

PATENT COURT OF KOREA

FOURTH DIVISION

DECISION

| | |
|---------------------------------|--|
| Case No. | 2014Heo2184 Invalidation (Design) |
| Plaintiff | A Counsel for Plaintiff Patent Attorney Woong KIM |
| Defendant | B CEO C Counsels for Defendant Patent Attorneys Wooyeong LEE, Euncheol LEE, Juyeop KIM |
| Date of Closing Argument | May 28, 2014 |
| Decision Date | June 20, 2014 |

ORDER

1. The IPTAB Decision 2013Dang1184 dated February 28, 2014 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. Registered Design at Issue (Plaintiff's Exhibit 3)

1) Filing date of application/ date of registration/ design registration number:
September 28, 2012/ November 14, 2012/ No. 668925

2) Article on which design is expressed: Simplified sprinkler

3) Description, point, and drawing of design: As specified in Annex 1.

4) Design right holder: Defendant

B. Prior designs

1) Prior design 1 (Plaintiff's Exhibits 4-2 and 6)

This is a design of the simplified sprinkler that the defendant installed, on or around June 11, 2012, in the elderly and children facilities located in Jincheon-gun, Chungcheongbuk-do as illustrated in an image under Paragraph 1 of Annex 2.

2) Prior design 2 (Plaintiff's Exhibit 8-1)

This is a design of the simplified sprinkler posted in an Internet blog (<http://D/ldkname/7597529>) on July 4, 2009 as illustrated in an image under Paragraph 2 of Annex 2.

3) Prior design 3 (Plaintiff's Exhibit 8-2)

This is a design of the simplified sprinkler posted in an Internet newspaper (<http://E/news/articleView.html?idxno=6932>) on November 24, 2011 as illustrated in an image under Paragraph 3 of Annex 2.

4) Prior design 4 (Plaintiff's Exhibit 8-3)

This is a design of the simplified sprinkler posted in an Internet newspaper (http://F/sub_read.html?uid=13526) on June 10, 2011 as illustrated in an image under Paragraph 4 of Annex 2.

5) Prior design 5 (Plaintiff's Exhibit 8-4)

This is a design of the simplified sprinkler posted in an Internet blog (<http://D/ldkname/7597652>) on June 3, 2011 as illustrated in an image under Paragraph 5 of Annex 2.

6) Prior design 6 (Plaintiff's Exhibit 8-5)

This is a design of the simplified sprinkler posted in an Internet newspaper (http://F/sub_read.html?uid=13680%A1%D7ion=sc81) on July 11, 2011 as illustrated in an image under Paragraph 6 of Annex 2.

7) Prior design 7 (Plaintiff's Exhibit 8-6)

This is a design of the simplified sprinkler posted in an Internet blog (<http://G/PostView.nhn?blogId=psk015&logNo=131568580>) on June 29, 2011 as illustrated in an image under Paragraph 7 of Annex 2.

8) Prior design 8 (Plaintiff's Exhibit 8-7)

This is a design of the simplified sprinkler posted in an Internet blog (<http://G/PostView.nhn?blogId=lph1052&logNo=90091010552>) on July 10, 2010 as illustrated in an image under Paragraph 8 of Annex 2.

9) Prior design 9 (Plaintiff's Exhibit 8-8)

This is a design of the simplified sprinkler posted on December 4, 2011 on Google, which is an Internet portal site, as illustrated in an image under Paragraph 9 of Annex 2.

10) Prior design 10 (Plaintiff's Exhibits 4-2, 10-1 through 5)

This is a design of the simplified sprinkler that the defendant himself/herself disclosed on April 3, 2012 as part of the procedure to receive the "KFI Technical Approval" from the Korea Fire Equipment Inspection Corporation as illustrated in an image under Paragraph 10 of Annex 2.

11) Prior design 11 (Plaintiff's Exhibits 15-1 through 3)

This is a design of the simplified sprinkler for which the defendant applied, on September 18, 2012, for the "KFI Technical Approval" with the Korea Fire Equipment Inspection Corporation as illustrated in an image under Paragraph 11 of Annex 2.

