

# Patent Act

(as amended in 2011)

1. Promulgated on May 29, 1944 by the Government; effective on January 1, 1949
2. Amended and Promulgated on January 22, 1959 by Presidential Order
3. Amended and Promulgated on May 12, 1960 by Presidential Order
4. Amended and Promulgated on April 16, 1979 by Presidential Order
5. Amended and Promulgated on December 24, 1986 by Presidential Order
6. Amended and Promulgated on January 21, 1994 by Presidential Order
7. Amended and Promulgated on May 7, 1997 by Presidential Order; effective on January 1, 2002
8. Amended and Promulgated on October 24, 2001 by Presidential Order
9. Amended and Promulgated on February 6, 2003 by Presidential Order; effective on July 1, 2004
10. Amended and Promulgated on August 25, 2010 by Presidential Order; effective on September 12, 2010
11. Amended and Promulgated on December 21, 2011 by Presidential Order

(The 2011 Amendment will be effective on January 1, 2013)

## Table of Content

### Chapter 1 General Provisions

Article 1 Purpose

Article 2 Categories of patents

Article 3 Competent authority

Article 4 Acceptance of foreign application

Article 5 Right to apply for patent

Article 6 Transference and pledge of patent

Article 7 Invention made in the performance of duties

Article 8 Invention irrelevant to the performance of duties

Article 9 Protection of employees' legitimate rights

Article 10 Agreement on ownership

Article 11 Patent agency

Article 12 Joint application

Article 13 Co-ownership of the right to apply for patent

Article 14 Recordation to have *Locus standi* against a third party: transference of right to apply for patent

Article 15 Duty of confidentiality of staff members and patent examiners

Article 16 Avoiding conflict of interests by patent examiners

Article 17 Delay and reinstatement

Article 18 Service by publication

Article 19 E-filing

Article 20 Calculation of time periods

### Chapter II Invention Patent

#### Section 1: Patentability

Article 21 Definition of invention

Article 22 Substantial conditions

Article 23 Deemed as lack of novelty

Article 24 Statutory exclusion

## **Section 2: Application**

Article 25 Filing date

Article 26 Disclosure

Article 27 Deposit of biological material

Article 28 Priority claim under WTO membership, etc.

Article 29 Claim of priority

Article 30 Priority claim based on earlier application

Article 31 Principle of first-to-file

Article 32 One creation applied for invention patent and utility model patent

Article 33 Unity

Article 34 Division of application

Article 35 Invalidation request filed by genuine holder of right to apply for a  
patent

## **Section 3: Examination and Reexamination**

Article 36 Assignment of examiner for examination

Article 37 Early publication of patent application

Article 38 Request for substantive examination

Article 39 Request Procedure for substantive examination

Article 40 Prioritized examination of invention patent application

Article 41 Effect of the laying open of application

Article 42 Interview and inspection in examination of application

Article 43 Amendment during examination; final notice

Article 44 Foreign language documents

Article 45 Decision of examination

Article 46 Grounds for rejection decision

Article 47 Publication of patented invention and application for viewing

Article 48 Reexamination

Article 49 Amendment during reexamination

Article 50 Assignment of examiner for reexamination

Article 51 Confidentiality of invention involving national security

#### **Section 4: Patent Rights**

Article 52 Payment of fees and publication

Article 53 Extension of patent term

Article 54 Deemed as extended

Article 55 Assignment of examiner for extension application

Article 56 Scope of patent term extension

Article 57 Invalidation of patent term extension

Article 58 Effects of invention patent right

Article 59 Limitations of patent right

Article 60 Limitations of patent right: research and trials of pharmaceuticals

Article 61 Limitations of patent right: dispensation of medicines

Article 62 Recordation to have *Locus standi* against a third party: transference of  
patent right

Article 63 Sub-license

Article 64 Disposal of jointly-owned patent right

Article 65 Disposal of one's own share of jointly-owned patent right

Article 66 Prolongation of patent term

Article 67 Amendment of granted patent

Article 68 Examination of amendment

Article 69 Restriction of abandonment or amendment of patent right

Article 70 Extinguishment of patent right

Article 71 Grounds for invalidation

Article 72 Invalidation against extinguished patent

Article 73 Invalidation request

Article 74 Invalidation proceedings

Article 75 Principle of *Ex officio*

Article 76 Interview and inspection in invalidation proceedings

Article 77 Joint proceedings of invalidation and amendment

Article 78 Joint proceedings of multiple invalidation requests

Article 79 Assignment of examiner for invalidation

Article 80 Restriction of withdrawal of invalidation

Article 81 Principle of *ne bis in idem*

Article 82 Decision of invalidation

Article 83 Procedures to be applied *mutatis mutandis* to invalidation against  
patent term extension

Article 84 Publication in the Patent Gazettes

Article 85 Patent Registry

Article 86 Publication by electronic means

### **Section 5 Compulsory Licensing**

Article 87 Grounds for compulsory licensing

Article 88 Procedure and decision of compulsory license

Article 89 Termination of compulsory license

Article 90 Compulsory licensing of pharmaceuticals: grounds; procedures

Article 91 Compulsory licensing of pharmaceuticals: export; remuneration

### **Section 6: Payment of Fees**

Article 92 Fees

Article 93 Time limit on payment of annuity

Article 94 Addition of annuity

Article 95 Reduction of annuity

## **Section 7 Damages and Action**

Article 96 Right to claim in the event of patent right infringement

Article 97 Calculation of damages

Article 98 Marking of patent certificate number

Article 99 Presumption of manufacture process used

Article 100 Forwarding an original copy of judgment

Article 101 Acceleration of invalidation proceedings

Article 102 Unrecognized foreign juridical person or organization

Article 103 Patent infringement assessment

## **Chapter III Utility Model Patent**

Article 104 Definition of utility model

Article 105 Statutory exclusion

Article 106 Filing date

Article 107 Division of application

Article 108 Conversion of application

Article 109 Amendment of application

Article 110 Foreign language documents

Article 111 Decision of application

Article 112 Formality examination

Article 113 Grant of patent; publication

Article 114 Term of patent

Article 115 Request of technical report

Article 116 Presentation of technical report

Article 117 Liability of damages; immunity

Article 118 Amendment of granted patent

Article 119 Grounds of invalidation

Article 120 Provisions applied *mutatis mutandis* to utility model patent

## **Chapter IV Design Patent**

Article 121 Definition of design

Article 122 Substantial conditions

Article 123 Deemed as lack of novelty

Article 124 Statutory exclusion

Article 125 Filing date

Article 126 Disclosure

Article 127 Application and restriction of derivative design patent

Article 128 Principle of first-to-file

Article 129 Unity; design for a set of articles

Article 130 Division of application

Article 131 Conversion between design patent and derivative design patent

Article 132 Conversion into design patent

Article 133 Foreign language documents

Article 134 Grounds for rejection decision

Article 135 Term of patent

Article 136 Effects of design patent right

Article 137 Claim of derivative design patent

Article 138 Disposal of derivative design patent

Article 139 Amendment of granted design patent

Article 140 Restriction of abandon of design patent right

Article 141 Grounds for invalidation

Article 142 Provisions applied *mutatis mutandis* to design patent

## **Chapter V Supplementary Provisions**

Article 143 Preservation of patent files

Article 144 Prescription of regulations governing awards for creations

Article 145 Prescription of regulations governing submission of foreign language documents

Article 146 Prescription of regulations governing fees

Article 147 Transitional provisions: patent term extension

Article 148 Transitional provisions: patent term

Article 149 Transitional provisions: pending cases

Article 150 Transitional provisions: Priority claim based on earlier application; division

Article 151 Transitional provisions: grace period; design patent

Article 152 Transitional provisions: deposit of biological material

Article 153 Transitional provisions: Priority claim under WTO membership, etc.

Article 154 Transitional provisions: request for extending patent term

Article 155 Transitional provisions: no revival of extinguished patent right

Article 156 Transitional provisions: pending design patent application

Article 157 Transitional provisions: pending associated design patent application

Article 158 Prescription of Enforcement Rules

Article 159 Date of implementation

## **Chapter 1 General Provisions**

### **Article 1 Purpose**

This Act is enacted for the encouragement, protection and utilization of creations of inventions, utility models and designs in order to promote the development of industry.

### **Article 2 Categories of patents**

The term "patent" referred to in this Act is classified into the following three categories:

1. invention patents;
2. utility model patents; and
3. design patents.

### **Article 3 Competent authority**

The "competent authority" as referred to in this Act is the Ministry of Economic Affairs (hereinafter as the MOEA).

Patent affairs shall be administrated by a specific agency appointed by the MOEA.

### **Article 4 Acceptance of foreign application**

A patent application filed by a foreign applicant shall not be accepted if the home country of such foreign applicant is not a signatory to an international treaty for protection of patent right to which the Republic of China (ROC) is a signatory, or if the home country does not conclude with the ROC a treaty or an agreement for reciprocal protection of patent rights, or if no patent protection agreement is concluded by and between organizations or institutions of the ROC and said foreign country which has been approved by the competent authority, or if the laws of said foreign country do not accept

patent applications filed by nationals of the ROC.

#### **Article 5 Right to apply for patent**

The term "right to apply for a patent" shall mean the right to file a patent application in accordance with the provisions of this Act.

Subject to provisions in this Act otherwise provided for or the covenants otherwise set forth in an agreement, the term "the owner of the right to apply for a patent" shall mean an inventor, utility model creator, designer or his/her assignee or successor.

#### **Article 6 Transference and pledge of patent**

The right to apply for a patent or the patent right is both assignable and inheritable.

The right to apply for a patent shall not be taken as the subject of a pledge.

In the case of taking a patent right as the subject of a pledge, the pledgee shall not be allowed to exploit the patent right, unless it is otherwise provided for in an agreement.

#### **Article 7 Invention made in the performance of duties**

Where an invention or a utility model or a design is made by an employee in the performance of his/her job duties, the right to apply for a patent and the patent right thereof shall be vested in his/her employer and the employer shall pay the employee reasonable remuneration; where there is an agreement providing otherwise, such agreement shall prevail.

The phrase "an invention, or a utility model or a design made by an employee under the performance of his/her job duties" as set forth in the preceding paragraph shall mean the invention, utility model, or design completed by an employee in performing his/her job duties during the period of his/her employment.

Where a fund provider engages another party to conduct research and development, the ownership of the right to apply for a patent and the patent right in connection with the outcome of such research and development shall be vested in the party as mutually agreed upon in an agreement between both parties, or such right shall be vested in the inventor, utility model creator or designer in the absence of such covenant in the agreement. However, the fund provider shall be entitled to exploit such invention, utility model or design.

Where the ownership of the right to apply for a patent and the patent right are vested in the employer or the fund provider under Paragraph 1 or the preceding paragraph, the inventor, utility model creator or the designer concerned shall be entitled to a right to have his/her name shown as such.

#### **Article 8 Invention irrelevant to the performance of duties**

Where an invention, utility model or design made by an employee has no connection to the performance of his/her job duties, the right to apply for a patent and the patent right for such invention, utility model or design shall be vested in the employee. However, if such invention, utility model or design is made through utilization of the employer's resources or experience, the employer may, after paying the employee a reasonable remuneration, exploit the invention, utility model or design concerned in its enterprise.

Upon completion of an invention, utility model or design by an employee, which has no connection to the performance of his/her job duties, the employee shall give his/her employer notice in writing of such event and shall inform his/her employer of the process of the innovation, if necessary.

If the employer fails to raise any objection to the employee within six months after receiving the employee's written notice under the preceding paragraph, the employer shall not claim that such invention, utility model or design was made by the said employee in the performance of his/her job duties.

**Article 9 Protection of employees' legitimate rights**

An agreement concluded between an employer and an employee as stated in the preceding Article, based on which the employee is precluded from enjoying his/her legitimate rights and interests in respect of his/her invention, utility model, or design shall become void.

**Article 10 Agreement on ownership**

Where an agreement has been reached by an employer and its employee regarding a dispute over attribution of rights as set forth in Articles 7 and 8 of this Act, the employer or employee concerned may file an application along with relevant evidentiary documents with the Specific Patent Agency for change of ownership of the right involved. The Specific Patent Agency may, as it deems necessary, notify the parties involved to submit documents relevant to any mediation, arbitration or court judgment rendered in accordance with other laws and regulations.

