Patent Examination Guidelines

July 2013

Korean Intellectual Property Office

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(Note) This English version of the Korean Intellectual Property Office's Patent Examination Guidelines is based on Korean Patent Examination Guidelines published in July, 2013. If there is any inconsistency or ambiguity between the Korean version and English version, the Korean version shall prevail.

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PART I. General Rules

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Chapter 1. Capacity

1. Relevant Provisions

Article 3 of the Patent Act (Capacity of Minors etc.) ① Minors, quasi-incompetents and incompetents may not initiate a procedure for filing an application, requesting an examination or any other patent-related procedure (referred to as "a patent-related procedure") unless represented by a legal representative. However, this provision does not apply where a minor or quasi-incompetent can perform a legal act independently.

② The legal representative referred to in paragraph ① may act without the consent of the family council in any trial or retrial procedure initiated by another party.

③ Deleted

Article 4 of the Patent Act (Associations etc. Other than a Juristic person) A representative or an administrator designated by an association or a foundation that is not a juristic person may request an examination of a patent application, or appear as a plaintiff or defendant in a trial or a retrial in the name of the association or foundation.

Article 5 of the Patent Act (Patent Administrator for Nonresidents) ① A person who has neither a residential nor business address in the Republic of Korea (referred to as "a nonresident") may not, except when the nonresident (or a representative of the nonresident if a juristic person) is sojourning in the Republic of Korea, initiate any patent-related procedure or appeal any decision taken by an administrative agency in accordance with this Act or any decree under this Act, unless the person is represented by a representative (referred to as "a patent administrator") who has a residential nor business address in the Republic of Korea.

② A patent administrator shall, within the scope of powers conferred on the patent administrator, represent the party involved in all procedures related to a patent and in any appeal against a decision taken by an administrative agency in accordance with this Act or

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any decree under this Act.

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Article 25 of the Patent Act (Capacity of Foreigners) Foreigners who have neither a residential nor business address in the Republic of Korea are not entitled to enjoy patent rights or other patent-related rights, except under any of the following circumstances:

(1) where their country allows nationals of the Republic of Korea to enjoy patent rights or other patent-related rights under the same conditions as its own nationals;

(2) where their country allows nationals of the Republic of Korea to enjoy patent rights or other patent-related rights under the same conditions as its own nationals when the Republic of Korea allows their country's nationals to enjoy patent rights or other patent-related rights; or

(3) where they may enjoy patent rights or other patent-related rights according to a treaty or the equivalent of a treaty (referred to as "a treaty").

Article 26 of the Patent Act (Effects of a Treaty) Where a treaty contains a patent-related provision that differs from this Act, the treaty prevails.

2. Patent-related procedures

(1) A patent-related procedure under the Patent Act, the Enforcement Decree of the Patent Act and the Enforcement Rules of the Patent Act refers to the procedure for filing an application, requesting an examination or any other patent-related procedure, as defined in Article 3 of the Patent Act. The patent-related procedures are the procedures which are carried out by an applicant, petitioner, requestor or another party (hereinafter referred to as 'an applicant, etc.') against the Commissioner of the Korean Intellectual Property Office, an examiner, the President of the Intellectual Property Tribunal, an administrative patent judge,

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or a trial examiner (hereinafter, referred to as 'the Commissioner of the Korean Intellectual Property Office, etc.'), including the procedures ①~③.

① Procedure for filing an application

Patent application, Divisional application, Converted application, Application filed by a legitimate right holder, Application for registration of an extension of patent term, PCT application, etc.

② Procedure for requesting an examination

Request for an examination, request for a reexamination, other requests for trial (including request for trial filed by an examiner), request for technical evaluation, and request for retrial, etc.

③ Other patent-related procedure
Procedures initiated by an applicant, etc. against the Commissioner of the Korean Intellectual Property Office, etc. in conjunction with the abovementioned procedures ① and ②, and other procedures such as request for accelerated examination and request for deferral of examination

(2) A patent-related procedure excludes the procedure initiated by the Commissioner of the Korean Intellectual Property Office, etc. against an applicant, etc. (notifications, requests, etc.), the procedure of examination processing within the Korean Intellectual Property Office (formality examination, classification, prior art search and substantive examination), the procedure initiated by an applicant, etc. against a court (patent court), the procedure for an administrative trial, ordinary complaints filed by the general public, the procedure (warning) initiated by an applicant, etc. against a third party.

3. Incompetents

3.1 Purport of System

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The Civil Act defines a minor, a quasi-incompetent or an incompetent as a person without capacity. For a person without legal capacity to perform a juristic action, obtaining the consent of a legal representative is required. Based on the Civil Act, the Korean Patent Act bans minors, quasi-incompetents or incompetents from initiating a patent-related procedure unless a legal representative performs a juristic action on behalf of them, for the protection of incompetents.

3.2 Capacity of Incompetent

(1) The term 'an incompetent' used in the Patent Act is derived from the Civil Act. The term includes ① a person under age of 20 (minor), ② a feeble-minded person or a spendthrift who may bring poverty to himself or his family who is adjudicated quasi-incompetent by a court (quasi-incompetent) and ③ a person in a habitual condition of mental unsoundness who is adjudged incompetent by a court (incompetent).

(2) An incompetent can initiate a patent-related procedure only when represented by a legal representative. However, Article 3(1) of the Patent Act stipulates that this provision does not apply where a minor or quasi-incompetent can perform a juristic act independently. It defines the case where a minor or quasi-incompetent makes an independent legal action without representation of a legal representative.

The cases where an incompetent person can perform a legal action independently include the act of merely acquiring rights or being relieved from obligations (Article 5(1) of the Civil Act), the act of disposing of property permitted for disposal (Article 6 of the Civil Act), the act of carrying on a special business permitted for operation (Article 8(1) of the Civil Act), the act of agent (Article 117 of the Civil Act), the act of making will (Article 1062 of the Civil Act), and the act done as a member with unlimited liability of a company (Article 7 of the Commercial Act).

A possible act in conjunction with a patent-related procedure may include the act of a specific business operation permitted by a legal representative and the act of a minor regarded as a grown-up because of marriage even before the age of 20.

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(Note) A minor cannot initiate a patent-related procedure without the consent of a legal representative, even through an agent designated for the minor.

3.3 Ratification of Procedure Initiated by Incompetent

Article 7bis of the Patent Act provides that patent-related procedures, initiated by a person who lacks capacity, the power of legal representation or the authorization necessary to initiate any such procedures, shall have effect retroactively to the time when such procedures are performed if the procedures are ratifies by the party involved when he/she has gained capacity to proceed. It means that procedures initiated by an incompetent person or a person without authority of legal representation take effect retroactively from the time of the initial act because of ratification by a legitimate party involved in a later time.

Where it is revealed during the formality examination procedure that a patent-related procedure is initiated by a minor or other incompetents, an examiner shall order an amendment within the designated period under Article 46 of the Patent Act in the name of the Commissioner of the Korean Intellectual Property Office. Unless a party involved after the amendment or a legal representative ratifies the procedure within the designated period, the concerned patent-related procedure shall be invalidated.

(Note) An incompetent person shall initiate a patent-related procedure through a legal representative even for any patent-related procedure which can be easily initiated by anyone according to the provisions of the Patent Act, such as a request for an examination and an act of providing information, etc.

4. Capacity of Association such as Juristic person

4.1 Capacity of Juristic Person

(1) A juristic person obtains rights and obligations granted based on the Act, independent of its members. However, a juristic person cannot act as a natural person even though it can become the subject of rights and obligations. Therefore, a juristic person designates a particular organization (for example, the board of directors) and regards the acts of the

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organization as those of the juristic person.

Under the Patent Act, too, the scope of capacity of a juristic person is the same as that under the Civil Act. Where a juristic person initiates a patent-related procedure, the name and the business address of the juristic person shall be stated.

(2) Changing a juristic person to other types of business entity (from an incorporated company to a corporation or from an unlimited partnership to a limited partnership, etc.) does not mean to change the subject of substantive rights and obligations. Therefore, it shall be deemed the change of name, other than the change of the holder.

In such a case, a written report of the change (correction) of applicant code information (Annexed Form No.5) shall be submitted to change the type of business entity according to Article 9(3) of the Enforcement Rules of the Patent Act.

(3) When it is decided to commence rehabilitation procedures under the Debtor Rehabilitation and Bankruptcy Act, the authority to conduct the debtor's business and manage and dispose of his/her assets shall be exclusively vested in a custodian. In a lawsuit on the assets of the business, an administrator shall serve as a plaintiff or defendant (Case No. 97 Hu 3371(Supreme Court, 26. January. 1999)).

4.2 Capacity of National or Local Government

(1) A nation shall serve as the subject of rights as a juristic person even though there are no such provisions in the law. However, the legislative, judicial and administrative branches, government-affiliated organizations, state-run research institutes, universities are not entitled to be a juristic person. Therefore, they cannot become the subject of a patent-related right.

(Note) The Patent Act does not have provisions for a person who can become the subject of a patent application or capacity of the party involved. Therefore, reflecting on the nature of a patent right and the Patent Act, only a person with any capacity as well as capacity to be a party involved defined in the Civil Act and the Law of Civil Procedure can become a patent applicant or the subject of the trial and lawsuit. In this case, Kyungbook National University,

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the applicant, is not capable of becoming the applicant under the Civil Act. Therefore, the university cannot become a patent applicant, claimant of appeals or appellant. If the intention was to regard Korea as an applicant to file a patent application in the name of Kyungbook National University, the university should have filed the application in the name of the Republic of Korea. Or, if the university had intended to file the application in the name of the president of the university, the president should have corrected the name of the party involved by changing the name of the applicant and that of the requester (Case No. 96 Hu 825(Supreme Court, 26. September. 1997)).

(2) Article 2 of the Local Autonomy Act defines that a local government shall be deemed to be a juristic person. Therefore, local governments can become the subject of rights. Types of local government include the Special Metropolitan City, Metropolitan City, *Do, Si, Gun* and *Gu.* A *Gu* shall be confined to *Gu* within the jurisdiction of the Special Metropolitan City or a Metropolitan City (autonomous *Gu*). Therefore, a *Gu* in *Si* (e.g. *Yeongtong-Gu* in *Suwon-City*), other than autonomous *Gu*, shall not become the subject of rights.

4.3 Capacity of Associations etc. which are not Juristic Persons

Associations which are not juristic persons refer to those without legal personality because they did not register the establishment of juristic person. Such associations include clan gatherings, alumni meetings, churches, academies and so on. In principle, associations without legal personality cannot initiate a patent-related procedure, such as filing a patent application, because of their lack of capacity.

However, where an association or a foundation other than a juristic person has a representative or an administrator, the association or the foundation can become the party involved for the procedures of a request for examination of an application, a request for technical evaluation on utility models, a request for trial, a request for reexamination or procedures of being requested for trial or reexamination.

5. Capacity to Act of Overseas Residents

A person who has neither an address nor a place of business address in the Republic of

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Korea (hereinafter, referred to as overseas residents) shall not carry out any patent-related procedure unless through a patent administrator. Also, the person shall not appeal any decision taken by an administrative agency based on the Patent Act or any orders under the Patent Act.

Where even a national of the Republic of Korea does not have an address or a place of business domestically, patent-related procedures shall be carried out by his/her patent administrator.

Where an overseas resident initiates a patent-related procedure without designating a patent administrator, an examiner shall give him/her an opportunity for explanation and, if not addressed, return the documents to the overseas resident according to Article 5 of the Patent Act and Article 11 of the Enforcement Rules of the Patent Act.

6. Capacity of Foreigners

Foreigners can enjoy patent rights under Article 25 of the Patent Act only in the following cases: ① where their country allows nationals of the Republic of Korea to enjoy patent rights or other patent-related rights under the same conditions as its own nationals; ②where their country allows nationals of the Republic of Korea to enjoy patent rights or other patent-related rights under the same conditions as its own nationals when the Republic of Korea allows their country's nationals to enjoy patent rights or other patent-related rights; or ③ where they may enjoy patent rights or other patent-related rights according to a treaty or the equivalent of a treaty.

A foreigner or a stateless person who has an address or a place of business in the Republic of Korea shall enjoy patent rights in Korea regardless of whether the country to which they belong allows nationals of the Republic of Korea to enjoy patent rights or other patent-related rights.

(Note) In principle, where a foreigner has neither an address nor a place of business address in the Republic of Korea, his/her capacity of industrial property rights is not recognized. However, as an exception, where a treaty or an agreement has been concluded

or where the country where the foreigner belongs allows nationals of the Republic of Korea to enjoy patent rights or other patent-related rights, even though the nationals of the Republic of Korea have neither an address nor a place of business within the country, the Republic of Korea, too, shall be deemed to allow the foreigner to enjoy industrial property rights. It does not necessarily mean that the law of the country to which the foreigner belongs defines the Republic of Korea as a country which recognizes trademark rights ((Case No.74 Hu 61(Supreme Court, 27. April. 1976)).

7. Effect of Treaty

Article 6 of the Korean Constitution stipulates that treaties duly concluded and promulgated under the Constitution and the generally recognized rules of international law shall have the same effect as the domestic laws of the Republic of Korea.

Currently, the Republic of Korea is a member state to the Convention Establishing the World Intellectual Property Organization (March 1, 1979), the Paris Convention (May 4, 1980), the Patent Cooperation Treaty (August 10, 1984), Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure (March 28, 1988), and Strasbourg Agreement Concerning the International Patent Classification (October 8, 1999). The joining to the Patent Law Treaty (PLT) adopted on June 1, 2000 is under consideration.

The patent treaties to which the Republic of Korea has joined rarely conflict with the Korean Patent Act. However, the treaties shall be referred to for examination since some of the treaties contain more detailed contents than the Korean Patent Act. For example, even though Article 54 of the Patent Act defines that only a patent application is eligible for an application initially filed in one of the countries under the Treaty, the Paris Convention provides that even if the initial application under the Treaty is an application for patent, utility model or design or inventor's certificate, an applicant may file an application claiming priority. Therefore, where an initial application falls under other types of applications such as an application of utility model registration, other than a patent application, its priority claim shall be recognized.

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Chapter 2. Agents

1. Relevant Provisions

Article 6 of the Patent Act (Scope of Power of Attorney) Unless expressly empowered, a representative instructed to initiate a patent-related procedure before the Korean Intellectual Property Office by a person whose residential or business address is in the Republic of Korea may not change, abandon or withdraw an application for a patent, withdraw an application to register an extension for the term of a patent right, abandon a patent right, withdraw a petition, withdraw a request for a motion, make or withdraw a priority claim under Article 55(1), request a trial under Article 132*ter* or appoint a sub-representative.

Article 7 of the Patent Act (Proof of Power of Attorney) The power of attorney for a representative (including a patent administrator) who is initiating a patent-related procedure must be confirmed in writing.

Article 7*bis* of the Patent Act (Ratification Regarding Defect in Legal Capacity, etc.) Where the correct party or legal representative ratifies any procedure initiated by a person with no legal capacity or authority of legal representation or by a person to whom the authority required to initiate the patent-related procedure has been delegated defectively, the ratified procedure is deemed to have been initiated at the time the procedure was originally initiated.

Article 8 of the Patent Act (Continuation of Power of Attorney) The power of attorney of a representative representing a person initiating a patent-related procedure is not extinguished upon the death or loss of legal capacity of the party involved, the extinguishment of a juristic person of the party involved due to a merger, the termination of the duty of trust of the party involved, the death or loss of legal capacity of the legal representative or the modification or extinguishment of the power of attorney.

Article 9 of the Patent Act (Independence of Representation) Where two or more agents

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of a person initiating a patent-related procedure have been designated, each of them may independently represent the party involved before the Korean Intellectual Property Office or the Intellectual Property Tribunal.

Article 10 of the Patent Act (Replacement of Agents etc.) ① Where the Commissioner of the Korean Intellectual Property Office or the administrative patent judge considers that a person initiating a patent-related procedure is not qualified to conduct the procedure or make oral statements and so on, the Commissioner or administrative patent judge may order *ex officio* the appointment of a representative to conduct the procedure.

② Where the Commissioner of the Korean Intellectual Property Office or the administrative patent judge considers that a representative representing a person initiating a patent-related procedure is not qualified to conduct the procedure or make oral statements and so on, the Commissioner or administrative patent judge may order *ex officio* the replacement of the agent.

③ The Commissioner of the Korean Intellectual Property Office or the administrative patent judge may, in the case referred to in paragraphs ① or ② of this Article, order the appointment of a patent attorney to conduct the procedure.

④ The Commissioner of the Korean Intellectual Property Office or the administrative patent judge may invalidate any action taken before the Korean Intellectual Property Office or the Intellectual Property Tribunal by a person initiating a patent-related procedure referred to in paragraph ① of this Article or by a representative referred to in paragraph ② of this Article before the appointment or the replacement of a representative referred to in paragraphs ① or ②, respectively, after issuing the order referred to in paragraphs ① or ②.

Article 11 of the Patent Act (Representation of Two or More Persons) ① Where two or more persons jointly initiate a patent-related procedure, any of them may represent the joint initiators except for actions falling under any of the following subparagraphs, unless they have appointed a common representative and have notified the Korean Intellectual Property Office or the Intellectual Property Tribunal of the appointment of the representative:

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(i) change, abandonment or withdrawal of a patent application or withdrawal of an application to register an extension for the term of a patent right;
(ii) withdrawal of a petition; claim or withdrawal of a priority claim under Article 55(1);
(iii) withdrawal of a request; and
(iv) a request for a trial under Article 132*ter*.

② Where a common representative has been appointed and notification has been given under the proviso of paragraph ①, written proof that the representative has been appointed must be presented.

2. Overview of Representation

(1) The representation system under the Patent Act is derived from the representation system in the Civil Act or the Law of Civil Procedure. However, there exist some differences in the representation system under the Patent Act because of unique characteristics of a patent-related procedure. The provisions of the representation system under the Patent Act include Articles 3(Capacity of Minors etc.), 5(Patent Administrator for Nonresidents), 6(Scope of Power of Attorney), 7(Proof of Power of Attorney), 8(Continuation of Power of Attorney), 9(Independence of Representation), 10(Replacement of Agents etc.) and 12(*Mutatis Mutandis* Application of the Civil Procedure Act).

(2) Agents include legal representatives and designated representatives. Legal representatives refer to those provided under the legal provisions regardless of the subject's own intention, whereas a designated representative holds the power of attorney by the subject's own intention, as defined in Article 6 『Scope of Power of Attorney』 and Article 5 『Patent Administrator for Overseas residents』 of the Patent Act.

Generally, a patent attorney is designated as a designated representative. However, a designated representative for a patent or utility model registration under the Korean Intellectual Property Office can be anyone unless he/she serves as a representative by profession.

(3) A patent attorney shall engage in the business of acting as a representative on the

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matters to be directed to the Korean Intellectual Property Office or courts concerning patent, utility model, design, or trademark at the patent office or the court of patent, or perform appraisal and other acts thereon.

Even if a person is a qualified patent attorney, an unregistered patent attorney cannot carry out procedures as a patent attorney. There should be punishment if that person has conducted business as a patent attorney.

Also, a parent attorney shall not handle a case which he has previously handled as a representative of the other party of the same case. A person who is not a patent attorney shall not use the title of patent attorney or similar titles.

If a patent attorney violates Article 7 of the Patent Attorney Act (Case which shall not be handled) by handling the case of the other party in a patent-related procedure, or if a patent attorney violates Article 124 of the Civil Act (Representation on His Own Behalf, Representation of Both Parties), it shall be viewed as inadequacies in granting the power of attorney. In such a case, an examiner shall order both parties and the agent for amendment to a patent-related procedure under Article 46 of the Patent Act. If inadequacies are not addressed, the procedure for designating a representative shall be invalidated.

(Note) Article 7 of the Patent Attorney Act stipulates that a patent attorney shall not handle a case which he has previously handled as a representative of the other party of the case. This should be translated that a patent attorney shall not handle the same case as a representative of the other party of the case, holding the position against the party he initially worked for in the case. For example, Patent Attorney "L" handled the filing of the application and registration of Trademark A of Party A, but Party A initiated a lawsuit of invalidation, citing Trademark A of Party A is similar to Trademark B of Party B. However, Attorney L's representation of Party B as a representative of the case cannot be seen as the violation of Article 7 of the Patent Attorney Act ((Case No. 81 Hu 51 (Supreme Court, 27. April. 1982)).

3. Legal Representative

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(1) A legal representative refers to someone provided as a representative by the legal orders, without the consideration of his/her intention. The legal representative system is designed to protect the rights of a person who is incapable of initiating a lawsuit.

Whether a right of legal representation is granted by law or by designation of the offices such as the court does not affect the way of the designation.

Meanwhile, a representative designated by the legal order of the court(Article 144 of the Civil Procedure Act) or by the designation (replacement) order of the Korean Intellectual Property Office(Article 10 of the Patent Act) is a designated representative, other than a legal representative, because the designation of a representative was made by the party itself.

(2) In principle, the generation, change and extinguishment of the authority for legal representation shall be carried out according to the Civil Act. Based on the Civil Procedure Act, where the authority of legal representation is extinguished or changed, the party involved or agent cannot claim the effects of the extinguishment or change of the right unless it is notified to the other party, as in the examples of the Civil Procedure Act. Grounds for extinguishment of the authority of legal representation include death of the party involved or legal representative, adjudication of incompetency or bankruptcy of legal representative, resignation or removal of guardian.

Meanwhile, a patent-related procedure shall be interrupted when a legal representative dies or loses an authority of legal representation.

(3) Under the Civil Act, the authority of legal representation of legal representatives such as a person with parental authority or a guardian is widely acknowledged, since they are less likely to do damage to the party involved in transactions. Under the Patent Act, too, even though a legal representative does not obtain the special power of attorney when initiating a patent-related procedure in representation of the party involved, he/she may perform an act of representation for the special power of attorney under Article 6 of the Patent Act.

However, a person with parental authority and a guardian have different scopes of

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authority even though both are legal representatives. A person with parental authority under Article 3 of the Patent Act can initiate any patent-related procedure including trial or retrial, let alone the special power of attorney, without the consent of family council. On the other hand, a guardian may initiate procedures filed at the request of the other party, such as trial or retrial, without the consent of the family council. However, he/she shall obtain the consent of family council to perform any act for the purpose of a right to obtain a patent or acquisition, forfeit or alteration of a patent right, as well as an act of requesting a trial or retrial.

(Note) Under the Civil Act, too, a guardian has more restricted powers of attorney than a person with parental authority in performing one of the following acts: ① an act to conduct business; ② an act to contract a debt or to stand surety; ③ an act which aims at acquisition, forfeit and alteration of right and title on immovables or important property; and ④ an act to bring an action to the court. Where a guardian performs such acts in place of the ward or allows minors or quasi-incompetents to perform such acts, the guardian shall obtain the consent of family council.

(4) Where a legal representative initiates a patent-related procedure, he/she shall state such facts in the 'Agent' box in a written patent application, etc. and submit the evidential documents. Generally, if a person with parental authority intends to serve as a legal representative, submitting a certified copy of resident registration or family relations certificates would suffice.

Where a guardian intends to serve as a legal representative, the guardian shall submit the evidential document for such intention. Moreover, for a guardian to initiate procedures other than the ones defined in Article 3(2) of the Patent Act, the consent of family council shall be obtained. Therefore, the guardian shall submit the evidential documents of the consent of family council. Also, it is possible to secure the consent of family council for procedures either individually, or all at once.

(Note) Where an examiner can confirm through the system of the interorganizational use of the resident registration database whether the person acting in place of the ward is a legal representative, the examiner shall not require an applicant, etc. to submit the evidential

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documents.

4. Designated Representative

(1) A designated representative refers to a person who receives a credential of a party involved and becomes a representative by the intention of a party involved. The definition of a designated representative includes not only a representative with power of attorney, but also a representative on a contract of conduct of practices, let alone a contract of power of attorney. Patent administrators and designated agents are also designated representatives.

(2) The power of representation of a designated representative is created when a party involved grants power of attorney to another party.

(3) The power of representation is extinguished when a party involved withdraws the delegation of authority.

Unlike causes for lapse of the power of representation specified in Article 127 of the Civil Act, the Patent Act stipulates that the power of representation shall not lapse for the causes of the death or loss of legal capacity of the party involved, extinction of a juristic person of the party involved due to a merger, the termination of the duty of trust of the party involved, the death or loss of legal capacity of the legal representative, or the modification or extinction of his/her authority of representative. If the Patent Act had the same article as Article 127 of the Civil Act, a procedure initiated by a legal representative without noticing the death of a party involved would become invalidated and an urgent procedure could not be initiated, leading to doing an unexpected damage to an heir of the party involved and adversely affecting all the examination- and trial-related procedures. Considering all the possible problems, the system of a designated representative is designed to address such issues.

(4) A representative representing a person initiating a patent-related procedure (except a patent administrator of an overseas resident) cannot perform any of the following acts unless he/she obtains the special power of attorney: the change, abandonment or withdrawal of an application (withdrawal of application for registration of patent term

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extension); the abandonment of a patent right, withdrawal of a patent application, withdrawal of request, claim or withdrawal of Domestic Priority under Article 55(1) of the Patent Act and the request for trial or designation of subagent under Article 132(3) of the Patent Act. For example, where the scope of power of representation is written as 'all matters regarding to the application' in the Designation of Power of Representation box, the scope of power of representation does not include the power of attorney.

The delegation of special power of attorney is required to represent an Domestic Priority claim. The special power of attorney is stated as in the following examples to specify a prior application.

Case	Written Power of Attorney of Prior Application	Written Power of Attorney of Domestic Priority Application
Where the special power of attorney is granted to priority claim at filing a prior application	Any matter regarding to Application○○ (Special power of attorney related to priority claim) Priority claim or its withdrawal under Article 55(1) of the Patent Act according to Application○○ or under Article 11 of the Utility Model Act applied with Article 55(1) of the Patent Act	Any matter regarding to Application○○ ※ Description on special power of attorney unnecessary
Where the special power of attorney is granted to priority claim at filing an Domestic Priority application	Any matter regarding to Application○○ ※ No description on special power of attorney related to priority claim	Any matter regarding to Application○○ (Special power of attorney related to priority claim) Priority claim or its withdrawal under Article 55(1) of the Patent Act according to Application No. ○○ filed in (Year) or under Article 11 of the Utility Model Act applied with Article 55(1) of the Patent Act

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(Note) A patent-related procedure refers to all procedures after the registration of a patent right such as application, request, etc. In the case of a utility model registration, a procedure regarding technical evaluation after the registration of utility model, too, is included in a patent-related procedure. Therefore, if a representative has power of attorney regarding matters related to technical evaluation at the time of submitting a written application, the agent can represent the matters regarding requests for technical evaluation.

5. Patent Administrator

(1) A person who has a residential or business address in the Republic of Korea can initiate a patent-related procedure without designating a legal representative. However, an overseas resident cannot initiate a patent-related procedure or file a lawsuit against the decision made by an administrative office unless he/she resides in the Republic of Korea.

However, despite the provision of Article 5(1) of the Patent Act, if an overseas resident files an international patent application, he/she can initiate a patent-/utility model-related procedure, such as submission of the translation of the application, etc., even without a legal representative by the relevant date (the period for submitting domestic documents in the Republic of Korea, if an applicant makes a request for examination within the domestic document submission period, the date of request for examination). In such a case, the overseas resident shall designate a legal representative within two months from the expiration date of the submission period and notify the Commissioner of the Korean Intellectual Property Office of the appointment of a legal representative. When no notification of the appointment of a legal representative is made to the Commissioner of the Korean Intellectual Property Office, the international patent application shall be deemed to have been withdrawn.

A patent administrator of an overseas resident shall be distinguished from a legal representative of a resident in the Republic of Korea because of the different level in power of attorney.

(Note) Where an overseas resident initiates a patent-related procedure without the

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designation of a patent administrator, an examiner shall give the foreigner an opportunity to explain within the designated period according to Article 5 of the Patent Act as well as Article 11 of the Enforcement Decree of the Patent Act. If he/she fails to give the explanation, the examiner shall return the relevant documents to the foreigner. In such a case, addressing the irregularities through amendments, such as designating a patent administrator, is not acceptable.

Also, where an overseas resident's patent administrator no longer exists because of death, removal or other reasons, an examiner shall immediately contact the party involved (overseas resident) to urge him/her to initiate the procedure for designating a patent administrator. In such a case, until a new patent administrator is appointed, the relevant documents can be delivered to the party involved by registered airmail. However, a warning note (including the translation of the warning note) can be attached with the following notices: ① the documents shall be seen as having been delivered on the date when the documents were sent; ② a new patent administrator shall be designated and notified under Article 5(1) of the Patent Act because of the death of the previous patent administrator; and ③ subsequent procedures shall be initiated by a patent administrator.

(2) Where an application is jointly filed by a resident and an overseas resident, a resident can solely initiate a patent-related procedure, except for the procedures defined in Article 11(1) of the Patent Act, whereas an overseas resident cannot initiate a patent-related procedure alone, without designating a patent administrator.

As for a patent-related procedure under the provisions of Article 11(1) of the Patent Act, a resident shall jointly initiate the procedures with a patent administrator designated by an overseas resident.

Meanwhile, where an overseas resident chooses a resident who is a co-applicant, as a patent administrator, the overseas resident can initiate a patent-related procedure alone within the scope of powers conferred on the resident. Also, a resident and an overseas resident can appoint the same person as a legal representative or a patent administrator.

(3) A patent administrator of an overseas resident can represent the party involved in all the

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patent-related procedures or a lawsuit on a decision made by an administrative office based on all the Patent Act or any order under the Patent Act.

A patent administrator holds comprehensive powers within the scope of powers conferred on him/her, unlike a legal representative through ordinary designation. A patent administrator can conduct disadvantageous actions, such as withdrawal of an application or withdrawal of request for a trial, without any special power of representation. For example, if 'all of the procedures related to a patent', 'all procedures related to patent registration' and 'all procedures regarding a trial' are written in the [Power of Attorney] box of Annexed Form No. 1 of the Enforcement Decree of the Patent Act, a legal representative through ordinary designation is not deemed to have the special power of attorney under Article 6 of the Patent Act, whereas a patent administrator is deemed to have the special power of attorney. It is because even though a patent administrator of an overseas resident is also a kind of designated representatives with power of attorney created by an act of designation, the act of designation itself is required by the law and a patent administrator features a distinct characteristic in carrying out patent-related procedures. Therefore, a wider range of power of attorney is conferred on a patent administrator of an overseas resident than a designated representative through ordinary designation.

