

## ► LAWS & REGULATIONS ◀

### **TIPO Clarifies Applicable Interpretations for Certain Provisions in New Patent Act**

TIPO announced a few days ago the applicable interpretations to certain provisions in the newly promulgated Patent Act of February 6, 2003, which entered into force on July 1, 2004:

1. Article 108 applying *mutatis mutandis* to Article 33ter:  
Since Article 33ter stipulates that “divisional applications shall be filed before the re-examination decision on the original application is rendered,” and that re-examination no longer exists since utility model patent undertakes formality examination, related provisions no longer apply. Therefore, divisional applications for utility models shall be filed before the decision on the original application is rendered.
2. Article 12bis, Article 34, Article 67bis and ter:  
To protect the interests of the patent application right owner, a jointly owned patent application right that is not filed jointly by all joint-owners shall be revoked once it has been reported and confirmed to be in violation of Article 12bis. Other joint-owners may report such violation within two years from the date of publication. Once the violation is confirmed and the patent right is revoked, all joint-owners may apply for patent under Article 34.
3. Article 133 and Article 135:  
The addendum patent system was deleted from the Patent Act that was promulgated on October 24, 2001. However, pending patent applications filed before that promulgation date would be processed under the provisions stipulated prior to the promulgation. Since the new Patent Act stipulates that utility model patent will be subject to formality examination, pending applications filed before the new Act entered into force shall be subject to formality examination pursuant to Article 135. Examination guidelines for pending addendum patent applications file prior to the enforcement of the new Act are as follows:
  - a. Pending utility model patent applications and their addendum cases shall be examined pursuant to Article 135 under formality examination.
    - 1) Addendum applications for utility model patent applications will be approved after the original utility model patent applications had been approved by formality examination and licensed (pursuant to Rule 21.2 of the *Implementing Regulations of the Patent Act* prior to its revision on November 6, 2002: “Patent authority shall wait until the patent application has been issued patent certificate before approving its addendum.”)
    - 2) If for any reason the certificate for the original utility model patent application was not picked up, the applicant for the addendum application will be notified to change the addendum application to an independent patent application. If the applicant does not change his application, the addendum application will not be processed.
    - 3) If the original utility model patent application was rejected of its decision or was rejected of patent disciplinary action decision, the applicant for the addendum application will be notified to change the addendum application to an independent patent application. If the applicant does not change his application, the addendum application will not be processed.
    - b. If the original utility model patent application was examined under the substantial examination system prior to the enactment of the new Patent Act, but its addendum application was still pending, such application shall be processed as follows:
      - 1) If the opposition was established or the patent examination was refused for the original utility model patent application, the applicant for the addendum application will be notified to change the addendum application to an independent patent application, and the application will be examined under formality examination. If the applicant does not change his application, the addendum application will not be processed.
      - 2) If the opposition was not established or the patent examination was approved for the original utility model patent application, the applicant will be notified to pick up the certification if it has not been done so. After the certification is picked up, the addendum application will be examined under substantial examination in accordance to Article 133. If the certification has already been picked up, the addendum application will be examined under substantial examination in accordance to Article 133. If the addendum application was rejected at the preliminary examination, the applicant may apply for re-examination or change the application to an individual utility model patent application. At which, the application shall be subject to formality examination.
4. Article 135:  
Pending patent applications referred to in this Article are applications that have not completed preliminary or re-examination. These include cases whose original disciplinary action has been repealed by TIPO at the time of appeal but has not been rendered by re-examination, and cases whose appeal has been rendered or whose disciplinary action has been repealed by the court, but is

still pending for re-examination at TIPO.

## New Rules of Patent Fees Took Effect July 1, 2004

Since patent fees have been adjusted in compliance to the new Patent Act, the new *Rules of Patent Fees* entered into force on the same day the new Patent Act took effect on July 1, 2004. Major revisions to the Rules are as follows:

1. Invention patent fees are adjusted based on administrative costs.

2. Utility model patent fees are adjusted in compliance to the change in examination system for utility model patent from substantial examination to formality examination, and in the insertion of provisions for technology reports.
3. Other application fees, certification fees, re-issuance fees, and change of certification fees are adjusted based on administrative costs.
4. Annual fees for 7<sup>th</sup> to 9<sup>th</sup> year and for 10 years and beyond are adjusted.
5. Pending utility model patent application that has not been approved at the time the new Act takes effect, its fees shall be adjusted accordingly.
6. Stipulates transition fees for oppositions.

