



Newsletter

February 2019

Patent

I. Executive Yuan Passes Draft Amendments to the Patent Act

The Executive Yuan has approved draft amendments to the Patent Act. The draft amendments will be sent to the Legislative Yuan for review. The main points of the draft amendments are as follows:

(1) Broadening the applicability of the divisional application after allowance

According to the current Patent Act, a divisional application can be filed within 30 days from the receipt of the Notice of Allowance in the preliminary examination stage. The draft amendment proposes to broaden the applicability so that a divisional application can be filed within three months from the receipt of the Notice of Allowance in both the preliminary examination stage and re-examination stage. This applies to a utility model patent application as well. Also, the draft amendment adds the regulation that the divisional application shall be based on the invention(s) disclosed in the description or the drawing(s), but not those claims that have been approved in the original patent application. The violation of this regulation may be grounds for decision of rejection and for invalidation. *(Amendments of Articles 34, 46, 71, 107, 119, 120)*

(2) Accelerating the examination proceedings of patent invalidation

Under the current Patent Act, in patent invalidation proceedings, supplementary arguments, evidence, counterstatements, or a request of post-grant amendments of the patent can be filed any time before a final decision is made for the invalidation, which causes postponements of the examination of patent invalidation proceedings. To address the delays in invalidity proceedings, it is now proposed in the draft amendment that supplementary arguments and evidence shall be submitted within three months (one month currently) after the invalidation is filed, and documents submitted beyond the deadline shall not be

examined. Also, the regulation is added regarding the permitted period for the patentee to file a request of post-grant amendments in the invalidation proceedings. (*Amendments of Articles 73, 74 and 77*)

(3) Limiting the permitted periods to request for post-grant amendments for a utility model patent

As a utility model patent is not substantively examined before the grant, to prevent unbounded change of the scope of the claims which may affect the interest of a third party, limitations are added to the permitted period to file a post-grant amendment for a utility model patent. According to the draft amendments, a request of post-grant amendment for a utility model patent can be filed only when substantive disputes occur in the following proceedings: (a) an invalidation against the utility model patent is under examination (b) a request for a technical evaluation report of the utility model patent is proceeded; and (c) a lawsuit of the utility model patent is pending in court. Further, all the post-grant amendments will be examined substantively. (*Amendment to Article 118*)

(4) Extension of the duration term of design patents

The term of protection for design patents will be extended from 12 years to 15 years according to the draft amendments. (*Amendment to Article 135*)

(5) Preservation of patent files

In order to solve the problem of insufficient file storage space, the draft amendment proposes that only the patent files with preservation value shall be kept permanently, and the others shall be preserved for a period of no more than thirty (30) years. (*Amendment to Article 143*)

(6) Other amendments for completing the legal regime and transitional provisions

The amendment is made for the clarification that failing to submit the priority document within 16 months after the priority date may not be the grounds to apply for reinstatement of priority claim. Also, grounds which may cause misunderstanding for invalidation of patent term extension are deleted. Further, transitional provisions are added for the enactment of the draft amendments. (*Amendments to Article 29, 57, 157-2 to 157-4*)

Draft Amendment	
Article 29	<p><u>Claim of priority</u></p> <p>An applicant claiming priority in accordance with the preceding article shall simultaneously make a declaration with respect to the following when filing a patent application:</p> <ol style="list-style-type: none"> 1. the filing date of the first patent application; 2. the country or member of WTO in which the first patent application was

	<p>filed; and</p> <p>3. the application number of the first patent application.</p> <p>Within sixteen (16) months after the earliest priority date, the applicant shall submit a certified copy of the first patent application issued by the foreign patent authority under the preceding paragraph.</p> <p>In case of a violation of Subparagraph 1 or Subparagraph 2 of Paragraph 1 or the preceding paragraph, the priority claim shall be deemed not to have been made.</p> <p>Where an applicant unintentionally fails to claim priority at the time of filing, or where the priority claim is deemed not to have been made <u>in case of violating Subparagraph 1 or Subparagraph 2 of Paragraph 1 as prescribed in the preceding paragraph</u>, the applicant may, within sixteen (16) months after the earliest priority date, apply for reinstatement of priority claim, pay the required fees and undertake actions set forth in Paragraphs 1 and 2.</p>
Article 34	<p><u>Division of application</u></p> <p>A patent application that substantially contains two or more inventions may, upon notice by the Specific Patent Agency or upon request by the applicant, be divided into two or more divisional applications.</p> <p>A request for division shall be filed within any of the following time periods:</p> <ol style="list-style-type: none"> 1. before a reexamination decision on the original patent application is rendered; or 2. within <u>three months</u> thirty (30) days after the date on which an approval decision for the original patent application <u>or an approval decision of the reexamination</u> is served. However, it shall not be filed if a reexamination decision has been rendered. <p>The filing date of the divisional patent application shall be the same as the filing date of the original application. Where the priority claim has been made, the applicant may claim priority for the divisional patent application.</p> <p>The divisional patent application shall not extend beyond the scope of content disclosed in the description, claim(s), or drawing(s) of the original patent application as filed.</p>

