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幾番風雨，我們已逐漸茁壯。如 貴公司真有心躍登或繼續保持世界第一，何不尋求本所服務？

專利制度及專利法(109)

專利之補充、更正與修正 (四)

5、法條有無明文：「立法從嚴、執法從寬」、「立法從寬、執法從嚴」表彰中、美法治景象之區別，茲自以下各節分別簡論之：

- A. 我專利法再三叮嚀前述「補充、更正或修正」不得變更申請案之實質；美國專利法則僅於一條文但書提及，更正須以所涉變更不構成新實質內容或不須再審查為限。就此，吾人似可發現：
- a. 多（或大）未必佳：專利制度之合理、公平、成功或有效與否，在於運作心態如何？立法有無忠實反應人民心聲？似非憑恃我國有「補充、更正或修正」三種，而美國僅有「更正」一種，即可自得其樂？
- b. 多（或大）未必贏：我專利法雖再三叮嚀錯誤之矯正不得變更申請案之實質，美國法雖僅輕描淡寫。然實際運作結果，我國專利案件之「實質內容」常遭褻瀆，而美國案件之實質內容則常能確保完好如初；
- c. 多（或大）未必當：我國相關條文有八，美國相關條文有三。然「法隨時轉則治」、「徒法不足以自行」、「聰明人係吸收前人之經驗」、「他山之石，可以攻錯」……我朝野專利從業人員立於此等成語之前，寧無愧色？面對獨霸美國，竟能無動於衷？
- B. 就有無法條明文而言，有未必佳：如前所揭，我專利法前述規定係用於規範審查之際，而美國則規範專利發證之後。故就案件審查期間而言，我國有規定，美國則無規定。然不論就「實質內容」之護守或專利其他部份之運作言，我國似不如美國？
- C. 專利錯誤與法院：依我實務，冗漏發明人，常與法院無涉。縱法院如此發現，且當事人間就此激烈爭執，法官或因辦案壓力已然分身乏術，充其量亦僅會善意提醒申請人，應設法向行政機關辦理變更登記。然依美國專利法，法院得逕命為專利之改正，局長並應因此擊發證書。蓋依其基礎信仰，法官既係扮演「人間神」之角色，則依其無私心證而得之結果，行

政機關自應即刻無條件接受。吾人該當如何評價此一事實歧異？

- D. 更正時機：依我專利實務，冗漏發明人，於核准審定前，雖「寬厚」隨時可得為之，然須付出申請日延後之「慘痛」代價。雖原意非欲鼓勵「虛偽造假」，卻令廉潔人士無以自存於中華民國領土。依美國專利法，冗漏發明人得否改正，要以錯誤出於善意與否而斷。如其錯誤非出於善意，非但不得更正，其權利很可能不能行使，或竟至於無效。至於更正時機，既知生有錯誤，應本於善意，即刻申請更正。依前說明，審查期間本可應即行申請修正。是美國該法條應在明縱已發證，亦得更正之旨耳；

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- E. 申請更正之人：依我專利實務，發明人之增刪，應經原發明人同意（出具簡單同意書即可），由申請人為之。依美國專利法，則除應因所有當事人（即包括發明人以及造成此錯誤之關係人）及受讓人（即申請人）之共同申請外，並應經舉證該事實（詳細敘述錯誤發生之原因與經過）及其他法定要件（例如，敘明錯誤之發生係出乎善意）後，擊發改正此錯誤之證明

6、法無規定：以下事項我國無規定，美國則有規定。稍事瞭解之，亦頗有趣：

- A. 官方機關發生錯誤情形之處理：我專利法就此無規範，似不難理解。蓋，在「官大學問大」之國度中，官方舉措生有錯誤「已難想像」。官方真有錯誤，數十年或數代後為道歉，應可期待。然欲官員自承己過，似難得「期待可能性」。說不得在此又一次「長他人志氣，滅自己威風」，可愛之美國專利法非但有規定，且局長應寫「自白書」敘明該錯誤之事實及本質，並登錄於專利紀錄中。「公僕」之定義於此見之？蠻夷已然進化若此，我泱泱中國似仍故步自封，奈何？
- B. 「補充、更正或修正」應否收費：我專利法雖未有規定，然於實際實踐中，凡有修正，必徵費用（屬程序事項之官方錯誤，應有例外）。如屬核准後更正，代價更高（各國似皆如此，所謂「人同此心、心同此理」？故不宜胡亂苛責我官方）。美國專利法明文出因官方錯誤之

更正，不應收取規費。令人無奈者，乃我國專利審定書之作成，迄今各國仍偶有完全出因審查委員之誤解或不解專利法所致者（我國發生之頻率稍高），除延宕專利之核准外，冤枉審查程序所涉費用，申請人僅能以「天地不仁，以萬物為芻狗」聊供自慰？

- C. 證書原本與更正本：具體實踐上，我專利法未有規範，因通常之作法為先繳回原本，並經更正後再為發還，故原本與更正本間，實有二而一之情。依美國專利法，除應發予更正證書正本外，該專利之各印刷影本亦應附具該更正證書影印本，俾取閱者皆得知何處生有更正？故此證書，自應視為原始專利之一部份。例外於漏誤嚴重時，局長亦得免費製發更正專利證書代之。至法條中所謂，每一此種專利及此種證書，就嗣後發生訴訟行為之審判，應有猶如初始製發之際，已有經更正形式之相同法律上效果，無寧乃屬當然！

生物科技上之概念與落實同存主義:雙股螺旋之雙重標準(二十)

-John M. Lucas, Ph.D.

法院同意 Eli Lilly 如下之抗辯:

雖然 Amgen 處理概念的問題，其很清楚的可應用在本案例上。若一發明人尚未達成發明的概念，他將無以滿足 35 U.S.C. 112 第一項之方式適當地說明本發明。事實上，Fiers 法院指出”...一 DNA 之概念需要一精確的定義，如藉由結構、化學式、化學名、或物理性質等定義之，如我們所認為者，接著之說明亦需要該程度之指明。改寫委員會之言，即一個人不能說明其所未思及者。”

聯邦巡迴法庭支持地方法院的判決，認為 Regents 的專利因未能提供 cDNA 編碼人類胰島素之適當書面說明而無效。聯邦巡迴法庭利用對於 DNA 概念之要求，如 Fiers 中所述者，於 Eli Lilly 中定義書面說明之要求，認為：

一 DNA 之適當書面說明，如’525 專利之重組質體與微有機體之 cDNA，”需要一精確的定義，如以結構、化學式、化學名、或物理性質定義”，而不僅僅是希望或計畫得到該主張保護之

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化學發明。因此，”一 DNA 之適當書面說明，所需要者比單純敘述其為本發明之一部分，及可參考單離它之潛在方法還要更多;所需要者為該 DNA 本身的說明”。

本國專利制度新知(九)

智財局於 89.12.14 公告其所訂定專利審查基準第四章「說明書及圖式之補充修正、更正」，其中關於「實質變更之判斷」之說明將有助於申請人對於「實質變更」之認定有更具體之認識。其中，由「申請人進行補充修正說明書或圖式時，應依據「原說明書或圖式」所揭示的事項為準，不得構成實質變更。而審查人員判斷得否補充修正時，亦應依據「原說明書或圖式」而判斷之。經判斷若不屬於「原說明書或

圖式」所揭示的範圍內，即構成實質變更，不受理其補充修正。」之內容可知，補充修正之內容是否屬於「原說明書或圖式」所揭示的範圍內，即成為是否變更實質之具體判斷依據。

而再就「所謂「原說明書或圖式」所揭示的範圍，係指申請當日即揭示於原說明書之發明說明、申請專利範圍或圖式中之全部事項，包括文字、符號、公式或圖形等所表達的內容，以及熟習該項技術者依據說明書之記載所明確之事項。因此，認定申請時已揭示之技術內容，並不拘限需要完全按照逐字逐句解釋所記載之範圍，亦不拘限僅止於揭示發明本身而直接記載之範圍，而係及於申請當日凡為熟習該項技術者，憑藉「原說明書或圖式」所揭

