built across all the fields of IP based on the rule of law.
The experts expressed a range of views, including differences on some issues and consensus on others, and identified areas for further research.

### Executive Summary

The Dialogue generated the following forward-looking ideas and practices:

- A "guiding case system" provides timely and authoritative guidance nationwide for enforcement and judicial authorities. The continued development in China of this system will allow the law and public understanding of the law to move more swiftly than legislative amendments, keep pace with the marketplace and

technology, and help improve the consistency and uniformity of IP adjudication.
  - Examine the current system of granting evidence preservation and property preservation orders to IPR owners in Chinese courts.
  - Encourage Chinese courts to apply the existing legal criteria to award damages.
  - Make use of Criminal enforcement of IPR to provide effective deterrence against future theft and encourages compliance with the existing laws. Adjustments to the criminal protection system will help resolve many key problems in the enforcement of IPR, such as adjustments to the "for profit" determination.
  - To enhance the progress already made in the seizure of counterfeit and pirated exports, China Customs must be fully resourced, and engaged with global partners.
- Amendments to the Copyright Law will modernize China's copyright protection to help meet current challenges for industry in the areas of online copyright protection, software piracy, live sports programming, non-interactive streaming, and technical protection measures. In additional, amending the Criminal code to address criminalization of various copyright offenses should also provide the needed deterrence.
- On trademarks in China, challenges from bad faith registrations, cross borders enforcement challenges, and the involvement of both online and express mail services adversely impact the economy and endanger consumers. Positive measures must be taken to address these challenges in China. The courts play the central role in adjudicating patent cases. The theft of trade secrets, e.g., stealing of encryption codes, engineering documentation, and other know-how, whether the victims are foreign or domestic entities, is not tolerable. It is necessary to increase the courts' and companies' awareness of the value of trade secrets and improve trade secret enforcement in civil and criminal proceedings.

## Areas of Further Research & Capacity Building

The experts identified numerous areas ripe for further in-depth research and collaboration. Topics include the impact of IP crimes on economic and social development, the latest techniques to effectuate evidence preservation orders, the availability of injunctive relief in China and other markets, and the economic impact of online counterfeiting and piracy. The experts also support training and education to support the changes identified in this paper.

## Next Steps

Renmin University of China Intellectual Property Academy, the U.S. Chamber of Commerce, and the experts who participated in the dialogue acknowledge the success of the effort and offer the following next steps:

- The Dialogue members agree to provide their respective governments with a copy of the paper, discuss the paper with relevant officials/judges/prosecutors/academics, and explore opportunities for future engagement for the Dialogue.
- Renmin University of China's Intellectual Property Academy and the U.S. Chamber of Commerce expressed great interest in further discussion on potential phase two projects for the Dialogue.

## Acknowledgements

Thank you to Renmin University of China Intellectual Property Academy and the U.S. Chamber of Commerce for hosting the expert roundtables in Beijing and the United States from January

2013 to May 2013. Renmin University of China Intellectual Property Academy hosted a U.S.-China Experts Roundtable and an IPR Dialogue on January 29-30, 2013. On April 16, 2013, U.S. and China experts participated in a Digital Video Conference. On May 1-2, 2013, the Dialogue experts traveled to Washington, DC to renew the discussions and formulate consensus on a wide variety of topics.

Thank you to our experts for generously contributing their time and effort to the Dialogue and the paper.

## Co-Chairs

Professor Liu Chuntian, Renmin University of China, Chairman of China IP Law Association

Joseph Papovich, Former Assistant U.S. Trade Representative

## Experts

Director Cheng Yongshun, Beijing Intellectual Property Institute, Former Deputy Chief IP Judge of Beijing Higher People's Court

Professor Huang Jingping, Renmin University of China

Professor Li Yufeng, Director of IP Institute, Southwest University of Political Science and Law

Director Ma Yide, Zhongguancun Intellectual Property Research Institute, a member and the deputy director of Science and Technology Committee of Beijing People's Political Consultative Conference.

Stuart Seidel, Partner, Baker & McKenzie - DC Office (and former Assistant Commissioner of US Customs)

Professor Mark Cohen, Fordham University School of Law, USPTO Senior Counsel

Joseph Simone, SIPS - Simone IP Services

Professor Seagull HY Song, Loyola Law School of Los Angeles

# 1. Enforcement of IPR – Judicial

Chinese and U.S. experts acknowledge that accomplishing legislative reforms takes time and suggest an interim focus to work towards establishing an enforcement and judicial regime where judicial decisions have greater impact in guiding behavior of the courts. They encourage publication of significant case decisions to illustrate well-established points of application of law. More detailed suggestions and comments on judicial enforcement relating to patent and trade secrets are also listed out in the sections below.

## *1.1 Guiding Case System*

The experts also agreed that China should continue developing its "guiding case system," which provides timely and authoritative guidance nationwide for enforcement and judicial authorities. This will allow the law and public understanding of the law to move more swiftly than legislative amendments, keep pace with the marketplace and technology, and help improve the consistency and uniformity of IP adjudication. The experts concluded that all these processes will eventually increase efficiency and help reduce controversies in the application of law.

## *1.2 Amicus Briefs*

The U.S. experts also encouraged Chinese courts to allow amicus briefs so that outside parties interested in important cases can offer the court the benefit of their views and expertise without delaying resolution of cases. However, China experts believed that a simple transplant of an Amicus Brief system in China would not work.

## *1.3 Evidence Preservation Orders and Preliminary Injunctions*

Experts expressed firm support for an examination of the current system of obtaining evidence preservation from adverse parties (as well as other kinds of evidence discovery) and property preservation orders to IPR owners in Chinese courts. The courts' adoption of this policy is essential to giving IP owners confidence in the civil system. Experts proposed more training and guidelines would be useful on the gathering of evidence in complicated cases involving online evidence and access to financial records.

With respect to the role and ratio in practice of specific measures like preliminary injunctions, experts suggest conducting comparison studies between the judicial systems in China and overseas.

## *1.4 Damage Awards*

There is a consensus that the Chinese courts should apply the existing legal criteria to award higher damages to generate effectively deterrence against infringement.

