美國專利訴訟制度：以專利有效性問題為中心

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壹、前言

1982 年美國設立「美國聯邦巡迴上訴法院」(United States Court of Appeals for the Federal Circuit，以下稱 CAFC)，而 CAFC 最重要的管轄事項即是專利法事件[1]。在 CAFC 成立之前，專利事件在民事訴訟部分是，當事人先在聯邦地方法院處理爭端，而若不服地方法院的判決，則當事人可上訴至該地方法院所屬的巡迴上訴法院[2]。另在行政訴訟部分，專利申請人或專利權人如果不服「美國專利暨商標局」(United States Patent and Trademark Office，以下稱 USPTO)的處分，其案件將上訴至「美國聯邦海關暨專利上訴法院」(United States Court of Customs and Patent Appeals，以下稱 CCPA) [3]。以上訴審角度來說，是類似我國普通法院和行政法院雙軌制的架構。此

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1 *See* Rochelle Cooper Dreyfuss, *In Search of Institutional Identity: The Federal Circuit Comes of Age*, 23 BERKELEY TECH. L.J. 787, 787-89 (2008).

2 *See* Ted L. Field, *Improving the Federal Circuit's Approach to Choice of Law for Procedural Matters in Patent Cases*, 16 GEO. MASON L. REV. 643, 643-44 (2009).

3 *See* Cecil D. Quillen, Jr., *Commentary on Bessen and Meurer's Patent Failure: An Industry Perspective*, 16 J. INTELL. PROP. L. 57, 63-64 (2008).

外，CCPA 成立於 1929 年，而美國國會設立 CCPA 的目的之一是讓法院可以審理專利審查機關的處分[4]。

在 CAFC 未成立的時候，因為沒有單一的上訴法院來管轄專利事件的情況下，所以專利法運作的主要問題在於，各聯邦上訴法院在處理專利法爭議的時候，會使用不一樣的法理原則，造成有些上訴法院是偏向專利權人而有些上訴法院比較站在專利侵權人的一方[5]。

CAFC 所管轄的專利法事件包括從 USPTO 上訴的行政訴訟事件，也包括從聯邦地方法院上訴的民事訴訟事件。與我國法制比較，智慧財產法院於 2008 年 7 月的設立，使得我國關於專利法案件的第二級審不再區分民事或行政。

不過，CAFC 對民事訴訟和行政訴訟的上訴案件有不同的審查基準，而這不同的審查基準主要是針對事實問題。事實問題的決定者有三種：法官、陪審團、以及政府官員。對於不同的決定者，CAFC 會使用不同的審查基準。與我國比較來說，智慧財產法院是第二級審，而對於地方法院的判決是可以完全的不採而重新調查證據且做出新的法律判斷。然而，如果智慧財產法院審理的案件是關於智慧財產局的行政處分，則法院有可能會基於智慧局具有專業上知識而會比較容易維持智慧局的行政處分。

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[4] *See* John P. Sutton, *Should the Federal Circuit Defer to Findings of Fact by Tribunals below It?*, 89 J. PAT. & TRADEMARK OFF. SOC'Y 701, 702 (2007).

[5] *See* Adam Shartzer, *Patent Litigation 101: Empirical Support for the Patent Pilot Program's Solution to Increase Judicial Experience in Patent Law*, 18 FED. CIRCUIT B.J. 191, 194-95 (2009).

假設一種狀況，專利侵權民事案件的被告又同時在智慧局提出針對系爭專利的舉發案。最後，地方法院的判決和智慧局的行政處分在訴願程序結束後都上訴到了智慧財產法院。此外，在專利有效性的爭點上，被告又只有提出相同的證據。那麼，智慧財產法院該採取什麼樣的審查方式或基準呢？

面對這樣的問題，本文意在透過美國專利訴訟制度的現況和操作方式的觀察，來提出美國法制的可能操作方式的分析。本文第貳部分在介紹專利侵權民事訴訟中的當事人配對的不同與相對應的初審法院間的關係。第參部分在介紹，於專利核准後，會涉及該專利的行政訴訟類型。基本上，第貳部分和第參部分的整體內容可以讓讀者知道 CAFC 會從何處得到關於專利法事件的上訴案件。

接著，本文第肆部分則進一步分析 CAFC 的上訴審管轄權的種類、範圍和內容。另在第伍部分，本文分析美國專利法中的有效性問題，而解釋重點在於爭點中法律問題部分和事實問題部分。這樣區分的目的是做為之後介紹法律問題和事實問題的審查基準的基礎。最後，在這些基本的分析內容上，本文將討論如果民事訴訟和行政訴訟所涉及的專利有效性爭議同時上訴至 CAFC，則 CAFC 將會怎麼處理這樣的案件，特別是當面對相同證據的時候，CAFC 可能的處理方式。本文認為 CAFC 會同時處理民事訴訟事件和行政訴訟事件的機會極小。

貳、專利有效性爭議的初級處理平台之一：專利民事訴訟

一、爭議狀況之一：專利權人對一般人

根據 28 U.S.C. § 1331，由於專利法是聯邦法規，所以聯邦地方法院對於專利侵權民事訴訟有第一審的管轄權[6]。再根據 28 U.S.C. § 1338，聯邦地方法院對於涉及專利的訴訟有專屬的管轄權[7]。亦即，只要原告在起訴狀中提及專利侵權的爭議，聯邦地方法院就取得管轄權[8]。

但專利權人並非可在任一個聯邦地方法院提起專利侵權民事訴訟。只有在對被告有「對人管轄權」（personal jurisdiction）的地方法院，專利權人才能對被告提起專利侵權民事訴訟。如果被告居住在某聯邦地方法院的地理管轄區域內，或如果被告自願受該法院所管轄，則該地方法院對被告有管轄權[9]。不過，對於居住在外州或

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[6] *See* 28 U.S.C. § 1331 ("The district courts shall have original jurisdiction of all civil actions arising under the Constitution, laws, or treaties of the United States.").

[7] 28 U.S.C. § 1338 provides:
(a) The district courts shall have original jurisdiction of any civil action arising under any Act of Congress relating to patents, plant variety protection, copyrights and trademarks. Such jurisdiction shall be exclusive of the courts of the states in patent, plant variety protection and copyright cases.
(b) The district courts shall have original jurisdiction of any civil action asserting a claim of unfair competition when joined with a substantial and related claim under the copyright, patent, plant variety protection or trademark laws.

[8] *See* Emmette F. Hale, III, The 'Arising Under' Jurisdiction of the Federal Circuit: An Opportunity for Uniformity in Patent Law, 14 Fla. St. U. L. Rev. 229, 236 (1986)(explaining the meaning of "arising under" in 28 U.S.C. § 1338(a)).

[9] *See* State of Ga. v. Pa. R.R. Co., 324 U.S. 439, 467-68 (1945)("In a civil suit in personam, jurisdiction over the defendant, as distinguished from venue, implies, among other things, either voluntary appearance by him or service of process upon him at a place where the officer serving it has authority to execute a writ of

外國（或外國籍）的被告，法院要依照該州法律或判例法才能決定是否能行使「對人管轄權」[10]。

判斷「對人管轄權」的成立與否是必須根據 CAFC 的判例法[11]。首先，法院會假設原告起訴狀所指稱的事實是真實的，以便進行「對人管轄權」的判斷[12]。其次，根據專利權人如何主張，法院會決定其是否具有「一般的對人管轄權」（general personal jurisdiction）或「特定的對人管轄權」（specific personal jurisdiction）[13]。

（一）一般的對人管轄權

在「一般的對人管轄權」部分，被告必須要在法院所管轄的地理位置內維持「持續不斷的和系統性的」（continuous and systematic）一般商業上接觸，則法院才對其有管轄權[14]。

summons. Under the general provisions of law, a United States District Court cannot issue process beyond the limits of the district. And a defendant in a civil suit can be subjected to its jurisdiction in personam only by service within the district. Such was the general rule established by Judiciary Act Sept. 24, 1789, …, in accordance with the practice at the common law. And such has been the general rule ever since."(citing Robertson v. R.R. Labor Bd., 268 U.S. 619, 622 (1925))(citation omitted)).

[10] *See* GEOFFREY C. HAZARD, JR. ET AL., PLEADING AND PROCEDURE: STATE AND FEDERAL 146 (Foundation Press 9th ed. 2005)(1962).

[11] *See* Pennington Seed, Inc. v. Produce Exchange No. 299, 457 F.3d 1334, 1338 (Fed. Cir. 2006)(" We review personal jurisdiction issues in a patent infringement case under Federal Circuit law.").

