

FINNEGAN

2009 The 5th IP China Intellectual Property Summit Forum
2009第五届中国IP China知识产权峰会
南京, 2009年12月18-19日

U.S. Patent Infringement Litigation
The Problem of Foreign Parts Suppliers
美国专利侵权诉讼
外国零部件供应商所面临的问题

By: Erik Puknys

© Finnegan, Henderson, Farabow, Garrett & Dunner, LLP

The Problem Facing Foreign Parts Suppliers
外国零部件供应商所面临的问题

Two scenarios

1. U.S. buyer manufacturing final products overseas
2. Foreign buyer manufacturing final products overseas

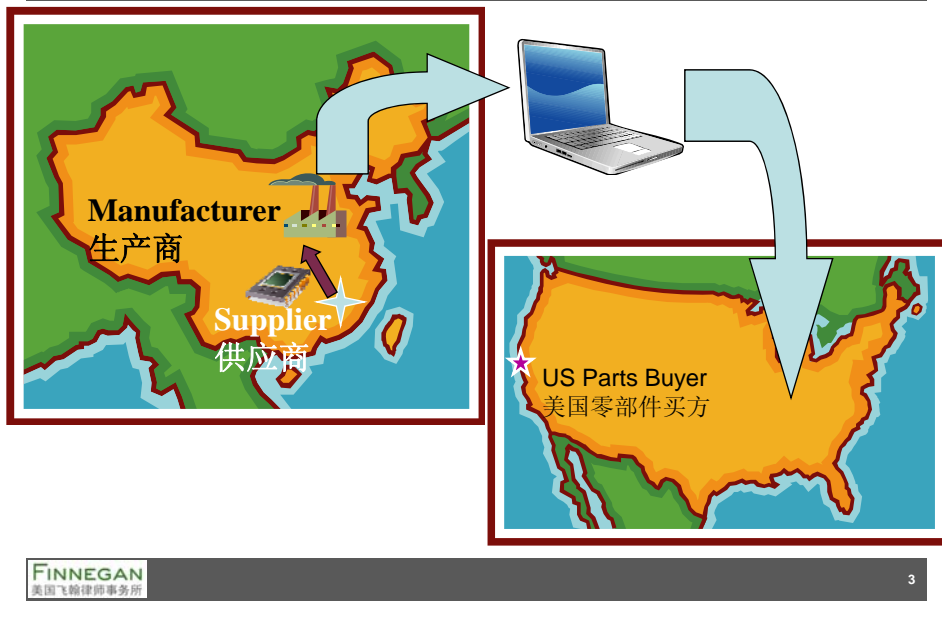
两种情况

1. 美国买方在海外进行最终产品生产
2. 其他外国买方在海外进行最终产品生产

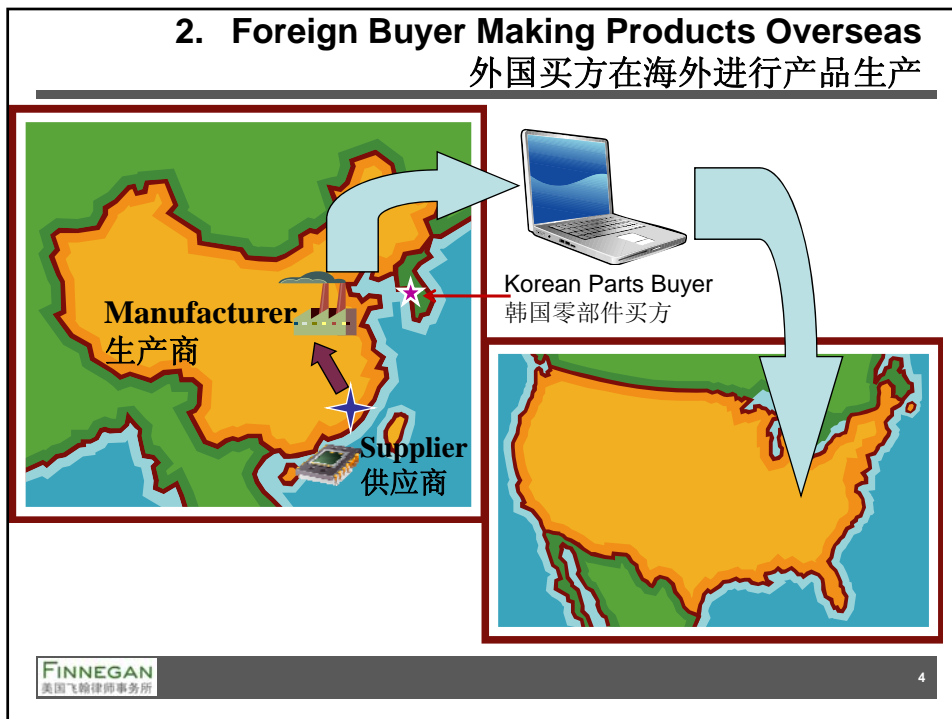
FINNEGAN
美国飞翰律师事务所

2

1. U.S. Buyer Making Products Overseas 美国买方在海外进行产品生产



2. Foreign Buyer Making Products Overseas 外国买方在海外进行产品生产



Can You Be Sued in the United States? Where? 您会在美国遭到起诉吗？ 司法管辖地为何处？

- Jurisdiction
 - General Jurisdiction
 - You have “extensive and continuing” contacts with the district
 - You have benefitted from transacting business in the district and you should be expected to consent to be sued here also
- 司法管辖权
 - 普通管辖权
 - 您同该地区具有“广泛且持续”的联系
 - 您从在该地区所进行的商业活动中获利，并且被认为会同同意在该地区被提起诉讼

Can You Be Sued in the United States? Where? 您会在美国遭到起诉吗？ 司法管辖地为何处？

- Jurisdiction
 - Specific Jurisdiction
 - The lawsuit is based on an injury allegedly caused by actions you took that were directed at the district
 - Courts have found that sales made to companies that the defendant knew or should have known would sell in the district suffice
 - Many states have additional requirements (set out in “long-arm statutes”)
- 司法管辖权
 - 专属管辖权
 - 诉讼依据：被控损害是否是由您对该地区有指向性的活动所引起的
