學術論文集

當公法遇上私法

台灣智慧財產訴訟制度之今昔

When Public Law Comes Across Private Law

Taiwan Intellectual Property Litigation System Then and Now

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元照

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推薦序

熊誦梅法官是美國柏克萊加州大學法學院法學博士，從事司法審判工作長達十七年，其間曾調司法院辦事二年，有司法行政之經驗，現任智慧財產法院法官，專事審理智慧財產民事、刑事及行政訴訟事件。

熊法官長期關懷台灣智慧財產訴訟制度的運作和功能，在審判工作繁忙之中，猶致力於催化訴訟制度之革新，以其語文能力及熟稔研究方法之專長，系統化引介各國智慧財產訴訟制度，予以比較分析，提供建言，作為司法行政機關規劃制度之重要參據，並就研究、審判、參與會議之相關論著集結成書。本書文筆流暢，視野宏觀，敘事明確扼要，由實務問題切入，述引個人親自參與之經驗，佐證所習制度及理論研究之心得，在領域上涵蓋了東西方訴訟制度之分析，程序上融冶了民事、刑事、行政訴訟及智慧財產案件審理法特別規定之應用，實體法上論述專利法、商標法、著作權法訴訟上常見爭議問題之見解，並觀察到台灣專利師此一新興專業，在智慧財產權訴訟之參與及其促進功能，可謂是了解智慧財產訴訟的入門書籍，閱之對智慧財產訴訟之演進及目前新制之運作與常見問題之處理，能有明晰之認識，在理論及實務皆有參考價值。

智慧財產法院　院長

Recommendation

I am most pleased to have the honor of writing a Preface to this book by Judge Sungmei Hsiung. Sungmei was a most outstanding student at U.C. Berkeley Law School where I had the privilege to supervise the research and writing of her dissertation for our J.S.D. (Doctor of Juridical Science) degree. And now I am pleased to be able to recommend to all readers the product of Sungmei's diligent research and hard work.

The research in this book represents some very thoughtful observations and insights on extremely important topics in the field of intellectual property, particularly patent law. A number of chapters in this book focus on the highly significant issue of the role and function of specialized IP courts. Sungmei has researched the history and structure of the Federal Circuit in the U.S., as well as the specialized IP courts of the major Asian countries – Taiwan, Korea, China, and Japan. She has examined not only the legislative details regarding each court but also the scholarly literature about their origins, functioning, and the pressing problems they face today. The attention to both the practical operation of these courts and the scholarly opinion regarding their strengths and weaknesses is a unique contribution of this book. I have personally learned

much of value from Sungmei on these issues, for example, the unique and innovative use of technical examination officers (TEOs) in Taiwan's new IP Court. I believe it is safe to say that on the topic of the comparative law of specialized IP courts, particularly those in Asia, Sungmei is perhaps the preeminent world expert at this time.

I hope you enjoy and learn from Sungmei's research as much as I have. It is my honor to recommend it to you, and to say that the Taiwan courts and IP system as a whole are fortunate to have this diligent scholar and shining star to learn from.

Professor Robert P. Merges
U.C. Berkeley School of Law

自　序

台灣智慧財產訴訟制度之今昔

台灣對智慧財產法律之推廣與實踐，隨著智慧財產法律研究所、科技法律研究所之蓬勃發展，已有相當之規模與進步。特別是在實體法部分，為加入國際組織所為之歷次修改，已讓台灣之智慧財產法制國際化，並與世界接軌，但陳舊的智慧財產訴訟制度，卻仍令智慧財產權利人望而卻步，且讓非正當權利人鑽營得利。二〇〇三、二〇〇四年間，實務界瀰漫著一片「台灣專利無用論」的呼聲，震撼了相關產業、學術及司法實務界人士，其中法律執行的無效率，即係智慧財產法制不彰的最主要原因之一。而法律執行的無效率，又係基於對智慧財產權本質之不了解。智慧財產既牽涉科技、管理及法律之整合，又橫跨公法及私法之交錯領域，因此傳統訴訟制度的設計，已無法因應智慧財產法制之日新月異。

其實相關智慧財產之法律制度，如專利、商標、著作及營業秘密等，溯其歷史脈絡，均係超過數百年以上之古老法制，但是在我接受基礎法學教育的一九八〇年代末期，卻是一個新興法領域的萌芽時期，我只選修了一門二學分的工業財產權法。一九九四年末，我初任台灣台北地方法院法官，因緣際會而忝為刑事庭智慧財產專股法官，當時係採專股輪辦但也兼辦其他案件，因此隔年就交出了專股寶座。一九九七年，我在辦理少年事件時，許多少年因受託販賣大補帖光碟而違法，因此

