PATENT COURT OF KOREA

SECOND DIVISION

DECISION

Case No.	2013Heo9805 Invalidation (Patent)
Plaintiff	A
Defendant	1. B Co., Ltd. CEO C, D, E 2. F Co., Ltd. CEO G Counsels for Defendants 1 and 2 KCL LLC. Attorneys in Charge Yeongcheol KIM, Beom hee KIM 3. H Co., Ltd. CEO I Counsels for Defendant 3 BAE, KIM & LEE LLC Attorneys in Charge Myeonggyu LEE, Mungi NAM, Hyeongji KIM Patent Attorneys in Charge Doyeon HWANG, Seongwook YANG
Date of Closing Argument	June 19, 2014
Decision Date	July 10, 2014

ORDER

1. The plaintiff's claim is dismissed.

2. The cost arising from this litigation shall be borne by the plaintiff.

PLAINTIFF'S DEMAND

The IPTAB Decision 2013Jaedang2 dated November 18, 2013 shall be revoked.

OPINION

1. Background

A. Patented Invention at Issue (hereinafter the "Subject Invention")

1) Title of invention: High performance double-layer glass system with therma l break spacer

2) Filing date of original application/ filing date of application/ date of registrat ion/ registration number: September 18, 2001/ March 19, 2002/ August 2, 20 04/ No. 444151

3) Patent holder: Defendant B Co., Ltd., Defendant F Co., Ltd.

B. IPTAB Decision

1) The Plaintiff joined the defendant B Co., Ltd. (hereinafter "B")on January 1, 1992, invented the "high performance double-layer glass system with thermal break spacer" which is the same as the Subject Invention, filed a utility model application therefor on September 18, 2001, and completed the utility model registration on November 28, 2001 (hereinafter the "Subject Utility Model Right").

2) The plaintiff decided to assign, for consideration, the Subject Utility Model Right to the defendant B and the defendant F Co., Ltd. (hereinafter "F"), assigned 1/2 of the Subject Utility Model Right to the defendant F on March 19, 2002, and, on the same date, assigned the remaining 1/2 of the Subject Utility Model Right to the defendant B.

3) The defendants B and F completed the patent registration of the Subject Invention with the Subject Utility Model Right as an original application on June 23, 2004, and abandoned the Subject Utility Model Right and had the

registration thereof extinguished on or around July 30, 2004.

4) However, the defendants F and B failed to provide the plaintiff with the consideration for assignment stated in Paragraph 2) above.

5) In response, the plaintiff filed a lawsuit with the Seoul Eastern District Court against the defendant F to seek the provision of consideration on May 25, 2007, and reconciliation was made on October 10, 2007 to the effect that the defendant F would provide the plaintiff with fees for patent (2007Gahap7773).

6) Meanwhile, as a settlement was not made amicably between the plaintiff and the defendant B as to the consideration for assignment of the Subject Utility Model Right, the plaintiff submitted a letter of resignation on May 16, 2010, but the defendant B did not accept the letter of resignation and, on May 31, 2010, dismissed the plaintiff on the ground that the plaintiff violated its company regulations for employee invention.

7) In response, the plaintiff filed a lawsuit with the Seoul Central District Court against the defendant B on July 7, 2010 to seek to transfer 1/2 of the patent right in the Subject Invention on the ground that an agreement to assign the Subject Utility Model Right was canceled. The Seoul Central District Court heard the petition as 2010Gahap6924 and then, on November 4, 2011, decided to grant the plaintiff's petition on the grounds that since the agreement to assign the Subject Utility Model Right between the plaintiff and the defendant B was lawfully canceled and the Subject Invention was registered with the Subject Utility Model Right as the original application, the defendant B was under an obligation to take transfer registration procedures for its share of the patent right in the Subject Invention, based on the cancellation of the assignment agreement (hereinafter the "Lower Court's Decision").

8) On December 7, 2011, the defendant B filed an appeal against the Lower Court's Decision to the Seoul High Court as 2001Na98503.

9) Meanwhile, the defendant H Co., Ltd. (hereinafter "H") filed a petition on February 24, 2012 for the invalidation of registration of the Subject Invention with the Intellectual Property Trial and Appeal Board (hereinafter the "IPTAB") against the defendants B and F. The IPTAB heard the petition as 2012Dang510 and, on June 27, 2012, decided to invalidate the Subject Invention on the ground that the Subject Invention cannot be deemed an invention completed at the time of its application, and the above administrative decision became final and conclusive on August 7, 2012 (hereinafter the "Original IPTAB Decision").

