Latest Developments in Adjudication of IP Cases by Beijing Higher People's Court in 2013

(Abridged Part on Patent)

The IP Tribunal of the Beijing Higher People's Court

In 2013, the Beijing Higher People's Court received 1,624 IP cases of all types, representing an increase by 7.55% of last year. Of all these cases 2 were of first-instance cases and 1,622 of second-instance cases. Of all the 1,622 second-instance cases, 1,441 were administrative cases involving grant and affirmation of the IP rights, taking up 88.84% of all the cases accepted and representing an increase by 4.65% of last year; 181 cases were IP-related civil cases, accounting for 11.16% of all the cases accepted in the year, and representing an increase by 36.09% of last year. Of all the 1,441 administrative cases involving IP right grant and affirmation accepted in the year, 411 cases were administrative case involving patent grant and affirmation, amounting to 28.52% and representing an increase by 16.43% of last year; and 1,030 involving trademark grant and affirmation, amounting to 71.48% and representing an increase by 0.59% of last year.

In 2013, the Beijing Higher People's Court closed 1,609 IP cases of all types, representing an increase by 7.48% of last year. Of all these cases 2 were of first-instance cases and 1,607 of second-instance cases. Of all the closed 1,607 second-instance cases, 1,447 were administrative cases in-

volving grant and affirmation of the IP rights, taking up 90.04% of all the cases and representing an increase by 7.82% of last year; 160 cases were IP-related civil cases, accounting for 9.96% of the closed cases of the year and representing an increase by 3.23% of last year. Of all the 1,447 closed administrative cases involving IP right grant and affirmation in the year, 397 cases were administrative cases involving patent grant and affirmation, amounting to 27.44% and representing an increase by 4.75% of last year; and 1,050 cases involving trademark grant and affirmation, amounting to 72.56% and representing an increase by 9.03% of last year.

The article will present an overview of the latest developments and updates of the Beijing Higher People's Court in adjudication of IP cases in 2013.

I. Administrative cases involving grant and affirmation of patent rights

Determination of whether independent claim lacks essential technical feature

Whether a technical feature is an essential technical feature should be determined from in view of the technical problem to be solved with account taken of the whole contents of the description; we should not simply identify a technical feature in the embodiment as an essential technical feature of the patented technical solution.

In Qualcomm v. Patent Reexamination Board (PRD)[1], an administrative case of dispute over reexamination of rejection of an invention patent application, the involved application[2] (200710102646.0) is one for a patent for the invention of a method for improving the sensitivity of GPS receiver, and the applicant was Qualcomm. The State Intellectual Property Office (SIPO) made the decision on 10 September 2010 to have rejected the application on the ground that the amendments made to claims 1, 4, 7, 10, 13, 16, 19 and the description was contrary to Article 33 of the Patent Law. Qualcomm revised claim 1 during the reexamination as the following "1 A method for improving the sensitivity of GPS receiver, characterised in that it comprises these steps: a) receiving GPS signals from GPS satellites; b) receiving information to determine synchronization with the GPS time, wherein said information is received from non-GPS satellites; c) determining the boundary of a plurality of code periods; d) relating said GPS signals received from each of said code periods to pre-determined locally generated signals in said code periods, said received GPS signals are coded with special code related to a particular satellite, said locally generated signals are encoded with the pre-determined code related to said particular satellite; e) making integral coherence of relevant signals on said code periods; and f) if the relevant multiplied related signals are larger than the threshold value, then determining that signals are received from said particular satellite."

The PRB concluded that directed to the defects of long search time and required knowledge of mid-boundary signal received in the methods for improving sensitivity in the prior art, the present application developed a method and device for improving the sensitivity of GPS receiver. Said method first determined whether the receiver had a source symchronised with the GPS time, and in the presence of said source synchronized with the GPS time, sought the sum of signal power and determined whether the signals are received. In the absence of source synchronised with the GPS time, the method converted the time zone and frequency zone of the power of the code periods of GPS signals, and determined whether the power under any one frequency in the frequency zone was larger than the threshold value. Claim 1 of the application in suit claimed a method for improving the sensitivity of GPS receiver, comprising five steps: a) receiving GPS signals; b) receiving information to determine synchronization with the GPS time; c) determining the boundary of the code periods; d) relating GPS signals received from each of said code periods to pre-determined locally generated signals; e) making integral coherence of relevant signals on said code periods; and f) if the relevant multiplied signals are larger than the threshold value, then determining that signals are received from said particular satellite. Claim 1 did not mention the step for determining the presence of a source synchronized with the GPS time, nor define how to process signals in the absence of source synchronized with the GPS time. In the absence of the source synchronized with the GPS time, the technical solution of claim 1 could not improve the sensitivity of GPS receiver. In other words, the step to determine whether the receiver had the source synchronized with the GPS time and the method of signal processing in the absence of the source synchronized with the GPS time were essential technical features of the method for improving sensitivity of receiver of the application. Without said technical features, it was impossible to improve the sensitivity of the GPS receiver both in the presence of source synchronized with the GPS time and in the

