Latest Developments in Adjudication of IP Cases by Beijing High People's Court in 2017

(Abridged Part on Patent)

The IP Tribunal of the Beijing High People's Court

In the year of 2017, the Beijing High People's Court accepted 3,415 IP cases of all types, representing a 2.9% year-over-year increase, of which there were 8 first-instance cases, 3,178 second-instance cases, 224 appeals, 3 retrials and 2 reviews. Of all the newly accepted 3,415 cases, administrative cases involving grant and affirmation of IP rights amounted to 3,053, accounting for 89.40% of all the newly accepted cases while civil cases amounted to 362, accounting for 10.60%. Of all the 3,053 administrative cases involving grant and affirmation of IP rights accepted in 2017, administrative cases involving patent grant and affirmation amounted to 399, taking up 13.07%, while administrative cases involving trademark grant and affirmation amounted to 2,654, taking up 86.93%.

In the year of 2017, the Beijing High People's Court concluded 3,424 IP cases of all types, representing an

8.08% year-over-year increase, of which there were 2 first-instance cases, 3,201 second-instance cases, 216 appeals, 3 retrials and 2 reviews. Of all the concluded 3,424 cases, administrative cases involving grant and affirmation of IP rights amounted to 3,070, accounting for 89.66%, while civil cases amounted to 354, taking up 10.34% of all the concluded cases. Of all the 3,070 administrative cases involving grant and affirmation of IP rights closed in 2017, administrative cases involving patent grant and affirmation amounted to 408, making up 13.29%, while administrative cases involving trademark grant and affirmation amounted to 2,622, making up 86.71%.

The cases tried at the Beijing High People's Court in 2017 can be characterized as follows: first, all types of cases have been covered, among which complicated and intricate cases take a major portion. For instance, an administrative dispute over invalidation of an invention patent titled "Nucleotide analogs" was concluded. Second, more and more cases have aroused concerns and attention from the public, such as "U key" case which is a dispute over infringement of an invention patent and a dispute over infringement of a trademark "墙锢". Third, the number of cases rises steadily with a 2.9% 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 are administrative cases involving trademark grant and affirmation. And fifth, the manpower for trials is replenished, but they are still under a heavy burden. A plurality of judges concluded more than 170 cases per capita in 2017, wherein the highest record was even up to 200 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 2017.

Administrative cases involving patent grant and affirmation

1. The date information indicated in a publication can assist in determining the publication date of the publication.

In determining the publication date of a publication, account shall be taken of not only the printing date, but also other information recited. A determination shall then be made in comprehensive consideration of all the information with the high degree of probability as the standard of proof. Only when all the information recited in the publication are inadequate to determine the publication date shall we apply the "presumption rule" as set forth in the Guidelines for Patent Examination to presume the last day of the month in which the publication was published as the publication date.

In an administrative dispute over invalidation of an invention patent titled "Treatment of gastrointestinal stromal tumors"[1], the requestor submitted Evidence 1, which is an article published on The Lancet Oncology in October 2000. The invalidation requestor argued that the claims of the patent in suit possess no inventive step over Evidence 1. The dispute of the case focuses on whether The Lancet Oncology (October 2000) constitutes the prior art, that is, whether it was published prior to the priority date (27 October, 2000) of the patent in suit. Both the requestor and the patentee submitted numerous evidence and grounds concerning the crux of the dispute. Evidence 9, 10 and 13 provided by the requestor are e-mail correspondences between the attorney on behalf of the requestor and Prof. David Collongridge, the editor-in-chief of The Lancet Oncology, in order to prove that The Lancet Oncology (October 2000) was published prior to the priority date of the patent in suit according to the statements of Prof. David Collongridge in e-mails. The patentee submitted the Counterevidence 1 and 2, namely its e-mail correspondences with Prof. David Collongridge and relevant information posted on the website of The Lancet Oncology, for proving that Prof. David Collongridge was the editor-in-chief of that journal in 2014 and it was uncertain when The Lancet Oncology (October 2000) was published.

