# 臺灣申請人的國際專利申請之策略

# International Patent Prosecution for Taiwanese Applicants

*By Rebecca M. McNeill and 鄭欣宜 Shing-Yi (Cindy) Cheng, Ph.D.*

原版於經濟日報，2010年5月3日
*Originally published in Economic Daily News, May 3, 2010*

Rebecca M. McNeill
617.452.1640
rebecca.mcneill@finnegan.com

Rebecca M. McNeill 主要處理客戶諮詢和專利申請，她特別善於向客戶提供專利申請方面的諮詢服務以及協助 戶制定全球性專利申請策略。McNeill 律師曾與生物科 新興公司、研究基金會以及著名的大型製藥公司合作，並在專利組合管理方面 備豐富經驗。

Rebecca M. McNeill practices client counseling and patent prosecution. She has a special interest in counseling clients on patent application filing and developing worldwide prosecution strategies. Ms. McNeill provides a full range of patent prosecution and counseling services to her clients and develops patent strategies in concert with clients' business goals. Ms. McNeill has worked with biotech start-ups, research foundations, and larger, established pharmaceutical companies. She has considerable experience managing patent portfolios.

鄭欣宜 Shing-Yi (Cindy) Cheng, Ph.D.
202.408.4244
cindy.cheng@finnegan.com

鄭欣宜博士的執業範圍包括美國專利的撰寫與申辦，主要及化學，化工，生物， 和 醫藥相關的發明。

Cindy Cheng focuses her practice on patent prosecution, primarily in the chemical, materials, pharmaceutical, and biological areas. She also provides technical support in patent litigation and opinion work.

---

得到國際專利的保護對台灣的機構是很重要的。專利合作條約 (Patent Cooperation Treaty，簡稱PCT)提供申請人一個獲得國際專利保護的方便途徑。提出PCT專利申請時，至少有一名發明人或是權利受讓人必須爲PCT成員國的國民。由於臺灣並非PCT成員，台灣申請人在提出PCT專利申請時面臨了一些難題。謹慎解決相關難題將確保臺灣機構在許多國家獲得有效並具有強制執行力的專利權，進而保護其商業產品和獲得可觀的授權金。

當所有發明人和權利受讓人均爲臺灣的國民時，進入PCT的最安全途徑是額外增加一名是PCT成員國國民的權利受讓人作爲申請人。臺灣公司機構可以在某個PCT成員國內設立一家分支機搆或者控股公司，並將其一部分的專利擁有權轉讓給這家控股公司。該控股公司之後即可當作符合PCT資格要求的申請人。

International patent protection is important for organizations in Taiwan. Patent Cooperation Treaty (PCT) offers a convenient way for applicants to obtain international patent protection. In order to file a PCT application, either an inventor or assignee of the application must be a national or resident of a PCT member country. Unfortunately, applicants from Taiwan face special burdens because Taiwan has not yet been recognized by the PCT. Paying careful attention to these burdens will allow these organizations to obtain valid and enforceable patents in many countries, which can either protect products or generate licensing revenue.

In cases where both the assignee is from Taiwan and inventors are both citizens and residents of Taiwan, the safest way to enter the PCT is to add an additional assignee, who is a resident of a PCT member country, as an additional applicant. Organizations can establish a subsidiary or holding company in a PCT member nation and assign at least a portion of the rights in their technologies to that holding company. The holding company would then serve as a PCT-qualified applicant.

如果臺灣的公司機構對於轉讓部分專利權給其控股公司持有疑慮，則可將該項專利權益中的一小部分（如1%）只在一個沒有或少有重要性的PCT成員國內進行轉讓。但某些實質性權利仍必須轉讓。除此之外，也可以在轉讓協議中加入一項條款，規定如果該臺灣公司機構向某一第三方授予使用許可或轉讓該項發明時，則該控股公司必須按照同等條件來授予使用許可或轉讓，並規定控股公司未取得該臺灣的公司機構的許可時，不得將發明專利的權益轉讓他人。再者，轉讓協議還可進一步要求該控股公司參與專利權相關的執行訴訟。值得注意的是，爲了達到提出PCT專利申請之目的而轉讓給可做爲PCT申請人的控股公司的部分權利必須是永久性和不可撤銷的。一份據稱是轉讓協議、但其轉讓的權利是可被撤銷的協議文件可能不會被認可，進而影響PCT專利申請以及任何國家階段的專利申請。

與其採用以上討論的方法，某些台灣公司機構會利用某些捷徑來提出PCT申請。有一做法是美國專利律師會把自己或其事務所列爲其PCT專利申請的申請人。此做法是不適當的,因爲將專利律師充當PCT專利申請人的方法是完全沒有法律依據的。如果這是被允許的，則要求申請人必須是PCT成員國國民這一前提條件將變成毫無意義。

