

Study on the Supreme Court Decision No. 2015 DA 244517

1. Overview of the Matter

Court Case No.: 2015 DA 244517

Related Patent: Korean Patent No. 10-1001354 B1

"Reflow solderable electric contacts having elasticity

Judgment Date: August 1, 2018

2. Gist of the Court Decision

(1) Where the applicant or patentee can be considered to have **knowingly excluded** a product (hereinafter, referred to as 'the subject product') **from the scope of claims of the patented invention, the patentee is not allowed to assert against a person who manufactures or sells the subject product that the subject product is within the protected scope of the patented invention under the doctrine of estoppel.**

(2) **As to whether the subject product is knowingly excluded from the scope of claims in the filing process of the patented invention,** it shall be determined not only in light of the specification, but also in light of the opinion given by the examiner of the Korean Intellectual Property Office (the KIPO) from filing of the application to granting of the application, the intentions of the applicant shown in the Amendments and the Arguments, etc., submitted by the applicant in the filing process, and the reasons for amendment, etc. **The legal principle applies to where the scope of claims was narrowed through corrections made after the registration of the patent.**

3. History of the Case

(1) The plaintiff who is the patentee filed a petition for an injunction against the defendant on November 15, 2011, but Seoul Central District Court which was the lower court rejected the petition on the ground that the worked product of the defendant is not within the scope of rights of the patented invention of the present case, on October 31, 2013 (2011 GAHAP 119908).

(2) The plaintiff appealed, and Seoul High Court rejected the appeal on the ground that the worked product of the defendant is not within the scope of rights of the patented invention of the present case, on May 1, 2014 (2013 NA 2025765).

(3) The plaintiff appealed to the Supreme Court, and according to Intellectual Property Trial and Appeal Board Decision No. 2014 JEONG 15 of June 23, 2014 approving the correction by the plaintiff, the Supreme Court made a decision remanding the case back to Seoul High Court for further proceedings on September 4, 2014, on the ground that the scope of the claims of the patented invention of the present case was corrected (2014 DA 212247).

(4) After the case was remanded, Seoul High Court rejected the appeal of the plaintiff on the ground that the worked product of the defendant is not within the corrected scope of claims of the patented invention on October 8, 2015 (2014 NA 2032500).

(5) Contesting this Court Decision, the plaintiff appealed again to the Supreme Court on October 29, 2015.

- Assertion of the plaintiff (Misunderstanding of the legal principle of prosecution history estoppel)
There is a legal restriction that a correction of a patent must be made within the scope that does not modify the rights substantially (Product 136(4) of the Patent Law) and thus there cannot be an abandonment of rights, and thus unlike an amendment, the legal principle of the prosecution history estoppel cannot be applied to corrections, and the Seoul High Court determining that, since Feature 5 was corrected, an infringement under the doctrine of equivalents cannot be asserted, erred in applying the legal principle of estoppel overlooking the difference between the amendment made in the filing process and the correction made after the registration of the patent, and thus it is clearly contrary to the legal principle of Product 136(4) of the Patent Law.

4. Comments

(1) Corrections by the plaintiff

Feature 5: Corrected from 'the insulating elastic core comprises a bottom face that is slantly formed in a width direction from both ends toward a middle portion in a scoop shape' to 'the insulating elastic core comprises a bottom face that is slantly formed in a width direction from both ends toward a middle portion in a scoop shape such that the vertical crossing face forms a hypotenuse of an isosceles triangle.'

(2) Application of the prosecution history estoppel to the infringement under the doctrine of equivalents

1) Significance of the prosecution history estoppel

The prosecution history estoppel is a legal principle established by the case law of US, and the general estoppel prohibiting contradictory assertion applies to the patent law and prohibits the patentee from making assertions contrary to his or her own actions taken against the KIPO in the process of obtaining a patent (such as an amendment and a statement of arguments) in the patent infringement proceeding thereafter.

2) The prosecution history estoppel as a passive requirement for an infringement under the doctrine of equivalents

The Supreme Court precedent recognizes the prosecution history estoppel, ruling an element that 'it shall not be excluded knowingly' as one of the passive requirements for an infringement under the doctrine of equivalents. If it is recognized as excluded knowingly, the assertion for an infringement under the doctrine of equivalents is denied.

3) Burden of proof/assertion

The Supreme Court precedent views that the person who works the invention in question (in the case of an action for patent infringement, the defendant) carries the burden of proof/assertion (Supreme Court Decision No. 2005 Hu 1240, dated February 8, 2007).

(3) Whether there is a misunderstanding of the legal principle as to the prosecution history estoppel in the case

1) Whether the feature before correction can be considered as excluded knowingly from the claims in the correction by the plaintiff

In this regard, the Supreme Court Decision No. 2014 Hu 638 dated April 26, 2017 ruled that "Whether constituent(s) have been knowingly excluded from the claims of a patented invention during the prosecution should be decided in consideration of not only the specification of the invention, but also the opinions presented by the examiner of the KIPO from the filing of the application to the decision on patentability, and the intention of the applicant, etc. presented in the amendment and argument submitted during the prosecution."

Moreover, in view of the history of the correction below, the plaintiff seems to have specifically limited the claims of the patent to distinguish from the prior art cited, when the inventive step was denied in the invalidation trial case against the registered patent and the patent was determined to be invalid.

- History of the specific invalidation trial and the correction trial

The defendant requested an invalidation trial against the registration of the patented invention of the present case twice, but ultimately, based on the corrected claims, the inventive step was not denied, and a conclusion was drawn that the registration is valid.

