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Introduction of the Design Patent Amendments in the New Taiwan Patent Act

The new Patent Act came into effect on January 1, 2013. In the new Patent Act, other than the amendments to the original provisions, related provisions regarding "partial design," "icon design," "group design" and "derivative design" were also added according to international practices and industry development trends.

The original provisions stipulated that protected new design patents have to be the "overall design" of the entire appearance of the object. However, to avoid competitors in the market plagiarizing parts of the novelty features of products and easily avoiding the protection of design patents, the amended Patent Act stipulates that the applicant may file a design patent application for the "partial design" of partial components of an object like car lights, or parts of the features for the appearance of an object like the exterior patterns on sneakers.

When filing an "overall design" patent application, the overall appearance of the drawing of the object in the specification must be outlined with ink lines. But when filing a patent application based on "partial design" of the object, the object to which the partial design applies must be stated in the specification. In addition, "the parts in the drawing which the design intends to claim" and "the parts in the drawing which the design does not claim" must be presented in a manner whereby the different parts can be clearly distinguished. For example, the appearance of "the parts in the drawing which the design intends to claim" of the patent application shall be specifically and realistically shown in solid lines, and "the parts in the drawing which the design does not claim" shall be shown in dotted lines or colored in grey or shown in a translucent manner to clearly distinguish "the parts in the drawing which the design intends to claim" from "the parts in the drawing which the design does not claim."

Computer Generated Icons ("CGI") like ones used for click-to-action functions and Graphical User Interface ("GUI") like function menus refer to types of drawings that are shown on display panels and monitors and only exist temporarily, and that cannot be constantly shown on objects like patterns or colors on wrapping paper or cloths. CGI includes application icons that are used for click-to-action functions shown on the monitors of computer or electronic devices. GUI includes pull down function menus or function menus in different forms. However, with the amendment of the Patent Act, it has been determined that the "icon design" of CGI and GUI used for objects are also a type of creation used for the appearance of the object, and thus it may also be subject to the protection of design patents.

When filing an "icon design" patent application, since icon designs have to be shown through monitors, display devices or various kinds of display panels, thus the object that shows the icon design has to be designated. The drawings of the CGI and GUI cannot be filed alone. Furthermore, other than still "icon designs," icon designs that change in appearance like video game characters that transform or user interfaces that change through click-to-action functions

