

Latest Developments in Adjudication of IP Cases by Beijing High People's Court in 2016

(Abridged Part on Patent)

The IP Tribunal of the Beijing High People's Court

In the year of 2016, the Beijing High people's Court accepted 3,847 IP cases (inclusive of 528 old files) of all types, representing a 30.41% year-over-year increase, of which there were 5 first-instance cases, 3,793 second-instance cases, 45 appeals and 4 retrials. Of all the newly accepted 3,319 cases, administrative cases involving grant and affirmation of IP rights amounted to 3,187, accounting for 96.02% of all the newly accepted cases while IP-related civil cases amounted to 132, accounting for 3.98%. Of all the 3,187 administrative cases involving grant and affirmation of IP rights accepted in 2016, administrative cases involving patent grant and affirmation amounted to 245, taking up 7.69%, while administrative cases involving trademark grant and affirmation amounted to 2,942, taking up 92.31%.

In the year of 2016, the Beijing High People's Court concluded 3,168 IP cases of all types, representing a 30.80% year-over-year increase, of which there were 3 first-instance cases, 3,123 second-instance cases, 38 appeals and 4 retrials. Of all the concluded cases, administrative cases involving grant and affirmation of IP rights amounted to 3,044, accounting for 96.09% of all the concluded cases, while IP-related civil cases amounted to 124, taking up 3.91% of all the concluded cases. Of all the 3,044 administrative cases involving grant and affirmation of IP rights concluded in 2016, administrative cases involving patent grant and affirmation amounted to 203, making up 6.67%, while administrative cases involving trademark grant and affirmation amounted to 2,841, making up 93.33%.

The cases tried at the Beijing High people's Court in 2016 can be characterized as follows: first, all types of cases have been covered, among which complicated and intri-

cate cases take a major portion. For instance, an administrative dispute over invalidation of a patent for invention entitled "nucleotide analog composition or salt and synthesis method thereof", which involves Markush claims, was concluded after trial. Second, more and more cases have aroused concerns and attention from the public, such as an administrative case involving opposition and review of Tencent's trademark "微信(WeChat)" and an appeal concerning copyright dispute related to "红色娘子军" (Red Detachment of Women). Third, the number of cases sharply rises with a 30.41% year-over-year increase. Fourth, administrative cases involving grant and affirmation of IP rights are still in a dominant position, wherein the vast majority thereof is administrative cases involving trademark grant and affirmation. And fifth, the manpower for trials is replenished, but they are still under a heavy burden. Judges concluded 150.9 cases *per capita* in 2016, wherein 19 judges concluded more than 100 cases.

This article will present an overview of the latest developments and updates of the Beijing High people's Court in adjudication of IP cases in 2016.

Administrative Patent-related Cases

1. The meaning of a technical term in the claim shall be determined according to the ordinary and customary meaning thereof in the said art if the description fails to provide a clear explanation.

In the patent grant procedure, a technical term in the claim shall be construed under the principle that internal evidence, such as claims, description and drawings, shall be superior to external evidence, such as textbooks and tech-

nological dictionaries in the said art. Where the term in the claim has an ordinary and customary meaning in the art and is specifically defined in the description, if the specific definition is clear enough for those skilled in the art to understand, the meaning of the term shall be determined according to such specific definition in the description; and whereas there is no specific definition in the description or the specific definition is not so clear that those skilled in the art are unable to understand the meaning of the specific definition, the meaning of the term shall be determined according to the ordinary and customary meaning of the term in the said art.

