

TIPO releases new Examination Guideline to clarify dual filing system

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In Taiwan, the utility model patent system is usually associated with corresponding 'dual filing' measures, which allow an applicant to file an invention application and a utility model application with the Taiwan IP Office (TIPO) based on the same creations on the same day. This dual filing system is a way of obtaining utility model patent protection more quickly as it has an easier formality examination, compared to the substantive examination for the invention application. When an invention application for a dual filing is allowed, the patentee has an option to abandon the previously issued utility model patent to avoid double patenting and to convert it to the later invention patent and enjoy the remaining exclusive term.



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Issues with dual filing system

Before recent amendments to the Patent Act, the major disputed issue regarding the dual filing system in Taiwan was that the original provision precluded continuation between both patent rights when selecting the allowable invention application. The original provision resulted in the utility model patent being deemed non-existent *ab initio*, leading to adverse outcomes for patentees, which lost the earlier protection of the utility model patent if they selected the invention patent. Alternatively, if they selected the utility model, they obtained a shorter 10-year exclusive term.



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In view of this, the Patent Act was partially amended on May 31 2013, with the amendments coming into force on June 13 2013, to provide a new dual filing system that allows the continuous protection of patent rights. According to Articles 32(I) and (II) of the Patent Act, a utility model patent right under the dual filing system ceases only from the issued date of the invention patent, rather than being deemed non-existent *ab initio* when an applicant selects the invention patent application, and thus allows applicants to benefit from using the dual filing system. However, for at least six months the new dual filing system caused confusion as TIPO failed to release the corresponding Examination Guideline immediately, so applicants had no guidance to refer to.



New Examination Guideline

TIPO released the new Examination Guideline (2014 edition) on January 1 2014 to detail the requirements of the new dual filing system. According to Section II, Chapter 3 of the Examination Guideline, the continuous protection of patent rights will be initiated only when both the invention application and the utility model application were filed after June 13 2013 and meet five requirements:

- “the same applicant”;
- “on the same date”;
- “for the same creation”;
- “making respective declarations”; and
- “the utility model patent right has been acquired, but [has not been] extinguished or revoked finally and bindingly”.

These requirements are further elaborated in Section II, Chapter 3 (page 2-3-31) and summarised as follows:

- “[T]he same applicant” means that the applicant for an invention and the applicant for a utility model in a dual filing cases should be the same party, especially at the points of filing, the notice of selection within a specified time limit, the notice of allowance for the invention application and the issue for the invention patent. If an assignment exists between filing and allowal of the invention application, both applications should be assigned together.
- “[O]n the same date” means that both the filing date and the priority date (if claimed) for the invention and the utility model should be identical. Attention should be given to a priority date before June 13 2013. In addition, provided that the invention application and the utility model application are filed on the same date, their division application will maintain the status of “the same date”.
- “[F]or the same creation” means that any claim disclosed in the invention application should be the same as any disclosed in the utility model application.
- “[M]aking respective declarations” means that the fact of filing the same creations on the same date should be declared in both patent application forms when filing. If the divisional application for the invention, which is filed after the original invention application, has ever made respective declarations, it can cite the declaration of the original invention application. However, this citation is limited to one

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divisional application for the invention.

- “[T]he utility model patent right has been acquired, but not been extinguished or revoked finally and bindingly” means that the utility model patent right existed before the invention application and remains valid unless the notice of allowance for the invention application is made in the following circumstances:
 - patent extinguishment, which refers to the utility model patent being terminated without reinstatement due to the annuity fee still being due more than six months (ie, the supplementary payment deadline) after the original due date; or
 - patent revocation, which refers to the utility model patent being non-existent *ab initio* caused by a final and binding patent invalidation decision.

Accordingly, the new Examination Guideline provides more specific instructions for dual filing, so that the potential applicants should have a better idea of how to develop their patent strategies based on this system, which not only awards patent protection quickly through a utility model patent, but also enjoys the long-term and stable protection of an invention patent.

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