

〈韓国〉



## 新規性喪失の例外規定の適用の根拠 となった先行デザインに基づく自由 実施抗弁の可否

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### 1. 概要

最近、大法院では、公知デザインが新規性喪失の例外規定に該当する場合には、新規性喪失の例外規定の適用の根拠となった先行デザインに基づいて自由実施デザインの主張を開陳することができないと判示しました。これは、特許法院の立場とは反対になるものです。以下では、各法院の立場及び根拠を通じて新規性喪失の例外及び自由実施デザインの意味について説明致します。

### 2. 特許法院の立場(2022 ホ 5412)

原告が被告に対して「確認対象デザインは、この事件の登録デザインの権利範囲に属する」と主張しつつ積極的権利範囲確認審判を請求しましたが、特許審判院が審判請求を棄却する審決をしたところ、上記審決の取消を請求しました。

その後、特許法院では、「先行デザイン2が適用された製品について写真が撮影され、この事件の登録デザインの出願前に、第三者にファイル形式で転送されましたが、これは、特別な事情がない限り公知のデザインに該当する」と見なし、被告の先行デザイン2に基づく自由実施デザインの抗弁を許容し、確認対象デザインが登録デザインの権利範囲に属しないと判断しました。

特許法院は、そのような結論の根拠として、①新規性喪失の例外規定は「デザイン登録の要件」の判断において、公知デザインが公知されたものと見なさないと明示している点、②新規性喪失の例外規定は、登録可否の判断時に「第三者の権益を損なわない範囲内で」考慮すべきである点、③自由実施デザインの法理は、対比の対象を公知デザインと確認対象デザインとしているだけで、「登録デザインとの関係」を考慮するものではない点、④取引過程で目的に反して不正にデザインが公開される場合、不正競争防止及び営業秘密保護に関する法律等により保

護されることができる点、などを挙げています。

### 3. 大法院の立場 (2021 フ 10473)

大法院は同様に、この事件の争点が、「新規性喪失の例外規定の適用の根拠となった先行デザインに基づいて、自由実施デザインの主張が可能か否かに関するもの」と見なし、「新規性喪失の例外規定の適用の根拠となった公知デザイン又はそれらの結合により容易に実施できるデザインが誰でも利用できる公共の領域にあることを前提とした自由実施デザインの主張は許与されない」と判断し、原審決を破棄・還送しました。

大法院は、これについて、①新規性喪失の例外を認める立法的決断を前提に、第三者とデザイン登録を受けることができる権利を有する者との間の利益均衡を図るために、新規性喪失の例外規定の適用を受けるために遵守すべき時期的・手続的要件を定めており、新規性喪失の例外規定の適用を受けたとしても、出願日自体が遡及されないものとした点、②確認対象デザインを公知デザインと対比する自由実施デザインの法理は、公共の領域にあるデザインは誰でも利用できるものでなければならないという考えに基づいているが、新規性喪失の例外規定の適用根拠となった公知デザインが公共の領域にあると断定できない点、③公知デザインに対して特別な創作的貢献をしていない第三者に無償の実施権限が付与されることで、第三者に対する保護を登録デザイン権者の権利に優先することになる不合理な結果をもたらし得る点、などを根拠として挙げました。

### 4. 結び

特許法院の判決後、新規性喪失の例外及び自由実施デザインの意味の解釈について多くの議論がありました。しかし、今回の大法院の判決によって、デザイン登録を受けることができる者が新規性喪失の例外によってデザイン登録を受けた場合、その根拠となる公知デザインは、もはや自由実施の領域にあるものと言えないという原則が確立されたものと見なすことができます。

判例上、認められていた自由実施の法理が明文化されて認められている公知例外主張に優先して適用されることは、下手をすると、権利者の権利を過度に制約する不合理な結論を生む恐れもあります。このことから、大法院の判断は、権利者の権利保護に積極的な立場と明確な基準を確立したという点で非常に望ましいと思われる。

