

## **Utility Models**

### **Post-Grant Utility Models Amendment and Examination in Taiwan**

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In Taiwan, an application for a utility model patent only needs to pass a formality examination by the Taiwan Intellectual Property Office (TIPO) to be granted a patent certificate. This mechanism offers the advantages of lower fees and an expedited grant of patent. However, utility model patents, which do not undergo substantive examination, are vulnerable in infringement cases to challenges to its validity, compelling the patentee to assess the patent for defects, and potentially apply for post-grant amendment.

TIPO recently issued Examination Guidelines regarding post-grant amendment of utility model patents, which were formulated essentially from current TIPO practice. The fundamental principle put forward in the guidelines is that:

“The post-grant amendment of a utility model patent should, in principle, be subject to formality examination; only when the procedure of a cancellation action is combined with the procedure of the post-grant amendment shall substantive examination apply.”

Since a utility model patent is granted following formality examination only, TIPO does not need to conduct substantive examination of a post-grant amendment for such utility model patent.

The formality examination conducted in a post-grant amendment of a utility model patent entails examining whether the amendment apparently extends beyond the scope of the claims or drawings disclosed in the patent publication. In addition, Article 120 of the Patent Act, to which Article 67, para 1 of the Act applies *mutatis mutandis*, provides that post-grant amendment is limited to deletion of claims, narrowing the scope of claims, correction of errors or translation errors, and clarification of ambiguous statements. However it should be noted that:

- In the formality examination of post-grant amendment to claims, the amended claims are compared claim-by-claim with the published claims of a granted patent in terms of the actual words in the claims and the meaning which can be unambiguously understood from the words (instead of comparing the amended claims with the published drawings or descriptions in the specification).
- In the formality examination of post-grant amendment to drawings, the amended drawings are compared with the contents or forms which can be unambiguously understood from the published drawings of the granted patent.
- In the formality examination of post-grant amendment to descriptions in a patent specification, the amended description is compared with the actual text or form indicated or shown in the published claims or drawings of the granted patent, not the published descriptions in the specification of that granted patent.

For example, a patentee applies to incorporate independent Claim 4 of the granted patent into independent Claim 1 to come up with a new Claim 1, which thereby results in changes to the substantial contents of Claim 2 and Claim 3, both of which originally depend on Claim 1.

Though such amendment should be allowed in the post-grant amendment of an invention patent, which is subject to substantive examination, in the post-grant amendment procedure for a utility model patent which is subject to formality examination, when TIPO compares the amended Claims 1–3 with the published Claims 1–3 and finds that the amended claims have additional technical features which are not specified in the text of the original Claims 1–3, TIPO will reject the post-grant amendment because

it “apparently extends beyond the originally granted scope in formality”. Because the content of a patent specification does not form the basis for comparison conducted by TIPO in the formality examination of the post-grant amendment for a utility model patent, it is suggested that the claims of a utility model patent be drafted to include as many implementable embodiments as possible to facilitate post-grant amendment in the future.

Since the formality examination of post-grant amendment for a utility model patent conducted by TIPO is based on a rigorous comparison as explained above, if significant amendments to a patent is needed to obtain a reasonable and valid scope of claims (and/or drawings, description), the patentee may need to have TIPO conduct a substantive examination procedure for the amendment.

One approach is to apply for patent amendment in response to an ongoing cancellation action procedure. However under local practice, TIPO does not accept a cancellation action filed by patentees themselves. If there is no cancellation action being filed by a third party opponent, the patentee may have to privately authorize a third party to file a cancellation action in that third party's name. After TIPO accepts the cancellation action request and commences the procedure, the patentee can then apply for post-grant amendment in the proceeding in response to the cancellation action. In the cancellation action, TIPO will implement “substantive examination” of the post-grant amendment according to the same guidelines for the examination of post-grant amendment to an invention patent.

As mentioned above, though a post-grant amendment filed for a utility model patent could be rejected by TIPO under formality examination, a different decision could be rendered under substantive examination. Thus a patentee can apply for the same post-grant amendment in a cancellation action procedure as filed before in a formality examination procedure, and TIPO will conduct substantive examination for the post-grant amendment as well as the cancellation action.