



Please rest assured that Taiwan IPO and our firm have been maintaining normal operation as the coronavirus pandemic spreads throughout the world.

When faced with the severe global health crisis triggered by the pandemic, please take good care of your health and stay healthy.

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-Korea cooperative program for mutual recognition of deposit of biological materials implemented as of September 1, 2020

Taiwan Intellectual Property Office (hereinafter referred to as the “TIPO”) and the Korean Intellectual Property Office (hereinafter referred to as “KIPO”) successfully inked the Memorandum of Understanding for the Mutual Cooperation in the Field of Deposit of Biological Materials for the Purposes of Patent Procedure in August 2020, following the launch of the cooperative program on mutual recognition of the deposit of biological materials for the purpose of patent procedure between Taiwan and Japan in 2015 and between Taiwan and the UK in 2017. The cooperative program between Taiwan and Korea has been implemented since September 1, 2020, which will expand the scope of mutual recognition of the deposit of biological materials with other countries.

After implementation of this cooperative program between Taiwan and Korea, TIPO recognizes the deposit of biological materials at the depositary designated by KIPO, and likewise, KIPO recognizes the deposit at TIPO’s designated depositary. In this regard, Taiwanese applicants who file patent applications relating to biological materials with KIPO or South Korean applicants who file patent applications relating to biological materials with TIPO are both able to have their biological materials deposited in their respective local designated depositary, which will ultimately simplify the deposit procedure for patent applicants of both sides, avoid the possible disability of the biological materials that may be caused by cross-border deposits, and further decrease the cost of repeated deposits.

Currently, the Food Industry Research and Development Institute is the designated depositary of TIPO, while those designated by KIPO are the Korean Collection for Type Cultures, the Korean Culture Center of Microorganisms, the Korean Cell Line Research Foundation, and the Korean Agricultural Culture Collection.

In addition, it is noticeable that TIPO and KIPO mutually recognize the deposits of biological materials which had been made in the Food Industry Research and Development Institute of Taiwan or in the depositary designated by KIPO before implementation of this cooperative program without repeated deposits to be made in either Taiwan or South Korea as long as their patent applications were filed on or after September 1, 2020 and the deposit certificates are submitted before the designated deadline. (Released 2020.09.01)

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02 Operational Directions for the Processing of Third-Party Observations on Invention Patent Applications in effect as of September 1, 2020

Taiwan Intellectual Property Office (hereinafter referred to as the “TIPO”) has been committed to pursuing the best patent quality. It is a common and effective practice adopted worldwide to ensure the stability of patent rights by encouraging any third parties’ submissions of prior art pertaining to the patentability of a claimed invention during the laid-open period for 18 months following the earliest effective filing date of any invention patent applications. For implementing Article 39 of the Enforcement Rules of Patent Act and for making the third party observation mechanism in patent examination more integral and complete, TIPO enacted and

announced the Operational Directions for the Processing of Third-Party Observations on Invention Patent Applications (hereinafter referred to as the “Operational Directions”) on August 25, 2020, which has come into effect since September 1, 2020. The enactment of the Operational Directions is expected to clearly regulate public participation procedures, and TIPO also provides a convenient access for third parties to submit their observations through its Patent Search System. Moreover, the patent citation information submitted by third parties will be relayed to relevant patent applicants by notification and will also be made available to the public on the Patent Search System. Through this mechanism, the public input in the form of third-party observations will apply most efficiently for enhancement of patenting quality.

The enforcement of the Operational Directions will be favorable and advantageous to patent applicants, the industries, and the TIPO in the following aspects.

1. For patent applicants, they were unable to consult or take reference of third parties’ citation information and to make necessary revisions of their claims before patent approval and thus waste more time and cost in post-grant invalidation actions, due to the fact that 90% out of the yearly 100 third-party patent observations were not made public upon such 90% third parties’ requests. Now, with the enforcement of the Operational Directions, patent applicants will receive notification regarding any third-party submissions on their claimed inventions in a timely manner, which will not only maintain patent applicants’ rights and interests but also elevate the stability of their patents and further facilitate their patent portfolio at home and abroad.
2. The more convenient access and document templates provided by the TIPO will make it easier for interested parties of relevant industries to file observations and prior art for examination purposes. In addition, the rules governing the time frame for third-party submissions are relaxed, which will be favorable to the interested parties in the circumstance where an applicant files both an invention application and a utility model application at the same time; the interested parties may submit their observations or prior art after completion of the formal examination of the utility model patent application, which procedurally would take a little over two months only, without having to wait for the due date of 18-month laid-open period for the invention patent application to do so.
3. For the TIPO, to provide a convenient access to the third-party observation application forms and document templates on the Patent Search System is able to motivate third parties to submit citation information and will in turn assist examiners in getting hold of and gaining an overview of prior art and also decrease the administrative costs possibly to be incurred in subsequent invalidation proceedings.

Generally speaking, the implementation of the Operational Directions will make Taiwan keep pace with international practices, facilitate public participation in patent examination, help patentees maintain the validity of their patents with less economic burden, and ultimately upgrade the quality of patent examination quality in Taiwan. (Released 2020.09.01)

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03 Taiwan IPO held public hearing for amending Trademark Act to establish practice of trademark agents

Taiwan IPO held a public hearing for the draft amendment to the Trademark Act (with respect to the provisions governing trademark agents) and draft of the Regulations Governing Trademark Agent Registration and Administration on August

17, 2020.

Back to year 2011, the Trademark Act of Taiwan was amended with the provision repealed, which stipulated that certified trademark attorneys can act as trademark agents. Repeal of this provision in the 2011 amendment was attributable to the fact that trademark-related matters in Taiwan were mostly handled by attorneys-at-law or any person who is experienced in trademark matters. The repeal, however, forms a regulatory loophole that any person can act as a trademark agent as long as he/she has domicile in Taiwan, which made it questionable that every trademark agent is truly qualified and specialized to act in trademark matters and is capable of properly handling all procedural matters for his/her clients as generally expected. In consideration of the aforesaid loophole, Taiwan IPO proposes to amend the current Trademark Act to formulate clear-cut provisions governing the qualifications of trademark agents, authorizing relevant competent authority to manage registration and administration of trademark agents, with a view to making trademark agents act upon their professional knowledge and work ethics to handle trademark-related matters and protect their clients' rights and effectively fulfill the purposes in each trademark-related procedure.

In response to the enactment of the Regulations Governing Trademark Agent Registration and Administration, the amendment to partial provisions of the Trademark Act clearly specifies the basis of authorization for the registration and administration of trademark agents and add a requirement that the trademark registry shall prepare a list of registered trademark agents and publish the registration and change of information of trademark agents, which makes information of trademark agents accessible and ready for the public's search. Moreover, according to the legal principle of security of right to work, the amendment establishes transitional provisions stipulating that people having been acting as trademark agents will have to satisfy certain qualifications for continuing eligibility of practicing as trademark agents. (Released 2020.08.18)

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