

Measures to Enhance Patent Examination Quality

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



Patent Examination Quality

◆ Examination Quality Depends on Work Quality in All Aspects

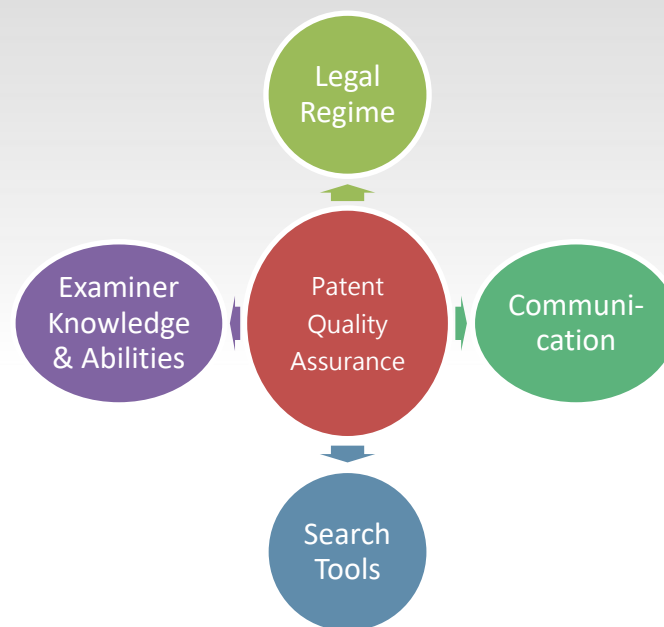
◆ Patent Examination Quality Related Initiatives in 2017

➤ **Quality Management System 2.0**

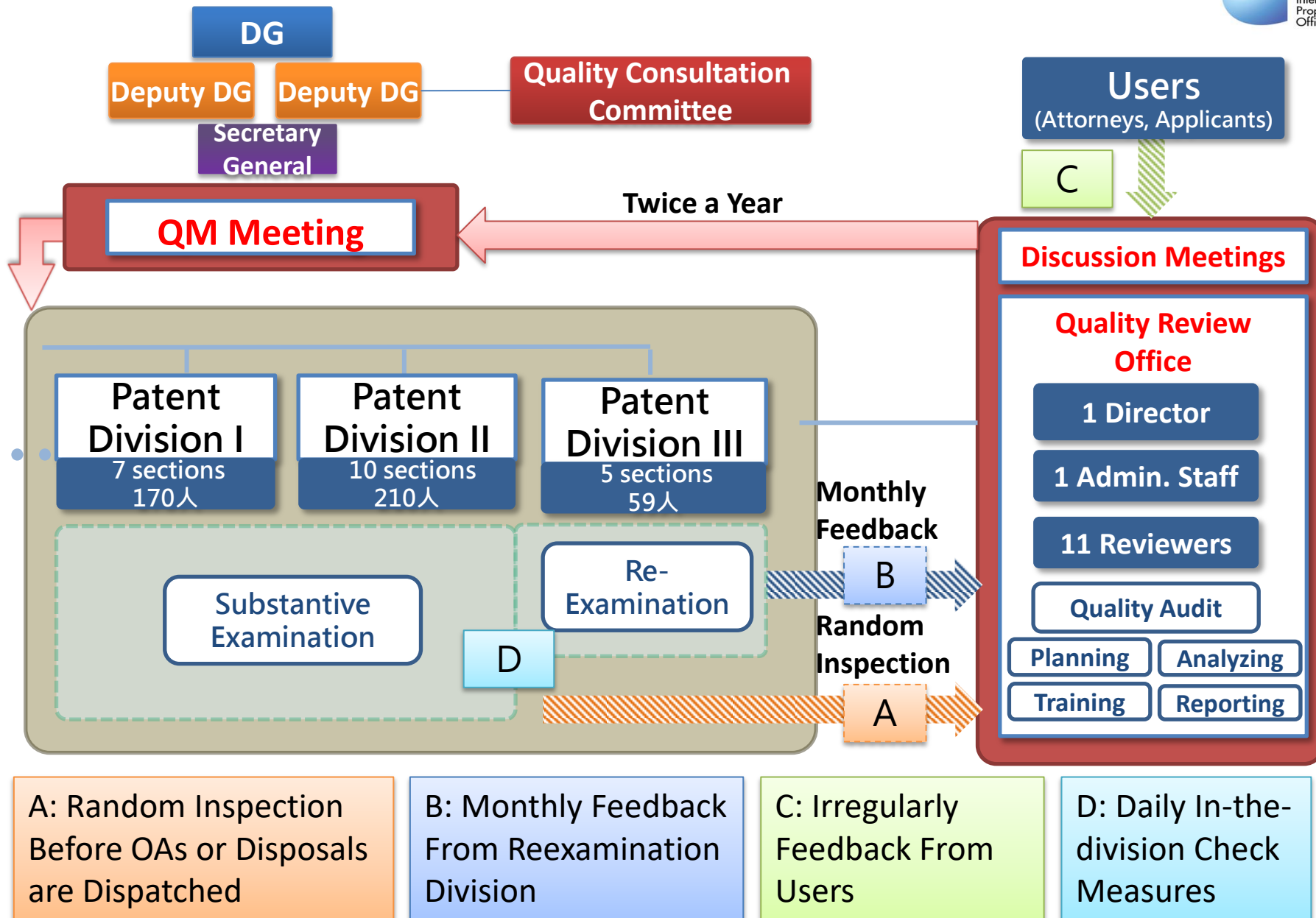
➤ **Revisions to the Examination Guidelines**