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示記載之事項，客觀上能直接推導的技術範圍內，均屬於「原說明書或圖式」有記載包含的範圍。」

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- 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~)

之內容可知，申請人所能補充修正之內容並不僅僅侷限於原說明書中逐字逐句之記載，而是能藉由熟習該項技術者，憑藉「原說明書或圖式」所揭示記載之事項，客觀上能直接推導的技術範圍內，均屬於「原說明書或圖式」有記載包含的範圍。

根據上述準則，申請人便可各顯神通地對審查委員所質疑揭示未清之處進行補充說明，但為保險起見，申請人之較佳作法是可先將補充說明之內容以附件方式呈上，而於探詢過審查委員之意見並得到其首肯後，再將補充內容增添至原說明書中，進而避免審查委員不同意該補正內容而導致案件之其它內容一併被駁回之情況。

智慧財產權報導 (7)

《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

由於大部分的公司是以十二月 31 日為會計年度結束，在此些州之大多數的特許權需在各年度的同日期被延展。結果是已經過度負荷的特許權審查委員體驗到在年度的那時候他們的工作負擔大量的增加。

在正常情況下，審查委員僅需審核先前申請案紅線更動的延展文件。他們將需要閱讀並評估那些剛剛已經變為新格式的登記者之整個要約通告。因此，許多特許權代理人擔心如果在政府審查委員費力處理大量積案時，他們的登記期滿，他們的特許權客戶可能在某些州賣出特許權之生意將短暫無法進行。

面對此一可能性，可能似乎存在一種較好的選擇來儘早準備一重寫的要約通告及檔案。此事在特許權審查委員年度之離峰期可經由後來生效的補正來完成。除非該補正涉及 UFOC 所揭露資訊之重大變更，而相反於唯獨格式的變更，雖修正的 UFOC 仍在審查中，那麼依據舊的 UFOC，特許權者仍可繼續販賣特許權。

《歐盟》在歐洲專利局(EPO)之異議

歐洲專利在核准後有 9 個月期限之異議。任何後續的挑戰必須是在依各國而不同的基礎上。大約 7% 的專利被異議，在 EPO 初期，其似乎是大部分的異議是由德國的專利權人及異議人之間所挑起。現在此是較不真確的，而且案子涵蓋來自許多國家之專利權人及異議者雙方。(待續)

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軟體專利性之發展

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所有輸入資料最先被儲存於一單一檔案，且隨後依據其相關的管理活動(財務或存貨)類型被分為分別的檔案。主要的檔案接著可以被更新，且一輸出以所需格式呈現。此發明被認為具有可專利性，因其於特定檔案結構與程序之提供具有一技術貢獻之基礎。一顯示於使用者以輸入資料於兩種程序之一共用"轉帳傳票"的使用亦意味著技術考量已被列入實施該方法之考量。一有趣點為技術貢獻被認為存在，而無視其本身是處於被排除於外的領域之財務與存貨管理的限制。

Sohei 判決是有價值的以支持許多軟體相關發明，其中許多類型之架構(屬於系統或程式)可被安排於申請專利範圍，特別是假如軟體是一可能被排除於外之商業應用。

T1173/97(1999EPOJ609)&T935/97"IBM"

於最近兩個案例(T1173/97,EP-B1-0457 112 & T935/97,EP-B1-0767 419)，一技術的上訴法院已經述明，假如，當執行時，程式有一技術效果，一電腦程式與包括具有電腦程式碼單元於其上之一電腦可讀取儲存媒介之一電腦程式產品之申請專利範圍理論上是可准的。此即謂假如當被執行之一電腦程式引起一技術效果(藉 VICOM 測試)則程式本身有一足夠之"非直接技術效應"。歐洲專利局，目前認為一程式主張為載體上之一記錄不管其內容為何是不准專利的，而已經指示將歐洲專利局目前之審查基準隨後修正之。此案例使歐洲專利局走向准許申請專利範圍訴求記錄媒介之美國專利局與日本專利局的做法。但歐洲專利局亦將准許申請專利範圍訴求一電腦程式本身(非於一載體)。因申請專利範圍直接保護程式本身以及軟體總是被販售之一記錄媒介，且可能擴大至其他散佈軟體之裝置，此案例極有利於申請人。可准之申請專利範圍格式為：

一電腦程式包括（電腦）程式碼裝置，係用於當該程式於一電腦上執行時，執行申請專利範圍 X 之所有步驟。

如申請專利範圍 Y 之一電腦程式被收錄（儲存）於一電腦可讀取（記錄）之媒介。

獨立的申請專利範圍亦可准，然須受歐洲專利局簡明要求的規範。

英國專利局亦已指出其將接受這些原則，且將准與此類型之申請專利範圍於英國國內專利申請案。（待續）

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歐洲專利局審查實務目前的發展(五)

玖、後補文件的提交

前年正當歐洲專利局欲加速處理異議與訴願程序，並避免當事人濫用該程序以使最終裁決遭致延遲時，該範疇中已有大量案例。關於此點，已有一些訴願委員會的裁決，係關於歐洲專利局考量後補文件的提交的事宜。在 T792/97 (Enichem SpA / Bayer AG, ICI)、T102/98 (Shell Internationale / BP International) 與 T190/97 (Shell Internationale ; BP

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International) 決議中，後補文件及/或證據並不允許進入這些程序中，這是因為任何一文件乍見下並不被認為與這些程序極有相關性。明顯地，於程序中所提交的文件之時間點越晚的話，歐洲專利局越有可能認為這些文件不應當被允許提交。

相反地，於技術訴願委員會的決議 T272/98(Shell Internationale/General Electric Company, BP International) 中，技術訴願委員會不受理多數後補文件，但是卻可以接受口頭程序中的口頭供訴，這是因為口頭供訴僅是根據先前提交的文件與理由來構成額外的辯解。以訴願委員會的觀點而言，這樣額外辯解的提交不僅在口頭程序中（事實上即為其目的）是被允許的，亦即，允許進行最終機會的辯解，抑且係以提呈於訴願委員會的事實與證據做為基礎。

如果提交文件是為了有助於訴願中進一步的辯解，而非對第一審級產生的問題點回應的話，則這些文件不僅必須具有相關性，且專利權人必須同意允許這些文件被提交至該程序中。此可由技術訴願委員會的決議 T204/97 (Pioneer Electronic Corporation / Interessengemeinschaft für Rundfunkschutzrechte EV) 中確認之。

當文件提交至訴願程序且被視為具有相關性時，訴

願委員會的決議 T1171/97 (Pitney Bowes Inc. / Francotyp – Postalia GmbH) 認為該案例移送至第一審級是適當的，以確保給予當事人兩次機會以考量整個案例。然而，並非所有情形下都採用這樣的程序。於技術訴願委員會的決議 T788/97 (Prolion BV / Alpha Laval Agri BV, Maasland Nv) 中，其認為因為文件於訴願程序中及時提交以使該案可被詳細地審理並避免發回。其認為，在該案例懸而未決之時程中，發回該案至第一審級將延長這些程序而影響大眾權益。因此，如同 T966/95 (Shell Internationale / Exxon Research and Engineering) 決議中所確認者，歐洲專利公約 (EPC) 第 111 條論及訴願委員會有權發回案件至第一審級。然而，其亦授予訴願委員會有決定該案件為第一且為唯一審級的權利，尤其是當發回案件對所有涉及該案當事人會產生額外費用，並造成程序的相當延遲而致於較長時間內使專利或專利申請案的命運不確定。該案例指出因為允許新文件提交而發回應該為例外情形，例如如果沒有這樣的發回而受文件提交影響的當事人並不能完全抗辯其效力。

