# 106 年智慧財產權業務座談會

# 專利法未來修正議題

## 議題說明

## 議題1：刪除申請專利範圍為取得申請日之必要文件

一、背景說明

近年來，智慧財產活動的全球化進展快速，使各國間有關專利申請程序的國際調和化更加重要，專利法條約(Patent Law Treaty)主要目的是調和及簡化各國和地區間不同的專利申請程序，提升使用方便性及減輕申請人負擔。各國多參照該條約規定修正其本國法規以符合國際潮流。我國為順應國際上對鬆綁申請專利範圍作為取得申請日之要件，並落實簡化專利申請程序，研議導入「刪除申請專利範圍為取得申請日之必要文件」議題。

二、規劃方向

現行專利法規定，申請發明或新型專利時，以申請書、說明書、申請專利範圍及圖式(或必要之圖式)齊備之日為申請日。依專利法第26 條規定，說明書應明確且充分揭露，使發明所屬技術領域中具有通常知識者，能瞭解其內容，並可據以實現；申請專利範圍應明確界定申請專利之發明，且各請求項必須為說明書所支持。也就是說，申請專利範圍所界定之發明，必須是申請人在申請時已認知並記載於說明書中之發明，而作為申請專利範圍基本單元之請求項，必須根據說明書揭露之內容為基礎，且不得超出說明書揭露之內容。由此可知，說明書揭露之內容，為申請專利範圍之基礎且包括申請專利範圍在內。另依同法第 58 條第 4 項規定，發明專利權範圍，以申請專利範圍為準，於解釋申請專利範圍時，並得審酌說明書及圖式。綜上所述，專利說明書及圖式應可涵蓋申請專利範圍全部內容，故以說明書及圖式(或必要之圖式)為取得申請日之核心要件即可，申請專利範圍似無於申請時即確立之必要。

又申請人為儘早取得申請日，或有在完成創作後，即匆促提出申請，致有申請專利範圍記載未盡周全之情況。惟申請專利範圍係界定申請人欲請求保護之範圍，作為日後權利主張之依據，故申請專利範圍應如何記載，甚為重要。為鼓勵發明創作，使申請人於完成說明書及圖式提出申請取得申請日後，再於相當期間內補正申請專利範圍，以免影響申請人取得申請日之時效，同時也可使申請人有較長的時間規劃衡酌申請專利範圍，以保障其創作內容，並減少申請專利範圍修正的機率，增進審查效能，研擬修正專利法第 25 條及第 106 條規定，刪除「申請專利範圍」為取得申請日之必要文件，並配套修正專利法施行細則及專利審查基準相關規定。

三、相關參考法條

(一) 專利法相關法規：專利法第 25 條、第 26 條、第 58 條、第 106 條

(二) 其他相關法規：

1. PLT Article 5 Filing Date

(1) Elements of Application

(a) Except as otherwise prescribed in the Regulations, and subject to paragraphs (2) to (8), a Contracting Party shall provide that the filing date of an application shall be the date on which its Office has received all of the following elements, filed, at the option of the applicant, on paper or as otherwise permitted by the Office for the purposes of the filing date:

(i) an express or implicit indication to the effect that the elements are intended to be an application;

(ii) indications allowing the identity of the applicant to be established or allowing the applicant to be contacted by the Office;

(iii) a part which on the face of it appears to be a description.

PLT 第 5 條 申請日

(1) [申請的組成部分 ]

(a) 除實施細則另有規定外，並在遵守本條第(2)至(8)款規定的前提下，締約方應規定，以其主管局收到根據申請人的選擇以紙件或該局為申請日的目的所允許的其他形式提交的下列所有組成部分之日為申請的申請日：

(i) 明示或暗示所提交的組成部分意圖是作為一份申請的說明；

(ii) 能使該局確定申請人身份或與申請人取得聯繫的說明；

(iii) 從表面看上去為一份說明書的部分。

## 議題 2：發明申請後 18 個月內審定之案件是否續行公開問題

一、背景說明

早期公開制度設立之目的，是為了因應過去專利審查期間較長，造成公眾第三人無法及早獲知專利資訊，衍生重複研發之情事。然而，近來我國發明專利申請案件審結時間逐漸縮短，甚至有申請案件於公開前即已完成審定之現象，產生後續公開作業是否續行之問題。

依照我國現行專利法規定，本局接到發明專利申請文件後，經審查認為無不合規定之處，且無應不予公開之情事者，經過 18 個月後，應將該申請案予以公開，且得因申請人請求提早公開，而將其申請案之技術內容在 18 個月期限屆滿前予以公開。

實務上，公開前已核准審定之申請案件，於完成繳費領證之程序後，即予以公告；該案申請時所提交的摘要、說明書、申請專利範圍及圖式(申請時所揭露技術內容之最大範圍)，自申請日滿 18 個月後，仍會予以公開。公開前已核駁審定之案件，因為公開前遭核駁審定一事，非屬法定不予公開之事由，因此自申請日滿 18 個月後，該案申請時所提交的摘要、說明書、申請專利範圍及圖式仍會依法予以公開。

二、規劃方向

綜合各國實務作法，擬修正專利法第 37 條，對於公開前已核准審定之發明專利申請案，採公告核准之技術內容及公開申請時所揭露之技術內容併行，較符合專利權人與公眾第三人間之利益平衡；至於公開前已核駁審定之發明專利申請案，採行不公開發明專利申請案申請時所揭露之技術內容，可對於申請人有較多之保護，以利其後續研

