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2017 Taiwan Patent Act and Related Examination Guidelines Developments

- 01 Taiwan Patent Examination Guidelines Change Updates**
- 02 Partial amendments to the Enforcement Rules of Patent Act took effect from May 1, 2017**
- 03 Extended grace period provisions of Taiwan Patent Act came into force from May 1, 2017**

01 Taiwan Patent Examination Guidelines Change Updates

Most recent amendments to Patent Examination Guidelines pertain to invalidation actions, grace period claims and the inventive step patentability test:

1. Effective as of 1 January 2017:

- a) Amendment to Chapter 9 (*Amendments & Corrections*), Part II Invention Patents Substantive Examination;
- b) Amendment to Chapter 1 (*Invalidation*), Part I Invalidation Examination.

Important changes pertaining to invalidation :

- 1) Added: exceptions where the amended will not be deemed withdrawn as a matter of course;
- 2) Added: items of matters which applicant of a dual application may exercise the right to clarify;
- 3) Added: taking of evidence retrieved online and taking of foreign-language evidence;
- 4) Removed: some of the examples given to explain what items may be subject to *ex officio* examination.

2. Effective as of 1 May 2017:

- a) Amendment to Part I Formality Examination & Patents Administration, including Chapter 2 (*Application Form*), Chapter 4 (*Attorney*), Chapter 7 (*Priority Claim & Grace Period*) and Chapter 13 (*Divisional Applications*);
- b) Amendment to Part II Invention Patents Substantive Examination: Section 4 Exceptions to Being Determined Obvious or Non-inventive, Chapter 3 (*Patentability*)

Requirements);

c) Amendment to Part III Design Patents Substantive Examination: Section 4 Exceptions to Being Determined Obvious or Non-inventive, Chapter 3 (*Patentability Requirements*).

Important changes pertaining to grace period (Section 4 Exceptions to Being Determined Obvious or Non-inventive, Chapter 3, Part II):

1) Grace period granted to inventions and utility models extended to 12 months (previously 6 months);

2) Laying-open related eligibility conditions for claiming grace period relaxed: Applicant may seek grant of grace period where the patent claimed has been laid open as a result of applicant's own intention to do so or in case of involuntary laying-open;

3) Manners and forms of publications (other than in Patent Gazette) no longer restricted.

4) Requirement that grace period claim (if any) must be made upon filing removed.

5) Added: laying-open made in Patent Gazette (Section 4.4); examination of claimed exceptions to being determined obvious or non-inventive (Section 4.7); points for attention regarding examination (Section 4.8). The Design Patents Examination Guidelines pertaining to grace period shall change in line with the amendment to those applicable to invention patents except that the grace period granted to design patents shall remain 6 months.

3. Effective as of 1 July 2017:

Amendment to Section 3 (*Inventive Step*), Chapter 3 Patentability Requirements, Part II Invention Patents Substantive Examination

Important changes regarding examination of the inventive step patentability requirement:

1) Added: A person skilled in the art in the relevant field of the invention claimed may be a group of persons;

2) Added: Elucidation of each step of the inventive step patentability test with step no. 5 illustrated in flowchart.

3) Sections 3.4 and 3.5 combined and consolidated to perfect step no. 5 of the test.

4) Added: scenario where a person skilled in the art is motivated to and capable of manifestly combining references (Section 3.4.1); scenario where a person skilled in the art is capable of manifestly combining references without considering his/her motive, if any (Section 3.4.2); other factors to consider in testing inventive step (Section 3.4.3); secondary factors to consider in testing inventive step (Section 3.4.4); additional explanatory examples.

[Source: Taiwan IPO <https://www.tipo.gov.tw/np.asp?ctNode=6703&mp=1>]

02 Partial amendments to the Enforcement Rules of Patent Act took effect from May 1, 2017

The Ministry of Economic Affairs has promulgated the partial amendments to the Enforcement Rules of Patent Act and had these amendments enforced since May 1, 2017 for implementing the amended grace period provisions of the Patent Act.

03 Extended grace period provisions of Taiwan Patent Act came into force from May 1, 2017

The amended provisions of Taiwan Patent Act promulgated on January 18, 2017 came into force on May 1, 2017 upon the Executive Yuan's approval. Amendments to the grace period provisions are summarized below.

1. The grace period for future invention and utility model patent applications is extended from 6 months to 12 months.

2. More lenient requirements on how the disclosure is made are provided; that is, invention applications will be eligible for the grace period as long as the disclosure thereof is made out of or not out of the applicant's intention.

3. It is no longer mandatory to claim grace period simultaneously on the date of filing.

The amended grace period provisions will be applicable to the applications filed on or after May 1, 2017.



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