NCCU Intellectual Property Review

智慧財產評論

第十四卷 · 第一期

July 2016

http://tiipm.nccu.edu.tw

TIIPM

國立政治大學 科技管理與智慧財產研究所
Graduate Institute of Technology, Innovation and Intellectual Property Management
National Chengchi University

NCCU Intellectual Property Review

智慧財產評論

第十四卷 · 第一期

July 2016

http://tiipm.nccu.edu.tw

國立政治大學 科技管理與智慧財產研究所
Graduate Institute of Technology,
Innovation and Intellectual Property Management
National Chengchi University

編 輯 委 員
Committee

目　錄
CONTENTS

BIOPROSPECTING AND BIOPIRACY: REMOVING GHOSTS

Sophia Espinosa Coloma*

Contents

* Professor of Law, Universidad San Francisco de Quito School of Law, Educator.
Submitted date: May 12, 2016; Accepted date: July 21, 2016.

ABSTRACT

Fears around bioprospecting have brought as a result that many multi-diverse countries have lost opportunities for innovation and industry development. Therefore, it is essential that biodiverse rich countries work on eliminating the ghosts surrounding bioprospecting. In this regard, it is important to make a clear distinction between bioprospecting and biopiracy. Furthermore, it is fundamental to highlight the benefits and value of bioprospecting for innovation and the generation of new products in fields such as health, food, cosmetics, biotechnology, etc. In this way, biodiversity rich would be able to promote bioprospecting as a key element for innovation and development.

Keywords: bioprospecting, biopiracy, innovation, CBD, multi-diverse countries, biodiversity rich countries, north-south debate.

生物探勘與生物剽竊—幽靈退散

Sophia Espinosa Coloma*

摘　要

本文以厄瓜多爲例討論生物探勘與生物剽竊的互動問題，並闡述生物探勘的正面意義，及釐清剽竊保護的疑慮。

關鍵字：生物探勘，生物剽竊，生物多樣性，專利

* 厄瓜多基多聖弗朗西斯大學法學教授
投稿日期：2016年4月11日；接受刊登日期：2016年7月21日

I. Introduction

Biodiversity prospecting or "bioprospecting" refers to the process of looking for potentially valuable genetic resources and biochemical compounds in nature.[1] Thus, bioprospecting is a practice that occurs in many fields such as medicine, agriculture, cosmetics, food, and biotechnology. Following this approach, we can affirm that bioprospecting has been practiced since the beginning of the mankind.

Around the world, some indigenous communities have discovered plants' medicinal uses for the treatment of illness and health. For instance, considering the use of herbs in traditional medicine to treat gynecological conditions, "a compendium of Chinese material medical has about 228 preparations described with applications related to fertility control; 97 as emmenagouges, 60 contraindicated in pregnancy, 44 as uterine stimulants and 27 as abortifacients."[2] In Ecuador, the use of Cinchona has been broadly extended for the local and foreign use for the treatment of malaria. In the Ecuadorian case, indigenous communities used to extract the quinine from the Cinchona bark in order to obtain the compound to treat malaria.

Ecuadorian indigenous communities use not only plants for the treatment of illness, but also animals. One example is the case of the Epipedobates tricolor frog, which is an endemic species from Ecuador and the north of Peru. Indigenous people can extract a strong analgesic from this frog. This compound is a strong "painkiller in the category of opium derivates. It has no side effects

---

1 *See* Thomas Eisner, *Chemical Prospecting: A Proposal for Action*, *in* ECOLOGY, ETHICS AND ECONOMICS: THE BROKEN CIRCLE 196, 196-202 (F. Herbert Bormann & Stephen R. Kellert eds., 1991).

2 A. Adebiyi et al., *Uterine Stimulating Effects of Crude Latex of Carica Papaya L.*, *in* ETHNOBIOLOGY AND BIOCULTURAL DIVERSITY: PROCEEDINGS OF THE SEVENTH INTERNATIONAL CONGRESS OF ETHNOBIOLOGY 299, 299 (John R. Stepp et al. eds., 2002).

and promotes alertness."[3]

In addition, some of the plants that have been used in traditional medicine by indigenous communities in the tropics, including Ecuador, are represented in the chart below[4]:

Plant common name	Plant Family	Vegetal Specie	Medical Use	Compound
Arbol de corcho (Cork Tree)	Solanaceae	Duboisia spp.	Antispasmodic	Buscapine
Cafe (Coffee)	Rubiaceae	Coffea spp.	Analgesic	Caffeine
Coca	Eryrhroxylaceae	Erythroxylum coca	Analgesic	Cocaine
Opium	Papaveraceae	Papaver somniferum	Analgesic and Antitussive	Codeine
Opium	Papaveraceae	Papaver somniferum	Analgesic	Corfina
Nuez Vomica (Pecan nut)	Loganiaceae	Strychnos nux-vomica	Insecticide	Strychnine
Opium	Papaveraceae	Papaver somniferum	Antitussive	Noscapine
Cascarilla	Rubiaceae	Chinchona pubescens	Anti-malaria and Antipyretic	Quinine
Indo-jyaboku	Apocynaceae	Rauwolfia serpentine	Hypotensive and tranquillizer	Reserpina
Tea	Theaceae	Camellia sinensis	Bronchodilator diuretic and stimulant	Teofilina
Ulmaria	Rosaceae	Filipendula ulmaria	Pain and inflammation reliever	Aspirin
Chamico	Solanaceae	Datura stramonium	Motor illness	Scopolamine
Ipecacuanha	Rubiaceae	Psychotria ipecacuanha	Induce vomit	Ipecacuanha
Jaborandi	Rutaceae	Pilocarpus jaborandi	Reduce the intraocular pressure	Pilocarpine

3 Esther Almeida, *Traditional Knowledge: An Analysis of the Current International Debate Applied to the Ecuadorian Amazon Context*, *in* HUMAN RIGHTS AND INTELLECTUAL PROPERTY RIGHTS: TENSION AND CONVERGENCES 209, 222 (Mpasi Sinjela ed., 2007).

4 *See* Monserrat Rios et al., *Plantas Útiles del Ecuador: Uso y Abuso*, *in* CONOCIMIENTO TRADICIONAL Y PLANTAS ÚTILES DEL ECUADOR: SABERES Y PRÁCTICAS 7, 15 (Abya-Yala et al. eds., 2008).

Plant common name	Plant Family	Vegetal Specie	Medical Use	Compound
Ma huang	Ephedraceae	Ephedra sinica	Reduce the nasal congestion	Seudoefredina
Vinca rosa de Madagascar (Madagascar Rose)	Apocynaceae	Catharanthus roseus	Treatment of Hodking disease	Vinblastina

Therefore, the use of biodiversity for medical and agricultural applications shows that bioprospecting has occurred around the world since antiquity.[5]

In contemporary times, bioprospecting has acquired significant value for many industries that work on the development of new products. The pharmaceutical, biotechnology, agriculture-food, and cosmetic industries see biodiversity as a valuable source of resources, and they consider bioprospecting to be a mechanism useful to identify those resources. For instance, "[i]n the United States, some 25 percent of prescriptions are filled with drugs whose active ingredients are extracted or derived from plants. Sales of these plant based drugs amounted to some $ 4.5 billion in 1980 and an estimated $ 15.5 billion in 1990."[6] This fact has arisen in a controversial debate between the use and access to biological resources. This controversy is deeply influenced by the North

5 *See* Corliss Karasov, *Who Reaps the Benefits of Biodiversity?*, 109 (12) Environmental Health Perspectives A582, A582 (2001), *available at* http://www.ncbi.nlm.nih.gov/pmc/articles/PMC1240518/pdf/ehp0109-a00582.pdf ("Bioprospecting had been shaping global cultures for centuries before a world trade organization came into being. A quick tour of almost any garden, farm field, or medicine cabinet should serve as a reminder that the global economy has in part been built on products of bioprospecting. According to Joshua Rosenthal, deputy director of the Division of International Training and Research at the NIH Fogarty International Center, more than 50% of the most prescribed medicines in the United States contain compounds derived from natural products. And an even larger percentage of the world's people rely on natural products for their primary medicinal needs.")

6 Walter V. Reid et al., Biodiversity Prospecting: Using Genetic Resources for Sustainable Development 7 (1993).

and South debate. On the other hand, it also shows the value of bioprospecting for innovation and industry development.

Considering innovation as a key element of development, it is important for multi-diverse countries to settle the basis to promote the construction of a technology oriented society that can make an efficient use of resources, while reassuring better economic conditions for its people. Promoting research and development is a complex process that has to work with different elements in order to create the conditions for an innovation environment. In this regard, bioprospecting becomes an important piece within the R&D process. Therefore, it is crucial for biodiversity rich countries to remove the ghosts surrounding bioprospecting. In this article, we will establish what bioprospecting is and its differences with biopiracy. We then conclude that bioprospecting should be considered as the cornerstone to promote innovation.

II. Fears around Bioprospecting and the Convention of Biological Diversity

A. Biological Resources

Traditionally biological resources were considered a "common heritage of mankind," which means in a broader sense that "the natural resources and vital life-support services belong to all mankind rather than to any one country."[7] Consequently, these resources can be considered goods that are commonly owned by the whole human race, but not by any specific group. To this respect, John Stuart Mill suggested that "the Earth itself, its forest and water above and below the surface. These are the inheritance of the human race, and there must

7 Gareth Porter & Janet Welsh Brown, Global Environmental Politics 13 (2d ed. 1995).

be regulations for the common enjoyment of it."[8] This perception meant that biological resources where considered public goods, and consequently, freely accessible.

For this reason, many pharmaceutical companies and botanic gardens collected significant samples from bio-rich countries for experimental and commercial purposes. As a result, the benefits from exploitation of biological resources were hoarded by third parties instead of being used for the benefit of the countries where the biological resources were found. For instance, "as recently as the 1980s, the plant rosy periwinkle (Catharanthus roseus) gave rise to two important drugs, vinblastine and vincristine, which are used to treat Hodgkin's disease and childhood leukemia, respectively. Together, the two drugs, manufactured primarily by Eli Lilly, net $100 million dollars annually, yet the source countries have never received a penny in royalties or other compensation."[9]

---

8 JOHN STUART MILL, PRINCIPLES OF POLITICAL ECONOMY WITH SOME OF THEIR APPLICATIONS TO SOCIAL PHILOSOPHY 70 (William J. Ashley ed., 7th ed 1909).

9 *See* Karasov, *supra* note 5. The rosy periwinkle case is an excellent example of "how difficult it can be to disentangle proprietary claims originating in folk traditions." At the beginning this case arose a significant controversy because the rosy periwinkle was alleged to be a native species of Madagascar. Therefore, it was alleged that "Madagascar was unfairly denied revenues from drugs whose discovery depend on its biodiversity and ethnomedical traditions." However, after revising the facts, it was stated that the Catharanthus roseus "is a resolutely cosmopolitan species now cultivated on six continents and thoroughly integrated into the folk healing traditions of countries as distant from one another as England, Pakistan, Vietnam, and Dominica … Far from being endangered species, Catharanthus roseus is regarded, at least in the state of Florida, as an aggressive exotic that gardeners should banish from their gardens." In addition,"according to the scientists working at Eli Lilly, the literature available to them identified the rosy periwinkle as a folk treatment for diabetes, not as a cancer medicine. … Instead, scientists came upon alkaloids that proved effective as agents for trating cancer. This discovery coupled with innovative extraction techniques, led to the development of vincristine and vinblastine, drugs that have helped doctors achieve remission rates of 90 percent or more in cases of childhood lymphocytic leukemia." Therefore, it is arguable to affirm that Madagascar had legitimate rights to participate from the profits. For further discussion, *see* MICHAEL F.

This kind of episode aggravated the historical friction between biologically rich countries in the South and technologically rich countries in the North. From this point of view, since colonialism, biodiversity rich countries or mega-diverse hotspots have been the principal suppliers of raw material to industrialized countries that own the technology to process and transform bioresources into final products. Therefore, this posture suggests that countries in the South have been exploited by developed countries in the North.

If we translate the North-South debate to the access and management of biological resources, we would find that southern countries feel outraged over the supposed misappropriation by northern countries of plant material and traditional knowledge for agricultural and pharmaceutical purposes. Global conditions show that countries in the South are the principal source of biodiversity. Therefore, they become undeniable fonts of genetic resources for bioprospecting and product development.[10]

On the other hand, northern countries are the ones that hold the technology and the knowledge necessary to economically exploit these resources. Consequently, the knowledge, technology, and market systems maintained by these countries allow them to concentrate the financial wealth. In addition, this economic expansion occurred without consideration for the conservation of the

---

BROWN, WHO OWNS NATIVE CULTURE? 135-38 (2003).

10 *See* Susette Biber-Klemm & Danuta Szymura Berglas, *Problems and Goals*, *in* RIGHTS TO PLANT GENETIC RESOURCES AND TRADITIONAL KNOWLEDGE: BASIC ISSUES AND PERSPECTIVES 3, 6 (Biber-Klemm et al eds., 2006) ("Biodiversity is distributed unevenly over the globe. Generally speaking, there is more diversity in warmer and wetter climates than in cooler and drier ones."); *see also* EDWARD O. WILSON, THE DIVERSITY OF LIFE 260 (1992) ("Seventy percent of the world's biodiversity is found in only 12 mega-diverse countries - Colombia, Ecuador, Peru, Brazil, Zaire, Madagascar, China, India, Malaysia, Indonesia, Australia and Mexico- which, with the exception of Australia are all developing, non-Western nations. A wealth of biodiversity is also found in many other countries; for instance, South Africa contains the most biological diversity in plant species.").

environment; therefore, in some cases over-exploitation of natural resources was the motor for the economic growth of industrialized nations.[11]

This scheme of production without consideration for the sustainability management of biological resources; combined with the inequities derived from the lack of compensation to local communities, which were the holders of traditional knowledge, brought a need to change this model. As a result, the international community reassessed the parameters of access to biological resources and biodiversity management.

B. Convention of Biological Diversity

Thus, in 1992 the Convention of Biological Diversity (hereinafter CBD) was signed. This new international legal framework states as an objectives "the conservation of biological diversity, the sustainable use of its components and the fair and equitable sharing of the benefits arising out of the utilization of genetic resources, including by appropriate access to genetic resources and by appropriate transfer of relevant technologies, taking into account all rights over those resources and to technologies, and by appropriate funding."[12] In order to effect adequate compensation for access to genetic resources and traditional

---

11 *See* CHIDI OGUAMANAM, INTERNATIONAL LAW AND INDIGENOUS KNOWLEDGE: INTELLECTUAL PROPERTY, PLANT BIODIVERSITY, AND TRADITIONAL MEDICINE 54 (Chidi Oguamanam ed., 2d ed. 2006). ("An industrial approach to natural resources facilitates overharvesting and consumption of natural resources, thereby posing a major threat to biodiversity. The global consumption pattern of biodiversity components supports this fact. Only 25 per cent of the global population controls the technologies and 85 percent of the global financial wealth needed for the deployment and consumption of natural resources. These consist mainly of the industrialized countries of the North. The tropical countries (including China) have 75 percent of the world's population and only 15 per cent of the global financial wealth. Collectively, people in developing countries use 20 per cent of industrial energy and less of most other materials that contribute to their standard of living, and include among their members only 6 percent of world scientists and engineers, according to the United Nations and the World Bank.").

12 Convention of Biological Diversity art. 1, June. 5, 1992, U.N.T.S.

knowledge, the CBD recognizes the sovereign rights of States over their natural resources, the authority to determine access to genetic resources rests with the national governments and is subject to national legislation."[13]

This change produced significant modifications in the management of bioresources and biodiversity. This is because for the first time, bioprospectors have an obligation to compensate source countries and indigenous communities that contributed their traditional knowledge. Thus, property-right mechanism over biological resources has been created, and the doctrine "common heritage of mankind" has been overturned.

Nevertheless, it has been overturned only in this field, because access to crop genetic resources for foods and agricultures still maintains the doctrine of "common heritage of mankind", given the global concern about food security. Thus, the FAO ("Food and Agricultural Organization") Commission and International Undertaking affirmed a resolution establishing that "plant genetic resources are a heritage of mankind and consequently be available without restriction."[14]

After the CBD came into force in 1993, it was perceived by the international community as a tool to calibrate the conditions of access to genetic resources. Thus, it facilitates access to genetic resources and at the same time promotes biodiversity conservation. In addition, through the establishment of the principles of benefit and sharing, life conditions in the source countries and indigenous communities could be improved.

In reference to the previous situation and the new conditions after the es-

13 CBD art. 15.1 .

14 International Undertaking on Plant Genetic Resources art. 1, FAO Conference, 22nd Sess., U.N. Doc. C/83/REP (Nov. 23, 1983), *available at* http://www.fao.org/wiews-archive/docs/Resolution_8_83.pdf.

tablishment of the CBD, Richard S. Cahoon, vice president of the Cornell Research Foundation and associate director of patents and technology marketing at Cornell University in Ithaca, New York, says that:

> *This meant that there was no law or moral obligation requiring a company that collected biological material from another country to pay for access to that material, ... What has changed is that we've begun to recognize property rights in all biota. We also recognize how bioprospecting can be used to encourage economic development and conservation in Third World countries.*[15]

Nevertheless, despite the recognition of national sovereignty over natural resources and the establishment of the principles of access, benefit, and sharing, the South is still skeptical about facilitating access to genetic resources. As a result, without adequate mechanisms to implement the CBD, the sovereignty that was considered one of the biggest achievements of this Convention could work against the objectives of this instrument. A "brute nationalism"[16] adopted by the South resulted in a system in which sovereignty was used to restrict access and not to facilitate it. The CBD empowers the countries of origin to control the conditions and terms of access to genetic resources. Nevertheless, in some cases, the lack of experience drafting contracts for access to genetic resources and the absence of laws have caused bioprospecting projects to be postponed.

For example, in August 2008, the Global Institute for BioExploration (GIBEX) and Universidad San Francisco de Quito made their formal presentation to the Ministry of Environment of Ecuador in order to obtain authorization

15 *See* Karasov, *supra* note 5, at A587.

16 It is the term used by Vogel while explaining the position of the South countries during the negotiations of the CBD.

to start a bioprospecting project in the following Ecuadorian regions: Maquipucuna, Choco–Andean; Tiputini, Amazonas; and Gaias, Galapagos. The objective of this project was to screen biological resources in order to find active compounds that could be used in the medical field. According to the terms of the proposal, all screening was going to take place in Ecuador; therefore, no sample of biological resources was going to be taken out of the country. In addition, any intellectual property right derived from the project was going to be assigned to Ecuador. Nevertheless, the government stated that there was no local regulation to govern the project.[17] Nowadays, Ecuador has a regulation regarding access, benefit and sharing, but despite the fact that now the procedure for accessing to genetic resources is clear, there are still many grounds to work on in order to promote innovation through the access to genetic resources.

III. Bioprospecting Is Not Biopiracy

A. Misappropriation Approach

The fears around bioprospecting have made that some members of ecological organizations still believe that bioprospecting is merely a justification to misappropriate biological resources that belong to southern countries. To this respect in Ecuador, Elizabeth Bravo, the President of the Institute of Ecologists Studies of the Third World, confuses the terms bioprospecting and biopiracy. Thus, she states that the only goal of bioprospecting is the commercialization of products, and therefore, its objective is to obtain revenue.[18] Consequently,

---

17 Taken from personal notes took in Ecuador, August 2008, at the Offices of the Ministry of Environment. In this meeting, Professor Manuel Baldeon from Universidad San Francisco de Quito and Professor Elvira de Mejia from University of Illinois, Urbana-Champaign made the presentation of the project.

18 *See generally* Elizabeth Bravo, *La Bioprospeccion en el Ecuador*, *in* BIODIVERSIDAD, BIOPROSPECCION Y BIOSEGURIDAD 131 (Ana Maria Varea ed., 1997), *available at* http://repository.unm.edu/bitstream/handle/1928/10512/Biodiversidad;jsessionid=

it is just a mechanism to loot biological resources and traditional knowledge from the third world. She concludes that "these facts not only constitutes a violation of the Constitutional rights but also is a mechanism to privatize the life and the traditional knowledge that has been elaborated and used in a collective way."[19] Furthermore, regarding the benefit and sharing, Bravo has stated that the Access Benefit and Sharing (ABS) is only a way to legalize the biopiracy.[20]

This kind of statement reflects the lack of knowledge and the irrational nationalism that exist on the topic of management of biological resources. First, if it is true that the final objective of bioprospecting is to obtain a product susceptible to commercialization, then its intrinsic purpose is to enhance human welfare. To this respect, David Kingston, a professor of bioorganic and natural products chemistry at Virginia Polytechnic Institute and State University in Blacksburg, sees bioprospecting as a win-win situation for bioprospectors, public health, and source countries when treaties are equitable. "The host country has nothing to lose … Bioprospecting is not solely driven by interest in money," he says. The hope that cures to cancer, AIDS, and other diseases are hidden in some endangered habitat still fuels enthusiasm for bioprospecting. Kingston believes we can't afford to stop looking at natural products. "No chemist could ever dream up the chemistry of Taxol," he says, referring to the drug for fighting breast and other cancers that is derived from the bark of the Pacific yew tree (Taxus).[21]

Moreover, it is fundamental to distinguish bioprospecting from biopi-

DA078AB3A3E46F594B2EBCF710C160CA?sequence=1.

19 *Id.*

20 *See generally* Elizabeth Bravo, *Biopiratería o "Buen Vivir". El caso de Ecuador*, 107 ESPECIAL 69 (2009), *available at* http://www.biopirateria.org/download/documentos/investigacion/biopirateria-casos/biopirateria-o-buen-vivir_Ecuador_EBRAVO_.pdf.

21 *See* Karasov, *supra* note 5, at A587.

racy. Biopiracy and bioprospecting are two completely different concepts, but sometimes they are associated and confused. As we stated before, bioprospecting has a positive connotation because it focuses on the search for genetic resources for their elaboration into final products that improve life conditions. Thus, even if it is true that in some ways bioprospecting has an economic and commercial purpose, in its beginning, the principal objective is searching for chemical compounds with useful characteristics.

On the other hand, biopiracy is defined by Dr. Vandana Shiva "as a process by which the rights of indigenous cultures to their genetic resources and associated traditional knowledge are replaced by monopoly rights of those who exploit these resources."[22] Others assert that biopiracy "refers to the use of intellectual property laws (patents, plant breeder's rights) to gain exclusively monopoly control over genetic resources that are based on the knowledge and innovation of farmers and indigenous peoples."[23]

Thus, biopiracy is understood as a misappropriation of genetic resources and traditional knowledge associated through the use of intellectual property rights. According to this perception, intellectual property regimens encourage biopiracy.[24] Nonetheless, it is an arguable point, in that sense according to WIPO, "existing IP laws have been successfully used to protect against some forms of misuse and misappropriation of TK, including through the laws of patents, trademarks, geographical indications, industrial designs, and trade

---

22 VANDANA SHIVA, BIOPIRACY: THE PLUNDER OF NATURE AND KNOWLEDGE 31 (1997).

23 RURAL ADVANCEMENT FOUNDATION INTERNATIONAL (RAFI), 1996 BIOPIRACY UPDATE US PATENTS CLAIM EXCLUSIVELY MONOPOLY CONTROL OF FOOD CROP, MEDICINAL PLANTS, SOIL MICROBES AND TRADITIONAL KNOWLEDGE FROM THE SOUTH (1996), *available at* http://www.etcgroup.org/sites/www.etcgroup.org/files/publication/460/01/raficom51biopupdate96.pdf.

24 *See generally* Charles R. McManis, *Fitting Traditional Knowledge Protection and Biopiracy Claims into the Existing Intellectual Property and Unfair Competition Framework*, *in* INTELLECTUAL PROPERTY AND BIOLOGICAL RESOURCES 425 (Burton Ong ed., 2004).

secrets."[25] Biopiracy can be cataloged within the tort of misappropriation because it involves an unfair invasion of other's property that causes a prejudice. Carol McHugh analyzing the Board of Trade v. Dow Jones & Co.[26] case makes an interesting point about misappropriation:

> *In evaluating misappropriation claims, courts generally require the plaintiff to prove both that it has suffered injury in the marketplace and that the defendant, a direct competitor, has been unjustly enriched through the wrongful appropriation. The competitive injury requirement, however, has been relaxed as misappropriation has evolved as part of the common law tort of unfair competition. ... This new test is a departure from traditional misappropriation law, especially in its support for the originators of intellectual property. Traditionally, some courts have defined the concept of competitive injury narrowly, making it very difficult for misappropriation plaintiffs to prevail. The Dow Jones court eliminated competitive injury from its analysis and instead stressed a balancing approach. This approach removed the inflexibility from the Illinois misappropriation doctrine. Rather than treating the type of competition between the parties as determinative, the court focused on the unjust enrichment that would have resulted to the CBT if it were allowed to use the Dow Jones index with impunity. This focus emphasized the broader principle underlying the misappropriation doctrine: that property of commercial value should be protected from another's unauthorized use for profit. ... The Dow Jones decision correctly recognized that the misappropriation doctrine must be flexible enough to provide courts a panoply of resources*

---

25 World Intellectual Property Organization, Intellectual Property and Traditional Knowledge 17 (2011), http://www.wipo.int/edocs/pubdocs/en/tk/920/wipo_pub_920.pdf.

26 Bd. of Trade of the City of Chicago v. Dow Jones & Co., 108 Ill. App. 3d 681, 439 N.E.2d 526 (1982).

to facilitate the eradication of enterprise piracy from the marketplace.[27]

As a consequence, if we follow this approach, in some cases biopiracy can be considered as a case of misappropriation. First of all, genetic resources and traditional knowledge sometimes are valuable assets within the market. Second, there is an economic detriment that genetic resources owners and traditional knowledge holders suffer because they do not receive a fair compensation for the use of these assets. Third, there is a possibility that genetic resources and traditional knowledge can be appropriated by a third party in a wrongful way, which means without consent and an equitable benefit-sharing (CBD). Then, we can say that biopiracy can be one of misappropriation faces.

Therefore, understanding biopiracy as an unfair appropriation of bioresources and traditional knowledge, it is without any doubt a practice that should be eliminated. For this reason, it is important to develop a strong legal framework in which the principles of access and benefit-sharing can be applied in an effective way. Only, with a strong, clear and enforceable framework that effectively enforces the CBD we will achieve reasonable protection for bioresources and traditional knowledge.

B. Bioprospecting Approach

Biopiracy sullies the legitimacy of bioprospecting. However, it is important to distinguish when the supposed biopiracy takes place and under which conditions. It is relevant because the circumstances and parameters for the management of biological resources significantly changed after the CBD. For this reason, all the acts that occurred under the old approach, the "common

---

27 Carol McHugh, S*eparating Commercial Parroting from Pirating: Board of Trade v. Dow Jones* & Co., 33 DePaul L. Rev. 595, 612 (1984), http://via.library.depaul.edu/cgi/viewcontent.cgi?article=2248&context=law-review.

heritage of the mankind," are difficult to reproach, because they were committed under the rules of that time. To this respect, James S. Miller from the Missouri Botanical Garden stated that "it's unfair to label the rosy periwinkle discoveries or any other bioprospecting done before the CBD was signed as biopiracy. It was … just the normal way of doing things. There wasn't anything malicious or malevolent about it."[28]

Furthermore, bioprospecting after the CBD provides an opportunity to strengthen the national economy, to improve the life of the traditional knowledge holders, to contribute with the promotion of science and inventions, and to conserve biodiversity under a sustainability approach. It is true that all these benefits from the CBD sound unreal and difficult to achieve. Enforcing and applying the CBD involves a difficult and complex challenge that requires the cooperation of the international community, the local governments, and the indigenous people.

However, the first step is to eliminate the fear that exists regarding bioprospecting. First, we have to clarify that bioprospecting is not biopiracy. Therefore, the major part of bioprospecting projects have as a main purpose to research and find helpful compounds to be used for the treatment of medical diseases, nutrition, and cosmetology. Thus, the main goal of bioprospecting is to enhance the human wellness and to become a key element of innovation. However, in order to maximize the benefits of bioprospecting, it is important that the contracts governing access to genetic resources and the prior informed consent agreements[29] be signed under a fair and reasonable basis. For this rea-

28 *See* KARASOV, *supra* note 5, at A586.

29 Prior informed consent agreements are those contracts that have to be subscribed by the indigenous communities that are contributing to the research with their traditional knowledge. It is a way to ensure that they receive the equitable remuneration if their knowledge is used to make a final product, or to recognize their participation an collaboration if any right has to be granted.

son, it is important to have a clear and effective regulation and to educate government officers and indigenous people about the issues and legal implications that surround these instruments. In addition, the regulation should not be complex or difficult; they should look for the needs of the stakeholders in order to accurately facilitate access.

Second issue that is relevant to this topic is the fact that bioprospecting does not imply an over-exploitation of nature. On the contrary, bioprospecting involves a good opportunity to obtain resources for the conservation of nature. Bioprospecting does not necessarily require the use of large samples of bioresources because it generally focuses on genetic material (however, it is important not to overexploit the resource). Thus, bioprospectors can use small quantities to do their screening and research. This small use of biological resources does not constitute a threat to the environmental equilibrium. However, if the bioprospecting brings favorable resources, the results can be used for the creation of final products, and the country of origin would receive a fair remuneration that should be used to conserve nature.[30]

Another fear regarding bioprospecting is the possibility that traditional knowledge may be misappropriated, limited, or threatened. This fear raises the possibility that bioprospectors could obtain intellectual property rights to tradi-

---

30 *See* PETER G. PAN, BIOPROSPECTING ISSUES AND POLICY CONSIDERATION 4 (2006), *available at* http://lrbhawaii.org/reports/legrpts/lrb/rpts06/biocon.pdf ("Bioprospecting involves searching for, identifying, and collecting appropriate biospecimens. In addition, bioprospecting uses various cutting-edge technologies to process and develop genetic material from these specimens that exhibit characteristics desirable in a commercial product. It is the genetic material, not the biospecimen itself that is of interest. Generally then, it would be inefficient, irresponsible, and unnecessary for bioprospectors to collect massive volumes of plants or animals for processing. Consequently, it is a misconception that bioprospecting decimates an organism's population to near extinction and denudes entire rainforests like wholesale strip-mining for gold. Bioprospecting firms or their partners or clients generally need only a few specimens to extract the genetic material they need.").

tional knowledge without recognizing the substantial participation of traditional knowledge holders. In addition, in the case that those intellectual property rights were acquired by bioprospectors in the jurisdiction in which traditional knowledge holders live; then, indigenous people would not be able to continue using and applying their own traditional knowledge in their territory. This problem could bring a limitation of traditional knowledge and practices that can undermine indigenous people's culture. Therefore, in order to avoid any possibility of biopiracy, it is fundamental to have a consistent legal framework and legal instruments to secure the rights of indigenous communities. Thus, intellectual property rights can be used as a mechanism of protection of traditional knowledge; however it is important to define the most convenient type to safeguard the interest of indigenous people.[31]

Indigenous people are not opposed to bioprospecting or to the adoption and practice of the principles of access, benefit, and sharing stated in the CBD. However, they have clearly stated that to continue with the application of these principles, it is important that their culture and traditions be respected. Indigenous communities are willing to share their knowledge to contribute to the good of humanity, but they do not want to be abused or exploited. Thus, during the discussion of the CBD, indigenous people manifested their concern and conditions regarding to the objectives of the CBD.

[K]nowledge is not merely a commodity to be traded like any other in the market place. Our knowledge of biodiversity is indivisible from our entities and our laws, institutions, value systems and cosmovisions as Indigenous Peoples. For generations, our peoples have been and continue to be custodians of nature upon which we all depend. We are therefore fully committed to the first two objectives of the Convention, that is, the conservation and sustainable

31 *Id.* at 17-21.

use of biodiversity. However, any discussion of the third objective that of access and benefit sharing, must recognize our fundamental rights to control our own knowledge, our right to be free, prior informed consent as peoples, and our collective land and territorial security.[32]

Traditional knowledge can be very valuable for bioprospecting, because it can save time and costs, which constitutes an aggregate value for researchers. This fact puts indigenous communities in a good position to negotiate. However, it is important that bioprospectors consider that the terms of negotiation are not limited to the economic issue, because there are social, cultural, and spiritual values that also have to be considered. In addition, it is also important that indigenous communities have a more realistic idea of the percentage and value that traditional knowledge represents. The significant contribution of traditional knowledge, especially in the drug discovery field, is well evidenced.[33]

As a consequence, the value of traditional knowledge associated with biological resources is not only a patrimony for indigenous people but also for the entire human race. Therefore, the global community should take the same position regarding biodiversity in the case of traditional knowledge. Thus, it

---

32 Statement of the International Indigenous Forum on Biodiversity at the Ad Hoc Open-Ended Working Group on Access and Benefit Sharing, CBD, Oct. 22-26, 2001, Bonn, Germany, reprinted in TEBTEBBA Briefing Paper No.8.

33 *See* NIRMAL SENGUPTA, ECONOMIC STUDIES OF INDIGENOUS AND TRADITIONAL KNOWLEDGE 213 (2007) ("An evaluation study for the US Congress (1993) concludes that the success by NCI [(National Cancer Institute)] could have been doubled, if had they taken into account the knowledge of medicinal folk to target testable species. Therefore, successful search processes are based on some ground truth of finding a probability of favorable outcome. Otherwise, scientists of Novartis and Merck could not have traveled in the wilderness of the Amazon and Costa Rica forest in search of unique phytochemicals which cannot be imagined to synthesize in the laboratory of combinatorial chemistry. Therefore, one finds enough evidence that the value of benefits of bioprospecting may be quite significant and that local's information in the search process can significantly enhance the strike rate of a hit.").

should be considered a common concern of mankind, because it has evolved with biodiversity through the time, space, and change. Consequently, bioprospecting should be used as a practice to enhance the moral, spiritual, and economic value of traditional knowledge in order to constitute an incentive for new generations of indigenous people to continue and maintain their traditions.

IV. Conclusions

In conclusion, bioprospecting is a legitimate practice that should be promoted under fair and reasonable parameters. It is impossible to negate all the benefits that bioprospecting brings to the human race, especially in the food security and human health fields. However, it is important to establish adequate legal mechanisms to allow bioprospecting within a sustainable and fair framework. In addition, it is important to valuate bioprospecting with regard to both its economic value and its social value. That would encourage a system wherein all the legal instruments created to facilitate the access, benefit, and sharing would not consider bioresources and traditional knowledge through only an economic lens, but as holistic concepts, repreas senting the needs and aspirations of all the parties involved.[34]

Legal mechanisms should be focused on facilitate access. Therefore, the inclusion of the principles of ABS and prior informed consent are fundamental

---

34 *See* PADMASHREE GEHL SAMPATH, REGULATING BIOPROSPECTING: INSTITUTIONS FOR DRUG RESEARCH, ACCESS, AND BENEFIT-SHARING 5 (2005) ("The bioprospecting perspective expresses optimism that through bioprospecting, all three objectives of the CBD –sustainable use, conservation of biological resources, and benefit-sharing- can be met. In this perspective, bioprospecting is seen a venue of revenue generation from potentially valuable traditional knowledge and genetic resources situated in the South. In the presence of wee-designed laws and contracts, bioprospecting presents a win-win situation where benefits generated can be used for a range of purposes - improvement to livelihoods of indigenous and local communities, biodiversity conservation programs and biotechnological capacity building.").

for an adequate protection of TK and genetic resources. However, it is important that the regulation that would be developed to regulate these principles will facilitate access to TK and genetic resources. Extremely complex systems, as the one we have in Ecuador, discourage the development of research and development, fact that only harm the country of origin or TK holders. It is crucial to develop a simplified process for accessing to genetic resources and traditional knowledge, in which the researchers have to deal only with the national authority and not with all the other stakeholders. The national authority should be in charge of the negotiation with the other parties, then bioprospectors do not have to face the difficulties of dealing with institutions or communities that have a different background that can bring obstacles in the negotiation. Training indigenous communities and governmental authorities in issues regarding access to genetic resources and traditional knowledge will facilitate the development of bioprospecting projects or projects that involve the use and application of TK/GR. The training will enhance the negotiation capacity of the different stakeholders as well as it will allow indigenous people to understand the other side of this topic. In addition, the government should work on incentives to motivate bioprospectors to come to Ecuador and develop strategic partnerships with the country. For example, tax exemptions can be a mechanism to attract investors and researchers.

Finally, in order to use bioprospecting as a mechanism to encourage innovation, we need to work beyond the access, benefit and sharing. In this regard, it is necessary that biodiversity and bioprospecting become a strategic resource, not only in the law but also in the practice. In this way political support is crucial, since it will contribute to biodiversity management and to develop strong intellectual property systems to protect the products of innovation. Moreover, biodiversity rich countries should see bioprospecting as the cornerstone for innovation; therefore, they should work in different schemes

and proposals to facilitate access to genetic resources and promote technology transfer. In this regard, it is crucial to develop creative agreements, concepts, educational campaigns to teach the community about the advantages and pros of bioprospecting, and marketing strategies to allow bioprospectors to take knowledge of the country, its resources and the advantages that the country provides. For instance, the ICBG Project is a role model, because it incorporates diverse mechanisms for the protection of traditional knowledge. In this project, prior informed consent was required for access to genetic resources and traditional knowledge. Agreements containing the principles of access and benefit-sharing were also signed by the parties, and existing intellectual property rights as patents were used to protect traditional knowledge and guarantee fair compensation to traditional knowledge holders.[35]

Furthermore, the construction of strategic alliances between the academia, civil society, indigenous communities and private organizations is important in order to develop true technology incubators. A project conceived for the public interest, but considering the needs, rights and interest of the different stakeholders is the only way to promote development and to build an industry around genetic resources that can benefit the entire society.

35 *See* Walter H. Lewis & Veena Ramani, *Ethics and Practice in Ethnobiology: Analysis of the International Cooperative Biodiversity Group Project in Peru*, *in* BIODIVERSITY AND THE LAW 400-10, (Charles McManis ed., 2007).

References

Books

BROWN, MICHAEL F., WHO OWNS NATIVE CULTURE? (2003).

MILL, JOHN STUART, PRINCIPLES OF POLITICAL ECONOMY WITH SOME OF THEIR APPLICATIONS TO SOCIAL PHILOSOPHY (William J. Ashley ed., 7th ed. 1909) (1848).

OGUAMANAM, CHIDI, INTERNATIONAL LAW AND INDIGENOUS KNOWLEDGE: INTELLECTUAL PROPERTY, PLANT BIODIVERSITY, AND TRADITIONAL MEDICINE (2d ed. 2006).

PAN, PETER G., BIOPROSPECTING ISSUES AND POLICY CONSIDERATION (2006).

PORTER, GARETH, & JANET WELSH BROWN, GLOBAL ENVIRONMENTAL POLITICS (2D ED. 1995).

REID, WALTER V., ET AL., BIODIVERSITY PROSPECTING: USING GENETIC RESOURCES FOR SUSTAINABLE DEVELOPMENT (1993).

RURAL ADVANCEMENT FOUNDATION INTERNATIONAL, 1996 BIOPIRACY UPDATE US PATENTS CLAIM EXCLUSIVELY MONOPOLY CONTROL OF FOOD CROP, MEDICINAL PLANTS, SOIL MICROBES AND TRADITIONAL KNOWLEDGE FROM THE SOUTH.

SAMPATH, PADMASHREE GEHL, REGULATING BIOPROSPECTING (2005).

SENGUPTA, NIRMAL, ECONOMIC STUDIES OF INDIGENOUS AND TRADITIONAL KNOWLEDGE (2007).

SHIVA, VANDANA, BIOPIRACY: THE PLUNDER OF NATURE AND KNOWLEDGE (1997).

SINJELA, MPASI, HUMAN RIGHTS AND INTELELCTUAL PROPERTY RIGHTS: TENSION AND CONVERGENCES (2007).

WILSON, EDWARD O., THE DIVERSITY OF LIFE (1992).

WORLD INTELLECTUAL PROPERTY ORGANIZATION, INTELLECTUAL PROPERTY AND TRADITIONAL KNOWLEDGE (2011).

Works in Collection

Adebiyi, A., et al., *Uterine Stimulating Effects of Crude Latex of Carica Papaya L., in* ETHNOBIOLOGY AND BIOCULTURAL DIVERSITY: PROCEEDINGS OF THE SEVENTH INTERNATIONAL CONGRESS OF ETHNOBIOLOGY 299 (John R. Stepp et al. eds., 2002).

Biber-Klemm, Susette, & Berglas, Danuta Szymura *Problems and Goals, in* RIGHTS TO PLANT GENETIC RESOURCES AND TRADITIONAL KNOWLEDGE: BASIC ISSUES AND PERSPECTIVES 3 (Biber-Klemm et al. eds., 2006).

Bravo, Elizabeth, *La Bioprospeccion en el Ecuador, in* BIODIVERSIDAD, BIOPROSPECCION AND BIOSEGURIDAD 131 (Ana Maria Varea ed., 1997).

Eisner, Thomas, *Chemical Prospecting: A Proposal for Action, in Ecology*, ETHICS AND ECONOMICS: THE BROKEN CIRCLE 196 (F. Herbert Bormann & Stephen R. Kellert eds., 1991).

McManis, Charles R., *Fitting Traditional Knowledge Protection and Biopiracy Claims into the Existing Intellectual Property and Unfair Competition Framework*, in INTELLECTUAL PROPERTY AND BIOLOGICAL RESOURCES 425 (Burton Ong ed., 2004).

Rios, Monserrat, *Plantas Utiles del Ecuador:Uso y Abuso*, in CONOCIMIENTO TRADICIONAL Y PLANTAS UTILES DEL ECUADOR 11 (Rios, Cruz & Mora eds., 2008).

Journal Articles

Bravo, Elizabeth, *Biopiratería o "Buen Vivir". El caso de Ecuador*, 107 ESPECIAL 69 (2009).

Karasov, Corliss, *Who Reaps the Benefits of Biodiversity?,* 109(12) ENVIRONMENTAL HEALTH PERSPECTIVES A582 (2001).

McHugh, Carol, *Separating Commercial Parroting from Pirating: Board of Trade v. Dow Jones & Co*., 33 DEPAUL L. REV. 595 (1984).

FACILITATING ACCESS TO KNOWLEDGE FOR EDUCATION IN VIETNAM THROUGH RE-CONSTRUCTING APPROPRIATE LIMITATIONS AND EXCEPTIONS TO COPYRIGHT

Nhan T. T. Dinh*

Contents

* Law Lecturer, Vietnam University of Commerce.
Submitted date: May 12, 2016; Accepted date: July 21, 2016.

ABSTRACT

This Article provides detailed recommendations of re-structuring copyright limitations and exceptions in Vietnamese copyright law so that it can support for education by ensuring the public can access to knowledge. Although Vietnam has recently made significant achievements in increasing living standards and reducing poverty, educational development in this country Vietnam is typically slow and outdated.This country has a large amount of unskilled people that have been exploited by other countries for cheap labor. While Vietnam has had economic growth in the short term, this is not truly development in the long term and will not last. Many reasons contribute to this problem, but the most important reason is the shortage of advanced knowledge in textbooks and other educational materials. Access to cultural works for education is significantly restricted because of copyright protections. This Article argues that copyright limitations and exceptions can provide the possibility of accessing and using copyright works for educational purpose with free of charge or reasonable compensation to the copyright owner. In doing this enhance access to knowledge for learning in this country.

This Article examines knowledge access demand for education in Vietnam. Currently, Vietnam is confronting the shortage of knowledge access for education, especially higher education. This shortcoming partly stems from strict copyright protection so that educational sector cannot afford to access on

fresh knowledge expressed in copyright works. Reconstructing limitations and exceptions to copyright toward enlarging their scope are a good solution to resolve access issue in Vietnam. This Article provides main suggestions: (1) adopting fair use; (2) introducing licensing schemes for educational institutions; (3) broadening the rights for libraries in serving customers for educational purpose; and (4) raising its voice in copyright international arguments for supporting education in developing countries

Keywords: Vietnam copyright limitations and exceptions, copyright and education, three-step test, fair dealing, fair use, limitations and exceptions for libraries.

