

**TAIWAN**

## Taiwan litigation guide



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萬國法律事務所  
**Formosa Transnational**  
 Attorneys at Law

Taiwan is a civil law jurisdiction modeled after the legal systems of continental Europe, and particularly Germany. As such, there exist only bench trials and there are no jury trials. Taiwanese courts are divided into three levels: namely the District Courts, which hear cases at first instance; and the High Courts and the Supreme Court, which preside over appeal cases from subordinate courts.

### Litigation proceedings

A civil action commences when a plaintiff files a formal complaint with the Court and then the Court issues and serves a writ of summons on the defendant. The plaintiffs are also required to deposit funds as the court fees.

Other than the court fees mentioned above, foreign plaintiffs lacking recognition under Taiwan law may be required to deposit an amount approximately equal to the court fees at the High courts and the Supreme Court. Other remedies:

*i. Injunctions*

A plaintiff may apply for a provisional injunction prior to receipt of a favourable final judgment, to enjoin a defendant from continuing or commencing certain acts.

*ii. Provisional attachment*

A plaintiff may petition for a provisional attachment of his opponent's assets by presenting *prima facie* evidence illustrating that a risk exists where such assets may be disposed of in an attempt to avoid the consequences of an unfavourable judgment.

*iii. Payment orders*

A court may issue a payment order in accordance with the creditor's petition when the subject of the matter is the payment of a specific sum of money or a certain amount of fungible items or valuable securities.

### Appeals

Appeals to the High Court on judgments of the District Courts are generally available as of right. Any party may appeal within 20 days after the date when the judgment is served.

For appeals in the High Court, parties may be prohibited by law to present new evidence, arguments or raising new issues.

Appeals to the Supreme Court may only be based on a misapplication of law by a subordinate court. With respect to any property claim, the value must be equal to or exceed the amount of NT\$1.5 million (US\$46,000) to be eligible for review by the Supreme Court.

### Enforcement of foreign judgments and orders

Foreign judgments will not be recognised and enforced in Taiwan if:

- (i) the foreign Court rendering the judgment had no jurisdiction over the case according to Taiwan law;

- (ii) the foreign judgment was rendered by default and the summons or Court orders necessary for commencement of the action had not been duly served on the defaulting party in that foreign country or through judicial assistance in Taiwan;
- (iii) the foreign judgment is deemed inconsistent with Taiwan's public policy or good morals; or
- (iv) judgments rendered in Taiwan are not reciprocally recognised by the subject foreign Courts.

According to Taiwan's law governing compulsory execution, the party seeking to enforce a final foreign judgment in Taiwan must file a lawsuit in a competent Taiwanese Court for permission to enforce that judgment. The parties may appeal to the Supreme Court in Taiwan just as in other civil cases.

### Arbitration

Taiwan law provides that any written documents or communications between parties evidencing a *prima facie* arbitration agreement shall be deemed as creating an arbitration agreement. Furthermore, in order to ensure the validity of an arbitration clause, the concept of separability has been adopted by Taiwan law.

In principle, Taiwan's Arbitration Law provides that an award will not be enforced unless a competent court has granted an enforcement order. However, the arbitral award may be enforced without an enforcement order if the parties agree in writing and the arbitral award concerns a payment of a specific sum of money or fungible assets or the delivery of a specific chattel.

Although Taiwan is not a party to the New York Convention on the Recognition and Enforcement of Foreign Arbitral Awards, the provisions of the Convention are incorporated into Taiwan's Arbitration Law and a foreign arbitral award is enforceable if its recognition is granted by the court. The foreign countries whose arbitral awards have been recognised by Taiwan courts include the US, the UK and Hong Kong, as well as awards rendered by the International Commerce Committee.

### ADR: Mediation

Mediation shall be initiated in any dispute where the value at issue does not exceed NT\$100,000 (US\$3,000), and in some matters provided under Taiwan's Civil Procedure Law – such as a dispute regarding property matters, rental issues, traffic accident or malpractice issues, and employment issues.

In addition to the mandatory mediation provisions of Taiwan's Civil Procedure Law, mediation proceedings can also be initiated if there is a mediation agreement between both parties. A mediated settlement has the same force as a final court judgment.

