

New Taiwan Patent Act Took Effect on 1 January 2013

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The Legislative Yuan of the ROC (Taiwan) completed the amendment to the Patent Act on 29 November 2011 and the amended provisions were promulgated by the President on 21 December 2011 and took effect on 1 January 2013. To cope with the implementation of the amended Patent Act, the Enforcement Rules of the Patent Act ("Enforcement Rules") were amended and the amended Enforcement Rules simultaneously took effect on 1 January 2013. The major amendments are summarized as follows:

A. Chapter Restructure of the Enforcement Rules

The structure of the Enforcement Rules has been re-arranged to include six chapters: General Provisions, Application for and Review of Invention Patent, Application for and Review of Utility Model Patent, Application for and Review of Design Patent, Patent Right, and Supplementary Provisions. Relevant provisions are provided under these six chapters, respectively. It is stipulated that the provisions under the chapter of Invention Patent apply *mutatis mutandis* to similar matters for utility model patents and design patents.

B. Matters that Require Special Appointment to be Handled by Agents

An agent has the authority to conduct all actions as long as the actions are within the appointment scope. However, without special appointment for an agent to do so, he/she shall not (i) appoint an agent or discontinue such an appointment, (ii) withdraw a patent application, (iii) withdraw a divisional application, (iv) withdraw a conversional application, (v) withdraw an application for reexamination, (vi) withdraw an application for correction, (vii) withdraw a petition for patent invalidation, or (viii) abandon patent right (Article 10 of the amended Enforcement Rules).

C. Changes Regarding Patentability Requirements

To cope with changes of the patentability requirements under the amended Patent Act, provisions regarding the date, based on which patentability requirements are determined, as well as definitions of "publication," "persons having ordinary skills in the art" etc. are stipulated as follows:

1. Absolute novelty requirement is adopted in Taiwan. Prior to amendment of the Patent Act, if any of the specific events prescribed in the Patent Act (including public disclosure made for research or experimental purposes, public disclosure made at a trade show sponsored or recognized by the Taiwanese government, and public disclosure made against the will of a patent applicant) occurs before patent filing, the novelty would not be affected by the said event, provided that a Taiwanese patent application is filed within 6 months from the date of the said event. According to the amended Patent Act, "publication made based on the will of an applicant" would become another exception for enjoying the 6-month grace period for novelty determination. Under the amended Patent Act, all the above-mentioned events with a 6-month grace period shall apply to not only the "novelty" requirement, but also the "inventive step" requirement (for

inventions and utility models) and creativeness requirements (for designs). (Articles 22 and 122 of the amended Patent Act.)

According to the amended Enforcement Rules, the term "before patent filing" mentioned in Articles 22 and 122 of the amended Patent Act refers to "before the priority date" if an international priority claim or a domestic priority claim is made; the term "publication" refers to documents or other storage media stored with information, that is accessible by the public (Articles 13 and 46 of the amended Enforcement Rules).

2. According to the amended Enforcement Rules, the term "persons with ordinary skills in the art" (as used when discussing "disclosure of specification," "inventive step/creativity," and "deposit of biological material") refers to those with ordinary knowledge and common skills in the field of the concerned technology at the time "when the concerned patent application is filed." The term "when the patent application is filed" refers to "the priority date" if international or domestic priority is claimed (Articles 14 and 47 of the amended Enforcement Rules).
3. According to the amended Enforcement Rules, for a person who obtains the right to apply for patent due to inheritance, assignment, employment, or engagement, Paragraph 3, Article 22 of the amended Patent Act shall apply if the concerned publication is made by his/her ancestor, assignor, employer, and fund-provider before patent filing. Under the above situation, the applicant may claim for a 6-month grace period for determination of novelty and inventive step/creativity requirements (Articles 15 and 48 of the amended Enforcement Rules).