D. Application Process of Registered Design at Issue and IPTAB Decision

1) On September 28, 2012, the defendant filed an application for the Registered Design at Issue with the Korean Intellectual Property Office (hereinafter the “KIPO”), stating the “KFI Technical Approval” as the type of disclosure in the “Exception to Lack of Novelty” in the application and “April 3, 2012” as the date of disclosure. Also, the defendant submitted as evidentiary documents a catalog in which prior design 10 is contained and the relevant invoice and receipt (Plaintiff’s Exhibits 10-1 through 5).

2) On May 8, 2013, the plaintiff filed a petition for trial to invalidate the registration of the Registered Design at Issue against the defendant with the IPTAB, arguing to the effect that the “novelty of the Registered Design at Issue is denied by prior designs 1 and 10, and a person having ordinary skill in the art (hereinafter a ”skilled person“) to which the Registered Design at Issue pertains could easily create the Registered Design at Issue from prior designs 2 through 9. Thus, the Registered Design at Issue falls under each subparagraph of Article 5(1) and Paragraph (2) of the same Article of the Design Protection Act.”

3) The IPTAB heard the petition for trial as 2013Dang1184 and, on February 28, 2014, rendered the IPTAB Decision to dismiss the plaintiff’s petition for trial on the grounds that “since prior designs 1 and 10 are subject to the exception to lack of novelty in relation to the Registered Design at Issue, the novelty of the Registered Design at Issue is not denied by prior designs 1 and 10. Further, it may not be deemed that a skilled person could easily create the Registered Design at Issue from prior designs 2 through 9.”

[Factual basis] Statements in Plaintiff’s Exhibits 1, 2, 3, 6, 8-1 through 8, 9, 10-1 through 5, and 15-1 through 3, and the purport of the overall argument

2. Summary of Revocation of IPTAB Decision

A. The Registered Design at Issue may be invalidated as follows, and thus the

IPTAB decision inconsistent therewith shall not be upheld:

1) Before September 28, 2012, which is the filing date of the application of the Registered Design at Issue, prior design 10, which is identical or similar to the Registered Design at Issue, was already published. Thus, when the defendant filed an application for the Registered Design at Issue, the defendant stated, in the “Exception to Lack of Novelty” in the application, “KFI Technical Approval” as its type of disclosure and “April 3, 2012” as its date of disclosure. However, as evidentiary documents, the defendant only submitted a catalog in which prior design 10 is contained and the relevant invoice and receipt (Plaintiff’s Exhibits 10-1 through 5). Since the evidentiary documents do not correspond to the type and date of disclosure stated in the application, the defendant’s arguments for an exception to lack of novelty stated above are against the procedures for such arguments. Thus, the provisions for exception to lack of novelty shall not be applied to prior design 10. Since the Registered Design at Issue is identical or similar to prior design 10 disclosed before the application of the Registered Design at Issue, the registration of the Registered Design shall be invalidated due to lack of novelty.

2) Even if the defendant’s arguments for exception to lack of novelty stated above are lawful and the exception to lack of novelty is applicable to prior design 10, the Registered Design at Issue was similar to prior design 10 disclosed before its application, and the defendant publicly practiced prior design 1, which is identical to the Registered Design at Issue. Thus, since prior design 1 is not identical to prior design 10, the arguments for lack of novelty stated above would not be applicable to prior design 1. Thus, prior design 1 shall not be subject to the provisions for exception to lack of novelty. Since the Registered Design at Issue is identical or similar to prior design 1 published before the application of the Registered Design at Issue, its registration shall be invalidated.

3) Since the Registered Design at Issue could be easily created from prior designs 2 through 9 published before its application, its registration shall be invalidated.

B. Since the Registered Design at Issue is identical to prior design 11 published before its application, its registration shall be invalidated.

3. Whether Novelty of Registered Design at Issue Is Denied by prior design 1

A. Relevant Law

Article 8(1) of the Design Protection Act stipulates that “where a design owned by a person entitled to a design registration falls under Article 5(1)(i) or (ii), it shall not be deemed to fall under Paragraph (1) items (i) or (ii) of the same Article in applying Paragraphs (1) and 2 of the same Article to the design for which an application for registration was filed within six months from such date.” As to the procedures for application of the provisions stated above, Paragraph (2) of the same Article provides that “a person who intends to be the subject to the provision of Paragraph 1 shall, at the time of filing the application for design registration, submit a written application for design registration specifying the purport of said intention to the Commissioner of the KIPO, and submit documents proving the relevant facts within 30 days from the date of application for design registration: Provided, That this shall not apply where the design falls under any subparagraph of Article 5(1) against his/her will” (hereinafter the “Provision for Exception to Lack of Novelty”).

