

WIPO Collection of Leading Judgments on Intellectual Property Rights People's Republic of China (2011–2018)

Supreme People's Court of the
People's Republic of China
World Intellectual Property Organization

世界知识产权组织 知识产权典型案例集 中华人民共和国卷 (2011–2018)

中华人民共和国最高人民法院
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Supreme People's Court of the People's Republic of China
World Intellectual Property Organization



Foreword

I am pleased to present this collection as the first title of a new series issued by the World Intellectual Property Organization (WIPO). The *WIPO Collection of Leading Judgments on Intellectual Property Rights* will give the global intellectual property community access to landmark judgments from some of the most dynamic litigation jurisdictions of the world, in a succession of volumes that will illustrate intellectual property adjudication approaches and trends by jurisdiction or by theme.

Technological transformations taking place throughout societies and economies worldwide are disrupting the existing intellectual property systems. The slow pace of the national and multilateral norm-setting processes means, however, that policymakers are not always able to provide solutions to the pressing questions that appear on the horizon. In this context, innovators and other actors in the intellectual property ecosystem are increasingly looking to the courts to resolve the culturally and economically significant questions that remain unanswered, with the effect that courts are playing a greater role in moulding the development of the intellectual property framework not only within their national borders, but also in the global economy.

WIPO's vision is to provide, through the WIPO Judicial Institute, a forum for the sharing of information and experiences amongst judiciaries, to support better understanding of complex intellectual property issues in a culturally, politically and socially diverse—and yet globalized—economy. WIPO is privileged to rely on the strong cooperation from judiciaries around the world to advance our collective knowledge about the state of the judicial administration of intellectual property.

Indeed, this joint publication between the Supreme People's Court (SPC) of the People's Republic of China and the WIPO Judicial Institute is the fruit of such collaboration, featuring 30 representative judgments rendered by the SPC between 2011 and 2018.

China is an intellectual property powerhouse. As WIPO's *World Intellectual Property Indicators (WIPI) Report* for 2019 found, China accounted for almost half of the world's patent filings in 2018. China has been equally innovative in modernizing its intellectual property system, including in the area of the judicial administration of intellectual property. The country's specialized intellectual property adjudication architecture, which was galvanized by the establishment of three specialized courts in Beijing, Shanghai and Guangzhou in 2014, has expanded to comprise intellectual property tribunals in intermediate people's courts in Nanjing and 20 other cities. Most recently, in January 2019, an Intellectual Property Court was established within the SPC to provide a national-level appeals mechanism for intellectual property cases. It is therefore a privilege to co-publish this volume together with the Supreme People's Court of China.

I hope that the *WIPO Collection of Leading Judgments in Intellectual Property: People's Republic of China (2011–2018)*, made available here in Chinese and English text, will make the significant jurisprudence built by the SPC more accessible to a broader readership, and assist judges, lawyers, academics and policymakers in understanding the judicial approaches that have been taken in China to address novel legal questions.

Francis Gurry
Director General
World Intellectual Property Organization

Preface

Fostering international judicial exchanges and cooperation towards a brighter future for intellectual property rights protection

To protect intellectual property rights (IPR) is to protect individuals' creativity and originality, to protect market forces, and to protect the drivers of a country's innovation and development. Today's world has welcomed a new era of technological revolution and industrial transformation that has had far-reaching impacts on human economic and social development, and that has introduced new challenges to, and opportunities for, IPR protection. The People's Republic of China has committed to strengthening its IPR protection not only to fulfil its international obligations, but also as a prerequisite for establishing itself as an innovative country and for achieving its "Two Centenaries" modernization goals. China has consistently attached significance to IPR protection, and the Supreme People's Court of China has been making efforts to improve and strengthen China's IPR system, to clarify its standards of IPR protection and to perfect the judicial protection of IPR in China. In the last three decades, China has taken strides in the field of IPR protection: the number of IPR cases litigated has risen dramatically; the quality of and efficiency with which those cases are conducted has improved; the courts system and legal mechanisms are themselves being refined; and the judicial protection system is witnessing continuous improvement. The Chinese courts are playing a leading role in improving the protection of IPR – that is, in adjudicating typical IPR cases, formulating IPR decisions and policies, and issuing guiding cases, thereby contributing to the promotion of scientific and technological innovation, economic prosperity and cultural development.

The case guidance system is a judicial system with specifically Chinese characteristics, established by the Supreme People's Court to gather case summaries, strengthen judicial supervision and guidance, streamline the application of the law, and improve the quality of decisions and thus safeguard justice. Since 2008, the Supreme People's Court has been actively exploring various methods of issuing guidance in IPR cases and has advocated for the citation of guiding cases in written judgments in order to strengthen its decisions. Each year, on World Intellectual Property Day, the Court publishes its latest achievements and experiences in two titles, the *Annual Report on IPR Cases of the Supreme People's Court*, and *10 Cases and 50 Typical Cases Concerning the Judicial Protection of Intellectual Property Rights in Chinese Courts*.

In the present volume, the *WIPO Collection of Leading Judgments in Intellectual Property: People's Republic of China (2011–2018)*, we bring together a selection of the leading cases published by the Supreme People's Court in recent years, covering copyright, trademarks, patents, trade secrets, new plant varieties, integrated circuit layout designs, monopoly and competition, and criminal enforcement of IPR. These cases epitomize the present situation in China in relation to IPR protection, and they reflect the tremendous efforts and significant progress made by the Chinese courts in promoting justice in IPR cases.

Thinking openly and with a global perspective, Chinese courts have continued to strengthen their communication and cooperation with relevant countries and international organizations, including the World Intellectual Property Organization (WIPO), in areas such as the judicial protection of IPR, staff training and collaboration, and academic research, among others, and this work has delivered remarkable outcomes.

At the same time, WIPO has been increasing its attention to the judicial protection of IPR, and has made significant pioneering efforts to effectively promote dialogue and cooperation among countries in the area of the judicial protection of IPR. This volume, published jointly by the Supreme People's Court and WIPO in both Chinese and English, marks the first edition of a new series, the *WIPO Collection of Leading Judgments on Intellectual Property Rights*, edited and published by the Organization. It not only testifies to WIPO's recognition of the progress made by China in the realm of the judicial protection of IPR, but also represents the fruit of comprehensive and pragmatic cooperation between WIPO and the Supreme People's Court, the scope of which has reached new heights.

With the publication of this volume, the Supreme People's Court also wishes to provide insight into the Chinese IPR experience, and to support its call for further in-depth exchanges and cooperation – with WIPO, other international organizations and other countries – so that together we might forge a brighter future for IPR protection.

The Honorable TAO Kaiyuan
Justice, Vice-President
Supreme People's Court of the People's Republic of China

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Chapter 1

Trademark cases

A. Right in a personal name can constitute an “existing prior right”, as protected under the Trademark Law

The right in a personal name is an important personal right enjoyed by a natural person to their name and such a right may constitute an “existing prior right” under article 31 of the Trademark Law of the People’s Republic of China.

Although one among a bundle of rights available to the right holder, “use” of the personal name is not an obligation that the person undertakes nor is it a legal precondition to their asserting protection over the name. Subject to the following conditions for protection of the right in a specific name, article 31 of the Trademark Law provides that the natural person may obtain protection of rights even in names that they do not actively use.

If a natural person claims protection of a right in a specific name, that name must meet three conditions:

- (a) the specific name shall have a certain level of popularity in China and must be a name known to a relevant group of people (a “relevant public”);
- (b) the relevant public shall use the specific name to refer to the natural person claiming the protection; and
- (c) a stable connection shall have become established between the natural person and the specific name.

If the Chinese translation of the name of a foreigner meets these three conditions, that translation may be protected as a personal name under the Trademark Law.

In some cases, commercial success or market position may be achieved not by good faith trading, but by confusing the relevant public and misleadingly using a name that is similar to an existing trademark. Not only is such use an infringement of the legitimate rights and interests of the holder of the prior existing right in their name, but also it is detrimental to consumers’ interests and it undermines attempts to establish a sound environment for the registration and use of such trademarks.

**MICHAEL JEFFREY JORDAN
V. TRADEMARK REVIEW AND
ADJUDICATION BOARD AND
QIAODAN SPORTS CO., LTD.
(2016) ZGFZX No. 27, SPC**

Cause of action:

Administrative dispute over a trademark

Collegial panel members:

Tao Kaiyuan | Wang Chuang | Xia Junli |
Wang Yanfang | Du Weike

Keywords:

dispute procedure, existing prior right, fair competition, good faith, right in a personal name, specific name, trademark, use in bad faith

Relevant legal provisions:

Tort Law of the People’s Republic of China, articles 2 and 20
Trademark Law of the People’s Republic of China (as amended in 2001), article 31

General Principles of the Civil Law of the People's Republic of China, articles 4 and 99

Basic facts: In the retrial of an administrative dispute over a trademark between the appellant, Michael Jeffrey Jordan (hereinafter “Michael Jordan”), and the respondent, the Trademark Review and Adjudication Board, State Administration for Industry & Commerce of the People's Republic of China (hereinafter “TRAB”), and the third party from the first-instance case, QIAODAN Sports Co., Ltd. (hereinafter “QIAODAN Company”), the trademark “乔丹” (pronounced *Qiao Dan*), Trademark No. 6020569 (hereinafter “the disputed trademark”), was filed by QIAODAN Company on April 26, 2007, and was approved for use for sports equipment, swimming pools (for entertainment), roller skates and Christmas tree decorations (except lighting and confectionery) under Class 28 of the International Classification of Goods and Services for the Purposes of the Registration of Marks (hereinafter the “Nice Classification”); the validity period of the exclusive right was March 28, 2012, to March 27, 2022. On October 31, 2012, Michael Jordan filed a cancellation request on the grounds that the registration of the disputed trademark infringed his existing prior right in his personal name. On April 14, 2014, the TRAB issued its *Decision on No. 6020569 “乔丹” Trademark Dispute* [2014] SP ZI No. 052058 (hereinafter “Decision No. 052058”) and maintained the registration of the disputed trademark. Michael Jordan subsequently filed an administrative lawsuit.

The Beijing No. 1 Intermediate People's Court (the court of first instance) held that the evidence in this case was insufficient to prove that the name 乔丹 alone was clearly identified with Michael Jordan. In addition, the products designated by the

disputed trademark were quite distinct from the field of basketball in which Michael Jordan bore influence. It was not easy for the relevant public to associate the disputed trademark with Michael Jordan. The existing evidence was insufficient to prove that the registration and use of the disputed trademark improperly drew on Michael Jordan's popularity or could have other effects on Michael Jordan's right in his personal name. The registration of the disputed trademark did not infringe Michael Jordan's right in his personal name. The court of first instance therefore affirmed Decision No. 052058.

Unconvinced, Michael Jordan lodged an appeal with the Beijing Higher People's Court, which dismissed the appeal and affirmed the original judgment.

Still unconvinced, Michael Jordan appealed to the Supreme People's Court and the Supreme People's Court ruled that the case should be reviewed.

Held: On December 8, 2016, the Supreme People's Court issued its administrative judgment, in which it stipulated that the TRAB's decision and the judgments of the lower courts were overturned, and ordered the TRAB to review the case and issue a new decision.

Reasoning: The Supreme People's Court held that the issue in this case was whether registration of the disputed trademark infringed the appellant's right in his personal name and thereby violated article 31 of the Trademark Law, which provides that “no applicant for trademark application may infringe upon another person's existing prior rights”.

The issues, in this case, were divided among eight specific questions, as follows.

- I. What are the legal grounds on which the appellant claims protection of a right in the name?
- II. What is the specific content of the name over which the appellant asserts a right to protection?
- III. What is the degree and scope of the appellant's popularity in China?
- IV. Did the appellant and Nike Company (as authorized by him) actively use the name 乔丹, and what effect did the fact of active use have on the right that the appellant claims in this case?
- V. Does the specific context of the disputed trademark lead the relevant public to mistakenly associate the disputed trademark with the appellant?
- VI. Did QIAODAN Company act in bad faith in registering the disputed trademark?
- VII. What has been the impact of QIAODAN Company's business status and its efforts in promoting, using, winning awards and protecting its own name and related trademark?
- VIII. Was there unreasonable delay on the part of the appellant in asserting protection of his right in his name and what impact does that delay have on the present case?

In answering these eight specific questions, the Supreme People's Court respectively held as follows.

I. Legal grounds on which the appellant claims a right in the name

Article 31 of the Trademark Law provides that "no applicant for trademark application may infringe upon another person's existing prior rights". Therefore existing prior rights specifically defined under the Trademark Law shall be protected in accordance with its special provisions. Civil rights or interests that

are not specified in the Trademark Law, but which were legally accorded to civil entities prior to the application date of the disputed trademark, shall be protected in accordance with the provisions of the General Principles of the Civil Law, the Tort Law and other laws. Such general provisions shall apply to such civil rights and interests.

Article 99(1) of the General Principles of Civil Law of the People's Republic of China and article 2(2) of the Tort Law of the People's Republic of China stipulate that natural persons enjoy a right in their personal name in accordance with the law. Such a right may therefore constitute an "existing prior right", as defined in article 31 of the Trademark Law. Where the registration of a disputed trademark infringes another person's existing prior right to their personal name, that trademark shall be deemed to violate the provisions of article 31.

Names are used to refer to, address and distinguish between specific natural persons. Name rights are important personal rights enjoyed by natural persons. With the continuous development of China's socialist market economy, it has become increasingly common for natural persons with a certain level of popularity to commercialize their names, and to obtain economic benefits under contracts to endorse specific goods and services. When article 31 of the Trademark Law is applied to protect the existing prior right in a personal name, it protects not only the personal dignity of the natural person, but also the economic interests of the natural person in their name – especially the name of a celebrity. Where the name of a person with a existing prior right to that name is registered as a trademark without their permission and hence misleads the relevant public to believe that the goods or services

bearing the trademark have specific connections with that natural person, such as that person’s endorsement or authorization, the registration of such trademark shall be deemed to have infringed that person’s existing prior right to their name and to have violated the provisions of article 31.

II. Specific content of the name over which the appellant asserts a right to protection

When a natural person claims a right in a specific personal name under article 31 of the Trademark Law, they must satisfy three conditions:

- (a) the specific name must have a certain degree of popularity in China and be known to the relevant public;
- (b) the relevant public must use the specific name to refer to the natural person; and
- (c) a stable connection must have been established between the specific name and the natural person.

In relation to the first and second conditions – the specific name should have certain popularity and be known to the relevant public, and should be used to refer to the natural person – article 6(2) of the Interpretation of the Supreme People’s Court on Several Issues Concerning the Application of Law in the Trial of Civil Cases of Unfair Competition defines as unfair competition those acts that “use the name of another person without permission and mislead the relevant public”. Such acts are closely related to the registration of a disputed trademark that is likely to mislead the relevant public and hence, in this case, the provisions of the Interpretation can be applied, *mutatis mutandis*, to establish the conditions under which a natural person’s right in their personal name will be protected.

In relation to the third condition – that a stable connection must have been established between the specific name and the natural person – in resolving the conflict involved in this case between the existing prior right in the personal name and the rights in a registered trademark, the standard of protection for the existing prior right shall be reasonably determined, and the interests of the holder of the existing prior right to the personal name and the interests of the trademark owner shall be balanced. On the one hand, registration of the disputed trademark shall not be deemed to sabotage the right of a natural person in their name just because the disputed trademark uses or incorporates that person’s name if it is known only to a limited circle of people or if is used only occasionally. On the other hand, rigorous standards shall not be imposed on a natural person asserting such a right, as was the case when the TRAB held that there must be one and only one connection between the name and any natural person for that natural person to claim protection of a right in their name. When a specific name claimed by a natural person has established a stable connection with that natural person, even if the relationship between the person and that name is not “unique”, that person’s right in their name can be protected in law.

When judging whether a foreigner can claim a right in the Chinese translation of their name, it is necessary to consider the relevant public’s common use of such names in China. If the translated name meets the three conditions under article 31 of the Trademark Law, it may be granted protection accordingly. The existing evidence in this case is sufficient to prove that the name 乔丹 has high reputation in China and is known to the relevant public. The relevant public in China usually refers to the appellant as

乔丹, and a stable connection has been established between the name 乔丹 and the appellant; hence the appellant can claim a right in the translated name 乔丹.

III. Degree and scope of the appellant's popularity in China

Correctly ascertaining the degree and scope of the appellant's popularity in China will have a significant impact on specific issues such as whether the appellant enjoys a right in the name 乔丹, whether QIAODAN Company may have registered the disputed trademark in bad faith and whether the relevant public is likely to mistakenly assume that the products marked with the disputed trademark are connected with the appellant.

The evidence in this case proves that, before the filing date of the disputed trademark and through to 2015, the appellant had always had a high reputation in China and that the scope of his popularity was not limited to the field of basketball; rather, he had become a highly popular public figure.

IV. Whether the appellant and Nike Company (as authorized by the appellant) actively used the name 乔丹, and what is the impact of that use on the right now claimed

First, according to the provisions of article 99(1) of the General Principles of the Civil Law of the People's Republic of China, the right to use a name is not an obligation, but one among a bundle of rights enjoyed by holders of the right in a personal name – and it is by no means a legal precondition imposed upon the holder of that right when applying to prohibit “interference with, usurpation of and false representation of the name” or to assert protection of the name.

Secondly, in applying article 31 of the Trademark Law to the protection of existing prior rights, whether the relevant public mistakenly believes that the goods or services marked with the disputed trademark have a specific connection with the natural person, such as their endorsement or authorization, is an important factor in ascertaining whether or not the natural person's right in their name has been infringed. Where the three conditions under article 31 are satisfied, therefore, the natural person is entitled to protection of their right in a specific name even if they do not actively use that name.

Finally, for foreigners who have a certain level of popularity in China, it is possible that they or interested parties may not actively use their names in China or that, for reasons of greeting, linguistic habits or cultural differences, the “name” familiar to the relevant public and news media in China is not exactly the same as the name that the right holder actively uses. For example, in this case, the relevant public and news media in China generally refer to the appellant as 乔丹, whereas Michael Jordan and Nike Company mainly use 迈克尔·乔丹. However, both 迈克尔·乔丹 and 乔丹 have high popularity among the relevant public, which generally uses either to refer to the appellant, to which use the appellant has no objection. The claim of the TRAB and QIAODAN Company that the appellant and Nike Company do not actively use 乔丹 and that the appellant is not entitled to enjoy a right in the name 乔丹 is therefore not persuasive.

V. Whether the specific context of the disputed trademark leads the relevant public to mistakenly associate the disputed trademark with the appellant

Trademark No. 6020569 “乔丹”, the disputed trademark in this case, is

designated for “sports equipment, swimming pool (entertainment), roller skates, Christmas tree decorations with the exception of lighting and confectionary” under Class 28 of the Nice Classification. Among them, “sports equipment, swimming pool (entertainment), roller skates” are common commodities in sports, while “Christmas tree decorations with the exception of lighting and confectionary” are common commodities in daily life. Consumers of these commodities are likely to mistakenly believe that the products marked with the disputed trademark have specific connections with the appellant, such as that he has endorsed or approved them, for the following specific reasons.

First, the evidence in this case is sufficient to prove that the appellant and the name 乔丹 have enjoyed long-term and extensive popularity in China, and that the relevant public is familiar with and generally uses the name 乔丹 to refer to the appellant. A stable connection has been established between 乔丹 and the appellant. Since the disputed trademark comprises only the Chinese characters 乔丹, it will be easy for the relevant public to associate it with the appellant and even to mistakenly believe that products marked with the disputed trademark have specific connections with the appellant.

Secondly, QIAODAN Company specifically issued the following statement in its prospectus, under the heading “Brand risk”: “Investors are specially reminded that ‘some consumers may associate the issuer and its products with Michael Jordan, which may create a misunderstanding or confusion.’” This indicates that QIAODAN Company was aware that the relevant public would be likely to mistakenly associate QIAODAN with the

appellant and that its trademark would thereby cause confusion. In the record of the case at first instance, QIAODAN Company also acknowledged that “there is a possibility that the public who has not purchased our products may be misled”.

Finally, the two market research reports put forward as part of the evidence in this case further prove that the relevant public is likely to mistakenly assume that the name 乔丹 has specific connections with the appellant.

VI. Whether QIAODAN Company registered the disputed trademark in bad faith

In this case, whether QIAODAN Company registered the disputed trademark in obvious bad faith is an important factor to consider in determining whether the trademark infringes the appellant’s right in his personal name. The evidence in this case is sufficient to prove that QIAODAN Company was fully aware of the appellant’s popularity and that of his name 乔丹. Instead of consulting and negotiating with the appellant to obtain his permission or authorization to use the name, QIAODAN Company willfully registered a large number of trademarks closely related to the appellant’s name, including the disputed trademark, and misled the relevant public to believe that the products so marked had a specific connection with the appellant. In this way, QIAODAN Company achieved the effect of the appellant’s “endorsement” without incurring the relevant costs. QIAODAN Company’s action violates the principle of good faith stipulated under article 4 of the General Principles of Civil Law of the People’s Republic of China, and it exhibited obvious subjective malice during the registration of the disputed trademark and related trademarks.

VII. Impact of QIAODAN Company's business status and its efforts in promoting, using, winning awards and protecting its own name and related trademark

QIAODAN Company's business status and its efforts in promoting, using, winning awards and protecting its own trade name and related trademarks are not sufficient to render registration of the disputed trademark legal.

First, from the perspective of the nature of the right, as well as the *actus reus* involved in sabotaging the existing prior right, a name is used to refer to, address and distinguish a specific natural person, and it therefore constitutes a natural person's personal right, whereas a trademark is used for distinguishing the source of goods or services and hence constitutes a kind of property right that is substantially different from the right in a personal name. To ascertain whether registration of the disputed trademark infringes another person's existing prior right in a name, it is critical to determine whether the relevant public has been misled to think that the goods or services marked with the disputed trademark have specific connections, such as endorsement or authorization, with the holder of the existing prior right in the name. In this regard, the *actus reus* is different from that of trademark infringement and therefore, even though QIAODAN Company and its “乔丹” trademark have gained a high popularity in specific product categories after years of operation, marketing and use, and even though the relevant public can recognize that products marked with “乔丹” are from QIAODAN Company, these factors are not sufficient to prove that the relevant public will not easily be misled into thinking that there is a specific connection between the products marked with “乔丹” and Michael Jordan.

Secondly, since QIAODAN Company registered the disputed trademark in bad faith, obviously contradicting the principle of good faith operation and infringing Michael Jordan's existing prior right in his name, the market position or commercial success put forward as evidence by the TRAB and QIAODAN Company was not a legitimate outcome of QIAODAN Company's business, being, to some extent, derived from its confusion of the relevant public. Maintaining such a market position or commercial success on this basis is detrimental not only to the protection of a natural person's legitimate rights in their name, but also to the safeguarding of consumers' interests and to the maintenance of a sound environment for the registration and use of trademarks.

VIII. Whether there was unreasonable delay on the part of the appellant in asserting protection of his name right and what impact that delay might have on the present case

Article 41(2) of the Trademark Law stipulates that, “[w]here a registered trademark is in violation of ... article 31, the holder ... may, within five years upon the registration of the trademark, request the Trademark Review and Adjudication Board to declare the registered trademark invalid”. The five-year period stipulated is therefore the statutory time limit within which a complainant must ask the TRAB to invalidate a disputed trademark.

The legislators fully considered the balance of interests between existing prior right holders and trademark owners when stipulating these time limits. The statutory time limits may urge the right holder or the interested party to claim rights promptly according to law, so as to avoid the legal validity of a disputed trademark remaining contentious long

after its registration. Such contention will hinder the trademark owners in promoting and using the disputed trademark, as well as impair the legitimate interests of the holder of a prior existing right.

In this case, the appellant filed with the TRAB an application for revocation of the disputed trademark within five years of the date of its registration, in accordance with the provisions under article 41(2). The claim of the TRAB and QIAODAN Company that the appellant has been negligent in protecting his right therefore has no basis in fact or law, and is not supported.

B. Applicant for international registration of a trademark should be given a reasonable chance to submit supplements and make corrections to the application documents

Where an applicant for international registration of a trademark has completed the relevant procedures pursuant to the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, and has fulfilled the representation and statement obligations set out in article 13 of the Implementing Regulations of the Trademark Law of the People's Republic of China, the application procedures should be deemed to be fundamentally complete.

Where the application documents lack only formalities, within the meaning of the Implementing Regulations of the Trademark Law, such as where they include only incomplete technical drawings of a three-dimensional (3D) design, the competent trademark authority should adhere to the principle of performing its obligations under international agreements, while giving the applicant a reasonable chance to submit supplements and make corrections to the documents.

**CHRISTIAN DIOR PERFUMES LLC
V. TRADEMARK REVIEW AND
ADJUDICATION BOARD**
(2018) ZGFXZ No. 26, SPC

Cause of action:

Administrative dispute reviewing rejection of a trademark application

Collegial panel members:

Tao Kaiyuan | Wang Chuang | Tong Shu

Keywords:

administrative lawsuit, extension of territorial protection, international registration, trademark

Relevant legal provisions:

Implementing Regulations of the Trademark Law of the People's Republic of China, articles 13 and 52

Basic facts: The trademark at issue is International Registration No. 1221382 (as illustrated), for which the applicant is Christian Dior Perfumes LLC (hereinafter "Dior"). The country of origin for the trademark at issue is France, with an approved registration date of April 16, 2014, and an international registration date of August 8, 2014. The international registration owner is Dior, and the designated products include eau de parfum and perfumes.



Trademark at issue

After the trademark at issue was registered internationally, according to relevant provisions under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, Dior applied to the International Bureau of the World Intellectual Property Organization (WIPO) (hereinafter the "International Bureau") for an extension of territorial protection to Australia, Denmark, Finland, the United Kingdom and China, among others. On July 13, 2015, the Trademark Office of the State Administration for Industry and

Commerce (hereinafter the "CTMO") issued notice to the International Bureau that it rejected the application for the extension of territorial protection over all of the designated products in China on the ground that the trademark at issue was lacking distinctive features. Within the statutory time limit, Dior appealed to the Trademark Review and Adjudication Board of the State Administration for Industry and Commerce (hereinafter the "TRAB"). The TRAB affirmed that the trademark at issue was not capable of distinguishing the source of goods and was lacking distinctive features; hence the TRAB issued Decision No. 13584, rejecting Dior's application for extension of territorial protection of the trademark at issue in China. Dior was dissatisfied with the decision and filed an administrative lawsuit, in which it argued that:

- (a) the trademark at issue is a three-dimensional (3D) mark in a specific color and while Dior had submitted to the TRAB the 3D drawing of the trademark at issue, the TRAB had based its decision incorrectly in fact on an understanding of the trademark at issue as an ordinary graphic trademark; and
- (b) the trademark at issue has a unique design that has become so significant, in light of Dior's long-term efforts to promote and market it, that the application for extension of territorial protection should be approved.

Held: Both the Beijing Intellectual Property Court and the Beijing Higher People's Court rejected Dior's claim, finding that Dior did not inform the CTMO that the trademark at issue was a 3D mark nor did it submit technical drawings of the trademark including at least three views within three months of the date of its international registration at the International Bureau. Only in its

first communication of supplementary reasons, when it requested a review of the TRAB's decision, did Dior inform the CTMO that the trademark at issue was a 3D mark and provide the three views. Under the circumstances, in which Dior did not originally state that the trademark at issue was a 3D mark or submit the relevant documents, the courts at first and second instance found that the CTMO did not err in treating the trademark at issue as an ordinary graphic trademark. Whether the CTMO committed errors when recording in the register the designated color, marks and other information relating to the trademark at issue was beyond the scope of the present case, and the courts advised Dior to seek relief in that regard through other channels.

Dior rejected the second-instance judgment and lodged an application to appeal with the Supreme People's Court. The Supreme People's Court issued its first administrative ruling on December 29, 2017, granting Dior permission to appeal ((2017) ZGFXS No. 7969), and it issued its judgment on April 26, 2018, overruling the first-instance and second-instance decisions, and ordering the TRAB to review the case and issue a new decision ((2018) ZGFXZ No. 26).

Reasoning: The Court held that the designated type of the trademark at issue was indeed “a three-dimensional mark”, with specific description of the 3D form clearly indicated in its international registration documents. In the absence of evidence to the contrary, the record in the international registration information of the specific type of the trademark at issue should be deemed to be the applicant's statement that it is a 3D mark. It can also be reasonably presumed that, when the application was filed for an extension of territorial

protection of the trademark at issue in China, the application information that the International Bureau transmitted to the CTMO was the same as the international registration information, so that the CTMO should have known the specific type of the trademark at issue. Since an applicant for international registration of a trademark is not required to file a separate application for registration before any designated country, any information relating to that trademark that the International Bureau transmits to the CTMO shall constitute the factual basis on which the CTMO examines the application and decides whether or not to grant extension of territorial protection of the trademark at issue in China. According to the evidence presented, the type of the trademark at issue for which the territorial protection was sought in China was “a three-dimensional mark”, not the “conventional trademark” that the CTMO recorded in its register, which record served as the basis for the CTMO's examination and the TRAB's review. During the review process, Dior made it clear that the specific type of the trademark at issue was a 3D mark and requested correction of the registration documents by additionally submitting technical drawings with three views. However, the TRAB did not accurately record these facts in its Decision No. 13584 nor did it, following Dior's request, verify whether the factual basis on which the CTMO decided to reject the application was erroneous. Instead, the TRAB continued to consider the trademark at issue as “a graphic trademark” and simply rejected Dior's request that the TRAB review its decision, which rejection violated legal procedure and had the potential to impair Dior's legitimate interests, and hence the Court found that it should be remedied. The Supreme People's Court provided that the CTMO and the TRAB were to review again whether the trademark at

issue was lacking distinctive features – this time, as a 3D (that is, not graphic) mark.

The Madrid Agreement Concerning the International Registration of Marks and its Protocol were designed to establish an international cooperation mechanism that improves procedures for the international registration of trademarks, streamlines and simplifies those procedures, and provides applicants with a convenient way of obtaining trademark protection in any country at the lowest possible cost. The facts of this case show that the trademark at issue was based on an application for international registration under Madrid, with China being designated, so that the relevant application information was to be based on that which the International Bureau transmitted to the CTMO. It can be reasonably presumed from the evidence presented that Dior made a statement in the international registration application that the trademark at issue was a 3D mark, clarified the specific use of the trademark at issue and submitted a single-perspective technical drawing of the trademark at issue. Where an application document lacks only formalities within the meaning of the Implementing Regulations of the Trademark Law, such as providing incomplete views of a 3D mark, the competent trademark authority should adhere to the principle of performing its obligations under international agreements, while giving the applicant a reasonable chance to submit supplements and to make corrections to the application documents. In this case, the CTMO did not keep accurate records in the international registration documents of Dior's statement as to trademark type nor did it give Dior a reasonable chance to submit supplements and to make corrections to those documents. In the absence of a

factual basis for doing so and in ignoring Dior's requests, the CTMO unilaterally changed the trademark at issue to an ordinary graphic trademark and reached its decision on this basis to Dior's disadvantage. The TRAB's failure to remedy the situation also has no basis in fact or law and had the potential to impair Dior's legitimate expectations; hence the Supreme People's Court ordered that it be rectified.

To conclude, the TRAB should, based on the reasons proposed by Dior in respect of the trademark type, rectify the CTMO's improper affirmation and review the application for extension of territorial protection of the trademark at issue in China, and it should do so according to the criteria for assessing whether the 3D trademark has distinctive features. In their reviews, the CTMO and the TRAB shall focus on:

- (a) the distinctiveness of the trademark at issue and the distinctiveness derived from use of the trademark at issue – particularly the date on which the trademark at issue entered into the Chinese market, evidence of its actual use, promotion and marketing, and the extent to which the trademark at issue serves to identify the source and function of the product; and
- (b) the principle of unified examination criteria – that is, the principle that while trademark review and judicial review procedures will necessarily involve consideration of the particular circumstances of the individual case, the basic standards for review shall adhere to the provisions under the Trademark Law of the People's Republic of China and the relevant administrative regulations, and these standards shall override any individual circumstances.

C. Malicious acquisition and exercise of trademark rights will not be protected under law

Where any party violates the principle of good faith, damages the legitimate interests of others, disrupts the operation of fair competition, and maliciously obtains and exercises trademark rights, then goes on to claim that others are infringing its rights, the Supreme People's Court shall reject that party's claims on the ground of abuse of rights.

WANG SUIYONG V. ELLASSAY (2014) MTZ No. 24, SPC

Cause of action:

Dispute over a trademark infringement

Collegial panel members:

Wang Yanfang | Zhu Li | Tong Shu

Keywords:

abuse of rights, good faith, trademark, trademark infringement

Relevant legal provisions:

Civil Procedure Law of the People's Republic of China (as amended in 2012), article 13

Trademark Law of the People's Republic of China (as amended in 2001), article 52

Basic facts: Shenzhen Ellassay Garment Industrial Co., Ltd. was founded on June 8, 1999. On December 18, 2008, the company acquired Trademark No. 1348583 “歌力思” by way of transfer, which trademark was approved for use on clothing products under Class 25 of the International Classification of Goods and Services for the Purposes of the Registration of Marks (hereinafter the “Nice Classification”) and had been approved for registration in December 1999. On November 19, 2009, the trademark registration was valid from

December 28, 2009, to December 27, 2019. At the same time, Shenzhen Ellassay Garment Industrial Co., Ltd. registered Trademark No. 4225104 “ELLASSAY”, which was approved for use on Class 18 commodities – that is, (animal) leather, wallets, travelling bags and folders (leather products); leather belts, fur, umbrellas, walking sticks and shopping bags – and valid from April 14, 2008, to April 13, 2018. On November 4, 2011, Shenzhen Ellassay Garment Industrial Co., Ltd. changed its name to Shenzhen Ellassay Fashion Co., Ltd. (hereinafter “Ellassay”, the defendant in the first-instance case). On March 1, 2012, the registrant of the trademark “歌力思” was accordingly updated to Ellassay under its new name.

Wang Suiyong, the plaintiff in the first-instance case, registered Trademark No. 7925873 “歌力思”, which was approved in June 2011 for use on commodities such as wallets and handbags under Class 18 of the Nice Classification. Wang Suiyong had also applied to register Trademark No. 4157840 “歌力思/graphic” on July 7, 2004. In the second-instance case on April 2, 2014, the Beijing Higher People's Court affirmed that this latter trademark infringed upon the prior trade name of Ellassay's affiliate Ellassay Investment Management Co., Ltd. and hence did not approve the registration.

Since September 2011, Wang Suiyong had been buying leather bags with tags bearing “Chinese Brand Name: 歌力思, English Brand Name: ELLASSAY” at Ellassay counters in Hangzhou, Nanjing, Shanghai and Fuzhou, through notarial procedures. On March 7, 2012, Wang Suiyong filed an action claiming that Ellassay and Intime Department Store (Group) Company Limited (hereinafter “Intime Department Store”) had infringed upon the trademarks “歌力思” and

“歌力思/graphic” by producing and selling these leather bags.

Held: On February 1, 2013, the Hangzhou Intermediate People’s Court rendered its civil judgment ((2012) ZHZCZ No. 362), holding that Ellassay’s and Intime Department Store’s production and sales of the disputed commodities infringed upon Wang Suiyong’s right to the registered trademark, and ruled that Ellassay and Intime Department Store should stop the infringement, compensate Wang Suiyong RMB100,000 for economic losses and reasonable expenses, and mitigate the impact of such infringement.

Dissatisfied with the decision, Ellassay lodged an appeal. On June 7, 2013, the Zhejiang Higher People’s Court passed a civil judgment ((2013) ZZZZ No. 222) dismissing the appeal and affirming the first-instance decision.

Thereafter, Ellassay and Wang Suiyong respectively applied for permission to appeal to the Supreme People’s Court. The Supreme People’s Court granted permission and passed its judgment on August 14, 2014, overturning the first-instance and second-instance judgments, and dismissing all claims by Wang Suiyong.

Reasoning: The Supreme People’s Court opined that good faith is a basic principle with which all market players should comply. On the one hand, it encourages people to accumulate social wealth and supports the creation of social value through honest work, and it protects property interests formed on this basis, as well as the freedom and right to dispose of these interests for proper and legitimate purposes. On the other hand, it also requires people to be honest and faithful in market activities, and to seek interests without

prejudicing others’ legitimate interests, public benefits and market position. The principle of good faith should also be followed in civil proceedings. While it safeguards the parties’ rights to exercise and dispose of their civil and procedural rights to the extent permitted by law, it requires that the parties exercise their rights in good faith and with due care without harming others’ and public interests. Any malicious acquisition or exercise of rights that disrupts fair market competition and which goes against the letter and the spirit of the law, with the intention of damaging others’ legitimate interests, is an abuse of rights and related claims brought in those circumstances shall not be protected or supported by law.

Registration of Trademark No. 4157840 “歌力思/graphic” had not yet been approved at the time of the claim; hence Wang Suiyong had no right to use it as a basis for suing others for trademark infringement. But did Ellassay and Intime Department Store infringe upon Wang Suiyong’s Trademark No. 7925873 “歌力思”? The Court found as follows.

First, Ellassay owns the legitimate existing prior rights to the trademark. Ellassay and its affiliates had used “ELLASSAY” as a trade name as early as 1996 and obtained the registered trademark “ELLASSAY” on commodities such as garments in 1999. As a result of long-term use and extensive publicity, “ELLASSAY” now enjoys high visibility in the market as Ellassay’s trade name and registered trademark. Thus Ellassay owns the existing prior rights to the trademark “ELLASSAY”.

Secondly, Ellassay’s use in this case was based on legitimate rights, and both its methods of use and the nature of that use are legitimate. In terms of venue of sales, Ellassay’s allegedly

infringing products were displayed and sold at Ellassay counters within Intime Department Store, and the counters clearly indicated the provider of the allegedly infringing products by displaying Ellassay's trademark "ELLASSAY". Given that Ellassay's business marks, including its trade name and trademark, are highly visible in the market and that Wang Suiyong failed to prove that the mark "歌力思" enjoys the same level of visibility, Ellassay's sales of allegedly infringing products at its counters were unlikely to lead ordinary consumers to falsely believe that these products were supplied by Wang Suiyong. In terms of Ellassay's specific methods of use, the trademark "ELLASSAY" was marked both on conspicuous areas of the packaging and inside the allegedly infringing products, and only the characters "品牌中文名 (Chinese Brand Name): 歌力思" were printed on the product tags. Because "歌力思" is Ellassay's trade name and is used as the substitute for the trademark "ELLASSAY", there is nothing obviously wrong with Ellassay using the Chinese characters 歌力思 on the tags of the allegedly infringing products to indicate the product manufacturer. It did not intend to attach itself to Wang Suiyong's trademark "歌力思" and the label would not prevent ordinary consumers from differentiating the correct source of the allegedly infringing products. On this basis, Intime Department Store's sales of the allegedly infringing products is not prohibited under law.

Finally, Wang Suiyong's obtaining of the trademark "歌力思" and exercising of the trademark right was neither justifiable nor appropriate. The trademark "歌力思" comprises the Chinese characters 歌力思, which are exactly the same as the Chinese characters of the trade name

first used by Ellassay and in the earlier registered trademark "ELLASSAY". 歌力思 is an invented phrase without any intrinsic meaning, but with a considerable degree of distinctiveness. Common sense dictates that it is unlikely that a company will register the exact same trademark by coincidence without seeing or knowing of the prior existing one. As a business operating in a similar area and with a similar business scope, it is even less likely that Wang Suiyong did not know about the existing trade name and trademark "ELLASSAY". In such circumstances, it is difficult to say that it would be appropriate for Wang Suiyong to apply for the registration of a trademark "歌力思" on handbags and wallets, among other things.

Accordingly, the Supreme People's Court found that Wang Suiyong's claim against Ellassay's fair use of a trademark that Wang Suiyang had acquired maliciously constituted an abuse of rights.

D. Protection of rights in the name of real estate property, the protection of rights under a registered trademark and the unauthorized use of another enterprise's name

If one party uses, as a name for its real estate property, a name over which another party has registered a trademark, the first party shall be found to have infringed upon the second party's exclusive right to use of that name.

If, however, the first party first used the disputed name in relation to its property before the second party used and then registered the name as a trademark, then the first party shall not be found to have infringed upon the second party's rights.

GUANGZHOU STAR RIVER INDUSTRY DEVELOPMENT CO., LTD. AND GUANGZHOU HONGFU REAL ESTATE CO., LTD. V. JIANGSU WEIFU GROUP CONSTRUCTION & DEVELOPMENT CO., LTD.

(2013) MTZ No. 102, SPC

Cause of action:

Dispute over infringement of a trademark right and unfair competition

Collegial panel members:

Wang Chuang | Wang Yanfang | Zhu Li

Keywords:

enterprise name, name of real estate property, prior use, trademark infringement, unfair competition

Relevant legal provisions:

Trademark Law of the People's Republic of China (as amended in 2001), article 51

Interpretation of the Supreme People's Court Concerning the Application of Laws in the Trial of Cases of Civil Disputes Arising from Trademarks, articles 9, 10 and 21

Basic facts: In the dispute over trademark infringement and unfair competition between appellants Guangzhou Star River Industry Development Co., Ltd. (hereinafter "Star River Company") and Guangzhou Hongfu Real Estate Co., Ltd. (hereinafter "Hongfu Company") and respondent Jiangsu Weifu Group Construction & Development Co., Ltd. (hereinafter "Weifu Company"), the combined mark, Trademark Nos. 1946396 and 1948763 (as illustrated) – authorized for use in relation to services falling into Class 36 of the International Classification of Goods and Services for the Purposes of the Registration of Marks (hereinafter the "Nice Classification") (apartment rental and apartment management and other services) – was registered based on an application by Hongfu Company, and later successively transferred first to Hongyu Group (Hong Kong) Co., Ltd. (hereinafter "Hongyu Company"), a party not involved in the case, and then to Star River Company.



Hongfu Company was licensed to use the two registered trademarks and was entitled to file in its own name a suit alleging infringement. Hongfu Company and its affiliates successfully developed property projects bearing the name "Star River" in Guangzhou, Beijing, Shanghai

and other places. The fact that Hongyu Group and Star River Company won many awards for their work boosted the profile of “Star River” properties.

Since 2000, Weifu Company had successfully launched several real estate projects, including “Star River Garden”, “Star Garden” and “Star View Garden” in Nantong City, Jiangsu Province, and all such names had been submitted to the Nantong Municipal Bureau of Civil Affairs for approval. Star River Company and Hongfu Company initiated legal proceedings on the grounds that use of the phrase “Star River” in Weifu Company’s real estate projects infringed on their registered trademark right and constituted unfair competition.

At first instance, the Intermediate People’s Court of Nantong, Jiangsu, held that Weifu Company’s use of “Star River Garden” as the name of its real estate property development did not cause confusion among consumers about the source of that property and therefore did not constitute trademark infringement. Hongfu Company’s “Star River” real estate property development did enjoy a high profile in Guangzhou City, but Weifu Company had long been using the name legitimately. Weifu showed no subjective intention of profiting from the name by free-riding on Hongfu Company’s reputation nor was there, objectively speaking, any possibility of consumer confusion over the name; hence Weifu Company’s action, in using such a name, did not constitute unfair competition. The first-instance court rejected the claims filed by Star River Company and Hongfu Company.

Star River Company and Hongfu Company subsequently appealed to the Higher People’s Court of Jiangsu, which affirmed the first-instance judgment.

Dissatisfied with the decisions at first and second instance, Star River Company and Hongfu Company lodged an appeal with the Supreme People’s Court.

Held: On February 26, 2015, the Supreme People’s Court delivered a civil judgment in which it overturned the decisions of the courts at first and second instance, and ordered Weifu Company not to use “Star River” as the name for any real estate property not yet sold or yet to be developed, and to pay Star River Company and Hongfu Company damages for economic losses in the amount of RMB50,000.

Reasoning: With respect to the question of whether Weifu Company’s use, as the name of a real estate property, of the trademark over which Star River Company and Hongfu Company enjoyed the exclusive right constituted an infringement of that right, the Supreme People’s Court affirmed that article 50(1) of the Implementing Rules of 2002 of the Trademark Law of the People’s Republic of China prescribes that “the use of a sign which is identical or similar to another person’s registered trademark on the same or similar goods as the name or decoration of the goods, thus misleading the public”, shall constitute an infringement upon the exclusive right to use a registered trademark provided for under article 52(5) of the Trademark Law of the People’s Republic of China. In this case, Star River Company owned the exclusive right to use registered Trademark Nos. 1946396 and 1948763, which were approved for use, respectively, in relation to Class 36 services (including real estate rental and real estate agency) and Class 37 services (including construction, interior decoration and maintenance); Weifu Company had used such a name for its commodity housing.

With respect to the question of whether commodity housing (as goods) and real estate construction (as a service) are similar, pursuant to provisions in article 11(3) of the Interpretation of the Supreme People's Court Concerning the Application of Laws in the Trial of Cases of Civil Disputes Arising from Trademarks, "similarity between goods and services" shall mean that there is a specific link between the goods and the services such that the relevant public may be easily confused. Service categories approved for the two registered trademarks involved in this case were real estate management and construction. When compared to the sale of commodity housing, the Court found the two to be similar in terms of function, purpose, consumers targeted and sales channels, among other things, and noted that both companies were real estate developers. Given this specific link between "real estate management and construction" and "the sale of commodity housing", the Court affirmed a similarity between the former (as a service) and the latter (as goods).

With respect to the question of whether the use of "Star River Garden" as a name would be likely to mislead the public, the Court examined the facts established by the court at first instance. Hongfu Company and its related business units had promoted "Star River" real estate in *Nanfang Daily*, *Yangcheng Evening News* and related media since 2001, and properties with the name "Star River" had won relevant awards, fueling a high public profile; the phrase "Star River" was therefore a most distinctive and well-known component of the registered trademark at issue. Weifu Company named its real estate properties "Star River Garden", which in fact played a role in identifying such property and essentially belonged to a specific type

of business marks. The word "Garden" in such a mark was a general term for the name of the property, but the most distinctive element was the phrase "Star River" – a phrase that was identical in both writing and pronunciation to the distinctive element "Star River" in the two trademarks registered by Star River Company and Hongfu Company. Furthermore, because information now flows richly and easily within a modern society, it would not be uncommon to see real estate businesses develop a series of properties nationwide under such a name, and if Weifu Company were to perpetuate such use, it would cause confusion, misleading the relevant public to believe that such property was somehow linked with the "Star River" series of properties developed by Star River Company and Hongfu Company. On this basis, the Court found that Weifu Company's use of the mark "Star River Garden" as the name of its property, which was similar to the trademark "Star River" over which Star River Company and Hongfu Company enjoyed an exclusive right of use, had caused confusion and misunderstanding among the public. Such use did constitute an infringement on the registered trademarks of Star River Company and Hongfu Company, and Weifu Company was to bear corresponding civil liability. The judgment at first instance that the use of "Star River" as only a name for real estate property could not cause confusion among the public about the source of the development was incorrect and the Supreme People's Court overturned that finding.

With respect to the question of whether Weifu Company's use of the name constituted an unauthorized use of another enterprise's name, the Supreme People's Court held that, based on facts established by the court at first

instance, Star River Company (formerly Guangzhou Minyu Wood Co., Ltd.) adopted its current name in August 2007. Weifu Company was able to demonstrate an established custom of naming its properties using the word “Star” that dated back to 2000.

On May 15, 2006, for example, Weifu Company had applied to Nantong Municipal Bureau of Civil Affairs for permission to name a residential community “Weifu Star River” on the basis that “Star” had been the first word in its existing “Star Garden” and “Star View Garden” properties, and that “River” was meant to refer to the two rivers running through the new community. On May 25, 2006, Nantong Municipal Bureau of Civil Affairs granted Weifu Company approval to use the name “Star River Garden”. This use pre-dated Star River Company’s use of the phrase “Star River” as its name and hence the Supreme People’s Court held that Weifu Company had *not* committed unauthorized use of another enterprise’s name.

E. Extent of similarity of two trademarks, one in Chinese and the other in another language, shall be based on whether a relevant public connects the two

To assess the extent to which two trademarks – one in Chinese and the other in another language – are similar, the courts shall consider not only the components of the trademarks, their overall similarity, their distinctiveness and reputations, and any correlation between the products to which they apply, but also whether a relevant public commonly makes a connection between the two.

CHATEAU LAFITE ROTHSCHILD V. TRADEMARK REVIEW AND ADJUDICATION BOARD AND NANJING GOLD HOPE WINE INDUSTRY

(2016) ZGFXZ No. 34, SPC

Cause of action:

Administrative case regarding a trademark dispute

Collegial panel members:

Wang Yanfang | Qian Xiaohong | Du Weike

Keywords:

connection, dispute procedure, trademark, trademark similarity

Relevant legal provisions:

Trademark Law of the People’s Republic of China (as amended in 2001), article 28

Basic facts: In the retrial of an administrative case of a dispute over a trademark between claimant company Chateau Lafite Rothschild (hereinafter “Chateau Lafite”) and, as respondents, the Trademark Review and Adjudication

Board of the State Administration for Industry and Commerce (hereinafter the “TRAB”) and Nanjing Gold Hope Wine Industry (hereinafter “Gold Hope Company”), the latter had applied to register Trademark No. 4578349 “Chateau Lafei” (hereinafter “the disputed trademark”) on April 1, 2005. The disputed trademark was approved for use on products falling within Class 33 of the International Classification of Goods and Services for the Purposes of the Registration of Marks, including wine, alcoholic beverages, fruit extracts (alcoholic), distilled alcoholic beverages, cider, alcoholic liquid, alcoholic beverages containing fruit, rice alcohol, highland barley alcohol and cooking alcohol, and Gold Hope Company was registered as the owner of the exclusive right to use the trademark. The date on which Chateau Lafite registered its trademark “LAFITE” (hereinafter “the cited trademark”) was October 10, 1996, which trademark was approved for use on Class 33 products – that is, alcoholic beverages (except for beers) – and Chateau Lafite held the exclusive right to use that registered trademark.

Within the statutory time limit, Chateau Lafite filed with the TRAB an application opposing the disputed trademark on the grounds that it violated article 28 of the Trademark Law of the People’s Republic of China. The TRAB rendered its *Decision on Trademark No. 4578349 “Chateau Lafei” Dispute* [2013] SPZ No. 55856 (hereinafter “Decision No. 55856”) on September 2, 2013, and cancelled the disputed trademark on the grounds that it violated article 28.

Dissatisfied with the ruling, Gold Hope Company instituted administrative proceedings. The Beijing No. 1 Intermediate People’s Court affirmed the TRAB’s decision.

Still dissatisfied, Gold Hope Company lodged an appeal. At second instance, the Beijing Higher People’s Court held that it was difficult to affirm that the cited trademark had established a market reputation on China’s mainland before the registration date of the disputed trademark and whether or not the relevant public was able to distinguish the cited trademark “LAFITE” from the disputed trademark “Lafei”. The disputed trademark had been registered and used for as long as 10 years, and it had established a stable market position. Thus, from the perspective of maintaining that established and stable market position, the registration of the disputed trademark in this case was to be sustained. The Beijing Higher People’s Court therefore overruled the judgment of the court at first instance and Decision No. 55856.

Chateau Lafite was dissatisfied and appealed to the Supreme People’s Court. An article entitled “AQSIQ announces six kinds of imported ‘Lafite’ wines that do not conform to quality standard”, published on China Economic Net, reported that:

Chinese consumers have always been enticed by “Lafite” Wines, however, recently, the Administration of Quality Supervision, Inspection and Quarantine (AQSIQ) announced six kinds of imported Lafite wines that did not conform to the quality standard, which left admirers of Lafite shocked. According to China Economic Net, the six kinds of wine products that did not conform to the quality standard are: Chateau 拉菲 (Lafei) 2012 dry red wine ...

On August 1, 2016, Sohu Finance published an article, with text and photos, in which it reported “Chateau 拉菲 (Lafei)” making a grand appearance

at China Food and Drinks Fair and consumers unaware of it being a knockoff”.

The Supreme People’s Court ruled that the case should be reviewed.

Held: The Supreme People’s Court delivered its administrative judgment on December 23, 2016, overruling the judgment of the court of second instance and affirming the judgment of the first-instance court and Decision No. 55856.

Reasoning: The Supreme People’s Court held that the decision on whether trademarks are similar requires consideration of the elements of the trademarks and their overall similarity, as well as of the distinctiveness and reputation of the relevant trademarks, and the correlation between the goods for which the trademarks are used. Whether it is easy for the trademarks to be confusing shall be used as the standard of judgment.

In this case, the disputed trademark consisted of Chinese characters 拉菲庄园 (“Chateau Lafei”). 庄园 (“Chateau”) has a weak distinctiveness with respect to the wine category and hence 拉菲 (“Lafei”) is the core element of the disputed trademark. The key to whether the disputed trademark is similar to the cited trademark is whether 拉菲 (“Lafei”) is similar to “LAFITE” or whether the two are regularly connected.

Before the application date of the disputed trademark, according to the facts ascertained by the Court, “LAFITE” had been transliterated as Chinese characters 拉菲 in various media and news reports published in the *News Express*, *Yangtze Evening Post* and *Beijing Daily* – newspapers that are easily accessible and which have a

large readership. Various media articles highly commended “LAFITE” wine and hence the cited trademark has a high reputation. In addition, as a result of many years of commercial operations, Chateau Lafite has established a stable objective connection between “拉菲” and “LAFITE”, and the relevant public in China often refers to “拉菲” as “Lafite”, so the disputed trademark is similar to the cited trademark.

In addition, where a trademark has been registered and used for a period of time, whether that use has resulted in a high market reputation and a relevant consumer community is assessed not on the basis of the period of use, but on whether the relevant public can objectively distinguish the trademark from other trademarks in practice. As per the facts ascertained by the Court, the relevant substandard products reported on by various news outlets could all be identified as products under the disputed trademark. It could also be seen from those news reports that the relevant public had indeed confused the disputed trademark with the cited trademark. The evidence that Gold Hope Company submitted therefore failed to prove that a distinct relevant public for its product had been formed as a result of its use of the disputed trademark. The second-instance court’s conclusion that the disputed trademark had established its own stable market position had no basis in fact and the Supreme People’s Court overturned that judgment.

F. Determination of “registration obtained by other improper means” under the Trademark Law

Under article 41(1) of the Trademark Law of the People’s Republic of China (as amended in 2001), “registration obtained by any other improper means” refers to the acquisition of a registered trademark not by fraud, but by any means that disrupt the authorized procedure for trademark registration, impair public interests, divert public resources or otherwise are in pursuit of unjust profits.

To apply for a registered trademark, a civil subject should be able to demonstrate genuine intention to use the name.

LI LONGFENG V. TRADEMARK REVIEW AND ADJUDICATION BOARD AND SANYA HAITANGWAN MANAGEMENT COMMITTEE
(2013) ZXZ Nos. 41 & 42, SPC

Cause of action:

Administrative dispute over a trademark

Collegial panel members:

Xia Junli | Yin Shaoping | Dong Xiaomin

Keywords:

other improper means, trademark registration

Relevant legal provisions:

Trademark Law of the People’s Republic of China (as amended in 2001), articles 4 and 41

Basic facts: In the retrial of an administrative trademark dispute between Li Longfeng and the Trademark Review and Adjudication Board of the State Administration for Industry & Commerce (hereinafter the “TRAB”), in

which Sanya Haitangwan Management Committee (hereinafter “Haitangwan Management Committee”) was the third party, the facts were as follows. On June 8, 2005, Li Longfeng had registered Trademark Nos. 4706493 “Haitangwan” and 4706970 “Haitangwan” (the disputed trademarks). Trademark No. 4706493 was for services under Class 36 of the International Classification of Goods and Services for the Purposes of the Registration of Marks, including rental of real estate and management of real estate and residence (apartments); Trademark No. 4706970 “Haitangwan” was for Class 43 services, spanning accommodation bureau services (hotels, boarding houses), tourist home services, hotel services and restaurant services. Under the provisions of articles 31, 41(1) and 10 of the Trademark Law of the People’s Republic of China (as amended in 2001), Haitangwan Management Committee requested that the TRAB cancel its registration of the disputed trademarks. The TRAB, in its *Decision on Trademark Dispute over Trademark No. 4706493 “Haitangwan”* (2011) SPZ No. 13255 (hereinafter “Decision No. 13255”) and *Decision on Trademark Dispute over Trademark No. 4706970 “Haitangwan”* (2011) SPZ No. 12545 (hereinafter “Decision No. 12545”), ruled to cancel the two “Haitangwan” trademarks. Li Longfeng found the decisions unsatisfactory and brought administrative lawsuits against both.

At first instance, the Beijing No. 1 Intermediate People’s Court overruled the TRAB and overturned Decision Nos. 13255 and 12545. Dissatisfied, the TRAB and Haitangwan Management Committee appealed.

At second instance, the Beijing Higher People’s Court overruled the first-instance judgment and affirmed Decision

Nos. 13255 and 12545. Dissatisfied, Li Longfeng applied for permission to appeal to the Supreme People's Court.

Held: On August 12, 2013, the Supreme People's Court denied Li Longfeng permission to appeal.

Reasoning: The Supreme People's Court held that, under article 41(1) of the Trademark Law, if the registration of a trademark is "obtained by fraudulent or other illegitimate means", other entities or individuals may request that the TRAB cancel that registration. To determine whether registration of the disputed trademark has been obtained by such means, the courts need to consider whether the registration has been acquired not by fraud, but by using any means that disrupt the authorized procedure for trademark registration, impair public interests, improperly occupy public resources or otherwise are in pursuit of unjust profits. Article 4 of the Trademark Law provides that any natural person, legal person or other organization that needs to obtain the exclusive right to use a trademark for the goods or services that they produce, manufacture, process, select or market shall apply to register the trademark with the Trademark Office. It may be inferred from this article that, to validly apply for a registered trademark, the civil subject should have a genuine intention to use the trademark to meet their own needs and that the means the subject uses to achieve trademark registration shall be reasonable or legitimate.

According to the facts established by the TRAB and at first instance, relevant governmental authorities in Hainan Province had already been using and promoting the name "Haitangwan" before Li Longfeng applied to register the disputed trademarks, and it had become the publicly known name of a resort

area in Sanya City, as well as the name of a major comprehensive development project, demonstrating distinct meaning and designation. When interviewed in the press, Li Longfeng had admitted that he applied to register the trademarks only because media coverage had led him to believe that the mark would become very famous and thus profitable when renowned entrepreneurs from Hong Kong participated in the Haitangwan development project. As an individual, Li Longfeng had obtained registration of the trademarks at issue not only for Class 36 services, including rental of real estate, management of real estate and residence (apartment), and for Class 43 services, spanning accommodation bureau services (hotels, boarding houses), tourist home services, hotel services and restaurant services, but also for use in relation to other classes of goods and services. Li Longfeng had obtained registration of more than 30 additional trademarks, such as "Xiangshuiwan" and "Yelinwan" for various classes of goods and services, some of which marks were related to well-known names of places and scenic spots in Hainan Island. In so doing, Li Longfeng intended to exploit the huge influence of the governmental authorities' efforts to promote and market Haitangwan as a resort area and of investment in the Haitangwan development project, and hence he squatted several trademarks related to "Haitangwan" and obtained registration of a large number of other trademarks without justifiable reason.

The Supreme People's Court found that Li Longfeng's conduct demonstrated that he had no intention to use the mark himself and had no legitimate justification for registering such a trademark, and that his application for permission to appeal constituted improper occupation of public resources and disruption of the authorized procedure for trademark registration.

G. Use of a business name as a name for a television show and infringement of rights under the Trademark Law

A logo in which the key attribute is the name of a television show may be a trademark. Whether the logo is eligible for use or is used as a trademark depends on whether it is sufficiently indicative of the source of relevant goods or services to enable the relevant public to distinguish between different providers of those goods or services.

Some television shows may be based on real-life situations; these situations are only elements for the shows. In judging whether such shows are the same as or similar to a certain class of service, the courts shall comprehensively examine the show and its main features, including its genre, and hence make a comprehensive and reasonable determination of the extent to which the show and the goods or service are sufficiently similar that use of the same name for both might infringe on any trademark rights.

JIN AHUAN V. JIANGSU BROADCASTING CORPORATION AND SHENZHEN ZHENAI.COM INFORMATION TECHNOLOGY CO., LTD.

(2016) YMZ No. 447, Guangdong Higher People's Court

Cause of action:

Dispute over infringement of trademark rights

Collegial panel members:

Xu Chunjian | Qiu Yongqing | Xiao Haitang

Keywords:

class, confusion, name of television show, trademark

Relevant legal provisions:

Trademark Law of the People's Republic of China (as amended in 2001), article 57(1) and (2)

Interpretation of the Supreme People's Court on Several Issues Concerning the Application of Law in the Trial of Civil Dispute Cases over Trademarks, articles 9–12

Basic facts: In the retrial of a case alleging infringement of trademark rights between appellants Jiangsu Broadcasting Corporation (hereinafter “Jiangsu TV Station”) and Shenzhen Zhenai.com Information Technology Co., Ltd. (hereinafter “Zhenai.com”), and respondent Jin Ahuan, who is the holder of Trademark No. 7199523 (as illustrated), written as 非誠勿擾 in traditional Chinese characters (meaning “If You Are the One”), the facts were as follows.



Jin Ahuan had applied for registration of the trademark on February 16, 2009, and it had been approved, on September 7, 2010, for use in relation to approved services under Class 45 of the International Classification of Goods and Services for the Purposes of the Registration of Marks (hereinafter the “Nice Classification”), including “dating services and marriage agency services”.

In 2010, under the auspices of Jiangsu TV Station, JSTV launched a television show entitled 非誠勿擾 (in simplified Chinese characters, meaning *If You Are the One*) based on the theme of marriage and dating. JSTV introduced the show as a large-scale dating program that adapts dating to the rhythm of modern life, providing an open forum for marriage

and dating, matching high-quality dating companions, and defining a brand-new model of marriage and dating. The method of registering for the show included “registering the information at Zhenai.com”. Zhenai.com recruited participants from Nanshan District in Shenzhen City and selected guests to go on blind dates for the show. In this case, the disputed logo took two main forms: one was the “If You Are the One” text-based logo; the other was a graphic logo, which combined the text “If You Are the One” and a female silhouette (as illustrated).



Jin Ahuan filed a lawsuit with the People’s Court of Nanshan District of Shenzhen, Guangdong Province, claiming that Jiangsu TV Station and Zhenai.com had infringed on its exclusive right to use its registered trademarks, and requesting that:

- (a) JSTV, under the auspices of Jiangsu TV Station, be ordered to immediately stop using the name “If You Are the One”;
- (b) Zhenai.com be ordered to immediately stop using the name “If You Are the One” for advertising, registration, screening, follow-up services and other joint infringement acts; and
- (c) the two defendants (Jiangsu TV Station and Zhenai.com) be ordered to jointly bear all litigation costs.

The People’s Court of Nanshan District of Shenzhen, Guangdong Province, found Jin Ahuan’s text-based trademark “If You Are the One” to be the same as the name of Jiangsu TV’s show *If You Are the One*, but that while the latter was related

to marriage and dating, it was nothing more than a television show; the relevant public generally believed there to be no specific connection between the show and Jin Ahuan’s dating service, and it was not easy to cause public confusion in this regard. The first-instance court therefore found the two services to be of very different types and the use of the registered trademark of one as a name for the other not to constitute infringement, and it dismissed Jin Ahuan’s claim.

Dissatisfied with the finding, Jin Ahuan lodged an appeal. The Shenzhen Intermediate People’s Court of Guangdong Province affirmed that Jiangsu TV Station’s show *If You Are the One* could be identified as a marriage and dating program based on its synopsis, its opening and concluding remarks, the conditions of participation and registration, the interactive content of the guests in the show, and the details published by the State Administration of Radio, Film and Television, as well as media commentary. Therefore, Jiangsu TV Station’s show *If You Are the One* could be said to have the same purpose as the “dating services and marriage agency services” approved under Jin Ahuan’s registered trademark. In the latter case, Jin Ahuan’s registered trademark had been put into commercial use and thus the use of the disputed logo could affect the normal use of the registered trademark. The court at second instance held that the relevant public could easily misunderstand and connect the use of the right holder’s registered trademark with Jiangsu TV Station’s show, and hence found the latter’s use of the name to constitute trademark infringement. Because Zhenai.com participated in the recruitment of the guests and promotion, and also signed a cooperation agreement with Jiangsu TV Station, it

was jointly liable for the infringement. The second-instance court ruled that Jiangsu TV Station and Zhenai.com should cease their infringement.

Dissatisfied with the decision at second instance, Jiangsu TV Station and Zhenai.com applied to Guangdong Higher People's Court for permission to appeal on the grounds that the disputed logo was not used as a trademark and that its use would not cause confusion because it belongs to a class of service other than that approved under Jin Ahuan's registered trademark.

Held: At first instance, in its judgment dated September 29, 2014, the People's Court of Nanshan District of Shenzhen, Guangdong Province, dismissed Jin Ahuan's claims. Jin Ahuan lodged an appeal. At second instance, the Shenzhen Intermediate People's Court of Guangdong Province delivered judgment on December 11, 2015, finding that:

- (a) the first-instance finding should be overturned;
- (b) JSTV, operating under the auspices of Jiangsu TV Station, was to cease using the "If You Are the One" name immediately on the second-instance judgment coming into force; and
- (c) Zhenai.com was to stop using the "If You Are the One" name for advertising, registration and follow-up services immediately on the second-instance judgment coming into force.

Jiangsu TV Station and Zhenai.com refused to accept the second-instance judgment, and applied to the Guangdong Higher People's Court for permission to appeal. The Court granted permission and, on December 30, 2016, it overturned the judgment of the second-instance court and affirmed the judgment of the court at first instance.

Reasoning: In reviewing the case, Guangdong Higher People's Court held as follows.

I. Whether the disputed logo is used as a trademark

The key to judging whether the disputed "If You Are the One" logo is a trademark lies in whether the logo aims to indicate the source of the relevant goods or services sufficiently distinctly as to enable the relevant public to distinguish between different providers. In this case, *If You Are the One* is the name that Jiangsu TV Station chose to distinguish its television show from its multiple other shows. However, judging from the circumstances of this case, Jiangsu TV Station's use of the disputed "If You Are the One" logo not only is descriptive in summarizing the content of the show, but also involves repeated and extensive independent or prominent use in commercial activities, such as on television, on an official website, and in advertisement and on-site publicity aiming to attract investment, and the manner of its use is continuous and coherent. The disputed logo is somewhat unique in its overall presentation, which clearly goes beyond the scope and general message necessary for descriptive use in relation to the show's content, and hence has the function of distinguishing goods or services. While Jiangsu TV Station applies the "JSTV" logo to the show as well as the "If You Are the One" logo, this cannot objectively be said to change the role and function of the latter in indicating its source, but instead prompts the relevant public to more closely associate the "If You Are the One" logo with JSTV, under the auspices of Jiangsu TV Station. As the show continues to be broadcast and advertised, the disputed "If You Are the One" logo becomes more distinctive. When the relevant public

sees the alleged logo, they more readily associate it with the television show and its source – that is, JSTV, under the auspices of Jiangsu TV Station. In this way, the disputed logo objectively plays a role in indicating the source of the goods or services. Moreover, in many advertisements, Jiangsu TV Station combines the disputed “If You Are the One” logo and the “JSTV” logo with brand logos including “Tuniu.com” and “KanS”, among others, aiming to generate joint publicity, and the evidence submitted during appeal indicates that Jiangsu TV Station sought trademark authorization from Huayi Company for the use of its logo. All of this directly reflects that Jiangsu TV Station can be judged to have been willing to use the disputed logo as a trademark to identify the show’s source and to maintain it as a brand. It therefore cannot be established when Jiangsu TV Station denied that the relevant behavior was trademark use on the grounds that “If You Are the One” was merely the name of the show and that the “JSTV” logo was that mark which clearly distinguishes its source.

II. Whether Jiangsu TV Station infringed on Jin Ahuan’s registered trademark rights

In making a judgment on trademark infringement, the issues for evaluation are whether the disputed logo is the same as or similar to the registered trademark, whether the two categories of service are the same or similar, and whether it is easy to cause confusion and misunderstanding in the minds of the relevant public.

(a) Whether the disputed logo is the same as or similar to the registered trademark In this case, the disputed “If You Are the One” text and graphic logos can be compared with Jin Ahuan’s registered trademark (Trademark No. 7199523).

There are differences in the character types – traditional Chinese characters are used in Jin Ahuan’s mark and simplified Chinese characters are used in the respondent’s logo – and there are also differences in fonts and text sequence. Unlike Jin Ahuan’s registered trademark, the disputed logo combines both graphic and text, and is different in color and pattern. The disputed logos are therefore not the same as Jin Ahuan’s registered trademark. While the distinctive and core elements of the disputed logos and Jin Ahuan’s registered trademark comprise the identical text “If You Are the One”, and the overall structure is similar and the natural components are similar, the similarity between the objective elements is not sufficient to qualify as infringement under the Trademark Law. What the Trademark Law is intended to protect is not the trademark logo itself, which is fixed by the act of registration, but the trademark’s function in identifying and distinguishing between goods or services. If the disputed logo is not used for the same or similar goods or services as the registered trademark, and if use of the logo does not do damage to the trademark’s function in identifying and distinguishing goods or services and on condition that it does not result in market confusion, the disputed logo should not be deemed to constitute a trademark infringement.

(b) Whether the two categories of service are the same or similar When judging whether a television show is identical with or similar to a category of service, it is not advisable simply to look at the form of expression or substantive theme of the show in isolation; rather, it is necessary to examine the show as a whole, including all of its main features and grasping its core aspects, and hence to arrive at a comprehensive and reasonable assessment. In this respect, when investigating the television show to which

the disputed logo “If You Are the One” is attached from the perspectives of purpose, content, method of expression and object of related services, its use is found to be that typical in television entertainment programs. Specifically, *If You Are the One* is a television entertainment program featuring blind dates and dating. It includes the words and actions of modern single people in blind date and dating scenarios, combined with on-site commentators and a host offering commentary and guidance, and it is broadcast as a television show after editing, so that the audience can learn more about the current phenomenon of social dating and related values while relaxing and enjoying the show, and hence be guided to establish a healthy and positive outlook on marriage, love and life. The purpose of the service is to provide the public with a culturally based entertainment program, and to deliver economic benefits to the broadcaster in the form of sponsorships and advertisements, based on audience ratings and interest in the show. The content of the service is delivered to its audience through the specific channels of television broadcasting and mass media, which disseminate cultural entertainment programs to the public, and the target audience of the service comprises unspecified viewers.

Those providing “dating services and marriage agency services” under Class 45 of the Nice Classification are offering an intermediary service to specific individuals to meet their needs for marriage matchmaking. The purpose of the service is to generate economic benefit for the supplier by providing such services. The methods involved in providing the service usually include managing the personal information of participants, providing consultation and advice, and communicating marriage intentions and other such intermediary services; the targeted recipients of the

service are specific unmarried people who are interested in getting wed.

The differences between the two types of service are therefore obvious in terms of the services’ purpose, content, method and recipients. Based on general knowledge among the relevant public, it is possible to clearly distinguish the content of the entertainment television show from the real-life matchmaking service activities and it is not likely that the relevant public will mistakenly believe that there is a connection between the two. Thus the two do not constitute identical or similar services.

Taking a step back, even if they were to be identified as similar services, in deciding whether a trademark infringement has occurred, the courts must closely follow the purpose of the Trademark Law and take into consideration the significance and popularity of the registered trademark involved, as well as (based on a determination of its scope and the intensity of protection) the likelihood of confusion and misunderstanding in the minds of the relevant public. In this case, the text “If You Are the One” in Jin Ahuan’s registered trademark is a common phrase in business activities. It has a low degree of distinctiveness when used in the field of marriage introduction services, and there is no evidence of the sort of long-term and large-scale use that would allow it to acquire such distinctiveness. The Court’s assessment of the scope and intensity of protection of the registered trademark in this case shall therefore be proportionate with Jin Ahuan’s contribution to the significance and popularity of the trademark. In contrast, the disputed “If You Are the One” logo justifiably uses the phrase as the name of a blind date and dating television program. After long-term broadcasting, the show has become well

known to the public as an entertainment and recreation program. Even if the program involves content related to dating, the relevant public can clearly distinguish the source of the service without misunderstanding or confusing it with Jin Ahuan's service, and therefore the disputed logo does *not* constitute trademark infringement.

H. Standard of protection for a product name as an unregistered well-known trademark

Distinctiveness is the fundamental feature of a trademark and the basic attribute that makes a name or eligible for trademark registration. Only when a mark or a name is of sufficiently distinctive character can it be used to identify and distinguish the source of goods, and hence only such a mark or name can be protected under the Trademark Law of the People's Republic of China.

Even if the name or mark is not registered under the Trademark Law, if the name or mark becomes sufficiently well known among a relevant public, it may acquire protection as an unregistered well-known trademark.

COMMERCIAL PRESS CO., LTD. V. SINOLINGUA CO., LTD.
(2016) J 73 MC No. 277, Beijing
Intellectual Property Court

Cause of action:

Disputes over infringement of trademarks and unfair competition

Collegial panel members:

Zhang Lingling | Feng Gang | Yang Jie

Keywords:

dissemination of knowledge, trademark, unfair competition, unregistered well-known trademark

Relevant legal provisions:

Law of the People's Republic of China against Unfair Competition (as published in 1993), articles 5(2) and 20(1)

Tort Law of the People's Republic of China, article 15

Trademark Law of the People's Republic of China (as amended in 2013), articles 13 and 14

Basic facts: Both the claimant, Commercial Press Co., Ltd. (hereinafter “Commercial Press”) and the defendant, Sinolingua Co., Ltd. (hereinafter “Sinolingua”), are publishing agencies. Since 1957, Commercial Press has continuously published the popular version of the *Xinhua Dictionary*, in its 11th edition at the time of the case; in 2010–15, Commercial Press’s average market share of the dictionary market exceeded 50 percent and, as of 2016, the global distribution of the *Xinhua Dictionary* exceeded 567 million, for which Guinness World Records lists it as both the “Most Popular Dictionary” and the “Bestselling Book (as revised on a regular basis)”, among other honors.

Commercial Press alleged that the acts of Sinolingua in producing and selling its own “Xinhua Dictionary” infringed the unregistered well-known trademark “Xinhua Dictionary” and that Sinolingua’s uses of the “special decoration” of the famous product *Xinhua Dictionary* (11th edn, Commercial Press) constituted unfair competition. Commercial Press asked the Beijing Intellectual Property Court to order Sinolingua to:

- (a) immediately stop its infringement of Commercial Press’s trademark rights and its acts of unfair competition;
- (b) publish statements in the relevant media, including the *China Press and Publication TV Broadcast Newspaper*, to mitigate the negative effects arising from the infringement; and
- (c) pay Commercial Press damages for economic losses in the amount of RMB3 million, and for reasonable costs and expenses in the amount of RMB400,000.

Sinolingua argued that it had based its product name “Xinhua Dictionary” on

the name of a national project that had evolved to become the common name of a dictionary in the public domain and that Commercial Press could not assert rights in the unregistered trademark “Xinhua Dictionary” or to prohibit others from using it appropriately. Sinolingua argued that the design of the *Xinhua Dictionary* (11th edn, Commercial Press) did not count as “special decoration” under article 5(2) of the Law of the People’s Republic of China against Unfair Competition and that its use of the design would not cause confusion or misunderstanding on the part of the relevant buying public. Sinolingua argued that, by filing a lawsuit aiming to control the common name of the dictionary (that is, “Xinhua Dictionary”), Commercial Press was improperly aiming to eliminate its competition and achieve a monopoly in the dictionary market.

The Beijing Intellectual Property Court held that the name “Xinhua Dictionary” has the distinctive features of a trademark and that, upon its use by Commercial Press, it became a well-known trademark and now constitutes an unregistered well-known trademark. Sinolingua’s reproduction and imitation of that unregistered well-known trademark consequently constituted infringement. The design of *Xinhua Dictionary* (11th edn, Commercial Press) fell under provisions protecting the special packaging and decoration of famous products, and hence Sinolingua’s use of that special decoration without consent was found to constitute unfair competition. The first-instance court therefore ruled that Sinolingua was to:

- (a) immediately cease its infringement of the trademark at issue and its acts of unfair competition;
- (b) publish statements in the relevant media, including the *China Press and Publication TV Broadcast*

- Newspaper*, to mitigate the negative effects arising from the infringement; and
- (c) compensate Commercial Press for economic losses in the sum of RMB3 million, and for reasonable costs and expenses of more than RMB270,000.

After the court rendered a judgment, the parties reached a settlement on its execution and the judgment came into force.

Held: The Beijing Intellectual Property Court delivered its judgment on December 28, 2017, in which it ordered Sinolingua to immediately cease using the unregistered well-known trademark “Xinhua Dictionary” and to immediately cease the unfair competition practices whereby it used in its design the same or similar “special decoration” as appeared on the famous product *Xinhua Dictionary* (11th edn, Commercial Press), ordered Sinolingua to publish remedial statements in the relevant media and held Sinolingua liable for compensating Commercial Press for its economic loss of RMB3 million, as well as its reasonable costs and expenses in the sum of RMB277,989.20.

Reasoning: In judging the case, the Beijing Intellectual Property Court held that the critical questions were:

- I. whether the name “Xinhua Dictionary” constitutes an unregistered well-known trademark and, if so, whether Sinolingua’s alleged conduct constituted an infringement;
- II. whether the design of *Xinhua Dictionary* (11th edn, Commercial Press) constitutes special packaging and decoration of a famous product under the law, and, if so, whether Sinolingua’s alleged behavior

- constitutes unfair competition; and
- III. if these infringements were confirmed, what legal liabilities Sinolingua should bear.

I. Whether the name “Xinhua Dictionary” constitutes an unregistered well-known trademark and, if so, whether Sinolingua’s alleged conduct constitutes an infringement

(a) *The Court held that the name “Xinhua Dictionary” constitutes an unregistered well-known trademark.* First, “Xinhua Dictionary” has the distinctive features of a trademark. Distinctiveness is a basic attribute that enables a mark to be considered as a trademark. Only marks with distinctive characteristics can be used to distinguish the source of goods and can consequently be registered or protected as trademarks. In this case, “Xinhua Dictionary” has both a specific historical origin and an identifiable evolution. It also has a long-term unique provider and an objectively successful market position. As a product name, “Xinhua Dictionary” maintains the mixed attributes of product and brand, and it has stable recognition among relevant consumers. It is used to indicate both the meaning and the source of the goods, and it has the distinctive characteristics of a trademark. In this case, pursuant to the precedents established in prior civil judgments – (2011) MTZ No. 55 and (2013) MSZ No. 371 – it was confirmed that “Xinhua Dictionary” has the distinctive characteristics of a trademark and can play a role in identifying the source of goods.

Secondly, the Court consequently held that “Xinhua Dictionary” constitutes an unregistered well-known trademark. Judging from the extent of knowledge that the relevant public has of the name “Xinhua Dictionary”, the mark is widely known to the relevant public across

the whole country. Based on the length of time for which Commercial Press has been using the name “Xinhua Dictionary”, the sales volumes it achieves and the extremely extensive reach of those sales, hundreds of millions of copies of its *Xinhua Dictionary* have been sold across the whole country in the past 60 years. Based also on the duration, intensity and geographic coverage of the efforts that Commercial Press has devoted to promoting *Xinhua Dictionary*, the product (and its name) has gained wide influence and high visibility. It can therefore be concluded that “Xinhua Dictionary” constitutes an unregistered well-known trademark.

Finally, Commercial Press can assert its right to the unregistered well-known trademark in the name of “Xinhua Dictionary”. While, at the time when the alleged infringing acts took place, the mark “Xinhua Dictionary” had not been approved for trademark registration, the extent of its familiarity among the relevant public is such that “Xinhua Dictionary” should be protected as an unregistered trademark under the Trademark Law of the People’s Republic of China. Such protection not only honors the power of the mark to identify its source and the extent of the goodwill accumulated as a result of Commercial Press’s efforts in marketing its *Xinhua Dictionary*, but also imposes on Commercial Press the legal obligation of and social liability for assuring product quality. Protecting the rights of the unregistered trademark holder in this way will not jeopardize the spreading of knowledge; rather, to maintain the good brand reputation of “Xinhua Dictionary”, Commercial Press will pay more attention to continuous improvement when publishing and distributing dictionaries marked as such, and will thereby facilitate the extensive spreading of correct knowledge.

(b) The Court held that Sinolingua’s reproduction and imitation of the unregistered well-known trademark “Xinhua Dictionary” in which Commercial Press holds the right is likely to cause confusion, and hence constitute trademark infringement. The products on which Commercial Press and Sinolingua each used the name “Xinhua Dictionary” are dictionaries under Class 16 of the International Classification of Goods and Services for the Purposes of the Registration of Marks (hereinafter the “Nice Classification”), and are identical products. Sinolingua used a completely identical mark to the unregistered well-known trademark “Xinhua Dictionary” in which Commercial Press has rights when publishing its own dictionary, which action constituted using the unregistered well-known trademark by way of reproduction. According to documented evidence, Sinolingua’s use of the mark “Xinhua Dictionary” in its published dictionary products under Class 16 has caused confusion and misunderstanding among consumers attempting to buy and use the dictionary, Sinolingua’s published *Xinhua Dictionary* being readily confused with that published by Commercial Press. In applying the “Xinhua Dictionary” mark to dictionaries under Class 16, Sinolingua’s action therefore constitutes reproduction of a well-known trademark, not registered in China, on the same products as that to which it otherwise applies and is a breach of article 13(2) of the Trademark Law.