The Patent Re-examination Board (PRB) held that on account of Evidence 1 being published before the priority date of the patent in suit, the determination of Evidence 1 as the prior art evidence before the priority date of the patent in suit was reasonable. The PRB accepted neither Evidence 8, 11 and 12 submitted by the requestor for proving the publication date of Evidence 1 nor the corresponding Counterevidence 3 to 11, 13, 14 and 27 submitted by the patentee. In view of all the above materials, the PRB issued the decision to declare the patent in suit wholly invalid. The first-instance court held that on the basis of the information disclosed in Counterevidence 12 and in conjunction with the e-mail correspondences between the parties concerned and the now editor-in-chief of The Lancet Oncology, it can be determined that Evidence 1 had been available to the public before the priority date of the patent in suit and

therefore constitutes the prior art of the patent in suit.

The second-instance court found that Evidence 1 and Counterevidence 12 indicate that The Lancet Oncology was published in "October, 2000", without telling a specific date, so the specific publication date of the journal shall be determined comprehensively in consideration of other relevant information. The two-page "Conference Log" in Counterevidence 12 includes 24 pieces of conference information consisting of time, name, location, liaison, etc. On the one-page "Classified Advertising" in Counterevidence 12, the term "coming soon" is at a conspicuous position under the item "Imedex medical conference experts". Eight pieces of information consist of name, time, location, conference president, etc. Among all the 32 pieces of conference information, five convened before the priority date of the patent in suit, on 5 October at the earliest, and the other twenty-seven were held after November, 2000. Under normal circumstances, a journal posting a conference advertisement shall be published before the conference convenes, so that those skilled in the art have chances to know the conference before conference participation, and it is less probable to see a journal published after a conference. Pursuant to the standard of proof of "the high degree of probability" used in civil litigation and in consideration of Evidence 1 and the "Conference Log" and "Classified Advertisement" in Counterevidence 12, it can be surely determined that Evidence 1 was published before the priority date of the patent in suit, and belongs to the prior art of the patent in suit. Claim 1 of the patent in suit lacks an inventive step over Evidence 1.

2. Technical solution excluded by a patentee when drafting claims should not be incorporated into the scope of the claims through claim construction

Effort shall be made to avoid improperly demarcating the scope of claims in the patent grant and affirmation process. If a solution, though disclosed in the description of a patent, is not incorporated into the scope of the claims, it shall be deemed that the solution has been abandoned by the patentee and shall not be incorporated into the scope of claims through claim construction. An explicit statement for abandoning a technical solution is not a requisite. As long as those skilled in the art can determine that the patentee only selects one or more of the multiple solutions disclosed in the description after reading the claims and description of the patent in suit, other solutions shall be considered to be "abandoned".

In an administrative dispute over invalidation of an invention patent titled "Electroluminescent bottle label and waterproof manufacturing process thereof" [2], the description of the patent in suit recites, in para. 0009 of the Summary of the Invention section, that "the battery box base is shaped to fittingly conform to the shape of the bottom of the bottle so as to be covertly installed in the bottom of the bottle", and in para. 0012 that "the battery box base can also be designed to have a groove in the upper portion thereof for embedding the bottom of the bottle or an externally protruding tapered component thereon for inserting the bottom of the bottle, thereby ensuring the stable placement of the bottle on the base." Three examples are recited in the description of the present patent. As recited in paras. 0043 and 0044, "Example 3: as shown in Figs. 11 and 12, the battery box base can be designed to be square-shaped, the square-shaped battery box base 4 can be designed to have a groove for embedding the bottom of the bottle or an externally protruding tapered component thereon for inserting the bottom of the bottle, thereby ensuring the stable placement of the bottle on the base. The bottle 5 can be disposed in the groove of the square-shaped battery box base, or on the square-shaped battery box base 4 by inserting the externally protruding tapered component of the square-shaped battery box base 4 into the bottom of the bottle 5, so as to ensure that the bottom can be placed onto the base stably, and then an electroluminescent label is attached to the bottle 5." One of the disputes of the case is whether "the battery box base is shaped to fittingly conform to the shape of the bottom of the bottle so as to be covertly installed in the bottom of the bottle" constitutes the technical solution claimed in Claim 2 of the patent in suit.

