

This article was published in the *International Law Office IP Newsletter* on May 1, 2017.

## **Intellectual Property, Taiwan**

### **TIPO accepts applications for deferring substantive examination of invention patent applications**

Contributed by Lee and Li Attorneys at Law

In addition to accepting applications for accelerated invention patent examination through the accelerated examination programme or the Patent Prosecution Highway, the Taiwan Intellectual Property Office (TIPO) now accepts applications for the deferment of substantive examination of invention patent applications. TIPO's reasons for why it now accepts deferment applications include:

- the consideration of patent applicants' application tactics;
- the facilitation of applicants' global patent layouts; and
- the timeframes for the commercialisation of inventions.

Such deferment applications are considered helpful in alleviating the pressure of patent examination.

According to the new regulations, the deferment of substantive examination of an invention patent application can be requested "at the same time as requesting substantive examination or thereafter but, in any case, should not be later than three years after the application was filed". For applications which claim priority, the first date for the calculation of the statutory time limit remains the date on which the application is filed with TIPO.

Conditions in which an application for deferment of substantive examination will not be granted include whether:

- an office action or decision regarding whether a patent should be granted application has been issued by TIPO;
- a divisional patent application has been filed with TIPO;
- a request for substantive examination has been filed by a third party; and
- a request for accelerated examination through the accelerated examination programme or the Patent Prosecution Highway has been filed with TIPO.

Other relevant stipulations include the fact that filing an application for deferment of substantive examination must not change the date of TIPO's publication of the invention under application. Such an application for deferment can be withdrawn; however, the applicant will not be allowed to apply for deferment again following the withdrawal.

An applicant that applies for deferment of substantive examination must designate a specific date for TIPO to resume substantive examination. The date can be changed by submitting a written application within three years of filing the patent application.

The statutory time limit for requesting substantive examination of an invention patent application is within three years of filing the application. However, according to the new regulations, deferment can be applied for after a request for substantive examination has been filed and a date which falls within the three-year period has been designated. From the perspective of patent management, compared with filing a request for substantive examination on the last day of the three-year statutory limit, the benefit of first filing a request for substantive examination and then applying for deferment just before the statutory time limit expires appears only to prevent third parties (eg, competitors) from initiating the substantive examination procedure.

---

*For further information on this topic please contact May Chen at Lee and Li Attorneys at Law by telephone (+886 2 2715 3300) or email (maychen@leeandli.com). The Lee and Li website can be accessed at [www.leeandli.com](http://www.leeandli.com).*