

Basic Concept

The purpose of this book is to help companies which need to train their employees with the ability to understand international OEM/ODM contracts. OEM/ODM contracts are a special type of manufacture/supply agreements and often require a long term supply relationship^❶. Usually in an OEM/ODM relationship, international buyers are in a stronger position and manufacturers are in a weaker one. As anyone can expect, a stronger buyer will insert provisions in an agreement that are favorable to the buyer and a manufacturer quite often is left with an incapability to bargain. Such incapability is caused either by poor bargaining power or the seller's limited understanding to legal languages and framework.

Taiwan enterprises are mainly manufacturers or suppliers in the international supply chain. They may only engage in manufacture as OEM or they may be able to enter the sphere of design as ODM. Only in rare cases can they work as OBM which requires a higher international reputation and management of complicated overseas channels. Employees in such OEM/ODM companies might be asked to deal with issues regarding OEM/ODM related legal affairs which may range from reviewing and modifying purchase orders and contracts to dealing with disputes, including litigation, on product liability and IPR infringements and, in many instances, transaction issues are often beyond their ability to manage. It is our wish that we can, with this book, help those companies which need to train their employees with the ability to understand international OEM/ODM contracts and related issues.

In a typical OEM/ODM case in Taiwan, we will see buyers from the western world placing orders to those manufacturers in Asia. If there is a long term

❶ 王全裕，企業文化與組織變革策略關係之研究，頁E3之3，2005；歐世琳、陳志祥，OEM/ODM合作方式下的協同生產計畫優化模型，武漢理工大學學報，2007年7月，第29卷、第7期。

基本概念

出版這一本書的目的，主要是希望能夠幫助那些有需要了解，以及訓練員工熟悉國際OEM、ODM契約的公司。OEM、ODM契約是一種比較特殊型態的製造生產合約，它通常也比較要求雙方長期供應的關係。通常在OEM、ODM的關係當中，國際買方是處於比較強勢的情況，而製造者則處於比較弱勢的情況。就像我們可以期待，強勢的一方往往會將對自己比較有利的條款放在契約裡面。而製造商對於契約比較沒有能力作任何的改變。這一種無能為力的情況，可能是由比較弱勢的談判實力所造成的，也可能是由於製造商對法律英文以及國際契約架構不夠熟悉。

臺灣企業在國際供應鏈上，主要是擔任製造者或供應者的角色。他們可能只擔任OEM生產者的角色，但也許他們也能夠達到ODM設計者的角色。只有在非常特殊的情況之下，他們可以擔任OBM的角色，而OBM要求較高的國際知名度以及較複雜的海外通路的管理。在這樣OEM、ODM公司工作的人員，常常有責任來處理關於OEM、ODM相關的法律事務，而這個法律事務，包括：審核、修正訂單、契約，關於產品責任與智慧財產權的糾紛與訴訟的處理，有非常多的情況，買賣的糾紛是超過他們能力所能處理的範圍。所以我們盼望，藉由這本書來訓練他們的員工，加強他們對於OEM、ODM的契約以及相關爭議的了解。

在一個典型的OEM、ODM案件裡，我們會看到來自於西方國家的買方，在亞洲對製造商下訂單。如果在買賣雙方是比較長期的商業關係的話，雙方通常會簽訂一個供應／製造契約，來建立未來營運的一個架構，

business relationship between the buyer and seller, both sides will generally sign a supply/manufacture agreement to set up a framework for future operations which is to ensure a stable supply of products with the buyer's expected price. This is the main purpose entertained in most of the buyer's versions of manufacture/supply agreements. This type of international agreement generally is drafted by a strong buyer to his own advantage and is seldom negotiated at an arm's length. This is because the buyer has a stronger international reputation and bargaining power. To accept such contracts prepared by the buyer without reviewing and negotiating, the supplier (or the manufacturer) might be therefore exposed to unfair risk contained in clauses such as tooling, forecast and indemnification clauses (e.g. In an indemnification case, the buyer in a contract explicitly requires a seller to be responsible for the buyer's negligence). Quite often, local businessmen are not aware of the risk existing on terms and conditions contained either in the master agreement or in subsequent purchase orders. On the following two cases, we will see how disputes happen and what approach we should take to solve disputes. A background scenario on how a transaction and a dispute have arisen might be helpful to us to analyze the issues to avoid similar conflicts from happening to us.