In the *Patent Re-examination Board (PRB) of the State Intellectual Property Office (SIPO) v. E.I. du Pont de Nemours and Company (DuPont Company)*¹, namely an administrative dispute over rejection of a patent application for invention, the patent in suit (No.200680040913.X) is an invention entitled “azeotrope compositions comprising e-1, 3,3,3-tetrafluoropropene and hydrogen fluoride and uses thereof” and filed by DuPont Company. The original examining section of the SIPO rejected the application on the grounds that the present application possessed no inventive step. The PRB sustained the Decision on Rejection after examination. The first-instance court held that claim 1 of the patent in suit reads “An azeotrope or near-azeotrope composition comprising from about 62.4 mole percent to about 89.4 mole percent E-HFC-1234ze and hydrogen fluoride……”, based on which, it can be seen that claim 1 fails to delimit the technical feature that E-HFC-1234ze is predominant. As clearly stated in the description of the patent in suit, “E-HFC-1234ze as used herein refers to a mixture of the isomers, E-HFC-1234ze …… or Z-HFC-1234ze ……”, wherein the predominant isomer is E-HFC-1234ze” and “as used herein, predominant isomer is intended to mean that isomer which is present in the composition at a concentration of greater than 50 mole percent”. It can be seen that the description of the patent in suit definitely recites that E-HFC-1234ze according to claim 1 is a mixture of the isomers, E-HFC-1234ze or Z-HFC-1234ze, wherein the predominant isomer is E-HFC-1234ze. Under such circumstances, the content of claim 1 shall be construed on the basis of the specific definition in the description, rather than literal depiction of claim 1, under the principle that the effect of internal evidence is superior to that of external evidence, that is, it shall be determined that E-HFC-1234ze in claim 1 refers to a mixture of the isomers, E-HFC-1234ze or Z-HFC-

1234ze, wherein the predominant isomer is E-HFC-1234ze. In contrast, reference document 1 (D1) simply discloses in the preparation method that 1233zd is reacted with HF to generate HFC-1234ze without indicating the proportion of E-HFC-1234ze in HFC-1234ze. By reason of the foregoing, claim 1 differs from D1 in that E-HFC-1234ze is predominant in a mixture of the isomers, E-HFC-1234ze or Z-HFC-1234ze. And such a distinguishing feature is missing in the Decision on Rejection. Based on that, the first-instance court decided to revoke that Decision.

The second-instance court was of the view that the issue of the said dispute lies in how to construe the term “E-HFC-1234ze” in claim 1 of the patent in suit. That term is given an ordinary and customary meaning in the art, i.e., a single isomer of 1,3,3,3-tetrafluoropropene in which the double bond is an E-type configuration. When seeing the name of the chemical compound, those skilled in the art can definitely determine the molecular formula and structure of the chemical substance under that name. Nevertheless, the description of the patent in suit also specifically defines that term as “E-HFC-1234ze as used herein refers to a mixture of the isomers, E-HFC-1234ze (CAS reg. no. 29118-24-9) or Z-HFC-1234ze (CAS reg. no. 29118-25-0), wherein the predominant isomer is E-HFC-1234ze”. Semantically speaking, the meaning of the expression that “E-HFC-1234ze … refers to a mixture of the isomers, E-HFC-1234ze … or Z-HFC-1234ze …”, wherein the predominant isomer is E-HFC-1234ze” is not clear enough for those skilled in the art to comprehend. DuPont Company argued in the second instance that the word “or” in the above sentence shall be understood as “and”, which means that the meaning of the said expression should be “E-HFC-1234ze … refers to a mixture of the isomers, E-HFC-1234ze … and Z-HFC-1234ze …”, wherein the predominant isomer is E-HFC-1234ze”. Such understanding, however, is in contradiction with the meaning of that term in other parts of the description, and is not reasonable throughout the full description. In the context of the description comprehensively, the meaning of the term in Claim 1, “E-HFC-1234ze” specifically defined in the description is not clear enough for those skilled in the art to determine the meaning of the specific definition. In such circumstances, when internal evidence is not sufficient enough to determine the meaning of the claim, the external evidence shall be used. In view that the said term has an ordinary and customary meaning in the art, the term shall be given its ordinary and customary

meaning, i.e., a single isomer of 1,3,3,3-tetrafluoropropene in which the double bond is an E-type configuration. The second-instance court therefore ruled to revoke the first-instance judgment and dismiss the claim of the lawsuit filed by DuPont Company.

