

淺談美國專利分擔侵權理論

王碩汶*

摘要

專利制度賦予專利權人於法定期間內享有排他權，當專利權受到侵害，專利權人基於國家所賦予的請求權基礎，行使專利的排他權，向侵權行為人請求損害賠償且禁止其侵害。雖然專利制度所創設的權利類型可以滿足過去科技發展下的產物，但近來卻發現，有越來越多的方法專利權人排除侵害時，因複數行為人採行接續地實施或分擔地實施專利之發明，而非傳統單一行為人或複數行為人共同完成整個侵權行為，進而將該複數行為人帶離於侵權判斷的構成要件之外，以致形成法規範漏洞，申言之，當專利權人對抗的複數侵權行為人時，即便方法專利權利範圍的所有實施步驟已由複數行為人分擔實施，但專利權人尚難對此類行為主張侵權責任。因此，本文擬探討此種接續型態的分擔侵權理論的特徵，並藉由近年美國聯邦巡迴上訴法院實務案例，說明分擔侵權理論的法律效果與該院見解的轉變，最後，擬提供粗淺的意見或可作為申請人或專利代理人申請美國專利或進行訴訟時之參考。

關鍵字：Divided Infringement Theory、Jointly Infringement、Direction or Control、分擔侵權理論、分擔侵權、分離式侵權、分別侵權、指導或控制關係、常規交易關係、共同侵權

* 作者為企業內專利工程師（in-house patent engineer），感謝經濟部智慧財產局智慧財產權月刊編輯審查委員惠賜寶貴修正意見。

壹、前言

隨著科技的發展，揆諸各國專利制度所創設的權利類型，也隨著科技而有多樣化的發展。為能有效保護與鼓勵創作發明，專利制度不僅創設權利，亦確保權利的行使，維護專利權人免受侵害，保障其財產安全，例如於專利權利受到侵害時，得依法向侵害其權利之人請求損害賠償，專利制度藉此鼓勵發明人創作發明與技術揭露，達成提昇國內產業技術水準的立法目的¹。

當專利權人欲行使其專利權時，依據一般專利實務，概可區分為兩個主要部分，一為解讀專利權利範圍，另一為檢測是否侵權²；其中，解讀權利範圍的法律問題（question of law）³，而專利權利範圍概以權利項（claims）作為唯一的解釋標的，專利說明書僅為字義導引效果⁴；若有目的性擴張（teleologische Extension）或限縮（teleologische Reduktion）的

¹ Bonito Boats, Inc. v. Thunder Craft Boats, Inc., 489 U.S. 141, 151 (1989) (“The ultimate goal of the patent system is to bring new designs and technologies into the public domain through disclosure.”)

² Markman v. Westview Instruments, Inc., 52 F.3d 967, 978 (Fed. Cir. 1995), aff’d, 517 U.S. 370 (1996) (“The two elements of a simple patent case, construing the patent and determining whether infringement occurred, were characterized by the former patent practitioner, Justice Curtis.”), available at <http://www.law.cornell.edu/supct/html/95-26.ZO.html>, last visited Jan 16, 2012.

³ *Id.* (“The first is a question of law, to be determined by the court, construing the letters-patent, and the description of the invention and specification of claim annexed to them. The second is a question of fact, to be submitted to a jury.”)

⁴ Bell Atlantic Network Services, Inc. v. Covad Communications Group, Inc., 262 F.3d 1258, 1268-69, 1271 (Fed. Cir. 2001) (“the written description can provide guidance as to the meaning of the claims, thereby dictating the manner in which the claims are to be construed, even if the guidance is not provided in explicit definitional format.”) (quoting *SciMed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc.*, 242 F.3d 1337, 1344 (Fed. Cir. 2001)), available at <http://www.ll.georgetown.edu/federal/judicial/fed/opinions/00opinions/00-1475.html>, last visited Jan 16, 2012.

法學解釋方法，或依先前判決之先例（precedent）調整權利範圍，則應依各國所採行的解釋途徑為之，嗣後，經由物或方法的權利項所界定的權利範圍，再與侵權之物或方法逐一比對，判斷其是否讀取於範圍之內，若是，則該物或方法之實施構成侵權。

惟近年來有案例指出，前揭方法的侵權判斷已不再適用現今侵權行為態樣的多樣化，例如一專利發明的實施步驟，係由複數行為人採行接續地或分擔地型態所完成的實施（performance）行為，則此情況下，因不同於過去專利法上單一或複數的侵權行為個體，專利權人無法依循直接侵權（direct infringement）行為類型或間接侵權（indirect infringement）行為類型等管道進行主張，即便該等侵權行為已滿足所有判斷要件而構成侵害事實，卻因其侵權行為係由接續地實施或分擔地實施該方法步驟，而逸離於任何種類的損害賠償請求權基礎射程之內，此況似乎值得國內實務稍加理解。

貳、分擔侵權理論（divided infringement theory）⁵的特徵

專利法的制度設計，通常僅是處理單一侵權行為人的情況，但現今

⁵ 作者並非自創學說，僅為傳遞原意擬將 divided infringement 譯為『分擔侵權』，理由在於分擔的字義本身即隱含兩人或多人個別承擔部分工作或完成部分事情的意思；因此，分擔侵權的意思係指兩個或兩個以上的行為人，彼此分擔某部分的侵權行為，藉由兩者或多者的分擔行為總和，構成一個完整的侵權行為；另國內亦有先進將 divided infringement 譯為『分離式侵權』（<http://stlc.iii.org.tw/docfile/d8722caa-2b6d-4e9f-b0b0-11b332b291d625596130crbq55iz0nla55jhns2p55.pdf>，網頁瀏覽日 2012 年 1 月 16 日）或『分別侵權』（http://www.google.com/url?q=http://www.apipa.org.tw/down_class_book_con.php%3Fid%3D126&sa=U&ei=-ocLT9SyBc-aiAf9djxBQ&ved=0CCEQFjAC&usg=AFQjCNFBi0GVIV3kH3dJneE7n493GxUqdA，網頁瀏覽日 2012 年 1 月 16 日）。

商業的發展已跨越一國的領域與過去企業型態，尤其是電腦網路科技的技術使然，若依屬地性（territorial）⁶的專利司法制度追訴單一侵權行為人，已難以面對多國的複數行為人的接續協力侵權行為的情況，例如在撰寫專利時，必將遭遇跨國司法管轄與複數協力行為人的難題⁷，專利代理人似有必要理解分擔侵權理論的相關特徵並加以克服。

一、由複數行為人分擔侵權行為

分擔侵權本屬直接侵權分支的一種侵權責任類型，主要係由兩個或多數的行為主體分擔的實施專利發明，此種類型有別於傳統上由單一或複數行為人實施完整專利步驟的侵權行為⁸，因此，分擔侵權理論則係基於該侵權行為相關判決所發展而成的一種理論，且特別是以電腦網路相關的方法發明專利爭議案件為首要，因為要構成方法專利之侵權，則必須要有單一的行為人或複數的共同行為人實施所有方法專利之步驟⁹，而電腦網路相關的方法發明專利有時正是需要透過他人接續實施。

⁶ See, e.g., *Dowagiac Mfg. Co. v. Minn. Moline Plow Co.*, 235 U.S. 641, 650 (1915) (“The right conferred by a patent under our law is confined to the United States and its territories, and infringement of this right cannot be predicated on acts wholly done in a foreign country.”); *Brown v. Duchesne*, 60 U.S. 183, 195 (1856) (“U.S. patent laws do not, and were not intended to, operate beyond the limits of the United States.”).

