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專利制度及專利法(108)

專利之補充、更正與修正（三）

3、中、美有關修正法制之主要歧異：如前所揭，就補充、更正或修正此一命題，我專利法係以說明書、圖式或圖說為規範對象，而民族性不同之美國專利法則明文凡善意錯誤（通常為文書或打字錯誤或輕微文字錯誤之屬）之本質者，不問涉何專利事項，俱有適用。就此錯誤而言：

A. 須為善意：可愛之老美，凡事講究善意。任何錯誤只要出乎善意，常可補救（世間事了不起花錢消災？）。故此「可愛」錯誤（人本屬易犯錯之脆弱動物），自不應使生專利無效之效果。更有趣或令人感佩者，其證明善意常僅須出具一份宣誓書，敘明錯誤始末。不論信不信神（耶穌），其社會無形中受神（或誠實）之規範。如我國引進此一制度，經我泱泱中華文化薰陶之國人似僅將援之以為文過飾非之工具耳？

B. 依美國專利法規定：來源有三，即一、因官方而生者；二、因申請人而生者；三、事屬贅漏發明人。前兩者通常屬文書或打字錯誤或輕微文字錯誤，至後者較為離奇，故須舉證事實。就前兩者更正之原因言，「單純」之美國人常係為使文件呈現完美狀態而已，「務實」之我國國民則常係因預慮何種錯誤內容將有致生何等不幸結果之虞，而「千方百計」試圖成功為修正。人間是非或強弱本難一時論斷，如「單純」與「務實」竟能造就今日中國與美國之國力分野，則我國究應於來日培養何詞句「？？」之國民性格，俾與「單純」相抗衡？更令人讚嘆者，乃依我智慧財產局之見解：

I. 案件未准者：如欲更改贅漏之發明人，不論出因如何美妙或令人同情，其申請日將延至正確發明人出現之時。縱使因此而使案件喪失新穎性，亦非所問。嗚呼！「官逼民反」其此之謂歟？國家對人民殘忍，如何期待人民愛國？國格、民族性、國家強弱，法律條文可見之？

II. 案件已准者：所有程序已走完，申請人或發明人皆不得再事申請更正發明人，其理由為更正發明人將延後申請日，而因案件已然公告核准，一來專利公報豈非白公告一場，二來「官員何忍予奪人民辛苦獲得之專利權？」此處官方之「好心」對照前段之「殘忍」，吾人究應「噴飯」，抑或「啞然失笑」？

C. 對象：複雜之人間百態，錯誤以何方式出現於何處，本難逆料，故美國法並不限制錯誤究將出乎何處？乃我專利法必欲以說明書、圖式或圖說為規範唯一對象，並拒斥、漠視或禁止其他地方之出錯。孰是孰非，豈非顯然？明知不及他人之美，卻又不屑效習他人之長？此種文化真屬泱泱國度者所應備具？

D. 內容：一般錯誤常屬輕微或可得即辨，故美國法並不一其類型，而不以說明書、圖式或圖說為主要規範對象已明於前。然如就此一專利世界核心部份生有錯誤者，則此種錯誤應係文書或打字錯誤或輕微文字錯誤之屬，實乃易於想像或理解，蓋錯誤如發生於此一核心部份，卻非若此輕微或顯可得辨之屬者，則如何期待此錯誤之更正，無須專業審查委員為助，僅須行政人員即可斷知其所涉變更不構成新實質內容或不須再審查？

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4、補充、修正與更正之別：我國法並存三者，美國法僅存後者，其定義已分別略敘在前。然仍待吾人探討者，乃：

A. 補充與修正區別何在：表面上，「補而充之」與「修而正之」實有大別。設有某說明書，其就元件間連結關係之陳述生有錯誤，然此錯誤並非案件關鍵特徵所在，且其錯誤乃熟習本技藝人士所能判知，而能輕易矯正。此種錯誤依我國實務，得為矯正應無疑義！然依美國實務，縱係此種錯誤之更正，亦須說明書或圖式何一部份得能支持，方始可行！換言之，縱審查委員亦同意其錯誤乃即可判明，如無支持論據，雖該審查委員得依一己之心證而逕為該專利之核准，然亦無權許申請人「就該明顯錯誤」為修正。蓋依該特定審查委員之心證，該錯誤固係「明顯」或「輕微」，然依「真理」或他人之「確信」，實未必若是。既然如此，何不留存史料，由後人自行判斷？為使說明書之敘述合乎邏輯，而為值得典藏之有價值文獻，就此錯誤之主、被動矯正，究屬「補充」，抑係「修正」，即難無疑問。查，就其錯誤乃即能判知或矯正以斷，該錯誤之矯正應屬「修正」；然就其錯誤之矯正，無可避免須為「全新描述」之添加以觀，復以「補充」為肖。徘徊在模糊界線之間，無以絕群疑於相異措辭之際，我最新版專利審查基準第四章，乃逕名之以「說明書及圖式之補充修正、更正」，技巧性忽視法條「補充或修正」文句中「或」一字，致凡須提及者，即一律並用，冀得「掩耳盜鈴」之功？矧其原意，當係既無以區別於其間，則何妨並用之以杜錯誤或話柄？

B. 依前揭我新版專利審查基準，「補充修正」之三大利益如下：

a. 申請人得藉以消除申請文件中不當缺陷，增加發明獲准專利之機會：果此事為真，則大眾權利無以確保之餘？國家專利水準欲躋於先進國家之林，亦將遙遙無期矣？
b. 公眾得因發明內容之描述更臻清楚明白，而明確認知其請求專利保護之範圍，減少侵權疑義及困擾：果此事為真，則一來「實質內容變更」之貞潔因而蒙塵？二來「申請專利範圍」將變得如「村夫愚婦」般和藹可親？三來「侵權鑑定」將不再令人煩惱或敬畏如昔？
c. 專利專責機關進行審查時，亦得因專利申請文件適當完整之補充修正，而縮短審查時間提昇審查效率：果此事為真，則非但申請人將視（、事或敬）審查委員若父母？專利審查亦不再有積案？而人民亦將視審定書如聖旨而心悅誠服矣？

生物科技上之概念與落實同存主義:雙股螺旋之雙重標準(十九)

-John M. Lucas, Ph.D.

D. Regents Of The University Of California (加州大學理事) v. Eli Lilly & Co.

相反地，南印第安那地方法院與聯邦巡迴法庭很容易發現，若此申請案未揭露核　序列，一申請人並不擁有一主張保護之 DNA。在書面說明之要求下，對一主張保護之 DNA"精準定義"以證明 *Fiers* 中所述概念之要求，在 *Regents of The University of California v. Eli Lilly & Co.*中亦有適用。*Eli Lilly* 為一加州大學理事("Regents")對抗 Eli Lilly 公司("Eli Lilly")之專利侵權案例。Regents 對 Eli Lilly 提出控訴，指稱 Eli Lilly 侵犯其人類胰島素 cDNA 編碼之專利(美國專利第 4,652,525 號)，哺乳類胰島素 cDNA 編碼之專利(美國專利第 4,431,740 號)，以及脊椎動物胰島素 cDNA 編碼之專利(美國專利第 4,431,740 號)。Regents 的專利主張保護人類與脊椎動物胰島素之 cDNA，但僅揭露老鼠胰島素 cDNA 之真實序列。Eli Lilly 反過來主張，根據 35 USC Section 112 第一項，因為發明人未對所主張保護之標的提供必要的書面說明，因此 Regents 主張保護自然人類胰島素原 cDNA 的專利申請範圍無效。除抗辯此主張受 *Amgen* 所支持外，Eli Lilly 主張"當一發明人無法想像一基因之詳細組成俾得與其它物質區分，以及其製得方法時，*概念在落實前無法達成*，換言之，直到基因單離出來前概念仍無法達成。

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本國專利制度新知(八)

