

Newsletter

A Quarterly Update of Korean IP Law & Policy

Spring/Summer 2017

PATENT

Korean Patent Court Dismisses Generics' Challenges to PTE Terms

New Patent Cancellation System Enacted

Korean Supreme Court Reverses 12-year Precedent: Technology Described as Background or in a Claim Preamble is Not Necessarily Prior Art

Supreme Court Affirms Employers Have Duty to Compensate Employee Inventors Even for Weak or Unused Patents

National Core Technology List Updated

TRADEMARK, DESIGN & UNFAIR COMPETITION

Copycat Packaging Enjoined for Unfair Competition on Dilution Grounds

Amendments to the Design Protection Act

FIRM NEWS

AWARDS & RANKINGS

Kim & Chang once again receives top rankings in Chambers Global 2017

Kim & Chang ranked again as a Tier 1 firm in Korea in MIP IP Stars 2017

Kim & Chang ranked Tier 1 across all areas in ALB 2017 IP Rankings

Kim & Chang named Korea Law Firm of the Year at Who's Who Legal Awards 2017

Kim & Chang named Pro Bono Firm of the Year at Who's Who Legal Awards 2017

EVENTS

JPAA's Kinki Branch Office Seminar in Osaka, March 1, 2017

5th Asia Pacific IP Forum in Kanazawa, March 18-19, 2017

INTA's Brands and Fashion Conference in New York, March 22-23, 2017

IPBC Korea 2017 in Seoul, April 28, 2017

JIPA Seminar in Tokyo and Osaka, July 6-7, 2017

EDITORS

John J. KIM
Inchan Andrew KWON

Korean Patent Court Dismisses Generics' Challenges to PTE Terms

By Duck-Soon CHANG, Tae Min KIM and Inchan Andrew KWON

In a recent decision announced on March 16, 2017 that could have led to the severe shortening or elimination of nearly all existing patent term extensions ("PTEs") for pharmaceutical patents in Korea, the Patent Court emphatically rejected the challenges raised by generics against the existing PTE system, and potentially affirmed the validity of the full term of extended patent rights of numerous innovator pharmaceutical companies.

Background

Article 89 of the Korean Patent Act provides that a PTE should be equivalent to the length of time a patented invention cannot be worked after grant due to regulatory approvals or registrations under other statutes required to practice the invention. Article 89 also states that any periods of delay that are attributable to the patentee should not be included as part of the PTE term.

Pursuant to Article 89, the Korean Intellectual Property Office ("KIPO") has been using the following general formula to calculate PTEs in Korea:

PTE period = domestic clinical trial period (from first patient in to last patient out) + Ministry of Food and Drug Safety ("MFDS") review period – any delay attributable to Patentee during the MFDS review period

KIPO has also further defined "delay attributable to Patentee during the MFDS review period" to mean specifically only periods of time where there is a supplementation request pending in all MFDS departmental examinations (standard and testing method; safety and efficacy test; good manufacturing practice; and drug master file) at the same time. In other words, even if there is even a single departmental examination that is proceeding without any supplementation needed, this time period cannot be attributable to the Patentee.

Numerous PTE invalidation actions were filed in Korea by generic companies challenging KIPO's PTE practice in the last two years (partly because the new patent-approval linkage system has incentivized such filings as one basis to obtain generic marketing exclusivity). In view of the

potential impact of this challenge on KIPO's practice, the Patent Court arranged special panels of judges (including the President of the Patent Court) to hear two cases involving the most commonly-asserted PTE invalidity arguments.

Generics had primarily challenged the validity of PTEs on two grounds: that the PTE was invalid on the procedural ground that the marketing approval holder for the drug on which the PTE was granted was not registered as a patent licensee before the PTE application was filed, and that various periods of time included within the PTE should not have been included under the relevant statutes.

The Patent Court's ruling regarding PTE periods

The Patent Court emphasized the following two points as fundamental principles when it verbally announced its decisions in court:

- 1) "Time period during which the patented invention could not have been worked" (*referred to as "Total Delay"*) begins on the day when the test for safety and efficacy is initiated or the day when the patent is registered (whichever is later) and ends on the date when the regulatory approval is "delivered" to the applicant (rather than "issued"), which presumably includes the period from the close of clinical trials to the drug approval application date.
- 2) "Time period of delay attributable to the patentee" (*referred to as "Patentee Delay" as above*) should be construed to mean periods which is the responsibility of the patentee and which can reasonably be said to have caused delay in the regulatory approval.

According to the above principles, the Patent Court rejected all alternative PTE term calculation methods proposed by the generics and found the granted PTE periods to be proper.

While the Court appears to recognize the propriety of the granted PTE periods according to KIPO's current methods, it appears that the Court suggests different standards for

the PTE period (= Total Delay – Patentee Delay), rather than KIPO's current method where the PTE period = clinical trial period + MFDS review period – Patentee Delay.

