

## Patent Act

AMENDED AND PROMULGATED ON 6 FEBRUARY 2003 BY  
PRESIDENTIAL ORDER NO. HUA-TZUNG-1-YI-TZU 0920017760 ENFORCE  
ON 1 JULY 2004 BY THE EXECUTIVE YUAN ORDER NO.  
YUAN-TAI-JING-TZU 0930026128

### Chapter I

#### General Provisions

##### Article 1

This Act is enacted for encouraging, protecting and utilizing inventions and creations so as to promote the development of industries.

##### Article 2

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

The government authority in charge of patent affairs (hereinafter referred to as the "Competent Authority") under this Act shall be the Ministry of Economic Affairs (the "MOEA").

The patent affairs shall be handled by a sole authority (hereinafter referred to as the "Patent Authority") to be appointed by the MOEA..

#### Article 4

A patent application filed by a foreign applicant may be rejected if the home country of such foreign applicant is not a signatory of an international treaty for protection of patent right to which the Republic of China (hereinafter referred to as the "ROC") is also a signatory, or if the home country has not concluded with the ROC a treaty or an agreement for reciprocal protection of patent rights, or if no patent protection agreement has ever been concluded by and between the organizations or institutions of the ROC and said foreign country, as approved by the Competent Authority, or if the acts of said foreign country do not accept patent applications filed by nationals of the ROC.

#### Article 5

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

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

#### Article 6

The right to apply for patent and the patent right are both assignable and inheritable.

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

In the case of taking a patent right as the subject of a pledge, the pledgee shall not be allowed to put the patent under pledge into practice, unless otherwise provided for as a covenant in an agreement.

## Article 7

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 patent and the patent right thereof shall be vested in his/her employer, and the employer shall pay the employee a reasonable remuneration, provided that if there is any covenant otherwise provided for in an agreement, such covenant shall prevail.

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

Where a fun-provider engages another party to conduct research and development, the ownership of the right to apply for patent and the patent right in connection with the outcome of such research and development shall be vested in the party as named by a covenant in the agreement between the two parties concerned, or shall be vested in the inventor or creator in the absence of such a covenant in the agreement provided, however, that the fun-provider shall be entitled to put such invention, utility model or design into practice.

In case the ownership of the right to apply for patent and the patent right is vested in the employer or the fun-provider under Paragraph One or the preceding Paragraph under this Article, the inventor or the creator concerned shall be entitled to the right of having his/her name shown as the inventor or the creator.

## Article 8

Where an invention, a utility model or a design made by an employee is irrelevant to his/her job duties, the right to apply for patent and the patent right concerned shall be vested in the employee provided, however, that if such invention, utility model or design is made through utilization of the employer's resources or experience, the employer may, after having paid the employee a reasonable remuneration, put the same invention or utility model or design into practice in the enterprise concerned.

Upon completion of an invention, a utility model or a design irrelevant to his/her job duties, the employee shall give his/her employer a notice in writing of such event and

shall inform his/her employer of the process of the creation when necessary.

If the employer fails to raise any objection to the employee within six (6) months after his/her receipt of the written notice given by the employee under the preceding Paragraph, he/she shall not claim that such invention, utility model or design is made by the said employee in the performance of his/her job duties.

#### Article 9

An agreement concluded between an employer and an employee, by which the employee is precluded from enjoying his/her legitimate rights and interests in respect of his/her invention, utility model or design, shall be void.

#### Article 10

Where an agreement has been reached by an employer and one of its employees in respect of the dispute concerning the principle for determining the attribution of patent-related rights as set forth in Articles 7 and 8 of the Act, the employer or employee involved shall file an application with the Patent Authority for change on the ownership of the right involved, accompanied by the relevant evidential documents. The Patent Authority may, as it deems necessary, notify the parties involved to submit thereto documents relevant to any mediation, arbitration or court judgment rendered in accordance with other acts and regulations.

#### Article 11

A patent applicant may designate an agent to act on his/her behalf in filing patent applications and handling patent-related matters.

A patent applicant who has no residence or business office in the territory of the ROC shall designate an agent to act on his/her behalf to file patent applications and handle patent-related matters.

An agent shall be limited to a certified patent attorney, unless otherwise provided for in the acts and regulations.

Qualification and administration of certified patent attorneys shall be prescribed in a

separate act. Before enactment of that separate act, the rules for acquisition, canceling and revocation of qualification certificate and the administration of certified patent attorneys should be prescribed by the competent authority.

#### Article 12

Where a patent application right is jointly owned by two or more person, the patent application(s) related thereto shall be filed jointly by all joint-owners.

Where two or more persons proceed to any patent-related procedure(s) other than filing a patent application, each of them may complete such procedure(s) independently, except for filing an application for withdrawing or abandoning a patent application, or for dividing a patent right or converting a patent application, or for filing any application otherwise required in this Act which shall be executed and filed by all joint-owners provided, however, that if a representative is designated by a mutual covenant of all joint-owners, such covenant shall prevail.

In the case of an application requiring execution of all joint-owners as set forth in the preceding two Paragraphs, one of the joint-owners shall be appointed as the recipient of service of the documents. In the absence of such a representative, the patent authority shall name the first applicant indicated in the list of joint-applicants as the recipient of service and shall advise all other joint-owners of such matters of service.

#### Article 13

Where the right to apply for patent is jointly owned by two or more persons, no joint-owner may, without the consent of the other joint-owners, assign his/her share therein to any third party.

#### Article 14

In the case of an inheritance or assignment of the right to apply for patent, the successor or the assignee shall have no locus standi against any third party unless the patent application was filed in the name of the successor or the assignee when filing for patent, or an application was filed thereafter with the Patent Authority for the

change of the applicant's name.

Any such application referred to in the preceding Paragraph, whether filed for an assignment or an inheritance, shall be accompanied by evidential documents.

#### Article 15

No staff and patent examiner, while serving in the Patent Authority, may apply for a patent or receive any rights and interests in connection with a patent directly or indirectly, except in the capacity of a successor thereto.

#### Article 16

Staff and patent examiners of the Patent Authority shall have the obligation to keep the confidentiality of the patent-related matters of any invention, utility model or design, or the trade secret of a patent application which has become known to or been held by them in the course of performing their duties.

#### Article 17

When a person filing a patent application or going through any other procedures in connection with patent matters has delayed beyond any statutory or given time limit, or has defaulted in payment of any fees prior to the deadline fixed therefor, the application filed or the other procedures instituted by him/her shall be dismissed, unless his/her delay to act within the given time limit or his/her failure in payment by the deadline has been corrected before an administrative decision is rendered by the Patent Authority.

If the delay is caused by natural calamities or other causes not attributable to the applicant, the applicant may within thirty (30) days after termination of such cause(s), file a written application with the Patent Authority for reinstating the interrupted case to its original condition by giving the reasons therefor in said application, except in the case where one (1) year has elapsed after expiration of the statutory time limit.

While applying for reinstatement of the interrupted case, the applicant shall

concurrently fulfill his/her obligations that should have been fulfilled by him/her within the statutory time limit.

#### Article 18

Where service of a written examination decision or any other documents can not be made, such written examination decision or document shall be published in the Patent Gazette and shall be deemed duly served after thirty (30) days from the date of publication thereof in the Patent Gazette.

#### Article 19

Procedures for patent application and other relevant operations may be effected by means of electronic operations; the commencement date of and the regulations governing such practices shall be prescribed by the competent authority.

#### Article 20

The duration of any relevant period as specified in this Act shall not include the beginning or the commencement date thereof.

The duration of the patent rights as specified respectively in Paragraph Three, Article 51; Paragraph three, Article 101; and Paragraph Three, Article 113 of this Act shall commence from the date of application of the patent concerned.

### Chapter II

#### Invention Patent

##### Section 1: Patentability of inventions

#### Article 21

The term "invention" as used herein refers to any creation of technical concepts by

utilizing the rules of nature.

## Article 22

An invention which is industrially applicable and is free from any of the following conditions may obtain a patent therefor upon application in accordance with this Act:

1. Which, prior to applying for patent, has been published or put to public use; or
2. Which, prior to applying for patent, has become known to the public.

Where an invention is under either of the circumstances set forth in the preceding Paragraph due to any of the following causes, and a patent application has been filed within six months from the date of occurrence of fact of the foregoing causes, such invention shall be free from the restrictive conditions set forth in the preceding Paragraph:

1. Where the invention is created as a result of research or experiment;
2. Where the invention has been exhibited at an exhibition sponsored or approved by the government; or
3. Where the invention has been disclosed in an occasion not intended by the patent applicant.

An applicant claiming the application of the cause set forth in Item 1 or Item 2 of the preceding Paragraph shall indicate the facts and the relevant dates in his/her application and submit evidential documents within the time limit specified by the Patent Authority.