II. Whether the design of *Xinhua Dictionary* (11th edn, Commercial Press) constitutes special packaging and decoration of a famous product under the law, and, if so, whether Sinolingua’s alleged behavior constituted unfair competition

(a) The Court held that the design of Xinhua Dictionary (11th edn, Commercial



11th edition single color
(published in June 2011)



11th edition double color
(published in June 2011)



11th edition paperback
(published in June 2011)



11th edition
large-character
(published in
January 2012)



Allegedly
infringing
Version1



Allegedly
infringing
Version2



Allegedly
infringing
Version3



Allegedly
infringing
Version4



Allegedly
infringing
Version5



Allegedly
infringing
Version8



Allegedly
infringing
Version10

(-----First published in July 2012 up to now-----)

(--First published in
February 2014 up to now--)

Press) constitutes special packaging and decoration of a famous product. First, the Court confirmed that *Xinhua Dictionary* (11th edition, Commercial Press) is a famous product. Since its first publication and distribution in June 2011 up to the time at which the allegedly infringing behaviors occurred, *Xinhua Dictionary* has been widely published and distributed across the whole country, and has obtained ever-greater popularity. On the basis of Commercial Press's national publicity and marketing efforts, and the series of honors and important awards won by *Xinhua Dictionary*, the product published by Commercial Press can be confirmed to be a famous product.

Secondly, the design of *Xinhua Dictionary* (11th edn, Commercial Press) can be deemed to be "special decoration" under article 5(2) of the Law of the People's Republic of China against Unfair Competition (as published in 1993). Its design comprises a unique arrangement and combination of elements unrelated to the product's functionalities, forming an overall image that can distinguish it from other publishers' similar products. Because of

Commercial Press's long-term promotion and use of this "special decoration", the design allows the relevant public to identify the product's source; the words, image and colors used in the design, and their specific arrangement and combination, play a role in identifying and distinguishing the specific source of the product as Commercial Press. Therefore, the decoration of *Xinhua Dictionary* (11th edn, Commercial Press) can be defined as "special decoration" as protected under article 5(2).

(b) The Court held that *Sinolingua's* uses of the "special decoration" of *Xinhua Dictionary* (11th edn, Commercial Press) without consent constitutes an act of unfair competition. Commercial Press provided the above images of the two competing products.

Sinolingua published its allegedly infringing product after Commercial Press published its *Xinhua Dictionary* (11th edn) and, as can be seen, the two are similar in terms of cover design, including the title and edition text, the graphic used, and the color and character of the spine. The design of *Sinolingua's* allegedly

infringing product is so similar to that published by Commercial Press in terms of fonts, graphic design, color matching, layout and other overall visual effects that the average consumer paying a standard level of attention might easily be misled into thinking that the source of the two is the same. Indeed, according to documented evidence, the allegedly infringing product has already created confusion among the relevant consumers in the market. Sinolingua's use of the "special decoration" of the famous product *Xinhua Dictionary* (11th edn, Commercial Press) without consent therefore constitutes an act of unfair competition under article 5(2) of the Law of the People's Republic of China against Unfair Competition.

III. If these infringements were confirmed, what legal liabilities Sinolingua should bear

The Court ruled that Sinolingua should immediately cease infringement and publish statements to mitigate the negative effects of its actions, that full support should be given to the claims of Commercial Press for damages of RMB3 million, and that, in addition, Commercial Press should be compensated some RMB277,989.20 for reasonable costs and expenses incurred.

First, in relation to the infringements of which Sinolingua was found guilty, the Court ordered it to immediately cease using the unregistered well-known trademark "Xinhua Dictionary" and prohibited it from using marks identical with or similar to "Xinhua Dictionary" on any dictionary products falling within Class 16 of the Nice Classification. The Court also ordered Sinolingua to immediately cease using any design identical with or similar to the "special decoration" of the famous product *Xinhua Dictionary* (11th edn, Commercial Press)

and to publish statements in relevant media to eliminate the negative effects of its infringement on Commercial Press.

Secondly, in calculating the economic impact on Commercial Press of Sinolingua's alleged infringements, the Court cited statistical information relating to the printing of some of the allegedly infringing dictionaries, as recorded by the Beijing Municipal Bureau of Press, Publication, Radio, Film and Television, the annual average return on net assets for publishing enterprises listed in the mainland in 2014 and the sales revenue of Sinolingua across the whole country, taking into account the nature and intention of its alleged infringements. The Court determined the damages due in the case to be 1.5 times the amount calculated according to these factors, in accordance with article 63(1) of the Trademark Law.

The specific calculation is as follows. During the period from September 30, 2012, to September 30, 2016, Sinolingua profited from publishing the allegedly infringing dictionary in the sum of RMB20,310,160 × 11.29% = RMB2,293,017.064. That amount multiplied by 1.5 would exceed the Commercial Press's claims for compensation of RMB3 million and hence the Court supported in full its claim for compensation of RMB3 million.

Finally, Commercial Press claimed compensation of RMB400,000 for reasonable costs and expenses, and provided some evidence of such expenses incurred during the legal proceedings. Taking into consideration the relevance and necessity of those expenses within the case, the Court assessed reasonable expenses of RMB277,989.20, based on receipts submitted, and rejected the excess amount.

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Chapter 2

Patent cases

A. Verifying the method used to produce the allegedly infringing drug in a method patent infringement dispute

In a dispute over infringement of a pharmaceutical patent relating to the method of manufacture of the drug (a process patent), in the absence of evidence to the contrary, the method filed with the relevant pharmaceutical authority should be presumed to be the genuine method used to produce the allegedly infringing drug. In the event that there is evidence proving that the process filed is *not* the genuine one, then the courts will examine in full evidence including, among other things and in accordance with the law, the technical specifications, documented production procedures, batch manufacturing records and filing documents to determine the actual method of producing the allegedly infringing drug.

In addition to relying on their own appraisal, the courts may comprehensively consider judicial appraisal, or may consult with specialist technical investigators or expert advisors to identify and verify the complicated technical detail involved in manufacturing the allegedly infringing drug.

**ELI LILLY & CO. V. WATSON
PHARMACEUTICALS
(CHANGZHOU) CO., LTD.**
(2015) MSZZ No. 1, SPC

Cause of action:

Dispute over infringement of a patented invention right

Collegial panel members:

Zhou Xiang | Wu Rong | Song Shuhua

Keywords:

infringement of a patented invention right, invention patent for method of manufacturing a drug, scope of protection, technical investigator, verification of the preparation methodology for an allegedly infringing drug

Relevant legal provisions:

Civil Procedure Law of the People's Republic of China (as amended in 2012), articles 78 and 79

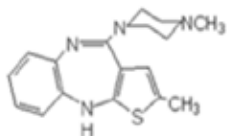
Patent Law of the People's Republic of China (as amended in 2000), articles 56(1), 57(2) and 62(1)

Basic facts: On July 25, 2013, Eli Lilly and Co. (hereinafter "Lilly") filed with the Jiangsu Higher People's Court (hereinafter the "Jiangsu Higher Court") a claim affirming Lilly's right to protection under Patent No. 91103346.7, which registered the invention of a method of preparing the drug olanzapine. When prepared using the patented method, the drug comprised a new product. When Watson Pharmaceuticals (Changzhou) Co., Ltd. (hereinafter "Watson") produced olanzapine using a method of preparation allegedly falling within the scope of Lilly's patent protection and sold it in the market, Lilly claimed that this constituted infringement of its patent right. Lilly consequently asked the court to order Watson to:

- (a) compensate Lilly for its economic losses of RMB151,060,000 and to pay another RMB28,800 in costs, to cover the investigation fee and other reasonable expenses incurred by Lilly, with the aim of deterring further infringement;
- (b) publish a statement on its website and in the journal *Medical Economics* to mitigate the adverse effects of its infringement on Lilly;
- (c) bear Lilly's legal representation costs of RMB1.5 million; and
- (d) to bear all other costs incurred in the case.

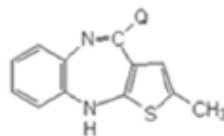
The Jiangsu Higher Court affirmed that the patent involved was Chinese Invention Patent Application No. 91103346.7, entitled "Method to prepare a thieno-benzodiazepines compound", which Lilly Industrial Company of the United Kingdom applied for on April 24, 1991. The patent was granted and published in the Patent Gazette on February 19, 1995, and it expired on April 24, 2011. The name of the patentee was changed to Eli Lilly Ltd of the United Kingdom on March 17, 1998, and then to Eli Lilly and Company on February 28, 2002.

The patent granted involved "a method to prepare 2-methyl-10-(4-methyl-1-piperaziny)-4H-thieno-[2,3,-b][1,5] benzodiazepine, or an acid salt thereof".

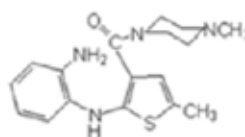


The method specified included:

- (a) "reacting N-methylpiperazine and a compound [as illustrated] in which Q is a radical capable of being split off"; or



- (b) "triggering a ring-closure reaction of a compound [as illustrated]".



In July 2001, Watson and the Institute of Materia Medica of the Chinese Academy of Medical Sciences (hereinafter the "Institute of Medicine") submitted to the State Food and Drug Administration (hereinafter the "SFDA") a new drug application (NDA) for olanzapine and olanzapine tablets. On May 9, 2003, the SFDA issued the Institute of Medicine and Watson with a new drug certificate for olanzapine and olanzapine tablets, and Watson obtained drug registration approval for olanzapine and olanzapine tablets. The method of preparation was recorded, in an NDA document entitled "Research Materials and Literature on the Production Methodology of API [active pharmaceutical ingredient]", as follows:

Add 4-amino-2-methyl-10-benzyl-thieno-benzodiazepines, hydrochloride, methyl piperazine and dimethylformamide, stir to get the crude product, with a yield coefficient of 94.5%; then add 2-methyl-10-benzyl-(4-methyl-1-piperaziny)-4H-thieno-benzodiazepine, glacial acetic acid and hydrochloric acid, stir to get the crude product, with a yield

coefficient of 73.2%; then with two more refinements, the total yield coefficient becomes 39.1%.

Based on analysis of the formula, the process is to react the compound in Formula 4 with methyl piperazine to create the compound in Formula 5, and then to debenzylate the compound in Formula 5 to create the compound in Formula 1. In August 2003, Watson sold its own novel antipsychotic drug “Watson-Olanzapine” to Qingdao Seventh People’s Hospital. As recorded in marketing literature for the product, the main component of the olanzapine tablet is olanzapine, the chemical name of which is 2-methyl-10-(4-methyl-1-piperazinyl)-4H-thieno-benzodiazepines.

In a different case heard before the Jiangsu High Court ((2010) JZ No. 19), the Shanghai Science and Technology Consulting Service Center had issued a technical expert report dated August 25, 2011, in which it stated that the API olanzapine could not be obtained by means of the process described in the “Production Methodology” document that Watson had filed. The expert’s conclusion was that the key reaction step recorded in that document as producing the API olanzapine was inauthentic and that the production methodology filed was not feasible.

After cross-examination in the present case, Lilly accepted the expert report and Watson did not raise any objection to it. Watson did, however, insist that the “two-step” method *could* produce olanzapine, alleging that the expert had failed to replicate it when following the instructions outlined in the “Production Methodology” only because some of the ingredients, which involved trade secrets, were omitted from that document.

Watson argued that it had *not* infringed upon Lilly’s patent right for the following reasons. It asserted that it had been using the filed olanzapine-producing technology since 2003, after the date on which it submitted a supplementary application, which was approved in 2008. The SFDA had approved the filed “Production Methodology” document on September 8, 2010, after evaluating its feasibility. In the absence of Lilly providing any evidence challenging Watson’s production methodology, the method of production for olanzapine that Watson filed in 2008 should be the basis on which infringement should be assessed.

In the “Application Content” column of an Approval Letter on Supplementary Application for Drugs that Watson subsequently submitted to the SFDA on September 8, 2010, Watson indicated that it intended to “1. change the production methodology that may affect the quality of drug; 2. revise the drug registration standard”. In the “Approval Conclusion” column, the Letter concluded:

After review, agree to change the production methodology and revise the quality standard. There is no other change in the production methodology other than with respect to the solvents and reagents used in the preparation method. The original route of synthesis remains unchanged. The quality standard is attached and is valid for 24 months.

In the text of a subsection “5.1.1 Technology Route”, under the heading “5.1 Research Materials and Literature on the Production Methodology of API”, in the “Supplementary and Registration Information for Olanzapine” attached to the 2010 Approval Letter, Watson stated that:

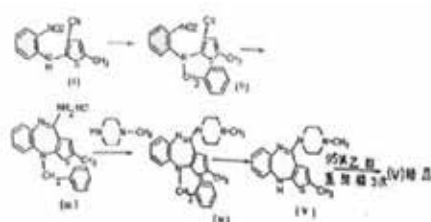
Based on the actual production condition of the API olanzapine, we have made partial adjustment and optimization of the olanzapine preparation methodology without changing the originally reported production route, to further guarantee and improve the quality of olanzapine intermediates and to effectively control relevant impurities during preparation process ... As neither the technology route nor the crystal-solvent used in the last step has been changed, the structure and morphology of the compound will not change.

In a second-instance hearing before the Supreme People's Court aiming to ascertain the technical facts involved in this case, Lilly was allowed to engage an expert advisor to appear on its behalf, in accordance with the provisions of article 79 of the Civil Procedure Law of the People's Republic of China and article 122 of the Interpretation of the Supreme People's Court Concerning the Application of Civil Procedure Law of the People's Republic of China (hereinafter the "Interpretation of Civil Procedure Law"). Watson was allowed to call witnesses to appear in court, in accordance with the provisions under article 117 of the Interpretation of Civil Procedure Law. The member of staff at the Jiangsu Science and Technology Consulting Service Center who issued Technical Validation Report (2014) SJD No. 02 was also called to appear in court, in accordance with the provisions of article 78 of the Civil Procedure Law of the People's Republic of China and article 227 of the Interpretation of Civil Procedure Law. In accordance with the provisions of articles 2 and 10 of the Temporary Provisions of the Supreme People's Court on Several Issues Concerning the Litigation Participation by Technical Investigators in the

Intellectual Property Court, technical investigators were appointed to appear in court for the first time to examine the expert advisor, witnesses and appraiser, as well as the parties, about the relevant technical issues.

On appeal, the Supreme People's Court found that Watson had signed a technology transfer contract with the Institute of Medicine, dated October 28, 1999, pursuant to which the Institute of Medicine transferred its independently developed anti-schizophrenia drug olanzapine and its formulation to Watson. The Institute of Medicine had been responsible for completing the applications for pre-clinical and clinical research approval in Beijing. The acceptance criteria are subject to the standards of approval for new drugs, and the procedure for acceptance involves obtaining both clinical approval documents and new drug certificates. In other words, both parties agreed on the new drug certificate and approval for production.

In its Application Form for Clinical Research of New Drugs (J99) YSLZ No. 82, which the Institute of Medicine completed and submitted in October 1999, the reaction route described in the "Preparation Methodology" column is as illustrated.



On November 9, 1999, the Beijing Municipal Health Bureau issued its Onsite Assessment Report for New Drug Development after receiving the clinical research application for new drugs from

the Institute of Medicine and recorded its conclusion that: “The Institute has the conditions for development of this raw material. The original records and experimental data are basically complete, and the contents are true.”

In June 2001, the Institute of Medicine and Watson jointly submitted an Application Form for New Drug Certificate and Production (2001) JSCZ No. 019. After receiving the application, the Jiangsu Food and Drug Administration (hereinafter the “Jiangsu FDA”) issued its Onsite Assessment Report for New Drug Development on October 22, 2001, recording its conclusion that:

After on-site assessment, the original records of sample preparation and inspection are basically complete, the inspection equipment conditions are basically in place, the research and development unit has no API production workshop at the moment, and is now applying for the new drug certificate for this product.

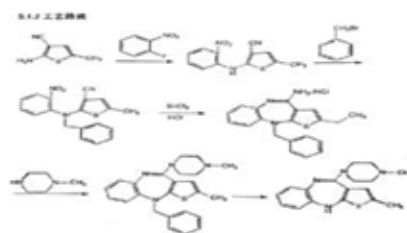
According to Watson’s application, the Jiangsu FDA issued a letter commissioning the Pharmaceutical Safety Supervision Department of Changzhou Food and Drug Administration of Jiangsu Province to inspect Watson’s olanzapine production site and sample the products. After inspection and sampling, the Jiangsu FDA issued an Onsite Inspection Report for Drug Registration and Production (Reference No. CXHB0800159) and recorded, in the “Inspection Result” column, that:

In accordance with the requirements for onsite inspection of drug registration, the first inspection of the production site of this variety is carried out on July 7, 2009. It has been found that the company’s

facilities and personnel, production and inspection facilities meet the production requirements for this variety, its raw and auxiliary materials can be traced back to the source, main raw materials are supplied according to the specified quantity, and the production process is carried out according to the reported process. In accordance with the requirements for onsite inspection of drug registration, an inspection is carried out on August 25, 2009 of the batch manufacturing records, inspection records, raw materials requisition and use, and inventory records for the products of batch Nos. 70309001, 70309002 and 70309003, and samples are taken in accordance with the sampling requirement.

It is recorded in the “Comprehensive Evaluation Conclusion” column that: “According to the comprehensive evaluation, the site inspection conclusion is: Passed.”

In text headed “5.1.2 Technology Route”, in the section “5.1 Research Materials and Literature Materials on the Production Technology of API”, in the “Supplementary and Registration Information for Olanzapine” attached to the Approval Letter on Supplementary Application for Drugs that the Institute of Medicine issued to Watson, the reaction route is described as illustrated.

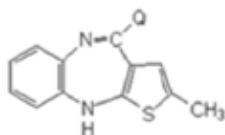


On March 5, 2015, the Jiangsu Science and Technology Consulting Center, as

commissioned by the Shanghai Fangda Law Firm (Beijing), issued its Technical Validation Report (2014) SJZ No. 02, in which it recorded, under the heading “Validation Conclusion”, that:

1. The olanzapine preparation methodology filed by Watson with the SFDA is feasible.
2. By comparing the olanzapine preparation methodology filed by Watson in 2008 with the SFDA, with Lilly’s methodology in patent No. 91103346.7, it is found that the initial materials of both are secondary amine compounds, however, their preparation methodology differs in: 1) the key intermediates produced in the reaction are different; 2) the reaction steps are different: it is a Four-Step Method for Watson and Two-Step Method for Lilly, respectively; 3) the reaction conditions are different: the solvent used by Watson in the substitution reaction is dimethylformamide and that used by Lilly is a mixed solvent composed of dimethyl sulfoxide and methylbenzene.

On appeal to the Supreme People’s Court, Lilly clarified that it sought to protect the patented method (a) in its first claim in the case (that is, “reacting N-methylpiperazine and a compound [as illustrated] in which Q is a radical capable of being split off”).



Held: At first instance, the Jiangsu Higher People’s Court made a civil

ruling on October 14, 2014 ((2013) SMCZ No. 0002), in which it:

- (a) ordered Watson to compensate Lilly RMB3.5 million for its economic loss and other reasonable fees involved, as a method of deterring further infringement; and
- (b) dismissed Lilly’s other claims.

With respect to the court fee of RMB809,744, Lilly was to pay RMB161,950 and Watson was to pay RMB647,794.

Both Lilly and Watson were dissatisfied with the ruling and appealed.

The Supreme People’s Court made a civil ruling in which it reversed the finding at first instance and dismissed Lilly’s claim. The total court fees of the two proceedings were RMB809,744, of which Lilly was ordered to pay RMB323,897 and Watson, RMB1,295,591.

Reasoning: On appeal, the Supreme People’s Court held that it is stipulated under article 7 of the Interpretation of the Supreme People’s Court on Several Issues Concerning the Application of Law in the Trial of Cases of Infringement upon Intellectual Property Rights that:

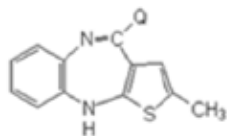
When the People’s Court determines whether the alleged infringing technical solution falls within the scope of patent right protection, all technical features recorded in the claim by the patentee should be reviewed. In the event that the alleged infringing technical solution contains the same or equivalent technical features as those of the claim, the People’s Court shall determine that it falls within the scope of patent right protection; in the event that the alleged infringing

technical solution lacks one or more technical features compared to all of those recorded by the claim, or contains one or more technical features that is (are) not the same or not equivalent with those of the claim, the People's Court shall determine that it does not fall within the scope of patent right protection.

In this case, the allegedly infringing drug produced and sold by Watson was the same as the product prepared by using the patented method involved in the case – that is, both were olanzapine; therefore, the following three questions were to be answered to determine whether the Watson's preparation methodology fell within the scope of Lilly's patent protection.

I. Scope of patent protection

Article 56(1) of the Patent Law of the People's Republic of China provides that: "For the patent right in an invention or a utility model, the scope of protection shall be confined to what is claimed, and the written description and the pictures attached may be used to explain what is claimed." In this case, Lilly required protection of method (a) of the first claim in its process patent (that is, "reacting N-methylpiperazine and a compound [as illustrated] in which Q is a radical capable of being split off").



The claim is drafted in an open-ended manner, in which only the tricyclic reduction, N-methylpiperazine and group participating in the substitution reaction are defined. The scope of

protection covers all methods of preparing olanzapine by using tricyclic reduction and N-methylpiperazine with a substitution reaction with Q, regardless of the materials used to start the reaction, the solvent and the reaction conditions. The key to determining whether Watson's method for preparing olanzapine falls within the scope of Lilly's patent protection lies in comparing the reaction routes in the two technical solutions, while excluding the materials used to start the reaction, the solvent and the reaction conditions from the comparison; otherwise, the scope of the patent protection involved in this case will be reduced improperly, and Lilly's legitimate rights and interests will be damaged.

II. Method of preparing olanzapine that Watson actually used

Article 57(2) of the Patent Law of the People's Republic of China provides that: "If a dispute over patent infringement involves an invention patent for the method of manufacturing a new product, the unit or individual manufacturing the same product shall provide evidence to show that the manufacturing method of their own product is different from the patented method." In the present case, neither party has any objection to the fact that the new product claimed in the process patent is olanzapine; Watson should bear the burden of proving that its method of preparing olanzapine is different from the patented method. Specifically, Watson should provide evidence to prove that the reaction route actually used within its olanzapine preparation methodology does not fall within the scope of protection of the patent right involved. If it fails to do so, Watson will be held liable and its infringement will be affirmed based on its inability to provide evidence otherwise.

In this case, Watson claims that it has in fact been using, since 2003, a methodology to prepare olanzapine that it lodged in a supplementary filing with the SFDA in 2008, and it has submitted as evidence the batch manufacturing records of 2003 and 2008 (Supplementary Evidence #6 at first instance), the production regulations of 2003, 2007 and 2013 (Supplementary Evidence #7 at first instance), and the Approval Letter on Supplementary Application for Drugs (Supplementary Evidence #12 at first instance). As noted above, the key to assessing infringement in this case lies in comparing the reaction routes of the two technical solutions. The reaction route of the process in Watson's 2008 supplementary filing can be seen in the Registration Information on the Supplementary Application for Olanzapine that it submitted to the SFDA, in which the text of "5.1.2 Technology Route", under the heading "5.1 Research Materials and Literature Materials on the Manufacturing Technique of API", outlines the reaction route as being, first, to protect the secondary amino group of "secondary amine compound" with benzyl to produce a "benzyl compound" (benzylation), and then to trigger a ring-closure reaction to produce a "benzyl-substituted thieno-benzodiazepines" tricyclic compound (reduction compound). Next, the amine group of the "reduction compound" is substituted by N-methylpiperazine to produce a "condensation compound" and, finally, the olanzapine is produced through a debenylation reaction.

The Supreme People's Court held that there was documented evidence that could form a complete chain of evidence proving that Watson had been producing olanzapine using the reaction route described in its 2008 supplementary filing since 2003 through to the expiry

date of the patent right involved. The main reasons for the Court's finding are as follows.

First, Watson submitted the supplementary application for registration of olanzapine to the SFDA in the Registration Information on Supplementary Application for Olanzapine, which clearly records the reaction route of the olanzapine preparation methodology. After receiving the supplementary application, the Jiangsu FDA inspected Watson's production site and took samples of the product on July 7 and August 25, 2009, respectively, and it subsequently issued its Onsite Inspection Report for Drug Registration and Productions (Reference No. CXHB0800159), in which it affirmed that Watson's "production process is conducted in accordance with the declared methodology", that three batches of products "were sampled in accordance with the sampling requirements" and that the on-site inspection was "Passed". This means that the process Watson described in its 2008 supplementary filing is feasible, based on the on-site inspection conducted by the Jiangsu FDA. Based on this finding, the SFDA issued to Watson its Approval Letter on Supplementary Application for Drugs, dated September 8, 2010, allowing Watson to "change the production process and revise the quality standard" of olanzapine. Lilly's expert advisor acknowledged the feasibility of the process described in Watson's 2008 supplementary filing at the appeal hearing. The Technical Validation Report (2014) SJZ No. 02 issued by Jiangsu Science and Technology Consulting Service Center also concluded that "Watson's preparation process for olanzapine described in its 2008 filing with the SFDA is feasible". In conclusion,

in the absence of other evidence to the contrary, it should be presumed that the process Watson outlines in its 2008 supplementary filing is the methodology it has in fact used to prepare olanzapine since it obtained the Approval Letter on Supplementary Application for Drugs.

Secondly, the application of a methodology for drug preparation in large-scale industrial production is often cumbersome and complicated, and consequently it cannot be refined overnight. The long-term process of technology accumulation, from research and development through to actual production, usually involves optimizing reaction conditions and operation details based on defects identified during actual production, within the necessary constraints of maintaining the basic stability of the reaction route. Watson's methodology for preparing olanzapine was transferred from the Institute of Medicine according to a technology transfer contract dated October 28, 1999, under which the Institute of Medicine had been responsible for completing the applications for pre-clinical and clinical research approval in Beijing. In its Application Form for Clinical Research of New Drugs (J99) YSLZ No. 82, which the Institute of Medicine filed and submitted in October 1999, the reaction route described in the "Preparation Methodology" column is the same as that described in Watson's 2008 supplementary filing. On November 9, 1999, the Beijing Municipal Health Bureau issued its Onsite Assessment Report for New Drug Development based on the application for clinical research involving a new drug, in which it confirmed that: "The original records and experimental data are basically complete and the contents thereof are true." Based on this affirmation, the Institute of Medicine and Watson jointly

submitted, under the technology transfer contract, the Application Form for New Drug Certificate and Production (2001) JSCZ No. 019. As per the application, the Jiangsu FDA issued its Onsite Assessment Report for New Drug Development on October 22, 2001, confirming that: "The original records of sample preparation and inspection are basically complete." After passing all reviews, including this assessment, the SFDA issued the Institute of Medicine and Watson with a new drug certificate for olanzapine and olanzapine tablets. Thus it can be seen that Watson has consistently used the same olanzapine preparation methodology, with the same reaction route as that stipulated in the 2008 supplementary filing, and had already obtained a new drug certificate by registering for a new drug application. It is therefore unlikely that Watson would have produced olanzapine using a very different preparation methodology at any time before the 2008 supplementary filing.

Finally, it is recorded in the "Approval Conclusion" column of the Approval Letter on Supplementary Application for Drugs that: "The revised production methodology has no other adjustment except with respect to the solvents and reagents used in the preparation methodology on the basis of not changing the original synthetic route." In other words, the SFDA confirmed that the reaction route outlined in Watson's 2008 supplementary filing is the same as that outlined in its earlier submissions. Watson submitted as evidence to the first-instance court its production regulations of 2003, 2007 and 2013, as well as its olanzapine batch manufacturing records of 2003 and 2008. Because Watson claimed that the evidence involved trade secrets, the court of first instance submitted both

parties to closed cross-examination so that it could determine the authenticity and relevance of this claim. On reflection, the court found the olanzapine batch manufacturing records of 2003 and 2008 to be records of actual production conducted in line with the production regulations of 2003 and 2007. Both the production regulations and batch manufacturing records show that the basic reaction route of Watson's olanzapine preparation methodology is the same as that which it filed in its 2008 supplementary filing, with only such minor adjustments and refinements of details such as reaction conditions and solvents as could be made without altering the basic reaction route. Such a process of technology accumulation is in line with the actual method of production.

To sum up, the Supreme People's Court held Watson's 2008 supplementary filing to be authentic and feasible, and affirmed that Watson has been producing olanzapine by means of the reaction route outlined in its supplementary filing of 2008 since 2003 through to the expiry date of the patent right involved.

III. Whether Lilly's claim of infringement could be substantiated

In comparing the reaction route described in Watson's olanzapine preparation methodology with the process patent involved in the case, the Court found the differences between them to lie in the reaction steps and key intermediates. To be more specific, the amine group of the tricyclic reduction that Watson's olanzapine preparation methodology uses is protected by benzyl; thus the benzylation reaction certainly existed before the substitution reaction to produce the benzylated tricyclic reduction and the debenylation reaction step also certainly existed after the substitution reaction to produce

olanzapine. However, there is no benzyl protection for the amine group of tricyclic reduction used in the patented process, and there are no corresponding steps for benzylation and debenylation.

Article 17(2) of Several Provisions of the Supreme People's Court Concerning the Application of Law in the Trial of Cases Involving Patent Disputes provides that:

An equivalent feature is a feature that has the same function and achieves the same effect through the same means as claimed in the patent application or granted patent, according to a person with ordinary skill in the field and without undue experimentation.

In this case, the differences in reaction routes between Watson's olanzapine preparation methodology and the patented process lie, first, in the fact that the intermediate of tricyclic reduction protected by benzyl differs from that of tricyclic reduction without benzyl protection. There are differences in characteristics between the chemical reactions – namely, both the Q group and amine group on the tricyclic reduction intermediate without benzyl protection can react with N-methylpiperazine, while that on the tricyclic reduction intermediate protected by benzyl does not have undesired substitution reactions with N-methylpiperazine. The substitution reaction happens only at the Q group. Correspondingly, there are no steps of benzylation and debenylation before and after the substitution reactions in the methodology of Lilly's patent. There is therefore a big difference between the two technical solutions in terms of reaction intermediates and reaction steps.

Secondly, the final product yield coefficient of Watson's preparation

methodology is reduced by the steps of benzylation and debenylation compared to that of the patented method. There is therefore a big difference between the two technical solutions in terms of technical effects such as yield coefficient.

Lastly, although it is common knowledge in the field of chemical synthesis that imposing benzyl protection for the amine group of tricyclic reduction will reduce adverse reactions, the effect of such a change is substantial. It will change the reaction characteristics of the tricyclic reduction intermediate and the added reaction step will reduce the yield coefficient. Moreover, the common knowledge of imposing benzyl protection indicates only that Watson's preparation methodology is a relatively limited improvement on the patented method involved; it does not mean that the technical means used by Watson and Lilly are basically the same.

In summary, Watson's method of preparing olanzapine differs from Lilly's patented method in terms of whether the intermediates of tricyclic reduction are benzylated intermediates, as well as with respect to the added steps of benzylation and debenylation. The corresponding technical features do not belong to the same technical means. There is a big difference in the technical effects achieved and no equivalent feature has been established. For this reason, Watson's preparation methodology does not fall within the scope of protection afforded by Lilly's process patent.

In conclusion, since Watson's olanzapine preparation methodology does not fall within the scope of protection under Lilly's process patent, the court of first instance erred in its assessment of facts and in the application of law in its judgment, and this decision should be remedied in accordance with the law.

B. Design features and their role in establishing infringement based on similarity of design

Design features comprise innovative content that distinguishes a patented design from prior art and marks the designer's creative contribution to the prior art. If a product is alleged to infringe a patented design, but does not contain all of the design features that differentiate the patented design from prior art, it will generally be presumed that the allegedly infringing design and the patented design are not similar.

The burden of proving the existence of design features falls on the patentee and the burden of rebutting that allegation, on the alleged infringer; whether or not there is patent infringement shall be determined by the Supreme People's Court under law.

JIANLONG V. GROHE
(2015) MTZ No. 23, SPC

Cause of action:

Dispute over infringement of a patented design

Collegial panel members:

Zhou Xiang | Wu Rong | Song Shuhua

Keywords:

assessment of similarity, design features, design patent

Relevant legal provisions:

Patent Law of the People's Republic of China, article 59(2)

Basic facts: Grohe Ag (hereinafter "Grohe") is the patentee of the design patent "handheld shower head No. A4284410X2", which patent was legal and valid at the time of the case. In November 2012, Grohe brought an action against Zhejiang Jianlong Sanitary Ware Co., Ltd. (hereinafter "Jianlong"),

which produces, sells and offers for sale sanitary products, on the ground that Jianlong had infringed Grohe's "handheld shower head" design patent. Grohe asked the court to order that Jianlong immediately stop the infringement, destroy infringing products held in stock and those molds used specifically to produce allegedly infringing products, and compensate Grohe RMB200,000 for its economic loss.

Based on the comparison conducted in the court of first instance, the only similarity between Jianlong's allegedly infringing product and Grohe's design patent was that they are both the same product type. Viewed in their entirety, both designs have a shower head and a handle. Spray from the shower head of the allegedly infringing product is delivered in the same way as that from the involved patent – that is, holes are distributed in a radial pattern in a region that is round on both ends and rectangular in the middle, with arc-shaped edges. The differences, however, were found to be as follows.

- (a) The edges of the shower head of the allegedly infringing product are inclined planes, while the front and left view of the patented shower head design shows that its edges have arc-shaped surfaces.
- (b) Spray from the shower head of the allegedly infringing product is separated from the panel only by a single line, while spray from the shower head of the patented design is separated from the panel by a band made up of two lines.
- (c) The distribution of the holes on the shower head of the allegedly infringing product is slightly different from that of the patented product.
- (d) There is an oblong switch on the handle of the patented design,

while there is no such switch on the allegedly infringing product.

- (e) There is an oblique angle where the head and the handle of the patented product connect, but the angle is so small that it almost appears to be a straight line, while the connecting angle between the head and the handle of the allegedly infringing product is wide.
- (f) The bottom view of the patented design shows that the handle has a round bottom, while the bottom of the allegedly infringing product's handle is a fan-shaped curved surface. The lower end of the handle of the patented design is a cylinder, which gradually turns into an ellipsoid at the point of its connection with the head, while the lower end of the handle of the allegedly infringing product is a fan-shaped cylinder and also presents a fan-shaped cylinder at the point of its connection with the shower head, with an arc-like protuberance in the middle of the handle.
- (g) There is a decorative arc on the bottom of the allegedly infringing product's handle that integrates the bottom of the handle and the back of the product into a whole, while there is no such element on the bottom of the handle of the patented design.
- (h) The proportion of the length between the head and handle of the patented design differs from that of the allegedly infringing product, and the arc-shaped surface at the connection between the head and handle is also different between the two.

Held: On March 5, 2013, the Zhejiang Taizhou Intermediate People's Court rendered a civil judgment and dismissed Grohe's claims ((2012) ZTZMCZ No. 573).

Not accepting the result, Grohe appealed to the Zhejiang Higher People's Court, which delivered its judgment on September 27, 2013 ((2013) ZZZZ No. 255), in which it:

- (a) reversed the judgment of the first-instance court;
- (b) asked Jianlong to immediately stop producing, offering for sale and selling products that infringed Grohe's "handheld shower head" design patent and to destroy any infringing products in stock;
- (c) asked Jianlong to compensate Grohe in the sum of RMB100,000 for its economic loss, including Grohe's reasonable expenses incurred in stopping the infringement; and
- (d) rejected Grohe's other claims.

Jianlong was dissatisfied with the decision and appealed to the Supreme People's Court. On August 11, 2015, the Supreme People's Court delivered its judgment reversing the second-instance judgment and affirming the findings of the court at first instance.

Reasoning: The Supreme People's Court affirmed that the design patent system has been developed to protect aesthetic and innovative industrial designs; as such, a patented design should feature identifiable innovative characteristics distinctive from those of prior art and only those designs that feature such innovative characteristics shall be eligible for protection. These features should be such that they make it easier for ordinary consumers to differentiate patented designs from prior art. They therefore have significant impact on the product's overall visual effect, from the perspective of the design. If an allegedly infringing product does not contain all of the design features that differentiate a patented

design from prior art, it will generally be presumed that the allegedly infringing product does not resemble the patented design.

The patentee may summarize such design features in a brief description or it may explain the design features in another pertinent way when seeking verification of its patent right or pursuing infringement procedures. Whether the patentee bears the burden of proving the infringement or it is judged on the basis of examining relevant documents submitted for the granting and verification of patent rights, the courts' findings regarding these specific design features can be overturned by counter-evidence if any third party raises an objection.

Based on cross-examination of the parties, the Supreme People's Court fully interrogated the evidence and determined the design features of the patented design according to law. It found that the patent in this case has three design features: first, the shape of the shower head and plane transitions; secondly, the shape of the shower head spray; and thirdly, the proportion between the width of the shower head and the handle diameter. Although the allegedly infringing product adopts a runway-shaped spray highly similar to that of the patented design involved in this case, the two have large differences in style in terms of the shape of the shower head and plane transition. The second-instance judgment considered only the design features of the runway-shaped spray, while neglecting others, as well as other distinctive design features that are easily noticeable in normal use of the product. In reaching its conclusion that the two are similar designs based on that assessment, the second-instance court's decision was consequently wrong.

C. Nature of the Markush claim, its amendment in invalidation proceedings and how to assess the “inventive step”

The compound patented under what is known as a Markush claim should be understood as the patent of a general technical solution rather than a patent of a collection of compounds.

A claimant may amend a Markush claim as long as the amendment does not introduce into a claim a new class of compounds, or a single compound, with new properties and effects. However, exceptions to that rule will be considered on a case-by-case basis.

The assessment of the “inventive step” necessary in patenting a compound under a Markush claim should follow the usual method – that is, the “three-step method” stipulated in the Guidelines for Patent Examination published by the National Intellectual Property Administration, PRC (hereinafter “NIPA”).

It is to be noted that “unexpected technical effect” is nothing more than a contributing factor in establishing the inventive step. In usual circumstances, it will *not* be appropriate to skip the three-step method and determine whether or not a patent application involves an inventive step based only on whether it has unexpected technical effect.

PATENT RE-EXAMINATION BOARD V. BEIJING WINSUNNY HARMONY SCIENCE & TECHNOLOGY CO., LTD. AND DAIICHI SANKYO CO., LTD.

(2016) Administrative Retrial No. 41, SPC

Cause of action:

Administrative dispute over invalidation of patent rights in an invention

Collegial panel members:

Qin Yuanming | Li Rong | Ma Xiurong

Keywords:

amendment, invalidation proceeding, inventive step (non-obviousness), Markush claim

Relevant legal provisions:

Patent Law of the People’s Republic of China, article 31(1)

Rules for the Implementation of the Patent Law of the People’s Republic of China, article 34

Basic facts: In the retrial of an administrative dispute over the invalidation of an invention patent under a “Markush claim” between the Patent Re-examination Board of the National Intellectual Property Administration, PRC (hereinafter the “Patent Re-examination Board”) and Beijing Winsunny Harmony Science & Technology Co., Ltd. (hereinafter “Winsunny”), with Daiichi Sankyo Company Ltd. (hereinafter “Daiichi Sankyo”) joined as a third party in the first-instance proceedings, Daiichi Sankyo was the holder of an invention patent No. 97126347.7 entitled “The preparation method of the pharmaceutical composition for the treatment or prevention of hypertension”. The patent claims were written in the form of a Markush claim. Winsunny asked the Patent Re-examination Board to invalidate the patent on the basis that it involved no inventive step.

On August 30, 2010, Daiichi Sankyo made the following amendments to the claim:

- (a) it deleted “or ester” in the phrase “or its salt or ester which can be used for medicinal purposes” in Claim 1;
- (b) it deleted “alkyl with 1 to 6 carbon atoms” under the definition of R4 in Claim 1; and

- (c) it deleted the other technical schemes except carboxyl and Formula COOR5a under the definition of R5 in Claim 1.

During the oral proceedings, the Patent Re-examination Board informed Daiichi Sankyo that the deletion of “or ester” in Claim 1 was approved, but that the other deletions were unacceptable since they did not conform to the relevant provisions under article 68 of the Rules for the Implementation of the Patent Law of the People’s Republic of China. Daiichi Sankyo and Winsunny did not object to this.

On January 14, 2011, Daiichi Sankyo submitted a revised claim for replacement in which “or ester” in Claim 1 was deleted. The Patent Re-examination Board issued Examination Decision No. 16266 on the Request for Invalidation (hereinafter “Decision No. 16266”), in which it decided that Claim 1 of the patent involved in the case was non-obvious as compared to that in Evidence #1, had an inventive step and conformed to article 22(3) of the Patent Law of the People’s Republic of China. Thus, on the basis of the revised version submitted by Daiichi Sankyo on January 14, 2011, the Patent Re-examination Board held that the patent right involved remained valid.

Opposing the decision, Winsunny initiated an administrative case before the Beijing No. 1 Intermediate People’s Court, which ruled that the Patent Re-examination Board had not erred in its application of law when it rejected Daiichi Sankyo’s revised text, as submitted on August 30, 2010, on the ground that it did not comply with article 68 of the Rules for the Implementation of the Patent Law. The court held that Claim 1 of the patent in question is non-obvious as compared

to that in Evidence #1 and involves an inventive step; hence the Court decided to affirm Decision No. 16266.

Winsunny was not satisfied with the ruling and appealed. At second instance, the Beijing Higher People’s Court held that the Markush claim is a special type of parallel technical solution and that the revised text that Daiichi Sankyo submitted on August 30, 2010, narrowed the scope of protection for the patent involved, which complies with article 68(1) of the Rules for the Implementation of the Patent Law. The effect of a specific formulation covered by the claim of the patent involved is equivalent to the technical effect of Formulation #329 of the existing technology in Evidence #1. Claim 1 of the patent involved did not achieve the unexpected technical effect and therefore the second-instance court held that it did not involve the necessary inventive step.

Unhappy with this decision, the Patent Re-examination Board applied for permission to appeal to the Supreme People’s Court.

Held: On April 1, 2011, the Patent Re-examination Board issued Decision No. 16266, in which it affirmed that the patent right involved was valid.

Opposing the decision, Winsunny lodged an appeal with the Beijing No. 1 Intermediate People’s Court, which decided on December 20, 2011, to affirm Decision No. 16266. Winsunny refused to accept the first-instance judgment and appealed to the Beijing Higher People’s Court, asking the court to overturn both the judgment and Decision No. 16266, and to order the Patent Re-examination Board to make a new examination decision. On September 24, 2013, the

second-instance court did indeed decide to overturn the decision at first instance and the Patent Re-examination Board's Decision No. 16266, and to order the Patent Re-examination Board to review the case and arrive at a new examination decision.

Opposing this decision, the Patent Re-examination Board applied for permission to appeal to the Supreme People's Court, which heard the case and delivered its judgment on December 20, 2017, reversing the second-instance decision and affirming that at first instance.

Reasoning: The Supreme People's Court held as follows.

I. Nature of the Markush claim

A Markush claim is a special way of writing a claim in applications for chemical invention patents – that is, any patent application that covers the identification of multiple parallel optional elements in one claim. The way in which a Markush claim is written is designed to solve the problem in the field of chemistry wherein many substituent groups cannot be summarized by a common upper-level concept. It has been considered to be a structural expression rather than a functional expression. The Markush claim requires the definition of parallel optional elements instead of additional claims, where all of its optional compounds have common properties and functions and a common structure, or all of the optional elements belong to the same compound recognized in the domain of the invention. Although the Markush claim is written in a special way, it shall also comply with the requirements of unity expressed in provisions under the Patent Law of the People's Republic of China and the Rules for the Implementation of

the Patent Law of the People's Republic of China. The strength of the Markush claim is its ability to generalize. Once the patent is granted, the scope of patent protection will cover all compounds with the same structure, property or function as that claimed, and the patentee's rights and interests will be maximized. In essence, a patent right is the monopoly on a certain right, which means that the greater the scope of the rights enjoyed by the patentee, the more restrictions to which the public will be subject. For this reason, from the point of view of fairness, the Markush claim shall be interpreted strictly. No matter how many variables and combinations it includes, the Markush claim should be regarded as a general combination solution. The choice of a variable should generate a drug with the same effect, while the choice of different molecular formulas should produce different drugs, but there should not be too much difference in the drug's efficacy and the drugs should be mutually replaceable, and the expected effect should remain the same. That is the reason why the Markush claim was created in the first place. Therefore, the Markush claim should be regarded as a collection of the Markush elements rather than of many compounds. Normally, the Markush elements should be understood as a class of compounds with common properties and functions, which would present themselves as a single compound only under certain circumstances. If it is determined that the compounds expressed under the Markush claim are a collection of many compounds, then the claim is inconsistent with the requirement of unity. It was consequently incorrect for the court of second instance to decide that the Markush claim is a parallel technical solution and its decision should therefore be corrected.

II. Amendment to a Markush claim in invalidation proceedings

The 2010 Guidelines for Patent Examination stipulate that, during the review stage of an invalidation request, any amendment to the new invention and utility patent documents shall be limited to the claims and shall adhere to the following basic principles.

- (a) The title of the original claim shall not be changed.
- (b) The scope of protection of the original patent shall not be extended as compared to the granted claim.
- (c) The technical features shall not go beyond those of the original specification and claim.
- (d) Generally, technical features that are not included in the granted claim shall not be added.

In the present case, however, the method of amendment employed, aside from meeting these principles, was specifically limited to the deletion of a claim, the deletion of a technical solution, the further limitation of a claim and the correction of an obvious error. “Further limitation of a claim” refers to the addition of one or more technical features recorded in other claims, so as to narrow the scope of protection.

It can be seen that, in invalidation proceedings, the amendment of patent documents can be effected in multiple ways. However, there are many special issues in the examination of patent application for chemical inventions, such as the fact that whether a chemical invention can be implemented needs to be confirmed by means of an experiment, that some chemical products need to be defined by means of parameters or preparation methods, and that the discovery of new properties

of and uses for a chemical product do not mean changes in its structure or components. In view of the peculiarity of chemical inventions and given the fact that, in drafting a Markush claim, a patent applicant has had the opportunity to put as many structures and formulas as possible into one claim to obtain the maximum scope of protection, any amendment to a Markush claim at the invalidation stage should be strictly limited in scope. Amendment to the Markush claim shall be allowed only when the amendment will not generate a class of compounds, or a single compound, with new properties and functions; however, individual cases that merit exception should also be duly considered. If a patent applicant or a patentee is allowed simply to delete any option within any variable, then, even if such deletion will narrow the scope of protection and will not impair the rights and interests of the public, there will be such uncertainty in the possible new scope of rights protection that it will undermine the reasonable expectations of the public, as well as jeopardize the stability of the patent rights system. The decisions of the court of second instance in this regard are obviously improper and should be corrected.

III. Method for assessing the inventive step within a Markush claim

Assessment of the inventive step within a Markush claim should follow the basic “three-step method” stipulated in the Guidelines for Patent Examination. Unexpected technical effect is a contributing factor in judging the inventive step: it is a special kind of negative method of judgment and it does not have universal applicability. Thus only when an assessment of non-obviousness cannot be made based on the “three-step method”

should a patent application be judged to involve an inventive step based only on unexpected technical effect. Generally, it would be inappropriate to skip the “three-step method” and directly apply the unexpected technical effect to determine whether or not a patent application involves an inventive step. As for the comparison of technical effects, in this case, the Patent Re-examination Board did not, in the invalidation proceedings, compare Formulations #10, #17, #50 and #69 of Document 1 with those of the patent and base its decision on that comparison; in the court of second instance, a direct comparison and decision was made, which obviously went beyond the scope of the requested review. Such a practice does not conform to the provisions of the Administrative Procedure Law of the People’s Republic of China and relevant judicial interpretations, and should be corrected.

Winsunny, which brought the invalidation proceedings, held that Claim 1 within the patent involved lacked the inventive step and used Evidence #1 as the closest comparative document. When deciding whether Claim 1 involves an inventive step or not, the Patent Re-examination Board and the court of first instance strictly followed the “three-step method”, finding that there are two distinguishing technical features between the compounds of Formula I in Claim 1 and the compounds of Formula I in Evidence #1. After analyzing the non-obviousness of the two distinguishing technical features, they believed that it was justified to declare that Claim 1 involves an inventive step. This Court affirms that finding.

D. Whether product manuals are to be considered “publications”, as defined under the Patent Law

Product operation and maintenance manuals are usually delivered to users only as companions to the products purchased. Neither the product users nor those who come into contact with such manuals have a duty of confidentiality. Such manuals can be accessed by an unspecified public and therefore are to be considered “publications”, as defined under the Patent Law. This means that the technical details recorded in the manuals shall be deemed to be in the public domain from the moment when the manuals are delivered to users.

THYSSENKRUPP AIRPORT SYSTEMS (ZHONGSHAN) CO., LTD. V. CHINA INTERNATIONAL MARINE CONTAINERS (GROUP) LTD., SHENZHEN CIMC TIANDA AIRPORT EQUIPMENT CO., LTD., AND GUANGZHOU BAIYUN INTERNATIONAL AIRPORT CO., LTD.
(2016) ZGFMZ No. 179, SPC

Cause of action:

Dispute over infringement of patent right in an invention

Collegial panel members:

Li Jian | Song Shuhua | Wu Rong

Keywords:

infringement, invention patent, product manual, publication

Relevant legal provisions:

Patent Law of the People’s Republic of China (as amended in 2000), article 22
Patent Law of the People’s Republic of China (as amended in 2008), article 62

Basic facts: In the dispute over infringement of an invention patent between appellant ThyssenKrupp Airport Systems (Zhongshan) Co., Ltd. (hereinafter “ThyssenKrupp Zhongshan”) and respondents China International Marine Containers (Group) Ltd. (hereinafter “CIMC”), Shenzhen CIMC Tianda Airport Equipment Co., Ltd. (hereinafter “Tianda”) and Guangzhou Baiyun International Airport Co., Ltd. (hereinafter “Baiyun Airport”), CIMC was the defendant at first instance and the holder of invention patent No. 200410004652.9, entitled “Supporting Device for Boarding Bridge and Boarding Bridge with the Device and the Control Methodology”. The patent was filed on February 26, 2004, and granted on August 22, 2007, as published in the Gazette. On May 8, 2009, the holder of the patent was changed from CIMC to CIMC and Tianda. CIMC and Tianda filed a lawsuit claiming that the implementation of certain technical schemes by Baiyun Airport and ThyssenKrupp Zhongshan without CIMC’s and Tianda’s permission had infringed upon their patent.

At first instance, ThyssenKrupp Zhongshan made its defenses based on prior art, submitted the testimony of Raymond K. Streat, chief operating director of ThyssenKrupp Zhongshan, and attached supporting documents to support its assertions of prior art. As recorded in the evidence, between October 2000 and March 2001, ThyssenKrupp sent an on-site team to San Francisco International Airport, where it developed a technical solution to eliminate the large amplitude of shaking of the boarding bridge. The solution included installation of a hydraulic stabilizer on both sides of the beam/loading wheel of the boarding bridge, for the purpose of promoting its stability. The

team called it a “cantilever beam design” or “cantilever beam device”. The user accepted and applied the suggestion of a “cantilever beam design” or “cantilever beam device”, and the production and installation work was carried out.

Appendix Y, “Hydraulic Stabilizer”, of the passenger boarding bridge manual (hereinafter “Appendix Y”) was released and delivered to the user after being updated. ThyssenKrupp Zhongshan claimed that Appendix Y proved that it was using a prior technology and not infringing on the patent. At first instance, Guangzhou Municipal Intermediate People’s Court of Guangdong Province held that Appendix Y was an informal publication printed by the affiliated company ThyssenKrupp Zhongshan. If ThyssenKrupp Zhongshan were to fail to prove that its affiliated company had used the technology of a “cantilever beam device”, it would be difficult for the first-instance court to confirm the authenticity of Appendix Y, as well as the time when the manual was printed and delivered to San Francisco International Airport. Because ThyssenKrupp Zhongshan did indeed fail to prove that the “cantilever beam device” technology had been publicized through Appendix Y in 2000–01, the defense concerning prior art was not found to be justified. The first-instance court therefore decided that ThyssenKrupp Zhongshan and Baiyun Airport should cease the act of infringement immediately, as well as that ThyssenKrupp Zhongshan should compensate CIMC and Tianda for their economic losses in the amount of RMB500,000, and it rejected CIMC’s and Tianda’s other claims.

ThyssenKrupp Zhongshan refused to accept the judgment and lodged an appeal. At second instance, the Higher People’s Court of Guangdong Province

dismissed the appeal and affirmed the original judgment.

ThyssenKrupp Zhongshan still refused to accept the ruling and applied to the Supreme People's Court for permission to appeal again. The Supreme People's Court decided to hear the case and, on October 10, 2016, it overturned the judgments at first and second instances, and it rejected CIMC's and Tianda's claims.

Held: On September 24, 2012, Guangzhou Municipal Intermediate People's Court of Guangdong Province delivered its judgment as follows ((2011) SZFMSZ No. 107).

- (a) ThyssenKrupp Zhongshan and Baiyun Airport should cease the infringing act immediately.
- (b) ThyssenKrupp Zhongshan should compensate CIMC and Tianda for their economic losses in the amount of RMB500,000.
- (c) CIMC's and Tianda's other claims were rejected.

ThyssenKrupp Zhongshan refused to accept the judgment and appealed to the Higher People's Court of Guangdong Province. On July 16, 2014, the Higher People's Court of Guangdong Province delivered its judgment, dismissing the appeal and affirming the original judgment ((2013) YGFMSZZ No. 38).

ThyssenKrupp Zhongshan still refused to accept the ruling and applied to the Supreme People's Court for permission to appeal again. The Court delivered its judgment on October 10, 2016, finding that:

- (a) the decision at second instance, of the Higher People's Court of Guangdong Province, was to be overturned;

- (b) the first-instance decision of the Guangzhou Municipal Intermediate People's Court of Guangdong Province was to be overturned; and
- (c) all claims made by CIMC and Tianda were to be rejected.

Reasoning: The Supreme People's Court held that, in this case, ThyssenKrupp Zhongshan had based its defense upon prior art – that is, it argued that because Appendix Y was a publication, the technology it described was available as a prior technology and hence its use did not constitute an infringement upon the patent involved. “Publications” are defined under the Patent Law of the People's Republic of China as independent communication media containing the detail of technologies or designs, the release or publication date of which, as indicated in the publication, can be verified by means of other evidence. Appendix Y, as a product manual for operation and maintenance, had been delivered to users along with the products sold, but neither the users nor those who had contact with it had the duty of confidentiality, which meant that Appendix Y was publicly available and accessible to the unspecified public by such means as photocopying. As a consequence, because Appendix Y was an independent communication medium, containing the technical features of the patented technologies involved, and it was possible to ascertain the time when it was delivered to San Francisco International Airport (that is, the time of public release), it fell into the scope of “publications”, as defined under the Patent Law, and ThyssenKrupp Zhongshan's defense based on prior art as evidenced in Appendix Y had a basis in both fact and law. The defense was therefore to be sustained.

E. Prior agreements between patentee and infringer may be the basis on which damages are calculated in a patent infringement case

Any earlier agreement between the patentee and another party on the sum of damages that shall be due in instances of infringement does not constitute a transactional agreement between them and hence the civil liability of the infringer is confined to liability in tort, which does not fall under the provisions of article 122 of the Contract Law of the People's Republic of China (that is, concurrence of liability in tort and liability for breach of contract).

A prior agreement on the sum of damages for infringement between the two parties is agreement only on the method that shall be used to calculate the damages due in the event of patent infringement, based on the loss incurred by the patentee and/or the proceeds accruing to the infringer.

In the absence of any laws or regulations that render such an agreement invalid, the Supreme People's Court may summarily calculate the damages due in tort to the patentee on the basis of that prior agreement between patentee and infringer.

ZHONGSHAN LONGCHENG DAILY USE PRODUCTS CO., LTD. V. HUBEI TONGBA CHILDREN'S APPLIANCES CO., LTD.

(2013) MTZ No. 116, SPC

Cause of action:

Dispute over infringement of a utility model patent

Collegial panel members:

Wang Chuang | Zhu Li | He Peng

Keywords:

compensation, concurrence, infringement of a utility model patent

Relevant legal provisions:

Contract Law of the People's Republic of China, article 122

Patent Law of the People's Republic of China, article 65(1)

Basic facts: Zhongshan Longcheng Daily Use Products Co., Ltd. (hereinafter "Longcheng") is the patentee of the utility model named "Wheel Alignment Device". In April 2008, Longcheng filed a claim in the Wuhan Intermediate People's Court against Hubei Tongba Children's Appliances Co., Ltd. (hereinafter "Tongba") on grounds of patent infringement, and the court ordered Tongba to cease the infringement and to compensate Longcheng.

Tongba refused to accept the judgment and filed an appeal. At second instance, the parties reached a mediation settlement and Hubei Higher People's Court prepared a civil mediation agreement ([2009] EMSZZ No. 42), the main contents of which included that Tongba should promise not to further infringe Longcheng's patent and that, in the event of any further infringement on the utility model of Longcheng, Tongba should voluntarily indemnify Longcheng in the amount of RMB1 million.

Later, Longcheng found that Tongba was still engaging in business activities that infringed upon Longcheng's patent and hence, in May 2011, it lodged another lawsuit with Wuhan Intermediate People's Court, requesting that the court order Tongba to compensate Longcheng in the amount of RMB1 million and to bear the litigation costs. At first instance in this second case, after hearing

the court's interpretation of the case, Longcheng made it clear that it was lodging this lawsuit on the grounds of patent infringement rather than breach of contract, but it asked the court to calculate the amount of compensation due according to the amount agreed by both parties during mediation. The court held that, in accordance with article 122 of the Contract Law of the People's Republic of China, the injured party should indeed have the right of choice of remedy in the event of simultaneous tort liability and liability for breach of contract. However, because Longcheng expressly chose to lodge the lawsuit for infringement, the amount of compensation would be determined under the Tort Law. If the standard for compensation were subject to the previous mediation agreement, this would conflict with the provisions of article 122 of the Contract Law. Because Longcheng had lodged the lawsuit for infringement, the lawsuit concerning breach of contract could not be included in the court's investigation, and the court need not decide on any breach of contract and consequent liabilities; thus it would have been inappropriate to calculate the amount of compensation due in this instance of breach on the basis agreed by both parties. Instead, the court of first instance applied the statutory standard of compensation and ruled that Tongba should compensate Longcheng RMB140,000.

Longcheng refused to accept this ruling and lodged an appeal. At second instance in this second case, Hubei Higher People's Court held that determination of the rights and liabilities between parties of the case at issue should be based on whether the infringement in fact took place. The allegedly infringing model of baby buggy involved in the previous case was different from the allegedly infringing

model involved in this case and thus the amount of damages agreed in the mediation agreement could not be applied to this case. On this basis, the second-instance court dismissed the appeal and affirmed the finding at first instance.

Longcheng still refused to accept the courts' rulings and applied to the Supreme People's Court for permission to appeal. The Supreme People's Court reheard the case and, on December 7, 2013, it ruled that the first- and second-instance judgments in this second case should be overruled, and that Tongba should compensate Longcheng RMB1 million.

Held: On October 24, 2011, Wuhan Intermediate People's Court delivered its judgment ((2011) WZCZ No. 467), in which it ordered Tongba to compensate Longcheng RMB140,000 and rejected Longcheng's other claims.

Longcheng refused to accept the ruling and instituted an appeal before the Hubei Higher People's Court, asking that it overrule the first-instance judgment and amend it according to law. The second-instance court delivered its judgment on May 11, 2012, dismissing the appeal and affirming the first-instance judgment.

Longcheng still refused to accept the judgments and applied to the Supreme People's Court for permission to appeal. The Supreme People's Court reviewed the case and, on December 7, 2013, it delivered its ruling that the first- and second-instance judgments should be overruled, and that Tongba should compensate Longcheng in the amount of RMB1 million.

Reasoning: On appeal, the Supreme People's Court held as follows.

I. On the effect of the mediation agreement made by both parties in the previous case

The mediation agreement that resulted from the previous case was made by both parties on the basis of free will and its contents concern only the disposal of private rights; they do not involve social public interests and third-party interests. There are no other circumstances under the law that would render the agreement invalid, and the Hubei Higher People's Court delivered the civil mediation agreement after reviewing and confirming the parties' mediation settlement; thus the agreement made by both parties in the previous case should be legally valid.

II. Whether quantum of damages in this case could be based on the calculation agreed in the previous mediation agreement

First, the civil liabilities that Tongba should have borne did not fall within the scope of simultaneous tort liability and liability for breach of contract. The premise for determining such simultaneous liability, as provided under article 122 of the Contract Law of the People's Republic of China, is that "the personal and property rights of the other party are damaged due to breach of contract by one party". According to that provision, the principle in instances of simultaneous tort liability and liability for breach of contract should be based on a transactional relationship between the parties. When one party breaches a contractual obligation and such breach infringes upon the other party's interests, the first party incurs tort liability. The "breach" stipulated in that provision should therefore refer to the fact that one party has violated an obligation agreed in the basic transactional contract, and that the violation simultaneously infringes upon the rights and interests

of the other party, rather than refer to the violation of an agreement concerning the way in which the parties will calculate liabilities for damages after an infringement has taken place. Subject to its contents, the mediation agreement made in the previous case was not a basic transactional contract between Longcheng and Tongba, but an agreement concerning how to apportion liability for damage in the event of infringement (including calculation methods and amount) *after* occurrence of an infringing act. Therefore, in this case, the civil liabilities that Tongba should have borne did not fall within the circumstance of simultaneous tort liability and liability for breach of contract, as stipulated in article 122 of the Contract Law.

Secondly, the civil liabilities that Tongba should assume in this case should be only the liability for infringement. On the one hand, as noted, Longcheng and Tongba were not in a basic contractual relationship; on the other hand, the legal significance and effect of the mediation agreement that resulted from the previous case did not lie in the parties' agreement on the contractual obligations of Tongba, but in their agreement on how to apportion liability for the infringement. Even in the absence of the mediation agreement, Tongba should bear the obligation of non-infringement according to the law. Both parties drafted into the mediation agreement the specific methods of calculating the amount of compensation due in instances of future infringement by Tongba only to specify how Tongba should assume the liability for infringement should it infringe upon the patent yet again.

Thirdly, the Tort Law, Patent Law and other laws do not prohibit the infringed party and infringer from agreeing in advance the method by which they

will apportion liability for infringement and calculate the amount of damages, among other things. The substance of such an agreement is to confirm, in advance, a simple method for calculating and determining the patentee's losses or the infringer's benefits as a result of any future infringement. Considering such factors as the difficulty in furnishing evidence, and the time-consuming and laborious nature of litigation, among other things, both parties concerned can certainly agree on an amount of damages that shall be payable for infringement to the extent of their autonomy under private law, and such an agreement may include both *ex post* remedies for actual infringement and *ex ante* measures to be taken in advance of the occurrence of infringement. The application of the method for determining the amount of compensation to which both parties agreed during mediation in the previous case did not conflict with relevant provisions of article 65 of the Patent Law of the People's Republic of China. In conclusion, the method for determining the amount of compensation as agreed by Longcheng and Tongba in the mediation agreement during the previous case could be applied in this case.

F. Whether notice sent by a victim of patent infringement to a network services provider is effective and whether the provider has taken necessary measures on receipt of such notice

A victim of patent infringement may issue, to a network services provider, a notice evidencing the victim's own identity, their patent certificate, details of the allegedly infringing website and preliminary evidence of the infringement. Such a notice shall be deemed to be valid under the Tort Law of the People's Republic of China if the victim requests that the provider take "necessary measures" after a network user commits an infringing act by means of the network services. Any complaints procedure that the network services provider may have established shall not affect its obligation to legally safeguard the victim's legitimate rights and interests.

Article 36(2) of the Tort Law provides that the "necessary measures" that shall be taken by a network services provider on receipt of such a notice include, but are not limited to, deletion, blocking and disconnection of the infringing web links. In exercising these measures, the provider shall observe the principles of prudence and proportionality, and the courts will assess the adequacy of the measures comprehensively in light of the nature of the infringed right, the specific circumstances of the infringement and the technical conditions.

WEIHAI JIAYIKAO HOME APPLIANCES CO., LTD. V. YONGKANG JINSHIDE INDUSTRY AND TRADE CO., LTD. AND ZHEJIANG TMALL NETWORK CO., LTD.

(2015) ZZZZ No. 186, Zhejiang Higher People's Court

Cause of action:

Dispute over infringement of invention patent

Collegial panel members:

Zhou Ping | Chen Yu | Liu Jing

Keywords:

civil, effective notice, infringement of invention patent, joint and several liability, necessary measures, network services provider

Relevant legal provisions:

Tort Law of the People's Republic of China, article 36

Basic facts: Weihai Jiayikao Home Appliances Co., Ltd. (hereinafter "Jiayikao Company") alleged that, without its agreement, Yongkang Jinshide Industry and Trade Co., Ltd. (hereinafter "Jinshide Company") publicized and sold on Taobao Mall (known as Tmall) and other network platforms products infringing on Jiayikao Company's patent (No. ZL200980000002.8), which actions constituted patent infringement. Because, when Jiayikao Company filed a complaint against Jinshide Company for infringement, Zhejiang Tmall Network Co., Ltd. (hereinafter "Tmall Company") failed to take any effective measures, it was joined as a party to the litigation alongside Jinshide Company. Jiayikao Company asked the court to order that:

- (a) Jinshide Company immediately cease the sale of the allegedly infringing products;

- (b) Jinshide Company immediately destroy any allegedly infringing products held in stock;
- (c) Tmall Company delete all web links to the alleged infringing products on Tmall;
- (d) Jinshide Company and Tmall Company jointly and severally compensate Jiayikao Company in the sum of RMB500,000; and
- (e) Jinshide Company and Tmall Company assume responsibility for the court fees in this case.

Jinshide Company contended that it was only a seller, not a producer, and that the amount of compensation claimed by Jiayikao Company was excessive.

Tmall Company contended that:

- (a) as a trading platform, it was neither the key operator engaged in the production or sale of the allegedly infringing products nor the seller of such products;
- (b) whether the products involved infringed upon the patent involved was uncertain;
- (c) whether the products involved were new (that is, not second-hand) was also uncertain;
- (d) if evidence were to fail to prove that it was the infringing party, there would be no basis in fact or law on which Tmall Company could be jointly and severally liable for compensation of RMB500,000.

Tmall Company added that it had already deleted the links to the allegedly infringing products and that Jiayikao Company's request that all such links be deleted was thus unprovable.

After hearing the evidence, Intermediate People's Court of Jinhua Municipality found that, on January 16, 2009, Jiayikao

Company and its legal representative Li Jinxi jointly filed a patent application for invention of a product entitled “Infrared Heating and Cooking Appliance” with the National Intellectual Property Administration, PRC (hereinafter “NIPA”; on November 5, 2014, the NIPA granted Jiayikao Company and Li Jinxi the patent (No. ZL200980000002.8). Among the claims within the invention patent was:

1. An infrared heating and cooking appliance, which has the following features: this infrared heating and cooking appliance includes: a bracket, in the upper central part, there is an axle hole and on one side, there is a switch for controlling power supply; a rotating disk that is heated once under infrared radiation, serving as a disc-shaped round container for containing food, and there is a removable ledge in the lower central part that may be inserted into the aforesaid axle hole; a holder, which is a longitudinal appliance on one side of the aforesaid bracket; a part of infrared radiation, which is located in the upper end of the aforesaid holder and once powered, it will launch infrared radiation to the aforesaid rotating disk; an oil drip pan, which is located in the aforesaid bracket and can be pulled out from the inner side; and axial oil outlets on the ledge of the aforesaid rotating disk.

On January 26, 2015, the patent was transferred to Jiayikao Company.

On January 29, 2015, Beijing Shangzhuan Law Firm, an agency engaged by Jiayikao Company, filed an application for notarization preserving evidence with Beijing Haicheng Notary Public Office. Under the supervision of the Notary Public Office, agents Wang Yongxian and

Shi Yin logged onto the website of Tmall (www.tmall.com), bought a 3D barbecue (BBQ) grill at a price of RMB388 from an online shop named “Yixinkang Flagship Store” and copied the business license of the operator of this online shop. On February 4, 2015, under the supervision of the Notary Public Office, Shi Yin received an express delivery from “Yixinkang Flagship Store”, which included a 3D BBQ grill packaged in Korean, a gift, a handwritten receipt, and instructions and a warranty card in Chinese. The notary logged the whole process to preserve it as evidence and issued a notary deed ((2015) JHCNMZZ No. 01494). On February 10, 2015, Jiayikao Company commissioned Zhang Yijun, a person not involved in the case, to upload complaint materials, including a report analyzing the patent infringement and comparing the form of technical features, to the intellectual property rights (IPR) protection department of trading platform Taobao, but Taobao did not conclude that the materials were actionable. On May 5, 2015, Tmall Company filed an application with the Qiantang Notary Public Office of Hangzhou City, Zhejiang Province, for notarization preserving evidence. Under the supervision of the Notary Public Office, its agent Diao Manli logged onto the website of Tmall (www.tmall.com) and searched “Yixinkang 3D BBQ Grill; Korean Household; Non-stick Electric Oven; Smoke-free BBQ Machine; Electric Baking Pan; Teppanyaki; Oven” in the “Yixinkang Flagship Store”. No commodity satisfying those conditions was available. The notary logged the whole process to preserve it as evidence and issued a notary deed ((2015) ZHQZNS No. 10879).

In the court at first instance, Jiayikao Company asserted that Claim 1 in the patent involved was to be considered to

be the scope of protection in this case. After comparing the allegedly infringing product with Claim 1, Jiayikao Company argued that all technical features of the allegedly infringing product fell within the scope of protection afforded to it under Claim 1 of the patent, other than the location of the switch, which could be changed by an ordinarily skilled technician in the field without any creative effort and hence was to be considered equivalent to that recorded in Claim 1. Neither Jinshide Company nor Tmall Company raised any objection to the result of this comparison. In addition, the court found that Jiayikao Company had paid a notarization fee of RMB4,000 and a service charge of RMB81,000 to lodge this case.

Held: Jinhua Intermediate People's Court of Zhejiang Province delivered its judgment on August 12, 2015 ((2015) ZJZMCZ No. 148), finding as follows.

- (a) Jinshide Company shall immediately cease the sale of the products infringing the patent (No. ZL200980000002.8).
- (b) Jinshide Company shall compensate Jiayikao Company in the sum of RMB150,000 for its economic loss (including its reasonable expenses incurred in stopping infringement) within ten days after the judgment takes effect.
- (c) Tmall Company shall bear joint liability for RMB50,000 of the amount that Jinshide Company shall compensate as mentioned above.
- (d) All other claims of Jiayikao Company are rejected.

Tmall Company refused to accept the judgment and lodged an appeal. On November 17, 2015, Zhejiang Higher People's Court dismissed the appeal and affirmed the first-instance judgment.

Reasoning: Since the parties to this case raised no objection to the fact that the features of the alleged infringing product fell within the scope of protection recorded in Claim 1 of Jiayikao Company's patent, the first-instance judgment that Jinshide Company's actions constituted patent infringement was correct. As for whether the action of Tmall Company constituted joint infringement, article 36(2) of the Tort Law of the People's Republic of China provides that, where after a network user commits an infringing act by means of network services, the victim of infringement shall have the right to notify the network services provider and ask it to take necessary measures, including, but not limited to, deletion, blocking and disconnection of the infringing web links. If, after being so notified, the network services provider fails to take necessary measures in a timely manner, it shall be jointly and severally liable for any additional harm with the network user. This provision regulates the circumstances in which the complainant sends a "notice" to the network services provider and requires the provider to take necessary measures to prevent additional damage after it finds that a network user has used network services to commit an infringing act. That provision also specifies the scope of the obligations and the structure of the liabilities that the network services provider shall assume under such circumstances. In this case, whether the action of Tmall Company constitutes an infringement shall be determined based on several factors, such as the nature of Tmall Company, the effectiveness of the "notice" sent by Jiayikao Company, whether Tmall Company shall take measures upon receipt of the "notice" from Jiayikao Company, and the necessity and timeliness of the measures taken.

First, Tmall Company is a legal holder of a value-added telecommunication services license and is a network services provider on an information publishing platform. In this case, it provided network services through which “Yixinkang Flagship Store”, operated by Jinshide Company, could sell the allegedly infringing product involved and hence it satisfies the requirements for a network services provider as specified in article 36(2) of the Tort Law.

Secondly, Tmall confirmed at second instance that, on February 10, 2015, Jiayikao Company commissioned Zhang Yijun, a person not involved in the case, to upload to Taobao’s IPR protection platform complaint materials, including the links to the product complained of, and a report analyzing the alleged patent infringement and comparing the form of technical features. Based on these materials, Tmall Company could have found out which product was the subject of the complaint and who the allegedly infringing company (the respondent) was.

Any determination of whether a network services provider is at fault, and whether the provider shall be jointly and severally liable for additional damages caused by the infringement, shall be based on the notice referred to in article 36(2) of the Tort Law. “Notice” refers to a communication that the victim of infringement may send after a network user commits an infringing act by means of network services, in which the victim will require the network services provider to take necessary measures and to prevent further infringement. Such a notice may be oral or written. Generally, it shall include materials such as the identity of the obligee, the ownership certificate, the preliminary evidence of the infringement fact and explicit details of the website of the allegedly

infringing party. If a notice satisfies these requirements, then it shall be deemed effective and valid. The notice sent by Jiayikao Company complies with these requirements as specified in the Tort Law, and hence shall be deemed valid and effective.

Thirdly, upon investigating the complaint, Tmall did not accept the complaint materials of Jiayikao Company as sufficient for action and gave the following reasons in its reply:

Please detail the technical features of the product involved that are covered by the claims in your patent in Table 2 of the Analysis and Comparison Sheet on the Infringement upon the Patent for Utility Model and Invention; a combination of pictures and text is recommended; (Note: the comparison shall be made with pictures and text in the commodity information published by the seller); and you also need to provide the purchase order number or the user name of the parties involved.

On appeal, the court held that assessment of alleged infringement of a patent for an invention or a utility model usually cannot be made on its face or on the basis of written documents, so the complainant generally may be required to provide only materials such as its own identity, the name and number of the patent, details of the allegedly infringing product and details of the alleged infringer, so that those receiving the complaint can inform the accused of its substance. In this case, the complaint materials that Jiayikao Company provided included all of these details. As for the comparison and analysis report, on the one hand, Tmall Company asserts its belief that it had only a limited

ability to judge whether the product sold by the seller infringed the invention patent; on the other hand, it asked Jiayikao Company to “detail the technical features of the product involved that are covered by the claims in your patent”, and suggested that “a combination of pictures and text is recommended”. The court held that, considering the huge number of complaints received and the complexity of online complaints, it was reasonable for Tmall to make this request to fulfil its own interests, and that such details could help Tmall to make a preliminary judgment on the nature of the alleged infringement and to take measures accordingly. Nevertheless, none of the requirements that Tmall Company outlined was essential for the complainant’s “notice” to be valid and effective in law. Moreover, Jiayikao Company had indeed provided, in its complaint materials, a five-page table comparing technical features, including pictures and text, but Tmall Company had nonetheless replied in a rigid, standardized manner and improperly included such a comparison as a reason for failing to act on the complainant’s request. As for criticisms of Tmall Company’s response to the notice and its request that the complainant provide the purchase order number or user name of the parties involved, the court held that whether Jiayikao Company provided those details would not affect the validity and effectiveness of the complaint. Indeed, a company’s own complaint procedures shall not be legally binding upon the complainant, who may safeguard its rights in accordance with law and who could, if it were to be in its own interests to do so, decide not to accept such complaint procedures. Moreover, the complainant need not actually purchase the product involved, but may instead provide other evidence to prove the alleged infringement,

such as other people’s purchases; hence, even if the complainant were to directly purchase the product involved, it may refuse to provide the requested relevant information for the purposes of safeguarding its economic interests or trade secrets.

Lastly, necessary measures that shall be taken by a network services provider upon receipt of a notice, as provided under article 36(2) of the Tort Law, include, but are not limited to, deletion, blockage and disconnection of the web links. “Necessary measures” shall be comprehensively determined according to the nature of the infringed right, the specific circumstances of the infringement and the technical conditions.

In this case, after determining that Jiayikao Company’s complaint was valid and effective, the court needed to judge whether Tmall Company’s handling of the complaint was prudent or reasonable. The court held that this case involved a dispute over infringement of an invention patent. Considering its own subjective judgment on whether or not there was such infringement, as well as the possibility of the complainant being recognized, and the need to balance the interests of the complainant and the respondent, and other factors, Tmall Company, as a provider of an e-commerce network services platform, was not required to immediately delete or block links to the product involved after receipt of the complaint. The taking of necessary measures in relation to the product involved shall comply with the principle of prudence and rationality so as to prevent damage to the lawful rights and interests of the respondent. However, one of the necessary measures that Tmall Company should have taken was to transfer effective

complaint materials to the respondent and require it to defend itself; otherwise, the complaint would be meaningless and the complainant may not be able to safeguard its rights. The network services provider shall ensure the smooth exchange of effective complaint information and shall not simply leave complaints unattended. The respondent may make a judgment on whether its products infringe upon others' rights and whether it will voluntarily stop the alleged infringement, and it should take measures accordingly. However, the respondent did not receive any warning that it ought to do so because Tmall Company failed to perform its obligations and hence additional damage was done. Tmall Company's deletion and blockage of links to the product involved after Jiayikao Company filed a lawsuit is to be deemed prudent and reasonable.

In conclusion, because, after Jiayikao Company issued notice, Tmall Company failed to take necessary measures in a timely manner, the court found that it should, together with Jinshide Company, be jointly and severally liable for any further damages. Tmall Company's grounds of appeal were not found to be established. As for the liability that Tmall Company was to assume, the appeal court found that it was appropriate for the court of first instance to determine that Tmall should be jointly and severally liable for paying RMB50,000 – that is, the amount that Jinshide Company was liable for compensation – based on comprehensive consideration of the duration of the infringement and the time when Tmall Company was made aware of the infringement.

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Chapter 3

Copyright cases

A. Necessary scenes and limited forms of expression in original works based on a historical theme are not protected under the Copyright Law

The main theme and the overall plot structure of any creative work based on a historical theme are within the public domain, which means that such ideas cannot be monopolized by any individual. Any person has the right to create a work based on such a theme.

Whether a work constitutes infringement shall be judged based on aspects such as whether the author of the alleged infringing work has had access to the work of the copyright holder, and whether the allegedly infringing work and the work of the copyright holder demonstrate substantial similarity. In judging the extent of such similarity, the courts shall not compare the ideas, characters, emotions and other things that are common to the historical theme, but rather the expression of those ideas, in terms of the authors' decisions to include or exclude certain historical details, the way in which the work is arranged and whether there are identical or substantially similar design features evident.

In accordance with the provisions of the Copyright Law of the People's Republic of China on the protection of original works, the courts shall protect an author's creative expressions – namely, not their ideas or emotions, but the creative ways in which they have expressed those ideas or emotions. Ideas, materials, information, creative media and necessary scenes that are in the public

domain, as well as forms of expression that are necessarily unique or limited by the historical circumstances, shall *not* be protected.

ZHANG XIAOYAN V. LEI XIANHE, ZHAO QI AND SHANDONG BOOK LOVER AUDIO-VIDEO AND BOOK CO., LTD.

(2013) MSZ No. 1049, SPC

Cause of action:

Copyright dispute

Collegial panel members:

Yu Xiaobai | Luo Dian | Li Rong

Keywords:

copyright infringement, cinematographic and television works, historical themes, substantial similarity

Relevant legal provisions:

Copyright Law of the People's Republic of China, article 2

Regulations on the Implementation of the Copyright Law of the People's Republic of China, article 2

Basic facts: Zhang Xiaoyan alleged that she began to produce and adapt the script for 高原骑兵连 (meaning "The Cavalry Troop on the Plateau") in December 1999. In August 2000, shooting began on a 20-episode television series named 高原骑兵连 (*The Cavalry Troop on the Plateau*), on which filming was completed in December 2000. Zhang Xiaoyan was the copyright holder for the series (hereinafter "Ms. Zhang's screenplay" shall refer to this script and television series). Lei Xianhe participated in the

production of the series *The Cavalry Troop on the Plateau* as honorary producer.

Later, Lei Xianhe was first scriptwriter and producer, and Zhao Qi was second scriptwriter, during filming of the television series 最后的骑兵 (*The Last Cavalryman*) (hereinafter “Mr. Lei’s screenplay” shall refer to this television series and its script).

On July 1, 2009, Zhang Xiaoyan bought a DVD of *The Last Cavalryman* from Shandong Book Lover Audio-Video and Book Co., Ltd. (hereinafter “Shandong Book Company”), and found that it was either identical with or similar to Ms. Zhang’s screenplay in terms of the relationship between the main characters, the storyline and other aspects, and hence she alleged that Mr. Lei’s screenplay infringed on her own. Zhang Xiaoyan therefore applied to the Intermediate People’s Court of Jinan Municipality, asking it to order:

- (a) the three respondents (Lei Xianhe, Zhao Qi and Shandong Book Company) to cease their infringement;
- (b) Lei Xianhe to publish a statement of apology in *Qilu Evening News*; and
- (c) Lei Xianhe to compensate Zhang Xiaoyan for her losses in the form of script remuneration, publication and distribution, as well as for adaptation of the script, in the sum of RMB800,000.

Lei Xianhe argued that the script of Ms. Zhang’s screenplay had been adapted from a full-length novel by Zhang Guanlin, entitled “雪域河源” (meaning *Snow Fields and River Source*), but that he had initially adapted his own screenplay from Shi Yonggang’s full-length novel 天苍茫 (meaning *The Endless Horizon*), as rewritten by Zhao Qi

in the short story 骑马挎枪走天涯 (meaning “Roaming the World on Horseback with a Rifle”). In the first half of 2000, Zhang Xiaoyan had proposed to work with Lei Xianhe on a screenplay reflecting life in the cavalry. Lei Xianhe introduced his adaptation of *The Endless Horizon* to Zhang Xiaoyan and proposed that they make the film together, but Zhang Xiaoyan refused. In August 2000, Lei Xianhe and Zhang Xiaoyan signed a cooperative agreement under which Zhang Xiaoyan was in charge of the shooting and Lei Xianhe was responsible for military security, but did not participate in artistic creation. Lei Xianhe did not see Zhang Xiaoyan’s script. Because Mr. Lei’s screenplay was created and broadcast in different time slots to those of Ms. Zhang’s screenplay, his television series was unlikely to affect the distribution and broadcast of Ms. Zhang’s screenplay.