[Questions and Comments]

1. What is the framework that a manufacture agreement is built upon? What are its content and purpose? What is a buyer looking for?
2. If you are an international sales person, how can you find out whether a contract drafted by a western buyer contains traps? Will you sign it without knowing its content?
3. An international buyer often has a stronger bargaining side. By "stronger", it generally means that a buyer has a better channel for international sales and more useful patents and designs on the products made. If you are on the weaker side, is there any special approach that you can take while both of you are negotiating on the contract some important terms such as tooling, forecast or indemnification clauses?

以確保製造商能以買方期待的價格穩定的供應產品，這是買方草擬長期供應／製造契約的主要目的。這一類的國際契約通常由較強勢的買方來草擬，好維護他們本身的利益，而這一種契約也很少在平等的地位之下達成協議。這是由於買方有比較高的國際知名度與談判實力所造成的。賣方假設不先經審查契約與談判，直接就接受這樣的契約而簽字的話，賣方無疑直接暴露在契約裡面所包含的不公平風險，例如：模具條款（tooling），以及備料預測條款（forecast）以及有關雙方責任分擔上（例如：買方在因自己的設計過失，對第三人賠償後，買方要求賣方為買方的過失負責）。通常當地的商人，他們不了解在供應契約或是之後的訂單上面所包含的風險。在下面兩個案子當中，我們看到，究竟是怎麼發生的，以及我們應該採取哪種方式來避免這樣的爭議。看一下這些前車之鑑可以幫助我們分析，國際買賣所發生的爭議。

〔問題與評論〕

1. 製造合約的架構是建立在什麼之上？什麼是內容與目的？買家是在找什麼？
2. 如果你是一個國際業務人員，你如何在一份西方買家所草擬的契約中找到陷阱？你會在不知道內容之前就簽字嗎？
3. 國際買方是處於比較強勢的情況，「強勢」意謂買方有比較好的國際通路與效用較高的專利與設計，如果你是處於比較弱勢情況的製造商，在與買方談判契約條款內容時，像是模具、備料或是第三人賠償擔保條款，你會採取何種方式，以達到平等、保護公司利益的目的？

《Case 1》

An American buyer visits a seller in Taiwan. The seller is engaged in a business of toy manufacturing for over 20 years and is a world wide-known supplier. The buyer visits the seller's factory and has a meeting with the seller's design team. Both parties sign a confidentiality agreement. The buyer thereafter shares with the seller's research team his design and the seller's team responds positively with the buyer's request. Both buyer and seller communicate verbally and by e-mails many times. The seller's research team also shares their opinion on how to modify the design originally presented by the buyer for better use and the buyer agrees with them. Therefore the design is modified according to the seller's opinion. Both sides agree that the seller will pay USD\$ 100,000 for tooling and such expense will be amortized within the contract terms by the buyer with the quantity ordered (USD\$ 1 for each unit). Finally, two months later, the buyer reaches an agreement with the seller's management on the product specifications, price, method of payment, tooling and intellectual property rights, and so on. A master agreement of 2 years is signed with details left to the subsequent purchase orders.

The relationship is running smoothly at the beginning but later turns sour after a few disputes over the method of payment. According to the contract, the buyer will make quarterly T/T payments and a "set off" is allowed. In one event, the seller is making a demand for the buyer's quarterly payment of USD\$ 1,000,000, yet the buyer is claiming a "set off" of USD\$ 150,000 because the seller's delivered non-conforming products in the past. The buyer claims that such damages caused by delivery of the non-conforming goods should be deducted from the quarterly payment. However, the seller is upset because the buyer is extremely picky with the quality of the products and, the amount the buyer purchases yearly is only counted as 10%, USD\$ 3,000,000, of the seller's yearly turnover of USD\$ 30,000,000, yet the amount of products the buyer rejects is about 15%, USD\$ 750,000, of the seller's total rejected goods of USD\$ 5,000,000 in that year.

