

Taiwan Intellectual Property Quarterly News

2010年春季台灣智慧產權通訊

Note from the Managing Editor

As economic signs point to a recovery from the severe global downturn, many companies are positioning themselves for growth in 2010. Taiwanese companies that protect and assert their intellectual property in Taiwan and abroad stand to benefit as they market their products globally. We hope the information in this issue will help keep you informed as you guide your own company's business and legal strategies.

In this issue we discuss several legal developments of interest, including the success of companies seeking to transfer cases out of the Eastern District of Texas – and the challenges that remain. We also discuss cases related to patent pooling and licensing considerations when a subsidiary is involved.

We are happy to report on recent victories on behalf of our clients, and rankings listing the firm as among the most active and well-respected in a number of intellectual property categories. In other exciting news, our firm has launched its first mobile application for iPhone.

Best wishes,

Alexander J. Hadjis, Morrison & Foerster LLP

編者按

經濟信號顯示急劇的全球經濟衰退已經開始復蘇，許多公司定位其業績在2010年將實現增長。隨著其在全球範圍內推廣產品，在台灣和海外地區保護和維護其智慧財產的台灣公司將會一如既往地通過智慧財產獲利。我們希望本發佈中的資訊在您指導公司業務和法律戰略時為您提供及時的資訊。

在本發佈中，我們討論了幾個備受關注的法律問題及其發展情況，包括尋求將案件移出德州東區法院的公司取得的成功經驗—以及依舊存在的問題。我們還討論了涉及子公司時與專利池和許可因素有關的案件。

我們十分高興的通報最近美富代表客戶取得的勝利，以及本所被評為多個智慧財產法類別中最活躍以及最受尊崇的律所之一。其他令人興奮的消息包括本所還推出了首個適用於iPhone的移動應用程式。

順致商祺！

美富律師事務所合夥人韓明山 (Alexander J. Hadjis)

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Imation v. Philips: Federal Circuit Holds That Patent License Extends to Subsidiaries Acquired After Expiration of License Agreement

By Rufus Pichler

The Federal Circuit held in *Imation Corp. v. Koninklijke Philips Electronics N.V.*¹ that Imation's rights under a cross-license agreement with Philips extend to two subsidiaries that Imation acquired *after* the termination of the agreement. The decision is a reminder of how important it is that license agreements be drafted clearly, carefully, and consistently to avoid unintended consequences of economic significance for the parties.

Factual Background

In 1995 Philips and Minnesota Mining and Manufacturing Company (known as "3M") entered into a patent cross-license agreement ("CLA") covering, among other technology, optical disks and drives. It was undisputed that Imation, a spin-off from 3M, succeeded in 3M's rights and obligations under the CLA. The CLA, by its terms, expired on March 1, 2000, but also provided that "any patent license which *has been granted* under [the license provision]" (emphasis added) was to continue, as to each licensed patent, for the life of such patent. In 2003, after expiration of the agreement term, Imation formed a joint venture with Moser Baer India Limited ("Moser Baer") which was called Global Data Media FZ-LLC ("GDM"). Imation owns 51% of GDM and Moser Baer owns 49%. In 2006 Imation also acquired Memorex International, Inc. ("Memorex").

Under the relevant provision of the CLA, Philips "agrees to grant and does hereby grant to [Imation] and its Subsidiaries a personal, non-exclusive, indivisible, nontransferable, irrevocable, worldwide, royalty-free license under Philips Licensed Patents to make, have made,

make for others, use, lease, distribute, offer to sell, sell, import, or otherwise dispose of Licensed Products." A "Subsidiary" is defined as any "corporation ... or other form of business organization as to which the party *now or hereafter* has more than a fifty percent (50%) ownership interest" (emphasis added).

Both GDM and Memorex commercialize optical storage disk products that are covered by Philips's patents. In 2007, Imation filed a declaratory judgment action seek-

THE ISSUE BEFORE THE DISTRICT COURT WAS WHETHER GDM AND MEMOREX HAVE VALID LICENSES TO PHILIPS'S PATENTS UNDER THE CLA IN LIGHT OF THE FACT THAT THEY BECAME IMATION SUBSIDIARIES ONLY AFTER THE EXPIRATION OF THE CLA.

ing, among other things, a declaration that GDM and Memorex are licensed under the CLA as "Subsidiaries" of Imation. To fully understand the background, it is important to note that Moser Baer supplies optical disks to GDM. While Moser Baer has its own royalty-bearing license agreement with Philips, Moser Baer, Imation, and GDM took the position that no royalties are owed to Philips under that agreement because GDM may exercise royalty-free "have made rights" under the CLA with respect to products supplied to it by Moser Baer.

The District Court's Decision

The issue before the district court was whether GDM and Memorex have valid licenses to Philips's patents under the CLA in light of the fact that they became Imation subsidiaries only *after* the expiration of the CLA. The district court held for Philips. In interpreting the CLA it found that, pursuant to the termination provision, only licenses that "had been granted" survive the expiration of the agreement on March 1, 2000. Because GDM and Memorex were not Imation subsidiaries until 2003 and 2006, respectively, no licenses could "have been granted" to them as of March 2000. Moreover, the court held that GDM and Memorex were not "Subsidiaries" as defined in the CLA because the language "now or hereafter" in the definition of "Subsidiaries" must be read as referring only to the time period up until the expiration of the agreement.

The Federal Circuit's Decision

The Federal Circuit disagreed and reversed. Applying New York law, the Court rejected the interpretation of the CLA by the district court. The Court concluded that the language in the license grant, wherein Philips "agrees to grant and does hereby grant to [Imation] and its Subsidiaries," constitutes a *present* license grant to a class comprised of Imation and each "Subsidiary," which class may shrink or grow over time as entities become or cease to be "Subsidiaries." Under this "group license" construction, as opposed to the district court's finding of a grant of multiple licenses over time, a single license "had been granted" and vested as of the effective date of the CLA even with respect to future "Subsidiaries."

怡敏信訴飛利浦 (*Imation v. Philips*)：美國聯邦巡迴法院判定，專利許可協議應延伸至在該協議到期後才被收購的子公司

作者：Rufus Pichler

在怡敏信訴飛利浦 (*Imation v. Philips*)¹案中，美國聯邦巡迴法院判定，怡敏信 (“Imation”) 的兩家子公司可以享有怡敏信與飛利浦 (“Philips”) 簽署的交叉許可協議下的權利，雖然怡敏信是在該協議到期後才收購了這兩家子公司。該判決提醒有關公司把許可協議寫得清晰，嚴謹，及連貫一致的重要性。只有這樣才能避免不勘的後果。

事實背景

1995年，飛利浦與明尼蘇達礦業及製造公司 (“3M”) 簽署了一份關於光碟與光驅等技術的專利交叉許可協定。怡敏信，一個3M的分公司，毫無疑問的繼承了交叉許可協議下的權利及義務。該交叉許可協定於2000年3月1日到期，但該協定也指出，任何已被該協定批准的專利許可將於那些專利到期的時候到期。2003年，在該協定到期後，怡敏信與Moser Baer India Limited (“Moser Baer”) 成立了一家合營公司，Global Data Media FZ-LLC (“GDM”)。怡敏信佔GDM的51%，而Moser Baer佔GDM的49%。2006年，怡敏信又收購了另一家公司，Memorex International, Inc. (“Memorex”)。

據該交叉許可協定，飛利浦“同意授予且特此授予[怡敏信]及其子公司一個非獨佔性、不可分割、全球免專利使用費的許可，以便其製造、已製造，為他人製造、使用、出租、分銷、提供銷售、銷售、進口或另行處置被許可產品。”

“子公司”被定義為任何“目前或今後被當事人(怡敏信)佔有百分之五十(50%)以上股權的公司……或其他形式的商業組織。”