[12] *Id.*

[13] *See* Silent Drive, Inc. v. Strong Industries, Inc., 326 F.3d 1194, 1200 (Fed. Cir. 2003).

[14] Synthes (U.S.A.) v. G.M. Dos Reis Jr. Ind. Com de Equip. Medico, 563 F.3d 1285, (Fed. Cir. 2009)("To be subject to general jurisdiction, a defendant business entity must maintain 'continuous and systematic general business contacts' with the forum, even when the cause of action has no relation to those contacts.").

（二）特定的對人管轄權

另在「特定的對人管轄權」部分，系爭侵權行為必須是源自於（arise out of）或相關於（relate to）系爭請求權基礎（cause of action）[15]。然而，儘管侵權人和法院所管轄的區域之間的接觸是獨立的（isolated）或偶爾的（sporadic），法院仍能夠對侵權人行使管轄權[16]。

判斷「特定的對人管轄權」成立與否有兩個步驟[17]。第一步驟是看該法院所在地的州法律或判例法是否可讓該州的地方法院對侵權人行使管轄權[18]。如果通過第一步驟，則第二步驟接著問法院管轄權的行使是否符合「正當程序」（due process）[19]。由於第一步驟涉及州法律或判例法的分析，故本文無法敘述一般的原則。不過，針對第二步驟的判斷，其涉及的是 CAFC 的判例法[20]，故本文可以對其法理進行一般的描述。

第二步驟的成立有三個要件：（1）被告有目的性地將他的活動導入該法院所轄區域內住民的生活中；（2）原告起訴所涉及的爭議是來自於被告的活動；（3）法院對被告行使管轄權是合理且公平的[21]。只要當事人間的情況達到此三要件，則法院就可以對居住在外

[15] *See Silent Drive, Inc.*, 326 F.3d at 1200.
[16] *See id*.
[17] *See id*.
[18] *See id* ("First, we look to the state long-arm statute and see whether it is satisfied.").
[19] *See id* at 1201("If state law confers jurisdiction, we decide whether the court's exercise of jurisdiction satisfies the requirements of due process.").
[20] *See* 3D Systems, Inc. v. Aarotech Laboratories, Inc., 160 F.3d 1373, 1377 (Fed. Cir. 1998)("[W]hen analyzing personal jurisdiction for purposes of compliance with federal due process, Federal Circuit law, rather than regional circuit law, applies").
[21] *See id.* at 1378 ("[W]e outlined a three-prong minimum contacts test for determining if specific jurisdiction existed: (1) whether the defendant purposefully

州或外國（或外國籍）的被告行使管轄權。

二、爭議狀況之二：專利權人對美國聯邦政府

如果被告是美國聯邦政府或及附屬單位或機構，則根據 28 U.S.C. § 1498(a)，第一審管轄法院歸屬於「美國國家賠償法院」（United States Court of Federal Claims）[22]。

三、爭議狀況之三：專利權人對州政府

根據美國憲法第十一次修正案[23]，原則上，在州政府不同意的情況下，聯邦法院是不能審查以州政府為被告的起訴[24]。但國會可以根據憲法第十四次修正案第五條，在為了保護專利權人的「正當程序」利益下，讓州政府免於在聯邦法院被控告的權力有所限制[25]。

如果州政府侵害了專利權，但卻未提供專利權人補償、或提供了不適當的補償，則專利權人可以在聯邦地方法院控告州政府[26]。此外，判斷是否州政府可以免於在聯邦法院被控告的準據法是

directed its activities at residents of the forum, (2) whether the claim arises out of or relates to those activities, and (3) whether assertion of personal jurisdiction is reasonable and fair.").

[22] *See* TDM America, LLC v. U.S., 85 Fed. Cl. 774, 781 (Fed. Cl. 2009).

[23] U.S. Const. Amend. XI provides, "The Judicial power of the United States shall not be construed to extend to any suit in law or equity, commenced or prosecuted against one of the United States by Citizens of another State, or by Citizens or Subjects of any Foreign State."

[24] *See* Pennington Seed, Inc. v. Produce Exchange No. 299, 457 F.3d 1334, 1339 (Fed. Cir. 2006)("The Eleventh Amendment to the United States Constitution limits the judicial authority of the federal courts and prevents citizens from bringing suit against a state in a federal court without its consent.").

[25] *See id*.

[26] *See id*. ("The infringement of a patent by a state may be actionable in federal courts 'only where the State provides no remedy, or only inadequate remedies, to injured patent owners for its infringement of their patent.'").

CAFC 判例法[27]。

至於州政府的官員如果是侵害專利權之人，雖然其是行使公權力或執行公務，卻無法享有如州政府的豁免權，故專利權人可以在聯邦地方法院對其提出訴訟[28]。不過，法院僅能給予排除侵害的救濟而非損害賠償金[29]。

四、爭議狀況之四：由擬侵權人提出的訴訟

根據 28 U.S.C. § 2201(a)[30]，如果「專利侵權人」面臨潛在的專利侵權訴訟紛爭，則其也可以主動出擊，而在聯邦地方法院提出「確認之訴」（declaratory judgment），以主張其並未侵害系爭專利權，或系爭專利是無效的或不可執行的（unenforceable）[31]。

然而，承審法院仍須要對於專利權人有「對人管轄權」[32]。所涉及的法理和專利權人控告專利侵權人的情況是一樣的[33]。此外，

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[27] *See id*. at 1338.
[28] *See id*. at 1341.
[29] *See id.*
[30] 28 U.S.C. § 2201(a) provides, "In a case of actual controversy within its jurisdiction, except with respect to Federal taxes other than actions brought under section 7428 of the Internal Revenue Code of 1986, a proceeding under section 505 or 1146 of title 11, or in any civil action involving an antidumping or countervailing duty proceeding regarding a class or kind of merchandise of a free trade area country (as defined in section 516A(f)(10) of the Tariff Act of 1930), as determined by the administering authority, any court of the United States, upon the filing of an appropriate pleading, may declare the rights and other legal relations of any interested party seeking such declaration, whether or not further relief is or could be sought. Any such declaration shall have the force and effect of a final judgment or decree and shall be reviewable as such."
[31] *See* MedImmune, Inc. v. Genentech, Inc., 549 U.S. 118, 120-21 (2007).
[32] *See* Deprenyl Animal Health, Inc. v. University of Toronto Innovations Foundation, 297 F.3d 1343, 1348 (Fed. Cir. 2002).
[33] *See id.* at 1349-51.

承審法院受理「確認之訴」的前提是，當事人之間有一定程度的紛爭，且此紛爭的解決是有急迫性和現實性，而使得法院必須要決定是否准予原告「確認之訴」所提出的請求[34]。

五、爭議狀況之五：新藥申請時的專利侵權訴訟

1984 年美國制訂了「藥品價格競爭暨專利權期限復原法」(Drug Price Competition and Patent Term Restoration Act of 1984)，又稱「Hatch-Waxman 法」(Hatch-Waxman Act)，意在平衡兩種政策，一是鼓勵藥廠投入新藥的研發，另是鼓勵更多藥廠加入「學名藥」(generic drug) 的生產以降低藥價[35]。

藥廠可選擇證明自己的藥品和學名藥品是生物上相等的，來取代一般新藥核准程序中必須要進行的安全性和有效性的評估，此即「簡化式新藥申請」(Abbreviated New Drug Application，以下稱 ANDA)[36]。根據 21 U.S.C. §§ 355(b)(1) & (c)(2)，學名藥的原始新藥申請藥廠要向「美國食品暨藥物管理局」(United States Food and Drug Administration)(以下稱 FDA) 提供與該藥物相關的專利，而 FDA 會將所列舉的專利刊登在記載藥品療效的「橘皮書」(Orange

[34] *See* Prasco, LLC v. Medicis Pharmaceutical Corp., 537 F.3d 1329, 1334 (Fed. Cir. 2008)("*MedImmune* reaffirmed that the proper test for subject matter jurisdiction in declaratory judgment actions is 'whether the facts alleged, under all the circumstances, show that there is a substantial controversy, between the parties having adverse legal interests, of sufficient immediacy and reality to warrant the issuance of a declaratory judgment.'").

[35] *See* Eli Lilly and Co. v. Teva Pharmaceuticals USA, Inc., 557 F.3d 1346, 1347 (Fed. Cir. 2009).

[36] *See id.* (citing 21 U.S.C. § 355(j)(2)(A)).

