Tae Min Kim and Alice Young Choi from Kim & Chang provide a complete guide to the patent filing and enforcement process in Korea

1. What are the procedures for filing patent applications in your jurisdiction?

Anyone who wants to obtain a patent may file a patent application with the Korean Intellectual Property Office (KIPO). The patent application should be accompanied by a specification, drawings if necessary, and an abstract stating: the title of the invention; a brief explanation of the drawings; a detailed description of the invention; and claims.

The patent application is published in the Patent Gazette 18 months after the priority date of the application, but can be published before 18 months from that date upon request from the applicant.

The Korean Patent Act (KPA) adopts a deferred examination system, in which a patent application is examined only when a request for examination is filed. Any person may request KIPO to examine the patent application within five years of the filing date. If the request for examination has not been made within the time limit, the patent application shall be deemed to have been withdrawn.

When the request for examination is filed, the application will be examined as to whether it meets patentability requirements. If the examiner finds grounds to reject the application, then a notice of preliminary rejection will be issued and the applicant will be given an opportunity to submit a response and an amendment to the preliminary rejection within a time limit.

If the examiner finds that the ground for rejection has been overcome, they will render a decision to grant a patent.

2. How long will it take to register a patent and what are the standard costs?

It takes about 18 months from the date of examination request for a patent application to be examined. This means that if an application is filed together with a request for examination and receives one notice of preliminary rejection before the registration, it will take approximately two years from the filing up to the registration. This time span applies to both an application under the Paris Convention Treaty and a PCT application.

The costs for prosecuting a patent application can vary depending on the number of pages of the specification, the number of claims and other various factors. Attorney fees for filing a patent application in Korea are approximately $2,500 to $4,000 including steps such as filing the application, the translation, and claiming priority. The official fees are $50 to $100. The cost for filing a request for examination depends on the number of claims, and the patent attorney fees and the official fees are $200 to $500 and $300 to $700 respectively. When a patent application is approved and a patent granted, the applicant must pay the first three years’ annuities in a lump sum. The patent attorney’s fee for paying the first three years’ annuities is $100 and the official fee is $38, which is the basic fee, and $33, which is the additional fee for each claim. From the fourth annuity, the annuities may be paid either yearly or in a sum of several years and are gradually increased.

3. What is the scope of patent protection in your jurisdiction?

A patentee shall have the exclusive right to work a patented invention both commercially and industrially. Working means any act falling under any of the following items:

1. in the case of an invention of a product, acts of manufacturing, using, assigning, leasing, importing, or offering for assigning or leasing, which includes displaying for the purpose of assignment or lease;
2. in the case of an invention of a process, acts of using, assigning, leasing, importing, or offering for assigning or leasing the product manufactured by the process, which includes displaying for the purpose of assignment or lease, in addition to the acts mentioned in item 1.
3. in the case of an invention of a process of manufacturing a product, acts of using, assigning, leasing, importing, or offering for assigning or leasing the product manufactured by the process, which includes displaying for the purpose of assignment or lease;
4. in the case of an invention of a process of using a product, acts of using the product, which includes displaying for the purpose of assignment or lease;
5. in the case of an invention of a process of displaying a product, acts of displaying the product, which includes displaying for the purpose of assignment or lease;
6. in the case of an invention of a process of assigning or leasing a product, acts of assigning or leasing the product, which includes displaying for the purpose of assignment or lease; and
7. in the case of an invention of a process of providing a product, acts of providing the product, which includes displaying for the purpose of assignment or lease.

4. Is there substantive examination and if so what is typically the nature and extent of correspondence with the patent examiner?

A patent application, upon the filing of a request for examination, undergoes substantive examination. If the examiner finds a ground for rejecting the application, then a notice of preliminary rejection will be issued and the applicant will be given an opportunity to submit a response and an amendment. Written responses are mainly used for correspondence with the examiner. However, in-person interviews are also frequently used to help the better understanding of the examiner.

5. What are the requirements on obviousness and inventive step?

A patent may not be granted if: the invention was publicly known or practised in or outside of Korea before the priority date; or the invention was described in a publication distributed in or outside of Korea before the priority date. The invention is generally considered to lack novelty if a single reference discloses the same technical constitution.

