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## TIPLo Outstanding work on Litigation Case (2017.11)

### Example work 1

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| <p>Name and brief description of case/portfolio:</p> | <p>一美國之電子零件測試設備製造商（專利權人）對客戶(日本公司)以及其台灣代理商，在智慧財產法院提起專利權侵害民事訴訟，主張客戶透過台灣代理商販賣之機器有侵害專利權，並請求客戶及其台灣代理商停止侵害並請求新台幣 3 億元之損害賠償。在訴訟中，因專利權人僅以客戶之產品說明書為依據，來主張侵權，故法院在第三人公司勘驗該第三人自客戶處所購得之機器。因專利權人主張受侵害之專利請求項為手段功能用語請求項，故雙方在訴訟中爭執系爭機器是否具有手段功能用語請求項所揭露之對應結構。客戶在訴訟中亦有提出先前技術主張系爭專利欠缺進步性而有應撤銷之事由。</p> <p>智慧財產法院一審法院為原告敗訴之判決。原告提起上訴。智慧財產法院 2 審於審酌雙方主張後，雖然認為系爭專利並無應撤銷之事由，但就系爭機器是否侵害系爭專利之部分，則認為：系爭機器並未侵害系爭專利，而駁回其上訴。判決理由如下：</p> <ol style="list-style-type: none"> <li>1. 系爭專利技術特徵(c) 對應的段落應為說明書第 19 頁第 4 行至第 20 頁第 1 行以及圖 1、3、10、10a 及 14，該等圖式係為輔助該等說明書的內容，而該等段落未見「傾斜面」，是以不宜解釋為「坐入柵板及槽座位於傾斜面」，但無「傾斜面」並無法達成技術特徵(c) 之「使元件歸位於槽座」的功能，已如前述，因而加入「因重力將未入槽座元件翻滾於空槽座上」必要結構與連結關係以達成技術特徵(c) 之功能。</li> <li>2. 根據申請程序歷史檔案，原告已明確表示系爭專利有關技術特徵© 所採用之手段「是利用重力方式將元件置於槽座」中，與利用壓力加速進料及下料之技術手段無關，而「半真空吸引機構」僅為「固持」元件之用。</li> <li>3. 根據原告於原審提出之照片及被告於原審準備程序提出之投影片可知，元件係透過吸力翻滾於空的槽座上，系爭專利與系爭產品雖均有「在環座旋旋轉所經的路徑中承收一元件流路並使元件歸位於槽座」的相同功能與結果，惟系爭產品以吸力翻滾於空的槽座上，此與系爭專利以重力翻滾於空的槽座上，兩者的手段有實質差異，未落入其結構之均等範圍，故從系爭產品無法讀取到系爭專利請求項 1 之要件 1(c)特徵。</li> <li>4. 系爭機器之空的槽座開孔方向與重力方向垂直，所以元件不可能透</li> </ol> |
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過重力翻滾於空元件槽座上，系爭產品之元件係透過吸力翻滾於空的槽座上，系爭專利之重力翻滾與系爭產品之吸力翻滾的技術手段實質不同，無均等論之適用，故系爭機器未落入系爭專利請求項 1 之專利權範圍。

A US maker of electronic parts test apparatus (the patentee) initiated a civil action asserting patent infringement with the IP Court against our client (a Japanese company) and its Taiwanese authorized agent. The US maker claimed that the machine sold by the Taiwanese agent under the client's authorization infringed upon the US maker's patent (the patent in issue) and thus demanded that the client and its Taiwanese agent stop the alleged infringement and pay damages in an amount of TWD3 hundred million. In the civil action, the patentee, namely the US maker, asserted infringement simply based on the client's product manual. In this regard, the IP Court performed on-site inspection of the physical sample of the accused product a third party bought from the client at the business premise of the third party. As the patentee alleged that the infringed claim of the patent in issue is means-plus-function claim, the disputed issue between the parties was whether the accused machine had the corresponding structure disclosed in the said means-plus-function claim. The client also challenged the validity of the patent in issue for its lack of inventive step by presenting prior arts.

The IP Court decided on this civil action in favour of the client in the first instance proceedings, which caused the US maker appealed this case to second instance proceedings. After examining both sides' statements and arguments, the IP Court in the second instance proceedings determined that the accused machine did not infringe upon the patent in issue and dismissed the US maker's appeal, even though the IP Court did not sustain the client's challenge against the validity of the patent in issue. The IP Court's judgment was rendered based on the following reasoning.

1. The corresponding paragraphs of the technical feature (c) of the patent in issue should be the 4<sup>th</sup> line of p.19 through the 1<sup>st</sup> line of p.20 of the description and drawing 1, 3, 10, 10a, and 14 of the patent in issue. These drawings are to support the content of the description. The "inclined surface" is absent from the above-mentioned paragraphs, and in this regard, it is inappropriate to construe the corresponding structures of means plus function claim of "means, in the path of the rotating ring, for receiving a stream of components and seating them in the ring," include "the seating fences and seats are on the inclined surface". However, without the "inclined surface", the function of "seating components in the ring" of technical feature (c) cannot be fulfilled. As mentioned above, "unseated components tumble on empty seats due to gravity" are added to the necessary structures and connection thereof to fulfill the function of technical feature (c).

2. According to prosecution files, the US maker had clearly indicated

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|                                      | <p>therein that the means of technical feature (c) of the patent in issue is “seating components by gravity” which is irrelevant to the technical means of accelerating materials feeding by vacuum pressure. The “partial vacuum means” is simply for “holding” the components.</p> <p>3. Also as indicated in the photos presented by the US maker in the first instance proceedings and its powerpoint slides produced in the preparatory proceedings in the first instance, the components tumble on the empty seats through suction. Even though both the patent in issue and the accused machine have the same function and cause the same result of “the means in the path of the rotating ring, for receiving a stream of components and seating them in the ring”, the accused machine causes components to tumble above and on the empty seats by suction, while for the patent in issue, it makes components tumble over and on the empty seats by gravity. There is substantial difference between the means of the patent in issue and the accused machine, and therefore, they do not constitute equivalents with respect to their respective structure. In this regard, the accused machine cannot be read on the technical feature (c) of claim 1 of the patent in issue.</p> <p>4. The direction of a through-hole of an empty seat of the accused machine is vertical to the direction of gravity, in which circumstance, the components are unlikely to tumble over and on the empty seats by gravity. With the difference in their respective means between the components tumbling by suction of the accused machine and components tumbling by gravity of the patent in issue, the doctrine of equivalents is not applicable in this case. Therefore, the accused machine does not fall into the scope of claims of claim 1 of the patent in issue.</p> |
| IP advisers from your firm involved: | H. G. Chen, Attorney-at-Law and Certified Patent Attorney<br>Y. S. Yang, Attorney-at-Law  |
| Other IP firms involved:             | <b>N/A</b>  |
| Date(s)                              | <p>2015.2.17 上訴人提起上訴<br/>2015.9.2 二審第 1 次開庭<br/>2016.1.27 詢問證人(發明人)<br/>2016.9.2 Inspection performed by the Court at the third person’s business premise<br/>2016.12.8 言詞辯論<br/>2017.1.12 宣判</p> <p>Timeline: --<br/>2013.5.3: Civil action initiated by the patentee.<br/>2013.11.26: The first court hearing held.<br/>2014.3.8: Inspection performed by the Court at the third person’s business premise<br/>2014.12.23: The 10th court hearing held (Oral argument session concluded).<br/>2015.1.23: Judgment rendered.<br/>2015.2.17: Appeal filed by the patentee.</p>  |

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|                       | <p>2015.9.2: The 1<sup>st</sup> hearing held in the second instance proceedings.<br/>2016.1.27: Witness (inventor) questioned.<br/>2016.9.2: Inspection performed by the Court at the third person's business premise<br/>2016.12.8: Oral argument sessions.<br/>2017.1.12: Judgment rendered.</p>  |
| Why was it important? | <p>法院於本件中所闡述之手段功能用語解釋原則及禁反言原則在申請專利範圍解釋及均等論之適用範圍之見解，均與我方之主張相同。雖然本件請求金額高，案情複雜，但在本所強力答辯下，成功地協助客戶免除高額之賠償金，也間接維護了客戶在市場上之競爭地位。</p> <p>With respect to the rules of construing a means-plus-function claim and the extent of application of the doctrine of estoppel to construction of patent claims and the extent of application of doctrine of equivalents, the Court provided the same explanations with our side's allegations. Even though this case involved high amount of claimed damages and complicated scenario, our firm successfully assisted the client in avoiding paying the high damages amount and indirectly maintaining the client's position on the market.</p> |