發策略之規劃。

三、徵詢事項說明

公開前已核駁審定之發明專利申請案，可申請再審查、訴願及行政訴訟等行政救濟程序，如核駁案提起行政救濟，其早期公開應如何作業，試擬方案如下：

- 方案一：如果經行政救濟確定該申請案應予核准，依該申請案時程進行公開(自其申請日後滿 18 個月者即予公開，未滿者，於滿 18 個月後公開)；行政救濟確定該申請案應予核駁時，不予公開。
- 方案二：提起行政救濟後，即按照一般審查中案件之程序，依該申請案時程進行公開準備作業，於其申請日滿 18 個月後予以公開。

四、相關參考法條：專利法第 37 條

## 議題 3：未於申請日後 3 年內申請實審之救濟

一、背景說明

依現行專利法第 38 條第 1 項及第 4 項之規定，發明專利申請日後 3 年內，任何人均得向專利專責機關申請實體審查；但未於上述期間內申請實體審查者，該發明專利申請案，視為撤回，且無補救之機會。

二、規劃方向

為給予專利申請人更完善之制度保障，擬參照 PLT 第 12 條(1)、及日本特許法第 48 條之 3(5)等立法例，對於被視為撤回的發明專利申請案的申請人，如非因故意致使無法在法定的期間內提出實體審查之申請，可以在一定期間內，提出實體審查之申請。

三、相關參考法條

(一) 專利相關法規：專利法第 38 條

(二) 其他相關法規：

1. PLT Article 12 Reinstatement of Rights After a Finding of Due Care or Unintentionality by the Office
   (1) [Request] A Contracting Party shall provide that, where an applicant or owner has failed to comply with a time limit for an action in a procedure before the Office, and that failure has the direct consequence of causing a loss of rights with respect to an application or patent, the Office shall reinstate the rights of the applicant or owner with respect to the

application or patent concerned, if:

(i) a request to that effect is made to the Office in accordance with the requirements prescribed in the Regulations;

(ii) the request is filed, and all of the requirements in respect of which the time limit for the said action applied are complied with, within the time limit prescribed in the Regulations;

(iii) the request states the reasons for the failure to comply with the time limit; and

(iv) the Office finds that the failure to comply with the time limit occurred in spite of due care required by the circumstances having been taken or, at the option of the Contracting Party, that any delay was unintentional.

第 12 條 在主管局認為已作出應作的努力或認為非故意行為之後的權利恢復

(1) [請求]締約方應規定，申請人或所有人未能遵守採取主管局的程式中的行動所適用的期限，並且因未遵守期限而直接帶來喪失對申請或專利的權利的後果的，如果符合以下規定，該局應恢復申請人或所有人對該有關申請或專利的權利：

(i) 按實施細則規定的要求向主管局提出這一內容的請求；

(ii) 該請求是在實施細則規定的期限內提交的，而且採取這一行動所適用的期限方面的所有要求在實施細則

規定的期限內均得到遵守；

(iii) 該請求說明未遵守期限的理由；並且

(iv) 主管局認為儘管已作出在具體情況下應作的努力而仍未能遵守期限，或根據締約方的選擇，主管局認為任何延誤並非出於故意。

2. 日本特許法第 48-3 條 Request for examination of application

(1) Where a patent application is filed, any person may, within 3 years from the filing date thereof, file with the Commissioner of the Patent Office a request for the examination of the said application.

(4) Where a request for the examination of an application is not filed within the time limit as provided in paragraph (1), the said patent application shall be deemed to have been withdrawn.

(5) An applicant of a patent application that was deemed to have been withdrawn under the preceding paragraph, where there are reasonable grounds for failing to file a request for examination of the patent application, may file a request for examination only within the time limit as provided in Ordinance of the Ministry, Trade and Industry.

## 議題 4：新型更正

一、背景說明

現行專利法第 118 條規定，新型更正案之審查方式以形式審查為原則，例外如果同時有舉發案繫屬時，應合併並進行實體審查。然而，實務上，遇到專利權人行使或預備行使專利權時，例如有民事侵權訴訟或新型技術報告案件繫屬中時，當事人爭執之對象，通常是新型專利案之實體內容是否合於專利要件，此時若僅對專利權人申請更正之內容進行形式審查，似乎反不利於專利權人行使權利。

另一方面，參考中國大陸與日本等國家有關新型專利更正制度的立法例，與我國有所差異。以中國大陸而言，依據其專利法實施細則第 69 條，當有專利無效宣告案件（對應為我國之舉發案件）繫屬時，始容許修改（對應為我國之更正）實用新型案件之權利要求書（對應為我國之申請專利範圍）；而是否准予修改，均係審查申請修改之實體內容，而非僅審查其形式。日本的實用新案則有訂正審判（對應為我國之更正）與訂正請求（對應為我國合併舉發之更正）二種制度（實用新案法第 14-2 條），訂正審判有申請次數之限制。

| | 更正 | 合併舉發之更正 |
|---|---|---|
| 中國大陸 | X | 實體審查 |
| 日本 | • 稱為「訂正審判」<br>• 限制申請人可提出的時機及次數(刪除請求項不受限制) | • 稱為「訂正請求」<br>• 限制申請人可提出的時機(刪除請求項不受限制)<br>• 實體審查 |
| 我國 | 形式審查 | 實體審查 |

此外，依現行我國專利法第 118 條第 2 項及新型專利更正之形式審查基準的規定，實際上，形式審查比實體審查之要求更多，容許更正的範圍更窄。

有鑑於上述情況，實務界有建議擴大新型專利更正案實體審查之適用範圍，並在無實體爭議的情形下擴大可准更正的範圍。對於擴大新型專利更正實體審查之適用範圍，且在無舉發案繫屬時是否亦可為獨立之更正案、是否採取形式審查等問題，綜整提出規劃方案如下。