**Article 11 Patent agency**

An applicant, holder or other interested person may designate an agent to file patent applications or handle patent-related matters on his/her behalf.

An applicant, holder or other interested person who has no domicile or business establishment in the territory of the ROC shall designate an agent to file patent applications or handle patent-related matters on his/her behalf.

Eligible agents shall be limited to patent attorneys, unless otherwise provided for by laws and regulations.

The qualification and administration of patent attorneys shall be prescribed by separate laws.

**Article 12 Joint application**

Where a right to apply for a patent is jointly owned by two or more persons, the patent application related thereto shall be filed by all the joint

applicants.

Where two or more persons engage in any patent-related procedure other than filing a patent application, each of them may complete such procedure independently, except for making a withdrawal or an abandonment of a patent application, filing a divisional application or a converted application, or taking other actions for which this Act requires execution by all the joint applicants. However, if a representative is designated by a mutual covenant of all the joint applicants, such covenant shall prevail.

In the case of an event requiring execution of all the joint applicants as set forth in the preceding two paragraphs, one of the joint applicants shall be appointed as the recipient of service of documents. In the absence of such a representative, the Specific Patent Agency shall name the first-listed joint applicant as the recipient of service of documents and shall advise other joint applicant(s) of such service matters.

#### **Article 13 Co-ownership of the right to apply for patent**

Where the right to apply for a patent is jointly owned, the right to apply for the patent shall not be assigned or abandoned without the consent of all joint applicants.

Where the right to apply for the patent is jointly owned by two or more persons, none of the joint applicants shall assign his/her own share therein to a third party without the consent of other joint applicant(s).

Where one of the owners of the right to apply for the patent abandons his/her own share, this share shall be vested in other joint owner(s).

#### **Article 14 Recordation to have *Locus standi* against a third party: transference of right to apply for patent**

In the case of an inheritance or assignment of the right to apply for a patent, the successor or the assignee shall have no locus standi against any

third party unless the patent application has been filed in the name of the successor or the assignee at the time of filing, or a request has been filed thereafter with the Specific Patent Agency for recordation of change in applicant.

The request referred to in the preceding paragraph, whether for assignment or inheritance, shall be accompanied by evidentiary documents.

#### **Article 15 Duty of confidentiality of staff members and patent examiners**

While serving with the Specific Patent Agency, a staff member or a patent examiner shall not apply for a patent or receive any rights or interests in connection with such patent directly or indirectly, except for inheritance.

Staff members or patent examiners of the Specific Patent Agency are obligated to keep confidential any invention, utility model, or design, or the trade secrets of an applicant, which have become known to or been possessed by them in the course of performing their duties; whoever violates such obligation shall bear relevant legal responsibility.

The qualification of patent examiners shall be prescribed separately by laws.

#### **Article 16 Avoiding conflict of interests by patent examiners**

Under any of the following circumstances, a patent examiner shall exclude himself/herself from performing the duties concerned:

1. where, for a concerned patent case, the patent examiner or his/her spouse is the patent applicant, patentee, invalidation petitioner, patent agent, or a partner of the said patent agent or a person having employment relationship with the patent agent;

2. where, for a concerned patent case, the patent examiner is presently related to the patent applicant, patentee, invalidation petitioner or the patent agent by consanguinity within the fourth degree or by affinity within the third degree;

3. where, for a concerned patent case, the patent examiner or his/her spouse and the patent applicant, patentee or invalidation petitioner are common obligee(s), obligor(s), or debt-paying obligor(s);

4. where the patent examiner is or was the legal representative, the family head or a household member of the patent applicant, patentee or invalidation petitioner;

5. where the patent examiner is or was a litigation agent of the patent applicant, patentee or invalidation petitioner, or is or was the assisting party thereof; or

6. where, for a concerned patent case, the examiner is or was a witness, an expert witness, an opposition petitioner or an invalidation petitioner.

Where an examiner should have but did not exclude himself/herself from performing his/her functions, the Specific Patent Agency may, upon request or on its own authority, revoke the measure(s) already taken and adopt an alternative measure instead.

#### **Article 17 Delay and reinstatement**

Unless otherwise provided in this Act, where a person filing a patent application or taking other proceeding in connection with patent matters has failed to comply within a statutory or specified time limit, the application filed or the proceeding initiated by him/her shall be dismissed. However, if the delay in not acting within a specified time limit has been corrected before the dismissal is rendered by the Specific Patent Agency, such application or proceeding shall still be accepted.

If the delay is caused by natural calamity or other cause(s) not attributable to the applicant, the applicant may, within thirty days after cessation of such cause, request with the Specific Patent Agency stating the cause(s) for delay and requesting for reinstatement. An application for reinstatement shall not be accepted if delay has exceeded one year from the expiration of a statutory time limit.

While applying for reinstatement, the applicant shall concurrently complete the application that should have been fulfilled by him/her within the concerned time limit.

The preceding two paragraphs shall not apply to a delay beyond the time limits as set forth in each of Paragraph 4 of Article 29, Paragraph 4 of Article 52, Paragraph 2 of Article 70, Paragraph 4 of Article 29 applicable mutatis mutandis under Article 120, Paragraph 4 of Article 52 applicable mutatis mutandis under Article 120; Paragraph 2 of Article 70 applicable mutatis mutandis under Article 120; Paragraph 4 of Article 29 applicable mutatis mutandis under Paragraph 1 of Article 142; Paragraph 4 of Article 52 applicable mutatis mutandis under Paragraph 1 of Article 142 and Paragraph 2 of Article 70 applicable mutatis mutandis under Paragraph 1 of Article 142.

#### **Article 18 Service by publication**

Where an examination decision or any other document cannot be served, such decision or document shall be published in the Patent Gazette and shall be deemed having been duly served thirty days after the date of publication.

#### **Article 19 E-filing**

Application for patent and other relevant proceedings may be effected by means of electronic communications, of which the implementation shall be prescribed by the competent authority.

#### **Article 20 Calculation of time periods**

The duration of relevant time periods as specified in this Act shall not include the beginning date thereof.

The duration of the patent right as specified respectively in Paragraph 3 of Article 52, Article 114 and Article 135 of this Act shall start to run from the filing date of the patent application concerned.

## Chapter II Invention Patent

### Section 1: Patentability

#### Article 21 Definition of invention

"Invention" means the creation of technical ideas, utilizing the laws of nature.

#### Article 22 Substantial conditions

An invention which is industrially applicable may be granted a patent upon application in accordance with this Act, except for the following:

1. the invention was disclosed in a publication prior to the filing of the patent application;
2. the invention was publicly exploited prior to the filing of the patent application; or
3. the invention was publicly known prior to the filing of the patent application.

Where an invention can be easily made by a person ordinarily skilled in the art based on prior art, a patent shall not be granted for such an invention notwithstanding the preceding paragraph.

Any of the following events shall not be deemed as one prescribed in Paragraph 1 or the preceding paragraph, which may preclude the grant of an invention patent, provided that the concerned patent application is filed within six months from the date of the event's occurrence:

1. the invention concerned was publicly disclosed as a result of conducting a test;
2. the invention was disclosed in a publication;
3. the invention was displayed at an exhibition held or recognized by the Government; or
4. the invention was disclosed without the consent of the applicant.

An applicant claiming exemption as set forth in Item 1 through Item 3 of the preceding paragraph shall state the fact and the relevant date in the patent

application at the time of filing and submit evidentiary documents within the time limit specified by the Specific Patent Agency.

#### **Article 23 Deemed as lack of novelty**

A patent shall not be granted invention where such invention claimed in a patent application is identical with an invention or utility model disclosed in the description, claim(s) or drawing(s) of an earlier-filed invention or utility model patent application which is laid open or published after the filing of the later-filed patent application; however, this shall not apply where the applicant of the later-filed patent application is the same as the applicant of the earlier-filed invention or utility model patent application.

#### **Article 24 Statutory exclusion**

An invention patent shall not be granted in respect of any of the following:

1. animals, plants, and essential biological processes for the production of animals or plants, except processes for producing microorganisms;
2. diagnostic, therapeutic and surgical methods for the treatment of humans or animals;
3. inventions contrary to public order or morality.

### **Section 2: Application**

#### **Article 25 Filing date**

An application for an invention patent shall be filed with the Specific Patent Agency by the person entitled to applying for patent by submitting a request, a description, claim(s), an abstract, and the necessary drawing(s).

The filing date of an invention patent application shall be the date on which the request, description, claim(s), and the necessary drawing(s) are submitted in full.

Where an applicant does not submit a description, claim(s) and the

necessary drawing(s) in Chinese at the time of filing, but in a foreign language, and where the Chinese translation for the said documents is submitted within the time limit specified by the Specific Patent Agency, the filing date shall be the date on which the foreign language version were originally submitted.

Where the Chinese translation is not submitted within the specified time limit as stated in the preceding paragraph, the patent application shall be dismissed; however, if the Chinese translation is filed prior to the dismissal decision is received, the date on which the Chinese translation is filed shall be regarded as the filing date, and the foreign language version shall be deemed not having been submitted.

#### **Article 26 Disclosure**

A description shall disclose the invention in a manner clear and sufficient for it to be understood and carried out by a person ordinarily skilled in the art.

Claim(s) shall define the claimed invention, and more than one claim can be included therein. Each claim shall be disclosed in a clear and concise manner and be supported by the description.

An abstract shall clearly contain a summary of the disclosed invention; it shall not be taken into account for the purpose of determining the sufficiency of the disclosure and the patentability of the claimed invention.

Manner of disclosure for description, claim(s), abstract, and drawing(s) shall be prescribed in the Enforcement Rules of the Patent Act.

#### **Article 27 Deposit of biological material**

When filing an invention patent application involving a biological material or utilization of a biological material, the applicant shall, no later than the filing date, make a deposit of the biological material with a domestic depository designated by the Specific Patent Agency. No deposit is required if

the biological material involved can be easily obtained by a person ordinarily skilled in the art.

An applicant shall, within four months after the filing date of his/her patent application, submit to the Specific Patent Agency a certificate of deposit, indicating the depository, date of deposit and depository number. If such document is not submitted within the time limit, the deposit shall be deemed not having been made.

Where priority is claimed under Article 28, the time limit set forth in the preceding paragraph shall be sixteen months after the priority date.

In the event that, prior to filing the invention patent application, the biological material concerned had been deposited with a foreign depository recognized by the Specific Patent Agency, and where the certificates of deposits issued by the designated domestic depository and the foreign depository have been submitted within the time limit prescribed in either the second paragraph or the preceding paragraph, the applicant is exempted from the requirement of making deposit no later than the filing date, as set forth in the first paragraph .

If an applicant has deposited the biological material concerned with a depository designated by a foreign country with which the ROC recognizes the effects of deposits based on reciprocity, and if the applicant has submitted the certificate(s) of deposit issued by said foreign depository within the time limit prescribed in Paragraph 2 or Paragraph 3, the applicant is exempted from the requirement of making a deposit in the ROC.

The competent authority shall enact regulations on the requirements for accession, types, forms, and quantities of deposits of biological materials, deposit fees, and other matters in connection with making deposits set forth in Paragraph 1.

#### **Article 28 Priority claim under WTO membership, etc.**

Where an applicant has duly filed his/her first patent application in a

foreign country, which reciprocally allows ROC nationals to claim patent priority, or with any member of the World Trade Organization (WTO), the applicant may claim priority in respect of his/her ROC patent application if the ROC patent application for the same invention is filed within twelve months from the filing date of the said first patent application.

Where an applicant claims two or more priorities in respect of a patent application, the period referred to in the preceding paragraph shall be on the basis of earliest priority date.

If a foreign applicant is a citizen of a non-member of the WTO and his/her home country does not mutually recognize priority with the ROC, but the applicant has domicile or business establishment in any member of the WTO or in the territory of a reciprocal country, the applicant shall also be entitled to claim priority in accordance with the provisions set forth in Paragraph 1.

For a patent application filed with priority, examination on its patentability shall be based on the priority date.

#### **Article 29 Claim of priority**

When claiming priority in accordance with the preceding Article, an applicant shall simultaneously make a declaration with respect to the following when filing his/her patent application:

1. the filing date of the first patent application;
2. the country or member of WTO in or for which the first patent application was filed;
3. the application number of the first patent application.