	<p>For the divisional patent application filed in accordance with Subparagraph 1 of Paragraph 2, the examination thereof shall resume the completed examination procedure of the original patent application.</p> <p>For the divisional patent application filed in accordance with Subparagraph 2 of Paragraph 2, <u>the request shall be based on the invention(s) disclosed in the description or the drawing(s), but not those claims that have been approved in the original patent application;</u> the examination thereof that has been conducted before the original patent application is approved shall be resumed <u>to the said divisional patent application.;</u></p> <p><u>No alteration may be made to the description, claim(s), or drawing(s) of the original patent application that have been approved. T</u>he original patent application shall be published based on the claim(s) and drawing(s) as originally approved.</p>
Article 46	<p><u>Grounds for decision of rejection</u></p> <p>When a patent application for invention is in violation of the provisions set forth in Articles 21 through 24, Article 26, Article 31, Paragraphs 1 and 3 of Article 32, Article 33, Paragraph 4 <u>and the fore part of Paragraph 6</u> of Article 34, Paragraph 2 of Article 43, Paragraphs 2 and 3 of Article 44, or Paragraph 3 of Article 108, a decision of rejection shall be rendered.</p> <p>Before rendering a decision in accordance with the preceding paragraph, the Specific Patent Agency shall notify the applicant to file a response within a specified time period. If the applicant fails to make a response within the time period, a decision of rejection shall be rendered accordingly.</p>
Article 57	<p><u>Invalidation of patent term extension</u></p> <p>Any person may file an invalidation action of the granted patent term extension to the Specific Patent Agency, together with document(s) of proof, under any of the following circumstances:</p> <ol style="list-style-type: none"> 1. where it is unnecessary to obtain the regulatory approval to exploit the invention patent concerned; 2. where neither the patentee nor licensee has obtained the regulatory approval; 3. where the granted term of extension exceeds the period during which the

	<p>patent cannot be exploited;</p> <p>4. where the requester of the patent term extension is not the patentee;</p> <p>5. where the regulatory approval of extension request is not the first approval, or a request for extension based on the said regulatory approval has been made;</p> <p>6. where the request for extension is based on the time spent on conducting trials or tests in a foreign country, the extended term granted by the Specific Patent Agency exceeds the period approved by the foreign patent authority; or</p> <p>7. <u>6.</u> where the pharmaceuticals involved in the granted patent term extension are veterinary drugs.</p> <p>If an invalidation decision revoking the patent term extension has become final and binding, the granted patent term extension shall be deemed non-existent ab initio. However, if such final and binding invalidation decision of revocation is rendered due to violation of Subparagraph 3 or Subparagraph 6 of the preceding paragraph, only the exceeding period of the extension shall be deemed non-existent.</p>
Article 71	<p><u>Grounds for invalidation</u></p> <p>Any person may request for an invalidation action against an invention patent with the Specific Patent Agency under any of the following circumstances:</p> <p>1. where there is a violation of Articles 21 to 24, Article 26, Article 31, Paragraphs 1 and 3 of Article 32, Paragraph 4 <u>and the fore part of Paragraph 6</u> of Article 34, Paragraph 2 of Article 43, Paragraphs 2 and 3 of Article 44, Paragraphs 2 to 4 of Article 67, or Paragraph 3 of Article 108 of this Act;</p> <p>2. where the home country of the patentee does not accept the patent applications filed by ROC nationals; or</p> <p>3. where there is a violation of Paragraph 1 of Article 12, or where the invention patentee is not the owner of the right to apply for an invention patent.</p> <p>An invalidation action based on Subparagraph 3 of the preceding paragraph shall only be filed by the interested party.</p>

