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Oral hearings for patent cancellation actions in Taiwan

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To allow the parties to fully argue the issues before examiners, and help examiners determine the facts, an oral hearing for a patent cancellation action is needed. As such, the Intellectual Property Office (IPO) published the Guidelines for Oral Hearings for Cancellation Actions on 1 March 2018, and will hold their first oral hearing on 27 July 2018.

The attendees of an oral hearing include the parties, the examiners, the agents of the parties, and the invited witnesses or experts. The agents can be patent attorneys, patent agents or attorneys-at-law. Where a party is a company, the said party may send its employees to attend the oral hearing. The attendance of interested parties and the general public should be based on specific requests, and on permission from the IPO.

A cancellation hearing should be heard by a panel of three or more examiners. One of the examiners acts as the presiding examiner, and without the presiding examiner's permission, no photos or videos are allowed during the oral hearing. A party may only ask the opposing party questions if the presiding examiner has given permission to do so.

The presiding examiner will check the attendees' identification. Both parties will be consulted for any objection to the eligibility of attendees, or a request to ban participation of an examiner due to a conflict of interest. The parties may ask the presiding examiner questions relating to the issues or the procedures, but may not request the presiding examiner to comment on his or her opinion on any substantive issue of the case.

In general, such oral hearings are open to the public. However, where the interests of any of the parties may be harmed if the oral hearing is open to the public, such a party may request the hearing to be held in private. The language used in the oral hearing is Mandarin. If any party would like to present arguments in a foreign language, he or she must hire an interpreter at his or her own cost.

THE PROCEDURES

The examiners may, ex officio or upon the request of a cancellation party, hold an oral hearing on the case. The IPO should give the parties notice of 30 days prior to the hearing, and publish this notice on the IPO's website. If the IPO considers that an oral hearing is unnecessary, the IPO should explain to the requester the reason why it is unnecessary in a notification, or in the cancellation decision.

For briefs and/or exhibits submitted to the IPO prior to the notice, the IPO should forward these briefs and/or exhibits to the opposing parties. After the notice, a party should directly send the new briefs and/or exhibits to the opposing party and the IPO within 10 days of the notice.

Where the issues of a cancellation action are complicated, the IPO may notify the parties to attend a pre-hearing meeting to arrange the hearing schedule, clarify the admissibility of the exhibits, and identify the issues. Either cancellation party may apply to call a witness or expert to the hearing. If the IPO considers it necessary, it will invite the witness or expert to the hearing.

During the hearing, the presiding examiner may ask the parties whether they are willing to negotiate a settlement, and, if so, the hearing may be suspended. The presiding examiner may ask the parties to make the final statements once he or she considers that the issues have been fully argued. After the final statements, the presiding examiner may announce the closure of the hearing. Where the issues have not been fully argued within the predetermined time, the presiding examiner may schedule a subsequent oral hearing after receiving consent from the parties.

In the hearing, an IPO employee, or a panel member designated by the presiding examiner, must take the hearing minutes. Important statements will be written down in the record of oral hearing. The minutes should be confirmed and signed by the examiners, parties, interested parties, experts and/or witnesses. If any of the attendees refuse to sign, it shall be put in the record of oral hearing.

THE APPEAL

In the past, there was no oral hearing for a patent cancellation action. If a party was dissatisfied with the cancellation decision, it could file an administrative appeal to the Ministry of Economic Affairs first, before filing an administrative suit against the cancellation decision with the Intellectual Property Court.

According to article 109 of the Administrative Procedure Act, if either cancellation party is dissatisfied with the cancellation decision made by the IPO based on an oral hearing, it may directly file an administrative suit against the cancellation decision with the Intellectual Property Court.

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