10) On September 28, 2012, the Seoul High Court revoked, in 2011Na98503, the Lower Court's Decision and rendered its decision to dismiss the litigation at issue on the grounds that since the patent right of the Subject Invention was extinguished retroactively when the Original IPTAB Decision became final and conclusive, the litigation at issue, which sought the transfer registration for the share in patent, has no merit.

11) The plaintiff filed a petition for retrial on the Original IPTAB Decision with the IPTAB on September 5, 2012 on the grounds that the defendants who were parties to the Original IPTAB Decision acted in collusion for the purpose of causing an administrative decision to be rendered which infringed on the plaintiff's right or interest by deception.

12) The IPTAB heard the petition for retrial as 2012Jaedang1 and, on February 15, 2013, rendered its decision to dismiss the petition for retrial filed by the plaintiff on the grounds that since there is insufficient evidence that the Original IPTAB Decision falls under a trial ruling rendered which infringes on a third party's right or interest, the petition for retrial cannot be deemed a lawful petition under Article 179 of the Patent Act (hereinafter the "First IPTAB Decision").

13) The plaintiff filed a revocation action against the First IPTAB Decision

with the Patent Court of Korea as 2013Heo1832, and the Patent Court decided to dismiss the plaintiff's petition on September 12, 2013 on the ground that it is insufficient to admit that the defendants acted in collusion for the purpose of causing the Original IPTAB Decision to be rendered which infringes the plaintiff's right or interest.

14) On October 8, 2013, the plaintiff filed an appeal with the Supreme Court against the above decision by the Patent Court as 2013Hu2477, and the Supreme Court dismissed the appeal by the plaintiff without hearing on December 12, 2013 and the First IPTAB Decision became final and conclusive.

15) Meanwhile, the plaintiff filed with the IPTAB a petition for retrial of the Original IPTAB Decision on October 10, 2013, immediately after filing of the above appeal, on the ground that the defendants who were the parties to the Original IPTAB Decision acted in collusion for the purpose of causing the Original IPTAB Decision to be rendered which infringes on the plaintiff's right or interest.

16) The IPTAB heard the above petition for retrial as 2013Jaedang2 and rendered an administrative decision to dismiss the petition for retrial under Article 142 of the Patent Act on the ground that the petition for retrial is the same as the petition for trial as 2012JaeDang1 and thus a double petition.

【Factual basis】 Undisputed facts, statements in the Plaintiff's Exhibits 1 through 3, 7, 8, 10, 18, 19, 20, and 22 and the Defendant's Exhibits 1 and 2, and the purport of the overall argument

2. Summary of Parties' Arguments

A. Plaintiff

As the IPTAB Decision 2013JaeDang1 became final and conclusive, the pe tition for trial is not pending. Thus, the petition for retrial at issue is not a dou ble petition for trial.

B. Defendants

The petition for trial at issue is a double petition for trial and was filed after the period for filing a petition for retrial. Thus, the petition for trial at i ssue shall not be upheld.

3. Discussion on Merits of IPTAB Decision

A. Whether Petition for Retrial at Issue is Double Petition for Trial

1) Relevant laws and legal principles

Article 259 of the Civil Procedure Act that is applied mutatis mutandis in Article 154(7) of the Patent Act stipulates that “for a case pending before a cou rt, neither party shall institute any lawsuit again,” and its elements are as follow s: first, the parties shall be identical; second, the petitions shall be identical; and third, a subsequent lawsuit shall be instituted while a preceding lawsuit is pendin g.

When applying the elements stated above to the prohibition of double petitio n for trial as to patent right, the following question is raised for the third eleme nt: whether the expression “while a preceding lawsuit is pending” means a “prec eding lawsuit is pending before the IPTAB,” or if it refers to a “case in which a decision rendered in the preceding lawsuit does not become final and conclusiv e.”