	<p>With respect to the ground(s) upon which an invalidation action is based and filed against an invention patent, the provisions in effect at the time of the said patent being approved shall govern. However, if an invalidation action is filed based on the ground(s) under Paragraph 4 <u>and the fore part of Paragraph 6</u> of Article 34, Paragraph 2 of Article 43, Paragraphs 2 and 4 of Article 67, or Paragraph 3 of Article 108, the provisions in effect at the time of filing the said action shall govern.</p>
<p>Article 73</p>	<p><u>Invalidation action</u></p> <p>Where an invalidation action is filed, a request form containing a statement and reason(s), along with evidence shall be provided.</p> <p>Where a patent contains more than one claim, an invalidation action may be filed against parts of the claims.</p> <p>An invalidation statement shall not be modified or added after filing, but it can be narrowed.</p> <p>A requester of invalidation action may provide invalidation reasons or evidence within <u>three (3) one (1) months</u> after the date of filing the said action; however, the reasons or evidence provided <u>beyond the deadline shall not be examined prior to rendering a decision shall still be examined.</u></p>
<p>Article 74</p>	<p><u>Invalidation proceedings</u></p> <p>Upon receipt of a request form for invalidation action stated in the preceding article, the Specific Patent Agency shall send a copy thereof to the patentee.</p> <p>The patentee shall provide a response within one (1) month after having been served with a copy of the request form. If the patentee fails to provide such response, the invalidation proceedings shall be conducted accordingly, unless a request for extension containing reason(s) thereof has been approved.</p> <p><u>In the period of examination of the invalidation, the patentee shall file a request for post-grant amendments only in the time period specified to file an argument, supplement arguments or file a response. However, this shall not apply to an invention patent with a lawsuit pending in court.</u></p> <p><u>When the Specific Patent Agency, as it deems necessary, notifies the</u></p>

	<p><u>requester of invalidation action to present an argument or the patentee to file supplementary arguments or response, the requester of invalidation action or the patentee shall provide a response within one (1) month after having been served with the official notification. The arguments provided beyond the deadline shall not be examined unless a request for extension containing reason(s) thereof has been approved.</u></p> <p>The Specific Patent Agency may conduct invalidation proceedings accordingly if the reason(s) or evidence provided by the requester of invalidation action is likely to delay the proceedings or if the facts and evidence provided are sufficiently clear.</p> <p>The specific Patent Agency may conduct invalidation proceedings accordingly if <u>the argument/response or supplementary argument/response filed as prescribed in the preceding paragraph</u> is likely to delay the proceedings or if the facts and evidence provided are sufficiently clear.</p>
Article 77	<p><u>Consolidated proceedings of invalidation and post-grant amendment</u></p> <p>If, during the invalidation proceedings, a request for post-grant amendment is filed, the said proceedings and post-grant amendment shall be consolidated; the decisions concerned shall be rendered jointly as well.</p> <p>If the Specific Patent Agency considers the said post-grant amendment <u>as stated in the preceding paragraph</u> approvable, it shall send a copy of the amended description, claim(s) and/or drawing(s) to the requester of invalidation action. <u>However, this shall not apply to the post-grant amendment of deletion of the claims.</u></p> <p>Where there are two or more requests for post-grant amendment filed during the proceedings of same invalidation action, the earlier-filed request(s) for post-grant amendment shall be deemed to have been withdrawn.</p>
Article 107	<p><u>Division of application</u></p> <p>A patent application for utility model which substantially contains two or more utility models may, upon notice by the Specific Patent Agency or upon request by the applicant, be divided into two or more divisional applications.</p> <p>A request for division shall be made <u>within any of the following time periods:</u></p> <ol style="list-style-type: none"> 1. before a decision on the original utility model application is rendered.