# 2. Enforcement of IPR - Criminal

There is broad consensus between Chinese and U.S. experts that minor adjustments to the criminal protection system can fundamentally resolve many key problems in the enforcement of IPR. Criminal enforcement generates efficient deterrence and encourages compliance.

### *2.1 The True Nature of IPR*

The U.S. experts believe that China's Criminal Code requires complex "for profit" determinations as the basis for criminal liability. In their experience, the police have to resort to the formula and numerical thresholds determined by a judicial interpretation to decide if a case is worth pursuing. This leaves many offenders unaccountable.

However, the Chinese experts were of the opinion that the judicial interpretation issued by China People's Supreme Court has provided clear definition of "for profit" upon which the judiciary authorities are able to precisely decide whether an infringement act is a crime. In fact, they referred to successful precedents. The Chinese experts believe this judicial interpretation will improve the consistency of criminal adjudication to promote judiciary authorities to refer to these precedents.

Some experts strongly believe that it is necessary to launch in-depth research on the impact of IP crimes on economic and social development. The outcome of the research will deepen the understanding of the necessity of criminal IP reforms.

### *2.2 The Criminal Penalty Conundrum*

While there was a healthy debate about whether Chinese policy makers struggle with the terms of imprisonment for IP infringement, the experts unanimously agree that criminal prosecution provides the most effective preventative remedy driving widespread and voluntary compliance by businesses and individuals. The Dialogue explored practical approaches to address concerns about IP criminal enforcement.

### *2.3 A Practical Approach – Targeted Prosecutions and a Wider Range of Options*

The Dialogue experts advocate police, prosecutors, and judges can be trained to exploit fully the tools already available in the criminal system to address IP violations without causing unintended consequences. Some suggestions include:

- Vigorously prosecute serious IP crimes committed by repeat offenders, participants of large scale counterfeiting/piracy groups, and cross-border criminals. Without the use of state powers in investigations and prosecutions, IPR owners are vulnerable in pursuing sophisticated IP criminals.
- Encourage officials to increase the volume of criminal prosecution, and allow experimenting with appropriate criminal penalties for lighter IP violations. The authorities can permit plea bargaining alike criminal settlement or victim-offender reconciliation or apply criminal fines in proportion to the magnitude of the IP crimes. Criminal settlement and victim-offender reconciliation during criminal proceeding have been adopted by China for a variety of other kinds of criminal cases.
- Allow IP owners as victims to file "collateral civil claims" (fudai) during the trials of criminal IP cases. It could generate additional deterrence.

Some experts believe such "small" changes may yield very effective results for some piracy (e.g., enterprise end-user liability) and counterfeiting cases (dealing with large scale retail and whole market management companies).

### *2.4 Specialized IP Enforcement Teams*

The experts agreed that further study is needed in the establishment of a dedicated, specialized IP enforcement team funded by the national government. The experts pointed to successful models in Taiwan, Hong Kong, and other regions. In fact, China has already set up special police teams in response to food and drug safety. The eventual goal should be a specialized force utilized nationwide, but the force should first be deployed in counterfeiting and piracy "hotbeds." Some experts also proposed that specialized prosecutors should be deployed, such as those in Haidian Beijing and Pudong Shanghai, in a wider scope to facilitate prosecution.

### *2.5 Investigation and Enforcement Guidelines*

The U.S. experts suggest supporting criminal prosecutions through the issuance and timely updating of IP criminal investigation guidelines. Police nationwide need clearer guidance on key issues such as how to launch criminal investigations, how to process and use leads from informants, and what policies on controlled purchases should be adopted. In addition, the publication of enforcement guidelines to enforcement agencies should increase transparency and clarity. China has taken similar steps to guide police, prosecutors, and courts in other criminal law fields such as financial crimes.

### *2.6 Prosecutorial Leadership*

Some experts pointed to earlier involvement by prosecutors in complex counterfeiting, piracy, and trade secret cases as crucial to successful prosecution and efficient use of the criminal justice system. Prosecutors should be encouraged to consider additional factors such as facts, evidence and relevant guiding cases to decide whether to prosecute a case. Prosecutors specializing in IP matters should be stationed at district prosecutor offices, at least in "hotbeds" areas. The experts expressed firm support for District prosecutor offices with IP departments in Haidian Beijing, Shanghai Pudong district, and Xuhui district, as good examples to follow.

## 3. Enforcement of IP – Administrative/Customs

The experts expressed firm support and appreciation for China Customs which has proven to be instrumental in cracking down on smuggling and related criminal activities, and believe that China Customs could be equally as effective at going after counterfeiting activities. China Customs and certain other agencies of the central government have worked very closely with rights holders to stop or reduce the manufacturing of counterfeit products. The experts commended China Customs and these other agencies for this cooperation and encouraged the agencies to continue sharing information and working with rights holders. Better resources (e.g., equipment, technology and specialized units to handle IPR cases) are part of the solution, and the experts agreed to advocate for such resources to policy makers.

To effectively stop the export of pirated and counterfeits products, the experts suggest China customs build a culture of trust and cooperation with the customs and law enforcement authorities in other countries, and exchange information with rights holders and law enforcement agencies in other countries.

# 4. Copyrights

China's first copyright law was enacted in the early stage of Chinese economic reform when China was transferring from planned economy to market economy, which left it with certain impacts of planned economy and the lack of knowledge about the damage of piracy and the importance of criminal copyright enforcement. However, the Chinese legislators soon realized that and issued interim regulations attaching seven-year-imprisonment as the top term to pirate crimes.

The Chinese Communist Party and China government are focused on making China a market economic and innovation-oriented country. The current amendment of Copyright Law is at the service of this goal.

## *4.1 Online Copyright Protection*

The experts believe that online piracy is different from traditional copyright infringement and needs more research to find solutions. The U.S. and China legal professionals have some successful experience in dealing with online piracy including pursing liability for Internet intermediaries to establish online infringement rules.

