判決評析

網路時代專利權之重要案例探討——

Quanta Computer, Inc. v. LG Electronics, Inc. (128 S. Ct. 2109, 2008)

臺灣桃園地方法院法官 ◀◀◀ 俞力華

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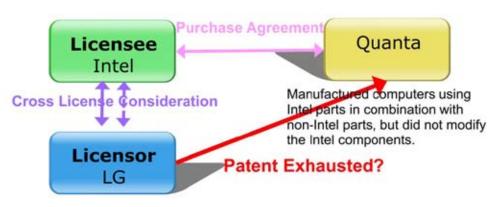
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壹、案件事實

LG Electronics, Inc. (下稱LG)於1999年 購買電腦技術專利組合,其中包括美國專利號 4939641、5379379、5077733此3項與微處理 器和晶片製造相關之專利技術。LG將此專利 組合與Intel進行交互授權,交互授權契約中允 許Intel直接及間接製造、使用、販賣、為販賣 之要約、進口或其他以其產品實行LG專利之 處置行為,雖然契約中授權範圍極廣,但仍 附有限制性約定,即排除任何第三人將授權製 造之產品與Intel以外製造商的零組件結合,亦 排除該結合物之使用、販賣、為販賣之要約、 進口行為,又雙方均同意不得以任何方式限制 或更改專利權耗盡之效果。雙方另一份主契約 (Master Agreement)中,LG明文要求Intel有義務告知客戶授權效力並不及於客戶將Intel產品與非Intel產品相結合之行為,但違反此契約義務仍不構成影響或終止授權契約之事由。

Quanta Computer, Inc. (下稱Quanta)自 Intel購買其生產之微處理器與晶片,並確實收 到Intel於Master Agreement被賦予通知義務之訊 息。然而, Quanta仍將該零組件裝配整合入電 腦系統而實施了LG專利技術內容。但Quanta全 未修改Intel售與之微處理器和晶片,且完全遵 照Intel之指示說明將其組裝入系統內。

LG因而向Quanta提起專利侵權訴訟,指稱 其將Intel生產之授權產品與非Intel生產之零組 件相結合之行為構成專利權侵害。



- ◆Authorizes Intel to make, use, sell (directly or indirectly), offer to sell, import or otherwise dispose of its own products practicing the LG Patents.
- The license doesn't extend, expressly or by implication, to any product that made by any third party combining an Intel product with any non-Intel product.

北加州地方法院最初核准Quanta簡易判決 (Summary Judgement),理由即以本件已符 合專利權耗盡該當條件,法院指出:儘管Intel 生產之微處理器和晶片尚未完全實現LG的專 利內容,但這些零組件除了用以組裝為完整電 腦外,並無其他侵權之用途,因此援引United States v. Univis Lens Co. (1942) 判例,認為此 時仍構成專利權耗盡。惟北加州地方法院在後 來的命令中限制了原先的簡易判決,北加州地 方法院認為專利權耗盡僅適用於物品專利,而 不適用製程、方法專利,正因LG主張的3項專 利中,均包含方法專利項,則專利權耗盡原則 就這部分不適用之。然而,北加州地方法院嗣 於2004年判決認為Quanta並未構成專利侵權。

本件經上訴至聯邦巡迴上訴法院,聯邦巡 迴法院為逆轉性判決,改判LG勝訴,對於北加 州地方法院判決理由為部分支持、部分反對之 見解:聯邦巡迴上訴法院同意專利權耗盡原則 不適用於方法專利之見解,但其認為因LG與 Intel的授權範圍已明文排除第三人將Intel產品 與非Intel產品組合之行為,故專利權耗盡原則 不適用於本件,從而改判。

本件最後經Quanta上訴至聯邦最高法院, 經聯邦最高法院受理並於2008年6月為最終判 決,聯邦最高法院以9:0票數推翻了聯邦巡迴上 訴法院的見解,對專利權耗盡原則做出重要性 解釋。





貳、聯邦最高法院判決理由

- \ Issue 1: Does the doctrine of patent exhaustion apply to method claims?
- → Holding: Yes, the doctrine of patent exhaustion applies to method claims.
- →先行整理聯邦最高法院就此部分之判決 理由如下

