U.S. Patent Law Update
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美国专利法最新进展
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Update on U.S. Patent Law
美国专利法最新进展

Agenda
议程

- Subject matter
- 保护客体
- Inequitable conduct
- 不公正行为
- Joinder in patent litigation
- 专利诉讼中的合并诉讼

Subject Matter
保护客体

35 USC §101 Inventions patentable.
《美国法典》第35篇第101条规定的可获得专利的发明

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
凡发明或发现任何新颖和适用的方法、机器、制造品或物质的组分或它们的任何新颖和适用的改进者，可以按照本法规定的条件和要求取得专利权。

Recap of Bilski v. Kappos (130 S. Ct. 3218)
Bilski诉Kappos案的回顾

- ***US Supreme Court decision on June 28, 2010***
- ***美国最高法院的判决，2010年6月28日***

- Bilski's claimed invention:
- Bilski案所涉及发明的权利要求

A method for managing the consumption risk costs of a commodity sold by a commodity provider at a fixed price comprising the steps of:
(a) initiating a series of transactions between said commodity provider and consumers of said commodity wherein said consumers purchase said commodity at a fixed rate based upon historical averages, said fixed rate corresponding to a risk position of said consumer;
(b) identifying market participants for said commodity having a counter-risk position to said consumers; and
(c) initiating a series of transactions between said commodity provider and said market participants at a second fixed rate such that said series of market participant transactions balances the risk position of said series of consumer transactions.
一种管理由商品供应商以固定价格出售的商品的消费风险成本的方法，包含以下步骤：
(a) 在所述商品供应商与所述商品的消费者之间发起了一系列的交易，其中，所述消费者以一个基于历史平均水平的固定费率购买所述商品，所述固定费率与所述消费者的风险状况相对应;
(b)识别与所述消费者有一个相反风险状况的所述商品的市场参与者;
(c) 在所述商品供应商与所述市场参与者之间发起一系列以第二个固定费率进行的交易，使得所述一系列市场参与者的交易平衡所述一系列消费者的交易的风险状况。

- No recitation of hardware or software
- 没有提及硬件或软件

Recap of Bilski v. Kappos Bilski诉Kappos案的回顾

- Patentable subject matter issues:专利保护客体问题
  - Patent eligibility of processes方法发明的可专利性
  - Business method inventions商业方法发明

- Questions presented:提出的问题

- Whether the Federal Circuit erred by holding that **a "process" must be tied to a particular machine or apparatus, or transform a particular article into a different state or thing ("machine-or-transformation" test),** to be eligible for patenting under 35 U.S.C. § 101, despite this Court's precedent declining to limit the broad statutory grant of patent eligibility for "any" new and useful process beyond excluding patents for "laws of nature, physical phenomena, and abstract ideas." [Answer: Yes]
- 尽管最高法院在先案例拒绝在排除专利对象是"自然规律、物理现象和抽象概念"之外进一步限制对"任何"新颖的实用方法的专利适格性的宽泛的法定授予，美国联邦巡回上诉法院还是认为：方法(process)必须关联到具体的机械设备，或者可以将物体转化成其它状态或其他东西（"机械关系或物质转化"检验标准），才是《美国法典》第35篇第101条所规定的专利保护客体，这是否犯了错误？ [回答：是]
- Whether the Federal Circuit's "machine-or-transformation" test for patent eligibility, which effectively forecloses meaningful patent protection to many business methods, contradicts the clear Congressional intent that patents protect "method[s] of doing or conducting business." 35 U.S.C. § 273. [Answer: Yes]
- 巡回上诉法院的判断专利资格的"机械关系或物质转化"检验标准——其实际上排除了对许多商业方法的专利保护——是否与国会关于专利保护"做生意或进行商务的方法"的清楚意图（美国法典第35篇第273条）相抵触[回答：是]