	<p>2. <u>within three months after the date on which an approval decision for the original patent application is served.</u></p>
<p>Article 118</p>	<p><u>Post-grant amendment of utility model patent</u></p> <p>With respect to examining a request for post-grant amendment, eExcept for the situation set forth in Paragraph 31 of Article 747, applicable mutatis mutandis under Article 120, the <u>patentee of a utility model patent</u> Specific Patent Agency shall conduct formality examination of <u>only make</u> the post-grant amendment, render a written decision and serve it on the patentee in any of the following time periods:</p> <ol style="list-style-type: none"> 1. <u>a request of technical evaluation report of the utility model patent is proceeding</u> 2. <u>a lawsuit of the utility model patent is pending in court.</u> <p>A decision rejecting the post-grant amendment shall be rendered after formality examination under any of the following circumstances:</p> <ol style="list-style-type: none"> 1. where there is an event prescribed in Subparagraphs 1 to 5 of Article 112; or where the post-grant amendment obviously extends beyond the scope of content disclosed in the claim(s) or drawing(s) as published.
<p>Article 119</p>	<p><u>Grounds for invalidation action</u></p> <p>Any person may request for an invalidation action against a utility model patent with the Specific Patent Agency under any of the following circumstances:</p> <ol style="list-style-type: none"> 1. where there is a violation of Article 104, Article 105, Paragraph 3 of Article 108, Paragraph 2 of Article 110, Article 22 applicable mutatis mutandis under Article 120, Article 23 applicable mutatis mutandis under Article 120, Article 26 applicable mutatis mutandis under Article 120, Article 31 applicable mutatis mutandis under Article 120, Paragraph 4 <u>and the fore part of Paragraph 6</u> of Article 34 applicable mutatis mutandis under Article 120, Paragraph 2 of Article 43 applicable mutatis mutandis under Article 120, Paragraph 3 of Article 44 applicable mutatis mutandis under Article 120, Paragraphs 2 to 4 of Article 67 applicable mutatis mutandis under Article 120 of this Act; 2. where the home country of the patentee does not accept patent applications filed by ROC nationals; or 3. where there is a violation of Paragraph 1 of Article 12, or where the

	<p>utility model patentee is not the owner of the right to apply for a utility model patent.</p> <p>An invalidation action based on Subparagraph 3 of the preceding paragraph shall only be filed by the interested party.</p> <p>With respect to the ground(s) for an invalidation action against a utility model patent, the provisions in effect at the time of the said patent being approved shall govern. However, if an invalidation request is filed based on violation of the ground(s) under Paragraph 3 of Article 108, Paragraph 4 and the fore part of Paragraph 6 of Article 34 applicable mutatis mutandis under Article 120, Paragraph 2 of Article 43 applicable mutatis mutandis under Article 120, or Paragraph 2 and paragraph 4 of Article 67 applicable mutatis mutandis under Article 120, the provisions in effect at the time of filing the said request shall govern.</p> <p>A written decision on an invalidation action shall bear the names of the patent examiners.</p>
Article 120	<p><u>Provisions applied mutatis mutandis to utility model patent</u></p> <p>Article 22, Article 23, Article 26, Articles 28 to 31, Article 33, Paragraphs 3 and to 4-7 of Article 34, Article 35, Paragraphs 2 and 3 of Article 43, Paragraph 3 of Article 44, Paragraph 2 of Article 46, Paragraph 2 of Article 47, Article 51, Paragraphs 1, 2 and 4 of Article 52, Paragraphs 1, 2, 4 and 5 of Article 58, Article 59, Articles 62 to 65, Article 67, Paragraphs 2 and 3 of Article 68, Article 69, Article 70, Articles 72 to 82, Articles 84 to 98, and Articles 100 to 103 shall apply mutatis mutandis to utility model patent.</p>
Article 135	<p><u>Patent term</u></p> <p>The term of a design patent shall expire after a period of fifteen twelve (15+2) years from the filing date of the application. A derivative design patent shall expire simultaneously with the original design patent.</p>
Article 143	<p><u>Preservation of patent files</u></p> <p>Patent files such as application documents, description, claim(s), abstract, drawing(s) evaluated by the Specific Patent Agency to be with preservation value shall be kept permanently in the custody of the Specific Patent Agency. Other documents shall be kept for a period of no more than thirty (30) years.</p> <p>Patent files not included in the preceding paragraph shall be kept for the</p>

