

PATENT COURT OF KOREA
SECOND DIVISION
DECISION

Case No.	2019Heo3854 Rejection (Design)
Plaintiff	A
Defendant	Commissioner of the Korean Intellectual Property Office Counsel for defendant Seungho Ryu
Date of Closing Argument	September 26, 2019
Decision Date	October 24, 2019

ORDER

1. The decision rendered by the Intellectual Property Trial and Appeal Board on April 17, 2019, concerning the case numbered 2018Won3368 shall be revoked.
2. The cost arising from this litigation shall be borne by the defendant.

PLAINTIFF'S DEMAND

As ordered.

OPINION

1. Background

A. Plaintiff's Claimed Design at Issue (Plaintiff's Exhibit No. 1)

- 1) Filing date of application / filing No.: August 8, 2017 / 30-2017-36578
- 2) Article to which design is applied: Toothbrush head
- 3) Main content and drawing: As in [Annex 1].

B. Prior Designs

- 1) Prior design 1 (Plaintiff's Exhibit No. 13)

The design of the 'Toothbrush' posted in the registered design announcement numbered 30-0857663, announced on June 8, 2016, and the main content and drawing are as illustrated in [Annex 2].

- 2) Prior design 2 (Defendant's Exhibit No. 1)

The design of the 'Toothbrush' posted in the US design patent announcement numbered US D732,831 S, announced on June 30, 2015, and the main content and drawing are as illustrated in [Annex 3].

C. Rejection Decision & Circumstances of Decision at Issue (Plaintiff's Exhibits No. 2 through 8)

1) Concerning the plaintiff's claimed design at issue, the Examiner of the Korean Intellectual Property Office issued a Notification of Refusal to the plaintiff on November 7, 2017 (Plaintiff's Exhibit No. 2), reasoning that 'the filed design of this case is merely an assembly of the materials of the toothbrush head of prior

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design 2 onto the toothbrush head of prior design 1, and thus the design cannot be registered pursuant to Article 33(2) of the Design Protection Act.’

2) In this regard, the plaintiff submitted a response to the grounds for rejection on February 5, 2018 (Plaintiff’s Exhibit No. 7), reasoning that ‘he design at issue cannot be derived by a person skilled in the art to which the design belongs (hereinafter, ‘skilled person’) simply through assembly of prior designs 1 and 2.’ However, on March 15, 2018, the Examiner of the Korean Intellectual Property Office issued a Decision of Rejection (Plaintiff’s Exhibit No. 3 on the claimed design at issue, reasoning that ‘although re-examination was conducted as per the plaintiff’s response, nothing was discovered that would overcome the grounds for rejection dated November 7, 2017.’

3) The plaintiff submitted a response on April 9, 2018 (Plaintiff’s Exhibit No. 8) as per the petition for re-examination; however, on May 9, 2018, the Examiner of the Korean Intellectual Property Office once again issued a Decision of Rejection (Plaintiff’s Exhibit No. 4) against the claimed design at issue, reasoning that ‘although re-examination was conducted as per the plaintiff’s response and supplementary statements, nothing was discovered that would overcome the ground for rejection dated November 7, 2017.’

4) The plaintiff then appealed to the Intellectual Property Trial and Appeal Board on August 13, 2018, concerning the rejection above. Thereafter, the Intellectual Property Trial and Appeal Board conducted the appeal trial for the plaintiff under the number of 2018WON3368HO, deciding (Plaintiff’s Exhibit No. 5 to dismiss the trial, reasoning that ‘the original decision rejecting the registration pursuant to Article 33(2) of the Design Protection Act is reasonable since the claimed design at issue corresponds to one which may be created by the combination of prior designs 1 and 2 by a skilled

person.’

[Factual Basis] Undisputed facts, Plaintiff's Exhibits No. 1 through 8, and 13, Statements in Defendant's Exhibit No. 1, Purport of the overall argument

2. Discussion of Whether IPTAB Erred

A. Summary of Plaintiff's Argument

The position and shape of the space in which the toothbrush head of the claimed design at issue is not planted cannot be deemed to be easily derived by a skilled person by combining prior designs 1 and 2 or by creative techniques commonly employed in the field of design. Thus, the IPTAB erred in its decision since although the registered design at issue should have been deemed not to fall under Article 33(2) of the Design Protection Act, the IPTAB decided to the contrary.

