



## IPR LEGAL REGIME

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3. Copyright Act



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To strengthen the intellectual property protection system, TIPO advanced amendments to the design patent regime in 2024 in response to developments in digital technologies. These efforts aim to enhance design patent protection and revise relevant subordinate regulations and examination guidelines for both patents and trademarks.

### 1. Patent Laws and Regulations

#### Draft Amendments to the Patent Act

To address the impact of digital technology and meet industry needs, TIPO has proposed amendments to the design patent system, taking into account judicial interpretations and practical considerations. The draft amendment to partial provisions of the Patent Act was announced on September 11, 2024, and a public hearing was held on November 4, 2024 to gather stakeholder feedback. Key proposed revisions include:

- (1) Expanded the scope of design patent protection to cover image-based designs created using digital technology.
- (2) Introduced an application system for filing several similar designs under a single application.
- (3) Extended the grace period for design patents from 6 months to 12 months.
- (4) Allowed divisional applications for design patents within three months after the original application or reexamination approval decision is delivered.

#### Operation Directions on Hearings for Patent Invalidation Cases

In order to align with legal drafting norms, the former “Program on Hearings for Patent Invalidation Cases” was renamed as the “Operation Directions on Hearings for Patent Invalidation Cases” on June 11, 2024. The revised document has also been harmonized with the “Operational Directions on Hearings for Trademark Dispute Cases” to ensure consistency in terminology and structure, thereby enhancing usability and accessibility for the public. Key revisions include strengthening the role of preparatory hearings, ensuring appropriate transparency in examiner reasoning, introducing video hearings to enhance accessibility, simplifying hearing records using technology, and clarifying the legal effect of absentee participation. These changes aim to better meet user needs while improving the quality, fairness and usability of the hearing process.

#### Operational Directions for Deferral of Substantive Examination of Invention and Design Patent Applications

In order to provide patent applicants with greater flexibility in managing invention and design patent portfolios, as well as support strategic patent deployment and commercialization, TIPO announced the Operational Directions for Deferral of Substantive Examination of Invention and Design Patent Applications on October 29, 2024. These directions will take effect on January 1, 2025. Key points include:

- (1) Consolidated the Operational Directions for Deferred Substantive Examination of Invention Patent Applications and the Operational Directions for Deferred Substantive Examination of Design Patent Applications into a single set of directions.
- (2) Relaxed the time limit for applying for deferred substantive examination in reexaminations, allowing applications before the first office action is issued.
- (3) Division applications are also eligible for deferred substantive examination.
- (4) Added provision that applications submitted for priority examination are not eligible for deferred substantive examination.

## Substantive Examination Guidelines for Invention Patents

In order to promptly respond to the practical needs of patent examination, ensure consistent interpretation, and enhance the quality of the examination process, TIPO revised the Patent Examination Guidelines, effective July 1, 2024. The revisions apply to Chapters 1, 3, 11, and 14 of Part II Substantive Examination for Invention Patents and Chapter 1 of Part V Examination of Invalidation. Key amendments are as follows:

- (1) Part II, Chapters 1 and 14: Revised in accordance with Article 17, Paragraph 7 of the Enforcement Rules of the Patent Act, with explicit clarification on the adoption of WIPO Standard ST.26.
- (2) Part II, Chapter 3: Added an example titled "Lack of Novelty Based on Legal Fiction," with specific criteria for assessment.
- (3) Part II, Chapter 11: Updated to reflect the amended name of the Ministry of Agriculture and the updated English name of the ICH organization.
- (4) Part V, Chapter 1:
  - (a) Introduced a clear definition of "interested parties," with a requirement for reasonable investigation and formal determination.
  - (b) Clarified examination principles for non-patent applicants in accordance with rulings from the Intellectual Property and Commercial Court.
  - (c) In accordance with Article 44 of the Intellectual Property Case Adjudication Act, the provision for TIPO to participate in litigation has been removed, and a mechanism for soliciting TIPO's opinion has been introduced. Revisions were also made to the section addressing the relationship between invalidation proceedings and patent infringement litigation.