The court found that Ms. Zhang’s screenplay, Mr. Lei’s screenplay, “Roaming the World on Horseback with a Rifle” and *The Endless Horizon* were four works that centered on military and historical subject matter, and which took the demobilization (or downsizing) of cavalry units during the military’s “streamlining and reorganization” of the mid-1980s as their main storylines. The short story “Roaming the World on Horseback with a Rifle” was published in issue #512 of *Literature and Art of the People’s Liberation Army* (vol. 12, 1996); the full-length novel *The Endless Horizon* was published by the Liberation Army Art Press in April 2001; Ms. Zhang’s screenplay was broadcast on CCTV-8 in a morning slot, between May 17, 2004, and May 21, 2004, at a rate of four episodes a day; Mr. Lei’s screenplay was broadcast on CCTV-1, in a prime-time evening slot, between May 19 and May 29, 2004, at a rate of two episodes a day.

“Roaming the World on Horseback with a Rifle” describes glorious moments in the cavalry’s history, the demobilization of the cavalry, and the obsession of members of the cavalry (especially Cheng Tian, the company commander) with cavalry and war horses, as narrated by the company commander, an instructor and a strong war horse, both before and after the cavalry’s retirement. “Roaming the World on Horseback with a Rifle” includes descriptions of: the mysterious pedigree and origins of the war horse (War Horse No. 15); the harmonious relationship between the company commander and the war horse; the personalities of the instructor Kong Yuehua and the company commander, who writes poems; the father of the company commander, who was a cavalry regiment commander; the important role that the cavalry could play in any future war; the great efforts that the company commander makes to retain the cavalry regiment; the eventual retirement of the cavalry regiment; and the grief of the company commander and war horse at the end of the story. In Mr. Lei’s screenplay, the horse is also mysterious and, other than that the father of Chang Wentian, the company commander, is a division commander, Mr. Lei’s screenplay is basically the same as “Roaming the World on Horseback with a Rifle” in terms of plot and content.

The Endless Horizon is a book centered on the legendary and mysterious history of the last cavalry regiment in the Chinese Army, describing prairie life and the lives of members of the cavalry, such as the emotional relationship between horse and human, and the genetic value of the last wild horse, including characters such as an elder who studies the language of horses and a mysterious prophet, and it tells a story of the last wild horse to win a race in Hong Kong. In *The Endless Horizon*, the father of

company commander Cheng Tian was the division commander of the cavalry, while the regional commander was the first company commander of Shannan Cavalry Regiment and Cheng Tian’s father’s former subordinate. When he was young, Cheng Tian secretly fell in love with the regional commander’s daughter, Lan Jing, but cavalry instructor Wang Qingyi was also in love with Lan Jing, and so Wang stirred up a romance between Cheng Tian and a genetics researcher, Liu Keke. At the end of the novel, Cheng Tian dies when he rescues the researchers, who have become trapped in a marsh. In Mr. Lei’s screenplay, Gao Bo lends the former cavalry instructor’s horse, “Da Lama”, which runs fast and steady, and has a good temper, to company commander Chang Wentian for his temporary use. In the end, the company commander is killed when trying to arrest a suspect. The relationship between the instructor Kong Yuehua and company commander Chang Wentian in Mr. Lei’s screenplay is described in similar terms to those used for the relationship between instructor Wang Qingyi and company commander Cheng Tian in *The Endless Horizon*.

The court commissioned the Copyright Authentication Committee of the Copyright Protection Center of China to conduct a legal comparison of Ms. Zhang’s and Mr. Lei’s screenplays, and the Committee concluded that:

- (a) the two were similar in terms of their setting and the relationships between the main characters;
- (b) the main storylines – that is, of demobilizing (downsizing) the cavalry unit – were similar; and
- (c) the two were the same or similar in some points of plot, but they were expressed in different language other than in one instance, which was basically the same.

That plot point which was expressed in both screenplays in virtually identical ways was the statement of the male lead in each work that he was “willing to be a herdsman”. In the fourth episode of Ms. Zhang’s screenplay, Qin Dongji says: “The green land is my home; treat my horse as my partner; I want to be a herdsman.” In the 18th episode of Mr. Lei’s screenplay, Chang Wentian says: “I treat the green land as my home and my horse as my partner. Have you seen the film *The Herdsman*? I want to be a free herdsman.”

Held: On July 13, 2011, the Intermediate People’s Court of Jinan Municipality, Shandong Province, delivered its judgment ((2010) JMSCZ No. 84), in which it rejected all of Zhang Xiaoyan’s claims.

Unconvinced, Zhang Xiaoyan appealed. On June 14, 2012, the Higher People’s Court of Shandong Province delivered its judgment ((2011) LMSZZ No. 194), in which it dismissed the appeal and affirmed the decision at first instance.

Still unconvinced, Zhang Xiaoyan applied to the Supreme People’s Court for permission to appeal. On November 28, 2014, after reviewing the facts of the case, the Supreme People’s Court, refused Zhang Xiaoyan such permission.

Reasoning: The Supreme People’s Court affirmed that the focus of the dispute in this case is whether the script and television series of Mr. Lei’s screenplay infringed upon the copyright associated with the script and television series of Ms. Zhang’s screenplay.

Whether a work constitutes a copyright infringement shall be judged based on aspects such as whether the author of the allegedly infringing work has had “access” to (been exposed to) the work of the copyright holder, and whether the

alleged infringing work and the work of the copyright holder demonstrate “substantial similarity”. None of the parties in this case disputed the fact that Lei Xianhe had been exposed to Ms. Zhang’s screenplay; the key question in this case was therefore whether there was any substantial similarity between the two works.

The Copyright Law of the People’s Republic of China protects an author’s creative expressions – that is, not their thoughts or emotions as such, but the creative ways in which they have expressed those thoughts or emotions. “Thoughts”, as defined here, include understandings of material existence, objective facts, human emotions and thought processes. Thoughts are objects that a person describes and demonstrates, and they fall within the ambit of subjectivity. “Creativity” is a process that others can perceive and during which the creator illustrates their ideas by recourse to artistic forms, using material media to convert their imagination into image, and to transform something abstract, subjective or intangible into something concrete, objective or tangible. Expressions that are formed creatively and which demonstrate originality are a type of work protected under the Copyright Law. Such protected expressions are found not only in the text, color, lines and symbols that might appear in the final form of a work; when the content of a work manifests the author’s thoughts and emotions, the content is also a type of expression protected under the Copyright Law. However, creative ideas, source material or information that are in the public domain, as well as some forms of creativity, necessary scenes or expressions that are unique or limited are excluded from the scope of protection under the Copyright Law. “Necessary scenes” can be

defined as those events, roles, settings or scenes that are inevitable when telling a particular story or exercising creativity with a particular theme. Such indispensable ways of expressing a particular theme are not protected under the Copyright Law. The term “expressions that are unique or limited” refers to those instances in which a certain thought can be expressed in only one or a limited number of ways. Such expressions are not granted copyright protection. When judging whether there is any substantial similarity between Mr. Lei’s screenplay and Ms. Zhang’s screenplay, comparisons shall be made of the expressions of ideas and emotions in the two works, whether or not such expression is the result of the authors’ choices, and whether the selections, arrangements and designs of the plot, sets, scenes, along with other things expressed in the works, are the same or similar. The courts shall not depart from expressions to look at aspects such as thoughts, emotions, creative ideas and objects as such, among other things.

The Supreme People’s Court based its judgment on analysis of the following aspects, in combination with Zhang Xiaoyan’s claims.

Zhang Xiaoyan claims that the main storylines of both Mr. Lei’s and Ms. Zhang’s screenplays are the same. Because both Mr. Lei’s screenplay and “Roaming the World on Horseback with a Rifle” closely follow the theme and situation of “a hero’s dead end, a cavalryman’s swan song”, and describe stories about “the last cavalryman” before and after demobilization, it can be determined that the main storylines in Mr. Lei’s screenplay, as well as the overall thread and sequence of ideas, are taken from “Roaming the World on Horseback with a Rifle”. Ms. Zhang’s screenplay, Mr. Lei’s screenplay, “Roaming the World on

Horseback with a Rifle” and *The Endless Horizon* are four works that center on military and historical subject matters, and which take as their main focus the demobilization (or downsizing) of cavalry units during the military’s efforts to “streamline and reorganize” in the mid-1980s. This storyline is in the public domain and cannot be monopolized by individuals. Each of the authors of those four works therefore has the right to use, in their own way, the historical subject matter and to create works based on it. Consequently, even if there are some similarities between the main storyline in Mr. Lei’s screenplay and that in Ms. Zhang’s screenplay, because the main storyline is not protected under the Copyright Law and the main storyline in Mr. Lei’s screenplay is taken from “Roaming the World on Horseback with a Rifle”, which was the earliest of the four works published, it cannot be concluded that Mr. Lei’s screenplay plagiarizes Ms. Zhang’s screenplay.

Zhang Xiaoyan also claimed that the main characters and their relationships are the same or similar in Mr. Lei’s screenplay and Ms. Zhang’s screenplay. The Court noted that the four works are all on military subject matter and take the demobilization (or downsizing) of cavalry units during a certain historical period as their main storyline. Other than “Roaming the World on Horseback with a Rifle”, which is limited by its length as a short story and thus does not include any love triangle or relationship between members of the cavalry and civilians, the other three works all cover such main characters and relationships between the main characters, including the love triangle, the superior–subordinate relationships between officers and soldiers, and the relationship between members of the cavalry and civilians. These ways of depicting this subject matter inevitably involve necessary

scenes that cannot be avoided in a work about the military subject matter. Because the means of giving expression to this subject matter are limited, they are not protected under the Copyright Law.

Zhang Xiaoyan claimed too that the verbal expressions and the storylines in Mr. Lei's screenplay and Ms. Zhang's screenplay are the same or similar. In terms of verbal expressions, the phrases "be a free herdsman" in Mr. Lei's screenplay and "be a herdsman" in Ms. Zhang's screenplay are basically the same. However, these verbal expressions are a type of phrase customarily used in a specific context; they are not original expressions. In terms of the storylines, a storyline that is used to manifest an author's thoughts and emotions falls within the ambit of "expressions". A storyline that has originality should be protected under the Copyright Law – but one cannot necessarily draw a conclusion that the storylines are the same or similar just because some elements of the storylines are the same or similar. In this case, the identical or similar parts of the four works largely derive from source material in the public domain or source material that otherwise lacks originality. In some of these parts, only some elements in the storyline are the same, but the specific words and the meanings expressed as the plot unfolds are not the same. The second-instance court held that six plot points were the same or similar in Mr. Lei's and Ms. Zhang's screenplays. Among these points were included those relating to the superior's relationship with a former subordinate and to the assigning of a temporary mount, among other things, and it was noted that similar plot content appears in *The Endless Horizon*. Although the plot structure in other parts of the two screenplays is the same or similar, some of these examples show that only a few elements used in their

expression are the same or similar. The court concluded that those parts of the two screenplays with the same or similar plot content are scarce and insignificant.

Generally speaking, in Mr. Lei's screenplay and Ms. Zhang's screenplay, the specific plot development is different, the focus of depiction is different, the personalities of the lead characters are different and the endings are different. Identical or similar plot points account for only an extremely low proportion in Mr. Lei's screenplay and are of secondary importance in its entire story arc. They do not constitute the main parts of Mr. Lei's screenplay, and will not cause the readers and viewers to have the same or similar experiences in appreciating the two works. The Court therefore cannot draw the conclusion that the two works have any substantial similarity. Article 15 of the Interpretation of the Supreme People's Court on Several Issues Concerning the Application of Law in the Adjudication of Copyright Civil Disputes provides that where works on the same subject matter are created by different authors, and the expression of each work is completed independently and has originality, the courts should determine that each author enjoys independent copyrights. The Court consequently held that Mr. Lei's screenplay and Ms. Zhang's screenplay were works on the same subject matter created independently by different authors. Both series have originality and each author enjoys independent copyright.

B. Expressions independently created and demonstrating originality in a derivative folk literary or artistic work shall be protected under the Copyright Law

Where a derivative folk literary or artistic work has been independently created and demonstrates originality, and it evidences in its expression the characteristics of a work protected under the Copyright Law, its author shall be deemed to be eligible to hold copyright in that part which demonstrates originality.

HONG FUYUAN AND DENG CHUNXIANG V. GUIZHOU WUFUFANG FOOD CO., LTD. AND GUIZHOU JINCAI NATIONAL CULTURE RESEARCH & DEVELOPMENT CO., LTD.

(2015) ZZMCZ No. 17, Guiyang Intermediate People's Court of Guizhou Province

Cause of action:

Dispute over copyright infringement

Collegial panel members:

Tang Youlin | Liu Yongju | Yuan Bowen

Keywords:

copyright infringement, derivative folk literary or artistic work, originality

Relevant legal provisions:

Copyright Law of the People's Republic of China, article 3
Regulations on the Implementation of the Copyright Law of the People's Republic of China, article 2

Basic facts: Hong Fuyuan and Deng Chunxiang claimed that the work created by Hong Fuyuan, "Harmonious

Coexistence XII", first appeared in the book *Fuyuan's Batik Arts*, published by Guizhou People's Publishing House, in August 2009. Hong Fuyuan had once transferred the right to exploit the work involved (excluding the right to use it on batik) to Deng Chunxiang, who was responsible for maintaining the copyright-related property rights. Without Hong Fuyuan's and Deng Chunxiang's permission, Guizhou Wufufang Food Co., Ltd. (hereinafter "Wufufang Company") used, for promotional purposes on commodities it sold, a selective part of Hong Fuyuan's work. Hong Fuyuan and Deng Chunxiang believed that Wufufang Company had infringed upon Hong Fuyuan's copyright and the copyright-related property right of Deng Chunxiang, and they asked the Intermediate People's Court of Guiyang City to order Wufufang Company to:

- (a) pay Deng Chunxiang RMB200,000 as compensation for the economic loss caused by its infringement upon her copyright-related property right;
- (b) cease using the pattern involved, and destroy any packaging and product brochures featuring the infringing image; and
- (c) publish a formal apology for its infringement upon Hong Fuyuan's copyright-related personal right.

Wufufang Company contended, first, that both the work in which the claimants asserted copyright in the action they filed and some patterns on the packaging of products designed for Wufufang Company by Guizhou Jincai National Culture Research & Development Co., Ltd. (hereinafter "Jincai Company") used the traditional batik patterns of the Gejia people in Huangping County of Guizhou Province, and that this meant that Wufufang Company's use of the relevant design in its product packaging did not constitute an infringement.

Secondly, Wufufang Company affirmed that a third party, Jincai Company, had designed the packaging of Wufufang Company's products and that the latter had exercised due care when using such packaging.

Thirdly, the image involved was placed in the lower right-hand corner of the product packaging and the area covered accounted for only about 1/20 of the total area, which meant that the image had little effect in promoting product sales and that the amount of compensation that Hong Fuyuan and Deng Chunxiang claimed (RMB200,000) was excessively high. Therefore, argued Wufufang Company, the claims against it had no basis in fact or law, and the court should dismiss the claims.

Jincai Company, the third party joined to the case, stated that it had engaged in advertising design and planning for Wufufang Company, and had completed the sketch of a pattern it called "Best Wishes for Four Seasons" in December 2006. The pattern was not used until October 2011, when Wufufang Company selected a part of the pattern for use when developing gifts for the tourism market. The bird pattern, Ru-Yi pattern and the copper drum pattern in the design all originated in the "primary form" of the batik of the Gejia people in Huangping County of Guizhou Province; the design of the bird pattern in Hong Fuyuan's work also originated in the traditional batik of Guizhou Province. Hong Fuyuan's work was therefore found not to be original and there was no factual basis for a finding of infringement in this case. The court dismissed Hong Fuyuan's and Deng Chunxiang's claims.

The court found that Hong Fuyuan had been engaged in the artistic design and creation of batik for many years, and that

he had been awarded such honors as being named one of "China's Top Ten Folk Artists" and an "Advanced Individual of Intangible Cultural Heritage Protection" by the Ministry of Culture. The work "Harmonious Coexistence XII", which he created in August 2009, had been published in the book *Fuyuan's Batik Arts* by Guizhou People's Publishing House. This work used the characteristics of natural patterns and geometrical patterns of the traditional batik arts as its reference and indigo as its main color, and it illustrated a harmonious environment in which flowers and birds coexisted. However, the outlines of birds were supplemented in this work. The lines of the birds' eyes and mouths were enriched, which made the patterns of the birds more vivid. Hong Fuyuan's original ideas were integrated into the necks and feathers of birds, which made the patterns of the birds livelier. Hong Fuyuan's creative ideas were also integrated into the copper drum patterns in the middle, which were different from the patterns found in traditional batik arts. On August 1, 2010, Hong Fuyuan and Deng Chunxiang entered into a contract under which Hong Fuyuan transferred the right to use the work involved (excluding its use on batik) to Deng Chunxiang and Deng Chunxiang was responsible for maintaining the copyright-related property rights in the work involved within the scope of the rights transferred.

Wufufang Company authorized a third party, Jincai Company, to provide it with planning and design services for the branding of its products, including product packaging and supporting designs, product brochures and marketing materials. According to the design services that Jincai Company provided, Wufufang Company used the batik flower and bird patterns, as well as a frame of Ru-Yi patterns, on the

upper left-hand and lower right-hand corners of the packaging of its products Guizhou Peppery Chicken, Guizhou Millet Dreg and Guizhou Dried Pork. Hong Fuyuan believed that Wufufang Company's use of his work, "Harmonious Coexistence XII", infringed upon his right of authorship, which split the connection between the author and the work, and infringed upon the property rights in the work enjoyed by Deng Chunxiang. It was found, upon comparison, that the design of the batik flowers and birds used on the packaging and product brochures of Wufufang Company's three products were identical with "Harmonious Coexistence XII", the work created by Hong Fuyuan, in terms of the pattern structure of the birds and flowers, as well as the choice and arrangement of the lines. Indeed, they were different only in terms of the color of the background to the pattern and the color of lines.

Held: On September 18, 2015, the Intermediate People's Court of Guiyang City, Guizhou Province, delivered its judgment, holding as follows.

- (a) Wufufang Company should, within 10 days of the judgment coming into force, pay Deng Chunxiang RMB100,000 as compensation for her economic loss.
- (b) After the judgment comes into force, Wufufang Company should immediately cease to use the work "Harmonious Coexistence XII".
- (c) Within five days of the judgment coming into force, Wufufang Company should destroy the packaging and product brochures of the products involved, including Guizhou Peppery Chicken, Guizhou Millet Dreg and Guizhou Dried Pork.
- (d) Hong Fuyuan's and Deng Chunxiang's other claims should be dismissed.

After the judgment at first instance was pronounced, none of the parties appealed and the judgment came into force.

Reasoning: In its effective judgment, the court held that the main issues in this case were:

- (a) whether the work "Harmonious Coexistence XII" was protected under the Copyright Law;
- (b) whether the patterns on the product packaging involved infringed upon Hong Fuyuan's copyright;
- (c) how to identify the parties responsible;
- (d) how to determine the apportionment of liability for infringement; and
- (e) how to calculate the amount of compensation due.

In relation to the first issue, the tails of the two birds in the work "Harmonious Coexistence XII", created by Hong Fuyuan, overlapped each other and, in the middle, copper drum patterns were used as a connecting motif demonstrating the beauty of symmetry, reflecting the characteristics of natural patterns and geometrical patterns found in the traditional batik arts. Based on the evidence submitted of this case, it could be determined that the work involved used the forms of expression found in the traditional batik arts and that the creative inspiration directly originated in the batik patterns of the Gejia people in Huangping County. However, the outlines of the birds were supplemented in the work involved. The lines of the birds' eyes and mouths were enriched, and the author integrated his original creation into the necks and feathers of birds, making the patterns of birds livelier and more vivid. Hong Fuyuan's own ideas were also integrated into the copper drum patterns in the

center of the work, which were different from patterns found in traditional batik arts. Article 2 of the Regulations on the Implementation of the Copyright Law of the People's Republic of China provides that: "The term 'work' as referred to in the Copyright Law means intellectual creations with originality in the literary, artistic or scientific domain, insofar as they can be reproduced in a tangible form." The work involved, "Harmonious Coexistence XII", was created by the claimant Hong Fuyuan and is a derivative work of traditional batik art. While it demonstrates the heritage and innovation found in traditional batik art, it also exhibits the characteristics of works protected under the Copyright Law, and therefore is protected under the law to the extent that it exhibits Hong Fuyuan's originality.

As to the second issue, according to article 4(9) of the Regulations on the Implementation of the Copyright Law: "'Works of fine art' means two- or three-dimensional works of the plastic arts created in lines, colors or other media which impart esthetic effects, such as paintings, works of calligraphy and sculptures." "Paintings" are two-dimensional artistic works of the plastic arts created using lines and colors, among other things, which impart aesthetic effects. It was found, upon comparison during the case, that the pattern of flowers and birds used on the packaging of and the product brochures for products such as Guizhou Peppery Chicken were consistent with the work at issue, "Harmonious Coexistence XII", in terms of the pattern structure of the birds and flowers, as well as the choice and arrangement of lines, and that they differed only in terms of the background color of the pattern and the color of the lines. Based on the results of this comparison, the court

held that these differences were only a way of concealing the infringement, not intellectual work with originality. The third party Jincai Company alleged that it created in 2006 the works that Wufufang Company then used on packaging and product brochures, but Jincai Company failed to provide any evidence to prove that fact. Meanwhile, Hong Fuyuan could prove that he published the work involved in the book *Fuyuan's Batik Arts* in 2009 and it was indicated in the book that the painting was created in 2003. It could therefore be determined that Hong Fuyuan's works involved in this case were the first to be created and published. Before Wufufang Company produced and sold the products involved, Hong Fuyuan had published the work "Harmonious Coexistence XII", so Wufufang Company was likely to have been exposed to the work. Accordingly, it could also be determined that the third party Jincai Company was intentionally plagiarizing Hong Fuyuan's works. Partial use by Wufufang Company of the claimant's works on packaging and product brochures when producing and selling the products involved infringed upon the right of reproduction enjoyed by Hong Fuyuan to the works of painting involved in the case.

With reference to the third issue in the case, the court asked Hong Fuyuan during pre-trial preparation whether he wanted to join Jincai Company as a defendant in the case and whether he wanted to change the claims. Hong Fuyuan refused, in writing, to join Jincai Company as a defendant, stating a belief that the legal relationship between Wufufang Company and Jincai Company was such that it would be improper for him to join the latter as a party to the case. In fact, Wufufang Company and Jincai Company had signed a contract under which Jincai Company would

design the packaging, advertising copy and promotional materials for all of Wufufang Company's products. The contract also stipulated that, should the design contents submitted by Jincai Company be found to be infringing copyright, Jincai Company should bear the consequences in full. In this case, however, Wufufang Company failed to provide evidence proving that it had exercised due care as a client. Wufufang Company was also the final user and actual beneficiary of the infringing works. Article 48(2)(i) of the Copyright Law provides that:

Any one who commits any of the following acts of infringement shall, depending on the circumstances, bear civil liabilities such as ceasing the infringement, eliminating the bad effects of the act, making an apology or paying compensation for damages:

- (i) reproducing, distributing, performing, presenting, broadcasting, compiling a work or making it available to the public through information network, without permission of the copyright owner, except where otherwise provided for in this Law
- ...

Under both this provision and articles 19 and 20(2) of the Interpretation of the Supreme People's Court Concerning the Application of Laws in the Trial of Civil Disputes over Copyright (hereinafter the "Interpretation Concerning Civil Disputes over Copyright"), Wufufang Company was to bear the civil liability for infringement in this case according to law. The legal relationship between Wufufang Company and Jincai Company was not covered by this case, and the parties may make a separate settlement.

As to the fourth issue, according to the provisions of articles 47 and 48 of the Copyright Law, if a copyright or copyright-related right is infringed, depending on facts of the case, the infringer shall bear civil liabilities such as ceasing the infringement, mitigating the bad effects of the act, issuing an apology or paying compensation for damages. In this case, the court found the following.

- (a) Hong Fuyuan's and Deng Chunxiang's copyright-related personal rights and property rights were infringed, objectively causing them economic loss, and hence their first claim for compensation of loss should be upheld by law.
- (b) Whether Wufufang Company was at fault or not, it was ordered to immediately cease its actions infringing the copyright of others so as to protect the right holder's legitimate rights and interests, to avoid further loss to the claimants and to enforce the law. The court sustained Hong Fuyuan's and Deng Chunxiang's request that Wufufang Company be ordered to cease using the patterns involved, and to destroy the packaging and product brochures involved.
- (c) Because there was no subjective intention and gross negligence on the part of Wufufang Company, which was liable for infringement according to law only because of its failure to exercise due care, and because Hong Fuyuan failed to submit evidence proving that the infringing act had resulted in damage to his reputation, the court rejected his third request – that is, that Wufufang Company be ordered to publish a formal apology in *Guizhou City News*.

In relation to the fifth issue in this case, neither Hong Fuyuan nor Deng Chunxiang claimed for or submitted evidence of their reasonable expenses incurred in the action to deter the infringing act. During the course of the case, they did not submit evidence proving the amount of actual losses that they had suffered or of Wufufang Company's illegal gains. In fact, it was difficult to determine either. According to article 25(1) and (2) of the Interpretation Concerning Civil Disputes over Copyright:

In case the actual losses of the copyright owners or the illegitimate revenues of the infringing party cannot be determined, the People's Court shall determine the amount of compensations as per the request of the parties concerned or according to the provisions of Article 48(2) of the Copyright Law (i.e. the current Article 49(2)) at their discretion within their powers. When determining the amount of compensations, the People's Court shall comprehensively consider the work type, reasonable usage fee, nature of infringing acts, results, and other relevant circumstances.

Taking into consideration the objective facts of this case, there were five main factors to be considered that had an impact on the amount of compensation due in this instance of copyright infringement, as follows.

(a) The work involved – that is, Hong Fuyuan's "Harmonious Coexistence XII" – is a derivative work based on traditional batik art originating in Guizhou Province. The creation of the copyrighted work built on the heritage and innovation demonstrated in traditional batik art,

and both the outline of bird patterns and the beauty of symmetry showed in the work involved originated from traditional artistic works. The innovation evident in the author's work was limited and the room for innovation was also limited.

- (b) Batik art in Guizhou Province featured certain regional characteristics and geographically significant features. In a sense, the artistic works in batik based on flowers, birds, insects and fish, among other things, belonged to elements and symbols of Guizhou Province. As a company local to Guizhou Province, Wufufang Company used the artistic works in batik of Guizhou Province in a manner conforming to the basic national and regional characteristics inherent in folk literary art works as intangible cultural heritage.
- (c) According to the contract transferring the right to exploit the work between Hong Fuyuan and Deng Chunxiang, Hong Fuyuan had transferred the right to exploit his work "Harmonious Coexistence XII" (excluding its use on batik) to Deng Chunxiang – that is, a large part of the copyright-related property rights of the work involved was transferred to Deng Chunxiang, who was not an heir to the traditional folk art. Deng Chunxiang was responsible for maintaining the copyright-related property rights of the work involved. Considering that the personal right and property right of the work at issue belonged to subjects who were, respectively, within and outside of the range of those entitled to inherit the traditional folk art, the consequences and impact of the corporate infringement of that heritage were insignificant.

- (d) Hong Fuyuan had devoted himself to the exploration and pursuit of national batik art for several decades, and he integrated traditional batik art and Chinese ancient culture into his creations, elevating batik art to a certain degree and driving regional cultural development. Although a large part of the copyright-related property rights in the work involved was transferred to Deng Chunxiang, who was not an heir to the traditional folk art, Hong Fuyuan's creative value and his reputation in the field of batik art should be respected.
- (e) The scale of production and the sales channels of the Wufufang Company products involved – Guizhou Peppery Chicken, Guizhou Millet Dreg and Guizhou Dried Pork – should be taken into account. Under a purchase contract between Wufufang Company and Guangzhou Zhuofan Color Printing Co., Ltd., submitted by Wufufang Company, although all of the evidence might not fully and objectively reflect the scale of production and operations concerning the products involved, Wufufang Company's claims should be reasonably admitted under law in the absence of the claimants submitting any contrary evidence.

Upon comprehensive consideration of all of these factors, and based on the current economic development level of and living standards within Guizhou Province, a discretionary decision was made that Wufufang Company should compensate Deng Chunxiang in the sum of RMB100,000 for her economic loss.

C. Nature of letters and manuscripts, auction of letters and manuscripts, and preliminary injunctions in a copyright dispute

Private letters, as expressions of human feelings and the exchange of ideas, are usually written works independently conceived and created by the sender, and hence shall be deemed to be works authored by the sender. In the absence of evidence to the contrary, private letters shall be protected under the Copyright Law of the People's Republic of China.

Although the party to whom the letter is sent has obtained a real right to the letters and manuscripts, that right shall be exercised in a manner that does not infringe upon the sender's copyright. The publication of such letters and manuscripts against the will of the copyright holder (the sender) or any of their heirs constitutes an infringement upon the sender's copyright.

In general, infringement relating to the personal rights of copyright would result in personal and emotional harm. Because such emotional harm is irreversible, it is difficult to remedy by means of monetary or non-monetary compensation. In addition, the right of the copyright holder to control publication of their work is the basis underpinning the exercise and protection of other related rights. Once a work is published against an author's will, that publication might also strip the author of the right to control reproduction and distribution of the work. As a consequence, should a party disregard the author's objection to exhibition of the work in public and thereby infringe upon the author's copyright, the courts will grant a preliminary injunction against the infringing party on the basis that "failure in timely deterrence of such infringement will

cause irreparable harm to the right holder” (article 101 of the Civil Procedure Law).

YANG JIKANG V. SUNGARI INTERNATIONAL AUCTION CO., LTD.
(2013) EZBZ No. 09727, Beijing No. 2 Intermediate People’s Court

Cause of action:

Dispute over preliminary injunction in a copyright infringement

Collegial panel members:

Zhang Jian | Yang Jing | Liu Juan

Keywords:

auction, copyright, letters, real right, pre-action injunction, privacy right

Relevant legal provisions:

Civil Procedure Law of the People’s Republic of China (as amended in 2012), articles 100, 101 and 108

Copyright Law of the People’s Republic of China, articles 10(1)(i), 19(1), 21(1) and 50

Law of Succession of the People’s Republic of China, articles 10 and 11
Regulations on the Implementation of the Copyright Law of the People’s Republic of China, article 17

Interpretation of the Supreme People’s Court Concerning the Application of Laws in the Trial of Civil Disputes over Copyright, article 30(2)

Basic facts: Yang Jikang (a famous writer and translator under the pen name “Yang Jiang”) is the widow of Qian Zhongshu (a famous writer and researcher in the field of literature), and they had a daughter named Qian Yuan (deceased). Li Guoqiang is the former editor-in-chief of a monthly journal named *Wide Angle*. After Qian Zhongshu and Li Guoqiang first became acquainted in 1979, Li became a close friend to

Qian Zhongshu, Yang Jikang and their daughter, Qian Yuan, and they wrote to each other frequently. Li Guoqiang had kept these letters.

In May 2013, Sungari International Auction Co., Ltd. (hereinafter “Sungari”), a comprehensive auction company, announced on its official website that it would be holding a public auction of “Collection, Letters and Manuscripts of Qian Zhongshu” on June 21, 2013, which would include more than 100 letters and manuscripts sent by Qian Zhongshu, Yang Jikang and Qian Yuan to Li Guoqiang. Before the auction, pre-auction exhibitions and seminars would also be held. Several media outlets, such as Xinhua Net and People.cn, reported on the upcoming auction, declaring that the event would “reveal a large number of manuscripts of Qian Zhongshu for the first time” and publishing in their reports a small number of manuscript images that Sungari had made public. Through investigation, it was found that the letters and manuscripts involved were mainly obtained from Li Guoqiang, their content covering private communications, household affairs, personal emotions, literary reviews, historic reviews, running commentary and other private issues that had never been made known to the public.

Yang Jikang strongly opposed the public auction and exhibition of the private letters and manuscripts, and she applied to the Beijing No. 2 Intermediate People’s Court for a preliminary injunction to stop the sale as an act of copyright infringement. Qian Yuan and Qian Zhongshu had fallen ill and died in 1997 and 1998, respectively. Yang Jikang was their heir. Another heir, Qian Yuan’s husband, Yang Weicheng, supported Yang Jikang’s claims.

During the course of the case, a third party, Tsinghua Unigroup Co., Ltd., issued a legitimate and valid statement, together with relevant materials, guaranteeing that it would cover all economic losses that the respondent might incur should the claimant fail to win the case.

Held: The Beijing No. 2 Intermediate People's Court ruled that Sungari should cease any act infringing the copyright held in the letters and manuscripts involved, sent from Qian Zhongshu, Yang Jikang and Qian Yuan to Li Guoqiang – that is, the auction, exhibitions and any publicity activity involving the publication, exhibition, reproduction, distribution or dissemination via information networks of the letters and manuscripts.

The ruling was to be immediately executed after service. In the event that any party was dissatisfied with the ruling, it was to apply to the court for review within 10 days of receipt of the ruling. The execution of the ruling was not to be suspended during any period of review.

Reasoning: In this case, the Beijing No. 2 Intermediate People's Court held as follows.

An order that pre-trial behavior cease is also known as a preliminary injunction, which is a compulsory order granted by courts, before trial and upon the request of one party, to promptly prohibit or limit a certain act of another party that does or is likely to infringe upon the intellectual property rights (IPR) of the rights holder. It aims to protect holders from further infringement of the rights and to prevent irreparable damage being done.

There are four main requirements for granting a preliminary injunction:

- (a) the applicant must be the holder of the IPR and the respondent must be engaging, or be about to engage, in an act that constitutes an infringement of those IPR;
- (b) failure to deter such infringement promptly must be likely to cause irreparable harm to the right holder;
- (c) the applicant must have provided a valid guarantee (should their case not be upheld and the respondent be granted permission to resume the act at issue); and
- (d) the granting of the preliminary injunction must not be detrimental to the public interest.

I. Letters and manuscripts are works protected by the Copyright Law

The term “works”, as referred to in the Copyright Law of the People's Republic of China, means intellectual creations with originality in the literary, artistic or scientific domain, insofar as they can be reproduced in a tangible form. Letters, as a human tool used to communicate feelings, exchange ideas and discuss issues, are usually written works independently conceived and created by the sender, and the content or form of expression is usually not or not fully a citation or transcription of published works by others. In other words, letters are not a simple imitation of, reproduction of or tampering with the works of others. Therefore, letters usually feature originality and replicability in line with the requirements set forth in the Copyright Law, and hence may be defined as “works” protected thereunder. Their author (that is, the sender) should therefore be entitled to the copyright and, in this case, according to relevant provisions of the Copyright Law, each of Qian Zhongshu, Yang Jikang and Qian Yuan was entitled to the copyright in their own letters.

II. Applicant is entitled to request an injunction under the Law of Succession

After Qian Zhongshu's death, Yang Jikang, his only heir, legally inherited the property rights to his copyright, and hence could protect his rights of authorship, alteration and integrity, and exercise his right of publication according to law. After Qian Yuan's death, Yang Jikang and Yang Weicheng were her heirs and inherited the same rights to her copyright. Given that Yang Weicheng expressly waived his rights to make claims, Yang Jikang was consequently entitled to all of these rights according to law. In disposing of letters and manuscripts, no one – including the receiver of the letters and other recipients who acquire the letters through legitimate means – shall impair the legal rights and interests of the copyright holders and their successors.

III. Respondent is engaging in or is about to engage in an infringing act

In determining whether a work has been published or not, the single criterion to consider is whether the work has been released to the public – namely, whether the work is at a state such that it could be known by an uncertain number of people. In this case, Sungari was about to make the letters and manuscripts available for public preview and auction. In doing so, it was or would be engaged in the reproduction and distribution of the letters and manuscripts by means of newspapers, Light Disks, promotion brochures and computer networks. Those acts would lead to the *de facto* publication of the works, constituting an infringement not only upon the publication right, but also upon the reproduction and distribution rights of the copyright holders.

IV. Respondent's act will cause "irreparable harm"

The publication right is one important personal right of copyright. It is the right to determine whether the work is to be exposed to the public, and when, where and by what means. The publication of the work is a one-off act. Once a work is illegally published, it represents a rejection of the will of the copyright holder. In terms of this case, it meant that private letters and manuscripts would enter the public area, which action is irreversible. Something brought to the public's attention can never again be the private preserve of the copyright holder. The illegal publication of the private letters and manuscripts by means of public auction could therefore cause irreparable harm to the copyright holder.

More importantly, the right to publication is not only an independent and important personal right of copyright, but also the basis on which the copyright holder can exercise and protect other related rights. Copyright belongs with the right holder whether the works are published or not. However, whether the works are published or not has a great influence over the copyright holder's ability to exercise control over and protect their own rights, and it also affects whether other people might obtain and use the work easily and potentially illegally. In this case, going forward with the illegal publication of the works will flip the "switch" between private and public status. Only when the switch is on will the general public be able to access, spread and reproduce the works involved. The Qians' letters and manuscripts are private letters written personally to Li Guoqiang. The function of private letters and the specific content of the letters involved in this case reveal that the sender's intent is to transmit information,

communicate feelings and exchange views – not to expose what has been written to the public for their appreciation and comment. The unauthorized publication of these works despite Yang Jikang’s strong opposition would strip her, as copyright holder, of control over other acts of reproduction, distribution and dissemination through information networks, which would be likely to trigger a chain of related copyright infringement actions. To do so would be to cause irreparable harm to the copyright holder.

In addition, the court has sufficiently evaluated the potential impact of the preliminary injunction. On condition that the applicant has provided a valid guarantee, granting the preliminary injunction would not be detrimental to the public interest. Both protecting copyright and encouraging the dissemination of works are values guarded by law, but private letters are somewhat peculiar in comparison with ordinary literary works, because they function as a means of expressing private thoughts and private emotions. Such letters are not intended for public cultural dissemination. The copyright holder’s control over these letters is a typical right to privacy that should be highly respected. Prohibiting the publication of private letters against the will of interested parties is not detrimental to public interests; rather, it will help to clarify the rules around copyright in private letters and the protection of a right to privacy.

Based on this analysis, the court held that Li Guoqiang and the auction company should not infringe upon the copyright of the works involved even though they were entitled to exercise their property rights. The preliminary injunction was granted.

D. Review of a preliminary injunction against a “cloud music” platform’s infringement of the right to network dissemination of information

In a networked environment, if alleged infringement is not prohibited in a timely manner, the alleged infringer may achieve market growth by taking improper advantage of others’ rights, causing irreparable harm to the interests of those rights holders. In such a case, a preliminary injunction shall be granted to prohibit the alleged infringing acts and preclude further damage being done to the rights holder(s).

SHENZHEN TENCENT COMPUTER SYSTEMS CO., LTD. V. GUANGZHOU NETEASE COMPUTER SYSTEMS CO., LTD., NETEASE (HANGZHOU) NETWORK CO., LTD., HANGZHOU NETEASE LEIHUO CO., LTD., CHINA UNITED NETWORK COMMUNICATIONS LIMITED HUBEI BRANCH, GUANGDONG OPPO MOBILE TELECOMMUNICATIONS CORP., LTD.

(2014) YWHZZJZ Nos. 00005 and 00005-2, Wuhan Intermediate People’s Court of Hubei Province

Cause of action:

Dispute over infringement of a right to disseminate musical works via the Internet

Collegial panel members:

He Zhen | Xu Jixue | Chen Feng

Keywords:

cloud music platform, preliminary injunction, right to network dissemination of information

Relevant legal provisions:

Civil Procedure Law of the People's Republic of China (as amended in 2012), article 100

Copyright Law of the People's Republic of China, article 50

Basic facts: In a dispute over copyright arising between claimant Shenzhen Tencent Computer Systems Co., Ltd. (hereinafter "Tencent Computer Systems") and respondents Guangzhou NetEase Computer Systems Co., Ltd. (hereinafter "Guangzhou NetEase"), NetEase (Hangzhou) Network Co., Ltd. (hereinafter "Hangzhou NetEase"), Hangzhou NetEase Leihuo Co., Ltd. (hereinafter "NetEase Leihuo"), China United Network Communications Limited Hubei Branch (hereinafter "Hubei Unicom") and Guangdong OPPO Mobile Telecommunications Co., Ltd. (hereinafter "Guangdong OPPO"), Tencent Computer Systems filed an application for preliminary injunctions with the Wuhan Intermediate People's Court of Hubei Province on November 10, 2014, requesting that the court order:

- (a) Guangzhou NetEase, Hangzhou NetEase and NetEase Leihuo to stop the dissemination to the public via the "NetEase Cloud Music" platform (music.163.com, and its PC and mobile client) of songs in which Tencent Computer Systems enjoyed an exclusive copyright, of which there were 623, including "Where Has the Time Gone", "The Support of Love", "Painted Heart", among others;
- (b) Hubei Unicom to stop rendering the free data packaging service for NetEase Cloud Music; and
- (c) Guangdong OPPO to stop delivering NetEase Cloud Music as a built-in feature within its OPPO-branded smartphones.

In applying for these injunctions, Tencent Computer Systems submitted relevant evidence including notarial certificates from Wuhan Quintai Notary Public Office in Hubei ((2014) EQTNZZ Nos. 13911, 14057, 15782, 15783, 15784, 15785 and 15786), music albums and printouts of related web pages, as well as Internet Protocol/Internet Communications Protocol (IP/ICP) file information inquiry results from the Ministry of Industry and Information Technology, to support the fact that the copyright in the music-and-lyrics products involved (hereinafter collectively the "musical works") belonged to Tencent. At the same time, Tencent Technology (Shenzhen) Co., Ltd., Guangzhou Branch, undertook to guarantee Tencent Computer Systems' application by providing as security a bank deposit of RMB3 million.

Held: With regard to the application for preliminary injunctions filed and evidence submitted by Tencent Computer Systems, the Wuhan Intermediate People's Court of Hubei Province formed a collegial panel under law. After reviewing the case, the court legally granted the following injunctions.

- (a) As of the effective date of the ruling, Guangzhou NetEase, Hangzhou NetEase and NetEase Leihuo were ordered to stop providing to the public, through the "NetEase Cloud Music" platform, some 623 musical works (as listed in an appendix attached to the ruling).
- (b) As of the effective date of the ruling, Hubei Unicom was ordered to stop rendering mobile network services to its mobile clients by means of the free data packaging of NetEase Cloud Music for the 623 musical works involved.
- (c) Guangdong OPPO was ordered to stop disseminating the 623 musical works involved to its mobile clients

by building the NetEase Cloud Music client into its smartphones branded “OPPO R830S” (contracted phones) within 10 days of the date immediately following the effective date of the ruling.

- (d) The bank deposit of RMB3 million in the account opened by Tencent Technology (Shenzhen) Co., Ltd., Guangzhou Branch, at China Merchants Bank Guangzhou Branch Huanshi East Road Sub-branch (A/C No. 2005xxxxxxx0001) was to be frozen.
- (e) Other injunction applications filed by Guangzhou NetEase were dismissed.
- (f) Tencent Computer Systems was ordered to bring its case to court within 30 days of the ruling coming into force; otherwise, the injunctive measures specified were to be released.

After the court issued these injunctions, Hubei Unicom and Guangdong OPPO immediately stopped their allegedly infringing acts and confirmed that they would actively adhere to their injunction obligations. Guangzhou NetEase, Hangzhou NetEase and NetEase Leihuo, however, applied for permission to appeal against the injunctions to the Wuhan Intermediate People’s Court of Hubei Province. On December 3, 2014, the court reviewed their application for reconsideration in a public hearing and held that their reasons could not be established, and hence the court dismissed their application.

During the court’s review, it became apparent to Tencent Computer Systems that allegedly infringing acts were still ongoing and hence it submitted a written application to the Wuhan Intermediate People’s Court of Hubei Province asking the court to penalize the respondents for their violation of the injunctions.

The court conducted a hearing, finding Guangzhou NetEase, Hangzhou NetEase and NetEase Leihuo in violation of its orders and imposing punitive measures accordingly. Upon the court’s issuance of its decision regarding the application for reconsideration, the three respondents ceased their allegedly infringing acts, pursuant to the requirements under the injunctions.

Reasoning: On reviewing the case, the Wuhan Intermediate People’s Court of Hubei Province held as follows.

- (a) Based on the music copyright licensing contracts, the music albums involved and other copyright documents submitted by Tencent Computer Systems, the claimant should be entitled to the rights to network dissemination of the 623 musical works, including “Green Rose” (as listed in the appendix attached to the judgment).
- (b) According to the notarial certificate ((2014) EQTNZZ No. 14057) submitted to Tencent Computer Systems by Wuhan Quintai Notary Public Office in Hubei, the respondents Guangzhou NetEase, Hangzhou NetEase and NetEase Leihuo jointly ran the NetEase Cloud Music platform (music.163.com), sponsored by Guangzhou NetEase, and communicated to the public via this platform the 623 musical works listed in the appendix attached to the judgment. The three respondents were suspected of infringing Tencent Computer Systems’ right to network dissemination of the 623 musical works.
- (c) According to the contents of the notarial certificate of Wuhan Quintai Notary Public Office in Hubei ((2014) EQTNZZ No. 13911) submitted to the court by Tencent Computer Systems, it could be confirmed

that the respondent Hubei Unicom cooperated with the NetEase Cloud Music platform and disseminated to its mobile clients the 623 musical works listed in the appendix, as prepared by Tencent Computer Systems, via the free data packaging of NetEase Cloud Music. These acts were suspected of infringing Tencent Computer Systems' right to network dissemination of the musical works involved in the case.

- (d) According to the contents of the notarial certificate of Wuhan Quintai Notary Public Office in Hubei ((2014) EQTNZZ No. 13911) submitted to the court by Tencent Computer Systems, Guangdong OPPO has built in a mobile client on its smartphones branded "OPPO R830S" (contracted phones) that accesses the "NetEase Cloud Music" platform for production and sales, and hence, by those means, has acquired the 623 musical works (as listed in the appendix attached to the judgment). Such acts were suspected of infringing Tencent Computer Systems' right to network dissemination of the 623 musical works listed in the appendix.
- (e) Substance specified in printouts of relevant NetEase Technology web pages, as submitted to the court by Tencent Computer Systems, included the following facts.
- (i) The legal representative of Guangzhou NetEase and Hangzhou NetEase claimed that they applied various Baidu, Alibaba and Tencent (BAT) modes; Alibaba and Baidu adopted the traffic mode, while NetEase was a content provider. The aggregate profits of the three large companies (JD, Xiaomi and Qihoo 360) were still less than those of NetEase.

(ii) According to NetEase Technology's website on August 18, 2014, NetEase Cloud Music had 40 million users; its hot songs list "English Songs that You Love to Hear" on its NetEase Cloud Music platform was played 170,000 times in only one week.

- (f) The secured assets provided by the guarantor Tencent Technology (Shenzhen) Co., Ltd. Guangzhou Branch, were verified to be genuine and the court froze the bank deposits of RMB3 million that it had provided.

Considering all of these factors, the court held that Tencent Computer Systems owned the right to network dissemination of the 623 musical works listed in the appendix attached to the judgment. It found that the five respondents had made available to the public the involved musical works by means of the Internet, the free data packaging of NetEase Cloud Music in smartphones and the built-in mobile client for NetEase Cloud Music, among other things. Not only were such acts suspected of infringing Tencent Computer Systems' right to network dissemination of these musical works, but also the respondents offered the musical works to the public in so significant a volume that they caused Tencent to suffer huge economic losses. In the view of the court and in light of the networked environment, if such acts were not prohibited in a timely manner, Guangzhou NetEase could further grow the market share that it had acquired by taking improper advantage of others' rights, which would cause irreparable harm to Tencent Computer Systems' interests. The court therefore ordered that all suspected infringement by all respondents via network dissemination of the 623 musical works listed in the

appendix should be prohibited. The security that the guarantor provided to cover the risk of the injunctions lodged was verified and the security procedure for the application of injunctions was legitimate.

When asked for a reconsideration, Wuhan Intermediate People's Court of Hubei Province held as follows.

- (a) Upon preliminary verification by the court, Tencent Computer Systems had submitted its copyright licensing contract, music albums, song lists and other evidence of its rights, which were sufficient to support the fact that it was the exclusive owner of the right to network dissemination of the involved musical works. Considering the dissemination feature of the "NetEase Cloud Music" platform and based on the *prima facie* evidence of the rapid market growth of the platform, the court determined that it was not improper to hold that failure to take injunctive measures might cause irreparable losses to Tencent Computer Systems.
- (b) Tencent Computer Systems had lodged an application for injunctions against Hubei Unicom, which provided the 623 musical works involved to its mobile users via the mobile service project of "free data packaging for NetEase Cloud Music" and hence was suspected of infringing Tencent Computer Systems' right to network dissemination, and that application was related to the application for review that the respondents had filed.
- (c) Other than the written statements issued by NetEase Leihuo that the platform involved was operated and managed by NetEase Leihuo independently, the three respondents who applied for review of the injunction order failed to submit any evidence that "NetEase Cloud Music" was jointly operated by the three such as may have been sufficient to overturn the injunction order. On the basis of evidence including the network domain applied by the "NetEase Cloud Music" platform, the Internet business license and NetEase Technology's declaration that Hangzhou NetEase was the developer of the software supporting the "NetEase Cloud Music" platform, as well as the title and copyright disclaimer on the NetEase Cloud Music website, it was not inappropriate to determine that Guangzhou NetEase, Hangzhou NetEase and NetEase Leihuo jointly operated the platform.
- (d) During the course of hearing the case, and as demonstrated by both the claimant and those respondents who applied for reconsideration, the musical works involved could be directly played by clicking the link code at the end of the web page provided by the "NetEase Cloud Music" platform, but such musical works could not be obtained online via the domain address provided by the three respondents. At the same time, the three respondents who applied for review failed to submit any evidence that may have supported their assertion that the "NetEase Cloud Music" platform merely provided web link technology and that the involved musical works had been lawfully licensed.
- (e) Songs #216 and #217 on the list of prohibited songs attached to the judgment in the case were not copies, but musical works of the same name performed by a different artist. Other works on the list were verified to be authentic. On the basis

of the musical works involved that were disseminated via the “NetEase Cloud Music” platform, the court had reason to confirm that these music products were the same as those for which Tencent Computer Systems claimed injunctions and there was no need to compare the sound sources.

E. Review of substantive elements in an application for an injunction, affirmation of irreparable harm and protection of right holder’s interests

In a case in which one party applies for an interim injunction, the courts should examine the likelihood that the applicant will win the case and whether the applicant is likely to suffer irreparable harm.

BLIZZARD ENTERTAINMENT INC. ET AL. V. CHENGDU QIYOU TECHNOLOGY ET AL.

(2015) YZFZMCZ No. 2-1 & (2015) YZFZSMCZ No. 2-1, Guangzhou Intellectual Property Court

Cause of action:

Dispute over copyright infringement and unfair competition

Collegial panel members:

Gong Qitian | Zhuang Yi | Peng Ang

Keywords:

interim injunction, irreparable harm, online gaming

Relevant legal provisions:

Civil Procedure Law of the People’s Republic of China (as amended in 2012), article 100

Copyright Law of the People’s Republic of China, article 50

Basic facts: Blizzard Entertainment Inc. (hereinafter “Blizzard Entertainment”) and Shanghai EaseNet Network Technology Development Co., Ltd. (hereinafter “EaseNet”) filed a request for an interim injunction alleging copyright infringement and unfair competition against Chengdu Qiyou Technology

Co., Ltd. (hereinafter “Qiyou”), Beijing Fenbo Times Internet Technology Co., Ltd. (hereinafter “Fenbo Times”) and Guangzhou Dongjing Computer Technology Co., Ltd. (hereinafter “Dongjing”). Blizzard Entertainment holds the copyright in computer software works such as *World of Warcraft* (first launched in the United States of America on November 23, 2004), *World of Warcraft: The Burning Crusade* (first launched in the United States on January 16, 2007), *World of Warcraft: Wrath of the Lich King* (first launched in the United States on November 13, 2008) and *World of Warcraft: Mists of Pandaria* (first launched in the United States on September 25, 2012).

The *World of Warcraft* series of games has won many important honors in China, such as being named among the “Top 10 Most Popular Online Games” in 2006 and 2007 at the China Game Industry Annual Conference, among the “Top 10 Most Popular Online Games” at the first Chinese Game Gold Raccoon Award in 2011 and “Online Game of the Year” at the Roster of Chinese Game Heroes in 2012.

From June 2014, Blizzard Entertainment started promoting its game *World of Warcraft: Warlords of Draenor* through its official Chinese website. On November 20, 2014, the game was officially launched in China and EaseNet operated it exclusively.

The hero characters in the *World of Warcraft* series of games include Velen, Illidan Stormrage, Garrosh Hellscream and Thrall, among others. The monster characters include Aku'mai and Deviate Shambler, among others. The designs of these heroes and monsters appeared on Blizzard Entertainment's official Chinese website, in the English publication

Ultimate Visual Guide of World of Warcraft, and in Chinese publications *Art of Blizzard* and *World of Warcraft Thrall: Twilight of Dragon*. These websites and publications all indicated that Blizzard Entertainment was the copyright owner. In these two cases, Blizzard Entertainment also claimed that it had copyright for fine-art works of 18 heroes and 7 monsters appearing in the games, as well as that “Warcraft” and “Draenor” constituted the specific names of well-known products, “Thrall” constituted a famous character name and four game scenes (including the title interface, login interface and role-creation interface) constituted the special decoration of well-known commodities.

The disputed game, originally named *Tribal Chief Thrall: Crusade of Warcraft*, was developed by the respondent Qiyou. Fenbo Times held shares in Qiyou and was also the exclusive operator of the disputed game. On August 25 and September 19, 2014, respectively, Fenbo Times launched the open beta iOS and Android versions of the disputed game on its official website (www.rekoo.com); on December 19, 2014, it renamed the game *Everyone Warcraft: War of Draenor*. Dongjing, with the authorization of Fenbo Times, provided the Android version of the game to the public for download via its official website (www.9game.cn).

Upon comparison, the court found the designs of the relevant heroes and monsters in the disputed game to be substantially similar to those designs in which Blizzard Entertainment claimed copyright.

With respect to the publicity and launch of the disputed game, Fenbo Times' official website contained the following statements:

“In order to recreate the *World of Warcraft* more perfectly, *Tribal Chief Thrall* ... whether it is the players controlling the heroes or the monsters in the game instance, and whether it is the map design or special skills, the designs of *World of Warcraft* are almost 100% recreated ... Panda Lin, top player of *Warcraft*, will accept the final challenge of ‘beauty calls at your home’.”

“*Everyone Warcraft* is a PRG card game with the background of *World of Warcraft*. As a piggy-backing product, it presents many contents of *World of Warcraft* perfectly and instantly ignites the passion of the fans with its plots, heroes and scenes.”

In Fenbo Times’ official blog, some players commented: “I love the challenge of *Warcraft* so much ... Let’s play *World of Warcraft* together.”

Blizzard Entertainment alleged that the disputed game copied the designs of heroes and monsters from its own game, and used names and decoration similar to those used in Blizzard’s own game. Indeed, Fenbo Times repeatedly claimed in its publicity that the disputed game was the mobile version of *Warcraft*. These acts of Qiyou, Fenbo Times and Dongjing jointly infringed Blizzard Entertainment’s copyright and constituted unfair competition. If allowed to continue, such infringement would cause irreparable harm to Blizzard Entertainment; hence, Blizzard instituted proceedings at the Guangzhou Intellectual Property Court and applied for an interim injunction, requesting that the disputed game be removed in its entirety. Blizzard Entertainment was willing to post a cash bond of RMB10 million.

Qiyou, Fenbo Times and Dongjing contended that:

- (a) the disputed game software was registered under the name of a third party;
- (b) Blizzard Entertainment could not prove that it was the owner of copyright in the designs of the heroes and monsters involved in the case, that the actions of Qiyou, Fenbo Times and Dongjing constituted copyright infringement and unfair competition or that it had suffered irreparable harm; and
- (c) the issuing of an injunction would seriously harm their interests and the interests of those playing the game.

Qiyou, Fenbo Times and Dongjing therefore requested that Blizzard Entertainment’s application for an injunction be denied.

Held: The Guangzhou Intellectual Property Court issued an interim injunction on March 9, 2015, in which it:

- (a) prohibited Qiyou from reproducing, distributing and disseminating through information networks the game *Everyone Warcraft: War of Draenor* (originally named *Tribal Chief Thrall: Crusade of Warcraft*) for a term expiring upon the effective date of the judgments of the present two cases;
- (b) prohibited Fenbo Times from reproducing, distributing and disseminating through information networks the game *Everyone Warcraft: War of Draenor* (originally named *Tribal Chief Thrall: Crusade of Warcraft*), and from engaging in the alleged unfair competition for a term expiring upon the effective date of the judgments of the present two cases, but on condition that

- the provision of balance inquiry, refund and other services for the game players during the term of the injunction shall not be affected;
- (c) prohibited Dongjing from disseminating the game *Everyone Warcraft: War of Draenor* (originally named *Tribal Chief Thrall: Crusade of Warcraft*) through its official website (www.9game.cn) for a term expiring upon the effective date of the judgments of the present two case, but on condition that the provision of balance inquiry, refund and other services for the game players during the term of the injunction shall not be affected; and
- (d) dismissed Blizzard Entertainment's and EaseNet's other injunction applications.

Reasoning: Guangzhou Intellectual Property Court held as follows.

I. Requirements for substantive review in applications for an injunction

According to article 100 of the Civil Procedure Law of the People's Republic of China, while one party's actions may make a judgment hard to enforce or cause the parties additional harm, the courts may nonetheless, at the request of the other party, prohibit the first party from committing certain acts. Thus, while determining whether to issue an injunction, the court shall first review the likelihood that the applicant for the injunction will win the case. According to article 101 of the Civil Procedure Law, a right holder may apply for a preliminary injunction in case of urgency in which the failure to immediately issue an injunction would cause irreparable harm to the right holder. In this case, because Blizzard Entertainment applied for the injunction while instituting proceedings and claimed

that the situation was urgent, it was also necessary to review whether the alleged infringement, if it were to occur, would cause the plaintiff irreparable harm.

II. Likelihood that the applicant will win the case

Both China and the United States are contracting parties to the Berne Convention for the Protection of Literary and Artistic Works, and Blizzard Entertainment's works are protected by China's copyright law under both the Convention and article 2 of the Copyright Law of the People's Republic of China. Blizzard Entertainment is the owner of copyright in the computer software works of the *World of Warcraft* series games. In view of this, and the copyright marks that appear on Blizzard Entertainment's official website and in its legal publications in relation to the introduction of heroes and monsters in the *World of Warcraft* series, there is sufficient proof that Blizzard Entertainment enjoys copyright in the artistic works of the designs of 18 heroes and 7 monsters claimed. The respondents' unauthorized use of the designs of these heroes and monsters in the game infringed Blizzard Entertainment's rights to reproduce, distribute and disseminate its fine-art works through information networks. At the same time, Blizzard Entertainment's *World of Warcraft* series of games are widely known in the Chinese marketplace. Its *World of Warcraft: Warlords of Draenor* therefore constituted a well-known game. Since the relevant public views "Warcraft" as an abbreviation of the *World of Warcraft* and "Draenor" is the name of a fictitious zone in the *World of Warcraft* with distinctive features that distinguish the source of the commodities, *World of Warcraft: Warlords of Draenor* constitutes a specific name of a well-

known game. Qiyou, Fenbo Times and Dongjing launched a similarly named game, *Everyone Warcraft: War of Draenor* (originally named *Tribal Chief Thrall: Crusade of Warcraft*), around the time that Blizzard Entertainment launched its *World of Warcraft: Warlords of Draenor*. Subjectively, it is clear that, in doing so, the respondents intended to free-ride on the popularity of the claimant's game. Objectively, the similarly named game was likely to cause confusion among the relevant public. It thereby constituted unfair competition and the unauthorized use of specific names of the well-known commodities of others. In addition, Fenbo Times repeatedly mentioned *World of Warcraft* when promoting the disputed game. This was false publicity that was likely to cause the relevant public to believe the game to be a mobile version developed or authorized by Blizzard Entertainment. Qiyou was the developer of the disputed game, Fenbo Times was its exclusive operator and a shareholder in Qiyou, and Dongjing provided the download services through which the disputed game was delivered to the public, as authorized by Fenbo Times; hence, there was sufficient evidence to establish Blizzard Entertainment's claim that Qiyou, Fenbo Times and Dongjing were jointly liable for the infringement. With Blizzard Entertainment being likely to win the case, it was obviously unconvincing for Qiyou, Fenbo Times and Dongjing to claim that the interim injunction would cause great harm to themselves and to their players if Blizzard were to lose. In addition, since the three jointly engaged in the infringement, whether or not the disputed game software was registered under the name of a third party did not affect whether the injunction should be issued in this case.

III. Whether the plaintiff would suffer from irreparable harm

The disputed game was launched around the same time as Blizzard Entertainment launched its game *World of Warcraft: Warlords of Draenor*. Although the two are mobile and PC games, respectively, both are online games that have similar names, which feature similarly designed and named heroes and monsters, have similar game interfaces and are similarly centered on heroes fighting monsters. The two are therefore products with a strong competitive relationship. The launch of the disputed game inevitably squeezed the market share of Blizzard Entertainment's newly launched game. Furthermore, online games are characterized by a short life cycle, fast-paced dissemination and broad circulation, making the quantum of Blizzard's damages hard to calculate. Moreover, Fenbo Times took a vulgar approach to marketing the disputed game. Confusing the disputed game for Blizzard's game, the relevant public may share negative reviews, which will harm Blizzard's goodwill.

IV. Removal of the disputed game in its entirety and the protection of players' interests

Although Qiyou, Fenbo Times and Dongjing proposed that they might modify the designs of relevant heroes and monsters, the modifications that they proposed after the hearing remained substantially similar to the content claimed by Blizzard Entertainment. In addition, according to the facts that the name, designs of relevant heroes and monsters, and other important components of the disputed game are all infringing, and that the disputed game

is promoted as “100% recreat[ing]” the designs of *World of Warcraft*, the designs of the remaining heroes or monsters of that game are likely to be found to be infringing, too. The facts underpinning Blizzard’s request that the respondents be required to remove the disputed game in its entirety are consequently sufficiently proven and the request shall be supported. However, the provision of services such as balance inquiry and refunds to players of the disputed game shall not be affected during the term of the injunction.

F. Idea–expression dichotomy and assessing infringement of the right to adapt a literary work

Works are the subject matter of copyright. However, not all elements in works are protected under the Copyright Law of the People’s Republic of China. The dichotomy between “idea” and “expression” is the basic principle used to distinguish between the protected and unprotected elements in works under the Copyright Law, which, in essence, protects the *expression* of ideas, rather than ideas as such.

“Expression”, in literary works, is not limited to dialogue, rhetoric, wording and phrasing, but neither can the theme, subject matter and ordinary relationships among characters be identified as expression protected under the Copyright Law. In literary works, plot must be closely connected through successive scenes and logical sequence if it is to form complete and individualized expressions. Such organic integration of sufficiently specific character settings, plot structure and inherently logical sequence can become “expression”, as protected under the Copyright Law.

The “right to adapt” a literary work refers to the right to change the work and to use it as a basis for a new creative work. The types of activity under direct control of the holder of the right to adapt are those integral to adaptation – that is, the acts of changing the original work and creating a new work. The new work must retain the same basic expressions that were found in the original literary work; if a new work is only loosely based on the ideas found in the original literary work, the right to adapt is not infringed.

If a new work is to be found to infringe the right to adapt, two requirements must be met:

- (a) the alleged infringer must have had the opportunity to “access” the original copyright work; and
- (b) the new work must demonstrate “substantial similarity” to the original literary work.

Access can be presumed. Substantial similarity can be determined on the basis of a comparison of extracted passages or other abstracted elements, or of overall expression, or on the basis of a combination of both approaches, depending on the specific circumstances of the case. In conducting such comparisons, the courts shall exclude instances of reasonable cross-reference.

**CHEN ZHE (PEN NAME: CHIUNG YAO)
V. YU ZHENG (PEN NAME: YU ZHENG)
ET AL.**

(2015) GM (Z) ZZ No. 1039, Beijing Higher People’s Court

Cause of action:

Copyright infringement dispute

Collegial panel members:

Xie Zhenke | Yuan Xiangjun | Zhong Ming
| Qi Lei (judge assistant)

Keywords:

access, expression, ideas, substantial similarity

Relevant legal provisions:

Copyright Law of the People’s Republic of China, articles 10(1)(xiv), 12 and 47(6)

Basic facts: Chen Zhe (under the pen name “Chiung Yao”) is a famous scriptwriter from Taiwan Province of China. Yu Zheng is a famous scriptwriter from the mainland of China. The script “Meihualao”, attributed to Chiung Yao, was completed in October 1992 and not published in paper form. The novel *Meihualao*, adapted from the script of “Meihualao”, was completed on June 30, 1993, and publicly distributed in Taiwan

Province of China from September 15, 1993. It was published on the Chinese mainland in the same year. Chiung Yao was named as the author of the novel *Meihualao*.

The television series *Meihualao* premiered in Taiwan Province of China on October 13, 1993, and on the Chinese mainland on April 13, 1994. The series *Meihualao* is highly similar to the script of “Meihualao”, but the opening credits name the scriptwriter as Lin Jiuyu, who issued a notarized statement on June 20, 2014, that she was responsible only for taking dictation of Chiung Yao’s creation, and for consolidating and editing the script. Lin Jiuyu affirmed that the script from “Meihualao” was independently created by Chiung Yao.

Yu Zheng was recorded as the author of a script “Palace 3: The Lost Daughter” – that is, Yu Zheng was named as the scriptwriter of the television series *Palace 3: The Lost Daughter*. The script was completed on July 17, 2012, and first published on April 8, 2014. The series was shot in accordance with the script, and its plot and content were basically the same as the script of “Palace 3: The Lost Daughter”. The series premiered on Hunan TV on April 8, 2014. The closing credits of *Palace 3: The Lost Daughter* named the production companies involved as Hunan eTV Culture Media Co., Ltd. (hereinafter “Hunan”), Dongyang Huanyu Film and Television Culture Co., Ltd. (hereinafter “Huanyu”), Wanda Media Co., Ltd. (hereinafter “Wanda”), and Dongyang Xingrui Film and Television Culture Media Co., Ltd. (hereinafter “Xingrui”).

The script of “Palace 3: The Lost Daughter” and the television series *Palace 3: The Lost Daughter* corresponded to Chiung Yao’s work, “Meihualao”, in terms of the setting,

the characters and their relationships, and its plots. The script of “Palace 3: The Lost Daughter” was basically the same as Chiung Yao’s work in various aspects of overall plot arrangement and plot progression. Chen Zhe filed a lawsuit with the No. 3 Intermediate People’s Court of Beijing Municipality, alleging that the script of “Palace 3: The Lost Daughter” infringed on her right of adaptation for the script and novel of *Meihualao*, and that the shooting of the series *Palace 3: The Lost Daughter* infringed on her cinematographic rights, and asked the court to order the termination of the infringement, a public apology and damages for loss.

Held: The No. 3 Intermediate People’s Court of Beijing Municipality delivered its judgment ((2014) SZMCZ No. 07916) on December 25, 2014, ruling as follows.

- (a) Hunan, Huanyu, Wanda and Xingrui were to immediately cease the reproduction, distribution and dissemination of the television series *Palace 3: The Lost Daughter* from the effective date of the judgment.
- (b) Yu Zheng was to publish statements conspicuously on outlets Sina.com, Sohu.com, LETV and ifeng.com apologizing to Chen Zhe (Chiung Yao) and aiming to mitigate the negative impact of the infringement. (Yu Zheng was to submit the statement proposed to the court for review within five days of the effective date of the judgment and, in the event of Yu Zheng’s failure to do so, the court would publish the gist of the judgment in the *Legal Daily*, for which Yu Zheng would bear the necessary costs.)
- (c) Yu Zheng, Hunan, Huanyu, Wanda and Xingrui were ordered to pay, jointly and severally, RMB5 million to compensate Chen Zhe for her economic losses and reasonable

litigation costs within 10 days of the effective date of the judgment.

- (d) Chen Zhe’s other claims were rejected.

Yu Zheng and the other respondents refused to accept the judgment and appealed to the Beijing Higher People’s Court, which dismissed the appeal and affirmed the decision at first instance.

Reasoning: The Beijing Higher People’s Court held as follows.

I. Expressions in literary works protected under the Copyright Law

The idea–expression dichotomy is the basic principle that distinguishes between the protected and unprotected elements in literary works. Its essence is that the Copyright Law of the People’s Republic of China protects the *expression* of an idea, rather than the idea as such. If it is alleged that an infringing work is substantially similar to the work of the right holder, it should be because the expressions within the two are substantially similar. Expressions protectable under the Copyright Law include not only the finalized form of the text, colors, lines and other symbols within the work, but also the material with which the author manifests their ideas and emotions. However, creative ideas, source material or information that is in the public domain, as well as some forms of creativity, necessary scenes or expressions that are unique or limited, are excluded from the scope of protection under the Copyright Law. Both scripts and novels are literary works, in which the boundary between ideas and expressions is difficult to delineate. “Expression”, in literary works, is not limited to dialogue, rhetoric, wording and phrasing, nor can the theme, subject matter and ordinary relationships among characters be identified as expression

protected under the Copyright Law. Expressions in a literary work are not only manifested by literal expressions, but also emerge in the story told through those literal expressions. However, the setting of and relations among characters, and the plots, which consist of the occurrence, development and sequence of specific events, cannot constitute expressions protected by the Copyright Law until they reach such a level of distinctiveness that the author's unique choices, judgments and trade-offs are reflected in the selection of scenes, their structural arrangement and the design of plot progression in a literary work.

In literary works, the coherent arrangement and logical sequence of well-knit plots from beginning to end is what turns the plots in aggregate into a complete and individualized expression. The organic combination of such sufficiently specific character setting, plot structure and inherently logical relationships may constitute expressions protected by the Copyright Law.

II. Ways of judging infringement of the right of adaption

According to the provisions of article 10(1)(xiv) of the Copyright Law of the People's Republic of China, the "right of adaption" is the right to change the work and create a new work based on it that displays originality. Subject to these provisions, the types of activity under direct control of the holder of the right to adapt are those integral to adaptation – that is, the acts of changing the original work and creating a new work. The new work must retain the same basic expressions that were found in the original literary work; if a new work is only loosely based on the ideas found in the original literary work, the right to adapt is not infringed.

Unless otherwise specified by the law, unauthorized adaptation of someone else's original works constitutes an infringement upon the original copyright holder's right of adaptation. If the acts complained of are to be found to infringe that right, the two requirements of access and substantial similarity must usually both be met.

"Access" means that the accused must have had the opportunity to access, know about or perceive the copyrighted works of the right holder. When disclosed through such means as publication, exhibition, broadcasting, performance and screening, the works of the right holder may be deemed to be published and made accessible to the public. Under normal circumstances, the alleged infringer will have had the opportunity to acquaint themselves with the works of the right holder. In this way, access can be presumed. In this case, the broadcast of the television series *Meihualao* may be deemed to be publication of the script "Meihualao". It may therefore be presumed that Yu Zheng, Hunan, Huanyu Film, Wanda and Xingrui accessed the script of "Meihualao".

The Copyright Law protects expressions of ideas, instead of ideas as such. If the allegedly infringing work is to be found to be "substantially similar" to the work of the right holder, it should be because the expressions within the two are substantially similar. Expressions protectable under the Copyright Law include not only the finalized form of the text, colors, lines and other symbols within the work, but also the material with which the author manifests their ideas and emotions. However, creative ideas, source material or information that is in the public domain, as well as some forms of creativity, necessary scenes or expressions that are unique or limited are excluded from the scope of protection

under the Copyright Law. To judge whether or not substantial similarity is justified, one shall first judge whether or not the elements claimed by the copyright holder belong to expressions protected under the Copyright Law.

Both scripts and novels are literary works, in which the boundary between ideas and expressions is difficult to delineate. Expression, in literary works, is not limited to dialogue, rhetoric, wording and phrasing, nor can the theme, subject matter and ordinary relationships among characters be identified as expression protected under the Copyright Law. Expressions in a literary work are not only manifested by literal expressions, but also emerge in the story told through those literal expressions. However, the setting of and relations among characters, and the plots, which consist of the occurrence, development and sequence of specific events, cannot constitute expressions protected by the Copyright Law until they reach such a level of distinctiveness that the author's unique choices, judgments and trade-offs are reflected in the selection of scenes, their structural arrangement and the design of plot progression in a literary work.

Assessing substantive similarity is a process of abstracting and filtering to determine what are the protected expressions of a literary work. When it comes to character relationships and the settings, comparison shall be made of expressions formed by the combination and interaction of characters and plots. If both the sequence of events and interaction of characters originate in the prior copyrighted work, then substantial similarity shall be established. In literary works, plots are closely connected by means of successive scenes and logical sequence to form complete and individualized expressions. Such

organic integration of sufficiently specific character settings, plot structure and inherent logical relations can become expressions protected by the Copyright Law. If the allegedly infringing work includes expressions that are sufficiently specific, and if well-knit and logical plot arrangements comprise a notable portion of the allegedly infringing work, substantial similarity shall be established on this basis. If such well-knit and logical plot arrangements within the text of the allegedly infringing work account for a sufficient portion in the copyrighted work, substantial similarity shall be established even if such duplication appears in only a small portion in the allegedly infringing work, but to such an extent that the relevant public feels as though they originated from the other work.

In addition, it needs to be clarified that even though some specific plots in a work may belong to the public domain or may constitute necessarily limited or unique forms of expression, it does not mean that the organic combination of such plots and other plots cannot be original or constitute expressions protected by the Copyright Law. Overall substantial similarity cannot be ruled out by partial dissimilarity of plot.

In this case, 9 of the 21 plot points claimed by Chiung Yao were expressions protected by the Copyright Law. The script of "Palace 3: The Lost Daughter" was found to be substantially similar to the copyrighted script in those 9 instances; the script of "Palace 3: The Lost Daughter" was also substantially similar in terms of the Chiung Yao's claimed setting and character relationships. On the whole, the court found the script of "Palace 3: The Lost Daughter" to be substantially similar to the protected work.

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Chapter 4

Monopoly and competition cases

A. Ownership of “special packaging and decoration” of well-known products

The relationship between “well-known products” and “special packaging and decoration”, as defined under article 5(2) of the Law of the People’s Republic of China against Unfair Competition (hereinafter the “Anti-Unfair Competition Law”), is mutually interdependent and inseparable; only those products that are distinguished using special packaging or decoration can be regulated under the Anti-Unfair Competition Law. Packaging and decoration that features abstract names or branding that has no definitive association with the product and which fails to suggest the ways in which the product might be used in practice cannot be assessed under article 5(2).

In determining the ownership of rights to and interests in special packaging and decoration, the courts shall both encourage honest trading based on the principle of good faith and respect the value of consumers’ awareness of the source of the commodity, based on the objectively distinctive features of packaging and decoration as such.

GPLH V. JDB COMPANY ET AL.
(2015) MSZZ No. 2 &
(2015) MSZZ No. 3, SPC

Cause of action:

Disputes over the unauthorized use of special packaging and decoration of a well-known product

Collegial panel members:

Song Xiaoming | Xia Junli | Zhou Xiang |
Qian Xiaohong | Tong Shu

Keywords:

ownership of rights and interests, special packaging and decoration, unfair competition, well-known product

Relevant legal provisions:

Law of the People’s Republic of China against Unfair Competition (as published in 1993), article 5(2)

Basic facts: On July 6, 2012, Guangzhou Pharmaceutical Holdings Limited (hereinafter “GPLH”) and Guangdong Jiaduobao Beverage and Food Co., Ltd. (hereinafter “JDB Company”) respectively instituted legal proceedings in a court on the same day, each asserting its rights and interests of the special packaging and decoration of a well-known product, “Red-Canned Wanglaoji Herbal Tea”, and alleging on this basis that the packaging and decoration of the red-canned herbal tea produced and sold by the other party constituted infringement.

Specifically, GPLH, as holder of the registered trademark “Wanglaoji”, asserted that since “Wanglaoji” is an inseparable part of the packaging and decoration, and distinctively indicates the source of the commodity, consumers would take it for granted that the product “Red-Canned Wanglaoji Herbal Tea” originated from the holder of the “Wanglaoji” trademark, and that recipe and taste would not affect the consumers’ identification and judgment of the commodity. JDB Company, as the former actual supplier of “Red-Canned Wanglaoji Herbal Tea”, asserted that the rights and interests in the packaging and decoration and the ownership of the

rights in the “Wanglaoji” trademark were independent from, and did not affect, each other. What consumers love is JDB Company’s “Red-Canned Wanglaoji Herbal Tea”, produced using a particular recipe, and packaged and decorated in a way that is both used by JDB Company and closely associated with the commodity; hence, JDB Company asserted its ownership of the rights and interests relating to the packaging and decoration.

Held: At first instance, Guangdong Higher People’s Court held that the rights and interests of the packaging and decoration of “Red-Canned Wanglaoji Herbal Tea” should belong to GPLH, and that the production and sale of red-canned herbal tea by Guangzhou Wanglaoji Health Industry Co., Ltd. (hereinafter “Health Company”), as authorized by GPLH, did not constitute infringement. Since JDB Company did not own the rights and interests in the packaging and decoration concerned, its production and sale of both red-canned herbal tea labeled 王老吉 (“Wanglaoji”) and 加多宝 (“JDB”) on either side, and that labeled 加多宝 (“JDB”) on both sides, constituted infringement. The court therefore ordered JDB Company to cease the infringement, to publish a statement to mitigate its effect, and to compensate GPLH RMB150 million for economic losses and more than RMB260,000 for reasonable enforcement costs.

JDB Company appealed the first-instance judgment to the Supreme People’s Court. The Supreme People’s Court delivered its judgment on July 7, 2017, dismissing all of the claims of both GPLH and JDB Company.

Reasoning: The Court held, in its effective judgment, that the distinctive nature of features of packaging and

decoration and their application to fairly well-known products are the two conditions that must be met if rights and interests connected with the packaging and decoration of commercial brands are to be protected under the Law of the People’s Republic of China against Unfair Competition. The application of article 5(2) of the Law defines the relationship between “special packaging and decoration” and “well-known products” as being mutually interdependent and inseparable. Only a commodity that uses special packaging and decoration can be assessed under the Law against Unfair Competition. In contrast, abstract commodity names or commodity concepts without definitive connotations are detached from the concrete commodities that the packaging and decoration envelop, absent any evaluable conducts of actual usage, and thus cannot be assessed under article 5(2).

The dispute arose between the two parties because “Wanglaoji Herbal Tea”, as a kind of commodity name, could refer to various packaged and decorated herbal tea products, including the green-boxed one produced by GPLH and the red-canned one produced by JDB Company. The purpose of defining “well-known product” is to inform assessment of whether the special packaging and decoration attached to that commodity meet the conditions under which the rights and interests in commercial branding are to be protected under the Law against Unfair Competition; hence, such a “well-known product” shall be clearly indicated on the packaging and decoration concerned. The court of first instance had disregarded the required interdependence of packaging and decoration and the commodity, and had found the commodity name “Wanglaoji Herbal Tea”, which has non-specific

references, to be the “well-known product” in this case. This decision had no basis in fact or law and so was corrected.

This dispute over the special packaging and decoration of the well-known product arose from the failure of both parties to clearly define, when entering into and performing a trademark license contract, how to allocate the derivative benefits accruable during the term of license. Usually, once a trademark license terminates, the licensee shall immediately stop using the trademark and the goodwill accumulated in the licensed trademark shall be simultaneously returned to the licensor. The dispute in this case occurred in an unusual way in the sense that the special packaging and decoration introduced during the licensed use not only closely related to the licensed trademark, but also created features of goodwill that extended beyond trademark rights because of their status as independent rights and interests under the Law against Unfair Competition. Both parties’ claims entailed the general application of law on the protection of rights and interests in branding, and reflected the complex historical and practical factors involved in forming the rights and interests in the special packaging and decoration in this case. The registered trademark system and the system of protection for the rights and interests in the special packaging and decoration of well-known products draw on different sources, even though they both belong to a legal system that aims to protect the rights and interests in commercial branding. Registered trademarks and packaging and decoration can each play an independent role in brand recognition, and respectively belong to different right holders.

After “Red-Canned Wanglaoji Herbal Tea” was launched into the market and marketed effectively by JDB Company and its affiliates, its packaging and decoration generated independent rights and interests relating to its commercial branding because of its popularity and specificity. This case is exceptional because, in the course of design, use and promotion, JDB Company, as the actual operator of the packaging and decoration concerned, always highlighted the word “Wanglaoji”, a registered trademark held by GPHL, on its packaging and decoration, and never intended to break and clearly distinguish the relationship between the packaging and decoration and the registered trademark contained therein, which objectively caused the packaging and decoration to simultaneously refer to JDB Company and GPHL. Consumers would not deliberately differentiate, in the legal sense, the trademark rights and the rights and interests of the special packaging and decoration of well-known products, but would naturally relate “Red-Canned Wanglaoji Herbal Tea” to GPHL and JDB Company at the same time.