 - 如果法院认为被告知晓或本应知晓该等公司会在该地区从事销售活动，但被告仍将侵权产品向其出售的话，这样就构成该地区专属管辖的充分理由
 - 许多州有其它要求（详见“长臂法案”规定）

Is Foreign Supplier Liable if Part Infringes? **如果零部件侵权，外国供应商是否需要承担责任？**

- Yes, if the buyer is sued and the foreign supplier has agreed to indemnify or is required by law to indemnify the buyer
- But often the patent owner wants to sell its own parts to the buyer, so it will not want to sue the buyer
- Can the patentee sue the foreign parts supplier instead?

- 如果买方遭到起诉, 外国供应商同意, 或者根据法律规定必须, 向买方提供赔偿
- 但是专利所有人往往希望将其零部件出售给买方, 因此, 一般不会起诉买方
- 专利权人能够转而起诉外国零部件供应商吗?

Is Foreign Supplier Liable if Part Infringes? **如果零部件侵权，外国供应商是否需要承担责任？**

- Direct or contributory infringement
 - Foreign supplier does not sell, use, manufacture, or import part in the U.S.
 - Be careful of sending samples to the U.S. for customer testing or for display at trade shows!

- 直接或辅助侵权
 - 外国供应商没有在美国销售、使用、生产零部件或将其进口到美国
 - 将样品寄到美国供客户检测或参展时, 应非常小心

Is Foreign Supplier Liable if Part Infringes? **如果零部件侵权，外国供应商是否需要承担责任？**

- Direct or contributory infringement
 - What if the foreign supplier’s sales representatives traveled to the U.S. to interest the U.S. buyer in the part and negotiated the contract in the U.S. ?

- 直接或辅助侵权
 - 如果外国供应商的销售代表到美国，美国买方对零部件具有购买意向，并在美国进行合同洽谈，则情况如何？

Is Foreign Supplier Liable if Part Infringes? **如果零部件侵权，外国供应商是否需要承担责任？**

- Is that an infringing “offer for sale”?
 - The Federal Circuit has never decided whether an “offer for sale” constitutes direct infringement if the contemplated sale is to take place outside the U.S.
 - District courts go both ways.