Implications regarding the Patent Court's decisions

Based on the Court's rulings, if a patentee proves that certain supplementations of documents are not attributable to the patentee or that there is no delay in the regulatory approval that can be reasonably found to be caused by such supplementations, the periods of these supplementations should also be eligible to be included in PTE.

Further, since the Court did not limit the test for drug approval to domestic clinical trials, it is possible other test periods (e.g., clinical trials conducted in foreign countries after the patent registration and reviewed by the MFDS

for the drug approval) may be requested as part of the PTE term. Also, the time period spent to prepare the drug approval application (i.e., from the closing date of domestic clinical trials to the application date of the drug approval) may also be requested as part of a PTE application, with supporting evidence.

However, KIPO has tended to be very conservative about granting PTE terms, and the Patent Court's decisions do not state explicitly that clinical trials conducted in foreign countries or time spent to prepare the drug approval application are also eligible for PTE term. Thus, it is possible KIPO may continue to exclude such periods from PTEs regardless of whether the Patent Court's decisions can reasonably be read to allow them. It is likely that further guidance will be needed from the Patent Court to resolve future cases involving these specific issues.

New Patent Cancellation System Enacted

By John J. KIM and Minhoo LEE

A new patent cancellation system has been enacted for patents registered on or after March 1, 2017. Previously, non-interested parties were permitted to file an invalidation action against a patent within 3 months of the patent being registered (interested parties may file an invalidation action at any time). Now, non-interested parties may no longer file invalidation actions, but any party may file a cancellation action against a patent within 6 months of the patent publication date.

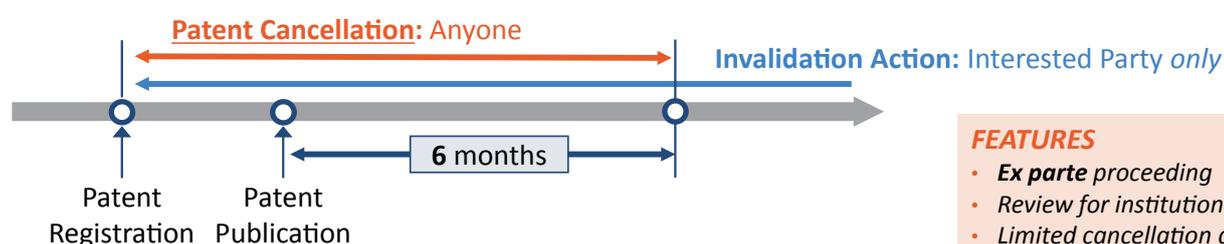
Grounds for Cancellation

The assertable grounds for cancellation are limited to (i) lack of novelty or inventive step in view of "written" publications, including patent and non-patent literature (as opposed to public use or knowledge) and (ii) violation of the first-to-file rule (e.g., the claimed invention being

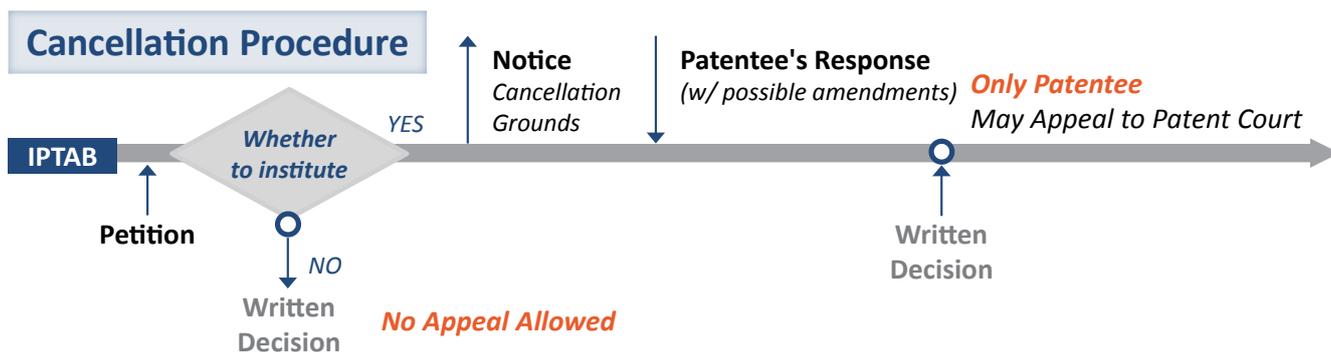
also claimed in an earlier-filed patent application). Other grounds for invalidation, such as violation of patentable subject matter, are not available in cancellation actions. In addition, a petitioner is not allowed to rely *solely* on the prior art cited during the prosecution of the patent. The petitioner may request cancellation based on a combination of prior art references cited during prosecution and a new prior art reference, but at least one new prior art reference is needed.