## Recommended firms at a glance

<b>BANKING &amp; FINANCE</b>	<b>CORPORATE/M&amp;A</b>
<b>Tier 1</b>	<b>Tier 1</b>
Baker & McKenzie	Baker & McKenzie
Jones Day	Jones Day
Lee and Li	LCS & Partners
<b>Tier 2</b>	Lee and Li
LCS & Partners	<b>Tier 2</b>
Lexcel Partners	Chen & Lin
Russin & Vecchi	Lexcel Partners
Tsar & Tsai	Tsar & Tsai
<b>Tier 3</b>	<b>Tier 3</b>
Chen & Lin	Formosa Transnational
Formosa Transnational	Formosan Brothers
K&L Gates	K&L Gates
Liang & Associates	Russin & Vecchi
Yangming Partners	Yangming Partners
<b>DISPUTE RESOLUTION</b>	<b>INTELLECTUAL PROPERTY</b>
<b>Tier 1</b>	<b>Tier 1</b>
Formosa Transnational	Formosa Transnational
Formosan Brothers	Lee and Li
LCS & Partners	Saint Island International Patent & Law Offices
Lee and Li	Tai E International Patent & Law Office
Tsar & Tsai	Tsai Lee & Chen
<b>Tier 2</b>	Tsar & Tsai
Baker & McKenzie	<b>Tier 2</b>
Jones Day	Baker & McKenzie
<b>Tier 3</b>	Jones Day
Alliance International Law Office	<b>Tier 3</b>
Winkler Partners	TIPLO Attorneys at law
Yangming Partners	Winkler Partners

## Banking & Finance

### RECOMMENDED FIRMS

#### Tier 1

Baker & McKenzie

Jones Day

Lee and Li

#### Tier 2

LCS & Partners

Lexcel Partners

Russin & Vecchi

Tsar & Tsai

#### Tier 3

Chen & Lin

Formosa Transnational

K&L Gates

Liang & Associates

Yangming Partners

### Baker & McKenzie

Baker & McKenzie featured on a number of headlining deals in capital markets, bank lending and corporate transactions this year.

Bank of Taiwan offered the firm roles in two syndicated loans including a dual tranche facility for President Fair Development, consisting of a NT\$6.7 billion (US\$203.9 million) ten-year term loan and a NT\$475 million (US\$14.5 million) five-year revolver. The firm also featured on another loan facility: the NT\$6.5 billion (US\$197.9 million) five-year revolving credit for Uni-President Enterprises, where bookrunners included Bank of Tokyo-Mitsubishi, First Commercial Bank, Mega International Commercial bank and Mizuho Corporate Bank.

The firm acted for E. Sun Financial Holding on the issuance of US\$200 million European convertible bonds, 99% of which were subscribed by Morgan Stanley Private Equity. Goldman Sachs also engaged the firm to advise its role as underwriter in the US\$48.5 million offering of global depositary receipts by Gintech Energy Corporation.

The firm worked on several M&A deals within the technology industry, such as the counsel for Teco Electric and Machinery in the issuance of NT\$386 million (US\$11.7 million) new shares by VMAX Telecom to Intel Capital. It also provided advice to Prime View International on a court-supervised W260 billion (US\$212 million) acquisition of Korean company, BOE Hydys Technology.

Justin Liang heads up the banking and project finance

## Corporate/M&A

### RECOMMENDED FIRMS

#### Tier 1

Baker & McKenzie

Jones Day

LCS & Partners

Lee and Li

#### Tier 2

Chen & Lin

Lexcel Partners

Tsar & Tsai

#### Tier 3

Formosa Transnational

Formosan Brothers

K&L Gates

Russin & Vecchi

Yangming Partners

team. Wayne Yang also advised a number of banking clients. The firm's M&A practice is led by Michael Wong, and Stacey Lee is head of the securities department. Other leading individuals include Wen-Yen Kang and Alex Chiang, who worked on corporate and capital markets transactions.

