



# ICLG

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## Patents 2016

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# Taiwan



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## 1 Patent Enforcement

### 1.1 How and before what tribunals can a patent be enforced against an infringer?

The Intellectual Property (IP) Court has jurisdiction over all patent infringement actions in Taiwan. Established on 1 July 2008 in New Taipei City, the IP Court is a specialist court intended exclusively for IP-related cases all over Taiwan. Before 1 July 2008, patent infringement cases were brought in district-level courts where the defendant was resident or located, or where infringing activities took place. Infringement proceedings are now commenced in the IP Court by filing a complaint with details of the parties, the cause of action and the relief sought.

### 1.2 What are the pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

The pre-trial (preparatory) procedural stages include: (i) preliminary review of the complaint to ensure procedural formalities are met and if not, requirement that they be remedied where possible; (ii) first exchange of briefs (i.e. service of the complaint on the defendant and service of the defendant's answer, which may contain procedural and substantive defences); (iii) designation of a Technical Examination Officer by the court where appropriate – the court typically finds a Technical Examination Officer necessary unless the patent-in-suit relates to an easily understandable technology; (iv) second exchange of briefs (i.e. exchange of written statements setting out disputed issues and admissions); and (v) preparatory hearing to confirm the disputed issues, determine the scope and order for evidence to be presented and fix the trial schedule. In general, the pre-trial procedural stages will take about four to six months.

### 1.3 Can a defence of patent invalidity be raised and if so how?

Yes, this is raised typically as part of the defendant's answer or other preparatory briefs, along with copies of documents supporting the grounds of invalidity. Absent exceptional circumstances, invalidity should be raised only during pre-trial (preparatory) stages.

### 1.4 How is the case on each side set out pre-trial? Is any technical evidence produced and if so how?

Before the trial stage begins, the parties must submit written statements and supporting documents which relate to: (i) facts and arguments based on the disputed issues; (ii) factual evidence to be presented and/or investigated; (iii) if applicable, grounds of invalidity and the prior art references relied upon; (iv) experts' reports; and (v) where the parties intend to call an expert witness at trial, background information of the witness. A copy of each party's written statements will be served on the adversary and the court will generally allow appropriate time (usually two to four weeks) for the adversary to prepare their response. Where invalidity is in issue, the court may exercise discretion to order the Taiwan Intellectual Property Office (Taiwan Patent Office, TIPO) to intervene in the action to provide their technical opinion, although in practice the court rarely does this. With regard to the issue of infringement, it is also possible for the parties to request that the court designate an experienced organisation or specialist to conduct an assessment of whether the claims are infringed as contended.

### 1.5 How are arguments and evidence presented at the trial? Can a party change its pleaded arguments before and/or at trial?

Pursuant to Article 255 of the Taiwan Code of Civil Procedure, after the service of the complaint, the Plaintiff may not amend his/her claim or raise additional claims, except in cases where: (i) the defendant agrees; (ii) the amendment or addition of the claim is based on the same transaction or occurrence; (iii) only the demand for judgment for the relief sought is expanded or reduced; (iv) a change of circumstances makes it necessary to replace the original claim with another claim; (v) the claim shall be adjudicated jointly when those who are not parties are joined as parties; (vi) the existence or non-existence of a certain legal relation, based upon which relation the case shall be decided, becomes disputed in the course of the proceeding and an additional claim for a declaratory judgment confirming such legal relation against the defendant is raised; and (vii) it would neither severely obstruct the defendant's defence nor delay litigation. Where the defendant proceeds orally on the merits without objecting to the amendment or addition of claims, he/she shall be deemed to have agreed to such amendment or addition.

It should also be noted that supplementing or rectifying factual or legal statements without changing the claim shall not be deemed an amendment or addition of claims (§256 of the Taiwan Code of Civil Procedure).

