

**PATENT COURT
THE THIRD DEPARTMENT
DECISION**

Case No. 98Heo2160 Scope Confirmation(Patent)

Plaintiff: 1. Wonho CHOI
2. Yoonho CHOI
Counsel for the Plaintiffs:
Byungdo HWANG, Patent attorney

Defendant: Samin Co., Ltd.
Counsel for the Defendant:
Yongin KIM, Patent attorney
Changseop SHIM, Patent attorney

Closure of Hearing: August 27, 1998

Order

1. The Plaintiffs' claims are dismissed.
2. The trial costs shall be borne by Plaintiffs.

Tenor of Claim

The decision of the Intellectual Property Tribunal ("IPT") issued on September 18, 1997 in Case No. 96Dang1172 shall be cancelled. The trial costs shall be borne by Defendant.

Reasoning

1. Background facts

Upon reviewing the description in Exhibit Nos. K-1 to K-3 and the overall pleadings, the following facts are recognized and there is no evidence to the contrary.

A. Procedural history in KIPO

Plaintiffs are patentees of Korean Patent No. 10-0097703 (filed on February 7, 1994 and registered on April 2, 1996; hereinafter, “Subject Patent”) entitled “Method for restoring wrinkled metal plate of automobile to original state.” The invention is described in Section B below.

Defendant filed an action against Plaintiffs seeking a decision that the invention, as described in the drawings and explanation in Annex A (hereinafter, “Invention A”) does not fall within the scope of the Subject Patent, and thus, the IPT issued a decision in Case No. 96 Dang 1172 on September 18, 1997 (hereinafter, “IPT decision”) that Invention A does not fall within the scope of the Subject Patent on the grounds as described in Section C below.

B. Summary of Subject Patent (Claims)

1) A method for restoring a wrinkled metal plate of an automobile to an original state, comprising the steps of: placing a fluorescent lamp on one side of a metal plate to be restored to its original state such that the fluorescent lamp is placed parallel to the metal plate; placing a tip of a working tool, the tip being sharp and bent, at a lower portion of a wrinkled part of the metal plate by a worker positioned opposite the fluorescent lamp; precisely placing the tip of the working tool at a lower portion of a center of the wrinkled part of the metal

plate by using a difference of light and shade of a shadow of the fluorescent lamp; and then rapidly, elastically, slightly and repeatedly pushing down a handle of the working tool by leverage until the wrinkled part is completely restored to the original state.

2) The method according to Claim (1), wherein an S-shaped hook is hung to a lower portion of the wrinkled metal plate and a body of the working tool is hung to a lower portion of the hook, thereby pushing down the handle of the working tool.

3) The method according to Claim (1) or (2), wherein the center of the wrinkled part of the metal plate is checked by using distortion and the difference of light and shade of the shadow of the fluorescent lamp reflected on the metal plate.

4) The method according to Claim (1) or (2), wherein the restoring of the wrinkled part of the metal plate is checked by using distortion and the difference of light and shade of the shadow of the fluorescent lamp.

C. Summary of Grounds of IPT decision

The Invention A wherein a wrinkled metal plate is flattened by a working tool having a hook shape while distinguishing light and shade reflected on a wrinkled region of the metal plate with the naked eye was publicly known as shown in a catalogue from Martin Tools, which was published in 1993 before the filing of the Subject Patent.

The Prior Art does not disclose that a board (101) colored with a black stripe (102) having a certain width is reflected on the wrinkled region of the metal plate. However, such a feature enables easy checking of the wrinkling and the Subject Patent does not disclose the technique of checking the wrinkling by using the board colored with the black stripe.

Thus, as reviewed above, Invention A was publicly known before

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the filing of the Subject Patent, and a patent right is granted only to an invention having novelty. Therefore, when part of a patent includes a portion that is publicly known and cannot be considered to be intimately combined with the occurrence of technical effects of the invention, the scope of right cannot expand to cover subject matter in the public domain. Therefore, there is no need to compare the Subject Patent with Invention A, and Invention A does not fall within the scope of the Subject Patent.

2. Judgment on the Propriety of the IPT Decision

A. Summary of Plaintiff's Ground to Cancel the Decision

1) The catalogue (Exhibit No. K-4) submitted by Defendant as evidence of being publicly known during the IPT trial procedure is not authentic, but was forged. The technique described as being identical or similar to Invention A is not described in a catalogue identified as Exhibit No. E-2. Thus, these catalogues cannot be used as evidence for being publicly known. Nevertheless, the IPT decision was issued by accepting these catalogues as evidence, ruling that Invention A was published before the filing of the Subject Patent. Accordingly, this IPT decision is unlawful.

2) The Subject Patent uses a wrinkling of an image of the fluorescent lamp by focusing the image on the wrinkled automobile body, whereas Invention A uses an image of the board by focusing the image on the wrinkled automobile body. Therefore, except for the difference in using the fluorescent lamp or the board, Invention A is substantially identical to the Subject Patent in that both inventions use the wrinkled image, which is the key technique of the Subject Patent. Thus, Invention A falls within the scope of the Subject Patent. Even though Invention A uses reflection light, the image focused on the automobile body is the same, and this difference does not bring about

any technical difference in working process. In the case of outdoor work where the sun shines, the effect is obtained wherein the image of the fluorescent lamp in the Subject Patent is focused more clearly than the image of the board in Invention A.

