Erick Robinson

U.S. patent attorney based in Shanghai: 16 years of experience in litigating patents worldwide for law firms and companies.

- BA Physics/Computer Science, Pomona College
- JD, University of Texas
- MBA, Indiana University (2017)
- IAM Strategy 300, The World’s Leading IP Strategists
- USPTO, Registered Patent Attorney

Mobile (USA): +1 713 498 6047
WeChat: erickrobinson
Email: Erick.Robinson@BeijingEastIP.com
Erick Robinson Is An Authority On China

THE WALL STREET JOURNAL.

TECH

China’s Patent-Lawsuit Profile Grows

Country becomes venue for suit filed by Canada’s WiLAN against Japan’s Sony

Xperia Z5 Premium smartphones, manufactured by Sony and offered by NTT DoCoMo, drew attention at an event introducing the devices in Tokyo last year. PHOTO: KIYOSHI OTA/BLOOMBERG NEWS

By JURO OSAWA

November 7, 2016

HONG KONG—When a Canadian patent-licensing firm wanted to sue Japanese electronics company Sony Corp., it chose an unlikely

The Canadian company’s goal is to reach a licensing deal with Sony, said Erick Robinson, a China-based attorney who is advising WiLAN in the Sony case. “Three or four years ago, I wouldn’t have advised any foreign company to file a patent lawsuit in China,” because the country lacked an effective system for enforcing intellectual-property rights, Mr. Robinson said.
Rebuttal

Why China Is A Good Place For NPEs

Law360, New York (March 13, 2017, 4:40 PM EDT) -- In the Law360 guest article "What To Expect From NPE Activity In China," published on March 9, Jackie Wong of Xiaomi addresses an important topic. However, his conclusion that China will see little nonpracticing entity activity over the next five years is short-sighted. I currently represent several NPEs in China, and my view is quite different. The purpose of this article is not to substantively rebut any "NPEs are evil" arguments but rather provide a different perspective on "what to expect from NPE activity in China."

Erick Robinson
Chinese companies are learning to take advantage of a maturing domestic patent system, laying claim to patents even if they weren’t the first to develop the broader technology, said Erick Robinson, chief patent counsel for Asia Pacific at the Rouse China law firm. “It is still relatively rare for Chinese companies to attack and be successful against Western companies, but you’re going to see more and more of this,” he said.

Qualcomm’s licensing model will be “destroyed” if it can’t win key China case, says its ex-Asian patent director

IAM today caught up with Erick Robinson, who until 2015 served as Qualcomm’s director of patents, Asia. Based in Beijing, he is now chief patent counsel, Asia for Rouse, who explained, “…Further, this case is important to the entire Chinese patent system. Qualcomm is well known to have an extremely strong patent portfolio – the best patent portfolio in the mobile industry – and if it cannot secure a litigation win or force a settlement based on the newly improved Chinese patent enforcement system, it will be a setback for the Chinese courts and ultimately, China itself. This is because foreign companies will lose some faith in a court system that has increasingly proven itself very efficient, effective, and fair in adjudicating patent disputes in China.”

Apple’s Challenges in China Underlined by Patent Dispute

By EVA DOU and DAISUKE WAKABAYASHI
Updated June 17, 2016 6:55 p.m. ET

“Chinese companies are learning to take advantage of a maturing domestic patent system, laying claim to patents even if they weren’t the first to develop the broader technology, said Erick Robinson, chief patent counsel for Asia Pacific at the Rouse China law firm. “It is still relatively rare for Chinese companies to attack and be successful against Western companies, but you’re going to see more and more of this,” he said.”
“China’s ability to protect patents has grown after decades of non-existence and nonenforcement. In 10 years, the number of patent litigations filed has more than quadrupled, with close to 10,000 cases submitted last year. The Chinese government’s new specialised IP courts now provide companies with an enforcement mechanism comparable to, if not better than, those in Europe and the US. Litigation in China also offers many advantages to patent owners, including win rates above 75 per cent (and even higher for foreign patentees), injunction rates above 95 percent, short time to trial, scant discovery and low costs (less than one-tenth of those incurred in the US). Most importantly, because so many supply chains pass through China, a single litigation can effectively impose a global ban on sales of a disputed product.”
Erick Robinson Is An Authority On China

RECENT PUBLICATIONS/PRESENTATIONS

- “Why China Is A Good Place For NPEs” IP Law360, March 13, 2017
- “How to Obtain Effective Evidence in China” Managing IP, October 2016.
- Patent Enforcement in China: For Executives and In-House Counsel, Text, To Be Published Early 2017

QUOTED IN MAJOR PUBLICATIONS:

- “At Bottom, Nowhere to Go But Up, Patent Inventors Say” Bloomberg BNA, November 18, 2016.
- “WiLAN Must Navigate Its Local Relationships with Added Care as It Wades Deeper into the Asian Patent Market” Intellectual Asset Management (IAM), November 8, 2016.
- “NPE Assertion Comes to China as WiLAN Subsidiary Files SEP Suit Against Sony in Nanjing” Intellectual Asset Management (IAM), November 4, 2016.
- “How to Obtain Effective Evidence in China” Managing IP, October 2016.
- Patent Enforcement in China: For Executives and In-House Counsel, Text, To Be Published Early 2017

Why China?

