

**ESSENCE OF THE NEW TAIWAN PATENT LAW — KEY ISSUES ONLY!
TO COME INTO FORCE ON 1 JANUARY 2013**

1. **Expansion of applicability scope and acceptable grounds for claiming grace period** (*Articles 22 and 122*)
2. **New: Acceptability of foreign-language specifications, claims and drawings** (*Articles 25, 44, 67, 106, 110, 125, 133, 139 and 145*)
3. **Inventor assignment**
4. **Priority claim** (*Article 29, 120 and 142*)
5. **Extended the time period for voluntary amendment and enacted the Final Notice regime** (*Articles 43 & 49*)
6. **Extended the time period for filing divisional applications** (*Article 34*)
7. **Expanded scope of statutory subject matters of design patents** (*Articles 121, 127 and 129*)
8. **Reinstatement of patent right** (*Articles 52 and 70*)
9. **Invalidation Actions** (*Articles 71, 73, 75 and Articles 78 - 82*)
10. **Biological Material** (*Article 27*)
11. **Pre-allowance Third-party opinions** (*Article 39 of the Patent Act Enforcement Rules*)
12. **Patent Annuity under the Amendment to Taiwan Patent Act**

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1. **Expansion of applicability scope and acceptable grounds for claiming grace period** (*Articles 22 and 122*)
 - ❖ Applicability of grace period extends to cover novelty and inventive step requirements for inventions and utility models (as well as creativeness requirement for designs).
 - ❖ Applicant may claim grace period where pre-filing publication has been made on applicant's own initiative, e.g. publication in a business periodical.
 2. **New: Acceptability of foreign-language specifications, claims and drawings** (*Articles 25, 44, 67, 106, 110, 125, 133, 139 and 145*)
 - ❖ Where the patent application is filed with foreign-language patent specification, claim(s) and/or drawings, no amendment of any of said foreign-language documents will be allowed.
 - ❖ Requirements to meet with respect to correction of translation errors.
 - ❖ Acceptable foreign languages and required items to be indicated in the foreign-language documents submitted upon filing shall be in accordance with the relevant regulations prescribed by Taiwan IPO.

3. Inventor assignment

- ❖ Inventor assignment is no longer required of patent applications filed on or after January 1, 2013.
- ❖ For applications filed before January 1, 2013, inventor assignment will be required when and only when the 6-month time limit to submit it duly expires before January 1, 2013.

4. Priority claim (*Article 29, 120 and 142*)

- ❖ Time limit for submitting priority document extended: The deadline for submitting priority document is extended from within 4 months from the filing date to within 16 months for inventions/utility models and 10 months for designs from the earliest priority date.
- ❖ Reinstatement of priority claim: Where applicant unintentionally failed to make a claim for priority at the time of filing, reinstatement of priority claim may be sought for within 16 months (for inventions/utility models) or 10 months (for designs) from the earliest priority date.

5. Extended the time period for voluntary amendment and enacted the Final Notice regime (*Articles 43 & 49*)

- ❖ Voluntary amendments may be submitted anytime before the first Office Action is received.
- ❖ A Final Notice regime is put in place to prevent examination delay due to repeated requests for amendment. After being duly served the Final Notice, applicant may request within the specified period for these and only these amendments: (1) deleting claim(s); (2) narrowing the scope of the claim; (3) correcting the errors; and (4) clarifying unclear disclosure.

6. Extended the time period for filing divisional applications (*Article 34*)

- ❖ Patent division for an invention patent application made after allowance is possible. A divisional application may be filed within thirty (30) days after receiving an allowance decision issued at the primary examination stage.
- ❖ Divisional application asserted based on allowed claims of the original application granted is not acceptable; the original application granted will be published with the allowed claims.

7. Expanded scope of statutory subject matters of design patents (*Articles 121, 127 and 129*)

- ❖ Design patent protection shall be expanded to partial designs; computer-generated icons (Icons) designs and graphical user interface (GUI) designs; articles composed as a whole and derivative designs. (The Associated Design Patent regime is abolished).
- ❖ Design patent applications filed pending allowance decision can be converted to partial-design patent applications within three (3) months on or after the present amendment to the Patent Act comes into force (i.e. 1 January 2013).