知識接觸與越南教育－以著作權的限制與例外之法制重構爲中心

Nhan T. T. Dinh*

摘　要

本文討論越南著作權法對教育上接觸知識的限制，並提出相關的改革建議。

關鍵字：合理使用，越南，著作權法，教學

* 越南商業大學法學院法學講師
投稿日期：2016年5月12日；接受刊登日期：2016年7月21日

I. Introduction

Education, in every sense, is one of the important elements for development. It is recognized as the key to achieving many development goals. It empowers people to develop personal skills and behaviors, as well as a sense of dignity.[1] It enriches people's knowledge and understanding of the world. It improves the quality of their lives and benefits every individual and the society.[2] Moreover, it is a human right, as well as an indispensable means to realize other human rights, according to the United Nations.[3] Thus, education plays a crucial role in promoting people's creativity and social progress.

Education plays a central role in Vietnam culture and society. It is considered as the avenue of advancement and families routinely sacrifice much to ensure their offspring get the required education. The government of Vietnam has constantly set education as a top priority in the country's development both in strategy papers and its budget allocation.[4] The great efforts have brought significant achievements in education with increased enrolment and improved teaching and learning condition.[5] However, Vietnam's education, especially

---

1 Committee on International Covenant of Economic, Social and Cultural Rights, Dec. 16, 1966, 993 U.N.T.S No. 03.

2 Ilhan Ozturk, *The Role of Education in Economic Development: A Theoretical Perspective*, 23 (1) J. RURAL DEV. & ADMIN. 39, 39 (2001).

3 General Comments No. 13, The Right to Education (Article 13 of the Covenant), at 112-127UN Doc. E/2000/22, Report of the Committee, Social and Cultural Rights, 21st sess., 1999.

4 Vietnamese government has increased the expenditure for education from 13% to approximately 20% of its State Budget. Vietnam has fallen into one of the top countries spending for education. H. Hanh, *Vietnam Is in the Top Group Spending For Education,* TINMOI NEWSPAPER, (Apr. 20, 2010, 03:43), http://www.tinmoi.vn/Viet-Nam-thuoc-nhom-nuoc-co-ty-le-chi-cho-giao-duc-cao-nhat-the-gioi-01154100.html;In 2015, Vietnam maintains 20% of State Budget spending for education. *Vietnam Maintains 20% of State Budget Spending for Education in 2015*, VUFO-NGO RESOURCE CENTRE, http://www.ngocentre.org.vn/news/vietnam-maintains-20-state-budget-spending-education-2015(last visited July 17, 2016).

5 *Vietnam Development Report 2014 - Skilling up Vietnam: Preparing the Workforce for a Modern Market Economy*, WORLD BANK (Nov. 2013), www-wds.worldbank.org/external/

higher education, is still facing mismatches in meeting the needs for industrialization, modernization and international economic integration. This shortcoming mainly stems from out of date teaching and learning methods, limited resourced for education and in efficient resources. It thus requires further strengthening of education system by improving capability of knowledge access in educational institutions including obtaining access to textbooks, journal articles, educational computer programs and other educational materials.

Increasing access to textbooks and other educational materials requires educational institutions to obtain permission and pay royalties as compensation to the copyright owner under protections of copyright, thus educational institutions with modest financial budget cannot afford. Fortunately, it is possible for educational institution to take advantages of limitations and exceptions to copyright in order to get access and utilize copyright works without permission of copyright owners and free of charge or at a reasonable price. Copyright limitations and exceptions encourage learning and diffusion of knowledge with educational sector by providing privileges in favor of educational institutions and their students accessing copyright works.

However, current Vietnamese copyright law is not really supportive for educational access when its copyright limitations and exceptions are quite restrictive. Although, international and regional agreements that Vietnam has been signed, particularly Berne Convention, TRIPS Agreement contains flexibilities for the country to draft limitations and exceptions to copyright for educational purposes, Vietnam fails in implementing into its domestic law provisions of copyright limitations and exceptions when it provides inflexible and limited scope provision of copyright limitations and exceptions. Therefore,

default/WDSContentServer/WDSP/IB/2013/11/26/000461832_20131126115640/Rendered/PDF/829400AR0P13040Box0379879B00PUBLIC0.pdf.

this Article would like to introduce new version of copyright limitations and exceptions in Vietnamese copyright law so that it can support for education effectively.

This Article proceeds as follows. Part I provides the scene of Vietnam and identifies its special access need on educational materials. Part II sets forth the theoretical role of copyright limitations and exceptions in supporting education. Part III examines copyright limitations and exceptions in Vietnam. The Part reveals that Vietnamese copyright law implements international conventions very quickly, but it only considers increasing rights of copyright owners, not equally pay attention to the interest of the public through limitations and exceptions to copyright. This has led to impede knowledge flow within the society in general and hinder teachers and students to access to educational works in particular. Part IV then focus on how copyright limitations and exceptions should be re-constructed to support for education. Part V concludes findings of the study and some further research is recommended

II. Some Important Concepts

A. The "Limitations and Exceptions to Copyright"

This phrase has various meanings. It could be broadly applied to all limitations and exceptions existing in copyright law, but could be restricted only within the meaning of limitations and exceptions to exclusive rights of the copyright owner. Hence, this section aims to make it clear that this term is used in this article in the restricted meaning: limitations and exceptions that restrict the exclusive rights of the copyright owner. The term encompasses instances where a work may be used without permission and payment of remuneration – so-called "uncompensated limitations and exceptions" – as well as the case of so-called "statutory/compulsory licences", where the use of the work does not

require the author's permission but a reasonable payment needs to be made.

By 1994, the term "copyright limitations and exceptions" had not appeared in any jurisdiction, even in IP international treaties. By that time, it had been occasionally stated by IP scholars. This term was formally tracked by the establishment of the TRIPS Agreement, and then repeated in WIPO Treaties, including the WIPO Performances and Phonograms Treaty 1996 (WPPT), WIPO Copyright Treaty 1996 (WCT) and the Beijing Treaty. However, no definition of this term has been found. Additionally, 'there is no definition in the international and regional instruments of the difference between a "limitation" and an "exception".[6]

In this article, the terms "limitation" and "exception" embody different, but related, meanings. According to the Oxford English Dictionary, "limitation" refers to "a limiting rule or circumstance; a restriction";[7] whereas "exception" means "a person or thing that is excluded from a general statement or does not follow a rule".[8] There is a notable difference between a limitation and an exception: one is a restriction of a rule and the other is an exemption from a rule. Importantly, Lucie Guibault argued that "limitations" and "exceptions" are not to be taken as equivalents. The expression "limitations", which includes "exemptions" and "exceptions", refers to the restrictions imposed on the exercise of copyright owners" rights. Specifically, the term "exception" is used in some circumstances that do not follow the rule or are excluded from the application of the law.[9] Put differently, limitations to copyright draws a line that restrict

---

6 Adrian Sterling, World Copyright Law 434 (2003).

7 *Limitation*, Online Oxford English Dictionary, http://oxforddictionaries.com/definition/english/limitation (last visited July 17, 2016).

8 *Exception*, Online Oxford English Dictionary, http://oxforddictionaries.com/definition/english/exception?q=exception (last visited July 17, 2016).

9 Lucie Guibault, *Discussion Paper on the Question of Exceptions to and Limitations on Copyright and Neighbour Rights in the Digital Era*, at 7, Instituut voor Informatierecht (1998), http://www.ivir.nl/publications/guibault/final-report.pdf.

exclusive rights of the copyright owner, while exceptions to copyright emphasizes exempted circumstances that exclude the user from infringement of copyright. Ficsor stated that

> *In accordance with the ordinary meaning of the words, an "exception" means that the given acts are exempted from the application of the right concerned, while a "limitation" means that, although the right is applicable, it is limited in a certain way.*[10]

Ficsor refers to compulsory licenses as "limitations" and to the use without authorization and payment of remuneration as "exceptions";[11] that is to say, a "copyright exception" means that the given acts are exempted from the application of the right concerned. There is no authorization needed and there is no obligation to pay remuneration. Whereas, a "copyright limitation" means that, although the right is applicable, it is limited in a certain way. For example, an exclusive right is limited to a mere right to remuneration or to a compulsory license.

Although copyright limitations differ from copyright exceptions, they are both important for users to access copyright works. There is a body of cases where the user is not liable for doing what would otherwise be an exclusive right of the copyright owner. Starting from Article 13 of the TRIPS Agreement and then Article 10 of WCT, limitations and exceptions have been bundled together. WIPO states that copyright limitations and exceptions are "cases in which protected works may be used without the authorization of the right hold-

---

10 Mihaly J. Ficsor, *Short Paper on the Three-Step Test for the Application of Exceptions and Limitations in the Field of Copyright*, 2 (Working Paper for the Central and Eastern European Copyright Alliance (CEECA) in the 25th session of the WIPO Standing Committee on Copyright and Related Rights (SCCR), Geneva, Nov. 19-23, 2012).

11 *Id.* Mihaly J. Ficsor, The Law of Copyright and the Internet – The 1996 WIPO Treaties, Their Interpretation and Implementation 257 (2002).

er and with or without payment of compensation." They encompass a substantial use of copyright work but are exempted by special purposes, such as fair use or fair dealing and compulsory licenses. The combination of limitations and exceptions constitutes the bundle of users' rights to strike the balance with the exclusive rights of copyright owners.[12] The concepts are treated together in this article .

B. Fair Use

Fair use is one approach used in drafting copyright limitations and exceptions in national laws. The fair use doctrine was first codified in the Copyright Act of 1976 (USA), section 107. Under this provision, the use of a copyright work for criticism, comment, news reporting, teaching, scholarship or research was not an infringement of copyright if it satisfies the assessment of 'fairness' of the use based on a balancing of four factors:

(1) The purpose and character of the use, including whether such use is of a commercial nature or is for non-profit educational purposes. The preamble of section 107 offers various purposes favored by fair use, namely criticism, comment, news reporting, teaching, scholarship and research. However, the list in section 107 is not exhaustive, and other non-enumerated purposes will be examined.

(2) The nature of the copyright work. According to the Supreme Court, the major distinction in valuating this factor is whether the work is factual or fictional. For example, "informative works, such as new reports, that readily lend themselves to productive use by others, are less protected than creative works of entertainment."[13] Another consideration is whether the work is available to the public. Courts are less likely to find fair in the copying of an unpub-

12 Stephen M. Stewart, International Copyright and Neighbouring Rights 79 (1989).
13 Sony Corp. of Am. v. Universal City Studios, Inc., 464 U.S. 417, 496-97 (1984).

lished work. However, the fact that "a work is unpublished shall not itself bar a finding of fair use if such finding is made upon consideration of factors."[14]

(3) The amount and substantiality of the portion used in relation to the copyrighted work as a whole. This third factor requires the courts to consider whether the amount of use is reasonable in both qualitative and quantitative terms.[15]Whether the amount used is reasonable must be determined in light of the size of both the copyrighted work and the work in which it is used, and the economic effect of the portion taken to both works.[16] For example, the amount used will be favored by fair use if it is a small quantity and likewise if the portion used is not central or significant to the entire work. In contrast, it will be rejected as a fair use if the portion used is central or the heart of the original work.[17]

(4) The effect of the use upon the potential market for or value of the copyrighted work. This factor requires the courts to consider not only the extent of harm caused by the use, but also "whether unrestricted and widespread conduct of the sort engaged in by the defendant…would result in a substantially adverse impact on the potential market for the original."[18]

It is worth noting that the assessment of the four factors in determining fair use is not exhaustive, but the courts are required to consider the factors together.[19]Should one factor fail to satisfy the fair work doctrine, then one must look to the other factors.[20]Indeed, the endless variety of situations and com-

14 17 U.S.C. §107 (2013).
15 7 U.S.C. §107(3) (2013). *See also* L.Ray Patterson & Stanley W. Lindberg, The Nature of Copyright: A Law of Users' Rights 202 (1991).
16 *Id.* at 203.
17 Bill Graham Archives, LLC v. Dorling Kindersley Ltd., 448 F.3d 605 (2d Cir. 2006).
18 Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 590 (1994).
19 It was noted in H.R. Rep. No.94-1476, at 65 (1976). It was also emphasized in *Sony Co.*v. Universal City Studios, 464 U.S. ¶ 79 (1984).
20 Patterson & Lindberg, *supra* note 15, at 202.

binations of circumstances that can arise in any particular case preclude the formulation of an exact rule.[21]This means that whether a particular use is a fair use is, to a large extent, a matter of judgment.

C. Fair Dealing

Fair dealing is the other approach used in drafting copyright limitations and exceptions in national laws. The fair dealing defense was first developed by section 2(1)(i) of the Copyright Act 1911 (UK), which provided that "any fair dealing with any work for the purposes of private study, research, criticism, review or newspaper summary"[22]would not constitute an copyright infringement. Under fair dealing, what constitutes fairness is determined by permitted purposes. Fair dealing, therefore, is recognized by its closed-ended mechanism. National legislations that employ the fair dealing approach provide a closed list of limitations and exceptions to copyright. Fair dealing privileges for the specific purposes of criticism or review, research and study, parody or satire, and reporting news are recognized in many countries.[23]

There are some positive aspects of fair dealing: they are explicit and predictable. In determining whether a use comes within the bounds of a fair dealing defense, the courts apply a two-step process.[24]First, the use must be for one of the specific purposes provided for in the national copyright act (or a closed-list copyright limitations and exceptions' provision). For example, a closed list of copyright limitations and exceptions in Vietnamese copyright law is regulated in Article 25-26 of the Law on IP 2005 (revised in 2009).In order to con-

---

21 *Id.* at 66.

22 Section 2(1)(i) of the *Copyright Act 1911* (UK), an Act to Amend and Consolidate the law Relating to Copyright.

23 Australia, for example, inserted new provisions permitting fair dealings with copyright materials for purposes of parody or satire in the *Copyright Amendment Act 2006 (Cth)*, section 41A.

24 ALRC, *Copyright and the Digital Economy*, Discussion Paper No.79, at 133 (2013).

clude a use as fair dealing, the Vietnamese courts must consider whether the use is for one of the purposes such as research or teaching, criticism or review, and so on. If the use falls into a purpose provided by the Law on IP 2005 (revised in 2009), it might be a legitimate if it satisfies the second process: the use must be fair. The question whether a particular use is fair will depend on the circumstances of the case, subject to guidance as to fairness stipulated by legislators. For example, in the fair dealing exception for the purpose of research or teaching in Vietnamese law, matters to be considered are that only one copy allowed is allowed and that copy must not be for a commercial purpose. Fair dealing for the purpose of criticism or commentary must be the quotation of 'reasonable portion without misrepresenting authors' views.[25]

However, the fair dealing defense has been criticized as restrictive as it is unable to be developed by the courts. The use of the work for any other purpose is never considered, even though it may be fair. Moreover, the fair dealing approach is not sufficiently broad to provide an effective balance between owners and users in the digital environment. It is not flexible enough to respond to changing circumstances caused by new technologies and uses. This issue will be discussed further below.

III. Special Access Needs of Vietnam to Copyright Works For Education

With a population of approximately ninety million people, ranked the eight-most populous Asian country, Vietnam has achieved fabulous economic growth performance in two recent decades: more than 7% on average in

25 Article 25(1)(b) of the *Law on IP 2005* (amended in 2009).

2000s,[26] GNI per capita reached over $1,000 in 2010,[27] and became a lower middle-income country in 2011.[28] The Vietnamese government has consistently given high priority to education. As a result, Vietnam has had remarkable progress in improving access to education with over 90% of the working-age population is literate.[29]

Despite the substantial progresses, Vietnam urgently requires access to advanced textbooks and educational materials for education in order to resolve the shortage of skilled labor in this country that threat to spread poverty both in urban and rural areas. Currently, the percentage of unskilled laborers has been significantly increased. This figure of 66% of the total workforce in 2006 was grown up to over 70% in 2009.[30] According to World Bank, Vietnam ranks on the bottom half of the rankings about ASEAN labor force development.[31] This is rooted from the wave of rapid shift of employment out of low productivity agriculture into higher productivity industrial fields in recent years. The rapid economic growth of Vietnam in the last ten years has been driven predominantly by the huge size of its workforce with youth population, as a large number of unskilled workers have been exploited by other countries for cheap labor.

---

26 GDP growth averaged around 9% per year from 1993 to 1997, 6.8% per year from 1998 to 2004, 8% in 2005 and 7.8% in 2006.. This economy was evaluated 10 times in late-1980s to 2006, at $61 billion, making Vietnam the 58th largest economy in the world in this year, up from 76th in 1986. Growth remained strong even in the face of the late-2000 global recession, holding at 6.8% in 2010 and 5.8% in 2011. *2011 Social-Economic Statistical Data*, General Statistic Office of Vietnam, http://www.gso.gov.vn/default.aspx?tabid=622&idmid=&ItemID=12133 (last visited July 17, 2016); *The World Factbook: Vietnam, Centre Intelligent Agency*, https://www.cia.gov/library/publications/the-world-factbook/geos/vm.html (last visited July 17, 2016).

27 *GNI per capita, Atlas Method (Current US$)*, World Bank, http://data.worldbank.org/indicator/NY.GNP.PCAP.CD (last visited Sept. 3, 2015).

28 *Overview of Vietnam*, World Bank, http://www.worldbank.org/en/country/vietnam/overview (last visited July 17, 2016).

29 See *supra* note 5.

30 *Growing Pool of Unskilled Labour Left behind in Vietnam*, The Rockefeller Foundation, http://www.searchlightcatalysts.org/node/310 (last visited July 17, 2016).

31 For example, unskilled workers are counted for 41.4% in Hanoi, 54.5% in Ho Chi Minh city, 62.9% in Vung Tau, and 64% in Haiphong. See *supra* note 5.

For long term development, Vietnam has been experiencing an unsustainable economic development,[32] because it cannot continue to rely on the size of its workforce for continued success when "golden population" becomes fade. Vietnam needs to focus on equipping its workforce with more skill-intensive non-manual jobs in the coming decades. Future growth is highly dependent on a high quality workforce who is better skilled and trained in modern education and with better quality language skills.According to Vietnam Works, a biggest Vietnam-based recruiting company, the number of skilled jobs posting in Vietnam increased by 23% in the first half of 2014 in compared to the same period last year, jobs mainly in IT, software and marketing. Unfortunately, many companies have not found it easy to recruit staffs due to low supply of necessary skills such as language, cognitive, behavioral and technical skills.[33] Local employees are not up to date with the latest information and technology as well as lack important knowledge in law and finance. To deal with the skilled worker shortage, many companies in Vietnam have spent a huge amount of money annually on retraining their employees.[34] This solution is not long-term effective. It must be done by renovating higher education in Vietnam, because a key reason for the lack of skilled workers in Vietnam is outdated education system. Although budget allocation has reserved high priority to education,[35] spending

---

32 Vietnam is in the period of "golden population structure" where fore every two people or more working, there is only one dependent person. *Population and Development*, UNFPA Vietnam, http://vietnam.unfpa.org/public/lang/en/pid/5571(last visited July 17, 2016); *Golden Population Begins to fade*, Vienam News, (May 28, 2014), http://vietnamnews.vn/opinion/255446/%E2%80%98golden-population-begins-to-fade.html.

33 According to recent World Bank Report, less than 15% of the labour force is competent to English and computing skills in Hanoi. See *supra* note5.

34 According to Nicola Connolly, Vice Chair of the European Chamber of Commerce, foreign companies in Vietnam are forced to spend money for retraining 40-50% of their Vietnamese *employees.SeeForeign Companies Report Labor and Skills Shortage in Vietnam,* Vietnam Briefing (July 30, 2014), http://www.vietnam-briefing.com/news/foreign-companies-report-labor-skills-shortage-vietnam.html/.

35 Vietnam has been fallen into top countries spending governmental budget for education in the world. Within 12 years (from 1998 to 2010), the country invested the total budget

money for knowledge access such as buying textbooks and other educational materials is not really noticeable by the Vietnamese government. The state budget has been mainly spent on improving school's infrastructure, school attendance rate, and expansion in the number of universities and colleges rather than focusing on the quality of education.[36] As a result, the quality of education is yet to meet the demand and development of the country. It was reported by VTC News that majority of textbooks used by Vietnamese universities are imported and translated from Russia, China and East-Europe since 60s- 70s of the last century.[37] Urgently, Vietnam needs to cut off out of date curriculum content and improving teaching and learning methods by accessing latest textbooks and other educational materials in order to help Vietnamese student to become more effective problem-solvers, critical thinkers, better communicators, and updated fresh knowledge learners.

Furthermore, accessing to copyright works for education is highly required due to the demand of acquiring knowledge for everyday self-education of Vietnamese people. Deep influence of Confucianism values and ideals imported from China,[38] Vietnamese people have a great love of learning. They

for education from 13% to 20%. The state budget for education has been down to 10% from 2013, but investment for education is still a top priority in Vietnam for the purposes of poverty reduction and industrialisation. See *supra* note 5.

36 *High Quality Education for All Should Be Vietnam's Priority*, WORLD BANK (Apr. 25, 2012), http://www.worldbank.org/en/news/feature/2012/04/25/high-quality-education-for-all-should-be-vietnams-priority.

37 Binh Na, T*extbooks Invested Millions VND Are Still Outdated,* VTC NEWS (Jan. 3, 2009), http://vtc.vn/dau-tu-tien-ti-giao-trinh-van-lac-hau.2.203143.htm (translated from Vietnamese language).

38 The Vietnamese people became independent from China in 938 AD and extended geographically into Southeast Asia, throughout the Indochina Peninsula. *Brief History of Vietnam*, VIET VENTURES, www.vietventures.com/Vietnam/history_vietnam.asp (last visited July 17, 2016); Gowming Donget al., *Knowledge-Sharing Intention in Vietnamese Organisations*, 40 VINE 262, 270 (2010); Que Thi Nguyet Nguyen et al., *The Inter-Relationships between Entrepreneurial Culture, Knowledge Management and Competitive Advantage in a Transitional Economy*, http://artsonline.monash.edu.au/mai/files/2012/07/qtnguyetnguyen.pdf (2008).

believe that "the only way for the superior man to civilize the people and establish good customs is through education."[39] For the love of learning, people desire to obtain knowledge. As a result, the country presents a high demand for gaining access to knowledge. It was reported by Cimigo that Vietnam has experienced rapid growth of internet penetration over the last few years, similar to China, the Philippines, and Thailand. The most important activity of the population on the internet is information and knowledge gathering.[40] However, the population of Vietnam is struggling with collecting fresh knowledge and information due to barriers of languages as well as copyright protection.

IV. Copyright Limitations and Exceptions Can Support Access to Copyright Works for Education in Vietnam

Educational activities have a strong connection to copyright. Indeed, to catch the student's attention and to improve their learning skills, educators rely heavily on contemporary books, newspapers, magazines, photographs, video, slides, sound recordings, broadcasting programs, and other media.[41] In practice, schools make millions of photocopies of copyright material in Vietnam every year. Moreover, the performance of works, the diffusion of radio or television broadcasts, and the communication of video or sound recordings are particularly suitable for teaching in a classroom environment.

Copyright limitations and exceptions support education by allowing stu-

---

39 Lin Yutang, The Wisdom of Confucius 200 (Michael Joseph ed., 1958). This idea is very important to support flexible and broad limitations and exceptions to copyright for education, because this country considers education the priority. Its opinion is heavily influenced by Confucius.

40 *2011Vietnam NetCitizens Report: Internet Usage and Development in Vietnam*, Cimigo (2011), http://www.cimigo.com/en/research-report/vietnam-netcitizens-report-2011-english.

41 Educational Multimedia Fair Use Guidelines Development Committee, *Fair Use Guidelines for Educational Multimedia*, July 17, 1996, §12.

dents, as well as educational institutions, to obtain knowledge without prior permission from copyright owners. From the Statute of Anne 1709, the encouragement of learning and dissemination of knowledge as a means to enhance the general welfare have been the chief goals behind the granting of exclusive rights to authors.[42] To implement this goal, a number of limitations and exceptions are established to carry out the government's information policy of dissemination of knowledge and information among the members of society.[43] First of all, there are limitations and exceptions for anybody to quote excerpts of cultural expression for the purpose of learning or criticism. This helps learners to achieve knowledge and improve their skills, which are essential for their lives. Moreover, privileges in favor of schools, universities, other educational institutions, public libraries, archives, and handicapped persons are those limitations and exceptions encouraging the spread of knowledge and information within the educational sector. Sustained access to educational knowledge is critical to long term improvements in productivity, preventive health care, the empowerment of women, the reduction of backwardness, and reductions in inequality.[44] More importantly, information society information is currently converted into the raw material of economic activity in order to create wealth. There is no doubt that access to a broad and diverse supply of information is extremely important for the citizens of society.[45] Dissemination, therefore, is a public good.[46] It is beneficial for both individuals and social growth. It enables

---

42 Preamble of the *Statute of Anne 1709.*

43 Within the international framework, *Article 10(2) of the Berne Convention* for the Protection of Literary and Artistic Works provides a provision called the "illustration for teaching". This provision opens potential policy space for signatory nations to mandate access to educational materials for development needs.

44 *Why Access to Education Is Important*, Consortium for Research on Educational Access, Transitions and Equity, http://www.create-rpc.org/about/why/ (last visited July 17, 2016).

45 Peter Lyman, *The Article 2B Debate and the Sociology of the Information Age*, 13 Berkeley Tech. L.J.1064, 1069 (1998).

46 Benedict Atkinson & Brian Fitzgerald, *Copyright as an Instrument of Information Flow*

individuals in society to understand, learn, and express.

Additionally, copyright limitations and exceptions, to some extent, are expected to be free in reproducing works for education, which is compatible with Vietnamese culture. As a matter of culture, Vietnamese people are in favor of free reproduction of expression for education. Confucius stressed repetition or memorization as the important methods of acquiring knowledge. Hence, in Confucian-based societies such as Vietnam, "the development of the ability to use imitation and repetition as an aid to learning is encouraged."[47] People are encouraged to learn and reproduce other expressions accurately. For example, at school, education is based on examination and memorisation, students are expected to have great knowledge rather than critical thinking. As a result, in terms of education, there is no shame if someone incorporates or uses someone else's work into their own works without permission. Moreover, the authors whose works are reproduced in classes without permission are generally more proud than hurt.It is also necessary to say that promotion of learning and respect of teachers are one of the traditional values of the Vietnamese people.[48] Furthermore, education has been prioritised in Vietnam for a thousand years, and teachers are highly respected as "father" or "the engineers of the human soul" or "being a teacher for one day, being the father for life."[49] In govern-

*and Dissemination: The Case of ICE TV Pty Ltd v. Nine Network Australia Pty Ltd (*2008*),* QueenslandUniversityof Technology, http://eprints.qut.edu.au/15208/1/1520'8.pdf.

47 Purdie Nola, *Education Statistics–News Sheet*, 4(6) Data Management Unit, Ministry of Education3 (1995).

48 *Education in Vietnam: Development History, Challenges and Solutions*, World Bank (2005) http://siteresources.worldbank.org/EDUCATION/Resources/278200-1121703274255/1439264-1153425508901/Education_Vietnam_Development.pdf.

49 The father of Confucianism, Confucius (551-479 BC), was a Chinese philosopher. It is worth noting that Vietnam, throughout history, has been heavily influenced by Chinese culture, particularly in the education sector. In the past, China was the cradle of Eastern Philosophy, especially Confucianism, which was created in China. Vietnam was heavily influenced by this school of thought. Confucianism was used as the main contents of education through Feudal Vietnam until 1945. Despite occupation by the French from

ment policy, education has been esteemed as the prime priority of Vietnam and it is a foundation to promote the culture and economic development of the country.[50] In short, both the public and the State recognise that education has important social benefits and the relevant uses of copyrighted works should be exempted from the usual legal obligations. In the other words, the use of copyrighted works should be treated to be free for education. Provisions of copyright limitations and exceptions for education provide educational institutions with the right to access copyright work "without the consent from, and without the payment of remuneration to, the copyright owner."[51] For instance, copyright limitations and exceptions in many cases provide rooms for students reproducing cultural works during studying and examination. Also, for the purpose of education, teachers are allowed to freely reproduce works in classrooms in the course of teaching.

V. Copyright Limitations and Exceptions in Vietnamese Copyright Law

Due to high demand of knowledge access for education, there is an expectation that Vietnamese copyright law should be introduced in a way that facilitates the knowledge demand for education. Unfortunately, copyright law in Vietnam is currently extremely restrictive, skewed towards knowledge privatisation, and pays little attention to access for education.

In the effort of joining the WTO and implementing its law in accordance

---

1889, two education systems existed in parallel in Vietnam, one taught Confucianism and the other was taught by the French. To date, Confucian educational philosophy has strongly influenced the educational policies of Vietnam. James A. Crites, *Confucianism and Its Spread to Vietnam*, ANGELFIRE COMMUNICATIONS, http://www.angelfire.com/ca/beekeeper/cf.html (last visited July 17, 2016); *Confucianism*, WIKIPEDIA, http://en.wikipedia.org/wiki/Confucianism, (last visited July 17, 2016).

50 *The Education Law 2005* (amended 2010) art. 9.

51 Article 25(1) (d), (g) and 32 (1) (b) of *the Law on Intellectual Property 2005.*

with the Bilateral Trade Agreement (BTA) VN-US, a separate IP law called the Law on IP 2005 was introduced, which is stricter than ever before.[52] It introduced the broad bundle of exclusive rights for copyright owners, both economic rights (the right of making a derivative work, right of reproduction, right of distribution, right of communication to public, right of rental, and right of exhibition) and moral rights (right to title the work, right to attachment, right to publication, and right of integrity). All exclusive rights of the copyright holder extended by TRIPS are included in Vietnamese copyright law. The term of protection is 50 years, plus the lifetime of the author; or 75 years from the date of first publication for cinematographic works, photographic works and works of applied art, and anonymous works. In accordance with international convention, works of foreign authors are protected the same way as domestic authors if the authors are citizens of countries that have agreements with Vietnam or are member of the same conventions that Vietnam is a party to. Additionally, infringement of copyright in Vietnam is able to be concluded either through civil[53] or criminal liability.[54] International copyright obligations set out by Berne, Rome, TRIPS, WCT and WPPT are overprotective.[55] They believe

---

52 *Overview of Copyright in 2008,* Copyright Office of Vietnam, http://www.cov.gov.vn/cbqen/index.php?option=com_content&view=article&id=769&catid=49&Itemid=96(last visited July 17, 2016).

53 Decree 131/2013/ND-CP on Administrative Penalties for Copyright and Related Rights Infringement, *come into force* Dec. 15, 2013*, available at* http://www.cov.gov.vn/cbq/attachments/article/1337/ND131.pdf.

54 *The Criminal Code 2009* art. 170(1).

55 Ruth L. Okediji, *The International Copyright System: Limitations, Exceptions and Public Interest Considerations for Developing Countries2*, http://unctad.org/en/docs/iteipc200610_en.pdf (ICTSD Issue Paper No. 15, 2006); Lauren Loew, *Creative Industries in Developing Countries and Intellectual Property Protection,* 9(1) VANDERBILT J. ENT. &TECH. L.171, 177 (2006); Michael J Finger, *Introduction and Overview*, IN POOR PEOPLE' S KNOWLEDGE: PROMOTING INTELLECTUAL PROPERTY IN DEVELOPING COUNTRIES 1, 1 (2004); Marci A Hamilton, *The TRIPS Agreement: Imperialistic, Outdated, and Overprotective*, 29 VAND. J. TRANSNAT'L L. 613, 615 (1996); Andreanne Leger, *The Roles of IPRs for Innovation: A Review of the Empirical Evidence and Implications for Developing Countries* (GERMAN INSTITUTE FOR ECON. RES. DISCUSSION PAPER NO. 707, 2007); Carsten Fink & Carlos A Primo Braga, *How Stronger Protection of IPRs Affects International*

that overprotective international copyright is actually generated by developed countries and then forced onto the developing world, which differsignificantlyfrom the developed world in levels of development, politics, and culture.[56] Academics therefore object the view of "one size's Western-style IPRs fit for all".[57]

Despite overly strong protection, piracy and Intellectual Property Rights(IPR) infringements are still widespread in Vietnam. The piracy rates in the software industry and music industry were recorded at 84% and 90% respectively. Book and journal publishers also suffer from uncontrolled piracy, in the form of illegal reprints, translations, and photocopies. Approximately 90% of the English language teaching works have been disseminated without authorization.[58] In terms of enforcement, despite making a lot of effort, there has been little positive recent development. The Copyright Office of Vietnam in its 2008 reports admitted that "the Inspectorate of the Ministry of Culture, Sports & Tourism (MOCST) has made every effort, but is unable to meet the requirement to establish order in the field of copyright and strictly handle the organizations and individuals who violate copyright and related rights".[59] Such issues remain of concern to the United States, leading the Office of the US Trade Representative to place Vietnam on its Special 301 Report "Watch List"

Trade Flows 19-22 (World Bank Pol'y Res. Working Paper, 2005); Rami Olwan, *Intellectual Property and Development: Theory and Practice16* (May 2011) (PhD Thesis, Queensland University of Technology).

56 *Id.*

57 Loew, *supra* note 33, at 185; Madhavi Sunder, *IP3*, 59(2) Stan. L. Rev. 257, 260 (2006); Keith E. Maskus, *Intellectual Property Rights and Economic Development*, 32 Case Western J. Int'l L. 471, 473 (2000).

58 *International Intellectual Property Alliance, Special 301 Report on Copyright Protection and Enforcement 2010*, Office of the United States Trade Representatives (2010), http://www.ustr.gov/about-US/press-office/reports-and-publications/2010/2010-special-301-report.

59 *See supra* note 52.

of Nations whose IPR practices remain inadequate.[60] As a result,Dr. Vu Manh Chu, General Director of the Copyright Office of Vietnam, said thatthe violations have negative effects on creative activities, the investment environment, social and cultural development, and the nation's integration into the world economy.[61]

In seeking an answer for the rampant copyright infringement in Vietnam, some blame ineffective enforcement.[62] However, the most important reason is that the Vietnamese copyright system is tremendously imbalanced. Too much protection is provided for the copyright owner, while there are few workable limitations and exceptions to copyright. Consequently, ordinary people have had their rights to access taken away by the shortage of important limitations and exceptions, in addition to the impractical and small scope of existing limitations and exceptions, which forces them to seek an alternative, illegal method.Vietnamese legislators have not paid attention to drafta proper set of copyright limitations and exceptions that provide true rights for users to legitimately access cultural expressions.

Currently, copyright limitations and exceptions in the Law on IP 2005 are double the provisions givenpreviously. They are applied by new regimes of either uncompensated or compensated schemes. Unfortunately, the educational limitations and exceptions do not reflect what Vietnamese people expect, as

60 *International Intellectual Property Alliance, Special 301 Report on Copyright Protection and Enforcement 2011*, Office of the United States Trade Representatives (2011), http://www.ustr.gov/about-USE/press-office/reports-and-publications/2011/2011-special-301-report.

61 *Vietnam to Clamp Down on Copyright Infringement,* Vietnamnews.biz (Jan. 09, 2009) , http://www.vietnamnews.biz/Vietnam-to-clamp-down-on-copyright-infringement_51.html.

62 IIPA, for example, it has been concluded in their reports every year that the reason for piracy in Vietnam has weak enforcement of copyright law. See more at IIPA Reports from 2001-2014 at www.iipa.com.

they are rather unclear, narrow in scope, and lack important provisions.

A. The Failure of Implementing the Three-Step Test

In implementing international obligations, Vietnam makes its copyright limitations and exceptions more restrictive. As an international obligation, drafting copyright limitations and exceptions Vietnam is bound by the three-step test under Berne Convention and TRIPS Agreement.[63] Vietnamese legislators attempted to adopt international standards into its domestic law, but the adoption is imperfect. It repeats the three-step test verbatim in the law. The simplicity of the limitations and exceptions' provisions not only limits the number of applicable limitations and exceptions, but also restricts the scope of each of the limitations and exceptions. The three-step test of Berne creates an additional condition that specific limitations and exceptions must satisfy, as it is inserted at the end of its closed list of limitations and exceptions.[64] Vietnam limitations and exceptions are subject to double tests: one test is set up under each particular limitations and exceptions and then has to comply with the second test: the three-step test. In Geiger, Gervais, and Senftleben's words, the three-step test "serves as a further restriction imposed on national limitations and exceptions".[65] The Vietnamese situation is similar to theChilean IP

63 The three-step test was first set out in the *Berne Convention* 1971 and then adopted in the TRIPS Agreement and other copyright agreements. Article 9(2) of Berne (approved by the Paris Act 1971) introduced setting out the general rule, with three requirements that must be satisfied for an exception or limitation of the reproduction to fall within the range of circumstances envisaged by the rule. Today this rule is known as the three-step test: It shall be a matter for legislation in the countries of the Union to permit the reproduction of such works in certain special cases, provided that such reproduction does not conflict with a normal exploitation of the work and does not unreasonably prejudice the legitimate interests of the author.
The three conditions set forth in the test are: (1) certain special cases, (2) no conflict with a normal exploitation, and (3) no unreasonable prejudice to the legitimate interests of the author/right holders.

64 Art. 25 (2) and 26 (2) of the *Law on IP 2005.*

65 Christophe Geiger et al., *The Three-Step Test Revisited: How to Use The Test's Flexibil-*

Law in 2003. The attention of implementing the three-step test was traced in the amendment of Chilean IP Law 1970 in 2003 that brought the legislation signed by Chile into accordance with the Agreements of the WTO,[66] including the TRIPS Agreements. Chilean lawmakers added a new Article 45bis that reproduced the treaties' language.[67] Article 45bis was criticized as "an extremely unfair test against the very few exceptions authorised by the law."[68] It requires the courts to exercise double tests for applying any exception, which is too strict and restricts the scope of limitations and exceptions to copyright.[69] The restriction of the application of limitations and exceptions raised by introducing the three-step test into its legislation was illustrated by the case of *Dao Thai Ton v. Nguyen Quang Tuan*.[70] In this case, the plaintiff, Nguyen Quang Tuan, claimed the defendant, Dao Thai Ton, had copied the full text of four articles of the plaintiff into the defendant's book "The Tale of Kieu – Research and Discussion". The plaintiff argued that the defendant illegally reproduces his works without his permission. However, the defendant believed that the use of Nguyen Quang Tuan's articles did not infringe copyright because it fell into the scope of limitations and exceptions to copyright in terms of quotation

---

ity in National Copyright Law, 29(3) AM. U. INT'L L. REV. 581, 583, 617-618(2014).

66 *Law No. 19.912 Bringing the Legislation Signed by Chile, in Accordance With The Agreements Of The World Trade Organization (WTO)*,WIPO, http://www.wipo.int/wipolex/en/details.jsp?id=5321(last visited July 16, 2016).

67 Article 45*bis* added by the *Law No. 19.912*:

> The exceptions established in this paragraph and in the following paragraph are lim ited to cases that do not conflict with normal exploitation of the work and do not cause unjustifiable damage to the legitimate interests of the copyright holder.

68 Daniel Alvarez Valenzuela, The *Quest for a Normative Balance: The Recent Reforms to Chile's Copyright Law*, ICTSD (Dec. 12, 2011), http://web.uchile.cl/archivos/derecho/CEDI/Art%EDculos/the-quest-for-a-normative-balance-the-recent-reforms-to-chilee28099s-copyright-law.pdf.

69 *Id.*

70 This case was initially held by the Hanoi People's Court, following this it was appealed and overruled by the Court of Appeal of the Supreme People's Court. See more at Judgement No. 127/2007/DSPT (June 14, 2007), http://www.ecap-project.org/sites/default/files/ip_case_law/VN_1-2-2007.pdf.

for the purpose of criticism. When this case brought to the courts, the courts had to follow to steps: (1) whether the use of the works fell into the closed list provided under Article 21 (1) of the Law on IP 2005. If the first step was satisfied, then the court needed to examine the three-step test added at Article 25 (2) Whether the right to quote/cite of the defendant has violated the three-step test or not. This means that limitations and exceptions for quotation have to pass two layers of restriction: one from the provision for quotation itself, and one from the three-step test. In this case, the courts had to pay attention to not only find out how much citation of the work is "reasonable",[71] but also to interpret three-step test. That is to say, adding the three-step test into legislation is wrong as it makes copyright limitations and exceptions more restrictive.

B. The Lack of Exception for Self-Study

The law does not cover limitations and exceptions for self-study circumstances, which impedes students gaining lawful access to cultural expression.[72] The laws only give users the right to make one copy for their own research and teaching without commercial purposes.[73] "Study"[74] is not included in the

---

71 Article 25 (1) (b).

72 Scholars in Vietnam concluded that the Law on Intellectual Property does not allow students to reproduce the copyrighted work for self-study purpose. *See* Ngoc Lam Nguyen et al., *Regarding the Reproduction Right in Education Environment*, 2 VIETNAMESE LEGAL J. 39 (2007).

73 Article 25(1) (a) of the Law on IP 2005. The word "research" is defined as "scientific research is the activity of discovering and inquiring into phenomena, things and laws of the nature, society and thought, and creating solutions for practical application. Scientific research includes basic research and applied research." The Law on Science and Technology 2000art. 2(4), *available at* http://www.wipo.int/clea/docs_new/pdf/en/vn/vn049en.pdf. "Teaching" is defined as "the imparting of instruction or knowledge; the occupation or function of a teacher." *Teaching*, OXFORD ENGLISH DICTIONARY ONLINE, http://www.oed.com/view/Entry/198356?rskey=gjkT4p&result=1&isAdvanced=false#eid (last visited July 17, 2016).

74 The word "study" is defined as "the application of mind to the acquisition of learning; mental labour, reading and reflection directed to learning, literary composition, invention, or the like." *Study*, OXFORD ENGLISH DICTIONARY ONLINE, http://www.oed.com/view/Entry/192083?rskey=RjTTg5&result=1&isAdvanced=false#eid (last visited July 17,

meaning of “research” or “teaching”. In the information age, students have a high demand for retrieving information and knowledge for study or greater production. However, they cannot afford to buy copyright works due to their modest budgets. Indeed, the majority of students in Vietnam are photocopying textbooks, articles, and lectures for their study. This has created an industry – the photocopying industry – that produces copies of works to fulfil students’ needs.[75] Such acts are obviously prohibited by the law. Therefore, many schools and universities of Vietnam have chosen to rent out places within their campus for the development of photocopying business, rather than provide photocopying services for students, in order to avoid copyright infringement issues. Moreover, some big state university libraries, such as the Vietnam University of Commerce and Hanoi Law University, do not allow students to take educational materials to their premises for the purpose of photocopying, even small parts. The unauthorized reproduction by a student of a reasonable part of a work to illustrate a lesson is accepted in almost all countries in the world.[76] Thus, without the advantage of limitations and exceptions for personal study, students in Vietnam are struggling to gain access to their educational materials lawfully. This is to say, Vietnam should introduce an exception for self-study. If Vietnam adopts fair use, this use should be included as fair use.

C. The Absence of Rules on Compulsory Licenses

In the absence of proper remuneration schemes for educational use, it is hard for students and teachers to gain bulk access to educational materials.

2016).

75 It has been reported by IIPA from 2001 up to now, that Vietnam has suffered from overwhelming piracy, in the form of illegalreprints and photocopies. *See 2001-2014 Special 301 Report – Vietnam,* IIPA, http://www.iipa.com/rbc/2008/2008SPEC301VIETNAM.pdf.

76 This issue is stipulated in §107 of the US as fair use and appears in Article 22(1) of the *Chinese Copyright Act. Similarly*, Section 40 of *the Australian Copyright Act 1968* considers study as fair dealing.

Like other developing countries, it is a necessity for Vietnam to have access to educational materials at affordable prices. For the purpose of educating skilled people, Vietnam needs to be able to access a complete book or an article to deliver to learners in the course of teaching. In order to do that teachers or educational institutions must seek permission from copyright owners, because none of the limitations and exceptions of Vietnam allow them to utilize entire works for teaching.[77] Teachers are allowed to make a single copy, while students are not permitted to reproduce works. The administration costs plus royalties for obtaining permission are extremely high, whereas schools and universities in Vietnam have limited financial resources and weak bargaining power to negotiate with commercial publishers. Therefore, most schools and universities have operated in an isolated world with a modest number of textbooks and little access to scientific journals, especially international journals.[78] Students and teachers opt to pay for illegal copies made by photocopying businesses. The photocopying business makes a huge profit from their sale, while publishers and copyright owners suffer from the practice of illegally photocopied works. This leads to two bad outcomes: users in the educational sector incur the risk of being sued at any time by copyright owners, and it erodes the incentive of creativities. This became true in the case of First New Co. v. Australia International English School & Vietnam Australian English Association on February 2012.[79] The defendants were sued for infringement, as they deliber-

77 Article 25 (1) (b), (d) and (g) of the Law on IP 2005 permit to use part work only.

78 Stephen W. Director et al., *Observes to Tertiary Education in Information Technology, Electronics-Digital and Telecommunication Fields in Some Universities of Vietnam*, The National Academies (2006).