B. Summary of Defendant's Arguments

Both inventions are completely different in technical means in that the Subject Patent uses the Fluorescent lamp, whereas Invention A uses a board colored with a black stripe. Further, both inventions have contrary technical ideas in that the Subject Patent obtains the unreflected image, whereas Invention A obtains the reflected image. Moreover, since the image of the shadow cannot be obtained outdoors where the sun shines, the Subject Patent cannot be practiced, whereas Invention A can be practiced merely with certain brightness regardless of whether it is indoors or outdoors. Also, there is a significant difference in effect in that two fluorescent lamps should be arranged in parallel to be closer to the metal plate in the Subject Patent, whereas regardless of the types of light source, Invention A only needs the presence of light when indoor. Consequently, the inventions are not even equivalent.

C. Judgment

1) Judgment on Whether Invention A was Publicly Known

The catalogue in Exhibit No. K-4 submitted by Defendant as evidence of being publicly known during the IPT trial procedure is not authentic and there is no other evidence to prove that Invention A was publicly known. Nevertheless, the IPT decision ruled that Invention A was publicly known before the filing of the Subject Patent. Thus, this IPT decision is unlawful (however, as will be described below, this unlawfulness does not affect the conclusion of the decision).

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2) Judgment on Whether Invention A Falls Within the Scope of the Subject Patent

a) It is prescribed in Article 97 of the Korean Patent Act that the scope of protection of a patented invention shall be determined by the subject matters described in the claims, and it is prescribed in Article 42(4) of the Korean Patent Act that the claims should include one or two or more claims describing the subject matters sought to be protected and the claims should be described only with the matters which are essential for the invention. According to said Articles, the scope of the patented invention is, in principle, determined by the subject matters described in the claims. However, in cases where the technical constitution of a claim cannot be understood from the descriptions or where the scope cannot be established even if the technical constitution is understood, the scope may be supplemented by other descriptions in the specification. However, if the technical scope is clear from the descriptions in the claim, it cannot be altered based on the description from the specification. (Supreme Court Case No. 91 Huh 1809 issued on June 23, 1992).

If Invention A includes all constitutional elements described in the claims, Invention A falls within the scope of the patented invention, and if Invention A lacks any constitutional elements, Invention A does not fall within the scope of the patented invention. However, even though an invention formally lacks a constitutional element of the patented invention, in a case where the invention uses a substantially equivalent element, infringement should be recognized exceptionally by applying the doctrine of equivalents.

b) Returning to this action, according to the description of Claim 1 of the Subject Patent (if Invention A does not fall within the scope of Claim 1, Invention A does not fall within the scope of any other claims; thus, Invention A is compared only with Claim 1), for the scope of protection, the Subject Patent claims a method for restoring a wrinkled metal plate of an automobile to an original state, comprising the steps of: ① placing a fluorescent lamp on one side of a metal

plate to be restored to its original state such that the fluorescent lamp is placed parallel to the metal plate; ② placing a tip of a working tool, the tip being sharp and bent, at a lower portion of a wrinkled part of the metal plate by a worker positioned opposite the fluorescent lamp; ③ precisely placing the tip of the working tool at a lower portion of a center of the wrinkled part of the metal plate by using a difference of light and shade of a shadow of the fluorescent lamp; and then ④ rapidly, elastically, slightly and repeatedly pushing down a handle of the working tool by leverage until the wrinkled part is completely restored to the original state.

Meanwhile, as described in the specification of A, Invention A relates to a method for restoring a wrinkled metal plate of an automobile to an original state, comprising the steps of: ① placing a board colored with a black stripe having a certain width on one side of a metal plate to be restored to its original state such that the board is placed vertical to the metal plate; ② placing a tip of a working tool, the tip being sharp and bent, at a lower portion of a wrinkled region of the metal plate by a worker positioned opposite the board; ③ precisely placing the tip of the working tool at a lower portion of a center of the wrinkled region of the metal plate by using a difference of light and shade of a shadow of the board after moving a position of the board by using the reflection of light source to adjust such that the black stripe covers 1/2 of the wrinkled region; and ④ then rapidly, elastically, slightly and repeatedly pushing down a handle of the working tool by leverage until the wrinkled region is completely restored to the original state. Upon comparing Invention A to Claim 1 of the Subject Patent, among the essential constitutional elements of the Subject Patent, Invention A lacks the constitutional element of “the fluorescent lamp” and the feature of “using the difference of light and shade of the shadow of the fluorescent lamp” and substitutes them with “the board colored with the black stripe having the certain width” and using the difference of light and shade of the shadow of the board after moving the position of the board by using the reflection of light source to

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adjust such that the black stripe covers the 1/2 the wrinkled region.

Thus, since Invention A does not include all constitutional elements, Invention A does not literally infringe the Subject Patent.

c) Then, it will be reviewed whether Invention A infringes under the doctrine of equivalents.

