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*On April 20, 2017, Beijing High People's Court issued new "Guidelines for Patent Infringement Determination".*

## **Guidelines for Patent Infringement Determination by Beijing High People's Court**

The Beijing High People's Court issued the new Guidelines for Patent Infringement Determination ("the new Guidelines") on 20 April 2017, replacing the previous guidelines issued on 4 Sep 2013 ("the 2013 Guidelines"). The new Guidelines include six sections with 153 articles:

1. Determination of protection scope of the patent for invention or utility model,
2. Determination of infringement on the patent for invention and utility model,
3. Determination of protection scope of the patent for design,
4. Determination of infringement of patent for design,
5. Determination of acts of patent infringement, and
6. Defense of patent infringement.

Notable changes in the new Guidelines include article 42 (related to "literal infringement") and article 56 (related to "equivalent infringement" or "infringement under doctrine of equivalents (DOE)"), on functional features or functional limitations in a claim and on the judging time for infringement under DOE. These two articles are substitutions for article 39 and article 54 in the 2013 Guidelines.

For literal infringement regarding functional features, in the framework of the 2013 Guidelines, the accused technical solution does not literally infringe unless the function, the steps and the structures that perform the function in the accused technical solution are identical to their counterparts in the patent. In the new Guidelines, by contrast, the accused technical solution may literally infringe even though there are differences in the structural and step features. The accused technical solution is deemed as comprising identical structural and step features with the functional features in the claim, as long as the structural and step features in the accused technical solution perform the same function and achieve the same effect with the same or substantially the same technical means, and can be envisaged, without inventive efforts, by a person skilled in the art on the filing date.

Regarding article 56 in the new Guidelines, the judging time of equivalent infringement to claims with functional features is changed from the patent application date to the time when the accused act occurs. Therefore, interchangeable features emerging after the filing date can be considered, which broadens the scope of claims with functional features.

Infringement under the Doctrine of Equivalents (DOE) in the new Guidelines in China now more closely follows the legal standard of infringing under the DOE in the U.S. Both countries require a triple-identity test to determine equivalents. In the US, this test amounts to determining whether the accused infringing device performs substantially the same function, in substantially the same way, to yield substantially the same result. The US, however, limits such equivalents to “foreseeable” equivalents. We will have to follow the Chinese court opinions to see if China also limits equivalents in this regard. In the US, the DOE is also limited by claim amendments and arguments that the patent owner makes during prosecution (a process known as prosecution history estoppel). Such principle exists in China but it remains to be seen to what extent the Chinese courts will also adopt this limitation on DOE in China.

Eagle IP will keep abreast of the changes in the new Guidelines and provide updates in subsequent newsletters. The full text of new Articles 42 and 56 are provided below and compared with the 2013 Guidelines in the following table:

the 2013 Guidelines	the new Guidelines
<p>39. For the claims including functional features, if identical functions of the features are realized in the alleged infringing technical solution, and structures and steps realizing the functions are identical to the structures and steps defined by the description of the preferred embodiments recorded in the patent description, the alleged infringing technical solution shall fall into the scope of protection of the patent right.</p>	<p>42. In respect of a claim comprising functional features, compared with the structural and step features prescribed in Article 19 of the Guidelines, the corresponding structural and step features of the accused technical solution achieve the same function and generate the same effect by the same means, or, despite the differences, achieve the same function and generate the same effect by substantially the same means, and can be envisaged by a person with ordinary skills in the art at the filing date of the patent without making inventive effort, it shall be determined that the corresponding structural and step features are identical with the functional features.</p> <p>When judging whether the structural and step features constitute identical features, the structural and step features shall be regarded as one technical feature, rather than be divided into two or more technical features.</p>

<p>54. For the claims including functional features, if not only the corresponding technical features of the alleged infringing technical solution realize the same functions, but also the structures, and steps for realizing the functions equal the structures and steps determined in the preferred embodiments of the description of the patent, such features shall be deemed as equivalent features.</p> <p>Judging time of the equivalents above shall be <u>the patent application date</u>.</p>	<p>56. In respect of a claim comprising functional features, compared with the structural and step features prescribed in Article 19 of the Guidelines, the corresponding structural and step features of the accused technical solution achieve the same function and generate the same effect by substantially the same means, which can be envisaged by a person with ordinary skills in the art during the period <u>from the filing date of the patent in suit till the date when the accused act takes place without making inventive effort</u>, it shall be determined that the corresponding structural and step features are equivalent to the functional features.</p> <p>When judging whether the structural and step features constitute equivalent features, the structural and step features shall be regarded as one technical feature, rather than be divided into two or more technical features.</p>
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If you have any questions or would like more information, please contact us at [eip@eipgroup.asia](mailto:eip@eipgroup.asia).

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