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## **Intellectual Property – Taiwan**

### **Post-grant amendment of utility model patents**

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#### **Introduction**

In Taiwan, an application for a utility model patent need only pass a formality examination by the Taiwan Intellectual Property Office (TIPO) to be granted a patent certificate. This process offers the advantages of lower fees and expedited granting of a patent. However, when the patentee of a utility model patent that has not gone through substantive examination asserts patent infringement against others, the patent will be vulnerable to any strong challenge to its validity, compelling the patentee to assess the patent for defects and potentially to apply for post-grant amendment.

#### **Guidelines**

TIPO recently issued examination guidelines regarding post-grant amendment of utility model patents, which are formulated based on current TIPO practice. The fundamental principle spelled out in the guidelines is:

"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 a substantive examination in the procedure of post-grant amendment for a utility model patent.

The formality examination conducted in a post-grant amendment procedure for a utility model patent entails examining whether the amendment apparently extends beyond the scope of claims or drawings disclosed in the patent publication. Article 120 of the Patent Act (to which Article 67(1) of the Act applies *mutatis mutandis*), provides that post-grant amendment is limited to:

- deletion of claims;
- narrowing the scope of claims;
- translation and correction of errors; and
- clarification of ambiguous statements.

However, the following should be noted:

- In the formality examination of a 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 used and their meaning that can be unambiguously understood (instead of comparing the amended claims with the published drawings or descriptions in the specification).
- In the formality examination of a post-grant amendment to drawings, the amended drawings are compared with the contents or forms that can be unambiguously understood from the published drawings of the granted patent.

- In the formality examination of a 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 his or her granted patent into independent Claim 1 to come up with a new Claim 1, resulting in changes to the substantial contents of Claim 2 and Claim 3, both of which originated from Claim 1. Though such an 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 to 3 with the published Claims 1 to 3 and finds that the amended claims have additional technical features that are not specified in the original claims, TIPO will reject the postgrant 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 postgrant 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 rigorous comparison, if significant amendment to a patent is needed in order to obtain a reasonable and valid scope of claims (and drawings or descriptions), 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 the patentee itself. If there is no cancellation action coincidentally filed by a third party, the patentee may have to privately authorise a third party to file a cancellation action in the third party's name. After TIPO accepts the cancellation action request and starts the procedure, the patentee can apply for a post-grant amendment in the proceeding in response to the cancellation action. In the cancellation action, TIPO will conduct a substantive examination of the post-grant amendment according to the guidelines for the examination of a post-grant amendment to an invention patent.

### **Comment**

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

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