In fact, on the one hand, the packaging and decoration at issue did bear the influence of GPHL’s brand “Wanglaoji” and, on the other hand, the popularity of the commodity and the remarkable brand recognition of the packaging and decoration was the result of JDB Company’s efforts in producing, operating and promoting the product for more than 10 years. In considering these factors as a whole, as well as the evolution of “Red-canned Wanglaoji Herbal Tea”, the background of cooperation between the parties, consumers’ brand recognition and the principle of equity, given the positive role of GPHL and its predecessor and that of

JDB Company and its affiliates in forming and developing rights and interests in the packaging and decoration concerned and establishing the goodwill attached to it, it would result in obvious unfairness and might harm public interests if the rights and interests in the packaging and decoration were to be wholly awarded to either party. Therefore, on the premise of compliance with the principle of good faith and respect for consumers' brand recognition, and without prejudicing the lawful rights and interests of others, the rights and interests in the special packaging and decoration of the well-known product concerned were found to be jointly owned by GPLH and JDB Company.

B. Methods for defining Internet-related markets and analyzing abuse of dominant market position

In handling antitrust cases, defining the "relevant market" is an important analytical step. However, the ability to clearly define the relevant market depends on the specific circumstances of the case and it will not be necessary in every case involving abuse of dominant market position. In such a case, a definition of the relevant market is a tool with which to assess the business operator's market position and the impact of the allegedly monopolistic practice on competition. If the business operator's market position and the market impact of the allegedly monopolistic practice can be demonstrated directly by evidence of barriers to or the elimination of competition, it will be unnecessary to clearly and conclusively define the relevant market.

Hypothetical monopolist testing (HMT) is a generally applicable analytical method that can be used to define the relevant market. In practice, it is assumed that HMT can be conducted through methods such as small, but significant and non-transitory, increase in price (SSNIP), or small, but significant and non-transitory, decrease in quality (SSNDQ). The free-of-charge features of Internet-based instant messaging (IM) services, for example, make users highly sensitive to price. Because the SSNIP test method can lead to an excessively broad definition of the relevant market, SSNDQ should be adopted when conducting qualitative analysis.

The cost and coverage of services shall be kept in mind in defining the relevant geographical market. A comprehensive assessment can then be made, based on the actual region in which a majority of users select the goods, the provisions

of local laws and regulations, the status of overseas competitors, and the timely access to relevant geographical markets and other factors.

In the Internet-related sector, market share is a relatively crude and potentially misleading indicator for evaluating dominant market position. Its position and role in determining dominant market position must be established based on the circumstances of the specific case.

QIHOO V. TENCENT
(2013) MSZZ No. 4, SPC

Cause of action:

Dispute alleging abuse of dominant market position

Collegial panel members:

Wang Chuang | Wang Yanfang | Zhu Li

Keywords:

abuse of dominant market position, market share, monopoly, relevant market

Relevant legal provisions:

Anti-Monopoly Law of the People's Republic of China, articles 17–19

Basic facts: This case was filed by Beijing Qihoo Technology Co., Ltd. (hereinafter “Qihoo”) with the Higher People's Court of Guangdong Province, alleging that Tencent Technology (Shenzhen) Company Limited (hereinafter “Tencent”) misused its dominant market position with respect to relevant IM software and services. On November 3, 2010, Tencent released a letter to users of its IM platform QQ requesting them to stop running QQ on computers that had Qihoo's 360 (anti-virus) software installed. On November 4, 360 Security Center announced that, after strong intervention by relevant state departments, the current

version of Tencent's QQ and its own 360 software were fully compatible. In September 2010, Tencent QQ IM software and QQ Software Management were provided to users for installation as a package. However, users were not prompted to install QQ Software Management when installing QQ IM software. On September 21, 2010, Tencent issued a notice that the current version of QQ Software Management and its own security software QQ Doctor would be automatically upgraded to QQ Computer Housekeeper. Qihoo claimed that Tencent refused to provide related software services to users who had installed Qihoo's 360 software and forced users to choose between Tencent's QQ and Qihoo's 360, thus constituting a restrictive trade practice, which is prohibited under the Anti-Monopoly Law of the People's Republic of China. Tencent's act of tying QQ Computer Housekeeper to its IM software and installing QQ Doctor under the guise of upgrading QQ Housekeeper constituted a bundled sale, which is prohibited under the Anti-Monopoly Law.

The case was filed, at first instance, in the Higher People's Court of Guangdong Province, which held as follows.

- (a) On the definition of the relevant market, Qihoo's claim that an integrated IM service constitutes an independent relevant commodity market and relevant geographical market, which in this case was mainland China, could not be established. The relevant commodity market in this case went far beyond the integrated IM service market and the relevant geographical market should be the global market. However, the court did not clearly define the scope of the relevant commodity market in this case.

- (b) On the dominant market position, because Qihoo misjudged the relevant commodity market in this case, the evidence it provided did not prove that Tencent had a monopolistic position in the relevant commodity market.

The court found that Qihoo's litigation claims had no basis in fact or law and thus could not be established. It delivered its judgment dismissing Qihoo's entire claim.

Not accepting the decision, Qihoo filed an appeal. The main points that it contended were as follows.

- (a) The first-instance judgment did not determine the relevant commodity market in this case, so the basic facts of the case were not clearly established.
- (b) The basic method used in the first-instance judgment to analyze the relevant commodity market was incorrect. Hypothetical monopolist testing (that is, an SSNIP test) should not have been directly applied in this case to free-of-charge products to define the relevant market. The relevant commodity market in this case should be defined as PC-related IM software and services that integrate text, voice and video.
- (c) The determination of the relevant geographical market at first instance was obviously incorrect. The relevant geographical market in this case should be mainland China.
- (d) The finding at first instance that Tencent did not possess a dominant position in the relevant market was incorrect. Tencent's share in the relevant market was more than half and thus it should be presumed to possess a dominant market position.

- (e) Tencent had abused its dominant position in the market and should bear legal liability according to law.

Held: On October 8, 2014, the Supreme People's Court delivered its judgment, in which it dismissed the appeal and affirmed the decision at first instance.

Reasoning: Based on the grounds of appeal, the Supreme People's Court summarized 22 specific controversial issues in terms of five aspects and analyzed each of the issues individually. In particular, with respect to the role, purpose and method of defining the relevant market, the Court approached the analysis of the traditional Anti-Monopoly Law creatively in its judgment, given the unique features of the Internet sector, and gave an innovative answer on the method of defining a relevant market in the global arena. For example, on the issue of whether it is necessary to define a relevant market in resolving a monopoly dispute related to abuse of dominant market position, the industry widely recognizes that accurate definition of such is a prerequisite to determining dominant market position, as expressed in the traditional analytical model "Relevant market – Market power – Competition effects", or "R–M–C". The Supreme People's Court reviewed the purpose and role of the relevant market based on the characteristics of Internet trading, and it eloquently illustrated the tools that can be used to define the relevant market, proposing the models "Market power – Competition effect" (or "MC") and "Conduct – Competition effect" (or "CC") for analysis that can be conducted independently of the determination of relevant market.

The Supreme People's Court held that the focus of dispute involved in this case mainly centered on:

- I. how to define the relevant market in this case;
- II. whether or not the respondent possessed a dominant market position; and
- III. whether or not the respondent's act constituted abuse of dominant market position and other aspects that are prohibited under the Anti-Monopoly Law.

I. How to define the relevant market in this case

The focal point of the dispute can be further divided into numerous specific issues, which can be summarized as follows.

First of all, it is not necessary to define the relevant market clearly in each and every case involving abuse of dominant market position. In general, competition occurs and is pursued within the scope of a certain market. Defining the relevant market can define the market scope and the competition constraints that business operators face. In a case alleging abuse of dominant market position, a reasonably defined relevant market is of great importance in correctly identifying the business operator's market position, analyzing the influence of the business operator's behavior on market competition, judging whether the business operator's acts are illegal or not, and determining the legal liabilities and other key issues in the event that violations are established. Therefore, in handling antitrust cases, defining the relevant market is usually an important analytical step. Nevertheless, a clear definition of the relevant market depends on the specific circumstances of the case – particularly, the evidence, the availability of relevant data and the complexity of competition in the relevant field. In handling cases alleging abuse

of dominant market position, defining the relevant market is nothing more than a tool for assessing the business operator's dominant market position and the influence of the allegedly monopolistic act on the competition; it is not the purpose in itself. In the absence of a clearly defined relevant market, the possible market impact of the business operator's market position and allegedly monopolistic act may be assessed with reference to direct evidence of elimination of or barriers to competition. In this case, however, the court of first instance actually defined the relevant market. Because its boundary in this case is ambiguous, the court merely analyzed the possibility of there being a boundary without arriving at any definite conclusion on where it might lie. In view of this, Qihoo's grounds for appeal that the failure of the first-instance court to clearly define a relevant commodity market in this case was a failure to establish the basic facts of the case could not be supported.

Secondly, on the issue of whether the HMT method of analysis can be applied to commodities offered free of charge, the effective judgment held as follows.

- (a) As an analytical way of defining the relevant market, it is assumed that HMT is universally applicable. In practice, there are several such tests that can be conducted, using either the SSNIP or the SSNDQ methods. At the same time, it is assumed that HMT can be conducted using both qualitative and quantitative methods when conditions permit, in practice.
- (b) In practice, choosing the HMT method depends on the specific field of market competition involved in the case and the relevant data available. If the homogeneity of commodities in a particular

market field is pronounced and if price competition is a relatively important form of competition, it is more feasible to adopt the SSNIP method. However, in a field in which product differentiation is obvious and in which competition based on non-price factors such as quality, service, innovation, consumer experience and so on become important, it will be difficult to adopt the SSNIP method. Using the SSNIP method is particularly difficult when the market equilibrium price of commodities in a particular field is zero. When using the SSNIP method, it is usually necessary to determine the appropriate benchmark price and to increase the price by between 5 and 10 percent to determine the consumer's reaction. Where the benchmark price is zero, price increases of 5 and 10 percent will still be zero. If the price is increased from zero to a smaller positive price, it will be equivalent to an indefinite price increase, which will mean that the characteristics of commodities or business models have undergone major changes, making it difficult to conduct the SSNIP test.

- (c) In terms of the applicability of HMT in this case, Internet service providers are placing greater emphasis on competing on the basis of quality, service and innovation rather than price. In circumstances in which a free-of-charge Internet-based IM service has existed for a long time and has become a pervasive business model, users are highly sensitive to price. Changing from toll-free tactics to charging even a small amount can result in a massive reduction in the number of users. Likewise, such a change also means a major shift in the

characteristics of the commodity and the business model – that is, changing from free goods to paid goods and from an indirect profitability model to a direct profitability model. Under such circumstances, if HMT based on relative increase in price were to be adopted, it would be likely to include non-substitutable commodities within the relevant market, resulting in an overly broad definition of the relevant market. Thus HMT based on relative increase in price is not entirely suitable for this case. Although it is difficult to fully apply HMT based on relative increase in price in this case, alternatives to this method remain available, such as HMT based on decrease in quality. Because it is difficult to assess quality degradation and to obtain relevant data, HMT based on decrease in quality can be used for qualitative analysis rather than quantitative analysis.

Thirdly, in relation to whether the relevant market in this case should be identified as Internet application platforms, Qihoo asserted that Internet application platforms have nothing to do with defining the relevant market in this case. Tencent argued that Internet competition is actually competition among platforms and that the scope of the relevant market in this case goes far beyond the IM services market. In light of the special features of competition among Internet platforms, the effective judgment examined the ways of considering these in defining the relevant market and held as follows.

- (a) To some extent, general competition on the Internet does have the same features as competition specifically among platforms. When the

allegedly monopolistic act occurred, the specific features of Internet platform competition became obvious. Operators enter the Internet arena at a particular point of access for the purpose of playing an intermediary role for different types of consumer with different demands, aiming to create value.

- (b) In terms of whether the relevant commodity market in this case should be identified as Internet application platforms, the key issue lies in whether the competition between network platforms for users and advertisers completely crosses the boundary determined by the characteristics of products or services and imposes enough competitive constraints on the business operators. The answer to this question ultimately depends on empirical testing. In the absence of definitive empirical data, attention shall be paid to at least the following aspects.
- (i) Competition between Internet application platforms for user and advertiser attention is based on the critical core products or services they provide.
 - (ii) The critical core products or services offered on an Internet application platform may differ in terms of attributes, features, functions and usages. Although advertisers may care not about differences in these products or services, but about prices and the effectiveness of advertisements, and although, from their perspectives, different Internet application platforms may be considered to be alternatives to each other, the majority of users are very unlikely to consider the products or services of different platforms that have completely

different functions and uses to be effective alternatives to each other. A user trying to find out about the life of a historical figure, for example, typically uses a search engine, not IM, and would hardly ever imagine that the two might be equally effective.

- (iii) Differences in the characteristics, functions and uses of the critical core products or services of Internet application platforms suggest that there may be differences between the major groups of users and advertisers for whom they compete. There are therefore likely to be obvious differences in the mode of obtaining economic benefits, targeting user groups and cross-selling other products.
- (iv) In this case, the focus should be on whether Tencent has taken advantage of its potential dominant market position in the field of IM to eliminate or block competition in Internet security software, and hence has extended its dominant market position in the field of IM into the field of security software, and whether this competitive process occurs more often for non-paying users.

For these reasons, the nature of competition among Internet platforms is not considered a major factor in defining the relevant market in this case.

- (c) In terms of how to consider the competitive features among Internet enterprise platforms in this case, the purpose of defining the relevant market is to clarify the constraints to competition that business operators face, to reasonably determine their market position and to judge accurately the impact of their actions

on market competition. Even if the features of competition among Internet platforms are not considered at the stage of defining the relevant market, due consideration can still be given to such a feature in recognizing the business operator's (dominant) market position. Therefore, in this case, failure to consider features of competition among Internet platforms while defining the relevant market does not imply that the court ignored these features, but rather that it took the features into consideration in a more appropriate way.

Finally, in terms of the issues that need to be clarified when defining the relevant geographical market for IM services, the effective judgment held that defining the relevant geographical market in this case should begin with the target market for the IM services in mainland China. Because Internet-based IM services can be delivered at low cost and can be made available to or cover the entire world without additional or noteworthy shipping costs, price costs or technical hurdles, the actual area in which the majority of users select the goods, the legal and regulatory jurisdiction, the status of overseas competitors and the time when the competitors entered the relevant market will be considered in defining the relevant geographical market. Because none of these factors is decisive, the court is required to assess them comprehensively.

(a) The vast majority of users in mainland China choose to use IM services provided by business operators based in mainland China. Users in mainland China do not pay much attention to international IM products.

- (b) China's Internet-related administrative rules and regulations clearly set out the requirements and conditions for operating IM services. China implements a system of administrative license for value-added telecommunications services such as IM. Foreign business operators usually cannot directly enter the mainland China market; to do so, such an operator must establish a joint venture with a Chinese partner and obtain a corresponding administrative license.
- (c) In terms of the actual situation of IM services operators located overseas, prior to the filing of this antitrust case most international IM operators, such as MSN, Yahoo, Skype, Google and so on, entered the market in mainland China by means of joint ventures. Therefore, when the allegedly monopolistic act took place, there were very few major international IM services operators that had not yet entered mainland China. If the quality of IM services in mainland China had decreased, there would have been a few overseas IM service operators available from among which domestic users could choose.
- (d) It is quite difficult for overseas IM service operators to enter mainland China in a relatively short period of time (such as a year) and to develop enough market share to restrict the scale of domestic operators. Overseas IM services operators need first to establish a joint venture, and then to satisfy a series of licensing conditions and to obtain appropriate administrative licenses, which, to a certain extent, delays the foreign business operator's entry.

In summary, the court found that the relevant geographical market in this case should be mainland China.

Based on other evidence and the facts of the case, the relevant market was to be defined as the IM market in mainland China, including both PC-based and mobile-based IM services, as well as both integrated IM services and non-integrated IM services, such as text, audio and video.

II. Whether or not the respondent possesses a dominant market position

With respect to the position and role played by a business operator's share in the relevant market in determining its market power, the effective judgment held that this must be determined according to the specific circumstances of the case. In general, the greater the market share and the longer its duration, the more likely it is to indicate the existence of dominant market position. However, market share is only a relatively crude and potentially misleading indicator of dominant market position. Under circumstances in which the market is relatively easy to enter, or high market share stems from a business operator's higher market efficiency or provision of better products, or products originating outside the market impose a strong competitive constraint on business operators, then high market share does not directly imply the existence of a dominant market position. In particular, competition in the Internet environment is highly dynamic. The boundaries of the relevant market are far less clear than those of markets in traditional fields. In this case, the role of market share as an indicator of dominant market position ought not to be overestimated;

instead, more attention should be paid to the operator's entry into the market, its market behavior and the impact of competition, as well as other specific facts and evidence that might help to reveal a dominant market position.

Combining all of these ideas, the effective judgment considered and analyzed whether Tencent possessed a dominant position in the market based on aspects such as market share, competitive conditions in the relevant market, its capacity to control price, the volume or other trading conditions of goods or the business operator's financial and technical conditions, the degree of dependency of other business operators on Tencent with respect to transactions and the degree of difficulty with which other business operators enter the relevant market – especially the fact that when Tencent forced its users to choose between its own QQ and Qihoo's 360 on November 3, 2010, the number of users that month of MSN, one of Tencent's competitors, increased by 23 million and many IM services competitors entered the field. The Court eventually found that the evidence submitted in this case was not sufficient to support a conclusion that Tencent had dominant market position.

III. Whether or not the respondent's act constitutes abuse of dominant market position and other aspects that are prohibited under the Anti-Monopoly Law

The effective judgment broke from the traditional "three-step" approach of analyzing the abuse of dominant market position and adopted a more flexible analytical procedure. It considered that, in principle, if the accused business operator does not have a dominant

market position, it is not necessary to analyze whether it has abused its dominant market position and it can be straightforwardly determined that its act does not constitute abuse of dominant market position as prohibited by the Anti-Monopoly Law. However, when the relevant market boundary is vague and it is not clear whether or not the accused business operator possesses a dominant market position, the effect of the allegedly monopolistic act on competition may be further analyzed to test whether the conclusion regarding dominant market position is correct or not. In addition, even if the accused business operator possesses a dominant market position, to assess whether the act constitutes abuse of dominant market position, it is necessary to comprehensively evaluate the negative and potential positive effects that such an act has on consumers and competition to further judge its legitimacy. In this case, such consideration has two main aspects, as follows.

(a) Whether Tencent's imposition of "product incompatibility" (whereby the user had to choose one of two products) constituted a restrictive trade practice, as prohibited under the Anti-Monopoly Law According to the provisions of article 17 of the Anti-Monopoly Law, any act of a business operator with market dominance that requires a party to trade exclusively with itself or to trade exclusively with a designated business operator(s) without any justifiable cause shall constitute abuse of dominant market position. Qihoo claimed that Tencent's act forcing users to stop using or to uninstall Qihoo's software constituted an abuse of its market dominant position aiming to restrict trade, as prohibited under the Anti-Monopoly Law. In this respect, the

effective judgment held that although Tencent's act of "product incompatibility" caused inconvenience to the user, it did not result in the obvious effect of eliminating or restricting competition. Such a result not only demonstrates that Tencent's act of "product incompatibility" did not constitute abuse of market dominant position, as prohibited by the Anti-Monopoly Law, but also supports the conclusion that Tencent did not possess the dominant market position.

(b) Whether Tencent's act constituted a bundling, as prohibited under the Anti-Monopoly Law According to the provisions of article 17 of the Anti-Monopoly Law, an act of a business operator with market dominance that bundles products or imposes unreasonable conditions at the time of trading without any justifiable cause shall constitute abuse of dominant market position. Qihoo claimed that Tencent tied its QQ Software Housekeeper to its IM software and installed QQ Doctor under cover of upgrading QQ Software Housekeeper. Such acts were contrary to conventional trading, consumption habits or commodity functions and restricted the consumer's right to choose, without any justifiable cause. However, the Supreme People's Court found that the first-instance court erred in its allocation of the burden of proof with regard to the effect caused by the alleged bundling of products of blocking or restricting competition. In this respect, the Court held that Qihoo's appeal against Tencent's abuse of dominant market position was not well grounded.

C. Determination of an operator's dominant market position

If an operator – as the sole operator engaged in a legitimate cable television transmission business, as well as the entity engaged in the centralized control of television broadcasting in a specific area – has advantages in market access, market share, operating status, operation scale and other elements, it may be found to have a dominant market position.

If the operator were to take advantage of its dominant market position and bundle a basic maintenance fee for receiving digital television programs with the fee for paid digital television programs, then collect the two fees together from a consumer, this would infringe the consumer's right of choice and disadvantage competing service providers. Even though there exist exceptional cases in which the operator charges these two fees separately, the courts will find it unconvincing should an operator argue that such fees do not constitute a bundled sale as prohibited under the Anti-Monopoly Law.

WU XIAOQIN V. SHAANXI BROADCAST & TV NETWORK INTERMEDIARY (GROUP) CO., LTD.
(2016) ZGFMZ No. 98, SPC

Cause of action:

Dispute over a bundled transaction

Collegial panel members:

Wang Yanfang | Qian Xiaohong | Du Weike

Keywords:

bundled transaction, dominant market position, monopoly, operator

Relevant legal provisions:

Anti-Monopoly Law of the People's Republic of China, article 17(1)(v)

Basic facts: Wu Xiaoqin alleged that, when he paid the basic maintenance fee for receiving digital television programs to Shaanxi Broadcast & TV Network Intermediary (Group) Co., Ltd. (hereinafter "BC & TV Company") on May 10, 2012, he learned that this fee had been adjusted from RMB25 per month to RMB30 per month. Wu Xiaoqin paid RMB90 for three months, comprising RMB75 as the basic maintenance fee for receiving digital television programs and RMB15 as the fee for a package of digital television programs. Afterwards, Wu Xiaoqin learned that subscribers should be able to freely choose and voluntarily subscribe to packages of digital programs. Wu Xiaoqin believed that, as a public utility enterprise, BC & TV Company had a dominant position in the digital television market, and its charging of the second fee deprived him of the right of choice and constituted a bundled sale. He consequently filed a lawsuit in which he asked the Intermediate People's Court of Zi'an City, Shaanxi Province, to nullify BC & TV Company's charging of the package fee of RMB15 paid on May 10, 2012, and to order BC & TV Company to refund him RMB15.

BC & TV Company contended that it was consistent with the Anti-Monopoly Law of the People's Republic of China for it, the centralized broadcaster of television programs in Shaanxi Province, to charge fees to those consumers who chose to receive programs beyond the basic ones. BC & TV Company had a dominant position in the provincial cable television market and encouraged subscribers to choose cable television packages, but it did not abuse its dominant market position or force its subscribers to buy service items beyond basic television program services. The subscribers had the right of free choice; the finding of monopolistic conduct

was an administrative power rather than a judicial one. BC & TV Company asserted that Wu Xiaoqin had no right to request the invalidation of monopolistic conduct: although BC & TV Company had launched a series of television program packages from among which subscribers could choose according to their individual needs, it had never made any compulsory bundled sale and it guaranteed most people's right to choose more television programs. BC & TV Company therefore asked the court to dismiss Wu Xiaoqin's claim to invalidate BC & TV Company's increased number of television programs and charge of fees, and it was willing to actively resolve Wu Xiaoqin's second claim.

In the course of proceedings, the court found that, when Wu Xiaoqin paid the basic maintenance fee for receiving digital television programs to BC & TV Company on May 10, 2012, he learned that the minimum monthly basic maintenance fee for receiving the programs had increased from RMB25 to RMB30. Wu Xiaoqin paid RMB90 as the basic maintenance fee for receiving digital television programs for the period from May 10 to August 9, 2012. The special invoice issued by BC & TV Company to Wu Xiaoqin recorded RMB75 as the basic maintenance fee for receiving digital television programs and RMB15 as the fee for a package of paid digital television programs. Afterwards, Wu Xiaoqin consulted BC & TV Company's customer service center (service telephone: 96766) and learned that BC & TV Company's program update had added various paid programs in different packages, the cheapest of which cost RMB360 per year, with each installment payable by subscribers for at least three months. With the approval of the People's Government of Shaanxi Province, BC & TV Company was the only operator engaged in the legitimate

operation of the cable television transmission business and the only entity engaged in the centralized broadcast control of television programs within Shaanxi Province. BC & TV Company admitted its dominant position in the cable television transmission business within Shaanxi Province.

The court also found that, as prescribed in the Interim Measures for the Administration of Basic Maintenance Fees for Receiving Cable TV Programs issued by the National Development and Reform Commission and the State Administration of Radio, Film and Television on December 2, 2004, the basic maintenance fee for receiving cable television programs shall be priced by the government and the fee rates shall be set by the pricing authorities. As prescribed in the Several Opinions on Promoting the Integral Transition of Cable TV Digitalization by Pilot Entities (for Trial Implementation) issued by the State Administration of Radio, Film and Television on July 11, 2005, in the process of promoting the overall transition, all pilot entities shall pay attention to the promotion of paid channels and other new business so that subscribers can freely choose among and voluntarily subscribe to them. As provided in the Notice on the Standards of Basic Maintenance Fees for Receiving Digital TV Programs across the Province issued by the Pricing Bureau of Shaanxi Province on May 29, 2006, the standard basic maintenance fee for receiving digital TV programs was based on one terminal per residential television set; the maintenance fee for each terminal for urban residential subscribers at or above the county level across the Province was RMB25 per month and subscribers to digital cable television programs were, according to their actual circumstances, permitted to choose to pay the basic maintenance fees for receiving television

programs on a monthly, quarterly or annual basis. As outlined in the Notice on Issues Concerning Strengthening the Administration of Fee Charging of Cable TV Programs issued by the National Development and Reform Commission and the State Administration of Radio, Film and Television on August 25, 2009, the basic maintenance fees for receiving cable television programs shall be priced by the government, and the fee rates of value-added cable television business services and paid packages of digital television programs shall be set by the cable television operators themselves.

At second instance, before the Higher People's Court of Shaanxi Province, BC & TV Company submitted photocopies of four special invoices for charges, proving that, around May 10, 2012, the outlet of BC & TV Company collected a monthly service fee at RMB25. Given the absence of originals, Wu Xiaojin refused cross-examination. After the hearing, BC & TV Company submitted the originals of three of the invoices, which both parties verified and cross-examined. All of these invoices showed that the annual payment was RMB300 – that is, RMB25 per month. BC & TV Company submitted the originals of five invoices, including the originals of the three invoices submitted during the first instance, all transacted in Xianyang City. They proved that, around May 10, 2012, BC & TV Company provided paid services for RMB25 per month.

On appeal to the Supreme People's Court, BC & TV Company submitted screenshots of fee packages on its website as of 2016, the Notice on Issuing the Measures for the Implementation of Public Business in 2016 (for Trial Implementation) and the 2016 invoices of some subscribers.

Held: On January 5, 2013, the Intermediate People's Court of Xi'an City, Shaanxi Province, rendered its judgment ((2012) XMSCZ No. 438) in which it:

- (a) affirmed that BC & TV Company invalidly charged Wu Xiaojin RMB15 on May 10, 2012, as a digital television fee; and
- (b) ordered BC & TV Company, within 10 days after the judgment's effective date, to refund Wu Xiaojin RMB15.

BC & TV Company appealed on September 12, 2013, and the Higher People's Court of Shaanxi Province delivered a judgment ((2013) SMSZZ No. 38) in which it overturned the judgment at first instance and dismissed Wu Xiaojin's claims.

Dissatisfied with the second-instance judgment, Wu Xiaojin appealed to the Supreme People's Court. On May 31, 2016, the Supreme People's Court delivered its judgment, in which it:

- (a) revoked the second-instance judgment of the Higher People's Court of Shaanxi Province; and
- (b) affirmed the first-instance judgment of the Intermediate People's Court of Xi'an City, Shaanxi Province.

Reasoning: In the effective judgment, the Supreme People's Court focused on:

- I. whether the disputed conduct violated article 17(1)(v) of the Anti-Monopoly Law of the People's Republic of China; and
- II. whether the court of first instance appropriately applied the Anti-Monopoly Law.

I. Whether the disputed conduct violated article 17(1)(v) of the Anti-Monopoly Law

Article 17(1)(v) of the Anti-Monopoly Law prohibits a business operator with a dominant market position from implementing a bundled sale or imposing other unreasonable conditions at the time of trading without justifiable cause. In its defense at first instance, BC & TV Company had explicitly conceded that it was the only business operator that was legally engaged in the cable television transmission business within Shaanxi Province, with the approval of the People's Government of Shaanxi Province. As the centralized broadcaster of television programs in Shaanxi Province, BC & TV Company affirmed that it had a dominant position in the provincial cable television market and had encouraged subscribers to choose cable television packages, but argued that it did not abuse its dominant market position or force its subscribers to buy service items beyond basic television program services. Denying at second instance that it had made this statement, BC & TV Company failed to produce corresponding evidence proving that it did not have a dominant market position. In the process of examination on appeal, BC & TV Company raised no objection to the fact found by the courts of first and second instances that it had a dominant market position. Given that BC & TV Company was the only legal operator engaged in cable television transmission business and the centralized broadcaster of television programs within Shaanxi Province, and on the basis of the facts found, the Supreme People's Court found that the courts of first and second instances did not err in recognizing that, in the cable television transmission business market, BC & TV Company was advantaged in terms of access, market share, operating status, scale of

operation and other elements, and had the dominant market position.

As to whether BC & TV Company made a bundled sale while serving Wu Xiaoqin, article 17(1)(v) of the Anti-Monopoly Law prohibits a business operator with a dominant market position from engaging in bundling without justifiable cause. In this case, according to the facts found by the first- and second-instance courts, when providing services, the personnel of BC & TV Company notified Wu Xiaoqin that, from March 2012, the minimum monthly fee rate had risen from RMB25 to RMB30, with each installment payable for at least a quarter; however, they failed to notify Wu Xiaoqin that he may pay the basic maintenance fee for receiving digital television programs or the fee for paid digital television programs separately. Afterwards, Wu Xiaoqin consulted BC & TV Company's customer service center (service telephone: 96766) and learned that BC & TV Company's program update increased the number of paid programs with various packages, the cheapest of which cost RMB360 per year (RMB30 per month), with each installment payable for at least three months. According to these facts and in light of the chargeable items recorded on the special invoices issued by BC & TV Company to Wu Xiaoqin (that is, RMB75 for the basic maintenance fee for receiving digital television programs and RMB15 for a package of paid digital television programs), it could be established that BC & TV Company actually tied the basic digital television programs to the paid digital television programs and sold them together to Wu Xiaoqin without notifying Wu Xiaoqin whether or not he could choose separately to receive only the basic digital television programs. In addition, the reply of BC & TV Company's customer service center (service telephone: 96766) also corroborated

that BC & TV Company had bundled the basic maintenance fee for receiving digital television programs and the fee for paid digital television programs, and had provided the two services together. Although, at second instance, BC & TV Company submitted relevant documents evidencing its separate charge of the basic maintenance fee for receiving digital television programs from other subscribers, such evidence could prove only that, when BC & TV Company collected such charge, there were exceptions to the package detailed by the customer service center. On appeal, BC & TV Company failed to make reasonable explanations of these exceptions. Furthermore, BC & TV Company's submission of receipts in which the relevant fees were separately charged occurred after this lawsuit was instituted, which was insufficient to prove the circumstances of the lawsuit and hence was not admitted. Therefore, the customer service center's explanation of exceptions to the package was insufficient to contradict BC & TV Company's common practice of bundling the basic maintenance fee for receiving digital television programs with the fee for paid digital television programs. The determination of the court of second instance that BC & TV Company provided not only portfolio services, but also basic services, was insufficiently evidenced and was to be corrected. Therefore, the existing evidence could not prove that an ordinary consumer could pay only the basic maintenance fee for receiving digital television programs or the fee for paid digital television programs, or that there existed for consumers a right of choice. Without proving the availability of a right of choice, the court of second instance straightforwardly concluded that this case was about the failure to inform the consumer of his right of choice and thus about the infringement of his right to

know. On this basis, the second-instance court held that BC & TV Company's sale did not constitute a bundled sale without justifiable cause, as provided for under the Anti-Monopoly Law. The Supreme People's Court held that this decision at second instance had no basis in fact or law and was to be corrected.

In accordance with the facts found on appeal, the basic maintenance fee for receiving digital television programs and the fee for paid digital television programs were fees for two separate services. At first and second instances and on appeal, BC & TV Company failed to prove that the combined provision of both services conformed to the conventional trading practices relating to digital television services. Moreover, there was no evidence proving that separating the charges of the basic maintenance fee for receiving digital television program and the fee for paid digital television programs would impair the performance and usage value of these two services nor did BC & TV Company state a justifiable cause for its conduct. Under these circumstances, by taking advantage of its dominant market position, BC & TV Company's combined charging of the basic maintenance fee for receiving digital television programs and the fee for paid digital television programs objectively affected the consumer's right to choose relevant paid digital television programs provided by other service providers, disadvantaged other service providers attempting to access the television services market and had negative impact on market competition. On appeal, the Court held that the court of first instance did not err in holding that BC & TV Company's conduct violated the provisions of article 17(1)(v) of the Anti-Monopoly Law. Some grounds of Wu Xiaoqin's application were therefore tenable and upheld.

II. Whether the court of first instance appropriately applied the Anti-Monopoly Law

In its defense in this case, BC & TV Company contended that this case was, in essence, a dispute over whether the right enjoyable by Wu Xiaoqin under the Law on the Protection of Consumer Rights and Interests was infringed, which was irrelevant to monopolistic conduct. BC & TV Company argued that the court of first instance should not have affirmed its dominant market position and invalidated its charges in accordance with the Anti-Monopoly Law and relevant provisions. Under articles 226 and 228 of the Interpretation of the Supreme People's Court on the Application of the Civil Procedure Law of the People's Republic of China, the courts shall, as per the claims and answers of the parties, as well as the circumstances revealed by the exchange of evidence, sum up disputes and consult the parties on that summing-up. The courts shall focus the trial on issues such as the facts disputed by the parties, the evidence and the application of the law. According to the facts found, Wu Xiaoqin's complaint was clearly stated as:

The digital TV program fee charged by the defendant was actually an additional service provided to the plaintiff beyond the scope of the aforesaid services, which the plaintiff should have the right to autonomously choose. The defendant, as a utility enterprise or other operator enjoying a lawful exclusivity, had a dominant position in the digital TV market. The aforesaid conduct of the defendant violated Article 17(1)(v) of the Anti-Monopoly Law which provides that "a business operator with a dominant market position shall not

abuse its dominant market position to conduct the ... acts of tying products or imposing unreasonable trading conditions at the time of trading without justifiable cause," and thus impaired the lawful rights and interests of the plaintiff. The Plaintiff instituted a civil lawsuit in accordance with the Provisions of the Supreme People's Court on Several Issues concerning the Application of Law in the Trial of Civil Dispute Cases Arising from Monopolistic Conduct and requested the people's court to invalidate the defendant's bundled transaction according to the law and order it to refund the plaintiff RMB 15.

In that complaint, Wu Xiaoqin did not allege that his consumer rights and interests were impaired; hence, the court of first instance did not err in applying the Anti-Monopoly Law to Wu Xiaoqin's claims.

In conclusion, the Supreme People's Court held that BC & TV Company had a dominant market position in the cable television transmission services market within Shaanxi Province. Bundling services for receiving digital television programs with packages of digital television programs and selling them together to Wu Xiaoqin violated article 17(1)(v) of the Anti-Monopoly Law. Wu Xiaoqin's request, on appeal, to invalidate BC & TV Company's charge of RMB15 for digital television programs and to have the RMB15 refunded were tenable. The first-instance judgment was clear in its finding of facts and correct in its application of law, and was to be affirmed. The second-instance judgment was insufficient in its factual basis and wrong in its application of law, and was to be corrected.

D. Applicability of article 2 of the Law against Unfair Competition and the boundaries among technological innovation, free competition and unfair competition in the context of Internet-based markets

Operators shall comply with the principles of voluntariness, equality, fairness, integrity and good faith in market transactions and shall practice generally recognized business ethics. Such principles also apply to Internet-based markets.

The key to determining whether a behavior constitutes unfair competition is whether it violates the principle of integrity and good faith, as well as generally recognized business ethics in the Internet industry, and whether it harms the legitimate rights and interests of others.

Technological innovation can stimulate competition, which in turn can further promote technological innovation. Neutral as it is of itself, technology can also be used as a tool to promote *unfair* competition. Technological innovation should be wielded as a tool for fair and free competition, rather than as an excuse to interfere with the legitimate business models of others.

QIHOO AND QGOA V. TENCENT TECHNOLOGY AND TENCENT COMPUTER (2013) MSZZ No. 5, SPC

Cause of action:

Dispute alleging unfair competition

Collegial panel members:

Wang Chuang | Wang Yanfang | Zhu Li

Keywords:

fair competition, integrity and good faith, Internet markets, technological innovation, unfair competition

Relevant legal provisions:

Law of the People's Republic of China against Unfair Competition (as published in 1993), articles 2, 14 and 20

Basic facts: In a dispute alleging unfair competition between Beijing Qihoo Technology Co., Ltd. (hereinafter “Qihoo”) and QGOA Software (Beijing) Co., Ltd. (hereinafter “QGOA”) against Tencent Technology (Shenzhen) Co., Ltd. (hereinafter “Tencent Technology”) and Shenzhen Tencent Computer Systems Co., Ltd. (hereinafter “Tencent Computer Systems”), Qihoo and QGOA had developed KouKou Bodyguard security software to specifically target Tencent's QQ IM software, had publicized on relevant websites that KouKou Bodyguard could comprehensively protect the security of QQ users and had offered the software for download. Once installed, the KouKou Bodyguard software ran an automatic inspection of the QQ software and then displayed messages such as: “The inspection score is 4, and QQ has a serious health problem”; “In total 40 items have been tested. 31 of them have problems. It is suggested to repair immediately! and run inspection again”; and “While running, QQ will scan the files on your computer (Tencent calls it a security scan); you can prohibit QQ from scanning your files and avoid breach of your privacy.” Meanwhile, it reminded users of serious problems with QQ in red fonts, offered one-click repair help in a green font and listed certain QQ items as “dangerous” in terms such as: “Your computer is in danger as 360 Safeguard has not been installed; upgrade QQ Security Center;

and prevent QQ from scanning my files.” While searching for and killing Trojans in QQ, KouKou Bodyguard would display a message reading, “If you do not install 360 Safeguard, you will be unable to use Trojan search and kill function”, and accompany this with a green button with which to download and install 360 Safeguard. After performing the one-click repair, KouKou Bodyguard would replace QQ’s secure communication interface with the KouKou Bodyguard interface.

On June 10, 2011, Tencent Technology and Tencent Computer Systems filed a lawsuit claiming that Qihoo’s and QGOA’s conduct constituted unfair competition. At first instance, the Higher People’s Court of Guangdong Province held that KouKou Bodyguard, which Qihoo and QGOA developed specifically to target QQ software, destroyed the security and integrity of the legitimately running QQ software and services, deprived Tencent Technology and Tencent Computer Systems of opportunities to deliver legitimate value-added services, such as advertisements and games, among other things, and thereby earn income, and replaced some functions of the QQ software, promoting Qihoo’s and QGOA’s own products by altering QQ’s functional interface, which conduct violated the principle of integrity and good faith, and that of fair competition, and constituted unfair competition. Qihoo and QGOA willfully fabricated and distributed false information about Tencent Technology’s and Tencent Computer Systems’ operations, which damaged their commercial reputation and goodwill, and constituted commercial disparagement. The court ordered that Qihoo and QGOA were to make a public apology, mitigate the negative effect of their acts, and jointly and severally indemnify Tencent Technology and Tencent Computer

Systems in the sum of RMB5 million in total for economic losses and reasonable enforcement expenses.

Dissatisfied with this judgment, Qihoo and QGOA applied for permission to appeal to the Supreme People’s Court.

Held: The Supreme People’s Court delivered its judgment on February 18, 2014, disallowing the appeal and affirming the decision at first instance.

Reasoning: In the appeal proceedings, the Supreme People’s Court opined that, in market competition, operators can usually select their preferred commercial model freely according to the demands of the market and consumers, and that this freedom is a necessary requirement of a market economy. To seek market benefit, Tencent Technology and Tencent Computer Systems had developed their QQ software, had built a comprehensive Internet business platform around it, and had provided IM services free of charge to attract relevant consumers to experience and use their value-added services and relevant advertisers to promote their goods or services on the platform, so as to create business opportunities and obtain relevant advertising income. Such a business model of combining a free platform with advertisement or value-added services was a common operational model in the Internet industry at the time when the dispute in this case occurred and also conformed to the characteristics of the developing Internet market in China. In fact, Qihoo and QGOA also used this business model. This business model did not violate the principles and spirit or the prohibitive provisions of the Law of the People’s Republic of China against Unfair Competition; it was appropriate to protect the right of Tencent Technology and Tencent Computer Systems to seek

commercial benefit, and to ensure that others should not damage their legitimate rights and interests without justification.

Qihoo and QGOA developed and operated KouKou Bodyguard specifically to target QQ software, destroying the security and integrity of QQ software and its services by aiding and abetting, reducing Tencent Technology's and Tencent Computer Systems' economic income and opportunities for value-added service transactions, disturbing their proper operational activities, and harming their legitimate rights and interests. "Fair competition" can be defined as honest competition among competitors exerting appropriate efforts. "Unfair competition" can be defined as seeking competitive advantage without exerting effort or by unfairly exploiting others' market achievements for one's own business opportunities, so as to obtain competitive advantage. While operating KouKou Bodyguard, Qihoo and QGOA embedded their own products and services into the interface of QQ software, and replaced some functions of Tencent Technology's and Tencent Computer Systems' QQ software. Their fundamental purpose was to sell and promote 360 Safeguard by relying on the huge group already using QQ software and by disparaging QQ software and its services, so as to increase the market transaction opportunities of Qihoo and QGOA, and thereby obtain competitive advantage in the market. In essence, such behavior is an improper use of others' market achievements for one's own business opportunities, so as to obtain competitive advantage. Thus Qihoo's and QGOA's behavior violated the principles of integrity and good faith, and that of fair competition, and constituted unfair competition.

Issues regarding the boundaries among technological innovation, free competition and unfair competition

Qihoo contended that its behavior manifested the free and innovative spirit of the Internet, and that the court of first instance had violated the laws of industrial development and oppressively applied the general principles of the Law against Unfair Competition in ways that would restrict competition and discourage innovation. The Supreme People's Court held that the development of the Internet relies on free competition, and on scientific and technological innovation. The encouragement of free competition and innovation in the Internet industry does not mean that the Internet is an arbitrary space beyond the law; freedom of competition and innovation must be bound by the principle of not infringing others' legitimate rights and interests. Furthermore, the sound development of the Internet shall be guaranteed by an orderly market environment and clear rules for market competition. Whether a behavior is free competition and innovation encouraged by the spirit of the Internet needs to be determined on the basis of whether it helps to establish a system of equal and fair competition, and whether it conforms to the consumers' general interests and the public interest. Mere technological progress cannot be regarded as free competition and innovation; otherwise, anyone may arbitrarily interfere with others' technological products or services under the guise of technological progress and innovation, which will create a "law of the jungle". Technological innovation may stimulate competition, which in turn can further promote technological innovation. Neutral as it is, technology can also

become a tool of unfair competition. Technological innovation should be a tool of fair and free competition, rather than an excuse to interfere with the legitimate business models of others. In this case, Qihoo had specifically developed KouKou Bodyguard to deeply interfere with Tencent's QQ software purportedly in the name of technological innovation, which can hardly be found to comply with the Internet's spirit of freedom and innovation. Hence the Supreme People's Court did not support Qihoo's and QGOA's grounds for appeal.

E. Review and application of interim injunctions in cases alleging infringement of trade secrets

The revised Civil Procedure Law of the People's Republic of China, as amended in 2012, provides for the application of a preliminary injunction to allow the holder of a trade secret to seek the remedy in a timely and effective manner. Before granting such an injunction, the courts shall consider factors such as the likelihood that the applicant will win their case, the substantial danger of irreparable harm being caused to the applicant should the injunction be denied, the extent of the potential harm that may be caused to the applicant in comparison with that which may be caused to the respondent and the extent to which such an injunction may infringe upon the public interest.

ELI LILLY AND COMPANY AND LILLY (CHINA) RESEARCH AND DEVELOPMENT CO., LTD. V. HUANG MENGWEI

(2013) HYZMW(Z) CZ No. 119, Shanghai No. 1 Intermediate People's Court

Cause of action:

Dispute over infringement of trade secrets

Collegial panel members:

Tang Zhen | Chen Yaoyao |
Chen Rongxiang

Keywords:

infringement of trade secrets, preliminary injunction

Relevant legal provisions:

Civil Procedure Law of the People's Republic of China (as amended in 2012), article 100

Basic facts: On July 2, 2013, Eli Lilly and Company (hereinafter “Eli Lilly”) and Lilly China Research and Development Co., Ltd. (hereinafter “Lilly China”) filed a lawsuit with Shanghai No. 1 Intermediate People’s Court against Huang Mengwei for infringing technological trade secrets and applied to the court for an injunction, asking the court to order Huang Mengwei not to disclose, use or allow others to use the 21 confidential documents that Eli Lilly and Lilly China alleged he had stolen from them.

Eli Lilly and Lilly China affirmed that Huang Mengwei joined Lilly China in May 2012 as a chief chemistry researcher. Lilly China signed a confidentiality agreement with Huang and provided corresponding training. In January 2013, Huang downloaded 48 documents owned by Eli Lilly and Lilly China from Lilly China’s server (including 21 core confidential documents) and stored the documents in his own device without authorization. Upon mediation, Huang Mengwei signed a letter of consent in February 2013, admitting to Eli Lilly and Lilly China that he had “downloaded thirty-three (33) confidential documents belonging to the company from the company’s server ...” and undertaking to:

... allow the company or persons designated by the company to check the first-hand device not belonging to the company and the second-hand device not belonging to the company to determine that I did not forward, modify, use or print any company document. If the company or persons designated by the company find any document or information of the company in the device not belonging to the company, I authorize the company or persons designated by the

company to delete such document or information. ...

After that, Eli Lilly and Lilly China designated persons to contact Huang Mengwei and require him to delete the confidential commercial documents. Eli Lilly and Lilly China also designated persons to check and confirm whether the confidential commercial documents had been deleted. However, Huang repeatedly ignored the mediation agreement and the companies’ efforts, and refused to perform the obligations to which he had agreed in the letter of consent. Because Huang had seriously violated Lilly China’s rules and regulations, Eli Lilly and Lilly China sent him a letter on February 27, 2013, announcing the termination of his employment contract. Eli Lilly and Lilly China held that the 21 core confidential commercial documents that Huang had downloaded without authorization were their trade secrets, and that Huang Mengwei knew and had admitted as much in the letter of undertaking. Huang’s failure to fulfill his undertaking had exposed trade secrets to risk of a leak, whether or not he disclosed or used them or permitted others to use them, and this would cause Eli Lilly and Lilly China irreparable harm. Therefore, in accordance with the law, Eli Lilly and Lilly China asked the court to order Huang Mengwei not to disclose, use or allow others to use the 21 trade secret documents that he had stolen from them. To support their application, Eli Lilly and Lilly China provided the court with the names and contents of the 21 trade secret documents involved, Huang Mengwei’s letter of undertaking, the certificate of notarization, a table of information devices allocated to employees, the notice terminating Huang’s contract of employment, the statistical statement of direct and indirect

costs, and other evidentiary materials. Eli Lilly and Lilly China also deposited RMB100,000 with the court as a security bond in support of the injunction application.

Held: Shanghai No. 1 Intermediate People's Court granted an injunction prohibiting Huang Mengwei from disclosing, using or allowing others to use the 21 documents claimed by Eli Lilly and Lilly China as protected trade secrets. Because Huang Mengwei did not apply for a review within the time limit specified by the court's order, that injunction came into force.

Reasoning: As the first in which an injunction was applied to a trade secret dispute under the new Civil Procedure Law (as amended in 2012), this case highlighted the practical efforts made by the courts in the new era to comply with societal needs and to strengthen the judicial protection of intellectual property rights according to law. During the course of proceedings, the court considered the following main factors.

I. Factors to be considered for injunctions in trade secret infringement cases

In trade secret infringement cases, a preliminary injunction plays an important role in protecting the interests of right holder in a timely and effective manner. However, as a special relief, preliminary injunctions can not only ensure the smooth enforcement of the upcoming effective judgment, but also enable its claimant to obtain, in advance, all or part of the interests of the final remedy. Therefore, in judicial practice, the court shall not enter an injunction simply when there exist general possibilities of unauthorized disclosure or use. Before entering an injunction, the court shall usually consider such factors as the

substantial possibility of the claimant winning the case, the substantial danger of irreparable harm that would be caused if the injunction were to be denied, the possibility of harm to the respondent outweighing any potential harm to the claimant and non-infringement of the public interest. The following factors made this case unusual.

- (a) Huang Mengwei had confirmed that he had downloaded 33 confidential documents belonging to the companies (including 21 documents for which they claimed trade secret protection) in violation of the companies' rules and regulations, and had undertaken to authorize persons designated by the companies to delete such documents. It was therefore obvious that Huang Mengwei had obtained by illegal means the confidential documents for which Eli Lilly and Lilly China claimed trade secret protection.
- (b) A trade secret, once lost, is lost forever. The commercial documents involved were already under Huang Mengwei's control. Once he disclosed such electronic documents, their content may be known to competitors or may enter the public domain and then lose its confidentiality, leaving Eli Lilly's and Lilly China's interests irreparably harmed.
- (c) Based on the facts of this case, Huang Mengwei, as a natural person in contrast with companies Eli Lilly and Lilly China, would not be harmed if he were to be prohibited from disclosing, using or allowing others to use the commercial documents. In addition, Eli Lilly and Lilly China had deposited a security bond with the court to cover the risk that any damage might be incurred as a result of the injunction.

Based on these facts, the court granted an injunction against Huang and informed him of the time limit within which he must apply for a review to facilitate the exercise of his right to a defense.

II. Key points to be considered for injunctions in trade secret infringement cases

As the first case in which an injunction was applied within a trade secret infringement case, there was no precedent for the court to follow with respect to the application of law. During the trial, the court considered the following key points.

- (a) *Consistency between Eli Lilly's and Lilly China's claims and the application for injunction* When filing the lawsuit, the companies asked the court to order Huang Mengwei to cease infringing their trade secrets and, specifically, to order Huang to delete and not to disclose, use or allow others to use the 21 commercial documents involved. The court held that its review of an injunction application shall be limited to the claims of the case without allowing additions and shall be in line with consideration of trade secret infringement as provided for in article 10 of the Law against Unfair Competition (as published in 1993). Huang was therefore ordered "not to disclose, use or allow others to use the 21 documents involved".
- (b) *Relationship between the preliminary injunction and the final judgment* When the case proceedings were under way, it was pending whether the documents involved constituted trade secrets and belonged to the category of legal interests protected by the

Anti-Unfair Competition Law. As a temporary measure, an injunction shall be free from the potential danger of conflicting with the final judgment. The judgment was therefore worded as "prohibiting Respondent Huang Mengwei from disclosing, using or allowing others to use the 21 documents claimed by Eli Lilly and Company and Lilly China Research and Development Co., Ltd. as protected trade secrets", which meant that the 21 documents involved were identified only as documents over which the companies claimed trade secret protection, not as information finally confirmed to be such by the court upon review under law.

- (c) *Balance between trial and enforcement* Because the content of the 21 documents involved was not clear in the body of the judgment, the department tasked with enforcing the order would lack actionable detail. The court therefore appended to its judgment a list naming the 21 documents involved. This suggested that although Huang Mengwei had downloaded 33 documents in violation of the companies' rules and regulations, he was to be held liable only in the event that he disclosed, used or allowed others to use the 21 documents in violation of the judgment.

III. Enforcing an injunction in trade secret infringement cases

An injunction is about the court ordering a party to engage or not to engage in a certain activity. Different from a freezing order, an injunction is enforced against a person's behavior, instead of property as such. Because of these special characteristics, enforcement of the injunction requires the party's

cooperation. Moreover, enforcement is more difficult when the injunction orders the party not to do something than when it orders someone to do something because a positive action by a party is perceivable from outside and sometimes accomplishable instantaneously, while the prohibition of a party's behavior depends on that party's conscientiousness, which is not objectively perceivable by the enforcement staff of the court and makes the enforcement of court orders less certain. The court held that such negative injunctions mainly depend on the deterrent force of effective legal instruments. Only by strengthening the deterrent force of effective legal instruments can the parties' conscientious compliance with court orders be ensured. Therefore, after entering the judgment in this case, the court not only serviced the legal instrument, but also summoned Huang Mengwei to the court and informed him of the content of the order and of the consequences of violating it. In fact, in the event that a party refuses to comply with effective court judgments or orders, the court may, in accordance with article 111 of the Civil Procedure Law, fine or detain that party based on the severity of circumstances and may even hold them criminally liable if a crime is committed. It is fair to say that, in this case, the warning generated good legal effect. In the court, Huang Mengwei undertook in writing that he was willing to comply with the court order and then represented in later submission to the court that he had destroyed the hard disks that stored the downloaded documents, attaching photos to corroborate his representations.

F. Resolving conflicting rights by attaching equal weight to protecting prior rights and maintaining coexisting rights

A conflict of rights is substantively a conflict of interests. The process through which the courts should redefine and clarify the boundaries of those rights represents the measurement and offsetting of conflicting interests, and reflects a value judgment.

BEIJING QUNA INFORMATION TECHNOLOGY CO., LTD. V. GUANGZHOU QUNA INFORMATION TECHNOLOGY CO., LTD.
(2013) YGFMSZZ No. 565,
Guangdong Higher People's Court

Cause of action:

Dispute alleging unfair competition

Collegial panel members:

Yue Lihao | Yu Jie | Shi Jinghan

Keywords:

domain name, specific name of famous service, unfair competition

Relevant legal provisions:

Interpretation of the Supreme People's Court on Several Issues Concerning the Application of Law in the Trial of Civil Dispute Cases Regarding Computer Network Domain Names, article 4

Basic facts: On May 9, 2005, Zhuang Chenchao registered the domain name "qunar.com" and established the "qunar" website. After Beijing Quna Information Technology Co., Ltd. (hereinafter "Beijing Quna Company") was incorporated and registered with the Industry and Commerce Authority on March 17, 2006, the domain name "qunar.com" was transferred by Zhuang Chenchao (Beijing

Quna Company's legal representative) to Beijing Quna Company. After years of use, service logos such as 去哪儿 (pronounced *qunar*, meaning "where to go"), 去哪儿网 (pronounced *qunar wang*, meaning "where to go website") and "qunar.com" became the specific names of a famous service.

Guangzhou Quna Information Technology Co., Ltd. (hereinafter "Guangzhou Quna Company") was formerly known as Guangzhou Longyou Xianzong Travel Agency Co., Ltd., which was founded on December 10, 2003, and covered a scope of business similar to that of Beijing Quna Company. On June 6, 2003, the domain name "quna.com" was registered. After several transfers, it was acquired by Yuan Jingen (Guangzhou Quna Company's legal representative) on May 9, 2009. On May 26, 2009, the renaming of Guangzhou Quna Company was approved and the domain name "quna.com" was transferred to it soon afterwards. Guangzhou Quna Company subsequently registered domain names "123quna.com" and "mquna.com", and used 去哪 (pronounced *quna*, meaning "where to go"), 去哪儿 (pronounced *qunar*, meaning "where to go"), 去哪网 (pronounced *quna wang*, meaning "where to go website") and "quna.com" in its external publicity materials and operations.

On April 25, 2011, Beijing Quna Company filed a lawsuit in the court of first instance against Guangzhou Quna Company, alleging that its use of "quna", "qunar", "quna wang" and "quna.com" in its external publicity materials and operations constituted unfair competition, and asking the court to order Guangzhou Quna Company to immediately cease its unfair competition and pay damages of RMB3 million to Beijing Quna Company for its economic losses.

Held: Guangzhou Intermediate People's Court delivered its judgment ((2011) SZFMSCZ No. 217) on June 9, 2013, holding that both Beijing Quna Company and Guangzhou Quna Company provided online travel services and there existed competition between them. The commercial marks "qunar", "qunar wang" and "qunar.com" used by Beijing Quna Company were the specific names of a famous service. Guangzhou Quna Company's use of the commercial marks "quna", "qunar", "quna wang" and "quna.com" constituted an infringement of Beijing Quna Company's right to those names, and Guangzhou Quna Company's use of the word "quna" in its company name constituted unfair competition. Guangzhou Quna Company's use of the domain names "quna.com", "123quna.com" and "mquna.com" constituted an infringement of Beijing Quna Company's interests in the domain name. The court therefore:

- (a) ordered Guangzhou Quna Company to cease using "quna" as its company name;
- (b) ordered Guangzhou Quna Company to cease using "quna", "qunar", "quna wang" and "quna.com" as its service marks;
- (c) ordered Guangzhou Quna Company to cease using the domain names "quna.com", "123quna.com" and "mquna.com", and to transfer these domain names to Beijing Quna Company within the stipulated time limit;
- (d) ordered Guangzhou Quna Company to pay RMB350,000 to Beijing Quna Company to compensate it for its economic losses; and
- (e) dismissed all other claims of Beijing Quna Company.

Dissatisfied with the judgment, Guangzhou Quna Company appealed to

the Guangdong Higher People's Court, arguing that its domain name "quna.com" was legitimately registered on June 6, 2003, and was thus an existing prior right. Furthermore, it argued that it had no malicious intent in acquiring the domain name "quna.com" and subsequently registering the domain names "123quna.com" and "mquna.com".

The second-instance court delivered its judgment on March 19, 2014, holding that "qunar", "qunar wang" and "qunar.com", as used by Beijing Quna Company, constituted specific names of a famous service, and that Guangzhou Quna Company's use of the word "quna" as its company name constituted unfair competition. However, it found Guangzhou Quna Company's use of domain names "quna.com", "123quna.com" and "mquna.com" to be the exercise of existing prior rights, which had a legal basis. The court of second instance therefore:

- (a) affirmed the first-instance decision that Guangzhou Quna Company be ordered to cease using "quna" in its company name and using marks such as "quna";
- (b) set aside the first-instance decision that Guangzhou Quna Company cease using the domain names "quna.com", "123quna.com" and "mquna.com" and the order that it transfer these domain names to Beijing Quna Company within the stipulated time limit; and
- (c) reduced the amount of compensation to RMB250,000 accordingly.

Reasoning: At second instance, the dispute focused on whether the use of domain names "quna.com", "123quna.com" and "mquna.com" by Guangzhou Quna Company had a legal basis.

According to article 4 of the Interpretation of the Supreme People's Court on Several Issues Concerning the Application of Law in the Trial of Civil Dispute Cases Regarding Computer Network Domain Names:

In the trial of domain name dispute cases, the people's court shall find the respondent's registration and use of a domain name to be an infringement or unfair competition when the following conditions are satisfied:

- 1) the civil rights and interests claimed by the plaintiff for protection are legitimate and valid;
- 2) the defendant's domain name or its main part constitutes the reproduction, imitation, translation or transliteration of the plaintiff's well-known trademark, or is same as or similar to the plaintiff's registered trademark and domain name, etc., enough to cause confusion among the relevant public;
- 3) the defendant has neither rights and interests in the domain name or its main part, nor justifiable cause to register or use such domain name;
- 4) the defendant registers or uses the domain name with a malicious intent.

The key to determining whether Guangzhou Quna Company had engaged in unfair competition was whether its use of the domain names satisfied all of these four elements.

- (a) On the use of the domain name "quna.com", the court of second instance opined that Guangzhou Quna Company enjoyed legitimate rights and interests in the domain

name “quna.com”, and had justifiable cause to use it; failing this third requirement, Guangzhou Quna Company’s action did not constitute unfair competition. The reason was as follows.

- (i) On June 6, 2003, the domain name “quna.com” was registered for the first time, but it was not until May 9, 2005, some two years after the initial registration of “quna.com”, that the domain name “qunar.com” was registered and the website created. The registration of “quna.com” was therefore legitimate. After several transfers, Yuan Jingen (Guangzhou Quna Company’s legal representative) acquired the domain name “quna.com” on May 9, 2009, and Guangzhou Quna Company later acquired it on July 3, 2009. Such transfers did not break the law and hence the law should not interfere with Guangzhou Quna Company’s use of its legally acquired domain name “quna.com”.
- (ii) On August 27, 2010, Beijing Quna Company submitted to the Beijing Secretariat of the Asian Domain Name Dispute Resolution Center a letter of complaint against Guangzhou Quna Company’s use of the domain name “quna.com”, requesting that this domain name be transferred to Beijing Quna Company. According to the expert panel, the complainant could not satisfy the three conditions stipulated in the Uniform Domain Name Dispute Resolution Policy and hence there was no reason to grant its request to “order the respondent to transfer

the disputed domain name to the complainant”. This further proved that Guangzhou Quna Company had justifiable cause to use the domain name “quna.com”.

- (iii) Because domain names are limited in length and quantity, similar domain names are registerable. The only difference between Beijing Quna Company’s domain name “qunar.com” and Guangzhou Quna Company’s domain name “quna.com” was the dropped letter “r”. Although the two domain names are similar, the two parties are obliged to tolerate the possible confusion between these two domain names in their use. If the confusion created by the use of the two domain names were to be used as a basis to argue that Guangzhou Quna Company used the domain name “quna.com” out of malicious intent, and to further infer that Guangzhou Quna Company’s acquisition of the domain name “quna.com” had no justifiable cause and hence constituted unfair competition, such logic would not hold water.
- (b) On the use of the domain names “123quna.com” and “mquna.com”, these are more similar to the domain name “quna.com” used by Guangzhou Quna Company than to Beijing Quna Company’s domain name “qunar.com”. Because Guangzhou Quna Company had justifiable cause to use the domain name “quna.com”, the domain names “123quna.com” and “mquna.com” registered afterwards should also be allowed to be registered and used.

In conclusion, there were valid reasons for Guangzhou Quna Company to argue that it had a legal basis to use the domain names “quna.com”, “123quna.com” and “mquna.com”. The court of second instance supported its appeal according to law.

As also noted by the court of second instance, both parties in this case enjoyed rights and interests in domain names with legitimate sources, and therefore they were ordered to tolerate, respect and coexist with each other over the long term. Neither party was permitted to deprive the other of its living space on the basis that its own popularity has increased nor was one party to maliciously exploit the higher goodwill of the more well-known party to achieve improper business advantages. Guangzhou Quna Company should therefore have the right to continuously use the domain names “quna.com”, “123quna.com” and “mquna.com”, but be obligated to add corresponding distinguishing marks on the domain-name-related search links and websites so that consumers can distinguish between these and “qunar”, “qunar wang” and “qunar.com”, which are the specific names of Beijing Quna Company’s famous service.

G. Verifying the client list in a case involving trade secrets and application of an injunction against an alleged infringer

In a case alleging infringement of trade secrets, a “client list” is not an ordinary list of client names, but a list containing in-depth information affecting the supplier–client transaction. Important information exchanged between the supplier and the client, such as tax invoices, delivery lists, remittance vouchers, requisition notices and parcel bills, among other things, delivers insight into clients’ trading habits, trading needs and budgets, which information and insight are different from that generally known to the public. This type of information has real or potential commercial value and hence will be found to constitute a trade secret on condition that the holder of the information (the supplier) has taken reasonable measures to secure its confidentiality.

HEBI REFLECTIVE MATERIAL CO., LTD. V. SONG JUNCHAO, HEBI RUIMINGTE TECHNOLOGY CO., LTD., AND LI JIANFA
(2016) YMZ No. 347, Henan Higher People’s Court

Cause of action:

Disputes over infringement of trade secrets

Collegial panel members:

Zhao Zheng | Zhao Yanbin | Jiao Xinhui

Keywords:

application of injunction, client list, infringement of trade secrets

Relevant legal provisions:

Law of the People’s Republic of China against Unfair Competition (as published in 1993), article 10

Interpretation of the Supreme People's Court on Some Issues Concerning the Application of Law in the Trial of Civil Cases Involving Unfair Competition, article 16

Basic facts: In a case involving disputes over infringement of trade secrets between the claimant Hebi Reflective Material Co., Ltd. (hereinafter “Reflective Material Company”) and respondents Song Junchao, Hebi Ruimingte Technology Co., Ltd. (hereinafter “Ruimingte”) and Li Jianfa, the facts were that Reflective Material Company had been established on April 4, 1996, and its business scope covered the processing and sales of reflective materials, as well as applications of reflective materials and coated products. Reflective Material Company submitted 18 pages of records of its transactions with clients in Northeast China, including 5 pages from 2010, 4 pages from 2011, 4 pages from 2012, 3 pages from 2013 and 2 pages from 2014. Those transaction records contained such information as “date”, “client name”, “variety”, “specification”, “quantity”, “unit price”, “income”, “address”, “contact person”, “contact number” and “remarks”. Song Junchao had been a sales representative at Reflective Material Company since 2006, responsible for sales and customer development in Heilongjiang Province, Jilin Province, Liaoning Province and Inner Mongolia Autonomous Region. Reflective Material Company had entered into two employment contracts with Song Junchao, both of which included confidentiality clauses and non-competition clauses. Reflective Material Company had established a confidentiality system for its business information, had taken necessary confidentiality measures to secure information relating to clients and potential clients, and had paid

confidentiality fees to Song Junchao and other sales staff. After noticing that Song Junchao had purchased reflective cloth on his own behalf, Reflective Material Company filed a lawsuit and asked for a preliminary injunction whereby it asked the court to seize the 14 pieces of reflective fabric stored by Song Junchao, which were to be sent to a “Song Xiang”, to prohibit Song Junchao, Ruimingte and Li Jianfa from conducting the infringing act, and to request that they compensate Reflective Material Company for reasonable expenses and losses in the sum of RMB500,000.

Hebi Shancheng Ruixin Reflective Material Business Department (hereinafter “Ruixin Business Department”) was established on April 3, 2006. The name of its operator was Li Jianfa and the contact number was 130xxxxxxx9. Hebi Ruixin Trading Co., Ltd. (hereinafter “Ruixin Company”) was established on June 22, 2011. Its business scope covered steel, building materials, hardware, electrical appliances, coated panels and reflective fences. The contact number of the legal representative, upon two changes, was 130xxxxxxx9. On November 12, 2011, a “Song Xiang” applied for a change of the company’s business scope. The expanded scope encompassed reflective material products, clothing, textiles, sanitary products and rubber products, among other things. On August 27, 2013, Song Xiang handled the procedures for changing Ruixin Company’s legal representative. In addition, during the operation of Ruixin Company, Song Xiang also participated in work related to the business registration procedures of the company, such as applying for a business license, changing the company’s business scope and submitting annual inspection reports. Ruixin Company changed its name to

Ruimingte Company on January 19, 2015. Song Junchao's ID number was 4106xxxxxxxx1537; Song Xiang's ID number was 4106xxxxxxxx7510. These two names referred to the same person. Song Junchao used a SIM card with the number 130xxxxxx9. Song Junchao had sent goods to Northeast China in the name of "Song Xiang" through Zhengzhou Debon Logistics Limited, Hebi Branch, more than 10 times. The goods sent included, among other things, "reflective cloth, 3 fibers" and "reflective strips, 2 fibers", and "cloth, 5 fibers". On February 8, 2014, Song Junchao delivered goods to Northeast China through Hebi Business Department of China Railway Corporation. Song Junchao had sent goods to Northeast China through Shanghai Jiayi Express Co., Ltd., Hebi Branch, seven times. The goods included, among other things, "cloth, 3", "cloth, 4" and "cloth, 9". Some of the clients listed were the same as those on Reflective Material Company's client list. The current account of Ruixin Company/Ruimingte showed that, between August 1, 2011, and July 31, 2015, among its clients in Northeast China were 10 clients who were the trading clients of Reflective Material Company and that there were 38 supply transactions, amounting to RMB830,512.50. Song Junchao, in his own capacity, withdrew the money from the accounts of Ruixin Company some 27 times, totaling RMB1,270,603.42.

Held: Henan Hebi Intermediate People's Court delivered its judgment ((2015) HMCZ No. 96) on December 25, 2015, in which it ordered Song Junchao and Ruimingte to cease infringement of Reflective Material Company's trade secrets, not to use Reflective Material Company's trade secret in the next two years and to pay the damages of RMB350,000.

Dissatisfied, Song Junchao and Ruimingte appealed to the Henan Higher People's Court, seeking revocation of the first-instance decision and dismissal of Reflective Material Company's claims. On August 2, 2017, Henan Higher People's Court issued its judgment dismissing the appeal and affirming the first-instance judgment.

Reasoning: In its final judgment, Henan Higher People's Court held as follows.

I. On whether the client list claimed by Reflective Material Company constitutes a trade secret

Article 10 of the Law of the People's Republic of China against Unfair Competition stipulates that, "for the purpose of this Law, commercial secrets refer to any technical information or operational information which is not known to the public, may create commercial value for the obligee, may have practical uses and for which its obligee has adopted measures to ensure its confidentiality". In this case, Reflective Material Company collected and recorded the client information stated in its VAT invoices issued to clients in Northeast China, the delivery list, the remittance vouchers for payment transfers with clients, notices of goods requisitioned, the parcel bills, and the travel schedules and travel plans, to form a client list with detailed business information, and it spent a lot of time, money and effort in doing so. Among these details, "transaction date" can reflect the regular pattern of a client's demand for goods; "variety", "specification" and "quantity" can explain a client's unique needs; "unit price" can explain a client's budget and its bottom line when it comes to price; "remarks" reflect special information relating to a client. All of these items constitute Reflective Material Company's "trade secret", because they reflect

unique client information that cannot be found in the public domain. All of this evidence matches the requirement under article 10 that the information be “not known to the public”. Reflective Material Company’s transaction records and client transaction bills cover a long period of time and a large number of clients. Such business information has real or potential business value. Some clients had established long-term business dealings with Reflective Material Company. Some clients had not established business relationships with Reflective Material Company, but were important resources with which Reflective Material Company may seek to obtain trading opportunities. The clients designated in the business information had formed stable supply channels and maintained good trading relationships with Reflective Material Company. Therefore, such information had practical utility in the operation of the business, and could deliver economic benefits and competitive advantages to Reflective Material Company. All of this evidence met the requirement under article 10 that the information “create commercial value for the obligee [and] have practical uses”. Reflective Material Company had established a specific system of confidentiality for these businesses’ information, and had taken the necessary measures to preserve the confidentiality of its clients and potential clients. The employment contract that Reflective Material Company entered into with Song Junchao clearly included a confidentiality clause and a competition restriction clause. Reflective Material Company also paid the corresponding confidentiality fees to Song Junchao and other sales staff. All of this evidence proved that Reflective Material Company took reasonable “confidential measures” to secure its business information and, in summary, the court found that Reflective Material Company’s client list produced constituted a trade secret.

II. On whether Song Junchao and Ruimingte infringed upon Reflective Material Company’s trade secret

Song Junchao had been a sales representative for Reflective Material Company since 2006. He was responsible for sales and customer development in Heilongjiang Province, Jilin Province, Liaoning Province and Inner Mongolia Autonomous Region, and he knew very well the client information related to Reflective Material Company’s trade secret. Song Junchao delivered goods to Northeast China 18 times under the name of “Song Xiang”. Some of the products were named similarly to reflective materials. Some of the clients listed were also the same as those of Reflective Material Company. It could therefore be ascertained that Song Junchao had traded with Reflective Material Company’s clients without permission. Song Junchao had participated in the work relevant to the business registration of Ruimingte, such as application for a corporate business license, a change of corporate business scope and submission of annual inspection reports. The contact number of Ruimingte’s legal representative was 130xxxxxxx9 on both instances of change, as used by Song Junchao. Song Junchao also withdrew money in his personal capacity from Ruimingte’s account some 27 times, to a total of RMB1,270,603.42. It could therefore be ascertained that Song Junchao had a close relationship with Ruimingte (formerly Ruixin Company). Song Junchao entered into a non-disclosure agreement with Reflective Material Company. Reflective Material Company also paid confidentiality fees to Song Junchao. Song Junchao was obligated to keep the business information that he obtained at work confidential. Song Junchao should have been aware of the company’s relevant management

regulations, and of the non-public nature and commercial value of client list, but he still conducted transactions in his personal capacity with Reflective Material Company's clients. Thus he knowingly committed the infringement. The act of Song Junchao in breaching confidentiality, and disclosing, using and allowing others to use Reflective Material Company's confidential business information, infringed on Reflective Material Company's trade secret. The business scope of Ruimingte, as changed by Song Junchao on November 12, 2011, partially overlapped with the business scope of Reflective Material Company. Under circumstances in which Song Junchao and Ruimingte maintained close ties, Ruimingte initiated business transactions within a short time frame with those clients who had maintained long-term relations with Reflective Material Company. According to the current accounts of Ruimingte, some of the clients in Northeast China who traded with Ruimingte from August 1, 2011, to July 31, 2015, were also clients of Reflective Material Company and the transaction amounts were significant. It could be ascertained that client information used by Ruimingte was the same or substantially the same as the business information gathered by Reflective Material Company. It could be further ascertained that Ruimingte actually had access to that business information through Song Junchao. Because Ruimingte failed to provide evidence to prove that the clients themselves initiated the transaction, it could be presumed that Ruimingte improperly obtained Reflective Material Company's client list, via Song Junchao, and used it to conduct transactions with Reflective Material Company's clients. Such acts infringed on the rights of Reflective Material Company to protect its client list as a trade secret,

constituting a common subjective intention. The court therefore found that Song Junchao and Ruimingte jointly infringed on Reflective Material Company's trade secret rights.

III. On how to determine liability for damage

Because it was impossible to calculate Reflective Material Company's loss and the profits of Song Junchao and Ruimingte, the court determined it to be appropriate that Song Junchao and Ruimingte should compensate Reflective Material Company in the sum of RMB350,000, based on the nature of their infringement, their subjective fault, the duration of trading, the number of transactions, Reflective Material Company's previous transaction price for similar products and the efforts made by Reflective Material Company to collect client business information. To protect Reflective Material Company from damage caused by the infringement, and to prevent Song Junchao and Ruimingte from continuing to profit from the infringement, Song Junchao and Ruimingte were ordered to immediately cease infringement of Reflective Material Company's trade secret and were prohibited from using that trade secret within the next two years, according to article 16 of Interpretation of the Supreme People's Court on Some Issues Concerning the Application of Law in the Trial of Civil Cases Involving Unfair Competition, which provides that:

When the People's Court imposes civil liability for infringement of trade secrets, the time frame for refraining from such infringement generally endures until the trade secret has been known to the public. If, according to the preceding provision, a judgement regarding

the time frame for refraining from infringement is evidently unreasonable, the infringer may be ordered to cease infringement of the trade secret for a certain period of time or within a particular scope, provided that the competitive advantage bestowed on the Obligee by such trade secret is protected in accordance with the law.

A.

Two parties respectively holding the male plant and the female plant of a new plant variety ordered to grant a license to each other to ensure continuous production of the new plant variety

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Chapter 5

New plant varieties case

A. Two parties respectively holding the male plant and the female plant of a new plant variety ordered to grant a license to each other to ensure continuous production of the new plant variety

If two parties who respectively hold the male plant and the female plant of a new plant variety (NPV) fail to reach a cross-licensing agreement, continuous production of the NPV will become impossible, which will impair the interests of both parties and obstruct cooperative breeding. To safeguard the public interest, to guarantee national food security, and to promote the commercialization and implementation of widely planted NPVs, on the basis of a judgment that both male and female plants are equally valuable in the production of an NPV, the Supreme People's Court may directly order each party to grant the other a license and that the two be mutually exempt from corresponding royalty payments.

TIANJIN TIANLONG SEED TECHNOLOGY CO., LTD. V. JIANGSU XUNONG SEED TECHNOLOGY CO., LTD.
(2011) SZMZZ No. 0194 & (2012) SZMZZ No. 0055, Jiangsu Higher People's Court

Cause of action:

Dispute over new plant variety rights

Collegial panel members:

Song Jian | Gu Tao | Yuan Tao

Keywords:

civil, cross-licensing, infringement of new plant variety rights

Relevant legal provisions:

Contract Law of the People's Republic of China, article 5

Regulations of the People's Republic of China on the Protection of New Varieties of Plants, articles 2, 6 and 39

Basic facts: Each of Tianjin Tianlong Seed Technology Co., Ltd. (hereinafter "Tianlong") and Jiangsu Xunong Seed Technology Co., Ltd. (hereinafter "Xunong") filed a lawsuit against the other alleging infringement upon rights to an NPV.

The 9A/418 rice variety, a three-line japonica hybrid rice variety, jointly cultivated by the Northern Japonica Hybrid Rice Engineering Technology Center (also known as the Liaoning Rice Research Institute; hereinafter "LRRI") and the Xuzhou Institute of Agricultural Sciences (hereinafter "XIAS"), achieved national crop variety validation on November 10, 2000. The 9A/418 rice variety is generated from female plant 9201A and male plant C418. On December 30, 2003, the LRRI applied to the Ministry of Agriculture for NPV rights with respect to the C418 rice variety, obtained approval on May 1, 2007, and granted to Tianlong the exclusive license to exercise NPV rights with regard to C418. On September 25, 2003, XIAS applied to the Ministry of Agriculture for protection of NPV rights with regard to the Xu 9201A rice variety that it had

bred, for which it obtained approval on January 1, 2007. On January 3, 2008, XIAS licensed to Xunong the exclusive right to exercise the NPV rights with respect to Xu 9201A. Upon investigation, it was found that Xunong and Tianlong used the same combinations to produce 9A/418 – namely, C418 as the male plant and Xu 9201A as the female plant.

On November 14, 2010, upon request by Tianlong, the court of first instance, the Intermediate People’s Court of Nanjing Municipality, commissioned Hefei Test Center, under the auspices of the Ministry of Agriculture, to conduct DNA identification to establish whether there was parenthood between the allegedly infringing variety provided by Tianlong and the protected variety C418. The following findings were obtained from the test:

Having applied the 48 rice SSR markers in the national standard GB/T20396-2006, a marker analysis was made of the DNAs of 9A/418 and C418. The results showed that in all markers tested, 9A/418 fully inherited the DNA band pattern of C418 and it may be concluded that there exists parenthood between 9A/418 and C418.

On August 5, 2010, upon request by Xunong, the court of first instance authorized the Hefei Test Center, under the auspices of the Ministry of Agriculture, to identify whether there was parenthood between the allegedly infringing variety provided by Xunong and the varieties C418 and Xu 9201A. The following findings were obtained from the test:

Having applied the 48 rice SSR markers in the national standard GB/T20396-2006, a marker analysis was made of the DNAs of the alleged

infringing variety and C418 and Xu 9201A. The results showed that in all markers tested, the alleged infringing variety fully inherited the DNA band pattern of C418 and Xu 9201A. It may be concluded that there is parenthood between the alleged infringing variety and C418 and Xu 9201A.

In the written application for NPV protection for C418 that Tianlong submitted, the description indicated that C418, a japonica-type restorer line with a shape close to indica and a specific affinity, was cultivated by using the “indica–japonica bridge” restorer production technique first invented by North China Japonica Hybrid Rice Center and by using intermediate materials between indica and japonica varieties to construct favorable genetic groups from indica and japonica varieties. C418 has a higher specific affinity, which is a property possessed by restorer lines cultivated by the “indica–japonica bridge” method, as manifested in the first hybrid offspring’s better coordination of the ecological and genetic differences between the genomes of indica and japonica varieties, thus providing a better solution to the weaknesses generally manifested by indica and japonica hybrids, such as low seed-setting rate, poor grain plumpness, temperature sensitivity and premature aging. C418 combines the excellent traits of indica and japonica varieties, and the hybrid combinations that it produces generally show a higher seed-setting rate and some degree of cold tolerance.

In their letter to Tianjin Seed Management Station, Xunong and XIAS claimed that Xu 9201A, a middle-season japonica sterile line that they had independently bred, passed the national validation for crop varieties in 1996. Prior to the validation, it had been named

“9201A”, abbreviated as “9A”; after the validation, it was renamed “Xu 9201A”. Using Xu 9201A as the female parent, Xunong and XIAS had successively bred various three-line japonica hybrid rice combinations, including 9 A/138, 9A/418 and 9A/24. In the application for national validation of the crop variety filed in 2000, the variety origins were indicated still as “9201A×C418”, which were the same for the combination of the two genetic groups in 1995. In the plant variety protection application for Xu 9201A filed with the Ministry of Agriculture in July 2003, it was indicated in the description that Xu 9201A had been combined with other genetic groups to breed various hybrid combinations, including 9A/138, 9A/418, 9A/24, 9A/686 and 9A/88. Xu 9201A and 9201A are the same middle-season japonica sterile line. Tianlong’s infringing use of 9201A was an infringing use of Xu 9201A.

Held: With respect to the case of *Tianlong v. Xunong*, the Intermediate People’s Court of Nanjing Municipality delivered its judgment ((2009) NMSCZ No. 63) on August 31, 2011, in which it:

- (a) ordered Xunong to immediately cease selling the seeds of the japonica hybrid rice 9A/418 and prohibited it from repeatedly using the seeds of the NPV C418 for production of the seeds of the japonica hybrid rice 9A/418 without authorization from the right holder;
- (b) ordered Xunong to pay, within 15 days of the effective date of the judgment, RMB500,000 to Tianlong as compensation for its economic loss; and
- (b) rejected Tianlong’s other claims.

Xunong was to bear the legal fees of RMB15,294 for the first-instance proceedings.

With respect to the case of *Xunong v. Tianlong*, the Intermediate People’s Court of Nanjing Municipality delivered its judgment ((2010) NZMCZ No. 069) on September 8, 2011, in which it:

- (a) ordered Tianlong to immediately cease infringing Xunong’s exclusive right to NPV Xu 9201A from the effective date of the judgment;
- (b) ordered Tianlong to pay, within 10 days of the effective date of the judgment, RMB2 million to Xunong as compensation for its economic loss; and
- (b) rejected Xunong’s other claims.

