# Chapter 3 Patentability

# Chapter 3 Patentability

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According to the Patent Act, Article 46, Paragraph 1, when determining whether a patent right shall be granted on a patent application for invention, the following factors should be considered: definition of invention, industrial applicability, novelty, inventive step, lack of novelty based on legal fiction, statutory unpatentable subject matter, requirements for written description, first-to-file principle, the condition in which an applicant files a patent application for invention and a patent application for utility model for the same creation on the same day but fails to select one patent application within a specified time limit or the patent right for the utility model no longer exists before an approval decision on the patent application for invention is rendered, unity of invention, the condition in which a divisional patent application extends beyond the scope of content disclosed in its parent application as filed, the condition in which an amendment extends beyond the scope of the content as filed, the condition in which a Chinese translation text submitted extends beyond the scope of its original foreign text as filed, the condition in which the correction of translation errors in a Chinese version extends beyond the scope of content disclosed in the original foreign language documents as filed, and the condition in which a converted patent application for invention extends beyond the scope of content disclosed in its parent application as filed. Among the others, requirements for written description, definition of invention, and statutory unpatentable subject matter are explicated in Chapters 1 and 2 of Part 2. This chapter explicates industrial applicability, novelty, lack of novelty based on legal fiction, inventive step, and first-to-file principle. Explanations for the rest of requirements for patentability are given in Chapters 4 to 8 and 10 of Part 2.

## 1. Industrial Applicability

### 1.1 Introduction

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"An invention which is industrially applicable may be granted a patent upon application in accordance with this Act" means that an invention sought to be patented must be industrially applicable so that it complies with the requirements for patentability (i.e., the invention has so-called "industrial applicability"). "Industrial applicability" is a requirement relevant to the nature of an invention, and is determined without the need of conducting a

prior art search, therefore, industrial applicability shall in general be determined before the examination of novelty or of an inventive step.

### 1.2 Concepts of Industrial Applicability

The Patent Act stipulates that an invention sought to be patented must be industrially applicable; however, the Act does not expressly stipulate the definition of "industry." "Industry" in the Patent Act is commonly understood in its broad sense as including activities of technical characters, which use technical ideas utilizing the laws of nature in any field, such as manufacturing, agriculture, forestry, fishery, animal husbandry, mining, aquatic products industry, and even transportation, communications, commercial industry, etc.

A claimed invention shall be considered as susceptible of industrial application (industrially applicable) if it can be made or used in industry. The term "can be made or used" means that the technical means for resolving a problem can possibly be made or used in industry. It does not necessarily imply that the technical means must be actually made or used. Nevertheless, for an invention which is theoretically practicable but obviously practically cannot be made or used, such as a method for preventing an increase in ultraviolet rays associated with the destruction of the ozone layer by covering the whole earth's surface with an ultraviolet radiation-absorbing plastic film, it is not considered industrially applicable.

Determination of industrial applicability should be made based on the nature of an invention or the explication set forth in the descriptions as to how the invention is considered as susceptible of industrial application. If a claimed invention is determined as unable to be made or used, an office action should be issued to notify the applicant the reasons for rejection and requesting the applicant to submit a response. If the applicant fails to submit a response within a specified time period or the applicant's arguments are without merit, a decision of rejection would be issued accordingly.

### 1.3 Differences between Industrial Applicability and Enablement Requirements

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"Industrial applicability" refers to the requirement that a claimed invention shall be able to be made or used. "Enablement Requirements" refer that a description must enable a person ordinarily skilled in the art to

understand a claimed invention to make and use the invention without undue experiments (see Chapter 1, 1.3.1 "Enablement Requirements"). In the case, where a claimed invention is determined to be industrially applicable, it should be subsequently determined whether the invention disclosed in the description fulfills the enablement requirements. In the condition in which a claimed invention is determined to be industrially inapplicable, it is by no means that the invention is practicable. The order or level of determining the two requirements is different because the two requirements should be determined one after another or by a high or low level. Taking the aforementioned invention (i.e., a method for preventing an increase in ultraviolet rays associated with the destruction of the ozone layer by covering the whole earth's surface with an ultraviolet radiation-absorbing plastic film) as an example, the invention obviously cannot be made or used, so it is industrially inapplicable and does not fulfill the enablement requirements. Taking another invention (i.e., a sunglass capable of blocking 99% of ultraviolet radiation in sunshine) as an example, the invention can possibly be made or used so that it is industrially applicable. However, if a claimed invention does not be described how to make or how to use the invention in the description, it does not meet the enablement requirements.

## 2. Novelty

### 2.1 Introduction

The patent system is a system that encourages a patentee to disclose publicly their invention by granting them an exclusive right. There is no need to grant a patent right to an application for invention which has been published and then made available to the public prior to the filing date of the patent application, or disclosed in an earlier filed patent application. Hence, for a claimed invention which is disclosed in a printed publication, publicly exploited, or publicly known before its filing date(the former condition), no patent right shall be granted thereto. In addition, for a claimed invention which is identical to the contents disclosed in the description, claims, or drawings of an patent application for invention or for utility model filed before, but laid-open or published after, the filing date of the claimed invention(the latter condition), no patent right shall be granted thereto either.

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Although both of the aforementioned conditions belong to the criteria of novelty, the applicable circumstances and the concepts of these conditions are different. The applicable circumstances of the former are explicated in 2.2 to 2.5 of this Chapter, and the applicable circumstances of the latter are explicated in 2.6 of this Chapter.

## 2.2 Concept of Novelty

A claimed invention is considered to be novel if it does not form part of the prior art The term "prior art" in the Patent Act refers to any technical content which has been disclosed in printed publications, publicly exploited, or publicly known before the filing date of a patent application.

Novelty is one of requirements for a patent claim to be patentable. Determination on whether a claimed invention has novelty is normally made after its industrial applicability has been confirmed. If a claimed invention is determined lack of novelty, no patent right shall be granted thereto.

### 2.2.1 Prior Art

Prior art should include any information made available to the public prior to the filing date by means of a written description, via internet or in any other way. There are no restrictions whatever as to the geographical location where or the language or manner in which the relevant information was made available to the public. prior art The term "prior to the filing date" is to be interpreted as "before the date of filing a patent application with the date of filing being excluded." For a patent application which claims foreign or domestic priority, the term "prior to the filing date" is to be interpreted as "before the priority date with the priority date being excluded." In addition, the claimed priority date of each claim should be individually considered.

Rule 13.I

The prior art "available to the public" means that prior art have been published and the technical contents disclosed therein are already publicly available. It does not necessarily imply that the technical contents disclosed in the prior art have actually been acquired by the public. The technical contents known by a person with confidentiality obligations do not constitute part of prior art, because the public are not, but the person on whom obligation of secrecy imposed are available to acquire them, i.e. the technical contents have not become published. However, if a person with

confidentiality obligations breaches the obligations, rendering the technologies disclosed and making the technical contents available to the public, those technical contents constitute prior art. The term " confidentiality obligation" includes not only the obligation to keep secret arising from regulations regarding confidence in a contract but also a situation where the obligation to keep secret arises from social customs or commercial practices, that is, from implicit agreements or understandings. For example, an employee of a company would normally have an obligation to keep secret on affairs of the company. ◦

### 2.2.1.1 Disclosed in Printed Publications

#### 2.2.1.1.1 General Criteria

"Printed publications" in the context of the Patent Act means paper documents or other storage media carrying information which are released to the public by means of manuscript, photography, hardcopies, replications, internet transportation or in any other way. Printed publications of the above definitions include not only paper documents but also other storage media carrying information made by electronic, magnetic, or optical means, such as hard disk drives, floppy disks, tapes, compact disks, microfiches, integrated circuit chips, films, internet, online databases, and others. Accordingly, materials in a form of patent gazettes, technical journals/magazines, research reports, academic theses, textbooks, student's dissertations, conversation records, teaching guidelines, or speech draft are all printed publications in the context of the Patent Act. Rule 13.II

An invention which has been “disclosed in printed publications” refers to the technical contents of the invention have been publicly disclosed in a paper document or in other storage media carrying information and everyone can acquire them. It does not necessarily imply that the contents have actually been read or acquired by the public. For example, cases where books, magazines, or academic theses are shelved or indexed in a library, fulfill the above definition. However, if there exists a solid evidence showing that the paper document or other storage media carrying information are not yet available to the public, for example, the condition in which manuscripts of technical journals/magazines and their printed products with publication date only accessible to specific people, technical contents therein should not be determined to be publicly disclosed. Furthermore, Act 22. I (1)

paper documents with the words "Internal Materials" or "Confidential Documents" or other similar wording should not be regarded as disclosed in a printed publication unless there is solid evidence showing that these documents have been published to the public.

#### 2.2.1.1.2 Determination of Publication Date

When determining the publication date, if the examiner finds evidence supporting a given date, the date should be determined as the publication date. If the examiner cannot find any evidence as a support, the publication date should be presumed according to the following rules:

(1) Where an issue date is indicated in the publication:

a. where only an issuing year is indicated: the last day of the year should be presumed as the publication date;
b. where issuing month and year are indicated: the last day of the month of the year should be presumed as the publication date;
c. where issuing day, month, and year are indicated: the day of the month of the year should be presumed as the publication date;
d. where multiple issuing years are indicated: the last day of the first year should be presumed as the publication date;
e. where multiple issuing months and years are indicated: the last day of the month of the first year should be presumed as the publication date;
f. where multiple issuing days, months, and years are indicated: the day of the month of the first year should be presumed as the publication date; and
g. where the publication is issued per season: the last day of the season determined by the area of issuance should be presumed as the publication date.

(2) Where no issue date is indicated in the publication:

a. where the import date of a foreign publication is known: the date starting from the import date traced back to the usual transport date from the importing country to R.O.C. should be presumed as the publication date;
b. where there is a related publication which includes book review, abstract, or catalogs of the publication recorded in other publications:

the issue date of the book review, the abstract, or the catalogs of the other publications should be presumed as the publication date.

(3) Where a reprinted publication indicates the issue dates of the initially printed publication and the reprinted publication: the issue date of the initially printed publication should be presumed as the publication date。

#### 2.2.1.1.3 Information on the Internet

##### 2.2.1.1.3.1 Principles of Determination

"Information on the internet" refers to the information which is carried on the internet or in online databases. Determination of whether such information has been "disclosed in printed publications" in the context of the Patent Act should be based on whether the public is aware of the webpage and the URL thereof to acquire the information, regardless of whether the public has actually accessed the website, and whether it is charged or requires a password to access the website. As long as the website does not have any special restrictions on its users and thus the public can access the website through registration, information thereon can be considered to be available to the public. On the contrary, if the information on the internet is secret information which can only be acquired by the members of certain parties or enterprises via intranet, or the information is encoded so that it is impossible to obtain via decryption tool using general manners (e.g., through payment or without charge), or the information on a non-officially published website is only accessible by chance, the information should be determined as not being available to the public.

When determining novelty of an application for invention, the cited documents fulfilling the definition of "prior art" must being open to the public before the application filed. Therefore in principle, if the information on internet is to be cited as prior art, the publication date of the information shall be specified. If no publication date of the information is specified, the authenticity of the date of publication is questionable or an applicant has shown that a given date is unreliable, the examiner should provide certified documents or other substantive evidence from the website which is in charge of publication or maintenance of the information to prove the publication date of the information. Otherwise, the information cannot be cited as prior art.

Examples of the aforementioned "other substantive evidence" include:

(1)Information relating to a web page available from an internet archiving service, for example, Wayback Machine(www.archive.org).
(2)Timestamp information relating to the history of modifications applied to a web page or a file , for example, the edition history of Wikipedia.
(3)Computer-generated timestamp information as available from file directories or other repositories, or as automatically appended to content, for example, the time of publication of articles in blog or forum messages.
(4)Indexing date given to the web page by searching engines, for example, from the Google cache.

The nature of information on the internet which, quite different from paper documents, is published in an electronic format may be more involved to establish their publication date, and their reliability may vary. However, considering the huge amounts and variety of the information on the internet, the chance of the situation should be minor. Unless evidence to the contrary is provided, the date of publication on the internet should be presumed as the actual publication date. In case where the contents of the information has been altered, if the contents of the change and the corresponding point in time can be ensured, the time of the change should be regarded as the date of publication. Otherwise, the latest time of change should be regarded as the date of publication. ◦

**2.2.1.1.3.2 Citation Format**

Because information on the internet can be easily changed, when citing such information, examiners should print out the contents of the prior art according to the format of the web page and mark the acquisition date, address of the website, and application number of the examined patent application on the hardcopy, to prevent the contents of the prior art from being subsequently deleted or altered by website administrators. In addition, examiners should describe the relevant information of the prior art in a notification or a decision as much as possible according to the following sequence: the author of the prior art, the title of the prior art, the date of publication, the name of the website, the location of the technical contents in online databases or file directories on the internet, and the address of the website.

### 2.2.1.1.3.3 Notes for Examination

The information on internet to be cited should have a specific publication date, for example, an electronic paper with publication date. If no publication date of the information is specified, examiners should provide certified documents or other substantive evidence from the website which is in charge of publication or maintenance of the information to prove the publication date of the information. Otherwise, the information cannot be used as prior art

In cases where the examiner has described the essential information of the cited document according to the manner in "2.2.1.1.3.2 Citation Format" in the office action and provided a copy of the cited document but the applicant simply doubts the authenticity of the date of publication and that of the contents of the information in the response without providing any objective evidence as support, the examiner may then issue a decision of rejection accordingly.

In the cases where paper documents describe identical contents as those available from internet and both of the information on the internet and the paper documents are qualified to be used as citations, paper documents should be used in advance.

### 2.2.1.2 Publicly Exploited

"Exploiting" in the context of the Patent Act means the acts of making, offering for sale, selling, using, or importing that product for the aforementioned purposes. Act 58

An invention which has been "publicly exploited" refers that technical contents of the invention via the aforementioned acts have been publicly disclosed and become available to the public. It does not necessarily imply that the technical contents must be actually exploited by or known to the public. For example, if structures of an article or steps of an exploited method can be understood by the public during a factory visit, an invention publicly exploited can be established. However, cases where the person of ordinary skilled in the art cannot understand, via the aforementioned acts, without being given explanation or making experiments, the technical features of an article invention (structures, elements, or the components, etc.) or those of a method invention (parameters, steps, etc.), do not be regarded as publicly exploited. Taking an article which is characterized by its inside Act 22. I (2)

structure as an example, since the public can only observe the appearance of the article and would by no means realize the technology of making the article even if it were publicly displayed, does not constitute a disclosure by public use.

The date on which the technical contents are available to the public shall be regarded as the date of public exploit.

