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## **Patents**

### **Amended Taiwan Patent Examination Guidelines For Dual Applications Over the Same Creation**

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Changes implemented on June 13, 2013 has amended Article 32 of Taiwan's Patent Act, promulgated on January 1, 2013, which allows a patent applicant to apply for both an invention patent and the new utility model patent over the same creation on the same date. With this amendment, the previous "Election on Patent Rights" system has now become the "Continuation of Patent Rights" system. Revisions for the Patent Examination Guidelines were completed and promulgated by the Taiwan Intellectual Property Office on January 16, 2014, taking effect retroactively from January 1, 2014.

The main provisions of the revised Patent Examination Guidelines are highlighted below.

#### **I. Applicable Differences Between "Election" and "Continuation" Systems**

Whether the "Election on Patent Rights" or "Continuation of Patent Rights" system is applied will be based on the date of the patent application. For dual applications over the same creation as now allowed under the Patent Act, if the patent application date is before June 13, 2013 (i.e. from January 1, 2013 to June 12, 2013), the "election" system provided by Article 32 of the Patent Act prior to the revision will apply. If the application date is on or after June 13, 2013, the dual invention/utility model application system provided by the revised Article 32 will apply.

#### **A. Declarations**

For patent applications under the "Election on Patent Rights" system, before the amended Patent Act took effect, as long as the invention and new utility model patent applications were filed on the same day and by the same person when filed in Taiwan, there is no need to declare in the respective applications that an invention or new utility model application for the same creation is being filed.

For patent applications under the "Continuation of Patent Rights" system, after the amended Patent Act took effect, the invention and utility model patent applications for the same creation should meet the following conditions:

- (i) They are filed on the same day;
- (ii) They are filed by the same person; and
- (iii) They include declarations separately when the applications are filed.

For example, the forms on the respective applications should include declarations such as:

"The applicant hereby declares that a new utility model patent over the same creation has been applied for on the same day on which the subject invention patent application is filed."

and

"The applicant hereby declares that an invention patent over the same creation has been applied for on the same day on which the subject utility model patent application is filed."

#### **B. Interpretation of Article 32, para 3**

Regarding the interpretation of para 3, Article 32 of the Act which states that the application for the invention patent will not be granted if the utility model patent right has become extinguished or has

been revoked finally and bindingly before a decision is rendered on the invention patent application, for dual applications over the same creation:

(a) For applications before the amended Patent Act took effect, the invention patent application will not be granted if the utility model patent right has become extinguished or has been revoked finally and bindingly before a decision is rendered on the invention patent application.

(b) For applications after the amended Patent Act took effect, the invention patent application will not be granted if the utility model patent right has become extinguished or has been revoked finally and bindingly before a decision is rendered on the invention patent application and before the publication of the invention patent.

### C. "Same Applicant" Requirement

Differences also exist over the "same applicant" requirement under the pre-amendment and post-amendment systems.

For patent applications under the "Election on Patent Rights" system, before the amended Patent Act took effect, the applicant of the dual application over the same creation should be the same person at the following time:

- (i) When the applications are filed in Taiwan; and
- (ii) When TIPO notifies the applicant to make a selection within a specified time period.

For patent applications under the "Continuation of Patent Rights" system, after the amended Patent Act took effect, the applicant of the dual application should be the same person at the following time:

- (i) When the applications are filed in Taiwan;
- (ii) When TIPO notifies the applicant to make a selection within a specified time period; and
- (iii) During the period from the receipt of the grant decision and the publication of the invention patent.

In addition, during the period from the filing date to the grant of the invention patent application, in case of patent assignments, the invention and new utility model patent applications will both be assigned. Should the assignment cause the patent applicant of the invention and new utility model patent to become different, since different applicants cannot proceed with "Election on Patent Rights", the invention patent application will be examined under the "first-to-file" principle. That is, the invention and the utility model patent applicants must negotiate and select only one from the invention patent and the utility model patent and submit the negotiation results before the designated deadline. If the other related patent application is withdrawn, abandoned, or corrected, the patent elected by the negotiators should be granted. TIPO will publish the results, announcing that the effect is that the patent right of said other related application will be deemed not to have existed.

If an agreement cannot be reached or an agreement is regarded as not reached because the negotiation report is not submitted within the deadline, all of the relevant patent applications under examination will be rejected. TIPO will publish the results, announcing that the effect is that the patent rights of all related patent applications will be deemed not to have existed (refer to section 5.6.2.2 of the amended Patent Examination Guidelines, entitled "Where the applicants are different and one of the applications has been published").

### D. Legal Effect of Election

The legal effect resulting from electing an invention patent in response to TIPO's notice to make an election within the deadline for dual applications over the same creation are also different pre-amendment and post-amendment.

For patent applications under the "Election on Patent Rights" system, before the amended Patent Act took effect, if the invention patent is elected, the utility model patent right will be regarded as non-existent.

For patent applications under the "Continuation of Patent Rights" system, after the amended Patent Act took effect, if the invention patent is elected, the utility model patent right will be regarded as extinguished from the date of publication of the invention patent.

## **II. Standard for Determining How Patents Relate to "Same Creation"**

Under the "Continuation of Patent Rights" system, the amended guidelines clearly provide the standard for determining how the invention and new utility model patents relate to the "same creation" before TIPO requires that election on patent rights be made before a deadline prior to the grant of the invention patent.

According to the guidelines, the examination principle and judging standard for the "same creation" and the way to determine that the invention and new utility model patents filed on the same day relate to the same creation are provided by sections 5.3, entitled "Examination standard of the first-to-file principle", 5.4, entitled "Judgment standard of the first-to-file principle", and 5.5, entitled "Way to determine that the invention patents filed on the same day are the same". Therefore, the examination opinions will be made on the basis of the invention recited in each claim.

## **III. Divisional Applications**

The amended guidelines stipulate that only one divisional application can quote the dual application over the same creation declaration cited in the original application.

According to the guidelines, if the invention and utility model patent applications respectively include declarations that they relate to the same creation when they are filed and a divisional invention application covering the same creation is subsequently filed, the divisional invention application can quote the dual application declaration cited in the original application. Only one divisional application can quote this declaration since the legislative purpose of the "Continuation of Patent Rights" system is to allow the applicant to file one invention patent and one new utility model patent application covering the same creation in Taiwan on the same day.

## **IV. TIPO Notice to Make Election**

The amended guidelines also indicate that when TIPO issues an office action to notify the applicant to "make election on patent rights before the deadline", if TIPO has other reasons against the patentability of the application, such reasons should be given in said office action.

## **V. TIPO to Issue Opinions on Applicant Response**

Under the "Continuation of Patent Rights" system, the amended guidelines clearly stipulate that after TIPO receives the applicant's response to an office action of "making election on patent rights before the deadline", TIPO will make the following conclusions or opinions on a case-by-case basis:

- If the applicant's response elects the invention application and overcomes other reasons against the patentability of the application, the invention patent will be granted.
- If the applicant's response does not make an election on the patent rights but overcomes other reasons against the patentability of the application, TIPO will issue another office action notice to the applicant regarding "making election on patent rights before the deadline".
- If the applicant's response fails to overcome the "other reasons against the patentability of the application", the invention patent application should be rejected regardless of whether the applicant had made the election of patent rights.

- After TIPO notifies the applicant to "make an election on the patent rights before the deadline", if the applicant's elected invention patent fails to overcome other reasons against the patentability of the application, said invention application should be rejected.