The PRB found that the technical solution of Claim 2 differs from the technical content disclosed in Evidence 1 in that ① the electroluminescent label comprises a PET film protective layer, a PET silk screen layer, an ITO film, a phosphor powder layer, a dielectric layer, a silver paste layer, a waterproof layer, a double-sided adhesive, which are sequentially adhered to each other; and ② the electroluminescent power supply wire belt has two electrodes therein, and the electroluminescent power supply wire belt is connected at its lowermost end with spot welding legs of two electrodes in the electroluminescent power supply wire, and the spot welding legs are connected to the driving unit of the battery box base. The appealed Decision upheld the validity of the patent in suit. The technical solution of Claim 2 has

neither prominent substantive features nor notable progress, and therefore lacks an inventive step. The first-instance court also found Claim 2 of the patent in suit lacks an inventive step.

The second-instance court held that the description of the patent in suit clearly recites that the battery box can be arranged in two ways, namely "be covertly installed in the bottom of the bottle" and "be stably placed on the base", which are two parallel technical solutions. Claims define the scope of protection of the patent. While drafting Claim 2, the patentee only wrote, into the claims, the technical solution that the battery box base can "be covertly installed in the bottom of the bottle", and did not claim the technical solution that the battery box base can "be stably placed on the base". Hence, the latter technical solution is not included into the scope of claims, and shall be considered to be the technical solution "donated" by the patentee and not be construed into the claims. Hence, Claim 2 of the patent in suit is only directed to the technical solution that the battery box is completely concealed in the bottom of the bottle, not that the battery box is exposed out of the bottom of the bottle. In assessing the inventive step of claim 2, the PRB neglected the distinguishing technical feature that "the battery box base is shaped to fittingly conform to the shape of the bottom of the bottle so as to be covertly installed in the bottom of the bottle". As a result, the PRB erred in finding claim 2 inventive.

3. Account shall be taken of the coordination between distinguishing features in the assessment of inventive step.

We should avoid directly regarding the basic attributes of the distinguishing technical feature *per se* to be the functions it performs in the technical solution, but examine the association between the distinguishing technical feature and other features, and finally determine the objective technical effect brought by the distinguishing feature. Especially when the distinguishing technical feature pertains to common knowledge in the art, if the technical effect is determined merely according to the attribute of the distinguishing technical feature without considering the cooperation and coordination between the distinguishing technical feature and other features in the technical solution, one turns a blind eye to the internal link between a single distinguishing technical feature and the entire technical solution. For the purpose of determining the function and effect of the distinguishing technical feature, one shall consider the distinguishing technical feature in the context of the entire technical solution of the patent in suit, while taking into comprehensive consideration the intrinsic attribute of the distinguishing feature, the relationship between the distinguishing feature and other features, the object of the invention, etc.

In the administrative dispute over invalidation of the utility model patent titled "Pressure-type safety belt reminding sensor positioned on lower surface of seat cushion or on seat framework" [3], Claim 2 of the patent in suit differs from the closest prior art in the following distinguishing technical features: (3-1) the pressure sensor in the patent in suit comprises a through hole disposed in a plastic film layer, whereas the membrane switch in Evidence 2 has a small vent passage 36 formed in an adhesive layer 18 and connected to a main vent passage 38, which terminates at the edge 39 of the membrane 20 so that it, in effect, is vented to atmosphere; (3-2) the pressure sensor in the patent in suit comprises a through hole disposed in a plastic film layer, whereas the membrane switch in Evidence 2 comprises a passage 46 in the substrate 10, and the passage 46 extends to the chamber 44 formed between the second substrate and the first substrate. The PRB decided that the description of the patent in suit did not describe the function of the through hole in detail, not to say how to identify the lowest load thereby. Thus, those skilled in the art are unable to determine that the through hole functions to identify the lowest load according to the description, and the patent in suit lacks an inventive step.