The experts expressed primary support for the judicial interpretation on intermediary liability released by the Supreme People's Court in 2012 which established comprehensive rules to deal with joint infringement, inducement, and contributory infringement in online piracy cases, and praised the Supreme People's Court for the transparency and openness in the process of drafting the judicial interpretation. The entire process of researching and issuing the document illustrated the ability of the Chinese courts to absorb the very best of international developments. The timely and effective interaction between the court and international judicial authorities and professionals will certainly help contribute to the maturing body of laws on a global basis.

Additional discussions points included:

- The rapid development of P2P brings challenges to both U.S. Digital Millennium Copyright Act （DMCA） and Chinese copyright legislation. The legal professionals from both countries are researching solutions to issues such as whether internet users involved in piracy undertake infringement liability and how to pursue liability.
- Both the U.S. and other countries' courts are also facing significant challenges in dealing with online copyright infringement that involve new technologies. The U.S. experts recommended that Chinese authorities develop the current judicial system to offer effective and efficient solutions to resolving complicated and expensive copyright cases.
- In the process of discussing civil remedies for copyright cases, the Chinese and U.S. experts held an in-depth discussion of U.S. companies' IP litigation strategy in China. Foreign or foreign invested litigants represent less than 2 percent of the Chinese docket of IP cases. This may be a result of the primary stage of Chinese legal environment and foreign companies' investment and marketing tactics in China. Both the Chinese and U.S. experts hope this Dialogue will encourage foreign companies investing in China to seek legal remedies.

### *4.2 Software Piracy*

For effective protection and enforcement of software copyright, China experts value the U.S. experts' opinions on the amendment of Chinese civil and criminal laws. China experts will convey the opinions on the amendment of Criminal Law to the criminal legislative branch.

The nature of using pirated software for commercial purposes (whether for direct or indirect economic benefit) infringes on private property and leads to unfair competitive environments. The necessity of criminal liability for such infringement in addition to civil and administrative liabilities shall be further discussed with tighter contact with criminal legislative branch.
U.S. experts recognized the Chinese government's continuous efforts over more than 10 years on software legalization program and the effective results.

### *4.3 Live Sports Programming and Non-interactive Streaming*

The experts unanimously agreed that when the production of live sports programming involves creativity and originality, it shall be protected under current China Copyright Law.

- The experts supported the provisions of the latest available amendment of the Copyright Law which provides a bifurcated approach - the adoption of "broadcast rights" to give protection to non-interactive streaming media and the right of communication through information networks to protect interactive streaming media. This approach should provide greater flexibility and depth to the protection of the copyright.

### *4.4 Criminal Enforcement of Technical Protection Measures (TPMs)*

The experts attached a great deal of importance to protection of TPMs, which not only relate to the immediate protection of existing works, such as software and audio-visual works, but also have great significance to cloud computing. If the law does not effectively protect TPMs, rampant piracy will undermine developers' incentives, and gravely harm the prospects of new growth opportunities in many sectors including software and audio-visual distribution sectors.

## 5. Trademarks

### *5.1 Online Counterfeits: The Real Cost and Impact on the Economy*

U.S. experts reported that online sales of fake goods are growing at a phenomenal pace. The online distribution of counterfeit goods can distort the marketplace by offering cut pricing, endanger consumers with products of inconsistent quality, and threaten the survival of legitimate businesses.

The experts expressed support for ongoing efforts at the State Administration of Industry and Commerce (SAIC) demonstrated by Order No. 49 published in 2010 "Interim Measures concerning Commodity Trading Network and Related Services" and is not being amended. The SAIC plans to establish a national electronic database system that will record the true identity of network operators and develop ways to preserve electronic evidence during the law enforcement process. U.S. experts also recommended that Chinese courts consider the principals of the Supreme People's Court's online copyright intermediary liability judicial interpretation and apply such principles to online trademark infringement cases with the goal of encouraging

greater and more effective cooperation between platforms and brand owners to reduce the online sales of counterfeit products.

### *5.2 Bad Faith Trademark Registrations*

U.S. experts agreed that bad faith trademark registration has created enormous problems in China and called upon the government to give special attention to resolving the situation. The experts endorsed the following suggestions:

- China Trademark Office shall adhere to the principle of good faith trademark registrations and ensure it is a basis to reject, revoke, and oppose an application.
- Removing the requirement for legitimate well-known brand owners to prove fame in China before the bad faith may be shown with respect to newly filed marks.

China experts agreed that the new Trademark Law Amendments released on August 30, 2013 had touched upon the above issues, but the further clarification by implementing regulations and judicial interpretations was still needed for the application of law.

### *5.3 Express Mail Services (EMS)*

The U.S. experts called for increased efforts and close cooperation between EMS and other express delivery service providers to track counterfeits and counterfeit distributors. The experts noted that counterfeiters all over the world explore and exploit new and different methods to distribute counterfeits including using the postal service and the courier industry. Counterfeiters exploit weak links in the industry by splitting-up the delivery of small packages to customers within China and around the world. The experts strongly supported the ongoing efforts of China EMS to implement a system which requires positive identification or the recordation of the sender's real name and identification. Both sides agreed that this would substantially decrease the amount of counterfeit goods shipped through express delivery services and increase the ability to track and prosecute offenders. As it currently stands, the system is far from sufficient.

## 6. Patents

The experts support an enforcement regime where legitimate right holders can effectively enforce their patents and at the same time not be easily brought into meritless and costly patent infringement proceedings, stifling rather than encouraging innovation.

### *6.1 Role of the Courts*

Chinese and U.S. experts unanimously agreed that courts should play a central role in adjudicating patent cases. There should be systematic efforts to train judges and legal professionals. There should be transparency and consistency in case adjudication around the country.

- Both Chinese and U.S. experts agreed that the 89 courts that can hear patent litigation cases are too many and suggested that China consider centralized jurisdiction over patent cases to ensure improved specialization and consistency in patent decisions. For nearly twenty years, China has been discussing the possibility of establishing a central patent court as has been done in the United States, Japan, Korea, Germany, and Taiwan. If this cannot be placed into the agenda of reforms in the foreseeable future, the Supreme Court should take actions to reduce the number of courts that are allowed to hear patent cases.