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**1.6 How long does the trial generally last and how long is it before a judgment is made available?**


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The trial typically consists of more than one day and may span up to four months. A written judgment is generally handed down by the judge two weeks after the trial is closed, a copy of which will be served to the parties about 10 days later.

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**1.7 Are there specialist judges or hearing officers and if so do they have a technical background?**


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The judges in the IP Court are all specialist judges with expertise in trying IP cases; some of the judges have a technical background. The Technical Examination Officers, who act as technical assistants to the judges, are mostly senior examiners of the TIPO and all of them have technical backgrounds, as well as experience in patent examination and assessment.

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**1.8 What interest must a party have to bring (i) infringement (ii) revocation and (iii) declaratory proceedings?**


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- (i) The plaintiff must be the owner of the patent, or an exclusive licensee with proper licensing registration at the TIPO.
- (ii) The claimant need not have any interest, except when the purported ground of revocation is (a) the patent application was not properly filed by all joint owners, or (b) the patent was issued to someone not legally entitled to file for the patent, only an “interested party” (e.g. a party who claims to be the legitimate applicant) can bring revocation proceedings.
- (iii) An action for a declaratory judgment confirming a legal relation may only be initiated by a party who has made a showing that he has immediate legal interest in seeking such a declaration. For example, a party who shows he is aggrieved by allegations of patent infringement or threats of infringement proceedings may bring an action for a declaration that the defendant’s claim for infringement does not exist.

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**1.9 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?**


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Yes. A party in a civil action may move the court to order the opposing party to produce documentary evidence in the opposing party’s possession. The motion must specify the relationship between such documentary evidence and the disputed fact to be proved, as well as the legal ground for the opposing party’s duty to produce such documents or materials. Under the Code of Civil Procedure, a party has the duty to disclose: (i) documents that such party has made reference to in the course of the proceedings; (ii) documents which the other party may require the delivery or inspection of pursuant to applicable laws; (iii) documents which were made for the interest of the other party; (iv) commercial accounting books; and (v) documents which were made in respect of matters relating to the action (the party may refuse to produce such documents on the ground of privacy or trade secrets). Where a party to a patent infringement action fails to produce relevant documents in accordance with a court order without justifiable reasons, the court may, at its discretion: (i) take the opposing party’s allegation with regard to such documents to be true; (ii) impose a fine of up to TWD 30,000 (GBP 600); and/or (iii) force production of such documents by an order of enforcement.

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**1.10 Can a party be liable for infringement as a secondary (as opposed to primary) infringer? Can a party infringe by supplying part of but not all of the infringing product or process?**


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The Taiwan Patent Act does not expressly provide for liabilities of a secondary infringer. Therefore no legal basis is available for claiming secondary infringement under the Patent Act. However, patent owners have attempted to rely on Article 185 of the Civil Code (joint liabilities for “instigators and accomplices” of a tort) to seek relief against secondary infringers, with success to a certain extent. For example, a person who supplies the essential parts of an infringing article (but not all of it) to the primary infringer with knowledge that they are to be used for the infringement, or a person who induces or instructs the primary infringer to engage in the act of infringement may be held jointly liable for infringement.

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**1.11 Can a party be liable for infringement of a process patent by importing the product when the process is carried on outside the jurisdiction?**


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Under Article 58(2) of the Patent Act, unless otherwise provided for in the Act, the patentee of a patented process shall have the exclusive right to preclude others from using such process and using, selling or importing for the above purposes the articles made through direct use of the said process without his/her prior consent. Accordingly, a party can be liable for infringement of a process patent by importing the product, even though the process is carried on outside the jurisdiction.

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**1.12 Does the scope of protection of a patent claim extend to non-literal equivalents?**


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Yes. In practice, the Taiwan Court applies the “doctrine of equivalents” (the function/way/result rule) to extend protection to non-literal equivalents, provided that the accused product or process must contain corresponding elements identical or equivalent to each claimed element of the patent under the “all-elements rule”.