### Chen & Lin

Chen & Lin has seen steady growth, particularly in its capital markets and banking practice. This year saw it acting as counsel for issuers in some share offering deals, such as Sunrex Technology's US\$23 million GDR offering and the US\$9 million common shares issuance by Novatek Microelectronics for its merger with Cheertek Incorporation.

The firm also worked on an acquisition financing deal, representing Transpac Capital on a US\$150 million financing for the acquisition and restructuring of Eastern Home Shopping & Leisure. It also provided advice to the borrower on the US\$250 million acquisition of Eastern Home Shopping & Leisure. Also counselling the borrower, the firm acted on the US\$185 million financing for NexPower Technology. Bank lenders include Bank of Taiwan, Chinatrust Commercial Bank and First Commercial Bank.

The firm was also heavily involved in the technology industry, acting for ITE Technology on the US\$220 million merger with Usbest Technology, Smedia Technology and Chip Advanced Technology. It also represented Unimicron

Technology in the \$230 million merger with Phoenix Precision Technology.

Jennifer Wang and Che-Hung Chen are two well respected partners of the firm.

### **Formosan Brothers**

Formosan Brothers has featured on several M&A deals, often acting as counsel for Japanese clients. The firm has acted on share purchases and acquisitions of Taiwanese companies in the chemical and steel industries. Local financial institutions also turned to the firm on the acquisition of a US mutual fund and cross broader transactions with US investment banks.

The firm maintained a close relationship with government bodies. It worked on several research projects relating to M&A activities in financial institutions and companies for the Banking Bureau, Financial Supervisory Commission and the Ministry of Economic Affairs.

Formosan was also visible in the real estate sector, offering advice to construction companies on IPOs and assisting listed companies on stock conversion from the Taiwan Stock Exchange to OTC (over-the-counter) managed stocks.

Peter Chen led the banking, project finance and capital markets practice, with support from Jeffrey Chang and Chung-Chiang Lai. Li-Pu Lee heads up the M&A team.

### **Formosa Transnational**

Formosa Transnational boasts a long-established reputation in dispute resolution, which brings several roles for the firm in restructuring proceedings for Japanese companies in the telecommunications and manufacturing sectors, valued at ¥ 66.5 million (US\$684 million) and NT\$2 billion (US\$60.9 million) respectively.

Local security companies called on the firm on a NT\$4 billion (US\$17.4 million) syndicated loan to eight Taiwanese banks. The firm also worked for foreign banks on business expansion in Taiwan, such as the establishment of local branches for a US bank.

With its solid Japanese client base, the firm assisted a group of Japan-based companies on the formation of joint ventures in Taiwan, across wafer probing services and electronic devices industries. It is also acted for a local company on the NT\$572 million share transfer purchases and termination of its joint venture with a US electric company.

Chun-yih Cheng heads up banking and finance as well as M&A activities. Rick Lee is also active in several corporate transactions.

### **Jones Day**

With a well-established corporate practice, Jones Day also

had a strong year across its capital markets, banking and finance practices.

The firm was found on several sales of non-performing loan (NPL) deals, such as the counsel for Capmark Financial on the disposal of US\$70 million remaining NPL and real estate portfolios. It also assisted a US private equity fund on the participation loan to a local asset management company to finance the purchase of NPL, valued at NT\$1.5 billion (US\$45.8 million).

Jones Day played key roles on several Taiwan IPOs, such as representing CSBC Corporation on its NT\$4.8 billion (US\$146.4 million) IPO, and advising Neo Solar Power on its NT\$155 million (US\$4.7 million) offering. Two offshore winery and plastics companies also consulted the firm on their proposed IPOs.

The firm acted on several headline M&A deals too. It advised Fubon Financial Holding on the acquisition of ING Group's Taiwan Life insurance unit, valued at US\$600 million. Micron Technology retained the firm on its formation of a joint venture with NanYa Technology as well as on its US\$400 million acquisition of Qimonda's 36.5% stake in Inotera Memories.

In the banking sector, Shinsei Bank engaged the firm on the US\$280 million takeover of Jih Sun Financial Holding, which was jointly acquired by its joint venture with Capital Target.

William Bryson is specialised in banking and project finance. Jack Huang heads up the capital markets and corporate team. Other leading lawyers include Chung-Ping Liu and Raymond Wang.

