

PATENT COURT OF KOREA
FIFTH DIVISION
DECISION

Case No. 2019Heo6655 Invalidation of Registration
(Design)

Plaintiff A
Counsel for the Plaintiff
Patent Attorney Youngsu KIM

Defendant B
Counsel for the Defendant
Patent Attorney Jaewan LEE

Date of Closing Argument April 3, 2020

Decision Date May 15, 2020

ORDER

1. The Plaintiff's claim is dismissed.
2. The Plaintiff shall bear the cost arising from this litigation.

PLAINTIFF'S DEMAND

The Intellectual Property Trial And Appeal Board (IPTAB) Decision (2019Dang873) dated July 23, 2019, shall be revoked.

OPINION

1. Background

A. Registered Design at Issue (hereinafter the “Subject Design”) (Plaintiff’s Exhibits 2 and 3)

- 1) Filing Date/Date of Registration/Registration No.: May 14, 2012/July 2, 2013/No. 30-0700454
- 2) Article subject to the design (hereinafter the “Subject Article”): Floodlight lens
- 3) Description and drawing of the Subject Design: as provided in the Appendix
- 4) Design right holder: Defendant

B. IPTAB Decision

1) On March 14, 2019, the Plaintiff filed a petition to the IPTAB against the Defendant, who is the owner of the design rights. The Plaintiff sought the Registered Design to be invalidated because the Subject Article cannot be recognized as a product that is independently traded in its normal state, and its compatibility as well as the possibility of compatibility cannot be recognized and does not fall under the “article” element as stipulated in Article 2(i) of the old Design Protection Act (the Act that was replaced by Act No. 11848 on May 28, 2013, hereinafter the “old Design Protection Act”). Moreover, the Registered Design was registered in violation of Article 5(1) of the old Design Protection Act. Therefore, the registration shall be invalidated.

2) The IPTAB assessed the said petition as Case No. 2019Dang 873 and dismissed the Plaintiff's petition on July 23, 2019, because the Subject Article falls under the "article" in Article 2(i) of the old Design Protection Act and the design usable for an industrial purpose under Article 5.1 of the same Act.

【Factual Basis】 Statements in Plaintiff's Exhibits 1, 2, and 3 and the purport of the overall argument

2. Whether or Not IPTAB Erred

A. Summary of Parties' Arguments

1) Summary of Plaintiff's Arguments

A) The Subject Article is named under the Product Classification Table of the Notification of the Korean Intellectual Property Office (KIPO) under Categories of Design Articles (KIPO Notification No. 2011-4, hereinafter the "KIPO Notification"). Nevertheless, the KIPO Notification is only intended to maintain consistency in the design registration application by encouraging the applicants to use uniform product names. It is not intended to determine whether the product meets the article requirement. Therefore, such determination must be done separately.

B) The Subject Article is a component used to manufacture end products such as automobile work lamps. It is bundled together with other components and designed to fit with other components. However, it can only be used with other components that go through the same component manufacturing processes. It is a made-to-order component for and by the end-product manufacturers and is used for making a specific end product. Therefore, it cannot be recognized as a product independently traded alone in its normal state.

C) The Subject Article is die-manufactured to form a specific

PATENT COURT DECISIONS

shape according to the original design. It can only be used for the end product it was designed for because of its differences in size or the coupling grooves. Therefore, it cannot be recognized as compatible.

D) Furthermore, the end product made with the Subject Article is combined to a protective cover, housing, and lens through hot melting process during the final manufacturing stage. This makes it hard for end-users or traders to separate or disassemble the product to replace any of the components. Moreover, the Subject Article is not traded independently.

E) Given the Subject Article's structure and shape, its coupling structure with other components, and tradability in the market, the Subject Article cannot be traded independently because it lacks compatibility and the possibility thereof, not subject to an independent dealing and the possibility thereof, thus failing to meet the article requirement. Therefore, the administrative decision that differed from these conclusions is erroneous.

2) Defendant's Arguments

A) The Subject Design meets the article requirement because it was registered based on the "floodlight lens" listed in the Product Classification Table of the KIPO Notification, which has the effect of an administrative order that classifies the products eligible for design registration under Article 9(1) of the Enforcement Rules of the Former Design Protection Act and Article 11(2) of the old Design Protection Act, which supplements Article 2 (Definitions) and Article 5 (Requirements for Design Registration) of the same Act.

