

[Proposed Patent Act Amendment in Taiwan]

The prevailing Taiwan Patent Act was comprehensively amended and enforced on January 1, 2013, followed by minor amendments in June 2013, 2014 and 2017. To meet the international trends, Taiwan Intellectual Property Office (TIPO) previously conducted a thorough review of the Patent Act, and raised amendment issues to hold public hearings several times. Recently, TIPO has made a proposed Patent Act Amendment to solicit public opinion. An overview of the major changes of Patent Act proposed by TIPO is as follows:

	Content of Amendment	Prevailing Provision	Proposed Amendment Provision	Proposed Amended Articles
1	Reinstatement of Claiming International Priority	An applicant may claim the priority of a patent application which was first filed in a foreign country having reciprocal recognition with Taiwan or in any member of WTO, for filing a patent of invention or utility model in Taiwan within 12 months (or 6 months for a design patent application) from the filing date of said foreign patent application.	If an applicant has unintentionally failed to file a patent application of invention or utility model within 12 months (or 6 months for a design patent application) in Taiwan from the filing date of a foreign patent application, he/she may file said patent application in Taiwan within 2 months after expiration of the priority deadline, and still claim foreign priority by paying fees.	§28, 120, 142
2	Scope and due date for filing a divisional application after allowance of a patent application	A divisional application may be filed within 30 days upon receipt of Notice of Allowance for an invention patent application after its primary examination.	A divisional application may be filed within 3 months upon receipt of Notice of Allowance for a patent application of invention, utility model or design after its primary examination or re-examination	§34, 46, 71, 107, 119, 120, 130, 134, 141, 142
3	Due date for filing a substantive examination	A substantive examination must be filed within 3 years after filing an invention patent application.	If an applicant has unintentionally failed to request for substantive examination within 3 years, he/she may file a request within 2 months after the due date by paying fees to reinstate the request for substantive examination	§38

	Content of Amendment	Prevailing Provision	Proposed Amendment Provision	Proposed Amended Articles
4	Legal use of the documents on file in a manner of reproduction, public transmission and translation after laid-open or publication of a patent	Not expressly stipulated.	Any person may reproduce, public transmit and make translation of specification, claims, abstract and drawings which is laid-open or published, in order to establish patent database for search.	§47
5	License agreement stands against an assignment of patent right	Not expressly stipulated.	After recordation of a license agreement, the license agreement still exists even the patent right is transferred to a third party.	§62
6	Invalidation procedure	An invalidation petitioner should supplement invalidation reasons or evidence within one month after initiating a petition for invalidation of patent; however, supplementary reasons or evidence shall still be examined by the Examiner before a decision is made.	An invalidation petitioner should supplement invalidation reasons or evidence within three months after initiating a petition for invalidation of patent; the overdue supplementary reasons or evidence shall not be examined; also, a correction by patentee is restricted to the specified time period only when receiving a notice to make counterstatement, supplementary counterstatement or response, except for an invention patent which is in pending of court proceedings.	§73, 74 77
7	Time period for filing correction of a utility model patent is restricted and substantive examination shall be made thereon	The correction of a utility model patent is conducted by a formality examination, and no time period has been set for filing the amendment.	Correction of a utility model patent may be filed, besides the statutory period of the invalidation examination, also during the period where a technical report of utility model patent is requested or a utility model patent is pending in court proceedings; the correction will be examined by substantive examination.	§118
8	Protection duration of a design patent is prolonged	The patent duration of a design is 12 years from its filing date.	The patent duration of a design will be 15 years from its filing date.	§135
9	Amending the retention period of patent files	The application, specification, claims, abstract, drawings of a patent file shall be retained permanently.	The application, specification, claims, abstract and drawings of a patent file worth for retention shall be retained permanently, while other documents shall be retained for no more than thirty years depending on the patent types and conditions.	§143

As can be seen from the above, many proposed amendments are set to loosen the time limit for various filing procedures, such as priority claiming, substantive examination, divisional application, invalidation, design patent term, and so on. The proposed Patent Act amendment bill by TIPO will need to be approved by the Ministry of Economic Affairs (MOEA) before submitting to Executive Yuan (Cabinet), and then passed three readings by Legislative Yuan (Parliament). For this sake, it may take one to two years for the newly revised Patent Act to be enforced in Taiwan.

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