### **K&L Gates**

K&L Gates found its role in several capital markets and venture capital transactions this year. Its deal list saw mandates from two Cayman Islands companies, Array and Horizon Securities, both of whom consulted the firm on their applications to enter shares for trading on the Taiwan Emerging Stock Market.

For capital financing deals, the firm acted for Taigen Biopharmaceuticals on the Series C financing. Together with the previous Series A and B financings, the company has raised over US\$100 million. It also helped Taiwan Lipsome which has received a US\$15.5 million Series A venture capital financing. Intel Capital Corporation called on the firm during its venture capital transaction with Applied Green Light on its investment project in Taiwan's Wimax wireless market.

James Chen, Jacqueline Fu and Jamie Lin are key partners of the firm.

### **LCS & Partners**

LCS & Partners is highly visible in some of this year's most

high profile deals in capital markets, banking and M&A practice.

Notable examples include its role for Pou Sheng International on the company's Hong Kong IPO, which totalled US\$309 million. It also represented Huga Pototech on the NT\$2 billion local primary public offering. Acting for lead manager JS Cresvale Securities, the firm worked on the NT\$45 million credit enhanced equity convertible bond offering by Wonten Technology.

China Trust Commercial Bank also called on the firm for its NT\$1.5 billion (US\$46.7 million) syndicated loan to Gala TV Corporation and other co-borrowers. It also assisted Mega International Bank on an acquisition financing deal, advising on the extension of NT\$12.3 billion (US\$374 million) loans to Carlyle for its acquisition of Tachong Bank.

Another highlight saw the firm working for Qimonda on the US\$400 million sale of 36.5% stake in Inotera Memories to Micron Technology. GlaxoSmithKline also sought the firm's counsel on the €500 million (US\$710 million) acquisition of the UCB's emerging markets business in Taiwan.

Amy Chin and Brian Yu co-head the capital markets practice. The M&A team is led by Rich Lin and Victor Chang. Mark Harty is head of the banking and project finance department. Other leading individuals include Kevin Chang and Pijan Wu, who have been active in banking and corporate transactions.

### **Lee and Li**

As one of the largest local firms, Lee and Li maintains a solid reputation across banking, project finance, securities and M&A activities. It is often found on high-profile and large transactions. HSBC mandated the firm to advise on its role as lead manager on three tranches of bond issuance by Central American Bank for Economic Integration, totalling NT\$7 billion (US\$213.5 million). Lee & Li also assisted Morgan Stanley on the subscription of 99% of the euro-convertible bonds issued by E.Sun Financial Holding Company, valued at US\$200 million.

The firm's banking practice excelled in aviation transactions, such as its role for Investec Bank on the financing of two aircraft sold and leased back to Eva Airways and China Airlines, valued at US\$163.5 million and US\$37 million respectively. The firm also advised the lender DVB Bank on the US\$37 million financing of eight spare engines sold by China Airlines to a Cayman special purpose vehicle.

For acquisition financing, the firm represented Avenger International on a series of syndicated loans (such as the US\$36.6 million onshore financing and US\$10 million for the borrower's offshore holding company) provided

by Chinatrust Commercial Bank and Citibank's Taipei branch.

Headlining M&A activities includes ING's sale of Taiwan subsidiary ING Life Insurance to Fubon Financial. The firm worked for the seller on the US\$600 million deal. In CDIC's sale of distressed bank Asia Trust, the firm advised the purchaser Standard Chartered Bank in the US\$101 million acquisition.

Robin Chang heads up the banking practice and Abe Sung leads the capital markets team. CT Chang and Ken-Ying Tseng are key partners for corporate and M&A practice.

### **Lexcel Partners**

Lexcel Partners has had a strong performance on spin-off and M&A transactions. HSBC consulted the firm on the proposed formation of a subsidiary bank and the demerger of assets, liabilities and business of its branches to the new subsidiary, totalling US\$610 million.

