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TIPLO Outstanding work on Litigation Case (2014.3)

Example work 1

Name and brief description of case/portfolio:	一日本之半導體製造商（本所客戶）起訴控告另一日本之半導體製造商侵害其專利權，該被控告侵權之半導體製造商於民事法院提出專利權不具有效性之抗辯，復向經濟部智慧財產局申請舉發要求撤銷本所客戶之專利。本案民事侵權部分係由其他事務所承辦，法院於民事判決中先做出系爭專利不具有效性的認定，導致本所客戶的處境相當不利。於實務上通常的情況係智慧財產局會尊重法院之認定亦作出舉發成立之處分。但由本所承辦之舉發案件中，成功的逆轉不利的處境，智慧財產局審理後，作成舉發不成立之處分，本所成功的為客戶完整的維持其專利的有效性。 A Japanese semiconductor maker, client of TIPLO, initiated a patent infringement action against a fellow maker in the same trade also in Japan. The accused Japanese company then challenged the validity of the client's patent in issue as a defense in the civil proceedings and also sought for invalidation of the patent in issue with Taiwan IPO. Represented by another law firm in the civil action, the client received a court decision that was adverse to the client by negating the validity of the patent in issue. In common practice, Taiwan IPO would respect a court decision to likewise invalidate the patent in issue. However, in the invalidation action, Taiwan IPO decided not to invalidate the patent in issue and therefore TIPLO successfully reversed the client's situation and maintained the validity of the patent in issue.
IP advisers from your firm involved:	林志剛　律師/專利師 高山峰　專利師 廖文慈　律師/專利師 王照廷　專利工程師 J. K. LIN, Attorney-at-Law and Certified Patent Attorney S. F. KAO, Certified Patent Attorney Grace W.T. LIAO, Attorney-at-Law and Certified Patent Attorney Chao-Ting WANG, Patent Engineer
Other IP firms involved:	N/A
Date(s)	2007.09：被提起舉發 2007.11：舉發人提補充理由（一） 2008.12：舉發人提補充理由（二）

	2009.11：提呈被舉發答辯（一） 2010.01：提呈被舉發答辯（二） 2011.08：提呈被舉發答辯（三） 2012.12：智慧局作成舉發不成立之處分 A brief chronology: Sep. 2007-- Client's patent was challenged with respect to the validity thereof. Nov. 2007 / Dec. 2008-- The accused Japanese company presented written statements (I) / (II) of reasons for the invalidation. Nov. 2009 / Jan. 2010 / Aug. 2011-- Client filed statement of defense (I) / (II) / (III). Dec. 2012-- The challenge was not successful upon Taiwan IPO's examination.
Why was it important?	系爭專利係關於一半導體基板之發明專利。案件之起因係本所客戶起訴控告另一日本之半導體製造商侵害其專利權，該被控告侵權之半導體製造商於民事法院提出專利權不具有效性之抗辯，復向經濟部智慧財產局申請舉發要求撤銷本所客戶之專利。本案民事侵權部分係由其他事務所承辦，法院於民事判決中先做出系爭專利不具有效性的認定，導致本所客戶的處境相當不利。於實務上通常的情況係智慧財產局會尊重法院之認定亦作出舉發成立之處分，以免造成裁判之歧異。但由本所承辦之舉發案件中，再本所強力的答辯下，協助客戶於無須藉由更正申請專利範圍之方式限縮其權利範圍下，成功的逆轉不利的處境，由智慧財產局作成舉發不成立之處分，成功的為客戶完整的維持其專利的有效性。於實務上極為罕見。 The client's patent is an invention with respect to semiconductor substrate, for which the client initiated an action against a Japanese fellow maker in the same trade asserting the said Japanese company's infringement. For defense, the said Japanese company challenged the validity of the patent in issue in the civil proceedings and also filed an invalidation action with Taiwan IPO. The court decided in favor of the said Japanese company to negate the validity of the patent in issue, which put the client in an adverse situation. In practice, Taiwan IPO would decide on the invalidation action in line with a court decision. In this case, Taiwan IPO, however, decided not to invalidate the patent in issue after examination. That is, TIPLO successfully defended the validity of the client's patent in issue without narrowing down the scope of claims of the patent in issue. It is a rare example that Taiwan IPO makes a reverse decision not in line with a court decision.