### 2.2.1.3 Publicly Known

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An ”publicly known” invention refers to the technical contents of a invention have been disclosed to be in the state available to the public in ways of oral description or demonstrating such as oral conversation, speech, conference, broadcasting, televising , or publicly displaying figures, photographs, models or samples and so on. It does not necessarily imply that the technical contents must be actually known, read, or obtained by the public.

The date on which the technical contents are available to the public in ways of oral speaking or demonstrating shall be regarded as the date of being publicly known, for example, the date of upholding the actions such as talking, speech, or conference, the date that the public receives the broadcasting or televising, and the date of public demonstration.

### 2.2.2 Citations

When conducting a substantive examination, all the relevant documents obtained by conducting a search from prior art or prior applications should be compared with the claimed invention to determine whether the claimed invention meets the requirements for patentability. The relevant documents when cited are referred to as "citations."

Although everything available to the public prior to the filing date constitutes prior art, according to practice, the prior art disclosed in printed publications is the most commonly cited as a citation. Once a patent application has been laid-open or published, it constitutes part of prior art. Even if the patent application has been withdrawn or rejected, or if the patent granted afterwards has been abandoned or revoked, the laid-open or published description, claims, and drawings all constitute the aforementioned printed publications and can be cited.

The publication date of a printed publication, publicly exploiting date, or the date on which an invention was publicly known should predate the filing date of the invention patent application. Even if a document cited to support technical contents being publicly exploited or being publicly known is published later than the filing date, the technical contents shall be considered to constitute part of prior art as of the date on which they were publicly exploited or publicly known. If the applicant only questions the aauthenticity of the document without providing any objective evidence as support, the document can still be cited.

When a citation is cited to judge novelty of an invention, the technical contents disclosed in the citation shall be based upon. Said technical contents include both those which have been formally and explicitly stated and those substantially implied but not formally stated therein. The term "substantially implied" refers to the contents that a person ordinarily skilled in the art can directly and unambiguously derived from the citation on the basis of common general knowledge as the citation published. (Common general knowledge at the time of filing for determining inventive step is explicated in 3.2.4 "Prior Art" of this Chapter.)

The disclosure of a citation must be such that a person ordinarily skilled in the art can reproduce and use the claimed invention. For example, where a claimed invention is a compound, if a citation only discloses the existence of the compound or simply provides the name or chemical formula of the compound without indicating how to prepare and use the compound, and a person ordinarily skilled in the art can by no means deduce preparation or isolation of the compound in light of the teachings of the citation or common general knowledge on the publication date of the citation, the compound as claimed cannot be rejected for lacking novelty based on the citation.

When a citation includes a drawing, if the drawing is merely a schematic diagram without any literal description, only the technical contents which have been clearly disclosed in the drawing can be deemed as being disclosed by the drawing. If the angle, proportional relationship or corresponding position of each element in the drawing is not changed by scaling up or down in photocopying, the drawing can be used as reference. If the contents derived from a drawing, such as a size or thickness measured

therefrom, will change when scaling up or down in photocopying, it is not able to be cited directly.

## 2.3 Principles of Examination of Novelty

### 2.3.1 Examination on Each Claim

When determining novelty, the invention of each claim should be examined individually and an opinion of each claim should be individually provided in the internal examination form. If a claim is drafted in an alternative format, the novelty of the invention directed to each alternation should be individually examined. If an independent claim is deemed novel, its dependent claim(s) has/have commensurate novelty, and such examination results can be addressed together in the internal examination form. If an independent claim is deemed to lack novelty, the lack does not automatically deprive claim(s) depending therefrom of their respective novelty, so an examination opinion for each claim should be individually provided in the written opinion.

### 2.3.2 Separate Comparison

When determining novelty, each claim of the application shall be compared separately with the relevant technical contents disclosed in each item of the prior art, rather than with a combination of the contents disclosed in several items of the prior art, or with a combination of the technical contents disclosed in a citation and the prior art disclosed in other forms (such as publicly exploited prior art or publicly known prior art).

When a reference document is explicitly mentioned to more clearly illustrate technical features disclosed in the citation, and the reference document is readily available to the public prior to the publication date of the citation, the disclosure of the reference document is considered part of the disclosure of the citation. In such a case, the publication date of the reference document will be deemed the same as that of the citation.

The matter explicitly disclaimed or the prior art explicitly disclosed in a citation is considered part of the citation.

Reference documents (such as dictionaries, textbooks, or reference books) which are available to the public prior to the publication date of a

citation for explaining the term(s) used in the citation can also be considered part of the citation.

## 2.4 Criteria for Determination of Novelty

When determining novelty, the invention as claimed is the object to be examined. The examiner shall compare all the technical features of the invention individually with the technologies disclosed in the citation, and may refer to the description, claims, and drawings of a patent application and take into consideration common general knowledge at the time of filing in order to understand the invention concerned.

A claimed invention lacks novelty if a comparison between the claimed invention and the technologies disclosed in the citation meets any of the following criteria:

(1) Where the claimed invention and the technical contents disclosed in a citation are totally identical.

There is no formal and substantial difference between the claimed invention and the prior art

(2) Where the difference only lies in the literal descriptions or in the technical features which can be directly or unambiguously deduced.

A claimed invention differs from the prior art only in the literal descriptions but they are substantially identical, or only in part of the technical features which, corresponding to the difference between the claimed invention and the prior and substantially solely implied or collectively implied in the prior, a person ordinarily skilled in the art can directly and unambiguously derive from the formally and explicitly disclosure of the prior art.

If the technical features of the prior art include multiple meanings, to only one of which the claimed invention is limited, the technical features of the invention cannot be deemed directly and unambiguously deduced. For example, in a situation where technical means disclosed in the prior art include a technical feature "elastomer" without providing any embodiment relating to "rubber" and the corresponding technical feature recited in the claimed invention is "rubber," since "elastomer" may include means such as "rubber" and "spring," it cannot be considered that the "rubber" of the invention can be directly and unambiguously deduced from the "elastomer" of the prior art.

(3) Where the difference of the corresponding technical features resides in the generic concepts and specific concepts

The term "generic concept" means a comprehensive concept consisting of the technical features belonging to the same family or type, or integrating a plurality of technical features sharing a common nature. If an invention is characterized by a technical feature comprising a generic concept, the invention is referred to as an invention of generic concept. The term "specific concept" is opposite to the term "generic concept" and represents a low-level, concrete concept. If an invention is characterized by a technical feature comprising a specific concept, the invention is referred to as an invention of specific concept.

If the prior art is an invention of specific concept, it means that the contents of the prior art have implied or suggested that the technical features disclosed therein are applicable to the invention of generic concept concerned. Therefore, a specific disclosure deprives generic claim embracing that disclosure of novelty. For example, a prior art disclosing "substance A made of copper" take away the novelty of an invention of a patent application directed to "substance A made of metal".

The publication of an invention of generic concept does not affect the novelty of any invention of specific concept. For example, prior art directed to "substance A made of metal" cannot invalidate the novelty of a claimed invention "substance A made of copper". In addition, a disclosure of halogen does not take away the novelty of chlorine. Furthermore, a compound disclosed in prior art does not take away the novelty of the claim invention directed to the optical isomers, hydrates or crystals of said compound.

## 2.5 Novelty of Specific Types of Claims and Selection Invention

### 2.5.1 Product-by-Process Claims

For a product-by-process claim, the invention to be patented should be the product *per se* whose properties are given by the process stated in the claim. In other words, whether a product-by-process claim has novelty or inventive step should not be determined based on the preparation process but rather the product *per se*. If the product specified in such type of claim is the identical with that disclosed in the prior art, or if they are different but the

claimed product belongs to that which can be easily accomplished based on the prior art, even if the product disclosed in the prior art is prepared by a different process, the claimed product should not be granted a patent. For example, where a claimed invention is directed to a protein prepared by process P (steps P1, P2, ... and Pn), if the name of protein Z prepared by process Q (which differs from process P) is identical with that of the protein as claimed, the properties of protein Z are the same as those of the protein prepared by process P, and protein Z has been disclosed in the prior art, , the claimed protein lacks novelty regardless of whether or not the process P has been known to the public at the time of filing.

### 2.5.2 Product Specified by Use

If there is an expression specifying the product by use in a claim, the product to be protected should be interpreted as suitable for the use specified. However, the actual limitation of the special use depends on whether the special use influences the product to be protected. In other words, it depends on whether the use implies that the claimed product has a certain specific structure and/or component which is (are) particularly suitable for the use. For example, if a claim refers to a "mold for molten steel" , a plastic ice cube tray disclosed in the prior art would not deprive the claim of novelty for that the use of molten steel renders the mold having structures and/or components to produce the properties for high melting point. In a further example, a claim is directed to "a crane hook." The use of crane implies that the hook has a structure with a specific size and intensity, and thus provides a limitation to the subject matter "hook." Although a fishing hook disclosed in the prior art has a similar shape, it would not come within the claims and not deprive the claim of novelty. In a further example, where a claim is directed to "a Fe based alloy for a piano string," the use "for a piano string" implies that the Fe based alloy has a lamellar microstructure supporting high tension, and thus provides a limitation to the subject matter." Therefore, a Fe based alloy without a lamellar microstructure disclosed in the prior art would not come within the claim and not deprive the claim of novelty.

If the use of a product specified in a claim merely describes the purpose of or the way to use the product, and fails to imply that the product would have a certain structure and/or component, the use does not furnish

any effect for determining whether or not the claim involves novelty or an inventive step. The following three conditions are provided:

(1) Compounds

The disclosure of compound X for use as a dye in the prior art takes away the novelty of the claimed invention directed to "compound X for use as a catalyst" for that those chemical structures determining the attributes of the compounds are identical, even if their stated uses are different.

(2) Compositions

The disclosure of an insecticidal composition comprising A + B in the prior art takes away the novelty of the claimed invention directed to "a cleaning composition comprising A + B" for that their components determining the attributes are identical. The disclosure of a composition for treating influenza comprising A + B in the prior art takes away the novelty of the claimed invention directed to " a composition for treating cardiac diseases comprising A + B" for that those components determining the attributes are identical.

(3) Articles

The disclosure of a U-shaped lock for a motorcycle in the prior art takes away the novelty of the claimed invention directed to " a U-shaped lock for a bicycle" for that structures *per se* of them are identical, even if their stated uses are different.

### 2.5.3 Use Claims

The patentability of a use claim rests upon discovering an unknown property of a product and upon finding out according to the purpose of usage that the product is suitable for a specific use which was unknown. Therefore, use claims are usually applied only to the technical fields where it is relatively difficult to know how to use the product only based on the structure or the name of the product, such as the technical field of using a chemical substance. As for inventions relating to articles such as a machine, equipment, and a device, since the article and its use are inseparably connected with each other in general, the use claims thereof usually lack novelty.

### 2.5.4 Selection Inventions

Selection inventions deal with the selection of individual elements, sub-sets, or sub-ranges, which have not been explicitly mentioned, within a larger set or range known in the prior art Selection inventions are often applied in the technical fields of chemicals and materials. (See Chapter 13, 5.2.1.2 "Selection Inventions of Compounds.") In determining the novelty of a selection invention, the examiner has to first decide whether the selected individual elements, sub-sets, or sub-ranges are specifically disclosed in the whole content of the prior art.

#### 2.5.4.1 Selection of Individual Elements or Sub-Sets

If all the selectable elements disclosed in the technical content of the prior art are addressed in a single set, a selection invention consisting of any one of the elements selected therefrom does not confer novelty. Where all the selectable elements disclosed in the technical content of the prior art are addressed in two or more sets, if a selection invention consists of the elements respectively selected from the different sets so that the combination constitutes combining elements from different sets, and if such a combination is not specifically disclosed in the prior art, the selection invention is deemed to be novel. The aforementioned selection consisting of two or more sets usually has the following conditions:

(1) A known chemical general formula has two or more substituent sets. The compound as claimed consists of the specific substituents, which are respectively selected from the different sets. The principles are also applicable when determining the patentability of a compound consisting of the specific substituents, which are selected from the different sets respectively disclosed in different prior arts.
(2) In an invention directed to a manufacturing process, the specific starting materials used are respectively selected from the different starting-material sets disclosed in the prior art
(3) The specific parameter sub-ranges are selected from many different parameter ranges known in the prior art

As for the selection inventions consisting of sub-sets, the principles for determining their novelty are the same as those described in this section.

### 2.5.4.2 Selection of Sub-Ranges

If a selection invention is directed to a narrow range selected from a broader numerical range of the prior art, the selection invention is generally deemed to have novelty with the exception of when the prior art has disclosed the value(s) within the selected sub-range. Some examples follow.

(1) The prior art discloses that the amount of a component ranges from 5 wt.% to 25 wt.%. If the amount corresponding to the prior component in a claimed invention ranges from 10 wt.% to 15 wt.%, the claimed invention would be considered novel.
(2) In the above example, if the prior art has disclosed that the amount of the component can be 12 wt.%, the claimed invention would not be considered novel.

As to overlapping ranges or numerical ranges of physical parameters, novelty is destroyed by an explicitly mentioned end-point in such as an embodiment of the prior art, explicitly mentioned intermediate values of the prior art in the overlap. For example, where the prior art discloses a process for preparing alumina ceramic, in which the firing time is 3 to 10 hours; and the firing time corresponding to the prior in a claimed invention as is 5 to 12 hours the novelty of the claimed invention is destroyed by explicitly mentioned end-point (10 hours)disclosed in the prior art.

## 2.6 Lack of Novelty Based on Legal Fiction

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The patent system is provided to grant an exclusive right to the patentee as to encourage the patentee to publish their invention and make the invention used by the public. As for the contents disclosed in the description or drawings of a patent application but do not belong to the claimed invention, there is no need to grant others a patent right because the applicant of a patent application has made them published and free to be used by the public. Therefore, if a claimed invention in an invention patent application with a later filing date (hereinafter referred to as "later application" in this section) is identical with the content disclosed in the specification, claims or drawings of an invention or utility model patent application with a filing date earlier than the later application but with a laid-open or publication date later than the filing date of the later application (hereinafter referred to as "earlier application" in this section), even though

the claimed invention in the later application does not have the conditions for losing novelty, the invention claimed in the later application is deemed to lack novelty based on legal fiction, and thus cannot be granted an invention patent. The conditions and concepts for determining novelty and those for determining lack of novelty based on legal fiction are different. In addition, it should be noted that both the above-mentioned applications were filed in the R.O.C.