GDM與Memorex均盈利被飛利浦的專利涵蓋的光存儲磁片產品。2007年，怡敏信提起宣告性判決訴訟，尋求法院宣告，GDM與Memorex為據交叉許可協定被授予免專利使用費許可的“子公司”。為充分瞭解有關背景，讀者須知Moser Baer供應光碟給GDM。雖然Moser Baer與飛利浦已簽署了另一個須付專利使用費的許可協議，但Moser Baer、怡敏信及GDM認為GDM不須據那須付專利使用費的許可協議而付飛利浦專利使用費，因為Moser Baer供應給GDM的光碟產品是“已製造”的被許可產品，所以GDM可享受那交叉許可協定的免專利使用費的權利。

美國地區法院的判決

對於美國地區法院，關鍵問題為GDM與Memorex是否享有那交叉許可協定的免付飛利浦專利使用費的權利，雖然GDM與

Memorex是在該交叉許可協議到期之後才成為怡敏信的子公司。對此，美國地區法院判定飛利浦得勝。在解釋那交叉許可協定時，美國地區法院判定只有已被該協定批准的專利許可才不會在該協定於2000年3月1日到期的時候到期。由於GDM與Memorex是在2003年及2006年才成為怡敏信的子公司，因此GDM與Memorex不可能有任何在2000年3月前已被批准的許可。而且，法院判定GDM與Memorex並非交叉許可協議中定義的“子公司”，因為“子公司”定義中的“目前或今後”必須被理解為僅指在那協議到期之前。

美國聯邦巡迴法院的判決

美國聯邦巡迴法院不同意地區法院的判決並因此推翻。巡迴法院判決，根據紐約州法律，地區法院對那交叉許可協定的解釋是錯誤的。巡迴法院裁定，那交叉許可協定的文字(其中包括飛利浦“同意授予且特此授予[怡敏信]及其子公司…免專利使用費的許可”)構成了一個授予[怡敏信]及每“子公司”的當前許可，該“子公司”組可增可減。根據巡迴法院的解釋，當交叉許可協議生效時，該協議已當前批准且授予“子公司”，包括未來的“子公司”，單一個許可。這個解釋與地區法院的“多個許可”的解釋是相反的。

Imation v. Philips

(Continued from Page 2)

Secondly, the Federal Circuit found that GDM and Memorex met the definition of “Subsidiaries” under the CLA. It refused to follow the district court’s reading that the term “hereafter,” without any express temporal limitation, is implicitly limited to the period of time up until the expiration of the CLA. The Federal Circuit reasoned that if the parties had intended to limit the group of “Subsidiaries” to those in existence at a certain time, they could have said so. Instead, the plain language of the relevant provision contains no such explicit temporal limitation, and the Court stated that it is “extremely reluctant to interpret an agreement as impliedly stating something which the parties have neglected to specifically include.” As additional support for its interpretation, the Court pointed to the agreement’s definition of “Licensed Patents,” which does contain an explicit temporal limitation (*i.e.*, patents now or hereafter owned *and* having a filing date prior to the expiration date). “Where one provision of an agreement contains a particular reference,” said the Court, “the omission of this reference from any similar provision must be assumed to have been intentional.”

As an aside, because “a proper interpretation of a contract generally assumes consistent usage of terms throughout the Agreement,” it follows from the Court’s interpretation of “hereafter” in the “Subsidiary” definition, that the “Licensed Patent” definition² also covers patents acquired by a party after the expiration date of the CLA (as long as such patents meet the separate requirement of a filing date prior to the expiration date). Similarly, Philips would be licensed under any patents of GDM and Memorex, as

“Subsidiaries” of Imation, which meet the filing date requirement.

Conclusion and Lessons

The ruling obviously has a significant economic effect on Philips which is not only prevented from recovering royalties from GDM and Memorex, but may also lose royalties from Moser Baer to the extent Moser Baer is now covered by GDM’s have made right and therefore does not need to rely on its own royalty-bearing license from Philips.

The decision highlights the significance of fundamental contract interpretation rules that should be remembered when drafting agreements, including the following which the Federal Circuit expressly relied on in reaching its conclusion:

- A contract will be construed so as to give full effect to its provisions and not render any portion meaningless.
- A contract will be read as a whole and be interpreted as to give effect to its general purpose.
- Courts are reluctant to interpret a contract as impliedly stating something which the parties did not specifically state.
- Where a provision of an agreement contains a particular reference, the absence of this reference from a similar provision will be assumed to have been intentional.
- Courts will not adopt an interpretation that renders language in the agreement superfluous.
- Courts will generally assume consistent usage of terms throughout an agreement.

Finally, the decision highlights the importance of clear, careful, and consistent drafting and the need to identify and address potential future problem areas. Specifically, the possibility of future acquisitions and other corporate transactions presents a variety of complex issues that

should be addressed in license agreements. These issues include, for example:

- Whether future subsidiaries will be licensed and how they are defined;
- Whether product lines acquired by the licensee through acquisition of a subsidiary or otherwise will be licensed;
- Whether there will be volume or “organic growth” restrictions with respect to the licensee’s products so that volume increases due to an acquisition will not automatically be covered by the license;
- Whether patents of acquired or acquiring entities will be encumbered by the license granted;
- Whether licenses can be transferred or extended in connection with the divestiture of product lines, assets, business units, or entities;
- Whether licenses survive an acquisition of the licensee, and, if so, whether there will be restrictions with respect to the licensed products (such as a limitation to pre-acquisition product lines or models); and
- The effects of an acquisition of an entity that is separately licensed (*e.g.*, under different terms that are more favorable to the licensor). ■

1 586 F.3d 980 (Fed. Cir. 2009).

2 The definition of “Licensed Patents” covers patents which “(1) are owned or controlled by the granting party or any of its Subsidiaries such that such party or its Subsidiaries now has or hereafter obtains the right to grant the licenses within the scope of this Agreement; (2) related to optical or magneto-optical storage and retrieval technology; and (3) have a filing date ... on or before the expiration date of this Agreement [*i.e.*, March 1, 2000].”

怡敏信訴飛利浦 (*Imation v. Philips*)

(Continued from Page 3)

其次，聯邦巡迴法院判定GDM及Memorex滿足交叉許可協議項下的“子公司”定義。聯邦巡迴法院拒絕遵循地區法院，在沒有任何明確的時間限制的情況下，將詞語“今後”含糊地解釋為限於交叉許可協議到期之前的時間。聯邦巡迴法院推斷，如當事人當時已有意將“子公司”集團限定為在某個時間存在的子公司，則其當時會做出相應規定。但相關條款並沒有明確包括這等明晰的時間限制。巡迴法院表示它們因此“尤其反對將那協議解釋為暗示規定了未被當事人明確納入的條款。”作為對比，法院指出該協議“被許可專利”的定義包含了明確的時間限制（即，目前或今後擁有的專利和任何在該協議到期前被申請的專利）。法院表示，“如某協議中一條款包含了某個具體援引，而另相似條款遺漏了相似具體援引，此遺漏必視為有意為之。”

另外，由於“合同中同類的措辭應被解釋為有同類的意義”，法院對“子公司”定義中“今後”詞語的解釋肯定“被許可專利”的定義²應被解釋為有涵蓋在交叉許可協議到期後才取得的專利（只要該專利是在該協議到期前申請的）。同意，飛利浦應為怡敏信的“子公司，”且擁有GDM與Memorex在該協議到期前申請的專利。

結論重點

這個判決顯然帶給飛利浦極壞的經濟後果。飛利浦不僅不能收GDM和Memorex專利使用費，而且，因為Moser Baer可利用GDM的“已製造”權且無須依賴與飛利浦簽的須付專利使用費的許可協議，飛利浦可能會失去Moser Baer的專利使用費。

這個判決強調了在起草協議與合同時應牢記的基本解釋原則和重要性，包括聯邦法院在作出判決時明確依據的下述原則：

- 合同的解釋應以使其條款產生全效為目的，而不得導致任何條款沒有意義。
- 合同應從整體上理解且被解釋為實現其目的。
- 法院拒絕將合同解釋為暗含當事人並未特別規定的事項。
- 如協議某項條款包含有某具體援引，則相似條款中缺失該等援引，法院將視此為有意如此為之。
- 法院不會採用導致協議規定沒必要存在的解釋。
- 法院通常採用協議中連貫一致的用詞。

最後，這個判決強調了把協議與合同寫得清晰，嚴謹，及連貫一致的重要性。這個判決也強調了檢測和解決未來可能存在的問題的必要性。具體而言，今後的企業收購與交易可能呈現了各種在許可協議中應該解決的複雜問題。舉例而言，這些問題包括：

- 未來子公司是否將獲得許可；如何定義子公司；
- 被許可人通過收購子公司或其他方式而收購的產品線是否將獲得許可；
- 是否限制許可人的產品的數量或“天然增長”；是否不包括所有因許可人收購而造成的數量增長；
- 授予許可的權利和負擔是否添加於被收購公司的專利；
- 許可是否能因產品線、資產、業務部門或公司的剝離予以轉讓或延伸；
- 許可是否會在被許可人被收購後繼續有效，且如果繼續有效，被許可產品是否會被限制（如，對預收購產品線或模型的限制）；以及
- 已被許可公司被另收購的問題（如，被收購條款給已被許可公司更多利處）。 ■

1 586 F.3d 980 (Fed. Cir. 2009).