B. Applicability of Article 33(2) of Design Protection Act to Claimed Design at Issue

1) Relevant law

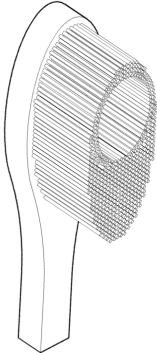
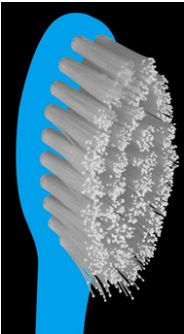
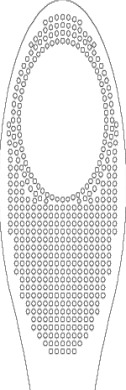
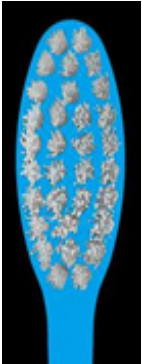
Article 33(2)(i) of the Design Protection Act provides that a design cannot be registered if it falls under Paragraph (1)(i) or (ii), or if a person skilled in the art to which the design belongs can easily create the design from combination thereof. However, the purpose of such provision is that even if and when one imitates, converts, or partially modifies the design's form, shape, color, or a combination thereof, if it amounts to a mere commercial or functional modification not recognized as having an overall aesthetic value, or if it amounts to a design whose extent of creativity is insignificant, such as a design


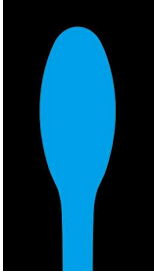


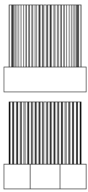
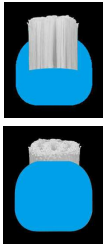
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which has been modified or converted by a creative technique or expression method commonly employed in the field of design, no registration for the design shall be allowed since it may be easily created by a skilled person (refer to judgment numbered 2013Hu2613 issued on March 10, 2016, by the Supreme Court).

2) Comparison of claimed design at issue and prior design 1

The table below illustrates a comparison of the claimed design at issue and prior design 1. For purposes of convenience, only the toothbrush heads are compared.

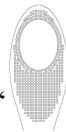
	Claimed Design at Issue	Prior Design 1
Perspect ive view		
Top view		


	Claimed Design at Issue	Prior Design 1
Bottom view		
Front & rear views		
Left & right side views		

3) Analysis of commonalities and differences

a) The part excluding the toothbrush head of the claimed design at issue and prior design 1 consists of an oval part and a handle part with similar curvature when viewed from the plane, and they share common shape from an aesthetic view since they are made of a similarly thin rectangular shape when viewed from the front.

b) However, the toothbrush head of the claimed design at issue has a space in which the toothbrush head is not bristled in an



oval shape at the top, appearing as ‘’, when viewed from the

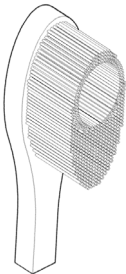

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plane, whereas the toothbrush head of prior design 1 does not have a space in which the toothbrush head is not bristled as such.

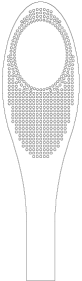




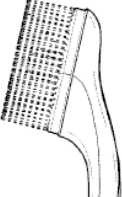
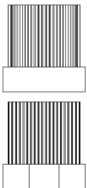
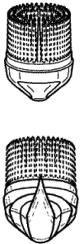
4) Analysis of differences

Due to such differences above, the claimed design at issue may be considered as having an aesthetic value which is different from that of prior design 1 when viewed in its entirety, and thus it is difficult to consider that a skilled person could easily create the same by combining prior design 1 with prior design 2. The reasoning therefor is as follows.

a) First, comparing prior design 2 and the toothbrush head part of the claimed design at issue, as illustrated in the comparison table below, prior design 2 has a space in which a certain part of the toothbrush head is not bristled inside the toothbrush head, thereby establishing a commonality with the toothbrush head of the claimed design at issue. However, there is a difference in that while prior design 2 has a space formed in a circular shape in which the toothbrush head is not bristled in the central part of the toothbrush head, the unbristled space of the toothbrush head of the claimed design at issue consists of an oval shape at the top of the toothbrush head.