### 2.6.1 Concept of Lack of Novelty based on Legal Fiction

Prior art includes all the information available to the public before the filing of a patent application. Normally, an earlier-filed application for invention or utility model which is filed prior to but laid-open or published after the filing date of a later-filed application should not constitute prior art. However, according to the stipulations of the Patent Act, contents disclosed in the description, claims or drawings of an earlier-filed application for invention or utility model still belong to the prior art for the purpose of determining novelty. Therefore, if the claimed invention of a later-filed application is the same as the technical contents disclosed in the description claims or drawings of an earlier-filed application, the later-filed application should be deemed lacking novelty based on legal fiction. Act 22. I

Lack of novelty based on legal fiction is a special regulation of the Patent Act. Since such prior art is not laid-open or published prior to the filing date of the later-filed application, it is not applicable to the examination of the inventive step. Act 22.II

### 2.6.2 Citations

When determining whether a later-filed patent application lacks novelty based on legal fiction, the citation must be a patent application for invention or utility model, filed prior to but laid-open or published after the filing date of the later-filed application. Criteria for determining whether an earlier-filed application is qualified as a citation include the following:

(1) The content of the earlier-filed application includes the description, claims and drawings essential to obtaining the filing date, as well as an additional reference which is clearly described therein, items which are clearly disclaimed therein, and relevant prior art explicitly described therein (see "2.3.2 Independent Comparison" of this Chapter), but does not include the priority document(s) claimed.

(2) The filing date of the earlier-filed application must be earlier than the filing date of the later-filed application, and the earlier-filed application must be laid-open or published after the filing of the later-filed application. If the earlier-filed application has not been laid-open or published at the time of the examination proceeding, it cannot be used as a citation.

Rule 13. I

(3) If the earlier-filed application cited is a conversion application or a divisional application, the point in time to determine which one was filed earlier resides in the filing date of the original application of the earlier-filed application.

(4) In case where the earlier-filed application claims an foreign priority claim or a domestic priority claim, and where the invention or utility model has been disclosed in the description, claims or drawings of both the priority basis document and the earlier-filed application, the point in time to determine which was filed earlier resides on the priority date of the earlier-filed application. In case where the invention or utility model is disclosed only in the description, claims or drawings of the earlier-filed application but not in the priority basis document, the point in time to determine which was filed earlier resides in the filing date of the earlier-filed application.

Act 30. II

(5) In the case where the earlier-filed application is claimed as domestic priority, the application is not qualified to be a citation because it will be deemed withdrawn upon an expiry of 15 months after its filing date and not be laid-open or published.

(6) As long as the earlier-filed application has been laid-open or published, it constitutes part of prior art and eligible to be a citation. Even if the earlier application is withdrawn or rejected thereafter, or is abandoned or dismissed thereafter, said application can still be used as a citation. However, if the earlier-filed application has been withdrawn before being laid-open but is still laid-open due to having entered the laid-open process, the earlier-filed application cannot be used as a citation.

(7) If the invention or utility model disclosed in the description, claims or drawings of the earlier-filed application has been laid-open or published, even if a part of the content thereof is deleted due to an amendment or correction made thereafter, the deleted part is eligible to be used as a citation.

(8) If the invention disclosed in the description, claims or drawings of the earlier-filed application is unclear or insufficient to allow a person

ordinarily skilled in the tart of the later-filed application to manufacture and use the claimed invention of the later-filed application, the earlier-filed application cannot be used as a citation.

(9) The earlier-filed application must be an invention or utility model application, but cannot be a design application. Since both invention and utility model belong to the creation of technical idea utilizing the laws of nature, there is no need to grant two patent rights on the same creations respectively. However, said two applications and a design application, a creation based on visual appeal, are different. Therefore, when determining whether a later invention patent application lacks novelty based on legal fiction, only an earlier-filed application for invention or utility model can be used as a citation.

### 2.6.3 Principles of Examination of Lack of Novelty based on Legal Fiction

When determining whether a later-filed application lacks novelty based on legal fiction, each claims of the later-filed application should be individually compared with the technical content disclosed in the description, claims or drawings of the earlier-filed application. The examination opinion for each claim should be individually provided in the written opinion.

"2.3 Principles of Examination of Novelty" of this Chapter applies *mutatis mutandis* to "Examination on Each Claim" and "Independent Comparison" in the determination of lack of novelty based on legal fiction.

### 2.6.4 Criteria for Determination of Lack of Novelty based on Legal Fiction

Not only can the criteria be as following:(1) "totally identical," (2) "the difference only lies in the literal descriptions or in the technical features which can be directly or unambiguously deduced," and (3) "the difference resides in the generic and specific concepts of the corresponding technical features" of "2.4 Criteria for Determination of Novelty" of this Chapter, but also in criterion (4) "the difference lies only in the technical features which can be directly substituted based on common general knowledge" which can be used to apply to the determination of "identical content" in lacking novelty based on legal fiction.

The aforementioned criterion (4) means that a claimed invention differs from the prior art only in some technical features, but a person ordinarily skilled in the art can directly make a replacement of the different technical features on the basis of common general knowledge. For example, if prior art discloses a screw as a fastening element and the screw has only "tightening" and "loosening" functions according to the technical means disclosed in the prior art, because a bolt also has said dual functions, if an invention of a patent application only replaces the screw in the prior art with a bolt, such a replacement should be deemed a direct replacement deducible from common general knowledge.

During examination, in order to understand a claimed invention, the description, claims and drawings of the later-filed application and the common general knowledge known at the time of filing may be deliberated.

**Example 1**

[Claim]

A chip package structure, at least comprising:

a metal substrate;

a chip, having an active surface and a corresponding back surface; and

a laminated circuit layer, disposed on the metal substrate and the chip.

[The citation]

A chip package structure, at least comprising:

a ceramic substrate;

a chip, having an active surface and a corresponding back surface; and

a laminated circuit layer, disposed on the ceramic substrate and the chip.

[Remarks]

The citation is an earlier-filed patent application for invention laid-open or published after the filing of the claimed invention. The difference between the disclosed contents of the citation and the claimed invention lies in the material of the substrate. The citation has disclosed that the ceramic substrate has the function of carrying the chip, and it is common general knowledge in the technical field that a

metal substrate has the function of carrying a chip. Therefore, if the claimed invention merely replaces the ceramic substrate of the citation with a metal substrate, it should be deemed a direct replacement based on common general knowledge.

### 2.6.5 Applicant

Act 31. I

If an applicant files an earlier-filed application and then a later-filed application, and the invention set forth in the claims of the later-filed application is identical with the content disclosed in the description or drawings of the earlier-filed application but is not disclosed in the claims of the earlier-filed application, it satisfies the condition in which the same applicant seeks protection of different inventions or utility models in separate applications, such that no double patenting issue may exist. Thus, the later-filed application can still be granted a patent. On the other hand, if the invention set forth in the claims of the later-filed application has identical contents as those set forth in the claims of the earlier-filed application, it satisfies the condition in which a double patenting issue is involved, regardless of whether the two applications were filed by the same applicant. In such case, only the earlier-filed application can be granted a patent. (See "5.6.1 Filed on Different Days" of this Chapter.)

Lacking novelty based on legal fiction applies only to the condition in which an earlier-filed application and a later-filed application are filed by different applicants at different filing dates where the invention set forth in the claims of the later-filed application has identical contents with those disclosed in the description, claims or drawings of the earlier-filed application. Whether the applicant of the earlier-filed application and that of the later-filed application are the same ones should be determined based on the following rules:

(1) The determination time should be the filing date (i.e., the date on which the application form, description, claims and the necessary drawing(s) are provided in full in R.O.C.) of the later-filed application. In other words, the timing to determine whether the applicant of the earlier-filed application and that of the later-filed application are the same should be at the filing date of the later-filed application. If the applicants of the two applications are determined to be the same at that time, even if any

one of which becomes inconsistent thereafter in view of name change, inheritance, or mergence, the original determination should still be valid.

(2) If both of the applications are filed by joint owners, the applicants are deemed to the same only when all the joint owners of both applications are the same.

(3) If the later-filed application is a conversion application or a divisional application, the determination time should be the filing date of the parent application of the later-filed application. Act 25. Ⅱ

## 3. Inventive Step

### 3.1 Introduction

The patent system is provided to grant an exclusive right to the patentee to encourage the patentee to publish their invention for public use. If an invention does not make any contribution over the prior art, there is no need to grant a patent thereto. Therefore, if a claimed invention can be easily accomplished by a person ordinarily skilled in the art based on prior art, it cannot be granted a patent. Act 22. Ⅱ

### 3.2 Concept of Inventive Step

Although a claimed invention differs from prior art, the invention is deemed lacking an inventive step if the invention, considered as a whole, can be easily accomplished by a person ordinarily skilled in the art based on prior art

Inventive step is one of the requirements for obtaining an invention patent. The determination as to whether a claimed invention involves an inventive step shall be made only if the invention is novel (including exhibiting no conditions of lacking novelty based on legal fiction). If an invention is deemed lacking in novelty, there is no need to examine its inventive step.

#### 3.2.1 Person Ordinarily Skilled in the Art

A person ordinarily skilled in the art refers to a hypothetical person who is possessed of general knowledge and ordinary skill of the technical field to which the invention pertains at the time of filing, and is able to understand and utilize technologies known at the time of filing. "Time of

Rule 14. Ⅰ

Rule 14. Ⅱ

filing" means the filing date. If an application claims an foreign priority or a domestic priority, "time of filing" means the priority date. If the problem to be solved can impel a person ordinarily skilled in the art to seek technical means for solving the problem from other technical field, said person should also be presumed to have common general knowledge in the other technical field.

"General knowledge" includes well-known knowledge as disclosed in reference books or textbooks, and also includes information commonly used and items which can be understood from "rules of thumb." "Ordinary skill" means the ordinary ability to perform routine works and experiments. "General knowledge" together with "ordinary skill" refers to "common general knowledge."

Generally, the term "a person ordinarily skilled in the art" is a legal fiction of an individual person. However, if it is more appropriate to fictionalize this as a group of people after considering the concrete facts of the technical field to which the invention pertains, it may also be fictionalized as a group of people.

### 3.2.2 Prior Art

Act 22. I

Act 23

In determining inventive step, prior art qualified refers that the prior art which has been disclosed in printed publications, been publicly exploited, or been publicly known before the filing date (see "2.2.1 Prior Art" of this Chapter). Said prior art does not include techniques which are laid-open or published on or after the date of filing, or an earlier-filed patent application for invention or utility model filed earlier but laid-open or published later than the date of filing.

The prior art used to determine the inventive step of a claimed invention should be relevant to prior art. Usually, the prior art and the claimed invention should belong to the same or related technical field. However, in a condition in which the technical field of the prior art and that of the invention are different or unrelated but the prior art and the invention share a common technical feature, the prior art is still deemed relevant.

### 3.2.3 Easily Accomplishable

If a person ordinarily skilled in the art can expect the claimed invention based on the related prior art at the time of filing in combination with common general knowledge at the time of filing, the invention, considered as a whole, should be deemed obvious to a person ordinarily skilled in the art, i.e., the invention can be easily accomplished. "Obviousness" and "being easily accomplished" belong to the same concept.

As for the term "common general knowledge," it has been explicated in "3.2.1 A Person Ordinarily Skilled in the Art" of this Chapter.

### 3.2.4 Citations

In determining an inventive step, the citations used apply *mutatis mutandis* to the requirements set forth in "2.2.2 Citations" of this Chapter. The citations include contents which have been formally and explicitly disclosed, and those which have not been disclosed but have been substantially implied. It should be noted that substantially implied contents mean that the contents can be directly and unambiguously deduced by a person ordinarily skilled in the art from common general knowledge at the time of filing (In determining novelty, common general knowledge known at the publication date of the citation needs to be considered).

## 3.3 Principles of Examination of Inventive Step

When determining inventive step, the following principles should be taken into consideration: examination as a whole, combination and comparison, and separate examination of each claim. Details are as follows.

### 3.3.1 Examination as a Whole

When determining an inventive step, the claimed invention must be considered as a whole, rather than an individual technical feature or a portion of the technical features of the invention, is to be examined. Furthermore, the examiner shall not determine whether the invention is easily accomplishable simply based on the differences between the invention and the relevant prior art.

### 3.3.2 Combination and Comparison

When determining inventive step, it is permissible to (1) combine all or parts of the technical contents of multiple citations, (2) combine different parts of the technical contents of one citation, (3) combine the technical contents of a citation with the technical contents of prior art available in other publication format (for example, being public used or being in a state available to the public), (4) combine the technical contents of a citation with common general knowledge, or (5) combine the technical contents of prior art available in another publication format of common general knowledge, so as to determine whether a claimed invention as a whole is easily accomplishable.

### 3.3.3 Examination on Each Claim

When determining an inventive step, the invention of each claim as a whole is to be examined, and an examination opinion for each claim should be individually provided in the written opinion. If an independent claim is deemed to have an inventive step, its dependent claim(s) obviously involve(s) an inventive step, and such examination opinion can be addressed together in the written opinion. If an independent claim is deemed to lack an inventive step, the lack does not automatically deprive claim(s) depending therefrom of their respective inventive step, so the examination opinion for each claim should be individually provided in the written opinion.

## 3.4 Steps for Determining Inventive Step

Usually, determination of whether a claimed invention involves an inventive step should be made according to the following steps:

- Step 1: determining the scope of a claimed invention;
- Step 2: determining the contents disclosed in relevant prior art;
- Step 3: determining the technical levels of a person ordinarily skilled in the art;
- Step 4: determining the differences between the claimed invention and the relevant prior art; and
- Step 5: determining whether a person ordinarily skilled in the art can easily accomplish the claimed invention based on the contents disclosed in relevant prior art and common general knowledge at the time of filing.

**Step 1: Determining the Scope of a Claimed Invention**

"The scope of a claimed invention" refers to the scope literally defined by the claims, so the scope should be prevailed by the claims. In order to identify the scope of a claimed invention, the description and the drawings can be used as a reference. However, the contents disclosed only in the description or the drawings, but not specified in the claims, should not be introduced to the claims (see Chapter 1, 2.5 "Interpretation of Claims").

**Step 2:Determining the Contents Disclosed in Relevant Prior Art**

Regarding "relevant prior art," please refer to the second paragraph of "3.2.2 Prior Art" of this chapter.

"Determining the contents disclosed in relevant prior art" means to comprehend the whole contents disclosed (including taught or suggested) in the relevant prior art by a person ordinarily skilled in the art based on common general knowledge at the time of filing.

**Step 3: Determining the Technical Levels of A Person Ordinarily Skilled in the Art**

Regarding "a person ordinarily skilled in the art," please refer to "3.2.1 A Person Ordinarily Skilled in the Art" of this chapter.

In determining an inventive step, the technical levels of a person ordinarily skilled in the art must be objectively determined. The following factors should be taken into consideration when determining the technical levels: (1) the types of problems encountered in the art, (2) the technical means used in prior art for solving the problems, (3) the speed of creativity of the technical field to which the invention pertains, (4) the complexity of technology, and (5) the education levels of persons working in the field. In an individual case, it is not necessary that every factor mentioned above would exist, but it is possible that one or more factors are crucial.