Bilski v. Kappos – The Majority View
Bilski诉Kappos案——多数派意见

- “This Court’s precedents establish that the machine-or-transformation test is a useful and important clue, an investigative tool, for determining whether some claimed inventions are processes under §101. ***The machine-or-transformation test is not the sole test for deciding whether an invention is a patent-eligible ‘process***.’” (emphasis added)
- “最高法院的先前判例确立，机械关系或物质转化检验标准，是判定某些发明是否是第101条所规定的方法的有益的重要线索、研究工具。**机械关系或物质转化检验标准不是决定方法发明是否是可专利的唯一判断标准。** “

- Court’s approach is ***not additive***, even if the invention does not meet the machine-or-transformation test (M-or-T), it is patent-eligible if it is not directed to an abstract idea (or law of nature or natural phenomena).
- 最高法院的做法并**不是增加标准**，即使发明不符合机械关系或物质转化检验标准(M-or-T), 如果其不是针对抽象思想（或自然规律或自然现象），那么该发明就属于专利保护客体。

Bilski v. Kappos – The Majority View
Bilski诉Kappos案——多数派意见

- Statutory prior user rights defense for performing “a method of doing or conducting business” (35 USC § 273) clarifies that business methods are one kind of “method” that, “at least in some circumstances, [is] eligible for patenting under §101.”
- 对实施“做生意或进行商务的方法”的法定的先用权抗辩规则（美国法典第35篇第273条）澄清，商业方法是一种——至少在某些情形中——按照第101条的规定属于专利保护客体的“方法”
  - The contrary conclusion – that business methods are categorically excluded – renders §273 meaningless.
  - 与此相反的结论——绝对排除商业方法——使第273条变得毫无意义
  - “[W]hile 273 appears to leave open the possibility of some business method patents, it does not suggest broad patentability of such claimed inventions.”
  - 尽管第273条看起来为某些商业方法专利留有余地，但并不表明这类发明具有宽泛的可专利性

In summary: 总结
- No categorical “M-or-T” exclusion 没有绝对排除“M-or-T” 检验标准
- No categorical business method exclusion 没有绝对排除商业方法
- Explicitly declined to endorse any prior interpretations of §101 by the Federal Circuit, including those provided in *State Street* and *AT&T*.
- 明确拒绝支持巡回法院对专利法第101条的任何先前的解释，包括在*State Street* 和*AT&T*案中的解释。

Bilski v. Kappos – Outcome
Bilski诉Kappos案——结局

- The case was resolved narrowly based on prior holdings (*Benson*, *Flook*, and *Diehr*)*: the claims are not patentable processes because they are directed to abstract ideas. [This holding was unanimous.]
- 该案根据对先前案例 (*Benson*, *Flook*, and *Diehr* *)的狭义理解而得到解决:权利要求不是可专利的方法，因为它们针对的是抽象思想[本裁定是意见一致的]

- "The concept of hedging, described in claim 1 and reduced to a mathematical formula in claim 4, is an unpatentable abstract idea, just like the algorithms at issue in *Benson* and *Flook*. Allowing petitioners to patent risk hedging would preempt use of this approach in all fields, and would effectively grant a monopoly over an abstract idea."
- 权利要求1中描述的、被限定为权利要求4中的数学公式的对冲概念，是不可专利的抽象思想，就像*Benson*和*Flook*案中涉及的算法一样。允许上诉人获得风险对冲的专利，就会抢占这个方法在各个领域的用途，实际上是授予对一个抽象思想的垄断 。

- Dependent claims, directed to "broad examples of how hedging can be used in commodities and energy markets," merely add field of use or "token postsolution components."
- 从属权利要求针对的是"如何在商品和能源市场应用对冲的广泛的例子"，仅仅是增加了应用的领域或在解决方案之外添加了象征性的特征。

* Gottschalk v. Benson, 409 U.S. 63 (1972); Parker v. Flook, 437 U.S. 584 (1978); Diamond v. Diehr, 450 U.S. 175 (1981)

Mayo Collaborative Services v. Prometheus Laboratories, Inc. (566 U.S. ___ (2012))
梅奥协作同服务公司诉普罗米修斯实验室案

