

Burden of Proof: Relying on Common Knowledge in Assessing Inventive Step

In Chinese patent prosecution, an examiner commonly relies on common knowledge, often without documentary evidence, to reject a claim for lack of inventive step. Would it be permissible?

I . Present Status of Proof on Common Knowledge in Examination of Inventive Step in China

During the examination of inventive step of invention, in order to prove that there is a motivation in the prior art of applying the distinguishing feature to the closest prior art to solve the existing technical problem, the examiner usually introduces the common knowledge.

Chapter 4, part II of the Examination Guidelines states: "Under the following circumstances, it is usually thought there exists such a technical motivation in the prior art. (i) The said distinguishing feature is a common knowledge, such as a customary means in the art to solve the redetermined technical problem, or a technical means disclosed in a textbook or reference book to solve the redetermined technical problem....".

However, with regard to the burden of proof on the common knowledge in the examination of inventive step, there is no relevant provision in the Examination Guidelines. Nevertheless, for examination in a post-granting procedure (invalidation), the Examination Guidelines states in Chapter 8, Part IV: "The party concerned alleging that certain technical means is common knowledge in the art shall bear the burden of proof for its 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 is not acknowledged by the opposite party, the panel shall not support the allegation." While the post-granting procedure is inter-parte and patent prosecution is ex-parte, the afore-stated allocation of burden of proof on common knowledge in the invalidation between parties may not be applicable to the examiners and the applicants in the patent application examination.

The lack of corresponding provisions in the Examination Guidelines is in part due to the following characteristics of the common knowledge.

(1) Well-known characteristics.

(2) Most of the common knowledge is too basic to find textual information.

(3) It is difficult to prove from the negative that a technology is not a common knowledge, and few documents record that the person skilled in the art did not know a certain technology at a certain time point in the past.

(4) Time limit. The judgment of whether or not a technology is a common knowledge before the filing date of the invention must be made by returning back to the filing date, and the time interval increases the difficulty of proof.

Based on the above characteristics, it is indeed difficult for an examiner to go back to the filing date to find out what is known to the person skilled in the art at that time. However, for the applicant, it is even more difficult, if not impossible, to show a technology is not a common knowledge.

Therefore, in practice, the examiner and the agent often reach a stalemate in determining whether the distinguishing feature is a common knowledge, and the same problem is also faced in the reexamination procedure.

II. Root of jurisprudence on the burden of proof on common knowledge in the examination of inventive step

The following is from the perspective of jurisprudence to discuss the question of the burden of proof on common knowledge in the examination of inventive step.



The examination of a patent application by the Patent Office according to laws is, in essence, an administrative act. According to the basic theory of administrative law, an administrative subject should make specific administrative actions based on the rules of administrative procedures. From the procedural point of view, the administrative subject should ascertain facts and collect evidence before making decisions or rulings, and if necessary, the administrative subject should listen to the opposing person's opinion before making decisions that are detrimental to the opposing person. Due to this kind of administrative procedural rule, in which the evidence is obtained first and then a ruling is made, the administrative subject should have obtained a sufficient factual basis and legal basis before making a specific administrative act, otherwise it is a violation of legal process. The "sufficient factual basis" stipulated in the administrative law shall mean that there must be a corresponding factual basis for each of the reasons on which a specific administrative act is based. From this point of view, it is in conformity with the spirit of the administrative law that the examiner should at least, before making a Decision of Rejection, provide the evidence for proving that the feature is the common knowledge as asserted in the Office Action.

From the perspective of evidence law, the evidence is divided into evidence in the proceedings and evidence in the administrative procedures. The evidence in the administrative procedure is to provide a factual basis for the specific administrative actions to be made. Such a basis is unilateral and not adversarial. Due to the strong nature of the administrative subject, usually, more burdens of proof are imposed on the administrative subject before making administrative acts in administrative law.