## Example work 2

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| Name and brief description of case/portfolio: | <p>本件專利權人為公告第 589539 號「電腦操作台與周邊裝置 訊號切換器及其方法」發明專利(下稱系爭發明專利)，及公告第 584276 號「自動切換器」新型專利(下稱系爭新型專利)之專利權人，起訴主張本所客戶 A 暨未經伊同意，製造 13 款 KVM 切換器，侵害系爭發明專利更正後請求項 1、6；另製造 9 款 KVM 切換器，侵害系爭新型專利更正後請求項 1；並將部分系爭切換器交由本所客戶 B 銷售，分別起訴請求法院判決命客戶 A 給付伊新臺幣(下同) 1 億 5000 萬元及加計法定遲延利息之判決，並請求客戶 B 給付伊 1000 萬元及加計法定遲延利息之判決。</p> <p>本案自西元(下同) 2005 年繫屬於法院，原第一審及第二審判決均認定系爭發明及新型專利有無效事由，專利權人不得主張專利權，經最高法院發回更審，命重新調查專利有效性後，更審判決認定專利雖不具無效事由，惟依據法院現場進行勘驗及測試之結果，認定專利權人未能證明系爭 KVM 切換器具有「依據工業標準以仿效複數個操作台裝置」、「以同步或不同步地切換鍵盤-影像-滑鼠 (KVM) 通道和周邊通道至一共同的電腦或不同的電腦，不會於切換器切換時中斷該周邊資料流」之功能，故未落入系爭發明專利請求項之文義或均等範圍。</p> <p>且系爭 KVM 切換器技術特徵要件「該各纜線之一端導入主插座體之殼體，殼體係藉由螺釘鎖合手段組合上下蓋體，且內面未與電路板密合」，與系爭新型專利請求項要件中「且該各纜線之一端係由該主插座體之殼體所包覆」不同，自不符合文義讀取；且前開 KVM 切換器之方式、功能、結果均與系爭新型專利請求項 1 實質不同，亦不適用均等論。</p> |
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故更審判決仍駁回專利權人之請求，經最高法院 2017 年判決駁回專利權人之上訴終告本所客戶 A、B 勝訴確定。

A patentee who holds and owns an invention patent under Publication No. 589539, titled "Signal switch for console and peripheral devices and the method thereof" (hereinafter the "subject invention patent") and a utility model patent under Publication No. 584276, titled "automatic switch" (hereinafter the "subject utility model patent"), maintained that our client A, without the patentee's prior consent, made 13 kinds of KVM switches infringing upon the amended claim 1 and 6 of the subject invention patent and also made the other 9 kinds of KVM switches infringing upon the amended claim 1 of the subject utility model patent (hereinafter collectively the "accused KVM switch products") and also that part of the accused KVM switch products were sold by our client B. In this regard, the patentee initiated a patent infringement action against the client A and client B, respectively, to seek an award of damages payable by client A in an amount of TWD150 million plus the statutory interest thereof and also an award of damages payable by client B in an amount of TWD10 million plus the statutory interest thereof, respectively.

The two actions had been initiated with and handled by the court since 2005. The court of the first instance and the court in second instance both decided that the subject invention patent and the subject utility model patent should be held invalid and thus the patentee should not assert the patent rights thereof. Further, the two actions were brought to the Supreme Court and the Supreme Court remanded the two actions back to the lower court for re-decision, demanding that validity issue should be reinvestigated. Finally, after reinvestigation, the lower court sustained the validity of the subject two patents but determined that the accused KVM switch products did not literally fall into the scope of the claims of the subject invention patent or the scope of its equivalents on the ground that the patentee failed to substantiate the subject KVM switch's functions of "emulating the plurality of console devices according to the industry standard" and "switch between the keyboard-video-mouse (KVM) channel and the peripheral channel to a common computer or to different computers simultaneously or non-simultaneously without interrupting the peripheral data flow while switching" as shown in the court's on-site examination and testing.

Moreover, the technical feature of the accused KVM switch products, "one port of each cable is directed into the housing of the master socket whose upper and lower covers are combined by means of screw locking and the internal side is not closely adhering to the circuit board" is different from the element of the claims of the subject utility model patent, namely "one end of each cables is covered by the housing of the master socket", and thus the accused KVM switch products did not constitute literal infringement upon the subject utility model patent. Furthermore, the doctrine of equivalents should not apply because the method, function, and

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|                                      | <p>performance result of the accused KVM switch products substantively differ from claim 1 of the subject utility model patent.</p> <p>Based on the foregoing, the lower court denied the patentee's request and the Supreme Court dismissed the patentee's appeal in 2017 to conclude the actions, which finally ascertained the victory of the client A and client B.</p>   |
| IP advisers from your firm involved: | <p>陳和貴律師<br/>郭佩宜律師<br/>H. G. Chen, Attorney-at-Law and Certified Patent Attorney<br/>Lisa Kuo, Attorney-at-Law</p>  |
| Other IP firms involved:             | N/A   |
| Date(s)                              | <p><u>客戶 A 被訴侵害專利案民事訴訟:</u><br/>2005: 起訴<br/>2010.12.21: 第一審判決<br/>2013.3.27: 第二審判決<br/>2014.11.7: 第三審判決，發回更審<br/>2016.10.27: 第二審更審判決<br/>2017.8.17: 第三審判決駁回專利權人上訴，本案判決確定</p> <p><u>客戶 B 被訴侵害專利案民事訴訟:</u><br/>2005: 起訴<br/>2010.11.12: 第一審判決<br/>2012.3.31: 第二審判決<br/>2013.9.25: 第三審判決，發回更審<br/>2016.10.27: 第二審更審判決<br/>2017.8.16: 第三審判決駁回專利權人上訴，本案判決確定</p> <p><u>Action against Client A:</u><br/>2005: Action initiated.<br/>2010.12.21: Adjudication in the first instance proceedings.<br/>2013.3.27: Adjudication in the second instance proceedings.<br/>2014.11.7: Case remanded as requested in the third instance judgment.<br/>2016.10.27: Re-decision.<br/>2017.8.17: Patentee's appeal to Supreme Court dismissed by a final judgment with binding force.</p> <p><u>Action against Client B:</u><br/>2005: Action initiated.<br/>2010.11.12: Adjudication in the first instance proceedings.<br/>2012.3.31: Adjudication in the second instance proceedings.<br/>2013.9.25: Case remanded as requested in the third instance judgment.<br/>2016.10.27: Re-decision.<br/>2017.8.16: Patentee's appeal to Supreme Court dismissed by a final judgment with binding force.</p> |

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| <p>Why was it important?</p> | <p>本所客戶被訴侵害專利，訴訟策略上除主張專利無效外，同時並主張縱使專利有效，客戶生產銷售之 KVM 產品亦未落入系爭專利之申請專利範圍。而就專利無效之抗辯雖為原第一審及第二審法院肯認，然未獲得最高法院支持，故本所代理客戶於發回更審之調查證據階段，請求法院就系爭 KVM 產品進行技術測試，經兩造當庭會同法官及技術審查官測試產品功能，除拆解產品確認產品結構外，並由法院提供鍵盤、螢幕、滑鼠設備，供兩造以系爭 KVM 產品進行切換連接測試，最終法院認定系爭 KVM 產品並未落入系爭發明及新型專利之申請專利範圍，而獲得勝訴判決確定。</p> <p>To beat the patent infringement accusation against our clients, our firm assisted client A and client B in challenging the validity of the two patents as a defense strategy. We also defended our clients by asserting that the accused KVM switch products did not fall into the scope of claims of the two patents, even if the court denied our validity challenge. Our validity challenge was sustained by the court of the first instance and the court of the second instance but was later denied by the Supreme Court. In that circumstance, our firm represented the clients to request the court for conducting technical testing on the accused KVM switch products during the lower court's reinvestigation. As requested, the testing was conducted with the parties, the judge, and the technical examiner being present. The accused KVM switch products were disassembled for confirming their product structure. In addition, the court provided the keyboard, video, and mouse equipment for the parties to conduct switch and connection test on the accused KVM switch products. Based on the result of the testing, the court ruled and determined in favor of our clients by a final judgment on the ground that the accused KVM switch products did not fall into the scope of claims of the subject two patents.</p> |
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### Example work 3

