

## TABLE OF CONTENTS

<b>CHAPTER 1 PATENTS AND UTILITY MODEL RIGHT</b> .....	3
I. Patents .....	3
1. Subjective requirements .....	3
2. Objective requirements .....	3
3. Procedural requirements .....	4
II. Utility model right .....	5
1. Consistency to Patent Act .....	5
2. Difference to Patent Act .....	5
<b>CHAPTER 2 INTRODUCTION TO PATENTS</b> .....	9
<b>SECTION 1 INTRODUCTION TO PATENTS</b> .....	9
I. Goals of the patent system .....	9
1. Meaning .....	9
2. Protection for invention .....	9
3. Inventive application .....	9
II. Development of patents .....	10
1. Introduction of patents .....	10
2. Enactment and amendment of the Patent Act .....	11
3. Reform of the patent litigation system .....	13
4. Basic principles of the Patent Act in Korea .....	14
<b>SECTION 2 INTRODUCTION TO PROCEDURE FOR THE PATENT ACT</b> ..	15
I. Competency .....	15
1. Capacity .....	15
2. Legal capacity .....	17
II. Power of attorney .....	18
1. Meaning .....	18
2. Types and rights of power of attorney .....	19
3. Certification of power of attorney .....	21
4. Non-distinguishment of power of attorney .....	22
5. Principle of individual agent .....	22
6. Replacement of power of attorney, etc .....	23
7. Common representative .....	23
8. Venue of nonresident nationals .....	24

III. Period .....	25
1. Meaning .....	25
2. Types of period .....	25
3. Calculating method for period .....	25
4. Extension of period .....	26
IV. Introduction to the procedure .....	28
1. The effects of the procedure .....	28
2. Invalidity of the procedure .....	29
3. Subsequent completion of the procedure .....	31
4. Suspension of the procedure .....	32
V. Publication .....	35
1. Meaning .....	35
2. Publication for public notification of registration .....	35
3. Pre-Grant Publication .....	36
4. Effect disclosed in the Pre-Grant Publication .....	36
<b>CHAPTER 3 PATENTS INVENTION .....</b>	<b>41</b>
<b>SECTION 1 PATENTABLE INVENTION .....</b>	<b>41</b>
I. Meaning .....	41
II. Requirements for an invention .....	41
1. Utilization of the law of nature .....	41
2. Technical idea .....	43
3. Skillfulness of creation .....	43
4. Relation between invention and discovery .....	44
III. Types of invention .....	44
1. Categories of invention .....	44
2. Invention of material .....	45
3. Invention of a method .....	45
<b>SECTION 2 REQUIREMENTS FOR PATENTABILITY .....</b>	<b>45</b>
I. Industrial applicability .....	45
1. Meaning .....	45
2. Scope of industry .....	45
3. Applicability .....	46
4. Medical service .....	46
II. Novelty of invention .....	48
1. Meaning .....	48
2. Criteria for time and place in deciding novelty .....	48

3. Cause of losing novelty .....	49
4. Determining novelty .....	53
III. Inventive step of invention .....	55
1. Meaning .....	55
2. Relevant provisions .....	56
3. Theories on determination of inventive step .....	56
4. Method of determining inventive step .....	57
5. Type of inventive step determination .....	59
6. Non-publicly known invention .....	62
IV. Identicalness of invention .....	63
1. Expanded first-to-file application .....	64
2. Prior application .....	66
<b>SECTION 3 PATENTABLE SUBJECT MATTER .....</b>	<b>69</b>
I. Patentable subject matter .....	69
1. Nature of right to obtain patent .....	69
2. Content of right to obtain a patent .....	70
II. Holder of Right .....	72
1. Inventor .....	72
2. Joint inventor .....	72
3. Successor .....	73
4. Prior applicant .....	73
5. Legitimate holder of right .....	73
<b>CHAPTER 4 PATENT APPLICATION .....</b>	<b>77</b>
<b>SECTION 1 PROCEDURE OF PATENT APPLICATION .....</b>	<b>77</b>
I. Meaning .....	77
II. General principles for patent application .....	77
1. Writing requirement .....	77
2. Use of Korean mandated .....	78
3. Formalism .....	78
III. Types of Application Form for Patents .....	78
1. Application Form for Patents .....	78
2. Specifications .....	79
3. Drawing .....	81
4. Abstract .....	82
5. Patent application procedure .....	85
IV. Claim of Patent .....	86
1. Meaning .....	86

TABLE OF CONTENTS

2. Function of Claim of Patent .....	86
3. Make up of Claim of Patent .....	87
V. Singularity of Invention .....	90
1. Meaning .....	90
2. Invention of Group .....	90
3. Requirements for Application #1 .....	91
4. Legal Effect for Breach .....	91
VI. Withdrawal and abandonment of application .....	91
<b>SECTION 2 AMENDMENT OF APPLICATION .....</b>	<b>92</b>
I. Amendment system .....	92
1. Meaning .....	92
2. Types of amendment .....	92
II. Object of amendment .....	93
1. Procedural amendment .....	93
2. Substantive amendment .....	93
III. Procedure of amendment .....	96
IV. Effect of amendment .....	96
1. Lawful amendment .....	96
2. Unlawful amendment .....	96
V. Dismissal of amendment .....	98
1. Meaning .....	98
2. Object of amendment dismissal .....	98
3. Cause of dismissal of amendment .....	99
4. Appeal to dismissal of amendment .....	99
<b>SECTION 3 DIVISIONAL &amp; CONVERSION APPLICATION .....</b>	<b>100</b>
I. Divisional application .....	100
1. Meaning .....	100
2. Requirements for lawful divisional application .....	100
3. Procedure of divisional application .....	101
4. Effect of divisional application .....	101
II. Conversion application .....	102
1. Meaning .....	102
2. Requirements for lawful conversion application .....	103
3. Procedure of conversion application .....	104
4. Effect of conversion application .....	104
5. Relations between original application and conversion application .....	105

<b>SECTION 4 PRIORITY</b> .....	105
I . Meaning .....	105
II . Priority based on treaty .....	105
1. Meaning .....	105
2. Requirements for priority claim .....	106
3. Procedure of priority claim .....	107
4. Effect of priority claim .....	108
5. Determination of priority claim .....	109
III. Domestic priority .....	109
1. Meaning .....	109
2. Requirements for domestic priority claim .....	110
3. Procedure of priority claim .....	110
4. Withdrawal of prior application .....	111
5. Effect of priority claim .....	112
<b>CHAPTER 5 PATENT EXAMINATION</b> .....	115
<b>SECTION 1 REGIMES OF EXAMINATION</b> .....	115
I . Examination regime and non-examination regime .....	115
1. Meaning .....	115
2. Comparison between examination regime and non-examination regime ..	115
3. Neo-examination regime .....	116
4. Classification of examination .....	116
II . Publication of application .....	117
1. Meaning .....	117
2. Time for publication of application .....	118
3. Legal effect of publication of application .....	118
4. Early publication of application by request .....	119
III. Request for examination of application .....	120
1. Meaning .....	120
2. Content .....	120
3. Legal effect of examination request .....	121
IV. Examination per claim .....	122
1. Meaning .....	122
2. Content .....	122
V . Preferred examination .....	122
1. Meaning .....	122
2. Content .....	123
3. Legal effect of preferred examination decision .....	125

<b>SECTION 2 EXAMINATION OF APPLICATION</b> .....	125
I . Examination .....	125
1. Meaning .....	125
2. Qualification of examiner .....	126
3. Exclusion of examiner .....	126
4. Procedure for substantive examination .....	127
<b>CHAPTER 6 PATENT RIGHT</b> .....	131
<b>SECTION 1 CREATION OF PATENT RIGHT</b> .....	131
1. Registration of patent right .....	131
2. Issuing of patent registration certificate .....	131
3. Items to enter in the patent register process .....	131
<b>SECTION 2 EFFECT OF PATENT RIGHT</b> .....	132
I . Meaning .....	132
II . Scope of effect .....	132
1. Scope in place .....	132
2. Scope in time .....	132
3. Scope of protection .....	132
III . Content of effect .....	133
1. ‘Commercially and industrially’ .....	133
2. ‘Patented invention’ .....	133
3. ‘Using’ .....	133
4. ‘Monopoly’ .....	134
IV . Restriction on effect .....	134
1. Meaning .....	134
2. Restriction from limitation of right .....	135
3. Restriction caused by relationship with others .....	136
<b>SECTION 3 ASSIGNMENT AND JOINT-OWNERSHIP OF PATENT RIGHT</b> ..	136
I . Assignment of patent right .....	136
II . Joint ownership of patent right .....	137
1. Working of jointly owned invention .....	137
2. Restriction on assignment .....	137
3. Restriction on licensing .....	137
4. Other .....	137
<b>SECTION 4 TERM OF PATENT RIGHT</b> .....	137
I . Meaning .....	137
II . Term of a patent right .....	138

1. Term .....	138
2. Calculation of term .....	138
III. Extension of the term of a patent right .....	138
1. Meaning .....	138
2. Object of application for extended registration .....	138
3. Extended term .....	138
4. Application of extended registration .....	139
5. Examination of application for extending period of registration .....	139
6. Registration of extension and its effect .....	140
7. Invalidation trial of registration of extension .....	140
<b>SECTION 5 EXTINGUISHMENT OF PATENT RIGHT .....</b>	<b>140</b>
I . Meaning .....	140
II . Cause of extinguishment of patent right .....	140
1. Abandonment of patent right .....	140
2. Cancellation of patent right .....	140
3. Invalidation of patent right .....	141
4. Non-payment of patent fee .....	141
5. Non existence of heir .....	141
6. Expiration of term of a patent right .....	141
<b>SECTION 6 LICENSE .....</b>	<b>142</b>
I . License .....	142
1. Meaning .....	142
2. Scope of license .....	142
3. Types of license .....	143
II . Exclusive license .....	143
1. Meaning .....	143
2. Creation of exclusive license .....	144
3. Content of exclusive license .....	144
4. Relationship between patentee and exclusive licensee .....	145
5. Extinguishment of exclusive license .....	145
III . Non-exclusive license .....	145
1. Meaning .....	145
2. Non-exclusive license by consent .....	146
3. Statutory license .....	146
4. Forced license .....	148

<b>SECTION 7 REGISTRATION</b> .....	150
I . Meaning .....	150
II . Effect of registration .....	151
1. Create a right .....	151
2. Effect a change in right .....	151
3. Effect against a third party .....	151
III. Publication of registration .....	151
1. Meaning .....	151
2. Object .....	152
3. Effect .....	152
<b>CHAPTER 7 IPT’S PATENT TRIAL</b> .....	155
<b>SECTION 1 IPT TRIAL SYSTEM</b> .....	155
I . Meaning .....	155
II . Nature of patent trial .....	155
III. Industrial Property Tribunal .....	155
1. Composition .....	155
2. Classification of IPT trial .....	156
3. Relationship with Patent Court .....	156
<b>SECTION 2 PROCEDURE OF PATENT TRIAL</b> .....	157
I . Request for trial .....	157
1. Mandatory items of the request .....	157
2. Amendment of request; Gist of request .....	158
3. Mandatory written attachment to the request .....	159
II . Party .....	160
1. Capacity to be a party .....	160
2. Qualification of a party .....	160
3. Request for IPT trial and interest .....	161
4. Joint IPT trial .....	161
5. Correction of party .....	162
III. Trial examination .....	162
1. Meaning .....	162
2. Trial examination of formality and lawfulness .....	162
3. Method .....	163
4. Principle .....	163
IV. IPT decision .....	165
1. Meaning .....	165

2. Items to be included in IPT decision .....	165
3. Conclusion of IPT decision .....	165
4. Reasoning of IPT decision .....	166
5. Effect .....	167
6. Correction of IPT decision .....	169
V. Withdrawal of request for IPT trial .....	170
1. Meaning .....	170
2. Requirements .....	170
3. Method .....	170
4. Effect .....	170
<b>SECTION 3 TYPES OF IPT TRIAL .....</b>	<b>171</b>
I . IPT Trial on appeal to patent rejection, etc. ....	171
1. Meaning .....	171
2. Request period .....	171
3. Items to be included in the request .....	171
4. Procedure .....	172
5. Types of IPT decision .....	172
II. Re-examination of amended application .....	173
1. Meaning .....	173
2. Object .....	173
3. Procedure .....	173
III. IPT trial to invalidate patent .....	174
1. Meaning .....	174
2. Grounds .....	175
3. Party .....	175
4. Time of request .....	176
5. Effect of invalidation .....	176
6. Request for correction of patent .....	176
IV. IPT trial to invalidate registration for patent term extension .....	177
1. Meaning .....	177
2. Grounds .....	177
3. Party .....	177
4. Time to request .....	177
5. Object .....	177
6. Effect of invalidation .....	178

V. IPT trial to confirm the scope of a patent right .....	178
1. Meaning .....	178
2. Classification .....	178
3. Party .....	179
4. Time to request .....	179
5. Procedure .....	179
6. Specifying target invention .....	179
7. Effect .....	180
8. Relationship between positive trial to confirm the scope of a patent right and a third invention .....	180
9. Relationship between trial to confirm the scope of a patent right and patentability requirement .....	181
10. Cases .....	181
VI. IPT trial to correct .....	184
1. Meaning .....	184
2. Petitioner .....	184
3. Time to request .....	184
4. Scope of correction .....	184
5. Request .....	186
6. Procedure of trial examination .....	186
7. Trial to correct in multi-claim system .....	187
8. Effect .....	187
VII. IPT trial to invalidate correction .....	188
1. Meaning .....	188
2. Party .....	188
3. Time to request .....	188
4. Grounds .....	188
5. Request for correction in a trial to invalidate correction .....	189
6. Effect .....	189
VIII. Trial to grant non-exclusive license .....	189
1. Meaning .....	189
2. Requirements .....	189
3. Party .....	190
4. Time to request .....	190
5. Request .....	190
6. Effect of final IPT decision .....	190

<b>CHAPTER 8 PATENT LITIGATION</b> .....	193
<b>SECTION 1 LITIGATION ON IPT DECISION, ETC.</b> .....	193
I . Introduction .....	193
1. Meaning .....	193
2. Nature .....	193
II . Relationship to civil and administrative litigation .....	194
1. Distinction from civil and administrative litigation .....	194
2. <i>Mutatis mutandis</i> application of administrative or civil procedure .....	194
III . Types .....	194
1. Action to cancel <i>ex parte</i> IPT decision (defendant: KIPO Commissioner) ..	194
2. <i>Inter parte</i> litigation where patentee or interested party is defendant ..	194
3. Seed Industry Act-related litigation (Article 105 of Seed Industry Act) ..	194
<b>SECTION 2 PATENT COURT</b> .....	195
I . Jurisdiction of patent court .....	195
1. Subject matter jurisdiction .....	195
2. Territorial jurisdiction .....	195
II . Structure .....	195
1. Trial divisions .....	195
2. Technical examination officer .....	195
<b>SECTION 3 FILING A LAWSUIT</b> .....	196
I . Interest in lawsuit .....	196
1. Meaning .....	196
2. Interest in action of patent litigation .....	197
3. Time to determine interest in action .....	197
II . Period for filing a lawsuit .....	197
1. Peremptory period .....	197
2. Court to file a lawsuit .....	198
<b>SECTION 4 PRE-TRIAL PROCEDURE</b> .....	198
I . Meaning .....	198
II . Patent litigation and pre-trial procedure .....	198
1. Purpose of pre-trial .....	198
2. Time to refer to pre-trial .....	198
3. Commissioning an associate judge .....	199
4. Deciding between open and closed pre-trial; preparation of record .....	199
5. Conducting pre-trial .....	199
6. Measures after conclusion of pre-trial .....	199

<b>SECTION 5 TRIAL IN PATENT LITIGATION</b> .....	200
I . Content of trial .....	200
1. Examination of requirements .....	200
2. Examination of merit .....	200
II. Principle and procedure of trial .....	200
1. Meaning .....	200
2. Modified adversarial system .....	200
III. Argument by the parties .....	201
<b>SECTION 6 CONCLUSION OF LITIGATION; APPEAL</b> .....	201
I . Cause of conclusion .....	201
II. Conclusion by other than judgment .....	201
1. Order to dismiss complaint or appeal .....	201
2. Withdrawal of an action or appeal .....	202
III. Conclusion by judgment .....	203
1. Dismissal, etc .....	203
2. Judgment .....	203
3. Effect of judgment .....	203
IV. Appeal to Supreme Court .....	203
1. Period of appeal .....	204
2. Court to file appeal .....	204
3. Scope of appeal .....	204
<b>SECTION 7 PATENT ATTORNEY’S FEE AND COST OF LITIGATION</b> .....	204
I . Meaning .....	204
II. Patent attorney’s fee and cost of litigation .....	205

TABLE OF CONTENTS ::

# CHAPTER 1

## PATENTS AND UTILITY MODEL RIGHT



- I. Patents
- II. Utility model right



## CHAPTER 1 PATENTS AND UTILITY MODEL RIGHT

### I. Patents

The purpose of a patent is to facilitate technological development and contribute to industrial development by protecting and encouraging invention and promoting its use, and to further the development of the industry through the invention application. In this sense, the patent system might be called a protective system for new technologies, a facilitating system for inventions, or a system which guarantees exclusive use. Therefore, a patent applicant who registers with the Patent Office, thereby disclosing his or her invention, in exchange, receives the exclusive right to control how the invention is to be used.

Not all inventions are patentable. In order for inventions to be registered as patents, they must meet the requirements for patentability, which include “subjective requirements”, “objective requirements”, and “procedural requirements” as prescribed by the Patent Act.

#### 1. Subjective requirements

##### A. Competent inventor

An applicant for patents shall be an “inventor” or a “legal successor” to a unique invention.

##### B. Legal capacity

As a legal subject of exercisable right, a “natural person” and a “legal entity” shall be deemed to have legal capacity. With regard to a foreigner’s legal capacity, his or her legal capacity shall be deemed as equal to that of a Korean citizen under the equal protection clause.

#### 2. Objective requirements

Objective requirements refer to the requirements on the application of a patentable invention. The requirements may be divided into “positive requirements for patentability” and “negative requirements for patentability”. Positive requirements for patentability involve how the patentable invention shall be applied, while the negative requirements for patentability involve how the patentable invention shall not be applied.

##### A. Positive requirements for patentability

###### (1) “Invention”

“Invention” under the Patent Act shall mean “a highly skilled thing or art that is a technological creation of ideas using natural laws.”

(2) Industrial applicability

One of the purposes of a patent system is to develop industry.

“Industry” shall include, but shall not be limited to, manufacturing, farming, forestry, stock farming, and supplementary industrial fields such as transportation service, traffic business, etc. “Medical services” shall include services that involve medical treatment and examination, but shall not include preventive medical activities to human beings as defined under the scope of “Industry” as prescribed by Patent Act due to humanitarian concerns.

(3) Novelty

Novelty requires that the invention be quantitatively “different” from a previously registered invention.

(4) Inventive step

Inventive step describes the level of creativity regarding the invention and requires that the invention be a non-obvious progression of prior Art. This requirement shall not be fulfilled if a skilled and reasonably informed person in the industry applied for an invention that serves the same purpose addressing the same issue.

B. Negative requirements for patentability

In spite of satisfying the above positive requirements for patentability, an invention that is anticipated to cause public disorder, be subject to bad moral judgment, or harm public health shall not be deemed patentable.

### 3. Procedural requirements

In order for an invention to be granted a patent, it shall satisfy the following provisions for patent application procedure as prescribed by the Patent Act in addition to the aforementioned subjective and objective requirements.

- A. The procedure for the application shall satisfy the requirements indicated for the specific type of patent;
- B. Filing in accordance to the application specifications shall satisfy the requirements under the rules of provisions;
- C. The application shall satisfy the requirements under the scope of applications.

## II. Utility model right

Most countries incorporating an industrial property right system have placed only technological creation of ideas under protection of patent laws. But several countries, including Germany, have enacted utility model laws, aside from patent laws, protecting technological creation of ideas pursuant to dual legal systems. Accordingly, the Korean Patent Act and Utility Model Act are closely related to each other and similarly reflect laws from other legal systems.

The German utility model system was established to supplement their patent system. Before implementing its utility model system, Germany did not grant exclusive rights to reformation inventions or micro-inventions under its original patent system. Therefore, Germany decided to recognize, thereby protecting and encouraging, micro-inventions of small and medium sized businesses or individual inventors. As a result, several other countries implemented various utility model systems to supplement their respective patent systems

### 1. Consistency to Patent Act

The Korean Utility Model Act shares principles with the Patent Act. Like the Patent Act, the Utility Model Act aims to facilitate technological development and contribute to industrial development by protecting and encouraging the technological creation of ideas and promoting its use. They, however, differ in the level of creativeness required. The Patent Act protects highly skilled and technical designs and arts, while the Utility Model Act protects creations that are less skillful and technical in nature.

The Utility Model Act and the Patent Act share many rules and requirements including, “first-to-file” principle, drawing system, amendment and refusal of amendment system, claim of priority system, local claim of priority system, public notification of registration and opposition to the grant of registration system, compulsory license system and ruling system, rights appropriation system, rights revocation system, request for a trial system, application division system, claim of patent multinomial system, rights infringement system, and reexamination and final appeal system. The Utility Model Act also applies the penal provisions when the following criminal acts have been committed: criminal infringement, false testimony, intentional fictitious declaration, disclosure of secrets and fine for negligence imposition, etc. Accordingly, the provisions of the Patent Act shall be applied *mutatis mutandis* to the Utility Model Act in its major parts.

### 2. Difference to Patent Act

#### A. Objects of protection

“Invention” is classified into invention related to ‘a thing’ and invention related to ‘a method’. Further, ‘a thing’ is divided into ‘an article’, which has a certain form or style and ‘a material’, which does not have a certain form or style. The Patent Act

covers all inventions as ‘a thing’ and inventions as ‘a method’, whereas the Utility Model Act protects utility design related to ‘a thing’ classified as ‘an article’. ‘Materials’ such as agricultural chemicals, medicine, DNA structure, microorganism, fiber optics, and cement creation shall be protected under the Patent Act and not under the Utility Model Act.

#### B. Requirements for registration

Both registration for patentability of invention and registration for utility design require the fulfillment of industrial applicability, novelty, and the inventive step. Note that the Patent Act has a higher requirement for the inventive step than the Utility Model in light of the prior art.

#### C. Term of rights and its extension

The term for patent rights and utility model rights differ from each other. The term of rights for patents shall take effect on the registration date lasting for a twenty-year period, while the term or rights under the utility model shall take effect on the registration date as well, but lasting for a shorter term of ten years.

#### D. Applications and the examination procedure

The application and examination procedures differ amongst the Utility Model Act and the Patent Act on the following points.

- (1) The application form for patents requires attachment of a drawing only if necessary, however, the application form for utility models requires the attachment of a drawing.
- (2) The application, examination, and registration fees for a utility model are relatively cheaper than those for a patent.
- (3) The application period for examination for patents shall not exceed five years from the application date (from the priority date in case of claim of priority), while for the utility model the application period shall not exceed three years thereafter.

#### E. Requirements for rights license

The Patent Act and the Utility Model Act differ in that the former protects inventions and the latter protects utility designs. The Utility Model limits the right of licensing to cover only production, use, assignment, lending, or import of an article, or engagement into assignment or lending of said article.

TABLE OF CONTENTS ::

## **CHAPTER 2**

### **INTRODUCTION TO PATENTS**



- SECTION 1  
INTRODUCTION TO PATENTS
  
- SECTION 2  
INTRODUCTION TO PROCEDURE FOR  
THE PATENT ACT



## CHAPTER 2 INTRODUCTION TO PATENTS

### SECTION 1 INTRODUCTION TO PATENTS

#### I. Goals of the patent system

##### 1. Meaning

The purpose of a patent system is to promote the industrial development of the nation in order to effectively protect “inventions” among industrial property rights. For this purpose, an inventor will be granted exclusive licensing rights in exchange for his or her disclosure of such invention to the Patent Office which will promote technological development and ultimately contribute to the nation’s industrial development. Each country’s system varies depending on their respective industrial policy. However, the basic mechanism where a grant of exclusive license is exchanged for disclosing an invention thus allowing a third party to utilize it according to a legal procedure is the same everywhere.

The Patent Act of Korea states in Article 1 “the purpose of this Act is to facilitate technological development and contribute to industrial development by protecting and encouraging invention and promoting its exploitation.” This indicates that “protection for invention” and “inventive application” are two cornerstones that are necessary for the purpose of industrial development.

##### 2. Protection for invention

Article 22 Paragraph 2 under the Constitution of the Republic of Korea states that “the rights of authors, inventor, scientists, engineers and artists shall be protected by the Acts.” Protecting the ownership rights in the manufacturing industry are prescribed by related Acts. The Acts provide substantial protection for inventions, as well as processes that are deemed patentable under the Patent Act as a property right for a certain period of time.

##### 3. Inventive application

An inventive application requires the disclosure of an invention to the public in return for its protection and enablement of a third party to freely avail himself of such invention for the purpose of research. An inventive application shall consist of the “disclosure of invention” and the “inventive license.”

### A. Disclosure of invention

A person who pursues ownership for inventive rights shall submit certain contents of the invention to the government in order to obtain a grant of exclusive license to such invention. The contents of the invention shall be disclosed to the public unless an extraordinary circumstance exists. The Patent Act implements an open applications system and a public notification of registration system as a means of disclosure of invention. Such patents are disclosed by publication issued by the Korean Intellectual Property Office.

### B. Inventive license

To obtain a patent, an inventor is always obligated to disclose the invention. But, under certain circumstances, an inventor may also be obligated to offer an inventive license to third parties. An inventive license includes, but is not limited to, his own license and licenses allowing third parties to use the invention for a certain price. Accordingly, most countries incorporating a patent system have stipulated provisions for controlling licenses under certain conditions for public interest reasons.

## II. Development of patents

### 1. Introduction of patents

In Korea, Seok Young Ji was the first to propose the idea of a patent system in his memorial speech to the government in 1882. However, Korea did not create a patent system until much later when the country received pressure from the rest of the world to establish a patent system.

Japan came to rule Korea after winning the China-Japan War and Russia-Japan War. On August 12, 1908, Japan and the United States entered into and promulgated the U.S.-Japan Treaty addressing protection of invention, design, trademark and copyright for the purpose of protecting their respective homeland technology. A patent system was introduced through the Korea Patents Order (Japan Emperor Order 196). On August 29, 1910, the Korea Patents Order was abrogated after Annexation, and the Japan Patent Act was directly implemented in Korea.

In 1945, Japan was defeated in World War II and Korea regained independence. The Patents Administrative Incorporation Committee was founded on January 4, 1946. Shortly thereafter on January 22<sup>nd</sup>, the 'Patents Office' was established pursuant to Order 44, U.S. Martial Law. On October 5, 1946, along with the inauguration of the first Commissioner of the Patent Office, the Patent Act was enacted and promulgated pursuant to Order 91, U.S. Martial Law. Thereafter, on October 15, 1946, the Local Rule, the Patent Act was promulgated, and a legal system for industrial property rights protection including the Utility Model Act and the Design Act was formed.

## 2. Enactment and amendment of the Patent Act

- (1) December 31, 1961 the Patent Act was enacted  
On May 16, 1960, as a result of a legal reorganization project after a military revolution, contents of the Patent Act was incorporated into newly enacted 3 Acts, the Patent Act, the Utility Model Act, and the Design Act. The Patent Act shall be comprised of 158 provisions introducing Korea to modern patent systems such as the “first-to-file” system, industrial applicability of requirements for patentability, prior use right, non-licensing revocation, the procedure for applications for nonresident nationals, etc.
- (2) Amendment of March 5, 1963: Added a provision to the definition of invention and amended the claim of priority system and change of an application.
- (3) Amendment of February 8, 1973: Added non-patentable object, a provision that novelty is lost when an invention is released in an overseas bulletin prior to his application, and added compulsory licenses.
- (4) Amendment of December 31, 1973: Amended claim of priority regulation, added incomplete preparation for specification as a ground of patent invalidity, and added incomplete preparation for claim of patent.
- (5) Amendment of December 31, 1980: On May 1, 1980, added a multinomial system pursuant to the Joined Paris Treaty, added accelerated disclosure applications system, application for examination system, amendment-limiting system, and a preferential examination provision.
- (6) Amendment of November 29, 1982: Addressed matters related to international procedures for applications pursuant to the Patent Cooperation Treaty (PCT) in order to join the PCT.
- (7) Amendment of December 31, 1928: Allowed material patents, improved enactment system by non-licensing, extended term to 15 years, and introduced the examination disposition system.
- (8) Wholly Amended Patent Act of January 13, 1990: expanded objects for patents for plant patents, admitted food, beverage and preferred substance patents, newly added local claim of priority system, refusal of amendment, refusal of amendment objection system, term of patents extension (application date for patents shall take effect for a twenty-year period), and deleted limitation period for invalidity trials.

- (9) Amendment of December 10, 1999: Established a period to submit claim of priority, approve documents for months of divisions, revisions, newly added provisions, return patent fees, and provide scope for *ex officio* examination of an object.
- (10) Amendment of January 5, 1995: revised the trial system, established Intellectual Property Office, abrogated appeal on a ruling trial system and provided for a trial decision revocation within an exclusive jurisdiction of the Patent Court.
- (11) Amendment of December 29, 1995: Amendment accommodated WTO/TRIPs provisions.
- (12) Amendment of April 10, 1997: Abrogated a system for public announcement of applications, and introduced opposition to the grant of registration after patents.
- (13) Amendment of September 23, 1998: Introduced a system of electronic applications, abrogated a system of altered applications for a patent, introduced a system of dual applications for a patent, and performed PCT international investigations and international preliminary examination duties.
- (14) On December 1, 1999, started international investigation and international preliminary examination duties.
- (15) Amendment of February 3, 2001: Added cause of novelty loss, expanded exceptional subject of novelty loss, and amended amendment system, claim of priority provision, opposition to the grant of registration, and the trial system.
- (16) Amendment of March 3, 2006: Abrogated a system of dual application for a patent, revived a system of altered application for a patent, integrated opposition to the grant of registration into an invalidity trial system, and converted public announcement from a local system into an international system.
- (17) Amendment of January 3, 2007: Mitigated requirements to enter detailed explanation for an invention and claim of patent submission extension system, and diversified application examination system and claim of patent filling method.

### 3. Reform of the patent litigation system

#### A. Background of system renovation

Ever since the “1946 Patent Act” which was enacted pursuant to Order 91, U.S. Martial Law after liberation on October 5, 1946, a patent-related litigation system has established itself through the Korean Intellectual Property Office; the system allows trial at the Trial Court and the Appellate Court, then the final decision was made in the Supreme Court. However, a decision to refuse and a trial decision by the Korean Intellectual Property Office, in spite of being an administrative measure, was not allowed to appeal on a ruling from a High Court, but, instead, had to institute a final appeal to the Supreme Court according to the structure illustrated above. On the ground that such rights to judgment as guaranteed under the Constitutional Law was infringed, an action was called to the Constitutional Court on September 28, 1995 for violation of the Constitution with regard to 1992 Patent Act, specifically in violation of Article 186 Paragraph 1 of the Constitution. The Constitutional Court ruled that there was a violation of the Constitution with respects to the Patent Act’s Article 186 Paragraph 1. Accordingly, on January 5, 1995, the Patent Act was amended mainly having a focus on the revision of the patent litigation system; the Amendment was made effective on March 1, 1998.

#### B. Major description

##### (1) Change of structure

The Trial Court of the Korean Intellectual Property Office previously took charge of first trial, the Appellate Court of the Korean Intellectual Property Office presided over the second trial, and the Supreme Court took charge of the third trial. The Trial Court and the Appellate Court were abrogated. And the newly established Intellectual Property Tribunal of Korean Intellectual Property Office took over the first trial, the Patent Court took over the second trial, and the Supreme Court has handled all unresolved issues. However, since the trial decision of the Intellectual Property Tribunal is not a court decision, the patent litigation system has actually adopted a dual trial format through the Patent Court and the Supreme Court.

##### (2) Establishment of the Intellectual Property Office

The Trial Court and the Appellate Court of the Korean Intellectual Property Office have been integrated. Also under the Korean Intellectual Property Office, the independent agency called the Intellectual Property Tribunal has been established, thus adjusting the Commissioner of the Korean Intellectual Property Office to that of the President of Intellectual Property Tribunal with respect to the operation of the patent appeals system.

### (3) Establishment of the Patent Court

The Patent Court shall be established at the level of a High Court in the Ministry of Justice and have an original jurisdiction over actions concerning objections to trial decisions and rulings of the Intellectual Property Office.

## 4. Basic principles of the Patent Act in Korea

### A. Principle of the right

Principle of the right means that an inventor has a right to obtain patents according to the Acts, and the government enforces this right following the system in place. Korea prescribes an inventor as a “patentable person” under the Acts declaring the principle of the right.

### B. Substantive examination

The method to grant a patent shall be comprised of a non-substantive examination and a substantive examination. A non-substantive examination is a system in which formal methodological requirements apply to patents and to grant patentability. A substantial examination with regard to validity of patents shall be decided by the court at the time of inurement of a patent dispute. Substantive examination is a system in which substantial examination occurs in respect to the prerequisites for patentability. Korea has adopted the principle of substantive examination.

### C. Prior right system

In cases where patent applications conflicted over identical inventions, the “first-to-invent” principle grants the first inventor patents; the “first-to-file” system grants patents to the first applicant irrespective of when the invention was actually completed. The “first-to-invent” principle protects the prior inventor and is desirable in promoting invention. However, procedurally, it is difficult to determine priority of completion of invention with this system. On the other hand, the “first-to-file” system protects the prior applicant and it is favored in promoting invention publication. At present, most countries, including Korea, have adopted the “first-to-file” system.

### D. Laying open of application

Laying open of application is a system that publicizes an invention as applied after the lapse of the time limit from the application date for patents irrespective of whether or not the patent is granted to application, which mainly aims to promote inventive application and to prevent abuse of substantive examination.

#### E. Application for substantive examination

The Patent Act introduced a patent application for examination system requesting substantial examination aside from the application itself, through substantial examination as processed by the order of applications for examination. The purpose of this system is to correct disadvantages of applicants and the third party by eliminating backlogging of examinations.

#### F. Public notification of registration and a system of oppositions to the grant of patents

The Office shall grant patents to patentable invention unless any cause of rejection is a result of substantial examination. When the patent is registered, anyone may take opposition to the grant of registration within three months of the public notification of registration date to minimize inefficient rights through cooperation by the public forum.

#### G. Registration system

Patents shall be inured by registration. Accordingly, patents shall be inured when one is entitled to a grant of a patent, pays a certain fee amount, and goes through the registration procedures. In addition, in cases where the right inures to change after patent registration, one can oppose a third party only after one registers the right.

## SECTION 2 INTRODUCTION TO PROCEDURE FOR THE PATENT ACT

### I. Competency

#### 1. Capacity

##### A. Meaning

“Legal Capacity” describes the position or qualification of a subject’s rights. Since not all legal competent persons are able to acquire rights or bear obligation, we rely on one’s competency to understand and determine intention to show that a legal competent person expresses “mental capacity”. Accordingly, a declaration of intention made by a person lacking mental capacity shall not be granted legal effect. However, to address the realistic issue of deciding mental capacity, the “incapacity system” was introduced within the scope of “legal action related to property”, which aims to protect incompetent persons by revoking their actions without confirming whether they act with mental capacity or not.

A person may be considered either incompetent or competent in describing capacity. Accordingly, capacity means a position or a qualification who is solely entitled to valid legal action. Civil Code does not provide for capacity, however, such terms as competency, competent person, incompetency, incompetent person are related to capacity. Accordingly, the Patent Act prescribes capacity of incompetent person under Article 3 of the Act.

## B. Incompetent person under the Patent Act.

### (1) Incompetent person system

(a) Legal action taken solely by an incompetent person can be revoked and may not be revoked if the incompetent person stands favorable with the action. But once it is revoked, it shall be invalid retroactively, whose absolute effect of invalidity shall influence all parties thereof. This incompetent person system is frequently acted in common, and it shall be applied only to “legal action related to property” using declaration of intention as a determining factor.

(b) Civil Code prescribes the following persons as incompetent persons:

- ① a person under 20 (minors),
- ② a person who is declared a person of quasi-competency under the adjudication of quasi-competency by the court as a physically and mentally handicapped person or a person who is anticipated to live in poverty due to waste of fortune,
- ③ a person with physical and mental loss who is declared incompetent under the adjudication of competency by the court.

### (2) Incompetent person under the Patent Act

The Patent Act prescribes “Minors” as a person of quasi-competency or a person of incompetency who shall not apply for patents without a legal representative. However, it shall not be applicable to such cases where minors and a person of quasi-competency are deemed to take legal action independently. This is pursuant to the incompetent person system of the Civil Code found in Paragraph 1, Article 3 of the Act, which prescribes that an incompetent person can only apply for the procedures for patents through legal representatives.

### (3) Authority of legal representative

The scope of power of attorney shall be prescribed by the provisions of the Act. Article 950 from the Civil Code states that, in order to protect an incompetent person from arbitrary actions of his legal representative, the legal representative will be able to represent incompetent person in the procedural act with consent of a family meeting, and the actions of the legal representative in violation of this regulation can be revoked

by the family meeting. On the other hand, Paragraph 2, Article 3, Patent Act prescribes that the “legal representative of Paragraph 1 shall be able to take action regarding opposition for patent proceedings for trial or reexamination by a third party without a consent of a family meeting.” This indicates that a legal representative shall be able to take proceedings regarding opposition for patent trial or reexamination by a third party for passive-relative procedural acts between parties without a consent from a family meeting.

#### (4) Ratification by a legal representative

(a) Ratification means abandonment of a right of revocation (declaration of intention of a legal action to another party that can be revoked by a ratifier), if ratified, a revocable act cannot be revoked thereafter. Its legal action shall be completely valid whose effect shall be applied retroactively effective to the first time of act.

(b) Article 172 of the Patent Act prescribes that “any procedure taken by a person without capacity or a legal power of attorney, or a person with a defect in authorization necessary to taking the procedures with respect to patents shall be effective retroactively to the act in cases of an amended party or ratification by a legal representative.” Accordingly, “ratification” under the Patent Act shall not mean abandonment of the right of revocation, but declaration of intention that invalidity of the procedure (Article 16 of the Act, Article 46 of the Act) taken by a person without capacity or a legal power of attorney, or a person with defect in authorization necessary to taking the procedures with respect to patents shall be retroactively effective to the time when the action occurs.

## 2. Legal capacity

### A. Meaning

“Legal Capacity” or “Legal Character” means a position or a qualification that can be the subject of rights. In the Civil Code, a person that is the subject of rights of legal capacity is a human being – “natural person” or a certain group, association or foundation – “legal entity”. The provisions of litigation party competency of an unincorporated association or foundation that is substantially an association or a foundation, but fails to obtain authorization by the competent authorities or go through registration of establishment shall not be prescribed in the General Provisions of the Civil Code, but in Article 48, Civil Procedure Act. In the Patent Act, one must have legal capacity in order to be the subject of rights related to a patent-related procedure and a patent right.

### B. Legal capacity of an association, etc, not in case of legal entity

Article 4 of the Patent Act prescribes “in cases where a representative or a manager is determined as an association or a foundation, not a legal entity, a person shall be able to apply for examination, oppositions to the grant of a patent, apply and defend a trial decision or apply and defend for reexamination in the name of its association or foundation.” This means that anyone entitled to apply for an examination and oppositions to the grant of patents within a set period of time, and the fact that an association or a foundation, not a legal entity is prescribed to be entitled to be a party in trial or reexamination has the same purpose prescribed in the Article 48, Civil Procedure Act “as an association or a foundation, not a legal entity, a representative or patent manager can be a party in its name.”

### C. A foreigner’s legal capacity

(1) A foreigner is a natural person not holding a nationality of the Republic of Korea, including a person who holds a nationality of foreign countries and a person without holding a nationality. A foreigner’s position, as prescribed by Paragraph 2, Article 6 of the Constitution “shall be guaranteed pursuant to the international Act and Treaty.” This is based upon the equal protection clause that allows the same legal capacity as that of resident nationals. Thus, foreign nationals shall be provided for individually in the Acts with regard to restriction to a foreigner’s legal capacity.

(2) Article 25 of the Patent Act restricts a foreigner’s patents or rights with respect to patents based upon resident nationals and the mutual equal protection clause. Accordingly, if a foreigner applies for a patent in violation of the provisions of Article 25 of the Patent Act, it shall be reasons for rejection, reasons for oppositions to the grant of patents and reasons for invalidity.