曾受邀擔任多場由當時著作權法之主管機關內政部著作權委員會主辦的校園著作權巡迴講座，以及台北律師公會為國中老師舉辦的智慧財產權法研習營。其後我改辦理民事事件時，智慧財產法制已逐漸進入開花時期。千禧年前後，我參加了許多由經濟部智慧財產局舉辦的研習活動以及各相關法律研究所舉辦的學術研討會及大型國際智慧財產法律研討會，著實開了我的眼界，引起我更深入研究智慧財產領域的興趣。同時間我開始著手撰寫司法院之年度研究報告——「法官辦理專利侵權民事訴訟手冊」，至二〇〇二年底完稿，而今觀之，或有不完備、疏漏甚至錯誤之處，但卻為我對智慧財產法制之研究奠下基礎。

我原來在法律學研究所係公法組的學生，碩士論文為中國大陸經濟仲裁制度之研究，當時大陸的經濟仲裁，實係採行政訴訟制度。不過選擇這個題目，一方面因為在當時中國的學術資料並不容易取得，我因為擔任國科會委託計畫的研究助理，因而得以接觸當時最新的資料，一方面也因為已經考上司法官特考，不想一再延訓，所以，雖然這本論文曾獲得行政院大陸委員會頒發的學術論文獎學金，但在我內心深處，偶爾還是覺得有點辜負了最適合研究的青春時光。二〇〇二年八月，因為曾是公法組研究生之故，調至司法院行政訴訟及懲戒廳辦事。其實自從離開研究所後，因長期辦理一般民、刑事審判，公法原則及理論就像在腦海中沉睡，在司法院調辦事期間慢慢被喚起甦醒。還記得當時我最驚訝的就是當初在唸研究所期間，公法老師們積極呼籲的課予義務訴訟，已經成為明文規範，且隨著高等行政法院的成立，公法之研究在學術及實務之努力下，也已蓬勃發展、欣欣向榮。而相關智慧財產法律，不僅本身即係行政法之規定，也常常受到其他行政法規範之影響，再配合

著台灣法院二元制之發展，行政訴訟二級二審制之開展，使智慧財產訴訟成為一個相當錯綜複雜的法制，招致國內外之批評。二〇〇三年六月，我發表了第一篇有關智慧財產法制之論文——「當公法遇上私法——從專利訴訟制度談起」，檢討台灣專利訴訟制度之複雜與無效率，並提出一些改革的建議。

二〇〇四年二月，司法院承受來自國內外之壓力及自身之覺醒，開始進行智慧財產法院之籌劃，當時我還在司法院行政訴訟及懲戒廳服務，同年八月出國進修前夕，奉廳裡指示寫了一本研究報告——「設立智慧財產法院之評估研究——兼論德國、韓國及日本之專利訴訟制度」，該報告於八月六日出版，八月十一日我即依原訂計畫與全家齊赴美國柏克萊加州大學法學院（University of California, Berkeley School of Law）進修，八月十七日開學。出國前之匆忙與混亂，迄今仍覺得難以想像。出國留學，一直是我大學時期的夢想，但隨著考上司法官特考、律師高考、受訓、分發而幾近放棄，經過多年的努力，終於在二〇〇三年底通過司法院的帶職帶薪進修計畫，且經過一般申請程序，選擇於二〇〇四年八月中赴美國新聞及世界報導（U.S. News & World Report）連續十數年均於智慧財產法領域評價第一的柏克萊法學院就讀。工作十年後重為學生，確實是一件令人興奮的事。柏克萊的湛藍陽光、自由風氣，重新喚起我的學術靈魂，我非常認真地學習，努力地參與法學院的各項活動，盡我所能地與同學及老師們互動，想要彌補當年沒能好好學習的研究所時光，因此不但於碩士班一年之課程內，取得柏克萊法學院科技法律中心頒發的結業證書，也在指導老師Robert P. Merges的重重考核下，獲其推薦而進入博士班課程，並於二〇〇八年五月畢業。柏克萊法學院是我人生中一個幸運的選擇，不只是因為其智慧財產法律課程及相關活動之豐富，

而且我在學校處處都能看到熊（雕像）的蹤跡，後來才知道原來Berkeley代表的意思就是Bear Territory（熊的領土）。果真我在熊的領土上，與全家一起度過了永生難忘且酸甜苦辣併陳的學生時光。