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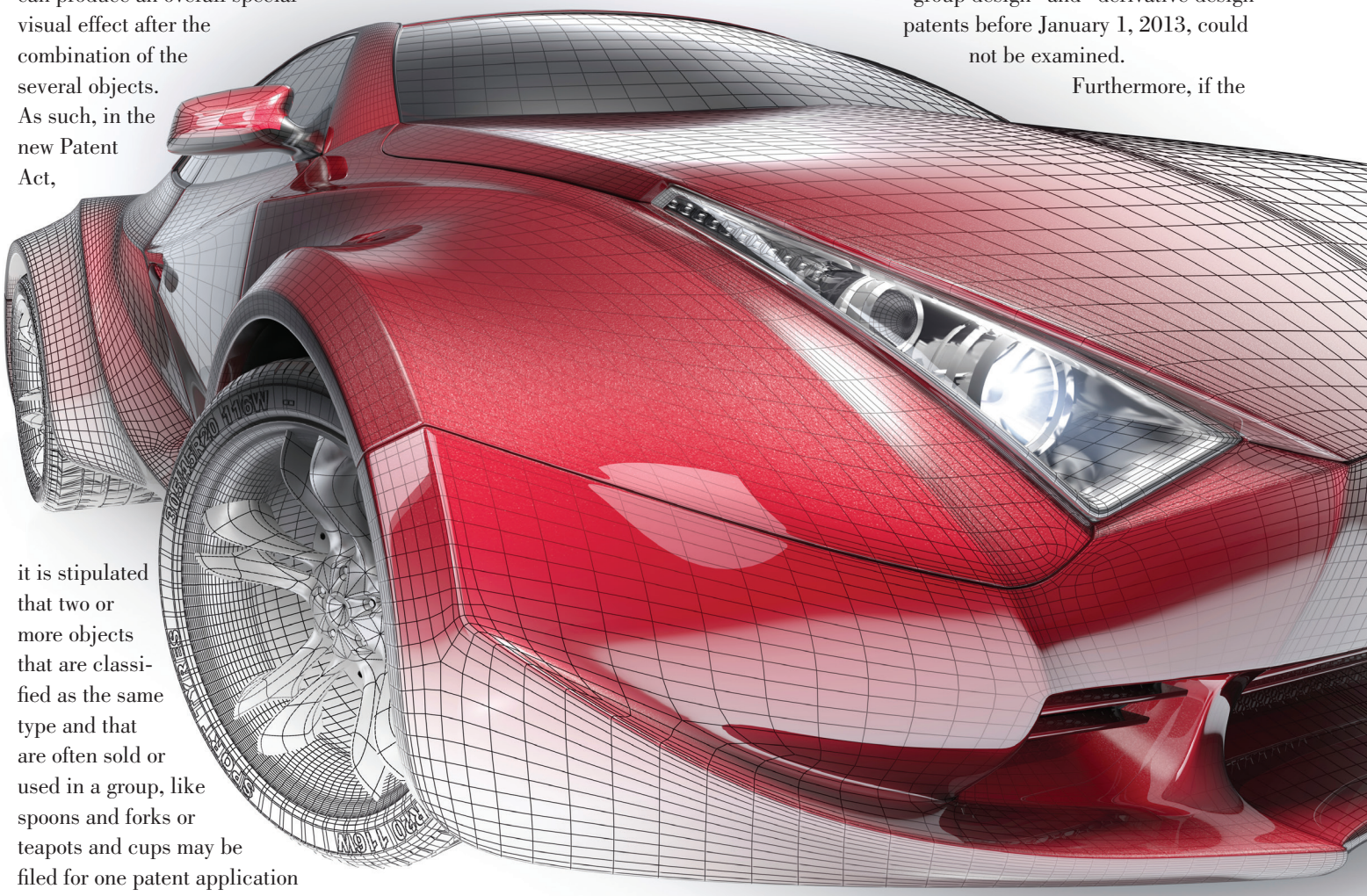
can also be filed for a patent application for the several changes of the appearance of the icon designs during the show of use of the drawing.

In the original provisions, it is stipulated that when filing new design patent applications, the appearance of each object shall be filed for, i.e. "an application for each design." However, when design industries are developing products, they often develop an entire creation for several objects that are often sold or used at the same time to achieve a design that can produce an overall special visual effect after the combination of the several objects. As such, in the new Patent Act, it is stipulated that two or more objects that are classified as the same type and that are often sold or used in a group, like spoons and forks or teapots and cups may be filed for one patent application as a "group design" to protect the design of the overall visual effects of the group. However, when exercising the rights of the design, the group design can merely be regarded as one design; the rights of each component of the group design cannot be exercised alone.

Furthermore, when developing new products, industries usually develop several similar product designs based on the same design concept, or develop similar designs due to improvements of the same product. In order to take into consideration similar designs developed based on the same design concept or due to improvements of the same product, which have the same value as the original design and thus shall be granted the same protection, the new Patent Act stipulates that when an applicant has two or more similar designs, the designs shall not be limited to the "first to file" condition, and the design after the second one may be filed as a "derivative design" patent application.



Compared to the "associated new design patent" of the original Patent Act, the deadline for filing a "derivative design" patent application is limited to when the applicant of the original design has filed a patent application (including the day that the patent application was filed) or before the patent examination of the original design. However, after the applicant of the derivative design obtains the patent rights, he/she may exercise the rights alone, and the derivative design shall not be classified as the original design and its effect shall be extended to the scope of similarity, thus the range of derivative designs is more independent and wider than the range of the original "associated new design patent."

Since the related provisions for filing "partial design," "icon design," "group design" and "derivative design" patent applications were implemented on January 1, 2013; therefore the applications filed for "partial design," "icon design," "group design" and "derivative design" patents before January 1, 2013, could not be examined.

Furthermore, if the priority date claimed by applicants that file for "icon design" and "group design" patent applications after January 1, 2013 and that claim priority rights is earlier than the implementation date of the amendment of the Patent Act, which is January 1, 2013, the priority date shall be January 1, 2013.