If an invention is not anticipated by a single prior art, then inventive step is examined. A patent may not be granted for an invention which could have been easily conceived by a person having ordinary skill in the art from prior art publicly known or practised, or described in a publication distributed in or outside of Korea before the priority date.
In general, the inventive step is assessed using a three-prong test: by comparing the purpose, technical constitution, and functional effect of the invention with those of the prior art. Technical constitution essentially refers to the structural elements and limitations of the claimed invention.

If the difference in technical constitution between the claimed invention and prior art is such that the claimed technical constitution would have been particularly unique or difficult to obtain from the prior art, then the claimed invention can be held patentable, even if the functional effects, that is particular benefits, derived from the technical difference are not proven. However, if the technical difference is not considered to be unique or difficult, it is usually necessary to show that there are unexpected or superior functional effects, and/or a unique purpose — task to solve — in the claimed invention.

In cases where two or more prior art references are cited, the difficulty in combining the references to reach a claimed invention based on certain factors may also be considered for assessing the inventive step of the invention.

6. What types of inventions or ideas can be patented? Are there any notable or unusual exceptions?

The term invention means the highly advanced creation of technical ideas utilising rules of nature, as Article 2, Paragraph 1 of the KPA states. Since it cannot easily be determined whether an invention falls under KPA Article 2, Paragraph 1, the KIPO Examination Guidelines exemplify the types of non-statutory inventions, as follows:

- laws of nature, such as the second law of thermodynamics, the law of conservation of energy;
- mere discoveries and not creations;
- those contrary to laws of nature, such as a perpetual motion machine;
- those in which a law of nature is not utilised;
- personal skill, such as a method of performing musical instruments;
- mere presentation of information;
- aesthetic creations;
- computer programming language or computer program, however, an invention where a data processing process by a computer program is specifically executed using a hardware, a data processing unit operating in association with the computer program, its operating method, and a computer readable medium carrying the computer program may be viewed as a patentable invention;
- those whose outcome of the claimed subject matter is not reproducible; and
- incomplete inventions.

Also, methods for the treatment of the human body by surgery, therapy or diagnosis are considered industrially inapplicable and non-patentable.

7. How can you appeal a denied application? Are there any time limits on making an appeal?

If an applicant who has received a decision of refusal of a patent from the examiner has an objection to this decision, they may file a notice of appeal with the Intellectual Property Tribunal (IPT) within thirty days of the date of receipt of the certified copy of the decision. The deadline for filing the notice of appeal may be extended once for two months upon filing a request for extension with payment of the prescribed fee.

Under the recently revised Patent Act, the applicant may amend the specification, claims, or drawings and request a re-examination instead of filing a notice of appeal. Where a request for re-examination is made, a decision to refuse a patent previously made for the patent application shall be deemed to have been withdrawn. In case the Examiner maintains his or her initial position and issues a decision of refusal of a patent at the re-examination stage, then the applicant may file a notice of appeal with the IPT.

8. Is it possible to file pre-grant or post-grant oppositions and if so how do these work?

For pre-grant oppositions, there is an information submission system in Korea. After a patent application is filed, any party may submit information or reference materials to KIPO challenging the patentability of the patent application, which may consist of, for example, prior art references and/or a brief on the technical and legal issues to assist the examiner's understanding. The examiner may issue an office action — preliminary rejection or final rejection — based on the information submission.

For post-grant oppositions, any interested party or a KIPO examiner may file an invalidation action with the IPT at any time from the registration date of the patent to three months after the date of publication of registration of the patent. Where a decision invalidating the patent becomes final and conclusive, the patent shall be deemed never to have existed.

9. What is the process for modifying patents?

A patentee can file a correction petition with the IPT at any time after an application is registered as a patent, even after a patent has expired. However, when an invalidation action has been filed against the patent, the patentee cannot file the correction petition. Rather, the patentee is required to correct the patent during the invalidation action proceedings.

