

# Providing IP Services

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Bukchon Hanok Village  
View of Seoul N Tower from Bukchon Hanok Village, Bukchon, close to many palaces in Seoul, used to be where the royal family and nobles lived, and many independence activists during the Japanese colonial period lived there.



# Response to COVID-19: Adjustment of Examination & Trial Services

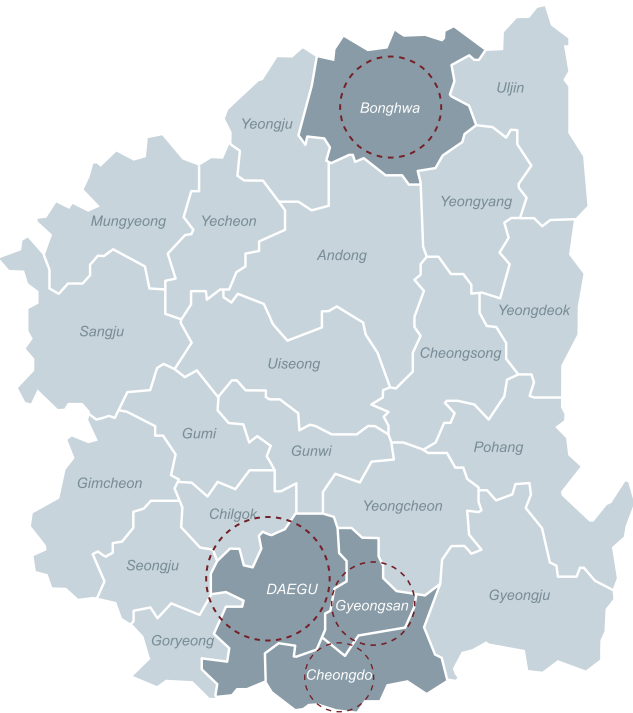
## Patent Fee Reduction for Special Disaster Zones

The sudden and rapid proliferation of the novel coronavirus (COVID-19) brought about consequential changes to many standard practices and economic order across the world. In the Republic of Korea (ROK), early cluster outbreaks of COVID-19 severely affected specific regions, such as Daegu City and Gyeongsangbuk-do Province. As the Korean government designated these regions as special disaster zones on March 15, 2020, the Korean Intellectual Property Office (KIPO) declared a one-year patent fee reduction for the residents of these regions until March 14, 2021.

More specifically, individuals and businesses with their resident address in

these special disaster zones were eligible for a reduction of their patent fees. A 30% fee reduction was provided for trial requests, registration for establishment of rights, annual registrations and applications for patents, utility models, and designs. Also, a 75% fee reduction was provided for international search requests by small and medium-sized enterprises (SMEs) filing international patent applications under the Patent Cooperation Treaty (PCT).

During this time of crisis, a patent attorney survey result revealed a demand for more government support, such as reduced official fees for special disaster zones. Also, despite the overall trend of increased domestic patent applications for the first



Fee Reduction for Special Disaster Zones

Category	Reduction Amount
Fee for application	30% ↓
Fee for requesting a trial	
Fee for registering establishment of right	
Fee for annual registration	
Fee for PCT international search	75% ↓
• Target regions : Daegu, Gyeongsan-si, Cheongdo-gun, Bonghwa-gun • Exemption period: March 15, 2020 - March 14, 2021	

## Ex Officio Extension for Patent Document Submission

quarter of 2020, Daegu and Gyeongbuk, in particular, showed a decrease in patent applications. Therefore, these measures

were implemented in order to lessen burden on users and help encourage patent applications.

Considering the global impact of COVID-19, it was anticipated that domestic and overseas applicants would have difficulty meeting the submission deadline of patent applications designated by KIPO. Under the Korean Patent Act, KIPO was able to ex officio extended document submission deadlines for 82,795 cases in total.

Initially, any deadline for document submission falling within March 31 to April 29, 2020 was ex officio extended to April 30, 2020. Afterwards, any deadline falling within April 30 to May 30, 2020 was extended to May 31, 2020 for a second time. These particular extensions did not require applicants or agents to file

for an extension nor to pay the fees arising therefrom. By alleviating this burden, applicants were able to proceed with the acquisition of their intellectual property right (IPR). The same arrangement was extended to patent applications from overseas where the spread of COVID-19 was severe.

Meanwhile, KIPO also approved requests for additional extensions to deadlines as long as the indicated reason was due to COVID-19. Even for situations where a deadline was missed and a patent application became invalid or the right was terminated, it would be possible to apply for redress of rights and to have the fee waived for reasons due to COVID-19.

