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AFD China Won Asia IP Awards 2020

Recently, the reputable intellectual property magazine *Asia IP* published the winners of the latest Asia IP Awards.

Because of "comprehensive, spot-on and one-stop services" and good feedback from existing clients, AFD won the title of "Patent Firm of the Year".

<http://afdip.com/index.php?ac=article&at=read&did=3619>

Law and Juridical Interpretation for Public Comment

The National People's Congress released a draft of the Copyright Law for public comment. Comments are due by June 13, 2020.

<http://www.npc.gov.cn/flcaw/userIndex.html?lid=ff80808171ba0ccc0171be96df3a02b0>

The Supreme People's Court released a revision of the "Provisions on Several Issues Concerning the Administrative Cases on Patent Validity for public comment. Comments are due by June 15, 2020. The formal juridical interpretation is scheduled to be released in August 2020.

<http://www.court.gov.cn/zixun-xiangqing-227631.html>

SAMR Details IPR Protection Tasks for 2020

The State Administration for Market Regulation has released an action plan on protection of intellectual property rights (IPR), detailing major tasks for 2020.

The plan called for further improvements in law enforcement to make the process more effective and professional, with enhanced cross-regional cooperation and tougher punishments on illegal activities.

More focus will be placed on major marketplaces with frequent IPR infringements and the Internet, as well as on commodities that concern public health and safety.

In recent years, Chinese authorities have intensified crackdowns on IPR infringements. The country now ranks the 14th in the global innovation index issued by the World Intellectual Property Organization and the 31st in the ranking of ease of doing business according to a World Bank report.

<http://english.cnipa.gov.cn/news/iprspecial/1148239.htm>

Survey Shows People's Satisfaction on China's IP Protection Improved in 2019

The National Intellectual Property Administration surveyed rights owners, professionals and the public for their opinions on China's efforts for IP protection in 2019.

Results showed that the country scored 78.98 out of 100 in terms of overall IP satisfaction last year, up 2.1 points from 2018. Among the respondents, rights owners were the most satisfied.

Most people surveyed expressed hopes of further crackdowns on infringements and an increase in the efficiency and amount of compensation for infringement damages.

<http://english.cnipa.gov.cn/news/iprspecial/1148592.htm>

SUPPLEMENTARY ISSUE

Guangzhou IP Court Sides with Italian Furniture Maker in Design Patent Dispute

Recently, Guangzhou IP Court made a first- instance judgment on a design patent infringement case between the Italian company Giovannoni Design S.R.L and Dongguan Boyuan Rotational Molding Technology Company and held that the design of the rabbit- shaped products Boyuan manufactured is similar to the design patent titled "CHAIRS" (Patent Number: ZL201530388869.3) and owned by Giovannoni and infringes Giovannoni's design patent right, ordering Boyuan to cease infringement and indemnify 80,000 yuan in damages.

In October, 2015, Giovannoni filed the application of the patent in dispute to the then- State Intellectual Property Office (SIPO), which would be granted on January 20, 2016 for use on furniture. The key feature of the design patent is the shape of the product, that is, the long-eared rabbit shape.

At the beginning of 2019, Giovannoni found that LED colorful and glowing- rabbit chairs, children's stools and creative bar stools as props for large- scale activities during Mid- Autumn Festival (alleged infringing products) sold by Boyuan on the Alibaba's e- commerce platform fell into the claimed protection scope of its design patent, infringing its patent rights. Giovannoni then filed the case at Guangzhou IP Court, requesting the Court to order Boyuan to stop manufacturing, selling and offering to sell the alleged infringing products and to indemnify 335,000 yuan.

Boyuan argued that firstly, the alleged infringing products belonged to decorative lighting and were different from the patent products in function and type. Secondly, the attached drawing of the design patent certificate was not the same with the one of the alleged infringing products. Thirdly, the features of the patent in dispute did not meet the conditions required for grant of a design patent. At last, Boyuan Company sold only two kinds of the alleged infringing products, and neither sold infringing products in large volumes nor gained notable profits. The damages Giovannoni asserted were too high.

Guangzhou IP Court held that the patent products are chairs, belonging to furniture. The alleged infringing products are called glowing rabbit shaped chairs in Boyuan's online store, which can meet the conditions as chairs considering the size of the alleged infringing products. The alleged infringing products and the design patent in dispute can be compared considering that they are identical in type. Both the design of the alleged infringing products and the patent in dispute are in long-ear rabbit shape and identical in shape and limb proportions, thus constituting similarity. In this connection, the alleged infringing products fell into the protection scope of the claims of the patent in dispute.

The Court made the above-mentioned judgment after a comprehensive consideration of the patent type, the popularity of the patent products, the nature and situation of Boyuan's infringing act and the price of the alleged infringing products.

After the first-instance judgment, Boyuan has appealed to Guangdong High Court, and CIPNews will continue to pay attention to the development of the case.