The first-instance court held that the description of the patent in suit only recites that different loads change the degree of contact between two plastic film layers and accordingly change the contact resistance, which is conveyed to a relevant control system for signal detection, not the technical effect that the plastic film through-hole is used to identify the lowest load and detect the sensor. After reading the description, those skilled in the art cannot acquire the above-mentioned technical effect, so the identification of the lowest load is not the technical problem to be actually solved by the present patent. Although the technical effect achieved by the plastic film through-hole in the distinguishing technical features (3-1) and (3-2) is not recited in the description of the present patent, those skilled in the art can know that a through hole disposed in the pressure sensor can achieve the technical effect of air ventilation and exhaustion, and the said technical effect can also be achieved in Evidence 2. Having read the description of the

present patent, those skilled in the art realize that the technical problem actually solved by the distinguishing technical features (3-1) and (3-2) is to provide a new manner to balance the pressure inside and outside the sensor. As for the distinguishing technical feature (3-1), it can easily occur to those skilled in the art to simply open an exhaust passage in the thin film for the sake of pressure balance. As for the distinguishing technical feature (3-2), those skilled in the art can also easily conceive of directly achieving the balance of pressure inside and outside the sensor without using the second substrate and the cavity 44 in E2. In addition, the distinguishing technical features (3-1) and (3-2) brought about no unanticipated technical effect to Claim 2 of the present patent. As for the distinguishing technical feature (4), those skilled in the art can arrange a textile protective material externally to the sensor according to different occasions as required, without making any inventive effort, and such an arrangement does not result in any unanticipated technical effect. Hence, Claim 2 of the patent in suit lacks an inventive step.

The second-instance court found that the patent in suit differs from the closest prior art in a pressure sensor including a "through-hole" disposed in the plastic film layer, and the "through-hole", together with other technical features like upper and lower layered plastic films and printed circuits, constitutes the sensor. The "through-hole" enables the air within the double-layered plastic films to be vented under the action of the load on the seat, and keeps the upper and lower layered printed circuits in contact so as to change the contact resistance and transmit the same to a relevant control system for signal detection, which provides occupant status information so as to remind them to keep the safety belts fastened. As the common knowledge or common sense in the art, the "through-hole" certainly has the function of "ventilation and exhaustion". Since the "through-hole" in the patent in suit is integrally formed with the pressure sensor, the objective technical problem shall not be determined on the basis of the function of the "through-hole" alone, but by judging the function of the "through-hole" in the context of the pressure sensor. The two-page description of the patent in suit reiterates that "sensing units of the sensor can make measurements repeatedly", and those skilled in the art can definitely realize the technical effect achieved by the sensing units is to "measure" the load on car seats according to the title and object of the invention, and the structure and embodiments of the sensing units. For those reasons, the technical problem to be actually solved by the patent in suit is neither to "exhaust and ventilate air" as alleged by the patentee, nor to "maintain balanced pressure" as concluded by the first-instance court, but to "identify the lowest load". The first-instance court mistakenly regarded the technical problem solved by the closest prior art to be the objective technical problem solved by the patent in suit, thereby resulting in an erroneous determination of inventive step for the patent in suit.

4. Supplemental experimental data can be used to assess an inventive step under particular conditions

Experimental data supplemented after the filing date shall be examined in the assessment of inventive step. If the experimental data are authentic and credible, the experimental methods and conditions are those used before the filing date of the patent in suit, the technical effect embodied in the experimental data is the one recited in the patent documents of the patent in suit, and the experimental data are obtained through experiments by the patentee against the reference documents submitted by the requestor, the supplemental experimental data can be generally accepted. Acceptance of supplemental experimental data shall not stand in violation of the first-to-file principle.

In an administrative dispute over invalidation of an invention patent titled "Nucleotide analogs" [4], three requestors respectively filed a request for invalidation with the PRB, requesting that the present patent shall be wholly invalid. Regarding the combination of evidence used by one of the requestors, the patentee submitted Counterevidence III-13 with the PRB, arguing that "such an article was published in an authoritative journal. Well-known experts in this field conduct examination to see whether the article is qualified for publication. As can be seen from this article, bis(poc)pmp is more easily absorbed by human bodies and achieves a stronger antiviral effect …… The present invention possesses an inventive step." Counterevidence III-13 discloses the experimental data relating to the anti-HIV activity of PMPA and its precursor in MT-2 cells and PBMC. This experiment monitors cell viability in the replication medium by XTT assay. According to Table 1, bis(poc)PMPA has the EC50 of 0.007μm and the IC50 of 22μm, and bis(pom)PMPA has the EC50 of 0.05μm and the IC50 of 7.5μm. The PRB made a decision to declare the patent in suit invalid without making comments on that Counterevidence. The first-instance court did not accept the Counterevidence III-13 and found

the Decision justifiable.