The firm also acted as counsel for Mitsui Sumitomo Insurance (MSI) on the demerger of businesses, assets and debts of its Taipei branch office to its subsidiary Mingtai Insurance, which issued the US\$42 million new shares to its parent company MSI. Lexcel Partners also worked for Merrill Lynch, Pierce and Fenner & Smith on the spin-off of its Taiwan business to establish a newly incorporated subsidiary.

Highlights of merger deals saw the firm acting on China Life's US\$153 million acquisition of assets from Prudential Life Insurance of Taiwan, where Lexcel acted for the purchaser. It also advised GIC Real Estate on the US\$196 million cash merger with TDC through its subsidiary.

Echo Yeh heads up the practice. Other leading lawyers include Mike Lu and David Tsai.

### **Russin & Vecchi**

Led by partner Thomas McGowan, Russin & Vecchi is a favourite for banking clients.

Within the area of banking, Taipei Fubon Bank mandated the firm on the financing of a private equity investment in Eastern Broadcasting. It also retained the firm on the financing for the acquisition of Eastern Home Shopping Leisure. Russin & Vecchi acted as counsel for Mega Bank in the financing of Carlyle's investment in Ta Chong Bank. And the firm provided advice to the borrower, acting for a group of private equity investors on the financing of the purchase of Gala TV Corporation.

The firm had a strong year in M&A too. It worked for AIG on the sale of its credit card and auto finance business in Taiwan. It also assisted 16 non-local structured produce issuers on negotiation with the Taiwan regulator on new

regulations governing the sale of structured projects in Taiwan. Clients also turn to the firm for ISDA netting and collateral opinions.

Recent fund manager clients include Aberdeen, AllianceBernstein, Janus, Morgan Stanley, PIMCO and Robecco.

### **Tsar & Tsai**

Tsar & Tsai has always been strong in banking and project finance, but this year it had an impressive showing on capital markets and corporate transactions.

The firm worked on several private placement deals, as counsel for LG Display on the subscription of NT\$3 billion preferred shares issued by HannStar Display Corporation. It also represented CPT on the private placement of US\$250 million European convertible bonds, which were subscribed by Warburg Pincus.

The firm's capital markets practice has also been busy, acting for LG Display on the subscription of 180 million preferred shares issued, worth NT\$3 billion.

GE Capital engaged the firm to advise on its role as lead manager in the US\$265 million syndicated loan to SRAM in connection with the creation of security interests over the local assets held by the borrower.

The firm has been active within the field of M&A too, often acting for banking clients. It advised on HSBC's US\$144 million acquisition of assets, liabilities and business of The Chinese Bank, a distressed local bank, from CDIC. In the technology industry, Tsar & Tsai represented Inotera Memories on the US\$190 million investment by Micron Technology and an ODM (Original Design and Manufacturing) company on the sale of notebook and server business to a US electronic manufacturing service provider. It also assisted a number of foreign companies in the inbound investment in information technology, consumer products and insurance sectors.

Partners Richard Chuang, Jackie Lin and Janice Lin handle all the financial and corporate practice areas such as banking, capital markets and M&A.

### **Other active firms**

#### **Eiger Law**

Eiger Law has been active in merger control analysis and filings. It maintains a good relationship with Taiwan's antitrust authorities at the Fair Trade Commission and is experienced on cross-straits transactions.

This year, it advised Centerbridge on merger control issues in connection with the acquisition of Dana Corp. It also worked on the investment in and joint venture issues of a UK software company with a Chinese healthcare group. Nathan Kaiser and John Eastwood co-head the corporate team.

## **Dispute Resolution**

### **RECOMMENDED FIRMS**

#### **Tier 1**

Formosa Transnational

Formosan Brothers

LCS & Partners

Lee & Li

Tsar & Tsai

#### **Tier 2**

Baker & McKenzie

Jones Day

#### **Tier 3**

Alliance International Law Office

Winkler Partners

Yangming Partners

### **Formosa Transnational**

Formosa Transnational has experience in litigation, arbitration and mediation in civil criminal and administrative divisions. Over the past 12 months, the firm has represented state-owned power company Taiwan Power in a case against a Swedish wire manufacturer. Wellington Koo is the firm's leader in this practice area and is able to call on experienced lawyers such as Paiff Huang and Georgia Chang.

