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Soothing headaches surrounding the issue of common knowledge

In patent examination practice in China, particularly when the issue of the inventiveness of a patent is involved, there is disagreement between examiners and applicants as to whether certain distinguishing technical features (or combinations of features) are “common knowledge”, causing great headaches for applicants.

Regarding common knowledge, examiners will often use “commonly used technical means”, “conventional choice” and “conventional design”, which essentially mean the same thing. However, there is no definition of common knowledge to be found in the Patent Law or its Implementing Rules, with only the following few instances provided in the Patent Examination Guidelines.

In a substantive examination. Part 2, substantive examination, of the guidelines specifies that an examiner can determine the inventiveness of a claim by bringing in “common knowledge” and taking into account the reference documents. Furthermore, chapter 8 of part 2 of the guidelines specifies that the common knowledge of the art in the office action by the examiner should be accurate. When the applicant objects to the common knowledge cited by the examiner, the examiner should be able to explain their reasons or provide supportive pertinent evidence.

In a re-examination or invalidation process. Section 2 of part 4 of the guidelines mentions that, in a re-examination process, “in the course of a collegiate examination, the collegiate board can determine whether a technical means belongs to common knowledge of the art, and may introduce such common knowledge evidence as that in technical dictionaries, technical manuals, textbooks, etc., into the examination.” In the section on cross-examination, examination and verification of evidence of section 8 on the patent invalidation process in part 4, the guidelines specify that “a party that asserts that a certain technical means is common knowledge in the field in question has the burden of proving such assertion”.

Instances of determinations

During an examination, the examiner will use a large volume of “common knowledge” while



considering the reference documents to determine the inventiveness of a claim. The specific means of bringing in common knowledge are as below:

1. The distinguishing technical feature between claim and reference document 1 (or further considering reference document 2 or 3) is A, and A is common knowledge (or a commonly used technical means, or it is readily conceivable);
2. The distinguishing technical features between claim and reference document 1 (or further considering reference document 2 or 3) are A and B. The examiner deems A to be common knowledge and B to be a commonly used technical means, or that B can be readily conceivable, given the technical teaching of reference document 2;
3. The distinguishing technical features between claim and reference document 1 (or further considering reference document 2 or 3) are A, B and C. The examiner deems A to be common knowledge, B to be a commonly used technical means (or that B can be readily conceivable, given the technical teaching of reference document 2) and C is also common knowledge or a commonly used technical means.

In the face of these circumstances, we would recommend that an applicant, when responding to an office action about common knowledge, first note whether the reference documents contain teaching concerning the applicable technical features A and B. If there is no such technical teaching, then feature A or B is not common knowledge.

Second, the combination of the distinguishing technical features A, B, C, etc., should be questioned. In the office action, the examiner will point out that the distinguishing technical features of the claim and the reference documents are A, B, C, etc., and then deduce the corresponding technical issues that each of these distinguishing technical features is meant to resolve. The examiner will then conclude that these distinguishing technical features are common knowledge, or commonly used technical means, and thereby affirm that the combination of this common knowledge and the reference documents results in the claims lacking inventiveness.

In the face of such an examination opinion, the applicant needs to analyse the function and technical effect of each feature A, B, C, etc., in the reference documents and whether the reference documents contain teaching on the combination of these features. In particular, whether the reference documents contain teaching combining common knowledge A, B, C, etc., and whether the reference documents need to be analysed, because such combinations are generally



difficult to realise.

Finally, the time factor regarding the distinguishing features A, B, C, etc., should be questioned. The applicant should call to the examiner's attention, or state their opinion, that the distinguishing technical features A, B, C, etc., may not have been common knowledge prior to the filing date.

Two points to consider

The bringing in of common knowledge should be consistent. From the provisions on the examination process and the reexamination and invalidation processes in the guidelines, it can be seen that the requirements regarding bringing in common knowledge in the examination process and in re-examination and invalidation are not the same. The bringing in of common knowledge in an invalidation process requires the presentation of evidence by the party bringing it in. Accordingly, if the applicant questions such common knowledge in an examination process, it is recommended that the applicant request that the examiner present evidence.

Appropriately draw on international experience. In the US, an examiner is not required to present evidence of a feature that can easily be determined to be common knowledge. However, if an applicant questions a finding of common knowledge, the examiner must present evidence explaining why a certain feature is common knowledge.

Japan's patent office has specifically defined known art (conventional art), and requires examiners, when bringing in known art, to provide to the extent possible documentation, except in cases where doing so is not necessary. When an applicant raises an objection to known art, although the examiner is not expressly required to provide documentary evidence, it is nevertheless recommended that he or she provide such evidence.

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