

Intellectual Property – Taiwan

Court clarifies whether feature not disclosed by prior art is common knowledge in industry

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Introduction

Under local practice, any party that considers a patent which has been granted by the Taiwan Intellectual Property Office (TIPO) to be substantially the same or easily conceivable by persons skilled in the art with reference to prior art can initiate a cancellation action against the patent by submitting relevant prior art exhibits and a brief stating the reasons. If TIPO revokes the patent in the cancellation procedure, the patentee can file an administrative appeal with the Ministry of Economic Affairs. If the ministry affirms TIPO's decision, the patentee can file an administrative suit requesting the administrative court to review the case. Such administrative cases are generally handled by the administrative panel of the IP Court.

Decision

The IP Court's recent judgments show that in addition to the disclosure of prior art exhibits, the court pays more attention to whether the exhibits provide any motivation for persons with ordinary skill in the art to combine two or more prior art exhibits, should lack of inventive step be a critical issue in the case. In Judgment 103-administrative-patent-suit-85 (March 31 2015), the IP Court voluntarily initiated an evidence investigation to review two further prior art exhibits which were not submitted by the cancellation petitioner. It concluded that the feature not disclosed by the prior art exhibits submitted by the cancellation petitioner was common knowledge in the art. The judgment affirmed TIPO's decision to revoke the patent.

The judgment mainly determined whether a patent relating to a fire-resistant sheet and its manufacturing method lacked inventive step. TIPO held that the combination of Prior Art Exhibits 3, 4 and 5 were sufficient to negate the inventive step of Claim 1 of the patent. The patentee stressed in both the cancellation and appeal procedures that the combination of the individual prior art exhibits failed to provide a reasonable connection between the steps of the process as recited in the claim.

The court noticed that Prior Art Exhibits 3, 4 and 5 failed to disclose four of the steps recited in Claim 1:

- opening blended staple fibres;
- dispersing on a conveyor belt;
- reeling; and
- packaging.

The court considered Steps 1 and 2 to have been common knowledge in the relevant field long before the patent was filed. It thus voluntarily provided two prior art documents to substantiate:

- a China laid-open patent case; and
- Patent TW I261636.

The court also asked both parties to review the two documents and provide a response. As to Steps 3 and 4 relating to reeling and packing, because the specification of the patent failed to explain what effects these steps achieve in comparison with the prior art, and since the patentee failed to provide evidence supporting the inventive step achieved by these steps, the court did not consider that Claim 1 had an inventive step because it recited the steps of reeling and packaging.

The plaintiff argued that the court should not voluntarily review prior art exhibits other than those submitted by the cancellation petitioner. However, the court emphasised that according to Articles 125 and 133 of the Code of Administrative Suit, an administrative court should voluntarily initiate an evidence investigation proceeding in such a suit if necessary. It went on to state that according to Article 8 and Article 34(1) of the Intellectual Property Adjudication Act, if the court already has professional knowledge and has provided an opportunity for the parties to respond and debate, such knowledge can serve as the basis of the court's judgment.

Comment

In the past, the scope of examination of a cancellation action was limited to the prior art exhibits submitted by the cancellation petitioner and the issues that the cancellation petitioner requested TIPO to review. In the administrative appeal procedure, the Ministry of Economic Affairs would not review any argument or evidence not reviewed by TIPO in the cancellation action procedure. However, according to TIPO's Examination Guidelines issued in 2013, TIPO can, if necessary, voluntarily review issues and exhibits not raised or submitted by a cancellation petitioner (but such voluntary review must meet certain requirements).

The administrative panel of the IP Court appears to take the initiative in probing some exhibits not submitted by a cancellation petitioner to resolve issues disputed by the parties. Regarding the issue of whether the feature recited in a claim but not disclosed by prior art exhibits was commonly known to persons skilled in the art before the filing date of the patent at issue, TIPO failed to thoroughly investigate or find the facts in the cancellation action. The court could have expressed its opinion on this matter in the judgment and decided to remand the case (requesting TIPO to investigate and revise the decision); however, the IP Court tends to resolve such issues on its own.

With regard to 'common knowledge in the art' on which the inventive step is determined, the issue remains as to whether it is sufficient to prove common knowledge by providing another prior art document to address the insufficiency of the cancellation prior art exhibits, unless new evidence can further prove that persons with common knowledge in the art can combine the prior art exhibits to accomplish the claimed invention.

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