- ***US Supreme Court decision on March 20, 2012***
美国最高法院的判决 （2012年3月20日）
- Prometheus' patent claims directed to methods of optimizing the dose of specific drugs used in the treatment of specific conditions
- 普罗米修斯的专利权利要求针对的是在特定条件下的治疗中使用特定的药物剂量的优化方法
- Question presented提出的问题
  - Whether 35 U.S.C. § 101 is satisfied by a patent claim that covers observed correlations between blood test results and patient health, so that the claim effectively preempts all uses of the naturally occurring correlations, simply because well-known methods used to administer prescription drugs and test blood may involve "transformations" of body chemistry.
  - 仅仅因为用于众所周知的管理处方药和血液测试的方法可能涉及体内化学的“转变”，就授予一项覆盖了观察到的血液测试结果与病人健康之间的相互关系的权利要求，使权利要求实际上抢占了对自然发生的相互关系的所有用途，这是否满足专利法第101条？
- USSC found claims invalid under 35 USC § 101 because they impermissibly claim laws of nature.最高法院认为，根据专利法第 101条，权利要求无效，因为请求保护的是自然规律，而这是不允许的。
  - Reversed CAFC which had twice upheld the validity of the claims at issue.
  - 撤销联邦巡回上诉法院两次对涉案权利要求有效的裁决

WIldTangent v. Ultramercial
WIldTangent 诉 Ultramercial案

- ***US Supreme Court decision on May 21, 2012***
美国最高法院的判决 （2012年5月21日）

- Patent claims a method for distributing copyrighted products over the Internet under a monetization scheme. Patent No. 7,346,545. The consumer must view an advertisement before receiving a copyrighted product over the Internet.
- 专利请求保护按照一种货币化计划在互联网上分发受版权保护产品的方法。专利号7346545。消费者在互联网上接收受版权保护产品之前必须观看广告。

- Federal Circuit (CAFC) found the claimed invention patentable under Section 101 based upon the requirement that a computer be used to perform the method and the programming complexity required to carry out the claimed elements:
- 联邦巡回上诉法院认为，根据一台计算机被用来执行方法和执行权利要求的要素所需的编程复杂性，依据专利法第101条，权利要求的发明属于专利保护客体：
  - While "the mere idea that advertising can be used as a form of currency is abstract, just as the vague, unapplied concept of hedging proved patent-ineligible in Bilski,...the '545 patent does not simply claim the age-old idea that advertising can serve as a currency. Instead, the '545 patent discloses a practical application of this idea."
  - 尽管“将广告作为一种货币形式的概念是抽象的——如同Bilski案中含糊不清、未经应用的对冲概念被证明不属于专利保护客体那样…’545‘专利并非只是请求保护广告可用作货币的陈旧想法，相反，’545’专利公开了一种对这种想法的实际应用’ ”

- USSC rejected the Ultramercial patent as effectively encompassing an unpatentable law of nature.
- 最高法院驳回了Ultramercia专利，因为其实际上包含了不可专利的自然规律。

CLS Bank v. Alice Corporation
CLS Bank 诉 Alice Corporation案

- **U.S. Court of Appeals for the Federal Circuit (CAFC) decision on July 9, 2012**
- **美国联邦巡回上诉法院(CAFC)的判决，2012年7月9日**
- Patent claims involve reducing settlement risk in computerized trading platforms.
- 专利权利要求涉及在计算机化的交易平台中降低结算风险。
  - U.S. District Court had dismissed the patent claims as being directed to a patent-ineligible "abstract idea," not unlike the abstract, risk-reducing hedging method that had been previously invalidated by the Supreme Court in *Bilski v. Kappos*
  - 美国地方法院驳回了专利权利要求，理由是权利要求针对的是不属于专利保护客体的“抽象概念”，与以前在Bilski诉Kappos案中被最高法院判决无效的、抽象的减少风险的对冲方法并无二样。

- CAFC Ruling: Reversed the district court's decision. 35 U.S.C. § 101 does not preclude one from obtaining patents directed to computer-implemented methods, systems and products, unless it is "manifestly evident" that they cover an abstract idea; that is, "the single most reasonable understanding is that a claim is directed to nothing more than a fundamental truth or disembodied concept, with no limitations in the claim attaching that idea to a specific application."
- CAFC裁定：撤销地区法院的判决。 专利法第101条不排除人们获得用计算机实现的方法、系统和产品的专利，除非请求保护的方案“清晰明显”覆盖抽象的概念；即“唯一最合理的理解是，权利要求仅仅针对基本的真理或无形的概念，权利要求中没有把抽象概念联系到具体应用的限定。”