智財局於 89.11.30 公告修正其所訂定專利審查基準第九章「異議、舉發、依職權審查」之部份內容，其主要對於「異議、舉發理由與證據之補正」之期限做出較為寬容之解釋，其中之重點在於原基準內容規定「若逾一個月補提證據係與原引證證據無關連性者，則屬新證據，例如，原引證證據為公開型錄或公開交易之統一發票、樣品，而補提證據為他人之某一專利前案，顯然前後所提證據並無關連性，其所補提者屬新證據，倘已逾法定期間，自應不予受理。」已被修正為「惟八十九年十月三十一日新修正公告之「專利申請文件補正事項管理作業要點」，其中第八點已針對上述逾期補正異議或舉發理由、證據之情事，規定於審定時仍應審酌，不得因其逾期補提而不予受理。故逾越一個月期間補提者，無論屬補強性質或新內容者，均應受理審酌之。（另見附註五）惟需注意有無踐行送請被異議人、被舉發人答辯之程序。〔附註五〕行政法院關於上述法定補正期間之見解關於異議、舉發補提理由及證據之一個月期間，行政法院曾於 85 年度判字第 2284 號判決認為舉發人補提（新）理由及證據時，縱使已逾上述期間，如原處分

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- 東吳法碩甲組碩士
- 聖島專利商標事務所國外所主任(71-74 年)
- 理律法律事務所資深成員（75-76 年）
- 各專利商標事務所特約英文專利說明書撰稿及顧問(77-80 年)
- 創立道法法律事務所(81 年~)

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機關尚未處理完畢時，仍應就其補提之理由及證據為實體上之審酌，不得因其逾期補提而不予受理，並於 86 年度判字第 1473 號再審判決仍認為舉發補提

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（新）理由及證據屬程序之行為，其性質並非不變期間。近期復於 89 年度判字第 1957 號判決仍持上述相同見解。此亦導致「專利申請文件補正事項管理作業要點」第八點之配合修正。」，由上述可知，異議舉發人在異議舉發案尚未處理完畢之前，皆有權力補提理由及證據，而審查委員亦必須進行實體上之審酌，不得因其逾期補提而不予受理。

智慧財產權報導（6）

《美國》對新統一特許權要約通告(UFOC)格式改變之時點激起特許權者之策略性問題

新的指導方針將迫使既有特許權要約通告做廣泛的變更。北美證券管理協會(NASAA)已明白表示兩個主要目的。首先，藉由要求"平易英文"之使用來為簡化及澄清 UFOC 所含之揭露。其次，為使不同州的版本合理，俾一項基本文件經由州指定提出及附帶之增加而得為全國性的採用。再者，一些新的指導方針顯然被設計為找出特許權者部分之實務，使諸多特許權受讓者及負責保護特許權受讓者之州務員覺得厭惡或在特許權體制上顯得無力。

在有效日後，所有初始註冊，更新，及再註冊必係以此新格式，但特許權者可以繼續使用舊格式，直到此類事件之一發生。

特許權從業者所面臨的一主要問題是在逐漸採用的期間，要改寫他們客戶的 UFOCs。此修改由於該新版本包括大量的新資訊，將係廣泛且昂貴的。儘管它剛開始對盡可能避免重寫 UFOC 之花費及勞力似乎合理的，但對許多登記者而言，盡快為之則有一有力理由。

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對大部分特許權者進行改變之"落閉"期將自 1995 年起每年為重新申請。雖然有些註冊州對各特許權者無論其有效日皆准予一整年之註冊，但其他州（加利福尼亞、夏威夷、明尼蘇達、紐約、南達科塔及威斯康辛）則訂定註冊期滿日及對應特許權者會計年度結束之重新申請義務。在此些州，註冊會在特許權者的會計年度結束後 90 及 120 天之間期滿，俾允許涵蓋對特許權者大多數最近會計年度之經稽查財務報表。（待續）

美國專利實務之重要改變

軟體專利性之發展

EPO 上訴法院之最近判決對尋求電腦程式發明保護之申請人而言是一大幫助，這些判決藉實際除去排除從電腦程式專利性之影響而形成法律。

此外，保護電腦程式法規限制的移除（於 52 條（b）(c)）是 EPC 修正中被討論的一部份現行議題。另一方面，由於保護"實行心智行為或做生意的發明"的限制法規似乎很可能保留，以至於我們不會指望今在美國邀准專利（且訴訟）之單純"生意方法"申請專利範圍在歐洲也獲開放。

EPO 利用第一次發展於 Vicom （Vicom/影像處理，T208/84, 1987, EPOJ 14）訴願的原則以評估軟體發明的專利性。如果發明提供一技術領域之貢獻，則發明被認為具有可專利性。EPO 不拘於認定必要技術貢獻的存在，且今只要求"技術考量"應加入軟體發展的考量。他們已經准 30,000 篇與軟體相關之發明專利於資訊技術核心領域，例如數位資料處理，資料辨識，資料表現與儲存。在實務上，一歐洲專利申請案真的很少以缺乏技術特質而遭拒絕。

下述判決描述歐洲專利局於可邀准專利之標的項目與被准許之申請專利範圍類型如何走向美國專利局與日本專利局的做法。

T769/92 "Sohei"(EP-B1-0 209 907)

Sohei 案例(Sohei/適用管理系統，T769/92, 1995 EPOJ 525)藉於資料檔案之提供與進行不同管理類型之檔案間的資料轉換中尋找一技術貢獻而發展法律。此發明係關於"一種包括至少一財務與存貨管理之複數種獨立管理之電腦系統"，其中所有類型管理的處理係經由一顯示於一顯示單元之共用"轉換滑道"而輸入。（待續）

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中國大陸的電子商務法概觀
-重點與更新(一)

政府間的國際組織，如聯合國國際貿易法委員會(UNCITRAL)與非政府組織如國際商會(ICC)已經在1996 年為電子商務標準制定聯合國國際貿易法委員會模範法供其會員國或組織選擇性的使用。他們成為國際間發展本國電子商務法的指導方針或骨架。許多政府如新加坡、香港與台灣已經採用該模範法做為制定其本國法律的基準。

無疑的，正在以遊說的方式進入世界貿易組織(WTO)的中國大陸，必須要追上管理無邊界的自動化空間之現代潮流。不像其它已經制定法律以強化及培養急速上升的電子商務的政府，中國大陸已經制定許多傾向於禁止或妨礙電子商務迅速創立的法律，特別是在國家機密或國家安全須要考慮到的時候。

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歐洲專利局審查實務目前的發展(四)

捌、異議

去年做了一個於異議實務上極為重要的決議，即擴大訴願委員會決議 G3/97（Indupak lG / Hartdegen, Emmerich Ing.）。由擴大訴願委員會處理之該決議改變了對於被指任異議人本質的一般性瞭解。擴大訴願委員會之早期決議中，闡述異議人不可以由"稻草人"所庇護，例如歐洲專利代理人。換言之，被指任異議人必須為對所異議之專利有利害關係之一當事人。擴大訴願委員會決議推翻此理解，且聲明除非於某些特定情況下，任何人皆可被指認為異議人。這些特定情況包括有被指任人實為未合格的代理人，或被指認人代理專利權人而本身竟可以對一專利自我異議而扮演專利權人的角色。

也就是說，未來時，競爭者可以異議一專利，而毋須專利權人即刻注意到異議人本質。

於異議實務之另一區域中，技術訴願委員會決議T1116/97（SITMA SpA / Buhrs Zaandam BV）確認了於異議程序中，建立異議理由舉證責任的負擔落於異議人身上之長久持續原則。只是因為專利權人沒有討論一問題點並不意謂著該問題點舉證責任的負擔已由異議人轉換至專利權人身上。

關於異議中證據認定之一事，技術訴願委員會決議 T389/95（Motorola / Nokia Mobile Phones）確認了於異議程序中提出任何證據之期限為在九個月的異議期間內。其後所提出之證據只有因為特定理由才會被接受，例如對修正之申請專利範圍提出之回應、關於聲稱為該技藝普遍技術或證據系列差距或集中辯論過程才出現的爭辯之無法預料的挑戰。該決議闡明了，如果異議期間後提出之證據不具回應性或雖有回應性但過度延緩，則異議部門有權力忽視該證據。其立論點為：專利核准過程中所涉之公共權益並不會惡化為一永無止境的障礙賽。很明顯地，歐洲專利局正逐漸地採取「雖然核准有效專利是重要的，該理想不應該被異議人操控至一連串進退不得之使一有效專利僅於一漫長過程終點才能出現之意圖」之觀點。

關於異議過程中之證據提出，訴願委員會決議T249/98 （Spanninga Metaal BV / Widek Metaalwarenfabriek）確認了，根據一習知技術使用的異議，使決定習知技術使用之日期、已使用哪些部份與習知技術使用情況成為可能的事實必須全部一併於異議申請書中提供。日後異議程序提供這些事實是不足的。然而，其確認了，支持這些事實的證據可以於提出異議申請書之後再提供。

