

出國報告（出國類別：進修）

104 年度經濟部科技專案  
跨領域科技管理與智財運用  
國際人才培訓計畫

「跨領域科技管理研習班」

服務機關：勞動部勞動及職業安全衛生研究所

姓名職稱：曹常成 副組長

派赴國家：美國

出國期間：104 年 7 月 11 日至 8 月 3 日

報告日期：104 年 11 月 2 日

## 摘要

參加 103 年度經濟部科技專案跨領域科技管理與智財運用國際人才培訓計畫「跨領域科技管理研習班」(MMOT) 國外培訓班－A 段「智慧財產保護與經營專題」及 B 段「智財管理與技術移轉專題」，分別於位在 Washing DC 的 Winston & Strawn 外國法事務律師事務所及位在 Seattle 的 University of Washington 上課，並參訪美國智慧財產權法令主管機關 (USPTO)、海關禁制令實施機關國際貿易委員會 (ITC) 及聯邦上訴巡迴法院 (CAFC)，研習課程主要議題包括：美國專利法重大變革－發明者法案 (Leahy-Smith America Invents Act, AIA)、反托拉斯法、專利訴訟策略、技術轉移授權契約擬訂及相關案例探討等。

本次研習並以創客運動為論文主題，探討如何為台灣創客產業建立一套發展模式，以利創客運動更蓬勃，進而提昇台灣創客企業整體發展，以應付外在的景氣循環與挑戰。本研究透過各國專家訪談與現況文獻探討後，獲致以下幾點結論：(一) 創客空間的資源對初階創客具有實質助益，並有助於概念整合與資源媒介。(二) 創客空間初期難以營利，仍需政府與廠商協助。(三) 企業如能輔導創客創新營運，對於創客創意商品化與企業化將有實質助益與深遠影響。(四) 政府如能提升創客政策高度，將有助加速產業聚落形成。最後並提出以下建議，供相關單位參考：(一) 建議政府建立創客運動完整之長程政策規劃，推廣施行。(二) 整合官方與民間創客加速器，政府規劃提出使資源和需求對接的執行方案，推廣創客空間、創新工場等新型孵化模式。(三) 參考美國政府部門措施，由各政府部門釋出民間創客參與政策計畫機會。(四) 宣導不怕失敗的創新文化，提倡動手實作的跨界精神，大力培育企業家精神和創客文化，將創新創意轉化為實實在在的創業活動。

對於本次進修、參訪心得，建議政府對於計畫產出研發成果運用法規可以再鬆綁，再增加獎勵的誘因或許可以有更高的運用率。另研習課程內容相當紮實，從美國智慧財產最新法規改革到法院訴訟實務均有系列課程介紹，並且佐以研討會型式，分別以政府單位、學研機構及執業律師 3 方不同角度，探討專利法新制施行對美國發明、創新之保護。模式可為成果推廣借鏡。此外，政府科研單位對於專利布局專業能力有限，建議政府成立一整合單位處理各機構專利事宜。

**關鍵詞：**智慧財產、專利、創新、創業

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## 一、目的

本次參與之訓練課程源於經濟部「跨領域科技管理與智財運用國際人才培訓計畫」後續擴充第 1 期計畫，以國際智慧財產保護、經營及其發展之研習主題外，規劃設計智財訴訟與策略、研發成果商業化二學程，聚焦於國際智財權之實戰概念，為我國廠商培育智財佈局、保護與經營之實務人才，以與政府「智財戰略綱領」密切契合。承辦單位磐安智慧財產教育基金會接受經濟部技術處委辦計畫，以專題研習方式，選派學員赴國外訓練，以培育及提升業界面對上述問題之國際處理能力。

磐安基金會遴選國內產業界與研究機構，具科技背景之研究發展或管理人才共計 27 人（如附件 1），赴美國接受智慧財產保護與國際發展、智財訴訟與策略、研發成果商業化與投資評估等課題之專業課程訓練。連同磐安基金會王偉霖博士、陳桂恒博士、許曉芬博士以及盧文祥教授、助教 2 人，全團共 33 人。本訓課程除了跨領域智權訓練以及智權管理策略，並透過論文撰寫，課前及課後分享報告強化培訓課程。

