



**COPING STRATEGIES FOR TECHNICAL FEATURES IDENTIFIED AS “COMMON KNOWLEDGE” IN NOTIFICATIONS OF OFFICE ACTION**

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During substantive examination of an application for patent in China, it is nothing new that an examiner identifies some technical features in a claim as “common knowledge” in the notification of office action, thereby denying inventiveness of this whole claim. Identification in this way mainly depends on the examiner’s mental impression on the technical feature, so patent attorneys sometimes feel powerless when responding to the office actions like this, because it is hard to convince the examiner by making specific statements in response to the examiner’s viewpoint.

Regarding this situation, I have come into contact with a large number of cases in daily patent agency work, and have got some experience in dealing with it. Here, I will share my thoughts with you, hoping to give some enlightenment and help to the patent practitioners.

**1. To ask the examiner to provide evidence according to the revised *Guidelines for Patent Examination***

At times, instead of citing any evidence, the examiner merely makes declaration expression or rather simple explanation when identifying in the Notification of Office Action that some technical features of a claim belong to “common knowledge”.

Such Office Actions frequently appear in my patent attorney career of more than ten years. However, I found that the standards for determining whether a technical feature belongs to “common knowledge” in the substantive examination and reexamination of a patent application are significantly different from those after the patent is granted, such as in the stage of request for invalidation. In the stage of patent application, such determination and identification are usually made by the examiner, and are directly received even without evidence. On the contrary, after the patent is granted, for example, in the examination of the request for invalidation, the determination and identification of “common knowledge” are usually made by the petitioner for invalidation, so detailed documentary evidence is indispensable; moreover, the evidence needs to be interrogated by the patentee before the final identification is made by the three examiners together in the collegial panel. In my practical experience, sufficient evidence shall still be submitted in the request for invalidation even for proving “common knowledge” that is really obvious, and the collegial panel is very cautious and tends to be conservative



in the determination of “common knowledge”. Apparently, even if the same conclusion will be made, different evaluation standards are used by different business departments of the State Intellectual Property Office for the same situation in the examination of a patent application and the confirmation after the patent is granted, and obvious substantive differences exist in the interpretation and application of the same law.

Perhaps the State Intellectual Property Office has noticed this difference in examination standards, the State Intellectual Property Office revised the *Guidelines for Patent Examination* in November, 2019, wherein the identification of “common knowledge” in substantive examination is specifically prescribed: *“The common knowledge in the field cited by the examiner in the Notification of Office Action shall be conclusive. If the applicant raises an objection to the common knowledge cited by the examiner, the examiner shall be able to provide corresponding evidence to prove it or reasons to explain. In the Notification of Office Action, when the examiner identifies the technical features in the claims that contribute to the solution of technical problems as common knowledge, they usually should provide evidence to prove it.”*

When the examiner simply points out in the Notification of Office Action that some technical feature in the claims belongs to “common knowledge”, we can use the above provision as a “weapon” to fight back. For example, we can first judge whether the technical feature in discussion contributes to the solution of a technical problem, if so, we can explain the situation and ask the examiner to provide corresponding documentary evidence to prove it. According to my experience, facing the request of providing evidence, most examiners will provide evidence to prove it or abandon the original identification of “common knowledge”.

It should be noted that the above regulations merely require the examiner to “usually” provide evidence under limited conditions. Due to this flexible provision, the examiner does not have to provide evidence; instead of providing evidence, he or she may make explanation only. For example, it is unnecessary to provide evidence if the technical feature obviously belongs to “common knowledge”. In this case, the examiner may also give opinions from another point of view.

## **2. Patent literature cannot necessarily serve as evidence of “common knowledge”**

In order to prove that a certain technical feature belongs to “common knowledge”, the examiner may cite existing patent literature as evidence. However, not all of the patent literature can necessarily serve as evidence of “common knowledge”.

On the one hand, according to several explanations about “common knowledge” in the *Guidelines for Patent Examination*, it is merely prescribed that **technical dictionaries, technical manuals and textbooks or the like** can be used as the evidence of common knowledge. Apparently, it is not stipulated that patent literature can necessarily serve as the evidence of common knowledge.