- ❖ Associated design applications filed pending allowance decision can be converted to derivative design applications within three (3) months on or after the present amendment to the Patent Act comes into force (i.e. 1 January 2013).
8. **Reinstatement of patent right** (*Articles 52 and 70*)
- ❖ If an applicant/patentee unintentionally fails to pay the sealing fee and/or annuities when due, he is allowed to request for reinstatement of patent right:
 - * Failure to pay the sealing fee and the 1st year annuity:
 - by paying the sealing fee and double the amount of the first year patent annuity within six (6) months from the original due date.
 - * Failure to pay the 2nd or any subsequent patent annuity before the 6-month grace period expires:
 - by paying triple the amount of the annuity overdue within one (1) year after the 6-month grace period expires.
9. **Invalidation Actions** (*Articles 71, 73, 75 and Articles 78 - 82*)
- ❖ *Ex officio* invalidation by Taiwan IPO is abolished.
 - ❖ Where a patent covers two or more claims, an invalidation action can be filed against the claims in part (as opposed to as a whole) of the patent.
 - ❖ Upon filing an invalidation action, the person seeking the invalidation must submit a declaration of invalidation to determine the scope of the invalidation action. After the declaration is filed, no change or addition to the claims included in the said declaration will be allowed.
 - ❖ Invalidation actions filed before the amendment to the Patent Act comes into force shall still be examined as one challenging all of the claims of the patent.
10. **Biological Material** (*Article 27*)
- ❖ The certificate of deposit and the viability test report are combined into one certifying document.
 - ❖ Deadline for submitting the certifying document is extended to within 4 months from the filing date (originally within 3 months from the filing date) or within 16 months from the earliest priority date if priority is claimed.
 - ❖ Requirement of indicating information about the deposit in the application form is removed.
 - ❖ *New: Recognition of deposits made by foreign nationals on reciprocal basis.*
11. **Pre-allowance Third-party opinions** (*Article 39 of the Patent Act Enforcement Rules*)
- ❖ After the invention patent application is laid open, any person believing that the invention claimed should not be granted may, before Taiwan IPO issues the allowance decision, present to Taiwan IPO for reference a written

statement of opinions together with relevant evidencing document (if any).

12. Patent Annuity under the Amendment to Taiwan Patent Act

The amendment to Taiwan Patent Act was promulgated on Dec. 21, 2011 by Presidential Order and will come into force as of Jan. 1, 2013. The amendment with respect to payment of patent annuities is summarized as follows.

I. For an approved patent application, the grant of such patent application shall be published only after the applicant has paid the patent certificate fee and the 1st annuity within 3 months upon receipt of the Allowance Decision of Examination. If the applicant fails to make the above-mentioned required payment within the statutory time limit, the applicant may pay **the patent certificate fee and twice the 1st annuity** within 6 months after expiration of the time limit. The Taiwan IPO shall publish the patent grant afterwards.

II. Annuities from the 2nd year shall be due on the day before the anniversary of the Publication Date. The overdue annuity still can be paid **plus a fine of “20% for each month of delay up to a maximum of 100% of the original annuity fee”** during a 6-month grace period after the due date. Failure to pay the annuity by the deadline of the grace period will cause extinguishment of the patent right.

Yet, the patentee may, **within 1 year after expiration of such grace period,** file a written application to the Taiwan IPO for **“Reinstating the Interrupted Case to its Original Condition”** by paying **triple the original annuity fee.** The Taiwan IPO shall publish the reinstatement of patent right afterwards.

Here is an example of the official cost of the 4th annuity for an **Invention** patent published on Jan. 11, 2010:

4th Annuity Cost		<u>The Official Fee</u>
By Due Date “1/10/2013”		NT\$5,000.00
6-Month Grace Period	1 st month (1/11/2013~2/10/2013)	NT\$6,000.00 (inclusive of a fine: 20% of the original fee)
	2 nd month (2/11/2013~3/10/2013)	NT\$7,000.00 (inclusive of a fine: 40% of the original fee)
	3 rd month (3/11/2013~4/10/2013)	NT\$8,000.00 (inclusive of a fine: 60% of the original fee)
	4 th month (4/11/2013~5/10/2013)	NT\$9,000.00 (inclusive of a fine: 80% of the original fee)

	5 th month (5/11/2013~6/10/2013)	NT\$10,000.00 (inclusive of a fine: 100% of the original fee)
	6 th month (6/11/2013~7/10/2013)	NT\$10,000.00 (inclusive of a fine: 100% of the original fee)
Reinstatement of Patent Right within 1 Year (i.e. (7/11/2013~7/10/2014))		NT\$15,000.00 (i.e. triple the original fee)

- III.** The aforesaid amended provisions are not applicable to “the patents to extinguish by the end of 2012”.