培訓課程共三週，分別在 2 地進行：第一週課程在美國華盛頓 Winston & Straw 法律事務所，主要以智慧財產訴訟及法規保護為主，並以實際案例剖析深入探討。第二及三週的課程移往美國西雅圖的華盛頓大學(University of Washington；UW)進行，課程聚焦在技術發展策略、市場評估、技術計價、授權與談判以及策略管理等重點。各週培訓課程規劃與課程內容如表 2~5，各課程及參訪內容摘記及論文內容亦敘述如後。

## 二、研習內容簡介

本次 AB 段研習共計 27 學員參加，除 3 員為政府單位派員外，餘皆來自律師／專利事務所及產業從業人員，除每日研習及部分參訪課程外，另須分組完成相關主題論文（每人至少 1 萬字）並於 11 月 13 日進行論文發表，各階段研習內容簡述如下：

### （一）研習課程

#### 1. A-1 段

(1)日期：103 年 7 月 11 日至 18 日。

(2)地點：Washing DC，Winston & Strawn 美國法事務律師事務所。

(3)課程表：如表 2。

表 2 美國東岸課程 (July 11-July 18)<sup>1</sup>

July 11-18, 2015 MMOT: US Intellectual Property Training Program (DRAFT)

Week 1 at Winston & Strawn, Washington DC							
Time	SAT, July 11	MON, July 13	TUE, July 14	WED, July 15	THU, July 16	FRI, July 17	SAT, July 18
8:15-9:00	1902 Flight UA 309 Arrive in Washington, DC WASHINGTON DULLES	Pre-Study	Pre-Study	Pre-Study	Pre-Study	Pre-Study	Check-Out Process  8:10 Bus Leaves  8:30-10:30 Tour of Library of Congress
9:00-10:30		Welcome to Winston and Winston Tour  Overview of the U.S. Court System  <i>John Alison</i>	Process and Strategy of Discovery in US Litigation  <i>John Rosenthal Jessica Hill</i>	Prosecution Challenges Under the America Invents Act  <i>Allan Fanucci</i>	IPR Protection & Management Strategy: Technology Standards, Patent Pools, NPEs  <i>Andrew Sommer</i>	IP Due Diligence  <i>John Alison</i>	
10:30		Break	Break	Break	Break	Break	
10:45-12:15	Check-in Process	Patent Fundamentals: Patentability, Claim Construction, and Infringement  <i>Steve Anzalone</i>	Infringement Damages and Reasonable Royalty Rate  <i>Judge Rader</i>	Patent Litigation at the U.S. International Trade Commission  <i>Tom Jarvis</i>	Validity Trials at the Patent Trial and Appeal Board: Strategies for Patent Owners  <i>Andrew Sommer</i>	Pharmaceutical Patent Litigation: ANDA Cases and Biologics  <i>Chuck Klein Sam Park</i>	11:00-12:00 Twin Oaks Estate
12:15	SUN July 12	Lunch	Lunch	Lunch	Lunch	Lunch	Lunch on own
1:30-3:00	3:00 PM Arrive in Winston & Strawn  Orientation (1) 3:15-4:00 pm <i>John Alison</i> (2) 4:00-5:00 pm <i>Prof. Wang</i> (3) 5:00-6:00 pm Team Study <i>Prof. Chan Prof. Wang</i>	Dispute Resolution- Mediation, Arbitration and Litigation  <i>John Alison</i>	Patent Jury Trials: Trends, Strategies, and Mock Juries  <i>David Wang</i>	Visit to USITC	Attend PTAB Hearing at USPTO	Patent/Antitrust Litigation Affecting International Commerce  <i>Matt Campbell</i>	Depart 1735 Flight UA 1637 WASHINGTON DULLES
3:00	Break	Break	Break	Visit EDVA Court	Break		
3:15-4:45	Visit to US Court of Federal Claims	Team Interviews/ Independent Study	Team Interviews/ Independent Study		Team Presentations and Certificates		
4:45	Break	Break	Break	Break	Break		
5:00-6:00	Review, Homework and Class Preparation	Review, Homework and Class Preparation	Review, Homework and Class Preparation	Dinner with Speakers (Host: CIPF)	Winston Reception 5:30-7:00 p.m.	Arrive in Seattle	