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行為違法性與教師懲戒權

七、教師懲戒行為違法性之探討

（一）教師懲戒行為並不如父母之懲戒權有民法第一０八五條之明文規定，且教師本身並非司法機關，本不具有制裁他人之合法權利，惟對受懲戒者而言，其實就是在進行制裁之行為，而伴隨侵害學生權利之後果，惟一般學者均以由於人類文化傳承功能之導向影響之理由，所以承認教師對學生有合法懲戒之權力[註一]，惟此種權力隨著重視兒童人權之觀念趨勢下，應在具備教育觀點之前提下，亦即須合於考量學生之性格、舉止、身心發展及不良行為之程度等因素下所進行之懲戒，分屬合於教育目的之懲戒行為，自得因合於社會倫理秩序之需要而阻卻違法，反之，如教師所採取之懲戒行為或許縱非體罰，惟如非基於教育學生之目的而為之，致學生之心理健康或身體成長有所侵害時，仍不得阻卻其違法性[註二]，而我國現行法並無教師懲

戒權之明文規定，自無依刑法第二十一條第一項規定阻卻違法[註三]。

(二) 教師懲戒之法理基礎，一般學說約有以下二者[註四]：

1、雙親懲戒權之委託：主張此說者認為，子女於上課期間，可視為父母此時段對子女之教育權權委託學校或老師，而發生民法上之委任關係，因此，教師基於親權受託人之地位，於必要範圍內，得對學生施以包括體罰在內之懲戒行為，則對於為教育學生之目的所為之維持秩序等管理行為，自亦包括在許可之內。

2、教師之教育自由：教師之教育自由可由憲法第十一條之講學自由中導出，因此，學校或教師可居於教育專業之立場，依教育原理及其所信之教育方法對學生施其教學，如教師不具懲戒權，則其教育權將無法實現，而為授業、生活教育、保護責任、維持秩序等，當須對違背義務者課以一定程度之懲戒，此即教育權中蘊含有懲戒之由。

3、以上二學說中，以後者即教師之教育自由說為通說，蓋如認教師之懲戒係基於雙親之委託，則每個家庭對子女懲戒之程度不同，有些家庭對子女之管教相當嚴格，有些家庭則對子女管教相當寬鬆，惟如一班級中，有部分學生來自於管教相當嚴格之家庭，其他部分學生則來自管教相當寬鬆之家庭，如認教師懲戒權係來自於父母之委託，則教師對於同班級而父母管教寬嚴不一之學生，其懲戒權之內容亦不一致，如此，即會產生不公平之現象，且與教育之目的不符，是故，學者通說認為教師對於學生之懲戒權應係源自於教師本身之教育自由[註五]，惟管見以為，教師本身之教育自由並無法導引出教師對學生之管理甚至懲戒之權力，換言之，二者並無法劃上等號，蓋教師之教育自由係教師本身之權利，學生並非其教育自由之權利客體，而就教師之秩序管理權力，應係基於「契約關係」，蓋學生基於與學校訂定之教育契約（應為一無名契約），學生有義務遵守學校所規定之校規等規定，故學生自應服從學校所聘任之教師（中小學以上之教師）或在學校服公職之教師（小學教師），為達成教育目的所為之必要管理行為，惟教師之管理行為自亦應符合教育之目的，且不得逾越必要之手段，否則亦無法阻卻行為之違法性。

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註一：參閱楊淑芬著「體罰的刑事責任」第六一頁，東吳大學一九九五年六月碩士論文。
註二：同前註論文第六二頁。
註三：我國學者之著作中，對於教師之懲戒討論並不多，學者蘇俊雄將教師之懲戒權臚列於「基於法令及職權之行為」而阻卻違法，詳參閱氏著「刑法總論Ⅱ」第二三八頁至第二三九頁，學者黃常仁則將教師懲戒權列於超法規阻卻違法事

由之中，詳請參閱氏著「刑法總論」（上）第一一一至第一一二頁，管見認為以學者黃常仁先生之見解為宜，蓋教師之懲戒於我國並無明文規定，自不屬依法令之行為，而是否為教師之「職權」，於法無明文之情形下，尚無定見，故管見認為於我國教師之懲戒應以超法歸阻卻違法事由之標準加以判斷其是否阻卻違法。日本之學校教育法第十一條即明文規定教師對學生有懲戒權，因此在日本教師對學生之懲戒行為可認定係依法令而阻卻違法，此為與我國最大不同之處，詳請參閱木村龜二著「刑法總論」，昭和六十一年四月十五日曾補版初版第八刷第二七八頁。
註四：引自范乃中著「論教師的教育自由」一文，一九九六年六月輔仁大學碩士論文第一三三頁。
註五：同前註。

油與水不可混-

North Cape 漏油事件與 Penn 460 漏油事件比較

Penn 460 漏油事件

用以決定肇事者的責任範圍之因素，同於 North Cape 漏油事件，但大部份有程度上的不同。首先漏油量接近於 9000 加侖，約為 North Cape 漏油量的 1 %。第二，漏油發生在平靜的夏季天氣裡，風浪狀況並沒有加劇漏油混合於水層中的效應。第三，所漏出的油密度遠低於 North Cape 之漏油，且大部份皆浮在水域表面；此意味著漏油的衝擊受限於水層的最上層，並不會到達龍蝦或甲殼類動物居住之底層。第四，不需要或者是沒有預期去進行漏油事件之刑事偵察，所以無重大過失或故意為不當行為之任何證據下，使肇事者得依 OPA 保護，使其自己獲有限制責任。

雖然可預期到，聯邦與州政府當局可能會經由與 North Cape 相同的代理機關代理人來主導評估因漏油事件受損的自然資源，此評估所投注的努力程度與花費可能不及 North Cape 漏油事件，但是可能只基於電腦模擬運用之結果來評估。

交涉與反應之相同點

關於漏油事件的第一步就是清理油污。在上述之漏油事件之個案裡，聯邦與州政府當局與肇事者合

作，以進行此清理問題。此重要因素在於：藉由肇事者與它的承包商的行為有助於控制清理的花費。

第二步為：在漏油事件的個案中成立關於提交仲裁、價值評估以及個人損害請求的進程。在每一個案中，肇事者僱請一個索賠調停公司，以建立當地辦公室與發佈提交仲裁與評估請求的步驟。既然肇事者應全然的負起責任，請求過程中唯一之議題僅在決定損害的因果關係與數量。這裡之重點在於：由肇事者與它的承包商迅速與適當的來處理損害請求，對肇事者終將有較低的財力支出。

在個案中之最後一步為進行與完成自然資源損害評估與回復過程。在 North Cape 漏油事件中，此過程之和解結果為確定肇事者的民事責任，使繫於 Block Island Sound 的一個龍蝦 v 型峽道復育計畫之結果以及支付一額外金額之賠償。在 Penn 460，此計畫則尚未開始，但是固定金額賠償的和解將會是其可能結果。

結論

自從 1990 年 OPA 法案訂立後，釋出油品於美國水域，對肇事者而言已變成一項非常昂貴的事件。雖然依 OPA 與並對應的州政府法令的責任是嚴格的，對於這類突發事件的肇事者，仍有許多方式去限制其財力支出。早期的仲裁調停與全程參與，包括從一開始的清理活動，到損害評估與請求過程，皆藉由有經驗的律師團、負責清理漏油之承包商以及環境顧問團等，乃能有最佳的機會說明此種漏油事件限制其責任。

法律現場-著作權(一)

灰色商品(Grey Goods)亮起了紅燈

外國公司所製造並出口至南非的商品通常會受到商標法或是著作權法的保護。而這樣的商標或著作權的權利通常授給外國的所有人。一個由外國所有人委任的南非銷售人通常係專屬性質而其銷售商品，僅係為了其自身的利益。然而，在一些案件中，由獲授權的外國公司製造的原始商品經由獲授權的銷售者以外的路線進口到南非。這樣的實務，通常稱為「平行輸入」或「灰色商品」(Grey Goods)導致獲授權的當地銷售者及某其他銷售者皆販賣原始商品，其他的銷售者可能從其他國家的外國所有者經授權的源頭獲得原始商品。

