

Wisdom News

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Wisdom News brings you the latest patent and trademark trends around East Asia
(Taiwan, China, Japan, Hong Kong etc.).

Taiwan

Amendments to the Taiwan Patent Act will be effective on 1 November 2019

The Taiwan Presidential Office promulgated the “Draft Amendments to the Taiwan Patent Act” on May 1st 2019. The new Taiwan Patent Act is scheduled to be implemented on 1 November 2019 and the 4 key amendments in the Draft are as follows:

1. Extending the scope and the period for filing divisional patent applications after receiving an approval decision (New Patent Act Art. 34 and 107)

Currently, division is only applicable to invention patent applications and must be requested within 30 days after the written decision of allowance is served. After the Draft Amendments are in effect, the original time frame of 30 days is extended to 3 months and divisional application now also applies to patents in the re-examination stage. The new provisions regarding divisional application are also applicable to utility model patent applications.

2. Limiting the time period for a party to submit new reasons and apply for post-grant amendments in an invalidation proceeding (New Patent Act Art. 73 and 74)

A. The current Patent Act requires an invalidation requester to provide reasons or evidences within 1 month after filing an invalidation action. Even if the reasons or evidences are provided after the deadline, the IPO will still consider the submitted information before the decision is rendered (current Patent Act Article 73). In order to avoid prolonging the invalidation process, the new Patent Act requires the invalidation requester to present reasons or evidences within 3 months after filing for the invalidation. Late-filed documents will not be taken into consideration.

B. The current Patent Act does not restrict the time frame which a patentee may make post-grant amendments in the invalidation proceeding. The new patent act sets out the time for requesting post-grant amendments:

- i. When the IPO notifies the patentee to provide a response;
- ii. When the IPO notifies the patentee to provide a supplementary response; or

- iii. The responding time period for reply to the rejection of post-grant amendments.

If a litigation case involving the patent is pending, there is no restriction of time limit to apply for post-grant amendments.

3. Imposing the time period for making a post-grant amendment to a utility model patent and the requirement of substantive examination after a post-grant amendment is filed (New Patent Act Art. 118)

The current Patent Act stipulates a post-grant amendment of a utility model patent is only subject to formality examination. The approval of post-grant amendment is therefore subject to stricter conditions. In the new Act, substantive examination will be conducted after filing for a post-grant amendment application of a utility model patent, which is more favourable to the patentee.

Only under circumstances as listed below can a post-grant amendment be requested:

- A. When the IPO is preparing a technical evaluation report for a utility model patent;
- B. A litigation case involving the utility model patent is pending; or
- C. The utility model patent is in the invalidation proceeding.

4. The protection period of design patent is extended: the term of design patents has been increased from 12 years to 15 years.

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