### Patent Fees

No.	Items	Old fees	New fees	Difference	% of difference
<b>Invention Applications</b>					
1	Invention patent application	NT\$2000	NT\$3500	NT\$1500	75%
2	Request for substantive examination	NT\$6000	NT\$8000	NT\$2000	33.3%
3	Application for conversion of an application into an invention application	NT\$2000	NT\$3500	NT\$1500	75%
4	Request for early laying-open of an invention patent application	NT\$1000	NT\$1000	(unchanged)	(unchanged)
5	Request for re-examination	NT\$6000	NT\$8000	NT\$2000	33.3%
6	Application for invalidation	NT\$9000	NT\$10,000	NT\$1000	11.1%
7	Divisional application	NT\$2000	NT\$3500	NT\$1500	75%
8	Application for extension of patent term	NT\$9000	NT\$9000	(unchanged)	(unchanged)
9	Application for correction of specification or drawings	NT\$2000	NT\$2000	(unchanged)	(unchanged)
10	Application for compulsory license	NT\$9000	NT\$100,000	NT\$91,000	1011%
11	Application for revocation of compulsory license	(new fee)	NT\$100,000	(new fee)	(new fee)
12	Filing a supplemental brief or evidence in an invalidation	NT\$1000	NT\$2000	NT\$1000	100%
<b>Utility Model Applications</b>					
13	Utility model application (formality examination)	NT\$4500	NT\$3000	-NT\$1500	-33.3%
14	Application for conversion of an application into a utility model patent application (formality examination)	NT\$4500	NT\$3000	-NT\$1500	-33.3%
15	Application for invalidation	NT\$8500	NT\$9000	NT\$500	5.88%
16	Divisional application (formality examination)	NT\$4500	NT\$3000	-NT\$1500	-33.3%
17	Applying for technical report of a utility model patent	(new fee)	NT\$5000	(new fee)	(new fee)
18	Application for correction of specification or drawings	NT\$2000	NT\$2000	(unchanged)	(unchanged)
19	Filing a supplemental brief or evidence in an invalidation	NT\$1000	NT\$2000	NT\$1000	100%
<b>Design Patent Applications</b>					
20	Design patent application	NT\$3000	NT\$3000	(unchanged)	(unchanged)
21	Associated design patent application	NT\$3000	NT\$3000	(unchanged)	(unchanged)
22	Divisional application	NT\$3000	NT\$3000	(unchanged)	(unchanged)
23	Application for conversion of an application into a design patent application	NT\$3000	NT\$3000	(unchanged)	(unchanged)
24	Request for re-examination	NT\$3500	NT\$3500	(unchanged)	(unchanged)
25	Application for correction of specification or drawings	NT\$2000	NT\$2000	(unchanged)	(unchanged)
26	Application for invalidation	NT\$8000	NT\$8000	(unchanged)	(unchanged)
27	Filing a supplemental brief or evidence in an invalidation	NT\$1000	NT\$2000	NT\$1000	100%
<b>Other Official Fees</b>					
28	Recordal of assignment or inheritance for the right to apply for patent	NT\$2000	NT\$2000	(unchanged)	(unchanged)

