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## **Intellectual Property, Taiwan** **TIPO introduces new measure to manage design patent** **application priority claims**

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On 12 July 2019 the Taiwan Intellectual Property Office (TIPO) announced a new measure to manage design patent application priority claims:

*In the future, the examiner will not evaluate the validity of the priority claim of a patent application based on priority documents, unless he/she finds - through a search - that there is a pending patent application or prior art whose filing date or date of disclosure falls between the priority date and the filing date of the later-filed application. If no pending patent application or prior art is found, the TIPO, in principle, will publish all the priority claims the applicant asserts in the Patent Gazettes. This measure will come into effect on the publication date of volume 46, issue 22 of the Patent Gazettes (1 August 2019).*

Chapter 3, Pages 3-5-3 and 3-5-4 of the Patent Examination Guidelines stipulate as follows:

*(4) The design disclosed in the drawings of a design patent application is required to comply with the requirement of 'one design for one application.' Accordingly, a design patent application can only claim one priority date for the claimed design. Claim to multiple priorities or a partial priority should not be accepted.*

*(5) If a pending application or prior art - whose filing date or date of disclosure falls between the priority date and the filing date of the later-filed application - is found during the process of searching, it is required to check if the priority claim(s) is valid in view of the priority documents. In addition, reasons are required to be given if the priority claim(s) is deemed invalid. If necessary, the applicant should be notified and required to submit a full or part of Chinese translation of the priority documents. If such Chinese translation of the documents fails to be submitted, the priority claim(s) should not be accepted.*

Previously, during the substantive examination of a design patent application, TIPO would check whether the design disclosed in the claimed priority basic application was the same as that disclosed in the design patent application. If not, TIPO would issue an office action requesting the applicant to respond. Where a design patent application claimed multiple priorities, TIPO would also issue an office action requesting the applicant to select one of the priority claims.

Now, the examination of a design patent application priority claim will align with that of an invention patent application – namely, the priority claim will not be substantively examined first. Thus, applicants can claim multiple priorities.

An examination of whether the priority claim corresponds to the later-filed application will be conducted only if there is a prior-filed application or prior art whose filing date or date of disclosure falls between the earliest priority date and the filing date of the later-filed application (this also applies to cancellation action proceedings). If no such prior-filed application or prior art is found, TIPO will publish all of the priority claims that the applicant asserts in the Patent Gazettes.

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