

A Study on the Supreme Court Decision 2019HU11541

1. Summary of the Matter

Decision No.: 2019HU11541

Related Patent: Patent No. 10-0815579 "Three-dimensional fabric and manufacturing method thereof"

Decision Date: January 14, 2022

2. Gist of the Decision

- (1) Whether the patentee of a product invention can seek confirmation that the product that the petitioner under trial is working on is within the scope of the patent right by specifying it as a proffered invention regardless of the manufacturing method (affirmative)**

The trial to confirm the scope of rights stipulated in Article 135 of the Patent Act specifically determines the scope of effect of the patent right in relation to the subject matter, and the subject matter is the proffered invention, which is a specific embodiment for which the petitioner has made the trial object. The patent holder monopolizes the right to practice the patented invention as a business (Article 94(1) of the Patent Law), and if a patented invention is a product invention, the act of producing, using, assigning, leasing, or importing the product, or making an offer for assignment or rental of the product is the implementation of the product invention [Article 2(3)a of the Korean Patent Law] , and thus, a patent right for a product invention is effective for a product having the same composition as the product invention, regardless of the manufacturing method. Therefore, the patent right holder of a product invention can seek confirmation that the product that the petitioner under trial falls within the scope of the patent right by specifying it as a proffered invention regardless of the manufacturing method.

- (2) If a manufacturing method is additionally described in the description or drawing of the proffered invention, whether only the product manufactured by such a manufacturing method becomes the proffered invention subject to trial (negative)**

Even if a manufacturing method is additionally described in the description or drawing of the proffered invention as a supplementary explanation to help the understanding of the proffered invention, it cannot be said that only the product manufactured by such a manufacturing method is the proffered invention subject to trial.

3. Details of the matter

(1) Facts

A. The plaintiff filed a trial for confirmation of the scope of rights of 1650DANG2018 on the reason that the invention of the defendant belongs to the scope of rights of Patent No. 10-0815579 (hereinafter referred to as 'patented invention') regarding the plaintiff's 'three-dimensional fabric and its manufacturing method'.

B. In response, the Intellectual Property Trial and Appeal Board cited the argument of the plaintiff on the grounds that the implementation invention falls within the scope of the patent invention claim 1, and the defendant filed a petition for cancelation of the trial decision.

(2) Judgment of the original trial (patent court)

A. In the process of trial, the defendant argued that the plaintiff was 'implementing' the proffered invention. As described in [Appendix 1], the plaintiff presented photos of FIGS. 1 and 4 in which a part of the manufactured product was taken, and the embodiment was embodied in that the product was manufactured in the same way as the conceptual diagrams in FIGS. 2 and 3. Considering that the patented invention in this case is 'three-dimensional fabric and its manufacturing method', it seems to be able to judge the proffered invention in comparison with the patented invention.

Therefore, the proffered invention finally confirmed in the trial decision process of this case is not the product itself, which is photographed in [Appendix 1] and shown in FIGS. 1 and 4, but it is the object that the plaintiff is manufacturing by the method according to the conceptual diagrams of FIGS. 2 and 3 above, as described in the description and drawings of the invention to be confirmed.

B. For the benefit of confirmation to be acknowledged in the positive scope confirmation trial, the plaintiff must actually be working on the proffered invention. The plaintiff asserted that the proffered invention is not being implemented. However, the defendant claims that the plaintiff is working on the invention to be confirmed and the trial result and the actual product submitted as manufactured by the plaintiff during the litigation process of this case (the product in the photo of proof No. 4 of A) or the product photographed in FIGS. 1 and 4.

C. However, when referring to all the evidence presented regarding the present case, it is insufficient to admit that the product manufactured by the plaintiff or a product photographed in FIGS. 1 and 4 of the invention to be confirmed is a product manufactured in the same way as the proffered invention, and there is no evidence to otherwise admit it.