- The nature of patent infringement proceeding requires a higher level of expertise from legal and technical sides. Injunctive relief, damages, evidence discovery, and outside expert appraisal of technical issues and specific issues related to patent enforcement often concern the patent owners. The very low rate of injunctive relief especially for invention patents as reported in the official statistics shows strong reservation by the judiciary bodies to grant such relief. Governments are urged to research the reasons behind such statistics.
- The experts recommended courts to reform the handling of cases in order to develop greater credibility and confidence among patent owners and professionals. Patent owners, especially those in high tech sectors, have been hesitant about litigating in front of Chinese courts due to undue delays in expert appraisals and the insufficient methods available to obtain evidence regarding infringement of manufacturing processes.

### *6.2 Article 26(3) of the Patent Law*

Chinese and U.S. experts discussed the issue of Article 26 (3) of the Patent Law and its application to pharmaceutical patents. Foreign pharmaceutical companies reported that China's Examination Guidelines required pharmaceutical companies to submit at the time of filing more experimental data than the other four largest IP offices.

Chinese experts pointed out that the State Intellectual Property Office (SIPO) is currently utilizing several different editions of the Patent Examination Guidelines. The retroactive application of new examination guidelines on patents already granted or submitted under an earlier version of the examination guidelines does not comply with Article 84 of China's Legislation Law.

U.S. experts also noted that the Patent Review Board (PRB) often invalidates pharmaceutical patent claims with superficial reasoning that "the patentee fails to provide sufficient evidence … [for the purpose of Art. 26(3)]." Such conclusive assertions place patentees at a disadvantage. U.S. experts point out that, to comply with due process requirements, the PRB and the courts need to clearly state their analysis in the opinions and publish the decisions in a timely manner. The lack of transparency has significantly increased the risks of arbitrary decisions.

In December, China's patent office reversed its decision to retroactively apply the new guidelines and clarified that data supplementation will be allowed for the purposes of Art.26.3. Pharmaceutical innovators are interested in how pending cases will be resolved in light of these policy changes and whether this policy change applied also allows data supplementation for purposes of inventiveness step in Art. 22.2.

### *6.3 Role of SIPO in Enforcement*

The experts noted that SIPO is seeking an additional enforcement role in China and caution against this expansion. SIPO is seeking extensive quasi-judicial power to conduct raid actions, even the power to take enforcement actions against patent infringement activities that it determines to be "market-disruptive" and to award hefty fines. Given the existence and on-going filing of numerous low quality patents in China, legitimate rights holders may have to face even more meritless patent enforcement proceedings that are costly and burdensome.

### *6.4 Judicial Review of Patent Prosecution and Validity Decisions*

Some experts point out that courts need to take effective measures and apply stricter standards in reviewing invalidity decisions made by the PRB. The decisions made by the PRB have been upheld at a high rate with only a few decisions overturned by the courts. While patent examiners at the PRB tend to have experience in handling technical issues, the current situation is worthy of increased attention. The way that Beijing courts have invited PRB officials to participate in the court's own decision-making process must be carefully reviewed to ensure judicial impartiality.

### *6.5 Statute of Limitations, Chinese Litigation System, and Value of Patents*

A study on the impact of the statute of limitations is useful as a longer period would extend legal liability for repeat infringement in order to effectively protect rights holders. With respect to setbacks encountered by foreign companies during the process of patent litigation, some Chinese experts thought a big reason for that is due to foreign companies' unfamiliarity with Chinese litigation. Foreign companies need effective preparation and a plan for litigation in China. Some experts pointed out that the weakness of patent enforcement has kept the value of Chinese patents severely low. The overspending of resources in prosecuting low quality invention patents and unexamined utility model and design patents has misdirected the entire patent profession and significantly delayed development of professional expertise.

## 7. Trade Secrets

The consensus among the experts is that the theft of trade secrets whether the victims are foreign or domestic entities, is not tolerable.

### *7.1 The Unique Impact of Trade Secrets Theft on Business Decisions*

Trade secret theft harms business value and destroys trust. The handling of trade secrets cases can have a big impact on the sustaining the growth of R&D facilities and technological collaboration in China.

### *7.2 Civil Enforcement of Trade Secrets*

U.S. experts point out that civil remedies in China are often insufficient to compensate the injured party and do not alone provide sufficient deterrence to trade secret theft. The main problems encountered are: (1) lack of evidence discovery and high threshold of evidence; (2) calculation of damage (lack of understanding of the value of trade secrets); (3) use of experts; and (4) executing injunctions. Experts pointed out that courts play an essential role to make sure rights are enforced in a meaningful way. Parties in such disputes should be given a fair opportunity to discover key facts and to examine evidence fully without breaching confidentiality.

- Allow police officers to conceal their identity during the criminal investigation of trade secrets. (Refer to the revised Criminal Procedure Art. 151);
- Conduct research on whether allowing prosecutors to provide the investigation result to the parties in civil cases may be possible without breach of confidentiality.

### *7.3 Criminal Prosecutions*

Chinese experts cautioned that criminal prosecution may be abused, leading to serious damages to legitimate businesses. In some cases, the civil and criminal results of the same trade secrets case turns out to be completely different, and there is still a controversy over what constitutes trade secrets between courts and in practice.

# 中美知识产权学者对话纪要

## 2013 年

2013 年，中美两国知识产权学者就双方共同及各自关注的知识产权问题分别在北京和华盛顿进行深入坦诚的对话和交流。

### 背景

当今世界，随着新科技革命和全球产业变革步伐加快，知识产权作为战略性资源在国际竞争中地位和作用越来越突出。中美双方知识产权制度都需要进一步调整以适应新形势的发展。中国正在实施“创新驱动发展战略”，其目标是在 2020 年建成创新型国家，知识产权保护无疑是推进战略和实现目标的重要支撑。

中美专家一致认为，中美知识产权学者对话机制作为中美知识产权双边交流的重要方面，有助于中美双方共同面对新形势新挑战，有助于中美双方深入理解彼此关切，有助于中美双方增进互信、加强协调、深化合作。