In the absence of opposite evidence, the second-instance court confirmed the authenticity of the Counter-evidence III-13, which is a scientific paper published in March 1998, earlier than the date on which the request for invalidation was filed. The Counterevidence III-13 and the prior art (i.e., Evidence II-2) adopted the same experimental method, XTT assay, so the experimental method used in the Counterevidence III-13 is the one occurring before the filing date of the patent in suit, and the specific experimental steps are also recited in the Counterevidence III-13. Meanwhile, the technical effect concerning antiviral activity and cytotoxicity of the Counterevidence III-13 is definitely recited in Example 16 of the description of the patent in suit, and the Counterevidence III-13 made parallel comparisons between bis(poc)PMPA of Claim 2 of the patent in suit and bis(pom)PMPA disclosed in Evidence II-2 in terms of antiviral activity and cytotoxicity. It can thus be seen that the Counterevidence III-13 provides those experimental data against particular reference document. To sum up, the experimental data provided in the Counterevidence III-13 were formed subsequent to the filing date of the patent in suit, but they can objectively manifest the technical contributions made by the patent in suit, and the acceptance of the experimental data would not bring about unjustified benefits to the patentee. Thus, the Counterevidence III-13 should be accepted for assessing the inventive step of Claim 2 of the patent in suit. Judging from Example 16 of the description of the patent in suit, Evidence II-2 and Counterevidence III-13, it can be known that bis(poc)PMPA of Claim 2 of the patent in suit achieves better antiviral activity and lower cytotoxicity over Evidence II-2.

5. Priority is verified on the basis of technical solutions, rather than claims

The priority system is designed to ensure that the first person who applies for a patent for identical inventions can be awarded the patent right under the first-to-file principle. The system design shall, on the one hand, provide conveniences and actual interests for applicants, and, on the other hand, prevent applicants from gaining unjustified benefits. Poor claim drafting skills should not, as such, be a reason for restricting an applicant's entitlement to claim the priority. Application of partial priority should not be treated differently. No technical solution pieced together by a plurality of claims shall be entitled to claim a priority to gain unjustified interests from partial priority. Partial priority shall be verified on the basis of the claimed technical solution, and assessment of partial priority is not restricted by claims, but meanwhile should not transcend the claims.

In an administrative dispute over invalidation of an invention patent titled "Nucleotide analogs" [5], three requestors respectively filed a request for invalidation with the PRB, requesting that the present patent shall be wholly invalid. The PRB found that the applicant only claimed one priority (US08/686,838 dated 26 July, 1996, Evidence II-14) in respect of the patent in suit in the phase of patent application. There are at least several differences between the published document of the patent in suit and the claimed priority document. Hence, Claims 1 and 3 of the patent in suit cannot enjoy the priority of US08/686,838 filed on 26 July, 1996, and accordingly Claims 4 to 14, and 19 to 32 having the same defect shall not be entitled to the said priority. In view that Claims 1, 3 to 14 and 19 to 32 of the patent in suit were not entitled to the claimed priority date, Evidence II-17, which was published earlier than the filing date of the patent in suit, can serve as the prior art for assessing the novelty and inventive step of Claims 1, 3 to 14 and 19 to 32 of the patent in suit. With respect to Evidence II-17, Claims 1, 3 to 6, 8 to 10, 22 and 26 of the patent in suit lacked novelty, which does not conform to Article 22.2 of the Patent Law. The PRB decided to declare the patent in suit wholly invalid.

