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TIPLO News

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This news mail distributed in Japanese and English from time to time provides updates on the development of law in Taiwan with focus on intellectual property rights law. For more information about the status of intellectual property right protection and practice in Taiwan, please visit our website www.tiplo.com.tw

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01 Taiwan and Japan ink an MOU on patent dossier information exchange

On November 30, 2018, Taiwan-Japan Relations Association and Japan-Taiwan Exchange Association signed an MOU for patent dossier information exchange, according to which, Taiwan Intellectual Property Office (TIPO) and Japan Patent Office (JPO) will work together to provide an one-stop platform that provides both Taiwanese and Japanese applicants and patent examiners with immediate, high-quality, and comprehensive files, dossier, and documents of patent examination. The patent dossier exchange system will enable patent examiners on both sides to consult the patent examination history and result of the other side, which will enhance the convenience, quality, and efficiency of examination, achieve consistency of patent granting in both Taiwan and Japan, and ultimately elevate the quality and stability of patent granting in both countries. Moreover, this patent dossier exchange system will increase publicity and presence of Taiwan's patent examination information so that other patent offices around the world may draw reference on the examination process and result in Taiwan. The system will be officially launched in service starting from January 2021 after its system establishment and relevant tests have been completed.

Besides the good and intense relationships in economy and trade between Taiwan and Japan, Japan was the filing country that filed the most applications for all three kinds of patents in Taiwan with 13,850 applications and also 12,497 applications for invention patent in 2017. Likewise, Taiwanese nationals had also filed almost 3,000 patent applications in Japan in the same year. Once the patent dossier information exchange between Taiwan and Japan becomes effective, patent applicants and patent examiners may have access to the published patent family, list of examination documents and the content of such documents of a patent application through its application number or publication number. As to the information or documents in Japanese language, English translation of such information or documents through machine translation system will be available and users may acquire the IPC and citations of an application. (November 2018)

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02 Draft amendment to partial provisions of Taiwan Patent Act submitted to Executive Yuan

Subsequent to Taiwan IPO's releasing and announcing the draft amendment to partial provisions of the Taiwan Patent Act on May 17, 2018, the notice duration of the draft amendment for public consultation had expired on July 16, 2018 and there had been a lot of advices and opinions contributed from all sectors. Taiwan IPO, through discreet deliberation and widespread consultation, decided to adjust the draft amendment and select some provisions whose amendment is more pressing and submit those provisions to the Taiwan Executive Yuan for review and deliberation. Taiwan IPO's responses to all sectors' advices are compiled and consolidated in a special section at Taiwan IPO's website. Highlights of the draft amendment to the Taiwan Patent Act submitted to the Executive Yuan are summarized as follows.

1. Relaxation of the time limit and applicable scope for filing a divisional application

As proposed in the amendment, a request for division of application may be filed after

receipt of the allowance decision of either the first examination or re-examination of the invention patent application, and the same stipulation shall apply also to utility model patent applications. The timing restriction for filing a divisional application is also extended from 30 days to 3 months after receipt of an allowance decision. Also, under the draft amendment, the divisional application shall be filed only for an invention that is different from that revealed in the description or drawing and the claim approved in the original patent application; if there is any violation of this stipulation, the proposed divisional application will be rejected and there will be a ground for invalidation to stand (Article 34, 46, 71, 107, 119, and 120).

2. Acceleration of invalidation proceedings examination

It is proposed in the amendment that supplementary grounds or evidence shall be submitted within a statutory time limit and delayed submissions will not be examined. Also, limitations and exceptions are provided in the amendment for patentees that may request for amendment of claims during invalidation proceedings (Article 73, 74, and 77).

3. Post-grant amendments of utility model patent

Under the current Patent Act, after a utility model application matures into a registration, the utility model patent holder may file a request for post-grant amendment at any time, for which the draft amendment proposed a time limit for post-grant amendment in the stages that (a) an invalidation action has been filed against the utility model registration and is pending, (b) a request to obtain a technical evaluation report on the utility model registration has been filed but the report has not yet been issued, and (c) a patent infringement suit based on the utility model registration is pending in court. Moreover, all the post-grant amendments filed will be examined in a substantive manner (Article 118).

4. Extension of duration term of design patents

The amendment proposes the patent term of a design patent shall be extended from 12 to 15 years (Article 135).

5. Patent files Preservation

Under the current Patent Act, patent files such as application documents, description, claim(s), abstract, drawing(s) shall be kept permanently. It is proposed in this amendment that only the patent files with preservation value shall be kept permanently and the others shall be preserved for a period of no more than thirty (30) years under appropriate categories, which is to solve the file storage space problem (Article 143).

6. Other provisions to complete the legal regime for patents

This amendment clarifies that failure in submission of priority documents within sixteen months commencing from the earliest priority date will disallow priority reinstatement. Also, the amendment proposed to remove the statutory circumstances that would easily cause misunderstanding for filing an invalidation action of any granted patent term extension (Article 29 and Article 57).