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

➤ **Improving Interview Practice**



1. Quality Management System 2.0



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 ☐ 查核 ☐ 2通以上 ☐ 最後通知

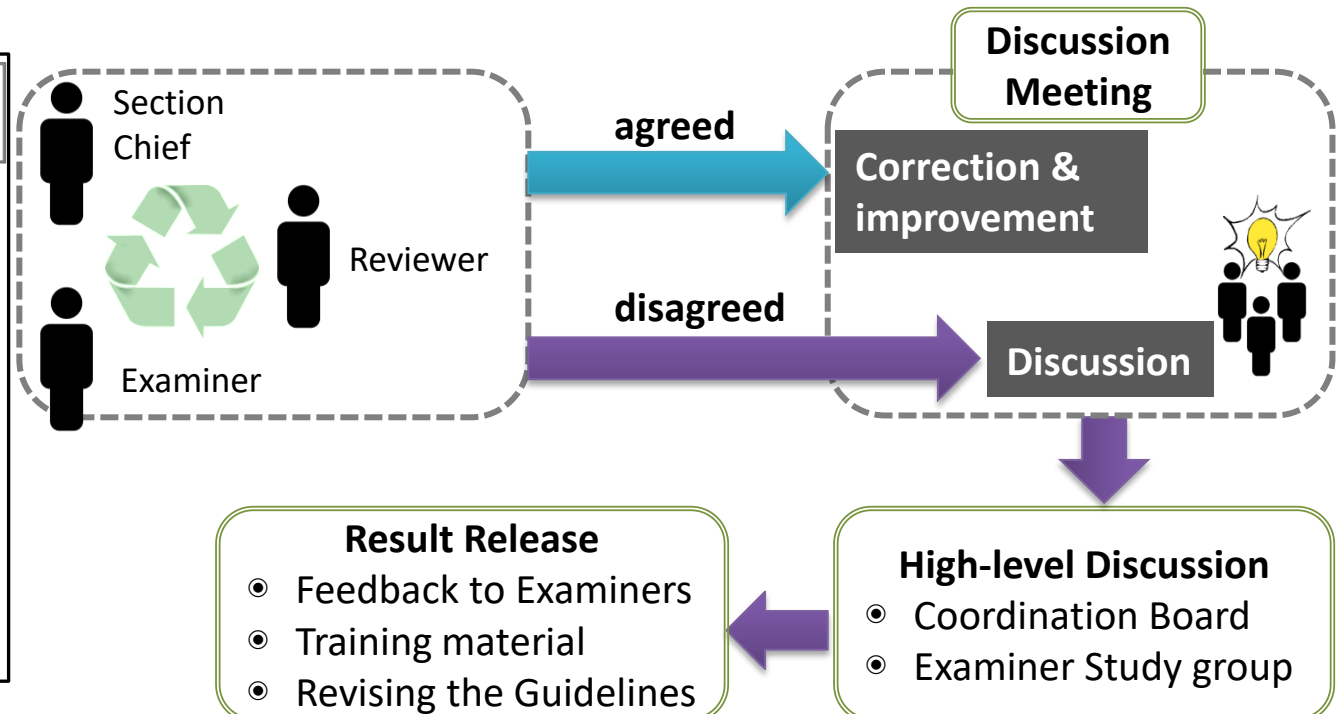
發明名稱： ☐ 核准 ☐ 延遲

承審人員： ☐ 內審 ☐ 外審 IPC 分類號： ☐ 核准 ☐ 延遲

☐ 研發替代役 ☐ TW-SEPA

內容輔助人力(若有) ☐ 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
<input type="checkbox"/>	違反記載要件		
<input type="checkbox"/>	820-1 <input type="checkbox"/> 820-2		
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<input type="checkbox"/>	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	