Example work 2

Name and brief description of case/portfolio:	一日本自行車製造商（本所客戶），向經濟部智慧財產局申請舉發要求撤銷另一德國自行製造商之專利。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）。舉發人不服而向法院起訴，亦被法院駁回起訴確定。 A Japanese maker of bicycles, client of TIPLO, sought for the invalidation of a patent owned by a German fellow member in the trade and Taiwan IPO had the challenged patent invalidated. The German patentee appealed with the MOEA Appeal Board and the Appeal Board let stand Taiwan IPO's invalidation decision. That is, client's invalidation action is successful. The German patentee further initiated an action but the court dismissed the action by a final decision.
IP advisers from your firm involved:	林志剛　律師/專利師 高山峰　專利師 廖文慈　律師/專利師 詹皓安　專利工程師 J. K. LIN, Attorney-at-Law and Certified Patent Attorney S. F. KAO, Certified Patent Attorney Grace W.T. LIAO, Attorney-at-Law and Certified Patent Attorney Hao-An CHAN, Patent Engineer
Other IP firms involved:	N/A
Date(s)	2007.08：提起舉發 2008.05：舉發補充理由（二） 2009.08：舉發補充理由（三） 2010.05：舉發補充理由（四） 2010.05：辦理面詢 2010.06：舉發補充理由（五） 2010.11：舉發補充理由（六） 2011.08：舉發補充理由（七） 2011.12：智慧局作成舉發成立之處分 2012.08：訴願會駁回訴願 2013.07：智慧法院駁回起訴確定 A brief chronology: Aug. 2007 -- Client filed invalidation action with Taiwan IPO. May 2008 / Aug. 2009 / May 2010 -- Client presented written statements (II) / (III) / (IV) of reasons for the invalidation sought for. May 2010 -- Client requested Taiwan IPO for an interview for its opinion to be heard. Jun. 2010 / Nov. 2010 / Aug. 2011 -- Client supplemented written statements (V) / (VI) / (VII) of reasons for the invalidation sought for. Dec. 2011 --

	Taiwan IPO invalidated the patent challenged Aug. 2012 -- MOEA Appeal Board dismissed the patentee's appeal. Jul. 2013 -- IP Court dismissed the action the patentee initiated.
Why was it important?	1. 系爭專利係關於一觸發器開關用之調整裝置之發明專利，舉發人（本所客戶）針對其中一獨立項及其附屬項提出舉發，自 2007 年申請舉發後，前後共提出七次補充理由，被舉發人亦提出二次更正申請專利範圍之申請，被舉發人逼迫不斷的限縮申請專利範圍，雙方極盡攻防之能事，顯見本件舉發之複雜性。案件由經濟部智慧財產局作成舉發成立之處分（本所客戶勝訴）。被舉發人嗣後雖不服智慧局之處分而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。舉發人不服而向法院起訴，亦被法院駁回起訴確定（本所客戶勝訴）。 1. The patent challenged is an invention on an adjusting device used on the trigger switch. Client sought for the invalidation of one of the independent claim and its dependent claims and, due to the complexity of the issues involved, presented a total of seven written statements of reasons after filing the invalidation action in 2007. In the meantime, the patentee twice requested to correct and had to repeatedly narrow down the scope of claims of its patent. Client's efforts prove successful with the MOEA Appeal Board dismissing the patentee's appeal taken from Taiwan IPO's invalidation decision and further with the court dismissing the action initiated by the patentee by a final decision. 2. 本案之爭點在於在觸發器開關上的操作桿根數是否為熟悉該項技術者可容易置換變化的設計選擇？系爭案的發明是否可藉由該相異點而產生舉發證據所無法預期的效果？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？ 2. The focal issues in dispute in this case are: (a) Can a person skilled in the art easily opt to change/adjust the amount of the operating levers of the trigger switch? (b) Can the invention in issue achieve any effect unexpected by the evidence presented by differentiating the amount of the operating levers? (c) Is it possible at all for a person skilled in the art to combine the various evidence presented?