⁷ Mark A. Lemley, *Inducing Patent Infringement*, 39 U.C.D.L. REV. 225, 226 (2005), available at http://papers.ssrn.com/sol3/Delivery.cfm/SSRN_ID772264_code603.pdf?abstractid=772264&mirid=1, last visited Jan 16, 2012.

⁸ Edward Van Gieson, *Divided patent infringement and patent valuation*, (“Divided infringement liability is a special subset of direct liability. Traditionally, in order to infringe a patented process, a single party must practise each step of the claim. Divided infringement occurs when two or more different parties are required to infringe the claims of a patent.”), available at <http://www.beyerlaw.com/pdf/Feature%207.pdf>, last visited Jan 16, 2012.

⁹ *Joy Techs., Inc. v. Flakt, Inc.*, 6 F.3d 770, 773 (Fed. Cir. 1993) (“For process patent or method patent claims, infringement occurs when a party performs all of the steps of the process.”).

承上所述，分擔侵權的特徵係由複數的行為人，各自分擔部分的實施步驟而完成一個完整的侵權行為，但任何一位侵權行為人皆不必承擔侵害專利之損害賠償責任，主要理由係因沒有一位行為人有完整實施專利發明。舉例而言，某一方法發明專利，主要由步驟一至步驟五所構成，雖然每一項步驟拆解來看時皆為先前技術，但可專利性的判斷係採整體觀之（as a whole）¹⁰，於是前揭步驟一至五將依法取得專利權，若某甲實施步驟一至步驟五，將可能構成侵權，但分擔侵權的概念是某甲實施步驟一至三，某乙接續實施步驟四至五，該甲或乙皆可主張實施先前技術（practicing the prior art）¹¹。

二、分擔實施專利步驟的侵權判斷

在分擔實施專利步驟的情況下，雖然沒有一位行為人完整實施該專利步驟，或者行為人於實施時省略了某些專利步驟，使得專利權人無法對抗任何一位不完全實施的行為人¹²，但依據美國法院過去的判例，仍會有兩種方式判斷侵權與否，其一，判斷複數行為人間是否具有指導或控制關係，其二，判斷是否構成均等理論下之侵害。

¹⁰ *Diamond v. Diehr* 450 U.S. 175 (1981) (“In determining the eligibility of respondents' claimed process for patent protection under 101, their claims must be considered as a whole.”)

¹¹ *Yoches, E. Robert, Designing Around Patents*. (“Another way to avoid infringement is to practice the prior art. A patent claim that covers the prior art is invalid, so practicing the prior art will prevent interpreting a claim to be both valid and infringed.”)

¹² See, e. g., *Engelhard Industries, Inc. v. Research Instrumental Corp.*, 324 F.2d 347, 351 (9th Cir. 1963), *Cert. denied*, 377 U.S. 923, 84 S.Ct. 1220, 12 L.Ed.2d 215 (1964); *Great Lakes Carbon Corp. v. Continental Oil Co.*, 219 F.Supp. 468, 475 (W.D.La.1963), *Aff'd per curiam*, 345 F.2d 175 (5th Cir.), *Cert. denied*, 382 U.S. 905, 86 S.Ct. 241, 15 L.Ed.2d 158 (1965) (“A patent is not infringed where any of the steps which constitute the patented method or process is omitted.”)

（一）判斷複數行為人間是否具有指導或控制關係

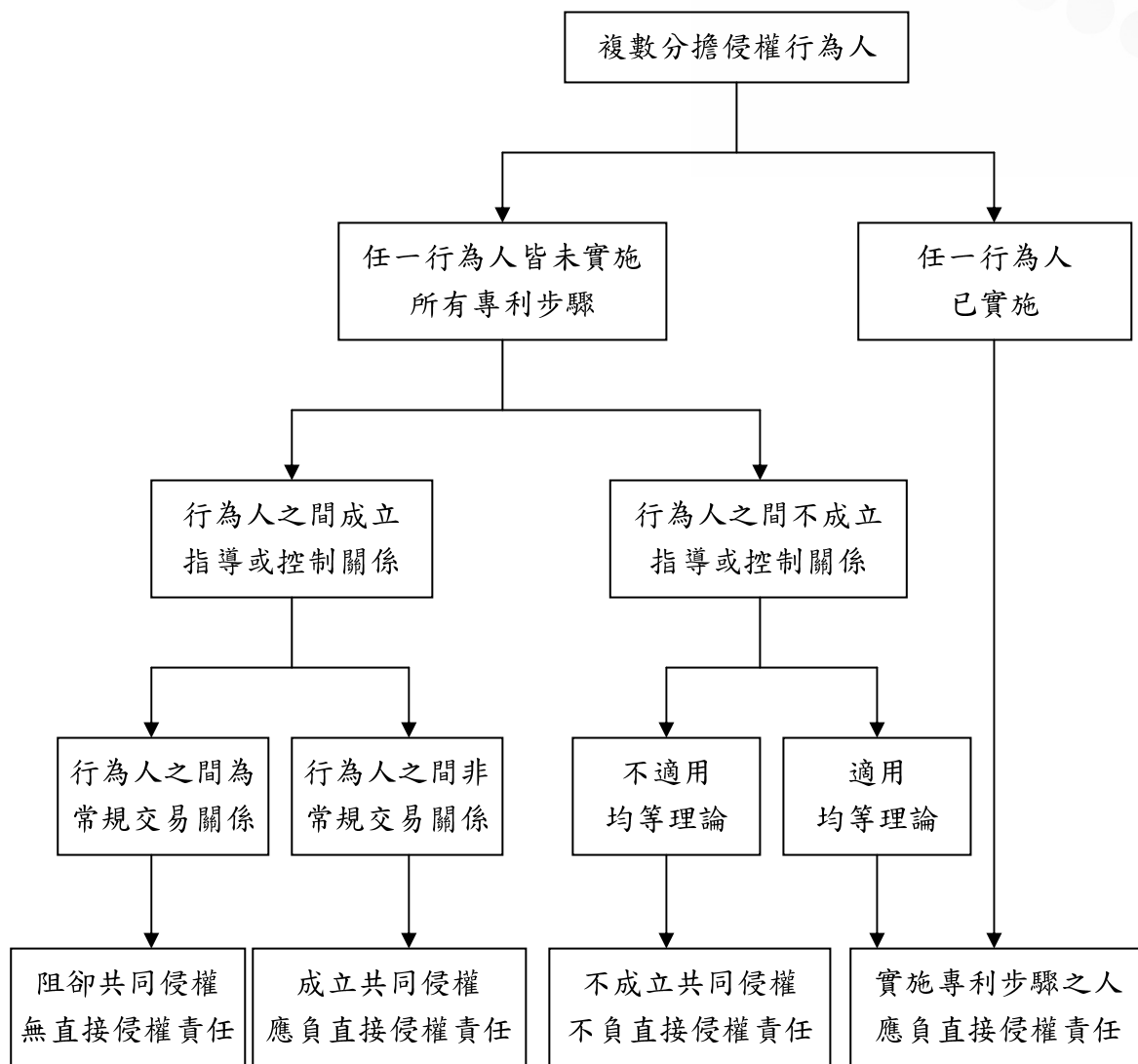
在過去美國法院的判例上，只要有任何一方藉由合意（contracting）控制另一方去實施所有專利製程步驟者，則該控制他人去實施專利製程步驟之人將構成直接侵權¹³，除非雙方間被法院判定為常規交易（arms-length agreements）關係所致，否則控制方與被控制方兩者將成立共同侵權（jointly infringement）行為，雙方皆負直接侵權責任。