If the contents of relevant prior art are sufficient to reflect or determine the technical levels of a person ordinarily skilled in the art, the technical levels can be directly confirmed without the need for additionally considering the aforementioned factors.

**Step 4: Determining the Differences between the claimed Invention and the Relevant Prior Art**

The examiner needs to select the citations suitable for the determination of an inventive step from relevant prior art, and choose one among them for comparison to determine the differences between the citation and the technical claimed invention. The single citation constituting a basis for comparison is called "the primary citation" and the rest of the citations are referred to as "the additional citations."

It should be noted that the examiner shall not combine two or more citations as "the primary citation."

**Step 5: Determining Whether a Person Ordinarily Skilled in the Art can Easily Accomplish the Claimed Invention Based on the Contents Disclosed in Relevant Prior Art and Common General Knowledge at the Time of Filing**

Upon determining the differences between the contents of the citation and the claimed invention, it can then be determined whether the reasoning for lacking an inventive step can be established in view of the relevant citation(s) together with common general knowledge at the time of filing according to the following sequence (as shown in the table as follows):

(1) Determining whether any of the factors in "3.4.1 Factors Negating Inventive Step" of this Chapter are applicable, including: "3.4.1.1 Motivation to Combine Multiple Citations," "3.4.1.2 Simply Changing," and "3.4.1.3 Simply Scraping Together."

(2) Following item (1), if none of the factors in "Factors Negating Inventive Step" is applicable, the reasoning for lacking an inventive step cannot be established. The claimed invention could be considered as involving an inventive step.

(3) Following item (1), if any of the factors in "Factors Negating Inventive Step" is applicable, "3.4.2 Factors Affirming Inventive Step" should then be taken into consideration, including: "3.4.2.1 teaching away," "3.4.2.2 Advantageous Effects," and "3.4.2.3 Auxiliary Factors Considered."

(4) Following item (3), if there is no way to determine whether the reasoning for lacking an inventive step can be established upon considering "Factors Negating Inventive Step" and "Factors Affirming Inventive Step," the claimed invention could be considered as involving an

inventive step. On the contrary, if the reasoning for lacking an inventive step can be established, the claimed invention could be considered as lacking an inventive step

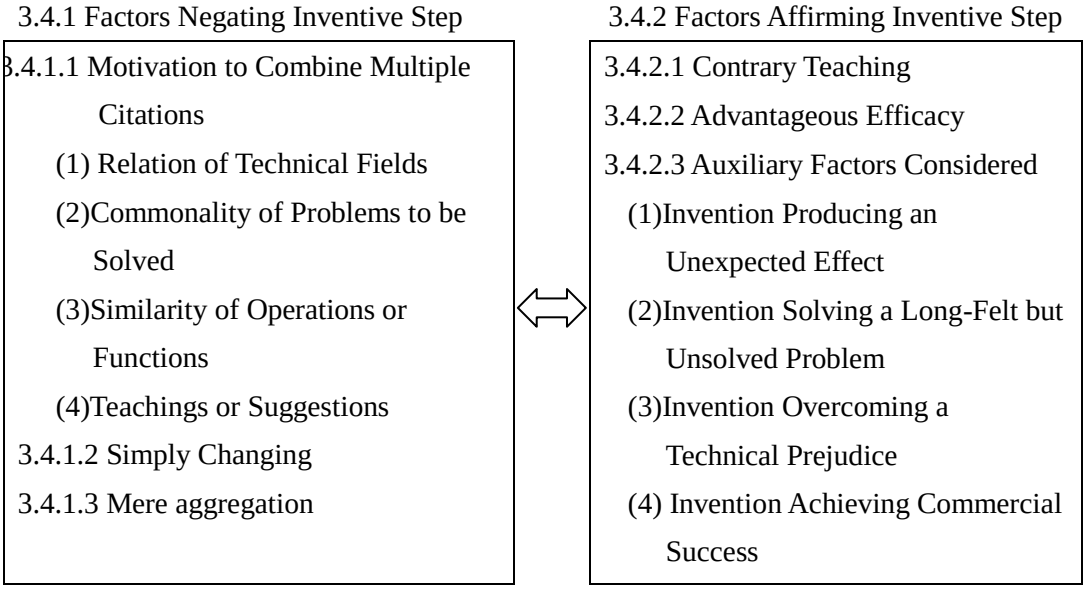


Figure: Factors to be taken into consideration when determining whether the reasoning for lacking an inventive step can be established

### 3.4.1 Factors Negating Inventive Step

#### 3.4.1.1 Motivation to Combine Multiple Citations

When determining an inventive step, a combination of the technical contents of multiple citations is usually involved. The examiner shall evaluate whether a person ordinarily skilled in the art would have motivation to combine the technical contents of multiple citations (for example, by combining technical content A of a primary citation with technical content B of an additional citation) so as to accomplish the claimed invention (for example, the claimed invention comprising A and B). If there is a motivation to combine the citations, there exists a factor negating inventive step.

When determining whether a person ordinarily skilled in the art would have motivation to combine the technical contents of multiple citations, the relation or similarity between the technical contents of multiple citations, rather than the relation or similarity between the technical contents of the citations and the technical contents of a claimed invention, should be taken

into consideration, to prevent hindsight. In principle, an overall review of the factors "relation of technical fields," "similarity of problems to be solved," "similarity of operations or functions," and "teachings or suggestions" should be made.

Generally speaking, the more aforementioned factors exist, the higher the possibility would be that a person ordinarily skilled in the art would have motivation to combine the technical contents of multiple citations. In certain cases, the existence of one strong factor could be grounds for determining that there is motivation for a person ordinarily skilled in the art to combine the technical contents of multiple citations.

#### 3.4.1.1.1 Relation of Technical Fields

"Relation of Technical Fields" should be determined based on whether the technical fields of the technical contents of multiple citations are identical or relevant.

When determining the technical field of the technical contents of a certain citation, the article, principle, mechanism or function which applies the technique can be taken into consideration.

Generally, even if the technical fields of the technical contents of multiple citations are deemed relevant, it would be difficult to directly determine that a person ordinarily skilled in the art would have motivation to combine the citations. In principle, one or more of "3.4.1.1.2 Commonality of Problems to be Solved," "3.4.1.1.3 Similarity of Operations or Functions," and "3.4.1.1.4 Teachings or Suggestions" should be further taken into consideration.

**Example 1**

[Claim]

> A telephone apparatus which sorts records in an address book according to communication frequencies.

[The Primary citation]

> A telephone apparatus which sorts records in an address book according to levels of importance set by a user.

[The Additional citation]

A facsimile apparatus which sorts records in an address book according to communication frequencies.

[Remarks]

Both of the apparatus of the primary prior art and the apparatus of the secondary prior art belong to the technical field of communication devices, so the technical fields of the technical contents of the two citations are relevant. Still, this cannot determine that a person ordinarily skilled in the art would have motivation to combine the technical contents of the citations. One or more of "3.4.1.1.2 Commonality of Problems to be Solved," "3.4.1.1.3 Similarity of Operations or Functions," and "3.4.1.1.4 Teachings or Suggestions" should be further taken into consideration.

### 3.4.1.1.2 Commonality of Problems to be Solved

"Similarity of Problems to be Solved" should be determined based on whether the technical contents of multiple citations contain a substantially identical problem to be solved.

When determining the problem to be solved by the technical contents of a certain citation, consideration should be made based on the problem to be solved disclosed in the citation, on the problem to be solved which is easily deducible by a person ordinarily skilled in the art therefrom and so on.

If the problems to be solved by the technical contents of multiple citations have commonality, it can then be determined that a person ordinarily skilled in the art would have motivation to combine the technical contents of the citations.

**Example 1**

[Claim]

A plastic bottle for which a hard carbon film is formed on its surface.

[The primary citation]

A plastic bottle for which a silicon oxide film is formed on its surface, wherein the coating of the silicon oxide film achieves the purpose of enhancing gas barrier properties.

[The additional citation]

A sealed vessel for which a hard carbon film is formed on its surface, wherein the coating of the hard carbon film achieves the purpose of enhancing barrier properties.

[Remarks]

Both the primary citation and the additional citation describe that the coating of a film achieves the purpose of enhancing gas barrier properties, so there is commonality in the problems to be solved between the technical contents of the two citations.

**Example 2**

[Claim]

A pair of cooking scissors having a cap opener in a handle portion thereof.

[The primary citation]

A pair of cooking scissors having a shell cracker in a handle portion thereof.

[The additional citation]

A petit knife having a cap opener in a handle portion thereof.

[Remarks]

Providing multi-functionality to a cooking utensil such as a pair of cooking scissors or a knife is an obvious problem to be solved in the field of the cooking utensil and such a solution is easily deducible by a person ordinarily skilled in the technical field of the cooking utensil. Therefore, there is commonality in the problems to be solved between the technical contents of the two citations.

### 3.4.1.1.3 Commonality of Operations or Functions

" Commonality of operations or functions" should be determined based on whether the technical contents of multiple citations contain substantially identical operations or functions.

If the operations or functions disclosed in the technical contents of multiple citations have commonality, it can then be determined that a person ordinarily skilled in the art would have motivation to combine the technical contents of the citations.

**Example 1**

[Claim]

A printing machine which comprises a cleaning device for a blanket cylinder, said cleaning device pressing and contacting a cleaning sheet through swelling of a swelling member within the device thereby cleaning the cylinder.

[The primary citation]

A printing machine which comprises a cleaning device for a blanket cylinder, said cleaning device pressing and contacting a cleaning sheet through a cam structure within the device thereby cleaning the cylinder.

[The additional citation]

A printing machine which comprises a cleaning device for a gravure cylinder, said cleaning device pressing and contacting a cleaning fabric through swelling of a swelling member within the device thereby cleaning the cylinder.

[Remarks]

The technical contents of the primary citation disclose pressing and contacting a cleaning sheet through a cam structure. The technical contents of the additional citation disclose pressing and contacting a cleaning sheet via a swelling member. Both citations disclose pressing and contacting a cleaning sheet thereby cleaning the cylinder.

Therefore, the technical contents of the two citations have commonality of operation or function.

#### 3.4.1.1.4 Teachings or Suggestions

If the technical contents of a relevant citation have provided a teaching or suggestion explicitly stated or substantially implied combining the technical contents of different citations, for example, at least one of citations A and B provides a teaching or suggestion that the technical contents of the two citations can be combined, or a further citation C provides a teaching or suggestion that the technical contents of citations A and B can be combined, it may be deemed that a person ordinarily skilled in the art has a strong motivation to combine the technical contents of the citations (i.e., citations A and B).

**Example 1**

[Claim]

A building structure material sheet made of aluminum comprising a bent formation.

[The primary citation]

A building structure material sheet comprising a bent formation, wherein the sheet is made of a lightweight and highly corrosion-resistant material (The primary citation does not disclose the use of aluminum).

[The additional citation]

A roof trussing member which is made of aluminum or aluminum alloy. (The additional citation discloses that using aluminum can reduce the weight of the member because aluminum is a light weight material.)

[Remarks]

The technical contents of the primary citation disclose that the structure material sheet is made of a lightweight material. The additional citation discloses that aluminum is a lightweight material,

and thus can be used for making a roof trussing member. Therefore, the technical contents of the relevant citations have provided a teaching or suggestion that the technical contents of the two citations can be combined.

**Example 2**

[Claim]

A transparent film comprising an ethylene/vinyl acetate copolymer and an acid-acceptor particle dispersed in the copolymer, wherein the copolymer is cross-linked by a cross-linking agent.

[The primary citation]

A transparent film for use as a sealing film of the element of a solar battery comprising an ethylene/vinyl acetate copolymer and an acid-acceptor particle dispersed in the copolymer.

[The additional citation]

A transparent film for use as a sealing film of a solar battery, which is formed from an ethylene/vinyl acetate copolymer wherein the copolymer is cross-linked by a cross-linking agent.

[Remarks]

The technical contents of the primary citation disclose a transparent film comprising an ethylene/vinyl acetate copolymer, and wherein said transparent film is applicable as a sealing film of a solar battery element. The technical contents of the additional citation disclose a transparent film formed from an ethylene/vinyl acetate copolymer which is cross-linked by a cross-linking agent, and wherein the film is applicable as a sealing film of a solar battery. Therefore, the technical contents of the relevant citations have provided a teaching or suggestion that the technical contents of the two citations can be combined.

### 3.4.1.2 Simply Changing

With respect to the distinguishing technical feature between the technical contents of a claimed invention and those of a single citation, when attempting to address a certain problem, if a person ordinarily skilled in the art can accomplish the claimed invention through simply modifying, replacing, omitting, or converting the distinguishing technical feature of the single citation based on common general knowledge at the time of filing, the claimed invention should be considered "simply changing" the technical contents of said single citation.

As for the term "common general knowledge," it is explained in "3.2.1 A Person Ordinarily Skilled in the Art" of this Chapter.

If a claimed invention is a simple change of the technical contents of a single citation, it is determined that there exists a factor negating inventive step. If the technical contents of the single citation or the technical contents of a further citation provide a teaching or suggestion of such "simply changing," said teaching or suggestion should be deemed strong evidence in support of the existence of a factor negating inventive step.

Example: In order to reduce number of repairing, a claimed invention is accomplished by a person ordinarily skilled in the art through substituting a brushless DC motor for a DC motor with a brush in a driving means of a bathroom drying apparatus on the basis of common general knowledge at the time of filing.

Example: In order to more easily assemble an article, a claimed invention is accomplished by a person ordinarily skilled in the art through using one-piece technology to make a part of the elements of the article to be one piece on the basis of common general knowledge at the time of filing.

Example: In order to save elements or simplify steps, a claimed invention is accomplished by a person ordinarily skilled in the art through omitting a part of the elements of an article or a part of the steps of a method to reduce the functions of the omitted components or steps on the basis of common general knowledge at the time of filing.

As for determination of the inventive step of a claimed invention which is accomplished by using a simple selection of the technical contents of a

single citation, please refer to "3.5 Determination of Inventive Step of a Selection Invention" of this Chapter.

It should be noted that this "Simply Changing" section and "3.4.1.1 Motivation to Combine Multiple Citations" of this Chapter can be taken into consideration separately or in combination.

#### 3.4.1.3 Mere Aggregation

If a claimed invention (e.g., a pen fixed with a digital watch) merely aggregates the technical contents of multiple citations (e.g., those relating to a digital watch and a pen, respectively), and the technical features of the combined invention do not functionally support each other but function in their routine ways so that the overall technical effect of the combined invention is just the sum of the technical effect of each citation before aggregation, the claimed invention should be deemed a mere aggregation of the technical contents of multiple citations.