2 定義“被許可專利”涵蓋了以下專利：（1）授予方或其任何子公司當前擁有或控制的專利，從而使該方或其子公司當前擁有或今後取得在本協議範圍內授予許可的權利；（2）與光或者磁光存儲及檢索技術有關的專利；以及（3）其申請日在本協議到期日[即2000年3月1日]當天或之前。

Recent Federal Circuit Venue Decisions Continue to Reveal Transfer Options For Companies Sued In The Eastern District of Texas

By Jason A. Crotty, Rudy Y. Kim, and J. Manena Bishop

In re Hoffman-La Roche Inc. and *In re Nintendo Co., Ltd.* are the latest in a series of Federal Circuit decisions that have shifted the legal landscape regarding patent venue – turning the tide in favor of defendants seeking to transfer cases out of the Eastern District of Texas.¹ These cases may be helpful to Taiwanese companies and other defendants who do not have any specific ties to the district.

The Eastern District of Texas (“EDTx”) has developed a reputation for being a plaintiff-friendly forum. Until recently, motions to transfer were often denied and many defendants were forced to litigate in EDTx, even if they had little or no connection to the venue.

The Fifth Circuit’s *en banc* decision in *Volkswagen* started a significant change in Eastern District of Texas transfer law. *In re Volkswagen of America, Inc.*, 545 F.3d 304 (5th Cir. 2008) (*en banc*). In *Volkswagen*, the plaintiff filed an auto injury related suit in the Eastern District of Texas even though virtually all of the witnesses, documents, and physical evidence were located in the Northern District of Texas. *Id.* at 316-18. The district court denied transfer, discounting the physical location of evidence in view of the fact that modern technology has made it easier to transport certain types of discovery. The appellate court, however, concluded that the district court failed to properly consider the actual location of evidence, the availability of the compulsory process, and the local venue’s interest in deciding the case “at home.” *Id.* at 317-18. The Fifth Circuit, therefore, granted Volkswagen’s petition

for a writ of mandamus and ordered the case transferred to the Northern District of Texas. *Id.* at 319.

Shortly thereafter, in *TS Tech*, a defendant in a patent infringement suit filed a similar petition for a writ of mandamus in the Federal Circuit. *In re TS Tech USA Corp.*, 551 F.3d 1315, 1318 (Fed. Cir. 2008). Following Fifth Circuit law, the Federal Circuit held that the district court abused its discretion by: (1) giving too much weight to plaintiff’s choice of venue; (2) ignoring Fifth Circuit precedent requiring an assessment of costs for attendance of witnesses; (3) marginalizing the factor concerning the relative ease of access to sources of proof; and (4) disregarding Fifth Circuit law in analyzing the public interest in having localized decisions decided “at home.” *Id.* at 1320-21. Accordingly, the Federal Circuit granted TS Tech’s writ and ordered the district court to transfer the case. *Id.* at 1322-23.

Initial district court rulings following *Volkswagen* and *TS Tech* suggested that more cases would be transferred from the Eastern District of Texas, particularly when the physical evidence and witnesses were centralized at or near an alternate forum that was “clearly more convenient.” *Id.* at 1319. Some district court decisions, however, distinguished these “centralized” cases from “decentralized” cases involving multiple defendants (*i.e.*, cases in which the evidence, witnesses, and parties were located throughout the U.S. and outside the U.S.).

For example, in *Genentech*, Novartis, a German company, filed suit in the Eastern District of Texas against Genentech (located in the Northern District of California) and Biogen (located in the Southern Dis-

trict of California). *Genentech*, 566 F.3d at 1340-41. The witnesses and evidence were located in multiple geographic regions, and none were located in Texas. *Id.* The district court denied transfer on the grounds that the Eastern District of Texas was a central location that was as good a location as any other venue. *Id.* at 1342.

The Federal Circuit, however, rejected this “central location rationale” and concluded that the district court failed to properly apply Fifth Circuit law. *Id.* at 1342-49. Among other things, in ruling that Texas is a central location, the district court failed to consider the fact that none of the identified witnesses lived in Texas and the majority of witnesses lived in California. *Id.* at 1344-45.

The district court also placed too much emphasis on the fact that Texas was closer to the witnesses in Europe, given that those witnesses would be “required to travel a significant distance no matter where they testify.” *Id.* Therefore, the slight additional time that European witnesses would have to travel was far outweighed by the significant inconvenience that two California parties and multiple California-based witnesses would have had to face if required to travel to Texas. *Id.* Likewise, while there would be a “significant and unnecessary burden” imposed on defendants if required to transport relevant materials from California to Texas, it would be only “slightly more inconvenient or costly” to transport materials from Europe to California instead of Texas. *Id.* at 1345-46.

More recently, in *Hoffmann-La Roche*, the Federal Circuit has extended this shift in transfer law. 2009 WL 4281965, at *4. In *Hoffmann-La Roche*, Novartis, a California

聯邦巡迴法院近期判決繼續為在德州東區法院進行訴訟的公司展示了移案選擇權

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聯邦巡迴法院做出了一系列關於專利審訊地的判決，改變了這一方面的法律前景——有利於被告尋求將案件移出德州東區法院¹。霍夫曼·羅氏公司案和任天堂株式會社案是最近判決的兩起案件。這些案件可能對台灣公司以及與德州東區法院不存在任何具體聯繫的其他被告有所幫助。

德州東區法院因成為偏向專利案原告而聞名。直到最近，被告的移送申請通常都是被拒絕的，從而被告不得不在德州東區應訴，即使他們與訴訟地之間幾乎沒有聯繫或者根本不存在聯繫。

自從第五巡迴法院對大眾汽車案的全院庭審判決公佈以來，德州東區法院移送法律有了重大改變。（美國大眾汽車公司案，《聯邦案例彙編》第3輯第545卷第304頁（2008年第五巡迴法院）（全院庭審））。在大眾汽車案中，原告在德州東區法院提起了與汽車傷害有關的訴訟，雖然實際上所有的證人、文件和實物證據都位於德州北區法院管轄區。（同上第316-18頁。）東區法院拒絕移案，認為現代技術傳送某些證據非常便宜，可以忽視證據實際所在地因素。但是，上訴法院（第五巡迴法院）認為地區法院未能適當考慮證據的實際所在地、強制法律程式的可用性以及地方利益地方裁決的因素。（同上，第317-18頁。）因而，第五巡迴法院同意了大眾汽車公司請求下發執行令

的申請，責令將案件移送德州北區法院。（同上第319頁。）

此後不久，在台思案中，專利侵權訴訟的被告在聯邦巡迴法院提出了類似的下達執行令的申請。

（美國台思技術公司案，《聯邦案例彙編》第3輯第551卷第1315頁，1318頁（2008年聯邦巡迴法院））。根據第五巡迴法院法律，聯邦巡迴法院裁定地區法院濫用了其裁量權，因為地區法院（1）過多考慮了原告的訴訟地選擇；