	Claimed Design at Issue	Prior Design 2
Perspe ctive view		



Tooth Brush Head Case

Top view		
Bottom view		
Front & rear views		
Left & right side views		

b) However, if and when the purport of the overall argument is combined with the statements of Plaintiff's Exhibits No. 9 and 11, the creative motif wherein the toothbrush head of prior design 2 is not bristled and made to form a circular shape at the center of the toothbrush head was intended to create a space for accommodating or discharging gel capsules containing oral care solutions such as

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toothpaste inside the toothbrush head, whereas the creative motif of forming the unbristled space of the toothbrush head of the claimed design at issue into an oval shape at the top of the toothbrush head may be recognized for its intention to secure a complex cleaning function due to the bristled part of the toothbrush head of each different form, given the formation of the bristled part of the toothbrush head of the semi-oval shape equipped with large area such

as ‘’ at the bottom of the toothbrush head and the bristled part of the toothbrush head having a thin semi-oval strip form such as ‘’ at the top of the toothbrush head.

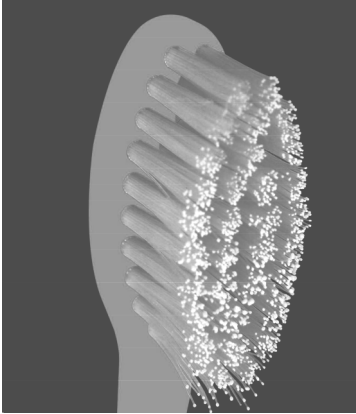
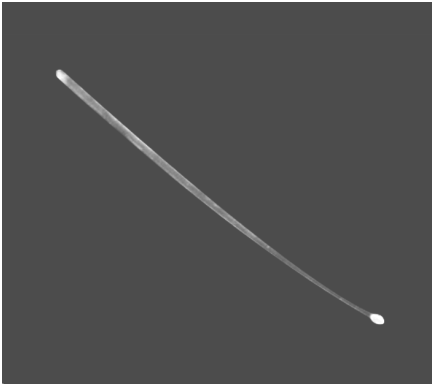
c) The fact that the technical form of the structure of the article is different is not directly relevant to the discussion of the availability of creation cost. However, even if it were a design which expresses functional characteristics, if it has created a shape which carries an aesthetic value among various shapes which can perform such functions, in lieu of having an appearance formed by considering functions only, it leads to the creation of such a design, and thus it may be said that the functional aspect could be considered in the discussion of the availability of creation cost. If the functional aspect could not be considered as the motif of creation for modern design, in which the functional aspect is further stressed in addition to the functions of the article carrying the design, it would not be possible to essentially protect the design by ignoring the characteristics of modern design.

d) As seen above, since the two designs differ in terms of the main creative motif, under only the circumstances that prior design 2 discloses a toothbrush design equipped with a circular empty space without the toothbrush head being bristled in the center of the toothbrush head, it ought to be deemed that it would be difficult for a skilled person to have motivation to form an empty oval space without

the toothbrush head being bristled at the top of the toothbrush head as in the claimed design at issue. Furthermore, the empty space of the toothbrush head is transformed from circular to oval, and the oval space is shifted from the center of the toothbrush head to the top; further, given that the placement and thickness of the toothbrush head at the top and bottom of the toothbrush head are symmetrical, and if the modification which makes the thickness of the head placement much thinner than the thickness of the bottom of the toothbrush head is a commercial or functional one that is not recognized as having other aesthetic values as a whole, or is merely a creative technique or expression commonly employed in the field of design, there is no ground to deem it a design with a low level of creativity, such as a design that has been modified, combined, or converted.

e) Furthermore, prior design 2, as illustrated in the figure on the right, may be considered as a design which gives rise to a gracefully curved toothbrush head and a sharp. pointed handle to create a unique aesthetic overall; however, separating only the toothbrush head of the above design and combining the same with prior design 1 would not only be hardly considered easy for a skilled person, but moreover, according to a description of its designer, the tip of the toothbrush head of prior design 1 is rounded, as illustrated in the figure below, thereby avoiding causing damage to teeth without hurting the gums, its intention being the effective use thereof to scrape food scraps, and it is also described as a design formed with the motif of the legendary tale of a flower blooming once every three millennia. Nonetheless, substituting prior design 1's toothbrush head, characterized by the unique shape of its toothbrush head, with the toothbrush head of prior design 2 may be deemed to be damaging to the significance of prior design 1's design or the aesthetic value intended by the designer, and thus, it is difficult to deem that it is a modification which a skilled person could easily achieve.