Bancorp Services v. Sun Life

Bancorp Services 诉 Sun Life案

- **U.S. Court of Appeals for the Federal Circuit (CAFC) decision on July 26, 2012**
- **美国联邦巡回上诉法院(CAFC)的判决，2012年7月26日**
- The patents in issue directed to managing life insurance policies.
- 涉案专利针对的是管理人寿保险保单
  - The asserted claims set out a series of steps for tracking, reconciling and administering a life insurance policy with a stable value component using computer components.
  - 被控权利要求用一个使用计算机部件的稳定值部件(stable value component)设置一系列用于跟踪、协调、管理人寿保险保单的步骤。
  - U.S. District Court found that the computer was not necessary for carrying out the method; it can be performed manually, although less efficiently.
  - 美国地方法院认为，计算机不是执行该方法所必需的；能手工执行该方法，尽管效率较低。

- CAFC Ruling: Upheld District Court. Patented process failed the “manifestly evident” standard set out in *CLS v Alice Bank*. **35 U.S.C. § 101 precludes one from obtaining a patent on a computer-implemented abstract process where the computer does not play a “significant part” in the performance of the claimed invention (i.e., where the computer “simply performs more efficiently what could otherwise be accomplished manually”).**
- CAFC裁决：依据在CLS诉Alice Bank案中设定的“清晰明显”标准，维持地方法院判决。按照专利法第101条，计算机在执行权利要求的发明的过程中不起“重要作用”(即计算机“只是更高效地执行本来可以手动完成的功能”）的，则排除人们就计算机实现的抽象过程获得专利。

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- **Inequitable conduct**
- **不公正行为**
- Joinder in patent litigation
- 专利诉讼中的合并诉讼

Inequitable conduct – Background
不公正行为—背景

- A defense based on patent applicant's conduct before PTO during the patent's application process
- 基于申请人在专利申请过程中对美国专利商标局的行为的抗辩
  - Includes conduct -- such as affirmative misrepresentations of a material fact, failure to disclose material information, or submission of false material information -- coupled with an intent to deceive the PTO
  - 包括行为—如对实质性事实的肯定性虚假陈述，未能披露实质性信息，或者提交虚假的实质性信息——并伴有欺骗专利局的企图
  - If found, the entire patent can be unenforceable
  - 如果被发现，整个专利失去可执行性
- Courts have been inconsistent in applying this defense
- 法院应用这个抗辩规则的做法向来不一致
  - Possibly because it is an "equitable" judgment call, which often turns on circumstantial evidence of intent
  - 可能是因为这是一种"公正的"判断要求，常常需要有证明意图的旁证
- Courts have long recognized problems with this defense
- 法院早就认识到这个抗辩规则存在的问题
  - "the habit of charging inequitable conduct in almost every major patent case has become an absolute plague." *Burlington Indus. v. Dayco* (Fed. Cir. 1988).
  - "在几乎每一个重大专利案件中指控不公正行为的习惯，已经成为一个绝对的瘟疫。"

