

Appeals against CNIPA invalidation decisions: representative cases

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In the final part of a series on challenging patent invalidation decisions in China, lawyers at Spruson & Ferguson and Marshall Gerstein share how courts adjudicate appeals

As discussed in our [previous article](#), appeals against CNIPA invalidation decisions proceed through a structured judicial framework, beginning with the Beijing Intellectual Property Court and potentially continuing to the IP Tribunal of the Supreme People's Court.

While that procedural structure defines how appeals are heard, the courts' reasoning in individual cases provides clearer insight into how challenges succeed or fail. The following representative cases illustrate how Chinese courts analyse both procedural violations and substantive technical issues when reviewing patent invalidation decisions.

Here we describe a few cases to illustrate how the courts adjudicate appeals of Patent Re-examination and Invalidation Board (PRB) invalidation decisions and which factors may affect the courts' conclusions.

Case one

This case illustrates how procedural issues may be resolved in court appeals.

A petitioner requested to invalidate the Chinese Patent No. CN201280035267.3 based on the grounds that the claims lacked an inventive step over several combinations of prior art publications and common general knowledge (CGK). In particular, the petitioner alleged that the claims lacked inventive step over the following three combinations of prior art—each referred to as D1, D2, D3, etc.:

- Combination of D1, D2, and common knowledge;
- Combination of D1, D3, and common knowledge, and;
- Combination of D1, D2, D3, and common knowledge.

The PRB agreed with the petitioner and declared all claims of the patent invalid. The PRB specifically agreed with the petitioner's ground that the claims lacked inventive step in view of the second prior art combinations listed above.

During the oral hearing, however, the petitioner had abandoned that ground of attack (2nd combination). The patentee therefore appealed the PRB's decision to the BIPC.

In its appeal brief, the patentee argued that the PRB violated the request principle prescribed in the Guidelines of Patent Examination, because the petitioner had explicitly abandoned the ground on which the PRB declared the claims invalid. Further, the PRB had not given the patentee an opportunity to challenge this ground before it issued the unfavourable decision. The PRB also violated the hearing principle prescribed in the guidelines.

Upon review, BIPC confirmed that the PRB had violated the principles of request and hearing during examination and issued an Administrative Judgment that revoked the PRB's decision, remanding the matter to the PRB to render a new decision.

CNIPA and the third party (the petitioner) did not appeal the BIPC's decision to the SPC. Later, the petitioner submitted a written statement to the PRB withdrawing the request of invalidation, and the PRB issued a 'Notice of Closure of the Invalidation Case.'

Thus, the patent in question remains valid.

Case two

This case illustrates an instance where the SPC reversed decisions from the BIPC and PRB as those decisions failed to offer the patentee adequate notice and right to be heard (referred to as the 'principle of hearing').

A petitioner filed a request to invalidate the Chinese Patent No. ZL99804256.0. The PRB decided that the patent claims lacked inventiveness and declared the patent invalid.

The patentee appealed the PRB's decision to the BIPC, requesting the BIPC revoke (reverse) the PRB's decision. The patentee argued that the petitioner only stated in its request that the claims lacked novelty over a single prior art publication, and on this basis, the claims also lacked inventiveness over the same publication without providing any further specific reasons for lacking inventiveness.

During the oral hearing before the PRB, the petitioner did not present any specific reasons why the claims lacked inventiveness. The PRB nevertheless declared claim 1 invalid on the ground that it lacked inventiveness over a prior art publication (evidence 2) in view of common knowledge, offering reasons that were never articulated during the oral hearing.

The PRB, as defendant, argued that 1) the invalidation request included a statement that a person skilled in the art can achieve the technical solution of claim 1 based on evidence 2 and the common knowledge; 2) the invalidation request were delivered to the patentee; 3) the patentee therefore had an opportunity to comment on the inventiveness of claim 1 with evidence 2 as the closest prior art during the oral hearing.

The BIPC affirmed the PRB's decision and ruled that the PRB did not violate the principle of hearing, explaining that the third party (the petitioner) mentioned the lack of inventiveness of claim 1 by combining evidence 2 and common knowledge, and the defendant (the PRB) investigated whether common knowledge can be used to assess the inventiveness of claim 1 with both parties, according to the records of the oral hearing.

The patentee then appealed the BIPC's decision to the IP Tribunal of the SPC, arguing that the PRB and BIPC violated principles of law that require the patentee to be offered fair notice of the basis for invalidity attacks and that neither the PRB nor the BIPC afforded the patentee such opportunities to fairly defend validity.

The SPC further looked into the case history, specifically the records of the oral hearing during the invalidation proceedings, and held that: 1) the third party (invalidation petitioner) simply mentioned that claim 1 lacked an inventive step in its argument that the claim was not novel over evidence 2, without providing any specific reasoning in either the invalidation request or the further statement during the invalidation proceeding, the patentee therefore had no basis to argue against; 2) during the oral hearing, the PRB only checked if there is any differences between claim 1 and evidence 2, and did not investigate if claim 1 lacks inventiveness over evidence 2 and the common knowledge, nor provided the patentee an opportunity to defend; 3) while the third party explained how evidence 2 and common knowledge establish a lack of novelty of claim 1, the third party never explained how the same combination established that claim 1 lacked inventiveness.