2. Where the meaning of the term in the claim cannot be determined according to the description, prior art and common knowledge in the art, the claim involved shall be deemed as unclear in terms of its protection scope.

The protection scope of a patent is defined and limited by the claims. Where the meaning of the word in a claim is ambiguous, which, furthermore, still cannot be determined by taking the description, common knowledge in the art and relevant prior art into consideration, the protection scope of the claims shall be deemed unclear.

In *Bo Wanqing v. the PRB, Jining Weikai Maternal and Children Products Co., Ltd. (Weikai Co.), Shanghai Anti-electromagnetic Radiation Association (Anti-Radiation Association) and Shanghai Tianji Textile Technology Co., Ltd. (Tianji Co.)*², namely an administrative dispute over invalidation of a utility model patent, the patent in suit (No.200420091540.7) is a utility model entitled “anti-electromagnetic clothes” and owned by Bo Wanqing, which was filed on 8 May, 2002 and issued on 20 December, 2006. The claim of the patent in suit reads “anti-electromagnetic pollution clothes, comprising a coat and trousers, characterized in that the clothes is provided therein with metallic wires having high magnetic permeability and no remanence or a metallic net or membrane made of metallic powders for the sake of shielding”. Weikai Co., Anti-Radiation Association and Tianji Co. respectively filed a request for invalidation of the patent in suit with the PRB. The PRB declared the patent in suit invalid in the Decision on the grounds that the technical term “high magnetic permeability” in claim 1 of the patent in suit is unclear in meaning, which, thereby, renders the protection scope of claim 1 ambiguous. The first-instance court sustained the PRB’s Decision.

The second-instance court concluded that it is hard for those skilled in the art to determine the specific scope or meaning of the technical feature “high magnetic permeability” in claim 1 according to the description of the patent in suit and the evidence submitted by Bo Wanqing, so the protection scope of claim 1 of the patent in suit cannot be accurately determined. Bo Wanqing failed to furnish relevant evidence in support of the fact that in the field to which the pat-

ent in suit belongs, those skilled in the art have a relatively uniform understanding in regard to the meaning or scope of the technical feature “high magnetic permeability”. Thus, the protection scope of claim 1 of the patent in suit is unclear and not in compliance with the provision of Rule 20.1 of the Implementing Regulations of the Patent Law.

3. The literal portion beyond the drawings of a prior design generally shall not be incorporated as the contents disclosed in the drawings when comparing the contents disclosed in drawings of a prior design with those of the granted design.

A granted patent for design shall usually be compared with a prior design by taking ordinary consumers as judging subjects and in a manner of “overall observation and comprehensive judgment”. The protection scope of a granted patent for design shall be limited to the scope disclosed in the drawings or photographs. When examining whether the drawings of a utility model are obviously different from the granted design, the same requirement for protection scope shall be followed, whereas the literal portion of the description of the patent for utility model shall not be used to interpret the drawings.

In *Zhejiang Zhongheng Lock Co., Ltd. (Zhongheng Lock Co.) v. the PRB and ASSA ABLOY Baodean Security Products Co., Ltd.*, an administrative dispute over invalidation of a design patent³, the patent in suit (No. 200830245821.7) is a patent for design (hereinafter referred to as the said patent) entitled “anti-theft lock (double arc)”, which was filed on 30 October, 2008 and issued on 14 October, 2009. Zhongheng Lock Co. filed a request for invalidation of the said patent with the PRB on 13 December, 2013. The PRB sustained the said patent valid. The first-instance court held that the PRB erred in finding that the said patent does not violate the provision of Article 23 of the Patent Law and then revoked the PRB’s Decision and ordered the PRB to make a new decision.