### **Formosan Brothers**

Formosan Brothers offers dispute resolution services in a variety of practice areas, making it an attractive firm for local and international clients. The firm has worked some high profile cases recently including one that saw its client awarded NT\$2.9 billion in a contract dispute. The settlement is one of the largest in Taiwanese history. Other cases have seen Formosan Brothers argue for clients in front of the International Court of Arbitration and the Arbitration Association of the Republic of China. Leading lawyers at the firm include James Ku, Chih-Poung Liou and Helena Chan.

### **LCS & Partners**

LCS & Partners is well known for its commercial mediation and arbitration experience, with major multinationals such as General Electric as regular clients. Key lawyer Margaret Huang has been kept busy recently acting as mediator in disputes between parties involved with the BOT railway project. This includes The Forestry Bureau, Council of Agriculture, Executive Yuan and Butterfly Valley Enterprise.

The firm is representing senior managers of Invetec Appliances, who are accused of insider trading by the Banciao Court Prosecutor's Office. It also represented Taipei Fubon Bank in a case involving structured notes.

### **Lee & Li**

Lee and Li acted on a number of high-profile civil and criminal cases over the last 12 months. The firm represented Taiwan Business Bank in a US\$7m action, and recently successfully defended former Taipei mayor Ying-Jeou Ma when he was accused of misappropriating his special allowance mayoral fund. Chi-chang Yu is recommended for banking and financial disputes, Daniel Song for criminal cases, and Alan Lin for corporate and investment matters.

### **Tsar & Tsai**

Tsar & Tsai boasts a strong cross-border litigation group, which has been called upon for cases resulting from the global economic downturn.

Highlights include representing American International Underwriters (AIU) in an arbitration brought by it against a Japanese listed company. AIU was looking for damages against the listed company for destruction caused by a fire at United Integrated Circuits Corp in 1997.

China Petroleum Corporation (CPC) used the firm's services in a civil action against a contractor over a construction dispute. Tsar & Tsai won the case, although the defendant is appealing. The firm's cross-border capability was highlighted in a case involving a high profile businessman involved on a child support dispute in a California court. Tsar & Tsai, which has an associate office in the American state, received a favourable settlement for its client.

### **Baker & McKenzie**

Baker & McKenzie offers dispute resolution services on cross-border and local cases. In the last year, it has been retained by the charity Jen-Chi Yuan, which owns a number of land plots in Taipei. The foundation leased the lots to provide homes for the city's poorer inhabitants. Given the rise of the local economy, Jen-Chi Yuan has adjusted the rent rate to allow for the new reality but 60 tenants refused to pay. Bakers is representing the firm on a number of cases relating to this.

The firm represented the chairman of a joint venture accused of embezzlement and knowingly preparing false accounts. Bakers successfully defended its client, but the prosecutor is appealing the verdict. Sanofi-Aventis is using the firm in its case against TTY Biopharm, which Sanofi-Aentis accuses of infringing one of its patents. David Liou is head of dispute resolution at the firm. Remington Huang and H Henry Chang are two other respected names.

### **Jones Day**

Jones Day is well known for its dispute resolution work in Taiwan. The firm fosters close links between its Beijing and Taipei offices, and also has strong links with Jones Day offices around the world. Recent work has seen the Taipei office involved on two insider trading cases. In the first, the firm represented three officials from Inventec Appliances accused of insider trading.

The second case saw the firm represent officials from WK Technology accused of insider trading regarding the purchase of a Taiwan company (of which WK Technology was a shareholder) by a US company. The firm has been kept busy with two cases of shareholders fighting for control of a company. One saw the firm represent Chinese Maritime Transport, a shareholder in Taiwan Navigation Company, from having its shares diluted in the company. In the other, Jones Day represented CT&D in three civil and three criminal lawsuits. Victor Chang and Marianne Chao head the firm's department in this practice area. Jason Chen is a leading lawyer within Jones Day's disputes team.

