

Analysis of Supreme Court's Decision for Case No. 2023Hu11340

1. Overview of the Case

Case No.: 2023Hu11340 Scope Trial (Patent)
Related patent: Patent No. 10-1027722
Decision date: July 17, 2025

2. Summary of the Decision

(1) Interpretation of the scope of the claims in which functional expressions are used

The scope of protection of a patented invention is defined based on the matters described in the claims, and it is not allowed to limit or expand the scope of protection by the description of the invention or drawings, in principle. However, where the matters described in the claims are expressed with so-called functional expressions such as function, effect, or properties, *not* by general structures, methods, or materials, so the specific technical feature cannot be understood from the recitation itself, there may be cases where interpreting the claims literally would lead to an unreasonable result in light of other descriptions in the specification in the context of determining an infringement or confirming the scope of the patent right. This includes cases where some of what is interpreted as being included in the claims is not supported by the descriptions in the description of the invention or where it appears that the applicant has intentionally excluded some of them from the scope of the patent. In such cases, the scope of the patent right may be limitedly interpreted by considering all of the content of the technical idea of the invention, other descriptions in the specification, the applicant's intention, and legal stability for third parties.

(2) Interpretation of the claims of a divisional application in consideration of the prosecution history of its parent application

The term 'cleaning means' in claim 1 of the present patent is considered as a functional expression which means 'means for performing a cleaning function,' and the specific technical feature cannot be figured out from the term *itself*, and the description of the invention includes no description on 'means for cleaning by generating a sterilizing substance through electrolysis.' and it *neither* specifically describes *nor* suggests any feature of the 'cleaning means.'

During the examination process of the parent application, in order to overcome the rejection ground, the plaintiff submitted an Argument, arguing that the 'cleaning means' in claim 1 does not include 'means for cleaning by generating a sterilizing substance through electrolysis.' The applicant of the parent application is identical to the applicant of the present patent, which is the plaintiff of the present case. The present patent was filed as a divisional application from a divisional application which was *first* filed from the parent application, and this invention is within the scope of matters described in the specification or drawings originally attached to the

parent application. The plaintiff filed the present patent after submitting the arguments for the parent application.

Considering these circumstances, the prosecution history of the parent application can be taken into account also when interpreting the claims of the present patent, which was filed as a divisional application thereafter. Taking this into account, it appears that the plaintiff intentionally excluded 'means for cleaning by generating a sterilizing substance through electrolysis' from the 'cleaning means' of claim 1 of the present patent.

(3) Criteria for determining identicalness of the principle of solving the problem in the doctrine of equivalents

In order for an accused product, which is compared with a patented invention, to be deemed to fall within the scope of the patented invention, the features recited in the claims of the patented invention and the organic relationship among the features must be included in the accused product as they are. Even in case where an accused product includes a substitution in the features recited in the claims of the patented invention, if the accused product has the same principle of solving the problem as the patented invention and has substantially the same effect, and the substitution can be easily made up by a person having ordinary skill in the art to which the present invention pertains, the accused product should be deemed to be equivalent to the features recited in the claims of the patented invention and thus fall within the scope of the patented invention, unless there are special circumstances. In determining whether the accused product and the patented invention have 'the same principle of solving the problem', the determination should be made by substantively examining what the core of the technical idea underlying the solution unique to the patented invention is, as compared to prior art, in light of the descriptions in the description of the invention in the specification and the common technology at the time of filing, *not* by formally extracting some of the features recited in the claims. Accordingly, depending on the degree to which the patented invention has contributed to technological development in consideration of prior art technology, it should be determined how broadly or narrowly to understand the principle of solving the problem.

3. Details of the Case

(1) Facts

A. The plaintiff's patented invention relates to 'a purifier which is able to clean itself.' The plaintiff filed the parent application on February 3, 2009, then filed a first divisional application directed to a part of the parent application on October 28, 2010, and thereafter filed again a divisional application directed to a part of the first divisional application on April 4, 2011, which was registered as the present patent.

B. Claim 1 of the present patent recites the feature of 'the cleaning unit which is connected to the storage tank in order to wash the storage tank by taking advantage of the water flowed in the filtration part, the cleaning unit comprises a cleaning

means', but it does not recite the specific technical feature of the 'cleaning means'.

C. Meanwhile, during the examination process of the parent application, in order to overcome the rejection ground, the plaintiff submitted an Argument on March 7, 2011, arguing that the 'cleaning means' in claim 1 does not include 'means for cleaning by generating a sterilizing substance through electrolysis.'

D. On April 4, 2011, the present patent was filed and thereafter registered.

E. The respondent filed a negative scope trial seeking to confirm that the accused invention does not fall within the scope of claim 1 and claim 10 referring thereto. The description of the accused invention discloses that 'it includes an electrode sterilizer that generates electrolyzed water by electrolyzing filtered water. The electrode sterilizer does not contain a cleaning substance or sterilizing substance, and generates electrolyzed water by electrolysis.'