	Recordal of assignment or inheritance for patent right	NT\$3500	NT\$2000	-NT\$1500	-42.86%
30	Recordal of license of patent right	NT\$4000	NT\$2000	-NT\$2000	-50%
31	Recordal of pledge over patent right	NT\$4000	NT\$2000	-NT\$2000	-50%
32	Recordal of extinguishments of pledge over patent right	(new fee)	NT\$2000	(new fee)	(new fee)
33	Recordal of other changes pertaining to pledge over patent right	(new fee)	NT\$300	(new fee)	(new fee)
34	Recordal of trust of patent right	NT\$3500	NT\$2000	-NT\$1500	-42.86%
35	Recordal of obliteration of patent trust	NT\$2000	NT\$2000	(unchanged)	(unchanged)
36	Recordal of ownership of patent trust	NT\$2000	NT\$2000	(unchanged)	(unchanged)
37	Recordal of other changes pertaining to patent trust	NT\$300	NT\$300	(unchanged)	(unchanged)
38	Application for certified copy of a document	NT\$600	NT\$1000	NT\$400	66.67%
39	Request for an interview	NT\$2000	NT\$1000	-NT\$1000	-50%
40	Request for inspection of experiments, models or specimens conducted/submitted	NT\$3500	NT\$5000	NT\$1500	42.86%
41	Application for changes	NT\$300	NT\$300	(unchanged)	(unchanged)
<b>Certification and Annual Fees</b>					
42	Certification fee	NT\$2500	NT\$1000	-NT\$1500	-60%
43	Re-issuance of certification	NT\$1250	NT\$600	-NT\$650	-52%
44	1 <sup>st</sup> -3 <sup>rd</sup> year	NT\$2500	NT\$2500	(unchanged)	Natural persons, schools and SMEs NT\$800 deduction
45	4 <sup>th</sup> -6 <sup>th</sup> year	NT\$5000	NT\$5000	(unchanged)	Natural persons, schools and SMEs NT\$1200 deduction
46	7 <sup>th</sup> -9 <sup>th</sup> year	NT\$10,000	NT\$9000	NT\$1000	-10%
47	10 <sup>th</sup> year and beyond	NT\$20,000	NT\$18,000	NT\$2000	-10%

### **Tie Limit for Processing Patent, Trademark, Copyright, and Integrated Circuit Layout Related Applications Revised**

Pursuant to Article 51*bis* of the Administrative Procedure Act, TIPO announced on May 19, 2004 the revision to the *Time Limit for Processing Trademark, Copyright, and Integrated Circuit Layout Related Applications*. The revision took effect on the same day it was announced. Also on the same day, the *Time Limit for Processing Patent Related Applications* was announced, but took effect on July 1, 2004.

#### **Time Limit for Processing Patent Related Applications**

No.	Item	Time limit
1	Preliminary examination for invention patent (applying for substantial examination)	18 months
2	Early laying-open of an invention patent	8 months
3	Applying for priority examination of an invention patent	10 months
4	Re-examination for electric machinery and chemical engineering cases	15 months
5	Re-examination for machinery and daily commodities cases	12 months
6	Compulsory license of an invention patent	24 months
7	Revocation of a compulsory license of an invention patent	18 months
8	Rendering compensation for compulsory license of an invention patent	6 months
9	Extension of an invention patent term	12 months
10	Utility model patent application	6 months
11	Technical report of a utility model patent	12 months
12	Technical report of a utility model patent (for business practices for non-right holder)	6 months

13	Preliminary examination for utility model patent	12 months
14	Preliminary examination for associate utility model patent	16 months
15	Re-examination for utility model patent	12 months
16	Re-examination for associate utility model patent	16 months
17	Opposition	10 months
18	Invalidation	12 months
19	Priority examination for invalidation	6 months
20	Correction of specification or drawings	6 months
21	Division of patent (this item no longer exists after the new Act takes effect)	3 months

Note: The time frame for processing each type of application begins from the date the application is received. However, any legitimate delays such as notification to make correction, applying for re-evaluation, replying to charges, etc., are not counted in the processing time.

#### **Time Limit for Processing Integrated Circuit Layout Applications**

No.	Item	Time limit
1	Integrated circuit layout registration	3 months
2	Cancellation of integrated circuit layout registration	12 months
3	Compulsory license for integrated circuit layout	24 months
4	Revocation of compulsory license of integrated circuit layout registration	18 months
5	Appraising integrated circuit layout right	24 months
6	Mediating integrated circuit layout right disputes	6 months

Note: The time frame for processing each type of application begins from the date the application is received. However, any legitimate delays such as notification to make correction, applying for re-evaluation, replying to charges, etc., are not counted in the processing time.

### Time Limit for Processing Trademark Applications

No.	Item	Time limit
1	Trademark registration	9 months
2	Extension of trademark term	2 months
3	Licensing and re-licensing registration	1 month
4	Cancellation licensing (re-licensing) registration	1 month
5	Transfer of trademark right registration	2 months
6	Division of trademark registration	2 months
7	Division of trademark right	2 months
8	Changes in registration item	1 month
9	Reduction of goods for registered trademark	1 month
10	Trademark pledge registration	1 month
11	Cancellation of trademark pledge registration	1 month
12	Re-issue or change in trademark registration certificate	1 month
13	Other certifications	1 month
14	Revocation of trademark right	6 months
15	Oppositions	5 months
16	Appraisals	6 months

Note: The time frame for processing each type of application begins from the date the application is received. However, any legitimate delays such as notification to make correction, applying for re-evaluation, replying to charges, etc., are not counted in the processing time.