It should be recognized that the administrative acts of patent examination have some salient features compared to general administrative acts, namely:

(1) The administrative act of patent examination includes many affirmations on technical aspects.

(2) The applicant of the patent first came into contact with the technology in the application, thus, it is indeed helpful for the examiner to ascertain the truth of the technology

by obtaining some clues from the applicant.

(3) The patent examination is an administrative procedure, but to a certain extent, it is quasi-judicial. If a patent right is granted to the applicant, then the entire public cannot use the patent during the validity period of the patent. If the patent right is not granted to the applicant, the technical information recorded in the publication text is disclosed freely and the entire society can use it without compensation. It is indeed conducive to the interests of the applicant and the public interests by providing a similar system of distribution of proofs in the judicial procedure. Only if the interests of the applicant and the public interests are fully satisfied, the examination results could be impartial.

Finally, from the perspective of patent law, the patent system is the result of continuous game between the interests of the applicant and the public interests. Through the patent system, the applicant of the patent is provided with a monopoly on the patent for several years, so that the patentee can exercise the exclusivity during the validity period of the patent, and then the technology can be used for the public as a whole after the validity period of the patent expires, so as to advance the development of social productivity. Therefore, considering the question of the distribution of burden of proof on the common knowledge in the examination of inventive step, only when the applicant's interests and the public interests in the game are analyzed, can we find a true answer that meets the needs of the socio-economic dynamics.

III. Analysis of Burden of Proof on Common Knowledge in Examination of Inventive Step in the United States (US) and Europe (EP)

(i) Practice of distribution of burden of proof on common knowledge in examination of inventive step (obviousness examination) in the US

In the Manual of Patent Examining Procedure (MPEP) in the US, there is no straight-forward provision on the issue of distribution of burden of proof on common knowledge in obviousness examination. It only stipulates the facts that the examiner should ascertain and the refutation that the applicant



should make after receiving the examination opinions.

The MPEP in US stipulates that obviousness is a legal issue based on the following factual inquiries:

(A) Determining the scope and content of the prior art; and

(B) Ascertaining the differences between the claimed invention and the prior art; and

(C) Resolving the level of ordinary skill in the pertinent art.

The examiner must strictly perform the above three aspects of resolving obligations. The ascertaining of common knowledge is implemented by (C). It is not required in the MPEP in US that the ascertaining of the above-mentioned three aspects is implemented on the evidence of the reference documents, but it must be ensured that there were written records in each aspect. The source of information is not limited to written reference documents or common knowledge in the field. Reference documents that are later than the date of invention and therefore cannot be used as the prior art can be cited to justify the level of ordinary skill in the pertinent art around the date of the invention. From the above, it can be seen that the MPEP in US does not provide straight-forward regulations for the issue of common knowledge proof in the obviousness examination, and only stipulates the resolving obligations of the examiner and the corresponding use of reference documents.

Once the examiner concludes that the invention is not inventive based on the facts, the burden of proof is transferred to the applicant. 37 CFR 1.111(b) requires applicant to distinctly and specifically point out the supposed errors in the Office's action and reply to every ground of objection and rejection in the Office action. A mere statement or argument that the Office's reliance on common knowledge is unsupported by documentary evidence will not be considered substantively adequate to rebut the rejection of inventive step by the examiner.

The MPEP also provides that once the applicant has presented rebuttal evidence, Office

personnel should reconsider any initial obviousness determination in view of the entire record.

In summary, it can be seen that in the patent system in US, the burden of proof on common knowledge in obviousness examination is not distributed to one of the examiner and the applicant, and by specifying the respective obligations of the examiner and the applicant, the level of ordinary skill in the pertinent art when the invention is made may be resolved, so as to improve the fairness of patent examination. In addition, in the patent system in US, by stipulating the reference documents involving common knowledge proof, the use of the reference documents on issues of common knowledge is strengthened. Moreover, in addition to relying on such reference documents involving common knowledge proof, the U.S. Patent Office can also obtain evidence of the level of ordinary skill in the pertinent art through technical appraisal, expert transcripts, etc., and the applicant can also provide reverse evidence by submitting witness statements, affidavits, and the like to prove that a certain feature is not the common knowledge in the art. In this way, the possibility of providing the proof by both the examiner and the applicant is ensured, so that the dispute between the two parties can be fully developed and a real investigation at the date of invention can be guaranteed.