Within sixteen months from the earliest priority date, the applicant shall submit a certified copy of the first patent application issued by the foreign patent authority under the preceding paragraph.

In case of a violation of Subparagraph 1 or Subparagraph 2 of Paragraph 1 or Paragraph 2, the priority claim shall be deemed not having been made.

Where, unintentionally, no priority claim is made at the time of filing his/her patent application or priority claim is deemed not having been made as prescribed in the preceding paragraph, the applicant may, within sixteen months after the earliest priority date, apply for reinstatement of priority claim, pay the required fee and undertake actions set forth in Paragraphs 1 and 2.

### **Article 30 Priority claim based on earlier application**

Where an applicant, based on his/her earlier invention or utility model patent application in the ROC, files a subsequent patent application, he/she may make a priority claim with respect to the invention or utility model disclosed in the description, claim(s) or drawing(s) submitted for the earlier patent application. This provision shall not apply under any of the following circumstances:

1. where a period of twelve months has elapsed from the filing date of the earlier patent application;

2. where priority has been claimed in accordance with the provisions of Article 28 or this Article in respect of the invention or utility model disclosed in the earlier patent application;

3. where the earlier patent application is a divisional patent application to Paragraph 1 of Article 34 or Paragraph 1 of Article 107, or a patent application converted pursuant to Paragraph 1 of Article 108;

4. where the earlier patent application is for an invention patent application that has been published or has been irrevocably rejected;

5. where the earlier patent application is for a utility model patent application that has been published or has been irrevocably rejected;

6. where the earlier patent application has been withdrawn or dismissed.

The earlier patent application referred to in the preceding paragraph shall be deemed having been withdrawn upon an expiry of fifteen months

from its filing date.

Priority claimed shall not be withdrawn upon an expiry of fifteen months from the filing date of the earlier patent application.

For a subsequent patent application filed with priority claim in accordance with Paragraph 1 of this Article, which has been withdrawn within fifteen months from the filing date of the earlier application, the priority claim thus made shall be deemed having been withdrawn at the same time.

Where an applicant claims two or more priorities for a patent application, the calculation of priority period shall be on the basis of the earliest priority date.

For a patent application filed with priority, examination on its patentability shall be based on the priority date.

Where a priority claim is made in accordance with Paragraph 1 under this Article, the filing date and the application number of the earlier patent application shall be declared at the time of filing. If the above-mentioned declaration is not made, priority claim shall be deemed not having been made.

### **Article 31 Principle of first-to-file**

Where two or more patent applications are filed for the same invention, only the earliest application can be granted. The above shall not apply if the priority date claimed for the later-filed application is earlier than the filing date of the earlier application.

If the filing date and the priority date referred to in the preceding paragraph are the same, the applicants shall be notified to reach an agreement with respect to the matter concerned. If such an agreement cannot be reached, none of the applications shall be granted. If the said patent applications are filed by the same applicant, the applicant shall be notified to select one patent application within a time limit; failure to make a selection within the time

limit shall result in rejection of all such patent applications.

While the applicants concerned are in the process of reaching an agreement, the Specific Patent Agency shall require these applicants to report the results of the negotiation within an appropriate time limit. If the said report is not submitted within the specified time limit, it shall be deemed that an agreement is not reached.

Where an invention patent application and a utility model patent application are filed separately in respect of the same creation, the provisions set forth in the preceding three paragraphs shall apply *mutatis mutandis*, except for the circumstance stipulated in Article 32.

### **Article 32 One creation applied for invention patent and utility model patent**

Where an applicant files an invention patent application and a utility model patent application for the same creation on the same date, if the utility model patent application has been granted before a decision of admission is issued on the invention patent application, the Specific Patent Agency shall notify the applicant to select one patent application within a specified time limit. The invention patent application shall not be granted if the applicant fails to make the selection within the specified time limit.

Where the applicant select the invention patent application according to the provision set forth in the preceding paragraph, the utility model patent right shall be deemed non-existent *ab initio*.

The invention patent application shall not be granted if the utility model patent right has extinguished or has been invalidated before a decision is issued on the invention patent application.

### **Article 33 Unity**

An application for an invention patent shall relate to one invention.

Two or more inventions so linked as to form a single general inventive

concept may be filed as one application.

#### **Article 34 Division of application**

For a patent application which substantially contains two or more inventions, the said patent application may, upon notice by the Specific Patent Agency or upon request by the applicant, be divided into two or more divisional applications.

A divisional application shall be filed within any of the following time limit:

1. before a reexamination decision on the original patent application is rendered;
2. within thirty days from the date on which an approval decision for the original patent application has been served. However, it shall not be filed if a reexamination decision has been rendered.

The filing date of the divisional patent application shall be deemed to have the filing date of the original application. Where the priority claim has been made, the applicant can claim priority for the divisional patent application.

The divisional patent application shall not extend beyond the scope of content of the description, claim(s), or drawing(s) of the original patent application as filed.

For the divisional patent application filed in accordance with Subparagraph 1 of Paragraph 2, the examination thereof shall be continued from the examination procedure of the original patent application.

For the divisional patent application filed in accordance with Subparagraph 2 of Paragraph 2, the examination thereof shall be continued from the examination procedure that was left before the original patent application was approved; the original patent application shall be published with the claim(s) and drawing(s) as approved.

### **Article 35 Invalidation request filed by genuine holder of right to apply for a patent**

Where an invalidation request is filed against a granted patent by the person entitled to apply for a patent or by the joint owner(s) of the right to apply for a patent within two years from the published date of the patent concerned in accordance with Item 3, Paragraph 1 of Article 71, and where the said person or joint owner(s) newly file(s) a patent application for the same invention within two months from the day on which the invalidation decision revoking the patent has become final and binding, the filing date of the newly filed patent application shall be deemed to have the filing date of the invalidated patent.

A patent application newly filed in accordance with the preceding paragraph shall not be published again.

### **Section 3: Examination and Reexamination**

#### **Article 36 Assignment of examiner for examination**

The Specific Patent Agency shall assign an examiner to conduct the substantive examination of an invention patent application.

#### **Article 37 Early publication of patent application**

After receiving the filing documents for an invention patent application, if, after examination, the Specific Patent Agency finds no violation of the formality requirements and no event that may lead the patent application being not laid open, the Specific Patent Agency shall have such patent application laid open after eighteen months from the filing date of such patent application.

The Specific Patent Agency may advance the laying-open of a patent application upon the request of the applicant.

An invention patent application shall not be laid open under any of the following circumstances:

1. where it is withdrawn within fifteen months from its filing date;

2. where it involves national defense secrets or any other secrets pertaining to national security;

3. where it is contrary to public order or morality.

Where priority is claimed, the calculation of the time limit set forth in Paragraph 1 and the preceding paragraph shall be on the basis of the priority date; where two or more priorities are claimed, the time limit calculation shall be on the basis of the earliest priority date.

### **Article 38 Request for substantive examination**

A request to the Specific Patent Agency for substantive examination of an invention patent application shall be made by any person within three years from the filing date of the patent application.

In the case of an invention patent application which was divided under Paragraph 1 of Article 34 or was converted under Paragraph 1 of Article 108, if the time limit set forth in the preceding paragraph has lapsed, a request for substantive examination can be filed no later than thirty days following the application for division or conversion.

A request for substantive examination under the preceding two paragraphs shall not be withdrawn.

Where a request for substantive examination is not filed within the time limit prescribed in Paragraph 1 or Paragraph 2, the invention patent application shall be deemed to have been withdrawn.

### **Article 39 Request Procedure for substantive examination**

A request for substantive examination under the preceding Article shall be submitted.

The Specific Patent Agency shall publish the fact regarding a request for substantive examination in the Patent Gazette.

Where the substantive examination is requested by a person other than the applicant, the Specific Patent Agency shall notify the applicant of the invention patent application of such fact.

#### **Article 40 Prioritized examination of invention patent application**

Where, after the laying-open of an invention patent application, a person other than the applicant has exploited the invention commercially, the Specific Patent Agency may, upon request, conduct prioritized examination.

Relevant evidentiary documents shall be submitted when filing a request under the preceding paragraph.

#### **Article 41 Effect of the laying open of application**

After the laying-open of an invention patent application, where the applicant has given a written notice to a person indicating the content of the invention claimed in the patent application, the applicant may, after the publication of the said patent application, claim appropriate compensation against the said person if he/she continues to exploit the invention commercially after receiving the notice and prior to the publication of the said patent application.

A claim referred to in the preceding paragraph can also be made where a person who knows that an invention patent application has been laid open but continues to exploit the invention commercially prior to publication of the patent application.

The right to claim compensation as provided in the preceding two paragraphs does not affect the exercise of other rights.

The right to claim compensation set forth in Paragraph 2 shall be ceased if it is not exercised within two years from the date of publication of the said invention patent.

#### **Article 42 Interview and inspection in examination of application**

When examining an invention patent application, the Specific Patent Agency may, upon request or on its own initiative, notify the applicant to conduct any of the following actions within a specified time limit:

1. to appear before the Specific Patent Agency for an interview;
2. to perform necessary experiment(s) or submit model(s) or sample(s).

Where experiment(s) or model(s) or sample(s) is(are) performed or submitted as stated in Subparagraph 2 of the preceding paragraph, the Specific Patent Agency may, when necessary, visit the site or a designated place for inspection.

#### **Article 43 Amendment during examination; final notice**

Unless otherwise provided for in this Act, when examining an invention patent application, the Specific Patent Agency may, upon request or on its own initiative, notify the applicant to amend the description, claim(s), or drawings within a specified time limit.

Except for correction of translation errors, any amendment shall not extend beyond the scope of content of the description, claim(s), or drawing(s) as filed.

Where the Specific Patent Agency issues a notice in accordance with Paragraph 2 of Article 46, a patent applicant can only make amendments within the time limit specified in the notice.

After the Specific Patent Agency has issued a notice under the preceding paragraph, as it deems necessary, they may issue a final notice. After a final notice is issued, as to amendment of claim(s), the patent applicant shall only conduct the amendment as follows within the time limit specified in the said notice:

1. to delete claim(s);
2. to restrict the scope of claim(s);
3. to correct the errors;
4. to clarify the ambiguous statement.

In case of a violation of the provisions in the preceding two paragraphs, the Specific Patent Agency shall state the reasons and issue a decision accordingly.

The Specific Patent Agency may issue a final notice if the original patent application or its divisional application meets any of the following conditions:

1. where the content of the notice issued for the original patent application is same as that of the notice issued for the divisional patent application;

2. where the content of the notice issued for the divisional patent application is same as that of the notice issued for the original patent application;

3. where the content of the notice issued for a divisional application is same as that of a notice issued for other divisional application(s).

#### **Article 44 Foreign language documents**

Where a patent applicant submits a description, claim(s), and drawings prepared in a foreign language under Paragraph 3 of Article 25, such foreign language documents shall not be amended.

The Chinese translation submitted under Paragraph 3 of Article 25 shall not extend beyond the scope of content of the original foreign language documents as filed.

Any correction of translation errors of the Chinese version stated in the preceding paragraph shall not extend beyond the scope of content of the original foreign language documents as filed.

#### **Article 45 Decision of examination**

Upon completion of examination of an invention patent application, a written decision shall be rendered and served on the applicant.

When a patent application is determined to be unpatentable, the reason(s) shall be given in the written decision of examination.

A written decision of examination shall bear the name of the patent examiner. This requirement shall also apply to written decisions for reexamination, amendment after grant, invalidation, patent term extension and invalidation against patent term extension.

#### **Article 46 Grounds for rejection decision**

When an invention patent application is in violation of the provisions set forth in Articles 21 through 24, Article 26, Article 31, Paragraphs 1 and 3 of Article 32; Article 33, Paragraph 4 of Article 34, Paragraph 2 of Article 43, Paragraphs 2 and 3 of Article 44 or Paragraph 3 of Article 108, a rejection decision shall be rendered.

The Specific Patent Agency shall notify the applicant and ask him /her to file a response within a time limit before it renders a decision in accordance with the preceding paragraph. If the applicant fails to make a response before the time limit, a decision of rejection shall be rendered accordingly.

#### **Article 47 Publication of patented invention and application for viewing**

A claimed invention shall be patented if there is no reason for negating its patentability, and the claim(s) and the drawing(s) of the patent application shall be published.