(Note) When making a notification on the designation of a patent administrator, if matters for delegation and a power to initiate particular patent-related procedures are limited, even a patent administrator cannot conduct an act of representation for such procedures.

6. Designation or Replacement of Representative

6.1 Designation of Representative

(1) A designated representative shall submit a power of attorney and a report of designation of a representative to prove the designation. A report of removal or change of a representative, too, shall be submitted in order to remove or change the designated representative. The procedures for designation, removal or change of a representative are specified in Article 5 of the Enforcement Rules of the Patent Act.

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(2) When a legal representative is designated or changed while undertaking a procedure for filing an application, etc., a report of the designation of a representative or a report of change of representative shall be submitted with a power of attorney attached. Where a procedure is initiated by a representative with only a power of attorney attached (including the case where the intention of granting all the patent-related powers of attorney is stated) to a written argument or other intermediate documents, a legal representative shall be treated to hold power of attorney only for the intermediate procedure (when another intermediate procedure is being taken at the same time, the concerned procedure shall be also included). In such a case, when the legal representative continues to take patent-related procedures after the intermediate procedure, another notification of the designation of a representative shall be separately filed. Also, where no change has been made to the content of the previously-submitted power of attorney, a copy of a power of attorney can be submitted with the indication of its source.

Also, where the designated agent intends to continue to initiate a patent-related procedure for an application in which the name of the applicant has been changed, a notification of designation of a representative shall be submitted with a power of attorney of the successor in title attached.

Where any deficiency is found in the evidential documents for the power of attorney, an examiner shall order an amendment within a designated period. If deficiency is not addressed, an examiner shall invalidate the procedure for the designation of a representative as well as the procedure taken by the legal representative with irregularities in the power of attorney.

(3) A power of attorney shall include the indication of the case for representation, the names and addresses of the assignor and assignee, matters for delegation and the date of drawing up the power of attorney. And then the assignor shall sign or write his/her name and affix his/her seal on the documents.

Where the content of the submitted documents such as an application is different from the content described in a power of attorney, or where any deficiency is found in a report of delegation of a representative, a report of subattorney attorney or a report of removal of a

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representative, an examiner shall request an amendment to the concerned procedure. If irregularities are not addressed, an examiner shall invalidate the procedure.

(Note) Where『all matters regarding ...』and『all the other matters regarding ...』are stated in the 'Matters for Delegation' box, it shall be deemed that special powers of attorney under Article 6 of the Patent Act are not included. Also, where『change of name of applicant regarding ...』and『all matters related to the change of name of applicant regarding ...』are stated in the 'Matters for Delegation' box in a power of attorney attached to a report of change of name of applicant, but where the procedure after the notification of the change of name of applicant is not indicated, it shall be deemed only as a notification of change of name of applicant.

(4) The authority of representative of a representative of a person who initiates a patent-related procedure (including a patent administrator) shall be proved in writing. Where evidential documents for the authority of representative are not attached, where a power of attorney states an incorrect name of the party involved or where the seal on the document is different from the registered seal shall be deemed to be representation by agent without authority. In such cases, an examiner shall request an amendment as well as the submission of a correct power of attorney. Where amendment is made and a correct power of attorney is submitted, the power of attorney shall be deemed to be ratified by the party involved. If the power of attorney is not ratified, an examiner shall invalidate a patent-related procedure initiated by the party involved.

6.2 General Power of Attorney System

(1) The general power of attorney system is designed to grant power of attorney to cover all the proceedings to a representative who is designated to initiate a patent-related procedure.

(2) Where general power of attorney is to be granted, evidential documents of the authority of representative (hereinafter, referred to as 'a general power of attorney') shall be attached to an application for the registration of general power of attorney and be submitted to the Commissioner of the Korean Intellectual Property Office.

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Where an application for the registration of general power of attorney is filed, the Commissioner of the Korean Intellectual Property Office shall grant the registration number of general power of attorney and notify the registration number to the applicant who has registered the general power of attorney. A person who intends to initiate a patent-related procedure after obtaining general power of attorney shall state the registration number of general power of attorney in the documents submitted to the Commissioner of the Korean Intellectual Property Office or the President of the Intellectual Property Tribunal.

(3) Where a person who has registered general power of attorney intends to restrict the reliance of general power of attorney for particular proceedings or to withdraw general power of attorney, the person shall submit a report of restriction of reliance on general power of attorney or a report of withdrawal of registration of general power of attorney, respectively, to the Commissioner of the Korean Intellectual Property Office.

Meanwhile, where a report of removal of a representative is submitted for an application filed by a representative who has registered general power of attorney, it shall be deemed that a report of restriction of reliance of general power of attorney is submitted.

(Note) Where a representative holding general power of attorney intends to resign from particular proceedings or resign from the position of the agent with general power of attorney, he/she shall submit a written withdrawal of registration of general power of attorney defined in the provision of Article 5(4) of the Enforcement Rules of the Patent Act (Annexed Form No.3 of the Enforcement Rules of the Patent Act).

6.3 Replacement of Representatives, etc.

(1) Where the party involved or a legal representative is recognized not to perform administrative procedures because of the lack of capacity to perform actions, it shall be recommended to designate a representative to protect the benefits of the party involved or to order another representative to initiate a patent-related procedure under the system for replacement of representative.

(2) Where a person initiating a patent-related procedure or his/her representative is

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recognized not to be capable of initiating such procedure or making oral statements, the Commissioner of the Korean Intellectual Property Office or the President of the Intellectual Property Tribunal can designate a new representative or order *ex officio* another representative to initiate the procedure. Also, a patent attorney can be designated to initiate the procedure.

Even if a patent attorney is designated to initiate a patent-related procedure, but when he/she is recognized to lack capacity to perform actions, regardless of the formality requirements under Article 10 of the Patent Act, the Commissioner of the Korean Intellectual Property Office or the President of the Intellectual Property Tribunal can order ex officio the appointment of another representative for administrative convenience and protection of the party involved. Where a patent attorney cannot initiate a patent-related procedure because of health conditions or where a patent attorney is incapable of making oral statements, he/she is deemed to be incapable of initiating a patent-related procedure.

(3) The Commissioner of the Korean Intellectual Property Office or the President of the Intellectual Property Tribunal can invalidate the procedure initiated by the party involved or representative before the Korean Intellectual Property Office or the Intellectual Property Tribunal in the period after the order for designation or replacement of representative or before the designation or replacement of representative is carried out.

6.4 Sub-agency

(1) Sub-agency refers to an act of representation carried out by another person designated by a legal representative in order for the representative to conduct the acts within the scope of representation by making the person represent the representative. In such a context, the person appointed by the representative is a subagent. The right to appoint a subagent is granted based on approval of the party involved or legal provisions, other than the right of representation itself.

(2) Since a legal representative is appointed as a representative against his/her intention, the authorities granted to a legal representative are generally broad. Also, a legal representative is incapable of accepting or resigning of the position. Therefore, it is interpreted that a legal

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representative always holds the right to appoint a subagent and is allowed to designate a subagent.

If a designated representative (except for a patent administrator) fails to obtain special power of attorney, he/she is not allowed to appoint a subagent. Considering that only a legal representative of a resident in the Republic of Korea holds the special power of attorney for the appointment of subagent, it is interpreted that a patent administrator holds the right to appoint a subagent.

(3) In principle, a legal representative is responsible for all of the acts of his/her subagent regardless of whether a legal representative makes a mistake in the appointment or supervision of a subagent. However, where an unavoidable reason exists, a legal representative is only accountable for the appointment and supervision of a subagent.

A designated representative is responsible for the payment of damages incurred to the party involved only when he/she is negligent in the appointment and supervision of a subagent. Where a designated representative has appointed a subagent who is designated by the party involved, he/she shall incur responsibility only when he knew such subagent to be unfit or untrustworthy and neglected to notify the party involved thereof or to remove him.

(4) The scope of authority exercised by a subagent cannot exceed the scope of authority of a legal representative. Where a representative is granted with the power of appointment of a subagent and the special power of attorney from the party involved, he/she can grant even the special power of attorney to the subagent.

Meanwhile, in principle, the power of appointment of a subagent designated by a representative is not accepted. However, where the party involved has granted a representative the power of attorney and power of appointment and, at the same time, has indicated that a subagent can appoint another subagent, it is allowed that a subagent can designate another subagent.

A subagent shall represent the party involved in respect of acts within the scope of his/her

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authority and hold the same rights and duties as the agent towards the party involved and third parties. The party involved can remove a subagent since a subagent, too, holds the main rights and duties of the prudent administrator in accordance with the original purpose of the representation system.

(5) Where a legal representative holds the authority to appoint a subagent by the power granted from the party involved, a subagent designated by the authority shall be deemed to be a representative of the party involved. In such a case, the evidential documents for the authority of representation, 'the document which proves that the party involved has granted the authority to appoint a subagent to the agent' and 'the document which proves that the agent has appointed a subagent by the power of appointment of subagent', shall be submitted. It is common that a power of attorney is submitted as the evidential document since whether the power to appoint a subagent is granted or not can be confirmed in the [Matters for Delegation] in a power of attorney.

(6) Like the power of representation, the authority of a subagent to initiate a patent-related procedure shall not be extinguished upon the decease or loss of legal capacity of the party involved, the extinction of a juristic person of the party involved due to a merger, the termination of the duty of trust of the party involved, the decease or loss of legal capacity of the legal representative, or the modification or extinction of his/her authority of representative despite the causes for lapse of power of representation under Article 127 of the Korean Civil Act (death of the party involved; and death, adjudication of incompetency, or bankruptcy of the agent). Also, the power of representation of a subagent shall not be extinguished even for the causes for lapse of power of representation under Article 127 of the Korean Civil Act (death, adjudication of incompetency, or bankruptcy of the agent) or the resignation or removal of a subagent.

The authority of a subagent shall be extinguished for the causes for lapse of power of representation under Article 127 of the Korean Civil Act or the appointment or removal of a legal representative or a subagent.

(Note) Unlike the Korean Civil Act where the power of representation of a subagent is extinguished in case of death of a legal representative because of absence of supervision by

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the representative, the Korean Civil Procedure Act stipulates that the power of appointment of a subagent shall not be extinguished even in case of death of a legal representative of the procedure based on the original purpose of the swift and smooth execution of the procedures. Except for the special provisions regarding a representative stipulated in the Patent Act, the provisions of the Civil Procedure Act shall apply *mutatis mutandis.* Therefore, the power of representation of a subagent in a patent-related procedure shall not be extinguished in case of death of a legal representative.

7. Other Provisions for Representation

(1) The Korean Civil Procedure Act states that where there exist many attorneys, each of them shall represent the party involved and where the parties involved have concluded an agreement in contrary to the above-mentioned provision, such agreement shall not take any effect. The Korean Patent Act, too, provides that where two or more representatives of a person initiating a patent-related procedure have been designated, each of them shall independently represent the party involved before the Korean Intellectual Property Office or the Intellectual Property Tribunal.

Therefore, the principle of individual representation shall apply to the acts conducted between designated representatives; the party involved and designated representative; the designated representative and subagent; the party involved and subagent as well as the procedures initiated by the same representative several times.

(Example) Where more than two representatives have submitted a written amendment individually in response to a notification of the grounds for rejection made by an examiner, all the amendments shall be deemed to be legitimately submitted. In such a case, the examiner shall conduct an examination after confirming the specification to be examined with reference to Part 5, Chapter 3『6.3.1 Confirmation Method for Amended Specification』.

(2) Article 7(2) of the Patent Act stipulates that a patent-related procedure, initiated by a person who lacks capacity, the power of legal representation or the authorization necessary to initiate any such procedures, shall have effect retroactively to the time when such procedures are performed if the procedures are ratified by the party involved when he/she

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has gained capacity to proceed. Therefore, procedures initiated by an incompetent or an un-entitled agent shall take effect retroactively based on the ratification by a legitimate party involved or legal representative. 'The party involved after amendment' in this context refers to someone who was a minor when the procedure was initially performed, but now has reached 21 years old and become a person with legal capacity.

(3) Where more than two parties involved jointly initiate a patent-related procedure, each of them shall represent the joint initiators except for certain actions that could incur disadvantages to other parties involved. Matters for which more than two parties involved should jointly initiate the procedure are similar to those which an authorized representative can represent after obtaining a special power of attorney in accordance with Article 6 of the Patent Act.

Where more than two parties involved have appointed a common representative and have notified such fact to the Korean Intellectual Property Office, only the common representative can initiate a patent-related procedure. Also, more than two common representatives can be appointed. Where a common representative is to be appointed, the designated representative shall submit to the commissioner of the Korean Intellectual Property Office or the president of the Intellectual Property Tribunal the evidential documents of the status of a representative and the power of representation (only when a procedure is initiated by a representative) attached to the Report on Agent[Representative] in Annexed Form No.2 of the Enforcement Rules of the Patent Act.

(Note) Even a common representative cannot initiate a patent-related procedure under the provisions of Article 11(1) of the Patent Act without the special powers of attorney of multiple parties involved. Therefore, where a common representative initiates a patent-related procedure without the special power of attorney, the commissioner of the Korean Intellectual Property Office shall request amendment. When irregularities are not addressed, the commissioner of the Korean Intellectual Property Office shall invalidate the procedure. Whether a common representative is granted with the power to initiate a patent-related procedure shall be confirmed in a power of attorney, etc.

(4) When only some of the parties involved appoint a representative, the designated

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representative can initiate a patent-related procedure on behalf of all the parties involved. However, he/she shall initiate the procedures mentioned in the provisions of Article 11(1) of the Patent Act, jointly with the other parties involved.

(Note) Where a common representative does not represent all of the applicants, his/her name shall be specified as Applicant ○○○'s representative in [Reference] below [Address] in the [Representative] column of a written application.

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Chapter 3. Period

1. Relevant Provisions

Article 14 of the Patent Act (Calculation of Time Limits) A time limit in this Act or in any decrees under this Act is calculated as follows:

(i) the first day of a period is not counted unless the period starts at midnight;

(ii) when a period is expressed in months or years, it is counted according to the calendar;

(iii) when the start of a period does not coincide with the beginning of a calendar month or year, the period expires in the final month or year of the day preceding the date that corresponds to the starting date of the period; however, if no corresponding date occurs in the final month, the period expires on the last day of that month; and

(iv) when the last day of a period for executing a patent-related procedure falls on an official holiday(including Saturday and Labor Day, as designated by the Labor Day Designation Act), the period expires on the first working day after the holiday.

Article 15 of the Patent Act (Extension of Time Limits etc.) ①The Commissioner of the Korean Intellectual Property Office or the President of the Intellectual Property Tribunal may, upon request or *ex officio*, extend the period for demanding a trial under Article 132*ter* for once and for up to 30 days. However, the number and period of extension may be further extended for a person residing in an area that is difficult to access.

②The Commissioner of the Korean Intellectual Property Office, the President of the Intellectual Property Tribunal, a administrative patent judge or an examiner who has designated a period for a patent-related procedure to be initiated under this Act may shorten or extend the period upon request or extend the period *ex officio*. In such cases, the Commissioner of the Korean Intellectual Property Office and so on shall decide whether to shorten or extend the period in a way that does not unduly violate the interests of the

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parties involved in the relevant procedure.

③An administrative patent judge or an examiner who has designated a date for initiating a patent related procedure under this Act may change the date upon request or *ex officio*.

2. Type of Period

Periods are divided into statutory periods and designated periods. Statutory periods refer to periods defined in the Patent Act or any order under the Patent Act. Designated Periods mean periods which the Commissioner of the Korean Intellectual Property Office, the President of the Intellectual Property Tribunal, a presiding trial judge or an examiner sets based on the Patent Act or any order under the Patent Act towards a person initiating a patent-related procedure for filing an application, making a request, and so on.

Statutory periods and designated periods regarding the examination of a patent application are as follows.

Statutory Period	Designated Period
ㅇ Period for requesting withdrawal of invalidation of procedure (Article 16) ㅇ Period for retroactively recognizing the filing date of a lawful right holder (Articles 34, 35) ㅇ Period in case of inventions not deemed to be publicly known (Article 30) ㅇ Period for amendment of description or drawings (Article 47) ㅇ Period for filing a divisional application (Article 52) ㅇ Period for filing a converted application (Article 53) ㅇ Period for priority claim under Treaty	ㅇ Period designated by KIPO commissioner ㅇ Period for amendment of procedure (Article 46) ㅇ In case of request for consultation on the identical invention, etc. (Articles 36, 38) ㅇ In case of request made to the party involved for submission of documents and articles (Article 222) □ Period designated by examiner ㅇ When an examiner notifies a ground for rejection and provides an applicant with an opportunity to present his/her

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(Articles 54,55,56) º Period for request for examination of patent application (Article 59) º Time for laying open an application (Article 64) º Application to register the extension of term of patent right (Article 90) º Trial against the decision to reject a patent application (Article 132(3)) º Time for service by public announcement coming into force (Article 219) º Period for request for re-examination (Article 67(2))	written opinions (Article 63) º When an examiner requests the party involved to submit documents and articles(including model, sample, test report) necessary for examination (Article 222)

3. Calculation of Periods

The periods shall be calculated according to Article 155 of the Korean Civil Act, except for special cases. However, Article 14 of the Patent Act separately defines the method of calculating periods based on the Patent Act and any order under the Patent Act. Therefore, the calculation of periods under the Patent Act is primarily governed by Article 14 of the Patent Act and Article 155 of the Civil Act supplementally applies.

(Note) The methods of calculating the periods are divided into two types: natural calculation and calculation according to calendar. Natural calculation is precise but inconvenient, whereas calculation according to calendar is somewhat imprecise but convenient.

(1) In calculating the period under the Patent Act, the first day of the period is not counted. However, if the period starts at midnight, the first day of the period shall be counted.

(2) When the period is expressed in months or years, it shall be counted according to the calendar regardless of the length of a month or a year.

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(3) When the start of the period does not coincide with the beginning of a month or year, the period shall expire on the day preceding the date in the last month or year of the period corresponding to the date on which the period started. However, where a month or year is used and there is no corresponding day in the last month, the period shall expire on the last day of that month. In this context, the day on which the calculation begins refers to the first date counted in calculating the period and the expiration date means the last day counted in calculating the period.

In a patent-related procedure, where the last day of the period falls on a public holiday, the period shall be expired on the day after the last day. It should be noted that the period expired on the day after the last day is a statutory period or designated period in a patent-related procedure. In other words, a statutory or designated period irrelevant of a patent-related procedure is not governed by Article 14(4) of the Patent Act. For example, as for an application claiming Domestic Priority, the time on which an earlier application is deemed to have been withdrawn and the date of expiration of the patent term shall not be extended by one more day even if the last day of such period falls on a public holiday.

(Example) Where the expiration date of the designated period according to the notification of grounds for rejection is January 27 and where January 27 is Lunar New Year's holiday and January 28 is Sunday, the amendment period shall be expired on January 29. Therefore, when a written amendment is submitted on January 29, the amendment is deemed to have been submitted within the legitimate period (Case No. 90 Hu 1680(Supreme Court, 28. February. 1991)).

(Note) Where the day on which the calculation begins falls on a public holiday, the period shall start from the public holiday.

(4) Where a person who intended to submit electronic documents through a computerized network has sent the electronic documents, but failed to deliver them within the period because of the network glitch, the period shall mature on the following day when the glitch has become removed. The network glitch refers to the failure of the computerized network as well as the malfunction of computers or relevant devices used in the Korean Intellectual Property Office. However, if the Korean Intellectual Property Office has notified of the

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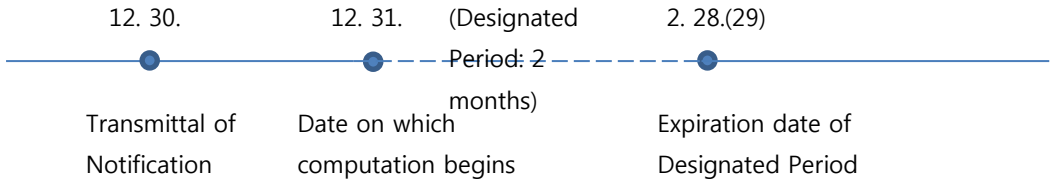
network glitches in advance, they are not deemed to be glitches. Article 9(4) of the Enforcement Rules of the Patent Act and 'the Announcement of Term Extension for Failure of Computerized Network' shall be referred to for the detailed information.

(5) When a period is expired in accordance with Article 15 of the Patent Act and even when the last day of a period falls on a public holiday, the initial period shall mature on the concerned public holiday and the extension of the period shall be counted from the day after the expiration day of the period. Moreover, when more than two requests for extension of a period(one request of extension means the request of term extension by one month, hereinafter the same) have been made, the period by each request shall be calculated in the above-mentioned manner.

The detailed example about the extension of a period below shall be referred.

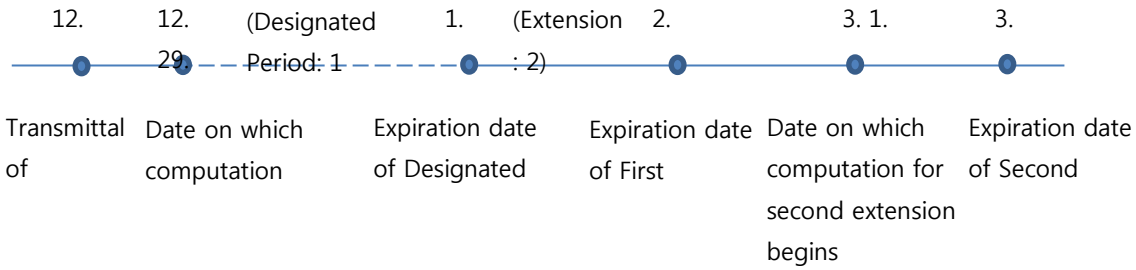
Where there is no concerned date in the last month of the period



In calculating a period under the Patent Act, the first day of the period is not counted. However, when the period starts at midnight, the day on which the calculation begins does not start on the following day, but starts on the first day of the period. In the above-mentioned case, a written notification is hardly delivered at midnight, therefore, the day on which the calculation begins falls on December 31.

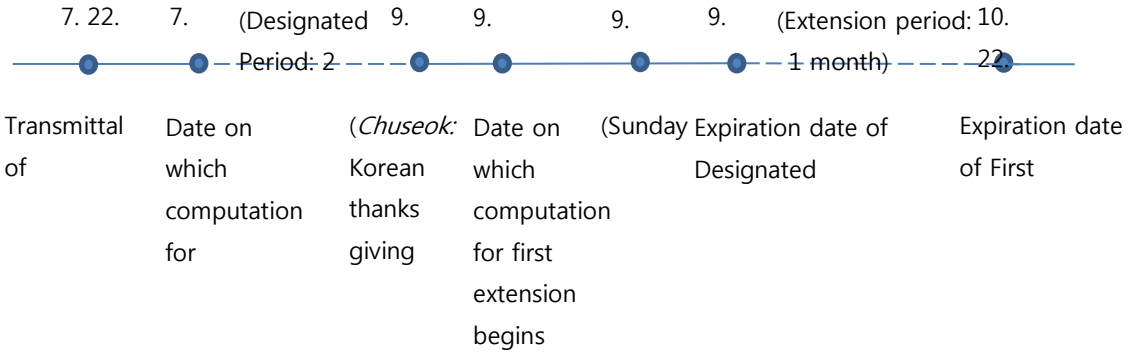
Moreover, where there is no day concerned in the last month of the period, the last day of the month shall be expiration date. As in the above case, since February 30 does not exist, the last day of that month, February 28, shall be the expiration date of the designated period.

Where the extension date of a period is counted from the first day of a month or a year



When a period is not counted from the beginning of a month or a year, the period shall mature on the day before the day on which the calculation begins in the last month or year (the expiration date of the designated period). Also, the day on which the calculation begins for the extension of the period is counted from the first day of a month or year, the period shall mature on the last day of the last month or year of the period (the expiration date when term extension is conducted twice).

When the expiration date of the designated period falls on a public holiday and the period is extended



When the last day of a period in a patent-related period falls on a public holiday, the period shall mature on the following day. Therefore, if the extension of the period had not been conducted in the above case, the period is expired on September 25.

Even when the day on which the calculation begins falls on a public holiday, the day on which the calculation begins of a period starts from a public holiday. Therefore, the extended period shall mature on October 22.

As in the above case, of the designated period matures on September 25, the request for extension of the period can be made only by September 25. Even when the request is made on September 25, the day on which the calculation begins for extension of the

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period shall fall on September 23 and the extended period shall mature on October 22.

4. Extension of Periods

The system of the extension of a period is designed to enable a person who intends to initiate a patent-related procedure within a statutory or designated period to undertake the procedure smoothly by allowing the extension of the period, because the person resides in an area with poor transportation or it takes a great deal of time for preparation to initiate the procedure.

Meanwhile, it is hard to fulfill an applicant's demand that the decision to grant a patent be made before the expiration of the designated period only by granting the extension of the period. Therefore, the period reduction system was designed to allow for the reduction of the designated period by request.

A statutory period can be extended if it is the period for request of trial under Article 132(3) of the Patent Act, whereas a designated period can be extended regardless of its kind. Also, a statutory period cannot be shortened, while a designated period can be reduced upon request by a party involved.

4.1 Extension and Acceptance of Statutory Period

Anyone can extend a statutory period of request for appeal trial for a decision to reject a patent application or a utility model registration application one time for less than thirty days. Meanwhile, a person residing in an area with poor transportation can further extend the statutory period. If an application for extension of a statutory period has been submitted, the President of the Intellectual Property Tribunal (the Trial Policy Division) shall determine whether the requirements for extension are fulfilled and whether to accept the written application.

4.2 Extension and Acceptance of Substantive Examination-related Designated Period

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(1) A request for extension of a designated period under Article 16 of the Enforcement Rules of the Patent Act can be filed for one month each time or for more than two months all at once. When a request for extension of the period for less than one month is filed, the desired extension period shall be deemed to be one month.

A request for extension of a period shall be deemed to be accepted when the application for extension of the period is submitted, except for the period for submission of a written argument in response of a notification of grounds for rejection (hereinafter, referred to as 'submission period for written argument'). However, if an examiner concluded that the interests of an interested person are unlawfully infringed, the examiner shall approve the extension of the period only for the necessary amount of time and can disapprove the extension of the rest of the period after a warning of disapproval of period extension.

(2) A request for extension of the submission period for a written argument shall be deemed to be accepted when the written application for extension of the submission period for a written opinion is submitted, if the expiration date of the desired extension period is within four months from the expiration date of the period designated in the initial notification of submission of written opinion (hereinafter referred to as 'period allowed for extension request'). However, where the period allowed for extension request has elapsed, an examiner shall consider reasons for period extension and approve the extension if necessary.

When the expiration date of the desired extension period in a request for extension of the period for the submission of a written argument has elapsed the period allowed for extension request, an examiner shall approve the extension of the period only within the period allowed for extension request. An examiner shall determine whether to approve the extension of the period after examining whether the reasons presented by an applicant for extension of the period fall under the reasons mentioned below. Where an applicant intends to submit the intention of extension of the period and make a further request for period extension after the examiner has decided to approve the extension of the period, the examiner shall order the applicant to explain the reason for an additional request for extension of the period.

① Where an applicant has appointed a representative for the first time or removed or

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changed the appointed representatives within one month before the expiration of the period.

② Where an applicant has submitted a notification of change of applicant within one month before the expiration of the period. However, it is only limited to the addition of a new applicant.

③ Where an applicant has received examination results from a foreign patent office and submitted the results along with a request for extension of the period within two months before the expiration of the period.

④ Where the delivery of a written argument has delayed over a month.

⑤ Where an earlier application or subsequent application is pending in a trial or lawsuit.

⑥ Where more time is needed for conducting examinations relating to grounds for rejection as well as analyzing the results of such examinations.

⑦ Where extension of the period is recognized to be necessary inevitably.

※ If request for extension of the period is related to an application filed by a third party, the request shall be disapproved even the request corresponds to the reasons of no. ① ~⑤.

(3) Where fees for a request of extension of the period have not been paid, an examiner shall and order an amendment within a designated period. When unpaid fees have been paid within the designated period, it shall be deemed to be a legitimate request for extension of the period. However, if the late fees are not paid within the designated period, the request for extension of the period shall be invalidated. Such guidelines shall apply to all of statutory periods and designated periods regarding substantive examinations as well as formalities examinations.

(4) Where a request for extension of the designated period is submitted after the expiration

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of the designated period regarding substantive examinations (the concerned extended period when the period is extended because of a request for extension of the designated period), an examiner shall give the applicant an opportunity to explain and return the written application. The fees paid along with the submission of the request for extension of the designated period shall be returned.

(Note) Where a request for extension of the period is not approved, the paid fees shall be returned.

4.3 Extension and Approval of Designated Period regarding Formalities Examination

(1) The extension of the amendment period under Article 46 of the Patent Act can be requested for one or more than two months each time. When a period requested for extension is for less than one month, the period requested for extension shall be deemed to be one month.

(2) The period allowed for extension is four months in total. However, where a situation in which an applicant cannot bear responsibilities for or where additional requests for extension of the designated period are deemed necessary for an international patent application entering the national phase, additional extensions of the designated period shall be allowed.

(3) When the period requested for extension has not exceeded four months in total and fees have been paid, the request for extension shall be deemed to be approved when the request for extension of the period was submitted. Where the requested period is for four months, an examiner shall state a notice that 'any further extension of the period shall not be allowed' in the written approval for extension of the period and notify it to the applicant.

When another request for extension of the designated period is submitted, the examiner shall disapprove the request for extension of the period.

(4) Where a request for extension of the designated period is submitted after the expiration of the designated period regarding formalities examinations (the extended period where the

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period is extended because of the request for extension of the designated period), an examiner shall give the applicant an opportunity to explain and return the written application. The fees paid along with the submission of the request for extension of the designated period shall be returned.