（2）忽視了第五巡迴法院要求評估證人出庭成本的判決先例；

（3）對與證據來源取得的相對便宜性之相關因素，沒有給與充分的重視；以及（4）忽視了第五巡迴法院對地方利益地方裁決所涉公共利益進行分析時的相關法律。

（同上，第1320-21頁）因此，聯邦巡迴上述法院向台思授予了執行令並責令地區法院移案。（同上第1322-23頁。）

大眾汽車案和台思案後，地區法院隨後的裁決意味著從德州東區法院移送的案件數量將會增多，尤其是在實物證據和證人均集中或鄰近“明顯更加便利”的候選法庭的情況下。（同上第1319頁。）但是，某些地區法院的裁決將這些“集中型”案件與涉及多個被告的“分散型”案件（例如，證據、證人以及當事人遍及美國及美國之外的地區）進行了區別對待。

例如，在基因技術公司案，一家德國公司，諾華公司在德州東區法院向基因技術公司（位於加州

北區）和Biogen公司（位於加州南區）提起訴訟。（基因技術公司案，《聯邦案例彙編》第3輯第566卷第1340-41頁）。證人和證據位於多個地理區域，而且沒有一個是在德州的。（同上。）地區法院拒絕移案，理由是德州東區法院與任何其他審判地一樣均是較好的中心位置。（同上第1342頁）。

但是，聯邦巡迴法院推翻了這一“中心位置理論依據”並且認定地區法院未能適當的採用第五巡迴法院的法律。（同上，第1342-49頁。）其中，在裁決德州是中心位置時，地區法院未能考慮確定的證人沒有一個是居住在德州的，而多數證人都是居住在加州的這一事實。（同上第1344-45頁。）

地區法院還過度的強調了德州距離歐洲證人更近這一事實，因為那些證人“無論在哪出庭作證都需要很遠的行程。”（同上。）因此，與兩家加州公司和多位於加州的證人趕赴到德州所面臨的不便相比，歐洲證人出行需要多花的那點時間根本不算什麼。（同上。）同樣，雖然將相關資料從加州傳送到德州會對被告造成“重大和不必要的負擔”，但是與將資料從歐洲傳送到德州相比，傳送到加州“所產生的不便性和費用將會更小。”（同上，第1345-46頁。）

最近，在霍夫曼·羅氏公司案中，聯邦巡迴法院擴大了移送法律的轉變。（2009 WL 4281965第4頁）。在霍夫曼·羅氏公司案中，加州的諾華公司（子公

Eastern Texas

(Continued from Page 6)

company, brought suit in the Eastern District of Texas against Hoffmann-La Roche Inc., Roche Laboratories Inc., Roche Colorado Corp., and Trimeris, Inc. *Id.* at *1. The accused product was developed at Trimeris' labs in North Carolina where certain documents were maintained. *Id.* Roche's manufacturing and processing facilities were located in Colorado, Michigan, and Switzerland. *Id.* The company packaged the drug at its New Jersey headquarters and marketed the accused product nationwide. *Id.* Only a handful of 25 potential witnesses lived in North Carolina. *Id.*

Defendants moved to transfer, contending that there were no witnesses or evidence within 100 miles of the Eastern District of Texas. *Id.* Additionally, defendants argued that most of the relevant evidence, a number of Trimeris' employee witnesses, and four non-employee witnesses were located in North Carolina. *Id.* The plaintiff argued that because the case involved multiple parties from across the country, and sources of proof and witnesses were located throughout the United States, transferring the case to North Carolina would merely rearrange the inconveniences. *Id.*

The district court denied the motion to transfer, finding that: (1) four non-party witnesses in North Carolina did not constitute a substantial number of witnesses; (2) Novartis's documents had been transferred to Texas; and (3) the district court had subpoena power over one of the witnesses who lived in Houston. *Id.* at *2. The district court concluded that "the Eastern District of North Carolina had no more of a local interest in deciding this matter than the Eastern District of Texas" because the accused product was offered for sale nationwide. *Id.* at *4. Defendants

petitioned the Federal Circuit for a writ of mandamus. *Id.* at *2.

The Federal Circuit compared the case's connection to the Eastern District of Texas and its connection to the Eastern District of North Carolina and held that there was "a stark contrast in relevance, convenience, and fairness between the two venues." *Id.* The appellate court held that the district court abused its discretion by failing to give proper weight to the meaningful connection that the patent infringement dispute had to North Carolina but did *not* have to the Eastern District of Texas. *Id.* at *4. Accordingly, the Federal Circuit granted the defendants' petition and ordered the case to be transferred to the Eastern District of North Carolina. *Id.* at *4.

An even more recent Federal Circuit decision further confirms this ongoing shift in the law. See *Nintendo*, 2009 WL 4842589, at *4-5. In *Nintendo*, Nintendo sought transfer to the Western District of Washington, where it was incorporated and had its principal place of business. *Id.* at *1. Motiva opposed transfer, arguing that Eastern District of Texas was the proper venue for the decentralized case. *Id.* The Federal Circuit again rejected the "decentralized" argument for maintaining a case in Texas that lacks any connection to the venue and reminded the district court that it had "already questioned this type of reasoning in another case involving the Eastern District of Texas." *Id.* at *4 (citing *Genentech*, 566 F.3d at 1344).

In holding that the district court abused its discretion in denying transfer from a venue "with no meaningful ties to the case," the Federal Circuit concluded that: (1) the district court gave the plaintiff's choice of venue too much deference, (2) the district court failed to give proper weight to the fact that all of the identified key witnesses were in Washington, Japan, Ohio, and New York and no witnesses lived in Texas, (3) the fact that Nintendo's products are

sold nationally did not justify keeping the case in Texas as the "Fifth Circuit has unequivocally rejected the argument that citizens of the venue chosen by the plaintiff have a 'substantial interest' in adjudicating a case locally because some allegedly infringing products found their way into the Texas market," and (4) the district court "glossed over a record without a single relevant factor favoring the plaintiff's chosen venue" and incorrectly "hypothesized that the Eastern District of Texas could serve as a centralized location" despite the fact that neither party had evidence in Texas and the majority of Nintendo's evidence was located in Washington. *Id.* at *3-5.

These recent Federal Circuit decisions indicate that the tide continues to turn in favor of parties seeking to transfer cases out of the Eastern District of Texas. *Genentech* and *Nintendo* indicate that transfer is appropriate in decentralized cases if there are no witnesses in the district where the case is filed and a significant number of witnesses would benefit from a change of venue. *Hoffman-La Roche* and *Nintendo* suggest that district courts evaluate whether the patent dispute's connection to a plaintiff's selected venue is more meaningful than the connection to any one alternative local venue. All of these cases highlight the importance of witness convenience, location of evidence, and a connection between the dispute and the district. Additionally, the fact that a case involves a product that is sold nationwide does not mean that any venue in the country is appropriate. Consequently, even decentralized cases now appear to have a high probability of being transferred if the dispute does not have any meaningful connection to the Eastern District of Texas and an alternate jurisdiction with such a connection exists. ■

1 *In re Hoffmann-La Roche Inc.*, — F.3d —, Misc. No. 911, 2009 WL 4281965 (Fed. Cir. Dec. 2, 2009); *In re Nintendo Co., Ltd.*, — F.3d —, Misc. No. 914, 2009 WL 4842589 (Fed. Cir. Dec. 17, 2009).