- **High win rate (75% - 95%)**
- Foreign plaintiffs win more than Chinese plaintiffs (but must do their homework)
- **Virtually guaranteed injunctions (99%)**
- **Short time from filing to trial/judgment (6-14 months)**
- Sparse discovery = **Low cost**
- Validity challenges are often not complete until after judgment (and injunction)
- **Dominant Chinese market** for sales (largest worldwide for many electronics) and manufacturing (largest worldwide)
- Specialized IP Courts and judges that take pride in their skill and fairness (**no discrimination against NPEs**)
- Although a civil law system, judges seek out and respect prior decisions
- Government has demanded that the courts be fair and create a strong enforcement system
- Forum shopping available (a Best Buy in Longview...)
- Pre-trial asset freeze available – freezing bank accounts, inventory a useful negotiating tactic
- System for blocking goods due for export at Customs is well developed
Injunctions are Virtually Guaranteed
Length of Cases Continues to Shrink, Especially for Foreign Patentees

Duration of proceedings for Foreign and Chinese plaintiffs

Data from CIELA.CN (Invention Patents Only)
One study that suggests foreign companies are now better able to protect their intellectual property was done by the London-based law firm Rouse. In analyzing 346 first-instance patent infringement cases initiated by foreign plaintiffs between 2006 and 2014, the firm, which runs the Beijing-based intellectual properties litigation database CIELA, found an 82 percent win rate (282 cases).

In a separate study, Beijing-based Kangxin Intellectual Property Agency Co. Ltd., an affiliate of law firm Kangxin Partners, found an 89 percent win rate in 102 first-instance patent cases initiated by foreign plaintiffs (102 cases won) between 2013 and 2015.
“We’re asking the court to assist us and get them in compliance,” said Don Rosenberg, Qualcomm’s general counsel in a telephone interview. “China is really making a concerted effort, including having the special IP courts, to enforce intellectual property rights and to value intellectual property rights. We’re putting our faith in the court system there and we wouldn’t do that if we didn’t think we were in capable hands.”
Accordingly, if BYD is not prevented immediately, and pending a final determination in the arbitration, from continuing the Chinese Patent Litigation, Apple and Apple’s supply chain may suffer serious disruption. Such disruption will irreparably harm Apple, Apple’s reputation and goodwill, and the millions of consumers and businesses who demand Apple’s high-end innovative products.
Shenzhen Baili, a little-known startup, won a surprise injunction against sales of Apple’s iPhone 6 and iPhone 6 Plus in Beijing, based on a patent covering smartphone design. Apple said the order had been stayed pending appeal and sales remain unaffected.

Apple Understands the Danger of Chinese Patent Litigation

- In June, **Apple also lost a patent litigation in Beijing** to a nearly bankrupt Shenzhen-based company, Baili.

- The patent in suit was a **design** patent.

- Apple has **appealed** and the injunction has been stayed pending appeal because Baili did not apply for a preliminary injunction.

- Both parties are waiting for the appellate court in Beijing to adjudicate the infringement issue.

- If the court holds for Baili, then an injunction can be immediately instituted on the infringing products with **no bond needed**. This is true even if the validity issue has not yet been addressed. If the patent(s) is/are later ruled invalid, then Baili can no longer enforce the patent(s) but they need not reimburse Apple for any harm in the interim.

- If the court invalidates the patent(s) before or at the same time as addressing infringement then no injunction can be issued. If the court invalidates the patent(s) before or at the same time as addressing infringement then no injunction can be issued.

- Drawings from patent:
Damages Are Increasing

The Beijing IP Court last week (8 Dec 2016) awarded damages of 50,000,000 RMB ($7.2M USD) in a patent case. This included 49 million RMB in civil compensation plus 1 million RMB in legal fees. This is one of the first instances of a court awarding legal fees to a prevailing party based on the time spent on the matter.

This is one of the first cases after the new burden-shifting rules for damages. Thus, damages were not limited to statutory damages. This is the beginning of a new phase in patent damages in China.