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Toothbrush head of Prior Design 1	Enlarged view of toothbrush head of Prior Design 1
	

5) Overall review of review results

Examining such circumstances in their entirety, the claimed design at issue is not one which may be easily created by a skilled person via the combination of prior designs 1 and 2, and thus, is not applicable under Article 33(2) of the Design Protection Act.

C. Summary of Discussion

Therefore, the IPTAB, which, contrary hereto, determined that the claimed design at issue is applicable under Article 33(2) of the Design Protection Act, erred in its decision.

3. Conclusion

Therefore, a decision is rendered as ordered since the plaintiff's petition had grounds in seeking the revocation of the IPTAB's decision.

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Presiding Judge	Jejeong LEE
Judge	Kisu Kim
Judge	Jiyoung Yi

[Annex 1]

Claimed Design at Issue

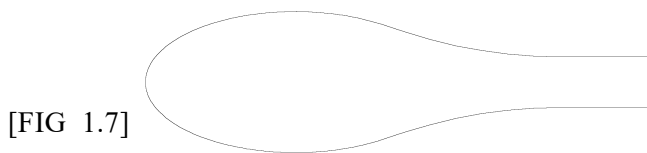
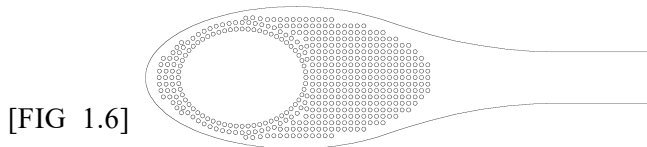
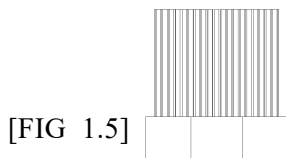
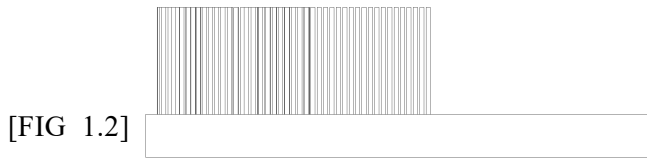
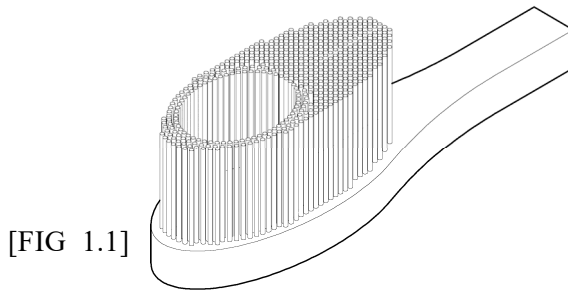
【Article to Which Design Is Applied】 Toothbrush head

【Description of Design】

1. This design of a toothbrush head shall be made of synthetic resin.
2. This design, the circular shaped toothbrush head located at the front end of the toothbrush head, may be inserted in the space between the concealed tooth surface and the gum, and the dense toothbrush head at the latter part of the toothbrush head is intended to brush the tooth surface exposed to the outside of the gums.
3. This design has an oval space formed where the toothbrush head is not bristled and at the rear of the oval shaped toothbrush head at the front end of the toothbrush head, and the center of the oval space is shifted to the front of the toothbrush head, whereby the thickness of the placement area of the oval shaped toothbrush head at the front end is much thinner than that of the dense toothbrush head at the rear end of the toothbrush head.
4. FIG 1.1 is a perspective view of this design.
5. FIG 1.2 is a front view of this design.
6. FIG 1.3 is a rear view of this design.
7. FIG 1.4 is a left side view of this design.
8. FIG 1.5 is a right side view of this design.
9. FIG 1.6 is a top view of this design.
10. FIG 1.7 is a bottom view of this design.