Notwithstanding the absence of the conditions set forth in Paragraph One of this Article, if the proposed invention can be easily accomplished by a person having ordinarily knowledge in the art based on prior art before the application for patent is filed, no invention patent should be granted for such invention under this act.

## Article 23

Where the contents of an invention claimed in a patent application are identical to the contents described in the specification or drawings submitted along with an application for invention or utility model patent that is filed prior to but laid-open or published after the filing of the present patent application, no invention patent may be granted to the invention, except that the applicant(s) of the present application is (are) the same applicant(s) of such prior invention or utility model patent application.

## Article 24

The following items shall not be granted an invention patent:

1. Animals, plants, and essentially biological processes for production of animals or plants, except the processes for producing microorganisms;
2. Diagnostic, therapeutic or surgical operation methods for the treatment of humans or animals;
3. An invention which is contrary to public order, morality or public health.

## Section 2: Application

### Article 25

The application for an invention patent shall be made by the person entitled to file the patent application by submitting to the Patent Authority a application, a specification, and necessary drawings.

Where the person entitled to file a patent application is an employer, assignee or heir, the name of the inventor shall be indicated in the application, and the document evidencing the employment, assignment or inheritance shall be submitted along with the application.

The filing date of the invention patent application shall be the day which the application, the specification and necessary drawings are fully submitted .

Where the specification and all necessary drawings submitted under the preceding Paragraph are written in a foreign language, and the Chinese translation thereof has been supplemented prior to date specified by the Patent Authority, the date on which the foreign language version of such documents are submitted shall be regarded as the filing date of such patent application. Failure to submit the Chinese translation thereof by or on the specified date shall cause the patent application to be dismissed provided, however, that if the Chinese translation has been supplemented prior to the execution

of the dismissal, the date on which the Chinese translation is submitted shall be regarded as the filing date.

#### Article 26

The specification referred to in the preceding Article shall contain the title of invention, description of invention, abstract of invention, and scope of claims.

The description of invention shall contain a sufficiently clear and complete disclosure of contents of the invention so as to enable person skilled in the art to understand the contents of and to practice said invention.

The scope of claims shall indicate distinctly the invention for which the patent is claimed. Each claim shall be written in a concise manner and must be supported by the descriptions and drawings of the invention.

The manner for disclosing the description, the claims and the drawings of an invention shall be prescribed in the implementing Regulations of the Patent Act.

#### Article 27

A patent applicant, who has filed his/her first patent application legally in respect of an invention in a member of the World Trade Organization (hereinafter referred to as the "WTO") or in a foreign country which allows ROC nationals to claim priority based on reciprocity and has filed his/her patent application for the same invention in the ROC within twelve (12) months from the filing date of his/her first patent application in said foreign country, may claim a priority for his/her ROC application.

Subject to the provisions of the preceding Paragraph, in case an applicant claims for two or more priority rights in a single patent application, the beginning date for calculation the priority period shall be the day following the earliest priority date.

If the foreign applicant is a citizen of a non-member country of the WTO and his/her home country does not maintain a relation for mutual recognition of priority rights with the ROC but the applicant has a residence or business office in a member

country 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 One of this Article.

For a patent application claiming priority, the priority date shall be used as the reference date in the examination of the patent requirements.

#### Article 28

An applicant claiming priority in accordance with the preceding Article shall, when applying for patent, simultaneously file a statement and declare in the written application the filing date and the application number of the corresponding foreign application as well as the foreign country in which the same application was filed.

The applicant shall, within four (4) months from the filing date, submit the documents issued by the government of the foreign country declared in the preceding Paragraph evidencing the acceptance of said foreign application.

Violation of the provisions set forth in the preceding two Paragraphs shall cause the deprivation of the priority right.

#### Article 29

Where an applicant files a further application based on a prior invention application or utility model application filed by himself/herself in the ROC, he/she may claim for the priority right in respect of the invention or creation described in the specification or drawings submitted along with his/her prior patent application, except under the following circumstances:

1. Where a period of twelve (12) months has elapsed from the filing date of the prior patent application;
2. Where a claim for priority right has been made in accordance with the provisions of Article 27 or this Article in respect of the invention or creation described in the prior patent application;
3. Where the prior patent application has been divided into a divisional application in accordance with the provisions of Paragraph One, Article 33, or has been converted in

accordance with the provisions of Article 102;

4. Where the examination decision has been made in respect of the prior patent application.

The prior patent application referred to in the preceding Paragraph shall be deemed having been withdrawn after 15 months from its filing date.

A priority claim in respect of a prior patent application may not be withdrawn after 15 months from the filing date of the prior application.

Where a later application filed with priority claim in accordance with Paragraph One of this Article is withdrawn within fifteen (15) months from the filing date of the prior application, the priority claim shall be deemed withdrawn at the same time.

Where an applicant claims two or more priority rights in a single application, the beginning date for calculation of the priority period shall be the day following the first priority date.

For a patent application claiming priority, the priority date shall be used as the reference date during the patentability examination .

A statement for claiming priority in accordance with Paragraph One under this Article shall be filed concurrently while filing a patent application, and the filing date and the application number of such prior patent application shall be indicated in the application. Failure of the applicant to file the statement or to indicate the filing date and the application number of the prior patent application shall cause the deprivation of priority .

The claimed priority date under this Article shall not be earlier than October 26, 2001.

## Article 30

In applying for an invention patent involving any biological material or the utilization of any biological material, the applicant shall, no later than the filing date, deposit the biological material at a local deposit institute designated by the Patent Authority and shall indicate in the application the name of the deposit institute, and the date and the

serial number of such deposit provided, however, that the deposit is not required if the biological material involved can be easily obtained by ordinarily skilled person in the relevant art to the biological material.

The applicant shall, within three (3) months from the filing date of the application, submit to the Patent Authority the document(s) evidencing the deposit. If such evidentiary documents are not submitted before the foregoing period, the deposit shall be deemed not having been effected.

In the event the biological material involved has been deposited, before filing the patent application, at a foreign deposit institution which is recognized by the Patent Authority and the fact of such deposit has been stated in the application, and the deposit certificates issued by both a designated local deposit institution and the foreign deposit institution have been submitted within the time limit specified in the preceding Paragraph, the requirement for deposit before filing the application as set forth in Paragraph One of this Article may be exempted.

Regulations governing the accepting conditions, the categories, the types, and the quantity of such biological materials to be deposited, the rates of the deposit fees, and other matters in connection with the depositing operation shall be prescribed by the Competent Authority.

### Article 31

When two or more applications are filed for the same invention, only the application filed first may be granted an invention patent, except in the case where the priority date claimed by the later 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 date, the applicants shall be requested to reach a compromise between themselves. If such compromise cannot be reached, none of the applicants shall be granted an invention patent. In case the applications are filed by the same applicant, the applicant shall be requested, by a notice, to select one of such applications for filing within a given time limit; and failure of the applicant to select within the time limit shall cause the dismissal of all such applications.

While the applicants involved are in the process of negotiating for a compromise, the Patent Authority may notify such applicants to submit the results of the negotiation within an appropriate period of time to be set by the Patent Authority. Failure to submit the negotiation results within the time limit shall be deemed a failure of negotiation.

Where an invention patent application and a utility model patent application are filed separately in respect of the same invention or creation, the provisions set forth in the preceding three (3) Paragraphs shall apply *mutatis mutandis*.

#### Article 32

An application for a patent for invention shall be limited to one invention.

Two or more inventions belonging to a single general inventive concept may be filed as one application.

#### Article 33

In the case of a patent application which substantially involves two or more inventions, the application may, upon notice given by the Patent Authority or the request by the applicant, be divided into two or more separate divisional applications.

The divisional applications set forth in the preceding Paragraph shall be filed before the re-examination decision on the original application is rendered. If divisional applications are accepted, the filing date of the original application shall still be taken as the filing date of the divisional applications, and the applicant shall remain entitled to claim priority, if any, and the Patent Authority shall proceed with the examination procedures left unfinished in the examination of the original application.

#### Article 34

When an invention patent is granted upon application filed by a person other than the person entitled to file such application, the filing date of the application filed by the person not entitled to file the application shall be taken as the filing date of the application filed by the person entitled to file the application, if the person entitled to file the patent application files an invalidation action against the patent application

filed by the person not entitled to file the application within two (2) years from the publication date of the patent application in question, and files his/her own patent application within sixty (60) days from the day the invalidation decision becomes irrevocable.

No publication will be given in respect of the application filed in accordance with the provisions set forth in the preceding Paragraph by the person entitled to file the invention patent application.

### Section 3: Examination and Re-examination

#### Article 35

The Patent Authority shall designate patent examiner(s) to conduct substantive examination on an invention patent application.

The qualification of patent examiners shall be prescribed by a separate act.

#### Article 36

After receipt of the documents of an invention patent application, if the Patent Authority considers, through examination, that nothing is contrary to the formality requirements and should not be laid-open, the Patent Authority shall have such application laid-open after a period of eighteen (18) months from the filing date of such patent application.