基于上述理解，中美知识产权学者从知识产权保护制度和实际运行两个方面，开展了议题全面、内容丰富并且卓有成效的对话。中美专家一致认为，一个真正有效的知识产权保护机制应当是建立在法治原则基础上的，适用于知识产权各个领域。专家们提出了一系列意见，既包括针对某些问题的不同看法，也包括达成的共识，同时探求需要进一步研究的领域。

*“这次对话本身就是一个创新，为中美在知识产权领域的广泛、深入交流创造了新的机会，也为两国政府的知识产权合作提供了多维度的启迪与参考。”*

-刘春田

中国人民大学法学院教授

中国知识产权法学研究会会长

中美知识产权学者对话联席主席

*“这次活动为来自中美两国在知识产权领域拥有丰富经验和知识的专业人士提供了一次独一无二的合作机会。这次合作产生了一系列的思路，我希望这些思路能够经受严格的检验，并且被两国政府付诸实践。”*

-Joseph Papvoich 中美知识产权学者对话联席主席

## 纪要摘要

- 推广知识产权领域内建立“指导性案例”，为全国各地的执法部门和司法部门在处理案件时提供案例指导，维护司法的权威性，解决立法滞后性的法律适用问题，提升知识产权案件司法审判的一致性和统一性。
- 进一步完善现有的证据保全制度和财产保全制度，推进两项制度的实施。
- 推动司法机关充分运用现行的法律规则确定赔偿额。
- 充分发挥知识产权刑事保护的震慑作用，防范犯罪行为。对刑事保护体系的修改有助于解决知识产权保护面临的突出难题，如调整“以营利为目的”的判定标准。中国海关在扣押假冒商标和盗版产品出口方面已经取得了很大的成就，应当给予中国海关充足的资源，推动与其他各国的海关和紧密合作
- 《著作权法》的修改将使中国著作权保护更具现代化，有助于解决在网络著作权保护、软件盗版、体育赛事直播节目、非交互式的流媒体和技术保护措施等领域所面临的现实挑战。此外，对刑法典的修订，有助于解决一系列重大侵犯著作权行为的定罪问题，也将发挥有效的威慑作用。
- 在商标方面，违反诚实信用原则的商标抢注问题、跨境的商标保护，以及网络售假和甚至利用邮政渠道寄送假冒商品的问题，对经济发展和消费者利益产生了负面的影响，应该采取积极措施来解决这些挑战。
- 司法机关在审理侵犯专利权案件中起到了主导作用。恶意侵犯商业秘密的行为，如窃取加密代码、工程图纸文件和其他专有知识，不论该受害者是国内或国外企业，都是不能容忍的。提升司法机关和企业对商业秘密价值的认识，在民事和刑事诉讼中加强商业秘密的保护。

## 双方认为亟待进一步研究的问题和开拓的领域

专家们一致认为还有许多领域需要进行深入的研究与合作，如知识产权犯罪行为对经济和社会发展的影响，有效实现证据保全的最新技术方法，在中国或其他市场实施禁令救济的情况，以及网络售假和盗版行为对经济的影响。专家们赞同开展培训和教育活动，用以支持实现本报告当中的建议。

## 下一步计划

中国人民大学知识产权学院，美国全国商会以及与会的专家（对话成员）认为本次对话务实、成功、富有成效，并提出了下一步的计划：

- 与会专家同意向其各自政府部门提交该文件，并与相关部门、法官、检察官、学者

进行交流，为今后继续开展对话寻求机会。

- 中国人民大学知识产权学院以及美国全国商会对该对话项目的下一个阶段进行深入的讨论表示了极大的兴趣。

## 致谢

感谢中国人民大学知识产权学院以及美国全国商会于 2013 年 1 月至 2013 年 5 月在北京和华盛顿共同举办中美专家研讨会。中国人民大学知识产权学院于 2013 年 1 月 29 日至 30 日举办了中美专家圆桌会议和知识产权对话。2013 年 4 月 16 日，中美专家参加了视频会议。2013 年 5 月 1 日至 2 日，与会专家抵达华盛顿进行新一轮的对话项目，并就许多议题达成了共识。

感谢与会专家为对话项目和该对话文件所投入的时间和精力。

## 联席主席

- 刘春田　中国人民大学教授，中国知识产权法学研究会会长
- Joseph Papovich　前美国贸易谈判助理代表

## 专家

- 程永顺　北京务实知识产权中心主任，北京市高级人民法院知识产权庭前副庭长
- 黄京平　中国人民大学教授
- 李雨峰　西南政法大学法学院教授，知识产权研究所主任
- 马一德　中关村知识产权战略研究院院长，北京市政协常委、科技委员会副主任
- Stuart Seidel　贝克麦坚时律师事务所华盛顿办公室合伙人
- 柯恒（Mark Cohen） 纽约 Fordham 大学法学院、美国专利商标局顾问
- 谢西哲 (Joseph Simone) SIPS-Simone IP Service
- 宋海燕　洛杉矶 Loyola 法学院

## 1. 知识产权的保护 – 司法保护

中美专家认识到实现立法改革需要时间，在此期间，应该是建立和完善知识产权执法和司法体系，充分发挥案例指导制度的作用，鼓励及时公布阐明重大法律适用问题的典型案例。关于专利和商业秘密相关的司法保护的具体的建议将在后面相应部分列出。

### *1.1 案例指导制度*

中美专家认为中国应该继续完善和发挥案例指导制度的作用，这种制度对全国案件的审理提供及时和权威的指导且能维护司法的权威性。同时，有助于解决立法滞后带来的法律适用难题，有助于提升知识产权案件司法审判的一致性和统一性。专家们总结到，所有这些程序都将大大提高效率及有助于减少法律适用的分歧。

### *1.2 “法庭之友”意见*

美方专家还建议和鼓励中国法院允许采用“法庭之友”的方式，使得那些对于重大案件有重要兴趣的各方能够在不影响案件审理的情况下向法院提出其意见和专家意见。中方专家认为，中国法律体系中不存在“法庭之友”制度，难以简单移植。

### *1.3 证据保全和诉前禁令*

中美专家支持对中国法院现有的证据保全和财产保全制度重新审视。法院在实际采取这些措施的态度对于知识产权权利人获得民事救济的信心至关重要。专家认为，对于涉及网络侵权的证据和财务记录这类的证据如何进行收集，可以通过培训和发布具体的指导，加以完善。

