

PATENT COURT OF KOREA

SECOND DIVISION

DECISION

Case No. 2014Heo4555 Rejection (Patent)

Plaintiff A
Counsel for Plaintiff
Patent Attorney Seung HOON

Defendant Commissioner of Korean Intellectual Property
Office
Counsel for Defendant Byeongseong KIM

Date of Closing Argument October 14, 2014

Decision Date December 4, 2014

ORDER

1. The IPTAB Decision 2014Won75 dated May 27, 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. Claimed Invention at Issue

- 1) Title of invention: Dual mode vibrating accessory
- 2) Filing date of application/ application number: November 30, 2011/ No. 10-2011-126873
- 3) Applicant: Plaintiff

4) Claims (Amended on October 30, 2013. Hereinafter, each claim of the Claimed Invention shall be referred to in the format of “Claim 1,” and the invention as a whole as the “Claimed Invention”).

【Claim 1】 A dual mode vibrating accessory, comprising: a motor housing; a vibration motor inserted into the motor housing configured for a contact conductor with one polarity to face an opening of the motor housing; a battery housing screwed with the motor housing; the first battery inserted into the battery housing configured for a contact terminal to face an opening of the battery housing; the second battery inserted into the battery housing configured for a contact terminal to face an opening of the battery housing and arranged in parallel with the first battery; an insulating o-ring placed between the vibration motor and the second battery and adhered to a rim of the contact terminal in the second battery; a dual mode ring placed between the first battery and the second battery, adhered to a rim of the contact terminal in the first battery, and shaped in a way whose inner diameter becomes larger from the first battery to the second battery; and a watertight o-ring installed on a screw part of the motor housing between the motor housing and the battery housing, characterized in that, depending on a level of tightening and loosening of screws in the motor housing and the battery housing, the vibration motor could be turned on and off and a level of vibration could be adjusted in two levels by a short circuit of the vibration motor and the second battery, or electric connection between the vibration motor and the second battery and a short circuit between the first battery and the second battery, or electric connection between the vibration motor through the second battery and the first battery.

【Claim 2】 A dual mode vibrating accessory according to claim 1, wherein a length of screw formed in the battery housing is longer than a length of screw formed in a motor housing and a part of the second battery lies on a screw of

battery housing whose inner diameter is larger than an inner diameter of the battery housing.

【Claim 3】 A dual mode vibrating accessory according to claims 1 or 2, wherein a detachable ring to which a motor housing and a battery housing are screwed together and inserted at the top and a small figure-of-eight ring in which an insertion ring larger than the detachable ring is formed in parallel at the bottom of the detachable ring.

【Claim 4】 A dual mode vibrating accessory according to claims 1 or 2, wherein a detachable ring to which a motor housing and a battery housing are screwed together and inserted at the top and a large figure-of-eight ring in which an insertion ring larger than the detachable ring is formed in rotating 90 degrees and crossing at a right angle at the bottom of the detachable ring.

【Claim 5】 A dual mode vibrating accessory according to claim 4, wherein a number of soft embossing projections are formed on the whole external surface of the detachable ring.

【Claim 6】 A dual mode vibrating accessory according to claims 1 or 2, wherein a number of soft embossing projections are formed on the whole external surface of the detachable ring as a decoration cap to cover the motor housing and the battery housing.

5) Main drawings: As illustrated in Annex.

B. Procedural History

1) On March 12, 2013, a KIPO examiner issued a notice of grounds for rejection to the effect that “the Claimed Invention relates to sexual aids in essence in terms of its use or effect and may intensify sexual pleasure by exciting sexually or providing excessive stimulus to sexual organs, etc. Thus, since the Claimed Invention constitutes an invention that violates public order or sound morals, it is unpatentable under Article 32 of the Patent Act.”

2) On May 6, 2013, the plaintiff submitted an amendment and a written opinion, but, on September 29, 2013, the KIPO examiner issued a final rejection of the Claimed Invention on the ground that “since the Claimed Invention may violate public order or sound morals or is likely to harm public health, it is unpatentable under Article 32 of the Patent Act.”