Deadline Extension for Document Submission

Category	Original Deadline	Extended Deadline	Number of Cases
1st extension	March 31, 2020–April 29, 2020	April 30, 2020	30,155
2nd extension	April 30, 2020–May 30, 2020	May 31, 2020	52,640
Total 82,795 Cases			

**Additional measures  
for IP Trial and Appeal  
Proceedings in response  
to COVID-19**

In response to the new challenges of the pandemic, KIPO adopted additional measures so that cases could continue to be heard in a safe environment. Previously, the Intellectual Property Trial and Appeal Board (IPTAB) of KIPO only allowed videoconference oral hearings in which parties needed to be physically present in the hearing rooms in Seoul or Daejeon. However, KIPO implemented telephonic hearings to prevent parties and representatives from having to physically attend oral proceedings and instead participate by telephone, as measure of social distancing in the effort to contain the pandemic. Also, telephonic

hearings could potentially provide benefits in situations where Internet access is not secure.

With the consent of the adverse party, parties may request for online interviews or telephonic hearings either online or by phone. However, if the case requires examination of witnesses or taking of evidence, oral proceedings will be held in the IPTAB oral hearing rooms. Furthermore, online interviews were introduced in order to enable parties to participate remotely from their home or offices via Internet ([vc.on-nara.go.kr](http://vc.on-nara.go.kr)).

# New Examination Guides for New Digital Industry Inventions

KIPO newly established the "Examination Guides by Art Field" which contains "Criteria on Patentability for Inventions in the Digital Industry Fields." In order to provide proper protection for inventions of Fourth Industrial Revolution (4IR) technologies, a few major countries have made amendments to their existing examination guidelines by adding example cases of related technologies.

KIPO, on the other hand, created separate criteria on patentability according to each new digital industry. The guides outline patentability requirements and written description requirements and include various example cases with a focus on convergence technologies, such as artificial intelligence (AI), Internet of things (IoT), biotechnology, etc.

For instance, the guide on AI provides patentability requirements and specific examination cases together with guidelines on drafting specifications to help applicants obtain high quality patents, a feature which many companies previously found too difficult due to the characteristics of new industries.

When it comes to was IoT, the criteria on patentability was modified to have sufficient consideration on the characteristics and effects according to each service field. This is in order to prevent unreasonable application of manufacturing-based patentability requirements to ICT convergence technologies and to encourage new market entrants.

As for the bio-field, the previously ambiguous patentability criteria for AI-based new drugs development was supplemented, thus providing support for pharmaceutical businesses to establish optimal patent application strategies for each development stage of AI-based drug repositioning technology.

KIPO will further identify new digital industries with ample growth potential, such as autonomous driving systems, intelligent robots and cosmetics, so as to provide more suitable criteria on patentability.

# Cutting-edge Technology Used for e-Filing and the First Mobile Application for Trademarks

In 2020, KIPO's e-filing website "Patent-ro" (www.patent.go.kr), was upgraded with focus on enhancing user access and functionality. New features have been included to help streamline the process of filing IPR applications for users. The upgrades were made by incorporating cutting-edge IT technology to vastly improve features for user convenience and to offer a user interface (UI) compatible with PCs and mobile devices, such as tablets, smartphones, etc.

Most importantly, KIPO is the first ever to offer mobile e-filing services for trademark applications, which was released to the public on March 2020. It is now possible to carry out a wide range of services through a mobile device from filing trademark

applications to receiving notifications, paying fees, viewing examination progress, obtaining registration certificates, etc. Users are also able to customize their homescreen for quick access to their most used features.

Additionally, the website allows a simple authentication process through browser-embedded authorization certifications or "Digital Onepass," a system that gives access to a wide range of Korean government services through a single username and verification tool. Furthermore, by utilizing a blockchain-based proxy service to distribute and share filing data, users can benefit from 24/7 uninterrupted submission services for their IPR application.



# Improvement of Trademark & Design Examination

## Amendment of Trademark Examination Guidelines Regarding Trade Dress

More and more businesses are applying to protect their trade dress under trademark rights. The term "trade dress" is a broader concept which refers to a product's total image or overall appearance that distinguishes the product from competitors and encompasses the product's size, 2D or 3D shape, color, texture, etc.