The Patent Authority may advance the laying-open of a patent application at the request of the applicant.

Under any of the following circumstances, an invention patent application shall not be laid-open:

1. Where the patent application has been withdrawn within fifteen (15) months from the filing date of said application;

2. Where the contents of the invention involve the national defense secret or any other secret pertaining to national security; or

3. Where the contents of the invention are detrimental to morality or public health.

The period set forth in Paragraph One and the preceding Paragraph of this Article, if any priority is claimed, is calculated from the day following the priority date, or following the earliest priority date if two or more priority are claimed.

#### Article 37

Any person may, within three (3) years from the filing date of an invention patent application, apply to the Patent Authority for a substantive examination.

If the divisional application under Paragraph One, Article 33 is filed, or an invention patent application is converted under Article 102, after the time frame set forth in the preceding Paragraph, the application for substantive examination may be filed within thirty (30) days from the filing date of the divisional applications or the filing date of the conversion application.

No substantive examination application filed under the preceding two Paragraphs may be withdrawn.

If substantive examination is not applied within the period specified in Paragraph One or Paragraph Two of this Article, the invention patent application shall be deemed withdrawn.

#### Article 38

When applying for substantive examination under the preceding Article, a application shall be submitted.

The Patent Authority shall post the fact of an application for substantive examination in the Patent Gazette.

Where the substantive examination application is filed by a person other than the

applicant of the invention patent application concerned, the Patent Authority shall inform the applicant of said invention patent application of such fact.

Where a substantive examination application is filed by the applicant of an invention patent application pertaining to a biological material or a method for utilizing any biological material, a certificate of viability issued by the deposit institution concerned shall be submitted along with the application; whereas, if such substantive examination application is filed by a person other than the applicant of the invention patent application, the Patent Authority shall notify the applicant of the invention patent application to submit such a certificate of viability within three (3) months.

#### Article 39

After an invention patent application is laid-open, if any person other than the applicant of the invention patent application puts such invention to practice for commercial purposes, the Patent Authority may effect the examination on a priority basis upon application.

For filing the application under the preceding Paragraph, relevant evidential documents shall be submitted along with the application.

#### Article 40

Where a person has received a written notification of the contents of an invention patent application from the applicant thereof after laying-open of such patent application and continues to put the invention to practice for commercial purpose in the interim after such notification and prior to the publication, the applicant of the invention patent application may, after the publication of his/her invention patent application, make a claim against said person for an appropriate pecuniary compensation.

The claim referred to in the preceding Paragraph may also be made against a person who knows that an invention patent application has been laid-open but still continues to put the invention to practice for commercial purpose prior to the publication of the application.

The right to claim provided for in the preceding two Paragraphs shall have no prejudice to the exercise of any other rights.

The right to claim for pecuniary compensation set forth in Paragraph One and Paragraph Two of this Article shall become extinguished if not exercised within two years from the date of publication of said invention patent application.

#### Article 41

The provisions of the preceding five Articles shall be applicable only to the invention patent applications filed on or after October 26, 2002.

#### Article 42

Under any of the following circumstances, a patent examiner shall exclude from exercising his/her own initiative:

1. Where the patent examiner or his/her spouse is the patent applicant, or the patent attorney, or a partner of the patent attorney or a person having an employment relation with the patent attorney of the applicant of the patent to be examined;
2. Where the patent examiner is presently related to the patent applicant or the patent attorney of the patent application to be examined by consanguinity within the fourth degree or by affinity within the third degree;
3. Where the patent examiner or his/her spouse has the relation with the patent applicant as a joint obligee, joint obligor or debt-paying obligor in respect of the patent application to be examined;
4. Where the examiner is or was the statutory representative, the head or a member of the family of the applicant of the patent application to be examined;
5. Where the examiner is or was an attorney ad litem or assistant in litigation of the applicant of the patent application to be examined; or
6. Where the examiner is or was a witness, or an expert witness, or an opposition petitioner, or an invalidation petitioner of the present patent application.

Where an examiner should but did not withdraw from exercising his/her function, the Patent Authority may, ex officio or at request, revoke the measure he/she took and take another appropriate measure instead.

#### Article 43

Upon completion of examination of a patent application, a written decision shall be rendered and issued to the applicant or his/her patent attorney.

When a patent application is found not patentable, the reasons therefor shall be given in the written decision of examination.

A written decision of examination shall bear the name of the patent examiner(s). This requirement shall also apply to any written decision of re-examination, opposition action, invalidation action and patent-term extension.

#### Article 44

Any invention patent application which is found to be contrary to the provisions set out in Articles 21 through 24; Article 26; Paragraph One, or Paragraph Two, Article 30; Article 31; Article 32; or Paragraph Four, Article 49 of this Act shall not be patented.

#### Article 45

Where the examination result reveals no reason to deny the patentability of an invention, such invention shall be patented, and the claims and the drawings disclosed in that patent application shall be published.

Any person may apply for access to the written decision of examination, specification, drawings, and the entire file and information in connection with a specific patent application which has been allowed and published so as to read or to make hand, photographic or reproduced copy of the relevant information thereof, except for the information which should be kept confidential by the Patent Authority in accordance with the act.

#### Article 46

In case of dissatisfaction with a rejection decision rendered for an invention patent application, the applicant may, within sixty (60) days from the date the rejection decision is served, apply for re-examination by submitting a statement of reasons. If the application is rejected on procedural grounds or on the ground of the ineligibility of the applicant, the applicant may directly appeal for an administrative remedy in accordance with the act.

If there is any reason to deny the patentability of an invention patent through the re-examination procedure, the Patent Authority shall, before rendering a re-examination decision, send to the applicant a notice requesting that a response be made within a specified time limit.

#### Article 47

For re-examination, the Patent Authority shall designate an examiner who has not participated in the examination of the original patent application to conduct the re-examination and render a written decision.

The written re-examination decision shall be served to the applicant.

#### Article 48

When examining an invention patent application, the Patent Authority may, ex officio or at a request, notify the patent applicant to do any of the following acts within a specified time limit:

1. To appear before the Patent Authority for an interview; or
2. To perform necessary experiment(s) or to supplement model(s) or sample(s).

The Patent Authority may, when necessary, visit the site or a designated place for inspection and observation of the experiments or models or samples as required under Item 2 of the preceding Paragraph.

## Article 49

In the course of examining an invention patent application, the Patent Authority may, ex officio, notify a patent applicant to make a supplement or amendment to the specifications and/or drawings within a specified time limit.

A patent applicant may, within fifteen (15) months from the filing date of such patent application, make a supplement or amendment to the specifications and/or drawings. If the supplement or amendment to the specifications and/or drawings is filed after elapse of the fifteen (15) months, the application shall be laid-open as it was originally filed.

After fifteen (15) months from the filing date of the invention patent application, a patent applicant may make a supplement or amendment to the specification and/or drawings only on the dates or during the periods as specified below:

1. At the same time of filing an application for substantive examination;
2. Within three (3) months from the service date of a notice of substantive examination issued in respect of the patent application concerned, if the substantive examination application is filed by a person other than the patent applicant;
3. During the time limit for response as specified in a notice given by the Patent Authority prior to its written reasons for rejection of the patent application concerned;  
or
4. At the time of filing an application for re-examination, or during the period fixed for filing a supplemental statement of reasons for re-examination.

The contents of the supplement or amendment made under the preceding three Paragraphs shall not exceed the scope of the specification or drawing disclosed in the original patent application.

Where a claiming priority is made, the periods specified in Paragraph Two and Paragraph Three under this Article shall be calculated from the day following the priority date.

## Article 50

Where an invention is considered, in the process of examination, to be likely to affect the national security, the specification of such invention shall be referred to the Ministry of National Defense or the relevant national security authorities for their opinions. If it is deemed necessary to keep such invention confidential, the invention shall not be published, and the documents included in the patent application package shall be sealed and kept in a secret file not accessible to the public. In addition, a written decision to such effect shall be made and served to the patent applicant, his/her patent attorney and the inventor accordingly.

The patent applicant, his/her patent attorney and the inventor shall keep the confidentiality of the invention of the nature as described in the preceding Paragraph. Upon violation of this confidential clause by any of the aforesaid parties, the right to apply for patent for such invention shall be deemed to have been waived.

The confidential period shall last for one year from the date the written decision is served on the patent applicant and may be extended on a year-by-year basis. The Patent Authority shall, within one month prior to the expiry of the confidential period, consult with the Ministry of National Defense or the relevant national security authorities about the continuation of the confidential period. If the confidential requirement of a patent case is no longer necessary, such patent shall be published.

The Government shall make appropriate compensation for any damages to be sustained by the patent applicant during the confidential period.