As a result, the SPC reversed (revoked) the BIPC's decision and the PRB's decision. The SPC directed the PRB to notify the parties of the reasons, evidence and facts on which its invalidation decision was based, and offer the parties an opportunity to explain and express their opinions on the relevant reasons, evidence and specific facts, especially before making a new decision unfavourable to either of the parties.

Case three

This case illustrates how the courts address substantive appeals of PRB decisions.

A Chinese pharmaceutical company (petitioner) filed a request to invalidate Chinese Patent No. ZL99815926.X, which is owned by a Swedish company. The issue in this case was whether the substitutions of a few groups in a general chemical formula belong to common knowledge or common technical means, and whether the post-filing data is acceptable to support the claim.

The PRB, in its invalidation decision, acknowledged that claim 1 of the targeted patent differs from the prior art document D1 by two substitutions (referred to below as substitution 1 and substitution 2). With respect to substitution 1, the PRB determined that it constituted routine technical means, and relying on several pieces of evidence submitted by the petitioner to support this conclusion, held that such substitution did not achieve any unexpected technical effect. With respect to substitution 2, the PRB found that it was explicitly taught by D1.

The PRB further determined that supplementary experimental data submitted by the patentee was inadmissible, because the said technical effect was only mentioned in the background section of the specification without supportive data in the filed application, making it impossible for a person skilled in the art to predict such an effect only based on the specification. Consequently, the PRB declared the patent invalid. The patentee then appealed that decision to the BIPC.

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In its appeal brief, the plaintiff (patentee) argued:

- For substitution 1, the evidence used by the PRB related to compounds that had different core structures from the claimed compound and had different targeting molecules, with one example even teaching away from the substitution as it resulted in contrary activity. In addition, the corresponding group in the compound disclosed in the prior art (D1) was located in the core structure and thus was not a variable that could be substituted.
- For substitution 2, there is prior art evidence indicating that the two groups have significant differences in properties.
- The PRB wrongly disregarded the post-filing data the patentee provided, as the technical effect demonstrated by such data had been sufficiently referenced in the specification of the filed application.

However, the BIPC did not find the above arguments persuasive.

For substitution 1, the BIPC determined that the compound of D1 and the claimed compound had the same core structure, and the corresponding groups in these two compounds are both commonly used in the art. Moreover, according to the data provided in the description of the patent, the claimed compound did not bring about any unexpected technical effect.

For substitution 2, the BIPC reached the same opinion as the PRB, that D1 sufficiently (and explicitly) teaches the substitution.

For the post-filing data, the BIPC agreed with the PRB's opinion that the technical effect demonstrated by such data cannot be explicitly determined from the description of the patent.

The patentee further appealed to the Beijing High People's Court (BHPC), a second instance court that had reviewed patent cases before the IP tribunal of the SPC was established. The BHPC held that:

- Regarding substitution 1, the PRB's conclusion was wrong due to the differences between the structures of the compound of D1 and the claimed compound. The BHPC supported the patentee's opinion that the corresponding group of the compound of D1 was part of the core structure of the compounds and thus was not variable. The PRB was wrong to interpret it as a variable group, which violated the common understanding of those skilled in the art.
- Regarding substitution 2, D1 provided an explicit technical hint. Therefore, this substitution was obvious to those skilled in the art. That is, the BHPC supported the opinions of the PRB and BIPC.
- The BHPC agreed with the PRB and BIPC that the description of the patent did not recite the effect demonstrated by the data as one of the functions/properties of the claimed compounds.

Despite some agreement with the BIPC/PRB, the BHPC still revoked the PRB's decision and the BIPC's judgment due to its wrong conclusion on substitution 1 (reason 1) and ordered the PRB to render a new decision.

From the BHPC ruling, it can be seen that the plaintiff can overturn the previous ruling/decision based on even only one factual defect therein. Further, whether the post-filing data are acceptable greatly depends on whether the effect demonstrated by the data has been disclosed in the patent specification as an intended technical effect. For chemical compound structures and the substitutions thereof, examiners should focus on the compounds having the same core structure for comparison and inventiveness evaluation.

Concluding remarks

The above cases demonstrate that the court's (BIPC's or SPC's) logic in reversing (revoking) a PRB decision primarily focuses on procedural violations and substantive errors.

In terms of procedures, the PRB must comply with the principle of hearing (giving the relevant party a chance to make explanations for adverse grounds that would lead to an unfavourable decision) and principle of request (examination based on the petitioner's grounds/evidence).

In terms of substantive issues, such as "whether the claims are supported by the description," "whether the patent features are obvious over the prior art," and "whether the description is sufficiently disclosed," the courts will thoroughly review all the evidence and correct any incorrect judgment regarding key technical questions, if any.

These exemplary cases demonstrate the judicial remedy obtainable via appeal of administrative actions, ensuring that patent confirmation procedures adhere to procedural justice, conform to technical facts, and balance the interests of patentees and the public.

While the above information is intended to provide a general framework, it's important to note that each trial is highly case-specific—no two cases are alike. The above information is intended to explain and illustrate common procedures and dispositions that the reader may analogise to opposition and invalidation procedures in other jurisdictions (e.g., Europe, Japan, and the US).

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[SP1] You should include a new paragraph that explains what the PRB decided and its reasoning. Only then will the remainder of the case explanation make sense to the reader as there are lots of details that seem to be missing.

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