

NEWSLETTER

April 2021

Intellectual Property Group

CONTACT



Un Ho KIM

T: +82,2,772,4695
E: unho.kim@leeko.com



John KIM

T: +82,2,772,4931
E: john.kim@leeko.com



Tae H. KIM

T: +82,2,6386,6656
E: taehyung.kim@leeko.com



Julie SHIN

T: +82,2,772,4978
E: julie.shin@leeko.com

Korean Supreme Court Details Standard for Establishing Doctrine of Equivalents Infringement

In Korea, as in the United States and Japan, the recognition of patent infringement claims under the Doctrine of Equivalents (DoE) has been established by several key precedents. Recently, the Korean Supreme Court provided key guidance through detailed ruling standards for two of the three factors to establish DoE infringement, namely (1) the “Substantially Identical Solution Principle” and (2) the “Substantially Identical Effect Principle.”¹⁾

Summary of the Key Issues and Holdings of Korean Supreme Court Ruling (2019Da237302). Patentee A brought an infringement suit against B, alleging that one of B’s products was infringing A’s patent for a “detachable handle for cooking vessels.”

The Korean Patent Court ruled that, even though some parts of B’s product had been changed from A’s patented product, their solution principles and effects were substantially identical, and a person of ordinary skill in the art (POSITA) would readily be able to come up with such changes. After the Patent Court ruled in favor of the patentee by finding DoE infringement, the case was subsequently appealed to the Korean Supreme Court. The main issue in dispute on appeal was the meaning and standards for the “**substantially identical solution principle**” and the “**substantially identical effect principle**” for establishing DoE infringement.”

1) In Korea, an accused product that includes a modified element as compared with a patented invention may still be infringing under the DoE when the accused product has:

- (1) a **substantially identical solution principle with the patented invention**;
- (2) accomplished **substantially identical effect to the patented invention despite some elements being different**; and
- (3) modifications that would have been obvious to a POSITA (“person of ordinary skill in the art”).

However, DoE infringement may not be established if (4) an accused product comprises technology already publicly disclosed before the filing of the patented invention, or a POSITA can easily conceive from the publicly known technology, or (5) the prosecution history of the patented invention indicates that the modified element of the invention for review was consciously excluded from the claims of the patented invention.

With regard to the first DoE factor, namely the “substantially identical solution principle,” the Korean Supreme Court ruled that:

“when determining whether the solution principle of an infringing product is substantially identical to that of a patented invention, courts must practically explore and determine the core technical idea forming the basis for the unique solution means of the patented invention compared to prior art, in view of the **description of the invention in the specification and publicly known technology at the time of the invention’s filing**, rather than formalistically extracting parts of claims.”

As for the second DoE factor, namely the substantially identical effect principle, the Korean Supreme Court held that:

“Determination of whether the effects [of the infringing product and patented invention] are substantially identical shall be based primarily on whether the infringing product solves the same technical issue solved by the patented invention which had not been solved by prior art. Therefore, in principle, if **the core technical idea forming the basis for the unique solution of the patented invention** (in light of the description of the invention found in the specification and publicly known technology at the time of the invention’s filing) **is also found in the infringing product**, then their effects shall be deemed to be substantially identical as well.

If such core technical idea had been actually or effectively publicly disclosed before the filing of the patented invention, however, then the core technical idea was neither unique to the patented invention, nor did it solve the technical issue which had not been solved by prior art. In such case, the determination for the DoE factor (ii) should not be based on whether the core technical idea was found in the infringing product; **instead, the determination should be made by comparing the individual functions or roles of the elements which the DoE issues hinge upon.**”

Significance and Implications of the Korean Supreme Court’s Ruling. In Korean patent infringement litigation, it is quite rare to find an allegedly infringing product or method that fits neatly within the scope of a patented invention. In practice, many patent infringement and scope confirmation actions in Korea involve DoE infringement issues, and the Korean tribunal’s findings regarding the first and second DoE factors are often dispositive of the final case outcome.

The ruling of the Korean Supreme Court clarifying DoE infringement are significant because the Court provided detailed guidance and additional clarity for both patent owners and accused infringers. Specifically, the Court has ruled that when Korean courts analyze the solution principle of the patented invention (as described in its specification), the “substantially identical solution principle” mandates a careful examination of the individual element’s function and role within the context of the technology at the time of the invention.

In light of the recent line of Korean Supreme Court DoE decisions (2017Hu424 decided on Jan. 31, 2019 and 2018Da267252 decided on Jan. 31, 2019), the outcome of cases involving DoE infringement claims will likely turn on the interpretation of the solution

principle (core technical idea) of a patented invention and whether such solution principle has already been publicly disclosed. Sophisticated litigants in Korea will tailor their trial themes to address the core technical ideas through the prism of the prior art and the publicly known technology at the time of the invention.

From a patent prosecution perspective, patentees will need to craft the patent specification to define the essence of the invention at the drafting stage and respond strategically to KIPO office actions while keeping in mind a potential infringer's future characterizations of public disclosure assertions during litigation. Like many contentious patent proceedings at the court and administrative levels, the more broadly recognized the scope of the core technical idea, the more likely infringement will be established down the line. For defendants in Korean infringement suits, resonant trial themes must be established early to define the scope of the alleged core technical idea within the context of known public disclosures, including a focused presentation of dispositive prior art references to narrow the scope of any DoE infringement.

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Hanjin Building 63 Namdaemun-ro, Jung-gu Seoul 04532, Korea | Tel: +82-2-772-4000 | Fax: +82-2-772-4001/2 | www.leeko.com

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