二、規劃方向

- 方案一：將新型專利更正案實體審查之適用範圍，擴大於有舉發案、新型專利技術報告案或民事訴訟繫屬中時，但不受理獨立的更正案，也就是廢除現行新型更正之形式審查制度。
- 方案二：除如同方案一擴大新型專利之更正實體審查的適用範圍外，仍受理獨立的更正案，維持現行形式審查之方式。

三、相關參考法規

(一) 專利相關法規：專利法第 67 條、第 118 條

(二) 其他相關法規

- 中國大陸實用新型法施行細則第 69 條

  在無效宣告請求的審查過程中，發明或者實用新型專利的專利權人可以修改其權利要求書，但是不得擴大原專利的保護範圍。

  發明或者實用新型專利的專利權人不得修改專利說明書和附圖，外觀設計專利的專利權人不得修改圖片、照片和簡要

說明。

- 日本實用新案法第 14-2 條 Correction of description, claim or drawing attached to the application

(1) Except for the following cases, a holder of utility model right may correct the description, scope of claims, or drawings attached to the application only once.
  (i) where two months have lapsed from the date when the first Report of Utility Model Technical Opinion was served; and
  (ii) where the time limit initially designated under Article 39(1) for a trial for invalidation of utility model registration has expired.

(2) The correction under the preceding paragraph shall be limited to those for the following purposes:
  (i) restriction of the scope of claims;
  (ii) correction of errors; and
  (iii) clarification of an ambiguous statement.

(3) Any correction under paragraph (1) shall be made within the scope of the matters described in the description, scope of claims or drawings attached to the application (in the case of correction for the purpose of item (ii) of the preceding paragraph, the description, scope of claims or drawings originally attached to the application).

(4) The correction under paragraph (1) shall not substantially enlarge or alter the scope of claims.

(5) Article 4 of the Patent Act shall apply mutatis mutandis to the period prescribed in paragraph (1)(i).

(6) Notwithstanding item (i) of paragraph (1), where, due to reasons beyond the control of the person who requests a correction under paragraph (1), the person is unable to request the correction within the time limit as provided in the said item, the person may request the correction within 14 days (where overseas resident, within two months) from the date on which the reasons ceased to exist, but not later than six months following the expiration of the said time limit.

(7) In addition to the corrections allowed under paragraph (1), a holder of utility model right may correct the description, scope of claims, or drawings attached to the application as far as such correction is for the purpose of deletion of a claim or claims; provided, however, that where a trial for invalidation of the utility model registration is pending at the Patent Office, the description, scope of claims, or drawings attached to the application may not be corrected after notice is given under Article 156(1) of the Patent Act applied mutatis mutandis pursuant to Article 41 (in the case where the proceedings have been reopened under Article 156(2) of the Patent Act, after further notice is given under Article 156(1) of the Patent Act).

(8) A correction under paragraph (1) or the preceding paragraph may be made even after the lapse of the

utility model right; provided, however, that this shall not apply after the utility model registration has been invalidated in a trial for invalidation of the utility model registration.

## 議題 5：舉發人補提理由或證據逾限者，不予審酌

一、背景說明

依據現行專利法第 73 條第 4 項但書規定，舉發人在舉發審定前補提之舉發理由或證據，仍應審酌。實務上常發生，就同一專利案有民事訴訟案件及舉發案同時繫屬時，訴訟中較不利的一方，藉由舉發審查程序中仍得補提理由或證據之規定，持續提出新理由、新證據或意見陳述，導致舉發審查程序延宕數年，不但耗費國家行政、司法資源，且損及對造當事人利益。

經查，有關舉發案件之提起，各國係以提交舉發理由、證據為程序要件之一。舉發人於提起後再增加理由或補充證據之處理，各國之立法方式，有適用民事訴訟法規定要求舉發人須限期為之，或於專利法及其相關法規明定舉發人須於一定期限內提出，逾期提出之補充理由或證據則不予考慮者。

為避免當事人於舉發案件審查時濫行補提理由或證據導致程序拖延或影響相關司法案件之順利進行，故經檢視日本特許法第 131 條、第 132 條及第 174 條、中國大陸專利法第 45 條，專利法實施細則第 67 條及審判指南 4.3.1 規定，修正本項文字。且為使舉發人有更充足之補提期間，爰延長補提期間為舉發後三個月內，亦併敘明。

二、規劃方向

修正專利法第 73 條第 4 項，舉發人補提理由或證據，應於舉發後三個月內為之，逾期提出者，不予審酌之。

三、相關參考法條

(一) 專利相關法規：專利法第 73 條

(二) 其他相關法規

1. 日本特許法

- 第 131 條 Formal requirements of appeal/request for trial

(1) A person filing appeal/request for trial shall submit a written request stating the following to the Commissioner of the Patent Office:

(i) the name, and the domicile or residence of the party and the representative thereof;
(ii) the identification of the appeal/trial case; and
(iii) object and statement of the claim.

(2) When a request for invalidation trial is filed, the facts on which the invalidation of the patent is based shall be specified in concrete terms, and the relationship of each fact that is required to be proved with the relevant evidence shall be stated in the grounds for the request as provided in item (iii) of the preceding paragraph.

(3) Where a request for correction trial is filed, the object and statement of the claim listed in paragraph (1) item (iii) shall be stated as provided by Ordinance of the Ministry of Economy, Trade

and Industry.

(4) Where a request for correction trial is filed, the corrected description, scope of claims or drawings shall be attached to the written request.