The second-instance court held that a reference is the drawings of the description of a patent for utility model, in which a structure with an inclined tongue has not been demonstrated. It is groundless for the first-instance court to conclude that there is a handle hole illustrated in the drawings, and those skilled in the art can know, based on the knowledge they comprehend, that the corresponding inclined tongue is implicitly disclosed and that since the shape of the inclined tongue is a conventional design, it therefore has no impact on the entire visual effect. Meanwhile, the first

-instance court was also erroneous in making a judgment by introducing the concept of those skilled in the art. The subjects for judging the similarity of design shall be ordinary consumers. Even though ordinary consumers are capable of realizing that the handle hole certainly has an inclined tongue, the reference design does not disclose the specific shape of the inclined tongue. The so-called conventional design refers to the corresponding design in the prior design, which is so well-known to ordinary consumers that it can occur to them once the name of the product is mentioned. Even though some design feature is disclosed in several prior designs, it is not sufficient enough to prove that the said design feature is well-known to ordinary consumers that once the name of the product is mentioned, the corresponding design will be recalled, simply based on the aforesaid several prior designs. By reason of the foregoing, it can, in no way, be determined that the reference design implicitly discloses the design of the inclined tongue. The said patent is not a design similar to the reference design and does not violate the provision of Article 23 of the Patent Law.

4. The contents derived from the drawings of a reference document, if lacking of other explicit recitation, shall usually not be directly used as the disclosed technical features for evaluating the novelty of a patent for invention.

Generally speaking, the technical contents cited from a reference document, unless explicitly recited in words or implicitly disclosed, may also be directly and undoubtedly determined from the drawings, if there is any. However, if the technical contents cited from a reference document are neither literally recited nor be directly determined from the drawings, the contents derived merely from the drawings cannot be directly used as the disclosed technical features for evaluating the novelty of a granted patent.

In *3M Innovative Properties Company v. the PRB*, an administrative dispute over re-examination of rejection of a patent application for invention⁴, the said application (No.200880013375.4) is an application of patent for invention entitled "Maintenance-free Anti-fog Respirator" filed by 3M Innovative Properties Company on 26 March, 2008 with a priority dated 3 May, 2007. The PRB decided to sustain the SIPO's Decision on Rejection made on 1 March, 2012 on the grounds that claims 1, 8 to 10, 12, 13 and 15 of the said application lack novelty under Article 22.2 of the Patent Law, and claims 2 to 7, 11 and 14 lack inventive step under Article 22.3 of the Patent Law. The first-instance court was

of the view that the area 12 in D1 corresponds to the sinus region of the said application in terms of position. In D1, the area 12 is provided with a plurality of longitudinally extending ribs by way of ultrasonic welding. Similar to the principle of the said application, the air cannot pass through the area having those ribs. Compared with the area having no ribs, the area with ribs has less area for air circulation, and thereby sees a greatly increased pressure drop. Thus, a further effect achieved by D1 is that the support of ribs enlarges the entire space of the mask. And the existence of the ribs will certainly increase the pressure drop in the area. Thus, the first-instance court sustained the PRB's Decision.

The second-instance court held that the technical solution of claim 1 of the said patent is mainly used to solve the problem of the significantly increased pressure drop across the entire sinus region, whereas D1 mainly solves the problem of easy collapse of the surface area in the upper portion. Claim 1 of the said application defines an alteration to an intrinsic structure without specifying the means to make such an alteration, and claim 2 thereof defines the manner of spot welds. In contrast, D2 solves the problem of recess of the mask due to increase in a filtration area by means of adding more ribs. The expected technical effect of the said application is to make the air penetrate through a filtration region, rather than a sinus region (in which a pressure drop increases, namely, the air penetration resistance increases) as much as possible, but the expected technical effect of D1 is to increase a surface area and decrease the overall respiratory resistance. The said application is dissimilar to D1 in terms of the technical problem to be solved, the technical solution and the expected technical effect. The first-instance court and the Decision being sued were erroneous in presumptively deciding that "the alteration to the intrinsic change will certainly significantly increase the pressure drop across the upper portion" according to the drawings of D1, without understanding the translated contents of the technical solution comprehensively. Claim 1 of the said application over D1 possesses novelty under Article 22.2 of the Patent Law. The PRB shall make a new decision on whether the said application should be rejected on the basis of a re-determination on whether claim 1 of the said application possesses novelty.