absence of source synchronized with the GPS time. Accordingly, claim 1 of the application in suit lacked essential technical features. The first-instance court concluded that the PRB erred in construing the technical solution of the application in suit, and claim 1 of the application in suit did not lack essential technical features.

The second-instance court concluded that as was described in the part on the background of invention of the description of the application in suit showed, the problems of long search time and poor capture effect in the capture process of receivers existed in the prior art. It was stated in the part of summery of the invention of the description that "the present invention provides a method and device for improving the sensitivity of GPS receiver"; hence the technical problem the present invention was to solve was to improve the sensitivity of GPS receiver. As the summery of the invention of the description of the application in suit showed, the application in suit provided two solutions: one, in the presence of the source synchronised with the GPS time, sought the sum of power of signal and determined whether signal was received; two in the absence of the source synchronised with the GPS time, converted the time zone and frequency zone of the power of the code periods of GPS signals, and determined that the power under any one frequency in the frequency zone was larger than the threshold value. The two solutions were respectively directed to the presence and absence of the source synchronized with the GPS time, and both could improve the sensitivity of GPS receivers. The technical problem to be solved by the technical solution defined in claim 1 of the application in suit was that in the presence of the source synchronized with the GPS time, the problem of long search time and poor capture effect in the capture process of receivers was solved. That was, using the source synchronized with the GPS time on the several code periods to integrate coherence of relevant signals in a plurality of code periods to improve the sensitivity of GPS receiver; the described technical solutions could improve the sensitivity of GPS receivers, and there did not lack any essential technical features. Accordingly, the appellant ground of the PRB that claim 1 of the application lacked essential technical feature was not tenable.

It is possible to determine that amendment made by patentee to patented Markush claim by way of deletion with support of embodiment conforms to Rule 68, paragraph one, of the Implementing Regulations of the Patent Law as of 2001

Where a Markush claim relates to compounds, which are parallel and optional, each compound is an independent technical solution, and the claim outlines a set of several technical solutions, and each element is mutually substitutable to achieve the same effect. A patentee's deletion of a Markush element narrows down the scope of protection of his patent, but does not impair public interests; hence the patentee should be allowed to delete relevant optional element. But, given that the compounds covered in a Markush claim when it was patented are not all synthecised, the patentee is allowed to make amendment to the extent that the amended claim should not be a specific compound absent in the description. If a Markush claim is viewed as a whole technical solution and any deletion of any optional element of any variant is disallowed, it is difficult to pose a patentee's granted patent against any other person's invalidation request, and the so-called Markush claim will become meaningless. For that reason, in both patent grant examination and invalidation procedures, patent applicants or patentees should be allowed to delete any optional element of any variant, and the deletion is one of technical solution.

In PRB v. Bayer[3], an administrative case of dispute over invalidation of a patent right, Bayer was the owner of the patent (94115915.9) for the invention of 3-aryl-4-hydroxy-Δ^3-dihydrofuran derivatives, their preparation, pesticides containing them and uses thereof. In response to the request filed by the Jiangsu Sevencontinent Green Chemical Co., Ltd. for invalidation of its patent, Bayer deleted the Chinese word meaning "may" in "may choose any…" in the definition of a part of substituents and "may be" in the definition of "A and B" in the published text of claims 1-3. In its Invalidation Decision No. 16241, the PRB concluded that claims 1-3 were Markush claims expressed with a structure of general formula, having a plurality of substituents; each substituent had a plurality of options; the Markush claims were a whole technical solution formed by generalising the structure-effect relations based on the technical solution of specific embodiments. With the different options in the Markush claims being identical or different substituents, these options, viewed as a whole, were not parallel to one another, and it was impossible to form parallel technical solutions in the claims. Deletion of one or some options in one or some substituents in the Markush claims was not the deletion of the parallel technical solutions mentioned in the Guidelines for Patent Examination. For this reason, Bayer's amendment was not acceptable. The first-instance court concluded that it was obviously undue for the PRB to have determined that the Markush claims

