

医药技术

PHARMA TECHNOLOGY

经济导报 特刊
总编室设在北京朝内大街 中国医药报社在天津发行

www.jdonline.com.hk

www.医药技术.cn

SUMMER 2009

特别报道：自动化技术

Special Report: Automation Technology

该行业为什么转向外包
Why the industry is turning to outsourcing
如何最好的利用营销预算
How best to focus your marketing budget

ISSN 0013-0265



9 770013 026007

BRIC.com

在首个成功诉讼案例之后，Eli Lilly已经阻止了对其一种仿制药品的销售
Eli Lilly has blocked the sale of a generic version of one of its drugs following a successful initial court case



挽回因专利侵权所造成的损失

Recouping damages from patent infringements

Vondst Advocaten的Otto Swens和Arjan Reijns说：“自从2004年欧盟第2004/48/EC号指令生效后，欧洲专利诉讼大幅减少。”

Since the 2004/48/EC Enforcement Directive came into force in 2004, patent litigation in Europe has to a large extent been harmonised, explain Otto Swens and Arjan Reijns of Vondst Advocaten

当公司财务状况不断恶化时，和当前经济衰退时期的许多公司一样，最明智的做法就是保护资产。为此所形成的战略将使侵权者处于非常不利的诉讼境地。专利权所有人将进行风险分析，并对可能的“收入”和不进行诉讼的情况下最佳的替代解决办法进行评估。如果专利权所有人从最初就知道诉讼并不能产生获得收支平衡所需赔偿，那么就会选择放弃诉讼。在评估过程中，专利权所有人将面临两个主要问题：

When companies are faced with a deteriorating financial position, as many companies are in the current economic downturn, securing their assets may be the smart thing to do. Strategies to that effect can comprise a tough litigation stance against infringers. A patentee will make a risk analysis and assess both the possible “revenue” and the best alternative without litigation. If it is



Otto Swens of
Vondst Advocaten

何时能够获得赔偿金？

赔偿金数额将如何计算？

在本文中，我将针对德国、英国、法国和荷兰主要的专利诉讼权限有关的问题进行简要回答。首先，我将以荷兰司法为出发点，之后从较为泛欧的角度谈一下与其他国家所存在的差异。

强制指令

欧盟第2004/48/EC指令使专利诉讼产生了几项变化，并已经成为我们专利诉讼制度的必要组成部分，与其先后顺序没有关系。第一个变化直接关系到《与贸易有关的知识产权协议》（TRIPs）第45项重新编纂条款，以及上面所提到的问题。赔偿金仅从侵权者“故意”进行侵权行为后开始计算。

根据1995年荷兰专利法（DPA）第70条第3款，只有专利侵权人知晓其正在侵权时，才可以提出专利侵权损害赔偿。专利侵权人不但需要知道专利，还需知道其行为构成对该专利的侵权。这就意味着，为了开始计算赔偿金，专利所有人须确保专利侵权人存在故意行为，并向其发出正式通知。如果在专利侵权人“知晓或有合理的理由知晓”的情况下开始承担责任，则此规范与TRIPs的第45条款及欧盟第2004/48/EC号指令之间存在着明显的制衡。荷兰最高法院在2003年对Roche诉Primus案的判决具有重要而深远的意义，在该判决中，TRIPs（及欧盟第2004/48/EC号指令）优于荷兰专利法（DPA）第70条第3款。因此，无需司法官发出正式通知，只需发出警告信即可。

获得赔偿

获得侵权赔偿可分为两种方式：提出索赔并要求返还利润。在荷兰获得赔偿的这些方法与德国、英国和法国的方法非常类似，虽

clear from the outset that litigation will not yield sufficient damage payment to tip the balance, a patentee will choose not to litigate. In making his assessment the patentee is faced with two principal questions:

1. When can damages be recouped?

2. How will the amount of these damages be calculated?

In this article I will give a short overview of the answers to these questions for the main patent litigation jurisdictions: Germany, the UK, France and the Netherlands. I will start by using the Dutch jurisdiction as a springboard and then continue to discuss various deviations from somewhat more of a pan-European perspective along the way.

The Enforcement Directive

The Enforcement Directive 2004/48/EC has brought about several changes in patent litigation which have now become essential parts of our, in part commutative, patent litigation system. The first change directly concerns a re-codification article 45 of TRIPs and relates to the questions raised above. Damages only start to accrue after an infringer "knowingly" commits his infringing actions.