Example work 3

Name and brief description of case/portfolio:	一日本發光元件製造商（本所客戶）之發明專利先後被 4 家不同的韓國之發光元件製造商及化學公司提出舉發要求撤銷其專利權。經濟部智慧財產局審理後，智慧財產局就 4 件舉發案均陸續作成舉發不成立之處分（本所客戶勝訴）。 A Japanese light-emitting component maker, client of TIPLO, holds an invention patent, against which 4 Korean light-emitting makers and chemical companies had one after another filed invalidation actions with Taiwan IPO. Taiwan IPO had dismissed the said 4 companies' invalidation actions after examination. That is, the client succeeded in the invalidation action.

IP advisers from your firm involved:	林志剛　律師/專利師 高山峰　專利師 蕭助政　專利工程師 J. K. LIN, Attorney-at-Law and Certified Patent Attorney S. F. KAO, Certified Patent Attorney Harry HSIAO, Patent Engineer
Other IP firms involved:	N/A
Date(s)	2009.11：被提起舉發 2009.12：提答辯理由（一） 2010.10：提答辯理由（二） 2011.08：提答辯理由（三） 2013.08：智慧局審定舉發不成立 A brief chronology: Nov. 2009-- Client's patent was challenged with respect to its validity. Dec. 2009 / Oct. 2010 / Aug. 2011-- Client filed a statement of defense (I), (II), (III). Aug. 2013-- These invalidation actions were not successful upon Taiwan IPO's examination.
Why was it important?	系爭專利係關於一發光元件及發光媒體之發明專利，舉發人主張系爭專利欠缺新穎性及進步性及記載不明確導致無法據以實施等理由而應予撤銷。經被舉發人最小限度的限縮申請專利範圍及強力的答辯進行下，智慧局就該 4 件舉發案均陸續作成舉發不成立之處分。本所成功的為客戶完整的維持其專利的有效性。 The patent challenged involves an invention in regard to a light-emitting component and light-emitting medium. The said 4 Korean companies challenged the validity of the patent in issue by indicating its lack of novelty and inventive steps and also its impracticability due to the content of its specification being not specific enough. After the client had slightly narrowed down the scope of claims of the patent in issue and TIPLO's successful defense, Taiwan IPO did not have the patent in issue invalidated after examination and the client successfully sustains the validity of the patent in issue.

Example work 4

Name and brief description of case/portfolio:	一日本自行車製造商（本所客戶），向經濟部智慧財產局申請舉發要求撤銷另一德國自行製造商之專利。案件由經濟部智慧財產局審理中後作成舉發成立的處分（本所客戶勝訴）。 A Japanese bicycle maker, a client of TIPLO, filed an invalidation action with Taiwan IPO to seek invalidation of the patent held by a fellow member of the trade in Germany. Taiwan IPO examined the invalidation action and decided to have the challenged patent invalidated. That is, client's invalidation action is successful.
IP advisers from your firm involved:	林志剛　律師/專利師 高山峰　專利師