德州東區 法院

(Continued from Page 7)

司)在德州東區法院向霍夫曼·羅氏公司、Roche Laboratories Inc.、Roche Colorado Corp.和 Trimeris, Inc.提起訴訟。(同上第1頁。)被指控的產品是在 Trimeris設在北加州的實驗室開發的,那裏也保存著相關的文檔。(同上。)Roche的生產和加工設備位於科羅拉多州、密歇根州和瑞士。(同上)。該公司在其新澤西總部對藥物進行包裝,並在全美行銷被指控的產品。(同上。)僅有較少的25個潛在證人居住在北卡羅來納州。(同上。)

被告提議移送案件,聲稱在德州東區法院100英里以內沒有相關證人或證據。(同上。)此外,被告辯稱大部分有關證據、許多Trimeris的僱員證人及四名非僱員證人均位於北卡羅來納州。(同上。)原告聲稱因為該案的涉案多方來自全國各地,而證據來源及證人分部在全美各地,將案件移送至北卡羅來納州純粹是換湯不換藥,不過是重整了這些不便因素。(同上。)

地區法院駁回了移送申請,做出如下裁決:(1)四名位於北卡羅來納州的非當事方證人並不構成多數證人;(2)諾華的文件已被移送至德州;且(3)地區法院對居住在休斯頓的一名證人享有傳喚權。(同上,第2頁)地區法院裁定

“就判決本案而言,北卡羅來納州東區法院與德州東區法院的地方利益沒有差異”,理由是被告產品系在全國範圍內均有銷售。(同上,第4頁)被告請求聯邦巡迴法院下

發執行令。(同上,第2頁)

聯邦巡迴法院將該案與德州東區法院及北卡羅來納州東區法院的關聯進行了比較並認定“這兩個審判地點在相關性、便利性及公平性上存在鮮明對比。”(同上。)上訴法院認為德州東區法院濫用了其裁量權,因為該專利侵權訴訟與北卡羅來納州東區法院存在有意義的關聯,而與德州東區法院不存在該等關聯,但德州東區法院對這一點未能給予適當重視。(同上,第4頁。)因此,聯邦巡迴法院同意了被告的申請,並責令將案件移送北卡羅來納州東區法院。(同上,第4頁。)

聯邦巡迴法院最近所做判決進一步證明上述轉移的合法性。(參見任天堂案,2009 WL 4842589第4-5頁。)在任天堂案中,任天堂尋求將案件移送至其成立所在地及業務主營地華盛頓西區法院。(同上,第1頁)Motiva反對移送,辯稱德州東區法院是分散型案件的適當審訊地。(同上。)聯邦巡迴法院再次拒絕以“地域分散”為由將案件繼續留在德州審訊,認為這一理由與審訊地沒有任何關聯,並提醒地區法院其已經“在德州東區法院的另一樁案件中對這類推理提出過質疑。”(同上,第4頁。)(摘自基因技術公司案,《聯邦案例彙編》第3輯第566卷第1344頁)

聯邦巡迴法院認為區法院拒絕將案件從“與案件沒有有意義聯繫的審判地移出”濫用了其裁量權,違反了第五上訴法院的判例。聯邦法院判定:(1)地區法院過於順從原告的審訊地選擇,(2)地區法院未能正確的重視“本案中所有已確定的關鍵證人均居住在華盛頓州、日本、俄亥俄州及紐約”以及“沒

有證人居住在德州”這一事實,

(3)任天堂的產品在全國範圍內銷售的事實不能證明將案件在德州審訊係正當的,因為“第五巡迴法院已明確駁回了以下主張,即以某些據稱造成侵權的產品在德州市場進行銷售為由,從而認為原告所選審訊地的居民會對裁定該案件有“重大利益”。”以及(4)地區法院“掩蓋了沒有任何有關因素有利於原告所選審訊地的記錄”並錯誤地“假定德州東區法院可作為中心地區被選為審訊地”,無視任何一方在德州均沒有證據,而任天堂的大部分證據來自華盛頓州這一事實。(同上,第3-5頁。)

聯邦巡迴法院最近所做的判決表明未來的趨勢將有利於尋求將案件轉出德州東區法院的當事人。基因技術公司與任天堂案表明如果沒有證人居住在提交案件所在地以及更改審訊地對大多數證人更便利,案件移送適合於該等分散型案件。霍夫曼·羅氏公司與任天堂案表明地區法院評估專利爭議與原告所選審訊地的關聯是否比與任何其他備選審訊地的關聯更有影響力。所有這些案件均強調了證人便利性、證據所在地及爭議與地區的關聯的重要性。此外,案件涉及在全國範圍出售的產品不再意味著國內任何地區均為合適的審訊地。因此,目前即使分散型案件被准予移送的可能性也顯得有所提高,只要爭議並未與德州東區法院有著任何有意義的關聯且另外存在一個與爭議有著重要關聯的管轄地。■

1 霍夫曼·羅氏公司案-《聯邦案例彙編》第3輯-Misc. No. 911, 2009 WL 4281965 (2009年12月2日聯邦巡迴法院);任天堂株式會社案-《聯邦案例彙編》第3輯-Misc. No. 914, 2009 WL 4842589 (2009年12月17日聯邦巡迴法院)。

Can a Company Refuse to License a Pooled Patent Outside of the Pool?

By Cynthia Lopez Beverage

Any company involved in patent licensing or litigation that concerns technology subject to patent rights “pooled” among multiple companies (such as when competitors have jointly-developed industry standards patent pools) should pay close attention to an *en banc* hearing that will take place in *Princo Corporation v. International Trade Commission* in 2010.¹ At present, the parties, the NYIPLA, and the AIPLA are preparing briefs on the patent misuse issues that the Federal Circuit specifically identified in its October 13, 2009 order granting *en banc* review.² In this case, the Federal Circuit may decide whether it is patent misuse for patent owners, who create a patent pool for technology that is also subject to other companies’ patents, to agree among themselves *not* to license a pooled patent for a potentially competing technology outside of the pool.³

Background

The root of the patent misuse issues in *Princo* started in the late 1980s and early 1990s, when U.S. Philips Corporation and Sony Corporation jointly developed the technical industry standards (called the “Orange Book”) for the production of CD-R and CD-RW discs. Philips developed and patented an analog method for encoding position data on a blank disk to determine position (“Raaymakers patent”). Sony developed and patented a digital method for doing the same (“Lagadec patent”). Philips and Sony, nevertheless, chose to define the Orange Book standard using only Philips’s analog approach. However, when Philips and Sony and two other companies agreed to pool their patents that covered the Orange Book standard, they also included Sony’s Lagadec patent in the patent pool’s joint license, even though this patent did not cover the chosen analog approach

described in the Orange Book.

Princo Corporation and Princo American Corporation originally took a license to the Orange Book pooled patents but they quickly stopped paying royalties, insisting they should not have to pay royalties for a variety of reasons, including patent misuse on the part of Philips. Though Princo did not dispute that its products were covered by the patent pool, it asserted that Philips’s and Sony’s agreement not to license the Lagadec patent outside the patent pool was patent misuse because that agreement prevented the development of a technology that competed with the Orange Book technology.⁴ Princo’s nonpayment of royalties resulted in Philips filing a complaint against Princo before the International Trade Commission (“Commission”), where Philips claimed that Princo, among others, imported CDs that infringed Philips’s patents. The Commission’s administrative law judge and the Commission ruled in Princo’s favor, finding patent misuse.⁵ However, Philips appealed and the Federal Circuit reversed and remanded.⁶ On remand, the Commission rejected Princo’s misuse defense.⁷ Princo then appealed and asserted the Commission erred because Philips’s conditional licensing of essential patents for production of Orange Book compliant CD-R and CD-RW discs upon the purchase of a license to the Lagadec patent was patent misuse, as was Philips’s agreement with Sony not to license the Lagadec patent as competing technology to the Orange Book.

On April 20, 2009, a Federal Circuit panel issued a decision after reviewing an International Trade Commission ruling in *Princo*. The Panel Decision rejected Princo’s argument that the Lagadec patent was not necessary to practice the technology of the Orange Book standard,⁸ but it also remanded to the Commission for further fact-finding on whether Sony and Philips had agreed not to license the Lagadec patent.⁹ In its

en banc order, the Federal Circuit vacated its Panel Decision, granted the petitions for rehearing *en banc* filed by Philips and the Commission, and reinstated the appeal filed by Princo.¹⁰ Princo’s reinstated appeal will now be decided by the Federal Circuit sitting *en banc*, after the parties file new briefs primarily addressing Section II of the Panel Decision.¹¹

Arguments Addressed By The Princo 2009 Panel Decision

Generally, Section II of the Panel Decision, on which the *en banc* court will focus, addressed whether the Lagadec patent was a viable alternative to the technology licensed through the Orange Book patent pool, and whether Philips and Sony did agree *not* to license the Lagadec patent in a way that would permit a competitor to develop, use, or license the Lagadec patent’s technology to create a competing technology.

