

Study on Supreme Court Decision 2019Da222782

1. Indication of the Case

Case No.: Supreme Court Decision 2019Da222782 of October 17, 2019 (injunction against patent infringement)

Related Patent: Korean Patent No. 10-1326763, titled "AN APPARATUS FOR INSERTING A MEDICAL THREAD AND A SURGICAL PROCEDURE KIT FOR INSERTING A MEDICAL THREAD COMPRISING THE SAME"

2. Gist of the Decision

Exceptional case in which infringement can be recognized despite the principle of territoriality of patent rights

Under the principle of territoriality of patent rights, the right of the patent holder of a product invention to the product regarding the working of the patent including exclusive production, use, assignment, lease, or importation shall be effective only within the territory of the country in which the patent is registered. However, in the case where all parts or components for the working of a patented invention are produced or a semi-finished product that has undergone most of the production steps and has all the major components is produced in Korea, they are scheduled to be exported to an entity for the final processing or assembly, and such processing or assembly is so insignificant or simple that the production of all components or the semi-finished product alone achieve a state in which the effect of a systemically integrated form of each component of the patented invention can be implemented, it should be considered, as an exception, as domestic production of a product working the patented invention, which accords with protection of the patent right in practice.

3. Detailed of the Case

i) Facts

The features of the present patented invention and the Respondent products are compared as follows.

Feature	Patented Invention (Medical Thread Inserting Device)	Respondent Products
Claim 1 (independent)	an insertion path forming means (100) provided with a tube member (120) forming a path into which a medical thread (410) is inserted and a support member (110) inserted into the conduit of the tube member (120) a medical thread supply means (400) supplying the medical thread (410) through the tube member (120) after the support member (110) is removed from the insertion path forming means (100)	a catheter comprising a tube member and a support member a hub connected to a fastening portion of the tube member to supply a suture through the tube member
Claim 5 (dependent from claim 1)	the tube member (120) comprises a fastening portion (122) provided with a mounting groove (126), the medical thread supply means (400) is provided with a medical thread holding portion (420), and the medical thread holding portion (420) is provided with a connector (424) having a complementary shape that is fastened to the mounting groove (126) of the tube member (120)	a catheter, a hub, a suture
Claim 6 (dependent from claim 5)	<u>a medical thread support (414) is formed at an end of a medical thread (410) to fix the medical thread (410) in a tissue of body</u>	a suture and a suture support

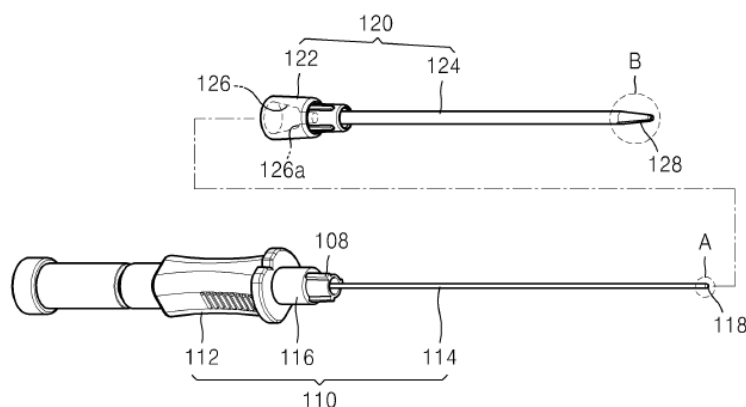
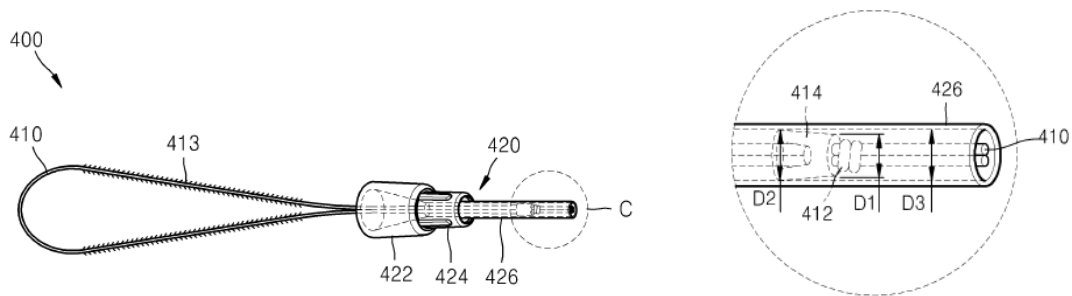