Book）內[37]。

根據 35 U.S.C. § 271(e)(2)，一旦藥廠提出 ANDA，則學名藥的原始新藥申請藥廠可以控告該藥廠侵害其專利權[38]。另根據 21 U.S.C. § 355(j)(2)(A)(vii)，當該藥廠提出 ANDA 時，必須要列舉藥品所涉及的專利[39]。或者，藥廠可選擇向 FDA 提出以下四種內容的具結其中之一：（1）沒有相關的專利；（2）相關專利的期限已經到期；（3）專利權即將到期；或（4）相關專利是無效的、或沒有侵權的疑慮[40]。

此外，根據 21 U.S.C. § 355(j)(2)(B)，如果該藥廠提出的具結是第四種類型，則該藥廠必須要向學名藥的原始新藥申請藥廠提出詳細的說明，來支持專利無效或是沒有侵權的主張[41]。接著，專利權人（即學名藥的原始新藥申請藥廠）要在四十五天內決定是否對該藥廠提出侵權訴訟[42]。如果專利權人不提告，則 FDA 就會准許 ANDA；然而，如果專利權人提告，則 FDA 會等到專利權期限期滿、訴訟有所結果、或在專利權人收到該藥廠的通知起三十個月之後，才會考慮是否核准 ANDA[43]。

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[37] *See id.*
[38] *See id.*
[39] *See id.*
[40] *See id.* ("The Hatch-Waxman Act specifies the certification alternatives, (I) no such patent information has been submitted to the FDA; (II) the patent has expired; (III) the patent is set to expire on a certain date; or (IV) the patent is invalid or will not be infringed by the manufacture, use, or sale of the new generic drug for which the ANDA is submitted.").
[41] *See id.*
[42] *See id.*
[43] *See id.*

參、專利有效性爭議的初級處理平台之二：專利行政訴訟

一、由專利權人開啟的程序

在專利申請案被核准後，專利權人會和二個行政部門進行互動。一是 USPTO，接觸的目的在於修正專利的缺陷。二是國際貿易委員會（International Trade Commission，以下稱 ITC），接觸的目的在於把侵害專利權的進口物品擋在海關。在這兩類互動中，所涉及的行政訴訟都會有機會處理專利的有效性。

（一）USPTO

在專利申請案核准後，專利權人可以向 USPTO 申請「再發證」（reissue）[44]或「再審查」（reexamination）[45]。

根據 35 U.S.C. § 251，專利權人可利用「再發證」來修正請求項、專利說明書或圖示等的缺陷，以避免專利無效的問題發生[46]。不過，在「再發證」程序中，USPTO 仍然可以對系爭專利進行可

[44] *See* Anthony M. Petro, Note, *Threading the Needle: Intermediate-Scope Broadening Reissue Claims and the Recapture Rule*, 87 TEX. L. REV. 827 (2009).

[45] *See* Greg H. Gardella & Emily A. Berger, *United States Reexamination Procedures: Recent Trends, Strategies and Impact on Patent Practice*, 8 J. MARSHALL REV. INTELL. PROP. L. 381, 382-86 (2009)(introducing the current system of patent reexamination).

[46] 35 U.S.C. § 251, ¶ 1 provides, "Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Director shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue."

專利性的審查[47]。

另關於「再審查」，根據 35 U.S.C. § 302，專利權人可遞交專利或書面資料向 USPTO 主張系爭專利的可專利性疑慮，並要求 USPTO 進行審查[48]。如果經過重新審查後系爭專利仍然維持其可專利性，則在未來訴訟中，系爭專利的有效性比較難以被挑戰[49]。此外，當 USPTO 收到「再審查」的申請時，根據 35 U.S.C. § 303(a)，其必須先確認是否有「新的可專利性問題」(a substantial new question of patentability)[50]。不過，這不是一個高門檻的限制。最後，如果專利權人不服 USPTO 的處分，則其可上訴至 CAFC。

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[47] *See* In re Doyle, 482 F.2d 1385, 1392 (Cust. & Pat. App. 1973)("However, we agree with the board that the statutory provision for reissue of patents, 35 U.S.C. § 251, by its third paragraph, dictates that the provisions applicable to applications for patents, including section 112, are applicable to reissue applications also.").

[48] *See* In re Swanson, 540 F.3d 1368, 1375 (Fed. Cir. 2008)("Any person may file a request for an ex parte reexamination of an issued patent based on prior art patents or printed publications.").專利權人亦可根據 35 U.S.C. § 301 來向 USPTO 遞交與其專利的可專利性有關的先前技術文獻。但對於依照 35 U.S.C. § 301 所遞交的文件，USPTO 並無義務去以該文件來審查系爭專利的可專利性，而 USPTO 僅需要將該文件列為系爭專利的檔案資料之一即可。換句話說，儘管 35 U.S.C. § 301 的先前技術文獻可能會使系爭專利產生可專利性的問題，但如果 USPTO 不依此而為任何處分，並不會有任何可專利性爭議的情況發生。因此，專利權人理論上應該不會利用此條來修補其專利的可專利性缺陷。

[49] *See* Jason S. Oliver, Note, *Reexamining the Meaning of a "Substantial New Question of Patentability": Amending the Patent Reexamination Provision's Threshold Requirement*, 53 SYRACUSE L. REV. 1093, 1095 (2003)("[A] patent that survived a reexamination proceeding was viewed as having an enhanced level of validity--as a 'high quality' patent--and was less likely to be challenged in future litigation.").

[50] *See Swanson*, 540 F.3d at 1375.

（二）ITC

美國國會立法設立 ITC 的目的在於防止進口貨物對於美國國內廠商的不公平競爭情況發生，而侵害專利權即被視為一種不公平競爭[51]。根據 19 U.S.C. § 1337，專利權人可向 ITC 請求禁止侵害其專利權的產品進口、或禁止為了銷售而進口該產品、或禁止已進口的該產品繼續銷售[52]。一旦 ITC 開始進行其調查程序[53]，其採取的是類似法院審理案件的方式[54]。由行政法官（administrative law judge）擔任程序主持者及事實認定者，而當事人雙方必須要根據聯邦法院的程序法和證據原則來進行是否有專利侵權事實的認定[55]。在行政法官做出決定後，ITC 會根據該決定再進一步做出最終的行政處分[56]，亦即，ITC 會決定如何對專利權人給予救濟、或是宣告專利侵權不成立[57]。此外，在 ITC 做出給予專利權人救濟的行政處分後，會有六十天的時間來讓美國總統來決定是否不執行該處分，而如

[51] *See* Sapna Kumar, *The Other Patent Agency: Congressional Regulation of the ITC*, 61 FLA. L. REV. 529, 550 (2009).

[52] *See e.g.*, Energizer Holdings, Inc. v. Int'l Trade Com'n, 275 Fed. App'x 969, 970 (Fed. Cir. 2008); Amgen Inc. v. Int'l Trade Com'n, 565 F.3d 846, 848 (Fed. Cir. 2009).

[53] *See* Carl C. Charneski, *The Role of the Office of the Administrative Law Judges within the United States International Trade Commission*, 8 J. MARSHALL REV. INTELL. PROP. L. 216, 218 (2009), *available at* http://www.jmripl.com/Publications/Vol8/Issue2/Charneski.pdf.

[54] *See* Bas de Blank & Bing Cheng, *Where is the ITC Going after Kyocera?*, 25 SANTA CLARA COMPUTER & HIGH TECH. L.J. 701, 702-03 (2009).

[55] *See* Bas de Blank & Bing Cheng, *Where is the ITC Going after Kyocera?*, 25 SANTA CLARA COMPUTER & HIGH TECH. L.J. 701, 703 (2009).

[56] Carl C. Charneski, *The Role of the Office of the Administrative Law Judges within the United States International Trade Commission*, 8 J. MARSHALL REV. INTELL. PROP. L. 216, 225-26 (2009).

[57] *See* Carl C. Charneski, *The Role of the Office of the Administrative Law Judges within the United States International Trade Commission*, 8 J. MARSHALL REV. INTELL. PROP. L. 216, 219 (2009).

