

# Measures to Enhance Patent Examination Quality

Chinese Taipei  
APEC IPEG Feb 27<sup>th</sup>-28<sup>th</sup>, 2018  
(Port Moresby, Papua New Guinea)



# Patent Examination Quality

◆ Examination Quality Depends on Work Quality in All Aspects

◆ Patent Examination Quality Related Initiatives in 2017

➤ **Quality Management System 2.0**

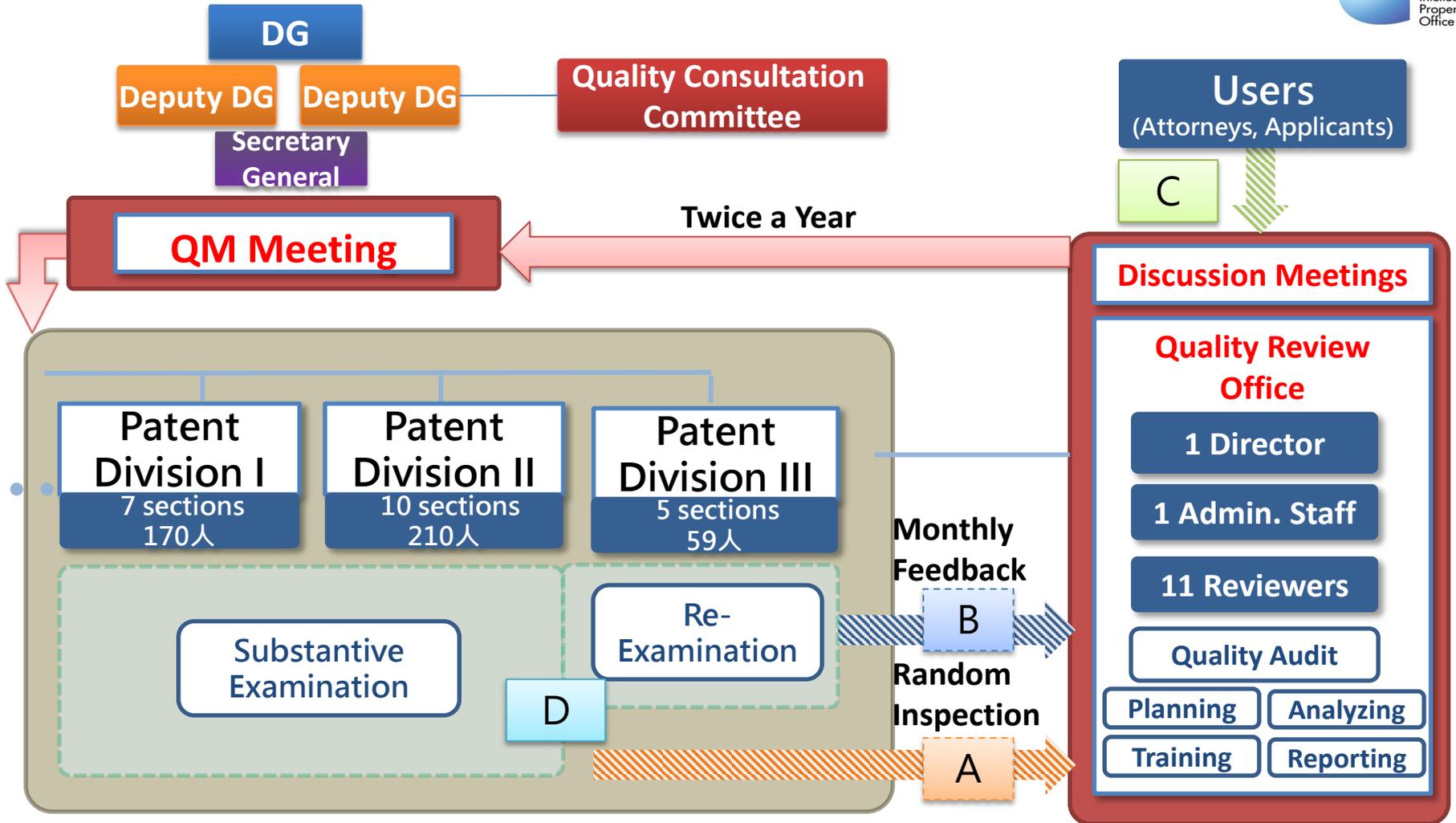
➤ **Revisions to the Examination Guidelines**

