

知识产权的保护及技术合同： 最佳做法

INTELLECTUAL PROPERTY PROTECTION and LICENSING: Best Practices

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简介 - Introduction

- Commercialization of technology needs a business plan and a budget
- 技术的商业化需要有一个商业计划以及预算
- Part of the plan and budget should be devoted to protection of the intellectual property
- 计划以及预算的一部分应关注于知识产权的保护
- Part of the plan and budget should be devoted to contracts required
- 计划以及预算的一部分应关注于所需合同的签订

简介 - Introduction

- Plans vary depending on the stage of development of the technology, early stages have higher risk, lower value
- 计划根据技术发展的不同阶段而有所不同。技术开发处于早期阶段，则相应的风险高而价值低

简介- Introduction – 基本见解 Basic Advice

Basic Elements:

基本要素

- Register the important intellectual property
- 注册重要的知识产权
- Sign confidentiality agreements before disclosing IP to the other parties, or to consultants
- 在将有关知识产权透露给其他参与方或顾问之前，须签订保密协议

简介- Introduction – 基本见解 Basic Advice

- Carefully chose the governing law and forum in the international agreements
- 在跨国协议当中慎重选择所适用的法律和管辖法院
- Carefully choose your partners and have strong contracts with them
- 谨慎选择合作伙伴并与其签订优质的合同

注册知识产权 – Register the IP

- What to Register?
- 注册什么？
 - Conduct an audit, what IP is important?
 - 进行一下核查，什么知识产权比较重要？
 - Where are the potential licensees located?
 - 潜在的被许可人在何处？
 - Where will the product be made?
 - 产品将在何处生产？

注册知识产权 – Register the IP

- Where will the product be sold?
- 产品将在何处销售？

- What is the best protection: patent, trade secret, copyright, design patent (industrial design)?
- 哪种保护方式最佳：专利，商业秘密，版权，外观设计（工业品设计）？

注册知识产权 – Register the IP

- In Canada most inventors first apply to register patents in the United States – biggest market
- 在加拿大，大多数发明人会首先在美国申请他们的专利—原因很简单，美国是最大的市场
- Patent protection is only in the country where the patent is granted
- 专利保护只存在于该专利被授予的国家
- Use the Patent Co-operation Treaty to postpone costs of prosecution in other countries – including Canada
- 使用有关专利合作条约推迟该专利在其他国家的申请（包括加拿大）

注册知识产权 – Register the IP

- Software patents – not protected in all countries – sometimes better to use trade secret protection or copyright
- 计算机软件专利—并非在所有国家都受到保护。有时商业秘密或版权保护是更好的选择
- Copyright protection – treaties – Berne Convention – Universal Copyright Convention – provides national treatment in foreign jurisdictions
- 版权保护—条约—伯尔尼条约—国际范围内的版权公约—在外法域中提供国民待遇

注册知识产权 – Register the IP

- Copyright registration usually not required; but improves the protection
- 注册版权并非必须，但可以加强对该版权的保护

注册知识产权 – Register the IP

- Trade secret protection – no treaties – key are the contractual obligations of the other party
- 商业秘密保护—目前没有相应条约—最重要的是通过合约义务约束对方
- Also important are the steps taken by owner to maintain secrecy
- 另外，商业秘密所有者所采取的保密措施也很关键
 - Passwords and restricted access
 - 密码以及访问受限
 - Confidentiality agreements with own employees
 - 与雇员签订保密协议

注册知识产权 – Register the IP

- Trade-marks
- 商标
 - Many Chinese trade-marks are registered by others overseas – “HiSense” case in Germany
 - 很多中国的商标被他人 在海外注册—如海信在德国的案子
 - Example from the Canadian Trade-mark Database:
 - 一个出自于加拿大商标数据库的案例:

注册知识产权 – Register the IP

APPLICATION NUMBER:

1392370

REGISTRATION NUMBER:

not registered

STATUS:

SEARCHED

FILED:

2008-04-22

FORMALIZED:

2008-04-23

APPLICANT:

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ONTARIO

China Commercial Aircraft Co. Ltd.
中国商用飞机有限责任公司

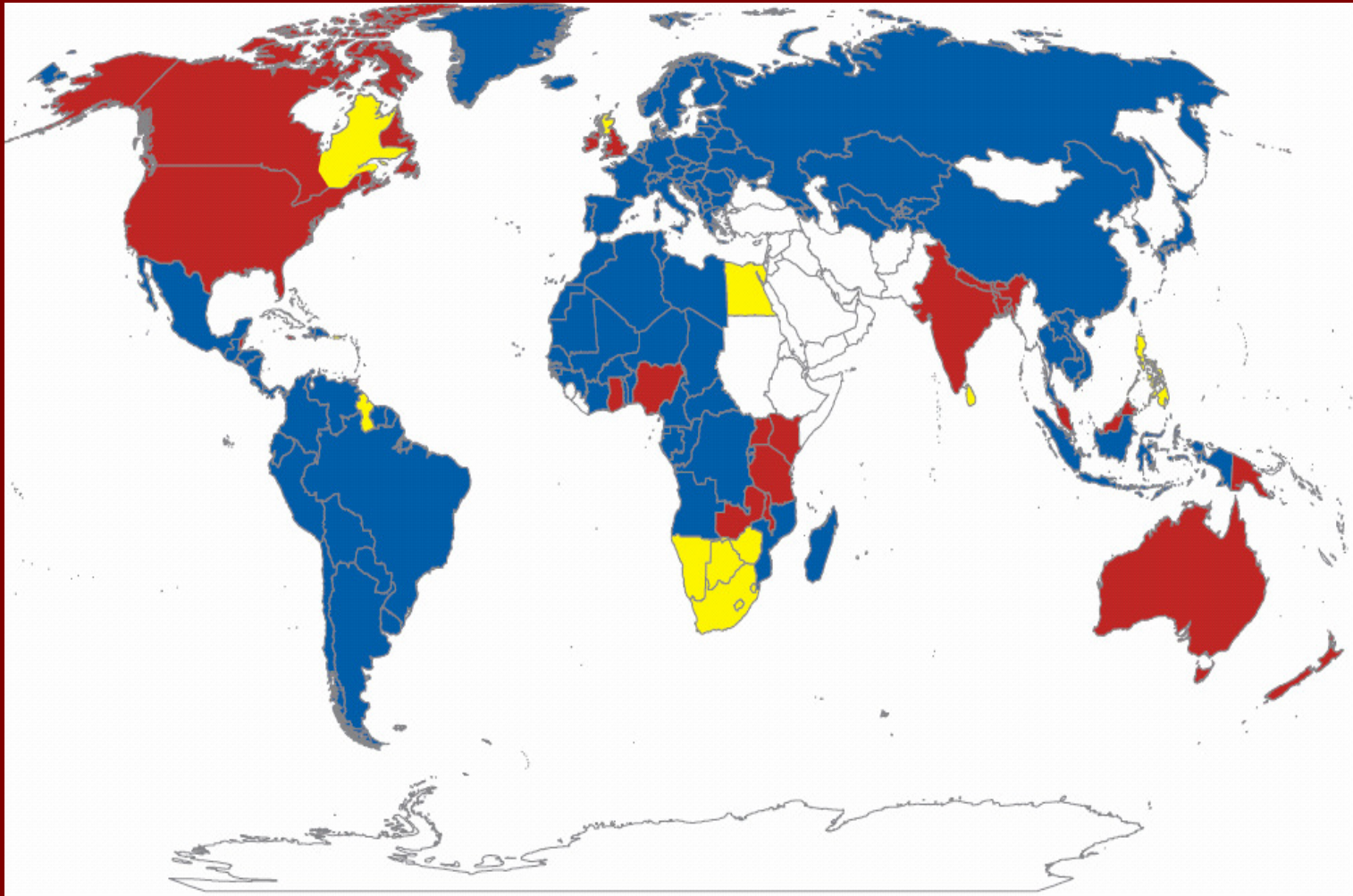
注册知识产权 – Register the IP

- Need staff in charge of IP protection
- 需要专门人员负责知识产权保护
- Need budget that reflects overseas cost of registration for IP
- 预算要充分考虑到知识产权域外注册的费用
- Need to develop network of overseas IP agents
- 需要与国外知识产权代理建立关系

保密协议 – Confidentiality Agreement

- Also known as “Non-Disclosure Agreements”
- 也被称之为“Non-Disclosure Agreements”
- First question: is the other jurisdiction common-law or civil law?
- 第一个问题：另外的管辖区是普通法是大陆法？
- Look at the map: red is common-law, blue is civil law; yellow is mixed
- 请看地图：红色标注为普通法系地区，蓝色标注为大陆法系地区，黄色部分为混合区域

保密协议 – Confidentiality Agreement



保密协议 – Confidentiality Agreement

- Some companies use different forms of agreements for civil law and common law countries
- 有些公司针对大陆法系和普通法系采用不同的合约形式
- Advantage of a contract – in a common law jurisdiction the other party specifically agrees to protect things that may not be otherwise registrable or protectable
- 合约的优势—在普通法系国家，对于无法注册或无法获得法律保护的某些事物，可以通过合约特别规定加以保护

