

Intellectual Property - Taiwan

TIPO to amend guidelines on inventive step assessment

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Introduction

The inventive step assessment is of paramount importance in patent application examinations, and examiners must often consider multiple references. In regards to the determination of patentability based on multiple references, the Patent Examination Guidelines state that:

"if a claimed invention could have been easily made by combining, modifying, substituting or adapting the teachings of one or more prior art references in view of the common knowledge at the time of filing, then the claimed invention as a whole is obvious. In that case, the examiner should determine that the claimed invention can be easily arrived at."

Because of these rules, examiners often treat prior art references as mosaic pieces, combining them without indicating which is the primary reference. Moreover, examiners often ignore the 'teaching away' of the prior art. These practices have resulted in many findings based on hindsight.

At a recent Intellectual Property Court conference, the Taiwan Intellectual Property Office (TIPO) representative discussed possible amendments to the Patent Examination Guidelines to avoid findings based on hindsight. The proposed amendments clearly define the technical level of a person having ordinary skill in the art ('PHOSITA') at the time of filing and provide principles to help examiners achieve objective reasoning based on available evidence. The proposed amendments, which are expected to make patent examination less subjective, cover the following areas.

Definition of PHOSITA

According to the guidelines, a PHOSITA is a 'hypothetical person'. However, technological development often involves interdisciplinary knowledge and requires the efforts of a group of persons – such as a research and development or manufacturing team – rather than a single person. Therefore, TIPO plans to adopt the European standards and amend the definition of PHOSITA in the inventive step assessment to mean a group of skilled persons from different fields.

Identification of primary reference

TIPO plans to require examiners to choose the closest prior art reference or the most appropriate prior art reference as the primary reference, which will enable examiners to determine a starting point for examination.

Inventive step assessment

Under the proposed amendments, when assessing an inventive step examiners should consider the following factors when determining whether there is motivation to combine two or more references:

- whether the references relate to the same field;
- whether the technical problems addressed by the references are the same or related;
- whether the effects or functions of the references are the same or related; and
- the teachings or suggestions of the prior art relating to the claimed invention.

If it is determined that there is motivation to combine two or more references, the examiner should then determine whether the claimed invention yields unexpected results.

Like their Japanese counterparts, TIPO examiners will have to take into account any 'blocking factors' (ie, the 'teaching away' of the prior art) when determining whether two or more references are combinable.

Blocking factors could include instances where:

- the purpose of the secondary references is different to that of the primary reference;
- the combination of the primary reference and secondary references would render the primary reference inoperable;
- the teachings of the secondary reference are incompatible with those of the primary reference; and
- it is already documented in the art that the teachings of the secondary references cannot be combined with those of the primary reference, and therefore the PHOSITA would not consider such a combination.

Comment

The amendments, if adopted, will improve the quality of inventive step assessments.

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