### *1.4 损害赔偿*

中美专家一致认为中国法院应该执行现行的法律标准，加大损害赔偿力度，以便对侵权行为起到有效的威慑作用。

## 2. 知识产权的保护 - 刑事责任

中美专家基本认同，刑事保护体系的小幅变革可以为解决知识产权保护问题带来根本性的促进作用。刑事保护带来有效的威慑作用，鼓励企业和个人遵守法律的规定。

### *2.1 知识产权的本质*

美方专家认为，中国刑法典将“情节严重”、“以营利为目的”等构成要素作为判定罪与非罪的标准，在实践中，公安机关和检察机关必须借助于司法解释确定的数额标准来解决是否需要开展刑事侦查和公诉，这导致了很多违法者逃脱刑事责任的追究。

中方专家认为，事实上中国最高司法机关制定的司法解释已经对“以营利为目的”的确切含义作出明确规制，依据相关司法解释可以准确判定侵权行为构成犯罪，且相关典型案例已经出现，积极推进典型案例的参照适用，将有助于刑事审判的法律适用统一性。

有的专家强烈认为非常有必要展开研究，深入调查知识产权犯罪行为给经济和社会发展所造成的影响，研究的结果将大大深化对知识产权刑事保护进行改革必要性的理解。

### *2.2 刑事责任涉及的政策困境*

中美专家们在中国对知识产权侵权进行定罪量刑的态度问题上有一定分歧，但专家们一致认为刑事处罚驱使个人和企业更多的自愿去遵守法律，从而起到了较为有效的犯罪预防作用。中美知识产权合作对话针对有关知识产权刑事保护的顾虑，探讨了一些实际的措施。

### *2.3 实际的措施– 有针对性的起诉和更多处罚措施的选择*

中美专家提倡，对公安机关、检察院和法院而言，可以通过更多的培训，提高如何充分适用现有刑法体系已有的制度和手段，在追究侵犯知识产权行为的刑事责任的同时，避免引发非预期后果。建议包括：

- 将惯常侵权者、大规模盗版犯罪人、团伙和跨境犯罪分子作为重点对象处以严厉的刑罚处罚。如果在侦查和起诉过程中不使用国家公权力，知识产权权利人在面对技术精良、手段狡猾的知识产权犯罪分子时将是无能为力的。

- 鼓励司法机关增加刑事检控案件的数量，同时对不太严重的知识产权犯罪行为适用恰当的刑事处罚，可以根据知识产权犯罪行为的严重性来决定使用类似诉辩交易的刑事和解或刑事谅解方式或罚金来处理。类似辩诉交易的刑事和解或刑事谅解已经在中国许多类型刑事案件中被采用。知识产权刑事案件可以借鉴实施。

- 在审理知识产权刑事案件时，允许知识产权权利人作为受害者提起刑事附带民事诉讼。这种做法或许是具有威慑力的。

有的专家认为，如此“小”的改变会对一些盗版行为（如追究商业经营过程中使用盗版软件的企业的刑事责任）和假冒商品案件（针对大规模零售和批发市场管理企业）产生有效的作用。

### *2.4 专门的刑事执法队伍*

专家们一致认为，需要进一步研究中央政府拨付财政资金建立专门的知识产权刑事保护执法队伍这一举措。专家们提到了台湾、香港和其他地区在这方面的成功经验。事实上，中国已经成立了打击假冒伪劣药品和食品的公安执法队伍。未来的目标是建立专门性的执法力量，在国内各地打击假冒商标和盗版犯罪活动，同时在此过程当中，可以在那些生产、销售假冒盗版商品活动泛滥的地区首先建立专门队伍。有的专家也提议检察机关应当成立专门的知识产权部门，如北京市海淀区和上海浦东新区已经实践的方式，更好的促进刑事检控工作的开展。

### *2.5 侦查和执法工作指南*

美方专家建议发布和及时更新知识产权犯罪侦查工作指南以指导刑事侦查工作。对一些重要的问题，比如如何启动刑事侦查，如何处理和使用举报人的信息，以及针对受监管的购买行为采用什么政策等需要给予全国的公安机关清楚地指示。除此之外，向执法部门公布执法工作指南将提高透明度和明确性。中国已经在其他刑事领域，如金融犯罪案件中，采取类似的措施来指导公安机关、检察机关和法院的工作。

### *2.6 检察监督*

有的专家指出，检察机关提前介入复杂的假冒商标、盗版和商业秘密案件，对于起诉的成功性和有效利用刑事司法体系至关重要。应该鼓励检察官在决定是否起诉时，考虑一些因素，例如事实、证据以及相关的指导案例。专门从事知识产权事务的检察官应该被分配到地方检察院，尤其是那些知识产权犯罪行为严重的地方。专家们明确表示对北京海淀检察院、上海浦东检察院和徐汇检察院设立知识产权检察部门的赞赏，认为这是可以推广的好实例。

## 3．知识产权的保护 – 行政/海关

专家强烈支持并欣赏中国海关在打击走私和相关刑事犯罪活动中所起到的关键作用，认为中国海关在打击假冒商标活动中也能够起到同样有效的作用。中国海关和中央政府的各部门与权利所有者紧密配合来制止或减少假冒商标的生产销售。专家们赞扬了中国海关和其他执法部门给予的合作，鼓励他们继续分享相关信息并与权利所有者合作。专家们认为，

给海关部门投入更多的资源（如设备、技术和专门的队伍来处理知识产权案件等）是有效改进执法的解决方案，建议政策制定者投入资源。

为了有效地制止盗版和假冒商标出口，专家建议中国海关与其他国家的海关当局和执法部门建立更好的信任和合作关系，与权利所有者和其他国家的执法当局交流信息。

## 4．著作权

中华人民共和国的第一部著作权法诞生于改革开放之初，恰值中国由计划经济向市场经济体制转型，因此多少受到计划经济体制的影响，在立法方面尤其表现为对盗版的严重性，以及对著作权予以刑事救济的必要性认识不足。但是，很快中国的立法者认识到这点，并采取临时立法措施，对盗版行为课以最高七年徒刑的刑罚。