7. Transitional provisions

The draft amendment sets forth transitional provisions, which provide that the patent applications, invalidation actions, and amendments pending before enforcement of

this proposed amendment shall be all subject to the amended provisions, and also that principles or guidelines applicable to the amended regulations, such as, new time limit and scope for filing a divisional application and extended design patent term, will be formulated separately (Article 157-2~Article 157-4). (November 2018)

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03 Legislative Yuan greenlights Taiwan Patent Attorney Act amendments to safeguard right to work of persons with disabilities

To put into practice Article 27 of the UN Convention on the Rights of Persons with Disabilities (CRPD) that ensures the equal rights of persons with disabilities to work and freedom to choose their profession, Taiwan Legislative Yuan passed the third reading of the amendments to Article 4, Article 37, and Article 40 of the Taiwan Patent Attorney Act on November 2, 2018. The amendments repeal the original provisions that those who have been certified by a medical doctor commissioned by the relevant competent authority as having mental illness or physical or mental disorder and thus being unable to engage in professional services shall not practice as a patent attorney or a patent agent. (November 2018)

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04 2018 TOP 20 Taiwanese global brands revealed

The Industrial Development Bureau, the Ministry of Economic Affairs released the 2018 Taiwan International Brand Value List. The Bureau announced the top 20 most valuable brands in Taiwan; Asustek Computer clinched the top position for six consecutive years, while Micro-Star International Co., Ltd. (MSI) joined the ranking again on the back of its successful transformation as an e-sports brand. Compared with last year, the most visible improvement in brand value was contributed by CTBC Holding by 13% growth. Going through a year of more global turmoil, the top 20 brands' total value still went upward steadily with 0.2% increase.

According to the brand value survey, the diversified development pattern of the Taiwan top 20 brands remained unchanged, and consumer electronics and technology sectors kept their steady growth. For example, two brands outshone other brands in the two sectors; they are Trend Micro Inc., which has developed cloud services to correspond to the industrial trend, while Delta Electronics, Inc. has boosted innovation with smart application solutions. Acer Inc. also had remarkable brand value performance on the back of its successful transformation. The most visible growth was seen in financial services brands, among which CTBC Holding (by 13% growth) and Cathay Financial Holdings (by 11% growth) had demonstrated their upward power in brand value.

The brand value survey organizes and points out four major trends for Taiwan's brand development, which are "intelligence driven for industrial reformation", "enterprise alliance for breakthrough", "brand innovation for upgrade experiencing", and "commitment fulfillment for value enhancement". To begin with, the trend of "intelligence driven for industrial reformation" echoes with the rapid development of such emerging technologies as artificial intelligence and IoT that have powered the overall industrial advancement, and to correspond to that, brands will also have to

involve more immediate responsive measures and integration abilities. Next, the trend of “enterprise alliance for breakthrough” is the demonstration of the diversified trans-boundary arrangement through international brands cooperation, which is achieved by breakthrough of traditional thoughts so as to create synergy. In addition, the trend of “brand innovation for upgrade experiencing” will subdivide the market into more sectors and professions, and as a result of that, services providing will be more precise and pertinent and thus experiencing such upgraded services will become the most dominant consumption pattern. Finally, under the trend of “commitment fulfillment for value enhancement”, consumers will pay more attention to the brand mind and transparency of a brand, and therefore, to win consumers’ recognition of a brand will reinforce the trustworthy image of that brand. (November 2018)

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05 Six Taiwanese inventions win 2018 R&D 100 Awards

A total of six Taiwanese innovations were selected as the winners by the 2018 R&D 100 Awards, which has been widely recognized as the “Oscars of invention”. Among the six winning technologies, three of them were submitted by the Industrial Technology Research Institute (ITRI), two by the Institute for Information Industry (III), and the other one by Taiwan Main Orthopaedics Biotechnology Co. Ltd.. Taiwan’s winning inventions stood out and shined among more than 1000 competing entries, showing Taiwan’s innovative force that has been fully recognized by the R&D 100 Awards program for eleven consecutive years and also representing a success of the Technology Development Programs launched by the Ministry of Economic Affairs.

ITRI’s winning inventions include “Functional Dyeing Synchronized with CO2 Supercritical Technology”, “Portable UVC LED Water Sterilizer System”, and “Automatic Police UAV Patrol System”. III’s selected winning inventions are “Hybrid MassLINK Bus Stop” and “Streaming *Analytics* System for Manufacturing Performance Monitoring” that uses big data analytics to boost speed and accuracy. The other award-winning invention was the worldwide exclusive technology of “Smart Surgical Glasses System Designed to Aid in Minimally Invasive Surgery” presented by Taiwan Main Orthopaedics Biotechnology Co. Ltd.. (November 2018)

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