Generally, in order to recognize equivalent infringement, the following requirements should be satisfied: although Invention A substitutes the constitutional elements of the patented invention with other constitutional elements, the substituting constitutional elements perform substantially the same functions in substantially the same manner to provide substantially the same functional effects as the constitutional elements of the patented invention; such substitution could have been easily derived at the time Invention A was reduced to practice by a person having ordinary skill in the art ("PHOSITA") Invention A does not use the same techniques which were publicly known at the time of filing the Subject Patent or could not have been easily derived by PHOSITA from such techniques at the time of filing; and the constitutional elements of the Invention A which substituted the constitutional elements of the Subject Patent should not have been intentionally omitted from the scope of the claims during the prosecution of the Subject Patent.

Returning to this action, the board, which is the constitutional element substituted in Invention A, performs substantially the same function as the fluorescent lamp, which is the corresponding constitutional element of the Subject Patent, as it assisted an accurate finding of the center of the wrinkled region in the metal plate. However, Invention A is practiced by locating the center of the wrinkled region by using the difference in light and shade of the shadow of the board after moving the position of the board by using the reflection of the light source to adjust, such that the image of the black stripe reflected on the metal plate covers the 1/2 of the wrinkled region, whereas the Subject Patent is practiced by locating the center of the wrinkled part by using the difference of light and shade of the

image of the fluorescent lamp between the wrinkled part and the unwrinkled part by shining the fluorescent lamp to the wrinkled part of the metal plate. Thus, it cannot be considered that both inventions are practiced in substantially the same manner in that Invention A uses the image of the board generated by the reflection of light source and the light and shade of the black stripe, whereas the Subject Patent uses the light and shade of the image of the fluorescent lamp itself, which is the light source. Further, Invention A has advantages in that natural, outdoor light could be used and it is very convenient to install and move the board. On the other hand, the effect of the Subject Patent is greatly marred under natural, outdoor light in spite of using the fluorescent light, and the Subject Patent has disadvantages in that it is very inconvenient to install and move the fluorescent lamp since the fluorescent lamp requires an electric power supply and electric codes. Thus, it cannot be considered that both inventions have substantially the same functional effect (even though the Subject Patent is advantageous in being able to find the center of the wrinkled part more accurately than Invention A, the judgment remains the same).

Therefore, Invention A does infringe the Subject Patent under the doctrine of equivalents.

3. Conclusion

Accordingly, since Invention A does not fall within the scope of the Subject Patent, the decision of the IPT decision is reasonable. Thus, Plaintiff's claim seeking cancellation of the IPT decision is groundless, the Court dismisses the claim and issues the decision stated in the Order.

September 17, 1998

Presiding Judge	Ilhwan PARK
Judge	Jangho LEE
Judge	Soowan LEE

Drawings of Invention A

Fig. 1

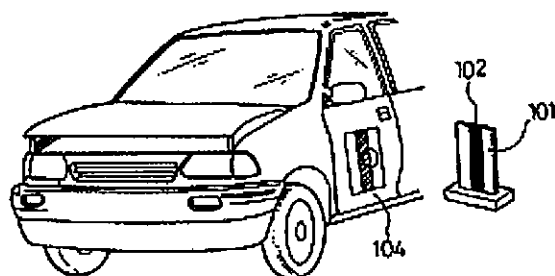
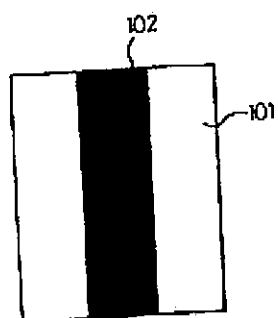


Fig. 2



Explanations on the drawings of Invention A

1. Title of Invention A

Method for restoring wrinkled metal plate of automobile to original state

2. Brief explanations of the drawings

Fig. 1 is a perspective view showing an operating state of Invention A.

Fig. 2 is a front view of a board applied to Invention A.

3. Detailed explanation of Invention A

The present invention relate to a method for restoring a wrinkled metal plate of an automobile to an original state by using a working tool with a hook shape, comprising the steps of: placing a board (101) colored with a black stripe (102), which has a certain width on its intermediate region, on one side of a metal plate (104) along a wrinkled region of the metal plate (104) such that the board is placed vertical to the metal plate (104) and then, identifying light and shade of the black stripe (102) reflected on the wrinkled region by a worker with the naked eye after moving a position of the board (101) by using the reflection from the light source to adjust, such that the black stripe (102) covers a 1/2 of the wrinkled part.

According to the method for restoring the wrinkled metal plate of the automobile to the original state as described above, the wrinkled region is gradually flattened by identifying a movement (an amount of change) of a boundary region between the black stripe (102) and a background color when performing a process on a region where the black stripe (102) colored in the board (101) and the background color (white) of the board extend over the wrinkled part while, by using

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natural light or light irradiated from indoor illumination light, identifying with the naked eye that the light and shade of the black stripe (102) colored in the board (101) is reflected on the metal plate (104).