

# Intellectual Property and Commercial Court`s Guidelines on Preparing Legal Documents during Litigation concerning Patent Infringement

Date: July 1, 2021

## **1. Plaintiff's Complaint- the sections of factual statements and evidence should follow the instructions below:**

- (1) Grounds for a Cause of Action must be stated, for instance:
  - (a) Plaintiff demands a monetary remedy of NTD \_\_\_\_\_ arising from defendant's intentionally infringing plaintiff's rights vested in Article 184, Paragraph 1 of the Civil Code so as to cause damages on plaintiff.
  - (b) Plaintiff requests this Court, according to Article 84, Paragraph 1 of the Patent Act, to enjoin defendant from making, offering for sales, selling, making the use of, or for above purposes importing, products that infringe plaintiff's Patent No. \_\_\_\_\_ ("\_\_\_\_\_").
  - (c) Plaintiff demands a monetary remedy of NTD \_\_\_\_\_ arising from defendant's violation of plaintiff's rights vested in Article 85, Paragraph 1, Subparagraph 2 of the Patent Act.
  - (d) Plaintiff demands a monetary remedy of NTD \_\_\_\_\_ arising from defendant's breach of contract, where defendant has violated Article \_\_\_ of the contract ("\_\_\_\_\_") signed by both parties.
- (2) Plaintiff has to submit a report of analyzing patent infringement. Such report has to include a claim chart which must provide the following information to this Court: the claims that were infringed by the accused infringing products and the analysis of literal infringement or infringement under the doctrine of equivalents. Such report has to provide the technical features or elements of both infringed claims and accused infringing products, and it also has to compare these technical features or elements for analysis purposes. Each infringed claim shall have its own claim chart that shall be clear and simple. Arguments or explanations shall follow the claim chart. Plaintiff has to submit color pictures that attach to each claim chart, and those pictures shall show the accused infringing products. In these pictures, each technical element has to be labeled .
- (3) Evidence shall include:
  - (a) A copy of the patent certificate of the patent at dispute.
  - (b) The publication of the specification (that is, the detailed description) of the patent at dispute, and the publication of the revision.

- (c) The accused infringing products: in principle, a real object has to be submitted to this Court. But, there are exceptions. First, when a real object is too big or not movable so as not to be submitted to the Court for review. Plaintiff has to provide to this Court the reasons of not being able to bring the real object to this Court. Plaintiff also has to indicate the place where the real object is located and provide the pictures of the real object. Second, when the accused infringing products are hold by defendant or third parties such that plaintiff cannot acquire them, plaintiff has to provide to the Court the reasons of unavailability and the place where the products are located.
- (d) The sources of the accused infringing products, for example, receipts of the product.

**2. Defendant's Answer- the sections of factual statements and evidence in Defendant's answer should follow the instructions below:**

- (1) Defendant has to state whether the disputed infringing products were made, offered for sales, sold, used, or for purposes above imported, by him.
- (2) Defendant has to state whether the accused infringing products are covered by the claims of the patent at dispute.
- (3) If defendant denies that the accused infringing products are covered by the claims of the patent at dispute, he shall propose an analysis report of showing non-infringement. That is, such report has to provide an analysis that includes the technical features or elements of both infringed claims and accused infringing products, and also a comparison between those technical features/elements from the both sides. Each infringed claim shall have its own claim chart that provides an analysis that is easy to understand. Arguments or explanations shall follow the claim chart. Defendant has to attach color pictures to each claim chart, and those pictures shall show the accused infringing products. In these pictures, each technical element has to be labeled.
- (4) If defendant asserts that there have been reasons for invalidating the patent at dispute, then he shall state the following items:
  - (a) Grounds for invalidating the patent at dispute, evidence and statutes relied on:

Defendant has to specifically state the reasons for invalidating the patent at dispute. For instance, he might assert that claim 1 and claim 3 do not satisfy the inventive-step requirement so as not to meet the requirements vested in Article 22, Paragraph 4 of the Patent Act (as amended on February 6, 2003) applied at the time of the grant of the patent at dispute. If there are more than two claims being challenged, defendant has to state for each claim at dispute, the reasons, evidence and statutes that he is relying on.

If defendant uses prior arts as evidence, he shall first present the written documents of the proposed prior arts, for example patent specification (that is, the detailed description), textbooks, journals, and so on.

Defendant has to specify the cited documents that provide sufficient evidence to

show the reasons for invalidating claim \_\_\_ of the patent at dispute. For instance, he might assert that in prior art 1 (the specification of Utility Model Patent No. \_\_\_\_\_) at page \_\_\_ lines \_\_\_ to \_\_\_, this Court can find, “\_\_\_\_\_.” Such disclosure “\_\_\_\_\_” is the prior technology related to the patent at dispute. As a result, claim 1 in the patent at dispute which has technical features related to \_\_\_\_\_ can be easily achieved by the ordinary skilled in the art. Claim 1, then, does not satisfy the inventive-step requirement.

- (b) In asserting that the patent at dispute does not meet the novelty requirement or inventive-step requirement, defendant shall present an analyzing report that compares the patent at dispute and prior arts. Each claim at dispute shall have its own claim chart to be compared with each piece of evidence or the combination of different pieces of evidence. The claim chart shall be simple, where descriptions or arguments shall be presented below the claim chart.

**3. Plaintiff's Reply to Defendant's Answer That Has Raised an Issue of Invalidity of the Patent at Dispute- Plaintiff has a right to reply to defendant's invalidity arguments:**

In response to defendant's invalidity assertions, plaintiff could submit his opinions regarding that by presenting a report of analyzing and comparing the patent at dispute and prior arts, where each claim at dispute shall have its own claim chart.

**4. Summary of Issues Submitted by Both Parties- the legal issues identified in the summary shall include:**

- (1) The claim construction of the claims of the patent at dispute.
- (2) Whether the accused infringing products fall within the claim scope of the patent at dispute.
- (3) The reasons for invalidating or validating the patent at dispute.
- (4) The calculation of damages.