果總統同意執行該處分，則 ITC 的行政處分發生效力[58]。

根據 19 U.S.C. § 1337(a)(2)，專利權人必須證明系爭專利所保護的物品在美國國內是有市場存在的[59]。專利人只要證明以下三種情況之一即可：(a) 其對於與專利的實施所需的廠房或器具有一定的投資；(b) 其對於專利的實施已投入了一定的人力或資金；(c) 其對於專利已進行一定的利用，例如：研發或授權實施等[60]。

此外，如果 ITC 認為專利侵權行為是成立的，ITC 可採取二個措施[61]。一是根據 19 U.S.C. § 1337(d)來禁止侵權物進口[62]。另是根據 19 U.S.C. § 1337(f)來禁止對已進口的侵權物進行銷售或流通[63]。

對於不服此類處分的當事人，其可以上訴至 CAFC[64]。

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[58] *See* Thomas A. Broughan, III, *Modernizing § 337's Domestic Industry Requirement for the Global Economy*, 19 FED. CIRCUIT B.J. 41, 45 (2009); G. Brian Busey, *An Introduction to Section 337 and the U.S. International Trade Commission*, 949 PLI/Pat 11, 28 ("If the Commission determines that a violation of Section 337 has occurred and adopts a remedy (i.e. exclusion order), then that determination is transmitted to the President. The President may within a 60-day period disapprove the ITC's order for policy reasons. The President has acted only rarely in the past 30 years to disapprove ITC orders in Section 337 cases, and not since the administration of President Reagan." (citation omitted)).

[59] *See* Alloc, Inc. v. Int'l Trade Com'n, 342 F.3d 1361, 1375 (Fed. Cir. 2003)("A requirement of a patent-based section 337 action is that a domestic industry "relating to the articles protected by the patent ... exist [ ] or [be] in the process of being established." 19 U.S.C. § 1337(a)(2).").

[60] *See* Sapna Kumar, *The Other Patent Agency: Congressional Regulation of the ITC*, 61 FLA. L. REV. 529, 540 (2009).

[61] *See* Fuji Photo Film Co. v. Int'l Trade Com'n, 474 F.3d 1281, 1286 (Fed. Cir. 2007).

[62] *See id.*

[63] *See id.*

[64] *See* Carl C. Charneski, *The Role of the Office of the Administrative Law Judges within the United States International Trade Commission*, 8 J. MARSHALL REV. INTELL. PROP. L. 216, 229-30 (2009).

二、由非專利權人開啟的程序

非專利權人亦可申請「再審查」，其可選擇二個管道。一是根據 35 U.S.C. § 302，要求 USPTO 進行「再審查」，但非專利權人無法就 USPTO 的審查決定採取行政爭訟程序[65]。另是根據 35 U.S.C. § 311，非專利權人可以要求參與「再審查」，並能對 USPTO 的審查決定提起行政救濟，且有機會上訴至 CAFC[66]。不過，如果非專利權人選擇了第二個管道，但卻未能成功地挑戰系爭專利的可專利性，則該非專利權人原則上無法在往後的民事訴訟或「再審查」程序中再度挑戰系爭專利的可專利性[67]。

肆、專利事件的上訴審管轄權

一、CAFC 的設立

1982 年美國成立了 CAFC，其主要目的在於促進專利法適用上的一致性[68]。它的前身是「美國關稅及專利上訴法院（United States

[65] *See* Cooper Technologies Co. v. Dudas, 536 F.3d 1330, 1332 (Fed. Cir. 2008). 如果非專利權人只是想遞送習知的技術文獻給 USPTO，而不想參與可專利性的審查，則其可根據 35 U.S.C. § 301 向 USPTO 提供相關文獻，且非專利權人的身分可以被保密。

[66] *See id.* ("Unlike an *ex parte* reexamination proceeding, an *inter partes* reexamination proceeding allows the third-party requester to participate in the reexamination by submitting written comments addressing issues raised in the patent owner's response to an office action, appealing a decision in favor of patentability, and participating as a party to an appeal taken by the patent owner.").

[67] *See* ACCO Brands, Inc. v. PC Guardian Anti-Theft Products, Inc., 592 F.Supp.2d 1208, 1216 (N.D. Cal. 2008)("A third party whose request for an *inter partes* reexamination results in an order under 35 U.S.C. § 313 is estopped from asserting at a later time the invalidity of any claim finally determined to be valid and patentable, so long as the third party raised or could have raised the issue during the *inter partes* reexamination proceedings.").

[68] *See* Lawrence M. Sung, *Echoes of Scientific Truth in the Halls of Justice: The*

Court of Customs and Patent Appeals，稱 CCPA）[69]。在 1982 年，根據「聯邦法院改善法」（Federal Courts Improvement Act of 1982）」，美國設立了 CAFC[70]。CAFC 可管轄的事件規範在 28 U.S.C. §§ 1291, 1292, 1295 & 1296。

二、CAFC 對專利法事件的上訴審管轄權

（一）對實體判決

根據 28 U.S.C. § 1295(a)(1)，如果聯邦地方法院對於系爭案件的管轄權是因為系爭案件是單純的專利法爭議、或是系爭案件的爭議中有部分是專利法事件，則針對該法院對於系爭案件的判決，CAFC 有專屬的上訴審管轄權[71]。但案件是否屬於專利法事件的判斷是根據原告在起訴狀中是否主張了和專利法有關的權利、所有權、或利益[72]。

（二）對於裁定

根據 28 U.S.C. §§ 1291(a)(1) & (c)(1)，關於訴訟程序中法官對於當事人各項聲請的裁定，除了是關於「禁止令」（injunction）的核准、廢止等裁定之外，CAFC 原則上是不能在地方法院未做出關

Standards of Review Applied by the United States Court of Appeals for the Federal Circuit in Patent-Related Matters, 48 AM. U.L. REV. 1233, 1236-37 (1999).

[69] *See* In re Zurko, 142 F.3d 1447, 1456 (Fed. Cir. 1998).

[70] *See id.*

[71] *See* Christianson v. Colt Industries Operating Corp., 486 U.S. 800, 807 (1988).

[72] *See id.* 807-08 ("[I]n order to demonstrate that a case is one 'arising under' federal patent law 'the plaintiff must set up some right, title or interest under the patent laws, or at least make it appear that some right or privilege will be defeated by one construction, or sustained by the opposite construction of these laws.'").

於系爭案件的判決之前，對該裁定進行上訴審的審查[73]。例如，「初步禁止令」（preliminary injunction）的裁定就是 CAFC 可以在系爭案件仍在地方法院進行時予以審查的裁定[74]。

（三）對 USPTO 的行政處分

根據 28 U.S.C. § 1295(a)(4)(A)，對於 USPTO 的審查官在專利申請案時或在「再審查」程序中所做的處分，不服處分的申請人或專利權人必須先在 USPTO 的「專利上訴暨衝突委員會」（Board of Patent Appeals and Interferences）進行訴願程序後，才可以上訴至 CAFC[75]。

（四）對 ITC 的行政處分

根據 28 U.S.C. § 1295(a)(6)[76]，對於 ITC 依據「關稅法」（Tariff Act of 1930）第 337 條（即 19 U.S.C. § 1337）的處分，若當事人不

[73] *See* Procter & Gamble Co. v. Kraft Foods Global, Inc. 549 F.3d 842, 846 (C.A.Fed. (Cal.),2008)("Taken together, these subsections provide that this court has exclusive jurisdiction over appeals from interlocutory orders "granting, continuing, modifying, refusing or dissolving injunctions," 28 U.S.C. § 1292(a)(1), in any case over which this court would have jurisdiction of an appeal under § 1295. 28 U.S.C. § 1292(c)(1).

[74] *See* Amazon.com, Inc. v. Barnesandnoble.com, Inc., 239 F.3d 1343, 1347 (Fed. Cir. 2001)("The district court granted Amazon's motion, and now BN brings its timely appeal from the order entering the preliminary injunction. We have jurisdiction to review the district court's order under 28 U.S.C. § 1292(c)(1) (1994).").

[75] *See* In re Basell Poliolefine Italia S.P.A., 547 F.3d 1371, 1373-74 (Fed. Cir. 2008)(reexamination).

[76] 28 U.S.C. § 1295(a)(6) provides, "(a) The United States Court of Appeals for the Federal Circuit shall have exclusive jurisdiction-- … (6) to review the final determinations of the United States International Trade Commission relating to unfair practices in import trade, made under section 337 of the Tariff Act of 1930."

服該處分而提出的行政訴訟，CAFC 對該訴訟有專屬管轄權[77]。

三、準據法問題

（一）實體法部分

關於準據法問題，在實體法部分，當 CAFC 遇到專利法的爭點時，其會遵循 CAFC 判例法。但在遇到非其專屬管轄的實體法爭議時，CAFC 會使用原審地方法院所對應的巡迴上訴法院的判例法，例如：著作權法[78]。

（二）程序法部分：CAFC 判例法對其他巡迴上訴法院的判例法

另在程序法部分，如果系爭訴訟程序的爭議和專利法爭議有「基本的關連性」（essential relationship），則 CAFC 會採用其本身的判例法[79]。例如，如何決定當事人哪一方可以獲得律師費的補償即是適用 CAFC 判例法[80]。但通常只要程序事項並非是針對專利法所設計的，則 CAFC 就會採用管轄原審地方法院的巡迴上訴法院的判例法，例如：「重新交付陪審團審查事實的聲請」（即 a motion for a new trial）[81]。

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[77] *See* Linear Technology Corp. v. Int'l Trade Com'n, 566 F.3d 1049, 1054 (Fed. Cir. 2009).