(3) Supreme Court judgment

A. The patented invention is an invention titled 'three-dimensional fabric and its manufacturing method' consisting of a total of 39 claims. The patented invention for which the defendants, who are the patentees, want to confirm the scope of protection is claim 1 (hereinafter referred to as the 'invention of claim 1'). The

invention of claim 1 relates to a three-dimensional fabric and falls under a product invention.

B. In the claim of the invention of claim 1, there are descriptions related to the weaving process, such as 'weaving', 'weaving', and 'plying'. This is only a concrete expression of the structure, shape, and state of the three-dimensional fabric, which is the invention of the product, and cannot be said to represent a series of processes or steps for manufacturing the product, so it is difficult to view it as a description of the manufacturing method. Even from the description of the manufacturing method, it cannot be said that the method affects the structure or properties of the three-dimensional fabric claimed in the invention of claim 1 and the scope of the invention of claim 1 should be regarded as related to the object itself, which is a three-dimensional fabric.

C. The defendants filed a claim against the plaintiff for a positive trial to confirm the scope of rights, taking 'three-dimensional fabric described in the description and drawings of the proffered invention' as the proffered invention subject to judgment and seeking confirmation that the proffered invention belonged to the scope of rights of the invention of claim 1. The defendants describe and explain the specific configuration of the part corresponding to the component of the invention of claim 1 among the proffered inventions in the description and drawings, and through this, it is possible to confirm whether the effect of the patent right of the invention of claim 1 extends to the proffered invention.

D. Meanwhile, the defendants additionally described the method of manufacturing the three-dimensional shape fabric of the proffered invention with reference to FIG. 3 in the description of the proffered invention, but this part does not correspond to the components of the invention of claim 1, but is merely an amplified explanation added to help understand the proffered invention. Depending on whether the proffered invention is a product manufactured by the manufacturing method according to such amplification, it does not matter whether the patent right of the invention of claim 1 applies to the inventor of the product. Therefore, it cannot be said that only products manufactured by the manufacturing method additionally described above are subject to confirmation subject to trial.

4. Review Comment

Regarding the specification of the patented invention in the trial to confirm the scope of rights, in Supreme Court Decision 2013HU1726 dated February 12, 2015, if the patented invention is a product invention in which a manufacturing method is described, the method of interpreting the scope of patent claims should be applied in the same way while determining whether or not it falls within the scope of the patented invention at the stage of patent infringement, such as a patent infringement lawsuit or a trial to confirm the scope of rights. However, if there are clearly unreasonable circumstances, such as the fact that the scope of the patented invention derived by such an interpretation method is too broad in light of the substance of the invention identified by the overall description of the specification, it is judged that the scope of the right could be limited within the scope of the manufacturing method described in the claims. If the patented invention is a product invention in which a manufacturing method is described, that is, a PBP (Product-By-Process) claim invention, in principle, regardless of the description of the manufacturing method, it was determined that **the product invention itself should be specified and prepared as a patented invention**, and specific standards for patented inventions for product inventions with manufacturing methods described were presented.

Meanwhile, Decision 2019HU11541 is a decision that made a specific judgment on the specification of the proffered invention in the trial for confirmation of the scope of rights. In the judgment of the Patent Court, the lower court judged that there was no benefit of confirmation for the reasons that since the proffered invention is specified as a product manufactured by the method described in the description

and drawings of the proffered invention, the proffered invention and the working invention are not manufactured by the same manufacturing method as the proffered invention. The Supreme Court precedent held that even if the manufacturing method is additionally described in the description or drawing of the proffered invention as an additional explanation to help the understanding of the proffered invention, the product itself, not the product manufactured by the manufacturing method, must be specified as the proffered invention.

In short, the Supreme Court precedent is considered as a significant precedent that in the trial to confirm the scope of rights, in addition to existing precedents related to the specification of patented inventions, precedents specifically presenting the legal principles related to the specification of the proffered invention, especially in the case where the proffered invention is a product in which a manufacturing method is described.