- Grace Period
- Inventive Step
- Post-grant Amendment
- Invalidation

➤ **Improving Interview Practice**



# 1. Quality Management System 2.0



**A:** Random Inspection Before OAs or Disposals are Dispatched

**B:** Monthly Feedback From Reexamination Division

**C:** Irregularly Feedback From Users

**D:** Daily In-the-division Check Measures

# 1. Quality Management System 2.0 (cont.)



## Key points

- Full-time quality review director
- Increase inspection rate & refine inspection items
- Improve the procedure when examiners disagree with the quality review result

年 月發明專利初審案件覆核表

單位：專利 組 科案號：  通知 ( 首通  2通以上  最後通知)  核准 ( 核准)  核駁 ( 逾期)  TW-SEPA
 發明名稱：  研發替代業  研發替代業  專利檢索中心  覆核人員：

承審人員：  內審  外審 IPC 分類號：

內容輔助人力(如有)  專利檢索中心  覆核人員：

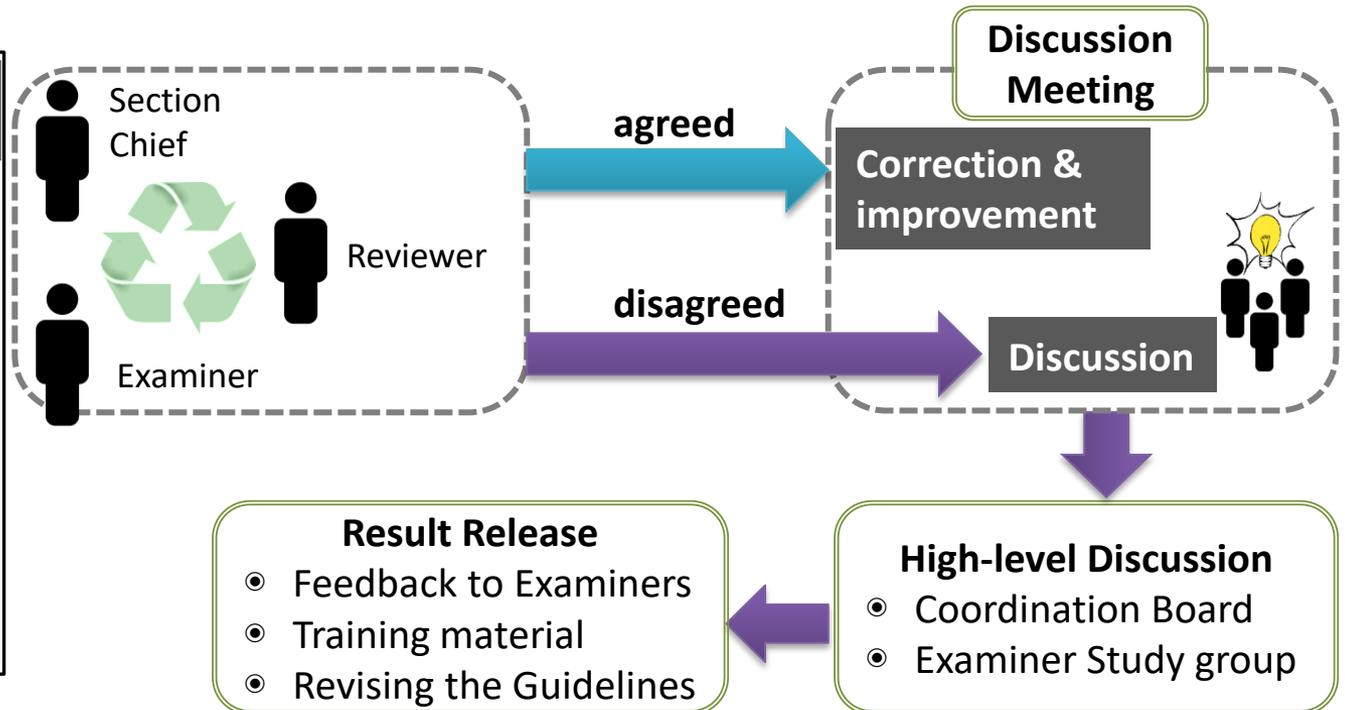
OA核駁案件審查結果			
V	核駁事由	申請專利範圍	說明書
	違反記載要件 <input type="checkbox"/> 820-1 <input type="checkbox"/> 820-2 <input type="checkbox"/> 820-3 <input type="checkbox"/> 820-4		
	不具新穎性		
	不符發明定義		
	擬制喪失新穎性		
	不具進步性		
	不具發明單一性		
	其他不准專利事由		