B) Furthermore, the Subject Article is or can be traded independently, and can be compatible for the following reasons: (1) Products to which the Subject Article was applied were advertised in automobile-related magazines, and products of the same kind as the Subject Article were sold or advertised in many Internet shopping

mall; (2) the Subject Article concentrates the light, and the application for the Subject Design's registration was made with 3D drawings, with the Subject Article in a slim shape with two screw-fastening parts, and this enables various assembly methods for lighting fixtures, which include hot melting, silicone bonding, and screw fastening. Therefore, consumers (manufacturers) can purchase articles applying the Subject Design to use them as parts for various lighting fixtures. (3) The Subject Article is interchangeable with the lens used in the Plaintiff's lighting fixtures.

C) Therefore, the administrative decision concluding the same is not erroneous because the Subject Design is usable for an industrial purpose under the body of Article 5.1 of the Former Design Protection Act.

B. Whether the Subject Design Is Subject to Article 2(i) of the Former Design Protection Act

1) Relevant Law

The term "article" referred to in Article 2(i) of the old Design Protection Act pertains to a tangible property with independence. An article must be independently tradable in its normal state for it to be eligible for design registration. If that article is a part of a product, then it implies its compatibility. However, it does not necessarily mean that the part is traded and compatible. It is eligible for design registration as long as it is the subject of such an independent transaction and has the possibility of compatibility. (Supreme Court Decision, 98Hu2900, decided April 27, 2001; Supreme Court Decision, 2003Hu274, decided July 9, 2004).

2) Established Facts

The following facts are acknowledged based on the statements and

PATENT COURT DECISIONS

images in the Plaintiff's Exhibit 27 and the Defendant's Exhibits 3, 4, 8 through 12, 16, 20 through 23, and 27 (including hyphenated numbers, if any; the same applies hereinafter) along with the purpose of the overall argument.

A) LED floodlights¹⁾ used as the work lamp for automobiles, heavy equipment, and ships are manufactured by assembling lenses (the Subject Article) with a reflector inside a space formed by a front protective cover and rear housing. A printed circuit board (PCB) assembly is also placed inside the space.


B) In the 20th issue of Trucks and Special Vehicles in 2012, an automobile-related magazine, various products manufactured by C operated by the Defendant are featured under the "Parts" category. Among them, in the "LED circular tail lamps" column, as shown in the picture on the right, the finished product's images and product name, "LED circular tail lamp (MODEL NO: KT11-R)," are provided. Underneath the model number is the statement, "this product shall not be reproduced without permission since its lens and reflector are patented and protected under patent law." Below the statement, lenses that are components of the circular tail lamps above are shown in various colors, including the image of the lens to which the Subject Design is applied (the lenses are marked by a red square).





1) The term "floodlight" refers to a lighting unit such as a headlight, searchlight, and lamp. (Source: Naver, Doopedia)

Under the “LED WORK LAMP” column, a picture of a finished product, “LED rectangular work lamp (Model: LK85-3),” that appears to have applied the Subject Design is featured. The same content and picture above are also featured in the 24th issue of Trucks and Special Vehicles in 2015.


C) In addition to selling finished work lamps, C Auto, which is operated by the Defendant, separately sold the lens and a part of the work lamp to D on August 5, 2013.

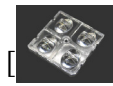
D) In “COUPANG”, which is a domestic online shopping mall, a diffused lens light shaped as  is on sale for the LED interior lights that can be installed on the New SM-5-XE, SE, and PE vehicles. Auction, a domestic Internet shopping mall, also sells the LED circular substrate for lighting and lens set, and its lens part


shaped as . Z (www.Z.co.kr), an online shopping mall selling

LED lighting fixtures in Korea, sells LED lenses shaped as ]

and ].

E) E, a Chinese lighting fixture manufacturer, advertises a number of lenses for LED floodlights shaped as  on its website.²⁾ In Alibaba³⁾, a global online shopping mall, lenses shaped as




and  for LED floodlights and manufactured by F, a Chinese lighting fixture manufacturer, are traded. Y (www.Y.com), an online shopping mall selling lighting fixtures in China, categorized various lighting parts, such as LED lens, reflectors, and lamp


2) <https://www.bicomoptics.com/en/products/classtwo.aspx?Bid=5&sid=506>


3) <https://www.darkoo.en.alibaba.com/>


PATENT COURT DECISIONS

covers/shades, under “Lighting Components.” It also sells a LED floodlight lens shaped as .

F) Both the floodlight manufactured by G Ind., which is operated by the Plaintiff (model name: SH-L107, hereinafter the “Plaintiff’s Product”), and C’s floodlight (model name: LK85-3, hereinafter the “Defendant’s Product”), which uses the Subject Article, consist of five main components: the protective cover, floodlight lens, reflector, PCB, and housing. In other words, it is possible to assemble the Plaintiff’s Product with the lens used for the Defendant’s Product. As shown in the picture below, it is also possible to assemble the Plaintiff’s Product using an assembly (the reflecting plate consisting of floodlight lenses and a reflector) used in the Defendant’s Product by combining a part (reflective plate for the emitter).