79 Cong Quang, *The First Litigation Related to Books' Copyright,* Dantri Online Newspaper (Feb. 28, 2012), http://dantri.com.vn/c20/s202-569841/hoi-chuong-thuc-tinh-viec-ton-trong-ban-quyen.htm (in Vietnamese language); HoaBinh, *Australia International English School and Vietnam Australian English Association Were Sued*, Baomoi (Feb. 22, 2012), http://www.baomoi.com/Anh-ngu-Uc-Chau-va-Anh-van-Viet-Uc-bi-kien/107/7924917.epi (in Vietnamese language).

ately reproduced some parts of copyrighted books for their own collections to use in lectures or as study materials in their classrooms. The First New Company required compensation of 380 million VND (approximately 18,000 US dollars).[80] Ultimately, the case was settled by negotiation between parties: the defendant had to compensate thehuge amount of money for their infringement acts, plus give a public apology.[81] The practice of illegally photocopying works in the educational sector has been not tolerated by copyright owners, because it negatively affects the normal exploitations of the work, the second step of the three-step test. This is witnessed by the reaction of the Vietnam Reproduction Rights Organization (VIETRRO) in relation to making copies of artistic works by students and teachers.[82] VIETRRO made a claim to the Ministry of Education and Training (MOET) to ask for compensation (10,000 VND per year per student, or 500VND and a little bit more per teacher for whatever they copied, or asked a photocopying business to pay some levies)for photocopying made by students and teachers.[83] MOET has remained silent on this issue. There is a fear that VIETRRO will bring the case to the court for copyright infringement in the educational sector.

D. The Out of Date of the One Copy Rule

The one copy reproduction rule for reproduction of educational materi-

80 *Id.*

81 *Id.*

82 VIETTRO was established on Mar. 29, 2010 by the Vietnam Writer Association and approved by the Ministry of Culture, Sport and Tourism of Vietnam (MOCST) and the Ministry of Home Affairs of Vietnam (MOHA). This organisation is working as a collective management organisation that represents copyright owners to license reproduction rights. Currently, VIETRRO has represented more than 10,000 copyright owners. See more at VIETRRO,http://www.vietrro.org.vn/(last visited July 17, 2016).

83 *VIETRRO Will Collect 1 Million US Dollars in 5 Years*, Baomoi (Dec. 21, 2011), http://www.baomoi.com/Hiep-hoi-Quyen-sao-chep-VN-5-nam-thu-phi-sao-chep-1-trieu-usd/59/4307513.epi.

als for teachingis an obstacle to the educational sector.[84] It challenges teachers in the course of distributing the work to students. How can she/he do this with only one copy in her/his hand? She can perhaps pass it to the students and the students can enjoy the copyrighted work for a very short period and return it to the teacher. Even this can be seen as a copyright infringement, as Vietnamese limitations and exceptions do not mention that teachers are entitled to distribute the work to a class. In reality, teachers often make multiple copies of essential materials and distribute them to their students. More professionally and conveniently, educational institutions combine necessary materials together and make copies to deliver to their students so that they can be used in classrooms. Such acts by teachers or educational institutions are absolutely liable for copyright infringement. It is evident by the litigation between Fist New Co. v. Australia International English School & Vietnam Australian English Association on February 2012.[85] The defendants paid a huge amount of compensation for the use of the compilations that contained some parts of the plaintiff's books in their classrooms, because they infringed copyright by making more than one copy of some excerpts of copyrighted works and distributing them in their classrooms. This discourages schools from endeavoring to make study material resources; and thus, impedes the overhaul of education in the country.

E. Limitations and Exceptions to Copyright Do Not Extend to Distance Learning

Current limitations and exceptions for education do not extend to distance learning, which constrains the development of this educational model. Recently, distance learninghas played an important role, due to the massive

84 *The Law on IP 2005 (revised 2009)* art. 25(1)(a). This provision was interpreted by the Decree 100/2006/ND-CP that no more than one copy of a work is allowable.

85 *See supra* note 79.

demand from not only remote areas,[86] but also big cities such as Hanoi and Ho Chi Minh. The emergence of information technology, especially the internet, has made distance education flourish and become a great monetary potential for educational institutions and enterprises.[87, 88] At the same time, distance learning brings equality for people in education, regardless of their locations and conditions,[89] which is good for human development. Therefore, it needs to be facilitated in Vietnam. Unfortunately, this educational model is impeded by inappropriate limitations and exceptions because Vietnamese limitations and exceptions treat distance learning the same as face-to-face learning. Today's

---

86 Distance learning is defined as "a form of education in which students are separated from their instructors by time and/or space" *SeeReport on Copyright and Digital Distance Education ii*, US COPYRIGHT OFFICE (May 1999), http://www.copyright.gov/reports/de_rprt.pdf.

87 It was recorded in 1998-1999 that approximately 800,000 learners participated in courses of distance education. *A Country Report on Open and Distance Learning in Vietnam,* GLOBAL DISTANCE LEARNING NETWORK (2001), http://gdenet.idln.or.id/country/ar_vietnam/CRVietnam.htm; Doung et al., *Distance Education Policy and Public Awareness in Cambodia, Laos and Vietnam,* DISTANCE EDUCATION 28, 163-177 (2d ed. 2007), http://search.proquest.com/docview/217779057?accountid=13380.

88 Distance learning has been undertaken in Vietnam since 1993, when the government created two Open Universities to help the development of distance education in Hanoi and Ho Chi Minh cities. Distance learning is reaching wider audiences, covering all segments of the population. The college audience is increasing rapidly due to responsiveness to the needs of an older, non-traditional student population. Students also include professionals engaging in professional development or training, and retirees. To date, 17 universities have provided distance learning programmes and covered 63 cities and provinces in Vietnam. Approximately 160 thousand students have graduated and around 233 thousand students are studying such programmes. Distance education in Vietnam is the most utilised form of higher education. Before the spread of the internet, distance learning was conducted via audio or visual audio broadcasts, tapes, CDs, VCDs. Thanks to the development of the internet, educational materials are now digitalised and transmitted to learners via the internet. *See* Vi Thuy, *Develop Distance Learning – an Indispensable Trend*, EDUCATION AND EPOCH ONLINE NEWSPAPER (Nov. 2, 2009), http://www.gdtd.vn/channel/2741/200911/Phat-trien-giao-duc-tu-xa-Xu-the-tat-yeu-cua-thoi-dai-1913519/.

89 Distance education helps students overcome such barriers as full-time work commitments, geographic inaccessibility, and the difficulty of obtaining child or elder care, and physical disabilities. It can also provide the advantage of convenience and flexibility. With digital technologies enabling courses to reach and appeal to wider audiences, including rural, busy, impaired, and retired people.

distance education courses use digital technologies such as email, shared applications, streaming video/audio, video/audio file sharing, links, interactive CD-ROMs and DVD-ROMs[90] for various purposes and in numerous ways. These uses during the conduct of distance education make it different from face-to-face instruction. In virtual life, a teacher using a work to teach her class will invariably exercise one or more of the copyright owner's exclusive rights. She reproduces it and displays it to her limited students. In this situation, the one-copy reproduction rule can be workable. Unlike face-to face teaching,[91] if a teacher wants to display a copyrighted work to students she/he must transmit it over a digital network. The transmission over a digital network will generally constitute an exercise of the reproduction right and possibly the distribution right.[92] The digital transmission involves the automatic creation of copies during the transmission process. Particularly, when material is transmitted to a distant location over a computer network, temporary RAM copies are made in the computers through which it passes, by virtue of the technological process of transmission. In the other words, RAM copies implicate the copyright owner's reproduction right.[93] The copy of the work that arrives on the recipient's computer is the ultimate copy in this process. This means that it is possible to create numerous copies of the work using digital transmission. This kind of digital transmission constitutes the communication right to the public via a computer network. Therefore, it does not enable educators to digitize and transmit copyright materials to remote students,as this process definitely creates multiple copies instead of one copy.

---

90 Formore detail about these technologies, see *supra* note 86.

91 This is the rule established in Article 25(1)(a) and 32 (1)(b) of the *Law on Intellectual Property* 2005 that allows users to reproduce only one copy of a work for teaching purposes.

92 *See supra* note 86.

93 MAI Sys.Corp. v. Peak Computer, Inc., 991 F. 2d 511 (9th Cir. 1993); Stenograph L.L.C. v. Bossard Assocs., 144 F. 3d 96, 101-102 (D.C. Cir. 1998).

F. The Ignorance of Rules for Access to Educational Materials for Ethnic Groups

Access to educational materials of minority ethnic groups is extremely restricted because the copyright law removed the limitations and exceptions for translation of works from Vietnamese language to minority languages. Vietnam is a culturally diverse country, with 54 different ethnic groups and 90 different languages. Although King people (or Viets) account for approximately 86% of Vietnam's total population,[94] the Vietnamese Constitution explicitly declares that "every nationality group lives equally, co-operates, and helps each other. Each ethnic group has the right to preserve and use their own language."[95] Currently, many ethnic groups, such as Tay, Thai, Muong, H'Mong, Dao, and Khmer, use their own languages in conjunction with the national Vietnamese language. It is worth noting that members of 53 ethnic minority groups in Vietnam occupy up to 14% of the country's population, but they account for more than half of the country's poor people. The Vietnamese government has attributed a lot of effort to exercising favourable policies to such groups. One such effort is to provide education and give them opportunities to absorb cultural and artistic activities from outside their communities.[96] Unfortunately, the privilege of translation and distribution of works from Vietnamese languages to minority ethnic languages that used to exist under Article 761(f) of the Civil Code 1995, was removed by the Law on IP 2005. Therefore, these translations and distributions infringe copyright, if they are done without authorisation and

---

94 Cu Hoa Van, *The Nationality Issue and the Implementation of Nationality Policy in Vietnam: Facts and Solutions,* NATIONALASSEMBLY OF VIETNAM (2009), http://www.na.gov.vn/sach_qh/chinhsachpl/phan4/p4_iv_6.html; *Vietnam Demographic 2012,* INDEXMUNDI, http://www.indexmundi.com/vietnam/demographics_profile.html(last visited July 16, 2016).

95 Article 34 of *Constitution 1992 of Vietnam.*

96 Bert Maetern, *Challenges of Poverty's Reduction in Vietnam*, OXFAM IN VIETNAM (Mar. 05, 2012), http://oxfaminvietnam.wordpress.com/2012/03/05/the-challenges-of-poverty-reduction-in-vietnam/.

payment of royalties. This results in a shortage of textbooks, newspapers, and books translated from the national Vietnamese language into ethnic languages.[97] It explains why numerous people of minority ethnic groups are living in poverty and are uneducated. Therefore, it is worthwhile that Vietnam adds limitations and exceptions for translation and distribution of works to minority ethnic languages for educational purposes.

G. The Lack of Important Access Rights for Libraries

Inappropriate copyright limitations and exceptions for libraries have blocked the knowledge flow within the society, thus it hinders the capability of learning of Vietnamese citizens. Libraries play an important role in society. They contribute greatly to promoting learning, and spreading and sharing knowledge among members of society, in furtherance of a common good.[98] They are the public's access points to knowledge for the public to accomplish research, teaching and learning. More importantly, these access points are free of charge;[99] thereby, they have immense value for the people who lack resources elsewhere, like many in Vietnam. In exercising their function, libraries become deeply involved in access to cultural works when they make reproductions of the works for purposes of preservation, distribute works for research, private study, and teaching, and send or receive works under the name of interlibrary loans. Vietnam copyright law provides privileges for libraries to ac-

---

97 Thong Ta Van, *Preservation Languages of Minority Ethnic Group in Vietnam*, THE PEOPLE (July 12 2014), http://www.nhandan.com.vn/khoahoc/khoa-hoc/item/23754202-bao-ton-ngon-ngu-cac-dan-toc-thieu-so-o-viet-nam.html.

98 GUAN H TANG, COPYRIGHT AND THE PUBLIC INTEREST IN CHINA 167 (2011); Juan Carlos Fernández-Molina & José Augusto Chaves Guimarães, *Library Exceptions in the Copyright Laws of Ibero-American Countries*, 26(3) INFO. DEVELOPMENT 214, 215(2010); Shalini R Urs, *Copyright, Academic Research and Libraries:Balancing the Rights of Stakeholders in the Digital Age,* 38(3) PROGRAM: ELECTRONIC LIBRARY & INFO. SYSTEM 201, 201 (2004).

99 *See Ordinance of Libraries 2001 of Vietnam*, article 6(2).

cess cultural expression; however, this privilege is extremely limited, therefore libraries are struggling to provide adequate resources, to create friendly, accessible environments, as well as extending their service to different groups of the community. Firstly, there is the fact that collections of Vietnamese libraries are modest and insufficient to meet the demands of the public. Many reasons have been determined, such as the lack of funding to import collections from overseas, the development of collections mainly depending on donations, the limited number of works published in Vietnamese, or untrained libraries in archiving works.[100] The restricted scope of limitations and exceptions for libraries partly contributes to this issue. Libraries are permitted to reproduce cultural works for preservation under Article 25(1)(đ) of the Law on IP 2005.[101] However, only one copy can be made.[102] This rule challenges librarians, because original works, especially printed works, have been damaged, lost, or stolen. If this happens, and there is only one copy left, this will also be at risk of being damaged, lost or stolen. However, librarians are not allowed to make multiple copies or digitalise them for safe preservation. Therefore, they are suffering the loss of cultural works from libraries' collections. This negatively impacts on human development, as it shrinks the range of cultural works that human beings can learn from. Moreover, libraries are confronting difficulties in exercising their function of dissemination of knowledge to the public as "libraries are not allowed to reproduce and disseminate copies of works to the public, even digital copies."[103] Article 25(1)(đ) of the Law on IP 2005 refers to the right of libraries to reproduce one copy for research. In connection to the provision

---

100 *See generally Barbro Thomas, Development of Public Library Performance in Laos and Vietnam13,* (National Library of Sweden Final Report, 2009), http://www.kb.se/Dokument/Bibliotek/utredn_rapporter/2009/Laos_Vietnam_Final_Report_2009-04-07.pdf.

101 Article 25(1)(đ) of the *Law on IP 2005.*

102 Article 25(2) of the *Decree 100/2006/ND-CP (Sept. 21, 2006) Detailing and Guiding the Implementation of A Number of Articles of the Civil Code and the Intellectual Property Regarding the Copyright and Related Right.*

103 *Id.*

that prohibits libraries from reproducing and disseminating copies of works to the public, it is likely that the libraries are only entitled to copy one copy for themselves to serve their own research, not for research purpose of the public. This means that libraries are not allowed to reproduce and supply copies of articles or books to their patrons, which is the public, as well as to other libraries through inter-library systems. Prohibiting the supply of copies of works to patrons definitely creates obstacles to the dissemination of knowledge in public, as libraries can only provide materials to enjoy on their premises, without allowing any copying of materials. Currently, if the patrons want to make a copy for their legitimate purposes of research or teaching, they must borrow copyrighted works and take them somewhere else to reproduce them, rather than order libraries' officers to do so. This not only creates huge profits for the photocopying industry, but also makes libraries less helpful and discourages patrons from retrieving resources from libraries. This explains why Vietnam's citizens have a longstanding passion for reading,[104] public libraries are widespread throughout the country,[105] but only a very small portion of the population take advantages of public libraries.[106] Furthermore, the development of interlibrary lending in Vietnam is impeded because copyright law does not allow libraries to reproduce works to the public. Within academic libraries, interlibrary loans have been seen as the effective way of supplementing the limited resources currently available. This becomes more important in Vietnam, as

---

104 Over 90 percent of the Vietnamese population are literate.Every corner of streets or parks shows people reading books, newspapers, or magazines. In addition, over 25 million people access websites via internet daily for the love of reading. See DinhKieuNhung, *Unlocking the Potential of Vietnam's Libraries*, The Asia Foundation (Sept.7, 2011), http://asiafoundation.org/in-asia/2011/09/07/unlocking-the-potential-of-vietnams-libraries/.

105 *Id.* There are nearly 2,000 commune-level libraries, 613 district libraries, 63 provincial libraries and a national library..

106 Recent surveys indicated that only 2 or 3 percent of the population have used a libraries' services. This figure is around 60 percent of the population in the world. Barbro Thomas, *supra* note 100, at 17.

most libraries do not have sufficient resources to meet their own needs. Additionally, Vietnamese limitations and exceptions exclude libraries from the right of dissemination of copies of works in digital forms; it concedes the dead of distance/digital libraries. Thanks to digital technologies, people can digitalize copyrighted works into digital forms so that they can be enjoyed online and transmitted through the internet. This has resulted in the dramatic growth of distance/digital libraries around the world in the past two decades.[107] Libraries nowadays can serve patrons both from inside their premises and from a distance by sending digital copies to patrons. Unfortunately, library staffs are confronted with the challenge of addressing copyright issues related to distributing work in digital forms; due to Vietnamese copyright law treating this act as copyright infringement. Therefore, libraries' distance services via digital forms have been far reached to special target groups that suffer disadvantages of locations or abilities. In short, libraries in Vietnam "are unattractive and underresourced to meet the tremendous demand for study and research."[108] People in remote areas are not able to reach fresh knowledge.[109] Those shortcomings stem from the lack of proper privileges for libraries. In her article, Thu Hang complained that "libraries open every day just doing a simple things, lending books from limited resources."[110] This is true, because librarians are not allowed to provide various services for the public. For example, interlibrary transfer is impossible, so if a library patron cannot find a book in a library, he/

---

107 Oded Nov & Chen Ye, *Users' Personality and Perceived Ease of use of Digital Libraries: The Case for Resistance to Change*, 59(5) J. Am. Society for Info. Science & Tech. 845 (2008).

108 Thu Hang, *Outdated Libraries Put Damper on Learning*, VietnamNews (July 27, 2010), http://vietnamnews.vn/in-bai/201919/outdated-libraries-put-damper-on-learning-.html.

109 Anh Tuyet, *Improving the Spread of Scientific and Technology Knowledge for People in Remote Areas*, Hanoimoi Newspaper (May 29, 2015), http://hanoimoi.com.vn/Tin-tuc/Khoa-hoc/757788/nang-cao-vai-tro-pho-bien-kien-thuc-khoa-hoc-cong-nghe (translated from Vietnamese languages).

110 Thu Hang, *supra* note 108.

she must go to another library.[111] This discourages the public from going to libraries. Moreover, the lack of educational material encoded for people with disabilities has become common in Vietnam,[112] as copyright protection pushes the price up, while limitations and exceptions to copyright are limited.

VI. Recommendations of Reconstructing Copyright Limitations and Exceptions to Facilitate Access to Knowledge For Education

A. Remove the Three-Step Test from Legislation

As a requirement of international law, a country needs to unpack the three-step test to form its own limitations and exceptions. The three-step test draws a baseline for nations to introduce their own limitations and exception, so it should be regarded as a guiding principle to dictate that member nations write their legislation, rather than used as a strict rule.[113] This means the test needs to be examined by lawmakers before introducing certain limitations and exceptions, not users, copyright holders, or courts. As a general principle or packed guide, the three-step test must be unpacked by domestic legislation. In implementing the test, each country has its own method. The three-step test is impliedly addressed in the §107 of the US Copyright Act of fair use with four factors: (1) the purpose and character of the use, including whether such use is

---

111 Thu Hang, *supra* note 108. In this article, the author said she often has to run between libraries to find a book she needs.

112 *The Shortage of Books for Visually Impaired People*, Hanoi Disable Association, http://dphanoi.org.vn/index.php?option=com_content&task=view&id=2718&Itemid=808 (last visited July 17, 2016) (translated from Vietnamese language). The article stated that books for visually impaired people only satisfied 60% of the demand. Sexual educational and entertainment books for such people are extremely rare.

113 Okediji, *supra* note 55, at 32; *Declaration on a Balanced Interpretation of the Three-Step Test in Copyright Law*, Max Planck Institute for Intellectual Property, Competition and Tax Law, http://www.ip.mpg.de/shared/data/pdf/declaration_three_step_pdf.

of a commercial nature or is for non-profit educational purposes; (2) the nature of the copyrighted work; (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole: and (4) the effect of the use upon the potential market for, or value of, the copyrighted work. Other specific limitations and exceptions of the US have been introduced consistent with the three-step test, although their laws do not mention the test at all. Similarly, Chi[114] and Brazil[115]created their own exhaustive lists of limitations and exceptions without referring to the three-step test, as the test was carefully examined by lawmakers before introducing such limitations and exceptions.

The three-step test has not been properly unpacked in Vietnam. Vietnam simply reproduces the treaties' language into its domestic law[116]as below:

> *Article 25 (2): Organizations and individuals that use works defined in Clause 1 of this Article may neither affect the normal utilization of these works nor prejudice the rights of the authors or copyright holders; and shall indicate the authors" names, and sources and origins of these works.*
>
> *Article 26 (2): Organizations and individuals that use works under Clause 1 of this Article must neither affect the normal utilization of these*

---

114 The *2010 IP Law* of Chile under Article 71 Q introduced the fair dealing provision that implemented the three step test as below:

> The incidental and exceptional use of a protected work is hereby deemed lawful, for purposes of criticism, commentary, caricature, teaching, scholarship, or research, pro vided that said use does not constitute a covert exploitation of the protected work. The exception established by this article is not application to audiovisual works of a doc umentary nature.

115 *Pedro Nicoletti Mizukami et al.,* said that the three-step test "was not itself turned into law in Brazil". Brazilian copyright law has no provision directly referring to the three-step test. See Pedro Nicoletti Mizukami *et al., Exception and Limitations to Copyright in Brazil: A Call for Reform,* in Access to Knowledge in Brazil: New Research on IP, Innovation and Development 50 n.10, (Lea Shaver ed., 2010).

116 See Article 25, 26 of *the Law on IP 2005*.

works nor prejudice the rights of the authors or copyright holders: and shall indicate the authors' names, and sources and origins of the works.

The way to implement the three-step test makes the law unworkable, because its meaning is too general. Take the case of Section 200AB of theAustralian Copyright Act 1968 as an example. The Copyright Amendment Act 2006 of Australian was intended to create a flexible exception toward open-ended fair use to enable copyright material to be used for certain socially useful purposes. Section 200AB allows libraries, archives, galleries, and museums to use copyright materials, provided they are compliant with the three-step test.[117] In practice, this section has not really worked, as it creates confusion and uncertainty,[118] and thus, is not reliable.[119] The use of the treaties' language undermines the objectives of Section 200AB in creating flexible dealing exceptions.[120]

That is to say, the three-step test works as a legislative guidance in drafting limitations and exceptions, not as a restriction to be directly adopted in legislation. Therefore, it restricts the application of limitations and exceptions if lawmakers introduce it directly into their legislation. It becomes a burden for both users and courts in exercising limitations and exceptions in practice. Thus, it should be removed from legislation.

---

117 *The Australian Copyright Act 1968 (Cth.)*, Section 200AB(1)

118 See Nicolas *Suzoret al., Digital Copyright and Disability Discrimination: From Braille Books to Bookshare*, 13 MEDIA &ARTS L.REV.1,8, 13 (2008). It was argued that there is no guidance about what is likely to constitute a "special case", which makes the law uncertain; *See also* Anne Fitzgerald &Kylie Pappalardo, *Copyright Law and IP' Report on the Government 2.0 Taskforce: Project 4*, 50 (2009), http://eprints.qut.edu.au/29416/1/29416.pdf. It is argued that Section 200AB provides insufficient certainty about the meaning of "special case".

119 Fitzgerald & Pappalardo, *supra* note 119. They argued that it is unreliable and this stems from the uncertainty inherited from Berne.

120 *Id.; Suzor et al., supra note* 118.

B. Adopting US Fair Use Approach Instead of Fair Dealing

In drafting limitations and exceptions to copyright, Vietnam follows fair dealing approach by providing closed-list of copyright limitations and exceptions under Articles 25(1) and 26(1) of the Law on IP 2005(amended in 2009):

Article 25. Cases of use of published works in which permission and payment of royalties or remunerations are not required

1. Cases of use of published works in which permission or payment of royalties or remunerations is not required include:

a/ Duplication of works for personal scientific research or teaching purpose;

b/ Reasonable recitation of works without misrepresenting the authors' views for commentary or illustrative purpose;

c/ Recitation of works without misrepresenting the authors views in articles published in newspapers or periodicals, in radio or television broadcasts, or documentaries;*

d/ Recitation of works in schools for lecturing purpose without misrepresenting the authors" views and not for commercial purpose:

c/ Reprographic reproduction of works by libraries for archival and research purpose;

f/ Performance of dramatic works or other performing-art works in mass cultural, communication or mobilization activities without collecting any charges in any form:

g/ Audiovisual recording of performances for the purpose of repotting current events or for teaching purpose;

h/ Photographing or televising of plastic art, architectural, photographic, applied-art works displayed at public places for the purpose of presenting images of these works:

i/ Transcription of works into Braille or characters of other languages for the blind:

j/ Importation of copies of others' works for personal use.

3. The provisions of Points a and e. Clause 1 of this Article are not applicable to architectural works, plastic works and computer programs.

Article 26. Cases of use of published works in which permission is not required but the payment of royalties or remunerations is required

1. Broadcasting organizations that use published works in making their broadcasts, which are sponsored, advertised or charged in whatever form, are not required to obtain permission but have to pay royalties or remunerations to copyright holders from the date of use. Levels of royalties, remunerations or other material benefits and modes of payment shall be agreed upon by involved parlies. If no agreement is reached, involved parties shall comply with regulations of the Government or institute lawsuits at court under law.

Broadcasting organizations that use published works in making their broadcasts, which are not sponsored, advertised or charged in whatever form, are not required to obtain permission but have to pay royalties or remunerations to copyright holders from the date of use under regulations of the Government.

3. The use of works in the cases specified in Clause 1 of this Article does not apply to cinematographic works.

It can be seen from the aforementioned legal provisions, Vietnam provides closed lists of copyright limitations and exceptions which refers to fair dealing approach. This approach is a fix set of limitations and exceptions, so it does not allow courts to enlarge the scope of limitations and exceptions if necessary. Therefore, it is too restrictive, rigid, and unadaptable in the digital economy. Therefore, it is not suitable for Vietnam, a knowledge seeker, to improve education.Fair dealing is recognized by the closed-ended mechanism, which is inflexible and restrictive, because it provides courts with less flexibility in dealing with new circumstances.[121] Under fair dealing, what constitutes fairness is determined by permitted purposes. The use for any other purpose is never considered, even though it may be fair. Australia's fair dealing, for example, requires that the dealing must be carried out for one of five specific purposes.[122] Similarly, Vietnam[123] provides fair dealing privileges for specific purposes of criticism, commentary, caricature, teaching, scholarship, or research. The specificity of the fair dealing provisions hinders the courts when dealing with new circumstances that have emerged in the digital economy. Specific circumstances identified by the list leave no room for the court to consider the development of copyright law, especially regarding digital technologies and

---

121 Paula Baron, The *Moebius Strip: Private Right and Public Use in Copyright Law,* 70 ALBANY L.REV. 1227, 1232 (2007); Fred Von Lohmann, *Fair Use and Digital Right Management: Preliminary Thoughts on the (Irreconcilable?) Tension Between Them*, ELECTRONIC FRONTIER FOUNDATION1, 5-6 (2002), https://www.eff.org/files/cfp_fair_use_and_drm_0.pdf.

122 Research or study, criticism or review, reporting news, professional advice given by a legal practitioner or attorney, and parody or satire. Section 40-42, 103A-103C of the *Copyright Act (Cth) 1968*.

123 Article 25 (1) of the *Law on IP 2005.*

the internet. The scope of Vietnamese copyright limitations and exceptions has remained unchanged since enacted in 2005, while cultural, social, and technological changes happen constantly. As a result, the limited fair dealing approach is too scant to embrace the new circumstances that have occurred due to recent technological and social changes. For example, while it is popular that teachers send over lectures and other educational materials via internet for students in distance learning, and that everyone is making a copy of works for self-study, the closed-list of copyright limitations and exceptions in Vietnam does not account to those circumstances, therefore if any case is brought to the Vietnamese court relating to the use of educational materials for distance learning, or self-study, the court would have to conclude that such uses constitute copyright infringement. No way for the courts to judge such uses lawfully, as such uses were outside of the permitted purposes' categories clarified by the Law on IP 2005.

Moreover, closed-list limitations and exceptions cannot create a way for users to legally access computer software source codes for study purposes (reverse engineering), which has occurred in recent years, this might therefore impede innovation in this field. Vietnam's software development industry has been booming in the last five years. Companies like Intel, Samsung, and LG have invested billions in the country's electronics manufacturing industry.[124] The information technology sector was expected to contribute 8-10 percent of GDP by 2020.[125] This plan will become true if 250,000 information technology workers study cutting-edge technologies.[126] In the computer software industries, workers need to absorb ideas created around the world and then develop them into new software. Moreover, computer software products quickly be-

124 Hawkins Pham, *Computer Science in Vietnam: Counting Down to The Hour of Cod,* FORBES (Dec. 18, 2014), http://www.forbes.com/sites/techonomy/2014/12/18/4560/.
125 *Id.*
126 *Id.*

come obsolete; thus, competitive preference is only achieved by someone who quickly develops them. Time delays occur if developers are prohibited from learning about existing software. This restrains the development of follow-up innovation or inter-operating applications through reverse engineering. Therefore, if Vietnam's limitations and exceptions extend to the making of a reproduction of a computer program for the purpose of studying the ideas behind the program, and the way in which it functions, it will help to educate thousands IT workers and thus facilitate competition and growth in the computer software industry. Unfortunately, the restricted fair dealing approach will not allow for these limitations and exceptions unless a change is made to the legislation.[127]

Unlike strict fair dealing, which is confined to prescribed purposes or types of use, fair use is flexible because it provides general fairness factors to determine which use is fair. These factors include the purpose and character of the use and any harm that might be done to a rights holder's interests by the use.[128] It is broadly applicable to all kinds and uses of copyrighted work, regardless of any specific purposes, as long as such uses satisfy four general factors. The list of the specific examples of fair use, such as criticism, comment, news reporting, teaching, scholarship, or research, is non-exclusive. The list has been broadened over time by the courts. Take the case of reverse engineering of computer programs as an example. Reverse engineering al-

---

127 It is different from the fair use approach of the US reverse engineering was allowable on the grounds of fair use from 1992 by judgements of the court in the case *Atari Games Corp. v. Nintendo of America, Inc,*. 975 F.2d 832 (Fed. Cir. 1992) the court held that "reverse engineering object codes to discern the unprotectable ideas in a computer program is a fair use." In the Sega Enterprises Ltd. V. Accolade, Inc. 977 F. 2d 1510 (9th Cir. 1992) the court reached a similar conclusion that making intermediate copies of software's code to study and understand the code was fair use'. *See* Robert H. Lande & Sturgis M. Sobin, *Reverse Engineering of Computer Software and the US Antitrust Law*, 9(2) HARV. J.L. & TECH. 237, 245 (1996).

128 Section 107 of the US *Copyright Act.*

ways requires deconstructing the original program's literal code. In doing so, it can create compatible and interoperable programs that may contain code from the original program. Therefore, to some extent it may constitute copyright infringement. However, thanks to the flexible and broad meaning of fair use, reverse engineering had been defended.[129] Moreover, fair use is only limited to those uses that the court has previously affirmed and new uses cannot evolve.[130] Hence, under the general and flexible terms of fair use, a creator may dare to make some use of another's work that he/she believes to be fair. If the copyright owner agrees, the use continues, otherwise she/he can call on the courts to intervene and rule on the case.[131] Additionally, flexible fair use leaves the courts' ultimate discretion in application by imposing only four general factors, which makes the law easily adaptable to new circumstances without legislation. Fair use was a judicial doctrine codified by the Congress merely "to restate the present judicial doctrine of fair use, not to change, narrow, or enlarge it in anyway".[132] This means that by the time of its codification, Congress intended to leave it to the courts' discretion to decide fair use based on facts of each case. Each case raising the question of fair use has to be decided based on its own facts. Fair use doctrine, thus, is regarded as an embodiment of "law

---

129 Currently, the reverse engineering exception is covered by s. 1201(f) of the US Copyright Act, introduced by the Digital Millennium Copyright Act 1998. However, before codifying this provision, the US courts had held it as a finding of fair use. For example, the cases of Sega Enterprises Ltd v. Accolade, Inc., 977 F2d 1510 (9th Cir. 1992); Atari Games Corp v.Nintendo of America, Inc., 975 F2d 832 (Fed.Cir. 1992); Suny Handa, *Reverse Engineering Computer Programs under Canadian Copyright Law*, 40 McGill L.J. 621, 684 (1995).

130 Von Lohmann, *supra* note 121.

131 In US, it can be illustrated by *Sony Corp. of America v. Universal City Studios,* Inc., 464 U.S. 417 (1984) case. In the belief of fair use, in 1975 Sony produced and released a recording tool called the Betamax VCR for home taping of television programs for later viewing (time-shifting). In 1976, some copyright owners, such as Universal City Studios and the Walt Disney Company, sued Sony for providing a tool of piracy. The Supreme Court ruled in 1984 that time-shifting constituted fair use. That is to say, flexible fair use operates as a 'safety valve' mediation between copyright and new technologies.

132 H.R.Rep. No.94-1476, 94th Cong., 2d Sess.86, 66 (1976).

and fact".[133] It enables the courts to apply an endless variety of cases and can be adapted to new situations through case by case development.

Fair use is a great provision in the rapid technological changes, as it offers a flexible standard for courts to actively adapt the copyright law to major changes in technology.[134] As new technologies develop, courts generally have the first opportunity to apply copyright law to them, with Congress lagging behind. With its discretion, the court is able to interpret fairness factors based on their own facts. It has been witnessed by the US practice that the court enables, among other things, the use of thumbnail images in internet search results,[135] caching of web pages by a search engine, a digital plagiarism detection service, and time-shifting of over the air-broadcasting programmingby the privilege of the fair use defence in the US.[136] By doing this, a legislative solution of Congress for new technologies is only the final word after the court ruling.

Vietnam has been confronted with a shortage of knowledge for education, so Vietnam requires broad and inexpensive knowledge access. However, overly strong copyright protection in Vietnam is creating obstacles for innovation and development. It creates a copyright imbalance, increases the price of access and takes away the capability of the public to access cultural knowledge for education. Current Vietnamese limitations and exceptions are critically strict; therefore, the country needs to extend their scope to rebalance the copyright system and cope with the rapid change in digital technologies and social needs. To achieve this, fair use seems to be the best option for Vietnam

---

133 Harper and Row Publishers, Inc. v. Nation Enterprises, 471 U.S. 539, 560 (1985).

134 *Fair Use and Other Copyright Exceptions: An Examination of Fair Use, Fair Dealing and Other Exceptions in the Digital Age*, THE DEPARTMENT OF THE ATTORNEY GENERAL (2005), http://www.copyright.org.au/admin/cms-acc1/_images/144741021851b6a62aab6b2.pdf.

135 Kelly v. Arriba Soft Corp., 336 F.3d 811, 815-16 (9th Cir. 2003); Perfect 10, Inc. v. Amazon.com, Inc., 508 F.3d 1146, 1163-68 (9th Cir. 2007).

136 A.V. v. Iparadigms, LLC, 562 F.3d 630, 637-45 (4th Cir. 2009).

in extending the scope of limitations and exceptions, as it more flexible, adaptable, and adequately predictable than fair dealing. The above arguments have led to the conclusion that the fair dealing approach is too rigid and restrictive; hence, it will never be comprehensive in its coverage and may therefore prevent digital technology improvement and the dynamism of the information society in Vietnam. Innovation and development in Vietnam may be restrained if the laws remain frozen and outdated, and allow copyright holders to block important new technologies.[137] Moreover, fair dealing is expected to provide certainty; however, what it has presented in practice shows that fair dealing has not been more certain than fair use. In contrast, fair use is fairly flexible and easily adaptable in the new circumstances that constantly occur in the daily life of the digital economy. It ensures its law avoids instant revisions of inserting new limitations and exceptions into its legislation in order to keep pace with rapid technological changes of the digital age. In terms of certainty or predictability, recent empirical studieshave concluded that fair use was actually not incoherent, uncertain, or unpredictable as had been assumed.[138] Statistics from case law showed that fair use outcomes were certain and predictable. In addition, by using the fair use clause, the transaction cost for use of a work may be considerably decreased, as if it is a permitted use under the fair use defence it will gain free access without permission.[139] Moreover, when the statutory law leaves much to be desired,[140] fair use can offer a flexible standard to the courts

137 Matthew Sag, *Predicting Fair Use*, 73 (1) Ohio State L.J.47, 50 (2012).

138 Barton Beebe, *An Empirical Study of US Copyright Fair Use Opinions, 1978-2005,* 156 (3) U. Pa. L. Rev. 549 (2008); Pamela Samuelson, *Unbundling Fair Use*, 77 Fordham L. Rev. 2537, 2547 (2009); Matthew Sag, *The Pre-History of Fair Use*, 76 Brook. L. Rev.1371 (2011).

139 Glynn S. Lunney, Jr., *Fair Use and Market Failure: Sony Revisited*, 82B.U. L. Rev.975(2002); Wendy Gordon, *Excuse and Justification in the Law of Fair Use: Commodification and Market Perspectives*, *in* The Commodification of Information (Elkin-Koren & Netanel eds., 2002).

140 The Vietnamese legal system has maintained various defects. Its law still contains numerous loopholes that contradict each other. *See* Dang The Duc, *Overhaul of Intellectual*

to fill the gap. At present, by adopting the fair use defence, the use of computer software for reverse engineering, the use of work for self-study, and the use of work in term of distance learning will be included into the fair use doctrine. Moreover, life is made up of multiple facets; hence, the law should be flexible to be applicable into many circumstances. No law can be written in a way that embraces and covers all circumstances of reality and society at all times. The legal system is often out of date with real life, because the moment the law is enacted or amended, life goes on and naturally continues to incorporate new facets and aspects. However, if a law is drafted based on a general principle, it can have a wide reach. Modern law is characterised by its generality rather than having a number of factual circumstances as its subject matter. This generality and flexibility allows the law to respond and adapt to new circumstances through its interpretation without requiring legislative interference. The law still remains as written, although its meaning can be adapted to changes of social life and the evolution of society. It contains the capacity to adapt and enhance the law without changing the way it was written. Furthermore, general limitations and exceptions should be described using fair use in order to make them easy to understand. In addition, it is important to note that there are indications that Vietnam tried to shift to fair use in the Civil Code 1995 by introducing fair use like provisions in Article 760.[141] This reflects that Vietnamese copyright law paid attention to fair use and it might be considered as a founda-

Property System in Vietnam, Intellectual Property Magazine (2000), http://www.intellectualpropertymagazine.com/ipwo/doc/view.htm?id=49&searchCode=P&channelID=copyright; Pham & Associates, *Vietnam Moves to Fill IP System Gaps*, Modaq (July 12, 2000), http://www.mondaq.com/article.asp?articleid=8872; Abbott Philip *et al., Trade and Development: Lessons from Vietnam's Past Trade Agreement*, 37(2) World Development 342, 346 (2009); Global Investment and business Centre USA, Vietnam Business Law Handbook 24 (2007).

141 It said above that the *Civil Code* 1995 Art. 760 introduced a general provision for limitations and exceptions to copyright and Art. 761 were examples of limitations and exceptions.

tion for the establishment of fair use in this country.[142]

C. Introducing Statutory Licensing Schemes for Educational Purpose

To deal with the issue of illegally bulk copy of copyright works, Vietnamese copyright law should introduce compulsory licensing schemes for such uses. This scheme has been in force in many countries such as Australia, US, UK, Thailand and Malaysia. In Australia, for example, apart from free use exceptions for educational use under the fair dealing doctrine for research or study, and Section 200AB,[143, 144] educational sectors are able to rely on compulsory licensing schemes to obtain access to entire educational materials subject to reasonable payment to copyright owners via the collecting society under Part VA & VB of the Copyright Act 1968. In the Vietnam situation, compulsory license should be a good choice for the use of entire works for education, because it is can ensure the interest of the copyright owner and facilitate legitimate uses of copyright works in educational sectors at the same time. Some people can argue that it is not necessary to introduce compulsory licence scheme in Vietnam when educational institutions can go to publishers to negotiate voluntarily. Currently, it is difficult for authors/publishers and educational sector to reach an agreement in using educational materials, especially in books an text books imported from overseas. Authors are expecting a high rate of royalties while educational sector wishes for free access to educational materials. For example, in case of school text books, VIETTRO on Sept. 24, 2014 submitted a claim to the Copyright Office of Vietnam to require a the amount of 23.7 billion Vietnamdong royalties, approximately 1

142 There might be some worries about the adoption of fair use into Vietnamese copyright law. As the limit scope of this article, this topic cannot be solved, it will be resolved by another article of the author.

143 Section 40-42 and 103A-C, *The Copyright Act (Cth)* 1968.

144 The *Copyright Act (Cth)* 1968.

million USD, for the use of copyright works in school textbooks (from grade 1 to 12) in 2014.[145] This is disproportionately high in compare to the selling price of school textbooks. In development policy, Vietnam put the first priority on education, so the government has tried to ensure that every student going to school can afford to buy school textbooks. Hence, school textbook are sold under manufactured price and the government has to cover publishers' losses.[146] Moreover, as Vietnamese culture, free reproduction of works for education is favored off, so educational institutions are often not willing to pay royalties for the use of copyright works. Publishers of school textbooks have not paid royalties for the authors of the works for many years. Up to now, licensing fee for using copyright works in school textbooks has not been finalized yet. While waiting for final agreement, copyright owners are losing their licensing fee. That is to say, voluntary licensing scheme is economically inefficient in Vietnam. It is better this country sets out compulsory licensing scheme, in which the government will set out a reasonable fixed royalty for the use of the work for education. In doing so, users including teachers, students, and educational institutions are happy to pay a small amount of royalties to the copyright owners or a collecting society such as VIETTRO while the copyright owners are also happy because their interests are protected. This scheme will bring down licensing price. At the same time, it forces educational institutions to pay remuneration when using copyright works immediately.

---

145 Anh Khoa, *Shock with the Number of 1 million USD if Paid for Textbook Copyright Royalties*, DANTRI NEWSPAPER (Sept. 26, 2014), http://dantri.com.vn/giao-duc-khuyen-hoc/choang-voi-con-so-1-trieu-usd-neu-tra-tien-ban-quyen-sach-giao-khoa-1412248941.htm (translated from Vietnamese language).

146 In Vietnam, publishing school textbooks is not for commercial purpose because publishers suffer loss of income from publishing them. Vietnamese government has to cover publishers' losses. *See* Nguyen Minh Thuyet, *The Public Will Suffer Losses Because School Textbooks' Price Is Increased by Copyright Royalties*, DANTRI NEWSPAPER (Oct. 4, 2014), http://dantri.com.vn/giao-duc-khuyen-hoc/cong-chung-se-thiet-neu-sach-giao-khoa-bi-doi-gia-vi-tac-quyen-1412965281.htm (translated from Vietnamese language).

It is worthy noted that when teachers or educational institutions use entire works they have to pay an equitable remuneration by a set royalty under compulsory license. It is deemed to not unreasonably prejudice the interests of copyright owner, because a requirement to pay remuneration under compulsory license can recover the losses of the copyright owner by the interpretation of Main Committee I quoted below:[147]

A rather large number of copies for use in industrial undertakings…may not unreasonably prejudice the legitimate interests of the author, provided that, according to national legislation, an equitable remuneration is paid. If a small number of copies are made, photocopying maybe permitted without payment, particularly for individual or scientific use.[148]

As such, if educational institutions transmit a small amount of the work under fair dealing provisions, such use is fair and cause small harm to the copyright owners. If they transmit whole works under licensing schemes, they have to pay royalties to copyright owners. Moreover, suggestion of introducing compulsory licensing for education is not only to provide the opportunity for students/teachers to legally obtain bulk access to copyright works, but also create more money for the copyright owner by collecting royalties via collecting societies. That is to say, providing more access for education can help Vietnamese people improve their working skills, knowledge and enjoyment but do not harm to the interest of the copyright owner. New reform still keeps balance between interests of copyright owners and users.

