

## Practice of Filing Patent Divisional Application in Taiwan

1. According to the Taiwan Patent Act implemented between January 2011 and October 2019, if there are two or more inventions for an invention patent application, a divisional patent application could be filed by the applicant or upon the notification of examiner, within the following time limits:
  - 1) During the prosecution of primary examination or re-examination stage
  - 2) Within 30 days upon receipt of a Notice of Allowance after primary examination (but not re-examination)

The effect for a divisional application:

- 3) Retaining the application date of parent application (i.e. original application date)
  - 4) Claiming the same priority/priorities as that of its parent application
  - 5) Its contents shall not exceed the scope of specification, claims, and drawings (if any), of its parent application
  - 6) Its examination shall continue from the examination procedure of its parent application, which means a divisional application will be conducted for a primary examination or re-examination depending on whether said divisional application is filed in the stage of primary examination or re-examination
2. Per the Taiwan Patent Act amended and implemented on November 1, 2019, the time limit and procedures for filing a divisional application of an invention patent application has been relaxed as follows:
    - 1) During the prosecution of a primary examination or re-examination stage
    - 2) Within 3 months upon receipt of a Notice of Allowance after primary examination or re-examination

The effect for a divisional application:

Same as the above 3), 4), 5) and 6), plus the following 7).

7) A divisional application filed after the parent application has been allowed, it shall be based on the specification or drawings as disclosed by the parent application, and its claims must not be the same invention to the claims as allowed for said parent application.

Namely, a divisional application could be filed according to the technical content from the specification or drawings but not the claims of its parent application.

3. In Taiwan, a utility model patent application has adopted formality examination, and is not applicable to the re-examination system. Before the Patent Act was amended, a divisional utility model application could be filed only during the examination of its parent application and prior to receipt of a Notice of Acceptance. Per the revised Patent Act effective from November 1, 2019, a divisional application could be filed within 3 months upon receipt of a Notice of Acceptance for utility model application.

4. For a Taiwan design patent application, its divisional application shall not be filed after receipt of a Notice of Allowance. However, a divisional design application may still be filed during the prosecution in primary examination or re-examination.
5. As mentioned above, starting from 2011, a divisional application could be filed for invention patent application after its allowance at primary examination stage. The filing numbers of divisional applications for all three patent types are as follows:

Year	2011	2012	2013	2014	2015	2016	2017	2018	2019*
Invention	803	1122	1583	1984	2537	2917	2936	2328	1304
Utility Model	15	3	21	9	10	5	12	12	4
Design	57	54	205	239	204	211	203	249	215

Source: Taiwan Intellectual Property Office

\*up to July 15, 2019

6. Below are filing numbers of divisional invention applications filed at different stages from 2013 and up to July 2019. It shows that over one half of the applicants filed divisional applications when the parent applications were allowed after primary examination.

	Filing numbers	Percentage
During prosecution of primary examination	4024	25.73
Upon receipt of Notice of Allowance after primary examination	8977	57.40
During prosecution of re-examination	2638	16.87

Source: Taiwan Intellectual Property Office

7. Generally, a divisional application is filed in consideration of the following factors:
  - ♦ Unity of invention
  - ♦ Matter not claimed by the parent application
  - ♦ Obtaining different examination results
  - ♦ Prolonging the examination period indirectly
  - ♦ The allowed scope of parent application does not meet the desired protection
  - ♦ Increase numbers of granted patents
8. In 2019, Taiwan relaxed many restrictions on filing a patent divisional application. Under the current patent system, a divisional application can be filed during the prosecution of an invention, utility model, or design application, within 3 months after the allowance of an invention application at the stage of primary examination or re-examination, and also for a utility model application after its allowance. However, a divisional application cannot be filed upon the rejection of a patent application. If a patent application is rejected at the primary examination stage, the applicant must first file a request for re-examination, and then file a divisional application while the parent application is live. Moreover, the filing of such divisional application is not applicable when a patent application has been rejected at the re-examination stage. Therefore, the current Taiwan patent divisional system may not fully protect the benefit of applicant. Hopefully, future adjustments can be introduced to enable the filing of a divisional application upon the rejection of its parent application.