	廖文慈　律師/專利師 蔡爾修　專利師 J. K. LIN, Attorney-at-Law and Certified Patent Attorney S. F. KAO, Certified Patent Attorney Grace W.T. LIAO, Attorney-at-Law and Certified Patent Attorney Richard TSAI, Certified Patent Attorney
Other IP firms involved:	N/A
Date(s)	2008.06：提起舉發 2011.10：被舉發人第一次申請更正申請專利範圍 2012.01：提補充理由（一） 2012.04：舉行面詢 2012.06：提補充理由（二） 2012.08：被舉發人第二次申請更正申請專利範圍 2013.08：智慧局審定舉發成立 A brief chronology: Jun. 2008— Client filed invalidation action challenging the validity of the patent in issue. Oct. 2011-- The said German company filed the first request for making amendments to the scope of claims of the patent in issue. Jan. 2012-- Client supplemented statement (I) of reasons for seeking the invalidation. Apr. 2012-- Client requested Taiwan IPO for an interview for its opinions to be heard. Jun. 2012-- Client supplemented statement (II) of reasons for seeking the invalidation. Aug. 2012-- The said German company filed another request for amending the scope of claims of the patent in issue. Aug. 2013— Taiwan IPO invalidated the patent in issue.
Why was it important?	系爭專利係關於一自行車用之傳動鏈之發明專利，本所為客戶提出舉發後，被舉發人於 2011 年提出第一次更正申請專利範圍之申請，限縮申請專利範圍。惟於本所繼續為客戶提出補充理由並申請面詢向智慧局之審查委員當面解釋說明相關之技術問題後，在審查委員之強力要求下，迫使被舉發人二度大幅限縮申請專利範圍，再度提出更正申請專利範圍之申請，但即便如此，智慧局最終仍認定系爭專利不具進步性而審定舉發成立。 The patent in issue involves an invention in respect to drive chain for bicycles. The said German company filed the first request for making amendments to narrowing down the scope of claims of the patent in issue in 2011 after the client filed a request for invalidation of the patent in issue. After TIPLO represented the client to present supplemental reasons for seeking invalidation of the patent in issue and to request for an interview to present relevant technical issues

	to Taiwan IPO, the said German company again narrowed the scope of claims of the patent in issue upon Taiwan IPO' request. Taiwan IPO finally decided to have the patent in issue invalidated on the ground of lack of inventive steps of the patent in issue.

Example work 5

Name and brief description of case/portfolio:	一日本自行車製造商（本所客戶），向經濟部智慧財產局申請舉發要求撤銷另一台灣自行製造商之專利。案件由經濟部智慧財產局審理後作成舉發成立的處分（本所客戶勝訴）。 A Japanese bicycle maker, client of TIPLO, filed an invalidation action with Taiwan IPO to seek invalidation of the patent held by a fellow member of the trade in Taiwan. The client successfully had the patent in issue invalidated after Taiwan IPO's examination.
IP advisers from your firm involved:	林志剛　律師/專利師 高山峰　專利師 廖文慈　律師/專利師 詹皓安　專利工程師 J. K. LIN, Attorney-at-Law and Certified Patent Attorney S. F. KAO, Certified Patent Attorney Grace W.T. LIAO, Attorney-at-Law and Certified Patent Attorney Hao-An CHAN, Patent Engineer
Other IP firms involved:	N/A
Date(s)	2010.10：提起舉發 2010.11：補充理由（一） 2011.01：被舉發人更正申請專利範圍 2012.11：補充理由（二） 2012.04：舉行面詢 2013.08：智慧局審定舉發成立 A brief chronology: Oct. 2010-- Client filed invalidation action challenging the validity of the patent in issue. Nov. 2010-- Client supplemented statement (I) of reasons for seeking the invalidation. Jan. 2011-- The Taiwanese patentee filed a request for making amendments to the scope of claims of the challenged patent. Nov. 2012-- Client supplemented statement (II) of reasons for seeking the invalidation. Apr. 2012-- Client requested Taiwan IPO for an interview for its opinions to be heard. Aug. 2013-- Taiwan IPO had the challenged patent invalidated after examination.

Why was it important?	系爭專利係關於一自行車用之變速器改良之發明專利，本所為客戶提出舉發後，被舉發人提出更正申請專利範圍之申請，大幅的限縮申請專利範圍。惟於本所繼續為客戶提出補充理由並申請面詢向智慧局之審查委員當面解釋說明相關之技術問題後，智慧局最終仍認定系爭專利不具進步性而審定全部請求項均舉發成立。 The patent in issue is an invention on transmission for bicycles. After TIPLO represented the client to file an invalidation action, the Taiwanese patentee filed a request for making amendments to the patent in issue by largely narrowing down the scope of claims of the patent in issue. After TIPLO had represented the client to present supplemental reasons for seeking invalidation and requested for an interview to present relevant technical issues to Taiwan IPO, Taiwan IPO decided to invalidate all claims of the patent in issue on the ground of lack of inventive steps.