3) On October 30, 2013, the plaintiff filed a request for re-examination and submitted an amendment. However, on December 4, 2013, the KIPO examiner issued a final rejection on the ground that “despite re-examination based on the amendment dated October 30, 2013, the ground for rejection dated March 12, 2013 has not been resolved.”

4) The plaintiff filed a petition to seek the revocation of the rejection decision with the Intellectual Property Trial and Appeal Board (hereinafter the “IPTAB”). After the IPTAB heard the petition as 2014Won75 and, on May 27, 2014, rendered an administrative decision (hereinafter the “IPTAB Decision”) dismissing the plaintiff’s petition for trial on the ground that “since the Claimed Invention may violate public order or sound morals or is likely to harm public health, it is unpatentable under Article 32 of the Patent Act,” as stated below:

An invention that violates public order or sound morals or is likely to harm public health as stipulated by Article 32 of the Patent Act includes not only an invention that originally intends to be immoral or scandalous but also the disclosure or use of an invention which is immoral or scandalous. However, it shall be deemed that a circumstance in which public order or sound moral may be violated by use of an invention for purposes other than its original purpose does not fall under Article 32 of the Patent Act.

In light of the statements and illustration in the detailed description of the Claimed Invention, an original purpose of the Claimed Invention is to increase a sexual stimulus on specific female body parts with dual modes. In terms of

constitution, it is obvious to excite specific female body parts with various forms in a dual mode vibrating accessory, figure-of-eight ring, embossing projections, and convex projections. Thus, it could be easily known that the Claimed Invention may be effective in arousing sexual curiosity and a sense of obscenity and stimulating sexual excitement in minors. Thus, a dual-mode vibrating accessory in the Claimed Invention intends to unnecessarily excite a sexual desire or increase a sexual feeling with excessive stimulus on sexual organs. Also, the Claimed Invention may arouse the sexual curiosity of minors unnecessarily or cause the general public to feel sexual humiliation. Thus, it may be deemed that the Claimed Invention may violate public order or sound morals.

【Factual basis】 Statements in Plaintiff's Exhibits 1 through 5 and Defendant's Exhibits 1 through 4 (including each hyphenated number, if any), and the purport of the overall argument

2. Parties' Arguments

A. Summary of Plaintiff's Argument for Revocation of IPTAB Decision

The Claimed Invention is not an invention that violates public order or sound morals or is likely to harm public health. Thus, the IPTAB decision, which is inconsistent with the above analysis, shall not be upheld.

B. Defendant's Arguments

Since the Claimed Invention is an invention that violates public order or sound morals or is likely to harm public health, the Claimed Invention is unpatentable under Article 32 of the Patent Act. Thus, the IPTAB decision, which is consistent with the above analysis and maintains the rejection determination at issue, shall be upheld.

3. Whether Claimed Invention Falls Under Article 32 of Patent Act

A. Relevant Laws and Regulations

- 1) Article 32 of the Patent Act

Article 32 of the Patent Act stipulates that “, no inventions that are feared to have risks to contravene public order or morality or to injure public health shall not be patentable, notwithstanding Articles 29(1) and (2)” and includes indeterminate concepts, such as “public order,” “morality,” etc.

2) Similar regulations and relevant laws

Article 103 of the Civil Act provides that “a juristic act which has for its object such matters as are contrary to good morals and other social order shall be null and void.” The term “good morals” in Article 103 of the Civil Act means general moral senses, i.e. the minimal morality with which everyone shall comply. Also, the term “social order” shall be construed to mean public order or a general interest of the state and society.