5. Such an amendment made by deleting the end values of a numerical range with no new technical solution formed is acceptable.

In invalidation proceedings, if the end values of a nu-

merical range, which fall within the numerical range of the document as originally filed, are deleted from a claim, such deletion is deemed as deletion of a technical solution from a claim, which neither extends beyond the scope of disclosure contained in the original description and claims, nor adds a new technical feature to a valid claim. Such amendment does not form a new technical solution.

In *Shantou Special Economic Zone Chaoyi Screw Industry Co., Ltd. (Chaoyi Co.) v. the PRB and Cai Chunyao*, an administrative dispute over invalidation of a utility model patent⁵, the patent in suit (No.200920075414.5) is a patent for utility model (hereinafter referred to as the said patent) entitled “Fast Self-tapping Lock Screw for Sheet Metal” filed by the patentee, Chaoyi Co., on 28 July, 2009 and issued on 12 May, 2010. On 17 March, 2014, Cai Chunyao filed a request for invalidation of the said patent with the PRB. Chaoyi Co. submitted the observations and amended the claims. The PRB was of the view that as for a claim drafted in a numerical range format, the numerical range shall be regarded as an entire technical solution. If the numerical range is changed even by narrowing it down, a new technical solution may be formed as a result of such a change, and the new solution cannot be unambiguously derived from the documents as originally filed by those skilled in the art. Consequently, the PRB decided to declare the patent wholly invalid. The first-instance court ruled to revoke the PRB’s decision, holding that deletion of the end values of the numerical range is not in violation of relevant provisions, and does not form a new technical solution.

The second-instance court stated that both the claims and description of the said patent explicitly recite the technical feature that “the screw body has a flat point with an angle of $35^{\circ} \pm 5^{\circ}$ ”, which indicates that the angle includes the value of “ 40° ”. In comparison with the claims and description of the said patent which are sustained valid, claim 3 of the said patent amended by Chaoyi Co. does not include the end value “ 40° ”, and the amended range still falls within the numerical range of the documents as originally filed, which neither broadens the original protection scope, nor forms a new technical solution. Chaoyi Co. amended claim 3 of the said patent as “the screw body has a flat point with an angle of greater than or equal to 30° and less than 40° ”, which belongs to deletion of a technical solution, i.e., deletion of the technical solution that “the screw body has a flat point with an angle of 40° ” as is included in the original claim. The amendment neither extends beyond the scope

of disclosure contained in the original description and claims, nor adds any new technical feature that is not included in the claims which are sustained valid. As a result, the amendment made by Chaoyi Co. does not violate the relevant provisions of the Implementing Regulations of the China’s Patent Law and the Guidelines for Patent Examination. Although claim 3 was originally drafted as “the screw body has a flat point with an angle of $35^{\circ} \pm 5^{\circ}$ ” and then amended as “the screw body has a flat point with an angle of greater than or equal to 30° and less than 40° ”, the two drafting manners both indicate a respective numerical range, which makes no substantial difference. The claim asserted by Cai Chunyao that such amendment does not comply with relevant provisions shall not be supported.

6. The amendment to claims shall not cause substantial changes to the contents of a technical solution.

The protection scope of claims shall be delimited by all the contents recited in the claims as a whole. Thus, judgment on whether amendments made by a patentee to a claim meet the requirement shall be made based on comprehensive consideration of the entire technical solution. Examination on whether amendments to a claim are legitimate or not shall be made based not only on the protection scope of the claim, but also the legislative objective of the China’s Patent Law, with a focus on whether there is any change to the essential content of the claimed technical solution. If the protection scope of the amended technical solution is narrowed down with substantial changes caused to the contents of the technical solution, such an amended technical solution shall be deemed as a new technical solution different from that of the original one.

