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Technical problem actually solved in
assessment of inventiveness should be
properly generalized

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On September 27, 2019, the Intellectual Property Court of the Supreme People's Court ("SPC IP Court") renders a judgment (2019) Zui Gao Fa Zhi Xing Zhong No. 32, confirming the validity of a utility model (UM) patent, ZL201520439003.5, titled "Photovoltaic module and automatic cleaning device thereof". This case is selected as one of the 36 exemplary cases concluded by the SPC IP Court in 2019 for its significance in clarifying the rule on how to determine a technical problem actually solved in assessment of inventiveness.

Facts:

On January 30, 2018, Shandong HAOWO Electronic Co., Ltd. ("HAOWO") filed an invalidation request before the Patent Reexamination Board ("PRB") against the UM patent owned by Kashi BOSI Photovoltaic Technology Co., Ltd. ("BOSI").

On July 24, 2018, the PRB issued a decision ("litigious decision") maintaining the validity of the UM patent, holding that claim 1 involves an inventive step over the combination of the prior art, namely, D1 (CN203987878U) + D2 (CN203417873U) + common knowledge/D3 (CN1605313A)/D5 (W02014/185082A1).

HAOWO filed an administrative lawsuit before the Beijing IP Court. On January 29, 2019, the Beijing IP Court made a judgment (2018) Jing 73 Xing Chu No. 9181, revoking the litigious decision, finding that the UM patent is not inventive over the combination of the prior art, namely, D1 + D2 + D3/D5.

The PRB and BOSI filed an appeal against the judgment of the Beijing IP Court ("1st-instance judgment") before the SPC IP Court. On September 27, 2019, the SPC ruled that the litigious decision was not only clear on fact findings but also correct on law applications, thereby revoked the 1st-instance judgment. The validity of the UM patent was eventually confirmed by the SPC IP Court.

Court Holds:

The SPC IP Court held that in assessing inventiveness of the invention, the technical problem actually solved by such invention should be determined based on the role, function or technical effect of the distinguishing technical features of the invention. The technical problem actually solved cannot be overly generalized, thus underestimating inventiveness of an invention, nor can it be simply equated to the role, function or technical effect of the distinguishing technical features so that inventiveness would be overestimated. To determine the technical problem actually solved, a proper generalization should be made on the basis of the actual role, function or technical effect of the distinguishing technical features.

Though the SPC IP Court found that the PRB did not properly generalize the technical problem actually solved, namely, how to make the automatic cleaning device move along photovoltaic panels to be cleaned without being jammed by the uneven edges of panels, the lapse did not directly affect the assessment of inventiveness. The SPC IP Court, on the other hand, held that the 1st-instance judgment overly generalized the technical problem actually solved, i.e., how to ensure the cleaning device move normally. The SPC IP Court gave a further analysis as follows. Those skilled in the art are generally aware of the fact that many factors may affect normal movements of a device for cleaning photovoltaic panels, such as the walking unit or driving unit of the cleaning device, the unevenness caused by the change of width in photovoltaic panels within a certain range, the varying height of photovoltaic panels caused by the terrain, or even the cleaning unit itself. Each problem may correspond to a different solution. A technical problem actually solved, if being overly generalized, will obviously

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lead to erroneous assessment of inventiveness. Based on the above reasoning, the SPC IP Court ruled to overturn the 1st-instance judgment.

Comments:

The Guideline of Examination (2001) introduced for the first time the so-called “three-step approach” for assessing inventiveness. Determination of the technical problem actually solved is an essential part of the second step. The Guideline of Examination set forth that in principle the technical problem actually solved should be determined based on the technical effects of the distinguishing technical features. However, in absence of detailed criteria, determination of the technical problem actually solved could be subjective or even arbitrary in practice.

It is therefore very welcome that the SPC IP Court establishes a practical rule for determination of the technical problem actually solved in this case. That is, rather than overly generalized, it shall be a proper generalization based on the actual role, function or technical effect of the distinguishing technical features. The SPC IP Court affirmed that it is not a proper generalization to equate the role, function or technical effect of the distinguishing technical features to the technical problem actually solved, yet it did not elaborate on to what extent will a generalization be deemed proper, which awaits to be further clarified in future judicial practice.