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| <p>Name and brief description of case/portfolio:</p> | <p>(商標授權合約終止後請求損害賠償事)</p> <p>客戶為「A」商標之商標權人，另經客戶之關係企業同意後，由客戶將上開商標以及客戶關係企業取得之「B」商標一併授權予○○公司使用，因此客戶與○○公司於 2010 年 8 月 31 日簽署商標授權合約，授權期間自 2011 年 6 月 1 日起至 2016 年 5 月 31 日止，授權使用範圍為內衣褲成衣商品。此外，經客戶要求後，第三人△△同意就○○公司履行系爭商標授權合約範圍內擔任○○公司之連帶保證人。</p> <p>惟因○○公司於授權期間內違反系爭商標授權合約內之條款，客戶因此於 2013 年 3 月 30 日委託本所寄發律師函予○○公司表示終止商標授權合約，另於 2015 年 3 月 30 日委託本所對○○公司以及第三人△△提起民事訴訟，主張因可歸責於○○公司之因素而終止商標授權合約後，因此致客戶於合約終止後喪失對○○公司收取剩餘三年授權權利金即新台幣 378 萬元之利益，而客戶暫先就新台幣 100 萬元之範圍內請求○○公司以及第三人△△對客戶負損害賠償連帶責任。</p> |
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第一審法院認為○○公司於商標授權期間有違反商標授權合約第 11-2 條第(1)、(2)項、第 4-9 條、第 5 條、第 7-3 條(即業績未達標準、未結算營業額以及超額權利金、未提供銷售業務資料、商品包裝設計未經客戶審核)之情事,而客戶因○○公司有上開違約情事而終止系爭商標授權合約,導致客戶自 2013 年 6 月起連續 3 年度喪失對○○公司收取最低權利金之利益達 378 萬元,此屬於客戶之所失利益,故○○公司以及第三人△△當應對客戶負賠償責任,並判決○○公司以及第三人△△應給付新台幣 100 萬元予客戶。

被告○○公司以及△△對第一審民事判決提起上訴,第二審法院則認為○○公司於商標授權期間違反商標授權合約第 11-2 條第(1)、(2)項、第 4-9 條、第 5 條、第 7-3 條時,客戶因此終止授權契約,終止後即無法繼續收取授權金 378 萬元,但○○公司於商標授權期間尚有違反商標授權合約第 11-1 條(即被授權人使用授權商標逾越授權範圍、將授權商標圖樣任意變更後使用),依約○○公司以及△△仍應對客戶給付違約金 100 萬元,因此判決駁回○○公司以及△△之上訴。

**(Claim for damages after termination of a trademark license agreement)**

As a trademark proprietor, the client, upon obtaining consent from its affiliate, granted a license to Company X for Company X to use both its mark and the affiliate's registered mark, for which license the client executed a trademark license agreement with Company X on August 31, 2010. The term of license commenced from June 1, 2011 through May 31, 2016 and the scope of license covered underwear and underpants products. Besides, upon the client's request, a third person agreed to act as the joint guarantor for Company X with respect to its performance of the said trademark license agreement.

Due to Company X's breach of the provisions of the said trademark license agreement during the term of license, our firm was retained by the client to issue an attorney letter to Company X on March 30, 2013 to terminate the said trademark license agreement. Further on March 30, 2015, our firm represented the client to initiate a civil action against Company X and the said third person, claiming that the client suffered profit loss in an amount of TWD3,780,000, namely the royalties of license the client should have received from Company X for the remaining three years, as a result of termination of the said trademark license agreement due to the reason attributable to Company X. The client temporarily claimed damages in an amount of TWD1 million against Company X and the said third person guarantor.

The court of the first instance held that during the term of license, Company X breached paragraph (1) and (2) of Article 11-2, Article 4-9, Article 5, and Article 7-3 of the said trademark license agreement (with respect to Company X's failure to meet the sales performance standards, the non-closed sales amount and excess royalty, and also its failure to provide sales information, and to seek

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|   | <p>the client's approval of product packaging design), and that the client indeed suffered profit loss caused by the fact that the client terminated the said trademark license agreement due to Company X's breach of the said agreement and thus the client had not received the least royalty in a total amount of TWD3,780,000 for three consecutive years beginning from June 2013. Based on the foregoing, the court determined that Company X and the said third person should be held liable for the client's loss and should pay TWD1 million to the client.</p> <p>Company X and the said third person filed an appeal against the first instance judgment. With respect to the appeal, the superior court made the following holding that Company X's breach of paragraph (1) and (2) of Article 11-2, Article 4-9, Article 5, and Article 7-3 of the said trademark license agreement during the term of license had caused the client to terminate the agreement and the termination discontinued the client's receipt of royalties of TWD3,780,000. More than that, Company X had also breached Article 11-1 of the same agreement during the term of license (that is, Company X, as the licensee, used the licensed trademark beyond the scope of license and changed the licensed trademark for use without prior approval). Based on the foregoing holding, the superior court determined that Company X and the said third person should pay to the client TWD1 million as default penalty in accordance with the said trademark license agreement and dismissed Company X and the said third person's appeal and.</p> |
| <p>IP advisers from your firm involved:</p> | <p>陳和貴律師<br/>吳宗樺律師<br/>H. G. Chen, Attorney-at-Law and Certified Patent Attorney<br/>C. H. Wu, Attorney-at-Law</p>  |
| <p>Other IP firms involved:</p>             | <p><b>N/A</b></p>   |
| <p>Date(s)</p>                              | <p>2015年3月30日：提起民事訴訟。<br/>2015年7月2日：第一審進行準備程序。<br/>2015年7月27日：第一審進行第一次言詞辯論程序。<br/>2016年1月11日：第一審進行第六次言詞辯論程序(辯論終結)。<br/>2016年2月5日：第一審宣判。<br/>2016年8月1日：第二審進行準備程序。<br/>2016年11月7日：第二審準備程序終結。<br/>2016年12月8日：第二審進行言詞辯論程序。<br/>2017年12月29日：第二審宣判。</p> <p>2015.3.30: Civil action initiated.<br/>2015.7.2: Preparatory hearing held in the first instance proceedings.<br/>2015.7.27: 1<sup>st</sup> oral argument session held in the first instance proceedings.<br/>2016.1.11: 6<sup>th</sup> oral argument session held in the first instance</p>  |

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|                       | <p>proceedings (oral argument sessions concluded).<br/>2016.2.5: Adjudication of the first instance proceedings.<br/>2016.8.1: Preparatory hearing held in the second instance proceedings.<br/>2016.11.7: Preparatory procedure concluded.<br/>2016.12.8: Oral argument sessions conducted in the second instance proceedings.<br/>2017.12.29: Adjudication of the second instance proceedings.</p>  |
| Why was it important? | <p>客戶曾委託本所對○○公司負責人提起刑事告訴，主張○○公司於商標授權合約終止後仍繼續使用授權商標，因此有侵害商標權之罪行。惟檢察官經調查後雖認為○○公司於商標授權合約終止後並未繼續使用授權商標，而對○○公司負責人為不起訴處分，但本所嗣後仍幫助客戶於民事上請求○○公司負民事上之損害賠償責任，以取得○○公司對客戶應賠償之違約金。</p> <p>For the above case, the client had also authorized our firm to file a criminal complaint against the responsible person of Company X for Company X's trademark infringement by continuing using the licensed trademark after termination of the said trademark license agreement. The prosecutor, however, held that Company X did not continue using the licensed trademark after termination of the said trademark license agreement, and decided not to indict the responsible person of Company X. Regardless of the unsuccessful criminal complaint, our firm still sought to represent the client to recover its damages in civil aspects by receiving the default penalty payable by Company X.</p> |

#### Example work 4

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| Name and brief description of case/portfolio: | <p>(證據保全)</p> <p>客戶為系爭發明專利之專利權人，專利權期間自 2013 年 1 月 1 日起至 2025 年 11 月 20 日止。客戶就系爭專利於 2005 年 11 月 21 日向經濟部智慧財產局提出專利申請後，即開始製造使用系爭專利之產品並銷售予位於中國之第三人。惟因第三人自 2012 年 11 月起即停止對客戶訂貨及購買產品，經客戶自行調查後發現第三人改向○○公司訂購 A 產品。此外，客戶由○○公司之中國代理商處取得 A 產品後，經過自行評估認為 A 產品屬侵害系爭專利之產品。</p> <p>為向法院釋明 A 產品屬侵害系爭專利之產品，客戶委託本所於台灣找尋適當之鑑定人進行專利侵害鑑定，經鑑定人鑑定後出具 A 產品侵害系爭專利之專利侵害鑑定報告。</p> <p>客戶同時對○○公司寄發警告函，主張○○公司有涉嫌侵害系爭專利之情事等語，惟○○公司回函表示該公司確有在台灣生產 A 產品並販賣予在中國之第三人，但該公司在中國並無代理商，因此客戶所謂由○○公司中國代理商處取得之 A 產品屬於仿品並非事實，同時亦拒絕提出 A 產品予第三公正機關進行專利侵害鑑定。</p> <p>鑑於客戶對○○公司提起民事侵害專利權訴訟後，因 A 產品之銷售對象位於中國，法院難以命第三人提出 A 產品，因此○○公司勢必繼續爭執</p> |
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客戶取得 A 產品之真實性、否認侵害事實及範圍、拒絕提出全部或部分 A 產品以及相關文書銷售資料，致難以證明侵害專利權之事實以及損害賠償範圍，客戶因此委託本所向智慧財產法院聲請證據保全。

