

Chinese Practice: Impacts of Common Knowledge on Patentability

Determining what constitutes common knowledge plays an important role in the assessment of novelty, inventiveness, and sufficiency of disclosure. In China, common knowledge can be a customary means known or ought to be known to one skilled in the art and applied by such a person to solve specific technical problems, or can be a technical means that is most likely to be considered and applied by one skilled in the pertinent art when working on solutions to specific technical problems. While burdens to prove may be different for each means, a party bearing the burden of proof varies in different procedures.

During prosecuting a patent application in the substantial examination and reexamination stages, or during the invalidation and infringement procedures after patent issuance, “common knowledge” is the most common cited term against patentability. Now we will say something about the common knowledge in the art.

1. Definition of the common knowledge

Based on the provision in the Guidelines for Patent Examination (2010 Ed., the “Guidelines”), Chapter IV, part II, the common knowledge is a customary means in the art to solve a redetermined technical problem based on the cited references, or a technical means disclosed in a text book or reference book to solve the redetermined technical problem.

Further, the Guidelines, in Chapter VIII, part V, provide that the party alleging that certain technical means is common knowledge in the art shall bear the burden of proof for the allegation. If the party concerned cannot produce evidence or cannot adequately explain that the technical means is common knowledge in the art, and the allegation will not be supported by a panel of examiners. The party concerned may prove that certain technical means is common knowledge in the art with reference to the technical contents recorded in a reference book such as a textbook, a technical dictionary, or a technical manual.

Based on the above, the common knowledge may include the customary means in the art and the technical means recorded in the textbook, a technical dictionary, or a technical manual. Furthermore, if a party alleges the concerned features are the common technical means, he should provide evidentiary support from a textbook, a technical dictionary or a technical manual. However, if a party asserts the features are the customary means in the art, there is no requirement for proof. Accordingly, in practice, “the common knowledge” has been commonly

asserted as “the customary means in the art,” “easy to conceive”, “easy to achieve though limited times of experiences,” so as to avoid proofs. Even if an examiner holds the concerned features are the technical means, in practice, the examiner rarely provides any proof, but to provide some technical analysis.

Why does the examiner like to assert the common knowledge frequently? Because, firstly, the examiner cannot assess the inventiveness of claims, he needs more technical analysis and/or evidences from the applicant to support his understanding; and secondly, the examiner believes that the distinction is too trivial to find a proof or he thinks there is no need to look for a proof.

Based on the above, it is hard for the applicant to rebut to the assertion of common knowledge.

2. How to rebut the common knowledge

Here is an exemplary case.

The patent application relates an exhaust structure of a rotary compressor. Independent claim 1 reads as:

“An exhaust structure of a rotary compressor, comprises an exhaust port, valve (330) and limiter, each of them provided on an upper face of a cylinder, wherein the valve is directly mounted on a upper face of the exhaust port and covered the exhaust port, the limiter is mounted on the valve to limit the movement of

the valve, and the valve has a transition (331) having a shape conform with a shape of an inner diameter of the cylinder."

During the substantive examination, the examiner cites two references and indicates that the distinction between claim 1 and reference 1 lies in "the exhaust structure further comprises the limiter mounted on the valve to limit the movement of the valve, and the valve has a transition (331) having a shape conform with a shape of an inner diameter of the cylinder." Furthermore, the examiner indicates that reference 2 discloses the limiter 7 mounted on the valve 6 to limit the movement of the valve 6.

As for the feature "the valve has a transition (331) having a shape conform with a shape of an inner diameter of the cylinder" neither disclosed in reference 1 nor in reference 2, the examiner holds that it is the customary means in the art to achieve the technical effects of simplifying structure and avoiding interference. Thusly claim 1 does not possess inventiveness over D1 in view of D2 and the customary means. The above examination opinions are very common in practice.

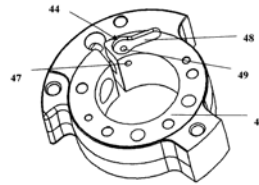
How to respond to the examination opinions?

