



NEWSLETTER

NOV 20, 2024 NO.20241120-E1

Recent Draft Amendments of Patent Act on Taiwan Design Application

Taiwan Intellectual Property Office (TIPO) recently announced on September 11, 2024 a draft for the proposed amendments to the Patent Act on Design Application, followed by a public hearing on November 4, 2024. The proposed amendments have included important changes in design applications. The main points are summarized as follows.

Items	Prevailing Stipulations	Draft Amendments	Remarks
Multiple designs for one application	In principle, one design application can have only one embodiment of design. If an applicant has two or more similar designs, the applicant may file a design application as the principal design, and other similar design(s) as derivative design application(s).	If the same applicant has two or more similar designs, the applicant can file the multiple designs in a single design application by designating one of the designs as the principal design.	As the current derivative design application may still be retained, there will be two options for a same applicant to file similar designs: 1) one application filed with multiple designs; or 2) derivative application(s) filed for similar design(s).
Graphic design	Design application can be filed for computer generated icons (Icons) and graphic user interface (GUI) that applied to an article (product).	Relaxing the restrictions on that for graphic design produced by digital technology must be applied to an article (product).	Removing the restriction of graphic design that must be applied on the article, and stipulating that the graphic design must be produced by computer programs or other digital technologies (namely, the design application of non-computer digitally generated pattern must still be applied to an article).
Novelty grace period	6 months	12 months	The time period after the fact of disclosure occurs (by the Applicant's intentional or unintentional disclosure, and this will not result in the

			loss of novelty and creativity).
Divisional application	A divisional application must be filed during the stage of primary examination or re-examination, i.e. before the design application has been allowed for grant of patent.	The Applicant can file a divisional application within 3 months upon receipt of Notice of Allowance for primary examination or re-examination, and the divisional application shall follow the same procedure (primary examination or re-examination) that conducted for the original application (parent application).	A divisional application can be filed within three months after receipt of Notice of Allowance.

Currently, Taiwan design application is on the basis of one design (embodiment) for each application. If the same applicant has a similar design, he/she can file a derivative design application, which is equivalent to Japan's "related design" application. Furthermore, design application and derivative design application in Taiwan are subject to substantive examination. After TIPO has conducted the examination and allowed the design application and derivative design application, the Applicant will receive a Letters Patent upon payment of fees and will also pay annuities separately. TIPO is now trying to introduce the multiple designs mechanism by referring to the Hague Agreement and procedures of the European Union and the United States. A design application with multiple designs will have to pay the official filing fees based on the number of designs. If an invalidation is filed after the grant of patent, it can be made against one or more designs of said design application and thus its official fees will depend on the number of designs. Therefore, if Taiwan provides a dual-track system of filing derivative design application for similar design, and filing multiple designs for a single application, TIPO must also consider various factors and the opinions from all the parties. Accordingly, TIPO may further revise the above proposed draft amendments of Patent Act.