If a claimed invention is a mere aggregation of the technical contents of multiple citations, it can be determined that there exists a factor negating inventive step. If the technical contents of the multiple citations or the technical contents of a further citation provide a teaching or suggestion of such mere aggregation, said teaching or suggestion should be deemed strong evidence in support of the existence of a factor negating inventive step.

When determining whether a claimed invention involves an inventive step, the claimed invention, considered as a whole, should be examined. Furthermore, the examiner should not determine that a claimed invention is a mere aggregation simply based on all the technical features of the claimed invention having been disclosed in the combination of multiple citations, but should take into consideration each technical feature of the combined invention and whether the technical features functionally support each other.

### 3.4.2 Factors Affirming Inventive Step

#### 3.4.2.1 Teaching Away

In "Step 2:Determining the Contents Disclosed in Relevant Prior Art" for determining inventive step, all contents disclosed in the relevant prior art

should be taken into consideration, including whether the relevant prior art teaches away from a claimed invention.

The term "teach away" refers to the relevant prior art providing a teaching or suggestion explicitly stating or substantially implying that a claimed invention is excluded, including a teaching or suggestion that the relevant technical features of a claimed invention cannot be combined, or that a person ordinarily skilled in the art would be dissuaded from taking the approach taught by the technical contents based on the technical contents disclosed by the citation.

If the relevant prior art teaches away from a claimed invention, it may be determined that there exists a factor affirming an inventive step.

For example, In cases where a claimed invention uses a catalyst comprising iron and alkali metals, and citation A discloses incorporating iron to a catalyst but explicitly excluding antimony being incorporated to the catalyst, and citation B teaches the interchangeability of antimony and alkali metal with the same beneficial result, based on the teachings of both citations, a person ordinarily skilled in the art would not be suggested to make a catalyst combined both with iron and an alkali metal. In other words, both citations have disclosed that the relevant technical features of the claimed invention cannot be combined. As such, the citations teach away from the claimed invention.

Determination of whether a relevant prior art teaches away from a claimed invention should be made based on the substantial contents of the relevant prior art For example, if a claimed invention is directed to an epoxy resin as a material for printed circuit and prior art discloses a polyamide resin as a material for circuit printing boards and further teaches that although an epoxy resin material has an acceptable stability and a certain degree of flexibility, its properties are poor compared to those of a polyamide resin, since the substantial contents of the prior art do not disclose that a polyamide resin cannot be used as a material for circuit printing boards or teach or suggest that the claimed invention can be excluded, the prior art does not teach away from the claimed invention.

If prior art simply discloses a preferred embodiment or one or more embodiments expressed in an alternative manner, and a claimed invention is not the preferred embodiment or one of the alternative embodiments, the

prior art does not teach away from the claimed invention because the prior art does not explicitly exclude the claimed invention.

### 3.4.2.2 Advantageous Effects

When determining whether a claimed invention involves an inventive step, the advantageous effect of the invention as compared with prior art should be taken into consideration. The advantageous effect includes that disclosed in the description submitted at the time of filing (see "1.2.4.3 Effects as Compared with Prior Art" of Chapter 1) as well as that asserted by the applicant during the submission of amendment or response. It should be noted that the advantageous effect should be the technical effect directly resulting from the technical means for practicing the invention. In other words, it should be the technical effect directly resulting from all the technical features which constitute the technical means. In addition, the advantageous effect should be explicitly disclosed in the description, claims, or drawings submitted at the time of filing or easily deduced by a person ordinarily skilled in the art from the contents of the originally filed description, claims, or drawings. Advantageous effects which are not explicitly disclosed or cannot be deduced should not be taken into consideration.

If a claimed invention has advantageous effect over prior art, it is determined that there exists a factor affirming inventive step. If the advantageous efficacy is an "unexpected effect," it should be deemed strong evidence in support of the existence of a factor affirming inventive step (see "3.4.2.3.1 Invention Producing an Unexpected Effect" of this chapter).

### 3.4.2.3 Auxiliary Factors Considered

When determining an inventive step, the auxiliary evidential document submitted by the applicant at the time of filing or during the prosecution to support the inventive step of a claimed invention from the following aspects should also be taken into consideration.

#### 3.4.2.3.1 Invention Producing an Unexpected Effect

The term "producing an Unexpected Effect" means that as compared with a relevant prior art, the claimed invention produces a technical effect which is unexpected as compared with prior art, including a significant

enhancement of an efficacy (i.e., a quantitative change) or a new performance (i.e., a qualitative change), wherein said effect cannot be expected by a person ordinarily skilled in the art at the time of filing. Alternatively, even if a claimed invention produces a significant enhancement of an effect or a new performance, if such effect is expected for a person ordinarily skilled in the art at the time of filing, it still does not deem "an unexpected effect."

For example, where a claimed invention is directed to derivatives of protein A, and the derivatives exhibit an increased activity for 6 to 9 times compared with those of protein A of prior art, if the significantly enhanced effect is unexpected for a person ordinarily skilled in the art at the time of filing, it can be determined that the claimed invention produces an unexpected effect.

For example, where prior art discloses a preparation of pentachlorophenol useful as a fungicide for wood, and a claimed invention is directed to the use of a preparation of pentachlorophenol as a herbicide, if the new use is unexpected for a person ordinarily skilled in the art at the time of filing, it can be determined that the claimed invention produces an unexpected effect.

If a claimed invention has an unexpected effect as compared with relevant prior art, it should be deemed strong evidence in support of the existence of a factor affirming inventive step. Therefore, even if a person ordinarily skilled in the art would be motivated by common general knowledge or prior technology existing at the time of filing to accomplish a claimed invention, as long as the claimed invention produces an unexpected effect, it can be deemed strong evidence in support of the existence of a factor affirming inventive step.

#### 3.4.2.3.2 Invention Solving a Long-Felt but Unsolved Problem

If a claimed invention solves a long-felt but unsolved problem of prior art or satisfies a long-felt need among the public, it can be determined that there exists a factor affirming inventive step.

When determining whether a problem is a long-felt but unsolved problem, the following three requirements must be simultaneously fulfilled: (1) the person ordinarily skilled in the art recognized the problem existed in the art for a long period of time without solution, (2) the problem must not

have been solved by another before the claimed invention by applicant, and (3) The claimed invention must in fact successfully solve the problem.

Example: the problem of permanently marking farm animals such as cows without causing pain or damage to the hide thereof is recognized among livestock industry as a long-felt but unsolved problem. If no solution has been provided prior to the filing of a claimed invention, and the claimed invention provides a lyophilizing-marking method which solves the long-felt but unsolved problem, it can be determined that there exists a factor affirming inventive step.

#### 3.4.2.3.3 Invention Overcoming a Technical Prejudice

If a claimed invention uses a technical means abandoned based on a technical prejudice to deal with a certain technical problem in a certain technical field and said technical means solves the problem, it is determined that there exists a factor affirming inventive step.

The term "technical prejudice" refers to the understanding in the art of a certain technical problem in a certain technical field that departs from the objective facts, which leads to the belief that there is no other possibility in the technical field.

Example: It is generally believed that during bottling of carbon dioxide-contained beverages, the bottles must be sealed immediately after being filled to prevent the beverage from ejecting from the bottles in view of the high temperature of the bottles caused by disinfection. A claimed invention teaches that during the bottling procedure, no beverage will be ejected from the bottles even if the bottles are not sealed immediately after filling. Therefore, the belief that "a carbon dioxide-contained beverage will eject from the hot bottles got after disinfecting" is a technical prejudice. Since the claimed invention overcomes the technical prejudice, it can be determined that there exists a factor affirming inventive step.

#### 3.4.2.3.4 Invention Achieving Commercial Success

If a claimed invention achieves commercial success and if the technical features of the invention directly bring about such success, rather than other factors such as selling technique or advertisement, it can be determined that there exists a factor affirming inventive step.

## 3.5 Determination of an Inventive Step of a Selection Invention

A selection invention is an invention which is made by selection of sub-sets, sub-ranges, or individual elements which have not been explicitly mentioned in a relevant prior art from a larger set or range disclosed in the relevant prior art

Determination of the inventive step of a selection invention should be made in accordance with the criteria given in "3.4 Steps for Determining Inventive Step" of this Chapter. The following conditions should also be taken into consideration:

In a selection invention, if the selected part furnishes an unexpected effect as compared with a relevant prior art, it should be determined that the invention cannot be easily accomplished and has an inventive step (an unexpected effect is referred to in "3.4.2.3.1 Invention Producing an Unexpected Effect" of this Chapter).

A selection invention is often seen in the technical field relating to chemicals and materials (see "5.3.1.5 Selection Invention of Compounds" of Chapter 13). For example, where a relevant prior art has disclosed a process for manufacturing compound C by reacting compound A with compound B at elevated temperature, and teaches that the yield of compound C increases along with the increased temperature in the range from 50 to 130$^{o}$C, and a selection invention chooses a temperature ranging from 63 to 65$^{o}$C (this subrange not being explicitly disclosed in the relevant prior art) and claims that the yield of compound C is significantly increased in the subrange, since the effect is unexpected for a person ordinarily skilled in the art at the time of filing of the selection invention, it can be determined that the selection invention has an unexpected efficacy, cannot be easily accomplished, and involves an inventive step.

With respect to the distinguishing technical feature between a claimed invention and the technical contents of a single citation, in order to solve a specific problem, if a person ordinarily skilled in the art can accomplish a claimed invention by using a simple selection from the distinguishing technical feature of the single citation based on common general knowledge at the time of filing, the invention does not furnish any unexpected effect, the claimed invention does not have an inventive step.

As for the term "common general knowledge," it has been explained in "3.2.1 A Person Ordinarily Skilled in the Art" of this Chapter.

Example: The technical contents of a claimed invention and a single citation are both directed to a cable having a PE plastic layer adhered to a metal protection layer with an adhesive agent. The difference lies only in that the claimed invention uses a specific adhesive agent (i.e., adhesive agent A). It is general knowledge that an adhesive agent can be used to bind a plastic to a metal, and that there is no particular limitation to the species of the adhesive agents. Adhesive agent A selected by the claimed invention is the best or preferred adhesive agent which a person ordinarily skilled in the art would select based on common general knowledge to solve the problem of limited adhesion, and such selection does not furnish any unexpected efficacy. Therefore, the claimed invention does not have an inventive step.

Example: The technical contents of a claimed invention and a single citation are both directed to a coating comprising antioxidant A. The difference lies only in that the claimed invention limits the amount of antioxidant A to a range from 2 to 3%. It is general knowledge that antioxidant A can be used in coatings, and that there is no particular limitation to the amount of such antioxidant. The amount ranging from 2 to 3% selected by the claimed invention is the best or preferred amount which a person ordinarily skilled in the art would select based on common general knowledge to solve the problem of oxidation of coatings, and such selection does not furnish any unexpected efficacy. Therefore, the claimed invention does not have an inventive step.

## 3.6 Notes for Examination

(1) Whether an invention is found by chance or accomplished through painstaking research or testing should not affect determination of the inventive step.
(2) When determining the inventive step of an invention, the examiner should firstly understand from the disclosure of the description the problem to be solved by the invention, the technical means used in the invention to solve the problem, and the effect of the invention as compared with prior art, rather than determining whether or not a claimed invention has an inventive step by respectively comparing the above three factors with relevant prior art to find out if there is any substantial difference between

them. In principle, the inventive step of a claimed invention should be determined by sequentially following the aforementioned five determination steps.

(3) When determining the inventive step of a claimed invention, the examiner should not assert that the claimed invention can be easily accomplished and lacks an inventive step based on "hindsight" after reviewing the contents of the description, claim(s), and drawing(s), but should compare the claimed invention, considered as a whole, with relevant prior art, and then make an objective judgment based on the viewpoint that a person ordinarily skilled in the art would have made in view of common general knowledge at the time of filing.

(4) When determining the inventive step of a claimed invention, the examiner should determine whether the claimed invention can be easily accomplished based on the relevant technical contents disclosed in a citation obtained from prior art search. If the examiner cannot cite the citation(s) obtained from prior art search, but merely cites the relevant prior art documents described in the description of a patent application directed to the claimed invention for rejection of lacking an inventive step, concrete reasons must be stated in the office action. (see "1.4 Notes for Examination " of Chapter 1)

(5) When determining a claimed invention lacking an inventive step, in principle, the citation of the relevant prior art should be attached to the office action. If only the technology cited is common general knowledge (see "3.2.1 A Person Ordinarily Skilled in the Art" of this chapter), there is no need to attach the citation. However, the examiner should sufficiently and clearly describe the reasons for rejection in the office action and the rejection decision.

(6) When the invention of a product involves an inventive step, the invention regarding the manufacturing process or the use of the product commensurately involves an inventive step.

(7) If the applicant asserts in the response that the citation applies to the exceptions to lack of novelty or an inventive step, the stipulations set forth in "4. Exceptions to Lack of Novelty or an Inventive Step" of this chapter should be considered.

## 4. Exceptions to Lack of Novelty or an Inventive Step

### 4.1 Introduction

A grace of exceptions to lack of novelty or an inventive step means that there is a fact that the applicant disclosed the invention under a specific condition within a specific period before the filing of a patent application for invention, where the fact of disclosure shall not preclude granting of the patent application for invention from lack of novelty or an inventive step. Therefore, when there is a fact that a disclosure is made by or against the applicant's will, and a patent application for invention is filed within 12 months of the occurrence of the fact of disclosure, the invention applies to the grace of exceptions to lack of novelty or an inventive step. The aforementioned 12-month period, which allows the technical contents relevant to the fact of disclosure not to be deemed prior art to determine whether a patent application for invention involves novelty or an inventive step, is referred to as the grace period.

Act 22.III

If the aforementioned fact of disclosure is a publication in a patent gazette made in the ROC or a foreign country in accordance with the laws as the consequence of filing a patent application and made by the applicant, in principle, the publication is not applicable to the grace of exceptions to lack of novelty or an inventive step, and the technical contents relevant to the fact of disclosure are deemed prior art to determine whether the invention involves novelty or an inventive step.

Act 22.IV

### 4.2 Actors of Fact of Disclosure

The actors of fact of disclosure of exceptions to lack of novelty or an inventive step should be the applicant or a third party.

The "applicant" used herein also includes the pre-owner of the rights of the applicant. The "pre-owner of the rights" represents the predecessor or assignor of the owner of the right to apply for a patent, or the employee or appointee of the owner of the right to apply for a patent, etc.

Rule 15

"A third party" used herein refers to a person other than the applicant who discloses the technical contents of the invention of the applicant. For example, a third party may be a person who is designated, consented to, or instructed by the applicant, a person who fails to meet confidentiality

obligation, or a person who illegally obtains the invention by way of duress, fraudulence, or theft.