were a whole technical solution formed by generalising the structure-effect relations based on the technical solution of specific embodiments. The law allowed a patentee to amend his claims, but the scope of protection of the patent in suit should not be broadened in the patent affirmation procedure. Bayer's deletion was one of one technical solution of the two parallel technical solutions, without broadening the scope of protection of the patent in suit. Accordingly, the first-instance court decided to have reversed the PRB's Invalidation Decision No. 16241.

The second-instance court concluded that if the optional elements in a Markush claim were similar in property, the claim might be viewed as having unit of invention as required, and put on a par, and draft them into a Markush claim. When Markush elements were compounds, mutual substitution of the Markush compounds produced the same effect, that was, the compounds were of one independent technical solution, the claim outlined a set of several technical solutions, and the elements were mutually substitutable to produce the same effect. A person skilled in the art could understand that "may choose any …" in the published text of the claims meant "choose" or "not choose", and "may be substituted by …" meant "be substituted" or "not be substituted", and "may be disconnected by oxide" meant "be disconnected by oxide…" or "not be disconnected by oxide". These expressions were commonly used when expressing the specific situation of substituents in the field. Bayer's deletion of the Chinese word meaning "may" in "may choose any…" in the definition of a part of substituents and "may be" in the definition of "A and B" in the published text of claims 1-3 was deletion of one of the two parallel technical solutions, without broadening the scope of protection of the patent in suit. Accordingly, it was obviously undue for the PRB not to have accepted the amended text.

When a technical solution similar in technical effect to any embodiment of Markush claim exists in the prior art, the patent does not possess inventiveness

When a Markush claim relates to compounds, said claim often covers thousands of specific compounds, and has a relatively large scope of protections and each specific compound covered should have unexpected use or effect compared with the specific compound similar in structure in the prior art. When it is involved assessment of inventiveness of Markush claims of varied scope, selection should be made within the scope of the Markush claims of varied scope to select the specific compound as similar as possible for comparison in terms of technical effect. So long as the embodiments covered in the Markush claims do not have unexpected use or effect compared with the technical effect of at least one specific compound, said Markush claim does not possess inventiveness.

In Beijing Winsunny Pharmaceutical Industry Co., Ltd. (Wansheng) v. PRB and Daichi Sankyo Company Limited (TYO)[4], an administrative case of dispute over invalidation of a patent right, Daichi Sankyo Company Limited was the owner of the patent for the invention of the method for making medicament compound for the treatment or prevention of high-blood pressure symptoms. Winsunny requested, on 23 April 2010, the PRB for invalidation of the patent. The PRB and the first-instance court both concluded that the compound formula 1 of evidence 1 covered a huge amount of compounds. Evidence 1 neither disclose the compound of structure 1 in claim 1 of the patent in suit, nor disclose the specific compound mentioned in Winsunny's request. Evidence 1 did not disclose, nor did Winsunny have evidence to prove, that alkyl of 4-positioned imidazole and alkoxy branched chain alkyl or hydroxyl in the compound formula 1 of evidence 1 were mutually substitutable, nor was it disclosed that they were identical or similar in function after alkyl of 4-positioned imidazole and alkoxy branched chain alkyl or hydroxyl might be mutually substitutable. Therefore it was necessary for a person skilled in the art to derive the technical solution of claim 1 based on what was disclosed in evidence 1 with undue burden, claim 1 was not obvious compared with evidence 1, and claim 1 possessed inventiveness.

The second-instance court concluded that selection was made of the compounds with experiment in the patent in suit, and determined that embodiments 10, 17, 19, 22-24, 50 and 69 were the specific embodiments. The court also compared them with data ID50 of embodiment 329 of evidence 1 which was structurally different in only one substituent. Only four embodiments had better effect than embodiment 329, and the other four had poorer effect. The findings of the comparison showed that the effect of one specific embodiment covered in the claim of the patent in suit was equivalent to the technical effect of embodiment 329 of evidence 1 in the prior art; hence claim 1 of the patent in suit did not have unexpected technical effect, and did not possess inventiveness.