- 第 132 條 Joint trial

(1) Where two or more persons file a request for invalidation trial or a trial for invalidation of the registration of extension of duration concerning the same patent right, the request may be filed jointly.

(2) Where a request for trial is filed against patentees jointly owning a patent right, the demandees in the said request shall be all the joint owners of the said patent right.

(3) Where appeal/request for trial is filed by a joint owner or owners of a patent right or a right to obtain a patent, with regard to the right under joint ownership, all of the said joint owners shall jointly file the request.

(4) Where there is a ground for suspension or termination of appeal/trial procedures on any of the demandants of appeal/request for trial under paragraph (1) or (3) or any of the demandees of appeal/request for trial under paragraph (2), the said suspension or termination shall have effect on all of the demandants or demandees.

- 第 174 條 Application mutatis mutandis of provisions regarding trial, etc.

  (1) Articles 114, 116 to 120-2, 120-5 to 120-8, 131(1), the main clause of 131-2(1), 132(3), 154, 155(1) and (3), and 156(1), (3) and (4) shall apply mutatis mutandis to a retrial against a final and binding revocation decision.

  (2) Articles 131(1), the main clause of 131-2(1), 132(3) and (4), 133, 133-2, 134(4), 135 to 147, 150 to 152, 155(1), 156(1), (3) and (4), 157 to 160, the main clause of 167-2, 168, 169(3) to (6), and 170 shall apply mutatis mutandis to a retrial against a final and binding trial decision in an appeal against an examiner's decision of refusal.

  (3) Articles 131(1), the main clause of 131-2(1), 132(1), (2) and (4), 133, 133-2, 134(1), (3) and (4), 135 to 152, 154, 155(1) to (3), 156(1), (3) and (4), 157, 167, 168, 169(1), (2), (5) and (6), and 170 shall apply mutatis mutandis to a retrial against a final and binding trial decision in an invalidation trial or a trial for invalidation of the registration of extension of the duration.

  (4) Articles 131(1) and (4), the main clause of 131-2(1), 132(3) and (4), 133, 133-2, 134(4), 135 to 147, 150 to 152, 155(1) and (4), 156(1), (3) and (4), 157, 165, 167-2, 168, 169(3) to (6), and 170 shall apply

mutatis mutandis to a retrial against a final and binding trial decision in a correction trial.

(5) Article 348(1) (Scope of proceedings) of the Code of Civil Procedure shall apply mutatis mutandis to a retrial

2. 中國大陸專利法第 45 條：自國務院專利行政部門公告授予專利權之日起，任何單位或者個人認為該專利權的授予不符合本法有關規定的，可以請求專利複審委員會宣告該專利權無效。
3. 中國大陸專利法實施細則第 67 條：在專利複審委員會受理無效宣告請求後，請求人可以在提出無效宣告請求之日起 1 個月內增加理由或者補充證據。逾期增加理由或者補充證據的，專利複審委員會可以不予考慮。

## 議題 6：違反審定後分割之法效

一、背景說明

根據專利法施行細則第29條，申請案核准審定後甫申請分割者，應自原申請案說明書或圖式所揭露之發明且非屬原申請案核准審定申請專利範圍之部分，申請分割，以避免影響已審定案件。然而，該條並未對於審定後分割違反此規定之效果加以規定。實務上，審定後分割如係自原申請案之申請專利範圍中分割者，將對分割申請案以違反專利法施行細則第 29 條予以核駁審定。

然而，分割申請案性質上屬於獨立之專利申請案件，其核駁事由應以專利法定之，以資明確。

二、規劃方向

擬將審定後分割係自原申請案之申請專利範圍中分割之效果，在專利法中予以明定，具體係將專利法施行細則第 29 條之內容移列專利法第 34 條，並於第 46 條第 1 項增訂對應之核駁事由。

三、相關參考法條：專利法第 34 條、第 46 條、專利法施行細則第 29 條

## 議題7：真正申請權人救濟

一、背景說明

我國專利法第5條、第7條及第8條對於創作或設計係出於受雇或受聘之關係者，其專利申請權如何決定歸屬，有相關規定。惟實務上，創作人與資金提供者之間，可能締結僱傭、聘用、委託開發、技術合作或產學合作種種契約，對於該等契約關係在法律上應如何定性、創作產出是否屬於雙方關係所由生者等，可能產生爭議。而如創作之內容遭非為專利申請權適法歸屬之人提出專利申請，也就是所稱冒認申請時，便會產生真正申請權人應如何尋求救濟之問題。

一方面，真正申請權人可以提起舉發撤銷該專利權，並循專利法第35條，就相同發明提出申請案，並以經撤銷確定之發明專利權之申請日為其申請日。實務上對第35條案件將以變更專利權人辦理。另一方面，真正申請權人與冒認申請人間具有僱傭關係者，真正申請權人可依據專利法第10條，提出證明文件請求變更專利權人名義。實務上將第10條規定類推適用於其他法律關係(後續應可修法明文擴大適用範圍)，並以專利權讓與登記辦理。

然而，對於上述民事、行政雙軌救濟途徑，實務操作結果似有未盡合於各方需求之處。為對各界經驗及需求有所了解，爰以諮詢。

二、徵詢事項說明

承上所述，目前所悉關於真正申請權人之救濟途徑，產生疑慮的事項如下，請各界就運用經驗上是否曾遭遇困難、有無建議修法方向等表示意見。

(一) 專利權依第10條規定回復歸屬於真正申請權人者，權利變動之

效力時點為何？

理論上，名義專利權人欠缺享有專利權之資格，真正申請權人如取回專利權，宜認為其自始即為權利人，以維護其權益。如果認為真正申請權人是在某一時點(譬如判決確定時)方取回權利，形同認為名義專利權人有一段時間合法享有專利權，法理上似乎未盡公允。