Firstly, we can analysis said features deemed by the examiner as the customary means. As shown in the right fig, valve 330 is a very common part of the exhaust structure of the rotary compressor, it is commonly mounted on the exhaust slot to open or close the exhaust slot. In order to avoid interference, it seems easy to conceive to provide a transition 331 on the valve 330. Thusly, the examiner's opinion seems reasonable.

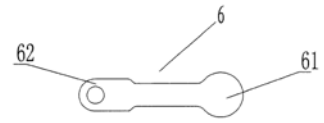


In order to argue with the examiner, we firstly can analysis the common shape of the valve 330. After communicating with the inventor and reading the reference documents, we find the common shape of the valve is not as shown in the present application, but as shown in the following figs, the shape of the valve 48 in reference 1 is somewhat similar to that of the valve 6 in reference 2, which shape is to conform with the common shape of the exhaust slot, so

that the valve can put into the exhaust slot.



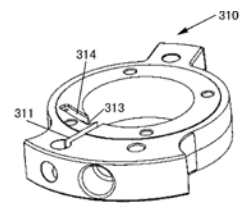
Reference 1



Reference 2

Based on the above analysis, we can say, for the person skilled in the art, the common shape of the valve is just as shown in the reference, and the shape of the present valve is not common.

Secondly, we can strengthen our arguments by stating the technical problem and the technical effect. As for the technical problem, providing a transition 331 on the valve is not the only approach to solve the technical problem of avoiding interference. For example, as disclosed in reference 1, providing the exhaust slot far from the inner diameter of the cylinder is also an approach to solve the problem of interference. As for the technical effect, as shown in right fig, in virtue of the special shape of the present valve 330, the shape of the exhaust slot 314 also can be simplified, for example, the exhaust slot 314 has the shape of rectangle, and thusly the manufacture process can be also simplified, and the cost can be reduced. Furthermore, the exhaust slot can be positioned near the inner diameter of the cylinder, such that the whole size of the compressor can be reduced.



By arguing as above, the examiner finally accepts our arguments, and the application is granted a patent right.

3. How to assert the common knowledge

Sometimes, we need to allege the common knowledge, for example during an invalidation procedure.

Firstly, we should provide the evidence to prove the common knowledge. Based on the Guidelines, the evidence should be reference

book such as a textbook, a technical dictionary, or a technical manual. The evidence in the other form, such as the other patent documents cannot be used as the proof for the common knowledge.

On the other hand, in case that we cannot find any proof for the common knowledge, we should try to find the indirectly proof for the common knowledge. For example, we can divide

said features into small units, and find the proof aimed at each of the units. As for the units we cannot find any proof, we could make detailed technical analysis, for example, from its technical problem, technical effects, the common status aimed at the unit. If necessary, we can use indirectly proof to strengthen our views.

The newsletter is not intended to constitute legal advice. Special legal advice should be taken before acting on any of the topics addressed here.

*For further information, please contact the attorney listed below. General e-mail messages may be sent using LTBJ@lungtin.com which also can be found at www.lungtin.com
FU, Yongli(Flora), Partner, Senior Patent Attorney: LTBJ@lungtin.com*



FU, Yongli (Flora)

(Partner, Senior Patent Attorney)

Ms. Fu is a senior patent attorney at Lung Tin. She focuses on patent matters including drafting and responding to the Office Action in the fields of machinery, with particular expertise in home appliance and connector. Ms. Fu is experienced in patent prosecution, invalidation, litigation and patent analysis with particular experience in representing European and American clients for their patent applications in China. Ms. Fu has provided a full and high qualified service to a lot of famous domestic and foreign companies, and gained good reputation from her clients.

Ms. Fu has started her patent profession since 2002. Prior to joining Lung Tin, she worked with another well-known IP firm handling a great amount of patent prosecution cases, and worked with Beijing No.3 Machine Tools Manufacture as an engineer. Ms. Fu published her articles "Providing A Strong Contravallation -The Importance of the Description" and "How To Make A Good Drafting Concerning The Later Patent Prosecution" based on her experiences in patent prosecution.