Taiwan has had specific patent law since 1944. It was one of the first countries to adopt patent legislation. Since then, Taiwan’s industrial focus has shifted from agriculture and small manufacturing to high-tech industrial production. The Patent Act 1944 has been amended many times to follow international trends and remain consistent with global patent practice. As a result of the political issues relating to Taiwan’s identity, Taiwan is not a signatory to many global patent treaties. Instead, various patent practices specific to Taiwan have been established. This chapter considers these special provisions and discusses some major developments relating to patent prosecution in Taiwan.

Claiming priority
The right of priority is one of the most important rights to be considered in international patent applications because it gives a patent applicant the right to track its filing date back to the date of filing the first application. Although the Patent Act provides for a right of priority in Taiwan, these rules are inconsistent with general global practice.

Changes following WTO membership
Before Taiwan became a member of the World Trade Organisation (WTO), Taiwanese patent applicants could not claim priority if they subsequently filed patent applications in most countries in the world. As Taiwan is not a member of the Paris Convention, a key document for priority claims, it was unable to enjoy the cooperative benefits of international patent prosecution. In the mid-1990s Taiwan focused on forming bilateral patent recognition agreements with its major trading partners (Australia, Austria, France, Germany, Japan, Liechtenstein, the Netherlands, New Zealand, Switzerland, the United Kingdom and the United States) and gained reciprocal recognition with those countries. Although this facilitated international patent filings, it was still not enough. As Taiwanese industry began to play a more important role in the global manufacturing chain, the ability to claim priority in only 11 countries was insufficient to satisfy the needs of the global patent prosecution business.

In 2002 Taiwan joined the WTO and agreed to comply with the terms of the Agreement on Trade-Related Aspects of Intellectual Property Rights. An applicant can now file a patent application in Taiwan within 12 months of the earliest date on which any corresponding application has been filed in another WTO member country. As Taiwan joined the WTO on January 1 2002, the priority date cannot be earlier than that date.

Article 27 of the Patent Act provides that a patent applicant that files an initial patent application in a WTO member state may claim priority for a Taiwan application within 12 months. If the foreign applicant is a citizen of a country that is not a WTO member, but has a place of business or residence in a WTO member country, he or she may also claim priority for an application in Taiwan. In this regard, the Taiwanese application will be treated as if it had been filed on the same date as the first application filed in the WTO member country.

As the political relationship between Taiwan and China remains unresolved, foreign patent attorneys and agents do not always know whether it is necessary to file a separate patent application in Taiwan after filing a patent application in China. In fact, the Taiwan and Chinese governments control only the patent applications filed in their own territory. A patent application granted in China cannot be enforced in Taiwan. In addition, China and Taiwan do not admit priority rights for each other’s patent applications (even though both are WTO members). Thus, an applicant that files a patent application in Taiwan is unable to claim priority based on his or her Taiwan patent application when subsequently filing a corresponding application in...
China, and vice versa. In order to maintain the benefit of the earliest filing date, it is necessary to file patent applications in both Taiwan and China, especially when an applicant chooses one of these countries as the first filing country for a global patent prosecution.

Relationship with PCT countries

Most countries are signatories to the Patent Cooperation Treaty (PCT), including all major industrialised countries. Taiwan, however, is still not a party to the PCT. When filing under the PCT procedure, an applicant may submit a request to enter a specific national phase within 30 months of the international filing date. Since Taiwan is not a PCT country, however, the applicant cannot file an application in Taiwan through PCT procedures and the 30-month grace period does not apply. Some foreign applicants have lost their right to claim priority by mistakenly assuming that Taiwan is a party to the PCT.

The Paris Convention states that any filing that is equivalent to a regular national filing under the domestic legislation of a country that is a party to the convention, or under bilateral or multilateral treaties concluded between countries that are party to the convention, shall be recognised as giving rise to the right of priority. As a result, on November 27 2002 the Taiwan Intellectual Property Office (TIPO) announced that an applicant from a WTO member country that files a patent application in Taiwan based on a PCT application may claim a right of priority if the application is allowed provided that the Taiwanese Patent Act is more restrictive, providing only a six-month grace period. In some countries, such as the United States, a grace period allows an inventor to publish his or her invention for one year prior to the filing date. The Taiwanese Patent Act is more restrictive, providing only a six-month grace period. In addition, the grace period can be claimed only if:

- publication is a result of research or experimentation;

Foreign provisional application

Some countries, such as Australia and the United States, provide for a provisional application filing procedure. A provisional application allows an applicant to obtain a filing date in advance of filing the regular (non-provisional) application. After filing a provisional application, the non-provisional application must be filed or the provisional application must be converted into a non-provisional application within a specific timeframe (eg, 12 months in Australia and the United States). Thus, a provisional application is deemed to be the first filing in Taiwan when claiming a priority right for the corresponding Taiwan application.