第一審法院以鑑定人出具之專利侵害鑑定報告說明不夠完全為由，駁回客戶證據保全之聲請。惟經本所代客戶向第二審提起抗告，並同時 (1)請求鑑定人提出補充說明，(2)由本所加強說明本件難以用通常方法取得 A 產品、A 產品有滅失或礙難使用之虞、保全 A 產品有時間上之急迫性、就確定 A 產品銷售情況之現狀有法律上利益且有必要等事由後，第二審法院准許客戶為保全證據之聲請。

**(Perpetuation of evidence)**

The client owns the invention patent with the patent term thereof beginning from January 1, 2013 through November 20, 2025 (hereinafter the "subject patent"). After filing a patent application for the subject patent with the Taiwan IPO on November 21, 2005, the client had practiced the subject patent to manufacture products for sale to a third person in China. The said third person, however, had stopped ordering and purchasing products with the client since November 2012, which caused the client to voluntarily conduct investigation on this matter and found that the said third person turned to Company X to purchase product A. Further, the client obtained a sample of product A from the Chinese distributor of Company X to conduct examination on the sample and concluded that product A infringed upon the subject patent.

For substantiating to the court the alleged infringement upon the subject patent, the client retained our firm's services to find an appropriate institutional expert for identifying the existence of the alleged patent infringement, and the institutional expert issued a patent infringement analysis report identifying and confirming the existence of the alleged infringement by product A upon the subject patent.

In the meantime, the client issued a cease and desist letter to Company X, indicating therein that Company X was suspected of infringing upon the subject patent. Company X made a formal reply that they indeed manufactured product A in Taiwan and sold it to a third person in China, but they had no authorized distributor in China, and the sample the client obtained from the so-called Chinese distributor of Company X is a counterfeit; Company X also refused to provide product A for the third impartial institutional expert to conduct patent infringement analysis.

Further, the client initiated a civil action asserting patent infringement against Company X. After that, there was a difficulty that the Taiwan court did not have a legal basis to order the said third person to produce product A because product A was manufactured for sale in China. In that circumstance, it was predictable that Company X kept challenging the authenticity of product A obtained by the client and further denying the alleged patent infringement and the scope of

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|                                      | <p>infringement and also refusing to provide product A and relevant document or information in whole or in part. The foregoing made it difficult for the client to prove the occurrence of the alleged infringement and the amount of damages, and therefore, the client authorized our firm to file a motion with the IP Court for having the evidence perpetuated.</p> <p>The court of the first instance rejected the client's motion for evidence perpetuation on the ground that the submitted patent infringement analysis report provided no complete explanations. Our firm represented the client to file an interlocutory appeal in the second instance proceedings. At the same time, for successfully having the evidence perpetuation motion granted, our firm also (1) requested the institutional expert to provide supplemental explanations and (2) emphasized to the court the difficulty in obtaining product A in usual ways, the likelihood that product A may be destroyed or its use in court may be difficult, the urgency in time, and also the legal interests in ascertaining the status quo of product A with respect to its sale, and finally the superior court granted the motion.</p> |
| IP advisers from your firm involved: | <p>陳和貴律師<br/>楊益昇律師<br/>吳宗樺律師<br/>H. G. Chen, Attorney-at-Law and Certified Patent Attorney<br/>Y. S. Yang, Attorney-at-Law<br/>C. H. Wu, Attorney-at-Law</p>  |
| Other IP firms involved:             | <b>N/A</b>  |
| Date(s)                              | <p>2016年4月25日：聲請保全證據。<br/>2016年5月5日：第一審法院駁回聲請。<br/>2016年5月27日：提起抗告。<br/>2016年7月25日：第二審法院廢棄原裁定，准許保全證據之聲請。</p> <p>2016.4.25: Motion for perpetuation of evidence filed.<br/>2016.5.5: Motion denied by the court of the first instance.<br/>2016.5.27: Interlocutory appeal filed.<br/>2016.7.25: Motion for perpetuation of evidence granted by the superior court.</p>  |
| Why was it important?                | <p>客戶無法透過市場取得證據且難以說明目前取得證據之來源，因此侵權人將來於本案訴訟中勢必爭執證據是否具有證明力。本所幫助客戶於起訴前尋找適當之鑑定人出具專利侵害之鑑定報告並聲請證據保全，以確保後續本案訴訟並取得有利之訴訟或談判優勢。</p> <p>Due to the facts that the client could not obtain the necessary evidence on market and it was difficult to explain about the source from which the client obtained the evidence, the infringer would necessarily challenge the admissibility of the evidence submitted by the client in the proceedings. In this case, our firm successfully assisted the client in finding an appropriate institutional expert to issue a patent infringement analysis and filing a motion for evidence</p>   |

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|  | perpetuation in the pre-action proceeding, so as to put the client in the strategically favorable position both in the action and also in negotiation. |
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**Example work 5**

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| <p>Name and brief description of case/portfolio:</p> | <p>(商標侵權刑事訴訟事)</p> <p>客戶在日本為「A」商標之商標權人，惟「A」商標在台灣已經於 2002 年由○○公司搶先註冊並於數年後轉讓予關係企業○○公司。○○公司除取得「A」商標之外，並向經濟部國貿局註冊與客戶英文公司名稱相同之進出口廠商名稱、抄襲客戶產品之包裝盒、條碼後銷售、出口同種類之產品。另據客戶表示○○公司對外宣稱係客戶之授權廠商，得使用客戶之商標、包裝盒，致台灣以及海外市場之相關消費者誤認○○公司銷售之低價產品與客戶之產品相同。</p> <p>鑒於○○公司完全抄襲客戶產品包裝盒(包括「A」商標以及「B」圖樣)、條碼，客戶因此委託本所在台灣註冊「B」圖樣為商標後，對○○公司負責人△△提起侵害「B」商標以及偽造私文書(條碼)之刑事告訴，檢察官嗣後對△△為起訴之處分。</p> <p>第一審法院認為(1)商品條碼於日常生活中隨處可見，因此被告△△辯稱不知商品條碼之作用與功能云云，係不足採信、(2)關於被告△△未得客戶同意使用相同「B」商標之行為，被告△△雖主張有「善意先使用」之適用，惟由被告△△並無日本相關背景、客戶最早於 1984 年即使用「A」字樣、被告△△嗣後將○○公司英文名稱改成與客戶英文公司名稱相同、被告△△印製之包裝盒與客戶極為相似、「B」商標圖案非屬一般日常生活可見之圖案等情判斷，被告△△顯然基於攀附客戶之商譽而抄襲包裝盒圖樣、文字，因此並無主張善意先使用之餘地、(3)被告 2013 年起為犯罪行為，應論以接續犯之一罪，從重論以行使偽造私文書(條碼)罪，處有期陸月，如易科罰金，以新臺幣參千元折算壹日，扣案之包裝盒以及包裝盒內產品均為沒收。</p> <p>被告△△以及檢察官均對第一審判決提起上訴。第二審法院維持第一審判決宣告罪刑之部分並駁回雙方上訴，但就第一審判決沒收之部分為撤銷，改諭知僅沒收仿造條碼、商標之包裝盒，並認為包裝盒內之產品因未使用「B」商標圖案並無侵害商標權之情事而應為發還。就第二審判決沒收之部分，本所請求檢察官上訴最高法院，現仍由最高法院審理中。</p> <p><b>(Criminal lawsuit of trademark infringement)</b></p> <p>The client is the proprietor of mark A in Japan, while a Taiwan-based Company X had already outflanked the client in registering mark A in Taiwan since 2002 and further assigned the mark to its affiliate Company Y several years later. In addition to holding the Taiwanese registration of mark A, Company X also successfully applied with the Bureau of Foreign Trade under the Ministry of Economic Affairs for registering itself as an importer and exporter by the English corporate name identical to that of the client. Moreover,</p> |
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Company X also imitated the packaging box and barcode of the client's products and used such packaging box and barcode onto the product same with that of the client for sale and export. Also according to the client, Company X declared to the public that it is the authorized distributor of the client and is duly authorized to use the client's trademark(s) and packaging box. Such false statements caused the relevant consumers in Taiwan and international market to mistakenly believe that the product(s) sold by Company X at lower price(s) is (are) identical to the client's products.

In view of Company X's imitation of the client's packaging box (bearing the mark A and device B) and barcode, the client authorized our firm to apply for registering device B as a trademark (mark B) in Taiwan and further to file a criminal complaint against Company X's responsible person for infringement upon mark B and private document (barcode) forgery, for which the prosecutor indicted Company X's responsible person (defendant) after investigation.