## Section 4: Patent Rights

### Article 51

A patent application filed in respect of an invention is approved by a written decision shall be published only after the issue fee and the first year annuity have been paid by the applicant within three (3) months after the service of the aforesaid written decision; if the foregoing fees have not been paid upon expiry of the above-given deadline, no publication shall be made, and the patent right for said invention shall not exist ab

initio,.

The granted patent rights shall be on the date of publication, and a patent certificate shall be issued thereto.

The term of an invention patent right shall end with twenty (20) years from the filing date of the patent application.

#### Article 52

In the case of invention patents covering pharmaceuticals, agrichemicals, or processes for preparing the same, a patentee may apply for an extension of his/her patent term for two (2) to five (5) years, if, pursuant to other acts or regulations, a prior government approval must be secured to practice such patents, for which the processing exceeds two (2) years after the publication of the patents. Only one such extension shall be permitted provided, however, that the patent term extended shall not exceed the length of time required for obtaining an approval from the central government authority in charge of end enterprises. In case the length of time required for obtaining an approval exceeds five (5) years, the term of extension shall still be limited to five (5) years.

Any application for an extension of the term of a patent right must be filed with the Patent Authority by submitting a written application together with supporting evidence within three (3) months from the date of the first government approval involved provided, however, that no extension application shall be filed within six (6) months prior to the expiration of the original patent term.

To determine the term of extension of a patent under the preceding Paragraph, the Competent Authority shall take into consideration the impact of the extension on the health of nationals in general and shall prescribe the approving rules in conjunction with the central government authority in charge of the end enterprises concerned.

#### Article 53

The Patent Authority shall designate examiner(s) to examine an invention patent extension application and shall make written decision which shall be served on the

patentee or his/her patent attorney.

#### Article 54

Under any of the following circumstances, any person may file an invalidation action together with relevant evidence with the Patent Authority against the term extension of an invention patent granted by the Patent Authority:

1. If it is not necessary to obtain a government approval for practicing the patented invention at issue;
2. If the patentee or his/her licensee has not obtained a government approval as required;
3. If the approved term of extension exceeds the length of time in which the patented invention can not be practiced;
4. If the patent extension application is filed by a person other than the patentee;
5. If the patent right is jointly owned by two or more persons, and the extension application is not filed in the name of all co-owners;
6. In case the application for extension was based on the time spent in conducting experiments or testing in a foreign country, the extended term allowed by the Patent Authority exceeds the duration recognized by the patent authority of such foreign country; or
7. The time required for obtaining an approval is less than two years.

If an invalidation action against the grant of a patent term extension has become irrevocably sustained, the extended patent term originally granted shall become non-existing ab initio. However, if such invalidation action is irrevocably sustained on the grounds listed in Item (3) or Item (6) of the preceding Paragraph, only the exceeding term shall be deemed non-existing.

#### Article 55

When the Patent Authority acknowledges the existence of any of the events set forth in Paragraph One of the preceding Article, it may, ex officio, revoke the extended term of the invention patent right at issue.

When the revocation of the approved extension of the term of a patent right becomes irrevocable, the originally approved extension shall be deemed not in existence ab initio; however, if the irrevocable revocation is rendered as a result of violation of the provisions of Item 3 or Item 6 of Paragraph One of the preceding Article, the exceeding duration shall be deemed non-existing.

#### Article 56

Unless otherwise provided for in this Act, the patentee of a patented article shall have the exclusive right to preclude other persons from manufacturing, making an offer for sale, selling, using, or importing for above purposes the patented article without his/her prior consent.

Unless otherwise provided for in this Act, the patentee of a patented process shall have the exclusive right to preclude others from using such process and using, selling or importing for above purposes the articles made through direct use of the said process without his/her prior consent.

The scope of an invention patent right shall be determined based on the claim(s) set forth in the specification of the invention. The descriptions and drawings of the invention may be used as reference when interpreting the scope of the claims in the patent application.

#### Article 57

The effect of an invention patent right shall not extend to any of the following matters:

1. Where the invention is put into practice for research, educational or experimental purposes only, with no profit-seeking acts involved therein;

2. Where, prior to filing for patent, the invention has been used in this country, or where all necessary preparations have been completed for such purpose provided, however, that this provision shall not apply where knowledge of the manufacturing process was obtained from the patent applicant within six (6) months prior to applying for patent and the patent applicant has made a statement concerning the reservation of his/her patent right therein;
3. Where the article has already been in existence in this country prior to the filing of the patent application;
4. Where the article is simply a vehicle or a device thereof that passes the territory of this country;
5. Where, in the case of revocation of the patent right acquired by a person other than the one entitled thereto as a result of an invalidation action filed by the patentee, the licensee has, prior to the revocation of the patent involved, used the patent in good faith or completed all necessary preparations therefor in this country; and
6. Where the patented articles manufactured by the patentee or under the consent of the patentee are put to use or resold after the sale thereof. The aforesaid manufacture and sale are not limited to those committed in this country.

The user referred to in Items 2 and 5 of the preceding Paragraph shall confine his/her continued use of the invention to his/her original enterprise exclusively. The geographic areas in which sale can be made under Item 6 of the preceding Paragraph shall be determined based on the facts by the court.

The licensee of the patent right which has been revoked as a result of an invalidation action as referred to in Item 5 of the first Paragraph under this Article shall pay the patentee a reasonable amount of royalty from the date of receiving a written notification from the patentee, provided that the licensee continues to practice the patent after the revocation of the patent.

## Article 58

For medicines manufactured by concocting two or more medicines or the concocting process itself, the patent right shall not cover prescriptions made by physicians or the

medicines prepared in accordance with such prescriptions.

#### Article 59

The assignment, trust or licensing made by the patentee of the patent right of an invention to another person to practice the invention, or the pledge created on the patent by the patentee shall not be asserted against any third party, unless it has been registered with the Patent Authority.

#### Article 60

An assignment or a licensing of an invention patent shall not take effect if the contract signed therefor contains any of the following circumstances that will give rise to unfair competition:

1. To prohibit or restrict the assignee from using any specific article or process not furnished by the assignor or licensor; or
2. To require that the assignee purchase products or raw materials of the assignor which is not under patent protection.

#### Article 61

In the case of the joint-ownership of an invention patent, other than the practice of the patent by the joint-owners themselves, the patent shall not be assigned or licensed to others for practice without the consent of all joint-owners. If, however, there is an agreement providing otherwise, such agreement shall govern.

#### Article 62

A joint-owner of an invention patent shall not assign or entrust his/her share thereof to another person or create a pledge on the same patent, without the consent of all the other joint-owners.

#### Article 63

An invention patentee who has suffered damages as a result of war between the ROC and a foreign country may apply for a prolongation of the term of his/her patent for five (5) to ten (10) years, and only one such prolongation shall be permitted; provided, however, that this provision shall not apply if the patentee is a national of the belligerent country.

#### Article 64

An invention patentee may file an application for making amendment(s) to the contents of the specification and drawings only in respect of the following matters:

1. Narrowing the scope of the claims:
2. Correction of the error(s) made in the specification; or
4. Explanation of obscure description(s).

Any amendment to be made under the preceding Paragraph shall not exceed the scope of contents which were disclosed in the original specification or drawings while filing the patent application, and shall not substantially expand or alter the scope of the patent claims.

Upon the approval of the amendment(s), the Patent Authority shall publish the cause of such amendment(s) in the Patent Gazette.

The effect of the amendment(s) to the the specification and/or drawings shall, upon publication, be retroactive to the filing date of the patent application concerned.

#### Article 65

An invention patentee shall not abandon his/her patent right or file any application as provided in the preceding Article without the consent of the licensee or the pledgee.

## Article 66

An invention patent right shall extinguish ipso facto under any of the following circumstances:

1. In the case of expiry on the duration of a patent right, from the day following the expiration;
2. In the case of death of the patentee without an heir, from the date the patent right accrues to the Treasury as provided for in Article 1,185 of the Civil Code;
3. In the case of the patentee's failure of effecting the payment of a patent annuity for the second year or any year thereafter within the grace period, from the day following the expiration of the original statutory period for such payment; except for the patent right to be reinstated under Paragraph Two, Article 17 of this Act; or
4. In the case of voluntary abandonment of a patent right, from the date of the patentee's written declaration to such effect.

## Article 67

Under any of the following circumstances, an invention patent right shall be revoked and the patent certificate issued thereto shall be recalled within a given time limit by the Patent Authority either by an invalidation action or ex officio, and if recalling fails, a public notice for revocation of said patent certificate shall be published:

1. If the invention is found in violation of the provisions of Paragraph One, Article 12, Articles 21 through 24, Article 26, Article 31 or Paragraph Four, Article 49 of this Act;
2. If the home country of the patentee does not accept the patent applications to be filed by nationals of the ROC; or
3. If the invention patentee is found being a person other than the person entitled to file the invention patent application.

