

[Latest Proposed Patent Act Amendment in Taiwan]

The prevailing Taiwan Patent Act was revised in 2011 and implemented on January 1, 2013, followed by revisions of partial articles in June 2011, 2014 and 2017, respectively. Due to global economic situation and changes, Taiwan Intellectual Property Office (TIPO) proposed to revise the Patent Act by holding public hearings in December 2017 and January 2018. TIPO then published the proposed Patent Act Amendment on May 17, 2018, which was reported in our newsletter of June 25, 2018.

By taking consideration of the different public comments, TIPO decided to proceed with few revised articles which are imperative to meet the current demand and practice. For the time being, some of the proposed articles would not be revised, such as reinstatement of claiming international priority, reinstatement for failure to file substantive examination within the 3-year deadline, etc. The latest proposed Patent Act Amendment by TIPO was made in November 2018 and then passed by the Executive Yuan on December 27, 2018. Accordingly, the proposed Patent Act Amendment has five major issues shown in the following table.

	Content of Amendment	Prevailing Provision	Proposed Amendment of Provision	Articles
1	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 or utility model after its primary examination or re-examination	§34, 46, 71, 107, 119, 120
2	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 made on specification, claims, etc. by patentee is restricted to the specified time period only when receiving a notice to	§73, 74, 77

	Content of Amendment	Prevailing Provision	Proposed Amendment of Provision	Articles
			make counterstatement, supplementary counterstatement or response, except for an invention patent which is in pending of court proceedings.	
3	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 correction.	Correction of a utility model patent may be filed within the statutory period of the invalidation examination, 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
4	Protection duration of a design patent 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
5	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

The above proposed Patent Act Amendment has been submitted to Legislative Yuan for deliberation. It is unknown when the revised Act will pass three readings by the Legislative Yuan. However since only partial amendments of the Patent Act are made, the revised Taiwan Patent Act may be passed soon and possibly be implemented in 2019 or 2020.