D. Providing More Privileges for Libraries

Copyright exceptions for libraries and archives should be updated to

147 *Id.*
148 *Records* 1967, Vol. II, at 1145-1146. Professor Ulmer's comments appear at 883.

better enable preservation and other legitimate use in accordance with rapid technological change. Copyright law should: (1) remove the one copy rule for preservation or replacement and enable to some extent reproduction of copies of copyright materials for preservation and security (2) allow libraries to reproduce and disseminate single copies of small portions of all types of works, regardless of format, for legitimate purposes such as scholarship, research, study, or upon the request of users or other libraries, and digitalize works and communicate with users and other libraries in digital forms (3) extend these privileges to other public archiving organizations, such as museums and public galleries; (4) search and preserve collections of publicly available online content based on the needs and interests of local communities and make them available to users; (5) convert the format of works when the equipment for perceiving the work is obsolete and the copyright owner has not distributed the work in the newer format.

Next, Vietnamese copyright law should extend the compulsory licensing scheme to libraries so that libraries are more active in serving the public and the rights of copyright owners are guaranteed by compulsory royalties under this scheme. The free reproduction and communication of the works for users can be justified where libraries or archives are doing at reasonable portion of copyright works subject to the requests of individual students or researchers under the use for research or study. In this case, libraries or archives are doing on the behalf of users for research or study, and such uses are deemed to be fair or not unreasonable prejudice the interests of the copyright owners.[149] However, the reproduction and communication of the whole or more than reasonable portions of works for users possibly harm for the copyright owner,because users would otherwise be possible to seek a license from the copyright owner

149 I justified this argument in section III.G.

to make the reproduction.[150] Sam Ricketson thus asserted that a free use of the making of reproductions of the whole or more than a reasonable portion of copyright works for the purposes of individual users in the requesting library may be well be a disproportionate prejudice in the absence of a requirement to pay remuneration.[151] Similarly, in term of interlibrary lending, the making of the reproduction of work to supply to other libraries or archives is unreasonable prejudice to the economic interest of authors, in the sense of being disproportionate (as required by the third-step of the Berne Convention to assess the balance between copyright owners and users).[152] Even in the case of reproduction and communication of works for preservation, it is possible that the copyright owners still suffers from losses, on the basis that they could authorise libraries or archives to do. Therefore, to balance interests of both sides, it is suggested that a requirement to pay remuneration may be help to void the disproportionate.[153] It means that libraries must pay remuneration to the copyright owners either by voluntary licensing or compulsory licensing schemes. Voluntary licences for libraries are possible but not greatly appreciated because it might be difficult for libraries to negotiate with copyright owners to obtain licences. In many cases, according to Jane Ginsburg, transaction costs may be subdued by voluntary collective licensing.[154] Libraries in Vietnam are today in poor conditions and tight budgets allocated from government cannot afford voluntary licensing fees which are "very often higher than the royalties reasonably payable in respect of the reproduction of the work."[155] It is a good idea to

---

150 Sam Ricketson,*WIPO Study on Limitations and Exceptions of Copyright and Related Rights in the Digital Environment* (World Intellectual Property Organization No. SCCR/9/7, 2003).

151 *Id.* at 120-21.

152 *Id.* at 120.

153 *Id.* at 40, Reports 1967 the discussion of Main Committee I.

154 Jane Ginsburg, *Creation and Commercial Value: Copyright Protection of Works for Information*, 90 Colum. L. Rev. 1865, 1926 (1990).

155 *Report on Reprographic Reproduction*, Australian Copyright Law Committee (1976)

apply the compulsory licensing scheme for libraries, so that they are able to access copyright works without permission but reasonable payment must be made. It is necessary to repeat the words of Jan Ginsburg that "the real purpose of a compulsory license is to reduce the extent to which copyright ownership of the work conveys monopoly power, so that the copyright owner must make the work available to all who wish to access and exploit it".[156]

E. Actively Raising Its Voice in International Arguments to Ask More Support for Education in Developing Countries

In order to get practical privileges for developing countries to improve education, it needs to collaborate with other developing countries such as Brazil or Chile to put pressure on the international community. Brazil is leading a movement within WIPO to take into account constructing limitations and exceptions to copyright for innovation and development by asking WIPO for new agreements for the benefit of developing world. This nation has, along with other countries in the group of "Friends of Development"[157] submitted a Proposal for a Development Agenda in 2004. The Development Agenda was then adopted by the General Assembly of WIPO in September 2007, including 45 recommendations towards development-oriented approaches to IP that would allow equal access to copyright works.[158] In 2005, Brazil made a proposal calling for a general public interest clause, broad copyright limitations and exceptions, and a minimum list of exceptions to be present in a future treaty.[159]Chile,

(Franki Committee Report).

156 Ginsburg, *supra* note 155, at 1926.

157 The "Friends of Development" group includes Brazil, Argentina, Bolivia, Cuba, the Dominican Republic, Ecuador, Egypt, Iran, Kenya, Peru, Sierra Leone, South Africa, Tanzania, and Venezuela.

158 WIPO Gen. Assemb. Report, Doc. No. WO/GA/32/13 (Nov.12, 2015).

159 *Proposal by Brazil on the Protection of Broadcasting Organization – Corrigendum,* WIPO Doc. No.SCCR/13/3(Nov.21, 2005), http://www.wipo.int/meetings/en/doc_details.jsp?doc_id=53241.

in November 2004, for instance, asked WIPO to include limitations and exceptions to copyright for the purposes of education, libraries and archives, and disabled persons on the WIPO's Standing Committee on Copyright and Related Rights in order "to strengthen international understanding of the need to have adequate limitations, learn from existing models, and move towards agreement on exceptions and limitations for public interest purposes, which, like minimum standards, were to be envisaged in all legislation for the benefit of the international community".[160] Following this, in 2005 Chile composed another Proposal concerning the protection of broadcasting organisationsthat recommended some exceptions to copyright in the case of broadcast.[161, 162] A few days later, Chile submitted another Proposal on the Analysis of Exceptions and Limitations that requires the recognition of minimum limitations and exceptions at the international level.[163] Next, Chile, along with Brazil and others, proposed a Proposal to Standing Committee on Copyright and Limited Rights for Limitations and Exceptions in 2008.[164] Currently, Chile, along with Vietnam and other developing countries, is negotiating with developed countries including Australia and the US on the Agreement of Trans Pacific Partnership (TPP). This Agreement contains provisions of copyright limitations and exceptions. Chile is actively protesting provisions that create more restrictive limitations and exceptions. Vietnam should join the active developing countries'

160 *Proposal by Chile on the subject Exceptions and Limitations to Copyright and Related Rights (Chile's 2005 submission)*, WIPO Doc. No. SCCR/12/3(Nov. 17-19, 2004), http://www.wipo.int/edocs/mdocs/copyright/en/sccr_12/sccr_12_3.pdf.

161 *Proposal by Chile Concerning the Treaty for the Protection of Broadcasting Organisation,* WIPO Doc. No. SCCR/13/4 (Nov. 21-23, 2005), http://www.wipo.int/edocs/mdocs/copyright/en/sccr_13/sccr_13_4.pdf.

162 *Id*. at section III.

163 *Proposal by Chile on the Analysis of Exceptions and Limitations*, WIPO Doc. No .SCCR 13/5 (Nov. 22, 2005), http://www.wipo.int/edocs/mdocs/copyright/en/sccr_13/sccr_13_5.pdf.

164 *Proposal by Brazil, Chile, Nicaragua and Uruguay for Work Related Limitations and Exceptions*, WIPO Doc. No. SCCR/16 (July 17, 2008), http://www.wipo.int/meetings/en/doc_details.jsp?doc_id=10771.

group of Chile, Malaysia, Brunei, and other developing countries to raise its voice in international discussions in order to obtain practical limitations and exceptions for the interest of developing countries.

VII. Conclusion

It is undeniable that Vietnam is today confronting to the shortage of knowledge access for education, especially higher education. This shortcoming partly stems from strict copyright protection so that educational sector cannot afford to access on fresh knowledge expressed in copyright works. Reconstructing limitations and exceptions to copyright toward enlarging their scope are a good solution to resolve access issue in Vietnam. It is high time for Vietnam to: (1) remove the three-step test from legislation; (2) adopt fair use; (3) introduce licensing schemes for educational institutions; (3) broaden the rights for libraries in serving customers for educational purpose; and (4) raise its voice in copyright international arguments for supporting education in developing countries. In doing so makes more access to copyright works for educational purpose, thus, it can not only resolve the shortage of skilled labour in this country that threat to spread poverty both in urban and rural areas, but also satisfy knowledge demand of Vietnamese citizens for self-education and the love of learning.

Reference

Books

FICSOR, MIHALY J., THE LAW OF COPYRIGHT AND THE INTERNET – THE 1996 WIPO TREATIES, THEIR INTERPRETATION AND IMPLEMENTATION (2002).

GLOBAL INVESTMENT AND BUSINESS CENTRE USA, VIETNAM BUSINESS LAW HANDBOOK (2007).

LIN, YUTANG, THE WISDOM OF CONFUCIUS (MICHAEL JOSEPH ED., 1958).

PATTERSON, L. RAY & LINDBERG, STANLEY W., THE NATURE OF COPYRIGHT: A LAW OF USERS' RIGHTS (1991).

STEWART, STEPHEN M., INTERNATIONAL COPYRIGHT AND NEIGHBOURING RIGHTS (1989).

TANG, GUAN H, COPYRIGHT AND THE PUBLIC INTEREST IN CHINA (2011).

Journal Articles

Baron, Paula, *The Moebius Strip: Private Right and Public Use in Copyright Law*, 70 ALBANY L. REV. 1227 (2007).

Beebe, *Barton, An Empirical Study of US Copyright Fair Use Opinions*, 1978-2005, 156(3) U. PA. L. REV. 549 (2008).

Dong, *Gowming et al., Knowledge-Sharing Intention in Vietnamese Organisations*, 40 VINE 262 (2010).

Fernández-Molina, Juan Carlos &Guimarães, José Augusto Chaves, *Library Exceptions in the Copyright Laws of Ibero-American Countries*, 26(3) INFO. DEVELOPMENT 214 (2010).

Geiger, Christophe et al., *The Three-Step Test Revisited: How to Use The Test's Flexibility in National Copyright Law*, 29(3) AM. U. INT'L L. REV. 581 (2014).

Ginsburg, Jane, *Creation and Commercial Value: Copyright Protection of Works for Information,* 90 COLUM. L. REV. 1865 (1990).

Hamilton, Marci A., The TRIPS Agreement: Imperialistic, Outdated, and Overprotective, 29 Vand. J. Transnat'l L. 613 (1996).

Handa, Suny, *Reverse Engineering Computer Programs under Canadian Copyright Law*, 40 MCGILL L.J. 621 (1995).

Lande, Robert H. & Sobin, Sturgis M., *Reverse Engineering of Computer Software and the*

US Antitrust Law, 9(2) HARV. J.L. & TECH. 237 (1996).

Loew, Lauren, *Creative Industries in Developing Countries and Intellectual Property Protection*, 9(1) VANDERBILT J. ENT. & TECH. L. 171 (2006).

Lunney, Glynn S., Jr., *Fair Use and Market Failure: Sony Revisited,* 82B.U. L. REV. 975 (2002).

Lyman, Peter, *The Article 2B Debate and the Sociology of the Information Age*, 13 BERKELEY TECH. L. J. 1064 (1998).

Maskus, Keith E., *Intellectual Property Rights and Economic Development,* 32 CASE WESTERN J. INT'L L. 471 (2000).

Nguyen, Ngoc Lam et al., *Regarding the Reproduction Right in Education Environment*, 2 VIETNAMESE LEGAL J. 39 (2007).

Nov, Oded & Ye, Chen, *Users' Personality and Perceived Ease of use of Digital Libraries: The Case for Resistance to Change*, 59(5) J. AM. SOCIETY FOR INFO. SCIENCE &TECH. 845(2008).

Ozturk, Ilhan, *The Role of Education in Economic Development: A Theoretical Perspective*, 23 (1) J. RURAL DEV. & ADMIN. 39 (2001).

Philip, Abbott *et al., Trade and Development: Lessons from Vietnam's Past Trade Agreement*, 37(2) WORLD DEVELOPMENT 342 (2009).

Sag, Matthew, *Predicting Fair Use,* 73(1) OHIO STATE L. J. 47 (2012).

Sag, Matthew, *The Pre-History of Fair Use*, 76 BROOK. L. REV. 1371 (2011).

Samuelson, Pamela, *Unbundling Fair Use*, 77 FORDHAM L. REV. 2537 (2009).

Sunder, Madhavi, *IP3*, 59(2) STAN. L. REV. 257 (2006).

Suzor, Nicolas *et al., Digital Copyright and Disability Discrimination: From Braille Books to Bookshare,* 13 MEDIA & ARTS L. REV. 1 (2008).

Urs, Shalini R., *Copyright, Academic Research and Libraries: Balancing the Rights of Stakeholders in the Digital Age*, 38(3) PROGRAM: ELECTRONIC LIBRARY & INFO. SYSTEM 201 (2004).

Works in Collection

Finger, Michael J., *Introduction and Overview*, in POOR PEOPLE' S KNOWLEDGE: PROMOTING INTELLECTUAL PROPERTY IN DEVELOPING COUNTRIES 1 (2004).

Doung *et al, Distance Education Policy and Public Awareness in Cambodia, Laos and*

Vietnam, DISTANCE EDUCATION 28 (2d ed. 2007).

Gordon, Wendy *Excuse and Justification in the Law of Fair Use: Commodification and Market Perspectives*, in THE COMMODIFICATION OF INFORMATION (Elkin-Koren & Netanel eds., 2002).

Mizukami, Pedro Nicoletti *et al, Exception and Limitations to Copyright in Brazil: A Call for Reform,* in ACCESS TO KNOWLEDGE IN BRAZIL: NEW RESEARCH ON IP, INNOVATION AND DEVELOPMENT 50 (Lea Shaver ed., 2010).

Cases

America v. Universal City Studios, Inc., 464 U.S. 417 (1984)

Atari Games Corp. v. Nintendo of America, Inc.,975 F.2d 832 (Fed. Cir. 1992).

Bill Graham Archives, LLC v. Dorling Kindersley Ltd., 448 F.3d 605 (2d Cir. 2006).

Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569 (1994).

Harper and Row Publishers, Inc. v. Nation Enterprises, 471 U.S. 539 (1985).

Kelly v. Arriba Soft Corp., 336 F.3d 811 (9th Cir. 2003).

MAI Sys.Corp. v. Peak Computer, Inc., 991 F. 2d 511 (9th Cir.1993).

Perfect 10, Inc. v. Amazon.com, Inc., 508 F.3d 1146 (9th Cir. 2007).

Sega Enterprises Ltd. V. Accolade, Inc., 977 F.2d 1510 (9th Cir. 1992).

Sony Corp. of Am. v. Universal City Studios, Inc., 464 U.S. 417 (1984).

Stenograph L.L.C. v. Bossard Assocs., 144 F.3d 96 (D.C. Cir. 1998).

Internet and Other Sources

2001-2014 Special 301 Report – Vietnam, IIPA, http://www.iipa.com/rbc/2008/2008SPEC301VIETNAM.pdf.

2011 Social-Economic Statistical Data, GENERAL STATISTIC OFFICE OF VIETNAM, http://www.gso.gov.vn/default.aspx?tabid=622&idmid=&ItemID=12133.

2011 Vietnam NetCitizens Report: Internet Usage and Development in Vietnam, CIMIGO (2011) ; http://www.cimigo.com/en/research-report/vietnam-netcitizens-report-2011-english.

A Country Report on Open and Distance Learning in Vietnam, GLOBAL DISTANCE LEARNING NETWORK (2001), http://gdenet.idln.or.id/country/ar_vietnam/CRVietnam.htm.

ALRC, *Copyright and the Digital Economy,* Discussion Paper No.79, at 133 (2013).

Andreanne Leger, *The Roles of IPRs for Innovation: A Review of the Empirical Evidence and Implications for Developing Countries* (German Institute for Econ. Res. Discussion Paper No. 707, 2007).

Anh Khoa, *Shock with the Number of 1 million USD if Paid for Textbook Copyright Royalties*, Dantri newspaper (Sept. 26, 2014), http://dantri.com.vn/giao-duc-khuyen-hoc/choang-voi-con-so-1-trieu-usd-neu-tra-tien-ban-quyen-sach-giao-khoa-1412248941.htm (translated from Vietnamese language). Minh Thuyet, *The Public Will Suffer Losses Because School Textbooks' Price Is Increased by Copyright Royalties*, Dantri newspaper (Oct. 4, 2014), http://dantri.com.vn/giao-duc-khuyen-hoc/cong-chung-se-thiet-neu-sach-giao-khoa-bi-doi-gia-vi-tac-quyen-1412965281.htm (translated from Vietnamese language).

Anh Tuyet, *Improving the Spread of Scientific and Technology Knowledge for People in Remote Areas*, Hanoimoi Newspaper (May 29, 2015), http://hanoimoi.com.vn/Tin-tuc/Khoa-hoc/757788/nang-cao-vai-tro-pho-bien-kien-thuc-khoa-hoc-cong-nghe (translated from Vietnamese languages).

Anne Fitzgerald & Kylie Pappalardo, *Copyright Law and IP' Report on the Government 2.0 Taskforce: Project* 4, 50 (2009), http://eprints.qut.edu.au/29416/1/29416.pdf.

Barbro Thomas, *Development of Public Library Performance in Laos and Vietnam* 13, (National Library of Sweden Final Report, 2009), http://www.kb.se/Dokument/Bibliotek/utredn_rapporter/2009/Laos_Vietnam_Final_Report_2009-04-07.pdf.

Benedict Atkinson & Brian Fitzgerald, *Copyright as an Instrument of Information Flow and Dissemination: The Case of ICE TV Pty Ltd v. Nine Network Australia Pty Ltd*, Queensland University of Technology (2008), http://eprints.qut.edu.au/15208/1/1520'8.pdf.

Bert Maetern, *Challenges of Poverty's Reduction in Vietnam*, Oxfam in Vietnam (Mar. 05, 2012), http://oxfaminvietnam.wordpress.com/2012/03/05/the-challenges-of-poverty-reduction-in-vietnam/.

Binh Na, *Textbooks Invested Millions VND Are Still Outdated*, VTC News (Jan. 3, 2009), http://vtc.vn/dau-tu-tien-ti-giao-trinh-van-lac-hau.2.203143.htm.

Brief History of Vietnam, Viet Ventures, www.vietventures.com/Vietnam/history_vietnam.asp.

Carsten Fink & Carlos A Primo Braga, *How Stronger Protection of IPRs Affects International Trade Flows* 19-22 (World Bank Pol'y Res. Working Paper, 2005).

Confucianism, Wikipedia, http://en.wikipedia.org/wiki/Confucianism.

Cong Quang, *The First Litigation Related to Books' Copyright*, Dantri Online Newspaper (Feb. 28, 2012), http://dantri.com.vn/c20/s202-569841/hoi-chuong-thuc-tinh-viec-ton-trong-ban-quyen.htm (in Vietnamese language).

Cu Hoa Van, *The Nationality Issue and the Implementation of Nationality Policy in Vietnam: Facts and Solutions*, National Assembly of Vietnam (2009), http://www.na.gov.vn/sach_qh/chinhsachpl/phan4/p4_iv_6.html. Vietnam Demographic 2012, Indexmundi, http://www.indexmundi.com/vietnam/demographics_profile.html.

Dang The Duc, *Overhaul of Intellectual Property System in Vietnam*, Intellectual Property Magazine (2000), http://www.intellectualpropertymagazine.com/ipwo/doc/view.htm?id=49&searchCode=P&channelID=copyright.

Daniel Alvarez Valenzuela, *The Quest for a Normative Balance: The Recent Reforms to Chile's Copyright Law*, ICTSD (Dec. 12, 2011), http://web.uchile.cl/archivos/derecho/CEDI/Art%EDculos/the-quest-for-a-normative-balance-the-recent-reforms-to-chilee28099s-copyright-law.pdf.

Declaration on a Balanced Interpretation of the Three-Step Test in Copyright Law, Max Planck Institute for Intellectual Property, Competition and Tax Law, http://www.ip.mpg.de/shared/data/pdf/declaration_three_step_pdf.

Decree 131/2013/ND-CP on Administrative Penalties for Copyright and Related Rights Infringement, *come into force* Dec. 15, 2013, available at http://www.cov.gov.vn/cbq/attachments/article/1337/ND131.pdf.

Dinh Kieu Nhung, *Unlocking the Potential of Vietnam's Libraries*, The Asia Foundation (Sept. 7, 2011), http://asiafoundation.org/in-asia/2011/09/07/unlocking-the-potential-of-vietnams-libraries/.

Education in Vietnam: Development History, Challenges and Solutions, World Bank (2005), http://siteresources.worldbank.org/EDUCATION/Resources/278200-1121703274255/1439264-1153425508901/Education_Vietnam_Development.pdf.

Educational Multimedia Fair Use Guidelines Development Committee, *Fair Use Guidelines for Educational Multimedia*, July 17, 1996, §12.

Exception, Online Oxford English Dictionary, http://oxforddictionaries.com/definition/english/exception?q=exception.

Fair Use and Other Copyright Exceptions: An Examination of Fair Use, Fair Dealing and Other Exceptions in the Digital Age, The Department of the Attorney General(2005), http://www.copyright.org.au/admin/cms-acc1/_images/144741021851b6a62aab6b2.pdf.

Fred Von Lohmann, *Fair Use and Digital Right Management: Preliminary Thoughts on the (Irreconcilable?) Tension Between Them*, Electronic Frontier Foundation 1, 5-6 (2002), https://www.eff.org/files/cfp_fair_use_and_drm_0.pdf.

Golden Population Begins to fade,Vienam News, (May 28, 2014), http://vietnamnews.vn/opinion/255446/%E2%80%98golden-population-begins-to-fade.html.

Growing Pool of Unskilled Labour Left behind in Vietnam, The Rockefeller Foundation, http://www.searchlightcatalysts.org/node/310.

H.R. Rep. No.94-1476, 94th Cong., 2d Sess. 86, 66 (1976).

Hanh, H., *Vietnam Is in the Top Group Spending For Education*, Tinmoi Newspaper, (Apr. 20, 2010, 03:43), http://www.tinmoi.vn/Viet-Nam-thuoc-nhom-nuoc-co-ty-le-chi-cho-giao-duc-cao-nhat-the-gioi-01154100.html

Hawkins Pham, *Computer Science in Vietnam: Counting Down to The Hour of Cod*, Forbes (Dec.18, 2014), http://www.forbes.com/sites/techonomy/2014/12/18/4560/.

High Quality Education for All Should Be Vietnam's Priority, World Bank (Apr. 25, 2012), http://www.worldbank.org/en/news/feature/2012/04/25/high-quality-education-for-all-should-be-vietnams-priority.

HoaBinh, *Australia International English School and Vietnam Australian English Association Were Sued*, Baomoi (Feb. 22, 2012), http://www.baomoi.com/Anh-ngu-Uc-Chau-va-Anh-van-Viet-Uc-bi-kien/107/7924917.epi (in Vietnamese language).

International Intellectual Property Alliance, Special 301 Report on Copyright Protection and Enforcement 2010, Office of the United States Trade Representatives (2010), http://www.ustr.gov/about-US/press-office/reports-and-publications/2010/2010-special-301-report.

International Intellectual Property Alliance, Special 301 Report on Copyright Protection and Enforcement 2011, Office of the United States Trade Representatives (2011), http://www.ustr.gov/about-USE/press-office/reports-and-publications/2011/2011-special-301-report.

James A. Crites, *Confucianism and Its Spread to Vietnam*, Angelfire Communications,

http://www.angelfire.com/ca/beekeeper/cf.html.

Law No. 19.912 Bringing the Legislation Signed by Chile, in Accordance With The Agreements Of The World Trade Organization (WTO), WIPO, http://www.wipo.int/wipolex/en/details.jsp?id=5321.

Mihaly J Ficsor, S*hort Paper on the Three-Step Test for the Application of Exceptions and Limitations in the Field of Copyright*, 2 (Working Paper for the Central and Eastern European Copyright Alliance (CEECA) in the 25th session of the WIPO Standing Committee on Copyright and Related Rights (SCCR), Geneva, Nov. 19-23, 2012).

NI per capita, Atlas Method (Current US$), WORLD BANK, http://data.worldbank.org/indicator/NY.GNP.PCAP.CD.

Overview of Copyright in 2008, COPYRIGHT OFFICE OF VIETNAM, http://www.cov.gov.vn/cbqen/index.php?option=com_content&view=article&id=769&catid=49&Itemid=96.

Overview of Vietnam, WORLD BANK, http://www.worldbank.org/en/country/vietnam/overview.

Pham & Associates, *Vietnam Moves to Fill IP System Gaps*, MODAQ (July 12, 2000), http://www.mondaq.com/article.asp?articleid=8872.

Population and Development, UNFPA Vietnam, http://vietnam.unfpa.org/public/lang/en/pid/5571.

Proposal by Brazil on the Protection of Broadcasting Organization – Corrigendum, WIPO Doc. No. SCCR/13/3 (Nov. 21, 2005), http://www.wipo.int/meetings/en/doc_details.jsp?doc_id=53241.

Proposal by Brazil, Chile, Nicaragua and Uruguay for Work Related Limitations and Exceptions, WIPO Doc. No. SCCR/16 (July 17, 2008), http://www.wipo.int/meetings/en/doc_details.jsp?doc_id=10771.

Proposal by Chile C*oncerning the Treaty for the Protection of Broadcasting Organisation,* WIPO Doc. No. SCCR/13/4 (Nov. 21-23, 2005), http://www.wipo.int/edocs/mdocs/copyright/en/sccr_13/sccr_13_4.pdf.

Proposal by Chile on the Analysis of Exceptions and Limitations, WIPO Doc. No . SCCR 13/5(Nov. 22, 2005), http://www.wipo.int/edocs/mdocs/copyright/en/sccr_13/sccr_13_5.pdf.

Proposal by Chile on the subject Exceptions and Limitations to Copyright and Related Rights (Chile's 2005 submission), WIPO Doc. No. SCCR/12/3 (Nov. 17-19, 2004),

http://www.wipo.int/edocs/mdocs/copyright/en/sccr_12/sccr_12_3.pdf.

Purdie Nola, Education Statistics–News Sheet, 4(6) Data Management Unit, Ministry of Education 3 (1995).

Que Thi Nguyet Nguyen et al., *The Inter-Relationships between Entrepreneurial Culture, Knowledge Management and Competitive Advantage in a Transitional Economy*, (2008) http://artsonline.monash.edu.au/mai/files/2012/07/qtnguyetnguyen.pdf.

Rami Olwan, *Intellectual Property and Development: Theory and Practice 16* (May 2011) (PhD Thesis, Queensland University of Technology).

Report on Copyright and Digital Distance Education 20, US Copyright Office (May, 1999), http://www.copyright.gov/reports/de_rprt.pdf.

Report on Copyright and Digital Distance Education ii, US Copyright Office (May 1999), http://www.copyright.gov/reports/de_rprt.pdf.

Report on Reprographic Reproduction, Australian Copyright Law Committee (1976) (Franki Committee Report).

Ruth L. Okediji, *The International Copyright System: Limitations, Exceptions and Public Interest Considerations for Developing Countries,* 2, http://unctad.org/en/docs/iteipc200610_en.pdf (ICTSD Issue Paper No. 15, 2006).

Sam Ricketson, *WIPO Study on Limitations and Exceptions of Copyright and Related Rights in the Digital Environment* (World Intellectual Property Organization No. SCCR/9/7, 2003).

SeeForeign Companies Report Labor and Skills Shortage in Vietnam, Vietnam Briefing (July 30, 2014), http://www.vietnam-briefing.com/news/foreign-companies-report-labor-skills-shortage-vietnam.html/.

See Vi Thuy, *Develop Distance Learning – an Indispensable Trend*, Education and Epoch online Newspaper (Nov. 2, 2009), http://www.gdtd.vn/channel/2741/200911/Phat-trien-giao-duc-tu-xa-Xu-the-tat-yeu-cua-thoi-dai-1913519/.

Stephen W. Director *et al., Observes to Tertiary Education in Information Technology, Electronics-Digital and Telecommunication Fields in Some Universities of Vietnam*, The National Academies (2006).

Study, Oxford English Dictionary online, http://www.oed.com/view/Entry/192083?rskey=RjTTg5&result=1&isAdvanced=false#eid.

Teaching, Oxford English Dictionary online, http://www.oed.com/view/Entry/198356?rskey=gjkT4p&result=1&isAdvanced=false#eid.

The Shortage of Books for Visually Impaired People, Hanoi Disable Association, http://dphanoi.org.vn/index.php?option=com_content&task=view&id=2718&Itemid=808 (translated from Vietnamese language).

The World Factbook: Vietnam, Centre Intelligent Agency, https://www.cia.gov/library/publications/the-world-factbook/geos/vm.html.

Thong Ta Van, *Preservation Languages of Minority Ethnic Group in Vietnam*, The People (July 12 2014), http://www.nhandan.com.vn/khoahoc/khoa-hoc/item/23754202-bao-ton-ngon-ngu-cac-dan-toc-thieu-so-o-viet-nam.html.

Vietnam Development Report 2014 - Skilling up Vietnam: Preparing the Workforce for a Modern Market Economy, World Bank (November 2013), www-wds.worldbank.org/external/default/WDSContentServer/WDSP/IB/2013/11/26/000461832_20131126115640/Rendered/PDF/829400AR0P13040Box0379879B00PUBLIC0.pdf.Limitation, Online Oxford English Dictionary, http://oxforddictionaries.com/definition/english/limitation.

Vietnam Maintains 20% of State Budget Spending for Education in 2015, Vufo-Ngo Resource centre, http://www.ngocentre.org.vn/news/vietnam-maintains-20-state-budget-spending-education-2015.

VIETRRO Will Collect 1 Million US Dollars in 5 Years, Baomoi (Dec. 21, 2011), http://www.baomoi.com/Hiep-hoi-Quyen-sao-chep-VN-5-nam-thu-phi-sao-chep-1-trieu-usd/59/4307513.epi.

VIETRRO, http://www.vietrro.org.vn/.

Why Access to Education Is Important, Consortium for Research on Educational Access, Transitions and Equity, http://www.create-rpc.org/about/why/.

WIPO Gen. Assemb. Report, Doc. No. WO/GA/32/13 (Nov.12, 2015).

美國337條款國內產業要件之經濟要件：以專利授權實質投資為中心*

李柏靜**、張采揚***

目次

* 本研究之經費來源來自科技部補助專題研究計畫「美國關稅法案337條款國內產業要件之經濟要件-實證研究與實務建議」，計畫編號MOST 103-2410-H-128-005-MY2，特此致謝。

** 世新大學智慧財產權法律研究所副教授。作者誠摯感謝匿名審稿委員的精心審閱及寶貴建議。

*** 世新大學智慧財產權法律研究所碩士。作者誠摯感謝匿名審稿委員的精心審閱及寶貴建議。

投稿日期：2016年5月12日；接受刊登日期：2016年7月21日

摘 要

向美國國際貿易委員會（International Trade Commission，ITC）聲請337條款調查，聲請人須證明在美國有系爭專利之產業存在或正被建立中，亦即「國內產業要件」。只要符合19 U.S.C. § 1337(a)(3)(A)至(C)三款其中之一，聲請人即可滿足國內產業要件。實務上，國內產業要件包括經濟要件與技術要件，而符合該三款其中之一所規範之經濟活動，即滿足經濟要件。本文探討美國聯邦巡迴上訴法院（Court of Appeals for the Federal Circuit，CAFC）關於經濟要件中「實質投資於系爭專利之授權」之適用，包含*J*ohn Mezzalingua Assocs. v. ITC、InterDigital Communications, LLC v. ITC及Motiva, LLC, v. ITC等案。實務上，ITC早已利用(A)、(B)款兩類經濟活動以檢視國內產業要件是否構成，然而，無論是(A)款或(B)款，均與系爭專利是否在美國有生產活動有關，對於在美國無生產活動之權利人而言，此要件不免過於嚴苛。直至1988 年修法新增(C)款經濟活動後，救濟對象不再僅限於美國從事生產系爭專利物品之權利人，而擴大至於美國非從事生產，惟有實質投資於系爭專利之利用之權利人，放寬了國內產業要件之門檻。近來判決顯示CAFC於判斷國內產業要件之經濟要件時趨於嚴格。根據19 U.S.C. §1337(a)(3)(C)主張實質投資於系爭專利之授權以滿足主張國內產業要件時，必須證明實質投資與「與受專利保護之物品有關」，即須滿足「物品要件（articles requirement）」，如證明有受系爭專利保護之物品存在，但專利產品是否在國內生產則非所問。以專利侵權訴訟費用主張實質投資於系爭專利之授權之聲請人，其訴訟目的須爲「促進授權」而非「禁止生產」，始能滿足國內產業要件。專利侵權訴訟促成之授權

協議，其性質爲「生產導向」將獲得較高評價，若爲「收益導向」則評價較低。

關鍵字：美國國際貿易委員會、337條款調查、國內產業要件、經濟要件、實質投資於系爭專利之授權、物品要件

* Po-Ching Lee, Associate Professor, Graduate Institute of Intellectual Property Law, School of Law, Shih Hsin University. The authors would like to thank the anonymous reviewers for their constructive advices and valuable comments.

** Tsai-Yang Chang, Master of Law, Graduate Institute of Intellectual Property Law, School of Law, Shih Hsin University.The authors would like to thank the anonymous reviewers for their constructive advices and valuable comments.

Study of Domestic Industry Requirement of Section 337 Investigations -Focusing on Substantial Investment in Patent Licensing

Po-Ching Lee*, Tsai-Yang Chang**

Abstract

Section 337 investigations by the United States International Trade Commission (ITC) requires that the complainant demonstrates the existence of an industry in the United States or that such an industry is in the process of being established, i.e., the domestic industry requirement. The domestic industry requirement consists of an economic prong and a technical prong. The economic prong is satisfied by meeting the criteria of any of the three subsections listed in 19 U.S.C. § 1337(a)(3)(A)-(C). This research studies the fulfillment of the economic prong of the domestic industry requirement by focusing on the recent judicial applications of 19 U.S.C. § 1337(a)(3)(C) at the Court of Appeals for the Federal Circuit (CAFC), including Mezzalingua Assocs. v. ITC, InterDigital Communications, LLC v. ITC and Motiva, LLC v. ITC. These cases are related to the issue of "substantial investment in exploitation of the patent through licensing." In early ITC determinations, the subsections (A) and (B) in 19 U.S.C. § 1337(a)(3) have been relied on in finding the existence of a domestic industry. However, these

two subsections require actual production of the article in the Unites States. In 1988, Congress relaxed the domestic industry requirement to include certain non-manufacturing activities by adding the third factor that now found in subsection (C). The recent CAFC rulings illustrate the application of economic prong has tended to be rigid. Establishing licensing-based domestic industry under 19 U.S.C. § 1337(a)(3)(C), one must prove that substantial investment is related to the article protect by the asserted patent, i.e., the "articles requirement;" it does not require that the article protected by the patent be made in the US. While a complainant shows the substantial investment in the exploitation of the patent based on a patent infringement litigation, the purpose of the litigation must be related to "licensing," but not for permanent injunction. Moreover, to claim the litigation is a means to urge a license agreement, the merit of the license agreement must be "production-driven."

Keywords: United States International Trade Commission, ITC, Section 337 investigations, domestic industry requirement, economic prong, patent licensing, substantial investment, articles requirement

壹、前言

美國 337 條款調查（Section 337 investigation）是指根據 1930 年關稅法案（Tariff Act of 1930）第 337 條，亦即 19 U.S.C. §1337，由美國國際貿易委員會（United States International Trade Commission，下稱 ITC）對於進口貿易之不公平行爲所進行之調查。凡以不公平方法競爭[1]，或所有人、進口人或承銷人進口侵害專利權、著作權、註冊商標、或註冊之光罩作品等[2]智慧財產權之物品屬違法行爲，ITC 可核發排除令（exclusion order）使美國海關禁止侵權物品入境，或停止令（cease and desist order）以限制已進口侵權物品之銷售[3]。337 條款調查大多涉及侵害專利權及商標權[4]，其中專利爭議約占總案件之 90%[5]。ITC 必須在調查通知公告後最快的可行時間內（at the earliest practicable time）做出決定[6]，初步決定（initial determination）通常目標設爲 16 個月內完成[7]，因此 337 條款調查是在高度時間壓力下所進行。不論從排除令或停止令之救濟形式、或調查過程之時間壓力及其相對應成本，對於進口產品之答辯廠商是十分艱辛之程序[8]。再則，ITC 爲準司法聯邦機構（quasi-judicial Federal agency），不服 ITC 決定則至聯邦巡迴上訴法院（Court of Appeals for the Federal Circuit，下稱 CAFC）上訴，又是十分耗費訴訟資源之司法程序。

以專利案件爲例，根據 19 U.S.C. §1337(a)(2)，聲請 337 條款調查，聲請人（complainant）須證明在美國有系爭專利之產業存在或正被建立

1 19 U.S.C. §1337(a)(1)(A) (2006).
2 19 U.S.C. §1337(a)(1)(B)–(E) (2006).
3 *Section 337 Investigation at the U.S. International Trade Commssion: Answers to Frequently Asked Question*s, United States International Trade Commission, 1 (2009), *available at* http://www.usitc.gov/intellectual_property/documents/337_faqs.pdf.
4 *Id.*
5 Michael G. Mcmanus & Rodney R. Sweetland, III, Section337investigation: Unfair Trade Practice Litigation Beforethe Itc 32 (2014).
6 19 U.S.C. §1337(b)(1) (2006).
7 *See supra* note 3, at 20, n.16.
8 李柏靜，台灣廠商涉及美國337調查之實證研究，2012世新美國專利訴訟國際學術研討會暨模擬法庭，世新大學智慧財產權研究所主辦（2012 年4 月20日）。

中[9]，亦即「國內產業要件（domestic industry requirement）」。根據 19 U.S.C. §1337(a)(3)，受專利保護之物品，在美國境內如有以下情形，可認爲有國內產業存在：

(A) 顯著投資於廠房與設備（significant investment in plant and equipment）；

(B) 顯著人力雇用或資本（significant employment of labor or capital）；或

(C) 實質投資於系爭專利之利用，包括工程、研究與開發、或授權（substantial investment in its exploitation, including engineering, research and development, or licensing）[10]。

與受專利保護之物品有關，只要符合 19 U.S.C. §1337(a)(3)(A) 至 (C) 三款其中之一，聲請人即可滿足「國內產業要件」。實務上，國內產業要件包括「經濟要件（economic prong）」與「技術要件（technical prong）」[11]；而滿足以上 (A) 至 (C) 款其中之一所規範之經濟活動，實務

---

9 19 U.S.C. §1337(a)(2) (2006) ("Subparagraphs (B), (C), (D), and (E) of paragraph (1) apply only if an industry in the United States, relating to the articles protected by the patent, copyright, trademark, mask work, or design concerned, exists or is in the process of being established.")

10 19 U.S.C. §1337(a)(3) (2006) ("For purposes of paragraph (2), an industry in the United States shall be considered to exist if there is in the United States, with respect to the articles protected by the patent, copyright, trademark, mask work, or design concerned - (A) significant investment in plant and equipment; (B) significant employment of labor or capital; or (C) substantial investment in its exploitation, including engineering, research and development, or licensing.")

11 Taras M. Czebiniak, *When Congress Gives Two Hats, Which Do You Wear? Choosing between Domestic Industry Protection and IP Enforcement in Sec. 337 Investigations*, 26 Berkeley Tech. L.J. 93, 109 n.110 (2011), c*iting* Certain Ammonium Octamolybdate Isomers, Inv. No. 337-TA-477, Comm'n Op. at 55 (Jan. 5, 2004) ("Typically, the domestic industry requirement of section 337 is viewed as consisting of two prongs: the economic prong and the technical prong."); Colleen V. Chien, *Protecting Domestic Industries at the ITC*, 28 Santa Clara High Tech. L.J. 169, 180 n.63 (2011), *citing* Certain CD-ROM Controllers and Products Containing the Same-II, Inv. No.337-TA-409, Comm'n Op. at 37 (Oct. 18, 1999) ("The statutory domestic industry requirement has two prongs:

上稱爲「經濟要件」。無論是 19 U.S.C. §1337(a)(3)(A) 或 (B)，皆與系爭專利是否在美國有製造生產活動有關，對於沒有從事生產或製造活動的聲請人而言，根據 19 U.S.C.§1337(a)(3)(C)，則要能證明有實質的投資於在美國之專利授權或研發等活動。傳統上認爲建立國內產業要件是一個低門檻[12]。

美國或外國廠商時而利用 337 條款調查制止專利侵害，並作爲打擊競爭者的手段。過去台灣廠商動輒被調查，近年來台灣廠商也開始主動聲請 337 條款調查[13]。根據 2012 年之研究[14]，近十年來台灣廠商涉及 337 條款調查案件數量明顯攀升，尤其是 2010 及 2011 年台灣案件比例占年度總數三分之一，其中台灣案件有 98% 涉及專利侵害。在涉案產品方面，通訊傳播設備案件激增，光電材料及元件案件也增加，而電腦及週邊案件則是下降，其趨勢與台灣產業發展趨勢類似[15]。又根據 ITC 2013 年分析報告，2011 至 2012 年間最多數訴訟案爲電腦與通訊產品相關案件[16]，相關產業也是台灣重要產業，可見瞭解 337 條款調查的重要性。

身爲聲請人時，必須滿足「國內產業要件」；當身爲答辯人時，推翻聲請人之「國內產業要件」則可作爲主要因應策略[17]。近年國內產業要

---

the technical prong and the economic prong."). *See also,* Certain Coaxial Cable Connectors and Components Thereof and Products Containing Same, Inv. No. 337-TA-650, Comm'n Op. at 38 ("The Commission has divided the domestic industry requirement into an economic prong (which requires certain activities) and a technical prong (which requires that these activities relate to the intellectual property being protected).") [hereinafter *Coaxial Cable Connectors*].

12 *See* E.g., Bryan A. Schwartz, *Where the Patent Trials Are: How the U.S. International Trade Commission Hit the Big Time as a Patent Litigation Forum*, 20(2) INTELL. PROP. L. NEWSL., 1 (2002); Thomas A. Broughan, III, *Modernizing § 337's Domestic Industry Requirement for the Global Economy*, 19 FED. CIR. B.J. 41, 78 (2009).

13 李柏靜，前揭註8。

14 李柏靜，台灣廠商涉及美國337調查之實證研究——兼論國內產業要件，智慧財產評論，10卷2期，頁73-132，2013年1月。

15 同前註，頁83-92。

16 *Facts And Trends Regarding USITC Section 337 Investigations*, UNITED STATES INTERNATIONAL TRADE COMMISSION (Apr. 15, 2013), *available at* https://www.usitc.gov/press_room/documents/featured_news/sec337factsupdate.pdf.