Where an invalidation action is filed on the ground that the patent right in question is in violation of the provisions set out in Paragraph One, Article 12 of this Act or under the circumstance set forth in Item 3 of the preceding Paragraph, the petitioner shall be limited to an interested party; whereas, in any other cases, any person shall be entitled to file to the Patent Authority an invalidation action with evidences.

Any supplemental reason and evidence from the petitioner shall be filed within one month from the date the invalidation action is initiated provided, however, that any supplemental reason and/or evidence that is submitted prior to the conclusion rendered on examination of an invalidation action shall still be examined.

Once an invalidation action is dismissed after the examination, no person may file another invalidation action based on the same fact or the same evidence.

#### Article 68

An interested party may institute an invalidation action after the patent has expired or extinguished ipso facto if he/she has reinstatable legitimate interests as a result of the revocation of the patent.

#### Article 69

Upon receipt of a written petition for patent invalidation, the Patent Authority shall serve a duplicate of such written petition to the patentee of the patent challenged.

The patentee of the patent challenged shall, within one month after the service of the written petition, file a statement of defense, and the examination of the invalidation action shall proceed without further notice, if the patentee fails to file the statement of defense upon expiry of the said one-month deadline, except an extension application with good cause shown therein has been filed and approved prior to the deadline.

#### Article 70

For the examination of an invalidation action, the Patent Authority shall designate a patent examiner who did not participate in the examination of the original patent

application and shall require that the designated examiner make a written examination decision which shall be serviced on both of the patentee and the petitioner concerned.

#### Article 71

In the process of examining a patent invalidation action, the Patent Authority shall, upon a request or ex officio, notify the patentee involved to take any of the following actions:

1. to appear before the Patent Authority for an interview;
2. to conduct necessary experiment, or to submit supplemental model(s) or sample(s);  
and
3. to make amendment(s) in accordance with the provisions set out in Paragraph One and Paragraph Two, Article 64 of this Act.

The Patent Authority may, when necessary, visit the site or a designated place for inspection and observation of the experiment, or the model(s) or sample(s) as required in Item 2 of the preceding Paragraph.

Where amendment(s) to the specification or drawings of a patented invention is (are) required under Item 3, Paragraph One of this Article, the Patent Authority shall give the petitioner a notice of such request.

#### Article 72

For filing an invalidation action against the invention patent term extension under Article 54 of this Act, the provisions set out in Paragraph Three and Paragraph Four of Article 67, and the preceding four Articles herein shall apply mutatis mutandis.

For revocation of a patent right ex officio under Article 67 of this Act, the provisions set out in the preceding three Articles shall apply mutatis mutandis.

#### Article 73

Under any of the following circumstances, the revocation of an invention patent right shall become irrevocable:

1. No administrative remedy has been sought in accordance with the act; and
2. Where an irrevocable decision on dismissal of the action instituted for administrative remedy is rendered.

The effect of an irrevocably-revoked invention patent right shall be deemed non-existent ab initio.

#### Article 74

The grant, alteration, extension, prolongation, assignment, trust, licensing, compulsory licensing, revocation, extinguishments or pledging of an invention patent right as well as other matters which should be published, the Patent Authority shall effect such publication in the Patent Gazette.

#### Article 75

The Patent Authority shall establish and maintain a register of patent rights, in which the title of the patent rights granted, the term of each patent right, the changes in patent rights, and all other matters required by the act shall be registered.

The register of patent rights set forth in the preceding Paragraph may be made and maintained by electronic means and shall be made available to the public for reading and making handwritten, photographic or reproduced copies therefrom.

#### Section 5: Practicing

#### Article 76

In order to cope with the national emergencies, or to make non-profit-seeking use of a

patent for enhancement of public welfare, or in the case of an applicant's failure to reach a licensing agreement with the patentee concerned under reasonable commercial terms and conditions within a considerable period of time, the Patent Authority may, upon an application, grant a right of compulsory licensing to the applicant to put the patented invention into practice; provided that such practicing shall be restricted mainly to the purpose of satisfying the requirements of the domestic market. However, if the application for compulsory licensing of a patent right covers semiconductor technology, such application may be allowed only if the proposed practicing is purposed for a non-profit-seeking use contemplated to enhance the public welfare.

In the absence of the conditions set forth in the preceding Paragraph, the Patent Authority still may, upon an application, grant to the applicant a compulsory license to practice the patented invention in the event that the patentee has imposed restrictions on competition or has committed unfair competition, as confirmed by a judgment given by a court or a disposition made by the Fair Trade Commission of the Executive Yuan.

Upon receipt of a written application for such compulsory licensing, the Patent Authority shall send a duplicate copy thereof to the patentee, requesting that a response be filed within three (3) months. If no response is filed within the specified time limit, the Patent Authority may decide the matter at its own discretion.

The right of compulsory licensing shall not preclude other persons from obtaining the right to practice the same patented invention.

The grantee of the compulsory license shall pay to the patentee an appropriate compensation. In the case of dispute over the amount of such compensation, the amount shall be decided by the Patent Authority.

The compulsory license shall be transacted together with the business pertaining to the compulsorily licensing for assignment, trust, inheritance, licensing or pledge creation.

Upon extinguishment of the cause of compulsory licensing, the Patent Authority may terminate the compulsory license upon an application.

If the person who has been granted a right of compulsory licensing under the provisions of the preceding Article has acted contrary to the purposes of the compulsory licensing, the Patent Authority may, upon an application filed by the patentee or ex officio, annul the compulsory license.

#### Article 78

The term "reinvention" as used herein shall mean an invention which is accomplished through use of the principal technical contents of an invention or a utility model created by another person.

The patentee of a reinvention shall not practice his/her patented invention without obtaining a prior consent from the patentee of the original invention.

Where a product manufactured in accordance with a patented manufacturing process is covered by a product patent granted to another person, the patentee of such manufacturing process patent shall not put his/her invention into practice without obtaining a prior consent of the patentee of the product patent.

The patentee of the reinvention patent and the patentee of the original invention patent, or the patentee of the manufacturing process patent and the patentee of the product patent, as referred to in the preceding two Paragraphs, may reach an agreement on cross licensing arrangement for practicing the inventions.

If the agreement on cross licensing arrangement set forth in the preceding Paragraph cannot be reached, the patentee of the reinvention patent and the patentee of the original invention patent, or the patentee of the manufacturing process patent and the patentee of the product patent may apply for compulsory licensing in accordance with Article 76 of this Act. However, such compulsory licensing application may not be filed by the patentee of the reinvention or the patentee of the manufacturing process patent unless the technology expressed by the reinvention or by the manufacturing process invention has important technical improvement(s) with considerable economic significance over the original invention or the product invention.

The compulsory license obtained by the patentee of a reinvention patent or the patentee of a manufacturing process patent shall be transacted together with the patent

right of said patentee for assignment, trust, inheritance, licensing or pledge creation.

#### Article 79

An invention patentee shall mark the serial number of patent certificate on his/her patented article or the packaging thereof, and may require that his/her licensee or the grantee of compulsory license do the same. In case of failure to affix such marking, no claim for damages shall be allowed, except in the case that the infringer has known, or should have known as proved by facts, the existence of the patent.

#### Section 6: Government Fees

#### Article 80

In respect of each application concerning invention patents, the applicant shall pay a fee at the time of filing the application.

For an allowed patent, the invention patentee shall pay an issue fee and annuities. In the case of an approval for an extension or prolongation of patent term, annuities shall still be paid during the extended or prolonged patent term.

The amount of the application fee, issue fee and annuities shall be prescribed by the Competent Authority.

#### Article 81

The annuity for an invention patent shall be payable commencing from the publication date. Payment of the first year annuity shall be made in accordance with the provision set out in Paragraph One, Article 51 hereof, while the payment of the second year annuity and the annuities thereafter shall be made prior to the expiration of each of the current patent years.

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 82

In case the annuity payable for the second year or each year thereafter due is not paid within the regulatory period for the annuity payment, it may be paid later within six (6) months after expiry of the said regulatory period provided, however, that the amount of late payment shall be twice as much as the regular amount of the annuity.

#### Article 83

Where a patentee is a natural person, school or a small and medium enterprise, he/it may file an application with the Patent Authority for a reduction or exemption of the patent annuity. Regulations governing the conditions, number of years, amount, and other matters of such reduction and exemption shall be prescribed by the Competent Authority.

### Section 7: Indemnity for Damages and Litigation

#### Article 84

In the event of infringement on an invention patent, the patentee may claim for damages and demand the removal of the infringement and the prevention of any threat of infringement.

An exclusive licensee may also make the claim or demand set forth in the preceding Paragraph, unless otherwise provided for in an agreement, and in such case, the provisions set out in the agreement shall prevail.

When an invention patentee or an exclusive licensee claims for damages pursuant to the preceding two Paragraphs, he/she may request for destruction of the infringing products or the raw materials or implements used in infringing the patent, or request for other necessary disposals.

