

A Study on Supreme Court Decision 2019Da237302

1. The Case

The case: 2019Da237302 Petition for prohibition of infringement of patent rights, etc.

The subject patent: Patent No. 716595, "Detachable handle for kitchen utensil"
Announcement date: 11 March 2021

2. Summary of the Decision

(1) The requirements for infringement under the Doctrine of Equivalents and how to determine whether the principle of solving the problem is the same

In order to say that a product manufactured by a defendant in a patent infringement lawsuit or a method of use (hereinafter referred to as "infringing product, etc.") infringes a patent right, the organic relationship between the components recited in a claim of the patented invention and the components must be included in the infringing product as they are. Even if there is a changed part in some of the features described in the claim in the infringing product, etc., if the patented invention and the infringing product, etc., have the same principle of solving the problem, show substantially the same effect, and the change is to the extent that anyone with ordinary skill in the relevant technical field can easily conceive it, it should be deemed that the infringing product, etc., is equivalent to the constitution described in the claim of the patented invention, and thus still infringes the patent right, unless there is a special circumstance.

Here, in determining whether the principle of solving the problem is the same between the infringing product, etc., and the patented invention, rather than mechanically extracting only part of the features described in the claim, the description of the invention written in the specification and the known technology at the time of filing should be taken into account and then in comparison with the prior art, it should be substantively examined and judged what is the core technical idea that the principle of the patented invention is based on (Supreme Court Decision 2017Hu424 announced on January 31, 2019; Supreme Court Decision 2016Hu2546 announced on April 29, 2020).

(2) When the core technical idea of the patented invention had already been publicly known at the time of filing of the patented invention or was nothing more than that, how to determine whether the effect is substantially the same

Whether the functional effect is substantially the same should be determined based on whether the problem solved by the patented invention is also solved by the infringing product, etc., as a technical task that had not been resolved in the prior art. Therefore, if the core technical idea on which the means to solve the problem unique to the patented invention as identified by taking into account the description of the invention and the known technology at the time of filing, is implemented in the infringing product, etc., in principle, the effect is substantially the same. However, **if the core technical idea had already been publicly known at the time of the filing of the patent invention or is nothing more than that**, then the core technical idea cannot be regarded as unique to the patented invention, and the patented invention should not be deemed to have solved the problem that had not been solved in the prior art. **In such a case, it is not possible to determine whether or not the effect is substantially the same based on whether the core technical idea of the patented invention is implemented in the infringing product, etc., and the individual function or role of the feature in question under the Doctrine of Equivalents should be compared and judged** (Supreme Court Decision 2018Da267252, announced on January 31, 2019; Supreme Court Decision 2015Hu2327, announced on February 14, 2019).

3. History of the Case

(1) The plaintiff, who is the patentee, filed a lawsuit for prohibition of patent infringement and compensation for damages on October 24, 2016 alleging infringement of its patented invention by two Defendants' product. 6. 8. Only the infringement by a first defendant's product was recognized, and the amount of damages of 20,000,000 won was awarded in accordance with Article 128 (7) of the Patent Act. (2016Gahap563500).

(2) In response to the decision against the plaintiff in relation to the other defendant, the plaintiff filed an appeal on June 27, 2018, and the Patent Court, which is an appellate court, found an infringement of claim 1 by the second defendant's product, and awarded 115,965,212 won in damages calculated pursuant to Article 128 (4) of the Patent Act excluding 20,000,000 won awarded in the first instance.

(3) The defendant filed an appeal with the Supreme Court on 4 June 2019 regarding the portion of the ruling that was unfavorable toward it.

4. The Supreme Court's Judgment

The Supreme Court revoked that portion of the lower court's ruling for the following reasons.

(1) In this case, the core technical idea identified from the description of the invention of the patented invention is 'moving the sliding plate forward and backward by operating a rotary operation unit' and 'moving the push member or pin member up and down through a button formed on an upper surface to control the forward/backward movement of the sliding plate, thereby preventing the button from being pressed by mistake,' and it had been publicly known at the time of filing the invention of claim 1.

(2) Then, the above technical idea cannot be regarded as unique to the invention of claim 1 of this case, and it cannot be said that the invention of claim 1 of this case solved a technical problem that had not been solved in the prior art. It cannot be taken as a criterion whether or not the above technical idea is implemented, and it should be determined by comparing the individual function or role of the features that are in question under the Doctrine of Equivalents.

