This article was published in the *International Law Office IP Newsletter* on November 14, 2016.

Intellectual Property, Taiwan

Comparison of design patent and accused product should be based on design as whole

Contributed by Lee and Li Attorneys at Law

Judging infringement of a design patent involves the interpretation of patent claims, as well as the comparison of interpreted patent claims and accused products. When comparing the scope of a design patent with an accused product, the court should first adopt the viewpoint of persons skilled in interpreting the content of the accused product, and then adopt the viewpoint of common consumers, taking into consideration shape, pattern and colour as disclosed by the drawings of the design patent as a whole.(1) Thus, incorrect interpretation of the scope of the accused product can affect the judgment on the visual design as a whole.

In Judgment 2015-Tai-Shang-1775 recently issued by the Supreme Court, the IP Court's second-instance decision was revoked because the Supreme Court thought that the conclusion of patent infringement had been affected by an incorrect interpretation of the accused product. The Supreme Court thought that interpretation of the scope of the accused product (in this case, a motorbike) had been tainted by the fact that the patentee had removed the luggage basket before comparing the scope of the design patent and the accused product. The Supreme Court also noted that when comparing the design patent and the accused product, the IP Court had not considered the pattern and colour disclosed by the accused product, which affected the judgment on the design as a whole.

When judging the visual effect of a design as a whole, the design of the main part of the design patent should be considered before the secondary parts. However, if shape, pattern or colour is excluded from consideration and the reasons for the exclusion are not provided, or if any novel features of the accused product are excluded from consideration, the judgment based on the comparison may be deemed incorrect.

Endnotes

(1) Relevant provisions can be found in Part 2, Section 3, Chapter 2, Volume 2 of the Patent Infringement Assessment Guidelines.

For further information on this topic please contact Alina Tang at Lee and Li Attorneys at Law by telephone (+886 2 2715 3300) or email (alinatang@leeandli.com). The Lee and Li website can be accessed at www.leeandli.com.