Meanwhile, the Criminal Act punishes the following: any person who distributes, sells, lends, openly displays, or shows any obscene documents, drawing, pictures, films, or other things (Article 243); a person who, for the purpose of accomplishing the acts as prescribed in Article 243, manufactures, possesses, imports, or exports obscene goods (Article 244); and a person who publicly commits an obscene act (Article 245). The Act on Promotion of Information and Communications Network Utilization and Information Protection, etc. and the Act on the Regulation of Amusement Business Affecting Public Morals have similar punishment provisions. The Supreme Court held as follows: ① in relation to the open display of obscene goods, “the term ‘obscene’ means to arouse sexual excitement by stimulating a sexual desire of the general public and to be contrary to sexual morality by causing sexual humiliation. Thus, the obscene goods shall express or describe specific bodily parts without reserve so that it may be estimated that the dignity or value of a human is severely damaged or distorted, not merely giving a sense of vulgarity as a whole” (See Supreme Court Decision, 2013Do9228, dated July 24, 2014). ② In relation to

the public indecency, “the term ‘obscene act’ under Article 245 of the Criminal Act is an act to arouse sexual excitement by stimulating a sexual desire of the general public and to be contrary to sexual morality by causing ordinary sexual humiliation. However, such act shall not necessarily portray a sexual act or display a sexual intent” (See Supreme Court Decision, 2005Do1264, dated January 13, 2006). ③ In relation to a violation of the Act on Promotion of Information and Communications Network Utilization and Information Protection, etc., “the term ‘obscenity’ in Article 44-7(1)(i) of the Act on Promotion of Information and Communications Network Utilization and Information Protection, etc. is to arouse sexual excitement by stimulating a sexual desire of the general public and to be contrary to sexual morality by causing ordinary sexual humiliation. Thus, when observing and estimating expressions, they shall express or describe specific bodily parts or acts without reserve so that it may be estimated that the dignity or value of a human to be respected and protected is severely damaged or distorted, not merely giving a sense of vulgarity or promiscuity as a whole.” In light of social norms, the obscene expressions are what appeals to sexual appeals entirely or predominantly but have no value at all in terms of culture, arts, ideology, science, medical science, or education. The expressions shall be estimated objectively and normatively as to whether they are obscene based not on subjective intention of their producer but on sound social norms (See Supreme Court Decision, 2011Do16580, dated October 25, 2012). ④ In relation to the Act on the Regulation of Amusement Business Affecting Public Morals, the “term ‘obscene act’ provided by subparagraph 1-2 of Article 3 of the old Act on the Regulation of Amusement Business Affecting Public Morals (before amendments were made to Act No. 10377 on July 23, 2010) means to harm the ordinary sexual humiliation of the general public and to be contrary to sound sexual morality, as an act to arouse, stimulate, or satisfy

sexual desires. Thus, it shall be determined whether an act committed in a place where an amusement business is managed falls under an ‘obscene act’ subject to a criminal penalty in light of the following: type of amusement business; form of permitted business; limit of age of users or disclosure of place; time and place of obscene act to expose a body; exposed part, method, degree, motive, history, etc. Also, an obscene act exposes sexual body parts or expresses sexual acts without reserve so that it may be estimated that the obscene act may have an adverse effect on society, not merely giving a sense of shame or displeasure to the public. Thus, it shall be determined whether it could be evaluated, in terms of perspectives of average persons, that the obscene act stimulates a sexual desire, arouses sexual excitement, or causes ordinary sexual humiliation” (See Supreme Court Decision, 2010Do10171, dated September 8, 2011).

Also, Article 234(i) of the Customs Act prohibits to export and import books, publications, drawings, films, records, videos, sculptures, and other similar goods which corrupt public morals. The Supreme Court held that “it would be reasonable to construe that the term ‘corrupt public morals’ provided in Article 234(i) of the Customs Act means ‘obscenity’ that harms sexual customs, except as otherwise specifically provided (See Supreme Court Decision, 2002Do7166, February 26, 2004). Here, the term ‘obscenity’ means to arouse sexual excitement by stimulating a sexual desire of the general public and to be contrary to sexual morality by causing sexual humiliation. Thus, when observing and estimating expressions, they shall express or describe specific bodily parts or acts without reserve so that it may be estimated that the dignity or value of a human to be respected and protected is severely damaged or distorted, not merely giving a sense of vulgarity or promiscuity as a whole. In light of social norms, the obscene expressions are what appeals to sexual appeals entirely or predominantly but have no value at all in terms of culture, arts, ideology,

science, medical science, or education. The expressions shall be estimated objectively and normatively as to whether they are obscene based not on subjective intention of their producer but on sound social norms” (See Supreme Court Decision, 2008Do254, dated April 11, 2008; Supreme Court Decision, 2006Do3558, dated March 13, 2008).