(Note) Where a request for extension of the period is not approved, the paid fees shall be returned.

4.4. Reduction of Designated Period

When the period for initiating a patent-related procedure has been set, the period can be shortened upon request. Where a request for reduction of the period is submitted, or where the intention of reduction of the period is written in an amendment and is submitted, an examiner shall deem the concerned designated period to have expired on the day when the request or the amendment has been submitted and carry out the examination.

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Chapter. 4 Invalidation of Procedure and Return of Document

1. Relevant Provisions

Article 46 of the Patent Act (Amendment of Procedure) The Commissioner of the Korean Intellectual Property Office or the President of the Intellectual Property Tribunal shall order an amendment to a patent-related procedure within a designated period if the procedure falls under any of the following subparagraphs:

(i) where the procedure does not comply with Articles 3(1) or 6;

(ii) where the procedure does not comply with the formalities prescribed in this Act or by Presidential Decree; or

(iii) where fees required under Article 82 have not been paid.

Article 16 of the Patent Act (Invalidation of Procedure) ① Where a person who has been instructed to make an amendment under Article 46 fails to do so within the designated period, the Commissioner of the Korean Intellectual Property Office or the President of the Intellectual Property Tribunal may invalidate the patent-related procedure. However, where a person who has been instructed to make an amendment for not paying the fees for requesting an examination under Article 82(2) fails to pay the fees for requesting an examination, the Commissioner of the Korean Intellectual Property Office or the President of the Intellectual Property Tribunal may invalidate the amendment to the description attached to the patent application.

② Where a patent-related procedure is invalidated under paragraph (1), if the delay is considered to have been caused by unavoidable reasons, the Commissioner of the Korean Intellectual Property Office or the President of the Intellectual Property Tribunal may revoke the disposition of invalidation at the request of the person instructed to make the amendment, provided the request is made within two months of the date on which the

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reasons for the delay cease to exist and not more than a year after the designated period expired.

③ Where the disposition of invalidation is revoked under the proviso of paragraph (1) or paragraph (2), the Commissioner of the Korean Intellectual Property Office or the President of the Intellectual Property Tribunal shall issue a copy of the disposition notification to the person who was instructed to make an amendment.

Article 17 of the Patent Act (Subsequent Completion of Procedure) Where a person who has initiated a patent-related procedure fails to observe either the period for requesting a trial under Article 132*ter* or the period for demanding a retrial under Article 180(1) 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 67-3 of the Patent Act (Restoration of Patent Application) ① Where a patent applicant fails to comply with one of the following periods due to reasons unattributable to him or her and this leads to the revocation of a patent application or confirmation of a decision to reject a patent right, the applicant may file a request on examination or reexamination of the application within two months from the date on which such grounds cease to exist. However, if one year has passed from the expiration date of the concerned period, the applicant shall not file a request on examination or reexamination of the application:

1. the period allowed for a request of examination on an application in accordance with Article 59(2) or (3) of the Patent Act
2. the period allowed for a request of reexamination on an application in accordance with Article 67(2)(i) of the Patent Act

② Notwithstanding Article 59(5) of the Patent Act, where there is a request for examination or reexamination on an application under paragraph 1, the patent application shall be deemed not to have been withdrawn or the decision of rejection of the patent right shall be deemed not to be confirmed.

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Article 11 of the Enforcement Rules of the Patent Act (Return of Illegitimate Application Document) ① Where a patent application or an application to register an extension of the term of a patent right, a trial-related document or article such as sample, etc.(hereinafter in this Article referred to as 'application documents, etc.') under Articles 42, 90, 140 or 140(2) of the Patent Act falls under any of the following subparagraphs, the Commissioner of the Korean Intellectual Property Office of the President of the Intellectual Property Tribunal shall not deem such application documents to be legitimate, except for special provisions in the Enforcement Rules of the Patent Act.

1. Where Article 2 of the Enforcement Rules of the Patent Act is violated and one document for each application is not written.

2. Where the type of an application or a document is not clear.

3. Where the name (the title in case of a juristic person) or the applicant code of a person who initiates a patent-related procedure[In absence of application code, the name and address of the applicant(in case of a juristic person, its title and business address] is not described.

4. Where an application is not written in Korean

5. Where a description is not attached to a written application (including the case where the detailed explanation of the invention is not disclosed in a description).

5-2. Where a description which does not specify claims is attached to a patent application and the amendment period of the description under Article 42(5)(1) of the Patent Act has already elapsed when the patent application was filed as a divisional application, converted application as well as application by the lawful holder of a right.

6. Where an application document was submitted by a person who has neither an address nor a place of business in the Republic of Korea, other than a patent administrator under Article 5(1) of the Patent Act.

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7. Where the documents were not submitted within the designated period under the Patent Act or any order under the Patent Act.

8. Where a request for extension of the period was submitted for the period not allowed for extension among the designated periods under the Patent Act or any order under the Patent Act.

9. Where a request for extension of the period was submitted after the expiration of the period for requesting a trial under Article 132(3) of the Patent Act or the period designated by the Commissioner of the Korean Intellectual Property Office, the President of the Intellectual Property Tribunal, an administrative patent judge or an examiner.

10. Where documents regarding a patent-related procedure have been submitted after the termination of such patent-related procedure.

11. Where a person not entitled to initiate a patent-related procedure has submitted application documents regarding the procedure.

12. Where the concerned documents are not clear and cannot be accepted when an application code should be granted based on a report in Annexed Form No.2 (only for restriction of reliance on general power of attorney), an application for registration of general power of attorney in Annexed Form No.3, an application for change/withdrawal of registration of general power of attorney, an application for grant of the applicant code in Annexed Form No.4 or *ex officio.*

13. Where a patent application or any document submitted over a computerized network or via electronic recording device is not written by using the software offered by the Korean Intellectual Property Office or the KIPO website, or where documents in an electronic form have been submitted in a condition where they cannot be handled in the electronic data processing system.

13-2. Where documents required to be submitted under Article 3(2)(2) of the Enforcement Rules of the Patent Ace have not been submitted within the designated period.

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14. Where documents required to be submitted under Article 8 of the Enforcement Rules of the Patent Act have not been submitted within the period allowed for explanation without any legitimate explanation.

15. Where a patent applicant has submitted a request for examination on a patent application attached with a description which does not specify claims.

16. Where a request for early publication has been submitted for a patent application attached with a description which does not specify claims or a patent registered for publication under Article 87(3) of the Patent Act.

17. Where a decision to grant a patent cannot be delayed since the application falls under any of sub-subparagraphs of Article 40 (2)(1) of the Enforcement Rules of the Patent Act.

18. Where an examination on a patent application cannot be delayed since the application falls under any of the sub-subparagraphs of Article 40(3)(3) of the Enforcement Rules of the Patent Act.

19. Where a request for re-examination without amendment of a description or drawing(s) attached to a patent application has been made or where a request for re-examination cannot be made since the application falls under the provision of Article 67(2)(1) of the Enforcement Rules of the Patent Act.

② Where application documents deemed to be illegitimate under the provision of Article 11(1) of the Enforcement Rules of the Patent Act are to be returned, the Commissioner of the Korean Intellectual Property Office or the President of the Intellectual Property Tribunal shall deliver a notice containing the intention to return the application documents, grounds for return and period for explanation to the applicants who have submitted the application documents. However, where application documents fall under Article 11(1)(14) of the Enforcement Rules of the Patent Act, the commissioner or the president shall notify the applicants of the grounds for return the documents and return the documents immediately.

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③ Where an applicant who has received the returned application documents under Article 11(2) of the Enforcement Rules of the Patent Act intends to give explanation, he/she shall submit to the Commissioner of the Korean Intellectual Property Office or the President of the Intellectual Property Tribunal an explanation in Annexed Form No.24 of the Enforcement Rules of the Patent Act within the period for explanation. When an applicant wishes to receive the returned application documents without giving any explanation within the period allowed for explanation, the applicant shall submit a request for return of documents in Annexed Form No.8 of the Enforcement Rules of the Patent Act to the Commissioner of the Korean Intellectual Property Office or the President of the Intellectual Property Tribunal. In such a case, the commissioner or the president shall immediately return the application documents when a request for return has been made.

④ When an applicant has failed to submit an explanation or a request for return within the period for explanation or where the submitted explanations are deemed to be groundless, the Commissioner of the Korean Intellectual Property Office or the President of the Intellectual Property Tribunal shall return the application documents right after the expiration of the period for explanation.

2. General Principles of Formalities Examination

(1) A formalities examination refers to a review procedure conducted by the Commissioner of the Korean Intellectual Property Office or the President of the Intellectual Property Tribunal regarding a patent-related procedure under Article 46 of the Patent Act and Article 11 of the Enforcement Rules of the Patent Act. If irregularities are found in the results of the formalities examination, the commissioner or the president shall order to amend and invalidate the concerned patent-related procedure or return the application documents after giving the applicant an opportunity to explain.

(2) In principle, formalities examinations are conducted by divisions in charge of formalities examination (Application Division, International Application Division, Registration Division or Trial Policy Division) under the name of the Commissioner of the Korean Intellectual Property Office or the President of the Intellectual Property Tribunal. However, where irregularities found in formalities examinations are closely linked to substantive examinations and the

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division which has received the document found it inappropriate to process such documents (such as non-prejudicial disclosure), the formalities examination shall be conducted by an examiner.

Where irregularities in formalities related to application, subsequent requests, claim procedures are omitted and transferred as general items to be processed in divisions in charge of formalities examination, an examiner shall describe the irregularities and transfer the documents to divisions in charge of formalities examination. The division in charge of formalities examination which has received the documents from the examiner shall complete the formalities examination by reviewing the irregularities and re-transfer the relevant documents to the examiner.

3. Invalidation of Procedure

(1) Where a patent-related procedure falls under any subparagraph of Article 46 of the Patent Act, an examiner shall request an amendment of such procedure in the name of the Commissioner of the Korean Intellectual Property Office.

Where bibliographic data of an application, amendment period, documents to be amended, written amendments are not submitted within the designated period, an examiner shall state the intention to invalidate the concerned procedure and items to be amended in detail in a request for amendment. Items to be amended shall contain the contents in violation of procedural requirements defined in the Patent Act or other relevant provisions. If necessary, amendment methods shall be stated in detail.

The amendment period for a patent-related procedure designated in a request for amendment shall be within one month.

(2) Where irregularities in a patent-related procedure have been addressed through the submission of an amendment within the designated period, the application shall be deemed to have been amended when the procedure was conducted. Where an amendment is not submitted within the designated period, or where irregularities are not addressed, an examiner can invalidate the concerned procedure.

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Where an amendment has been submitted, an examiner shall examine the application in consideration of the followings.

① Where a procedural amendment is submitted after the expiration of the designated period

After the expiration of the designated period, where irregularities are addressed through the submission of an amendment before the delivery date of a notice of invalidation (hereinafter, referred to as 'date of invalidation'), an examiner shall not invalidate the application, but accept the application. An amendment submitted after the date of invalidation shall be returned.

Where an amendment was submitted by mail before the date of invalidation, but an examiner invalidated the application without noticing the submission of the amendment, or where irregularities are addressed by reviewing amended items, an examiner shall revoke the disposition of invalidation and accept the amendment. An amendment submitted on the date of invalidation shall be treated in the same manner.

② A procedural irregularity is newly found

Where any new irregularities are found when the amendment is completed by the request for amendment, an examiner shall set the period for such irregularities and request amendment again. In this case, an applicant shall pay the amendment fees for each amendment. However, where the items which would have been amended for the first time have been omitted and an examiner orders an amendment to such items again, any additional fees for amendment to such items shall not be required. (Article 3 of the Instruction on the Payment of amendment fee among Patent fee, Registration fee and other fees and KIPO Notification No. 2009-19 shall be referred.)

③ Where an amendment including the amended items which are irrelevant of the amendment request is submitted

Where a voluntary amendment irrelevant of the intention of the amendment request has

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been submitted while a written amendment by the request for amendment has not been submitted, an examiner shall accept the amendment. If the amended items fall under the items for which the amendment fees are paid, the amendment fee shall be paid.

④ Where only parts of the items required for amendment are amended

Where an examiner requests amendment to more than two procedures in a single request for amendment, but an amendment containing only parts of the procedures are amended is submitted within the designated period, an examiner shall invalidate only the procedures of which irregularities are not addressed. Where more than two items required for amendment have been amended in two or more separate amendments, it shall be deemed to be separate amendments. Therefore, fees for separate amendments shall be paid.

⑤ Where only the amended items are submitted without an amendment

Where only the amended items are submitted without using the formalities of an amendment, an examiner shall accept the document first, and then request amendment to the amendment procedure, citing the procedure is in violation of the formalities of an amendment. If the type of the document is unclear, an examiner shall return the document. Where irregularities are minor, an examiner can accept the document without requesting an amendment.

Where an amendment in violation of the formalities of amendment has not been corrected based on the formalities within the designated period, an examiner shall invalidate the amendment procedure for the concerned amendment. Where irregularities indicated by the decision to invalidate the amendment procedure are not addressed, an examiner shall invalidate the concerned procedure.

(3) The person who can invalidate a patent-relate procedure is the Commissioner of the Korean Intellectual Property Office or the President of the Intellectual Property Tribunal, not an examiner. Subjects of invalidation are not limited to application procedures. All the patent-related procedures shall be subject to invalidation.

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When an examiner intends to invalidate a patent-related procedure, he/she shall state the grounds for invalidation and notify the reasons to the person who has initiated the procedure. A notice stating that an applicant can initiate an administrative trial or lawsuit shall be attached to a notification of invalidation of the procedure.

(4) Where an additional payment of examination fees is required to an applicant since the number of claims is increased because of the amendments to the description after a request for examination made by a person other than the applicant, but the applicant has not paid the examination fees, an examiner shall invalidate the amendment procedure for a description.

(5) When an application is invalidated, the application is deemed to have never filed in applying Articles 36(1) to (3) of the Patent Act. Also, an application claiming Domestic Priority cannot be filed based on inventions disclosed in the description or drawing(s) originally attached to the concerned application.

Also, when an application is invalidated, the right to request compensation shall be deemed never to have existed.

4. Revocation of Invalidation

(1) Where a patent-related procedure is invalidated, but if the failure to amend within the designated period is recognized to have been caused by reasons not imputable to a person ordered to amend, the Commissioner of the Korean Intellectual Property Office can revoke the disposition of invalidation if a request for revocation is made within two months of the day when such unavoidable grounds are extinguished. However, when one year has elapsed after the designated period expires, the commissioner or the president cannot revoke the disposition of invalidation. In such a case, 「causes not imputable to a person ordered to amend」 refer to the reasons that an ordinary person cannot avoid even if he/she is cautious, such as natural disasters and other unavoidable reasons, as well as the case where an invalidation document has been delivered to a party uninvolved. An applicant's unawareness of service by notification shall not be included to unavoidable grounds, unless there is a

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particular reason for an applicant to be unaware of the service by notification.

(Note) The so-called 'laches waiver' defined in Article 32(2) of the Patent Act* shall apply only where the Commissioner of the Korean Intellectual Property Office invalidates a patent-/request-related procedure, except for cases where a person who has initiated a patent-/request-related procedure has intentionally passed the designated period for the subsequent actions or has failed to pay the patent fees at the time of registration as defined in Article 32(1). However, the 'laches waiver' shall not apply where a patent right is deemed to have been extinguished since a registered parent right holder has failed to pay the patent fees in the additional payment period and the period for patent fee payment has elapsed, as defined in Article 77(3) of the Patent Act ((Case No. 82 Nu 264(Supreme Court, 14. December 1982)).

(Footnote) Article 32(2) of the Patent Act* was the provision of the previous Patent Act at the time when the ruling of the case was made. It now corresponds to Article 16(2) of the current Patent Act.

(2) If an applicant wishes to receive the revocation of the disposition of invalidation, he/she shall attach a copy of the evidential document for reasons of laches to a written request for relief of the expiration of the period in Annexed Form No.10 of the Enforcement Rules of the Patent Act and submit the request to the Commissioner of the Korean Intellectual Property Office. In the presence of a legal representative, a copy of the evidential document of the power of representation shall be attached to the written request, too.

(3) Whether to revoke the disposition of invalidation shall be determined by an examiner (or a division) that has invalidated the application in the first place under the name of the Commissioner of the Korean Intellectual Property Office or the President of the Intellectual Property Tribunal. Then, the examiner or the division shall notify such decision to the person who requested the revocation of invalidation. Also, the examiner or the division shall state in a notification of the revocation of the disposition of invalidation that amendment can be made within the period corresponding to the original amendment period from the time of the revocation of invalidation.

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Where a patent-related procedure or examination is initiated during the period after the disposition of invalidation before the revocation of the disposition of invalidation, an examiner shall review the procedure or examination and determine whether such procedure or examination takes effect by considering the effect made by the revocation of the disposition of invalidation and the confidence protection principle.

5. Return of Documents

(1) The Commissioner of the Korean Intellectual Property Office or the President of the Intellectual Property Tribunal shall deliver a notification stating the intention to return application documents, the ground for rejection of the documents and the period for explanation to the applicant, requester for trial or submitter (hereinafter referred to as 'an applicant, etc.') of application documents deemed to be illegitimate under Article 11 of the Enforcement Rules of the Patent Act.

(2) Where an applicant, etc. who has received a notification containing the intention to return application documents wishes to give explanations, he/she shall submit a written explanation in Annexed Form No.24 of the Enforcement Rules of the Patent Act to the Commissioner of the Korean Intellectual Property Office within the period for explanation. Where an applicant, etc. wishes to get his/her application documents returned without giving any explanation within the period for explanation, he/she shall submit a request for return of application documents in Annexed Form No.8 of the Enforcement Rules of the Patent Act to the Commissioner of the Korean Intellectual Property Office.

When a request for return of application documents is made, the Commissioner of the Korean Intellectual Property Office or the President of the Intellectual Property Tribunal shall return the documents immediately. Also, even when an applicant, etc. fails to submit the documents required for submission under Article 8 of the Enforcement Rules of the Patent Act without giving any legitimate explanation within the period for explanation, the commissioner or the president shall state the grounds for rejection of documents and return the application documents immediately.

Where an applicant, etc. fails to submit a written explanation or a request for return of

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application documents within the period for explanation, or where the explanation is recognized to be groundless, the Commissioner of the Korean Intellectual Property Office or the President of the Intellectual Property Tribunal shall immediately return the application documents right after the expiration of the period for explanation.

When the Commissioner of the Korean Intellectual Property Office or the President of the Intellectual Property Tribunal intends to return application documents to an applicant, etc., he shall notify the applicant, etc. of the ground for rejection of the documents. A notice that an applicant, etc. can initiate an administrative trial or lawsuit shall be written in the notification of the return of documents.

(3) An applicant, etc. can submit an explanation or opinion on the notification of grounds for rejection of application documents within the period for explanation. However, he/she is not allowed to submit an amendment in order to address the grounds for rejection of application documents.

(Note) The matters to be amended in procedures include irregularities in the items of applications, failure to prepare required documents. Other than the above-mentioned irregularities in formalities, substantive issues such as whether foreigners hold any capacity or whether an applicant can obtain a patent (in the case of a joint invention) shall not be included. Therefore, a decision not to accept such substantive matters immediately shall not be made. Application documents containing such substantive matters shall be accepted first, and then an examiner shall conduct a substantive examination on the application documents.

6. Subsequent Completion of Procedure

(1) Where a person who initiated a patent-related procedure has failed to comply with the period for requesting a trial under Article 132(3) or the period for demanding a retrial under Article 180(1) of the Patent Act because of a cause not imputable to the person, he/she may subsequently complete the procedure within the designated period. It is based on the reason that where a person who initiated a patent-related procedure is not allowed to challenge the decision or the ruling because the period for requesting a trial or retrial has

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expired due to a cause not imputable to the person, he/she would get harshly disadvantaged in such procedures. Also, it is the same purport as Article 16(2) of the Patent Act.

(2) The period allowed for subsequent completion of a patent-related procedure is within 14 days of the day when a cause not imputable to the person who initiated the patent-related procedure ceases to exist. When one year has elapsed from the day of the expiration of the period for subsequently completing a patent-related procedure, the procedure cannot be completed subsequently.

7. Restoration of Patent Application

Where a patent applicant fails to comply with one of the following periods due to reasons unattributable to him or her and this leads to the revocation of a patent application or confirmation of a decision to reject a patent right, the applicant may file a request on examination or reexamination of the application within two months from the date on which such grounds cease to exist. However, if one year has passed from the expiration date of the concerned period, the applicant shall not file a request on examination or reexamination of the application. (Article 67(3)(i) of the Patent Act)

1. the period allowed for a request of examination on an application in accordance with Article 59(2) or (3) of the Patent Act
2. the period allowed for a request of reexamination on an application in accordance with Article 67(2)(i) of the Patent Act

② Notwithstanding Article 59(5) of the Patent Act, where there is a request for examination or reexamination on an application under paragraph 1, the patent application shall be deemed not to have been withdrawn or the decision of rejection of the patent right shall be deemed not to be confirmed.(Article 67(3)(ii) of the Patent Act)

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Chapter 5. Discontinuation and Resumption of Procedure

1. Relevant Provisions

Article 18 of the Patent Act (Succession of Procedural Effects) The effects of a procedure taken in relation to a patent or other rights relating to a patent shall extend to the successor in title.

Article 19 of the Patent Act (Continuation of a Procedure by a Successor) Where a patent right or other patent-related right is transferred while a patent-related procedure is pending before the Korean Intellectual Property Office or the Intellectual Property Tribunal, the Commissioner of the Korean Intellectual Property Office or the presiding administrative patent judge may require the successor in title to continue the patent-related procedure.

Article 20 of the Patent Act (Interruption of a Procedure) If any patent-related procedure pending in the Korean Intellectual Property Tribunal falls under any of the following subparagraph, it shall be interrupted: *Provided,* That this shall not apply where there is a representative authorized to conduct the procedure:

1. When the party involved is deceased;

2. When the juristic person involved ceases to exist by merger;

3. When the party involved loses the ability to conduct the procedure;

4. When the legal representative of the party involved is deceased or loses his/her authority;

5. When the commission of a trustee given by the trust of the party involved terminates;

6. When the representative as provided for in the proviso of Article 11(1) is deceased or loses his/her qualification; or

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7. When the trustee in bankruptcy, etc. who acted on behalf of the party involved in his/her own name under a certain qualification loses his/her qualification or is deceased.

Article 21 of the Patent Act (Resumption of an Interrupted Procedure) When a procedure pending in the Korean Intellectual Property Office or the Intellectual Property Tribunal has been interrupted in the manner referred to in Article 20, a person who falls under any of the following subparagraphs shall resume the procedure:
1. In cases of subparagraph 1 of Article 20, the deceased person's successor, administrator of inheritance, or any other person authorized to pursue the procedure under other Acts: Provided, That the his/her right to succession is subject to renunciation;

2. In cases of subparagraph 2 of Article 20, the juristic person established by a merger or survived a merger;

3. In cases of subparagraphs 3 and 4 of Article 20, the party whose ability to take necessary procedure has been restored or any person who becomes the legal representative of the party;

4. In cases of subparagraph 5 of Article 20, a new trustee;

5. In cases of subparagraph 6 of Article 20, a new representative or each party;

6. In cases of subparagraph 7 of Article 20, a new trustee in bankruptcy, etc. holding the same qualification.

Article 22 of the Patent Act (Request for a Resumption) ① A request to resume a procedure interrupted under Article 20 may be made by an opposing party.

② When a request to resume a procedure interrupted under Article 20 is made, the Commissioner of the Korean Intellectual Property Office or the presiding administrative patent judge shall notify the opposite party thereof.

③ If the Commissioner of the Korean Intellectual Property Office or the administrative

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patent judge deems that no grounds exist to accept a request to resume the procedure interrupted under Article 20, after examining the request *ex officio*, he/she shall dismiss the request by decision.

④ The Commissioner of the Korean Intellectual Property Office or the administrative patent judge shall decide, upon request to resume, whether to permit resumption of the interrupted procedure after a certified copy of the decision or trial decision was sent.

⑤ If a person referred to in Article 21 fails to resume the interrupted procedure, the Commissioner of the Korean Intellectual Property Office or the administrative patent judge shall, *ex officio*, designate a period and order to resume such procedure within the period.

⑥ If no request for resumption is made within the period designated in paragraph (5), the resumption is deemed to have been made on the day after the designated period expires.

⑦ Having determined that a resumption has been made in accordance with paragraph (6), the Commissioner of the Korean Intellectual Property Office or the administrative patent judge shall notify the party involved.

Article 23 of the Patent Act (Suspension of a Procedure) ① If the Commissioner of the Korean Intellectual Property Office or the administrative patent judge is unable to carry out his/her duties due to a natural disaster or other extenuating circumstances, the procedure pending in the Korean Intellectual Property Office or the Intellectual Property Tribunal shall be suspended until such impediments cease to exist.

② If a party involved is unable to pursue a procedure pending in the Korean Intellectual Property Office or the Intellectual Property Tribunal on account of impediments of indefinite duration, the Commissioner of the Korean Intellectual Property Office or the administrative patent judge may order its suspension by decision.

③ The Commissioner of the Korean Intellectual Property Office or the administrative patent judge may cancel the decision issued under paragraph (2).

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④ If a procedure is suspended under paragraphs (1) or (2), or a decision is canceled under paragraph (3), the Commissioner of the Korean Intellectual Property Office or the presiding administrative patent judge shall notify the parties involved thereof.

Article 24 of the Patent Act (Effects of Interruption or Suspension) The interruption or suspension of a patent-related procedure pending in the Korean Intellectual Property Office suspends the running of a term and the entire term shall start to run again from the time of the notification of the continuation or resumption or pursuit of the procedure.

2. Discontinuation of Procedure

Discontinuation of a patent-related procedure refers to a condition where a patent-related procedure such as filing an application, making a request has not been legally initiated while an application is pending before the Korean Intellectual Property Office or the Intellectual Property Tribunal. The Patent Act divides the discontinuation of a patent-related procedure into interruption of procedure and suspension of procedure.

Interruption of a procedure means that when a cause not attributable to a party involved happens, the concerned legal procedure is interrupted until another party can reinitiate a procedure interrupted.

Suspension of a procedure refers to the condition where a cause not imputable to the Korean Intellectual Property Office or a party involved happens in pursuing the concerned procedure, the procedure is suspended legally or by the decision of the Korean Intellectual Property Office.

2.1 Interruption of Procedure

(1) A patent-related procedure shall be interrupted because of legal reasons regardless of intention of the Korean Intellectual Property Office or a party involved who initiates the concerned procedure. When a procedure is interrupted, a legitimate successor in title shall make a request for resumption of the interrupted procedure. However, even in the presence of a cause of interruption of a patent-related procedure, the concerned procedure shall not

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be interrupted if there is a legal representative with power of attorney.

Parties who can resume the interrupted patent-related procedure based on ground for interruption are listed below.

① Where a party involved is deceased, a successor in title or an administrator of inherited property of the party involved or a person who is legally required to pursue the interrupted procedure

However, a successor in title shall not resume the concerned procedure until he/she renounces inheritance.

(Note) Article 1019 of the Korean Civil Act (Period for Acceptance and Renunciation) ① An inheritor to property may, within three months after he is informed of the commencement of an inheritance, effect an acceptance, absolute or qualified, or a renunciation.

② Where a juristic person involved ceases to exist by merger, the juristic person established by merger or continuing to exist after merger

③ Where a party involved loses the ability to conduct a patent-related procedure, the party involved who has recovered the ability to conduct the procedure, or a person who has become a legal representative

④ Where a legal representative of a party involved is deceased or loses his/her authority, the party involved who has recovered the ability to conduct a patent-related procedure or a legal representative or a person who has been newly appointed as a legal representative

⑤ Where the commission of a trustee given by the trust of the party involved is terminated, a newly-appointed trustee

⑥ Where a representative under the proviso to Article 11(1) of the Patent Act is deceased or loses his/her qualification, a new representative or each party involved

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⑦ Where a trustee in bankruptcy, etc. who acted on behalf of a party involved in his/her own name holding a certain qualification loses his/her qualification or is deceased, a person with the same qualification

(2) An interrupted procedure can be resumed by submitting a written application stating such intention of resumption. When a request for resumption of an interrupted procedure is made, the Commissioner of the Korea Intellectual Property Office or the President of the Intellectual Property Tribunal shall notify such request to the opposing party in the concerned procedure.

A person who intends to request the resumption of an interrupted procedure shall attach evidential documents of grounds for resumption to a written request for resumption of an interrupted procedure and then submit them to the Commissioner of the Korean Intellectual Property Office or the President of the Intellectual Property Tribunal. Also, a resumption of an interrupted procedure can be requested by an opposing party. The Commissioner of the Korean Intellectual Property Office or the administrative patent judge shall dismiss the request of resumption when a request for resumption of an interrupted procedure is recognized to be groundless recognizing based on the result of an *ex officio* investigation.

The Commissioner of the Korean Intellectual Property Office or the administrative patent judge shall determine, upon request to resume, whether to permit resumption of an interrupted procedure after a certified copy of the decision to grant a patent was sent.

Meanwhile, where the party involved who was supposed to resume an interrupted procedure failed to do so, the Commissioner of the Korean Intellectual Property Office or the administrative patent judge shall order a resumption of the interrupted procedure within a designated period. Where the interrupted procedure is not resumed within the designated period, the interrupted procedure shall be deemed to be resumed on the day following the expiration of the designated period and be notified to the party involved.

(3) In general, even when grounds for interruption of a patent-related procedure generate or cease to exist, the commissioner or the administrative patent judge cannot be aware of such fact when a report of change of rights is not submitted by an applicant. Therefore, in

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an ordinary examination, an examiner shall conduct the examination on a patent-relate procedure without an additional investigation into whether the procedure has been interrupted or not.

Where the Commissioner of the Korean Intellectual Property Office has become aware of the fact that a ground for interruption of a patent-related procedure was generated in the middle of an examination, he shall suspend the examination until the point when the procedure is resumed under Article 21 of the Patent Act. An interrupted procedure can be resumed when a request for resumption has been made or when the commissioner has become aware that the ground for resumption of the procedure has been addressed.