Thus, in its *en banc* decision, the Federal Circuit will likely address whether and when the patent misuse doctrine will apply to pooling arrangements in which participants agree not to license a patent outside of the pool. First, it is unclear whether the court has viewed the relationship between Sony and its patents and Philips and its patents as a vertical or horizontal relationship. In the Panel Decision, the panel discussed the “the appropriate standard under the rule of reason,”¹² as if it was the correct standard to apply to the relationship between Sony and Philips. However, in contrast, the Panel Decision also identified the Lagadec patent as “a pool competitor to the Raaymakers pool patents,”¹³ rejected Philips’s characterization of the licensing agreement with Sony as tantamount to a merger that would make the question of competition moot,¹⁴ and implied that Philips and Sony were “horizontal competitors.”¹⁵

If the Federal Circuit concludes the relationship between Sony and Philips was vertical

一家公司可否拒絕在專利集管以外許可集管的專利？

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任何公司，如業務涉及由多家公司集中管理之專利（集管專利 patent pool）（例如當競爭對手共同開發行業標準之專利集管），無論是專利許可管理或專利訴訟，應密切留意將於2010年進行的Princo Corporation訴國際貿易委員會的全院庭審。¹日前，與訟雙方、紐約智慧財產法協會（NYIPLA）及美國智慧產權法學會（AIPLA）都在撰寫書面辯護狀，辯護狀是關於聯邦巡迴法院於2009年10月13日授予全院聯席審查之命令中特別認定的、關於不當使用專利的問題。²在此案中，聯邦巡迴法院可能決定以下行為是否屬於不當使用專利，即集管專利所有者，相互之間是否可以簽約，拒絕將集管專利許可給任何競爭之替代技術。³

背景

Princo不當使用專利的根源開始於八十年代後期和九十年代初期，美國飛利浦公司（Philips Corporation）與索尼公司（Sony Corporation）共同就生產CD-R和CD-RW光碟開發技術行業標準（稱為“橘皮書”）之時。飛利浦開發了把位置資料轉化成密碼，記錄在空白光碟中以確定位置的模擬方法，並且取得相關的專利權（“Raaymakers專利”）。索尼開發了同樣功用的數碼方法並為其取得專利權（“Lagadec專利”）。然而，飛利浦和索尼選擇僅以飛利浦的模擬方法界定橘皮書標準。不過，當飛利浦和索尼

及另外兩家公司同意集管其涵蓋橘皮書標準的各項專利時，雖然索尼的Lagadec專利沒有涵蓋橘皮書所述的上述已經選擇的模擬方法，該等公司還把Lagadec專利納入在專利集管的聯合許可之內。

Princo Corporation與Princo American Corporation原本取得了橘皮書集管的專利之許可，但是，這兩家公司很快就停止繳納專利權稅，並且提出不同的理由來堅持它們不應繳納專利權稅，包括飛利浦不當使用專利權。雖然Princo沒有就其產品使用了專利集管的相關技術提出爭議，但是它聲稱，飛利浦與索尼之間達成的、不在專利集管範圍以外許可Lagadec專利的協定是不當使用專利。其原因是該協議阻止了開發與橘皮書技術競爭的技術。⁴ Princo沒有繳納專利權稅導致飛利浦針對Princo向國際貿易委員會（“委員會”）提出了起訴，飛利浦提出了Princo進口光碟侵犯了飛利浦的專利權等主張。委員會的行政法官和委員會裁定Princo勝訴，裁決為不當使用專利。⁵不過，飛利浦進行上訴，聯邦巡迴法院經審查推翻裁決併發回重審。⁶發回重審的時候，委員會駁回了Princo提出的不當使用的抗辯。⁷然後，Princo進行上訴並聲稱委員會犯錯，原因是飛利浦在發放生產與橘皮書相容的CD-R和CD-RW光碟許可時，強迫專利權購買者同時購買非必要的Lagadec專利，該行為構成不當使用專利。此外，飛利浦與索尼

之間相互約定不發放Lagadec專利許可，如果Lagadec專利技術將作為橘皮書的競爭技術，此等約定一樣構成不當使用專利。

於2009年4月20日，聯邦巡迴法院專案庭在審閱國際貿易委員會對Princo的裁決後作出判決。專案庭裁決推翻了Princo提出關於Lagadec專利對實行橘皮書標準技術不是必需的論點，⁸但是，專案庭也將該案發回委員會重審以進一步尋找關於索尼和飛利浦是否已經相互約定不發放Lagadec專利許可的事實。⁹聯邦巡迴法院在其全院庭審作出的命令中取消了其專案庭裁決，准予飛利浦和委員會提呈的全院重審的呈請書，並且恢復Princo提呈的上訴。¹⁰在各方圍繞專案庭裁決的第二部分將提出新的訟案辯護狀，新恢復之Princo上訴現將由聯邦巡迴法院全院庭審裁決。¹¹

PRINCO的2009年專案庭裁決提出的論點

一般而言，全院庭審將會集中注意在專案庭裁決的第二部分。該部分主要分析了Lagadec專利是否為專利集管下橘皮書技術的一種可行替代技術，以及飛利浦和索尼是否達成協議拒絕發放Lagadec專利之許可，如果該許可將會在某程度上允許某競爭對手開發、使用Lagadec專利技術，或（進一步）發放Lagadec專利許可可以創造一項與橘皮書相競爭之技術。

因此，在其全院庭審裁決中，聯邦巡迴法院將很可能會提出，不

Pooled Patent

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(i.e., one in which the parties own complementary patents), the court will likely apply a rule of reason analysis, which balances the procompetitive and anticompetitive effects of the restriction, to determine if there was patent misuse. However, if the Federal Circuit views the relationship between Sony and Philips as horizontal (i.e., one in which the parties own competing patents), then there will be the potential that the court would find the agreement to be *per se* patent misuse. The fundamental question the court must answer is whether procompetitive benefits of the patent pool potentially justify an agreement not to license outside of the pool. If so, the court would apply a rule of reason analysis even though the relationship is horizontal. If not, the court could apply a *per se* analysis.

Second, if the Federal Circuit concludes that the purported agreement between Philips and Sony is subject to a rule of reason analysis, it is unclear whether, on remand, the Federal Circuit will provide instructions on how the Commission should determine the relevant market in which to evaluate the effects of the purported agreement and whether there is market power. For example, although the “relevant market” was already determined by the Commission, the Panel Decision has also cited a couple of markets that could be considered the “relevant market.” The “relevant market” could be the market for the licensing of the technology covered by the Lagadec patent,¹⁶ the market for the technology of the Raaymakers patented processes or products,¹⁷ or even the patent pool market.¹⁸

This case could have a significant impact on the kinds of agreements that patent owners, who are forming a pool, may enter into with each other, and how licensees regard these agreements. If the Federal Circuit decides the agreement in *Princo*

was *per se* patent misuse, patent pool owners will not be able to agree not to license pooled patents that arguably involve substitutable technologies outside of the pool without fear that they will violate the patent misuse doctrine. Equally, potential licensees of pooled patents will then be able to insist on paying royalties only on the patents that actually cover the competing technology being licensed. And if a potential licensee discovers that any of the patents in the pool disclose alternative, substitutable technologies to the licensed technology, that potential licensee may be able to use this discovery in negotiations against the patent pool owners, or if later sued for patent infringement, raise patent misuse as a defense against the patent pool owners.

THIS CASE COULD HAVE A SIGNIFICANT IMPACT ON THE KINDS OF AGREEMENTS THAT PATENT OWNERS, WHO ARE FORMING A POOL, MAY ENTER INTO WITH EACH OTHER, AND HOW LICENSEES REGARD THESE AGREEMENTS.