When the inventor's right to indicate his/her name is infringed, he/she may request a ruling to indicate the inventor's name or otherwise to recover his/her reputation.

The right to claim provided in this Article shall become extinguished if not exercised within two (2) years from the time the patentee is aware of the infringement act and the obligator for the damages, or within ten (10) years from the time of the infringement act.

#### Article 85

To claim damages in accordance with the preceding Article, any of the following options may be adopted for calculating of the amount of damages:

1. To claim in accordance with Article 216 of the Civil Code. A patentee may, however, take the balance derived by subtracting the profit earned through the practice of his/her patent after the existence of infringement from the profit normally expected through the practice of the same patent as the amount of the damages, provided that no proving method can be presented to justify the damages;
2. To claim based on the profit earned by the infringer as a result of his/her infringement act. The entire income derived from the sale of the infringing articles shall be deemed the infringer's profit, provided that the infringer is unable to produce proof to justify his/her costs or necessary expenses.

In addition to the provisions set forth in the preceding Paragraph, the patentee may claim separately for damages at a reasonable amount in case the business reputation of the patentee has been downgraded or injured as a result of the infringement.

Subject to the provisions of the preceding two Paragraphs, if the infringement is found to be an intentional act, the court may, after considering the details of the infringement, decide the compensation in an amount higher than the amount of damages estimated, but not more than triple damages.

#### Article 86

Any article used in an act of patent infringement or produced by such an act may,

upon the application of the injured party to the court, be provisionally seized to serve as the whole or a part of compensation for the damages as may be awarded by judgment.

When the injured party instituted an action claiming for damages under the preceding Article and applying for provisional seizure, the court shall allow procedural relief in accordance with the Code of Civil Procedure.

#### Article 87

Where an article which is made by using a patented manufacturing process has never been seen in this country or outside of the country before the filing of a patent application for the manufacturing process, an article identical thereto made by another person shall be inferred as having been manufactured by using said manufacturing process.

The inference made under the preceding Paragraph may be overturned by presentation of counter-evidence. 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 presentation of counter-evidence. The legal rights and interests in the manufacture and trade secret, as disclosed by the defendant in producing such counter-evidence, shall be fully protected.

#### Article 88

With regard to a litigation involving an invention patent, the court shall send to the Patent Authority one original copy of the judgment rendered by it.

#### Article 89

The injured party may, after an irrevocable favorable judgment is rendered, request the court issue a ruling for publishing in a newspaper the judgment in full or in part, at the expenses of the losing party.

## Article 90

For any civil proceedings pending in a court in connection with an invention patent, the court may suspend the trial process until a decision on the patent application, invalidation, or revocation action related thereto has become irrevocable.

When rendering a ruling for suspending the trial proceedings in accordance with the provisions set out in the preceding Paragraph, the court shall look into the legitimacy of the cause of the invalidation action.

Where an invalidation action instituted involves the trial proceedings of the patent infringement actsuit, the Patent Authority shall give the priority to the examination of the invalidation action.

## Article 91

A non-recognized foreign juristic person or entity may institute a civil action in respect of the matters governed by this Act, provided, however, that the nationals or entities of the ROC are entitled to such rights in said foreign country under a treaty, or the national acts, ordinances or customary practices of said foreign country. A patent protection agreement between a ROC entity or organization and a foreign entity or organization and duly approved by the Competent Authority shall have the same effect.

## Article 92

The court may set up a professional tribunal or designate specific persons to handle invention patent litigation cases.

The Judicial Yuan may appoint specific professional institution(s) to perform the expert verification work as required in patent infringement case(s).

A court which accepts and handles a actsuit pertaining to an invention patent may engage the professional institution(s) appointed under the preceding Paragraph to perform the expert verification work as required.

## Chapter III

### Utility Model Patents

#### Article 93

The term " utility model" shall refer to any creation of technical concepts by utilizing the acts of nature, in respect of the form, construction or installation of an article.

#### Article 94

Any utility model that is industrially applicable and is free from any of the following conditions may obtain a utility model patent upon an application in accordance with this Act:

1. Which, prior to filing such a patent application, has been disclosed in any publication or put into public use; or
2. Which, prior to filing such a patent application, has become known to the public.

In case either of the conditions set forth in the preceding Paragraph does exist as a result of any of the following causes, and a utility model application is filed within six (6) months from the date any of the foregoing causes occurs, said utility model shall be free from any of the restrictive conditions set out in the preceding Paragraph:

1. due to a research, or an experiment;
2. due to a display in an exhibition sponsored or approved by the government; or
3. due to a disclosure not agreed by the applicant.

An applicant claiming the application of the cause set forth in Item 1 or Item 2 of the preceding Paragraph shall indicate the facts and the relevant date(s) in his/her application, and shall submit evidential documents within the time limit specified by the Patent Authority.

Notwithstanding the absence of the conditions set forth in Paragraph One of this Article, no utility model patent may be applied for or granted under this Act, if the utility model can easily be accomplished by any ordinary skilled person in the relevant art based on existing prior art before the application for patent is filed.

#### Article 95

Where the contents of a utility model claimed in a patent application are identical to the contents described in the specification and drawings submitted along with an application for invention or utility model patent that is filed prior to but laid-open or patented after the filing of the present application, no utility model patent may be granted, except that the applicant(s) of the present application is (are) the same applicant(s) of such prior invention or utility model patent application.

#### Article 96

No utility model patent shall be granted to a utility model application which is detrimental to public order, good custom or public health.

#### Article 97

Where a utility model claimed in a patent application is considered, after the formality examination, to be under any of the following circumstances, a disapproval decision shall be made:

1. Where the utility model is not related to the form, construction or installation;
2. Where the new utility is contrary to the provision set out in the preceding Article;
3. Where the manner of disclosing the utility model is contrary to the requirements in Paragraphs One and/or Four of Article 26 which are applicable *mutatis mutandis* under Article 108 of this Act;
4. Where the utility model is in violation of the provisions set out in Article 32 which are applicable *mutatis mutandis* under Article 108 of this Act; or

5. Where certain essential matters have not been disclosed in the specification or drawings, or the essential matters disclosed therein are obviously unclear.

Prior to making the decision in accordance with the provisions set out in the preceding Paragraph, the applicant shall be required, by an advance notice, to make necessary statement, supplement or amendment to the specification or drawings previously filed.

#### Article 98

In the event a utility model claimed in a patent application is considered, after the formality examination, to be under any of the circumstances set out in the preceding Article, a written decision with the reasons shall be made and served to the applicant or his/her attorney.

#### Article 99

Where the utility model claimed in a patent application is considered, after formality examination, not under any of the conditions of non-patentability set out in Article 97 hereof, said utility model shall be granted a patent, and the claims and the drawings of the application therewith shall be published.

#### Article 100

Where a patent applicant applies for making supplement or amendment to the specification or drawings enclosed in the original application, an application for such shall be filed within two (2) months from the filing date of the original application.

Any supplement or amendment to be made under the preceding Paragraph shall not exceed the scope disclosed in the specification or drawings submitted along with the original application.

#### Article 101

A claimed utility model in a patent application will not be published until the applicant shall have paid the issue fee and the first year annuity within three (3) months after the applicant has received the written decision for grant of the patent as requested; if the applicant fails to make the foregoing payments upon expiry of the given deadline, no publication of said utility model will be made, and the patent right granted thereto shall not exist ab initio.

A claimed utility model in a patent application shall be granted a utility model patent right, effective from the date of publication thereof, and a patent certificate shall be issued thereto.

The duration of a utility model patent right shall be ten (10) years from the filing date of the patent application.

#### Article 102

Where an application originally filed for an invention or a design patent protection is converted into a utility model patent application or where an application originally filed for a utility model is converted into an invention patent application, the filing date of the original patent application shall be taken as the filing date of the converted patent application provided, however, that no application for patent conversion may be filed after lapse of sixty (60) days from the date the written decision granting a patent or the written decision denying a patent on the original patent application is served.

#### Article 103

After a utility model claimed in a patent application is published, any person may, with respect to the conditions set forth in Item 1 or Item 2, Paragraph One, or Paragraph Four of Article 94; Article 95; or Article 31 applicable mutatis mutandis under Article 108 of this Act, apply to the Patent Authority for obtaining a technical revaluation report pertaining to the proposed utility model.

The Patent Authority shall publish in the Patent Gazette the facts that an application for a technical evaluation report regarding a proposed utility model as set forth in the preceding Paragraph is filed.

Upon receipt of an application for the report of Paragraph One of this Article, the

Patent Authority shall appoint patent examiner(s) to prepare the technical evaluation report regarding the proposed utility model and to indicate his/their name(s) thereon.