2. A-2 段

- (1)日期：103 年 7 月 20 日至 26 日
- (2)地點：Seattle，University of Washington
- (3)課程表：如表 3。

<sup>1</sup>備註：每日 8 時至 8 時 30 分預習報告，15 時 30 分至 17 時 30 分複習報告。

表 3 美國西雅圖課程 (July 20-July 23)

Draft 07/13/2015

2015 CASRIP Patent and IP Law Summer Institute  
July 20 – July 31, 2015  
University of Washington School of Law, Seattle, Washington

Core Subjects  
Monday – Thursday, July 20 – July 23, 2015

	8:30 a.m. - 10:20 a.m.	10:30 a.m. - 12:20 p.m.	1:40 p.m. - 3:30 p.m.
July 20	Patent Basics 1: First-To-Invent and Statutory Bars Martin Adelman/Toshiko Takenaka/Randall Rader	Patentability at USPTO 1: Patent Eligibility, Utility and Novelty Bill LaMarca	U.S. Patent Prosecution 1: Patent Application Drafting Jeff Sakoi <hr/> New Option: Trademark Prosecution Pam Jacobson
July 21	Patent Basics 2: Patentability Case Law Martin Adelman/Toshiko Takenaka/Randall Rader	Patentability at USPTO 2: Nonobviousness and Disclosure Bill LaMarca	U.S. Patent Prosecution 2: Office Actions and Examiner Interviews Jeff Sakoi <hr/> New Option: Trademark Litigation Michael Atkins
July 22	Patent Basics 3: Claim Interpretation and the DOE Martin Adelman/Toshiko Takenaka/Randall Rader	Patentability at USPTO 3: Court Review & Pre-Grant Publication Bill LaMarca	Patent Litigation 1: Pre-Filing Strategies and Pleadings Paul Meiklejohn
July 23	U.S. Current Issues in Comparative Law Perspective Martin Adelman/Heinz Goddar/Randall Rader	Patentability at USPTO 4: Post Issuance Procedure Bill LaMarca	Patent Litigation 2: Pre-Discovery, Motions and Trial Paul Meiklejohn

- MMOT Group - Daily Pre-Study Time : 8:00-8:30am
- MMOT Group - Review and Study Session : 3:30-5:00pm

(4) July 25 (五) – 26 (六) 研討會：High Technology Protection Summit (議程詳如表 4)

表 4 High Technology Protection Summit (July 20-July 31) 議程



**AGENDA**  
**Friday, July 24, 2015**  
(6.75 General CLE Credits Approved)

● **MMOT Group - Daily Pre-Study Time : 8:00-8:30am**

- 8:00 a.m. Registration
- 8:30 a.m. Welcome: Sean O'Connor, Assistant Dean for Law, Business & Technology Initiatives  
University of Washington School of Law, Seattle, WA
- 8:40 a.m. Keynote: Patent Eligibility – A Different Approach  
Honorable Justice Annabelle Bennett AO, Judge, Federal Court of Australia, Sydney, Australia
- Patent Eligibility: Comparative Law Perspective
- 9:10 a.m. Challenging Software-Business Method Patent Eligibility in Civil Actions and Post Grant Review  
Moderator: Mr. Paul Meiklejohn, Dorsey & Whitney LLP, Seattle, WA
- Panelists: Mr. Robert Stoll, Drinker Biddle & Reath, Washington D.C.  
Mr. Bill LaMarca, Special Counsel for Patent & IP Litigation, USPTO, Alexandria, VA  
Mr. Shinjiro Ono, Yuasa & Hara, Tokyo, Japan  
Professor Heinz Goddar, Boehmert & Boehmert, Munich, Germany  
Dr. Niels Hoelder, Hoffmann & Eitle, Munich, Germany
- 10:30 a.m. Open Discussion
- 10:45 a.m. Coffee Break
- 11:00 a.m. Biotech and Pharma Patents Eligibility: Challenges for Harmonization  
Speaker: Professor Randall Rader, Harry M. Cross Visiting Professor, University of Washington  
School of Law, Seattle, WA
- Moderator: Professor Martin Adelman, George Washington University School of Law, Washington D.C.
- 11:15 a.m. Panel Discussion  
Panelists: Dr. Ken Weber, Kilpatrick Townsend & Stockton, San Francisco, CA  
Dr. Denise M. Kettelberger, Sunstein Kann Murphy & Timbers LLP, Boston, MA  
Mr. Jim Haley, Ropes & Gray, New York, NY  
Dr. Jan Krauss, Boehmert & Boehmert, Munich, Germany
- 12:15 p.m. Open Discussion
- 12:30 p.m. Lunch (Sponsored by Kilpatrick Townsend & Stockton)