拾、口頭程序的參加者

歐洲專利局目前建立起了就當事人而言，個人（而非經授權的代表人）應於口頭程序中發言的實務，通知書必須儘早於口頭程序前呈送至歐洲專利局與所有其他當事人。該通知書應該載明欲發言之人與指明這些人所欲談及之標的主體。因為歐洲專利局設有期限，在該期限後而於口頭期限前不應該提交進一步證據資料，許多人認為該期限日亦為向歐洲專利局指明欲於口頭程序發言之參加者的期限日。然而，技術訴願委員會的決議 T1180/97 (The Boeing Company / DaimlerCrysler Aerospace Airbus GmbH) 中闡述「以技術訴願委員會的觀點而言，十九天的期間對於提供被告適當時間而做關於擬議的口頭申請準備，被視為已足夠長」。然而，該決議是就該案例特殊情況所做的決定，其中被告是生產航空運輸交通工具的世界領導性公司，且被認為擁有大量合格的技術職員，這些技術職員中至少有一位相關領域之專家能夠在收受通知稍後即可找到。

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行為違法性與教師懲戒權

八、結論 - 案例分析

問題一：教師甲公然侮辱學生乙之行為是否具有違法性？

（一）按「公然侮辱人者，處拘役或三百元以下罰金。」刑法第三百零九條第一項定有明文。甲於教室中罵乙是豬，整天只想睡覺云云，係對特定人乙為之，且

教室有其他學生正在上課，而為不特定人或多數人得以共聞共見之場所，則甲罵乙之行為，自屬該當刑法第三百零九條第一項規定之「公然」構成要件之行為，且依一般社會觀念而言，豬係一好吃懶做之動物，甲罵乙是豬之行為，實足已貶損乙之社會評價，是故，甲公然罵乙是豬之行為，實已該當刑法第三百零九條第一項公然侮辱罪之構成要件。

(二) 甲罵乙是豬之行為已該當刑法第三百零九條第一項公然侮辱罪之構成要件已如前述，則甲之行為已具有違法性之表徵，至甲之行為是否屬得阻卻違法之教師懲戒行為，端視甲之行為是否合於教育之目的而言。由題旨觀之，乙未盡其學生本份而於課堂中睡覺，則甲基於教育之目的，有權命乙專心上課，惟其目的應在使乙聽講，自應以適當且合於教育目的之方式為之，惟甲以罵乙是豬之方式懲戒乙，其方式並非基於教育之目的，蓋教師本身應以身作則，不應恣意辱罵他人，且甲非不得以其他適當而不致侮辱乙之方式使乙不再繼續睡覺，如以適當之言詞告誡乙莫於課堂中睡覺，惟甲卻仍以侮辱乙之方式懲戒乙，則甲之行為自非屬合於教育之目的，而無法阻卻其違法性。

(三) 職是之故，甲之構成要件該當行為並無阻卻違法事由，而具違法性且亦具有責性，因此，甲之行為成立刑法第三百零九條第一項之公然侮辱罪。

問題二：乙之行為是否構成傷害罪（刑法第二七七條第一項）？

(一) 按「傷害人之身體或健康者，處三年以下有期徒刑、拘役或一千元以下罰金。」刑法第二百七十七條第一項定有明文。乙將書本擲向教師甲，造成甲臉部發生擦傷之傷害結果，且乙明知遺將書本擲向甲之行為，會造成甲之傷害結果，而仍為之，則乙之行為該當刑法第二百七十七條第一項傷害罪之構成要件。

(二) 次按「對於現在不法之侵害，而出於防衛自己或他人權利之行為，不罰。但防衛行為過當者，得減輕或免除其刑。」刑法第二十三條定有明文。乙將書本擲向甲係因甲證在對乙為公然侮辱之犯罪不法行為，乙為防衛自己之名譽權，自得對甲之現時不法之侵害行為，行使正當防衛，惟正當防衛行為依刑法第二十三條規定，須非過當始得阻卻違法，而防衛過當之情形則仍具有違法性，僅得減輕或免除其刑。是故，乙將書本擲向甲，造成甲發生傷害結果，乙侵害甲之身體法益

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係為防衛乙之名譽法益，二法益權衡結果，則乙之防衛行為實屬過當，則乙之行為該當刑法第二百七十七條第一項傷害罪之構成要件，而無阻卻違法事由，且乙之行為具有責性，職是之故，乙之行為成立刑法第二百七十七條第一項之傷害罪。

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南非管理電子商務之發展

南非政府最近已開始對電信產業做一顯著改革。為了將驅動世界經濟的新資訊重新引入南非，這些改革是必須的。

在 1999 年，南非政府經由通訊部門所設立之運作進程以具體發展電子商務之政策。此政策形式之進程包括下列步驟：

1. 討論資料 (於 1999 年 7 月 29 日公佈)
2. 綠皮書 (於 2000 年 11 月 20 日公佈)
3. 白皮書 (將於 2001 年第二期公佈)
4. 立法 (排程於 2001 年第四期)

最近公佈之綠皮書並未構成法律，而係用以完成南非電子商務應行檢討之議題。南非政府聲明他們希望盡可能的納入更多關於相關人士之論點。政府在 2001 年 3 月 31 日前以廣邀電子商務綠皮書之書面回應。

綠皮書被分成以下的主要項目：

1. 電子傳遞時安全性與隱密性之確認
2. 電子商務資訊基礎結構之提昇
3. 管理電子商務之準則
4. 使南非人口受益於電子商務為可能

我們擇錄綠皮書中智慧財產與電子商務關係之部份。有關於智慧財產之文與綠皮書之全文可於 www.spoor.com 之網站內尋得。

智慧財產權與電子商務

綠皮書中認為網際網路的引入，已使得智慧財產權超越國與國間的界限。南非智慧財產權之規範因此應符合國際標準與協定。身為貿易關稅總協定 (GATT)，世界貿易組織 (WTO) 與智慧財產貿易相關協定 (TRIPPS) 之簽約國，南非對於現存法令之修訂也應符合簽約國之義務。應行遵守之國際標準與規則，例如由聯合國委員會就國際貿易法所公佈之對電子商務標準法。

對於保護智慧財產權之難題見於下述：

1. 由智慧財產所產生之壟斷與鼓勵思想發展與自由流通間衝突的解答。

我們已獲知南非競爭法已被修正以清楚釐清現行競爭法與智慧財產權法間的模糊關係。

2. 智慧財產擁有權之確認，關於此事，原有之智慧財產所有權人要求某實體為一財產之所有人或保管人擁有。
3. 迴避技術之管理以及促進智慧財產複製之策略
政府單位顯示已緊密追隨美國之數位千禧年著作權法之引入。
4. 制訂法令以保護固有的智慧財產
視為固有的智慧財產權範例，如 southafrica.com 之網址，南非政府已於最近向 ICAAN 組織提出抗議。
5. 有效監督與保護智慧財產
6. 已發展國家在創作智慧財產之優越性
7. 電子商務的國際性質相對於智慧財產的屬地性質間之衝突，例如商標。
8. 網際網路服務供應商之權利與責任的管理。

法律現場-著作權(二)

一個大的咆哮卻不露出任何的牙齒(1)

南非已簽署了國際智慧財產權貿易相關協定 (TRIPS)，其規範簽署智慧財產權法律各國須遵守之最低要件。TRIPS 協定相當致力於提供適當的措施及防禦以對抗仿冒商品的銷售。

南非已經正式宣布新而有效的立法以符合其依 TRIPS 協定之義務，並且在 1997 年時，通過仿冒商品法案，企圖明確地反制仿冒商品之交易，仿冒商品法在 1998 年 1 月 1 日通過並生效。

這個法案為仿冒商品之買賣，創造了一種犯行：若是非家庭或私人使用時，並及於製造或生產、販賣、租用、交換、分配、輸入或輸出或在仿冒品交易過程中持有。

依仿冒商品法，仿冒商品被定義為模仿存有智慧財產權的商品。而所謂的智慧財產權包含了：

1. 依據 1993 年商標法而獲得相關商標的權利；
2. 依據 1978 年著作權法的一個創作，或
3. 一個排他權利以使用一個特殊的標誌在商品上，依據商品標誌法第十五條而可以禁止他人使用這樣的標誌。

仿冒商品法引進很重的罪責加在買賣仿冒商品案件被證明有罪時。任何人

被證明有罪，在第一次的定罪，會依各商品或項目處以罰鍰。每一個物品或項目，不得被科以超過 5000 元南非幣或處或併處以三年以下有期徒刑。若是第二次或嗣後證明有罪時，在各個物品或項目不得被科以超過 10000 元南非幣並處以五年以下有期徒刑。