Aforementioned "a person other than the applicant" is called other person, which includes a third party.

### 4.3 Period of Exceptions to Lack of Novelty or an Inventive Step

The grace period is 12 months calculated from the day following the occurrence of the fact of disclosure. Where multiple disclosures are made by or against the applicant's will within the grace period so that there are multiple applicable grace conditions, the grace period should be 12 months calculated from the day following the occurrence of the earliest fact of disclosure. In other words, in case where the grace condition is applicable, the time period calculated from the day following the occurrence of the earliest fact of disclosure to the date of filing should not exceed 12 months.

The occurrence date of the fact of disclosure should be determined based on the date shown on the technical contents disclosed or a relevant document of proof. If the fact of disclosure can only be determined to the occurred year, season, year/month, bi-week, or week, the first day of the year, the first day of the season, the first day of the year/month, the first day of the first week of the bi-week, or the first day of the week should be presumed as the occurrence date. If the presumed date is not more than 12 months prior to the filing date of the patent application, there is no need to notify the application to indicate the occurrence date of the fact of disclosure. If the presumed date is more than 12 months prior to the filing date of the patent application, such disclosure is not applicable to the grace conditions. If the applicant considers the grace conditions to be applicable, the applicant should clearly describe the fact of disclosure and the occurrence date of the fact, and provide a relevant document of proof as evidence.

Act 28. I
Act 30. I (1)

A grace of exceptions to lack of novelty or an inventive step differs from a priority in their starting dates. The starting date of the former is 12 months calculated from the day following the occurrence of the fact of disclosure, but the stating date of the later is 12 months calculated from the filing date of an foreign or domestic patent application based on which a priority is claimed. Therefore, if a patent application applies to the grace of exceptions to lack of novelty or an inventive step and also claims a priority, the starting dates of both conditions should be determined separately.

Since the Patent Act of the ROC does not follow the stipulations set forth in the Paris Convention, Article 11, the priority date of an foreign priority cannot be traced back to the occurrence date on which the goods of a patent application exhibited at an exhibition.

### 4.4 Publication in Patent Gazette

If the technical contents of an invention of a patent application filed by the applicant in the ROC or a foreign country have been laid-open or published in a lay-open gazette or patent gazette in accordance with the laws, in principle, the publication of the patent application is not applicable to the grace of exceptions to lack of novelty or an inventive step, and the technical contents relevant to the fact of disclosure are deemed prior art to determine whether the invention involves novelty or an inventive step Act 22.Ⅳ

One exception is when the publication in a patent gazette is due to a specific Patent Agency's negligence. The other exception is when the technical contents of the invention of the applicant are directly or indirectly known by a third party, the publication is due to a patent application filed the third party covering the same invention without the applicant's approval, and the applicant files a new patent application for the same invention within 12 months after the publication. Accordingly, the new application applies to the grace of exceptions to lack of novelty or an inventive step, and the fact of disclosure should not be deemed prior art to determine whether the invention of the new application has novelty or an inventive step. In such condition, the applicant should clearly describe the fact of disclosure and the occurrence date of the fact, and provide a relevant document of proof as evidence.

### 4.5 Conditions Applying to Exceptions to Lack of Novelty or an Inventive Step

The conditions applying to exceptions to lack of novelty or an inventive step, except for the publication in a patent gazette, include "a disclosure made by the applicant's will" and "a disclosure made against the applicant's will." Act 22.III

"A disclosure made by the applicant's will" used herein refers to a disclosure made by the applicant's will but not necessarily by the applicant in

person. In such case, the actors of the disclosure may include the applicant, and a person who is designated, consented to, or instructed by the applicant.

When there are two or more applicants, the previous disclosure action needs not be performed by all the applicants, and thus, each applicant can take such action alone. Furthermore, whether disclosure by each applicant is approved by others or not, such disclosure meets the condition "made by the applicant's will."

"A disclosure made against the applicant's will" used herein refers to a disclosure not made by the applicant's will, but still disclosed. In such case, the actors of the disclosure may include a person who is not designated, consented to, or instructed by the applicant, a person who fails to meet confidentiality obligation, or a person who illegally obtains the invention by way of duress, fraudulence, or theft.

In these two conditions, the disclosure without any limitation could be made by means of experimental, in a printed publication, at an official or officially recognized exhibition, in a public exploitation, or in any other way.

A disclosure of an invention independently created by another person does not meet the aforementioned two conditions. Therefore, such patent application for invention is not applicable to the grace of exceptions to lack of novelty or an inventive step, and thus the technical contents disclosed therein are deemed prior art to determine whether the invention involves novelty or an inventive step.

If a fact of disclosure was made by another person prior to the filing of the application, in order to determine whether said disclosure meets the aforementioned two conditions, i.e., whether the patent application for invention is applicable to the grace of exceptions to lack of novelty or an inventive step, the applicant should clearly describe the fact of disclosure and the occurrence date of the fact, and provide a relevant document of proof as evidence.

### 4.6 Effect of Exceptions to Lack of Novelty or an Inventive Step

The effect of a grace of exceptions to lack of novelty or an inventive step is that the technical contents of the fact of disclosure are not deemed

prior art to determine whether a patent application for invention has novelty or an inventive step.

The effect of a grace of exceptions to lack of novelty or an inventive step and the effect of a priority are different. The former only prevents the technical contents of the fact of disclosure in the grace period from being deemed prior art to determine whether a patent application for invention has novelty or an inventive step. It does not affect the base date to determine whether an invention complies with the requirements for patentability. The later makes all the technical contents discloses between the priority date and the filing date not be deemed prior art to determine whether a patent application for invention has novelty or an inventive step. It affects the base date to determine whether an invention complies with the requirements for patentability. Therefore, if other relevant technical contents, such as a disclosure of an invention independently created by other person, are disclosed within the grace period, the patent application for invention may not be granted for lack of novelty or an inventive step. For the same reasons, if there is an application covering the same invention filed by other person within the grace period, since the claimed grace of not lack of novelty or an inventive step cannot exclude the fact that an application has been filed earlier by other person, the patent application for invention cannot be granted a patent in view of lack of novelty based on legal fiction or first-to-file principle. The earlier-filed application of another person should also not be granted a patent because it lacks novelty in view of the fact that the same invention has been disclosed prior to its filing date. Act 28.IV Act 30.VI

### 4.7 Examination of Exceptions to Lack of Novelty or an Inventive Step

Whether a publication in a patent gazette makes a patent application for invention applicable to grace should refer to "4.4 Publication in Patent Gazette" of this chapter.

When there is a fact of disclosure, except for publication in a patent gazette, if both the requirements, (1) the applicant files a patent application for invention within 12 months of the occurrence of the fact of disclosure; and (2) the disclosure is made by or against the applicant's will, are met, the invention should apply to the grace of exceptions to lack of novelty or an inventive step, and the technical contents relevant to the fact of disclosure

should not be deemed prior art to determine whether the patent application for invention has novelty or an inventive step.

If either of these two requirements can be met, such as the occurrence date of the fact of disclosure being earlier more than 12 months from the date of filing, or the actors of disclosure is another person or includes other person (e.g., a disclosure of an invention independently created by other person), in principle, it should be deemed that the invention does not apply to the grace of exceptions to lack of novelty or an inventive step, and the technical contents relevant to the fact of disclosure should be deemed prior art to determine whether the patent application for invention has novelty or an inventive step. If the applicant considers the grace to be applicable, the applicant should clearly describe the fact of disclosure and the occurrence date of the fact, and provide a relevant document of proof as evidence.

The examination of these two requirements is exemplified as follows:

(1) The applicant files a patent application for invention within 12 months of the occurrence of the fact of disclosure.

For example, if a paper of a symposium discloses only the publication year and month, and the applicant files a patent of application for invention after the publication of the paper, the publication date of the paper should be presumed as the first day of the month of that year. If the presumed date is not more than 12 months prior to the filing date, and the actors of publication is the applicant, the publication of the paper can be deemed to be made by the applicant's will, and the invention applies to the grace. Therefore, the technical contents disclosed in the paper should not be deemed prior art to determine whether the patent application for invention involves novelty or an inventive step.

For example, if a paper of a symposium discloses only the publication year, and the applicant files a patent of application for invention after the publication of the paper, publication date of the paper should be presumed as the first day of the published year. If the presumed date is more than 12 months prior to the filing date, in principle, the invention does not apply to the grace. Therefore, the technical contents disclosed in the paper should be deemed prior art to determine whether the patent application for invention has novelty or an inventive step. If the applicant considers the invention to be applicable to the grace, the applicant should clearly describe the fact of disclosure

and the occurrence date of the fact, and provide a relevant document of proof as evidence.

(2) The disclosure is made by or against the applicant's will.

For example, a paper of a symposium discloses that the author is A. Within 12 months of the publication of the paper, applicants A and B file a patent application for invention. Since the actor of disclosure is one of the applicants, the disclosure of the paper is deemed to be made by the applicant's will. And since the applicants file the patent application for invention within 12 months of the occurrence of the fact of disclosure, the invention applies to the grace, and the technical contents disclosed in the paper should not be deemed prior art to determine whether the patent application for invention involves novelty or an inventive step.

For example, a paper of a symposium discloses that the authors are A and B. Within 12 months of the publication of the paper, applicant A files a patent application for invention. Since the actors of disclosure includes a person other than the applicant, the contents of the disclosure may be an invention independently created by other person, so that it should not be deemed that the invention apply to the grace in principle, and the technical contents disclosed in the paper should be deemed prior art to determine whether the patent application for invention has novelty or an inventive step. If the applicant considers the invention to be applicable to the grace, the applicant should clearly describe the fact of disclosure and the occurrence date of the fact, and provide a relevant document of proof as evidence.

If many facts of disclosures are made by or against the applicant's will, such as after a disclosure is made by the applicant in person, and it is further reported by media, when determining whether a patent application for invention is applicable to the grace of exceptions to lack of novelty or an inventive step, it should be determined by the facts, independently.

If the aforementioned many facts of disclosures have an "inseparable" relationship, in other words, the earliest fact of disclosure and the subsequent facts of disclosure are closely related, the applicant needs to provide a document of proof for only the earliest fact of disclosure but not for the others.

Examples of the "inseparable" relationship include:

(1) An experiment continually conducted for several days.
(2) A disclosure of an experiment and the description thereof disseminated on the spot.
(3) The reprint of and the first edition of a printed publication.
(4) A paper published in a seminar and a symposium published thereafter accordingly.
(5) Traveling exhibits of the same exhibition.
(6) An exhibit at an exhibition and a catalog of the exhibition published thereafter.
(7) A paper previously published on a website of a publishing company and the same paper published thereafter in a printed publication issued by the publishing company.
(8) A published degree thesis and the thesis displayed in a library.

Further explanations include:

(1) In a case where the applicant discloses their paper on a website of a publishing company and where the paper is then disclosed in a printed publication issued by the publishing company. Both disclosures have an inseparable relationship, and thus only a document of proof showing the disclosure on the website needs to be submitted.
(2) In a case where the applicant discloses their degree thesis in a publication ceremony or seminar and where the applicant then display or discloses the thesis in a library or symposium. Both disclosures have an inseparable relationship, and thus only a document of proof showing the thesis disclosed in the publication ceremony or seminar needs to be submitted.
(3) In a case where the applicant discloses their invention in a newspaper and where the applicant then discloses the invention in a printed publication of seminar. Each of the disclosure is an individual disclosure action so that the two disclosures do not have an inseparable relationship. In such case, an explanation clearly describing the fact of each disclosure and a document of proof for each disclosure need to be submitted.
(4) In a case where the application authorizes their original draft disclosing the invention to different publishing companies and where the original draft is then disclosed in different printed publications by the different publishing companies. The disclosures do not have an inseparable relationship with each other. In such case, an explanation clearly

describing the fact of each disclosure and a document of proof for each disclosure needs to be submitted.

(5) In a case where the same invention is sequentially exhibited at different non-traveling exhibitions held in a short period. Since exhibition of the invention at different exhibitions is decided by the applicant, the facts of multiple disclosures do not have an inseparable relationship. In such case, an explanation clearly describing the fact of each disclosure and a document of proof for each disclosure needs to be submitted.

(6) In a case where the applicant discloses a part of the technical contents of their invention in a paper of a seminar and where the applicant then additionally supplies the other part of the technical contents in a symposium of the seminar. It is possibly deemed that there is no inseparable relationship between the disclosure of the technical contents in the paper and the publication of the symposium. In such case, an explanation clearly describing the fact of each disclosure and a document of proof for each disclosure is preferably to be submitted.

Whether facts of multiple disclosures would have an inseparable relationship should be objectively determined based on each fact of disclosure. Upon examination, if it is deemed that the facts of multiple disclosures do not have an inseparable relationship and can be used as prior art to determine whether a patent application for invention has novelty or an inventive step, the applicant still needs to submit a document of proof for each disclosure.

### 4.8 Notes for Examination

(1) Patent applications claiming a grace of exceptions to lack of novelty or an inventive step and filed after 1 May 2017 apply to the relevant stipulations set forth in the Patent Act after amendment. Patent applications claiming a grace of exceptions to lack of novelty or an inventive step and filed before 1 May 2017 apply to the relevant stipulations set forth in the Patent Act before amendment.

(2) A grace of exceptions to lack of novelty or an inventive step is not necessary to be claimed at the date of filing. Before a final decision is issued, if the applicant clearly describes the fact of disclosure and the occurrence date of the fact, and provide a relevant document of proof on his/her own initiative, the grace should be considered during examination.

(3) Even if "the disclosure is made against the applicant's will," if only the applicant has filed a patent application for invention within 12 months from the technical contents of the patent application are disclosed, the grace of exceptions to lack of novelty or an inventive step will be applicable. If the patent application is filed beyond the 12-month period, the grace will not be applicable, and the technical contents of the fact of disclosure will be deemed prior art to determine whether the patent application for invention involves novelty or an inventive step.

## 5. First-to-File Principle

### 5.1 Introduction

Act 31. I

The exclusivity of patent rights is an important principle in the patent system. Therefore, only one patent right shall be granted to one invention. When two or more patent applications is filed for one invention, only the earliest-filed patent application may be granted. If the filing dates or, where priority is claimed, the priority date of the two or more patent applications are the same but the applicants are different, the applicants shall be notified to hold consultations for an agreement with respect to the matter concerned. If such an agreement fails to be reached, none of the applications shall be granted. If the filing date or, where priority is claimed, the priority date of the two or more patent applications are the same and the applicants are the same person, the applicant shall be instructed to select one patent application within a specified time period. Failure to make a selection within the time period shall result in the rejection of all patent applications.