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**1.13 Other than lack of novelty and inventive step, what are the grounds for invalidity of a patent?**


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The principal grounds are:

- (i) lack of industrial applicability;
- (ii) insufficiency of disclosure in the written description (lack of enablement);
- (iii) the scope of claims is not supported by the description and drawings;
- (iv) pre-grant amendments which exceeded the scope of specification, claims or drawings originally filed;
- (v) where the patent application right was jointly owned, the application was not filed by all joint owners;
- (vi) the patent was granted to someone not entitled to file for the patent; and
- (vii) the home country of the patentee does not accept patent applications filed by Taiwan nationals.

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**1.14 Are infringement proceedings stayed pending resolution of validity in another court or the Patent Office?**


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No. Article 16 of Taiwan’s Intellectual Property Case Adjudication Act requires that the IP Court may not suspend or stay the

proceedings pending resolution of validity in the TIPO or the Administrative Court.

### 1.15 What other grounds of defence can be raised in addition to non-infringement or invalidity?

In addition to non-infringement or invalidity defence, the infringer may raise the following defences: (i) no damages should be awarded due to the patent owner's non-compliance with patent marking requirements; (ii) no damages should be awarded because the defendant lacks the subjective intention or negligence on which an award of damages must be based; (iii) the patent was exhausted; (iv) the plaintiff was an exclusive licensee who did not register the licence with the TIPO; and (v) the plaintiff's claim was time-barred (see question 1.20 below).

### 1.16 Are (i) preliminary and (ii) final injunctions available and if so on what basis in each case?

Both preliminary and final injunctions are available.

- (i) A preliminary injunction (known as an "injunction maintaining the temporary *status quo*") is granted if the claimant can show that an injunction is necessary to prevent material harm or imminent danger or other similar circumstances exist. The factors generally considered by the court to determine whether a preliminary injunction is warranted include: (a) the likelihood of success on the merits of the case (both invalidity and infringement would be considered); (b) whether the claimant would suffer irreparable harm absent an injunction; (c) the balance of interests between both parties; and (d) the impact on the public interest (particularly in pharmaceutical cases).
- (ii) Final injunctions are typically granted if the claimant is successful at trial in establishing that (a) the patent is infringed and not invalid, and (b) the defendant is currently engaging in infringing activities or is likely to engage in infringing activities in the future.

### 1.17 On what basis are damages or an account of profits estimated?

Under Article 97 of the Patent Act, the plaintiff has three options to choose from as the basis for assessing the quantum of damages:

- (i) the method provided in Article 216 of the Civil Code; the patentee may claim damages based on the amount of the balance derived by subtracting the profit earned through exploiting the patent after infringement from the profit normally expected through exploiting the same patent, if no method of proof can be produced to prove the damage suffered;
- (ii) the profit earned by the infringer as a result of patent infringement; and
- (iii) the equivalent amount of royalty that may be collected from exploiting the invention patent under licensing.

Also, under Paragraph 2, Article 97 of the Patent Act, where the infringement is found to be intentionally committed, the court may, upon request and on the basis of the severity of the infringement, award the damages greater than the loss suffered but not exceeding three times of the proven loss.

### 1.18 What other form of relief can be obtained for patent infringement?

Upon the plaintiff's request, the court may order the destruction of infringing goods, raw materials and equipments used for infringing activities or other necessary disposals.

### 1.19 Are declarations available and if so can they address (i) non-infringement and/or (ii) claim coverage over a technical standard or hypothetical activity?

- (i) Declarations are available to address non-infringement, provided that the party seeking the declaratory relief has the interest indicated in question 1.8 (iii) above.
- (ii) In general, declaratory proceedings can only be initiated in respect of a disputed "legal relation" or "existence or nonexistence of facts from which a legal relation arises". The court is unlikely to entertain declaratory proceedings to address claim coverage over a technical standard or hypothetical activity as the declaration sought here is not considered to be a "legal relation" or "fact from which a legal relation arises".