<http://english.ipraction.gov.cn/article/tc/202005/310892.html>

AVIKO Catches a Break at Second Instance over TM Registration

AVIKO, a renowned Dutch potato food maker, filed an application for registration of the No.24384025 爱味客郁金香 AVIKO TULIP and its figure trademark in 2017, but would see denials one after the other, leaving the Dutch company on a warpath to reverse them.

On May 27, 2017, AVIKO filed a registration application for the trademark in dispute to the Trademark Office (TMO) of former State Administration for Industry and Commerce, designating its use on Class 29 products including fish-based products.

After examination, the former TMO rejected the application of the trademark in dispute. According to the TMO document, the trademark in dispute constitutes similarity with No.12258410 爱味客 and its figure, No.18097228 爱味客, No.4958837 郁金香 TULIP and its figure, No.7152229 郁金香, No.9880152 郁金香 DOPTOP TULIP FOOD and its figure, No.19772528 金郁金香 and its figure, No.930632 郁金香, No.G908979 TULIP and its figure, No.G1070749 TULIP, No.13321374 TULIP and its figure (the I to X cited trademark) when used on the same or similar products.

The disgruntled AVIKO then pled a request for review to the former Trademark Review and Adjudication Board (TRAB).

On September 6, 2018, TRAB rejected AVIKO's request on the grounds that the trademark in dispute contains 爱味客 in cited I and II trademark, and TULIP in cited VIII, IX and X trademark, which constitute similarity with above cited trademarks. As the products on which the trademark in dispute was certified to be used were same or similar products with cited I, II, III, IV, V, VII, VIII, IX and X trademark, so the trademark in dispute constitutes similarity with above cited trademarks when used on the same or similar product.

AVIKO then brought the case to Beijing IP Court.

The IP Court held that the identifiable letters of trademark in dispute are AVIKO TULIP, which constitutes similarity with the cited VIII and X trademark in letter composition as their identifiable letters are TULIP. So the court dismissed AVIKO's claim, holding its registration may cause confusion among the public.

AVIKO then brought the case to Beijing High People's Court along with mails between the company's agent and the agents of the cited VIII and X trademarks on negotiating the coexistence of the trademarks and the concluded trademark coexistence agreements.

The court of second instance held that the trademark in dispute was similar to the cited VIII and X trademarks in terms of letter combinations and structure, and was used on similar goods. However, in view of the fact that AVIKO submitted the relevant trademark coexistence agreement during the second-instance trial, and that the trademark in dispute was certified to be used on potato pancakes and other goods, there was no evidence to prove that the coexistence of the disputed trademark and the VIII and X cited trademarks would prejudice the public interest. In summary, the court evacuated the first instance judgment and the review decision made by the former TRAB, and ordered China National Intellectual Property Administration to make a de novo decision.

<http://english.ipraction.gov.cn/article/tc/202005/312628.html>

"Technical Problem" as a Contributing Factor to Inventiveness Assessment

When determining whether a technology seeking protection in a patent application possesses inventiveness, an examiner usually needs to make several assessments, for example, regarding technical improvement, features and enlightenment, etc. This article discusses another important contributing factor in inventiveness assessment - the technical problem actually solved by the claimed invention.

The principle of inventiveness assessment, pursuant to the Guidelines for Patent Examination ("the Guidelines"), is that when evaluating whether or not an invention involves an inventive step, the examiner shall consider not only the technical solution itself, but also the technical field to which the invention pertains, the technical problem solved, and the technical effects produced by the invention, and treat the invention as a whole.

The Guidelines provide a "three-step method" for inventiveness assessment, which consists of a series of determinations in a specific order: (1) determining the closest prior art; (2) determining the distinguishing technical features of invention and the technical problem actually solved by the invention; (3) determining whether the claimed invention is obvious to a person skilled in the art.

Regarding step (1), the Guidelines further stipulate that "the closest prior art may, for example, be an existing technology in the same technical field as the claimed invention, whose technical problem actually solved, technical effects, or intended use are the closest to the claimed invention, and/or which has disclosed the greatest number of technical features of the claimed invention; or be an existing technology which, despite being in a different technical field from the claimed invention, is capable of performing the function of the invention and has disclosed the greatest number of technical features of the invention."

Regarding step (3), the Guidelines require assessments on whether the claimed invention is obvious to a person skilled in the art in view of the closest prior art and the technical problem actually solved by the invention.

From these requirements, it can be seen that no matter judging by the general principles or the specific rules, from determination of the closest prior art to the assessment of obviousness, "technical problem" is always a contributing factor to the inventiveness assessment.

In practice, it is often the case that the "three-step method" is over-rigidly applied. Specifically, an examiner would sometimes jump to the conclusion that the claimed invention does not possess inventiveness by following a simplistic reasoning: comparing the technical features of the claimed invention and the prior art references, determining the technical problem, pointing out the distinguishing feature, and asserting it is common knowledge or obvious. However, in essence, making the assertion requires a comprehensive analysis on the whole schemes of the claimed invention and the closest prior art, in terms of the technical fields, problems actually solved and technical effects, etc., rather than merely judging whether the distinguishing technical feature has been disclosed in the reference documents or whether it is common knowledge.