Rational:

- LGE reasons that, because method patents are linked not to a tangible article but to a process, they can never be exhausted through a sale. Rather, practicing the patent which occurs upon each use of an article embodying a method patent is permissible only to the extent rights are transferred in an assignment contract.
- Quanta, in turn, argues that there is no reason to preclude exhaustion of method claims, and points out that both this Court and the Federal Circuit have applied exhaustion to method claims. It argues that any other rule would allow patent holders to avoid exhaustion entirely by inserting method claims in their patent specifications.
- Quanta has the better of this argument. Nothing in this Court's approach to patent exhaustion supports LGE's argument that method patents cannot be exhausted. It is true that a patented method may not be sold in the same way as an article or device, but methods nonetheless may be "embodied" in a product, the sale of which exhausts patent rights.
- The precedents do not differentiate transactions involving embodiments of patented methods or processes from those involving patented apparatuses or materials. To the contrary, this Court has repeatedly held that method patents were exhausted by the sale of an item that embodied the method.

- In Ethyl Gasoline Corp. v. United States, 309 U.S. 436, 446, 457, 60 S.Ct. 618, 84 L.Ed. 852 (1940), for example, the Court held that the sale of a motor fuel produced under one patent also exhausted the patent for a method of using the fuel in combustion motors. Similarly, as previously described, Univis held that the sale of optical lens blanks that partially practiced a patent exhausted the method patents that were not completely practiced until the blanks were ground into lenses. 316 U.S., at 248-251, 62 S.Ct. 1088.
- Eliminating exhaustion for method patents would seriously undermine the exhaustion doctrine. Patentees seeking to avoid patent exhaustion could simply draft their patent claims to describe a method rather than an apparatus. Apparatus and method claims "may approach each other so nearly that it will be difficult to distinguish the process from the function of the apparatus."
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- →Holding: The Court held that the relevant consideration is whether a sold article embodies the essential features of the patent. If so, then its sale exhausts that patented invention.
- →先行整理聯邦最高法院就此部分之判決 理由如下

Rational:

- Quanta argues that, although sales of an incomplete article do not necessarily exhaust the patent in that article, the sale of the microprocessors and chipsets exhausted LGE's patents in the same way the sale of the lens blanks exhausted the patents in Univis.
- Quanta also argues that exhaustion doctrine will be a dead letter unless it is triggered by the sale of components that essentially, even if not

completely, embody an invention. Otherwise, patent holders could authorize the sale of computers that are complete with the exception of one minor step-say, inserting the microprocessor into a socket-and extend their rights through each downstream purchaser all the way to the end user.

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- We agree with Quanta that Univis governs this case. As the Court there explained, exhaustion was triggered by the sale of the lens blanks because their only reasonable and intended use was to practice the patent and because they "embodied essential features of the patented invention."
- LGE has suggested no reasonable use for the Intel Products other than Incorporating them into computer systems that practice the LGE Patents. Nor can we can discern one: A microprocessor or chipset cannot function until it is connected to buses and memory. And here, as in Univis, the only apparent object of Intel's sales to Quanta was to permit Quanta to incorporate the Intel Products into computers that would practice the patents.
- Everything inventive about each patent is embodied in the Intel Products. They control access to main and cache memory, practicing the '641 and '379 patents by checking cache memory against main memory and comparing read and write requests. They also control priority of bus access by various other computer components under the '733 patent. Naturally, the Intel Products cannot carry out these functions unless they are attached to memory and buses, but those additions are standard components in the system, providing the material that enables the microprocessors and chipsets to function.
- · Quanta was not required to make any creative or inventive decision when it added those parts. Indeed, Quanta had no alternative but to

follow Intel's specifications in incorporating the Intel Products into its computers because it did not know their internal structure, which Intel guards as a trade secret. Intel all but practiced the patent itself by designing its products to practice the patents, lacking only the addition of standard parts.