(ii) Practice in distribution of burden of proof on common knowledge in examination of inventive step in EP

For the issue of proof on common knowledge in the examination of inventive step, the Guidelines for Examination in EP states that the state of the art may reside in the relevant common general knowledge, which need not necessarily be in writing and needs substantiation only if challenged. That is to say, when the examiner rejects the inventive step by using the common knowledge, and the applicant requests the examiner to provide the corresponding reference document for proving the common knowledge assertion in the observations, the burden of proof is transferred back to the examiner.

IV. Contrastive Analysis of Proof on Common Knowledge in Examination of inventive step in CN, US, and EP

From above, in China, there is no provision related to the proof on common knowledge in examination of inventive step, which is different from both the US and EP. In the US, there is no obligation on the examiner and the applicant to provide proof on common knowledge in the examination of inventive step, however, some points that need to be done are specified, and the parties' proofs can be ensured through various means. In EP, the principle of transfer of proof on common knowledge in examination of inventive step is directly stipulated. In addition, the practices of the US and EP in this respect are somewhat common, that is, they do not simply distribute the proof on common knowledge in examination of inventive step to the examiner or applicant unilaterally, but reasonably distribute the burden between the examiner and the applicant. This is a result of a comprehensive consideration of the examiner's favorable position in the collection of evidence, the complexity of the technical determination, and the degree of understanding of the applicant in the field to which the application belongs.

V. Judicial Advice on Proof on Common Knowledge in Current Examination of Inventive Step in China

Since the 1990s, China has entered the era of mobile phones and the Internet. From the perspective of the characteristics and ease of inventions since the entry into the electronic age, the current situation in China and the contemporary society in the United States have already had some similarities. This can be seen from the current surge in applications for electronics field in the Chinese patent office. Many applications are merely the technical integration and reflection of minor changes in ideas. However, some problems about subsidiary nature of standard patents in current industry in China also reveal that there are some problems existing in current examination standards relating to inventive step in China that hinder the progress of the industry. The author believes that as early as possible, obligations of resolving the technical aspects of the technical field at the time of filing date by the examiner and the applicant in the

examination of inventive step should be established in the Examination Guidelines or related regulations, so that the patent examination will be rationally performed with a balance between the interests of the applicant and the public interests, which is very important for the current development of social productivity.

In addition, the author believes that due to the particularity of patent examination in terms of technical recognition and the particularity that the patent examination belongs to an administrative procedure but with quasi-judicial, in the Examination Guidelines, it is inappropriate to definitely stipulate the burden of proof on common knowledge in examination of inventive step, and only certain resolving obligations that the examiner and the applicant should perform respectively should be specified. Due to the fact that specific technologies vary widely, the distribution of obligations for resolving the common knowledge in specific cases varies with technology. Since it is impossible to make very clear provisions on the distribution of obligations for resolving the common knowledge, it is imperative to supplement the incompleteness of such provisions by other means. In the US, it is supplemented by methods such as signing by experts on the examiner side, witness testimony on the agent side, and affidavit. In China, it lacks of provisions in the Examination Guidelines on the effectiveness of witness testimony, affidavits, etc., and the testimony and affidavit of an ordinary person cannot really provide a convincing effect on the determination of the level of common technology in the field. Therefore, the author believes that in China, it is one of possible approach of increasing the support of social intermediary appraisal agencies, and clarifying the role of the appraisal agency's appraisal conclusions for the examination of inventive step in the Examination Guideline.



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