然而，另一方面，該專利權可能已有讓與或授權關係，如權利自始改歸於真正申請權人，善意受讓權利或取得授權之人應如何處理？(譬如 A 創作一發明之後並未提出專利申請案，遭 B 冒認申請，並於取得專利權後讓與予善意之 C，再由 C 授權善意之 D 實施。)

對於真正申請權人及第三人之保護、維護先申請原則、避免法律關係複雜化等等目標，彼此之間有不易平衡之處。

(二) 得以冒認申請之事由提起舉發之人，是否宜限於真正申請權人？

得以冒認申請之事由提起舉發之人，限於利害關係人(第 71 條第 1 項、第 2 項)，如遭到名義專利權人提起侵權訴訟之被告。然而，如專利權因此事由而被撤銷，真正申請權人便無從獲得救濟；是否應限縮得以此事由提起舉發之人限於真正申請權人，而第三人如遭名義專利權人依民事訴訟程序主張權利，仍得為無效抗辯。

(三) 第 35 條是否應刪除或修正？

我國專利法第 35 條係規定真正申請權人於舉發成立確定後，得提起自己之申請案並援用冒認申請案之申請日，而案件不再公告。因此，真正申請權人之專利權期限應是始於冒認申請案申請日，而於冒認申請案公告日後得主張權利。其效果形同真正申請權人溯及自始取得該專利權，因此，實務上對於此類案件，以變更專利權人辦理。

不過，前述原則首先同樣會產生對於已發生之讓與或授權關係應如何處理之問題。另一方面，真正申請權人對於其無法透過第 35 條將冒認申請案的內涵優化，亦有其權益未能獲得充分保護之意見。此外，循民事或行政救濟途徑之結果十分相似，也引發對於以舉發程序處理申請權爭議議題之效益之討論。

三、其他事項

對於真正申請權人之救濟，各國所選擇之立法例有所不同，反映不同政策思考方向。美國自 AIA 法案生效後，由先發明原則改為發明人先申請原則，在審查程序中仍有先確認發明人為何之衍生程序(Derivation Proceedings)，以使專利案(權)歸屬於真正申請權人。

相對地，日本法以雙軌制處理申請權爭議問題，一方面真正申請權人得請求將專利權移轉為其所有(移轉請求權)，此移轉之效果為該專利權溯及自始為真正申請權人所有。該專利權之善意被授權人，如果已於日本境內有實施該發明之事業或準備，在該程度內享有非專屬授權。另一方面，冒認申請為核駁及無效審判事由，但特許法並無類似我國專利法第 35 條之規定，亦即，如果循無效審判撤銷該專利權，該專利權即自始消滅，無從復歸真正申請權人所有。

中國大陸則似是傾向認為申請權歸屬爭議為私法性質，冒認申請並非核駁及無效宣告事由；真正申請權人得請求中止專利案之審查或凍結專利權之變動，等到其循機制獲致肯定其為權利歸屬人之調解書或判決書後，再請求變更權利人登記，並終結該中止、凍結狀態。

德國法則一方面允許真正申請權人得請求名義專利權人將專利權移轉歸其所有(移轉請求權)，但起訴年限依名義專利權人係善惡意而不同。另一方面，冒認申請案核准公告後，真正申請權人得以冒認

申請為事由提起異議撤銷該專利權，並於一個月內提起自己的申請案，以冒認申請案為基礎案主張優先權。如此一來雖然申請日較後，但真正申請權人有提出較佳專利文件的機會；不過，如果真正申請權人錯過公告後 9 個月之異議期間，雖然仍得提起無效審判，但便無提出自己申請案主張優先權之機會，該專利將歸於消滅。

四、相關參考法規

(一) 專利相關法規：專利法第 10 條、第 35 條、第 71 條

(二) 其他相關法規

1. 日本特許法

- 第 38 條 Joint applications

  Where the right to obtain a patent is jointly owned, a patent application may only be filed by all the joint owners.

- 第 49 條 Examiner's decision of refusal

  The examiner shall render an examiner's decision to the effect that a patent application is to be refused where the patent application falls under any of the following:

  (vii) where the applicant for the patent does not have the right to obtain a patent for the said invention.

- 第 74 條 Special provisions pertaining to transfer of patent right

(1) Where a patent falls under the requirements as provided in Article 123(1)(ii) (limited to cases where the patent is obtained in violation of Article 38) or the requirements as provided in item (vi) of the said paragraph, a person who has the right to obtain a patent for the invention pertaining to the said patent may request the patentee thereof to transfer the said patent right as provided by Ordinance of the Ministry of Economy, Trade and Industry.

(2) Where the transfer of a patent right has been registered based on the request under the preceding paragraph, the patent right shall be deemed to have belonged to a person who has obtained the said registration from the beginning. The same shall apply to the right to claim compensation under Article 65(1) or Article 184-10(1) on the invention pertaining to the said patent right.

(3) Paragraph (1) of the preceding Article shall not apply where the share of a jointly owned patent right is transferred based on the request under paragraph (1).

- 第 79-2 條 Non-exclusive license due to the working of the invention prior to the registration of transfer of patent right

A person who had a patent right, or an exclusive license on the patent right or a non-exclusive license on the patent right, or the exclusive license at the time of the registration of transfer of the patent right based on the request pursuant to Article 74(1), who is doing a business working an invention in Japan or preparing such business, before the registration of transfer of the patent right, without knowledge that the patent falls under the requirements as provided in Article 123(1)(ii) (limited to cases where the said patent has been obtained in violation of Article 38) or the requirements as provided in item (vi) of the said paragraph, shall have a non-exclusive license on the patent right only to the extent of the invention and the purpose of such business worked or prepared.