## II. Power of attorney

### 1. Meaning

Effect of legal action shall be inured to a person who declares the intention to utilize power of attorney. However, in a system of “power of attorney”, the legal effect is ascribed to the third party, not the person who declared the intention. This power of attorney was not allowed in ancient Roman or German law. But in the 17th century, Germany developed an “agreement for the third party” theory which is now known as the power of attorney. The concept of power of attorney has been admitted as an independent legal system and is allowed in all legal action except for ‘status-related legal action’ where one demands sole and absolute decision-making power. Accordingly, the power of attorney separates a person with legal action or declaration of intention from a person

who receives such legal effect. The effect of representation by power of attorney shall totally belong to him or her.

The provisions regulating the power of attorney can be found in the Patent Act under Article 3, legal power of attorney, Article 5, patent manager system by nonresident nationals, Article 6 to 10, the scope, authenticity, non-distinguishment of power of attorney, and individual agent and replacement. In addition, the Civil Procedure Act shall apply *mutatis mutandis* to matters not related to Article 12 of the Patent Act unless otherwise described with regard to an agent specifically prescribed in the Patent Act.

## 2. Types and rights of power of attorney

An agent under the Patent Act can be divided into a “legal representative” or a “temporary substitute” pursuant to the type of inurement.

### A. Legal representative

#### (1) Meaning

A legal representative is a person who holds power of attorney pursuant to the provisions of the Patent Act regardless of the intention of the principal. Parents who are persons having paternal right (Article 909, Article 911, Civil Code) or guardians (Article 928, Civil Code) shall be legal representatives under the positive law with regard to minors among incompetent persons and guardians (Article 929, Article 938, Civil Code) with regard to person of quasi-competency or person of incompetency.

Paragraph 1, Article 3 of the Patent Act states that “minors, person of quasi-competency or person of incompetency, unless otherwise through a legal representative, shall not go through the procedure for application for a patent for others. However, this shall not be applicable to such cases where minors and a person of quasi-competency are deemed to take a legal action independently”, which prescribes that incompetent persons can and shall take the procedure for patents only through a legal representative.

#### (2) The scope of power of attorney

The scope of power of attorney shall be prescribed by the provisions of the Patent Act. Article 950 of the Civil Code regulates that, in order to protect an incompetent person from arbitrariness of a legal representative, the legal representative may represent an incompetent person in the procedural act with consent of a family meeting, and the actions of a legal representative in violation of the above regulation can be revoked by the family meeting. On the other hand, Paragraph 2, Article 3 of the Patent Act states that the “legal representative of Paragraph 1 shall be able to take proceedings regarding opposition for patents, proceedings for trial or reexamination from the other party without a consent of a family meeting.” This indicates that a legal representative shall be able to take proceedings regarding disadvantageous acts against an incompetent person without consent from a family meeting.

## B. Temporary substitute

Temporary substitute refers to the case when a principal grants power of attorney to another. Temporary substitute can be divided into a “non-exclusive agent” and a “patent manager” depending on whether the principal has his or her own address or a place of business.

### (1) Non-exclusive agent

#### (a) Meaning

Non-exclusive agent refers to a “patent manager” under the Patent Act and an agent of a person who has his or her own address or place of business.

#### (b) The scope of temporary substitute

The scope of temporary substitute is determined through “conferred power” of the Patent Act stating that the principal grants the agent power of attorney. A non-exclusive agent, unless otherwise conferred power as prescribed by Article 6 of the Patent Act, shall have a right to take a patent-related procedure. Matters related to specially conferred power needing confirmation of individual intention of the principal are provided for as “applications abandonment, withdrawal, withdrawal of application for registration of extension of term of patents, patents abandonment, withdrawal of application, withdrawal of a request for a trial, claim of priority or its withdrawal prescribed under Paragraph 1 of Article 55, a request for a trial or appointment of sub-agent prescribed under Article 132-3.”

### (2) Patent manager

#### (a) Concept

The Patent Act provides for a patent manager system for smooth patents procedures for nonresident nationals. A patent manager is a person who has an address or a place of business in Korea as an agent with respect to patents of nonresident nationals among temporary substitutes. Nonresident nationals shall not take part in a patent-related procedure or bring an action against measures taken by the administrative agency regarding the Patent Act or orders pursuant to the Patent Act without a patent manager (Paragraph 1, Article 5 of the Act).

#### (b) Right

The current Amendment Act prescribes that the patent manager shall be able to represent all procedures with respect to patents within the conferred scope of representation. It shall have a general right unlike a non-exclusive agent even in the act of following the principal’s disadvantage. And, without specially conferred power, it can represent disadvantageous acts such as a withdrawal of applications or a withdrawal of a request for a trial (Paragraph 2, Article 5 of the Act).

For example, if the scope of power of attorney says, in the blank of delegating power of attorney, “whole cases with respect to ○○ applications of the court”, it shall be deemed that it is included in specially conferred power issues.

### 3. Certification of power of attorney

#### A. Meaning

The effect of representation of power of attorney shall belong to the principal, therefore, power of attorney of a person who has taken a patent-related procedure including patent manager shall be provided in written form (Article 7 of the Act).

Documents that approve power of attorney of a legal representative shall consist of an extract or a copy of the domiciliary register, an extract or a copy of registration of incorporation, and documents to approve temporary substitute include a power of attorney or other arrangements approving conferred power, etc.

In cases where a person has not approved power of attorney to initiate a patent-related procedure, the Commissioner of the Korean Intellectual Property Office, the President of the Intellectual Property Tribunal or a presiding trial examiner shall order an amendment by indicating a certain period to prove power of attorney in a written form. In cases where a person fails to provide such an amendment order, he shall be liable to invalidity of the procedure for the year or be forced to dismiss his request for a trial (Article 16 of the Act, Article 141 of the Act).

#### B. In a case of individual power of attorney

In cases where a person initiates a patent-related procedure through an appointed power of attorney, he shall submit a power of attorney in an attached form to report of power of attorney appointment.

However, appointment report shall not be submitted in cases where an agent submits an application form for patents, oppositions form to the grant of patents, application form for a trial, reapplication for examination report or written reply attaching a power of attorney in cases of applications, oppositions to the grant of patents, request for a trial, reapplication for examination or reply to oppositions to the grant of patents, request for a trial, reapplication for examination (Paragraph 2, Article 5, Local Rule).

#### C. In a case of general power of attorney

In cases where a patent-related procedure is initiated by an agent, and he would like to grant a general power of attorney without specifying the cases in advance with regard to present and future issues, he shall submit an application for a general power of attorney registration together with a general power of attorney to the Commissioner of the Korean Intellectual Property Office. The Commissioner of the Korean Intellectual Property Office

will give a general power of attorney registration number and notify its number to the applicant for general power of attorney registration.

Requirements under the general power of attorney registration include entering the general power of attorney registration number onto the documents submitted to the Korean Intellectual Property Office or Intellectual Property Tribunal without the need to include additional proof of power of attorney. However, such procedures of general power of attorney will not be allowed in oppositions to the grant of patents and trial (except for a trial against decision to refuse a patent or decision to revoke a patent). Therefore, the provisions of individual power of attorney shall apply *mutatis mutandis* to matters related to the application for a general power of attorney registration.

#### 4. Non-distinguishment of power of attorney

##### A. Meaning

An agent by power of attorney who initiates a patent-related procedure of the Patent Act shall, in spite of problems to the principal himself, maintain continuity of the procedure. And for swift-smooth proceedings of administrative procedure, application of non-distinguishment of power of attorney of litigation under Article 86 of the Civil Procedure Act shall be applied *mutatis mutandis*.

##### B. Cause of non-distinguishment of power of attorney

The power of attorney of an agent shall not be extinguished even if the following causes inured to the principal or a legal representative who delegated a patent-related procedure.

- ① the death of the principal or loss of legal capacity
- ② the extinguishment of a legal entity of the principal due to a merger
- ③ the termination of the duty of trust of the principal
- ④ the death or loss of legal capacity of the legal representative or the modification or extinguishment of the power of attorney

#### 5. Principle of individual agent

If there are multiple agents of a person who initiate a patent-related procedure, each person represents the principal with regard to the Korean Intellectual Property Office or Intellectual Property Tribunal (Article 9 of the Act). Accordingly, in cases where there are several agents, any of the procedures initiated between the Korean Intellectual Property Office and an agent shall be deemed valid, and documents shall be transmitted to any one of the several agents.

The actions of the several agents may contradict or collide with each other. In cases where the contradictions occur at the same time, none shall be valid. However, in cases

where it happens at a different time, if the proceeding act can be withdrawn, its act shall be withdrawn by the subsequent act. Likewise, if the proceeding act cannot be withdrawn, the subsequent act shall have no effect.

## 6. Replacement of power of attorney, etc

In cases where it is deemed that the Commissioner of the Korean Intellectual Property Office or a presiding trial examiner determines, in its sole discretion, that a person who initiates a patent-related procedure is not expected to appropriately carry out its procedure or he will not be able to carry out its procedure smoothly or express his own opinions at oral hearing, he shall be able to order to carry out such procedure by the agent. (Paragraph 1, Article 10 of the Act) In cases where it is deemed that the agent of a person who initiates a patent-related procedure is not expected to appropriately carry out its procedure or he will not be able to carry out its procedure smoothly or express his own opinions at oral hearing, then he shall be able to order a replacement for the agency (Paragraph 2, Article 10 of the Act).

The Commissioner of the Korean Intellectual Property Office or a presiding trial examiner, after ordering appointment or replacement of power of attorney, shall be able to invalidate a patent-related procedure related to the Korean Intellectual Property Office or Intellectual Property Tribunal taken by a person who initiates a patent-related procedure prior to appointment or replacement of power of attorney or an agent prior to replacement.

## 7. Common representative

### A. Meaning

The term “common representative” means a person who is reported to be a party in a written form to represent multiple parties initiating two or more patent-related procedures. In this sense, the procedure will be simpler than that in taking two or more patent-related procedures at the same time. A representative of multiple parties is similar in its legal characteristics of a party designated under Article 49 of the Civil Procedure Act, however, differing in that it represents multiple parties.

### B. Capacity of multiple parties

(1) In a case where two or more patent-related procedures are initiated, with the exception of procedures that are disadvantageous to other multiple parties, all parties shall be represented. In other words, the procedure initiated by one party shall be effective to multiple parties, unless otherwise prescribed by any of the following Subparagraphs, Paragraph 1, Article 11 of the Act, shall affect all of the parties. However, in cases where the parties appoint and report a representative to the Korean Intellectual Property Office or Intellectual Property Tribunal in a written form, the representative shall only be entitled to the procedure.

(2) The representative shall not be allowed any of the following procedures as prescribed by Paragraph 1, Article 11 of the Act, therefore, multiple parties shall complete the following procedure.

- ① applications abandonment or withdrawal of application for registration of extension of patent terms
- ② withdrawal of application, local claim of priority or its withdrawal
- ③ withdrawal of a request for a trial
- ④ request for a trial with regard to decision to refuse a patent or decision to revoke a patent

### C. Common representative

#### (1) A representative

In a case of initiating two or more patent-related procedures, each multiple party shall appoint its own representative in taking action on behalf of each multiple party. In cases where the parties would like to appoint and report a representative out of multiple parties with the number of reported representatives, the representative shall only be entitled to the procedure.

#### (2) The right of a representative

A common representative shall have the position of the principal and a representative of other parties concurrently; it shall be entitled to the procedure of representing all of parties commonly. A procedural act representing other parties shall be enabled within a scope that is allowed by each representative. Accordingly, in cases where one initiates the procedural act as illustrated in Paragraph 1, Article 11 of the Act, one shall obtain an agreement of the other party.

## 8. Venue of nonresident nationals

Special venue for nonresident nationals is prescribed in Civil Procedure Act Article 9: “a trial related to a property right without an address or without a known address in the Republic of Korea shall be brought in the court with the jurisdiction of purpose for a request for a trial or object of mortgage or seizable address of a property of a defendant.”

Accordingly, a trial against a patent or the patent right of nonresident nationals shall be brought:

- ① in the court with the jurisdiction of address or a place of business of its patent manager if one was registered,
- ② in the court with the jurisdiction of location of the Korean Intellectual Property Office if a patent manager was not registered.

### III. Period

#### 1. Meaning

Due date indicates a certain period. Period means continued time from a certain designated point of time to another certain designated point of time. The calculating method of period shall be normally determined pursuant to Civil Code (Article 155-Article 161), however, the Patent Act prescribes another period calculating method (Article 14 of the Act), therefore, this act shall be given preference over other Acts.

#### 2. Types of period

##### A. Legal period

Legal period refers to the period pursuant to the relevant Act, and may include the extension period (Paragraph 1, Article 15 under the Patent Act) or an additional period (Paragraph 5, Article 186 under the Patent Act). The legal period shall not include any arbitrary length of time. Legal period under the Patent Act shall include, but not be limited to, a deadline for submission of certificates in cases of being deemed an invention without public announcement (Paragraph 2, Article 30 of the Patent Act), an altered applications period (Paragraph 1, Article 53 of the Act), an application period for examination for patents (Paragraph 2, Article 59 of the Act), etc.

##### B. A designated deadline

A designated deadline refers to the time determined pursuant to the Patent Acts deemed necessary to carry out the procedure by the Commissioner of the Korean Intellectual Property Office, the President of Intellectual Property Tribunal, and a presiding trial examiner or examiner. A designated deadline under the Patent Act shall include, but not be limited to, a consultation order period for identical applications (Paragraph 6, Article 36 of the Act), a procedural amendment period (Article 46 of the Act), and a written argument for deadline submission (Article 63 of the Act), etc.

#### 3. Calculating method for period

Calculating method for period is divided into “natural calculating method” that exactly calculates the natural time flow from one moment to another moment and “calendar calculating method” calculates the time pursuant to the calendar time. In addition, the calendar calculating method is classified into “extensive calculating method” that extends a substantial period by excluding the beginning day and “contractive calculating method” refers to contracting a substantial period by including one day. The Patent Act adopts the former, “extensive calculating method”, as a base, although the latter is exceptionally accepted.

#### A. Day on which computation begins (Paragraph 1, Article 14 of the Act)

The Patent Act adopts the extensive calculating method, which excludes the beginning day in the counting period. In rare cases, however, where the period begins at 12:00 a.m., the beginning day is included. For example, in cases where a written argument deadline for submission is June 10, 2001, the period shall be 12:00 a.m., June 11, 2001 that is calculated to be extended in a case of an application for extension of the period.

#### B. Day of expiration

(1) In cases where the period is determined by the month or the year, it shall be computed by the calendar method (Paragraph 2, Article 14 of the Act). For example, the date of expiration following three months beginning from 12:00 a.m., August shall be 12:00 p.m., November 30.

(2) In cases where the period is not computed from the beginning of the month or the year, the period expires on the previous day of expiration on which computation began in the last month or year (Paragraph 3, Article 14 of the Act). For example, the day of expiration one month after June 30, based upon principle of not inserting the beginning day, shall have its day on which computation begins on July 1, and shall have its day of expiration on July 31, a previous expiration day of August 1, one month thereafter.

(3) In cases where it is determined that pursuant to the month or the year, and there isn't a day applicable in the last month, the period shall expire as of the last day of the month (Paragraph 3, Article 14 of the Act). For example, the last day of the month following one month after January thirty (30) shall be the last day of February.

(4) In cases where the last day of the period is a holiday (including Labor Day and Saturdays), and the procedure is patent-related, the period shall expire on the following day (Paragraph 4, Article 14 of the Act). However, in cases of computation of the period, such as term of patents not including patent-related procedure, the period expires on the holiday even if the last day of the period is a holiday.

### 4. Extension of period

#### A. Meaning

In cases where a person initiates a patent-related procedure and is unable to perform the procedural act during the allotted period, he shall lose the opportunity to take such act. However, an extension of a patent term system is available for the protection of

an inventor for the benefit of a person who initiates a patent-related procedure residing in an area that is remote or difficult to access or is not expected to take such act within a set period of time (Article 15 of the Act).

## B. Period of subjection of extension

### (1) Legal period

The Commissioner of the Korean Intellectual Property Office or the President of the Intellectual Property Tribunal may extend the following period by *ex officio* determination or by a party's application for the benefit of a person residing in an area that is remote or difficult to access.

- ① the period within thirty days after oppositions to the grant of patents that can amend cause or evidence of opposition to the grant of registration by the applicant for oppositions to the grant of a patent,
- ② the period within thirty days as of the date of submission of the decision to refuse appeal by a person who has a decision to refuse,
- ③ the period within thirty days as of the date of submission of a copy of decision to revoke by a person who has a decision to revoke,
- ④ the period within thirty days as of the date of submission of a copy of decision to apply for appeal of an examiner's decision of refusal by a person who has a decision to refuse an application to extend the term of a patent right.

### (2) A designated deadline

A designated deadline indicates that a written argument for a deadline for submission shall be within two months as pursuant to Article 63 of the Act. An amendment period shall be one month as pursuant to Article 46 of the Act as a rule. However, the extension or contraction of a designated deadline may be offered if necessary. At this time, in cases where the Commissioner of the Korean Intellectual Property Office, the President of Intellectual Property Tribunal, a presiding trial examiner or examiner determine the period for a patent-related procedure, it may *ex officio* or by a party's application determine an extension or a contraction.

## C. Extension of the procedure

A person who would like to receive a legal period or a designated extension of a period shall pay the required fee for an application form for extension of a patent term as prescribed by Paragraph 2, Article 16, Local Rule of the Patent Act prior to the expiration of the original term and submit it to the Korean Intellectual Property Office. Where the application form is submitted after the lapse of the set period, extension of a patent term shall not be approved.

## IV. Introduction to the procedure

### 1. The effects of the procedure

#### A. Period of enter into force

(1) A patent-related procedure shall be by submitted documents that take effect upon the receipt by the Korean Intellectual Property Office or Intellectual Property Tribunal (Paragraph 1, Article 28 of the Act).

(2) Where the documents are delivered to the Korean Intellectual Property Office or Intellectual Property Tribunal by mail, the law adopts the principle to regard the date on which the documents are submitted to the post office as the date on which the documents arrive in the Korean Intellectual Property Office or Intellectual Property Tribunal if the mail has a clear sealed impression on it.

If the sealed day is not clear, the day that is proved by the receipt of mail shall be deemed to arrive at the Korea Intellectual Property Office or Intellectual Property Tribunal. However, where the registration application forms regarding patents rights and documents related to international applications under the provisions of the Patent Cooperation Treaty Article 2(vii) are submitted by mail, the above principle of arrival shall be adopted (Paragraph 2, Article 28 of the Act).

(3) In cases where documents are submitted by mail, any delay or loss of mail and submission of documents due to suspension of postal service, the procedure shall be as follows:

#### (a) Delay and loss of the mail

Where an applicant submits documents by registered mail with regard to international applications submitted to the Commissioner of the Korean Intellectual Property Office which fails to be delivered due to delay or loss of the mail within the deadline for submission, he may submit proof that he already submitted documents by mail within five days prior to the deadline for submission to the Commissioner of the Korean Intellectual Property Office (Paragraph 1, Article 86, Local Rule, Patent Act). Submission of evidence shall be made within one month as of the day that an applicant is aware of a delay of a document's arrival or the day that he could have been aware of the fact if he had paid considerable attention, but it shall be submitted within six months from expiration of a deadline for submission for the documents. In cases where it is deemed that the documents couldn't arrive within a deadline for submission due to a delay or loss of the mail as seen from the submitted evidence, the documents shall be presumed to be regarded as submitted within the deadline for submission (Paragraph 2, Article 86, Local

Rule, Patent Act). Note that the documents may be delivered via air mail. In addition, in cases where it is clear that it usually takes more than three days to arrive if otherwise by a method other than air mail and the documents are not delivered via air mail, it shall not be deemed to arrive within the deadline for submission (Paragraph 3).

(b) Suspension of postal service

Where an applicant submits documents with regard to international applications to the Commissioner of the Korean Intellectual Property Office and the documents fail to arrive within a deadline for submission due to suspension of postal service as a result of war, revolution, riot, strike, natural disaster or other similar accidents in the locality or a place of stay belonging to an address or a place of business of applications or its power of attorney, applications may submit evidence to the Commissioner of the Korean Intellectual Property Office. Submission of evidence shall be made within one month from the day that an applicant is aware of the delay of the document arrival or the day that he could have been aware of the fact if he had paid considerable attention, but it shall be submitted within six months from the expiration of a deadline for submission of the documents. Where it is deemed that the reason the documents failed to arrive within a deadline for submission arrival was due mainly to delay by the postal service as seen from submitted evidence, an applicant may prove he delivered the documents within five days of recovery from the postal service, the documents shall be presumed to be submitted within the deadline for submission.

B. Succession of effect

The effects of a patent-related procedure or other a patent-related right extends to the successor in title. The effects of the procedure includes not only the effects of the procedures that a party initiates to the Korean Intellectual Property Office but also the general procedures the Korean Intellectual Property Office initiates to a party.

C. Continuation of the procedure

Where a patent-related procedure continues in the Korean Intellectual Property Office or Intellectual Property Tribunal and application for transfer of a patent-related right is made, the Commissioner of the Korean Intellectual Property Office or a presiding trial examiner may continue its procedure for a patent-related right with its successor and with the notification to the party in a written form.

## 2. Invalidity of the procedure

Invalidity of the procedure occurs when the procedure effective retroactively loses its effects of a patent-related procedure initiated to the Korean Intellectual Property Office

or Intellectual Property Tribunal due to defection from regulation. The Patent Act prescribes the provisions related to the amendment of defective procedure within a period ruled by the Commissioner of the Korean Intellectual Property Office or the President of the Intellectual Property Tribunal. If the defect fails to be amended within a certain period of time, the Commissioner of the Korean Intellectual Property Office or the President of the Intellectual Property Tribunal shall, in its own discretionary administrative act, make a decision to invalidate the procedure.

#### A. Subject of amendment order

- (1) In violation of the provisions of Paragraph 1, Article 3 of the Act (capacity of Minors, etc) or Article 6 (the scope of power of attorney)

In cases where an incompetent person without capacity such as minors, person of quasi-competency or persons of incompetency, initiates a patent-related procedure without a legal representative for patent-related procedure, or an agent initiates a patent-related procedure of applications for patents abandonment, withdrawal of application, withdrawal of a request for a trial, local claim of priority or its withdrawal, decision to refuse a patent, a request for a trial for a decision to revoke a patent or refuse an application to extend the term of a patent right or a decision to refuse a patent or appointment of sub-agent without especially conferred power of the principal, the Commissioner of the Korean Intellectual Property Office or the President of the Intellectual Property Tribunal may order a procedural amendment by designating a deadline. If no such legal amendment is made within the designated deadline for legal amendments, the procedure may be invalid.

- (2) In violation of type

A patent-related procedure shall observe the provisions as prescribed by the Patent Act, and any violated procedure shall be ordered to amend. If no such legal amendment is made within a designated deadline of legal amendment, the Commissioner of the Korean Intellectual Property Office or the President of the Intellectual Property Tribunal shall make the procedure for amendment invalid.

- (3) In cases of not paying the fee

An applicant who initiates a patent-related procedure shall pay the required fee, however if the applicant fails to pay within the set period of time, the procedure shall be invalid. In cases where a person, not an applicant for patent, applies for examination and then amends the application and therefore adds claims for a patent, an applicant shall pay an application fee for examination per its increased claims for a patent. If the application fee for examination fails to be paid within set period of time, any amendment to the specification shall be invalid.

## B. Remedies for disposition of invalidity

(1) In cases where the Commissioner of the Korean Intellectual Property Office or the President of the Intellectual Property Tribunal invalidates a patent-related procedure due to failure to observe a designated deadline pursuant to the provisions of Paragraph 1, Article 16 of the Act results from probable reasons not belonging to the responsibility of a person who is ordered to amend, the invalidation may be revoked by the party's application within 14 days of extinguishment of the reasons. However, this shall not be applicable in cases where a year elapses after expiration of a designated deadline. A person who wants to apply for a revocation of invalidation shall hand in:

- ① documents approving reasons of laches,
- ② in cases where the procedure was initiated by an agent, the documents approving power of attorney shall be submitted to the Commissioner of the Korean Intellectual Property Office or the President of the Intellectual Property Tribunal.

(2) A person who receives an invalidation to a patent-related procedure by the Commissioner of the Korean Intellectual Property Office may bring an administrative trial or bring an action in the administrative court in opposition to its invalidation.

## 3. Subsequent completion of the procedure

In cases where a person initiates patent-related procedure and is delayed without following the procedural act during the specified act period, he shall lose the opportunity to take such act. However, it may be deemed harsh and unfair that the applicant lose such an opportunity due to "non-ascribable reasons." Therefore, the procedure that is not performed within a certain period can be subsequently be completed through remedies as prescribed by Article 17 of the Act.

### A. Reasons of subsequent completion

Subsequent completion shall be restricted to cases with "non-ascribable reasons of a person who has taken a patent-related procedure." These reasons include, not only natural disaster or force majeure, but any other reasons that could not have been avoided even if they paid utmost attention and with full capacity.

### B. Subject of subsequent completion

The period of subsequent completion under the Civil Procedure Act shall be restricted to a peremptory period as stipulated in the provisions of a legal period, and the rest of the period shall not be subject to a subsequent completion. Where for the same purpose, a person who has taken a patent-related procedure fails to observe due to non-ascribable

reasons a request for a trial period prescribed under Article 132-3, the application period for reexamination prescribed under Paragraph 1, Article 180 of the Patent Act, the subsequent completion may be admitted.

#### C. The procedure for subsequent completion

An applicant shall apply for a subsequent completion within 14 days of extinguishment of the reasons. However, the application must be within one year following expiration of its original period. A person applying for it shall submit:

- ① documents approving reasons of laches,
- ② where the procedure was initiated by an agent, the documents approving power of attorney shall be submitted to the Commissioner of the Korean Intellectual Property Office or the President of the Intellectual Property Tribunal.

### 4. Suspension of the procedure

Suspension of the procedure may occur and may be differentiated from when a procedure is substantially stopped as a result of applying for an extension of a patent term. Suspension of the procedure shall be needed in cases where a party might not be able to participate in the proceedings of procedure if the Korean Intellectual Property Office or Intellectual Property Tribunal continues regardless of the death of the principal, the merger between legal entities, extinguishment of the power of attorney, and so forth which makes a party incapable of carrying out the procedure. Suspension of the procedure consists of interruption of the procedure and suspension of the procedure. Interruption of the procedure means that proceedings of a legal procedure is stopped until a new party shows up and performs where a party may not be able to perform the procedure due to certain reasons.

Suspension of the procedure is logically stopped due to legal reasons or the Korean Intellectual Property Office decides the procedure should be stopped in cases where the Korean Intellectual Property Office or Intellectual Property Tribunal encounters unexpected issues that may impede proceedings. Accordingly, if reasons for interruption of the procedure occur, a person who carries out the procedure may be accompanied by a replacement. On the other hand, in cases of a suspension of the procedure, a person who carries out the procedure may not be accompanied by a replacement.

#### A. Interruption of the procedure

##### (1) Reasons for interruption

Interruption of the procedure may occur due to the following legal reasons.

##### (a) In the case of the death of the principal

Where a party dies in the process of the procedure, or is presumed to be dead based upon a missing report, the procedure is interrupted until a successor takes over the

procedure. A qualified successor shall be a person who should continue the procedure by succession as a property manager or the person who can continue the procedure as pursuant to the Act. However, a successor shall not resume its procedure until the successor abandons its succession. Accordingly, where a successor abandons succession within a deadline for abandonment, the procedure will finish without interruption.

(b) In the case of extinguishment of the principal or legal entities due to a merger, the procedure shall be interrupted. However, in the case of liquidation of a legal entity due to reasons other than a merger, an interruption shall not occur since a liquidated legal entity still exists. Accordingly, rights and obligations of a legal entity shall be interrupted where a legal entity is newly established pursuant to the Act. A legal successor shall be a new legal entity in cases where a new legal entity is established due to a merger.

(c) Where the principal loses capacity to initiate the procedure

A party may lose capacity to perform actions where he is adjudicated to quasi-competency, incompetency, or a loss of mental capacity. Accordingly, a person or a legal representative who recovers competency to initiate the procedure shall resume its procedure.

(d) In cases of the extinguishment of a legal entity of the principal due to a merger

A party shall not alter itself. However, the procedure shall be interrupted in cases where power of attorney is lost in cases of the death of a legal representative or suspension of in-service execution, and a party or a legal representative who recovered competency to initiate the procedure shall resume its procedure.

(e) In the case of the termination of the duty of trust of the principal

This refers to the termination of the duty of the principal as pursuant to the Trust Act where a new trustee shall resume the procedure.

(f) In the cases of the death of a common representative or loss of its qualification as prescribed under Paragraph 1, Article 11

In cases of reporting a common representative to the Korean Intellectual Property Office, a representative shall only initiate the procedure. However in cases of the death of a representative or loss of qualification, the procedure shall be interrupted, and a new representative or each party shall resume the procedure.

(2) Exceptions to interruption

Except for the above reasons for interruption of the procedure, the proceedings of procedure shall continue without extinguishment of its power of attorney in order to protect a profit of a successor in cases where there is an agent to a party who triggered an interruption. Since an agent may become an agent of a new party without the procedure for resumption,

the procedure for litigation shall not be interrupted for the above reasons of interruption.

(3) Settlement of interruption

Interruption of the procedure may be solved by application for a resumption by a party or resumption order by the Commissioner of the Korean Intellectual Property Office. Once solved, proceedings shall resume.

(a) Without taking the procedure for resumption

An application for a resumption of a procedure may be utilized by a successor of a party who has reasons for interruption or the person who precede the successor. This promotes swift procedural performance by enabling an application for resumption for the other party. The Commissioner of Korean Intellectual Property Office or a presiding trial examiner shall inform the other party of the application, and determine whether it is resumed or not. The presiding trial examiner shall dismiss the request *ex officio* by decision after examining the request.

(b) Resumption order

The Commissioner of the Korean Intellectual Property Office or the trial examiner, in cases where the person as prescribed by Article 21 of the Act fails to resume an interrupted procedure, may *ex officio* determine a designating period of resumption to carry out the procedure. In the case of failure to resume the procedure within a set period as pursuant to a resumption order of the Commissioner of the Korean Intellectual Property Office or the trial examiner, it shall be presumed to resume on the following day after expiration of its period. In this case, the Commissioner of the Korean Intellectual Property Office or a presiding trial examiner shall notify the fact of resumption to the person as prescribed by Article 21 of the Act.

(4) Effect of interruption

In cases of interruption of a patent-related procedure, the act of carrying out the procedure shall be invalid. Proceedings of all periods shall resume upon the delivering of a notification of resumption or continuation. In short, proceedings of a period prior to interruption shall be ignored and shall be deemed that a party resumes its procedure from the beginning.

B. Suspension of the procedure

(1) Reasons of suspension

(a) Natural suspension : In cases where the Commissioner of the Korean Intellectual Property Office or the trial examiner shall not be deemed to continue its in-service duties on account of a natural disaster, an extraordinary geographical phenomenon or other unavoidable reasons, the pending procedure in the Korean Intellectual Property Office or Intellectual Property Tribunal shall be suspended until extinguishment of these events,

and the Commissioner of the Korean Intellectual Property Office or a presiding trial examiner shall inform such fact to each respective party.

(b) The Commissioner of the Korean Intellectual Property Office or the trial examiner, in cases where a party is unable to continue the pending procedure in the Korean Intellectual Property Office or Intellectual Property Tribunal due to an unfixed period of disability, may determine its suspension by an order, and once the cause of the suspension is solved, suspension may be revoked. In cases of suspension or revocation, the Commissioner of the Korean Intellectual Property Office or a presiding trial examiner shall inform such fact to each respective party.

(c) The procedure might be suspended in relation to other procedures.

A procedure for the examination might be suspended until oppositions to the grant of patents are finally determined, a trial decision is made, or the procedure for litigation is completed if it is deemed necessary to the examination of applications or oppositions to the grant of patents. If it is deemed necessary to a trial, a procedure for the examination might be suspended until oppositions to the grant of patents related to the trial case are determined, a trial decision of the other trial is made, or the procedure for litigation is completed.

(2) The effects of suspension

In the event of a suspension of a patent-related procedure, procedures of its period shall stop and procedures of all period shall resume as of the day when a party notifies resumption of its procedure or continues its procedure.

## V. Publication

### 1. Meaning

Publications are public bulletins issued by the Korean Intellectual Property Office to inform the public of patents-related matters or patents (Article 221 of the Act). Publications shall be issued as either “Publication for registration public bulletin” or “Pre-Grant Publication” for convenience of record keeping (Article 19, Enforcement Decree, Patent Act).

### 2. Publication for public notification of registration

Publication for public notification of registration shall include the following matters (Paragraph 2, Article 19, Order).

- ① name and address of a patentee (in the case of a legal entity, its title, a place of business)
- ② applications number, classification symbol and application date

- ③ inventor's name and address
- ④ patents number and registration date
- ⑤ public notification of registration date
- ⑥ matters regarding claim of priority
- ⑦ matters regarding dual applications or divisional applications (amendment 2003.6.13)
- ⑧ specification, drawing and abstract attached to application form for patents
- ⑨ laying open of application number and publication date
- ⑩ provisions corrected as pursuant to the provisions of Article 77, Article 133-2, Article 136 and Article 137 of the Act
- ⑪ any other matters deemed necessary by the Commissioner of the Korean Intellectual Property Office

### 3. Pre-Grant Publication

Pre-Grant Publication shall include the following matters (Paragraph 3, Article 19 of the Order). However, the matters that may disrupt public order or morality or harm public health shall not be disclosed.

- ① name and address of a patentee (in the case of a legal entity, its title, a place of business)
- ② applications number, classification symbol and application date
- ③ inventor's name and address
- ④ laying open of an application number and publication date
- ⑤ specification, drawing and abstract attached to application form for patents
- ⑥ matters regarding claim of priority
- ⑦ dual applications or dual applications with respect to matters(amendment 2003.6.13)
- ⑧ the fact of application for examination under Paragraph 2, Article 60 of the Act.  
However, in cases when its fact is not disclosed at the time of the laying open of an application, publication number of applications, classification symbol and applications number shall be disclosed on Pre-Grant Publication with the fact of its application for examination.
- ⑨ the purpose that "anybody shall be able to submit to the Commissioner of the Korean Intellectual Property Office the information that the invention shall not be patentable with an evidence approving the fact" in cases of publication of applications under the provisions of Article 64 of the Act
- ⑩ matters related to other applications publication

### 4. Effect disclosed in the Pre-Grant Publication

Where the matters of an application are disclosed through Pre-Grant Publication, a party shall have a claim for compensation (Article 65 of the Act) with which he shall be able to apply for compensation to be rewarded for a loss as a result of a business

without a just title and “first-to-file” position of the third party. In addition, the third party may submit to the Commissioner of the Korean Intellectual Property Office the purpose that the invention shall not be patentable with evidence approving of the fact.



TABLE OF CONTENTS ::

## **CHAPTER 3**

### **PATENTS INVENTION**



- SECTION 1  
PATENTABLE INVENTION
- SECTION 2  
REQUIREMENTS FOR PATENTABILITY
- SECTION 3  
PATENTABLE SUBJECT MATTER



## CHAPTER 3 PATENTS INVENTION

### SECTION 1 PATENTABLE INVENTION

#### I. Meaning

Invention means to create a new thing by using one's knowledge, including, but not limited to the production of a new method, technology, material, or appliance through scientific and technological creativity.

However, not all inventions may be protected as patents. Only patentable inventions prescribed by the Patent Act shall be protected as patents. Inventions which may disrupt public order, corrupt morality, or harm public health shall not be patentable.

#### II. Requirements for an invention

As patent systems have gradually become uniform due to multi-national treaties, Patent Acts of most countries have focused on international harmony. Only a few countries in the world have defined concepts of invention through their Patent Acts. If we applied the concept of invention in the Patent Act, we could apply the provisions of the Act more clearly. It is difficult, however, to implement a strict concept of invention to various highly skilled and modern scientific technologies.

Regardless of such pros and cons, the Korean Patent Act, in order to promote clarity, defines an invention as a: "highly skilled thing as a technological creation of ideas using the law of nature" under Paragraph 1, Article 2 of the Act' this seems to be based upon the definition of Aller Kohler.

##### 1. Utilization of the law of nature

###### A. Law of nature

"Law of nature" refers to a certain unchangeable and unavoidable law taking place in the natural world that is the reason for the occurrence of a phenomenon in the natural world. This may include laws such as the law of gravity, the laws of thermodynamics, and the law of energy conservation. On the contrary, laws contrived or discovered through the intellectual activities of human beings, academic laws, or artificial regulations and so forth shall not be included in the laws of nature.

## B. Utilization of the law of nature

“Laws of nature” are not subject to discovery or invention. However, note that, in order to become an invention under the Patent Act, it is apparent that an invention will be governed by a “law of nature”. One salient example against the law of nature is the non-repetitive permanent exercise substance premised on permanent exercise.

To make use of the law of nature means to apply the law of cause and effect in the context of natural science. Utilization means that the whole of the law is used rather than just a part in an invention.

In addition, an invention shall have applicability and repetitiveness; that is, the invention uses unavoidable laws of nature. Therefore it may be repeated and expropriated by a third party under the same conditions. However, 100% certainty of repetitiveness is not required. Less than normal rates of repetition for pioneer inventions are allowed. If the invention’s repeatable success is extremely low but it is deemed fairly certain to be attainable at a certain level, it may be deemed as having repetitiveness.

Even though an inventor is not fully aware of all laws of nature that he is making use of with his invention, the invention, if proved to use laws of nature in the end, shall be deemed an invention for purposes of the Patent Act even though the invention may be created without any recognition of the laws of nature.

As far as laws of nature are concerned, there is a debate in the intelligence information era of the 21st century regarding new technology in the field of computer software and Business Method (BM) patents. Software includes, but is not limited to, a system plan, flow chart, or a manual that discloses a method of how to use a computer as a system that creates and operates a program. A program means a combination of command language for conducting data processing in the computer whether it is in use of any laws of nature or not.

A program is considered similar to calculating a formula. As an expression of man’s intellectual process in the existing law, application for a program itself is rejected on the basis of not utilizing a law of nature. Examples of rejected applications for programs include cases where the program is a method or a device that increases or controls the capacity of hardware as a distinguished type of hardware and apparatus or media that is capable of computer decoding.

In addition, BM patents belong in the category of computer software related inventions. They are combined as operating methods and computer technologies on the internet to protect various operating methods or business ideas with patents operated through the internet. At present, pure business models conducted by social norms, mutual agreements, human psychological judgment or administrative authorities’ action due to artificial determination shall not be admitted as a law of nature invention. If a software application program is realized in combination with hardware using internet, it shall be deemed to use a law of nature.

## 2. Technical idea

### A. Technology

The dictionary defines technology as “a method or means which applies the theory learned academically.” This definition includes talents or crafts in technical art. In the natural science field it means, “a method or means that applies science to allow mankind to improve the nature for their living.” This second definition of technology includes technology in the human and social science fields, as well as in the natural science field.

However, “technology” under the Patent Act is restricted to technology using laws of nature with concrete means with demonstrating applicability and repetitiveness. It means that with this technology any third party having an average of level of understanding in the technological field will be able to attain the same result. In addition, there needs to be objectiveness of technology in the sense that ability, performance technology, and each technique in sports are not included in various technologies under the Patent Act.

### B. Technical idea

Invention shall be a technical idea. The term “idea” means an abstract Idea or a concept rather than a concrete shape. “Technical idea” means a specified idea that has not attained a technical level that would allow it to be concretely applied industrially. In other words, it means an intangible concept existing inside the shape combined via technological means. If, for example, the inventor designs a vehicle for carrying coal in a circular cone in order to level center of gravity, the design would be deemed an idea to level the center of gravity, not the shape of a circular cone itself. Otherwise, a patent to protect the invention would be an empty right.

In addition, technical ideas shall not be abstract, but concretized and shall be applicable in the future. Accordingly, in a case where there is a theme or conception without a concretization problem-solving method or it is deemed to attain its goal with such method regardless of there being a problem-solving method, it shall be deemed as an incomplete invention.

## 3. Skillfulness of creation

### A. Creation

Invention shall be a “creation” of a technical idea. A “creation” is different from a discovery. A creation is something that never existed before while a discovery is making known something that had already exist. As a matter of fact, “invention of use” discovers a specific property of a material and its exclusive use is based upon discovery of the property of the material and is included in the category of invention distinguished from a simple discovery that is recognized directly from the five senses of the body.

Although there are many arguments over whether creativity should require newly-emerged novelty or non-obviousness, such requirements have no advantage where patentability judgments are based on novelty and inventive steps. Accordingly, even though novelty is not included when objectively judged, the invention which is deemed creative by a party shall be deemed an invention anyway.