覆核意見

覆核人員(簽名/日期)： 覆核人員(簽名/日期)：

覆核意見彙整簡表

<input type="checkbox"/> 未發現瑕疵	<input type="checkbox"/> 論述理由錯誤
<input type="checkbox"/> 審查版本錯誤	<input type="checkbox"/> 論述理由不充分/不恰當/結構不妥
<input type="checkbox"/> 引證不適當	<input type="checkbox"/> 基本資料有誤
<input type="checkbox"/> 引證不恰當/不足	<input type="checkbox"/> 審查意見/檢索報告內容誤譯或漏記
<input type="checkbox"/> 請求項尚未審查/未逐項論述	<input type="checkbox"/> 其他
<input type="checkbox"/> 法律引用不當	

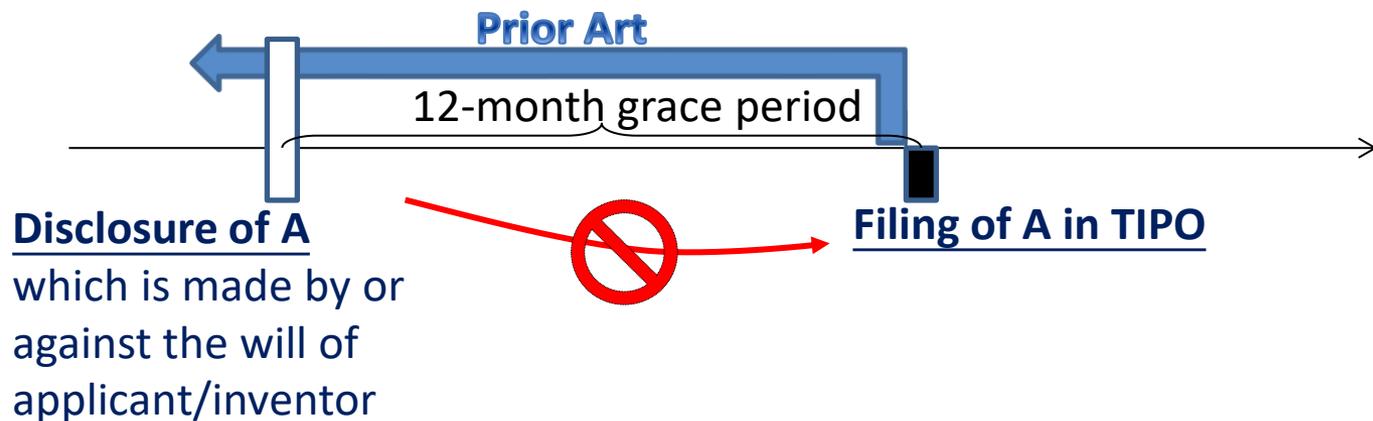


## 2. Grace Period-Guideline Revision



### Key points

- **12-month grace period**
- **Disclosure made by applicant/inventor + Disclosure against the applicant/inventor's will**
- **Declaration shouldn't be made at the time of filing**



# 3. Inventive Step-Guideline Revision



## Key points

- **Detailing the 5-step procedure of determining inventive step**
- **Consider both “factors in support of the non-existence of inventive step” and “factors in support of the existence of inventive step”**
- **Hint or motivation to combine prior arts is strictly required**
- **More examples added**

### Facts in support of the non-existence of inventive step

- Motivation for combining prior art
  - (1) Relation of technical field
  - (2) Similarity of problems to be solved
  - (3) Similarity of operations or functions
  - (4) Teaching or Suggestion
- Simple variations
- Mere aggregation of prior art