- · While each Intel microprocessor and chipset practices thousands of individual patents, including some LGE patents not at issue in this case, the exhaustion analysis is not altered by the fact that more than one patent is practiced by the same product. The relevant consideration is whether the Intel Products that partially practice a patent-by, for example, embodying its essential features-exhaust that patent.
- 三 \ Issue 3: Was Intel's sale to Quanta an "authorized" sale sufficient to trigger the doctrine of patent exhaustion?
- → Holding: Yes, Intel's sale to Quanta exhausted LGE's patent rights.
- →先行整理聯邦最高法院就此部分之判決 理由如下

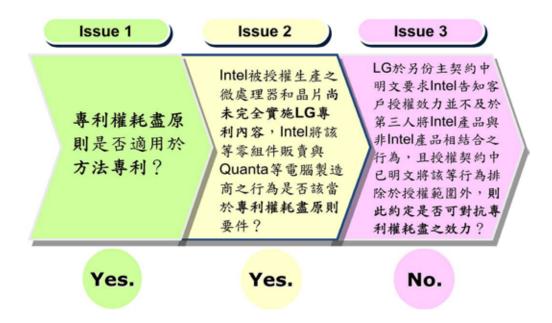
Rational:

- Exhaustion is triggered only by a sale authorized by the patent holder. LGE argues that this sale was not authorized because the License Agreement does not permit Intel to sell its products for use in combination with non-Intel products to practice the LGE Patents.
- LGE overlooks important aspects of the structure of the Intel-LGE transaction. Nothing in the License Agreement restricts Intel's right to sell its microprocessors and chipsets to purchasers who intend to combine them with non-Intel parts. It broadly permits Intel to "'make, use, [or] sell'" products free of LGE's patent claims.
- To be sure, LGE did require Intel to give notice to its customers, including Quanta,

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that LGE had not licensed those customers to practice its patents. But neither party contends that Intel breached the agreement in that respect. In any event, the provision requiring notice to Quanta appeared only in the Master Agreement, and LGE does not suggest that a breach of that agreement would constitute a breach of the License Agreement. Hence, Intel's authority to sell its

products embodying the LGE Patents was not conditioned on the notice or on Quanta's decision to abide by LGE's directions in that notice. Because no conditions limited Intel's authority to sell products substantially embodying the patents, the sale constituted an authorized sale, and the doctrine of patent exhaustion applies.



參、聯邦最高法院判決論述

一、專利權耗盡原則為判例揭示之原則

專利權耗盡原則早在19世紀即為判例所揭示,例如:Bloomer v. McQuewan、Bloomer v. Millinger、Adams v. Burke、Bauer & Cie v. O'Donnell、Motion Picture Patents Co. v. Universal Film Mfg. Co.等判例,長久以來已成為專利制度中根深蒂固之準則。其中,聯邦最高法院就專利權耗盡距離本件最近之討論是在United States v. Univis Lens Co. (1942),聯邦最高法院揭示當購買之物件雖未完全實現專利權內容,但其已涵蓋專利發明之主要特徵,且勢必被購買者加以使用以完全實現專利權內容,此時專利權人之權利亦已耗盡。

二、專利權耗盡原則適用於方法專利

LG認為專利權耗盡不適用於方法專利,而系爭3項專利均帶有方法專利項,故本件無耗盡原則之適用,其理由在於方法專利所連結者非有形物件,便無法透過販售使其耗盡。反之,Quanta主張並無合理理由足以排除方法專利於耗盡原則之外,且指出聯邦最高法院和聯邦巡迴上訴法院均曾認同適用耗盡原則於方法專利,又若方法專利無專利權耗盡之適用,專利權人只要在專利中安插方法專利項,即可輕易規避耗盡原則之限制,則將形同架空了耗盡原則。

聯邦最高法院在此項爭點中採納了Quanta 之理由,表明該院從未有過任何見解認為專利 權耗盡不適用於方法專利,雖然方法專利無法 如同實體物件般被販售,但仍可被具體化實行於產品中,而販售該產品便可達專利權耗盡之效果,該院過去的判例就專利權耗盡之討論,亦未將方法專利和物品專利予以差別化處理,反而存有判例揭示方法專利可適用耗盡原則,見Ethyl Gasoline Corp v. United States(1940)、United States v. Univis Lens Co.(1942)。