[78] *See* Amini Innovation Corp. v. Anthony California, Inc., 439 F.3d 1365, 1368 (Fed. Cir. 2006)("This court applies copyright law as interpreted by the regional circuits, in this case the for the Ninth Circuit.").

[79] *See* Biodex Corp. v. Loredan Biomedical, Inc., 946 F.2d 850, 858 (Fed. Cir. 1991).

[80] *See* Manildra Mill. Corp. v. Ogilvie Mills, Inc., 76 F.3d 1178, 1182 (Fed. Cir. 1996).

[81] *See* Koito Mfg. Co. v. Turn-Key-Tech, LLC, 381 F.3d 1142, 1148 (Fed. Cir. 2004)("We review the denial of a motion for a new trial under the law of the regional circuit, in this case the Ninth Circuit.").

四、其他巡迴上訴法院的管轄權

一般而言，其他巡迴上訴法院會把涉及專利法的案件移轉至CAFC[82]。然而，如果原告在起訴狀中未能請求處理關於專利法的爭議，反而是被告在反訴時主張專利法的爭議，則其他巡迴上訴法院依然可對於系爭案件有管轄權[83]。

伍、專利有效性問題的處理

一、專利有效性

專利有效性問題主要環繞在四個條文，35 U.S.C. §§ 101, 102, 103, 112。

所謂"a motion for a new trial"是指，根據美國聯邦民事訴訟程序法（Federal Rules of Civil Procedure）第59條，當事人在不同意陪審團的事實認定的情況下，向法院聲請重組陪審團來重新審查證據的可信度。*See* Corey M. Dennis, Case Comment, *Sufficiency of Evidence Not Reviewable in Absence of Post-Verdict Judgment as a Matter of Law or New Trial Motion - Unitherm Food Systems, Inc. v. Swift-Eckrich, Inc., 546 U.S. 394 (2006)*, 41 Suffolk U. L. Rev. 279, 281 (2007)("Under the Federal Rules of Civil Procedure, a movant may challenge the sufficiency of the non-movant's presented evidence by filing a Rule 50(a) motion for JMOL, a Rule 50(b) motion for JMOL, or a Rule 59 motion for new trial. A Rule 50(a) motion for JMOL challenges the sufficiency of evidence before the court submits the case to the jury. A movant making a Rule 50(b) renewed motion for JMOL - formerly called a motion for judgment notwithstanding the verdict (JNOV) - requests that the district court enter judgment in her favor even though the jury returned a verdict for the non-movant. A district court will generally grant a new trial under Rule 59 if the verdict is against the clear weight of the evidence, the damages are excessive, the trial was unfair, or the court made erroneous evidentiary rulings."). 在我國法律中，並無以公民所組成的陪審團來審查證據可信度的制度，故"a motion for a new trial"很難有相當的翻譯。如果按照英文直翻，將無法有就名詞本身來瞭解其意義的效果。因此，筆者選擇將其翻譯為「重新交付陪審團審查事實的聲請」，以盡量能讓名詞本身解釋其制度的內容。

[82] *See* Maxwell v. Stanley Works, Inc., 82 U.S.P.Q.2d 1960, 1960(6th Cir. 2007).

[83] *See* Holmes Group, Inc. v. Vornado Air Circulation Sys., Inc., 535 U.S. 826, 830-34 (2002).

（一）35 U.S.C. § 102：可預見性

35 U.S.C. § 102 在規範何時可以成立「可預見性」（anticipation）。其也規範了可做為引證案的證據類型。此外，「可預見性」是事實問題[84]。其在檢視單一引證案中是否揭露了系爭請求項的所有元件或限制條件[85]。

然而，在 35 U.S.C. § 102 的規範中，仍存在著法律問題。例如，在 35 U.S.C. §§ 102(a) & (b)中關於「印刷版的刊物」（printed publication）的認定[86]；在 35 U.S.C. § 102(b)中關於「公開使用」（in public use）和「銷售」（on sale）的認定[87]；在 35 U.S.C. § 102(f)中關於「發明人」（inventorship）的認定[88]；在 35 U.S.C. §§ 102(a), (e) & (g)中關於「先發明日」的判斷[89]。

[84] *See* Finisar Corp. v. DirecTV Group, Inc., 523 F.3d 1323, 1334 (Fed. Cir. 2008)("Anticipation is a question of fact, reviewed for substantial evidence when tried to a jury.").

[85] *See* Net MoneyIN, Inc. v. VeriSign, Inc., 545 F.3d 1359, 1369 (Fed. Cir. 2008)("As we have stated numerous times (language on which VeriSign relies), in order to demonstrate anticipation, the proponent must show 'that the four corners of a single, prior art document describe every element of the claimed invention.'").

[86] *See* Bruckelmyer v. Ground Heaters, Inc., 445 F.3d 1374, 1377 (Fed. Cir. 2006)("[T]he question whether a particular reference is a 'printed publication' is one of law, which we review *de novo*.").

[87] *See* Manville Sales Corp. v. Paramount Systems, Inc., 917 F.2d 544, 549 (Fed. Cir. 1990)("Whether or not an invention was on sale or in public use within the meaning of section 102(b) is a question of law that this court reviews *de novo*; however, factual findings underlying the trial court's conclusion are subject to the clearly erroneous standard of review.").

[88] *See* Checkpoint Systems, Inc. v. All-Tag Sec. S.A., 412 F.3d 1331, 1338 (Fed. Cir. 2005)("Inventorship is a question of law with underlying factual issues.").

[89] *See* Monsanto Co. v. Mycogen Plant Science, Inc., 261 F.3d 1356, 1362 (Fed. Cir. 2001)("Priority of invention is a question of law based on underlying factual determinations.").

（二）35 U.S.C. § 103：顯而易知性

35 U.S.C. § 103 是一個混合了法律問題和事實問題的問題，其在判斷引證案是否會讓熟知此技藝者認為系爭發明是顯而易知的。「顯而易知性」是法律問題，但在得出法律問題的結論之前必須要解決四個事實問題[90]。

四個事實問題包括（1）決定引證案的範圍及內容；（2）引證案與系爭請求項間的差異；（3）熟知此技藝者的程度；（4）可能使系爭標的具可專利性的輔助考量（例如：商業上的成功、長期為人感受但卻未解決的需求、他人的失敗等）[91]。此外，「顯而易知性」判斷的關鍵在引證案是否能組合而揭露了整體的系爭請求項[92]。

（三）35 U.S.C. § 101：非專利法保護標的

根據 35 U.S.C. § 101，基本上美國專利法所指發明是除了自然法則、物理現象或抽象想法之外的一切事物[93]。如果系爭發明是屬於「非專利法保護標的」，則儘管其通過其他可專利性的測試，其

[90] *See* Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 17 (1966).
[91] *See id.* at 17-18 ("Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.").
[92] *See* KSR Intern. Co. v. Teleflex Inc., 550 U.S. 398, 417 (2007)("The principles underlying these cases are instructive when the question is whether a patent claiming the combination of elements of prior art is obvious.")
[93] *See* Diamond v. Chakrabarty, 447 U.S. 303, 309 (1980)("The laws of nature, physical phenomena, and abstract ideas have been held not patentable.").

仍不會享有專利權的保護[94]。此外，「非專利法保護標的」的爭點是法律問題[95]。特別在由 USPTO 上訴至 CAFC 的案件中，CAFC 可以逕行審查系爭發明是否為非專利法保護標的，而無須當事人將 35 U.S.C. § 101 列為爭點之一[96]。

（四）35 U.S.C. § 112：說明書內容

35 U.S.C. § 112 主要是關於專利說明書內容的規範，其爭點有四種，「可實施性（enablement）」、「書面揭露」（written description）、「最佳實施例」（best mode）和「不明確性」（indefiniteness）[97]。前三者是關於 35 U.S.C. § 112, Para. 1 的規範，而最後一個爭點是關於 35 U.S.C. § 112, Para. 2 的規範。

「可實施性」是在檢驗系爭請求項是否能夠是熟知此技藝者在閱讀說明書後就可以實行的發明，而不用經過「過多的實驗」(undue

[94] *See* In re Comiskey, 554 F.3d 967, 973 (Fed. Cir. 2009)("Only if the requirements of § 101 are satisfied is the inventor 'allowed to pass through to' the other requirements for patentability, such as novelty under § 102 and, of pertinence to this case, non-obviousness under § 103.").

