

=CORRESPONDENTS=

Taiwan - Intellectual Property

Revised guidelines improve Taiwan patent exam quality

By Hsiu-Ru Chien, Lee and Li

The Taiwan Intellectual Property Office (TIPO) revised the inventive step examination guidelines in April 2017, which came into force on 1 July 2107. According to the TIPO, this revision is to enhance patent examination quality and prevent examiners from arbitrarily combining prior art references as if they were pieces of a mosaic, which usually results in findings based on hindsight.

The new guidelines provide a general definition for "PHOSITA" (Person Having Ordinary Skill In The Art) while adding that, if required, the PHOSITA may include a group of persons having ordinary skill in the art. The guidelines are silent about whether patent examiners should specifically interpret a PHOSITA in their decisions.

The Supreme Administrative Court gave a clear answer in its judgments 2015-Pan-No. 326 and 2016-Pan-No. 503 that, before judging inventive step, the skill standards of a PHOSITA should be first determined based on the technical field of the disputed patent, the problems encountered by its prior art, the methods proposed to resolve these problems, the complexity of disclosed technologies, and the ordinary levels of practice, so as to form an objective baseline for determination, and the parties involved should be provided with an opportunity to elucidate their opinions.

With respect to the selection of prior art references cited to examine the inventive step, the new guidelines on the one hand recognize the admissibility of a prior art reference belonging to different or irrelevant technical fields while sharing some common technical features with the claimed invention, which seem to expand the scope of admissible prior art references; but on the other hand require that one "primary prior art reference" be chosen from all the prior art references for comparison with the claimed invention, and then the comparison result be employed as the basis of the inventive step analysis.

While the concept of "primary (or closest) prior art reference" was initially introduced to the guidelines, the IP Court, in its judgment 2016-Xing-Zhuan-Su-No. 13, already addressed the necessity of identifying a "closest prior art" for ascertaining the differences with the claimed invention, with a remark that no excessive efforts should be made to mechanically compare structural differences among various prior art references in order to negate their possible combinations.

The most crucial amendment to the guidelines is the redefinition of the test for determination of inventive step, which covers the following steps:

- Examiners must first review and decide whether there are "negative factors" that can negate the inventive step of the claimed invention.
- These negative factors include: (1) whether there is motivation to combine multiple prior art references; (2) whether the claimed invention is merely a simple modification of a single prior art reference; and (3) whether the claimed invention is a pure aggregation of multiple prior art references. If no such factors are found, the claimed invention must be deemed to have an inventive step.
- In case certain "negative factors" are actually found, examiners should review whether there are "positive factors" that can support the inventive step.

- The positive factors recited in the guidelines include: (1) whether the prior art teaches away from the claimed invention; (2) whether the claimed invention has advantageous efficacy compared to the prior art; and (3) whether there are secondary factors of inventive step, such as unexpected efficacy, resolving a long existing question, overcoming a prejudiced view of technology, or achieving commercial success.
- Based on the result of step 2, examiners must evaluate the negative and positive factors together, and if it is difficult to establish a rationale of lack of inventive step, the claimed invention must be held to have an inventive step, and vice-versa.

Before the revision of the guidelines, the Supreme Administrative Court had repeatedly emphasized the importance of determining the “motivation” to combine prior art reference, such as in its judgments 2015-Pan-No. 452 and 2014-Pan-No. 126. The court held that, in order to eliminate 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 arts, and avoid relying on the hindsight obtained from reading through the patent specification and thus arbitrarily reaching a conclusion of lacking inventive step.

Such principles have been incorporated into the new guidelines published by the TIPO.

By setting a higher standard and a more subtle process for establishing adequate reasoning for holding that a claimed invention lacks an inventive step, the amended guidelines are expected to improve the quality of patent examination in Taiwan.