In *Telefonaktiebolaget LM Ericsson (Ericsson) v. the PRB and Huawei Technologies Co., Ltd.*, an administrative dispute over invalidation of an invention patent⁶, the patent in suit is a PCT invention entitled “Method for Improving Handoffs in Cellular Mobile Radio Systems” owned by Ericsson. The technical solutions of claims 1, 4 and 5 of the said patent all define the measurement of signal strength and direction of arrival parameters from an uplink signal transmitted by a mobile terminal to a serving radio base station “in at least one candidate target base station”. Take claim 1 for example, which specifies “a method for performing an inter-cell handoff in a mobile communications system, comprising the steps of: measuring in at least one candidate target base station signal strength and direction of arrival parameters from an uplink signal transmitted by a

mobile terminal to a serving radio base station; reporting said measured signal strength and direction of arrival parameters to a network controller; said network controller determining whether to perform the inter-cell handoff and selecting a target base station from at least two candidate target base stations responsive to the measured signal strength and the direction of arrival parameters, said two candidate target base stations including said at least one candidate target base station using said measured parameters; and ordering said selected target base station to complete said handoff of said mobile terminal.” In the invalidation proceedings, Ericsson amended “at least one candidate target base station” in claims 1, 4 and 5 to “at least two candidate target base stations”. Neither the PRB nor the first-instance court accepted such an amendment to the claims made by Ericsson. Ericsson filed an appeal as being unsatisfied with the decision.

The second-instance court held that literally speaking, such an amendment decreases the number of candidate target base stations in the technical solution. It seemed that the protection scope of the original patent, rather than be broadened, was narrowed down instead. The technical solutions defined in claims 1, 4 and 5, however, theoretically comprise the solution of using one candidate target base station to realize the object of the invention, which is apparently different from the solution of using at least two candidate target base stations to realize the object of the invention. The two solutions are substantively different from each other in essence. Additionally, judging from the drafting manner, claims 1, 4 and 5 are not generalized in a form of several choices listed in parallel, so there does not exist a technical solution equivalent in effect which can be deleted without affecting the substantial contents of the claim. By reason of the foregoing, the amendments to claims 1, 4 and 5 made by Ericsson do not meet the requirement of the Implementing Regulations of the Patent Law, and the PRB does not err in conducting examination based on the granted documents of the said patent.

7. The technical effect of a selection invention shall be compared with that of non-selected generic scope in the prior art.

A selection invention refers to a small-scope invention or an individual invention which is not mentioned in the prior art but is selected out on purpose from a broader scope disclosed in the prior art. The key to judge whether a selection invention involves an inventive step is to consider what un-

expected technical effect has been achieved by the selection invention over the prior art. When the technical effect of the selection invention is compared with that achieved by the prior art before the filing date of the selection invention, if the prior art falls within a generic scope of the selection invention, the technical effect of the selection invention shall be compared with that of the non-selected invention at the same level in the prior art.

In *Daiichi Sankyo Co., Ltd. (Sankyo Co.) and UBE Industries, Ltd. (UBE Co.) v. the PRB and Huaxia Shengsheng Pharmaceutical (Beijing) Co., Ltd. (Huaxia Co.)*, an administrative dispute over invalidation of an invention patent⁷, Sankyo Co. and UBE Co. are patent owners of an invention No. 01815108.6 (hereinafter referred to as the said patent) entitled “Hydropyridine Derivative acid addition salts”. In regard to the said patent, Huaxia Co. deemed that claims 1 and 2 of the said patent possess no inventive step by taking E2 or E3 as the closest prior art, and respectfully requested the PRB to declare the said patent invalid. The PRB decided that claims 1 and 2 of the said patent involve the hydrochloride or the maleate of a prasugrel compound. Claim 22 of E2 and claim 28 of E3 have disclosed the technical solution of pharmaceutically acceptable salts of prasugrel. Claims 1 and 2 of the said patent differ from the technical solution of E2 and E3 in that claims 1 and 2 of the said patent respectively specify the pharmaceutically acceptable salts as the hydrochloride and the maleate. Contrast experiments of the said patent merely indicate that prasugrel hydrochloride or maleate exhibits excellent oral absorption, metabolism into the active compound and activity in inhibition of platelet aggregation with respect to prasugrel free base. Nevertheless, no evidence has been provided either in the description of the said patent or by the patentees to demonstrate that prasugrel hydrochloride or maleate of the said patent achieves any unexpected technical effect in terms of oral absorption, metabolism into the active compound and activity in inhibition of platelet aggregation with respect to the prior art, namely, other salts within the scope of “pharmaceutically acceptable salts” disclosed in E2 or E3. Thus, claims 1 and 2 possess no inventive step over E2 or E3, which results in non-compliance with the provision of Article 22.3 of the Patent Law. The PRB then declared the present patent wholly invalid, and the first-instance court sustained the PRB’s decision.