表 4(續) High Technology Protection Summit (July 20-July 31) 議程

- 1:20 p.m. Speech by Honorable Pavana Sugandhavanij, Chief Justice of IP Court, Thailand
- Global Patent Enforcement Strategy**
- 1:30 p.m. **Border Measures for Patent Infringement**  
Moderator: Mr. Douglas Stewart, Bracewell & Giuliani, Seattle, WA
- Panelists: Mr. Steve Kunin, Oblon Spivak, Washington D.C.  
Mr. John Rabena, Sughrue Mion, Washington D.C.  
Dr. Tilman Mueller-Stoy, Bardehle Pagenberg, Munich, Germany  
Mr. Ryoichi Mimura, Nagashima & Ohno, Tokyo, Japan
- 2:45 p.m. **Open Discussion**
- 3:00 p.m. **Coffee Break**
- Patent and Trade Secret Interface: Developments in U.S. Europe and Asia**
- 3:15 p.m. **Enforcing Trade Secrets at Japanese Courts**  
Speaker: Honorable Kazuhide Shimasue, IP Division, Tokyo District Court, Tokyo, Japan
- Moderator: Professor Robert Gomulkiewicz, University of Washington School of Law, Seattle, WA
- 3:35 p.m. **Panel Discussion**  
Panelists: Mr. Hiro Hagiwara, Ropes & Gray, Tokyo, Japan  
Mr. Scott Mosko, Finnegan Henderson, Palo Alto, CA  
Mr. Zhiyong Wang, Beijing High Law Partners, Beijing, China  
Dr. Christof Karl, Bardehle Pagenberg, Munich, Germany  
Ms. Mitsuko Miyagawa, TMI Associates, Tokyo, Japan
- 4:45 p.m. **Open Discussion**
- 5:00 p.m. **Closing**
- **MMOT Group - Review and Study Session : 5:00-5:45pm**
- 6:30 p.m. **Reception (Hosted by Seed Intellectual Property Law Group)**
- **Friday, July 24: High Technology Protection Summit Reception hosted by Seed IP Law Group (6:30p.m.-8:30p.m.). Bus departs at 5:45pm. Bus departs Seed at 8:30pm.**

**AGENDA**  
**July 25, 2015**  
(3.50 Ethics CLE Credits Approved)

- **MMOT Group - Daily Pre-Study Time : 8:00-9:00am**
- 8:30 a.m. **Registration**
- 9:00 a.m. **Monetizing Patents: Licensing and Ethical Issues**  
Moderator: Professor Sean O'Connor, University of Washington School of Law, Seattle, WA
- Panelists: Mr. Nick Psychogeos, Microsoft, Redmond, WA  
Mr. Peter Ayers, Lee & Hayes, Austin, TX  
Dr. Ralph Nack, Noerr LLP, Munich, Germany  
Mr. Kazuhiko Yoshida, Nakamura & Partners, Tokyo, Japan
- 10:30 a.m. **Open Discussion**
- 10:45 a.m. **Coffee Break**
- 11:00 a.m. **Ethical Issues in Patent Litigation: Abuse of Process**  
Moderator: Mr. Jeff Sakoi, Seed IP Law Group, Seattle, WA
- Panelists: Mr. Rik Parker, Baker Hostetler, Philadelphia, PA  
Mr. David Tellekson, Fenwick & West, Seattle, WA  
Mr. Benjamin Grzimek, EIP Europe LLP, Dusseldorf, Germany  
Mr. Toshiaki Iimura, Yuasa & Hara, Tokyo, Japan
- 12:30 p.m. **Open Discussion**
- 12:45 p.m. **Adjourn**
- **MMOT Group - Review and Study Session after class**

3. B 段

(1)日期：103 年 7 月 28 日至 8 月 1 日



(2)地點：Seattle，University of Washington

(3)課表：如表 5。

表 5 美國西雅圖課程 (July 27-July 31)

Draft 07/13/2015

Advanced Subjects and IP Management – July 27– 31, 2015

Monday, July 27, 2015

8:30 a.m. - 10:20 a.m.