《案例一》

一個美國買家訪問在臺灣的賣家。賣家從事玩具生產超過20年的時間，是一個國際知名的供應商。買家訪問賣家的工廠之後，與賣家的設計團隊開會，雙方簽訂了保密協定，買方因此將他的設計與賣方的研究團隊分享。而賣方的研究團隊對於買方的要求也都予以正面肯定。買方與賣方利用口頭與e-mail溝通非常多次，賣方的研究團隊，同時也將他們如何使原設計成為更好的意見，與買方分享，而買方也同意他們的設計理念。所以，設計最初是由買方所提供，但是卻由賣方所修正。雙方同意賣方負責開模，費用是美金10萬元，而這個費用會由買方在契約期限之內，按照訂單所購買的數量（每一個單位一美金），逐步攤還。在兩個月之後，買方與賣方的管理階層，就產品規格、價格、付款方式、模具及智慧產權部分達成協議。雙方簽訂主要供貨契約，期限兩年，細節部分則交由之後的訂單來處理。

雙方的關係一開始還好，但是在幾次付款上面的爭議之後，逐漸變差了。根據契約，買方應該在每一季結束的時候，用T/T來付款，以及雙方債權債務的（抵賬）是許可的。在一次場合當中，賣方要求買方支付當季貨款美金100萬元。但是買方主張抵銷美金15萬元，因為賣方在過去交付了不合規定的貨物。買家聲稱這些不合規定的貨物造成的損害，所以應該從當季的貨款當中扣除。但是，賣家非常的不高興，因為買家對於貨物的品質，極端的挑剔；再者，買家每一年所買的貨物，僅相當於賣家一年營業量（美金3,000萬元）的10%，也就是美金300萬元，但是買家的退貨率卻高達賣家當年所有退貨率（美金500萬元）的15%，也就是（美金75萬元）。

The seller is threatening to terminate the contract and to stop delivery. The seller also refuses the buyer's request to return the moulds. The buyer is extremely angry with such "threat" because this might cause the buyer's to breach with many his clients in the United States^②. The buyer therefore threatens to sue for breach of contract and patent infringement and both sides hold meetings for negotiation.

CASE ANALYSIS

1. Confidentiality agreement

- a. A confidentiality agreement drafted by a buyer reveals that the buyer (a) desires to protect information of the "proprietary nature" and (b) requires that the manufacturer's confidential treatment of such information to have limited use in the strict business sense of use and (c) restricts a seller's use for the buyer's interest only.

The scenario in case 1 serves as a good illustration of a regular business operation of Taiwan OEM/ODMs. In a typical OEM/ODM relationship, forms of contracts for different purposes will be signed in sequence between a buyer and a seller to ensure of their longer cooperative supply relationship. The first to be signed is a confidentiality agreement which, also known as Non Disclosure Agreement, is signed before valuable information is divulged by a buyer to a manufacturer. Not all information is restricted except that of the proprietary nature relating to, for example, patent, design, marketing, customers or trade. In a confidentiality agreement drafted by a buyer, we can see that buyer (a) desires to protect information of the "proprietary nature" and (b) requires that the manufacturer's confidential treatment of such information to have limited use in the strict business sense of use and (c) restricts a seller's use for the buyer's interest only.

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^② Usually, buyers are buying for re-sell in the United States in this case. If the manufacturer stops delivery, the buyer will be forced either to buy same/similar products from the market often with a higher price or to breach the contract with the buyer's clients.

賣方威脅要終止契約，並不再出貨。賣方同時也拒絕了買方將模具歸還的要求。買方對於這樣的威脅感到非常的憤怒，因為賣方的行為很可能會導致買方與其他美國客人的違約。買方因此也威脅要控告賣方違約以及專利侵權。接著雙方展開了談判的會議。

〔案件分析〕

1. 保密契約

- a. 在一個買方所草擬的保密契約中，透露出買方(a)希望保護具有財產價值的訊息；(b)要求製造商只能在很嚴格的商業用途下，以保密的方式，使用該訊息；以及(c)限定製造商只能為買方利益而使用。