南非智慧財產權法的修正提議

合理的禁止

在垂直關係當事人間的契約，如對於市場具有實質阻止或減少競爭的影響，則應予禁止，除非該契約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。

再者，這個禁止並非無限制的：義務將賦予契

約當事人，其通常為智慧財產權擁有者，去釋明其有助於競爭的利益超過反對競爭的效果。

絕對的禁止

轉售價格維持的實務是明確及絕對地被禁止，然而，最低轉售價格則可建議提供，但須明示該建議並非約束且”被建議價格”字句須接近指定價格而出現。

優勢的濫用

一個在市場上佔有優勢的公司被禁止去

- *收取使消費者受損害的過高價格；
- *當其在經濟上具有可行性時，拒絕給予競爭者接近必要設備之機會；

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*如果反對競爭的效果超過技術性、有效性或其它有助於競爭的利益時，仍從事一般的排他性行為；

*從事特定的專屬或排他性行為，例如要求供應者或消費者不要與競爭者交易；在經濟上具有可行性，拒絕提供競爭者稀有商品；以低於邊際成本而銷售商品或服務；買主必須買無關的商品或服務（除非相關公司銷售商品或服務能釋明技術性、有效性或其它有助於競爭的利益超過反對競爭的效

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果) · 而為販售商品或服務。

值得注意的是，於專屬性行為情況下，主要釋明有助於競爭利益的義務歸於遭優勢地位濫用控告的當事人。我們相信使用權利的智慧財產權擁有者會常與這些專屬性行為相抵觸。例如專利權人指示廠商提供專利組件但要求廠商勿提供這些組件給競爭者，可能被認為抵觸禁令。同樣地，專利權人拒絕提供競爭者專利組件而該組件構成稀少商品則可能構成違法行為。

智慧財產權在法律上的發展

結束在國外的專利權

全世界的專利法中，殊屬其特者，乃美國法律條款允許，甚至是鼓勵，美國發明人在市面上試驗他的發明或在向美國專利局提出申請前公開揭露他的發明內容。依美國法律，一項新的發明可藉由發明人公開揭露（經由公開使用、發表或開價出售）可追溯至提出專利申請前一年的時間，而不致害及美國專利的有效性。然而，美國發明人運用這項權利在多數其它的國家將對專利有效性產生致命破壞性，如此所謂的絕對世界新穎性原則(Rule of Absolute Universal Novelty)是專利有效性的準據原則。

Absolute Universal Novelty 原則最純粹的型式是假如一項發明在提出專利申請

之前已經在全世界任何地方公開揭露，後續任何有關本發明之專利都無效。這個原則的本質是，假如在專利申請被提出之前，公眾能於任何公開的場合因發明人或是其它當事人的行為而獲知該發明案的實質內容時，將無合法之專利可以被授予。

美國發明人如欲在美國之外申請專利，則在美國專利申請提出後始公開該項發明，則可以使它在國外獲准專利可能性增加至最大。一年之內，申請案可根據巴黎公約或 PCT 而至外國申請，且仍保留在美國申請日之優先權。這項穩健的程序使美國申請前一年寬限時間之公開揭露宛若不存在。這就是，宛如美國專利和商標局亦採用 Absolute Universal

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Novelty 原則的最純粹形式。採用這項作法，將在美國或外國有最大的機會取得有效的專利權。

歐洲之生物保護與授權許可 (九)

規則第 23 條 c 項 b 款

係為在 EPC 上施行指令之中心主旨。事實上，據前述條

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款之明確用詞所載，並不會影響到根據 EPC 第 53 條 b 項有關植物變異種與動物品種之排除，然而卻會使後者之解釋背離在 T356/93 所建立之 PGS 解釋。因此，倘若擴大上訴法庭於“基因轉殖植物/Novartis”案之待決判例確認該 PGS 案判例，則新規則第 23 條 c 項 b 款應須再被重新評估。在彼案中，為了施行指令，在外交層次上 EPC 應被修訂，而包括如次問題：即，修正（甚至取得一致意見時），也該被合約國之國家國會所批准，且只是涵蓋指令之條款項目中主要討論與關係論點之一。規則第 23 條 c 項 c 款最終地澄清了微生物程序原則上一直可被保護，甚至當該微生物程序僅為係關於獲取一植物變異種（或動物品種）。在此案例中，其唯一限制範圍，該專利權所賦予保護範圍僅及於方法，不及於藉由上述製程中獲取之產品（即植物變異種或動物品種）。

基於 EPC 第 53 條 a 項，新的規則第 23 條 d 項列舉了一些正面列舉的可專利性例外，採用指令第 6 條第 2 項之用詞，而提供一個並不詳細具體公眾秩序與道德規範觀念之態樣。就心理觀點而言，依據大眾意見所認為生物技術專利之可容許性上，規則第 23 條 d 項具根本上之重要性，因為它明確地將人類胚胎之任何用途以及無性繁殖人類及/或改造人類生殖細胞基因鑑定之任何程序之可專利性排除掉，同時也排除了未被判斷出對動物或人類有本質上醫學利益的動物基因操作之任何程序。

美國新專利審查程序 及美國發明人法案實

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施之相關法規改變之摘要

Rabin & Champagne, PC
11.02.2000

以下是相關法規重要改變的摘要，其中包括被認為與申請人極有關係，以及可能影響其在專利審查程序中參與權利之法規（此係相對於申請人之美國代理人而言）

小實體之身分

自 2000 年 9 月 8 日起，小實體之身分可經由簡單的文書主張其符合此種身分而獲得；因此，已不再需要特殊的格式或特定的主張。美國智財局將寬大解釋關於小實體身分之書面資料為此種身分之主張。此外，可以主張小實體身分之當事人亦擴大為：任何經註冊之從業者（律師或代理人）、發明人之一（而非所有發明人）、或是部份受讓人（而非所有受讓者）。

若申請人只支付小實體之基本送件費用或基本內國費用時，則視為主張小實體之身分。值得注意的是：但在支付其他任何費用時若缺乏書面之主張，申請人並不會因為其支付小實體之費用而為視為具有小實體之身分。

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假如申請人是在 2000 年 9 月 8 日前送件並附上小實體基本送件費以及小實體之主張，但並未附上小實體之聲明書，則不須再補件即可獲得小實體之身分。因此自 2000 年 9 月 8 日起，此法規可適用於上述之申請案，也就是說，申請人將被認為在 2000 年 9 月 8 日已為該申請案中被視為具有小實體身分。

早期公開

對於美國專利申請案 18 個月之早期公開之重要目的有二：

一為在相對早期及可預期的階段，即提供審查委員及公眾可獲得之習知技術；一為給予公眾在審查期間可呈送習知技術之機會，俾專利審查品質將較以往好且所審查結果之專利權將較有力。但是，為就公眾所提呈之習知技術部份提供一較有秩序以及公平之考量，其提呈之時機為一申請案公開之日起兩個月內。因此，申請人應該預期在申請案公開後兩個月內可能會有公眾提呈之習知技術，以及應準備對其競爭對手之申請案提呈有關之習知技術。

當前歐洲專利新動向(1)

by J.A.KEMP & CO.