Determination of whether an invention possess inventiveness should not be made in isolation from evaluation of inventiveness of each technical feature

Inventiveness of a patent should be assessed by following the overall and comprehensive principles. By the overall principle is meant that whether an invention possesses inventiveness should be assessed according to the whole technical solution defined in the claims, and whether each technical feature possesses inventiveness should not e assessed in isolatation. By the comprehensive principle is meant that whether an invention possesses inventiveness should be assessed with consideration taken of not only the technical solution *per se*, but also the technical problem the technical solution solves and the technical effect achieved and by treating it as a whole whether in direction to the technical solution in the prior art or to that of the invention.

In Xu Yaozhong v. PRB[5], an administrative case of dispute over reexamination of rejection of an invention patent application, Xu Yaozhong filed, with the SIPO on 16 August 2005, an application for a patent for the invention of a multi-resonance point linkage bass speaker. The examination department of the SIPO rejected the application in suit. The PRB and the first-instance court both concluded that the technical solution claimed in claimed 1 of the application in suit was obvious compared with reference 1 and the general knowledge known in the art, so the application in suit did not possess inventiveness.

The second-instance court concluded that claim 1 of the application in suit differed from the technical solution disclosed in reference 1 in that 1) a Helmholts resonance box was driven respectively on the front and back of the speaker's vibration cone, and 2 speakers altogether drove 3 or 4 Helmholts resonance boxes; and 2) the resonance points of the two component speakers were arranged in order from the low to high pitches. Said distinguishing features were to solve the technical problem: improving electric-acoustic conversion efficiency and improving the sound quality of the speaker. As the comprehensive understanding of the technical solution of reference 1 and that of claim 1 of the application in suit showed, the key of the technical solution of reference 1 lay in use of the technical means of rigid connection through the cone to achieve the technical effect of synchronic vibration of two cones and increased output power; the key technical means of claim 1 of the application in suit was to drive a resonance box respectively on the front and back of the cone to allow 2 cones to drive 3 or 4 resonance boxes, and arrange in order the resonance points of the two component speaker from the low to high pitches to achieve the technical effect of improving electric-acoustic conversion efficiency. Even if it was known that the resonance points of the two component speakers were orderly arranged from the low to high pitch, it worked together with the technical feature of driving a resonance box respectively on the front and back of the cone. One should not discuss it as to whether it was disclosed or not in isolation against the overall principle. Accordingly, the second-instance court reversed the former court decision and the PRB's administrative decision in suit.

When distinguishing technical feature of prior art and corresponding technical features of patented technical solution are used for different reasons and purposes, said distinguishing technical feature should not be found disclosed

While the technical solution of a reference uses a distinguishing technical feature, the reason and purpose for which said distinguishing technical feature was used in said technical solution are different from those for which the technical feature was used in a patent in suit, so are the technical problem to be solved and the technical effect to be achieved thereby, the distinguishing technical feature should not be found disclosed.

In Shanghai Kaisai Biotechnology Research and Development Centre Co., Ltd. (Kaisai) v. PRB and Shangdong Hilead Biotechnology Co., Ltd (Hilead)[6], an administrative case of dispute over invalidation of a patent right, Kaisai was the owner of the patent for the invention of a method for making positive long chain biatomic acid. On 7 June 2010, Hilead filed, with the PRB, a request for invalidation of the patent in suit. On 14 September 2010, Kaisai amended the claim. The technical features that distinguished the claimed technical solution in claim 1 of the patent in suit from evidence 1 were: (1) the substrate used in claim 1 of the patent in suit was paraffin or aliphatic or fatty acid, and that used in evidence 1 was paraffin, and that aliphatic acid could also be substrate was not mentioned; (2) claim 1 of the patent in suit specifically defined the pH value and temperature in the alkaline-adding and heating steps while evidence 1 only mentioned alkaline-addition and heating, without mentioning the specific values; (3) in the pre-treatment after alkaline-addition and heating and emulsion breaking, claimed 1 used the membrane filtration method while evidence 1 used filter pressing or centrifugal method; and (4) after the biatomic acid was obtained through acidation crysitalisation, the wiped film evaporation and short distance distillation refining were performed under certain vacuum and temperature condition in claim 1. The PRB and first-instance court both concluded that claim 1 of the patent in suit was contrary to Arti-

cle 22, paragraph three, of the Patent Law, and did possess inventiveness.