中国的执政党和政府明确提出到 2020 年要基本建成社会主义市场经济体制和建成创新型国家。目前对《著作权法》的修改，责无旁贷地服务于上述目标的实现。

### *4.1 数字环境下的著作权保护*

专家们认为，数字环境下的盗版不同于传统环境下的侵权形式，需要针对其加强研究，并寻找对策。对此，中美两国的法律工作者取得一些成功的经验。其中，追究互联网服务提供者的责任，确立了互联网环境下的侵权责任规则。

中美专家对最高人民法院 2012 年发布的网络著作权侵权责任的司法解释表示基本认同，该司法解释建立了比较全面的共同侵权、诱导和帮助侵权等侵权责任，反映出中国法院在制定司法解释的过程中的所具有的透明性和开放性。该解释的整个调研和制定过程反映了中国法院在汲取国际法律发展变化所具有的成熟能力。专家认为，法院、国际司法机构以及专业人士及时和有效的交流将有助于全球范围内法律体系的成熟和完善。

其他讨论的要点还包括：

- P2P 技术的出现及其快速的升级换代，使美国的数字千年版权法-DMCA 和中国的著作权立法受到新的挑战。特别是作为网络用户的企业和个人在参与盗版的情况下，是否要承担侵权责任，如何追究其责任，等等，都亟待两国的法律工作者找出可行的解决方案。

- 美国和其他国家的法院对于处理涉及新技术的网络著作权案件也面临很大的挑战。美

国专家建议中国应该在现有的审判体系上探索有效且高效的方法，审理复杂的和昂贵的网络著作权案件。

- 在讨论著作权案件民事责任的过程中，中方专家和美方专家深入探讨了美国企业在中国的知识产权诉讼策略。在中国的知识产权案件中，外国投资企业作为当事人的案件占比不到百分之二。这里面既有中国的法律环境尚处于初级阶段的原因，也有外资企业的在华投资与营销策略因素。中美双方的专家希望通过本合作对话，能够起到鼓励在华的外资企业积极寻求法律救济的作用。

### *4.2 软件盗版*

为了加强软件著作权的保护，中方专家十分重视美方专家对改进中国民事法律和刑事法律的意见。鉴于刑法的修改完全由不同的部门负责，中方专家将向刑事立法部门转达美方的意见。

为商业目的（不论是出于直接或间接经济利益）使用盗版软件的本质是侵害他人财产，制造不公平竞争环境。对于这种侵权行为除追究民事责任、行政责任，是否有必要追究刑事责任，尚需要认真讨论，并且与刑事立法部门保持紧密的联系。

中方专家向美方专家介绍了十余年来中国政府不间断地推动使用正版软件的工作和取得的积极有效成果。美方专家注意到中方专家的介绍，并对中国政府的努力给予积极的评价。

### *4.3 体育赛事直播节目和非交互式的流媒体*

专家一致认为，体育赛事的现场直播节目在制作过程当中涉及大量创作与投资，根据现行著作权法，可以从不同的角度寻求保护。

- 专家赞同《著作权法》最新的修正草案条款，即通过“播放权”给予非交互式的流媒体保护以及通过信息网络传播权包含交互式流媒体，这一明晰的规定，给予权利保护提供了更大的灵活性和深度。

### *4.4 技术保护措施的刑事保护*

专家们认为，对技术保护措施提供法律保护至关重要，因为其不仅与目前存在的作品如软件和影音作品紧密相关，而且对于正在新兴起的云计算非常关键。如果技术保护措施不能

得到有效的法律保护，猖狂的盗版行为将会有损于软件开发者的激励机制，且该损害将会给软件行业和音像内容分发渠道的发展前景带来严重损害。

## 5．商标

### *5.1 网络售假及其带来的实际危害及对经济的影响*

美方专家认为，网络销售假冒商品的现象正在以前所未有的速度在增长。网络销售假冒商品扭曲了市场价格，产品的质量问题危害了消费者并直接威胁到合法经营企业的生存。

专家对国家工商管理总局于 2010 年发布的 49 号令《网络商品交易及有关服务行为管理暂行办法》所做出的不断努力表示支持。国家工商总局计划设立一个全国性的电子数据库系统来记录网络经营者的真实身份，并且也在制定办法来保全执法过程当中的电子证据。美方专家还建议，中国法院应该参考最高法院有关网络侵犯著作权的司法解释，并将其同样地应用到网络侵犯商标权案件中，旨在鼓励交易平台和商标权利人有效合作来减少网络销售假冒商品。

### *5.2 商标抢注*

美方专家认为中国恶意抢注的问题非常严重，值得引起政府部门的高度重视，并提出了以下建议：

- 商标局应当遵循申请商标的诚实信用的原则，确保将其作为异议、撤销和审查申请的基础。

- 在全球化的大背景下，考虑不再要求合法的知名商标权利人证明被抢注商标在抢注商标申请日前在中国有知名度。

中方专家认为，中国在 2013 年 8 月 30 日公布了修改后的《商标法》对上述问题已有涉及但相关条款如何适用仍有待于《商标法实施细则》和司法解释的进一步明确。

### *5.3 利用邮政渠道传送假冒商品*

美方专家建议加强 EMS 与其他快递服务提供者之间的合作和配合来追踪假冒商品和制假者。专家们注意到世界各地的制假者利用新的、不同的方法出口和销售假冒商品，包括通过邮政和快递渠道递送侵权产品。制假者利用传统邮政和快递渠道的薄弱环节以化整为零

的方式在中国国内或向国外销售假冒商品。专家强烈支持中国的 EMS 开始实施的实名登记制度，即要求记录发件人的真实姓名和身份。中美专家一致同意，该制度将大大减少通过邮政和快递渠道递送假冒商品的数量，同时加强对制假者的追踪和处罚。但是，目前来看该制度还远不足以解决该问题。

## 6．专利

中美专家主张专利保护机制的构建和实施，应当确保权利人既能有效地行使其专利权，同时企业和个人不会轻易地卷入毫无价值的、昂贵的侵犯专利权的诉讼当中，这些无意义的滥用权利的诉讼阻碍而非鼓励创新。

