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## **Intellectual Property, Taiwan**

### **Judicial Yuan and IP Court forum consensus on IP issues**

Contributed by Lee and Li Attorneys at Law

On May 4 and 5 2015 the Judicial Yuan and the IP Court held an IP forum. The chief justice of the Supreme Court moderated discussions on civil litigation issues, while the president of the IP Court moderated criminal and administrative litigation issues. The participants comprised judges and public prosecutors of the first and second instance, attorneys, patent agents and patent attorneys, as well as personnel from the Petitions and Appeals Committee of the Ministry of Economic Affairs (the authority in charge of administrative appeal) and representatives from the Taiwan Intellectual Property Office (the authority in charge of trademarks, patents and other IP matters).

The forum discussed 12 proposed issues and reached a consensus on the following:

- Regarding damage claims against civil liabilities due to trademark infringement, if the unit prices of the various seized counterfeit goods are different, the average unit price should be cited as the basis for calculation of claimed damages.
- The defence of prior use in good faith against the registered trademark owner's alleged infringement should be cited as a defence rather than a right. Nonetheless, while the business is assigned the assignee may also raise the prior use defence and continue using the trademark.
- Whether the use of a registered trademark as a company name violates the Trademark Act should be considered in respect of when the company was established.
- Copyright ownership or authorship of copyrightable works for hire should be determined by contract.
- The Trademark Act has jurisdiction over Taiwan, exclusive of trademark infringement conducted in China.
- Public performance of copyrightable music at karaoke bars is not a type of renting.
- Once a patentee loses a patent litigation case and later dies, the statutory appeal period should be renewed when the heir takes over the litigation.

Although the consensus reached at the forum is not a precedent, public prosecutors and judges will consider it when examining specific issues. Therefore, this consensus will have a substantial influence on the investigation and trial of IP cases.

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*For further information on this topic please contact Ruey-Sen Tsai at Lee and Li Attorneys at Law by telephone (+886 2 715 3300) or email (rueysentsai@leeandli.com). The Lee and Li website can be accessed at [www.leeandli.com](http://www.leeandli.com).*