17 參前揭註14，頁97。

件爭議多是針對 19 U.S.C. §1337(a)(3)(C) 之「經濟要件」，尤其是「實質投資於系爭專利之授權」之適用。由於 337 條款調查案件之訴訟，通常上訴至 CAFC 即爲最後判決，可知 CAFC 之見解實爲重要。因此本文以 CAFC 近期判決爲主，以下將簡述 19 U.S.C. §1337(a)(3)(C) 之立法背景，然後探討 CAFC 近期有關「實質投資於系爭專利之授權」判決，並討論「實質投資於系爭專利之授權」適用上所產生的問題，最後試由聲請人及答辯人的角度提供相應的訴訟策略與專利管理之建議。

貳、國內產業要件

一、國內產業要件

依據 337 條款規定，聲請調查必須符合二項法律原則。第一，聲請人須證明 ITC 有所對物管轄權（*in rem* / subject matter jurisdiction），即證明系爭被控侵權產品之進口情事[18]；第二，由於 337 條款之制定目的在於保護美國產業[19]，因此聲請人須證明其有存在國內產業或正在建立中[20]。

國內產業要件初見於 1930 年關稅法第 337 條[21]，其中提到在美國有效且經濟地運作之產業（an industry, efficiently and economically operated,

---

18 Jay H. Reiziss, *The Distinctive Characteristics of Section 337*, 8 J. MARSHALL REV. INTELL. PROP. L. 231, 231 (2009); *see also* Certain Welded Stainless Steel Pipe and Tube, USITC Pub. 863, Inv. No. 337-TA-29 (Feb. 1978) 1978 WL 50692, Op. of Comm'rs Minchew, Moore and Alberger, at 11-13 (discussing the ITC's *in rem* / subject matter jurisdiction is limited to the unfair acts listed in 19 U.S.C. §1337(a))

19 S. Alex Lasher, *The Evolution of the Domestic Industry Requirement in Section 337 Investigations Before the United States International Trade Commission*, 18 U. BALT. INTELL. PROP. L.J. 157, 157 (2010).

20 19. U.S.C. §1337(a)(2) (2006).

21 337條款歷經多次修法，修法背景及內容參閱例如林育琪，美國337條款調查國內產業要件之研究——以實質投資於系爭專利之授權爲中心，世新大學智慧財產權法律研究所碩士論文，頁35-56，2013年7月；張采揚，337條款調查國內產業要件之研究－以實質投資於專利授權之「物品要件」爲中心，世新大學智慧財產權法律研究所碩士論文，頁31-39，2016年2月。

in the United States），惟該法並未規定聲請人應提出何等證明[22]。早期國會認爲所謂國內產業須由專利權人、受讓人及被授權人於國內從事利用系爭專利之生產活動；換言之，國內產業即爲「國內生產」，許多早期 ITC 決定均採此見解[23]。至 1980 年代中期，國內產業要件之定義仍未臻明確，同時，ITC 決定亦反映出當時美國勞動力由製造業向服務業轉移的現象[24]，因此逐漸將產業定義擴大涵蓋「非生產活動」，如安裝、維修、品管及包裝[25]。直至 1988 年，美國國會通過 1988 年關稅法（Omnibus Trade and Competitiveness Act），新增 19 U.S.C. §1337(a)(3) 以涵蓋「非生產製造（non-manufacturing）」之新產業型態，並包含正在建立中的新興產業[26]。此一變革同時反映美國國會體認到美國製造業的生產製造活動外移趨勢，故國內產業要件不再要求聲請人於美國有實際生產活動[27]。19 U.S.C. §1337(a)(3) 規定：

第二段（19 U.S.C. §1337(a)(2)）所稱之產業，如在美國境內有以下情事，且該情事與受系爭專利權、著作權、商標權、半導體晶片上之光罩作品或其設計所保護之物品有關，可被認定在美國境內有產業存在或正在建立中：

(A) 顯著投資於廠房與設備；

(B) 顯著人力雇用或資本；或

---

22 *See* Smoot-Hawley Tariff Act of 1930, ch. 497, §337, 46 Stat. 703 (Subsection (a) of the statute prohibits [u]nfair methods of competition and unfair acts in the importation of articles...the effect or tendency of which is to destroy or substantially injure an industry, efficiently and economically operated, in the United States, or to prevent the establishment of such an industry, or to restrain or monopolize trade and commerce in the United States ....). *See also* John Mezzalingua Assocs. v. ITC, 660 F.3d 1322, 1327 (Fed. Cir. Oct. 4, 2011) [hereinafter*John Mezzalingua*].

23 Lasher, *supra* note 19, at 163-64.

24 *Id.* at 165.

25 *Id.* at 166.

26 *Id.* at 167-68.

27 *Id.* at 168.

(C) 實質投資於系爭專利之利用，包括工程、研究與開發、或授權[28]。

實務上，ITC 早已利用 (A) 款、(B) 款兩類經濟活動是否構成檢視國內產業要件，然而，無論是 (A) 款或 (B) 款，均與系爭智慧財產權是否在美國有生產活動有關，對於在美國無生產活動之權利人而言，此要件不免過於嚴苛。直至 1988 年修法新增 (C) 款即第三類經濟活動，目的在於放寬國內產業要件之門檻，將保護範圍擴大至非生產製造之經濟活動[29]，以因應以資訊產業爲主之知識經濟時代[30]。國會修法目的乃在於確保在美國境內有具體投資的機構能適用 ITC 救濟機制，亦能避免 ITC 拒絕救濟國內大型服務產業的不利結果，並同時給予在國內無財力資源從事生產的大學及小型企業得以向 ITC 提出救濟聲請之資格[31]。(C) 款規定不再要求聲請人在國內具備生產設備[32]或國內生產事實[33]，僅需證明其在國內有實質投資於法條列舉之活動[34]。此後，救濟保護對象不再僅限「於美國從事生產系爭專利物品之權利人」，而擴大至「於美國非從事生產，惟有顯著或實質投資之權利人」。一般而言，國內產業要件被認爲是能輕易

---

28 19 U.S.C. § 1337(a)(3) (2006).

29 Omnibus Trade and Competitiveness Act of 1988, Pub. L. No. 100-418, 102 Stat. 1107 (1988) (codified as amended at 19 U.S.C. § 1337 (2006), *cited in* Reiziss, *supra* note 18, at 238 n.45; *see also* Certain Dynamic Sequential Gradient Compression Devices and Component Parts Thereof, Inv. No. 337-TA-335, USITC Pub. 2575, Initial Determination 59 (Nov. 1992) [hereinafter *Compression Devices*](discussing § 1337(a)(3)(C) represents Congress' intent to define certain appropriate non-manufacturing activities as a domestic industry.)

30 99 Cong. Rec. 2904 (1986), *cited in* InterDigital Communications, LLC v. ITC, 707 F.3d 1295 (Fed. Cir. 2013); Broughan, III, *supra* note 12, at 62-64, 69.

31 Certain Digital Processors and Digital Processing Systems, Components Thereof and Prods. Containing Same, Inv. No. 337-TA-559, Initial Determination 89 (June 21, 2007) (*quoting* 132 Cong. Rec. H1783 (daily ed. Apr. 10, 1986) (statement of Rep. Kastenmeier)), *cited* in Reiziss, *supra* note 18, at 238 n.46.

32 Tom M. Schaumberg, A Lawyer's Guide To Section 337 Investigations Before The U.S. International Trade Commission, 1-2 (2d ed. 2012).

33 S. REP. No. 100-71, at 129 (1987); H.R. REP. NO. 100-40, at 157 (1987), *cited in* Reiziss, *supra* note 18, at 239 n.48.

34 *Id.*

構成的，即使是與美國僅存有微弱關聯的國外公司亦能滿足該要件[35]。

二、技術要件與經濟要件

實務上，ITC 針對專利調查案件發展出一檢視國內產業要件之標準，將國內產業要件再區分爲「技術要件」與「經濟要件」[36]，欲提出 337 條款調查的聲請人必須符合該二子要件[37]，以下分別說明之。

(一) 技術要件

爲滿足技術要件，聲請人必須證明有實施系爭專利之事實[38]。聲請人須證明其國內產品有「利用（exploit）」系爭專利，所謂利用是指要能證明聲請人之產品實施了系爭專利的一個請求項。至於如何判斷該產品是否實施了至少一個請求項，其判斷之比對方法與判斷是否侵權之比對方法本質上相同[39]。

(二) 經濟要件

基於保護「美國國內產業」並對抗國外的仿冒行爲[40]，因此爲滿足經濟要件須證明有存在國內產業或正在建立中，以示該國內產業與美國之關聯[41]。法定經濟要件規範於 19 U.S.C. § 1337(a)(3)(A) 至 (C) 三款[42]，聲請人滿足三款其一即可。

---

35 Reiziss, *supra* note 18, at 236. *See also* Schwartz, *supra* note 12; Broughan, III, *supra* note 12, at 78.

36 Lasher, *supra* note 19, at 171.

37 Czebiniak, *supra* note 11, at 109; Chien, *supra* note 11, at 180.

38 Chien, *supra* note 11, at 180.

39 *Id.*, *citing* Alloc, Inc. v. ITC, 342 F.3d 1361, 1375 (Fed. Cir. 2003) ("The test for satisfying the "technical prong" of the industry requirement is essentially same as that for infringement, i.e., a comparison of domestic products to the asserted claims."); Czebiniak, *supra* note 11, at 109, citing *Coaxial Cable Connectors*, Inv. No. 337-TA-650, ALJ Initial Determination, at 103 (The ITC analyzes infringement under the same standard used to prove infringement in the federal courts.). 參前揭註14，頁99-100。

40 Colleen V. Chien, *Patently Protectionist? An Empirical Analysis of Patent Cases at the International Trade Commission*, 50 WM. & MARY L. REV. 63, 87 (2008).

41 H.R. REP. No. 100-40, pt. 1, at 157 (1987), *cited in* Chien, *supra* note 11, at 177 n.42.

42 19 U.S.C. § 1337(a)(3) (2006).

於 1988 年關稅法修法前，實務上判斷國內產業要件構成與否，聲請人須證明其在國內對於廠房、設備或人力、資本之投資乃用於生產受系爭專利保護之物品[43]。修法後則增加工程投資、研發投資及授權投資等經濟活動。至於何謂「顯著（significant）」或「實質（substantial）」，實務上則考量產業特性、聲請人資源、市場情況等根據個案事實認定[44]，並沒有僵化的數字門檻。對於只生產一種產品的聲請人而言，證明 (A) 款廠房設備之投資以建立國內產業是相對簡單。而當聲請人生產多種產品時，則須判斷廠房設備投資中與系爭專利技術有關者佔了多少，亦即須建立投資活動與系爭專利的關聯，以判斷是否滿足國內產業要件。證明 (B) 款人力、資本之投資亦然，必須判斷投資活動與系爭專利的關聯。

爲了順應產業變化，委員會漸而允許單獨主張 (C) 款有實質投資於利用系爭專利之聲請人無須滿足技術要件，因而演變成主張 (A) 或 (B) 款所列之經濟活動時，須同時證明滿足技術要件及經濟要件；而主張 (C) 款所列之經濟活動時，則無須證明技術要件[45]。然而，單獨主張授權投資的聲請人無須證明技術要件即可滿足國內產業要件，是否妥適？以下將由 CAFC 近期關於「實質投資於系爭專利之授權」之判決加以探討。

參、司法實務發展—聯邦巡迴上訴法院判決

本文針對 2011 年後 CAFC 涉及「經濟要件」，尤其是關於「實質投資於系爭專利之授權」之實務見解，包含 John Mezzalingua Assocs. v.

---

43 SCHAUMBERG, *supra* note 32, at 2.

44 *Id. See also* Certain Dynamic Random Access Memories, Components Thereof and Products Containing Same, Inv. No. 337-TA-242, Comm'n Op. at 61 (1987)("The scope of the domestic industry in patent-based investigations has been determined on a case by case basis in light of the realities of the marketplace..."); Certain Multimedia Display and Navigation Devices and Systems, Components Thereof, andProducts Containing Same, Inv. No. 337-TA-694 Comm'n Op. at 15 (Aug. 8, 2011) [hereinafter *Navigation Devices*] ("The type of efforts that are considered a "substantial investment" under section 337(a)(3)(C) will vary depending on the nature of the industry and the resources of the complainant.")

45 Chien, *supra* note 11, at 182-83.

ITC[46]（*John Mezzalingua* 案）、InterDigital Communications, LLC v. ITC[47]（*InterDigital I* 案上訴判決與 *InterDigital II* 案重審駁回裁定）及 Motiva, LLC v. ITC[48]（*Motiva* 案）等案加以探討，以下個案試涵蓋 ITC 決定至 CAFC 決定以呈現司法實務見解形成之脈絡。

一、John Mezzalingua Assocs. v. ITC

(一) 案由背景

權利人 PPC[49] 爲一專門從事電器用之電纜連接器製造商，其主張 Arris International, Inc.（下稱 Arris）所進口、爲進口而銷售及進口後所銷售的同軸電纜連接器（coaxial cable connectors）侵害其四項專利，向 ITC 聲請 337 條款調查[50]。系爭專利爲第 D440,539 號設計專利（下稱 '539 專利）及第 6,559,194 號專利（下稱 '194 專利），其中 '194 專利又爲第 08/910,509 號專利申請（下稱 '509 申請案）之延續案[51]。

PPC 主張其於 2001 年在佛羅里達地院控告 Arris 侵害其 '539 專利一案作爲投資授權活動之根據（下稱佛羅里達案），該案於 2002 年判決侵權確定，PPC 除獲償 135 萬美元之損害賠償金外，亦獲准禁制令。同年 PPC 另於克羅拉多地院控告 Arris 之經銷商 International Communications Manufacturing, Inc. 侵害其 '539 專利（下稱克羅拉多案）。2003 年 PPC 再向威斯康辛西區地院控告 Arris 侵害其 '194 專利（下稱威斯康辛案），該案亦判決侵權確定[52]。於 2004 年間，克羅拉多案尚未判決確定前，兩造遵循佛羅里達案及威斯康辛案的判決結果達成和解，並授權 Arris 實

46 *John Mezzalingua*, 660 F.3d at 1322.
47 InterDigital Communications, LLC v. ITC, 690 F.3d 1318 (Fed. Cir. Aug 1, 2012) [hereinafter *InterDigital I*];InterDigital Communications, LLC v. ITC, 707 F.3d 1295 (Fed. Cir. January 10, 2013) [hereinafter *InterDigital II*].
48 Motiva, LLC v. ITC, 716 F.3d 596 (Fed. Cir. May 13, 2013) [hereinafter *Motiva*].
49 PPC（Production Products Company）爲John Mezzalingua Associates, Inc.旗下之部門，以設計及生產電器專用之同軸電纜連接器爲主要營業項目。
50 *Coaxial Cable Connectors*, Fed. Reg. 31145 (May 30, 2008).
51 *John Mezzalingua*, 660 F.3d at 1324.
52 *Id.* at 1325.

施 ’509 申請案之前的所有專利，包含系爭 ’539 專利在內 [53]。PPC 主張該長年訴訟乃係爲促成 2004 年的授權協議，因此訴訟支出應被視爲對授權活動之投資 [54]。

(二) ITC 決定

行政法官初步決定認定 PPC 針對系爭設計專利之授權活動構成「實質投資於系爭專利之利用」，並認定其於佛羅里達案中針對 ’539 專利之訴訟支出中至少有部分很可能係爲促成和解及達成授權協議，應被視爲授權活動的投資，因此滿足國內產業要件 [55]。

委員會未採認行政法官之決定並發回重審（reversed）[56]。委員會指出 19 U.S.C. § 1337(a)(3)(C) 中規定之「授權」，其意義不僅是「訴訟前」爲促使系爭專利商品化所爲之授權協議，亦包括「訴訟後」針對既存的生產行爲請求授權金之授權協議。委員會同時表示行使專利權之訴訟支出於特定情況下可支持國內產業之存在 [57]，然委員會認爲就 ’539 專利相關訴訟之支出與取得授權協議間有否「關聯」以及訴訟支出是否爲「實質」，PPC 並未完盡舉證責任 [58]。委員會更指出若允許無法證明與授權活動有關的訴訟支出能構成國內產業要件，則對於在地方法院提起專利侵權訴訟的專利權人而言，國內產業要件將形同虛設，進而導致委員會身爲解決貿易相關爭端的角色因而被淡化。

經重審，行政法官指出證據顯示 PPC 取得的唯一一項授權協議僅有一部份與 ’539 專利有關，可證其並無專爲 ’539 專利擬訂授權計畫，更無針對該專利採取任何授權行動 [59]。行政法官認定 PPC 之訴訟目的爲單純

---

53 *Id.*
54 *Id.*
55 *Id.*
56 *Id. See Coaxial Cable Connectors*, Notice, at 2 (Dec. 2009).
57 *Coaxial Cable Connectors*, at 50.
58 *Id.* at 55.
59 *John Mezzalingua*, 660 F.3d at 1326.

爲取得永久禁制令以停止生產[60]，因此判定 PPC 的訴訟支出與授權活動無充分關聯，且任何授權活動投資均非實質。委員會肯認行政法官之重審決定以做成最終決定。

(三) CAFC 判決

CAFC[61] 肯認 ITC 之最終決定，並特別闡釋 337 條款立法沿革，指出 1988 年修法目的乃因過去 ITC 對國內產業要件的適用過於嚴格，僅有適用 19 U.S.C. §1337(a)(3)(A)、(B) 款二類經濟活動，因此增訂 (C) 款所列之經濟活動，允許能證明有授權或研發等非生產活動之權利人亦符合國內產業要件，以放寬救濟資格之限制，然而並非欲全盤捨棄國內產業要件之適用，因國會明確認知委員會本質上爲一「貿易法庭」，而非「智慧財產權法庭」，唯有當權利人積極從事其智慧財產權之利用與開發始能聲請調查。事實上，(C) 款條文亦無明訂「爲行使專利權所花費之訴訟支出能做爲國內產業存在之證明」[62]。

根據修法意旨對於本案之適用，委員會解釋「專利侵權訴訟不得自動構成國內產業要件中所規定的實質投資於系爭專利之利用的證據」，否則恐有過度放低國內產業要件門檻之虞，以致規定淪同虛設[63]，法院對此一解釋表示支持。

CAFC 反對專利訴訟本身即爲利用專利的一種投資行爲之當然論述[64]。實際上 PPC 亦未能證明訴訟支出與授權協議間之關聯，根據佛羅

---

60 *Coaxial Cable Connectors*, at 53-54 (“PPC provided little if any evidence that it was seeking a license from […] rather than the permanent injunction it actually sought and received from the district court.”). *See also John Mezzalingua*, 660 F.3d at 1329 (“As the Commission recognized, that delay suggests that PPC’s purpose in litigating was not to obtain a license but, rather, was to stop Arris from manufacturing infringing connectors.”).

61 *John Mezzalingua,* 660 F.3d 1322.本文個案司法判決均以呈現多數意見即法院意見爲主，以下通稱CAFC或法院意見；若有不同意見則視個案於註解中呈現。

62 *Id.* at 1327, *citing* H.R. Rep. No. 100-40, at 157.

63 *Id.* at 1328.

64 本案之不同意見認爲1988年的修法意旨337條款實爲解決智慧財產權爭議之法

里達案的調查結果顯示 PPC 在提起訴訟前，未曾有向 Arris 提出授權協議的事實，亦查無 PPC 曾有寄出警告函尋求和解的證據，更無跡象顯示 PPC 曾於訴訟進行中嘗試和解或協議授權，終究 PPC 未能證明其訴訟支出能反應出對授權活動的顯著投資[65]。委員會認爲在佛羅里達案中 PPC 的訴訟意圖並非爲取得授權協議，而是爲禁止 Arris 生產侵權的連接器。換言之，訴訟之他造最終接受授權並不意味原告先前花費的訴訟支出係爲促成授權所投入的努力，CAFC 支持此一見解。此外，CAFC 亦認同針對不同專利所花費的訴訟支出不得認定爲是爲促成同一授權協議的投資，並肯定即便因判決結果而促成一授權協議，仍不得就此解釋該訴訟之目的係爲促成授權[66]。

二、InterDigital Communications, LLC v. ITC

(一) 案由背景

權利人 InterDigital Communications, LLC 及 InterDigital Technology Corporation（下稱 InterDigital）爲一電信技術開發商，擁有分碼多重進接（Code Division Multiple Access，下稱 CDMA）之 3G 通信標準技術。InterDigital 主張 Nokia Inc. 及 Nokia Corporation（下稱 Nokia）所進口的寬頻 CDMA 耳機產品侵害其美國第 7,190,966 號專利（下稱 '966 專利）及第 7,286,847 號專利（下稱 '847 專利），於 2007 年向 ITC 聲請 337 條款調查[67]。

有關國內產業要件之爭議，Nokia 主張 InterDigital 並無建立「受系爭專利保護之物品相關」的國內產業，並指出其授權活動無法充分滿足

律，應讓智慧財產權人能更有效地執行專利權，專利侵權訴訟可幫助強化專利價值，做爲市場競爭之手段，專利侵權訴訟可視爲利用專利之實質投資。*Id.* at 1339-41 (Reyna, J., dissenting).

65 *Id.* at 1328 (majority opinion).

66 *Id.* at 1329.

67 Certain 3g Mobile Handsets & Thereof, Inv. No. 337-TA-613, 72 *Fed. Reg*. 51838 (Sept. 11, 2007) [hereinafter 3g *Mobile Handsets*].

337 條款所規定的國內產業要件[68]。InterDigital 則提出其授權系爭專利供全球無線設備大廠生產以及具體授權收入之事實證據[69]。

(二) ITC 決定

行政法官之初步決定認定 InterDigital 有實質投資於系爭專利之授權活動，並指出 19 U.S.C. §1337(a)(3)(C) 明確規定授權活動可單獨作爲國內產業存在之根據，而未要求授權標的（即受專利保護之物品）必須於國內生產。惟行政法官判定 InterDigital 無法證明 Nokia 的侵權事實，委員會最終決定亦判定 Nokia 未侵權，並未就國內產業要件加以探討[70]，InterDigital 隨即上訴至 CAFC。

(三) *InterDigital I* 案（CAFC 上訴判決）

CAFC[71] 指出 1988 年國會增訂 19 U.S.C. §1337(a)(3)(C)，即是爲了廢止委員會早期所爲有關「授權活動無法構成國內產業要件」之認定原則[72]，修法意見亦指出該款規定意義爲「只要能證明有實質投資及類似活動發生於美國境內，是否於美國境內從事實際生產則非所問[73]」。因此，CAFC 認同行政法官認定 InterDigital 之授權活動足以構成國內授權產業之解釋。本案因 CAFC 認爲委員會對於二個請求項解讀有誤，而推翻該決定並發回重審[74]。Nokia 針對 InterDigital 的授權活動可構成國內產業要件之決定不服，向 CAFC 提出重審聲請（petition for rehearing）。

(四) *InterDigital II* 案（CAFC 重審駁回裁定）

1. 實質投資與受系爭專利保護之物品有關

68 *InterDigital I,* 690 F.3d at 1318.
69 *InterDigital II*, 707 F.3d at 1295.
70 *3g Mobile Handsets*, at 3.
71 *InterDigital I*, 690 F.3d 1318.
72 *Id.* at 1329, *citing* Omnibus Trade and Competitiveness Act of 1988, Pub. L. No. 100-418, §1342(a), 102 Stat. 1212-13.
73 S. Rep. No. 100-71, at 129 (1987); H.R. Rep. No. 100-40, at 157 (1987), *cited in Inter-Digital I*, 690 F.3d at 1329-30; *see also John Mezzalingua,* 660 F.3d at 1327-28.
74 *InterDigital I*, 690 F.3d at 1320.

CAFC[75] 指出本案爲涉及 19 U.S.C. §1337(a)(3)(C) 適用之經典案例。根據證據調查顯示 InterDigital 爲一頗具規模之公開發行公司，一直在美國從事 CDMA、而後發展爲 WCDMA（Wideband CDMA，寬頻分碼多重進接）技術之研發與授權活動，其專屬技術並被納入 3G 的通訊標準。InterDigital 亦有從事部分相關產品之製造，但其主要還是專注於手機產業之智慧財產權研發及授權。InterDigital 曾投資近 760 萬美元人事費用從事與系爭專利相關之授權活動，並透過包括系爭專利在內的專利組合授權協議獲得近 1 千萬美元的授權金收入，其中約有四成收入歸因系爭專利技術，行政法官判定上開事實構成授權活動之「實質投資」，並且確認其投入於研發之實質投資造就了系爭專利之產出[76]。法院亦採信以上證據及事實。

CAFC 認爲本案唯一爭點在於 InterDigital 所主張利用系爭專利之實質投資是否與「受系爭專利保護之物品有關（with respect to the articles protected by the patent）」？法院認定系爭專利所保護的技術有實際體現於其授權之產品以及試圖排除侵害之產品（the products that it has licensed and that it is attempting to exclude）中，因此可證明利用系爭專利的實質投資「與系爭專利保護之物品有關」[77]。

CAFC 並肯認 19 U.S.C. §1337(a)(3)(C) 款中之「授權」即是設計來使 ITC 保護那些本身沒有生產系爭專利產品、但與他人合作以生產系爭專利產品之聲請人。InterDigital 的美國專利中有 24 項會產生收益的授權，其中包括系爭專利，這些都是與無線裝置的主要製造商，如 Samsung、LG、Matsushita、Apple、RIM 等大廠之授權。InterDigital 即是那種本身沒有生產、但與他人合作以生產系爭專利產品之聲請人，也就是法律所要保護的授權人[78]。

---

75 *InterDigital II,* 707 F.3d 1295.

76 *InterDigital II*, 707 F.3d at 1298-99.

77 *Id.* at 1299.

78 *Id.* 本案不同意見認爲InterDigital在國內未生產系爭專利產品，亦無授權任何國內產業生產，其提起本案調查之目的並非希望 Nokia 接受國內生產授權協議，而是

2. 1988 年修法納入利用系爭專利之實質投資

CAFC 特別闡釋 337 條款之修法背景及目的，指出在 1988 年修法前，ITC 認爲要能證明國內產業存在必須具備國內生產之事實[79]，然而有反對聲浪認爲此一認定過於嚴格，導致未能保障在國內無實際生產，但因侵權產品之進口造成損害之發明人。因此，美國參議員 Lautenberg 提出了擴張 337 條款救濟範圍之修法提案，盼能修訂或刪除國內產業要件，以保障無從事生產，惟有從事工程、研發或授權其他業者進行生產的美國產業[80]，其指出當時社會之經濟型態逐漸以資訊業爲主流，對該等實質投資於智慧財產權研發及授權者，勢必需要救濟管道[81]。

同時，國會亦有反對完全刪除國內產業要件聲浪存在。然而，完全刪除該要件恐將使 ITC 之定位由「貿易法庭」轉變爲「智慧財產權法庭」，並且使與美國無實質關聯的國外權利人亦能向 ITC 請求救濟[82]。對此，美國衆議員 Kastenmeier 則提出一折衷方案，其建議保留國內產業要件，惟明確指出「受專利保護之物品於美國境內生產」非爲必要條件，亦即無國內生產事實，僅須證明有實質投資於工程、研發或授權，即可構成國內產業要件[83]。

爲許可 Nokia 於國外生產後之進口行爲，然而收益導向之授權活動與1988年關稅法修訂授權規定之精神不符。*Id.* at 1304 (Newman, J., dissenting).

79 *See* Certain Miniature, Battery-Operated, All-Terrain, Wheeled Vehicles, Inv. No. 337-TA-122, USITC Pub. 1300, at 41-42 (Oct. 1982), aff'd, Schaper Mfg. Co. v. ITC, 717 F.2d 1368, 1371-72 (Fed. Cir. 1983) [hereinafter *Schaper*](discussing the legislative history shows that the provision was intended to protect production activities in the United States.), *cited inInter Digital II*, 707 F.3d at 1300.

80 *InterDigital II,* 707 F.3d at 1300.

81 99 Cong. Rec. 2904 (1986), *cited in InterDigital II*, 707 F.3d at 1300-01.

82 *See* Intellectual Property and Trade: Hearings before the Subcomm. on Courts, Civil Liberties, and the Administration of Justice of the H. Comm. on the Judiciary, 99th Cong. 6, 23, 470-72 (1986) (statements of Paula Stern, Chairwoman, Int'l Trade Comm'n); Intellectual Property Rights: Hearings before the Subcomm. on Int'l Trade of the S. Finance Comm. 99th Cong. 57, 65 (1986) (statements of Paula Stern, Chairwoman, Int'l Trade Comm'n), *cited in InterDigital II*,707 F.3d 1295, 1301.

83 *InterDigital II*, 707 F.3d 1295, 1301-02. 不同意見則認爲國會修訂授權規定之目的爲鼓勵並支持專利產品之國內生產，而非爲刪除國內生產要件以提供國外產業誘因。*InterDigital II*, 707 F.3d 1295, 1305 (Newman, J., dissenting).

最終，國會採取美國眾議員 Kastenmeier 所提出之折衷方案，即保留國內產業要件以排除與美國無關聯的專利權人，並擴大對「無從事生產但有從事工程、研發或授權其他業者生產」的美國產業（涵蓋授權予製造商的大學及其他智慧財產權所有人）提供保護及救濟[84]，以放寬 337 條款之適用要件。眾議院及參議院之修法報告均指出 337 條款修訂目的在於強化解決國外進口侵權物品問題之效率與能力，除了刪除須證明因進口侵權物品而導致國內產業受有損害之要件[85]，另保留了國內產業要件，用以排除與美國無關聯之權利人濫用 337 條款之救濟，做爲證明美國產業之必要關聯[86]。

因此 CAFC 認爲，在 1988 年修法意旨下，只要聲請人有實質投資於專利利用，如藉由工程、研究與開發、或授權，不需要證明製造系爭專利所保護的產品、不需要其他國內廠商製造系爭專利產品，只要聲請人可以證明利用系爭專利之實質投資滿足國內產業要件，並且欲排除之物品爲系爭專利所涵蓋，即可獲得 337 條款之救濟[87]。最後法院做出了拒絕重審之裁定。

三、Motiva, LLC v. ITC

(一) 案由背景

權利人 Motiva, LLC （下稱 Motiva）於 2008 年向美國德州東區地方法院（隨後移審至美國華盛頓西區地方法院）主張 Nintendo Co., Ltd. 及 Nintendo of America, Inc.（下稱 Nintendo）的 Wii 電動遊戲系統及控制器（下稱 Wii）侵害其所有之第 7,292,151 號專利（下稱 '151 專利）。同年 9 月，Motiva 向 ITC 聲請 337 條款調查[88]，主張 Nintendo 針對 Wii 的進口、

84 *InterDigital II,* 707 F.3d 1295, 1300, *citing* S. Rep. No. 100-71, at 129 (1987) [hereinafter *Senate Report*]; H.R. Rep. No. 100-40, at 157 (1987) [hereinafter *House Report*].
85 *Id.* at 1302, *citing House Report* at 155; *Senate Report* at 128.
86 *Id.* at 1302, *citing House Report* at 157; *Senate Report* at 129.
87 *InterDigital II,* 707 F.3d at 1303-04.
88 Certain Video Game Sys., No. 337-TA-743, 75 *Fed Reg*. 68379 (Nov. 5, 2010) [hereinaf-

爲進口而銷售及銷售行爲侵害其所有之 '151 專利及第 7,492,268 號專利（下稱 '268 專利），有違 337 條款規定。

Nintendo 主張 Motiva 並無有關專利技術的商業化產品，且其爲發展系爭專利國內產業的唯一方式僅爲一專利侵權訴訟案件，並主張訴訟本身不可謂對於系爭專利利用之顯著或實質投資，因此無法滿足國內產業要件[89]，逕向委員會提出簡易決定之聲請（motion for summary determination）。

Motiva 則指出 Wii 之上市正值 Motiva 積極投入於引發市場關注系爭專利技術之時期，然因 Wii 之出現導致市場對於系爭專利技術之興趣蕩然無存，因此 Motiva 宣稱其將國內活動由原先的系爭專利產品開發，轉爲對 Nintendo 主張系爭專利之侵權訴訟[90]。

(二) ITC 決定

行政法官簡易初步決定（summary initial determination）判定 Motiva 唯一有關於商業化系爭專利之活動即爲其向 Nintendo 所提出的一件專利侵權訴訟。行政法官認爲該訴訟與授權活動之間並無充分直接的關聯，且發現 Motiva 從未從事任何授權相關活動，故無法滿足國內產業要件[91]。Motiva 隨後向委員會聲請重審（petition for review）。

委員會推翻簡易初步決定並發回行政法官重新調查（vacate and remand），並指出授權活動之目的在於「透過專利商業化以促進系爭專利技術之實務應用」，並能確保專利權人之授權收益、或被投資之機會，則侵權訴訟可被視爲與授權活動有充分關聯[92]。因而實應針對系爭專利之國內發展活動進行更深入之事實調查，以判斷系爭專利技術是否已達

ter *Video Game Sys*].

89 *Video Game Sys,* Comm'n Op. at 2.

90 *Id.* at 3.

91 *Id.* at 4.

92 *Motiva,* 716 F.3d at 598.

「準備生產」之階段，並查明該訴訟與系爭專利商業化是否具有充分「關聯」[93]。

Motiva 表示向 Nintendo 所提起之訴訟爲確保及加速授權之必要手段，否則因 Wii 流通於市場而完全削弱授權可能性。Motiva 認爲一旦 Nintendo 接受授權或離開相關市場，市場上的潛在合作對象將願意投資或接受授權。Motiva 並認爲其向 Nintendo 所提訴訟之支出即爲證明經濟要件之實質投資證據[94]。

經行政法官重審調查，仍判定 Motiva 無法滿足 337 條款所規定的國內產業要件之經濟要件，原因如下：

1. Motiva 主張其向 Nintendo 所提起之訴訟爲促進授權機會之必要手段，惟行政法官認爲訴訟本身與授權活動無充分關聯（'268 專利甚至未曾在地院訴訟中被主張）[95]，因 Motiva 並非期待透過訴訟以刺激投資或授權機會，而係爲向 Nintendo「取得損害賠償金或和解金」[96]；

2. Motiva 主張其所花費之訴訟支出爲實質投資之證據，惟行政法官判定該訴訟支出非屬「實質」。證據調查顯示 Motiva 未曾支付任何律師費用（將來亦可能完全不需支付），因此該訴訟投資乃相當「投機」[97]。至於其內部員工花費於該訴訟的時間成本約 17,000 美元，不可謂顯著[98]；

3. Motiva 主張若 Nintendo 之產品離開市場或接受授權則能促使市場對其投資或請求授權，惟行政法官認定系爭專利技術僅停留在

93 *Video Game Sys.,* Comm'n Op. at 11.
94 *Motiva,* 716 F.3d at 599.
95 *Id.*
96 *Id.* at 599-600.
97 *Id.* at 600.根據勝訴酬金制度（Contingency Fee Arrangement），若非Motiva因勝訴而有獲償，則不需支付任何費用。
98 *Id.* at 600.

> 測試階段，而未達「準備生產」之程度，不具市場可行性，亦不引發市場興趣[99]。系爭專利技術及被控侵權產品兩者市場截然不同，不具市場競爭可能性，因此即便被控侵權產品退出市場，仍不對系爭專利技術商業化造成影響[100]。

委員會肯認行政法官的重審分析而爲最終決定，未深究國內產業要件的爭議。此外，委員會並針對「以聲請人提出 337 條款調查之聲請日，做爲判斷國內產業存在與否之基準日」之裁定原則[101]表示支持。

(三) CAFC 判決

CAFC 指出判斷國內產業要件之構成與否乃一法律暨事實問題，然本案僅存在事實問題須待實質證據之審查，並認爲 ITC 的最終決定乃爲實質證據所支持[102]。由於調查證據顯示系爭專利的發明人期待的是透過訴訟直接獲得利益，而非期待投過訴訟以刺激投資或建立與製造商的合作關係，由此可證 Motiva 所提之訴訟乃以金錢收益爲目的，而非促進系爭專利的應用。甚至 Motiva 從未向地方法院聲請禁制令，而是等待三年之久始向 ITC 聲請調查[103]。

根據 *John Mezzalingua* 案之原理原則[104]，即便因訴訟而最終獲得一授權協議，該訴訟支出仍不得自動視爲授權活動的實質投資，而確實 Motiva 針對 Nintendo 侵權訴訟目的非爲了「達成授權以供生產相關產品」

---

99 *Id.* at 599, 601.

100 *Id.* at 599-600.

101 Bally/Midway Mfg. v. ITC, 714 F.2d 1117, 1120 (Fed. Cir. 1983) ("...the proper date for determining whether Bally's Rally-X game constituted an "industry" entitled to protection under section 337 was the date on which the complaint was filed rather than the date on which the Commission rendered its decision."), *cited in Motiva,* 716 F.3d at 601.

102 *Motiva*, 716 F.3d at 600-01.

103 *Id.* at 601.

104 *John Mezzalingua*, 660 F.3d at 1328 (discussing how litigation expenses should not automatically be considered a substantial investment in licensing, even where litigation leads to a license.), *cited in Motiva*, 716 F.3d at 601.

所爲之投資。再則，根據 *InterDigital* 案之原理原則[105]，若專利授權協議的直接目的在於爲產出「實施該專利技術之產品」則可視爲是授權活動的實質投資。綜合 ITC 根據事實證據的充分論證，即便 Motiva 獲得地院勝訴判決，對於能否刺激市場之投資或授權機會以生產「應用系爭專利之產品」，其中實無合理可能性[106]。

肆、討論

一、單獨主張實質投資於系爭專利之授權可否滿足國內產業要件？

(一) 問題背景

337 條款於 1988 年修法後所衍生之爭議多來自於 ITC 實務操作上認爲在國內無生產活動之聲請人根據 19 U.S.C. §1337(a)(3)(C) 主張國內產業要件時，僅須證明對於系爭專利之利用有實質投資，而無須證明技術要件[107]。而根據同條 (A) 款或 (B) 款主張國內產業要件時，須同時滿足技術要件，以示該投資與系爭專利相關[108]。有論者認爲相對於主張 (A) 款或

---

105 *See InterDigital II*, 707 F.3d at 1299 (Clarifying that efforts directed toward licensing a patent can satisfy the domestic industry requirement where they would result in the production of "goods practicing the patents"), *cited in Motiva*, 716 F.3d at 601.

106 *Motiva*, 716 F.3d at 601.

107 Chien, *supra* note 11, at 182-83; *see also* Certain Short-Wavelength Light Emitting Diodes, Laser Diodes and Products Containing Same, Inv. No. 337-TA-640, at 60 (Feb 19, 2008) ("Professor Rothschild does not need to make the additional showing that the technical prong of the domestic industry requirement has been satisfied because she is relying on her substantial investment in enforcement and licensing of the '499 patent to satisfy the requirements of the economic prong of the domestic industry requirement."); Schaumberg, *supra* note 32, at 64; *see also* Certain Semiconductor Chips with Minimized Chip Package Size and Products Containing Same, Inv. No 337-TA-432, Initial Determination 11(Jan. 24, 2001) ("[A] complainant is not required to show that it or one of its licensees practices a patent-in-suit on order to find that a domestic industry exist pursuant to 19 U.S.C. §1337(a)(3)(C), which pertain to licensing.").

108 Chien, *supra* note 11, at 181-82; *see also* Certain Variable Speed Wind Turbines and Components Thereof, Inv. No. 337-TA-641, at 43 (Mar. 2010) ("GE was found not to practice the patent, and therefore, to lack a domestic industry.") and Certain Gel-Filled Writs Rests and Products Containing Same, Inv. No. 337-TA-456, at 12 (Jan. 2003) ("We affirm the ALJ's finding that complainants do not practice the '544 patent, and that the domestic industry requirement of section 337 is therefore not met in this investigation.")

(B) 款之聲請人，此判定原則將使主張 (C) 款之聲請人負擔較輕之舉證責任[109]，而且實質投資之判斷標準如此寬鬆恐使國會修法時所欲避免 ITC 之角色由解決貿易糾紛之法庭成爲智慧財產權法庭[110]之情形因而實現。

(二) *InterDigital* 案分析

1. 1988 年之修法精神爲保護實質投資於利用系爭專利之聲請人

InterDigital 案中，根據 ITC 決定及 *InterDigital I* 案 CAFC 見解，在 19 U.S.C. §1337(a)(3)(C) 之規定下，專利授權可單獨作爲國內產業存在之根據，且不要求授權活動所產生之物品、即專利保護之物品須於國內生產[111]。法院認爲 1988 年修法國會新增 (C) 款的目的即是推翻先前委員會認爲不可單獨以授權活動成立國內產業要件之見解，因此上述見解與立法意旨是相符的[112]。

於 *InterDigital II* 案之重審駁回裁定中，法院更詳盡地檢視 1988 年修法背景及目的。雖然有不同意見認爲 1988 年授權規定修訂的目的在於允許權利人獲得救濟以擴大國內產業之利益及誘因，鼓勵並支持專利產品之國內生產，而並非是爲了刪除授權產品之「國內生產」要件以削弱此一誘因，反而提供國外產業誘因[113]。然而多數意見認爲 1988 年關稅法修訂 337 條款之精神在於讓有實質投資於專利之利用（如透過工程、研發或授權）之權利人能獲得救濟，無須要求其自行生產系爭專利產品，亦無須要求任何國內廠商進行生產。CAFC 更指出若將 19 U.S.C. §1337(a)(3) 解讀爲需要國內生產活動，似乎忽略該條文中三款規定應各別適用，(A) 款及 (B) 款對國內產業要件之要求並不適用於 (C) 款[114]。只要系爭專利涵蓋欲排除侵害之標的物品（the patent covers the article that is the sub-

109 Chien, *supra* note 11, at 177, 183.
110 *Id.* at 183.
111 *InterDigital I*, 690 F.3d at 1329.
112 *Id.* at 1329-30.
113 *InterDigital II,* 707 F.3d at 1305 (Newman, J., dissenting).
114 *Id.* at 1303 (majority opinion).

ject of the exclusion proceeding），同時可證明實質投資於該專利之利用，權利人即有尋求 337 條款救濟之適格性[115]。

InterDigital II 案中，CAFC 肯認 InterDigital 之實質授權投資，符合聲請人資格。法院表示 InterDigital 爲頗具規模之事業，並有將系爭專利授權給全球無線設備大廠進行生產之事實，顯示其利用系爭專利之投資與授權有關，而系爭專利確實體現於國外授權產品中，可證明其授權投資與系爭專利相關。此外，InterDigital 針對系爭專利相關之授權活動支出約計 760 萬美元，包含系爭專利在內之專利組合授權收益約計 1 千萬美元，其中四成收益是歸因於系爭專利，該等授權支出與相應收益被認定構成實質投資[116]。法院乃根據 InterDigital 之國內活動事實而認定構成與美國間之充分關聯，因此將其歸納爲 1988 年關稅法修法時所欲納入之救濟對象。

2. 專利授權實質投資必須與受專利保護之物品有關：「物品要件」之提出

從 *InterDigital I* 案 CAFC 肯認，專利授權可單獨作爲國內產業存在之根據且不要求受專利保護之物品須於國內生產，發展到 *InterDigital II* 案 CAFC 重申，只要是實質投資於系爭專利之利用（藉由工程、研發或授權）即可符合國內產業要件。*InterDigital II* 案中，法院並非單純陳述主張 19 U.S.C. §1337(a)(3) 之 (C) 款者無須證明「技術要件」，而是檢視這些經濟活動是否與「與受專利保護之物品有關」，以下本文稱之爲「物品要件（articles requirement）[117]」。

綜觀 19 U.S.C. §1337(a)(2) 及 (3) 對於國內產業要件之規定，於 19 U.S.C. §1337(a)(2) 中規定「與受專利保護之物品有關（relating to the articles protected by the patent）」，於 19 U.S.C. §1337(a)(3) 之前言規

115 *Id.* at 1303-04.
116 *Id.* at 1298-99.
117 *InterDigital II* 後，實務界普遍認爲CAFC對於授權投資之「物品」要求已經形成，討論於後。*See infra* note 130.