The scope of correction of the claims in a correction petition should meet all of the following requirements:

- The correction should be made only to narrow a claim, correct a clerical error or clarify an ambiguous description.
- The correction is limited in scope to the subject matter disclosed in the description or drawing of the patented invention.
- The correction should not substantively expand or modify the scope of the patent right.
- The corrected claim should have been patentable at the time of filing the application.

Where a decision allowing the correction becomes final and conclusive, the patent application, the publication of the application, the decision on the patent and the registration of the patent shall be deemed to have been made on the basis of this corrected specification or drawing(s).

10. Is there anything else about the filing system in your jurisdiction that patentees should be aware of?

Although patent applications in Korea are examined in the order of when the request for examination is made, KIPO also offers an expedited examination under certain circumstances. A request for expedited examination can only expedite an already requested normal examination, and should be filed simultaneously with or after the filing of the request for normal examination.
11. How can patents be enforced in your jurisdiction? What options do patent owners have?

Procedurally, there are several options for enforcing patents in Korea. Most commonly, a civil court action can be filed against an infringer. Criminal prosecution is also possible, although it is not practical except in extraordinary cases. If the infringing product is imported to or exported from Korea, an action before the Korea Trade Commission (KTC) may be another option.

12. Are there some types of patents that are harder to enforce than others?

Generally, between product inventions such as compounds, compositions, formulations, and devices, and process inventions such as manufacturing processes, processes of using or treating a product, process patents are harder to enforce than product patents. This is because, for a process patent, the patentee should prove that the process is actually being used by the alleged infringer and, unlike an infringing product, it is more difficult to prove that the alleged infringer is using the process subject. However, when a patent is directed to a process for manufacturing a new article as of the time of filing the patent application, articles identical with such novel articles are presumed to have been produced by the patented process, as stipulated in Article 129 of the KPA.

13. Where does the burden of proof lie for infringement allegations?

The patentee who brings the infringement action has the burden of proof for infringement allegations. However, the patentee does not need to submit complete evidence of infringement when filing a complaint with the court. The defendant’s infringement can be proven by various discovery means conducted after the filing of the action. In general, the plaintiff submits the patent register and patent specification as published, along with the complaint. If available, the defendant’s product brochure or newspaper articles on the defendant’s product or business activity may also be submitted.

14. What are the typical remedy options for infringements? How are damages awards calculated?

KPA provides the following three types of civil remedies: preliminary or permanent injunctive relief; compensation for damages; and restoration of injured business goodwill or reputation.

With monetary damages, KPA provides three levels of damages: actual damages sustained by the patentee; profits earned by the infringer; and reasonable royalties. Unlike in the US, wilful or punitive damages are not recognised in Korea. Also, lawyers’ fees are generally not recoverable. Only a very small and fixed amount of lawyer and court fees may be recoverable.

15. How can you appeal an enforcement decision? How long and how costly is the process?

When a preliminary injunction order is issued, the defendant may file an opposition against the order with the same district court, and/or request the court to direct the plaintiff to file a main action. The plaintiff, upon losing the preliminary injunction action, may file an appeal to a high court, and/or file a main action with the district court.

In the case of a main action decision, an appeal must be filed with a high court within 30 days from the date of receipt of the district court decision. A high court decision may also be appealed to the Supreme Court.

It generally takes about nine to 19 months from the filing of the complaint for the district court to issue a decision, about eight to 14 months for a decision by the high court, and about three months to two years for a decision by the Supreme Court. It takes roughly two and a half to four years in total from the first instance to the last instance at the Supreme Court.

The cost generally consists of stamp taxes (filing fees), processing fees, other out-of-pocket costs such as per diem fees for witnesses and photocopies, and lawyers’ fees. The stamp tax is payable by the party instituting the action, including a counterpart claim, and the appeal. The amount levied is calculated by a formula based on the claim amount, which differs according to the type of claim.

The costs for processing services and other out-of-pocket expenses, which include witness fees for local fact witnesses, are nominal. The costs of expert witnesses are determined separately, depending on the charges for the expert.