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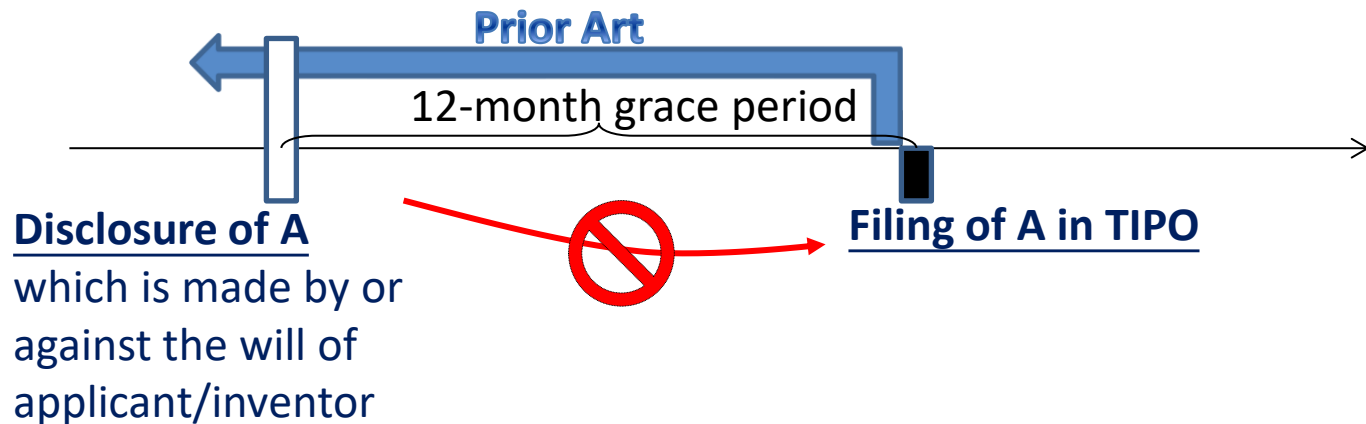


2. Grace Period-Guideline Revision



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

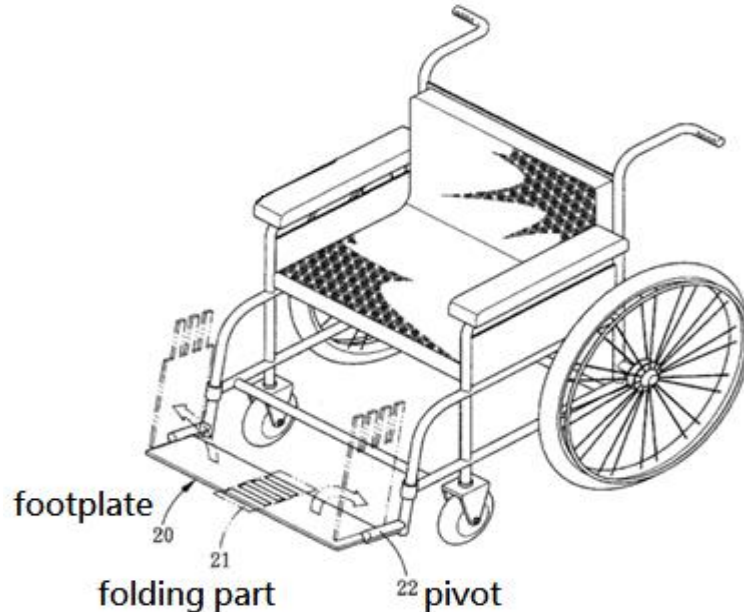
Factors for evaluating whether claimed invention has an inventive step

4. Post-grant Amendment- Guideline Revision

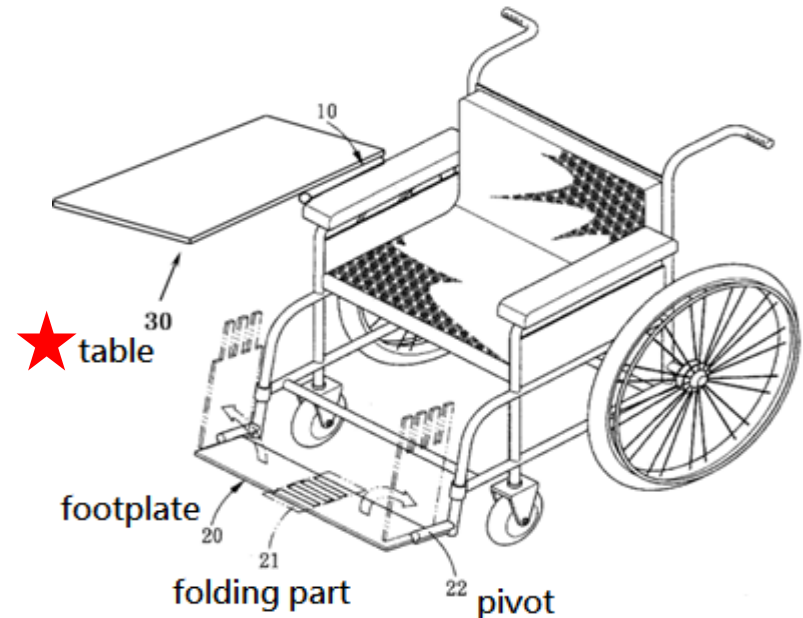
Key points

- 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 web page, 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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