The second-instance court concluded that as for the above distinguishing technical feature (2), alkaline-addition and heating in the patent in suit were to increase the fermentation liquid mobility in the process of treatment to solve the problem of flux during membrane filtration while that in evidence 1 was to demulsify and stratify fermentation liquid during stationary state. Meanwhile the technical solution defined in claim 1 of the patent in suit did not include the emulsification and stratification steps. The patent in suit was directly to carry out membrane filtration of the original liquid of the long chain biatomic acid fermentation liquid while evidence 1 was to re-collect oil left in the upper layer after emulsification and stratification and eliminate bacterial cells and left-over oil in the patent in suit by plate pressing or centrifugal filter-grading, which showed that evidence 1 did not disclose the distinguishing technical feature. Whether distinguishing technical feature (3) was disclosed or not, first, the membrane filtration method of the patent in suit processed the emulsified original liquid of the long chain biatomic acid fermentation liquid after alkaline-addition and heating, and said original liquid of the long chain biatomic acid fermentation liquid had three ingredients of bacterial cells, paraffin and biatomic acid for the purpose to eliminate bacterial cells and left-over paraffin or fatty acid in the original liquid of the long chain biatomic acid fermentation liquid to obtain purified biatomic acid liquid. The membrane separation technology, including ultra-filtration and micro-filtration mentioned in evidence 18 only involved the general principle of membrane filtration; the counter evidence involved the principle of ultra-filtration and micro-filtration, and the material and the explanation of the property of the membrance filtration; and it did not mention that the membrane filtration could be applied to filtration of biatomic acid fermentation liquid. Second, evidence 1 and other prior art involved adding alkaline to and heating the original liquid of the long chain biatomic acid fermentation liquid and emulsification and stratification and eliminating left-over oil in the upper layer, and then filtering the bacterial cells layer in the lower layer, and did not filtrate intermediate clear liquid after static stratification. The patent in suit directly carried out membrane filtration of the original liquid of the long chain biatomic acid fermentation liquid after alkaline addition and heating. The filtration by centrifugal or filter pressing method in evidence 1 differed from the patent in suit in object of membrance filtration. Third, in evidence 1 use of the filter pressing or centrifugal method was to carry out membrane filtration of bacterial cells layer in the lowest layer to get rid of the left-over bacterial cells. In the patent in suit, membrane filtration of fermentation liquid was to stop paraffin and bacterial cells to allow biatomic acid to pass through. Therefore, the patent in suit differed from the prior art in the reason, purpose and object of the used membrane filtration; it should not be determined that the technical feature of membrane filtration of the patent in suit was disclosed, and the PRB and the first-instance court both erred in ascertaining the relevant facts.

Whether relevant theory is adequate or not in the description generally has no effect on the exploitability of patented technical solution

Whether the technical solution presented in the patent description conforms to Article 26, paragraph three, of the Patent Law should be determined according to whether a person skilled in the art can exploit the invention in line with the technical solution in the description, but not according to whether the explanation of the theory involved in the technical solution in the description is adequate or not. Even if the explanation is not adequate enough, it is possible to find the patented technical solution conforming to Article 26, paragraph three, of the Patent Law.

In Tsinghua University and Foxconn Refining Industry (Shenzhen) Co., Ltd. v. PRB[7], an administrative case of dispute over reexamination of rejection of a patent for invention, Tsinghua University and Foxconn Refining Industry (Shenzhen) Co., Ltd. were applicants for the patent for the invention of a carbon nanotube film structure and method for making the same. The independent claim 1 of the application in suit was: "1. A carbon nanotube film structure, comprising at least one carbon nanotube film structure, characterised in that said carbon nanotube film includes a plurality of super-long carbon nanotubes parallel to the surface of carbon nanotube film, and the super-long carbon nanotubes are parallel to one another." It was mentioned in the description of the application in suit that the prior art revealed a carbon nanotube film structure and method for making the same. Directed to the inadequacy of the prior art, this application provided a carbon nanotube film structure and method for making the same that did not contain catalyst, was arranged in order, could effectively apply the fine property of the carbon nanotube, and had self-support. In the application in suit, the super-long carbon nanotubes in the growth substrate floated above the receiving substrate with constant in-coming car-