Any person may apply for reviewing, transcribing, photographing, or photocopying the written decision of examination, description, claim(s), abstract, drawing(s), and the file wrapper in connection with a patent application which has been published, except for the information which should be kept confidential by the Specific Patent Agency in accordance with laws.

#### **Article 48 Reexamination**

Where an applicant of an invention patent application is dissatisfied with a rejection decision rendered for his/her patent application, he/she may

apply for a reexamination with reason(s) within two months after the date on which the rejection decision is served. If the patent application is not accepted or dismissed for formality defects or on the ground of ineligibility of the applicant, the applicant may directly file administrative remedy actions in accordance with acts.

#### **Article 49 Amendment during reexamination**

Where a rejection decision is preceded by a notice of rejection as set forth in Paragraph 2 of Article 46, the applicant shall still be allowed to amend his/her description, claims, or drawing(s) during the reexamination stage.

Where a final notice has been issued before the rejection decision is rendered for a patent application, any amendment made during the reexamination stage shall still be subject to limitations set forth in each item of Paragraph 4 of Article 43. The above shall not apply to reexamination, if the Specific Patent Agency finds that the final notice issued in the original examination procedure was improper.

The Specific Patent Agency may issue a final notice under any of the following circumstances:

1. where the reason(s) for reexamination still involves unpatentable event(s);
2. where the amendment(s) made during the reexamination stage still lead to unpatentable event(s);
3. where an amendment made in accordance with the preceding paragraph violates Paragraph 4 of Article 43.

#### **Article 50 Assignment of examiner for reexamination**

At the time of reexamination, the Specific Patent Agency shall assign an examiner, who did not participate in the original examination stage of the concerned patent application, to conduct the reexamination and render a written decision served to the applicant.

## **Article 51 Confidentiality of invention involving national security**

Where, through examination, an invention involves national defense secrets or any other secrets pertaining to national security, the Ministry of National Defense or relevant national security authorities shall be consulted for their comments; if it is deemed necessary to keep such invention confidential, the application documents of the said patent application shall be sealed. If a request for substantive examination has been filed for the said patent application, an examination decision shall be rendered and served to the applicant and the inventor.

The applicant, his/her patent agent and the inventor shall keep the invention confidential as described in the preceding paragraph; the right to apply for a patent for such invention shall be deemed having been abandoned if there is any violation of the confidentiality requirement.

The confidentiality period shall last for one year from the date on which the decision is served on the applicant, and such period may be extended on an annual basis. One month prior to the expiry of the confidentiality limit, the Specific Patent Agency shall consult with the Ministry of National Defense or relevant national security authorities and, if confidentiality is no longer required, such patent application shall be laid open.

Where an invention prescribed in Paragraph 1 is approved and if confidentiality is deemed unnecessary for such patent application, the Specific Patent Agency shall notify the applicant to pay the patent certificate fee and the first year patent annuity within three months, and shall publish the grant of the invention patent after receiving such fees. If the said fees are not paid prior to the time limit stated above, no publication shall be made.

The Government shall pay a considerable compensation sustained by the applicant during the confidentiality period.

## **Section 4: Patent Rights**

### **Article 52 Payment of fees and publication**

For an invention patent application that is approved, the grant of such patent application shall be published only when the patent certificate fee and the first year patent annuity are paid by the applicant within three months from the date of receiving the allowance decision; if the fees are not paid before the expiration of time limit stated above, no patent grant publication shall be made.

Patent rights granted to an invention patent application shall start from the date of patent grant publication, and a patent certificate shall be issued thereto.

The term of an invention patent shall expire after a period of twenty years from the filing date of the application.

Where applicant unintentionally failed to pay the required fees within the time limit set forth in Paragraph 1 of this Article or Paragraph 4 of the preceding Article, the applicant may pay the patent certificate fee and two times the patent annuities of the first year within six months after the time limit expired, in which case the patent grant shall be published by the Specific Patent Agency.

### **Article 53 Extension of patent term**

For an invention patent directed to a pharmaceutical or agrichemical(s), or the manufacturing process thereof, of which the exploit needs to obtain a regulatory approval pursuant to other acts or regulations, if the regulatory approval is obtained after the publication of the concerned invention patent, the patentee may apply for one and only one extension of the patent term of said invention patent based on the first regulatory approval. Said regulatory approval is only allowed to be used once for seeking patent term extension.

The extension of the patent term approved under the preceding paragraph shall not exceed the length of time when the patent cannot be

exploited because of absence of the regulatory approval concerned from the central government authorities in charge of the business. If the time needed to obtain said regulatory approval exceeds five years, the granted patent term extension shall be five years.

The term "pharmaceutical" set forth in Paragraph 1 does not include any veterinary drug.

When applying for patent term extension under the first paragraph, a written request and evidentiary documents must be submitted to the Specific Patent Agency within three months after obtaining the first regulatory approval; no request for patent term extension shall be filed within six months prior to the end of the original patent term.

When making a decision on an application for patent term extension, the Specific Patent Agency shall take into consideration the impact on public health and shall coordinate with the central competent authority in charge to enact the regulations concerned.

#### **Article 54 Deemed as extended**

Where a request for patent term extension is filed under the preceding Article, the patent term shall be deemed having been extended if the Specific Patent Agency has not issued a decision before the original patent term expires. However, where such request for patent term extension is not allowed, the patent term shall expire at the original expiration date.

#### **Article 55 Assignment of examiner for extension application**

The Specific Patent Agency shall assign an examiner to examine a request for patent term extension, issue a written decision and serve it on the patentee.

#### **Article 56 Scope of patent term extension**

The scope of a patent, of which a term extension has been granted, is

limited to the active ingredients and use stated in the regulatory approval concerned.

#### **Article 57 Invalidation of patent term extension**

Any person may request for invalidation of the granted patent term extension to the Specific Patent Agency, together with evidentiary documents, under any of the following circumstances:

1. where it is unnecessary to obtain the regulatory approval to exploit the invention patent concerned;
2. where neither the patentee nor his/her licensee has obtained the regulatory approval;
3. where the granted term of extension exceeds the period during which the patent cannot be exploited;
4. where the applicant of the patent term extension is not the patentee;
5. where the regulatory approval of extension request is not the first approval, or an extension based on the said regulatory approval concerned has been done;
6. where the request for extension is based on the time spent in conducting trials or tests in a foreign country, the extended term granted by the Specific Patent Agency exceeds the period recognized by the foreign patent authority;
7. where the pharmaceuticals involved in the granted patent term extension are veterinary drugs.

If invalidation of the patent term extension is irrevocably sustained, the granted patent term extension shall be deemed non-existent *ab initio*. However, if such invalidation is irrevocably sustained on the ground listed in Subparagraph 3 or Subparagraph 6 of the preceding paragraph, only the exceeding period of the extension shall be deemed non-existent.

### **Article 58 Effects of invention patent right**

Unless otherwise provided for in this Act, the patentee of an invention patent has an exclusive right to prevent others from exploiting the invention without the patentee's consent.

Where the invention is a product, exploiting of which means the acts of making, offering for sale, selling, using, or importing that product for the aforementioned purposes.

Where the invention is a process, exploiting of which means the following acts:

1. using the process;
2. using, offering for sale, selling or importing for these purposes the product obtained directly by that process.

The extent of the protection conferred by an invention patent shall be determined by the claim(s), and the description and drawing(s) may be considered when interpreting the claim(s).

The abstract shall not be used for the purpose of interpreting claim(s).

### **Article 59 Limitations of patent right**

The effects of an invention patent right shall not extend to the following circumstances:

1. acts done privately and for non-commercial purpose(s);
2. necessary acts to exploit the invention for research or experimental purpose(s);
3. acts done by a person who has been exploiting the invention or making all the necessary preparations for doing such act in this country before the filing date of the invention. However, this provision shall not apply where a person learning of the invention from the applicant for patent within six months and the applicant has made a statement reserving his right in the event of a patent being granted;
4. a vehicle merely passing through the territory of this country, or any

device of such vehicle;

5. where a patent granted to a person not entitled to apply for a patent is revoked as a result of an invalidation filed by the patentee, acts done by a licensee who has, prior to patent invalidation, been exploiting the invention in good faith or making all the necessary preparations to do such an act ;

6. where, after the sale of a patented product made by the patentee or made under consent of the patentee, using or reselling such product. The making and selling as stated above are not limited to acts done domestically;

7. where, after an invention patent is ceased pursuant to Subparagraph 3, Paragraph 1 of Article 70 and before it is reinstated and published under Paragraph 2 of Article 70 of this Act, acts done by a person who has been exploiting the invention in good faith or making all the necessary preparations to do such an act.

The person exploiting the invention as stated in Subparagraphs 3, 5, and 7 of the preceding paragraph, may continue to exploit the invention within the original business purpose.

A licensee as stated in Subparagraph 5 of Paragraph 1, who continues to exploit the invention after the patent is revoked, shall pay the patentee a reasonable royalty as of the date of receiving a written notice from the patentee.

#### **Article 60 Limitations of patent right: research and trials of pharmaceuticals**

The effects of the patent right shall not extend to research and trials, including their practical requirements, necessary for obtaining registration and market approval of drugs under the Pharmaceutical Affairs Act or obtaining market approval of pharmaceuticals from a foreign country.

#### **Article 61 Limitations of patent right: dispensation of medicines**

The effects of the patent right for the invention of medicines to be manufactured by mixing two or more medicines or for the invention of a

process thereof, shall not be affected against the preparing medicines in accordance with a prescription from a physician, or the medicines so prepared.

**Article 62 Recordation to have *Locus standi* against a third party:  
transference of patent right**

The assigning, entrusting, licensing, or establishing of a pledge on a patent right by the patentee shall have no locus standi against any third party unless it is recorded with the Specific Patent Agency.

The license as stated in the preceding paragraph may be an exclusive license or a non-exclusive license.

An exclusive licensee shall, within the scope of the license granted, exclude the patentee and third parties from exploiting the patented invention.

Where a patentee establishes multiple pledges on his/her patent for the purpose of securing multiple creditors' rights, the ranks of these pledges shall be determined according to the order of their recordation.

**Article 63 Sub-license**

An exclusive licensee may sub-license a third party to exploit the licensed patent unless otherwise agreed upon by contract.

A non-exclusive licensee shall not be allowed to sub-license a third party to exploit the licensed patent without the consent of the invention patentee or the exclusive licensee.

The sub-license contract shall have no locus standi against any party unless it is recorded with the Specific Patent Agency.

**Article 64 Disposal of jointly-owned patent right**

Where a patent right is jointly owned, except for exploitation by each of the joint owners, it shall not be assigned, entrusted, licensed, pledged, or abandoned without the consent of all the joint owners.

### **Article 65 Disposal of one's own share of jointly-owned patent right**

Where a patent right is jointly owned, no joint owner may assign, entrust or establish a pledge on his/her own share without the consent of all other joint owners.

Where a joint owner of a patent right has abandoned his/her own share, this share shall be vested in other joint owner(s).

### **Article 66 Prolongation of patent term**

Where the patentee has suffered loss as a result of a war between the ROC and a foreign country, he/she may apply for patent term prolongation of his/her patent for five to ten years; only one such prolongation shall be permitted. However, if the patent is owned by a national from the foreign country in war with the ROC, an application for patent term prolongation shall not be allowed.

### **Article 67 Amendment of granted patent**

When applying for amending the description, claim(s) or drawings of an invention patent, the patentee shall only conduct the amendment as follows:

1. to delete claim(s);
2. to restrict the scope of claim(s);
3. to correct errors or incorrect translations;
4. to clarify ambiguous statement.

Except for correction of incorrect translations, an amendment shall not extend beyond the scope of content of the description, claim(s), or drawing(s) as filed.

For an invention patent application filed by submitting the description, claim(s), and drawings prepared in a foreign language pursuant to Paragraph 3 of Article 25, a correction of incorrect translations shall not extend beyond the scope of disclosure in the foreign language documents as filed.

An amendment shall not substantially enlarge or alter the scope of the

claim(s) as published.

#### **Article 68 Examination of amendment**

The Specific Patent Agency shall designate patent examiner(s) to conduct examination of patent amendment, render a decision and serve it to the patentee, except for an amendment filed in accordance with the provisions set forth in Article 79.

After approving the amendment, the Specific Patent Agency shall publish the result therefor.