- Chinese v. Chinese
- Relatively small case
- Technology related to USB security
- Largest damages by that court
- One of first cases after damages burden-shifting rule

Chen Jinchuan, deputy director of the court, said they have been enhancing IP protection by greatly increasing compensation from rights violators, especially those committing bad faith and repetitive violations, so that the cost of IP infringement will no longer be low. "The market is the best frame of reference to determine the value of IPs," he said.

http://www.ebeijing.gov.cn/BeijingInformation/BeijingNewsUpdate/t1461670.htm
<table>
<thead>
<tr>
<th>MONTH</th>
<th>1</th>
<th>2</th>
<th>3</th>
<th>4</th>
<th>5</th>
<th>6</th>
<th>7</th>
<th>8</th>
<th>9</th>
<th>10</th>
<th>11</th>
<th>12</th>
<th>13</th>
<th>14</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>1</strong>– 4 months</td>
<td><strong>1</strong>– 4 months</td>
<td><strong>1</strong>– 3 months</td>
<td><strong>&lt; 30 days</strong></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
</tr>
</tbody>
</table>

**Litigation Timeline**

- **Plaintiff files civil complaint**
- **Court accepts complaint**
- **Court initiates service of complaint**
- ** Defendant files response**
- **Court serves response on plaintiff**
- **Evidence submission and exchange**
- **“Preliminary” Injunction**
  - **Appeal filed (stays injunction)**
  - **Court hearing**
  - **Injunction**
- **Judgment**
- **Defendant can file challenge to jurisdiction (to be decided within 45 days by statute)**
- **Defendant files invalidity action at Patent review board (patent litigation rarely stayed) (pendency 1 - 2.5 years)**
- **Filing to judgment in just over a year**
  - **(Appeal is additional 6-12 months)**
Litigation Timeline

When an appeal is filed by the defendant, the injunction is normally stayed.

For maximum leverage, a “preliminary” injunction request can be filed or renewed after winning at first instance (trial court). Because the patentee has already shown infringement, this PI request will likely be granted.

However, a bond must be posted by the patentee before the PI is enforced (no bond is required if the defendant does not appeal or the defendant loses the appeal).

Defendant can file challenge to jurisdiction (to be decided within 45 days by statute)

Defendant files invalidity action at Patent review board (patent litigation rarely stayed) (pendency 1 - 2.5 years)

Filing to judgment in just over a year

(Appeal is additional 6-12 months)
Bond Calculation for Preliminary Injunction

• The amount of bond required is generally **inconsistent across courts and judges**, and no statistics are available.

• Only consistency is that the amount is **much less than the amounts required in Germany**.

• According to the Supreme People’s Court’s judicial interpretation, the applicant shall provide a guarantee equivalent to the preservation amount, and the court will decide the amount based on the **specific circumstances of the lawsuit**.

• The local courts generally use the same standards, and the applicant must provide **bond equal to the amount of damages claimed**.

• According to Beijing higher court’s provisions, where the applicant cannot provide the bond equal to the amount claimed, if the parties' rights and responsibilities are clear and irreparable damage will occur, **the court may require 20% of the amount claimed**.
### Bond Calculation for Preliminary Injunction

<table>
<thead>
<tr>
<th></th>
<th>Beijing</th>
<th>Shanghai</th>
<th>Jiangsu</th>
<th>Zhejiang (Shaoxing)</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>Principle</strong></td>
<td>Equivalent to the preservation amount</td>
<td>Equivalent to the preservation amount, or no less than the damage that could happen due to wrong preservation.</td>
<td>Equivalent to the damage that could happen due to wrong preservation.</td>
<td>The guarantee should be 20% the preservation amount</td>
</tr>
<tr>
<td><strong>Exception:</strong></td>
<td>For applicants unable to provide an equal amount of guarantee</td>
<td>If the case meets both conditions,</td>
<td>Reference for the determine of guarantee when unable to identify the damage:</td>
<td></td>
</tr>
<tr>
<td></td>
<td>1. rights and obligations of the case is clear</td>
<td>2. If not preserve in time might cause irreparable damage</td>
<td>20% when the preservation amount is below RMB 10 million; 10% when the preservation amount is between RMB 10 million to 100 million; 5% when the preservation amount is above RMB 100 million.</td>
<td></td>
</tr>
<tr>
<td></td>
<td>Then the guarantee should be no less than 20% the preservation amount</td>
<td>Reference for the determine of guarantee when unable to identify the damage:</td>
<td></td>
<td></td>
</tr>
<tr>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
</tr>
</tbody>
</table>

---

Reference for the determination of guarantee when unable to identify the damage:
- 20% when the preservation amount is below RMB 10 million;
- 10% when the preservation amount is between RMB 10 million to 100 million;
- 5% when the preservation amount is above RMB 100 million.