[95] *See* In re Ferguson, 558 F.3d 1359, 1363 (Fed. Cir. 2009)("Whether a claim is drawn to patent-eligible subject matter under § 101 is an issue of law that we review *de novo*.").

[96] *See Comiskey*, 554 F.3d at 974.

[97] *See e.g.*, Mark J. Stewart, Note, *The Written Description Requirement of 35 U.S.C. § 112(1): The Standard after Regents of the University of California v. Eli Lilly & Co.*, 32 IND. L. REV. 537, 541-42 (.1999)("The USPTO and the courts interpret this paragraph to contain three independent requirements: (1) a written description of the invention; (2) a disclosure of how to make and use the invention (enablement); and (3) the best mode of practicing the invention."); Janet S. Hendrickson, Note, *Solomon V. Kimberly-Clark Corp.: The Federal Circuit Throws out the § 112, P 2 "Regards" Clause with Inventor Litigation Testimony*, 32 U. TOL. L. REV. 407, 413 (2001)("There are two grounds to reject a claim for indefiniteness under § 112, P 2.").

experimentation）後才可以實行[98]。「可實施性」是法律問題[99]。

「書面揭露」是檢驗說明書是否能使熟知此技藝者確認發明人的確發明了請求項所主張的發明[100]。其是事實問題[101]。

「最佳實施例」的要求是防止發明人隱藏關於系爭發明的最佳實施例[102]。其是事實問題[103]。有二個事實是要被證明的。一是看發明人在專利申請日當時是否有主觀認定的最佳實施例[104]。二是從客觀的角度來判斷該最佳實施例是否適當地揭露在說明書中[105]。

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[98] *See* Sitrick v. Dreamworks, LLC, 516 F.3d 993, 999 (Fed. Cir. 2008)("The []enablement requirement is satisfied when one skilled in the art, after reading the specification, could practice the claimed invention without undue experimentation.").

[99] *See id.* ("Whether a claim satisfies the enablement requirement of 35 U.S.C. § 112, ¶ 1 is a question of law, reviewed de novo, based on underlying facts, which are reviewed for clear error.").

[100] *See* Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1562-63 (Fed. Cir. 1991)("A fairly uniform standard for determining compliance with the 'written description' requirement has been maintained throughout: 'Although [the applicant] does not have to describe exactly the subject matter claimed, ... the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed.'").

[101] *See id.* at 1563 ("Our cases also provide that compliance with the 'written description' requirement of § 112 is a question of fact.").

[102] *See* Teleflex, Inc. v. Ficosa North America Corp., 299 F.3d 1313, 1330 (Fed. Cir. 2002)("The best mode requirement creates a statutory bargained-for exchange by which a patentee obtains the right to exclude others from practicing the claimed invention for a certain time period, and the public receives knowledge of the preferred embodiments for practicing the claimed invention.")

[103] *See id.* ("Compliance with the best mode requirement is a question of fact which involves a two-pronged inquiry.").

[104] *See id.* ("The first prong is subjective, focusing on the inventor's state of mind at the time he filed the patent application, and asks whether the inventor considered a particular mode of practicing the invention to be superior to all other modes at the time of filing.")

[105] *See id.* ("The second prong is objective and asks whether the inventor adequately disclosed the mode he considered to be superior.").

「不明確性」是探究熟知此技藝者是否能根據說明書的內容來瞭解請求項的範圍[106]。其為法律問題[107]。

（五）35 U.S.C. § 251：不合法的更正

如果系爭專利是「再發證」後的專利，則更正內容的合法性即會成為專利有效性的爭點之一[108]。「不合法的更正」是法律問題[109]。其主要在防止專利權人透過「再發證」程序來重新主張其在專利申請過程中所放棄的權利範圍[110]。其有三個步驟的判斷，第一是確認系爭請求項哪一部分是廣於更正前的範圍，第二是檢驗更正後的該較廣範圍的部分是否為專利申請過程中被放棄的標的，最後是看系爭請求項的其他部分是否是實質上地被限縮了其範圍，而使得整體來說系爭請求項的更正並未擴大了保護範圍[111]。

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106 *See* AllVoice Computing PLC v. Nuance Communications, Inc., 504 F.3d 1236, 1240 (Fed. Cir. 2007)("The test for definiteness asks whether one skilled in the art would understand the bounds of the claim when read in light of the specification.").

107 *See id.* ("The review of indefiniteness under 35 U.S.C. § 112, paragraph 2, proceeds as a question of law without deference.").

108 *See* Medtronic, Inc. v. Guidant Corp., 465 F.3d 1360, 1370 (Fed. Cir. 2006).

109 *See id.* at 1373 ("Determining whether the claims of a reissued patent violate 35 U.S.C. § 251 is a question of law, which we review *de novo*.").

110 *See id.*

111 *See id.* ("We apply the recapture rule as a three-step process: (1) first, we determine whether, and in what respect, the reissue claims are broader in scope than the original patent claims; (2) next, we determine whether the broader aspects of the reissue claims relate to subject matter surrendered in the original prosecution; and (3) finally, we determine whether the reissue claims were materially narrowed in other respects, so that the claims may not have been enlarged, and hence avoid the recapture rule.").

二、法律問題的審查基準

只要是法律問題，CAFC 會「重新」(de novo) 審查地方法院的裁判。除了前述的法律問題之外，涉及專利有效性的法律問題包括「請求項解釋」[112]。

三、事實問題的審查基準

CAFC 對於事實問題的審查基準比較多元，其依事實發現者 (facts finder) 的身分不同而採用不同的審查基準。

(一) 民事訴訟部分一：法官作為事實發現者

1、法官判斷事實問題

如果當事人未要求組織陪審團，則法官會自行判斷事實問題[113]。對這樣的事實發現的審查，CAFC 是採用「明顯的錯誤」(clear error) 基準[114]。亦即，如果沒有「明確的和肯定的確信」(definite and firm conviction) 以斷定法官是發現了錯誤的事實，則 CAFC 不能推翻法官的事實發現[115]。

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[112] *See* Markman v. Westview Instruments, Inc., 517 U.S. 370, 376 (1996).

[113] *See* Huff v. Dobbins, Fraker, Tennant, Joy & Perlstein, 243 F.3d 1086, 1090 (7th Cir. 2001)("Rule 38 of the Federal Rules of Civil Procedure provides that any party may demand a trial by jury for a jury issue by serving upon the other party a jury demand at any time after the commencement of the action, but not later than ten days after service of the last pleading directed to such issue, otherwise a jury is waived.").

[114] *See* Forest Laboratories, Inc. v. Ivax Pharmaceuticals, Inc., 501 F.3d 1263, 1268 (Fed. Cir. 2007)("Anticipation is a question of fact that we review for clear error following a bench trial.").

[115] *See id.* ("Under the clear error standard, the court's findings will not be

2、簡易判決

在民事訴訟過程中，且在還沒有進入陪審團聽審階段時，如果當事人向法官聲請「簡易判決」（summary judgment），只要法官認為對於「關鍵的事實」（material fact）已經沒有可爭執的理由，則其會核准「簡易判決」[116]。例如，被告可以向法官聲請對於系爭專利的無效性做出「簡易判決」[117]。

如果不服裁定的一方上訴，則 CAFC 會「重新」（de novo）審查地方法院的「簡易判決」[118]。CAFC 會檢驗地方法院所持有的證據，而以一種有利於上訴人的角度，來看是否沒有一組有理性的陪審團會做出有利於上訴人的決定[119]。

（二）民事訴訟部分二：陪審團作為事實發現者

CAFC 會審查陪審團的事實發現的前提是，當事人在陪審團聽完當事人所提出的證據後，於陪審團做出決定的之前和之後，必須

overturned in the absence of a definite and firm conviction that a mistake has been made.").

116 *See* Revolution Eyewear, Inc. v. Aspex Eyewear, Inc., 563 F.3d 1358, 1365 (Fed. Cir. 2009)("Summary judgment is appropriate when there is no genuine issue of material fact and the moving party is entitled to judgment as a matter of law.").

117 *See id.* at 1366.

118 *See id.* at 1365 ("We review a district court's grant of summary judgment de novo.").