Example work 6

Name and brief description of case/portfolio:	一台灣之基板保持環製造商，於相近的時間內，向經濟部智慧財產局申請舉發要求撤銷一日本之基板保持環製造商一共 8 件權利範圍相近之設計專利。8 件案件陸續由經濟部智慧財產局審理後，均作成舉發不成立之處分（本所客戶勝訴）。縱使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舉發人之訴願（本所客戶勝訴）。 A Taiwanese substrate retaining ring maker had successively in a short period of time filed invalidation actions with Taiwan IPO against 8 design patents held by a Japanese maker in the same trade, a client of TIPLO. The Taiwanese maker failed in these invalidation actions after Taiwan IPO's examination, and further appealed with the MOEA Appeal Board. The Appeal Board let stand the Taiwan IPO's invalidation decisions. That is, client succeeded in these invalidation actions.
IP advisers from your firm involved:	林志剛　律師/專利師 高山峰　專利師 廖文慈　律師/專利師 涂神溢　專利師 J. K. LIN, Attorney-at-Law and Certified Patent Attorney S. F. KAO, Certified Patent Attorney Grace W.T. LIAO, Attorney-at-Law and Certified Patent Attorney Shen-Yi TU, Certified Patent Attorney
Other IP firms involved:	N/A
Date(s)	2012.12：被提起舉發 2013.02：提答辯理由（一） 2013.09：智慧局審定舉發不成立 A brief chronology: Dec. 2012-- Client's patents in issue were challenged with respect to the validity thereof. Feb. 2013--

	Client filed a statement of defense (I). Sep. 2013-- The challenges were unsuccessful upon Taiwan IPO's examination.
Why was it important?	該 8 件設計專利係關於基板保持環之設計專利，權利範圍甚為均相近，舉發人於極為相近的時間內就該 8 件設計專利提出舉發，各件舉發案之舉發證據亦不盡相同，於實務上甚為罕見。在本所成功的答辯策略進行下，提出由舉發證據之剖面圖推導為近似於系爭專利之立體圖的不必然性理論，成功的說服智慧局就該 8 件舉發案均作出舉發不成立之審定，縱使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舉發人之訴願。本所成功的為客戶完整的維持其 8 件專利的有效性。 The client's 8 patents challenged involve the designs on substrate retaining ring, whose scopes of claims are close to one another. The Taiwanese maker had filed invalidation actions against the 8 patents in issue one after another in a short period of time based on different evidences, which is a rare practice. TIPLO successfully defended client's patents in issue and beat the challenge by negating the Taiwanese maker's alleged apodictic similarity between the three-dimensional patterns of the patents in issue and the three-dimensional pattern deduced from the sectional drawing the Taiwanese maker cited as evidence of invalidation. By strategically refuting such alleged similarity, TIPLO upheld the validity of the patents in issue upon Taiwan IPO's dismissal of the invalidation actions. The Taiwanese maker appealed with the MOEA Appeal Board which still let stand the Taiwan IPO's invalidation decisions.