灰色商品被視為對專屬銷售者的懲罰。他們會尋求憑藉著商標法及主張不公平競爭，以企圖削減灰色商品的貿易—在大部分的情況不很成功。然而，著作權是智慧財產權之下的一個分枝，可以是而且成功地被專屬銷售者使用在灰色商品上限制經銷商。為了達到這個目的，專屬銷售者在其銷售商品的國家內，做了一個讓渡契約，以規範關於商標上任何著作權方面的事，例如一個標誌或具顯著性手寫體型式。如此為之的銷售者見於 Frank&Hirsch (Pty) Limited 與 A Roopaand Brothers (Pty) Limited 這個案子中，上訴法院判決:若藝術品在包裝中並且置入構成藝術品之一個有聲音的卡帶的容器，在南非會享有著作權方面的保護，並且銷售者如同著作權的所有人，有權去限制錄音帶的平行輸入品。

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南非智慧財產權法的修正提議

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限制水平實務

合理的禁止在如果介在水平關係的當事人及對於市場具有實質阻止或較少競爭的影響之契約或協議的實務將被禁止，除非該契約或協議之當事人能證明技術性、有效性或其它有助於競爭的利益超過反對競爭的效果。這個禁止並非無限制的：一個義務被賦予契約當事人，其通常為智慧財產權擁有者去證明由修正或實務會引起有助於競爭的利益。

在向競爭為委員會及貿易和工業部門提出的提案中，指出專利權經由例如是專屬授權契約之一般利用，或是專利權人及專屬被授權人共同實施專利權（如被專利法所允許），能被視為這個禁止條款的違反行為。

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為避免這樣的違反行為，專利權人將必須釋明技術性或其它有助於競爭的利益超過反對競爭的效果。

絕對的禁令

契約或協議的實務也被禁止，如果牽涉任何以下限制的水平實務，即

*直接或間接訂定一個購入或賣出價格或其它貿易條件；

*藉由分配買主、領域或商品或服務的特定型態來分割市場；或

*串通投標。

這些實務絕對地被禁止且沒有任何可能有助競爭的

利益之評估規定，基於此，智慧財產權將被牽涉於這樣的實務中。

我們認為依照慣例的方法，亦即智慧財產權例如藉由在國家內的不同區域或就商品或服務的不同範圍授權予不同被授權人，此時將構成這些絕對禁止的違反行為。無疑地，此明顯的矛盾乃需要被解決。

智慧財產權在法律上的發展

PCT 的期限

在指定的會員國申請內國申請案的截止期限，將從優先權日算起最少 20 個月或最多 30 個月。因此，假如 PCT 申請案的其它優勢被運用，對於 PCT 的同盟國而言，申請案可獲得最少 8 個月至 18 個月的延長期限。這些額外的時間可用以決定是否至任何指定的會員國提出申請以及依照所做的決定行事。

這裡有許多好消息。在任何 PCT 申請案，檢索是被執行的並向申請人提出報告，指出在申請案所定義之發明特徵相關的技術水平。這份報告包含有關檢索人員對於本發明獲得專利可能性看法的有益指示。這些資料對於做有關是否及至何處花費專利經費的決定時是非常有利的。

一般 PCT 申請案及檢索報告將在申請日起 18 個月或稍後被發表。

PCT 第 19 個月是很重要的。它是請求有關 PCT 申請案獲得國際發明專利可能性的初步審查報告的最後截止期限。國際判斷專利可能性的標準與美國的判斷標準基本上相同，但是他們具有不同的標籤。

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審查報告在指定會員國的專利局並無約束力，在那裡內國階段的專利申請案可能稍後經由 PCT 申請。如此，全面性有利的報告是非常具有說服力的。

假如國際初步審查已於 PCT 申請案請求並有適當的記載時，在被指定的會員國申請內國階段申請案之 PCT 期限可延長至 30 個月。

因此，考慮在其它國家（PCT 會員國或地區）提出專利申請案時，使用 PCT 提出國際申請案對於內國申請的費用支出可延期 8 個月，或更常見的一般 18 個月，其比較基礎是：假如這些相同的申請案都在巴黎公約下申請，而這些所籌款項之花費，可能白白浪費掉。

美國發明人或他們的雇主是 PCT 在世界上最大的使用者。當他們一看到，就知道它是一個有益的工具。藉由使用這個工具，他們比起巴黎公約只提供唯一的方式到國外申請，能更明智及有效率地花費他們的專利經費。

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歐洲之生物保護與授權許可（八）

規則第 23 條 b 項第五款係有關於植物或動物生產之一種"實質地生物性"程序之定義。關於此新的 EP 規則之措詞，相較於 EPC 第 53 條 b 項具有更具體明確之定義，該定義即是倘若在此可獲取動物或植物之程序中任一步驟中，確有人類行為（或無論任何一種技術）干預介入者，即是屬於非"實質地生物性"，而不論該程序是否曾一度被需要或是再三地被實現完成。

規則第 23 條 b 項第六款最後定義出"微生物程序"，即為任何程序中有一步驟表現出，或結果導致，亦或僅包括一微生物材料者即可稱之，就名詞定義言，該定義相較於上訴委員會所建立之判例法（參考如 T356/93）似乎有點較廣泛。

新的規則第 23 條 c 項明確地規定出所謂具可專利性之生物科技發明，也包含了明確可專利性項目之一個不具排他性列表。尤其是：

規則第 23 條 c 項 a 款係關於發現與發明之區別劃分以及新穎性之原則。若可以藉一種技術程序由自然環境上所分離出以及能夠形成一種工業產品，則不僅可應用在自然產物上，譬如蛋白質或其他可被分離成純化形式之自然項目（便於能提供給社會大眾）或人為地製造生產（由化學合成或由重組 DNA 技術），當然也是可以應用在基因層次上。

歐洲生物技術發明之專利授權

Dr. Bernard Huber, Muller-Bore & Partner

(五) 修正案

有關修正案之法律基礎是記載於歐洲專利公約第 123 條及法規第 88 條。

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歐洲專利公約第 123 條

第二項 對一歐洲專利申請案或一歐洲專利而言，若其修正內容 超出原先

之申請實質內容，則此修正將不被允許。

歐洲專利公約法規第 88 條

在歐洲專利申請文件中，語言或翻譯之錯誤或誤繕是可視需求而加以更正。但是，若此更正之請求與申請專利之說明書、申請專利範圍及圖式有關，則此更正必須是顯而易見的，並即可明瞭其別無該更正以外之其他任何意涵。

從此有關擴大訴願委員會之判例，可明下列事項：

—歐洲專利申請案或一歐洲專利之說明書、申請專利範圍及圖式，僅有在一熟知該項技藝者能經由一般知識且從原申請專利文件整體中即可直接推導得知之範圍內，才能加以更正。

第七版

至於非屬專利說明書、申請專利範圍及圖式之部份，其應用唯於其申請日之際，能滿足一般知識之證明的範圍之內，始得為之。

範例

在一專利申請案中，一 DNA 序列被揭露，該 DNA 序列包括一已知訊息ᵥ ᵏ 之序列以及編譯一新蛋白質之序列。

1. 編譯該新蛋白質之 DNA 序列有一錯誤，而正確之 DNA 序列已在優先權文件中揭露。但是，該優先權文件可能無法作為更正依據。再者，該蛋白質 DNA 序列之錯誤並無法從習知之技術中推知，所以，此更正之請求並非顯而易見，因此將不被允許。
2. 該已知訊息ᵥ ᵏ 之序列有一錯誤，而正確之 DNA 序列可從習知技術中得知。所以，此更正之請求為顯而易見，因此將被允許。

結論

若一發明包括一 DNA 分子之序列，含有該 DNA 分子之轉化子應被寄存。而寄存是說明書的一部份，所以該轉化子所含的 DNA 序列將可作為該 DNA 序列的更正基礎。

1999年美國新專利立法摘要(5)

by WEBB ZIESENHEIM

第四章第 F 節規定一種隨意之兩造參加(inter parte)重新審查(reexamination)程序，其係包含重新審查請求、決定、順序、訴訟實施、訴願及某些程序上的禁令。第四章本節全部專門規定一種新的重新審查實施之形式。本節目前已生效。