定「與受專利保護之物品有關（with respect to the articles protected by the patent）」，19 U.S.C. §1337(a)(3) 中所列三款經濟活動，自應與受專利保護之物品有關，始能成立國內產業要件。由 *InterDigital* 案之發展脈絡可知，CAFC 支持委員會關於聲請人可以單獨以授權主張國內產業要件，但並非所有授權活動皆可成立，而是授權之實質投資必須與系爭專利保護之物品有關。而 CAFC 檢測物品要件的方式就是判斷 InterDigital 之系爭專利有實際體現於其授權之產品以及其試圖排除之侵權產品上，因而可證明其實質投資與系爭專利保護之物品有關。

3. 19 U.S.C. §1337(a)(3)(C) 之實質投資判斷趨於嚴格

至於論者主張過去 (C) 款之聲請人形同負擔較輕之舉證責任、實質投資之判斷標準如此寬鬆恐使國會修法時所欲避免 ITC 之角色由解決貿易糾紛之法庭成爲智慧財產權法庭等問題，CAFC 實已有所回應。CAFC 於 *John Mezzalingua* 案及 *InterDigital* 案均有提到 1988 年修法時，國會明確認知 ITC 本質上爲「貿易法庭」，避免 ITC 變成「智慧財產法庭」，因此仍然保留國內產業要件，而新增 (C) 款所列經濟活動以放寬國內產業要件之門檻，其目的在於將保護範圍擴大至非生產製造之經濟活動，而非爲了完全刪除國內產業要件或刻意留下漏洞。國會最終保留國內產業要件之規定，即爲排除與美國無關聯之權利人濫用救濟，以做爲證明美國產業之必要關聯。

再則，CAFC 認爲 InterDigital 有關系爭專利之國內投資活動屬於實質投資，乃是考量其事業規模、研發活動、授權投資與相應收益等眾多因素，而綜合判斷各項因素後，認定有構成與美國間之充分關聯，故將其歸納爲 1988 年關稅法修法時所欲納入之救濟對象，可知 CAFC 在判斷投資實質性上並不寬鬆。更重要的是，雖肯認 InterDigital 已構成了實質授權投資，CAFC 更進一步要求以 (C) 款主張國內產業要件之聲請人尚必須證明物品要件，以強調投資活動有與系爭專利保護之物品有關，由此可見 CAFC 對於 (C) 款之適用與判斷乃趨於嚴格。

CAFC 於 2013 年作成 *InterDigital II* 裁定之後，同年於 Microsoft Corporation v. ITC 案[118]（下稱 *Microsoft* 案）中引用 *InterDigital II* 之物品要件。Microsoft 案同樣主張 19 U.S.C. §1337(a)(3) 之 (C) 款經濟活動，但權利人 Microsoft 是主張研發投資而非授權投資。CAFC 指出，根據 *InterDigital II* 案之原理原則，以 19 U.S.C. §1337(a)(2) 及 (3) 主張國內產業要件，即使無須要求受系爭專利保護之物品係「於美國所生產」，惟無疑要求國內業者之實質投資（如研發活動）須與「受系爭專利保護之物品」有關[119]。據此認定權利人 Microsoft 因無法提出受系爭專利保護之物品，或未能證實其所提出之物品有實施系爭專利，故未能滿足物品要件進而成就國內產業要件[120]。由此可見 CAFC 對於 (C) 款趨於嚴格認定之態度。

此外，CAFC 於 2015 年 LSI Corporation v. ITC 案[121] 中，*Audiovisual Components* 案[122]（討論於後）之聲請人 LSI 因無法證明有受系爭專利保護之物品而被 ITC 判定無法構成國內產業要件，LSI 不服而上訴至 CAFC[123]，惟其針對國內產業要件之爭議僅主張 ITC 將 *Computer Peripheral Devices* 案[124]（討論於後）於 2014 年所確定有關物品要件之法律標準，錯誤回溯適用於 *Audiovisual Components* 案 2013 年之證據審理，CAFC 認為 LSI 對於缺乏授權活動一事並未提出解釋，故駁回 LSI 之上訴主張[125]，並對 ITC 判定其無法證明系爭專利之國內產業存在之決定表示支持[126]。

(三) 實務界見解及 ITC 後續發展

於 *InterDigital* 案作出前，即有論者提出有關技術要件之要求與

---

118 Microsoft Corporation v. ITC, 731 F.3d 1354 (Fed. Cir. 2013) [hereinafter Microsoft].
119 *Id.* at 1361-62.
120 *Id.*
121 LSI Corporation v. ITC, 604 Fed. Appx. 924 (Fed, Cir. 2015)[hereinafter *LSI*].
122 *Audiovisual Components, see infra* note 133.
123 *LSI,* 604 Fed. Appx. at 925.
124 *Computer Peripheral Devices, infra* note 131.
125 *LSI,* 604 Fed. Appx. at 927.
126 *Id.* at 925.

否，可由 19 U.S.C. §1337(a)(2) 及 (3) 之條文來辨識[127]。由於 19 U.S.C. §1337(a)(2) 及 (3) 所規定之國內產業，並非以「有無從事生產」做爲區分，而是以「技術發展階段」以判斷產業形成之狀態[128]。「國內產業存在或正在建立中」之條文設計對於技術要件之要求與否，提供了合理且合法之解釋。例如一新創事業或大學將研發成果授權予製造商，在準備生產期間，因無實際成品供申請專利範圍之比對，即無理由要求證明技術要件[129]（構成正在建立中的國內產業）。

此外，值得留意的是，早期 ITC 不要求主張國內授權產業之聲請人證明有受系爭專利保護之物品存在[130]，繼 2013 年 *InterDigitalII* 及 *Microsoft* 案對於主張 19 U.S.C. §1337(a)(3)(C) 之實質投資須證明物品要件表示肯認後，2014 年起開始有 ITC 決定遵循此一原則。2014 年 1 月，*Computer Peripheral Devices* 案[131] 之 ITC 重審決定中，委員會指出 *InterDigital II* 案之結論係指以 19 U.S.C. §1337(a)(3)(C) 主張國內產業要件強調證明物品要件，包括國內授權產業[132]。2014 年 3 月，*Audiovisual Components* 案[133] 之 ITC 重審決定中，委員會亦肯認 *Computer Peripheral Devices* 案支持物品要件之結論[134]。

---

127 Chien, *supra* note 11, at 183-84.

128 *Id.*

129 *Id.*

130 Daniel Muino & Jessica Roberts, *Show Me the Article: The "Articles" Requirement for Domestic Industry Based on Licensing*, MOTO@ITC (Sept. 11, 2015), http://mofoatitc.mofo.com/domestic-industry/show-methe-article-the-articles-requirement-for-domestic-industry-based-on-licensing/.

131 Certain Components and Computer Peripheral Devices, and Components Thereof, and Products Containing Same, Inv. No. 337-TA-841 (Jan. 9, 2014) [hereinafter *Computer Peripheral Devices*].

132 *Computer Peripheral Devices*, Comm'n Op. at 27-28 ("the only plausible interpretation of the opinion is to impose an 'article' requirement for subparagraph (C) domestic industries, including licensing-based domestic industries.")

133 Certain Audiovisual Components and Products Containing the Same, Inv. No. 337-TA-837 (Mar. 26, 2014) [hereinafter *Audiovisual Components*].

134 *Audiovisual Components*, Comm'n Op. at 32 (The Commission now "impose[s] an 'articles' requirement for subparagraph (C) domestic industries, including licensing-based domestic industries."). *See Computer Peripheral Devices*, Comm'n Op. at 32.

以上接連認同以 19 U.S.C. §1337(a)(3)(C) 主張國內產業要件須證明有受系爭專利保護之物品存在，實務界便逐漸體認到 *InterDigital* 案及 *Microsoft* 案判決爲經濟要件之解讀與適用帶來一大變革，物品要件推翻了過去 ITC 習之已久的判斷原則[135]。

二、訴訟支出可否適用於實質投資於系爭專利之授權？

(一) 問題背景

1988 年 337 條款修法後，救濟保護對象不再限於於美國從事生產系爭專利物品之權利人，而擴大至於美國非從事生產，但有從事工程、研發或授權其他業者生產之權利人。根據 ITC 2014 年分析報告之統計，2006 年至 2011 年間非專利實施實體（Non-Practicing Entities，NPEs）聲請人向 ITC 聲請救濟的案量明顯增多[136]，此類聲請人多根據 19 U.S.C. §1337(a)(3)(C) 所規定之「授權活動」主張國內產業要件提起 337 條款調查[137]，對製造商施壓以獲得和解或賠償。此現象恐使 ITC 成爲另一個專利訴訟法庭[138]，卻與 ITC 解決貿易爭議、創造產業生產之目的不符。

---

135 Muino & Roberts, *supra* note 130; Charles Sanders, *Domestic Industry Continued To Evolve At ITC In 2014*, Law360 (Jan. 08, 2015, 1:15PM), http://www.goodwinprocter.com/~/media/Files/Publications/Attorney%20Articles/2015/Domestic%20Industry%20Continued%20To%20Evolve%20At%20ITC%20In%202014.pdf; Chenwei Wang, Daniel Muino&Lynn Levine, *LSI Corp. v. ITC: Federal Circuit Affirms "Articles" Requirement For Domestic Industry*, MOFO@ITC (April 3, 2015), http://mofoatitc.mofo.com/federal-circuit-decisions-re-itc/federal-circuit-releases-lsi-corp-v-itc-opinion/. 關於物品要件，*Interdigital II*案及*Computer Peripheral Devices*案均有不同意見，有關二案不同意見之態度及論述參閱張采揚，參前揭註21，頁68-75、107-09、136-49、171-72。

136 *USITC Section 337 Investigations - Facts And Trends Regarding Caseload And Parties*, 4 (figure: Commission Investigations Instituted 5/16/2006 - Q1 2014), United States International Trade Commission (June. 10, 2014 Update), *available at* https://www.usitc.gov/press_room/documents/featured_news/337facts.pdf. ITC文件提及，有論者認爲2006年美國最高法院eBay判決之後禁制令取得困難，非專利實施實體因此轉向ITC尋求排除令。

137 *Id.* at 3; Weit Wang, *Non-practicing Complainants at the ITC: Domestic Industry or Not?*, 27 Berkeley Tech. L.J. 409, 409 (2012).

138 Broughan, III, *supra* note 12, at 73-75. Broughan, III認爲NPEs會透過ITC之排除令以壯大自身談判籌碼或索求高額費用，衍生問題在於難以區分大學或個人發明人等

透過訴訟手段達成和解而取得授權協議之聲請人，其訴訟支出是否可做爲國內產業要件之證明因而受到關注。

(二) *John Mezzalingua* 案分析

本案主要爭議在於 19 U.S.C. §1337(a)(3)(C) 中規定之「授權」要件，爲取得系爭專利授權協議所爲之侵權訴訟有關之「訴訟支出」於該款適用上之正當性。

針對 ITC 之最終決定，CAFC 肯認 ITC 對於 1988 年所增訂 19 U.S.C. §1337(a)(3)(C) 之法條解釋及修法意旨之闡釋。檢視 (C) 款條文，並無明文規定專利侵權訴訟支出可做爲國內產業存在之證明，然 ITC 並非因此斷然否定條文列舉以外之系爭專利之利用態樣，而是強調在「特定情形」下亦可構成系爭專利之利用，例如當聲請人能證實爲行使系爭專利之專利權所花費之訴訟支出與授權活動有所關聯時。

反之，若僅依據一專利侵權訴訟最終促成授權之事實，即直接認定該訴訟支出爲「授權活動的實質投資」，恐眞有違背 337 條款爲保護美國產業的立法精神，因採如此寬鬆認定，不免過度放低國內產業要件的適用門檻，恐導致原爲鬆綁限制的美意反成爲給予與美國僅有微小關聯的專利權人之濫用空間，並且淡化 ITC 身爲解決貿易相關爭端的角色。因此可見 ITC 及 CAFC 並非限縮國內產業要件之適用對象，而是遵循 337 條款立意，嚴謹判斷聲請人實質投資及與授權之關聯。

(三) *Motiva* 案分析

本案爭議有關聲請人所提出的訴訟與系爭專利之授權間是否有充分關聯以構成國內產業要件。本案因有 *John Mezzalingua* 案[139] 以及 *InterDigi-*

促進創新的NPEs和透過禁制令或排除令作爲威脅手段以濫用專利制度的NPEs。*Also e.g.,* Wang, *supra* note 137, at 421-22; Chien, *supra* note 11, at 177-78; 參前揭註 14，頁92。

139 *John Mezzalingua*, 660 F.3d at 1322.

tal II 案[140]等前例可依循，且因僅涉及事實問題之判斷，故評價過程並不複雜。而且由 *Motiva* 案之前的 ITC 決定中，可看出實質投資於系爭專利之授權之判斷日趨嚴格之發展脈絡，分述如下。

於 *Coaxial Cable Connector* 案[141]中，委員會指出條文設計及立法歷史均強調「唯有能促進發明之實務應用或商業化的授權活動」始能構成系爭專利之利用，同案上訴至 CAFC 即 *John Mezzalingua* 案，其判決結果支持委員會之見解；法院亦同意在「特定情形下」專利侵權訴訟可構成實質投資於系爭專利之利用。

於 *Navigation Devices* 案[142]中，委員會提出應將授權契約區分爲創造產業、生產導向之授權活動（生產導向）及促進營收之授權活動（收益導向），以判斷國內授權產業。委員會指出雖 19 U.S.C. §1337(a)(3)(C) 規定適用於任何授權活動，然而聲請人所主張之授權協議性質偏重於獲取授權金，而不屬於國會修法意旨所鼓勵之生產導向，因而對於收益導向之授權協議給予較低評價[143]。而於 *Motiva* 案之 ITC 決定中，亦援引 *Navigation Devices* 案之先例。

於 *Motiva* 案中，CAFC 認爲實質證據顯示 Motiva 對 Nintendo 的侵權訴訟無助於「促進系爭專利技術之實務應用（生產導向）」，而僅係爲「取得損害賠償金或和解金（收益導向）」，可證該訴訟與促進專利之實務應用無充分關聯，與 19 U.S.C. §1337(a)(3)(C) 欲保護授權產業之精神不一致。

(四) 訴訟活動與專利授權實質投資之判斷與評價

---

140 *InterDigital II,* 707 F.3d at 1295.

141 *Coaxial Cable Connectors*, Comm'n Op. at 49. *See* Chien, *supra* note 11, at 180.

142 Wang, *supra* note 137. *See also Navigation Devices*, Comm'n Op. at 435 ("Pioneer's activities, on the whole, reflect a revenue-driven licensing model targeting existing production rather than the industry-creating, production-driven licensing activity that Congress meant to encourage…Although our statute requires us to consider all "licensing" activities, we give Pioneer's revenue-driven licensing activities less weight.")

143 *Id.* 參前揭註14，頁111-12。

在 *John Mezzalingua* 與 *Motiva* 二案中，CAFC 針對聲請人之訴訟目的與授權性質之爭議嚴謹審視，以遵循 337 條款保護國內產業之精神及 1988 年修法新增授權規定之立意，維持 ITC 爲「貿易法庭」之本質，而非「智慧財產權法庭」。

根據上述分析，本文將訴訟活動與專利授權實質投資之判斷與評價，歸納如圖 1，以便說明 ITC 及 CAFC 對於訴訟活動及其支出、以及訴訟結果之授權契約於實質投資於系爭專利之利用上之判斷與評價。*John Mezzalingua* 案主要探討權利人主張之訴訟支出是否構成實質授權投資？ CAFC 認爲，倘若訴訟目的是爲了促使建立授權協議，則肯定該訴訟支出爲授權投資；倘若訴訟目的是爲了取得禁制令以禁止生產侵權產品，則與 1988 年關稅法新增授權規定之精神不符，因而否定這類證據。*Motiva* 案則是探討權利人之訴訟活動欲促成之授權關係是爲了促進專利產品之生產，或單純爲獲得財務上利益？當授權目的是爲了促進系爭專利之實務應用，在實質投資之認定上將獲得較高評價；而單純爲了獲取財務上利益則獲得較低評價。

如圖 1 所示，探討訴訟目的時，由於權利人向地方法院提起專利侵權訴訟是爲了取得禁制令以禁止廠商生產，而非爲了授權協議，本文將訴訟目的之性質區分爲「禁止生產（injunction）」及「促進授權（licensing）」，而僅有促進授權的目的爲法院所採納。探討授權性質時，由於權利人訴訟活動欲促成之授權關係是單純爲了獲得財務上利益，而非爲了促進專利產品之生產，本文將授權契約之性質區分爲「生產導向（production-driven）」及「收益導向（revenue-driven）」，而分別有高低不同之評價。

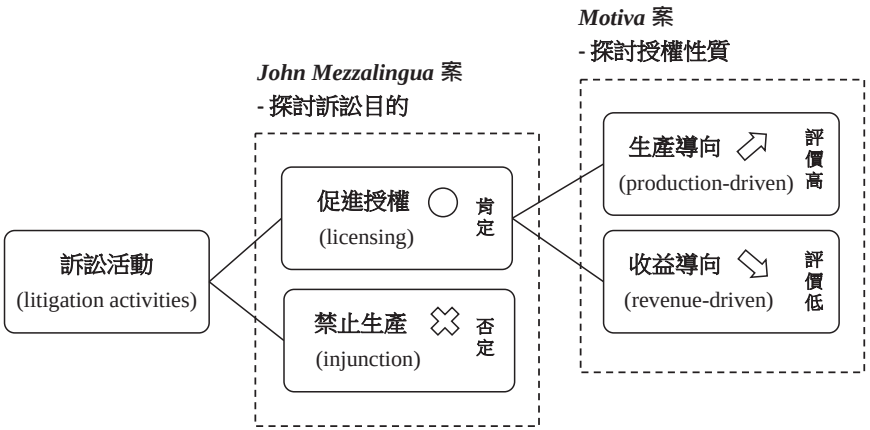

圖1：訴訟活動與專利授權實質投資之判斷與評價（本研究整理繪製）

伍、結論與建議

根據 1988 年關稅法修法意旨，因國會認爲 ITC 對於國內產業要件之判斷過於嚴格，爲能允許能夠證明有授權或研發等非生產活動之聲請人亦能獲得救濟適格，因而增訂 19 U.S.C. §1337(a)(3)(C) 之工程、研發及授權等三類經濟活動，並排除「國內生產要件」，以放寬國內產業要件之限制。惟同時要求智慧財產權所有權人有積極從事其智慧財產的「利用」始能聲請調查[144]，以避免僅擁有美國專利權之權利人對於 337 條款調查之濫用。由近期 CAFC 相關案件發展觀察，國內產業要件、尤其是主張實質投資於系爭專利之利用，並非一低門檻。

CAFC 於 *InterDigital I* 案上訴判決中肯認 ITC 見解，即基於 19 U.S.C. §1337(a)(3)(C) 主張實質投資於系爭專利之授權之聲請人，可將專利授權單獨作爲國內產業存在之根據，無須要求有國內生產活動，僅須證明

[144] H.R. Rep. No. 100-40, at 157; S. Rep. No. 100-71, at 130, *cited in John Mezzalingua*, 660 F.3d 1322.

有實質投資於系爭專利之利用。然而，值得留意的是，CAFC 於 *Inter-Digital II* 案重審駁回裁定中，就經濟要件判斷發展出之「物品要件」不同於 ITC 習之已久之判斷原則，指出根據 19 U.S.C. §1337(a)(3)(C) 以投資活動主張國內產業要件必須證明是否「與受專利保護之物品有關」，例如國內授權產業必須證明授權產品存在，惟授權產品不限於國內生產。

根據 *John Mezzalingua* 案[145] 及 *Motiva* 案[146]，專利侵權訴訟不自動構成實質投資於系爭專利之利用，必須符合特定情形。訴訟活動必須爲「促進授權」爲目的，而能促使對造接受授權，以證實該訴訟與系爭專利之利用有合理關聯。反之，倘若訴訟目的爲單純「禁止生產」而與授權無關則不應採認，否則恐有過度放低國內產業要件門檻之虞。專利侵權訴訟所欲促成之授權協議，其性質需爲「生產導向」，該訴訟始能構成與系爭專利之利用的充分關聯。反之，倘若訴訟目的僅爲獲得損害賠償金或和解金，則相關授權活動之性質應被視爲「收益導向」，而無助於系爭專利之實務應用。

由於國內產業要件之適用門檻對於在美國無生產活動之聲請人而言並非易事；相對於答辯人而言則可能成爲答辯優勢。337 條款調查程序速度快、成本高、壓力大，台灣廠商除平時做好智權管理外，倘若於 ITC 被列爲 337 條款調查對象，除了侵權比對或專利有效性等攻防外，可直接針對聲請人之國內產業要件提出攻擊，一旦主張成功，有助於案件迅速終結，節省可觀的訴訟資源。而且台灣許多廠商均有涉及跨國營運，主動聲請 337 條款調查或被列爲答辯人之案件增多，了解聲請人應如何滿足「國內產業要件」、答辯人應如何有效反制，實爲台灣廠商首當之務。

本文根據 CAFC 近期系爭專利授權實質投資相關案件發展，並將後續相關 ITC 決定輔以參考，爲台灣廠商面臨 337 條款調查時提供建議如

145 *See John Mezzalingua*, 660 F.3d 1322.
146 *See Motiva*, 716 F.3d 596.

下：

一、針對以「實質投資於系爭專利之授權」主張國內產業要件之聲請人

(一) 必須證明實質投資與受系爭專利保護之物品有關，例如證明有專利授權產品之存在。即便聲請人本身無從事生產，亦無須限於授權國內廠商生產，授權國外廠商生產之專利產品亦可做爲主張國內產業要件之依據。

(二) 應爲各項專利或專利組合擬定正式的授權計畫，並應確保訴訟前及訴訟中均應採取授權相關活動，如訴訟前寄發警告函提出授權方案或確認授權意願，訴訟中提出協商授權意願。

(三) 訴訟目的須爲「促進授權」。欲以行使專利權所花費之「訴訟支出」以示爲系爭專利授權之實質投資，需證明該侵權訴訟爲授權計畫之其中一步驟，即用以刺激授權機會，始能證實該訴訟與授權有關。

(四) 授權性質須爲「生產導向」。若以「訴訟支出」證明專利授權之實質投資，該侵權訴訟所欲促成之授權協議必須能促進系爭專利之實務應用，如專利技術商品化、將專利產品量產上市，該訴訟始能構成與系爭專利之利用的充分關聯。

(五) 留意授權支出及授權收益之實質性與關聯性。授權支出及相應收益之數額必須明確具體，尤其系爭專利爲專利組合授權協議中之一部分，應確實掌握並區分出與系爭專利相關之支出及收益之比重。

(六) 留意投入系爭專利利用之資源與本身事業規模之對等性。欲判斷投資是否實質，需綜合考量投資金額、產業性質及本身事業規模，因此即便是大規模企業亦可能因爲對系爭專利之投資金額相對低，而無法構成實質投資。

(七) 建立智財控管機制並確實執行。聲請人應將平日專利研發或授

權工作內容明確記載與管控，包括外部律師顧問費及內部智財相關人事費，細則至薪資數額、工作時數、案件標的均應詳加紀錄，未來涉訟時便能對授權投資之實質性及關聯性順利舉證。

二、針對以「實質投資於系爭專利之授權」推翻國內產業要件之答辯人

(一) 挑戰聲請人之國內產業要件，尤其是能否證明有受爭專利保護之物品存在。若聲請人未能提出相關專利產品，即無法建立與美國產業之充分關聯，而不符合救濟資格。

(二) 留意聲請人之訴訟目的是否僅爲「禁止生產」。若聲請人起訴之用意是爲取得禁制令或損害賠償、和解金等非促進授權關係之建立，則答辯人可主張其訴訟目的與授權無關。

(三) 留意聲請人之授權協議性質是否爲「收益導向」。因國會修法意旨所鼓勵及保護之授權活動爲「生產導向」，因此實務上對於「收益導向」之授權協議給予較低評價。倘若授權協議之形成過程或目的並非爲促進系爭專利之實務應用，則可提出爭執。

(四) 留意聲請人針對系爭專利之授權支出及授權收益。支出或收益均應限於與系爭專利相關或有所貢獻之部分，始得做爲與系爭專利之利用相關之投資判斷。

(五) 留意聲請人所投入系爭專利利用之資源與其事業規模之對等性。答辯人可要求聲請人提出投入於系爭專利授權工作之投資比重，包括律師顧問費、人員薪資、工作時數及案件標的。

綜上歸納，國內產業要件並非一低門檻，CAFC 對於國內產業要件、尤其是實質投資於專利授權之判斷趨於嚴格。*InterDigital II* 案所形成之物品要件，要求聲請人主張 19 U.S.C. § 1337(a)(3)(C) 之實質投資須證明與受專利保護之物品有關，可見須有受系爭專利保護之物品存在，專利授

權產品則不一定於美國生產。此一變革不僅顯示以 19 U.S.C. § 1337(a)(3)(C) 之經濟活動主張國內產業要件之規定趨於嚴格，相關爭議之後續發展亦值得持續關注。

參考文獻

中文部分

期刊論文

李柏靜，台灣廠商涉及美國337調查之實證研究—兼論國內產業要件，智慧財產評論，10卷2期，頁73-132，2013年1月。

研討會論文

李柏靜，台灣廠商涉及美國337調查之實證研究，2012世新美國專利訴訟國際學術研討會暨模擬法庭，世新大學智慧財產權研究所主辦，2012 年4 月20日。

學位論文

林育琪，美國337條款調查國內產業要件之研究－以實質投資於系爭專利之授權爲中心，世新大學智慧財產權法律研究所碩士論文，2013年7月。

張采揚，337條款調查國內產業要件之研究－以實質投資於專利授權之「物品要件」爲中心，世新大學智慧財產權法律研究所碩士論文，2016年2月。

英文部分

書籍

Mcmanus, Michael G. & Sweetland Iii, Rodney R., Section 337 Investigations: Unfair Trade Practice Litigation Before the ITC (2014).

Schaumberg, Tom M., A Lawyer's Guide to Section 337 Investigations Before The U.S. International Trade Commission (2D ED. 2012).

期刊論文

Broughan, III, Thomas A., *Modernizing § 337's Domestic Industry Requirement for the Global Economy*, 19 Fed. Cir. B.J. 41 (2009).

Chien, Colleen V., *Patently Protectionist? An Empirical Analysis of Patent Casesat the International Trade Commission*, 50 Wm. & Mary L. Rev. 63 (2008).

Chien, Colleen V., *Protecting Domestic Industries at the ITC,* 28 Santa Clara High Tech. L.J. 169 (2011), *available at* http://digitalcommons.law.scu.edu/chtlj/vol28/iss1/5.

Czebiniak, Taras M., *When Congress Gives Two Hats, Which Do You Wear? - Choosing between Domestic Industry Protection and IP Enforcement in Sec. 337 Investigations,* 26 BERKELEY TECH. L.J. 93 (2011), *available at* http://scholarship.law.berkeley.edu/btlj/vol26/iss1/5.

Lasher, S. Alex, *The Evolution Of The Domestic Industry Requirement In Section 337 Investigations Before The United States International Trade Commission*, 18 U. BALT. INTELL. PROP. L.J. 157 (2010).

Reiziss, Jay H., *The Distinctive Characteristics of Section 337*, 8 J. MARSHALL REV. INTELL. PROP. L. 231 (2009).

Schwartz, Bryan A., *Where the Patent Trials Are: How the U.S. International Trade Commission Hit the Big Time as a Patent Litigation Forum,* 20(2) INTELL. PROP. L. NEWSL.,Vol 20, No. 2 (2002).

Wang,Weit, *Non-practicing Complainants at the ITC: Domestic Industry or Not?*, 27 Berkeley TECH. L.J. 409 (2012).

法院判決

Alloc, Inc. v. ITC, 342 F.3d 1361 (Fed. Cir. 2003).

Bally/Midway Mfg. v. ITC, 714 F.2d 1117 (Fed. Cir. 1983).

InterDigital Communications, LLC v. ITC, 690 F.3d 1318 (Fed. Cir. 2012).

InterDigital Communications, LLC v. ITC, 707 F.3d 1295 (Fed. Cir. 2013).

John Mezzalingua Associates v. ITC, 660 F.3d 1322 (Fed. Cir. 2011).

LSI Corporation v. ITC, 604 Fed. Appx. 924 (Fed, Cir. 2015).

Microsoft Corporation v. ITC, 731 F.3d 1354 (Fed. Cir. 2013).

Motiva, LLC v. ITC, 716 F.3d 596 (Fed. Cir. 2013).

Schaper Mfg. Co. v. ITC, 717 F.2d 1368 (Fed. Cir. 1983).

美國國際貿易委員會決定

Certain 3g Mobile Handsets & Thereof, Inv. No. 337-TA-613 (Apr. 1, 2010).

Certain Ammonium Octamolybdate Isomers, Inv. No. 337-TA-477 (Jan. 5, 2004).

Certain Audiovisual Components and Products Containing the Same, Inv. No. 337-TA-837 (Mar. 26, 2014).

Certain CD-ROM Controllers and Products Containing the Same-II, Inv. No.337-TA-409 (Oct. 18, 1999).

Certain Coaxial Cable Connectors and Components Thereof and Products Containing Same, Investigation No. 337-TA-650, Initial Determination (Apr. 14, 2010).

Certain Components and Computer Peripheral Devices, and Components Thereof, and ProductsContaining Same, Inv. No. 337-TA-841 (Jan. 9, 2014).

Certain Digital Processors and Digital Processing Systems, Components Thereof and Prods. Containing Same, Inv. No. 337-TA-559, Initial Determination (Jun. 21, 2007).

Certain Dynamic Random Access Memories, Components Thereof and Products Containing Same, Inv. No. 337-TA-242 (1987).

Certain Dynamic Sequential Gradient Compression Devices and Component Parts Thereof, USITC Pub. 2575, Inv. No. 337-TA-335, Initial Determination (Nov. 1992).

Certain Gel-Filled Writs Rests and Products Containing Same, Inv. No. 337-TA-456 (Jan. 2003).

Certain Methods of Making Carbonated Candy Products, Inv. No. 337-TA-292, USITC Pub. 2390 (Jun. 1991).

Certain Miniature, Battery-Operated, All-Terrain, Wheeled Vehicles, Inv. No. 337-TA-122, USITC Pub. 1300 (Oct. 1982).

Certain Multimedia Display and Navigation Devices and Systems, Components Thereof, and Products Containing Same, Inv. No. 337-TA-694, USITC Pub. 4292 (Nov. 2011).

Certain Semiconductor Chips with Minimized Chip Package Size and Products Containing Same, Inv. No. 337-TA-432, Order No. 13 (Jan. 24, 2001).

Certain Short-Wavelength Light Emitting Diodes, Laser Diodes and Products Containing Same, USITC Inv. No. 337-TA-640 (Feb. 19, 2008).

Certain Variable Speed Wind Turbines and Components Thereof, Inv. No. 337-TA-641 (Mar. 2010).

Certain Video Game Sys., No. 337-TA-743 (Jan. 5, 2012).

Certain Welded Stainless Steel Pipe and Tube, USITC Pub. 863, Inv. No. 337-TA-29 (Feb. 1978).

其他

United States International Trade Commission, Section 337 investigation At The U.S. International Trade Commssion: Answers To Frequently Asked Questions, Publication No. 4105 (Mar. 2009 ed.), *available at* http://www.usitc.gov/intellectual_

property/documents/337_faqs.pdf.

U.S. International Trade Commission, Facts and Trends Regarding Usitc Section 337 Investigations (April 15, 2013 Update), *available at* https://www.usitc.gov/press_room/documents/featured_news/sec337factsupdate.pdf.

U.S. International Trade Commission, Usitc Section 337 Investigations - Facts and Trends Regarding Caseloadand Parties (Jun. 10, 2014 Update), *available at* https://www.usitc.gov/press_room/documents/featured_news/337facts.pdf.

Chenwei Wang, Daniel Muino & Lynn Levine, LSI Corp. v. ITC: Federal Circuit Affirms "Articles" Requirement For Domestic Industry (April 3, 2015), http://mofoatitc.mofo.com/federal-circuit-decisions-re-itc/federal-circuit-releases-lsi-corp-v-itc-opinion/.

Facts And Trends Regarding USITC Section 337 Investigations, United States International Trade Commission (Apr. 15, 2013), *available at* https://www.usitc.gov/press_room/documents/featured_news/sec337factsupdate.pdf

Muino, Daniel & Roberts, Jessica, Show Me the Article: The "Articles" Requirement for Domestic Industry Based on Licensing (Sep. 11, 2015), http://mofoatitc.mofo.com/domestic-industry/show-me-the-article-the-articles-requirement-for-domestic-industry-based-on-licensing/.

Sanders, Charles, Domestic Industry Continued To Evolve At ITC In 2014, Law360, New York (Jan. 08, 2015), http://www.goodwinprocter.com/~/media/Files/Publications/Attorney%20Articles/2015/Domestic%20Industry%20Continued%20To%20Evolve%20At%20ITC%20In%202014.pdf.

*Section 337 Investigation at the U.S. International Trade Commssion: Answers to Frequently Asked Question*s, United States International Trade Commission (2009), *available at* http://www.usitc.gov/intellectual_property/documents/337_faqs.pdf.

USITC Section 337 Investigations - Facts And Trends Regarding Caseload And Parties, 4 (figure: Commission Investigations Instituted 5/16/2006 - Q1 2014), United States International Trade Commission (Jun. 10, 2014 Update), *available at* https://www.usitc.gov/press_room/documents/featured_news/337facts.pdf.

封鎖侵權網站？從英國法及歐盟判決論封網定暫時狀態處分之演進

江雅綺*

目次

* 國立台北科技大學智慧財產研究所助理教授
投稿日期：2016年4月7日；接受刊登日期：2016年7月21日。

摘要

網路時代的侵權行爲，在侵權人與著作權人之間，多了一個第三方「網路服務提供者」，侵權責任的探討，也隨著科技發展，由直接侵權逐漸轉移至間接侵權。於是，如何在數位科技發展下保障著作權人的權利、同時又兼顧網路使用者與網路服務提供者（Internet Service Providers，ISP）的權益，一直是著作權法制在數位時代的重要挑戰。

有關ISP對網路侵權行爲所應負有的責任，早期著作權人試圖透過ISP業者的自律條款、教育使用者勿蹈侵權法網，但近年來，ISP責任有逐漸由自律規範移向政府立法的趨勢。臺灣於2009年，便增訂《著作權法》第六章之一，大致以美國數位千禧年著作權法的避風港規定爲參考，要求網路服務提供者「通知取下」以爭取民事免責。

但科技日新月異，網路侵權手法亦不斷翻新，在大西洋另一端的歐洲，漸有ISP業者應負擔「通知取下」以外的科技義務之聲音出現。爲了呈現另一種觀點，本文即以目前備受關注的「封鎖網站的定暫時狀態處分」（site blockinginjunction）爲例，由2003年英國著作權法中新增權利人可向法院聲請ISP定暫時狀態處分之源起，繼而介紹英國2010年的《數位經濟法》中更細膩與廣泛的ISP責任與暫時封鎖處分的規定，最後以歐盟2014年允許空白的封網定暫時處分的判決，總結分析近年歐盟有關封網定暫時狀態處分的發展趨勢。

關鍵字：著作權、侵權、定暫時狀態處分、封鎖網站、網路服務提供者

The Evolution of Site Blocking Injunction in Europe: From UK CDPA 1988, DEA 2010, To CJEU Case

Ya-Chi Chiang**

Abstract

Along with the technology developments, the central debate of tacking copyright infringement in the digital environment has moved from direct liabilities by users to possible indirect liabilities by Internet Service Providers (ISP). Therefore, how to balance the copyright protection, internet users' freedom of expression and ISP's rights to carry out commercial activities, has been one of the most challenging tasks to copyright reforms.

In regard of ISP liabilities for internet users' copyright infringements, copyright holders used to urge ISP set up a self-regulatory model to educate users, preventing users from violating copyright laws. Nonetheless, in recent years, there is a trend to pen down ISP liabilities into statutory laws. Taking Taiwan for example, in 2009 it added a new chapter to introduce ISP safe harbor rules into its copyright act. The new chapter follows the DMCA model in the US, requesting

** Assistant Professor, Graduate Institute of Intellectual Property, National Taipei University of Technology.

ISP to take down disputed content after they receive notices from copyright holders in order to be immune from possible infringement liabilities in the future.

Yet the copyright infringements methods advance along with the technology, some may begin to wonder whether the aforementioned "Notice and Take Down" has become not only a safe harbor for ISP but also for copyright infringers. At the other side of the Atlantic Ocean, some countries of Europe started to think whether there are more options to regulate ISP to enhance copyright protection. Leaning against this background, this article focuses on one of most debated measure against ISP: site blocking injunction which aimed at ordering ISP to block disputed websites and prohibit users from accessing them. The author takes UK for example to introduce the firstsite blocking injunction rule added in Copyright, Design and Patent Act in 2003,followinga more comprehensive technical obligations against ISP pushed forward by Digital Economy Act in 2010. Subsequently, this article analyzes the technical efficiency of site blocking injunction and further examines the legal justification of it with the CJEU case in 2014. In the conclusion, the author looks at the current ISP chapter in Taiwan Copyright Act and renders suggestions by summarizing the previous analysis and examination on site blocking injunction practice.

Keywords: Copyright, Infringement, Injunction, Site blocking, Internet service providers

壹、前言

套用大文豪狄更斯的話：「這是一個最好的時代，也是一個最壞的時代!」文字、影音、以及各式各樣內容的創作者，可以將透過網路將自己的著作傳送到全世界，只需負擔連線上網的成本。但另一方面，侵害著作權以得利的網路使用者，也一樣受惠於數位時代，可以用最低的成本與便捷的科技、高效率地向全世界散播侵權內容。網路時代的侵權行爲，之所以如此棘手，正是因爲多了一項「科技因素」。科技因素在數位時代扮演關鍵仲介角色，也讓侵權人與著作權人之間，多了一個第三方「網路服務提供者」，侵權責任的探討，也隨著科技發展，由直接侵權逐漸轉移至間接侵權[1]。如何在數位科技發展下保障著作權人的權利、以達到著作權法以經濟利益獎勵著作權人辛苦創作的目的，同時又兼顧網路使用者與網路服務提供者（Internet Service Providers，ISP）的權益，一直是著作權法制在數位時代的重要挑戰。

從著作權人的角度出發，固然希望要求網路服務提供者負起更多責任；但從網路服務業者的角度出發，著作權人的權益應該由著作權人自己負起保衛的責任。有關 ISP 對網路侵權行爲所應負有的責任，早期著作權人試圖透過 ISP 業者的自律條款、教育使用者勿蹈侵權法網，但近年來，ISP 責任有逐漸由自律規範移向政府立法的趨勢[2]。以臺灣而言，於 2009 年增訂《著作權法》第六章之一「網路服務提供者之免責事由」，基本上是參考美國《數位千禧年著作權法》的避風港條款而定[3]，透過建立 ISP 收到侵權通知時移下相關內容方可免責的機制，間接課予 ISP 通知取下的義務，關於此章，已有許多學者做出豐富精彩的比較與評析[4]。

---

1 馮震宇，數位環境下著作權侵害之認定及相關案例研討，臺灣法學雜誌，206期，頁41-67，2012年8月。

2 Adrienne Muir, *Online Copyright Enforcement by Internet ServiceProviders,39(2)* J.INFO. SCI., 256-269 (2013).

3 李治安，網路服務提供者民事免責事由之要件分析，中央研究院出版，頁451-490，2014年。

4 王怡蘋，著作權法關於網路服務提供者之民事免責規範，月旦法學雜誌，173期，頁25-41，2009年10月；章忠信，二〇〇九年新修正著作權法簡

但科技日新月異，網路侵權手法亦不斷翻新，在大西洋另一端的歐洲，漸有 ISP 業者應負擔「通知取下」以外的科技義務之聲音出現。爲了呈現另一種觀點，本文即以英國爲例，由 2003 年英國《1988 著作權，設計與專利法》（Copyright, Designs and Patents Act 1988，CDPA 1988）中新增權利人可向法院聲請 ISP 封網之定暫時狀態處分[5]之源起，繼而介紹英國 2010 年的《2010 數位經濟法》（Digital Economy Act，DEA 2010）中更細膩與廣泛的 ISP 責任與封網定暫時狀態處分的規定，同時由法院判決及科技分析兩個層面，討論其相關規定的優劣，最後並以歐盟 2014 年有關電子商務指令針對網路服務業者的空白封網定暫時狀態處分判決，做一結論。

貳、封鎖侵權網站？英國法規的演進

一、英國著作權法：由CDPA 1988 到DEA 2010

英國規範著作權的法律爲《1988 著作權，設計與專利法》（Copyright, Designs and Patents Act 1988，CDPA 1988），於 2003 年，因應數位時代

析—網路服務提供者之責任限制，月旦法學雜誌，173期，頁5-24，2009年10月。沈宗倫，對於我國著作權法關於網路服務提供者民事責任豁免立法之初步評析，中正財經法學，1期，頁257-298，2010年1月。姚信安，從美國法角度探討我國著作權民事間接侵權責任相類制度，中正財經法學，2期，頁139-201，2011年1月。李治安，失衡的承諾：著作權法責任避風港規範之立法政策評析，臺大法學論叢，43卷1期，頁143-207，2014年3月。

5 本文接受審查時，曾有審查委員提出injunction應從國內多數學者習慣譯爲「禁制令」，但作者認爲，英文用語的翻譯似乎應以其意義而定，而非限定於國內多數學者的用語。所謂「禁制令」，其意指禁止當事人做某種行爲。但在CDPA 以及DEA的規定中，是在侵權爭訟並未確定之前，即要求ISP業者採取封鎖特定網站的措施，它所針對的，並非侵權當事人（禁止其繼續爲侵權行爲），而是要求ISP業者先將網站封鎖。因此，作者認爲，在此規範意義之下，翻譯爲「禁制令」反而失眞。而「定暫時狀態處分」更能體現此是針對ISP業者採取某種措施的處分。且搜索2016年5月的最新關於封網主題的文獻中（邵瓊慧著，發表於月旦法學雜誌），亦有將此injunction譯爲「定暫時狀態處分」，顯見此中文名詞並非僅有作者獨用。故此本文皆將injunction譯爲「定暫時狀態處分」，並將site blocking injunction譯爲「封鎖網站之定暫時狀態處分」，簡稱「定暫時封網狀態處分」或「封網之定暫時狀態處分」。

的侵權問題，也爲符合歐盟 2001 年的著作權指令第 8 條第 3 項（要求會員國應確保著作權人可向提供服務被第三人用來侵權的仲介者聲請定暫時狀態處分）[6]，該法新增第 97A 條「對服務提供者之定暫時狀態處分（Injunctions against service providers）」[7]。該條第一項規定：「若服務提供者確實知道（actual knowledge）他人正使用其服務侵害著作權，高等法院有權對服務提供者爲定暫時狀態之處分。」至於如何判定服務提供者「確實知道」，同條第二項要求法院應考量下列情狀：(a) 服務提供者是否收到通知，(b) 通知內容含：寄送通知者的全名和住址、以及侵權行爲的細節。

由於第 97A 條所能爲之定暫時狀態處分，需以「服務提供者對侵權行爲知情」，亦即「侵權行爲存在」爲前提，導致著作權人無法援引此條，對未來可能發生之侵權預做防範。這在如現場活動的影音串流直播，就有遠水救不了近火之遺憾。其次，依第 97A 條，定暫時狀態之處分僅能針對「侵權之爭議內容」，因此，這也讓著作權人批評處分之範圍過窄。

2010 年 4 月[8]，英國進一步提出《數位經濟法》（Digital Economy Act 2010，以下簡稱 DEA 2010）[9]，其中有關網路非法傳輸檔案行爲的部分，將原本業界自律協議中所採行的警告侵權方案，進一步深化、並落實於法律規定中，於法律中賦予網路服務提供者一定的科技義務（technical obligation）。所謂科技義務，主要即指網路服務對者對使用者採行

6 Directive 2001/29, of the European Parliament and of The Council of 22 May 2001 on the Harmonization of Certain Aspects of Copyright andRelated Rights in the Information Society, 2001 O.J. (L 167) 18, article 8.3: “Member States shall ensure that rightholders are in a position to apply for an injunction against intermediaries whose services are used by a third party to infringe a copyright or related right.”

7 Section 97A of CDPA 1988, *available at* http://www.legislation.gov.uk/ukpga/1988/48/section/97A (last visited July 24, 2016).

8 江雅綺，英國《數位經濟法》中網路服務提供者對侵權使用者的科技義務，科技法學論叢，8期，頁187-212，2012年12月。

9 Digital Economy Act 2010，*available at* http://www.legislation.gov.uk/ukpga/2010/24/notes/contents (last visited May 31, 2016).