(3) The 'pin member and second elastic spring installed through the upper and lower members and the sliding plate' according to claim 1 is not included in the second defendant's product. According to claim 1, even if the rotary operation part is rotated, thanks to the pin member installed through the upper and lower members and the sliding plate,' the handle is not separated from the cooking container unless the pin member is released. By comparison, according to the second defendant's product, because the locking piece is bent inclined upward from the sliding piece and is integrally formed, the slide piece connected to the lever and the arc-shaped pull rod can advance by simply rotating the lever in the opposite direction when attaching the handle, and then the handle and the cooking utensil become slightly separated because the locking piece is caught at the stopper formed on the inner surface of the upper member, and in this state, if the locking piece is directly pressed by pressing the button installed in the center of the lever, the locking piece is released from the stopper and reaches a completely separated state. As such, the two differ in terms of functional effect.

In addition, if the pin member is changed to a locking piece, not only the relative movement relationship between the button and the slide piece in claim 1, but also the arrangement of the connection components must be changed drastically. Further, there is no suggestion and motivation to change the pin member to the locking piece. On this account, it is difficult to deem that the feature of the 'pin member and second elastic spring installed through the upper and lower members and the sliding plate' according to claim 1 can be easily changed to the 'locking piece' of the second defendant's product.

(4) Therefore, the second defendant's product does not include a feature equivalent to the 'pin member and the second elastic spring installed through the upper and

lower members and the sliding plate' of claim 1, and it does not infringe claim 1.

Nevertheless, the lower court decided that the 'pin member and the second elastic spring' of claim 1 and the 'button and locking piece' of the second defendant's product have the same principle of problem solving and substantially the same functional effect, and that the change can be easily conceived by a skilled person, and ruled that they are equivalent to each other. There is a mistake in the judgment of the lower court that influenced the judgment by misunderstanding the legal principles on the establishment of equivalent infringement.

5. Our Comments

Article 97 of the Patent Act provides, "The scope of protection of a patented invention shall be determined by the matters recited in the claims." Accordingly, in principle, if each element described in the claims of a patented invention and the organic combination between the elements are included in the infringing product as they are, it has infringed on the patent right. If, however, the infringing product changes some of the elements of the patented invention into equivalent ones, an equivalent infringement may be established.

The Supreme Court explicitly accepted the Doctrine of Equivalents for the first time in Case No. 97Hu2200 on July 28, 2000, and since then, the Doctrine has been applied in a number of cases. The requirements for equivalents infringement are summarized as follows:

<Active Requirements>

- Requirement 1: The patented invention and the infringing product should have the common or same principle to achieve their technical subject matter.
- Requirement 2: The substituted feature of the infringing product should have substantially the same effects as the corresponding feature of the patented invention.
- Requirement 3: The substitution of the feature of the patented invention with the corresponding feature of the infringing product should be obvious to the extent that a person skilled in the art can easily derive it.

<Passive Requirements>

- Requirement 4: The infringing product should be neither known nor could be easily derived from the prior art by a person skilled in the art at the time of filing the patented invention.
- Requirement 5: There should be no special circumstances, such as where the substituted feature in the infringing product has been knowingly excluded from the claims of the patented invention during the prosecution of the patented invention.

In the present case, the lower court judged: The core technical idea that differentiates the patented invention from the prior art is 'a pin member is installed such that its front end is exposed to the top and the rear end is elastically supported by a second elastic spring, and it is moved up and down by the second elastic spring being restored and compressed according to the user's pressing operation on the front end of the pin member, so as to control the forward and backward movement of the sliding plate.' Despite its slight differences in the detailed structure from the 'pin member and the second elastic spring' of claim 1, the second defendant's 'button and locking piece' includes the core technical idea of claim 1, and thus, the principle of problem solving is the same, the functional effect of action is substantially the same, and the 'button and locking piece' of the second defendant's product corresponds to a technology that had already been widely known, and changing it to this is a simple design change.

However, the Supreme Court deemed that the core technical idea of claim 1 is 'moving the sliding plate forward and backward by operating a rotary operation unit' and 'moving the push member or pin member up and down through a button formed on an upper surface to control the forward/backward movement of the sliding plate, thereby preventing the button from being pressed by mistake,' and then found that it had been publicly known at the time of filing the invention of claim 1, such as a patent publication. Accordingly, the Supreme Court found that the technical idea cannot be regarded as unique to claim 1, and that it cannot be said that the invention of claim 1 solved a technical problem that had not been solved in the prior art, and in determining whether the functional effect is the same, the Supreme Court compared the individual function and role of each element of the 'pin member and the second elastic spring' of claim 1 and the 'button and locking piece' of the second defendant's product, and then decided that there was a difference in the effect, and that because it was not easy to change the configuration, there was no equivalent infringement.

According to the Supreme Court's decision, identifying "the core technical idea on which the patented invention's means of solving a problem is based" not only affects the determinations of whether the principle of problem solving is identical and of whether the functional effect is identical, but also whether there is an equivalent infringement. Therefore, when it comes to cases where the issue is whether there is an equivalent infringement, it will be important to understand what the core technical idea on which the patented invention's means of solving a problem is based, and whether this core technical idea had already been publicly known at the time of filing the patent invention.