In general, the registration of a new design relates to the granting of an exclusive right to the creator of the design in return for the disclosure of the design. If a design is already disclosed at the time of the application which is identical or similar to a design whose application for registration is filed, the design whose application is filed lacks novelty and would not be eligible for design registration under Article 5(1) of the Design Protection Act, irrespective

of whether the design identical or similar to the design whose application is filed is disclosed by a person who is eligible for the registration of design or by a third party.

However, if the legal principles for novelty stated above are applied too strictly, it would be unfair to a person who is eligible for the design registration and would not correspond to the intent of the Design Protection Act to promote the development of industry. Accordingly, the Design Protection Act stipulates provisions for the exception to lack of novelty, and thus, where certain requirements and procedures are satisfied, the disclosed design shall not be viewed, in its relationship with a design whose application is filed, as a design under Article 5(1)(i) or (ii) of the Design Protection Act, i.e. “any design publicly known or worked in the Republic of Korea or in a foreign country prior to the application for design registration or any design which has been carried in a publication distributed in the Republic of Korea or in a foreign country, or which has become utilizable by the public through telecommunication lines prior to the application for design registration is filed.”

Furthermore, even if a person who has a right to register a design discloses the design several times within six months as stipulated in Article 8(1) of the Design Protection Act, each disclosure may be subject to the provisions for exception to lack of novelty. Where a design identical to the design is disclosed several times at the time of application of the design, it would be reasonable to construe that even if an applicant argues the exception to lack of novelty only against a design which was disclosed first, the applicant would naturally argue the exception to lack of novelty against all identical designs disclosed after the first design. The disclosure of design is not an act limited to a certain time from its nature but a state in which an act will be committed continuously. Thus, even if an argument for the exception to lack of novelty is raised only

for a design disclosed for the first time, it is necessary for the argument to have an effect on the designs disclosed continuously thereafter. Thus, even if an applicant of a design argues the exception to lack of novelty only for the initially disclosed design, it shall be construed that the provisions for the exception to lack of novelty shall also be applied to the remaining disclosed designs.

In comparing two designs, they would be identical when a shape, pattern, or color of an article comprised in the two designs invokes the same sense of beauty through visual perception.

B. Whether prior design 1 is Identical to prior design 10

As admitted above, prior design 1 and prior design 10 relate to the simplified sprinkler, and their shapes, patterns, and colors are as illustrated below.

| prior design 1 | prior design 10 |
|---|--|
|  |  |

While prior design 10 has no separate handle on a door at the top front,

prior design 1 has a rectangular handle on a door at the top front as shown in



‘ .’ In relation to such difference, prior design 1 is organized to open and close the door at the top front by putting a hand in the handle, while prior design 10 is organized, as illustrated in