### 1.20 After what period is a claim for patent infringement time-barred?

The claim to seek damages for patent infringement is time-barred after a two-year period from when the patent owner becomes aware of the infringement and the infringer, or a 10-year period from the time the infringement takes place, whichever expires earlier.

### 1.21 Is there a right of appeal from a first instance judgment and if so is it a right to contest all aspects of the judgment?

Yes, the losing party (if the party lost the case in whole or in part) may appeal against the judgment unfavourable to it. While it is generally considered a liberal right to contest all aspects of the judgment, the Court of Appeal will not allow a party to present a new contention or defence, unless it can be shown that the new contention or defence is based on facts that occur after the first instance judgment is handed down or could not have been presented in the first instance due to reasons not imputable to that party.

### 1.22 What are the typical costs of proceedings to first instance judgment on (i) infringement and (ii) validity; how much of such costs are recoverable from the losing party?

Costs are incurred mostly from court fees and attorney fees. A court fee is the money that the plaintiff must pay to the court when bringing an action. Court fees are part of 'litigation expenses', which can ultimately be recovered from the losing party. The amount of the court fee is approximately one per cent of the value of claim which is to be assessed at the discretion of the court. The level of attorney fees varies depending on how complicated the case is and whether invalidity is raised. The average attorney fees through to a first instance decision for an infringement action where invalidity is not in issue are in the range from TWD 500,000 to TWD 750,000.

(GBP 10,000 – GBP 15,000); where invalidity is raised (which is the typical case), the fees range from TWD1 million to TWD1.5 million (GBP 20,000 – GBP 30,000). Attorney fees for the first and second instance are to be borne by each party themselves; they are not recoverable from the losing party.

**1.23 For countries within the European Union: What steps are being taken in your country towards ratification, implementation and participation in the Unitary Patent Regulation (EU Regulation No. 1257/2012) and the Agreement on a Unified Patent Court? For countries outside of the European Union: Are there any mutual recognition of judgments arrangements relating to patents, whether formal or informal, that apply in your country?**

Taiwan has not concluded with any other country any agreement on mutual recognition of judgment in relation to patent right. Even so, any foreign national/entity may request from a Taiwan court the recognition of a final foreign judgment to seek compulsory execution in Taiwan. However, a Taiwan court will not recognise a foreign judgment in the following circumstances where (1) a foreign court lacks the jurisdiction in accordance with the laws of Taiwan, (2) a default judgment is rendered against the losing defendant, except in the case where the notice or summons of the initiation of action have been legally served in a reasonable time in the foreign country or have been served through judicial assistance provided under Taiwan's laws, (3) the content of the foreign judgment or the proceeding of the relevant patent lawsuit is contrary to the public order or good morals of Taiwan, and (4) no mutual recognition is conducted by and between Taiwan and the relevant foreign country. The mutual recognition refers to judgment recognition, instead of recognition of state. Generally Taiwan court recognises a foreign judgment rendered by a foreign court, unless the said foreign court does not expressly refuse to recognise a Taiwan judgment.

## 2 Patent Amendment

**2.1 Can a patent be amended *ex parte* after grant and if so how?**

Yes, by filing an application for amendment to the TIPO (answers to questions 2.1 through to 2.3 discuss only post-grant amendments). Upon approval, the amendment will be published by the TIPO in the Patent Gazette. The amendment will have retroactive effect backdated to the filing date of the patent.

**2.2 Can a patent be amended in *inter partes* revocation proceedings?**

**Yes.** *Inter partes* revocation proceedings are filed to the TIPO, in which the patent owner may propose an amendment or the TIPO may, at its discretion, instruct the patent owner to make the appropriate amendment. The TIPO must notify the party seeking revocation of the proposed amendment.

**2.3 Are there any constraints upon the amendments that may be made?**

In terms of post-grant amendments, the amendments can only be made in accordance with one of the following:

- (i) to delete claims;
- (ii) to narrow down the scope of claims;

- (iii) to correct erroneous descriptions or erroneous translation; and
- (iv) to clarify ambiguous descriptions.