119 *See* Ethicon Endo-Surgery, Inc. v. U.S. Surgical Corp., 149 F.3d 1309, 1315 (Fed. Cir. 1998)("[S]ummary judgment may be granted when no 'reasonable jury could return a verdict for the nonmoving party.' In deciding whether summary judgment was appropriate, we view the evidence in a light most favorable to the party opposing the motion with doubts resolved in favor of the opponent, which in this case is Ethicon." (internal citation omitted)).

要向法官聲請將本案視為法律問題而對本案「依法判決」(judgment as a matter of law，JMOL)[120]。

一旦事實發現者是陪審團，則 CAFC 會以「實在的證據」(substantial evidence）基準[121]。此時，JMOL 聲請人（即挑戰陪審團的事實發現的一方）必須要證明，在考慮所有的證據之後，以有利於「非 JMOL 聲請人」的角度，且由「非 JMOL 聲請人」的利益出發來考慮事實推論的合理性，卻無法得出有「足夠的證據」(sufficient evidence）可以支持陪審團對於「非 JMOL 聲請人」有利的裁判[122]。

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[120] *See* Unitherm Food Systems, Inc. v. Swift-Eckrich, Inc., 546 U.S. 394, 396 (2006)("Ordinarily, a party in a civil jury trial that believes the evidence is legally insufficient to support an adverse jury verdict will seek a judgment as a matter of law by filing a motion pursuant to Federal Rule of Civil Procedure 50(a) before submission of the case to the jury, and then (if the Rule 50(a) motion is not granted and the jury subsequently decides against that party) a motion pursuant to Rule 50(b). In this case, however, the respondent filed a Rule 50(a) motion before the verdict, but did not file a Rule 50(b) motion after the verdict. Nor did respondent request a new trial under Rule 59. The Court of Appeals nevertheless proceeded to review the sufficiency of the evidence and, upon a finding that the evidence was insufficient, remanded the case for a new trial. Because our cases addressing the requirements of Rule 50 compel a contrary result, we reverse.").

[121] *See e.g.*, *Koito Mfg. Co.*, 381 F.3d at 1149 ("Anticipation is a factual determination that is reviewed for substantial evidence when decided by a jury."); Minnesota Min. & Mfg. Co. v. Chemque, Inc., 303 F.3d 1294, 1305 (Fed. Cir. 2002)("To reverse the district court's denial of the judgment as a matter of law, this court would have to find that the jury verdict of anticipation is not supported by substantial evidence.").

[122] *Minnesota Min. & Mfg. Co.*, 303 F.3d 1294 at 1300 ("When reviewing a district court's denial of JMOL following a jury verdict, the court must []determine whether 'viewing the evidence in the light most favorable to the non-moving party,' and giving the non-movant 'the benefit of all reasonable inferences,' there is sufficient evidence of record to support a jury verdict in favor of the non-movant.").

（三）行政訴訟部分

對於行政機關的事實發現，CAFC 採用「實在的證據」基準[123]。也就是，CAFC 會以一個具有合理的心智的人的角度，來看相關的證據是否能適當地支持行政機關對於事實發現的結論[124]。值得注意的是，因為審查行政處分所用的「實在的證據」基準和審查陪審團的事實發現時所用的「實在的證據」基準，在規範內容上是有差異的，所以在相同的證據下，CAFC 對於 USPTO 和陪審團的事實發現是會給予不同的審查基準。

陸、當民事訴訟和行政訴訟的專利有效性問題匯流在 CAFC

一、專利有效性的爭端處理平台

專利權人是不會認為系爭專利的有效性是有問題的，所以專利侵權人才會有選擇何種爭端處理平台來處理專利有效性問題的主動權。一方面，侵權人可以等著專利權人提起民事訴訟，而後在專利侵權訴訟中處理專利有效性的問題；或者，如果專利權人向 ITC 申請禁止侵權物進口時，侵權人可在 ITC 程序中處理專利有效性問題。另一方面，侵權人也可以發動民事訴訟，提出「確認之訴」來要求法院處理專利有效性問題；或者，侵權人可向 USPTO 申請「

[123] *See e.g.*, In re Fallaux, 564 F.3d 1313, 1316 (Fed. Cir. 2009)("We review the Board's factual findings for substantial evidence."); Gemstar-TV Guide Intern., Inc. v. Int'l Trade Com'n, 383 F.3d 1352, 1360 (Fed. Cir. 2004)("[I]n an appeal from the ITC, factual findings are reviewed for substantial evidence pursuant to the Administrative Procedures Act, 5 U.S.C. 706(2)(E).").

[124] *See* Kinik Co. v. Int'l Trade Com'n., 362 F.3d 1359, 1361 (Fed. Cir. 2004)("Substantial evidence is 'such relevant evidence as a reasonable mind might accept as adequate to support a conclusion.'").

再審查」。

（一）平台的選擇：地方法院 v. USPTO

在專利侵權民事訴訟中，被告（專利侵權人）可以根據涉及專利有效性問題的四個條文，35 U.S.C. §§ 101, 102, 103 & 112，來攻擊系爭專利。這些工具是比在「再審查」程序中可使用的工具還多。

根據 35 U.S.C. § 301，可用來做為「再審查」的證據是美國專利或是公開發表的刊物[125]。但在民事訴訟中，證據類型可以是美國專利、公開發表的刊物、證人證詞、或專家證人證詞。

在 USPTO 的「再審查」程序中，被告不可能提出證據來主張 35 U.S.C. § 112 的爭點，因為這些爭點的證據可能要透過「證據調查」（discovery）程序來挖掘出。例如，「最佳實施例」或「先發明」的證據必須要從詢問發明人的過程中取得。此外，關於 35 U.S.C. § 103 的爭點，被告可以在民事訴訟中提出專家證人的證詞來證明引證案間是可組合的，但其在「再審查」程序中卻無法提出同樣的證據。因此，如果被告對於系爭專利的有效性問題是握有相當多元的證據類型時，地方法院或許會是比較有利的平台。

不過，選擇 USPTO 做為平台的好處是，一旦 USPTO 撤銷專利權，當案件上訴至 CAFC 時，CAFC 會採取對於 USPTO 的決定比較尊重的作法，而維持 USPTO 的撤銷專利的處分。然而，如果被告所處的平台是聯邦地方法院，一旦地方法院判專利權無效而後案件上訴至 CAFC 時，雖然 CAFC 對地方法院的審查是比對 USPTO

[125] *See* Canady v. Erbe Elektromedizin GmbH, 271 F.Supp.2d 64, 68 (D.D.C. 2002).

的審查來的嚴格，但是 CAFC 仍可能會維持地方法院宣告專利權無效的判決。畢竟在地方法院的訴訟過程中所發展的證據會更完整。

相反地，如果 USPTO 做出系爭專利具有可專利性的處分，而當案件上訴至 CAFC 時，CAFC 有可能會維持。但當地方法院維持了系爭專利的有效性時，CAFC 有可能會因為證據力的問題而撤銷原判決。畢竟在審查所有證據之後，雖然法官以 JMOL 裁定來宣告系爭專利是無效的，CAFC 仍有可能會同意陪審團所發現的事實，因而廢棄了地方法院法官的 JMOL 裁定。

因此，儘管被告可能同時在民事和行政訴訟中主張系爭專利的無效問題，若案件上訴至 CAFC，會有什麼結果？如果不是 CAFC 公布它的答案，其實也不會有非常確定的預測可以得知。

（二）ITC 平台

相對於其他平台，專利侵權人在 ITC 平台應該是處於最有利的位置，但這不是專利侵權人可主動選擇的平台。在 ITC 程序中，被控侵權人可以主張在專利侵權民事訴訟中所有的有效性抗辯[126]。ITC 的程序規則是比照「聯邦民事訴訟規則」（Federal Rules of Civil Procedure），而當事人可以進行「證據調查」（discovery）程序來爭辯系爭專利的有效性問題[127]。

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[126] *See e.g.*, Kaken Pharmaceutical Co. v. U.S. Int'l Trade Com'n, 1997 WL 152065 at 1 (Fed. Cir. 1997)(best mode); Gemstar-TV Guide Intern., Inc. v. Int'l Trade Com'n, 383 F.3d 1352, 1360 (Fed. Cir. 2004)(inventorship); Yingbin-Nature (Guangdong) Wood Industry Co., Ltd. v. Int'l Trade Com'n, 535 F.3d 1322, 1334 (Fed. Cir. 2008)(written description).