Subsequently, the court of the first instance found defendant guilty of use and forgery of private documents (barcode) and thus imposed on him a sentence of six-month imprisonment, which may be commuted to a fine payment calculated at the rate of TWD3,000 per day, and the seized packaging boxes and products contained therein should be all confiscated. The court also found that these criminal acts having done by defendant since 2013 should legally constitute one offense and defendant should be considered a consecutive offender. The court imposed the sentence based on the following holding and reasoning.

(1) Since product barcode is commonly seen in ordinary life, defendant's defensive argument that he did not know the function and purpose of product barcode is inadmissible;

(2) Defendant asserted the applicability of "prior use with bona fide" in regard to his use of the client's mark B without seeking the client's prior consent. Nevertheless, defendant's intent was obvious that he took a free ride on the client's business reputation by imitating the packaging box and wording of the client's products because (a) nothing in defendant's personal background pertained to Japan, (b) as opposed to the client's first use of its mark A early in 1984, defendant subsequently changed Company X's English corporate name to another one identical to that of the client, (c) the packaging box printed by defendant was extremely similar to that of the client, and (d) the device of mark B was not one commonly seen in ordinary life. Based on the foregoing, the court ruled that it is groundless for defendant to assert his bona fide prior use of mark B.

Both defendant and the prosecutor took an appeal from the first instance judgment. The superior court affirmed defendant's offense sustained and also the sentence imposed on defendant in the first instance judgment and also dismissed the appeals filed by

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|                                      | <p>defendant and the prosecutor, except that the superior court vacated the decision of confiscation and advised that only the forged barcode and packaging boxes but not the products should be confiscated because the products contained in the packaging boxes did not bear mark B and thus these products did not involve the occurrence of trademark infringement. With respect to the confiscation decision, our firm represented the client to request the prosecutor to appeal this case with respect to the confiscation decision to the Supreme Court. Now, this case is pending at the Supreme Court.</p>  |
| IP advisers from your firm involved: | <p>陳和貴律師<br/>吳宗樺律師<br/>H. G. Chen, Attorney-at-Law and Certified Patent Attorney<br/>C. H. Wu, Attorney-at-Law</p>   |
| Other IP firms involved:             | <b>N/A</b>   |
| Date(s)                              | <p>2015年5月19日：檢察官起訴。<br/>2015年7月15日：第一審進行準備程序。<br/>2016年3月7日：第一審準備程序終結。<br/>2016年5月12日：第一審進行第一次審理程序。<br/>2016年11月21日：第一審進行第四次審理程序。<br/>2016年12月15日：第一審宣判。<br/>2017年3月2日：第二審進行準備程序。<br/>2017年3月29日：第二審準備程序終結。<br/>2017年4月20日：第二審進行審理程序。<br/>2017年5月4日：第二審宣判。<br/>2017年6月1日：檢察官對第二審判決提起上訴。</p> <p>2015.5.19: Indictment brought by prosecutor.<br/>2015.7.15: Preparatory hearing held in the first instance proceedings.<br/>2016.3.7: Preparatory procedure concluded in the first instance proceedings.<br/>2016.5.12: 1<sup>st</sup> trial hearing held in the first instance proceedings.<br/>2016.11.21: 4<sup>th</sup> trial hearing held in the first instance proceedings.<br/>2016.12.15: Adjudication of the first instance proceedings.<br/>2017.3.2: Preparatory hearing held in the second instance proceedings.<br/>2017.3.29: Preparatory procedure concluded.<br/>2017.4.20: Trial hearing held in the second instance proceedings.<br/>2017.5.4: Adjudication of the second instance proceedings.<br/>2017.6.1: Appeal filed by prosecutor against second instance judgment.</p> |
| Why was it important?                | <p>客戶之「A」商標在台灣已經被搶先註冊，並且罹於提起異議以及評定之法定期間。惟客戶仍可以透過註冊「B」商標後，委託本所對該侵權行為人提起刑事告訴，並另於提起附帶民事訴訟時請求損害賠償。</p> <p>Even though the client's mark A had already been registered by a Taiwanese company and the prescription for the client's filing an opposition and invalidation request had both lapsed, the client still</p>   |

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|  | successfully registered its mark B to have a basis to file a criminal complaint against the infringer and also additionally initiated an incidental civil action to claim damages. |
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**Example work 6**

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| Name and brief description of case/portfolio: | <p>美國的通訊設備之製造商，向經濟部智慧財產局申請舉發要求撤銷一日本通訊設備製造商（本所客戶）之專利。案件由經濟部智慧財產局審理後，作成舉發不成立之處分（本所客戶勝訴）。</p> <p>A US telecommunication equipment manufacturer filed a request with the Taiwan IPO seeking invalidation of a patent owned by a Japanese fellow member of the trade who is a client of TiPLO. Taiwan IPO dismissed the invalidation action and the client's patent challenged remains valid in good standing.</p>   |
| IP advisers from your firm involved:          | <p>林志剛律師/專利師<br/>高山峰專利師<br/>廖文慈律師/專利師<br/>蘇福長專利工程師<br/>J.K. LIN, Attorney-at-Law / Certified Patent Attorney<br/>Charles S.F. KAO, Certified Patent Attorney<br/>Grace W.T. LIAO, Attorney-at-Law / Certified Patent Attorney<br/>SU Fu-Chang, Patent Engineer</p>  |
| Other IP firms involved:                      | N/A   |
| Date(s)                                       | <p>2013.01：被提起舉發<br/>2013.04：提呈被舉發答辯(一)及申請更正申請專利範圍<br/>2013.11：舉發人提補充理由書(一)<br/>2014.01：提呈被舉發答辯(二)<br/>2014.02：舉發人提補充理由書(二)<br/>2014.04：提呈被舉發答辯(三)<br/>2014.05：舉發人提補充理由書(三)<br/>2014.09：提呈被舉發答辯(四)<br/>2015.01：舉發人提補充理由書(四)<br/>2015.05：提呈被舉發答辯(五)<br/>2015.06：舉發人提補充理由書(五)<br/>2015.07：舉發人提補充理由書(六)<br/>2015.11：提呈被舉發答辯(六)及申請更正申請專利範圍 2015.12：舉發人提補充理由書(七)<br/>2016.04：提呈被舉發答辯(七)<br/>2016.05：辦理面詢<br/>2016.09：提呈被舉發答辯(八)<br/>2016.09：辦理面詢<br/>2016.10：舉發人提補充理由書(八)<br/>2016.11：提呈被舉發答辯(九)</p> <p>Jan. 2013: Invalidation action filed.<br/>Apr. 2013: Patentee filed response statement (I) and a request for</p> |

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|                              | <p>amending scope of the patent being challenged.</p> <p>Nov. 2013: Invalidation requester presented written statement (I) alleging reasons why the patent should be invalidated.</p> <p>Jan. 2014: Patentee filed response statement (II).</p> <p>Feb. 2014: Invalidation requester presented written statement (II).</p> <p>Apr. 2014: Patentee filed response statement (III).</p> <p>May 2014: Invalidation requester presented written statement (III).</p> <p>Sep. 2014: Patent tee filed response statement (IV).</p> <p>Jan. 2015: Invalidation requester presented written statement (IV).</p> <p>May 2015: Patentee filed response statement (V).</p> <p>Jun. 2015: Invalidation requester presented written statement (V).</p> <p>July 2015: Invalidation requester presented written statement (VI).</p> <p>Nov. 2015: Patentee filed response statement (VI) and a request for amending the scope of the patent.</p> <p>Dec. 2015: Invalidation requester presented written statement (VII).</p> <p>Apr. 2016: Patentee filed response statement (VII).</p> <p>May 2016: Taiwan IPO conducted an interview.</p> <p>Sep. 2016: Patentee filed response statement (VIII).</p> <p>Sep. 2016: Taiwan IPO conducted a second interview.</p> <p>Oct. 2016: Invalidation requester presented written statement (VIII).</p> <p>Nov. 2016: Sept. 2016: Patentee filed response statement (IX).</p> |
| <p>Why was it important?</p> | <p>1. 系爭專利係關於一信號調變裝置之發明專利，舉發人提出 11 個證據，針對全部請求項共 64 項提出舉發，主張系爭專利不具新穎性及進步性，且說明書之記載有不明確致熟悉該項技術者無法據以實施的問題。</p> <p>2. 由於涉案請求項高達 64 項，亦多達 11 個舉發證據，本案舉發人及被舉發人雙方各自均提出 9 份理由書及答辯書，智慧局亦罕見的進行二次面詢，耗時 4 年才作成舉發不成立之審定，顯見本案案情至為複雜。</p> <p>3. 本所首先於程序上先指出其中 2 個證據的公開日期晚於系爭案之優先權日，不具證據適格。另外，於實體上明確性及進步性的部分亦成功的說服審查委員。智慧財產局最終作成全部請求項舉發不成立之處分，本所客戶獲得全面勝利。</p> <p>1. The patent in issue is the invention a signal adjusting device. The invalidation requester cited a total of 11 prior arts to challenge all of the 64 claims of the patent. In the proceeding, the invalidation requester attacks the non-obviousness and inventive step as well as the specification of the patent alleging that no person skilful in the art is able to reduce the patent claimed by reading the specification which is vague and unclear.</p> <p>2. Given the complexity of the case with as many as 64 patent claims and 11 prior arts involved, the invalidation requestor presented 9 written statements to elaborate the grounds alleged for the invalidation sought for and the patentee presented also 9 written statements in response to defend the patent and Taiwan IPO conducted two interviews for the case and took four years to decided</p>  |