Time Limit for Petition

A petition for patent cancellation may be submitted from the registration of a patent until 6 months from the publication of the patent. In contrast, an invalidation action may be initiated at any time after a patent is registered, even after the patent has expired.



- FEATURES**
- *Ex parte* proceeding
 - Review for institution
 - Limited cancellation grounds



Procedures

The Intellectual Property Trial and Appeal Board ("IPTAB") of the Korean Intellectual Property Office ("KIPO"), through a panel, reviews cases based only on documentary examination and then issues a written decision.

After a petition has been submitted, the IPTAB will decide whether to institute substantive proceedings after 6 months have passed from the patent publication date. Further, the IPTAB will decide whether to institute proceedings only after reviewing all petitions filed against the patent at issue. That is, if multiple petitions are submitted against one patent, the IPTAB will consolidate them into one proceeding, and issue one written decision for all petitions at the close of the proceeding.

If the IPTAB determines that at least one of the cancellation grounds has merit, the IPTAB will issue a notice including the cancellation ground(s) to the patentee. The patentee will then be given a chance to submit its response with a request for correction (proposed post-grant amendment) within a certain period of time.

It should be noted that although the Korean Patent Act states that the IPTAB shall review a case based on documentary examination, the IPTAB's internal regulation on managing hearings and other similar proceedings allows a patentee or a petitioner for patent cancellation to request an interview with the IPTAB (generally, the responsible IPTAB examiner). In addition, if the case is complicated, the IPTAB has discretion to hold a technical hearing to ask one or both parties to present their explanations and arguments regarding certain issues.

Therefore, it may be strategically advantageous to request an interview or technical hearing if the patent at issue is critical. After the patentee's response, the IPTAB panel will issue a written decision.

Appeal

If the IPTAB finds at least one claim of the patent should be cancelled, then the patentee may appeal to the Patent Court within 30 days from the receipt of the official copy of the decision, with KIPO as the Defendant (accordingly, at the Patent Court, the case turns into an *inter parte* proceeding). However, the petitioner is not allowed to appeal if the IPTAB finds the patent valid.

Effect of Decision

The IPTAB renders a written decision on a claim-by-claim basis (i.e., finding one claim invalid does not mean that the patent as a whole is canceled). If a decision to cancel any patent claims becomes final and conclusive, then the cancelled patent claims are deemed never to have existed. In other words, the cancelled patent claims are *retroactively* invalid. However, there is no estoppel attached to a decision to uphold the validity of a patent claim. Thus, an invalidation action may be initiated based on the same reference(s). In practice, however, since the IPTAB is responsible for both cancellation and invalidation actions, it would be difficult to obtain a different outcome from the IPTAB in a subsequent invalidation action (particularly based on the same references). Therefore, depending on the importance of the patent and budget constraints, challengers generally should plan to file either a cancellation or an invalidation action, not both.

Korean Supreme Court Reverses 12-year Precedent: Technology Described as Background or in a Claim Preamble is Not Necessarily Prior Art

By Duck-Soon CHANG, Injae LEE and Inchan Andrew KWON

On January 19, 2017, in an *en banc* decision,¹ the Korean Supreme Court ruled in a review of a patent invalidation trial that the mere fact that technology is described in the patent specification as background technology or in a claim preamble does not automatically mean that such technology was prior art disclosed to the public prior to the filing date of the patent. This ruling affirmed the previous Patent Court decision.²

Background

A patent claim that recites a preamble, and identifies one or more inventive elements as a point of novelty distinguishable over the content of the preamble, is often referred to as a "Jepson-type" claim. Further, patent specifications usually include a description of the background technology in the invention field. In Korea, courts and examiners have often treated the subject matter described in a claim preamble or in the specification as admitted prior art. An earlier Supreme Court decision³ supported this interpretation.

Case Details

In the present case, in response to a preliminary rejection for lack of inventiveness, the patent applicant amended the subject claim during prosecution into a Jepson-type

claim. The applicant submitted the amendment together with an opinion stating that the elements described in the preamble were prior art. However, it appears the applicant mistakenly believed that the background technology described in the patent was already known to the public.

The Supreme Court held that the presumption that technology described in a claim preamble or as background in the specification is prior art should only apply in limited cases, e.g., where it is clear from the specification and prosecution history as a whole that the description was intended to describe the prior art. Further, the Court held that if the applicant presents evidence that the description as prior art was made in error, the presumption can be rebutted.

Accordingly, the Court reversed its earlier precedent.

Significance / Potential Impact

As a result of the new Supreme Court decision, certain confusing practices in patent and utility model examinations have now been resolved. Also, a new claim interpretation principle has been established – technology described as background in a patent specification or in a claim preamble is not necessarily prior art to the claimed invention.