本文摘錄有關歐洲專利情況之四個計畫的進展：

1. 歐洲專利公約(EPC)之修訂

1.1 於 2000 年七月公告之歐洲專利局的“歐洲專利公約修訂計畫”係經由行政會議(Administrative Council)指派專利法委員會(Committee on Patent Law)進行多年的成果。該計畫長久以來提出許多改變歐洲專利公約(EPC)之建議。以下將討論最引人興趣的特殊建議。其他建議包含將公約的條文移到施行細則(Implementing Regulations)中，實務上大體沒有改變。此主要基於日後靈活性目的，因為法定更改施行細則的程序遠較法定更改公約的程序更容易，特別是隨著簽約國數目增加時。細則將隨條約於適當的時程修正。

第 52(2)條-電腦軟體

1.2 依據建議，第 52(2)條將修正為將“電腦程式”從不可專利性之發明的名單中剔除。雖此項變更引起許多注意，然實際上的重要性將會相當小，因為歐洲專利局(EPO)審查委員目前的習慣幾乎忽略該項除外規定。因此，在一發明中使用電腦程式不會造成該發明不可專利性，已有一段時間被接受，並且訴願委員會(Appeal Board)在二件 1999 年 IBM 之訴願案中決定，假使在申請專利範圍中至少具有可視為表示技術效果之要素，則可准許訴求“一種電腦軟體”之申請專利範圍。

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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 (六)

IV 分析

由這些案例所浮現的論題是：基於分子生物學領域的不可預測性，專利所有權人無法教導熟習該技藝之人士何種蛋白質修飾將保有特定之生物活性。據此，此申請專利範圍

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圍是缺乏翔實揭露。然而，上述所言結論為：關於該領域之技藝、決定哪一個蛋白質修飾保有生物活性的可預測性或不可預測性，以及為何申請專利範圍

圍違背翔實揭露主義的基本方針，皆非有意義的討論。

事實上，在 Amgen 案例中，Federal Circuit 而藉聲明 Wands 因素是“例示的，非強制性的”而避免討論上述因素。不論是部分的 Wands 因素或其他因素，法院不應該以他們的判斷替代熟習該技藝之人士者。法院也不應該忽視申請專利範圍的廣度將會影響該有用技藝之進步：即要求翔實揭露的目的。適度地使用 Wands 因素的分析架構，會准許較廣的申請專利範圍同時鼓勵創新。

A. 該領域之技藝、範例與導引

在 Amgen 案例中，Federal Circuit 表示除了 DNA 分子，說明書無法教導熟習該技藝之人士“製造方法”。較晚的 Deuel 案例，同一法院重申除了專利申請案中所揭露的 DNA 分子，說明書無法教導熟習該技藝之人士如何製造該 DNA 分子。然而，一專利說明書最好排除該領域充分已知的部分。熟習該技藝之人士可確實決定每一個可編碼特定蛋白質的 DNA 序列。

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澳大利亞智慧財產權集錦 (二)

健康投資之指南

聰明的發明人想確保其金錢有智慧地運用，以獲得最大之回饋。提供基金予健康及醫藥研究部門之團體當然亦無例外，且已意識到有效智慧財產管理之必要，俾保護其投資。

國家健康及醫藥研究會(NHMRC)近日發佈運用其基金所為研究之智慧財產管理及商業化指導方針草案。指導方針旨在確保不致失去源自研究之商業副產品及促進研究機構發展商業化及企業文化。

基金接受者將被要求具適當之智慧財產及商業化系統，且若該系統不明確時，基金能撤回。

人格\身分權之設立

就作品關於作者名譽之人格\身分權，乃額外且完全地獨立於作者之經濟權，並繼續存在於經繼權移轉之後。

人格\身分權法律生效於 2000 年 12 月 21 日。著作權修正(人格權)法包含文學、美術、戲劇、音樂著作及攝影等著作之人格權規定。該法令使澳大

利亞得與其他國家規範一致並使國際義務生效。

該法賦予著作物之作者某些權利，如：

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- 著作物之著作人身份歸屬；
- 禁絕著作人身份不正歸屬；
- 著作物著作人身份之完整，即不得使其遭受貶損待遇。

人格權僅適用於個人且不得讓與。然而，作者得同意關於該著作物之某些行為及捨棄。對於著作物作者人格權之侵害，賦予作者就該侵害採行法律行為。

名稱底蘊為何？

植物供給者常想以所供植物名稱註冊商標。該等商標常積極地被促銷而變得相當有價值。

然而，商標局所註冊者係植物名稱而非「植物品種」之名稱。值得討論者乃其究否係植物名稱或品種。一旦註冊商標成為被接受之特殊植物品種名稱，該商標將因被認定不具顯著性而被撤銷。

因此植物供給者嚴格遵守對於註冊商標維持®標示而對於未註冊商標為™標示是很重要的。並應於所宣傳之文字及媒體上清楚標示其為商標，而非一般性名稱。該等商標係為形容詞而非名詞，如 STARSTRUCK 杜鵑花。

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法訊新知

國際商標註冊(IR)之馬德里協定最新成員國

亞洲-亞美尼亞、不丹、中國(不含香港、澳門及台灣)、喬治亞、日本、北韓、新加坡(申請人使用新加坡商標註冊為國際商標註冊之基礎者，不得於 IR 指定新加坡)、土庫曼；

歐洲-奧地利(CM)、比荷盧(比利時、荷蘭、盧森堡)(CM)、捷克共和國、丹麥(CM)、愛沙尼亞、芬蘭(CM)、法國(CM)、德國(CM)、希臘



(CM)、匈牙利、愛爾蘭、義大利(CM)、拉脫維

亞、列支敦斯登、立陶宛、摩爾達維亞、摩納哥、挪威、波蘭、葡萄牙 (CM)、羅馬尼亞、俄羅斯、斯洛伐克、斯洛伐尼亞共和國、西班牙 (CM)、瑞典 (CM)、瑞士、土耳其、英國 (CM)、南斯拉夫；

(* Cm 係指得受歐盟商標保護者，且申請人可能偏好歐盟商標保護取而代於 IR 中為數歐洲指定國之指定。)

美洲-安地卡及巴布達、古巴、美國(可望 2001 年生效)；

非洲-肯亞、賴索托、摩洛哥、莫三比克、獅子山、史瓦濟蘭。

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

by C.F. Tsai

Detailed Analyses

*Relationship among relevant parties

In 1991, the Australia enacted to permit the parallel import of publications printed in a foreign country, which ensued the denouncements from the American Publisher Association, International Publisher Association and International Publisher Copyright Commission, commonly asserting that this enactment has destroyed the territorially allocating rights of the publisher as to how the publication should be published and/or issued and damaged benefits and investments of the publisher through ruining the commercial structure of the international publication and violating the copyright territorialism. It is interested to note here that these organizations apply the copyright territorialism for resorting to the local protection and banning the parallel import, in view of the universal principle that the copyright will automatically be produced nearly all over the world (except in Taiwan being stopped by Mainland China from entering into the international organization or treaty) once the work is completed.

Certainly, the universal principle does not necessarily directly conflict with the territorialism. Nevertheless, it is believed that the copyright territorialism will find more difficult to be supported than the trademark territorialism since the trademark owner always needs pay additionally efforts and expenses in order to develop a localized trademark right whereas the copyright owner needs not or does not need to pay so much. In the copyright side, relevant parties may only include the copyright owner having a right automatically generated universally and the parallel importer. In this case, two copyright owners in two respective countries in fact are of the same entity. Is it apparent now that the copyright owner has an improper enrichment? Do we consider the same copyright owner having once sold its work in a first country could certainly exercise its copyright for banning the parallel import in a second country through the derivation of rights from copyright territorialism if the copyright owner does not license or transfer the local copyright to any third party or make any kind of efforts in promoting its work in a second country? Is it fair that the copyright owner should be double enriched simply because it has another local copyright when not only said another local right is obtained for free but also it pays no cost or efforts in maintaining, advertising or promoting said another local right. If we believe in this specific situation, we had better take the position that the copyright owner has no legitimate rights to ban the parallel import, this would mean we have admitted the exhaust theory to some extent till now. If this is true, is it correct for us to take that we need not wonder or wander about whether the parallel import is legitimate since it would appear that there is not a big gap between the above situation and the one that the copyright owner licenses or even transfers its local copyright in the second country to a third party? This is because the licensee or transferee often is affiliated with the copyright owner or has a close relationship therewith, e.g. an arm's length arrangement.

If the copyright owner licenses or transfers or assigns its copyright to a third party in a second country, both the copyright owner and the local right owner in the second country should have the obligation to respect each other for performing the goal of the agreement entered therebetween. Each party shall not act against the purpose of the

agreement and the other party shall have the right to claim damage otherwise. As such, the parallel importer cannot be either one of parties to the licensing or assigning agreement. Otherwise, the other party can claim damage against the parallel importer according to the agreement. Accordingly, it will make senses for us to be troubled so much only when the parallel importer is a third party to two parties to the agreement. It appears to be a great idea to resolve the parallel import issue by returning to the principles of contract.