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|  | <p>on the case.</p> <p>3. Procedurally, we had two cited prior arts stricken in the first place for their laying open both post-date the prior filing date claimed by the patent challenged. For substantive issues, we successfully convinced the examiner of the patentability and practicability of the patent challenged to vacate all of the allegations presented for the invalidation: all of the 64 claims challenged remain valid in good standing representing an overall victory for the client.</p> |
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**Example work 7**

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| <p>Name and brief description of case/portfolio:</p> | <p>一日本市佔率極高之文具用品製造商(本所客戶),向經濟部智慧財產局申請舉發,要求撤銷另一日本文具用品製造商之專利。案件由經濟部智慧財產局審理後,作成舉發成立之處分(本所客戶勝訴)。被舉發人嗣後向經濟部訴願審議委員會提起訴願,訴願會仍維持智慧財產局之處分而駁回被舉發人之訴願(本所客戶勝訴)。</p> <p>A Japanese stationery maker whose stationery products take a remarkable share in the Japanese market (and who is a client of TiPLO) filed a request with Taiwan IPO seeking invalidation of a patent owned by a Japanese fellow member of the trade. Taiwan IPO found the invalidation action tenable and had the patent invalidated. The patentee appealed the invalidation decision to the MOEA and the MOEA Appeal Board dismissed its appeal letting stand Taiwan IPO's decision. The client's invalidation action proves successful.</p> |
| <p>IP advisers from your firm involved:</p>          | <p>林志剛律師/專利師<br/>高山峰專利師<br/>廖文慈律師/專利師<br/>高文欽工程師/主任<br/>J.K. LIN, Attorney-at-Law / Certified Patent Attorney<br/>Charles S.F. KAO, Certified Patent Attorney<br/>Grace W.T. LIAO, Attorney-at-Law / Certified Patent Attorney<br/>GAU Win-Chin, Patent Engineer / Chief of Sec. JP11, TiPLO Patent Department</p>   |
| <p>Other IP firms involved:</p>                      | <p><b>N/A</b></p>  |
| <p>Date(s)</p>                                       | <p>2015.12: 提起舉發<br/>2016.03: 被舉發人提呈答辯書(一)<br/>2016.10: 提呈舉發補充理由<br/>2017.01: 被舉發人提呈答辯書(二)<br/>2017.02: 智慧局作成舉發成立之處分<br/>2017.08: 訴願會駁回訴願<br/>2017.09: 被舉發人向智慧法院起訴</p> <p>Dec. 2015: Invalidation action filed.<br/>Mar. 2016: Patentee filed response statement (I).<br/>Oct. 2016: Invalidation requester presented written statement alleging additional reasons why the patent should be</p>   |

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|                              | <p>invalidated.</p> <p>Jan. 2017: Patentee filed response statement (II).</p> <p>Feb. 2017: Taiwan IPO decided on the invalidation action and the patent challenged is invalidated.</p> <p>Aug. 2017: MOEA Appeal Board dismissed patentee's appeal.</p> <p>Sep. 2017: Patentee initiated administrative action in the IP Court.</p>   |
| <p>Why was it important?</p> | <p>1. 系爭專利係關於一書寫工具之發明專利，本案之舉發人（本所客戶）於日本與被舉發人正在進行專利侵權訴訟，並同時亦於美國、韓國、中國均對該系爭專利之各該國對應案提出情報提供，因此本所客戶對本案之成敗極為重視。假若本所客戶能於台灣成功的撤銷系爭專利，將相當有利於新產品於台灣市場之佈局，取得獨佔的地位，亦對其於其他國家之相關訴訟有正面的幫助。</p> <p>2. 本案之爭點在於系爭專利之書寫工具的摩擦體的技術特徵是否已被諸舉發證據所揭露？熟悉該項技術者究竟有無將數舉發證據加以組合之可能性？</p> <p>3. 本案智慧局之審查時程亦相當罕見，極為快速的於 1 年半內即作出舉發成立之處分，且訴願會亦於 4 個月內即駁回被舉發人之訴願，顯見舉發理由甚為充足，且本所擬定之攻擊方亦至為正確。被舉發人雖已向智慧法院起訴，但本所對於該案亦具有極高的勝訴信心。</p> <p>1. The patent in issue is an invention on writing instrument. The invalidation requester (a client of TIPL) and the patentee were the parties to a patent infringement lawsuit in Japan where the patent in issue is the patent in dispute. During the court proceeding of said patent infringement lawsuit, the client filed information with the USPTO, the KIPO and the SIPO challenging the validity of the local corresponding patents of the patent in dispute. As such, whether or not the invalidation action in Taiwan would turn out successful is of extreme importance to the client. Winning the invalidation sought for will not only clear the way for the client to launch all new products to come but also help solidify the client's position in the lawsuit in Japan as well as in the invalidation sought for of the corresponding patents in various countries.</p> <p>2. To solve the dispute at hand is to answer these two questions: Is the technical feature of the friction structure of the patent in dispute claimed on the writing instrument readily disclosed by the prior arts cited? Is it possible for a person skilful in the art to combine the cited prior arts to achieve the patent in issue?</p> <p>3. It took only 18 months for Taiwan IPO to decide on this month and less than 4 months for the MOEA Appeal Board to deny the patentee's appeal, which efficiency is fairly uncommon. The main reason accounting for the speedy decision is the accurate and solid attack presented against the patentability of the patent challenged. Much as Taiwan IPO's invalidation decision is pending decision by the IP Court on the administrative action initiated by the patentee, we firmly believe Taiwan IPO will prevail in the action and the</p> |

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|  | invalidation decision against the patent will stand. |
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**Example work 8**

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| Name and brief description of case/portfolio: | <p>一台灣自行車製造商，向經濟部智慧財產局申請舉發要求撤銷一日本自行車製造商（本所客戶）之專利。案件由經濟部智慧財產局審理後，作成舉發不成立之處分（本所客戶勝訴）。</p> <p>A Taiwanese bicycle maker filed a request with Taiwan IPO seeking invalidation of a patent owned by a Japanese fellow member of the trade who is a client of TiPLO. The invalidation action turns out unsuccessful and the client's patent challenged remains valid in good standing.</p>   |
| IP advisers from your firm involved:          | <p>林志剛律師/專利師<br/>高山峰專利師<br/>廖文慈律師/專利師<br/>詹皓安工程師<br/>J.K. LIN, Attorney-at-Law / Certified Patent Attorney<br/>Charles S.F. KAO, Certified Patent Attorney<br/>Grace W.T. LIAO, Attorney-at-Law / Certified Patent Attorney<br/>ZHAN Hao-An, Patent Engineer</p>   |
| Other IP firms involved:                      | <b>N/A</b>   |
| Date(s)                                       | <p>2014.12：被提起舉發<br/>2015.02：提呈被舉發答辯(一)<br/>2017.02：辦理面詢<br/>2017.04：舉發人提補充理由<br/>2017.07：提呈被舉發答辯(二)</p> <p>Dec. 2014: Invalidation action filed.<br/>Feb. 2015: Patentee filed response statement (I).<br/>Feb. 2017: Patentee appeared before Taiwan IPO for an interview.<br/>Apr. 2017: Invalidation requester presented written statement alleging additional reasons why the patent should be invalidated.<br/>July 2017: Patentee filed response statement (II).</p>                    |
| Why was it important?                         | <p>系爭專利係關於一自行車用齒輪曲柄之新型專利，舉發人針對請求項之獨立項提出舉發。自行車相關發明之技術領域極為狹窄，研發空間甚為有限，被質疑不具進步性成立的可能性頗高。但在本所與審查委員密切的溝通以掌握審查委員的心證，以正確的擬定答辯方針，並充分的運用答辯技巧之戰略下，無須藉由申請更正專利範圍以迴避先前技術，即讓智慧局仍認定系爭專利具進步性，而作成舉發不成立之處分，成功的為客戶固守最大的權利範圍。</p> <p>The patent in issue, which is a utility model, is a gear wheel crank for bicycle. The independent claim of the patent claimed is challenged. A bicycle-related patent could be easily challenged as the relevant technical field is relatively small and there is limited</p> |