The first-instance court held that the "identical subject-matters" limitation is aimed to prevent a patent applicant from introducing into the patent application some technical information published after the priority date, so the assessment of priority should be made following the rule for judging whether amendments go beyond the original disclosure as set forth in Article 33 of the Patent Law. That is to say, a comparison shall be made between the priority document and the technical solution of the patent document. In this case, Gilead Sciences Inc. made its claim to priority, and if the technical solution introduces the technical information that has never occurred in the priority document, it should be deemed that the subject-matter of the technical solution is not identical to that of the priority document, and the technical solution should not be entitled to the priority. The patentee claimed that Claims 1, 3 to 14 and 19 to 32 enjoyed a foreign priority. The priority should be verified on the basis of comparison between claims in the priority documents and the patent application, rather than the specific compounds contained in the claims. For judging whether the

claim is entitled to the priority, a comparison should be made between the claim in the granted document of the patent in suit and the corresponding part in the priority document. In view that the patentee recognized the difference in respect of the claims between the patent document and the priority document, as determined in the appealed Decision, the technical solution of the claims and that in the priority document do not constitute technical solutions with the same subject-matters. For this reason, the patentee's assertion that the claim enjoys the priority should not be upheld.

The second-instance court held that "identical subject-matters" are not directed to claims, but to the technical solutions claimed therein, and whether subject-matters are identical can be evaluated on the basis of technical solutions to see if the technical fields, technical problems solved and technical effects achieved thereby are the same. A multiple priorities system design in foreign countries further proves that matter. In the multiple priorities system in foreign countries, technical solutions that can be alternatively selected in one claim can become the minimum units for verification of a priority. So are the minimum units for verification of a partial priority. Article 4, Part F of the Paris Convention for the Protection of Industrial Property reads: "No country of the Union may refuse a priority or a patent application on the ground that an application claiming one or more priorities contains one or more elements that were not included in the application or applications whose priority is claimed." Taking a technical solution as the minimum unit for verification of a priority is in line with the legislative spirit of priority and the relevant provisions in the Paris Convention. Partial priority shall be verified on the basis of the claimed technical solution, and assessment of partial priority is not restricted by claims, but meanwhile should not transcend the claims. A Markush claim, as a special drafting manner, is a generalization of multiple technical solutions. But different from a common generalizing method like a generic concept, a Markush claim is, in essence, not a single technical solution, though being formally integral. On account of the particularities of a Markush claim, it is also possible that a Markush claim contains a limited number of clearly-divided alternative technical solutions under special circumstances. At this time, a Markush claim can enjoy a partial priority.

6. In litigation, it is generally unadvisable to initiatively introduce common knowledge not asserted by a requestor

Common knowledge can be common technical knowledge well-known to those skilled in the art. Introduction of common knowledge should meet the requirement of the hearing principle. In the patent invalidation proceedings, the party who advocates the use of common knowledge is required to adduce evidence or make an adequate explanation. In administrative lawsuits involving patent grant and affirmation, it is generally unadvisable to initiatively introduce the evidence of common knowledge which is not used by the requestor in invalidation examination and not cited by the PRB during examination, let alone combining the evidence of common knowledge with the reference document to assess the inventive step of the patent in suit.

In an administrative dispute over invalidation of an invention patent titled "Electrostatic dust separator" [6], Claim 1 of the patent in suit reads: an electrostatic dust separator (8) for horizontal gas throughflow comprising: a housing (2) which is substantially rotationally symmetrical in relation to a central housing axis (3) and has a tubular inlet port (1) and a tubular outlet port (9), characterized in that the tubular inlet port (1) flares in a single conical section (10) up to 80 to 95% of the housing diameter (D), the remaining widening of 5 to 20% of the housing diameter (D) takes the form of a step (5) which is configured to be substantially perpendicularly and radially symmetrical in relation to the housing axis (3); and at least two perforated gas-distributing plates (6, 6', 6") arranged in the conical section (10) and substantially perpendicularly in relation to the housing axis. The requestor argued against the inventive step of Claim 1 of the present patent over the combination of Evidence 1 and 5. However, in the PRB's view, Evidence 5 does not disclose in a clear-worded language that the inlet is not conical, but pyramid-shaped with a square cross section. Bearing in mind a cylindrical housing (1) disclosed in Evidence 1, those skilled in the art will apparently make the shape adaptable to the cylindrical housing (1). That is to say, when applying the single conical section and the step in Evidence 5 to Evidence 1, those skilled in the art who intends to render the gas flow more uniform would readily conceive of further dimensioning the single conical section and the step in Evidence 5 to the size within the dimensional range defined in Claim 1 of the present patent by means of the conventional experimental means in the art, thereby obviously arriving at the technical solution of Claim 1. Accordingly, the PRB made the appealed Decision, declaring the patent in suit invalid.