Specifically, the parallel import made by the third party is an accident to two parties to the licensing or assigning agreement. In order to perform the goal of the agreement faithfully, two parties to the agreement have duties to compromise or make remedies honestly. More specifically, the copyright owner shall not act to damage the rights of the right owner in the second country who in turn shall not produce trouble for the copyright owner for return, in order that the purpose of the agreement can be wonderfully performed. Accordingly the parallel import issue should be resolved somehow according to or in the licensing or assigning agreement in order not to trouble the government or the public.

Those who advocate to curb the parallel import issue might illustrate the following examples to name a few to contest against the above reasoning:

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- 1) The parallel importer having known the serving period of an article is to expire soon still import the goods for sale to harm the health of the public;
- 2) If a kind of goods has a high custom tax, the parallel importer will gain unduly enriched if it tries to escape the tax;
- 3) If the currency in the importing country is appreciated, the parallel importer will won a wonderful chance to profiteer.

It is believed that the above examples cannot divert our belief any a bit since in the first example, the parallel importer will be held liable if the public get harmed somehow because the parallel importer fails to duly remind or advise the consumer what it is selling. In the second case, the government or the custom must so have a duty dereliction that the parallel importer has the opportunity of escaping from being taxed as required by the law. In the third example, not only it is purely accidental but also it does not relate to the core problem of the parallel import issue. Accordingly it seems that even if the cons can illustrate further examples, it appears that we can stand motionlessly as we are.

*15 USC 1125(a), 19 USC 526 & 19 CFR 133.21

Section 1125(a)(1) of the US Trademark Law (or Section 43(a) of the Lanham Act stipulates that: Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—

- (A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or
 - (B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities,
- shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

It is true that this provision is a good measure to curb the parallel import but it is equally true that this provision could not be taken as a provision for specifically dealing with the parallel import issue. We would like to investigate the prerequisites for an act violating this provision:

- 1) There must be a person: Such person should include a juristic person and a natural person. Nevertheless, there is a loophole from which a juristic person might be interested in trying to escape its liabilities (we have no intention to instigate any 'person' to act against the law but instead, the US Congress might be interested to take a look here). As the words are used in 15 USC 1125(a)(1)(A), "approval of his or her goods" can be based to persuade that the 'person' here is referred to the natural person only;
- 2) who, on or in connection with any goods or services, or any container for goods: the drafter for this section must be a genius in order to complete such a seamless article. It appears to be somewhat more cruel if the words "any container for goods" are changed into "any container or material for goods or service";
- 3) uses in commerce: If what the "wrongdoer" does does not relate to commerce, its act would be no problem;

4) any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact: There are four primary types of media by which an act could be pursued as violating this section, namely:

- I) any word, term, name, symbol, or device, or any combination thereof: These are the usual vehicles by which trademarks exist and should require no further explanations;
- II) any false designation of origin: This should also call for no further mention;
- III) false or misleading description of fact: It does not matter whether the relevant act is false or misleading, but must relate to description of fact. Such fact may relate to the 'person' or another person; and
- IV) false or misleading representation of fact: Although it is very easy for everybody to know this clause is different from the preceding clause by one word, it appears that the talented drafter desires to trouble the world since it is uneasy to differentiate "description" from "representation." According to Webster's Ninth New Collegiate Dictionary, to "describe" is to "represent or give an account of in words." From this interpretation, it appears it is a terrifying task to distinguish "describe" over "represent." There are many meanings for 'representation' according to that dictionary. One of which is "a statement or account made to influence opinion or action." We strongly doubt whether we have successfully selected the best one construction here therefor. Let us suppose we have done it in order to conclude that Item III) is an 'active' interpretation but this Item is a 'passive' one.

5) which is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person: Accordingly, the act of the wrongdoer must "be likely to":

- I) cause confusion or mistake, or deceive;
- II) as to:
 - i) the origin;
 - ii) sponsorship;
 - iii) approval, by another person, of his or her:
 - a) goods;
 - b) services; or
 - c) commercial activities; or
- 6) in the course of commercial advertising or promotion, the act of the wrongdoer:
 - I) misrepresents;
 - II) so far as the wrong contents are concerned,
 - i) the nature;
 - ii) characteristics;
 - iii) qualities; or
 - iv) geographic origin;
 - III) of his or her or another person's: This clause will be more cool if changed into "of its, his or her or another person's";
 - IV) goods, services, or commercial activities.

Since title 15 is the US trademark law, it is also correct that section 1125(a) relates to the trademark matter. Although it might be wonderfully applied to curb the parallel import in respect of the trademark side, it appears to be apparent we have the following problems to consider:

- 1) It is a pity such brilliant provisions do not present in other related laws, e.g. the patent law or the copyright law since the parallel import issue does not occur only in the trademark field;
- 2) Which one of the trademark regulation and the unfair regulation is the more proper one to put therein the contents of this section? It has been quite common for a country to have a law regarding the unfair competition. After repetitively reading this section, do we still consider that this section is more closely related to the trademark law than the unfair competition law?
- 3) Certainly, we can put similar sections in all relevant laws. If the parallel import issue does relate to the unfair competition, why we need be bothered to respectively have provisions in all relevant laws?
- 4) Is this section primarily provided for curbing the parallel import issue? Is it necessary that we require so many wonderful words to achieve our goal? Is it necessary that in different laws, we need splendidly skillful differently phrased sections?
- 5) Is it possible that a single simple section in a specific law could work to solve all troubles as experiences?

It is reported that before 1921, the US adopted the conventional theory of universality to take that the parallel import involves no

illegitimate act. Such position is switched in 1921 by the Supreme Court in *A. Bourjois & Co. v. Katzel*. The switched position was established by Section 526 of the 1922 Tariff Act abolishing the theory of universality but adopting the modern theory of territoriality to ban the parallel import. 19 USC 526 provides in part:

It shall be unlawful to import into the United States any merchandise of foreign manufacture if such merchandise, or the label... bears a trademark owned by a citizen or a corporation organized within the United States, and registered in the Patent and Trademark Office... unless written consent of the owner of such trademark is produced at the time of making entry.

According to the US Supreme Court in *Coalition to Preserve the Integrity of American Trademarks (COPIAT) v. the United States* in May, 1988, out of the following three parallel imports:

- 1) The parallel imported goods are manufactured by an independent foreign supplier and a US citizen or corporation owns a local trademark right;
 - 2) The parallel imported goods are manufactured by an entity hold or controlled and licensed by a US trademark owner; and
 - 3) The parallel imported goods are licensed to be locally manufactured and sold in a foreign country by an independent company licensed by a US trademark right owner;
- only the second case is legitimate and the first and third situations will be illegitimate under 19 USC 526. Here, we could encounter the following problems:

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- 1) It is to be particularly noticed that according to 19 USC 526, a trademark needs be "owned by a citizen or corporation organized within the United States." This clause seriously harms the sublimity or integrity of this section to serve as an unfair competition principle since it is so much related to prejudicially protect a US citizen or corporation rather than a general US trademark right owner being a foreigner rather than to loflyly establish a general game rule.
- 2) Since this section only provides the situation about the trademark, the similar problems we examine above for 15 USC 1125(a) will also apply.

Perhaps, owing to these and other problems, the US enacted in 1972 in code of federal rule limitations for 19 USC 526. According to 19 CFR 133.21(c), 19 USC 526 shall not apply in any one of the following situations:

- 1) Two local trademark right owners are of the same entity;
- 2) Two local trademark right owners are affiliated or commonly owned or controlled;
- 3) The parallel imported goods bear the same trademark licensed by the US trademark owner; and
- 4) The same trademark has been removed before imported into the US.

Nevertheless, the US Supreme Court took in *K. Mart v. Cartier* in 1988 that 19 CFR 133.21(c)3) literally conflicts with 19 USC 526(a) and that in view of the uncertainty as to how to define the word "own" in 19 USC 526(a), it cannot determine whether 19 CFR 133.21(c) is correct but will respect the interpretation thereon by the customs. It is to be noticed that although the customs can exercise the administrative discretion to determine whether the parallel imported goods should be permitted or banned, such discretion cannot bind the court which can certainly judge by itself independently about any situation it encounters. All the above provisions certainly have shown the complexity of the parallel import issue but cannot explicitly or implicitly suggest or teach how we can deal with the parallel import issue.

