

Study on Supreme Court Decision 2016HU2829

1. The Subject Case

Decision No.: 2016HU2829

Case No.: Invalidation Trial against Korean Registered Utility Model No. 470862 titled "MOBILE PHONE CASE with a shielding magnet for operating hall IC"

Date of Decision: October 15, 2020

2. Gist of the Decision

For determination on whether inventiveness of a utility model is denied or not, it should be examined whether, despite a difference between the utility model and prior art, the utility model can be extremely easily derived by a person having ordinary skill in the art to which the utility model belongs (hereinafter referred to as 'a skilled person in the art') making up the difference in light of the scope and content of the prior art, the difference between the utility model and prior art, the technical level of the skilled person. In this case, the determination on whether a skilled person in the art can very easily conceive the utility model should not be made based on hindsight analysis on the assumption that he/she is in the knowledge of the art disclosed in the specification of the utility model the inventiveness of which is to be determined (see Supreme Court decision 2013HU3326 dated November 27, 2015, Supreme Court decision 2014HU2184 dated November 25, 2016, etc.)

3. History of the Case

The history of Korean Registered Utility Model No. 470862 (hereinafter referred to as 'the present registered utility model') is as follows.

(1) The defendant, which runs a business in the same field as the plaintiff, filed an invalidation trial against all claims (claims 1 to 4) of the present utility model. After decisions by the Intellectual Property Trial and Appeal Board (IPTAB; 1-1) and the Patent Court (1-2) that invalidated all claims, the plaintiff filed an appeal with the Supreme Court (1-3).

(2) Immediately before the decision by the Patent Court (1-2), the plaintiff filed a correction trial, which was rejected by both the IPTAB and the Patent Court. However, the Supreme Court accepted the correction, and the IPTAB issued a trial decision accepting the correction. Based on the corrected claims, the Supreme

Court then ruled that the decision by the Patent Court (1-2) was illegitimate and remanded the case. As a result, the case is currently pending at the Patent Court.

4. The Supreme Court's Decision

The Supreme Court provides that the determination on inventiveness of a utility model should be made by examining whether or not a skilled person in the art can derive the utility model from prior art extremely easily. The Supreme Court also recognizes the features added by the correction and the effect achieved by the features as a technical characteristic of the present registered utility model, and judged that the decisions by the Patent Court and the IPTAB that the technical characteristic can be derived from prior art are based on hindsight analysis, concluding that the inventive step of the utility model should not be denied. The gist of the judgment is as follows.

(1) The technical object of the utility model of claim 1* is 'prevention of malfunction of a sensor that may occur due to turning of the front portion of the mobile phone case to the back of the back portion (added by the correction trial) by using a shielding magnet at the point of the front portion of the mobile phone case corresponding to a hall IC built in the mobile phone.'

* A mobile phone case provided with a shielding magnetic for operating a hall IC, the mobile phone case being mounted on a mobile phone to cover the front, the back and one side of the mobile phone and to protect the exterior of the mobile phone, characterized in that a front portion of the mobile phone case can be turned to the back of a back portion of the mobile phone case, the front portion of the mobile phone case has a shielding magnetic built therein at the point corresponding to a hall IC built in the mobile phone, the shielding magnetic comprising a permanent magnetic and a yoke, and the shielding magnetic provides a magnetic signal detected by the hall IC on the front of the mobile phone and attenuates the magnetic signal using the yoke on the back of the mobile phone.

(2) Prior Utility Model 1 has the technical object of prevention of malfunctions such as one that a mobile phone is turned on by external force pressing a key input unit when a mobile phone case is closed, and the means to achieve the object is to control its operation only by magnetic force and responses of a hall sensor to magnetic force, not physical stimulation. Prior Utility Model 3 relates to a case for physical protection of a mobile phone itself, regardless of operation of the mobile phone. Prior Utility Model 2 is directed to a shielding magnet that can be used in the general electric and electronic fields.

(3) The prior utility models do not have any motivation or implication for combination of them. They also lack any recognition of a problem that can be caused by a permanent magnet when the front portion of the mobile phone case is turned back. Given this, it can hardly be deemed that a skilled person in the art can extremely easily apply the shielding magnet combining a permanent magnet and a yoke to a mobile phone case.

5. Our Comments

It appears that, over the course of the invalidation trial at the IPTAB and the Patent Court, the plaintiff, the owner of the utility model, had recognized that there should be some limit in its argument for the effect (technical object) of 'prevention of malfunction of a sensor that may occur due to turning of the front portion of a mobile phone case to the back of the back portion by using a shielding magnet comprising a permanent magnet and a yoke of a particular structure' even though the effect is stated in the description of the utility model because claim 1 does not comprise the feature that 'the front portion of the mobile phone case is turned to the back of the back portion of the mobile phone case.'

The IPTAB and the Patent Court did not accept the correction because the features to be added by the correction were not inventive at the time of the filing of the utility model application, and the Patent Court decision stated that 'the only technical objective of Prior Utility Model 1 is prevention of key input by a magnetic signal when the case is closed, and it can be reasonably deemed that a skilled person in the art can sufficiently anticipate that when it is altered to the case disclosed in Prior Utility Model 3, i.e., the case where its front portion can be turned to the back of the back portion, the magnet mounted on the front portion is positioned at the back of the case as stated earlier and coupled to the hall IC to lead to a recognition that the case is closed, thereby causing abnormal operations of the mobile phone.' In this regard, the Supreme Court found that the Patent Court decision was based on hindsight analysis and that even when the disclosures of the prior utility models are combined, it is not extremely easy to derive the technical object of the present registered utility model of 'prevention of malfunction of a sensor that may occur due to turning of the front portion of a mobile phone case to the back of the back portion.'

The Supreme Court Decision 2016HU2829, which is in favor of the utility model owner in light of various circumstances, was covered in a newspaper article (<https://magazine.hankyung.com/business/article/2020120701306000051>) not only because the decisions by the IPTAB and the Patent Court were overturned by the Supreme Court but also because the technological value of the utility model of an individual who is of a relatively weak status was acknowledged by the Supreme

Court.

The decision is in line with the pro-patent trend in Korea, where punitive damages were recently introduced by a revision to the Korean Patent Law.