Once a description, claim(s) and drawing(s) is amended and published, such amendment shall take effect retroactively from the filing date.

#### **Article 69 Restriction of abandonment or amendment of patent right**

A patentee shall not abandon his/her patent right, or apply for an amendment as stated in Subparagraph 1 or Subparagraph 2, Paragraph 1 of Article 67 without the consent of the licensee or pledgee .

Where a patent right is jointly owned, no joint owner may apply for amendment as stated in Subparagraph 1 or 2, Paragraph 1 of Article 67 without the consent from all the joint owners.

#### **Article 70 Extinguishment of patent right**

An invention patent right shall become extinguished under any of the following circumstances:

1. where the patent term has expired, and the patent shall become extinguished;
2. where the patentee has passed away without heirs;
3. where the second year annuity or any subsequent patent annuity is not paid within the payment time limit, the patent right shall become extinguished after the expiration of the original due payment date;

4. where the patentee abandoned the patent, the patent right shall be extinguished from the date the patentee wrote a declaration.

Where the applicant unintentionally failed to pay a patent annuity within the late payment time set forth in Paragraph 1 of Article 94, the patentee may apply for reinstatement of the patent rights within one year from the due date for effecting the payment by paying triple the amount originally due, and the Specific Patent Agency shall publish with respect to the above.

#### **Article 71 Grounds for invalidation**

Any person may request for invalidation against an invention patent with the Specific Patent Agency under any of the following circumstances:

1. where there is a violation of Articles 21 to 24, Article 26, Article 31, Paragraphs 1 and 3 of Article 32, Paragraph 4 of Article 34, Paragraph 2 of Article 43, Paragraphs 2 and 3 of Article 44, Paragraphs 2 to 4 of Article 67, or Paragraph 3 of Article 108 of this Act;

2. where the home country of the patentee does not accept the patent applications filed by nationals of the ROC; and

3. where there is a violation of Paragraph 1 of Article 12, or where the invention patentee is not entitled to file the invention patent application.

An invalidation request based on Subparagraph 3 of the preceding paragraph shall only be filed by the interested party.

With respect to ground(s) of an invalidation request against an invention patent, the provisions in effect at the time of the said patent approved shall govern. However, if an invalidation request is filed based on the ground(s) under Paragraph 4 of Article 34, Paragraph 2 of Article 43, Paragraph 2 and Paragraph 4 of Article 67 or Paragraph 3 of Article 108, the provisions in effect at the time of filing the said request shall govern.

#### **Article 72 Invalidation against extinguished patent**

Where the interested party possesses recoverable legal interests due to

the invalidation of a patent, such interested party may request for invalidation after the said patent has become extinguished ipso facto.

#### **Article 73 Invalidation request**

An invalidation request shall be submitted with a statement reason(s), and accompanied by evidence.

Where a patent contains more than one claim, an invalidation request may be filed for each claim.

An invalidation statement shall not be modified or added after filing, but it can be narrowed.

An invalidation requester may supplement invalidation reasons or evidence within one month after the date of filing the said request; however, supplementary reason(s) and/or evidence submitted prior to rendering a decision shall still be examined.

#### **Article 74 Invalidation proceedings**

Upon receipt of the request stated in the preceding Article, the Specific Patent Agency shall send a copy of such request to the patentee.

Within one month after sending the copy of the request, a response shall be submitted by the patentee. If the patentee fails to submit such response, the invalidation proceedings shall be conducted directly, unless the patentee has requested for extension with reason(s) beforehand and such extension has been approved.

The Specific Patent Agency may conduct invalidation proceedings directly if the supplementary reason(s) or evidence by the invalidation requester is likely to delay the proceedings or if the fact and evidence submitted has been sufficiently clear.

#### **Article 75 Principle of *Ex officio***

When conducting an invalidation proceedings, the Specific Patent

Agency may, *ex officio*, examine the reason(s) and evidence not submitted by the invalidation requester if the said reason(s) and evidence are within the scope of the invalidation statement, and notify the patentee to submit a response within a time limit. The invalidation proceedings shall be conducted directly if the patentee fails to submit a response within the time limit.

#### **Article 76 Interview and inspection in invalidation proceedings**

When conducting an invalidation proceedings, the Specific Patent Agency may, upon a request or *ex officio*, notify the patentee to take any of the following actions within a time limit:

1. to appear at the Specific Patent Agency for interview;
2. to perform necessary experiment(s) or submit model(s) or sample(s).

Where experiment(s) or model(s) or sample(s) performed as stated in Subparagraph 2 of the preceding paragraph, the Specific Patent Agency may, when necessary, visit the site or a designated place for inspection.

#### **Article 77 Joint proceedings of invalidation and amendment**

If, during the invalidation proceedings, a request for amendment is filed, the said proceedings and amendment shall be conducted jointly, then decisions concerned shall be rendered jointly as well. If the Specific Patent Agency considers the said amendment approvable, it shall send a copy of the amended description, claim(s) and/or drawings to the invalidation requester.

Where there is more than one request for amendment, the earlier amendment shall be deemed to have been withdrawn.

#### **Article 78 Joint proceedings of multiple invalidation requests**

Where there is more than one invalidation request filed against the same patent, when necessary, the invalidation proceedings of the said requests may be conducted jointly by the Specific Patent Agency.

Where the invalidation proceedings have been conducted jointly

pursuant to the preceding paragraph, decisions concerned may also be rendered jointly.

#### **Article 79 Assignment of examiner for invalidation**

When conducting invalidation proceedings, the Specific Patent Agency shall designate patent examiners, render a decision and serve the same to the patentee and the invalidation requester.

Decision on an invalidation request shall be rendered on a claim-by-claim basis.

#### **Article 80 Restriction of withdrawal of invalidation**

An invalidation request may be withdrawn by the requester before a decision concerned has been rendered. However, if the patentee has already submitted a response, such withdrawal shall be consented from the patentee.

The Specific Patent Agency shall notify the patentee of the withdrawal of an invalidation request. If the patentee raises no objection within ten days after the notice has been served, it shall be deemed that the patentee has agreed to such withdrawal.

#### **Article 81 Principle of *ne bis in idem***

Under any of the following circumstances, any person shall not be allowed to separately request for invalidation against the same patent based on the same facts and evidence:

1. where another invalidation request filed based on the same facts and evidence has been considered groundless by a decision;
2. where new evidence is submitted with the Intellectual Property Court pursuant to Article 33 of the Intellectual Property Case Adjudication Act, and considered groundless by a judgment.

#### **Article 82 Decision of invalidation**

Where an invalidation request against an invention patent is considered

well grounded, the patent right shall be invalidated; such invalidation may be made on a claim-by-claim basis.

Invalidation of an invention patent right shall become final and binding under any of the following circumstances:

1. where no administrative remedy proceedings are filed in accordance with laws;

2. where administrative remedy proceedings are filed but dismissed finally and bindingly.

Where an invention patent is invalidated finally and bindingly, the effect of patent right shall be deemed never to have existed.

#### **Article 83 Procedures to be applied *mutatis mutandis* to invalidation against patent term extension**

With respect to an invalidation request filed against patent term extension of an invention patent under Paragraph 1 of Article 57 of this Act, the provisions in this Act with respect to invalidation requests against invention patents shall apply *mutatis mutandis*.

#### **Article 84 Publication in the Patent Gazettes**

An invention patent with respect to grant, change, extension, prolongation, assignment, trust, licensing, compulsory licensing, revocation, extinguishment, establishment of a pledge, invalidation decisions, as well as other matters which should be published are to be published in the Patent Gazettes.

#### **Article 85 Patent Registry**

The Specific Patent Agency shall maintain a Patent Registry, in which the patent grants, changes of patent rights, and all other matters required by laws shall be registered.

The Patent Registry set forth in the preceding paragraph may be

produced in electronic means and shall be made available to the public for reading, transcribing, photographing, or photocopying.

#### **Article 86 Publication by electronic means**

Matters which should be laid open and published by the Specific Patent Agency in accordance with this Act may be done by electronic means; the commencement date thereof shall be decided by the Specific Patent Agency.

### **Section 5 Compulsory Licensing**

#### **Article 87 Grounds for compulsory licensing**

In response to national emergency or other circumstances of extreme urgency, the Specific Patent Agency shall, in accordance with an emergency order or upon notice from the central government authorities in charge of the business, grant compulsory licensing of a patent as needed, and notify the patentee as soon as reasonably practicable.

Under any of the following circumstances, for which a compulsory patent licensing is necessary, the Specific Patent Agency may, upon request, grant compulsory licensing of a patent:

1. where the patented invention is exploited non-commercially for enhancement of public interest;
2. where a later invention or utility model patent cannot be exploited without infringing a prior invention or utility model patent, and where the later invention or utility model patent involves an important technical advancement of considerable economic significance in relation to the prior invention or utility model patent;
3. where a patentee has committed acts restricting competition or has committed unfair competition acts, which have been determined via a judgment issued by a court or a decision issued by the Fair Trade Commission of the Executive Yuan.

Applying for compulsory license of a patent covering semiconductor

technology shall be filed based on the grounds set forth in Subparagraphs 1 and 3 of the preceding paragraph.

Applying for compulsory license of a patent in accordance with Subparagraphs 1 through 2 of Paragraph 2 may only be permitted if the requestor for compulsory license has made efforts to obtain authorization from the right holder on reasonable commercial terms and conditions, and that such efforts have not been successful within a reasonable limit of time.

Request for compulsory licensing of a patent in accordance with Subparagraph 2 of Paragraph 2, the owner of the prior patent may propose reasonable terms and conditions and seek grant of compulsory license of the later patent owned by the requestor.

#### **Article 88 Procedure and decision of compulsory license**

After receiving an application for compulsory license as filed in accordance with Paragraph 2 of the preceding Article or Article 90, the Specific Patent Agency shall notify the patentee concerned and require the patentee to submit a statement of defense within a designated time limit. If no statement of defense is submitted within the designated time limit, the examination of the compulsory license request shall be proceeded accordingly.

The exploitation under a compulsory license shall be authorized predominantly for the supply of the domestic market. The above shall not apply to compulsory license granted in accordance with Subparagraph 3, Paragraph 2 of the preceding Article.

A decision on a request for compulsory license shall be made in writing, and shall indicate the reasons, scope, duration, and the required remuneration.

A compulsory license shall not affect the exercise of patent right by the patentee concerned.

The right granted under compulsory license shall not be assigned, entrusted, inherited, licensed or pledged except for the following circumstances:

1. where a compulsory license is granted in accordance with Subparagraph 1 or Subparagraph 3, Paragraph 2 of the preceding Article, it is assigned, entrusted, inherited, licensed or pledged with the business involving the exploitation of the patent;

2. where a compulsory license is granted in accordance with Subparagraph 2 of the preceding paragraph or Paragraph 5 of the preceding Article, it is assigned, entrusted, inherited, licensed or pledged with the patent owned by the licensee.

#### **Article 89 Termination of compulsory license**

Where a compulsory license granted in accordance with Paragraph 1 of Article 87 is considered no longer necessary by the central government authority in charge of the business, the Specific Patent Agency shall terminate the compulsory license upon a notice from the central government authorities in charge of the business.

The Specific Patent Agency may, upon request, terminate the grant of compulsory license under any of the following circumstances:

1. where the fact warranting the compulsory license has been changed and compulsory licensing is no longer necessary;

2. where the licensee fails to properly exploit the patent as required in the compulsory license ;

3. where the licensee fails to pay the remuneration as determined by the Specific Patent Agency.

#### **Article 90 Compulsory licensing of pharmaceuticals: grounds; procedures**

For purposes of assisting countries with insufficient or no manufacturing capacities in pharmaceutical sector to obtain pharmaceutical product(s)

needed in treating HIV/AIDS, tuberculosis, malaria and other epidemics, the Specific Patent Agency shall, upon request, grant compulsory license for the requestor to exploit a patent concerned for the purpose of producing such pharmaceutical products(s) and its export to eligible importing countries.