保密协议 – Confidentiality Agreement

- Key Terms:

- 重要条款:

- Definition of confidential information: business information as well as technical information
- 对于机密信息的定义：商业信息以及技术信息
- Scope of Use: only for the project – the Confidential Information should not be used if there is no technology transfer
- 使用范围：仅限于项目使用----若没有技术转让，机密信息不得使用

保密协议 – Confidentiality Agreement

- Allowable Disclosure to Employees: disclose on need-to-know basis; have separate agreements for employees and independent contractors
- 对于雇员的可透露程度：建立在“需要知悉”的基础上；须与雇员以及独立合约者另外签订相关协议

保密协议 – Confidentiality Agreement

- Key Terms cont'd.
- 重要条款 续:
 - Nature of Remedies: interim injunction
 - 救济的本质: 临时禁令
 - Return of confidential information
 - 返还保密信息

保密协议 – Confidentiality Agreement

- Audit and inspection
- 审核和检查

- Ownership of intellectual property
- 知识产权的所有权

保密协议 – Confidentiality Agreement

- Non-Competition Obligations
- 禁止竞业义务
 - Often difficult to prove that trade secrets have been used by another party
 - 往往很难证明商业信息被他方所使用
 - Solution: have other party promise not to compete
 - 解决办法：让他方承诺不与其竞争
 - But non-competition obligations can be difficult to enforce
 - 但是该义务很难强制履行

保密协议 – Confidentiality Agreement

Enforcement of Non-Competition Obligations:

禁止竞业义务的强制履行

- Elements: must be reasonable
- 要素： 必须合理
 - Time
 - 时间
 - Geographic area
 - 地域
 - Scope of business prohibition
 - 禁止从事的业务范围

保密协议 – Confidentiality Agreement

- Terms must also be clear and easy to ascertain, especially for employees
- 条款必须清楚易懂，特别对于员工来讲

适用法律以及管辖法院: Governing Law & Forum

International Agreements always have these questions:

跨国协议总会存在如下问题:

- By which law should the contract be interpreted?
- 合同依据什么法律进行解释?
- If there is a dispute, do the parties use arbitration or a court?
- 如果产生纠纷, 双方当事人是诉诸仲裁还是法院?
- If they use a court, in which countries court, in which city?
- 如果诉诸法院, 诉诸于哪国哪个城市的法院?

适用法律以及管辖法院: Governing Law & Forum

Primary Question:

基本问题:

- What remedy is most desired?
- 当事人最需要何种救济?
 - Monetary damages – enforcement against assets, where are the assets located?
 - 金钱损失—有相关财产可供强制执行，该财产位于何处？

适用法律以及管辖法院: Governing Law & Forum

- Court Order (Injunction) prohibiting disclosure, competition or transferring back IP ownership?
- 法院令状（禁令）禁止泄密，竞争或知识产权所有权的转移？

适用法律以及管辖法院: Governing Law & Forum

International Arbitration:

国际仲裁

- Enforced through the New York Convention on the Enforcement of Arbitral Awards
- 通过《承认及执行外国仲裁裁决公约》（《纽约公约》）强制承认及执行仲裁裁决
- Most countries are a party
- 绝大多数国家均为该公约缔约国

适用法律以及管辖法院: Governing Law & Forum

International Arbitration cont'd:

国际仲裁 续:

- But still have to present the award for enforcement by the local court
- 但仍须向当地法院申请承认及执行仲裁裁决

- May be slow and expensive
- 进程可能会比较缓慢以及昂贵

适用法律以及管辖法院: Governing Law & Forum

International Arbitration cont'd:

国际仲裁 续:

- Power to order remedies other than money may be limited
- 要求非金钱救济的权利可能受限

适用法律以及管辖法院: Governing Law & Forum

Chinese Courts:

中国法院:

- Few treaties with foreign countries for the reciprocal enforcement of judgments
- 与外国签订的互相承认和执行外国法院判决的相关条约比较少见

适用法律以及管辖法院: Governing Law & Forum

Foreign courts:

外国法院:

- In some countries only a court can decide IP matters, give injunctions
- 在有些国家，只有法院有权裁决知识产权相关事项，发出禁令

适用法律以及管辖法院: Governing Law & Forum

Possible Solutions:

可能的解决方法:

- CIETAC arbitration
- 中国国际经济贸易仲裁委员会 (CIETAC) 仲裁
- Hong Kong SAR Courts – judgments can now be enforced in China
- 香港特别行政区法院—判决可被中国大陆承认并执行
- Singapore arbitration or courts
- 新加坡仲裁或法院

