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# Wisdom News

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## Taiwan

### Taiwan IP Court on Teaching Away in Obviousness Determinations: *Phoenix Silicon International Corporation v. Integrated Service Technology Inc.*

The Taiwan Intellectual Property Court (IP Court) reaffirmed its principles on determining teaching away in its *2019 Mingzhuansuzi No. 88 Civil Judgment,* stating that teaching away occurs when relevant references "expressly disclose or substantially imply" teachings or suggestions on excluding the claimed invention. Therefore, if the disclosure in the references is not clear enough to be considered as teaching away from the invention, responding to obviousness decisions with teaching away as the main argument may lead to unfavorable results in court.

#### Case Facts

Phoenix Silicon International Corporation (Patentee and Plaintiff, "Psi") is the patentee of the invention patent "MANUFACTURING PROCESS OF WAFER THINNING" (Patent No. I588880, "'880 patent"), accusing Integrated Service Technology Inc. ("iST") of patent infringement. The IP Court dismissed the case after finding claims 1 and 2 of '880 patent obvious.

#### Main Point of Argument

'880 patent relates to a manufacturing process of wafer thinning, including steps of grinding, etching, cleaning, and drying. The Defendant, iST claimed that claim 1 of '880 patent can be easily proven obvious over the combination of (a) References 14 and 24, or (b) References 14, 24, and 25, or (c) References 14 and 26. Psi, however, stated that the references cited involved teaching away from one another, and that they could not be combined to prove '880 patent obvious.

#### IP Court's Opinion

The term "teaching away" originates from the U.S. patent practice. A prior art reference teaches away when it discourages, criticizes, or discredits the solution claimed for technical or safety reasons, or when the person skilled in the art, upon reading the reference, would be led

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in a direction divergent from the path that was taken. That is, what is disclosed in prior art would discourage a person skilled in the art to carry out the claimed invention, which is an advantage when determining the non-obviousness of the invention. However, judging by scientific principles or the technical field applied, prior art references and the claimed invention differ in the features, conditions, or suitable ranges of the technical means. Science and technology advance on the basis of an accumulation of experiments or trial and error. Teaching away is established only if the uncommon claims in prior technology are extreme unscientific errors that discourage, criticize, or discredit the solution claimed, or if a person skilled in the art would be led onto a divergent path. Otherwise, it is difficult to claim that prior art references "teach away" from the claimed invention merely for the difference between their technical features. The prior art with different technical features, or the experiments accumulated and trial and errors of the uncommon claims shall be seen as teachings or knowledge from another perspective, and not be used to infer that prior art or the uncommon claims naturally teach away and further conclude that the claimed invention is not obvious.

Below is the IP court's determination on the Psi's argument that prior art references teach away from the claimed invention:

| | Psi's argument | IP Court's opinion |
|---|---|---|
| 1 | Reference 24 considers forming a protective film a disadvantage in the manufacturing process. Thus, it teaches away from the wafer-taping process disclosed in Reference 14 and '880 patent. | Reference 24 discloses that spin-cutting has the advantage that it is unnecessary to form a protective film or the like on a surface which does not require etching. Although Reference 14 discloses forming a protective tape on a surface that does not require etching, a person skilled in the art would be motivated to decide whether to form a protective film on said surface based on his or her needs. |
| 2 | The etchant used in the etching process of References 14 and 24 are acidic, while Reference 25 teaches away as it discloses using acid washing with alkali etching. | Reference 25 discloses that the metal contaminant-removal step involves acid washing by using an aqueous solution of HF. After the etching process of References 14 and 24, a person skilled in the art would naturally consider the acid washing step using an aqueous solution of hydrogen fluoride if there is a need for removing metal contaminants. |
| 3 | Reference 26 has excluded the grinding process. With etching, | The replacement of grinding with etching in Reference 26 is only intended for surface-treating. |

| | Psi's argument | IP Court's opinion |
|---|---|---|
| | Reference 26 has achieved a roughness similar to that obtained through grinding, and thus would not consider combining the etching process in Reference 14. | Reference 26 does not discourage a person skilled in the art to use grinding in other steps of the manufacturing process. |

## Wisdom Suggested Strategies

Ever since the strict rules on determining "teaching away" in U.S. law are adopted in Taiwan on 1 July, 2017, there has been a considerable decrease in cases that constituted teaching away. An example is given in the Taiwan Patent Examination Guidelines:

> *"When determining whether prior art teaches away from the claimed invention, the nature of the teaching must be weighed in substance. For instance, the claimed invention is an epoxy resin based printed circuit material. A prior art reference disclosed a polyester-imide resin based printed circuit material, and taught that although epoxy resin based materials have acceptable stability and some degree of flexibility, they are inferior to polyester-imide resin based materials. Since the prior art reference did not teach that epoxy resin based materials cannot be used as printed circuit material, namely, it did not teach or suggest to exclude the claimed invention, it does not constitute a teaching away from the claimed invention."*

Because most literatures differ in effect or performance, the existence of new materials or methods does not necessarily imply that past materials or methods cannot be used or combined. Unless a prior art reference expressly discourages or criticizes the solution claimed, it would not constitute a teaching away.

For the combinations of several prior art references with considerable technological differences, if the responding party responds on the grounds that prior art references constitute "teaching away" while the references do not expressly discourage or criticize the solution claimed, the focus would be wrongly shifted onto the argument of whether "teaching away" is found. In light of this, the responding party should avoid the term "teaching away," and instead discuss the difficulty in combining references due to difference in technical ideas. This approach would be able to prevent defeat in court that results from wrongly resorting to teaching away as a response strategy.

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