It would be reasonable to construe the expression “while a preceding lawsuit is pending” as a “case in which a decision rendered in the preceding lawsuit do es not become final and conclusive” in light of the following circumstances: ① Even if a petitioner institutes a revocation action against a decision rendered in t he preceding administrative proceedings and then requests the same administrative trial before the administrative decision becomes final and conclusive, the subsequ ent petition for the administrative trial would not violate the principle of res judi cata, provided that the expression “while a preceding lawsuit is pending” is cons

trued narrowly as a “preceding lawsuit is pending before the IPTAB” (See, Supr eme Court Decision, 2009Hu2234, dated January 19, 2012), and since the IPTAB shall render a decision on the subsequent petition for administrative trial, there w ould be two decisions on the identical petition for administrative proceedings, wh ich would be contrary to the legislative purport of provision which prohibits dou ble petition for trial to prevent procedures of no or little use from being repeate d. ② If the expression “while a preceding lawsuit is pending” is construed narro wly as a “preceding lawsuit is pending before the IPTAB,” a petitioner who is s ubject to an unfavorable decision rendered in the preceding administrative decisio n may institute a revocation action against an administrative decision and file a petition for the same administrative trial. In this case, a respondent shall defend his/her cases against not only the revocation action but also the newly institutued petition for administrative trial. This would be contrary to the judicial economy, and the legislative purport of provision which prohibits double petition for trial t o prevent an abuse of the right to institute a petition for trial would not be achi eved. ③ Where an action is instituted to revoke an administrative decision in th e preceding lawsuit and a petition was filed for the same administrative trial, the retrial proceedings will commence while the subsequent petition for administrative trial is still pending, provided that a decision is rendered to revoke the decision rendered in the preceding lawsuit and becomes final and conclusive. Thus, it wo uld be unreasonable for the same parties to proceed with two legal proceedings f or the same petition.

2) Discussion

The petition for trial at issue and the prior petition for preceding trial un der Case No. 2012Jaedang1 dated September 5, 2012 are a double petition for tr ial in light of the following: ① the petitioners and the respondents are identical; ② the petition for retrial of the Original IPTAB Decision is that retrial is to be

instituted on the ground that in the Original IPTAB Decision, the defendants who are the parties to the trial acted in collusion for the purpose of causing a decision to be rendered which infringes on the plaintiff's right or interest; and ③ since the revocation action on the petition for the preceding trial is pending, the petition is instituted while the decision has not become final and conclusive.

B. Whether Period for Filing Petition for Retrial Is Exceeded

A petition for retrial shall be filed within 30 days from the date when a party becomes aware of the ground for retrial after an administrative decision becomes final and conclusive. Since the Original IPTAB Decision became final and conclusive on August 7, 2012, it shall be deemed that the plaintiff became aware of the ground for retrial on or around September 5, 2012, when the plaintiff filed a petition for retrial as 2012Jaedang1 with the IPTAB on the ground that the Original IPTAB Decision was caused to be rendered which infringed on the plaintiff's right or interest.

Thus, the petition for retrial at issue, which was instituted on October 10, 2013, was filed more than 30 days after September 5, 2012, and thus shall not be upheld.

The plaintiff argues to the effect that the period for filing the petition for retrial shall be computed from when he/she came to be aware objectively, from Plaintiff's Exhibits 4 and 6, which are new evidence that could not be presented in the preceding proceedings, that the Original IPTAB Decision was caused to be rendered which infringed on the plaintiff's right or interest.

However, the plaintiff's arguments above would not be accepted in light of the following circumstances: it is reasonable to deem that the plaintiff already knew of the grounds for retrial when the plaintiff argued the grounds for retrial and filed the petition for retrial; the fact that the plaintiff found evidence to support the grounds for retrial is not for the plaintiff to become aware of new ground

s for retrial but to recognize evidence to additionally support the same grounds f or retrial; and thus, the period for filing a petition for retrial shall not be compu ted from when the plaintiff came to know of grounds for retrial and found evide nce that supports the grounds for retrial after filing the petition for retrial.

C. Summary of Discussion

Thus, the petition for retrial at issue us a double petition for trial or is ins tituted after the period for filing thereof. Thus, the petition for retrial at issue sh all not be upheld.

4. Conclusion

The IPTAB decision is therefore consistent with the above analysis and shall be upheld. The plaintiff's claim to revoke the IPTAB decision is without merit and therefore dismissed. It is so decided as ordered.

Presiding Judge Beomshik SEOL

Judge Jeonghoon PARK

Judge Jutak YOON