### Time Limit for Processing Copyright Applications

No.	Item	Time limit
1	Permit for compulsory licensing of music copyright	4 months
2	Plate right registration	2 months
3	Transfer of ownership and registration or plate right	2 months
4	Registration of plate right trust	2 months
5	Permit for setting up copyright intermediary organization	12 months
6	Copyright dispute mediation	4 months
7	Documents for exports of audio-visual copyrighted works and OEM audio CDs	Process on first come first serve basis

Note: The time frame for processing each type of application begins from the date the application is received. However, any legitimate delays such as notification to make correction, applying for re-evaluation, replying to charges, etc., are not counted in the processing time.

### Utility Model Patent Application Submitted Before June 30, 2003 and Have Not Been Approved Prior to the Enactment of the New Patent Act Shall be Examined Under Formality Examination

According to TIPO, a total of 751 utility model patent applications that were filed before June 30, 2003 were still pending for approval as of July 1, 2004 when the new Patent

Act entered into force. Pursuant to Article 135, pending applications shall be subject to provisions stipulated in the new Patent Act, and are subject to formality examination.

### New Regulations for Reading Patent Archives Entered into Force July 1, 2004

MOEA announced on June 15, 2004 the revisions to the *Regulations for Reading Patent Archives*, which entered into force on July 1, 2004. The revisions provide examiners who are entrusted by the court to examine a patent case the right to apply for reading patent archives if such act shall be useful in rendering an examination. In addition to revising certain wordings and changing article numbers to help clarify provisions in the Regulations, the new Regulations also deleted provisions on the limitation as to how many people may accompany the examiner in reading the archives and the manner in which their tasks are divided. The new Regulations inserted provisions that prohibit the examiners from damaging the archives in any way and changing the “examiner’s suggestion form” to “examination form for invention/utility model cases and suggestion form for patent technology report”.

### New Patent Applications Forms Effective July 1, 2004

TIPO announced on June 29, 2004 the revisions to patent application forms that took effect on July 1, 2004 along with the new Patent Act. All forms may be downloaded from TIPO’s website at [http://www.tipo.gov.tw/patent/patent\\_table.asp](http://www.tipo.gov.tw/patent/patent_table.asp). All old forms may still be used until September 30, 2004 as long as cited Articles and wordings on the forms are changed so that they are in compliance with the new Act. All old forms will become invalid on October 1, 2004.

### TIPO’s Inspection Center at the CKS International Airport Closed Its Doors on July 1, 2004

On July 1, TIPO’s Inspection Center at the CKS International Airport closed its doors permanently in conjunction to the abolishment of the *Regulations for Establishing and Managing the TIPO’s Inspection Center at the CKS International Airport* on June 30. The Regulations are no longer in effect as of July 1, 2004. In addition, Article 4 of the *Regulations for Processing Exports of Audio-Visual Copyrighted Works and OEM Audio CDs Documents* has been revised and took effect on July 1, 2004.

## TAIWAN IPR NEWS

PUBLISHER / JEN-SHYONG HO  
EDITOR-IN-CHIEF / YEA-KANG WANG  
DEPUTY EDITOR-IN-CHIEF / JOSEPH C. CHEN  
EDITORS / FRANCK LIN ANFERY HSU  
TRANSLATOR / K. KAILI LONG

PUBLISHING AGENCY /  
INTELLECTUAL PROPERTY PROTECTION COMMITTEE,  
CHINESE NATIONAL FEDERATION OF INDUSTRIES  
ADDRESS / 12TH FL., 390, FU HSING S. RD., SEC. 1,  
TAIPEI, TAIWAN, R.O.C.  
TEL / 886-2-27033500 FAX / 886-2-27042477  
E-MAIL / [intell@cnfi.org.tw](mailto:intell@cnfi.org.tw)

THIS PUBLICATION IS FUNDED BY  
THE GOVERNMENT INFORMATION OFFICE AND THE INTELLECTUAL PROPERTY OFFICE, MOEA