Under article 70(3) of the Dutch patent Act 1995 (DPA), damage suffered from patent infringement could only be claimed to the extent that the infringer knew that he was infringing. The infringer not only had to know that there was a patent, but also that his actions constituted infringement thereof. This meant that in order for damages to start to accrue, the patentee had to ensure that the infringer acted knowingly and had to send them a formal notice.

There is a clear tension between this criterion and the criterion in article 45 of TRIPs and article 31 of Directive 2004/48/EC, where it is provided that liability starts when the infringer acts "knowingly, or with reasonable grounds to know". In its landmark decision of 2003 in Roche/Primus, the Dutch Supreme Court decided that TRIPs (and Directive 2004/48/EC) supersedes article 70(3) DPA. Therefore, a formal notice by a bailiff is no longer required, but a warning letter will generally suffice.

荷兰最高法院在2003年对Roche诉Primus案的判决具有重要而深远的意义，在其判决中，TRIPs（及欧盟第2004/48/EC号指令）优于荷兰专利法（DPA）第70条第3款



Arjan Reijns
of Vondst
Advocaten

然德国法并不对两种方法进行区分，但德国在赔偿金的计算中也包括这两种方法。

赔偿金包含“财务损失”和“其它损失”（荷兰民法典第6条95款）。财务损失为假定未侵权时的财务状况与侵权时的实际状况之间的差额。其中包括损失的利润、受到的其它财务损失、防止或限制损害所支出的合理成本、确定损害和责任所支出的合理成本及通过法律获得解决所支出的合理成本。

荷兰法院将“按照最符合损害种类的方式”（荷兰民法典第6条97款）计算赔偿金。如果无法进行准确的计算，则所有赔偿金将按照公平合理的原则进行估算。法院使用的计算方法可以是抽象的或具体的，也可以是两者的结合。在德国，赔偿金通常用以下三种方法之一进行计算：即按照损失的利润，适当的许可费用或由专利侵权人所提供的收益信息进行计算。专利权所有人可以从这些选项中选择，在诉讼程序过程中仍可进行变更。

在法国，专利权所有人也可以选择，但在计算损失利润过程中有两点不同。即利润只能为专利所有人在未侵权情况下所实际获得的

在德国，赔偿金通常用以下三种方法之一进行计算：即按照损失的利润，适当的许可费用或由专利侵权人所提供的利润信息进行计算

Obtaining compensation

Two ways of obtaining compensation for infringements can be distinguished: claiming damages and claiming the surrender of profits. These methods of receiving compensation in The Netherlands are very similar to those in Germany, the UK and France, although German law does not distinguish between the two but includes both methods in the calculation of damages.

Damages can consist of 'financial loss' and 'other loss' (Article 6:95 DCC). Financial loss is the difference between the hypothetical financial position without and the actual position with the infringement. This includes lost profits, other suffered financial loss, reasonable costs to prevent or limit damage, reasonable costs to determine damage and liability and reasonable costs to obtain settlement out of court.

In the Netherlands the Court shall calculate the damages "in the way that best fits the nature of the damages" (Article 6:97 DCC). If no accurate calculation can be made, the full damages are estimated at *aequo et bono*. The methods of calculation that the court can apply can be abstract or concrete or a mix of the two. In Germany, damages are generally calculated in one of three ways: lost profits, calculation of an appropriate license payment or surrender of profit-information by the infringer. The patentee can choose from these three options and still switch during the proceedings.

In France, the patentee will also have to choose, but there are two deviations in calculating lost profit. These only entail the profits the patentee would have actually made. For the surplus, the court determines a reasonable royalty rate. Non-infringing sales can also be included in the "total infringing sales" when the former infringer was enabled to sell his non-infringing, substitute product to customers he acquired through his infringing sales.

The Enforcement Directive has explicitly opened up the possibilities to set the damages as a lump sum on at least the amount of royalties or fees that would have been due if the infringer had requested authorisation to use the intellectual property right. Depending on the circumstances of the case, this fee can be higher than its regular fee as a licensor would never grant a licence to a competitor under the same terms as it would to a regular other licensee. In 2006, the District Court of The Hague decided not only that the infringer had to compensate the patentee by means of a fictional licence fee, but also ordered to provide compensation for price erosion for both the patentee's own products and for erosion of the licence fee it could ask. The fictional licence fee per infringing product was set at a rate that was 150 per cent of the regular license fee, due to the competitive relationship between the patentee and the infringer.