Case

One of our recent responses to an inventiveness rejection gave an example on how "technical problem" should be addressed in the assessment. In short, we compared the technical problems

and the technical schemes of the claimed invention and the prior art reference, pivoting on the different intentions behind the problem-solving approaches, and argued that the reference had not provided technical enlightenment to solving the technical problem brought up by the claimed invention. The reexamination panel accepted our arguments and ultimately revoked the inventiveness rejection.

In the inventiveness rejection, the distinguishing technical features of Claim 1 over Reference 1 were identified as: the substrate is poly-silicon; spacing between each select gate wordline and a dummy wordline is adjustable correspondingly to select-gate to core cell wordlines requirements. Based on the above distinguishing technical features, it can be determined that the technical problems actually solved by the claim are: forming a pattern on the poly-silicon substrate, and preventing accidental overlay and crosstalk with the select-gate on a core cell wordline. The examiner thought it was common knowledge in the art to use poly-silicon to prepare the substrate or the gate of a semiconductor device. In addition, it was a basic requirement in the field to prevent the crosstalk and overlay between the select-gate and the core cell wordlines. Therefore, in order to align the patterns and prevent overlay and crosstalk, a person skilled in the art could readily use the method for forming patterns having various widths simultaneously to make an adjustment, and thus obtained the technical scheme of the invention.

We couldn't agree with this understanding. We noted that the background section of the present application wrote: the spacing between a select-gate wordline and a nearest core cell wordline may vary and this inconsistency in select-gate wordline placement leads to a number of well-known difficulties in semiconductor device operation. According to Reference 1, its method, however, is to overcome problems of misalignment that may occur between wordlines having various widths while the interval/spacing between the patterns is uniform. That is, Reference 1 does not address the problem of varied spacing between the select-gate wordline and the nearest core cell wordline, which is what the claimed invention tries to solve.

Before the disclosure of the present application, a person skilled in the art did not know the technical scheme of the claimed invention, even though they might have seen Reference 1. The questions for assessing the inventiveness of the claimed invention should be: whether a person skilled in the art, having knowledge of Reference 1, faces the technical problems solved by the present application; and whether the existing technologies would give the technical enlightenment of applying the distinguishing technical features of the claimed invention to solve the technical problems. Specifically to this case, Reference 1 only realizes pattern alignment for uniform spacing between different wordlines and does not mention that for different spacing. It gives no technical enlightenment to the technical problems solved by the present application. A person skilled in the art would not have the motivation to improve the technical scheme of Reference 1 to address the technical problems solved by the present application.

Therefore, in the responses, we wrote: regarding determination of the closest prior art, prioritized consideration should be given to the technical problem actually solved, the technical effects, or the intended use, of the inventions, rather than the number of similar technical features disclosed. Reference 1 does not solve the same problem nor brings the same technical effects as the claimed invention does. It should not be deemed as the closest prior art of the present application.

We further pointed out that Reference 1 provides the technical schemes merely to the alignment of different wordlines with uniform spacing although the wordlines have different widths. It does not give any technical enlightenment on how to avoid the interference or overlap between the select-gate wordlines and the core cell wordlines. Even when the size of the semiconductor

features is gradually decreasing and a person skilled in the art has been trying to avoid interference and overlap between the wordlines, it is not easy for them to come up with the idea of setting the dummy wordlines between the select-gate wordlines and the core cell wordlines and adjusting the space between the select-gate wordlines and the dummy wordlines according to the target spacing between the select-gate wordlines and the core cell wordlines, in order to avoid interference and overlap between the select-gate wordlines and the core cell wordlines. Such a solution requires changing the setting of the mask of the etching process of the doubling patterning, so that the mask pattern can leave dummy wordlines between the select gate wordlines and the core cell wordlines. It was clearly not obvious.

As mentioned earlier, the collegial panel, after receiving and deliberating over the above-mentioned opinions, decided to revoke the inventiveness rejection.

Summary

The above handling reveals that the technical problem actually solved by the claimed invention should be identified before determining whether a particular technical enlightenment exists in prior arts, and the latter should be considered by reviewing the technical points as a whole.

Apparently, a technical problem can be solved only after it has been identified. For a person skilled in the art, the process of solving the technical problem would involve answering the question - whether the prior art gives any technical enlightenment of applying the distinguishing technical features to the closest prior art to solve the technical problem. In other words, the first step of the determination should be to find out whether the technical problem actually solved by the claimed invention has been identified in the field. If not, it means that a person skilled in the art is not aware of the technical problem before the present application, and moreover it would be illogical for them to apply any prior art and seek any technical enlightenment to solve the technical problem.

The consideration surrounding technical problem of a claimed invention functions as an indispensable step in inventiveness assessment. When determining whether a technical scheme or claim possesses inventiveness, one needs to understand and capture the role of identifying technical problem and fairly address the three-step method in order to render tenable opinions. As a patent attorney, that would be one of the most important skills that help protect the interest of clients.

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<http://www.iplink-asia.com/articles/123>