（二）判斷是否構成均等理論下之侵害

分擔侵權理論的特徵之一即在於無一方完整的實施該方法專利步驟，換句話說，即便部分的方法專利步驟未被一行為人所實施、或被行為人所置換，法院仍可進入均等理論（doctrine of equivalents）的標準進行判斷，探討系爭專利與任一被控侵權者間之結構的設計、操作的模式與產生的結果是否實質相同（substantially identical）¹⁴，因此，方法專利步驟經置換後，仍有被推導為侵權的可能。

¹³ BMC Resources Inc. v. Paymentech LP, 84 U.S.P.Q.2d 1545 (Fed. Cir. 2007) (“A party cannot avoid infringement, however, simply by contracting out steps of a patented process to another entity. In those cases, the party in control would be liable for direct infringement.”), <http://www.ll.georgetown.edu/federal/judicial/fed/opinions/06opinions/06-1503.pdf>, last visited Jan 16, 2012.

¹⁴ American Seating Co. v. Southeastern Metals Co., 412 F.2d 756. (“It is well settled that infringement exists only where the accused device and the teachings of the patent in suit are substantially identical in structure, mode of operation, and results accomplished.”)



資料來源：本文整理

圖一 分擔侵權的違法性判斷

三、分擔侵權似無適用間接侵權的空間

依據現行美國專利法規定，專利侵權類型概可區分為直接侵權¹⁵與間接侵權，其中的間接侵權又分成誘使侵權（induced infringement）¹⁶與輔助侵權（contributory infringement）¹⁷兩種，但目前分擔侵權理論的發展，似尚未有案例適用間接侵權的情況，而僅得主張第 271 條 a 項的直接侵權責任，以下本文擬探討之，以供專利代理人至美國申請專利或訴訟之建議。

（一）主張直接侵權責任

首先，美國專利法第 271 條 a 項的直接侵權係為一種嚴格責任的主張（strict-liability offense）¹⁸，該項之主張雖然被限制於任何已實施所有發明專利之步驟或構成元件進而侵害專利權利之人，且因分擔侵權的行為人，彼此之間已滿足指導或控制之要件

¹⁵ 35 U.S.C. §271(a) (“Except as otherwise provided in this title, whoever without authority makes, uses, offers to sell, or sells any patented invention, within the United States, or imports into the United States any patented invention during the term of the patent therefor, infringes the patent.”).

¹⁶ 35 U.S.C. §271(b) (“Whoever actively induces infringement of a patent shall be liable as an infringer.”).

¹⁷ 35 U.S.C. §271(c) (“Whoever offers to sell or sells within the United States or imports into the United States a component of a patented machine, manufacture, combination, or composition, or a material or apparatus for use in practicing a patented process, constituting a material part of the invention, knowing the same to be especially made or especially adapted for use in an infringement of such patent, and not a staple article or commodity of commerce suitable for substantial noninfringing use, shall be liable as a contributory infringer.”).

¹⁸ In re Seagate Tech., LLC, No. 830, 2007 U.S. App. LEXIS 19768, at *12 (Fed. Cir. Aug. 20, 2007) (en banc) (“Because patent infringement is a strict liability offense, the nature of the offense is only relevant in determining whether enhanced damages are warranted.”); Hilton Davis Chem. Co. v. Warner-Jenkinson Co., 62 F.3d 1512, 1523 (Fed. Cir. 1995) (en banc) (per curiam) (“Accidental or ‘innocent’ infringement is still infringement.”), rev’d on other grounds, 520 U.S. 17 (1997).

而成立共同侵權者，專利權人當可依循直接侵權責任進行主張。

（二）似無法主張誘使侵權責任

其次，同法第 271 條 b 項的間接侵權責任，則要求行為人須具備具體的意圖（specific intent）¹⁹誘使他人侵權，且同條 a 項的直接侵權為第 b 項構成前提，在此，有學者認為該 b 項係誘使他人侵權之人的延伸責任（extends liability）²⁰，但反觀在分擔侵權的情況，其係由一方分擔部分的侵權行為，再由另一方分擔剩餘部分的侵權行為，任一人皆無完整實施的情況下，專利權人似無主張任一方具備具體的意圖誘使他人實施一個完整專利步驟而構成侵權行為，申言之，即便一方誘使他人實施部分的專利步驟，此況亦無成立誘使侵權之可能。

（三）亦無類推適用物的輔助侵權責任

最後，則為第二種間接侵權之輔助侵權行為，其係規定於同法第 271 條 c 項，該項係要求行為人必須具備違法的犯意（mens rea）²¹，且該項之適用係以零件或材料之銷售將無實質非侵權之用途（without substantial non-infringing uses）者為限²²，從字義觀之，該項僅適用於零件或材料等物，似無法類推至方法步驟，再

¹⁹ BMC Resources, *supra* note 13, at page 12. (“indirect liability requires evidence of “specific intent” to induce infringement.”)

²⁰ Mark A. Lemley, *supra* note 7. (While §271(a) of the Patent Act creates liability for someone who directly infringes a patent, §271(b) of the act “extends liability to one who actively induces infringement by another.”).

²¹ See general *Developments In The Mens Rea of Inducement of Patent Infringement*, available at <http://www.mkgip.com/node/698>, last visited Jan 16, 2012.

²² 35 U.S.C. §271(c), *supra* note 17.