¹ Supreme Court *en banc* Decision 2013Hu37

² Patent Court Decision 2012Heo7123

³ Supreme Court Decision 2004Hu2031, December 23, 2005

Supreme Court Affirms Employers Have Duty to Compensate Employee Inventors Even for Weak or Unused Patents

By Jongmin LEE, Inchan Andrew KWON and Yoon Chang LEE

- Supreme Court Decision Case No. 2017 2014Da220347, rendered on January 25, 2017

In a much-scrutinized dispute between Samsung Electronics Co., Ltd. ("Samsung") and a former employee researcher regarding the appropriate compensation to be paid by Samsung for the employee's in-service invention, the Supreme Court has finally issued a ruling largely affirming the reasoning of the lower appellate court, and determining that Samsung must pay its former employee approximately KRW 22 million (roughly equivalent to USD 19K).

The case involved two in-service inventions related to a keypad search scheme used in mobile phones. The focus of the Supreme Court's ruling was on one of these inventions, which the lower court had determined was highly likely to be invalidated, and also had not actually been used by Samsung. Though Samsung argued that these circumstances meant that Samsung should not have to pay inventor compensation for this patent, the Supreme Court disagreed, reasoning that non-use and likelihood of invalidation do not *per se* excuse a company from its remuneration duty, though such factors should be taken into account when calculating the proper amount of remuneration.

Regarding likelihood of invalidation, the lower courts had disagreed as to whether Samsung had received any exclusive benefit from the invention in question (regardless of the invalidation issue) that would justify compensation to the inventor (see Seoul Central District Court Decision Case No. 2012Gahap501788, rendered on July 18, 2013;

Seoul High Court Decision Case No. 2013Na2016228, rendered on July 17, 2014). The Supreme Court agreed with the lower appellate court in recognizing some benefit to the employer even if the patented invention had a high possibility of invalidation. In other words, likelihood of invalidation is merely a factor in calculating the amount of inventor compensation, not a complete bar to receiving compensation.

Regarding non-use, both of the lower courts agreed, and the Supreme Court affirmed, that this is also a factor to consider when setting the compensation amount, not a bar to compensation. The Supreme Court reasoned that "even if the product actually manufactured and sold by the employer does not fall within the scope of the in-service invention, it might be a substitute for demand for other products actually implementing the invention. As such, if competitors were unable to use the invention due to the employer's patent rights thereto, and the employer thereby increased its sales, such increased sales could be deemed as a benefit to the employer from the in-service invention."

The Supreme Court held that there are potential benefits to companies from their employees' inventive activity regardless of whether the claimed invention is used or is likely to be invalidated. Thus, an employer is not excused from its duty to remunerate employees for their in-service inventions.

National Core Technology List Updated

By Mikyung (MK) CHOE and Seok Hee LEE

The Ministry of Industry, Trade and Energy ("MOTIE") issued a notification on November 28, 2016 publishing an updated list of the "National Core Technologies" (Notification No. 2016-211). Currently, two Korean statutes govern the outflow/export of technology: (i) the Foreign Trade Law ("FTL") and (ii) the Act on Prevention of Leakage and Protection of Industrial Technology ("ITA"). While the FTL regulates "Strategic Technology" controlled under multinational strategic materials export control regimes, such as the Wassenaar Arrangement, the Nuclear Suppliers Group, etc., the ITA regulates National Core Technology ("NCT"), that is industrial technology which, if leaked, may have a detrimental effect on the national security and development of the national economy due to their substantial economic value. MOTIE is the primary government agency responsible for administering these two laws.

Under the ITA, an exporter of an NCT is required to (i) obtain approval of the export from MOTIE if the technology was a result of R&D supported by government funding or (ii) declare the export to MOTIE if the technology was a result of R&D without government funding. If an NCT subject to export approval/declaration is improperly exported (e.g., without required approval; via incorrect procedures; without export declaration; using a false declaration, etc.), MOTIE may suspend or prohibit the export or order "restoration to the original state" (e.g., revoking export contract). Violators of the ITA will be subject to criminal prosecution. The maximum penalty is up to 15 years

in prison or up to KRW 1.5 billion (approximately USD 1,350,000) fines under the June 30, 2016 amendment to the ITA.

The ITA also regulates a foreign investor's acquisition of, or merger with, a Korean company possessing NCT that is developed through R&D funded by the Korean government's subsidies. If a foreign investor (including a Korean company owned and controlled by a foreign investor) acquires 50% or more of the shares of a Korean company (the "Target Company") (or, if acquiring less than 50%, if the acquiring company will become the largest shareholder having substantial control over the management of the Target Company), and the Target Company owns an NCT that is developed through R&D funded by the Korean government's subsidies, the Target Company must report such acquisition to MOTIE prior to the closing of such transaction – the transaction may not be finalized until MOTIE issues its approval.