The second-instance court held that under the teaching of E2 or E3, the prior art has provided the solution relat-

ing to prasugrel free base and pharmaceutically acceptable salts thereof. The said patent selected two salts among them, which makes it a selection invention. Therefore, the inventive step of the present patent is premised on that the selection of salts achieves some unexpected technical effect. Judgment on the inventive step of such a selection shall be made on the basis of the comparative result between the technical solution of the said patent and the effect of other prasugrel pharmaceutically acceptable salts. The prior art fails to provide a definite effect achieved by prasugrel pharmaceutically acceptable salts, and E2 or E3 discloses compounds having a general formula and pharmaceutically acceptable salts thereof, wherein the preferable compounds comprise prasugrel free base. Those skilled in the art can predict, according to their common knowledge, that prasugrel free base and pharmaceutically acceptable salts thereof have substantially the same technical effect. In the description of the said patent, the effect achieved by prasugrel hydrochloride or maleate is compared with prasugrel free base so as to prove the technical progress of the said patent, which complies with the method of comparing the technical solution of the said patent with the closest prior art. The PRB ruled that the said patent shall be compared with other prasugrel pharmaceutically acceptable salts in terms of the technical effect to testify its inventive step. Although there is nothing wrong with that ruling, it is factually groundless to distinguish the technical effect achieved by prasugrel free base from that achieved by prasugrel pharmaceutically acceptable salts. In view that the PRB's determination concerning the technical effect of the prasugrel pharmaceutically acceptable salts lacks factual basis, and that the further requirement of PRB to compare the technical solution of the said patent with that of the prasugrel pharmaceutically acceptable salts is not only infeasible but also goes against the common knowledge of those skilled in the art, the PRB fails to determine whether the technical solution recited in the description of the said patent achieves an unexpected technical effect as compared with the prasugrel free base or pharmaceutically acceptable salts having an equivalent effect as recognized by those skilled in the art. Hence, the PRB shall re-determine the above issues before deciding whether the technical solution of the said patent possesses inventive step.

8. Multiple patent references commonly known to and accepted by those skilled in the art can be used to prove whether a technical feature falls within the scope of com-

mon knowledge.

Common knowledge refers to the technical knowledge in each technical field which is commonly known to those skilled in the art and should be grasped by those skilled in the art. Common knowledge is often proved in textbooks, technical brochures and the like. If a technical fact has been disclosed in such technical literature as journals or patent documents prior to the filing date of a patent, it may also be regarded as common knowledge.

In *the PRB and Ningbo Baogong Electrical Appliance Co., Ltd. (Baogong Co.) v. Ye Xiaoyong*, an administrative dispute over invalidation of a utility model patent⁸, Ye Xiaoyong is the patent owner of the patent for utility model (No. 200720109764.X) entitled "Fuel Heater". Baogong Co. filed a request for invalidation of the said patent. The PRB declared the said patent wholly invalid after examination. The first-instance court was of the view that the additional technical feature of claim 5, which is dependent on any one of claims 1 to 3, of the said patent reads "the power supply circuit of the electric motor is provided with a photoresistor". A photoresistor is a common component and it is also a conventional technical means to dispose a photoresistor on a power supply circuit for the control of an electric motor, but there is no evidence proving that the use of a power-supply circuit for an electric motor, provided with a photoresistor, in a fuel heater is a conventional technical means, nor is there any evidence which teaches the combination of the above features. Thus, it is groundless for the PRB to decide that the technical solution of claim 5 according to claim 1 is obvious and lacks inventive step.