#### B. High skillfulness

According to the definition of invention, to invent a creation, such creation shall be “highly skillful”. However, “highly skillful” (high skillfulness) is judged not by objective criteria but by a subjective criteria; this traces back to the intention that distinguishes invention under the Patent Act from that of the utility model from the Utility Model Act. In short, utility design omits the term of “highly skilled” as seen in the context of “using the law of nature technological creation of ideas.”

#### 4. Relation between invention and discovery

Invention and discovery share requirements of introduction and application of novelty. However, invention is a creation by novelty whereas discovery is finding all or part of whole that have existed before.

Nonetheless, discovery creates many inventions. Inventions tend to promote new discovery. In particular, the biggest problem between invention and discovery for patents in practice is the requirement for its use and application.

Invention of use means “invention attributed to a new discovery of specific use belonging to the material.” Therefore, patentability is deemed admitted where it is recognized that the material is found to have a new use that has not been known in the electric or mechanic field unlike other fields such as the chemical field since its material property is multifaceted. Accordingly, invention of use means an “invention of the materials applying a new use to an originally non-patentable material.”

### III. Types of invention

#### 1. Categories of invention

Invention is classified into invention of material and invention of a method pursuant to specifications of such invention. “Invention of material” means concretization of a technological creation of ideas to give it a shape, including, but not limited to, product, apparatus (mechanics, device, facility, etc), creation and material. On the contrary, “invention of a method” means concretization of technological creation of ideas into a certain method, and is classified into a method to produce material and another method. The categories of invention shall not be interpreted just by words of claim of the patent but also by the substantiality of invention.

A method of material and invention of a method are different in the effect of a patent right pursuant to its inventive expropriate type (Act Article 2-3, Article 94).

## 2. Invention of material

Invention of material means concretization of a type of material, an invention without having a lapse of a time limit. Among them, invention of product or apparatus means concretization of a tangible type, which combines elements forming space and takes a technological effect. On the other hand, invention of material means a single element material manufactured by a chemical method or a nuclear transformation method.

## 3. Invention of a method

Invention of a method is affected by the lapse of a time limit, and its constituent elements are a pre-arranged stage for expropriating its method. Invention of a method under the Patent Act is classified into a method producing the material and other methods, such as use and handling.

## SECTION 2. REQUIREMENTS FOR PATENTABILITY

Even if an invention meets the definition of invention in Article 2.1 of the Patent Act (“the Act”) that says an “invention means the highly advanced creation of a technical idea using the laws of nature”, it still has to meet the requirements of industrial applicability, novelty and inventive step prescribed in Article 29 of the Act in order to be granted protection as a patent under the Act.

### I. Industrial applicability

#### 1. Meaning

Since the purpose of Patent Act is to contribute to industrial development, in order for an invention to be patented, it has to have industrial applicability. Thus, an invention which cannot be used industrially or which can only be used in areas other than industry cannot be patented.

#### 2. Scope of industry

Article 1.3 of the Paris Convention for the Protection of Industrial Property interprets industrial property in the broadest sense and shall apply not only to industry and commerce proper, but likewise to agricultural and extractive industries and to all manufactured or natural products. Also, Article 33.4 of the Patent Cooperation Treaty provides that

“industry shall be understood in its broadest sense, as in the Paris Convention for the Protection of Industrial Property.”<sup>1)</sup> Therefore, “industry” in Article 29.1 of the Patent Act is generally interpreted as including not only primary or secondary industries such as agriculture, stock-farming, forestry, fishery, mining and manufacturing but tertiary industries such as commerce, finance, transportation and service industry.

Some argue that service industry is excluded from “industry” mentioned above because it includes little technical idea using the laws of nature, but the general reasoning of opposition is made on the ground that with industrial development in mind, the scope of protection is ever being expanded to include business models. However, inventions in the medical area are treated differently because they deal with the human body.

### 3. Applicability

With respect to the concept of industrial applicability, there are various theories: an invention has to be suitable to use in industrial management; an invention which can only be used academically or experimentally is excluded; an invention has to be a technology directly related to manufacturing of goods; etc. It would be reasonable to exclude only the invention which in its content is not actually applicable to the industrial field or which is purely academic or experimental.

Article 33.4 of the Patent Cooperation Treaty provides, “for the purposes of the international preliminary examination, a claimed invention shall be considered industrially applicable if, according to its nature, it can be made or used (in the technological sense) in any kind of industry.” Industrial applicability is a requirement for a patent because the purpose of Patent Act is industrial development through technological progress and thus if industrial applicability is lacking, then it should be excluded. Since an invention only needs to have applicability in any industry other than medicine, industrial applicability is rarely an issue as a condition of patent.

### 4. Medical service

Medical industry, which is engaged in the treatment, examination and prevention of human disease, includes drugs for treatment or prognosis and methods of treatment, prognosis and operation using drugs and related medical equipment. Among them, drugs and medical equipment are patentable but medical methods dealing with humans are not.<sup>2)</sup> The reason is that medical method is about what a doctor does with respect to the patients’

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1) Article 33(4), PCT-“Industry” shall be understood in its broadest sense, as in the Paris Convention for the Protection of Industrial Property’

2) Types of industrially applicable inventions (See the Examination Guideline of KIPO)

① Invention of a method to operate or prognose human being, i.e., medical treatment, is not industrially applicable. However, products to be used for such invention (medical equipment, drug, etc.) are industrially applicable.

lives and exercising patent at the expense of the patients' lives is ethically unacceptable. Also, since drugs and medical equipment are patentable, inventors are protected accordingly and doing otherwise will raise medical cost.

The Patent Act does not directly mention inventions of medical methods dealing with the human body but Articles 29.1, 32 and 96.2 applies to this issue in practice. That is, an invention of a medical method dealing with the human body is not patentable on the ground that it is not "industrially applicable" (Article 29.1) and against public policy (Article 32). Also, patent for invention of drugs manufactured by combining two or more drugs or invention of method for such manufacturing does not cover prescription activity or prescribed drug provided for in the Pharmaceutical Affairs Act. (Article 96.2)

KIPO's Industry Sector Examination Standards (Medical Sector) recognizes as industrially applicable, invention of a method to treat, prognose or prevent disease of mammals except humans or promote their growth. On the other hand, with respect to an invention on human body wastes, invention of method in which substances are applied to human body, excretion or blood are extracted and drugs are made from them, and an invention in which drugs are made from what is already collected, removed, discharged from human body such as blood, serum, urine, feces, sap, placenta, tumor, hair and nail are recognized as applicable to industry. However, invention of method in which drug ingredients are made inside human body using body specific material or method in which such drug ingredients are extracted outside are not recognized as applicable to industry.

Among other countries, Japan has the same provisions as those of the Patent Act and Examination Standard regarding invention of medical methods, while Article 52.4 of the European Patent Convention denies patent to "methods for treatment of the human or animal body by surgery or therapy and diagnostic methods practised on the human or animal body" from patentability, because these methods are regarded as not susceptible of industrial application.

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- ② Method to process what is extracted from human body (blood, urine, skin, hair, etc.) or method to collect data by analyzing those is an industrially applicable invention. However, if processing the above is on the condition that what is extracted is returned for treatment purpose to the person from whom it is extracted (e.g., hemodialysis), it is a medical treatment and thus not an industrially applicable invention
- ③ Method, even though it can generally be used to operate, treat and prognose human being, if it is stated in the claim to be restricted to animals, it is industrially applicable. (90 Hu 250 decision, Supreme Court, Mar 12, 1991)

## II. Novelty of invention

### 1. Meaning

The goal of the Patent Act is to promote the use of invention by making it public and thus to develop the industry. Since granting monopoly over an invention already known to the public may impede the industry, novelty of invention is the most basic requirement of patentability. How novelty is defined can have great influence on a nation's industry. Therefore, the definition may differ depending on different countries and eras.

Novelty in the Patent Act requires that an invention's technological creation be new in comparison to past technology or prior art and novelty is intended to exclude the same technology as prior art.

Article 29.1 of the Patent Act does not define novelty positively but provides that an invention that has industrial applicability has novelty unless it is publicly known or used or it is described in a distributed publication or published through telecommunication means.

### 2. Criteria for time and place in deciding novelty

#### A. Criteria for time

The criteria regarding time in deciding novelty is the time for filing an application for a patent.<sup>3)</sup> Thus, if a person announces and makes public an invention in the morning and someone else files an application for patent in the afternoon that same day, the invention lacks novelty. However, such a case is extremely rare.

#### B. Criteria for place

In the past, whether or not an invention was publicly known or used was decided only domestically while public notice by documentation or telecommunication was decided globally. With the advance of telecommunication technology, however, an invention known overseas other than by publication can easily be proved and if an invention publicly worked overseas can be patented domestically, it is against the purpose of patent law that an invention has to be new in order to be patentable. The Patent Act revised on March 3, 2006 denies patent for technology publicly known or used overseas.

Different standards apply in different countries in deciding that an invention is not novel because it is publicly known, have been used or published in some place. According to the revised Patent Act, an invention lacks novelty if before the filing of

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3) Order in time of the applications is based on the 'date.' (Article 36 of Patent Act)

the application the invention is publicly known, publicly used or published, domestically or overseas, or if the invention is publicly through telecommunication by means of internet websites operated by central or local governments or publicly funded research institutes in foreign countries or international organization and thus has become available to the public.

### 3. Cause of losing novelty

#### A. Publicly known invention

Public knowledge in Article 29.1.1 of the Act refers to the state in which the general public knows or is capable of knowing, and a publicly known invention is an invention not hidden. Being out of secret is enough to establish as a publicly known state; the number of people knowing is irrelevant. If an invention is disclosed to a person who is obligated to keep it confidential, it is not public knowledge. But if that person reveals it to a third person in violation of his duty, it can become public. Also if the above mentioned duty of confidentiality loses effect it will also become public, and if the person uses the invention, then the invention becomes a publicly used invention, making it difficult to distinguish between whether it is public knowledge or public work.

There are different opinions with respect to the issue of whether or not public knowledge requires 'actual' knowledge. Since it may be difficult to prove whether a third party 'actually' had knowledge, it would be reasonable to conclude that public knowledge is the state in which the general public is capable of knowing the invention. Cases on this issue hold that a thesis is not in the public domain at the time of printing, submitting to the university or approval by the thesis review committee unless it has already been made public. The thesis becomes public knowledge when it passes the committee and is then published and delivered to the public or to university libraries or distributed to many unspecified people so that the general public is able to access its content.

#### B. Publicly used invention

Publicly used invention provided for in Article 29.1 of the Patent Act means an invention which those skilled in the art used before the filing of the patent application that would thus make the invention easy to know about. That is, it is an invention which can be used easily and repeatedly without supplementing, adding or further developing the technical idea. Thus, even if an invention was used by a third party, the invention may be deemed to not have been publicly used if those skilled in the art was not able to easily know the contents of the invention. On the other hand, during the construction or at the opening ceremony of a factory in which machinery is installed, an invention

can be deemed a publicly used invention before the filing of the patent application if it was used in circumstances where the general public was able to know the content of the invention and measures to maintain confidentiality were not taken.<sup>4)</sup>

### C. Invention publicly known by documentation:

Article 29.1.2 of the Act provides that an invention described in a publication distributed in the Republic of Korea or in a foreign country before the filing of a patent application or inventions published through telecommunication lines as prescribed by Presidential Decree lacks novelty and thus lacks patentability as well.

#### (1) Concept of publication

Publication means document, picture, photo and other information-transmitting medium copied for the purpose of being opened to the public by a mechanical or chemical method such as printing.<sup>5)</sup> It also includes not only printed material but handwritten or type-written material. While some deny that microfilm, CD-ROM or disc is publication, it would be more persuasive to acknowledge them as publication, considering that, in today's information society, they transmit information as clearly and securely as traditional printed publications. Finally, although copies may differ from the regular publication in that copies of the original are custom-manufactured, for the purpose of determining novelty copies are considered publication as well.

A publication has to be intended for the public and excludes secret publications. However, not-for-sale or limited edition books can be considered publications if they are copied documents which are open to the public and which includes information.

#### (2) Distribution

##### (A) Meaning

Distribution means the state in which a publication is delivered so that it can be read or accessed by the public, but does not require that someone has actually read it.<sup>6)</sup> The courts hold that a publication is distributed once it has been registered for receipt by the library even if it has not been displayed on the bookshelf because by that time someone with interest is able to access the publication, enabling the general public to be aware of the content of the publication.

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4) See 99 Hu 6596 decision (Patent Court, Sep 21, 2000)

5) 98 Heo 1945 decision (Supreme Court, Sep 18, 1998)

6) 83 Hu 40 decision (Supreme Court, Dec 23, 1986)

## (B) Time of distribution of the publication

## 1) Where publication date is written

- A) If only the year is written, last day of the year
- B) If the year and month are written, last day of the month
- C) If the year, month and date are written, the date is presumed the publication date

## 2) Where publication date is not written

- A) If a foreign publication has a clear import date, it is presumed to have been distributed at a normal rate of time that is required to import into Korea before the import date.
- B) If another publication includes review, excerpt, catalogue, etc. of the relevant publication, the distribution date is presumed to be from the other publication.
- C) If a later edition of the publication has date of first edition written on it, that date is presumed to be distribution date. However, in the case of later edition, relevant parts of the first and later edition have to be same.
- D) If there are other plausible grounds, distribution date should be presumed from those.

(C) If the filing date and publication date are the same, unless the time of filing is definitely later than the time of publication, the invention does not lose novelty.

## (3) Described invention

Described invention means an invention whose content is described in a publication so that those skilled in the art are easily able to use it. For an invention to be described in a publication, at a minimum, what constitutes the invention has to be disclosed. Thus, if only a photo of an invention's exterior structure is shown, the invention is not considered to be described in a publication because the content of the invention is not recognizable.<sup>7)</sup>

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7) 98 Heo 1945 decision (Patent Court, Spe 18, 1998)

#### D. Invention publicly known on the Internet

##### (1) Meaning

With the rapid progress of IT technology, people can freely disclose information on the Internet but technical information disclosed on the Internet can fall under Article 29.1.1 of the Act only if proved or confirmed. Such information, however, did not belong to the distributed publication category of Article 29.1.2 of the previous Act so the Act was revised on February 3, 2001 to recognize ‘an invention made available to the public through electronic telecommunication lines prescribed by Presidential Decree’ as prior art, without separate proof and confirmation, like the invention described in a publication.

However, technical information published through telecommunication lines such as the Internet can easily be altered and is difficult to put a publication date and secure reliability. So, the revised Act prescribes reliable telecommunication lines, which include Internet, BBS, e-mail and other devices which can transmit and receive data through wired, wireless, electric or magnetic means.

##### (2) Relevant provisions

(A) In order for Article 29.1.2 of the Act to apply, relevant technology has to be published by telecommunication lines prescribed by Presidential Decree and the public has to be able to use it. Thus, an invention published on the KIPO intranet is not deemed open to the public for use.

(B) Telecommunication lines prescribed by Presidential Decree for the purpose of securing reliability of technical information published through telecommunication lines such as the Internet include telecommunication lines operated by: central, local or foreign governments or international organization; public school provided for in Article 3 of Higher Education Act or foreign public university; domestic or foreign public research institutes; a juridical person set up for the purpose of conducting patent information related task and designated and announced by the Commissioner of KIPO.

(C) Information published through telecommunication lines other than those prescribed by Presidential Decree is not prior art as provided for in Article 29.1.2 of the Act but can be prior art of publicly known technology as provided for in Article 29.1.1 of the Act, if its content and publication date are proved.

(D) ‘Invention available to the public for use’ is an invention which is open to the general public. Thus, invention inaccessible through common search engines or which has a password for login can be prior art only if the general public has access.

(E) If date of publication by telecommunication lines is not clearly indicated, in the absence of proof to the contrary, the information is presumed published on the last day of the year if only the year is indicated and on the next day of the last day of the month if the month and year are indicated.

#### 4. Determining novelty

##### A. Principle

In determining novelty of an invention, invention stated in the claim is examined to determine if it falls under each subparagraph of Article 29.1 of the Act by comparing it with the 'reference invention.' An invention is not novel if the reference invention (which corresponds one on one with the invention stated in the claim) meets all elements of the invention stated in the claim. Novelty is different from the inventive step requirement (where the invention stated in the claim is compared with the combination of multiple reference inventions). This is called the Single Source Anticipation Rule in U. S. patent law.

Also, in deciding identicalness which belongs in the novelty category, it is not acceptable to compare the reference invention and the claim of invention applied for the patent simply by expression or format stated. The two have to be compared on the basis of their essences of the technical idea inherent in the claim. Even if only 'part' of the technical idea is identical, unless the remaining part constitutes a separate invention, the two inventions are deemed to be identical.<sup>8)</sup>

##### B. Invention stated in the claim

(1) The determination of an invention should be based on what is stated in the claim.

(2) If the claim is clear, the invention will be acknowledged as stated in the claim and the terms in the claim shall have its usual meaning. However, even though the claim is clearly stated, if the terms in the claim are defined or explained in a separate description or drawing, the definition or explanation shall be considered.

However, just because an example of the sub-concept, which belongs to the concept of the terms in the claim, is included in the description or drawing does not mean they constitute the aforementioned definition or explanation.

(3) Even if the patent claim itself is not clearly stated, when the description or drawing renders the meaning clear, such description or drawing shall be considered when acknowledging an invention.

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8) 93 Hu 1940 decision (Supreme Court, Jun 9, 1995)

(4) What is stated in the description or drawing but not in the claim is disregarded in interpreting the claim.

(5) If the description or drawing does not render a claim clear, the invention stated in the claim is not acknowledged, and can be denied a patent on the ground that the scope of claim is not properly stated.

### C. Reference invention

#### (1) Publicly known invention

A publicly known invention is an invention known or knowable to the general domestic public before the filing of a patent application.

#### (2) Publicly worked invention

A publicly worked invention is one which is worked while the invention is known or knowable to the public before the filing of the patent application.

#### (3) Invention described in distributed publication

An invention described in distributed publication will include not only the invention described in publication but also what is extracted from that invention by those skilled in the art using common technical knowledge at the time of publication.

### D. Method of determining novelty

(1) Sameness and difference between the invention stated in the claim and the reference invention shall be collected by comparing elements of both.

(2) If there is no difference between the aforementioned inventions, then the invention stated in the claim will be deemed not to be novel. However, if there is a difference, then the invention will be deemed novel.

### E. Caution in determining novelty

(1) With respect to the claim including a statement which tries to specify a matter, if the invention stated in the claim and the reference invention are expressed in genus and species, novelty shall be determined as follows because an invention and the claim which the inventor claims as his invention have to match. That is, if the inventor claims a narrower scope than his invention, he is deemed to relinquish part of his invention; an inventor is not allowed to claim a broader scope than his invention as it is a violation of the principle of social contract.

(A) If the invention stated in the claim is expressed in genus and the invention stated in the reference invention is expressed in species, the former lacks novelty because the inventor is claiming more than his invention.

(B) If the invention stated in the claim is expressed in species and the invention stated in the reference invention is expressed in genus, the former is acknowledged novelty. However, if the latter can be extracted from the former using general technical knowledge at the time of filing the application, the former is denied novelty.

(2) Novelty has to be determined by comparison with a single reference invention, while an inventive step has to be determined by comparison with a combination of multiple reference inventions.

#### F. Examples where novelty is denied because of substantial identicalness

Novelty is not denied only in the case when an invention is identical to a publicly known and used technology. Courts hold that even if an invention derives from a prior, publicly known and used technology, when the similarity to publicly known and used technology is obvious and thus the invention cannot be deemed a new technology, novelty itself may be denied before the issue of inventive step is explored, including substantially identical inventions in the novelty category.<sup>9)</sup> Inventions are substantially identical if change in form, location, sequence, proportion or direction does not cause function or effect to change or if elements are divided or combined.

### III. Inventive step of invention

#### 1. Meaning

Inventive step<sup>10)</sup> is an academic concept that means the degree by which those skilled in the art<sup>11)</sup> cannot easily invent given the technical standard at the time of the patent application. A novel invention may lack inventive step and granting a monopoly protection to such invention, which belongs to the realm of free technology, is against the purpose of patent law; patent law's purpose is to promote technological progress. Many countries, including Korea in Article 29.2 of the Act, impose this requirement, despite some differences in language.

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9) See 91 Ma 540 decision (Supreme Court, Jun 2, 1992)

10) Section 103 of the US Patent Act uses the term 'non-obvious subject matter,' while Article 56 of the EPC uses the term 'Inventive step.'

11) See 91 Ma 540 decision (Supreme Court, Jun 2, 1992)

## 2. Relevant provisions

Article 29.2 of the Act provides that “notwithstanding paragraph (1), where an invention referred to in each subparagraph of paragraph (1) (\*publicly known or used invention) could easily have been made before the filing of a patent application by a person with ordinary skill in the art to which the invention pertains, the patent for such an invention may not be granted.”

### A. ‘Art to which the invention pertains’

With the rapid progress of technology causing technological areas to specialize and segmentalize, more and more technologies are used in areas outside of their original purposes; sometimes these technologies are used by those skilled in the art of distant technical areas.

‘Art to which the invention pertains’ means in principle the industrial area to which the invention is applied but also includes the technological area which is grasped by the nature or function of all or part of the invention’s elements. Thus, it is not limited by the name of the invention which is stated in the description, but it means the area to which the technical idea, which is the essence of invention, belongs to; all in consideration of the purpose, constitution and effect of the invention as a whole. In practice, this means the technical scope of the relevant class in the International Patent Classification (IPC).

### B. ‘Those skilled in the art’

The criteria for determining inventive step are those skilled in the art in the relevant technical areas at the time of the patent application. ‘Those skilled in the art’ is an abstract concept, meaning an average expert who can understand common technical knowledge of the relevant technical area. Thus the patent examiner shall not determine inventive step subjectively but determine objectively from the perspective of those skilled in the art.

## 3. Theories on determination of inventive step

With respect to the method or criteria of determining inventive step, there are three theories which place emphasis on the purpose, constitution or effect of the invention respectively. Each theory has its own strengths and weaknesses so inventive step has to be determined considering the purpose, constitution or effect as a whole.

### A. Constitution centered theory

The purpose of an invention is the task an inventor intends to solve and the effect of an invention is the result, both of which are based on the inventor’s subjective

perception. Meanwhile, constitution of an invention is concrete, can be objectively grasped and must be stated in the claim thus contrasting the invention to prior art. This theory holds that in determining inventive step, difference in constitution between the invention stated in the claim and what is publicly known has to be grasped and depending on the difficulty in constitution, the purpose and effect of invention have to be considered. According to this theory, if an invention clearly lacks difficulty in constitution, it does not have inventive step despite the difference in purpose or effect, and if on the contrary an invention clearly has difficulty in constitution, it has inventive step even if the difference in purpose or effect is insignificant.

#### B. Effect centered theory

The purpose is the motive of invention; constitution is an instrument to achieve the task of the invention; and the effect which is achieved when constitution serves its purpose is the substance contributing to technological progress. Therefore, ease of selecting and combining elements of the invention has to be determined by the effect. That is, peculiarity of invention and remarkableness of effect have to be the criteria of inventive step.

#### C. Predictability theory

Invention is divided into stages. Stage one is where the purpose which is a technical desire to solve a task is established; stage two is where the technical means is constituted by selecting and combining the elements; and stage three is where the effect derived from constitution is actually verified. This theory holds that for each of the above stages, predictability of purpose, constitution and effect have to be the criteria for determining novelty. The theory also holds that the stages have to be treated equally.

### 4. Method of determining inventive step

Since invention protects the combined technical means of invention, inventive step determination is determining the difficulty of an invention's technical constitution and is subject to the examiner's discretion. However, the discretion must not be arbitrary but rather it must be objective thereby requiring that underlying facts be offered as proof.

#### A. Invention which is the object of inventive step determination

Invention which is the object of inventive step determination is an invention stated in the claim which has novelty. If there are two claims or more, inventive step has to be determined for each claim.

## B. Method of determining inventive step

### (1) Process of inventive step determination

First, invention stated in the claim is examined by the same method as in novelty.

Second, reference invention is examined by the same method as in novelty.

Third, invention stated in the claim and the reference invention are compared and sameness and difference are extracted therefrom.

Fourth, whether or not invention stated in the claim can obviously be derived by a technical standard in the relevant area at the time of patent application is articulated.

Fifth, if the above can be articulated, the invention lacks inventive step, but if on the contrary the above cannot be articulated, the invention has inventive step.

(2) In the establishing of logic, sameness and difference of the elements must be clarified by comparing the reference invention to the invention stated in the claim. Then the following must be examined. With respect to difference one must inquire whether or not the reference invention implies the invention stated in the claim; the commonality of tasks, use and function of the inventions can yield perspective of the motivation. Also, whether or not the effect of invention stated in the claim is better than that of the reference invention due to difference in constitution can yield perspective of how to determine inventive step. For example, even though the invention stated in the claim can be easily done by those skilled in the art from the combination of multiple reference inventions, if the invention stated in the claim has an unexpected and a new effect, then the inventive step may be acknowledged.

## C. Caution in the inventive step determination

Criteria for determining the inventive step provided by the Act are whether or not those skilled in the art can easily invent publicly known technology. This is very abstract, so in order to obtain objective validity, the following has to be considered.

(1) Most inventions are improvement inventions. They try to solve tasks or achieve a new and enhanced effect by combining publicly known elements, so when determining inventive step by combining two documentations or more, even if the elements are already known, whether or not the combination has technical difficulty has to be examined.

(2) If the invention stated in the claim uses as prior art a reference invention from different technical areas, objective validity such as the relationship between the areas, commonality in task solving and functional identicalness must be examined.

(3) If a publicly known or used technology<sup>12)</sup> is the main reason for rejection, then relevant documentation must be offered to the applicant as many as possible. Reference invention offered for determining novelty or inventive step does not have to be expressed clearly in its technical constitution, and although the invention is incomplete or is expressed unclearly due to a shortage of data, it can still be considered reference invention if those skilled in the art can easily grasp the content of the technology from the past.<sup>13)</sup>

(4) If invention of a matter itself has an inventive step, then invention of manufacturing method or use of the matter in principle has an inventive step.

(5) Invention stated in the claim must be examined as a combination of the whole. Just because each element such as elements of improvement invention or utility invention are publicly known does not mean that the invention stated in the claim lacks inventive step. But when elements of an invention are not systematically combined but simply compiled into a collection and there is no part of the invention that has an inventive step, then the invention will be deemed to lack inventive step.

(6) If favorable effect of an invention is not expressly stated in the description, then it cannot be considered in principle.<sup>14)</sup> However, if those skilled in the art can easily infer effect from the purpose or constitution of the invention, assertions about the effect in the submitted argument and evidence (test results or scores) may be considered.<sup>15)</sup>

## 5. Type of inventive step determination

### A. collective invention

A collective invention to which most inventions belong to is a collection of publicly known technology. A collective invention which lacks inventive step is called aggregation and a collective invention which has inventive step is called combination.

With respect to an invention which collects and combines past technologies and improves them, the Korean Supreme Court<sup>16)</sup> held that inventive step is lacking unless there is special hardship in the process of combining, the invention produces a greater effect

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12) 'Publicly known technology' is a technology which is generally known in relevant technical area, has a multitude of documentations and is so well known in the industry that examples need not be shown. 'Publicly worked technology' is a publicly known technology which is widely used.

13) 96 Hu 1514 decision (Supreme Court, Aug 26, 1997)

14) 96 Hu 221 decision (Supreme Court, May 30, 1997)

15) 98 Heo 8571 decision (Patent Court, May 20, 1999)

16) 96 Hu 221 decision (Supreme Court, May 30, 1997)

than expected from prior art, and those skilled in the art cannot easily invent, or a new technical method is added.

#### B. Replacement invention & conversion invention

Replacement invention replaces an element of a publicly known invention with an element of another publicly known invention in the same technical area. Conversion invention brings publicly known inventions from a different area and has inventive step only if there is a hard-to-expect effect or technical difficulty in constitution, from the perspective of those skilled in the art. Therefore, a replaced element has to be publicly known, be obvious to those skilled in the art and have substantially the same effect.

#### C. Use invention

Use invention is an invention derived from new discovery of certain specific use of a matter. Inventive step is acknowledged if the use is novel, effect is remarkably improved, and change of use is easy for those skilled in the art.

#### D. Utilization invention

(1) Utilization invention is, according to the common gist theory, which is the prevailing theory, an invention which has an additional element to be patented, a prior invention and that prior invention is patented. According to the courts,<sup>17)</sup> if prior invention and later invention have use relationship, then the later invention belongs to the prior one. In such a relationship, the invention of machine, equipment, etc, the later invention adds a new technical element to the gist of the prior invention. For invention of method, especially manufacturing of chemicals, intermediate substance or catalyst are added with the goal of interaction so it is very difficult to prove that a substance used in prior invention remains the same after the interaction. Also, in chemical manufacturing, use or non-use of a catalyst has a vastly different technical idea. Thus, between manufacturing method mentioning catalyst and patented manufacturing method not mentioning catalyst, even if they have the same starting and ending substance, the latter is not using prior invention unless use of catalyst is simply an addition to a meaningless process.

Also, recent Supreme Court and Patent Court rulings recognize utilization invention using equivalent material.<sup>18)</sup>

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17) 90 Hu 1499 decision (Supreme Court, Nov 26, 1991)

18) Supreme Court decisions 98 Hu 522 (Aug 21, 2001), 2001 Hu 393 (Sep 7, 2001); 2001 Heo 5466 decision (Patent Court, May 16, 2002)

(2) With respect to equivalence and use relationship, equivalence means the case where part of the elements of invention stated in the claim is replaced with another, equivalent element and the invention is deemed identical to prior invention. Equivalence is a matter of identicalness to prior invention, while utilization invention means an invention which includes all elements of the claim, adds additional element and is patented. Both belong in the scope of patent right of prior invention.

#### E. Selection invention

Selection invention means, in chemistry, an invention in which unspecified species are selected as an element of a publicly known invention of which all or part of the elements are expressed in genus. Here, species belong to genus and thus is the same as a known technology in principle but if invention in species is not detailed in a publicly known invention in genus, selecting the unspecified ones and combining them can bring about inventive step if there is a special effect that is unexpected from prior art.

Selection invention can belong to utilization invention because selection invention and publicly known invention expressed in genus have basic tasks and technical instruments in common and only have minor differences. But not all selection inventions have relationship of use, which has to be determined according to the scope and content of technology of prior application.

#### F. Number or form-restricted invention

This invention comes from limiting the number from a publicly known technology or changing or limiting form or arrangement. It lacks inventive step unless the change or limitation has technical difficulty or significantly increases effect of the invention.

Among them, number restricted invention is an invention expressed in numbers by specifying the length, weight, temperature, angle, combination ratio, etc. of the elements. Here, if the number is within a specific range provided by publicly known technology, then the invention lacks inventive step but if the publicly known technology does not provide numbers or provide different numbers, inventive step can be a contested issue. In such invention, if those skilled in the art use publicly known technology, they will set an optimal condition. So, unless there is something special about the numbers, the invention lacks inventive step because those skilled in the art could use it. In particular, effect of number restricted invention must not be expected from publicly known technology, so specifying the number must have technical significance and restriction must have critical significance in order to gain inventive step. However, specified numbers of the invention exceeding technical common sense does not have a particular critical significance.

## 6. Non-publicly known invention

### A. Meaning

Novelty is determined based on the time of the patent application so if the application is filed after an invention is made public, the invention loses novelty. However, under some circumstance where the person making an invention public and the person filing application are the same, the invention is deemed not to lose novelty. (Novelty deemed. Article 30 of the Act)

If Article 29.1 is applied too strictly without allowing exception, it can be harsh on inventors and harm industrial development, so certain inventions which have lost novelty are given relief by relevant provisions in order to protect inventors, unless they harm the general public.

In the past, when a person with the right to obtain a patent conducts tests on the invention, publishes the invention in printed matter, publishes the invention through telecommunication lines as prescribed by Presidential Decree or presents the invention in writing before an academic organization as prescribed by ordinance of the Ministry of Commerce, Industry and Energy, the invention was not denied patent. However, the revised Act (Mar 3, 2006) did away with restriction on the form of publication because publication form other than previously allowed, such as a website, increased in number and some products are launched and advertised in overseas market and thus not able to be patented. In sum, all activities by the applicant who makes the invention publicly known within six months prior to the filing becomes excluded from the grounds for rejection, starting with filings from March 3, 2006.

### B. Invention which can be deemed to have novelty

(1) When, pursuant to the intention of a person with the right to obtain a patent, the invention falls under either subparagraph (public knowledge, etc.) of Article 29.1, the patentable invention is recognized as being novel, as long as the patent application is filed within six months of the applicable date. However, if filing or registering is announced domestically or overseas, then according to the statutes or treaty, the above will not apply. (Article 30.1.1)

(2) When, against the intention of a person with the right to obtain a patent, the invention falls under either subparagraph (public knowledge, etc.) of Article 29.1, the patentable invention is recognized as being novel. (Article 30.1.2)

### C. Legal effect

#### (1) Relationship to novelty

An invention identical to a publicly known invention is not deemed novel.

#### (2) Relationship to inventive step

When an invention (A+a) differs from a publicly known invention (A), even if the latter is one which those skilled in the art can easily invent, the latter is not deemed a prior art. That is, an improvement invention is not placed at a disadvantage by a publicly known invention in terms of determining novelty but is used as prior art with respect to the invention of a third party.

### D. Submitting written evidence

In order to have relevant invention treated as non-public, a written application has to be filed to the Commissioner of KIPO simultaneously with the patent application. Documents proving the above have to be submitted to the same, within 30 days of the patent application. (Article 30 of the Act)

### E. Caution

(1) In Article 30, filing date for the invention not considered to be publicly known does not take effect retroactively and the invention is not deemed to have applied when novelty was lost. But, it merely deems the invention to maintain novelty of losing the novelty. A third party filing (except for forged filing) before the inventor has priority because of the first-to-file rule. Thus, it is best to file as early as possible.

(2) Article 30 only applies to applications filed within 6 months of public knowledge (domestic or overseas). Therefore, in order to claim treaty based priority and enjoy the benefit of Article 30, the application has to be filed in Korea within 6 months of public knowledge in the first country.

## IV. Identicalness of invention

Identicalness of invention is an important concept throughout patent law, and is an important standard in determining the issues of novelty, inventive step, expanded first-to-file, first-to-file and infringement. This section covers identicalness issues regarding expanded first-to-file and first-to-file only.

## 1. Expanded first-to-file application

### A. Meaning

The basic rule of patent law is ‘one patent for each invention’ in which a single exclusive patent is granted to a single invention. Where two or more applications related to identical inventions are filed on different dates, only the applicant with the earlier filing date may obtain the patent for the invention based on the first-to file-principle regardless of the actual time of invention. Thus, if two applications have identical inventions stated in the claim(s), a patent cannot be granted to the later application according to Article 36 of the Act. However, when an invention identical to the one stated only in the description or drawing of a prior application is stated in the claim(s) of a later application before the prior application or registration is made public, the later applicant, in principle, can be patented and this is problematic. In order to solve this, a later application stating in its claim(s) that the same invention stated in a prior application whose application or registration was published shall not be patented according to Articles 29.3 and 29.4 of the Act. Those articles apply by expanding the scope of prior application, and determining identicalness in the so-called expanded prior application.

### B. Relevant provisions

Where an application is filed for an invention that is identical to an invention or device described in the description or drawing(s) originally attached to another patent application that has already been laid open or published, or where the invention is identical to a utility model whose application has already been published, a patent may not be granted. However, if the inventor of the concerned patent application and the inventor of the other patent or utility model application are identical, or if the applicants of the above are identical at the time of filing, a patent may be granted.<sup>19)</sup>

### C. Requirements for application

- (1) In order for Article 29.3 of the Act to apply,
  - ① Filing time (or date for which priority is claimed) is later than that of the other (earlier) patent or utility model
  - ② The other (earlier) application or registration is published after the concerned (later) application
  - ③ Invention stated in the claim(s) of the later application is stated in the initial description of the earlier application
  - ④ Both inventions are identical

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19) Article 29.3 of the Patent Act

If the prior application is divisional or duplicated, the date of the divisional or duplicated application is deemed the filing date according to Article 52.2 or 53.2 of the Act. The reason for this is to prevent the filing date of divisional or duplicated application from moving back to the date of the first application whose description or drawing did not state the new technical items that are in the divisional or duplicated application.

If the prior application claims treaty-based priority, its filing date is the day on which patent application was filed in the first country.

(2) In domestic priority-based patent application, with regard to application of Articles 29.3 and 29.4 to prior and later applications,

- ① Invention stated in both prior and later applications: prior application prevails
- ② Invention stated in later, but not prior, application's description: later application prevails
- ③ Invention stated in prior, but not later, application's description: Articles 29.3 and 29.4 do not apply

(3) If earlier application is an international application designated for Korea

- ① Earlier application is published internationally
- ② Only when the invention stated in the claim(s) of the concerned (later) application is stated in the description or drawing of the earlier, international application, the earlier, international application shall rule

A later application has to be identical to the description or drawing of an international application filed on the day deemed as the international filing date according to Article 214.4 of the Patent Act or Article 71.4 of the Utility Model Act, or identical to the translation submitted or invention or utility model stated in the drawing on the day deemed as the international filing date according to Article 214.2 of the Patent Act or Article 71.2 of the Utility Model Act.

#### D. Exception

If prior application was filed before, but published (application or registration) after the filing of a later application and the two applications have the same inventors or applicants, then the issue of identicalness becomes moot.

Where all inventors as written in one application are completely or essentially identical to those of the other, both applications are deemed to have identical inventors. If inventors are not completely identical on paper, then the applicant has the burden of proof to show that the inventors are the same.

Furthermore, if there are two or more applicants, all the applicants have to be completely identical, and if the concerned application is an amended one, applicant of the original application shall be the applicant of the concerned application.

E. Determining whether or not invention stated in the claim(s) is identical to an invention or device described in the description or drawing(s) originally attached to another patent application

(1) Whether they are same or different is determined by comparing the invention stated in the claim and the reference invention. Two or more independent reference inventions shall not be combined when comparing.

(2) If there is no difference, the inventions are identical. Even if there is difference, when technical idea belongs in the same category and the difference in constitution simply comes from addition, deletion or conversion of publicly known technology, and no new effect is expected, then they are deemed essentially identical.<sup>20)</sup>

(3) In the claim(s) for a subject matter specified by work, function and nature, if the invention in the claim(s) is stated as genus including reference invention, and reference invention is recognized as species of the invention in the claim(s), then the inventions are deemed to be identical.

## 2. Prior application

### A. Meaning

Patent law provides the inventor with an exclusive right to use the patented invention for a certain period of time, in compensation for making the invention public. And in order to prevent rights from being overlapped, a single patent is granted for a single invention, which illustrates 'one invention, one patent' or 'exclusion of double patent' principles. With respect to the method of granting patents where multiple applications related to identical inventions are filed, there exist the first-to-invent rule and first-to-file rule.

#### (1) First-to-invent rule and first-to-file rule

First-to-invent rule protects the first inventor and is ideal for promoting invention, but it is difficult to confirm who the first inventor is. Sometimes an inventor keeps the invention a secret for his own interest and in such cases the rights of the concerned parties of the invention can be unstable. On the other hand, the first-to-file rule decides rights based on the date of filing and helps enhance stability of the rights surrounding an invention. It encourages patent applications and suits the purpose of the patent system but can burden the inventors because they have to promptly file.

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<sup>20)</sup> See 98 Hu 1013 decision (Supreme Court, Jun 1, 2001)

Currently, most countries adopt the first-to-file rule which values legal stability. Korea adopts the first-to-file rule which is provided in the Patent Act, “where two or more applications related to the same invention are filed on different dates, only the applicant of the application with the earlier filing date may obtain a patent for the invention.”<sup>21)</sup>

(2) Criteria for time in determining prior versus later application

(A) Principle

In deciding which application is the first, filing date is the standard. Documents submitted to KIPO take effect the day on which they arrive at KIPO (arrival rule; Article 28.1 of the Act). However, application, demand and other documents submitted by mail is deemed to have arrived at the time of mailing, which is an exception. In the mailing rule, where the date stamp is clear, they are deemed to have been delivered on the date of the stamp, while where the date stamp is unclear, they are deemed to have been delivered on the date on which the mail was submitted to a post office, if the date is verified by a receipt.

The arrival rule, however, not the above, applies if applications to register patent and other related rights and documents concerning an international application under Article 2(vii) of the Patent Cooperation Treaty (referred to as “an international application”) are submitted by mail.

(B) Exception

In the first-to-file rule, there are some exceptions with respect to filing date. In some cases it is deemed earlier than actually filed while in other cases it is deemed later.