Example work 7

Name and brief description of case/portfolio:	一台灣之進口商，前後 3 次向經濟部智慧財產局申請舉發要求撤銷一日本之家電用品製造商之保溫杯之設計專利。3 件案件陸續由經濟部智慧財產局審理後，均作成舉發不成立之處分（本所客戶勝訴）。舉發人嗣後向經濟部訴願審議委員會提起訴願，訴願會一度鮮見的召開言詞辯論庭重新調查證據，欲推翻智慧財產局的處分。經本所成功的答辯並出庭防衛後，經濟部訴願審議委員會維持智慧財產局之處分而駁回舉發人之訴願（本所客戶勝訴）。 A Taiwanese importer had successively filed three invalidation actions with Taiwan IPO against a design patent for thermos mugs held by a Japanese electric home appliances maker but these invalidation actions were all unsuccessful upon Taiwan IPO's examination. The said Taiwanese importer subsequently appealed with the MOEA Appeal Board to seek a reverse decision and the Appeal Board had once held a hearing for oral argument to re-initiate investigation, which had seldom occurred in the MOEA Appeal Board's practice. However, the MOEA Appeal Board still let stand the Taiwan IPO's decisions after TIPLO had acted for the client to defend the patent in issue. That is, the Japanese electric home appliances maker successfully defends the validity of its design patent.

IP advisers from your firm involved:	林志剛　律師/專利師 廖文慈　律師/專利師 張啓宏　專利工程師 J. K. LIN, Attorney-at-Law and Certified Patent Attorney Grace W.T. LIAO, Attorney-at-Law and Certified Patent Attorney Chi-Hung CHANG, Patent Engineer
Other IP firms involved:	N/A
Date(s)	2011.09：被提起舉發 2012.12：提答辯理由（一） 2013.08：提答辯理由（二） 2013.08：經濟部訴願審議委員會召開言詞辯論庭 2013.10：智慧局審定舉發不成立 A brief chronology: Sep. 2011-- Client's patent in issue was challenged with respect to its validity. Dec. 2012 / Aug. 2013-- Client filed a statement of defense (I) and (II). Aug. 2013-- The MOEA Appeal Board held a hearing for oral argument. Oct. 2013-- The challenge was unsuccessful upon Taiwan IPO's examination.
Why was it important?	該設計專利係關於該日本家電用品製造商之經典保溫杯之設計專利，該公司所製造販售之各式保溫杯中均標榜系爭設計專利之新穎特徵。系爭專利前後曾 3 次被他人向經濟部智慧財產局申請舉發，在本所成功的答辯策略進行下，智慧財產局均陸續作出舉發不成立之審定。即便於 N03 案中，訴願會一度鮮見的召開言詞辯論庭重新調查證據，欲推翻智慧財產局的處分。然而經本所成功的答辯並出庭防衛後，經濟部訴願審議委員會於言詞辯論庭後一個月的時間內快速地駁回舉發人之訴願（本所客戶勝訴），舉發人並放棄向法院提出上訴。本所成功的為客戶完整的該重要的設計專利的有效性。 The patent in issue involves a design specifically for the thermos mugs made by the Japanese electric home appliances maker, and every thermos mug of the Japanese maker bears such design as a novel characteristic. Three challenges against the validity of the patent in issue had been all unsuccessful upon Taiwan IPO's examination through TIPLO's defense. Even though the MOEA Appeal Board had once held a hearing for oral argument to reinitiate investigation on the 3rd invalidation action, the Appeal Board still dismissed the Taiwanese importer's appeal within one month after the hearing. The Taiwanese importer did not go further to litigate this matter, and the client successfully maintains the validity of the patent in issue.