The second-instance court held that the PRB submitted several patent references during the second instance of the case for proving that it is a conventional technical means to dispose a photoresistor on a power supply circuit for an electric motor to achieve the control of the electric motor. Since the use of a photoresistor on a power supply circuit for an electric motor is the common knowledge in the art, it can easily occur to those skilled in the art to use a power supply circuit for an electric motor, provided with a photoresistor, for all electric motors including a fuel heater. Hence, the PRB's decision is correct in finding the technical solution of claim 5 according to claim 1 obvious and lacking in inventive step. ■

(proofread by Yang Boyong)

¹ See the Administrative Judgment No. Jingxingzhong 5347/2016 issued by Beijing High People's Court on 29 December, 2016 (the judges of the Panel were Liu Hui, Liu Qinghui, Su Zhifu, and the handling judge was Liu Qinghui) and the Administrative Judgment No. Jingzhixingchuzi 4944/2015 issued by Beijing Intellectual Property Court.

² See the Administrative Judgment No. Gaoxing(zhi)zhongzi 1549/2015 issued by Beijing High People's Court on 27 January, 2016 (the judges of the Panel were Liu Hui, Liu Qinghui, Ma Jun, and the handling judge was Liu Qinghui) and the Administrative Judgment No. Jingzhixingchuzi 23/2014 issued by Beijing Intellectual Property Court.

³ See the Administrative Judgment No. Jingxingzhong 50/2016 issued by Beijing High People's Court on 29 March, 2016 (the judges of the Panel were Cen Hongyu, Liu Qinghui, Ma Jun, and the handling judge was Cen Hongyu) and the Administrative Judgment No. Jingzhixingchuzi 83/2015 issued by Beijing Intellectual Property Court.

⁴ See the Administrative Judgment No. Gaoxing(zhi)zhongzi 1288/2015 issued by Beijing High People's Court on 28 December, 2016 (the judges of the Panel were Pan Wei, Kong Qingbing, Tao Jun, and the handling judge was Kong Qingbing) and the Administrative Judgment No. Yizhongzhixingchuzi 2857/2013 issued by Beijing No.1 Intermediate People's Court.

⁵ See the Administrative Judgment No. Jingxingzhong 485/2016 issued

by Beijing High People's Court on 11 March, 2016 (the judges of the Panel were Cen Hongyu, Liu Qinghui, Ma Jun, and the handling judge was Cen Hongyu) and the Administrative Judgment No. Jingzhixingchuzi 275/2015 issued by Beijing Intellectual Property Court.

⁶ See the Administrative Judgment No. Gaoxingzhongzi 1737/2013 issued by Beijing High People's Court on 13 December, 2016 (the judges of the Panel were Sha Rina, Zhou Bo, Tao Jun, and the handling judge was Zhou Bo) and the Administrative Judgment No. Yizhongzhixingchuzi 223/2012 issued by Beijing No.1 Intermediate People's Court.

⁷ See the Administrative Judgment No. Gaoxing(zhi)zhongzi 2879/2015 issued by Beijing High People's Court on 13 July, 2016 (the judges of the Panel were Zhong Ming, Yuan Xiangjun, Qi Lei, and the handling judge was Zhong Ming) and the Administrative Judgment No. Yizhongzhixingchuzi 2469/2013 issued by Beijing No.1 Intermediate People's Court.

⁸ See the Administrative Judgment No. Jingxingzhong 3766/2016 issued by Beijing High People's Court on 6 December, 2016 (the judges of the Panel were Jiao Yan, Kong Qingbing, Jiang Qiang, and the handling judge was Jiao Yan) and the Administrative Judgment No. Yizhongxing(zhi)chuzi 995/2015 issued by Beijing No.1 Intermediate People's Court.