Fig. 2 of the Present Patented Invention



Figs. 7a and 7b of the Present Patented Invention

The Respondents produced the catheter, the hub, the suture, the suture support of the Respondent products in Korea and exported them abroad.

ii) Original Decision (by the Patent Court)

The original decision acknowledged that the insertion path forming means (100), the medical thread supply means (400), the medical thread (410), and the medical thread support (414) of the patented invention respectively correspond to the catheter, the hub, the suture, and the suture support of the Respondent products, but found that while the present patented invention (claim 6) is where 'a medical thread support (414) is formed at an end of a medical thread (410) to fix the medical thread (410) in a tissue of body,' the suture and the suture support of the Respondent products were exported without being assembled and an additional processing is necessary to form the suture support on the suture; thus, the Respondents' domestic production of the suture and the suture support does not constitute infringement of the present invention (claim 6).

iii) Supreme Court's Decision

However, the Supreme Court overturned the original decision on the following grounds.

(1) Under the principle of territoriality of patent rights, the right of the patent holder of a product invention to the product regarding the working of the patent including exclusive production, use, assignment, lease, or importation shall be effective only within the territory of the country in which the patent is registered. However, in the case where all parts or components for the working of a patented invention are produced or a semi-finished product that has undergone most of the production steps and has all the major components is produced in Korea, they are scheduled to be exported to an entity for the final processing or assembly, and such processing or assembly is so insignificant or simple that the production of all components or the semi-finished product alone achieve a state in which the effect of a systemically integrated form of each component of the patented invention can be implemented, it should be considered, as an exception, as domestic production of a product working the patented invention, which accords with protection of the patent right in practice.

(2) The feature that 'a medical thread support is form at an end of a medical thread' of the present patented invention (claim 6) corresponds to individual products of the suture and the suture support of the present case among the Respondent products.

The Respondents produced all of the features for working of the present patented invention (claim 6) by producing the individual products of the catheter, the hub, the suture, and the suture support of the present case. The individual products were manufactured for the purpose of being sold to a hospital named OOOO in Japan for use in skin lifting procedures

In light of the claim (claim 6) and the description in the specification of the present patented invention, a method for fixing or coupling a medical thread support to an end of a medical thread is no more than a method that can be properly selected by a skilled person in the art.

It is obvious to a skilled person in the art to arrange and fix a medical thread support to an end of a medical thread before or during a procedure, and a skilled person in the art can use the individual products by assembling or coupling them in light of their functions without particular difficulty.

(3) Accordingly, it is reasonable to see that the production of the individual products of the catheter, the hub, the suture, and the suture support of the present case by the Respondents alone achieve a state in which the effect of a systematically integrated form of each component of the patented invention (claim 6) can be implemented in Korea and thus constitutes infringement of the invention.

Despite the above, the original decision did not recognize infringement of the patented invention (claim 6) on the grounds that an additional processing or assembly is necessary to form a suture support at an end of the suture of the present case. Therefore, the original decision is flawed in that the decision is affected by misunderstanding of a legal principle about patent infringement.

4. Conclusion

All of the constituents (individual medical devices for a skin lifting procedure) of the present patented invention were produced in Korea and exported to be finally used by one subject, without the medical thread support and the medical thread of the patented invention (claim 6) being combined. In this regard, the original decision did not recognize infringement of the patent under the principle of territoriality of patent rights. However, the Supreme Court found that, despite the principle of territoriality of patent rights, the patent infringement is recognized because the combination can be recognized as a processing or assembly that is so insignificant

or simple that the production of all components or the semi-finished product alone achieve a state in which the effect of a systematically integrated form of each component of the patented invention can be implemented in Korea.

The decision recognized an exception to the principle of territoriality of patent rights. Conventionally, there has been a problem that, under strict application of the principle of territoriality of patent rights, it is difficult to properly restrict patent infringements by working of a patented invention across national borders. In this regard, the present decision is noteworthy in that, even when components or semi-finished products working a patented invention were produced in Korea and then assembled into finished products abroad, if the particular requirements stated in the decision is met, infringement of the patent can be recognized exceptionally as in the case where a product working the patented invention is produced in Korea.