*How does the parallel import issue interact with related laws?

How the parallel import issue can be regulated? In which law it should be stipulated, respective intellectual property laws, the trading law or the competition law, and/or the accompanying goods labeling act or tariff act? It is easily understandable that the country offering the most favorable protection for the right owner will attract the most investments from all over the world. It is also easily recognizable that offering the most favorable protection is different from having the fairest provisions among the right owner, the consumer and the society.

So far as respective intellectual property laws are concerned, the US Trademark Law has shown us a good example to regulate the parallel import. It is apparent, however, we have the following questions:

- 1) Although 15 USC 1125(a) might be able to govern the parallel import issue in the trademark side, does it call for us some consideration whether its spirit can be applied to regulate similar issues in the other intellectual property fields, e.g. the patent and the copyright sides? If yes, how this trademark section should be transferred into the other field?

- 2) Do these respective sections in different fields serve our intended purposes well? Do we believe that these sections are much related to respective intellectual property laws than to other law?
- 3) It is asserted that different intellectual property fields have different features. For example, patent inventors and copyright authors have higher contributions to the human civilization than trademark registrants have. Patents and copyrights subject to expire relatively easily while trademark rights can be prolonged unlimitedly. Is a simple and unified provision possible for the parallel import issue? If yes, why sections in the patent and copyright fields have not provided?

We have no interests to deeply discuss all these and other questions or problems in this short article. It is welcome that any one who is attracted by the viewpoint of this article can base on our findings to build more stoutly the entire theory with clues presented here.

It is generally believed that to regulate the parallel import issue with the trading law is improper since the trading law is much related to the administrative measure and appears to be inappropriate to regulate an act whose economic effect is indeterminate. It has also been well-established that the competition law is originally intended to handle the economic phenomenon of an indeterminate economic effect since the competition law normally include the considerations of evaluating the economic effect and the act legitimacy. So far as these factors are concerned, we have the following questions:

- 1) Is the parallel import issue an act of an indeterminate economic effect? Is it possible that the parallel import issue is so regarded simply because the human being has not yet grasped which property it really is?
- 2) Is it correct for us to take that the competition law is the best medium to handle an act of an indeterminate economic effect? If yes, is it a wonderful idea for us to govern the parallel import by the competition law?

*Is a new model possible to properly regulate the parallel import phenomenon?

According to the theories of contract, when there is an accident happened to an agreement, how the accident should be resolved or who should be responsible therefor should be determined from the contract spirit to be read from the full text of the agreement. If there is a parallel import issue which is not anticipated by either one of parties to the agreement and one of said parties claims to be damaged or troubled for compensation, whether there is a party who should be held responsible should find its answers from the original agreement. It goes without saying that the parallel import is an issue because the licensing or assignment agreement normally makes no mention thereof. As such, there must be one or both of said parties to the agreement who should be separately or jointly responsible therefor since it is the fault of said two parties to the agreement who are not able to predict or try to curb in advance the parallel import problem.

Since the parallel import issue is a problem which should fall into the private field, the government or the law need not actively and/or positively engage in the game of solving the parallel import issue but make necessary interference only when the situation becomes absolutely necessary. Specifically, if the local right owner feels damaged through the parallel import, it should claim damages against the original right owner. If the original right owner can assert or show no negligence or intention on its side, the claim of the local right owner should be rejected. Furthermore, it is possible for the contract parties to enter into a supplemental agreement to provide how the parallel import should be solved. Before seeking to execute such supplemental agreement, it would be baseless for any party to claim damages to be compensated by the other party.

If there is no provision in the agreement regarding the parallel import, since the parallel imported goods are genuine, the consumer should not be got into troubles simply because there is what kind of implications between (intellectual property) right owners in different countries. It is the fault of the two right owners but never that of the consumer, which causes such troubles in the society through the lack of provisions in respect of the parallel import in the relevant agreement. Since the imported goods are genuine, the consumer must take the risk of whether it has bought a product deserving the price it spent.

If there is a cheat, swindle or the like so far as the quality or contents expressed of the goods are concerned, the parallel importer should be pursued by a public prosecutor for administrative punishment or criminal penalty by applying, e.g. the Consumer Protection Act or the Criminal Code. The parallel import act per se does not contain any offensiveness against the public order or policy so that it should not violate the law in any way if the parallel imported goods do not embody any element capable of doing harm to the consumer. Now

that the parallel import issue is brought forward to this civilized society by the contracting parties, it is the duty of them to solve the issue somehow.

Accordingly it is quite simple for us to solve this complex issue. Specifically it is the requirement imposed on the relevant parties who may present the parallel import issue to confuse the world to include a clause providing how the parallel import should be solved. If there is no such provision in the agreement, the consumer, the public and the government need not devote any efforts to overcome on behalf of the local right owner any troubles it may encounter since the consumer need not live dependent on the local right owner, the public need not dispose of their living convenience in exchange of the private right of the local right owner, and the government should not try to protect the private right of the local right owner at the sacrifice of the taxed public.

Through such arrangement, the social fairness can be found in that the contracting parties between respective (local) right owners are definite and relatively very few and thus can be put in regulation relatively quite easily. In contrast, the public and the consumer are indefinite and myriad and thus can be hardly controllable. Is it not clear there exists a tremendous difference between solutions obtainable through efforts from the contracting parties with a contract clause and from the indeterminate public without any effective or predictable measure, which automatically comes to consent to such arrangement?

Parties of local right owners involved in the parallel import might be the same entity. In this case, it appear that we cannot effectively find sound bases for prohibiting the parallel import. Even in the situation that parties of respective right owners are different, they should have a contract in some stage of their

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businesses. Contracting parties are often affiliated, and if not, have been linked to some extent to each other in some stage during their business ages. Either one of contracting parties has enough opportunity to include in the licensing or assigning agreement a simple clause or complicate pages to govern how the parallel import should be treated. If they are so lazy as to fail to add in advance or supplement later in the relevant agreement provisions relating to the parallel import, why the consumer, the public and/or the government need to bear unhappy consequences left thereby and try hard to solve on their behalves this simple problem, which has consumed so much energies of so many scholars and has been transformed into a complex issue having caused so much troubles to the societies.

If the contracting parties have duly provided the parallel import in the agreement, the local right owner can claim damages against the original right owner if the original right owner fails to curb as agreed upon its goods to be imported into the territory the local right owner has the right to exclusively use the trademark. If the parallel import is permitted in the agreement, there will be no parallel import issue. If the agreement is silent on the parallel import, it should be first construed as having consent to the parallel import but the parallel importer has the basic obligation to particularly notice the consumer or the public what it is selling are parallel imported goods rather than ones from the local right owner, in order to protect the local right owner. Here we have two problems to solve. One is why the parallel importer has the obligation to differentiate its goods from those of the local right owner? The other is how the original right owner can control where its sold goods are eventually imported to which place?

The local right owner has been operating its business. It appears to be impossible that the parallel importer does not know there is the local right owner engaging in the operation of selling specific goods protected under a local right. Since what the parallel importer intends to sell are so much similar to those of the local right owner, in order to distinguish its goods from those originating from the local right owner in order to establish it has no evil intention to take advantages of the local right owner, the parallel importer should be so obliged. It is a basic rule of existence that a newcomer must and can only subsist by respecting and/or staying away from what have been occupied by preemptions in order to avoid conflicts of interests. Accordingly such obligation imposed on the parallel importer is never an inappropriate requirement.