D. Formality of Written Patent-related Applications

According to the amended Enforcement Rules, the formality of written applications (transmittal letters) used for filing invention and design patent applications, filing divisional patent applications, applying for amendment, applying for rectification, applying for correction, filing an invalidation action etc. has been revised or newly created. The amended Enforcement Rules also specify matters that should be specified in each kind of written application as well as the supporting documents (Articles 16 to 23, 28, 36, 37, 70, and 72 of the amended Enforcement Rules). The major contents are provided below:

1. Where an applicant claims for a 6-month grace period based on any of the prescribed events for determination of novelty and inventive step/creativity requirements (including public disclosure made for experimental purposes, public disclosure made at a trade show sponsored or recognized by the Taiwanese government, public disclosure made against the will of a patent applicant, or a publication made based on the will of a patent applicant), he/she must clearly state such claim when filing his/her patent application. If there are several facts/events which can all be claimed by the applicant in support of the 6-month grace period claim, he/she must clearly state each of the facts/events when filing the patent application. However, if the facts/events are closely connected with each other, the applicant may only state the first fact/event when claiming the 6-month grace period. For a 6-month grace period claim made based on two or more facts/events, the 6-month grace period shall be calculated based on the date of the first fact/event (Paragraph 3, Article 16 of the amended Enforcement Rules). Similar provisions are stipulated in the amended Enforcement Rules for design patent applications (Paragraph 4, Article 49 of the amended Enforcement Rules).

2. The symbols in patent drawings, which are corresponding to the technical features of a claim, can be cited when expressing such technical features. Such symbols should be added in brackets right after the corresponding technical features. When interpreting claims, such symbols should not be used to limit the scope of claims (Paragraph 2, Article 19 of the amended Enforcement Rules).
3. To enhance the quality and efficiency of patent examination , the following items should be disclosed in a written application for amendment or correction: (i) the pages, paragraphs, and lines of the amended/corrected parts together with the reasons for amendment/correction, (ii) for amendment of claims, the claims to be amended/corrected together with the reasons for amendment, and (iii) for amendment of drawings, the number of the drawing to be amended/corrected together with the reasons for amendment (Paragraph 2, Article 36 and Paragraph 2, Article 70 of the amended Enforcement Rules).
4. When applying for rectifying a specifications, claims, and/or drawings due to translation error(s), a written application thereof should specify the following: (i) the pages, paragraphs, and lines of the rectified parts together with the reasons for rectification, as well as the pages, paragraphs, and lines of the corresponding parts in the specification prepared in the foreign language, (ii) for rectification of claims, the claims to be rectified, the reasons for amendment, and the corresponding number of the claim prepared in the foreign language, and (iii) for rectification of drawings, the number of the drawing to be rectified, the reasons for amendment, and the corresponding number of the drawing prepared in the foreign language (Paragraph 2, Article 37 of the amended Enforcement Rules).
5. For an invention patent application, if the applicant simultaneously applies for rectification of translation error(s) and amendment of specification, patent claims and/or drawings, he/she may file two separate applications for each of the rectification and the amendment. Alternatively, he/she may file such application by using a "written application for translation error rectification", specifying the matters to be rectified and amended, respectively. If the applicant simultaneously applies for rectification of translation error(s) and patent correction, the above-mention rules also apply (Article 38 of the amended Enforcement Rules).

E. Particulars Needed in a Specification

To comply with the formality changes about disclosure requirements as stated in the amended Patent Act, the amended Implementing Regulations state that the required particulars in a specification shall include: (i) the title of invention, (ii) the field of technology, (iii) prior technologies (including all prior technologies known by the applicant; the applicant may submit relevant information regarding such prior technologies), (iv) the contents of invention (including the problems to be solved, the technical means suitable for solving such problems and the effects of the concerned invention or utility model as compared with prior technologies), (v) a brief description of drawings (where there are drawings, a brief description of drawings shall be made in the sequential order of the figures of drawings, (vi) the method(s) of implementation (one or more methods of implementing the concerned invention or utility model shall be disclosed, which can be alternatively described by working examples, if necessary; where there are drawings, the description shall make reference to the figures of drawings), and (vii) a description of symbols (a list including the major symbols appearing in

the drawings with the description of such symbols). A specification shall be drafted in the above sequential order and shall include section titles. However, the above shall not apply where an invention can be described more clearly in any other way of expression. (Paragraph 1, Article 17 of the amended Enforcement Rules)

F. Content Missing from a Specification and Drawings

According to the amended Enforcement Rules, if any content is missing from a specification or drawings, the principles of determining the filing date are as follows, depending upon the different characteristics among an invention patent, a utility model patent, and a design patent (Articles 24, 40 and 55 of the amended Enforcement Rules):