A request for compulsory license filed in accordance with the preceding paragraph may only be permitted if the requestor has made efforts to obtain authorization from the right holder on reasonable commercial terms and conditions and that such efforts have not been successful within a reasonable period of time; however, the above shall not apply if compulsory licensing of the required pharmaceutical product(s) has been granted in the importing country. If the importing country concerned is a WTO member, the requestor, when filing a request according to Paragraph 1, shall submit evidentiary documents proving that the importing country has fulfilled the following:

1. the Council for Trade-related Aspects of Intellectual Property Rights has been notified of the name(s) and expected quantities of the pharmaceutical product(s) needed;

2. the Council for Trade-related Aspects of Intellectual Property Rights has been notified of its intention as an importer and has established that it has insufficient or no manufacturing capacities in the pharmaceutical sector. However, such evidentiary document(s) is (are) not needed if the importing country is a least-developed country;

3. the required pharmaceutical product(s) is (are) not patented in the importing country, or where the pharmaceutical product(s) is(are) patented in its territory, it has granted or intends to grant a compulsory license.

The so called "least-developed countries" mentioned in the preceding paragraph refers to countries announced by the United Nations (UN) as being least-developed countries.

If the importing country is not a WTO member, but is a least-developed country or is a country with insufficient or no manufacturing capacities in the pharmaceutical sector, when filing a request for compulsory license according

to Paragraph 1, the requestor shall submit evidentiary documents proving that the importing country has fulfilled the following conditions:

1. the name(s) and expected quantities of the pharmaceutical product(s) needed have been filed in writing with the foreign affairs authorities of the ROC;
2. stating that it agrees to prevent re-exportation of the pharmaceutical product(s) needed.

#### **Article 91 Compulsory licensing of pharmaceuticals: export; remuneration**

Pharmaceutical product(s) produced under compulsory license in accordance with the preceding Article shall be exported to the importing country entirely, and the quantity of the product authorized to be produced shall not be more than the quantity reported by the importing country in its notice sent to the Council for Trade-related Aspects of Intellectual Property Rights or the foreign affairs authorities of the ROC.

Pharmaceutical product(s) produced under compulsory license granted in accordance with the preceding Article shall be marked with the basis of the licensing on the external packaging thereof in accordance with the direction specified by the Specific Patent Agency; the packaging, coloring or shaping of the pharmaceutical product(s) produced under compulsory license shall be sufficiently distinguishable from pharmaceutical product(s) produced by the patentee or his/her licensee(s).

A licensee of a compulsory license shall pay appropriate remuneration to the patentee. The amount of remuneration shall be decided by the Specific Patent Agency, taking into account the economic value of the patent involving the required pharmaceutical product(s) to the importing country with reference to the human development index issued by the United Nations.

Before exporting the pharmaceutical product(s) produced under a compulsory license, the licensee of such compulsory license shall post on a website the quantities, name(s) and destination(s) of such pharmaceutical

product(s), as well as distinguishing features of the pharmaceutical product(s).

Inspection and registration of the pharmaceutical product(s) produced and exported under compulsory licensing in accordance with the preceding Article shall not be bound by the Paragraph 2, Article 40ter of the Pharmaceutical Affairs Act.

## **Section 6: Payment of Fees**

### **Article 92 Fees**

With respect to each request for patent-related matters, the requestor shall pay fees at the time of filing.

For a granted invention patent, the patentee shall pay a patent certificate fee and patent annuities. If extension or prolongation of patent term is allowed, patent annuities shall still be paid during the extended or prolonged patent term.

### **Article 93 Time limit on payment of annuity**

The annuity for an invention patent shall be paid commencing from the publication date. Payment of the first year annuity shall be made in accordance with the provision set out in Paragraph 1, Article 52 hereof, while the payment of the second year annuity and the annuities thereafter shall be made prior to the expiration of each patent payment year.

The annuity for several years may be paid at one time. Under such circumstance, if the annuity rate is adjusted upwardly, the patentee concerned will not be required to pay the deficit.

### **Article 94 Addition of annuity**

If the annuity for the second or any subsequent payment year is not paid within the original time limit, a late payment can be made within six months from the original due date with a specified percentage addition.

Payment of additional annuities based on the specified percentage as stated in the preceding paragraph means additional annuities will be needed on a monthly basis depending on the time limit elapsed from the original due date. For every month that has elapsed, an additional fee at a ratio of 20% is needed with a maximum of additional fee which is same as the amount originally due. The elapsed time limit from one day to one month shall be deemed one month.

#### **Article 95 Reduction of annuity**

Where the patentee of an invention patent is a natural person, school or small and medium enterprise, the patentee may apply with the Specific Patent Agency for a reduction of patent annuities.

#### **Section 7 Damages and Action**

##### **Article 96 Right to claim in the event of patent right infringement**

A patentee of an invention patent may demand a person who infringes or is likely to infringe the patent right to stop or prevent such infringement.

In the case of infringement of an invention patent with intent or due to negligence, the patentee may claim for damages suffered therefrom.

When making a demand pursuant to Paragraph 1, the patentee may request for destruction of the infringing articles or the materials or implements used in infringing the patent, or request for other necessary disposal.

An exclusive licensee may, within the licensed scope, make demands in accordance with the preceding three paragraphs. However, if it is otherwise provided for in an agreement, such agreement shall prevail.

Where the inventor's right to be indicated as such is infringed, the inventor may request to have his/her name indicated or take other measures necessary to recover his/her reputation.

The rights to claim provided for in Paragraph 2 and the preceding

paragraph shall become extinguished if not exercised within two years from the date on which the patentee become aware of the damage and the person liable for damages. This right shall also become extinguished if it is not exercised within ten years from the time of infringement.

#### **Article 97 Calculation of damages**

Damages claimed in accordance with the preceding Article may be calculated according to any of the following methods:

1. the method provided in Article 216 of the Civil Code; patentee may claim damages based on the amount of the balance derived by subtracting the profit earned through exploiting the patent after infringement from the profit normally expected through exploiting the same patent, if no method of proof can be produced to prove the damage suffered;
2. the profit earned by the infringer as a result of patent infringement;
3. the equivalent amount of royalty that may be collected from exploiting the invention patent under licensing.

#### **Article 98 Marking of patent certificate number**

The patent certificate number of a patent shall be marked on the patented article. If such marking cannot be fixed on the patented article, the patentee may make such marking on the labels or packaging, or make such marking in a distinct way sufficient to draw other persons' attention. Where no patent marking is made, evidence shall be produced when claiming damages to prove that the infringer knows or has a reason to know the said article is under patent protection.

#### **Article 99 Presumption of manufacture process used**

Where an article made by using a patented manufacturing process which is unknown within and outside of this country before the filing of a patent application for the manufacturing process, an article identical thereto made

by another person shall be presumed as having been manufactured by using said manufacturing process.

The presumption made under the preceding paragraph may be rebutted by producing proof to the contrary. A proof made by the defendant that the process used by him in manufacturing the article at issue is different from the patented process shall be deemed as proof to the contrary. The legitimate rights and interests with respect to the manufacturing and trade secrets disclosed by the defendant when producing evidence, shall be fully protected.

#### **Article 100 Forwarding an original copy of judgment**

A court shall forward to the Specific Patent Agency an original copy of a judgment issued thereby for a patent litigation case involving an invention patent.

#### **Article 101 Acceleration of invalidation proceedings**

Where an invalidation request involves trial of infringement litigation case, the Specific Patent Agency shall give priority to such invalidation proceedings.

#### **Article 102 Unrecognized foreign juridical person or organization**

An unrecognized foreign juridical person or organization may file civil suits in respect of the matters governed by this Act.

#### **Article 103 Patent infringement assessment**

A court may form specialized tribunal(s) or assign specific staff members to take charge of invention patent litigation cases.

The Judicial Yuan may appoint specialized institution(s) to conduct patent infringement assessments.

A court hearing a litigation pertaining to an invention patent may request the specialized institution appointed according to the preceding paragraph to conduct patent infringement assessment.

## **Chapter III Utility Model Patent**

### **Article 104 Definition of utility model**

"Utility model" means the creation of technical ideas relating to the shape or structure of an article or combination of articles, utilizing the laws of nature.

### **Article 105 Statutory exclusion**

A utility model patent shall not be granted in respect of utility model which is contrary to public order or morality.

### **Article 106 Filing date**

An application for a utility model patent shall be filed with the Specific Patent Agency by the person entitled to applying for patent by submitting a request, a description, claim(s), an abstract, and drawing(s).

The filing date of a utility model patent application shall be the date on which the request, description, claim(s), and drawing(s) are submitted in full.

Where an applicant does not submit a description, claim(s) and drawing(s) in Chinese at the time of filing, but in a foreign language, and where the Chinese translation for the said documents is submitted within the time limit specified by the Specific Patent Agency, the filing date shall be the date on which the foreign language version were originally submitted.

Where the Chinese translation is not submitted within the specified time limit as stated in the preceding paragraph, the patent application shall be dismissed; however, if the Chinese translation is filed prior to the dismissal decision is received, the date on which the Chinese translation is filed shall be regarded as the filing date, and the foreign language version shall be deemed not having been submitted.

### **Article 107 Division of application**

For a utility model patent application which substantially contains two or

more utility models, the said utility model patent application may, upon notice by the Specific Patent Agency or upon request by the applicant, be divided into two or more divisional applications.

A divisional application shall be filed before a decision on the original utility model application is rendered.

#### **Article 108 Conversion of application**

Where a patent application originally filed for invention or design patent is converted into a utility model patent application, or where a patent application originally filed for utility model patent is converted into an invention patent application, the filing date of the converted patent application shall be deemed to have the filing date of the original patent application.

An application for patent conversion shall not be applied under any of the following circumstances:

1. where a written decision allowing the original patent application has been served;
2. where two months have elapsed after serving a decision rejecting the original invention or design patent application;
3. where thirty days have elapsed since serving a decision rejecting the original utility model patent application.

A converted patent application shall not extend beyond the scope of content of the description, claim(s), or drawing(s) of the original patent application as filed.

#### **Article 109 Amendment of application**

When conducting the formality examination of a utility model patent application, the Specific Patent Agency may, upon request or on its own initiative, notify the applicant to amend the description, claim(s) or drawings within a specified time limit.

### **Article 110 Foreign language documents**

Where a utility model patent applicant submits a description, claim(s), and drawings prepared in a foreign language under Paragraph 3 of Article 106, such foreign language documents shall not be amended.

The Chinese translation submitted under Paragraph 3 of Article 106 shall not extend beyond the scope of content of the original foreign language documents as filed.

### **Article 111 Decision of application**

Upon completion of the formality examination of a utility model patent application, a written decision shall be rendered and served on the applicant.

When a utility model patent application is determined to be unpatentable, the reason(s) shall be given in the written decision of formality examination.

### **Article 112 Formality examination**

Through formality examination, a utility model patent application shall be rejected under any of the following circumstances:

1. where the utility model does not relate to the shape, or structure of an article or combination of articles;
2. where there is a violation of Article 105;
3. where there is a violation of Paragraph 4 of Article 26, applicable *mutatis mutandis* under Article 120 of this Act;
4. where there is a violation of Article 33, applicable *mutatis mutandis* under Article 120 of this Act;
5. where the description, claim(s), or drawing(s) does (do) not disclose the essential matters that need to be disclosed, or the disclosure therein is obviously unclear;
6. where an amendment obviously extends beyond the scope of content of the description, claim(s) or drawing(s) as filed.

### **Article 113 Grant of patent; publication**

Where, through formality examination, a claimed utility model shall be patented if there is no reason for negating its patentability, and the claim(s) and the drawing(s) of the patent application shall be published.

### **Article 114 Term of patent**

The term of a utility model patent shall expire after a period of ten years from the filing date of the patent application.

### **Article 115 Request of technical report**

After a utility model patent application is published, any person may file a request with the Specific Patent Agency for obtaining a utility model patent technical report.

The Specific Patent Agency shall publish in the Patent Gazette the fact that the request for obtaining the utility model patent technical report has been filed.

The Specific Patent Agency shall assign a patent examiner to issue the utility model patent technical report, and the report shall bear the name of the above-mentioned examiner.

For request filed under Paragraph 1, the Specific Patent Agency shall issue the utility model patent technical report with respect to matters set forth in Subparagraph 1, Paragraph 1 and Paragraph 2 of Article 22, applicable *mutatis mutandis* under Article 120, Article 23, applicable *mutatis mutandis* under Article 120, and Article 31, applicable *mutatis mutandis* under Article 120.