Surrender of profits

In the Netherlands, a party can cumulatively claim damages and surrender of profits (article 6:104 DCC). The patentee can

利润。对于剩余利润，法院确定一个合理的专利权使用费。当之前的专利侵权人通过侵权销售获得客户，并向这些客户销售非侵权替代产品时，则该非侵权销售也可以包含在“总侵权销售”中。如果专利侵权人要求授权使用该项知识产权，则应付专利权使用费或一次付清费用金额，强制指令明确允许此种赔偿金处理方式。根据案件的情况，由于许可证发放者绝不会向其他普通被许可人一样以相同的条件将许可授予竞争对手，因此此项费用可高于其正常费用。

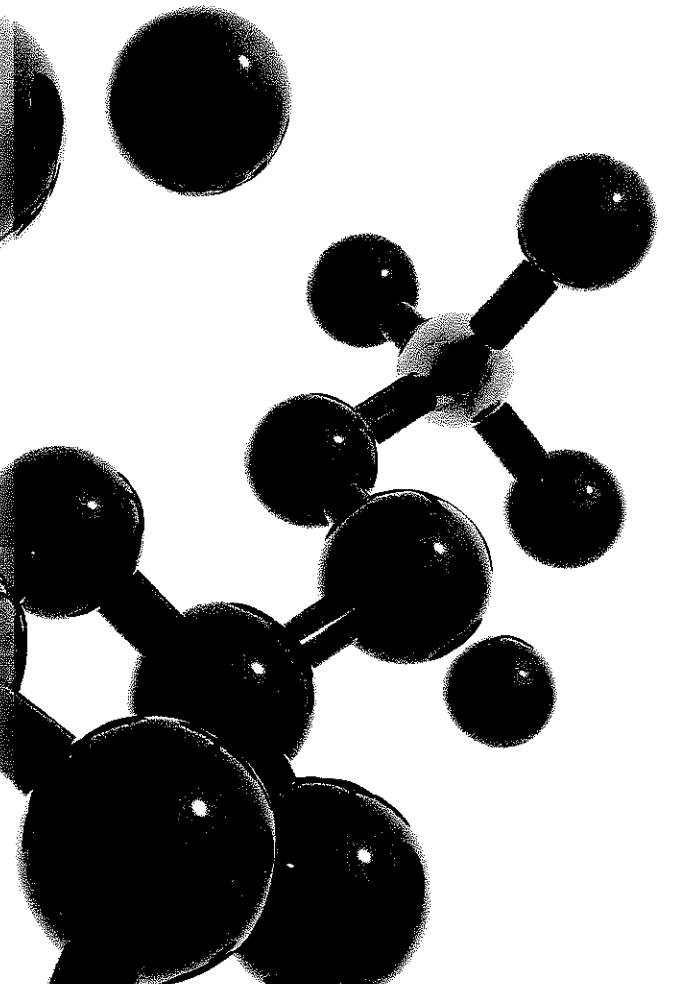
2006年，海牙地区法院不仅判决专利侵权人通过以非实际许可费的方式赔偿专利所有人，而且命令对专利所有人自有产品及其可以要求的许可费的价格侵蚀给予赔偿。由于专利所有人与专利侵权人之间的竞争关系，每项侵权产品的非实际许可费按照普通许可费150%的费率计算。

利润返还

在荷兰，一方可以累积提出损害赔偿金要求和利润的返还（荷兰民法典第6条104款）。专利所有权人可以通过法院发出指令要求专利侵权人提供利润信息，并在获得该信息后仍可决定是否选择要求赔偿金或利润返还。虽然赔偿金和利润返还可以累积索赔，但专利所有人所被判给的金额不得超出两个款项中最高金额。在英国，上述选项虽然可获得更多赔偿，但该选项已经明确地排除在专利法（1977）第61条2款之外，从而使返还选项存在风险。

claim a court order against the infringer to surrender information of profits and still decide after that whether he chooses to claim damages or surrender of profits. Although damages and surrender of profits can be claimed cumulatively, the patentee will not be awarded more than an amount equal to the highest of both amounts. In the UK, such a choice has explicitly been excluded in article 61-2 of the Patents Act 1977 making the choice for the surrender somewhat risky, although it can yield substantially more.