Act 31. II

Art 31. I, II apply mutatis mutandis to Art 31. IV

In addition, since both an invention and an utility model are creations using technical ideals, if a patent application for invention and a patent application for utility model are filed separately based on identical creation, except the circumstances stipulated in the Patent Act, Article 32, the Patent Act, Article 31, Paragraph 4 shall be applicable *mutatis mutandis* the provisions set forth here.

Act 32

In cases where the same applicant files a patent application for invention and a patent application for utility model for identical creation on the same date and the patent application for utility model is granted before an approval decision on the patent application for invention is rendered, where the filing dates of the patent applications are after June 13, 2013 and where the applicant made respective declarations in respect of the patent

applications being filed for the same creation on the same date at the time of filing, the provisions in respect of double patenting set forth in current Article 32 shall be applicable (see "5.7 Continuation of Patent Rights"). If the filing dates of the patent applications predate June 13, 2013, the provisions in respect of double patenting set forth in pre-amended Article 32 shall be applicable ( see "5.8 Alternative of Patent Rights").

Pre-amended Art 32

## 5.2 Concept of First-to-File Principle

"First-to-File Principle" refers to situations where two or more patent applications (or one patent and one patent application) are filed for idential invention. Regardless of whether the patent applications are filed on different or the same date and regardless of whether the patent applications are filed by different or the same applicant, only the earliest-filed patent application will be granted. Two or more patent rights cannot be issued to prevent double patenting. Because patent applications for inventions adopt requests for examination, the proviso for applying this Article is that a request for substantive examination of said patent application for invention has been made. ◦

Act 38

### 5.2.1 Identical Invention

The term "identical invention" refers to cases where inventions in two or more sequentially filed patent applications or two or more patent applications filed on the same date are identical. Namely, when inventions specified in any of the claims of the two or more patent applications are the identical.

### 5.2.2 Conditions Applying to the First-to-File Principle

According to the "first-to-file principle," when two or more patent applications are filed for one invention, only the earliest-filed patent application may be granted. Cross combinations of applicants and filing dates include the following four cases:

(1) Case where applications are filed by the same applicant on the same date;
(2) Case where applications are filed by different applicants on the same date;
(3) Case where applications are filed by the same applicant on different

dates; and

(4) Case where applications are filed by different applicants on different dates.

Act 23

When examining applications filed on the same date under cases (1) and (2) and the later-filed application in condition (3), the first-to-file principle is applicable. The contents of this section regulate the three cases.

As to case (4) "Filed by different applicants on different dates," in case where the earlier-filed patent application has not yet been laid-open or published before the filing of the later-filed patent application but is laid-open or published after the filing of the later-filed patent application, the examination of the later-filed patent application is prioritized to apply for lack of novelty based on legal fiction.

Act 22. I

As to both cases (3) and (4) in which the patent applications are filed on different dates, if the earlier-filed patent application is laid-open or published before the filing of the later-filed patent application, the examination of the later-filed patent application is prioritized to apply for novelty.

### 5.2.3 Citations

Principles for determining whether an earlier-filed patent application or the other patent application filed on the same date can be used as a citation are as follows:

(1) Determination of whether the patent applications are filed sequentially or on the same date should be made based on the filing dates of the applications. If the patent application is a converted patent application or a divisional patent application, it should be determined based on the filing date of its parent patent application of the converted or divisional patent application. When the patent application claims an foreign or domestic priority, if the claimed invention concerned is disclosed in the description, claim(s), or drawing(s) of the priority basis application, it should be made based on the priority date of the invention. If the patent application claims two or more priorities, it should be made based on the priority date of each priority basis application in which each claimed invention is disclosed.

Act 28. Ⅱ、Ⅳ
Act 30. Ⅴ、Ⅵ

(2) For a patent application for invention or a patent application for utility model that has been withdrawn before being laid-open or published, has



Act 38.IV

been dismissed finally and bindingly by a notification, or rejected finally and bindingly by a decision or a notification, and for a patent application for invention which is deemed to have been withdrawn because a request for substantive examination was not filed within the time period prescribed in Paragraph 1 or 2 of Article 38 of the Patent Act, such a patent application shall not be used as a citation to determine whether a claimed invention is the same invention. Especially, the examiner shall not cite a patent application for invention or a patent application for utility model which has been rejected finally and bindingly as a citation. If appropriate, the examiner should use the citation(s) and the reason(s) for rejecting the earlier-filed patent application to reject the patent application.

(3) The earlier-filed patent application or the other patent application which is filed on the same date must be a patent application for invention or a patent application for utility model, and cannot be a patent application for design. This is because both invention and utility models belong to creations of technical ideals utilizing natural rules, and design is a creation of an article by visual appeal. No double patenting will exist between an invention and a design or between a utility model and a design. Hence, the first-to-file principle is not applicable.

**5.3 Principles of Examination of First-to-File Principle**

During determination of whether the inventions are identical, the invention of each claim should be examined individually and the opinion of each claim should be individually provided in the written opinion. If the technical contents disclosed in the descriptions of the two or more patent applications are identical, for example, both the patent applications disclose a specific article and a process for manufacturing the article, but the inventions set for in all the claims of the two or more patent applications are not identical, for example, one patent application claims for an article and the other patent application claims for a process for manufacturing the article, it should be determined that the inventions of the two or more patent applications are not identical.

"2.3 Principles of Examination of Novelty" of this Chapter applies *mutatis mutandis* to "Examination on Each Claim" and "Separate Comparison" in the determination of whether the inventions are identical.

## 5.4 Standards for Determination of First-to-File Principle

Standards for determination of the so-called "identical invention" include "5.5 Criterion for Determination on Whether Inventions Filed on the Same Day are Identical." In addition, the contents in "2.6.4 Criterion for Determination of Lack of Novelty based on Legal Fiction" are applicable *mutatis mutandis*. Namely, the standards also include the criteria (1) "totally identical," (2) "the difference only lies in the literal descriptions or in the technical features which can be directly or unambiguously deduced," (3) "the difference resides in the generic and specific concepts of the corresponding technical features," and (4) "the difference lies only in the technical features which can be directly substituted based on common general knowledge." During examination, in order to understand a claimed invention, the description, the claim(s), the drawing(s) and common general knowledge at the time of filing may be deliberated.

## 5.5 Criterion for Determination on Whether Inventions Filed on the Same Date are identical

"First-to-File Principle" refers to, when two or more patent applications are filed for one invention, the earlier-filed patent application for invention or utility model excluding the later-filed patent application. Between two patent applications filed on the same day, if only one is determined applicable to the Article and no patent right shall be granted thereto, and the other patent application is determined not applicable to the Article, the inconsistent determination is improper. It should be determined that the inventions in the two or more patent applications are not identical and the Article is not applicable. For example, if invention A of an earlier-filed patent application is expressed as a specific concept and invention B of a later-filed patent application is expressed as a generic concept, invention B will be deemed identical with invention A. However, if invention B is claimed in an earlier-filed patent application and invention A is claimed in a later-filed patent application, invention A will not be considered identical with invention B. When, however, both patent applications filed for inventions A and B are filed on the same date, it shall not be deemed that the two inventions are identical.

Therefore, when determining whether two or more patent applications filed on the same day are filed for the one invention, not only should "5.4

Standards for Determination of First-to-File Principle" be followed, but the examiner should further follow the following steps to make an adjustment. First, assuming invention A is claimed in an earlier-filed patent application and corresponding invention B is claimed in a later-filed patent application, if it is found that invention B and invention A are identical, and then the examiner should reverse the filing sequence of the two patent applications (i.e., assuming invention B is claimed in an earlier-filed patent application and invention A is claimed in a later-filed patent application), if it is still found that invention A and invention B are identical, the two inventions should be deemed the identical invention based on these two consistent results. On the other hand, if it is found that invention A and invention B are not identical, the two inventions should be deemed not the identical invention based on the two inconsistent results.

## 5.6 Procedures for Examination

### 5.6.1 Filed on Different Dates

When two or more patent applications are filed for one invention on different dates and the earlier-filed patent application has been laid-open or published before the filing of the later-filed patent application, the regulations regarding novelty should preferentially apply to the examination of the later-filed patent application. If the earlier-filed patent application has not yet been laid-open or published before the filing of the later-filed patent application, the examination of the later-filed patent application should be made according to the followings. Act 22. I (1)

#### 5.6.1.1 Filed by Different Applicants

If two or more patent applications for one invention are filed by different persons on different dates, the regulation regarding lack of novelty based on legal fiction should preferentially apply to the patent applications. However, the later-filed patent application shall be examined if only after the earlier-filed patent application has been laid-open or published. Because the subjects to be examined under "First-to-File Principle" are the claims of both the earlier-field patent application and the later-filed patent application, and the technical means disclosed in the claims of the earlier-filed patent application could be altered in view of the amendments made during prosecution but the technical contents disclosed in the description or drawing(s) of the earlier-filed patent application would not be altered in view

of the amendments made during prosecution. If the later-filed patent application is considered to fail to meet the first-to-file principle on the basis of the claims of the earlier-filed patent application, it is possible that the reasons for unpatentability would become not applicable in the future. Therefore, that the later-filed patent application is considered to lack novelty based on legal fiction according to the description or drawing(s) of the earlier-filed patent application benefits the applicant of the later-filed patent application to subsequently submit a response and an amendment.

In case where two or more patent applications for one invention are filed by different applicant on different dates, and the later-filed patent application does not entail any other grounds for unpatentability and is patentable, the examiner shall issue an office action stating that the later-filed patent application and the earlier-filed patent application are identical invention. If the later-filed patent application entails other grounds for unpatentability, the examiner should issue an office action stating the reasons for unpatentability as well as the reason that the later-filed patent application and the earlier-filed patent application are the same invention. After the specified time period, the examiner will continue the examination of the patent applications depending on conditions such as the amendment(s) made, withdrawal(s) filed, and response(s) issued to the earlier-filed patent application and the later-filed patent application, respectively. If it is still determined that the inventions are identical, the later-filed patent application should be rejected under the Patent Act, Article 23.

Act 23

### 5.6.1.2 Filed by the Same Applicant

Act 31.

When two or more patent applications for one invention are filed by the same applicant on different dates, if the later-filed patent application does not entail any other grounds for unpatentability and is patentable, the examiner should issue an office action stating that the later-filed patent application and the earlier-filed patent application are identical invention. If the later-filed patent application entails other grounds for unpatentability, the examiner should issue an office action stating the reasons for unpatentability as well as the reasons that the later-filed patent application and the earlier-filed patent application are identical invention. After the specified time period, the examiner shall continue examination of the patent applications depending on conditions such as amendment(s) made, withdrawal(s) filed, and response(s) issued to the earlier-filed patent

application and the later-filed patent application, respectively. If it is still determined that the inventions are the same, the later-filed patent application should be rejected under the Patent Act, Article 31, Paragraph 1.

### 5.6.2 Filed on the Same Date

When two or more patent applications for one invention are filed on the same date, the following four cases should be taken into consideration independently during examination: applicants are different or identical, and all patent applications have not yet been published or some patent applications have been published.

#### 5.6.2.1 Applicants are Different and all Patent Applications have not yet been Published

Act 31. Ⅱ

When two or more patent applications for one invention are filed by different applicants on the same date, if none of the relevant patent applications entail any other grounds for unpatentability and are patentable, the examiner should require the applicants of all relevant patent applications to reach an agreement with respect to the matter concerned and report the results of the negotiation. If the patent applications entail other grounds for unpatentability, the examiner should issue an office action stating the reasons for unpatentability as well as the reasons that the patent application and the other patent applications are identical. After the specified time period, the examiner should continue the examination depending on conditions such as amendment(s) made, withdrawal(s) filed, and response(s) issued to the relevant patent applications. If it still considers that those patent applications identical and do not entail any other grounds for unpatentability, the examiner should require the applicants to reach an agreement with respect to the matter concerned and report the results of the negotiation. If the applicants report the results of the negotiation within the specified time period, a patent right shall be granted to the patent application under the agreement after the other relevant patent applications have been withdrawn.

Act 31. Ⅲ

If the applicants do not reach an agreement or fail to report the results of the negotiation upon the specified time period has expired, it should be deemed that an agreement has not been reached, all the relevant patent applications should be rejected according to the Patent Act, Article 31, Paragraph 2.

### 5.6.2.2 Applicants are Different and one of the Patent Applications has been Published

Act 31. II

When two or more patent applications for the invention are filed by different applicants on the same date, if one of the patent applications has been published, and the other patent applications do not entail any other grounds for unpatentability and are patentable, the examiner should require the applicants to reach an agreement with respect to the matter concerned and report the results of the negotiation. If the other patent applications entail other grounds for unpatentability, the examiner should issue an office action stating the reasons for unpatentability as well as the reasons that the patent application and the other patent applications are identical. After the specified time period, the examiner should continue the examination depending on conditions such as amendment(s) made, withdrawal(s) filed, and response(s) issued to the relevant patent applications. If it still considers that the patent applications are identical but do not entail any other grounds for unpatentability, the examiner should require the applicants to reach an agreement with respect to the matter concerned and report the results of the negotiation

If the applicants report the results of the negotiation within the specific time limit, upon the other relevant patent applications being withdrawn, abandoned, or corrected, a patent right shall be granted to the patent application under the agreement after the other relevant patent applications have been withdrawn, and the other relevant patent has been abandoned or a post-grant amendment has been made thereto. Publication announcing that the relevant patent applications are deemed as non-existent from the beginning should be published. If the applicants do not reach an agreement or fail to report the results of the negotiation upon the specified time period has expired, it should be deemed that an agreement has not been reached, all the relevant patent applications pending should be rejected according to the Patent Act, Article 31, Paragraph 2, and the Specific Patent Agency should make a publication announcing that the relevant patent is deemed non-existent *ab initio*.

### 5.6.2.3 Applicants are the same and all Patent Applications have not yet been Published

When two or more patent applications for the same invention are filed by the same applicant on the same date, if none of the relevant patent applications entail any other grounds for unpatentability and are patentable, the examiner should require the applicant to select one application to be prosecuted within a specified time period. If there are other grounds for unpatentability, the examiner should issue an office action stating the reasons for unpatentability as well as the reasons that the patent application and the other patent applications identical. After the specified time period, the examiner should continue the examination depending on conditions such as amendment(s) made, withdrawal(s) filed, and response(s) issued to the relevant patent applications. If the applicant fails to make a selection, and all the relevant patent applications are still deemed identical invention, all the relevant patent applications should be rejected according to the Patent Act, Article 31, Paragraph 2.