者，若方法製程專利的實施步驟拆解來看，皆已是先前技術，則專利權人亦無對抗他人實施先前技術之餘地。因此，雖然物的專利，可以用有無實質非侵權之用途來認定「部分的零件或材料」是否構成輔助侵權，但在方法製程步驟的概念上，難以主張「部分的實施步驟」構成輔助侵權，因為「部分的實施步驟」之違法性已受先前技術所阻卻。

參、近期聯邦巡迴上訴法院與國際貿易委員會的實際案例

為求得理解分擔侵權的實務發展，本文體擬列舉近期聯邦巡迴上訴法院與國際貿易委員會的實際案例作為探討如下。

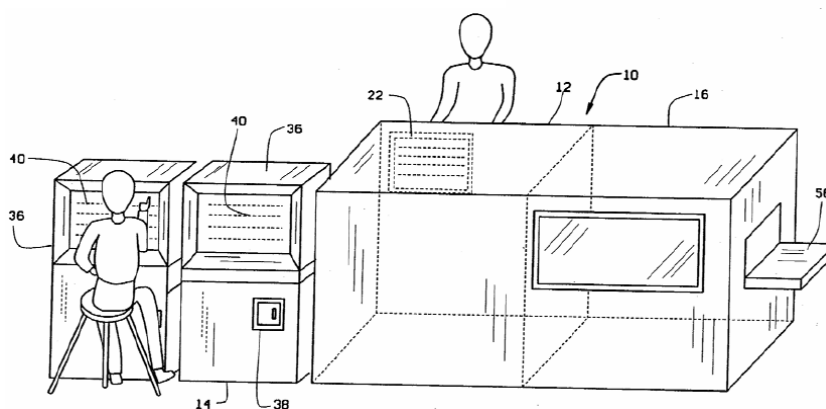
一、*On Demand v. Ingram*²³ 案

（一）案例背景

本案專利為一種書籍印製系統，包含：一存儲資料之電腦裝置，該資料係對應於複數關聯書籍的文字與資訊，該書籍得為該電腦可檢索之格式；一與該電腦裝置相通訊之選擇裝置，得選擇性的檢索該書籍的資料；一高速的文字印製裝置，於選定書籍與頁數後，由該選擇裝置傳遞一訊號與指令給該電腦裝置；該格式係藉由一定址顏色格式而描述該書籍的封面，且其中該電腦裝置儲存並選擇性的檢索該複數書籍封面所對應的彩色圖形，以及一

²³ *On Demand Machine Corp. v. Ingram Industries, Inc.*, Nos. 05-1074, -1075, -1100 (Fed. Cir. 2006), available at <http://caselaw.findlaw.com/us-federal-circuit/1451352.html>, last visited Jan 16, 2012.

印製該書籍圖形封面之彩色印刷裝置，係藉由該書籍被選擇後，從該選擇裝置產生一訊號與指令後，印製於合適的封面材質上²⁴。



圖二 本案 5,465,213 專利示意圖

原告²⁵專利權人主張被告²⁶侵害其專利權，第一審法院認定被告侵權，被告應負侵權行為損害賠償²⁷。被告不服第一審法院判決，上訴至聯邦巡迴上訴法院。

²⁴ See Claim 1 of USPAT 5,465,213. ("a book manufacturing system comprising: computer means for storing data corresponding to the text of and information concerning a plurality of books in a format retrievable by said computer means; selection means in communication with said computer means for selectively retrieving stored data corresponding to each of such books; means for high speed printing of the text of a selected one of said books on paper pages upon a signal from said selection means and command from said computer means; said format describing the cover of the book in a bit mapped color format, and wherein said computer means stores and selectively retrieves data corresponding to the color graphics of the covers of said plurality of books, and color printer means for reproducing the cover graphics of said selected one of said books on suitable cover material upon a signal from said selection means and command from said computer means.")

²⁵ On Demand Machine Corporation.

²⁶ Ingram Industries, Inc., Lightning Source, Inc., and Amazon.com, Inc.

²⁷ On Demand Machine Corp. v. Ingram Indus., Inc., No. 4:01cv1668MLM (E.D. Mo. Oct. 28, 2004) (judgment); July 23, 2004 (order denying enhancement of damages); July 5, 2003 (claim construction order).

(二) 爭點

如圖二所示，本案原告專利發明的基本意涵，係由一客戶使用現場的電腦設備查看資訊，並於隨後啟動列印。雙方的爭點之一即在於被告所有實施的步驟，是否侵害原告的權利範圍²⁸。

(三) 法院見解

聯邦巡迴上訴法院認為，以原告專利權人所請求的權利範圍而言，其每一個實施步驟，若單獨來看都已是先前技術，但這些實施步驟經過組合以後始具可專利性之發明，基此，侵害該發明專利實施步驟也必定要完整的實施，始構成侵權。反觀本案被告，已將所有專利發明之步驟，加以分離到不同的主體間進行實施，被告自己本身所實施的步驟僅是實施先前技術，並無原告專利發明的所有實施步驟。²⁹因此，上訴法院採認被告的抗辯，被告並無完整實施原告的專利發明步驟，其中的印刷裝訂係由客戶與銷售者所實施³⁰。

²⁸ On Demand, *supra* note 23, (“However, the fundamental precept of the Ross invention is that the customer uses an on-site computer to view promotional information, and then initiates rapid single copy printing.”), available at <http://caselaw.findlaw.com/us-federal-circuit/1451352.html>, last visited Jan 16, 2012.

²⁹ *Id.* (“Each of these components of the claimed invention is in the prior art; their combination is the patentable invention, and it is the practice of the combination that is essential to infringement. Taken separately, Amazon’s method of taking orders for books is prior art; Amazon does not print books, and the immediate on-site printing of the Ross invention is absent.”)

³⁰ *Id.* (“The printing of a single copy of a book, using computer technology and high-speed printing, was prior art to the Ross patent. The defendants correctly point out that the Ross invention is the immediate printing and binding of a copy of a book, where the customer initiates this activity upon review of promotional information stored in a computer that is provided by the seller.”)