Where an examiner is aware of a ground for resumption of an interrupted procedure, he/she shall order a resumption of the procedure within the designated period in the name of the Commissioner of the Korean Intellectual Property Office. Where a request for resumption of a patent-related procedure is not filed within the designated period, the request for resumption shall be deemed to have been filed. Then, the examiner shall notify such fact to the party involved and carry out the examination.

(4) Where an examiner overlooks a ground for interruption of a patent-related procedure and continues an examination procedure, he/she shall invalidate such procedure and initiate the procedure from the beginning.

(Example) Where an applicant without any representative has died, but an examiner has sent a notice of ground for rejection and made a decision of rejection without awareness of death of the applicant, the decision of rejection is illegitimate since the procedure for submission of a written opinion according to a notice of ground for rejection is supposed to be halted under Article 20 of the Patent Act, even when the Korean Intellectual Property Office or a successor of the applicant does not take additional actions. Therefore, an examiner shall revoke the decision of rejection and give an opportunity to submit a written opinion by delivering a notification of submission of a written opinion after resumption of the interrupted procedure.

2.2 Suspension of Procedure

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(1) If the Korean Intellectual Property Office is unable to carry out its duties due to a natural disaster or other extenuating circumstances, the procedure shall be suspended without any decision of suspension.

(2) If a party involved is unable to pursue a procedure pending in the Korean Intellectual Property Office on account of impediments of indefinite duration, the Commissioner of the Korean Intellectual Property Office or the administrative patent judge may order its suspension by decision. In this context, 'impediments of indefinite duration' refer to the condition in which the Korean Intellectual Property Office is able to conduct its duties but a party involved faces impediments in initiating a patent-related procedure. Such examples include where communications of a region in which a party involved is residing have been disrupted because of a war or other extenuating conditions and there is no sign of recovery from disruption anytime soon or where a party involved suddenly falls ill and is unable to contact the Korean Intellectual Property Office.

(3) Where the examination procedure of a patent application is related to a trial or litigation and where conducting the examination procedure on the concerned application after the completion of the trial or litigation procedure is deemed appropriate, an examiner can suspend such procedure by discretion.

(4) Where the condition in which the Korean Intellectual Property Office is unable to conduct its duties, such as a natural disaster, ceases to exist, the interrupted procedure shall be resumed under Article 23(1) of the Patent Act.

As for a suspended procedure under Article 23(2) of the Patent Act, where it is recognized that the ground for suspension ceased to exist or other patent-related procedures can be resumed, an examiner can revoke the decision of suspension.

Where a patent-relate procedure is suspended under Article 23(1) or (2) of the Patent Act or where a decision of suspension is revoked, the Commissioner of the Korean Intellectual Property Office or the presiding administrative patent judge shall notify the party involved thereof.

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2.3 Effect of Suspension of Procedure

The interruption or suspension of a patent-related procedure shall suspend the running of a period for such procedure and the entire period shall start to run again from the time of the notification of the continuation or resumption or pursuit of the procedure. In other words, the period which elapsed before the interruption or suspension of the period shall not be calculated and the entire term of the designated period or statutory period shall commence anew, instead of that the designated period or statutory period is completed by the running of the remaining period before the interruption or suspension of the period.

(Example) Where an examiner ordered to amend a patent-related procedure within one month under Article 46 of the Patent Act in the name of the Commissioner of the Korean Intellectual Property Office, but the procedure was interrupted when 15 days elapsed after the request for amendment and then was resumed, the period allowed for amendment after the resumption of the period shall be one month.

(2) In principle, while a patent-related procedure is interrupted or suspended, the Commissioner of the Korean Intellectual Property Office or an examiner shall not initiate the procedure.

3. Resumption of Procedure and Succession of Effect

(1) Where a patent right or any patent-related right is transferred while a patent-related procedure is pending in the Korean Intellectual Property or the Intellectual Property Tribunal, the Commissioner of the Korean Intellectual Property Office or the presiding administrative patent judge may require the successor in title to the patent right or the patent-related right to continue the patent-related procedure.

Where an examiner intends to make the successor in title resume a patent-related procedure, he/she shall notify the party involved of such intention in the name of the Commissioner of the Korean Intellectual Property Office.

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(2) Where a patent right or any patent-related right is transferred, the effect of the already-initiated patent-related procedure shall reach the successor in title. In other words, where a patent right or any patent-related right is transferred, the procedure does not need to commence anew since the already-initiated procedure is effective. Therefore, a party involved does not need to restart the patent-related procedure which was already initiated.

(Example) Where a notice of change of applicant was filed within the designated period after an examiner sent a notification of submission of a written opinion, the examiner does not need to send a notification of submission of a written opinion to the successor in title again. Also, the period for submission of a written opinion shall become a period designated in the original notification of submission of a written opinion.

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Chapter 6. Submission and Delivery of Documents

1. Relevant Provisions

Article 28 of the Patent Act (Effective Date of Submitted Documents) ① Written applications, written requests or other documents (including articles; hereinafter the same shall apply in this Article) submitted to the Korean Intellectual Property Office or the Intellectual Property Tribunal under this Act, or any order thereunder, shall be effective as of the date on which they are delivered to the Korean Intellectual Property Office or the Intellectual Property Tribunal.

② Where written applications, written requests or other documents under paragraph (1) are submitted by mail to the Korean Intellectual Property Office or the Intellectual Property Tribunal, they are deemed to be delivered to the Korean Intellectual Property Office or the Intellectual Property Tribunal on the date stamped by the mail service if the date stamp is clear. However, if such stamped date is unclear, they are deemed to have been delivered on the date on which the mail was submitted to a post office, which is proved by a receipt therefor. *Provided*, That this shall not apply where written applications for requesting registration of a patent right and other rights related thereto, and documents concerning an international application under Article 2(vii) of the Patent Cooperation Treaty (hereinafter referred to as "international application") are submitted by mail.

③ Deleted.

④ Matters concerning the submission of documents with regard to the delay of mail, loss of mail, or interruption of the mail service, other than paragraphs (1) and (2), shall be presented by Ordinance of the Ministry of Knowledge Economy.

Article 28-3 of the Patent Act (**Procedure for Filing Patent Applications by Electronic Documents)** ① A person who initiates a patent-related procedure may, pursuant to the means prescribed by Ordinance of the Ministry of Knowledge Economy, convert a written application for a patent or other documents to be presented to the Commissioner of the

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Korean Intellectual Property Office or the President of the Intellectual Property Tribunal under this Act into electronic documents, and may present them by means of any information and communication network or any electronic recording medium, such as a floppy disk or an optical disk.

② Electronic documents presented under paragraph (1) shall have the same effect as other documents presented under this Act.

③ When a presenter thereof confirms a receipt number through an information and communication network, such electronic documents presented through an information and communication network under paragraph (1) shall be deemed to have been received as the details written in a file for receipt saved on a computer system operated by the Korean Intellectual Property Office or the Intellectual Property Tribunal.

④ The kinds of documents capable of being presented by means of electronic documents under paragraph (1) and the means of such presentation or other necessary matters therefor shall be prescribed by Ordinance of the Ministry of Knowledge Economy.

Article 28-4 of the Patent Act (Report on Use of Electronic Documents and Electronic Signature) ① A person who intends to initiate a patent-related procedure by electronic documents shall first report the use thereof to the Commissioner of the Korean Intellectual Property Office or the President of the Intellectual Property Tribunal, and shall affix his/her electronic signature so that the presenter may be discerned.

② Electronic documents presented under Article 28-3 shall be deemed to have been filed by a person who affixes his/her electronic signature under paragraph (1).

③ Matters necessary for procedures of report on use of electronic documents and the methods of electronic signature under paragraph (1) shall be prescribed by Ordinance of the Ministry of Knowledge Economy.

Article 28-5 of the Patent Act (Notification, etc. through Information and Communication Networks) ① If the Commissioner of the Korean Intellectual Property

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Office, the President of the Intellectual Property Tribunal, a presiding administrative patent judge, an administrative patent judge, a presiding examiner, or an examiner intends to give notification and make transmission (hereinafter referred to as a "notification, etc.") of any pertinent documents to a person who reports the use of electronic documents under Article 28-4 (1), he/she may do so through information and communication networks.

② The notification, etc. of any pertinent documents given through information and communication networks under paragraph (1) shall have the same effect as that given in writing.

③ The notification, etc. of any pertinent documents under paragraph (1) shall, if it is written in a file of a computer system operated by a person who receives the said notification, etc., be deemed to reach as the details written in a file of a computer system for transmission operated by the Korean Intellectual Property Office or the Intellectual Property Tribunal.

④ Matters necessary for the classification and the means of notification, etc. given through information and communication networks under paragraph (1) shall be prescribed by Ordinance of the Ministry of Knowledge Economy.

Article 218 of the Patent Act (Service of Documents) Necessary matters related to procedures for service of documents, etc. in this Act shall be prescribed by Presidential Decree.

Article 219 of the Patent Act (Service by Public Announcement) ① In cases where documents cannot be served because the domicile or place of business of a person to be served is unclear, service shall be made by public announcement.

② Service by public announcement shall be implemented by publishing a notice in the patent gazette to the effect that the documents will be served at any time to the person to be served.

③ The initial service by public announcement shall come into force after the expiry of two weeks from the date it is published in the Patent Gazette: *Provided*, That subsequent service

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by public announcement on the same party shall come into force from the date following its publication in the Patent Gazette.

Article 220 of the Patent Act (Service of Documents to Overseas Residents) ① For an overseas resident having a patent administrator, documents shall be served on his/her patent administrator.

② For an overseas resident without a patent administrator, documents may be sent to him/her by registered airmail.

③ When documents have been sent by registered airmail under paragraph (2), such documents shall be deemed to have been served on the mailing date.

2. Submission of Documents

2.1 Effective Date of Submitted Documents

Written applications, written requests or other documents (including articles) submitted to the Korean Intellectual Property Office shall be effective as of the date on which they are delivered to the Korean Intellectual Property Office and 'the date on which they are delivered' can be defined as follows:

(1) Where written applications, written requests or other documents are submitted by mail to the Korean Intellectual Property Office, they are deemed to be delivered to the Korean Intellectual Property Office ① on the date as stamped by the mail service if the stamped date is clear, ② on the date when the mail was submitted to a post office, which is proved by a receipt therefor, if the stamped date is unclear or ③ on the date the documents are delivered to the Korean Intellectual Property Office if the stamped date is unclear or if there is no receipt for the mail.

(Note) Where documents are submitted by mail, the distance between the Korean Intellectual Property Office and the place where each party involved resides may differ, leading to unfairness to a party involved who lives a long distance away. Therefore, the time

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when the documents are submitted to a post office is deemed to be the time when the documents are delivered to the Korean Intellectual Property Office.

(2) Where written applications, written requests or other documents (including articles) are submitted by other means except for by mail, they are deemed to be delivered to the Korean Intellectual Property Office when the office has received such documents.

(3) Where documents regarding an international application (an international application under Article 2 (vii) of the Patent Cooperation Treaty) are submitted by mail, such documents shall take effect from the date when they are delivered to the Korean Intellectual Property Office despite the above-mentioned provision (1) regarding the submission of documents by mail.

However, this shall apply to only an international application. Where a translation is submitted to enter the national phase or where a written opinion is submitted in the examination phase, an examiner shall determine based on the above-mentioned (1) or (2).

(4) In the cases of delay of mail, loss of mail, or interruption of the mail service of an international application in the international phase, the application shall be prescribed by Articles 86 to 88 of the Enforcement Rules of the Patent Act. However, where other provisions on an international application exist in the PCT Rules (Article 82) other than the above-mentioned articles, the PCT Rules shall apply preferentially.

(5) Where there is a delay of mail, loss of mail of an internal application, or interruption of the mail service, Articles 86-88 of the Enforcement Rules of the Patent Act shall apply.

2.2 Execution of Patent-Related Procedure by Electronic Documents

(1) A patent-related procedure can be initiated by using electronic documents. A person who wishes to initiate a patent-related procedure by electronic documents shall first report the use thereof to the Commissioner of the Korean Intellectual Property Office or the President of the Intellectual Property Tribunal. The report of use of electronic documents under Article 9(3) of the Enforcement Rules of the Patent Act shall be prescribed by Annexed Form No.6

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of the Enforcement Rules of the Patent Act.

(2) Electronic documents hold the same effect as other paper documents submitted. Electronic documents presented through an information and communication network shall be deemed to have been received as the details written in a file for receipt saved on a computer system operated by the Korean Intellectual Property Office or the Intellectual Property Tribunal when a presenter of the documents confirms a receipt number through an information and communication network.

(3) Documents submitted by a person who initiates a patent-related procedure by electronic documents through an information and communication network or any electronic recording medium exclude a written submission of articles, such as attached electronic documents, a written request for correction and assignment, documents related to an international application written in Japanese (including submission of Annexed Forms No.35 and 51 attached with original copies of the documents), a written request for ruling under Article 214(1) of the Patent Act and a written request for correction of the digitized contents.

Meanwhile, an applicant who files an application related to national defense under secrecy orders cannot file an application electronically. However, where an applicant has received a notification to cancel the maintenance of secrecy or a notice to cancel secrecy, he/she can file an electronic application.

(4) Electronic documents shall be electronically signed by using the software operated by the Korean Intellectual Property Office or the KIPO webpage and be submitted.

Also, a person who wishes to submit documents online shall enter the applicant code and password to the electronic data processing system by using the software provided by the Korean Intellectual Property Office.

(5) Where electronic documents are submitted in an electronic recording medium, 'a written submission of articles such as attached electronic documents' of Annexed Form No.7 of the Enforcement Rules of the Patent Act shall be submitted to the Commissioner of the Korean Intellectual Property Office or the President of the Intellectual Property Tribunal. In this case,

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documents which cannot be submitted in an electronic recording medium shall be attached to 'a written submission of articles such as attached electronic documents' and be submitted.

(6) Where a person initiating a patent-related procedure submits the documents online and there are some documents that have not been attached in online submission among the documents which are required to be submitted, he/she shall attach the documents which are not submitted to 'a written submission of articles such as attached electronic documents' in Annexed Form No.7 of the Enforcement Rules of the Patent Act within three days of the day when the applicant confirmed a receipt number of his/her online submission and submit the documents in writing.

(7) Where two or more patent-related procedures which are required to be initiated at the same time by ordinance are submitted online, they shall be entered consecutively. Among two or more patent-related procedures required to be initiated at the same time by ordinance, where one of such procedures are submitted online and the rest are submitted in an electronic recording medium or in writing, all of the concerned patent-related procedures shall be conducted on the same day.

3. Service of Documents

Under the Patent Act and the subordinate statutes, where the results of a patent-related procedure which is being carried out affect the gain or loss of a patent right or the interest of a party involved, the document containing such results shall be notified and served to a party involved in a certain procedure. It is to avoid possible conflicts in advance by serving the documents to a person who is supposed to receive such documents.

The Patent Act and the subordinate statutes define documents which affect the gain or loss of a patent right in a patent-related procedure as documents subject to service and also specify methods for service of such documents. The Patent Act and the subordinate statutes prescribe that service of documents other than those subject to service shall be prescribed by the Commissioner of the Korean Intellectual Property Office.

3.1 Service Procedure of Documents

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(1) Documents subject to service related to examination under the Patent Act and the subordinate statutes include a certified copy of the decision to grant a patent right, a notification of invalidation under Article 16(2) of the Patent Act, as well as a certified copy of the decision under Article 214(3) of the Patent Act.

(2) Methods of service of documents include personal service, service by mail and service by public notification. Such methods of service of documents shall be prescribed in Article 18 of the Enforcement Decree of the Patent Act.

Meanwhile, under Article 18(11) of the Enforcement Decree of the Patent Act, the sending, etc. of documents other than those subject to service under the Act shall be made under the conditions as prescribed by the Commissioner of the Korean Intellectual Property Office. However, currently the sending, etc. of documents related regulations for practice of the Korean Intellectual Property Office as well as operation of installation of dispatch boxes, regulations for administrative practices on examination, regulations for administrative practices on filing an application and the PatentNet system are operated in the same way as the sending etc. of documents subject to service. Therefore, such documents shall be treated the same as documents subject to service.

Moreover, even though a format such as in a notification to cancel of the decision of invalidation is not reflected in the patent examination processing system, where examination results affect the gain or change of a patent right, an examiner shall notify the examination results to a party involved by using the 「Government Electronic Document System(On-nara system)」.

(3) Personal service refers to a method of serving documents to a party involved or his/her representative in person. In such a case, an examiner shall obtain a receipt stating the date of receipt and the name of recipient from the person who has received the documents. Where a recipient writes the date of receipt and the name of recipient on the document service registry (Annexed Form No.3) and the registry of postage payment by addressee (Annexed Form No.4) placed at the dispatch box in the General Services Division and confirms them with the registered seal, the presentation of a receipt can be replaced with

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the stamping of the registered seal. When the above-mentioned recipient is not a patent attorney, the patent attorney's registered seal and a representative's seal shall be stamped together (Article 7 of the Regulation for Administrative Practices of Dispatch Box of the Korean Intellectual Property Office).

(4) Service of documents shall be conducted by registered mail, except for the cases where a party involved or his/her representative receives documents in person or via an information and communication network. Where documents are served by mail, a receipt of the registered mail of such documents issued by a post office shall be placed.

(Note) Where a written ruling or decision on trial, retrial or revocation of a patent right is to be served, an examiner shall follow a special service method as prescribed the Postal Service Act. However, an examiner may use the information and communication network when serving a ruling or decision on trial, retrial or revocation of a patent right to a person who filed the documents in the electronic form.

(5) The recipient of documents to be served shall be a person to whom the documents are to be served. Where an applicant has a legal representative, the recipient shall be the legal representative. Where an applicant has a sub-attorney or a representative appointed in the middle of a procedure**,** the recipient shall be the sub-attorney or the agent appointed in the middle of a procedure, except for some special reasons. In this context, some cases with special reasons refer to where a representative not subject to preferential notification or a party involved directly initiated a procedure related to examination, such as a procedure for amendment or a written opinion, right before the notification by an examiner.

Where there are two or more legal representatives, the representative firstly written in an application shall become the recipient of the documents, except for some special reasons.

Where there is a representative with general power of attorney among two or more representatives, documents shall be served case by case to each representative in charge.

Where a person to be served is an incompetent person, documents shall be served to

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his/her legal representative.

Where two or more persons jointly initiate a patent-related procedure and a common representative has been appointed, documents shall be served to the common representative. Where there is no notification of appointment of common representative, the applicant firstly written in the documents shall receive such documents, except for some special reasons.

Any service to a person who is put in a prison or detention house shall be made to the head of such prison or detention house.

Meanwhile, where there are more than two parties involved or legal representatives and one legal representative is designated to receive documents and the fact is notified to the Commissioner of the Korean Intellectual Property Office (the president of the Intellectual Property Tribunal), any service of documents shall be made to the legal representative.

(6) Documents shall be served to the domicile or business office of a person to be served. However, where a person wishing to receive documents has made a report on another place, documents shall be served to the place where the recipient wanted to receive them. When the place where the documents are originally to be served is changed, it shall be reported without delay to the Commissioner of the Korean Intellectual Property Office.

(Note) Where a person to be served refuses to receive the documents without any justifiable reason and it is thereby impossible to make a service, the service shall be considered to have been made on the day of sending.

3.2 Service by Public Announcement

Where documents cannot be served because the domicile or place of business of a person to whom the documents are to be served is unclear, service shall be made by public announcement. In this context, 'where documents cannot be served because the domicile or place of business of a person to be served is unclear' refers to the case where the domicile of a person to be served cannot be confirmed even by using the resident registration

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number sharing system. Where two or more persons initiate a patent-related procedure, documents shall be served by public announcement when the domiciles of all of the persons cannot be identified.

An examiner shall make a service by public announcement based on the following procedure.

① Where documents are returned, the director of the chief division of the examination bureau shall enter the dispatch number and the grounds for return of the documents into the data processing system and notify such facts to the director of the examination division or the head of the examination team.

After being notified of the above-mentioned facts, the director of the examination division or the head of the examination team shall confirm the domicile of a person to be served by entering such information into the administrative data sharing system and notify such results to the examiner in charge of the application.

② Where an examiner cannot confirm a new domicile of the applicant even by using the method mentioned in the above paragraph ①, the examiner shall try to confirm the applicant's domicile by calling the phone number written in the application or by other means.

③ When the domicile of the applicant is identified by using the methods mentioned in the above paragraph ① or ②, an examiner shall, once again, send "a guide for notification of change(correction) in applicant information" attached with a notification of applicant information in Annexed Form No.5 of the Enforcement Rules of the Patent Act and the returned document to the newly-identified domicile of the applicant.

④ Where the domicile of the applicant cannot be identified even by using the method mentioned in the above paragraph ②, an examiner shall service the returned documents by public announcement. However, where a ground for return of the document is the recipient's absence, the examiner can serve "a guide of notification of change in applicant information" attached with a notification of applicant information in Annexed Form No.5 of the

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Enforcement Rules of the Patent Act and the returned documents to the domicile of the applicant again.

※ Where a person to be served is a juristic person, the resident registration number sharing system cannot be used. Therefore, an examiner shall try to find the correct domicile and serve the documents to the statutory domicile of the recipient at least once before serving documents by public announcement.

(Notice) Despite procedures reflected in the regulations for examination practices and the patent net system, where an examiner can serve documents to a person to be served by reviewing documents by each application, he/she can serve such documents by the above-mentioned method.

(Note) Currently, when a certified copy of a written request is served once to the address of the plaintiff originally written on the register, but is returned, an examiner immediately obtains internal approvals for the return of the document and then services the document by public announcement. However, there are other ways to identify the address of the plaintiff by *ex officio* investigation, such as looking up the information of the plaintiff in other relevant administrative institutions, since his/her resident registration number is written in the register. Therefore, the decision of service of documents by public announcement without trying to find the address of the plaintiff cannot be deemed to be the proper proceeding of the procedure (Case No. 91 Hu 59(Supreme Court, 8. October 1991)).

3.3 Instruction of Service of Documents by Public Announcement

(1) Where the address of an applicant has changed after documents were served to the applicant by public announcement, the documents served by public announcement shall be delivered to the applicant again. However, where a patent-related procedure in respect with the document to be re-served is terminated, such documents do not need to be delivered to the applicant again. Then, a designated period or statutory period shall be calculated starting from the effective date by service of documents by public announcement. Where service of documents by public announcement was made for the first time, the service shall become effective two weeks after such documents are disclosed in the patent gazette.

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However, any subsequent service of documents by public announcement to the same party involved shall take effect on the following date of the disclosure of the documents in the patent gazette.

(2) After the initial public announcement, where an examiner intended to deliver relevant documents to the same party involved, but ① there was no notification of change of applicant information despite a notice on report of change of applicant information and ② the grounds for return of the documents at the time of public announcement were 'Recipient Absence', 'Moved' or 'Address Unknown', he/she shall immediately make a public announcement, rather than delivering the documents by mail.

(3) Where a party involved makes a request for the notification of documents to be publically announced without changing his/her address, an examiner shall deliver the documents by stating the contents of the documents or attaching the documents to be publically announced at the announcement of the report on change of applicant information. Also, where an examiner recognizes that such decisions are necessary, he/she shall do the same.

(4) Where a party involved is absent from the submitted address for a long time or a business of a party involved is temporarily shut down without change of domicile or business address, the treatment of returned documents shall apply *mutatis mutandis* to the service of such documents.

(5) Among documents delivered from the Korean Intellectual Property Office regarding examination, documents under Article 218 of the Patent Act and under Article 18 of the Enforcement Decree of the Patent Act shall be served by public announcement. However, documents other than the above-mentioned documents for public announcement shall not be necessarily served by public announcement if they have little influence on the right to obtain a patent and future notifications on such procedures are possible.

(Example) Where an examiner intends to deliver a notification for the possibility of use of documents to an information provider, he/she can skip the service of such notification by public announcement.

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(6) Where there are more than two parties involved to be served, such as two or more applicants and if the delivered documents are returned, an examiner shall serve the documents again to the other party involved, rather than serving the documents by public announcement.

(Notice) Where documents are delivered to a representative of more than two parties involved, but are returned, an examiner shall not directly deliver the documents to the parties involved, other than the representative. It is because any other person, other than a representative, cannot initiate the concerned procedure.

(7) Where a party involved requests the direct delivery of documents after the service of the documents by public announcement, a receipt for a written application shall be stored in the file wrapper. As for an electronically-filed application, an examiner shall make a request for the history of a written application to the Information Development Division of the Korean Intellectual Property Office and a receipt shall be kept in each examination division.

3.4 Service of Document to Overseas Resident

For an overseas resident having a patent administrator, documents shall be served on his/her patent administrator.

For an overseas resident without a patent administrator, documents may be sent to him/her by registered airmail and when the documents have been sent by registered airmail, such documents shall be deemed to have been served on the mailing date. In other words, the sending theory is adopted to the mail service to an overseas resident.

3.5 Special Service of Document

If an adjudication or decision on trial, review, ruling on the establishment of non-exclusive license and revocation of patent right are to be served, they shall be delivered by a special service method as prescribed by the Postal Service Act and the Enforcement Decree thereof. As for a utility model registration, if an adjudication or decision on technical evaluation of a

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utility model, trial, review, ruling on the establishment of non-exclusive license and revocation of a utility model right are to be served, they shall be delivered by a special service method as prescribed by the Postal Service Act. However, where a special service is to be made to a person who has filed a report of using the electronic filing system, the information and communications network can be utilized.

Article 15 of the Postal Service Act, Article 25 of the Enforcement Decree of the Postal Service Act and Articles 62, 63 of the Enforcement Rules of the Postal Service Act shall be referred as for a special service method.

3.6 Service of Electronic Document

Where an examiner wishes to serve documents to a person who has made a notification of use of electronic documents to the Korean Intellectual Property Office, he/she can do so through an information and communication network. Service of documents through an information and communication network shall have the same effect as service of written documents. Also, all documents can be served in an electronic form, except for there are special relevant provisions in the Patent Act (Example: Document by Special Service).

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Chapter 7. Fees

1. Relevant Provisions

Article 82 of the Patent Act (Official Fees) ① A person initiating a patent-related procedure shall pay official fees.

② Where the number of claims is increased because of the amendments to the description after a request for examination made by a person other than the applicant, the applicant shall pay the fees for the request for examination corresponding to the increased number of claims.

③ Matters necessary for the payment of official fees, the payment method and deadline thereof under paragraph (1) and other necessary matters shall be prescribed by Ordinance of the Ministry of Knowledge Economy.

Article 83 of the Patent Act (Reduction or Exemption of Patent Fees or Official Fees) ① Notwithstanding Articles 79 and 82, the Commissioner of the Korean Intellectual Property Office shall grant an exemption from paying any of the following patent fees or official fees:

1. Official fees or patent fees corresponding to the patent applications or patent rights belonging to the State; or

2. Official fees related to requests for an invalidation trial made by an examiner under Article 133(1), 134(1) or 137(1).

② Notwithstanding Articles 79 and 82, where a patent application has been filed by a person eligible for assistances in accordance with Article 5 of the National Basic Living Security Act or a person prescribed by Ordinance of the Ministry of Knowledge Economy, the Commissioner of the Korean Intellectual Property Office may reduce or exempt the payment of the official fees prescribed by Ordinance of the Ministry of Knowledge Economy and the patent fees for obtaining the establishment registration of a patent right for the first

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three years.

③ A person who intends to take advantage of reduction or exemption of patent fees or official fees in accordance with paragraph (2) shall submit documents prescribed by Ordinance of the Ministry of Knowledge Economy to the Commissioner of the Korean Intellectual Property Office.

Article 84 of the Patent Act (Refund of Patent Fees etc.) ① No patent fee and official fee paid shall be refunded: *Provided,* That in any of the following cases, such fees shall be refundable upon a request by the person who made such payment:
1. Patent fees or official fees paid erroneously;

2. Portions corresponding to the patent fees for the years subsequent to the year in which a trial decision of invalidation on the patent becomes final and conclusive;

3. Portions corresponding to the patent fee for the years subsequent to the year in which a trial decision of invalidation on the registration of patent term extension becomes final and conclusive; or

4. Application fees for a patent and fees for the request for examination among official fees already paid where the patent application concerned was withdrawn or abandoned within a month after such application is filed (excluding a divisional application, converted application and patent application with a request for accelerated examination).

② When any patent fee or official fee paid falls under any subparagraph of paragraph (1), the Commissioner of the Korean Intellectual Property Office shall issue a notification to the party who paid such fees.

③ Refund of patent fees and official fees under the proviso to paragraph (1) may not be claimed if more than three years have elapsed from the date of receiving the notification under paragraph (2).

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2. Payment of Fees

Official fees are paid by a person initiating a patent-related procedure, such as filing a patent application or a request for trial, as a benefit in return for the service or rewards provided by the State. These fees have different characteristics from other ordinary taxes.

Grounds for collection of fees and a person entitled to payment of fees are prescribed in Article 82(1) and (2) of the Patent Act. The payment method and deadline thereof are prescribed in paragraph (3) of the same article of the Patent Act by Ordinance of the Ministry of Knowledge Economy. 'The Rule for Collection of Patent fee, etc. (hereinafter, referred to as Fee Collection Rules)' specifies the amount of official fees including patent fees, registration fees and the payment methods.

(1) Patent-related fees shall be paid by a person initiating the patent-related procedure. Therefore, if a person other than or an applicant or a patentee initiates a patent-related procedure, the person initiating the patent-related procedure shall pay the fees (fees of a request for trial or fees for accelerated examination, etc.).

However, if fees of a request for examination are increased because of amendment after the request for examination made by a third party (where the addition of a new claim leads to the increase of fees of a request for examination for the new claim), an applicant shall pay the additional fees for examination of the newly-added claim.

(2) Types and amounts of official fees are defined under Articles 2 and 3 of the Fee Collection Rules and the fees related to examination are listed below. The amount of each fee by type shall be referred to the KIPO website (http://www.kipo.go.kr).