最後，在第 G 節及 H 節中，則修改某些組織上及其他各項規定，包括：

1. 建立 USPTO、商標審判及訴願委員會(Trademark Trial and Appeal Board)及專利訴願與競權委員會(Board of Patent Appeals and Interferences)的權限、職責、組織、公共諮詢委員會、報導及其他各項規定；
2. 准許暫時申請案得依請求改請為一般申請案；
3. 延長暫時聲請案未決期間，倘若該期間最終日為週六、週日或國定假日中之一，則延至次日；
4. 延長 WTO 會員國人民較早申請日之利益，以及亦修正植物育種人的權利；
5. 准許對 USPTO 提交電子文件申請及從 USPTO 電子傳輸專利副本至公共圖書館，及相關電子維護；
6. 執行調查生物寄存的研究，以支持生物技術專利；
7. 與建立某些事實來創造競權期間之§102(g)阻礙；
8. 禁止某些專利及申請說明書以及圖式之副本未經授權即送至非 NAFTA 或非 WTO 會員國。

總而言之，該項法案係對美國專利法作全盤性的改變。相關改變發布於美國法典公告中，且無疑地，將導致聯邦規則法典中新的規定。

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翔實 DNA 及蛋白質組成物申請專利範圍為何主張生物均等物可鼓勵創新 (五)

有關 Amgen 公司的申請專利範圍第七項，法院陳明：由於 EPO 基因的結構複雜性、改變其結構之主要折疊可能性，及其相似物所具有的效用所伴隨的不確定性，我們認為需要更多關於確認申請專利範圍內的各種相似物與其製造方法，以及製造與 EPO 活性相似之化合物所需結構的必要條件。已經製造之此基因及未經清楚確認其活性之少數相似物，是不足以在申請專利範圍中主張所有可能具有 EPO 相似活性的基因序列。

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據此，法院因其未能教導熟習此技藝之人士其所主張發明之全部範圍，而駁回申請專利範圍第七項。

自 Amgen 案例以來，Federal Circuit 不再改變其觀點。在 In re Deuel 案例中，申請人分離出兩種

編碼肝素結合生長因子(heparin-binding growth factor, HBGF)之 DNA 分子。基於此 DNA 序列，Deuel 決定出其蛋白質之胺基酸序列，其中具代表性的申請專利範圍第四項為：

4.一經純化且分離的 DNA 序列，其組成為一 DNA 序列可編碼 168 個胺基酸之人類肝素結合生長因子，該 168 個胺基酸序列為：

Met Gln Ala……

PTO 並非因為缺乏翔實揭露而駁回此申請專利範圍。然而，Federal Circuit 附帶質疑申請專利範圍是否翔實揭露：“因為 Deuel 的專利申請案並未描述如何獲得除了所揭露的 cDNA 分子之外的任何 DNA，申請專利範圍第四項…可能不足以被本案所揭露的內容支持。” 隨後法院建議 PTO 應該按照 Amgen 的判例，檢閱申請專利範圍是否翔實揭露。

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澳大利亞智慧財產權集錦（一）

澳大利亞進入國際商標系統

澳大利亞已加入國際商標系統，提供於海外銷售商品及服務之澳大利亞公司及於澳大利亞從事商業行為之外國公司重要利益。

依新系統所為之註冊商標即所謂「國際(International)」或「馬德里協定(Madrid Protocol)」商標即將得藉由二種方法取得：

· 一澳大利亞申請人得為一單一商標申請註冊其商標於四十九國。迄今，澳大利亞申請人，除歐盟國家(其得涵蓋於單一申請案)外，須得於各國單獨申請。

· 一外國商標申請人得為一商標申請指定澳大利亞為其中之一國。

申請人主要商業交易之國家係馬德里協定“聯盟”之會員者，得獲得國際商標系統之利益。加入多邊協定之會員國包括英國、法國、德國、義大利、瑞典、新加坡及日本。而美國則預期於一年左右加入。

國際商標申請將於各指定國依各國商標法分別審理。依該系統取得註冊事實上將係眾多之內國註冊，故如侵害及註冊之除去(例如無效、未使用……等)事件，仍適用各別內國商標法。

國際商標註冊之所有人能透過一單一內國申請延展註冊，而無須至每一國家為延展之申請。

“澳大利亞加入馬德里協定”將提供以國際為中心之澳大利亞企業可觀成本花費節省之機會。

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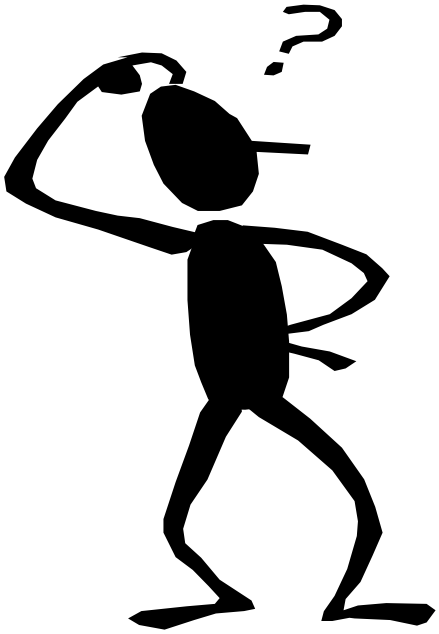
東海大學法律系

法訊新知

美國專利商標局專利實務規則修正

此外，美國專利商標局(USPTO)於 2000 年 11 月 7 日起基於專利事務目的實施新法規。依該新法之規定，主張小實體資格者將不再須要提供經簽署之小實體表格予 USPTO。惟小實體適格之要件並未改變，所不同者僅在於小實體資格正式確立適格之程序，此應予注意。加之，於美國當地之修正實務亦有所改變。關於說明書之修正，現須提供修正之替代段或替代頁。而



申請專利範圍之修正，則須提供修正後之完整申請專利範圍，取代先前使用之修正部份括弧及劃底線。專利事務目的法規之相關資訊參：http://www.uspto.gov/web/offices/dcom/olia/pbg/index.html.

如吾人所期，前開修正將重大影響專利申請程序及 USPTO 與申請人兩造。其修正重點乃在於加速申請至專利核准間之申請程序。

西班牙民事訴訟程序修正

西班牙民事訴訟程序新法於 2001 年 1 月 8 日生效。該實施之訴訟程序相類似於其他西方國家者，乃明顯偏重口頭而非書狀。

新系統將有一針對智慧及工業財產事件程序方面之基本規範，如中間救濟、專家意見及其它程序之一般觀點。

(西班牙民事訴訟新法之進一步介紹，將擇期刊載，敬請期待！)

人常在追求表象之超越中，忽略底蘊內含之真正進步；人常在富麗堂皇之炫惑中，錯漏樸素昇華之燦爛奪目。人常因經年累月身處陰暗，忘記陽光普照之欣欣向榮；人常因無時不刻錙銖必較，不見天覆地載之涵攝人寰。

其實，中國可以是偉大的、超強的，問題在於你、我如何緬懷過去、度過今日、規畫未來？

平行進口之法律問題業經世界各國智慧財產權界精銳鑽研、討論已有百年歷史，其間各項理論燦爛紛陳，迭有高潮，然百家爭鳴，莫衷一是。值此政治統獨論爭不斷歲月，令人煩躁。爰效中國古有智慧，發為螳臂擋車之言語，妄期此一百年擾攘之國際難題因此或有定於一尊之可能？雖才疏學淺，觀點可能令人噴飯，既已不慎發表國際，如有大謬，恐為外邦竊笑，尚請國人基於同胞之誼，伸以援手是盼！

吾人走在孤寂道路上，蠟燭兩頭燒。青春快逝，年華易走。因時間不足，完稿未曾核對，脫落在所難免。因個性使然，下筆之際未曾精密佈排，為文但求行雲流水，管他已否詮釋完足。故尚可發揮之處所在多有。缺論文題目之研究生，何妨補遺之？

Parallel Import — Can We Easily Rein It In? © (Part I)

by C.F. Tsai

Field of Endeavor

This article relates to any category of major intellectual property rights, and more particularly to the issue of parallel import related thereto.

Background Statement

Taken literally, the parallel import must relate to an act of import. Because it is parallel to something else, there comes the terminology of 'parallel import.' Accordingly, there must be an import act and another act or fact, which underlie this controversial topic. At first, we would like to list all the basic possibilities by means of practical examples which present the issue of parallel import for easy discussion and illustration. As any one knows, before there comes the issue of parallel import, we have a first trademark owner A who owns a first trademark right of a specific trademark in X country and a second trademark owner B who owns a second trademark right of a trademark the same with or similar to the specific trademark in Y country. While trademark owners A and B can be the same entity, an importer C buys and causes products labeled with the specific trademark in X country to be imported into Y country. Specifically, we have the following situations:

1. Trademark owner A is different from Trademark owner B, but they are affiliated entities. In this situation, we have two sub-situations as follows:
   I) Trademark owner B can exercise its own discretion as to how to exploit the second trademark right;
   II) Trademark owner B can make its decision as to how to make use of the second trademark right only after having obtained approval from Trademark owner A;
2. Trademark owner A is different from and has no affiliation with Trademark owner B, but Trademark owner A assigns the second trademark right to Trademark owner B;
3. Trademark owners A and B are of the same entity, and the goods imported into Y country are manufactured by Trademark owner A or B;
4. Trademark owners A and B are of the same entity and the goods imported into Y country are manufactured by a licensee D licensed to manufacture the imported goods by Trademark owner A or B.