bon gas. Said growth mechanism was known as kite-flying mechanism". The SIPO rejected the application in suit on the ground that said application was not sufficiently disclosed and was contrary to Article 26, paragraph three, of the Patent Law. Tsinghua University and Foxconn Refining Industry (Shenzhen) Co., Ltd. requested the PRB to reexamine the application, and submitted three appendixes as evidence to prove sufficient disclosure of the application in suit. Appendix 1 mentioned that some researchers had discovered that super-long carbon nanotubes did not all necessarily grow in the direction of the air current; some possibly growed opposite to the air current. It was necessary to carry on further experiment of the above "kite-flying mechanism". Appendix 3 stated that the single-arm super-long carbon nanotubes did not all necessarily grow in the direction of the air current and they might grow opposite to the air current. Tsinghua University and Foxconn Refining Industry (Shenzhen) Co., Ltd. clearly recognised that the "kite-flying mechanism" could not explain the experimental phenomenon that the carbon nanotubes grew opposite to the air current. The PRB concluded that the application in suit provided a carbon nanotube film structure and method for making the same and used the "kite-flying mechanism", but no established conclusion was made in the prior art on the growth mechanism of carbon nanotubes in air current, and carbon nanotubes did not necessarily grow in the direction of the air current; hence the "kite-flying mechanism" required to be proved with experimental findings. Besides, given that said growth mechanism was uncertain, the structure of the carbon nanotube film structure made this way also required experimental findings to prove that it had have such structure. The description of the application in suit failed to provide the specific theoretic basis and relevant experiment data to prove that it was possible to realise the stated carbon nanotube film structure. A person skilled in the art could not exploit the invention according to his own general technical knowledge and the description of the application in suit. The application in suit was contrary to Article 26, paragraph three, of the Patent Law, and the first-instance court maintained the PRB's decision in suit.

The second-instance court concluded that as the background technology of the description of the application in suit and appendixes 1 and 3 showed, making carbon nanotube film was not a brand new technology, and its prior art or experiment facts were available for reference. The technical solution of the application was developed on the basis of the experiment of growth of carbon nanotube film in the direction of carbon resource air current, not on the basis of the growth mechanism explaining the experiment facts. The application in suit relied on the experiment facts that it was certain that some carbon nanotube grew in the direction of air current. While the "kite-flying mechanism" could not explain the experimental phenomenon that the carbon nanotubes grew opposite to the air current, that some carbon nanotubes grew opposite to the air current was not the matter that the application in suit could not realise, and it was a one of efficiency of manufacture of the technical solution. A person skilled in the art could exploit the invention according to his own general technical knowledge and the description of the application in suit, without necessarily relying on experimental data. The second-instance court reversed the former court ruling and the PRB's decision in suit.

II. Patent administrative lawsuit and burden of proof

The PRB's own change of technology for comparison should be in line with the oral-hearing rules

By the request principle in the patent invalidation examination is meant that the patent invalidation procedure should be initiated at the request of an interested party, and the examination should normally be conducted of the scope of the invalidation request filed by an interested party and the ground and evidence produced with the request. Before making an examination decision, the PRB should give an interested party to whom an examination decision is not made in his or its favour a chance to express his opinions on the ground and evidence on the basis of which the decision was made, and the facts ascertained therein. Especially when the PRB compares technical information that is not claimed by an interested party for assessing inventiveness, but introduces some technical information for such comparison on its own initiative, it must give both interested parties a chance to fully express their opinions.

In Li Yi v. PRB and Zhuhai Print-Rite Printer Consumables Co. Ltd. (Print-Rite)[8], an administrative case of dispute over invalidation a utility model patent, the patent in suit was the patent (200520008160.7) for the utility model of composite ink feeding bottle, and the patentee was the Print-Rite. On 17 November 2010, Li Yi requested the PRB to declare the patent in suit invalid on the ground that claims 1-5 did not possess inventiveness. Li Yi argued that technical feature (f)