适用法律以及管辖法院: Governing Law & Forum

Collecting Evidence:

证据搜集:

- In Canada, the United States, and Australia – right of pre-trial discovery (called “depositions” in the U.S.) – now also in Hong Kong SAR
- 在加拿大，美国，澳大利亚等国家，审判前之证据提示之权利（在美国称为“depositions”）现在在香港特别行政区也存在

适用法律以及管辖法院: Governing Law & Forum

Collecting Evidence cont'd :

证据搜集 续:

- In the U.K., Europe and other civil law countries, like China – no discovery
- 而在英国，欧洲以及其他大陆法系国家，包括中国，则无该权利
- Pre-trial disclosure may be asked for in the agreement
- 审判前之证据提示可能在合约中加以约定

技术合同: License Agreement

Basic Assumptions:

基本观点:

- Civil Law jurisdictions: require pre-contractual good faith – voluntary disclosure
- 大陆法系: 合约签订前之善意、诚信—自愿披露
 - 中国: 合同法 – 第四十二条
- Common law jurisdictions: principle of “buyer beware”
- 普通法系: “买主须自行当心”原则

技术合同: License Agreement

合同法 1999

第四十二条 当事人在订立合同过程中有下列情形之一，给对方造成损失的，应当承担损害赔偿责任：

- (一) 假借订立合同，恶意进行磋商；
- (二) 故意隐瞒与订立合同有关的重要事实或者提供虚假情况；
- (三) 有其他违背诚实信用原则的行为。

技术合同: License Agreement

Canada – Supreme Court:

In many if not most commercial negotiations, an **advantageous bargaining position is derived from the industrious generation of information not possessed by the opposite party** as opposed to its market position as here. Helpful information is often a by-product of one party expending resources on due diligence, research or other information gathering activities. It is apparent that successful negotiating is the product of that kind of industry.

技术合同: License Agreement

- It would defeat the essence of negotiation and hobble the marketplace to extend a duty of care to the conduct of negotiations, and to label a party's failure to disclose its bottom line, its motives or its final position as negligent. Such a conclusion would of necessity force the disclosure of privately acquired information and the dissipation of any competitive advantage derived from it, all of which is incompatible with the activity of negotiating and bargaining....
- a duty to bargain in good faith has not been recognized to date in Canadian law

技术合同: License Agreement

IP Issues

知识产权相关事项

- Carefully describe the scope of the grant – who has the rights to products developed with the technology?
- 谨慎描述授权范围——对由该技术生产的产品，谁享有权利？

技术合同: License Agreement

IP Issues

知识产权相关事项

- Rights to improvements – laws in different countries treat grantbacks differently – co-ownership
- 改进权—不同国家的法律对技术的改进与回授态度不一—共同所有权
- How will access to the IP be controlled, monitored?
Can “reverse engineering” be prohibited?
- 如何监控对知识产权的接触? “反向工程”能否被禁止?

技术合同: License Agreement

IP Issues:

知识产权相关事项:

- Sub-licensing, exhaustion of rights
- 分许可，权利穷竭
- Representations and warranties as to the validity of the IP – especially patents
- 对该知识产权有效性所作的任何保证和承诺—尤其对于专利而言

技术合同: License Agreement

IP Issues:

知识产权相关事项:

- Auditing and reporting requirements
- 审计和报告要求

- Indemnities
- 赔偿

技术合同: License Agreement

- Application of Competition or Antitrust Laws:
- 反不正当竞争法的运用:
 - Canada: Intellectual Property Enforcement Guidelines
 - 加拿大: 知识产权执法准则
 - U.S.: 1995 Federal Antitrust Guidelines for the Licensing of Intellectual Property
 - 美国: 1995年联邦反托拉斯法知识产权授权行为准则

技术合同: License Agreement

- Application of Competition or Antitrust Laws:
- 反不正当竞争法的运用:
 - E.U.: Technology Transfer Block Exemption Regulations
 - 欧盟: 技术转让豁免条例

技术合同: License Agreement

- Other International Issues:
- 其他国际事项:
 - Withholding taxes and gross-up clauses
 - 预扣税及包税条款
 - Currency of payments
 - 支付币种
 - Export Controls on sensitive technology
 - 敏感技术的出口限制

其它资源:Other Resources

- Licensing Executives Society:
 - <http://www.lesusacanada.org/>
- Association of University Technology Managers:
 - <http://www.autm.net>
- IP Handbook of Best Practices:
 - <http://www.iphandbook.org/index.html>

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