

Study on Supreme Court Decision on 2017Hu2291

1. The Subject Case

Case No.: 2017Hu2291

Subject patent: Korean Patent No. 10-1026295 B1 "Massaging cup having dual structure for massage apparatus"

Date of decision: May 28, 2020

2. Gist of the Decision

Whether the target invention has been identified where the description of the invention includes unclear portions or there are drawings that are not consistent with the description

In a confirmation trial for the scope of a right, the target invention (the invention compared with the patented invention the scope of which is to be confirmed) needs to be identified in detail to the extent that it can be compared with the patented invention. It also should be identified in detail to the extent that it can be distinguished from others as a subject to be confirmed as to whether it is in the scope of the patented invention in light of common knowledge (see Supreme Court Decision on 2010Hu3356 of September 8, 2011, etc.)

Even when the description of the target invention has unclear parts or drawings that are not consistent with the description of the invention, the target invention is deemed to be identified if it can be determined whether or not the target invention is in the scope of the patented invention in consideration of the other parts and drawings of the description of the target invention (see Supreme Court Decisions on 2010Hu3356 of September 8, 2011 and 2010Hu296 of May 27, 2010, etc.)

3. History of the Case

(1) The defendant, which is the patentee, filed a positive confirmation trial for the scope of a right (Trial No. 2016Dang2965) with the Intellectual Property Trial and Appeal Board (IPTAB) against the plaintiff, arguing that the target invention is in the scope of claims 1, 2, 4, 5, 8 and 9 of the patented invention.

(2) On December 28, 2016, the IPTAB issued a decision that dismissed the defendant's arguments about claims 2, 5 and 8 of the patented invention and that accepted the arguments about claims 1, 4 and 9 of the grounds that the target

invention was not publicly known art and it was in a use relationship with claims 1, 4 and 9 of the patented invention, but not with claims 2, 5 and 8.

(3) Against the decision, the plaintiff filed a petition for cancellation of the decision, asserting that the target invention is not in the scope of claims 1, 4 and 9 of the registered invention.

(4) The original decision (the Patent Court) found that the target invention was not in the scope of claims 1, 4 and 9 of the patented invention on the grounds that the target invention was not deemed to be in a use relationship with claims 1, 4 and 9 of the patented invention (to cancel the trial decision).

(5) The defendant filed an appeal against the decision.

4. Supreme Court's Decision

Before deciding on the merit of the case, the Supreme Court reviewed whether the target invention is identified.

(1) As a feature corresponding to the feature of claim 1 of the patented invention that "in a plurality of skin contact portions, the inner side is set higher than the outer side," the defendant cites the disclosure of "the inner cup is positioned inside the outer cup and the end of the inner cup is formed to be about the same height as the end of the outer cup," and uses the unclear expression "about," and it can be deemed that, among the drawings of the target invention, Fig. 3(c) is where the inner cup is positioned above the outer cup.

(2) When the description of the drawings of the target invention as identified by the defendant are considered as a whole, the following can be understood: the inner cup is connected to the lower portion of the cylindrical main body via the elastic connection film having elasticity; accordingly, depending on the direction of the force applied by contact with the skin, the elastic connection film is bent to possibly cause the inner cup to move up or down with respect to the position of the outer cup, which is fixed, and when the force applied to the inner cup is removed, the position of the inner cup is brought back to the initial position by elastic force; and when no force is being applied to the inner cup, the ends of the inner cup and the outer cup are at the same height.

(3) It can be deemed that Fig. 3(c) of the drawings of the target invention shows that the inner cup is positioned above the outer cup, but in light of the disclosures of the other description of the target invention and the other drawings of the invention, it can hardly be deemed based on Fig. 3(c) alone that the target invention

is identified in a way that is not consistent with the above-mentioned technical disclosures.

(4) In light of the above, it can be deemed that the target invention is identified in detail to the extent that it can be compared with the patented invention. Accordingly, the original decision on the confirmation of the scope of a right, which was made on the assumption that the target invention is identified legitimately, is not affected by an error of misunderstanding of the legal principles regarding the specification of the target invention or of insufficient examination.

5. Comments

A confirmation trial for the scope of a right is filed with the IPTAB to seek an official confirmation of the scope of protection for a patented invention (Article 135 of the Patent Law). The trial is useful in that it prevents a patent infringement lawsuit and results in an official decision in a swift and simple manner. However, unlike a patented invention, which has a claim that clearly describes the invention, the target invention needs to be identified first to be compared with the patented invention, because it is not written down on paper. In this regard, Supreme Court decisions provide several determination criteria about specification of the target invention, but there are some cases where a trial is dismissed for the reason that the target invention is not identified. This Supreme Court decision is meaningful in that it determines that even when the description of the target invention has an expression or a drawing making the invention unclear, the target invention is deemed to be identified in detail if the content of the target invention can be identified in the consideration of the general disclosures of the description and the drawings of the target invention, thereby giving the demandant a greater opportunity to have the scope of its patented invention confirmed.