Act 31. Ⅱ

### 5.6.2.4 Applicants are the same and one of the Patent Applications has been Published

When two or more applications for the same invention are filed by the same person on the same date, if one of the applications is published, and if none of the other applications entail any other grounds for unpatentability and are allowable, the examiner should require the applicant to select one application to be prosecuted within a specified time period. If there are other grounds for unpatentability, the examiner should issue an office action stating the reasons for unpatentability as well as the reasons that the patent application and the other patent applications are identical. After the specified time period, the examiner should continue the examination depending on conditions such as amendment(s) made, withdrawal(s) filed, and response(s) issued to the relevant patent applications. If the applicant selects one application within the specified time period, the selected patent application should be granted a patent after the other relevant patent applications have been withdrawn, and the other relevant patent has been abandoned or a post-grant amendment has been made thereto. Furthermore, the Specific Patent Agency should make a publication announcing that the relevant patent is deemed non-existent *ab initio*. If the applicant fails to make a selection, and all the relevant patent applications are still deemed

Act 31. Ⅱ

identical, all the relevant patent applications pending should be rejected according to the Patent Act, Article 31, Paragraph 2, and the Specific Patent Agency should make a publication announcing that the relevant patent is deemed non-existent *ab initio*. If the applicant selects the published patent, and all the relevant cases are still deemed identical, all the relevant patent applications pending should be rejected according to the Patent Act, Article 31, Paragraph 2.

### 5.7 Continuation of Patent Rights

Act 32 I
Act 32 II
Act 32 III

After June 13, 2013, In case where the same applicant respectively files a patent application for invention and a patent application for utility model for the same creation in the ROC on the same date, where the applicant makes respective declarations in respect of the applications, where the patent application for utility model has been granted before an approval decision on the patent application for invention is rendered, and where the utility model patent right has not become extinguished or has not been revoked finally and bindingly, if the applicant selects the utility model patent right or fails to make a selection within the specified time period, the patent application for invention shall not be granted. Otherwise, if the applicant selects the patent application for invention, the utility model patent right shall become extinguished on the publication date of the invention patent.

Continuation of patent rights is applicable if only both the invention patent right and the utility model patent right meet the requirements "filed by the same applicant," "filed on the same date," " the same creation," "respective declarations in respect of the said applications being made at the time of filing," and "the utility model having been granted, and the utility model patent right not having become extinguished or not having been revoked finally and bindingly." Even when an invention patent right and an utility model patent right are "the same creation," continuation of patent rights is not applicable, if any of the requirements "filed by the same person," "filed on the same date," "respective declarations in respect of the said applications being made at the time of filing" is not fulfilled at the time of filing, or any of the requirements "filed by the same person," and "the utility model having been granted, and the utility model patent right not having become extinguished or having not been revoked finally and bindingly" is not fulfilled before the patent application for invention being rendered.

In view of the particularity of continuation of patent rights, the mentioned requirements are further explained as follows:

(1)The term "filed by the same applicant" as used herein represents that the applicant(s) of a patent application for invention and the applicant(s) of a patent application for utility model are totally the same at the time when filing the patent applications in the ROC, when making a selection been notified, when the patent application for invention to be rendered, and when the patent for invention is to be published.

After the applications have been filed and before the patent application for invention is to be rendered, if there is an assignment, both the invention patent and the utility model patent need to be assigned together. If an assignment makes the applicants of the patent applications for invention and utility model not totally the same, or the applicant(s) of the patent application for invention and the patentee(s) of utility model not totally the same, the patent application for invention should be examined based on the first-to-file principle (see "5.6.2.2 Applicants are Different and one of the Patent Applications has been Published") since a selection cannot be made by different applicants within the specified time period. Act 31.

(2)The term "filed on the same date" as used herein represents that the filing dates (the date on which the application form, description, claim(s) and the necessary drawing(s) are provided in full in the ROC) of the patent applications for invention and utility model which claim the same creation are the same. If the same creation claim priority , the priority dates of the patent applications for invention and utility model also need to be the same. It should be noted that the mentioned priority date is not necessary to be later than June 13, 2013. Act 25.Ⅱ

If the priority dates of the identical creation are different (which includes that only one application claims priority, and that the priority dates of the two applications are respectively different),the patent application for invention and the patent application for utility model should be deemed not to have been filed on the same date, and thus the patent application for invention should be examined based on the first-to-file principle(see "5.6.1.2 Filed by the Same Applicant"). Act 28.Ⅰ、30.Ⅰ

In case where a patent application for invention(parent application) and a patent application for utility model file on the same date, the filing date of a patent application for invention divided from the parent application must the same as that of the patent application for utility model.

(3)The term "identical creation" as used herein represents that at least one of claimed invention in a patent application for invention is identical with one of the claimed utility model in a patent application for utility model.

The contents of "5.3 Principles of Examination of First-to-File Principle" and "5.5 Criterion for Determination on Whether Inventions Filed on the Same Day are Identical" apply *mutatis mutandis* to the principles, standards, and ways to determine whether creations having the same filing date are identical..

(4)The term "respective declarations in respect of the said applications being made on the filing date" as used herein represents when the identical creation has been separately filed in different applications on the same date has been respectively declared on the filing date in both the application form of the patent application for invention and the application form of the patent application for utility model.

Act 31. II

If the applicant fails to make any declaration for both patent applications, or fails to make a declaration for either of the two applications, both the patent applications are considered to have failed to meet requirements. In such case, the patent application for invention should be examined based on the first-to-file principle (refers to "5.6.2.4 Applicants are the same and one of the Patent Applications has been Published").

If declarations were respectively made for the patent application for invention and the patent application for utility model at the date of filing, and if the identical creation is divided from the patent application for invention(parent application) thereafter, the declaration of the original application for invention may be invoked at the time of filing the divisional application; however, no declaration shall be supplemented afterwards.

If the same creation still exists before the approval and decision of either the original application or the divisional application, the applicant shall be notified to identify a unique application for invention as the continued application, so as to comply with the legislative intent that allows for the continuation of patent rights when an application for invention and an application for utility model are respectively filed for the same creation on the same date in the R.O.C.

(5)The condition "the utility model having being granted, and the utility model patent right not having become extinguished or not having been revoked finally and bindingly" occurs when a utility model patent can be

obtained faster than an invention patent because only a formality examination is conducted on a patent application for utility model but a substantive examination is conducted on a patent application for invention, and the utility model patent can exist continually. According to the Patent Art, Article 70, Paragraph 1, Item 3, the term "become extinguished" means that the annuity of the utility patent is not paid within the 6-month time period for late payment, and that the utility model patent right has not been allowed to reinstate and exist continually before an approval decision (either at the first examination stage or the re-examination stage) on the patent application for invention is rendered; and the term "been revoked finally and bindingly" means that an invalidation decision revoking the utility model patent has become final and binding.

Act 120 applies mutatis mutandis to Art 70

Act 119

If the utility model patent right has become extinguished or has been revoked finally and bindingly before a decision is rendered on the patent application for invention, the patent application for invention should be rejected.

Act 32.III

### 5.7.1 Procedures for Examination

When the same applicant has respectively filed, after June 13, 2013, a patent application for invention and a patent application for utility model based on the identical creation in the ROC on the same date, and the applicant has made respective declarations in respect of said applications on the date of filing, that after conducting a formality examination, the patent application for the utility model has been published as a utility model patent, and that the utility model patent right has not become extinguished or has not been revoked finally and bindingly, if the patent application for invention does not entail any other grounds for unpatentability and is patentable, the examiner should notify the applicant to make a selection between the patent application for invention and the utility model patent right within a specified time period; and if the patent application for invention entails other grounds for unpatentability, the examiner should issue an office action stating the reasons for unpatentability as well as the reason that the patent application for invention and the utility model patent are the same creation so that after overcoming the reasons for unpatentability stated in the office action, the applicant can rapidly obtain the invention patent right based on the selection made to achieve the effect of continuation of patent rights.

After the specified time period, the examiner should continue examination depending on the amendment made, withdrawal filed, and response issued to the patent application for invention, and the post-grant amendment made to the utility model patent. If the applicant fails to make a selection when making an amendment and a response, after the reasons for unpatentability stated in the previous office action have been overcome and the patent application for invention has become allowable, the examiner should further require the applicant to make a selection between the patent application for invention and the utility model patent right within a specified time period. If the applicant fails to make a selection once the specified time period has expired or selects the utility model patent right, and they are still deemed the same creation, the patent application for invention is rejected according to the Patent Act, Article 32, Paragraph 1. If the applicant selects the patent application for invention, according to the Patent Act, Article 32, Paragraph 2, the utility model patent right shall become extinguished on the publication date of the invention patent.

Act 32 II

### 5.7.2 Notes for Examination

(1) After the patent application for invention has been allowed and before the invention patent is published, if an assignment makes the applicant(s) of the patent application for invention and the patentee(s) of the utility model patent become not totally the same, the invention patent should not be published because it does not meet the "filed by the same applicant" requirement.

(2) If any reasons for unpatentability are found after examination, all reasons for unpatentability regarding the claims should be stated in as much detail as possible in the office action to notify the applicant (please see "1.3 Office Action" of Chapter 7 of this part). Therefore, the regulation "if the patent application for utility model has been granted before an approval decision on the patent application for invention is rendered, the Specific Patent Agency shall notify the applicant to make a selection within a specified time period" set forth in the Patent Act, Article 32, Paragraph 1 means that after the Specific Patent Agency notifies the applicant that the patent application for invention and the utility model patent are the same creation and that the patent application for invention entails the other grounds for unpatentability, if the applicant selects the patent application for invention when making an amendment and a response, and overcomes

the other grounds for unpatentability stated in the previous office action, an invention patent should be issued; and if the applicant fails to make a selection when making an amendment and a response, but the other grounds for unpatentability stated in the previous office action have been overcome and the patent application for invention has become allowable, a further notification should be issued to require the applicant to make a selection between the patent application for invention and the utility model patent right within a specified time period. If the amendment and response made by the applicant cannot overcome the other grounds for unpatentability stated in the previous office action irrespective of whether the applicant has selected the patent application for invention, the patent application for invention should be rejected because the patent application for invention does not meet the requirements for patentability. No further notification needs to be issued to require the applicant to make a selection within a specified time period as stipulated.

(3) If the applicant has been notified and has selected the patent application for invention within the specified time period, and the patent application for invention has no other grounds for unpatentability and is patentable, the utility model patent right shall become extinguished on the publication date of the invention patent according to the Patent Act, Article 32, Paragraph 2. If it is found that the patent application for invention still has any grounds for unpatentability as stated in the previous office action, the patent application for invention will be rejected, and thus publication of invention patent will no longer occur. The legal effect of the utility model patent right becoming extinguished will not occur even if the selection of the patent application of invention has been made by the applicant.

(4) After the patent application for invention is allowed and before the invention patent is published, if the utility model patent right becomes extinguished and been revoked finally and bindingly, the invention patent shall not be published because the techniques disclosed in the utility model patent have become those which can be freely used by the public. If the disclosed techniques are reinstated to be an exclusive right of the applicant of the patent application for invention, the public can suffer disadvantages.

(5) During the examination of an invention patent application, if an invalidation action against a utility model patent has been decided to be

well grounded but has not yet become final and binding, the determination for the invention directed to the same creation shall remain consistent with the determination result of the utility model patent. In principle, the examination of the invention patent application shall be continued after the administrative remedy for the invalidation action has become final and binding. However, depending on the circumstances of the case (e.g., the facts and evidence have become clear enough to establish that the invention application does not meet the requirements for patentability) or a change in circumstances (e.g., the applicant has amended the claims such that they are no longer directed to the same creation), the examiner may proceed with the examination of the invention patent application after considering the invalidation evidence of the utility model case.

(6) After the approval decision for the invention patent application and before the invention patent is published, if an invalidation action against the utility model patent has been decided to be well grounded but has not yet become final and binding, the results of the examination for the utility model and the invention based on the same creation shall be consistent. In such a case, the examiner shall withdraw the approval decision for the invention patent application and conduct examination. The examination principle is the same with the preceding item.

### 5.8 Alternative of Patent Rights

Pre-amended Art 32. I
Pre-amended Art 32. III
Pre-amended Art 32. II

Where the same applicant has respectively filed, prior to June 13, 2013, a patent application for invention and a patent application for utility model based on one creation in the ROC on the same date, the utility model patent has been issued before an approval decision on the patent application for invention is rendered, and the utility model patent right has not become extinguished or been revoked finally and bindingly, if the applicant selects the utility model patent right or fails to make a selection once the specified time period has expired, the patent application for invention shall not be granted a patent; and if the applicant selects the patent application for invention, the utility model patent right shall be deemed non-existent *ab initio*.

When a patent application for invention and a patent application for utility model belong to "the same creation," at the time of filing, if the applications do not meet any of the requirements "filed by the same person"

and "filed on the same date," or before being notified to make a selection within a specified time period, if he applications do not meet any of the requirements "filed by the same person" and "the utility model having being granted, and the utility model patent right has not become extinguished or been revoked finally and bindingly," neither application applies to alternative of patent rights.

Pre-amended Art 32. I、III

The meanings of the requirements "filed on the same date," "belonging to the same creation," and "the utility model having been granted, and the utility model patent right not having become extinguished or not having been revoked finally and bindingly" for both the alternative of patent rights effected before June 13, 2013 and the continuation of patent rights effected after June 13, 2013 are substantially the same, and the contents of "5.7 Continuation of Patent Rights" and "item (2) of 5.7.2 Notes for Examination" apply *mutatis mutandis* to the alternative of patent rights. It should be noted that the alternative of patent rights does not have the requirement "respective declarations in respect of the said applications being made at the time of filing" as required by the continuation of patent rights. Regarding the requirement "the same person," the alternative of patent rights requires only that the applicant(s) of a patent application for invention and the applicant(s) of a patent application for utility model are totally the same at the time when filing the patent applications in the ROC; and that the applicant(s) of the patent application for invention and the patentee(s) of utility model are also the same at the time when being notified to make selection. Said requirement for the alternative of patent rights is slightly different from that for the continuation of patent rights.

Pre-amended Art 32. I

Pre-amended Art 32. II

The effect of the alternative of patent rights effected before June 13, 2013 and the effect of the continuation of patent rights effected after June 13, 2013 are different in that if the applicant selects the patent application for invention within the specified time period, under the alternative of patent rights, the utility model patent right will be deemed non-existent *ab initio*, but under the continuation of patent rights, the utility model patent right will become extinguished on the publication date of the invention patent.

The contents of "5.7.1 Procedures for Examination" apply *mutatis mutandis* to the examination procedure of the alternative of patent rights. However, since the effect of the alternative of patent rights differs from the effect of the continuation of patent rights, if the applicant selects the patent

application for invention, the information that the utility model patent right is deemed non-existent *ab initio* should be published based on the pre-amended Patent Act, Article 32, Paragraph 2.