### **Winkler Partners**

Winkler Partners is an independent law firm comfortable on both local and cross-border dispute resolution. The firm houses a mix of local and US lawyers. One recent case saw the firm represent reinsurance syndicates before the Taipei District Court and High Court in a dispute between Taiwanese primary insurers and UK reinsurers over local practices. Another large deal saw the firm advise a TFT-LCD manufacturer negotiate and secure US\$200 million debt from a Californian distributor. Partner Chen Hiu-ling is the standout name at the firm for this work. She specialises in civil and criminal litigation.

### **Yangming Partners**

Yangming Partners is not just a recognised force in Taiwanese litigation, it is also strong in arbitration and alternative dispute resolution. Recent work has included a variety of mandates from international clients, including a US entertainment company in trade mark, copyright and contract claims. The firm represented a Hollywood studio in litigation against its former Taiwanese distributor, as well as worked on a case before the International Court for Arbitration for a defense supplier to the Taiwan military. Anthony Lo is the firm's leading light in dispute resolution and is supported by Charles Hwang.

## Intellectual property

### RECOMMENDED FIRMS

#### Tier 1

Formosa Transnational

Lee & Li

Saint Island International Patent & Law Offices

Tai E International Patent & Law Office

Tsai Lee & Chen

Tsar & Tsai

#### Tier 2

Baker & McKenzie

Jones Day

#### Tier 3

Tiplo Attorneys at law

Winkler Partners

### Formosa Transnational

Formosa Transnational offers a comprehensive IP practice with expertise in IP management, due diligence, patent prosecution, trade mark application, IP enforcement and dispute resolution. The firm boasts a number of multinational clients including Microsoft, which it represented on a number of patent disputes. Philips Electronics has used the firm too, in antitrust and unfair competition disputes for a patent licensing programme.

Japanese company Sanrio used Formosa Transnational on a trade mark enforcement, litigation and licensing case, while Realtek used the firm for patent litigation. Formosa has a strong Japanese client base, helped by the hiring of Weh-Yueh Chung. Partner Hsialing Fan passed the People's Republic of China bar exam, one of the first from Taiwan to do so, giving the firm broader capabilities in China.

### Lee & Li

Lee & Li has a wide-ranging IP practice that offers prosecution, enforcement, dispute resolution, strategy consulting and other areas. The firm has professionals covering industries like chemistry, bio-tech, mechanical, electronics, telecommunications and semiconductors. This last year it was kept busy on a patent infringement case. The plaintiff was seeking NT\$1 billion damages in a case that was one of the first under the new IP Adjudication Act. Lee & Li won a dismissal of the complaint from the civil court for its client.

French fashion company Chanel is using the firm to defend itself against a company that is trying to trade

mark the Chinese equivalent of Chanel's No 5 brand name for wine products. The Ministry of Economic Affairs accepted Lee & Li's argument, revoking the granting of a patent to the company by the Taiwan Intellectual Property Office. The firm boasts a number of leading professionals including Daisy Wang, TC Chiang, Dennis Huang, Joseph Yang and Cathy CW Ting.

### Saint Island International Patent & Law Offices

Saint Island International Patent & Law Offices has a leading IP practice that includes trade mark and patent prosecution, litigation, and other matters relating to intellectual property. It has four branch offices in four major cities of Taiwan and an international department that primarily deals with foreign cases. This includes filing patent and trade mark applications in Taiwan for its foreign associates and clients, and consolidating patent and trade mark applications from branch offices for filing in foreign countries. Patrick IC Yun founded the firm in 1974 and is still a respected practitioner today.

### Tai E International Patent & Law Office

Tai E International Patent & Law Office was established in 1952 and has developed a strong reputation for defending the IP rights of international companies. The firm can count Nikon Corporation, Lair Liquide and Ciba Specialty Chemicals as clients. Recent work has seen the firm represent a US toy manufacturer collect royalty payment under a certain Barbie trade mark license agreement.

The litigation group has been busy defending foreign proprietors in filing or performing customs procedure on trade mark infringement. Fred CT Yen is the biggest name at the firm, having practiced as a patent attorney for over 20 years. He is in charge of patent trade mark matters at the firm.