各種限制其使用網路服務的措施[10]。

析論之，該法第 3 條至第 18 條均爲針對線上侵害著作權行爲之規範（Online Copyright Infringements）。首先，針對網路服務提供者通知侵權使用者的義務，該法第 3 條授權英國主管通訊傳播的機關「通訊辦公室」（Office of Communication, Ofcom）可制定《初步義務命令》（Initial Obligation Code）[11]，於命令中要求網路服務提供者於收到著作權利人認爲某使用者侵害其權利之報告時，應通知該使用者。第 4 條[12]則授權《初步義務命令》可要求網路服務提供者於著作權利人要求下，應交出網路侵權行爲之明細表（但不用指出該疑似侵權使用者的身份）。

《初步義務命令》主要規範網路服務提供者對使用者與著作權利人的告知義務。有關進一步要求網路服務提供者限縮使用者使用網路服務的科技義務，則續規範於第 9 條[13]，該條第二項定義了何謂「科技義務」（technical obligation），指的是網路服務提供者爲了減少透過網路對著作權的侵害，對使用者採行某些科技措施（technical measure）。而第 3 項，則接續說明所謂的科技措施，可包括 (1) 限制該使用者網路連線服務的速度或容量 ; (2) 禁止該使用者透過網路服務接近某些內容、或限制其使用 ; (3) 暫停該使用者的網路服務 ; (4) 其他限制該使用者網路服務的方式。而該法第 10 條第 1 項則規定[14]，授權政府在 Ofcom 經過一定的評估程序與報告後，得以命令施加網路服務提供者負擔前條的科技義務。

除了授權政府得在經過一定的法定程序、符合一定的法定要件之

---

10 DEA 2010第10條標題即爲「Obligations to limit internet access」，同法第9條中並明列了四種限制使用者網路服務的措施。

11 DEA 2010 § 3, *available at* http://www.legislation.gov.uk/ukpga/2010/24/section/3 (last visited July 24, 2016).

12 DEA 2010§ 4, *available at* http://www.legislation.gov.uk/ukpga/2010/24/section/4 (last visited July 24, 2016).

13 DEA 2010§ 9, *available at* http://www.legislation.gov.uk/ukpga/2010/24/section/9 (last visited July 24, 2016).

14 DEA 2010§ 10, *available at* http://www.legislation.gov.uk/ukpga/2010/24/section/10 (last visited July 24, 2016).

下，得以命令網路服務提供者負擔告知與採行科技措施的義務，該法也進一步授權政府可立法請求法院發給禁止使用者接觸侵權網站內容的定暫時狀態處分（Power to make provision about injunctions preventing access to locations on the internet），以下簡稱爲「暫時封鎖處分」（blocking injunction）。第 17 條第 1 項規定指出「政府可以立法提供暫時封鎖處分之相關規範，規定倘若法院認爲某網路連線位置（a location on the internet）正在或可能在做爲侵害著作權活動之用，則法院可依聲請定暫時封鎖處分[15]。」

值得注意的是，第 17 條第 1 項並非直接規定，而是授權給英國政府做爲制定法規的法源，而同條第三項則規定：「除非符合下列三項要件，政府不得進行本條所授權之立法：(1) 使用網路連線以侵害著作權之行爲對商業或消費者有嚴重的不良影響；(2) 本立法是因應上述不良影響的適當方式；(3) 本立法不會影響國家安全、或犯罪防制[16]。」

總結而言，DEA2010 第 3 條與第 4 條，授權政府制定網路服務提供者通知使用者、列出疑似侵權使用者資料的義務命令；而第 9 條和第 10 條，則爲授權政府命令網路服務提供者限縮使用者使用服務的科技義務法源。同法第 17 條，則爲授權政府立法讓著作權人可透過法院聲請暫時封鎖處分的立法依據。因此，DEA 2010 的規範，主要是授權予政府立法規範三項 ISP 責任的依據，這些責任依條文前後順序排列，分別爲告知

15 DEA 2010 § 17(1),
"The Secretary of State may by regulations make provision about the granting by a court of a blocking injunction in respect of a location on the internet which the court is satisfied has been, is being or is likely to be used for or in connection with an activity that infringes copyright."

16 DEA 2010 § 17(3),
"The Secretary of State may not make regulations under this section unless satisfied that—
(a) The use of the internet for activities that infringe copyright is having a serious adverse effect on businesses or consumers,
(b) Making the regulations is a proportionate way to address that effect, and
(c) Making the regulations would not prejudice national security or the prevention or detection of crime."

侵權義務、限縮使用者使用服務義務、以及依法院處分暫時封鎖特定網路位址的責任。

與 CDPA 1988 的規定相較，DEA 2010 提供了更明確且廣泛的科技義務措施，甚至包含終止網路連線的高強度措施。而於著作權人聲請法院定暫時狀態的處分（Injunction）上，相較 CDPA 1988，DEA 2010 的要件也較寬鬆，並不以「服務提供者知情」爲要件，而以「該網站是否正被使用進行侵權行爲」。此外，依據 DEA 2010 第 17 條的規定，著作權人亦可針對「未來可能發生之侵權行爲」請求定暫時狀態之處分。

總結來說，DEA 2010 的規定偏重保障著作權人、而對網路服務業者課予較重的責任[17]。而兩者之間的關係，則規範於 DEA 2010 第 17 條的第八項[18]，指出依據第 17 條所爲之立法可修改 CDPA 1988 第 6 章第 1 節規定（亦即第 97A 條所在章節）與相關的從屬規定。換言之，由於 CDPA 1988 第 97A 條與 DEA 2010 第 17 條均有關權利人聲請法院定暫時狀態封鎖處分的規範，但一旦 DEA 2010 的立法完成後，其效力將優於 CDPA 1988 的第 97A 條。於是，DEA 2010 與 CDPA 第 97A 並存時，英國的 ISP 責任，呈現由 CDPA 第 97A 的暫時封鎖處分、DEA 2010 17 條的擴大版暫時封鎖處分（但尚未立法）以及 DEA 2010 第 9 條的科技義務共同組成的圖像[19]。不過需要說明的是，其後 DEA 第 17 條於 2015 年被刪除，因此，目前英國的定暫時封鎖處分仍以 CDEPA1988 第 97A 條規定爲主。

二、2010數位經濟法（DEA 2010）第17條（暫時封鎖處分）之分析

17 Daithí Mac Síthigh, *The Fragmentation of Intermediary Liabilityin the UK,* 8(7) J.Intell. Prop. L. & Prac. 521, 522 (2013).

18 DEA 2010 § 17(8),
"The regulations may—
(a) modify Chapter 6 of Part 1 of the Copyright, Designs and Patents Act1988, and
(b) make consequential provision modifying Acts and subordinatelegislation."

19 Sithigh, *supra* note 17 at 552.

承上段所述，DEA 2010 中第 17 條，是授權政府立法、讓著作權人可向法院申請暫時封鎖處分的核心規定，依據此條，政府可以立法提供暫時封鎖處分之相關規範，規定倘若法院認爲某網路連線位置（a location on the internet）正在或可能在做爲侵害著作權活動之用，則法院可依聲請定暫時封鎖處分[20]。

需注意的是，第 17 條第一項項並非直接規定權利人可聲請暫時封鎖處分，而是授權給英國政府做爲制定法規的法源，且不同於之前的告知與科技義務可以命令爲之，本條第 11 項，要求政府所提出的本條相關立法需經國會決議通過[21]。另外並明確規定政府何時可提出此相關立法、立法內容應有哪些…等，可見英國有關要求 ISP 暫時封鎖侵權網址處分立法之謹愼。爲便於讀者理解英國對此暫時封鎖處分立法之愼重，以下則一一介紹第 17 條的規定內容。

第 17 條第 3 項則規定：「除非符合下列三項要件，政府不得進行本條所授權之立法：(1) 使用網路連線以侵害著作權之行爲對商業或消費者有嚴重的不良影響；(2) 本立法是因應上述不良影響的適當方式；(3) 本立法不會影響國家安全、或犯罪防制[22]。」

同條第 4 項中指出政府的立法中應規定除非有下列情況，法院不得准許暫時封鎖處分之聲請：(1) 此網路位址的內容正有或可能有大量取自侵權內容；(2) 此網路位址正在或可能提供大量的侵權內容；(3) 此網路位址正在或可能用來讓使用者便於接觸前述兩款類型的網路位址[23]。

---

20 DEA 2010 §17(1).

21 DEA 2010 §17(11),

"A statutory instrument containing regulations under this section may not be made unless—

(a) the Secretary of State has complied with section 18, and

(b) a draft of the instrument has been laid before and approved by aresolution of each House of Parliament."

22 DEA 2010 §17(3).

23 DEA 2010 §17(4),

"The regulations must provide that a court may not grant an injunction unless sat-

第 5 項指出政府立法中應規定，法院於否准暫時封鎖處分時，應將下列情況列入考慮：(1)ISP 或網址營運者採取行動防止侵權行爲的證據；(2) 著作權利人或被授權人提供合法接觸該內容的證據；(3) 政府官員的意見；(4) 封鎖處分是否不合比例的影響其他人的法益；(5) 言論自由[24]。

第 6 項指出政府立法中應規定法院於暫時封鎖處分中，應明確指出 (1)ISP 業者及 (2) 網址營運者應採行何種形式、何種手段進行封鎖行爲[25]。

除了上述的「應立法規範事項」，第 17 條第 7 項則指出政府立法中「得規定的事項」，包括：(1) 規定某網路位址何時被視爲被用來便利接觸另一（侵權）位址；(2) 聲請暫時封鎖處分可依法公開並通知網路位址營運者；(3) 法院不得裁決 ISP 業者負擔費用，以及爲其他目的做其他

---

isfied that the location is—
(a) a location from which a substantial amount of material has been, isbeing or is likely to be obtained in infringement of copyright,
(b) a location at which a substantial amount of material has been, is beingor is likely to be made available in infringement of copyright, or
(c) a location which has been, is being or is likely to be used to facilitate access to a location within paragraph (a) or (b).”

24 DEA 2010 § 17(5),
“The regulations must provide that, in determining whether to grant an injunction, the court must take account of—
(a) any evidence presented of steps taken by the service provider, or by anoperator of the location, to prevent infringement of copyright in thequalifying material,
(b) any evidence presented of steps taken by the copyright owner, or by alicensee of copyright in the qualifying material, to facilitate lawfulaccess to the qualifying material,
(c) any representations made by a Minister of the Crown,
(d) whether the injunction would be likely to have a disproportionate effect on any person’s legitimate interests, and
(e) the importance of freedom of expression.”

25 DEA 2010 § 17(6),
“The regulations must provide that a court may not grant an injunction unless notice of the application for the injunction has been given, in such form and by such means as is specified in the regulations, to—
(a) the service provider, and
(b) operators of the location.”

立法規定等[26]。第 18 條則續規定，政府立法前應進行嚴謹的諮商與國會監督程序[27]，以上種種，均可看出，DEA 2010 第 17 條雖大幅放寬 CDPA 1988 第 97A 條定暫時封鎖處分的要件，但於授權政府立法時相當嚴格、預先設下許多前提，避免未來的立法失控。

三、數位經濟法（DEA 2010）的ISP科技義務受到挑戰

《數位經濟法》第 3 條至第 18 條中規定，以行政命令或立法之方式，授權政府得以制定要求網路服務提供者對使用者採取一定科技措施、負擔一定科技義務的規定，讓英國 ISP 業者不滿，不久即向法院提起違憲審查之訴[28]，主要針對上述《數位經濟法》中第四條規定授權政府制定其列出侵權使用者資料義務的命令、及第九條授權政府制定採行科技措施義務的命令，主張這些規定違反歐盟的《科技標準指令》、《電子商務指令》、《資料保護指令》與言論自由權的保障法規，同時原告也要求法院對該法授權的《成本規則》草案[29]進行審查，主張網路服務提供者不應負擔監督侵權使用者與採行科技措施的成本。英國高等法院則於 2011 年 4 月做出合憲的判決[30]。

---

26 DEA 2010 § 17(7),
"The regulations may, in particular—
(a) make provision about when a location is, or is not, to be treated as being used to facilitate access to another location,
(b) provide that notice of an application for an injunction may be given to opera tors of a location by being published in accordance with the regulations,
(c) provide that a court may not make an order for costs against the service pro vider,
(d) make different provision for different purposes, and
(e) make incidental, supplementary, consequential, transitional, transitoryor saving provision."

27 DEA 2010 § 18, *available at* http://lexisweb.co.uk/acts/2010/digital-economy-act-2010-2010-c-24/18-consultation-and-parliamentary-scrutiny(last visited June 4, 2016).

28 Julia Hörnle, P*remature or Stillborn? – The Recent Challenge to the Digital EconomyAct, 2*8(1) Computer L.& Sec. Rev. 83, 87-88 (2012).

29 *Online Infringement of Copyright: Implementation of the Online Infringement of Copyright (Initial Obligations) (Sharing of Costs) Order 2012*, Ofcom (June 22, 2012), http://stakeholders.ofcom.org.uk/binaries/consultations/onlinecopyright/summary/condoc.pdf.

30 On the Application of British Telecommunications Plc&Talktalk Telecom Group

析論之，在本案中原告（網路服務提供者英國電信公司與 TalkTalk 電信公司）總共提出五項聲明，而針對第 4 條的通知義務、第 9 條與第 10 條的「對使用者採行科技措施之義務」授權規定者，則爲其中四項，第五項則是針對政府尚未立法的第 17 條。首先，原告聲明 DEA 2010 的科技措施要求不符合歐盟《科技標準指令》（Technical Standard Directive）[31] 的規定，因該指令要求會員國實施新的科技標準，應通報歐盟委員會，但法官則指出，DEA 2010 僅是授權主管機關得制定命令，而 DEA 2010 本身並未規範新的科技措施，故非該指令規範的對象 [32]。第二，原告聲明 DEA 2010 賦予網路服務提供者侵權的損害賠償責任，違反歐盟《電子商務指令》（E-Commerce Directive），該指令第 12 條規定網路服務提供者若僅是提供接近網路的管道，並不爲其管道中所傳輸的資訊負侵權責任 [33]; 而第 15 條第 1 項則規定網路服務提供者不負一般性的監控義務（no general obligation to monitor principle）。法院則指出，基於 DEA 2010 授權的命令，網路服務提供者若未履行命令所規定的義務所產生的責任，並非侵權責任，網路服務提供者所負擔執行告知義務的 25% 成本，也非損害賠償的概念，故此並未違反第 12 條的規定。此外，由於網路服務提供者僅是被動的接收著作權權利人的報告並轉達予使用者，並不符合監控的定義，故此亦不違反第 15 條的規定。

第三，原告聲明於告知著作權利人義務中，需列出疑似侵權人的網路位址（IP Address），這違反歐盟的《資料保護指令》（Data Protection Directive），就此法院則認爲 [34]，此情況符合指令第 7 條第 3 項與第 5 項

Plc v. The Secretary of State for Business, Innovation and Skills [2011] EWHC 1021 (Admin) (UK).

31 *Id*., ¶ 71.

32 *Id*., ¶ 84.

33 Hörnle, *supra* note 28, at 87-88.

34 Directive 1995/46/EC, of the European Parliament and of the Council of 24 October 1995 on the Protection of Individuals with Regard to the Processing of Personal Data and on the Free Movement of Such Data, 1995 O.J. (L 281) 40, articles 7(c) and (e), *available at* http://www.dataprotection.ro/servlet/ViewDocument?id=177 (last visited July 24, 2016).

提到若爲遵守法律義務所必需、且符合公共利益，可以排除。

最後，原告聲明 DEA 2010 的授權規定，對 (1) 網路服務提供者於歐洲經濟區（EEA）提供跨域服務的權利 ; (2) 網路服務提供者的隱私權權 ; (3) 網路服務使用者的言論自由權的限制，均不合比例原則[35]。英國高等法院則認爲，首先在審查法律案時，應該尊重立法者的裁量空間，愈是具有公共政策目的的立法，則法院審查的空間就愈小[36]。原告在此項提出了六點聲明，法院一一駁回。首先，法院認爲 DEA 2010 的立法目的是具有正當性的，其授權條款有助於著作權利人上法院指認侵權行爲人[37]。第二，原告主張現有法律已經足以保障著作權利人，不需要另外賦予其報告、告知義務。法院則認爲和現行法相比，DEA 2010 的規定是較有效、公正的處理方式[38]。第三，原告主張 DEA 2010 的授權規定，是無效的方式。因爲一來，目前只有 37% 的侵權行爲是由點對點的檔案分享造成（而這是 DEA 2010 主要的規範對象），二來網路侵權行爲人也可能透過科技措施避免被發現。法院則指出就算僅有 37%，能減少這部分的侵權行爲也是意義重大[39]。第四，原告主張，DEA 2010 予網路服務提供者的義務，可能會造成網路環境的「寒蟬效應」，連一般使用者都不想分享網路連線予他人使用，因爲害怕他人經由自己的連線位址進行非法檔案傳輸行爲造成後果。不過，法院則指出，如果能夠透過賦予使用者注意義務，提高對著作權的保障，事屬合理[40]。第五，原告主張國會應分階段實施此立法，法院則認爲這屬於國會的裁量[41]。第六，原告主張倘若著作權於網路環境由於執法上之困難，未能充分保障，可能有助於產業發展一個更廉價、更有效、更方便的新線上模式，因此這未必是件壞事。法院

35 Hörnle, *supra* note 28.
36 British Telecommunications Plc & Anor, R (on the application of) v. The Secretary of State for Business, Innovation and Skills [2011] EWHC 1021 (Admin) (UK).
37 *Id.*
38 *Id.*
39 *Id.*
40 *Id.*
41 *Id.*

則指出，有關著作權法的規定是否適當的平衡了著作權利人的權利與公共利益，這是國會的工作，而相信國會所訂立的著作權法已做了平衡的裁量，因此不同意此項主張[42]。

值得注意的是，雖然 DEA 2010 通過了法院的違憲審查，但其中爭議之一的第 17 條，法院判決中指出「尚未有依該條而產生的立法」，因而無從審查、並未於判決中處理此爭議[43]。但 2010 年英國通傳主管機關 Ofcom 做出 DEA 2010 執行檢討報告[44]，內文中提到，DEA 2010 第十七條的規定並未能有效提供著作權人所期待的更快速、更有效的保障[45]，原因是封鎖網站的科技手段，往往道高一尺、魔高丈，侵權人會以各種方式避開封鎖處分、並另起爐灶，而即使 DEA 2010 第 17 條的要件規定，已較 CDPA 1988 的規定寬鬆，但仍無法涵蓋侵權人的各種防避手段。之後，英國政府決定將第 DEA 2010 中 17 條與關於第 17 條立法諮商程序的第 18 條刪除。易言之，授權政府立法由法院下暫時封鎖處分的規定，已於 2015 年依據《2015 去管制法》（Deregulation Act 2015）第 56 條之規定刪除[46]。但其他條款仍保留，於是 DEA 2010 第 9 條中四項科技義務仍然如舊：(1) 限制該使用者網路連線服務的速度或容量；(2) 禁止該使用者透過網路服務接近某些內容、或限制其使用；(3) 暫停該使用者的網路服務；(4) 其他限制該使用者網路服務的方式。總結來說，目前著作權利人可透過 CDPA 1988 的規定請求就現有的侵權行爲定暫時狀態處分，亦

---

42 *Id*.

43 *Id*.

44 *"Site Blocking" to Reduce Online Copyright Infringement: A Review of Sections 17 & 18 of the Digital Economy Ac*t, OFCOM (May 27, 2010), http://stakeholders.ofcom.org.uk/binaries/internet/site-blocking.pdf.

45 *Id*. at 49.

46 Deregulation Act 2015, §56,

> "In the Digital Economy Act 2010, omit sections 17 and 18 (which confer power on the Secretary of State to make regulations about the granting by courts of injunctions requiring the blocking of websites that infringe copyright)."

《2015去管制法》是英國政府檢視國內各項對個人或團體造成不必要的額外負擔的法令、或是一些不合時宜的法令，進行修正或刪除的依據。

可透過 DEA 2010 的規定，依據政府命令所規定的程序請求網路服務業者盡科技義務。

四、新興科技規避暫時封鎖處分

如上所述，英國高院以「尚未立法」爲由，並未就 DEA 2010 第十七條進行審查，但 Ofcom 於 2010 年提出的報告，卻由科技面審視該條，並指出暫時封鎖處分於科技上未必是最有效的方式。Ofcom 報告中指出，封鎖處分的主要技術有四[47]：

(1) 封鎖 IP 位址（IP address）；

(2) 封鎖網域名稱系統（DNS）；

(3) 封鎖連結（URL）；

(4) 封包檢查（Packet Inspection）。

針對 (1) 封鎖 IP 位址，報告中提到，網路運作的核心，是由許多網際網路協定（Internet Protocol，IP）所組成，而目前最被廣泛運用的 IP 版本是 IPv4，由四組數字組成。如 Ofcom 官網的 IP 位址，即爲「194.33.179.25.」[48]。是故若欲封鎖特定侵權網站，可透過封鎖特定 IP 位址達到目的，但此法的缺點，是侵權人可以於短時間內變換 IP 位址，同時，由於 IP 位址有限，同一位址可能由不同的網站共用，爲了封鎖涉及侵權的 IP 位址，可能連累其他無辜網站，封鎖成本亦難以精確預測[49]。

針對 (2) 封鎖網域名稱系統（DNS），Ofcom 報告中提到[50]，目前的 IPv4 大約有 43 億個 IP 位址，爲了便於網路互連，這些 IP 位址乃透過

47 *See supra* note 44.
48 *Id*. at 28.
49 *Id*. at 27-30.
50 *Id*. at 31.

一個階層式的命名系統運作。所謂的網域名稱系統（Domain Name System, DNS），就是以人們可閱讀的名稱呈現所有的 IP 位址。如 Ofcom 的官網的網域名稱爲「www.ofcom.org.uk」，就代表上述提過的 IP 位址「194.33.179.25.」。若以封鎖網域名稱系統的方式封鎖侵權網站，則侵權者可以透過虛擬私人網路（Virtual Private Networking, VPN）或其他匿名機制，避免其傳輸資訊被第三方得知。此外，侵權者亦可快速另外設置一個複製原侵權網站的鏡子（Mirror）網站，導致此封鎖方式效用有限[51]。

針對 (3) 封鎖連結（URL），報告中指出[52]，統一資源定位器（Uniform Resource Locator，URL）就是網路世界最常見的指引特定檔案、目錄或網頁的方式，例如一個侵權檔案的網頁連結可能如下：「http://www.example.com/download/pirate.zip」。雖然目前絕大多數的英國 ISP 業者使用封鎖 URL 的方式，避免兒童接觸網路上的虐待圖片[53]。但是封鎖連結最大的問題在於它僅能封鎖網路流量，它無法處理以檔案交換協定（file transfer protocol，FTP）進行的侵權內容，以至於連荷蘭 ISP 業者都不願在荷蘭採行此原封鎖方式[54]。此外，侵權人亦可透過上述避開 DNS 封鎖的方式，避開 URL 的封鎖[55]。

針對 (4) 封包檢查（Packet Inspection），報告中指出[56]，封包檢查可分爲「淺式檢查」和「深式檢查」兩種。「淺式」和封鎖 IP 位址的方式相差無幾，「深式」（Deep packet inspection, DPI）則檢查封包資訊的特性。DPI 的深式檢查常常用於檢測系統遭惡意入侵的情況，於侵權檢查的情況，則 DPI 於檢查中發現封包內容符合欲封鎖內容的特性時，即可進行封鎖。但如所檢測的封包未加密，進行 DPI 較無問題。倘若封包爲

51 *Id*. at 31-34.
52 *Id*. at 35.
53 *Id*. at 36.
54 *Id*. at 37.
55 *Id*. at 38.
56 *Id*. at 39.

加密封包，則 DPI 的使用就需很小心，避免觸及隱私權的爭議。不過，侵權人亦可透過如改變 IP 位址、或使用 VPN 傳輸等方式避開封包檢查的封鎖。

此外，報告中也提到若上述各項方式混合進行（HYBRID）[57]，每一項方式的缺點仍然同時存在。還有，新科技的發展也讓上述方式更加黔驢技窮[58]。例如，網域名稱系統的安全機制（DNS Security Extensions ，DNSSEC）的建立，是利用數位簽章認證 DNS，以建立網路信任，其目的是避免網路使用者無意中被駭、或是下載惡意軟體。但由於封鎖 DNS 的方式是建立在修改未經認證的 DNS 資料上，利用 DNS 封鎖方式將對 DNSSEC 有負面的效果。另外，還有新一代 IPv6 已出現，不似 IPv4 所能提供的 IP 位址有限，IPv6 能提供幾乎無盡的 IP 位址，這也讓侵權者能更快速、更有效的變化 IP 位址，而讓封鎖 IP 位址的方式愈來愈無效。此外，還有雲端科技（cloud）的進步[59]，讓網站可以任意變化 IP 位址、DNS、地理位置或是管轄，而一點也不會影響在雲端所儲存的資訊。以上這些科技的發展，都會影響到傳統封鎖方式的效能。不過，另一方面，科技的發展不只有利於侵權行爲的進化，也有利於封鎖方式的精進。例如新的柏克萊網域命名軟體（Berkley Internet Naming Domain ，BIND），原本是用來對付釣魚或惡意軟體的攻擊，但在未來也可用於封鎖侵權網站的工具。

最後，由於網路跨國界的特性，ISP 業者未必僅落腳在某一特定國家，各國若對封鎖處分的規定不一，則 ISP 業者可能僅針對特定國家中流通傳播的資訊內容進行封鎖[60]，這也可能讓使用者利用不同的 ISP 服務

---

57 *Id.* at 41.

58 *Id.* at 2-43.

59 有關雲端服務的網路侵權責任發展，學者已有由美國案例提出分析，如：馮震宇，數位環境下著作權侵害之認定及相關案例研討，臺灣法學雜誌，206期，頁41-67，2012年08月; 程法彰，雲端服務提供者的網路著作權侵權責任—以Aereo案件爲出發，法令月刊，66卷2期，頁76-91，2015年2月。

60 Pekka Savola, *The Ultimate Copyright Shopping Opportunity – Jurisdiction and Choice of Law in Website Blocking Injunctions*, 45(3) INT'L REV. INTELL. PROP. & COMP. L. 287 ,

便可繞過封鎖。

五、小結：重回CDPA 第97A條

DEA 2010 第 17 條的規定，雖然沒有機會在法院中審查，但 Ofcom 在其報告中，則詳細的由科技面檢討了現有封網處分所能動用工具的侷限。因之，英國決定刪除第 17 條的封網處分立法授權的規定。但刪除了 DEA 2010 的第 17 條，CDPA 第 97A 條仍然存在。目前著作權利人即可依據 CDPA 第 97A 條向法院聲請暫時封鎖侵權網站的處分。

首件依據 CDPA 第 97A 條聲請暫時封鎖處分獲准的案子，發生在 2010 年的 *Twentieth C. Fox v. Newzbin*[61] 一案。該案原告是一家電影製作公司 Twentieth Fox，控告網站 Newzbin 上有大量內容涉及侵權。Newzbin 隨後將網站移至海外另起爐灶 NewzBin2，此時英國法院境外網站無管轄權，Twentieth Fox 就改依 CDPA 第 97A 條向法院聲請由 ISP 封鎖此境外網站 [62]。法官則以「該網站雖在海外營運，但侵權效果卻在英國境內發生」爲由，同意暫時封鎖處分之聲請 [63]。於此案中，被要求進行封網措施的 ISP 業者主張：(1) ISP 的服務並未用來侵權 ; (2) ISP 對 NewzBin2 的侵權行爲並不知情 ; (3) 暫時封鎖處分將違反歐盟 2000 電子商務指令第十二條資訊傳輸管道的免責規定、第十五條禁止課予 ISP 監控義務規定及歐盟人權公約第十條的言論自由 [64]。法院則一一反駁：認爲 ISP 此時符合歐盟 2001 資訊社會指令第八條第三項的「中介者」（intermediaries）；而 NewzBin2 網站有大量侵權內容，許多 NewzBin2 的使用者亦爲該 ISP 服務的使用者，ISP 業者不可能不知 ; 最後，歐盟 2000 指令並未禁止要

287-315 (2014).

61 Twentieth Century Fox &Ors v. Newzbin Ltd [2010] EWHC 608 (UK).

62 Twentieth Century Fox Film Corp &Ors v. BritishTelecommunications Plc [2011] EWHC 1981 (UK).

63 Althaf Marsoof, *The Blocking Injunction: A Critical Review of Its Implementation in the United Kingdom within the Legal Framework of the European Union*, 46(6) INT'L REV. INTELL. PROP. & COMP. L. 632, 636 (2015).

64 Darren Meale, *NewzBin2: The First Section 97A Injunctionagainst* an ISP, 6 J. INTELL. PROP. L. & PRAC. 1, 1-3 (2011).

求 ISP 爲暫時封鎖措施，而暫時封鎖措施也並不等同於監控，且此時權利人是依據第 97A 條的「法律規定」主張此暫時封鎖處分，依法有據，並未侵害人權。

於 NewzBin2 案後，續有 The Pirate Bay, KAT, H33T 及 Fenopy 等五個網站，被法院裁定要求 ISP 業者封鎖[65]。值得注意的是，初始依據第 97A 聲請暫時處分的案件，雖然權利人是先針對侵權網站、其後因網站移至海外、權利人才開始聲請 ISP 業者進行封鎖。但 2013 年的 *EMI andothers v BSkyB and others*[66] 一案中，原告音樂製作公司直接要求六大 ISP 業者進行網站封鎖，法院亦判准之，可見法院對暫時封鎖處分之判斷，由於法有明文依據，並不以權利人先向侵權網站爭訟爲要件。

綜上所述，暫時封鎖處分在英國，由於舊有的 CDPA 第 97A 條並未受到 ISP 的挑戰，而新推出的 DEA 2010 第十七條卻因尚未完成立法、而未受法院審查之前便已被政府刪除。因而，由政府立法放寬暫時封鎖處分要件的機制，在英國是否符合人權保障的比例原則，並未有機會在法院中得到充分的討論。

不過，在英國法院第一件針對 ISP 業者核發定暫時狀態處分的 Newzbin2 一案中，被告 BT 的律師曾就比例原則主張此處分限制 BT 用戶於歐洲人權公約第十條之言論自由權[67]，但法官認爲此處分具針對性且範圍狹小，並包括情事變更時之保全程序，且 BT 應負擔之執行費用不高，故合乎比例原則。其後，2013 年，英國高院在 EMI Records v British Sky Broadcasting 一案中，法院判決亦曾提到法院在判斷是否允許暫時封鎖處分時，應考量基本人權與比例原則[68]。易言之，在法院就個案的判決中，

---

65 Darren Meale, *A Triple Strike against Piracy as the Music Industry Secures Three More Blocking Injunctions*, 8 J.Intell. Prop. L. & Prac.591, 591-594 (2013).

66 EMI &Ors v. BSkyB& Ors [2013] EWHC 379 (UK).

67 邵瓊慧，封鎖境外侵權網站之立法與案例發展—英國Newsbin2案件評析，月旦法學雜誌，252期，頁201，2016年5月。

68 Christina Angelopoulos, *Are Blocking Injunctions against ISPs Allowed in Europe? Copyright Enforcement in the Post-Telekabel EU Legal Landscape*, 9 J. Intell. Prop. L. &

已就 CDPA 第 97A 條的定暫時狀態處分做出合憲審查的結論。

參、歐盟判決：空白的暫時封鎖處分[69]

就要求 ISP 暫時封鎖處分是否符合基本人權與比例原則的保障，於 2014 年，歐盟法院（Court of Justice of the European Union，CJEU），針對奧地利法院的暫時封網處分，做出一個新的判決，其中不但由法律層次、詳細論述了封網處分並未違反歐盟基本人權的體系，並且迥異於英國 DEA 2010 中第 17 條中第 6 項要求法院應具體指示封網的形式與方法，歐盟法院認爲「空白的封鎖處分」（Non-specific blocking injunction）並不違法，換言之，會員國法院可以不對 ISP 封網的方式、手段做明確的指示，而將選擇權委由 ISP。CJEU 此項判決，似乎是擴大了 ISP 的封網責任[70]。

本案攸關暫時封鎖網站處分在歐洲的發展[71]，案例事實爲奧地利兩家電影公司 Constantin Film Verleih GmbH （以下簡稱 Constantin）以及 WegaFilmproduktionsgesellschaftmbH（以下簡稱 Wega），向該國法院請求網路服務業者 UPC Telekabel Wien GmbH （以下簡稱 UPC ），應封鎖一家以未得著作權利人授權而提供線上影片下載或線上觀賞的網站。奧地利最高法院指出由於奧國法律必須符合歐盟 2001/29/EC 資訊社會指令

PRAC.1, 1-10 (2014).

69 江雅綺，網路中立性與保護著作權的衝突—以歐盟法院封網處分決判爲例，科技法律評析，7期，頁307-325，2014年12月。

70 但亦有學者指出此判決僅適用「空白封鎖」，未必能直接適用於一般「特定的封鎖處分」（specific injunction）。*See* Martin Husovec, CJEU *Allowed Website: Blocking Injunctions with Some Reservations*, 9 (7) J. INTELL. PROP. L. & PRAC.(2014).

71 Case C-314/12, UPC Telekabel Wien GmbH v. Constantin Film Verleih GmbH & Wega Filmproduktionsgesellschaftmbh,http://curia.europa.eu/juris/document/document.jsf?text=&docid=149924&pageIndex=0&doclang=EN&mode=lst&dir=&occ=first&part=1&cid=122968 (last visited May 26, 2016) [hereinafter UPC v. Constantin]; *BEREC Guidelines on Transparency in the Scope of Net Neutrality: Best Practices and Recommended Approaches*, BODY OF EUROPEAN REGULATORS FOR ELECTRONIC COMMUNICATIONS (2011), http://berec.europa.eu/doc/berec/bor/bor11_67_transparencyguide.pdf.

（Directive 2001/29/EC, InfoSoc Directive）第 8 條第 3 項[72]：「會員國應該確保權利人可以請求被第三人用來侵害著作權或相關權益的中介服務者定暫時狀態處分。」因此將本案移送給歐盟法院處理。

本案主要爭點有二：首先，UPC 公司讓客戶得以在網路接觸非法內容，UPC 是否爲 2001 年指令中所謂用來做侵害著權使用的中介服務提供者，因此電影製作公司有權向法院請求 UPC 封鎖侵權網站定暫時狀態處分？其次，本案中的定暫時狀態處分，爲要求 UPC 公司自行決定採取能夠防止客戶進行侵權行爲的措施，並沒有特定其行爲類型，屬於空白的定暫時狀態處分（non-specific injunction），如此要求業者負擔封網義務且承擔決策風險，是否符合人權比例原則。

被告 UPC 公司（ISP 業者）則反駁，它並沒有違反 2001 年的資訊社會指令：因爲一、它並沒有和那些爭議的侵權網站有任何商業關係；二、其顧客是否有侵權行爲並未得到證明； 三、封鎖網路的措施對該公司耗費鉅大，且全數可以科技方式避開，其效果得不償失。

歐盟法院則於 2014 年 4 月出爐的判決中指出，UPC 屬於提供用以進行侵權行爲的中介服務者。判決認爲，定暫時狀態處分爲保障權利人的權利，定暫時狀態處分之適用並不需要侵權者和中介服務者之間有任何關係，也不需要證明網路服務業者的顧客確實有接觸那些侵權網站的內容，因爲指令要求會員國採取禁制令的目的除了排除已有的侵權行爲，也在防止未來的侵權行爲。

法院進一步認爲，在本案中，定暫時狀態處分並不違反歐盟的基本人權體系，只要符合下列兩項條件[73]：第一，這些網路服務業者所採取的

---

72 Directive 2001/29/EC, of the European Parliament and of the Council of 22 May 2001 on the Harmonisation of Certain Aspects of Copyright and Related Rights in the Information Society, 2001 O.J. (L167) 18, §8: “Member States shall ensure that rightholders are in a position to apply for an injunction against intermediaries whose services are used by a third party to infringe a copyright or related right.”

73 UPC v. Constantin, ¶ 63.

措施並沒有禁止網路使用者合法接觸網路資訊的可能性，第二，這些措施讓網路使用者接近違法侵權內容變得困難或防止他們如此做。

整理歐盟法院判決的要點，主要可分爲下列幾項：首先，有關 UPC 是否爲中介服務提供者的爭議，法院認爲 UPC 即爲 2001 年資訊社會指令第 8 條第 3 項中的中介服務提供者。因爲當有人將未得著作權人授權的內容置於網站公開時，以該指令第 3 條第 2 項的規範目的而言，此時提供網路服務以讓其他人得以接近那些非法內容的業者，合乎第 8 條第 3 項的中介服務者定義[74]。

第二，有關空白定暫時狀態處分是否違反歐盟的基本權利體系，法院認爲這些網路服務業者可以透過證明已採取其他有效措施（讓顧客很難或無法接近那些侵權內容），而避開未執行定暫時狀態處分的懲罰。而爭議中的定暫時狀態處分，與著作權、網路服務業者的商業自由，以及使用者的資訊自由處於權利衝突，當有多種權利發生衝突時，會員國應在各權利間取得平衡，且執法上不可違反基本權利體系（如比例原則）。但如上述，由於業者仍有決策的自由並可防止懲罰的後果，因此定暫時狀態處分並沒有侵害網路服務業者的核心商業自由，就保障著作權與商業自由的平衡之間，沒有違反歐盟基本權利體系的比例原則。

此外，歐盟法院判決指出，定暫時狀態處分對網路服務業者有正面效果，因此空白的處分，讓受命者（網路服務業者）可決定是否採取可達成目標的其他措施，受命者可以決定採取最適合其資源及能力的措施。且定暫時狀態處分也讓受命者可藉由證明已採行所有合理手段而不負任何侵權責任，這並非「不可忍受的犧牲」。

最後，歐盟法院認爲這對使用者亦有正面效益：因爲網路服務業者所採行的措施必需符合處分設定的目標，易言之，它們必需可以中止第三方的侵權行爲，如此既能保障著作權利人的權利，且不影響網路使用

74 *Id.*, ¶ 40.

者使用其服務而接近所有合法資訊的權利。但法院亦強調資訊透明的重要性，如果一旦已知網路服務業者已採取相關措施，需有讓網路使用者有可能保障他們的資訊自由的程序規則。

肆、代結論：暫時封鎖處分在臺灣？

上述英國法規的演進過程、與歐盟法院的判決，前者由科技面指出「暫時封網處分」的侷限，後者則由法律面判決封網處分符合人權比例原則，並進一步認爲法院可爲「空白封網處分」，兩者爲「暫時封網處分」分別由科技與法律面提供了一些判斷的參考標準。

就臺灣的情況而言，如何處理網路侵權行爲、並同時兼顧網路服務業者與網路使用者的權益，一直也是令相關主管機關頭痛的問題。2009年，臺灣《著作權法》修法，增訂第六章之一「網路服務提供者之民事免責事由」，於第 90 之 4 至第 90 之 12 條，詳列網路服務提供者於已盡特定法定義務之後，即可免負侵權行爲之賠償責任，這是近年來《著作權法》首次針對網路空間的侵權行爲，針對網路服務業者的責任界限做出規定，並有許多學者做出豐富精彩的論述，已如前言中所敘[75]。

就侵權案件定暫時狀態處分而言，我國智財法院成立至今，已有多件准許著作權法案件之定暫時狀態處分[76]。但即使有定暫時狀態處分之救濟方式，律師邵瓊慧爲文指出，目前臺灣實務上著作權人聲請定暫時狀態處分最大困難，乃在於其所得主張侵權排除之範圍或後續之執行[77]。例如 kuro 案之權利人曾向臺北地方法院聲請定暫時態分獲准，但該處分範圍僅及於該案權利人聲請時主張之歌曲，而不及於其他遭侵害之作品，導致該處分之象徵意義遠大於實質意義。

---

75 參前揭註3與4。

76 邵瓊慧，我國智慧財產案件定暫時狀態處分制度之研究-兼論美國案例最新發展，載：司法院智慧財產權訴訟相關論文彙編（第1輯)，頁331-399，2011年。

77 參前揭註67，頁205。

2013 年，爲了解決實務上定暫時狀態處分似有滴水救不了大火之憾，針對伺服器設置在國外的境外侵權網站，，臺灣智財局亦曾提出如該類網路屬專門從事網路侵權行爲、或其上之內容有重大明顯侵害著作權，嚴重影響相關產業發展者，智慧局得採取快速處斷措施，令網路服務提供者（ISP）予以封鎖，使國人無法連結至該等侵權網站[78]。雖然該封鎖重大侵權境外網站之提議，後來並沒有落實，但亦可看出，封鎖網站涉及網站所有人之權益、大眾接收資訊之自由及 ISP 業者執行成本負擔等，在立法、實務及科技面均需多方衡量。

較爲可惜的是，智財局當時所提出的封鎖侵權網站措施，由於行政機關的侵權判斷與否成爲社會爭議的焦點，此提議迅速撤回，有關封鎖網站若由立法或司法機關審酌執行，其法律面、科技面的可行性或侷限，並未有機會讓各方多做討論。由本文中可知，英國 CDPA 第 97A 條，由法院審酌權利人的聲請核發定暫時狀態處分，於英國法院判決中認爲合乎比例原則；而歐盟判決中更進一步認爲法院核發空白的定暫時狀態處分，亦合乎人權比例原則。因此，作者希望藉由本文寫作，嘗試擴大一些未來著作權法如何對應侵權網站的思考方向與討論空間，並祈各方指正。

78 經濟部智慧財產局，境外侵權網站無法管？智慧局研擬對策，2013年5月，http://www.tipo.gov.tw/ct.asp?xItem=425645&ctNode=7123&mp=1（最後瀏覽日：2016/5/26）。

參考文獻

中文文獻

專書論文

李治安，網路服務提供者民事免責事由之要件分析，載：國際比較下我國著作權法之總檢討，頁451-490，2014年。

邵瓊慧，我國智慧財產案件定暫時狀態處分制度之研究-兼論美國案例最新發展，載：司法院智慧財產權訴訟相關論文彙編（第1輯），頁331-399，2011年。

期刊

王怡蘋，著作權法關於網路服務提供者之民事免責規範，月旦法學雜誌，173期，頁25-41，2009年10月。

江雅綺，英國《數位經濟法》中網路服務提供者對侵權使用者的科技義務，科技法學論叢，8期，頁187-212，2012年12月。

江雅綺，網路中立性與保護著作權的衝突—以歐盟法院封網處分決判爲例，科技法律評析，7期，頁307-325，2014年10月。

李治安，失衡的承諾：著作權法責任避風港規範之立法政策評析，臺大法學論叢，第43卷第1期，頁143-207，2014年3月。

沈宗倫，對於我國著作權法關於網路服務提供者民事責任豁免立法之初步評析，中正財經法學，1期，頁257-298，2010年1月。

邵瓊慧，封鎖境外侵權網站之立法與案例發展—英國Newsbin2案件評析，月旦法學雜誌，252期，頁187-209，2016年5月。

姚信安，從美國法角度探討我國著作權民事間接侵權責任相類制度，中正財經法學，2期，頁139-201，2011年1月。

章忠信，二〇〇九年新修正著作權法簡析—網路服務提供者之責任限制，月旦法學雜誌，173期，頁5-24，2009年10月。

程法彰，雲端服務提供者的網路著作權侵權責任—以Aereo案件爲出發，法令月刊，66卷2期，頁76-91，2015年2月。

馮震宇，數位環境下著作權侵害之認定及相關案例研討，臺灣法學雜誌，第206期，

頁41-67，2012年8月。

英文文獻

期刊

Angelopoulos, Christina, *Are Blocking Injunctions against ISPs Allowed in Europe? Copyright Enforcement in the Post-Telekabel EU Legal Landscape*, 9 J. Intell. Prop. L. & Prac.1 (2014).

Hörnle, Julia, *Premature or Stillborn? – The Recent Challenge to the Digital Economy Act*, 28(1) Computer L. & Sec. Rev. 83 (2012).

Husovec, Martin, *CJEU Allowed Website: Blocking Injunctions with Some Reservations*, 9(7) J. Intell. Prop. L.&Prac. (2014).

Marsoof, Althaf, *The Blocking Injunction: A Critical Review of Its Implementation in the United Kingdom Within the Legal Framework of the European Union*, 46(6) Int 'l Rev. Intell. Prop. & Comp. L. 632 (2015).

Meale, Darren, *A Triple Strike against Piracy as the Music Industry Secures Three More Blocking Injunctions*, 8 J. Intell. Prop. L. & Prac. 591 (2013).

Meale, Darren, *NewzBin2: The First Section 97A Injunction against an ISP*, 6 J. Intell. Prop. L.&Prac. 1 (2011).