The NCT list is regularly updated and includes the following amendments. A new section for machine and robot technology was added having nine (9) sub-technologies. Moreover, one (1) automobile, two (2) nuclear power, one (1) information and communication, two (2) space sub-technologies were added to the list. Further, some of the existing sub-technology items were updated. We recommend reviewing your technologies in view of the amended NCT list below to ensure compliance with the export control law.

List of National Core Technologies (Updated as of November 28, 2016)

Field	National Core Technology
Electrical and Electronics (11)	Design, process and device technology & 3D stacking technology for 30nm or less DRAM
	Assembly and inspection technology for 30nm or less DRAM
	Design, process and device technology & 3D stacking technology for 30nm or less NAND flash
	Assembly and inspection technology for 30nm or less NAND flash
	Design, process, manufacturing (excluding module assembly process technology) and driving technology for 8G (2200x2500mm) or higher generation TFT-LCD panel
	Process and device technology & 3D stacking technology for 30nm or less foundry
	Design, process and manufacturing technology (excluding module assembly process technology) for AMOLED panel
	Design technology, process technology and manufacturing technology for medium & large-size, high-energy density (in case of pouch type 200Wh/kg or more; in case of angular type, 85% of the pouch type) and high-temp stable (50°C or higher) lithium secondary battery for electric automobile, etc.

Field	National Core Technology
Electrical and Electronics (11)	Design and process technology for mobile application processor SoC
	Design technology for LTE/LTE_adv baseband modems
	Modem design technology for WiBro terminal baseband modems
Automobile · Railway (8)	Design and manufacturing technology for gasoline direct injection (GDI) type fuel injection systems
	Design and manufacturing technology for hybrid and electric power based vehicle (xEV) systems (limited to control unit, battery management system, and regenerative braking system)
	Design and manufacturing technology for fuel cell vehicle stack system, hydrogen storage and supply system
	Design and manufacturing technology for liquid phase LPG injection (LPLi) system of LPG vehicle
	Design and manufacturing technology for diesel engine fuel injection apparatus, super charger system and exhaust gas post-treatment apparatus of EURO 6 emission standards or higher (limited to DPF, SCR)
	Design and manufacturing technology for automobile engines and automatic transmissions (limited to technologies within 2 years after mass production)
	Design and manufacturing technology for integrated railway vehicle body using composite materials
	Design and manufacturing technology for power system of high-speed train having speed of 350km/h or higher (limited to AC induction motor, TDCS control and diagnosis, and main power converting device technology)
Steel (6)	FINEX fluidized furnace operation technology
	Manufacturing technology of iron bar/section steel with yield strength 600MPa or higher (limited to product manufactured by electrical furnace with low-carbon steel (0.4% C or less))
	Manufacturing technology for TWIP steel containing manganese for high-processing (more than 10% manganese)
	Manufacturing technology for giga-level high strength steel board containing 4% or less alloy element
	Manufacturing technology for 100 tons or higher (for single product) large-sized cast and forged-steel product for shipbuilding and power plant
	Manufacturing technology for low-nickel (3% or less Ni) and high-nitrogen (0.4% or more N) stainless steel
Shipbuilding (7)	Design technology for high-value-added ships (super-large capacity container ship, low temperature liquid tank ship, large capacity cruise ship, anti-freezing freight ship, etc.) and ocean systems (maritime structure, maritime plant, etc.)
	Manufacturing technology for LNG ship cargo tanks
	Block erection and overland ship building technology for 3,000 tons or more ships
	Manufacturing technology for 500 or higher horsepower diesel engines, crankshafts and propeller with 5 meter or more diameter
	Technology of combined control system and automated navigation for ship
	ERP/PLM system, and CAD-based design and production support program for shipbuilding
	Manufacturing technology for ship core machinery materials (BWMS manufacturing technology, WHRS manufacturing technology, fuel supply device manufacturing technology for ship with gas fuel projection and re-liquefaction & re-gasification device manufacturing technology)
Nuclear Power (5)	Technology for passive auxiliary feed water system of nuclear power plant
	Technology for remote visual inspection of the secondary side of nuclear power plant steam generator
	Development technology for neutron mirror and neutron guide tube
	Manufacturing technology of U-Mo alloy nuclear fuel for research-purpose atomic reactor
	Technology of nuclear reactor output control system for advanced light-water reactor
Information & Communication Technology (8)	Interwork design technology for binary CDMA baseband modem and security algorithm for near field communication
	Intelligent customized learning management and operation technology
	Light weight PKI implementation technology (limited to set-top boxes including DTV and IPTV, mobile terminals and ubiquitous terminals)
	Non-stop detection and avoid (DAA) technology for avoiding signal interference in UWB system
	Design technology for LTE/LTE_adv system