The first invalidation trial proceeded in order of:

- ① Intellectual Property Trial and Appeal Board Decision No. 2011 Dang 264, dated June 24, 2011 (valid registration, before correction) ⇒
- ② The Patent Court Decision No. 2011 Heo 7249, dated February 17, 2012 (valid registration, before correction) ⇒
- ③ The Supreme Court Decision No. 2012 Hu 1019, dated April 26, 2013 (Remanded back overturning the former Court Decision, correction trial decision made conclusive) ⇒
- ④ The Patent Court Decision No. 2013 Heo 3968, dated September 25, 2014 (valid registration, after correction) ⇒
- ⑤ The Supreme Court Decision No. 2014 Hu 2313, dated January 15, 2015 (Dismissal of trial by discontinuance).

The second invalidation trial proceeded in order of:

- ① The Intellectual Property Trial and Appeal Board Decision No. 2015 Dang 3250, dated November 26, 2015 (valid registration, after correction) ⇒
- ② The Patent Court Decision No. 2015 Heo 8479, dated December 22, 2016 (valid registration, after correction) ⇒
- ③ The Supreme Court Decision No. 2017 Hu 165, dated May 16, 2017 (Dismissal of trial by discontinuance).

In summary, the plaintiff requested a correction trial in order to prevent the inventive step from being denied in an invalidation trial, and narrowed the scope of claims by specifically

limiting the shape of the bottom face of the insulating elastic core to the shape of a hypotenuse of an isosceles triangle' through a correction.

Considering the above, as to whether the prosecution history estoppel applies also to the assertions made by a right holder in an invalidation trial or a correction trial which is a procedure after the registration of the patent without narrowing the claims, an invalidation trial has a nature of a re-examination for validity of the patented invention, and in light of the purport of the prosecution history estoppel which is to prohibit contradictory assertions to the assertion made to satisfy the patentability requirement when determining the scope of rights of the patented invention, even in a procedure after the registration of the patent, if an assertion was made in a procedure where the issue was whether the patentability requirement was satisfied, it seems reasonable to deem that it is subject to the prosecution history estoppel.

Accordingly, in the present case, it is reasonable to consider that 'a shape of a curve' or 'a shape that the left and right are asymmetrical,' etc. that do not form the hypotenuse of an isosceles triangle are excluded from the scope of the claims of the registered patent of the plaintiff.

The present Supreme Court ruling also made it clear considering the totality of the corrected description, correction history, and correction result, etc. as above, that intentional exclusion (i.e., knowingly excluding the feature of a claim) may also be applied to the correction of a registered patent, and accordingly the principle of the prosecution history estoppel which is a passive requirement for an infringement under the doctrine of equivalents may also be applied.

2) Whether the assertion is reasonable that a correction of a patent is made within the scope that does not modify the rights substantially, (Product 136(4) of the Patent Law) and thus there cannot be an abandonment of rights, and thus unlike an amendment, the legal principle of the prosecution history estoppel cannot be applied to corrections

As explained above, in light of the purport of the prosecution history estoppel which is to prohibit contradictory assertions to the ones made to satisfy the patentability requirement when determining the scope of rights of the patented invention, even in a procedure after the registration of the patent, if an assertion was made in a procedure where the issue was whether the patentability requirement was satisfied, it is deemed that it is subject to the prosecution history estoppel.

Moreover, Article 136(1) of the Patent Law provides that as the scope of correction, a correction may be requested where it is to (i) narrow the claim; (ii) correct clerical errors in the description; or (iii) clarify an ambiguous description, and Article 97 of the Patent Law provides that the scope of protection of a patented invention shall be determined on the basis of the claims, and thus the effects from the correction of a patent can be considered to include narrowing of the scope as well, and thus if the scope of the claims is narrowed by the correction, it is also reasonable to consider that the protected scope of the patented invention has been narrowed.

In addition, considering the purport recognizing the correction trial for the patentee is to i) make the description of the patented invention clear in a restrictive scope and thereby pre-empt the risk of dispute with a third party, and ii) prevent the invalidation of the patent

right to protect the patentee, even though the protective scope of the patented invention is narrowed by the correction, it is difficult to consider that unjust damage is caused to a third party, and the patentee has already gained the benefit of protecting the patent right by the correction narrowing the scope of claims, and thus even if the protected scope of the patented invention is narrowed by the correction, it is not contradictory to the purport of recognizing the correction trial.

Likewise, in the Supreme Court Decision No. 2002 Hu 2105, dated November 26, 2004, it is ruled that the prosecution history estoppel may be applied, not only to an amendment in the filing process, but also to claims that are narrowed by correction.

Accordingly, the present Supreme Court rejected the assertion by the plaintiff that a correction of a patent is made within the scope that does not modify the rights substantially, (Article 136(4) of the Patent Law) and thus there cannot be an abandonment of rights and unlike an amendment, the legal principle of the prosecution history estoppel cannot be applied to corrections is erroneous.

(4) Significance of the Present Court Precedent

The present case has its significance in making the legal principle clear that the prosecution history estoppel which was recognized in case law as one of the passive requirements under the doctrine of equivalents is recognized not only in the amendment in the filing procedure, but also in the correction procedure made after the registration of the patent.

Moreover, intentional exclusion is determined considering the totality of the corrected description, correction history, and correction result, etc., and thus its significance can be also found in the criteria for applying the prosecution history estoppel to corrections as well.