Furthermore, the amendments must not “exceed the scope of disclosure made in the Chinese specification, claims or drawings originally filed” or “substantially expand or alter the scope of claims” in any event except for the correction on erroneous translation.

As to the correction of erroneous translation, it cannot exceed the scope of disclosure of the foreign-language specification originally submitted.

## 3 Licensing

**3.1 Are there any laws which limit the terms upon which parties may agree a patent licence?**

Yes, restrictive terms of a patent licence which result in anticompetitive effects are prohibited under the Fair Trade Act and the Fair Trade Commission Guidelines on Technology Licensing Arrangements. The following are some of the examples listed under Article 6 of the said Guidelines as potential violations of the Fair Trade Act to the extent they lessen competition or impede fair competition in the relevant market: (i) restrictive arrangements with respect to marketing methods, scope of use or trading counterparts, in order to achieve the goal of market segmentation; (ii) requirements that the licensee purchase, accept, or use other patents not needed by the licensee; (iii) requirements that the licensee exclusively grant back any improvements to the licensed patent; (iv) price-fixing; (v) restrictions on the licensee's ability to challenge the validity of the licensed patent; and (vi) limitations on output.

**3.2 Can a patent be the subject of a compulsory licence and if so how are the terms settled and how common is this type of licence?**

Yes, an invention patent (but not utility model and design patents) can be the subject of a compulsory licence. Under Article 87 of the Patent Act, the TIPO may grant a compulsory licence to an applicant on one of the following grounds: (i) in order to cope with national emergencies; (ii) to make non-profit use of a patent for enhancement of public welfare; (iii) if the applicant has failed to reach a licensing agreement with the patentee after making commercially reasonable offers to the patentee; or (iv) if a judgment or Fair Trade Commission decision confirmed that the patentee has engaged in anticompetitive conduct with respect to exercise of its patent rights. The grantee of a compulsory licence should pay to the patentee “appropriate compensation”, which is to be determined by the TIPO in the event that the parties fail to settle the amount. Compulsory licences are not so common in Taiwan; it is our understanding that only two compulsory licences have been granted by the TIPO to date.

## 4 Patent Term Extension

**4.1 Can the term of a patent be extended and if so (i) on what grounds and (ii) for how long?**

According to Article 50 of the Patent Act §53 (came into force on January 1, 2013), for an invention patent directed to a pharmaceutical or agrichemical(s), or the manufacturing process thereof, of which the exploit needs to obtain a regulatory approval pursuant to other acts or regulations (e.g. marketing authorisation required under the

Pharmaceutical Affairs Act), if the regulatory approval is obtained after the publication of the concerned invention patent, the patentee may apply for one and only one extension of the patent term of said invention patent based on the first regulatory approval. Said regulatory approval is only allowed to be used once for seeking patent term extension. Also, the term “pharmaceutical” set forth in the provision does not include any veterinary drug.

It should be noted that the extension of the patent term approved shall not exceed the length of time when the patent cannot be exploited because of absence of the regulatory approval concerned from the central government authorities in charge of the business. If the time needed to obtain said regulatory approval exceeds five years, the granted patent term extension shall be five years.

## 5 Patent Prosecution and Opposition

### 5.1 Are all types of subject matter patentable and if not what types are excluded?

Article 24 of the Patent Act stipulates that an invention patent shall not be granted in respect of any of the following: (1) animals, plants, and essential biological processes for the production of animals or plants, except processes for producing microorganisms; (2) diagnostic, therapeutic and surgical methods for the treatment of humans or animals; and (3) inventions contrary to public order or morality.

### 5.2 Is there a duty to the Patent Office to disclose prejudicial prior disclosures or documents? If so, what are the consequences of failure to comply with the duty?