Field	National Core Technology
Information & Communication Technology (8)	Technology for smart device user interface (UI)
	Design technology of PA for downsizing base stations and minimizing electric power usage
	Design technology for LTE/LTE_adv/WiBro/WiBro_adv measuring devices
Space Technology (4)	High-performance cryogenic turbo pump technology
	Technology of cryogenic/high pressure diaphragm actuated opening/closing valve
	Algorithm technology for high-speed activation posture control of satellite cameras with resolution of 1 meter or less
	Solid-state diffusion-bonding component forming technology
Biotechnology (3)	Large scale fermentation and purification technology for antibody (animal cell expression and purification technology for 50,000 liter or more scale)
	Production technology for botulinum toxin formulations (including botulinum toxin strain)
	Manufacturing technology for scanning probe microscopy (true non-contact mode technology, dual servo type XY scanner technology, and 30nm or less semiconductor device cross-section shape 3D imaging technology)
Machine · Robot (9)	Design and manufacturing technology for multi-axis turning centers having capability of turning, milling, precision composite processes
	Design and manufacturing technology for high-precision 5-axis machining centers
	Reliability engineering and manufacturing technology for medium & large-sized excavators
	Design technology for off-road diesel engine and post-processing system of Tier 4F emission standards
	Design and manufacturing technology for load-sensing hydraulic type transmission for tractors
	Technology of high-efficiency turbo compressor working with low global warming potential (GWP) refrigerants
	Design and manufacturing technology for laparoscope and image guided surgical robot system
	Design and production technology of robots for high-density procedure operation
Robot guard system based on video surveillance technology	

Copycat Packaging Enjoined for Unfair Competition on Dilution Grounds

By Seong-Soo PARK, Angela KIM and Won-Joong KIM

Kim & Chang successfully obtained a preliminary injunction recently at the Seoul Central District Court on behalf of its client, Binggrae Co., Ltd. ("Binggrae"), against Dae Food Inc. ("Dae") for selling a product that copied the appearance of Binggrae's well-known banana flavored milk beverage. Significantly, while Dae's product (a banana-flavored jelly snack) technically did not infringe any of Binggrae's registered trademarks, Binggrae was ultimately able to prevail on a dilution theory under Korea's unfair competition law. The two products are shown below.



Dilution under Article 2, Paragraph (1), Item (c) of the Unfair Competition Prevention and Trade Secret Protection Act refers to the act of causing harm to a famous mark or source identifier by using a similar mark or source identifier

to sell or distribute another party's goods. A key issue generally is whether the original mark or source identifier is considered to be sufficiently famous in Korea to warrant protection from this type of unfair competition.

In this case, Binggrae's product packaging had previously been determined to be a well-known source identifier, in a 2005 preliminary injunction action against Haitai Dairy Co., Ltd.'s sales of a rival banana flavored milk beverage.

Consequently, the court found that (i) the appearance of Binggrae's packaging was a well-known source identifier; (ii) the defendant's packaging and product appearance were highly similar to Binggrae's; and (iii) sales of the defendant's product was likely to harm the selling power and reputation of Binggrae's famous trademark, and granted a preliminary injunction.

The court further confirmed that Binggrae had rights to the appearance of its banana milk product even for non-milk products (despite the fact that Binggrae's trademarks on the packaging are only registered for dairy products), because it determined that the appearance of the packaging itself was an intrinsic asset of Binggrae, and because Binggrae itself had used the same packaging on other types of products.

Amendments to the Design Protection Act

By Sung-Nam KIM and Jason J. LEE

Several amendments to the Design Protection Act ("DPA") were published on March 21, 2017, as follows. The amendments will go into effect on September 22, 2017.

1. Grace Period for Design Applications Will Be Extended to One Year

Under the current DPA, a design shall not be deemed to lose novelty over an identical or similar design as long as the application for the design is filed within six months from the date when the identical or similar design was first laid-open. To take advantage of this grace period under the current DPA, the applicant must claim the novelty grace period (i) at the time of filing the application (documentation of the previous disclosure can be submitted within 30 days from the application date), (ii) when filing a response to an office action issued by the Korean Intellectual Property Office ("KIPO"), (iii) when filing a response to an opposition filed by a third party, or (iv) when filing a response to an invalidation action filed by a third party.

The amended DPA extends the current six month grace period to one year. The amendment also replaces (ii) "when filing a response to an office action issued by KIPO" with (ii) "up until KIPO issues a final decision whether to grant a design registration" (so an applicant can now claim the grace period at any time while the application is still pending).