Unconvinced by the respective first-instance judgments, both Xunong and Tianlong appealed. On December 29, 2013, the Higher People’s Court of Jiangsu Province combined the two cases and delivered its joined judgments, in which it:

- (a) overturned the first-instance judgments delivered by the Intermediate People’s Court of Nanjing Municipality, Jiangsu Province;
- (b) ordered Tianlong to pay, within 15 days of the effective date of the judgment, RMB500,000 to Xunong as compensation; and
- (b) rejected both parties’ other claims.

Reasoning: In its effective judgment, the court held that the right to an NPV, as a type of important intellectual property right, should be respected and protected. Article 6 of the Regulations on the Protection of New Varieties of Plants clearly provides that:

The entity which or the person who has accomplished the breeding has an exclusive right in their protected variety. No other entity or person shall, without the consent

of the holder of the variety rights, produce or sell for commercial purposes the propagating material of the said protected variety, or use for commercial purposes the propagating material of the protected variety in a repeated manner in the production of the propagating material of another variety.

However, it is necessary to point out that this provision did not apply to the situation in this case.

First, the cooperative cultivation of 9A/418, combining rice groups free of charge, traces its origin back to the large-scale cooperation in hybrid rice research that took place in the 1990s in China. Variety 9A/418 has excellent traits and has been widely planted in Jiangsu, Anhui, Henan and other regions. It has been generally welcomed by many farmers and has become the leading variety of middle-season japonica hybrid rice. The infringement of rights alleged by both parties in itself shows that variety 9A/418, compared with other varieties, has higher economic value and better market prospects, and hence involves enormous economic interests on the part of the collaborating parties (that is, LRRRI and XIAS), as well as both parties to this case. At second instance in this case, the court carried out significant mediation work in the hope that the parties to the case could engage in cross-licensing to allow the continued production of the excellent variety 9A/418. The parties agreed to cross-license the variety rights involved in the case, but the mediation was not successful, for the sole reason that the first-instance court had ordered Tianlong to pay Xunong compensation in the amount of RMB2 million and Xunong to pay Tianlong in the amount of RMB500,000, but the parties could not

reach a settlement on the RMB1.5 million net balance of compensation. Because Tianlong and Xunong could not reach a settlement, production of the variety 9A/418 could not continue. This could not be considered to affect only the interests of the two parties in this case; in fact, this outcome impaired the implementation of the National Food Security Strategy and was detrimental to the public interest. In addition, this outcome was not consistent with the fundamental purposes of the collaborative breeding initially carried out by LRRRI and XIAS nor did it comply with the fundamental requirements for promoting the commercialization and application of NPVs. On its face, the parties to this case took action to protect their own intellectual property rights, but the actual results were a barrier to the use of intellectual property rights and to the commercialization and application of scientific and technological outcomes. Considering that the public interest was involved in the two cases, including national food production security, and that the promotion of the excellent variety 9A/418 was affected, the court held that the parties should both be subject to some constraints when exercising their exclusive licensing rights to the NPV involved in the case. In the production of the rice variety 9A/418, each party should permit the other to use the propagation material of its own parent variety. This result was clearly beneficial to the common interests of LRRRI and XIAS (the two collaborating parties) and to the parties to this case. This result would also take care of many farmers' interests. It was therefore inappropriate for the first-instance court to order the parties of the two cases to respectively cease infringing each other's rights and to pay each other compensation for economic losses. That court's mistakes were to be corrected.

Secondly, 9A/418 is a three-line hybrid combination that combines the excellent traits of the two parents and has notable heterosis. The role of the female parent sterile line is important and the selective breeding of the male parent C418 also successfully solved significant problems related to three-line japonica hybrid rice. In the 9A/418 combined groups, the male parent has the same status and function as the female parent. The court issued a decision that XIAS and LRRRI, the two parties that collaborated in the development of the rice variety 9A/418, as well as Xunong and Tianlong, the parties to this case, all had the rights to use the propagation material of the parent variety for which protection had been granted and that they should mutually exempt each other from the relevant licensing fees. However, the rights and exemption applied only to the production and sale of the rice variety 9A/418, and could not be used for other commercial purposes. Xunong expended significant business efforts and carried out research to overcome key technological barriers to planting variety 9A/418, whereas Tianlong entered into production of the variety 9A/418 only after it had been widely recognized by the market; the latter's market costs for promoting the variety were therefore significantly reduced. For the sake of fairness and equity, the court also ordered Tianlong to pay Xunong RMB500,000 as economic compensation.

Finally, given that each party produced 9A/418 on its own, it was found that there existed some market competition and conflict of interest between them, and the court cautioned them that they were to abide by the relevant provisions of the Law of the People's Republic of China against Unfair Competition, to operate their businesses honestly, to compete

in an orderly manner and to ensure the quality of their products. In particular, the two parties were to clearly indicate their respective business logos to prevent new controversies and disputes from arising, and both parties were to jointly preserve the good reputation of variety 9A/418.

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Chapter 6

Integrated circuit layout design case

A. Infringement of exclusive rights in an integrated circuit layout design

Because of the limited scope for innovation in designing the layout of integrated circuits, stricter standards should be adopted in any case alleging infringement of such a design to ascertain whether two designs are identical or substantially similar.

The claimant shall bear the burden of proving the originality of the integrated circuit layout design for which it claims protection. If the evidence that the claimant provides and their explanations demonstrate that the design is not a conventional design, the claimant will be deemed to have satisfied the preliminary burden of proof. If the alleged infringer argues that the relevant layout design is a conventional design, it should provide evidence to support its argument.

Any original part of a protected layout design shall be protected by law regardless of its size or role in the overall circuit. The act of reproducing all or any original parts of a protected layout design constitutes infringement.

The law does not prohibit reverse engineering by means of photographing the layout design of a competitor's integrated circuit and analyzing the principles behind its design. However, the law does not allow for the direct copying of competitors' layout designs by reverse engineering.

HITREND TECHNOLOGY (SHANGHAI) CO., LTD. V. RENERGY MICRO-TECHNOLOGIES (SHENZHEN) CO., LTD. AND SHANGHAI YACHUANG TEXIN ELECTRONICS CO., LTD.

(2014) HGMS (Z) ZZ No. 12, Shanghai Higher People's Court

Cause of action:

Dispute over infringement of protected integrated circuit layout design

Collegial panel members:

Ding Wenlian | Ma Jianfeng | Xu Zhuobin

Keywords:

exclusive rights in an integrated circuit layout design, originality, reproduction, reverse engineering, substantial similarity

Relevant legal provisions:

Regulations on Protection of Layout Designs of Integrated Circuits, articles 2, 3(1), 4, 7, 23, 30 and 33(1)

Basic facts: In the case of a dispute over infringement of an exclusive right to an integrated circuit (IC) layout design between claimant HiTrend Technology (Shanghai) Co., Ltd. (hereinafter "HiTrend Company") and respondents Renergy Micro-Technologies (Shenzhen) Co., Ltd. (hereinafter "Renergy Company") and Shanghai Yachuang Texin Electronics Co., Ltd. (hereinafter "Yachuang Company"), HiTrend Company had completed its IC layout design "ATT7021AU" on March 1, 2008, and registered the design in the same year. The registered IC layout design drawing indicated 16 layers. The "Brief Description of Structure, Technology and Functions of ATT7021AU IC Layout

Design”, included among the registration documents, recorded that the design:

- (a) satisfied the state-of-the-art best-of-breed layout design requirements of function/performance-optimized area (single-phase energy measurement);
- (b) was a chip layout design with digital–analogue hybrid high anti-interference/high electrostatic protection; and
- (c) applied circuit design technology and layout technology, such as rational layout of the metal layer, diffusion layer and signal flow, to achieve sensitive signal noise shielding and isolation of big and small signal interference.

A review conducted by the Patent Re-examination Board of the State Intellectual Property Office (hereinafter the “Patent Re-examination Board”) did not find any defect under the Regulations on the Protection of Layout Designs of Integrated Circuits (hereinafter “the Regulations”) that would warrant revocation of HiTrend Company’s exclusive right in the layout design; hence, Renergy Company’s application to the Patent Re-examination Board for its revocation was dismissed.

On January 20, 2010, HiTrend Company made a notarized purchase of 100 pieces of IC chips (model no. RN8209G) from Yachuang Company’s business site. Yachuang Company confirmed that it sold those chips; Renergy Company confirmed that it manufactured and sold RN8209 and RN8209G chips. Renergy Company’s website showed that, as of September 2010, the sales volume of RN8209 exceeded 10 million pieces. Some VAT special invoices seized from Renergy Company indicated that a total of 1,120 RN8209G chips were sold, at

a unit price largely ranging between RMB4.80 and RMB5.50, with one invoice bearing a unit price of about RMB2; a total of 6,610 pieces of the RN8209 chips were sold, with the unit price ranging between RMB4.20 and RMB4.80.

Shanghai No. 1 Intermediate People’s Court commissioned Beijing Zitu Intellectual Property Judicial Appraisal Center (hereinafter the “Zitu Appraisal Center”) to carry out a judicial appraisal, which concluded as follows.

- (a) RN8209 and RN8209G are identical to the Original Feature No. 5 in HiTrend Company’s claim (a layout for connection of digital ground rack and analogue ground rack).
- (b) RN8209 and RN8209G are identical to the layout of independent booster circuit in the second section of the Original Feature No. 7 in HiTrend Company’s claim (a layout for the analogue-to-digital conversion circuit).
- (c) Based on existing evidences, the two foregoing items were ascertained to be original and exclusive, and not conventional.

In 2006, HiTrend Company signed employment contracts and confidentiality agreements with Chen Qiang and Zhao Cong. HiTrend Company hired Chen Qiang as its sales manager; Zhao Cong was to engage in IC design work in its research and development department. Later, Chen Qiang worked at Renergy Company as its general manager and Zhao Cong also went to work at Renergy Company. During proceedings, Zhao Cong stated that he had seen the layout design of HiTrend Company’s ATT7021AU IC chip while he was working at that company; Renergy Company did not reverse engineer HiTrend Company’s ATT7021AU IC chip.

HiTrend Company claimed that the acts of Renergy Company and Yachuang Company infringed on its exclusive rights in the IC layout design, and it filed a lawsuit with the court, asking that it order the two to cease the infringement, to make public apology and to compensate HiTrend Company RMB15 million for its economic losses.

Held: On December 24, 2013, the Shanghai No. 1 Intermediate People's Court ruled that:

- (a) Renergy Company should immediately cease the infringement on HiTrend Company's exclusive right in the IC layout design ATT7021AU (Registration No. BS.08500145.7);
- (b) Renergy Company should compensate HiTrend Company RMB3.2 million for its economic losses and reasonable expenses for stopping the infringement; and
- (c) HiTrend Company's remaining claims were to be rejected.

Both HiTrend Company and Renergy Company were dissatisfied with the decision, and each appealed to Shanghai Higher People's Court. Shanghai Higher People's Court dismissed the appeals on September 23, 2014, and affirmed the first-instance judgment.

Reasoning: Shanghai Higher Intermediate People's Court held as follows.

I. On whether the corresponding layout designs of RN8209 and RN8209G chips were the same as the “layout for connection of digital ground rack and analogue ground rack” and the “independent booster circuit layout” in HiTrend Company's ATT7021AU IC layout design

Because there is limited scope for innovation in IC layout design, strict standards should be adopted when assessing whether two designs are identical or substantially similar in instances alleging infringement.

The main features of the “layout for connection of digital ground rack and analogue ground rack” and “independent booster circuit layout” of the RN8209 and RN8209G chips were found to correspond and be identical to the main features of HiTrend Company's “layout for connection of digital ground rack and analogue ground rack” and “independent booster circuit layout”.

Although the wiring in the two parties' layout designs differed in terms of the M2 layer, the three-dimensional configuration of the combination between the wiring and the interconnected components was not substantially altered. As for the difference claimed by Renergy Company with respect to connection position, rack width, arrangement of specific layout, size and shape, and the difference in size of the MOS tube in M1, M2, M3 and PL layers, all of these were found to be minor and insignificant, and not to substantially change the three-dimensional configuration of the combination between the wiring and the interconnected components. The difference in the ST layer was caused by the parties using different processes. These differences were held, on appeal, not to be sufficient to change the first-instance judgment that the two layout designs were substantially

similar. Therefore, in this case, even in accordance with the more stringent judgment criteria, the corresponding layout designs of Renegy Company's RN8209 and RN8209G chips were found to display a substantial similarity to the "layout for connection of digital ground rack and analogue ground rack" and "independent booster circuit layout" in HiTrend Company's ATT7021AU IC layout design.

II. On whether there is originality in the "layout for connection of digital ground rack and analogue ground rack" and "independent booster circuit layout" in HiTrend Company's ATT7021AU IC layout design

According to the provisions of article 4 of the Regulations, "originality" of a layout design means that the layout design is the result of the inventor's own intellectual work and that, at the time of its creation, the layout design is not a standard design generally accepted by layout design inventors and integrated circuit manufacturers. Moreover, HiTrend Company should bear the burden of proof for the originality of the IC layout design for which it claims protection, but it was neither necessary nor possible for HiTrend Company to exhaust all relevant conventional layout designs to prove that its layout design was an unconventional design. As long as the evidence it provided and the explanations it offered could prove that the layout design for which it claimed protection was not a conventional design, HiTrend Company was to be deemed to have satisfied the preliminary burden of proof. In this context, Renegy Company argued that the relevant layout design was a conventional design and that it should be able to overturn HiTrend Company's claim by providing only one identical or substantially similar conventional layout

design. In this case, to substantiate its claim that its "layout for connection of digital ground rack and analogue ground rack" and "independent booster circuit layout" in the ATT7021AU IC layout design were original, HiTrend Company had already provided the relevant Registration Certificate for IC Layout Design and the Patent Re-examination Board's conclusion that there was no defect that warranted revocation of the registration, as well as the conclusions of the Zitu Appraisal Center and other such evidence. These actions were found to be sufficient to meet the requirements of preliminary burden of proof. In this context, the evidence provided by Renegy Company, or the circuit schematic diagram, or the layout design in which the feature points differed from HiTrend Company's layout design were all insufficient to prove that its "layout for connection of digital ground rack and analogue ground rack" and "independent booster circuit layout" in the ATT7021AU IC layout design were conventional. It could therefore be affirmed that HiTrend Company's "layout for connection of digital ground rack and analogue ground rack" and "independent booster circuit layout" had originality.

III. On whether Renegy Company's conduct in producing and selling RN8209 and RN8209G chips violated HiTrend Company's exclusive rights in the ATT7021AU IC layout design

According to article 30 of the Regulations, reproduction of all or any of the original parts of a protected layout design constitutes an infringement. It is apparent that any original part of the protected layout design is protected under law, regardless of its size or role in the overall layout design. In this case, there were conventional designs readily available for "layout for connection

of digital ground rack and analogue ground rack” and “independent booster circuit layout”. Renergy Company had the choice of either adopting these conventional designs or independently developing different layout designs with originality. Renergy Company did not take either approach, but instead directly copied the “layout for connection of digital ground rack and analogue ground rack” and “independent booster circuit layout” in HiTrend Company’s ATT7021AU IC layout design, so as to manufacture and sell the RN8209 and RN8209G chips involved in this case. Such practice therefore straightforwardly constituted infringement.

Chips that achieve the same or similar functions will inevitably have similar circuit work mechanisms and these do not meet the criteria granting the designer exclusive rights as stipulated in the Regulations. The law therefore does not prohibit the act of reverse engineering other designers’ chips by photographing their layout design and analyzing the circuit work mechanisms. However, the law does not allow the direct copying of other people’s layout designs through reverse engineering, because such copying will massively reduce the time and costs invested by the imitators and hence severely weaken the competitive advantage of the business that created the original design, which will ultimately lower the incentives for innovation in the entire IC industry. In this case, Renergy Company’s motivation in partially copying HiTrend Company’s ATT7021AU IC layout design was neither for a personal purpose nor for the purpose of evaluation, analysis, research, teaching and so on, but for developing a new IC for commercial exploitation. Renergy Company admitted that it did not obtain HiTrend Company’s ATT7021AU IC layout design through

reverse engineering; instead, it directly copied the original “layout for connection of digital ground rack and analogue ground rack” and “independent booster circuit layout” in HiTrend Company’s ATT7021AU IC layout design, using it to manufacture and sell the RN8209 and RN8209G chips involved in this case. Regardless of whether Renergy Company’s RN8209 and RN8209G chip layout designs were original, therefore, article 23 of the Regulations should not apply to any of its practices.

In summary, Renergy Company admitted that it had accessed HiTrend Company’s ATT7021AU IC layout design. Without HiTrend Company’s permission, Renergy Company had incorporated the original “layout for connection of digital ground rack and analogue ground rack” and “independent booster circuit layout” of the ATT7021AU IC layout design into the RN8209 and RN8209G chips that it produced and sold. Such practices violated HiTrend Company’s exclusive right to the ATT7021AU IC layout design and Renergy Company was therefore to bear the relevant civil liabilities.

IV. On whether the amount of compensation decided by the court of first instance was reasonable

Because Renergy Company refused to provide its financial information, it was apt to use the information on the sale of 10 million pieces, as displayed on its website, as the basis for calculating the amount of compensation due in this case. In this case, neither party had submitted evidence to prove the profit from the sales of the alleged infringing products; the appraisal report clarified that the other original parts claimed by HiTrend Company were not identical with or substantially similar to those of Renergy Company, so there was no

basis on which HiTrend Company could claim compensation on the full profits of Renergy Company on the ground that there was similarity in other modules. The “layout for connection of digital ground rack and analogue ground rack” and “independent booster circuit layout” did not play a core and important role in the allegedly infringing chip, and they took up only a very small area. By directly copying HiTrend Company’s “layout for connection of digital ground rack and analogue ground rack” and “independent booster circuit layout”, Renergy Company saved on its investment in research and development, shortened its chip development time and, accordingly, obtained a competitive advantage in the market. The amount of compensation therefore could not be determined solely on the basis of the proportion of the two layouts in the whole chip. In summary, it was not appropriate for Shanghai No. 1 Intermediate People’s Court to rule, based on the facts of the case, that Renergy Company compensate HiTrend Company RMB3.2 million for its economic losses and reasonable expenses.

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Chapter 7

Criminal case involving intellectual property rights

A. Defense of “click farming” for feigned credibility is groundless and inadmissible

In criminal cases involving the counterfeiting of a registered trademark, the quantum of illegal business revenue and other gains can be calculated by taking into full account such evidence as defendants’ confessions, witness testimony, victim statements, electronic sales data, the defendants’ current accounts, delivery bills and suppliers’ data records.

Where a defendant contends that there exist falsified records of online retail dealings aiming to feign credibility, but can provide no evidence to substantiate that contention, the contention shall not be admitted into proceedings.

GUO MINGSHENG, GUO MINGFENG AND SUN SHUBIAO

(2015) SZZXCZ No. 0004, Suqian Intermediate People’s Court of Jiangsu

Cause of action:

Criminal case alleged counterfeiting

Collegial panel members:

Cheng Liming | Zhu Geng | Bai Jin

Keywords:

amount of illegal business revenue, crime of counterfeiting, criminal, online sales

Relevant legal provisions:

Criminal Law of the People’s Republic of China, article 213

Basic facts: The public prosecutor charged the defendants with the following.

From the end of November 2013 to June 2014, without the authorization of Samsung (China) Investment Co., Ltd. (hereinafter “Samsung Investment”), and for the purpose of seeking illegal profits and in collusion with Sun Shubiao and Guo Mingfeng, Guo Mingsheng made wholesale purchases from other persons of counterfeit bare SAMSUNG mobile phones and accessories, assembled them, promoted them as “genuine and authentic” in his online store “SAMSUNG Digital Shoppe” on Taobao, and sold them at a price significantly lower than the market price. The three sold a total of more than 20,000 counterfeit SAMSUNG mobile phones, achieving sales revenue of over RMB20 million and illegal profits of over RMB2 million. This formed the basis of their criminal liabilities for the crime of counterfeiting. In the joint criminal proceedings, Guo Mingsheng was found to have played a leading role and was the principal offender; Guo Mingfeng and Sun Shubiao were found to have played an assisting role and were accessories, entailing lighter punishments.

Guo Mingsheng, Sun Shubiao, Guo Mingfeng and their counsel confirmed, without dissent, the criminal facts that they, without authorization from the holder of SAMSUNG trademark, had assembled counterfeit SAMSUNG mobile phones, and had promoted and sold them through their online store on Taobao, but they filed an objection to the amount of illegal business revenue and illegal profits achieved. They contended that the real volume of business was no more than 10,000 sets, because they had hired some “click farmers” to boost the feigned credibility of their online store.

Upon investigation, the court found that “SAMSUNG” is a trademark that has been registered in China by Samsung Electronics Co. Ltd. (hereinafter “Samsung Electronics”) with validity until July 27, 2021; Samsung Investment is a company established by Samsung Electronics in China, and is specially authorized by Samsung Electronics to deal with the management and legal affairs concerning trademarks, patents, copyrights and other intellectual property rights owned by Samsung Electronics. In November 2013, Guo Mingsheng had purchased a Taobao online store (account no. play2011-1985), the storekeeper of which was “Wang Liang”, and then changed its name to “SAMSUNG Digital Counter”. Without authorization from Samsung Investment, he made wholesale purchases of counterfeit bare SAMSUNG I8552 mobile phones and accessories from Yuanwang Digital Mall at Huaqiangbei, Shenzhen, and from Tongtiandi Telecommunication Market in Futian District, Shenzhen, assembled them, and then promoted and sold them as “genuine and authentic” through his online store “SAMSUNG Digital Counter” on Taobao. Guo Mingfeng was responsible for customer service and managing customer service staff at the online store, and Sun Shubiao was responsible for sourcing, packaging and contracting with delivery companies for shipment of the counterfeit SAMSUNG I8552 mobile phones. Up until June 2014, the online store assembled and sold a total of more than 20,000 counterfeit SAMSUNG I8552 mobile phones, on an aggregated basis, achieving total sales revenue of over RMB20 million and illegal profit of over RMB2 million.

Held: Suqian Intermediate People’s Court of Jiangsu issued its judgment on September 8, 2015, finding that:

- (a) Guo Mingsheng had committed the crime of counterfeiting and issuing a sentence of five years’ imprisonment, plus a fine of RMB1.6 million;
- (b) Sun Shubiao had committed the crime of counterfeiting and issuing a sentence of three years’ imprisonment, with a five-year probation, plus a fine of RMB200,000; and
- (c) Guo Mingfeng had committed the crime of counterfeiting and issuing a sentence of three years’ imprisonment, with a four-year probation, plus a fine of RMB200,000.

None of the three defendants appealed the decision and the judgment took effect.

Reasoning: The court held, in its effective judgment, that Guo Mingsheng, Guo Mingfeng and Sun Shubiao, without Samsung Investment’s authorization or licensing, purchased counterfeit bare SAMSUNG mobile phones and accessories, assembled into mobile phones under the registered trademark “SAMSUNG”, and promoted and sold them as “genuine and authentic” through their online store. Their activities constituted illegal behavior in using the same trademark on the same product without the authorization of the holder of the registered trademark. With sales revenue of over RMB20 million and illegal profits of over RMB2 million, it constituted the very severe crime of counterfeiting.

Guo Mingsheng, Guo Mingfeng and Sun Shubiao filed an objection to the amount of illegal business revenue and illegal profit assessed by contending that they had hired “click farmers” to boost the feigned credibility of the online store. However, the three defendants’ confessions, as well as delivery bills, records of payment transfers from Alipay to Guo Mingfeng’s bank account, records of payments from Guo Mingfeng’s bank account, records of the Taobao online store “SAMSUNG Digital Counter”, data records of delivery companies, records seized on site by the Public Security Department and other evidences collected by the Public Prosecution Department, corroborated each other to establish the prosecution’s charge that the defendants had in fact sold a total of more than 20,000 counterfeit SAMSUNG I8552 mobile phones, achieving sales revenue of over RMB20 million and illegal profit of over RMB2 million. The defense put forward of “click farming” to feign sales and boost credibility was not supported by the evidence, and hence was found to be inadmissible. Guo Mingsheng, Guo Mingfeng and Sun Shubiao were jointly liable for the offence, in which Guo Mingsheng played a leading role and was the principal offender, and Guo Mingfeng and Sun Shubiao played an assisting role and were accessories, and therefore should be given lighter punishments.

世界知识产权组织 知识产权典型案例集 中华人民共和国卷 (2011-2018)

中华人民共和国最高人民法院
世界知识产权组织



前言

我很高兴地为世界知识产权组织发布的新系列的第一卷作序。《世界知识产权组织知识产权典型案例集》将先后推出多卷，按司法管辖区或主题阐明知识产权案件的审判方法和趋势，使全球知识产权界了解世界上最活跃的诉讼管辖区作出的具有里程碑意义的判决。

全球各个社会和各个经济体的技术变革正在颠覆现行的知识产权制度。然而，国家层面和多边层面缓慢的准则制定进程意味着决策者并非总是可以为即将出现的紧迫问题找到解决方案。在这样的背景下，知识产权生态系统中的创新者和其他主体越来越多地寻求通过法院来解决那些尚未找到答案并且具有重大文化和经济影响的问题，从而使法院不仅在国境之内，而且在全球经济中，对塑造知识产权发展的框架发挥出越来越大的作用。

产权组织的愿景，是通过产权组织司法研究所——一个在司法机构之间共享信息和经验的论坛——为在文化、政治和社会方面既多元化又全球化的经济中，更好地理解复杂的知识产权问题提供支持。产权组织有幸仰赖世界各地的司法机构之间所开展的强有力的合作，来提升我们关于知识产权司法管理状况的集体知识。

由中华人民共和国最高人民法院和产权组织司法研究所合作出版的这本合集正是上述合作的成果，其中介绍了最高人民法院在 2011 年至 2018 年期间审判的 30 个典型案例。

中国是知识产权强国。产权组织的年度出版物《世界知识产权指数》(2019年版)显示,2018年全球专利申请中几近半数来自中国。中国在其知识产权制度的现代化方面,包括知识产权司法管理领域,也同样具有创新精神。受2014年在北京、上海和广州设立的三个知识产权专门法院的推动,中国这种特有的知识产权审判架构得到扩大,现已包括南京和其他20个城市中级人民法院的知识产权法庭。最近的举措是,2019年1月,最高人民法院设立了知识产权法庭,为知识产权案件提供了国家级的上诉机制。因此,与中国最高人民法院共同出版此书,我们深感荣幸。

我希望以中文和英文出版的《世界知识产权组织知识产权典型案例集》(中华人民共和国卷(2011-2018)),将使广大读者了解最高人民法院作出的重要判例,帮助法官、律师、学者和决策者了解中国为解决新型法律问题而采取的司法途径。

世界知识产权组织总干事
弗朗西斯·高锐

序 言

加强国际司法交流与合作 共创知识产权保护事业 的美好未来

保护知识产权，就是保护智慧和创造，保护市场的创新和竞争活力，保护国家创新和发展的动力源泉。当前，全球迎来了新一轮科技革命与产业变革，在给人类经济社会发展带来深远影响的同时，也给知识产权保护事业带来新的挑战和机遇。加强知识产权保护不仅是**中国履行国际义务的庄严承诺**，更是**中国加快创新型国家建设、实现现代化建设“两个一百年”奋斗目标的必然要求**。中国始终高度重视知识产权保护工作，最高人民法院在改革完善知识产权保护体系、健全知识产权司法保护制度、明晰保护标准、加大司法保护力度等方面付出了持续不懈的努力。三十多年以来，中国的知识产权司法保护事业取得了举世公认的巨大成就。知识产权案件数量持续大幅增长，案件审判质效不断提高，审判体制机制不断健全，司法保护体系不断完善。中国法院充分发挥司法保护主导作用，通过典型案件审理、制定司法解释和司法政策、发布指导性案例等多种方式，不断提高知识产权司法保护水平，为推动科技创新、经济发展和文化繁荣作出了重要贡献。

案例指导制度是最高人民法院为总结审判经验、加强监督指导、统一法律适用、提高审判质量、维护司法公正而建立的一项具有中国特色的司法制度。自2008年起，最高人民法院即开始积极探索构建多样化的知识产权案例指导方式，倡导在裁判文书中援引典型案例的裁判规则作为说理依据。通过在每年“世界知识产权日”期间对外公布《最高人民法院知识产权案件年度报告》、中国法院知识产权司法保护十大案件及五十个典型案例等方式，及时总结中国知识产权司法保护的新成果、新经验。本次入选本案例集的全部案例，均精选自最高人民法院于近年来通过各种方式公布的典型案例，涉及著作权、商标权、专利权、商业秘密、植物新品种、集成电路布图设计、垄断和不正当竞争，以及刑事执法等多个领域，它们是鲜活的中国知识产权司法保护实践的缩影，充分体现了中国法院为知识产权司法保护做出的巨大努力和取得的显著进步。

中国法院始终坚持开放思维和世界眼光，不断加强与世界知识产权组织等国际组织以及有关国家的交流与合作，在知识产权司法保护、人员培训与交流、学术研究等方面都取得了卓有成效的合作成果。近年来，世界知识产权组织高度重视知识产权司法保护，开展了大量卓有成效的开创性工作，有力推动了各国在知识产权司法保护领域的对话与合作。最高人民法院与世界知识产权组织以中英双语方式合作出版的本案例集，是世界知识产权组织编辑出版的《世界知识产权组织知识产权典型案例集》系列的第一卷。这既是世界知识产权组织对中国知识产权司法保护所作努力的高度认可，也是双方深入开展全面务实合作的又一丰硕成果，标志着双方合作的广度和深度都跨上了新的台阶。最高人民法院也希望通过本案例集的出版，继续为世界知识产权事业的发展贡献“中国经验”和“中国智慧”，以不断加强与世界知识产权组织等国际组织，以及相关国家的交流与合作，共创知识产权保护事业的美好未来！

是为序。

中华人民共和国二级大法官、最高人民法院副院长 陶凯元

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第一章

商标案件

A. 姓名权可以构成商标法保护的“在先权利”

裁判要旨：

姓名权是自然人对其姓名享有的重要人身权，姓名权可以构成 2001 年修正的《中华人民共和国商标法》第三十一条规定的“在先权利”。

“使用”是姓名权人享有的权利内容之一，并非其承担的义务，更不是姓名权人主张保护其姓名权的法定前提条件。在符合有关姓名权保护条件的情况下，自然人有权根据 2001 年修正的《中华人民共和国商标法》第三十一条的规定，就其并未主动使用的特定名称获得姓名权的保护。

自然人就特定名称主张姓名权保护的，该特定名称应当符合三项条件：

- 其一，该特定名称在我国具有一定的知名度、为相关公众所知悉；
- 其二，相关公众使用该特定名称指代该自然人；
- 其三，该特定名称已经与该自然人之间建立了稳定的对应关系。

外国人外文姓名的中文译名如符合前述三项条件，可以依法主张姓名权的保护。

商标权人主张的市场秩序或者商业成功并不完全是诚信经营的合法成果，而是一定程度上建立于相关公众误认的基础之上。维护此种市场秩序或者商业成功，不仅不利于保护姓名权人的合法权益，而且不利于保障消费者的利益，更不利于净化商标注册和使用环境。

迈克尔·杰弗里·乔丹与商标评审委员会、乔丹体育股份有限公司商标争议行政系列纠纷案

案号：

最高人民法院（2016）最高法行再 27 号

案由：

商标争议行政纠纷

合议庭成员：

陶凯元 | 王 闯 | 夏君丽 | 王艳芳 | 杜微科

关键词：

商标，争议程序，在先权利，姓名权，特定名称，使用恶意，诚实信用，市场秩序

相关法条：

《中华人民共和国民法通则》第四条、第八十九条
 《中华人民共和国侵权责任法》第二条、第二十条
 《中华人民共和国商标法》（2001 年修正）第三十一条

基本案情：在再审申请人迈克尔·杰弗里·乔丹（以下简称乔丹）与被申请人国家工商行政管理总局商标评审委员会（以下简称商标评审委员会）、一审第三人乔丹体育股份有限公司（以下简称乔丹公司）商标争议行政纠纷案（以下简称“乔丹”商标争议案）中，第 6020569 号“乔丹”商标（以下简称争议商标）由乔丹公司于 2007 年 4 月 26 日提出注册申请，核定使用在国际分类第 28 类的“体育活动器械、游泳池（娱乐用）、旱冰鞋、圣诞树装饰品（灯饰和糖果除外）”商品上，专用权期限自 2012 年 3 月 28 日至 2022 年 3 月 27 日。2012 年 10 月 31 日，乔丹以争议商标的注册损害了其在先权利等为由，提出撤销申请。2014 年 4 月 14 日，商标评审委员会作出商评字〔2014〕第 052058 号《关于第 6020569 号“乔丹”

商标争议裁定》(以下简称第 052058 号裁定)，对争议商标的注册予以维持。乔丹不服，提起行政诉讼。

北京市第一中级人民法院一审认为，本案证据尚不足以证明单独的“乔丹”明确指向乔丹。此外，争议商标指定使用的商品与乔丹具有影响力的篮球运动领域差别较大，相关公众不易将争议商标与乔丹相联系，现有证据不足以证明争议商标的注册与使用不当利用了乔丹的知名度，或可能对乔丹的姓名权造成其他影响。争议商标的注册未损害乔丹的姓名权。一审法院遂判决维持第 052058 号裁定。乔丹不服，提起上诉。北京市高级人民法院二审判决驳回上诉、维持原判。乔丹仍不服，向最高人民法院申请再审，最高人民法院裁定提审本案。

裁判结果：最高人民法院提审后，于 2016 年 12 月 8 日作出 (2016) 最高法行再 27 号行政判决：撤销商标评审委员会第 052058 号裁定和一审、二审判决，判令商标评审委员会对争议商标重新作出裁定。

裁判理由：最高人民法院提审判决认为：本案争议焦点为争议商标的注册是否损害了再审申请人就“乔丹”主张的姓名权，违反《中华人民共和国商标法》第三十一条关于“申请商标注册不得损害他人现有的在先权利”的规定。

该争议焦点分为以下八个具体问题：

- 第一，再审申请人主张保护姓名权的法律依据是什么？
- 第二，再审申请人主张的姓名权所保护的具体内容是什么？
- 第三，再审申请人在我国具有何种程度和范围的知名度？
- 第四，再审申请人及其授权的耐克公司是否主动使用“乔丹”，其是否主动使用的事实对于再审申请人在本案中主张的姓名权有何影响？
- 第五，争议商标的具体情形是否会使相关公众误认为与再审申请人具有关联？

第六，乔丹公司对于争议商标的注册是否存在明显的主观恶意？

第七，乔丹公司的经营状况，以及乔丹公司对其企业名称、有关商标的宣传、使用、获奖、被保护等情况，对本案具有何种影响？

第八，再审申请人是否具有急于保护其主张的姓名权的情形，该情形对本案有何影响？

对于上述八个具体问题，最高人民法院分别认定如下：

一、关于再审申请人主张保护姓名权的法律依据

《中华人民共和国商标法》(2001 年修正)第三十一条规定：“申请商标注册不得损害他人现有的在先权利”。对于商标法已有特别规定的在先权利，应当根据商标法的特别规定予以保护。对于商标法虽无特别规定，但根据民法通则、侵权责任法和其他法律的规定应予保护，并且在争议商标申请日之前已由民事主体依法享有的民事权利或者民事权益，应当根据该概括性规定给予保护。《中华人民共和国民法通则》第九十九条第一款、《中华人民共和国侵权责任法》第二条第二款均明确规定，自然人依法享有姓名权。故姓名权可以构成《中华人民共和国商标法》第三十一条规定的“在先权利”。争议商标的注册损害他人姓名权的，应当认定该争议商标的注册违反《中华人民共和国商标法》第三十一条的规定。

姓名被用于指代、称呼、区分特定的自然人，姓名权是自然人对其姓名享有的重要人身权。随着我国社会主义市场经济不断发展，具有一定知名度的自然人将其姓名进行商业化利用，通过合同等方式为特定商品、服务代言并获得经济利益的现象已经日益普遍。在适用《中华人民共和国商标法》第三十一条的规定对他人的在先姓名权予以保护时，不仅涉及对自然人人格尊严的保护，而且涉及对自然人姓名，尤其是知名人物姓名所蕴含的经济利益的保护。未经许可擅自将他人享有在先姓名权的姓名注册为商标，容易导致相关公众误认为标记有该商标

的商品或者服务与该自然人存在代言、许可等特定联系的，应当认定该商标的注册损害他人的在先姓名权，违反《中华人民共和国商标法》第三十一条的规定。

二、关于再审申请人主张的姓名权所保护的具体内容

自然人依据《中华人民共和国商标法》第三十一条的规定，就特定名称主张姓名权保护时，应当满足必要的条件。

其一，该特定名称应具有一定知名度、为相关公众所知悉，并用于指代该自然人。《最高人民法院关于审理不正当竞争民事案件应用法律若干问题的解释》第六条第二款是针对“擅自使用他人的姓名，引人误认为是他人的商品”的不正当竞争行为的认定作出的司法解释，该不正当竞争行为本质上也是损害他人姓名权的侵权行为。认定该行为时所涉及的“引人误认为是他人的商品”，与本案中认定争议商标的注册是否容易导致相关公众误认为存在代言、许可等特定联系是密切相关的。因此，在本案中可参照适用上述司法解释的规定，确定自然人姓名权保护的条件。

其二，该特定名称应与该自然人之间已建立稳定的对应关系。在解决本案涉及的在先姓名权与注册商标权的权利冲突时，应合理确定在先姓名权的保护标准，平衡在先姓名权人与商标权人的利益。既不能由于争议商标标志中使用或包含有仅为部分人所知悉或临时性使用的自然人“姓名”，即认定争议商标的注册损害该自然人的姓名权；也不能如商标评审委员会所主张的那样，以自然人主张的“姓名”与该自然人形成“唯一”对应为前提，对自然人主张姓名权的保护提出过苛的标准。自然人所主张的特定名称与该自然人已经建立稳定的对应关系时，即使该对应关系达不到“唯一”的程度，也可以依法获得姓名权的保护。综上，在适用《中华人民共和国商标法》第三十一条关于“不得损害他人现有的在先权利”的规定时，自然人就特定名称主张姓名权保护的，该特定名称应当符合以下三项条件：其一，该特定名称在我国具有一定的知名度、为相关公众所知悉；其二，相关公众使用该特定名称指

代该自然人；其三，该特定名称已经与该自然人之间建立了稳定的对应关系。

在判断外国人能否就其外文姓名的部分中文译名主张姓名权保护时，需要考虑我国相关公众对外国人的称谓习惯。中文译名符合前述三项条件的，可以依法主张姓名权的保护。本案现有证据足以证明“乔丹”在我国具有较高的知名度、为相关公众所知悉，我国相关公众通常以“乔丹”指代再审申请人，并且“乔丹”已经与再审申请人之间形成了稳定的对应关系，故再审申请人就“乔丹”享有姓名权。

三、关于再审申请人在我国具有何种程度和范围的知名度

正确认定再审申请人在我国具有何种程度和范围的知名度，对于认定再审申请人能否就“乔丹”享有姓名权，乔丹公司对于争议商标的注册是否存在明显的主观恶意，以及相关公众是否会误认为标记有争议商标的商品与再审申请人具有关联等具体问题均具有重要影响。

本案证据可以证明在争议商标的申请日之前，直至2015年，再审申请人在我国一直具有较高的知名度，其知名范围已不仅仅局限于篮球运动领域，而是已成为具有较高知名度的公众人物。

四、关于再审申请人及其授权的耐克公司是否主动使用“乔丹”，其是否主动使用的事实对于再审申请人在本案中主张的姓名权有何影响

首先，根据《中华人民共和国民法通则》第九十九条第一款的规定，“使用”是姓名权人享有的权利内容之一，并非其承担的义务，更不是姓名权人“禁止他人干涉、盗用、假冒”，主张保护其姓名权的法定前提条件。

其次，在适用《中华人民共和国商标法》第三十一条的规定保护他人在先姓名权时，相关公众是否容易误认为标记有争议商标的商品或者服务与该自然人存在代言、许可等特定联系，是认定争议商标的注册是否损害该自然人姓名权的重要因素。因此，

在符合前述有关姓名权保护的三项条件的情况下，自然人有权根据《中华人民共和国商标法》第三十一条的规定，就其并未主动使用的特定名称获得姓名权的保护。

最后，对于在我国具有一定知名度的外国人，其本人或者利害关系人可能并未在我国境内主动使用其姓名；或者由于便于称呼、语言习惯、文化差异等原因，我国相关公众、新闻媒体所熟悉和使用的“姓名”与其主动使用的姓名并不完全相同。例如在本案中，我国相关公众、新闻媒体普遍以“乔丹”指代再审申请人，而再审申请人、耐克公司则主要使用“迈克尔·乔丹”。但不论是“迈克尔·乔丹”还是“乔丹”，在相关公众中均具有较高的知名度，均被相关公众普遍用于指代再审申请人，且再审申请人并未提出异议或者反对。故商标评审委员会、乔丹公司关于再审申请人、耐克公司未主动使用“乔丹”，再审申请人对“乔丹”不享有姓名权的主张，不予支持。

五、关于争议商标的具体情形是否会使相关公众误认为与再审申请人具有关联

本案争议商标为第 6020569 号“乔丹”商标，指定使用的商品类别为第 28 类“体育活动器械、游泳池（娱乐用）、旱冰鞋、圣诞树装饰品（灯饰和糖果除外）”。其中，“体育活动器械、游泳池（娱乐用）、旱冰鞋”均属于体育运动中常见的商品，“圣诞树装饰品（灯饰和糖果除外）”则属于日常生活中常见的商品。上述商品的相关公众容易误认为标记有争议商标的商品与再审申请人存在代言、许可等特定联系。具体理由如下：首先，本案证据足以证明再审申请人及其姓名“乔丹”在我国具有长期、广泛的知名度，相关公众熟悉并普遍使用“乔丹”指代再审申请人。“乔丹”与再审申请人之间已经建立了稳定的对应关系。因争议商标标志仅为“乔丹”文字，故相关公众看到争议商标后，容易由此联想到再审申请人本人，进而容易误认为标记有争议商标的商品与再审申请人存在代言、许可等特定联系。其次，乔丹公司在《招股说明书》之“品牌风险”中特别注明：“特别提醒投资者‘可能会有部分消费者将发行人及其产品与迈克尔·乔丹联系起来从

而产生误解或混淆，在此特提请投资者注意。’”这表明其已经认识到相关公众容易将“乔丹”与再审申请人相互联系，可能导致相关公众误认。乔丹公司在一审庭审笔录中，亦认可“确实会有没有购买过我方商品的公众会产生联系的可能”。最后，两份调查报告可以与其他证据结合，进一步证明相关公众容易误认为“乔丹”与再审申请人存在特定联系。

六、关于乔丹公司对于争议商标的注册是否存在明显的主观恶意

本案中，乔丹公司申请注册争议商标时是否存在主观恶意，是认定争议商标的注册是否损害再审申请人姓名权的重要考量因素。本案证据足以证明乔丹公司是在明知再审申请人及其姓名“乔丹”具有较高知名度的情况下，并未与再审申请人协商、谈判以获得其许可或授权，而是擅自注册了包括争议商标在内的大量与再审申请人密切相关的商标，放任相关公众误认为标记有争议商标的商品与再审申请人存在特定联系的损害结果，使得乔丹公司无需付出过多成本，即可实现由再审申请人为其“代言”等效果。乔丹公司的行为有违《中华人民共和国民法通则》第四条规定的诚实信用原则，其对于争议商标的注册具有明显的主观恶意。

七、关于乔丹公司的经营状况，以及乔丹公司对其企业名称、有关商标的宣传、使用、获奖、被保护等情况，对本案具有何种影响

乔丹公司的经营状况，以及乔丹公司对其企业名称、有关商标的宣传、使用、获奖、被保护等情况，均不足以使争议商标的注册具有合法性。

其一，从权利的性质以及损害在先姓名权的构成要件来看，姓名被用于指代、称呼、区分特定的自然人，姓名权是自然人对其姓名享有的人身权。而商标的主要作用在于区分商品或者服务来源，属于财产权，与姓名权是性质不同的权利。在认定争议商标的注册是否损害他人在先姓名权时，关键在于是否容易导致相关公众误认为标

记有争议商标的商品或者服务与姓名权人之间存在代言、许可等特定联系，其构成要件与侵害商标权的认定不同。因此，即使乔丹公司经过多年的经营、宣传和使用，使得乔丹公司及其“乔丹”商标在特定商品类别上具有较高知名度，相关公众能够认识到标记有“乔丹”商标的商品来源于乔丹公司，也不足以据此认定相关公众不容易误认为标记有“乔丹”商标的商品与乔丹之间存在代言、许可等特定联系。

其二，乔丹公司恶意申请注册争议商标，损害乔丹的在先姓名权，明显有悖于诚实信用原则。商标评审委员会、乔丹公司主张的市场秩序或者商业成功并不完全是乔丹公司诚信经营的合法成果，而是一定程度上建立于相关公众误认的基础之上。维护此种市场秩序或者商业成功，不仅不利于保护姓名权人的合法权益，而且不利于保障消费者的利益，更不利于净化商标注册和使用环境。

八、关于再审申请人是否具有怠于保护其主张的姓名权的情形，该情形对本案有何影响

《中华人民共和国商标法》第四十一条第二款规定：“已经注册的商标，违反本法……第三十一条规定的，自商标注册之日起五年内，……可以请求商标评审委员会裁定撤销该注册商标。”上述规定中的“自商标注册之日起五年内”是向商标评审委员会申请撤销争议商标的法定期限，立法者在规定该期限时已经充分考虑了在先权利人与商标权人之间的利益平衡。该期限可以督促权利人或者利害关系人及时主张权利，避免争议商标的法律效力在核准注册后的长时期内仍处于可争议状态，从而影响商标权人对争议商标的宣传和使用，损害商标权人的合法权益。本案中，再审申请人在争议商标注册之日起五年内向商标评审委员会提出撤销申请，符合上述法律规定。因此，商标评审委员会、乔丹公司关于再审申请人怠于保护其姓名权的主张缺乏事实和法律依据，不予支持。

B. 商标国际注册申请人应当获得合理的补正机会

裁判要旨：

商标国际注册申请人已经根据《商标国际注册马德里协定》《商标国际注册马德里协定有关议定书》的规定，完成了申请商标的国际注册程序，以及《中华人民共和国商标法实施条例》第十三条规定的声明与说明义务，应当属于申请手续基本齐备的情形。

在申请材料仅欠缺商标法实施条例规定的部分视图等形式要件的情况下，商标行政机关应当秉承积极履行国际公约义务的精神，给予申请人合理的补正机会。

克里斯蒂昂迪奥尔香料公司与商标评审委员会商标申请驳回复审行政纠纷案

案号：

最高人民法院（2018）最高法行再26号

案由：

商标申请驳回复审行政纠纷

合议庭成员：

陶凯元 | 王闯 | 佟姝

关键词：

商标，行政诉讼，国际注册，领土延伸保护

相关法条：

《中华人民共和国商标法实施条例》第十三条、第五十二条

基本案情：涉案申请商标为国际注册第1221382号商标（见下图），申请人为克里斯蒂昂迪奥尔香料公司（以下简称迪奥尔公司）。申请商标的原属国为法国，核准注册时间为2014年4月16日，国际注册日期为2014年8月8日，国际注册所有人为迪奥尔公司，指定使用商品为香水、浓香水等。



申请商标

申请商标经国际注册后，根据《商标国际注册马德里协定》《商标国际注册马德里协定有关议定书》的相关规定，迪奥尔公司通过世界知识产权组织国际局（以下简称国际局），向澳大利亚、丹麦、芬兰、英国、中国等提出领土延伸保护申请。2015年7月13日，国家工商行政管理总局商标局（以下简称商标局）向国际局发出申请商标的驳回通知书，以申请商标缺乏显著性为由，驳回全部指定商品在中国的领土延伸保护申请。在法定期限内，迪奥尔公司向国家工商行政管理总局商标评审委员会（以下简称商标评审委员会）提出复审申请。商标评审委员会认为，申请商标难以起到区别商品来源的作用，缺乏商标应有的显著性，遂以第13584号决定，驳回申请商标在中国的领土延伸保护申请。迪奥尔公司不服，提起行政诉讼。迪奥尔公司认为，

首先，申请商标为指定颜色的三维立体商标，迪奥尔公司已经向商标评审委员会提交了申请商标的三面视图，但商标评审委员会却将申请商标作为普通商标进行审查，决定作出的事实基础有误。

其次，申请商标设计独特，并通过迪奥尔公司长期的宣传推广，具有了较强的显著性，其领土延伸保护申请应当获得支持。

裁判结果：北京知识产权法院及北京市高级人民法院均未支持迪奥尔公司的诉讼主张。其主要理由为：迪奥尔公司并未在国际局国际注册簿登记之日起3个月内向商标局声明申请商标为三维标志并提交至少包含三面视图的商标图样，而是直至驳回复审阶段在第一次补充理由书中才明确提出申请商标为三维标志并提交三面视图。在迪奥尔公司未声明申请

商标为三维标志并提交相关文件的情况下，商标局将申请商标作为普通图形商标进行审查，并无不当。商标局在商标档案中对申请商标指定颜色、商标形式等信息是否存在登记错误，并非本案的审理范围，迪奥尔公司可通过其他途径寻求救济。

迪奥尔公司不服二审判决，向最高人民法院提出再审申请。最高人民法院于2017年12月29日作出（2017）最高法行申7969号行政裁定，提审本案，并于2018年4月26日作出（2018）最高法行再26号判决，撤销一审、二审判决及被诉决定，并判令商标评审委员会重新作出复审决定。

裁判理由：法院生效裁判认为，申请商标国际注册信息中明确记载，申请商标指定的商标类型为“三维立体商标”，且对三维形式进行了具体描述。在无相反证据的情况下，申请商标国际注册信息中关于商标具体类型的记载，应当视为迪奥尔公司关于申请商标为三维标志的声明形式。也可合理推定，在申请商标指定中国进行领土延伸保护的过程中，国际局向商标局转送的申请信息与之相符，商标局应知晓上述信息。因国际注册商标的申请人无需在指定国家再次提出注册申请，故由国际局向商标局转送的申请商标信息，应当是商标局据以审查、决定申请商标指定中国的领土延伸保护申请能否获得支持的事实依据。根据现有证据，申请商标请求在中国获得注册的商标类型为“三维立体商标”，而非记载于商标局档案并作为商标局、商标评审委员会审查基础的“普通商标”。迪奥尔公司已经在评审程序中明确了申请商标的具体类型为三维立体商标，并通过补充三面视图的方式提出了补正要求。对此，商标评审委员会既未在第13584号决定中予以如实记载，也未针对迪奥尔公司提出的上述主张，对商标局驳回决定依据的相关事实是否有误予以核实，而仍将申请商标作为“图形商标”进行审查并进行驳回迪奥尔公司复审申请的做法，违反法定程序，并可能损及行政相对人的合法权益，应当予以纠正。商标局、商标评审委员会应当根据复审程序的规定，以三维立体商标为基础，重新对申请商标是否具备显著特征等问题予以审查。

《商标国际注册马德里协定》及其议定书制定的主要目的是通过建立国际合作机制，确立和完善商标国际注册程序，减少和简化注册手续，便利申请人以最低成本在所需国家获得商标保护。结合本案事实，申请商标作为指定中国的马德里商标国际注册申请，有关申请材料应当以国际局向商标局转送的内容为准。现有证据可以合理推定，迪奥尔公司已经在商标国际注册程序中对申请商标为三维立体商标这一事实作出声明，说明了申请商标的具体使用方式并提供了申请商标的一面视图。在申请材料仅欠缺商标法实施条例规定的部分视图等形式要件的情况下，商标行政机关应当秉承积极履行国际公约义务的精神，给予申请人合理的补正机会。本案中，商标局并未如实记载迪奥尔公司在国际注册程序中对商标类型作出的声明，且在未给予迪奥尔公司合理补正机会，并欠缺当事人请求与事实依据的情况下，径行将申请商标类型变更为普通商标并作出不利于迪奥尔公司的审查结论，商标评审委员会对此未予纠正的做法，均缺乏事实与法律依据，且可能损害行政相对人合理的期待利益，对此应予纠正。

综上，商标评审委员会应当基于迪奥尔公司在复审程序中提出的与商标类型有关的复审理由，纠正商标局的认定，并根据三维标志是否具备显著特征的评判标准，对申请商标指定中国的领土延伸保护申请是否应予准许的问题重新进行审查。商标局、商标评审委员会在重新审查认定时应重点考量如下因素：

一是申请商标的显著性与经过使用取得的显著性，特别是申请商标进入中国市场的时间，在案证据能够证明的实际使用与宣传推广的情况，以及申请商标因此而产生识别商品来源功能的可能性；

二是审查标准一致性的原则。商标评审及司法审查程序虽然要考虑个案情况，但审查的基本依据均为商标法及其相关行政法规规定，不能以个案审查为由忽视执法标准的统一性问题。

C. 恶意取得并行使商标权的行为不受法律保护

裁判要旨：

当事人违反诚实信用原则，损害他人合法权益，扰乱市场正当竞争秩序，恶意取得、行使商标权并主张他人侵权的，人民法院应当以构成权利滥用为由，判决对其诉讼请求不予支持。

王碎永与深圳歌力思服装实业有限公司等侵害商标权纠纷案

案号：

最高人民法院（2014）民提字第24号

案由：

侵害商标权纠纷

合议庭成员：

王艳芳 | 朱理 | 佟姝

关键词：

知识产权侵权，商标，诚实信用，权利滥用

相关法条：

《中华人民共和国民事诉讼法》第十三条
《中华人民共和国商标法》第五十二条

基本案情：深圳歌力思服装实业有限公司成立于1999年6月8日。2008年12月18日，该公司通过受让方式取得第1348583号“歌力思”商标，该商标核定使用于第25类的服装等商品之上，核准注册于1999年12月。2009年11月19日，该商标经核准续展注册，有效期自2009年12月28日至2019年12月27日。深圳歌力思服装实业有限公司还是第4225104号“ELLASSAY”的商标注册人。该商标核定使用商品为第18类的（动物）皮；钱包；旅行包；文件夹（皮革制）；皮制带子；裘皮；伞；手杖；手提包；购物袋。注册有效期限自2008年4月14日至2018年4月13日。2011年11月4日，深圳歌力思服装实业有限公司更名为深圳歌力思服饰股份有限公司（以下简称歌力思公司，即本案一审被告人）。2012年3

月1日，上述“歌力思”商标的注册人相应变更为歌力思公司。

一审原告人王碎永于2011年6月申请注册了第7925873号“歌力思”商标，该商标核定使用商品为第18类的钱包、手提包等。王碎永还曾于2004年7月7日申请注册第4157840号“歌力思及图”商标。后因北京市高级人民法院于2014年4月2日作出的二审判决认定，该商标损害了歌力思公司的关联企业歌力思投资管理有限公司的在先字号权，因此不应予以核准注册。

自2011年9月起，王碎永先后在杭州、南京、上海、福州等地的“ELLASSAY”专柜，通过公证程序购买了带有“品牌中文名：歌力思，品牌英文名：ELLASSAY”字样吊牌的皮包。2012年3月7日，王碎永以歌力思公司及杭州银泰世纪百货有限公司（以下简称杭州银泰公司）生产、销售上述皮包的行为构成对王碎永拥有的“歌力思”商标、“歌力思及图”商标权的侵害为由，提起诉讼。

裁判结果：杭州市中级人民法院于2013年2月1日作出（2012）浙杭知初字第362号民事判决，认为歌力思公司及杭州银泰公司生产、销售被诉侵权商品的行为侵害了王碎永的注册商标专用权，判决歌力思公司、杭州银泰公司承担停止侵权行为、赔偿王碎永经济损失及合理费用共计10万元及消除影响。

歌力思公司不服，提起上诉。浙江省高级人民法院于2013年6月7日作出（2013）浙知终字第222号民事判决，驳回上诉、维持原判。

歌力思公司及王碎永均不服，向最高人民法院申请再审。最高人民法院裁定提审本案，并于2014年8月14日作出（2014）民提字第24号判决，撤销一审、二审判决，驳回王碎永的全部诉讼请求。

裁判理由：最高人民法院提审认为：诚实信用原则是一切市场活动参与者所应遵循的基本准则。一方面，它鼓励和支持人们通过诚实劳动积累社会财富和创造社

会价值，并保护在此基础上形成的财产性权益，以及基于合法、正当的目的支配该财产性权益的自由和权利；另一方面，它又要求人们在市场活动中讲究信用、诚实不欺，在不损害他人合法权益、社会公共利益和市场秩序的前提下追求自己的利益。民事诉讼活动同样应当遵循诚实信用原则。一方面，它保障当事人有权在法律规定的范围内行使和处分自己的民事权利和诉讼权利；另一方面，它又要求当事人在不损害他人和社会公共利益的前提下，善意、审慎地行使自己的权利。任何违背法律目的和精神，以损害他人正当权益为目的，恶意取得并行使权利、扰乱市场正当竞争秩序的行为均属于权利滥用，其相关权利主张不应得到法律的保护和支持。

第4157840号“歌力思及图”商标迄今为止尚未被核准注册，王碎永无权据此对他人提起侵害商标权之诉。对于歌力思公司、杭州银泰公司的行为是否侵害王碎永的第7925873号“歌力思”商标权的问题，

首先，歌力思公司拥有合法的在先权利基础。歌力思公司及其关联企业最早将“歌力思”作为企业字号使用的时间为1996年，最早在服装等商品上取得“歌力思”注册商标专用权的时间为1999年。经长期使用和广泛宣传，作为企业字号和注册商标的“歌力思”已经具有了较高的市场知名度，歌力思公司对前述商业标识享有合法的在先权利。

其次，歌力思公司在本案中的使用行为系基于合法的权利基础，使用方式和行为性质均具有正当性。从销售场所来看，歌力思公司对被诉侵权商品的展示和销售行为均完成于杭州银泰公司的歌力思专柜，专柜通过标注歌力思公司的“ELLASSAY”商标等方式，明确表明了被诉侵权商品的提供者。在歌力思公司的字号、商标等商业标识已经具有较高的市场知名度，而王碎永未能举证证明其“歌力思”商标同样具有知名度的情况下，歌力思公司在其专柜中销售被诉侵权商品的行为，不会使普通消费者误认该商品来自于王碎永。从歌力思公司的具体使用方式来看，被诉侵权商品的外包装、商品内的显著部位均

明确标注了“ELLASSAY”商标，而仅在商品吊牌之上使用了“品牌中文名：歌力思”的字样。由于“歌力思”本身就是歌力思公司的企业字号，且与其“ELLASSAY”商标具有互为指代关系，故歌力思公司在被诉侵权商品的吊牌上使用“歌力思”文字来指代商品生产者的做法并无明显不妥，不具有攀附王碎永“歌力思”商标知名度的主观意图，亦不会为普通消费者正确识别被诉侵权商品的来源制造障碍。在此基础上，杭州银泰公司销售被诉侵权商品的行为亦不为法律所禁止。

最后，王碎永取得和行使“歌力思”商标权的行为难谓正当。“歌力思”商标由中文文字“歌力思”构成，与歌力思公司在先使用的企业字号及在先注册的“歌力思”商标的文字构成完全相同。“歌力思”本身为无固有含义的臆造词，具有较强的固有显著性，依常理判断，在完全没有接触或知悉的情况下，因巧合而出现雷同注册的可能性较低。作为地域接近、经营范围关联程度较高的商品经营者，王碎永对“歌力思”字号及商标完全不了解的可能性较低。在上述情形之下，王碎永仍在手提包、钱包等商品上申请注册“歌力思”商标，其行为难谓正当。

王碎永以非善意取得的商标权对歌力思公司的正当使用行为提起的侵权之诉，构成权利滥用。

D. 楼盘名称与注册商标权的保护及擅自使用他人企业名称的判断

裁判要旨：

将申请人享有注册商标专用权的商标作为楼盘名称使用构成侵犯注册商标专用权

他人善意使用诉争名称的时间早于权利人对其企业名称的使用，该使用行为不构成擅自使用他人企业名称的行为。

广州星河湾实业发展有限公司、广州宏富房地产有限公司与江苏炜赋集团建设开发有限公司侵害商标权及不正当竞争纠纷案

案号：

最高人民法院（2013）民提字第102号

案由：

侵害商标权及不正当竞争纠纷

合议庭成员：

王 闯 | 王艳芳 | 朱 理

关键词：

商标侵权，不正当竞争，楼盘名称，企业名称，在先使用

相关法条：

《中华人民共和国商标法》（2001年修正）第五十二条

《最高人民法院关于审理商标民事纠纷案件适用法律若干问题的解释》第九条、第十条、第二十一条

基本案情：在再审申请人广州星河湾实业发展有限公司（以下简称星河湾公司）、广州宏富房地产有限公司（以下简称宏富公司）与被申请人江苏炜赋集团建设开发有限公司（以下简称炜赋公司）侵害商标权及不正当竞争纠纷案（以下简称“星河湾”商标侵权及不正当竞争案）中，核定使用在第36类“公寓出租、公寓管理”等服务上的第1946396号和第1948763号组合商标由宏富公司提出注册申请，后先后转让给案外人宏宇企业集团（香港）有限公司（以下简称宏宇公司）及星河湾公司。



宏富公司经许可可使用上述两注册商标，并有权以自身的名义提起侵权诉讼。宏富公司及其关联企业先后在广州、北京、上海等地开发以“星河湾”命名的地产项目，“星河湾”地产项目及宏宇集团、星河湾公司先后获得多项荣誉。

自2000年起，炜赋公司在江苏省南通市先后推出“星河湾花园”“星辰花园”“星景花园”等多个地产项目，小区名称均报经南通市民政局批准。星河湾公司、宏富公司以炜赋公司在开发的不动产项目中使用了“星河湾”字样，侵害其注册商标权并构成不正当竞争为由，提起诉讼。

江苏省南通市中级人民法院一审认为，炜赋公司使用“星河湾花园”作为其开发的楼盘名称，未导致消费者对该楼盘来源产生混淆，不构成商标侵权。宏富公司开发的“星河湾”楼盘在广州地区具有较高知名度，但炜赋公司长期正当、合理使用“星河湾花园”这一名称，主观上并无搭便车之故意，客观上也未造成消费者误认，故炜赋公司使用该名称不构成不正当竞争。遂判决驳回星河湾公司、宏富公司的诉讼请求。

星河湾公司、宏富公司不服，向江苏省高级人民法院提起上诉。

江苏省高级人民法院二审判决驳回上诉、维持原判。星河湾公司、宏富公司仍不服，向最高人民法院申请再审。最高人民法院裁定提审本案。

裁判结果：最高人民法院于2015年2月26日作出(2013)民提字第102号民事判决：判决撤销一审、二审判决，判令炜赋公司在其尚未出售的楼盘和将来拟开发的楼盘上不得使用相关“星河湾”名称作为其楼盘名称，并赔偿星河湾公司、宏富公司经济损失5万元。

裁判理由：最高人民法院提审认为：关于被申请人将申请人享有注册商标专用权的商标作为楼盘名称使用是否构成侵犯注册商标专用权的问题。根据《中华人民共和国商标法》实施条例第五十条第(一)项规定，“同一种或者类似商品上，将与他人注册商标相同或者近似的标志作为商品名称或者商品装潢使用，误导公众的”属于《中华人民共和国商标法》第五十二条第(五)项所称的侵犯注册商标专用权行为。本案中，星河湾公司享有第1946396号、第1948763号注册商标的专用权，两商标分别核定使用于第36类的不动产出租、不动产代理等服务和第37类的建筑、室内装潢修理等服务，炜赋公司在商品房上使用该商品名称。关于商品房与不动产建造是否构成商品与服务类似的问题，根据《最高人民法院关于审理商标民事纠纷案件适用法律若干问题的解释》第十一条第三款之规定，商品与服务类似，是指商品和服务之间存在特定联系，容易使相关公众混淆。本案两注册商标核定的服务类别分别是不动产管理、建筑等，与商品房销售相比，两者功能用途、消费对象、销售渠道基本相同，开发者均系相关房地产开发商，不动产管理、建筑等服务与商品房销售存在特定的联系，应当认定为商品与服务之间的类似。

关于使用“星河湾花园”商品名称是否会误导公众的问题。根据原审法院查明的事实，从2001年起，宏富公司等单位就开始在南方日报、羊城晚报等相关媒体上对星河湾楼盘进行宣传，“星河湾”命名的楼盘先后获得了相关荣誉，具有较高的知名度，因此“星河湾”文字系该注册商标中最具有显著性和知名度的部分。炜赋公司将其开发的楼盘命名为“星河湾花园”，由于该名称事实上起到了识别该楼盘的作用，其实质也属于一种商业标识，该标识中“花园”为楼盘名称的一般用语，其最显著的部分为“星河湾”文字，与星河湾公司、宏富公司上述两个注册商标中的显著部分“星河湾”完全相同，呼叫方式一致，加之现代社会信息流通丰富快捷，相关房地产开发商在全国各地陆续开发系列房地产楼盘亦非罕见，

炜赋公司此种使用方式会使相关公众误认该楼盘与星河湾公司、宏富公司开发的“星河湾”系列楼盘有一定的联系，容易误导公众。因此，炜赋公司将与星河湾公司享有商标专用权的“星河湾”商标相近似的“星河湾花园”标识作为楼盘名称使用，容易使相关公众造成混淆误认，构成对星河湾公司、宏富公司相关商标权的侵犯，应当承担相应的民事责任。原审法院认为其仅作为楼盘名称使用，不可能使相关公众对楼盘及其服务的来源产生混淆，该认定错误，最高人民法院予以纠正。

关于是否构成擅自使用他人企业名称的问题。最高人民法院认为，根据原审法院查明的事实，星河湾公司原名为广州明宇木业有限公司，2007年8月更名为星河湾公司。以“星”字开头命名楼盘名称，是炜赋公司自2000年以来形成的习惯和传统，且早在2006年5月15日，炜赋公司已向南通市民政局申请命名该小区为“炜赋·星河湾”，理由为：继星辰花园、星景花园后仍以“星”字开头，因保留该地原有两条河流穿过小区，故以“炜赋·星河湾”命名。同年5月25日，南通市民政局批复同意炜赋公司将该住宅区命名为“星河湾花园”，因此诉争楼盘名称的使用先于星河湾公司企业名称的使用，该种使用并不属于擅自使用他人企业名称的行为。

E. 判断中外文商标是否构成近似应当考虑二者是否已经形成了稳定的对应关系

裁判要旨：

判断中文商标与外文商标是否构成近似，不仅要考虑商标构成要素及其整体的近似程度、相关商标的显著性和知名度、所使用商品的关联程度等因素，还应考虑二者是否已经在相关公众之间形成了稳定的对应关系。

拉菲罗斯柴尔德酒庄与商标评审委员会、南京金色希望酒业有限公司商标争议行政纠纷案

案号：

最高人民法院（2016）最高法行再34号

案由：

商标争议行政纠纷

合议庭成员：

王艳芳 | 钱小红 | 杜微科

关键词：

商标，争议程序，商标近似，对应关系

相关法条：

《中华人民共和国商标法》第二十八条

基本案情：在再审申请人拉菲罗斯柴尔德酒庄（以下简称拉菲酒庄）与被申请人国家工商行政管理总局商标评审委员会（以下简称商标评审委员会）、南京金色希望酒业有限公司（以下简称金色希望公司）商标争议行政纠纷案（以下简称“拉菲庄园”商标争议案）中，第4578349号“拉菲庄园”商标（即争议商标）的申请日为2005年4月1日，核定使用在第33类葡萄酒、酒（饮料）、果酒（含酒精）、蒸馏酒精饮料、苹果酒、含酒精液体、含水果的酒精饮料、米酒、青稞酒、料酒商品上，注册商标专用权人为金色希望公司。“LAFITE”商标（即引证商标）申请日为1996年10月10日，核定使用在第33类的含酒精饮料（啤酒除

外)商品上,注册商标专用权人为拉菲酒庄。

在法定期限内,拉菲酒庄以争议商标违反《中华人民共和国商标法》(2001年修正)第二十八条等规定为由,向商标评审委员会提出争议申请。商标评审委员会于2013年9月2日作出商评字[2013]第55856号《关于第4578349号“拉菲庄园”商标争议裁定书》(以下简称第55856号裁定),以争议商标违反《中华人民共和国商标法》第二十八条规定为由,对争议商标予以撤销。

金色希望公司不服,提起行政诉讼。

北京市第一中级人民法院一审判决维持第55856号裁定。金色希望公司不服,提起上诉。北京市高级人民法院二审认为,难以认定引证商标在争议商标申请日之前,已经在中国大陆地区具有市场知名度,相关公众已经能够将引证商标与“拉菲”进行对应性识别。争议商标的注册和使用长达十年之久,其已经形成稳定的市场秩序,从维护已经形成和稳定的市场秩序考虑,本案争议商标的注册应予维持。遂判决撤销一审判决及第55856号裁定。

拉菲酒庄不服,向最高人民法院申请再审。经查明,中国经济网2014年2月12日《质检总局公布六款进口“拉菲”葡萄酒质量不合格》报道记载,

“‘拉菲’葡萄酒一直让中国消费者对其趋之若鹜,……然而近日,国家质检总局公布六款洋拉菲酒质量不合格,让‘拉菲迷’们大跌眼镜。中国经济网了解到,六款不合格产品为:拉菲庄园2012干红葡萄酒……。”

2016年8月1日搜狐财经刊登图文消息“‘拉菲庄园’隆重登陆糖酒会消费者不知其为山寨”。

最高人民法院裁定提审本案。

裁判结果:最高人民法院于2016年12月23日作出(2016)最高法行再34号行政判决:撤销二审判决,维持一审判决及第55856号裁定。

裁判理由:最高人民法院提审认为:认定商标是否近似,既要考虑商标构成要素及其整体的近似程度,也要考虑相关商标的显著性和知名度、所使用商品的关联程度等因素,以是否容易导致混淆作为判断标准。

争议商标由中文文字“拉菲庄园”构成,“庄园”用在葡萄酒类别上显著性较弱,“拉菲”系争议商标的主要部分,判断争议商标与引证商标是否构成近似,关键在于判断“拉菲”与“LAFITE”是否构成近似或者形成了较为稳定的对应关系。

在争议商标申请日前,根据法院查明的事实,各类宣传报道中即有将引证商标“LAFITE”音译为“拉菲”的情况,且《新快报》《扬子晚报》《北京日报》等刊物属于消费者容易接触到的,受众面较大的宣传媒介。相关媒体所载文章均对“LAFITE”葡萄酒给予了极高评价,引证商标具有较高的知名度。

此外,拉菲酒庄通过多年的商业经营活动,客观上在“拉菲”与“LAFITE”之间建立了稳固的联系,我国相关公众通常以“拉菲”指代“LAFITE”商标,争议商标与引证商标构成近似商标。此外,对于已经注册使用一段时间的商标,是否已经通过使用建立较高市场声誉和形成自身的相关公众群体,并非由使用时间决定,而是要看相关公众能否通过其使用行为,在客观上实现了与其他商标的区分。根据法院查明的事实,有关新闻报道所涉不合格产品,均系使用了争议商标的相关产品。从相关新闻报道也可以看出,相关公众对争议商标与引证商标已经混淆误认。因此,金色希望公司提交的证据未能证明其通过对争议商标的使用已经形成了相关公众群体,二审法院所作争议商标已经形成了稳定的市场秩序的结论并无事实依据,最高人民法院予以纠正。

F. 商标法关于“其他不正当手段取得注册”的认定

裁判要旨：

2001年《中华人民共和国商标法》第四十一条第一款规定的“以其他不正当手段取得注册”，是指以欺骗手段以外，扰乱商标注册秩序、损害公共利益、不正当占用公共资源或者以其他方式谋取不正当利益的手段取得注册；民事主体申请注册商标，应该有使用的真实意图，其申请注册商标行为应具有合理性或正当性。

李隆丰与商标评审委员会、三亚市海棠湾管理委员会商标争议行政纠纷案

案号：

最高人民法院（2013）知行字第41、（2013）知行字第42号

案由：

商标争议行政纠纷

合议庭成员：

夏君丽 | 殷少平 | 董晓敏

关键词：

商标注册，其他不正当手段

相关法条：

《中华人民共和国商标法》（2001年修正）第四条、第四十一条

基本案情：再审申请人李隆丰与国家工商行政管理总局商标评审委员会（以下简称商标评审委员会）、一审第三人三亚市海棠湾管理委员会（以下简称海棠湾管委会）商标争议行政纠纷案中，李隆丰于2005年6月8日在第36类的不动产出租、不动产管理、住所（公寓）等服务上注册了第4706493号“海棠湾”商标，在第43类住所（旅馆、供膳寄宿处）、旅游房屋出租、饭店、餐馆等服务上注册了第4706970号“海棠湾”商标（即两争议商标）。海棠湾管委会依据《中华人民共和国商标法》

第三十一条、第四十一条第一款、第十条规定向商标评审委员会申请撤销上述两争议商标。商标评审委员会分别作出商评字〔2011〕第13255号《关于第4706493号“海棠湾”商标争议裁定书》（以下简称第13255号裁定）和〔2011〕第12545号《关于第4706970号“海棠湾”商标争议裁定书》（以下简称第12545号裁定），裁定撤销上述两个“海棠湾”商标。李隆丰不服，分别提起行政诉讼。

北京市第一中级人民法院一审分别判决撤销第13255号裁定和第12545号裁定。商标评审委员会和海棠湾管委会不服，提出上诉。

北京市高级人民法院二审分别判决撤销一审判决，维持第13255号裁定和第12545号裁定。李隆丰不服，向最高人民法院申请再审。最高人民法院于2013年8月12日分别裁定驳回李隆丰的再审申请。

裁判结果：商标评审委员会分别作出商评字〔2011〕第13255号《关于第4706493号“海棠湾”商标争议裁定书》和〔2011〕第12545号《关于第4706970号“海棠湾”商标争议裁定书》，裁定撤销上述两个“海棠湾”商标。李隆丰不服，分别提起行政诉讼。北京市第一中级人民法院一审分别判决撤销第13255号裁定和第12545号裁定。商标评审委员会和海棠湾管委会不服，提出上诉。北京市高级人民法院二审分别判决撤销一审判决，维持第13255号裁定和第12545号裁定。李隆丰不服，向最高人民法院申请再审。最高人民法院于2013年8月12日分别裁定驳回李隆丰的再审申请。

裁判理由：最高人民法院认为：根据2001年《中华人民共和国商标法》第四十一条第一款的规定，已经注册的商标是以欺骗手段或者其他不正当手段取得注册的，其他单位或者个人可以请求商标评审委员会裁定撤销。审查判断诉争商标是否属于该条款规定的“以其他不正当手段取得注册”的情形，要考虑其是否属于欺骗手段以外的扰乱商标注册秩序、损害公共利益、不

正当占用公共资源或者以其他方式谋取不正当利益的手段。依据《中华人民共和国商标法》第四条的规定，自然人、法人或者其他组织对其生产、制造、加工、拣选或者经销的商品或者提供的服务，需要取得商标专用权的，应当向商标局申请商标注册。从该条规定的精神来看，民事主体申请注册商标，应该有使用的真实意图，以满足自己的商标使用需求为目的，其申请注册商标行为应具有合理性或正当性。根据商标评审委员会及原审法院查明的事实，在李隆丰申请注册争议商标之前，“海棠湾”标志经过海南省相关政府机构的宣传推广，已经成为公众知晓的三亚市旅游度假区的地名和政府规划的大型综合开发项目的名称，其含义和指向明确。李隆丰自己在接受媒体采访时也承认是在看到报纸报道香港著名企业家将参与开发海棠湾的消息后，认为该标志会非常知名，作为商标会具有较高的价值，因而才将其申请注册为商标。李隆丰作为个人，不仅在第36类的不动产出租、不动产管理、住所（公寓）等服务上和第43类的住所（旅馆、供膳寄宿处）、旅游房屋出租、饭店、餐馆等服务上注册了本案争议商标，还在其他商品或服务类别上申请注册了“海棠湾”商标。此外，李隆丰在多个类别的商品或服务上还注册了“香水湾”“椰林湾”等30余件商标，其中不少与公众知晓的海南岛的地名、景点名称有关。李隆丰利用政府部门宣传推广海棠湾休闲度假区及其开发项目所产生的巨大影响力，抢先申请注册多个“海棠湾”商标的行为，以及没有合理理由大量注册囤积其他商标的行为，并无真实使用意图，不具备注册商标应有的正当性，属于不正当占用公共资源、扰乱商标注册秩序的情形。

G. 电视节目名称在商标法意义上的使用与侵权判断

裁判要旨：

相关标识具有节目名称的属性并不能当然排斥该标识作为商标的可能性。判断被诉标识是否属于商标性使用，关键在于相关标识的使用是否能指示相关商品/服务的来源，起到使相关公众区分不同商品/服务的提供者的作用。

电视节目大多以现实生活为题材，这些现实生活题材只是电视节目的组成要素。在判断此类电视节目是否与某一服务类别相同或类似时，应当综合考察节目的整体和主要特征，把握其行为本质，作出全面、合理、正确的审查认定。

金阿欢与江苏省广播电视总台、深圳市珍爱网信息技术有限公司侵害商标权纠纷案

案号：

广东省高级人民法院（2016）粤民再447号

案由：

侵害商标权纠纷

合议庭成员：

徐春建 | 邱永清 | 肖海棠

关键词：

电视节目名称，商标，类别，混淆

相关法条：

《中华人民共和国商标法》第五十七条第（一）项、第（二）项

《最高人民法院关于审理商标民事纠纷案件适用法律若干问题的解释》第九条、第十条、第十一条、第十二条

基本案情：在再审申请人江苏省广播电视总台（以下简称江苏电视台）、深圳市珍爱网信息技术有限公司（以下简称珍

爱网公司)与被申请人金阿欢侵害商标权纠纷案中,金阿欢系第7199523号商标权利人,该商标于2009年2月16日申请注册,2010年9月7日获得核准注册,核定服务项目包括第45类的“交友服务、婚姻介绍所”。



江苏电视台旗下的江苏卫视于2010年开办了以婚恋交友为主题、名称为《非诚勿扰》的电视节目。江苏卫视在节目简介中称:“《非诚勿扰》是一档适应现代生活节奏的大型婚恋交友节目,我们将为您提供公开的婚恋交友平台,高质量的婚恋交友嘉宾,全新的婚恋交友模式。”报名方法包括“在珍爱网登记报名资料”。珍爱网曾在深圳南山区招募嘉宾,为该节目推选相亲对象。该案中,被诉“非诚勿扰”标识主要体现为两种形态:一是“非诚勿扰”纯文字标识;二是,即“非诚勿扰”文字与女性剪影组合的图文标识。



金阿欢以江苏电视台和珍爱网侵害其注册商标专用权为由,向广东省深圳市南山区法院提起诉讼,请求法院判令:

1. 江苏电视台所属的江苏卫视频道立即停止使用“非诚勿扰”栏目名称;
2. 珍爱网公司立即停止使用“非诚勿扰”名称进行广告推销、报名筛选、后续服务等共同侵权行为;
3. 两被告共同承担本案全部诉讼费用。

广东省深圳市南山区人民法院认为:金阿欢的文字商标“非诚勿扰”与江苏台电视节目的名称“非诚勿扰”相同,被诉“非诚勿扰”电视节目虽然与婚恋交友有关,但终究是电视节目,相关公众一般认为两

者不存在特定联系,不容易造成公众混淆,两者属于不同类别服务,不构成侵权。一审遂判决:驳回金阿欢的诉讼请求。

金阿欢不服,提起上诉。广东省深圳市中级人民法院认为,从《非诚勿扰》节目简介、开场白、结束语,参加报名条件、节目中男女嘉宾互动内容,以及广电总局的发文、媒体评论,可认定江苏电视台的《非诚勿扰》为相亲、交友节目。故江苏电视台的《非诚勿扰》节目与金阿欢涉案注册商标所核定的“交友、婚姻介绍”服务相同。本案金阿欢涉案注册商标已投入商业使用,被诉行为影响了该商标正常使用,相关公众容易对权利人的注册商标使用与江苏电视台产生错误认识及联系,构成商标侵权。珍爱网公司参与了节目嘉宾招募、宣传,还与江苏电视台签订有《合作协议书》,构成共同侵权。遂判决江苏电视台与珍爱网公司停止侵权行为。

江苏电视台与珍爱网公司不服二审判决,以被诉标识不属于商标性使用、类别与金阿欢注册商标核定使用类别不同、不构成混淆为由,向广东省高级人民法院申请再审。

裁判结果:广东省深圳市南山区人民法院于2014年9月29日作出一审判决:驳回金阿欢诉讼。金阿欢不服,提起上诉。广东省深圳市中级人民法院于2015年12月11日作出二审判决:

1. 撤销(2013)深南法知民初字第208号民事判决;
2. 江苏电视台所属的江苏卫视频道于判决生效后立即停止使用“非诚勿扰”栏目名称;
3. 珍爱网公司于判决生效后立即停止使用“非诚勿扰”名称进行广告推销、报名筛选、后续服务等行为。

