

This article was published in the *International Law Office IP Newsletter* on February 24, 2020.

## **Intellectual Property, Taiwan**

### **International Patent Classification: one factor in determining whether motivation to combine multiple citations exists**

Contributed by Lee and Li Attorneys at Law

Article 120 of the Patent Act applies mutatis mutandis to Paragraph 2 of Article 22(2) of the act, which stipulates that a utility model patent application that can be easily accomplished by persons ordinarily skilled in the art in view of prior art will not be patented. According to the Patent Examination Guidelines, in order to determine whether the patent application can be easily accomplished by persons ordinarily skilled in the art in view of the citations, it is necessary to consider whether there is motivation to combine multiple citations. Further, such motivation depends on whether the multiple citations are relevant or common in their technical contents. In principle, factors such as technical fields, problems to be resolved, functions, effects, teachings or suggestions should be comprehensively considered.

In a Supreme Administrative Court judgment (478/2019), the appellant (plaintiff) claimed that the International Patent Classification (IPC) of Exhibits 2, 3 and 4 were A47B47/00, B65D5/00 and F16L55/11, respectively, and that, accordingly, they are in different technical fields. Further, the appellant claimed that they have different problems to be resolved and different functions or effects and that persons ordinarily skilled in the art would have no motivation to combine Exhibits 2, 3 and 4. Moreover, the appellant argued that Exhibits 2, 3 and 4 do not teach or suggest the technical features of the claimed inventions of the patent at issue, so it is hard to say that combining Exhibits 2, 3 and 4 is obvious.

The Supreme Court disagreed with the appellant and highlighted that the so-called 'technical field' is the specific technical field, which generally pertains to the basic classification of the IPC. However, even if the technical fields are different and under different IPC classes, in order to determine whether their technical contents are related, the court should comprehensively consider factors such as the articles to be applied, principles, mechanisms and effects. After considering such factors, if they are considered to be similar to each other, the citations will be deemed as having similar technical contents. In fact, the IPC classification of Exhibits 2 and 3 are A47B47/00 and B65D5/00, respectively, but their technical solutions are similar – thus, they have similar technical contents.

Therefore, the IPC classes can be used to determine the technical fields, but are merely one of the factors to be considered in determining whether there is motivation to combine multiple citations. The courts must still comprehensively consider other factors such as problems to be resolved, functions or effects (eg, articles to be applied, principles or mechanisms), teachings or suggestions. In this judgment, the court noticed that different IPC classes do not necessarily mean that there is no motivation to combine Exhibits 2 and 3. In contrast, after comprehensively considering the functions or effects of citations, as well as the IPC, the court ultimately still considered that persons ordinarily skilled in the art would have motivation to combine Exhibits 2 and 3.

---

*For further information on this topic please contact Michael Sun at Lee and Li Attorneys at Law by telephone (+886 2 2763 8000) or email (michaelsun@leeandli.com). The Lee and Li website can be accessed at [www.leeandli.com](http://www.leeandli.com).*