(3) Same day application

(A) Where multiple applications related to identical inventions are filed on the same day, only the person agreed upon by all the applicants after consultation may obtain a patent for the invention. If no agreement is reached or no consultation is possible, none of the applicants may obtain a patent for the invention. (Article 36.2)

(B) Where a patent application has the same subject matter as a utility model application and the applications are filed on the same day, the same rule as above applies. (Article 36.3)

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21) Article 36.1 of the Patent Act

(C) With respect to multiple applications filed on the same day, the Commissioner of KIPO can order the applicants to agree to which applicant will file application within a designated time, and if the applicants do as ordered, the Commissioner shall proceed the examination process. However, if the applicants fail to do so, both applications shall be rejected. The applicant agreed to by the applicants must file application signed by all applicants, document proving the agreement, and a power of attorney documentation if necessary.

(4) Identical invention by identical inventor

With respect to multiple applications by a single applicant for a single invention, the same rule as above shall apply. If the dates are different, only the application submitted earlier will be patented, and if the dates are the same, the applicant will be ordered to choose one. If he fails to follow the order, all the applications shall be rejected. Where multiple applications by a single applicant for a single invention are all granted and subsequently one of them is finally invalidated, the remaining registrations are interpreted as valid.

(5) Object's scope for the prior application

In the application of Article 36 of the Act, regarding identical invention or device, some applications are prior applications and some are not.

Non-Prior Application

- ① Where application for patent or utility model is invalidated, withdrawn or abandoned, or where the decision to refuse patent is finalized, except when the ground is applicants' failure to agree provided for in Article 36.2 of the Act.
- ② An application filed by an applicant who is not a successor in title to the right to obtain the patent or utility model registration shall be deemed not to have existed.

Prior Application

- ① Application is granted
- ② Application is abandoned
- ③ Decision is made to refuse a patent, patent application shall be deemed prior application or become the object of discussion with respect to the subsequent application

B. Method of determining prior application

Articles 36.1 to 36.3 of the Act which deal with identical inventions of prior and subsequent applications concerns whether or not inventions stated in the claim are the same among applications with different or same filing dates or between patent applications and utility model applications, i.e., identicalness of inventions.

## (1) Object of determination

Object of identicalness determination according to Article 36 of the Act is the invention stated in the claim(s). Identicalness determination concerns the technical idea of the invention stated in the claim(s) according to the definition of invention. Where the patent claim(s) has multiple claim(s), identicalness is determined for each claim(s).

## (2) How to determine whether or not claims are identical

## (A) Acknowledging invention stated in the claim

Same method as in novelty determination

## (B) Comparison between inventions stated in the claim

If there is no difference, inventions are identical.

If the difference is

- ① Simply a matter of expression
- ② About purpose and effect but constitution is the same
- ③ About constitution but it is simply from adding, deleting or converting publicly known or worked technology and there is no new effect,

Inventions are determined identical

## SECTION 3 PATENTABLE SUBJECT MATTER

### I. Patentable subject matter

The person who can be granted a patent is an inventor or successor. An inventor can be granted a patent as long as the invention meets requirements of the Patent Act. Article 33 of the Act provides, “inventor or successor has the right to be patented according to this Act.”

#### 1. Nature of right to obtain patent

With respect to the nature of an inventor’s right to obtain a patent by making an invention, the following theories exist.

## (1) Public right theory

The right is a public right to request the state to grant patent. It is a property right and is assignable. This is an approach with emphasis on procedure.

### (2) Private right theory

The right is a natural right created by an act of invention itself. It is a private right preceding application and thus patent application is simply a procedure. This is an approach focused on substance.

### (3) Public-private right theory

The right is public in that the inventor can request the state for a patent but also private in that an act of invention creates an 'invention right', a private substantive right.

## 2. Content of right to obtain a patent

### (1) Specific content

Right to obtain a patent comes into being at the completion of invention and lasts until a patent right is created. It can be exercised by the inventor or successor, who can use, profit from or assign the invention without infringing on the rights of others.

(A) Inventors or successors can use the invention themselves or let others use it. However, the right to obtain a patent does not create an exclusive right to use the invention and the inventor is prohibited from exercising the right if doing so infringes on others' rights.

(B) The right is part of an inventor's right, a property right and assignable by the parties' agreement. A non-property right of an inventor is not assignable so the inventor can sign his name as "inventor" on the application.

(C) The right cannot be published. It cannot become the object of mortgage or pledge because the mortgagee/pledgee has no right of consent in the amendment of the description or drawing under the Act. However, 'transferring title for mortgage purpose' is not prohibited.

### (2) Transfer of right to obtain a patent

#### (A) Succession of right before patent application

Succession to the right to obtain a patent before filing an application is not effective against third parties unless the successor in title files an application (Article 38.1 of the Act), which is the same for inheritance or other general succession. Where the right to obtain patent is transferred to more than one parties (overlapping transfer), the first-to-file successor can be patented.

(B) Succession of right after patent application

Succession to the right to obtain patent after filing an application is not effective unless notification of change of the applicant is filed, except for inheritance or other general succession (Article 38.4 of the Act), in order to clarify transfer of right. Upon inheritance or other general succession of the right, the successor in title shall immediately notify the Commissioner of KIPO. (Article 38.5)

(C) Conflict among multiple patent applications or notifications of change of applicant, with same filing date

Where two or more applications are filed on the basis of the right to obtain patent derived by succession from the same person for the same invention on the same day, succession by any person other than the one agreed upon after consultations by all applicants is not effective. (Article 38.2)

Also, where two or more notifications of change of applicant are made on the basis of the right to obtain patent derived by succession from the same person for the same invention on the same day, notification by any person other than the one agreed upon after consultations by all persons who made notification is not effective. (Article 38.6)

Despite the KIPO Commissioner's order for consultation, if the parties do not report the result of consultation within the designated period, the parties are deemed not to have an agreement and no one can be granted patent on the invention which is the target of the concerned patent application or change of applicant notification. (Article 38.7)

(3) Restriction on transfer of right to obtain a patent

Where two or more persons jointly make an invention, they are entitled to jointly owning the patent (Article 33.2), and where a patent right is jointly owned, the owners may not assign their individual share without the consent of the other owners. (Article 37.3)

(4) Loss of right to obtain a patent

Where decision to refuse patent or opposition to such decision is finalized, if the successor to the right to obtain the patent does not exist or the party loses capacity to own a patent, the right to obtain patent is lost. The same goes for where patent application is abandoned or withdrawn.

## II. Holder of Right

The right to obtain a patent only belongs to the inventor and successor, which is the 'inventor rule'. Therefore, a patent application by someone other than an inventor or successor shall be refused (Article 62) and even if registered, can be the object of patent opposition (Article 69.2), invalidated (Article 74) or cancelled (Article 133). Nowadays, since many countries have a strong tendency to promote industrial development by protecting inventors, the 'inventor rule' is a global trend.

### 1. Inventor

An inventor is a natural person who actually made the invention. Invention is not a legal, but a factual act, so a person who is not able to conduct legal activity can still make an invention. Also, an inventor is one who directly participates in the creative act of invention, so a mere assistant, advisor or lender of money cannot be an inventor. An inventor also has a right to have his name stated in the application, other than being patented.

A juridical person cannot be an inventor. Article 42.1 provides that a patent application shall state the name and address of the applicant (and, if a juridical person, then the name and address of the business) and the inventor. An applicant needs only to state the name of the juridical person while an inventor has to state the inventor's name, meaning that an applicant may be a juridical person while an inventor has to be a natural person.

Also, where some of the inventors are omitted or erroneously stated in the patent application due to applicant's mistake, adding or revising is allowed until the time of decision to grant or refuse the patent. (Article 28 of Ministerial Decree)

### 2. Joint inventor

Where more than one person jointly makes an invention, they are entitled to jointly own the patent (Article 33.2) and all the joint owners shall jointly file patent application. (Article 44) According to the current law, if any joint inventor objects, remaining joint inventors cannot file application and if only part of the joint inventors participate in the application, the application shall be refused or, if granted, invalidated or cancelled.

Requirements for a joint inventor are same as for sole inventors, and a mere administrator, assistant or lender of money is not a joint inventor. Therefore, in order to be a joint inventor, one has to be an actual cooperator who directly participated in the conceiving or completing of the technical idea.

Employee invention and joint research and development (R&D) are main issues in the joint invention. In an industrial or academic-industrial joint R&D, it is difficult to decide the share of contribution made by each participant. Therefore, it is necessary to make an agreement by contract in advance. The Patent Act provides that where joint applicants have agreement on each applicant's share, they have to state so in the application and file to the Commissioner of KIPO along with a document proving there was an agreement. (Article 27 of Ministerial Decree)

### 3. Successor

The right to obtain a patent may be transferred by contract, inheritance or other general succession. (Article 37.1) This right can be transferred partially. The successor only succeeds to such right as a property right and the inventor's right to fame remains with him. So, the real inventor's name has to be stated in the application. Where the right to obtain a patent is jointly owned, each joint owner needs the consent of all other joint owners in order to transfer the right.

Regarding whether or not a successor can be deemed to have succeeded to the right to obtain an overseas patent, there is disagreement but the general interpretation is that unless otherwise agreed to, succession is limited to domestic patents due to the principle of patent independence. Therefore, a successor who wishes to be granted a patent overseas needs to put it in an agreement.

### 4. Prior applicant

An inventor naturally has inventor's right, which is included in the right to obtain a patent. However, a patent right is not automatically granted to an inventor but to the first-to-file applicant. Because of the inventor rule, a non-inventor cannot patent even if he is the first-to-file applicant.

### 5. Legitimate holder of right

#### A. Meaning

Non-right holder is divided into the fraudulent patent holder who is not a legitimate holder of the right to obtain a patent and the 'good faith non-right holder' who is a successor to the fraudulent patent holder. Note, however, that a non-right holder in Articles 34 and 35 includes both.

Patent application by a non-right holder shall be refused, cancelled or invalidated. However, although an application by a non-right holder can be refused or, if granted, cancelled or invalidated, the fact that an application was filed remains, which may hurt the application by a legitimate holder of the right. Thus, Article 34 protects applications

of legitimate holders who files while a non-right holder's application is pending, and Article 35 does the same after granting of a patent to a non-right holder.

#### B. Protection of legitimate holder of right

##### (1) Patent application by non-right holder and protection of legitimate holder of right

Where a patent application is not granted on the ground that it is filed by a non-right holder, an application by a legitimate holder of right filed thereafter is deemed to have been filed at the same time as the non-right holder. However, where application by the legitimate holder of right was filed after 30 days from the date when the non-right holder is decided not to be patented, the above shall not apply.

Therefore, where application is filed within the period designated by law, since the legitimate holder of right's application is effective retroactively, the legitimate holder shall have priority over a third person filing in between. "Date when a patent application is decided to be refused" is interpreted to mean the date when patent application is finally refused for lack of right and the KIPO notifies accordingly. It will also mean, the filing date of when a non-right holder files a written withdrawal or abandonment.

##### (2) Patent of non-right holder and protection of legitimate holder of right

Where a illegitimate holder of right's patent is cancelled in an opposition procedure or is finally invalidated in a patent tribunal on the ground that it is an application by an illegitimate holder of right, the patent application by the legitimate holder of right is deemed to have been filed. However, where a legitimate holder of right filed a patent application after two years from the patent registration by an illegitimate holder of right or after 30 days from the patent finally being cancelled, the patent application by the legitimate holder of right does not take effect retroactively to the date of application by the non-right holder.

#### C. Conditions for protection of patent application by legitimate holder of right

(1) Identical invention: Above all, inventions of a legitimate holder of right and illegitimate holder of right have to be identical.

(2) Application within certain period of time: Legitimate holder of right has to file a patent application within 30 days from the date when the patent application by the illegitimate holder of right is refused patent or, if granted, is finally invalidated or cancelled. Also, where registration of a non-right holder's patent is published, the legitimate holder's application has to be filed within two years from the publication.

(3) Filing application: In order for a legitimate holder of right to have his status acknowledged, he has to file a patent application with a document proving his right attached.

TABLE OF CONTENTS ::

## **CHAPTER 4**

### **PATENT APPLICATION**



- SECTION 1  
PROCEDURE OF PATENT APPLICATION
- SECTION 2  
AMENDMENT OF APPLICATION
- SECTION 3  
DIVISIONAL & CONVERSION APPLICATION
- SECTION 4  
PRIORITY



## CHAPTER 4 PATENT APPLICATION

### SECTION 1 PROCEDURE OF PATENT APPLICATION

#### I. Meaning

Patent application is an act of submitting an application by an inventor requesting the KIPO to make a patent decision, by which the inventor can be granted a patent. Copyright belongs to the creator *ab initio* from the moment of creation without any procedures or methods but, a patent is created by an act of the government. That is, an inventor has the right to a patent but he/she must apply for it and perform necessary procedures in order to be granted a patent. A patent application is an attempt to monopolize certain technology and has a big impact on people so it must be submitted to the KIPO in a physical or electronic document format prescribed by relevant laws, in order to prevent uncertainty about its content. Patent applications failing to meet such requirements can be refused a patent or be subject to disadvantage even after being patented.

#### II. General principles for patent application

Once a patent application is recognized legally and accepted by the KIPO, the application date and number shall be issued and a written notice of the application number shall be sent to the applicant. Submission of the application shall become effective on the date of the application's arrival at the KIPO.

##### 1. Writing requirement

Patent application shall be submitted by an application document, detailed description, drawing and abstract of the disclosure in a physical or electronic document format complying with relevant laws. (Patent Act, Article 28-3) Submitted documents shall be prepared separately per application unless otherwise provided by law, it will include the applicant's name (in the case of a juridical person, its name) and identification number (applicant code) and have the applicant's seal stamped. However, in the absence of an applicant code, it shall include the applicant's name and address (in the case of a juridical person, its name and place of business) and have the applicant's seal stamped. (Patent Act Enforcement Rule, Article 2)

In the application procedure, if necessary, it is possible to submit a sample. But, an oral explanation or submission of the sample cannot replace a written application. This writing requirement is in principle adopted in all procedures of KIPO or KIPT, as well as in patent applications.

## 2. Use of Korean mandated

Application documents have to be in Korean (Patent Act Enforcement Rule, Article 4.1) and if not, shall be returned as an illegal application. (Patent Act Enforcement Rule, Article 11.1) Attachments to the application, such as power of attorney, certificate of nationality or priority claim shall include Korean translations as well. However, among the priority claim document, detailed description and drawing of the invention, to the extent that they are identical to those attached to the application, do not have to include a Korean translation with a proper explanation. (Patent Act Enforcement Rule, Article 4.2).

## 3. Formalism

Patent application shall be submitted in accordance with the form provided by patent laws and if not, may be returned as an illegal application. (Patent Act Enforcement Rule, Article 11) Also, the applicant may be instructed to amend his/her application by the Commissioner of KIPO (Patent Act, Article 46) and if he/she fails to do so, the Commissioner may invalidate the application. (Patent Act, Article 16)

### III. Types of Application Form for Patents

#### 1. Application Form for Patents

A person who wishes to be granted a patent has to prepare a patent application in the form prescribed by Attached Form #10 of the Ministerial Decree to the Patent Act (“Ministerial Decree”), attach necessary documents and file them to the Commissioner of KIPO.

A. A patent application has to state the following. (Article 42.1)

- ① Name and address of the applicant (and, if a legal entity, the name and address of the business),
- ② Name and residential or business address of the agent, if any (and, if the agent is a patent legal entity, the name and address of the business and the name of the designated patent attorney),
- ③ Title of the invention,
- ④ Name and address of the inventor

B. The following has to be attached to the application.

- ① Description, abstract and drawing,
- ② Where an agent purports to represent a person who is initiating a patent-related procedure, the agent shall present written proof of the power of attorney.

- ③ Other written evidence required by the law: Evidence of invention not being considered to be publicly known (Article 30.2), Evidence of being a lawful right holder (Article 31.2 of Ministerial Decree), Written evidence of priority (Article 25 of Ministerial Decree), Written evidence of microbes being deposited (Article 2 of Presidential Decree to Patent Act), etc.

Where an agent, which in this Act includes patent administrators, purports to represent a person who is initiating a patent-related procedure before the Korean Intellectual Property Office, the agent shall present written proof of a power of attorney.

## 2. Specifications

The most important attachment to the application is the description, of which the ‘detailed explanation of invention’ functions as a technical documentation showing the content of the invention as a result of technological development, and the ‘claim’ functions as a title of right showing the technical scope to be claimed as a patent. In order to show content of an invention, the following has to be stated according to relevant provisions

- ① Title of invention,
- ② Brief explanation of drawing,
- ③ Detailed explanation of invention,
- ④ Patent claim

### A. Title of invention

This facilitates classification, investigation, etc. of the application and has to be stated concisely and clearly according to content of the invention

### B. Brief explanation of drawing

(1) In the patent application, a drawing is optional and ‘brief explanation of drawing’ is stated only when a drawing is attached to application. On the contrary, for an application for a utility model registration, which only concerns things, a drawing must be attached.

(2) What each drawing represents must be briefly stated (e.g. drawing #1 is a top plan view and drawing #2 is a cross-sectional view) and underneath that, names of marks for important parts of the drawing must be stated.

### C. Detailed explanation of invention

This explains the invention stated in the patent claim and functions as documentation of the invention. It must state, as prescribed by the Industry and Resources Ministerial Decree, the invention in such a manner that it may easily be carried out by a person

with ordinary skill in the art to which the invention pertains.<sup>22)</sup> (Article 42.3 of the Act)<sup>23)</sup> Violating this can be cause for a decision to refuse, and if granted, can invalidate a patent application.

(1) Explanation of terminology<sup>24)</sup>

(A) ‘Art to which the invention pertains’ is not limited to the technical area indicated by the title of invention but means the technical area objectively determined from the purpose and means of invention.

(B) ‘Person with ordinary skill’ is an average engineer with common technical knowledge in the relevant area at the time of the application who can freely employ general means and ability for R&D, obtain all the knowledge available at the time of application and belonging to the area related to the purpose of invention, and make them his own.

(C) ‘In a manner that it may be carried out’ requires that in the invention of things, the things to be manufactured and used, in the invention of method, the method be used, and in the invention of method of manufacturing things, the things be manufactured by the method. Invention is limited to that which is stated in the claim.

(D) ‘In a manner that it may easily be carried out’ requires that an invention be accurately understood and reproduced without employing excessive trial and error or by a complicated and sophisticated experiment by a person with ordinary skill in the art to which the invention pertains.

(2) Requirements for statement

(A) Task to solve

This is the motive of invention. Past technology related to applicable industrial area for the invention must be specifically stated and the task the invention is intended to solve by deriving problems of the past technology has to be clearly stated.

(B) Means of solution

Specific technical means to carry out the purpose of invention has to be stated along with its working. Technical means has to be stated clearly and specifically, and state examples of working which show how the invention is materialized.

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22) See 97 Hu 2675 decision (Supreme Court, Dec 10, 1999)

23) Patent Act revised Jan 3, 2007 abolished the provision requiring statement of purpose, construction and effect of invention, and required that invention be stated clear and detailed according to the Industry and Resources Ministerial Decree.

24) 1 Examination Guideline of the KIPO (Sep 1, 1998)

1) Technical means to solve a problem: Technical means to carry out the purpose of the invention and the connection between technical means must be stated specifically. However, a technical idea not directly related to the essence of invention need not be stated.

2) Function and working: Not only connection but also function and working of the technical means has to be clearly stated so that a third person can carry it out easily.

3) Examples of working: Specific examples need to be stated to allow a person with ordinary skill to reproduce the invention. And, stating more examples helps clarify the technical idea of the invention and interpret the scope of patent stated in the claim. When using drawings to explain examples, the invention can be clarified by noting ‘symbols of drawing’ in parenthesis.

(C) Effect of invention: Favorable effects, as compared to past technology, derived from combination of the technical means achieving the purpose of invention has to be stated. This can be an important criterion for determining inventive step.

Revised Patent Act (promulgated Jan 3, 2007 and taking effect Jul 1, 2007) abolished the division of purpose, construction and effect, and allowed stating detailed explanation of the invention in a method prescribed by the Industry and Resources Ministerial Decree.

#### D. Patent claim

Patent claim is a kind of title of right. An inventor publishes invention by ‘detailed explanation of invention’ in the description and the scope of patent. What the inventor obtains in return is determined by the patent claim. (Article 97) Thus, a patent claim has to include one or more claims stating the protection intended for, and the claims have to meet the following.

- ① Must be supported by detailed explanation of the invention
- ② Must be stated clearly and concisely

The Patent Act revised on January 3, 2007 abolished the requirement that a claim only state indispensable items in the construction of an invention.

### 3. Drawing

A drawing transfers an invention into picture in order to serve as a better understanding and is a supplement to description. Drawing can only be attached when necessary from the types of invention, so if it is not necessary or not able to be attached, as in a chemical material, it need not be attached. A drawing has to be prepared according to the guidelines prescribed in Attached Form #12 to Article 21 of the Ministerial Decree.

#### 4. Abstract

A. An abstract attached to a patent application may not be interpreted to define the scope of an invention for which protection is sought but it serves as technical information. (Article 43)

B. Abstract must be prepared in the order of **【summary】** , **【representative drawing】** and **【reference】** .

(1) In order to facilitate determining the content of invention, **【summary】** item shall state the following

- ① Technical area to which invention belong (about 30 Korean characters),
- ② Purpose of invention (about 80 Korean characters),
- ③ Construction of invention (about 250 Korean characters),
- ④ Effect of invention (about 50 Korean characters)

(2) If drawing is available, one shall be stated in the **【representative drawing】** item.

(3) Five to ten main reference terms related to construction of the invention shall be stated in **【reference】** item and if necessary, terms not included in description can be stated.

**[Attached Form #10] Patent application form**

**[Document]** patent application

**[addressee]** KIPO Commissioner

**[Filing date]**

**[international patent classification]**

**[Invention in Korean]** (Stated so that the whole invention can be generally understood)

**[Invention in English]**

**[applicant]**

**[Name]**

**[applicant code]** (Application for applicant code to be attached)

**[Inventor]**

**[Name in Korean]**

**[Name in English]**

**[Resident Registration Number]**

**[Zip code]**

**[Address]**

**[Examination request]** (Request can be made within five years of application)

**[Early publication]** (Published after 3 months if requested and after 18 months by default if not)

**[How to receive registration certificate]**

**[Intent]** Pursuant to Article 42 of Patent Act, application is hereby filed.

**[Fee]**

**[Base fee]**

**[Examination fee]**

**[Total]**

**[Reduction or exemption]**

**[After reduction or exemption]**

**[Attachment]** 1. Abstract, description, drawing (1 for each)

**[Attached Form #15]<sup>25)</sup>**

**【Description】**

**【Title of invention(device)】**

**【Detailed explanation of invention(device)】**

**【Technical area】**

**【Background technology】**

**【Content of invention(device)】**

**【Task to be solved】**

**【Means to solve task】**

**【Effect】**

**【Details to work invention(device)】**

( **【Example of working】** )

( **【Industrial applicability】** )

**【scope of Claim of patent(utility mode registration)】**

**【Claim 1】**

**【Brief explanation of drawing】**

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**[Attached Form #12]**

**【Drawing】**

**【drawing 1】**

**【drawing 2】**

---

**[Attached Form #13]**

**【Abstract】**

**【Summary】**

**【Representative picture】**

**【Reference】**

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25) Taking effect on Jul 1, 2007.

## 5. Patent application procedure

### A. Method of application

In order to file patent application, applicant has to prepare application and file it to KIPO. A method of filing includes written filing and electronic filing using KIPO electronic filing system filing electronic document on line or by floppy disc. However, an invention ordered to maintain confidentiality cannot be filed in electronic document.

### B. Applicant Identification Number

A person filing a patent application must apply to KIPO or the Intellectual Property Tribunal (“Tribunal”) for an ‘identification number (applicant code number)’, which shall be provided immediately. If requested by mail, the number shall be returned by mail. The number shall be used for all documents filed to KIPO or the Tribunal.

### C. Application procedure using electronic document

(1) Notification of electronic document use: A person purporting to apply by electronic document must also register for an electronic document use with the Commissioner of KIPO or the President of the Tribunal, and has to electronically sign the electronic documents submitted to the KIPO or the Tribunal so that he can be identified. (Article 28.4) Applicant must prepare application, description, drawing and abstract by using S/W provided by the KIPO.

(2) Applying on-line: Online application must be done by using S/W provided by KIPO and documents not able to be submitted online such as power of attorney and written proof have to be submitted within three days from the day when the online application number is confirmed, along with an electronic document attachment certificate.

(3) Applying by floppy disc: Documents not able to be submitted in floppy discs have to be submitted as an attachment to the written floppy disc application.

## IV. Claim of Patent

### 1. Meaning

The modern patent system was first legislated in England and ‘patent claim’ was adopted in 1883 by law. As technology diversified with industrial development, it became difficult to make patent infringement determination by statements in the description. Also, the term ‘patent claim’ went into use in the U.S. in the 1820s, gradually being used as an independent item at the bottom of the description. Even after the term ‘patent claim’ became popularized, it was just for reference and the focus was on the description and the drawing.

However, the usefulness of the patent claim was recognized among patent practitioners and U.S. Congress ratified its use by legislating it in 1836. After that, with respect to the scope of claim, the U.S. changed from the center limitation rule to the border limitation rule.

With such background, patent claim is being used as important criteria for interpreting the scope of right. An inventor needs to recognize the importance of the patent claim, which is a title of invention for the patent he obtained in return for his invention.

### 2. Function of Claim of Patent

Patent claim’s essential and fundamental functions are the protection scope function and the invention defining function.

#### A. Scope of protection

As may be known from its birth, patent claim is the scope for which an applicant wants protection for his invention, so when someone infringes on the scope, it is patent infringement. In order to clarify this, the Patent Act provides that “the scope of protection conferred by a patented invention is determined by the subject matter described in the claim(s).” (Article 97) Thus, invention stated in the description but not in the claim(s) is not protected.

#### B. Requirement of construction

Claim(s) must define the invention clearly and concisely. (Article 42.4.2 of the Act)

### 3. Make up of Claim of Patent

#### A. Requirements for statement

A patent claim has the purpose of obtaining protection for an invention, so inventors need to state it so they may have maximum protection. Also, since an invention must be completed, everything necessary to specify the invention must be stated clearly.

There has to be one or more claims, which must be supported by a detailed explanation of the invention and that which defines the invention clearly and concisely. (Article 42.4 of the Act) Thus, an application not meeting the above shall be refused and, if the patent has already been granted, the patent shall be cancelled or invalidated.

#### (1) To be supported by detailed explanation of the invention

(A) A patent claim must only state the invention mentioned in the description because protecting an invention not stated there is against the purpose of the patent system.

#### (B) Types not supported by detailed explanation of the invention

- 1) Where items corresponding to the statement of claim is neither clearly stated nor implied in the description of invention.
- 2) Where the description and the claim have discrepancy in terminology and their correspondence (matching) is unclear.
- 3) Statement in the patent claim is phrased as 'means' to carry out a certain function or 'work process' but the description does not clearly state specific technical construction to implement such means or work process.

#### (2) Invention shall be stated clearly and concisely

Where, in order to broaden the claim, the construction requirement of the invention is not clearly stated with functional expressions, where combination among the elements and thus the invention is unclear, or where the patent is granted for an invention whose statement is not concise, the burden of interpreting protection scope is shifted to a third person, hurting legal stability. Thus, the patent claim has to state the definition clearly and concisely. However, a functional statement, if clear as a whole, is very helpful in stating the claim.

#### B. Method of statement

(1) On September 1, 1981, the Patent Act abolished the single claim system where only one claim is stated in the patent claim. The multiple claim system was adopted

where two or more claims are allowed. On the method of stating independent and subordinate claims, Article 5 of the Presidential Decree provides as follows:

(A) An independent claim is stated first and then a subordinate claim adding or limiting the independent claim can be stated. If necessary, another subordinate claim adding or limiting the former subordinate claim can be stated.

(B) Independent claims have to be stated in proper numbers depending on the nature of invention.

(C) In stating subordinate claims, one or more claims have to be cited among independent or other subordinate claims, whose numbers also have to be stated.

(D) Claims citing two or more claims have to state the number of one of the cited claims.

(E) Claims citing two or more claims cannot cite other subordinate claim citing two or more claims.

(F) Cited claims have to be stated before citing claims.

(G) Claims have to be stated so that each claim is stated in a separate line and each claim is numbered in the order of the statement.

(2) Statement of independent claim

(A) Independent claims are stated in principle without citing other claims. But, where the category of invention is different, it can be stated citing other claims as long as the invention is clearly understood, in order to prevent overlapping statement.

[Example]

- 1) Product manufactured with the method of claim #\_
- 2) Method of manufacturing product of claim #\_ by \_\_\_\_\_
- 3) Method of \_\_\_ by using product manufactured by method of claim #\_

(B) Independent claims citing other claims can cite one or more claims among independent or subordinate claims.

[Example]

- 1) Product manufactured with the method of claim #\_ or claim #\_
- 2) Product manufactured with the method stated in claims from #\_ to #\_

(C) Claims citing two or more claims cannot cite other claims citing two or more claims.

[Example 1] Examples where claims citing two or more claims cite other claims citing two or more claims

- 1) Method of \_\_\_\_\_
- 2) Method of \_\_\_\_\_ in claim #1
- 3) Method of \_\_\_\_\_ in claim #1 or #2
- 4) Product manufactured by Method of claim #2 or #3

[Example 2] Examples where claims citing two or more claims cite other claims citing claims citing two or more claims

- 1) Method of \_\_\_\_\_
- 2) Method of \_\_\_\_\_ in claim #1
- 3) Method of \_\_\_\_\_ in claim #1 or #2
- 4) Method of \_\_\_\_\_ in claim #3
- 5) Product manufactured by method of claim #2 or #4

(3) Statement of subordinate claim

(A) Subordinate claims limit or add independent or other subordinate claims cited. The scope of protection is interpreted narrower than cited claims. However, in stating subordinate claims, the following are not allowed.

- ① Limiting only effect or terminology of invention
- ② Reducing elements of cited claim
- ③ Replacing elements stated in the cited claim with other elements

(B) Subordinate claims have to cite one or more claim among independent or other subordinate claims. In such case, numbers of cited claim have to be stated.

(C) Claims citing two or more claims must state the number of cited claims selectively, and claims citing two or more claims cannot cite other claims essentially citing two or more claims.

(D) Cited claims have to be stated before citing claims.

(E) Subordinate claims cannot cite and state independent or other subordinate claims of a different category.

[Example]: Prohibited examples (Claim #3 and claim #4)

- 1) Method of \_\_\_\_\_

- 2) Method of \_\_\_\_\_ in claim #1
- 3) Method of \_\_\_\_\_ in claim #2
- 4) Method (or Product) of \_\_\_\_\_ in claim #2 or #3

Meanwhile, revised Patent Act (promulgated January 3, 2007; Effective July 1, 2007) allowed a patent claim to be submitted by request of examination or publication of filing.

## V. Singularity of Invention

### 1. Meaning

As technology becomes advanced and sophisticated, in order to properly protect an invention obtained from technological development, and to allow people to easily check filed inventions and help KIPO to speed up and improve efficiency of examination, the KIPO determines the scope of multiple inventions included in one application, i.e., the scope of patent application. Thus, despite the ‘one invention, one application’ rule, a group of inventions that form a single general inventive concept may be the subject of a patent application. (Article 45) The U.S., Japan and EPC have similar provisions.<sup>26)</sup>

### 2. Invention of Group

A group of Inventions can include multiple independent claims of same or different category. Where the category is the same, the following has to be met.

- ① An invention with the same area of industrial application and task, as specified in the invention
- ② An invention which includes the same main part, the essential item for construction, as specified in the invention<sup>27)</sup>

A. Invention with the same industrial application area: includes cases where specific a invention and related invention have the same, overlapping or directly related technical areas.

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26) Article 121 of the US Patent Act provides that if two or more independent and distinct inventions are claimed in one application, the Director of USPTO may require the application to be restricted to one of the inventions, and Article 1.141(a) of the CFR in principle does not allow two or more independent and distinct inventions to be claimed in one application.; Article 82 of EPC (“Unity of invention”); Article 37 of the Patent Act of Japan

27) Article 37.1 of the Patent Act of Japan

- B. Invention with the same task: includes the case where a specific invention and related invention have the same or overlapping tasks to solve.
- C. Invention with the same main part: ‘main part of claim elements’ means that the part deemed necessary to specify the invention by task, and the ‘invention with the same main part’ means the case where the related invention has as its main part the main part of specific invention.

### 3. Requirements for Application #1

A patent application must relate to a single invention only. However, a group of inventions that form a single general inventive concept may be the subject of a patent application (Article 45), with the following requirements. (Article 6 of Presidential Decree)

1. Inventions shall have a technical relationship with each other.
2. Inventions shall have the same or corresponding technical feature which shall be an improvement over prior technology as a whole (revised Jun 13, 2003).

### 4. Legal Effect for Breach

Whether or not the ‘one invention, one application’ rule is violated concerns not substantive requirements but the filing procedure of treating two or more applications as one. Thus, a violation shall be cause of patent refusal (Article 62) but, if the patent has been granted, it shall not be a cause of patent invalidation or a request of reason for the patent. Also, where an applicant is refused a patent for the above violation, the applicant can file divisional application or file an amendment by deletion within a designated period.

## VI. Withdrawal and abandonment of application

An applicant can withdraw or abandon his/her patent application during the patent procedure. Withdrawal or abandonment may be caused by events prescribed by law or by the applicant’s own will.

## SECTION 2 AMENDMENT OF APPLICATION

### I. Amendment system

#### 1. Meaning

Amendment of an application means a procedure which, where the method of application or statement of the description or drawing has flaws. Thus, the applicant cures such flaws during the application procedure while maintaining the identicalness of the original description or drawing. In the first-to-file rule, applicants may be haste in filing in order to secure first-to-file status and thus the description or drawing may have flaws or unexpected problems. The amendment of application is intended to remedy this problem by protecting the applicants by providing opportunities to cure the flaws. However, since an amendment becomes effective retroactively, unlimited amendment is against the first-to-file rule and can hurt third-parties. Also, unlimited amendments may harm the stability of the patent system and cause problems during the examination procedure.

Therefore, the Patent Act adopts a qualified amendment principle where post-application amendment is acknowledged with qualification in time and content.

#### 2. Types of amendment

Amendment of patent application is divided into procedural and substantive amendment.

- A. Procedural amendment: Where a patent procedure does not meet the method prescribed by law, it can be amended. (Method amendment)  
Procedural amendment can be done by the applicant's will or by an amendment order from the KIPO Commissioner. (Article 46)
  
- B. Substantive amendment: Substantive amendment concerns not the mode of application but the description or drawing in which case their erroneous contents are amended. Substantive amendment can be done by the applicant's will or by an amendment order from the KIPO Commissioner. (Article 47)

## II. Object of amendment

### 1. Procedural amendment

A. Object: Causes of procedural amendment are as follows. (Article 46)

- ① Person without legal capacity engages in patent procedure
- ② Scope of power of attorney is lacking
- ③ Where the procedure does not comply with the formalities prescribed in this Act or by Presidential Decree
- ④ Where fees required under Article 82 have not been paid

B. Time of amendment: Procedural amendment can be done anytime while the patent application is pending. However where the KIPO Commissioner issues an amendment order, amendment shall be done within a designated period and if the period has expired, the Commissioner can invalidate the application. (Article 16)

### 2. Substantive amendment

A. Scope of amendment

#### (1) Principle

(A) Prohibition on adding new items

An amendment to a description or drawing must be within the scope of the features disclosed in the description or drawing originally attached to the application. (Article 47.2) The rules prohibiting the addition of new items introduced harmony with the rules of the PCT, EPC, the U.S. and Japan, etc.

(B) Criteria for determination of new items

1) New items: An amendment to a description or drawing must be within the scope of the features disclosed in the description or drawing originally attached to the application. (Article 47.2) 'Features other than those disclosed in the description or drawing originally attached to the application' are commonly called new items.

'Features not expressly stated in the description or drawing originally attached to the application but deemed to be stated therein by those skilled in the art' shall be excluded from new items.

2) Object of comparison: Whether or not the new items are added is determined by the description or drawing originally attached to the application. New items are not allowed in any of the above.

In international patent applications, where substantive examination is done by translation, whether or not new items are added is determined by a statement in the translation. Thus 'features disclosed in the description or drawing originally attached to the application' shall be 'translation of the description or drawing (limited to explanation part of the drawing only) filed on the date of international patent application or features disclosed in the drawing (except for explanation) filed on the date of international patent application.'

(C) Amendment adding new items

1) Amendment during the voluntary amendment period or initial notice of reason for refusal: Regarding an amendment adding new items during the examination procedure reason for refusal shall be provided.

2) Amendment of final notice of reason for refusal or amendment at filing opposition to the decision to refuse patent: Regarding an amendment adding new items, the examiner shall reject the amendment by a decision. (Article 51.1)

3) Where an amendment violating the law is found after registration of a patent: Where an amendment is found after the patent registration has violated the prohibition on adding new items, a patent invalidation request as well as an appeal can be filed.

(2) Amendment after final notice of reason for refusal and at filing opposition to a decision to refuse a patent

(A) Amendments other than claims: Regarding an amendment of the detailed explanation in the description or the drawing, features other than those disclosed in the description or drawing originally attached to the application cannot be added.

(B) Amendment of claims:

1) Permitted scope of amendment

After final notice of refusal reason or at the time of filing opposition to the decision to refuse patent, an amendment to the patent claim is only allowed where patent claims are reduced, erroneous statement is corrected, or unclear statements are clarified. The above is for the purpose of promoting speedy examination.

## 2) Permitted scope of amendment (examples)

A) Where the scope of a claim is reduced: Regarding an amendment made within the designated period, an amendment to a description or drawing must neither substantially expand nor modify the scope of the claim, and the matters described in the claim after an amendment must have been patentable when the patent application was filed. (Article 47.4)

Examples of patent claim reduction are: Claim deletion; deletion of selectively stated elements; genus to species statement; adding or limiting elements; reducing the number of cited claims in a subordinate claim citing multiple claims; etc.

B) Where erroneous statements are amended: Assuming that the pre-amendment statement and the post-amendment statement are the same, where the description or drawing are deemed obviously erroneous from the statement or common knowledge or past experience, the errors are corrected.

C) Where unclear statements are clarified: Only where the examiner instructed clarifying an unclear statement is an amendment allowed.

(C) Determination criteria for new items (new law) and amendment of essence (old law)

They have the same object of comparison, which is the statement in the original description and the features deemed obvious to those skilled in the art. However, they are different in that amendment of essence is determined based on the scope of claim while new items are determined based on the description or drawing.

## (D) Division between initial and final notice of reason for refusal

1) Article 47.1.1: Notice of reason for refusal means initial notice. This provision concerns initial notice and also notices thereafter, which are not covered by Article 47.1.2.

2) Article 47.1.2: Notice of reason for refusal means final notice and this provision concerns notice necessitated by amendment of initial notice of reason.

## B. Time of amendment

Where reason for refusal is not notified, amendment can be filed by the time a copy of the patent decision is served. Where the reason is notified, amendment can be filed by the time response to the notice is filed.

Where an applicant requests a trial against a decision to refuse a patent, an amendment can be filed within thirty days after the filing of request. (Article 47.1.3)

### **III. Procedure of amendment**

A person purporting to amend an application shall file the designated amendment forms along with written proof to the KIPO Commissioner. Also, a fee has to be paid.

### **IV. Effect of amendment**

#### **1. Lawful amendment**

Where a patent application amendment is lawful, the application is deemed to have been filed as amended on the day of original application.

#### **2. Unlawful amendment**

A. Procedural amendment: Where a procedural amendment is filed after the expiration of the period designated by the Commissioner, the amendment is invalid.

#### **B. Substantive amendment**

(1) Amendment for the description or drawing filed after the expiration of designated period shall be returned. (Article 11.1 of Ministerial Decree)

(2) Amendment adding new items shall be cause for information request (Article 64.2), refusal (Article 62), appeal to patent and patent invalidation.

(3) Where amendment regarding final notice of reason for refusal or filed after opposition to the decision to refuse violates Articles 47.2 to 47.4 shall be dismissed.