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## **Admissibility of Free Implementation Defense Based on Prior Design that Served as Basis for Application of Exception to Lack of Novelty (Decision by the Supreme Court on February 23, 2023, 2021Hu10473, confirmation of scope of rights (D))**

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### **1. Overview**

Recently, the Supreme Court ruled that if a publicized design falls under the exception to lack of novelty, it is not possible to claim a free implementation design based on the prior design that served as the basis for the application of exception to the lack of novelty. As this is contrary to the position of the Patent Court, the implication of the exception to lack of novelty and the free implementation design will be examined herein based on the positions and grounds of each court.

### **2. Position of the Patent Court (2022Heo5412)**

The plaintiff claimed against the defendant that “the design subject to confirmation belongs to the scope of rights of the present registered design” and requested an appeal to confirm the scope of rights, and when the Intellectual Property Trial and Appeal Board rendered a decision dismissing the appeal, the plaintiff filed a lawsuit for cancellation of the decision.

Afterwards, the Patent Court held that a photograph of the product to which Prior Design 2 was applied was taken, and was transmitted to a third party in the form of a file prior to filing the application for the present registered design, and thus that this corresponds to a publicized design unless there are special circumstances, and the Patent Court allowed the defendant’s free implementation design defense based on prior design 2 and determined that the design subject to confirmation did not fall within the scope of the registered design’s rights.

As a basis for the conclusion, the Patent Court held that ① the lack of novelty exception stipulates that a publicized design shall not be regarded as being publicized in the determination of “requirements for design registration,” that ② the lack of novelty exception should be considered “to the extent that the rights and interests of third parties are not harmed” when determining whether to register, that ③ the legal principle of free implementation design is that the subject of comparison is configured as the publicized design and the design subject to confirmation, and does not consider the “relationship with the registered design,” and that ④ if the

design is unjustly disclosed against the purpose during the transaction process, the design can be protected by the Unfair Competition Prevention and Trade Secret Protection Act.

### **3. Position of the Supreme Court (10473Hu2021)**

The Supreme Court considered that the issue in this case is whether it is possible to claim a free implementation design based on the prior design that served as the basis for the application of the lack of novelty exception rule, and held that the claim for free implementation design on the premise that the publicly available design, which is the basis for application of the lack of novelty exception rule, or the design that can be easily implemented according to the combination thereof is in the public domain available to anyone is not allowed, and reversed and remanded the lower court's decision.

The Supreme Court cited as the grounds for the above conclusion that, ① to promote a balance of interests between a third party and a person who has the right to receive design registration on the premise of a legislative decision recognizing the exception of lack of novelty, the timing and procedural requirements to comply with to apply the lack of novelty exception rule are determined, and even if the lack of novelty exception rule is applied, the filing date is not retroactive, that ② the legal principle of free implementation design, which compares the design subject to confirmation with the publicized design, is based on the idea that anyone should be able to use the design in the public domain, and it cannot be concluded that the publicized design, which is the basis for application of the lack of novelty exception rule, is in the public domain, and that ③ as the right to use free of charge is granted to a third party who has not made any creative contribution to the publicized design, an unreasonable result may occur in which the protection of the third party takes precedence over the right of the registered design rights holder.

### **4. Conclusion**

After the ruling of the Patent Court, there have been a great deal of controversy about the interpretation of the exception to lack of novelty and free implementation design. However, based on the decision of the Supreme Court, the principle was established that if a person eligible for design registration received design registration as an exception to the lack of novelty, the publicized design which is the basis for that can no longer be considered to be in the domain of free implementation.

Applying the legal principle of free implementation, which has been recognized in judicial precedent, in preference to the claim for exception of lack of novelty, which has been explicitly recognized, may lead to an unreasonable conclusion in which the rights holder's rights are excessively restricted. In this respect, the decision of the Supreme Court is considered highly desirable in that it has established an active stance and clear standards for the protection of rights holders.