

Patents

Taiwan IP Court Rules on Disclosure of Prior Art Drawing for Negating Validity

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When handling a patent infringement suit in which the allegedly infringing party asserts patent invalidity, or an administrative suit as a subsequent procedure to a cancellation (invalidation) action, the court must make a determination as to whether the patent is valid. If a technical feature of a patent in dispute is not clearly disclosed in the textual description of a cited document, requiring the drawings of the cited document to be carefully referred to, according to the Patent Examination Guidelines, only those features "clearly" disclosed in the drawings can be deemed a portion of disclosure of that cited document.

Recently, two judgments were issued in the Taiwan Intellectual Property Court. In each of the two court cases, the patentees argued that the opponent parties "speculated" that the drawings within the cited documents disclose the features of the patents in dispute. The IP Court however, considered the disclosed drawings capable of complementing the insufficient disclosure of the textual description of the prior art references.

In Judgment No. 102-Min-Chuan-Shan-43, one important contentious issue was that the main technical feature of the patent in dispute, that of an interdental brush, the fixation portion of which was formed by twisted metal wires, had an enlarged portion so that the fixation portion does not easily slip off from the handle after it is inserted into the handle. Although the textual description of the cited document mentions that the fixation portion is formed as spiral structure, it does not disclose forming an enlarged portion thereon.

Could the technical feature of the patent in dispute be reasonably inferred by referring not only to the description but also the drawings? The court held that although the cited document does not clearly disclose the relationship between the outer diameter of the twisted metal wire portion and the dimension of the metal wire, the textual description has disclosed that the twisted metal wire portion has the manner of an "irregular spiral twist" and did not need to "specify the shape of the twisted portion", and thus the cited document would achieve the effect of not easily slipping off from the handle. In addition, the drawings disclose that due to the clamping of the twisted wires, the bristles extended outward laterally. Given the above, the court considered that persons with ordinary skill and common knowledge in the art could "directly and unambiguously" know the technical features of the patent in dispute from the disclosure of the cited document and thus concluded that the patent lacked novelty.

Meanwhile, Judgment No. 102-Shing-Chuan-Suit-48 involved a case where the most important cited document did not mention the concrete shape of the axle such as the shape of the splines and a "flange" on the axle, which were the main features of the patent in dispute. Both parties contended as to whether the disclosure of the drawings of the cited document met the requirement of "clearly disclosing". The court granted both parties' request to subpoena expert witnesses to state their opinions on the disclosure of the drawings.

The IP Court did not provide a concrete criterion regarding the level of disclosure which a drawing would meet the requirement of "clearly disclosing". Instead, it stated that the drawing disclosed "a hollow axle [with] a stepped cylindrical shape with several different diameters" and that "persons familiar with the skill in the art can understand the features from the drawing", and thus the court considered the patent to lack inventive step.

According to the Patent Act and relevant regulations, the drawings of a prior art references should be interpreted based on the technical level "at the time when the patent was filed" or "on the priority date". Under the circumstances where the textual description of a prior art reference does not disclose the main technical features of a patent, and where many years have passed before a cancellation or invalidation action is filed with the patent office or before a court starts to review the patent in an infringement case, it is worth observing how the patent office and the courts determine an appropriate series of measures or standards to interpret the content of such drawings at the correct technical level.