	<p><u>following regulated preservation periods:</u></p> <ol style="list-style-type: none"> 1. <u>Invention patents shall be kept for thirty (30) years; other invention patent applications that are not allowed to be granted shall be kept for twenty (20) years.</u> 2. <u>Utility model patents shall be kept for fifteen (15) years; other utility model patent applications that are not allowed to be granted shall be kept for ten (10) years.</u> 3. <u>Design patents shall be kept for twenty (20) years; other design patent applications that are not allowed to be granted shall be kept for fifteen (15) years.</u> <p><u>The preservation periods as set forth in the preceding paragraph shall be calculated from the first day of the next year of the year in which the decision, withdrawal or being deemed to have been withdrawn occurs.</u></p> <p><u>With respect to the patent files that exist prior to the implementation of the mm/dd/yy, amendment of this Act, the preservation periods thereof shall be governed by the amended Act.</u></p> <p>The patent files referred to in the preceding paragraph may be stored on microfilm, magnetic disc, magnetic tape, optical disc or other storage media. The files thus stored, whose record of storage has been confirmed by the Specific Patent Agency, shall be deemed to be the original files, and the original hard copy of such patent files may be destroyed. A reproduced copy of the stored patent file shall be deemed to be a true copy upon confirmation by the Specific Patent Agency.</p> <p>Regulations governing confirmation, administration, and use of the substitutes for stored files referred to in the preceding paragraph shall be prescribed by the competent authority.</p>
<p>Article 157-2 (Newly added)</p>	<p><u>Transitional provisions:</u></p> <p><u>Unless otherwise provided for in the Act, for a patent application which is still pending at the time of the implementation of the mm/dd/yy, amendment of this Act, the amended Patent Act shall govern.</u></p> <p><u>With respect to a request for post-grant amendment and invalidation action which is still pending at the time of the implementation of the mm/dd/yy, amendment of this Act, the amended Patent Act shall govern.</u></p>

<p>Article 157-3 (Newly added)</p>	<p><u>Transitional provisions:</u> <u>With respect to an examination decision regarding patent application rendered prior to the implementation of the mm/dd/yy, amendment to this Act, if the time periods stated in Subparagraph 2, Paragraph 2 of Article 34 and Subparagraph 2, Paragraph 2 of Article 107 has not expired, the amended Patent Act shall govern.</u></p>
<p>Article 157-4 (Newly added)</p>	<p><u>Transitional provisions:</u> <u>For a design patent application which still maintains at the time of the implementation of the mm/dd/yy, amendment of this Act, the amended Patent Act shall govern.</u></p> <p><u>With respect to a design patent which becomes extinguished based on Paragraph 1 of Article 142 applicable mutatis mutandis under Subparagraph 3, Paragraph 1 of Article 70 and apply for reinstatement of the patent rights request based on Subparagraph 2 of the same paragraph before the time of the implementation of the mm/dd/yy, amendment of this Act, the amended Patent Act shall govern.</u></p>

Source: <https://www.tipo.gov.tw/ct.asp?xItem=692068&ctNode=7452&mp=1>

II. Taiwan and Japan sign an MOU on patent dossier information exchange

The Taiwan-Japan Relations Association and Japan-Taiwan Exchange Association have signed an MOU on Patent dossier information exchange on November 30, 2018. Through the cooperation between the Taiwan Intellectual Property Office (TIPO) and the Japan Patent Office (JPO), a one-stop sharing platform will provide applicants and patent examiners in Taiwan and Japan thorough information such as patent examination documents in real-time and with high quality. The patent examiners in Taiwan and Japan can easily take the information from examination history in each other's database as reference, which will improve the quality of the examination and speed up the examination. As a result, the patent rights of the applicants in both countries will become more consistent. TIPO also hopes that through this platform, the visibility of the examination information in Taiwan will be enhanced , and patent offices in the world can also refer to the examination results in Taiwan. After establishing the system and performing the related tests, the platform plans to officially provide its services in January 2021.

Due to the close business relationship between Taiwan and Japan, Japan is the foreign country who has filed the most patent applications in Taiwan. In 2017, Japan outnumbered the others with 13850

applications. In terms of invention patent applications, Japan led with 12497 cases. Taiwanese applicants filed almost 3000 patent applications yearly in Japan. Once the patent dossier exchange between Taiwan and Japan becomes effective, patent applicants and patent examiners will be able to use application number or publication number of an application to view its patent family, list of examination documents, and the content of the documents. In addition, in the Japanese documents, besides the original patent text in Japanese, English version translated by machine will be provided as well. Users can also acquire the International Patent Classification (IPC) and citations of an application.

Source: https://www.tipo.gov.tw/public/epaper/113/ePaper113_ep13573.htm