Criteria	Time of amendment	Scope of amendment		Unlawful amendment	
		Description, drawing	Patent claim	Examination pending	Post registration
Initial description or drawing attached to application §47 ②	Before arrival of patent decision (§47 ①) or initial notice of reason for refusal	Prohibiting new items (§47 ②)	Prohibiting new items (§47 ②)	Reason for refusal (§62 ⑤)	Cause of appeal, invalidation §69 ① 4-2, §133 ① 4-2)
	Within period to file brief to initial notice of reason for refusal (§47 ① 1)				
	Within period to file brief to final notice of reason for refusal (§47 ① 2)	Prohibiting new items (§47 ②)	Prohibiting new items (§47 ②) Amendment allowed for the following only. ① Reducing patent claim (§47 ③ 1) ①-1 Amendment of description or drawing does not essentially expand or change patent claim (§47 ④ 1) ①-2 Item stated in patent claim after amendment can be patented at time of application (§47 ④ 2) ② Correcting erroneous statement (§47 ③ 2) ③ Clarify unclear statement (§47 ③ 3) ③-1 Item examiner referred to in reason for refusal (§47 ③)	Amendment dismissed (§51 ①)	Adding new item is cause of appeal or invalidation (§69 ① 4-2, §133 ① 4-2); Where §47 ④ 2 (patentability requirement) not met, can be appealed or invalidated
Within 30 days of filing appeal to decision to refuse patent (§47 ① 3)					
Description, drawing §136 ②	Amendment in appeal procedure (§77) Within period to file answer (§77 ① → §70 ②) Within period to file brief (§77 ① → § 72 ①)	Prohibiting new items (§77 ③ → §136 ②) Correction allowed for the following only. ① Reducing patent claim (§77 ①, §47 ③ 1) ①-1 Item stated in patent claim after correction can be patented at time of application (§77 ③ → §136 ④) ② Correcting erroneous statement (§77 ①, §47 ③ 2) ②-1 Within scope of statement in description or drawing originally attached to application (§77 ③ → §136 ②) ②-2 Item stated in patent claim after correction can be patented at time of application (§77 ③ → §136 ④) ③ Clarify unclear statement (§77 ①, §47 ③ 3) ④ Correction of ① to ③ cannot essentially expand or change patent claim (§77 ③ → §136 ③)	Unlawful correction can be amend within period to file brief (§77 ③ → §136 ⑤, ⑨) Request for correction trial not allowed during appeal procedure	Unlawful amendment is cause of invalidation (§137 ①)	

## V. Dismissal of amendment

### 1. Meaning

Rejection of an amendment means an act by the examiner and trial examiner to refuse an amendment of the description or drawing filed by the applicant where the amendment exceeds the scope permitted by law. (Article 51)

The purpose of this is to prevent hurting legal stability in violation of the first-to-file rule, and to prevent impeding speedy examination and decision-making by adding new items through the filed amendment after a final notice of reason for refusal.

### 2. Object of amendment dismissal

A. Amendment at examination stage: Amendment filed after the examiner's final notice of reason to refuse patent shall be dismissed if it falls under the following.

- ① includes new items or
- ② violates Article 47.3 or 47.4 (restricting additional amendment of patent claim)

B. Amendment at pre-examination stage: Where new reasons for refusal are found at the pre-examination stage, provisions on the first and final notices of reason for refusal and dismissal of amendment apply in their entirety.

(1) Dismissible amendment: at the pre-examination stage,

- ① amendment filed after the examiner's final notice of reason for refusal
- ② where amendment at the time of filing of opposition to the decision to refuse patent violates the provision prohibiting addition of items or the provision limiting additional amendment of patent claim, amendment shall be dismissed.

(2) Non-Dismissible amendment: Since Article 174.1 of the Patent Act provides, "under Article 47(2), excluding an amendment filed before a request for a trial against a ruling of refusal to grant a patent under Article 132ter," amendment before filing an opposition to the decision to refuse a patent cannot be dismissed at the pre-examination stage. Thus where at the examination stage an amendment to final notice should have been dismissed because it adds new items or fails to meet patentability requirements but the examiner erred, a final notice of reason to refuse patent shall be given.

### C. Amendment at trial stage

(1) Dismissible amendment: At the examination stage,

- ① amendment filed after examiner's final notice of reason to refuse patent
- ② where the amendment at the time of filing of opposition to the decision to refuse patent violates the provision which prohibits adding new items and the provision which limits the additional amendment of a patent claim, an amendment shall be dismissed. (Article 170.1)

(2) Non-dismissible amendment: As Article 171.1 provides in its parenthesis, an amendment before filing opposition to a decision to refuse patent cannot be dismissed at the trial stage. Thus where at the examination stage amendment to a final notice should have been dismissed because it adds new items or fails to meet patentability requirements but the examiner erred, a final notice of reason to refuse patent shall be given. (Article 170.1)

### 3. Cause of dismissal of amendment

Where an amendment filed at the examination, pre-examination, or trial stages falls under the following, the amendment shall be dismissed.

A. Where new items beyond what is stated in the description or drawing originally attached to the application are added in the amendment

B. Where the amendment in the patent claim is not one of the following:

- ① reducing patent claim
- ② correcting erroneous statement
- ③ clarifying unclear statement

C. Where the amendment reducing patent claim falls within the following:

- ① essentially expanding or changing the patent claim
- ② what is stated in the patent claim after the amendment was not patentable at the time of the application

### 4. Appeal to dismissal of amendment

It is not possible to appeal independently to a decision to dismiss an amendment. However, where an amendment of concerned application is dismissed and then refused and opposition is filed to the decision to refuse patent, it is possible to contest the dismissal of the amendment at the trial procedure. (Article 51.3) This is to prevent delayed examination of the appeal to dismissal of an amendment.

## SECTION 3 DIVISIONAL & CONVERSION APPLICATION

### I. Divisional application

#### 1. Meaning

Where an application includes two or more inventions, filing a separate application for part of the inventions is called divisional application. (Article 52.1) Since it divides a certain invention from the original application, an original application remains and the divisional application becomes effective retroactively. Thus, where a patent is refused for violating the scope of one patent application, divisional application can be a relief and where it is more advantageous to divide inventions and obtain multiple patents, an applicant can voluntarily divide inventions.

#### 2. Requirements for lawful divisional application

A. Original patent application is pending: Original application has to be validly pending before the KIPO at the time of a divisional application. Thus, if the original application is registered or refused, invalidated, abandoned or withdrawn, the divisional application cannot be filed. However, if the original application is invalidated, abandoned or withdrawn after the divisional application, the divisional application can remain valid.

B. Original applicant and divisional applicant are same: Divisional applicant has to be the original applicant or a lawful successor at the time of the divisional application. Applicants who are different thereafter do not influence the divisional application.

C. Original invention and divisional invention shall maintain sameness: Since a divisional application has to be divided from inventions stated in the description or drawing, inventions of both applications have to be same.

D. After division, original application and divisional application are not same: After division, inventions stated in the patent claim of the original and the divisional application shall not be the same. If they are the same, it will result in a duplicated patent and violate the first-to-file rule. Thus, where an invention stated in the patent claim of the original application is divided, an amendment deleting the divided invention from the original application is necessary.

E. Shall be within amendment period: Divisional application can be filed within the period when the description or the drawing of the original application can be amended (Article 52.1) because the original application's description has to be amended by a divisional application.

### 3. Procedure of divisional application

Since a divisional application is a new application, anyone purporting to divide an original application has to prepare a separate application and file it. (Article 29.1 of Ministerial Decree) Where divisional application necessitate amendment of the original application's content, the description, abstract or drawing attached to the original application has to be amended at the time of the divisional application. (Article 29.3 of Ministerial Decree)

Where documents attached to the original application are intended to apply to a divisional application without change in content, the original documents may be cited by stating in the divisional application such intent.

### 4. Effect of divisional application

#### A. Lawful divisional application

(1) Moving filing date back: Lawful divisional application becomes effective retroactively to the original application date in principle. (Article 52.2) Thus, novelty, inventive step and first-to-file shall be determined based on the original application date.

(2) Exception: Considering the problems caused by moving back the date of the divisional application, actual divisional application date shall be the filing date, in the following scenarios:

(A) Where expanded prior application (Article 29.3) applies: Where a divisional application is a patent application of Article 29.3 of the Patent Act or Article 5.3 of the Utility Model Act, actual application date is the filing date. The rationale is to prevent possible harm to a third person that can be caused by adding in the divisional application technical issues not stated in the original application.

(B) Where one purports to claim a publicly unknown invention (Article 30.2) or priority (Articles 54.3 or 55.2) regarding a prior application, file divisional application for the invention in order to invoke the effect of prior application, the applicant has to repeat the procedure taken in prior application. However, if the filing date of relevant documents is moved back to the date of prior application, he may not be able to take measures he could have taken at the time of the divisional application. Thus, where 'not publicly known invention' or 'treaty or domestic priority' was claimed regarding prior application, in order to invoke the effect of such application by filing a divisional application, one must claim such intent and submit written proof to the KIPO Commissioner within 30 days ('not publicly known invention') or 3 months ('treaty or domestic priority') from the divisional application.

(3) Special provision for request of examination

A five-year examination request period of divisional application starts from the original application date. However, where divisional application is filed after five years from the original application, examination can be requested within 30 days of the divisional application. (Article 59.3)

(4) Relationship between original and divisional applications

Although a divisional application is a division of the original application, they are deemed to be separate. Thus, a separate procedure has to be taken in a conversion application such as the publication of filing, payment of examination fee, etc.

(5) Amendment of divisional application

(A) Time of amendment: Divisional applications can be amended as if it were filed at the time of the original application. Where reason for refusal is not notified, an amendment can be filed by the time a copy of the patent decision is served. Where the reason is notified, an amendment can be filed by the time response to the notice is filed.

(B) Content of amendment: Description or drawing of the amended divisional application is restricted to the scope of the description or the drawing at the time of division.

## B. Unlawful divisional application

(1) Where divisional application is filed after the expiration period of when a division is allowed (Article 52.1), the flaw is not curable by amendment and the application is returned. (Article 11.1.7 of Ministerial Decree)

(2) Where divisional application cannot be deemed lawful because it has as its essence what is not stated in the initial description or drawing of the original application, the applicant shall be given an opportunity to submit briefs (arguments) and if the submitted briefs (arguments) and/or amendment cannot render the divisional application lawful, it shall be refused.

## II. Conversion application

### 1. Meaning

Conversion application converts an application's form into an object of another statute while maintaining the same technical idea. Where a utility model applicant converts the application to a patent application, it is a change of form.

Invention, an object of the patent application, and device, an object of utility the model application, are both creations of a technical idea. It is difficult to decide which law will better protect them, and sometimes an examiner will point out that the object of application is not correct. Therefore, conversion application allows applicants to change application forms. This procedure also aims to protect inventors by maintaining the first-to-file status.

This was momentarily abolished on July 1, 1999 when the utility model was changed to a prior registration system. However, as the utility model changed to registration after examination, conversion application was re-introduced on October 1, 2006 by the revised Patent Act.

## 2. Requirements for lawful conversion application

### A. Application shall be amended while original application is pending

This converts a utility model application into a patent application and thus can be done while the original application is validly pending. Where the original application is withdrawn, invalidated, etc. and not pending, the application cannot be converted.

### B. Original patent applicant and conversion patent applicant are the same

Conversion application can be filed by an original applicant or his successor. A successor of an original applicant has to file notification of change of applicant, as well as a conversion application to the KIPO Commissioner.

### C. Original application and conversion application shall maintain same content

Since an application can only be converted within the scope of what is stated in the description or drawing of what was originally attached to the application, both applications have to be same.

### D. Shall be within amendment period

Application can be converted within 30 days of the date when the decision to refuse a utility model registration is received. Thus, even if the decision to refuse is being contested or if it is within 30 days of receipt of re-decision to refuse after original decision has been remanded, an application cannot be converted. This is because the decision is not the first one. Time of filing is restricted to prevent procedural waste.

The 30-day period is extended when the period for filing opposition to a decision to refuse a patent is extended according to Article 15.1. (Article 53.5) This is to provide a choice to the person who was refused a patent.

### 3. Procedure of conversion application

A. Conversion application has to be filed to the KIPO Commissioner as a separate application because it is a new one. A conversion application has to state the intent of conversion and the utility model application that is to be converted. (Article 53.3)

B. Where an agent files a conversion application, care has to be taken. Conversion application results in withdrawing the original application so an applicant must carefully decide whether or not he/she want to convert an application. Thus, an agent except for a patent administrator has to have special authorization, which is different from the procedural requirements for divisional applications. (Article 6)

C. In a conversion application, anyone claiming priority (treaty/domestic) has to file a priority claim to the KIPO Commissioner with 30 days of conversion. (Article 52.6)

### 4. Effect of conversion application

#### A. Moving back filing date

Where a conversion application is lawful, it is deemed filed at the time of the original application. Thus, regarding a conversion application, the determination of patentability, application of first-to-file rule, publication time of application, period of patent, etc. shall apply based on the date or time of the original application. (Article 53.2)

#### B. Exception

Conversion application is not retroactively effective where, (Article 53.2)

- (1) where expanded first-to-file provision applies (Article 29.3)
- (2) where invention not published provision applies (Article 30.2)
- (3) where priority provisions apply (Article 54.3, 5.2)

#### C. Special provision for request for examination

Where the utility model application is converted to a patent application after three years of application, examination can be requested in 30 days of conversion. (Article 59.3)

Also, if examination is not requested until the above period expires, conversion application is deemed withdrawn. (Article 59.5)

#### D. Withdrawal of original application

Utility model application is deemed withdrawn by conversion application. (Article 53.4)

Conversion application is a change of 'form' and the applications are identical. Original application is deemed withdrawn in order to prevent overlapping application.

### 5. Relations between original application and conversion application

Conversion application is based on the original application but they are separate. Thus, separate procedures have to be taken in a conversion application, such as publication of filing, payment of examination fee, etc.

## SECTION 4 PRIORITY

### I. Meaning

In patent law, there are two priority claims. One is a treaty-based priority based on the Paris Convention entered into on March 20, 1883 for the purpose of international protection of industrial property. The other is a domestic priority claim purporting to introduce the Paris Convention-based priority claim in a domestic application for improvement invention based on prior invention filed domestically.

Treaty-based priority allows a foreigner to move domestic filing date back by claiming priority based on first country filing. However, Koreans were not being allowed priority claim based on prior domestic application, so for the purpose of balance, domestic priority claim was introduced on September 1, 1990, with a similar goal to the treaty-based one.

### II. Priority based on treaty

#### 1. Meaning

In order to lessen an inventors' burden of simultaneous applications in many countries with different systems and languages, priority claim of the Paris Convention treats anyone who has filed an application in the first country of the members of the Paris Convention and who subsequently files an application for the same invention in another members' country and claims priority, as if he filed the later application on the day of initial application. When a citizen of another member country which acknowledges priority claim to Koreans files application in any member country and files in Korea for the same invention and claims priority, the first filing date shall be deemed the filing date in Korea and Articles 29 and 36 of the Act apply in such cases. (Article 54.1)

(1) If a national of a country that recognizes under a treaty the right of priority for a patent application filed by a national of the Republic of Korea (“Korea”) claims priority for an application in Korea based on the earlier application for the same invention in the national’s country or in another country that recognizes the treaty, the filing date of the earlier application in the foreign country is deemed to be the filing date in Korea under Articles 29 and 36. Also, where a Korean national has filed an application in a country that recognizes under a treaty of priority for patent applications filed by a Korean national claims priority for a patent application in Korea based on the earlier application for the same invention in that country, this provision applies.

## 2. Requirements for priority claim

### A. Person who can claim priority

Treaty-based priority can be claimed by nationals of Korea and member states or nationals of non-member states having residence or place of business in Paris Convention members. Also, the applicant claiming priority and the applicant in the first country shall be same person or the successor. A successor has to succeed to priority as well as application related rights.

### B. Shall be the first application based on regular domestic application of the first country

A regular, domestic application in the first country is an appropriate application for determining the filing date regardless of the result of filing. A withdrawn, abandoned, refused or invalidated application is deemed such, as long as the filing date can be determined. Also, an application in the first country which is the basis for priority claim is limited to the first application in that country in order to prevent a series of priority claims for the same object. Application in the first country includes patent application, utility model application, design application, trademark application (excluding service mark) or inventor certificate application.

### C. Shall be within priority claim period

In order to claim priority, the application shall be filed in the second country within one year of filing the application in the first country for a patent and a utility model, six months for design and trademark. Where the application claiming priority and the application in the first country which is basis for the former are of different types, priority shall be claimed within the period as determined by the application in the first country. Thus, if a design application was filed in the first country and a utility model application was filed based on that in Korea, application with priority claim shall be filed within six months of the filing date in the first country.

#### D. Same invention for the first country application and priority claim application

Contents of the application in the first country and the application with priority claim shall be same. That is, the invention stated in the patent claim in the application with priority claim and the invention understood from the whole patent documentation filed in the first country such as description or drawing need be substantially same. Also, even if application with priority claim includes what is not included in the application in the first country, the part included shall be granted priority.

### 3. Procedure of priority claim

#### A. Priority claim

Any person purporting to take advantage of the priority of a previous filing shall be required to make a declaration indicating the date of such filing and the country in which it was made. (Article 4.D of Paris Convention) Thus, anyone purporting to claim priority domestically shall do so by stating in their patent application such intent, the country name and date of the first application and shall file within one year of the first application. Anyone who claimed priority may amend or add priority within one year and four months of the first filing date.

#### B. Submitting written proof

(1) Anyone claiming priority in a domestic application shall submit to KIPO a written statement of the filing date recognized by the country where the application was first filed, and the copies of the description and the drawing of the invention will be submitted as well within one year and four months from the earliest date. For written priority claim in a foreign language, a Korean translation shall be attached. However, to the degree where the description and drawing of the invention are the same as those attached to application pursuant to Article 42.2, a Korean translation may be exempted by stating such fact.

(2) However, for countries designated by Industry and Resources Ministerial Decree, it is possible to exempt written proof of priority by submitting a written stating the patent application number. (Article 54.4) In such case, a Korean translation shall be attached to the priority claim in a foreign language. ‘Countries designated by Industry and Resources Ministerial Decree’ means the countries whose patent agencies have systems to electronically exchange written proof of priority with KIPO and also designated by KIPO. Japan and EU were designated accordingly.<sup>28)</sup> Following are requirements for the above provision.

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28)

- ① the first country application was filed in countries designated by the Ordinance and can be deemed the first application
- ② priority claim by a person who filed an application in the country designated by the Ordinance and his successor
- ③ domestic application with priority claim is filed on July 1, 2007 or later
- ④ application with priority claim based on patent and utility model application filed in the countries designated by the Ordinance

(3) For divisional and duplicated applications, written proof of priority can be submitted to the KIPO commissioner within three months from the date of divisional or duplicated application. (Article 52.4, 53.4)

### C. Amendment of priority claim

#### (1) Application which can amend priority claim

In order to amend priority claim

- ① priority was claimed at the time of application
- ② subsequent application shall be filed within one year of the initial application which is the basis for priority claim. Also, where a priority claim is withdrawn, abandoned or invalidated or where subsequent application is not pending, priority claim cannot be amended.

#### (2) Scope of amendment for priority claim

##### (A) Amendment within one year and four months of the earliest date

In this period, priority claim can be amended or added. Thus, withdrawing all or part of priority claim, correcting obvious error and adding priority claim are allowed.

##### (B) Amendment after one year and four months of the earliest date

Amendment made after one year and four months from the first filing date has more restrictions than an amendment made before; adding is not allowed. Thus, withdrawing all or part of a priority claim, correcting obvious error, etc. are allowed but an amendment where the first country application is changed or added is not allowed

## 4. Effect of priority claim

Paris Convention treats a subsequent application by an applicant filing in the first country among the Paris Convention members or the successors as if it were filed on the date of prior application in the first country. A patent application for which priority is acknowledged, in applying Articles 29 and 36 of the Act, shall be deemed to have been filed in Korea on the date of the first application. Therefore, novelty, inventive step and prior application shall be determined based on the date of first application.

## 5. Determination of priority claim

### A. Examination procedure regarding treaty-based priority claim

(1) If priority claim is flawed after examining it, an order to amend shall be issued under Article 46. If not, substantive examination shall be conducted.

#### (2) Substantive examination,

- ① Where no prior art is found between the prior filing date which is the basis of priority and the actual domestic filing date, patentability shall be decided based on the prior filing date
- ② Where prior art is found between the prior filing date and the actual domestic filing date, patentability shall be determined based on the first filing date if the inventions are deemed same, and based on the subsequent filing date if the inventions are not deemed same. In the latter, the reason for not moving back filing date shall be notified along with the reason for refusal.

### B. Examination of amendment of treaty-based priority claim

(1) Whether or not amendment of priority claim is lawful shall be decided considering the time of the amendment.

(2) Where flaws of priority claim are not amended within the period designated by an order to amend, priority claim shall be invalidated.

## III. Domestic priority

### 1. Meaning

Domestic priority means the case where a person filing a patent or a utility model application in Korea as prior application or his successor then specifies, improves or adds to the prior application, and within 12 months of the prior application files a subsequent application combining both inventions and claims priority, prior application is deemed filed at the prior application date, and improvement application is deemed filed at the filing date of application with priority claim. This allows one to claim priority, based on the prior application, on the subsequent application which adds items to the prior application filed in Korea. Many countries have similar systems in order to protect priority of their own citizens, such as the CIP application in the U.S., interim description of the UK, and the PCT application of the PCT.

## 2. Requirements for domestic priority claim

### A. Person who can claim priority

Applicant of a patent application (subsequent application) claiming domestic priority shall be the same as the prior applicant at the time of subsequent application or shall be a lawful successor. In a joint application, prior and subsequent applicants must be exactly the same.

### B. Time requirement

Patent Application claiming domestic priority based on prior application shall be filed within one year from the date of prior application. Domestic priority can be claimed based on two or more prior applications but shall be filed within one year from the earlier of the prior applications.

### C. Shall have same invention as in prior application

Application which is the basis of a domestic priority claim shall include patent and utility model applications and exclude design application which deals with beauty based on sight. A patent applied invention accompanying domestic priority can be claimed on the basis of two or more prior applications and can also include items not included in prior application but has to be the same invention (device) that was stated in the initial description or drawing of the prior application.

### D. Requirements for prior application on which is based domestic priority claim (Article 55.1)

- (1) prior application shall not be a divisional or duplicated application
- (2) prior application shall not be abandoned, invalidated, withdrawn or dismissed at the time of patent application
- (3) at the time of the patent application, whether or not to grant a patent for prior application has been finally decided.

## 3. Procedure of priority claim

### A. Priority claim

(1) Applicant who purports to claim domestic priority shall state the intent and the prior application which is the basis of priority. (Article 55.2) Since the prior application which is the basis for domestic priority is pending before the KIPO, it is not necessary to submit written proof of domestic priority.

(2) Where a person who claimed domestic priority based on prior application which asserted exception to notice (Article 30) purports to have Article 30 applied, he shall submit a writing stating such intention to the commissioner at the time of application, and within a designated period (30 days from subsequent application) submit written proof prescribed by Article 30.2. However, if content of the written proof is the same as that of the proof already submitted, he may state and cite it for his interest. (Article 10.2 of Ministerial Decree)

#### B. Amendment of priority claim

##### (1) Application which can amend priority claim

Application where domestic priority claim can be amended or added

- ① prior application was filed within one year before filing of a subsequent application
- ② prior application is not a divisional or duplicated application
- ③ at the time of application with priority claim, prior filed patent procedure is pending
- ④ applicants of both applications are same

##### (2) Scope of amendment for priority claim

###### (A) Amendment within one year and four months of the earliest date

In this period, scope of amendment is similar to treaty based priority claim and thus priority claim can be amended or added. So, withdrawing all or part of priority claim, correcting obvious error in the claim and adding priority claim are allowed. However, priority claim cannot be withdrawn after one year and three months from the date of prior application (Article 56.2) because prior application is already deemed to have been withdrawn by that time and thus there is no use in allowing withdrawal.

###### (B) Amendment after one year and four months of the earliest date

As in the treaty based priority, amendment after one year and four months from the earliest date can only be done in the case of an obvious typo.

#### 4. Withdrawal of prior application

A. Prior application which is the basis of a priority claim is deemed withdrawn at the time of priority claim if it is for a utility model registration, and after one year and three month from the date of application if it is for a patent, except for in the following cases:

- ① Prior application is abandoned, invalidated, withdrawn or dismissed
- ② Decision of whether or not to grant patent is finalized

- ③ Priority claim based on the prior application is withdrawn
- ④ Registration of utility model according to the Utility Model Act

B. Applicant of a patent accompanying priority claim cannot withdraw priority claim after one year and three months from the date of prior application because the prior application is deemed to be withdrawn after one year and three months so there is no use in withdrawing it.

C. Where subsequent patent application accompanying priority claim withdrawn after one year and three months from the date of prior application, subsequent application is deemed to have been withdrawn at the same time. This is to prevent the prior application from being deemed withdrawn by priority claim of subsequent application, although subsequent application was filed after the prior application was deemed withdrawn.

## 5. Effect of priority claim

A. Among filed inventions accompanying domestic priority claim, with respect to invention stated in the description or drawing originally attached to the prior application which is the basis of priority claim, the application shall be deemed to have been filed at the time of the prior application in the application of the following provisions.

- ① Article 29.1 and 29.2 (Novelty; Inventive step),
- ② Article 29.3 (Status of expanded first-to-file),
- ③ Article 30.1 (Where considered not publicly known invention)
- ④ Article 36.1 to 36.3 (Prior application),
- ⑤ Article 47.4.2 (Amendment of patent application),
- ⑥ Article 96.1.3 (Scope where a patent does not have force),
- ⑦ Article 98
- ⑧ Article 103
- ⑨ Article 105.1 and 105.2
- ⑩ Article 129
- ⑪ Article 136.4 (Includes the case where this provision is applied *mutatis mutandis* in Articles 77.3 or 133.2.3)

B. Where prior application is accompanied by domestic or treaty based priority claim, claiming priority in the subsequent application about the invention stated in the prior application which is the basis for such priority is actually an extension of the priority claim period. Thus priority is for added items over the prior application.

TABLE OF CONTENTS ::

## **CHAPTER 5**

### **PATENT EXAMINATION**



- SECTION 1  
REGIMES OF EXAMINATION
  
- SECTION 2  
EXAMINATION OF APPLICATION



## CHAPTER 5 PATENT EXAMINATION

### SECTION 1 REGIMES OF EXAMINATION

#### I. Examination regime and non-examination regime

##### 1. Meaning

A patent purports to provide an inventor a monopolistic, hence an exclusive right to an invention. In order to be protected by a patent, one needs to file a patent application pursuant to the procedure and form prescribed in the patent laws. Examination refers to a series of procedures which try to determine whether or not to grant a patent to an invention. The method of examination is divided into an examination regime and non-examination regime, which are vastly different in nature and thus different countries have adopted different methods.

In the examination regime all applications are examined while in the non-examination regime only certain requirements of an application are. In a neo-examination regime only applications requested for examination on the condition of pre-examination publication are examined. Examination and non-examination regimes are older while the neo-examination regime can be called an evolved regime.

##### 2. Comparison between examination regime and non-examination regime<sup>29)</sup>

###### A. Examination regime

In the examination regime, patent agencies examine whether or not an invention stated in the application is patentable (substantive examination), as well as whether or not the form and procedure of the application is lawful (formal or procedural examination).<sup>30)</sup>

An examination regime is better in terms of trust and stability of a patent and has fewer disputes regarding the patent. However, it requires a lot of examiners, excessive expense, more time to decide whether or not to grant the patent and thus delays protection of the invention and publication of the technology.

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29) Currently, most countries adopt examination regime (including neo-examination regime) while a few adopt non-examination regime. There are also countries adopting a hybrid type.

30) 'Formal examination' examines the form of application, unrelated to patentability, such as bibliography of the application or whether or not attached document is lacking or lawful. In the utility model, in addition to formal examination, 'basic requirement examination' which examines whether or not it is a protectable utility model, claims are properly stated, it is a single device, and the description or drawing has what needs to be included.

## B. Non-examination regime

In this regime, simple requirements of patent such as form and procedure of application are examined and the time-consuming, substantive requirements such as novelty and inventive step are only examined when there are disputes. Thus, the non-examination regime still examines the procedural aspect. The KIPO used to adopt the examination regime for patents and the non-examination regime, from July 1, 1999, for the utility model. However, on October 1, 2006, the KIPO adopted the examination regime for both.

## 3. Neo-examination regime

Examination regime is said to best serve the original goal of the patent system to create a right out of an invention. Unfortunately, with the accelerated progress of technology, the result was an explosive amount of patent applications which then took too much time to make a patent determination, therefore, harming the patent system itself. Thus, a new regime was adopted where a few supplementary features were added to shorten the required period; this is the neo-examination regime.

In order to deal with problems of the traditional examination regime, the neo-examination regime adopts publication of application, request for examination, early publication, preferred examination, and so forth.

## 4. Classification of examination

### A. Classification by patent procedure

Examination is divided into the following by its procedure

- ① Examination of a patent applied
- ② Examination of opposition to patent (patents registered before July 1, 2007 only)
- ③ Re-examination before a trial
- ④ Examination of application for extension of patent period

#### (1) Examination of a patent applied

This is divided into formal examination and substantive examination, depending on the object of examination. In the former, the Commissioner of KIPO examines whether or not an application meets the form and procedure of the law while in the latter, an examiner examines whether or not an invention is patentable.

#### (2) Examination of opposition to patent

Opposition to patent means the process where a third party can make opposition to a patent granted, within a certain period, and the KIPO decides whether or not

the grant of patent is lawful, thereby improving the trustworthiness of a patent and serving the public interest. However, opposition to patent overlapped with request for patent invalidation and resulted in delay and waste of time and resources. Thus, the Patent Act revised on March 3, 2006 abolished opposition to patent and allowed any person, not just interested parties, to file request for patent invalidation within three months of the publication of the patent registration, thereby merging opposition of patent into it.

(3) Re-examination before a trial

Where a person appealing a decision to refuse patent amends the application within 30 days of appeal, the examiner shall re-examine whether or not the original reason for refusing patent is cured based on the amendment. This re-examination before trial saves cost and effort on the part of the applicant and also saves time.

(4) Examination of application for extension of patent period

The patent right is given an extension for testing where the use of a patented invention requires approval or registration by other statutes and also a long period of time to test the activity and stability which is necessary in order for the approval or registration. For this extension, the patentee shall file an application pursuant to the Patent Act and the examiner shall examine the application.

B. Classification by content of examination

This is divided into formal and substantive examination. In the former, the Commissioner of KIPO examines whether or not the application meets requirements of the law while in the latter, the examiner examines whether or not the invention has industrial applicability, novelty, inventive step, etc.

## II. Publication of application

### 1. Meaning

Contents of all patent application pending before the KIPO shall be published to the public by the request of the applicant or after one year and six months of the filing, in return for legal protection for the applicant. Publication of the application applies whether or not substantive examination is in progress, and could be referred to as an introduction of a type of non-examination regime.

The applicant can request the above even before the one year and six months period, which is called early publication.

## 2. Time for publication of application

The Commissioner of KIPO shall publish application after one year and six months from the filing date. Application with priority claim shall be published one year and six months from the following dates. With the introduction of a patent claim postponement on July 1, 2007, where the description is not amended to state a patent claim, the application shall be deemed withdrawn and thus shall not be published.

A. Priority claim of Article 54.1 of the Patent Act: filing date which is the basis of the priority claim.

B. Priority claim of Article 55.1 of the Patent Act: the prior filing date provided for in that article.

C. Multiple priority claims of Article 54.1 or 55.1 of the Patent Act: the earliest of the filing dates which are the basis of the priority claim.

Applications are published after one year and six months from the filing date because applications by foreigners have to be considered too. That is, for foreigner's application with priority claim, regarding time of filing and requirement for patentability, time for application publication is based on the first filing date. So, the period of one year and six months has been decided, considering the following: the period for domestic filing of application with priority claim (one year from priority date), submission of written proof of priority after filing (one year and four months from priority date) and period required for production of a publication gazette.

## 3. Legal effect of publication of application

This is divided into effect against the public and against the applicant. Regarding the public, the public is provided technical documentation and also an opportunity to submit data which can be used in the examination, thereby indirectly allowing them to participate in the examination process.

Regarding the applicant, publication expands the scope of monetary damage which he will be entitled to if a third party uses the invention commercially and industrially and expands the scope of the first-to-file application.

### A. Claim of damage

Publication renders the invention public and if a third party uses it commercially and industrially without justification, the applicant will suffer loss. An applicant can warn the infringer in writing during the period from the publication to patent registration.

When warning the infringer, an applicant is entitled to the amount of money ordinarily expected to earn out of the use of invention from the date of warning to the date of patent registration. Even if there was no warning, where the infringer knew it, the applicant has the same remedy from the date of knowledge to the date of patent registration.

#### B. Status of expanded first-to-file application

Unlike general cases, under Article 29.3 (publication of application), a first-to-file application is not limited to a patent claim but extends to a drawing and a detailed explanation of the invention of the description.

#### C. Request for research of data

Where the Commissioner of KIPO deems it necessary to speed up examination, he can request specialized research institutions to research the prior art. This can be done after publication of application because application must be kept confidential until then.

#### D. Restriction on amendment

Amendment used to be restrained after one year and three months from the filing date. However, the Patent Act which was revised on February 3, 2001 abolished this conditional period to allow examination within the period. In an application with a priority claim the starting date is the earliest application date.

#### E. Publication as technical documentation

The Commissioner of KIPO shall publish the entire application in the publication gazette.

#### F. Request for documents related to patent application, etc.

A person can request the Commissioner of KIPO for documents on patent application and so forth after publication of the application.

### 4. Early publication of application by request

#### A. Meaning

If necessary, an applicant can request the Commissioner of KIPO for publication of application before one year and six months from the application and the Commissioner shall publish it in the official gazette according to the Ministry of Commerce, Industry and Energy Decree.

## B. Purpose

Examination can take a long time and thus delay industrial application for an applicant who prefers stability in conducting business. Also an applicant has no protection until publication of the application, causing a problem for products which have a short life cycle.

With the introduction of this, inventions which have applied for a patent has more protection through warning to a third party, earlier entitlement to damage, and so forth.

## C. Request for early publication of application

### (1) Requester

This is an applicant or a successor. Each joint application can also request an early publication of the application (Article 11).

### (2) Submission of request

Applicant shall submit a request to the Commissioner of KIPO.

### (3) Time of early publication

This can be done simultaneously with the patent application.

## III. Request for examination of application

### 1. Meaning

If each and every application has to be examined, it will result in wasting of administration resources, increased cost to applicant, delay in patent procedure and loss of value for a patent.

Patent application shall be examined only if requested.

### 2. Content

#### A. Object of examination request

An application has to be pending before KIPO, excluding withdrawn, abandoned or invalidated application.

Since divisional and duplicated applications are separate from the original, they have to be separately requested for examination. So does an application with domestic priority claims. An application without a patent claim has to be amended to state patent claim to be examined, but a third party can request an examination even if the patent claim is missing. In such case, an applicant shall state the patent claim within three month from being notified of the third party request (within one year and six months from application at the latest).

## B. Requester

Anyone can request examination. However he shall be a patentee in Korea. A foreign resident can request through a patent administrator.

## C. Period to request examination

Examination shall be completed within five years from application. In an application with a priority claim, it shall be from the actual application while in divisional or duplicated applications, it shall be the original application because the application is deemed to move back, or 30 days from the divisional or duplicated application if the 5 year period has already expired.

In international applications, the applicant can request examination after submitting a translation of the description, patent claim, etc. submitted on the international filing date and after payment of the fee within two years and seven months from priority date (“domestic submission date”). Also, for international applications filed in foreign countries under the patent cooperation treaty, the starting date for examination request shall be the date of the international application.

## D. Procedure for examination request

### (1) Procedure for examination request

A request shall be submitted to the Commissioner of KIPO. Also, a fee has to be paid. Request shall state the name and address of the requester and the date and object of request. Where request and application are filed simultaneously, the applicant may simply indicate such fact on the application.

### (2) Examination request by third party

In such case, the Commissioner of KIPO shall notify the applicant. This is to allow the applicant to amend the description or drawing.

## 3. Legal effect of examination request

### A. Publication of examination request

If examination request is made before publication of application, such fact shall be indicated at the time of publication. If made after, such fact shall be published in the patent gazette immediately.

### B. Notice of request for application examination

If a person other than the applicant requests examination, the Commissioner of KIPO shall notify the applicant in order to give time to prepare for the examination procedure.

### C. Initiation of substantive examination

This is done by the order of examination requests while formal examination is done by the Commissioner of KIPO at the time of the application. However, the Commissioner can first examine the application which he deems requires urgent processing.

### D. Withdrawal of examination request prohibited

Withdrawal of examination request is prohibited.

### E. Request of preferred examination

The Commissioner of KIPO can conduct preferred examination for an application if he decides that the invention is being used by a third party for profit after the filing date, or that such application requires urgent processing.

## IV. Examination per claim

### 1. Meaning

Under previous law, examination is done for an application as a whole, so even if a single claim has cause of refusal, the entire application is refused. Thus, when reason for refusal is not provided claim by claim, the applicant may not be able to take appropriate actions such as amending or abandoning a specific claim and fails to obtain a patent. The revised Patent Act (promulgated Jan 3, 2007, effective Jul 1, 2007) addressed this issue by requiring a claim-by-claim examination, so that the applicant can easily find the claims with cause of refusal.

### 2. Content

Current law requires that where application with multiple claims is refused, reason for refusal shall be given specifically for all relevant claims.

## V. Preferred examination

### 1. Meaning

The Commissioner of KIPO may direct an examiner to examine an application in preference to another, where a person other than the applicant is considered to commercially and industrially use the invention claimed in the patent application after the laying open of the application, or where urgent processing of the patent application is considered necessary as prescribed by the Presidential Decree. This is an exception to the request for examination in that examination is made regardless of the order of examination request.

## 2. Content

### A. Object

#### (1) Application requested for examination

Applicant can request preferred examination simultaneously with requesting an examination.

#### (2) Third party uses invention for profit after publication of application

A third party uses an invention for profit after publication of application

#### (3) Application prescribed by Presidential Decree

An application which is deemed to require urgent processing and prescribed by Presidential Decree is as follows (Article 9 of Presidential Decree)

#### **【Presidential Decree】**

Article 9 (Object of preferred examination) ‘Application prescribed by Presidential Decree’ in Article 61 of the Act is one of the following, among published applications, and designated by the Commissioner of KIPO.

1. Application in defense industry
2. Application useful for prevention of pollution
3. Application directly related to export promotion
4. Application regarding the work of a central or local government (including application regarding works of public schools prescribed by Higher Education Act and filed by technology transfer organization set up within public schools pursuant to Article 9.1 of the Technology Transfer Promotion Act)
5. Application by a company certified to venture according to Article 25 of the Act on Special Measures for the Promotion of Venture Businesses
- 5-2. Application by a small or medium company selected as promoting technical innovation according to Article 15 of the Technical Renovation of Small and Medium Companies Act
6. Application regarding output from new national technology support or a quality certification project
7. Application which is the basis for a treaty based priority claim (limited to application pending before foreign patent agency by priority claim based on such application)
8. Application whose invention an applicant is using or preparing to use
9. Application directly related to electronic commerce
10. Application on which the Commissioner of KIPO and a foreign head of a patent agency agreed for preferred examination

## B. Request

### (1) Person who can make request

Anyone can make a request except for when the application is in regards to work of the central or local government, only those entities can make a request.

### (2) Submission of request and written proof

#### (A) Submission of request

Requester shall submit to KIPO (application service team) or KIPO Seoul office (application and registration division) a request (attached form #22 to Ministerial Decree), explanation (written proof attached), power of attorney if necessary, and anything else which is necessary.

Requester shall pay a fee according to the rules of payment of a patent fee to a bank. Where a third party is deemed to use an invention commercially and industrially after publication of the application, the requester shall state in the request specific facts. Where an application is deemed to require urgent processing, the applicant shall state in the request specific reasons.

#### (B) Preparation of explanation for preferred examination request

The explanation shall state the following

i) Requester shall pay to banks a fee according to the rules on payment of patent fee, etc. Where a third party is deemed to use an invention commercially and industrially after publication of the application, the requester shall state in the request specific facts.

ii) Where an application is deemed to require urgent processing, the applicant shall state in the request specific reasons.

### (3) Decision of preferred examination

The Commissioner of KIPO shall transfer document on preferred examination to the relevant examination office. The relevant examiner shall decide whether or not the application requires (merits) preferred examination within 15 days from acceptance of the document. Where documents are significantly flawed, examiner can order amendment within one month.

### (4) Preparing notice of result of preferred examination and the notice

If decided, preferred examination shall be initiated within 2 months from the date when a preferred examination notice was sent, and the final result shall be notified to the requester and applicant.

(5) Dismissal of request for preferred examination

Examiner shall dismiss request in the following scenarios; fees shall be returned.

- i ) where it is not an object of preferred examination or does not meet the requirement
- ii) where request or the attached document is significantly flawed
- iii) where a third party's use of the invention is with the consent of the applicant

### 3. Legal effect of preferred examination decision

Other than the fact that such application is examined prior to other applications, there is no other effect regarding patent requirement or order of application.

## SECTION 2 EXAMINATION OF APPLICATION

### I. Examination

#### 1. Meaning

This is divided into substantive examination whose result can be a cause for the decision to refuse a patent and formal examination whose result can be the cause for notice to the Commissioner of KIPO's order to amend.