Meanwhile, Article 7(1)(iv) of the Trademark Act stipulates that “any trademark of which, by itself or by being used for goods, the meaning and content conveyed to consumers are feared to be contrary to the virtuous customs deemed as the prevailing moral sense of ordinary people or to harm the public order shall not be registered.” The Supreme Court held that “here, the term ‘any trademark that is likely to be contrary to the virtuous customs deemed as the prevailing moral sense of ordinary people’ includes circumstances not only where the meaning or content of the trademark composition itself or designated goods violates public order or is contrary to moral norms, the prevailing moral sense of ordinary people, but also where an act to register and use the trademark violates good morals, such as fair goods distribution order, international faith, commercial ethics, etc. Also, if a use of the trademark infringes public interests, it shall be deemed that the use violates public order and thus shall not be permitted” (See Supreme Court Decision, 2011Hu1722, dated June 28, 2012).

B. Detailed Description and Drawing in Specification of Claimed Invention

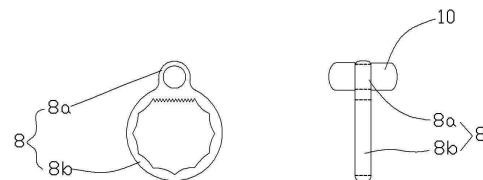
Among the statements in the detailed description and illustration in the drawings of specification of the Claimed Invention, the following were the grounds to determine, in the IPTAB Decision, that an invention is likely to disorder sound morals.

► One of the purposes of the present invention is to provide a dual mode vibrating accessory in which a detachable ring and an insertion ring bigger than the detachable ring are formed in parallel vertically, which includes a small figure-of-eight ring in which the dual mode vibrating accessory is

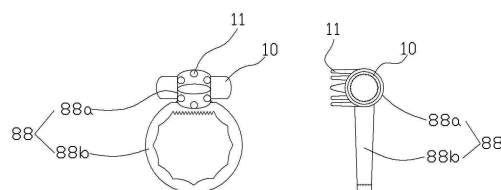
inserted into the detachable ring and a large figure-of-eight ring on which the detachable ring rotates 90 degrees and which a user or a partner could wear on various body parts and feel vibration with the small figure-of-eight ring and the large figure-of-eight ring. ([0010] in Defendant's Exhibit 2)

► Another purpose of the present invention is to provide a dual mode vibrating accessory which can give soft stimulation with the soft convex projections when a user or his/her partner feels the vibration by covering the motor housing and the battery housing with a decoration cap on whose surface the convex projections are formed. ([0011] in Defendant's Exhibit 2)

► As illustrated in FIG. 5, a small figure-of-eight ring (8) is combined with a small detachable ring (8a) on the top and placed in parallel and at the same direction with a big insertion ring (8b) at the bottom, and a dual mode vibrating accessory (10) in the present invention is inserted into the small detachable ring (8a) on the top, and fingers are inserted into the big insertion ring (8b) at the bottom of the small figure-of-eight ring (8). (FIG. 5, [0046] in Defendant's Exhibit 2)

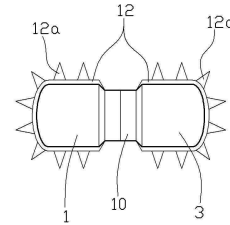


► As illustrated in FIG. 7, the dual mode vibrating accessory (10) of the present invention is used as being inserted into the detachable ring (88a) of the small figure-of-eight ring (88), and a number of projections (11) in a form of embossing are formed on a surface of the detachable ring (88a). When using the small figure-of-eight ring (88) with the small figure-of-eight ring (8), the projections (11) in a form of embossing formed on the detachable ring (88a) will stimulate more strongly with the vibration of the dual mode vibrating accessory (10) of the present invention. Of course, the projections (11) in a form of the embossing can be applied even to the detachable ring (9a) of the large figure-of-eight ring (9). In this case, the use of the large figure-of-eight ring (9), the size of the detachable ring (9a), and the use of projections (11) in a form of embossing



are as stated above. (FIG. 7, [0052]-[0054] in Defendant's Exhibit 2)

