

108 年 專 門 職 業 及 技 術 人 員 高 等 考 試
會 計 師 、 不 動 產 估 價 師 、 專 利 師 考 試 試 題

代號：70150
70650
頁次：8-1

等 別：高等考試

類 科：專利師（選試專業英文及工程力學）、專利師（選試專業英文及生物技術）、專利師（選試專業英文及電子學）、專利師（選試專業英文及物理化學）、專利師（選試專業英文及工業設計）、專利師（選試專業英文及計算機結構）

科 目：專業英文

考試時間：2 小時

座號：_____

※注意：禁止使用電子計算器。

甲、申論題部分：(50 分)

(一)請以英文作答，不必抄題，作答時請將試題題號及答案依照順序寫在申論試卷上，於本試題上作答者，不予計分。

(二)請以藍、黑色鋼筆或原子筆在申論試卷上作答。

一、Claim construction plays a core role in determination of patent infringement. According to the judicial decisions made by the Taiwan Intellectual Property Court, there are two significant sources of evidence—*intrinsic* evidence and *extrinsic* evidence—to support claim construction in the cases of patent infringement. If you were a judge in a case of patent infringement, what your opinion would be about the relationship between *intrinsic* and *extrinsic* evidence when claim construction is undertaken. (30 分)

二、Please translate the following opinion of the Supreme Administrative Court in English: (20 分)

發明是否具進步性應以該發明所屬技術領域中具通常知識者參酌相關先前技術所揭露之內容及申請時之通常知識，是否能輕易完成系爭專利之發明作為判斷標準。若涉及複數引證之技術內容，應考量該發明所屬技術領域中具通常知識者是否有動機結合複數引證之技術內容。判斷該發明所屬技術領域中具通常知識者是否有動機能結合複數引證之技術內容時，原則上係綜合考量「技術領域之關連性」、「所欲解決問題之共通性」、「功能及作用之共通性」及「教示或建議」等事項。

乙、測驗題部分：(50 分)

代號：5701

(一)本測驗試題為單一選擇題，請選出一個正確或最適當的答案，複選作答者，該題不予計分。

(二)共25題，每題2分，須用 2B 鉛筆在試卡上依題號清楚劃記，於本試題或申論試卷上作答者，不予計分。

- 1 According to the TRIPs Agreement, which of the following statements is correct?
 - (A) Members of the WTO are obligated to exclude from patentability diagnostic, therapeutic and surgical methods for the treatment of humans or animals.
 - (B) With regard to conditions on patent applicants, Members of the WTO must require an applicant for a patent to provide information concerning the applicant's corresponding foreign applications and grants.
 - (C) In patent infringement civil proceedings, if the subject matter of a patent is a process for obtaining a product, the judicial authorities of Members of the WTO shall have the authority to order the defendant to prove that the process to obtain an identical product is different from the patented process.
 - (D) Members of the WTO may exclude from patentability inventions, the prevention within their territory of the commercial exploitation of which is necessary to protect *ordre public* or morality, as long as the exploitation is prohibited by their law.
- 2 Which of the following descriptions regarding the priority claim under the R.O.C. Patent Act is incorrect?
 - (A) Where an applicant has first applied for a patent in a foreign country that is a member of the World Trade Organization (hereinafter the "WTO"), the applicant may claim priority in respect of an R.O.C. patent application for the same invention if the R.O.C. patent application for the same invention is filed within twelve months after the filing date of the said first patent application.
 - (B) For a patent application filed with priority, examination on its patentability shall be based on the actual filing date of this patent application, not on the priority date.
 - (C) Where an applicant claims two or more priorities in respect of a patent application, the twelve months period referred to in Article 28, para. 1 of the R.O.C. Patent Act shall be on the basis of the earliest priority date.
 - (D) If a foreign applicant is a citizen of a non-member of the WTO and whose home country does not mutually recognize priority with the R.O.C., but the applicant has domicile or business establishment in any member of the WTO or in the territory of a reciprocal country, the applicant shall also be entitled to claim priority.
- 3 Which of the following statements with regard to patent licensing under the R.O.C. Patent Act is correct?
 - (A) An exclusive license for a patent is not valid until it is recorded with the Specific Patent Agency.
 - (B) An exclusive licensee of a patent has the right to grant sub-license to a third party to exploit the licensed patent unless otherwise agreed by the parties.
 - (C) An exclusive licensee does not have the right to exclude the patentee from exploiting the patented invention.
 - (D) The sub-licensing contract granted by a non-exclusive licensee is not valid until it is recorded with the Specific Patent Agency.