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|  | <p>room for R&amp;D. We successfully defended the client's patent without seeking amendment of the patent for a design-around. During the proceeding, we drew up accurate defence strategy based on the most possible direction of the examiner's discretion we learned in the course of our intensive communication with him. Taiwan IPO admitted the defence we presented, dismissed the invalidation action and the client's patent challenged successfully sustains as is.</p> |
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### Example work 9

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| Name and brief description of case/portfolio: | <p>一台灣自行車製造商，向經濟部智慧財產局申請舉發要求撤銷一日本自行車製造商（本所客戶）之專利。案件由經濟部智慧財產局審理後，作成舉發不成立之處分（本所客戶勝訴）。</p> <p>A Taiwanese bicycle maker filed a request with Taiwan IPO seeking invalidation of a patent owned by a Japanese fellow member of the trade who is a client of TiPLO. Taiwan IPO dismissed the invalidation action and the client's patent challenged remains valid in good standing.</p>  |
| IP advisers from your firm involved:          | <p>林志剛律師/專利師<br/>高山峰專利師<br/>廖文慈律師/專利師<br/>詹皓安工程師<br/>J.K. LIN, Attorney-at-Law / Certified Patent Attorney<br/>Charles S.F. KAO, Certified Patent Attorney<br/>Grace W.T. LIAO, Attorney-at-Law / Certified Patent Attorney<br/>ZHAN Hao-An, Patent Engineer</p>  |
| Other IP firms involved:                      | <b>N/A</b>  |
| Date(s)                                       | <p>2014.11：被提起舉發<br/>2015.02：提呈被舉發答辯(一)<br/>2017.02：辦理面詢<br/>2017.04：舉發人提補充理由<br/>2017.07：提呈被舉發答辯(二)</p> <p>Nov. 2014: Invalidation action filed.<br/>Feb. 2015: Patentee filed response statement (I).<br/>Feb. 2017: Patentee appeared before Taiwan IPO for an interview.<br/>Apr. 2017: Invalidation requester presented written statement alleging additional reasons why the patent should be invalidated.<br/>July 2017: Patentee filed response statement (II).</p> |
| Why was it important?                         | <p>系爭專利係關於一自行車用鏈輪緊固構造之新型專利，舉發人針對請求項之獨立項提出舉發。雖然自行車相關發明之技術領域極為狹窄，研發空間甚為有限，被質疑不具進步性成立的可能性頗高。但在本所與審查委員密切的溝通以掌握審查委員的心證，以正確的擬定答辯方針，並充分的運用答辯技巧之戰略下，無須藉由申請更正申請專利範圍以迴避先前技術，即讓智慧局仍認定系爭專利具進步性，而作成舉</p>   |

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|  | <p>發不成立之處分，成功的為客戶固守最大的權利範圍。</p> <p>The patent in issue, a utility model, is a bicycle chain wheel-fastening device. The invalidation requester challenged the independent claim of the patent claimed. A bicycle-related patent may be easily challenged given the fact of the relevant technical field being relatively small and there being not much room for R&amp;D. We successfully defended the client's patent without the client having to amend the patent for a design-around. During the proceeding, we had intensive communication with the examiner thereby getting hold of the most possible direction of his discretion to draw up accurate defence strategy. Taiwan IPO admitted the defence we presented, dismissed the invalidation action and the client's patent challenged sustains as is.</p> |
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### Example work 10

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| <p>Name and brief description of case/portfolio:</p> | <p>一日本之化工材料製造商，向經濟部智慧財產局申請舉發要求撤銷另一日本化工材料製造商（本所客戶）之發明專利。案件由經濟部智慧財產局審理後，作成舉發不成立之處分（本所客戶勝訴）。</p> <p>A Japanese manufacturer of chemical engineering materials filed a request with Taiwan IPO seeking invalidation of an invention patent owned by a Japanese fellow member of the trade who is a client of TiPLO. Taiwan IPO dismissed the invalidation action and the patent challenged remains valid in good standing.</p>   |
| <p>IP advisers from your firm involved:</p>          | <p>林志剛律師/專利師<br/>高山峰專利師<br/>廖文慈律師/專利師<br/>邱嘉彬專利工程師<br/>J.K. LIN, Attorney-at-Law / Certified Patent Attorney<br/>Charles S.F. KAO, Certified Patent Attorney<br/>Grace W.T. LIAO, Attorney-at-Law / Certified Patent Attorney<br/>QIOU Jia-Bin, Patent Engineer</p>  |
| <p>Other IP firms involved:</p>                      | <p><b>N/A</b></p>  |
| <p>Date(s)</p>                                       | <p>2016.07：被提起舉發<br/>2016.11：提答辯理由（一）及申請更正專利範圍<br/>2017.04：舉發補充理由<br/>2017.07：提答辯理由（二）<br/>2017.08：智慧局審定舉發不成立</p> <p>July 2016: Invalidation action filed.<br/>Nov. 2016: Patentee filed response statement (I) and a request for amending scope of the patent being challenged.<br/>Apr. 2017: Invalidation requester presented written statement alleging additional reasons why the patent should be invalidated.<br/>July 2017: Patentee filed response statement (II).<br/>Aug. 2017: Taiwan IPO dismissed the invalidation action.</p> |

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| <p>Why was it important?</p> | <p>系爭專利係關於一噴嘴排出式塗敷法用正型光阻阻成物之發明專利，舉發人提出 5 個引證案主張系爭專利欠缺進步性。本所詳細的分析各個引證案與系爭專利於技術特徵之差異，並比較其各自在所欲解決之課題及使用之技術手段上的差異，成功的使智慧局極為快速的於 1 年內即作出舉發不成立之處分，為客戶成功的維持專利權的有效存在。</p> <p>The invention patent in issue is a positive photoresist composition for discharge nozzle type application and resist pattern formation method . Invalidation requested cited a total of five prior arts against the inventive step of the invention. We successfully won for the client Taiwan IPO's dismissal of the adverse action within only a year's time and hence the good standing of the client's invention patent. In the proceeding, we detailed an analytical showing of the difference between the technical features of each of the prior arts cited and those of the client's invention. We also pinpointed the difference between the problems the cited arts each aim to solve and those the client's invention aims to solve as well as how the technical method adopted by the client's invention differs from those adopted by the cited prior arts.</p> |
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**Example work 11**

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| <p>Name and brief description of case/portfolio:</p> | <p>Trademark Opposition<br/>系爭商標： sunlego<br/>註冊號數： 1791332<br/>類別： 11<br/>指定商品：舞台照明燈；車內照明燈；緊急照明燈；停電自動照明燈；照明燈；水族箱用照明燈；照明器具；照明用散光器；照明用放電管；照明用發光管；礦工用照明燈；發光二極體照明燈。<br/>商標權人：國立臺灣科技大學<br/>商標異議人：丹麥商樂高法律股份有限公司（本所客戶）<br/>據以異議商標： <b>LEGO</b></p> <p>Disputed TM: sunlego<br/>Reg. No.: 1791332<br/>Class: 11<br/>Designated Goods: Stage lights; automobile lights; emergency flashlights; auto emergency lights; lights; aquarium lights; lighting apparatus and installations; light diffusers; discharge tubes, electric, for lighting; luminous tubes for lighting; miners' lamps; led lights<br/>Registrant: National Taiwan University of Science and Technology<br/>Opposer: LEGO JURIS A/S<br/>Cited Trademark: LEGO</p> |
|  | <p>異議人對商標權人所有之註冊第 1791332 號商標提出異議，智慧財產局認為二造商標相衝突，而為異議成立之處分，系爭商標之註冊應予撤銷之處分，商標權人未對該處分提起訴願，本案系爭商標因而遭撤銷註冊確定。</p> <p>The Opposer filed an opposition against TM Reg. No. 1791332</p>  |