聯邦最高法院認為一旦排除方法專利於耗盡原則外,將會嚴重侵蝕耗盡原則,專利權人要迴避專利權耗盡所帶來之限制,僅需輕易地將原本的物品專利項改寫為方法專利項即可,因該二者本身即具有灰色地帶,有時方法製程和物品功效是難以區辨的。倘若採取LG之見解,縱使LG已授權Intel販賣帶有LG專利之完整電腦系統,任何Intel下游採購商甚至是消費者仍無法豁免於專利侵權,此結果將會嚴重破壞長久以來建立之原則。

三、販賣專利產品之主要組成元件亦構成 專利權耗盡

Quanta指出Intel售與之微處理器和晶片雖 未實施LG之專利內容和功效,且須與記憶體 (memory)、匯流排(buses)等其他零組件 組裝後才會完全實現LG專利內容,但其援引 United States v. Univis Lens Co.(1942)判例, 認為若該微處理器和晶片已具備專利主要功 能,仍應適用耗盡原則。前開主張為聯邦最高 法院所採納,認為本件滿足下列條件,故會引 發專利權耗盡之效果,即:

- 1. 販賣之零組件其唯一合理之用途將無可 避免會實現專利權內容;
- 2. 該零組件蘊含專利權核心發明內容之主 要特徵。

專利權人授權或販賣之物若其唯一用途僅在於實現專利內容,則就該授權或販賣行為已構成專利權人對於專利獨占權之放棄。本件LG已預期Intel的微處理器和晶片除了組裝入電腦系統外,別無其他合理用途,亦無法單獨作用,Intel售與Quanta該等物件自然是允許將之

組裝入電腦而實施專利內容。此外,Intel生產 之微處理器和晶片雖未完全實現LG專利內容, 但所剩之步驟只在於一個普通製程或與其他 標準元件結合,LG的3項專利核心發明內容均 已彰顯於Intel生產之微處理器和晶片內,縱然 Intel產品未與記憶體、匯流排連結時尚無法完 成LG專利功效,但記憶體和匯流排均為系統內 標準零組件,Quanta無庸另行創新技術來組裝 這些零件,事實上Quanta也只能遵循Intel指示 之方法將Intel生產之微處理器和晶片安裝入電 腦系統,除此之外別無他法,因為Intel微處理 器和晶片之內部結構均為營業秘密,Quanta無 從得知,可見Intel於設計製造微處理器和晶片 時,已幾乎完全實現了LG專利內容,僅欠缺與 標準零件相結合而已。故聯邦最高法院認為當 LG授權Intel製造微處理器和晶片時,即應認已 該當專利權耗盡之要件。

四、授權契約約定內容並未限制專利權耗 盡原則

LG爭執其與Intel之授權契約中,並未允許 第三人將Intel產品與非Intel產品結合實施其專 利技術內容,專利權耗盡僅會因專利權人販賣 或授權販賣而觸發,本件尚不符合業經專利權 人授權販賣之要件,且其援引General Talking Pictures Corp. v. Western Elec. Co. (1938)判 例,該判例中製造商販賣含有專利技術之擴音 器供商業使用,然而當初授權契約中明文限制 專利產品僅能販售供私人消費者使用,當時聯 邦最高法院判定應不適用專利權耗盡,因為製 造商並未取得販售供商業使用之授權——LG主 張相同準則亦可適用於本件:Intel與Quanta雙 方明知LG未曾授權Intel販賣其製造之零組件 供第三人與非Intel相結合而實現專利內容此一 用途。

聯邦最高法院認為,授權契約中並未限制 Intel販賣微處理器和晶片給欲將之與非Intel零件結合之買受人,其授權範圍極為廣泛。雖然 LG確實要求Intel通知其客戶,但法院認為LG亦 同意違反約定於Master Agreement的通知義務條款不等同於違反授權契約,從而,Intel被授權販賣該產品便不以履行通知義務以及Quanta遵守該指示內容為條件。此外,聯邦最高法院認為此問題和是否取得默示授權並無關係,因為Quanta合法實行專利內容是植基於專利權耗盡原則而非默示授權原則,耗盡原則則因Intel被授權販賣帶有LG專利之產品而啟動。