##### A. Formal examination

In the formal examination, the Commissioner of KIPO examines whether or not the application filed by an applicant meets the requirements of patent law.<sup>31)</sup> This contrasts with the substantive examination which examines requirements for patentability and conducts in various procedures for the patent. Applicants and claimants are required to follow certain methods in order to achieve a smooth administration of the patent by standardizing the form and procedure of patent.

Where, as a result of formal examination, a procedure cannot be deemed effective because it lacks essential requirements and cannot be cured by amendment, the relevant document is returned as unlawful. However, where the defect of the document does not amount to a cause for return, amendment is ordered.

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31) Formal examination is based on Article 46 of Patent Act (procedural amendment), Government agency's inherent power to examine whether or not submitted documents are complete, and Article 11 of the Ministerial Decree (return of document).

## B. Substantive examination

In a substantive examination, an examiner examines whether or not an invention stated in the patent application is patentable. This is done in principle by the examiner but the general public can sometimes participate therein by provision of information.

## 2. Qualification of examiner

### A. Legal status of examiner

An examiner examines an application for, or appeal to, a patent and is appointed by the Commissioner of KIPO. Thus, an examiner is subordinate to the Commissioner.

However, examination by an examiner is independent of the Commissioner of KIPO in that its qualification is separately prescribed in the Presidential Decree and the result of examination can only be changed by the Intellectual Property Tribunal or courts, not the Commissioner.

### B. Qualification for examiner

Examiner shall be a regular public official with a 5<sup>th</sup> degree of rank or higher belonging to KIPO or affiliated agencies, and shall have successfully finished a training program at the international patent training center. Public officials of corresponding rank with patent attorney license are exempt from training at the international patent training center.

## 3. Exclusion of examiner

### A. Meaning and purpose

For a fair and objective examination, the Patent Act provides for the exclusion of the examiner, similar to those of a judge or trial examiner.

### B. Cause for exclusion

- i) examiner or current or former spouse of examiner is the party of the case or the person appealing the patent (“parties”)
- ii) examiner and parties are current or former relatives
- iii) examiner is current or former legal representative of the parties.
- iv) examiner is current or former witness or expert witness of the case
- v) examiner is current or former counsel of the parties
- vi) examiner has direct interest in the case

## 4. Procedure for substantive examination

### A. Initiation

(1) Examination is done in the order of request. Where the request dates are the same, filing dates shall decide. In the case of divisional or duplicated application, original application shall be given preference.

(2) Examination once initiated shall be complete within 6 months from submission of intermediate document. Where it is necessary to withhold or delay examination due to conflict with prior application, consulting outside expert, trial or litigation pending, etc., examiner shall notify the applicant accordingly.

(3) For application cancelled, remanded, or re-examination before a trial, the examiner shall initiate re-examination in principle within one month from submission of the application package and shall notify the president of the tribunal of the result when examination is completed. Where it is impossible to initiate within one month, he shall notify the Commissioner of KIPO the reason.

### B. Notice of reason for refusal

Examiners shall examine regarding all causes provided by Article 62. In the initial notice of reason for refusal, all reason for refusal shall be notified, but in subsequent notice, notice shall only concern new reasons for refusal.

Below are reasons for refusal.

- ① Application is not patentable due to violation of Articles 25 (Capacity of Foreigners), 29 (Requirements for Patentability), 31~33 (Patent for a Plant Invention, Unpatentable Inventions, Persons Entitled to Obtain a Patent), 36.1~3 (First-to-File application) or 44 (Joint Application)
- ② Application by an unentitled person
- ③ Application violating treaty
- ④ Defective statement in description; requirement of single application not met
- ⑤ Where new items are added
- ⑥ Divisional or duplicated application exceeding the scope of description or drawing initially attached to the original application

However, according to the revised Patent Act (promulgated Jan 3, 2007 or effective Jul 1, 2007), as for the applications with more than 2 claims, it is requested for the patent examiner to record a specific reason for refusal for each claim (newly added Article

63.2). In addition, the condition that ‘only indispensable items for construction of invention should be stated’ was excluded from the reasons for refusal or ineffectiveness, allowing various types of claims to be recorded depending on the type of technology.

### C. Intermediate processing and conclusion of examination

#### (1) Examination by briefs, amendment, etc.

Briefs shall be submitted to respond to the reason for refusal pointed out by the examiner in the notice of reason for refusal within a designated period but it is not mandatory. Briefs and amendments shall be considered in comparison with the reason for refusal in order to decide whether or not the reason for refusal can be maintained.

#### (2) Flexibility in period for submitting intermediate document (Article 15.2)

In general the examiner notifies reason for refusal in two months. In the past, the Patent Act only had a provision for extending the period. However, revised law allows making a patent decision if requested by applicant, thus enabling speedy processing of the patent application.

#### (3) Whether or not to grant patent

Where, from examining application based on briefs and amendment, no reason for refusal is found, decision to grant a patent shall be made. Where reason for refusal is not resolved by a brief or an amendment submitted after notice of reason to refuse, decision to refuse patent shall be made.

### D. Providing information on patent application

In order to prevent an unpatentable invention from being patented and to promote a speedy and accurate examination, the Patent Act allows a person who has knowledge of a reason why the invention should not be patented to provide information. (Article 63-2)

While patent procedure is pending information provider can provide information that the application has reason for refusal and cannot be patented, along with proof, except for violation of requirement provided for in Article 42.8 or 45.

TABLE OF CONTENTS ::

## **CHAPTER 6**

### **PATENT RIGHT**



- SECTION 1  
CREATION OF PATENT RIGHT
- SECTION 2  
EFFECT OF PATENT RIGHT
- SECTION 3  
ASSIGNMENT AND  
JOINT- OWNERSHIP OF PATENT RIGHT
- SECTION 4  
TERM OF A PATENT RIGHT
- SECTION 5  
EXTINGUISHMENT OF PATENT RIGHT
- SECTION 6  
LICENSE
- SECTION 7  
REGISTRATION



## CHAPTER 6 PATENT RIGHT

### SECTION 1 CREATION OF PATENT RIGHT

#### 1. Registration of patent right

A patent right becomes effective upon the establishment of the patent registration. (Article 87.1) Where a person purporting to register a patent paid the patent fee or was exempt from paying the fee, the Commissioner of KIPO shall register the patent.

#### 2. Issuing of patent registration certificate

When a patent right has been registered, the Commissioner of KIPO shall issue a patent registration certificate to the patentee. Where a patent certificate does not coincide with the patent register or other documents, the Commissioner shall issue an amended certificate or a new certificate upon request or *ex officio*. Also, when a decision on a trial for amendment has become final, the Commissioner shall issue a new patent registration certificate in accordance with the trial decision.

#### 3. Items to enter in the patent register process

##### A. Patent register shall state the following items

(1) Creation, transfer, extinguishment, restoration, restriction on disposal or extension of the term of patent right;

(2) Creation, maintenance, transfer, modification, extinguishment, or restriction on disposal of an exclusive or nonexclusive license; and

(3) Creation, transfer, modification, extinguishment or restriction on disposal of a pledge on a patent right or an exclusive or nonexclusive license.

##### B. Where the description and drawing of a patented invention or the gist of the decision, trial ruling or judgment regarding appeal to the patent is registered in the patent register, the originals of such shall be part of the patent register.

## SECTION 2 EFFECT OF PATENT RIGHT

### I. Meaning

A patent becomes effective by its registration and the registration takes effect by writing in the patent register kept in the KIPO. A patent has an active effect, where a patentee can exclusively use the invention and a passive effect where a patentee can prevent others from using the invention. The active effect has the scope of having an effect and the passive effect has the scope of protection. Regarding active effect of the patent, Article 94 provides that “a patentee has an exclusive right to use a patented invention commercially and industrially unless the patent right is the subject of an exclusive license.” In regards to the passive effect, Article 97 provides that “the scope of protection of a patented invention is determined by the subject matter described in the claim.” Also, as an exception to a patent, the Patent Act has provisions for restricting its effect.

### II. Scope of effect

#### 1. Scope in place

According to the territorial principle adopted by the Paris Convention signed on March 20, 1883 for the purpose of international protection of industrial property, a patent is only in force in the country which conferred the patent.

#### 2. Scope in time

Patent is created by the act of KIPO and only has effect during the period<sup>32)</sup> prescribed by the law. If a patent is in force permanently, it will be against the public interest. Thus globally, a patent is only effective during the period which is sufficient for the inventor to reap the R&D costs and to make a reasonable profit.

#### 3. Scope of protection

A patent is only effective for the patented invention, and a patented invention refers to the invention stated in the patent claim of the description. Article 97 clarifies the scope of protection by providing that “the scope of protection of a patented invention is determined by the subject matter described in the patent claim.” Thus, an invention not stated in the patent claim is not protected by the patent right.

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32) The term of a patent right commences upon registration of the patent right and ends twenty years after the filing date of the patent application. (Article 88 of Patent Act)

### III. Content of effect

Article 94 provides that “a patentee has an exclusive right to use a patented invention commercially and industrially.”

#### 1. ‘Commercially and industrially’

Considering that the purpose of patent law is contributing to industrial development, personal or home use should not be prohibited.

There is no convincing legal authority on the meaning of ‘commercially and industrially’<sup>33)</sup> but the majority view is that it means something other than individual or home use.

#### 2. ‘Patented invention’

Patented invention means an invention which is patented, i.e., an invention after the registration and in its duration of protection for exclusive use.

#### 3. ‘Using’

##### A. concept of using

Using a patented invention means ‘using’ defined by Article 2.1.3 of the Act, so an act of using can be divided into invention of product, invention of process (invented process) and invention of process to manufacture product. (Article 2.3)

##### (1) Using of ‘an invented product’

Act of manufacturing, using, assigning, leasing, importing or offering for assignment or lease (including displaying for assignment or lease) of an invented product

##### (2) Using of ‘an invented process’

Act of using an invented process

##### (3) Using of ‘an invented process of manufacturing product’

Having both aspects of invention of product and invention of process, this includes acts of using an invented process and acts of using, assigning, leasing, importing or offering for assignment or lease (including displaying for assignment or lease) of a product manufactured by the invented process.

33) Theories are as follows: ① ‘working’ other than personal or at home; ② not limited to for profit working but referring to repeated and continual ‘working’ as business in a broad sense; ③ ‘working’ for the purpose of serving unspecified, general public directly or indirectly, etc.

## B. content of working

(1) Manufacturing: act of making things, including not only industrial manufacturing but assembling, constructing, correcting and combining components

(2) Using: act of using produced things or invented method in order to achieve purpose of the invention. Simply possessing, even if with the intention of using, is not using.

(3) Assigning: act of transferring ownership, with or without compensation. Independent contracting in law can be an assignment if it is an act of manufacturing and then delivering for compensation.

(4) Leasing: a temporary, unlike assigning, lending of things with or without compensation.

(5) Importing: act of bringing things from abroad into a domestic territory. Things in a bonded area has not been imported but producing patented products using imported goods as raw material or parts within the bonded area is deemed as domestic production.

(6) Offering: an individual, definitive expression of intention for the purpose of entering into a contract to assign or lease patented goods.

## 4. 'Monopoly'

Monopoly on use means a patentee's exclusive right to use the invention to the exclusion of others. Thus, where a third party uses a patented invention without justifiable authority, it is an infringement of the patent and the patentee can request the infringer to stop using the patent and is entitled to damages.

## IV. Restriction on effect

### 1. Meaning

Patent is an exclusive right to use an invention commercially and industrially and prevent others from using the invention, and since it could thus harm public interest, it is necessary to restrict the effect of a patent. Such restrictions come from Article 96 (Limitations on a Patent Right), Article 181 (Restriction on Effects of a Patent Right) and relationship with others.

## 2. Restriction from limitation of right

### A. Working a patented invention for research or testing purposes (Article 96.1.1)

Laboratories sometimes use others' patented inventions commercially and industrially in order to verify the effect of a patented invention. Such use can contribute to industrial development, so a patent does not prevent this act of using others' patent for R&D commercially and industrially.

'Research or testing purpose' is only acknowledged when the patented invention is a direct object of the research or testing, not a test instrument for another invention.

### B. Vessels, aircraft or vehicles merely passing through Korea, or machinery, instruments, equipment or other accessories used on vessels, aircraft or vehicles (Article 96.1.2)

A patent does not have an effect on vessels, aircraft or vehicles merely passing through Korea, or machinery, instruments, equipment or other accessories used on vessels, aircraft or vehicles. The reasoning is that damage is minimal in such cases and smooth international traffic needs to be maintained.

### C. Articles existing in Korea when the patent application was filed (Article 96.1.3)

This means only those existing in Korea when the patent application was filed, and that when it is lost, manufacturing a new one is an infringement to the patent. This provision is similar to the right of prior use in patent law. While a right of prior use consists of a non-exclusive license, this provision purports to protect such articles by putting them outside the effect of the patent.

### D. Prescription method and prescription medicine (Article 96.2)

The effects of a patent right for the invention of products used for diagnosis, therapy, alleviation, medical treatment or prevention of human disease ("medicines") that are manufactured by mixing two or more medicines, or for the invention of processes for manufacturing medicines by mixing two or more medicines, do not extend to acts of dispensing medicines under the Pharmaceutical Affairs Act or to medicines manufactured by such acts. This is to prevent confusion in medical clinics and contribute to promoting the health of the people.

### E. Restriction on Effects of a Patent Right Restored by a Retrial

Regarding patent restored by a retrial, in order to protect those who trusted the trial ruling that was finalized before, Article 181 excludes effect of the patent right from good faith use of an invention before registration of the request for retrial.

## 3. Restriction caused by relationship with others

### A. restriction from use, conflict

Where a patented invention uses or infringes on others' patent, utility model, design, or trademark filed earlier, a patentee, exclusive licensee or non-exclusive licensee of such patent cannot use the patented invention unless he has the others' consent or he has been granted a license based on Article 138.1 of the Patent Act. Thus, a patent filed later is restricted in its force because the patentee cannot use the invention himself.

### B. restriction by license

A patentee, who grants a license to others by his own will or by the law, is restricted in his exercise of the patent right by the scope of the license.

Thus, where a patentee grants exclusive license to a third party, his patent is restricted by the scope of the license. Also, a patentee's right is restricted by Articles 81-3.3 (Restoration etc. of a Patent Application and Patent Right by Late Payment or Remaining Payment of Patent Fees), 106 (Expropriation of Patent Right etc), 107 (Adjudication for the Grant of a Nonexclusive License), 138 (Trial for Granting a Nonexclusive License).

## SECTION 3 ASSIGNMENT AND JOINT-OWNERSHIP OF PATENT RIGHT

### I. Assignment of patent right

A patent is an intangible property and can be freely transferred by a patent holder. It can be transferred by legal acts such as sale, gift, exchange, investment, trust or by other events such as inheritance, judgment, auction or expropriation. Transfer by legal act requires transfer registration and transfer by other cause requires notification to the Commissioner of KIPO only.

## II. Joint ownership of patent right

Where two or more patentees jointly own a patent, they are registered as joint patentees in the register. Joint ownership of patent occurs by the filing of multiple applicants, assigning part of the patent or joint inheritance.

### 1. Working of jointly owned invention

A joint owner of a patent can freely work the patented invention without consent of other joint owners unless there is an agreement otherwise. Also, in principle, profit from using the patent invention belongs to the joint owner who used the invention.

### 2. Restriction on assignment

A joint owner of a patent cannot assign his share without the consent of other joint owners. The reason is that transfer of a share can have significant influence on other joint owners and their interests have to be protected.

### 3. Restriction on licensing

Where a joint patentee purports to create exclusive or non-exclusive license on his share, he needs consent from all other joint patentees.

### 4. Other

Where a joint patentee purports to create a pledge on his share, he needs consent from all other joint patentees.

Also, a patent trial regarding jointly owned patent must be requested by or against the entire joint patentees. Where a joint patentee abandons his share, it shall belong to other joint patentees by the ratio of their shares.

## SECTION 4 TERM OF PATENT RIGHT

### I. Meaning

A patent allows a patentee to reap profit from the exclusive use of an invention for a certain period of time in exchange for promoting technological progress. However, if the period is too long the public will have difficulty in using the invention and be harmed. Thus, unlike general ownership, a patent has a life span that is limited by law.

## **II. Term of a patent right**

### **1. Term**

A patent is effective from its registration to 20 years from the patent application, pursuant to Article 87.1, like UR/TRIPs, the U.S., Japan, EPO and Germany.

Where the applicant was not a lawful holder of right but a lawful holder was granted a patent pursuant to Articles 34 and 35, the term of the patent is 20 years from the next day of the application by a non-lawful holder according to Article 88.2.

### **2. Calculation of term**

The term of a patent is calculated pursuant to Article 14 and where the last day is a holiday, the period expires on that day because a patent can be exercised on holidays too.

## **III. Extension of the term of a patent right**

### **1. Meaning**

A patent has a limited term and where an approval or registration is required by other statutes in order to use the invention, or where a lengthy clinical trial or stability test are necessary, the term of such patent is actually shortened, resulting in an imbalance with other patents. Thus, where an invention cannot be used due to requirements of law, the term of the patent is extended by a certain period to compensate for the lost time.

### **2. Object of application for extended registration**

In order to extend the term of a patent according to Article 89 approval or registration by other statutes are necessary to use the invention, which requires a long time for testing of activity or stability and is designated by the presidential decree.

Article 7 of the presidential decree prescribes medical inventions requiring approval pursuant to Articles 26.1 or 34.1 and agrochemicals or agrochemical ingredients to be registered pursuant to Articles 8.1, 16.1 or 17.1 of the Agrochemicals Control Act.

### **3. Extended term**

The term of a patent can be extended for the period where the patent could not be used with a maximum of five years. Thus, the maximum term of a patent is 25 years from the date of application.

The period where a patent could not be used means the period required for obtaining a patent; that period is from the later of either when the test began or patent registration to the date when approval by other statutes was granted. Specifically, for drugs, the period is from the later of the date when the Commissioner of the Korea Food and Drug Administration approved the test plan and the date of patent registration to the date it was approved by the Pharmaceutical Affairs Act. For agrochemicals, the period is from the later of the date for registration or testing is applied to the testing by research institutions designated by Articles 8.2, 16.1, 16.2, and 17.1 of the Agrochemicals Control Act or patent registration date to the date when items or ingredients were registered.

#### 4. Application of extended registration

Anyone purporting to extend the term of a patent shall file to the Commissioner of KIPO an application stating the name and address of the applicant or agent (if necessary), patent number, patent claim, extension period, approval or registration by other statutes and grounds for extension (proof attached).

Licensees cannot apply for an extension of term, and in a joint patent application the application has to be filed by all joint owners.

Extension applications can be filed within three months from approval by other statutes and cannot be filed less than six months before the expiration of patent. This is to prevent hurting the trust of third parties.

#### 5. Examination of application for extending period of registration

This application is examined by an examiner and if no cause of refusal is found, the period is extended. Appointment of examiner is the same as in patent application. Examiners who participated in the prior determination are not excluded (Article 148.6), and in practice are preferred for efficiency's sake in examination.

In examining an application for extension, the examiner shall notify the applicant reasons for refusal in advance and provide an opportunity to submit briefs. (Article 63) Reasons for refusal are as follows.

- i) using the invention does not deem to require approval according to Article 89.
- ii) patentee or exclusive or non-exclusive licensee has not obtained approval according to Article 89.
- iii) extension period filed exceeds the period where invention could not be used.
- iv) applicant for extension registration is not the patentee in question.
- v) where extension was not applied by all joint patentees.

## 6. Registration of extension and its effect

Unless an examiner can find special cause of refusal, extension shall be allowed and the Commissioner of KIPO shall register extension in the register and publish it in the patent gazette.

Where a term of a patent is extended, the extended term begins from the next day of expiration and the extension only covers the use of the invention regarding the object of approval which was the basis for the extension.

## 7. Invalidation trial of registration of extension

Decision to register extension is not the object of opposition and where the extension has cause of invalidation, interested parties or examiner can request an invalidation trial for the extension.

# SECTION 5 EXTINGUISHMENT OF PATENT RIGHT

## I. Meaning

In principle, a patent loses effect at the expiration of its term, which is 20 years after the filing date. However, a patent can also be extinguished from abandonment, cancellation, etc, after which anyone can use the invention.

## II. Cause of extinguishment of patent right

### 1. Abandonment of patent

A patentee can abandon a patent by filing an application to erase the patent to the Commissioner of KIPO. However, where a patent is bound by another right, such as a license, consent by the holder of the right is required. Abandonment becomes effective by registration in the register.

### 2. Cancellation of patent right

A patentee is not obligated to use the invention. However, if a patented invention has not been continuously used in Korea for a period of two years or more from the date of an adjudication, then the Commissioner of KIPO may cancel the patent right *ex officio* or upon the request of any interested parties. (Article 116) Also, when a patent right is thus cancelled, it is extinguished and deemed never to have existed.

### 3. Invalidation of patent right

Where a trial decision invalidating a patent has become final, the patent right is deemed never to have existed (Article 133.3).

### 4. Non-payment of patent fee

A fee shall be paid to register and maintain a patent. Failure to pay such fee shall result in loss of the patent. The due date for payment is the day before the beginning of the term of a patent. Failing to meet the due date will result in having to pay twice the amount of the original fee and shall be due in six months.

Where a person purporting to register a patent or a patentee fails to pay part of the patent fee within the late payment period, the Commissioner shall order payment of the balance. In such case, twice the amount of the unpaid fee shall be paid within one month of the order.

Also, where a patentee or a person seeking to register a patent right fails to pay the patent fees within the period of late payment or fails to pay the remaining portion within the period of remaining payment for unavoidable reasons, the patentee or the person may pay late patent fees or pay the remaining balance within fourteen days of the date on which the reasons for the delay cease to exist, but not later than six months after the expiration date for either the period of late payment or the period of balance payment, whichever comes later. Notwithstanding Article 81.3, a person who has paid late or remaining patent fees is considered not to have abandoned the patent application, and the concerned patent right is considered to have existed retroactively on the date on which the period for paying the patent fees expired.

In the case of non-payment of the fee, application by the person purporting to register patent shall be deemed to have abandoned the application, and the patent is deemed to have been extinguished retroactive to the last day to pay the fee.

### 5. Non existence of heir

In the case of a patentee's death, the heir shall inherit the patent but in the absence of an heir, the patent shall be extinguished and the invention shall be freely used by all.

### 6. Expiration of term of a patent right

The term is 20 years and when extended, can amount to a maximum of 25 years.

## SECTION 6 LICENSE

### I. License

#### 1. Meaning

Patent is an exclusive right granted to a patentee in return for the patentee's promotion of technology and contribution to industrial development. A patentee in principle has right to exclusively use a patented invention but other people can also be allowed to use the invention. Thus, a license is a right by which a non-patentee can use a patented invention commercially and industrially. Licenses provide to a patentee having difficulties in using the invention an opportunity to utilize the patent while providing a third party a chance of using the invention, thereby helping industrial development. Using is defined in Article 2.3, as follows.

- i) Using 'an invented product': Act of manufacturing, using, assigning, leasing, importing or offering for assignment or lease (including displaying for assignment or lease) of an invented product
- ii) Using 'an invented process': Act of using an invented process
- iii) Using 'an invented process of manufacturing product': Having both aspects of invention of product and invention of process, this includes acts of using invented process and acts of using, assigning, leasing, importing or offering for assignment or lease (including displaying for assignment or lease) of a product manufactured by the invented process.

Even if a patentee has an exclusive right to use the invention, sometimes it is more advantageous to grant a license to a third party by the need of a patentee or for the good of the public and in such cases, license right, enabling use by third party, is necessary.

License is divided into exclusive license and non-exclusive license, which is then divided into non-exclusive license by approval, by force and by law.

#### 2. Scope of license

A patentee can grant license for all or part of the patent right.

##### A. Term

A patentee can grant license for a certain period of time.

##### B. Region

A patentee can grant license within a certain region. In the absence of a designated regional scope, the scope can be interpreted to be an appropriate region.

### C. Content

A patentee can license part of the use of an invention, such as sale or manufacturing. In the absence of a restriction of what type of use, the scope can be interpreted to be an appropriate type of use.

## 3. Types of license

### A. Classification by effect

Exclusive license allows a person to exclusively use a patented invention commercially and industrially within a certain scope while a non-exclusive license allows a person to use a patented invention without exclusivity.

### B. Classification by cause of creation

License is divided into license by permission created by agreement between the patentee and the licensee, forced license forcibly granted by the Government for public interest purpose, and statutory license created by patent law.

#### (1) Types of statutory license

- i) non-exclusive license by use of invention
- ii) non-exclusive license by prior use
- iii) non-exclusive license by using it before registering for invalidation proceeding request
- iv) non-exclusive license after the expiration of design
- v) non-exclusive license from transfer of patent by exercise of pledge right
- vi) non-exclusive license by prior user of patent restored by retrial
- vii) non-exclusive license by original holder of right losing patent by retrial
- viii) non-exclusive license on patent restored from late payment of fee

#### (2) Types of license by force

- i) license by national defense needs
- ii) non-exclusive license by patent trial
- iii) non-exclusive license by adjudication

## II. Exclusive license

### 1. Meaning

According to Article 94, a patentee has an exclusive right to use a patented invention commercially and industrially unless the patent right is the subject of an exclusive license, in which case the exclusive licensee has an exclusive right to use the patented invention

(Article 100.2). A patentee cannot use or profit from the patented invention within the scope of exclusive license, and multiple exclusive licenses cannot be granted in a single patent.

Exclusive license is exclusive and thus can be claimed against any third parties. It needs registration to take effect, however. (Article 101.1.2)

## 2. Creation of exclusive license

This is created by an agreement between the patentee and the licensee. Exclusive license takes effect through registration with the KIPO patent register. (Article 101.1)

## 3. Content of exclusive license

### A. effect of exclusive license

An exclusive licensee has an exclusive right to use a patented invention commercially and industrially within the scope determined by the agreement. Even the patentee cannot use the invention without the consent of the exclusive licensee. In the case of infringement on his license, an exclusive licensee has the right to take measures such as filing a lawsuit to request prohibition or prevention of the infringement and to claim damages.

Where an exclusive license is jointly owned, as in a joint patent, unless the joint licensees agree otherwise on the use of the invention, each joint licensee can use the invention without the consent of the other joint licensees.

### B. scope of exclusive license

A patentee can grant exclusive license for all or part of the claims. Also, a patentee can restrict the place, time, content or manner of use of the invention by an agreement.

### C. registration and transfer of exclusive license

Exclusive license has to be registered to take effect. Thus, the creation, transfer, change or extinguishment of an exclusive license and the creation, transfer, change, extinguishment or restriction of disposal of pledge on the exclusive license has to be registered in order to take effect.

An exclusive license is a separate property and can be assigned for which the consent of the patentee is required because of issues such as who will use the invention or how the use of the invention can influence the value of the patent. However, in the case of inheritance or other general succession, or where it is transferred along with the concerned business, notification to the Commissioner of KIPO, not consent of the patentee, is required. Creation or change of jointly owned exclusive license requires consent of all joint owners.

#### 4. Relationship between patentee and exclusive licensee

##### A. rights and duties of a patentee

When granting an exclusive license, a patentee shall guarantee to the licensee an exclusive use of the invention, for which the patentee shall perform the contract, cooperate in registration, obtain consent of the exclusive licensee to abandon patent or request correction trial and pay the patent fee so that the patent is not extinguished.

Even if an exclusive license is created, a patentee has a right to protect his name and the patent. Thus, when a third party infringes on the patent, a patentee can take remedies such as prohibiting infringement or claiming damages without the consent of the exclusive licensee.

##### B. Rights and duties of a licensee

An exclusive licensee when transferring his license by granting a non-exclusive license within the scope of his license or pledging on his license shall obtain consent of the patentee. Also, when an exclusive licensee has created a non-exclusive license or pledge, he shall obtain their consent in order to abandon his licensee.

In addition, when a third party uses the invention commercially and industrially without permission, the exclusive licensee can take remedies such as prohibiting infringement or claiming damage without the consent of exclusive licensee. Also, the exclusive licensee can request the patentee to perform the agreement and has the right of consent when the exclusive licensee abandons the patent or requests a correction trial.

#### 5. Extinguishment of exclusive license

An exclusive license is extinguished by the extinguishment or term expiration of the patent or exclusive license, revocation, cancellation, abandonment or confusion of the contract or expropriation of the patent. Specifically, expiration of the patent term or revocation, cancellation or abandonment of the contract has to be registered to take effect.

### III. Non-exclusive license

#### 1. Meaning

Non-exclusive license allows the licensee to use a patented invention commercially and industrially within the scope of registration. It differs from an exclusive license in that it is not exclusive and so multiple non-exclusive licenses can co-exist. In a non-exclusive license, both patentee and licensee can use the invention, thus contributing to industrial development. Also, where it is necessary for the Government to restrict the patent right to a certain degree, a non-exclusive license can minimize the scope of restriction.

## 2. Non-exclusive license by consent

### A. Meaning

In general, a non-exclusive license is created by an agreement between the patentee or the exclusive licensee and a person seeking to use the patented invention. This is a non-exclusive license by consent or by agreement.

This license is not exclusive and can only be claimed against the licensor. Thus, where a third party infringes on the patent, the licensee can only take remedial actions indirectly, through the patentee or exclusive licensee.

### B. creation of non-exclusive license by consent

A non-exclusive license is basically created by the parties' agreement. Also, it does not need registration to take effect. When registered, however, this license can be claimed against third parties including subsequent patentees or exclusive licensees. Transfer, change, extinguishment, restriction of disposal or pledge also has to be registered to be effective against third parties.

### C. content of non-exclusive license

The parties can agree to restrict non-exclusive license in the manner, period, place, content, etc of the use. Also a non-exclusive licensee can transfer or pledge the license by consent of the patentee (or exclusive licensee). (Article 102)

When agreement on the non-exclusive license is revised, it can be registered for revision. In a joint non-exclusive licensee, each joint licensee can use the invention without the other licensees' consent but needs consent of all licensees for transfer of his share.

Non-exclusive license by consent is extinguished by the extinguishment or term expiration of the patent or exclusive license, revocation, cancellation or confusion of the contract, or where there is no heir.

## 3. Statutory license

This license is created 'by law' where requirements of the Patent Act are met based on fairness to third parties and needs of national industrial policy without regard to the intention of the patentee.

### A. Non-exclusive license by job-related invention (Article 10 of Invention Promotion Act)

A job-related invention refers to an invention by an employee who is or has been engaged in the work related to the invention and falls within the scope of employer's work. Where an employee, officer, public official of an employer, legal entity, the state,

local government or their successor is patented for such, the employer, etc shall be granted a non-exclusive license on the patent by law.

An employer has no duty to pay compensation for job-related inventions and use of the invention without restriction on period, place and content of the working. However, in order to transfer, with the exception for transfers of the business where the invention is used, consent of the patentee is required. Establishment of patent *ex officio* also requires consent of the patentee.

#### B. Nonexclusive License by Prior Use (Article 103)

(1) This is a free of charge non-exclusive license granted to a prior user who has been using the invention in good faith before the patent application. It is granted when a person without knowing about the invention uses the invention before the application is filed or when a person learns from the inventor about the invention and uses or prepares to use the invention. 'Preparation of using' refers to preliminary acts required to begin the use and shall be determined objectively. Evidence of such use include a technical development plan, development meeting minutes, a written proof of purchase for essential materials, an experiment plan, experiment data, a drawing of the instrument, an estimate sheet for sale of the new product, notification to a government agency, application, a news article for the new product, an inventor's treatise, proof by third parties, and a written statement.

(2) Regarding theories supporting this, fairness theory asserts that preventing a person who was already using or preparing to use the invention in good faith at the time of the application from using the invention because of a patent is unfair because it overly protects the patentee and sacrifices vested rights. Industrial policy theory opines that prohibiting good faith party's use of an invention is against the goal of patent law and discarding equipment newly invested does not benefit the national economy.

(3) A licensee by prior use shall have nonexclusive license on the patent for such applied invention within the purpose of the invention or business being used or prepared for use. (Article 103) He can expand business within the same business purpose but shall not change the area of business because that is outside the purpose of the business.

#### C. Nonexclusive license for patent restored by late payment of patent fee

Where a person purporting to register a patent or a person using or preparing to use an invention or patent applied in good faith by a third party in Korea during the period from the expiration of the late payment period to the date of payment or the restricted

effect period, shall have nonexclusive license on the patent for such applied invention within the purpose of the invention or business being used or prepared for use. The nonexclusive licensee shall make reasonable payment to the patentee or exclusive licensee.

#### D. Nonexclusive License Due to Working before Registration of a Request for an Invalidation Trial (Article 104)

This is granted to a good faith licensee meeting one of the following criteria below. Good faith means not knowing that his patent has cause of invalidation. Using or preparing to use has to be done in Korea.

(i) Original patentee, where one of multiple patents granted for the same invention has been invalidated;

(ii) Original owner of a utility model right, where a patented invention and a device registered as a utility model are the same and the utility model registration has been invalidated;

(iii) Original patentee, where the patent has been invalidated and a patent for the same invention has been granted to an entitled person;

(iv) Original owner of a utility model right, where the utility model registration has been invalidated and a patent for the same invention as the device has been granted to an entitled person; or

(v) A person who, at the time of registering a request for an invalidation trial of an invalidated patent right or utility model right, has been granted an exclusive license, a nonexclusive license or a nonexclusive license on the exclusive license and the license has been registered.

#### 4. Forced license

This is a license established forcibly by the state for a third party regardless of the patentee's intention through due process of law when using the invention is deemed to advance national interest or when it is necessary to activate the use. This is intended for industrial development and public interest and is allowed to restrain private property to a degree with reasonable compensation to the patentee if necessary to achieve its goal. It is divided into forced non-exclusive license by national defense needs, by trial, and by adjudication.

A. right of working an invention granted for national defense (Article 106)

If a patented invention is necessary for national defense during a time of war, incident or other similar emergency, the Government may expropriate the patent right, use the patented invention or require a person other than the Government to use the patented invention. This is to ensure national security.

B. nonexclusive license by trial decision

Where a patentee or exclusive or non-exclusive licensee seeks to obtain, in vain, permission from a third party because the invention is in a relationship of use or conflict with the third party and thus cannot use the invention, the person may request for adjudication for the grant of a nonexclusive license. This is to achieve the goal of patent law (industrial development through the use of patented inventions) and the decision is given to the government agency in order to maintain balance between the patentee and licensee.

C. Adjudication for the Grant of a Nonexclusive License (Article 107)

This is granted by the Commissioner of KIPO upon request for adjudication by a person purporting to use the invention where an invention is not being used or insufficiently used and or where public interest or fighting unfair trade requires the use of the invention.

This is a reflection of Article 5.A of the Paris Convention or Article 31 of the WTO/TRIPs and purports to prevent the case where a patentee unjustifiably fails to use the invention or allows others to use it, thus hurting industrial development and public interest. The following are causes of adjudications prescribed by Article 107.

(i) Where a patented invention has not been used for more than three consecutive years in Korea, except for in natural disasters, force *majeure* or other justifiable reasons prescribed by Presidential Decree;

(ii) Where a patented invention has not continuously been used commercially or industrially in Korea on a substantial scale for three years or more without justification, or where the domestic demand for the patented invention has not been satisfied to an appropriate extent and under reasonable conditions;

(iii) Where using a patented invention non-commercially is necessary for the interests of the public; or

(iv) Where using a patented invention is necessary to remedy a practice determined to be unfair by the judicial or administrative process.

(1) Request for adjudication for public interest purpose

Where it is necessary to use an invention for public interest on a non-commercial purpose, adjudication can be requested. However, if it is required by public interest to protect the patent, a property right of an individual, it shall be interpreted narrowly. Public necessity means, for example, the need to use drugs quickly in order to improve the health and hygiene of the people.

In the above cases, where mostly urgency is required, consultation with patentee or exclusive licensee is not necessary. Also non-commercial use is required because if not, forced use is not justified. This reflects Article 31 of UR/TRIPs. Lastly, adjudication for this can be requested anytime.

(2) Request for adjudication to correct unfair trade

Where abuse of right by patentee results in unfair practices, forced use is allowed, which is an import from Article 31(k) of UR/TRIPs.

Here, unfair practices have to be found by judicial or administrative procedure and consultation with right holders is not required. Request can be made anytime.

(3) Request for adjudication to grant nonexclusive license on semiconductor technology

For semiconductor technology, a request for adjudication may be made only if necessary for public interest or antitrust purposes. Here prior consultation with patentee or exclusive licensee is not required and adjudication can be requested anytime.

(4) Procedure of adjudication

Anyone purporting to request adjudication shall submit to the Commissioner of KIPO a request for adjudication stating scope, price and period of non-exclusive license. Where exclusive license is granted, patentee and exclusive licensee shall be joint defendants. The Commissioner shall register in advance such request, send copies of request to those with registered rights for the patent and provide an opportunity to submit a brief. Before adjudicating, the Commissioner of KIPO shall solicit an opinion from the Intellectual Property Rights Dispute Committee and shall consider the need for non-exclusive license for each request.

## SECTION 7 REGISTRATION

### I. Meaning

Registration of industrial property rights is adopted in order to disclose the legal and factual status of the right by registering its creation, extinguishment, ownership, change, etc. in the register, to promote a clear and sound transaction for third parties as well as the parties, and to allow the industrial property market to function smoothly.

Patent registration is an act of writing in the patent register kept at KIPO patent related matters such as its establishment, change, extinguishment, etc., by *ex officio*, request of the parties, court or government agencies.

## II. Effect of registration

### 1. Create a right

Patent is created by an establishment registration. That is, it is created by an act of writing required items in the Patent Register. Thus, it can be said that an establishment registration has the effect of ‘creating’ a patent although a decision of the KIPO or Industrial Property Tribunal grants patent and payment of patent fee is also required. Without such a decision, registration does not ‘create’ a patent. Establishment registration does not guarantee the survival of a patent.

### 2. Effect a change in right

Transfer of patent, grant and transfer of exclusive license, and so forth shall be registered to take effect. Thus, registration is a requirement for change in right to take effect.

### 3. Effect against a third party

In some cases, registration allows some items to be asserted against third parties. Non-exclusive license by agreement becomes effective by agreement between the parties but cannot be asserted against subsequent patentees or exclusive licensees.

However, when registered, a non-exclusive license shall be acknowledged by subsequent patentees or exclusive licensees. Furthermore, when transfer, change or restriction of disposal is registered, non-exclusive license can be asserted against third parties as well.

## III. Publication of registration

### 1. Meaning

Publication of patent registration discloses to the general public content of an invention that has been decided to be patented after examination. It is intended to warrant a complete and fair examination and prevent patent disputes by allowing the general public to file opposition, and to prevent overlapping research by disclosing the patent.

## 2. Object

An examiner examines the positive and negative requirements of patentability prescribed by law and when no reason for rejection is found, the examiner shall grant a patent. Thereafter, the applicant shall pay the fee and the patent shall be registered and published.

## 3. Effect

### A. Opposition to patent

Where a patent has cause of invalidation prescribed in Article 133.1, anyone can file opposition to the patent within three months of the publication. This period cannot be shortened or extended.

### B. Provide inspection of filed documents

The Commissioner of KIPO shall provide filed documents and attached articles for public inspection for three months from publication.

### C. Determine scope of patent

Registering and then publishing a patent in Patent Gazette will provide technical documentation to third parties and will also determine the scope of patent.

### D. Expand scope of prior application

Where a patent is registered without publication of the patent application, expanded prior application status shall be recognized from the date of publication of registration.

### E. Publish patented invention

Invention is published at the time of publication of registration, especially when patent application was not published.

TABLE OF CONTENTS ::

# **CHAPTER 7**

## **IPT ' SPATENT TRIAL**



- SECTION 1  
IPT TRIAL SYSTEM
- SECTION 2  
PROCEDURE OF PATENT TRIAL
- SECTION 3  
TYPES OF IPT TRIAL



## CHAPTER 7 IPT'S PATENT TRIAL

### SECTION 1 IPT TRIAL SYSTEM

#### I. Meaning

A patent trial by the Industrial Property Tribunal ("IPT") is an administrative trial conducted by a panel of independent IPT trial examiners in order to solve disputes surrounding the KIPO examiner's act or the effect of a patent. Article 107.3 of the Constitution allows an administrative trial to be conducted before a judicial trial and since industrial property is different from other properties and requires special knowledge and experience, it is decided by specialists (trial examiners) of the IPT which belongs to the KIPO. Such trials of IPT can be appealed to the Patent Court, which is similar to an appellate court.

#### II. Nature of patent trial

An IPT patent trial is in its form an administrative trial where patent disputes are decided by panels of IPT trial examiners, but it is actually a quasi-judicial, quasi-civil procedure in consideration of the trial examiner's duty of independence.

