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The Development and Disputes of Issue Preclusion in Civil Patent Litigation in the U.S. and Taiwan —Dilemma Resulting from Patent Invalidity Two-track System in Taiwan

Chih-Chieh Yang *

Abstract

In civil procedure in U.S., there is a principle of collateral estoppel, also called as issue preclusion. When a patent be declared invalid in a civil litigation opinion by court, principle of collateral estoppel would prevent the patent owner litigate on the patent again. In 1971, the U.S. Supreme Court decides the case *Blonder-Tongue vs. University of Illinois Foundation*, overruling the old principle mutuality of estoppel, held that once a patent owner's patent be declared as invalid, he can't bring infringement suit against other implementers any more. Afterwards, the scope of principle of collateral estoppel extended to the issue of infringement or not infringement of patent, and issue of patent claim interpretation.

* Professor, Institute of Technology Law, National Yunlin University of Science & Technology, Taiwan; Ph.D., in Law, National Taiwan University, Taiwan.

For the purpose of understanding development and scope of principle of collateral estoppel in patent context in U.S., several important cases in U.S. courts will be studied. Furthermore, we will compare the operation of Taiwan IP court with the U.S. There are two situations problematic in Taiwan: 1. For reasons of dual judiciary system in Taiwan, court decision in civil proceeding declare a patent invalid actually not yet invalidate that patent forever. 2. After a patent owner lose his suit against upstream company alleged infringing patent, he can then bring suit against downstream company. In the end, the two-track invalidation system of Japan, Taiwan, German, and U.S. will be compared, to find what the problems and dilemma in Taiwan's patent invalidation system.

Keywords: Patent Civil Litigation, Collateral Estoppel, Issue Preclusion, Patent Invalid, Dual Judiciary System