In its *Gemeinkostenanteil* decision, Germany's Federal Court of Justice (BGH) decided that general expenses – costs that are not directly attributable to the production process, such as maintenance of the plant and the premises of plant itself – are not to be deducted from the revenue when calculating the infringer's profits. These costs are to be regarded as "Sowieso" – costs that the company would have made anyway. In the UK these costs are not to be deducted either. In the Netherlands, under the *Cordis/Schneider* decision, a proportional part of the general expenses, including costs of the premises and overhead costs, may be deducted from the revenue.



扩展到欧洲？ Expanding to Europe?

www.vondst-law.com

专利与技术、商标、植物新品种权、
医药和生命科学、IT以及版权与设计

patents & technology, trade marks, plant variety rights,
pharma & life sciences, IT and copyright & design

医药和生命科学领域请联系：

Your contacts for pharma & life sciences:

Otto Swens
otto.swens@vondst-law.com

Silvie Wertwijn
silvie.wertwijn@vondst-law.com

Vondst Advocaten N.V.
P.O. Box 75781
1070 AF Amsterdam
Van Leijenberghlaan 199
1082 GG Amsterdam
The Netherlands
t +31 (0)20 504 20 00
f +31 (0)20 504 20 10
www.vondst-law.com

Your innovation.
Our passion.

vondst
advocaten



在当前的经济环境下，公司要确保他们的专利权不被侵犯
In the current economic climate companies need to ensure their patents are not infringed

在德国联邦最高法院（BGH）判决的Gemeinkostenanteil案件中，在计算专利侵权人的利润时，总费用并不从收入当中扣除，该项总费用中不包括与生产过程相关的工厂和工厂自身设施的维护成本等成本。这些成本将被视为“Sowieso”，即公司至少需要支出的成本。在英国，这些成本也不得被扣除。在荷兰，对Cordis诉Schneider的判决中，总费用的一定比例部分可从收入中扣除，其中包括设施成本和管理费用。

另一个产生重要影响的变化是对律师费用、专利律师费用和许多其它与荷兰程序法第14条规定程序直接相关的成本的返还，胜诉的原告只能获得诉讼费和记录在案的律师固定工资成本的返还。此项变化使被判给诉讼当事人的诉讼费用超过50万欧元。

执行判决

由于是欧洲的立法，执行判决的过程将在欧盟内部进行（由欧盟法院实施），因此不会遇到太多困难。在被告所在国家，专利权所有人可从该国指定权利机构获得强制执行令（欧盟第44/2001/EC号条例第38条）。如果不违反一般规定，如与公共秩序相抵触，则基本上可获得该执行令。在获得执行令后，专利权所有人可自行采取各种措施，并可将该判决视为国家判决。

结论

随着指令的执行，专利诉讼已经大幅减少，但成员国对其立法进行适应性调整的方式可能会有所不同。但是，专利侵权人须为故意行为，对此无须再发出正式通知。关于德国、英国和荷兰的诉讼，其间的差异似乎仅限于对赔偿金的理解和返还利润的计算。

Another change with major impact that was brought was the recovery of attorney's fees, patent attorney's fees and many other costs directly related to the proceedings under article 14. Under general Dutch procedural law, a successful plaintiff could only recover court fees and fixed salary costs of the attorney of record. This change had already led to parties having been awarded over half a million Euros in costs in the proceedings.

Executing decisions

Thanks to legislation on a European level, the process of executing a decision in the EU – that is rendered by a court in the EU – does not present too many obstacles. The patentee can obtain a declaration of enforceability from the designated authority in the country in which the defendant is established (article 38 Regulation 44/2001/EC). In principle this declaration is obtained (article 33) if it is not in violation of standard stipulations such as being contrary to the public order. After the declaration is obtained, the patentee has all measures at its disposal as if the decision were a decision of a national judge.

Conclusion

With the implementation of the Enforcement Directive, patent litigation has been harmonised to a large extent, but the ways in which the member states shape their compliant legislation may vary. However, the infringer will have to have acted knowingly, for which a formal notice is no longer required. Regarding German, UK and Dutch proceedings, the differences seem to be limited to the perception of damages and the calculation of the profits that are to be surrendered. ■