#### III. Industrial Property Tribunal

##### 1. Composition

The Industrial Property Tribunal was established by the KIPO on March 1, 1998 to preside over appeals or opposition cases for patent, utility model, trademark and design and related investigations and research. Currently it consists of a President, 13 specialized trial divisions and an administrative office.

The IPT President appoints trial examiners and a presiding trial examiner of each trial division (a collegial body composed of 3 to 5 trial examiners). A decision is made by a majority of trial examiners of a division. Deliberation is held in private.

Qualifications for trial examiners are provided for in Article 18 of the Presidential Decree. Trial examiners make decisions independently, without direction from the KIPO Commissioner or the IPT President, and in order to maintain fairness, the law provides for exclusion and recusal.

## 2. Classification of IPT trial

### A. Classification by structure of trial

(1) Inter parte trial: This is an adversarial system of petitioner and respondent. Examples include trials to invalidate a patent (Article 133), trials to invalidate registration of a patent term extension (Article 134), trials to confirm the scope of a patent right (Article 135), trials to invalidate a correction (Article 137) and trials to grant non-exclusive license (Article 138). In Principle, the losing parties pay the trial cost.

(2) Ex parte trial: This is a petitioner-only trial such as a trials on appeal to reject or cancel a patent (Article 132-3), trials on appeal to dismiss an amendment<sup>34)</sup> and trials for correction (Article 136).<sup>35)</sup> Petitioners pay the trial cost.

### B. Classification by independence of trial

#### (1) Independent trial

This trial is initiated, conducted and concluded independently of other trials, and includes inter parte and ex parte trials.

#### (2) Collateral trial

This trial is initiated, conducted and concluded collateral to other pending trials. Trial for exclusion and recusal (Article 152), trial for participation (Article 155) and trial for investigation and preservation of evidence (Article 157) belong here.

## 3. Relationship with Patent Court

(1) Pursuant to Article 186 of the Act, the trial system related to IPR is a three part procedure which consists of the Industrial Property Tribunal, the Patent Court and the Supreme Court, and a person cannot file lawsuit in the Patent Court without first requesting a trial before the IPT. When a lawsuit is filed, the Patent Court shall immediately notify the President of the IPT.

(2) If necessary, a lawsuit can be continued until the relevant IPT trial becomes final or vice versa.

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34) Patent Act (revised Feb 3, 2001) abolished 'IPT trial on appeal to dismissal of amendment' for patent and utility model, effective as of Jul 1, 2001, and allowed appeal to such trial by using 'IPT trial on appeal to patent rejection.'

35) Classified as inter parte IPT trial, in practice

(3) When a patent or exclusive license infringement action is brought or concluded, the court shall notify the IPT President accordingly and when a responding patent invalidation trial is requested, the IPT President shall notify the court. The same applies to dismissal of a trial request and withdrawal of a trial or application.

## SECTION 2 PROCEDURE OF PATENT TRIAL

### I. Request for trial

#### 1. Mandatory items of the request

A person seeking a trial shall file to the IPT President a request stating the following below. If the request is defective, the IPT President shall order an amendment within a designated period and if not amended, the request shall be dismissed.

##### A. Inter parte trial

- ① Name and address of parties (for legal entity, name and principal place of business),
- ② Name and address (or principal place of business) of the counsel if necessary (for a patent firm, name, address and designated patent attorney)
- ③ Identification of the case
- ④ Prayer for relief <sup>36)</sup> and reasoning<sup>37)</sup>

Depending on the type of trial, other items or written attachment can be added.

##### B. Ex parte trial

For trial on appeal to rejection or cancellation of patent,

- ① Name and address of petitioner (for a legal entity, name and principal place of business),
- ② Name and address (or principal place of business) of the counsel if necessary (for a patent firm, name, address and designated patent attorney)

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36) Conclusion of the request for IPT trial, which shows the type and content of decision sought by the petitioner and binds the IPT. Thus, it is required to state the conclusion of the decision which the petitioner requests concisely and clearly. Also, it has to mention cost of the IPT trial. For example, a request for trial to invalidate a patent has to state, "Patent for invention #\_\_ is hereby invalidated. Respondent shall pay for the cost of trial."

37) Facts which support the petitioner's claim and for which the petitioner bears the burden of production and proof

- ③ Date and number of application (for a decision to cancel patent, registration date and patent number),
- ④ Name of invention
- ⑤ Date of decision rejecting or canceling patent,
- ⑥ Identification of the case,
- ⑦ Prayer for relief and reasoning

## 2. Amendment of request; Gist of request

### A. Scope of amendment

The gist of a request for a trial cannot be amended, and an amendment of 'reasoning', which is a fact necessary to specify prayer for relief is not deemed an amendment of the gist. (Article 140.2)

Gist of a request means the parties and object of a trial. Regarding the parties, identification of the case and prayer for relief, amendment is allowed within the scope of identicalness.

### B. Cases falling under the amendment of gist

#### (1) Amendment of parties, etc.

This is an amendment of gist, except when the parties remain identical, such as a typo. Thus, supplementing or changing the name of a representative of a legal entity is allowed.

#### (2) Amendment of identification of case

Amending the number of an application or a right is allowed only when the object of the trial remains identical, such as a typo. Thus, it is not allowed to change a trial to invalidate a patent to a trial to confirm the scope of a patent right, or to change a case number.

#### (3) Amendment of prayer for relief

Changing a claim stated in the prayer for relief, adding a claim or changing the case is an amendment of gist. Thus, changing a trial to invalidate a patent to a trial to confirm the scope of a patent right is an amendment of gist. However, where a patented invention which is the object of the patent invalidation trial is amended by an amendment decision, making the amended invention the object of the IPT trial is not. Also, withdrawing a patent invalidation request regarding some of the claims is allowed as a reduction of prayer for relief.

### 3. Mandatory written attachment to the request

A. A representative or an administrator designated by an association or a foundation that is not a legal entity may request an examination of a patent application, file an opposition to the granting of a patent, or appear as a petitioner or respondent in a trial or a retrial on behalf of the association or foundation. (Article 4)

B. A minor or a person of limited or no capacity shall attach a written proof of authority of statutory agent or a written proof that they can conduct legal affairs independently. (Article 3 of the Act, Article 7 of Ministerial Decree)

C. Where counsel, which in this Act includes patent administrators, purports to represent a person who is initiating a patent-related procedure before the KIPO, counsel shall present written proof of power of attorney. (Article 7 of Act, Article 5 of Ministerial Decree)

D. Where joint applicants select a representative, a written proof thereof shall be attached. (Article 11 of the Act, Article 6 of Ministerial Decree)

E. A successor to the right to obtain a patent shall attach a written proof of succession and if the right is jointly owned, then consent of other joint owners is necessary. (Article 38 of the Act, Article 7 and 26 of Ministerial Decree)

F. Trial to correct, to invalidate, or to invalidate a correction: The following shall be attached.

- ① Consent of the exclusive licensee, pledge, or non-exclusive licensee by a job-related invention or by an agreement, if necessary
- ② A corrected description or drawing

G. Trial to confirm the scope of a patent right: explanation or drawing (description or drawing which can be compared to the patented invention – Article 140.3) shall be attached

H. Power of attorney, nationality certificate, etc. in a foreign language: a Korean translation shall be attached. (Article 4 of Ministerial Decree)

I. Necessary number of copies of request to deliver to the opposing party shall be attached. – Old law (Article 3.2~3.4 of Ministerial Decree deleted on May 17, 2003)

J. Where the petitioner changed his/her name, a written proof shall be attached. (Article 9 of Ministerial Decree)

## II. Party

Petitioner and respondent in an IPT trial or retrial

### 1. Capacity to be a party

In an IPT trial, a person who is able to own a right based on the Civil Act or other laws, i.e., natural person and legal entity, can be a party. A non-legal entity association or foundation can be a party too if it has a representative or an administrator.<sup>38)</sup> However, among those without a domicile or a place of business in Korea, foreigners cannot enjoy patent or related rights except in certain cases.<sup>39)</sup>

### 2. Qualification of a party

#### A. Petitioner

(1) Ex parte trial

A person suffering rejection or cancellation of a patent or his/her successor

(2) Inter parte trial

(A) Trial to invalidate: Interested party or KIPO examiner<sup>40)</sup>

(B) Trial to invalidate registration of patent term extension: Interested party or KIPO examiner

(C) Trial to confirm the scope of a patent right: Right-holder or interested party

(D) Trial for a correction: Right-holder

(E) Trial to invalidate a correction: Interested party or KIPO examiner

(F) Trial to grant non-exclusive license: Holder or exclusive or non-exclusive licensee of a right in the use or conflict relationship

#### B. Respondent

An ex parte trial or a trial to correct has no respondent. In an inter parte trial, the right-holder is the respondent but in a positive (offensive) trial to confirm the scope of a patent right, an interested party is the respondent.

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38) 97 Hu 3371 decision (Supreme Court, Jan 26, 1999) (“Administrator of a company under Company Reorganization Act has sole authority manage and dispose of the company’s business and property, and litigation related to a company’s property includes an IPT trial to invalidate the company’s utility model. Thus, in such OPT trial, the administrator, not the company, can be a respondent.”)

39) Article 25 of Patent Act

40) 86 Hu 171 decision (Supreme Court, Mar 14, 1989) [“Patent Act (Utility Model Act) allowed KIPO examiner to request IPT for patent invalidation trial for public interest purpose. Thus, the KIPO examiner need not have examined the utility model or one at the time of IPT decision.”]

### 3. Request for IPT trial and interest

#### A. Interest in trial

The civil procedure principle of 'no interest, no action' applies to patent law and thus request of trial is limited to interested parties. If not, the request is dismissed.

#### B. Scope of interested parties

Interested parties include a person who uses the same invention or manufactures or sells the same equipment or product as is related to the trial. Also included are those persons who use the same kind of inventive process or manufactures or sells the same kind of equipment or product, and a person who is expected, from the nature of the business, to employ the patented process. Also, a person who may be disadvantaged in the present or future when the invention to be invalidated is patented, and a person who intends to manufacture and sell the product in question are included.

#### C. Proof of interest

If a petitioner of trial is determined uninterested, the request shall be dismissed for being unlawful. Thus, a request for trial shall state 'interest'. Where such claim is lacking or insufficient, the party shall be ordered to amend it and if not amended, the request shall be dismissed.<sup>41)</sup>

#### D. Determination of interest

Whether or not a person is an interested party has to be decided *ex officio* and decided at the time of an IPT decision, not at the request of a trial.

### 4. Joint IPT trial

A. Where multiple parties can request a trial about the same patent, they can do it altogether or individually. In a quasi-mandatory joint trial, unlike a genuinely mandatory joint trial, a missing party cannot be added after the expiration of the statute of limitation. Since Article 139.1 provides that where multiple parties may request an invalidation trial or a trial to confirm the scope of a patent right for the same patent, the request may be made jointly; such joint trial is a quasi-mandatory joint trial.

B. Where joint owners of a patent or a right to obtain a patent request a trial, they shall request a trial or become respondents altogether. Thus, where a single joint owner

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41) 82 Hu 58 decision (Supreme Court, Dec 27, 1993) ("It is an insufficient examination of whether or not request for an IPT trial is lawful to jump to the conclusion that petitioner of this case is an interested party because there is no dispute.")

requests a trial, it shall be deemed unlawful pursuant to Article 142 and shall be dismissed for being unamendable.

## 5. Correction of party

Parties can be corrected within the scope of being identical to current parties and a substantial change shall be prohibited.

### III. Trial examination

#### 1. Meaning

The IPT trial is a series of processes where the trial examiner gathers and determines data in order to make a decision. Unlike a civil action judgment which only binds the parties, an IPT decision binds third parties too. Thus, in addition to elements of the adversarial system, it has elements of an inquisitorial system.

#### 2. Trial examination of formality and lawfulness

##### A. Formality

This examines whether or not a request for trial meets the formalities prescribed by the law. Thus, where a request violates Articles 140.1,3~5, 140-2.1, 3.1 or 6, or fee for the request has not been paid, or formalities of the law have not been obeyed,<sup>42)</sup> the presiding trial examiner of the division shall order an amendment within a designated period and if not amended, shall issue a written dismissal of the request with reasons called a dismissal order. A party contesting this order can file a lawsuit in the Patent Court.

##### B. Lawfulness

Examination of lawfulness concerns whether or not a request of trial itself is lawful. Where a request for trial contains defects that cannot be corrected by an amendment, the request may be rejected by a ruling without giving the respondent an opportunity to submit a written answer. (Article 142) This is called dismissal of trial and a dismissed party can file an appeal in the Patent Court. Trial is dismissed when some of the joint owners are missing as a party, when the principle of ne bis in idem is violated, when an uninterested party brings an action, etc.

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42) In KIPO practice, the period is one month. If requested by the party, it is extended by the same period.

### 3. Method

This includes an oral hearing and a documentary examination. Documentary examination is where a trial is conducted with documents submitted by the parties; it is clear, easy to understand and readily verifiable, but over-burdened with documents and time-consuming. Meanwhile an oral hearing is where a trial is conducted by oral argument and evidence; it is lively and easy to spot and organize issues, but going to court can be burdensome and complicated facts are hard to explain in an oral hearing.

IPT trial proceedings are conducted by oral hearing or documentary examination. However, when a party requests an oral hearing, the trial has to be conducted by oral hearing unless a decision can obviously be made on the basis of a documentary examination alone. In practice, documentary examinations are the rule.

In holding an oral hearing, the trial examiner shall determine the date and location and notify the parties in writing. In order to preserve the content of the hearing, the presiding trial examiner shall have a clerk designated by the IPT President prepare a trial record to be signed by the preparer and the presiding trial examiner. Oral hearing shall be held in public unless public order or good moral may be harmed.

### 4. Principle

Unlike a civil litigation conducted in an adversarial system, the IPT patent trial adopts an inquisitorial system where the trial examiner plays an active role because a patent trial needs a solution effective against third parties due to public interest and industrial policy while a civil litigation has the goal of dispute-solving between the parties and thus must respect the intention of the parties to the utmost. An inquisitorial system is divided into a substantive and a procedural one.

#### A. Procedural inquisitorial system

Here, a trial examiner conducts trial *ex officio*, not by motions of the parties.

##### (1) Conducting of trial

Notwithstanding the failure of a party or intervenor to take any proceedings within the period prescribed by law or designated under the Act, or the failure to appear on the designated date (Article 154.4), the presiding trial examiner may proceed with the trial proceedings. (Article 158) Thus, even when one of the parties is absent, oral hearing shall be conducted and the other party is not deemed to have made a confession unlike a civil action.

Also, when examining two or more trial proceedings where one or both parties are the same (e.g., positive or negative trial to confirm the scope of a patent right), a trial examiner may examine the cases together or separately. (Article 160)

(2) Setting and changing of date and suspension of procedure

The presiding trial examiner can set or change the trial date and extend the period (Articles 15, 154.4, etc), and trial examiner can suspend a procedure or order the undertaking of a suspended procedure. (Articles 19~21, 23, etc)

B. Substantive inquisitorial system

This system allows the trial examiner to take an active role in gathering and investigating evidence without being bound by the parties' assertions.

(1) *Ex officio* trial examination

For the sake of public interest, grounds that have not been pleaded by a party or intervenor in a trial may be examined; however, in such cases, the parties and intervenors must be given an opportunity within a designated period to state their opinions regarding the grounds. (Article 159.1) For example, in a request for patent invalidation, the trial examiner can base the decision on grounds not argued by the petitioner. However, the examiner has to provide the parties and intervenors with an opportunity to present opinions within a designated period. An IPT decision violating this provision is unlawful because it is a mandatory provision intended to prevent disadvantage to the parties and warrant fairness.

An examination may not be made on the prayer for relief not requested by the petitioner. (Article 159.2) Thus, *ex officio* trial examination is limited to the reasoning supporting prayer for relief.

(2) Investigation and preservation of evidence

For an IPT trial, evidence may be taken or preserved upon the request of a party, intervenor or interested party or *ex officio*. (Article 157.1) The provisions of the Civil Procedure Act related to taking and preserving evidence apply *mutatis mutandis* to any taking and preserving of evidence. (Article 157.2) A request to preserve evidence must be made to the President of the IPT before a request for a trial and to the presiding trial examiner of the case while the trial is pending. (Article 157.3) Also, where evidence has been taken or preserved *ex officio*, the presiding trial examiner shall notify the parties, intervenors and interested parties and shall give them an opportunity to submit written opinions within a designated period. (Article 157.5)<sup>43)</sup>

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43) The court investigating evidence *ex officio* shall make record of it and provide the parties to state opinions. (Article 82.1 of Trademark Act, Article 159.1 of Patent Act) This is a mandatory provision based on the public policy considerations. [94 Hu 241 decision (Supreme Court, Feb 9, 1996); 96 Hu 2104 decision (Supreme Court, Aug 29, 1997)]

## IV. IPT decision

### 1. Meaning

An IPT decision is the final expression and official decision made by the trial examiner on the request for trial following a mandatory examination on the merits. It is a document stating such decision in a format prescribed by law and becomes effective when its copy is delivered to the party, intervenor and a refused intervenor. The IPT trial is generally concluded by a decision, however, where a request does not meet legal formality, a trial can end with an order<sup>44)</sup> and also with a withdrawal of the request.

### 2. Items to be included in IPT decision

An IPT decision must state (i) number of the IPT trial; (ii) name and address of the parties, intervenors and counsels (and, if a legal entity, name and address of the business); (iii) identification of the case; (iv) conclusion of the decision; <sup>45)</sup> (v) reasoning for the decision; (vi) date of the decision; and (vii) signature of all trial examiners of the trial division. (Article 162.2)

In practice, in addition to the above, IPT decision includes (i) identification of the trial division; (ii) title; (iii) identification of the case; (iv) persons involved in the trial such as the parties and counsels; (v) date of the original decision; (vi) conclusion of decision; (vii) reasoning; (viii) date of the IPT decision; and (ix) names of trial examiners making the decision and their signatures.

### 3. Conclusion of IPT decision

#### A. Method of writing

This is the conclusion of the trial and the IPT's final answer to the request.

This shall be concise and clear and shall be stated so that the decision can be interpreted by the text itself. If not, such decision can harm legal stability and bring about additional disputes.

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44) An order to dismiss is made where the presiding trial examiner ordered amendment due to defect of formality such as non-payment of fee at the time of filing trial request or missing of grounds for request, but amendment was not made within designated period.

45) 88 Hu 97 decision (Supreme Court, Nov 14, 1989) 1("Conclusion of an IPT decision has to be specific on its face. IPT decision in this case states that the design described in target invention drawing and explanation belongs to but they are not attached to the decision, and thus such decision shall be cancelled.")

Regarding the IPT trial cost, where the law orders the petitioner to pay the cost, such as a trial on patent rejection, an IPT decision need not state it. However, in the inter parte trial, the decision has to expressly decide *ex officio* which party shall pay for it. Also, it has to decide which party shall pay the cost caused by objection to intervention.

## B. Conclusion of IPT decision

### (1) Dismissal

Where a request for IPT trial, though meeting formalities, contains unlawful defects that cannot be corrected by an amendment, the request may be rejected by a decision without giving the respondent an opportunity to submit a written answer. (Article 142)

Thus, a request for an IPT trial is dismissed where: the period of an IPT trial request has expired; a request has been filed against a non-patentee; a request has been filed by an uninterested party; some joint owners are not made a party; a request has been filed in violation of the *ne bis in idem* principle; the trial to confirm the scope of a patent right has been filed for an extinguished right or has not proved use of a target invention; where the gist of a target invention has been amended in the right-versus-right positive trial to confirm the scope of a patent right.

(2) Admission: A trial examiner decides the case has merit and petitioner's request stated in the prayer for relief is admitted.

(Ex) 'KIPO decision is cancelled and this case is remanded to examination bureau.'  
'Patent granted for invention #\_\_ is hereby invalidated.'

(3) Denial: Where a trial request is deemed without merit, a trial examiner shall deny the request. Where only part of the request has merit, an examiner shall admit some and deny some.

(Ex) 'This request is hereby denied.'  
'Claim #1 of patent granted for invention #\_ is invalidated.'

Remainder of the request is denied.' (Or, 'Trial request for claim #2 to #5 of the patent granted for the invention is denied.')

## 4. Reasoning of IPT decision

An IPT decision shall state its reasoning, which is a factual and legal basis leading to the conclusion, specifically and based on proven facts.

## 5. Effect

With respect to IPT decisions, which can be claimed against third parties unlike civil litigation judgments which only bind the parties, the law allows certain effects for legal stability and trust. Such effects include binding force and the formal and substantive force of finalization.

### A. Binding force

Where a copy of the IPT decision is delivered to the parties, even the trial examiner may not withdraw or revise it. This is the binding force and purports to maintain legal stability by building trust for IPT decisions.

### B. Formal finalization

Where the parties do not appeal to an IPT decision or even if they appeal the decision subsequently becomes final so that it cannot be appealed through regular procedure; the decision is formally finalized. A person can appeal the IPT decision within 30 days of receiving a copy of the decision. After that, unless there is cause of a new trial the decision cannot be canceled or amended.

### C. Substantive finalization

Where an IPT decision is formally finalized, its content cannot be contested. This is a substantive finalization and expresses the principle of *ne bis in idem* in patent law.

### D. *Ne bis in idem* principle<sup>46)</sup>

#### (1) Meaning

Where an IPT decision has become final under this Act, a person may not demand a new trial on the basis of the same facts and evidence unless the final IPT decision is a rejection. (Article 163) However, a final decision of dismissal is an exception.

Rationale for *ne bis in idem* are: it maintains trust and authority of the final IPT decision or court judgment by preventing contradictory decision or judgment; it promote judicial economy for IPT trial procedures by preventing frivolous lawsuits from being filed.

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46) *Res judicata* in the civil procedure law renders a final judgment to bind the parties of relevant case, not third parties, while *ne bis in idem* of the patent law binds third parties as well as the parties.

(2) Difference among Patent Act, Civil Procedure Act and Criminal Procedure Act

(A) Comprising two pillars of criminal procedure along with “no crime, no punishment,” this principle refers to the external effect of a substantive finalization of a judgment. In a criminal procedure the court cannot retry as long as the facts are the same, while in a patent trial both the facts and evidence have to be the same.

(B) Civil litigation has force of ‘*res judicata*’ but not the principle of *ne bis in idem* because its object can appear or disappear after the judgment. The difference is as follows: *Ne bis in idem* can be asserted against third parties while *res judicata* only binds the parties. The former applies to a final IPT decision, but the latter only applies to a final judgment. In the former, a new IPT trial or litigation is prohibited based on same facts and evidence but in the latter as long as the object of litigation is the same, no more litigation is allowed.

(3) Object of application

This principle is limited to a final IPT decision based on the facts and evidence presented by the parties. Thus, it does not apply to dismissal or a decision on appeal to a patent rejection, but to a decision invalidating a patent, an extension of patent term or a correction or a decision to confirm the scope of a patent right.

(4) Requirements

This principle applies where the same IPT trial is requested on the same facts and evidence after an IPT decision has become final.

(A) Same facts

Where a specific fact lending merit to the prayer for relief is identical, this requirement is met. That is, specific facts shall be the same regarding the same right and ground. Thus, for example, where a final IPT decision is based on lack of novelty, another request for an IPT trial can be filed based on inventive step.

(B) Same evidence

The following are the theories.

1) Important evidence theory

This one interprets ‘same evidence’ broadly, in that adding minor evidence is within the scope of same evidence.

2) Identical evidence theory

This is a narrower interpretation of ‘same evidence’ and requires that the evidence be essentially the same.

### 3) Formal evidence theory

This is a still narrower interpretation of 'same evidence' and requires that the evidence be exactly the same in form.

### 4) Issue evidence theory

Where an issue has been admitted, no more evidence is allowed. However, where an issue has been denied, all evidences have to be allowed.

### 5) Evidence within the same law theory

This one relates to the same fact and evidence. As long as it is used to prove the same factual requirement in the same statute, the evidence is deemed the same.

The courts support the 'identical evidence theory' and hold that where their contents are substantially the same, the evidences are the same. However, a publication is not deemed the same where quoted part and the technology to prove are different.

### (C) Same IPT trial

Where the object of prayer for relief and the type of trial are the same, this requirement is met. One court held that negative and positive trials to confirm the scope of a patent right are the same if they concern the same target invention and thus are based on the same facts and evidence.<sup>47)</sup>

### (5) Criteria in time

Unlike the requirements for request of an IPT trial which are decided as of the time of request, the time of IPT decision governs here.

## 6. Correction of IPT decision

A. The Patent Act does not have a provision like Article 197 of the Civil Procedure Act which allows the court to, *ex officio* or by the parties' request, correct its decision when there are obvious defects such as a typo. However, the courts allow such correction.

B. A correction cannot change the content of an IPT decision.

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47) 75 Hu 18 decision (Supreme Court, Jun 8, 1976)

## V. Withdrawal of request for IPT trial

### 1. Meaning

This means a unilateral recalling of all or part of the request filed by a petitioner, by which the trial is deemed never to have existed and the trial procedure is concluded.

### 2. Requirements

A. Object: Where a request for an IPT trial to invalidate a patent under Article 133(1) or to confirm the scope of a patent right under Article 135 has been made with regard to multiple claims, the request may be withdrawn for each of the claims. (Article 161.2)

B. Time: A request for an IPT trial may be withdrawn by the petitioner anytime before the IPT decision becomes final (Article 161.1), including when the case is pending before the court.

C. Consent of respondent: This must be obtained where an answer has already been filed because after that point the respondent has interest in maintaining the IPT trial. A partial withdrawal does not require consent of the respondent, however.

### 3. Method

A withdrawer shall submit to the IPT President a withdrawal and a necessary written attachment, and the presiding trial examiner shall notify the other party accordingly in writing. (Article 69 of Ministerial Decree)

### 4. Effect

Where an entire request is withdrawn, it is deemed never to have been filed. Where partially withdrawn, request for an IPT trial on the withdrawn part is deemed never to have been filed. A petitioner can file a withdrawn request but where the parties agreed not to, such request shall be dismissed.

## SECTION 3 TYPES OF IPT TRIAL

### I. IPT Trial on appeal to patent rejection, etc.

#### 1. Meaning

IPT trial for an appeal to rejection includes a trial on appeal to reject a patent or extend registration (Articles 62, 91) and a trial on appeal to cancel a patent (Article 74.3). In the latter, the IPT President shall notify the person who filed opposition accordingly.

#### 2. Request period

Applicant or patentee contesting a patent rejection, etc. can request an IPT trial within 30 days of receiving a copy of the patent rejection or patent cancellation. The President of the IPT may extend, for the benefit of a person residing in an area that is remote or difficult to access, the period for demanding a trial, upon request or *ex officio*. Such extension shall be two months or less and will be allowed only once. (Article 15.1, Article 11 of IPT Trial Regulations)

Where a person who has initiated a patent-related procedure fails to observe the period for requesting an IPT trial for unavoidable reasons, the person may complete the procedure within the fourteen-day period immediately after the date on which the reasons ceased to exist, if not more than one year has elapsed since the designated period expired. (Article 17)

#### 3. Items to be included in the request

##### A. Request for trial

- ① Name and address of petitioner (if a legal entity, name and place of business),
- ② Name and residential or business address of the counsel, if any (if a patent firm, name, address of business and the name of designated patent attorney),
- ③ Date and number of patent application (if an appeal to patent cancellation, date of registration and number of patent),
- ④ Title of the invention,
- ⑤ Date of patent rejection or patent cancellation
- ⑥ Identification of the case
- ⑦ Prayer for relief and reasoning

- B. Where a description or drawing is amended within 30 days of filing an appeal to a patent rejection and the patent application being re-examined by an examiner, such appeal need not state the prayer for relief. However, when the original patent rejection is maintained as a result of re-examination (by amendment) and the IPT President orders an amendment of the prayer for relief, the petitioner shall oblige.

#### 4. Procedure

(1) Regarding the IPT trial on patent rejection, Articles 47.1.1 & 2, 51, 63 and 66 shall apply *mutatis mutandis*. (Article 170)

(2) Object of the IPT trial examination is lawfulness of the KIPO decision. Where an IPT trial examiner finds different reasons for rejection from the KIPO, he/she shall notify the applicant of such reason and provide a chance to submit a brief. Or, it will be a procedural violation.

For example, although a KIPO decision and an IPT decision have the same reasoning that novelty is lacking, if they concern different claims, the reason for rejection differs. Also, where novelty was denied for the same claim, if the cited examples are different, then they are different reasons for rejection. Thus, a new reason for the rejection shall be notified.<sup>48)</sup>

#### 5. Types of IPT decision

A. Dismissal: Where a request meets formality requirements but is incurably unlawful, the request shall be dismissed without giving the respondent a chance to submit an answer.

B. Denial: Where an IPT trial examiner deems the request meritless, he/she shall deny it.

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48) 98 Hu 515 decision (Supreme Court, Feb 5, 2001) (“Before making a decision to refuse patent, a KIPO examiner has to notify the applicant a reason for refusal and give him/her opportunity to file a brief. Article 124 of Patent Act provides the same in IPT trial if an IPT trial examiner finds different reason for refusal than the KIPO. The reasoning for the above is that since determination of patentability requires such a high level of expertise that a single examiner can not be expected to be perfectly knowledgeable. Also, refusing a patent application without a chance to amend a possible defect is too harsh.”)

C. Admission (Cancellation): Where an IPT trial examiner finds the request has merit, he/she shall make a decision to reject or cancel the patent or reject registration of the patent term extension. When canceling, a trial examiner can make a decision himself/herself or decide to refer to a KIPO examination. When the case is remanded, the reason which is the basis for cancellation shall bind the KIPO examiner.

(1) No remand (IPT making a decision): Where the grounds of the KIPO decision cannot justify the patent rejection or cancellation, or where remanding is not desirable for administrative economy. (Article 61.05 of IPT Trial Manual)

(2) Remand: IPT cancels KIPO decision and remands it to the KIPO Examination Bureau in the following cases: (Article 61.05 of IPT Trial Manual)

- ① Substantive determination has not been made for an invention in the examination or a patent was refused for formalistic reasons;
- ② Cited example was not properly identified or correct ones are missing; or
- ③ Patent was rejected without being given an opportunity to submit an opinion.

## II. Re-examination of amended application

### 1. Meaning

Where a person appealing a patent rejection amends the description or drawing of the patent application within 30 days of appeal, a KIPO examiner shall re-examine the patent application before an IPT trial on the appeal. This is to reduce the caseload, make a quick decision and serve the applicants.

### 2. Object

- ① Application rejected under Article 62,
- ② Appeal shall be filed within 30 days of receiving the rejection, and
- ③ The description or drawing in the patent application shall be amended within 30 days of the appeal.

Where there is no amendment, a case shall proceed under the IPT trial procedure.

### 3. Procedure

A. In a request for an IPT trial where the original patent application has to be re-examined due to an amendment, unless the request is dismissed, the IPT President shall notify the KIPO Commissioner before making the decision and the KIPO Commissioner shall order an examiner to re-examine relevant inventions. In principle,

the examiner who had rejected the application shall re-examine for economy and speed purposes, but if the examiner is unavailable, then an examiner with a relevant technical background shall examine the invention.

B. After re-examination of amended patent application,

(1) Where the original grounds for the KIPO decision are 'addressed' by amendment and no other grounds for rejection is found, patent rejection shall be cancelled and a patent shall be granted, ending the re-examination and request for an IPT trial.

(2) Where the original grounds for the KIPO decision are 'addressed' by amendment but other grounds for rejection is found, the original grounds shall be notified and an opportunity shall be given to submit a brief. The applicant can re-amend the description or drawing within such period for filing a brief.

(3) Where the original or new ground of the KIPO decision is not 'addressed' by an amendment, a KIPO examiner shall not issue a new decision to refuse, shall report to the Commissioner the result of such re-examination and shall end the re-examination process. In such case, the Commissioner shall notify the IPT President, who shall appoint a trial examiner, and a regular procedure will follow.

### III. IPT trial to invalidate patent

#### 1. Meaning

Where grounds for invalidating a registered patent (Article 133.1) are found after a substantive IPT trial examination, such patent is invalidated.

Even if a patent has grounds for invalidation, it is not void *ab initio* and is deemed valid until it is finally invalidated by the IPT or court. Thus, regarding patent infringement litigations, a patent shall be invalidated by an IPT decision to invalidate the patent. Such IPT trials can be requested for each claim and requested even after the patent is extinguished.

There used to be opposition procedures (for patents) that could be filed by anyone, apart from the IPT patent invalidation trial that could be filed by interested parties or the KIPO examiner. They were similar in that both were filed after a patent was established and an opportunity to amend was given. Considering that the opposition procedure had no independent means of appeal, the revised Patent Act (effective Oct 1, 2006) merged it into the IPT trial to invalidate a patent.

## 2. Grounds

### A. General (Article 133.1)

(1) Where a patent has been granted in violation of Articles 25, 29, 31, 32, 36(1) to (3), 42(3), (4), or 44

(2) Where the right provided for in Article 33.1 (person who has a right to obtain patent) is absent or where Article 44 (joint application) is violated

(3) Where a patent has been granted to a person who is not entitled to the patent under Article 33(1)

(4) Where, after the grant of a patent, the patentee is no longer capable of enjoying the patent right under Article 25 or the patent no longer complies with a treaty: The country of patentee withdraws from the Paris Convention or the cause of non-patentability is added as regards Korea, providing cause of invalidation.

(5) Where a patent has been granted in violation of a treaty;

(6) Where an application has been amended beyond the scope of Article 47(2) (amendment including new items)

(7) Divisional application outside the scope prescribed in Article 52.1

(8) Converted application outside the scope prescribed in Article 53.1

### B. Grounds in international patent application

In an international patent application that is in a foreign language, in addition to the above, a patent can be invalidated i) where the description, claim, drawing or Korean translation of an application filed on the international filing date lacks mandatory items or ii) where a patent was granted based on added items not included in the application (drawing) filed on the international filing date. (Article 213)

## 3. Party

### A. Petitioner

Interested parties or a KIPO examiner can request this. However, from the patent registration date until three months from the publication of registration anyone can make a request.

Interested party is a person who can be challenged legally due to the patent. That is, it is a person who suffers or is feared to suffer loss because of the invention, uses the invention commercially and industrially, is in a position expected to use the invention from the nature of the business, or was rejected a patent because of the invention. On the contrary, a person who is granted license from the patentee is not an interested party during the term of license because he has no danger of being challenged on his right.

Where a non-legal entity association or foundation has a representative or administrator, such person can file a request on behalf of the association or foundation.

Petitioner has to prove his/her 'interest' and if not, the request shall be dismissed.

#### B. Respondent

Respondent shall be the patentee in the patent register at the time of request for patent invalidation. Joint patentees shall be joint respondents. Where a patent right or other patent-related right is transferred while a patent-related procedure is pending before the KIPO or the IPT, the KIPO Commissioner or the IPT's presiding trial examiner may require the successor in title to continue the patent-related procedure. (Article 19) Respondent before the succession can continue conducting the procedure.

#### 4. Time of request

An IPT trial under Article 133.1 may be requested even after the extinguishment of a patent. (Article 133.2) A damage action can be brought against a patent infringer unless the statute of limitation (Article 766 of Civil Act) has expired.

#### 5. Effect of invalidation

A. Where an IPT decision to invalidate a patent becomes final, such patent is deemed not to have existed. However, where a patentee subsequently becomes unable to own a patent pursuant to Article 25 (foreigner's ownership of right) or an IPT decision to invalidate the patent becomes final due to violation of a treaty, the patent loses its force at the time of such occurrence. (Subsequent cause of patent invalidation)

B. Where a patentee or registered licensee of an invalidated patent falls under Article 104, the original patentee or registered licensee has a statutory non-exclusive license by paying a reasonable compensation to the patentee or exclusive licensee.

C. Where an IPT decision invalidating a patent becomes final after a patent infringer is found guilty or a damage judgment becomes final, a new trial can be requested for such civil or criminal judgment. (Article 420 of Criminal Procedure Act, Article 422 of Civil Procedure Act)

#### 6. Request for correction of patent

Where a patent has risk of invalidation, the patentee can request correction of the patent in order to avoid invalidation. Here, a patentee can request within the period to submit an answer or a brief in a patent invalidation trial, correction of the description or drawing: i) where correction is within the scope of description or drawing but when

correcting a defective statement within the scope of description or drawing initially attached to a patent application; ii) where it reduces the claim, corrects clerical error or clarifies unclear statement; or iii) where correction does not essentially expand or amend the claim and the reduced or corrected claim shall be patentable. (Article 133-2) Details are as stated earlier.

#### **IV. IPT trial to invalidate registration for patent term extension**

##### **1. Meaning**

Where a patent whose term cannot be extended is registered for an extension of the term, it overly protects the patentee and runs against the goal of the patent system. This IPT trial acknowledges the patent but merely invalidates the extended term of a patent.

##### **2. Grounds**

A. Where extension of a term is registered although approval (for using the invention) by another statute was not necessary

B. Where a patentee or exclusive or non-exclusive licensee registered extension of a patent term without approval, etc. by another statute

C. Extended period exceeds the time during which an invention could not be used

D. Application for extension was not made by the patentee

E. Application for extension was not made by all joint patent owners.

##### **3. Party**

Interested party or examiner is the petitioner and patentee is the respondent. Joint patentees shall be joint respondents.

##### **4. Time to request**

Request shall be made during and after the duration of the patent.

##### **5. Object**

Each and every claim shall have reason for invalidation because patent invalidation decision reaches all the claims.

## 6. Effect of invalidation

When the invalidation decision becomes final extension is deemed to have never existed. However, where extension is invalidated for exceeding the required time, only such extra period shall be invalidated.

## V. IPT trial to confirm the scope of a patent right

### 1. Meaning

This trial purports to determine the scope of the patent in the context of the relationship between a patented invention and an invention being used or intended to be used. Article 135.1 provides, “a patentee or an interested party may request a trial to confirm the scope of a patent right,” providing legal basis for this trial. Article 50 of the Utility Model Act, Article 69 of Design Act and Article 75 of Trademark Act all provide for this trial.

Article 97 says that “the scope of protection conferred by a patented invention is determined by the subject matter described in the claim,” thus providing criteria for what the protected scope of a patented invention is. But its interpretation depends on interpreters and that is why this trial is necessary. In this trial, a panel of technical experts determines the specific scope of a patent but such decision by the IPT is not binding. Thus, some are questioning the effectiveness of this trial.

### 2. Classification

Negative trial to confirm the scope of a patent right also can be requested against an invention a respondent plans to use in the future.

#### A. Positive trial to confirm the scope of a patent right

A patentee requests against an interested party of the target invention<sup>49)</sup> an IPT decision in which the ‘target invention belongs to the scope of patent #\_\_.’

#### B. Negative trial to confirm the scope of a patent right

An interested party of the target invention requests against the patentee an IPT decision in which the ‘target invention does not belong to the scope of patent #\_\_.’

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49) ‘Target invention’ in a trial confirming scope of rights is a technology which interested parties are specifically working or intend to work, and is contrasted to a patented invention.

### 3. Party

A patentee or an interested party may request a trial to confirm the scope of a patent right. (Article 135.1) In a positive trial, the petitioner is the patentee or exclusive licensee, and the respondent is the interested party. In a negative trial, it is the other way around. An interested party includes not only those who manufacture and/or sell, commercially and industrially, products which can cause dispute on the scope of the patent, but those who intend to do so.

### 4. Time to request

Where a patent is extinguished, general theory is that if the statute of limitation in Article 766 of the Civil Act has not expired, this IPT trial is allowed as long as there is an 'interest in action.' Meanwhile, the courts hold that such request is not allowed because a trial to confirm the scope of a patent right purports to determine the scope of an existing patent.<sup>50)</sup>

### 5. Procedure

The petitioner shall submit to the IPT President a request stating the name and address of parties and representatives (for legal entity, its name and principal place of business and name of its representative), identification of case, prayer for relief and reasoning, and explanation and the necessary drawing that can be compared with the patented invention must be attached to the written request. (Article 140.3)

Where a description or a drawing which can be compared to the patented invention is not attached, the presiding trial examiner shall order an amendment within a designated period and if not amended shall dismiss the request. (Article 141.1)

Where a patent contains multiple claims, the patentee may request a trial for each claim. (Article 135.2) Thus, if a petitioner expressly specifies a claim, whether or not a relevant claim belongs to the scope of the patent shall be decided and expressly stated in the conclusion of decision.

### 6. Specifying target invention

A. Object of an IPT trial to confirm the scope of a patent right, target invention shall be an invention that is currently used or can be used in the future.<sup>51)</sup>

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50) 94 Hu 2333 decision (Supreme Court, Sep 10, 1996) ("Request for an IPT trial to confirm the scope of a patent right has to be made about an existing patent right. The term of patent in this case has expired so this case lacks 'interest of confirmation'.")