五、小結

聯邦最高法院認為,授權販賣「本質上」 帶有專利之產品亦會耗盡專利權。LG授權Intel 實施LG專利技術內容並販售該專利產品,Intel 之微處理器和晶片「本質上」帶有LG專利內 容,因其未有其他合理非侵權使用用途,且包 含了LG專利近乎所有的發明內涵,授權契約中 復未限制Intel販售帶有LG專利技術之產品。因 此,Intel被授權販賣專利產品之行為已使該產 品排除於專利獨占權之外,LG無法再以其專利 權對抗Quanta。

肆、本件聯邦最高法院判決評析

本件判決被科技業視為專利權的指標性判決,判決結果澄清專利權耗盡之定義與範疇。產品中使用多種元件的硬體大廠,如:惠普(HP)、捷威(Gateway)、戴爾(Dell)、諾基亞(Nokia),於本件繫屬後紛紛向聯邦最高法院遞狀聲援Quanta,因判決結果將會波及所有電腦、手機等大量需求零組件組裝特色之產業生態結構,重新架構產業界往後對專利權範圍的詮釋以及專利授權和契約設計協商方式。此對未來專利權人之權利金主張規劃,以及供應鍊中品牌業者、代工組莊業者尋求合法零件來源和應用產品時,對自身權利義務將有較明確之規範可循。

針對此具有重要性意義之判決,可分別從 法律面和策略面加以評釋分析:法律面將以判 決中3個主要爭點為出發點進行剖析;策略面則 將探討在本件判決結果下,對專利權人、代工 組裝業者未來之行為模式將產生何等影響。

一、法律面

- 1. 專利權耗盡理論適用於方法專利;
- 2. 販賣專利產品之主要組成元件亦構成專 利權耗盡;
- 3. 契約條件與專利權耗盡之關係?——本件最具關鍵性之後續爭點,應為「授權契約中對於授權範圍之限制性約定將如何影響專利權耗盡適用」。聯邦巡迴上訴法院認為,因LG與Intel的授權範圍已明文排除第三人將Intel產品與非Intel產品組合之行為,則專利權耗盡原則便不適用。聯邦最高法院推翻上述判決內容,理由在於:認為授權契約中,並未對於Intel販賣微處理器和晶片給欲將之與非Intel零件組合之買受人的權利做出限制,故仍有耗盡原則之適用。

本件判決是否對於契約條件與專利權耗盡 之關連性做出突破性之解釋?——Not yet!

1. 得否以契約約定直接排除耗盡原則之 適用?

美國法下,耗盡原則究係強行規定抑或任 意規定?本件判決理由中揭示,雙方於授權契 約中均同意並非以任何方式限制或更改專利權 耗盡之效果,因此聯邦最高法院未有機會探討 到此層次的問題。

專利權耗盡在於賦予專利權人權利上限制,該法律上利益乃歸屬於供應鍊上之合法採購者,下游採購商若自專利權人或經其授權者採購專利產品,即可正當合理信賴得免於該專利權人之侵權追訴,倘若認為專利權人可於授權契約中對下游採購者仍保留專利追訴權,形同以契約限制第三人法律上權利,將會導致採購者每每於採購時尚須回溯探究上游供應商和專利權人之授權契約是否帶有專利權耗盡之限制,徒增交易成本,更何況契約內容多屬機密性質而不會揭露於客戶面前。反觀專利權人地位,其於授權時即可獲取一定合理之報酬,縱

認為專利權人應有分隔權利金(Split-Royalty) 之權能,即可將供應鍊分割成不同層次,將權 利金收取對象為階段性分割,以減少單一階段 廠商的權利金負擔,然而專利權人大可使用不 控訴 契約類型達成此目的,無須改變長久以來 之授權理論。綜上,專利權耗盡帶有促進交易 自由流通、避免專利權人藉此分割市場等公益 目的,為合理平衡專利權人與下游採購商以及 整體交易競爭秩序之權益,本人認為專利權耗 盡不應允許專利權人於授權契約中進行排除。

2. 條件授權得否影響耗盡原則之適用?