10:30 a.m. - 12:20 p.m.

1:40 p.m. - 3:30 p.m.

Advanced Patent Prosecution 1: Priority Contest under Pre-AIA and AIA Peter Davis	Advanced Patent Prosecution 2: U.S. IP Law Developments in Life Sciences & Biotechnology Joe Hao	Advanced Patent Prosecution 3: Strategic Patent Prosecution for Foreign Originated Applications Steve Cho
International Litigation Strategies 1: Standard Setting Process and US Patent Enforcement Michael Stein	International Litigation Strategies 2: Standard Setting Process and International Patent Enforcement Christof Karl	International Litigation Strategies 3: ITC Practice Michael Anderson
☆MMOT IP Management 1: IP Entrepreneurship Overview Jennifer Fan	☆MMOT IP Management 2: Angel Investors and Incubators Russ Murphy	☆MMOT Management 3: IP Based Understanding on Open Innovations Roy Diaz

- MMOT Group - Daily Pre-Study Time : 8:00-8:30am
- MMOT Group - Review and Study Session : 3:30-5:00pm
- Monday, July 27: Mariner's Baseball Game at Safeco Field hosted by Perkins Coie Law Firm (7:10p.m.-10:00p.m.)

Tuesday, July 28, 2015

8:30 a.m. - 10:20 a.m.

10:30 a.m. - 12:20 p.m.

1:40 p.m. - 3:30 p.m.

EU Patent Practice 1: EU Patent Enforcement Strategies Tilman Mueller-Stoy	EU Patent Practice 2: Patent Prosecution at EPO Jan Krauss	EU Patent Practice 3: EU Technology Transfer in Health Science Jan Krauss
Advanced Patent Enforcement 1: Infringement Remedies Ramsey Al-Salam	Advanced Patent Enforcement 2: Negotiating Settlement Hiro Hagiwara	Advanced Patent Enforcement 3: Enforcing Patents in Japan- China Toshiaki Iimura, Zhiyong Wang
☆MMOT IP Management 4: Patent Assertion Entities and Pending Bills to Protect Businesses from Their Activities Ryan McBrayer	☆MMOT IP Management 5: LOI Negotiation Sung Yang	☆MMOT IP Management 6: License Agreement Drafting Essentials Chandran Iyer

- MMOT Group - Daily Pre-Study Time : 8:00-8:30am
- MMOT Group - Review and Study Session : 3:30-5:00pm

## Wednesday, July 29, 2015

8:30 a.m. - 10:20 a.m.

10:30 a.m. - 12:20 p.m.

1:40 p.m. - 3:30 p.m.

International Litigation Strategies 4: Forum Shopping and Valuation using Data Metrics Michael Elmer	Patent Drafting Clinic 1-A: Electrical/Mechanical John Branch	Advanced Patent Enforcement 4: Evaluating Infringement/Non- Infringement Positions for Patent Litigation Doug Stewart
Advanced Patent Prosecution 4: Continuation Strategies Steve Rosenman	Patent Drafting Clinic 1-B: Chemical/Biotechnological Karl Hermanns	Advanced Patent Prosecution 5: Design Patent Prosecution and Enforcement Robert Katz
☆MMOT IP Management 7: Biotechnological/Pharmaceutical Licensing Katherine Kowalchuk/Dianna El Hioum	☆MMOT IP Management 8: Technology Transfer Lisa Norton	☆MMOT IP Management 9: Working with BRICS Countries and Beyond Mark Guetlich

- MMOT Group - Daily Pre-Study Time : 8:00-8:30am
- MMOT Group - Review and Study Session : 3:30-5:00pm

## Thursday, July 30, 2015

8:30 a.m. - 10:20 a.m.

10:30 a.m. - 12:20 p.m.

1:40 p.m. - 3:30 p.m.