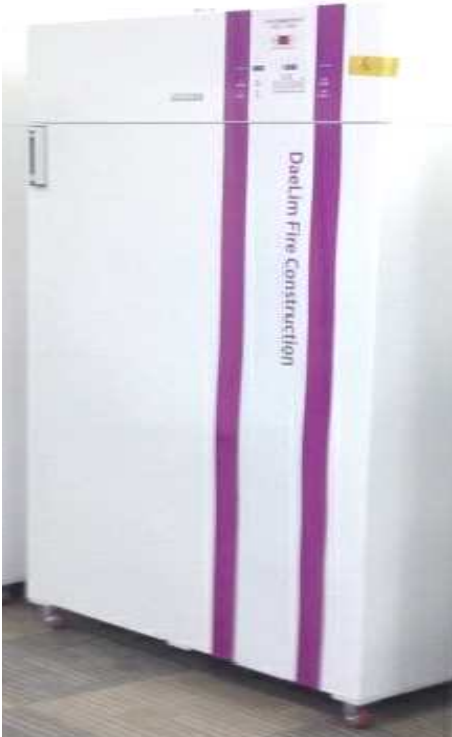
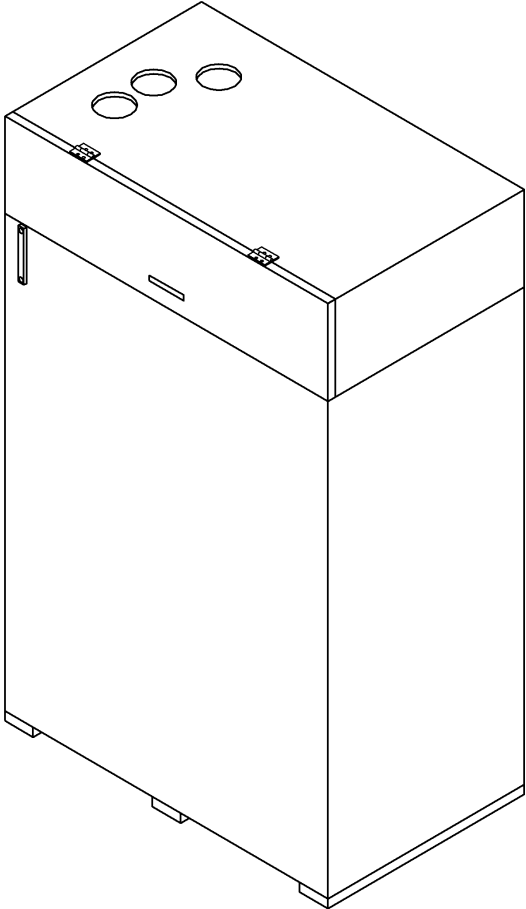
‘ ,’ with no separate handle, and thus the door

at the top front shall be opened and closed vertically with both hands. Parties argue nothing about such facts. Even though the grip at the top of prior design 1 occupies only a small part of its area, the grip is located at the top front of prior design 1 and thus visible at eye level. Also, its function is to open and close a door vertically in prior design 1. Thus, it could be understood as an element to have an effect on appearance or a sense of beauty.

Thus, since prior design 1 and prior design 10 are different in the existence of a handle at the top front, which has an effect on appearance or a sense of beauty, they could not be viewed as identical designs whose shape, pattern color, or combination invokes the same sense of beauty through visual perception.

E. Whether prior design 1 is Identical or Similar to Registered Design at Issue

As admitted above, prior design 1 and the Registered Design at Issue both relate to the simplified sprinkler. As their appearances are as illustrated below, the parties do not dispute that elements (except the front) not contained in the following table among design elements of prior design 1 are identical to the corresponding design elements in the Registered Design at Issue.

| prior design 1 | Registered Design at Issue |
|--|---|
|  |  |

prior design 1 and the Registered Design at Issue are somewhat different in their details. However, they are identical in the ratio of top and bottom parts in the front and the position of handles in the top and bottom, which are predominant characteristics. Thus, prior design 1 and the Registered Design at Issue are identical or similar designs which invoke an identical or similar sense of beauty to ordinary observers as a whole (the plaintiff and the defendant do not dispute that the two designs are identical or similar).

D. Summary of Discussion

Thus, the provisions for exception to lack of novelty cannot be applied to prior design 1, and the Registered Design at Issue is identical or similar to prior design 1, which was disclosed before the application for the Registered Design a

t Issue was filed, and therefore the Registered Design at Issue is subject to Article 5(1)(i) of the Design Protection Act.

4. Conclusion

Since the registration of the Registered Design at Issue shall be invalidated, the IPTAB decision is inconsistent with the above analysis and shall not be upheld. Thus, the plaintiff's claim to revoke the IPTAB decision is therefore well grounded and shall be granted. It is so decided as ordered.

Presiding Judge Gyuhyeon HAN

Judge Dawoo LEE

Judge Hyejin LEE

[Annex 1]

Registered Design at Issue

1. Article on Which Design is Expressed

Simplified sprinkler

2. Description of Design

A. The materials are metal and synthetic resins.

B. The present design is a simplified sprinkler that is installed mainly inside a building and can extinguish a fire by spraying firewater stored therein in case of fire.