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|                                      | owned by the Registrant. The Intellectual Property Office (IPO) considering conflict between the two parties' trademarks made an Opposition Founded Decision. As the Registrant failed to institute an administrative appeal, the disputed trademark registration was cancelled and the cancellation has become ascertained.  |
| IP advisers from your firm involved: | 林志剛律師/專利師<br>楊憲祖律師/專利代理人<br>J.K. LIN, Attorney-at-Law / Certified Patent Attorney<br>Rick S. T. YANG, Attorney-at-Law / Patent Agent  |
| Other IP firms involved:             | N/A   |
| Date(s)                              | 2016.12 – 提出異議<br>2017.05 – 智慧財產局為異議成立之處分<br>2017.08 – 撤銷註冊公告<br>December 2016 – Opposition filed<br>May 2017 – Opposition Founded Decision made by the IPO<br>August 2017 – Cancellation published   |
| Why was it important?                | <p>由任意字彙「sun」與著名商標「lego」所結合之系爭商標，可否避免與著名商標產生近似而得以註冊在不相類似之商品/服務？</p> <p>智慧財產局認為，據爭「LEGO」商標已達著名商標之程度，廣為我國相關事業或消費者所普遍認知，且據爭諸商標亦較系爭商標為相關消費者所熟悉，於判斷有無混淆誤認之虞時，應給予較大之保護。系爭「sunlego」商標外文係由習見文字「sun」結合「lego」所組成；兩商標相較，皆有相同之外文「LEGO」部分，雖系爭商標另有外文「sun」作為起首，然其為太陽之意，係習見文字，反觀「LEGO」為無意義之文字，經異議人長期廣泛使用，識別性高，是以系爭商標後段外文「lego」仍給予消費者極深之印象，應屬構成近似程度不低之商標。又衡酌據爭商標經異議人長期廣泛使用已達著名商之程度，識別性高，兩造商標近似程度不低，據爭商標較為消費者所熟悉且其獲准註冊多件商標權有多角化經營之可能，系爭商標指定使用於「舞台照明燈；車內照明燈；緊急照明燈；停電自動照明燈；照明燈；水族箱用照明燈；照明器具；照明用散光器；照明用放電管；照明用發光管；礦工用照明燈；發光二極體照明燈」商品，自易使消費者誤認其所提供之商品源自於異議人，客觀上仍有使相關公眾誤認二商標之商品來自同一來源，或誤認二商標之使用人間存在關係企業、授權關係、加盟關係或其他類似關係，而產生混淆誤認之虞，智慧財產局因而為系爭商標之註冊應予以撤銷之處分。</p> <p>Whether the disputed trademark combining a common word “sun” with the famous “lego” may be granted registration on dissimilar goods/services?</p> <p>The IPO considered that the cited “LEGO” trademark known among local relevant business or consumers so as to become famous; the cited trademarks with which relevant consumers are more familiar than the disputed trademark should enjoy more protection; the disputed TM “sunlego” is a combination of “sun” and “lego”; comparing the two trademarks, both contain the same “LEGO”; the disputed trademark starts with “sun” which is a common word but</p> |

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|  | <p>“LEGO” without any specific meaning has become distinctive through the Opposer’s long-term and extensive use; therefore, the other word “LEGO” is impressive to consumers; they should be deemed closely similar trademarks; in view that the cited trademarks have become famous and distinctive through the Opposer’s long-term and extensive use, consumers are familiar with the cited trademarks, the Opposer has acquired many trademark rights and has the strategy of diversification, the disputed trademark designating for use on “stage lights; automobile lights; emergency flashlights; auto emergency lights; lights; aquarium lights; lighting apparatus and installations; light diffusers; discharge tubes, electric, for lighting; luminous tubes for lighting; miners' lamps; led lights” would make consumers misidentify the goods as those from the Opposer; objectively, relevant consumers could misidentify the goods bearing the two parties’ trademarks as those from the same source or misbelieve that there is an affiliating, licensing, franchising or other similar relationship between the two trademark users so as to be likely to cause confusion and misidentification. Therefore, the IPO made a decision to cancel the disputed trademark registration.</p> |
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**Example work 12**

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| <p>Name and brief description of case/portfolio:</p> | <p><b>Trademark Abandonment</b><br/>         系爭商標：TUV<br/>         註冊號數：1023109<br/>         類別：12<br/>         指定商品：機車、船舶、航空機用之活塞、活塞環、活塞梢、汽缸套、汽缸襯、排氣閥、避震器、曲軸、濾油器、氣門嘴、剎車來令、離合器。<br/>         商標權人：詠翔工業股份有限公司（「YCP 公司」）<br/>         Disputed TM: TUV<br/>         Reg. No.: 1023109<br/>         Class: 12<br/>         Designated Goods: Pistons, piston rings, piston pins, cylinder liners, cylinder bushes, exhaust valves, shock absorber, crankshafts, oil filters, schrader valves, brake linings and clutches for automobiles, motorcycles, ships, aircrafts<br/>         Registrant: YONG CHIANG PISTONS CO., LTD.</p> |
|  | <p>本所客戶德商 TÜV 品牌協會發現，以汽車零件銷售為主要業務之 YCP 公司於西元 2002 年取得註冊號數第 1023109 號之系爭商標「TUV」。惟本所客戶所隸屬之杜夫萊茵集團（TÜV Rheinland）乃國際知名的獨立第三方認證機構，並以「TÜV」作為市場核心識別標誌，YCP 公司使用系爭商標將導致消費者誤認其產品均經德國杜夫萊茵集團驗證，而有損害「TÜV」信譽及誤導消費者之虞。經本所發函要求 YCP 公司自行撤銷系爭商標，YCP 公司旋於一個月內拋棄系爭商標，該項商標拋棄並經智慧財產局公告撤銷在案。</p> <p>The client, TÜV Markenverbund e.V., found that in 2002 Yong Chiang Pistons Co., Ltd. mainly running automobile parts business registered the disputed TM “TUV” as No. 1023109. However, the client is a</p>  |

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|                                     | <p>member of TÜV Rheinland Group, which is a leading global independent testing and certification service provider using “TUV” as the core mark for its services. Yong Chiang Pistons Co., Ltd.’s of the disputed trademark will possibly cause consumers to misidentify its products as those certified by TUV Rheinland Group so as to damage “TÜV” reputation as well as to mislead consumers. Being asked to abandon the disputed trademark in a cease and desist letter sent by this Office, Yong Chiang Pistons Co., Ltd. abandoned the disputed trademark within one month and the abandonment has been officially published by the IPO.</p>   |
| IP advisers from your firm involved | <p>林志剛律師/專利師<br/>楊憲祖律師/專利代理人<br/>陳奐君律師<br/>J.K. LIN, Attorney-at-Law / Certified Patent Attorney<br/>Rick S. T. YANG, Attorney-at-Law / Patent Agent<br/>H. J. Chen, Attorney-at-Law</p>  |
| Other IP firms involved             | N/A   |
| Date(s)                             | <p>2017.07 – 寄發律師函要求商標權人拋棄系爭商標。<br/>2017.08 – 商標權人函覆本所表示同意拋棄系爭商標。<br/>2017.08 – 商標權人自請撤銷系爭商標獲准。<br/>2017.09 – 撤銷註冊公告。</p> <p>July 2017 – Cease and desist Letter sent to the Registrant for abandonment of the disputed trademark<br/>August 2017 – Response to agree abandonment of the disputed trademark<br/>August 2017 – Approval to the application of abandonment filed by the Registrant<br/>September 2017 – Abandonment publication</p>   |
| Why was it important?               | <p>他人註冊超過五年之商標有與自己商標構成混淆誤認之虞時，除主張著名商標保護外，有何方式可撤銷該他人商標？</p> <p>本件 YCP 公司除註冊系爭商標外，另曾在商品目錄印製表彰經杜夫萊茵集團驗證通過之「TÜV CERT」標識，惟 YCP 公司雖曾向杜夫萊茵集團取得認證，但該認證早已過期失效，相關資料卻持續可由網路檢索而得。綜合 YCP 公司將標示「TÜV CERT」之產品文件置於網路，以及相關大眾接觸系爭商標將不可避免聯想到杜夫萊茵集團之「TÜV」等情，該公司有違反公平交易法與商標法之嫌。本所發函予 YCP 公司後，YCP 公司旋即表示願自請撤銷系爭商標，本所客戶之商標權亦獲得有效率的保障。</p> <p>In addition to claim protection of famous trademark, how to successfully cancel another person’s trademark which has been registered for over five years and could cause confusion and misidentification?</p> <p>Yong Chiang Pistons Co., Ltd. not only has registered the disputed trademark, but also used “TÜV CERT” symbol in product catalogues. However, Yong Chiang Pistons Co., Ltd. had ever been certified by</p> |



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|  | <p>TÜV Rheinland Group and the relevant information was still available on internet even if the certificates had been expired. Since Yong Chiang Pistons Co., Ltd. suspiciously is in contravention of the Fair Trade Law and the Trademark Law by posting "TÜV CERT" stuff on the website that relevant public inevitably could associate the disputed trademark with TÜV Rheinland Group's TÜV symbol, this Office sent a cease and desist letter. Yong Chiang Pistons Co., Ltd. immediately agreed to abandon the disputed trademark, and by way of such an abandonment the client's trademark right can be protected efficiently.</p> |
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