案例一的情況，是臺灣OEM/ODM平常商業運作模式的很好寫照。在一個典型的OEM/ODM關係中，買賣雙方，在不同的時間會就不同目的契約簽字，用來確保他們長期合作的供應關係。首先簽字的是保密契約，同時也稱作NDA。買方於簽字後，會將具有價值的訊息，透露給製造商。不是所有的訊息都受限，除了那一些具有財產價值的訊息，比方說專利、設計、市場資訊、消費者或是貿易資訊。在一個買方所草擬的保密契約中，我們可以看到買方(a)希望保護具有財產價值的訊息；(b)要求製造商只能在很嚴格的商業用途下，以保密的方式，使用該訊息；以及(c)限定製造商只能為買方利益而使用。

Examples commonly seen in an agreement regarding confidentiality treatment includes: a. requiring all envelopes be marked with “confidential”, allowing accessible information only to some restricted manufacturer’s personnel, a prior notice and written approval is required from the buyer before the information is shared with any third party such as subcontractors and the return of all materials once the manufacture agreement is terminated.

b. A typical exclusive clause regarding jurisdiction of a foreign court may exclude a buyer’s remedy for injunctive relief from a Taiwan local court.

A typical confidentiality agreement, generally drafted by a buyer, carries the provisions allowing injunctive relief which will permit a buyer to take action through local courts, which are usually located where a manufacturer resides or established, to prohibit a manufacturer from illegal disclosure. Interestingly, the very same agreement provides as well that the governing law and jurisdiction of any disputes arising from this agreement shall be the buyer’s home courts, for example, the state court of California.

Here comes the question: Which court should the buyer turn to for remedy? Time is always of essence in such situation. If the buyer initiates legal action in California to stop a manufacturer’s disclosure, obviously it might be too late since location of illegal disclosure is in Taiwan and California’s courts decision requires Taiwan courts’ approval for enforcement in Taiwan. Taiwan court may not necessarily grant such permission. The buyer’s other choice is to bring a lawsuit into a Taiwan local court. As you can see from a typical clause, it regards the governing law and jurisdiction in the buyer’s version of the agreement, “This agreement shall be governed by, and construed and enforced in accordance with, the laws of the state of California. The state court of California shall have an exclusive jurisdiction over any disputes arising from this agreement.” The manufacturer could argue before a Taiwan local court that, in accordance with the confidentiality agreement signed, any dispute should be referred to the California state court rather than the Taiwan court for the solution. In other words, the manufacturer may reasonably argue that the California court has an exclusive jurisdiction over this dispute. Therefore, Taiwan court has no jurisdiction in this case. This case might be dismissed from the Taiwan court and, if that is so, the buyer might lose his protection on injunction.

關於保密處理資訊的方式，常見的例子有要求所有的信封記載「機密」，只准許製造商、特殊人員使用該訊息，若要跟任何第三人，比如與承包商分享訊息時，應該通知買方並取得書面同意，以及在製造契約終止後，歸還由買方取得的所有文件。

- b. 一個典型外國法院專屬管轄權的條款，可能會排除買方向臺灣當地的法院尋求強制執行的救濟管道。

一個典型的保密契約，通常都是由買方所草擬，條款當中會准許買方向當地的法院，也就是製造商所居住或是公司設立的地方，申請禁止令，來禁止製造商的非法透露訊息。很有趣的，同一份約也記載與本約有關的任何爭議、管轄法律以及管轄法院，應該是買方的本國法院，例如：加州法院。

現在有個問題，究竟是哪一個法院，買家應該尋求救濟。在這個不當洩密的案件中，時間是很急迫的。如果買家在加州法院起訴，很明顯一切都會太遲。因為洩密地點在臺灣，而加州法院的判決，需要臺灣法院的承認，才能在臺灣執行。而臺灣法院不一定會承認加州法院的判決。買家的另外一個選擇，是在臺灣地方法院起訴。你可以在買方版本的契約中，看到一個這樣關於管轄法律，與管轄法院的典型條款，「本約應該依照加州法律來詮釋並執行。加州法院對因本約所生任何爭議有專屬管轄權。」製造商可以在臺灣法院前面辯稱，依據雙方的保密協定，任何爭議應該由加州法院，而不是臺灣法院來管轄。換句話說，製造商可以很合理的辯稱，加州法院在這樣的爭議中，是唯一有管轄權的，因此臺灣法院在本案沒有管轄權。這樣的案件有可能被臺灣法院駁回，買家因此失去他在禁止令上面的保護。