It appears to be ridiculous from a prima facie viewpoint to require the original right owner control where its sold goods should finally go. Nevertheless, after a further thought, it would readily become apparent that it is not. Before the parallel import can become an issue, there must be an act importing quite a lot of goods. Since the quantity to be imported is normally so large, it never is a problem for the original right owner to curb such importation/exportation. If the original right owner is so honest and faithful, it could easily and should naturally perform as or locate on its behalf a manufacturer to fabricate or sell its goods to the dealer with a proviso in the manufacturing or dealing

agreement that the fabricated or purchased goods could not be sold to the country where the local right owner is located. Buying/selling goods in a substantial amount is never an act uneasy to find out or regulate. If the original right owner does not so follow in its home country, it is not a righteous party to the licensing or assigning agreement and thus is punishable. If the local right owner finds damaged somehow by the parallel import, it certainly can claim damages against the original right owner for compensation. Specifically such licensing or assigning agreement is an international agreement since it involves in rights and duties to be enjoyed and performed in different countries.

Under such model, the parallel import only relates to extremely few interrelated right owners and has nothing to do with any one else, possibly being the consumer, the public or the government. How the world will become beautiful a bit through such model? Are we too naive, artless or innocent to solve this complex parallel import by having erroneously taken what kinds of important or complicate natures of the parallel import issue?

Even at some situations where the parallel import issue gets out of control under the agreement, the parallel import issue can still be solved by applying the principles of the contract. From the expediency of the operation of law, such model is desired and justified in that the contracting parties have ample tools or resources to overcome the parallel import issue whereas it is relatively difficult or nearly impossible to prevent or eradicate the parallel import issue. Can any one assert now we are wrong because of what kinds of reasons?

Such model for solving the parallel import issue has nothing to do with the theory of exhaustion, theory of universality, theory of territorialism and/or new theory of modern territorialism but are built on the bases of the contract law since the contracting parties do exist a kind of relationship which is private therebetween and should not bring forth any disaster or inconvenience to the public or the society. Nevertheless, this model happens to comply with the meanings of theories of exhaustion and universality and does not necessarily confront against the classical or modern theories of territorialism.

*How does the new model regulate illustrated examples?

By applying the new model established above, it will naturally come to the conclusion that in principle, all parallel import acts are legitimate. It goes without saying that all illustrated examples described in the background statement are legal if there is a parallel import. Nevertheless, we would like to examine and briefly comment on the examples:

1. Trademark owner A is different from Trademark owner B, but they are affiliated entities. Normally Trademark owner B is an offspring or branch entity of Trademark owner A. They are so closely related as to be little different from being the same entity. For the following two situations:

I) Trademark owner B can exercise its own discretion as to how to exploit the second trademark right. This situation often occurs when Trademark owner A realizes or finds it applicable that Trademark owner B, although being a different independent entity from Trademark owner A according to the law, that it is important for Trademark owner B to discern by itself the real situation it faces. Nevertheless, since A and B are affiliated, it would be easy for them to settle down how the parallel import should be handled. In order to protect B, if A really so desires, A should exercise some kinds of plans, which is never difficult, to curb the parallel import;

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: In such situation, B is much closely related to A than the situation I). A should have a strong drive to protect B from being damaged by the parallel import through effective measures to be adopted in its home country;

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: Since B derives its right from A, B has an adequate opportunity to include in the assignment a clause governing the parallel import. If not, it is the laches of B to so request. Certainly, the prescription is suitable to function here. B should ask for compensation against A or an addition of the parallel import clause later in the assignment. If denied by A, B should pursue its rights for specific performance before the court to substantiate its rights of assignment by declaring that what it desires to be assigned is an integral right free from being threatened or damaged by the parallel import;

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: As disclosed above, in this situation, A or B has few bases to fight against the parallel importer since it is the matter of A as to whether it desires to be damaged through no active involvement in the exporting country. Since A can take effective measures relatively easily in the exporting country to safeguard itself from being damaged in the second country, how can we believe that the society should exercise additional endeavors to twice or double protect A having been generously conferred with local rights respectively in two countries? If A has no motivation to be unduly enriched, why it keeps silence in curbing the purchase of the parallel importer in the first country? If A intentionally or negligently allows the parallel import to occur, is it proper for the government in the second country to protect A's local rights in the second country without any hatred?

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: This situation does not differ much from the Item 3. Under the "arm's length arrangement," it makes no difference whether A or B or the licensee is the manufacturer of the imported goods since it is under the control of A whether it should manufacture the goods by itself or license D to manufacture on its behalf. Accordingly the answer to this situation does not differ from that in the above Item 3. Certainly as mentioned above, under any one of the above situations or sub-situations, we have the following two cases which will be briefly discussed also:

i) The quality of imported goods is the same to that of those manufactured by Trademark owner B: In this case, the local right owner can find less supports in soliciting an additional local protection for prohibiting the parallel import no matter how the quality is defined. Certainly in this connection, it is even harder for the local right owner to promote its goods if its price is higher than the parallel importer's. Likewise, it requires more techniques for the parallel importer to perform the obligation of distinguishing its goods from those of the local right owner.

local right owner in view of the same quality since it must make it clear how and why its goods have been distinguished thereover on the one hand, while trying to promote its goods on the other hand;

ii) The quality of imported goods is different from that of those manufactured by Trademark owner A: If the quality of imported goods is different from that of the local right owner, it is easier for the parallel importer to distinguish its goods from the local right owner's. It is hard, however, for the parallel importer to lofly declare its goods have an inferior quality before the consumer. Nevertheless, it is imperative that the parallel importer expresses somehow on the goods that they are different from those from the local right owner in order to stand aside civil liability claimable thereby. It appears that the local right owner will have a hardship if the parallel importer provides parallel imported goods having a higher quality. Although it might be difficult for the parallel importer to promote its goods in such situation, it is a downhill work for it to advertise how its goods are distinguished from those from the local right owner.

Accordingly under this new model, all confusing situations can find solved quite easy to the extent capable of trapping all of us in a wonder why we are puzzled before the parallel import issue in the past years? Are we rational to construct this new model? Are we wrong somewhere in some stage upon formulating this new model? Are all questions thus raised thereto really problems which will conduce to unanticipated or uncontrollable issues? Why all the elite in the world will not join to scrutinize in the strictest manner this article?

Claims We Have

1. Article 24 of the Fair Trade Law of Taiwan, R.O.C. stipulates that "any business shall not engage in other cheating or apparently unfair act capable of influencing the trading order except otherwise provided by this law." It appears that an article of such contents can effectively govern the parallel import in various fields, including patent, trademark and copyright. If this is agreeable, we further assert that any one needs not be troubled to judge whether there is a cheating or apparently unfair act and/or such act will influence the trading order. What one needs to judge is whether the parallel importer has duly distinguished its imported goods through some proper measure from the goods from the local right owner.

2. In the country where no article can regulate the parallel import, it is a good time at present to consider to make it clear that the parallel import might not be so much related to the respective intellectual property law, trading and/or competition law but relates only to the contract law and the civil law. Specifically there is an implicit contract relationship between respective local right owners and

there is a civil obligation on the parallel importer who is required to distinguish its goods from those of the local right owner in order to stay away from a tort claim. Even the parallel importer's obligation here will be arguably categorized otherwise, it should be able to be considered to be one under the competition law.

3. It is reported that Hungary and three countries in Northern Europe adopt for the patented parallel import goods a 'constructive license' principle by which is meant if there is no indication of limited license use or sale territory, it is constructed that the patentee has licensed its goods to be re-sold worldwide. This practice only deals with the patent matter and govern the relation between the right owner in the exporting territory and the parallel importer. We are of the opinion that what is important is whether the parallel importer has somehow acted for distinguishing or expressing its goods in any a specific situation but not whether there is an indication of limited license use or sale territory. Further, we believe it is also important for the parallel import to abide by its obligation under the civil law and/or the competition law.
4. It was reported in 1990 by the International Industrial Property Protection Association that according to its investigation, most of the 22 industrial countries negate the legitimacy of the parallel imported patented products. We do not think this is a good idea according to what has been disclosed and discussed above.
5. If there should be an article specifically dealing with the parallel import, it appears to be a good idea to let it have the contents, like "the parallel importer shall be liable for other's damages if its imported goods are not caused to be appropriately distinguished from a relevant right owner."
6. We are too busy to fully develop our finding. Nevertheless, we believe we have raised enough inklings for an interested entity to continue the development. We welcome such entity to feedback some benefits to this firm if its ultimate development richly reaps somehow.

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