【Summary of Design's Creative Content】

This design is based on the shape of the “Toothbrush head.”



[Annex 2]

Prior Design 1

【Article to Which Design Is Applied】 Toothbrush

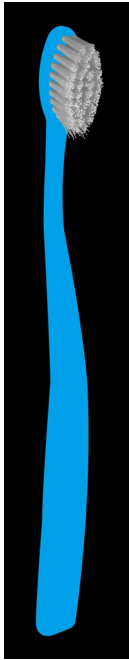
【Description of Design】

1. The material is synthetic resin.
2. This design is a partial design, and the portion excluding sky blue part is intended to be registered.
3. This design was created with the motif of the legendary tale of a flower which blooms once every three millennia.
4. This design is intended to have a rounded tip of the toothbrush head so that it can be effectively used to scrape food residues off of teeth without damaging the gums.
5. Additional FIG 1.1 is an enlarged view of the toothbrush head of this design, and Additional FIG 1.2 is an enlarged view of the toothbrush head of Additional FIG 1.1.

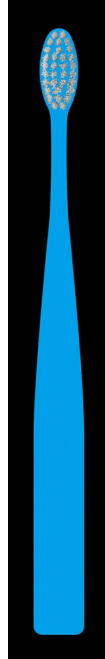
【Summary of Design's Creative Content】

The combination of the form and shape of this toothbrush design is the basis of the design's creative content.

Tooth Brush Head Case



[FIG 1.1]



[FIG 1.2]



[FIG 1.3]



[FIG 1.4]



[FIG 1.5]



[FIG 1.6]



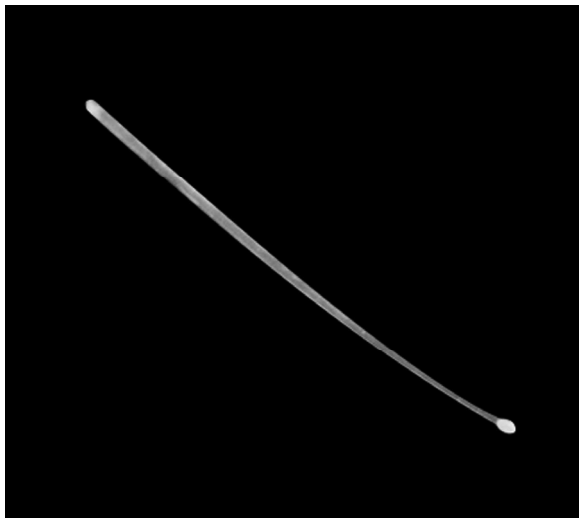
[FIG 1.7]

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[Additional FIG 1.1]



[Additional FIG 1.2]



[Annex 3]

Prior Design 2

【Article to Which Design Is Applied】 Toothbrush



FIG. 1



FIG. 2



FIG. 3

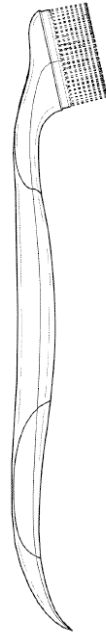


FIG. 4

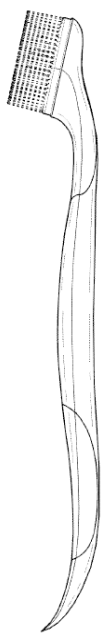


FIG. 5

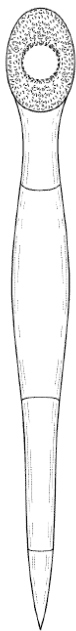


FIG. 6



FIG. 7



FIG. 8

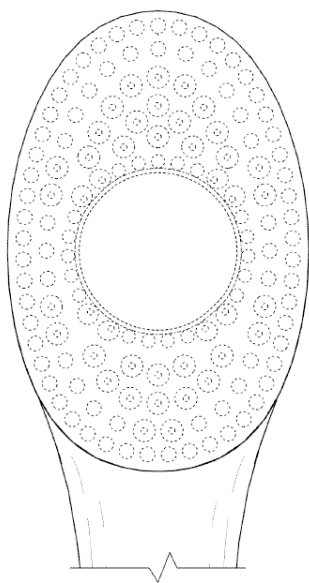


FIG. 9

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