IBM

Therasense
Therasense案

- *Therasense v. Becton, Dickinson, 649 F.3d 1276* (Fed. Cir. 2011) (en banc)
  Therasense 诉Becton, Dickinson案
  - latest attempt to reform this area of the law改革这个领域的法律的最新努力
  - this case will reduce availability of inequitable conduct defense
  - 该案将减少不正当行为抗辩的适用性
  - but how closely will it be followed? 4 out of 11 judges dissented, which reflects inconsistency in judicial approaches to the defense
  - 但是，该判例如何被紧密遵循？11名法官中的4名持反对意见，反映了司法实践应对这种抗辩的不一致性
  - this case has already been cited in over 100 District Court cases
  - 该案已经在超过100个地方法院案件中被引用
- "While honesty at the PTO is essential, low standards for intent and materiality have inadvertently led to many unintended consequences, among them, increased adjudication cost and complexity, reduced likelihood of settlement, burdened courts, strained PTO resources, increased PTO backlog, and impaired patent quality."
- "虽然对专利局的诚信是必不可少的，对主观意图和实质性的低标准，无意中导致许多意想不到的后果，其中包括，判决的成本和复杂性增加，和解的可能性减少，法院的负担加重，专利局的资源紧张，积压案件增加，专利质量受损。"
- "This court now tightens the standards for finding both intent and materiality in order to redirect a doctrine that has been overused to the detriment of the public."
- "法院现在收紧了认定主观意图和实质性二者的标准，以便对被过度利用而损害公众利益的理论重新导向。"

Therasense
Therasense案

- Held: Intent and materiality are separate requirements that must each be found independently – there is no sliding scale
- 裁定：意图和实质性是单独的要求，每个都必须得到独立的认定——没有移动尺度
Held: defendant must prove patentee acted with specific intent to deceive
- 裁定：被告必须证明专利权人的行为具有特定的欺骗意图
  - Deceptive intent must be the single most reasonable inference drawn from the all circumstances
  - 欺骗性的意图必须是从所有情况中得出的唯一最合理的推论
  - Inequitable conducts requires that applicant: Knew of the reference, knew it was material, and made a deliberate decision to withhold it
  - 不公正行为要求申请人：了解参考材料，了解其实质性，并且作出了拒绝提供的刻意决定
- Held: Inequitable conduct requires “but for” materiality
- 裁定：不公正行为要求实质性作用的判断
  - Would the PTO have allowed the claim if it had been aware of the undisclosed reference倘若专利局清楚未披露参考材料，是否还是允许权利要求
  - There is an exception to this requirement for “egregious conduct” 对于“异乎寻常的行为”，该要求有例外

Cases after Therasense
Therasense 案之后的案例

- *Powell v. Home Depot* (Fed. Cir. 2011)
- *Powell* 诉 *Home Depot*案(联邦巡回，2011)
  - The Federal Circuit held there was no inequitable conduct. The failure to update a Petition to Make Special was not but-for material, and was not egregious misconduct."
  - 联邦巡回上诉法院裁定，没有不公正行为。未能更新**特别案例诉愿**并不是实质性的因素，也不是异乎寻常的不当行为。
- *Therasense v. Becton, Dickinson*, 2012 U.S. Dist. LEXIS 42100 (on remand)
- *Therasense诉 Becton, Dickinson*案,(发回重审)
  - The District Court found that the patentee's representatives had the specific intent to deceive the PTO in withholding directly contrary positions that the patentee took in securing a European patent. If the examiner had been provided with the information, he would have rejected the '551 patent.
  - 地区法院认为，专利权人的代表人有特定的意图欺骗美国专利商标局，其隐瞒了专利权人为获得欧洲专利而采用的截然相反的立场。要是审查员被提供了该信息，其原本会驳回'551'专利。
- *Aventis Pharma v. Hospira* (Fed. Cir. 2012)
- *Aventis Pharma 诉 Hospira 案*(联邦巡回. 2012)
  - The Federal Circuit upheld inequitable conduct finding. The District Court had held that 2 prior art references were material to patentability and that the inventor withheld them with intent to deceive. The judge found that the inventor lacked credibility and that the inventor had previously learned valuable information from the prior art reference.
  - 联邦巡回上诉法院维持不公正行为的认定。地区法院认为，两件现有技术引用材料对可专利性具有实质性意义，而发明人隐瞒了引用材料，具有欺骗意图。法官认为，发明人缺乏可信度，并且发明人从现有技术的引用材料中了解到有价值的信息。

