

## **Intellectual Property, Taiwan**

### **Criteria for examining motivation to replicate invention of patent application**

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#### **Introduction**

It has always been a challenge to determine whether an invention patent specification has an inventive step when compared with the prior art. This is because only when no identical prior art is found will it be determined whether the patent has an inventive step.

During examination the invention must be compared with prior art references in order to determine whether any person having ordinary skill in the art at the time of filing is able to replicate the invention through simple modifications to prior art references. In a cancellation action, in order to demonstrate that a person having ordinary skill in the art can replicate a patented invention, the cancellation petitioner may cite several prior art references to support his or her argument.

#### **Criteria to determine motivation**

Recently, courts have requested that where combinations of two or more prior art references are brought against the inventive step of an invention patent, the cancellation petitioner must provide proof that the person having ordinary skill in the art is sufficiently motivated to combine the multiple prior art references. According to the Patent Examination Guidelines 2013, in order to determine whether a person having ordinary skill in the art would be motivated to do so, the following matters must be taken into consideration:

- Any connection between the prior art references and the invention in terms of their technical fields.
- Any connection between the prior art references and the invention in terms of the problem that must be solved by the invention.
- Any connection between the prior art references and the invention in terms of their functions or effects.
- Any knowledge relevant to the invention patent included in the prior art references.

The guidelines further state that the absence of any of the above does not necessarily mean that there is a lack of motivation to combine prior art references.

However, the guidelines do not discuss the eventuality that a person having ordinary skill in the art is motivated to combine multiple prior art references provided that one of the matters is satisfied by prior art references and the invention patent.

#### **IP Court opinion**

In May 2017 the IP Court gave its opinion on the specific criteria used to determine whether a person having ordinary skill in the art is motivated to combine prior art references in order to replicate an invention (2016-Xing-Zhuan-Su-Zi-65). The case involved a cancellation action followed by an administrative suit. The opposed patent related to the position of a motorcycle's rear seat pedals. The cancellation petitioner cited two prior art references and argued that any person having ordinary skill in the art could easily replicate the invention in question by combining them. Both prior art references concerned a motorcycle with rear seat pedals, but the positions were different from those specified in the claim of the target patent. Although the target patent related to the modification of common mechanical structures, the IP Court held that a person having ordinary skill in the art would not be sufficiently motivated to combine the cited references. A summary of the IP Court's opinion is as follows:

- Inventive step examinations should be evaluated by referring to the cited references and taking into account the technical content of the invention, together with its purpose and functions, to determine

whether the invention has acquired outstanding technical features or an obvious inventive step. It would violate the principles of an inventive step judgment to draw a conclusion, without careful review of the cited references, solely on the grounds of the patent specification that technical features of the tandem foot pedals in the invention can be easily recreated.

- The objective of the invention in question was for passengers to feel more comfortable when riding on the rear seat and resting their feet on the pedals. However, the purpose of the first prior art reference was to improve comfort for motorcycle riders and the purpose of the second was to prevent foot pedal struts from being too large. Therefore, the two prior art references differed from the invention in objective and function.
- Neither prior art reference included the positional features of the rear seat pedals specified in the invention in question.
- Further, the first prior art reference differed from the second in objective and function. A person having ordinary skill in the art would not be motivated to combine the two references solely on the basis of their content.

### **Comment**

It is difficult to avoid hindsight in determining whether an invention concerning modifications to common mechanical structures has an inventive step. The IP Court's method in reaching its opinion (ie, rigorously cross-comparing the technical content, objectives and functions of prior art references and the invention in question) is a useful model for this issue going forward.

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