① Application Fee: Fee for Patent Application, Fee for Registration of Patent Term Extension, Fee for Utility Model Registration, Fee for Division of Application, Fee for Conversion of Application
② Fee for Priority Claim: Fee for Request for Priority Claim of Patent Application
③ Fee for Request for Examination: Fee for Request for Patent Examination, Fee for Request for Retrial, Fee for Request for Accelerated Examination

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④ Fee for Change of Applicant Name
⑤ Fees for Amendment
⑥ Fee for Extension of Statutory Period, Fee for Extension of Statutory Period

(3) When documents are submitted, the registration number of the documents shall be deemed as the payer number. Then, fees shall be paid to a bank collecting taxes or a post office by the following day of receipt of the documents. Additional fees shall be paid along with basic fees.

Fees can be paid through electronic payment means, such as *Internet Giro*, or in cash along with the description in Annexed Form No. 1(2) of the Rules for Collection of Patent fee. However, when fees are paid by mail, they shall be paid with a postal money order attached.

Fees paid after the period for payment of fees has elapsed shall be returned.

(4) When a request for examination is made, fees of a request for examination under Article 2(1)(7) and 3(1)(6) of the Fee Collection Rules shall be paid by a person who has made the request for examination. When fees of a request for examination are unpaid, an examiner shall order amendment. Where irregularities are not addressed after amendment, an examiner may invalidate the concerned request for examination.

In estimating fees of a request for examination, the number of claims shall be counted by each claim, regardless of an independent claim and dependent claim. Even if a claim is dependent on more than two claims, the claim shall be counted as one claim.

After making a request for examination, where fees of a request for examination are increased because of amendment (It refers to the case where fees of a request for examination are increased because a new claim is added or the previously-deleted claim is corrected to disclose an invention), an applicant shall pay the additional fees when submitting a written amendment. Even when claims are deleted because of amendment, the fees already paid shall not be returned.

The calculation manners of the number of claims when counting fees of a request for

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examination are as follows:

① When filing an application and a request for examination is conducted at the same time or where no amendment is made until a request for examination is made, fees shall be counted based on the claims in the initial application.

(Example) Initial claims: 3 → No amendment → Fee for examination request: based on 3 claims

② Where claims are increased or decreased because of amendment until a request for examination is made, fees shall be counted based on the final claims after amendment.

(Example) Initial claims: 3 → Claims after amendment: 5 → Fee for examination request: based on 5 claims
Initial claims: 3 → Claims after amendment: 2 → Fee for examination request: based on 2 claims

③ Where filing a request for examination and submitting amendment to claims are made at the same time, fees shall be counted based on the claims at the time of submission of amendment.

(Example) Initial claims: 3 → Amendment (one deleted, three newly added) → Fee for examination request: based on 5 claims (3-1+3)

④ Where claims are increased because of amendment after a request for examination is made, fees shall be counted based on the increased number of claims regardless of the deleted claims.

(Example) Initial claims: 3 → Fee payment for examination request → Increased claims because of amendment (one deleted, five newly added) → Additional fee for examination request: based on the newly-added 5 claims (excluding one deleted claim).

3. Reduction of Patent Fees or Official Fees

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3.1 Exemption of Fees

The Commissioner of the Korean Intellectual Property Office shall grant an exemption from the payment of patent fees or official fees related to a patent application belonging to the State (except for regional governments) or a request for invalidation trial by an examiner as well as all the fees for the patent-related procedures.

However, where the State and a person other than the State jointly initiate a patent-related procedure, patent fees or official fees shall be paid according to the fee collection rules, rather than an exemption from the payment of fee granted.

(Note) Where a patent application is filed by a special organization in state/public universities as an employee's invention of the state/public universities, the payment of patent fees or official fees shall not be exempted.

3.2 Complete Exemption of Patent Fees or Official Fees

The following persons shall not pay application fees and fees of a request for examination for 10 cases each for a patent and utility model registration as well as patent fees or fees for utility model registration for the first three years when he/she files a patent application or utility model registration or registers the establishment of the right.

However, it should be noted that amendment fees other than application fees and fees related to a request for examination are collected.

Each requirement for exemption from payment of patent fees or official fees shall be met when the concerned documents are submitted. Therefore, where an applicant fell under the exemption from payment of patent fees when filing an application, but is excluded from exemption at the time of registration of the right, patent fees for the first three years shall not be exempted.

Subject of Exemption	Requirement	Evidential Document

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1. National Basic Livelihood Security Recipient	Only when the inventor and the applicant are identical	Evidential documents under National Basic Livelihood Security Act
2. Person with National Merit and the surviving/bereaved family, Person with National Merit of 5.18 Democratic Uprising and the surviving/bereaved family, Agent Orange Victim, Patient suspicious for Agent Orange, Second-generation victim of Agent Orange, Government special agent and the bereaved, etc.		One copy of evidential documents of the concerned qualification
3. The registered disabled person under Welfare of Disabled Persons Act		Copy of the Identification Booklet for the Physically Handicapped or evidential documents of registered disabled person under Welfare of Disabled Persons Act
4. Student [only under-graduates(including polytechnic college students), except for graduate students]		Certificate of Attendance
5. Minor younger than 19 years old		None

(1) Recipients receiving National Basic Livelihood Security Act benefits are only limited to those who are designated as recipients under Article 2 of the National Basic Livelihood Security at the time of submission of documents such as a patent application.

(2) Persons of National Merit and the surviving/bereaved families are only limited to those who are designated as persons with national merit and the surviving/bereaved families under Articles 4 and 5 of the Act on Honorable Treatment, etc. to Persons of National Merit at the time of submission of documents such as a patent application.

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(3) The handicapped are only limited to those who are designated as the handicapped under Article 32(1) of the Welfare of Disabled Persons Act at the time of submission of documents such as a patent application.

(4) Students are only limited to those who are designated as students of the schools under Article 2 of the Elementary and Secondary Education Act and Article 2 of the Higher Education Act(except for graduate students) at the time of submission of documents such as a patent application.

Schools under Article 2 of the Elementary and Secondary Education Act include elementary schools and civic schools, middle schools and high civic schools, high schools and high technical schools, special schools, etc.

Schools under Article 2 of the Higher Education Act include universities and colleges, industrial colleges, teachers' colleges, air colleges, air and correspondence colleges and cyber colleges, technical colleges, etc.

(5) Students of polytechnic colleges are only limited to those who are attending the polytechnic colleges under the proviso of Article 2(1) of the Polytechnic College Act at the time of submission of documents such as a patent application.

3.3 Partial Exemption of Patent Fees or Official Fees

Partial exemption from the payment of application fees, fees for a request for examination, patent fees for the first three years or fees for utility model registration shall be granted to an individual as well as a middle- and small-sized company (hereinafter, referred to as SMEs) under the proviso of Article 2 of the Framework Act on Small and Medium Enterprises, a joint research between conglomerates and SMEs, a public research organization, a technology transfer task force.

In calculating the exemption amount, less than 100 won shall not be included in the amount to be exempted.

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In this context, if an applicant who has filed an application personally wishes to obtain exemption from the payment of patent fees or official fees, he/she shall be an inventor or designer.

Payment of application fees, fees for a request for examination, patent fees for the first three years and utility model registration fees shall be exempted by 70% in the following cases.

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Subject for Exemption	Requirement	Evidential Document
1. Individual	Only when the inventor is the applicant	None
2. Small Enterprise	º Small Enterprises under the proviso of Article 2 of the Framework Act on Small and Medium Enterprises 1. Company with less than 50 full-time employees in mining, manufacturing, construction or transportation 2. In the businesses other than those defined above, company with less than 10 full-time employees ※Business classification under the Appendix of the Enforcement Decree of the Framework Act on Small and Medium Enterprises ※Only in the case of employees' invention (design) · creation	º Evidential documents of small enterprise -A copy of business registration certificate -Document proving the number of full-time employees e.g.) Report for state of withholding tax payment, etc.
3.Medium Enterprise	º Medium Enterprises under the proviso of Article 2 of the Framework Act on Small and Medium Enterprises 1. Manufacturing: Company with less than 300 full-time employees or 8 billion won in capital 2. Mining, Construction, Transportation: Company with less than 300 full-time employees or 3 billion won in capital 3. Retail Sale in Non-Specialized large Stores, Hotel, Condominium, Telecommunications, Other Information Technology and Computer Operation Related Services, Engineering Service, Hospital, Broadcasting: Company with less than 300 full-time employees or 30 billion won in sales 4. Growing of Crop Seeds and Nursery Products, Fishery, Electricity·Gas and Water Supply, Wholesale of Medicine and Medical Goods, Wholesale of Solid, Liquid and Gaseous	º Evidential documents of medium enterprise - A copy of business registration certificate - Documents corresponding to the subparagraph 1 · Document proving the number of full-time employees e.g.) Report for state of withholding tax payment, etc. · Document proving the amount of capital or sales e.g.) Balance sheet, etc.

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	Fuel and Related Products, Retail Sale via Mail Order Houses , Door to Door Retailing of Merchandise, Supporting and Auxiliary Transport Activities; Activities of Travel Agencies, Supporting and Auxiliary Transport Activities ; Activities of Travel Agencies, Storage and Support Activities for Transportation, Professional, Scientific and Technical Activities, Business Support Services, Motion Picture, Amusement and Theme Park Operation: Company with less than 200 full-time employees or 20 billion won in sales 5. Wholesale Trade and Commission Trade, Except of Motor Vehicles and Motorcycles, Renting of Industrial Machinery and Equipment, Research and Experimental Development On Natural Sciences, Research and Experimental Development On Natural Sciences, Public Performance, News Agency Activities, Operation of Botanical and Zoological Gardens and Natural Parks, Sewage and Refuse Disposal, Sanitation and Similar Activities: Company with less than 100 full-time employees or 10 billion won in sales 6. Other businesses: Company with less than 50 full-time employees or 5 billion won in sales ※Business classification under the Appendix of the Enforcement Decree of the Framework Act on Small and Medium Enterprises ※Only in case of employees' invention (design) · creation	

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Payment of the concerned fees shall be exempted by 50 % in the following cases.

Subject of Exemption	Requirement	Evidential Document
1. Joint Research between Conglomerates and SMEs	º Application fee and fee for a request for examination where a joint research is conducted based on the contract between conglomerate and small/medium enterprise ※ Only application fee and fee for a request for examination where application or a request for examination was filed after May 1, 2006	º A copy of business registration certificate of conglomerate º Evidential document of small/medium enterprise
2. Public Research Organization	º Public research organization under the proviso of Article 2(6) of the Technology Transfer and Commercialization Promotion Act	
	1. National · Public research organization	º Evidential document
	2. State-funded research organization established under the Act on the Establishment, Operation, and Fosterage of Government-invested Research Institutions	º None
	3. Specific research organization under the Support of Specific Research Institutes Act	º None
	4. Schools under the Higher Education Act (public schools established and operated by the State, civic schools established and operated by local governments and private schools established and operated by educational foundations)	º None
	5. Juristic person · organization related to R&D established under the Civil Act or other acts	
	- Juristic person · organization funded or supported with half of the annual research budget by the State, local governments or state-invested firms	º Evidential document
	- Juristic person funded with half of the capital or wealth invested or funded by the State, local governments or state-invested firms	
	- Juristic person · organizations necessary for promotion of technology transfer recognized and designated by other relevant central administrative	

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	agencies ※ Application fees, Examination request fees, Patent fees for the first three years, Utility model registration fees	
3. Technology Transfer Task Force	º Task forces under the proviso of Article 11(1) of the Technology Transfer and Commercialization Promotion Act(only when a task force established in public/civic schools under the Higher Education Act is a juristic person) ※ Application fees, Examination request fees, Patent fees for the first three years, Utility model registration fees	º Evidential document of task force
2. Local Government	º Local governments under Article 2(1) of the Local Autonomy Act ※ As for application, a request for examination or registration of establishment of rights made after July 28, 2010, only application fees, fees for a request for examination or registration fees for establishment of rights	º None

3.4 Procedure for Reduction of Patent fee or Official fee

(1) A person taking advantage of reduction or exemption of payment of application fees, etc. shall state grounds for reduction or exemption and the subject for fee reduction or exemption in a written application, a written request for examination or annual fee payment documents submitted at the time of filing an application, making a request for examination or registration of establishment of patent right. Then, he/she shall submit the concerned evidential documents to the Commissioner of the Korean Intellectual Property Office.

(2) An applicant shall state grounds for reduction/exemption of patent fees or official fees when initiating the patent-related procedure such as filing an application, making a request for examination, etc. in order to take advantage of reduction of payment of patent fees or official fees. If a person failed to apply for reduction of payment of patent fees or official fees at the time of filing an application or making a request for examination, but later

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applied for reduction on the ground that he/she was subject to reduction of payment of patent fees or official fees, his/her application for reduction of payment of paten fees or official fees shall not be recognized.

(3) Where evidential documents for a person with national merit or a registered handicapped person have been already submitted to the Commissioner of the Korean Intellectual Property Office, the documents may not need to be re-submitted. Where evidential documents of a recipient of National Basic Livelihood Security benefits, a person with national merit (the bereaved) or a registered handicapped person have already submitted, the submission of the evidential documents can be skipped by stating the intention of skipping the submission of such documents and the index information on the submitted documents.

4. Refund of Patent Fees or Official Fees

(1) Patent fees or official fees shall be refundable upon a request by the person who has made the payment in the following cases:

① Any fees paid by mistake

º All fees submitted when an application is not accepted (refunded)

º Where an application is invalidated, all fees paid at the time of filing an application, other than an application fee (fees for making a request for examination, fees for making a request for technical valuation, fees for application for priority claim, etc.)

º Fees paid by mistake or in excess

º Fees in case of invalidation or disapproval of the procedure

Where a priority claim and an additional request for priority claim have become invalidated or where a request for extension of the designated period and statutory period, and a request for change of the due date have become disapproved

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② The amount of patent fees for the following years after the decision to revoke a patent right has been made or a ruling of invalidating a patent right has become final and conclusive

③ The amount of patent fees for the following years after a ruling invalidating the registration for extension of a patent term has become final and conclusive

④ Fees for filing an application and fees for a request for examination already paid where a patent application (except for divisional application, converted application and patent applications filed after a request for accelerated examination) is filed and then the application is invalidated or abandoned within one month from the filing date [applied to patent applications filed after July 1, 2007]

(2) A request for refund of patent fee or official fee paid by mistake shall be made to the Korean Intellectual Property Office by a person whose name is written in the signature box on the receipt of fee payment documents or a person with power of attorney. Meanwhile, a person whose name is stated in the signature box on the receipt of fee payment documents, a registered patent right holder or a person with power of attorney shall make a request for refund of the patent (registration) fees for the following years after the decision to revoke a patent right has been made or a ruling of invalidating a patent right has become final and conclusive.

Also, where an examiner intends to make a decision of invalidation which would lead to refund of patent fee or official fee under the name of the Commissioner of the Korean Intellectual Property Office, he/she shall deliver a written invalidation with the guide for the procedure of refund of patent fee or official fee to the concerned payer.

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Chapter 8. Other Patent-Related Procedures

1. Relevant Provisions

Article 216 of the Patent Act (Inspection of Documents etc.) ① A person who intends to receive a certificate for a patent or a trial, a certified copy or extract of documents, or inspect or copy the Patent Register or documents may request the Commissioner of the Korean Intellectual Property Office or the President of the Intellectual Property Tribunal to that effect.

② The Commissioner of the Korean Intellectual Property Office or the President of the Intellectual Property Tribunal may refuse to permit the request referred to in paragraph (1) if it relates to a patent application, the establishment of which has not been registered or which has not been laid open for public inspection, or if it relates to matters liable to contravene public order or morality.

Article 217 of the Patent Act (Prohibition of Documents Relating to Patent Application, Examination, Trial, Retrial or Patent Register, etc. from being Taken out or Opened to Public) (1) Documents relating to a patent application, examination, trial or retrial or the Patent Register shall be prohibited from being taken out except for any of the following cases:

1. Where documents relating to patent applications or examinations are taken out for the purpose of searching prior art, etc. under Article 58(1) or 58(2) of this Act are removed;

2. Where documents relating to patent applications or examinations are taken out for the purpose of entrusting the affairs of digitizing patent documents under Article 217-2(1) of the Patent Act;

3. Where documents relating to patent applications, examinations, trials or retrials or the Patent Register are taken out for the purpose of online remote working under Article 32(2) of the Electronic Government Act.

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② A response shall not be given to a request for an expert opinion, testimony or any inquiry as to the contents of a pending patent application, examination, trial, or retrial that is in process, or as to the contents of an examiner's decision, trial decision or ruling.

Article 226 of the Patent Act (Offense of Divulging Confidential Information, etc.) Where any present or former employee of the Korean Intellectual Property Office or the Intellectual Property Tribunal has divulged confidential information on inventions or appropriated the invention disclosed in a pending patent application (including an invention for which an international application is pending) to which he/she had access during the course of his/her duties, such employee shall be punished by imprisonment not exceeding five years or by a fine not exceeding 50 million won.

Article 226*bis* of the Patent Act (Executives and Employees of Specialized Institutions, etc. Deemed to be as Public Officials) A person who is or was an executive or employee of any specialized institution or any agency of digitizing patent documents under Article 58(1) shall be deemed one who is or was an employee of the Korean Intellectual Property Office for purposes of applying Article 226.

2. Inspection of Documents

A person who intends to receive a certificate for a patent or a trial, a certified copy or extract of documents, or inspect or copy the Patent Register or documents may submit a written application under Annexed Form No.29 of the Enforcement Rules of the Patent Act to the Commissioner of the Korean Intellectual Property Office.

However, the Commissioner of the Korean Intellectual Property Office or the President of the Intellectual Property Tribunal shall not allow the inspection of documents relating to a patent application which have not been registered or disclosed yet or in case allowing the inspection of such documents would contravene public order or morality.

3. Prohibition of Documents from Being Taken or Open to Public

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Documents relating to a patent application, examination shall be prohibited from being taken out except for where a patent application is taken out for prior art searches or patent classification by a special agency or for entrusting the affairs of digitizing patent documents or for on-line remote performance of duties.

Also, it shall be noted that an examiner cannot give a response to a request for an expert opinion, testimony or an inquiry on the contents of a pending patent application, examination, trial.

4. Indication of Source of Document

(1) Indication of source of patent-related documents means where a person initiates more than two patent-related procedures simultaneously or consecutively and the contents of the evidential documents for such procedures are the same, he/she can submit the original copies of the evidential documents for one of the procedures or the procedure which was initiated first. Then, the documents for the rest of the procedures or subsequent procedures can be replaced by submitting a copy of the evidential documents with the same content or stating the intention of indication of the source of the original document in the box for the attached documents in the concerned form.

Source of the documents can be indicated in the following cases:

① A power of attorney where a patent-related procedure is initiated by a legal representative (including a patent administrator)
② Evidential documents where an invention is deemed to have not been disclosed
③ Documents of priority claim where a priority claim under the Treaty is made
④ Evidential documents of a legal representative of more than two parties involved
⑤ Evidential documents of a successor in title where a person succeeding a patent right initiates procedures of patent application, request, etc.
⑥ Evidential documents where a person initiating a patent-related procedure needs permission, approval, agreement, or consent from a third party in initiating procedures for patent applications, requests, etc.
⑦ Evidential documents if a patent-related procedure is initiated by a juristic person, or a

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certificate of nationality or evidential documents submitted by a national of a non-member state to the Treaty where a foreigner initiates a patent-related procedure

⑧ Evidential documents where a person initiating a patent-related procedure changes or corrects the name and domicile (in case of a juristic person, the title and business address) or changes his/her seal

Where copies of evidential documents are submitted instead of the original copies of the documents, the intention to indicate the source of documents shall be stated in the box for attached documents. The intention of indication shall be stated as in the following example.

(Example) A power of attorney [Indication of Document attached to Patent application No. 00-00000 submitted on (Month) (Day), (Year)]

(2) Where a person initiating a patent-related procedure intends to indicate the source of the already-submitted evidential documents, he/she can state the intention of indication in the box for attached documents in the concerned documents to replace the evidential documents.

(3) Evidential documents for authority of representative under Article 7 of the Patent Act do not need to be submitted in the following cases:

① Where a legal representative who has made a notification of designation of a representative under Article 5(2) of the Enforcement Rules of the Patent Act initiates a patent-related procedure within the scope of the power of attorney

② Where a legal representative who has made a registration of general power of attorney under Article 5(2)(2) of the Enforcement Rules of the Patent Act initiates a patent-related procedure within the scope of the general power of attorney

5. Offense of Divulging Confidential Information, etc.

Employees of the Korean Intellectual Property Office are regarded as public officials.

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Therefore, they have an obligation to protect the confidentiality of information acquired in the course of their work. Anyone shall be charged with divulging of confidential information if he/she divulges confidential information defined in the law. However, the protection of confidentiality of information on an invention in the course of filing a patent application is vital for the benefits of applicants. Therefore, the Patent Act contains the special provision regarding the offense of divulging confidential information.

A present or former executive and employee of a special institution or agency for digitizing patent documents under Article 58(1) of the Patent Act, too, shall be regarded as present or former staff of the Korean Intellectual Property Office, considering that they have easy access to the contents of undisclosed inventions in the course of their work.

(1) The subject of the offense of divulging confidential information includes a present and former public official of the Korean Intellectual Property Office and the Intellectual Property Tribunal. In this context, public officials refer to 'employees working for national or regional government agencies under the Act'. However, conventional wisdom and precedents dictate that 'employees of a public corporation equivalent to an administrative institution after individual consideration' are deemed to be public officials. Article 226(2) of the Patent Act specifies that an executive and employee of a special institution or agency for digitizing patent documents under Article 58 can be recognized as employees of the Korean Intellectual Property Office and they, too, can be subject to the offense of divulging confidential information.

(2) The object of the offense of divulging confidential information is confidential information on an invention in a patent application acquired in the course of work. In this context, confidential information on an invention in a patent application acquired in the course of work includes items to be kept confidential under the Patent Act and other relevant acts and items with considerable benefits when kept secret.

(3) Divulgence of confidential information means the act of informing a third party of confidential information. Such acts of informing a third party of confidential information include intentional divulgence as well as accidental divulgence. Misappropriation refers to the act of working an invention in a patent application acquired in the course of work

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against the intention of a right holder or the act of filing a patent application or utility model registration with a subservient invention or utility model related to the concerned invention.

(Note) Offenses related to the duties of public officials under the Criminal Act are defined in Articles 122-135 of Chapter 7 of Part 2 <Individual Provisions> of the Criminal Act. Offenses related to the duties of public officials have three types: the violation of the duties of public officials, the offense of harming the fairness of national function by power abusing and the offense of bribery.

① Violation of duties: Abandonment of duties, Publication of facts of suspected crime, Divulgence of official secrets
② Abuse of power: Abuse of authority, Unlawful arrest, Violence and cruel act
③ Bribery: Acceptance of bribe, Advance acceptance, Bribe to third person, Improper action after acceptance of bribe, Subsequent bribery, Acceptance of bribe through good offices, Offer, etc. of Bribe

A person who commits offenses related to the duties of a public official shall be a public official at the time of such acts. However, subjects of offenses of divulging of official secrets and advance acceptance of bribe shall include former and as soon-to-be government officials.

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PART II. Patent Application

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Chapter 1. Patent Applicant

1. Relevant Provisions

Article 33 of the Patent Act (Persons Entitled to Obtain Patent) ① Anyone who makes a new invention or his/her successor shall be entitled to obtain a patent in accordance with this Act: *Provided*, That employees of the Korean Intellectual Property Office and the Intellectual Property Tribunal shall not obtain patents while in office excluding cases of inheritance or bequest.

② If two or more persons jointly make an invention, the right to obtain a patent shall be jointly owned.

Article 34 of the Patent Act (Patent Application Filed by Unentitled Person and Protection of Lawful Holder of Right) If a patent cannot be granted because an application was filed by a person who is not the inventor or a successor to the right to obtain a patent (hereinafter referred to as "unentitled person") under the main sentence of Article 33 (1) falls under subparagraph 2 of Article 62, a subsequent application filed by a lawful holder of the right shall be deemed to have been filed on the date of filing of the initial application filed by the unentitled person: *Provided*, That this shall not apply where the subsequent application is filed by the lawful holder of the right more than 30 days after the date on which the application filed by the unentitled person was rejected.

Article 35 of the Patent Act (Patent Granted to Unentitled Person and Protection of Lawful Holder of Right) If a trial decision invalidating a patent has become final and conclusive due to the lack of entitlement under the main sentence of Article 33(1) as prescribed in Article 133(1)(2), a subsequent application filed by the lawful holder of the right shall be deemed to have been filed at the time the invalidated patent application was filed: *Provided*, That this shall not apply where the subsequent application is filed more than two years after the publication date of the first application or more than 30 days after the decision of invalidation becomes final and conclusive.

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Article 37 of the Patent Act (Transfer, etc. of Right to Obtain Patent) ① The right to obtain a patent may be transferred.

② The right to obtain a patent shall not be the subject of a pledge.

③ In cases of joint ownership of the right to obtain a patent, a joint owner shall not assign his/her share without the consent of all the joint owners.

Article 38 of the Patent Act (Succession to Right to Obtain Patent) ① The succession to the right to obtain a patent before the filing of the patent application shall not be effective against third persons unless the successor in title filed the patent application.

② Where two or more applications for a patent are filed on the same date with respect to the right to obtain a patent for the same invention derived by succession from the same person, the succession to the right to obtain the patent by any person, other than the agreed upon by all the patent applicants, shall not be effective.

③ Paragraph (2) shall also apply where a patent application and a utility model registration application are filed on the same date, with respect to the right to obtain a patent and utility model registration for the same invention and device which has been derived by succession from the same person.

④ Succession to the right to obtain a patent after the filing of the patent application shall not be effective unless a notice of change of applicant is filed, except in cases of inheritance or other general succession.

⑤ Upon inheritance or other general succession with respect to the right to obtain a patent, the successor in title shall notify the Commissioner of the Korean Intellectual Property Office of such purport without delay.

⑥ Where two or more notifications of change of applicant are made on the same date, with respect to the right to obtain a patent for the same invention that has been derived by succession from the same person, a notification made by any person, other than the one

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agreed upon after consultations among all the persons who made notifications, shall not be effective.

⑦ Article 36(6) shall apply *mutatis mutandis* to cases under paragraphs (2), (3) and (6).

Article 44 of the Patent Act (Joint Applications) Where the right to obtain a patent is jointly owned under Article 33(2), all the owners shall apply for the patent application jointly.

2. Inventor

(1) An inventor shall be entitled to obtain a patent from the time when an invention is completed to the time when the decision to reject a patent application has become final and conclusive or when the patent right is registered. The right to obtain a patent shall belong to an inventor upon creating an invention without taking any measures.

Article 33(1) of the Patent Act defines that anyone who makes a new invention or his/her successor shall be entitled to obtain a patent. Paragraph (2) of the same article states that if two or more persons jointly make an invention, the right to obtain a patent shall be jointly owned.

Where the application is filed by a person who does not have the right to obtain a patent for the application or where persons who jointly invented an invention fail to jointly file a patent application for the invention, it shall constitute a ground for rejection and invalidation.

(2) An inventor refers to someone who creates technical ideas by using the law of nature. Since invention is a factual act, anyone even without legal capacity, such as a minor, can become an inventor and as long as they initiate a patent-related procedure through a legal representative, they can obtain a patent.

(3) Where an invention is created by more than two persons, those who jointly made the inventions are inventors. Therefore, the right to obtain a patent is jointly owned. In such a case, a patent shall not be granted if some of the joint owners of the right to obtain a patent file a patent application.

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To become joint owners of an invention, each of the inventors shall, even partly, make a meaningful contribution to the completion of the concerned invention through mutual complementation in the technical process of creating the invention. Technically, all the joint owners shall be in mutual cooperation for the completion of an invention.

(4) Where an applicant unintentionally omitted or misspelled the names of some of the inventors, if necessary, the applicant can add or correct the names of the inventors until an examiner in charge determines the patentability of the claimed invention.

Once an examiner determines the patentability of the claimed invention, the addition of a new inventor shall not be accepted, except for where the name of the inventor was written incorrectly or where the name of an inventor that was stated in the application became omitted in the course of the application procedure.

Where an amendment of changing the name of an inventor is submitted during examination, it would suffice if an examiner determines whether the name of an inventor is omitted or misspelled by mistake unless there are any special reasons. An examiner does not need to ask for submission of evidential documents. In such a case, special reasons refer to where an examiner doubts that the omission or misspelling of the name of an inventor was unintentional because the examiner notified a ground for rejection under Article 29(3) of the Patent Act, but the applicant tried to address the ground by submitting an amendment of change of inventor.
(5) Where an examiner reasonably suspects that the person stated as the inventor is not the genuine inventor, the examiner may order to amend the application. Cases where an examiner reasonably suspects that the person stated as the inventor is not the genuine inventor include where an inventor is not a natural person, where a minor deemed not to have created the invention is stated as the inventor, etc.

3. Successor

The right to obtain a patent is a property right and may be transferred. Therefore, Article 37 of the Patent Act stipulates that the right to obtain a patent may be transferred.

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3.1 Procedure for Succession to Right to Obtain Patent

(1) Where the right to obtain a patent is transferred before filing a patent application, initiating special procedures for succession of the right is not required. However, the succession of the right to obtain a patent after filing an application shall be effective when a notice of change of inventor is filed, except for general succession.

Meanwhile, where the right to obtain a patent is transferred to a successor before filing a patent application and the successor intends to counter a third party, the successor shall file a patent application first.

(2) Where the right to obtain a patent is transferred after filing a patent application, the person who intends to file a notice of change of applicant shall submit to the Commissioner of the Korean Intellectual Property Office each copy of the following documents before the registration of the concerned application: the evidential document stating the grounds for change of applicant in a report of change of right relations in Annexed Form 20 of the Enforcement Rules of the Patent Act; the evidential document of permission/approval/agreement/consent from a third party, if necessary; or the evidential document of the right of representation if a patent-related procedure is initiated by a legal representative.

Where notices of change of applicant on more than two patent applications are to be filed, just one report can be filed on the premise that the contents of other notices of change of applicant are the same.