2. Proof of Priority Will Be Eased

Under the current DPA, in order to claim priority, an application must include drawings substantially identical to the drawings in the foreign priority application, and a copy of the priority application certified by the foreign government must also be submitted.

Under the amended DPA, KIPO will now accept certain other documents to confirm the details of the foreign priority application. By this amendment, applicants will be able to use the WIPO Digital Access Service to submit priority documents (the Service allows priority documents to be securely exchanged between IP offices directly).

3. Penalties Will Be Increased for Various Offenses

The maximum fine for perjury by a witness, expert witness or interpreter under oath before the Intellectual Property Trial and Appeal Board ("IPTAB") will be increased from KRW 10,000,000 (approximately USD 9,000) to KRW 50,000,000 (approximately USD 45,000).

The maximum fine for falsely indicating that a design has been registered or applied for will be increased from KRW 20,000,000 (approximately USD 18,000) to KRW 30,000,000 (approximately USD 27,000).

The maximum fine for fraudulently obtaining a design registration or an IPTAB decision related to a design will be increased from KRW 20,000,000 (approximately USD 18,000) to KRW 30,000,000 (approximately USD 27,000).

FIRM NEWS

AWARDS & RANKINGS

Kim & Chang once again receives top rankings in Chambers Global 2017

In the Chambers Global 2017 Guide, a leading global law firm directory published by Chambers & Partners, Kim & Chang has been ranked as a top firm (Band 1) in Korea in all of the 7 practice areas surveyed, achieving the highest number of Band 1 rankings among law firms in Korea. The firm also ranked as a Band 1 firm for General Business Law in North Korea and a Band 4 firm for International Arbitration in the Asia-Pacific region. Moreover, the firm received "Expertise Based Abroad" recognition for Corporate/M&A in China:



South Korea

- Banking & Finance (Domestic Firms): Band 1
- Capital Markets (Domestic Firms): Band 1
- Corporate/M&A: Band 1
- Corporate/M&A: Foreign Expertise for China
- Corporate/M&A: Foreign Expertise for North Korea
- Dispute Resolution-Arbitration: Band 1
- Dispute Resolution-Litigation: Band 1
- **Intellectual Property: Band 1**
- International Trade: Band 1

North Korea

- General Business Law (Expertise based Abroad): Band 1

Asia-Pacific

- Arbitration (International): Band 4

China

- Corporate/M&A (International Firms): Expertise Based Abroad

In addition, 26 Kim & Chang professionals were recognized as "Leading Individuals," and additional 4 professionals were recognized as "Other Noted Practitioners." In the Intellectual Property practice area, **Duck-Soon Chang**, **Sang-Wook Han**, **Young Kim**, **Chun Y. Yang**, and **Jay (Young-June) Yang** were selected as "Leading Individuals," and **Ann Nam-Yeon Kwon** was recognized as one of "Other Noted Practitioners."

Kim & Chang ranked again as a Tier 1 firm in Korea in MIP IP Stars 2017

Kim & Chang has once again been recognized as a Tier 1 firm in Korea in every



category covered – patent prosecution, patent contentious, trademark prosecution, trademark contentious, and copyright – by the Managing Intellectual Property (MIP) IP Stars 2017. This marks the 15th consecutive year that Kim & Chang has received this honor.

MIP identifies leading law firms based on extensive research and in-depth interviews with IP practitioners and clients worldwide.

Kim & Chang ranked Tier 1 across all areas in ALB 2017 IP Rankings

Kim & Chang has been recognized as a Tier 1 firm in Korea in the patents and copyright/trademark categories in Asian Legal Business (ALB)'s 2017 IP Rankings.



ALB is a legal publication owned by Thomson Reuters, the world's leading source of intelligent information for businesses and professionals. Its rankings are based on research and interviews with a wide variety of lawyers and clients in Asia.

Kim & Chang named Korea Law Firm of the Year at Who's Who Legal Awards 2017

Kim & Chang was named "Korea Law Firm of the Year 2017" at Who's Who Legal's Country and State Awards 2017 ceremony held in London on May 15, 2017.



This is the twelfth consecutive year that Kim & Chang has received this honor.

Who's Who Legal, published by Law Business Research Limited, spends months collecting recommendations from both private practitioners and in-house counsel in over 70 jurisdictions in order to identify the global legal market's most widely recognized and accomplished law firms and individuals in multiple areas of business law.

Kim & Chang named Pro Bono Firm of the Year at Who's Who Legal Awards 2017

Kim & Chang was named "Pro Bono Law Firm of the Year" at Who's Who Legal Awards 2017 held in London on May 15, 2017 for the firm's steadfast commitment to pro bono work and for providing phenomenal services in 2016. This is the first time an Asian law firm has received such recognition. Also, Kim & Chang has been recognized as one of the top 10 leading law firms in the world for its pro bono services for four consecutive years.