In the event the fact of a commercial practice of the proposed utility model by a person other than the patentee has been described by the applicant when filing the application for a technical evaluation report regarding the proposed utility model in accordance with the provision set out in Paragraph One of this Article, and relevant evidences has been submitted along with the application, the technical evaluation report shall be completed within six (6) months.

An application for a technical evaluation report regarding a proposed utility model may still be filed after the extinguishment of the utility model patent ipso facto.

An application filed in accordance with the provisions of Paragraph One shall not be withdrawn.

#### Article 104

When exercising a utility model patent right, the patentee of that utility model right shall present the technical evaluation report regarding the utility model patent for the purpose of warning.

#### Article 105

In case the patent right of a utility model is revoked, the patentee shall be liable for the damages sustained by any other persons from the exercising of such utility model right by said patentee prior to the revocation thereof.

In the case set forth in the preceding Paragraph, if the exercise of the utility model patent by the patentee is carried out based on the contents of the technical evaluation report associated with said utility model, or with due care by the patentee, it shall be presumed that the patentee has done no fault in exercising the utility model patent right.

#### Article 106

Unless otherwise provided for in this Act, the patentee of a utility model shall have the exclusive right to preclude other persons from manufacturing, offering for sale, selling, using, or importing for such purposes such patented products without his/her prior consent.

The scope of a utility model patent shall be determined based on the claim(s) set forth in the specification of the patented utility model. When interpreting the scope of claims, the description and drawings of the utility model patent may be used as reference.

#### Article 107

Under any of the following circumstances, a utility model patent right shall be revoked and the patent certificate issued thereto shall be recalled within a given time limit by the Patent Authority upon receipt of an invalidation action and if recalling fails, a public notice of revocation of said patent certificate shall be published:

1. If the utility model patent is found in violation of the provisions of Paragraph One, Article 12; Article 93 through Article 96; Paragraph Two, Article 100; Article 26 applicable mutatis mutandis under Article 108; or Article 31 applicable mutatis mutandis under 108 of this Act;
2. If the home country of the patentee does not accept the patent applications to be filed by nationals of the ROC; or
3. If the utility model patentee is a person other than the person entitled to file the utility model patent application.

An invalidation filed on the ground of violation on the provisions set out in Paragraph One, Article 12 of this Act or the grounds set forth in Item 3 of the preceding Paragraph of this Article shall be filed only by an interested party; whereas under any other circumstances set forth in the preceding Paragraph, any person may file to the Patent Authority an invalidation action with evidences.

The written decision to be issued in respect of an invalidation action shall be affixed with the signature of the patent examiner(s) making such decision.

## Article 108

The provisions of Articles 25 through 29, Articles 31 through 34, Paragraph Two of Article 35, Articles 42, Paragraph Two of Article 45, Article 50, Article 57, Articles 59 through 62, Articles 64 through 66, Paragraph Three and Paragraph Four of Article 67, Articles 68 through 71, Articles 73 through 75, Paragraphs One, Two and Four of Article 78, Articles 79 through 86, Articles 88 through 92 of this Act shall apply *mutatis mutandis* to the utility model patents.

## Chapter IV

### Design Patents

## Article 109

The term " design" shall refer to any creation made in respect of the shape, pattern, color, or combination thereof of an article through eye appeal.

The term "associated design" as used herein refers to a creation made by the same person, which is originated from and similar to his/her original design.

## Article 110

Any design that is industrially applicable and is free from any of the following conditions may be granted a design patent upon an application filed in accordance with this Act:

1. Which, prior to applying for patent, is preceded by an identical or similar design already published or put to public use; or
2. Which, prior to applying for patent, has become known to the public.

In the event a design is under any of the conditions set out in Paragraph One of this

Article as a result of either of the following events, and a patent application has been filed for said design within six (6) months from the date of such event occurs, the design shall be free from any of the restrictive condition set out in the preceding Paragraph:

1. Where it has been displayed in an exhibition sponsored or approved by the government; or
2. Where it has been disclosed in a manner not agreed by the applicant.

An applicant claiming the application of the definition set forth in Item 1, Paragraph One of this Article shall indicate the facts and the relevant date(s) in his/her application, and submit evidential documents within the time limit specified by the Patent Authority.

Notwithstanding the fact that a design is not under any of the conditions set out in Paragraph One of this Article, it shall still not be granted a patent under this act if it can easily be conceived by ordinarily skilled persons in the relevant art based on existing prior art before the application for patent is filed.

If the same applicant applies for a patent on a design similar to another design patent application filed by the same person, an associated design patent application shall be filed in respect of said similar design without being subject to the restrictions set out in Paragraph One and in the preceding Paragraph of this Article. However, if, prior to the filing of the original design patent application, another design identical or similar to such associated design has been published, or put to public use, or has become known to the public, no associated design patent may be applied for and granted under this Act.

No application for an associated design patent may be filed if the design involved is claimed to similar to another associated design.

## Article 111

Where a design claimed in a patent application is identical or similar to the contents described in the specification or drawings submitted along with an application for design patent filed prior to but patented after the filing of the present patent

application, no design patent may be granted to the design, except that the applicant(s) of the present application and such prior design patent is ( are ) the same.

#### Article 112

The following items shall not be granted design patents:

1. An article the shape of which is solely dictated by the function of the said article;
2. A pure fine arts creation or work;
3. Layout of integrated circuits and electronic circuits;
4. An article which is contrary to public order or good custom or public health; and
5. An article the shape of which is identical or similar to a political party flag, the national flag, a portrait of the Father of the ROC, the national emblem, the military flags, an official seal, or a medal awarded by the government.

#### Article 113

A design claimed in a patent application is approved after examination, it will not be published until the applicant shall have, within three (3) months after the service of the written decision, paid the issue fee and the first year annuity ; no publication shall be made if the foregoing fees is not paid upon expiry of the above-given deadline, and in this case, the patent right so granted thereto shall become non-existent ab initio.

The claimed design in a patent application shall be granted a design patent right upon the date of publication and a patent certificate shall be issued thereto.

The duration of a design patent right shall be twelve (12) years from the filing date of the patent application; and the duration of an associated design patent right shall expire simultaneously with the duration of the original design patent right.

#### Article 114

Where an application originally filed for an invention patent or a utility model patent

is converted into a design patent application, the filing date of the original invention or utility model patent application shall be taken as the filing date of the design patent application provided, however, that no patent conversion application may be filed after sixty (60) days from the date the written decision granting a patent or the written decision rejecting a patent on the original patent application is served.

#### Article 115

Where an application originally filed for an independent design patent is converted into an associated design patent application, or an application originally filed for an associated design patent is converted into an independent design patent application, the filing date of the original patent application shall be taken as the filing date of the converted patent application provided, however, that no patent conversion application may be filed, after sixty (60) days from the date the written decision granting a patent or the written decision rejecting a patent on the original patent application is served.

#### Article 116

An application for a design patent shall be filed by the person entitled to file the patent application by submitting to the Patent Authority a written application accompanied by a specification and drawings.

Where the person entitled to file a patent application is an employer, assignee or heir, the name of the creator shall be indicated in the application, and the document evidencing the employment, assignment or inheritance shall be submitted along with the application.

For an application for a design patent, the date on which the written application and the accompanied specification and drawings are submitted shall be the filing date of the patent application.

Where the accompanied specification and drawings initially submitted are written in a foreign language, and the Chinese version thereof are submitted within a given time limit fixed by the Patent Authority, the date of submission of the foreign language version shall be regarded as the filing date of that patent application; failure to submit the Chinese translation by the given deadline shall cause the dismissal of the patent

application. However, if the Chinese version of such accompanied specification and drawings are submitted prior to the date on which an administrative measure is taken, the date of submission of the Chinese version shall be regarded as the filing date of the patent application.

#### Article 117

The specification and drawings as required in the preceding Paragraph shall contain the title of the article embodying the design, the description of the creation, the drawings or figures and the description thereof.

The descriptions and drawings shall provide sufficiently clear and complete disclosure so as to enable the ordinarily skilled persons in the relevant art to understand the contents of, and to practice said design.

The manner to disclose the specification and drawings of a design shall be prescribed in the Enforcement Rules of the Patent Act.

#### Article 118

Where two or more patent applications are filed in respect of the same or similar designs, only the design claimed in the first application may be granted a design patent, except that the date of priority claimed in the later application is earlier than the date of application of the earlier application.

In case the filing date and the date of priority claimed under the preceding Paragraph fall on the same day, the applicants involved shall be required, by a notice, to settle the issue by an agreement, and in the absence of such an agreement, no design patent shall be granted to any of the applicants involved; whereas, if the separate patent applications are filed by the same applicant, said applicant shall be required, by a notice, to choose one therefrom as the valid application, and no design patent shall be granted, if the applicant fails to make such choice.

Where the applicants involved are required to reach a mutual agreement under this Article, the Patent Authority shall further require, by a notice, such applicants report the result of such negotiation within a given period of time; and in the absence of the

report upon expiry of the given time limit shall be deemed as a failure of such negotiation.