On the other hand, as far as I can see, some examiners actually confuse the concept of “prior art” and “common knowledge” when they use patent literature as the evidence of “common knowledge”, and there are precedents in existing court decisions denying the use of patent literature as evidence of common knowledge. For instance, it is mentioned on page 13 in Administrative Judgment of 2016-Jing-73-Xing Chu No. 2378: “Common knowledge is common means in this field for solving related technical problems, or regular means disclosed in textbooks or tool books for solving related technical problems, so the scope of common knowledge should be much smaller than the coverage of the prior art. The preceding patent literature can merely show that the disclosure belongs to the prior art... If the preceding patent literature is directly regarded as equivalent to common knowledge, the inventiveness of the invention or utility model will be unattainable...”. Apparently, the disclosure of patent literature may include “common knowledge”, but cannot be directly regarded as equivalent to “common knowledge”.

In my daily patent practice, I succeeded in persuading the examiners to give up their identification of “common knowledge” by using the above reasons when the examiner cited patent literature as evidence of “common knowledge”.

### **3. Whether the common knowledge gives the teaching of combining**

Even if the technical feature is identified as “common knowledge”, the examiner tends to mention vaguely or simply gives a conclusion in the notification of office action about the teaching of combining “common knowledge” with cited reference documents. I do not agree with the examiners on this.

In my opinion, in the judgment of inventiveness, it needs to comprehensively consider whether there is technical teaching of combining the reference documents with common knowledge when their combination is used for judging inventiveness. As for this, we can start from the following aspects:

(1) Consider whether there is a technical basis of combining a reference document with “common knowledge” according to the object of the invention and the overall technical concept of the reference document

Sometimes, the distinguishing technical feature of the claim relative to the reference document belongs to “common knowledge”, but this distinguishing technical feature may happen to be a technical solution that is avoided on purpose in the technical concept of the reference document, or is contrary to the object of the invention and will lead to a failure of realizing the object of the invention once the distinguishing technical feature is adopted. In this case, even if the distinguishing technical feature belongs to “common knowledge”, it does not mean that one can think of combining this “common knowledge” with the reference document without paying creative effort.



(2) Technical bias against the prior art including “common knowledge” makes it impossible to think of using “common knowledge”

In the cognition of prior art, known technical defects exist if the distinguishing technical features of claims relative to the reference documents serve as “common knowledge”, and such technical defects will adversely affect the target technical effect. Therefore, without creative efforts, a person skilled in the art will have no reasonable motivation to combine this “common knowledge” into the reference document.

(3) Whether the combination of the reference document with “common knowledge” can realize the object of the application for patent as well as the technical effect of the distinguishing technical feature

The object of the invention in the application for patent is to overcome the technical problem existing in the prior art, and relies on the technical effect that can be realized by the combination of the distinguishing technical feature with other technical features in the overall technical solution. If this technical effect cannot be realized when the distinguishing technical feature alone serves as “common knowledge”, then it cannot be simply considered that the same technical effect can be realized through the combination of “common knowledge” with the reference document.

(4) The relevance of combination should be taken into consideration when multiple distinguishing technical features exist in the claim belong to “common knowledge”

To my way of thinking, in the consideration of inventiveness of a technical solution, instead of simply extracting a technical feature and comparing it alone with different prior art, the technical effect that can be produced by each technical feature in the technical solution should be considered in the overall technical solution. Even if multiple distinguishing technical features belong to “common knowledge”, it needs to consider whether **the combination** of these distinguishing technical features still belongs to “common knowledge” and whether this combination can bring about the technical effects that intended to achieve by the patent application, rather than separating each distinguishing technical feature from the overall technical solution and judging its technical effect by comparing it with different prior art.

### **Postscript**

This article introduces some coping strategies and methods when a technical feature is identified as “common knowledge” in the notice of office action in the substantive examination. However, the circumstances of different cases are in endless variety in practice, and the interpretation and application of the law will also continuously evolve over time, so the seemingly identical coping strategy can have different variations, which requires patent attorneys or other patent practitioners to analyze specific situations and choose suitable methods to try.