Cases after Therasense
Therasense 案之后的案例

- *The Am. Calcar v. Am. Honda Motor Co. (S.D. Cal. Apr. 17, 2012)*
- *The Am. Calcar 诉 Am. Honda Motor Co.案 (S.D. Cal. Apr. 17, 2012)*
  - the District Court found that Calcar committed inequitable conduct during the prosecution of 3 patents. The court affirmed that the claims were invalid as anticipated by a 96RL navigation system, and that the inventors must have had access to the 96RL manual but failed to disclose it to the PTO. 地区法院认定，Calcar在三件专利的审查期间从事了不公正行为。法院确认，权利要求的方无效，因为相对于一种96RL导航系统没有新颖性；并且发明人一定阅读过96RL的手册，却没有向专利局披露。
  - Intent to deceive the PTO was established through circumstantial evidence. The court stated “[i]n this case, the circumstantial evidence weighs overwhelmingly in favor of a finding of intent to deceive.” The patentee knew the operational details of the 96RL navigation system were material to his inventions. He cited the 96RL navigation system in another one of his patent applications, and also based figures in the patent application on figures from the 96RL navigation system manual.
  - 通过旁证确定欺骗专利局的意图。法院指出：“本案中，对他的发明具有实质性意义的间接证据压倒性地有利于欺骗意图的认定。”专利权人知道96RL导航系统的操作细节。他在其另一件专利申请中引用过96RL导航系统，并且该专利申请中的附图也基于数字96RL导航系统手册中的附图。

Update on U.S. Patent Law
美国专利法最新进展

Agenda
议程

- Subject matter
- 客体
- Inequitable conduct
- 不正当行为
- **Joinder in patent litigation**
- **专利诉讼的合并诉讼**

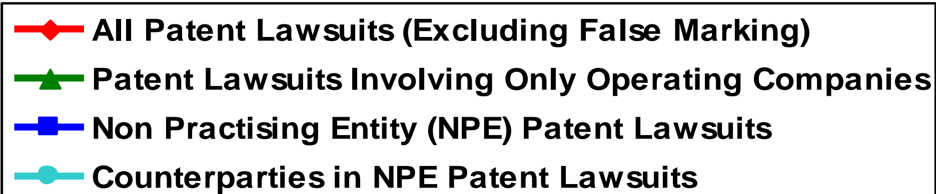
Joinder in Patent Litigation
专利诉讼的合并诉讼

- *Prior to §299 of the 2011 American Invents Act (AIA) taking effect, patent owners commonly filed a single action joining multiple defendants, with the only common link between these defendants was being accused of infringement of the same patent*
- 在2011年美国发明法（AIA）第299条生效之前，专利所有人通常在一件诉讼中加入多个被告，这些被告之间唯一的共同联系是被控侵犯相同的专利。
- Congress amended the law of patent joinder in the AIA because problems occasioned by the joinder of defendants (sometimes numbering in the dozens) who have tenuous connections to the underlying disputes in patent infringement suits.
- 由于对与专利侵权诉讼中的潜在纠纷稍微有联系的被告（有时有数十个）的合并诉讼所引起的问题，国会在AIA中修改了专利法的合并诉讼。

Joinder in Patent Litigation
专利诉讼的合并诉讼

- For example, in the 2010 case of *Parallel Networks, LLC v. Abercrombie & Fitch, Co., et al.*, (ED Texas), the plaintiff candidly explained his strategy to the court as:
- 例如，在2010年的Parallel Networks, LLC 诉 Abercrombie & Fitch, Co.等一案中，原告坦率地向法庭解释了其策略：
  - “not to go after one defendant and ask for $30 million. It was our strategy to go after a lot of defendants, get those issues resolved, hopefully by settlement.”
  - “并非仅追究一个被告，要求3千万美元的赔偿。我们的策略是追究很多被告，寄希望以和解的方式解决这些问题。”
  - The court explained that "Plaintiff has sued over 100 Defendants [in 4 cases] with the goal of early resolution of the disputes through settlement in a range that essentially amounts to litigation costs. In this case, the Patent Rules and the Court’s standard docket control order . . . make defending the case almost cost prohibitive. . . . Plaintiff’s strategy presents Defendants with a Hobson’s choice: spend more than the settlement range on discovery, or settle for what amounts to cost of defense, regardless of whether a Defendant believes it has a legitimate defense.”
  - 法院解释说：“原告[在4个案件中]起诉超过100个被告，目标是在基本上相当于诉讼成本的范围内早日通过和解来解决纠纷。在这种情况下，”专利实施细则和法院的标准案卷控制排序......使案件的辩护成本高昂......原告的战略留给被告的是霍布森选择：要么花费超过和解费范围的调查费，要么以相当于辩护成本的和解费与原告和解，而无论被告是否相信其是否具有合法的抗辩。“