The stamp taxes, processing services and witness fees are all recoverable in full by the winning party. In principle, legal expenses are to be borne by the losing side and a claim for reimbursement of legal costs can be filed with the court after the final decision has been made. However, lawyer’s fees are not fully recoverable pursuant to Supreme Court regulations and are calculated based on a tariff schedule, which is based on the claim amount.

16. Who holds the burden of proof for patent invalidity claims?

The party who is attacking the validity of the patent holds the burden of proof. While an infringement action is brought before the district court, an invalidation action is filed before the IPT, which is an administrative tribunal within KIPO and comparable to the Board of Patent Appeals in the USPTO. For the validity of a patent, the IPT has exclusive subject matter jurisdiction. The alleged infringer or any other party of interest may file such an invalidation action either in parallel with or independent of a district court action. Also, the Patent Court, as an intermediate appellate court, reviews decisions made by KIPO. Appeals against an IPT decision should be filed before the Patent Court.

17. What kind of expertise does your patent court system hold?

The Patent Court, which is an appellate court specialising in various IP matters, was established in Korea on March 1, 1998. The Patent Court only reviews appeals of IPT decisions, including decisions in invalidation actions, scope confirmation actions and correction actions. In addition, the Patent Court also reviews appeals against IPT decisions upholding KIPO final rejections of patent applications.
18. Who can act in a litigation case in court?

In Korea, both patent attorneys and general attorneys-at-law can act on behalf of a party in actions before the IPT and the Patent Court and in appeals against Patent Court decisions before the Supreme Court.

In patent infringement actions however, only a general attorney-at-law can act on behalf of a party.

19. What are the alternatives to litigation in courts?

As already stated under question 11 above, if the infringing product is imported to or exported from Korea, an action before the KTC may be possible.

20. Are there any other issues relevant to your jurisdiction?

As mentioned above, there are two different routes for patent litigation in Korea. Patent infringement actions are brought before the district court, while administrative actions such as invalidation actions and confirmation of scope actions are brought before KIPO. Accordingly, if the validity or scope of a patent is disputed in an infringement action, a different decision on the validity or scope of the same patent may be made in a separate invalidation action or confirmation of scope action. Administrative actions are not bound by decisions in district court actions, and vice versa.

ALICE YOUNG CHOI

Alice Young Choi is a US attorney in the firm’s Intellectual Property Group. Her work includes all aspects of patent procurement, litigation, and client counselling, with an emphasis on biotech and chemical technologies.

Before joining Kim & Chang, Choi worked at Nixon Peabody from 2000 to 2007, where she gained considerable experience in drafting and prosecuting US patent applications in the chemical and biotechnology fields, including pharmaceuticals, multi-dimensional NMR spectroscopy, medical devices, assays, vaccines, recombinant DNA technology, and plant biotechnology. While there, a large portion of her practice included advising on patent procurement for university and corporate clients and creating and developing their patent portfolios. Choi has also provided opinions on patentability, validity and infringement for clients and worked on patent interference matters.

Choi is admitted to practise in New York and is registered to practise before the US Patent and Trademark Office. She also received her doctorate degree in pharmacological and physiological sciences from the University of Chicago.

TAE-MIN KIM

Tae Min Kim joined Kim & Chang in 1999 and is a patent attorney in the chemical department of the Intellectual Property Group, specialising in the areas of organic chemistry and pharmacology. Kim received his BS in Chemistry in 1998 from Seoul National University and was a visiting scholar from 2006 to 2007 at the University of Washington School of Law. He was admitted to the Korean Patent Bar in 1999. Kim also served as an advisory council for the G4B (Government for Business) Project, an electronic government project, from 2004 to 2005 to enhance corporate competition. He also serves as a member of the Intellectual Property Forum and Korean Patent Attorney Association.

He has extensive experience in prosecuting and litigating patents, counselling in patent infringement and validity matters, and developing intellectual property strategies for companies. In recent years, he has advised clients on freedom-to-operate analysis and validity analysis. He has managed patent portfolios of pharmaceutical companies on patent term extension and various Korean-specific issues regarding pharmaceuticals. He has also handled many trials before the Intellectual Property Tribunal of KIPO and actions before the Patent Court, and has written opinions on infringement and validity.

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