- 第 123 條 Invalidation Trial

(1) Where a patent falls under any of the following, a request for invalidation trial may be filed. In the event of two or more claims, a request for invalidation trial may be filed for each claim.

(ii) where the patent has been granted in violation of Articles 25, 29, 29-2, 32, 38 or 39(1) to 39(4); (where the patent has been obtained in violation of Article 38, excluding the case where the transfer of a patent right pertaining

to the patent has been registered based on the request under Article 74(1));

(vi) where the patent has been granted on a patent application filed by a person who has not had the right to obtain a patent for the said invention; (excluding the case where the transfer of a patent right pertaining to the patent has been registered based on the request under Article 74(1));

(2) A request for invalidation trial may be filed only by an interested person (in a case where a request for invalidation trial is filed on the ground that the patent falls under item (ii) of the preceding paragraph (limited to cases where the patent is obtained in violation of Article 38) or item (vi) of the said paragraph; a person who has the right to obtain the patent).

2. 德國專利法

- 第 7 條

(1) In order to avoid the substantive examination of the patent application being delayed due to the need to establish the identity of the inventor, the applicant shall be deemed, in the proceedings before the German Patent and Trade Mark Office,

to be entitled to request the grant of the patent.

(2) If a patent is revoked on account of opposition filed on the ground of usurpation (section 21 (1) no. 3) or if opposition results in the surrender of the patent, the opponent can himself file an application in respect of the invention within one month of the official communication thereof and claim the priority of the earlier patent.

- 第 8 條

The entitled person in respect of whose invention an application has been filed by a non-entitled person or a party aggrieved by usurpation can require the patent applicant to assign to him the right to the grant of the patent. Where the application has already resulted in a patent, he can require the proprietor of the patent to transfer the patent. Subject to the fourth and fifth sentences, the right can be asserted by bringing an action only within a time limit of two years after publication of the grant of the patent (section 58 (1)). If the aggrieved party has filed opposition on the ground of usurpation (section 21 (1) no. 3), he can still bring an action within one year of the final conclusion of the opposition proceedings. The third and fourth sentences shall not apply if the proprietor of the patent did not act in good faith when obtaining the patent.

- 第 21 條

(1) The patent shall be revoked (section 61) if it emerges that

3. the essential content of the patent has been taken from the descriptions, drawings, models, implements or equipment of another person or from a process used by this person, without his consent (usurpation)

- 第 59 條

(1) Within nine months of publication of the grant of the patent any person may give notice of opposition to the patent, in the case of usurpation only the aggrieved party. Notice of opposition shall be given in a written reasoned statement. It may only be based on the claim that one of the grounds for revocation set out in section 21 exists. The facts justifying the opposition shall be detailed. The particulars shall, in so far as they have not already been included in the notice of opposition, be submitted in writing within the opposition period.

- 第 81 條

(1) Proceedings for revocation of the patent or

invalidity of the supplementary protection certificate, or on account of the grant or withdrawal of the compulsory licence, or on account of the adjustment of the remuneration for a compulsory licence determined by court judgment shall be initiated by filing an action. The action shall be directed against the proprietor of the patent entered in the Register or against the holder of the compulsory licence. An action against the supplementary protection certificate may be consolidated with an action against the patent on which it is based and may also be based on the fact that there is a ground for revocation (section 22) of the patent on which it is based.

(2) An action for revocation of a patent cannot be filed as long as a notice of opposition can still be filed or opposition proceedings are still pending. An action for the declaration of invalidity of the supplementary protection certificate cannot be filed in so far as requests in accordance with section 49a (4) can be filed or proceedings for a decision on these requests are pending.

(3) In the case of usurpation, only the aggrieved party shall be entitled to file an action.

## 議題 8：專利申請案經公告後，說明書與著作權之關係

一、背景說明

(一) 著作權法第 3 條第 1 項第 1 款規定:「著作係指屬於文學、科學、藝術或其他學術範圍之創作。」而創作的內容需符合「原創性」（為著作人自己之創作，非抄襲他人者）及「創作性」(作品需符合一定之「創作高度」) 等 2 項要件，才是著作權法保護之「著作」。是以，專利說明書、摘要、申請專利範圍及其圖式如符合前開著作之要件者，則屬受著作權法保護之著作。

(二) 專利法第 47 條第 2 項規定，經公告之專利案，任何人均得申請閱覽、抄錄、攝影或影印其審定書、說明書、申請專利範圍、摘要、圖式及全部檔案資料。因此，專利案如經公告，則上開資料是否仍受著作權法保護？

二、規劃方向

現行第三人對於經公告後之專利說明書得重製行為態樣過於限縮，且皆為實體物重製之行為態樣，但專利公報已改採網路發行。故擬參考澳洲專利法第 226 條、美國聯邦法規 37 CFR § 1.71(d)、(e)、37 CFR § 1.84 等規定，並考量我國現實狀況，明定任何人對經公告之專利案，得為全部檔案資料之重製或公開傳輸行為。

三、相關參考法條

(一) 專利相關法規：專利法第 47 條

(二) 其他相關法規

1. 澳洲專利法第 226 條 Documents open to public inspection do not infringe copyright

(1) If a document mentioned in subsection (2) is open to public inspection, doing any of the following in relation to the whole or part of the document does not constitute an infringement of any copyright subsisting under the Copyright Act 1968 in any literary or artistic work:

(a) reproducing the document in two-dimensional form;
(b) communicating (within the meaning of that Act) the document to the public
(c) translating (within the meaning of that Act) the document.