- 4 Which of the following statements regarding the right to apply for a patent is correct?
- (A) Unlike patent right itself, the right to apply for a patent is not inheritable.
 - (B) If there is no agreement providing otherwise, where an invention is made by an employee in the course of performing his/her duties, the right to apply for a patent thereof shall be vested in the employee.
 - (C) Where a right to apply for a patent is jointly owned, the patent application related thereto could be filed by each joint owner individually.
 - (D) Where the right to apply for a patent is jointly owned, the right to apply for the patent shall not be assigned or abandoned without the consent of all joint owners.
- 5 According to Article 34 of the Agreement on Trade-Related Aspects of Intellectual Property Rights, which of the following statements about “proof burden of process patents” is incorrect?
- (A) For the purposes of civil proceedings with respect to the infringement of the rights of the owner, if the subject matter of a patent is a process for obtaining a product, the judicial authorities shall have the authority to order the plaintiff to prove that the process to obtain an identical product is different from the patented process.
 - (B) Any identical product when produced without the consent of the patent owner shall, in the absence of proof to the contrary, be deemed to have been obtained by the patented process if the product so obtained is new.
 - (C) Any identical product when produced without the consent of the patent owner shall, in the absence of proof to the contrary, be deemed to have been obtained by the patented process if there is a substantial likelihood that the identical product was made by the process and the owner of the patent has been unable through reasonable efforts to determine the process actually used.
 - (D) In the adduction of proof to the contrary, the legitimate interests of defendants in protecting their manufacturing and business secrets shall be considered.
- 6 According to Article 3 of the Patent Cooperation Treaty, which of the following statements about “the international application” is incorrect?
- (A) An international application shall contain a request, a description, one or more claims, one or more drawings, and an abstract.
 - (B) The abstract serves the purpose of interpreting the scope of the protection sought.
 - (C) The international application shall be in a prescribed language.
 - (D) The international application shall comply with the prescribed requirement of unity of invention.

- 7 Which of the following is not one of the inventive step inquiries?
- (A) The scope of the prior art.
 - (B) The level of ordinary skill in the pertinent art.
 - (C) Differences between the prior art and the allegedly infringing product at issue.
 - (D) The content of the prior art.
- 8 According to Article 37 of the R.O.C. Patent Act, which of the following statements about “early publication of patent application” is correct?
- (A) After receiving application documents and determining through examination that they conform to the stipulated formality requirements and contain no elements that may be deemed unsuitable for laying open, the Specific Patent Agency shall lay open the patent application for invention, twelve (12) months after its application.
 - (B) The Specific Patent Agency may delay the laying-open of a patent application upon the request of the applicant.
 - (C) If a patent application for invention is withdrawn within fifteen (15) months after its filing date, it shall not be laid open.
 - (D) If a patent application for invention involves national defense secrets or any other secrets pertaining to national security, it shall be laid open.
- 9 Which of the following is not among the grounds for granting compulsory licenses under Article 87 of the R.O.C. Patent Act?
- (A) National emergency or other circumstances of extreme urgency.
 - (B) Where a later invention patent cannot be exploited without infringing upon a prior invention patent, and where the later invention patent involves an important technical advancement of considerable economic significance in relation to the prior invention patent.
 - (C) Where a patented invention is to be exploited non-commercially for the enhancement of public interest.
 - (D) Where a patentee has committed acts restricting competition or has committed unfair competition acts, to be determined by the Specific Patent Agency.
- 10 Which of the following statements regarding patent remedies is correct?
- (A) A patentee of an invention patent may demand a person who infringes to stop only when it is proven that the infringement occurs due to intentional act or negligence.
 - (B) A non-exclusive licensee may claim for damages in case an infringement of invention patent occurs due to intentional act or negligence.
 - (C) The patentee can freely choose any one of the three available methods of calculation of damages under Article 97, para. 1 of the R.O.C. Patent Act.
 - (D) The damages, if calculated based on the profit earned by the infringer as a result of patent infringement under Article 97, para. 1, sub-para. 2 of the R.O.C. Patent Act, the right to claim damages shall become extinguished if not exercised within fifteen (15) years after the patentee has become aware of the damages and the person liable for damages.