本書得以出刊，要謝謝元照出版公司的殷殷期盼、耐心等候，從起意至完成，竟然花了近三年的時間，此次若不是台灣大學法律學研究所經濟法組王宗雄同學的協助校稿，我想我可能還是沒有勇氣出這本書。書中收錄了我近幾年來，在智慧財產法院成立前後所寫過的一些文章，有些節錄自我於司法院調辦事期間撰寫之研究報告，有些曾在學術會議上宣讀過，有些則曾發表於學術期刊上，還有幾篇我在美國學習時之英文論著，多半與台灣智慧財產訴訟制度之檢討有關，也有係智慧財產實體法律適用問題之探討，而即使是有關實體法之論述，也多以判決評析為基礎。值此智慧財產法院仍屬嬰幼兒之際，藉此機會集結成冊，一方面作為自己學習智慧財產法制之紀念，並見證台灣這二十多年來智慧財產法制之推廣與發展；一方面也希望能對台灣智慧財產司法文化之提升盡綿薄之力。台灣過去智慧財產司法文化之匱乏，審判實務之缺席係主因之一，希望本書之出刊，能繼續前輩們已開啟之路，提升學術與實務之結合，法律與科技之整合，公法與私法之融合，使台灣之智慧財產法制開花結果並繼續蓬勃發展。

驀然回首，我在台灣台北地方法院將近十五年的法官生涯中，辦理過民、刑、少年、簡易、執行等事件，期間也至司法院擔任過以研究工作為主之調辦事法官，並赴美進修研讀碩士、博士，這樣的經驗讓我的人生豐富許多，隨後調至智慧財產法院，大量案件的累積，更充實我在智慧財產法領域的學

習，謹以此書之出刊，作為我法官生涯之紀念。此外，要謝謝智慧財產法院的高秀真院長，以及指導老師Robert P. Merges教授，百忙之中，非常懇切地針對這本著作撰文推薦。最後，要感謝我的父母，一位飄洋來台的無知小兵熊林才、一位台灣嘉義的單純女孩簡美珍（謹以此書於金兔年獻給屬兔的父親），以及永遠站在我這邊的公婆韓相祐、尹北順，他們都是我生活中的最佳後盾。當然也要感謝我的先生京惠，沒有他的望妻成鳳，我不可能有這麼多樣的人生體驗，還有我活潑乖巧的三個兒子——在煥、在善、在龍，為了豐富媽媽的人生，二度漂洋過海，前一天還在台灣小學參加學校的運動會賽跑，隔天已飛至美國的學校上課，希望他們的人生也因此而更顯精采。

二〇一一年春天
於智慧財產法院

Preface

It was the best of times, it was the worst of times...

— Charles Dickens
A Tale of Two Cities (1859)

Harmonization vs. Diversity

Harmonization is of particular interest within the context of intellectual property law, given that this body of law has had a long history of being associated with international economic trade.[1] Specifically, as the world becomes subject to globalization in this age of information, together with new forms of transportation, the need to harmonize different countries' intellectual property systems has

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1 Undeniably, creating a uniform intellectual property legal system on a global scale has universal recognition. See Robert M. Sherwood, Why a Uniform Intellectual Property System Makes Sense for the World, Global Dimensions of Intellectual Property Right in Science and Technology 68, 68 (1993) (arguing that "a uniform intellectual property system makes sense for the world"); Marshall A. Leaffer, Protecting United States Intellectual Property Abroad: Toward a New Multilateralism, 76 Iowa L. Rev. 273, 278 (1991) (stating a "general thesis" that "the ultimate goal of the United States ... should be the adequate protection of intellectual property based on international standards"); Robert W. Pritchard, The Future is Now—The Case for Patent Harmonization, 20 N. C. J. Int'l L. & Com. Reg. 291 (1995) (arguing that patent harmonization is in the best interests of the United States).

increased. In past decades, the international community has devoted substantial effort toward making this ideal into a reality.[2] The most recent, and most significant, manifestation of this movement is the 1994 Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPs),[3] part of the 1994 Uruguay Round of General Agreement on Tariffs and Trade (GATT) revisions, administered by the World Trade Organization (WTO).[4] This agreement sets minimum standards for many forms of intellectual property regulations.[5] The TRIPs agreement represents the most important piece of a much larger and ever-increasing network of treaties and international agreements in the progressive push towards the harmonization of intellectual property law at the international level. The TRIPs introduced intellectual property law to the international trading system for the

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2 For example, the Paris Convention for the Protection of Industrial Property of 1983, most recent amended in 1979; the Berne Convention for the Protection of Literary and Artistic Works of 1886, most recently amended in 1979; the Convention Establishing the World Intellectual Property Organization (WIPO Convention) of 1967, amended in 1979; the Patent Cooperation Treaty of 1970, amended in 1979, modified in 1984 and 2001; the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (Madrid Protocol) of 1989, amended in 2006.

