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Intellectual Property - Taiwan

How are new deadlines calculated for office action reply extensions?

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Introduction

The Taiwan Intellectual Property Office (TIPO) designates a timeframe in which a reply to an office action for an invention patent or design patent case must be made. A response or amendments must be filed:

- for Taiwanese applicants, within two months of the day after receipt of the office action; and
- for foreign applicants, within three months of the day after receipt of the office action.

If the applicant cannot file a response or amendments within the designated period it can apply to TIPO for a one-off extension. The extension length varies according to the applicant's nationality:

- two months for Taiwanese nationals; and
- three months for foreign nationals.

However, final deadlines often vary due to differences in calculation methods, and inconsistent deadlines can affect the management of cases by applicants and agents. Naturally, a number of questions have been raised concerning this issue.

Extensions

When an applicant applies to TIPO for an extension, he or she is usually granted a two or three-month extension depending on nationality. In practice, TIPO notifies the applicant of the new deadline by providing an exact date.

In some cases, TIPO calculates the extension commencement date based on the date on which the applicant's request was received (Case 1). In other cases, the commencement date is calculated based on the total time from the date following the applicant's receipt of:

- TIPO's office action;
- the originally designated period; and
- the extension period (Case 2).

For example, for a Taiwanese applicant the new deadline will be four months from the day after receipt of the office action. In contrast, for a foreign national, the new deadline will be six months from the day after receipt of the office action.

In Case 2, the commencement date is fixed and the applicant can plan for and manage the new deadline beforehand. However, in Case 1 the new deadline will differ depending on the date on which the extension application was made. In order to obtain the longest possible extension, an applicant will inevitably apply for an extension as late as possible before the initial deadline.

Deadlines

If a deadline falls on a weekend or public holiday it is automatically extended to the following business day. In such case, the question is whether such a rule also applies in regard to extensions. For example, if a foreign applicant received an office action on June 6, with a stipulated deadline of three months (ie, September 6), and the latter date happened to be a Saturday, the applicant's deadline for filing a response would be extended to Monday September 8. However, in this case, would the extension deadline, if applied for, subsequently fall on December 6 or December 8?

Comment

On August 21 2014 TIPO announced a uniform calculation method for extensions to solve these issues. The deadline following an extension will now be four months for Taiwanese nationals and six months for foreign nationals from the day after receipt of TIPO's office action. In addition, if the new deadline falls on a weekend or public holiday, the deadline will be extended automatically to the following business day.

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