(2) The documents are:

(a) a provisional specification; and
(b) a complete specification; and
(c) a prescribed document.

(3) If a reproduction of an unpublished work is made as a result of a document being open to public inspection, the supply or communication of the reproduction does not constitute the publication of the work for the purposes of the Copyright Act 1968.

2. 美國聯邦法規

- 37 CFR §1.71 Detailed description and specification of

the invention.

(d) A copyright or mask work notice may be placed in a design or utility patent application adjacent to copyright and mask work material contained therein. The notice may appear at any appropriate portion of the patent application disclosure. For notices in drawings, see § 1.84(s). The content of the notice must be limited to only those elements provided for by law. For example, "© 1983 John Doe" ( 17 U.S.C. 401) and " *M* John Doe" ( 17 U.S.C. 909) would be properly limited and, under current statutes, legally sufficient notices of copyright and mask work, respectively. Inclusion of a copyright or mask work notice will be permitted only if the authorization language set forth in paragraph (e) of this section is included at the beginning (preferably as the first paragraph) of the specification.

(e) The authorization shall read as follows:

A portion of the disclosure of this patent document contains material which is subject to (copyright or mask work) protection. The (copyright or mask work) owner has no objection to the facsimile reproduction by anyone of the patent document or the patent disclosure, as it appears in the Patent and Trademark Office patent

file or records, but otherwise reserves all (copyright or mask work) rights whatsoever.

- 37 CFR §1.84 Standards for drawings.

(s) Copyright or Mask Work Notice. A copyright or mask work notice may appear in the drawing, but must be placed within the sight of the drawing immediately below the figure representing the copyright or mask work material and be limited to letters having a print size of .32 cm. to .64 cm. ( 1/8 to 1/4 inches) high. The content of the notice must be limited to only those elements provided for by law. For example, "© 1983 John Doe" ( 17 U.S.C. 401) and "*M* John Doe" ( 17 U.S.C. 909) would be properly limited and, under current statutes, legally sufficient notices of copyright and mask work, respectively. Inclusion of a copyright or mask work notice will be permitted only if the authorization language set forth in § 1.71(e) is included at the beginning (preferably as the first paragraph) of the specification.

## 議題 9：引進開放授權

一、背景說明

專利權之價值並非技術本身，而係取決於技術實際運用後所能達成的經濟產能，故擬參考英國及德國之立法例，引進開放授權制度，透過專利權人自願向本局聲明開放讓任何人在一定條件下實施其專利，且本局將開放授權聲明登記及公告之方式，建置公開透明的專利資訊交換及專利交易平台，以期協助企業專利之運營。

二、規劃方向

專利權人在無專屬授權或其他限制授權之情況下，得自願向本局聲明開放讓任何人在一定條件下實施其專利；該項聲明經登記與公告後，專利權人不得請求禁制令。欲使用該項專利者，只要通知專利權人，在符合相當條件及給付授權金後，專利權人無正當理由不得拒絕其實施。開放授權契約一旦成立，被授權人即負有給付授權金及踐行實施該專利的義務；專利權人則在「無開放授權契約存在」或是「被授權人無實施該專利」大前提下，得撤銷開放授權。

三、相關參考法條

(一) 專利相關法規：無

(二) 其他相關法規：

1. 德國專利法第 23 條

(1) Where a patent applicant or the person entered in the Register as the proprietor of the patent (section 30 (1)) declares to the German Patent and Trade Mark Office in writing that he is willing to allow anyone to use the

invention in return for equitable remuneration, the annual renewal fees due in respect of the patent following receipt of the declaration shall be reduced to one half. The declaration shall be recorded in the Register and published in the Patent Gazette (Patentblatt).

(2) The declaration shall be inadmissible as long as there is an entry in the Register regarding the grant of an exclusive licence (section 30 (4)) or an application is pending before the German Patent and Trade Mark Office for such entry to be made.

(3) Any person who, subsequent to the declaration being entered, wishes to use the invention shall inform the proprietor of the patent of his intention. The information shall be deemed to have been effected if it has been dispatched by registered letter to the person entered in the Register as the proprietor of the patent or to his registered representative or the person authorised to accept service (section 25). The information shall indicate how the invention is to be used. Subsequent to the information, the informing party shall be entitled to effect use in the manner he has indicated. He shall be obliged, after the expiry of each calendar quarter, to inform the proprietor of the patent of the use effected and to pay the remuneration for that use. If he does not fulfil this obligation in due time, the person registered as proprietor of the patent

may set him a reasonable extension of time for payment and, following expiry without the obligation being fulfilled, may prohibit further use of the invention.

(4) The remuneration shall be fixed by the Patent Division upon the written request of a party. Sections 46, 47 and 62 shall apply mutatis mutandis to the procedure. The request may be directed against more than one party. When fixing the amount of the remuneration the German Patent and Trade Mark Office may make an order requiring the party opposing the request to bear the costs of the procedure in whole or in part.

(5) After the expiry of a period of one year following the last fixing of remuneration, any party affected thereby may apply for its adjustment if in the meantime circumstances have arisen or become known which make the remuneration fixed appear obviously inappropriate. In other respects, subsection (4) shall apply mutatis mutandis.

(6) Where the declaration is made in respect of an application, the provisions of subsections (1) to (5) shall apply mutatis mutandis.

(7) The declaration may be withdrawn in writing vis-à-vis the German Patent and Trade Mark Office at any time, as long as the proprietor of the patent has not been informed of any intention to use the invention. The withdrawal shall take effect when it is filed. The sum

by which the annual renewal fees have been reduced shall be paid within one month of the withdrawal of the declaration. If the difference is not paid within the time limit specified in the third sentence, it may still be paid together with the surcharge for late payment before the expiry of a period of a further four months.