江苏电视台与珍爱网公司不服二审判决,向广东省高级人民法院申请再审。广东省高级人民法院裁定提审本案,并于2016年12月30日判决撤销二审判决,维持一审判决。

裁判理由：广东省高级人民法院提审认为：

一、关于被诉标识是否属于商标性使用的问题

判断被诉“非诚勿扰”标识是否属于商标性使用，关键在于相关标识的使用是否为了指示相关商品/服务的来源，起到使相关公众区分不同商品/服务的提供者的作用。本案中，“非诚勿扰”原是江苏电视台为了区分其台下多个电视栏目而命名的节目名称，但从本案的情况来看，江苏电视台对被诉“非诚勿扰”标识的使用，并非仅仅为概括具体电视节目内容而进行的描述性使用，而是反复多次、大量地在其电视、官网、招商广告、现场宣传等商业活动中单独使用或突出使用，使用方式上具有持续性与连贯性，其中标识更在整体呈现方式上具有一定独特性，这显然超出对节目或者作品内容进行描述性使用所必需的范围和通常认知，具备了区分商品/服务的功能。江苏电视台在播出被诉节目同时标注“江苏卫视”台标的行为，客观上并未改变“非诚勿扰”标识指示来源的作用和功能，反而促使相关公众更加紧密地将“非诚勿扰”标识与江苏电视台下属频道“江苏卫视”相联系。随着该节目持续热播及广告宣传，被诉“非诚勿扰”标识已具有较强显著性，相关公众看到被诉标识，将联想到该电视节目及其提供者江苏电视台下属江苏卫视，客观上起到了指示商品/服务来源的作用。而且，江苏电视台在不少广告中，将被诉“非诚勿扰”标识与“江苏卫视”台标、“途牛”“韩束”等品牌标识并列进行宣传，在再审查程序中提交的证据表明江苏电视台曾就该标识的使用向华谊公司谋求商标授权，以上均直接反映江苏电视台主观上亦存在将被诉标识作为识别来源的商标使用、作为品牌而进行维护的意愿。因此，江苏电视台仅以“非诚勿扰”属于节目名称、同时标注台标明晰来源为由，否认相关行为属于商标性使用，不能成立。

二、关于江苏电视台是否侵害金阿欢涉案注册商标权的问题

在商标侵权裁判中，必须对被诉标识与注册商标是否相同或近似、两者服务是否相同或类似，以及是否容易引起相关公众的混淆误认作出判断。

(一) 关于被诉标识与涉案商标是否相同或近似的问题

本案中，将被诉“非诚勿扰”文字标识及图文标识分别与金阿欢涉案第7199523号注册商标相比对，文字形态上均存在繁体字与简体字的区别，在字体及文字排列上亦有差异。被诉图文组合标识与金阿欢注册商标相比，还多了颜色及图案差异。故该两被诉标识与金阿欢涉案第7199523号注册商标相比，均不属于相同标识。该两被诉标识与金阿欢涉案注册商标的显著部分与核心部分均为“非诚勿扰”，文字相同，整体结构相似，在自然组成要素上相近似。但客观要素的相近似并不等同于商标法意义上的近似。商标法所要保护的，并非仅以注册行为所固化的商标标识本身，而是商标所具有的识别和区分商品/服务来源的功能。如果被诉行为并非使用在相同或类似商品/服务上，或者并未损害涉案注册商标的识别和区分功能，亦未因此导致市场混淆后果的，不应认定构成商标侵权。

(二) 关于两者服务类别是否相同或类似的问题

对于电视节目是否与某一服务类别相同或类似进行司法判断时，不能简单、孤立地将某种表现形式或某一题材内容从整体节目中割裂开来，应当综合考察节目的整体和主要特征，把握其行为本质，作出全面、合理、正确的审查认定。以此考察被诉《非诚勿扰》电视节目，从相关服务的目的、内容、方式、对象等方面情况来看，正是典型的使用在电视文娱节目上。具体言之，被诉《非诚勿扰》

节目系一档以相亲、交友为题材的电视文娱节目，其借助相亲、交友场景中现代未婚男女的言行举止，结合现场点评嘉宾及主持人的评论及引导，通过剪辑编排成电视节目予以播放，使社会公众在娱乐、放松、休闲的同时，了解当今社会交友现象及相关价值观念，引导树立健康向上的婚恋观与人生观。其服务目的在于向社会公众提供旨在娱乐、消遣的文化娱乐节目，凭节目收视率与关注度获取广告赞助等经济收入；服务的内容和方式为通过电视广播这一特定渠道和大众传媒方式向社会提供和传播文娱节目；服务对象是不特定的广大电视观众等。而第45类中的“交友服务、婚姻介绍”系为满足特定个人的婚配需求而提供的中介服务，服务目的系通过提供促成婚恋配对的服务来获取经济收入；服务内容和方式通常包括管理相关需求人员信息、提供咨询建议、传递意向信息等中介服务；服务对象为特定的有婚恋需求的未婚男女。故两者无论是在服务目的、内容、方式和对象上均区别明显。以相关公众的一般认知，能够清晰区分电视文娱节目的内容与现实中的婚介服务活动，不会误以为两者具有某种特定联系，两者不构成相同服务或类似服务。

退一步而言，即使认定其为类似服务，也必须紧扣商标法宗旨，考虑涉案注册商标的显著性与知名度，在确定其保护范围与保护强度的基础上考虑相关公众混淆、误认的可能性，从而判断是否构成商标侵权。本案中，金阿欢涉案注册商标中的“非诚勿扰”文字本系商贸活动中的常见词汇，用于婚姻介绍服务领域显著性较低，其亦未经过金阿欢长期、大量的使用而获得后天的显著性。故本案对该注册商标的保护范围和保护强度，应与金阿欢对该商标的显著性和知名度所作出的贡献相符。反观被诉《非诚勿扰》节目，其将“非诚勿扰”作为相亲、交友题材的节目名称具有一定合理性，经过长期热播，作为娱乐、消遣的综艺性文娱电视节目为公众所熟知。即使被诉节目涉及交友方面的内容，相关公众也能够对该服务来源作出清晰区分，不会产生两者误认和混淆，不构成商标侵权。

H. 商品名称作为未注册驰名商标保护的司法标准

裁判要旨：

显著性是商标的基本特征，是一个标志可以作为商标的基本属性。只有具有显著特征的标识才能发挥区别商品来源的作用，进而可以作为商标注册或保护。商品名称只有在具备显著性的情况下，才能够发挥识别商品来源的作用，同时，在达到驰名商标的程度时，可以获得未注册驰名商标的保护。“新华字典”具有特定的历史起源、发展过程和长期唯一的提供主体以及客观的市场格局，保持着产品和品牌混合属性的商品名称，已经在相关消费者中形成了稳定的认知联系，具有指示商品来源的意义和作用，具备商标的显著特征。从商务印书馆对“新华字典”进行宣传所持续的时间、程度和地理范围来看，“新华字典”已经获得较大的影响力和较高的知名度。综合以上因素，可以认定“新华字典”构成未注册驰名商标。

“新华字典”侵害商标权及不正当竞争纠纷案

案号：

北京知识产权法院（2016）京73民初277号

案由：

侵害商标权及不正当竞争纠纷

合议庭成员：

张玲玲 | 冯刚 | 杨洁

关键词：

商标，未注册驰名商标，不正当竞争，知识传播

相关法条：

《中华人民共和国侵权责任法》第十五条
《中华人民共和国商标法》第十三条、第十四条
《中华人民共和国反不正当竞争法》第五条第（二）项、第二十条第一款

基本案情：原告商务印书馆有限公司（以下简称商务印书馆）与被告华语教学出版社有限责任公司（以下简称华语出版社）同为出版机构。原告商务印书馆自1957年至今，连续出版《新华字典》通行版本至第11版，2010～2015年，原告商务印书馆出版的《新华字典》在字典类图书市场的平均占有率超过50%，截至2016年，原告商务印书馆出版的《新华字典》全球发行量超过5.67亿册，获得“最受欢迎的字典”吉尼斯世界纪录及“最畅销的书（定期修订）”吉尼斯世界纪录等多项荣誉。

原告商务印书馆诉称被告华语出版社生产、销售“新华字典”辞书的行为侵害了原告商务印书馆“新华字典”未注册驰名商标，且被告华语出版社使用原告商务印书馆《新华字典》（第11版）知名商品的特有包装装潢的行为已构成不正当竞争。请求法院判令被告：

1. 立即停止侵害商标权及不正当竞争行为；
2. 在《中国新闻出版广电报》等相关媒体上刊登声明，消除影响；
3. 赔偿原告经济损失300万元及合理支出40万元。

被告华语出版社辩称，“新华字典”由国家项目名称发展为公共领域的辞书通用名称，原告无权就“新华字典”主张商标权益，无权禁止他人正当使用。涉案《新华字典》（第11版）的装潢不属于《中华人民共和国反不正当竞争法》第五条第（二）项规定的“特有装潢”，不会使购买者产生混淆或误认。原告提起诉讼旨在通过司法判决的方式独占“新华字典”这一辞书通用名称，具有排除竞争、实现垄断辞书类市场的不正当目的。

北京知识产权法院认为，“新华字典”具备商标的显著特征，且经过原告商务印书馆的使用已经达到驰名商标的程度，构成未注册驰名商标，被告华语出版社复制、摹仿原告商务印书馆的未注册驰名商标“新华字典”的行为，容易导致混淆，构成商标侵权。原告商务印书馆出版的《新

华字典》（第11版）构成知名商品的特有包装装潢，被告华语出版社擅自使用《新华字典》（第11版）知名商品的特有装潢的行为构成不正当竞争。一审法院判决：

1. 被告华语出版社立即停止涉案侵害商标权及不正当竞争行为；
2. 在《中国新闻出版广电报》等相关媒体上刊登声明，消除影响；
3. 赔偿原告商务印书馆经济损失300万元及合理支出27万余元。

本案一审宣判后，双方当事人达成执行和解，一审生效。

裁判结果：北京知识产权法院于2017年12月28日作出（2016）京73民初277号判决：判令被告华语出版社立即停止使用原告商务印书馆的“新华字典”未注册驰名商标的行为及立即停止使用与原告商务印书馆《新华字典》（第11版）知名商品的特有装潢相同或近似装潢的不正当竞争行为；在相关媒体上发布声明并承担赔偿经济损失3,000,000元及合理费用277,989.2元的赔偿责任。

裁判理由：北京知识产权法院判决认为：本案的焦点问题为：

1. 涉案“新华字典”是否构成未注册驰名商标，如果“新华字典”构成未注册驰名商标，华语出版社实施的被诉行为是否构成侵权；
2. 商务印书馆出版的《新华字典》（第11版）是否构成知名商品的特有包装装潢，如果构成知名商品的特有包装装潢，华语出版社的被诉行为是否构成不正当竞争；
3. 如果前述侵权行为成立，华语出版社应当如何承担法律责任。

一、涉案“新华字典”是否构成未注册驰名商标？如果“新华字典”构成未注册驰名商标，华语出版社实施的被诉行为是否构成侵权？

1. 法院认为，涉案“新华字典”构成未注册驰名商标。

首先,“新华字典”具备商标的显著特征。显著识别性是商标的基本特征,是一个标志可以作为商标的基本属性。只有具有显著特征的标识才能发挥区别商品来源的作用,进而可以作为商标注册或保护。本案中,“新华字典”具有特定的历史起源、发展过程和长期唯一的提供主体以及客观的市场格局,保持着产品和品牌混合属性的商品名称,已经在相关消费者中形成了稳定的认知联系,具有指示商品来源的意义和作用,具备商标的显著特征。本案遵循在先案例(2011)民提字第55号民事判决及(2013)民申字第371号民事裁定中确立的裁判标准,认定“新华字典”具有商标的显著特征,能够发挥商品来源的识别作用。

其次,“新华字典”构成未注册驰名商标。从相关公众对涉案“新华字典”的知晓程度来看,“新华字典”已经在全国范围内被相关公众广为知晓。从商务印书馆使用“新华字典”持续的时间和销售数量来看,“新华字典”近60年间已经在全国范围内销售数亿册,销售量巨大,销售范围非常广泛。从商务印书馆对“新华字典”进行宣传所持续的时间、程度和地理范围来看,“新华字典”已经获得较大的影响力和较高的知名度。综合以上因素,可以认定“新华字典”构成未注册驰名商标。

最后,商务印书馆可以就“新华字典”主张未注册驰名商标。至被诉行为发生时,“新华字典”标识尚未获准商标注册,但“新华字典”经过商务印书馆的使用已经达到驰名商标的程度,应该得到《中华人民共和国商标法》的保护。将“新华字典”作为商务印书馆的未注册驰名商标给予保护,不仅是对于之前商务印书馆在经营“新华字典”辞书商品中所产生的识别来源作用和凝结的商誉给予保护,更是通过商标保护的方式使其承担商品质量保障的法定义务和社会责任。这不仅不会损害知识的传播,相反,为了维护“新华字典”良好的品牌商誉,商务印书馆对其出版、发行的标有“新华字典”标识的辞书更会注重提升品质,促进正确知识的广泛传播。

2. 法院认为,华语出版社复制、摹仿商务印书馆的未注册驰名商标“新华字典”的行为,容易导致混淆,构成商标侵权。

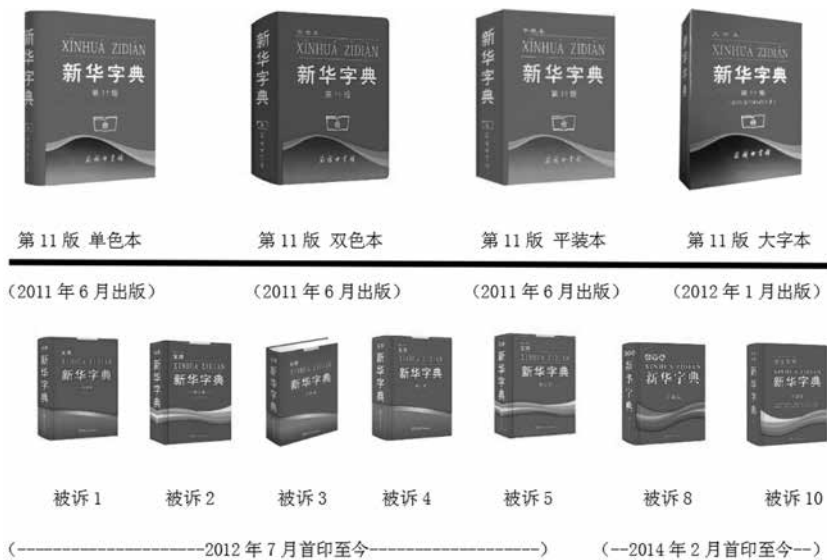
商务印书馆和华语出版社使用“新华字典”的商品均为第16类辞书,属于相同商品,且华语出版社在其出版的字典上使用了与商务印书馆未注册驰名商标“新华字典”完全相同的商标,该行为属于以复制的方式使用商务印书馆的未注册驰名商标。根据在案证据显示,华语出版社在其出版的第16类字典商品上使用“新华字典”标识,已经使消费者在购买和使用字典的过程中将其出版的《新华字典》误认成商务印书馆出版的《新华字典》。华语出版社的上述行为已经导致相关公众发生混淆和误认。因此,华语出版社在第16类辞书上使用“新华字典”标识的行为已经构成在相同商品上复制他人未在中国注册的驰名商标,容易导致混淆,违反了《中华人民共和国商标法》第十三条第二款的规定。

二、商务印书馆出版的《新华字典》(第11版)是否构成知名商品的特有包装装潢?如果构成知名商品的特有包装装潢,华语出版社的被诉行为是否构成不正当竞争?

1. 法院认为,商务印书馆出版的《新华字典》(第11版)构成知名商品的特有包装装潢。

首先,商务印书馆出版的《新华字典》(第11版)属于知名商品。《新华字典》第11版自2011年6月出版发行,至被诉行为发生时已经在全国范围大量出版发行,并取得较高的知名度。结合商务印书馆在全国范围内宣传和经营《新华字典》的情况,以及《新华字典》辞书获得的系列荣誉和重要奖项,可以认定商务印书馆的《新华字典》(第11版)属于知名商品。

其次,《新华字典》(第11版)的装潢属于特有装潢。《新华字典》(第11版)使用的装潢是对与其功能性无关的构成要素进行了独特的排列组合,形成了能够与其他经营者的同类商品相区别的整体形象。经过商务印书馆长期的宣传和使用,使得相关公众能够将上述装潢的整体形象与《新华



字典》(第11版)的商品来源联系起来,该装潢所体现的文字、图案、色彩及其排列组合具有识别和区分商品来源的作用,具备特有性。因此,《新华字典》(第11版)的装潢属于《中华人民共和国反不正当竞争法》第五条第(二)项所保护的知名商品的特有装潢。

2. 法院认为, 华语出版社擅自使用《新华字典》(第11版)知名商品的特有装潢的行为构成不正当竞争。

商务印书馆提交了原、被告的产品对比图如下:

从以上产品对比图可见, 被诉侵权产品在《新华字典》(第11版)之后出版, 且在字典封面的整体设计、封面中上部的文字设计、封面中部的版式设计、封面下部的图形设计、字典书脊的颜色及文字设计方面构成近似。由此, 华语出版社的被诉侵权产品的装潢与商务印书馆《新华字典》(第11版)的装潢在文字结构、图案设计、色彩搭配、排列位置等整体视觉效果上相近似, 普通消费者施以一般注意力, 容易对原、被告商品的来源发生混淆和误认。且根据在案证据, 被诉侵权产品已经在市场上引起了相关消费者的混淆和误认。因此, 华语出版社因擅自使用《新华字典》

(第11版)知名商品的特有装潢而构成《中华人民共和国反不正当竞争法》第五条第(二)项规定的不正当竞争行为。

三、华语出版社应当如何承担法律责任?

法院判决华语出版社立即停止侵权并刊登声明、消除影响, 对商务印书馆300万元赔偿数额的诉讼请求予以全额支持, 另判决赔偿合理支出277,989.2元。

首先, 鉴于华语出版社实施了上述被诉侵权行为, 其应当立即停止使用商务印书馆的“新华字典”未注册驰名商标, 并禁止在第16类辞书商品上使用与“新华字典”相同或近似的商标。同时, 其还应当立即停止使用与商务印书馆《新华字典》(第11版)知名商品的特有装潢相同或近似的装潢的行为, 并刊登声明, 消除其侵权行为给商务印书馆带来的负面影响。

其次, 本院参考北京市新闻出版广电局备案的部分被控侵权字典印刷委托书的信息统计数量、2014年内地上市的出版企业年度平均净资产收益情况、华语出版社在全国的销售情况, 综合考虑华语出版社被诉侵权行为的性质及主观故意, 参照《中华人民共和国商标法》第六十三条第一款规定, 按照上述方法确定数额的1.5

倍确定本案的赔偿数额。具体计算如下：2012年9月30日至2016年9月30日期间，华语出版社因出版印刷被控侵权字典而获利为 $20,310,160 \times 11.29\% = 2,293,017.64$ 元。该数额的1.5倍已经超出了商务印书馆300万元赔偿数额的诉讼请求，故，本院对商务印书馆300万元赔偿数额的诉讼请求予以全额支持。

最后，商务印书馆主张合理支出40万元，并提交了部分维权合理支出的证据。考虑到商务印书馆提交的合理支出凭证与本案的关联性、必要性，本院对于具有凭证的合理支出277,989.2元予以支持，超出部分不予支持。

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第二章

专利案件

A. 药品制备方法专利侵权纠纷中被诉侵权药品制备工艺的查明

裁判要旨：

药品制备方法专利侵权纠纷中，在无其他相反证据的情形下，应当推定被诉侵权药品在药监部门的备案工艺为其实际的制备工艺；有证据证明被诉侵权药品备案工艺不真实的，应当充分审查被诉侵权药品的技术来源、生产规程、批生产记录、备案文件等证据，依法确定被诉侵权药品的实际制备工艺。

对于被诉侵权药品制备工艺等复杂的技术事实，可以综合运用技术调查官、专家辅助人、司法鉴定以及科技专家咨询等多种途径进行查明。

礼来公司与常州华生制药有限公司侵害发明专利权纠纷案

案号：

最高人民法院（2015）民三终字第1号

案由：

侵害发明专利权纠纷

合议庭成员：

周翔 | 吴蓉 | 宋淑华

关键词：

侵害发明专利权，药品制备方法发明专利，保护范围，技术调查官，被诉侵权药品制备工艺查明

相关法条：

《中华人民共和国专利法》（2000年修正）第五十六条第一款、第五十七条第二款、第六十二条第一款

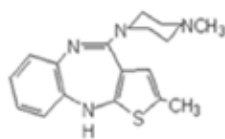
《中华人民共和国民事诉讼法》第七十八条、第七十九条

基本案情：2013年7月25日，礼来公司（又称伊莱利利公司）向江苏省高级人民法院（以下简称江苏高院）诉称，礼来公司拥有涉案91103346.7号方法发明专利权，涉案专利方法制备的药物奥氮平为新产品。常州华生制药有限公司（以下简称华生公司）使用落入涉案专利权保护范围的制备方法生产药物奥氮平并面向市场销售，侵害了礼来公司的涉案方法发明专利权。为此，礼来公司提起本案诉讼，请求法院判令：

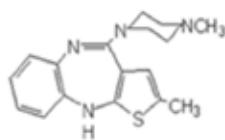
1. 华生公司赔偿礼来公司经济损失人民币151,060,000元、礼来公司为制止侵权所支付的调查取证费和其他合理开支人民币28,800元；
2. 华生公司在其网站及《医药经济报》刊登声明，消除因其侵权行为给礼来公司造成的不良影响；
3. 华生公司承担礼来公司因本案发生的律师费人民币1,500,000元；
4. 华生公司承担本案的全部诉讼费用。

江苏高院一审查明：涉案专利为英国利利工业公司1991年4月24日申请的名称为“制备一种噻吩并苯二氮杂化合物的方法”的第91103346.7号中国发明专利申请，授权公告日为1995年2月19日。2011年4月24日涉案专利权期满终止。1998年3月17日，涉案专利的专利权人变更为英国伊莱利利有限公司；2002年2月28日专利权人变更为礼来公司。

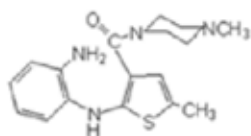
涉案专利授权公告的权利要求为：1. 一种制备2-甲基-10-(4-甲基-1-哌嗪基)-4H-噻吩并[2,3-b][1,5]苯并二氮杂，或其酸加成盐的方法。所述方法包括：



- (a) 使 N-甲基哌嗪与下式化合物反应，式中 Q 是一个可以脱落的基团，或



- (b) 使下式的化合物进行闭环反应



2001年7月，中国医学科学院药物研究所（简称医科院药物所）和华生公司向国家食品药品监督管理局（简称国家药监局）申请奥氮平及其片剂的新药证书。2003年5月9日，医科院药物所和华生公司获得国家药监局颁发的奥氮平原料药和奥氮平片《新药证书》，华生公司获得奥氮平和奥氮平片《药品注册批件》。新药申请资料中《原料药生产工艺的研究资料及文献资料》记载了制备工艺：

即加入 4-氨基-2-甲基-10-苄基-噻吩并苯并二氮杂，盐酸盐，甲基哌嗪及二甲基甲酰胺搅拌，得粗品，收率 94.5%；加入 2-甲基-10-苄基-(4-甲基-1-哌嗪基)-4H-噻吩并苯并二氮杂、冰醋酸、盐酸搅拌，然后用氢氧化钠中和后得粗品，收率 73.2%；再经过两次精制，总收率为 39.1%。

从反应式分析，该过程就是以式四化合物与甲基哌嗪反应生成式五化合物，再对式五化合物脱苄基，得式一化合物。2003年8月，华生公司向青岛市第七人民医

院推销其生产的“华生-奥氮平”5mg-新型抗精神病药，其产品宣传资料记载，奥氮平片主要成份为奥氮平，其化学名称为 2-甲基-10-(4-甲基-1-哌嗪)-4H-噻吩并苯并二氮杂。

在另案审理中，根据江苏高院的委托，2011年8月25日，上海市科技咨询服务中心出具（2010）鉴字第19号《技术鉴定报告书》。该鉴定报告称，按华生公司备案的“原料药生产工艺的研究资料及文献资料”中记载的工艺进行实验操作，不能获得原料药奥氮平。鉴定结论为：华生公司备案资料中记载的生产原料药奥氮平的关键反应步骤缺乏真实性，该备案的生产工艺不可行。

经质证，礼来公司认可该鉴定报告，华生公司对该鉴定报告亦不持异议，但是其坚持认为采取两步法是可以生产出奥氮平的，只是因为有些内容涉及商业秘密没有写入备案资料中，故专家依据备案资料生产不出来。

华生公司认为其未侵害涉案专利权，理由是：2003年至今，华生公司一直使用2008年补充报批的奥氮平备案生产工艺，该备案文件已于2010年9月8日获国家药监局批准，具备可行性。在礼来公司未提供任何证据证明华生公司生产工艺的情况下，应以华生公司2008年奥氮平备案工艺作为认定侵权与否的比对工艺。

华生公司提交的2010年9月8日国家药监局《药品补充申请批件》中“申请内容”栏为：“（1）改变影响药品质量的生产工艺；（2）修改药品注册标准。”“审批结论”栏为：“经审查，同意本品变更生产工艺并修订质量标准。变更后的生产工艺在不改变原合成路线的基础上，仅对其制备工艺中所用溶剂和试剂进行调整。质量标准所附执行，有效期24个月。”

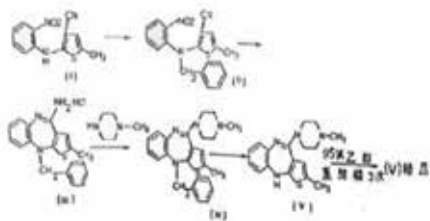
上述2010年《药品补充申请批件》所附《奥氮平药品补充申请注册资料》中5.1原料药生产工艺的研究资料及文献资料章节中5.1.1说明内容为：

“根据我公司奥氮平原料药的实际情况，在不改变原来申报生产工艺路线的基础上，对奥氮平的制备工艺过程做了部分调整变更，对工艺进行优化，使奥氮平各中间体的质量得到进一步的提高和保证，其制备过程中的相关杂质得到有效控制……由于工艺路线没有变更，并且最后一步的结晶溶剂亦没有变更，故化合物的结构及晶型不会改变。”

最高人民法院二审审理过程中，为准确查明本案所涉技术事实，根据《中华人民共和国民事诉讼法》第七十九条、《最高人民法院关于适用〈中华人民共和国民事诉讼法〉的解释》（以下简称《民事诉讼法解释》）第一百二十二条之规定，对礼来公司的专家辅助人出庭申请予以准许；根据《民事诉讼法解释》第一百一十七条之规定，对华生公司的证人出庭申请予以准许；根据《中华人民共和国民事诉讼法》第七十八条、《民事诉讼法解释》第二百二十七条之规定，通知出具（2014）司鉴定第02号《技术鉴定报告》的江苏省科技咨询中心工作人员出庭；根据《最高人民法院关于知识产权法院技术调查官参与诉讼活动若干问题的暂行规定》第二条、第十条之规定，首次指派技术调查官出庭，就相关技术问题与各方当事人分别询问了专家辅助人、证人及鉴定人。

最高人民法院二审另查明：1999年10月28日，华生公司与医科院药物所签订《技术合同书》，约定医科院药物所将其研制开发的抗精神分裂药奥氮平及其制剂转让给华生公司，医科院药物所负责完成临床前报批资料并在北京申报临床；验收标准和方法按照新药审批标准，采用领取临床批件和新药证书方式验收；在其他条款中双方对新药证书和生产的报批作出了约定。

医科院药物所1999年10月填报的（京99）药申临字第82号《新药临床研究申请表》中，“制备工艺”栏绘制的反应路线如下：



1999年11月9日，北京市卫生局针对医科院药物所的新药临床研究申请作出《新药研制现场考核报告表》，“现场考核结论”栏记载：“该所具备研制此原料的条件，原始记录、实验资料基本完整，内容真实。”

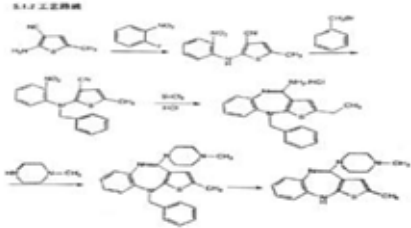
2001年6月，医科院药物所和华生公司共同向国家药监局提交《新药证书、生产申请表》[(2001)京申产字第019号]。针对该申请，江苏省药监局2001年10月22日作出《新药研制现场考核报告表》，“现场考核结论”栏记载：“经现场考核，样品制备及检验原始记录基本完整，检验仪器条件基本具备，研制单位暂无原料药生产车间，现申请本品的的新药证书。”

根据华生公司申请，江苏药监局2009年5月21日发函委托江苏省常州市食品药品监督管理局药品安全监管处对华生公司奥氮平生产现场进行检查和产品抽样，江苏药监局针对该检查和抽样出具了《药品注册生产现场检查报告》（受理号CXHB0800159），其中“检查结果”栏记载：

“按照药品注册现场检查的有关要求，2009年7月7日对该品种的生产现场进行了第一次检查，该公司的机构和人员、生产和检验设施能满足该品种的生产要求，原辅材料等可溯源，主要原料均按规定量投料，生产过程按申报的工艺进行。2009年8月25日，按药品注册现场核查的有关要求，检查了70309001、70309002、70309003三批产品的批生产记录、检验记录、原料领用使用、库存情况记录等，已按抽样要求进行了抽样。”

“综合评定结论”栏记载：“根据综合评定，现场检查结论为：通过”。

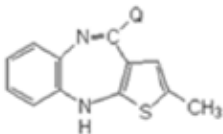
国家药监局 2010 年 9 月 8 日颁发给华生公司的《药品补充申请批件》所附《奥氮平药品补充申请注册资料》中，5.1“原料药生产工艺的研究资料及文献资料”之 5.1.2“工艺路线”中绘制的反应路线如下：



2015 年 3 月 5 日，江苏省科技咨询中心受上海市方达（北京）律师事务所委托出具（2014）司鉴字第 02 号《技术鉴定报告》，其“鉴定结论”部分记载：

1. 华生公司 2008 年向国家药监局备案的奥氮平制备工艺是可行的。
2. 对比华生公司 2008 年向国家药监局备案的奥氮平制备工艺与礼来公司第 91103346.7 号方法专利，两者起始原料均为仲胺化物，但制备工艺路径不同，具体表现在：(1) 反应中产生的关键中间体不同；(2) 反应步骤不同：华生公司的是四步法，礼来公司是二步法；(3) 反应条件不同：取代反应中，华生公司采用二甲基甲酰胺为溶媒，礼来公司采用二甲基亚砷和甲苯的混合溶剂为溶媒。

二审庭审中，礼来公司明确其在本案中要求保护涉案专利权利要求 1 中的方法 (a)。



裁判结果：江苏省高级人民法院于 2014 年 10 月 14 日作出（2013）苏民初字第 0002 号民事判决：

1. 常州华生制药有限公司赔偿礼来公司经济损失及为制止侵权支出的合理费用人民币计 350 万元；

2. 驳回礼来公司的其他诉讼请求。

案件受理费人民币 809,744 元，由礼来公司负担 161,950 元，常州华生制药有限公司负担 647,794 元。

礼来公司、常州华生制药有限公司均不服，提起上诉。

最高人民法院 2016 年 5 月 31 日作出（2015）民三终字第 1 号民事判决：

1. 撤销江苏省高级人民法院（2013）苏民初字第 0002 号民事判决；
2. 驳回礼来公司的诉讼请求。一、二审案件受理费各人民币 809,744 元，由礼来公司负担 323,897 元，常州华生制药有限公司负担 1,295,591 元。

裁判理由：最高人民法院二审认为：《最高人民法院关于审理侵犯专利权纠纷案件应用法律若干问题的解释》第七条规定：

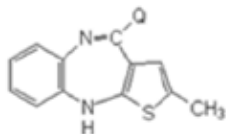
“人民法院判定被诉侵权技术方案是否落入专利权的保护范围，应当审查权利人主张的权利要求所记载的全部技术特征。被诉侵权技术方案包含与权利要求记载的全部技术特征相同或者等同的技术特征的，人民法院应当认定其落入专利权的保护范围；被诉侵权技术方案的技术特征与权利要求记载的全部技术特征相比，缺少权利要求记载的一个以上的技术特征，或者有一个以上技术特征不相同也不等同的，人民法院应当认定其没有落入专利权的保护范围。”

本案中，华生公司被诉生产销售的药品与涉案专利方法制备的产品相同，均为奥氮平，判定华生公司奥氮平制备工艺是否落入涉案专利权保护范围，涉及以下三个问题：

一、关于涉案专利权的保护范围

《中华人民共和国专利法》第五十六条第一款规定：“发明或者实用新型专利权的保护范围以其权利要求的内容为准，说明书及附图可以用于解释权利要求。”本

案中，礼来公司要求保护涉案专利权利要求1中的方法(a)，该权利要求采取开放式的撰写方式，其中仅限定了参加取代反应的三环还原物及N-甲基哌嗪以及发生取代的基团，其保护范围涵盖了所有采用所述三环还原物与N-甲基哌嗪在Q基团处发生取代反应而生成奥氮平的制备方法，无论采用何种反应起始物、溶剂、反应条件，均在其保护范围之内。基于此，判定华生公司奥氮平制备工艺是否落入涉案专利权保护范围，关键在于两个技术方案反应路线的比对，而具体的反应起始物、溶剂、反应条件等均不纳入侵权比对范围，否则会不当限缩涉案专利权的保护范围，损害礼来公司的合法权益。



二、关于华生公司实际使用的奥氮平制备工艺

《中华人民共和国专利法》第五十七条第二款规定：“专利侵权纠纷涉及新产品制造方法的发明专利的，制造同样产品的单位或者个人应当提供其产品制造方法不同于专利方法的证明。”本案中，双方当事人对奥氮平为专利法中所称的新产品不持异议，华生公司应就其奥氮平制备工艺不同于涉案专利方法承担举证责任。具体而言，华生公司应当提供证据证明其实际使用的奥氮平制备工艺反应路线未落入涉案专利权保护范围，否则，将因其举证不能而承担推定礼来公司侵权指控成立的法律后果。

本案中，华生公司主张其自2003年至今一直使用2008年向国家药监局补充备案工艺生产奥氮平，并提交了其2003年和2008年奥氮平批生产记录（一审补充证据6）、2003年、2007年和2013年生产规程（一审补充证据7）、《药品补充申请批件》（一审补充证据12）等证据证明其实际使用的奥氮平制备工艺。如前所述，本案的侵权判定关键在于两个技术方案反应路线的比对，华生公司2008年补充备案工艺的反应路线可见于其向国家药监局提交的《奥

氮平药品补充申请注册资料》，其中5.1“原料药生产工艺的研究资料及文献资料”之5.1.2“工艺路线”图显示该反应路线为：先将“仲胺化物”中的仲氨基用苄基保护起来，制得“苄基化物”（苄基化），再进行闭环反应，生成“苄基取代的噻吩并苯并二氮杂”三环化合物（还原化物）。“还原化物”中的氨基被N-甲基哌嗪取代，生成“缩合物”，然后脱去苄基，制得奥氮平。本院认为，现有在案证据能够形成完整证据链，证明华生公司2003年至涉案专利权到期日期间一直使用其2008年补充备案工艺的反应路线生产奥氮平，主要理由如下：

首先，华生公司2008年向国家药监局提出奥氮平药品补充申请注册，在其提交的《奥氮平药品补充申请注册资料》中，明确记载了其奥氮平制备工艺的反应路线。针对该补充申请，江苏省药监部门于2009年7月7日和8月25日对华生公司进行了生产现场检查和产品抽样，并出具了《药品注册生产现场检查报告》（受理号CXHB0800159），该报告显示华生公司的“生产过程按申报的工艺进行”，三批样品“已按抽样要求进行了抽样”，现场检查结论为“通过”。也就是说，华生公司2008年补充备案工艺经过药监部门的现场检查，具备可行性。基于此，2010年9月8日，国家药监局向华生公司颁发了《药品补充申请批件》，同意华生公司奥氮平“变更生产工艺并修订质量标准”。对于华生公司2008年补充备案工艺的可行性，礼来公司专家辅助人在二审庭审中予以认可，江苏省科技咨询中心出具的（2014）司鉴字第02号《技术鉴定报告》在其鉴定结论部分也认为“华生公司2008年向国家药监局备案的奥氮平制备工艺是可行的”。因此，在无其他相反证据的情形下，应当推定华生公司2008年补充备案工艺即为其取得《药品补充申请批件》后实际使用的奥氮平制备工艺。

其次，一般而言，适用于大规模工业化生产的药品制备工艺步骤繁琐，操作复杂，其形成不可能是一蹴而就的。从研发阶段到实际生产阶段，其长期的技术积累过程通常是在保持基本反应路线稳定的情况下，针对实际生产中发现的缺陷不断优化调整

反应条件和操作细节。华生公司的奥氮平制备工艺受让于医科院药物所，双方于1999年10月28日签订了《技术转让合同》。按照合同约定，医科院药物所负责完成临床前报批资料并在北京申报临床。在医科院药物所1999年10月填报的(京99)药申临字第82号《新药临床研究申请表》中，“制备工艺”栏绘制的反应路线显示，其采用了与华生公司2008年补充备案工艺相同的反应路线。针对该新药临床研究申请，北京市卫生局1999年11月9日作出《新药研制现场考核报告表》，确认“原始记录、实验资料基本完整，内容真实。”在此基础上，医科院药物所和华生公司按照《技术转让合同》的约定，共同向国家药监局提交新药证书、生产申请表[(2001)京申产字第019号]。针对该申请，江苏省药监局2001年10月22日作出《新药研制现场考核报告表》，确认“样品制备及检验原始记录基本完整”。通过包括前述考核在内的一系列审查后，2003年5月9日，医科院药物所和华生公司获得国家药监局颁发的奥氮平原料药和奥氮平片《新药证书》。由此可见，华生公司自1999年即拥有了与其2008年补充备案工艺反应路线相同的奥氮平制备工艺，并以此申报新药注册，取得新药证书。因此，华生公司在2008年补充备案工艺之前使用反应路线完全不同的其他制备工艺生产奥氮平的可能性不大。

最后，国家药监局2010年9月8日向华生公司颁发的《药品补充申请批件》“审批结论”栏记载：“变更后的生产工艺在不改变原合成路线的基础上，仅对其制备工艺中所用溶剂和试剂进行调整”，即国家药监局确认华生公司2008年补充备案工艺与其之前的制备工艺反应路线相同。华生公司在一审中提交了其2003年、2007年和2013年的生产规程，2003年、2008年的奥氮平批生产记录，华生公司主张上述证据涉及其商业秘密，一审法院组织双方当事人进行了不公开质证，确认其真实性和关联性。本院经审查，华生公司2003年、2008年的奥氮平批生产记录是分别依据2003年、2007年的生产规程进行实际生产所做的记录，上述生产

规程和批生产记录均表明华生公司奥氮平制备工艺的基本反应路线与其2008年补充备案工艺的反应路线相同，只是在保持该基本反应路线不变的基础上对反应条件、溶剂等生产细节进行调整，不断优化，这样的技术积累过程是符合实际生产规律的。

综上，本院认为，华生公司2008年补充备案工艺真实可行，2003年至涉案专利权到期日期间华生公司一直使用2008年补充备案工艺的反应路线生产奥氮平。

三、关于礼来公司的侵权指控是否成立

对比华生公司奥氮平制备工艺的反应路线和涉案方法专利，二者的区别在于反应步骤不同，关键中间体不同。具体而言，华生公司奥氮平制备工艺使用的三环还原物的胺基是被苄基保护的，由此在取代反应之前必然存在苄基化反应步骤以生成苄基化的三环还原物，相应的在取代反应后也必然存在脱苄基反应步骤以获得奥氮平。而涉案专利的反应路线中并未对三环还原物中的胺基进行苄基保护，从而不存在相应的苄基化反应步骤和脱除苄基的反应步骤。

《最高人民法院关于审理专利纠纷案件适用法律问题的若干规定》第十七条第二款规定：

“等同特征，是指与所记载的技术特征以基本相同的手段，实现基本相同的功能，达到基本相同的效果，并且本领域普通技术人员在被诉侵权行为发生时无需经过创造性劳动就能够联想到的特征。”

本案中，就华生公司奥氮平制备工艺的反应路线和涉案方法专利的区别而言，首先，苄基保护的三环还原物中间体与未加苄基保护的三环还原物中间体为不同的化合物，两者在化学反应特性上存在差异，即在未加苄基保护的三环还原物中间体上，可脱落的Q基团和胺基均可与N-甲基哌嗪发生反应，而苄基保护的三环还原物中间体由于其中的胺基被苄

基保护，无法与 N-甲基哌嗪发生不期望的取代反应，取代反应只能发生在 Q 基团处；相应地，涉案专利的方法中不存在取代反应前后的加苄基和脱苄基反应步骤。因此，两个技术方案在反应中间物和反应步骤上的差异较大。其次，由于增加了加苄基和脱苄基步骤，华生公司的奥氮平制备工艺在终产物收率方面会有所减损，而涉案专利由于不存在加苄基保护步骤和脱苄基步骤，收率不会因此而下降。故两个技术方案的技术效果如收率高低等方面存在较大差异。最后，尽管对所述三环还原物中的胺基进行苄基保护以减少副反应是化学合成领域的公知常识，但是这种改变是实质性的，加苄基保护的三环还原物中间体的反应特性发生了改变，增加反应步骤也使收率下降。而且加苄基保护为公知常识仅说明华生公司的奥氮平制备工艺相对于涉案专利方法改进有限，但并不意味着两者所采用的技术手段是基本相同的。

综上，华生公司的奥氮平制备工艺在三环还原物中间体是否为苄基化中间体以及由此增加的苄基化反应步骤和脱苄基步骤方面，与涉案专利方法是不同的，相应的技术特征也不属于基本相同的技术手段，达到的技术效果存在较大差异，未构成等同特征。因此，华生公司奥氮平制备工艺未落入涉案专利权保护范围。

综上所述，华生公司奥氮平制备工艺未落入礼来公司所有的涉案专利权的保护范围，一审判决认定事实和适用法律存在错误，依法予以纠正。

B. 设计特征的认定及外观设计近似性判断的影响

裁判要旨：

设计特征体现了授权外观设计不同于现有设计的创新内容，也体现了设计人对现有设计的创造性贡献。如果被诉侵权产品未包含授权外观设计区别于现有设计的全部设计特征，一般可以推定二者不构成近似外观设计。

设计特征的存在应由专利权人进行举证，允许第三人提供反证予以推翻，并由人民法院依法予以确定。

浙江健龙卫浴有限公司与高仪股份公司侵害外观设计专利权纠纷案

案号：

最高人民法院（2015）民提字第 23 号

案由：

侵害外观设计专利权纠纷

合议庭成员：

周翔 | 吴蓉 | 宋淑华

关键词：

外观设计专利，近似判断，设计特征

相关法条：

《中华人民共和国专利法》第五十九条第二款

基本案情：高仪股份公司（以下简称高仪公司）为“手持淋浴喷头（No. A4284410X2）”外观设计专利的权利人，该外观设计专利现合法有效。2012 年 11 月，高仪公司以浙江健龙卫浴有限公司（以下简称健龙公司）生产、销售和许诺销售的丽雅系列等卫浴产品侵害其“手持淋浴喷头”外观设计专利权为由提起诉讼，请求法院判令健龙公司立即停止被诉侵权行为，销毁库存的侵权产品及专用于生产侵权产品的模具，并赔偿高仪公司经济损失 20 万元。

经一审庭审比对，健龙公司被诉侵权产品与高仪公司涉案外观设计专利的相同之处为：二者属于同类产品，从整体上看，二者均是由喷头头部和手柄两个部分组成，被诉侵权产品头部出水面的形状与涉案专利相同，均表现为出水孔呈放射状分布在两端圆、中间长方形的区域内，边缘呈圆弧状。两者的不同之处为：

1. 被诉侵权产品的喷头头部四周为斜面，从背面向出水口倾斜，而涉案专利主视图及左视图中显示其喷头头部四周为圆弧面；
2. 被诉侵权产品头部的出水面与面板间仅由一根线条分隔，涉案专利头部的出水面与面板间由两条线条构成的带状分隔；
3. 被诉侵权产品头部出水面的出水孔分布方式与涉案专利略有不同；
4. 涉案专利的手柄上有长椭圆形的开关设计，被诉侵权产品没有；
5. 涉案专利中头部与手柄的连接虽然有一定的斜角，但角度很小，几乎为直线形连接，被诉侵权产品头部与手柄的连接产生的斜角角度较大；
6. 从涉案专利的仰视图看，手柄底部为圆形，被诉侵权产品仰视的底部为曲面扇形，涉案专利手柄下端为圆柱体，向与头部连接处方向逐步收缩压扁呈扁椭圆体，被诉侵权产品的手柄下端为扇面柱体，且向与喷头连接处过渡均为扇面柱体，过渡中的手柄中段有弧度的突起；
7. 被诉侵权产品的手柄底端有一条弧形的装饰线，将手柄底端与产品的背面连成一体，涉案专利的手柄底端没有这样的设计；
8. 涉案专利头部和手柄的长度比例与被诉侵权产品有所差别，两者的头部与手柄的连接处弧面亦有差别。

裁判结果：浙江省台州市中级人民法院于2013年3月5日作出(2012)浙台民初字第573号民事判决，驳回高仪公司诉讼请求。

高仪公司不服，提起上诉。浙江省高级人民法院于2013年9月27日作出(2013)浙知终字第255号民事判决：

1. 撤销浙江省台州市中级人民法院(2012)浙台民初字第573号民事判决；
2. 浙江健龙公司立即停止制造、许诺销售、销售侵害高仪公司“手持淋浴喷头”外观设计专利权的产品的行为，销毁库存的侵权产品；
3. 浙江健龙公司赔偿高仪股份公司经济损失（含高仪公司为制止侵权行为所支出的合理费用）人民币10万元；
4. 驳回高仪公司的其他诉讼请求。浙江健龙公司不服，提起再审申请。

最高人民法院于2015年8月11日作出(2015)民提字第23号民事判决：1. 撤销二审判决；2. 维持一审判决。

裁判理由：最高人民法院提审认为：外观设计专利制度的立法目的在于保护具有美感的创新性工业设计方案，一项外观设计应当具有区别于现有设计的可识别性创新设计才能获得专利授权，该创新设计即是授权外观设计的设计特征。由于设计特征的存在，一般消费者容易将授权外观设计区别于现有设计，因此，其对外观设计产品的整体视觉效果具有显著影响，如果被诉侵权产品未包含授权外观设计区别于现有设计的全部设计特征，一般可以推定被诉侵权产品与授权外观设计不近似。

专利权人可能将设计特征记载在简要说明中，也可能在专利授权确权或者侵权程序中对设计特征作出相应陈述。无论是专利权人举证证明的设计特征，还是通过授权确权有关审查文档记载确定的设计特征，如果第三人提出异议，都应当允许其提供反证予以推翻。

人民法院在听取各方当事人质证意见的基础上，对证据进行充分审查，依法确定授权外观设计的设计特征。本案专利的设计特征有三点：一是喷头及其各面过渡的形状，二是喷头出水面形状，三是喷头宽度与手柄直径的比例。虽然被诉侵权产品采用了与本案专利高度近似的跑道状出水面，但在喷头及其各面过渡的形状这一设计特征上，二者在设计风格上呈现明显差异。二审判决仅重点

考虑了本案专利跑道状出水面的设计特征，而对于其他设计特征，以及产品正常使用时容易被直接观察到的其他区别设计特征未予考虑，从而认定二者构成近似外观设计的结论是错误的。

C. 马库什权利要求的性质、在无效程序中的修改方式和创造性判断方法

裁判要旨：

以马库什方式撰写的化合物权利要求应当被理解作为一种概括性的技术方案，而不是众多化合物的集合。

允许对马库什权利要求进行修改的原则，应当是不能因为修改而产生具有新性能和作用的一类或单个化合物，但是同时也要充分考量个案因素。

对于以马库什方式撰写的化合物权利要求的创造性的判断，应当遵循创造性判断的基本方法，即专利审查指南所规定的“三步法”。意料不到的技术效果是创造性判断的辅助因素，通常不宜跨过“三步法”，直接适用具有意料不到的技术效果来判断专利申请是否具有创造性。

专利复审委员会与北京万生药业有限责任公司、第一三共株式会社发明专利权无效行政纠纷案

案号：

最高人民法院（2016）最高法行再41号

案由：

发明专利权无效行政纠纷

合议庭成员：

秦元明 | 李 嵘 | 马秀荣

关键词：

无效程序，马库什权利要求，修改方式，创造性

相关法条：

《中华人民共和国专利法》第三十一条第一款

《中华人民共和国专利法实施细则》第三十四条

基本案情：在再审申请人国家知识产权局专利复审委员会（以下简称专利复审委员会）与被申请人北京万生药业有限责任公

司（以下简称万生公司）、一审第三人第一三共株式会社发明专利权无效行政纠纷案（简称“马库什权利要求”专利无效行政纠纷案）中，第一三共株式会社系名称为“用于治疗或预防高血压症的药物组合物的制备方法”、专利号为 97126347.7 的发明专利（即涉案专利）的权利人。涉案专利权利要求以马库什方式撰写。万生公司以涉案专利不具备创造性等为由向专利复审委员会提出无效宣告请求。

2010 年 8 月 30 日，第一三共株式会社对权利要求进行了修改，其中包括：

1. 删除了权利要求 I 中“或其可作药用的盐或酯”中的“或酯”两字；
2. 删除权利要求 1 中 R4 定义下的“具有 1 至 6 个碳原子的烷基”；
3. 删除了权利要求 I 中 R5 定义下除羧基和式 COOR5a 外的其他技术方案。

专利复审委员会在口头审理过程中告知第一三共株式会社，对于删除权利要求 I 中“或酯”的修改予以认可，但其余修改不符合《中华人民共和国专利法实施细则》第六十八条的相关规定，该修改文本不予接受。第一三共株式会社和万生公司对此无异议。

2011 年 1 月 14 日，第一三共株式会社提交了修改后的权利要求书替换页，其中删除权利要求 1 中的“或酯”。专利复审委员会作出第 16266 号无效宣告请求审查决定（简称第 16266 号决定），认为涉案专利权利要求 I 相比于证据 1 是非显而易见的，具有创造性，符合《中华人民共和国专利法》第二十二条第三款的规定。遂在第一三共株式会社于 2011 年 1 月 14 日提交的修改文本的基础上，维持涉案专利权有效。

万生公司不服，提起行政诉讼。北京市第一中级人民法院认为，专利复审委员会以不符合《中华人民共和国专利法实施细则》第六十八条的规定对第一三共株式会社于 2010 年 8 月 30 日提交的修改文本不予接受，不存在法律适用错误。涉案专利权利要求 1 相对于证据 1 是非

显而易见的，具备创造性。遂判决维持第 16266 号决定。

万生公司不服，提起上诉。北京市高级人民法院二审认为，马库什权利要求属于并列技术方案的特殊类型，第一三共株式会社于 2010 年 8 月 30 日提交的修改文本缩小了涉案专利权的保护范围，符合《中华人民共和国专利法实施细则》第六十八条第一款规定。涉案专利权利要求所涵盖的一个具体实施例的效果与现有技术证据 1 中实施例 329 的技术效果相当，因此，涉案专利权利要求 1 未取得预料不到的技术效果，不具备创造性。

裁判结果：专利复审委员会于 2011 年 4 月 1 日作出第 16266 号无效宣告请求审查决定，维持本专利权全部有效。

万生公司不服第 16266 号决定，向北京市第一中级人民法院提起行政诉讼。北京市第一中级人民法院于 2011 年 12 月 20 日一审判决维持专利复审委员会作出的第 16266 号决定。万生公司不服一审判决，向北京市高级人民法院提起上诉，请求撤销一审判决及第 16266 号决定，责令专利复审委员会重新作出审查决定。北京市高级人民法院于 2013 年 9 月 24 日二审判决撤销一审判决、撤销专利复审委员会第 16266 号决定、专利复审委员会重新作出无效宣告请求审查决定。

专利复审委员会不服，向最高人民法院申请再审。最高人民法院裁定提审本案，并于 2017 年 12 月 20 日判决撤销二审判决，维持一审判决。

裁判理由：最高人民法院提审认为：

一、关于马库什权利要求的性质

马库什权利要求是化学发明专利申请中一种特殊的权利要求撰写方式，即一项申请在一个权利要求中限定多个并列的可选择要素概括的权利要求。马库什权利要求撰写方式的产生是为了解决化学领域中多个取代基团没有共同上位概念可概括的问题，其本身一直被视为结

构式的表达方式，而非功能性的表达方式。马库什权利要求限定的是并列的可选要素而非权利要求，其所有可选择化合物具有共同性能和作用，并且具有共同的结构或者所有可选择要素属于该发明所属领域公认的同一种化合物。虽然马库什权利要求的撰写方式特殊，但是也应当符合专利法和专利法实施细则关于单一性的规定。马库什权利要求具有极强的概括能力，一旦获得授权，专利权保护范围将涵盖所有具有相同结构、性能或作用的化合物，专利权人权益将得到最大化实现。而从本质而言，专利权是对某项权利的垄断，专利权人所享有的权利范围越大，社会公众所受的限制也就越多，因此，从公平角度出发，对马库什权利要求的解释应当从严。马库什权利要求不管包含多少变量和组合，都应该视为一种概括性的组合方案。选择一个变量应该生成一种具有相同效果药物，即选择不同的分子式生成不同的药物，但是这些药物的药效不应该有太大差异，相互应当可以替代，而且可以预期所要达到的效果是相同的，这才符合当初创设马库什权利要求的目的。因此，马库什权利要求应当被视为马库什要素的集合，而不是众多化合物的集合，马库什要素只有在特定情况下才会表现为单个化合物，但通常而言，马库什要素应当理解为具有共同性能和作用的一类化合物。如果认定马库什权利要求所表述的化合物是众多化合物的集合，就明显与单一性要求不符，因此二审判决认为马库什权利要求属于并列技术方案不妥，应当予以纠正。

二、关于马库什权利要求在无效程序中的修改方式

2010年《专利审查指南》规定无效宣告请求审查阶段，发明和实用新型专利文件的修改应仅限于权利要求书，其遵循的基本原则是：

1. 不得改变原权利要求的主题名称；
2. 与授权的权利要求相比，不得扩大原专利的保护范围；
3. 不得超出原说明书和权利要求书中技术特征；

4. 一般不得增加未包含在授权权利要求书中的技术特征。

但是，目前修改方式已经改为在满足上述修改原则的前提下，修改权利要求书的具体方式一般限于权利要求的删除、技术方案的删除、权利要求的进一步限定、明显错误的修正。权利要求进一步限定是指在权利要求中补入其他权利要求中记载的一个或者多个技术特征，以缩小保护范围。

可见，在无效程序中，专利文件修改方式更加多样化。但是，化学领域发明专利申请审查存在诸多特殊问题，如化学发明是否能够实施需要借助于实验结果才能确认，有的化学产品需要借助于参数或者制备方法定义，已知化学产品新的性能和用途并不意味着结构或者组分的改变等。鉴于化学发明创造的特殊性，同时考虑到在马库什权利要求撰写之初，专利申请人为了获得最大的权利保护范围就有机会将所有结构方式尽可能写入一项权利要求，因此在无效阶段对马库什权利要求进行修改必须给予严格限制，允许对马库什权利要求进行修改的原则应当是不能因为修改而产生新性能和作用的一类或单个化合物，但是同时也要充分考量个案因素。如果允许专利申请人或专利权人删除任一变量的任一选项，即使该删除使得权利要求保护范围缩小，不会损伤社会公众的权益，但是由于是否因此会产生新的权利保护范围存在不确定性，不但无法给予社会公众稳定的预期，也不利于维护专利确权制度稳定，因此二审法院相关认定明显不妥，应当予以纠正。

三、关于马库什权利要求的创造性判断方法

马库什权利要求创造性判断应当遵循创造性判断的基本方法，即专利审查指南所规定的“三步法”。意料不到的技术效果是创造性判断的辅助因素，而且作为一种倒推的判断方法，具有特殊性，不具有普遍适用性。因此，只有在经过“三步法”审查和判断得不出是否是非显而易见时，才能根据具有意料不到的技术效果认定专利申请是否具有创造性，通常不宜跨过“三步法”直接适用具有意料不到的技术效果来

判断专利申请是否具有创造性。关于技术效果比对结果的问题，本案中，专利复审委员会在无效程序中并未将比文件 1 实施例 10、17、50 和 69 和涉案专利的实施例进行比对且就此作出认定，而二审直接进行比对并作出认定，明显超出了无效审查决定的审查范围，不符合行政诉讼法和相关司法解释的规定，应当予以纠正。无效宣告请求人万生公司认为涉案专利权利要求 1 不具备创造性，并将证据 1 作为最接近的对比文件。专利复审委员会和一审法院在对涉案专利权利要求 1 的创造性进行判断时，严格遵循了“三步法”，认定权利要求 1 的式 I 化合物和证据 1 的式 I 化合物相比较具有两项区别技术特征，然后对两项区别技术特征的非显而易见性进行了分析，从而认定涉案专利权利要求 1 具有创造性并无不当。

D. 产品说明书是否属于专利法意义上的公开出版物

裁判要旨：

产品操作和维护说明书随产品销售而交付使用者，使用者及接触者均没有保密义务，且其能够为不特定公众所获取，属于专利法意义上的公开出版物。其中记载的技术方案，以交付给使用者的时间作为公开时间。

蒂森克虏伯机场系统（中山）有限公司与中国国际海运集装箱（集团）股份有限公司、深圳中集天达空港设备有限公司、广州市白云国际机场股份有限公司侵害发明专利权纠纷案

案号：

最高人民法院（2016）最高法民再 179 号

案由：

侵害发明专利权纠纷

合议庭成员：

李 剑 | 宋淑华 | 吴 蓉

关键词：

发明专利，侵权，产品说明书，出版物公开

相关法条：

《中华人民共和国专利法》（2000 年修正）
第二十二条
《中华人民共和国专利法》（2008 年修正）
第六十二条

基本案情：在再审申请人蒂森克虏伯机场系统（中山）有限公司（以下简称蒂森中山公司）与被申请人中国国际海运集装箱（集团）股份有限公司（以下简称中集公司）、深圳中集天达空港设备有限公司（以下简称天达公司）、一审被告广州市白云国际机场股份有限公司（以下简称白云机场）侵害发明专利权纠纷案中，中集公司系名称为“登机桥辅助支撑装置和

带有该装置的登机桥及其控制方法”的第200410004652.9号发明专利(即本案专利)的权利人,本案专利的申请日为2004年2月26日,授权公告日为2007年8月22日。授权时的专利权人是中集公司。2009年5月8日,本案发明专利权人变更为中集公司和天达公司。中集公司与天达公司以白云机场和蒂森中山公司未经许可擅自实施本案专利的技术方案侵害其专利权为由,提起诉讼。

蒂森中山公司在一审诉讼过程中提出现有技术抗辩,并提交了蒂森克虏伯机场系统公司运营总监雷蒙德·K·斯特里特的证言及来源于该公司的佐证证言的附件作为支持其现有技术抗辩的证据。该证据记载,从2000年10月至2001年3月,蒂森克虏伯集团派往旧金山国际机场的现场小组为消除晃动幅度过大的问题研究出一种技术解决方案,其中包括在登机桥的横梁/负重轮的两侧均安装一个液压稳定器,以增强登机桥的稳定性。这种方法被称为“悬臂梁设计”或“悬臂梁装置”。用户接受使用“悬臂梁设计”或“悬臂梁装置”的建议。随后便进行了生产和安装。

《手册》的附录Y“液压稳定器”(以下简称附录Y)经更新后发布并交付用户。蒂森中山公司主张,附录Y证明其使用的为现有技术。广东省广州市中级人民法院一审认为,附录Y是一份由蒂森中山公司关联公司自行印制的非正规出版物。在蒂森中山公司不能证明其关联公司曾使用“悬臂梁装置”技术的情况下,一审法院难以确认该附录Y内容的真实性及其印制及交付给旧金山国际机场的时间。因蒂森中山公司不能证明“悬臂梁装置”技术于2000~2001年就已通过附录Y公开发表,故其现有技术抗辩不能成立。一审法院遂判决蒂森中山公司、白云机场立即停止侵权行为,蒂森中山公司赔偿中集公司与天达公司经济损失50万元并驳回中集公司与天达公司的其他诉讼请求。

蒂森中山公司不服,提起上诉。广东省高级人民法院二审判决驳回上诉、维持原判。

蒂森中山公司仍不服,向最高人民法院申请再审。最高人民法院裁定提审本案,并

于2016年10月10日判决撤销一审、二审判决,驳回中集公司与天达公司的诉讼请求。

裁判结果:广东省广州市中级人民法院于2012年9月24日作出(2011)穗中法民三初字第107号民事判决:

1. 蒂森中山公司、白云机场立即停止侵权行为;
2. 蒂森中山公司赔偿中集公司与天达公司经济损失50万元;
3. 驳回中集公司与天达公司的其他诉讼请求。

蒂森中山公司不服一审判决,向广东省高级人民法院提起上诉。广东省高级人民法院于2014年7月16日作出(2013)粤高法民三终字第38号民事判决:驳回上诉,维持原判。

蒂森中山公司仍不服,向最高人民法院申请再审。最高人民法院裁定提审本案,并于2016年10月10日作出(2016)最高法民再179号民事判决:

1. 撤销广东省高级人民法院(2013)粤高法民三终字第38号民事判决;
2. 撤销广东省广州市中级人民法院(2011)穗中法民三初字第107号民事判决;
3. 驳回被申请人中国国际海运集装箱(集团)股份有限公司和深圳中集天达空港设备有限公司的诉讼请求。

裁判理由:最高人民法院提审认为:蒂森中山公司在本案中主张现有技术抗辩,即因附录Y构成出版物公开,故其使用的是现有技术,不侵害本案专利权。专利法意义上的出版物是指记载有技术或设计内容的独立存在的传播载体,并且应当表明或者有其他证据证明其公开发表或出版的时间。附录Y虽是一份产品操作和维护说明书并随产品销售而交付使用者,但其使用者以及接触者均没有保密义务,也即附录Y是可公开的,且其能够为不特定公众通过复印的方式获取。由此可见,附录Y系独立存在的传播载体,鉴于其也记载了涉案专利技术的技术特征,其交付给旧金山

国际机场的时间，即公开时间亦能确定，故其属于专利法意义上的出版物公开，蒂森中山公司据此主张现有技术抗辩，有事实和法律依据，应当予以支持。

E. 专利权人与侵权人的事先约定可以作为确定专利侵权损害赔偿数额的依据

裁判要旨：

权利人与侵权人就侵权损害赔偿数额作出的事先约定，不构成权利人与侵权人之间的交易合同，故侵权人应承担的民事责任仅为侵权责任，不属于《中华人民共和国合同法》第一百二十二条规定的侵权责任与违约责任竞合的情形。

权利人与侵权人就侵权损害赔偿数额作出的事先约定，是双方就未来发生侵权时权利人因被侵权所受到的损失或者侵权人因侵权所获得的利益所预先达成的一种计算方法。

在无法律规定无效等情形下，人民法院可直接以权利人与侵权人的事先约定作为确定侵权损害赔偿数额的依据。

中山市隆成日用制品有限公司与湖北童霸儿童用品有限公司侵害实用新型专利权纠纷案

案号：

最高人民法院（2013）民提字第116号

案由：

侵害实用新型专利权纠纷

合议庭成员：

王闯 | 朱理 | 何鹏

关键词：

实用新型专利侵权，损害赔偿，竞合

相关法条：

《中华人民共和国合同法》第一百二十二条

《中华人民共和国专利法》第六十五条第一款

基本案情：中山市隆成日用制品有限公司（以下简称隆成公司）是名称为“前轮定

位装置”实用新型专利(以下简称涉案专利)的专利权人。2008年4月,隆成公司曾以湖北童霸儿童用品有限公司(以下简称童霸公司)侵犯涉案专利为由向武汉市中级人民法院提起诉讼,法院判决童霸公司停止侵权并赔偿损失。

童霸公司不服,提起上诉。二审期间,双方达成调解协议并由湖北省高级人民法院制作了(2009)鄂民三终字第42号民事调解书,其主要内容为:童霸公司保证不再侵犯隆成公司的专利权,如发现一起侵犯隆成公司实用新型专利权的行为,自愿赔偿隆成公司100万元。

后隆成公司发现童霸公司仍在从事侵害涉案专利权的经营行为,遂于2011年5月再次向武汉市中级人民法院提起诉讼,请求法院判令童霸公司赔偿隆成公司100万元并承担诉讼费用。一审庭审中,经法院释明,隆成公司明确本案依据专利侵权起诉,不选择合同违约之诉,但请求法院对侵权赔偿数额按双方约定的标准计算。一审法院认为:根据《中华人民共和国合同法》第一百二十二条的规定,侵权责任与违约责任竞合时,受损害方有选择权。隆成公司明确选择提起侵权之诉,应根据侵权责任法确定赔偿数额。若赔偿标准以前案民事调解书的约定为准,则与合同法的上述规定相冲突。因隆成公司主张侵权之诉,违约之诉无法纳入法庭调查和辩论的范围,法院无须对违约行为及违约责任作出判断,故不宜适用当事人约定的违约赔偿金。一审法院遂适用法定赔偿判决童霸公司赔偿隆成公司14万元。

隆成公司不服,提起上诉。湖北省高级人民法院二审认为,侵权行为成立与否是本案双方当事人权利义务关系的基础,前案中被诉侵权童车产品的型号与本案中被诉侵权童车产品的型号不同,故调解协议约定的赔偿数额不能适用于本案,遂判决驳回上诉,维持一审判决。

隆成公司仍不服,向最高人民法院申请再审。最高人民法院裁定提审本案,并于2013年12月7日判决撤销原一、二审判决,判令童霸公司赔偿隆成公司100万元。

裁判结果:武汉市中级人民法院于2011年10月24日作出(2011)武知初字第467号民事判决,判令童霸公司赔偿隆成公司14万元,驳回隆成公司其他诉讼请求。

隆成公司不服一审判决,向湖北省高级人民法院提起上诉,请求撤销一审判决,并依法改判。湖北省高级人民法院于2012年5月11日作出二审判决,驳回上诉,维持一审判决。

隆成公司不服二审判决,向最高人民法院申请再审。最高人民法院裁定提审本案,并于2013年12月7日判决撤销原一、二审判决,判令童霸公司赔偿隆成公司100万元。

裁判理由:最高人民法院提审认为:

一、关于双方当事人在前案中达成的调解协议的效力

由于调解协议系双方当事人自愿达成,其内容仅涉及私权处分,不涉及社会公共利益、第三人利益,也不存在法律规定的其他无效情形,且湖北省高级人民法院对调解协议进行审查确认后制作了民事调解书,故双方在前案中达成的调解协议合法有效。

二、关于本案能否适用双方在调解协议中约定的赔偿数额确定方法

首先,本案中童霸公司应承担的民事责任,不属于侵权责任与违约责任竞合之情形。《中华人民共和国合同法》第一百二十二条所规定的侵权与违约责任的竞合,其法律要件是“因当事人一方的违约行为,侵害对方人身、财产权益”。就该规定来看,违约责任与侵权责任发生竞合的前提是当事人双方之间存在一种基础的交易合同关系。基于该交易合同关系,一方当事人违反合同约定的义务,该违约行为侵害了对方权益而产生侵权责任。因此,该规定中的违约行为应当是指对基础交易合同约定义务的违反,且该违约行为同时侵害了对方权益,而不是指对侵权行为发生之后当事人就如何承担赔偿责任所作约定的违反。就调解协议的内容来看,该协议并非隆成

公司与童霸公司之间的基础交易合同，而是对侵权行为发生后如何承担侵权赔偿责任（包括计算方法和数额）的约定。因此，本案中童霸公司应承担的民事责任，不属于《中华人民共和国合同法》第一百二十二条规定的侵权责任与违约责任竞合的情形。

其次，本案中童霸公司应承担的民事责任系侵权责任。一方面，前已述及，隆成公司与童霸公司之间并不存在基础合同关系；另一方面，调解协议的法律意义与效果，不在于对童霸公司的合同交易义务作出约定，而在于对侵权责任如何承担作出约定。即使没有调解协议，童霸公司基于法律规定也同样负有不侵权的义务。当事人双方将童霸公司将来侵权行为发生后的具体赔偿方法和数额写进调解协议，只是为了便于进一步约定当童霸公司再次侵权时其侵权责任应如何承担。

第三，侵权责任法、专利法等法律，并未禁止被侵权人与侵权人就侵权责任的方式、侵权赔偿数额等预先作出约定。这种约定的实质是，双方就未来发生侵权时权利人因被侵权所受到的损失或者侵权人因侵权所获得的利益，预先达成的一种简便的计算和确定方法。基于举证困难、诉讼耗时费力等因素的考虑，双方当事人在私法自治的范畴内完全可以对侵权赔偿数额作出约定，这种约定既包括侵权行为发生后的事后约定，也包括侵权行为发生前的事先约定。因此，本案适用调解协议中双方约定的赔偿数额确定方法，与《中华人民共和国专利法》第六十五条的有关规定并不冲突。综上，本案可以适用隆成公司与童霸公司在前案调解协议中约定的赔偿数额确定方法。

F. 被侵权人向网络服务提供者所发出的有效通知、网络服务提供者接到通知后所应采取的必要措施的判断方法

裁判要旨：

网络用户利用网络服务实施侵权行为，被侵权人依据侵权责任法向网络服务提供者所发出的要求其采取必要措施的通知，包含被侵权人身份情况、权属凭证、侵权人网络地址、侵权事实初步证据等内容的，即属有效通知。网络服务提供者自行设定的投诉规则，不得影响权利人依法维护其自身合法权益。

《中华人民共和国侵权责任法》第三十六条第二款所规定的网络服务提供者接到通知后所应采取的必要措施包括但不限于删除、屏蔽、断开链接。“必要措施”应遵循审慎、合理的原则，根据所侵害权利的性质、侵权的具体情形和技术条件等来加以综合确定。

威海嘉易烤生活家电有限公司与永康市金仕德工贸有限公司、浙江天猫网络有限公司侵害发明专利权纠纷案

案号：

浙江省高级人民法院（2015）浙知终字第186号

案由：

发明专利权侵权纠纷

合议庭成员：

周平 | 陈宇 | 刘静

关键词：

民事，侵害发明专利权，有效通知，必要措施，网络服务提供者，连带责任

相关法条：

《中华人民共和国侵权责任法》第三十六条

基本案情：原告威海嘉易烤生活电器有限公司（以下简称嘉易烤公司）诉称：永康市金仕德工贸有限公司（以下简称金仕德公司）未经许可，在天猫商城等网络平台上宣传并销售侵害其 ZL200980000002.8 号专利权的产品，构成专利侵权；浙江天猫网络有限公司（以下简称天猫公司）在嘉易烤公司投诉金仕德公司侵权行为的情况下，未采取有效措施，应与金仕德公司共同承担侵权责任。请求判令：

1. 金仕德公司立即停止销售被诉侵权产品；
2. 金仕德公司立即销毁库存的被诉侵权产品；
3. 天猫公司撤销金仕德公司在天猫平台上所有的侵权产品链接；
4. 金仕德公司、天猫公司连带赔偿嘉易烤公司 50 万元；
5. 本案诉讼费用由金仕德公司、天猫公司承担。

金仕德公司答辩称：其只是卖家，并不是生产厂家，嘉易烤公司索赔数额过高。

天猫公司答辩称：

1. 其作为交易平台，并不是生产销售侵权产品的主要经营方或者销售方；
2. 涉案产品是否侵权不能确定；
3. 涉案产品是否使用在先也不能确定；
4. 在不能证明其为侵权方的情况下，由其连带赔偿 50 万元缺乏事实和法律依据，且其公司业已删除了涉案产品的链接，嘉易烤公司关于撤销金仕德公司在天猫平台上所有侵权产品链接的诉讼请求亦不能成立。

法院经审理查明：2009 年 1 月 16 日，嘉易烤公司及其法定代表人李璘熙共同向国家知识产权局申请了名称为“红外线加热烹调装置”的发明专利，并于 2014 年 11 月 5 日获得授权，专利号为 ZL200980000002.8。该发明专利的权利要求书记载：

“1. 一种红外线加热烹调装置，其特征在于，该红外线加热烹调装置包括：托架，在其上部中央设有轴孔，且在其一侧设有控制电源的开关；受红外线照射就会被加热的旋转盘，作为在其上面可以盛食物的圆盘形容器，在其下部中央设有可拆装的插入到上述轴孔中的突起；支架，在上述托架的一侧纵向设置；红外线照射部，其设在上述支架的上端，被施加电源就会朝上述旋转盘照射红外线；上述托架上还设有能够从内侧拉出的接油盘；在上述旋转盘的突起上设有轴向的排油孔。”

2015 年 1 月 26 日，涉案发明专利的专利权人变更为嘉易烤公司。

2015 年 1 月 29 日，嘉易烤公司的委托代理机构北京商专律师事务所向北京市海诚公证处申请证据保全公证，其委托代理人王永先、时寅在公证处监督下，操作计算机登入天猫网（网址为 <http://www.tmall.com>），在一家名为“益心康旗舰店”的网上店铺购买了售价为 388 元的 3D 烧烤炉，并拷贝了该网店经营者的营业执照信息。同年 2 月 4 日，时寅在公证处监督下接收了寄件人名称为“益心康旗舰店”的快递包裹一个，内有韩文包装的 3D 烧烤炉及赠品、手写收据联和中文使用说明书、保修卡。公证员对整个证据保全过程进行了公证并制作了（2015）京海诚内民证字第 01494 号公证书。同年 2 月 10 日，嘉易烤公司委托案外人张一军向淘宝网知识产权保护平台上传了包含专利侵权分析报告和技术特征比对表在内的投诉材料，但淘宝网最终没有审核通过。同年 5 月 5 日，天猫公司向浙江省杭州市钱塘公证处申请证据保全公证，由其代理人刁曼丽在公证处的监督下操作电脑，在天猫网益心康旗舰店搜索“益心康 3D 烧烤炉韩式家用不粘电烤炉无烟烤肉机电烤盘铁板烧烤肉锅”，显示没有搜索到符合条件的商品。公证员对整个证据保全过程进行了公证并制作了（2015）浙杭钱证内字第 10879 号公证书。

一审庭审中，嘉易烤公司主张将涉案专利权利要求 1 作为本案要求保护的专利范围。经比对，嘉易烤公司认为除了开关位置的不同，被控侵权产品的技术特征完全落入了涉案专利权利要求 1 记载的保护范围，而开关位置的变化是业内普通技术人员不需要创造性劳动就可解决的，属于等同特征。两原审被告对比对结果不持异议。另查明，嘉易烤公司为本案支出公证费 4,000 元，代理服务费 81,000 元。

裁判结果：浙江省金华市中级人民法院于 2015 年 8 月 12 日作出 (2015) 浙金知民初字第 148 号民事判决：

1. 金仕德公司立即停止销售侵犯专利号为 ZL200980000002.8 的发明专利的产品的行为；
2. 金仕德公司于判决生效之日起十日内赔偿嘉易烤公司经济损失 150,000 元（含嘉易烤公司为制止侵权而支出的合理费用）；
3. 天猫公司对上述第二项中金仕德公司赔偿金额的 50,000 元承担连带赔偿责任；
4. 驳回嘉易烤公司的其他诉讼请求。

一审宣判后，天猫公司不服，提起上诉。浙江省高级人民法院于 2015 年 11 月 17 日作出 (2015) 浙知终字第 186 号民事判决：驳回上诉，维持原判。

裁判理由：法院生效裁判认为：各方当事人对于金仕德公司销售的被诉侵权产品落入嘉易烤公司涉案专利权利要求 1 的保护范围，均不持异议，原审判决认定金仕德公司涉案行为构成专利侵权正确。关于天猫公司在本案中是否构成共同侵权，《中华人民共和国侵权责任法》第三十六条第二款规定，网络用户利用网络服务实施侵权行为的，被侵权人有权通知网络服务提供者采取删除、屏蔽、断开链接等必要措施。网络服务提供者接到通知后未及时采取必要措施的，对损害的扩大部分与该网络用户承担连带责任。上述规定系针对权利人发现网络用户利用网络服务提供者的服务实施侵权行为后“通知”网络服务提供者采取必要措施，以防止侵权后果不当扩大的情形，同时

还明确界定了此种情形下网络服务提供者所应承担的义务范围及责任构成。本案中，天猫公司涉案被诉侵权行为是否构成侵权应结合对天猫公司的主体性质、嘉易烤公司“通知”的有效性以及天猫公司在接到嘉易烤公司的“通知”后是否应当采取措施及所采取的措施的必要性和及时性等加以综合考量。

第一，天猫公司依法持有增值电信业务经营许可证，系信息发布平台的服务提供商，其在本案中为金仕德公司经营的“益心康旗舰店”销售涉案被诉侵权产品提供网络技术服务，符合《中华人民共和国侵权责任法》第三十六条第二款所规定网络服务提供者的主体条件。

第二，天猫公司在二审庭审中确认嘉易烤公司已于 2015 年 2 月 10 日委托案外人张一军向淘宝网知识产权保护平台上传了包含被投诉商品链接及专利侵权分析报告、技术特征比对表在内的投诉材料，且根据上述投诉材料可以确定被投诉主体及被投诉商品。

《中华人民共和国侵权责任法》第三十六条第二款所涉及的“通知”是认定网络服务提供者是否存在过错及应否就危害结果的不当扩大承担连带责任的条件。“通知”是指被侵权人就他人利用网络服务商的服务实施侵权行为的事实向网络服务提供者所发出的要求其采取必要技术措施，以防止侵权行为进一步扩大的行为。“通知”既可以是口头的，也可以是书面的。通常，“通知”内容应当包括权利人身份情况、权属凭证、证明侵权事实的初步证据以及指向明确的被诉侵权人网络地址等材料。符合上述条件的，即应视为有效通知。嘉易烤公司涉案投诉通知符合侵权责任法规定的“通知”的基本要件，属有效通知。

第三，经查，天猫公司对嘉易烤公司投诉材料作出审核不通过的处理，其在回复中表明审核不通过原因是：

请在实用新型、发明的侵权分析对比表表二中详细填写被投诉商品落入贵方提供的专利权利要求的技术

点，建议采用图文结合的方式一一指出。（需注意，对比的对象为卖家发布的商品信息上的图片、文字），并提供购买订单编号或双方会员名。

二审法院认为，发明或实用新型专利侵权的判断往往并非仅依赖表面或书面材料就可以作出，因此专利权人的投诉材料通常只需包括权利人身份、专利名称及专利号、被投诉商品及被投诉主体内容，以便投诉接受方转达被投诉主体。在本案中，嘉易烤公司的投诉材料已完全包含上述要素。至于侵权分析比对，天猫公司一方面认为其对卖家所售商品是否侵犯发明专利判断能力有限，另一方面却又要求投诉方“详细填写被投诉商品落入贵方提供的专利权利要求的技术点，建议采用图文结合的方式一一指出”，该院认为，考虑到互联网领域投诉数量巨大、投诉情况复杂的因素，天猫公司的上述要求基于其自身利益考量虽也具有一定的合理性，而且也有利于天猫公司对于被投诉行为的性质作出初步判断并采取相应的措施。但就权利人而言，天猫公司的前述要求并非权利人投诉通知有效的必要条件。况且，嘉易烤公司在本案的投诉材料中提供了多达5页的以图文并茂的方式表现的技术特征对比表，天猫公司仍以教条的、格式化的回复将技术特征对比作为审核不通过的原因之一，处置失当。至于天猫公司审核不通过并提出提供购买订单编号或双方会员名的要求，该院认为，本案中投诉方是否提供购买订单编号或双方会员名并不影响投诉行为的合法有效。而且，天猫公司所确定的投诉规制并不对权利人维权产生法律约束力，权利人只需在法律规定的框架内行使维权行为即可，投诉方完全可以根据自己的利益考量决定是否接受天猫公司所确定的投诉规制。更何况投诉方可能无需购买商品而通过其他证据加以证明，也可以根据他人的购买行为发现可能的侵权行为，甚至投诉方即使存在直接购买行为，但也可以基于某种经济利益或商业秘密的考量而拒绝提供。

第四，《中华人民共和国侵权责任法》第三十六条第二款所规定的网络服务提供者接到通知后所应采取必要措施包括但不限于删除、屏蔽、断开链接。“必要措施”

应根据所侵害权利的性质、侵权的具体情形和技术条件等来加以综合确定。

本案中，在确定嘉易烤公司的投诉行为合法有效之后，需要判断天猫公司在接受投诉材料之后的处理是否审慎、合理。该院认为，本案系侵害发明专利权纠纷。天猫公司作为电子商务网络服务平台的提供者，基于其公司对于发明专利侵权判断的主观能力、侵权投诉胜诉概率以及利益平衡等因素的考量，并不必然要求天猫公司在接受投诉后对被投诉商品立即采取删除和屏蔽措施，对被诉商品采取的必要措施应当秉承审慎、合理原则，以免损害被投诉人的合法权益。但是将有效的投诉通知材料转达被投诉人并通知被投诉人申辩当属天猫公司应当采取的必要措施之一。否则权利人投诉行为将失去意义，权利人的维权行为也将难以实现。网络服务平台提供者应该保证有效投诉信息传递的顺畅，而不应成为投诉信息的黑洞。被投诉人对其生产、或销售的商品是否侵权，以及是否应主动自行停止被投诉行为，自会作出相应的判断及应对。而天猫公司未履行上述基本义务的结果导致被投诉人未收到任何警示从而造成损害后果的扩大。至于天猫公司在嘉易烤公司起诉后即对被诉商品采取删除和屏蔽措施，当属审慎、合理。综上，天猫公司在接到嘉易烤公司的通知后未及时采取必要措施，对损害的扩大部分应与金仕德公司承担连带责任。天猫公司就此提出的上诉理由不能成立。关于天猫公司所应承担责任的份额，一审法院综合考虑侵权持续的时间及天猫公司应当知道侵权事实的时间，确定天猫公司对金仕德公司赔偿数额的50,000元承担连带赔偿责任，并无不当。