承上所述，因被告未完全實施所有的專利發明步驟，上訴法院推翻（reversed）一審陪審團所為之侵權成立的裁決，且判給原告損害賠償的部分亦同時被撤銷（vacated）³¹。

二、*BMC v. Paymentech*³²案

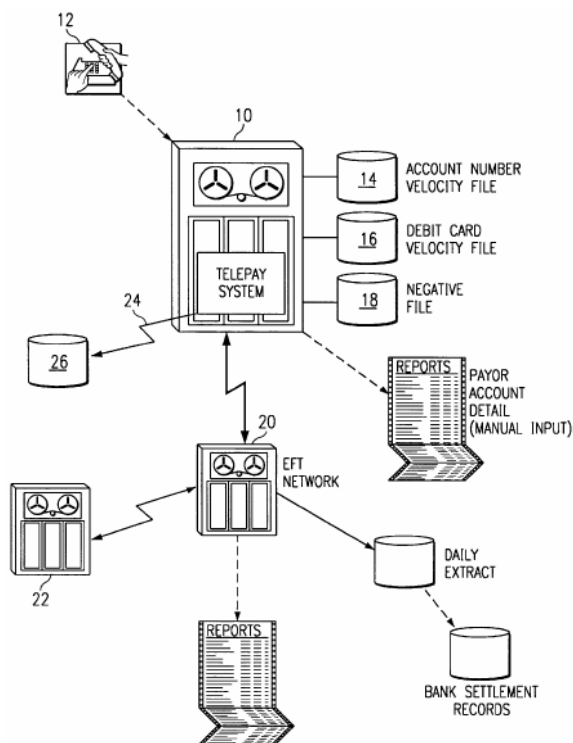
（一）案例背景

本案方法發明係為一種付款交易時使用信用卡號處理方法，且該方法不需個人識別碼，主要步驟係包含：提供一種電信支付系統（telepay system）介面，該介面銜接一標準按鍵電話與一信用卡網路，且得藉由電話按鍵之操作，即時地完成帳單付款交易；其中，該電信支付系統主要包含一語音答覆單元，得提示付款人輸入授權碼、帳號、信用卡號與付款總額，並通知該付款人相關交易狀態；本發明亦提供即時的信用卡網路交易處理，而不需透過票據交換所，且該電信支付系統亦得自動執行結算功能與查詢付款人的歷史交易³³。

³¹ *Id.*

³² *BMC, supra* note 13.

³³ See Abstract of USPAT 5,870,456. (“Method and apparatus for processing payment transactions using debit card numbers without the requirement of a personal identification number (PIN) is disclosed. A telepay system of the present invention provides an interface between a standard touchtone telephone and at least one debit card network such that real-time bill payment transactions may be effected using a keypad of the telephone. The telepay system includes an interactive voice response unit for prompting a payor to enter an access code, account number, debit card number and payment amount and for informing the user of the status of the transaction. Real-time processing of transactions is provided through use of debit card networks, rather than the Automated Clearing House. The telepay system is also capable of performing settlement functions and processing inquiries by payees of the system regarding previously processed transactions.”)



圖三 本案 5,870,456 專利示意圖

本案原告專利權人不服第一審法院判決被告未侵權的結果，上訴至聯邦巡迴上訴法院。

(二) 爭點

本案被告僅實施部分專利步驟，其餘步驟由第三人實施，但本案被告與第三人之間並無指導或控制（direction or control）關係³⁴，

³⁴ BMC, *supra* note 13, at page 14 (“The evidence before the magistrate and the district court to support direction or control of financial institutions by Paymentech was even scarcer. As the district court observed, the record contained no evidence even of a contractual relationship between Paymentech and the financial institutions.”).

如此是否構成侵害原告的方法專利。

（三）法院見解

上訴法院認為本案被告與財務機構、信用網路或付款服務業者之間並無指導或控制關係，被告亦無實施所有方法專利之實施步驟³⁵，因此，維持第一審判決被告未構成侵權。

三、*Akamai v. Limelight*³⁶案

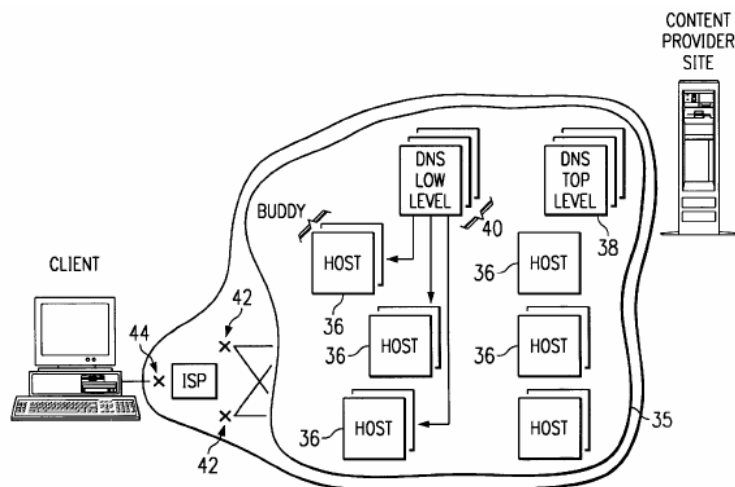
（一）案例背景

2006 年六月份原告專利權人於麻州地方法院控訴被告侵害其三件專利³⁷，經法院進行侵權審理，703 號專利的獨立項次第 19 與 34 以及附屬項次第 20 至 21，其中該兩項獨立項皆為一種於內容提供者的網頁上進行對一嵌入物件進行標記（tagging）之方法，該方法可解決內容提供者位於不同網域名稱的問題。本案經陪審團裁定後，判給原告並四千零一十萬所失利益與一百四十萬合理權利金等損害賠償數額，但陪審團的損害賠償裁定被法院的法律審理之判決（JMOL, judgment as a matter of law）所推翻。原告不服，上訴至聯邦巡迴上訴法院。

³⁵ *Id.* (“Without this direction or control of both the debit networks and the financial institutions, Paymentech did not perform or cause to be performed each and every element of the claims.”)

³⁶ *Akamai Technologies, Inc. v. Limelight Networks, Inc.* (Fed. Cir. 2010), available at www.cafc.uscourts.gov/images/stories/opinions-orders/09-1372.pdf, last visited Jan 16, 2012.

³⁷ 包含 6,108,703, 7,103,645, 與 6,553,413。



圖四 本案 6,108,703 專利示意圖

(二) 爭點

雙方所不爭的事實是被告並無實施系爭專利權利項之所有實施步驟，被告僅提供必要資訊予其客戶（同前揭內容提供者），藉此，該客戶得修正其網頁及網址資訊後使用被告的服務，然而該標記步驟係由該客戶所實施，如此被告是否構成侵權³⁸？再者，被告是否應負共同侵權責任。

(三) 法院見解

上訴法院認為，過去在判斷直接侵權時，必定是由某一單一

³⁸ Akamai Technologies, *supra* note 36, at page 8. (“It is undisputed that Limelight does not itself perform every step of the asserted claims. JMOL Opinion at 116. Limelight provides the information necessary for its customers, the content providers, to modify their web pages or Internet address routing information to use the Limelight service. However, the content providers perform the actual tagging step (emphasized above) themselves. There are two tagging methods used by Limelight’s customers.”)