Example work 8

Name and brief description of case/portfolio:	一日本之基板搬送裝置製造商（本所客戶）因在中國發現一台灣之基板搬送裝置製造商於台灣製造及輸出之侵權產品，故擬在台灣起訴控告該製造商侵害其專利權，但本所客戶僅有侵權產品之照片，並無實物；且侵權產品無法於公開市場取得，故該製造商恐於訴訟中否認有製造侵權品之事實，不利我方專利權之行使，故以「防止證據有滅失或礙難使用之虞」，且「有確定事、物現狀之法律上利益」為由，於起訴前向法院聲請證據保全。智慧財產法院審酌我方提出之證據資料後，認為我方有提出鑑定報告釋明專利權受侵害之情事，且認聲請證據保全有確定侵權人侵權行為有無之法律上利益，故准予證據保全。證據保全之方式係就侵權人營業場所之侵權產品進行拍照及攝影勘驗後，並取一件交智慧財產法院保存。雖然智慧財產法院准予證據保全之核准率低，但本所仍成功的為客戶藉由證據保全程序取得侵權產品，而於備妥證據後向法院起訴請求排除侵害。 A Japanese maker of substrate transfer apparatus, the patentee and our client, was informed in China that certain substrate transfer apparatus made and exported by a Taiwanese fellow member of the trade was infringing upon its relevant patent and decided to sue the infringer for patent infringement in Taiwan. However, the accused product was not commercially available and so no physical sample was available for examination and to be presented as evidence. The only piece of physical evidence our said client had is a photo of the accused product, a very weak proof to establish the alleged infringement. To remove said adversity in the action to initiate against the infringer, we successfully filed a motion for preservation of evidence filed for the client on the grounds of (a) preventing evidence from loss or unreasonable hardship to introduce the evidence in the proceeding and (b) client's *legal interest in ascertaining the status quo of the evidence to be introduced in the action*. In practice, the court tends to put a motion seeking preservation of evidence to very strict tests and only a less-than-moderate number of claimants have succeeded in obtaining the ruling sought for. After considering the evidence and materials presented, the court granted the motion on the showing of (1) the infringement alleged made with the patent infringement analysis presented, (2) the patentee claimant (i.e. the client) having legal interests in ascertaining whether or not its patent is infringed. Generally speaking, the preservation of evidence is executed at the accused's business premises by taking pictures, video recording and performing an on-site inspection of the accused product a physical sample of which will be taken and presented to the IP Court for record.
IP advisers from your firm involved:	陳和貴　律師/專利師 劉倫仕　律師/專利代理人 H. G. Chen, Attorney-at-Law and Certified Patent Attorney Lawrence LIU, Attorney-at-Law and Patent Agent
Other IP firms involved:	N/A.

Date(s)	Timeline: -- 17 Jun. 2013: Filed the motion for perpetuation of evidence. 26 Jun. 2013: Court granted the motion. 03 July 2013: Received the ruling for perpetuation of evidence. 23 July 2013: Perpetuation of evidence performed at the accused's premises. 22 Aug. 2013: Patentee claimant initiated action in the IP Court against the accused.
Why was it important?	智慧財產法院對於證據保全聲請核准率低(從統計資料上可知平均核准率不到 20%)。因法院考量證據保全易被濫用而以窺探營業秘密。但因取得侵權物品實物係為證明侵權品有落入專利權範圍及侵權人有製造及販賣侵權品之主要舉證方式，故本所於分析法院於核准案例所考量之要件後，為本所客戶擇定最適當之證據保全範圍，故獲得智慧財產法院准予證據保全，為日後之起訴行動跨出重要之一步。 IP Court tends to put motions seeking perpetuation of evidence to very strict tests in consideration of preventing the claimant from abusing the proceeding to probe the respondent's trade secret. (The relevant statistics shows a less-than-20% success rate.) Nevertheless, the physical sample of the accused product is the key means of evidence to establish the accused product falls into the scope of claims of the patent in issue and so the alleged infringement stands. By getting hold of an understanding of the court's examination and deliberation of the relevant motions seeking preservation of evidence, we assisted clients in defining the scope of the preservation sought for acceptable to the court to successfully obtain the preservation order.

Example work 9

Name and brief description of case/portfolio:	(承上案例)於實施證據保全時，本所客戶發現侵權人之營業場所置放大量從事侵害行為之原料及器具，雖經由法院公權力取得半成品一件，但如其餘從事侵害行為之原料任由侵權人在訴訟期間內將之交付予第三人或為處分行為，則本所客戶勢必無法於獲得勝訴判決之後銷毀該從事侵害行為之原料及器具。故為保全將來銷毀請求權之強制執行，遂建議本所客戶向智慧財產法院聲請一般假處分禁止侵權人處分系爭侵權產品及從事侵害行為之原料及器具。 智慧財產法院於審酌後，認為我方有就假處分之本案請求(即侵害專利權之事實)已為相當之釋明，就侵權人會處分系爭產而有日後無法執行可能性之部分，釋明雖有不足，但仍同意供擔保後為假處分。嗣在本所協助客戶迅速地進行假處分執行，並使本所客戶成功的在侵權人營業處所扣押為數不少之從事侵害行為之原料及器具。雖然侵權人有向法院提出抗告及再抗告，但最後在本所成功地答辯之下，遭最高法院駁回確定。 (Furthering to the case as profiled above) Upon executing the ruling for preservation of evidence at the accused's premises, a substantial amount of materials, tools and equipment used to manufacture the accused product were sighted, all of which the respondent could freely remove or transfer to a third party or otherwise dispose of during the proceeding, in which case, it would