For request in obtaining the utility model patent technical evaluation report as filed under Paragraph 1, if it is stated in the request that commercial exploit of the utility model patent is made by a party other than the patentee and if supporting evidence is submitted, the Specific Patent Agency shall issue the utility model patent technical report within six months.

Request for obtaining a utility model patent technical evaluation report can still be filed after the utility model patent has become extinguished.

Request filed in accordance with Paragraph 1 shall not be withdrawn.

#### **Article 116 Presentation of technical report**

When exercising a utility model patent, the patentee shall present a utility model patent technical report as warning.

#### **Article 117 Liability of damages; immunity**

Where a utility model patent is invalidated, the patentee shall be liable for compensating damages suffered by another person due to the patentee's exercise of his/her utility model patent prior to the patent invalidation. The above shall not apply if the exercised utility model patent is based on the content of the utility model patent technical report and the patentee has exercised his/her patent with due care.

#### **Article 118 Amendment of granted patent**

With respect to examination of a request for patent amendment, except for the situation set forth in Paragraph 1 of Article 77, applicable *mutatis mutandis* under Article 120 of this Act, the Specific Patent Agency shall conduct formality examination of the patent amendment, issue a decision and serve it on the patentee.

Through formality examination, a decision rejecting the patent amendment shall be rejected under any of the following circumstances:

1. where there is an event prescribed in Subparagraphs 1 to 5 of Article 112;
2. where the amendment obviously extends beyond the scope of content of the claim(s) or drawing(s) as published.

#### **Article 119 Grounds of invalidation**

Any person may request for invalidation against a utility model patent

with the Specific Patent Agency under any of the following circumstances:

1. where there is a violation of Article 104, Article 105, Paragraph 3 of Article 108, Paragraph 2 of Article 110, Article 22 applicable *mutatis mutandis* under Article 120, Article 23 applicable *mutatis mutandis* under Article 120, Article 26 applicable *mutatis mutandis* under Article 120, Article 31 applicable *mutatis mutandis* under Article 120, Paragraph 4 of Article 34 applicable *mutatis mutandis* under Article 120, Paragraph 2 of Article 43 applicable *mutatis mutandis* under Article 120, Paragraph 3 of Article 44 applicable *mutatis mutandis* under Article 120, Paragraphs 2 to 4 of Article 67 applicable *mutatis mutandis* under Article 120 of this Act;

2. where the home country of the patentee does not accept the patent applications filed by nationals of the ROC;

3. where there is a violation of Paragraph 1 of Article 12, or where the utility model patentee is not entitled to file the utility model patent application.

An invalidation request based on Subparagraph 3 of the preceding paragraph shall only be filed by the interested party.

With respect to ground(s) of an invalidation request against a utility model patent, the provisions in effect at the time of said patent approved shall govern. However, if an invalidation request is filed based on the ground(s) under Paragraph 3 of Article 108, Paragraph 4 of Article 34 applicable *mutatis mutandis* under Article 120, Paragraph 2 of Article 43 applicable *mutatis mutandis* under Article 120, or Paragraph 2 and paragraph 4 of Article 67 applicable *mutatis mutandis* under Article 120, the provisions in effect at the time of filing said request shall govern.

A written decision on an invalidation request shall bear the names of the patent examiners.

#### **Article 120 Provisions applied *mutatis mutandis* to utility model patent**

Article 22, Article 23, Article 26, Articles 28 to 31, Article 33, Paragraphs 3

and 4 of Article 34, Article 35, Paragraphs 2 and 3 of Article 43, Paragraph 3 of Article 44, Paragraph 2 of Article 46, Paragraph 2 of Article 47, Article 51, Paragraphs 1, 2 and 4 of Article 52, Paragraphs 1, 2, 4 and 5 of Article 58, Article 59, Articles 62 to 65, Article 67, Paragraphs 2 and 3 of Article 68, Article 69, Article 70, Articles 72 to 82, Articles 84 to 98, and Articles 100 to 103 of this Act shall apply *mutatis mutandis* to utility model patent.

## **Chapter IV Design Patent**

### **Article 121 Definition of design**

"Design" means the creation made in respect of the shape, pattern, color, or any combination thereof, of an article as a whole or in part by visual appeal.

For computer generated icons (Icons) and graphic user interface (GUI) applied to an article, an application may also be filed pursuant to this Act for obtaining a design patent.

### **Article 122 Substantial conditions**

A design which is industrially applicable may be granted a design patent upon application in accordance with this Act, provided any of the following does not exist:

1. an identical design or a similar design was disclosed in a publication prior to the filing of the patent application;
2. an identical design or a similar design was publicly exploited prior to the filing of the patent application;
3. a design was publicly known prior to the filing of the patent application.

Where a design can be easily conceived by a person ordinarily skilled in the art of the design based on prior art, a design patent shall not be granted for such a design notwithstanding the preceding paragraph.

Any of the following events shall not be deemed as one prescribed in

Paragraph 1 or the preceding paragraph, which may preclude the granting of a design patent, provided that the concerned design patent application is filed within six months from the date of the event's occurrence:

1. the design was disclosed in a publication;
2. the design was displayed at an exhibition held or recognized by the government;
3. the design was disclosed without the consent of the applicant.

An applicant claiming exemption as set forth in Subparagraph 1 and Subparagraph 2 of the preceding paragraph shall state the fact and the relevant date in the patent application at the time of filing and submit evidentiary documents within the time limit specified by the Specific Patent Agency.

#### **Article 123 Deemed as lack of novelty**

Where a design claimed in a design patent application is identical or similar to a design disclosed in the description or drawings of an earlier-filed design patent application which is laid open or published after the filing of the later-filed design patent application, a design patent shall not be granted to such design; however, this shall not apply where the applicant of the later-filed design patent application is the same as the applicant of the earlier-filed design patent application.

#### **Article 124 Statutory exclusion**

A design patent shall not be granted in respect of any of the following:

1. a shape of an article, which is solely dictated by its function;
2. an artistic work;
3. the layout of an integrated circuit and electronic circuits;
4. an article contrary to public order or morality.

### **Article 125 Filing date**

An application for a design patent shall be filed with the Specific Patent Agency by the person entitled to applying for patent by submitting a request, a description and drawings.

The filing date of a design patent application shall be the day on which the request, description and drawings are submitted in full.

Where an applicant does not submit a description and drawings in Chinese at the time of filing, but in a foreign language, and where the Chinese translation for the said documents is submitted within the time limit specified by the Specific Patent Agency, the filing date shall be the date on which the foreign language version was originally submitted.

Where the Chinese translation is not submitted within the specified time limit as stated in the preceding paragraph, the design patent application shall be dismissed; however, if the Chinese translation is filed prior to the dismissal decision is received, the date on which the Chinese translation is filed shall be regarded as the filing date, and the foreign language version shall be deemed not having been submitted.

### **Article 126 Disclosure**

A description and drawings shall disclose the design in a manner clear and sufficient for it to be understood and carried out by a person ordinarily skilled in the art of the design.

Manner of disclosure for description and drawings shall be prescribed in the Enforcement Rules of the Patent Act.

### **Article 127 Application and restriction of derivative design patent**

For two or more similar designs owned by the same person, applications may be filed for a design patent and its derivative design patents.

The filing date of a derivative design patent application shall not be earlier than the filing date of the original design patent application.

An application for derivative design patent filed after the publication of the original design patent is not acceptable.

A design owned by the same person cannot file a derivative design patent which is similar only to another derivative design but not to the original design.

#### **Article 128 Principle of first-to-file**

Where two or more design patent applications are filed for the same or similar design(s), only the first-filed application can be granted. The above shall not apply if the priority date claimed for the later-filed application is earlier than the filing date of the earlier application.

Where the filing date and the priority date referred to in the preceding paragraph are the same, the applicants shall be notified to reach an agreement with respect to the matter concerned. If such an agreement cannot be reached, none of the applications shall be granted. If the said design patent applications are filed by the same applicant, the applicant shall be notified to select one design patent application within a time limit; failure to make a selection within the time limit shall result in rejection of all such design patent applications.

While the applicants concerned are in progress of reaching an agreement, the Specific Patent Agency shall require these applicants to report the results of the negotiation within an appropriate time limit. If said report is not submitted within the specified time limit, it shall be deemed that the agreement is not reached.

The above three paragraphs shall not apply to any of the following:

1. the applications for the original design and its derivative design(s);
2. the applications for two or more derivative designs originated from the same original design.

#### **Article 129 Unity; design for a set of articles**

An application for a design patent shall relate to one design.

Two or more articles belonging to the same class and are customarily sold or used together may be filed as for one design.

An application for a design patent shall indicate the article to which the design is applied.

#### **Article 130 Division of application**

For a design patent application which substantially contains two or more designs, said design patent application may, upon notice by the Specific Patent Agency or upon request by the applicant, be divided into two or more divisional applications.

A divisional application shall be filed before a reexamination decision on the original application is rendered.

For a divisional patent application, the examination thereof shall be continued from the examination procedure of the original patent application.

#### **Article 131 Conversion between design patent and derivative design patent**

When a design patent application is converted into a derivative design patent application or where a derivative design patent application is converted into a design patent application, the filing date of the converted design patent application shall be deemed to have the filing date of the original design patent application.

A converted design patent application shall not be filed under any of the following circumstances:

1. after a written decision granting the original application is served;
2. after two months from the date on which a written decision rejecting the original application is served.

A converted design patent application or a derivative design patent application shall not extend beyond the scope of disclosure in the description and/or drawings of the original application as filed.

### **Article 132 Conversion into design patent**

Where an application originally filed for invention or utility model patent is converted into a design patent application, the filing date of the converted design patent application shall be deemed to have the filing date of the original application.

A converted application shall not be made under any of the following conditions:

1. where a written decision granting the original patent application is served;
2. after two months from the date on which a written decision rejecting the original invention patent application is served;
3. after thirty days from the date on which a written decision rejecting the original utility model patent application is served.

A converted patent application shall not extend beyond the scope disclosed in the description, claims, or drawings of the original patent application as filed.

### **Article 133 Foreign language documents**

Where a patent applicant submits a description and drawings prepared in a foreign language under Paragraph 3 of Article 125, such foreign language documents shall not be amended.

The Chinese translation submitted under Paragraph 3 of Article 125, shall not extend beyond the scope of content of the original foreign language documents as filed.

### **Article 134 Grounds for rejection decision**

When a design patent application is in violation of any of the provisions set forth in Articles 121 to 124, Article 126, Article 127, Paragraphs 1 to 3 of Article 128, Paragraphs 1 and 2 of Article 129, Paragraph 3 of Article 131, Paragraph 3 of Article 132, Paragraph 2 of Article 133, Paragraph 4 of Article

34 applicable *mutatis mutandis* under Paragraph 1 of Article 142, Paragraph 2 of Article 43 applicable *mutatis mutandis* under Paragraph 1 of Article 142, and Paragraph 3 of Article 44 applicable *mutatis mutandis* under Paragraph 1 of Article 142 of this Act, a rejection decision shall be rendered.

#### **Article 135 Term of patent**

The term of a design patent shall expire after a period of twelve years from the filing date of the application. A derivative design patent, shall expire simultaneously with the original design patent.

#### **Article 136 Effects of design patent right**

Unless otherwise provided in this Act, the patentee of a design patent has the exclusive right to prevent others from exploiting the design or similar design(s) without the patentee's consent.

The extent of the protection conferred by a design patent shall be determined by the drawings, and the description may be considered as a reference.

#### **Article 137 Claim of derivative design patent**

The derivative design patent right can be claimed independently, and its effect shall be extended to the scope of similarity.

#### **Article 138 Disposal of derivative design patent**

A derivative design patent right shall be assigned, entrusted, inherited, licensed or pledged together with its original design patent.

Where the original design patent right has become extinguished or has been invalidated in accordance with Subparagraph 3 or 4, Paragraph 1 of Article 70 applicable *mutatis mutandis* under Paragraph 1, Article 142, and where there are two or more derivative design patents still in force, the derivative design patents shall not be separately assigned, entrusted, licensed, or pledged.

### **Article 139 Amendment of granted design patent**

When applying for amending the description or drawings of a design patent, the patentee shall only conduct the amendment as follows :

1. to correct erroneous disclosure or incorrect translations;
2. to clarify ambiguous statement.

Except for correction of incorrect translations, an amendment shall not extend beyond the scope of content of the description or drawings as filed.