2. 英國專利法

- 第 46 條 Patentee's application for entry in register that licences are available as of right.

(1) At any time after the grant of a patent its proprietor may apply to the comptroller for an entry to be made in the register to the effect that licences under the patent are to be available as of right.

(2) Where such an application is made, the comptroller shall give notice of the application to any person registered as having a right in or under the patent and, if satisfied that the proprietor of the patent is not precluded by contract from granting licences under the patent, shall make that entry.

(3) Where such an entry is made in respect of a patent—

(a) any person shall, at any time after the entry is made, be entitled as of right to a licence under

the patent on such terms as may be settled by agreement or, in default of agreement, by the comptroller on the application of the proprietor of the patent or the person requiring the licence;

(b) the comptroller may, on the application of the holder of any licence granted under the patent before the entry was made, order the licence to be exchanged for a licence of right on terms so settled;

(c) if in proceedings for infringement of the patent (otherwise than by the importation of any article [F27from a country which is not a member State of the European Economic Community]) the defendant or defender undertakes to take a licence on such terms, no injunction or interdict shall be granted against him and the amount (if any) recoverable against him by way of damages shall not exceed double the amount which would have been payable by him as licensee if such a licence on those terms had been granted before the earliest infringement;

(d) the renewal fee payable in respect of the patent after the date of the entry shall be half the fee which would be payable if the entry had not been made.

(3A)An undertaking under subsection (3)(c) above may be given at any time before final order in the proceedings, without any admission of liability.]

(4) The licensee under a licence of right may (unless, in the case of a licence the terms of which are settled by agreement, the licence otherwise expressly provides) request the proprietor of the patent to take proceedings to prevent any infringement of the patent; and if the proprietor refuses or neglects to do so within two months after being so requested, the licensee may institute proceedings for the infringement in his own name as if he were proprietor, making the proprietor a defendant or defender.

(5) A proprietor so added as defendant or defender shall not be liable for any costs or expenses unless he enters an appearance and takes part in the proceedings.

- 第 47 條 Cancellation of entry made under s. 46.

(1) At any time after an entry has been made under section 46 above in respect of a patent, the proprietor of the patent may apply to the comptroller for cancellation of the entry.

(2) Where such an application is made and the balance paid of all renewal fees which would have

been payable if the entry had not been made, the comptroller may cancel the entry, if satisfied that there is no existing licence under the patent or that all licensees under the patent consent to the application.

(3) Within the prescribed period after an entry has been made under section 46 above in respect of a patent, any person who claims that the proprietor of the patent is, and was at the time of the entry, precluded by a contract in which the claimant is interested from granting licences under the patent may apply to the comptroller for cancellation of the entry.

(4) Where the comptroller is satisfied, on an application under subsection (3) above, that the proprietor of the patent is and was so precluded, he shall cancel the entry; and the proprietor shall then be liable to pay, within a period specified by the comptroller, a sum equal to the balance of all renewal fees which would have been payable if the entry had not been made, and the patent shall cease to have effect at the expiration of that period if that sum is not so paid.

(5) Where an entry is cancelled under this section, the rights and liabilities of the proprietor of the patent shall afterwards be the same as if the entry had not been made.

(6) Where an application has been made under this section, then—

(a) in the case of an application under subsection (1) above, any person, and

(b) in the case of an application under subsection (3) above, the proprietor of the patent, may within the prescribed period give notice to the comptroller of opposition to the cancellation; and the comptroller shall, in considering the application, determine whether the opposition is justified.

## 議題 10：專利檔案保存規定之檢討

一、背景說明

現行專利法第 143 條規定專利檔案保存期限為永久保存，但幾十年下來，本局專利檔案儲存空間已佔 3,500 坪，但每年仍有 7~8 萬新申請案，已面臨儲存空間不足問題；又專利電子申請及審查尚未全面化，致使保存成本過高，故擬修法專利檔案之保存期限改為定期保存。

二、規劃方向

擬在現行檔案管理法制下，修正專利法第 143 條，將專利檔案之保存期限由永久保存改為定期保存，並針對不同結案情形的檔案訂定不同的保存年限，同時，保留本局擇定具代表性、價值性之檔案，延長其保存年限之彈性。

三、相關參考法條：專利法第 143 條

## 其他議題

下述議題為本局初步評估應屬可採，或業經對外徵詢意見之修法議題，併供參考。

一、申請人未於專利法第 28 條第 1 項所定 12 個月內，至我國提出專利申請案並主張國際優先權者，得於 2 個月內提出申請案並主張國際優先權

二、專利申請權或專利權為共有者，就應有部分之強制執行，無須全體共有人同意

三、專利權為共有，共有人之一死亡而無繼承人時，其應有部分以比例分配其他共有人

四、專利權授權並經登記後，專利權人將專利權讓與給第三人，該授權契約對受讓人繼續存在

五、設計專利權期限延長為 15 年

六、專利申請案核准審定後，得申請分割之期間延長為 3 個月

七、刪除說明書為取得設計專利申請日之必要文件

八、專利法第 31 條、第 32 條一案兩請相關議題：

(一)依第 31 條規定審查而申請人選擇發明放棄新型時，實務上會以「新型專利權，視為自始不存在」來辦理新型專利案，此法源是否明訂於專利法。

(二)發明核准審定後公告前，新型當然消滅或撤銷時，依專利法施行細則第 26 條之 2，發明專利不予公告。此法源是否明定於專利法。