In general, the provisional application will be updated to form the non-provisional application, with the addition of new material as necessary. However, only the foreign application for the same invention can be used to claim priority. If an application filed in Taiwan is based on a non-provisional application with a different claim scope or for different technology from that disclosed in the provisional application, the non-provisional application shall form the base application for that part of the claim. Therefore, if amendments are made between a foreign provisional application and a foreign non-provisional application, the foreign non-provisional application should be claimed as the basic application and the relevant certified application documents should be submitted to TIPO at the same time to ensure the applicant’s right of priority.

Novelty grace period

An invention must be kept secret until a patent application is filed. In some countries, such as the United States, a grace period allows an inventor to publish anywhere, make available for public use or put on sale in the United States his or her invention for one year prior to the filing date. The Taiwanese Patent Act is more restrictive, providing only a six-month grace period. In addition, the grace period can be claimed only if:

- publication is a result of research or experimentation;
that claims drafted in the following formats are considered to be therapeutic methods:

- “a method for treating disease X, using...”; or
- “use of substance Y in the treatment of disease X”.

Although the Patent Act restricts therapeutic methods, this does not mean that a therapeutic medicine or substance cannot be protected by a patent in Taiwan. If an inventor wants patent protection for a therapeutic invention, he or she can draft a patent application setting out claims in the following manner:

- “a composition for treating disease X, comprising...”; or
- “a method for producing a substance for treating disease X, comprising...”; or
- “using substance Y in producing medication for treating disease X”.

Patent claims drafted in such a way are not considered to be therapeutic methods and are patentable under the Patent Examination Standards.

**Limitation contrary to public order, morality or public health**

As the most controversial technology in the biotech field, the patentability of human cloning is one of the hottest discussion topics in the patent field. According to the prohibition clauses, human cloning is considered contrary to public order, morality or public health and related inventions are not regarded as patentable subject matter. As human cloning is a very broad concept and there are some ambiguities, patentable and non-patentable matters can be distinguished. TIPO is drafting guidelines to provide more detailed guidance and to define ‘human cloning’. It is hoped that these guidelines will balance the interests of developing medical science against the public interest.

**Depositing biological material for patent applications**

Under Article 30(1) of the Patent Act, when applying for an invention patent involving biological material or the use of biological material, the applicant shall, no later than the filing date:

- deposit the biological material at a deposit institute designated by the Patent Authority; and
- indicate in the application the name of the deposit institute and the date and serial number of the deposit.

This deposit is not required, however, if the biological
material can be easily obtained by an ordinary person skilled in the relevant field. At present, the Bioresource Collection and Research Centre is the deposit institute appointed by the authority and the only institute authorised by the Taiwanese government for the deposit of patented microbial materials.

Since Taiwan is not a signatory to the Budapest Treaty, a patent applicant cannot complete the deposit process for his or her biological material at a deposit institute recognised by the Budapest Treaty when filing a patent application for biological materials.

However, in the event that the biological material has been deposited at a foreign deposit institution recognised by TIPO before filing the patent application, there is a three-month grace period to allow the applicant to complete the deposit process in Taiwan if he or she requests this in the application. Within this three-month period the applicant must submit the deposit certificates issued by both the Bioresource Collection and Research Centre and the foreign deposit institution to complete the deposit process for the patent application.

Comment
The processes for international patent prosecution develop very quickly. Foreign attorneys practising international patent prosecution need at least a general understanding of some of the peculiarities of Taiwanese practice, as this may influence their application and prosecution strategies in Taiwan. Many further developments have been discussed in recent months and are expected to be implemented in 2008, including:

- the establishment of specialist IP courts;
- new dispute resolution procedures for IP cases; and
- new guidelines for biotechnology and computer software.

Taiwanese IP practice is expected to continue to enjoy fast and active development over the coming year.