	be impossible for the client to demand for destruction of them in the action. We therefore advised the client to immediately file a motion for provisional injunction which the court granted on acceptable showing of the possibility that there would be no property to merit the execution of the judgment final with binding effects in favor of the client. Much as the provisional injunction order was granted on condition of the deposit of a security bond, we successfully assisted the client in quickly having the above materials, tools and equipment seized in time and beating the respondent's appeal up to the Supreme Court.
IP advisers from your firm involved:	陳和貴 律師/專利師 楊益昇 律師/專利代理人 H. G. CHEN, Attorney-at-Law and Certified Patent Attorney Yi-Sheng YANG, Attorney-at-Law and Patent Agent
Other IP firms involved:	N/A
Date(s)	Timeline: -- 20 Aug. 2013: Filed motion for provisional injunction filed. 30 Aug. 2013: Motion granted. 09 Sep. 2013: Received the ruling for provisional injunction 12 Sep. 2013: Filed motion for execution of the injunction order. 18 Sep. 2013: Executed the injunction order at respondent's premises. 27 Sep. 2013: Respondent took interlocutory appeal. 15 Oct. 2013: Answer filed on behalf of client. 17 Oct. 2013: IP Court dismissed respondent's interlocutory appeal. 01 Nov. 2013: Respondent appealed further. 03 Dec. 2013: Answer filed on behalf of the client. 21 Jan. 2014: Supreme Court dismissed respondent's appeal.
Why was it important?	雖然可透過證據保全取得侵權物品，但如為避免侵權人在判決前繼續製造及販賣侵權產品，實務上通常會聲請定暫時狀態處分。惟准予定暫時狀態處分之要件嚴格，且即便准予，亦會要求專利權人供擔保後始得執行之，且會同意侵權人提反擔保後免為執行，故目前在智慧財產權侵權訴訟聲請定暫時狀態假處分之案件並非常見。但在本件案例中，因透過證據保全程序而發現侵權人於其營業場所有置放大量從事侵權之原料及器具，故為免侵權人在訴訟期間任意處分該原料，以保全將來銷毀請求權之執行，故決定不採聲請定暫時狀態處分之方式，而係透過一般假處分之聲請來達成。最後也成功的阻止侵權人以該原料為後續可能之侵權行為。 While the accused infringing product may be obtained for physical evidence by way of perpetuation of evidence, in practice, it is advisable for the claimant to also seek an injunction order to prevent the accused from continuing the manufacturing and distribution of the infringing product before the proceeding on the action concludes with a favorable judgment final with binding effects. However, the courts tend to adopt very strict tests in deciding to or not to grant a motion for preliminary injunction and, generally speaking, will order the claimant to make a security bond whereas the respondent will be allowed to post a counter security bond to be exempted from the

	execution of the injunction order granted. As such, the number of claimants who successfully obtained a ruling for preliminary injunction from the IP Court has remained relatively low. In this case, in consideration of (a) preventing the accused from disposing of the materials, articles and equipment used to make the infringing product (sighted during the execution of the ruling for perpetuation of evidence) in the proceeding and (b) seizing those materials, articles and equipment to merit the execution of the award of the demand for destruction of them, we recommended the client to seek and the client succeeded in obtaining a provisional injunction as opposed to preliminary injunction thereby preventing the accused from continuing manufacturing and distributing the infringing product.

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