Under any one of the above situations or sub-situations, we have the following two cases:

i) The quality of imported goods is the same to that of those manufactured by Trademark owner B;
ii) The quality of imported goods is different from that of those manufactured by Trademark owner A.

The quality here we mean is defined to include kinds of possible and relevant definitions, e.g. the one referred to conventionally, the one associated with the service after-sale and the one guaranteed from defects…etc.

As having been disclosed, the parallel import issue must involve in an importer who imports goods from a foreign country and a trademark owner who often causes to locally provide or locally manufactures goods being thus 'parallel' to the imported ones. Since the imported goods generally come from a real Trademark owner A, the goods are 'genuine' ones. Nevertheless, such goods might harm or somehow infringe the rights of the local Trademark owner B so that these goods are frequently named non-identical products or ones from the gray market (not so black as a black market, but not so white as a white market according to Mr. M. Franzosi).

Why does the parallel import issue arouse so many and big waves in relevant societies including academy and court? It is easy to understand that a standard or convincing answer is never easily available for a controversial topic or an issue in rigorous dispute. Why is a topic or issue controversial or in rigorous dispute? It is easy to answer: the issue involved is too complex or difficult. What kind of issue can be lawfully categorized as complex or difficult? It appears that an objective answer would be: it might be one which is newly developed so that the human does not have enough experiences or time to solve it, one which seems to be so diversified that it is beyond manageable, or one which somehow exists till now but has not been strenuously tried solved. Does the parallel import issue fall into such purview? Is it possible that this terrifying issue is solved by this article?

Summary of Developments

It is therefore an object of this article to present an overview as to how the parallel import issue occurs.

It is therefore another object of this article to deal with problems from different aspects as to how the parallel import issue can be put under control.

It is still an object of this article to figure out a proposal attempted to rein in the parallel import issue.

There must be reasons on which pros and cons can base their confidences to advocate as legal and rebut as illegal the parallel import. We will list major ones of such reasons in the following for further discussions immediately succeeding thereto. The pros often apply the following reasons as their bases:

P1). Under the exhaust theory, since an IPR (intellectual property right) owner has ever enjoyed its rights at the first time of trading a product on which the relevant IPR is embodied, how the identical specific product will be ultimately disposed of is never related to the owner in any way.

Discussions: This theory will find short of strength if questioned as follows:

Q1) Any theory developed for any law cannot extend its effect beyond the realm of the country in which said any law is enacted. As such, while the domestic exhaust theory must be accepted to be correct, it is never viable for us to assert that there must come an international exhaust theory.

Q2) According to the trademark territorialism (here we use trademark merely for clarity rather than complete coverage since there are other applicable rights), the rights of a trademark owner shall not be deteriorated or abated by acts happening or performed in a foreign country. Accordingly the trademark owner should be allowed to enforce its rights through kinds of measures including seeking to enjoin the parallel import.

P2). Now that the product to be imported in parallel is genuine, how can the law unlawfully intervene in such act?

Discussions: This assertion will find short of strength if questioned as follows:
Q1) What should be discussed for the parallel import issue is whether or not such act is permissible rather than whether the imported product is genuine.
Q2) "Genuine" as a term has two meanings: one to denote genuine so far as the respective sources of origin are concerned and one denoting genuine so far as the specific local trademark owner is concerned. If whether the parallel import issue is legal can be decided by clarifying whether the imported product is "genuine", how one can boldly allege which meaning is the correct one meant by "genuine" here?
P3). Conventionally, a trademark is designed to identify the source of origin of specific goods. If there is no problem on this primary function, why such act should be otherwise banned?
Discussions: This reason will find short of strength if questioned as follows:
Q1) The law not only is always behind the technology but also behind the time. The law can also get old. Although the trademark law might be initially enacted to identify the source of origin of specific goods, the trademark law need not always so play, as evidenced by the fact that it has been established that a trademark additionally can assure for the consumer the goods of a specific quality, can advertise the business of a trademark owner or can express the goodwill of the trademark owner.
Q2) It might be controversial about how to interpret the term, "source of origin." Specifically, if we interpret it to stand for the local source, the parallel import act will become illegal automatically.
P4). The trademark law is enacted to enhance benefits of the consumers so that if the parallel import act can add furtherance in this respect, why it should be somehow curbed?
Discussions: This reason will find short of strength if questioned as follows:
Q1) Although it is indisputable that the trademark law is intended to enhance benefits of the general public, it is unnecessarily correct that this object is to be performed by the parallel import.
Q2) Even if the parallel import does bring forth benefits for the consumer, it never is readily clear whether the parallel import act achieves this object in the manner the trademark law is contemplated. Specifically, it might be possible that the trademark law originally tries to obtain this object through strictly monitoring the direct correlation between the goods and the business of the trademark owner. Although the time is changing, should we naturally take it for granted that the parallel import should be allowed merely because it can add the completion of this object? Is it possible there will be adverse effects if we do not follow what the trademark law is originally contemplated?
P5). The trademark law is stipulated to grant the trademark registrant an exclusive right but never an undue monopoly. If the parallel import is prohibited, the trademark owner would be likely to obtain a monopoly which is never contemplated by the trademark law.
Discussions: This reason will find short of strength if questioned as follows:
Q1) Permitting the parallel import might contribute to the undue monopoly, but the undue monopoly needs not necessarily be performed by the permission of parallel import.
Q2) It is unclear whether the parallel import could fall into the purview of exercising the exclusive right of a trademark owner. If yes, the parallel import issue will make no weight here. If not, is it correct that the parallel import must contribute to the formation of the undue monopoly? Are we right in correlating the parallel import with the undue monopoly?
P6). Although according to the trademark territorialism, trademark rights in different countries are mutually independent, the constructed goodwill nevertheless is integral and inseparable internationally so that the parallel import will make no damage to the trademark owner.
Discussions: This reason will find short of strength if questioned as follows:
Q1) If the goodwill of a specific international business is integral, how we can freely stand before the fact that one of various trademark rights in different countries has a relatively higher fame but the other one in another country only has a relatively lower reputation?
Q2) If the goodwill of a specific international business is inseparable, how we can explain the fact that even if various trademark rights in respect of the same trademark in different countries are owned by the same entity, the entity can legally possess one of them in a country on the one hand but can lawfully assign the other one trademark right in another country to the other party on the other hand?
Q3) Even if the goodwill is integral and inseparable, is it necessary that the parallel import makes no damage to the trademark owner?
P7). Even if the quality of the parallel import goods is different from that of the locally manufactured products, a specific trademark can be wonderfully construed that the goods affixing thereon the specific trademark possess a quality to a certain extent but needs not be mechanically interpreted as those labeled with the specific trademark must have the identical quality since a certain number of goods are subject to a kind of quality difference even if they come from the very same source.
Discussions: This reason will find short of strength if questioned as follows:

Q1) It goes without saying that an article under a trademark must have a certain quality. Nevertheless, are we confident to allege that a trademark affixed article must have a quality above a certain acceptable degree? If yes, are we correct in taking that all articles having quality above the certain degree, with or without the trademark concerned affixed, no matter what the sources of origin might be, can be freely transacted without intervening the trademark law?
Q2) If the quality problem can only exist because it is dependent on other functions of the trademark, is it proper for us to determine whether the parallel import will violate the trademark law from the viewpoint whether the parallel imported goods have a quality of a certain degree? This will be found even more disputable in view of the fact that different batches of goods from the same source of origin will or must have different 'qualities," macroscopically or microscopically.
P8). Price difference never is a good excuse for rejecting the parallel import since the lower the price is, the more benefits the consumer reaps.
Discussions: This reason will find short of strength if questioned as follows:
Q1) Theoretically, it is possible that the price for the parallel import goods is higher than that of the locally provided goods. If this is the case, is this reason still one to be held in the pro-side?
Q2) If the lower the price is, the more benefits the consumer has but the less the goods provider will reap, could we answer how or why the entire human society will ultimately have a net negative or positive?
Q3) Is the price a necessary factor for us to consider whether it is legal for the parallel import? If it is, what the role it should play in such consideration? Is it real that the lower the price is, the more benefits the consumer will reap?
P9). The importer merely imports the parallel goods and does not use in any way a specific trademark. As such, how one can have the heart to fabricate a charge for its importing act?
Discussions: This reason will find short of strength if questioned as follows:
Q1) As is known, the trademark owner has the exclusive right to use a trademark on the specific goods. Strictly speaking, if this is the correct definition for a trademark right, since the parallel importer does not have by itself any act in 'applying a trademark on' the goods, it does have not used the trademark in any way. Nevertheless, it could be more accurate or correct to define a trademark right as that the trademark owner has the exclusive right to cause a trademark to be embodied on the specific goods. If the definition can be so made, it would appear the parallel import will fall into the scope of such definition.
Q2) Although it would appear that we can establish easily the parallel import qualifies as a kind of use of trademark, the question whether the parallel import is legal still exists but does not diminish.
P10). It is never a truth that the quality of the parallel import goods is always inferior to that provided by the trademark right owner so far as the basic or conventional quality, the after-sale service or the other interests are concerned. As an example, the quality of some parallel import goods which require no after-sale service is never inferior to that manufactured by the local trademark right owner. Even if the parallel import goods require an after-sale service, it is not seldom found it is never difficult to get the goods after-sale served.

Discussions: This reason will find short of strength if questioned as follows:
Q1) At least in Taiwan, it has been said that the quality of some counterfeited goods is superior to that of genuine goods. If this does be the case, it would naturally appear that the quality is not a good problem to question the parallel import.
Q2) It has been proposed that what quality is meant here includes the conventional quality, after-sale maintenance, lottery-drawing…etc.. It is clear, however, the most important factor for buying a product is whether it can properly work before it becomes broken for the first time rather than whether the consumer can easily call for maintenance for the broken product. Accordingly, if the product can duly perform its work before it breaks, is it so important for us to take the after-sale service problem into consideration? This would be especially true if the product in fact requires no after-sale.
Q3) It is more interesting to consider this factor by standing before the fact that some parallel importer will perfectly perform the after-sale service. Furthermore, it is not seldom found that the after-sale service provider for the genuine goods will not necessarily reject to provide maintenance for the parallel imported goods. As such, will it be required for us to consider the after-sale service problem while seeking answers for the parallel import.
If all the above reasons applied by the pros are not so convincing or persuasive, shall the pros give up their adherence to their original position? How they can base their position on what kind of other theories or reasons? Are there really other more sound reasons for the pros to find their stout bases?
The cons often take the following reasons as their weapons to illegitimate the parallel import act:
C1). It can easily be understood that a free-riding act is never a good or legal act. Now that the parallel import is so much closely related to such free-riding act, how we can have the guts to legitimate the parallel import?
Discussions: This reason will find short of strength if questioned as follows:
Q1) "A poison can be used as an antidote for another poison." By this proverb, it is meant even if what is recognized as a poison, it never means that it is totally useless. Instead, it can be an antidote or medicine for wonderfully combating another poison. This means that there must be two poisons. It is not certain whether we can list the parallel import or free-ride as a poisonous act in the society. If yes, it appears to be also uncertain whether the society exists another poison requiring this antidote. Nevertheless, according to Taoism, any law is a poison. If this is the case, the trademark law certainly is a poison. The remaining question is thus whether the free-ride or the parallel import is a correct antidote for the trademark law.
Q2) As just mentioned, whether the parallel import is good or evil is not readily apparent. Even it is evil, it is unnecessary that it must be useless. Even if it is so much closely related a free-ride, it needs not necessarily be a free-ride. Even if it is a free-ride, it needs not necessarily be a 'poison.'
C2). A trademark is to guarantee a quality for the goods having thereon the trademark. Since the parallel import goods often have inferior quality, why our benevolent mind will permit the consumer to be possibly damaged?
Discussions: This reason will find short of strength if questioned as follows:
Q1) It is true a trademark is generally intended to establish a brand loyalty. It appears to have some difficulties in defeating an allegation that a brand loyalty is constructed through a specific property on the goods with a specific trademark rather than a quality thereon. Although the quality should be a factor, important, perhaps, in building up the reputation of a trademark, it needs not be able to successfully represent all what the 'specific property' is to express.
Q2) If the specific property rather than the quality is the determinant for correlating the consumer with the trademark, is it proper for us to be so serious as to take the quality as an important element in commenting the parallel import issue? Sometimes, the specific property is irrelevant to the quality.
Q3) Even if the parallel imported goods have an inferior quality, if the consumer obtain them in a lower price, is it necessary that the consumer thus get damaged? Is it unfair that a lower price should only be able to make an article of an inferior quality available? Is it fair that the consumer who only desire or are used to buy an article at a lower price deserve to be punished through being provided with articles of an inferior quality in order to 'wake them up' some day to respect or to examine carefully whether what they are to buy or have just bought is genuine or not?
C3). If the trademark owner is not properly protected, there will be no motivation for it to duly and/or generously manage its business which will in turn cause damages to the consumer in the long run if it cannot be protected against parallel import.
Discussions: This reason will find short of strength if questioned as follows:
Q1) It has been similarly disputed whether the patent system does act to promote the invention. The questioner alleges that even if there is no patent protection, the manufacturer will be always driven to provide a more powerful new product in order to keep a role of leader in the relevant field (we will not involve in any more discussions here in this respect). Now that the government bestows the trademark owner a trademark right, it certainly should be protected somehow. The problem is that how we can be confident that the trademark owner has been properly protected? Is the prohibition of the parallel import a compulsory measure in protecting the trademark owner?

Q2) Is it true that if the trademark owner is unwilling to adequately operate its business, the consumer will thus be damaged eventually? Unlimited expanded populations chase limited resources on earth. Dare the trademark owner not seriously run its business if it desires its business to subsist in the long run?
C4). The conventional theory of universality had been powerfully abolished by the US Supreme Court in A. Bourjois & Co. v. Katzel in 1921 and 1922 Tariff Act adopting the modern theory of territoriality by which it is meant what the parallel importer does will mislead the consumer to confuse the parallel import goods with goods from the local trademark right owner. Accordingly, there is no room for parallel import to subsist.
Discussions: This reason will find short of strength if questioned as follows:
Q1) 'Global village,' a term so much bewitching, great and moving, which is said to be the spectacular trend of the marvelous future is to be carefully cast through various endeavors, e.g. the formation of a World Trade Organization. Although it has lapsed years since the United Nations has been established, the world does not appear to be more lovely. If the ideal like the global village is indeed the dream all the human being should pursue, what is the reason why we discard the theory of universality so easily? Is it real that the modern theory of territoriality is better or more correct than the theory of universality? If yes, it appears to be very interesting to realize and examine reasons or bases for comparison.
Q2) By what kinds of criteria, it is concluded that the consumer will be mislead to confuse the parallel import goods with the local trademark owner's ones. Is our answer the same if the consumer can distinguish the parallel ones to the local ones? What the situation will be if the parallel importer has adequately delimiting the parallel ones from the local ones?
Q3) If we were to distinguish the parallel import goods from the locally supplied ones, is it a good measure to apply the modern theory of territoriality? Is the modern theory of territoriality specifically created to curb the parallel import? If the parallel import were to be prohibited, is it a right recipe for us to invent the modern theory of territoriality?
C5). According to trademark territorialism which is internationally recognized nowadays, a lawful act, i.e. buying legitimate goods in a foreign country is never a good pretext to locally legitimate an illegal act, i.e. the parallel import.
Discussions: This reason will find short of strength if questioned as follows:
Q1) If the exhaust theory is an internationally applicable truth and the trademark territorialism is a nationally applicable truth, why an international truth must subordinate to the national truth? Policy- or law-lobbyists, or even the law interpretation normally stand with the side where the pressure or interests originate. Is the trademark territorialism related to the parallel import? Is it possible that the trademark territorialism is derived from the jurisdiction territorialism, which means that a specific government cannot exercise its jurisdiction beyond the territory it effectively rules, which means that a trademark right owner cannot enforce its rights beyond the territory where the specific government resides? Is it possible the trademark territorialism is over-exploited if it were to serve as the basis of the parallel import? In this era for breaking down kinds of trading barriers, is it possible for the territorialism being a kind of tariff barrier to subsist in a longstanding manner?
Q2) The parallel import phenomenon includes two acts, i.e. buying legitimate goods in a foreign country and importing the bought goods into the national market. It is unclear how these two independent acts should be related? It is not readily apparent why the exhaust theory should be repealed. It is clear that the trademark owner having two local trademark rights

should be separately protected in two different territories. It is not, nevertheless, necessitated that the very same single article should be protected twice in order that the trademark right owner can 'illegally' double reap its benefits for the very same trademark. The necessity why it must seek registered respectively in two different countries does not originate from the fault of the consumer. It is the fault of the United Nations which has not yet unified the world and ultimately requires the trademark owner to respectively register its trademark in various countries. Why is it the trademark owner rather than the consumer who could reap its interests on the fault of the United Nations?