If, on the other hand, the Federal Circuit decides that the rule of reason applies to pooling arrangements in which participants agree not to license a patent outside of the pool, the competitive effects of entering into such an agreement could expose pooling arrangements to patent misuse claims. Though this would make it harder for a former licensee sued for patent infringement to prove a patent misuse claim than under a *per se* analysis, such companies will still be able to raise questions about the patent pool agreement if there is any doubt as to the true nature of the relationship among the patent pool owners, i.e., horizontal

as opposed to vertical; the necessity of a patent being part of the pool; or whether a particular patent may apply to a competing, substitutable technology. Thus, until the Federal Circuit issues its *en banc* decision in *Princo*, patent owners and licensees should closely scrutinize agreements they may be entering into, particularly if any agreements restrict access to patents. ■

- 1 563 F.3d 1301 (Fed. Cir. 2009) (the “Panel Decision”).
- 2 *Princo Corp. v. International Trade Comm’n*, 583 F.3d 1380 (Fed. Cir. 2009) (per curiam). At present, the court has extended the deadlines for briefing. *Princo*’s and the Commission’s briefs are due on 1/15/2010; Philips’s brief is due on 2/5/2010.
- 3 Though it previously held that a patent owner was under no obligation to license a patent, *Intergraph Corporation v. Intel Corporation*, 195 F.3d 1346, 1362 (Fed. Cir. 1999) (the antitrust laws do not negate the patentee’s right to exclude others from patent property) (citing *Cygnus Therapeutic Sys. v. ALZA Corp.*, 92 F.3d 1153, 1160 (Fed. Cir. 1996)), in *Princo* the question is addressed as to whether patent owners can agree among themselves to withhold a license to a patent.
- 4 *Princo*, 563 F.3d at 1302.
- 5 *In re Certain Recordable Compact Discs & Rewritable Compact Discs*, Inv. No. 337-TA-474 (Int’l Trade Comm’n Apr. 8, 2004).
- 6 *U.S. Philips Corporation v. International Trade Comm’n*, 424 F.3d 1179 (Fed. Cir. 2005).
- 7 *In re Certain Recordable Compact Discs & Rewritable Compact Discs*, No. 337-TA-474, slip op. at 9 (Int’l Trade Comm’n Feb. 5, 2007).
- 8 563 F.3d at 1311-12.
- 9 *Id.* at 1310.
- 10 583 F.3d at 1380-81.
- 11 *Id.* at 1381.
- 12 563 F.3d at 1318.
- 13 *Id.* at 1315.
- 14 *Id.* at 1316.
- 15 *Id.* at 1317.
- 16 *Id.* at 1315 (“patent licensing of competing technologies”).
- 17 *Id.* (“processes for manufacturing an unpatented product”).
- 18 *Id.* (patent “pooling of competing process[es]”).

集管專利

(Continued from Page 11)

當使用專利原則可否並何時適用於參與者協議不在集管以外許可一項專利的集管安排。首先，我們不清楚法院是否已經視索尼並其專利和飛利浦並其專利之間屬於縱向或橫向的關係。在專案庭裁決中，專案庭討論了對於該問題是否採用“合理原則的適用標準”，¹² 似乎該標準應當是應用於索尼與飛利浦之間的關係的正確標準。不過，與此形成鮮明對比的是，專案庭裁決還把Lagadec專利認定為“Raaymakers集管專利的集管競爭對手”，¹³ 以此駁回飛利浦的兼並理論。該兼並理論認為飛利浦與索尼訂立的許可協議相當於一個縱向公司兼並，從而使濫用專利這一問題變得沒有實際意義。¹⁴ 但專案庭的裁決似乎暗示飛利浦與索尼是“橫向競爭者”（之間的兼並）。¹⁵

如果聯邦巡迴法院最後裁決索尼與飛利浦之間的關係是縱向的（即雙方擁有互補的專利的關係），法院將很可能應用合理原則來分析，該原則可權衡在專利集管中限制性條款的有利與阻遏競爭的影響，以確定是否該限制構成不當使用專利。不過，如果聯邦巡迴法院視索尼和飛利浦的關係為橫向的（即雙方擁有互相競爭的專利的關係），則法院有可能裁定協議無論後果如何，其本身就是不當使用專利。法院必須回答的基本問題是：專利集管中有助於競爭的利益是否潛在能證明一份不在集管以外許可專利的協議合法。如是的話，就算關係是橫向的，法院仍會應用合理原則分析。否則，法院會應用不計後果如何，認定行為本身就是

不當的分析準則。

第二，如果聯邦巡迴法院最後裁定，飛利浦與索尼之間聲稱的協議須按合理原則分析，則在駁回的時候，就不清楚聯邦巡迴法院是否會提供應如何確定相關市場的方法，用以評估評估協議在相關市場之影響，以及如何判斷是否有市場（壟斷）能力的方法。例如，雖然“相關市場”已經由委員會確定，專案庭裁決也提出了幾個可能被視為“相關市場”的市場。但“相關市場”可以是以下幾個市場之一：許可Lagadec專利所涵蓋的技術的市場¹⁶、Raaymakers專利程式或產品的技術之市場¹⁷ 或者甚至是專利集管市場。¹⁸

此案件會對組成集管的專利所有人之間可互相簽訂的協定類別，以及被許可人如何看待此等協議構成重大影響。如果聯邦巡迴法院確定Princo的協議本身就是不當使用專利，則專利集管的所有人將會擔心，協議不許可有可能涉及集管範圍以外之替代技術的集管專利，會直接構成不當使用專利。同樣地，集管專利的潛在的被許可人則可堅持僅對實際涵蓋被許可競爭技術的專利繳納專利權稅。而且，如果潛在的被許可人發現集管的任何一項專利披露了被許可技術的替代技術或潛在的替代技術，則該潛在的被許可人可能會在與專利集管所有人的談判中（或者，如果後來被控訴專利侵權時）利用此發現提出不當使用專利作為針對專利集管所有人的抗辯。

如果，從另一方面說，聯邦巡迴法院決定合理原則須應用於參與者協議不在集管以外許可專利的集管安排，簽訂該協定的競爭效果是可使集管安排承受不當使用專利主張的風險。雖然這樣會使被控告專利侵權的前專利許可持

有者要證明不當使用專利的主張較行為本身構成專利不當使用之分析更加困難，但是，如果有任何關於專利集管所有人之間關係的任何疑問，該等公司將仍然能夠提出關於專利集管協議的問題，即橫向相對於縱向而言；專利作為集管一部分的必要性；或者某一特定的專利可否應用於一項具競爭性、可替代的技術。因此，在聯邦巡迴法院作出其對Princo的全院庭審裁決之前，專利所有人和被許可人應密切詳細檢查其可能簽訂的協定，尤其是如果協定有任何限制取用專利的協議。■

- 1 第563輯第3d卷第1301頁（2009年聯邦巡迴法院）（“專案庭裁決”）。
- 2 Princo Corp. 訴 國際貿易委員會，第583輯第3d卷第1380頁（2009年聯邦巡迴法院）（由法庭共同議決）。目前，法院延遲了呈交訟案的期限。Princo及委員會呈交其訟案的限期是2010年1月15日；飛利浦的訟案則須於2010年2月5日呈交。
- 3 雖然以前認為專利所有人無義務許可專利（Intergraph Corporation 訴 Intel Corporation 第195輯第F.3d卷第1346、1362頁（1999年聯邦巡迴法院））（反壟斷法律沒有否定專利權人排除其他人在專利財產之外的權利）（引用Cygnus Therapeutic Sys. 訴 ALZA Corp. 第92輯第3卷第1153、1160頁（1996年聯邦巡迴法院）），就Princo而言，問題是專利所有人之間可否同意拒絕給予專利的許可。
- 4 Princo（第563輯第3卷第1302頁）。
- 5 有關若干可寫光碟和可重寫光碟，Inv. No. 337-TA-474（國際貿易委員會2004年4月8日）。
- 6 美國飛利浦公司 訴 國際貿易委員會，第424輯第3d卷第1179頁（2005年聯邦巡迴法院）。
- 7 有關若干可寫光碟和可重寫光碟，編號：337-TA-474，立法意見第9頁（國際貿易委員會2007年2月5日）。
- 8 第563輯第F.3d卷第1311-12頁。
- 9 同上第1310頁。
- 10 第583輯第F.3d卷第1380-81頁。
- 11 同上第1381頁。
- 12 第563輯第F.3d卷第1318頁。
- 13 同上第1315頁。
- 14 同上第1316頁。
- 15 同上第1317頁。
- 16 同上第1315頁（“具競爭性技術的專利許可”）。
- 17 同上（“製造沒有申請專利權的產品的過程”）。
- 18 同上（專利“集管具競爭性的過程”）。

IP Practice News

Recent Awards & Accolades

Morrison & Foerster's intellectual property group achieved rankings in ten categories in the annual "World IP survey" by Managing Intellectual Property. The issue, "2010 Patent Firms Of The Year," includes the World IP Survey in which the firm is ranked in ten categories, and moved higher in two categories: ITC practice and Patent Contentious (West) for which the firm earned the highest Tier 1 ranking. Our group also received the Tier 1 ranking in Copyright (West). We have also been shortlisted for Managing IP's North America Awards 2010 in

the areas of United States: National: ITC Litigation, United States: West: Patent Prosecution, and United States: West: Patent Contentious.