### Facts in support of the existence of inventive step

- Teach away
- Advantageous effects
- Secondary considerations
  - (1) Unexpected result
  - (2) Solving long-felt need
  - (3) Overcoming technical prejudice
  - (4) Commercial success

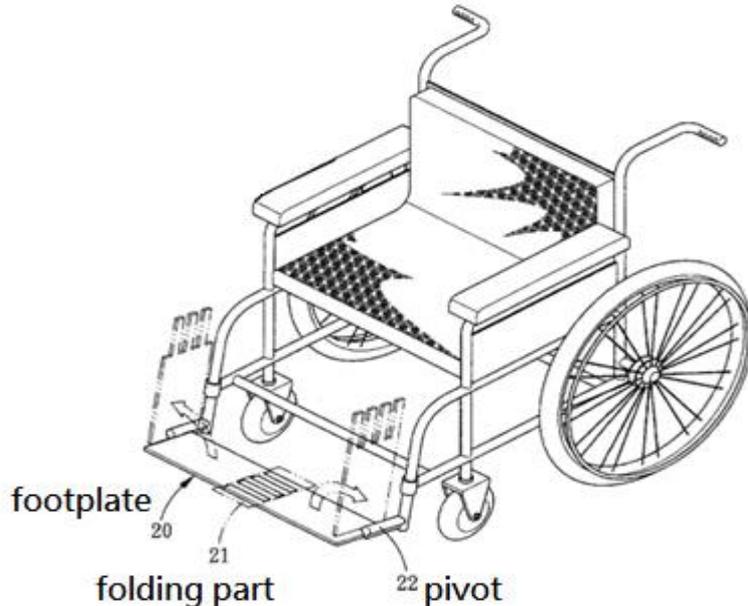
Factors for evaluating whether claimed invention has an inventive step

# 4. Post-grant Amendment-Guideline Revision

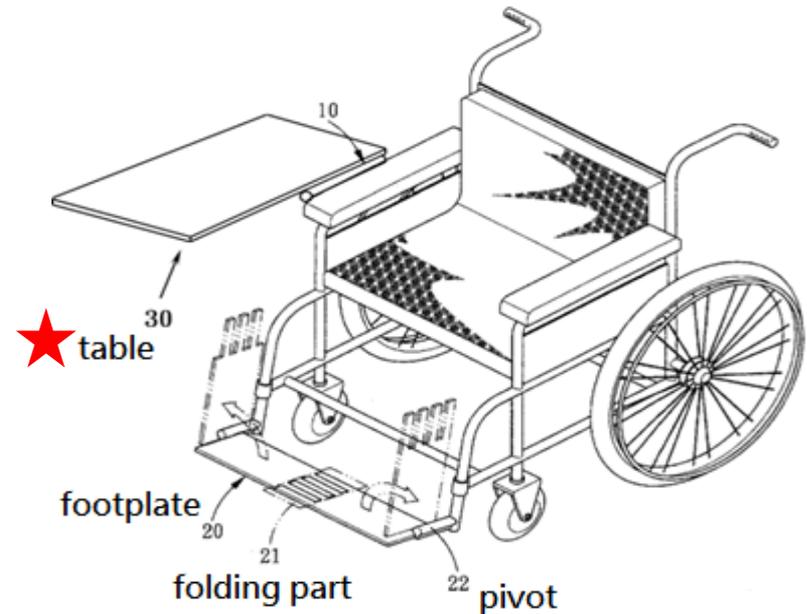
## Key points

- **Relaxing the methodology used to determine “substantially altering the claim scope”-- whether the object of claimed invention is maintained**
- **More examples added**

Before Claim 1



After Claim 1



# 5. Invalidation-Guideline Revision

## Key points

- **Methods for proving the publication date of webpage evidences**
- **Investigation of the translation of foreign language evidence**

### Webpage evidence from the Invalidation Petitioner



### Counter evidence from the Patent Owner



If evidence for invalidation is the FLASH portion on a webpage, date stamps from Wayback Machine cannot be used to prove the publication date.

# 6. Improving Interview Practice

## Key points

- **New request form to enhance the communication before interview**
- **Procedure, space and equipment improvements**
- **Interview record completeness**





# Thank You

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