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Intellectual Property - Taiwan Tests for doctrine of equivalents in patent infringement assessment guidelines

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In February 2016 the Taiwan Intellectual Property Office published new patent infringement assessment guidelines to replace those released in 2004. The guidelines serve as a reference for courts in patent infringement cases. In addition to the tripartite test (the sole test for the doctrine of equivalents prescribed in the 2004 guidelines), the 2016 guidelines introduce two new tests:

- the insubstantial difference test; and
- the interchangeability test.

According to the tripartite test, a feature of an accused product or process is equivalent to a corresponding feature of a claim if the accused feature performs substantially the same function in substantially the same way so as to accomplish substantially the same result as the claimed feature.

Pursuant to the insubstantial difference test, a feature of an accused product or process is equivalent to a corresponding feature of a claim if the difference between the accused feature and the claimed feature is insubstantial.

Under the interchangeability test, the doctrine of equivalents applies if a feature of an accused product or process and a corresponding feature of a claim are interchangeable and a person of ordinary skill can recognise that the features were interchangeable at the time of infringement and perform substantially the same function.

Rather than prescribing specific criteria as to which of the tests to adopt in determining whether the doctrine of equivalents applies to a particular case, the guidelines stipulate that the choice of test should be decided on a case-by-case basis according to the technology and facts involved.

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