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How to determine novelty by implicit disclosure in prior art reference

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The purpose of the patent system is to encourage applicants to publicly disclose the results of their research and development by granting them exclusive rights so that the public can use such published inventions or creations. For this reason, there is no need to grant a patent for an invention or creation that has been known to the public before the patent was filed. This is the legal requirement for the patentability of 'novelty', as stipulated in Article 22(1) of the Patent Act.

According to the Patent Examination Guidelines, the following three factors determine novelty:

- whether the invention claimed in a patent application is exactly equivalent to the prior art disclosed in the citation document;
- whether the form of text description or technical features can be directly and unambiguously perceived in the citation document; or
- whether the corresponding technical features are superordinate and subordinate concepts.

As long as the claimed invention or creation is exactly or substantially equivalent to the prior art, the invention or creation should be considered as lacking novelty and not be granted a patent.

With regard to the criteria for determining novelty, the Supreme Administrative Court further explained in its 2015-Pan-No 764 judgment (December 17 2015) that:

> *"When reviewing novelty issue in an invalidation case, the invention at issue recited in each claim shall be compared to single invalidation evidence, and the decision should be based on the contents publicly disclosed in the invalidation evidence. Such contents include the explicit disclosure and the implicit disclosure in the invalidation evidence. The 'implicit disclosure' refers to the contents which can be directly and unambiguously obtained by the person having ordinary skill in the art from the common knowledge at the time when the invalidation evidence is disclosed. In other words, although single invalidation evidence does not disclose all technical features contained in the patent at issue, the undisclosed part must be the absolutely indispensable part naturally inherited or existing in that invalidation evidence, and such undisclosed part is inevitably inherited in such invalidation evidence from the viewpoint of the person having ordinary skill in the art."*

Conversely:

> *"if the explicit disclosure and the implicit disclosure in the invalidation evidence are unable to disclose the technical features of the invention at issue, that invalidation evidence is unable to prove that the invention at issue lacks novelty."*

In this case, the IP Court determined that there was a difference in only the form of text description between the claim of the patent at issue and the prior art reference after the technical features were compared, and that the prior art reference was admissible to prove that related claims of the patent at issue lacked novelty. However, the Supreme Administrative Court overruled this view and determined that in addition to the difference in the form of text description there was a substantial difference in the components and structures between the patent at issue and the prior art reference. Moreover, the

difference was not disclosed in the prior art reference and was not naturally inherited or existing in that evidence. Hence, the prior art reference was inadmissible to prove that Claim 1 lacked novelty.

Judicial practice considers that explicit disclosure in the citation document is not the only evidence that can be used for determining novelty of a claimed invention in a patent application. Determination can also include the undefined but naturally inherited or existing content in the citation document in view of a person having ordinary skill in the art. However, only when the implicit disclosure discloses the technical features of the invention at issue can it be determined that the patent at issue lacks novelty.

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