- 这是否构成侵权的“许诺销售”？
 - 联邦巡回法院从来没有就以下问题做出决定：如果预期销售发生在美国境外，“许诺销售”是否构成直接侵权
 - 不同地方法院则可能有不同裁定

Induced Infringement

诱导侵权

- 35 U.S.C. § 271(b): “Whoever actively induces infringement of a patent shall be liable as an infringer.”
- A party that induces or contributes to infringement is **jointly and severally liable** with the direct infringer for all general damages. See *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, (Fed. Cir. 1990).
- 美国法典35章271(b)条：“任何人若积极诱导他人侵犯专利权，则应作为侵权人承担法律责任。”
- 诱导或辅助侵权的当事方应与直接侵权人一起，就一般损害赔偿金承担**共同与连带责任**。参阅 *Hewlett-Packard Co. v. Bausch & Lomb Inc.* 案，909 F.2d 1464, 1469，（联邦巡回法院，1990年）

Elements of Induced Infringement

诱导侵权的构成要素

1. Inducing Act + Intent
 2. Direct Infringement
-
1. 诱导行为+意图
 2. 直接侵权

Elements of Inducement – Affirmative Act 诱导的构成要素—确认行为

- There must be an **affirmative act** of inducement such as licensing others, designing the infringing product or process, advertising, labeling or providing instructions or directions
- No inducement liability from failure to take legal or other steps to prevent infringement by another. *Tegal Corp. v. Tokyo Electron Co., Ltd.*, 248 F.3d 1376 (Fed Cir. 2001)
- 必须存在诱导的**确认行为**，如向他人授予许可、设计侵权产品或方法、进行广告宣传、贴标签或提供说明或指导。
- 若已采取法律程序或其它措施阻止他人侵权行为，但并未成功，则无需承担诱导侵权责任。*Tegal Corp. 诉 Tokyo Electron Co., Ltd.*案，248 F.3d 1376（联邦巡回法院，2001年）

The Problem of Foreign Suppliers 外国供应商所面临的问题

- Can a foreign supplier be liable for inducing infringement when all of its allegedly inducing acts occur overseas?
- Does the patentee have to show that the alleged inducer caused the foreign manufacturer to sell its products in the United States?
- 如果所有被控诱导行为发生在海外，外国供应商是否需要诱导侵权承担责任？
- 专利权人是否有责任证明：被控诱导者促使外国生产商在美国出售其产品？

The Problem of Foreign Suppliers 外国供应商所面临的问题

- Can a foreign supplier be liable for inducing infringement when all of its allegedly inducing acts occur overseas?
 - Never directly addressed by the Federal Circuit.
 - *MEMC Electronic Matls., Inc. v. Mitsubishi Silicon Corp.*, 420 F.3d 1369, 1379 (Fed. Cir. 2005) (“We therefore need not address whether inducing activity in Japan can give rise to liability under United States patent laws.”)

- 如果所有被控诱导行为发生在海外，外国供应商是否需要诱导侵权承担责任？
 - 联邦巡回法院从未直接裁定这一问题
 - *MEMC Electronic Matls., Inc. 诉 Mitsubishi Silicon Corp.* 案，420 F.3d 1369, 1379（联邦巡回法院 2005年）（“因此我们无须根据美国专利法说明在日本发生的诱导活动是否应承担责任的。”）

The Problem of Foreign Suppliers 外国供应商所面临的问题

- Most district courts have answered this question “yes” as long as the foreign supplier knew or should have known the final products would be sold in the U.S.

- 大多数地方法院对这个问题的回答是“是” - 只要外国供应商知道或应该知道最终产品会在美国进行销售,则对诱导侵权承担责任

The Problem of Foreign Suppliers 外国供应商所面临的问题

- Does the patentee have to show that the alleged inducer caused the foreign manufacturer to sell its products in the United States?
- Again, the Federal Circuit has not directly addressed this issue, but the *MEMC* decision suggests the answer is “yes”
- 专利权人是否有责任证明：被控诱导者促使外国生产商在美国出售其产品？
- 同样，联邦巡回法院也从未直接裁定这一问题，但从 *MEMC* 案判决来看，法院认为专利权人有该等责任

The Problem of Foreign Suppliers 外国供应商所面临的问题

- *MEMC*, 420 F.3d at 1380:
Finding there was “sufficient circumstantial evidence for a reasonable jury to conclude that SUMCO was not only aware of the potentially infringing activities in the United States by Samsung Austin, but also that SUMCO intended to encourage those activities.”
- *MEMC*案，420 F.3d 1380页：
“其结果是，有充分详细的间接证据使一个理性的陪审团得出结论，即SUMCO不仅知道Samsung Austin在美国进行潜在侵权活动，而且还有意鼓励这些活动。”

The Problem of Foreign Suppliers 外国供应商所面临的问题

- Potentially inducing acts in MEMC:
 - Technical support to U.S. customer via e-mail
 - Shipping replacement products directly to U.S. customer
 - Technical presentations in the U.S.

