

Intellectual Property, Taiwan

Revisions of the Patent Substantive Examination Guidelines in 2021

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Introduction

The Taiwan Intellectual Property Office (TIPO) has recently revised the Patent Substantive Examination Guidelines in order to promptly respond to the needs of patent examination practices and improve the quality of patent examination. The revisions became effective on 14 July 2021 and include changes to:

- Chapter 1-6, 10, 11, 13 and 14 of Part II (Substantive Examination for Invention Patents);
- Chapter 1 and Chapter 5 of Part III (Substantive Examination for Design Patents);
- Chapter 3 of Part IV (Formality Examination for Utility Model Patents); and
- Chapter 1 of Part V (Invalidation Proceedings).

This article provides an overview of the revisions.⁽¹⁾

Part II, Chapter 1 – description, claims, abstract and drawings

The newly revised guidelines provide further instructions on the examination of the manner in which a claim is disclosed, as follows (section 2(6)):

- An independent claim must state the designation of the subject matter as claimed, which must not be too general or brief. Where the subject matter is denoted merely by expressions such as "an article", "a device" or "a method", it is categorised as undesignated.
- Where an independent claim of an invention is presented in two-part form, it must contain expressions such as "characterised in that", "wherein the improvement comprises" or other similar expressions, while a dependent claim need not do so.
- Referring to a corresponding reference sign in a drawing – where the technical feature of a claim is followed by the reference sign in parentheses – will not make the claim unclear.

Part II, Chapter 2 – definition of "invention"

The newly revised guidelines explicitly stipulate that although a mathematical method does not satisfy the definition of an invention, an invention which uses a mathematical method to optimise the workload distribution on a computer network should not be considered inconsistent with the definition of an invention merely because it involves a mathematical method (section 1(3)(4)). In addition, the newly revised guidelines expressly specify the statutory exclusion of diagnostic methods for the treatment of humans or animals as prescribed under article 24 of the Patent Act, including all steps from data obtainment to diagnosis (section 2(3)(1)).

Part II, Chapter 5 – restrictions on grace periods and patterns of disclosure

The grace period granted for invention and utility model patent applications was extended from six months prior to the date of filing a patent application to 12 months when the Patent Act and the Enforcement Rules of the Patent Act were amended in 2017. In addition, the restrictions on the patterns of disclosure that may allow for a grace period to be requested were removed. On top of that, a change was made so that a disclosure made against an applicant's will may not be deemed as a circumstance that would preclude the grant of an invention patent or a utility model patent. However, this does not apply to intentional publications relating to a patent application in a gazette in Taiwan or a foreign country.

As the amendment to the foregoing legal articles was adopted when the revisions of Part II, Chapter 3 were made in 2017, Chapter 5 of Part II has now been revised to provide for the extension of the grace period and the relaxation of the patterns of disclosure.

Part II, Chapter 6 – restrictions on circumstances allowed for disclaimer amendments

Given that the examination of disclaimer amendments during examination or post-grant prosecution has always been less stringent in Taiwan's examination practices, the TIPO has expressly restricted in the 2021 revisions the circumstances under which disclaimer amendment during examination or post-grant prosecution is allowed. Such restrictions were made to avoid abusive use of disclaimer amendments during examination or post-grant prosecution by applicants or patentees. Amendments can now be made only where the disclaimer amendment during examination or post-grant prosecution is made to:

- overcome the lack of novelty indicated by references cited;
- overcome the lack of fictitious novelty indicated by references cited;
- overcome non-compliance with the first-to-file principle indicated by references cited. However, references cited with the same filing date do not qualify for such amendments; and
- exclude a subject of statutory exclusion (eg, a disclaimer of the "human part" in claims on the object or a disclaimer of the "step(s) applied to a living human body or animal body" in claims on the means).

Part II, Chapter 6 also requires that the following conditions must be met if an alteration of the maximum and minimum values in claims is to be made:

- The altered maximum and minimum values have already been disclosed in the description, claims or drawings submitted for the patent application.
- The altered value range has been included in the value range disclosed in the description, claims or drawings submitted for the patent application. Two more embodiments are included in this amendment for clarity.

Part II, Chapter 10 – division and conversion

The newly revised guidelines explicitly stipulate that where an applicant which made declarations in respect of its earlier patent application for an invention and utility model for the same creation on the same date and later requested for the division of this patent application for an invention – while claiming that the divisional patent application is a correct continuation of the utility model patent – the divisional patent application is allowed to cite the earlier declaration in respect of the patent application for the invention, and is limited to one divisional patent application. However, the applicant should make a declaration of the citation when filing the divisional patent application. Making a supplementary statement of the citation afterwards is not allowed (section 1(3)).

Part II, Chapter 13 – pharmaceutical-related inventions

The newly revised guidelines explicitly stipulate that what differentiates the subject matter of a selection invention from prior art is that a selection invention claims individual elements, sub-groups or sub-ranges that are not explicitly mentioned in a larger, known group or range of the prior art. Namely, the statement that the selection needs to be purposeful has been removed from the guidelines (section 5(3)(1)(5)).

Part V, Chapter 1 – new section on hearings

Previously, patent invalidation actions in Taiwan were examined based on written documentation or evidence submitted. In order to let the parties fully express their opinions during the examination of patent invalidation cases, and to simplify the procedures for subsequent administrative remedies, the TIPO published the Programme for Hearing Patent Invalidation Cases for implementation on 30 March 2018. It then published amendments to the programme on 5 August 2019 and 8 February 2021. The

addition of a new section 3(3)(2) on hearings in the new guidelines aims to expressly stipulate that the provisions of the programme must be followed when holding hearings.

Part V, Chapter 1 also amends the principles with regard to the intention of the court's judgment in invalidation cases that require re-examination by TIPO where the original dispositions were revoked due to new grounds or fresh evidence that did not appear until the administrative remedial proceedings thereof:

- If the judgment which revoked the original disposition of a patent invalidation case fails to demand the performance of any obligation by the specific patent agency, the patent invalidation case will return to a state where a decision has not yet been rendered. As for new grounds or fresh evidence that were not raised by the invalidation requester during the invalidation proceedings until the administrative remedial proceedings, there is no need to notify the parties to provide their responses because they have sufficiently argued with each other during the administrative litigation proceedings.
- If the intention of the court's judgment on the revocation of the original disposition of an invalidation case is simply to order the specific patent agency to re-examine the invalidation case in accordance with the court's judgment opinions, the specific patent agency will proceed to do so. Matters not covered by the court's judgment opinions do not, in principle, require any further investigation. However, if the intention of the court's judgment indicates that there is still relevant evidence to be clarified or a further investigation is required, the specific patent agency may, as it deems necessary, notify the invalidation requestor to submit comments or the patentee to provide a response or a supplementary response within a specified time period. If late submission of any comment or response occurs, the specific patent agency may proceed to render a decision.

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