另外,某些臺灣公司機構在“中國專利受理局(SIPO）辦理PCT專利申請時，宣稱其公司機構以及臺灣發明人都是中國公民。我們亦擔心此做法會對只有台灣申請人的PCT申請案造成影響。尤其是，雖然中國會接受僅有臺灣發明人的臺灣公司機構所提出的PCT專利申請，但在世界其他司法管轄地，對於由臺灣申請人以在中國所提出的的PCT專利申請而提出的國家階段的專利申請,目前尚不清楚它國專利局是否會授予其專利權或法院是否會強制執行該專利權。換句話說,SIPO會受理台灣申請人所提的PCT專利申請的這一事實可能對其他國家的專利局對就相關情況所作的解釋並不具有法律約束力。根據PCT第18條規則,對於一位專利申請人是否爲其聲稱的爲某PCT成員國的公民，將取決於該國國籍法的相關規定，且將由專利受理局予以裁決。因此,在國家階段申請時,若該國家有不同的詮釋並決定該申請沒有符合規定的PCT申請人,該申請案有可能會被視爲沒有符

If the organization has concerns about making an assignment to a holding company it is possible to assign a small percentage (e.g., 1%) of the interest in the invention, in only one PCT member country of little significance. However, some substantial rights must be transferred. It is also possible to insert a term into the assignment that if the organization licenses the invention to a third party, that the holding company must license it with the same terms, and cannot otherwise transfer rights in the invention. Further, the assignment can require that the holding company join in any patent enforcement action. Nevertheless, for the purpose of filing a PCT application, the assignment to the holding company should provide a permanent and non-revocable transfer of an interest in the invention. Documents purported to be assignments that transfer only a revocable interest could be disregarded, jeopardizing the PCT application as well as any national stage applications.

Instead of following these recommendations, some organizations take shortcuts to the PCT. We understand that in certain instances, U.S. attorneys are naming themselves or their firms as applicants for these PCT applications. This approach is inappropriate as there is no legal basis for the patent attorney to serve as a PCT applicant. If this was permitted, it would erase the requirement for the applicant to be a PCT national.

In addition, some organizations have filed PCT applications in the China PCT Receiving Office (SIPO) claiming that the organization and the inventors are all nationals of China. However, we have concerns that this might jeopardize the PCT application. Specifically, while China may accept PCT applications filed by companies from Taiwan with inventors from Taiwan, it is unclear whether, in other jurisdictions throughout the world, patent offices will issue or courts of law will enforce patents filed as national stage applications from a PCT application filed in China by solely Taiwan applicants. In other words, the fact that SIPO accepts the application may have no legal bearing on other countries' Patent Offices' interpretation of the facts. PCT Rule 18 states that the question of whether an applicant is a resident or national of the Contracting State of which he/she claims to be a resident or national shall depend on the national law of that State and shall be decided by the receiving Office. If in national stage examination, another country has a different interpretation and concludes there was no proper PCT applicant, that application could be considered abandoned for not meeting

合PCT要求而被列爲放棄。然而,也有可能它國司法管轄地會遵從SIPO就此問題所做出的裁決；但是，該等處理方式是沒有保證的而且不同國家也有可能會有不同的結論。

另外，即使在這方法下獲得專利權，如果該臺灣公司機構或日後的某個受權人試圖強制執行該項專利時，被控侵權者有可能會已該專利在提出PCT專利申請時未能滿足對申請人的基本要求而辨稱該項專利無效或不可執行。雖說作者尚未發現任何因臺灣公司機構聲稱其具有中國公民身份而致使其經由PCT申請再進入國家階段所得的專利權喪失效力的案例，但這種情況是有可能出現的。

最後,有些公司機關爲了克服進入PCT的困難，而刻意將一位不是發明人但具有某個PCT成員國國籍身份的人列爲發明人。爲確保獲得PCT專利申請而提供一份不正確的發明人名單會被視爲欺詐，並對該項PCT專利申請及任何由其提出的其他國家階段的專利申請產生非常不利的影響。

basic PCT requirements. Nevertheless, it is also possible that another jurisdiction would respect SIPO's decision on this matter. However, such treatment is not guaranteed and different countries may draw different conclusions.

Additionally, even if such a patent is granted, if the organization or a later licensee attempts to enforce the patent, an alleged infringer could potentially argue that the patent was invalid and/or unenforceable because the basic filing requirements of the PCT were not met. While the authors are not aware of any cases invalidating a patent in a national stage country based on PCT application where citizens of Taiwan claimed Chinese citizenship, such a decision is within the realm of possibilities.

Finally, given the difficulty in entering the PCT, it could be possible to name inventors primarily because they have citizenship in a PCT member country. Naming an incorrect inventor for the purpose of securing a PCT application would be fraudulent and jeopardize both the PCT application and any national phase applications.