(3) Where more than two persons jointly file a patent application or a notice of change of applicant, and intends to partition the patent-related rights for applicants or successors, or where there exists a contract stating that the patent-related rights shall not be partitioned for a period not exceeding five years under the proviso of Article 268(1) of the Civil Act, the applicants shall state such intention in the written patent application or a report of change of right relations and submit the evidential documents.

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(Note) Even when the share of patent-related rights owned by applicants is to be changed, a copy of the evidential document of the ground for change of share or a copy of the evidential document of the right of representation if a patent-related procedure is initiated by a legal representative shall be attached to a report of change of right relations in Annexed Form 20 of the Enforcement Rules of the Patent Act and be submitted to the Commissioner of the Korean Intellectual Property Office.

(4) Where the person who initiated a patent-related procedure is deceased and the right to obtain a patent has been transferred, the procedure is interrupted under Article 20(1) of the Patent Act. Therefore, an inheritor shall resume the interrupted procedure by attaching ① the evidential document of the death of the inheritee(a death certificate or a copy of the legal predecessor's removal register from the census register/a family relation certificate), ② the evidential document of inheritance(a family relation certificate of the inheritor, etc.).

Where two or more inheritors exist, the interrupted procedure can be resumed if the evidential document of the representative of inheritors (a written consent of the inheritor, etc.) is submitted. An inheritor, etc. of the right to obtain a patent is prescribed under the provisions of Part 5. Inheritance of the Civil Act.

(5) Where the right to obtain a patent is transferred through bequest, a person with 'all-inclusive bequest' can resume the interrupted procedure by submitting ① the evidential document of death of an inheritee (a death certificate or a copy of the legal predecessor's removal register from the census register/a family relation certificate) or ② the evidential document of general bequest (a will, etc.), as done by an inheritor. However, a person with 'specific bequest' shall take over the right to obtain a patent from the inheritor by requesting him/her to perform the bequest of the right.

(Note) Bequest refers to an act that a testator leaves his/her personal property to another person under the will after his/her death. After collectively considering the wording of the will and the circumstances and according to the testator's intension, bequests are divided into all-inclusive bequests and specific bequests.

A person with an all-inclusive bequest has the same rights and duties as an inheritor under

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Article 1078 of the Korean Civil Act. Therefore, the person shall acquire the real rights as prescribed in Article 187 of the Civil Act. However, a person with a specific bequest shall only acquire a bond to request the person with the bequest liability to bequeath the property he/she owned.

(6) The right to obtain a patent can be jointly owned in the form of partnership-ownership. Therefore, in the cases of joint ownership of the right to obtain a patent, each joint owner shall not assign his/her share without the consent of the other joint owners.

(Note) Co-ownership refers to the right of property shared by two or more owners. In general, the co-owned property right can be used and profited according to the proportion of the share and the share can be disposed of without the consent of the other joint owners. In comparison, partnership-ownership of property refers to the property right owned by several persons through partnership relationship. The person having partnership-ownership cannot assign his/her share of property to another person without the consent of the other persons in the partnership. In other words, co-ownership is a temporary joint ownership for convenience, whereas partnership-ownership restricts individuals for the purpose of the partnership.

3.2 Treatment of Special Succession

(1) Where two or more applications relating to the same invention are filed on different dates with respect to the right to obtain a patent for the same invention derived by succession from the same person, only the applicant of the application having the earlier filing date may obtain a patent for the invention under Article 36(1) of the Patent Act.

(2) Where two or more applications for a patent are filed on the same date with respect to the right to obtain a patent for the same invention derived by succession from the same person, the succession to the right to obtain the patent by any person, other than the one agreed upon by all the patent applications, shall not be effective.

In such a case, an examiner shall designate a period in the name of the Commissioner of the Korean Intellectual Property Office under Article 36(6) of the Patent Act which Article

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38(7) of the same act applies *mutatis mutandis* and request the applicants to report on the result of consultation within the designated period. Notwithstanding the request of consultation, where the applicants fail to reach an agreement, the succession shall not be effective. Therefore, since all the relevant applications are deemed to have been filed by unentitled persons, the examiner shall notify the applicants of the ground for rejection citing the violation of Article 33 of the Patent Act and reject the applications.

The result of consultations shall be submitted to the Commissioner of the Korean Intellectual Property Office in the evidential document of the consultations attached to the report of change of right relations in Annexed Form No. 20 of the Enforcement Rules of the Patent Act, signed and sealed by all the conflicting parties. Where a patent-related procedure is initiated by a legal representative, the result of consultations shall be submitted to the Commissioner, attached with a copy of the evidential document of the legal representation. Also, necessary measures might be taken based on the result of consultations, such as withdrawal of some of conflicting patent applications.

(3) Where two or more notices of change of applicant are filed on the same date, with respect to the right to obtain a patent for the same invention that has been derived by succession from the same person, notices made by any person, other than the one agreed upon after consultations among all the persons who made notices, shall not be effective.

In such a case, an examiner shall designate a period in the name of the Commissioner of the Korean Intellectual Property Office as prescribed in Article 36(6) of the Patent Act which Article 38(7) of the same act applies *mutatis mutandis* and request all the persons who made notices to report on the result of consultations. Where no consultation is reached, the examiner shall conduct the examination, considering that the report of change of applicant has never been filed, rather than notifying the applicant of the ground for rejection.

The result of consultations shall be submitted to the Commissioner of the Korean Intellectual Property Office in the evidential document of the consultations attached to the report of change of right relations in Annexed Form No. 20 of the Enforcement Rules of the Patent Act, signed by all the conflicting parties. Where a patent-related procedure is initiated by a legal representative, the result of consultations shall be submitted to the Commissioner

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attached with a copy of the evidential document of the legal representation. Also, necessary measures might be taken based on the result of consultations, such as withdrawal of some of conflicting patent applications.

4. Protection of Lawful Holder of Right

The Korean Patent Act extends a greater protection to inventors, etc. with the provision for protection of a lawful holder of the right, even when an unentitled person filed a patent application before a lawful holder of the right filed an application for the same invention, if certain requirements are met. Articles 34 and 35 of the Patent Act define the protection of the lawful holder of the right indicating that where a patent cannot be granted or a patent right has been invalidated due to the lack of entitlement, a subsequent application filed by the lawful holder of the right shall not be rejected. In such a case, 'an unentitled person' refers to a person who is not the inventor or the successor to the right to obtain a patent. In other words, a person who failed to succeed the right to obtain a patent in a legitimate manner, but acts as the lawful holder of the right (hereinafter referred to as 'a person who filed a misappropriated application') as well as a successor in good faith who succeeded the right to obtain a patent from the person who filed a misappropriated application are unentitled persons.

4.1 Measures for Protection of Lawful Holder of Right

In order for a lawful holder of the right to be protected after a patent application was filed by an unentitled person, the lawful holder shall file an application for the same invention under Article 34 or 35 of the Patent Act. The lawful holder of the right shall submit an application in Annexed Form No. 14 of the Enforcement Rules of the Patent Act to the Commissioner of the Korean intellectual Property Office, attached with a specification, abstract or drawing(s), evidential document of the lawful holder of right as well as the evidential document of legal representation (in case of the presence of a legal representative).

4.2 Effect of Application filed by Lawful Holder of Right

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(1) An application filed by a lawful holder of the right shall be deemed to have been filed on the date when the initial application was filed by the unentitled person in the following conditions:

① Where the decision of rejecting a patent is made because the application was filed by an unentitled person and a subsequent application was filed by a lawful holder of the right. *Provided*, That this shall not apply where the subsequent application is filed more than 30 days after the decision of rejecting a patent becomes final and conclusive.

② Where a trial decision invalidating a patent has become final and conclusive due to the lack of entitlement and a subsequent application was filed by a lawful holder of the right after the initial application was filed by the unentitled person. *Provided,* That this shall not apply where the subsequent application is filed more than two years after the publication date of the first application or more than 30 days after the trial decision of invalidation becomes final and conclusive.

The patentability, calculation of the paten term and application of relevant provisions for an application filed by a lawful holder of the right shall be determined based on the date of the filing of the initial application filed by an unentitled person.

For example, where an application was filed by a third party for the same invention between the time when the initial application was filed by an unentitled person and the time of filing the subsequent application by a lawful holder of the right, the application filed by the lawful holder of the right shall not be rejected due to the application filed by the third party since the filing date of the application filed by the lawful holder of the right has a retroactive effect and precedes the filing date of the application filed by the third party. Rather, the application filed by the third party shall be rejected because of the application filed by the lawful holder of the right.

(Note) In order to protect a lawful holder of the right from the application filed by an unentitled person, Article 36(5) of the Patent Act stipulates that a patent application or utility model registration application filed by a person who is not the inventor, creator, or successor in title to the right to obtain a patent or utility model registration shall, in

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applying paragraphs (1) through (3), be deemed never to have been filed.

(2) Even when the application was filed by a lawful holder of the right more than five years after the date of filing the initial application by an unentitled person, a request for examination can be made within thirty days from the date on which the lawful holder of the right has filed the application. (Article 59(3) of the Patent Act)

where a request for examination on the application filed by the lawful holder of the right was made at the same time (or on the same day) as the date of the application filing, the request for examination shall be deemed effective.

(3) In order for the scope of invention of the application filed by a lawful holder of the right to be deemed legitimate, the invention disclosed in the detailed description of the invention and drawing(s) as well as the claimed invention shall be included in the scope of invention of the application filed by an unentitled person.

Where the application filed by a lawful holder of the right is out of scope of the invention (where multiple inventions are included in the application filed by a lawful holder of the right but only parts of the inventions are disclosed in the application filed by an unentitled person), the filing date of the application by the lawful holder of the right shall have no retroactive effect.

(4) Where a patent is granted to a lawful holder of the right under Articles 34 and 35 of the Patent Act, the term of a patent owned by the lawful holder of the right shall be 20 years, calculated from the following day of the filing date of the application by an unentitled person after the patent right of the lawful holder of the right is registered.

(5) As for an application filed by an unentitled person which has provided the reason for a lawful holder of the right to file a subsequent application for the same invention, an examiner shall notify a ground for rejection citing the violation of Article 33(1) of the Patent Act and make a decision of rejection. Also, after the decision of rejection has become final and conclusive, the examiner shall notify the lawful holder of the right of the decision in writing according to Article 33 of the Enforcement Rules of the Patent Act.

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(Note) Where a patent is granted to an application filed by an unentitled person, the patent can be invalidated through an invalidation trial.

5. Reference

(1) Article 33(1) of the Patent Act restricts the right to obtain a patent for employees of the Korean Intellectual Property Office while in office since they are closely engaged in a patent-related work. However, if employees of the Korean Intellectual Property Office create an invention, they can transfer the right to obtain a patent for the invention to a third party before filing an application or transfer the patent right to a third party after filing an application for the invention.

(2) The right to obtain a patent shall not be the subject of a pledge. Therefore, where a pledge is established upon the right to obtain a patent, the pledge shall not be effective.

(Note) Where a patent right or a utility model right is registered, a pledge can be established upon the patent right or the utility model right.

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Chapter 2. Patent Application Documents

1. Relevant Provision

Article 42 of the Patent Act (Patent Application) ① Any person who intends to obtain a patent shall file a patent application stating the following matters with the Commissioner of the Korean Intellectual Property Office:

1. The name and domicile of an applicant (if a juristic person, its title and place of business);
2. The name and domicile, or place of business of a representative of the applicant, if any (the title, place of business and the name of the designed patent attorney if the representative is a patent corporation);
3. Deleted;
4. The title of the invention;
5. The name and the domicile of an inventor;
6. Deleted.

② A patent application under paragraph (1) shall be accompanied by a specification stating the following matters, and necessary drawing(s) and abstract(s):

1. The title of an invention;
2. Brief description of the drawing(s)
3. Detailed description of the invention;
4. Claims

③~⑨ Omitted

Article 43 of the Patent Act (Abstract) An abstract under Article 42(2) shall not be interpreted to define the scope of invention for which protection is sought, but rather shall serve as a technical information document.

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2. Application

(1) In principle, a person who creates an invention is entitled to obtain a patent for the invention. However, the act of creating an invention does not necessarily guarantee the patent granting. Inventors, too, shall initiate subsequent procedures such as filing a patent application and making a request for examination, etc. in order to obtain a patent.

Article 42 of the Patent Act defines documents necessary for filing a patent application (application documents) which are a patent application, a specification, drawing(s) and abstract and instructions on how to fill out such documents. The principle on submission of application documents shall apply to initial applications as well as divisional or converted applications.

(2) Application documents are the substance of filing a patent application; written documents clarifying the subject of the application filing (a patent applicant) and the person who initiates the patent-related procedure (a patent applicant or a legal representative) as well as indicating the intention of obtaining a patent; and notices of other descriptions.

The descriptions in a patent application include ① the name and domicile of an applicant (if a juristic person, its title and place of business); ② the name and domicile, or place of business of a representative of the applicant, if any (the title, place of business and the name of the designated patent attorney if the representative is a patent corporation); ③ the title of the invention; ④ the name and the domicile of an inventor and so on. Also, the applicant code, priority claim, grade period and request for examination shall be indicated in a patent application.

(3) The title of the invention in a patent application shall be written briefly and concisely according to the content of the invention relevant to the application. However, the title of the invention in a patent application shall be identical with that of the invention in a specification.

(4) An inventor who fills out a patent application refers to the actual inventor who has made the invention related to the application and the person who holds the right as the inventor

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in a patent certificate. A juristic person shall not be recognized as an inventor.

3. Abstract

(1) Under Article 42(2)**(i)** of the Patent Act, a patent application shall be attached with an abstract.

The system for attaching an abstract is designed to efficiently use patent information in response to an ever-increasing number of applications filed and the sophistication of technical matters. This system allows an applicant to disclose the abstract at the time of filing the application so that any person who intends to utilize the information can easily search the abstract.

(2) An abstract cannot be used to set the scope of the claimed invention for which protection is sought. Under Article 97 of the Patent stipulates that the scope of protection conferred by a patented invention shall be determined by the subject matters described in the claims. Moreover, unlike a specification referred to when determining the scope of protection of the invention, an abstract is submitted only as the technical information indicating the overview of the invention.

Moreover, matters disclosed only in an abstract cannot hold the status of another patent application under Article 29(3) of the Patent Act and adding such matters disclosed only in an abstract to a specification through amendment shall not be allowed.

(3) Where an abstract is not attached to a patent application, the concerned application procedure shall be subject to request for amendment. Even when an abstract is poorly written without referring to the guideline for writing abstracts under Annexed Form No. 16 of the Enforcement Rules of the Patent Act, the abstract can be subject to request for amendment under Article 46 of the Patent Act.

Where irregularities are not addressed despite a request for amendment, an examiner may invalidate the concerned application procedure in accordance with Article 16 of the Patent Act.

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(Note) It shall be noted that when an abstract is incorrectly stated, an examiner shall not notify a ground for rejection citing that it has failed to meet the requirement under Article 42(3) or (4) of the Patent Act.

4. Specification

(1) The patent system is designed to promote the protection of an invention by granting the person who has invented and disclosed the new technology after the examination procedure and to contribute to industrial development by giving a third party the opportunity to utilize the invention. Such protection and utilization of the invention is realized by the specification serving not only as a title which specifies the scope of the invention of the invention, but as a technical document that discloses the technical matter of the invention.

Article 42 of the Patent Act specifies the requirement of stating the detailed description of an invention and the claims which compose a specification for the role of a specification as a right document and a technical document. Guidelines on writing the detailed description of an invention and the claims shall be referred to Chapters 3 and 4.

(2) A specification attached to a patent application at the time of filing shall state the title of the invention, a brief description of the drawing(s), the detailed description of the invention and claims according to Article 42(2) of the Patent Act. If necessary, the scope of patent claims may not be disclosed at the time of filing an application. However, it shall be stated through amendment within the period under the latter sentence of Article 42(5) of the Patent Act.

(3) The title of the invention disclosed in a specification shall be stated briefly and concisely based on the content of the invention as in the following:
① An ambiguous or wordy description of the invention shall be avoided and the name of the invention shall be stated briefly and concisely based on the content of the invention.

(Example) It is supposed to be stated as 'a device of preventing vibration in a dehydrating barrel of a centrifugal dehydrator', but instead written as 'a centrifugal dehydrator' or 'a

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centrifugal dehydrator without the dehydrating barrel vibrating', which is inappropriate.

② The name of a person, trademark, nickname of a product, expression of abstract functions or the word 'patent' itself shall not be included in the title of the invention.

(Example) 00(Inc.), Upgraded, Improved, State-of-the-art, Modern, etc.

③ When disclosing claims of more than two categories(product, manufacturing process, manufacturing device, usage, etc.) in the claims, the brief and concise title encompassing such multiple categories shall be used.

(Example) 'Paper, the manufacturing process and manufacturing device'

④The title of an invention shall clearly indicate what the invention claims for.

(Example) Where an invention is widely applied to multiple industries as an automatic control device, the title of the invention can be 'the automatic control device'. However, when the invention is only used for temperature control, it would be more appropriate that the title of the invention is stated as 'the automatic temperature control device'.

⑤ Where an invention disclosed in the claims is changed through amendments, the title of the invention shall be amended accordingly.

Moreover, the title of the invention shall be stated identically as that of the invention disclosed in the application.

Where the title of the invention disclosed in the specification is different from that of the invention disclosed in the application or is inappropriate, if there exists a ground for rejection, the examiner shall notify the applicant of the incorrect indication of the title of the invention, along with the ground for rejection. In such a case, the examiner may suggest a proper title of the invention to the applicant. Where the title of the invention is not amended despite the above-mentioned notification or where a decision to grant a patent is to be made since no other ground for rejection exists, the examiner shall amend the

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application by deciding the title of the invention deemed appropriate *ex officio* (use the *ex officio* button on the examination page of PatentNet) as well as the title of the invention in the specification accordingly. Where the decision to grant a patent cannot be made, the examiner shall order amendment under Article 46 of the Patent Act and invalidate the application procedure only if that the title of the invention is clearly inappropriate.

(Attention) It should be noted that the inappropriate title of the invention shall not constitute a ground for the decision of rejection even after a notification of submission of opinion has been delivered.

(Note) Where the English title of the invention disclosed in the application document or specification which an examiner intends to grant a patent is inappropriate and the English title is not consistent with that of the Korean title or is mistranslated, the examiner shall amend the title of the invention in the application as well as in the specification accordingly *ex officio*.

(4) In the box for the brief description of drawing(s), what each drawing indicates shall be stated as in the followings.

(Example) ［Brief description of drawing(s)］

Drawing 1 is the ground view of the whole assembly of the invention.
Drawing 2 is the front view of one side of the invention.
Drawing 3 is the longitudinal section of one side of the invention.

Where a brief description of drawing(s) is inappropriate, it shall be handled as the case of the inappropriate title of the invention in the above-mentioned (3).

5. Drawings

(1) When deemed necessary for explanation of the claimed invention, drawings may be attached for a better understanding of the subject matter of the invention disclosed in a specification.

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Drawings attached to a patent application shall be made under the guideline for drawings of Annexed Form No. 17 of the Enforcement Rules of the Patent Act. Where drawings are difficult to be made under Annexed Form No. 17 of the Enforcement Rules of the Patent Act such as crystal structure, structure of metal, shapes of fibers, structure of particles, types of organisms, results of oscilloscope; where it is inevitable in order to clearly indicate the content of the invention; or where the embodiment of the invention is better described with pictures, relevant pictures may replace drawings.

Where an applicant submits pictures instead of drawings, pictures clear enough to be laid open in the official gazette shall be acknowledged and, if unavoidable, grayscale images and color pictures may be accepted.

(2) A patent application may be attached with drawings when necessary. However, an application of utility model registration must be attached with drawings.

(Note) Where application documents of the utility model registration application do not include drawings, it shall be deemed an illegitimate application and be returned to the applicant.

(3) Where drawings irrelevant to the claimed invention, such as drawings of another patent application, are attached and where it constitutes the error in attachment of drawings, leading to the ground for rejection under Article 42(3**)(i)** of the Patent Act, an examiner shall indicate such intention and notify the concerned ground for rejection to the applicant. Where the error in attachment of drawings does not affect the working of the invention disclosed in the claims, it shall be indicated as the reference when notifying another ground for rejection. However, the above-mentioned error in attachment of drawings shall not be used as the ground for the decision of rejection.

(Attention) Where an amendment is made by submitting new drawings for the application including incorrect drawings, it could be the amendment of addition of new matters. Therefore, an examiner shall be cautious about examining the concerned application.

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Chapter 3. Detailed Description of Invention

1. Relevant Provision

Article 42 of the Patent Act (Patent Application) ①~② Omitted

③ Detailed descriptions of an invention under paragraph (2)3 shall satisfy the following requirements:

1. Descriptions of an invention shall be provided in accordance with the methods prescribed by Ordinance of the Ministry of Knowledge Economy in a clear and detailed manner to ensure that any person with ordinary knowledge in the art to which the relevant invention pertains can easily make the invention;

2. Background art shall be stated.

④~⑨ Omitted

Article 21 of the Enforcement Rules of the Patent Act (Patent Application, etc.) ①~② Omitted

③ The detailed description of an invention under Article 42(3)(i) of the Patent Act shall include the followings:

1. The technical field
2. The technical task to be solved
3. The solution means
4. Other necessary matters for a person with ordinary skill in the art to easily understand the content of the invention

④ Where no matter falls under the above-mentioned ③, that item may be omitted.

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2. Enablement Requirement

The detailed description of an invention shall be written clearly and fully so that a person with ordinary knowledge in the art to which the invention pertains easily understands the concerned invention. This means that a clear and precise description of the invention should lead a person skilled in the art to easily work the invention based on the technical knowledge, specification and drawings at the time of filing the application.

2.1 Subject of Working the Invention

In determining whether the detailed description of an invention fulfills Article 42(3)**(i)** of the Patent Act, 'a person skilled in the art to which the invention pertains' shall be deemed a technician with the average understanding in the technical field to which the application belongs(hereinafter referred to as a person skilled in the art).

2.2 Definition of「Easily Working the Invention」

(1) 'Working the invention' in terms of a product invention refers to the act of producing as well as using the product. As for a process invention, working means the act of using the method. Also, when it comes to a manufacturing process invention, working the invention shall refer to the manufacturing of the product by the concerned process.

(2) The invention subject to working shall be interpreted as the invention disclosed in claims. Therefore, where an invention only disclosed in the detailed description of the invention, but not in the claims, is not described well enough for the working, it does not violate Article 42(3**)(i)** of the Patent Act.

(3) 'Easily working' refers to a person skilled in the art to which the invention pertains fully understands the invention and reproduces it with the level of the technology at the time of application filing by referring to the specification, without adding special knowledge and excessive trial and error or repetitive experiments.

2.3 Examination Process

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2.3.1 Basic Consideration

(1) Product Invention

① Where a product invention is disclosed in claims, the detailed description of the invention shall contain the clear and full explanation on items allowing a person skilled in the art to produce the product. In general, to make manufacturing a product possible, the manufacturing process needs to be fully specified(Except for the case where the product can be manufactured based on the specification and drawings with the level of technology at the time of application filing even in absence of the description of the manufacturing process). Also, the concerned product needs to be fully grasped from the whole description of the detailed description of the invention and the roles and functions of each special technical feature that specifies the product shall be described together.

② A product invention shall be fully described so that a person skilled in the art can use the product disclosed in the claims. In order for a product to be available for use, meaningful and specific usage of the product needs to be described in a technical manner. However, it shall be an exception where, even without the description of use of the product, the product can be used based on the specification and drawings with the level of technology at the time of application filing.

(2) Process Invention

Where a process invention is disclosed in claims, the detailed description of the invention shall contain the clear and full explanation on items allowing a person skilled in the art to use the process. In general, to make using a process possible, the process needs to be fully grasped from the whole description of the detailed description of the invention and the roles and sequences of each step that specifies the process shall be described together.

(3) Manufacturing Process Invention

Where a manufacturing process invention is disclosed in claims, the detailed description of

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the invention shall contain the clear and full explanation on item allowing a person skilled in the art to produce a product with the manufacturing process. In general, to make manufacturing a product based on its manufacturing process possible, the manufacturing process itself needs to be fully grasped from the whole description of the detailed description of the invention and the roles and sequences of each step that specifies the manufacturing process shall be described together.

The manufacturing process of a product generally consists of a series of detailed steps dealing with raw materials. Therefore, raw materials for manufacturing the product and a series of the detailed steps shall be fully explained. Though not specifically described, the product manufactured through the concerned process shall be clearly described, except for the case where the product is easily understood based on the raw materials or detailed manufacturing steps.

2.3.2 Special Cases

(1) Chemical Substance Invention

The detailed description of chemical substance invention shall not be enough only with the name of the concerned chemical substance or the chemical formula. It is because chemical reaction which is expected to draw the certain chemical substance, in reality, would never happen because of unexpected causes and also the invention itself, as well as its possible effect, cannot be grasped without direct experimentation, confirmation and analysis. Therefore, as for chemical substance invention, the detailed manufacturing process of the chemical substance, let alone the description of the chemical substance itself, shall be described, except for the case where a person skilled in the art would easily understand the chemical reaction disclosed in the specification based on the level of technology at the time of the application filing.

As for chemical substance invention, its embodiment shall include the detailed response conditions necessary for manufacturing the substance invention such as the starting material, temperature, pressure, inflow and outflow and the result of the direct experiment under such conditions.

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(2) Use (Medicine) Invention

Chemical inventions might vary based on the content of the concerned invention and the level of technology, but unlike machinery device whose effect can be easily understood and realized from the subject matter of the invention, a person skilled in the art would not easily understand and realize the effect of the invention unless the experiment example suggesting the experimental data is not stated due to low predictability or realizability.

Therefore, chemical substance use invention can be deemed to be realized when the effect of the invention is described in the detailed description of the invention and at the same time, the description requirement of specification shall be met. Especially, as for medicinal use invention, description of medical data proving that the subject matter of the invention contains the same medical effect or description detailed enough to replace such medical data shall be disclosed unless particular conditions exist such as the certain mechanism indicating the medical effects disclosed in the specification before the application filing is disclosed.

(3) Parameter Invention

① A parameter invention refers to an invention serving as a part of the component of the invention after an applicant arbitrarily creates a parameter for physical-chemical characteristic values which is not the standard in the concerned technical field or an unacceptable parameter or creates a parameter based on the arithmetic expression by using the correlation between the multiple variables. In order for a parameter invention to be easily worked, a person skilled in the art shall state the detailed technical content on the parameter so that the detailed method of realizing the invention, the technical objective of the invention as well as the technical solution are clearly grasped.

② The detailed technical content on the parameter to easily work the invention shall include (ⅰ) the definition of the invention or the explanation of the technical meaning, (ⅱ) the numerical scope and the reason of limiting the numerical scope when the numerical limitation of the parameter is included, (ⅲ) the explanation on the method, condition and

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measuring device of measuring the parameter, (iv) the explanation on the method of manufacturing the product which meets the parameter, (v) the embodiment that fulfills the parameter, (vi) the comparative example that does not meet the parameter, and (vii) the explanation on relation between the parameter and effects.

③ Even when the detailed technical content on the parameter is not explicitly stated in the detailed description of the invention or drawing(s), where the content can be clearly understood considering the level of the technology at the time of application filing, an examiner shall not decide that the invention cannot be easily worked based on the above-mentioned ground.

2.4 Relation with Lack of Description on Claims

Since the enablement requirement and the requirement that the invention should be supported with the detailed description of the invention are closely linked, relevant provisions according to the below-mentioned criteria shall be applied in order to maintain efficiency and consistency of examination.

Article 42(3)**(i)** of the Patent Act applies when a person with ordinary knowledge in the art to which the invention pertains, that is, a person skilled in the art may not easily reproduce the claimed invention based on the detailed description of the invention. Article 42(4)(1) of the same act applies when the claimed invention is not disclosed in the detailed description of the invention or is out of scope of the detailed description of the invention that a person skilled in the art easily recognizes.

(Note) Whether the claims are supported with the detailed description of the invention shall be determined by a person skilled in the art based on whether the subject matter corresponding to the invention disclosed in the claims is disclosed in the detailed description of the invention. Where the content disclosed in the detailed description of the invention cannot be extended or generalized to the extent of the invention disclosed in the claims even based on the level of the technology at the time of application filing, the claims cannot be deemed to be supported with the detailed description of the invention.

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(1) Article 42(4)(i) shall apply where claims disclose the invention with the upper concept and the detailed description of the invention does not describe the invention with the upper concept but the invention with the lower concept, and the invention with the upper concept cannot be clearly grasped from the invention with the lower concept disclosed in the detailed description of the invention.
Article 42(3) of the Patent Act shall apply, too, where an embodiment of the invention with the lower concept is partially disclosed in the detailed description of the invention and, therefore, it can be clearly assumed that the invention with other lower concepts which belong to the upper concept of the claims cannot be easily worked.

Meanwhile, Article 42(4)(i) of the Patent Act shall apply where the invention with the lower concept disclosed in the claims is not clearly grasped from the detailed description of the invention even when the claims disclose the invention with the lower concept and the detailed description of the invention disclose the invention with the upper concept. Also, where the invention with the lower concept disclosed in the claims cannot be easily worked based on the detailed description of the invention, Article 42(3)**(i)** of the Patent Act shall apply, too.

(Example 1) Where claims disclose the extrusion molding method of plastic materials, but the detailed description of the invention briefly mentions the method of applying extrusion of plastic materials but describes the manufacturing process of edible plastic of agro-fisheries products whose main components are carbohydrate or protein in detail and, therefore, the disclosed molding temperature or pressure, etc. cannot be applied to the execution of the extrusion molding method of other plastic materials such as ceramics or metals, an examiner shall notify a ground for rejection citing the violation of Article 42(3) of the Patent Act. Also, where the detailed description of the invention does not disclose the method of applying extrusion of other plastic materials such as ceramics or metals besides the extrusion of agro-fisheries products, an examiner shall notify a ground for rejection citing the violation of Article 42(4)(i) of the Patent Act.

