

# 美國與臺灣專利民事侵權 訴訟爭點效之發展與爭議 ——兼論臺灣專利無效雙軌制之困境

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摘 要

所謂附隨禁反言，又稱為爭點排除效。美國專利侵權訴訟中爭執之專利一旦被判定無效，基於附隨禁反言，該無效判決則產生對世效力。1971年，美國最高法院就 *Blonder-Tongue v. University of Illinois Foundation* 一案判決，改變過去見解，判決中提及專利權人在一終局並得上訴之判決中被認定無效之專利權人，被禁止再對他人主張專利權。隨後，此一附隨禁反言之適用範圍，從專利無效之認定，擴大到專利侵權及不侵權之認定，以及專利請求項之解釋。本文研究美國法院一系列之判決發展，討論專利訴訟之附隨禁反言之範圍與發展。並藉由美國附隨禁反言之概念，回頭檢討臺灣智慧財產法院

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DOI：10.3966/181130952018090003003

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投稿日：2018年3月26日；採用日：2018年4月25日

之相關運作。臺灣目前問題有二：1.基於司法二元化之結構，民事專利無效判決無法讓該專利真的無效；2.專利權人對上游廠商而法院判決不侵權後，卻轉而對下游廠商提告之問題。本文將比較日本、臺灣、德國、美國之專利無效雙軌制度，並檢討臺灣制度之問題。

關鍵詞：專利民事訴訟、附隨禁反言、爭點排除效、專利無效、司法二元化

Cite as: 3 NCTU L. REV., September 2018, at 97.

# **The Development and Disputes of Issue Preclusion in Civil Patent Litigation in the U.S. and Taiwan —Dilemma Resulting from Patent Invalidity Two-track System in Taiwan**

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Abstract

In civil procedure in U.S., there is a principle of collateral estoppel, also called as issue preclusion. When a patent be declared invalid in a civil litigation opinion by court, principle of collateral estoppel would prevent the patent owner litigate on the patent again. In 1971, the U.S. Supreme Court decides the case *Blonder-Tongue vs. University of Illinois Foundation*, overruling the old principle mutuality of estoppel, held that once a patent owner's patent be declared as invalid, he can't bring infringement suit against other implementers any more. Afterwards, the scope of principle of collateral estoppel extended to the issue of infringement or not infringement of patent, and issue of patent claim interpretation.

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For the purpose of understanding development and scope of principle of collateral estoppel in patent context in U.S., several important cases in U.S. courts will be studied. Furthermore, we will compare the operation of Taiwan IP court with the U.S. There are two situations problematic in Taiwan: 1. For reasons of dual judiciary system in Taiwan, court decision in civil proceeding declare a patent invalid actually not yet invalidate that patent forever. 2. After a patent owner lose his suit against upstream company alleged infringing patent, he can then bring suit against downstream company. In the end, the two-track invalidation system of Japan, Taiwan, German, and U.S. will be compared, to find what the problems and dilemma in Taiwan's patent invalidation system.

**Keywords: Patent Civil Litigation, Collateral Estoppel, Issue Preclusion, Patent Invalid, Dual Judiciary System**