3 TRIPs, Annex 1C of the Agreement establishing the WTO, is an integral part of the WTO Agreement.

4 The WTO Agreement was established on January 1, 1995, subsumed and expanded upon its predecessor GATT which was established in 1947.

5 For detailed information on intellectual property in the WTO, news and official records of the activities of the TRIPs Council, and details of the WTO's work with other international organizations in the field, see TRIPs material on the WTO website, available at: http://www.wto.org/english/tratop_e/trips_e/trips_e.htm (last visited on May 13, 2008).

first time.[6] It continues to be the most comprehensive international agreement on intellectual property to date. Failure to give sufficient respect to intellectual property has been a significant encumbrance in IP related trade negotiations.[7] TRIPs comes into play in two respects. Not only does it streamline procedures, but it also provides substantive uniform standards of protection.[8] Domestic policymakers therefore face different political pressures that have caused intellectual property lawmaking to move from domestic political arenas to the international forum. However, countries differ in terms of their levels of wealth, economic structures, technological capabilities, political systems, and culture traditions. Though intellectual property regulations of signatory countries might be internationalized and standardized, the enforcement of intellectual property rights still depends on the unique judiciary of each country. In order to create an increasingly harmonized environment, the desire for greater

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6 According to the Understanding on Rules and Procedures Governing the Settlement of Disputes (DSU), Annex 2 of the WTO Agreement, the WTO members can impose unilateral sanctions on countries concerning a lack of intellectual property protection. In comparison to the WIPO and WTO's predecessor of GATT is that the decisions of the dispute settlement panels or the Appellate Body of the WTO will be adopted and become legally binding, see Philippe Sands and Pierre Klein, Bowett's Law of International Institutions, at 379-383 (2001).

7 Paragraph 46 of Doha Ministerial Declaration, adopted on November 20, 2001, full text available at: http://www.wto.org/English/thewto_e/minist_e/min01_e/mindecl_e.htm (last visited on May 13, 2008).

8 TRIPs sets minimum standards for intellectual property protection and enforcement, but not maximum standards, opening the way for bilateral or regional agreements that go further than TRIPs.

uniformity of the intellectual property system must exist in both the substantive body of law and the application of law.[9] In addition, the harmonization of the intellectual property system should not only be pursued and made apparent on the international level, but also in the domestic field. The business communities of industrialized nations, especially that of the U.S., have greater expectations in having a more competent, or, so to speak, a more intellectual property favored, judiciary in order to efficiently and uniformly enforce their intellectual property rights. The establishment of the United States Court of Appeals for the Federal Circuit in 1982 is the first paradigm of this trend.[10]

Additionally, in view of the fact that intellectual property is dramatically increasing in value and is taking on a much more crucial role in business strategy and, more importantly, innovations which travel very quickly beyond national boundaries, the international business community is zealously pursuing friendly judiciaries in countries that have markets which are very significant to world trade, particularly those countries that have traditionally resisted strong intellectual property protection.[11] In this regard, East Asian countries

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9 See Randy L. Campbell, Global Patent Law Harmonization: Benefits and Implementation, 13 Ind. Int'l & Comp. L. Rev. 605 (2003).

10 See S. Rep. No. 97-275, at 5 (1981) ("The creation of the Court of Appeals for the Federal Circuit will produce desirable uniformity in this area of ... [patent] law."); H.R. Rep. No. 97-312, at 20-21 (1981) (discussing the existing problems of the lack of uniformity and noting that "some circuit courts are regarded as pro-patent and others anti-patent, and much time and money is expended in shopping for a favorable venue").

11 See William P. Alford, To Steal a Book is an Elegant Offense: Intellectual

are the main targets of this trend. In previous decades, East Asian legal systems have gone through certain phases of intellectual property development which correlate with economic stages.[12] Since entering into the WTO, all WTO countries implementing these systems have taken major steps designed to bring their intellectual property laws into close conformity with the expectations of Western regimes, threatening to impose trade sanctions in response to ignoring the protection of intellectual property rights.[13] Subsequently, the international business community turned their eyes to the judiciary of each legal system for the implementation of these rights. In the name

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Property Law in Chinese Civilization (1995) (arguing that according to ancient Chinese history and culture, particular the Confucianism, copying is not traditionally seen as a bad thing but is considered a compliment. In Chinese culture, the person will be referred to as an "Elegant Thief". Likewise, in Japan, South Korea, and Taiwan whose cultures are historically steeped in Confucianism were always thought to be less receptive to the idea of intellectual property rights.