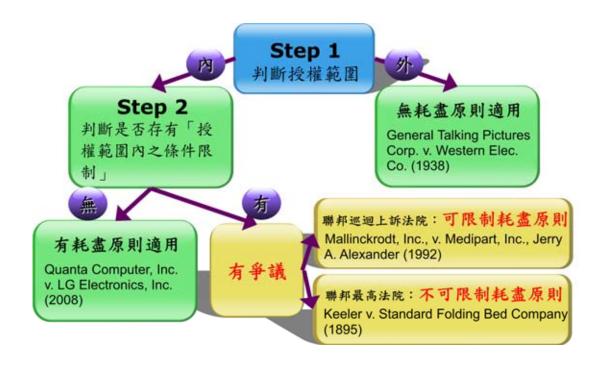
基於契約自由原則,專利權人自得對於授 權進行一定限制,例如:針對授權產品,被授 權人僅得售與特定對象、僅得進行非商業利用 行為等。本件LG即嘗試對於授權進行限制:不 得使第三人將Intel產品與非Intel產品結合,形 同課予被授權人Intel一定之契約監督義務。究 竟授權契約之條件限制是否會對耗盡原則產生 一定之影響?

事實上,本件處理範圍僅圍繞在探討「授 權範圍」之範疇:首先,在授權條款下,LG採 用極為廣泛的授權文字,即「允許Intel直接及 間接製造、使用、販賣、為販賣之要約、進口 或以其他以其產品實行LG專利之處置行為」; 其次,再以但書之方式表明「排除任何第三人 將授權製造之產品與Intel以外製造商的零組件 結合,以及該結合物之使用、販賣、為販賣之 要約、進口行為」;最後,於Master Agreement 中,課以Intel「告知客戶授權效力並不及於 客戶將Intel產品與非Intel產品相結合行為之義 務,但違反此契約義務並不構成影響或終止授 權契約之事由」。聯邦最高法院即綜合這些契

約條款文字,於判決理由中不斷地探求當事人 真意:究竟第三人將Intel產品與非Intel產品相 結合之行為,是否在授權範圍之內?最後聯邦 最高法院得出肯定之結論,認為既然有無履行 告知義務均不影響授權契約效力,雙方應無意 將其視為授權後之條件限制,即認為該授權契 約並非條件授權,Intel乃獲得了LG完整的授 權,而有耗盡原則之適用。

因此,契約內條件限制是否會對耗盡原則 產生一定影響?此問題應區分二階段進行處 理:首先判斷「授權範圍」,若屬授權範圍之 外,即無耗盡原則之適用;若屬授權範圍之 內,再判斷該契約是否存在有「授權範圍內 之條件限制」,惟該條件限制得否限制耗盡原 則,則屬本件判決未處理到之層次。

關於第二層次「授權範圍內之條件限制」 得否限制耗盡原則,聯邦巡迴上訴法院過去曾 有判決肯認附條件之銷售可排除專利耗盡之適 用, 見Mallinckrodt, Inc., v. Medipart, Inc., Jerry A. Alexander (1992);然而,聯邦最高法院 過往判決指出,若專利權人或被授權人有意透 過契約方式來限制專利產品購買者購買後的 使用行為,其效力應是來自於契約法理,而非 來自其專利權利,見Keeler v. Standard Folding Bed Company(1895);於此脈絡下,專利權 耗盡不會因為專利權人在販售時設下條件而有 影響,即使該條件具有契約拘束力,也不會致 使專利權人有權基於專利權來限制專利產品合 法購買者的使用行為,聯邦巡迴上訴法院前例 見解乃是模糊了契約法與專利法兩者間應有之 分際。



二、策略面

- 1. 專利權人可能之授權策略調整:
- A. 設法將條件限制明訂於授權範圍之外;
- B. 明訂為授權範圍內之條件授權;
- C. 慎選供應鍊上授權對象;
- D. 引為高權利金談判籌碼;
- E. 採用不控訴契約(covenant not to sue) 類型。

- 2. 臺灣代工廠商之因應策略:
- A. 授權範圍與專利權耗盡範圍脫勾處理之 思維;
- B. 請求上游供應商予以訴訟上協助;
- C. 契約中明訂擔保補償條款;
- D. 代工客戶自行採購組裝元件;
- E. 確實履行Due Diligence;
- F. 專利侵權責任保險;
- G. 與其他潛在侵權被告進行聯盟。