Advanced Patent Prosecution 6: Appeal at USPTO David Sheldon	Patent Drafting Clinic 2-A: Electrical/Mechanical John Branch	Advanced Patent Prosecution 7: Advanced Patent Enforcement 6: Strategic Use of Reexamination and Reissue Melanie Seelig/Chris Sweeney
Advanced Patent Enforcement 5 : Strategic Use of Post-Grant Review Peter Ayers	Patent Drafting Clinic 2-B: Chemical/Biotechnological Karl Hermanns	International Litigation Strategies 5: The Doctrine of Equivalent in EU Countries Prof. Mario Franzosi
☆MMOT IP Management 10: Trademark Branding Russ Jacobs	☆MMOT IP Management 11: Global IP Portfolio Management Andrew Serafini	☆MMOT IP Management 12: Game Business Kaoru Otawara / Joel Emans

- MMOT Group - Daily Pre-Study Time : 8:00-8:30am
- MMOT Group - Review and Study Session : 3:30-5:00pm
- Thursday, July 30: Happy Hour Reception at Agua Verde hosted by Knobbe Martens Law Firm (5:00p.m.-7:00p.m.). Meet at 4:30pm and walk down to Agua Verde.

Draft 07/13/2015

Friday, July 31, 2015

8:30 a.m. - 10:20 a.m.

10:30 a.m. - 12:20 p.m.

Advanced Patent Enforcement 7: Discovery for Non-U.S. Party Carrie Beyer	Patent Drafting Clinic 3-A: Electrical/Mechanical John Branch
Advanced Patent Prosecution 8: Office Action Strategies Han Gim	Patent Drafting Clinic 3-B: Chemical/Biotechnological Karl Hermanns
☆MMOT IP Management 13: Patent Evaluation Richard Ogawa	☆MMOT IP Management 14: In-House Counsel Brook Assefa

- MMOT Group - Daily Pre-Study Time : 8:00-8:30am
- Friday, July 31: Group photo. Graduation lunch at UW School of Law hosted by Kilpatrick, Townsend & Stockton Law Firm (12:30p.m.-2:00p.m.).
- MMOT Group - Review and Study Session & Team Presentations ( 2:00p.m.-5:00p.m.)



圖 1 於 Winston & Strawn 美國法事務律師事務所上課研討

## 1. 美東華盛頓 DC：Winston & Straw 事務所

7月11~7月18日在Winston & Straw的練課程，主要以智慧財產訴訟及法規保護為主，並以實際案例剖析深入探討智權申請重要基本內涵、保護重點、佈局策略、訴訟流程，從中

了解美國智慧財產權的保護與相關司法體系，訓練的主軸是在Winston & Straw律師事務所之訓練教室進行，除課程講授、討論外，尚包含參觀美國智財局(USPTO，旁聽一場PTAB IPR)、美國國際貿易委員會(ITC)由ITC行政法官介紹ITC運作情況、U.S. District Court for the Eastern District of Virginia由法官介紹美國地方法庭等。

MMOT訓練課程的特色在於密集的課後複習、課前演練，並需完成論文撰寫，論文撰寫過程中需安排與課程老師進行面談與討論，強化論文主題的內容。本次以創客運動為論文主題，探討如何為台灣創客產業建立一套發展模式，以利創客運動更蓬勃，進而提昇台灣創客企業整體發展，以應付外在的景氣循環與挑戰。



圖 2 上課進行論文報告





圖 3 接受 Winston & Strawn 課程結業證書

## 2. 美西西雅圖：華盛頓大學

7月19日~8月2日的課程在美國西部西雅圖的華盛頓大學(University of Washington；UW)進行，由磐安基金會安排所有MMOT學員參與由Toshiko Takenaka，華盛頓大學法學院教授負責規劃的Center for Advanced Study and Research on Intellectual Property (CASRIP)訓練課程，課程分為三部分，core subject 及 advanced subject and IP Management，期間並有一場國際論壇(high technology protection summit)。法學院課程除了MMOT學員外，另有來自美國及其他國家的學員一同上課，學員可藉此機會多與不同國家的學員交流。



圖 4 西雅圖華盛頓大學上課情形



圖 5 參加 High Technology Protection Summit 研討會



圖 6 美國聯邦巡迴法院院長授課情形





圖 7 接受華盛頓大學法學院院長頒發結業證書



圖 8 參加華盛頓大學課程各國學員合影





圖 9 參加華盛頓大學課程台灣學員合影



圖 10 於華盛頓大學全體學員與主辦單位合影