of claim 1 of the patent in suit was: on the first and second sides of the principal bottle was deposed a retaining mechanism to stop it from disconnecting after it was connected with an adjacent bottle with the connecting mechanism. Evidence 1 disclosed that it was possible to change as one wished the size and number of the protrusion part and the concave part working with it to keep it effective, and also disclosed use of tight snap coordination. In evidence 1, when the tight snap was used in coordination between the two ink storage containers 36, the connection structure *per se* functioned to stop disconnection of the connecting part, that is, said connecting mechanism was also such mechanism deposed on the first and second sides of the principal bottle; hence evidence 1 disclosed the technical feature. The PRB concluded, upon examination, that combination of the available evidence was insufficient to deny the inventiveness of claim 1 of the patent in suit, and correspondingly insufficient to deny the inventiveness of dependent claims 2-5; hence the patent in was kept valid. The first-instance court concluded that the PRB acted in violation of the principles concerning request and oral hearing, and the PRB should have reevaluated the technical feature (f) of claim 1 of the patent in suit according to the tight snap method coordination disclosed in evidence 1 as claimed by Li Yi; hence the first-instance court reversed the PRB's decision in suit, and ordered it to make another reexamination decision.

The second-instance court concluded that when commenting on technical feature(f) of claim 1 of the patent in suit, Li Yi used the technical information of the method of snap coordination disclosed in evidence 1, but the PRB did not mentioned it when evaluating technical feature (f) in claim 1 of the patent in suit in Decision No. 16777. Instead, the PRB used the technical content of micro-convex and concave parts disclosed in evidence 1 to have assessed the novelty and inventiveness of claim 1, and concluded that claim 1 had novelty and inventiveness compared with evidence 1 unfavourable to Li Yi, and did not give him a chance to express his opinions. It was not undue for the trial court to have determined that the PRB made decision No. 16777 in violation of the request and oral-hearing principles.

PRB's substantial change of the contents of examination decision in suit in judicial procedure is procedurally undue

Reviewing the legality of a specific administrative action, the people's court should review the legality of the subject matter and procedure of the specific administrative action. To protect the lawful rights and interests of an administrative respondent, the administrative authority should perform its specific administrative action as requested by an administrative respondent to ensure that the administrative respondent is clear about the contents of the administrative action, and make the subject matter the people's court reviews certain. If the administrative authority changes its action as it wishes, and makes it impossible for the administrative respondent to know clearly about the specific administrative action in suit, it would naturally affect the latter's lawful rights and interests; and make the subject matter unclear when the people's court reviews the legality of the subject matter. For this reason, the administrative authority should make it specific administrative action clear, and inform the administrative respondent thereof. The PRB's change of specific administrative action in judicial procedure will make it impossible for the People's Court to determine the scope of its review, and may constitute undue procedure.

In Starlinger & Co. Gmbh (Starlinger) v. PRB and Changzhou City Hengcheng Plastic Machinery Co., Ltd. (Hengcheng)[9], an administrative case of dispute over invalidation of an invention patent, Starlinger was the owner of the patent for the invention of bag made of polymer and particularly polyolefine fabric and process for producing it. On 30 March 2011, Hengcheng requested the PRB to declare the patent in suit invalid. On 11 November 2011, the PRB issued the Decision No. 17530 to Starlinger and Hengcheng, declaring the whole patent in suit invalid for lack of sufficient disclosure in the description of the patent in suit. Dissatisfied with the Decision, Starlinger brought an administrative suit. The PRB produced to the first-instance court an Explanation of Facts, stating that an error of lack of correspondence between the number of the claim and comments thereof in Decision No. 17530 as of 11 November 2011, and issued, on 12 September 2012, an Notification on Rectification to the interested parties attached with the fully numbered items in the Invalidation Request Examination Decision No. 17530, making it clear that the administrative respondent might sue in the people's court within 3 months from receipt of the Notification. The first-instance court reviewed the Invalidation Decision made by the PRB on 12 September 2012, and kept it valid.