No. Although the Enforcement Rules of the Patent Act provide that applicants “may submit prior art materials related to the claimed invention”, they do not have a duty to disclose prejudicial prior disclosures or documents.

### 5.3 May the grant of a patent by the Patent Office be opposed by a third party and if so when can this be done?

No. A challenge of the grant of a patent by a third party can only be achieved through revocation proceedings brought at the TIPO.

### 5.4 Is there a right of appeal from a decision of the Patent Office and if so to whom?

Yes, decisions of the TIPO can be appealed to the Appeal Board of the Ministry of Economic Affairs on the grounds that the decision is illegal and/or inappropriate; decisions of the Appeal Board can be further appealed to the IP Court on the grounds that the decision is illegal.

### 5.5 How are disputes over entitlement to priority and ownership of the invention resolved?

Issues as to entitlement to priority are generally determined by the TIPO during prosecution of the patent application. The applicant may appeal the TIPO’s decision to the Appeal Board of the Ministry of Economic Affairs. Disputes over ownership (e.g. as between joint inventors, employer and employee or non-related parties) can

be brought before the TIPO during revocation proceedings, but as the TIPO tends to advise the parties to seek resolution of the dispute through a civil action where the rules of evidence-taking can better facilitate examination and determination of contested facts, the claimant currently often seeks civil action directly to resolve the ownership issues by requesting the court to order that the patent in issue be transferred to the claimant.

### 5.6 Is there a “grace period” in your country and if so how long is it?

Yes, there is a “grace period” in Taiwan and it is six months from the date of the occurrence of events (Paragraph 3 of Article 22 of the Patent Act).

### 5.7 What is the term of a patent?

The term of a patent is as follows: for invention patents, 20 years from filing; for utility model patents, 10 years from filing; and for design patents, 12 years from filing.

## 6 Border Control Measures

### 6.1 Is there any mechanism for seizing or preventing the importation of infringing products and if so how quickly are such measures resolved?

In addition to preliminary injunction, a patent owner may act upon the newly-added provisions of Article 97-1 – Article 97-4 (**this took effect on March 24, 2014**) to file a request in writing with the customs for detention of suspected infringing goods when he/she has a suspicion of infringement, provided that the patent owner shall present the facts of infringement and provide a cash deposit or security equivalent to the duty-paid price of the potentially infringing goods as assessed by the customs. However, the owner of the detained goods may also provide a counter security in an amount equivalent to two times the amount provided by the patent owner to have the granted request repealed. In addition, should the patent owner fail to commence an action within 12 days upon receipt of the customs’ notice and notify the customs of his/her initiation of the action, the customs will repeal the detention. Further, where court determines and establishes the infringement by a final judgment, the owner of the detained goods shall bear the cost arising from demurrage, warehousing, loading, and unloading the detained goods. On the contrary, the patent owner shall be liable for the damages caused by the detention request to the owner of detained goods if the court clears the alleged infringement by a final judgment.

## 7 Antitrust Law and Inequitable Conduct

### 7.1 Can antitrust law be deployed to prevent relief for patent infringement being granted?

While antitrust law may impose penalties (fines and/or even criminal charges) on patent owners who abuse their patent rights with anticompetitive consequences, the general view is that it cannot be deployed to render a patent invalid or unenforceable. There has never been a case where a defendant successfully relied on antitrust law to prevent relief for patent infringement being granted.

## 7.2 What limitations are put on patent licensing due to antitrust law?

See question 3.1 above.

## 8 Current Developments

### 8.1 What have been the significant developments in relation to patents in the last year?

- (i) To enhance patent right protection, relevant provisions with respect to border protection measures are included in the Patent Act, by which a patent owner may file a request for the Customs' detention of suspected infringing goods at the border (see question 6.1).
- (ii) On April 1, 2015, Taiwan IPO launched a new programme to accept requests for deferring substantive examination on invention patent applications, except in any of the following scenarios:
  - (1) An office action has been issued for the application in question or the application in question has been approved.
  - (2) A request for division of the application in question has been filed.
  - (3) A third party has filed a request for substantive examination on the application in question.
  - (4) A request for examination under AEP or PPH programme has been filed for the application in question.