Who's Who Legal highlighted our firm's dedication to help support and advance our communities and our nation. Some of the highlighted projects included our work for the Overseas Korea Cultural Heritage Foundation, which helped them locate and preserve Korean artifacts found overseas and of international interest. Also mentioned was our work with the Korea Differently Abled Federation, where our professionals carried out comparative analysis on the regulation of care for the disabled across numerous jurisdictions, as well as analyzing the relevant legislation for the benefit of the Federation's work.

"It's a great honor for our firm to have been named as the 'Pro Bono Law Firm of the Year,' but it also carries with it a heavy responsibility," said Dr. Young Joon Mok, former Constitutional Court justice and current chairman of the Kim & Chang Committee for Social Contribution. "Going forward, we will keep focusing on what we believe are the focal points of social contribution – being authentic and being consistent, and on being beneficiary-centered in all of our pro bono activities."

Who's Who Legal, an international legal media affiliated with Law Business Research, has been conducting global surveys on law firms' pro bono services since 2013.

EVENTS

JPAA's Kinki Branch Office Seminar in Osaka, March 1, 2017

Jin-Baek Kim, a patent attorney in Kim & Chang's IP Practice, presented at the JPAA's Kinki Branch Office Seminar, which was held in Osaka, Japan on March 1, 2017. Mr. Kim spoke on "Recent Trends and Practices in Technology and Patent Valuation in Korea."

Organized by the Intellectual Property Evaluation Promotion Center, an affiliated organization of the JPAA (Japan Patent Attorneys Association), the seminar served as a great platform for networking and enhancing the understanding of the recent developments and differences between the Japanese and Korean Patent Valuation Systems.

5th Asia Pacific IP Forum in Kanazawa, March 18-19, 2017

Sang-Wook Han, a senior attorney in Kim & Chang's IP and Japan Practices, attended the 5th Asia Pacific IP Forum, which was held in Kanazawa, Japan on March 18-19, 2017. Mr. Han participated as a speaker in a parallel session entitled "Emerging IP Issues" and presented on "The Role of IP at the 4th Industrial Revolution: The strategy of Korea," sharing his insights on recent trends and prospects surrounding the 4th Industrial Revolution.

This event was co-organized by Hokkaido University Graduate School of Law and Kanazawa University Graduate School of Law, and sponsored by major Japanese research institutes and regional governments. Headlined "Challenges and Opportunities for IP Protection," it served as a great platform to bring together renowned IP professors and professionals from across the world for cooperation and networking.

INTA's Brands and Fashion Conference in New York, March 22-23, 2017

Ann Nam-Yeon Kwon, a senior trademark attorney in Kim & Chang's Trademark Practice, spoke at INTA's Brands and Fashion Conference, which was held in New York on March 22-23, 2017. Ms. Kwon presented the "Unregistered Designs: Working Your Way Out of the Shadows and into the Light" session at the conference.

Founded in 1878, INTA (The International Trademark Association) is a global not-for-profit membership association of trademark owners and professionals dedicated to supporting trademarks and related intellectual property in order to protect consumers and to promote fair and effective commerce. The conference proved to be an extraordinary opportunity for industry and brand experts to network and address issues relevant to the establishment of fashion brands on a global level.

IPBC Korea 2017 in Seoul, April 28, 2017

Man-Gi Paik, a senior patent attorney in Kim & Chang's IP Practice, attended the Intellectual Property Business Congress (IPBC) Korea 2017, which was held in Seoul on April 28, 2017. Mr. Paik participated as a moderator in a panel discussion titled "IP highlights in Asia and beyond," and facilitated a discussion on key changes to patents, their implications to Korean corporates, and strategic considerations in the global marketplace.

Hosted for the second time by Intellectual Asset Management (IAM), a leading IP business information provider, this one-day, invitation-based event proved once again to be a unique platform for senior IP delegates from across the world to discuss the key issues and challenges surrounding IP value creation and corporate IP practice.

JIPA Seminar in Tokyo and Osaka, July 6-7, 2017

Joon Lee, a patent attorney in Kim & Chang's IP Practice, has been invited to speak at the upcoming JIPA Seminar on Patent Systems in Asia, which will be held in Tokyo and Osaka, Japan on July 6-7, 2017. Mr. Lee will present on the Korean patent system, highlighting recent developments, case studies, and unique practical aspects.

JIPA (Japan Intellectual Property Association) is a non-profit, non-governmental organization founded in 1938. With the objective of contributing to the creation of a better IP environment, JIPA studies and addresses global IP-related issues and policies, and regularly hosts formal and informal gatherings to bring together IP professionals for information exchange, cooperation, and networking.

IP Newsletter

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