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第三章

著作权案件

A. 根据同一历史题材创作作品中的必要场景和有限表达方式不受著作权法保护

裁判要旨：

根据同一历史题材创作的作品中的题材主线、整体线索脉络，是社会共同财富，属于思想范畴，不能为个别人垄断，任何人都有权对此类题材加以利用并创作作品。

判断作品是否构成侵权，应当从被诉侵权作品作者是否接触过权利人作品、被诉侵权作品与权利人作品之间是否构成实质相似等方面进行。在判断是否构成实质相似时，应比较作者在作品表达中的取舍、选择、安排、设计等是否相同或相似，不应从思想、情感、创意、对象等方面进行比较。

按照《中华人民共和国著作权法》保护作品的规定，人民法院应保护作者具有独创性的表达，即思想或情感的表现形式。对创意、素材、公有领域信息、创作形式、必要场景，以及具有唯一性或有限性的表达形式，则不予保护。

张晓燕与雷献和、赵琪、山东爱书人音像图书有限公司著作权侵权纠纷案

案号：

最高人民法院（2013）民申字第1049号

案由：

著作权纠纷

合议庭成员：

于晓白 | 骆电 | 李嶸

关键词：

著作权侵权，影视作品，历史题材，实质相似

相关法条：

《中华人民共和国著作权法》第二条
《中华人民共和国著作权法实施条例》第二条

基本案情：原告张晓燕诉称：其于1999年12月开始改编创作《高原骑兵连》剧本，2000年8月根据该剧本筹拍20集电视连续剧《高原骑兵连》（以下将该剧本及其电视剧简称“张剧”），2000年12月该剧摄制完成，张晓燕系该剧著作权人。被告雷献和作为《高原骑兵连》的名誉制片人参与了该剧的摄制。被告雷献和作为第一编剧和制片人、被告赵琪作为第二编剧拍摄了电视剧《最后的骑兵》（以下将该电视剧及其剧本简称“雷剧”）。

2009年7月1日，张晓燕从被告山东爱书人音像图书有限公司购得《最后的骑兵》DVD光盘，发现与“张剧”有很多雷同之处，主要人物关系、故事情节及其他方面相同或近似，“雷剧”对“张剧”剧本及电视剧构成侵权。故请求法院判令：三被告停止侵权，雷献和在《齐鲁晚报》上公开发表致歉声明并赔偿张晓燕剧本稿酬损失、剧本出版发行及改编费损失共计80万元。

被告雷献和辩称：“张剧”剧本根据张冠林的长篇小说《雪域河源》改编而成，“雷剧”最初由雷献和根据师永刚的长篇小说《天苍茫》改编，后由赵琪参照其小说《骑马挎枪走天涯》重写剧本定稿。2000年上半年，张晓燕找到雷献和，提出合拍反映骑兵生活的电视剧。雷献和向张晓燕介绍了改编《天苍茫》的情况，建议合

拍，张晓燕未同意。2000年8月，雷献和张晓燕签订了合作协议，约定拍摄制作由张晓燕负责，雷献和负责军事保障，不参与艺术创作，雷献和没有看到张晓燕的剧本。“雷剧”和“张剧”创作播出的时间不同，“雷剧”不可能影响“张剧”的发行播出。

法院经审理查明：“张剧”“雷剧”、《骑马挎枪走天涯》《天苍茫》，均系以二十世纪八十年代中期精简整编中骑兵部队撤（缩）编为主线展开的军旅、历史题材作品。短篇小说《骑马挎枪走天涯》发表于《解放军文艺》1996年第12期总第512期；长篇小说《天苍茫》于2001年4月由解放军文艺出版社出版发行；“张剧”于2004年5月17日至5月21日由中央电视台第八套节目在上午时段以每天四集的速度播出；“雷剧”于2004年5月19日至29日由中央电视台第一套节目在晚上黄金时段以每天两集的速度播出。

《骑马挎枪走天涯》通过对骑兵连被撤销前后连长、指导员和一匹神骏的战马的描述，叙述了骑兵在历史上的辉煌、骑兵连被撤销、骑兵连官兵特别是骑兵连长对骑兵、战马的痴迷。《骑马挎枪走天涯》存在如下描述：神马（15号军马）出身来历中透着的神秘、连长与军马的水乳交融、指导员孔越华的人物形象、连长作诗、父亲当过骑兵团长、骑兵在未来战争中发挥的重要作用、连长为保留骑兵连所做的努力、骑兵连最后被撤销、结尾处连长与神马的悲壮。“雷剧”中天马的来历也透着神秘，除了连长常问天的父亲曾为骑兵师长外，上述情节内容与《骑马挎枪走天涯》基本相似。

《天苍茫》是讲述中国军队最后一支骑兵连充满传奇与神秘历史的书，书中展示草原与骑兵的生活，如马与人的情感、最后一匹野马的基因价值，以及研究马语的老人，神秘的预言者，最后的野马在香港赛马场胜出的传奇故事。《天苍茫》中连长成天的父亲是原骑兵师的师长，司令员是山南骑兵连的第一任连长、成天父亲的老部下，成天从小暗恋司令员女儿兰静，指导员王青衣与兰静相爱，并促进成天与基因学者刘可的爱情。最后连长为救被

困沼泽的研究人员牺牲。雷剧中高波将前指导员跑得又快又稳性子好的“大喇嘛”牵来交给常问天作为临时坐骑。结尾连长为完成抓捕任务而牺牲。“雷剧”中有关指导员孔越华与连长常问天之间关系的描述与《天苍茫》中指导员王青衣与连长成天关系的情节内容有相似之处。

法院依法委托中国版权保护中心版权鉴定委员会对张剧与雷剧进行鉴定，结论如下：

1. 主要人物设置及关系部分相似；
2. 主要线索脉络即骑兵部队缩编（撤销）存在相似之处；
3. 存在部分相同或者近似的情节，但除一处语言表达基本相同之外，这些情节的具体表达基本不同。

语言表达基本相同的情节是指双方作品中男主人公表达“愿做牧马人”的话语情节。“张剧”电视剧第四集秦冬季说：“草原为家，以马为伴，做个牧马人”；“雷剧”第十八集常问天说：“以草原为家，以马为伴，你看过电影《牧马人》吗？做个自由的牧马人”。

裁判结果：山东省济南市中级人民法院于2011年7月13日作出（2010）济民三初字第84号民事判决：驳回张晓燕的全部诉讼请求。

张晓燕不服，提起上诉，山东省高级人民法院于2012年6月14日作出（2011）鲁民三终字第194号民事判决：驳回上诉，维持原判。

张晓燕不服，向最高人民法院申请再审。最高人民法院经审查，于2014年11月28日作出（2013）民申字第1049号民事裁定：驳回张晓燕的再审申请。

裁判理由：最高人民法院审查认为：本案的争议焦点是“雷剧”的剧本及电视剧是否侵害“张剧”的剧本及电视剧的著作权。

判断作品是否构成侵权，应当从被诉侵权作品的作者是否“接触”过要求保护的权利人作品、被诉侵权作品与权利人

的作品之间是否构成“实质相似”两个方面进行判断。本案各方当事人对雷献和接触“张剧”剧本及电视剧并无争议，本案的核心问题在于两部作品是否构成实质相似。

我国著作权法所保护的是作品中作者具有独创性的表达，即思想或情感的表现形式，不包括作品中所反映的思想或情感本身。这里指的思想，包括对物质存在、客观事实、人类情感、思维方法的认识，是被描述、被表现的对象，属于主观范畴。思想者借助物质媒介，将构思诉诸形式表现出来，将意象转化为形象、将抽象转化为具体、将主观转化为客观、将无形转化为有形，为他人感知的过程即为创作，创作形成的有独创性的表达属于受著作权法保护的作品。著作权法保护的表达不仅指文字、色彩、线条等符号的最终形式，当作品的内容被用于体现作者的思想、情感时，内容也属于受著作权法保护的表达，但创意、素材或公有领域的信息、创作形式、必要场景或表达唯一或有限则被排除在著作权法的保护范围之外。必要场景，指选择某一类主题进行创作时，不可避免而必须采取某些事件、角色、布局、场景，这种表现特定主题不可或缺的表达方式不受著作权法保护；表达唯一或有限，指一种思想只有唯一一种或有限的表达形式，这些表达视为思想，也不给予著作权保护。在判断“雷剧”与“张剧”是否构成实质相似时，应比较两部作品中对于思想和情感的表达，将两部作品表达中作者的取舍、选择、安排、设计是否相同或相似，而不是离开表达看思想、情感、创意、对象等其他方面。结合张晓燕的主张，从以下几个方面进行分析判断：

关于张晓燕提出“雷剧”与“张剧”题材主线相同的主张，因“雷剧”与《骑马挎枪走天涯》都通过紧扣“英雄末路、骑兵绝唱”这一主题和情境描述了“最后的骑兵”在撤编前后发生的故事，可以认定“雷剧”题材主线及整体线索脉络来自《骑马挎枪走天涯》。“张剧”“雷剧”以及《骑马挎枪走天涯》《天苍茫》4部作品均系以二十世纪八十年代中期精简整编中骑兵部队撤（缩）编为主线展开的军旅历史题材作品，是社会的共同财富，不能为个别人所垄断，故4部作品的作者都有权以自己的方式对

此类题材加以利用并创作作品。因此，即便“雷剧”与“张剧”题材主线存在一定的相似性，因题材主线不受著作权法保护，且“雷剧”的题材主线系来自最早发表的《骑马挎枪走天涯》，不能认定“雷剧”抄袭自“张剧”。

关于张晓燕提出“雷剧”与“张剧”人物设置与人物关系相同、相似的主张，鉴于前述4部作品均系以特定历史时期骑兵部队撤（缩）编为主线展开的军旅题材作品，除了《骑马挎枪走天涯》受短篇小说篇幅的限制，没有三角恋爱关系或军民关系外，其他3部作品中都包含三角恋爱关系、官兵上下关系、军民关系等人物设置和人物关系，这样的表现方式属于军旅题材作品不可避免地采取的必要场景，因表达方式有限，不受著作权法保护。

关于张晓燕提出“雷剧”与“张剧”语言表达及故事情节相同、相似的主张，从语言表达看，如“雷剧”中“做个自由的‘牧马人’”与“张剧”中“做个牧马人”语言表达基本相同，但该语言表达属于特定语境下的惯常用语，非独创性表达。从故事情节看，用于体现作者的思想与情感的情节属于表达的范畴，具有独创性的故事情节应受著作权法保护，但是，故事情节中仅部分元素相同、相似并不能当然得出故事情节相同、相似的结论。前述4部作品相同、相似的部分多属于公有领域素材或缺乏独创性的素材，有的仅为故事情节中的部分元素相同，但情节所展开的具体内容和表达的意义并不相同。二审法院认定“雷剧”与“张剧”6处相同、相似的情节，其中老部下关系、临时指定马匹等在《天苍茫》中也有相似的情节内容，其他部分虽在情节设计方面存在相同、相似之处，但有的仅为情节表达中部分元素的相同、相似，情节内容相同、相似的部分少且微不足道。

整体而言，“雷剧”与“张剧”具体情节展开不同、描写的侧重点不同、主人公性格不同、结尾不同，二者相同、相似的情节在“雷剧”中所占比例极低，且在故事情节中处于次要位置，不构成“雷剧”中的主要部分，不会导致读者和观众对两部作品产生相同、相似的欣赏体验，不能

得出两部作品实质相似的结论。根据《最高人民法院关于审理著作权民事纠纷案件适用法律若干问题的解释》第十五条“由不同作者就同一题材创作的作品，作品的表达系独立完成并且有创作性的，应当认定作者各自享有独立著作权”的规定，“雷剧”与“张剧”属于由不同作者就同一题材创作的作品，两剧都有独创性，各自享有独立著作权。

B. 民间文学艺术衍生作品的表达系独立完成且有创作性的部分受著作权法保护

裁判要旨：

民间文学艺术衍生作品的表达系独立完成且有创作性的部分，符合著作权法保护的作品特征的，应当认定作者对其独创性部分享有著作权。

洪福远、邓春香与贵州五福坊食品有限公司、贵州今彩民族文化研发有限公司著作权侵权纠纷案

案号：

贵州省贵阳市中级人民法院（2015）筑知民初字第17号

案由：

著作权侵权纠纷

合议庭成员：

唐有临 | 刘永菊 | 袁博文

关键词：

著作权侵权，民间文化艺术衍生作品，独创性

相关法条：

《中华人民共和国著作权法》第三条
《中华人民共和国著作权法实施条例》第二条

基本案情：原告洪福远、邓春香诉称：原告洪福远创作完成的《和谐共生十二》作品，发表在2009年8月贵州人民出版社出版的《福远蜡染艺术》一书中。洪福远曾将该涉案作品的使用权（蜡染上使用除外）转让给原告邓春香，由邓春香维护著作财产权。被告贵州五福坊食品有限公司（以下简称五福坊公司）以促销为目的，擅自在其销售的商品上裁切性地使用了洪福远的上述画作。原告认为被告侵犯了洪福远的署名权和邓春香的著作财产权，请求法院判令：

1. 被告就侵犯著作财产权赔偿邓春香经济损失 20 万元；
2. 被告停止使用涉案图案，销毁涉案包装盒及产品册页；
3. 被告就侵犯洪福远著作人身权刊登声明赔礼道歉。

被告五福坊公司辩称：第一，原告起诉其拥有著作权的作品与贵州今彩民族文化研发有限公司（以下简称今彩公司）为五福坊公司设计的产品外包装上的部分图案，均借鉴了贵州黄平革家传统蜡染图案，被告使用今彩公司设计的产品外包装不构成侵权；第二，五福坊公司的产品外包装是委托本案第三人今彩公司设计的，五福坊公司在使用产品外包装时已尽到合理注意义务；第三，本案所涉作品在产品包装中位于右下角，整个作品面积只占产品外包装面积的二十分之一左右，对于产品销售的促进作用影响较小，原告起诉的赔偿数额 20 万元显然过高。原告的诉请没有事实和法律依据，故请求驳回原告的诉讼请求。

第三人今彩公司述称：其为五福坊公司进行广告设计、策划，2006 年 12 月创作完成“四季如意”的手绘原稿，直到 2011 年 10 月五福坊公司开发针对旅游市场的礼品，才重新截取该图案的一部分使用，图中的鸟纹、如意纹、铜鼓纹均源于贵州黄平革家蜡染的“原形”，原告作品中的鸟纹图案也源于贵州传统蜡染，原告方主张的作品不具有独创性，本案不存在侵权的事实基础，故原告的诉请不应支持。

法院经审理查明：原告洪福远从事蜡染艺术设计创作多年，先后被文化部授予“中国十大民间艺术家”“非物质文化遗产保护工作先进个人”等荣誉称号。2009 年 8 月其创作完成的《和谐共生十二》作品发表在贵州人民出版社出版的《福远蜡染艺术》一书中，该作品借鉴了传统蜡染艺术的自然纹样和几何纹样的特征，色彩以靛蓝为主，描绘了一幅花、鸟共生的和谐图景。但该作品对鸟的外形进行了补充，对鸟的眼睛、嘴巴丰富了线条，使得鸟图形更加传神，对鸟的脖子、羽毛融入了作者个人的独创，使得鸟图形更为生动，对中间的铜鼓纹花也融合了作者自己的构思而有别

于传统的蜡染艺术图案。2010 年 8 月 1 日，原告洪福远与原告邓春香签订《作品使用权转让合同》，合同约定洪福远将涉案作品的使用权（蜡染上使用除外）转让给邓春香，由邓春香维护受让权利范围内的著作财产权。

被告五福坊公司委托第三人今彩公司进行产品的品牌市场形象策划设计服务，包括进行产品包装及配套设计、产品手册以及促销宣传品的设计等。根据第三人今彩公司的设计服务，五福坊公司在其生产销售的产品贵州辣子鸡、贵州小米渣、贵州猪肉干的外包装礼盒的左上角、右下角使用了蜡染花鸟图案和如意图案边框。洪福远认为五福坊公司使用了其创作的《和谐共生十二》作品，一方面侵犯了洪福远的署名权，割裂了作者与作品的联系，另一方面侵犯了邓春香的著作财产权。经比对查明，五福坊公司生产销售的上述三种产品外包装礼盒和产品手册上使用的蜡染花鸟图案与洪福远创作的《和谐共生十二》作品，在鸟与花图形的结构造型、线条的取舍与排列上一致，只是图案的底色和线条的颜色存在差别。

裁判结果：贵州省贵阳市中级人民法院于 2015 年 9 月 18 日作出（2015）筑民初字第 17 号民事判决：

1. 被告贵州五福坊食品有限公司于本判决生效之日起 10 日赔偿原告邓春香经济损失 10 万元；
2. 被告贵州五福坊食品有限公司于本判决生效后，立即停止使用涉案《和谐共生十二》作品；
3. 被告贵州五福坊食品有限公司于本判决生效之日起 5 日内销毁涉案产品贵州辣子鸡、贵州小米渣、贵州猪肉干的包装盒及产品宣传册页；
4. 驳回原告洪福远和邓春香的其余诉讼请求。

一审宣判后，各方当事人均未上诉，判决已发生法律效力。

裁判理由：法院生效裁判认为：本案的争议焦点

- 一是本案所涉《和谐共生十二》作品是否受《中华人民共和国著作权法》保护；
- 二是案涉产品的包装图案是否侵犯原告的著作权；
- 三是如何确定本案的责任主体；
- 四是本案的侵权责任方式如何判定；
- 五是本案的赔偿数额如何确定。

关于第一个争议焦点。本案所涉原告洪福远的《和谐共生十二》画作中两只鸟尾部重合，中间采用铜鼓纹花连接而展示对称的美感，而这些正是传统蜡染艺术的自然纹样和几何纹样的主题特征，根据本案现有证据，可以认定涉案作品显然借鉴了传统蜡染艺术的表达方式，创作灵感直接来源于黄平革家蜡染背扇图案。但涉案作品对鸟的外形进行了补充，对鸟的眼睛、嘴巴丰富了线条，对鸟的脖子、羽毛融入了作者个人的独创，使得鸟图形象更为传神生动，对中间的铜鼓纹花也融合了作者的构思而有别于传统的蜡染艺术图案。根据《中华人民共和国著作权法实施条例》第二条“著作权法所称作品，是指文学、艺术和科学领域内具有独创性并能以某种有形形式复制的智力成果”的规定，本案所涉原告洪福远创作的《和谐共生十二》画作属于传统蜡染艺术作品的衍生作品，是对传统蜡染艺术作品的传承与创新，符合《中华人民共和国著作权法》保护的作品特征，在洪福远具有独创性的范围内受著作权法的保护。

关于第二个争议焦点。根据《中华人民共和国著作权法实施条例》第四条第（九）项“美术作品，是指绘画、书法、雕塑等以线条、色彩或者其他方式构成的有审美意义的平面或者立体的造型艺术作品”的规定，绘画作品主要是以线条、色彩等方式构成的有审美意义的平面造型艺术作品。经过庭审比对，本案所涉产品贵州辣子鸡等包装礼盒和产品手册中使用的花鸟图案与涉案《和谐共生十二》画作，在鸟与花图形的结构造型、线条的取舍与排列上一致，只是图案的底色和线条的颜色存在差别，就比对的效果来看图案的底色和线条的颜色差别已然成为侵权的掩饰手段而已，并非独创性的智力劳动；第三人今彩公司主张其设计、使用在五

福坊公司产品包装礼盒和产品手册中的作品创作于2006年，但其没有提交任何证据可以佐证，而洪福远的涉案作品于2009年发表在《福远蜡染艺术》一书中，且书中画作直接注明了作品创作日期为2003年，由此可以认定洪福远的涉案作品创作并发表在先。在五福坊公司生产、销售涉案产品之前，洪福远即发表了涉案《和谐共生十二》作品，五福坊公司有机会接触到原告的作品。据此，可以认定第三人今彩公司有抄袭洪福远涉案作品的故意，五福坊公司在生产、销售涉案产品包装礼盒和产品手册中部分使用原告的作品，侵犯了原告对涉案绘画美术作品的复制权。

关于第三个争议焦点。庭前准备过程中，经法院向洪福远释明是否追加今彩公司为被告参加诉讼，是否需要变更诉讼请求，原告以书面形式表示不同意追加今彩公司为被告，并认为五福坊公司与今彩公司属于另一法律关系，不宜与本案合并审理。事实上，五福坊公司与今彩公司签订了合同书，合同约定被告生产的所有产品的外包装、广告文案、宣传品等皆由今彩公司设计，合同也约定今彩公司提交的设计内容侵权行为，造成的后果由今彩公司全部承担。但五福坊公司作为产品包装的委托方，并未举证证明其已尽到了合理的注意义务，且也是侵权作品的最终使用者和实际受益者，根据《中华人民共和国著作权法》第四十八条第二款第（一）项“有下列侵权行为的，应当根据情况，承担停止侵害、消除影响、赔礼道歉、赔偿损失等民事责任……（一）未经著作权人许可，复制、发行、表演、放映、广播、汇编、通过信息网络向公众传播其作品的，本法另有规定的除外”，以及《最高人民法院关于审理著作权民事纠纷案件适用法律若干问题的解释》（以下简称《著作权纠纷案件解释》）第十九条、第二十条第二款的规定，五福坊公司依法应承担本案侵权的民事责任。五福坊公司与第三人今彩公司之间属另一法律关系，不属于本案的审理范围，当事人可另行主张解决。

关于第四个争议焦点，根据《中华人民共和国著作权法》第四十七条、第四十八

条规定，侵犯著作权或与著作权有关的权利的，应当根据案件的实际情况，承担停止侵害、消除影响、赔礼道歉、赔偿损失等民事责任。本案中，第一，原告方的部分著作人身权和财产权受到侵害，客观上产生相应的经济损失，对于原告方的第一项赔偿损失的请求，依法应当获得相应的支持；第二，无论侵权人有无过错，为防止损失的扩大，责令侵权人立即停止正在实施的侵犯他人著作权的行为，以保护权利人的合法权益，也是法律实施的目的，对于原告方第二项要求被告停止使用涉案图案，销毁涉案包装盒及产品册页的诉请，依法应予支持；第三，五福坊公司事实上并无主观故意，也没有重大过失，只是没有尽到合理的审查义务而基于法律的规定承担侵权责任，洪福远也未举证证明被告侵权行为造成其声誉的损害，故对于洪福远要求五福坊公司在《贵州都市报》综合版面刊登声明赔礼道歉的第三项诉请，不予支持。

关于第五个争议焦点，本案中，原告方并未主张为制止侵权行为所支出的合理费用，也没有举证证明为制止侵权行为所支出的任何费用。庭审中，原告方没有提交任何证据以证明其实际损失的多少，也没有提交任何证据以证明五福坊公司因侵权行为的违法所得。事实上，原告方的实际损失本身难以确定，被告方因侵权行为的违法所得也难以查清。根据《著作权纠纷案件解释》第二十五条第一款、第二款“权利人的实际损失或者侵权人的违法所得无法确定的，人民法院根据当事人的请求或者依职权适用著作权法第四十八条第二款（现为第四十九条第二款）的规定确定赔偿数额。

人民法院在确定赔偿数额时，应当考虑作品类型、合理使用费、侵权行为性质、后果等情节综合确定”的规定，结合本案的客观实际，主要考量以下5个方面对侵犯著作权赔偿数额的影响：

第一，洪福远的涉案《和谐共生十二》作品属于贵州传统蜡染艺术作品的衍生作品，著作权作品的创作是在传统蜡染艺术作品基础上的传承与创新，涉案作品中鸟图形

的轮廓与对称的美感来源于传统艺术作品，作者构思的创新有一定的限度和相对局限的空间；

第二，贵州蜡染有一定的区域特征和地理标志意义，以花、鸟、虫、鱼等为创作缘起的蜡染艺术作品在某种意义上属于贵州元素或贵州符号，五福坊公司作为贵州的本土企业，其使用贵州蜡染艺术作品符合民间文学艺术作品作为非物质文化遗产固有的民族性、区域性的基本特征要求；

第三，根据洪福远与邓春香签订的《作品使用权转让合同》，洪福远已经将其创作的涉案《和谐共生十二》作品的使用权（蜡染上使用除外）转让给邓春香，即涉案作品的大部分著作财产权转让给了传统民间艺术传承区域外的邓春香，由邓春香维护涉案作品著作权财产权，基于本案著作人身权与财产权的权利主体在传统民间艺术传承区域范围内外观分离的状况，传承区域内的企业侵权行为产生的后果与影响并不显著；

第四，洪福远几十年来执着于民族蜡染艺术的探索与追求，在创作中将传统的民族蜡染与中国古典文化有机地揉和，从而使蜡染艺术升华到一定高度，对区域文化的发展起到一定的推动作用。尽管涉案作品的大部分著作财产权已经转让给了传统民间艺术传承区域外的邓春香，但洪福远的创作价值以及其在蜡染艺术业内的声誉应得到尊重；

第五，五福坊公司涉案产品贵州辣子鸡、贵州小米渣、贵州猪肉干的生产经营规模、销售渠道等应予以参考，根据五福坊公司提交的五福坊公司与广州卓凡彩色印刷有限公司的采购合同，尽管上述证据不一定完全客观反映五福坊公司涉案产品的生产经营状况，但在原告方无任何相反证据的情形下，被告的证明主张在合理范围内应为法律所允许。

综合考量上述因素，参照贵州省当前的经济发展水平和人们的生活水平，酌情确定由五福坊公司赔偿邓春香经济损失10万元。

C. 书信手稿的性质，手稿拍卖与著作权侵权纠纷案件中的诉前行为保全

裁判要旨：

私人书信作为人类沟通感情交流思想的载体，通常是写信人独立构思并创作而成的文字作品，在无相反证据的情况下，应认定为写信人创作的作品，应受我国著作权法保护。

收信人可以取得书信手稿的物权，但行使物权时不得侵害写信人的著作权。违背著作权人及其继承人意志公开发表书信手稿构成对作品发表权的侵害。

由于侵害著作人格权的后果将导致作者人格利益与精神受到伤害，其受害状态具有不可逆转性，一般难以通过金钱赔偿等方式完全消弭。此外，发表权是著作权人行使和保护其他权利的基础，一旦作品被非法发表，极易导致权利人对复制、发行等行为难以控制。在作者反对的情况下，明确表示即将开展展览作品系对发表权的即发侵害行为，符合“如不及时制止将会给权利人造成难以弥补的损害”的行为保全条件。

杨季康与中贸圣佳国际拍卖有限公司书信手稿拍卖诉前行为保全案

案号：

北京市第二中级人民法院（2013）二中保字第09727号

案由：

著作权诉前行为保全纠纷

合议庭成员：

张剑 | 杨静 | 刘娟

关键词：

手稿，财产权，著作权，隐私权，拍卖，诉前行为保全

相关法条：

《中华人民共和国著作权法》第十条第一款第（一）项、第十九条第一款、第二十一条第一款、第五十条

《中华人民共和国著作权法实施条例》第十七条

《中华人民共和国继承法》第十条、第十一条

《中华人民共和国民事诉讼法》第一百条、第一百零一条、第一百零八条

《最高人民法院关于审理著作权民事纠纷案件适用法律若干问题的解释》第三十条第二款

基本案情：申请人杨季康（笔名杨绛，我国著名作家、翻译家）系钱钟书（已故著名作家、文学研究家）的配偶，二人育有一女钱瑗（已故）。被申请人李国强曾任《广角镜》月刊总编辑。钱钟书与李国强于1979年相识后，钱氏一家与李国强往来密切，通信频繁，钱氏家人的书信手稿一直由李国强收存。

2013年5月，被申请人中贸圣佳国际拍卖有限公司在其官方网站发布公告称，其将于6月21日拍卖“也是集——钱钟书书信手稿”，其中包括钱钟书、杨季康、钱瑗写给李国强的若干封信札、手稿作品百余件，此前还将举行预展和研讨会。随即新华网、人民网等多家媒体对此事进行了报道，宣称这将是“首次大规模曝光钱钟书手稿”，其中还刊登了中贸圣佳国际拍卖有限公司公布的少量手稿照片。经查，上述书信手稿多自李国强处取得，内容涉及私人交流、家庭琐事、个人情感以及文学历史时事评论等，均未曾公开发表。

杨季康强烈反对公开拍卖和展出手稿，经交涉未果，向北京市第二中级人民法院提出诉前停止侵害著作权行为的保全申请。经查，钱瑗、钱钟书相继于1997年、1998年病故，杨季康为二人继承人，钱瑗的另一继承人其配偶杨伟成同意杨季康的维权主张。

法院审理过程中，案外人紫光集团有限公司向法院出具了合法有效的财产担保申请和相关材料，承诺承担如因杨季康申请错误给被申请人造成的全部财产损失。

裁判结果：北京市第二中级人民法院经审理后，裁定如下：中贸圣佳国际拍卖有限公司在拍卖、预展及宣传等活动中不得以公开发表、展览、复制、发行、信息网络传播等方式实施侵害钱钟书、杨季康、钱瑗写给李国强的涉案书信手稿著作权的行为。

本裁定送达后立即执行。如不服本裁定，可在裁定书送达之日起十日内向本院申请复议一次。复议期间不停止裁定的执行。

裁判理由：北京市第二中级人民法院经审理认为：

诉前行为保全又称为诉前禁令，是指人民法院为及时制止正在实施或即将实施的侵害权利人知识产权或有侵害之虞的行为，在起诉前根据当事人申请发布的一种禁止或限制行为人从事某种行为的强制命令，其目的在于保护权利人知识产权免遭继续侵害，预防难以弥补损害的发生。

诉前行为保全需符合以下要件：

- (1) 申请人享有知识产权，被申请人正在实施或即将实施侵犯知识产权行为；
- (2) 不采取有关措施会给申请人的合法权益造成难以弥补的损害；
- (3) 申请人提供了有效担保；
- (4) 行为保全的作出不会损害公共利益。

一、书信手稿是受著作权法保护的作品

我国著作权法所称的作品，是指文学、艺术和科学领域内具有独创性并能以某种有形形式复制的智力创造成果。书信作为人类沟通感情、交流思想、洽谈事项的工具，通常是写信人独立构思并创作而成的文字作品，其内容或表现形式通常不是或不完全是对他人已发表的作品引用、抄录，即不是单纯摹仿、抄袭、篡改他人的作品。

因此，在无相反证据的情况下，书信通常具有独创性和可复制性，符合著作权法关于作品的构成要件，可以成为著作权法保护的作品，其著作权应当由作者即发信人享有。根据我国著作权法的相关规定，钱钟书、杨季康、钱瑗分别对各自创作的书信作品享有著作权。

二、申请人依据继承法享有行为保全请求权

钱钟书去世后，杨季康作为其唯一继承人，有权依法继承其著作权中的财产权，依法保护其著作权中的署名权、修改权和保护作品完整权，依法行使其著作权中的发表权。钱瑗去世后，杨季康、杨伟成作为其继承人，享有同上权利。鉴于杨伟成明确表示在本案中不主张权利，故杨季康依法有权主张相关权利。任何人包括收信人及其他合法取得书信手稿物权的人，对于书信手稿进行处分时均不得侵害作者及其继承人的著作权。

三、被申请人正在实施或即将实施侵权行为

判断作品是否已经发表的标准在于确定作品是否被公之于众，即将作品置于为不特定人所知的状态。本案中，中贸圣佳国际拍卖有限公司即将公开预展、公开拍卖涉案书信手稿，其为拍卖而正在或即将通过报刊、光盘、宣传册、计算机网络等方式复制发行涉案书信手稿的行为，将客观上使得作品被公开发表，不仅构成对发表权的侵犯，而且还构成对权利人复制权、发行权的侵犯。

四、被申请人的行为将造成“难以弥补的损害”

发表权属于著作人身权之一，是指决定作品是否公之于众以及何时、何地、以何种方式公之于众的权利。作品的发表是一次性行为，作品一旦被非法发表，将导致权利人的意志被违背。就本案而言，它意味着私人书信进入公众视野，该行为存在不可逆性，这种为公众所知悉的状态将不可逆转的、无法回复到为权利人所控制的私密状态。因此，一旦以公开拍卖等方式

非法发表他人私人书信手稿作品，将对权利人发表权难以弥补的损害。

更为重要的是，发表权不仅作为著作权中一项独立的人身权，更是著作权人行使和保护其他权利的基础。虽然不论作品是否发表，著作权人都依法享有著作权，但是作品是否已经发表对于著作权人对自身权利的保护和控制能力以及他人获取作品、使用作品的难易程度、合法性均有重大影响。一旦作品被非法发表，就如同打开了私人与公共状态之间的“开关”，只有打开这个“开关”，社会公众才有可能接触、传播、复制到涉案作品。涉案钱氏一家的书信手稿均为写给李国强的私人书信，从私人书信本身的功能和涉案书信的具体内容可以看出，写信人的本意在于向友人传递信息、沟通感情、探讨观点，而非将所写内容公之于众、为世人所品评。在杨季康强烈反对公开的情况下，擅自公开涉案书信手稿极易导致权利人其他人实施后续的复制、发行、信息网络传播等行为难以控制，极易导致连锁侵权行为，此乃给权利人造成难以弥补的损害。

此外，法院充分评估了行为保全可能带来的影响后认为，在申请人提供了有效担保的情况下，做出行为保全不会损害社会公共利益。保护作品著作权与鼓励作品传播均为法律保护的价值，然而私人书信作品与普通文字作品相比具有一定的特殊性，其承载的价值更多的是私人思想感情的表达，而非面向公众的文化传播，权利人对私人书信的控制权属于典型的私权，应得到充分尊重。禁止违背意愿的发表不仅不会对公共利益造成不良影响，反而将有助于明确书信著作权及隐私权保护规则，收信人和拍卖公司在行使物权时不得侵害作品著作权。

综上，做出诉前行为保全裁定。

D.“云音乐”平台侵害信息网络传播权诉前行为保全的审查判断

裁判要旨：

在网络环境下，被诉侵权行为如未及时予以禁止，将会使被申请人不当利用他人权利获得的市场份额进一步快速增长，损害申请人的利益，且这种损害将难以弥补。故对被申请人的被诉侵权行为应予禁止，应依法准许申请人对本案提起的诉前行为保全申请。

深圳市腾讯计算机系统有限公司与广州网易计算机系统有限公司、网易（杭州）网络有限公司、杭州网易雷火科技有限公司、中国联合网络通信有限公司湖北省分公司、广东欧珀移动通信有限公司侵害音乐作品信息网络传播权纠纷行为保全申请案

案号：

湖北省武汉市中级人民法院（2014）鄂武汉中知禁字第00005号、（2014）鄂武汉中知禁字第00005-2号

案由：

侵害音乐作品信息网络传播权纠纷

合议庭成员：

何震 | 许继学 | 陈峰

关键词：

云音乐平台，信息网络传播权，诉前行为保全

相关法条：

《中华人民共和国著作权法》第五十条
《中华人民共和国民事诉讼法》第一百条

基本案情：申请人深圳市腾讯计算机系统有限公司（以下简称腾讯公司）与被申请人广州网易计算机系统有限公司（以下简称广州网易）、网易（杭州）网络有限公司（以下简称杭州网易）、杭州网易雷火科技有限公司（下称网易雷火）、中

国联合网络通信有限公司湖北省分公司(以下简称湖北联通)、广东欧珀移动通信有限公司(以下简称广东欧珀)发生著作权争议,于2014年11月10日向湖北省武汉市中级人民法院申请诉前行为保全,腾讯公司请求:

1. 责令被申请人广州网易、被申请人杭州网易、被申请人网易雷火停止通过“网易云音乐”平台(music.163.com及其PC端、移动客户端)向公众传播申请人享有专有著作权的歌曲,这些歌曲包括《时间都去哪了》《爱的供养》《画心》等623首歌曲(见附件清单);
2. 责令被申请人湖北联通停止提供网易云音乐畅听流量包服务;
3. 责令被申请人广东欧珀停止在其OPPO品牌手机中内置网易云音乐行为。

申请人腾讯公司为前述诉前行为保全申请,向法院提交了湖北省武汉市琴台公证处(2014)鄂琴台内证字第13911、14057、15782、15783、15784、15785、15786号公证书、音乐专辑、相关网页打印件及工信部IP/ICP备案信息查询结果等证据,以证明申请人享有的涉案音乐作品(词曲作品、制品,以下通称音乐作品)著作权遭受侵权损害的事实。同时,担保人腾讯科技(深圳)有限公司广州分公司为申请人腾讯公司此次诉前行为保全申请提供了人民币300万元的银行存款进行担保。

裁判结果:对申请人腾讯公司诉前行为保全申请及提交的证据,湖北省武汉市中级人民法院依法组成合议庭进行了审查。经审查,法院依法准许申请人腾讯公司对本案提起的诉前行为保全申请,发布如下行为保全措施:

1. 被申请人广州网易计算机系统有限公司、被申请人网易(杭州)网络有限公司、被申请人杭州网易雷火科技有限公司于本裁定生效之日起立即停止通过网易云音乐平台向公众提供本裁定书附件所列623首音乐作品的行为;

2. 被申请人中国联合网络通信有限公司湖北省分公司于本裁定生效之日起立即停止向其移动手机客户提供网易云音乐畅听流量包中的涉案623首音乐作品的移动网络服务行为;
3. 被申请人广东欧珀移动通信有限公司于本裁定书生效次日起十日内停止通过其品牌为OPPO R830S型号(合约机)移动手机中内置的网易云音乐客户端向移动手机客户传播涉案623首音乐作品的行为;
4. 冻结担保人腾讯科技(深圳)有限公司广州分公司在招商银行广州分行环市东路支行(广州)开立的银行账号为2005xxxxxxx0001账户内的银行存款人民币300万元;
5. 驳回申请人广州网易计算机系统有限公司提出的其他行为保全申请;
6. 申请人腾讯公司应当在本裁定书生效后三十日内起诉,逾期不起诉的,将解除本裁定指定的行为保全措施。

禁止令发布后,被申请人湖北联通及被申请人广东欧珀立即停止了被诉行为,表示积极履行法院禁令义务。被申请人广州网易、杭州网易、网易雷火不服该行为保全,向湖北省武汉市中级人民法院提出复议申请。湖北省武汉市中级人民法院于2014年12月3日以开庭听证方式审查了三复议申请人的复议申请,认为复议申请人提出的复议理由均不能成立,裁定驳回复议申请人广州网易计算机系统有限公司、网易(杭州)网络有限公司、杭州网易雷火科技有限公司的复议申请。

复议中,申请人腾讯公司发现被诉行为仍在继续,向湖北省武汉市中级人民法院提交了违反行为保全应予处罚的书面申请。法院在听证中对申请人提出的触犯申请也进行了听证,并作出相应的处罚措施。至复议决定书发出后,被诉行为已经按照行为保全要求全面停止。

裁判理由:湖北省武汉市中级人民法院经审查认为:

1. 根据申请人腾讯公司提交的音乐版权授权合同、涉案音乐专辑等版权文件,

- 申请人腾讯公司依法享有本裁定书附件所列包括《绿色玫瑰》在内 623 首音乐作品的信息网络传播权。
2. 根据湖北省武汉市琴台公证处向申请人腾讯公司提交的编号为 (2014) 鄂琴台内证字第 14057 号公证书显示内容, 被申请人广州网易、杭州网易、网易雷火共同运营由广州网易主办的涉案网易云音乐平台 (网址: music.163.com), 并通过网易云音乐平台向公众提供本裁定书附件所列 623 首音乐作品。三被申请人的行为涉嫌侵犯申请人腾讯公司依法享有的附件所列 623 首音乐作品的信息网络传播权。
 3. 根据申请人腾讯公司提交的湖北省武汉市琴台公证处 (2014) 鄂琴台内证字第 13911 号公证书载明内容, 可以确认被申请人湖北联通与涉案网易云音乐平台合作, 并以网易云音乐畅听流量包的模式, 向其移动手机客户传播申请人腾讯公司附件所列 623 首音乐作品。被申请人湖北联通的上述行为涉嫌侵犯申请人涉案音乐作品信息网络传播权。
 4. 根据申请人腾讯公司提交的湖北省武汉市琴台公证处 (2014) 鄂琴台内证字第 13911 号公证书载明内容, 被申请人广东欧珀在生产销售的涉案 OPPOR830S 型号 (合约机) 的手机中内置有可以接入网易云音乐平台的移动手机客户端, 并通过移动手机内置客户端方式, 定向获取来源于网易云音乐平台提供的附件所列 623 首音乐作品。该行为涉嫌侵犯申请人腾讯公司享有的附件所列 623 首音乐作品的信息网络传播权。
 5. 申请人腾讯公司提交的名称为网易科技的相关网页打印件载明的内容如下: (1) 被申请人广州网易、杭州网易法定代表人声称, BAT 大家的模式不同, 阿里和百度还是流量模式, 网易是内容供应商。三小虎 (京东、小米和奇虎 360) 利润加起来还没有网易多。(2) 2014 年 8 月 18 日网易科技网页显示: 网易云音乐用户四千万; 网易云音乐内热门歌单《入耳便爱上的英文歌》短短一周的播放量就增加了 17 万次。

6. 担保人腾讯科技 (深圳) 有限公司广州分公司提供的担保资产经查证属实, 法院依法对担保人提供的银行存款 300 万元 (人民币) 予以冻结。

综上, 申请人腾讯公司对本裁定附件所列 623 首音乐作品依法享有信息网络传播权。五被申请人以互联网络、移动手机网易云音乐畅听流量包、内置网易云音乐移动手机客户端等方式, 向公众大量提供涉案音乐作品。该行为涉嫌侵犯申请人腾讯公司对这些音乐作品依法享有的信息网络传播权, 且被申请人向公众提供的音乐作品数量较大, 造成了申请人腾讯公司巨大的经济损失。法院考虑到, 在网络环境下, 该行为如不及时予以禁止, 将会使被申请人广州网易不当利用他人权利获得的市场份额进一步快速增长, 损害申请人腾讯公司的利益, 且这种损害将难以弥补。故对各被申请人通过网络传播本裁定附件所列 623 首音乐作品涉嫌侵权部分的行为理应禁止。担保人为申请人腾讯公司提出的行为保全申请进行担保, 经查证属实, 行为保全申请的担保程序合法。

湖北省武汉市中级人民法院经复议认为:

1. 法院经初步核查, 腾讯公司提交了著作权授权书、音乐制品专辑、歌单等权利证据可以证明申请人是涉案音乐作品的独家信息网络传播权人。法院考虑到“网易云音乐”平台的网络传播属性, 依据“网易云音乐”平台迅速发展的初步证据, 认定不采取行为保全措施可能给申请人腾讯公司造成不可挽回的损失并无不妥。
2. 行为保全申请人腾讯公司针对被申请人湖北联通通过“网易云音乐畅听流量包”这一移动网络服务项目, 向其移动用户提供涉案 623 首音乐作品的行为涉嫌侵害腾讯公司享有的信息网络传播权提出行为保全申请, 该项申请与针对复议申请人的行为保全申请相互关联。
3. 三复议申请人除提交由网易雷火出具的关于该平台由网易雷火单独运营管理的书面陈词外, 没有提交其他证据推翻行为保全对“网易云音乐”

平台由三方复议申请人合作运营的认定。行为保全依据“网易云音乐”平台所使用的网络域名、网络经营许可证、“网易科技”宣称的杭州网易是涉案“网易云音乐”平台软件的开发者及“网易云音乐”网站题头、网站版权声明信息等证据，初步认定“网易云音乐”平台系由广州网易、杭州网易、网易雷火三方合作运营并无不当。

4. 听证中，经复议申请人和复议被申请人演示，在“网易云音乐”平台提供的页面尾部，直接点击链接代码可以播放涉案音乐作品，但通过复议申请人提供的域名地址进行网络连接并不能获得涉案音乐作品。同时，三复议申请人没有提交证据证明“网易云音乐”平台属于单纯提供网络链接技术及涉案音乐作品已获得合法授权。
5. 本案行为保全所附被禁歌曲清单第216号与第217号并非重复列明，而是两首不同表演的同名音乐作品。行为保全清单中的其他作品均经核查属实。根据“网易云音乐”平台传播的涉案作品信息，法院有理由确认这些音乐制品与腾讯公司主张行为保全的权利作品为同一作品，无需进行音源比对。

E. 行为保全的实体审查要件、网游侵权案件中难以弥补损害的认定、游戏整体下线及玩家利益的保护

裁判要旨：

诉中行为保全应当审查原告胜诉可能性及原告是否受到难以弥补的损害。

被诉游戏的上线势必挤占原告新推游戏的市场份额。而且网络游戏具有生命周期短，传播速度快、范围广的特点，给原告造成的损害难以计算和量化。被诉游戏采用低俗营销方式也会给原告商誉带来损害。

被诉游戏重要组成部分均构成侵权，其余部分也存在较大侵权可能性，故应整体下线。但禁令期间不影响为被诉游戏玩家提供余额查询及退费等服务。

暴雪娱乐有限公司等与成都七游科技有限公司等著作权侵权及不正当竞争纠纷诉中行为保全案

案号：

广州知识产权法院（2015）粤知法著民初字第2-1号、（2015）粤知法商民初字第2-1号

案由：

著作权侵权及不正当竞争纠纷

合议庭成员：

龚麒天 | 庄毅 | 彭盎

关键词：

网络游戏，诉中行为保全，难以弥补损害

相关法条：

《中华人民共和国著作权法》第五十条
《中华人民共和国民事诉讼法》第一百条

基本案情：在原告暴雪娱乐有限公司（以下简称暴雪娱乐）、原告上海网之易网络科技发展有限公司（以下简称网之易公司）诉被告成都七游科技有限公司（以下简称

七游公司)、被告北京分播时代网络科技有限公司(以下简称分播时代)、被告广州市动景计算机科技有限公司(以下简称动景公司)著作权侵权及不正当竞争纠纷诉中行保全案中,原告暴雪娱乐是《魔兽世界》(2004年11月23日美国首次发行)、《魔兽世界:燃烧的远征》(2007年1月16日美国首次发行)、《魔兽世界:巫妖王之怒》(2008年11月13日美国首次发表)、《魔兽世界:熊猫人之谜》(2012年9月25日美国首次发表)等计算机软件作品的著作权人。

《魔兽世界》系列游戏在国内获得诸多重要游戏奖项,如被中国游戏产业年会评为2006年度、2007年度十大最受欢迎的网络游戏;在2011年首届中国游戏金流熊奖评选中,被评为十大人气网络游戏;在2012年度中国游戏英雄榜颁奖典礼上,被评为年度最佳网络游戏。

2014年6月起,原告暴雪娱乐通过中文官网为《魔兽世界:德拉诺之王》游戏造势。11月20日该游戏在中国正式上线运营,由原告网之易公司独家运营。

《魔兽世界》系列游戏中的英雄有维纶、伊利丹·怒风、加尔鲁什·地狱咆哮、萨尔等。怪兽有阿库麦尔、变异蹒跚者等。这些英雄和怪兽形象在原告暴雪娱乐中文官网、英文出版物《魔兽世界终极视觉宝典》、中文出版物《暴雪的艺术》及《魔兽世界·萨尔:巨龙的黄昏》中都可看到。上述网站及出版物均标明原告暴雪娱乐是著作权人。本两案中,原告主张其中18个英雄和7个怪兽形象美术作品的著作权。原告还主张“魔兽”“德拉诺”构成知名商品的特有名称,“萨尔”构成知名角色名称,4个游戏场景(包括标题界面、登陆界面和创建角色界面)构成知名商品的特有装潢。

被诉游戏原名《酋长萨尔:魔兽远征》,由被告七游公司开发。被告分播时代是被告七游公司股东,也是被诉游戏独家运营商。2014年8月25日,被告分播时代在官网(www.rekoo.com)发布被诉

游戏苹果版本公测,9月19日发布安卓版本公测,12月19日将该游戏更名为《全民魔兽:决战德拉诺》。被告动景公司经被告分播时代授权,在官网(www.9game.cn)向公众提供被诉游戏安卓版本下载。

将被诉游戏相关英雄和怪兽形象与原告主张的英雄和怪兽形象进行比较,两者构成实质相似。

关于被诉游戏的宣传和介绍,被告分播时代官网有以下表述:“为了更完美的还原魔兽世界,《酋长萨尔》……无论是玩家操控的英雄还是副本中的小怪,不论是地图设计还是技能特效,都几乎100%还原了魔兽中的形象。……魔兽高玩林熊猫将在家中接受‘美女上门服务’这一终极挑战。”“《全民魔兽》是一款以魔兽世界为背景的PRG卡牌游戏……作为借顺风车的一款作品,完美呈现了《魔兽世界》的很多内容,其中剧情、英雄、场景都可以瞬间点燃粉丝们的激情。”

在该被告官方微博有玩家评论:“最爱魔兽世界这么有挑战的游戏哦。……我们一起玩魔兽世界吧。”

原告认为,被诉游戏抄袭了原告游戏中的英雄和怪兽形象,使用了与原告游戏相似的名称、装潢。被告分播时代在宣传中反复声称被诉游戏是魔兽手游。三被告的行为共同侵犯了原告的著作权并构成不正当竞争。如果侵权行为持续,将会给原告造成难以弥补的损失。原告遂向广州知识产权法院起诉并同时申请行为保全,要求被诉游戏整体下线,其愿意提交1000万元现金担保。三被告则认为,被诉游戏软件登记在案外人名下,原告不能证明是涉案英雄和怪兽形象的著作权人,不能证明被告构成著作权侵权及不正当竞争,也不能证明受到难以弥补的损害,且采取行为保全措施将严重损害被告和游戏玩家利益,故请求驳回原告行为保全申请。

裁判结果:广州知识产权法院于2015年3月9日作出行为保全裁定:

1. 禁止被告七游公司复制、发行及通过信息网络传播《全民魔兽：决战德拉诺》（原名《酋长萨尔：魔兽远征》）游戏，效力维持至本两案判决生效日止；
2. 禁止被告分播时代复制、发行、通过信息网络传播《全民魔兽：决战德拉诺》（原名《酋长萨尔：魔兽远征》）游戏和实施涉案不正当竞争行为，效力维持至本两案判决生效日止，行为保全期间不影响为该游戏玩家提供余额查询及退费等服务；
3. 禁止被告动景公司通过其官网（www.9game.cn）传播《全民魔兽：决战德拉诺》（原名《酋长萨尔：魔兽远征》）游戏，效力维持至本两案判决生效日止，行为保全期间不影响为该游戏玩家提供余额查询及退费等服务；
4. 驳回原告暴雪娱乐、原告网之易公司其他行为保全申请。

裁判理由：广州知识产权法院认为：

一、关于行为保全的实体审查要件

根据《中华人民共和国民事诉讼法》第一百条的规定，人民法院对于可能因当事人一方的行为，使判决难以执行或者造成当事人其他损害的案件，根据对方当事人的申请，可以裁定禁止其作出一定行为。据此，法院决定是否颁发禁令，应当首先审查原告胜诉可能性。根据《中华人民共和国民事诉讼法》第一百零一条的规定，如果情况紧急，不立即采取行为保全将会使权利人受到难以弥补损害的，权利人可以申请诉前行为保全。由于原告是在起诉同时申请行为保全，并主张情况紧急，故还需对被诉侵权行为是否使原告受到难以弥补损害进行审查。

二、关于原告胜诉可能性

我国及美国均为《保护文学和艺术作品伯尔尼公约》成员国，根据该公约及《中华人民共和国著作权法》第二条的规定，原告暴雪娱乐的作品受我国著作权法的保护。原告暴雪娱乐是《魔兽世界》系列游戏计算机软件作品的著作权人。据此，并结合

原告暴雪娱乐官网及涉案合法出版物对《魔兽世界》英雄和怪兽介绍时的版权标记，足以证明其所主张的 18 个英雄和 7 个怪兽形象美术作品享有著作权。被告未经原告许可，在被告游戏中使用这些英雄和怪兽形象，侵犯了原告美术作品的复制、发行及信息网络传播等权利。同时，原告《魔兽世界》系列游戏在中国具有很高的市场知名度。故原告《魔兽世界：德拉诺之王》游戏构成知名游戏。又由于“魔兽”被相关公众视为《魔兽世界》的简称，“德拉诺”是《魔兽世界》虚构的地名，具有了区别商品来源的显著特征，故《魔兽世界：德拉诺之王》构成知名游戏特有名称。被告在原告《魔兽世界：德拉诺之王》游戏上线前后推出相似名称的游戏《全民魔兽：决战德拉诺》（原名《酋长萨尔：魔兽远征》），主观上具有搭原告游戏知名度便车的故意，客观上容易导致相关公众的混淆，构成擅自使用他人知名商品特有名称的不正当竞争行为。另外，被告分播时代在宣传被告游戏时多次提及魔兽世界，容易使相关公众误认该游戏是原告开发或与原告有授权许可等关系的手机游戏，构成虚假宣传。被告七游公司是被告游戏的开发商，被告分播时代是独家运营商且是被告七游公司的股东，被告动景公司经被告分播时代授权向公众提供被告游戏的下载服务，故原告主张三被告构成共同侵权，具有充分依据。在原告胜诉可能性高的情况下，被告关于如果原告败诉将会给其及玩家带来巨大损害的抗辩，明显缺乏说服力。另外，三被告共同实施了侵权行为，故被告游戏软件是否登记在案外人名下，并不影响本案禁令是否颁发。

三、关于原告是否受到难以弥补的损害

被告游戏是在原告《魔兽世界：德拉诺之王》游戏上线前后推出。虽然两者分属手机端和 PC 端的游戏，但两者都是网络游戏，且游戏名称相似，游戏中相关英雄和怪兽形象和名称相似，相关游戏界面相似，都采用玩家扮演英雄与怪兽作战的玩法。故两者是具有较强竞争关系的产品。被告游戏的上线势必挤占原告新推游戏的市场份额。而且网络游戏具有生命周期短，传播

速度快、范围广的特点，给原告造成的损害难以计算和量化。另外，被告分播时代在宣传被诉游戏时采用了低俗营销方式，在相关公众将被诉游戏与原告游戏混淆的情况下，会使相关公众对原告产生负面评价，从而给原告商誉带来损害。

四、关于被诉游戏应否整体下线及玩家利益的保护

被告虽提出相关英雄和怪物形象可以修改，但听证后提交的修改方案仍然与原告主张的内容构成实质相似。另根据被诉游戏的名称、相关英雄和怪兽形象等重要组成部分均构成侵权，以及被诉游戏宣传100%还原魔兽形象等事实，该游戏其余英雄或怪兽形象也存在较大的侵权可能性。据此，原告要求被诉游戏整体下线，依据充分，应予支持。但行为保全期间不影响为被诉游戏玩家提供余额查询及退费等服务。

F. 思想与表达的划分、涉文学作品侵害改编权的判定思路

裁判要旨：

著作权的客体是作品，但并非作品中的任何要素都受到著作权法的保护，思想与表达二分法是区分作品中受保护的要素和不受保护的要素的基本原则，其内涵是著作权法保护思想的表达而不保护思想本身。

文学作品的表达既不能仅仅局限为对白台词、修辞造句，也不能将文学作品中的主题、题材、普通人物关系认定为著作权法保护的表达。文学作品中，情节的前后衔接、逻辑顺序将全部情节紧密贯穿为完整的个性化表达，这种足够具体的人物设置、情节结构、内在逻辑关系的有机结合体可以成为著作权法保护的表达。

改编权即改变作品，创作出具有独创性的新作品的权利。改编权所直接控制的行为是改编行为，即改变作品，创作出具有独创性的新作品的行为，新作品应当保留原作品的基本表达，否则仅仅根据原作品的思想创作出来的新作品不受改编权的控制。

判断被诉行为是否侵犯权利人的改编权，通常需要满足接触和实质性相似两个要件。接触是指被诉侵权人有机会接触到、了解到或者感受到权利人享有著作权的作品。接触可以是一种推定。实质性相似的认定可以采用抽象分离法或整体观感法。判断文学作品是否构成实质性相似，根据案件具体情况，可以将两种方法结合使用，同时需要排除合理借鉴的情形。

陈喆（笔名：琼瑶）与余征（笔名：于正）等侵害著作权纠纷案

案号：

北京市高级人民法院（2015）高民（知）终字第1039号

案由：

侵害著作权纠纷

合议庭成员：

谢甄珂|袁相军|钟鸣|元雷(法官助理)

关键词：

思想，接触，表达，实质性相似

相关法条：

《中华人民共和国著作权法》第十条第一款第(十四)项、第十二条、第四十七条第(六)项

基本案情：原告琼瑶是台湾著名编剧。被告于正是大陆知名编剧。原告琼瑶主张的剧本《梅花烙》于1992年10月创作完成，未以纸质方式公开发表。小说《梅花烙》系根据剧本《梅花烙》改编而来，于1993年6月30日创作完成，1993年9月15日起在台湾地区公开发行，同年在中国大陆公开发表，小说《梅花烙》作者是本案原告琼瑶。

电视剧《梅花烙》于1993年10月13日起在我国台湾地区首次电视播出，并于1994年4月13日起在中国大陆地区首次电视播出，电视剧《梅花烙》内容与剧本《梅花烙》高度一致。电视剧《梅花烙》片头字幕显示署名编剧为林久愉，林久愉于2014年6月20日出具经公证认证的《声明书》，称其仅负责记录原告的创作讲述，执行剧本的文字统稿整理工作，剧本《梅花烙》系由原告琼瑶独立原创形成。

被告于正系剧本《宫锁连城》载明的作者，系电视剧《宫锁连城》的署名编剧。剧本《宫锁连城》创作完成时间为2012年7月17日，首次发表时间为2014年4月8日。电视剧《宫锁连城》根据剧本《宫锁连城》拍摄，剧情内容与剧本《宫锁连城》基本一致，于2014年4月8日在湖南卫视首播，片尾出品公司依次署名为：湖南经视公司、东阳欢娱公司、万达公司、东阳星瑞公司。

剧本《宫锁连城》、电视剧《宫锁连城》在人物设置及人物关系、情节上与原告涉案作品均存在对应关系。剧本《宫锁连城》相对于原告涉案作品在整体上的情节排布及推演过程基本一致。原告琼瑶起诉至北京市第三中级人民法院，认为剧本《宫锁

连城》侵害了其对《梅花烙》小说和剧本的改编权，电视剧《宫锁连城》的拍摄侵害了其摄制权，要求停止侵权、赔礼道歉和赔偿损失。

裁判结果：

北京市第三中级人民法院于2014年12月25日作出(2014)三中民初字第07916号民事判决，判决：

1. 湖南经视公司、东阳欢娱公司、万达公司、东阳星瑞公司于判决生效之日起立即停止电视剧《宫锁连城》的复制、发行和传播行为；
2. 余征于判决生效之日起十日内在新浪网、搜狐网、乐视网、凤凰网显著位置刊登致歉声明，向陈喆公开赔礼道歉，消除影响（致歉声明的内容须于判决生效后五日内送法院审核，逾期不履行，法院将在《法制日报》上刊登判决主要内容，所需费用由余征承担）；
3. 余征、湖南经视公司、东阳欢娱公司、万达公司、东阳星瑞公司于判决生效之日起十日内连带赔偿陈喆经济损失及诉讼合理开支共计人民币5,000,000元；
4. 驳回陈喆的其他诉讼请求。

后余征等被告不服，向北京市高级人民法院提起上诉，北京市高级人民法院判决：驳回上诉，维持原判。

裁判理由：北京市高级人民法院认为：

一、《中华人民共和国著作权法》保护的文学作品的表达

思想与表达二分法是区分作品中受保护的要素和不受保护的要素的基本原则，其内涵是著作权法保护思想的表达而不保护思想本身。若被诉侵权作品与权利人的作品构成实质性相似，应当是表达构成实质性相似。表达不仅指文字、色彩、线条等符号的最终形式，当作品的内容被用于体现作者的思想、情感时，内容也属于受著作权法保护的表达，但创意、素材或公有领域的信息、创作形式、必要场景和唯一或有限表达则被排除在著作权法的保护范围

之外。剧本和小说均属于文学作品，文学作品中思想与表达界限的划分较为复杂。文学作品的表达既不能仅仅局限为对白台词、修辞造句，也不能将文学作品中的主题、题材、普通人物关系认定为著作权法保护的表达。文学作品的表达，不仅表现为文字性的表达，也包括文字所表述的故事内容，但人物设置及其相互的关系，以及由具体事件的发生、发展和先后顺序等构成的情节，只有具体到一定程度，即文学作品的情节选择、结构安排、情节推进设计反映出作者独特的选择、判断、取舍，才能成为著作权法保护的表达。

文学作品中，情节的前后衔接、逻辑顺序将全部情节紧密贯穿为完整的个性化表达，这种足够具体的人物设置、情节结构、内在逻辑关系的有机结合体可以成为著作权法保护的表达。

二、侵害改编权的认定思路

《中华人民共和国著作权法》第十条第一款第（十四）项规定，改编权即改变作品，创作出具有独创性的新作品的权利。根据上述规定，改编权所直接控制的行为是改编行为，即改变作品，创作出具有独创性的新作品的行为，新作品应当保留原作品的基本表达，否则仅仅根据原作品的思想创作出来的新作品不受改编权的控制。除法律另有规定外，未经许可利用他人的原作品实施改编行为，构成对原作品著作权人改编权的侵犯。判断被诉行为是否侵犯权利人的改编权，通常需要满足接触和实质性相似两个要件。

接触是指被诉侵权人有机会接触到、了解到或者感受到权利人享有著作权的作品。接触可以是一种推定。权利人的作品通过刊登、展览、广播、表演、放映等方式公开，也可以视为将作品公之于众进行了发表，被诉侵权人依据社会通常情况具有获知权利人作品的机会和可能，可以被推定为接触。电视剧《梅花烙》的公开播放可以视为剧本《梅花烙》的发表，并可据此推定余征、湖南经视公司、东阳欢娱公司、万达公司、东阳星瑞公司接触了剧本《梅花烙》。

著作权法保护思想的表达而不保护思想本身。若被诉侵权作品与权利人的作品构成实质性相似，应当是表达构成实质性相似。表达不仅指文字、色彩、线条等符号的最终形式，当作品的内容被用于体现作者的思想、情感时，内容也属于受著作权法保护的表达，但创意、素材或公有领域的信息、创作形式、必要场景和唯一或有限表达则被排除在著作权法的保护范围之外。判断是否构成实质性相似时，需首先判断权利人主张的作品要素是否属于著作权法保护的表达。

剧本和小说均属于文学作品，文学作品中思想与表达界限的划分较为复杂。文学作品的表达既不能仅仅局限为对白台词、修辞造句，也不能将文学作品中的主题、题材、普通人物关系认定为著作权法保护的表达。文学作品的表达，不仅表现为文字性的表达，也包括文字所表述的故事内容，但人物设置及其相互的关系，以及由具体事件的发生、发展和先后顺序等构成的情节，只有具体到一定程度，即文学作品的情节选择、结构安排、情节推进设计反映出作者独特的选择、判断、取舍，才能成为著作权法保护的表达。确定文学作品保护的表达是不断抽象过滤的过程。对于人物关系和人物设置，应对人物与情节的相互结合互动形成的表达进行比对。如果事件次序和人物互动均来源于在先权利作品，则构成实质性相似。文学作品中，情节的前后衔接、逻辑顺序将全部情节紧密贯穿为完整的个性化表达，这种足够具体的人物设置、情节结构、内在逻辑关系的有机结合体可以成为著作权法保护的表达。如果被诉侵权作品中包含足够具体的表达，且这种紧密贯穿的情节设置在被诉侵权作品中达到一定数量、比例，可以认定为构成实质性相似；或者被诉侵权作品中包含的紧密贯穿的情节设置已经占到了权利作品足够的比例，即使其在被诉侵权作品中所占比例不大，也足以使受众感知到来源于特定作品时，可以认定为构成实质性相似。

此外，需要明确的是，即使作品中的部分具体情节属于公共领域或者有限、唯一的表达，但是并不代表上述具体情节

与其他情节的有机联合整体不具有独创性，不构成著作权法保护的表达。部分情节不构成实质性相似，并不代表整体不构成实质性相似。

本案中，原告琼瑶主张的 21 个情节中，其中 9 个情节构成著作权法保护的表达，剧本《宫锁连城》与上述 9 个情节构成实质性相似；原告琼瑶主张的人物设置及其相互关系，剧本《宫锁连城》与之构成实质性相似；剧本《宫锁连城》与涉案作品在整体上仍然构成实质性相似。

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第四章

垄断、竞争案件

A. 知名商品特有包装装潢权益归属的确定

裁判要旨：

《中华人民共和国反不正当竞争法》第五条第（二）项规定的“知名商品”和“特有包装装潢”之间具有互为表里、不可割裂的关系，只有使用了特有包装装潢的商品，才能够成为反不正当竞争法调整的对象。抽象的商品名称或无确定内涵的商品概念，脱离于包装装潢所依附的具体商品，缺乏可供评价的实际使用行为，不具有依据《中华人民共和国反不正当竞争法》第五条第（二）项规定进行评价的意义。

在确定特有包装装潢的权益归属时，既要在遵循诚实信用原则的前提下鼓励诚实劳动，也应当尊重消费者基于包装装潢本身具有的显著特征而客观形成的对商品来源指向关系的认知。

广药集团与加多宝公司等擅自使用知名商品特有包装装潢纠纷案

案号：

最高人民法院（2015）民三终字第2号、（2015）民三终字第3号

案由：

擅自使用知名商品特有包装装潢纠纷

合议庭成员：

宋晓明 | 夏君丽 | 周翔 | 钱小红 | 佟姝

关键词：

不正当竞争，知名商品，特有包装装潢，权益归属

相关法条：

《中华人民共和国反不正当竞争法》第五条第（二）项

基本案情：2012年7月6日，广州医药集团有限公司广药集团（以下简称广药集团）与广东加多宝饮料食品有限公司（以下简称加多宝公司）于同日分别向法院提起诉讼，均主张享有“红罐王老吉凉茶”知名商品特有包装装潢的权益，并据此诉指对方生产销售的红罐凉茶商品的包装装潢构成侵权。

具体而言，作为“王老吉”注册商标的权利人，广药集团认为，因“王老吉”商标是包装装潢不可分割的组成部分，并发挥了指示商品来源的显著识别作用，消费者当然会认为红罐王老吉凉茶来源于“王老吉”商标的权利人，而配方、口味并不会影响消费者对商品的识别和判断。作为红罐王老吉凉茶曾经的实际经营者，加多宝公司认为，包装装潢权益与“王老吉”商标权的归属问题各自独立，互不影响。消费者喜爱的是由加多宝公司生产并选用特定配方的红罐王老吉凉茶，本案包装装潢由加多宝公司使用并与前述商品紧密结合，包装装潢的相关权益应归属于加多宝公司。

裁判结果：广东省高级人民法院一审认为，“红罐王老吉凉茶”包装装潢的权益享有者应为广药集团，广州王老吉健康产业有限公司（以下简称大健康公司）经广药集团授权生产销售的红罐凉茶不构成侵权。由于加多宝公司不享有涉案包装装潢权益，故其生产销售的一面“王老吉”、一面“加多宝”和两面“加多宝”的红罐凉茶均构成侵权。一审法院遂判令加多宝公司停止侵权行为，刊登声明消除影响，并赔偿广药集团经济损失1.5亿元及合理维权费用26万余元。

加多宝公司不服两案一审判决，向最高人民法院提起上诉。最高人民法院于2017年7月7日二审判决对广药集团及加多宝公司的诉讼请求均予以驳回。

裁判理由：法院生效裁判认为，包装装潢具有显著识别特征，并用于具有一定知名度的商品之上，是与包装装潢有关的商业标识性权益获得反不正当竞争法保护的必要条件。在适用《中华人民共和国反不正当竞争法》第五条第（二）项的规定时，应对“特有包装装潢”与“知名商品”之间的关系作出正确理解，即二者具有互为表里、不可割裂的关系。只有使用了特有包装装潢的商品，才能够成为反不正当竞争法评述的对象。相反，抽象的商品名称，或无确定内涵的商品概念，脱离于包装装潢所依附的具体商品，缺乏可供评价的实际使用行为，不具有依据《中华人民共和国反不正当竞争法》第五条第（二）项规定进行评价的意义。

“王老吉凉茶”作为一种商品名称，在双方纠纷发生之时，至少可以指代由广药集团生产的绿色纸盒或加多宝公司生产的红色罐装等不同包装装潢形式的凉茶商品。而本案界定“知名商品”的目的，是为了判断附着于其上的、特定的包装装潢形式，是否符合反不正当竞争法对商业标识性权益提供保护的必要条件。因此，该“知名商品”应当与涉案包装装潢形式具有明确的指向关系。一审法院脱离了商品与包装装潢所应具有的依附关系，将指代并不唯一的商品名称“王老吉凉茶”认定为本案的“知名商品”，缺乏事实与法律依据，对此予以纠正。

本案所涉知名商品特有包装装潢纠纷的产生，源于双方在签订和履行商标许可使用合同的过程中，并未对可能产生于许可使用期间的衍生利益如何进行分割作出明确的约定。通常情况下，在商标许可使用关系终止后，被许可人应停止使用行为，被许可使用商标之上所积累的高誉，应同时归还于许可人。但本案纠纷发生的特殊之处在于，许可使用期间形成的特有包装装潢，既与被许可商标的使用存在密切联系，又因其具备反不正当竞争法下独立权益的属性，而产生了外溢于商标权之外的高誉特征。双方各自提出的权利主张，既涉及与商业标识性权益保护有关的一般性法律适用问题，也体现了本案所特有的包装装潢权益在形成过程中所包含的复杂历史和现实因素。

注册商标制度与知名商品特有包装装潢权益保护制度虽然均属于对商业标识性权益提供保护的法律制度，但二者的权利来源和保护条件有所不同。注册商标与包装装潢可以各自发挥其独立的识别作用，并分属于不同的权利主体。红罐王老吉凉茶推出市场后，经过加多宝公司及其关联企业有效的营销活动，红罐王老吉凉茶使用的包装装潢因其知名度和独特性，已经形成了独立的商业标识性权益。但本案的特殊之处在于，作为涉案包装装潢实际经营者的加多宝公司，在设计、使用及宣传推广的过程中，始终将作为广药集团注册商标的“王老吉”文字在包装装潢中进行了突出使用，且从未着意阻断和清晰区分包装装潢与其中包含的注册商标之间的关系，客观上使包装装潢同时指向了加多宝公司与广药集团。消费者亦不会刻意区分法律意义上的商标权与知名商品特有包装装潢权益，而会自然地将红罐王老吉凉茶与广药集团、加多宝公司同时建立联系。实际上，涉案包装装潢中确实也同时蕴含了广药集团“王老吉”品牌的影响力，以及加多宝公司通过十余年的生产经营和宣传推广而形成、发展而来的商品知名度和包装装潢的显著识别效果。综合考虑上述因素，结合红罐王老吉凉茶的历史发展过程、双方的合作背景、消费者的认知及公平原则的考量，因广药集团及其前身、加多宝公司及其关联企业，均对涉案包装装潢权益的形成、发展和高誉建树，各自发挥了积极的作用，将涉案包装装潢权益完全判归一方所有，均会导致显失公平的结果，并可能损及社会公众利益。因此，涉案知名商品特有包装装潢权益，在遵循诚实信用原则和尊重消费者认知并不损害他人合法权益的前提下，可由广药集团与加多宝公司共同享有。

B. 互联网领域相关市场界定及滥用市场支配地位行为的分析方法

裁判要旨：

在反垄断案件的审理中，界定相关市场通常是重要的分析步骤。但是，能否明确界定相关市场取决于案件具体情况。在滥用市场支配地位的案件中，界定相关市场是评估经营者的市场力量及被诉垄断行为对竞争影响的工具，其本身并非目的。如果通过排除或者妨碍竞争的直接证据，能够对经营者的市场地位及被诉垄断行为的市场影响进行评估，则不需要在每一个滥用市场支配地位的案件中，都明确而清楚地界定相关市场。

假定垄断者测试（HMT）是普遍适用的界定相关市场的分析思路。在实际运用时，假定垄断者测试可以通过价格上涨（SSNIP）或质量下降（SSNDQ）等方法进行。互联网即时通信服务的免费特征使用户具有较高的价格敏感度，采用价格上涨的测试方法将导致相关市场界定过宽，应当采用质量下降的假定垄断者测试进行定性分析。

基于互联网即时通信服务低成本、高覆盖的特点，在界定其相关地域市场时，应当根据多数需求者选择商品的实际区域、法律法规的规定、境外竞争者的现状及进入相关地域市场的及时性等因素，进行综合评估。

在互联网领域中，市场份额只是判断市场支配地位的一项比较粗糙且可能具有误导性的指标，其在认定市场支配力方面的地位和作用必须根据案件具体情况确定。

奇虎公司与腾讯公司滥用市场支配地位纠纷案

案号：

最高人民法院（2013）民三终字第4号

案由：

滥用市场支配地位纠纷

合议庭成员：

王闯 | 王艳芳 | 朱理

关键词：

垄断，滥用市场支配地位，相关市场，市场份额

相关法条：

《中华人民共和国反垄断法》第十七条、第十八条、第十九条

基本案情：此案由奇虎公司诉至广东省高级人民法院，指控腾讯公司滥用其在即时通信软件及服务相关市场的市场支配地位。2010年11月3日，腾讯公司发布《致广大QQ用户的一封信》，在装有360软件的电脑上停止运行QQ软件。11月4日，360安全中心宣布，在国家有关部门的强力干预下，目前QQ和360软件已经实现了完全兼容。2010年9月，腾讯QQ即时通信软件与QQ软件管理一起打包安装，安装过程中并未提示用户将同时安装QQ软件管理。2010年9月21日，腾讯公司发出公告称，正在使用的QQ软件管理和QQ医生将自动升级为QQ电脑管家。奇虎公司主张，腾讯公司拒绝向安装有360软件的用户提供相关的软件服务，强制用户在腾讯QQ和奇虎360之间“二选一”，构成反垄断法所禁止的限制交易；腾讯公司将QQ软件管家与即时通信软件相捆绑，以升级QQ软件管家的名义安装QQ医生，构成反垄断法所禁止的捆绑销售。

广东省高级人民法院一审认为：

1. 关于相关市场界定。奇虎公司关于综合性即时通信服务构成一个独立的相关商品市场以及本案相关地域市场应为中国大陆市场的主张不能成立。本案相关商品市场远远超出综合性即时通信服务市场，相关地域市场应为全球市场。但是，该院并未明确界定本案相关商品市场的范围。
2. 关于市场支配地位认定。由于奇虎公司对本案相关商品市场界定错误，其所提供的证据不足以证明腾讯公司在相关商品市场上具有垄断地位。奇虎公司的诉讼请求缺乏事实和法律依据，

不能成立。遂判决驳回奇虎公司的全部诉讼请求。

奇虎公司不服，提出上诉。其主要上诉理由为：

1. 一审判决对本案相关商品市场未作认定，属于案件基本事实认定不清。
2. 一审判决在分析相关商品市场时基本方法错误，对于本案的免费产品不应直接适用假定垄断者测试（即“SSNIP 测试”）界定相关市场，且其运用 SSNIP 价格增长测试也是错误的。本案相关商品市场应界定为综合了文字、语音、视频的个人电脑端即时通信软件和服务。
3. 一审判决对相关地域市场的认定明显错误，本案中相关地域市场应为中国大陆地区。
4. 一审判决认定腾讯公司在相关市场不具有支配地位是错误的。腾讯公司在相关市场的市场份额均超过二分之一，应当推定其具有市场支配地位。
5. 腾讯公司实施了滥用市场支配地位的行为，依法应当承担法律责任。

裁判结果：最高人民法院于 2014 年 10 月 8 日作出（2013）民三终字第 4 号民事判决：驳回上诉、维持原判。

裁判理由：最高人民法院针对该上诉理由，将争议焦点归纳为五个方面共计 22 个具体争议问题，并对每一争议问题逐一进行了分析。特别是，对于相关市场界定的作用、目的、方法等，最高人民法院在判决中根据互联网领域的独特特点，对于传统反垄断法的分析方法进行了创新和发展，在全球领域内首次对互联网领域相关市场的界定方法给出了创造性的答案。例如，在相关市场界定是否是滥用市场支配地位垄断纠纷的必经步骤这一问题上，业界普遍认为，准确界定相关市场是认定市场支配地位的前提。此谓传统的“相关市场（relative market—市场支配力（market power）—竞争效应（competition effects）（R-M-C）”分析范式。最高人民法院的判决在回溯相关

市场的目的与作用的基础上，结合互联网领域的特点，雄辩地说明了相关市场界定的工具性，并提出了不以相关市场界定为前提的“市场支配力—竞争效应（M-C）”分析范式和“行为—竞争效应（C-C）”分析范式。

最高人民法院审理认为：本案中涉及的争议焦点主要包括，一是如何界定本案中的相关市场，二是被上诉人是否具有市场支配地位，三是被上诉人是否构成反垄断法所禁止的滥用市场支配地位行为等几个方面。

一、如何界定本案中的相关市场

该争议焦点可以进一步细化为一些具体问题，择要概括如下：

首先，并非在任何滥用市场支配地位的案件中均必须明确而清楚地界定相关市场。竞争行为都是在一定的市场范围内发生和展开的，界定相关市场可以明确经营者之间竞争的市场范围及其面对的竞争约束。在滥用市场支配地位的案件中，合理地界定相关市场，对于正确认定经营者的市场地位、分析经营者的行为对市场竞争的影响、判断经营者行为是否违法，以及在违法情况下需承担的法律后果等关键问题，具有重要意义。因此，在反垄断案件的审理中，界定相关市场通常是重要的分析步骤。尽管如此，是否能够明确界定相关市场取决于案件具体情况，尤其是案件证据、相关数据的可获得性、相关领域竞争的复杂性等。在滥用市场支配地位案件的审理中，界定相关市场是评估经营者的市场力量及被诉垄断行为对竞争的影响的工具，其本身并非目的。即使不明确界定相关市场，也可以通过排除或者妨碍竞争的直接证据对被诉经营者的市场地位及被诉垄断行为可能的市场影响进行评估。因此，并非在每一个滥用市场支配地位的案件中均必须明确而清楚地界定相关市场。一审法院实际上已经对本案相关市场进行了界定，只是由于本案相关市场的边界具有模糊性，一审法院仅对其边界的可能性进行了分析而没有对相关市场的边界给出明确结

论。有鉴于此，奇虎公司关于一审法院未对本案相关商品市场作出明确界定，属于本案基本事实认定不清的理由不能成立。

其次，关于“假定垄断者测试”方法可否适用于免费商品领域问题。法院生效裁判认为：

第一，作为界定相关市场的一种分析思路，假定垄断者测试（HMT）具有普遍的适用性。实践中，假定垄断者测试的分析方法有多种，既可以通过数量不大但有意义且并非短暂的价格上涨（SSNIP）的方法进行，又可以通过数量不大但有意义且并非短暂的质量下降（SSNDQ）的方法进行。同时，作为一种分析思路或者思考方法，假定垄断者测试在实际运用时既可以通过定性分析的方法进行，又可以在条件允许的情况下通过定量分析的方法进行。

第二，在实践中，选择何种方法进行假定垄断者测试取决于案件所涉市场竞争领域以及可获得的相关数据的具体情况。如果特定市场领域的商品同质化特征比较明显，价格竞争是较为重要的竞争形式，则采用数量不大但有意义且并非短暂的价格上涨（SSNIP）的方法较为可行。但是如果在产品差异化非常明显且质量、服务、创新、消费者体验等非价格竞争成为重要竞争形式的领域，采用数量不大但有意义且并非短暂的价格上涨（SSNIP）的方法则存在较大困难。特别是，当特定领域商品的市场均衡价格为零时，运用SSNIP方法尤为困难。在运用SSNIP方法时，通常需要确定适当的基准价格，进行5%~10%幅度的价格上涨，然后确定需求者的反应。在基准价格为零的情况下，如果进行5%~10%幅度的价格增长，增长后其价格仍为零；如果将价格从零提升到一个较小的正价格，则相当于价格增长幅度的无限增大，意味着商品特性或者经营模式发生较大变化，因而难以进行SSNIP测试。

第三，关于假定垄断者测试在本案中的可适用性问题。互联网服务提供商在互联网领域的竞争中更加注重质量、服务、创新等方面的竞争而不是价格竞争。在免费的互联网基础即时通信服务已经长期存在并成为通行商业模式的情况下，用户具有极高的价格敏感度，改变免费策略转而收取哪怕是较小数额的费用都可能导致用户的大量流失。同时，将价格由免费转变为收费也意味着商品特性和经营模式的重大变化，即由免费商品转变为收费商品，由间接盈利模式转变为直接盈利模式。在这种情况下，如果采取基于相对价格上涨的假定垄断者测试，很可能将不具有替代关系的商品纳入相关市场中，导致相关市场界定过宽。因此，基于相对价格上涨的假定垄断者测试并不完全适宜在本案中适用。尽管基于相对价格上涨的假定垄断者测试难以在本案中完全适用，但仍可以采取该方法的变通形式，例如基于质量下降的假定垄断者测试。由于质量下降程度较难评估以及相关数据难以获得，因此可以采用质量下降的假定垄断者测试进行定性分析而不是定量分析。

再次，关于本案相关市场是否应确定为互联网应用平台问题。上诉人认为，互联网应用平台与本案的相关市场界定无关；被上诉人则认为，互联网竞争实际上是平台的竞争，本案的相关市场范围远远超出了即时通信服务市场。法院生效裁判针对互联网领域平台竞争的特点，阐述了相关市场界定时应如何考虑平台竞争的特点及处理方式，认为：

第一，互联网竞争一定程度地呈现出平台竞争的特征。被诉垄断行为发生时，互联网的平台竞争特征已经比较明显。互联网经营者通过特定的切入点进入互联网领域，在不同类型和需求的消费者之间发挥中介作用，以此创造价值。