[127] *See* David L. Schwartz, *Courting Specialization: An Empirical Study of Claim*

不過，由於 ITC 只能針對進口物品有管轄權，而且 ITC 並無法給與損害賠償的救濟，故專利權人仍可能會同時在 ITC 和地方法院提起爭訟[128]。儘管同時有二類訴訟進行中，也不代表 CAFC 會同時面對相同當事人和相同爭點與事實的上訴案件。

在 U.S. Philips 公司和台灣巨擘科技公司（Princo Corp.）之間的「可讀寫光碟」（CD-RWs）的專利侵權事件中，U.S. Philips 公司（專利權人）分別在地方法院和 ITC 對巨擘科技公司提起爭訟。ITC 在 2004 年 3 月 25 日做出不利於專利權人的行政處分[129]。地方法院在 2005 年 2 月 2 日宣判[130]。此兩件的爭點都是「專利權濫用」（patent misuse）[131]。

CAFC 先於 2004 年 5 月 7 日收到由 ITC 上訴的案件，並在 2005 年 9 月 21 日宣判（Philips I 判決）[132]。CAFC 之後在 2005 年 5 月 16 日收到由地方法院上訴的案件，並在 2006 年 3 月 27 日根據 Philips I 判決而將地方法院判決廢棄並發回重審[133]。因此，儘管 CAFC 審查二類案件的時間是有重疊的，但也不表示其會將案件併案審查。

Construction Comparing Patent Litigation before Federal District Courts and the International Trade Commission, 50 WM. & MARY L. REV. 1699, 1709-11 (2009).

128 例如 U.S. Philips 公司和 Princo 公司之間的「可讀寫光碟（CD-RWs）」的專利侵權事件。*See e.g.*, U.S. Philips Corp. v. Int'l Trade Com'n, 424 F.3d 1179 (Fed. Cir. 2005)("Philips I"); U.S. Philips Corp. v. Princo Corp., 173 Fed. App'x 832 (Fed. Cir. 2006) ("Philips II"); In re Princo Corp., 478 F.3d 1345 (Fed. Cir. 2007); Princo Corp. v. Int'l Trade Com'n, 563 F.3d 1301 (Fed. Cir. 2009).

129 *See Philips I*, 424 F.3d at 1182.

130 *See* U.S. Philips Corp. v. Princo Corp., 361 F.Supp.2d 168, 168 (S.D.N.Y. 2005).

131 *See Philips II*, 173 Fed. App'x at 833.

132 *See Philips I*, 424 F.3d at 1179.

133 *See Philips II*, 173 Fed. App'x at 832-33.

二、「再審查」程序和民事訴訟的停止

當和系爭專利有關的專利侵權民事訴訟和 35 U.S.C. § 311 類的「再審查」程序同時進行時，二類案件也不一定有機會共同在 CAFC 進行上訴審的審查。根據 35 U.S.C. § 318，專利權人可以向民事訴訟所繫屬的地方法院聲請停止訴訟，且這是屬於專利權人的權利[134]。此外，地方法院法官原本就有權力依當事人的聲請而裁定停止訴訟[135]。因此，一旦地方法院決定停止訴訟，則 CAFC 同時處理由 USPTO 和地方法院的上訴案件的機會又更小。

三、不同的請求項解釋方法

「再審查」程序中和民事訴訟程序中的請求項解釋方法是不一樣的。在「再審查」程序中，USPTO 採取的解釋方法是比照系爭專利在專利申請狀態中的解釋方式[136]。亦即，應該根據專利說明書的內容來合理地給與請求項最廣的解釋[137]。反觀民事訴訟過程中的

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[134] 35 U.S.C. § 318 provides, "Once an order for inter partes reexamination of a patent has been issued under section 313, the patent owner may obtain a stay of any pending litigation which involves an issue of patentability of any claims of the patent which are the subject of the inter partes reexamination order, unless the court before which such litigation is pending determines that a stay would not serve the interests of justice."

[135] *See e.g.*, *Procter & Gamble Co.*, 549 F.3d at 849; Bausch & Lomb Inc. v. Rexall Sundown, Inc., 554 F.Supp.2d 386, 389 (W.D.N.Y. 2008)("Although the commencement of reexamination proceedings does not operate as an automatic stay of federal court litigation involving identical claims, a district court retains the authority, pursuant to its inherent power to control and manage its docket, to stay an action pending the outcome of reexamination proceedings before the PTO.").

[136] *See* In re Yamamoto, 740 F.2d 1569, 1571-72 (Fed. Cir. 1984).

[137] *See id.* at 1571 ("We affirm the board's decision to give claims their broadest reasonable interpretation, consistent with the specification, in reexamination proceedings.").

請求項解釋方法，法官可能要參考專利申請過程中的歷史紀錄、字典等資料，因而無法給予請求項較廣的解釋[138]。

此外，地方法院的請求項解釋對 USPTO 可能是沒有拘束力的[139]，因而使得 CAFC 儘管同時處理二類案件，CAFC 也會因為請求項解釋的差異而無法站在同一個基準點上來進行判斷。因此，若案件的爭點之一是請求項解釋，則 CAFC 應該不會將二類案件來併案處理。

四、相同證據下的專利有效性問題審查

假設系爭專利法事件的專利有效性爭點只有針對以專利或公開發表的刊物為證據的 35 U.S.C. §§ 102 & 103 的爭點。如果 CAFC 併案審查民事訴訟的上訴案和「再審查」程序的上訴案，可能的審理模式是先審理 USPTO 的處分，而若系爭專利維持有效，則再繼續審查地方法院的判決。理由說明如下。

（一）請求項解釋為爭點之一

通常二類案件的爭點都會包括請求項解釋。由於「再審查」程序所涉及的請求項解釋會使得請求項範圍較廣，而面對範圍較大的

[138] *See* Phillips v. AWH Corp., 415 F.3d 1303, 1317 (Fed. Cir. 2005)(en banc)("Although we have emphasized the importance of intrinsic evidence in claim construction, we have also authorized district courts to rely on extrinsic evidence, which 'consists of all evidence external to the patent and prosecution history, including expert and inventor testimony, dictionaries, and learned treatises.'").

[139] *See* In re Trans Texas Holdings Corp., 498 F.3d 1290, 1297 (Fed. Cir. 2007)("However, the PTO was not even a party to the earlier district court litigation and cannot be bound by its outcome.").

請求項，判斷其是否具有可專利性是相對而言比較容易的。再者，法院對於系爭專利的有效性認定是不會拘束後來的 USPTO 對系爭專利的無效性認定[140]。

因此，先審查 USPTO 的處分是比較有經濟效益的，因為一旦維持 USPTO 的撤銷專利處分，則 CAFC 不須要再處理地方法院的判決。

（二）僅有事實問題的爭點

如果爭點只有事實問題，因為 CAFC 對於 USPTO 的事實認定是採取比較寬鬆的審查[141]，所以 CAFC 應該會先討論 USPTO 的處分。而一旦 CAFC 認為有「實在的證據」支持 USPTO 的事實發現，則其將會維持 USPTO 的撤銷專利處分。

柒、結論

在美國專利訴訟制度中，當事人主要可以選擇聯邦地方法院、USPTO 和 ITC 來做為爭端處理平台，以解決關於系爭專利有效性

[140] *See Swanson*, 540 F.3d 1368 at 1378 ("We agree with the PTO's current position. Section 303's language and legislative history, as well as the differences between the two proceedings, lead us to conclude that Congress did not intend a prior court judgment upholding the validity of a claim to prevent the PTO from finding a substantial new question of validity regarding an issue that has never been considered by the PTO.").

[141] *See* Dickinson v. Zurko, 527 U.S. 150, 162 (1999)("This Court has described the APA court/agency 'substantial evidence' standard as requiring a court to ask whether a 'reasonable mind might accept' a particular evidentiary record as 'adequate to support a conclusion.' ... It has described the court/court 'clearly erroneous' standard in terms of whether a reviewing judge has a 'definite and firm conviction' that an error has been committed. ... And it has suggested that the former is somewhat less strict than the latter.").

的問題。基於 CAFC 對於此三類機構的審查基準和證據調查制度等二個因素的考慮，各平台對被告（專利侵權人）是有利也有弊。

如果當事人同時在地方法院和 USPTO 中處理系爭專利的有效性問題，則地方法院有可能會裁定停止訴訟，而先等待「再審查」程序的最終結果。因此，CAFC 幾乎不可能同時會受理關於同一專利的民事訴訟案件和行政訴訟案件的上訴審。

儘管 CAFC 同時處理該二類案件，其併案審理的機會也比較低，因為二類案件中的請求項解釋方法不同，CAFC 無法在相同的基礎上同時審查二類案件。不過，如果 CAFC 將二類案件併案處理，則可預見的審查模式是 CAFC 會先審查 USPTO 的處分，因為這樣的模式是比較經濟的。