(2) Judgment in the original decision (Patent Court)

In the original decision, it was judged that: It should be based on the premise that the recitations of the parent application are identical to the recitations of claim 1 of the present patent; *however*, while the claim of the parent application recites 'cleaning means comprising a filter containing a cleaning substance or sterilizing substance or a cleaning sterilizing agent dosing system,' claim 1 of the present patent merely recites 'cleaning means'; and even if it may be considered that in the parent application, cleaning means other than the above limited feature was intentionally excluded from the scope of the claims, since in the present patent which was filed as a divisional application and then filed again as a second divisional application and thereafter registered, the claims do not include such limitation, it cannot be deemed that cleaning means other than 'a cleaning sterilizing filter or a cleaning sterilizing agent dosing system' was intentionally excluded from the scope of the claims; considering all of the above, the 'cleaning means' in claim 1 of the present patent is interpreted as 'a method or tool for cleaning the storage tank by supplying a cleaning substance or sterilizing substance,' but this not limitedly interpreted as 'a cleaning sterilizing filter containing a cleaning substance or sterilizing substance or a cleaning sterilizing agent dosing system'; therefore, the accused invention falls within the equivalent scope of claims 1 and 10 of the present patent.

(3) Supreme Court's Judgment

A. The term 'cleaning means' in claim 1 of the present patent is considered as a functional expression which means 'means for performing a cleaning function,' and the specific technical feature cannot be figured out from the term *itself*, and the description of the invention includes no description on 'means for cleaning by generating a sterilizing substance through electrolysis,' and it *neither* specifically describes *nor* suggests any feature of the 'cleaning means.'

Further, during the examination process of the parent application, in order to overcome the rejection ground, the plaintiff submitted an Argument, arguing that the

‘cleaning means’ in claim 1 does not include ‘means for cleaning by generating a sterilizing substance through electrolysis.’

After submitting the Argument for the parent application, the plaintiff lawfully filed the divisional application for the present patent, from the divisional application which was *first* filed from the parent application.

The Supreme Court judged that considering these circumstances, the prosecution history of the parent application can be taken into account also when interpreting the claims of the present patent which was filed as a divisional application thereafter. Taking this into account, it is judged that the plaintiff intentionally excluded ‘means for cleaning by generating a sterilizing substance through electrolysis’ from the ‘cleaning means’ of claim 1 of the present patent.

Accordingly, the Supreme Court judged that, among what could be interpreted as being literally included in the ‘cleaning means’ of claim 1, ‘means for cleaning by generating a sterilizing substance through electrolysis’ is not supported by the description of the invention, and is considered as the feature which was intentionally excluded by the petitioner who is the applicant from the scope of the patent right, and therefore, interpreting the ‘cleaning means’ literally would be definitely unreasonable.

B. Next, regarding whether the accused invention falls within the scope of the patent right, the Supreme Court has held that in light of the prior art at the time of filing, the contribution of claim 1 of the present patent to technological development does not appear to be significant, and therefore, the principle of solving the problem specific to claim 1 of the subject invention should be interpreted close to the recitations of the claims.

However, while the accused invention generates electrolyzed water through an electrode sterilizer using water filtered by part of the filtration part to self-clean the storage tank, the present invention self-cleans the storage tank by diluting a cleaning or sterilizing substance in water filtered by part of the filtering unit. Thus, it is judged that the accused invention does not have the same principle of solving the problem as claim 1 of the present invention.

As the result, the accused invention does not comprise the same or equivalent elements and their organic combination as recited in claim 1 of the present invention, and therefore, does not fall within the scope of claim 1, nor within the scope of dependent claim 10 which refers to claim 1.

4. Analysis

This decision has the significance in that the decision *not only* clearly held that, in interpreting the claims in which functional expressions are used, where a literal interpretation would be definitely unreasonable, the scope of the patent right can be limitedly interpreted in consideration of the descriptions in the specification and the prosecution history, *but also* it suggests that, where a divisional application is lawfully filed by the same applicant after an office action is issued against the parent application, the prosecution history of the parent application may affect the interpretation of the claims of the divisional application.

In particular, the decision appears to confirm that although a divisional application is

a separate application from the parent application, and the claims of the divisional application are different from the claims of the parent application, in consideration of the applicant's intention to intentionally exclude a specific feature from the scope of the parent application through the prosecution history of the parent application, this was taken into account in interpreting the claims of the divisional application, and therefore, it is hard to deem that arguments and amendments made during the prosecution of the parent application are entirely irrelevant to subsequent divisional applications.

Furthermore, the decision held that, in determining whether an accused invention falls within the scope of equivalents to the patented invention, the principle of solving the problem should be assessed in light of prior art at the time of filing in consideration of the actual technical contribution of the patented invention, and should be determined more broadly or narrowly depending on the contribution; and in cases where the contribution to technological development is not significant, the principle of solving the problem should be determined close to the recitations of the claims. This appears to be intended to prevent excessive expansion of the scope of equivalents for the claims in which functional expressions are used.

Accordingly, applicants are needed to note that when presenting arguments, during the prosecution of a parent application, to intentionally exclude a certain feature in order to distinguish a patented invention from prior art or overcome a rejection ground, such arguments may affect the interpretation of the scope of subsequent divisional applications. So, careful arguments and response are required from the stage of responding to office actions against the parent application, taking into account potential future divisional filings. Conversely, from the perspective of asserting non-infringement or in scope trials, it may be an effective strategy to closely examine not only the literal recitations of the claims but also the prosecution history of both the parent application and the divisional application to identify whether the patentee intentionally excluded certain features.

In light of the above, the Supreme Court's decision is meaningful in that it suggests that the prosecution history of the parent application may also be considered in interpreting the scope of a divisional application.