

## **Intellectual Property, Taiwan**

### **Refining determination of inventive step requirement**

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#### **Introduction**

A key factor in determining the validity of a patent is inventive step or non-obviousness. According to Article 22(2) of the Patent Act, "an invention that... can be easily made by a person having ordinarily skilled in the art based on prior art shall not be patented." However, hindsight often occurs in court practice in jurisdictions around the world when determining whether a patent is sufficiently inventive. Taiwan is no exception.

To deal with this issue, several recent Supreme Administrative Court judgments have clearly stated that in order to prevent a ruling based on hindsight, courts should first determine the level that a person ordinarily skilled in the art could achieve and then make a decision based on such a hypothetical person. The court should consider what constitutes "easily made... based on prior art" before it can make an appropriate determination.

#### **Decisions**

In Judgment Pan-Zi 326 (June 18 2015), the Supreme Administrative Court once again ruled that when reviewing the inventive step of a patent involved in a complaint, courts should first establish the level of a person ordinarily skilled in the art to form an objective baseline for determination, before taking the step to:

"determine if the invention in question is easily made by a person ordinarily skilled in the technical realm to which it belongs, with reference to disclosed content regarding previous technology, and generally-available knowledge at the time of application."

The judgment clearly stated:

"The establishment of the skill level of a person having ordinarily skilled in the technical realm to which [the invention] belongs, and the disclosed content regarding previous technology (i.e. evidence presented), are important steps in reaching an objective determination of inventiveness."

After establishing the said skill level, it becomes necessary to determine whether the invention can be 'easily made'. In Judgment Pan-Zi 452/2015 (August 13 2015), the Supreme Administrative Court further ruled that in order to avoid hindsight bias, the court should determine and describe in detail how the invention in question can be easily made based on suggestions or inspiration from prior technology. The judgment clearly stated:

"In determining inventiveness, the court should not rule that an invention may be easily made based on the hindsight of reading through the structured step-by-step content found in the description of the invention, and thus rule that the patent is not inventive. Instead, the court should compare the whole of the invention with the evidence presented in the complaint, and take the perspective of a person who is ordinarily skilled in the technical realm to which the invention belongs, with reference to common knowledge at the time of the application, and arrive at an objective judgment. The law states that an invention that 'can be easily made by a person having ordinarily skilled in the art based on prior art shall not be patented'. What technical characteristics present in Exhibit 3 can be transferred or exchanged with equal effectiveness, or provide inspiration or suggestions that allow the

invention to be easily made? As the original court did not investigate and clearly describe in detail the above matters, the original judgment's ruling that the technical characteristic 'does not surpass what can be easily achieved by a person ordinarily skilled in the technical field on the basis of existing technologies at the time of the application' seems hasty."

The case law suggest that future suits establishing an objective standard for determination for each case will be beneficial for correctly determining the inventive step of a patent.

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