► As illustrated in FIG 8, the motor housing (1) and the battery housing (3) of the dual mode vibrating accessory (10) of the present invention can be used, as covered with the decoration cap (12) on whose surface a number of convex projections (12a) are formed. The convex projections (12a) will stimulate more strongly with the vibration of the dual mode vibrating accessory (10). (FIG. 8, [0057] in Defendant's Exhibit 2)



C. Discussion

It shall be deemed that an invention is unpatentable under Article 32 of the Patent Act only where the goods which are an object of a patented invention express or describe specific body parts, etc. without reserve, or it is expected that the practice of an invention would inevitably entail an overt obscene act (thus, the cases where it is expected that an obscene act would be entailed in a private space in which publicity is not recognized are excluded), or an invention is so contrary to sexual morals, in light of the following facts: ① The “sound morals” in Article 32 of the Patent Act is an indeterminate concept and is included in various laws, such as the Criminal Act, the Customs Act, the Trademark Act, etc. as examined in Paragraph B above. Even though the Criminal Act and the Customs Act are regulatory law unlike the Patent Act, the Supreme Court construes the term “obscenity” in the Criminal Act and the Customs Act to “arouse sexual excitement by stimulating a sexual desire of the general public and to be contrary to sexual morality by causing sexual humiliation.” (It seems that the term “to be contrary to sexual morality” means to be contrary to sound morals.) Where the same term is used in various laws and regulations, it shall be construed uniformly to construe it in harmony with other laws and regulations, except as otherwise specifically provided. ② Article

1 of the Patent Act stipulates that “the purpose of this Act is to encourage, protect and utilize inventions, thereby promoting the development of technology, and to contribute to the development of industry.” If sex-related inventions, such as a sexual device, etc., can promote the advance of technology and contribute to the development of relevant industries, it is difficult to conclude that it would be contrary to a legislative intent of the Patent Act to permit sex-related inventions, such as sexual device, etc. to be registered for patent. (Article 22 of the Constitution provides that all citizens shall enjoy freedom of learning and the arts and that the rights of authors, inventors, scientists, engineers, and artists shall be protected by Acts. Also, the Patent Act shall be viewed as the laws enacted under the intent of the Constitution. Thus, the freedom of learning and the arts and the rights of authors, inventors, and engineers arise from the Constitution.) Thus, it would be reasonable to construe as to define a boundary on whether the Patent Act protects sex-related inventions rather than to construe, differently from other laws, Article 32 of the Patent Act to the effect that an invention is not likely to disrupt sound morals. ③ It is difficult to conclude that it would be against a legislative intent of the Patent Act to grant a patent to inventions, such as medicine, articles, etc. that people with bodily disabilities require, such as impotency drugs, premature ejaculation medicine, etc. ④ It is difficult to view that Article 32 of the Patent Act regulates inventions in terms of morality. (Thus, it is difficult to conclude that an invention which arouses a sexual desire¹⁾ or increases a sexual feeling by stimulating sexual organs excessively is likely to disorder “sound morals.”) ⑤ It seems that where it is necessary to limit the practice of an invention due to concern over abuse, protection of youth, etc., it would be possible to respond to such necessity by enacting or amending laws and regulations flexibly according to the changes of

1) It is also difficult to determine a definite meaning of the expression “of no use.”

the times (it seems that public interests, such as the necessity to protect youth from sex-related articles, such as sexual devices, etc., could be attained by other laws and regulations, such as the Youth Protection Act (Articles 2, 28, and 58), the School Health Act (Articles 6 and 19), etc.)