For a design patent application filed by submitting the description and drawings prepared in a foreign language pursuant to Paragraph 3 of Article 125, a correction of incorrect translations shall not be beyond the scope of content of the foreign language documents as filed.

An amendment shall not substantially enlarge or alter the scope of drawings as published.

### **Article 140 Restriction of abandon of design patent right**

A design patentee shall not abandon his/her own design patent right without consent of the licensee(s) or pledgee(s).

### **Article 141 Grounds for invalidation**

Any person may request for invalidation against a design patent with the Specific Patent Agency under any of the following circumstances:

1. where there is a violation of any of the provisions set forth in Articles 121 to 124, Article 126, Article 127, Paragraphs 1 to 3 of Article 128, Paragraph 3 of Article 131, Paragraph 3 of Article 132, Paragraph 2 of Article 133, Paragraphs 2 to 4 of Article 139, Paragraph 4 of Article 34 applicable *mutatis mutandis* under Paragraph 1, Article 142, Paragraph 2 of Article 43 applicable *mutatis mutandis* under Paragraph 1, Article 142 and Paragraph 3 of Article 44 applicable *mutatis mutandis* under Paragraph 1, Article 142 of this Act;
2. where the home country of the patentee does not accept patent

applications filed by nationals of the ROC;

3. where there is a violation of Paragraph 1 of Article 12 of this Act or where the design patentee concerned is not entitled to file the design patent application.

An invalidation request based on Subparagraph 3 of the preceding paragraph shall only be filed by the interested party.

With respect to ground(s) of an invalidation request against a design patent, the provisions in effect at the time of said patent approved shall govern. However, if an invalidation request is filed based on the ground(s) under Paragraph 3 of Article 131, Paragraph 3 of Article 132, Paragraphs 2 and 4 of Article 139, Paragraph 4 of Article 34 applicable *mutatis mutandis* under Paragraph 1, Article 142, or Paragraph 2 of Article 43 applicable *mutatis mutandis* under Paragraph 1, Article 142 of this Act, such invalidation action shall be governed by the provisions in effect at the time of filing said request.

#### **Article 142 Provisions applied *mutatis mutandis* to design patent**

The provisions of Article 28, Article 29, Paragraphs 3 and 4 of Article 34, Article 35, Article 36, Article 42, Paragraphs 1 to 3 of Article 43, Paragraph 3 of Article 44, Article 45, Paragraph 2 of Article 46, Article 47, Article 48, Article 50, Paragraphs 1, 2 and 4 of Article 52, Paragraph 2 of Article 58, Article 59, Articles 62 to 65, Article 68, Article 70, Article 72, Paragraphs 1, 3 and 4 of Article 73, Articles 74 to 78, Paragraph 1 of Article 79, Articles 80 to 82 Articles 84 to 86, Articles 92 to 98, Articles 100 to 103, of this Act shall apply *mutatis mutandis* to design patents.

In the case of design patent applications, the time period specified in Paragraph 1 of Article 28 shall be six months.

In the case of design patent applications, the time period specified in Paragraphs 2 and 4 of Article 29 shall be ten months.

## **Chapter V Supplementary Provisions**

### **Article 143 Preservation of patent files**

Patent files containing application documents, description, claim(s), abstract, drawing(s) shall be kept permanently in the custody of the Specific Patent Agency. Other documents shall be kept for a period of no more than thirty years.

The patent files referred to in the preceding paragraph may be stored on microfilm, magnetic disc, magnetic tape, optical disc or other storage medium. The files thus stored which have been confirmed by the Specific Patent Agency shall be deemed the original files, and the original hard copy of such patent files may be destroyed. A reproduced copy of the stored patent file shall be deemed a true copy upon confirmation by the Specific Patent Agency.

Rules governing the confirmation, administration, and use of substitutes for the stored files referred to in the preceding paragraph shall be prescribed by the competent authority.

### **Article 144 Prescription of regulations governing awards for creations**

The competent authority may prescribe the regulations governing awards for creations of inventions, utility models, or designs.

### **Article 145 Prescription of regulations governing submission of foreign language documents**

With respect to the foreign language documents submitted in accordance with Paragraph 3 of Article 25, Paragraph 3 of Article 106, and Paragraph 3 of Article 125, the competent authority shall prescribe the regulations governing the limitation of foreign language categories and other matters.

### **Article 146 Prescription of regulations governing fees**

Regulations governing application fees, issuance fees and annuities set forth in Article 92, Article 92 applicable *mutatis mutandis* under Article 120,

and Article 92 applicable *mutatis mutandis* under Paragraph 1 of Article 142 of this Act shall be promulgated by the competent authority.

Regulations governing the conditions, number of years, amounts, and other matters concerning the reduction or exemption of patent annuities as set forth in Article 95, Article 95 applicable *mutatis mutandis* under Article 120, and Article 95 applicable *mutatis mutandis* under Paragraph 1 of Article 142 of this Act shall be promulgated by the competent authority.

**Article 147 Transitional provisions: patent term extension**

A patent application filed before January 23, 1994, shall not apply for patent term extension under Article 53.

**Article 148 Transitional provisions: patent term**

For patents that have been published prior to the implementation of the January 21, 1994, amendment of this Act, their patent terms shall be calculated in accordance with the Patent Act in effect prior to the 1994 amendment. However, for invention patents that are still in force on the date when the WTO Agreement took effect in the territory of the ROC, their patent terms shall be governed by the amended Act.

For utility model patents that have been published prior to the implementation of the January 3, 2003, amendment of this Act, their patent terms shall be governed by the amended Patent Act.

For design patents that are still in force on the date when the WTO Agreement took effect in the territory of the ROC, their patent terms shall be governed by the May 7, 1997, amendment of the Patent Act.

**Article 149 Transitional provisions: pending cases**

Unless otherwise provided for in the Act, patent applications which have been filed but are still pending prior to the implementation of the November 29, 2011, amendment of this Act, the amended Patent Act shall govern.

For requests for patent amendment and invalidation which have been filed but are still pending prior to the implementation of the November 29, 2011, amendment of this Act, the amended Patent Act shall govern.

**Article 150 Transitional provisions: Priority claim based on earlier application; division**

For invention or utility model patent applications which have been filed prior to the implementation of the November 29, 2011, amendment of this Act with priority claims made in accordance with the former Article 29, if the prior patent applications have not been published or rejected, or these patent application have not become irrevocably, Paragraph 1 of Article 30 shall apply.

For invention patent applications which have been rendered examination decisions prior to the implementation of the November 29, 2011, amendment to this Act, if the time period stated in Subparagraph 2, Paragraph 2 of Article 34 has not expired, Subparagraph 2, Paragraph 2 and Paragraph 6 of Article 34 shall apply.

**Article 151 Transitional provisions: grace period; design patent**

Subparagraph 2, Paragraph 3 of Article 22, Subparagraph 2, Paragraph 3 of Article 22 applicable *mutatis mutandis* under Article 120, Paragraph 1 of Article 121, which pertains to the partial design, Paragraph 2 of Article 121, Subparagraph 1, Paragraph 3 of Article 122, Article 127, and Paragraph 2 of Article 129 shall be applicable only to patent applications filed after the implementation of the November 29, 2011, amendment of this Act.

**Article 152 Transitional provisions: deposit of biological material**

For invention patent applications that, prior to the implementation of the November 29, 2011, amendment of this Act, were found to violate the former Paragraph 2, Article 30, for which the deposits are deemed not having been

made, and the applications are still pending at the time of implementing the amendment to this Act, Paragraph 2 of Article 27 shall apply. For invention patent applications filed with priority claims, if the sixteen-month time period from the earliest priority date has not been expired, Paragraph 3 of Article 27 shall apply.

**Article 153 Transitional provisions: Priority claim under WTO membership, etc.**

Where, prior to the implementation of the November 29, 2011, amendment of this Act, patent applications that have been found to violate the former Paragraph 1 of Article 28, Paragraph 1 of Article 28 applicable *mutatis mutandis* under Article 108, and Paragraph 1 of Article 28 applicable *mutatis mutandis* under Paragraph 1 of Article 129 of this Act, and thus cannot claim priority in accordance with Paragraph 3 of Article 28, Paragraph 3 of Article 28 applicable *mutatis mutandis* under Article 108 or Paragraph 3 of Article 28 applicable *mutatis mutandis* under Paragraph 1 of Article 129 of this Act, if the patent applications are still pending at the time of implementation of the amendment of this Act, and if, for invention and utility model patent applications the period of sixteen months, for design patent applications the period of ten months from the earliest priority date has not elapsed respectively, Paragraph 4 of Article 29, Paragraph 4 of Article 29 applicable *mutatis mutandis* under Article 120, and Paragraph 4 of Article 29 applicable *mutatis mutandis* under Paragraph 1 of Article 142 of this Act shall apply.

Where, prior to the implementation of the November 29, 2011, amendment of this Act, patent applications that have violated the former Paragraph 1 of Article 28, Paragraph 1 of Article 28 applicable *mutatis mutandis* under Article 108 or Paragraph 1 of Article 28 applicable *mutatis mutandis* under Paragraph 1 of Article 129 of this Act, and thus cannot claim priority in accordance with Paragraph 3 of Article 28, Paragraph 3 of Article 28 applicable *mutatis mutandis* under Article 108, Paragraph 3 of Article 28

applicable *mutatis mutandis* under Paragraph 1 of Article 129 of this Act, if the patent applications are still pending at the time of implementation of the amendment, and if, for invention and utility model patent applications the period of sixteen months, for design patent applications the period of ten months from the earliest priority date has not elapsed respectively, the provisions of Paragraph 2 of Article 29, Paragraph 2 of Article 29 applicable *mutatis mutandis* under Article 120, and Paragraph 2 of Article 29 applicable *mutatis mutandis* under Paragraph 1 of Article 142 of this Act shall apply.

**Article 154 Transitional provisions: request for extending patent term**

A request for invention patent term extension that were filed prior to the implementation of the November 29, 2011, amendment of this Act, if decisions have not been issued for the request and if said invention patent is still in force at the time of implementing the amended Act, the amended Act shall govern.

**Article 155 Transitional provisions: no revival of extinguished patent right**

If any of the following events exists at the time of implementing the November 29, 2011, amendment of this Act, Paragraph 4 of Article 52, Paragraph 2 of Article 70, Paragraph 4 of Article 52 applicable *mutatis mutandis* under Article 120, Paragraph 2 of Article 70 applicable *mutatis mutandis* under Article 120, Paragraph 4 of Article 52 applicable *mutatis mutandis* under Paragraph 1 of Article 142, and Paragraph 2 of Article 70 applicable *mutatis mutandis* under Paragraph 1 of Article 142 shall not apply:

1. where, at the time of implementing the November 29, 2011, amendment of this Act, the time limit for paying an annuity has expired and the concerned patent has been deemed non-existent *ab initio* pursuant to Paragraph 1 of Article 51, Paragraph 1 of Article 101, or Paragraph 1 of Article 113 of this Act in effect prior to the amendment;

2. where, at the time of implementing the November 29, 2011,

amendment of this Act, a patent has become extinguished in accordance with Subparagraph 3 of Article 66, Subparagraph 3 of Article 66 applicable *mutatis mutandis* under Article 108, or Subparagraph 3 of Article 66 applicable *mutatis mutandis* under Paragraph 1 of Article 129 of this Act in effect prior to the amendment.

#### **Article 156 Transitional provisions: pending design patent application**

Where, at the time of implementing the November 29, 2011, amendment of this Act, a decision for a design patent application is still pending, the applicant may, within three months after the implementation date of the amended Act, apply to convert it into a partial design.

#### **Article 157 Transitional provisions: pending associated design patent application**

Where, at the time of implementing the November 29, 2011, amendment of this Act, an associated design patent application is still pending, the provisions of this Act prior to amendment with respect to associated design patent shall apply.

For an associated design patent application still pending at the time of implementing the November 29, 2011, amendment of this Act, if the associated design patent application was filed prior to the publication of their original design patent application, the applicant may convert said associated design patent application into derivative design patent application within three months as of the implementation of the amended Act.

#### **Article 158 Prescription of Enforcement Rules**

The Enforcement Rules of this Act shall be prescribed by the competent authority.

#### **Article 159 Date of implementation**

The date on which this Act takes effect shall be decided by the Executive Yuan.