1. Where, for an invention patent application, there is a partial content missing from the specification or where there is a missing of drawings, if such missing content is supplemented by the applicant, the date on which such missing content is supplemented shall be taken as the official filing date of the patent application. However, under any of the following conditions, the original filing date shall continue to be regarded as the filing date: (i) the missing content supplemented to the specification or drawings is included in the earlier filed patent application, based on which priority claim is made for the Taiwanese patent application; and (ii) the missing content supplemented to the specification or drawings is withdrawn by the applicant within thirty days from the date on which the IPO's decision verifying the official filing date is served (Article 24 of the amended Enforcement Rules).
2. Where, for a utility model patent application, there is a partial content missing from the specification or where there is missing of drawings, if such missing content is supplemented by the applicant, the date on which such missing content is supplemented shall be regarded as the filing date of the patent application. However, under any of the following conditions, the original filing date shall continue to be regarded as the official filing date: (i) the missing content supplemented to the specification or drawings is included in the earlier filed patent application, based on which priority claim is made for the Taiwanese patent application; and (ii) the missing content supplemented to the specification or drawings is withdrawn by the applicant within thirty days from the date on which the IPO's decision verifying the official filing date is served (Article 40 of the amended Enforcement Rules).
3. Where, for a design patent application, there is any partial content missing from the specification or drawings, if such missing content is supplemented by the applicant, the date on which such missing content is supplemented shall be regarded as the filing date of the patent application. However, under any of the following conditions, the original filing date shall continue to be regarded as the filing date: (i) the missing content supplemented to the specification or drawings is included in the earlier filed patent application, based on which priority claim is made for the Taiwanese patent application; and (ii) the missing content that is supplemented to the specification or drawings is withdrawn by the applicant within thirty days from the date on which the IPO's decision verifying the filing date is served (Article 55 of the amended Enforcement Rules).
4. Where an invention application, a utility model application, or a design patent application is filed with a specification and drawings prepared in a foreign language, the foregoing provisions shall also apply.

G. Application for Patent Division of an Invention Application after Allowance at the First Examination Stage

According to the amended Patent Act, a patent applicant may apply for patent division of his/her parent (original) invention patent application within one month of the date, on which an allowance decision is issued at the first examination stage. The amended Enforcement Rules stipulate that the applicant should apply for patent division based on the invention that is disclosed in the specification or drawings originally submitted, but that is not covered in the claim(s) allowed for the parent (original) patent application. When applying for patent division as stated above, the specification, claims, and drawings allowed for the parent (original) patent application shall remain unchanged (Article 29 of the Enforcement Rules).

H. IPO's Power to Rectify Obvious Errors

According to the amended Enforcement Rules, if there is any obvious error in the wording or symbols of a specification, claims, and/or drawings, the IPO may rectify such errors *ex officio* and notify the applicant of the same (Article 35 of the amended Enforcement Rules).

I. Design Patent Application Documents

In consideration of the expanded subject matters allowable for design patent protection, the amended Enforcement Rules set forth new requirements for preparing a design patent application, a specification, and drawings (Articles 49 to 54 of the Enforcement Rules). The major requirements are as follows:

1. When filing a design patent application, the following particulars shall be expressly indicated in a specification: (1) the title of design, (2) the usage of the concerned article, and (3) a description of design. The specification shall be drafted in the above sequential order and shall include section titles. However, disclosure of the "usage of the concerned article" and "description of design" can be omitted if they can be expressed clearly simply by reviewing the title of design or the drawings (Article 50 of the amended Enforcement Rules).
2. The term "usage of the concerned article" refers to a disclosure that is aimed to help explaining the usage and function of the article to which the claimed design is applied. The term "description of design" refers to a disclosure that is aimed to help explaining the shape, pattern, color, or a combination thereof, of the claimed design. Under any of the following events, a description of the event shall be included in the "description of design": (1) where the drawings include a part of the design that is not claimed, (2) where the claimed design refers to Computer Generated Icons (Icons) and Graphical User Interface (GUI) applied to an article, which contains continuous and dynamic changes, the changing sequence shall be described, and (3) where there are figures omitted because they are identical or symmetrical to the other figures or due to other reasons. In case of any of the following events, if necessary, a brief description shall be included in the "description of design": (i) where the appearance of the design may change due to the variation in features of materials, functional adjustment or state of use, (ii) where there are auxiliary figures or reference figures, and (iii) where a design application is filed to cover a "design as a set", the titles of the respective constituent articles should be described (Article 51 of the amended Enforcement Rules).
3. The drawings of a design patent application shall include figures (which could be a perspective view, front view, rear view, left view, right view, top view, bottom view,

plan view, unit view or other auxiliary views) which can sufficiently show the views of the design sought to be patented. If the design is three-dimensional design, the drawings should include, among others, a perspective view. If the design is in nature a continuative plane in form, the drawings shall include a single unit view. Drawings shall be prepared by dark lines, computer printed graphs or photos in accordance with the engineering drawing method; when the figures are reduced to two-thirds (2/3) in size, all details in the figures shall remain discernible. Where color is to be claimed, the drawings shall disclose such color. The part of the design to be claimed and the part not to be claimed in the drawings should be illustrated in a clearly distinctive way. The figures marked by reference views cannot be used to interpret the scope of design patent right (Article 53 of the amended Enforcement Rules).

