

**Study on the Patent Litigation in the USA and Taiwan:
Focusing on the Interaction Among Invalidation and
Amendment Proceedings and Infringement Lawsuit**

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Abstract

Nowadays enormous investments for research and development are necessary to survive in a competitive market. Proper protection for inventions and an enforceable legal mechanism with regard to patent rights thus needs to be considered, since patent law provides the “first-mover advantage” to spur innovation in every technological field. Taiwan’s patent legal framework was modeled after German law, in particular the bifurcation (or double-track, “Trennungsprinzip”) system of administrative (validity) and civil (infringement) proceedings. Accordingly, disputes over validity are administrative matters governed by administrative proceedings, and issues of patent infringement have to be determined in the civil action. Unlike the inter partes invalidation procedure, for those who wish to invalidate a patent granted by Taiwan Intellectual Property Office (TIPO), only the ex parte revocation procedure is available and the TIPO is always the accused party to the proceedings. Since strong need was felt to establish effective adjudication proceedings in IP fields, in 2008 the IP Court was established and the IP Adjudication Act was passed in Taiwan. However, it seems that the goal of establishing an effective and efficient judicial proceeding has not been fully achieved. By comparison, the US Congress passed the Leahy-Smith America Invents Act (AIA) in 2011 which laid the foundation for a new adjudicatory body at the United States Patent and Trademark Office (USPTO). The AIA established the Patent Trial and Appeal

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Board (PTAB) which provides a judicial and inter partes proceeding. Since the issues over validation and reissue of patents can be resolved in an efficient way provided by the PTAB, the patent rights can be effectively enforced in the civil action. The purpose of this article is to analyze the operation of the PTAB in the USA and the IP Court in Taiwan, particularly focusing on the interaction among the proceedings of invalidation and amendment of patent right and infringement lawsuits.

Keywords: patent, patent infringement, invalidation of patent, amendment of patent right, intellectual property court, patent litigation