### Tsai Lee & Chen

Tsai Lee & Chen is one of the top intellectual property law firms in Taiwan with its full-service expertise primarily in the field of semiconductors, TFT-LCD, LED, computer hardware and software, e-commerce, business method, telecommunication, biological materials, chemical and pharmaceuticals, mechanical and electrical engineering.

Its clients include individual inventors, educational institutions, small and medium-sized businesses, non-profit organisations as well as multinational corporations. The firm contains partners who are qualified to practice before the USPTO, or practice laws in the US, while some others studied and taught IP law in China.

### Tsar & Tsai

Tsar & Tsai is an expert in the IP practice areas of trade

marks, copyrights, patents and litigation. Recent high profile work saw the firm represent multinational Johnson & Johnson in a case as plaintiff in front of the Intellectual Property Court. Tsar & Tsai managed to overturn a decision made by the Taiwanese Intellectual Property Court (TIPO) that had registered a mark that bore resemblance to the 'J&J' mark that is synonymous with the Johnson & Johnson brand.

Another interesting case saw the firm represent Gamma Optical, a company that manufactures optical film for LCD, against a temporary injunction brought by a competitor on the basis of trade secret infringement. Tsar & Tsai successfully defended the client in the injunction and is now defending it in the civil court. The firm can boast a number of respected partners on its bench. Jennifer Lin is the standout name, while the department is led by Joyce Ho.

### **Baker & McKenzie**

Baker & McKenzie boasts an enviable list of international clients such as Sanofi-Aventis Singapore, Philips Electronics, Eli Lilly & Company, and Hi-Life International. The firm offers a comprehensive IP practice to its clients, with its team kept busy representing Sanofi-Aventis as a patentee in litigation against a manufacturer of generic drugs. The firm brought the case before the generic drug hit the market, protecting Sanofi-Aventis' revenues from the drug.

Philips has used the firm almost continuously since 2005 in cases relating to the patent for its CD-R technology. The latest case saw Bakers represent Philips against Lead Data in 2009 for breach of a patent license contract. Eli

Lilly and Company has used the firm's expertise since 2005 too; first gaining an injunction order against a generic pharmaceuticals company and then continuing to enforce the injunction. Bakers' IP team is headed by the duo of Stacey Lee and Joy Pan.

### **Jones Day**

Jones Day is another international firm that has an established IP practice in Taiwan. In line with the firm worldwide, the Taipei office boasts a top-notch IP litigation capability that can call on Taiwanese, Chinese and US capability. One standout deal saw the firm represent Nokia in cases in the US and mainland China against Qualcomm. Jones Day reached a settlement on behalf of its client with Qualcomm.

CPDC has retained Jones Day's services in three cases of patent infringement brought by Celanese International Corporation. The final case saw the firm have the High Court overturn the decision of a lower company to award US\$34 million to the plaintiff. Jones Day also represented Taiwanese firm Primax on a US Trade Commission Investigation with Microsoft. Primax successfully settled the case. The firm can call on talents like Victor CM Chang, Jason Chen and Ya-Chiao Chang.

### **Winkler Partners**

Winkler Partners boasts genuine international capability with a mix of US and Taiwanese lawyers. Peter Dernbach heads the firm's department in this practice area and brings a wealth of experience from the US. The firm frequently represents European and US companies that have had their patent or trade mark infringed by a Taiwanese company.

## Other notable areas of law – recommended firms

Further information available online at [www.asialawprofiles.com](http://www.asialawprofiles.com)

LABOUR & EMPLOYMENT	IT, TELCO & MEDIA
<b>Tier 1</b>	<b>Tier 1</b>
Baker & McKenzie	Baker & McKenzie
Lee and Li	Lee and Li
<b>Tier 2</b>	Yangming Partners
Formosan Brothers	<b>Tier 2</b>
Jones Day	Jones Day
LCS & Partners	LCS & Partners
Tsar & Tsai	Lee Tsai & Partners
Yangming Partners	Shay & Partners
	Tsar & Tsai
<b>TAX</b>	<b>Tier 3</b>
<b>Tier 1</b>	Pamir Law Group
Baker & McKenzie	Winkler Partners
Lee and Li	
<b>Tier 2</b>	
Jones Day	
Puhua & Associates	
Tsar & Tsai	