The World IP Survey is a qualitative ranking of the leading firms in each category and reveals which firms are rated by their peers for the strength of their expertise and the depth of their ability to service clients, according to the magazine. The survey, in its 14th year of publication, is based on hundreds of conversations with clients and practitioners worldwide. ■

Morrison & Foerster Launches iPhone Mobile Application "MoFo2Go"

Continuing the firm's tradition of innovation, Morrison & Foerster has launched one of the first iPhone applications created by a major law firm. MoFo2Go is a multi-function app designed for on-the-go professionals and is available for free through iTunes. To download, go to the app store in iTunes and search "MoFo2Go."

The app's four functional areas are "People," "News," "Locations," and "Play." "People" allows users to view short bios of all attorneys who are on

the MoFo website and is searchable by practice/industry, office location, or law school. In the "News" section, users can view our client alerts, press releases and newsletters — plus special content from our award-winning magazine *MoFo Tech*. "Locations" has important information about our offices and includes handy guides to the nearest transportation hubs, hotels, and restaurants. Then there's the "Play" function — MoFo Maze — a game that challenges users to progress through four levels of increasing difficulty. ■

Morrison & Foerster Wins Summary Judgment for AMEC

MoFo obtained a summary judgment for its client AMEC that the employment agreements at the center of a trade secrets dispute between AMEC and its rival, Applied Materials Inc. ("Applied"), are invalid and constitute unfair competition under California law.

Applied sued AMEC in October 2007 after several of Applied's former employees went to work for AMEC. The suit claims the former employees filed patent applications in China, Japan and the U.S. that disclosed Applied's trade secrets to the public and violated the employment agreements.

Under the Applied employment agreement, it was assumed that any patent application a former Applied employee filed within a year of leaving the

company relates to an invention they created during their time with the company, and the application was deemed assigned to Applied.

AMEC argued that the agreements constituted unenforceable non-compete agreements under California law because they restricted employee mobility, requiring former Applied employees to sign over inventions even if they resulted from independent research. In his May 20 ruling, Judge Ware sided with AMEC, finding that the agreements were unenforceable and constituted unfair competition under California law.

Gerald Yin, AMEC's chief executive officer, said the decision marked a victory for innovators, entrepreneurs, and all high-tech workers in California. ■

智慧產權業務新聞

最近所獲獎勵和榮譽

在智慧財產管理雜誌進行的年度“世界智慧財產調查”中，美富律師事務所的智慧財產部門榮登10個類別的排行榜。期刊“2010年年度專利領域最佳律所”發佈了世界智慧財產調查結果。本所獲得其10個類別排名，並在兩個排名中名次上升（ITC業務和專利訴訟（西部），其中專利訴訟（西部）名列一級）。本所部門還獲得版權（西部）領域的一級排名。本所還入圍智慧財產管理雜誌評選的2010年北美獎，具體包括以下獎項：

美國（全國）：ITC訴訟，美國（西部）：專利訴訟以及美國（西部）：專利訴訟領域。

根據雜誌所述，世界智慧財產調查是對領先律所在各個類別中的定性排名，揭示了哪些律所憑藉其專業技術的實力以及其客戶服務的能力而受到同行的大力推崇。在該調查14年的出版發行中，該調查均是基於與世界範圍內的客戶和專業人員進行的數百次訪談進行的。■

美富律師事務所推出 iPhone 移動應用程式 “MoFo2Go”

秉承本所創新的傳統，美富已經推出了首個由一家大型律所創造的iPhone應用程式。MoFo2Go是一款為移動工作的專業人士設計的多功能應用程式，可以通過iTunes免費獲得。欲下載，需進入iTunes的應用程式保存頁面，然後搜索“MoFo2Go。”

此應用程式的四個功能領域為“人員”、“新聞”、“地點”以及“遊戲”。“人員”可以讓

用戶流覽美富網站上所有律師的簡介，而且可以通過業務/行業、辦公地點或者法學院等關鍵字進行搜索。在“新聞”區，用戶可以流覽我們的客戶提示、新聞發佈以及通訊—以及本所獲獎雜誌美富技術（*MoFo Tech*）中的具體內容。

“地點”擁有關於本所辦事處的重要資訊並包括針對最近交通樞紐、酒店和飯店的便利指南。

“遊戲”功能—*MoFo Maze*—是一款通過不同難易程度的四個等級來挑戰用戶升級的遊戲。■

美富律師事務所為AMEC公司贏得簡易判決

美富為其客戶AMEC贏得了簡易判決，判決認為：AMEC及其競爭對手Applied Materials Inc（“Applied”）僱用協議是無效的，該協議是雙方商業秘密爭議的焦點。而且判決認定依照加州法律該協議構成了不正當競爭。

在Applied的幾個前僱員到AMEC工作後，Applied於2007年10月起訴AMEC。訴訟主張前任僱員在中國、日本和美國提交了專利申請，這種做法向公眾披露了Applied的商業秘密並違反了僱用協議。

Applied的僱用協議規定：假定Applied前任僱員在離開公司一年內就其在工作期間創造的發明

提交了任何專利申請，則該等申請被視為轉讓給了Applied。

AMEC主張該等協議依照加州法律構成不可執行的競業禁止協議，因為Applied要求前僱員簽字同意讓與發明的做法包括了獨立研發實現的發明，限制了僱員的流動性。在5月20日的裁決中，法官Ware同意AMEC的主張，判定協議是不可執行的而且依照加州法律構成了不公平競爭。

AMEC的首席執行官Gerald Yin說此次判決標誌著加州創新者、企業家以及所有高技術人員取得的勝利。■

IP Practice News

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Morrison & Foerster Represents Yahoo! in Sale of HotJobs

On January 5, Yahoo! announced its sale of the assets of Yahoo! HotJobs (a leading online recruitment website) to Monster Worldwide, Inc. for \$225 million. A team of MoFo TTG attorneys in the San Francisco office led negotiations on the intellectual property and commercial aspects of the deal. The team also led negotiations on a

three-year commercial traffic agreement in which Monster will become Yahoo!'s provider of career and job content on the Yahoo! homepage in the United States and Canada. The transaction is expected to close sometime during the third quarter of 2010, subject to regulatory review. ■

智慧產權業務新聞

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美富律師事務所代表雅虎！出售HotJobs

1月5日，雅虎！宣佈向Monster Worldwide, Inc. 出售其資產 Yahoo! HotJobs（一家領先的線上招聘網站），金額為2.25億美元。美富位於三藩市辦事處的TTG律師團隊領導此次談判的智慧財產談判和交易的商業方面問題之談判。律師團隊

還領導了三年期商業業務協定的談判，在該協議中，Monster將成為美國和加拿大雅虎！主頁上職業和工作內容的提供商。受限於監管審查，此次交易預計在2010年第三季度交割。 ■

This newsletter addresses recent intellectual property updates. Because of its generality, the information provided herein may not be applicable in all situations and should not be acted upon without specific legal advice based on particular situations. If you wish to change an address, add a subscriber, or comment on this newsletter, please email Michael Zwerin at mzwerin@mofo.com in Palo Alto, David Harvey at dharvey@mofo.com in Washington, D.C. or Priscilla Chen at priscillachen@mofo.com in Greater China.

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