It is difficult to view that the Claimed Invention is an invention that violates public order or sound morals or is likely to harm public health in light of the above legal principles: ① Even if the “dual mode vibrating accessory” of the Claimed Invention is deemed to be a sexual device or sexual aid in light of the statements and drawings in the detailed description of the Claimed Invention as examined in Paragraph B above, the sexual device or sexual aid is manufactured and used for sexual satisfaction differently from general sexual expression. People may require such sexual devices and sexual aids not only for sexual satisfaction or pleasure but also for their physical disability, etc. Also, such sexual devices and sexual aids are used in a very private space. Thus, it seems that in determining whether such sexual devices and sexual aids constitute obscene articles or are likely to disorder sound morals, standards shall be applied more strictly than they are applied to ordinary sexual expressions. ② It is difficult to deem that the “dual mode vibrating accessory” of the Claimed Invention expresses or portrays specific body parts, etc. without reserve and that it is expected that the practice of the Claimed Invention would necessarily entail public obscene acts. ③ There is no special circumstance in which the Claimed Invention harms public health.

C. Summary of Discussion

Thus, the registration of the Claimed Invention shall not be rejected under Article 32 of the Patent Act. However, the IPTAB decision is inconsistent with the above analysis and thus shall not be upheld.

4. Conclusion

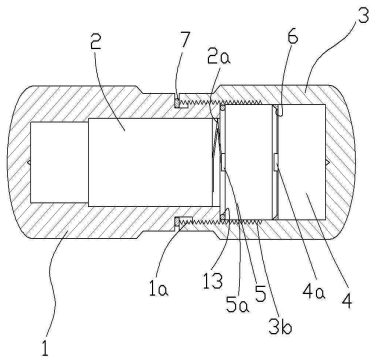
The Plaintiff's claim to revoke the IPTAB decision is therefore well grounded and shall be granted. It is so decided as ordered.

Presiding Judge Beomshik SEOL

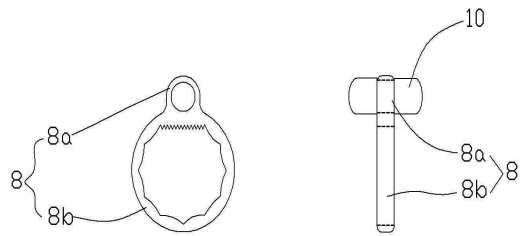
Judge Jeonghoon PARK

Judge Jutak YOON

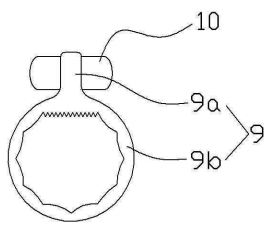
Main Drawings of the Claimed Invention



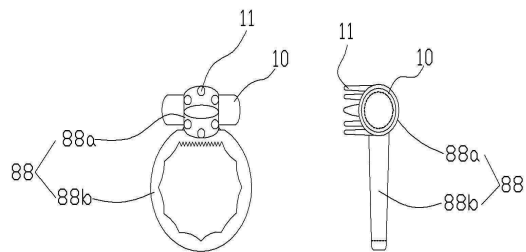
[FIG. 3]



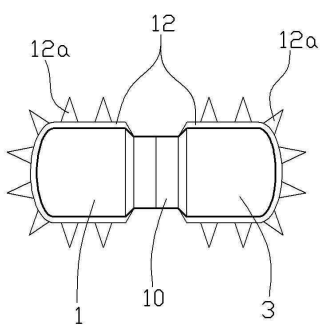
[FIG. 5]



[FIG. 6]



[FIG. 7]



[FIG. 8]

[Symbols]

1: Motor housing, 2: Vibrating motor, 2a: Contact conductor, 3: Battery housing, 4: First battery, 4a, 5a: Contact terminal, 5: Second battery, 6: Dual mode ring, 7: Watertight o-ring, 8, 88: Small figure-of-eight ring, 8a, 9a, 88a: Detachable ring, 8b, 88b: Insertion ring, 9: Large figure-of-eight ring, 10: Dual mode vibrating accessory of the present invention, 11: Projections in a form of embossing, 12: Decoration cap, 12a: Convex projections, 13: Insulating o-ring
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