4. The drawings of a design patent application shall disclose the legend of each figure. The perspective figure or a figure that can best represent the design shall be designated as the representative figure. If the representative figure is not designated or is not properly designated, the IPO may instruct the applicant to supplement it within a prescribed time period; or the IPO may designate it ex officio and then notify the applicant of the same (Article 54 of the amended Enforcement Rules).

J. Application for Patent Licensing Recordation

It is specified in the amended Patent Act that the licensing of a patent can be categorized as an exclusive licensing and a non-exclusive license, and sub-licensing of a patent is allowable under the amended Patent Act. Therefore, the amended Enforcement Rules set forth matters to be specified in the relevant licensing recordation applications as well as the scope of sub-licensing as follows:

1. When applying for recordation of a patent licensing, a patentee or a licensee should prepare a written application together with the following documents: (i) when applying for recordation of a patent licensing, the licensing agreement or other evidentiary documents, (ii) when applying for a change of patent licensing recordation, the evidentiary documents proving the concerned change, and (iii) when applying for removing the recordation of patent licensing, a consent to remove the recordation that is issued by the licensee, court judgment, a certificate of a final judgment, or other evidentiary documents that have the same effect as a final judgment; however, there is no need to submit any documents if the removal of patent licensing recordation is caused by the expiration of the duration of the patent licensing. The following matters should be indicated in the afore-mentioned "license agreement" or "evidentiary documents": (i) title of invention, utility model, or design and its patent certificate number, and (ii) the category, content, territory, and duration of the licensing. If a patentee only licenses a third party to practice a part of his/her patented claims, the number(s) of the licensed claim(s) should also be indicated in the "category" of licensing mentioned in point (ii) above. The duration of the licensing should not exceed the duration of the patent (Article 65 of the Enforcement Rules).
2. When applying for recordation of the sub-licensing of a patent, the original licensee or the sub-licensee should prepare a written application along with the following documents: (i) when applying for recordation of sub-licensing of a patent, the sub-licensing agreement or other evidentiary documents, (ii) when applying for change of a sub-licensing recordation, the evidentiary documents proofing such change, and (iii)

when applying for removing the recordation of sub-licensing, a consent to remove the recordation that is issued by the sub-licensee, court judgment, certificate of the final judgment, or other evidentiary documents that have the same effect as a final judgment. However, there is no need to submit any document if the removal of patent sub-licensing recordation is caused by the expiration of the duration of patent sub-licensing. Provisions related to matters that need to be included in a licensing agreement should apply mutatis mutandis to that for a sub-licensing agreement or evidentiary documents. The scope of a patent sub-licensing should be limited within the original scope of the patent licensing (Article 66 of the Enforcement Rules).

K. Patent Invalidation (Cancellation) Actions

To cope with the changes regarding patent invalidation (cancellation) practice as stated in the amended Patent Act, the amended Enforcement Rules set forth provisions with respect to claim for patent invalidation, procedural requirements regarding consolidated examination of patent correction application(s) and invalidation action(s), consolidated examination of multiple invalidation actions, decisions on invalidation actions, determination of examination plans etc. The major contents are as follows (Articles 72 to 76 of the Enforcement Rules):