- MEMC的潜在诱导行为:
 - 通过电子邮件为美国客户提供技术支持
 - 直接将更换产品发送给美国客户
 - 在美国进行技术演示

The Problem of Foreign Suppliers 外国供应商所面临的问题

Semiconductor Energy Lab. Co. Ltd. v. Chi Mei Optoelectronics Corp., 531 F. Supp. 2d 1084 (N.D. Cal. 2007)

Inducing acts:

- (1) Repair & return centers in the U.S.,
- (2) providing technical support in the U.S.,
- (3) shipping products directly to U.S. customers in order to address technical problems of pre-existing products,

*Semiconductor Energy Lab. Co. Ltd. 诉 Chi Mei Optoelectronics Corp.*案, 531 F. Supp. 2d 1084 (加利福尼亚州北区联邦地方法院, 2007年)

诱导行为:

- (1) 在美国设立维修和退货中心,
- (2) 在美国提供技术支持,
- (3) 直接将产品发送给美国客户, 以说明先前产品的技术问题,

The Problem of Foreign Suppliers 外国供应商所面临的问题

Semiconductor Energy Lab. Inducing acts:

- (4) on-site technical presentations in the U.S.,
- (5) adjustments in the manufacturing process to accommodate U.S. customer concerns, and
- (6) coordinating shipping to the U.S. via e-mail.

Semiconductor Energy Lab. 诱导行为

- (4) 在美国进行现场技术演示，
- (5) 调整生产工艺，以满足美国客户的要求，并
- (6) 通过电子邮件，协调将货物发送至美国的事宜。

The Problem of Foreign Suppliers 外国供应商所面临的问题

Power Integrations, Inc. v. Fairchild Semiconductor Int'l, Inc.,
589 F.Supp.2d. 505 (D. Del. 2008)

Induced infringement liability where:

- (1) Fairchild indemnified its largest off-shore customers for potential infringement in the U.S.

Power Integrations, Inc. 诉 Fairchild Semiconductor Int'l, Inc.
案，589 F.Supp.2d. 505（特拉华州联邦地方法院，
2008年）

诱导侵权责任：

- (1) Fairchild就美国的潜在侵权活动，向其最大的离岸客户提供赔偿

The Problem of Foreign Suppliers 外国供应商所面临的问题

- (2) Companies like Samsung imported Fairchild's accused devices into the U.S., and Fairchild was aware of this importation
- (3) Although they were manufactured overseas, 18% of Fairchild's infringing products are imported into the U.S.
- (2) Samsung等公司将Fairchild的被控产品进口到美国，并且Fairchild知道此类进口行为的存在
- (3) 尽管Fairchild在海外进行产品生产，但其18%的侵权产品最终会进口到美国

The Problem of Foreign Suppliers 外国供应商所面临的问题

Power Integrations

BUT:

“the Court also agrees with Fairchild that acceptance of this figure necessarily means that 82% are not imported into the United States”

*Power Integrations*案

但是:

“法院赞同Fairchild的以下观点：接受这一数字必然意味着另外82%的产品没有进口到美国”

The Problem of Foreign Suppliers 外国供应商所面临的问题

- (1) Accordingly, the Court will reduce the jury's damages award by 82%, representing that portion of the infringing products not imported into the United States
- (2) Damages award lowered from \$33 million to \$6 million

Decision on appeal.

- (1) 相应地，法院将陪审团判付的损害赔偿金数额减少了82%，以体现该部分侵权产品未进口到美国
- (2) 损害赔偿金因此从3300万美元减少到600万美元

上诉判决。

Thank you 谢谢!

Contact Information:
联络方式:

Erik Puknys (Palo Alto,
CA)
(650) 849-6644
erik.puknys@finnegan.com