(Example 2) Where the detailed description of the invention discloses "an invention related to an oxygen absorbing composition and using particles of metal after annealing and electroreduction which can absorb oxygen faster than ordinary metal after annealing and

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electroreduction", but claims disclose "an oxygen absorbing composition including particles of metal after annealing and electroreduction with up to 99.6% of weight, salt up to about 3.5% of weight joining with water for creating electrolyte and properties of OOOO', if the patent claims are disclosed as the upper concept compared to the content in the detailed description of the invention and such content of the claims are not disclosed in the detailed description of the invention, an examiner shall notify the ground for rejection in violation of Article 42(4)(i) of the Patent Act considering the claims are not supported with the detailed description of the invention.

(2) Where claims use the Markush type and the detailed description of the invention discloses only embodiments related to certain matter among all the subject matter disclosed in the claims and the rest of the matter is only mentioned but their embodiments are not disclosed so that a person skilled in the art cannot easily work the invention, an examiner shall notify a ground for rejection citing the violation of Article 42(3) of the Patent Act.

(Example) Where claims disclose a method of producing para-nitro substituted benzene through nitration of compounds of substituted benzene with CH3, OH, COOH alternatively disclosed by substituent(X), but the detailed description of the invention only discloses the embodiment when the compound is toluene (when X is CH3) and the method is deemed inappropriate when compound is benzoic acid (when X is COOH) base on the opposite orientation of CH3 and COOH, an examiner shall notify a ground for rejection citing the violation of Article 42(3) of the Patent Act.

(3) Where the detailed description of the invention discloses a certain embodiment for working the invention and the embodiment of the invention related to the claims is deemed to be different from the embodiment disclosed in the detailed description of the invention, an examiner shall notify a ground for rejection in violation of Article 42(3**)(i)** of the Patent Act citing the reason that the invention related to the claims cannot be worked only with the embodiments disclosed in the detailed description of the invention.

(4) Where the terms used in the detailed description of the invention and the claims do not clearly match, an examiner shall notify a ground for rejection citing the violation of Article 42(4) (i) of the Patent Act since it is deemed that the invention disclosed in the claims is

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not supported with the detailed description of the invention.

3. Description Requirements

3.1 Purpose

(1) Since invention refers to the act of creating new technical ideas, it is important to disclose the invention for a better understanding of what technical implication the concerned invention has in consideration of the level of the technology at the time of filing the application and what technical advance the concerned invention has brought. In order to understand the content of the invention, the detailed description of the invention should include what unresolved tasks are left in what technical field and how the tasks are solved with which methods. This is the method of description generally adopted by many countries around the world in terms of writing a specification.

The description requirement was drawn to clarify the technical matter and scope for which the patent protection is sought by disclosing the content of the claimed invention so that a third party can easily understand the invention only with the specification.

(2) Article 21 of the Enforcement Rules of the Patent Act suggests the description method enabling examiners or third parties to easily understand what technical advances the invention would bring, including the technical field, the technical objectives that the invention intends to achieve, the means for solving technical problems and other necessary items for a better understanding of the content of the invention by a person skilled in the technical field to which the invention pertains.

However, the above-mentioned items do not need to be separately disclosed. Where such items are understood from the overall content of the detailed description of the invention, it shall be deemed sufficient.

(3) Where an invention for which patent protection is sought does not fall under any of the items specified under the Enforcement Rules of the Patent Act, the concerned item may be deleted.

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For example, where a method of composing a new matter is invented by chance, if the new matter or the composing method can be well understood from the description without any description on the technical objectives that the invention intends to achieve, it shall not be deemed to be the violation of the description requirement of the detailed description of the invention.

3.2 Detailed Method of Description

In principle, the detailed description of the invention shall contain the following boxes: [Technical Field], [Background Art], [Prior Art Literature], [Content of Invention], [Detailed Content for Working of Invention], [Industrial Applicability], [Consignment Number] and [Sequence Listing Free Text]. The content shall be clear and precise enough for a person skilled in the art to easily understand the invention and reproduce it through repetition.

In such a case, "the detailed description of the invention" refers to the rest of the description beside the title of the invention, the brief explanation of drawings (if the explanation of marks is disclosed, it shall be included) and the scope of patent claims, among all the items disclosed in the specification submitted by an applicant attached to the specification under Article 42(2) of the Patent Act.

3.2.1 Technical Field

The technical field of the invention for which patent protection is sought shall be stated clearly and briefly. If possible, related technical fields shall be disclosed, too. At least one technical field shall be indicated, but where a person skilled in the art can understand based on the technical knowledge without explicit description, the technical field need not be indicated.

Where an applicant knows the International Patent Code to which the invention belongs, the applicant may refer to the IPC.

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3.2.2 Content of Invention

In principle, the content of the invention includes technical tasks to be solved, a means for solving the technical issues and effects and shall be stated as in the following manner.

(1) In the box for technical tasks to be solved, the issue of prior art which is the technical objective of the invention for which patent protection is sought shall be stated.

However, if a person skilled in the art can understand the technical tasks to be solved based on other descriptions in a specification and the technical knowledge without any explicit description, the content of the invention need not be disclosed. Also, when original technical tasks to be solved are not raised in the first place, like an invention created based on an idea totally different from prior art, the description of the technical issues is not necessary.

(2) In the box for a means for solving the technical issues, the type of the means used to address the concerned technical shall be stated. In general, the invention for which patent protection is sought itself can become the means for solving the technical issues. However, where a person skilled in the art can sufficiently understand the process of solving the technical issues based on other descriptions of the specification such as the technical tasks to be solved and embodiment, etc., any means for solving the technical issues need not be stated.

Where original technical tasks to be solved are not raised in the first place, like an invention created based on an idea totally different from prior art, any means for solving the technical issues need not be stated.

(3) In the box for effects, particular effects of the invention for patent protection is sought recognized better compared to those of prior art shall be stated. Where superior effects of the claimed invention are disclosed in a specification, an applicant shall state such effects as far as the applicant knows since such effects can be recognized for confirmation of inventive step of the invention.

3.2.3 Detailed Content for Working Invention

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(1) As for the detailed content for working the invention, at least one detailed content for working the invention shall be stated, if possible, in various ways so that a person skilled in the art can easily figure out how to work the invention.

In order to figure out how the invention is being worked, technical means for solving the issues needs to be stated. Where multiple technical means exist, how these means are connected to generate such superior effects shall be indicated. The detailed technical means itself shall be stated, not the mere function or effect of the means.

(2) The detailed content for working the invention shall contain the composition of the invention as well as its functions. In fact, stating the function based on the technical field might be more appropriate than stating the composition of the invention in detail. For example, in the case of the computer field, stating what functions each technical means holds as well as how these means are connected to solve the technical tasks might be more advantageous.

(3) If necessary, the box for embodiments can be created and embodiments of how the invention can be actualized can be disclosed. As many embodiments as possible shall be stated.

Description of embodiments can be made as in the following manner:

① When the claims are disclosed comprehensively, each representative embodiment corresponding to the comprehensive description shall be stated, except for where a person skilled in the art can figure out the detailed content of the invention based on the description.

② Basic data, etc. shall be disclosed for embodiments and, if necessary, comparative embodiments and applied embodiments and so forth may be stated, too. Comparative embodiments shall be technically closest to the concerned invention and differences between embodiments, comparative embodiments and applied embodiments shall be specified.

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③ Where embodiments are described by using drawings, marks of the corresponding section on the drawings shall be disclosed in brackets after the technical terms.

(4) As for numerical limitation for certain technical means, the ground for limitation shall be disclosed.

Also, where the claimed invention is explained by using experiment data, test methods, test/measurement tools and test conditions shall be disclosed in detail so that a person skilled in the art can easily reproduce the experiment results.

Where materials or devices hard to secure are used to work the invention, the manufacturing process or the source of securement shall be disclosed.

Standard terms or academic terms generally recognized in the technical field shall be used for technical terms. Chemical symbols, mathematical symbols and molecular formulas widely used in the technical field shall be pursued.

(5) In presence of drawings, description of the drawings shall be stated.

3.2.4 Industrial Applicability

Where it is hard to determine whether the claimed invention is industrially available, the method of industrial applicability, manufacturing method or utilization method shall be stated in the box for [Industrial Applicability]. Since industrial applicability can be well inferred from other descriptions of the specification, additional description on industrial applicability may not be necessary.

4. Requirement of Description of Background Art

Form no. 15 (Specification) of the Enforcement Rules of the Patent Act stipulates that applications filed before June 30, 2011 shall disclose the background technology and the information on literature of background art, if possible. However, a ground for rejection is

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not filed even if the background art is not specified.

Article 42(3)(ii) of the Patent Act newly established in accordance with the revision on May 24, 2011 (taken effect on July 1, 2011) states that the detailed description of the invention shall disclose the background art of the invention. If an applicant fails to disclose the background art in the detailed description of the invention, a ground for rejection is notified according to the violation of Article 42(3)(ii) of the Patent Act. The revised Patent Act and its subordinate guidelines on background art shall be applied to application filed after July 1, 2011.

4.1 Meaning of Background Art

Background art of an invention refers to exiting technology deemed beneficial in understanding technological implications of the invention and conducting prior art searches and examination.

4.2 Description Requirement of Background Art

(1) Background art shall be related to an invention for which patent protection is sought.

An invention for which patent protection is sought means an invention specified by the matters disclosed in the claims. Whether background art is related to an invention for which patent protection is sought shall be determined considering the technical field to which the concerned invention pertains, technical problem of the invention, solution to the technical problem and the effect of the invention.

(2) An applicant shall disclose the detailed explanation on the background art in the box [Background Art] of the detailed description of the invention and the information on prior art literature where such background art is disclosed, if possible. The information on prior art literature shall contain the country of publication, the name of gazette, publication number, publication date for patent literature and the name of author, title of publication (title of thesis), publisher, date of publication, etc. for non-patent literature. Basically, the same instructions on citation of prior art literature at a time of notification of ground for

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rejection can be followed (See Part 5, Chapter 3, 「Disclosure of Information on Prior Art Documents」)

However, even if only the information on prior art literature is disclosed, not the detailed explanation on the background art, where the prior art literature describes proper background art of the invention, the background art of the invention shall be deemed to be disclosed.

Where multiple prior art literatures exist, the literature(s) closest to the invention shall be disclosed.

(3) Where the background art cannot be distinguished since the concerned invention is developed based on novel ideas different from existing technology, the description of the background art of the invention can be replaced with the disclosure of existing technology of the closest technical field or the description of difficulty finding proper background art.

4.3 Illegitimate Types of Disclosure of Background

Cases where a ground for rejection is notified based on failure to meet the requirement under Article 42(3)(ⅱ) of the Patent Act are as follows:

4.3.1 Where no background art is written

Where the box[Background Art] and the entire content of the detailed description of the invention only disclose the technical problem of the invention, solution to the technical problem and the effect of the invention, not the background art

4.3.2 Where background art is not related to invention for which patent protection is sought

Where the background art disclosed in the detailed description of the invention is not related to the invention for which patent protection is sought and therefore Article 42(3)(ⅱ) of the Patent Act is violated as in the following cases:

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① Where only background art not related to the invention for which patent protection is sought is disclosed

(Example) Where it is deemed that the claimed invention and the background art are not related considering the technical field to which the concerned invention pertains, technical problem of the invention, solution to the technical problem and so on, like the case where claims disclose "a vacuum cleaner equipped with wet mop", but the box[Background Art] only discloses background art related to a cleaner with detachable wet mop

② Where the background art of an invention only in the detailed description of the invention, not the claims is disclosed

③ Where a divisional application is filed because of the violation of unity of invention and the background art disclosed in the detailed description of the invention of the divisional application is not related to the invention claimed in the claims of the divisional application

4.3.3 Where background art of the invention is not deemed to be disclosed because it constitutes basic technology

Where existing technology such as the technical field of the invention for which patent protection is sought is disclosed as background art, but it merely constitutes basic technology and therefore, cannot be deemed as the background of the invention.

Whether the disclosure of such basic technology is recognized as the disclosure of background art shall be determined based on whether the disclosed technology is beneficial in understanding the invention for which patent protection is sought and conducting prior art searches and examination considering the technical problem of the invention and the technical solution disclosed in the specification
However, in such a case it shall be recognized that the content of the prior art or relevant literature deemed appropriate as background art are well known in the concerned technical field or easily secured to notify the ground for rejection citing the violation of Article 42(3)(ii) of the invention. Where an examiner recognizes the prior art literature disclosing

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proper background art, the examiner may suggest such prior art literature at the time of notification of the ground for rejection.

(Example 1) Where an applicant files an application of 'a noise-reducing suction nozzle of vacuum cleaner' but only discloses the general technical knowledge of vacuum cleaners in the Box[Background Art], if multiple prior arts on 'noise-reducing vacuum cleaner' or 'the structure of suction nozzle of vacuum cleaner' directly related to the technical problem or the technical solution of the invention exist and can be easily searched through conventional search systems, it shall not be deemed to be the disclosure of the invention and therefore, the invention shall be subject to notification of the ground for rejection under Article 42(3)(ii) of the Patent Act.

(Example 2) Where an applicant files an application of 'high-precision hydraulic drilling device', but discloses the general technology related to 'electric motor drilling device', not 'hydraulic drilling device', if the prior art (or laid-open gazette on the application filed by the applicant) on 'hydraulic drilling device' beneficial in understanding the invention, conducting prior art searches and examination can be easily searched through conventional search systems, it shall not be deemed to be the disclosure of the invention and therefore, the invention shall be subject to notification of the ground for rejection under Article 42(3)(ii) of the Patent Act.

(Example 3) Where an applicant files an application of 'electrode grinder for welding machine' and the Box[Background Art] describes the phenomenon of the edge of the electrode becoming rounded when using a common welder and the technical solution of the invention specifies the electrode grinder for welding machine being provided to address the above-mentioned phenomenon, if existing technology related to welder or grinder related to the phenomenon of the edge of the electrode becoming rounded when welding more beneficial in understanding the invention conducting prior art searches and examination cannot be easily searched through conventional search systems, the concerned invention shall not be subject to the notification of the ground for rejection under Article 42(3)(ii) of the Patent Act, despite the fact that common technical knowledge is disclosed in the box[Background Art].

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4.4 Notification of Ground for Rejection in case of Illegitimate Description of Background Art

Where it is deemed that the description of the background art is illegitimate, the examiner shall notify a ground for rejection under Article 42(3)(ⅱ) of the Patent Act.

Whether the requirement of Article 42(3)(ⅱ) of the Patent Act is met shall not be determined uniformly. Rather, the current status of the technical field to which the concerned invention pertains (existence of pioneer invention, etc.), the level of accumulation of existing technology, the level of R&D activities by applicant/inventor in the concerned technical field shall be considered.

The requirement under Article 42(3)(ⅱ) of the Patent Act may constitute a ground for rejection of Article 62 of the Patent Act, but shall not become a ground for furnishing of information concerning Patent Applications (Article 63-2) or a ground for rejection (Article 133(1)).

4.5 Response taken by Applicant to Notification of Ground for Rejection in Violation of Article 42(3)(ⅱ) of the Patent Act

Where a ground for rejection is notified citing the failure of description of background art of the invention, an applicant shall respond to the notification by making an amendment of addition of information on prior art literature disclosing proper background art in the box［Background Art］ or the box［Prior Art Literature］. In such a case, it is deemed appropriate to submit a written opinion indicating that the background art of the invention for which a patent protection is sought is disclosed in the concerned prior art literature.

(Amendment Example 1) Addition of "No. 10-OOOO-OOOOOOO (2002.4.25) of Laid-Open Patent Gazette of Republic of Korea" in Box［Patent Literature］in ［Prior Art Literature］ of ［Background Art］

(Amendment Example 2) Addition of "The prior art of the concerned invention is No.

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10-OOOO-OOOOOOO (2002.4.25) of Laid-Open Patent Gazette of Republic of Korea" in Box ［Background Art］

Where an invention is developed based on novel ideas totally different from existing technology and therefore, no proper background art is found, an applicant may respond to the notification by explaining such intention in a written opinion to the notification of the ground for rejection.

Meanwhile, where an applicant adds the explanation on background art in the detailed description of the invention after receiving a notification of the ground for rejection or makes an amendment of adding the explanation of the background art disclosed in the prior art literature, along with the information on such literature, it shall be noted that such explanation on the background art constitutes the addition of new matters, unless the explanation can be obviously derived from the description from the initially-submitted specification, etc.(See Detailed Determination Process of Prohibition of Addition of New Matter in 1.2, Chapter 2, Part 4)

5. Other Instructions

(1) Where the terms disclosed in a specification are not written in Korean and the description are unclear, an examiner shall give the applicant an opportunity to explain under Article 11(1)(iv) of the Enforcement Rules of the Patent Act and return the application. However, where a part of the specification is written in a foreign language and the content of the application can be well understood except the concerned part, an examiner shall not return the application. Instead, the examiner shall order amendment citing the violation of Article 46 of the Patent Act.

(2) Where an error in translation is found in an application claiming priority under the Treaty filed based on a patent application in a foreign language, only when lack of description is found after determination on lack of determination only with the specification of the application claiming priority under the Treaty, an examiner shall notify a ground for rejection under Article 42(3) or (4) of the Patent Act. Even when an error in translation changed the content of the application filed in a first country or the content of the description in the

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specification is unclear, an examiner shall take note that a reason of rejection cannot be notified on the ground of an error in translation.

In such a case, since the submission of amendments is highly likely to lead to that ① the technical matter disclosed only in the specification of the application in a first country, but not disclosed in the initial specification of the application claiming priority under the Treaty is added, or ② the invention impossible to be worked only with the content of the specification of the application claiming priority under the Treaty has become possible to be worked. Since the addition of new matters is highly likely, an examiner shall examine the application thoroughly.

(3) Where an invention cannot be easily worked since the technical terms used in the detailed specification of the invention are not harmonized, an examiner shall notify a ground for rejection citing the violation of Article 42(3) of the Patent Act. Where the technical terms disclosed in the detailed description of the invention and claims are different, or the technical terms written in the claims are ambiguous, an examiner shall notify a ground for rejection citing the violation of Article 42(4) of the Patent Act.

(4) Where technical terms or academic terms not widely used are not defined in the detailed description of the invention and their definitions are unclear or where the invention cannot be clearly understood since the technical terms which are hard to be understood in Korean are not accompanied with the corresponding Chinese characters or the original language in brackets, an examiner shall notify a ground for rejection citing the violation of Article 42(3) of the Patent Act.

(5) In principle, stating the trademark or name of a product is not allowed in a specification. However, even though the trademark or name of a product is disclosed, where the concerned product can be easily secured; the change in quality or composition of the product with the trademark and name is less likely to change the content of the invention, stating the trademark or name of the product shall be exceptionally allowed.

6. Notification Method of Rejection Ground

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(1) When an examiner intends to notify a ground for rejection citing the violation of the enablement requirement and description requirement of this chapter, any violation of such requirements shall be specified and notified. Especially, where a ground for rejection is to be notified based on the violation of enablement, the corresponding claims shall be specified.

(2) Where the detailed description of the invention is made under Article 21(3) of the Enforcement Rules of the Patent Act, but the description is not clear and detailed enough for the invention disclosed in the claims to be easily worked, an examiner shall notify a ground for rejection only based on Article 42(3) of the Patent Act.

(3) Where the detailed description of the invention does not satisfy both the enablement requirement and the description requirement, an examiner shall notify a ground for rejection based on Article 42(3) of the Patent Act and Article 21(3) of the Enforcement Rules of the Patent Act.

Meanwhile, where the description requirement under Article 23(3) of the Enforcement Rules of the Patent Act is violated, but all of the inventions disclosed in the claims can be easily worked only with the detailed description of the invention, the description shall be deemed to be legitimate.

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Chapter 4. Claims

1. Relevant Provisions

Article 42 of the Patent Act (Patent Application) ①~③ Omitted

④ The claims under paragraph(2)4 shall describe the matter for which protection is sought in one or more claims (hereinafter referred to as "claims") and the claims shall fall under any of the following subparagraphs:

1. The claims shall be supported by detailed description of the invention;
2. The claims shall define the invention clearly and concisely;
3. *Deleted.*

⑤ When filing a patent application, any patent application may attach the specification not stating the claims under paragraph (2)4 to the patent application, notwithstanding paragraph (2). In such cases, the specification shall be amended so as to state the claims within the period classified under the following subparagraphs:

1. Until one and half years since the day falling under any subparagraph of Article 64(1);
2. Until three months since the day of receiving the notification of the purport of a request of examination of patent application under the provisions of Article 60(3) within the period set forth in subparagraph 1 (until one and a half years since the day falling under any subparagraph of Article 64(1), if such notification was received after one year and three months from the day falling under any subparagraph of the same paragraph).

⑥ The claims under paragraph (2)4 shall state such matters regarded necessary to specify an invention as structures, methods, functions and materials or combination thereof to clarify what to be protected.

⑦ Where a patent applicant fails to amend the specification until the period set forth in each subparagraph of paragraph (5) after filing an application, the application concerned

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shall be deemed withdrawn on the day after the period expires.

⑧ Details concerning how to enter the claims under paragraph (2)4 shall be prescribed by Presidential Decree.

⑨ Omitted.

Article 5 of the Enforcement Decree of the Patent Act (Descriptive Method of Scope of Patent Claim)

① When the claim (hereinafter referred to as "claim") within the scope of the patent claim provided for in Article 42(8) of the Act is to be entered, the independent claim (hereinafter referred to as "independence") shall be entered and the dependent claim (hereinafter referred to as "dependence") that substantiates the independence by limiting or adding to it may be entered. In such cases, if it is deemed necessary, other dependence that shapes up the dependence by limiting or adding to it may be entered.

② The claim shall be entered, one or more paragraphs from among independence or other dependence shall be quoted and the number of paragraphs quoted shall be entered.

③ *Deleted.*

④ The number of a claim which depends upon another claim shall be entered.

⑤ The claim that quotes not less than two claims shall mention alternatively the numbers of the quoted claims.

⑥ In the claim that quotes not less than two claims, the quoted claim shall be prohibited from quoting two or more other claims again. The same shall apply to the formula by which in the claim that quotes not less than two claims, the quoted claim quotes one claim that results in quoting not less than two claims after quoting one claim again.

⑦ The claim that is quoted shall be entered ahead of the claim that quotes other claim.

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⑧ Each claim shall be entered after changing the line of each paragraph and the serial number in the Arabic figure shall be given in the order of the entries.

2. Recognition of Invention

Description of claims holds significance in that the scope of protection of a patent right is determined based on the description. Where claims does not meet the description requirement, the right of a third party can be unfairly limited due to the patent right. A patent holder, too, can face disadvantages such as invalidation of a patent right or unnecessary limitation on the scope of protection of a patent right. Therefore, when examining the description requirement of the claims, an examiner shall be mindful of the description.

Items disclosed as claims are those that an applicant selects among the inventions disclosed in the detailed description of the invention and discloses as items for which patent protection is sought at his/her will according to the description method of the claims under Article 42(4) and (8) of the Patent Act. Therefore, the recognition of the invention for which patent protection is sought shall be made based on the description disclosed in each of the claims in consideration of the content of the claims selected at the applicant's will. The detailed description of the invention or description in drawings shall be referred to only when the description of claims is unclear or the definition and content of the technical terms are ambiguous. The invention disclosed in claims cannot be recognized based on the content of the detailed description of the invention out of the description of the claims.

Also, since an abstract is used for technical information, it cannot be used to decide the protection scope of the invention.

3. Claims Supported by Detailed Description of Invention

The detailed description of the invention serves as a written technical disclosure. When an invention not disclosed in the detailed description of the invention is stated as claims and is

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granted a patent, it would lead to the invention not disclosed in the detailed description of the invention being unfairly granted a patent right. To avoid it, Article 42(4)(i) of the Patent Act specifies that the claims shall be supported by detailed description of the invention.

Under Article 42(2) of the Patent Act, the detailed description of the invention refers to the rest of the descriptions other than the title of the invention, brief explanation of drawings (if the explanation on marks is disclosed, it shall be included) as well as the claims among the items disclosed in the specification attached to the patent application submitted by the applicant.

(1) An examiner shall determine whether an invention disclosed in claims are supported by the detailed description of the invention based on whether a person skilled in the technical filed to which the invention pertains can figure out the matters corresponding to the invention disclosed in the claims are written in the detailed description of the invention.

Whether the corresponding matters are disclosed in the detailed description of the invention shall be determined by reviewing whether an invention out of the scope grasped by a person skilled in the concerned technical field based on the detailed description of the invention is claimed in claims, considering the purport of Article 42(4)(i) of the Patent Act rather than literal identicalness between the claims and detailed description of the invention.

(2) Cases where an invention disclosed in claims is not supported by the detailed description of the invention include the followings:

① Where the items corresponding to those in claims are neither disclosed nor implied in the detailed description of the invention

(Example 1) Where specific numerical limitation is disclosed in claims, but such numbers are not disclosed in the detailed description of the invention

(Example 2) Where claims only disclose an invention using an ultrasonic motor, but the detailed description of the invention does not disclose the invention using the ultrasonic motor, but only discloses an invention using a direct current motor

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However, where the detailed description of the invention discloses the direct current motor as the embodiment, but there exists the description that other motors other than direct current motors can be used and where working the invention using an ultrasonic motor is possible based on the level of technology at the time of application filing, the claims shall be deemed to be supported by the detailed description of the invention.

② Where the terms are not harmonized in the detailed description of the invention and the invention disclosed in the claims so that the correspondence between the detailed description of the invention and the claims is ambiguous

③ Where the items disclosed in claims are means or steps to perform particular functions, but specific composition corresponding to such means or steps is not disclosed in the detailed description of the invention

④ Where the content disclosed in the detailed description of the invention cannot be extended or generalized to the scope of the claimed invention based on the level of technology of the concerned technical field at the time of application filing

(Example 1) For example, where an invention is to be specified by the scope of energy efficiency to be achieved, but the detailed description only discloses the embodiment by specific means and it is deemed that the suggested embodiment cannot be extended or generalized to the entire scope of energy efficiency of the claimed invention even with the level of technology of the technical filed at the time of application filing.

(Example 2) Where claims disclose particular medicine with chemical compounds defined by preferred quality as effective properties, but the detailed description of the invention discloses that only part of the particular medicine included in the claims is confirmed to be effective as the concerned medicine and the effectiveness of the chemical compounds included in the claims cannot be recognized even based on the ordinary knowledge of the technical field at the time of application filing

(Example 3) Claim 1 describes the composition as 'selective inhibitor of collagenase-3' and

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based on definition of the term disclosed in the specification, the 'selective inhibitor of collagenase-3' refers to 'a chemical having selectiveness on collagenase-3 enzyme activation suppression more than 100 times than collagrnase-1 enzyme and having potency of less than 100nM defined by the result of the IC50 according to the fluorescence analysis method of MMP-13/MMP-1. The term is interpreted to refer to 16 compositions listed in the detailed description of the invention as well as all the chemical materials meeting the above-mentioned requirement. However, the detailed description of the invention only discloses the content on effectiveness of two out of the 16 compositions in treatment and prevention of ostarthritis and the experiment outcomes of their pharmacological effect since such compositions have selective suppression activation on collagenase-3 and substantially inhibits the activation of collagenase on joints. Also, there is no disclosure on the pharmacological effect of the remaining 14 compositions or numerous chemical materials whose chemical structure belonging to the above-defined 'selective inhibitor of collagenase-3' cannot be specified, as well as no available document of forecasting such chemical materials to have identical clinical correlation with the two compositions based on the level of technology as of filing. In such a case, claim 1 is not supported by the detailed description of the invention. (Supreme Court Ruling. Case No. 2004 Hu 1120)

⑤ Where claims do not recite the features explained as indispensable features to solve the technical problem in the detailed description of the invention and therefore, it is deemed that the claims claim an invention which a person skilled in the art cannot recognize from the detailed description of the invention

(Example) Where the detailed description of the invention describes the composition and effect of rice cake by allowing only 'cream which does not cause moisture transition from rice cake (dough) due to its lower water content than that of rice cake (dough)' as the stuffing, but claims state the stuffing as just 'cream' which is deemed as fatty substance separated from milk regardless of water content (Supreme Court Ruling. Case No. 2003 Hu 496)

(3) As for the relation between Article 42(4)(i) and Article 42(3)(i), Part 2 Chapter 3 「2.4 Relation with Lack of Description on Claims」 shall be referred to.

4. Clear and Concise Statement of Invention

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When a patent right is granted to an invention whose description in claims is unclear or concise, a parent application cannot serve its role as the abstract of title which determines the scope of protection of the claimed invention because of the unclear protection scope of the invention. Also, the determination of patentability cannot be conducted. Therefore, Article 42(4)(ⅱ) of the Patent Act can be deemed to be a provision to prevent such issues..

(1) In principle, whether the claimed invention is disclosed clearly and concisely shall be determined by a person skilled in the technical field to which the invention pertains based on the description of the claims with consideration of the detailed description of the invention or the description of drawings as well as the level of technology at the time of application filing. It cannot be determined except for the description of the claims.

(2) That an invention shall be concisely disclosed does not mean that the definition of the invention shall be concise. It means that the description itself in the claims shall be concise.

(3) Cases where an invention is not disclosed clearly and concisely are as follows:

① Where the description of claims are unclear. However, where the unclear part is a mere error in the description and the error does not lead a person skilled in the technical field to which the invention pertains to decide that the invention is unclear or the invention can be easily understood based on the detailed description of the invention, drawings or the level of technology at the time of application filing, the invention shall not be deemed to be unclear.

② Where each composition consisting of the invention is merely sequenced, but the connection between the compositions is not disclosed and therefore, the invention is unclear

③ Where the category to which the claimed invention belongs is unclear

④ Where the description of claims is too lengthy, such as the repetition of the same description and so that the description to which patent protection is sought is not clear and

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concise

⑤ Where claims include the unclear expression about the composition of the invention. However, even with the use of such unclear expression, where the meaning is clearly supported by the detailed description of the invention and the invention is deemed to be clearly specified, the invention shall not be deemed to be unclear.