1. When filing an invalidation action against an invention patent or a utility model patent, in the "claim for patent invalidation," a petitioner must specify whether the petition is filed against all the claims or a part of the claims of the concerned patent. If an invalidation action is filed against a part of the claims, the claims sought to be revoked should be clearly identified. For an invalidation action filed against a design patent, a petitioner should claim the specific design patent under invalidation petition. In the "invalidation reason," a petitioner should state the legal basis for filing an invalidation action as well as the facts, and the petition should also describe the relationship between the facts and the evidence (Article 72 of the amended Enforcement Rules).
2. Examination and a decision on an invalidation action should be made within the scope of the "claim for invalidation". The main text of a decision issued for an invalidation action should state the conclusion of the decision; the conclusion should be made on a claim-by-claim basis for an invalidation action against an invention patent or a utility model patent (Article 73 of the amended Enforcement Rules).
3. Where a patent correction application and an invalidation action are consolidated for examination, the IPO should first examine the patent correction application; if the correction application is deemed unacceptable, the IPO should notify the patentee of the same and ask the patentee to file a response within a specified time period. If a patentee does not file a response in time, or if a response filed by a patentee does not lead to an allowance of the correction application, the IPO may review the invalidation action based on the original documents on file. In case of a consolidated examination of a patent correction application and an invalidation action, the main text of the invalidation decision issued therefore should indicate conclusions of the patent correction application and the invalidation action, separately. However, if it is concluded that a correction application is not allowed, the IPO shall only indicate this conclusion in the "reasons" of the decision (Article 74 of the Enforcement Rules).
4. When the IPO's examination of multiple invalidation actions is consolidated, the IPO should serve each invalidation petitioner and the patentee with the "reasons and evidence" submitted for each of the invalidation actions. Each petitioner and the

patentee may provide his/her opinion or defense reasons in response to the served reasons and evidence within the time period specified by the IPO (Article 75 of the Enforcement Rules).

5. During the examination period of an invalidation action, as the IPO deems necessary, the IPO may coordinate with the petitioner and patentee to form an "examination plan" (Article 76 of the Enforcement Rules).

L. Decisions on Compulsory License Petitions

To ensure that a licensee of a compulsory licensing grant complies with the so-called "local supply requirement" (i.e., the grant of a compulsory licensing is mainly to supply for the demand of domestic market), it is stipulated in the amended Enforcement Rules that the IPO shall, in its decision, state that the licensee should, in an appropriate manner, disclose the information related to its practice of the patent as follows: (i) the status of the practice of the compulsory licensing, and (ii) the volume of the products manufactured and the product flow (Article 78 of the Enforcement Rules).

M. Matters that Should be Published for an Allowed Patent Correction and a Decision for an Invalidation Action

1. After the IPO approves a patent correction application, it shall publish the following matters in the Patent Gazettes: (i) the patent certificate number, (ii) the original publication date of the patent, (iii) the patent application number, (iv) the title of invention, utility model, or design patent, (v) the name of the patentee, and (vi) the correction allowed (Article 84 of the Enforcement Rules).
2. After the IPO issues a decision on an invalidation action against a patent, it shall publish the following matters in the Patent Gazettes: (i) the number of the invalidation case, (ii) the title of invention, utility model, or design patent, (iii) the name of the patentee, his/her domicile address or business address, (iv) the name of the invalidation petitioner, his/her domicile address or business address, (v) the name of the agent, if any, (vi) the date of filing the invalidation action, (vii) the main text of invalidation decision, and (viii) the reasons of invalidation decision (Article 85 of the Enforcement Rules).

N. Transitional Period of Using Patent Application Forms

For a patent application filed in accordance with the amended Patent Act and the amended Enforcement Rules (i.e., filed on or after 1 January 2013), the applicant should use the patent application forms as well as the forms for preparing a specification, claims, abstract and drawings which are announced for use after the amended Patent Act and Enforcement Rules take effect. According to the amended Enforcement Rules, under any of the following circumstances, except for the written application forms (transmittal letter forms), other patent forms applicable prior to 1 January 2013 can still be used: (i) where an invention patent application or a utility model patent application is filed on or before 31 March 2013, (ii) where a patent application is filed based on a specification and drawings prepared in a foreign language on or prior to 1 January 2013, whereas a Chinese translation thereof is supplemented prior to 30 June 2013, and (iii) where a patent application is filed prior to 1 January 2013 or is filed as stated in Item (i) above, and an amendment application or a correction application is filed on or after 1 January 2013 (Article 88 of the Enforcement Rules).

O. Design Patent Applications for "ICONS and GUI Designs" and "Design as a Set"

According to Paragraph 2, Article 121 and Paragraph 2, Article 129 of the amended Patent Act, for a design patent application covering "Computer Generated Icons (Icons) and Graphical User Interface (GUI) applied to an article" or a "Design as a set", which is filed on or after 1 January 2013 with priority claim based on a corresponding foreign application filed earlier than 1 January 2013, the priority date of such Taiwanese design patent application shall be 1 January 2013 (Article 89 of the amended Enforcement Rules).