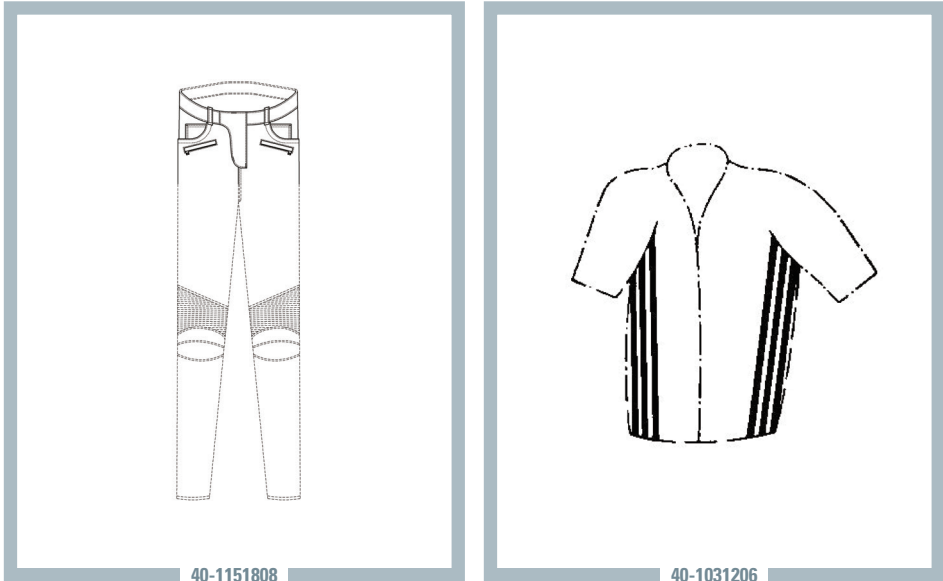
Reflecting this increasing trend, several amendments were made to the "Trademark Examination Guidelines" to improve examination quality and accuracy related to various types of visually perceivable and non-perceivable marks, including 3D shape, sound, color and color marks which will be in effect starting January 1, 2021.

First of all, a distinctive appearance of a business can be recognized as the trademark of a specified individual. For example, the interior/ exterior of a building in which goods are sold and services are provided can be classified as a type of 3D mark. In order to provide better protection as a registered trademark, specific guidelines for examination were established. In particular, applicants are able to illustrate the interior and exterior appearance of their place of business in their application with solid lines to indicate elements to be protected and dotted lines to indicate elements not to be protected, which may change depending on actual use.

Examples of Registered 3D Marks by Type

	Shape of the goods	Shape of the packaging (containers) for the goods	Shape of the packaging (containers) for the goods	Shape unrelated to the goods or their packaging
Mark				
Reg. No.	40-1138531	1216793	40-1302518	41-0364501
Designated goods	Ice candies, ice creams	Umbrella sticks, canes	Perfume, cosmetics	Data search in computer files for others

Examples of Position Marks in Korea



Secondly, according to established Supreme Court case law, a “position mark” is recognized when “a shape (3D) or figure (2D) has acquired distinctiveness when used in a particular position on a product.” This scope was expanded to also include “colors (a single color or combination of colors) which have acquired distinctiveness when used in a particular position.” The supplemented system allows the use of a specific color or combination of colors in a specific position to be protected as a “position mark” as long as it acts as a source identifier in the final product. Further, improvements were made by expanding the range for expressing specific shades of color (i.e. Pantone, HEX, RGB, CMYK, etc.) and by amending the

guidelines on acquiring distinctiveness regarding sound trademarks.

Lastly, examination standards were strengthened by supplementing examination guidelines for non-traditional marks in terms of functionality so that some 3D shapes which should be protected as patents are not erroneously registered as trademarks. For instance, it is now required to comprehensively consider the existence of relevant patents/utility models, the promotion via advertisements on the functionality of the product, as well as the existence of alternative shapes of the product for the same function, and the ease and economic feasibility of producing such alternative forms.

**Restructure of the Partial-Substantive Design Examination System (PSES)**

Partial-substantive design examination system (PSES) allows early acquisition of rights through rapid examination of formality and eligibility of design applications of which have a short design life cycle and are easy to copy (clothes, fabric, etc.).

The first office action of PSES would take about 60 days from the date of the filing. However, it could not accommodate the fast-changing reality of the design industry where fast fashion trends change in just 2~3 weeks. Therefore, from January 2020, KIPO significantly reduced the processing time of the first office action of PSES

from 60 days to 10 days by improving the efficiency of internal procedures and recruiting experienced examiners.

Additionally, KIPO expanded the PSES track to cover more classes. Previously, PSES was applied only to designs from three classifications: Clothing and haberdashery (Class 2), Textile piece goods (Class 5), and Stationery and office equipment (Class 19). Since December 2020, four more classifications were added: Foodstuffs (Class 1), Travel goods (Class 3), Packages and containers (Class 9), and Articles of adornment (Class 11).

The Partial-Substantive Design Examination System track (in effect December 1, 2020)

Locarno classification	Class 1	Class 2	Class 3	Class 5	Class 9	Class 11	Class 19
Articles	Foodstuffs	Clothing & haberdashery	Travel goods	textile piece goods	Packages & containers	Articles of adornment	Stationery & office equipment

Oftentimes, if a design is not registered under the Design Protection Act, it is difficult to receive proper protection. Even with protection under other laws, companies often give up taking actions against third parties who illegally use their

design without permission due to the time and cost. With these new measures, it is expected to allow companies to secure their design with the launch of their business.