Applicants may file the deferral request at the same time of or after filing a request for substantive examination, but no later than three years from the filing date of the application in question. In addition, where the applicant has claimed priority for the application in question, the aforesaid three-year period shall begin from the date when the applicant filed the application in question in Taiwan.

### 8.2 Are there any significant developments expected in the next year?

- (i) The Taiwan IPO is preparing and drafting the "*Examination Guidelines for Amendment to Utility Model Patents*". The draft is now available to the public for viewing and the first public hearing will be held in mid-June, 2015. Utility model patent rights are uncertain and unstable due to the absence of substantive examination in the patent prosecution process; however, substantive examination on any amendment, if any, requested by the patentee of a utility model patent would lead to an extremely imbalanced situation. Therefore, any amendment requested by a patentee for his/her utility model patent will only go through a formality examination, so as to not affect public interests. The formality examination on the amendment of a utility model patent will not involve substantive requirements, but simply focus on whether the content of the requested amendment complies with the formal requirements in the prosecution process and whether the requested amendment **obviously extends** beyond the scope of content disclosed in the claim(s) or drawing(s) as published (hereinafter referred to as the "obvious extended content"). According to the draft *Guidelines*, the "examination on the obvious extended content" is simply a comparison with the amended content in its formality and the basis of comparison is limited to the scope of claim(s) or drawing(s) as published. As to the "comparison in formality", this refers to a decision on whether the requested amendment either increases any content(s) not disclosed in the scope of claim(s) or drawing(s) that has been published, or deletes part of the technical features of the scope of claim(s) or drawing(s) that

has been published. If the requested amendment is to either, "in its formality", increase any content(s) not disclosed in the scope of claim(s) or drawing(s) published, or deletes part of the technical features (structures, ingredients, steps, or combination(s) thereof, etc.), the requested amendment should be sustained as the "obvious extended content" without examining whether the requested amendment "substantially" broadens or changes the scope of claim(s) of the utility model patent in question.

- (ii) The Taiwan IPO is also researching and preparing a new version of *Guidelines for Patent Infringement Analysis*. The new version will provide more clarifications on the interpretation of claim(s). (For example, whether or not the description in patent specification should be taken as reference for claim construction), applicability of doctrine of equivalents (as-a-whole analysis or element-by-element analysis), and limitation(s) thereon (such as, application for prosecution history estoppels and dedication rule).

### 8.3 Are there any general practice or enforcement trends that have become apparent in Taiwan over the last year or so?

Under the current Patent Act, there are some measures which will significantly influence those who will file a patent application in Taiwan.

#### 1. Corrections to erroneous translations

Corrections to erroneous translations in the Chinese specification during prosecution and post grant cannot exceed the scope of disclosure of the foreign-language specification originally submitted (Article 44, Article 67).

#### 2. Timing of filing divisional application

Applicants may file a divisional application within either of the following time limits:

- (1) within 30 days of receipt of the Notice of Allowance for parent application rendered at the primary examination stage; and
- (2) before the Final Decision for parent application rendered at the re-examination stage (if the parent application is rejected at the primary examination stage and enters the re-examination stage) (Article 34).

#### 3. Timing for submitting voluntary amendments

Applicants may submit voluntary amendments to the specification and/or claims before receiving the first Office Action from TIPO (Article 43).

#### 4. Submission of final notice prior to rejection

When deemed necessary, examiners may issue a final notice prior to rejection, requiring applicants to conduct the following amendment to the claims within a specific time limit:

- (1) to delete claims;
- (2) to narrow down the scope of claims;
- (3) to correct the erroneous descriptions; and
- (4) to clarify the ambiguous descriptions (Article 43).