## 2.Trademark Laws and Regulations

### Enforcement Rules of the Trademark Act

The Enforcement Rules of the Trademark Act was amended, promulgated and implemented on May 1, 2024. Key points of the revision include:

- (1) If the applicant is an unincorporated group or a business entity without a legal personhood, documents related to the establishment or registration shall be furnished.

- (2) Relevant provisions have been revised in accordance with Article 6 of the Trademark Act, which classifies agents into (a) professionals legally authorized to handle trademark matters and (b) trademark agents.
- (3) The format in which the trademark name is presented in the application must conform to the standards published by the Registrar Office.
- (4) Broken lines may be used in trademark reproductions to illustrate how the trademark is used - its placement, functionality, or contextual use – on the designated goods or services.
- (5) Clarifications were added regarding the required content of an accelerated examination request, the legal consequences of non-payment of fees, and the interpretation of the phrase "necessary to seek rights approval promptly" as stipulated in the Trademark Act.
- (6) Added provisions specifying the circumstances under which third-party opinions may be submitted in relation to a trademark registration application, including required content and how such opinions will be handled by the Registrar Office.

## Regulations Governing Trademark Agent Registration and Management

The Regulations Governing Trademark Agent Registration and Management was established, promulgated, and implemented on May 1, 2024. Key points include the commissioning of the Trademark Professional Capability Certification Examination and the eligibility criteria for entities entrusted to administer the examination; the qualifications and required documents for trademark agent registration; requisite on-the-job training hours, the method of calculating training hours, and how to handle cases where the minimum required hours are not met; management measures for trademark agents handling trademark-related matters; the items to be recorded and updated in the Trademark Agent Register; the circumstances under which a registered trademark agent may be reported for violations of laws and regulations; and the procedure for convening the Trademark Agent Incident Deliberation Committee.

## Fee-charging Standards of Trademark

The Fee-charging Standards of Trademark was revised, promulgated and implemented on May 1, 2024. The amendments include the addition of fee provisions for accelerated examination of trademark registration applications and for the registration or amendment of trademark agent records.

## Operational Procedures for Accelerated Examination of Trademark Registration Applications

The Operational Procedures for Accelerated Examination of Trademark Registration Applications was established, promulgated, and implemented on May 1, 2024. Key points include defining the types of cases eligible for accelerated examination, detailing the application and review procedures, and clarifying the expected timeframes for completing accelerated examinations.

## Operational Directions on Hearings for Trademark Dispute Cases

The Operational Directions on Hearings for Trademark Dispute Cases was revised, promulgated, and implemented on June 11, 2024. Key points of the amendment include clearly defining that at least three reviewers must be appointed as a panel to review trademark dispute cases in hearing procedures; holding preliminary hearings based on the complexity of the case; allowing the presiding official to moderately disclose legal reasoning; clarifying the effect of default hearings; introducing the use of video hearings; and simplifying the content of hearing records.

## Others

In response to the renaming of government agencies under the Executive Yuan following reorganization, TIPO amended four administrative directives accordingly, including the Examination Guidelines on Certification Marks, Collective Membership Marks and Collective Trademarks, Examination Guidelines on Retail Services, Examination Guidelines on Procedures of Trademark Dispute Cases, and Operational Directions on Submitting a Proposal for Invalidation of a Trademark Registration by Trademark Examiners.

## 3. Copyright Act

The Executive Yuan previously submitted the Draft Amendments to Certain Provisions of the Copyright Act to the Legislative Yuan for review on April 12, 2021. However, due to the 2024 legislative election, the draft was not carried over for further review. To strengthen the copyright legal framework and address the evolving needs of society and technological advancements, TIPO resumed the amendment process in 2024. As part of this effort, an Industry Consultation Meeting on the Copyright Act Amendment Issues was held on June 4, 2024, followed by a Consultation Meeting on the Resubmission of the Draft Amendments to Certain Provisions of the Copyright Act on October 7, 2024.