Q3) The act of buying legitimate goods in a foreign country can be independent of or relevant to the act of importing the bought goods into the national market, depending on what viewpoint we are taking. What is the correct viewpoint we should adopt in discussing the parallel import issue?

C6). Goodwill needs not be established internationally since it is easily discernible that the goodwill can only be constructed from locally to internationally, or from a small extent to a large extent. Since it is impossible for the goodwill to be internationally uniform, it readily comes the conclusion that the goodwill cannot be internationally judged by the single standard. Since it is hardly possible for the trademark owner to build brand loyalties in different countries to the same extent exactly, it is equally impossible to legalize the parallel import without damaging the local trademark right owner somehow. Just like the government grants a patent right in exchange for a technical disclosure from the patentee, the trademark owner must ensure a guaranteed quality on its goods in exchange for the brand loyalty from the consumer.

Discussions: This reason will find short of strength if questioned as follows:

Q1) It is true that goodwill needs not be established internationally, but it is equally true whenever there is a parallel import issue, there always involves an inter-national trademark. It can be deduced from viewpoints having been proved in various fields of sciences that even if it is impossible for the goodwill to be internationally uniform, a model simulating what we desire to judge can be constructed by using various parameters if a single standard is impossible. If the parallel import is righteous, can we illegitimate it simply because the local trademark right owner is somehow damaged? Isn't it a truth or natural rule in the world that the benefit of a specific person is normally based on the loss of another person?

Q2) Since a trademark owner stands at the strong side of the society, is it not an obligation that the trademark owner must ensure a guaranteed quality on its provided goods in exchange for the trademark rights conferred by the government? Is it not proper for the trademark owner to try its best efforts in order to maintain the brand loyalty from the consumer? According to Confucius, one needs not worry about being nameless but should worry about not being so learned as to possibly get famed. If the article or its quality is good enough, is it necessary for the trademark owner to strenuously run its business in order to be famous or gain benefits?

C7). A trademark per se is a symbol of advertisement which generally comes to fame through the input of money. If the parallel import were to be unconditionedly permitted to dilute the value of the trademark, is it not cruel for the law to treat the trademark owner?

Discussions: This reason will find short of strength if questioned as follows:

Q1) A symbol of advertisement can have two meanings. One refers to that the trademark can be famous because lots of money is used to so establish. The other is referred to that the trademark itself has the function of advertisement. As such, through the registration of the trademark, the trademark registrant obtains a vehicle of advertisement for its goods or business. According to this latter meaning, isn't it natural that the trademark owner should pay for earning this faming vehicle through adequate measures?

Q2) If the parallel import is legitimate somehow, it will be irrelevant whether the trademark is diluted. Is a trademark diluted if the parallel import is allowed? Goods in the parallel import bear the same trademark to symbolize or advertise the same trademark which gets thus famed and should accordingly find no dilution. Isn't it possible that if the parallel import goods are hot-sold, the very same trademark will get automatically famous rather than otherwise diluted? From this particular viewpoint, is it not lovely for the law to allow the parallel import?

C8). A trademark is used to represent a specific localized business goodwill. Even if the parallel import goods are genuine, the parallel import can never escape from being categorized as a kind of free-riding act to damage the specific goodwill.

Discussions: This reason will find short of strength if questioned as follows:

Q1) Theory is always different from practice. Although a local trademark should only be theoretically representative of the goodwill of a local business, it appears to have nothing to do with a differently local trademark. Nevertheless, in practice, the parallel import will not happen if two local trademarks are respectively owned by two mutually independent owners or if there does not involve two territories allowing the registrations of two trademark rights having the same or similar trademark. Accordingly, whether a trademark is used to represent a specific local goodwill appears to be unrelated to whether the parallel import should be legitimated.

Q2) The key point does not reside in whether the parallel import goods are genuine but in whether the parallel import should be legal somehow. According to Webster's Ninth New Collegiate Dictionary, a free ride is meant to be "something (as entertainment, acclaim, or a profit) obtained without the usual cost or effort." Anything, e.g. the terms "usual," "cost," or

"effort," in this world is relative. How can we determine whether some standard, e.g. "usual" has been met? How about the situation will be if the parallel importer has expended or exercised some 'unusual' cost or effort?

C9). As is well-known, the trademark law is enacted to safeguard the public interests in addition to the protection of the trademark registrant. Although the man is born to be equal and the law must treat every national as a good resident, it is impractical for us to believe there will be no national who will act against the public interests. If we cannot make sure the public will not get confused or damaged through the parallel import, why we should allow it to legally exist, especially in view of the experience or hearsay that the goods counterfeited or parallel imported generally are inferior in quality?

Discussions: This reason will find short of strength if questioned as follows:

Q1) The basic principle in the modern society is that the law never punishes the suspect. Why can we ban the parallel import simply because we are not certain whether the public will not get confused or damaged through what kind of act? Anyone's interests are important so that interests of anyone or the public should be appropriately protected. Nevertheless, don't we have gone too far to raise this question if we have not settled down first as to whether the parallel import will do interests for or against the public or the consumer?

Q2) It should be true that some experience or hearsay that the goods counterfeited or parallel imported have an inferior quality. It is also equally true that one is not so much experienced if one does not hear or causes to be experienced that the counterfeited or parallel imported goods have a quality higher than that of the genuine ones.

C10). It is easy to determine that the parallel import is illegal simply through the phenomenon of price difference in view of the simple adage that whatever you are given, you must pay for it in the long run.

Discussions: This reason will find short of strength if questioned as follows:

Q1) It is a general concept that a higher price needs not guarantee a higher quality for a product. Quality is determined by cost, technique, management, promotion…etc.. In view of the shortage of the resources on earth, one who should be encouraged should be the one who can offer the same product at a lower price, which is wonderfully satisfied if the parallel import is proved to be legitimate somehow.

Q2) If the price is so important, can we legitimate the parallel import if the selling price of the parallel imported goods is not lower than that of the locally supplied ones? If it is believed that under this situation (the selling price of the parallel import goods is higher), the parallel import is legal, does it mean that the price is the core of the parallel import issue? Is there any one who really believes that the essential factor determining whether the parallel import issue is legitimate is the price?

If all the above reasons applied by the cons are also found unconvincing or unpersuasive, shall the cons also give up their adherence to their original position? Again, how they can base their position on what kind of other theories or reasons? Are there really other more encouraging reasons for the cons to construct their strong defenses?

If neither the pros nor the cons can find vigorous foundations for their position or rigorous arguments to conquer the opponent, how the human society should treat the parallel import phenomenon? Certainly, we can let it be because the earth will still revolves around the sun if we cannot provide a definite or convincing solution to be followed. Some countries permit while other ones ban. Diversifications and complexes make a beautiful world possible since the monotone easily dulls

the life of the human being and possibly raises the unemployment rate. From this point of view, what we are endeavoring to solve the confusing situation the parallel import issue is causing is some kind of evilness. If it happens that this article help clarify or even solve the dilemma the parallel import phenomenon traps, governments on earth should carefully wonder and try hard to figure out whether the dilemma is a mishap or a beautiful trap the God has graciously generated?

Brief Items to be Discussed for Presenting Issues We Concern
**Relationship among relevant parties*
**15 USC 1125(a), 19 USC 526 & 19 CFR 133.21*
**How does the parallel import issue interact with related laws?*
**Is a new model possible to properly regulate the parallel import phenomenon?*
**How does the new model regulate illustrated examples?*

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