Joinder Trend Prior to the AIA
AIA之前合并诉讼的趋势



所有的专利诉讼
仅涉及运营公司的专利诉讼
非实施性实体NPE的专利诉讼
NPE专利诉讼的对手

Joinder after the AIA
AIA之后的合并诉讼

- President Obama signed the Leahy-Smith America Invents Act (AIA) into law on September 16, 2011 and the anti-joinder rule went into effect that day.
- 奥巴马总统2011年9月16日签署莱希 - 史密斯美国发明法（AIA），反合并诉讼规则当日生效。
- The AIA created a new Section 299 to the Patent Act to addresses joinder and consolidation of trials.
- 由AIA产生的专利法的新第299条，对合并诉讼和合并审理作出规定
- Parties who are accused infringers may be joined as defendants or counterclaim defendants only if:
- 被控侵权的当事人，仅在下列情况下，可以联合作为被告或反诉被告：
  - (1) relief is asserted against the parties, jointly, severally, or in the alternative, arising out of the same transaction regarding the manufacture, use, or importation of the accused product or process; and
  - （1）基于生产，使用或进口被控侵权产品或方法的相同行为，而针对相关当事人——连带地、个别地，或替代地提出了救济;和
    (2) questions of fact common to all of the defendants will arise in the action.
  - （2）在诉讼中将涉及对所有被告来说具有共同性的事实问题。
- New 299 also clarifies that joinder will not be available if it based solely on allegations that a defendant has infringed the patent in question.
- 新的第299条也澄清，如果仅仅根据被告侵犯涉案专利的指控，不能进行合并诉讼。

IBM

Joinder after the AIA
AIA之后的合并诉讼

- This AIA provision is not retroactive and applies only “to any civil action commenced on or after the date of the enactment of th[e] Act.”
- 该AIA规定不溯及既往，只适用于“该法颁布之日起或之后的任何民事诉讼。”
- *In re EMC Corp.* (Fed. Cir. May 4, 2012)
- *In re EMC Corp.* 案（联邦巡回上诉法院2012年5月4日）
  - In a pre-AIA case, the Federal Circuit applied a reading of the existing joinder statute in a way that is consistent with the AIA. The court held that to join diverse defendants in an infringement complaint filed pre-AIA, a plaintiff must show that there is “substantial evidentiary overlap in the facts giving rise to the cause of actions against each defendant.”
  - 联邦巡回上诉法院在一个前AIA的案件中，采用与AIA一致的方式解读既有的合并诉讼法规。法院认为，要在前AIA提起的一件侵权之诉中加入不同被告，原告就必须证明，“在产生针对每个被告的诉讼原因的事实中有实质性的证据重叠”。
- *IpVenture v. Acer (D. Del. July 24, 2012)*
- IpVenture诉Acer案（特拉华州地区法院2012年7月24日）
  - Applied the EMC test. Claims against independent defendants cannot be joined under Rule 20's transaction-or-occurrence test unless the facts underlying the claim share an aggregate of operative facts.
  - 应用EMC检验法。针对独立被告的指控，不能按照细则第20条的交易或事件（ transaction-or-occurrence ）检验法而合并，除非指控所针对的行为，具有重叠的事实和证据。
    The sameness of the accused products is not enough to establish that claims of infringement arise from the “same transaction.”
  - 被控产品的同一性，不足以确立侵权指控缘自“同一交易”
    - Unless there is *an actual link between the facts underlying each claim of infringement*, independently developed products using differently sourced parts are not part of the same transaction, even if they are otherwise coincidentally identical.
    - 除非每个侵权指控可依据的事实之间有实际的联系，使用不同来源的部件独立开发的产品不是该同一交易的一部分，即使它们碰巧在其它方面是相同的。

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