



2019 Patent Act Amendments

CHINESE TAIPEI

APEC IPEG AUG 15th-16th, 2019

PUERTO VARAS, CHILE

LEGISLATIVE PROGRESS



The amendments to the Patent Act were promulgated on 2019.5.1 and will enter into force on 2019.11.1



2019.4.16 The amendments to the Patent Act were passed by the Legislative Yuan through a third reading



2017.12.21 & 2018.01.15
Public hearings were held



The key points of the amendments

Expand the scope and period of patent application division after written decision of allowance is served

Enhance the examination effectiveness of invalidation requests

Set the period for applying post-grant amendments to utility model patents while adopting substantive examination

Extend the term of protection for design patents



Expand the scope and period of patent application division after written decision of allowance is served

Before

After

Only applicable to invention applications

Applicable to invention applications and utility model applications

Shall be submitted within **30 days** after the date on which an approval decision for the original patent application is served

Shall be submitted within three (3) months after the date on which an approval decision for the original patent application or reexamination is served



Enhance the examination effectiveness of invalidation requests

The time period for a requester to provide reasons or evidence

1. Before

- The requester should provide further evidence or reasons if necessary within 1 month after proposing an invalidation request.
- If the reason or evidence is provided prior to a written decision is made, it should still be examined.

2. After

The requester should provide the reason or evidence within 3 months or it shall not be examined.

The time period for a patentee to propose a post-grant amendment

1. Before
No such limits

2. After

- Post-grant amendment may only be filed when the patentee is notified to provide responses or further responses.
- A pending litigation case involving the invention patent in question is not bound by this rule.

The time period for a requester/patentee to give a response

1. Before
No such limits

2. After

- When TIPO sends a notification to the requester /patentee to submit comments or responses, the requester/patentee must reply within 1 month .
- Unless a request for extension has been approved, no comment or response shall be examined if the requester or patentee fails to reply within 1 month.



Set the period for making post-grant amendment to utility model patents while adopting substantive examination

Before

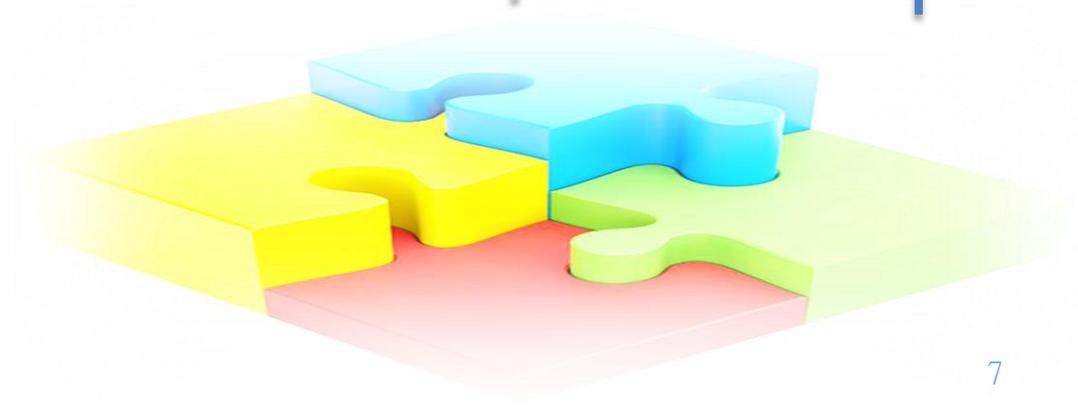
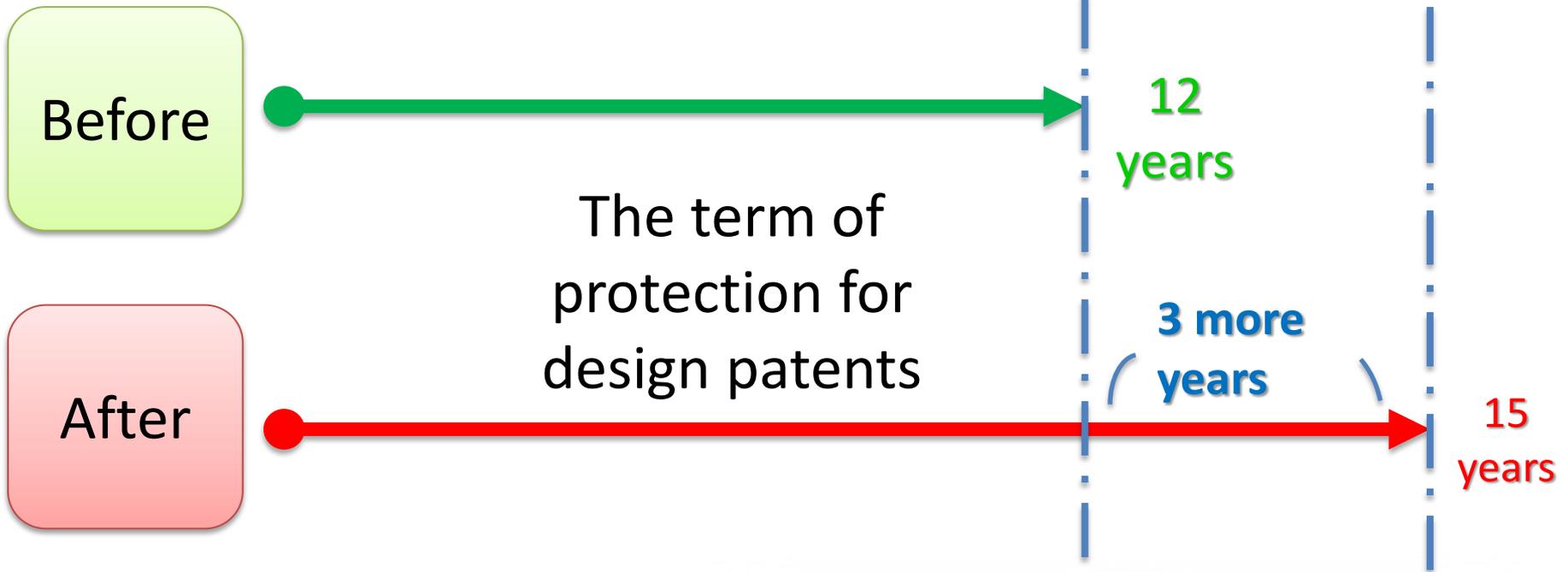
- Post-grant amendments to the utility model patent may be carried out at any time
- Except that post-grant amendments are proposed when an invalidation request is made, TIPO shall conduct formality examination for the post-grant amendments.

After

- Post-grant amendments shall apply only in the circumstances as specified below:
 - **A request for a technical evaluation report of a utility model patent is pending**
 - **A litigation case involving a utility model patent is pending**
 - **An invalidation case is pending**
- Substantive examination will be adopted



Extend the term of protection for design patents





**Thank you for your
attention**