12 Take Taiwan as an example, Taiwan experienced from a driving growth through export and paying price for intellectual property infringements to reforming intellectual property system infrastructures and profiting from intellectual property. See Yao-Jen Liu & Shang-Jyh Liu, Dept. of Graphic Commun. & Technol., Shih Hsin Univ., Taiwan, The Intellectual Property Policy of Taiwan: A Strategic Viewpoint, Engineering Management Conference, 2004 IEEE International, available at: http://ieeexplore.ieee.org/xpl/freeabs_all.jsp?tp=&arnumber=1407072&isnumber=30509 (last visited on April 19, 2008).

13 To Asian legal systems, the most intimidating way used by the U.S. government is the Section 301-310 of the Trade Law of 1974, threatened a trading partner with sanctions for lack of intellectual property enforcement when the trading party enjoys access to the U.S. market.

of harmonization, the international intellectual property system often includes universal templates that seek to provide one-size-fits-all solutions to problems within the intellectual property field. With this expectation, a specialized court which adjudicates all kinds of intellectual property cases has become a fashionable trend among both developed and developing countries.

There can be no doubt that conflicts of law or inconsistencies of judicial decisions interfere with trade. However, it has been long been argued that concentrating on a specific field of law in a specialized forum would favor repeat players and special interest groups,[14] produce tunnel vision and foster laws and practices far removed from the prevalent mainstream.[15]

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[14] See e.g., Lawrence Baum, Judicial Specialization, Litigant Influence, and Substantive Policy: The Court of Customs and Patent Appeals, 11 Law & Soc'y Rev. 823 (1977) (arguing that court specialization enhances the likelihood of litigant interest groups affecting substantive policy); William M. Landes & Richard A. Posner, An Empirical Analysis of the Patent Court, 71 U. Chi. L. Rev. 111, at 111-112 (2003) (hypothesizing that a specialized patent court is more likely than a generalist court to take a strong stance on its subject matter because "interest groups that had a stake in patent policy would be bound to play a larger role in the appointment of the judges of such a court than they would in the case of the generalist federal courts").

[15] See Richard Posner, The Federal Courts 147-160 (1985) (pointing out that "Judges in specialized courts are exposed to a few narrow subjects in great depth. Such a narrow focus can prevent judges from being open to new ideas or seeing the greater implications of their decisions; see also Randall R. Rader, Specialized Courts: The Legislative Response, 40 Am. U.L. Rev. 1003, at 1003-6 (1988) (noting criticisms of specialization of Federal Circuit's jurisdiction arising in legislative history of Federal Courts Improvement Act); Ellen E. Sward & Rodney F. Page, The Federal Courts

Shifting to the international side, at least one specialized court has commented that it was backed by great economic force.[16] Obviously, in this environment of international intellectual property environment, the pressure to conform to homogeneous standards of legal systems has increased. However, law is not independent nor is it separated from other social phenomena, so we find that legal diversity is an inherent element where we consider it can be largely based on various cultural traditions and social economics.[17] Therefore, the substantive law might be normalized, but the enforcement of the law could be localized. In this sense, even if creating a specialized court becomes an international trend, it does not mean the design of the court would necessarily be universal. In all actuality, it is incumbent upon a court system to be built based on national legal culture and social traditions.

The common theme of the harmonization of the enforcement of intellectual property rights is that uniformity of the application of law is critically necessary, and a single court would be an efficient and effective way to achieve this desired goal. Close to its 30th Anniversary, the first single court of this harmonization trend, the United States Court of Appeals for the Federal Circuit (the Federal

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Improvement Act: A Practitioner's Perspective, 33 Am. U.L. Rev. 385, at 395-396 (1984)(discussing Congress' hesitancy and concerns about granting additional specialized jurisdiction to Federal Circuit).

16 See supra note 13.

17 See Rodolfo Sacco, Diversity and Uniformity in the Law, 49 Am. J. Comp. L. 171 (2001); see also Patrick H. Glenn, Harmony of Laws in the Americas, 34 U. Miami Inter-Am. L. Rev. 223 (2003).