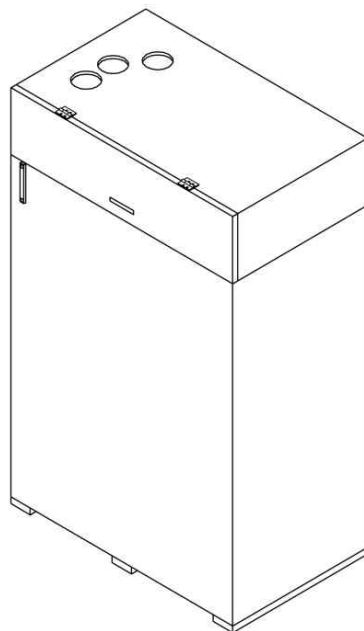
C. An upper part is opened to facilitate the maintenance and inspection as illustrated in swatch-type drawing 1.

3. Points of Design Creation

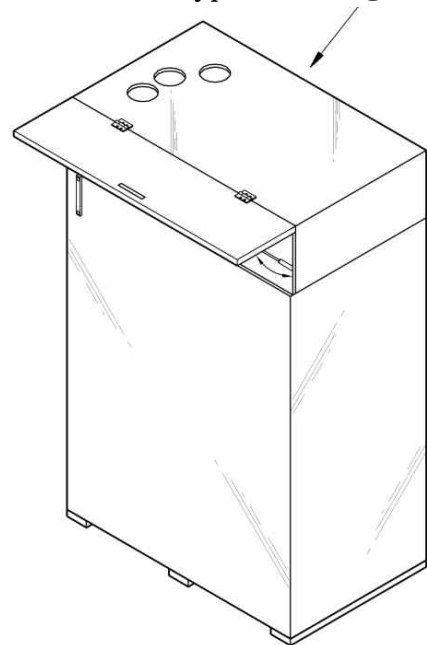
Combination of shape and pattern of the “simplified sprinkler”

4. Drawings

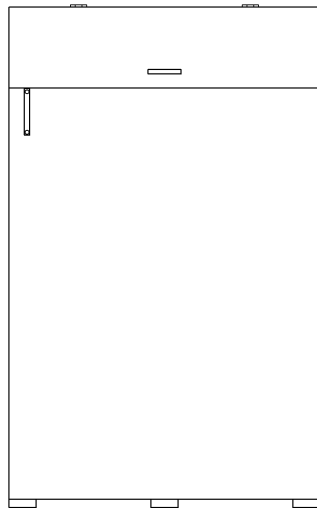
[Perspective View]



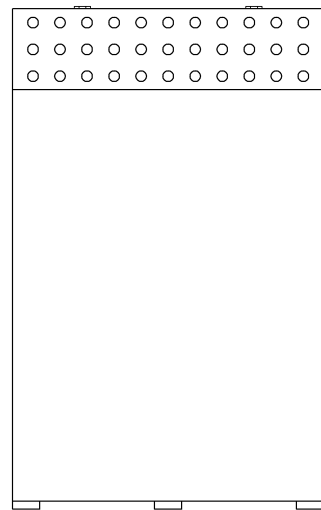
[Swatch-type Drawing 1]



[Front View]



[Rear View]



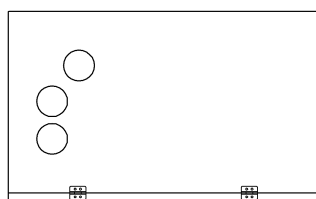
[Left Side View]



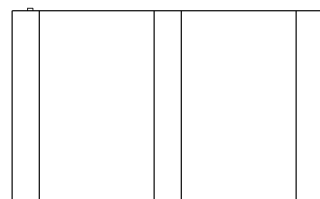
[Right Side View]

Symmetrical to Left Side View

[Top View]



[Bottom View]



[Annex 2]

Prior designs

1. Prior design 1 (Plaintiff's Exhibit 6)

| | |
|-------------|--|
| 진천 노유자시설 | Jincheon Elderly and Children Facilities |
| 간이스프링클러팩케이지 | Simplified Sprinkler Pack Cage |