第二，判断本案相关商品市场是否应确定为互联网应用平台，其关键问题在于，网络平台之间为争夺用户注意力和广告主的相互竞争是否完全跨越了由产品或者服务特点所决定的界限，并给经营者施加了足够强大的竞争约束。这一问题答案最终取决于实证检验。在缺乏确切的实证数据的情况下，至少注意如下方面：首先，互联网应用平台之间争夺用户注意力和广告主的竞争以其提供的关键核心产品或者服务为基础。其次，互联网应用平台的关键核心产品或者服务在属性、特征、功能、用途等方面上存在较大的不同。虽然广告主可能不关心这些产品或者服务的差异，只关心广告的价格和效果，因而可能将不同的互联网应用平台视为彼此可以替代，但是对于免费端的广大用户而言，其很难将不同平台提供的功能和用途完全不同的产品或者服务视为可以有效地相互替代。一个试图查找某个历史人物生平的用户通常会选择使用搜索引擎而不是即时通信，其几乎不会认为两者可以相互替代。再次，互联网应用平台关键核心产品或者服务的特性、功能、用途等差异决定了其所争夺的主要用户群体和广告主可能存在差异，因而在获取经济利益的模式、目标用户群、所提供的后续市场产品等方面存在较大区别。最后，本案中应该关注的是被上诉人是否利用了其在即时通信领域中可能的市场支配力量排除、限制互联网安全软件领域的竞争，将其在即时通信领域中可能存在的市场支配力量延伸到安全软件领域，这一竞争过程更多地发生在免费的用户端。鉴于上述理由，在本案相关市场界定阶段互联网平台竞争的特性不是主要考虑因素。

第三，本案中互联网企业平台竞争特征的考虑方式。相关市场界定的目的是为了明确经营者所面对的

竞争约束，合理认定经营者的市场地位，并正确判断其行为对市场竞争的影响。即使不在相关市场界定阶段主要考虑互联网平台竞争的特性，但为了正确认定经营者的市场地位，仍然可以在识别经营者的市场地位和市场控制力时予以适当考虑。因此，对于本案，不在相关市场界定阶段主要考虑互联网平台竞争的特性并不意味着忽视这一特性，而是为了以更恰当的方式考虑这一特性。

最后，关于即时通信服务相关地域市场界定需要注意的问题。法院生效裁判认为：本案相关地域市场的界定，应从中国大陆地区的即时通信服务市场这一目标地域开始，对本案相关地域市场进行考察。因为基于互联网的即时通信服务可以低成本、低代价到达或者覆盖全球，并无额外的、值得关注的运输成本、价格成本或者技术障碍，所以在界定相关地域市场时，将主要考虑多数需求者选择商品的实际区域、法律法规的规定、境外竞争者的现状及其进入相关地域市场的及时性等因素。由于每一个因素均不是决定性的，因此需要根据上述因素进行综合评估。首先，中国大陆地区境内绝大多数用户均选择使用中国大陆地区范围内的经营者提供的即时通信服务。中国大陆地区境内用户对于国际即时通信产品并无较高的关注度。其次，我国有关互联网的行政法规规章等对经营即时通信服务规定了明确的要求和条件。我国对即时通信等增值电信业务实行行政许可制度，外国经营者通常不能直接进入我国大陆境内经营，需要以中外合资经营企业的方式进入并取得相应的行政许可。再次，位于境外的即时通信服务经营者的实际情况。在本案被诉垄断行为发生前，多数主要国际即时通信经营者例如 MSN、雅虎、Skype、谷歌等均已经通过合资的方式进入中国大陆地区市场。因此，在被诉垄断行为发生时，尚未进入我国大陆境内的主要国际即时通信服务经营者已经很少。如果我国大陆境内的即时通信服务质量小幅下降，已没有多少境外即时通信服务经营者可供境内用户选择。最后，境

外即时通信服务经营者在较短的时间内(例如一年)及时进入中国大陆地区并发展到足以制约境内经营者的规模存在较大困难。境外即时通信服务经营者首先需要通过合资方式建立企业、满足一系列许可条件并取得相应的行政许可,这在相当程度上延缓了境外经营者的进入时间。综上,本案相关地域市场应为中国大陆地区市场。

综合本案其他证据和实际情况,本案相关市场应界定为中国大陆地区即时通信服务市场,既包括个人电脑端即时通信服务,又包括移动端即时通信服务;既包括综合性即时通信服务,又包括文字、音频以及视频等非综合性即时通信服务。

二、被上诉人是否具有市场支配地位

对于经营者在相关市场中的市场份额在认定其市场支配力方面的地位和作用,法院生效裁判认为:市场份额在认定市场支配力方面的地位和作用必须根据案件具体情况确定。一般而言,市场份额越高,持续的时间越长,就越可能预示着市场支配地位的存在。尽管如此,市场份额只是判断市场支配地位的一项比较粗糙且可能具有误导性的指标。在市场进入比较容易,或者高市场份额源于经营者更高的市场效率或者提供了更优异的产品,或者市场外产品对经营者形成较强的竞争约束等情况下,高的市场份额并不能直接推断出市场支配地位的存在。特别是,互联网环境下的竞争存在高度动态的特征,相关市场的边界远不如传统领域那样清晰,在此情况下,更不能高估市场份额的指示作用,而应更多地关注市场进入、经营者的市场行为、对竞争的影响等有助于判断市场支配地位的具体事实和证据。

结合上述思路,法院生效裁判从市场份额、相关市场的竞争状况、被诉经营者控制商品价格、数量或者其他交易条件的能力、该经营者的财力和技术条件、其他经营者对该经营者在交易上的依赖程度、其他经营者进入相关市场的难易程度等方面,对被上诉人是否具有市场支配地位进行考量和分析,并特别考虑了腾讯公司实施“二选一”行为仅仅持续一天即导致其竞争对手 MSN 当月覆盖人数增长 2300 多万,多

个竞争对手争抢即时通信服务市场的事实。最终认定本案现有证据并不足以支持被上诉人具有市场支配地位的结论。

三、被上诉人是否构成《中华人民共和国反垄断法》所禁止的滥用市场支配地位行为

法院生效裁判打破了传统的分析滥用市场支配地位行为的“三步法”,采用了更为灵活的分析步骤和方法,认为:原则上,如果被诉经营者不具有市场支配地位,则无需对其是否滥用市场支配地位进行分析,可以直接认定其不构成反垄断法所禁止的滥用市场支配地位行为。不过,在相关市场边界较为模糊、被诉经营者是否具有市场支配地位不甚明确时,可以进一步分析被诉垄断行为对竞争的影响效果,以检验关于其是否具有市场支配地位的结论正确与否。此外,即使被诉经营者具有市场支配地位,判断其是否构成滥用市场支配地位,也需要综合评估该行为对消费者和竞争造成的消极效果和可能具有的积极效果,进而对该行为的合法性与否作出判断。本案主要涉及两个方面的问题:

一是关于被上诉人实施的“产品不兼容”行为(用户二选一)是否构成反垄断法禁止的限制交易行为。根据《中华人民共和国反垄断法》第十七条的规定,具有市场支配地位的经营者,没有正当理由,限定交易相对人只能与其进行交易或者只能与其指定的经营者进行交易的,构成滥用市场支配地位。上诉人主张,被上诉人没有正当理由,强制用户停止使用并卸载上诉人的软件,构成反垄断法所禁止的滥用市场支配地位限制交易行为。对此,法院生效裁判认为,虽然被上诉人实施的“产品不兼容”行为对用户造成了不便,但是并未导致排除或者限制竞争的明显效果。这一方面说明被上诉人实施的“产品不兼容”行为不构成反垄断法所禁止的滥用市场支配地位行为,也从另一方面佐证了被上诉人不具有市场支配地位的结论。

二是被上诉人是否构成反垄断法所禁止的搭售行为。根据《中华人民共和国反垄断法》第十七条的规定,具有市场支配地位的经营者,没有正当理由搭售商品,或者在交

易时附加其他不合理的交易条件的，构成滥用市场支配地位。上诉人主张，被上诉人将 QQ 软件管家与即时通信软件捆绑搭售，并且以升级 QQ 软件管家的名义安装 QQ 医生，不符合交易惯例、消费习惯或者商品的功能，消费者选择权受到了限制，不具有正当理由；一审判决关于被诉搭售行为产生排除、限制竞争效果的举证责任分配错误。对此，法院生效裁判认为，上诉人关于被上诉人实施了滥用市场支配地位行为的上诉理由不能成立。

C. 经营者占有市场支配地位的认定

裁判要旨：

作为特定区域内唯一合法经营有线电视传输业务的经营者及电视节目集中播控者，在市场准入、市场份额、经营地位、经营规模等各要素上均具有优势，可以认定该经营者占有市场支配地位。

经营者利用市场支配地位，将数字电视基本收视维护费和数字电视付费节目费捆绑在一起向消费者收取，侵害了消费者的消费选择权，不利于其他服务提供者进入数字电视服务市场。经营者即使存在两项服务分别收费的例外情形，也不足以否认其构成反垄断法所禁止的搭售。

吴小秦与陕西广电网络传媒（集团）股份有限公司捆绑交易纠纷案

案号：

最高人民法院（2016）最高法民再 98 号

案由：

捆绑交易纠纷

合议庭成员：

王艳芳 | 钱小红 | 杜微科

关键词：

垄断，搭售，经营者，市场支配地位

相关法条：

《中华人民共和国反垄断法》第十七条第一款第（五）项

基本案情：原告吴小秦诉称：2012 年 5 月 10 日，其前往陕西广电网络传媒（集团）股份有限公司（以下简称广电公司）缴纳数字电视基本收视维护费得知，该项费用由每月 25 元调至 30 元，吴小秦遂缴纳了 3 个月费用 90 元，其中数字电视基本收视维护费 75 元、数字电视节目费 15 元。之后，吴小秦获悉数字电视节目应由用户自由选择，自愿订购。吴小秦认为，广电公司属于公用企业，在数字电视市场内具有支配地位，其收取数字电视节

目费的行为剥夺了自己的自主选择权，构成搭售，故诉至法院，请求判令：确认被告2012年5月10日收取其数字电视节目费15元的行为无效，被告返还原告15元。

广电公司辩称：广电公司作为陕西省内唯一电视节目集中播控者，向选择收看基本收视节目之外的消费者收取费用，符合反垄断法的规定；广电公司具备陕西省有线电视市场支配地位，鼓励用户选择有线电视套餐，但并未滥用市场支配地位，强行规定用户在基本收视业务之外必须消费的服务项目，用户有自主选择权；垄断行为的认定属于行政权力，而不是司法权力，原告没有请求认定垄断行为无效的权利；广电公司虽然推出了一系列满足用户进行个性化选择的电视套餐，但从没有进行强制搭售的行为，保证了绝大多数群众收看更多电视节目的选择权利；故请求驳回原告要求确认广电公司增加节目并收取费用无效的请求；愿意积极解决吴小秦的第二项诉讼请求。

法院经审理查明：2012年5月10日，吴小秦前往广电公司缴纳数字电视基本收视维护费时获悉，数字电视基本收视维护费每月最低标准由25元上调至30元。吴小秦缴纳了2012年5月10日至8月9日的数字电视基本收视维护费90元。广电公司向吴小秦出具的收费专用发票载明：数字电视基本收视维护费75元及数字电视节目费15元。之后，吴小秦通过广电公司客户服务中心（服务电话96766）咨询，广电公司节目升级增加了不同的收费节目，有不同的套餐，其中最低套餐基本收视费每年360元，用户每次最少应缴纳3个月费用。广电公司是经陕西省政府批准，陕西境内唯一合法经营有线电视传输业务的经营者和唯一电视节目集中播控者。广电公司承认其在有线电视传输业务中在陕西省占有支配地位。

另查，2004年12月2日国家发展改革委、国家广电总局印发的《有线电视基本收视维护费管理暂行办法》规定：有线电视基本收视维护费实行政府定价，收费标准由价格主管部门制定。2005年7月11日国家广电总局关于印发《推进试点单位有线电视数字化整体转换的若干意见（试行）》

的通知规定，各试点单位在推进整体转换过程中，要重视付费频道等新业务的推广，供用户自由选择，自愿订购。陕西省物价局于2006年5月29日出台的《关于全省数字电视基本收视维护费标准的通知》规定：数字电视基本收视维护费收费标准为：以居民用户收看一台电视机使用一个接收终端为计费单位。全省县城以上城市居民用户每主终端每月25元；有线数字电视用户可根据实际情况自愿选择按月、按季或按年度缴纳基本收视维护费。国家发展改革委、国家广电总局于2009年8月25日出台的《关于加强有线电视收费管理等有关问题的通知》指出：有线电视基本收视维护费实行政府定价；有线电视增值业务服务和数字电视付费节目收费，由有线电视运营机构自行确定。

二审中，广电公司提供了四份收费专用发票复印件，证明在5月10日前后，广电公司的营业厅收取过25元的月服务费，因无原件，吴小秦不予质证。庭后广电公司提供了其中三张的原件，双方进行了核对与质证。该票据上均显示一年交费金额为300元，即每月25元。广电公司提供了五张票据的原件，包括一审提供过原件的三张，交易地点均为咸阳市。由此证明广电公司在5月10日前后，提供过每月25元的收费服务。

再审中，广电公司提交了其2016年网站收费套餐截图、关于印发《2016年大众业务实施办法（试行）的通知》、2016年部分客户收费发票。

裁判结果：陕西省西安市中级人民法院于2013年1月5日作出（2012）西民四初字第438号民事判决：

1. 确认陕西广电网络传媒（集团）股份有限公司2012年5月10日收取原告吴小秦数字电视节目费15元的行为无效；
2. 陕西广电网络传媒（集团）股份有限公司于本判决生效之日起十日内返还吴小秦15元。

陕西广电网络传媒（集团）股份有限公司提起上诉，陕西省高级人民法院于2013

年9月12日作出(2013)陕民三终字第38号民事判决：1.撤销一审判决；2.驳回吴小秦的诉讼请求。

吴小秦不服二审判决，向最高人民法院提出再审申请。最高人民法院于2016年5月31日作出(2016)最高法民再98号民事判决：1.撤销陕西省高级人民法院(2013)陕民三终字第38号民事判决；2.维持陕西省西安市中级人民法院(2012)西民四初字第438号民事判决。

裁判理由：法院生效裁判认为：本案争议焦点包括：

一是本案诉争行为是否违反了《中华人民共和国反垄断法》第十七条第一款第(五)项之规定。

二是一审法院适用《中华人民共和国反垄断法》是否适当。

一、关于本案诉争行为是否违反了《中华人民共和国反垄断法》第十七条第(五)项之规定

依据《中华人民共和国反垄断法》第十七条第一款第(五)项规定，禁止具有市场支配地位的经营者没有正当理由搭售商品或者在交易时附加其他不合理的交易条件。本案中，广电公司在一审答辩中明确认可其“是经陕西省政府批准，陕西境内唯一合法经营有线电视传输业务的经营者。作为陕西省内唯一电视节目集中播控者，广电公司具备陕西省有线电视市场支配地位，鼓励用户选择更丰富的有线电视套餐，但并未滥用市场支配地位，也未强行规定用户在本基本收视业务之外必须消费的服务项目。”二审中，广电公司虽对此不予认可，但并未举出其不具有市场支配地位的相应证据。再审审查过程中，广电公司对一、二审法院认定其具有市场支配地位的事实并未提出异议。鉴于广电公司作为陕西境内唯一合法经营有线电视传输业务的经营者，陕西省内唯一电视节目集中播控者，一、二审法院在查明事实的基础上认定在有线电视传输市场中，广电公司在市场准入、市场份额、经营地位、经营规模等各要素上均具有优势，占有支配地位，并无不当。

关于广电公司在向吴小秦提供服务时是否构成搭售的问题。《中华人民共和国反垄断法》第十七条第一款第(五)项规定禁止具有市场支配地位的经营者没有正当理由搭售商品。本案中，根据原审法院查明的事实，广电公司在提供服务时其工作人员告知吴小秦每月最低收费标准已从2012年3月起由25元上调为30元，每次最少缴纳一个季度，并未告知吴小秦可以单独缴纳数字电视基本收视维护费或者数字电视付费节目费。吴小秦通过广电公司客户服务中心(服务电话号码96766)咨询获悉，广电公司节目升级，增加了不同的收费节目，有不同的套餐，其中最低套餐基本收视费为每年360元，每月30元，用户每次最少应缴纳3个月费用。根据前述事实并结合广电公司给吴小秦开具的收费专用发票记载的收费项目——数字电视基本收视维护费75元及数字电视节目费15元的事实，可以认定广电公司实际上是将数字电视基本收视节目和数字电视付费节目捆绑在一起向吴小秦销售，并没有告知吴小秦是否可以单独选购数字电视基本收视服务的服务项目。此外，从广电公司客户服务中心(服务电话号码96766)的答复中亦可佐证广电公司在提供此服务时，是将数字电视基本收视维护费和数字电视付费节目费一起收取并提供。虽然广电公司在二审中提交了其向其他用户单独收取数字电视基本收视维护费的相关票据，但该证据仅能证明广电公司在收取该费用时存在客户服务中心说明的套餐之外的例外情形。再审中，广电公司并未对客户服务中心说明的套餐之外的例外情形作出合理解释，其提交的单独收取相关费用的票据亦发生在本案诉讼之后，不足以证明诉讼时的情形，对此不予采信。因此，存在客户服务中心说明的套餐之外的例外情形并不足以否认广电公司将数字电视基本收视维护费和数字电视付费节目费一起收取的普遍做法。二审法院认定广电公司不仅提供了组合服务，也提供了基本服务，证据不足，应予纠正。因此，现有证据不能证明普通消费者可以仅缴纳电视基本收视维护费或者数字电视付费节目费，即不能证明消费者选择权的存在。二审法院在不能证明是否有选择权的情况下直接认为本案属于未告知消费者有选择

权而涉及侵犯消费者知情权的问题，进而在此基础上，认定为广电公司的销售行为未构成反垄断法所规制的没有正当理由的搭售，事实和法律依据不足，应予纠正。

根据本院查明的事实，数字电视基本收视维护费和数字电视付费节目费属于两项单独的服务。在原审诉讼及本院诉讼中，广电公司未证明将两项服务一起提供符合提供数字电视服务的交易习惯；同时，如将数字电视基本收视维护费和数字电视付费节目费分别收取，现亦无证据证明会损害该两种服务的性能和使用价值；广电公司更未对前述行为说明其正当理由，在此情形下，广电公司利用其市场支配地位，将数字电视基本收视维护费和数字电视付费节目费一起收取，客观上影响消费者选择其他服务提供者提供相关数字付费节目，同时也不利于其他服务提供者进入电视服务市场，对市场竞争具有不利的效果。因此一审法院认定其违反了《中华人民共和国反垄断法》第十七条第一款第（五）项之规定，并无不当。吴小秦部分再审申请理由成立，予以支持。

二、关于一审法院适用《中华人民共和国反垄断法》是否适当

本案诉讼中，广电公司在答辩中认为本案的发生实质上是一个有关吴小秦基于《消费者权益保护法》所应当享受的权利是否被侵犯的纠纷，而与垄断行为无关，认为一审法院应当依照《中华人民共和国反垄断法》及相关规定，认为其处于市场支配地位，从而确认其收费行为无效。根据《最高人民法院关于适用〈中华人民共和国民事诉讼法〉的解释》第二百二十六条及第二百二十八条的规定，人民法院应当根据当事人的诉讼请求、答辩意见以及证据交换的情况，归纳争议焦点，并就归纳的争议焦点征求当事人的意见。在法庭审理时，应当围绕当事人争议的事实、证据和法律适用等焦点问题进行。根据查明的事实，吴小秦在其诉状中明确主张“被告收取原告数字电视节目费，实际上是为原告在提供上述服务范围外增加提供服务内容，对此原告应当具有自主选择权。被告属于公用企业或者其他依法具有独占地位的经营

者，在数字电视市场内具有支配地位。被告的上述行为违反了《中华人民共和国反垄断法》第十七条第一款第（五）项关于‘禁止具有市场支配地位的经营者从事没有正当理由搭售商品，或者在交易时附加其他不合理的交易条件的滥用市场支配地位行为’，侵害了原告的合法权益。原告依照《最高人民法院关于审理因垄断行为引发的民事纠纷案件应用法律若干问题的规定》，提起民事诉讼，请求人民法院依法确认被告的捆绑交易行为无效，判令其返还原告15元。”在该诉状中，吴小秦并未主张其消费者权益受到损害，因此一审法院根据吴小秦的诉讼请求适用《反垄断法》进行审理，并无不当。

综上，广电公司在陕西省境内有线电视传输服务市场上具有市场支配地位，其将数字电视基本收视服务和数字电视付费节目服务捆绑在一起向吴小秦销售，违反了《中华人民共和国反垄断法》第十七条第一款第（五）项之规定。吴小秦关于确认广电公司收取其数字电视节目费15元的行为无效和请求判令返还15元的再审请求成立。一审判决认定事实清楚，适用法律正确，应予维持，二审判决认定事实依据不足，适用法律有误，应予纠正。

D. 互联网市场背景下对反不正当竞争法第二条规定的适用及技术创新、自由竞争和不正当竞争的界限

裁判要旨：

经营者在市场交易中，应当遵循自愿、平等、公平、诚实信用的原则，遵守公认的商业道德，互联网市场领域同样如此。

认定竞争行为是否构成不正当竞争，关键在于该行为是否违反了诚实信用原则和互联网行业公认的商业道德，是否损害了他人的合法权益。

技术创新可以刺激竞争，竞争又可以促进技术创新。技术本身虽然是中立的，但技术也可以成为进行不正当竞争的工​​具。技术革新应当成为公平自由竞争的工具，而非干涉他人正当商业模式的借口。

北京奇虎科技有限公司、奇智软件（北京）有限公司与腾讯科技（深圳）有限公司、深圳市腾讯计算机系统有限公司不正当竞争纠纷案

案号：

最高人民法院（2013）民三终字第5号

案由：

不正当竞争纠纷

合议庭成员：

王 闯 | 王艳芳 | 朱 理等

关键词：

不正当竞争，互联网市场，诚实信用，公平竞争，技术创新

相关法条：

《中华人民共和国反不正当竞争法》第二条、第十四条、第二十条

基本案情：在上诉人北京奇虎科技有限公司（以下简称奇虎公司）、奇智软件（北京）有限公司（以下简称奇智公司）与被上诉人腾讯科技（深圳）有限公司（以下简称腾讯公司）、深圳市腾讯计算机系统有限公司（以下简称腾讯计算机公司）不正当竞争纠纷案（以下简称“腾讯QQ”不正当竞争案）中，奇虎公司、奇智公司针对QQ软件专门开发了扣扣保镖，在相关网站上宣传扣扣保镖全面保护QQ用户安全，并提供下载。本案中，在安装了扣扣保镖软件后，该软件会自动对QQ软件进行体检，然后显示“体检得分4分，QQ存在严重的健康问题”；“共检查了40项，其中31项有问题，建议立即修复！重新体检”；“在QQ的运行过程中，会扫描您电脑里的文件（腾讯称之为安全扫描），为避免您的隐私泄露，您可禁止QQ扫描您的文件”等用语。同时，以红色字体警示用户QQ存在严重的健康问题，以绿色字体提供一键修复帮助，同时将“没有安装360安全卫士，电脑处于危险之中；升级QQ安全中心；阻止QQ扫描我的文件”列为危险项目；查杀QQ木马时，显示“如果您不安装360安全卫士，将无法使用木马查杀功能”，并以绿色功能键提供360安全卫士的安装及下载服务；经过一键修复，扣扣保镖将QQ软件的安全沟通界面替换成扣扣保镖界面。

2011年6月10日，腾讯公司、腾讯计算机公司以奇虎公司、奇智公司的上述行为构成不正当竞争为由，提起诉讼。广东省高级人民法院一审认为，奇虎公司、奇智公司针对QQ软件专门开发的扣扣保镖破坏了合法运行的QQ软件及其服务的安全性、完整性，使腾讯公司、腾讯计算机公司丧失合法增值业务的交易机会及广告、游戏等收入，扣扣保镖通过篡改QQ的功能界面从而取代QQ软件的部分功能以推销自己的产品，上述行为违反了诚实信用和公平竞争的原则，构成不正当竞争行为。奇虎公司、奇智公司针对腾讯公司、腾讯计算机公司的经营，故意捏造、散布虚伪事实，损害

了腾讯公司、腾讯计算机公司的商业信誉和商品声誉，构成商业诋毁。遂判决奇虎公司、奇智公司公开赔礼道歉、消除影响，并连带赔偿腾讯公司、腾讯计算机公司经济损失及合理维权费用共计500万元。奇虎公司、奇智公司不服，提起上诉。

裁判结果：最高人民法院于2014年2月18日作出（2013）民三终字第5号民事判决：驳回上诉、维持原判。

裁判理由：最高人民法院二审认为：在市场竞争中，经营者通常可以根据市场需要和消费者需求自由选择商业模式，这是市场经济的必然要求。腾讯公司、腾讯计算机公司为谋取市场利益，通过开发QQ软件，以该软件为核心搭建一个综合性互联网业务平台，并提供免费的即时通讯服务，吸引相关消费者体验、使用其增值业务，同时亦以该平台为媒介吸引相关广告商投放广告，以此创造商业机会并取得相关广告收入。这种免费平台与广告或增值服务相结合的商业模式是本案争议发生时，互联网行业惯常的经营方式，也符合我国互联网市场发展的阶段性特征。事实上，本案奇虎公司、奇智公司也采用这种商业模式。这种商业模式并不违反反不正当竞争法的原则精神和禁止性规定，腾讯公司、腾讯计算机公司以此谋求商业利益的行为应受保护，他人不得以不正当干扰方式损害其正当权益。

奇虎公司、奇智公司专门针对QQ软件开发、经营扣扣保镖，以帮助、诱导等方式破坏QQ软件及其服务的安全性、完整性，减少了腾讯公司、腾讯计算机公司的经济收益和增值服务交易机会，干扰了其正当经营活动，损害了其合法权益。正当的市场竞争是竞争者通过必要的付出而进行的诚实竞争。不付出劳动或者不正当地利用他人已经取得的市场成果，为自己谋取商业机会，从而获取竞争优势的行为，属于不正当竞争行为。奇虎公司、奇智公司在经营扣扣保镖时，将自己的产品和服务嵌入QQ软件界面，取代了腾讯公司、腾讯计算机公司QQ软件的部分功能，其根本

目的在于依附QQ软件强大用户群，通过对QQ软件及其服务进行贬损的手段来推销、推广360安全卫士，从而增加奇虎公司、奇智公司的市场交易机会并获取市场竞争优势，此行为本质上属于不正当地利用他人市场成果，为自己谋取商业机会从而获取竞争优势的行为。据此，奇虎公司、奇智公司的上述行为均违反了诚实信用和公平竞争原则，构成不正当竞争。

关于技术创新、自由竞争和不正当竞争的界限的问题

奇虎公司认为其行为是互联网自由和创新精神的体现，认为一审法院违反行业发展规律，苛刻适用反不正当竞争法的一般原则，会限制竞争和打击创新。最高人民法院认为，互联网的发展有赖于自由竞争和科技创新，互联网行业鼓励自由竞争和创新，但这并不等于互联网领域是一个为所欲为的法外空间，竞争自由和创新自由必须以不侵犯他人合法权益为边界，互联网的健康发展需要有序的市场环境和明确的市场竞争规则作为保障。是否属于互联网精神鼓励的自由竞争和创新，仍然需要基于是否有利于建立平等公平的竞争秩序、是否符合消费者的一般利益和社会公共利益为标准来进行判断，而不是仅有某些技术上的进步即认为属于自由竞争和创新。否则，任何人均可以技术进步为借口，对他人的技术产品或者服务进行任意干涉，就导致借技术进步、创新之名，而行“丛林法则”之实。技术创新可以刺激竞争，竞争又可以促进技术创新。技术本身虽然是中立的，但技术也可以成为进行不正当竞争的工​​具。技术革新应当成为公平自由竞争的工具，而非干涉他人正当商业模式的借口。本案中，奇虎公司以技术创新为名，专门开发扣扣保镖对腾讯公司QQ软件进行深度干预，难以认定其符合互联网自由和创新之精神，最高人民法院对其上诉理由不予支持。

E. 商业秘密侵权诉讼中行为保全措施的审查与适用

裁判要旨：

2013年1月1日施行的《中华人民共和国民事诉讼法》规定了行为保全措施，有利于商业秘密权利人及时有效地寻求救济措施。法院要综合考虑：原告胜诉的实质可能性、如不采取行为保全措施将遭受无可挽回损失的实质性威胁、原告可能受到的损害大于对被告的任何潜在损害、采取行为保全措施不违反公共利益等因素作出裁定。

美国礼来公司、礼来（中国）研发公司诉黄孟炜侵害技术秘密纠纷案

案号：

上海市第一中级人民法院（2013）沪一中民五（知）初字第119号

案由：

侵害技术秘密纠纷

合议庭成员：

唐震 | 陈瑶瑶 | 陈荣祥

关键词：

侵害商业秘密，行为保全

相关法条：

《中华人民共和国民事诉讼法》第一百条

基本案情：

申请人（原告）美国礼来公司（Eli Lilly and Company）。

申请人（原告）礼来（中国）研发有限公司（以下简称礼来中国公司）。

被申请人（被告）黄孟炜。

2013年7月2日，美国礼来公司、礼来中国公司向上海市第一中级人民法院（以下简称上海一中院）起诉状告黄孟炜侵害技术秘密，同时向该院提出行为保全的申请，要求法院责令被告不得披露、使用或者允许他人使用从申请人处盗取的21个商业秘密文件。

申请人称：被申请人于2012年5月入职礼来中国公司，担任化学主任研究员工作。礼来中国公司与被申请人签订了《保密协议》，并进行了相应的培训。2013年1月，被申请人从礼来中国公司的服务器上下载了48个申请人所拥有的文件（其中21个为原告核心机密商业文件），并将上述文件私自存储至被申请人所拥有的设备中。经交涉，2013年2月，被申请人签署同意函，向申请人承认：“我从公司的服务器上下载了三十三（33）个属于公司的保密文件……”，并承诺：

“我允许公司或公司指定的人员检查第一手非公司装置和第二手非公司装置，以确定我没有进一步转发、修改、使用或打印任何公司文件。如果公司或其指定人员在非公司装置中发现任何公司文件或内容，我授权公司或其指定人员删除这些公司文件及相关内容……”。

此后，申请人曾数次派员联系被申请人，要求其配合删除机密商业文件，并由申请人派员检查并确认上述机密商业文件已被删除。但是，被申请人无视申请人的交涉和努力，拒绝履行同意函约定的事项。鉴于被申请人严重违反公司制度，申请人于2013年2月27日致信被申请人宣布解除双方劳动关系。申请人认为，被申请人私自下载的21个核心机密商业文件，系申请人的商业秘密，被申请人对此明知且已在承诺书中予以认可。由于被申请人未履行承诺，致使申请人的商业秘密处于随时可能因被申请人披露、使用或者许可他人使用而被外泄的危险境地，对申请人造成无法弥补的损害。据此，申请人依法请求法院责令被申请人不得披露、使用或者允许他人使用从申请人处盗取的21个商业秘密文件。为支持其申请，申请人还向法院提供了涉案21个商业秘密文件的名称及内容、被申请人的承诺书、公证书、员工信息设备配备表格、劳动关系终止通知函、直接及间接成本统计表等证据材料。申请人就上述申请还提供了担保金人民币10万元。

裁判结果：上海一中院裁定禁止被申请人黄孟炜披露、使用或允许他人使用申请人

美国礼来公司、礼来（中国）研发有限公司主张作为商业秘密保护的 21 个文件。被申请人黄孟炜在裁定指定的期限内未申请复议，该裁定发生法律效力。

裁判理由：本案系国内首例依据《中华人民共和国民事诉讼法》（2013 年 1 月 1 日起施行）在商业秘密侵权诉讼中适用行为保全措施的案件，凸显了新时期下人民法院顺应社会需求，依法加强知识产权司法保护的实践努力。在案件的审理过程中，法院主要从以下方面加以认识和把握：

一、商业秘密侵权诉讼中行为保全措施的裁量因素

商业秘密侵权诉讼中，行为保全能够及时有效保护权利人的利益，作用十分重要。但是，行为保全是一种特殊的救济措施，不仅能够保障未来生效判决的顺利执行，而且在一定程度上会使得申请人提前获得终局救济全部或部分的利益。因此，在司法实践中，仅仅是存在未经授权的披露或者使用的一般可能性，法院不能采取行为保全。通常而言，行为保全的适用要综合考虑原告胜诉的实质可能性；如不采取行为保全将遭受无可挽回损失的实质性威胁；原告可能受到的损害大于对被告的任何潜在损害；采取行为保全不违反公共利益等因素作出裁定。本案特殊性还在于：

1. 被申请人黄孟炜已经确认其违反公司规定下载了 33 个属于公司的保密文件（其中包括了 21 个权利人主张作为商业秘密保护的的文件），并承诺授权公司指定人员删除上述文件。据此，被申请人通过非法手段获取权利人作为商业秘密保护的保密文件的事实是显而易见的。
2. 商业秘密存在着“一旦丧失就永远丧失”的特性。涉案商业文件已经处于被申请人的掌控之下，一旦被申请人外泄，上述电子文件的内容很可能就会被竞争对手获悉或者进入公知领域，从而丧失秘密性，使得权利人的利益遭受无可挽回的损失。
3. 从案件事实来看，被申请人作为自然人主体，相对于权利人而言，禁止被

申请人披露、使用或允许他人使用涉案商业文件并不会对其造成损害。更何况，权利人也向法院提交了担保金，以防止万一可能出现的损害。

综合上述因素，合议庭对被申请人采取行为保全措施，同时告知其申请复议的时限，以利于被申请人行使自己的抗辩权利。

二、商业秘密侵权诉讼中行为保全措施的裁判要点

本案系首例商业秘密侵权诉讼中适用行为保全措施的案件，如何适用法律无先例可循。在审理过程中，合议庭还着重把握了以下裁判要点：

一是诉讼请求与行为保全申请统一的问题。权利人起诉时，请求法院判令被告停止侵犯原告商业秘密，并明确具体内容为要求被告删除及不得披露、使用或允许他人使用涉案 21 个商业文件。合议庭认为，法院审查权利人行为保全申请时只能局限于其诉讼请求的范围之内，而不允许另行增加，且应当符合《中华人民共和国反不正当竞争法》（1993 年）第十条规定的商业秘密侵权手段，故最终裁定被申请人“不得披露、使用或允许他人使用涉案 21 个文件”。

二是行为保全与终局裁判的关系问题。本案处于审理阶段，商业秘密能否成立，是否属于我国《反不正当竞争法》所保护的利益尚未定论。行为保全作为阶段性诉讼措施，禁令裁定不能埋下与最终裁判相互矛盾的隐患。因此，裁定主文采取的表述为“禁止被申请人黄孟炜披露、使用或允许他人使用申请人美国礼来公司、礼来（中国）研发有限公司主张作为商业秘密保护的 21 个文件”，这就意味着，涉案的 21 件文件目前仅系申请人主张作为商业秘密保护的的文件，而非经由法院依法审查，最终作为商业秘密保护的信息。

三是裁判与执行兼顾问题。仅从裁定主文而言，21 个文件内容尚不清晰，执行部门执行时将不具有针对性和可行性。因此，我们在裁定主文后附上涉案 21 个文件的具体名称。这说明尽管被申请人违反公司规定下载了 33 件文件，但只有违反裁定要求，

披露、使用或允许他人使用裁定所附的 21 件文件，才要承担相应的法律责任。

三、商业秘密侵权诉讼中行为保全措施的执行方式

行为保全的内容是法院裁决当事人作出一定行为或者禁止作出一定行为，行为保全不同于财产保全，执行的对象是人的行为，而非物本身。正是由于行为保全的特殊性，行为保全的执行需要当事人的配合。而且，禁止当事人实施一定行为比要求当事人作出一定行为执行难度更大。因为要求当事人作出一定行为可以被外在感知，某些时候也能即时履行完毕；而禁止当事人实施一定行为则有赖于当事人的自觉性。而这种自觉性并不能为法院执行人员所能客观感知，从而增加了裁定执行的不确定性。合议庭认为，这种不作为行为的裁定，主要依赖生效法律文书的威慑力。只有增强生效法律文书的威慑力，才能保证当事人自觉履行法院裁定。因此，在本案裁定作出之后，法院并未简单地送达法律文书，而是传唤被申请人到法院谈话，当庭告知其裁定的内容及违反裁定的后果。事实上，对于拒不履行法院已经发生法律效力判决、裁定的，法院可以依据《中华人民共和国民事诉讼法》第一百一十条的规定，根据情节轻重对行为人处以罚款、拘留；构成犯罪的，依法追究刑事责任。应当说，这种告诫取得了较好的法律效果。被申请人当庭书面承诺表示愿意遵守法院裁定，并在事后提交法院的答辩材料中，陈述其已经损毁了存储下载文件的硬盘装置，并附上照片佐证。

F. 解决权利冲突的原则： 保护在先权利与权利共存并重

裁判要旨：

权利冲突的实质是利益冲突，重新确定和明晰权利边界的过程是一个对冲突的利益进行衡量和取舍的过程，体现了司法裁判的价值取向。

北京趣拿信息技术有限公司与广州市去哪信息技术有限公司不正当竞争纠纷案

案号：

广东省高级人民法院（2013）粤高法民三终字第 565 号

案由：

不正当竞争纠纷案

合议庭成员：

岳利浩 | 喻洁 | 石静涵

关键词：

不正当竞争，知名服务特有名称，域名

相关法条：

《最高人民法院关于审理涉及计算机网络域名民事纠纷案件适用法律若干问题的解释》

基本案情：2005 年 5 月 9 日，庄辰超注册了“qunar.com”域名并创建了“去哪儿”网。北京趣拿信息技术有限公司（以下简称北京趣拿公司）于 2006 年 3 月 17 日经工商登记成立后，“qunar.com”域名由庄辰超（北京趣拿公司法定代表人）转让给公司。经过多年使用，“去哪儿”“去哪儿网”“qunar.com”等服务标识成为知名服务的特有名称。

广州市去哪信息技术有限公司（以下简称广州去哪公司）前身为广州市龙游仙踪旅行社有限公司，成立于 2003 年 12 月 10 日，经营范围与北京趣拿公司相近。2003 年 6 月 6 日，“quna.com”域名登记注册。经过多次转让，苑景恩

(广州去哪公司法定代表人)于2009年5月9日受让取得该域名。2009年5月26日,广州去哪公司经核准变更为现名,“quna.com”域名也随即转让给公司。公司随后注册了“123quna.com”“mquna.com”域名,并使用“去哪”“去哪儿”“去哪网”“quna.com”名义对外宣传和经营。

2011年4月25日,北京趣拿公司以广州去哪公司使用“去哪”“去哪儿”“去哪网”“quna.com”名义对外宣传和经营构成不正当竞争为由,向一审法院提起诉讼,请求判令广州去哪公司停止不正当竞争行为并赔偿经济损失人民币300万元,等。

裁判结果:广州市中级人民法院于2013年6月9日作出(2011)穗中法民三初字第217号民事判决。认为:北京趣拿公司、广州去哪公司均提供旅游网络服务,构成竞争关系。北京趣拿公司使用的商业标记“去哪儿”“去哪儿网”“qunar.com”属于知名服务特有的名称。广州去哪公司使用“去哪”“去哪儿”“去哪网”“quna.com”商业标记的行为构成对北京趣拿公司知名服务特有的名称的侵害。广州去哪公司在其企业字号中使用“去哪”字样的行为构成不正当竞争。广州去哪公司使用“quna.com”“123quna.com”“mquna.com”域名的行为构成对北京趣拿公司域名权益的侵害。一审法院据此判决:

1. 广州去哪公司停止使用“去哪”作为其企业字号;
2. 广州去哪公司停止使用“去哪”“去哪儿”“去哪网”“quna.com”作为其服务标记;
3. 广州去哪公司停止使用“quna.com”“123quna.com”“mquna.com”域名,并限期将上述域名移转给北京趣拿公司;
4. 广州去哪公司赔偿北京趣拿公司经济损失人民币35万元;
5. 驳回北京趣拿公司的其他诉讼请求。

广州去哪公司不服一审判决上诉至广东省高级人民法院。理由是该公司享有的域名“quna.com”是于2003年6月6日合

法登记注册的,是在先权利。该公司受让并使用“quna.com”域名,以及随后注册“123quna.com”“mquna.com”域名没有恶意。

二审法院于2014年3月19日作出二审判决。认为:北京趣拿公司使用的“去哪儿”“去哪儿网”“qunar.com”构成知名服务的特有名称;广州去哪公司使用“去哪”作为企业字号构成不正当竞争行为。但是,广州去哪公司使用域名“quna.com”“123quna.com”“mquna.com”属于对在先权利的使用,有合法依据。二审法院据此维持了一审判决关于广州去哪公司停止使用“去哪”企业字号及“去哪”等标识的判项;撤销了“广州去哪公司停止使用“quna.com”“123quna.com”“mquna.com”域名,并限期将上述域名移转给北京趣拿公司”的判项;并把赔偿数额相应减少为人民币25万元。

裁判理由:

二审的主要争议焦点是广州去哪公司使用域名“quna.com”“123quna.com”“mquna.com”是否有合法依据。

《最高人民法院关于审理涉及计算机网络域名民事纠纷案件适用法律若干问题的解释》第四条规定:“人民法院审理域名纠纷案件,对符合以下各项条件的,应当认定被告注册、使用域名等行为构成侵权或者不正当竞争:

- (一) 原告请求保护的民事权益合法有效;
 - (二) 被告域名或其主要部分构成对原告驰名商标的复制、模仿、翻译或音译;或者与原告的注册商标、域名等相同或近似,足以造成相关公众的误认;
 - (三) 被告对该域名或其主要部分不享有权益,也无注册、使用该域名的正当理由;
 - (四) 被告对该域名的注册、使用具有恶意。”
- 因此,判断广州去哪公司是否构成不正当竞争行为的关键,是看该公司使用域名的行为是否符合上述全部四个要件。

首先,关于使用“quna.com”域名的问题。二审法院认为,广州去哪公司对域名“quna.com”享有合法权益,使用该域名有正当理由,因此不符合上述第三个要件,

广州去哪公司不构成不正当竞争行为。理由是：

(一) 2003年6月6日，“quna.com”域名初次登记注册。而“qunar.com”域名被注册并创建网站的时间是2005年5月9日，较“quna.com”域名初次登记注册的时间要晚将近两年。因此，“quna.com”域名的注册是正当的。“quna.com”域名后经多次转让，于2009年5月9日由苑景恩（广州去哪公司的法定代表人）受让取得，2009年7月3日由广州去哪公司受让取得，这种转让行为亦不违反法律规定。广州去哪公司使用合法受让的“quna.com”域名，法律不应干涉。

(二) 2010年8月27日，北京趣拿公司曾就广州去哪公司的“quna.com”域名向亚洲域名争议解决中心北京秘书处提交投诉书，请求移转广州去哪公司名下的上述域名给北京趣拿公司。专家组认为，投诉人不能同时满足相关《统一域名争议解决政策》规定的三个条件；从而缺乏理由支持“裁决被投诉人将争议域名转移给投诉人”的请求。进一步证明广州去哪公司使用“quna.com”域名有正当理由；

(三) 由于域名有长度和总量限制，故允许近似域名注册，因此北京趣拿公司的“qunar.com”域名与广州去哪公司的“quna.com”域名因仅相差一个字母“r”，虽然构成相近似，但是对于在使用过程中可能产生混淆的情况，双方均有容忍的义务。如果以两个域名在使用过程中产生混淆的结果，反推广州去哪公司使用“quna.com”域名存在恶意，进而推定广州去哪公司取得“quna.com”域名没有正当理由，因此构成不正当竞争行为，不符合推理逻辑。

其次，关于使用“123quna.com”“mquna.com”域名的问题。相较北京趣拿公司的“qunar.com”域名而言，“123quna.com”“mquna.com”域名与广州去哪公司使用的“quna.com”域名更为近似。由于广州去哪公司使用“quna.com”域名有正当理由，随后注册的“123quna.com”“mquna.com”域名也应当允许注册和使用。综

上，广州去哪公司上诉认为该公司使用域名“quna.com”“123quna.com”“mquna.com”有合法依据的理由成立，二审法院依法予以支持。

二审法院同时指出，本案双方当事人均享有来源合法的域名权益，双方需要彼此容忍，互相尊重，长期共存。一方不能因为在经营过程中知名度提升，就剥夺另一方的生存空间；另一方也不能恶意攀附知名度较高一方的商誉，以谋取不正当的商业利益。据此，广州去哪公司虽然有权继续使用“quna.com”“123quna.com”“mquna.com”域名，但是也有义务在与域名相关的搜索链接及网站上加注区别性标识，以使消费者将上述域名与北京趣拿公司“去哪儿”“去哪儿网”“qunar.com”等知名服务特有名称相区分。

G. 商业秘密中客户名单的认定，以及侵权人承担停止侵权民事责任的适用

裁判要旨：

商业秘密中的客户名单不是简单的客户名称，还应包含名单以外影响交易的深度信息。权利人与客户之间的增值税发票、发货清单、汇款凭证、要货通知单、包裹票据等，包含了客户的交易习惯、交易需求、价格承受能力等区别于公知信息的特殊客户信息，具有现实或者潜在的商业价值，构成了经营信息的秘密点，经权利人采取合理保密措施后，构成商业秘密。

鹤壁市反光材料有限公司与宋俊超、鹤壁睿明特科技有限公司、李建发侵害商业秘密纠纷案

案号：

河南省高级人民法院（2016）豫民终347号

案由：

侵害商业秘密纠纷

合议庭成员：

赵 箬 | 赵艳斌 | 焦新慧

关键词：

侵害商业秘密，客户名单，适用停止侵权

相关法条：

《中华人民共和国反不正当竞争法》（1993年）第十条¹

《最高人民法院关于审理不正当竞争民事案件应用法律若干问题的解释》第十六条

基本案情：

上诉人宋俊超、鹤壁睿明特科技有限公司（以下简称睿明特公司）与被上诉人鹤壁市反光材料有限公司（以下简称反光材料公司）、原审被告李建发侵害商业秘密纠纷一案。反光材料公司成立于1996年4月4日，经营范围为反光材料及应用反光材料

制品、镀膜制品、加工销售等。反光材料公司提交了该公司2010年（5页）、2011年（4页）、2012年（4页）、2013年（3页）、2014年（2页）共计18页与东北地区客户的交易记录明细表。包含有“日期”“客户名称”“品种”“规格”“数量”“单价”“收入”“地址”“联系人”“联系电话”“备注”等信息。宋俊超自2006年起在反光材料公司任业务员，主要负责黑龙江省、吉林省、辽宁省及内蒙古自治区的销售及客户拓展工作。反光材料公司与宋俊超先后签订两份劳动合同，并约定有保密条款、竞业限制条款。反光材料公司对其经营信息制定有保密制度，对客户及潜在客户信息采取了必要的保密措施，同时向宋俊超及其他业务员支付了保密费用。之后，反光材料公司发现宋俊超自行购买反光布，向法院申请诉前保全及诉讼，请求查封宋俊超存放的收货人为宋翔的14件反光布，判令宋俊超、睿明特公司、李建发停止侵权，赔偿合理费用及损失50万元。

鹤壁市山城区睿欣反光材料经营部（以下简称睿欣经营部）成立于2006年4月3日，经营者姓名为李建发，联系电话为130xxxxxxx9。鹤壁市睿欣商贸有限公司（以下简称睿欣公司）成立于2011年6月22日，经营范围为钢材、建材、五金交电、涂板、反光护栏。法定代表人两次变更的联系电话均为130xxxxxxx9。2011年11月12日，宋翔办理了该公司经营项目变更，增加的经营项目为：反光材料制品、服装、纺织品、卫生用品、橡胶制品等。2013年8月27日，宋翔办理了睿欣公司法定代表人的变更手续。另外，在睿欣公司经营期间，宋翔还参与了办理营业执照、公司事项变更、提交年检报告等公司工商登记手续的相关工作。睿欣公司于2015年1月19日名称变更为睿明特公司。宋俊超的身份证号码为4106xxxxxxxx1537，宋翔的身份证号码为4106xxxxxxxx7510，两个名字系同一人。号码为130xxxxxxx9的SIM卡由宋俊超使用。宋俊超以宋翔名义先后10次通过郑州德邦物流有限公司鹤壁分公司向东北地区发送货物，货品有“反光布、3纤”等，“反光条、2纤”“布、5纤”等。宋俊超于2014年2月8日通过中铁

¹ 该法于2017年11月4日修订，新法法条为第九条。

股份有限公司鹤壁市营业部向东北地区发送货物。宋俊超先后7次通过上海佳吉快运有限公司鹤壁分公司向东北地区发送货物,货品有“布、3”“布、4”“布、9”等。部分客户名单与反光材料公司客户名单相同。睿欣公司的银行往来账目显示,自2011年8月1日至2015年7月31日期间,睿欣公司与东北地区客户中,与反光材料公司交易客户相重复的客户10户,供货交易38笔,交易金额830,512.50元。宋俊超以个人名义从睿欣公司账户取款27笔,金额为1,270,603.42元。

裁判结果：河南省鹤壁市中级人民法院于2015年12月25日作出(2015)鹤民初字第96号民事判决：判令宋俊超、睿明特公司停止对反光材料公司商业秘密的侵权行为,并在两年内不准使用反光材料公司所拥有的商业秘密,赔偿35万元。一审宣判后,宋俊超、睿明特公司不服,向河南省高级人民法院提起上诉,请求撤销一审判决,驳回反光材料公司的诉讼请求。河南省高级人民法院于2017年8月2日作出(2016)豫民终347号民事判决：驳回上诉,维持原判。

裁判理由：河南省高级人民法院终审认为：

一、关于反光材料公司主张的客户名单是否构成商业秘密

《中华人民共和国反不正当竞争法》第十条规定：“本条所称的商业秘密,是指不为公众所知悉、能为权利人带来经济利益、具有实用性并经权利人采取保密措施的技术信息和经营信息”。本案中,反光材料公司将向东北地区客户出具的增值税发票、发货清单、与客户资金往来汇款凭证、要货通知单、包裹票、出差工作日程表及出差计划上载明的客户信息汇总、整理,形成了包含详细经营信息的客户名单,并为此耗费了大量的时间、金钱和劳动。其中,“成交日期”能够反映客户的要货规律,“品种”“规格”“数量”能够说明客户的独特需求,“单价”能够说明客户对价格的承受能力、价格成交的底线,“备注”反映了客户的特殊信息,

这些内容构成了反光材料公司经营信息的秘密点,体现了反光材料公司特有的客户信息,不能从公开的信息中获取。以上证据符合“不为公众所知悉”的认定条件。反光材料公司提供的交易记录及客户来往票据,涵盖时间长,包含客户众多,这些经营信息具有现实的或者潜在的商业价值,有的已成为有长期业务往来的客户,有的虽未建立业务关系但亦是反光材料公司获得交易机会的重要资源,经营信息的客户已与反光材料公司形成了稳定的供货渠道,保持着良好的交易关系,在生产经营中具有实用性,能够为反光材料公司带来经济利益、竞争优势。以上证据符合“能为权利人带来经济利益、具有实用性”的认定条件。反光材料公司为上述经营信息制定了具体的保密制度,对客户及潜在客户信息采取了必要的保密措施,与宋俊超签订的劳动合同书中明确约定了保密条款、竞业限制条款,反光材料公司也向宋俊超及其他业务员支付了相应的保密费用。以上证据证明了反光材料公司为上述经营信息采取了合理的“保密措施”。综上,反光材料公司制作的客户名单构成商业秘密。

二、关于宋俊超、睿明特公司是否侵犯了反光材料公司的商业秘密

宋俊超自2006年起在反光材料公司任业务员,主要负责黑龙江省、吉林省、辽宁省及内蒙古自治区的销售及客户拓展,对在工作中接触到的关于反光材料公司商业秘密的客户资料等经营信息十分熟知。宋俊超以宋翔名义先后18次向东北地区发送货物,部分货物品名与反光材料类似,部分客户名单也与反光材料公司客户名单相同。因此,可以认定宋俊超擅自与反光材料公司的客户进行交易。宋俊超多次参与睿明特公司营业执照办理、公司事项变更、提交年检报告等工商登记的相关工作,睿明特公司法定代表人经两次变更的联系电话均为宋俊超使用的130xxxxxxx9号码,宋俊超也以个人名义从睿明特公司账户上支取27笔,共计1,270,603.42元款项,综上可以认定宋俊超与睿欣公司存在紧密联系。宋俊超在反光材料公司工作期间,签署了保密协

议，反光材料公司也向其支付了保密费用，宋俊超负有对反光材料公司的忠实义务，包括对工作中接触到的经营信息进行保密的义务。宋俊超应对公司的相关管理规定及客户名单的非公开性、商业价值清楚明了，但仍私自与反光材料公司的客户进行交易，主观上具有侵权故意。宋俊超违反保密约定，披露、使用、允许他人使用反光材料公司经营信息的行为，侵害了反光材料公司的商业秘密。睿明特公司经宋俊超2011年11月12日办理变更经营项目后与反光材料公司的主要经营项目部分重合，在宋俊超与睿明特公司的紧密联系下，睿明特公司与反光材料公司长期联系的客户在较短时间内即发生了业务交易。据睿明特公司的银行往来账目显示，自2011年8月1日至2015年7月31日期间，睿明特公司与东北地区交易客户中，与反光材料公司交易客户部分相同，且交易数额较大，可以认定睿明特公司使用的客户信息与反光材料公司的经营信息存在相同或实质性相同。进而可以认定睿明特公司通过宋俊超实际接触到了反光材料公司的经营信息。结合睿明特公司未举证证明其业务往来系客户自行要求与其交易的事实，可以推定睿明特公司不正当地获取、使用了宋俊超所掌握的反光材料公司所拥有的客户名单与反光材料公司的特定客户进行交易，侵害了反光材料公司对客户名单享有商业秘密的权利，主观上具有共同故意。综上，宋俊超、睿明特公司对反光材料公司的商业秘密构成共同侵权。

三、关于侵权责任如何承担

由于反光材料公司的损失及宋俊超、睿明特公司的获利均无法计算，根据宋俊超、睿明特公司侵权行为的性质、主观过错、交易时间、交易的数量，反光材料公司以往的同类产品交易价格以及为获取客户经营信息付出的努力等因素，酌情确定宋俊超、睿明特公司赔偿反光材料公司35万元。为了避免反光材料公司遭受侵权损害，防止宋俊超、睿明特公司因侵权而继续获利，依照《最高人民法院关于审理不正当竞争民事案件应用法律若干问题的解释》第十六条：“人民法院对于侵犯商业秘密行为判决停止侵害的民事责任时，停止侵害

的时间一般持续到该项商业秘密已为公众知悉时为止。依据前款规定判决停止侵害的时间如果明显不合理的，可以在依法保护权利人该项商业秘密竞争优势的情况下，判决侵权人在一定期限或者范围内停止使用该项商业秘密”之规定，判决宋俊超、睿明特公司立即停止对反光材料公司商业秘密的侵权行为并在两年内不准使用反光材料公司所拥有的商业秘密。

A.

为确保新品种继续生产，判令持父本母本双方当事人相互授权许可

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第五章

植物新品种案件

A. 为确保新品种继续生产，判令持父本母本双方当事人相互授权许可

裁判要旨：

分别持有植物新品种父本与母本的双方当事人，因不能达成相互授权许可协议，导致植物新品种不能继续生产，损害双方各自利益，也不符合合作育种的目的。为维护社会公共利益，保障国家粮食安全，促进植物新品种转化实施，确保已广为种植的新品种继续生产，在衡量父本与母本对植物新品种生产具有基本相同价值基础上，人民法院可以直接判令双方当事人相互授权许可并相互免除相应的许可费。

天津天隆种业科技有限公司与江苏徐农种业科技有限公司侵害植物新品种权纠纷案

案号：

江苏省高级人民法院 (2011) 苏知民终字第 0194 号、(2012) 苏知民终字第 0055 号

案由：

植物新品种权纠纷

合议庭成员：

宋健 | 顾韬 | 袁滔

关键词：

民事，侵害植物新品种权，相互授权许可

相关法条：

《中华人民共和国合同法》第五条
《中华人民共和国植物新品种保护条例》第二条、第六条、第三十九条

基本案情：天津天隆种业科技有限公司（以下简称天隆公司）与江苏徐农种业科技有限公司（以下简称徐农公司）相互

以对方为被告，分别向法院提起两起植物新品种侵权诉讼。

北方杂交粳稻工程技术中心（与辽宁省稻作研究所为一套机构两块牌子）、徐州农科所共同培育成功的三系杂交粳稻 9 优 418 水稻品种，于 2000 年 11 月 10 日通过国家农作物品种审定。9 优 418 水稻品种来源于母本 9201A、父本 C418。2003 年 12 月 30 日，辽宁省稻作研究所向国家农业部提出 C418 水稻品种植物新品种权申请，于 2007 年 5 月 1 日获得授权，并许可天隆公司独占实施 C418 植物新品种权。2003 年 9 月 25 日，徐州农科所就其选育的徐 9201A 水稻品种向国家农业部申请植物新品种权保护，于 2007 年 1 月 1 日获得授权。2008 年 1 月 3 日，徐州农科所许可徐农公司独占实施徐 9201A 植物新品种权。经审理查明，徐农公司和天隆公司生产 9 优 418 使用的配组完全相同，都使用父本 C418 和母本徐 9201A。

2010 年 11 月 14 日，一审法院根据天隆公司申请，委托农业部合肥测试中心对天隆公司公证保全的被控侵权品种与授权品种 C418 是否存在亲子关系进行 DNA 鉴定。检验结论：

利用国家标准 GB/T20396 — 2006 中的 48 个水稻 SSR 标记，对 9 优 418 和 C418 的 DNA 进行标记分析，结果显示，在测试的所有标记中，9 优 418 完全继承了 C418 的带型，可以认定 9 优 418 与 C418 存在亲子关系。

2010 年 8 月 5 日，一审法院根据徐农公司申请，委托农业部合肥测试中心对徐农公司公证保全的被控侵权品种与 C418 和徐 9201A 是否存在亲子关系进行鉴定。检验结论：

利用国家标准 GB/T20396 — 2006 中的 48 个水稻 SSR 标记，对被控侵权品种与 C418 和徐 9201A 的 DNA 进行标记分析，结果显示：在测试的所有标记中，被控侵权品种完全继承了 C418 和徐 9201A 的带型，可以认定被控侵权品种与 C418 和徐 9201A 存在亲子关系。

根据天隆公司提交的 C418 品种权申请请求书，其说明书内容包括：C418 是北方杂粳中心国际首创“籼粳架桥”制恢技术，和利用籼粳中间材料构建籼粳有利基因集团培育出形态倾籼且有特异亲和力的粳型恢复系。C418 具有较好的特异亲和性，这是通过“籼粳架桥”方法培育出来的恢复系所具有的一种性能，体现在杂种一代更好地协调籼粳两大基因组生态差异和遗传差异，因而较好地解决了通常籼粳杂种存在的结实率偏低，籽粒充实度差，对温度敏感、早衰等障碍。C418 具有籼粳综合优良性状，所配制的杂交组合一般都表现较高的结实率和一定的耐寒性。

根据徐农公司和徐州农科所共同致函天津市种子管理站，称其自主选育的中粳不育系徐 9201A 于 1996 年通过，在审定之前命名为“9201A”，简称“9A”，审定时命名为“徐 9201A”。以徐 9201A 为母本先后选配出 9 优 138、9 优 418、9 优 24 等三系杂交粳稻组合。在 2000 年填报全国农作物品种审定申请书时关于亲本的内容仍沿用 1995 年配组时的品种来源 9201A×C418。徐 9201A 于 2003 年 7 月申请农业部新品种权保护，在品种权申请请求书的品种说明中已注明徐 9201A 配组育成了 9 优 138、9 优 418、9 优 24、9 优 686、9 优 88 等杂交组合。徐 9201A 与 9201A 是同一个中粳稻不育系。天隆公司侵权使用 9201A 就是侵权使用徐 9201A。

裁判结果：就天隆公司诉徐农公司一案，南京市中级人民法院于 2011 年 8 月 31 日作出（2009）宁民三初字第 63 号民事判决：

1. 徐农公司立即停止销售 9 优 418 杂交粳稻种子，未经权利人许可不得将植物新品种 C418 种子重复使用于生产 9 优 418 杂交粳稻种子；
2. 徐农公司于判决生效之日起十五日内赔偿天隆公司经济损失 50 万元；
3. 驳回天隆公司的其他诉讼请求。

一审案件受理费 15,294 元，由徐农公司负担。

就徐农公司诉天隆公司一案，南京市中级人民法院于 2011 年 9 月 8 日作出（2010）宁知民初字第 069 号民事判决：

1. 天隆公司于判决生效之日起立即停止对徐农公司涉案徐 9201A 植物新品种权之独占实施权的侵害；
2. 天隆公司于判决生效之日起 10 日内赔偿徐农公司经济损失 200 万元；
3. 驳回徐农公司的其他诉讼请求。

徐农公司、天隆公司不服一审判决，就上述两案分别提起上诉。江苏省高级人民法院于 2013 年 12 月 29 日合并作出（2011）苏知民终字第 0194 号、（2012）苏知民终字第 0055 号民事判决：

1. 撤销江苏省南京市中级人民法院（2009）宁民三初字第 63 号、（2010）宁知民初字第 069 号民事判决。
2. 天津天隆种业科技有限公司于本判决生效之日起十五日内补偿江苏徐农种业科技有限公司 50 万元整。
3. 驳回天津天隆种业科技有限公司、江苏徐农种业科技有限公司的其他诉讼请求。

裁判理由：法院生效裁判认为植物新品种权作为一种重要的知识产权应当受到尊重和保护。《中华人民共和国植物新品种保护条例》第六条明确规定：

“完成育种的单位或者个人对其授权品种，享有排他的独占权。任何单位或者个人未经品种权人许可，不得为商业目的生产或者销售该授权品种的繁殖材料，

不得为商业目的将该授权品种的繁殖材料重复使用于生产另一品种的繁殖材料。”

但需要指出的是，该规定并不适用于本案情形。

首先，9 优 418 的合作培育源于上世纪九十年代国内杂交水稻科研大合作，本身系无偿配组。9 优 418 品种性状优良，在江苏、安徽、河南等地广泛种植，受到广大种植农户的普遍欢迎，已成为中粳杂交水稻的当家品种，而双方当事人相互指控对方侵权，本身也足以表明 9 优 418 品种具有较高的经济价值和市场前景，涉及辽宁稻作所与徐州农科所合作双方以及本案双方当事人的重大经济利益。在二审期间，法院做了大量调解工作，希望双方当事人能够相互授权许可，使 9 优 418 这一优良品种能够继续获得生产，双方当事人也均同意就涉案品种权相互授权许可，但因一审判决令天隆公司赔偿徐农公司 200 万元，徐农公司赔偿天隆公司 50 万元，就其中的 150 万元赔偿差额双方当事人不能达成妥协，故调解不成。天隆公司与徐农公司不能达成妥协，致使 9 优 418 品种不能继续生产，不能认为仅关涉双方的利益，实际上已经损害了国家粮食安全战略的实施，有损公共利益，且不符合当初辽宁稻作所与徐州农科所合作育种的根本目的，也不符合促进植物新品种转化实施的根本要求。从表面上看，双方当事人的行为系维护各自的知识产权，但实际结果是损害知识产权的运用和科技成果的转化。鉴于该两案已关涉国家粮食生产安全等公共利益，影响 9 优 418 这一优良品种的推广，双方当事人在行使涉案植物新品种独占实施许可权时均应当受到限制，即在生产 9 优 418 水稻品种时，均应当允许对方使用己方的亲本繁殖材料，这一结果显然有利于辽宁稻作所与徐州农科所合作双方及本案双方当事人的共同利益，也有利于广大种植农户的利益，故一审判决该两案双方当事人相互停止侵权并赔偿对方损失不当，应予纠正。

其次，9 优 418 是三系杂交组合，综合双亲优良性状，杂种优势显著，其中母本不育系作用重要，而父本 C418 的选育也成功解决了三系杂交粳稻配套的重大问题，在 9 优 418 配组中父本与母本具有相同的地位及作用。法院判决，9 优 418 水稻品种的合作双方徐州农科所和辽宁省稻作研究所及其本案当事人徐农公司和天隆公司均有权使用对方获得授权的亲本繁殖材料，且应当相互免除许可使用费，但仅限于生产和销售 9 优 418 这一水稻品种，不得用于其他商业目的。因徐农公司为推广 9 优 418 品种付出了许多商业努力并进行种植技术攻关，而天隆公司是在 9 优 418 品种已获得市场广泛认可的情况下进入该生产领域，其明显减少了推广该品种的市场成本，为体现公平合理，法院同时判令天隆公司给予徐农公司 50 万元的经济补偿。

最后，鉴于双方当事人各自生产 9 优 418，事实上存在着一定的市场竞争和利益冲突，法院告诫双方当事人应当遵守我国反不正当竞争法的相关规定，诚信经营，有序竞争，确保质量，尤其应当清晰标注各自的商业标识，防止发生新的争议和纠纷，共同维护好 9 优 418 品种的良好声誉。

第六章

集成电路布图设计案件

A. 集成电路布图设计专有权的侵权判定

裁判要旨：

由于集成电路布图设计的创新空间有限，因此在布图设计侵权判定中，对于两个布图设计构成相同或者实质性相似的认定应当采用较为严格的标准。

原告应当对其主张保护的集成电路布图设计具有独创性承担举证责任，原告提供的证据以及所作的说明可以证明其主张保护的布图设计不属于常规设计的，则应当认为原告已经完成初步的举证责任。被告主张相关布图设计是常规设计的，应当提供反证加以证明。

受保护的布图设计中任何具有独创性的部分均受法律保护，而不论其在整个布图设计中的大小或者所起的作用。复制受保护的布图设计的全部或者其中任何具有独创性的部分的行为均构成侵权。

法律并不禁止对他人芯片的布图设计进行摄片进而分析其电路原理的反向工程行为，但是，法律并不允许在反向工程的基础上直接复制他人的布图设计。

钜泉光电科技（上海）股份有限公司与深圳市锐能微科技有限公司、上海雅创电子零件有限公司侵害集成电路布图设计专有权纠纷案

案号：

上海市高级人民法院（2014）沪高民三（知）终字第12号

案由：

侵害集成电路布图设计专有权纠纷

合议庭成员：

丁文联 | 马剑峰 | 徐卓斌

关键词：

集成电路、复制、实质性相似、独创性、反向工程

相关法条：

《集成电路布图设计保护条例》第二条、第三条第一款、第四条、第七条、第二十三条、第三十条、第三十三条第一款

基本案情：在上诉人（原审原告）钜泉光电科技（上海）股份有限公司（以下简称钜泉公司）与上诉人（原审被告）深圳市锐能微科技有限公司（以下简称锐能微公司）、原审被告上海雅创电子零件有限公司（以下简称雅创公司）侵害集成电路布图设计专有权纠纷案中，钜泉公司于2008年3月1日完成名称为“ATT7021AU”的布图设计创作，同年进行布图设计登记。该集成电路布图设计登记的图样共有16层，登记文件中的“ATT7021AU 集成电路布图设计结构、技术、功能简要说明”记载：

1. 达成业界相同芯片（单相电能计量）功能/性能最优化面积的版图设计诉求；
2. 数模混合高抗干扰/高静电保护芯片版图设计；
3. 采用电路设计技术和金属层、扩散层、信号流合理布局等版图技术实现灵敏信号噪声屏蔽，大小信号干扰隔离。

国家知识产权局专利复审委员会经审查，未发现钜泉公司涉案布图设计专有权存在不符合《集成电路布图设计保护条例》（以下简称《条例》）规定可以被撤销的缺陷，故终止了锐能微公司提出的撤销程序。

2010年1月20日，钜泉公司经公证在雅创公司经营场所购买集成电路芯片100

片，该芯片显示的型号为 RN8209G。微创公司确认该芯片系其销售，锐能微公司确认 RN8209、RN8209G 芯片系其制造、销售。锐能微公司网站中显示：2010 年 9 月 RN8209 销售量突破 1000 万片。从锐能微公司查封的部分增值税专用发票显示销售 RN8209G 芯片共计 1120 片，单价大多在 5.50 元至 4.80 元之间，有 1 张发票显示单价约为 2 元；销售 RN8209 芯片共计 6610 片，单价在 4.80 元至 4.20 元之间。

北京紫图知识产权司法鉴定中心（以下简称紫图鉴定中心）接受上海市第一中级人民法院委托进行司法鉴定，鉴定结论为：

1. RN8209、RN8209G 与原告主张的独创点 5（数字地轨与模拟地轨衔接的布图）相同；
2. RN8209、RN8209G 与原告主张的独创点 7（模拟数字转换电路的布图）中第二区段独立升压器电路的布图相同；
3. 依据现有证据应认定上述 1、2 点具有独创性，不是常规设计。

2006 年，钜泉公司分别与陈强、赵琮签订劳动合同和保密合同，钜泉公司聘用陈强为销售经理，聘用赵琮在研发部门从事 IC 设计工作。后陈强至锐能微公司担任总经理，赵琮亦至锐能微公司任职。庭审中，赵琮陈述称：在钜泉公司看到过钜泉公司的 ATT7021AU 集成电路布图设计；锐能微公司没有对钜泉公司 ATT7021AU 芯片进行反向工程。

原告认为，两被告的行为侵犯其集成电路布图设计专有权，遂诉至法院，请求判令两被告停止侵权、公开赔礼道歉、赔偿经济损失人民币 1500 万元。

裁判结果：上海市第一中级人民法院于 2013 年 12 月 24 日一审判决：锐能微公司立即停止侵害钜泉公司享有的 ATT7021AU（登记号为 BS.08500145.7）集成电路布图设计专有权；锐能微公司赔偿钜泉公司经济损失以及为制止侵权行为所支付的合理开支共计人民币 320 万元；驳回钜泉公司的其余诉讼请求。钜泉

公司、锐能微公司均不服一审判决，向上海市高级人民法院提起上诉。上海市高级人民法院于 2014 年 9 月 23 日二审判决驳回上诉，维持原判。

裁判理由：上海市高级人民法院认为：

一、涉案 RN8209、RN8209G 芯片的相应布图设计与钜泉公司 ATT7021AU 集成电路布图设计中的“数字地轨与模拟地轨衔接的布图”和“独立升压器电路布图”是否相同

由于集成电路布图设计的创新空间有限，因此在布图设计侵权判定中对于两个布图设计构成相同或者实质性相似的认定应当采用较为严格的标准。涉案 RN8209、RN8209G 芯片的“数字地轨与模拟地轨衔接的布图”“独立升压器电路布图”的主要特征与钜泉公司“数字地轨与模拟地轨衔接的布图”“独立升压器电路布图”的主要特征均一一对应相同。虽然在考虑 M2 层后，双方布图设计中一条布线的走向会有区别，但是布线与互连的元件之间组合的三维配置并未实质性改变。至于锐能微公司主张的衔接处位置、轨的宽度、具体布图的布局、尺寸、形状的差异以及 M1、M2、M3 层以及 PL 层的 MOS 管尺寸等不同，均属于细微的、次要的差异，也未实质性改变布线与互连的元件之间组合的三维配置，而 ST 层的不同是双方使用不同工艺造成的，上述不同点均不足以改变两者布图设计实质性相似的判断。因此，本案中，即使按照较为严格的判定标准，锐能微公司涉案 RN8209、RN8209G 芯片的相应布图设计也与钜泉公司 ATT7021AU 集成电路布图设计中的“数字地轨与模拟地轨衔接的布图”和“独立升压器电路布图”构成实质性相似。

二、钜泉公司 ATT7021AU 集成电路布图设计中的“数字地轨与模拟地轨衔接的布图”和“独立升压器电路布图”是否具有独创性

根据《条例》第四条的规定，布图设计具有独创性，是指该布图设计是创作者自己的智力劳动成果，并且在其创作时该

版图设计在版图设计创作者和集成电路制造者中不是公认的常规设计。并且，钜泉公司应当对其主张保护的集成电路版图设计具有独创性承担举证责任，但是钜泉公司并无必要也不可能穷尽所有的相关常规版图设计来证明其主张保护的版图设计属于非常规设计。只要钜泉公司提供的证据以及所作的说明可以证明其主张保护的版图设计不属于常规设计的，则应当认为钜泉公司已经完成了初步的举证责任。在此情况下，锐能微公司主张相关版图设计是常规设计的，则锐能微公司只要能够提供一份相同或者实质性相似的常规版图设计，即足以推翻钜泉公司关于非常规设计的主张。本案中，钜泉公司对于 ATT7021AU 集成电路版图设计中的“数字地轨与模拟地轨衔接的版图”“独立升压器电路版图”具有独创性的主张，已经提供《集成电路版图设计登记证书》、专利复审委员会认为不存在被撤销缺陷的决定以及鉴定结论等证据完成了初步的举证责任。在此情况下，锐能微公司提供的证据，或者是电路原理图，或者是特征点与钜泉公司版图设计并不相同的版图设计，尚不足以证明钜泉公司 ATT7021AU 集成电路版图设计中的“数字地轨与模拟地轨衔接的版图”“独立升压器电路版图”是常规设计。因此，可以认定钜泉公司的“数字地轨与模拟地轨衔接的版图”和“独立升压器电路版图”具有独创性。

三、锐能微公司生产、销售涉案 RN8209、RN8209G 芯片的行为是否侵犯钜泉公司享有的 ATT7021AU 集成电路版图设计专利权

根据《条例》第三十条的规定，复制受保护的版图设计的全部或者其中任何具有独创性的部分的行为均构成侵权。由此可见，受保护的版图设计中任何具有独创性的部分均受法律保护，而不论其在整个版图设计中的大小或者所起的作用。本案所涉“数字地轨与模拟地轨衔接的版图”“独立升压器电路版图”存在常规的版图设计，锐能微公司完全可以使用该些常规设计；或者，可以通过自行研发创作出具有独创性的不同的版图设计。但是，锐能微公司没有采取上述做法，而是直接复制钜泉公司 ATT7021AU 集成电路版图设计中具有

独创性的“数字地轨与模拟地轨衔接的版图”“独立升压器电路版图”用于制造涉案 RN8209、RN8209G 芯片并进行销售，其行为已经构成侵权。

实现相同或相似功能的芯片必然在电路原理上存在相似性，而电路原理不属于《条例》规定可赋予专有权的部分，因此法律并不禁止对他人芯片的版图设计进行摄片进而分析其电路原理的反向工程行为。但是，法律并不允许在反向工程的基础上直接复制他人的版图设计，因为这将大幅度减少竞争对手在时间和成本上的投入，从而极大地削弱被模仿企业的竞争优势，最终将降低整个集成电路行业创新的积极性。本案中，锐能微公司之所以对钜泉公司 ATT7021AU 集成电路版图设计进行部分复制，既不是为个人目的，亦不是单纯为评价、分析、研究、教学等目的，而是为了研制新的集成电路以进行商业利用；锐能微公司认可其并非通过反向工程获得钜泉公司 ATT7021AU 集成电路版图设计；锐能微公司未经许可直接复制了钜泉公司 ATT7021AU 集成电路版图设计中具有独创性的“数字地轨与模拟地轨衔接的版图”和“独立升压器电路版图”用于制造涉案 RN8209、RN8209G 芯片并进行销售。因此，无论锐能微公司涉案 RN8209、RN8209G 芯片的版图设计是否具有独创性，其行为均不适用《条例》第二十三条的规定。

综上，锐能微公司认可其接触了钜泉公司的 ATT7021AU 集成电路版图设计。现锐能微公司未经钜泉公司许可，在其生产、销售的涉案 RN8209、RN8209G 芯片中包含了钜泉公司 ATT7021AU 集成电路版图设计中具有独创性的“数字地轨与模拟地轨衔接的版图”和“独立升压器电路版图”，其行为已经侵犯了钜泉公司 ATT7021AU 集成电路版图设计专利权，应当承担相应的民事责任。

四、一审法院确定的赔偿数额是否合理

由于锐能微公司拒绝提供其财务资料，可以将钜泉公司主张的锐能微公司在其网站页面显示的 1000 万片的销售数量作为本案赔偿数额的计算依据；本案中，双方均

未提交证据证明被控侵权产品的销售利润；鉴定报告明确钜泉公司主张的其余独创性部分双方并不相同或实质性相似，故钜泉公司以其余模块双方亦存在相同部分为由要求锐能微公司以全部获利进行赔偿的主张，缺乏依据；“数字地轨与模拟地轨衔接的布图”和“独立升压器电路布图”在被控侵权芯片中所起的作用确非核心和主要作用且所占的布图面积确实较小；通过直接复制钜泉公司的“数字地轨与模拟地轨衔接的布图”和“独立升压器电路布图”，锐能微公司节约了自行研发的投入，缩短了芯片研发时间，并据此获得了市场竞争优势，因此也不能完全按照该两项布图在芯片中所占的比例来确定赔偿数额。综上，上海市第一中级人民法院根据本案实际情况判决锐能微公司赔偿钜泉公司包括合理支出在内的经济损失人民币 320 万元，并无不当。

A.
销售记录刷信誉行为的辩解无以证实,
不予采信

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第七章

知识产权刑事案件

A. 销售记录刷信誉行为的辩解无以证实，不予采信

裁判要旨：

假冒注册商标犯罪的非法经营数额、违法所得数额，可以综合考虑被告人供述、证人证言、被害人陈述、网络销售电子数据、被告人银行账户往来记录、送货单、快递公司电脑系统记录、被告人等所作记账等证据认定。被告人辩解称网络销售记录存在刷信誉的不真实交易，但无证据证实的，对其辩解不予采纳。

郭明升、郭明锋、孙淑标假冒注册商标案

案号：

江苏省宿迁市中级人民法院（2015）宿中知刑初字第0004号

案由：

假冒注册商标

合议庭成员：

程黎明 | 朱庚 | 白金

关键词：

刑事，假冒注册商标罪，非法经营数额，网络销售

相关法条：

《中华人民共和国刑法》第二百一十三条

基本案情：公诉机关指控：2013年11月底至2014年6月期间，被告人郭明升为谋取非法利益，伙同被告人孙淑标、郭明锋在未经三星（中国）投资有限公司授权许可的情况下，从他人处批发假冒三星手机裸机及配件进行组装，利用其在淘

宝网上开设的“三星数码专柜”网店进行“正品行货”宣传，并以明显低于市场价格公开对外销售，共计销售假冒的三星手机20,000余部，销售金额2000余万元，非法获利200余万元，应当以假冒注册商标罪追究其刑事责任。被告人郭明升在共同犯罪中起主要作用，系主犯。被告人郭明锋、孙淑标在共同犯罪中起辅助作用，系从犯，应当从轻处罚。

被告人郭明升、孙淑标、郭明锋及其辩护人对其未经“SAMSUNG”商标注册人授权许可，组装假冒的三星手机，并通过淘宝网进行销售的犯罪事实无异议，但对非法经营额、非法获利提出异议，辩解称其淘宝网存在请人刷信誉的行为，真实交易量只有10,000多部。

法院经审理查明：“SAMSUNG”是三星电子株式会社在中国注册的商标，该商标有效期至2021年7月27日；三星（中国）投资有限公司是三星电子株式会社在中国投资设立，并经三星电子株式会社特别授权负责三星电子株式会社名下商标、专利、著作权等知识产权管理和法律事务的公司。2013年11月，被告人郭明升通过网络中介购买店主为“汪亮”、账号为play2011-1985的淘宝店铺，并改名为“三星数码专柜”，在未经三星（中国）投资公司授权许可的情况下，从深圳市华强北远望数码城、深圳福田区通天地手机市场批发假冒的三星I8552手机裸机及配件进行组装，并通过“三星数码专柜”在淘宝网上以“正品行货”进行宣传、销售。被告人郭明锋负责该网店的客服工作及客服人员的管理，被告人孙淑标负责假冒的三星I8552手机裸机及配件的进货、包装及联系快递公司发货。至2014年6月，该网店共计组装、销售假冒三星I8552手机20,000余部，非法经营额2000余万元，非法获利200余万元。

裁判结果：江苏省宿迁市中级人民法院于2015年9月8日作出（2015）宿中知刑初字第0004号刑事判决，以被告人郭明升犯假冒注册商标罪，判处有期徒刑五年，并处罚金人民币160万元；被告人孙淑标犯假冒注册商标罪，判处有期徒刑三年，缓刑五年，并处罚金人民币20万元。被告人郭明锋犯假冒注册商标罪，判处有期徒刑三年，缓刑四年，并处罚金人民币20万元。宣判后，三被告人均没有提出上诉，该判决已经生效。

裁判理由：法院生效裁判认为，被告人郭明升、郭明锋、孙淑标在未经“SAMSUNG”商标注册人授权许可的情况下，购进假冒“SAMSUNG”注册商标的手机机头及配件，组装假冒“SAMSUNG”注册商标的手机，并通过网店对外以“正品行货”销售，属于未经注册商标所有人许可在同一种商品上使用与其相同的商标的行为，非法经营数额达2000余万元，非法获利200余万元，属情节特别严重，其行为构成假冒注册商标罪。

被告人郭明升、郭明锋、孙淑标虽然辩解称其网店销售记录存在刷信誉的情况，对公诉机关指控的非法经营数额、非法获利提出异议，但三被告人在公安机关的多次供述，以及公安机关查获的送货单、支付宝向被告郭明锋银行账户付款记录、郭明锋银行账户对外付款记录、“三星数码专柜”淘宝记录、快递公司电脑系统记录、公安机关现场扣押的笔记等证据之间能够互相印证，综合公诉机关提供的证据，可以认定公诉机关关于三被告人共计销售假冒的三星I8552手机20,000余部，销售金额2000余万元，非法获利200余万元的指控能够成立，三被告人关于销售记录存在刷信誉行为的辩解无证据予以证实，不予采信。被告人郭明升、郭明锋、孙淑标，系共同犯罪，被告人郭明升起主要作用，是主犯；被告人郭明锋、孙淑标在共同犯罪中起辅助作用，是从犯，依法可以从轻处罚。

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