Plaintiff’s Product (Finished Product)	Defendant’s Product (Finished Product)	A product comprising the Plaintiff’s Product and the Defendant’s assembly (the reflecting plate comprised of lenses and a reflector)
		

G) The Plaintiff filed an application on November 29, 2017 for a design shaped as ‘’ for a “work lamp lens,” as the article subject to the design, which was registered on July 13, 2018 (No. 30-0950903). On June 19, 2018, the Plaintiff filed another application

for a design shaped as ‘’, for a “LED work lamp,” as the article subject to the design, which was registered on July 12, 2019 (No. 30-1015566).

3) Analysis

According to the established facts above, it is reasonable to say that the Subject Article, “floodlight lens,” is not an end product but a part of a floodlight.



However, given the following facts and circumstances acknowledgeable based on the established facts above and the purport of the overall argument shown in the statements of the Plaintiff’s Exhibit 43 and images, the Subject Article should be considered compatible and independently tradable by the traders who buy the Subject Article to manufacture their floodlights, although it is rarely an independent trade item for general consumers.

① (a) Floodlights that use the Subject Article as a component are manufactured by contacting and forcibly combining the lens to a reflector inside a space formed by a frontal protective cover and rear housing, then placing a combinative body that is a combination of PCB assembly, and then combining them altogether. Given the manufacturing method of a floodlight, it is difficult to say that the floodlight lens must be manufactured together with other parts constituting the floodlight. It is foreseeable that the end-product manufacturer can manufacture end products (the floodlight) by assembling reflectors and PCBs with any purchased lenses as long as they meet the required specifications;⁴⁾ (b) Many domestic and overseas companies make products identical or similar to the Subject

4) The Plaintiff admitted that it purchases LED and provides it to its PCB supplier to have the LED-assembled PCB ready for its finished product. (Plaintiff’s brief dated October 17, 2019)

PATENT COURT DECISIONS

Article, and some companies have categorized the lighting fixture parts, including lenses, on their websites. Furthermore, the Defendant posted a photo of the part to which the Subject Design was applied featured in the automobile-related magazine, Trucks and Special Vehicles, along with a statement that the Subject Article, aside from the end products, was granted a design registration. The Defendant had also sold the lenses separately; (c) As the Plaintiff has admitted⁵⁾ that many companies other than the Defendant trade a number of end products that appear to have applied the design identical or similar to the Subject Design [in particular, the number and arrangement of the

lenses in the LED lamps () and () manufactured by J seem to be identical to those of the Subject Design, as stated in the Plaintiff's Exhibit 39]. As such, the Subject Article can be traded independently because floodlight lens manufacturers can sell the lens to other end manufacturers.

② Furthermore, given the Subject Design's characteristics above and the manufacturing method of the end product, the Subject Article's compatibility is recognizable because any lens can be purchased in the market for replacement, as long as it meets the required specifications and regardless of whether the floodlight lenses or reflectors are manufactured by different companies. (For example, it may be possible to assemble a lens made by the Defendant with a reflector made by the Plaintiff, and vice versa.)

③ The floodlight lens are included in the Product Classification Table of the KIPO Notification that was valid at the time of applying for the design registration of the Subject Design. However, the lens' inclusion does not mean that the article is recognized as "usable for an industrial purpose" because the KIPO Notification's purpose is to maintain consistency in the design registration application by

5) Plaintiff's brief dated October 14, 2019

encouraging the applicants to use uniform product names, a Subject Design and Subject Article that are identical or similar, and many similar designs that are registered, in which multiple lenses form a rectangular or circular-shaped plate. The Plaintiff also registered two designs similar to the shape of the Subject Design for the articles “lens for work lamp” and “lens for LED work lamp.”

4) Discussion on Plaintiff’s Arguments

A) The Plaintiff argues that the floodlight lenses (the Subject Article), a reflector, and a PCB are placed inside a space formed by a frontal protective cover and rear housing and that the protective cover, the housing, and the lenses, among others, are hot melted or bonded with silicone to manufacture the end product. Such a manufacturing method makes it impossible for general users to dismantle or disassemble the end product. Should an ordinary trader dismantle the end product, the groove or protruding parts of the product will be damaged in the dismantling process and it will be impossible to replace the damaged components, so none of the components can be traded separately in their normal state, and the compatibility or the possibility of compatibility is missing.