On the other hand, a programme on "Collective Interviews for Relevant Invention Patent Applications" was set up by TIPO to step up acquisition of patent protection for R&D and innovative creations by the industry, academia and individual inventors and to facilitate formulation of well-established patent strategy and portfolio. The programme, which was implemented on 1 October 2012, allows applicants to file for a collective examination for their invention patents, where examiners through group interviews can quickly grasp the technical aspects in each application, thereby speeding up patent examination, with enhanced effectiveness. Through its recent announcement, TIPO relieved certain restraints from filing under this programme while reserving its sole discretion to amend or terminate the programme.

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Mr. J. K. Lin became the director of TIPLO in 1997, after TIPLO's founder Mr. M. S. Lin passed away. In his earlier tenure as the director of the firm, J. K. set out to further streamline the hierarchy of the staff and adopt an effective formula leading to significant quality improvement of TIPLO's patent, trademark and legal services that accommodates clients' intensifying need for IPR enforcement. J. K. also devotes his time to many occasions of public speaking targeted at global corporations and international societies addressing issues of IP concerns, unfair competition and others, and continues the footsteps of his late father in dedicating to *pro bono* NGOs' activities like that of the Judicial Reform Foundation, Taiwan International Law Society and Taiwan Human Right Committee, among many others. He is currently on the Board of Directors of the Asian Patent Attorneys Association/APPA, and the president to the APAA, Taiwan Group.

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Mr. H. G. Chen is the Chief of the Legal Department of TIPLO. He has been practising law in Taiwan for more than 30 years. H. G. has extensive experience in the fields of intellectual property, litigation, unfair competition, dispute resolution and general corporate matters. In the late 1980s, he demonstrated primordial litigious flair by successfully representing the client in a leading trade dress case in Taiwan before the enactment of the Taiwan Fair Trade Act. He has represented various global corporate clients from Japan, the United States and Europe in patent and trademark litigation, licensing and negotiation in Taiwan and the illustrious record has won him the reputation as one of the most invincible lawyers in Taiwan. He served as the president of the Taipei Bar Association for the term of 2005 – 2006. He was the Director of Intellectual Property Committee of the Taipei Bar Association (1990 – 1993) and Taiwan Bar Association (1993 – 1995). He is now an executive member to the Board of Directors of the Asian Patent Attorneys Association (APAA), Taiwan Group, the executive director of the Taiwan Patent Attorneys Association, and the director of Legal Aid Foundation.



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TIPLO Attorneys-at-Law (also Taiwan International Patent & Law Office) was founded in 1965 by M. S. Lin and a group of professional legal and technical associates specialising in intellectual property rights. With over four decades of evolution TIPLO is now one of the largest and most reliable intellectual property law firms in Taiwan with diversified expertise to encompass IP, as well as general legal services provided by a full service law firm. TIPLO is currently staffed by over 240 full-time members, many of whom are multilingual professionals fluent in English, Chinese, Japanese, Taiwanese and other languages. TIPLO mainly consists of three departments, namely Patent, Trademark and Legal Departments. Our patent engineers and attorneys have an average career length of more than 10 years with expertise and experience covering a wide range of technical fields including electrical engineering, mechanical engineering, applied chemistry, biochemical engineering, biotechnology, pharmaceutical, semiconductor, computer technology and other emerging areas. TIPLO is a leading firm in patent and trademark prosecution, invalidation and opposition proceedings, and infringement assessment and validity appraisal. The proficiency of our Legal Department in IP enforcement, in particular infringement litigation and coordination of police raids, is also highly recognised by law enforcement institutes of all levels and the industries alike, reinforcing TIPLO as one of the most effective law firms representing the interests of its clients.

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The logo for Global Legal Group (GLG) features the letters 'GLG' in a bold, sans-serif font. The 'G' on the left is white, the 'L' in the middle is green, and the 'G' on the right is white. The logo is centered between two horizontal lines.

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