### *6.1 法院的作用*

中美专家一致认为，在保护专利方面，司法审判应当处于核心位置。应当对法官和法律专业人员进行系统的、持之以恒的培训，全国范围内对专利案件的审理应该保持其透明度和一致性。

- 双方专家一致认同，目前中国能够受理专利诉讼的法院数目过大（89 家法院），建议中国考虑集中专利案件的管辖权，确保提高专利案件审理的专业化和一致性。在过去的二十余年，中国一直在讨论建立像美国、日本、韩国、德国和台湾的知识产权专门法院。如果这种大的变化无法很快提上日程，最高人民法院应该考虑减少受理专利诉讼的法院数量。

- 侵犯专利权诉讼的性质决定了参与者需要具有高水平的法律和技术知识。禁令救济、赔偿损失、证据披露和有关技术鉴定问题是专利权人所最关心的。统计显示，诉前禁令批准比率较低说明了司法机关对该措施的谨慎态度。有关部门应该对统计数据所反映的背后原因进行研究。

- 专家建议法院改革其案件审理的方式，提高权利人和专业律师的信心。由于专家鉴定的过分迟延以及很难取得侵犯生产过程或方法专利的证据，专利权利人尤其是那些高科技产业的权利人不愿意在中国法院起诉。

### *6.2 《专利法》第二十六条第三款*

中美专家讨论了《专利法》第二十六条第三款的规定，及其对医药专利的适用问题。国外医药企业提到，中国的专利审查指南中要求制药企业在提起药品专利申请时提交的临床实验数据，超过国际上其他四个最大的知识产权局的要求。

中方专家指出，国家知识产权局采用过多个不同版本的审查指南，而对已经授予的或者根据专利审查指南先前版本而授权的专利，如果在无效程序当中适用新的专利审查指南，将违背中国《立法法》第八十四条的规定。

美方专家也指出，专利复审委员会经常在一些重大药品专利无效案件中仅做非常简短的分析。此种分析往往是以“专利权人未能提供足够的证据证明……”的形式作出结论。此种方式往往将专利权人置于非常不利的境地。美方专家指出，专利复审委员会和法院审查专利复审委员会的裁定须严格遵照正当程序的要求，清晰地陈述其分析意见，并及时公告判决。否则，缺乏透明度会大大增加了决定的任意性。

2013 年 12 月，中国专利局规定新的专利指南有溯及既往的效力，并且明确，为专利法第 26.3 条之目的，可以进行数据补充。医药创新者们十分关注这种政策变化将如何影响正在进行的案件以及是否会允许为第 22.2 条之目的进行数据补充。

### *6.3 国家知识产权局在执法过程中的作用*

专家指出国家知识产权局正寻求发挥行政执法作用，专家对此持谨慎反对的态度。国家知识产权局希望扩大自己的准司法性质的行政执法权，对破坏市场秩序的专利侵权行为采取整治和查处行动，并处予高额罚款。考虑到中国目前存在的大量的低质量的专利和专利申请，专利权人将不得不耗费大量人力物力，疲于应付没有实际技术价值的垃圾专利诉讼。

### *6.4 专利诉讼和专利无效决定的司法审查*

有的专家指出，法院应该采取有效措施和适用严格的标准来审理专利复审委员会所做出的专利无效决定。目前法院对于专利复审委员会决定的支持率非常高，极少案件被法院改判。即使专利复审委员会的审查员可能在处理技术问题上有更多的经验，现有情况值得高度注意。为确保司法公正，防止利益冲突，北京市乃至最高人民法院长期邀请专利复审委员会审查员到法院参与其实际司法审判工作的做法，值得反思和审查。

### *6.5 诉讼时效、中国诉讼体系和专利的价值*

对诉讼时效可能造成影响的研究是非常有用的。更长的诉讼时效有助于专利权人追究持续侵权行为，有效保护权利。对于国外企业在中国进行专利诉讼遇到的挫折，有中方专家认为，一个重要的原因是国外企业不熟悉中国的诉讼方式，需要有效的准备和计划在中国的诉讼方式。也有专家指出，专利司法保护的薄弱，已经影响了中国专利的质量。目前的现状是企业为了追求专利数量，把资金用在撰写质量不高的专利和未经审查的实用新型专利，这种资源的浪费误导了整个专利代理行业的发展，延缓了中国专利从业人员专业化道路的发展。

## 7．商业秘密

专家的共识是，故意窃取商业秘密的行为，不论该受害者是国内或国外企业，都是不能容忍的。

### *7.1 故意窃取商业秘密的行为对商业决定的影响*

窃取商业秘密的行为有害于商业价值和企业之间的信任。对商业秘密案件的处理对在中国建立研发中心和促进中外技术合作将产生重要影响。

### *7.2 商业秘密的民事救济*

美国专家指出，中国的民事救济对于侵害商业秘密受害方的补偿是不够的，且对商业秘密的窃取不能起到有效的威慑作用。主要遇到的问题是（1）缺少证据的收集和证据要求过高；（2）赔偿的认定（缺乏对商业秘密价值的认识）；（3）专家鉴定和（4）禁令的执行等等。专家指出，法院须充分发挥实质性作用，以确保司法权力的执行。法院应当确保商业秘密案件中的当事人拥有平等的机会，在不二次泄密的情况下，全面了解事实和证据，进行公正审理。

- 在商业秘密刑事案件的侦查过程当中，应当允许公安人员隐匿其身份进行侦查（见修改后的刑事诉讼法第一百五十一条）；
- 研究在防止二次泄密的情况下，可否允许检察机关将侦查结果提供给当事人在民事诉讼当中使用。

### *7.3 追究刑事责任*

中方专家担心，有关侵害商业秘密刑事责任的制度可能被滥用，严重损害合法运营的企业的利益。有的案件当中，审理同一商业秘密案件的民事和刑事案件的结果完全不同，法院和实务界对于什么构成商业秘密的界定仍然存在很大争议。

U.S.-China IP Cooperation Dialogue in action at Renmin University in Beijing, China January 2013


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