個體實施所有發明專利步驟，此乃確立已久的原則³⁹，但反觀本案事實，卻是由被告的客戶在自身的網頁上實施了標記與伺服器（serving）的發明專利步驟⁴⁰；另外，在共同侵權責任的判斷上，上訴法院認為應依循 BMC 案所建立的控制或指導檢測法，而去判斷共同行為之人是否應負發明專利的直接侵權責任⁴¹，該院認為本案並無證據證明被告的客戶於實施相關侵權步驟時，被告與其客戶間有成立代理關係⁴²，再者，被告的客戶有選擇何種內容的自由，嗣後藉由客戶端的標記與伺服器步驟取得被告的內容發送網路（CDN, content delivery network），即便被告與其客戶間有協議，但該協議仍無要求客戶有義務（obligate）實施原告的專利步驟⁴³，因此，上訴法院維持地院不侵權的法律審理判決（JMOL）。

四、McKesson v. Epic⁴⁴案

（一）案例背景

本案系爭專利為一種保健醫療業者（healthcare providers）與

³⁹ *Id.*, at page 11 (“It is well settled that direct infringement requires a single party to perform every step of a claimed method. BMC Resources, 498 F.3d at 1378-79 (citing Warner-Jenkinson Co., Inc. v. Hilton Davis Corp., 520 U.S. 17, 40 (1997)).”)

⁴⁰ *Id.*, at page 15 (“Here, the customers decide what content, if any, they would like delivered by Limelight’s CDN and then perform the step of “tagging” that content. Limelight’s customers also perform the step of “serving” their own web pages.”)

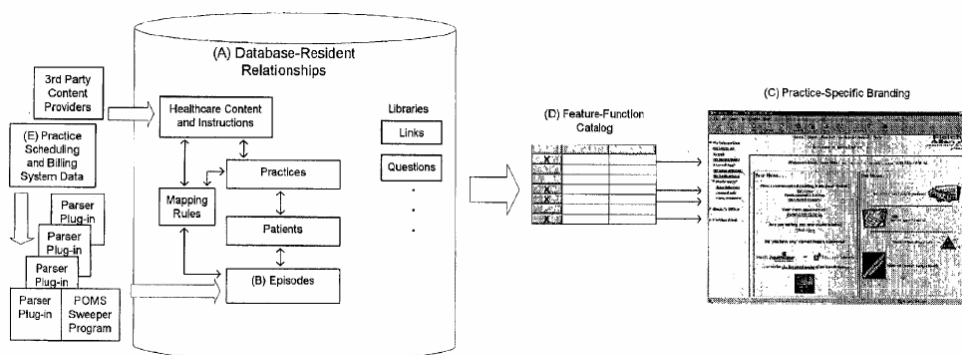
⁴¹ *Id.*, at page 12 (“While the “control or direction” test of BMC Resources established a foundational basis on which to determine liability for direct infringement of method claims by joint parties.”)

⁴² *Id.*, at page 14 (“In this case, there is nothing to indicate that Lime-light’s customers are performing any of the claimed method steps as agents for Limelight.”)

⁴³ *Id.*, at page 16 (“As discussed above, Limelight’s customers decide what content, if any, they choose to have delivered by Limelight’s CDN and only then perform the “tagging” and “serving” steps. The form contract does not obligate Limelight’s customers to perform any of the method steps.”)

⁴⁴ *McKesson Technologies Inc. v. Epic Systems Corp.* (Fed. Cir. 2011), available at [http://www.virginiaiplaw.com/uploads/file/McKesson\(1\).pdf](http://www.virginiaiplaw.com/uploads/file/McKesson(1).pdf), last visited Jan 16, 2012.

病患間的電子通訊方法，且包含一客製化的頁面可供病患與醫師溝通用⁴⁵，藉此產生醫師與病患間直接溝通之功效。本案被告為軟體開發商，其被控產品 MyChart 軟體，也是藉由頁面而讓醫師與病患間直接溝通，但被告並無使用該軟體，而是授權給保健醫療業者去使用⁴⁶。本案經地院審理後，認定被告並無侵權，原告不服，上訴至聯邦巡迴上訴法院。



圖五 本案 6,757,858 專利示意圖

(二) 爭點

本案被告之客戶並無直接的實施系爭專利的第一個步驟⁴⁷，此

⁴⁵ See 6,757,898 patent col.4 ll.3-44, available at <http://www.pat2pdf.org/patents/pat6757898.pdf>, last visited Jan 16, 2012.

⁴⁶ McKesson Technologies, *supra* note 44. (“Epic is a privately owned software development company that licenses software to healthcare providers. One such product is the accused MyChart software. MyChart allows healthcare providers to associate medical records with a patient’s personalized web page. MyChart also allows the patients to communicate with their healthcare provider online through these personalized MyChart web pages. In this way, patients are given access to their own medical records, treatment information, scheduling information, and other material.”)

⁴⁷ *Id.*, at page 4 (“The parties do not dispute that Epic’s customers do not directly perform the first step of the asserted method claims, the “initiating a communication” step.”)

為兩造皆不爭之事實，但是被告係因授權該被控軟體予醫療保健業者，令該業者提供被控軟體供其病患使用，此行為是否構成誘使侵權⁴⁸而侵害其專利。

（三）法院多數意見

本案經上訴法院審查後認為，原告無法證明有單一的（single）被告實施系爭專利步驟⁴⁹，亦無直接證據可證明被告產品之使用者，具有協議上之義務去實施發明專利步驟，且該使用者亦得選擇是否啟動與保健醫療業者間的溝通程序，此選擇並非是履行義務⁵⁰，再者，上訴法院認為，本案原告亦無法證明被告產品之使用者在實施專利步驟時，與被告之間具有代理關係（agency relationship）⁵¹，基此，維持地院認定不侵權的原判。

（四）Newman 法官不同意見書

本案承審法官 Newman 不同意本次多數意見，因此提出不同意見書，並駁斥著：「近期法院的判決皆認定複數行為，彼此之間不具有指導或控制關係者，若非共同合作（collaboration）、共同行

⁴⁸ *Id.*, at page 2-3 (“On December 6, 2006, McKesson sued Epic in the United States District Court for the Northern District of Georgia alleging that Epic induced infringement of claims 1-10, 12-14, and 16-18 of the '898 patent by licensing MyChart to healthcare providers who subsequently offered it to their patients.”)

⁴⁹ *Id.*, at page 2 (“Because McKesson is unable to attribute the performance of all the steps of the asserted method claims to a single party”)

⁵⁰ *Id.*, at page 8 (“Nor is there anything indicating that MyChart users were contractually obligated to perform any of the claimed method steps on behalf of the MyChart providers. These facts are undisputed. MyChart users choose whether or not to initiate communications with their providers and are under no obligation to do so. As in both *Akamai* and *Muniauction*, MyChart providers”)

⁵¹ *Id.*, at page 7 (“In this case, nothing indicates that MyChart users are performing any of the claimed method steps as agents for the MyChart providers. Nor does McKesson argue an agency relationship existed here.”)

