

Intellectual Property, Taiwan

New inventive step examination guidelines

Contributed by Lee and Li Attorneys at Law

The examination of inventive step is of paramount importance in examining patent applications. However, Taiwan Intellectual Property Office (TIPO) examiners tend to combine prior art references arbitrarily, which often results in findings based on hindsight. In order to prevent this practice and further enhance patent examination quality, TIPO amended the inventive step examination guidelines in April 2017. The amendments entered into force on July 1 2017.

Person having ordinary skill in the art

In cases that require interdisciplinary knowledge or the research efforts of a technical team, it is appropriate to expand the definition of the term 'a person having ordinary skill in the art' to include a group of persons.

Specifying scope of relevant prior art

Prior art references used in the examination of inventive step are usually chosen from technical fields identical or relevant to those to which the claimed invention pertains. Under the amendments, prior art references that belong to different or irrelevant technical fields but share some common technical features with the claimed invention are also regarded as relevant prior art references.

Obviousness

TIPO has deleted the following passage from the examination guidelines:

"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."

It has replaced it with the provision that if a person having ordinary skill in the art, in view of the prior art, could have arrived at the claimed invention through logical analysis, inference or routine work and experimentation, the claimed invention is obvious and can be easily accomplished.

Identifying primary reference

When determining the possible differences between a claimed invention and relevant prior art references, the examiner should choose the primary prior art reference for comparison with the claimed invention, which may belong to the same technical field as the claimed invention, or aim to resolve a problem substantially the same as that of the claimed invention.

Redefining test for determining inventive step

Under the amendments, the examiner should first determine whether it would be obvious to combine the relevant prior art references and the common knowledge at the time of filing. If yes, the examiner should determine whether there is any evidence indicating that the claimed invention lacks an inventive step. The examiner should consider whether the prior art reduces the advantages of the claimed invention. If there is logical and reasonable proof that the claimed invention can be easily accomplished, the claimed invention lacks an inventive step. Otherwise, the claimed invention involves an inventive step.

According to the amendments, a prior art reference can undermine the claimed invention if it is obvious that that prior art reference cannot be combined with another prior art reference.

If the new guidelines are fully observed by all examiners, the quality of inventive step examination will be improved.

For further information on this topic please contact Audrey Lo at Lee and Li Attorneys at Law by telephone (+886 2 2715 3300) or email (audreylo@leeandli.com). The Lee and Li website can be accessed at www.leeandli.com.