#### Article 119

In applying for a design patent, one application shall claim one design only.

A design patent application shall designate the article to which the design is applied.

#### Article 120

In case a design patent application is found to be in violation of the provisions of Article 109 through Article 112, Article 117, Article 118, Paragraph One, Article 119, or Paragraph Three, Article 122 of this Act, a disapproval decision shall be made.

#### Article 121

Where a claimed design in a patent application is considered, through patent examination, not un-patentable, a patent right shall be granted to the claimed design, and the drawings accompanied thereto shall be published.

#### Article 122

When examining an application for a design patent, the Patent Authority may, at a request or ex officio, notify the applicant to do the following acts within a specified time limit:

1. To appear before the Patent Authority for an interview;
2. To submit models or samples; or
3. To supplement or amend the specification or drawings.

The Patent Authority may, when necessary, visit the site or a designated place for inspection and observation of the models or samples which are required to be submitted under Item 2 of the preceding Paragraph.

The content of supplement or amendment to be made under Item 3 of Paragraph One above shall not exceed the scope of contents as disclosed in the original specification and drawings submitted along with the patent application.

#### Article 123

Unless otherwise provided for in this Act, for the designated article to which a patented design is applied, the patentee of such design patent shall have the exclusive right to preclude others from manufacturing, offering for sale, selling, using or importing for above purposes the articles of the design or similar design as claimed in the design patent without his/her prior consent.

The scope of the design patent right shall be determined based on the drawings of the patented design. When interpreting the scope of claim, the descriptions of the design patent made in the specification of the creation may be used as reference.

#### Article 124

The patent right of an associated design is attached to the patent right of the original design. An associated design right shall not be claimed separately, nor shall its effect be extended to the scope of similarity.

The patent right of an associated design shall be revoked or extinguished concurrently with the revocation or extinguishment of the patent right of the original design.

#### Article 125

The effect of a design patent right shall not extend to any of the following matters:

1. Where the design is put into practice for the purposes of research, teaching or experiment without any profit-seeking actions;
2. Where, prior to the patent application, the design article has been put into use in this country, or where all necessary preparations have been completed for such

purpose; with the exception that the information of the design was obtained from the patent applicant within six (6) months prior to the patent application and, that the patent applicant has made a statement to reserve its patent right therein;

3. Where the article has already been in existence in this country prior to the patent application;

4. Where the article is simply a vehicle or a device thereof that passes the territory of this country;

5. Where a licensee has used the design or has completed the necessary preparations for the use said design in good faith in this country prior to the revocation of the patent right, which is obtained by a person who is not entitled to apply for patent, as a result of a invalidation action filed by the patentee; and

6. Where the patented articles manufactured by the patentee or under the consent of the patentee are put to use or resold after the sale thereof. The aforesaid manufacture and sale are not limited to the manufacture and sale in this country only.

The user referred to in Items 2 and 5 of the preceding Paragraph may continue the use of the design only in its original enterprise. The geographic areas in which sale can be made under Item 6 of the preceding Paragraph shall be determined based on the facts by the court.

In case the licensee set forth in Item 5, Paragraph One of this Article keeps practicing the design after the patent right over such design has been revoked due to an invalidation action, said licensee shall pay to the patentee of that design a reasonable royalty to be calculated from the date of his/her receipt of a notice of the patent right revocation given by said patentee.

## Article 126

A design patentee may assign, entrust, license, pledge the design patent right to others for putting the design into practice in respect of the articles designated for application thereof, and such assignment, entrustment, licensing, or pledging may not be asserted against any third party, unless having been registered with the Patent Authority. Notwithstanding the proceeding provision, an associated design shall not be

separately assigned, entrusted, licensed, or pledged.

#### Article 127

A design patentee may file an application with the Patent Authority for correcting only the mistake or obscure statement contained in the specification and drawings of the granted patent.

After approval of the correction(s) made in accordance with the preceding Paragraph, the Patent Authority shall publish the cause for such correction(s) in the Patent Gazette.

The correction(s) approved and made in the specification and drawings shall take effect retroactively from the filing date of said design patent application.

#### Article 128

Under any of the following circumstances, a design patent right shall be revoked and the patent certificate shall be recalled within a given time limit by the Patent Authority, upon the institution of an invalidation action or ex officio and if a recall fails, a public notice for revocation of the patent certificate at issue shall be published:

1. If the design is in violation of the provisions of Paragraph One, Article 12, Article 109 through Article 112, Article 117, Article 118 or the provisions of Paragraph Three, Article 122 of this Act;
2. If the home country of the applicant does not accept the patent applications filed therein by nationals of the ROC; or
3. If the design patentee is not the person entitled to file the design patent application.

An invalidation action against a patented design for its violation of the provision set out in Paragraph One, Article 12 hereof or the provision set out in Item 3 of the preceding Paragraph of this Article may be instituted only by an interested party to such case; whereas under any other circumstances set out in the preceding Paragraph, an invalidation accompanied by relevant evidences may be filed with the Patent

Authority by any person.

#### Article 129

The provisions of Article 27, Article 28, Article 33 through Article 35, Article 42, Article 43, Paragraph Two, Article 45, Article 46, Article 47, Article 60 through Article 62, Article 65, Article 66, Paragraph Three and Paragraph Four of Article 67, Article 68 through Article 71, Article 73 through Article 75, Article 79 through Article 86, and Article 88 through Article 92 shall apply mutatis mutandis to design patents.

In the case of design patent applications, the period specified in Paragraph One of Article 27 shall be six (6) months instead.

#### Chapter V

#### Supplemental Provisions

#### Article 130

The files of application documents, specifications, figures and drawings of patent applications shall be placed in the custody of the Patent Authority on a permanent basis. The files of other documents shall be kept for a period of no less than thirty (30) years.

The patent files referred to in the preceding Paragraph may be stored by means of microfilms, magnetic discs, magnetic tapes, optical discs or other storage mediums. The files so stored, which have been confirmed by the Patent Authority, shall be deemed the original files, and the original hard copy of such patent files may be destroyed. The reproduction of the information and records of any patent file kept in the storage mediums shall be presumed as a true copy upon confirmation by the Patent Authority.

Rules governing the confirmation, administration and use of the substitutes for the files kept in storage mediums referred to in the preceding Paragraph shall be

prescribed by the Competent Authority.

#### Article 131

The Competent Authority may develop and publish incentive regulations for encouraging invention and creation activities.

#### Article 132

For the patent applications filed before January 23, 1994, no application for extension of the patent terms may be filed under Article 52 of this Act.

#### Article 133

Where an application for patent-of-addition filed before the amendment to this Act on October 24, 2001 has not been given an irrevocable examination decision, or where a patent-of-addition remains effective, when the amendment to this Act took effect, the provisions governing patent-of-addition in force before said amendment shall be applied thereto.

#### Article 134

For those patent cases that have been allowed and published prior to the January 21, 1994 Amendment to this Act, the duration of the patent rights granted in such cases shall be calculated in accordance with the provisions in force prior to the present amendment to this Act. However, regarding invention patents that remain effective on the date the World Trade Organization Agreement (hereinafter referred to as the "WTO Agreement) comes into force in the jurisdictional territory of the ROC, the provisions governing the duration of invention patent rights to be enforced after the present amendment to this Act shall prevail.

For the utility model patent application cases in respect of which an irrevocable decision has been made and the contents of the utility model have been published, the provisions governing the duration of utility model patent rights to be enforced before

the present amendment to this Act shall prevail.

For the design patents that remain effective on the date the WTO Agreement comes into force in the jurisdictional territory of the ROC, the provisions governing the duration of design patent right this Act that have been enforced till now after the May 7, 1997 Amendment to this Act shall prevail.

#### Article 135

For the patent applications which were filed but an irrevocable examination decision has not been rendered thereto prior to the enforcement of the January 3, 2003 Amendment to this Act, the provisions governing the duration of patent rights to be enforced after the effective date of the present amendment hereof shall prevail.

#### Article 136

For the patent opposition actions that were instituted and are pending prior to the enforcement of the January 3, 2003 Amendment to this Act, the provisions in force prior to the enforcement of the present amendment shall prevail.

For the applications in respect of which an irrevocable examination decision has been made and the contents of the patented matters have been published prior to the enforcement of the January 3, 2003 Amendment to this Act, an opposition action may still be instituted against any of such patented matters in accordance with the provisions of this Act in force prior to the enforcement of the present amendment of this Act, even after the present amendment takes effect..

#### Article 137

The Implementing Regulations of this Act shall be prescribed by the Competent Authority.

#### Article 138

Except for the provision of Article 11 hereof, which shall come into force from the date of promulgation of the present amendment, the effective date of the provisions set out in all other Articles hereof shall be decided by the Executive Yuan.