為 (joint action)、共同促成 (facilitation)、授權 (authorization) 或邀約 (invitation) 等情況，則無法克服阻卻侵權的認定」⁵²，該法官認為本案如此判決，將會消滅專利制度的誘因，再者，過去本院其他法庭與最高法院都曾經認定複數分擔侵權行為人應負侵權責任⁵³。

該法官認為，本案判決所採用的單一個體原則 (single-entity rule)，事實上那也不是法律原則的一種，即便後來被上訴法院所創設，但該原則也未有如此廣泛的適用範圍⁵⁴；互動的方法符合所有專利法上的要件與要求，應受專利制度充分保障，但本院卻藉由新創、且被過度擴張的單一個體原則，摧毀專利制度範圍內原有的互動方法，本院判決違背法律與公共政策⁵⁵。

肆、法院對該理論之認知與見解之轉變

一、指導或控制原則遭受常規交易關係所壓縮

即便上訴法院亦認知到，共同侵權與分擔侵權僅一步之隔的距離在

⁵² *Id.*, Dissenting, at page 2 (“Some recent panel holdings are of similar vein, holding that neither collaboration nor joint action nor facilitation nor authorization nor invitation can overcome the immutable barrier to infringement when all of the participating entities are not under the “control or direction” of a mastermind infringer.”)

⁵³ *Id.*

⁵⁴ *Id.*, at page 4 (“The court today holds that the claim cannot be infringed as a matter of law, on the theory that a “single-entity rule” is violated because the provider does not control or direct the patient who initiates the communication, in that the patient is neither the agent of the health-care provider nor contractually obligated to initiate the communication. Maj. Op. at 8-9. There is no such rule of law. Even the recent creation of a “single-entity rule” by this court does not go that far.”)

⁵⁵ *Id.*, at page 5 (“Interactive methods that meet all of the conditions and requirements of the Patent Act are fully entitled to participate in the patent system. The court’s removal of interactive methods from the purview of the patent system, through its newly minted and now enlarged “single-entity rule,” is contrary to law and policy.”)

於指導或控制原則，然而該原則的適用常因兩主體主張之間為常規交易關係，而將兩主體帶離於侵權範圍⁵⁶，基此，該指導或控制原則顯然已遭受常規交易關係的壓縮，適用空間蕩然無存。

申言之，共同侵權行為的認定係構成直接侵權的必要條件，而共同侵權行為又必須具備指導或控制原則的要件，但實際情況卻是，即便該指導或控制原則有可能成立時，當事人仍可主張兩者間為常規交易關係作為抗辯理由，如此，將合理推導出專利權人在追訴侵權行為損害賠償時，即面臨侵權行為兩主體或多數主體皆為不完全實施專利發明步驟的困境，除非專利權人能證明任一行為主體構成均等論下之侵害，否則任一獨立的主體皆無侵權可能。

因此，面對惡意侵權行為，若因行為人係由兩個主體所構成，兩者協議分別實施部分專利權步驟，且該兩主體間得主張為常規交易關係，雖滿足指導或控制原則的要件，但專利權人對此況仍無任何請求權基礎可得主張，專利制度保護創作發明的立法目的似被惡意侵權行為人不當的扭曲。

二、增加專利法所無明文規定之限制

過去的判決先例在判斷方法步驟之侵權與否時，僅需判斷系爭「專利的所有步驟是否被實施」⁵⁷既已足矣，但近期美國聯邦巡迴上訴法院的

⁵⁶ BMC Resources, *supra* note 13. (“This court acknowledges that the standard requiring control or direction for a finding of joint infringement may in some circumstances allow parties to enter into arms-length agreements to avoid infringement.”)

⁵⁷ EMI Group North America, Inc. v. Intel Corp., 157 F.3d 887, 891, 48 USPQ2d 1181, 1184 (Fed. Cir. 1998) (“For infringement of a process invention, all of the claimed steps of the process must be performed, either as claimed or by an equivalent step.”), available at http://www.ipo.org/AM/Template.cfm?Section=Federal_Circuit_Opinions&template=/CM/ContentDisplay.cfm&ContentID=3636, last visited Jan 16, 2012.

實務發展卻變成是「侵害一方法專利權，係由一單一個體實施所有專利步驟」⁵⁸，不免令人質疑該上訴法院見解的轉變，是否已增加專利法所無明文規定之限制。

伍、結論

若按照近期美國專利分擔侵權的發展現況，該國之方法專利權，只要隱含互動的步驟，此類型專利將無任何侵權理論可作為行使權利的基礎，此況就如同國家授予一座漂浮在天空的城堡給專利權人，卻無任何進入城堡的途徑，這恐怕不是該國專利法定的專利權，因此，本文擬對專利代理人、專利權人以及該理論的發展提出幾項建議如下。

一、專利代理人撰寫時應注意事項

為能有效避免落入分擔侵權的情況，專利代理人於撰寫專利與權利項時，宜注意語法上的格式，並且多加思考除了方法權利項以外，是否有物的權利項可得請求，以下說明撰寫時應注意的事項。

（一）以單一個體（unitary）的實施為原則

撰寫製程或方法專利權利項，通常比物的專利更為簡單，理由在於方法專利不需像物的專利要去描述結構上的連結關係，亦不需要許多詳細描述元件之間所產生的功效⁵⁹，雖此，吾人卻可從

⁵⁸ McKesson Technologies, *supra* note 44, at page 6 (“This court concluded that “where the actions of multiple parties combine to perform every step of a claimed method, the claim is directly infringed only if one party exercises ‘control or direction’ over the entire process such that every step is attributable to the control-ling party.””)

⁵⁹ See Robert C. Faber, *Landis on Mechanics of Patent Claim Drafting*, 5th Ed., page 4-1. (“Method, or process, claims are generally easier to write than mechanical claims. The reason for this is that method claims by their very nature do not require as much structural “connecting up” nor as many detailed statements of the mechanical cooperation of parts as do mechanical claims.”)

近期案例發現撰寫製程或方法專利權利項時，若權利範圍的部分實施步驟無法由同一人實施，而是從遠端的使用者、或客戶或任何第二人進行操作，則該專利權很有可能陷入分擔侵權泥淖，因此，撰寫製程或方法專利權利項時，最重要的原則是確認每一個實施步驟皆由同一人進行，必須避開第二人實施的專利步驟。

（二）嘗試以物作為請求標的（subject matter）

有學者認為：「專利申請人可試圖將方法權利項轉化為系統權利項的類型，或是情況許可下，將方法權利項改寫為製得之物上，因為大部分的申請人皆關注於操作的方法，以為如此一來會有助於專利權的行使，但其實不然。」⁶⁰，因此，專利代理人在撰寫權利範圍時，應幫客戶多思考以物的權利項作為申請標的的可能性。

二、專利權人已核准領證之專利

若專利權人所申請之專利已經取得核准領證，且權利項語法的態樣亦已確定是分擔侵權的類型者，則專利權人可能考慮兩種途徑挽回不利的劣勢，一為尋求第 271 條 g 項的救濟，另一為再發證（reissue）程序，說明如下。

⁶⁰ Mark A. Lemley, *supra* note 7, at page 275 (“Patent applicants should include in their coverage strategy claims directed to systems and, whenever possible, articles of manufacture.66 Too often, applicants focus on methods of operation in their coverage strategies, sometimes to the exclusion of other, more useful, coverage. This can be a mistake because the multiple-entity infringement problems we have discussed arise primarily with respect to method claims.”)

