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## Xinjiang Yuelu Juxing Building Materials Co., Ltd. v. Xinjiang Aksu Prefecture State Taxation Bureau

*Citation: The Supreme People's Court's Civil Judgment No. Minsanjianzi 16-1/2006*

*Date of judgment: August 10, 2007*

### **Procedural history**

The Xinjiang Yuelu Juxing Building Materials Co., Ltd. (Juxing) sued, in the Xinjiang Uygur Autonomous Region Higher People's Court (the Higher People's Court), the Xinjiang Aksu Prefecture State Taxation Bureau (the Bureau) and the Xinjiang Construction Engineering Group No.1 Construction Engineering Co., Ltd. (No. 1 Corporation) for infringement of its patent (ZL 99115648.X). The first-instance judgment found no infringement. Juxing requested the Supreme People's Court for retrial, and the Supreme People's Court order the Higher People's Court to retry the case. The Higher People's Court, holding that the grounds for the retrial were untenable and did not meet the retrial requirements, rejected the retrial request. Juxing requested the Supreme People's Court for retrial.

### **Issue**

How to determine the extent of protection of the patent in suit after it was partially invalidated?

### **Facts**

Juxing was exclusively licensed by Qiu Zeyou, patentee, the patent (ZL 99115648.X) for the technology of "site-casting hollow slab with pre-cast hollow, hard, thin wall member and construction method therefor". In September 2004, No. 1 Corporation used said construction method when un

dertaking the construction of an office building for the Bureau. Juxing notified the No. 1 Corporation of ceasing and desisting from the infringement. After that, Wang Benmiao, not a party to the case, requested the Patent Reexamination Board (PRB) for declaring the said patent invalid. On March 15, 2005, the PRB made its decision, declaring claims 1 - 4, 8, the first technical solution of claim 9 and claims 11-13 of said patent invalid while keeping the validity of claims 5 - 7, 10 and the second and third technical solutions defined in claim 9, wherein :

The first technical solution of claim 9 was “the axes of the singular hollow, hard, thin wall tubes are arranged in parallel in one direction”.

Claims 5 and the second and third technical solutions of claim 9 kept valid respectively referred to the invalidated claims 1 - 4.

No.1 Corporation’s hollow floor slab manufacturing technology used all the technical features of the technical solutions of the former claim 1 and its dependent claim 5 and the technical features of the first technical solution of claim 9 of the patent in suit.

The first-instance court held that the feature of arranging the axes of the singular hollow, hard, thin wall tubes parallelly in one direction used by No.1 Corporation has been invalidated. By the “all-feature” doctrine to determining patent infringement, No.1 Corporation’s construction method lacked an essential technical feature of the patent in suit, so it did not constitute an infringement.

The second-instance court held that the second and third technical solutions defined in claim 9 were essential technical features of the patent in suit while the respondent’s technical solution for construction arranged in parallel in one direction, that was, the essential technical features were missing in the alleged infringing product or method, and the latter did not constitute an infringement.

The second-instance court held in its retrial of the case that No.1 Corporation indeed used the first technical solution of invalidated claim 9 in its construction. Since said technical solution, already declared invalid, was no longer protected under the law and the regulations, No.1 Corporation’s

use of said technical solution did not constitute an infringement. Juxing's grounds for the retrial were not tenable, and did not meet the retrial requirements, so its retrial request was rejected.

Juxing argued in its request filed with the Supreme People's Court for the retrial of the case that the respondent's technical features had fully covered all the technical features of the technical solution formed by combining invalidated former claim 1 and dependent claim 5 kept valid, and the extent of protection of its invention patent should be determined by the terms of the new claim formed by recombination of the validated former claim 1 and dependent claim 5 kept valid.

No.1 Corporation argued in its defense that after the original independent claim of the patent was invalidated, the extent of protection of patent should be determined by the terms of the new claims formed by recombination of all the claims kept valid and the claims they referred to, not by the terms of the new claim formed by recombination of claims 1 and 5.

### **Rule of law**

Article 56, paragraph one, of the Patent Law *The extent of protection of the patent right for invention or utility model shall determined by the terms of the claims. The description and the appended drawings may be used to interpret the claims.*

### **Reasoning**

After a patent was partially invalidated, the extent of protection of the patent should be determined respectively by the terms of each claim that was kept valid and the claims it referred to. That was, the technical features of the claims that were kept valid and those of the claims they referred to jointly defined the extent of protection of the patent. Since the technical solutions cited in the claims that were kept valid were complete, and different from each other, they should be separately protected.

According to the relations between the claims that were kept valid and the claims they respectively referred to, claim 5 and claim 1 it referred to, and the second and third technical solutions of claim 9 and claim 1 it referred to should respectively be the basis on which the extent of protection of the patent was to be determined. In the present case, since the retrial requester claimed that

claim 5 and claim 1 it referred to be the basis for determining the extent of protection of the patent, the court should, in its trial of the case, compare all the technical features of the two claims with the corresponding technical features of the allegedly infringing product, and it should not further refer, in the technical features of claim 5, to the technical features of claim 9. Since the two respectively claimed different technical solutions, one did not depend on the other.

Since No.1 Corporation used all the technical features of the technical solution formed of the former claim 1 and its dependent claim 5, the two respondents' allegedly infringing product fell within the extent of protection as determined by the terms of the former claim 1 and its dependent claim 5 of the invention patent.

***Holding***

After a patent was partially invalidated, comparison should be made between all the technical features of the technical solution formed of each claim kept valid and the claims it referred to to base the determination of the extent of protection of the patent on.