Muir, Adrienne, *Online copyright enforcement by Internet ServiceProviders*, 39(2) J. Info. Sci., 256 (2013).

Savola, Pekka, *The Ultimate Copyright Shopping Opportunity – Jurisdiction and Choice of Law in Website Blocking Injunctions*, 45(3) Int 'l Rev. Intell. Prop. & Comp. L. 287, 287 (2014).

Síthigh, Daithí Mac, *The Fragmentation of Intermediary Liability in the UK*, 8(7) J. Intell. Prop. L. & Prac. 521 (2013).

案件

British Telecommunications Plc &Anor, R (on the application of) v. The Secretary of State for Business, Innovation and Skills [2011] EWHC 1021 (Admin) (UK).

Case C-314/12, UPC Telekabel Wien GmbH v. Constantin Film Verleih GmbH &WegaFilmproduktionsgesellschaftmbH, http://curia.europa.eu/juris/document/document.jsf?text=&docid=149924&pageIndex=0&doclang=EN&mode=lst&dir=&occ=first&part=1

&cid=122968.

EMI & Ors v. BSkyB & Ors [2013] EWHC 379 (UK).

On the Application of British Telecommunications Plc & Talktalk Telecom Group Plc v. The Secretary of State for Business, Innovation and Skills[2011] EWHC 1021 (Admin) (UK).

Twentieth Century Fox et al v. Newzbin Ltd [2010] EWHC 608 (UK).

Twentieth Century Fox Film Corp & Ors v. British Telecommunications Plc [2011] EWHC 1981 (UK).

歐盟指令

Directive 1995/46/EC, of the European Parliament and of the Council of 24 October 1995 on the Protection of Individuals with Regard to the Processing of Personal Data and on the Free Movement of Such Data, 1995 O.J. (L 281) 31.

Directive 2001/29, of the European Parliament and of The Council of 22 May 2001 on the Harmonization of Certain Aspects of Copyright and Related Rights in the Information Society, 2001 O.J. (L 167) 10.

Directive 2001/29/EC, of the European Parliament and of the Council of 22 May 2001 on the Harmonisation of Certain Aspects of Copyright and Related Rights in the Information Society, 2001 O.J. (L167) 10.

其他

"Site Blocking" to Reduce Online Copyright Infringement: A Review of Sections 17 & 18 of the Digital Economy Act, OFCOM (May 27, 2010), http://stakeholders.ofcom.org.uk/binaries/internet/site-blocking.pdf.

*BEREC Guidelines on Transparency in the Scope of Net Neutrality: Best Practices and Recommended Approache*s, BODY OF EUROPEAN REGULATORS FOR ELECTRONIC COMMUNICATIONS (2011), http://berec.europa.eu/doc/berec/bor/bor11_67_transparencyguide.pdf.

Online Infringement of Copyright: Implementation of the Online Infringement of Copyright (Initial Obligations) (Sharing of Costs) Order 2012, OFCOM (June 22, 2012), http://stakeholders.ofcom.org.uk/binaries/consultations/onlinecopyright/summary/condoc.pdf.

徵 稿 說 明

《智慧財產評論》乃國立政治大學科技管理與智慧財產研究所發行的專業學術期刊，其目的爲建構一國內外智慧財產相關學術資訊與意見交流之平台。本刊每年六月及十二月出版，內容包含智慧財產相關之法律、管理、技術移轉、技術評價及生物或資訊科技等方面之論文或個案研究。本刊採「公開徵稿」、「審稿人匿名」與「送審稿件匿名」三項徵稿與審查原則，稿件隨到隨審，同時本刊近來積極申請進入 TSSCI 期刊，依科技部規定，當本期刊納入 TSSCI 名單後，可回溯將本刊三年內投稿之論文，納入 TSSCI 資料庫中，歡迎各界賢達踴躍投稿。

投 稿 須 知

1. 謝絕一稿兩投，已投稿其他刊物或已發表之論文請勿投稿本刊。
2. 來稿格式請依智慧財產評論稿件格式說明（網址：http://tiipm.nccu.edu.tw/zh-hant/node/372），字數以三萬字以內爲宜。若篇幅較長，本評論保有分期刊登之權利。
3. 本刊之投稿人須簽署著作權授權書，同意本刊得以非專屬授權方式再授權予經本刊授權之資料庫，並得以數位方式爲必要之重製、公開傳輸、授權用户下載及列印等行爲。凡不願簽署同意書者將不予刊登。
4. 來稿均應附作者中英文姓名、簡介、題目、關鍵詞（五個），及五百字之中英文摘要。經接受刊登，引註及參考文獻格式須依本刊格式修正。

5. 本刊全部來稿均須經初審及複審程序，審查結果將適時通知作者。本刊對於接受刊登稿件之屬性類別有最終決定權。來稿經本刊開始審查程序後撤回者，以退稿處理。
6. 來稿引用他人文獻者，如有涉及第三者著作權部分，除以附註明示外，請事先取得原著者同意，本刊不涉及智慧財產權之法律責任。
7. 依國際期刊慣例，本刊無稿酬。來稿若經刊登即奉贈本刊該期五冊及抽印本十份。
8. 本刊自第七卷第一期起，將經銷權授權予元照出版公司，並設立智慧財產評論專有網站（網址：http://www.angle.com.tw），自該期起所有刊登於本刊之稿件，同時亦將以電子檔方式收錄於前述網站。
9. 投稿時，請附上論文電子檔（檔案格式：Microsoft Word），寄至「11605 台北市文山區指南路二段 64 號國立政治大學科技管理與智慧財產研究所智慧財產評論編輯部收」；或請以電子郵件方式，將稿件以夾檔傳送至 ipr@nccu.edu.tw。
10. 投稿或已刊登於本刊之稿件，如發生違反學術倫理之情事，本刊編輯委員會得爲必要之處置。

稿件格式說明

一、論文格式：

（一）來稿請以中文或英文撰寫，由左至右橫式打字。

（二）本文之前應有中文論文標題、作者姓名、摘要及關鍵詞（至多 5 個），英文標題、作者姓名、摘要及關鍵詞。

（三）中、英文姓名以註腳方式標明作者服務機關、子機構完整名稱與職稱。摘要以簡明扼要方式，敘述論文的主要貢獻及內容，字數在 500 字以內。

（四）使用 A4 大小紙張，字數應以三萬字以內爲宜。本文字級 12，註腳字級 10，中文字形請用新細明體，英文字形請用 Times New Roman。

（五）圖表：無論以中文或英文撰寫，圖表之標號一律以阿拉伯數字表示。表的名稱置於表上方；圖的名稱置於圖下方，並於圖表下方註明資料來源。

二、段落標明方式：

（一）中文稿

甲、大段落之標題應置於每行之最左方，並以字級 14 之粗體表示。例如：

壹、前言

乙、中段落之標明應置於每行之最左方，並以字級 12 之粗體表示，例如：

一、制度設計之目的

丙、小段落之標明應依照中段落向右一格處開始，並以字級 12 之粗體表示，例如：

（一）制度原則

其他更小段落之標明請依此類推。各段落前之數字號碼請按：壹、一、（一）1. (1) a. (a) 等順序排列。

（二）英文稿

型式一：

I

A

1.

a.

(a)

型式二：

3.Analysis

3.1 Assumption

3.2…….

三、註腳及參考文獻：

（一）本文之後將參考文獻區分不同資料類型（如：中英文書籍、中英文期刊、中英文文集論文等）逐條列出，且與本文中曾引用者一致。

（二）引用文獻及說明請使用註腳。註腳請採用「當頁註腳」（footnote）方式，註腳號碼應置於該整句最後之標點符號前，註腳內容則位於文章當頁下端，可作爲說明之用或陳述引用文獻出處。

（三）所引註之文獻資料，若係重複出現，緊鄰出現則註明「同前註」之後加註頁碼;前註中有數筆文獻時，應註明作者;若同一作者有數筆文獻，則應簡要指明文獻名稱；若非緊鄰出現則註明作者及「前揭註ＸＸ」之後再標明頁數，其他同前。

（四）若引用之網路文獻本身有發表時間，不須載明最後瀏覽日；若無發表時間或該網頁會持續更新資訊，則應載明最後瀏覽日。

（五）隨頁註之引用文獻格式舉例如下：

1. 專書：馮震宇，了解營業秘密法，頁 50-55，1998 年 6 月 2 版。（若某書爲初版，不需註明其版次）
2. 譯著：周添城譯，Richard Caves 著，美國產業之結構、行爲、績效，頁 124-125，1990 年 8 月。
3. 專書論文：王偉霖，科學技術基本法第六條之法律經濟分析－兼論專利制度之本質與美國拜杜法案之經驗，載：劉江彬教授榮退論文集，智慧財產的機會與挑戰，頁 3-45，2008 年 12 月。
4. 期刊：劉孔中、高安淇，從國際規範及歐盟設計規則論新式樣制度之革新，政大智慧財產評論，1 卷 1 期，頁 1-23，2003 年 10 月。
5. 學位論文：黃嘉敏，LED 產業技術採用生命週期管理—以 LED 背光源應用爲例，國立政治大學智慧財產研究所碩士論文，頁 126，2009 年 1 月。
6. 大法官解釋：大法官釋字第 243 號。
7. 行政函示：內政部（88）年台內地字第 8811978 號函。
8. 法院判決：行政法院 83 年判字第 56 號，行政法院裁判要旨彙編，14 輯，頁 966。
9. 法院決議：85 年度第 12 次刑事庭決議，1996 年 7 月 2 日，最高法院刑事庭決議彙編，頁 1081。
10. 報紙：鄭雅文，產學合作的流弊，中國時報，2004 年 6 月 17 日，A15。

11. 網頁：

馮震宇，專利訴訟費用負擔大逆轉 對抗 NPE 新利器浮現？，科技產業資訊室，2014 年 5 月，http://cdnet.stpi.narl.org.tw/techroom/pclass/2014/pclass_14_A164.htm。

智慧財產評論，訂閱辦法，國立政治大學科技管理與智慧財產研究所，http://tiipm.nccu.edu.tw/zh-hant/node/371（最後瀏覽日：2014/12/01）。

（六）引用外文文獻，請註明作者、論文或專書題目、出處（如期刊名稱及卷期數）、出版資訊、頁數及年代等，引用格式依各該國習慣。例如：

1. Book：DEBORAH L. RHODE, JUSTICE AND GENDER 56 (1989).
2. Periodical Materials: Patricia J. Williams, *Alchemical Notes: Reconstructed Ideals from Deconstructed Rights,* 22 HARV. L. REV. 401, 407 (1987).
3. Cases：Jackson v. Metropolitan Edison Co., 348 F. Supp. 954, 956-58 (M.D. Pa. 1972).
4. Web pages：

   Mark A. Lemley, *Why Do Juries Decide If Patents are Valid?*, SSRN (Aug. 5, 2013), http://ssrn.com/abstract=2306152.

   American Bar Association, Section on Legal Education and Admissions to the Bar, *Statistics,* http://www.americanbar.org/groups/legal_education/resources/statistics.html, last visited October 15, 2014.

（七）參考文獻：

在正文之後開列參考文獻，限於正文（含附錄）與註釋

中援引過之書籍及期刊文獻，惟法令裁判、立法沿革與新聞報導等資料性文獻得不列入。請依下列格式逐條列出：

1. 分中文部分與外文部分，中文在前，外文在後。外文部分請依日文、英文、德文、法文等次序分開呈列。中日文排列請按作者（編者）姓氏筆劃數，西文請按作者（編者）姓氏字母序。若同一作者有多項參考文獻時，請依年代先後順序排列。
2. 參考文獻書寫方式：
   (1) 中文書籍、專書論文、期刊論文：
   書籍：作者姓名、書名、出版社、出版年。（若某本書爲初版，不需註明其版次，僅須列出版年代。但若爲二版以上，則須註明版次。）
   例：馮震宇，企業e化•電子商務與法律風險，元照，2002年。
   專書論文：作者姓名、篇名、所載書名、出版年。
   例：蘇永欽，台灣的社會變遷與法律學的發展，載：當代法學名家論文集，1966年。
   期刊：作者姓名、篇名、期刊名、卷期別、起訖頁碼、出版年月。
   例：劉孔中、高安淇，從國際規範及歐盟設計規則論新式樣制度之革新，政大智慧財產評論，1卷1期，頁1-23，2003年10月。
   (2) 外文專書、專書論文、期刊論文：
   書籍：作者姓名（姓氏在前），書名（出版年）。出處作者與書名以小型大寫字表示。
   例：RHODE, DEBORAH L., JUSTICE AND GENDER (1989).

專書論文：作者姓名（姓氏在前），篇名，收錄於：書名（編者，出版年）。篇名以斜體字表示；收錄書名以小型大寫字表示。

例：Adams, John, *Argument and Report, in* 2 LEGAL PAPERS OF JOHN ADAMS (L. Kinvin Wroth & Hiller B. Zobel eds., 1965).

期刊論文：作者姓名（姓氏在前），篇名，出處期刊（出刊年）。篇名以斜體字表示；出處期刊名以小型大寫字表示。

例：Williams, Patricia J., *Alchemical Notes: Reconstructed Ideals from Deconstructed Rights*, 22 HARV. L. REV. 401 (1987).

3. 年代一律以西元紀年爲準。數字一律使用阿拉伯數字。
4. 作者得參考各該文獻出處國之學術慣例，斟酌調整參考文獻格式之細節。

著作權授權書

一、授權內容：

立書人＿＿＿＿＿＿同意授權國立政治大學、政大科技管理與智慧財產研究所，將下列著作：發表於智慧財產評論第【　】卷第【　】期之著作：「＿＿＿＿＿＿＿＿＿＿」進行數位化、重製等加值流程後收錄於資料庫，以電子形式透過單機、網際網路、無線網路或其他公開傳輸方式，提供用户進行檢索、瀏覽、下載、傳輸、列印等行爲。**並得以再授權其他資料庫業者進行前述之行爲。**

二、著作權聲明：

本授權書爲非專屬授權，立書人仍擁有上述授權著作之著作權。立書人擔保本著作係立書人之原創性著作，有權依本授權書內容進行各項授權，且未侵害任何第三人之智慧財產權。

立書人姓名：＿＿＿＿＿＿＿＿＿＿＿＿＿＿＿＿

身分證字號：＿＿＿＿＿＿＿＿＿＿＿＿＿＿＿＿

通訊電話：＿＿＿＿＿＿＿＿＿＿＿＿＿＿＿＿

電子信箱：＿＿＿＿＿＿＿＿＿＿＿＿＿＿＿＿

通訊地址：＿＿＿市(縣)＿＿＿區(鄉鎮市)＿＿＿路(街)＿段＿＿＿巷＿＿＿弄＿＿＿號＿＿＿樓之

立書人簽章：＿＿＿＿＿＿ (請親筆簽名) 中華民國＿＿年＿＿月＿＿日

智慧財產評論
NCCU Intellectual Property Review
國立政治大學科技管理與智慧財產研究所出版
Published by the Graduate Institute of Technology, Innovation and Intellectual Property Management
National Chengchi University

COPYRIGHT LICENSE AGREEMENT

The Author, _____, hereby grants a non-exclusive free license to National Chengchi University to collect the article as listed below ("Article") in its databases and provides the database in electronic form through signal PC version, internet, wireless network or any other way to transmit the article publicly, and to authorize others to do the same. The Article herein describes is:

Publicized in the NCCU Intellectual Property Review volume_____

_____

This Agreement only constitutes a non-exclusive license, and the Author reserves the copyright of the Article. The Author warrants that the Article is his/her original work, and has the right to license his/her copyright in accordance with this Agreement without infringing any intellectual property rights of any third party.

Name of Author: _____

ID Number: _____

Phone Number: _____

Email Address: _____

Signed by: _____ Date of Signing:_____

智慧財產評論
NCCU Intellectual Property Review
國立政治大學科技管理與智慧財產研究所出版
Published by the Graduate Institute of Technology,
Innovation and Intellectual Property Management
National Chengchi University

各位親愛的讀者，您好：

感謝您長期支持與愛護，本刊爲回饋廣大之讀者，即日起凡訂閱第一卷第一期至第六卷第二期之智慧財產評論者，本所將以八折之優惠回饋予讀者（不含運費）。數量有限，售完爲止，欲購者請洽本所。

期別	篇　　名	作　者	出版日期
第一卷第一期	從國際規範及歐盟設計規則論新式樣制度之革新 On the Reform of Taiwanese Design Law－Drawing Lessons from International and European Regimes	劉孔中 高安淇	2003.10
	智慧資本投資保障的完整性 Integrity Protection on Intellectual Capital Investment	周延鵬	
	電腦軟體與商業方法之專利保護：歐洲發展 Computer Program and Business Method Patents－The View from Europe	許曉芬	
	矽智財交易及其相關法律問題探討 SIP Trading Service and Related Legal Issues	蕭　敏 陳明發 黃淑君	
	中國大陸專家參審制度研究：以智慧財產權案件為例 Forward－Thinking Strategies for China Intellectual Property：To Maximize Economic Value of a Chinese Patent to the Extent Accorded to a U.S. Patent	陳昱奉 黃鈺晴	
	美國智慧財產權法最新發展與評析（2000～2003） On Recent Developments in U. S. Intellectual Property Law (2000～2003)	孫遠釗	
第二卷第一期	專利法修正後專利爭訟制度應有之改革－以專利權效力爭訟程序為中心 The Future of Post－Issuance Procedures of Patent Act in Taiwan	黃銘傑	2004.04
	中國知識產權戰略試探－一件中國專利將等於或大於一件美國專利的經濟價值 Forward-Thinking Strategies for China Intellectual Property－To Maximize Economic Value of a Chinese Patent to the Extent Accorded to a U.S. Patent	周延鵬	
	新著作權法「散布權」相關規定之檢討 The Analysis of Related Provisions Concerning the Distribution Right in New Copyright Law	章忠信	
	科技管理與大學衍生企業在日本的發展 The Development of MOT and USVB in Japan	溫肇東	
	智慧資本的法律定性與智慧財產證券化的可行性研究 The Legal Status of Intellectual Capital and the Feasibility Study of Intellectual Property Securitization	闕光威	

期別	篇　　名	作　者	出版日期
第二卷 第一期	從美國暫時性禁制令看我國定暫時狀態之假處分－以專利侵權爭議為例Comparative Study on the Preliminary Injunction between United States of America and Taiwan－Focus on Patent Infringement Cases	馮浩庭	
第二卷 第二期	從美國專利看臺灣企業科技創新競爭力 Evaluate the Technological Innovation Competitiveness of Taiwan Corporations Through U.S. Patents	陳達仁 黃慕萱 楊牧民	2004.10
	藥品創新與專利保護關聯之探討 Patent Protection on Pharmaceutical Innovations	黃文鴻 謝季峰	
	智慧資本揭露程度與智慧資本績效的關聯性研究 The Relationship between Level of Intellectual Capital Disclosure and Intellectural Capital Performance	羅庚辛 鄭明松 柯家瑜 許明峰	
	研發支出與人力資本對企業價值之影響 The Effects of R&D Expenditure and Human Capital on Business Value	汪瑞芝 吳志成 丁綉娟	
	品牌價值衡量模式之建構分析 A Study on Construction of the Brand Value Measurement Model	田祖武 許家甄 鍾宜靜	
	美國千禧年著作權法反規避條款對合理使用與競爭秩序之影響A Case Analysis of the DMCA Anti-Circumvention Provisions from Aspects of Fair Use and Competition	李憲珍	
第三卷 第一期	保險也有專利嗎？ Does Insurance Have a Patent?	賴奎魁 翁順裕	2005.04
	物品發明廠商智慧財產權保護決策之分析 The Analysis for Intellectual Property Protection Decision of Product Innovation Firm	吳桂森	
	網路侵權行為與臺灣地區盜版率The Effects of Internet Infringement Act on the Priacy Rate of Taiwan	鄭天澤 彭日欣	
	美國大學產學合作合約條款之研究The Study of Provisions of American Industry/University Cooperation Agreements	耿　筠 陳娟娟	
	建立鈾型企業的創新經營模式－以Gen Con公司為例 The Study of the Innovative Business Model－Uranium Enterprise	陳蕾琪 吳明璋 周隆亨 周源祥 張文俐 姚開陽 馮國璋	
	知識經濟指標之構念模型 Construct Model of Knowledge－Based Economy Indicators	陳智凱 黃恆獎	

期別	篇　　名	作　者	出版日期
第三卷 第二期	我國專利法及藥事法上試驗例外之研究 The Research of Experimental Use Exception on Patent Law and Pharmaceutical Affairs Act	孫小萍	2005.10
	由愛丁堡一案探討歐洲專利局對人類胚胎幹細胞可專利性之立場 An Analysis of the Position of European Patent Office on the Patentability of Human Embryonic Stem Cells Based on the Edinburgh Case	許耀華	
	客戶名單保護期間之決策 The Decision for Customer List Protect Horizon	吳桂森 耿　筠	
	專利技術授權策略研究－TFT LCD光學膜授權個案比較 A Study of Patent Technology's Licensing Strategy－Licensing Case of TFT LCD Optical Films	李滿祥	
	臺灣企業經營的全球化與臺灣法制的牽絆或解放－建構自由開放的對外投資、授權及技術移轉新環境 The Impediment or Liberalization of Taiwan Industries' Globalization under the Impact by Taiwan Legal Environment －A Quest to Liberalize Outbound Investment, license and Technology Transfer	周延鵬	
第四卷 第一期	我國智慧財產法院之理想與實現 Materializing the Goals of the Taiwan IP Court	盧文祥	2006.04
	中國高等教育、智慧財產權教育和人才培育的思考 Intellectual Property Right Education and Professional Training in China 's Higher Education	陳美章	
	台灣研發機構智慧財產的營運模式與行銷機制 A Study on Intellectual Property Business Model and Marketing Mechanism of Taiwan Non-Profit R&D Organizations	周延鵬 官欣雨	
	網際網路時代資訊安全管理制度檢核表之建立 The Construction of Checklist of Information Security Management System in Internet World	簡文慶 耿　筠	
	從工業設計的觀念探討新式樣專利 The Design Patent Discussing Form the Aspect and Concept of Industry Design	葉哲維	
	槍械與扣動扳機者孰負侵權之責？－論著作權之間接侵權行為責任 Is It the Gun or the Man Who Pull the Trigger That is Liable? －On Secondary Liabilities of Copyright Infringement	孫遠釗	
	以關係價值觀點建構連鎖加盟品牌鑑價模式 Construction of the Chain & Franchise's Model of Brand Valuation Based on the Aspect of Relationship Value	莊水榮 許牧彥 張彥輝	

期別	篇　　名	作　者	出版日期
第四卷 第二期	智慧財產作價投資與新創事業 Contribution of Intellectual Property as Equity and New Venture	周延鵬	2006.10
	技術標準與專利佈局策略之研究－以國內無線通信技術研發為例 Technical Standard and Patents Strategy on Wireless Communication R&D in Taiwan	陳達仁 馮國璋	
	數位音樂產業及其商業模式 A Study on Digital Music Industry and Business Model	周丸生 劉育奇 蔡宜廷 周欣嫻	
	真品平行輸入之商標權問題—從臺灣高等法院九十二年度上易字第二六九０號刑事判決談起 Trademark Issues Regarding the Parallel Importation of Genuine Goods Based on 2003 Taiwan High Court Interpretation No. 2690 of the Judicial Yuan	張作為	
	Protecting Your American Intellectual Property Rights：How Foreign Companies Can Utilize The United States International Trade Commission and Section 337 Investigations .	Gary M. Hnath & Mit Winter	
第五卷 第一期	著作採用創新授權機制衍生價值共享之探討 An Exploration of The Shared Benefits Derived from the Utilization of Innovative Licensing Mechanisms for Creative Works	盧文祥	2007.04
	專利侵權訴訟之訴訟觀與案件管理 Observation on Patent Litigation and Case Management	陳昱奉	
	台灣專利聯盟（Patent Pool）的可行性探討—以國際產業標準的營運模式為例 The Feasibility Analysis of patent Pool in Taiwan—The Business Model of International Standard	徐弘光	
	兩岸農業智財保護及其經營 The Protection and Management of Agricultural Intellectual Property between Taiwan and Mainland China	林之崴 高千雯 邱晶晶	
	TRIPs對於處方藥品試驗資料之保護 Protection of Test Data of Prescription Drugs Under TRIPs	楊代華	
第五卷 第二期	產品創新秘密保護期之敏感度分析 Sensitivity Analysis for Secret Protection Horizon of Product Innovations	吳桂森 李能慧 古東源	2007.10
	從專利觀點比較台灣與南韓技術創新能力（1987-2006） Technological Innovative Capacity of Taiwan and South Korea from 1987-2006－A Perspective of Patents	王俊傑 陳達仁 黃慕萱	

期別	篇　　名	作　者	出版日期
第五卷 第二期	對著作權保護範圍擴張的因應－合理使用實務與理論基礎之研究 A Response to the Enlargement of the Scope of Copyright－A Review of Judicial Practice and the Theoretical Framework of Fair Use	闕光威	2007.10
	大學技轉及育成中心的迷失與困境 The Myth and Loss of University Technology Licensing and Business Incubator	蔡孟潔 蔡達智	
第六卷 第一期	兩岸專利代理機構營運模式與績效比較－以將群、三友及三環為例 A Comparison between Taiwan and Across the Strait Patent Prosecution Business Models and Effects	李容嘉 翁千惠 黃上上 樊治齊	2008.04
	兩岸IT產業智慧財產與研發策略—以研華、方正為例 The IP Management And R&D Strategy of Cross-Strait IT Industry－Cases of the Advantech Corp. and the Founder Group.	鄭聖群 黃嘉敏 黃愛倫 羅晶華	
	兩岸國家型農業生技園區之營運模式探討－以楊凌農業高新技術產業示範區及屏東農業生物技術園區為例 Business Model of Cross-Strait National Agricultural Biotechnology Parks－An illustration of Yangling Agricultural Hi-tech Industries Demonstration Zone and Pingtung Agricultural Biotechnology Park	鄭雅文 歐師維 馮志峰 林群倫	
	兩岸智慧財產法院及審判實務 The Practice of the IP Cases in the Court in Taiwan and China	黃紫旻 吳雅貞 陳志承 朱家毅	
第六卷 第二期	有關大陸知識產權司法體制改革的思考 To Reform of the IP Judicial System of the P.R.C.	張玉瑞 韓秀成	2008.10
	論中國知識產權法律體系的協調化 Coordinating of Legal System of Intellectual Property Rights	胡開忠	
	試論我國《反壟斷法》對知識產權濫用的限制 Restrictions on Intellectual Property Abuse in China Antitrust Law	陳乃蔚	
	否棄集體作者觀：民間文藝版權難題的終結 Disavowal of Collective Authorship: Ending the Dilemma of Folklore Copyright	崔國斌	
	E世代知識管理管理平台中隱私權與智慧財產權法的爭議 A New Mode of Knowledge Transfer and the Relevant Intellectual Property and Privacy Issues in Taiwan	闕光威	
	APEC電子資料隱私保護原則分析 Analysis on APEC Privacy Framework Principles	潘兆娟	
	影響技術移轉績效的三個關鍵基礎理論 The Three Key Based Theories Impact on the Technology Transfer	葛孟堯	

期別	篇　　名	作　者	出版日期
第七卷 第一期	合理使用對內容產業的管理意涵－以市場失靈理論為核心 How Shall Content Industry Deal with Fair Use? －A Market Failure Perspective	闕光威	2009.04
	論企業共同開發完成後之專利權共有 Joint-Development and the Resulted Patent Co-Ownership －an Analysis from the Perspectives of Law and Economics	侯慶辰	
	資訊時代中營業秘密保障之探討 The Discussion of Trade Secrets Protection Posed by Computerization	曾勝珍	
	由UDRP處理原則探討網域名稱爭議於我國商標法之適用 Domain Name Dispute: From UDRP to Trademark Law	鄭嘉逸	
第七卷 第二期	美國專利間接侵權實務對我國專利法修正導入間接侵權之啓示 A Case Study of Indirect Infringement Practices in the U.S. and Some Notices to the Amended Patent Act in Taiwan	劉國讚	2009.10
	中國大陸專利法制之損害賠償規範與計算方法 －從第三次專利法修正談起 Damages Calculation in China Patent Law and Practice －Perspective of Third Amendment to Patent Law	李柏靜	
	我國專利特許實施主要問題之探討 －兼論最近相關修正草案 Discussion on Main Issues of Patent Compulsory Licenses in R.O.C－Additionally to Discuss the Latest Draft Amendment to the Patent Law	汪渡村 劉德勳	
	促進抑或是阻礙創新？從法律經濟學角度審視美國商業方法專利之適格性爭議－以*In re* Bilski案為例 Fostering or Hindering Innovation? Revisit the Patentability Issue of Business Method from the Perspective of Law and Economics－*In re* Bilski as an example	胡心蘭 蔡岳勳	
	到不了的安全港？歐洲共同體技術授權豁免法之研究 A Safe Harbour Out of Reach?－EU Approach to the Antitrust Analysis of Technology Transfer	謝國廉	
第八卷 第一期	反仿冒貿易條約草案下就點對點檔案傳輸施以刑罰實非為解決之道 Criminal Sanctions on P2P File-sharing under Proposed ACTA Are No Panacea	鄭莞鈴	2010.04
	生技專利聯盟模型可行性之探討－以中草藥為例 A Study on the Feasibility of Pooling Chinese Herbal Medicine Related Patents	江政穎 侯子文 許舜喨	
	智慧財產權之實行－亞洲公司於美國面臨之訴訟問題 Enforcing Intellectual Property Rights in the U.S.: Litigation Issues Confronting Asian Companies	鍾泳熾 江易儒	

期別	篇　　名	作　者	出版日期
第八卷 第一期	企業創業投資決策之前置因素分析 The Antecedents of Corporate Venturing Investment	邱奕嘉 邱世寬 廖宜慶 李岱砥	2010.04
第八卷 第二期	先前技術阻卻侵權之探討 Study on Practicing Prior Art Defense to Patent Infringement Charge	王瓊忠 蔡岳勳	2010.10
	論關係企業間技術授權的法律問題 Legal Issues regarding Technology Licensing Between Affiliated Companies	侯慶辰	
	我國智慧財產權保護之邊境相關管制措施施實務與未來－由「與貿易有關之智慧財產權協定（TRIPS）」以及美國實務為出發，兼論世界關務組織（wco）推展之「海關統一權力暫定執行標準」 The Practical Issues and Future for Border Measurement in Intellectual Property Protection in Taiwan-Starting from TRIPS and the Practice in the United States, also the "provisional Standards Employed by Customs for Uniform Rights Enforcement (S.E.C.U.R.E)" promoted within World Customs Organization	程法彰 劉國勝	
	智財權，產權保護程度與投資融資方式對跨國企業對外投資的影響 Intellectual Property Right, Ownerships, Financing Decision and FDI	賴法才 張順教	
第九卷 第一期	網路購物機制之微調－從購物網站標價錯誤之數件判決談起 The Fine Tuning for Online Shopping Mechanism: Lessons from Pricing Error Cases	張瑞星	2011.06
	從國際間對商標減損規範看智財法院Intel案判決與商標法修正 Famous Trademark Protection and Challenge in Taiwan－From Taiwan IP Court Decisions to International Practices	馮震宇	
	論策略性企業社會責任與著作權合理使用的藩籬與平衡：以Google數位圖書館計畫為中心 Testing The Boundaries And Balance Of Strategic Corporate Social Responsibility And Fair Use Doctrine: Perspective From The Google Books Library Project	王育慧	
	中國大陸地理標誌構成要件研究 Research on Constitution Requirement of Geographical Indications in the People's Republic of China	李祖明	

期　別	篇　　名	作　者	出版日期
第九卷 第二期	美國法專利權濫用理論對我國法之啓示 The Enlightenment of the Patent Misuse Doctrine	何曜任	2011.12
	美國專利法上的非顯而易知性研究 A Study of Nonobviousness of US Patent Law	鄭煜騰 王偉霖	
	上市要求與專利保護的法規競合對研發高階醫療器材投資之衝擊：磁振造影引導高強度聚焦超音波系統 The Impact of Competing Regulatory Requirements of Pre-Market Registration and Patent Protection on Investing in the Research and Development of High-End Medical Device: Magnetic Resonance Image Guided High Intensity Focused Ultrasound System	鄭匡善	
	評臺灣面對國外專利侵權訴訟的對應策略－兼論政府參與「智慧財產基金」的可行性 On Taiwan's Strategy towards Foreign Patent Infringement Litigation: Feasibility of Government Involvement in "Ip Bank"	孫遠釗	
第十卷 第一期	專利庫—經濟取向分析下之法制比較與調和 The Enlightenment of the Patent Misuse Doctrine	劉孔中	2012.06
	由美國 Cartoon Network LP, LLLP v. CSC Holdings, Inc. 一案對於我國著作權法的啓示與借鏡—以「公開傳輸權」為中心 Some Lessons from Cartoon Network LP, LLLP v. CSC Holdings, Inc. are Reflected in Taiwanese Copyright Law in terms of Public Transmission Right	沈宗倫	
	論美國專利授權契約之搭售與專利權濫用 Tying Restrictions and Patent Misuse in Patent Licensing Agreements of the United States	傅松青	
	兩岸著作權法視聽著作之立法檢討－以視聽著作之定義、歸屬及保護期間之比較為中心 A Reflection on the Copyright Legislations for Audiovisual Works on both sides of the Strait	蕭雄淋	
第十卷 第二期	歐盟競爭法處理濫用獨占地位爭議之新標準－以英特爾案為中心 The Intel Decision and the EU's New Standards for Behaviours by Dominant Firms	謝國廉	2012.12
	著作權濫用—以利用商品標籤或包裝之著作權禁止真品平行輸入一般商品為例 Copyright Misuse – The Parallel Importation Restriction by Copyrighted Product Labels	林利芝	
	台灣廠商涉及美國 337 調查之實證研究—兼論國內產業要件 An Empirical Study on Section 337 Inves tigations Involving Taiwanese Companies -with an analysis of the domes tic industry requirement	李柏靜	
	我國合理使用判斷基準之實證研究分析 An Empirical Study of Taiwan Courts' Opinions on Fair Use Four-Factor Test	蘇郁雅	

期　別	篇　　名	作　者	出版日期
第十一卷第一期	戲謔仿作（Parodie）與著作權保護 Parodywork and Protection of Copyright	王怡蘋	2013.06
	藥品試驗資料專屬權近期國際發展之趨勢—我國資料專屬權制度及因應國際趨勢應有之調整 The Data Exclusivity and its International Development - Aligning Taiwanese Law with nternational Norms and Concepts	葉雲卿	
	從美國司法判決看專利聯盟的今日與未來 The development of patent pool under the decision of CAFC Today and Tomorrow	傅松青	
	公共建設委外型研究案之智慧財產管理探討 Intellectual Property Management of Infrastructure related Public-Funded Research	高千雯 陳其華 沈麗琴 陶治中 黃鳳梅 吳東凌 洪銘揚	
第十一卷第二期	著作權法宏觀修法之比較研究 Comparative Study of Principles for de lega ferenda Copyright Law	劉孔中	2013.12
	兩岸著作權法修正發展之觀察與初步探討 The Observation and Preview to the Cross-Strait Copyright Amendments	章忠信	
	論生物相似性藥品上市審查規範：以美國生物藥品價格競爭與創新法為師或為鑒？ On Regulation of Biosimilar: A Model or a Lesson by the U.S. Biologics Price Competition and Innovation Act of 2009?	傅冬卿 陳銘雄	
	美國貿易法第 337 條與世界貿易組織法律架構之相容與衝突－以專利執法措施為研究中心 Section 337 of the US Tariff Act in the Context of United States Obligations under the WTO Legal Framework with Focus on Patent Enforcement Measures	Daniel Herrera	
第十二卷第一期	數位著作授權與合理傳輸—論權利耗盡原則的新時代意義 Licensing and Reasonable Transmission of Digitize Works—Epochal Application of the Exhaustion Doctrine	沈宗倫	2014.06
	疾病管制署採購愛滋治療之學名藥與專利侵權風險 AIDS Medicine Purchase by the Centers for Disease Control and the Risk of Patent Infringement	陳秉訓	

期　別	篇　　名	作　者	出版日期
第十二卷 第一期	泰國博物館難以為繼之困境與智慧財產權管理： 從類比到數位以及美國法的啓示 The Problem of Unsustainability in Thai museums and Intellectual Property Rights Management: From Analog to Digital and the Lessons from the US	陳光合 陳曉慧	2014.06
	資料專屬權與專利保護制度之競合：以美國藥品上市法制為中心 The Coopetition between Data Exclusivity System and Patent System － Focusing on American Law	夏　禾 陳錡雄	
第十二卷 第二期	由 AMP v. Myriad Genetics, Inc. 案談基因專利之適格性 Gene Patents in the Aftermath of AMP v. Myriad Genetics, Inc.	李治安	2014.12
	數位著作授權契約對第一次銷售原則之影響與濫用原則之適用 Applying Copyright First Sale Doctrine and Misuse Doctrine to the License Agreement of Digital Copyrighted Work	胡心蘭	
	專利侵權損害賠償決策因子之研究 —以台灣智慧財產法院之實證判決為基礎 A Research on Deciding Factors of Patent Infringement Damages: An Empirical Analysis of Cases in the Taiwan IP Court	桂祥豪 熊誦梅 蘇瓜藤	
	美國後 eBay 時代專利侵權案件之永久禁制令：以法院見解發展與實證研究為中心 Permanent Injunctions of Patent Infringement in the Post-eBay Era of the United States: Focusing on Opinion Development and Empirical Analysis of Judicial Decisions	李　玄 王立達	
第十三卷 第一期	美國 Microsoft 案後續發展及其對計算標準專利合理權利金之影響 The Aftermath of the Microsoft Case and Its Reach on the Calculation of Reasonable Royalty of Standard Patent in the United States	葉雲卿	2015.06
	智慧財產權擔保交易登記制度之研究 Study on Registry System of Security Rights in Intellectual Property on Secured Transactions	陳重見 顏世翠	
	從美國專利改革法案看美國專利法新穎性要件之變革 A Study on Changes of Novelty Requirement under U.S. Patent Law from the View of Leahy-Smith America Invents Act	劉振泰 蔡岳勳	

期　別	篇　　名	作　者	出版日期
第十三卷 第一期	手段功能用語之權利範圍解釋 —以圓剛科技 I240169 號專利行政訴訟與美國專利法為比較 Claim Construction of Means Plus Function -Focus on Patent No. I240169 Administrative Law Suit and Reexamined with U.S. Patent Practice	林博智	2015.06
第十三卷 第二期	數位著作物自由散布的界限與不法重製防止義務－重新建構我國著作權法數位權利耗盡原則 The Exhaustion Doctrine and the Duty of Assistance under Copyright Law in the Cases of Digital Transactions	沈宗倫	2016.01
	專利到期後續收權利金條款有效性探討 A Study on the Legality of Royalty Collection Clause after Expiration of Patent Rights	王偉霖	
	人體生物資料庫之合理近用及其專利政策－以我國之商業運用利益回饋為核心 On the Fair Access and Patent Policy of Human Tissue Biobanks—Focusing on the Benefit-Sharing Clause in Taiwan	李崇僖 星友康	
	封鎖外國侵權網站得否為著作權人的救濟手段－從歐洲法院 2014 年 UPC 案判決反思 Granting a Website-Blocking Injunction as a Relief for Copyright Owners—What Can We Learn from the 2014 UPC Decision of the European Court of Justice	陳秉訓	

智慧財產評論編輯委員會組織章程

93.01.06 編輯委員會籌備會議訂定
98.09.23 編輯委員會修訂全文
99.05.03 編輯委員會修訂第 4、5、9、10 條
100.11.03 編輯委員會修訂第 3、4、9 條
102.05.10 編輯委員會修訂第 4 條

第一章　總　則

第 一 條　國立政治大學科技管理與智慧財產研究所爲提升「智慧財產評論」（以下簡稱本評論）之編審及出版品質，特成立「智慧財產評論編輯委員會」（以下簡稱本委員會）。

第 二 條　本評論爲專業之學術期刊，每年六月及十二月各發行一期。其目的在提供國內外智慧財產相關學術資訊與意見交流的平台、提升智慧財產研討風氣。

第二章　組織架構

第 三 條　本委員會會址設於國立政治大學科技管理與智慧財產研究所辦公室內。

第 四 條　本委員會組織與職掌如下：

一、主編 1 人：決定編輯政策與方針及負責召集本委員會開會等相關事宜。由本委員會過半數同意決之，任期二年，並得連選連任。

二、執行編輯 1 人：協助主編決定編輯政策與方針、綜理編審工作、決定稿件審查人及各期稿件刊登相關事宜。執行編輯由主編指定之，任期二年，並得連選連任。

三、助理編輯 1 人：統籌負責編輯事宜。包括負責安排匿名審稿作業，並負責聯繫及出版事務等。助理編輯由主編指定之。

四、置編輯委員若干人：參與稿件審查工作、協助拓展稿源、提供本評論諮詢意見及決定稿件之刊登順序。由主編自國內外智慧財產相關領域之專家學者中遴聘組成，核定後頒發聘書，任期爲兩年，並得連任。

五、設編輯小組：協助進行稿件校對、編排期刊內容、出版等事項。編輯小組成員由本所研究生遴選之。

第三章　會　議

第五條　本委員會之法定開會人數爲全體委員人數之二分之一，如有決議事項，以不記名投票方式行之，票數達出席委員人數二分之一以上爲通過。

第六條　編輯委員會進行稿件審查作業視爲機密，各委員應遵守專業道德，非經公開程序，不得自行對外公開審查作業之相關資料。

第七條　本委員會爲編輯本評論之需要，得召開下列二類會議：

一、編輯委員會議

二、編輯小組會議

第八條　本委員會之編輯委員會議，由主編定期召集編輯委員及執行編輯等人召開，討論本委員會組織規程、刊登稿件、年度工作方針及預算經費等重大事項。

第九條　本委員會之編輯小組會議由執行編輯召集助理編輯及編輯小組召開，討論稿件審議、期刊內容、校稿、出版等事項；每期出刊前至少召開一次，必要時得召開臨時會議。

第四章　附　則

第十條　本委員會組織章程應由編輯委員會議通過並報請所長核可實施，修正時亦相同。

第十一條　其他未盡之事宜，得由編輯委員會議訂定相關辦法規範之。

智慧財產評論／政大科技管理與智慧財產研究所編印
第十四卷第一期
臺北市：國立政治大學科技管理與智慧財產研究所
民105/07
ISSN：1811-8518
GPN：2009204260

期刊名稱：智慧財產評論（原名：政治大學智慧財產評論）

Name of Journal: NCCU Intellectual Property Review

發行人：馮震宇
Publish：Jerry G. Fong

出版者：國立政治大學科技管理與智慧財產研究所
Publisher：Graduate Institute of Technology, Innovation and Intellectual Property Management

主　編：馮震宇
Editorial Director：Jerry G. Fong

出版日期：2016年07月15日
創刊日期：2003年10月15日

聯絡地址：116台北市文山區指南路二段64號
Address：64, Sec. 2, Zhi-nan Rd., Wenshan, Taipei 116, Taiwan, Republic of China

網　址：http://tiipm.nccu.edu.tw/zh-hant/node/369
Email：ipr@nccu.edu.tw

連絡電話：886-2-2939-3091分機89510
Tel：886-2-2939-3091 ext. 89510

傳眞：886-2-2938-7555
Fax：886-2-2938-7555

總 經 銷：元照出版公司
地　　址：10047台北市館前路18號5樓
網　　址：www.angle.com.tw
電　　話：886-2-2375-6688　　傳　　眞：886-2-2331-8496
劃撥帳號：19246890 戶名：元照出版有限公司（請註明刊名、期別、寄送地址）
訂閱一年二期500元（掛號）
大陸港澳：700元 亞.太地區：750元 歐.美.非地區：850元（以上皆航空掛號）
定　　價：新台幣200元整

MEMO

MEMO

NCCU Intellectual Property Review

Volume 14, Number 1

July 2016

http://tiipm.nccu.edu.tw

元照總經銷 Angle Publishing

TIIPM

國立政治大學 科技管理與智慧財產研究所
Graduate Institute of Technology, Innovation and Intellectual Property Management
National Chengchi University