- 11 _____ may be a defense to patent infringement when an accused infringer proves that a patentee unreasonably and inexcusably delayed filing an infringement suit to the material prejudice of the accused infringer.
- (A) Patent misuse (B) Illegal conduct
(C) Invalidity of the patent (D) Laches
- 12 According to Article 17 of the R.O.C. Patent Act, which of the following statements about “delay and reinstatement” is correct?
- (A) Where a person filing a patent application or undergoing other proceedings in connection with patent-related matters has failed to comply within a statutory or specified time period, the application filed or the proceeding initiated shall be accepted.
- (B) If the delay of not acting within a specified time period has been remedied before the dismissal decision is served by the Specific Patent Agency, such an application or proceeding shall be denied.
- (C) If the delay of a statutory time period is caused by natural calamities or other causes not attributable to the applicant, the applicant may, within thirty (30) days after cessation of such cause, file a written request with the Specific Patent Agency stating the causes for delay and requesting reinstatement.
- (D) An application for reinstatement shall be accepted if the delay has exceeded one (1) year after the expiration of the statutory time period.
- 13 According to Article 108 of the R.O.C. Patent Act, which of the following statements about “conversion of application for utility model” is correct?
- (A) When a patent application originally filed for invention is converted into a patent application for utility model, the filing date of the original patent application shall be deemed to be the filing date of the converted patent application.
- (B) A request for patent conversion shall be made after a written decision allowing the original patent application is served.
- (C) A request for patent conversion shall not be made if six (6) months have passed after the date on which a written decision rejecting the original patent application for invention or design is served.
- (D) A converted patent application shall extend beyond the scope of content disclosed in the description, claims, or drawings of the original patent application as filed.

- 14 According to Article 30 of the Agreement on Trade-Related Aspects of Intellectual Property Rights, which of the following statements about “exceptions to rights conferred” is incorrect?
- (A) Members may provide broad exceptions to the exclusive rights conferred by a patent.
 - (B) Exceptions to patent rights shall not unreasonably conflict with a normal exploitation of the patent.
 - (C) Exceptions to patent rights shall not unreasonably prejudice the legitimate interests of the patent owner.
 - (D) Exceptions to patent rights shall take account of the legitimate interests of third parties.
- 15 According to Article 31 of the Agreement on Trade-Related Aspects of Intellectual Property Rights, which of the following statements about “other use without authorization of the right holder” is incorrect?
- (A) If other use without authorization of the right holder’s individual merits is considered, the law of a WTO member shall allow for other use of the subject matter of a patent without the authorization of the right holder.
 - (B) In the case of a national emergency, other circumstances of extreme urgency, or public noncommercial use, the requirement that “prior to use without authorization of the right holder, the proposed user has made efforts to obtain authorization from the right holder on reasonable commercial terms and conditions and that such efforts have not been successful within a reasonable period of time” may be waived by the law of a WTO member.
 - (C) In situations of national emergency or other circumstances of extreme urgency, the proposed user shall not notify the right holder.
 - (D) In the case of public noncommercial use, where the government, without making a patent search, knows that a valid patent is or will be used by or for the government, the right holder shall be informed promptly.
- 16 According to Articles 4bis and 4ter of the Paris Convention for the Protection of Industrial Property, which of the following statements is incorrect?
- (A) Patents applied for in the various countries of the Union by nationals of countries of the Union shall be independent of patents obtained for the same invention in other countries, whether members of the Union or not.
 - (B) Patents applied for during the period of priority are independent, both as regards the grounds for nullity and forfeiture, and as regards their normal duration.
 - (C) Patents obtained with the benefit of priority shall, in the various countries of the Union, have a duration equal to that which they would have had they been applied for or granted without the benefit of priority.
 - (D) The inventor has no right to be mentioned as such in the patent.