（一）尋求第 271 條 g 項的救濟

專利法第 271 條 g 項⁶¹的主張，主要適用於進口或於國內使用與銷售該專利製程所製得之物，且該物的製程實施地不以美國境內為限。雖然該項的主張提供了專利權人對於境外侵權的救濟途徑⁶²，但僅以實體（physical）存在之物的製程為限，並無適用於網路資訊類型的方法專利⁶³，申言之，該項之適用雖僅限於實體物之製程⁶⁴，但可提供專利權人對抗美國境外實施部分方法專利之侵權行為人，例如，A 國之行為人實施製程專利步驟一至五，B 國之行為人實施其餘的製程專利步驟並製得一物後，當 B 國之行為人出口該物至美國時，專利權人即可向美國國際貿易委員會主張第 271 條 g 項的救濟。另外值得一提的是，美國國際貿易委員會在處理境外方法專利侵權時，該侵權行為必須是完整的實施所有專利步驟使得認定為侵權行為，反言之，若境外侵權僅是部分的專利步驟，再進口至美國境內完成其他專利步驟者，此況依現行

⁶¹ See 35 U.S.C. §271(g) (“Whoever without authority imports into the United States or offers to sell, sells, or uses within the United States a product which is made by a process patented in the United States shall be liable as an infringer, if the importation, offer to sell, sale, or use of the product occurs during the term of such process patent. In an action for infringement of a process patent, no remedy may be granted for infringement on account of the noncommercial use or retail sale of a product unless there is no adequate remedy under this title for infringement on account of the importation or other use, offer to sell, or sale of that product.”).

⁶² Mark A. Lemley, *supra* note 7, at page 276 (“As a result, 271(g) may, in effect, provide a patentee who has obtained appropriate method claims with coverage for some overseas exploitation of his invention.”)

⁶³ See Bayer AG v. Housey Pharms., Inc., 340 F.3d 1367, 1377-78, 68 U.S.P.Q.2d (BNA) 1001, 1009 (Fed. Cir. 2003); NTP, Inc. v. Research in Motion, Ltd., No. 03-1615, 2005 WL 1806123 (Fed. Cir. Aug. 2, 2005).

⁶⁴ Mark A. Lemley, *supra* note 7, at page 277 (“Accordingly only manufacturing methods create liability under §271(g).”)

美國國際貿易委員會的認定將是不侵權⁶⁵。

（二）申請連續申請案或再發證程序

當專利權人發現其專利申請案係採分擔侵權的類型，且該申請案已提出申請者，或許可藉由連續申請案（CA, continuation application）⁶⁶的程序，將權利項修正為單一個體實施的權利項，或者，當該申請案已經核准領證，則專利權人可於母案公告之日起二年內申請再發證（reissue）⁶⁷程序，請求單一個體實施的權利項。

三、分擔侵權理論日後發展的建議

雖然美國專利法迥異於該國其他侵權行為法的領域，僅由專利權人藉由明確定義其排他權的界限，並宣告予社會公眾，公示權利範圍以避免他人侵權，但形成鮮明對比的是，方法專利權人無法定義前期的損害並使之成立共同侵權責任，專利權人對此欠缺請求基礎⁶⁸，但本文認為分

⁶⁵ See 337-TA-724, *Commission Opinion*, page 12 (“We find that the Mac OS X Devices are imported with the Mac OS X operating system installed, which includes the[[]] codec at the time of importation. See Apple's Obj. to S3G's Prop. Find. Fact I.D.3.190, 192; II.03. However, with respect to the asserted data format claims (claims 11, 14, and 16 of the '978 patent), the Mac OS X Devices are not imported with DXT-encoded images. See Apple's Pet. for Review at 35; S3G's Resp. to Apple's Pet. for Review at 38. We also find that S3G has not proven by a preponderance of the evidence that the imported iDevices contain PVRTC-encoded images at the time of importation.”)

⁶⁶ See general MPEP 201.07.

⁶⁷ See 35 U.S.C. §251. (“No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.”)

⁶⁸ McKesson Technologies, *supra* note 44, at page 10 (“in patent law, unlike in other areas of tort law, the patentee specifically defines the boundaries of his or her exclusive rights and provides notice to the public to permit avoidance of infringement. This stands in sharp contrast to the circumstances surrounding a joint tort where the victim has no ability to define the injurious conduct upfront and where, absent joint liability, the victim would stand uncompensated as a consequence.”)

擔侵權理論的發展，可採行下述二種擇一的方式，以完備方法專利權人的合理法益。

（一）對複數惡意侵權行為人，可擬制為共同侵權責任

依據現行美國專利法的漏洞，主要癥結點在於侵權構成要件上的判斷建立在單一行為人或複數共同行為人是否「完整的實施」專利發明步驟，但現今的情況卻是複數行為人「分擔的實施」專利步驟，且行為人之間並無指導或控制關係，或行為人之間雖有指導或控制關係，卻主張常規交易關係，即使專利權人能證明侵權行為人主觀上惡意侵權，但此況仍被排除於法定侵權態樣並免於專利權人的追訴。

因此，本文認為可擴大對於共同侵權行為的判斷，不以指導或控制關係為限制條件，亦不以常規交易關係作為免責條件，而應綜合審查行為人之間有無主觀上的合意分擔侵權為構成要件，若有，則法律應擬制複數行為人之間成立共同侵權責任，並構成直接侵權。

（二）方法權利項應類推適用於美國專利法第 271 條 c 項

本文認為，目前美國專利法並無建立分擔侵權的判斷標準以供該國法院進行審查，但在專利法第 271 條 c 項已有類似規範可供類推適用，該 271 條 c 項之判斷標準係以零件或材料之銷售將無實質非侵權之用途者為限（採反面定義），同理，若適用於方法專利的判斷上，或可規定「分擔侵權行為人主觀認知其步驟之實施將實質分擔侵權之行為者」（採正面定義）。

其主要理由在於，物的判斷可取決將來用途是否構成侵權，但部分的方法步驟皆為先前技術，不可能會有將來構成侵權用途的可能，因此在間接侵權的判斷上，必須採用正面定義的方式，定義侵權行為人主觀上已認知該步驟之實施，將實質的與他人分擔部分侵權行為，而構成一個完整的侵權行為。