51) 94 Hu 2247 decision (Supreme Court, Mar 8, 1996)

B. In order to request this trial, the technical content of the target invention has to be specifically stated so that it can be compared to that of the patented invention. If not, such request shall be dismissed. Where the specifying is insufficient, an IPT trial examiner shall order an amendment of the explanation and drawing.

Amendment of the target invention is only allowed where the invention remains identical (e.g., regarding the description or drawing), correcting an obviously erroneous statement, clarifying an unclear statement or explaining something in detail.

Specific construction of a target invention only needs to be stated for the part corresponding to the construction of a patented invention. However, it shall be possible to see the difference between the construction of the target invention and the patented invention.<sup>52)</sup>

## 7. Effect

When an IPT decision becomes final, whether or not the target invention belongs to the scope of a patent is confirmed. Thus, where the invention is finally decided to belong there, working of target invention is deemed as a violation of the patent. However, a final decision does not bind the court in specific civil or criminal cases and is simply a technical determination. Where an IPT decision has become final under this Act, a person may not demand a new trial on the basis of the same facts and evidence, unless the decision is a rejection. (Article 163)

## 8. Relationship between positive trial to confirm the scope of a patent right and a third invention

In a negative confirmation trial the person using the invention specifies an invention being compared but in a positive confirmation trial the right holder makes the specification. Thus, it can be argued that a request is unlawful because the respondent is not using the target invention but a third invention. In such case, since an invention being compared and a third invention are not the same and *res judicata* of this IPT decision for an invention being compared does not cover a third invention, the request shall be dismissed.<sup>53)</sup> Also, even if an invention is being compared, the object of the trial and a third invention actually being used by the respondent have the same gist, the IPT decision that an invention being compared belongs to a patented invention does

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52) 93 Hu 381 decision (Supreme Court, May 24, 1994) (“In describing the technology of target invention in an IPT trial to confirm the scope of patent, the part of target invention corresponding to the constitution of patented invention shall be explained specifically so that such invention and the patented invention can be compared.”)

53) 94 Hu 2179 decision (Supreme Court, Jun 29, 1995)

not reach a third invention and thus the request of an IPT trial for an invention being compared lacks interest in action and shall be dismissed.<sup>54)</sup>

## 9. Relationship between trial to confirm the scope of a patent right and patentability requirement

In a trial to confirm the scope of a patent right, it can be argued that where a patented invention lacks novelty and inventive step as compared to the target invention, the target invention does not belong in such scope and technical comparison is not necessary.

Where a patented invention is found not to have an inventive step in a trial to confirm the scope of a patent right, such invention cannot have a scope of right. Thus, the courts consistently hold that in such cases target invention does not belong to the scope of a patent and thus specific technical comparison is not necessary.

Meanwhile, on the issue of whether or not the scope of a patent can be denied without a final decision to invalidate a patent registration because the patented invention lacks inventive step the Supreme Court has denied it. (97 Hu 2095, Oct 27, 1998).<sup>55)</sup>

## 10. Cases

### A. Specifying target invention and amendment of 'gist'

According to Articles 97.1.2, 100.1~2, 4 of the previous Patent Act (before revision of Jan 13, 1990), in order to make a request to the IPT for a trial to confirm the scope of a patent right, the description and drawing necessary to specify a target invention have to be attached. Also, prayer for relief can only be amended if the gist of the request remains unchanged so that an amendment may not delay the procedure or interfere with the respondent's defense. Thus, if the amendment simply clarifies an unclear part of the description or drawing or simply adds what is obvious, it will not affect identicalness and thus is not an amendment of gist.<sup>56)</sup> An amendment exceeding the above shall not be allowed.<sup>57)</sup>

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54) 94 Hu 2247 decision (Supreme Court, Mar 8, 1996)

55) 97 Hu 1016, 1023, 1030 decision (Supreme Court, Dec 22, 1998); 98 Hu 1068 decision (Supreme Court, Feb 9, 2001)

56) 93 Hu 1926 decision (Supreme Court, May 12, 1995) ("In amending a request for IPT trial, except in the grounds for request, the gist shall not be changed so that amendment may not delay the procedure or interfere with the respondent's defense. Thus, if the amendment simply clarifies unclear part of the description or drawing or simply adds what is obvious, it will not affect identicalness and thus not a change of gist".)

57) 2000 Heo 1290 decision (Patent Court, Jan 5, 2001)

## B. Right-versus-right IPT trial to confirm the scope of a patent right

(1) On the issue of whether or not an IPT trial to confirm the scope of a patent right can be requested in a right-versus-right situation, i.e., whether or not a right belongs to another right, there is no consensus of opinion.

(2) In an IPT trial to confirm the scope of a patent right (right-versus-right type), the prayer for relief for a positive confirmation ('A later registered right belongs to the scope of an earlier registered right') denies one of the rights. But a patent right once established cannot be denied effect until it is finally invalidated and thus the above request for confirmation shall be dismissed for lack of interest.<sup>58)</sup> However, where a holder of an earlier registered utility model requests a positive confirmation of scope of right on the ground that the later utility model is using an earlier utility model, the result of the IPT trial is not conditioned on the assertion that the subsequent utility model is void, thus allowing an interest of confirmation. Nevertheless, a positive confirmation of the scope of right cannot be requested where patentability of the subsequent utility model is essentially denied.<sup>59)</sup>

(3) In a negative confirmation procedure requesting an IPT decision that a later registered right does not belong to the scope of an earlier registered right, even if the request is allowed, the registered right of the respondent is not denied. Thus, the courts consider such request lawful.

## C. Interest of trial to confirm the scope of a patent right after patent extinguishment

In an IPT patent invalidation trial, Article 133.2 provides that a patent invalidation trial may be requested even after the extinguishment of a patent right. However, trial to confirm the scope of a patent right does not have such provision.

The Supreme Court denies interest of confirmation for an extinguished patent on the theory that a trial to confirm the scope of a patent right purports to determine that of an existing patent.<sup>60)</sup> The Patent Court agreed in a case where a registered design is extinguished for failure to pay registration fee.<sup>61)</sup>

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58) 96 Hu 375 decision (Supreme Court, Jul 30, 1996)

59) 99 Heo 1720 decision (Patent Court, Sep 2, 1999)

60) 94 Hu 2223, 2230 decision (Supreme Court, Sep 10, 1996)

61) 99 Heo 1706 decision (Patent Court, Dec 17, 1999)

D. Cases where target invention does not belong to scope of a patented invention

- ① Where target invention is publicly known<sup>62)</sup>
- ② Patented invention in this case is publicly known<sup>63)</sup>
- ③ Where target invention lacks an element of this invention<sup>64)</sup>
- ④ Where target invention an improved effect<sup>65)</sup>

E. Cases where target invention does belong to the scope of a patented invention

- ① Where a use relationship exists<sup>66)</sup>
- ② Where target invention can easily be used from the rights
- ③ Where target invention is a replacement of an equivalent item or a simple design change<sup>67)</sup>

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- 62) 96 Hu 1750 decision (Supreme Court, Nov 11, 1997) (“In deciding whether or not an invention belongs to the scope of a patented invention, i.e., whether or not both inventions are the same or similar, public knowledge shall be excluded. Thus, where target invention consists entirely of public knowledge, target invention shall not belong to the scope of patent right, regardless of similarity between them.”); 98 Heo 2252 decision (Patent Court, Jul 8, 1998)
- 63) 91 Ma 540 order (Supreme Court, Jun 2, 1992) (“where all or part of a registered, patented invention had been publicly known or worked at the time of patent application, a patentee can not exercise his/her right regardless of the result of IPT trial to invalidate the patent. However, where a filed invention has novelty but lacks inventive step because a person skilled in the art can easily invent by using prior art, the court can not deny a patent’s scope of right.”)
- 64) 98 Heo 1747 decision (Patent Court, Nov 26, 1998) (“Target invention has the same construction as the patented invention of this case except that it has only a single unit of coated sand can and retrieval can, and that it can not form a dual-wall shell mould. Based on the above, target invention has different effect in that it can do its moulding job more efficiently and prevent loss of coated sand. As long as target invention lacks core elements necessary to achieve the most important purpose of the invention in this case, such target invention is outside the scope of the invention in this case.”)
- 65) 90 Hu 960 decision (Supreme Court, Nov 12, 1991) (“Even if target invention is included in the genus described in the patent claim of in this case, according to the reasoning of IPT decision and the record of this case, technology not stated in the description of the patent is stated in that of target invention and used in manufacturing and achieved an effect not anticipated by the patent in this case. Where target invention has marked difference in effect such as manufacturing method or response temperature, the two inventions can be deemed different inventions.”)
- 66) 92 Hu 1660 decision (Supreme Court, Dec 5, 1995) (“When prior and subsequent inventions are in a usage relationship, the latter belongs to the scope of the former. A usage relationship is recognized when a subsequent invention adds new technical elements to the gist of patent for a prior invention and includes and uses all of such gist.”)
- 67) 98 Heo 2160 decision (Patent Court, Sep 17, 1998) (“In order for ‘infringement by doctrine of equivalent’ to be recognized, where target invention replaces elements of patented invention with others, the new

## VI. IPT trial to correct

### 1. Meaning

Where the description or drawing has defects, patentee can request an IPT trial to correct them. This trial protects a patentee from problems that are subsequently found and also a third party from unclear rights. However, this IPT trial is restricted for legal stability reasons and is not allowed where opposition to a patent or an IPT trial to invalidate the patent is pending before the IPT.

### 2. Petitioner

This trial can only be requested by a patentee (Article 136.1), and joint patentees shall be joint petitioners. It can be requested after a patent is extinguished by a patentee as of the time of extinguishment. Also, a patentee, i.e., a petitioner, has to obtain consent by an exclusive or non-exclusive licensee or the pledgee and if not, the request for a trial shall be dismissed.

### 3. Time to request

This trial can only be requested after the patent registration. It can also be requested after its extinguishment and there is no limit on how many times it can be requested. However, a request for this is not allowed,

- ① Where opposition to a patent or an IPT trial to invalidate a patent is pending before the KIPO or IPT, since this request can be filed in those proceedings;
- ② Where a patent is decided to be canceled or invalidated, since such patent is deemed to have never existed

### 4. Scope of correction

Since a decision to correct is made after the establishment of a patent, it shall be limited in scope so that stability is maintained.

#### A. Object of correction

A correction to the description or drawing must be limited in scope to the subject matter disclosed in the description or drawing of the patented invention. However, where a clerical error is corrected under Article 47.3.2, the correction must be limited to the scope of the subject matter of the description or drawing originally attached to the application. (Article 136.2)

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elements performs substantially same function as the elements of patented invention with substantially same manner and result, a person skilled in the art could easily figure out such replacement at the time of target invention but such target invention was not publicly known at the time of patented invention.”)

## B. Scope of correction

Correction of the description or drawing is allowed where,

- ① Scope of claim is reduced
- ② Clerical error is corrected
- ③ Unclear statement is clarified (Article 136.1)

Even if a correction falls under the above on its face, correction to the description of a drawing may not substantially extend or modify the scope of a patent right. (Article 136.3) Where a claim is reduced or clerical error is corrected, the matters described in the claim after a correction shall have been patentable when the patent application was filed. (Article 136.4)

### (1) Reduction in scope of claim

Where a claim is overbroad and includes a publicly known technology, in order to avoid cancellation or invalidation, the claim or optional items are deleted, or elements are added serially or changed from genus to species.

### (2) Correcting clerical error

This is a case where, on its face or as a whole, statement in the description or drawing is obviously erroneous. Also, where detailed explanation of invention and the scope of claim do not match or contradict each other, such problem can be corrected.

### (3) Clarifying unclear statement

This is a case where a statement is unclear or conflicts with other statements.

### (4) Expanding or amending a claim

Expansion of a claim includes adding a selective element or cited claim, deleting a series element, changing from species to genus and adding examples of use. Amendment of claim includes amendment of category or object. Whether or not correcting a claim falls under the expanding or amending of a claim shall be decided by substantially examining the entire description including a detailed explanation of invention.<sup>68)</sup> Thus, a change from genus to species, adding series elements, and so forth can be seen as a reduction in claim generally. However, where adding an element to an original invention makes it seem that a claim is reduced but the purpose or scope of patent is changed, the claim shall be deemed to have been substantially amended.

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<sup>68)</sup> 87 Hu 63 decision (Supreme Court, Feb 28, 1989)

### C. Prayer for relief

(1) For example, the 'purpose of IPT request' item states "it is requested that description (drawing) of patent #\_ invention be corrected with the description (drawing) attached to the request."

(2) Here, identity or scope of the request is changed by amending the prayer for relief. Before concluding an IPT trial, prayer for relief can be corrected as long as there is no 'change.'

#### (3) Type of amendment in prayer for relief

- ① Additional amendment (adding correction B to correction A)
- ② Reduced amendment (deleting correction B from correction A & B)
- ③ Requesting trial for a new prayer for relief shall be an amendment.

## 5. Request

A person purporting to request an IPT trial for correction shall submit to the IPT President a request stating items of Article 140.1 with an attachment with the corrected description or drawing. When correcting a description, the entire corrected description shall be attached, and the description or drawing to correct shall be submitted. Where a corrected description or drawing is missing, the presiding trial examiner shall order an amendment and if not amended, shall dismiss the request.

## 6. Procedure of trial examination

### A. Cases where correction is not allowed

Where a request is not the object of correction (violation of Article 47.3), essentially when a claim is expanded or amended or after correction is not patentable at the time of application, an IPT examiner shall notify the petitioner accordingly and provide an opportunity to file a brief. Where a brief is not filed or cannot be adopted, the IPT examiner shall notify the conclusion of the trial and dismiss the request.

Patentee may amend the corrected description or drawing attached to a written request only before the notification of conclusion of the IPT trial examination. (Article 136.9)

### B. Cases where correction is allowed

#### (1) Patent or utility model applied and patented before Jul 1, 2001

Where an IPT trial examiner deems a request for correction lawful, he/she shall issue a decision to publish the request in the Patent Gazette. Any person can appeal such

publication within two months of the publication date, and the IPT trial examiner shall make a decision. Where an appeal is not filed within two months or is groundless, a decision to correct shall be made.

(2) Patent or utility model applied and patented after Jul 1, 2001

Where an IPT trial examiner deems a request for correction lawful, he/she shall issue a decision to correct the description or drawing of the invention, concluding the trial procedure.

Where an IPT decision corrects the description or drawing, the IPT President shall notify the KIPO Commissioner, who shall publish it in the Patent Gazette,

## 7. Trial to correct in multi-claim system

A. Correction of scope of claim: A correction shall not result in an expansion or amendment of the technical items of each claim, and a deletion of a claim shall not be interpreted to essentially amend the claim.

B. Where a claim is deleted: In order to delete a claim cited by a subordinate claim, remainder of the claims shall be revised and the details of the correction (arranged according to independent and subordinate claims) shall be submitted.

C. Where an independent claim having cause of invalidation is deleted: Where a technical idea in the remaining subordinate claims constitutes an invention at the time of the patent application, items stated in such subordinate claims shall be deemed an independent claim and where such technical idea constitutes multiple inventions, the subordinate claims shall be allowed to be corrected to an independent claim.

## 8. Effect

Where an IPT decision allowing the description or drawing of a patented invention to be corrected becomes final, the patent application, the laying open of the decision and the registration of the patent right are deemed to have been made on the basis of the corrected description or drawing. (Article 136.8) Any party may request a new trial against an IPT decision that has become final. (Article 178)

Where, as a result of decision to correct, statement in the patent certificate is changed, the KIPO Commissioner shall issue a new certificate *ex officio*.

## VII. IPT trial to invalidate correction

### 1. Meaning

Where an amendment of description or drawing resulting from an IPT decision to correct is unlawful, it shall be invalidated in order to prevent harm to the good-faith of third parties.

In an IPT trial to invalidate correction as well as a patent, a patentee can request correction of the description or drawing of a patented invention within the period for answer designated by the presiding trial examiner or the period to submit a brief in an *ex officio* examination. (Article 137.3)

### 2. Party

Petitioner is a KIPO examiner or an interested party and respondent is a patentee in the patent register (or patentee at time of patent extinguishment).

### 3. Time to request

Request can be filed when the IPT's decision to correct becomes final. It can also be filed when the patent is extinguished.

### 4. Grounds

A. Invalidation of correction pursuant to Articles 77.1 (correction in an opposition), 133-2.1 (correction in invalidation decision), 136.1 (correction decision) can be requested when a patented invention's description or drawing falls under the following.

(1) Where a correction does not reduce a claim, correct clerical error or clarifies an unclear statement.

(2) Where a correction exceeds the scope of description or drawing at the time of patent registration (when correcting a clerical error, the description or drawing initially attached to the application).

(3) Where, after amendment, a claim is expanded or amended.

(4) Where the statement in the claim after correction was not patentable at time of the application.

B. Request to invalidate correction for each invention or to invalidate part of the correction is not allowed.

## 5. Request for correction in a trial to invalidate correction

In an IPT's trial to invalidate correction, the respondent (patentee) can correct the description or drawing within the following period. (Article 137.3)

- ① Period for filing answer, designated by presiding trial examiner (Article 147.1) or
- ② Period for filing brief, in *ex officio* examination (Article 159.1)

Where a request for correction does not meet the requirements, the presiding trial examiner shall notify petitioner of it and allow an opportunity to file a brief.

## 6. Effect

Where the IPT's decision to invalidate correction becomes final, the correction is deemed never to have been made. (Article 137.5) Also, when the decision becomes final and registered, *res judicata* applies. (\*no more invalidation of correction with the same fact and evidence)

## VIII. Trial to grant non-exclusive license

### 1. Meaning

Where a patentee's patented invention uses others' patented invention, registered exclusive or non-exclusive license or similar design filed before, or conflicts with others' design or trademark, in order to use his/her patented invention commercially and industrially, the patentee in question can request IPT for a non-exclusive licensee on the other party's right.

Where a right filed earlier and a right filed later are in a use or conflict relationship, holder of the right filed later shall not infringe on the right filed earlier and shall obtain consent of the earlier right holder in order to use such invention. Meanwhile, in order to use his/her own invention, the prior applicant shall also obtain consent from the later applicant. However, if it is impossible, the prior applicant can request to the IPT for a non-exclusive license.

### 2. Requirements

A. Use or conflict between the rights: The scope is the use of one's own patented invention.

B. Important technological advance meriting considerable economic value: Considering that this is mentioned as an additional requirement, this should mean technologically progress which is more advanced than an inventive step.

C. Failure to reach an agreement: Violation of this will result in dismissal.

### 3. Party

Petitioner is the patentee or exclusive or non-exclusive licensee purporting to work the invention. Respondent is the prior patentee, the utility model right holder or design right holder (including exclusive licensee for each right).

Where a right holder who has granted a non-exclusive license by an IPT decision needs to work a patented invention of the non-exclusive licensee but the negotiation has failed or is impossible, such right holder can request an IPT decision to grant a non-exclusive license against the patentee, the utility model right holder or design right holder being granted a non-exclusive license within the scope of the patented invention.

### 4. Time to request

Request can only be filed while the right is in existence.

### 5. Request

A person purporting to request an IPT decision granting a non-exclusive license shall state in the request general items (Article 140.1) and the following. If the items are missing, the presiding trial examiner shall order an amendment within a designated period and if not amended, shall dismiss the request.

A. Number and name of his/her own patent required to be used

B. Number, name and registration date of others' patented invention or registered utility model or design required to be used

C. Scope, period and price of non-exclusive license of patented invention or registered utility model or design required to be used

### 6. Effect of final IPT decision

A decision granting a non-exclusive license shall expressly state in its conclusion the scope, term and price of the non-exclusive license. (Article 162.2.4)

Where an IPT decision granting non-exclusive license becomes final, a forced non-exclusive license comes into being. However, where a non-exclusive licensee fails to pay or deposit the price decided in the IPT decision, there is no license granted.

The price determined in the IPT decision can be appealed in court.

TABLE OF CONTENTS ::

## **CHAPTER 8**

### **PATENT LITIGATION**



- SECTION 1  
LITIGATION ON IPT DECISION, ETC.
- SECTION 2  
PATENT COURT
- SECTION 3  
FILING A LAWSUIT
- SECTION 4  
PRE-TRIAL PROCEDURE
- SECTION 5  
TRIAL IN PATENT LITIGATION
- SECTION 6  
CONCLUSION OF LITIGATION; APPEAL
- SECTION 7  
PATENT ATTORNEY'S FEE AND  
COST OF LITIGATION



## CHAPTER 8 PATENT LITIGATION

### SECTION 1 LITIGATION ON IPT DECISION, ETC.

#### I. Introduction

##### 1. Meaning

Industrial property disputes concern patent, utility model, trademark or design and include actions to cancel the IPT decision and administrative, civil or criminal lawsuits, i.e., patent litigation in a broad sense. Examples are ① an action to cancel an IPT decision under the exclusive jurisdiction of the Patent Court and concerning the IPT decision on the rights provided for in Article 186.1 of the Patent Act, Article 56 of the Utility Model Act, Article 75 of the Design Act, Article 86.2 of the Trademark Act, ② an administrative litigation concerning the administrative acts of the KIPO, ③ an injunctive action of Article 126 of the Patent Act; action for damages in Article 750 of the Civil Act and Article 128 of the Patent Act; a civil litigation such as an action for measures to restore reputation in Article 131 of the Patent Act, and ④ criminal prosecution based on Article 225, etc. of the Patent Act (infringement, perjury, false representation, fraud and divulging of secret). Among them, the civil litigation concerns a patent infringement (patent infringement litigation) and is under the jurisdiction of ordinary courts, and the action to cancel an IPT decision is patent litigation in the narrow sense and under the Patent Court's jurisdiction. (The latter will be called "patent litigation" below.)

A person contesting a decision of the IPT, which is a part of the KIPO, can bring an action to cancel the IPT decision before the Patent Court. (Article 186) An action to cancel the IPT decision is a patent litigation where an ex parte or inter parte decision from the IPT is sought to be cancelled and where the decision of the IPT is appealed.

##### 2. Nature

IPT is an administrative agency, so its decision is an administrative act. Thus, a patent litigation where lawfulness of an administrative act is determined is an administrative litigation.

Some argue that an action to cancel an IPT inter-parte decision is a litigation between the parties in the administrative litigation. However, it differs from the above litigation in the scope of applying the adversarial principle and the parties' control over the litigation, so it should be seen as an action filed against an act of the administrative agency.

## II. Relationship to civil and administrative litigation

### 1. Distinction from civil and administrative litigation

Only the actions falling under the exclusive jurisdiction of the Patent Act shall be a patent litigation. A so-called patent infringement litigation such as an action for prohibition, damage or restoration of reputation is a civil litigation, and a litigation such as an action on non acceptance of a document, procedural invalidation, patent expropriation or appeal to granting of a non-exclusive license is an administrative litigation.

A lawsuit contesting compensation provided in Article 190 is, depending on its nature, either an administrative litigation (action for compensation for expropriation pursuant to Articles 41.3 and 4, 106.3) or a civil litigation (action for compensation for granting of non-exclusive license pursuant to Articles 110.2, 138.4).

### 2. *Mutatis mutandis* application of administrative or civil procedure

First, the Patent Act is applied and then the Administrative Litigation Act is applied *mutatis mutandis*. Finally, the Civil Procedure Act is applied *mutatis mutandis* pursuant to Article 8 of the Administrative Litigation Act.

## III. Types

### 1. Action to cancel *ex parte* IPT decision (defendant: KIPO Commissioner)

- ① IPT decision on trial or retrial on appeal to KIPO examiner's decision to refuse (Article 62) or cancel (Article 74.3) (Article 132-3, 184)
- ② IPT decision to correct (of patent)
- ③ IPT decision to dismiss request for trial or new trial

### 2. *Inter parte* litigation where patentee or interested party is defendant

An IPT decision to invalidate a patent or registration of a patent term extension, to confirm the scope of a patent right, to invalidate correction, or to grant a non-exclusive license

### 3. Seed Industry Act-related litigation (Article 105 of Seed Industry Act)

- ① Action to cancel decision (regarding dismissal of amendment, rejection or breed protection) of breed protection committee
- ② Action to cancel a dismissal of an amendment of an application for breed protection, trial or retrial

## SECTION 2 PATENT COURT

### I. Jurisdiction of patent court

#### 1. Subject matter jurisdiction

Established on March 1, 1998, the Patent Court, which is on the same hierarchy as appellate courts, has subject matter jurisdiction over

- ① Cases provided for by Article 186.1 of Patent Act, Article 56 of Utility Model Act, Article 75 of Design Act, and Article 86.2 of Trademark Act, and
- ② Cases designated by other statutes to belong to the jurisdiction of the Patent Court

Judgment by the Patent Court shall be appealed to Supreme Court.

#### 2. Territorial jurisdiction

The only Patent Court among the appellate and district courts with territorial jurisdiction over the entire nation has been located in Daejeon since March 1, 2000.

### II. Structure

#### 1. Trial divisions

Like ordinary appellate courts, three-judge panels enter judgment. The senior judge of a panel shall be the presiding judge under the supervision of the President of the Patent Court.

#### 2. Technical examination officer

The Patent Court shall have technical examination officers in order to supplement expertise in the technical areas.<sup>69)</sup>

##### A. Purpose

In order to supplement the technical aspect of a patent litigation, the system of technical investigation officer in Japan and a technical judge in Germany has been introduced.

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69) Article 54-2.1 of Judiciary Organization Act

## B. Job

### (1) Advising on technical matters

From time to time the technical examination officers will help the judges understand basic concepts of the applied technology and advise the judges on technical matters regarding the document submitted by the parties and the judgment.

### (2) Submitting opinion on technical matters

After reviewing litigation data under direction from the presiding judge, the technical examination officers will submit an opinion or present reports of research on technical matters.

### (3) Inquiring on technical matters

The technical examination officers can ask the parties technical questions, in trial or during pretrial, with the permission of the presiding judge or commissioned judge.

### (4) Stating opinion during deliberation

The technical examination officers will state their opinion on technical issues during deliberation under the presiding judge's permission.

## C. Exclusion, etc.

A technical examination officer participates in the judicial trial (decision-making). But in order to maintain neutrality and fairness, provisions of exclusion and recusal applying to the IPT trial examiner apply here. Also, where the grounds for exclusion or recusal exist, a technical examination officer may recuse himself from trial proceedings related to the case with the consent of the President of the Patent Court. (Article 188-2)

## SECTION 3 FILING A LAWSUIT

### I. Interest in lawsuit

#### 1. Meaning

'Interest in action' is, from a national and a public interest perspective, a principle controlling frivolous lawsuits and, from the parties' perspective is about a justifiable interest or need to use the institution of bringing lawsuits. It allows the court to focus on cases requiring decisions be made on the merit and prevents the opposing party's burden of responding to a frivolous lawsuit.

## 2. Interest in action of patent litigation

Without an interest in action, a patent litigation shall be dismissed.

An interest in a patent litigation concerns not only the patent litigation itself but the interest of an IPT patent trial because it is a lawsuit on appeal to the IPT decision.

## 3. Time to determine interest in action

A. Whether or not an interest in action exists is determined at the time of the conclusion of the trial. If no interest exists as of that time the lawsuit is dismissed.

B. where a right expires while patent litigation is pending

(1) The Patent Act allows an IPT's patent invalidation trial to be requested after a patent is extinguished. When considering the civil or criminal liability, interest in action in a patent litigation should be acknowledged after the patent term expires.

(2) Unlike the IPT's patent invalidation trial, an IPT trial to confirm the scope of a patent right does not have a provision like Article 133.2. Here, the courts, unlike academics,<sup>70)</sup> deny interest in action after a patent is extinguished.<sup>71)</sup> The courts' position is more persuasive because this IPT trial purports to confirm the scope of a patent right in the context of the relationship of the current disputed facts.

## II. Period for filing a lawsuit

### 1. Peremptory period

Article 186 provides that "the action against an IPT decision or dismissal of a request for a trial or new trial may be brought within the thirty-day period immediately after the date on which a certified copy of the IPT decision or ruling was received, and the period may not be changed." It also provides that "for the peremptory period mentioned above, a presiding IPT trial examiner may *ex officio* determine any additional period for the benefit of a person residing in an area that is remote or difficult to access."

70) The theory that, considering a claim of damage suffered before the extinguishment of patent, IPT trial need to be allowed after such extinguishment

71) 94 Hu 2223 decision (Supreme Court, Sep 10, 1996) ("Request for an IPT trial to confirm the scope of an extinguished patent right lacks interest of confirmation.")

## 2. Court to file a lawsuit

A patent litigation is filed by submitting a complaint in the Patent Court, not to the IPT, because it is first and foremost a lawsuit although it is also an appeal to an IPT decision. (\* Appeal to a judgment is filed to the original court.) When a patent lawsuit is filed in the IPT and the IPT transmits the complaint to the Patent Court, the action (bringing) period is calculated based on the complaint filed to the IPT.

When brought, the action becomes pending before a court.

## SECTION 4 PRE-TRIAL PROCEDURE

### I. Meaning

A focused trial requires conducting an organization of issues and evidence (oral argument and evidence investigation), especially witness testimony, before trial. Such procedure conducted under the supervision of an associate judge is called pre-trial procedure.

Generally, a patent or utility model litigation has many specialized, technical issues and complicated facts, and sometimes produces tons of written proof. Thus, in order to explain specialized technology, organize complex issues and written proof and specify the object of trial beforehand, pretrial is necessary in a patent litigation. On the contrary, most design or utility model cases do not have a pretrial procedure.

### II. Patent litigation and pre-trial procedure

#### 1. Purpose of pre-trial

In addition to its general purpose, pretrial in a patent litigation makes it easy to explain the technology because it is conducted in a pretrial conference room in an informal atmosphere. Also, it promotes a speedy, focused trial and can protect patent information and secrets because a pretrial is basically held in private.

#### 2. Time to refer to pre-trial

In practice, when defendant's answer to a complaint and initial brief by both parties are filed, the court determines the date of pre-trial and notifies each party accordingly.

### 3. Commissioning an associate judge

When referring a case to a pre-trial procedure, the court commissions an associate judge of the panel to do so. Generally, for consistency and efficiency of the procedure, the associate judge in charge of the case is commissioned.

### 4. Deciding between open and closed pre-trial; preparation of record

#### A. Participants; deciding between open and closed pre-trial

In principle, a pre-trial procedure is not held in public and is attended only by the commissioned judge, parties, representatives, technical examination officer and a court clerk.

Where a technical explanation is necessary for trial, an engineer of a legal entity or patent firm can attend with the approval of the commissioned judge.

#### B. Preparing pre-trial record

A court clerk prepares the pre-trial record (Articles 149, 141 of Civil Procedure Act) and in the absence of special provisions, provisions on trial record shall apply. Pre trial record becomes part of the case documents and is binding in subsequent litigations. Thus, interested parties have a right of inspection and can make an order to revise the record in the case of obvious mistakes in the record.

### 5. Conducting pre-trial

On the initial pre-trial date the commissioned judge hears the opinion of the parties or representatives on the proceeding and conducts a plaintiff's pleading of purpose and grounds of the action and submission of documents, the opposing party's response and verification of reasoning for decision, and issues an order to further gather evidence for the next pretrial date.

From the second pretrial date, issues and evidence shall be summarized by both parties' argument and the pretrial procedure shall be concluded. However, where a new argument or evidence which may influence the outcome of the litigation is presented, the pretrial procedure can be reopened.

### 6. Measures after conclusion of pre-trial

Where a pretrial is concluded, the commissioned judge shall send relevant documents to the court, and the presiding judge shall set a trial date immediately. Except for cases where witness testimony shall be necessary due to the issue of 'publicly known or worked technology', a new argument or evidence rarely appears in trial. Thus, generally a trial is concluded by stating the result of a pretrial.

## SECTION 5 TRIAL IN PATENT LITIGATION

### I. Content of trial

#### 1. Examination of requirements

This means examining *ex officio* whether or not an action meets requirements for a lawsuit. When such requirements are not met the action is dismissed.

Whether or not requirements for a lawsuit are met is decided as of the conclusion of the trial. However, the period of filing a lawsuit cannot be changed and shall be decided on the basis of the date of filing a complaint.

#### 2. Examination of merit

Here, the court conducts a substantive examination on the merit of the case through hearing arguments by the parties and viewing evidence, in order to decide whether or not to admit or deny the plaintiff's action.

### II. Principle and procedure of trial

#### 1. Meaning

In the absence of special provisions in the Administrative Litigation Act, the Civil Procedure Act applies in the trial of an action to cancel an IPT decision, so general principles of civil procedure such as public, oral hearing and the adversarial system shall apply. Given the public nature of patent litigations, an inquisitorial system also applies.

#### 2. Modified adversarial system

##### A. Principle

In this system, the parties are responsible for gathering and presenting facts and evidence, and only such materials shall become basis for a judgment. Thus, as long as the plaintiff does not assert a defect of an IPT decision, the court cannot cancel such decision.

Also, a lawsuit to cancel an IPT decision is separate from an IPT trial, so if the party fails to assert and prove what has already been asserted and proven in the IPT trial, it shall not be basis for the court's ruling.

## B. Modification and complementing

Administrative litigation such as an action to cancel an IPT decision is directly related to the public interest and the result thereof concerns the state and the public. So, the court plays an active role in the procedure and employs *ex officio* investigation of evidence as a supplement to the adversarial system for just decision making. Also, where statements of the parties are contradictory or vague, the court can exercise its power to clarify them or urge the parties for proof.

## III. Argument by the parties

An action to cancel an IPT decision is basically not too different from a civil or an administrative litigation but a complex, patent related litigation where issues are directly related to technology is generally concluded in trial after conducting a pretrial where issues are organized.

In the trial, generally the plaintiff states a complaint, argues reasons for canceling the IPT decision and presents evidence, while the defendant requests dismissal or rejection of the action, makes a counter-argument and presents evidence.

## SECTION 6 CONCLUSION OF LITIGATION; APPEAL

### I. Cause of conclusion

A lawsuit is concluded by a judgment of the court. Also, acts of the parties such as withdrawal or abandonment of action, settlement or mediation can conclude it.

### II. Conclusion by other than judgment

#### 1. Order to dismiss complaint or appeal

Where a complaint for a patent litigation is filed, the presiding judge of the panel examines it and if mandatory items such as party, statutory representative, prayer for relief and reasoning are missing or the required stamp is not attached or the complaint cannot be delivered, the presiding judge shall order an amendment within a reasonable period. If the complaint is not amended, then the presiding judge shall dismiss the complaint. (Article 231 of Civil Procedure Act, Article 8 of Administrative Litigation Act) When an appeal to the Supreme Court is filed, the presiding judge of the original panel of the Patent Court shall examine it and decide whether or not to dismiss it (Articles 368-2, 395 of Civil Procedure Act) and if the period to file such appeal has clearly expired, the complaint shall be dismissed without an order to amend.

## 2. Withdrawal of an action or appeal

### A. Withdrawal of an action

#### (1) Time for withdrawal

This is a unilateral act of the plaintiff to withdraw all or part of the action brought by the plaintiff, and can be done anytime before the judgment becomes final. (Article 239.1 of Civil Procedure Act)

Withdrawal before the final Patent Court judgment shall render the IPT decision final. If withdrawn after, the court judgment shall become final.<sup>72)</sup>

#### (2) Consent of defendant

Before a defendant files a brief, states in pretrial or argues in trial on the merits, withdrawal does not require consent of the defendant, however, consent is required afterwards. (Article 239.2 of Civil Procedure Act) This is because the defendant has made an active response to the lawsuit and the defendant has a possibility of winning the case.

#### (3) Method

A lawsuit shall be withdrawn in writing. However, it can be done orally during the trial or pretrial. In order to withdraw a request for an IPT trial after filing a withdrawal of action to the court, the plaintiff has to file in the IPT.

While a patent litigation is pending, where the parties agree to settle the dispute in a different fashion from the IPT decision, they shall withdraw the request for the IPT decision and then the lawsuit, because withdrawing the lawsuit first shall result in the IPT decision becoming final.

### B. Litigation deemed withdrawn (absence by both parties)

Where both parties are absent from trial or pre-trial or are present but fail to argue, twice, the action is deemed to have been withdrawn unless one party or both request the court to set a new date within one month.

Also, where litigation documents are lost due to fire, war, or other disasters to the court, the action is deemed to have been withdrawn unless the plaintiff files complaint within six months. (Articles 2, 3 of Act on the Temporary Measures for Civil and Criminal Cases Pending in Cases of Accidents at Court Premises)

### C. Withdrawal of an appeal

In such case, the judgment becomes final.

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72) 97 Da 6124 decision (Supreme Court, Jun 27, 1997) (“Where an employee of a counsel for the plaintiff withdraws action for the entire plaintiffs instead of one as instructed by the counsel, such withdrawal can not be deemed void.”)

### III. Conclusion by judgment

#### 1. Dismissal, etc

These include dismissal of the action or appeal due to failure to meet requirements of a lawsuit, such as expiration of the period to bring an action. Also, they include a declaration that a lawsuit has ended or that a withdrawal of lawsuit is void. *Res judicata* applies to these decisions also.

#### 2. Judgment

##### A. Denial

Judgment denying that plaintiff's claim has merit.

##### B. Admission

Judgment admitting all or part of the plaintiff's claim because the claim has merit.

Where a single IPT decision involves multiple determinations for multiple requests, partial cancellation of the IPT decision is allowed.

#### 3. Effect of judgment

In a judgment canceling an IPT decision, the basic grounds for cancellation binds the IPT; this is called the binding force of the cancellation judgment. An IPT trial is concluded by an IPT decision. Thus, if the court cancels an IPT decision, the IPT trial resumes and the trial examiner shall conduct a trial pursuant to the content of a cancellation judgment.

A binding force only concerns conclusion of the judgment and the finding of fact which is the basis for conclusion and its effect. Other parts of the judgment are not binding and the IPT can make a decision based on 'newly found' facts.<sup>73)</sup>

### IV. Appeal to Supreme Court

Judgment of the Patent Court can be appealed to the Supreme Court. Regarding the procedure, Articles 5 and 8.1,2 of the Administrative Litigation Act and Articles 395, 366 and 367.1 of the Civil Procedure Act apply *mutatis mutandis*.

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73) 88 Daca 5560 decision (Supreme Court, May 8, 1990) ("Supreme Court decision remanding a case to KIPO has a negative binding force in the sense that IPT decision's factual and legal reasoning is not correct. Thus, in a case where its decision is revoked and remanded by the Supreme Court, the KIPO can reach the same conclusion based on different grounds.")

### 1. Period of appeal

An appeal shall be filed at the Patent Court within two weeks of the receipt of the judgment and where the appellant resides in a remote location, the court can extend the period *ex officio*. (Article 159.2 of Civil Procedure Act) When the period has expired, it can be cured in 14 days domestically and 30 days overseas. (Article 5 of Administrative Litigation Act)

Where an appeal does not include the grounds for appeal, the appellant shall file it within 20 days from being notified that litigation documents have been received by the Supreme Court. Formality of an appeal shall be examined by the Patent Court.

### 2. Court to file appeal

Appeal shall be filed at the Patent Court. Appeals filed to the Supreme Court by mistake shall be transferred to the Patent Court but an appeal must be received by the Patent Court within the period of appeal.

### 3. Scope of appeal

The Supreme Court conducts trial only when legal issues in the appealed judgment have influenced its outcome. Regarding factual issues of the original judgment, the Supreme Court can dismiss an appeal, as trial discontinuance. (Act on Special Cases concerning Procedure for Trial by the Supreme Court effective since Mar 1, 1998)

## SECTION 7 PATENT ATTORNEY'S FEE AND COST OF LITIGATION

### I. Meaning

Until now, where a patent attorney represented a winning party in a patent litigation, the party had no grounds for including the patent attorney's fee paid or to be paid by him/her in the cost of litigation and could not compel the losing party to pay for it.

In a lawsuit it is the rule that the losing party pays the cost of litigation, so for a winner to pay his/her counsel just because he/she hired a patent attorney is against fairness. Thus, the Patent Act which was revised on March 3, 2006 treats inclusion of the patent attorney's fee in the cost of litigation the same as the inclusion of attorney's fee.

## II. Patent attorney's fee and cost of litigation

Where a patent attorney represents a party in a lawsuit in the Patent Court or the Supreme Court, Article 109 (attorney's fee and cost of litigation) of the Civil Procedure Act shall apply *mutatis mutandis* to the patent attorney's fee and in such case, 'attorney' shall be read to mean 'patent attorney'. (Article 191-2)

Meanwhile, Article 109 of the Civil Procedure Act acknowledges as cost of litigation fees paid or to be paid by the party to the counsel in the litigation within the amount prescribed by the Supreme Court Rules.

Thus, where a patent attorney represents a party in the Patent Court or the Supreme Court, cost of litigation shall be calculated in the same manner as when calculating the amount for an attorney.