The second-instance court concluded that the PRB issued, on 11 November 2011, the Decision No. 17530 to Starlinger and Hengcheng, and issued the Notification on Rectification, on 12 September 2012, on the ground that an error rested with the comments in the former decision in the

first instance court procedure, with the full invalidation request examination decision attached, and clearly indicated to the administrative respondent that the relief of bringing a suit is available to it. The first-instance court reviewed a different specific administrative action, and reviewed the legality of the invalidation decision made on 12 September 2012. The Guidelines for Patent Examination were the SIPO's regulations, and the PRB should regulate its specific administrative action according to the specific provision of the Guidelines for Patent Examination in hearing patent grant and affirmation cases. It was provided in Section 7.3, Chapter 1 of Part IV of the Guidelines for Examination as of 2006 that Where it is found that there exists, any obvious clerical error in an examination decision on requests for reexamination or invalidation and the error needs to be corrected, correction shall be made subject to the approval of the Director or one of the Deputy Directors, and the party concerned shall be notified by a notification attached with the substitution sheets. According to the ascertained facts in the case, the PRB's action was not in conformity with the normal form of rectification in an invalidation request examination decision. In an invalidation case examination, the PRB failed to change the form of documents produced under the Guidelines for Examination, it was a change of a specific administrative action, which made it impossible for the administrative respondent to identify the invalidation decision in suit and for the People's Court to determine the scope of its review. According to the ascertained facts in the case, the PRB's action was not in a normal form of rectification in an invalidation request examination decision. In the invalidation examination, the PRB failed to change the form of documents produced under the Guidelines for Patent Examination, it was a change of an specific administrative action; which made it impossible for the administrative respondent to identify the invalidation decision in suit and for the People's Court to determine the scope of its review when examining the legality of a specific administrative action. The PRB's said specific administrative action was procedurally undue, and impaired the lawful rights and interests of the administrative respondent. The PRB's failure to make change in its specific administrative action under the relevant provisions should be rectified to enable the people's court to review the legality of the specific administrative action at the request of an interested party after the PRB made the specific administrative action. Therefore, PRB's failure to make change in the specific administrative action under the relevant provision of the Guidelines for Patent Examination was contrary to the basic rules and regulations governing its operation, confusing the procedure where an interested party makes claim of the legality of a specific administrative action and making it impossible for the people's court to determine the specific administrative action in its review of relevant cases. It was an procedurally undue. Accordingly, the second-instance court ruled to have reversed the former court judgment and the PRB's decision in suit and ordered the PRB to make another invalidation decision. ■

Written by Liu Xiaojun, and proofread by Chen Jinchuan

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[1] See the Beijing Higher People's Court's Administrative Judgment No. Gaoxingzhongzi 1968/2013. (The Judges of the Panel were Liu Xiaojun, Yuan Xiangjun, Ma Jun and the handling Judge was Liu Xiaojun).

[2] For convenience, all the patent applications reviewed in the administrative lawsuits involving patent grant and/or affirmation are referred to as the applications in suit, and the patents reviewed are referred to as the patents in suit.

[3] See the Beijing Higher People's Court's Administrative Judgment No. Gaoxingzhongzi 2046/2013. (The Judges of the Panel were Cen Hongyu, Liu Qinghui, Jiao Yan and the handling Judge was Jia Yan).

[4] See the Beijing Higher People's Court's Administrative Judgment No. Gaoxingzhongzi 833/2012. (The Judges of the Panel were Qin Hongyu, Liu Qinghui, Jia Yan and the handling Judge was Jia Yan).

[5] See the Beijing Higher People's Court's Administrative Judgment No. Gaoxingzhongzi 1258/2013. (The Judges of the Panel were Liu Hui, Shi Bisheng and Tao Jun and the handling Judge was Shi Bisheng).

[6] See the Beijing Higher People's Court's Administrative Judgment No. Gaoxingzhongzi 1203/2012 rendered on 16 July 2013. (The Judges of the Panel were Liu Hui, Shi Bisheng and Tao Jun and the handling Judge was Shi Bisheng).

[7] See the Beijing Higher People's Court's Administrative Judgment No. Gaoxingzhongzi 1621/2013. (The Judges of the Panel were Liu Xiaojun, Yuan Xiangjun and Ma Jun and the handling Judge was Yuan Xiangjun.

[8] See the Beijing Higher People's Court's Administrative Judgment No. Gaoxingzhongzi 1834/2012. (The Judges of the Panel were Liu Xiaojun, Yuan Xiangjun and Ma Jun and the handling Judge was Liu Xiaojun).

[9] See the Beijing Higher People's Court's Administrative Judgment No. Gaoxingzhongzi 29/2013. (The Judges of the Panel were Liu Hui, Shi Bisheng and Tao Jun and the handling Judge was Tao Jun).