- 17 In the U.S. Supreme Court case, *Impression Products, Inc. v. Lexmark Int’l, Inc.*, the Court held that, “We conclude that a patentee’s decision to sell a product exhausts all of its patent rights in that item, regardless of any restrictions the patentee purports to impose or the location of the sale.” According to this case holding, which of the following types of exhaustion doctrines is emphasized in this case and the U.S. Patent Act?
- (A) National exhaustion (B) International exhaustion
(C) Regional exhaustion (D) Doctrine of equivalents
- 18 A claim with _____ element shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.
- (A) means-plus-function (B) inventive concept
(C) limitation (D) essential
- 19 According to Article 8 of the R.O.C. Patent Act, which of the following statements about an “invention irrelevant to the performance of duties” is correct?
- (A) When an invention made by an employee has no connection to the course of performing his/her duties, the right to apply for a patent and the patent right of such an invention shall be vested in the party as mutually agreed upon in an agreement between both parties.
(B) If an employee’s invention is made through the utilization of the employer’s resources or experiences, the employer may, after paying the employee a reasonable remuneration, exploit the invention concerned in the enterprise.
(C) After the completion of an invention that has no connection to the course of an employee’s performing his/her duties, the employee shall give the employer an oral notice regarding such an event. If necessary, the employee shall also inform the employer of the creative process.
(D) If the employer fails to raise any objection to the employee within twelve (12) months after receiving the employee’s oral notice, the employer could still claim that such an invention was made by the said employee in the course of performing his/her duties.
- 20 According to Article 14 of the R.O.C. Patent Act, which of the following statements about “an inheritance or assignment of the right to apply for a patent” is correct?
- (A) In the case of an inheritance of the right to apply for a patent, the successor shall have locus standi against any third party even if the patent application was not filed in the name of the successor at the time of filing.
(B) In the case of an assignment of the right to apply for a patent, the assignee shall have locus standi against any third party even though no request has been filed thereafter with the Specific Patent Agency to alter the recordation of the applicant.
(C) In the case of an assignment of the right to apply for a patent, the assignee shall have locus standi against any third party even if the patent application was not filed in the name of the assignee at the time of filing.
(D) Whether for assignment or inheritance, a request that has been filed thereafter with the Specific Patent Agency to alter the recordation of the applicant shall be accompanied by documents of proof.

- 21 Article 22, para. 2 of the R.O.C. Patent Act provides: “An invention that is without the circumstances prescribed in the subparagraphs of the preceding paragraph but can be easily made by a person ordinarily skilled in the art based on prior art shall not be patented.” Which requirement for patent is contained in this provision?
- (A) Inventive step (B) Novelty
(C) Enablement (D) Patentable subject matter
- 22 Which of the following statements regarding patent exhaustion is correct?
- (A) After the sale of a patented product made under consent of the patentee, the patent rights concerning sale and use to that product are exhausted.
(B) The R.O.C. Patent Act does not provide any specific rules regarding patent exhaustion doctrine.
(C) The buyer of the patented product must have purchased the product in the territory of R.O.C. in order for the patent rights to that product to be exhausted.
(D) The patent exhaustion is limited to act of using the product only. It does not extend to the act of reselling the product.
- 23 For computer generated icons (Icons) and graphic user interface (GUI) applied to an article, an application may also be filed pursuant to the R.O.C. Patent Act for obtaining a(n) ____.
- (A) design patent (B) invention patent
(C) utility model patent (D) plant variety right
- 24 Article 22, para. 1 of the R.O.C. Patent Act provides: “An invention which is industrially applicable may be granted a patent upon application in accordance with this Act” The term “industrially applicable” refers to which of the following patent requirement?
- (A) Novelty (B) Inventive step
(C) Enablement (D) Utility
- 25 An invention must be new to be patentable. If the invention is disclosed in the prior art, an invention is not new, that is, it is ____.
- (A) obvious (B) PHOSITA
(C) anticipated (D) sufficiently disclosed