However, given the following facts and circumstances acknowledgeable based on the purport of the argument shown in the statements of the Plaintiff’s Exhibits 32 through 37, it is difficult to conclude that the Subject Article cannot be traded independently and that there is no possibility of compatibility as the Plaintiff has argued above. ① As shown earlier, end-product manufacturers can purchase lenses (the Subject Article) separately to assemble them with other components, such as reflectors and PCBs, and to make end products. ② Manufacturers can produce end products through various methods, including hot melting as purported by the Plaintiff. These methods include silicone bonding and screw fastening, as there are no restrictions on the assembling of the Subject Article with other

PATENT COURT DECISIONS

components. Therefore, the Plaintiff's arguments above are without merit.

B) The Plaintiff argues that parts whose dimensions and specifications are prescribed under the Korean Industrial Standards (KS) can be obtained in the market for replacement or substitution even if they are made by different manufacturers. Parts whose names and prices are listed as price information published by official agencies can be traded regularly because their dimensions and specifications are standardized under the KS. On the other hand, the Subject Article's dimensions and specifications are not standardized, and products applied with a design identical or similar to the Subject Design have varying shapes, forms, and prices. Therefore, the Plaintiff argues that the Subject Design fails to meet the article requirement.

A part can be used as a replacement or substitution of an existing part, even if its dimensions and specifications are not standardized under the KS or its name and price are not listed as official price information, as long as its specifications match those of the existing part. The part's dimensions and specifications can likely be adjusted according to the buyer's request and the price may also change depending on the order size or type of materials. Therefore, it is unreasonable to conclude that there is no possibility of independent trade or compatibility for the Subject Article as in the Plaintiff's argument and the Plaintiff's argument above is without merit.

5) Summary of Analysis

In summary, it can be said that the Subject Article can be a subject of a design under the old Design Protection Act.

C. Summary of Discussion

Therefore, the Subject Design's registration cannot be invalidated, and the IPTAB Decision that is consistent with the aforementioned

analysis shall be upheld.

3. Conclusion

The Plaintiff's claim to revoke the IPTAB Decision is without merit and is, therefore, dismissed.

Presiding Judge	Seungryul SEO
Judge	Yunhyung JEONG
Judge	Donggyu KIM

[Appendix]

List (Subject Design)

【Description of the Design】

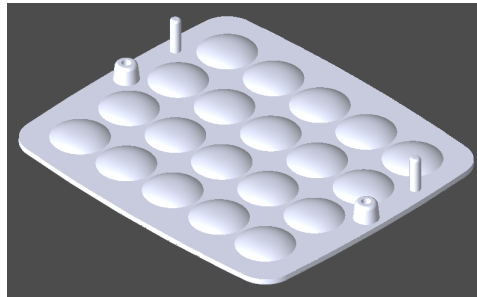
The lens used in floodlights collect light emitted from light sources, such as LEDs, to a particular range, and it is made from synthetic resin.

【Essence of the Creation】

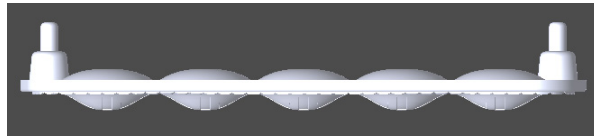
Shape and Pattern of the Floodlight Lens

【Drawings (Extracted from 3D Drawings)】

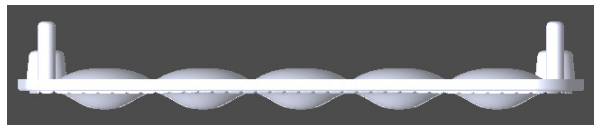
[Drawing 1.1]



[Drawing 1.2]

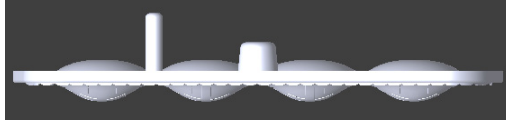


[Drawing 1.3]

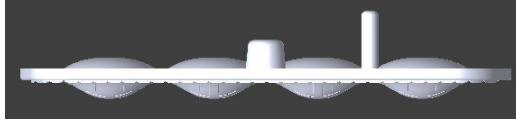


Floodlight Lens Case

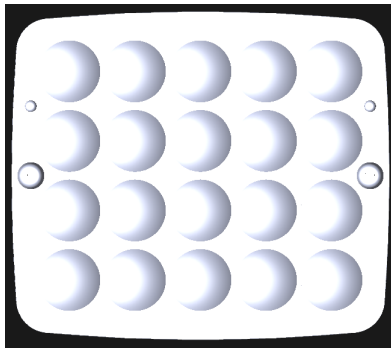
[Drawing 1.4]



[Drawing 1.5]



[Drawing 1.6]



[Drawing 1.7]



End.