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Should system of deferred publication for design patent applications be introduced?

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The Taiwan Intellectual Property Office (TIPO) convened a public hearing on April 30 2015 with respect to whether and how to extend the term of design patents and introduce a system of deferred publication for design patent applications.

Term of design patents

According to Article 135 of the Patent Law, the term of a design patent is 12 years from the date of filing. In light of the Hague Agreement, new design practice in the United States and the proposed amendment to China's Patent Law, TIPO plans to extend the term of a design patent to 15 years from the date of filing. TIPO will further study whether the term extension should cover:

- new design patent applications filed after the new law takes effect; or
- all valid pending design patent applications as of the date of the new law.

Deferred publication system

Under existing practice, the content of a design patent will be published once it is issued. According to Article 86 of the Enforcement Rules of the Patent Law, a patent applicant can, on request, postpone the issuance by up to three months. In light of the Hague Agreement, as well as practices in the European Union, Korea and Japan, TIPO proposes to introduce a system of deferred publication for design patent applications. Under the system, a design patent may be issued first and published later. The proposed rules for the system are as follows:

- The timing for requesting a deferred publication commences from the date of filing and ends on the date of payment of the issuance fee and first annuity.
- On the date of patent issuance, basic information only (eg, the patent certificate number and the date of filing) will be disclosed. The remaining information will be disclosed on the deferred publication date.
- The publication date can be deferred by up to 30 months from the filing or priority date. If the deferred publication date is earlier than 30 months from this date, the applicant can, before such deferred publication, request another deferred publication of up to 30 months from the filing or priority date.
- TIPO should disclose the publication-deferred design patent to a designated third party in any of the following circumstances:
 - the design patentee agrees to disclose the publication-deferred design patent to a specific third party; and
 - disclosure upon request by:
 - an applicant whose patent application is under examination or re-examination based on the publication-deferred design patent;
 - a party of a patent cancellation action in relation to the publication-deferred design patent; or

- a party patent litigation in relation to the publication-deferred design patent.
- Once the publication-deferred design patent application is issued, no derivative design patent application can be filed based upon it.
- On the issuance date of the publication-deferred design patent application, the applicant can effect the post-grant amendment to the issued design patent. Once the post-grant amendment is granted, its content should be published. However, if the amendment is related to the substance of the claimed design, TIPO should delay publication until the design patent is published.
- A cancellation action can be filed against the publication-deferred design patent application once it is issued. If the cancellation action is sustained by TIPO during the publication-deferred period, the deferred publication is waived and TIPO should publish all the information and drawings of the design patent in the patent gazette.
- A design patentee that has not waived deferred publication should not issue a cease and desist letter to a potential infringer.

TIPO will further consider whether to revise Point 2(8) to read "a design patentee who has not waived deferred publication shall not issue a warning (cease-and-desist) letter to, or file a design patent litigation against, a potential infringer".

Attendees of the hearing expressed concerns over the likelihood that the deferred publication may inhibit a good-faith effort to design around an issued patent, because the public would not have a chance to know the content of an issued design patent if its publication is deferred. TIPO will deliberate on this and take it into consideration.

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