진천 노유자시설 | 간이스프링클러팩케이지

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전용뷰어 보기



2. Prior design 2 (Plaintiff's Exhibit 8-1)



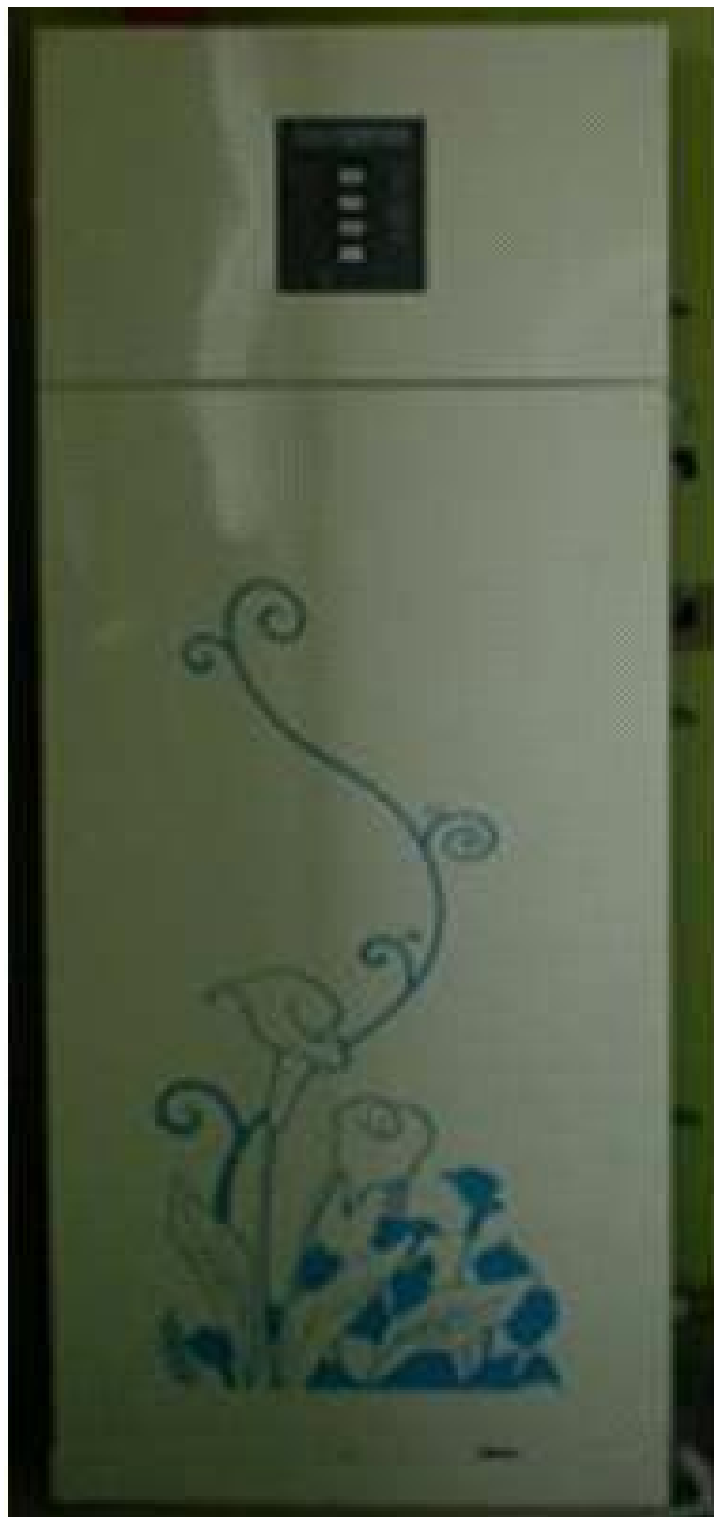
3. Prior design 3 (Plaintiff's Exhibit 8-2)



4. Prior design 4 (Plaintiff's Exhibit 8-3)



5. Prior design 5 (Plaintiff's Exhibit 8-4)



6. Prior design 6 (Plaintiff's Exhibit 8-5)



7. Prior design 7 (Plaintiff's Exhibit 8-6)



8. Prior design 8 (Plaintiff's Exhibit 8-7)



9. Prior design 9 (Plaintiff's Exhibit 8-8)



10. Prior design 10 (Plaintiff's Exhibits 10-1 through 5)



11. Prior design 11 (Plaintiff's Exhibits 15-1 through 3)



<End>