The first-instance court disagreed, holding that al-

though an inlet of a conical shape is not definitely disclosed in Evidence 5, square and circle are conventional choices for the shape of the inlet and housing of a dust separator from the viewpoint of those skilled in the art. Therefore, on the basis of the structure of "a tapered inlet and step" disclosed in Evidence 5, those skilled in the art will be surely motivated to adaptively amend it to be "a conical inlet and step" structure of the cylindrical housing in the patent in suit, and apply the said structure to Evidence 1 to arrive at the technical solution of claim 1 of the patent in suit. Evidence 5 teaches to apply the distinguishing technical feature to Evidence 1 to solve the technical problem actually solved by the patent in suit. As for the size of the "conical inlet" and the "step", it can be obtained by those skilled in the art after finite experiments. After analysis, it is found that Claim 1 of the patent in suit lacks an inventive step over Evidence 1 in view of Evidence 5 and common knowledge. The PRB's determination of Claim 1 of the patent in suit being inventive is correct.

The second-instance court was in favour of the finding of the first-instance court that those skilled in the art can, after reading Evidence, derive therefrom that the inlet part is either round or square. However, as regards the content in the First-instance Judgment that "square and circle are conventional choices for the shape of the inlet and housing of a dust separator from the viewpoint of those skilled in the art", the requestor did not argue that the above mentioned content was common knowledge and can be used in conjunction with Evidence 5 in the invalidation proceedings, and the PRB failed to determine *ex officio* "square and circle are conventional choices for the shape of the inlet and housing of a dust separator" as common knowledge, and assess the inventive step of claim 1 of the patent in suit over the combination of common knowledge and Evidence 5. There is no legal basis for the first-instance court to introduce the common knowledge which is not put forward by the party concerned in the invalidation proceedings and combine the same with Evidence 5 to assess the inventive step of Claim 1 of the patent in suit. ■

(Proofread by Yang Boyong)

[1] See the Administrative Judgment No. Jingxingzhong 2871/2017 issued by Beijing High People's Court on 20 December, 2017 (the judges of the Panel were Liu Hui, Liu Qinghui, Mao Tianpeng, and the handling judge was Liu Qinghui) and the Administrative Judgment No. Jing73xingchu 985/2016 issued by Beijing Intellectual Property Court.

[2] See the Administrative Judgment No. Jingxingzhong 1082/2017 issued by Beijing High People's Court on 30 June, 2017 (the judges of the Panel were Xie Zhenke, Yuan Xiangjun, Wang Xiaoying, and the handling judge was Yuan Xiangjun) and the Administrative Judgment No. Jing73xingchu 126/2016 issued by Beijing Intellectual Property Court.

[3] See the Administrative Judgment No. Gaoxing(zhi)zhongzi 3065/2015 issued by Beijing High People's Court on 30 March, 2017 (the judges of the Panel were Xie Zhenke, Yuan Xiangjun, Qi Lei, and the handling judge was Yuan Xiangjun) and the Administrative Judgment No. Jingzhixingchuzi 1298/2015 issued by Beijing Intellectual Property Court.

[4] See the Administrative Judgment No. Jingxingzhong 1806/2017 issued by Beijing High People's Court on 19 December, 2017 (the judges of the Panel were Jiao Yan, Ma Jun, Dai Yiting, and the handling judge was Jiao Yan) and the Administrative Judgment No. Jingzhixingchuzi 1297/2015 issued by Beijing Intellectual Property Court.

[5] Ibid.

[6] See the Administrative Judgment No. Jingxingzhong 64/2016 issued by Beijing High People's Court on 28 April, 2017 (the judges of the Panel were Liu Hui, Su Zhifu, Yu Huibin, and the handling judge was Liu Hui) and the Administrative Judgment No. Jingzhixingchuzi 741/2015 issued by Beijing Intellectual Property Court.