(Example 1) Where arbitrary additional items or selective items are disclosed along with expressions such as 'at one's will', 'if necessary', 'in particular', 'for example', 'and/or'

⇒ 'Invention A and/or Invention B' refers to both 'Invention A and Invention B' and 'Invention A or Invention B'. Therefore, both cases shall be determined for the violation of Article 42(4)(ⅰ)(ⅱ) of the Patent Act. In such a case, it shall be determined whether the description of 「and/or」 may lead to multiple contrasting inventions are claimed in a single claim(whether proper number of claims are disclosed according to the characteristics of the invention).

(Example 2) Where unclear expressions of comparison or degree are used such as 'mainly', 'as main process', 'appropriate', 'proper amount of', 'many', 'high', ' most of', 'almost', 'approximately', 'about'

(Example 3) Where unclear expressions of negation are used such as 'except for', 'other than'

(Example 4) As for an invention defined by numerical limitation, where numerical limitation without maximum or minimum description such as 'more than', 'less than', '0~10' or numerical limitation including 0(excluded when the composition including 0 is an arbitrary composition, not necessary composition) is disclosed. Or, where dual numerical limitations are disclosed within a single claim such as '120-200℃ or more appropriately 150-180℃'

⇒In this context, 'arbitrary composition' refers to the one that is additionally added or is deemed not to be added based on the applicant's need and the one whose intention is clearly disclosed in a specification

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⑥ Where the subject of indication is unclear and thus the composition of the invention is unclear
(Example) Where many different types of gears are disclosed in claims and, when specifying particular gears among them, the subject as 'said spur gear', 'electronic bevel gear' is used and instead, the subjects are unclearly specified such as 'said gear', 'electronic gear'

⑦ Where the composition of the invention to which patent protection is sought is unclear since multiple technical terms of the same expression serving different functions in claims are disclosed by specifying different functions or the clear description of the marks used in drawings is not disclosed

⑧ Where an invention is not clear and concise since items irrelevant of the technical composition of the invention such as commercial benefits, regions of sale, places of sale, etc.

⑨ Where the detailed description of the invention or description of drawings is substituted without disclosing the composition of the invention. However, where using the detailed description of the invention or description of drawings is necessary, description by such substitution shall be allowed.

(Example) As for an invention related to alloys, where the special relation between alloy elements cannot be clearly described only with numerical figures or sentences, drawings can be used for description, like "heat resisting alloy comprising Fe·Cr·Al within the scope surrounding Dot A(…), Dot B(…), Dot C(…), Dot D(…) of the attached Drawing no.1".

(4) As for Case ⑥ above, even though the subject is not literally identical, if it constitutes a clerical error and a person skilled in the art can understand the composition of the invention and reproduce the invention, it shall be deemed as legitimate description under Article 42(4)(ⅱ) of the Patent Act (2002 Huh 6251, 2011 Huh 7263)

The followings are cases of clerical errors and therefore, are not deemed to be in violation of Article 42(4)(ⅱ) of the Patent Act:

ⅰ) Where claims disclose "above-mentioned OOO" and the first part of the concerned claim

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or cited claim does not disclose 'OOO' at all, but the invention is clearly understood if interpreted excluding "the above-mentioned" based on the detailed description of the invention and drawing(s)

(Example 1) Where a claim states "consisting of the above-mentioned regulator(10) and **the above-mentioned added resistance(R6)(90)** in series in order for reference voltage to remain unchanged despite the voltage fluctuation of power supply energized through input terminal of the above-mentioned regulator (10)" and the first part of the claim on "the above-mentioned added resistance(R6)(90)" does not state "added resistance(R6)(90)" at all. However, if the claimed invention is clearly understood when interpreted excluding "the above-mentioned" based on the content of the detailed description of the invention of "consisting of the above-mentioned regulator (10) and an added resistance (R6)(90) in series in order for reference voltage to remain unchanged, "the above-mentioned" can be deemed as clerical error and therefore, it does not constitute the violation of Article 42(4)(ⅱ) of the Patent Act. (2010 Won 8839)

☞ However, where a claim discloses "the above-mentioned OOO", but the first part of the concerned claims or cited claim does not disclose "OOO" at all and it is uncertain whether either "the above-mentioned" is incorrectly written or the number of the cited claim is incorrectly entered, it shall not constitute the case above, but rather be deemed as an un unclear statement in violation of Article 42(4)(ⅱ) of the Patent Act. For example, where claim 8 discloses "as in claim 1, ... the above-mentioned subfield not doubled ...", but "subfield not doubled" is not disclosed in the first part of claim 8 or claim 1, but is disclosed in claim 6 and it is not certain whether either the claim number (claim 1) dependent upon claim 8 is incorrectly put or "the above-mentioned" from "the above-mentioned subfield not doubled" is incorrectly entered, it shall constitute the ground for rejection, in violation of Article 42(4)(ⅱ) of the Patent Act.

ⅱ) Where the indicated phrase and the phrase are not exactly identical, but they are deemed to correspond to each other based on the meanings
(Example) a claim states "between the two nodes in the telecommunication system, the second node contains the step of providing the information related to traffic condition containing cell-loading to the first node out of the above-mentioned two nodes,... the

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above-mentioned node value is based on the above-mentioned transmitted information and the mapping information. When only the "information" out of "above-mentioned transmitted information" is determined as "information related to traffic condition containing the cell-loading" and the phrase "transmitted" is not disclosed in the first part of the claim, but it can be certain that "the second node providing the information related to traffic condition containing cell-loading to the first node" can be interpreted as transmitting the information based on the detailed description of the invention. Therefore, "the above-mentioned transmitted information" shall not be in violation of Article 42(4)(ii) of the Patent Act. (2010 Won 9258)

iii) Where some of the referred-to claims are deleted, but the claimed invention is clearly understood when interpreted excluding the deleted claim(s).

(Example) Claim 10 discloses "as for one of claims 1 to 9, ...". Even if claim 3 is deleted, claim 10 can be interpreted to depend upon one of claim 1, claim 2, and claims 4 to 9 and therefore the claimed invention is clearly understood. Therefore, claim 10 shall not be deemed to be in violation of Article 42(4)(ii) of the Patent Act. (2010 Won 4920)

☞ However, where all of the referred-to claims are deleted, it shall be deemed to be in violation of Article 42(4)(ii) of the Patent Act since which claim is referred to cannot be known and the claimed invention cannot be clearly understood. For example, claim 3 states "as for claim 1, ...". If claim 1 is deleted, claim 3 is in violation of Article 42(4)(ii) of the Patent Act. In another example, claim 5 states "as for one of claims 1 to 3, ...". If claims 1 to 3 are all deleted, claim 5 is in violation of Article 42(4)(ii) of the Patent Act.

As shown above in i),ii), and iii), such statements are deemed to be clerical errors and therefore, the examiner shall not deliver the decision of rejection citing the violation of Article 42(4)(ii) of the Patent Act. Where such statement exists during the examination phase, the examiner shall make a decision to grant a patent by making an ex officio amendment if no other ground for rejection exists. (See Part 5, Chapter 5, 「3. Instructions of Amendment *Ex officio*」. If any other ground for rejection exists, the examiner shall recommend an amendment by indicating such ground as 'Matters to be noted' at the time of notifying the submission of opinion.

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However, where it is unclear that a claim falls under any of the above-mentioned three cases, it would be desirable for the examiner to notify the applicant of such facts and deliver the notification of the ground for rejection, rather than *ex officio* amendment or 'Matters to be noted', to give the applicant the opportunity to submit a written opinion or amendment. However, where the concerned claim is deemed to fall under one of the above-mentioned three cases after re-examining the application considering the submitted written opinion or amendment in response to the ground for rejection, the examiner shall not deliver a decision to reject the application and rather make an ex-officio amendment (if no other ground for rejection exists.)

Also, as for determining on rejecting an amendment (whether a new ground for rejection is created) under Article 51, even when matter constituting one of the three cases is newly created because of the amendment, the examiner shall not reject the amendment since the concerned matter is not deemed to be a new ground for rejection.

(5) Where more than two technical matters holding similar characteristics or functions, they can be disclosed in a single claim such as a Markush type claim.

Where the description of Markush type claims is related to chemical substances, such matters can be deemed to hold similar characteristics or functions if the following requirements are all met:

① All the matters shall hold the common characteristics or vitality
② All the matters shall share the important chemical structure, or all the matters shall belong to the group of chemical substances deemed as one group in the technical field to which the invention pertains

In this context, "all the matters shall share the important chemical structure" refers to the cases where multiple chemical substances feature the common chemical structure prominent in the most of the chemical structure, or even multiple chemical substances share only a small part of the chemical structure, where the shared chemical structure comprises a significant part in terms of structure. Also, 'the group of chemical substances deemed as one group' means the group of the chemical substances expected based on the knowledge of

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the technical field that each of the group of chemical substances disclosed as the subject matter is to be identically worked in the claimed invention. In order words, it refers to the case where the same result is expected whichever is chosen among the chemical substances among the group.

(5) Where claims include functional expressions describing the function or effect of an invention, but if the composition of the invention is not deemed to be clear even with such descriptions, the claims cannot be allowed(refer to Supreme Court Case No. 97 Hu 1344, October 18, 1998). In this context, cases where the composition of the invention is deemed to be clear even with functional expressions refers to ① where expressing claims functionally is necessary since the technical idea of the invention cannot be clearly disclosed only with the existing technical composition (There are cases where the claims cannot be expressed only with the detailed description of the composition due to the characteristics of the technical field to which the concerned invention pertains such as BM invention or computer-related invention, etc.), ② where the meaning of the functional expressions are clearly specified by the description of the detailed description of the invention and description in drawings(refer to Patent Court Case No. 2005 Hu 7354).

Where claims include functional expressions, the examiner shall determine whether the subject matter for which patent protection is sought is clearly understood from a perspective of a person skilled in the technical field to which the invention pertains considering the detailed description of the invention or the description in drawings and the level of technology at the time of application filing. If deemed otherwise, the examiner shall notify a ground for rejection citing the violation of Article 42(4)(ⅱ) of the Patent Act(refer to Supreme Court Case No. 2005 Hu 1486, September 6, 2007).

(6) The method of writing claims related to a product in ways of "a product manufactured by the method of", "a product manufactured with the apparatus of" shall be exceptionally recognized only when the composition of a product for which patent protection is sought cannot be properly disclosed (new matters, ingredients, food, etc.). Such claims shall be allowed to filed as one application of claims disclosing a method, apparatus and product and a group of inventions.

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Although the composition of a product filed in the above-mentioned format, where the invention is recognized to be unclear because of the failure in the composition of the product, an examiner shall notify a ground for rejection citing the violation of Article 42(4)(ⅱ) of the Patent Act.

(7) A parameter invention refers to the one created with part of the composition of the invention after an examiner arbitrarily creates a parameter on physical·chemical figure which is not the standard or prevalently used in the concerned technical field or creates a parameter in operation expression by using the correlation among multiple variables. Since the technical composition of a parameter invention having the figure that the parameter represents cannot be clearly understood only with the description, the invention shall be deemed not to be described clearly and concisely except for ① where the definition or technical meaning of parameter is clearly understood, ② where a ground for failure in the use of the concerned parameter is clearly shown, and ③ where the relation with the level of technology at the time of application filing is understood, considering the detailed description of the invention or drawing as well as the level of technology.

In order for the ground for failure in the use of the parameter to be clearly shown, the cause and effect relationship between the parameter and effect as well as the relation between the technical problem and the parameter as its solution shall be clearly understood through comparative examples of the satisfactory cases as well as the unsatisfactory case of the parameter. Also, for the relation between the parameter and the level of technology at the time of application filing to be understood, the detailed description of the invention shall include examples of comparative experiments of materials holding similar structure or effect or logical explanation so that it shall be clearly understood that such materials are not included to the claimed invention.

Although the technical meaning of the parameter, the reason why the concerned parameter cannot be used and the relation with the level of technology at the time of application filing are not explicitly disclosed in the detailed description of the invention or drawings, but if they can be clearly understood with consideration of the level of technology at the time of application filing, an examiner shall not consider the concerned invention as unclear only based on such grounds.

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5. Description of matters deemed necessary for Specification of Invention

Article 42(6) of the Patent Act stipulates that the claims under paragraph (2)4 shall state such matters regarded necessary to specify an invention as structures, methods, functions and materials or combination thereof to clarify what to be protected. As technology diversifies, describing the invention through the effect or operation method of an apparatus, rather than its physical structure or detailed means of the product(device) invention, would be desirable. Therefore, if an invention can be clearly specified, it shall be noted that the invention can be freely disclosed at an applicant's choice.

(Note) The above-mentioned provision does not provide the ground for rejection or invalidation of a patent right. Therefore, an examiner shall not notify a ground for rejection or make a decision of rejection based on the provision.

6. Claim Drafting Requirements

The way of describing the claims disclosed in a specification is defined by the law to make sure that it serves as an abstract of title which determines the claims of the claimed invention. Especially, the Korean Patent Act adopts the system of multiple claims under which one or more than two claims describing the matters for which patent protection is sought can be described. Article 5 of the Enforcement Decree of the Patent Act clearly prescribes the claim drafting requirements under the system of multiple claims.

6.1 Discrimination Criteria of Independent Claim and Dependent Claim

Claims disclosed in the claims (hereinafter referred to as "claims") are divided into independent patent claims(hereinafter referred to as "independent claims") and dependent patent claims(hereinafter referred to as "dependent claims") limiting, adding to or specifying independent claims.

In this context, 'limiting, adding to or specifying independent claims' means to

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substantiating an invention by adding the technical matter or limiting the upper concept with the lower concept. Dependent claims refer to those whose content of the invention is dependent on other claims and when the content of other claims changes the content of the concerned dependent claims changes accordingly.

In terms of the content of the invention, although a claim does not add to or limit an independent claim, if the claim does not depend on the independent claim in formalities, the claim cannot be considered as dependent claim. Even if a claim depends on an independent claim in formalities, where the claim does not limit or add to the independent claim (for example: in Claim O, a product with the composition of A substituted with B), the claim cannot be considered as dependent claim.

(Note) Article 5(1) of the Enforcement Decree of the Patent Act states that the claim that substantiates the independence by limiting or adding to it may be entered as the dependence. However, it does not necessarily mean than that claims substantiated by way of limiting or adding to independent claims shall be described in the form of dependence. Therefore, claims substantiated by way of limiting or adding to independent claims, too, can be described in the form of dependence.

6.2 Article 5(1) of the Enforcement Decree of the Patent Act

(1) Independent claims shall be entered without depending on other claims in the form of independence. However, even independent claims can be entered without depending on other claims within the scope in which the invention can be clearly understood to avoid the redundant description of the same matter.

(Example 1) A product of … manufactured by the method of claim O
(Example 2) A method of … manufacturing a product of claim O by …
(Example 3) A method of … by using a product manufactured by the method of claim O
(Example 4) A product manufactured with the device of claim O

(2) Dependent claims shall be entered by referring to independent claims or other dependent claims. Dependent claims shall all include the characteristics of the claims

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referred to.

(Example 1) A product of..., in terms of ...in claim O
(Example 2) A method characterized with ... in a method of ... of claim O or claim O

Claims in the following cases shall be treated as independent claims, not dependent claims.

① Where claims are entered in the form of decreasing the subject matter of the claims referred to
② Where the subject matter disclosed in the claims referred to is entered in the form of substituted with other matter

(Example)
〔Claim 1〕 A power transfer unit with the structure of ... equipped with a gear electric motor
〔Claim 2〕 A power transfer unit equipped with a belt conveyor, instead of a gear electric motor, in claim 1

(3) Article 5(1) of the Enforcement Decree of the Patent Act stipulates that where the claim within the scope of the patent claim provided for in Article 42(8) of the Act,....the dependent claim ... may be entered. Therefore, a ground for rejection shall not be notified based on this provision.

6.3 Article 5(2) of the Enforcement Decree of the Patent Act

(1) The claim shall be entered in a proper number according to the nature of the invention. This provision shall be separately treated from Scope of Patent Application of Article 45 of the Patent Act.

Cases where the claims are not entered in a proper number include ① where more than two inventions from different categories are disclosed in one claim, ② where the claimed matter is more than two, ③ where the same claim is disclosed redundantly(referring to the case of the identicalness of claims in terms of wording and different expressions with technically identical meaning shall be exempt), ④ multiple claims care referred to many times within a

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single claim, etc.

(Example 1) Where more than two subject matter is disclosed in one claim: A high molecular compound of … and a contact lens using the high molecular compound

(Example 2) Where more than two claims are referred to in a single claim and then multiple claims are referred to within the claims that are already referred to: for example, it can be 「A product of claim O or claim O manufactured by the method of claim O or claim O」. Such case shall be exempt because it could lead to confusion like the case where a dependent claim referring to more than two claims is dependent upon another claim referring to more than two claims.

6.4 Article 5(4) of the Enforcement Decree of the Patent Act

A claim dependent upon other claims shall contain the number of the claims cited and the number of the claims quoted shall be entered in the following manner:

(Example 1) A method of … in claim O
(Example 2) A device of … in any from claim O to claim O

(Note) Article 5(4) of the revised Enforcement Decree of the Patent Act (Presidential Decree No, 24645, promulgated on June 28, 2013), applicable to not only dependent claims but also all claims citing other claims, shall be applied to all applications examined after July 1, 2013.

6.5 Article 5(5) of the Enforcement Decree of the Patent Act

As for a claim dependent upon more than two claims, the claims referred to shall be numbered so that one claim can be chosen.

① Where the claims referred to are disclosed alternatively

(Example 1) A device of … in either claim 1 or claim 2

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(Example 2) A device of ... in any from claims 1 to 3
(Example 3) A device of ... in any from claim 1, claim 2 or claim 3
(Example 4) A device of ... in claim 1, claim 2 or claim 3
(Example 5) A device of ... in any of claims 1 to 7 and claims 9-11
(Example 6) A device of ... in any of claim 1, claim 2 and claims 4 to 7

In the above-mentioned examples, the numeric number of the claims referred to shall be deemed to be alternatively listed based on the fact that 'in any of claim...' limits all of the claims listed before and after the conjunction 'and'. Where claims are listed with the conjunctive word 'or' instead of 'and', the claims listed before and after 'or' are deemed to be limited. Therefore, the numeric number of the claims referred to shall be recognized to be disclosed alternatively.

② Where the claims referred to are not disclosed alternatively
(Example 1) A device of ... in claim 1 or claim 2
(Example 2) A device of ... in claim 1 and claim2 or claim 3
(Example 3) A device of ... in any of claim 1 and claim 2 or claim 3
(Example 4) A device of ... in claims 1, 2

6.6 Article 5(6) of the Enforcement Decree of the Patent Act

Claims dependent upon more than two claims cannot refer to other claims referring to more than two claims. The intention of this provision is to prevent difficulties of having to refer to other multiple claims in interpreting a single claim.

① Where a claim dependent upon more than two claims refers to another claim dependent upon more than two claims

(Example) Claim 4 dependent upon more than two claims refers to another claim (Claim 3) dependent upon more than two claims. Therefore, the claim violates the description method of scope of claim.

[Claim 1] A device of ...

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〔Claim 2〕 A device of … in claim 1
〔Claim 3〕 A device of … in claim 1 or claim 2
〔Claim 4〕 A device of … in claim 2 or claim 3

② Where a claim referred to in the claim dependent upon more than two claims refers to another claim and therefore, the claim turns out to be dependent upon more than two claims

(Example) Claim 5 dependent upon more than two claims refers to claim 4 dependent upon claim 3 referring to more than two claims. Therefore, the claim violates the description method of scope of claim.

〔Claim 1〕 A device of …
〔Claim 2〕 A device of … in claim 1
〔Claim 3〕 A device of … in claim 1 or claim 2
〔Claim 4〕 A device of … in claim 3
〔Claim 5〕 A device of … in claim 2 or claim 4
〔Claim 6〕 A device of … in claim 5

In the above-mentioned case, even if claim 4 is dependent upon claim 3, since claim 3 depends upon more than two claims, technically it is the same case with referring to more than two claims. Therefore, an examiner shall notify a ground for rejection on claim 5 citing the violation of Article 42(8) of the Patent Act.

Meanwhile, Article 5(6) of the Enforcement Decree of the Patent Act defines 'claims dependent upon more than two claims' and it shall be noted that this provision cannot be applied to claims dependent upon only one claim. As in the example above, claim 6 is dependent upon claim 5 which is the violation of Article 5(6) of the Enforcement Decree of the Patent Act and therefore, technically it leads to difficulties in interpretation of claims since other multiple claims shall be referred to. However, since claim 6 is not dependent upon more than two claims, it shall not constitute the violation of Article 5(6) of the Enforcement Decree of the Patent Act.

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6.7 Article 5(7) of the Enforcement Decree of the Patent Act

Where claims disclosed in the claims refer to the claim with the same numeric number as the claim itself, an examiner shall notify a ground for rejection citing that the failure of disclosing the claim referred to first violates Article 42(8) of the Patent Act and Article 5(7) of the Enforcement Decree of the Patent Act or a ground for rejection citing the unclear description of claims under Article 42(4)(ii) of the Patent Act.

Even when claims disclosed in the claims are dependent upon the claim with the same numeric number as the claim itself, the claims referred to shall not be stated first.

6.8 Article 5(8) of the Enforcement Decree of the Patent Act

Each claim shall be stated in a new line and the claims shall be numbered in sequence.

Where stating claims in number sequences is beneficial in understanding the invention, claims can be stated in the following example.

(Example) [Claim 1] A method of processing metallic materials conducted in the following procedures

(A) The first procedure of heating metallic materials at 800-850℃
(B) The second procedure of forging the heated metallic materials
(C) The third procedure of re-heating the forged materials at 600℃
(D) The fourth procedure of quenching the re-heated materials

7. System for Grace Period of Submission of Claims

(1) An applicant may attach a specification which did not disclose the claims at the time of application filing to a patent application. This system is designed to promote the protection of rights of a patent applicant by enabling the speedy application filing without drawing up the claims and providing enough time to effectively state the claims after thorough reviews

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of patent utilization strategies. However, the claims shall be disclosed for the convenience of examination and technology utilization by a third party. Therefore, it is stated that the claims shall be disclosed through amendments by a certain point of time (until three months have elapsed from the date of notification of intention of a request for examination or until 18 months have elapsed from the date of priority claim, etc.).

(2) Where an applicant who has attached a specification which did not disclose the claims at the time of application filing to a patent application fails to make amendments of stating the claims within the following limited periods, the concerned patent application shall be deemed to be withdrawn on the following day of the date of expiration of the periods.

① Until one year and six months have elapsed from the filing date (the earliest filing date in case of priority claim)

② Until 3 months have elapsed from the date of notification of the intention of a request for examination by a third party within the period mentioned in ① above (when the notification is made after one year and three months have elapsed from the filing date(the earliest filing date in case of priority claim), until one year and six months have elapsed from the filing date(the earliest filing date in case of priority claim))

(3) An applicant can make a request for examination as long as a specification disclosing the claims is submitted. Where an application makes a request for examination on the application attached with the specification which does not disclose the claims, an examiner shall give an opportunity of explanation on the written request and return it to the applicant.

(4) An application attached with a specification which does not disclose the claims shall be exempt from the subject of disclosure since it shall be deemed to be withdrawn on the following day of the date when one year and six months have elapsed from the filing date(the earliest filing date in case of priority claim).

Meanwhile, where a written request for early disclosure is submitted before an application attached with a specification which does not disclose the claims is deemed to be withdrawn, an examiner shall give an opportunity of explanation and return it to the applicant.

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(5) In principle, a specification which does not disclose the claims can be attached to a divisional application, converted application or an application filed by the lawful holder of a right. However, where an amendment of disclosing the claims is not made until one year and six months have elapsed from the original filing date(the earliest filing date in case of priority claim), it shall be noted that the concerned application is deemed to be withdrawn on the following date of the expiration of the period.

Meanwhile, where one year and six months have already elapsed from the original filing date(the earliest filing date in case of priority claim) when a divisional application, converted application or an application filed by the lawful holder of a right is filed, an examiner shall give an opportunity of explanation on the application and return it to the applicant.

(6) Whether the claims is disclosed under the system for grace period of submission of claims shall be determined based on whether the item of 'Patent Claims' in the specification under the Annexed Form no. 15 of the Enforcement Rules of the Patent Act is deleted or not. In other words, where the item of 'Patent Claims' is disclosed, even if any disclosure(for example, blanks, dots, commas, etc.) is included, the claims is not deemed to be in use of the system for grace period of submission of claims.

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Chapter 5. Unity of Invention

1. Relevant Provisions

Article 45 of the Patent Act (Scope of One Patent Application) ① A patent application shall related to one invention only: Provided, That a group of inventions so linked as to form a single general inventive concept may be the subject of one patent application.
② The requirements for one patent application under paragraph (1) shall be prescribed by Presidential Decree

Article 6 of the Enforcement Decree of the Patent Act (Requirements for Single Patent Application for Group of Inventions) A single patent application for a group of inventions as prescribed in the provision to Article 45(1) of the Act shall meet the following requirements:

1. The inventions described in the application shall have mutual relationship in adopted technology; and
2. The inventions described in the application shall have the same or corresponding technological features. In such cases, the technological features shall be improved in respect of the inventions at large when compared with prior arts.

2. Purpose of System

The provision of Article 45 of the Patent Act on scope of one patent application intends to promote the convenience for applicants, third parties and the Korean Intellectual Property Office by allowing applicants to file a single application on inventions closely related in terms of technology.

For applicants, it would be beneficial in terms of lower patent fees and patent right management if as many inventions as possible can be filed in one patent application. However, filing one invention in one application would be more convenient for third parties considering the fairness of application procedures, observation on patent rights and use of

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applications as prior art. Meanwhile, the Korean Intellectual Property Office would prefer the narrower scope of one patent application in examination practices such as classification and prior art search. Therefore, this provision can be considered to have been introduced to make a balance on the interests of applicants who prefer including multiple inventions in one application as well as third parties and the Korean Intellectual Property Office who would get disadvantaged if filing multiple inventions in one application is allowed.

3. General Consideration

(1) Whether inventions fall to「a group of inventions so linked as to form a single general inventive concept(hereinafter referred to as 'unity of invention')」under Article 45(1) of the Patent Act shall be determined based on technical correlation of the inventions disclosed in each claim since Article 6 of the Enforcement Decree of the same act stipulates that the inventions described in the application shall have the same or corresponding technological features.「The special technical features」refer to the improved features in respect of the inventions at large when compared with prior arts.

In this context, special technical features of the inventions do not need exactly the same. For example, if the special technical feature of elasticity in one claim is a spring, the special technical features of elasticity in another claim can be a rubber block.

(2)「The special technical features」are the concept specially suggested to determine the unity of inventions and shall involve novelty and inventive step compared to prior arts disclosed before the concerned patent application is filed. The unity of invention shall be determined after considering all the inventions at large.

「The special technical features」refer to the improved features in respect of the inventions at large when compared with prior arts. Therefore, whether the unity of inventions is satisfied or not can be determined before searching prior arts in some cases, but in general, shall be determined after considering prior arts.

For example, in claims disclosing inventions A+X and A+Y, since all the claims have the invention A in common, it could be determined a priori before searching the prior arts that

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the claims involve the unity of inventions. However, where prior arts related to A has been searched, each claim does not have the same or corresponding special technical features distinctive from the prior arts. Therefore, the claims shall be deemed to lack the unity of invention a posteriori.

(3) A group of inventions may include multiple independent claims from the same category within one application or may include multiple independent claims from different categories within one application.

Also, even one claim may include inventions out of the scope of one group of inventions, failing to meet the unity of inventions.

(4) Whether one group of inventions forms a single general inventive concept is not related to whether one group of inventions is claimed in separate claims or alternatively claimed in one claim.

(Note) Originally, the Patent Act stipulates that a patent application shall relate to one invention only. However, Article 45 of the Patent Act intends to promote the convenience of applicants, third parties, and the Korean Intellectual Property Office since it could be appropriate to allow applicants to file an application on technically linked invention in independent claims. Therefore, in interpreting the provision, it is important to strike a balance on the interests of applicants who prefers filing irrelevant inventions in a single application because of lower patent fees or easier patent management as well as third parties and the Korean Intellectual Property Office who would, in turn, get disadvantaged due to observation on other patent holders' rights, use the application as prior arts or more burden on patent examination respectively.

In this perspective, whether inventions constitute "a group of inventions so linked as to form a single general inventive concept" depends on whether the inventions described in each claim of the application have the same or corresponding technological features(in other words, whether the inventions are technically closely linked) and the technological features shall refer to the improved features in respect of the inventions at large when compared with prior arts(refer to Patent Court Case No. 98 Hu 5145, January 14, 1999).

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4. Determination on Unity of Invention

Basically, unity of inventions shall be determined in the following order.

(1) A first invention shall be chosen and the special technical features of the first invention which serves as improvement over prior arts shall be specified by comparison with the prior arts related to the invention. It shall be noted that even a single invention may include multiple special technical features depending on the technical content of the invention.

In this context, the first invention refers to the main invention and has nothing to do with the order of claims.

(2) A second invention shall be chosen and the special technical features of the first invention which serves as improvement over prior arts shall be specified by comparison with the prior arts related to the invention. It shall be noted that even a single invention may include multiple special technical features depending on the technical content of the invention.

(3) The technical correlation between the first invention and the second invention shall be checked by determining whether the special technical features of the first invention and the special technical features of the second invention are the same or corresponding. If there exist the special technical features which are the same or corresponding between the two inventions, it can be concluded that the inventions belong to the single general inventive concept.

(4) Through the steps of (2) and (3) above, whether a single general inventive concept is formed shall be determined based on the technical correlation under Article 6 of the Enforcement Decree of the Patent Act.

(5) The invention subject to examination shall be designated based on the first invention. In principle, the first invention as well as an invention belonging to the technical group(the first technical group) which forms a single general inventive concept with the first invention shall be prioritized for the invention subject to examination. However, an invention which is not

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included in any technical group because of lack of improvement over prior arts, but whose examination is terminated in the procedure of determination on unity of inventions shall be included.

Moreover, an invention which can be examined without additional efforts because of mere differences in expressions such as different categories from the inventions belonging to the first technical group can be included to the invention subject to examination.

(6) Examination on patentability except for unity of inventions shall be conducted for the invention subject to examination.

When notifying a ground for rejection citing the violation of the requirement of unity of inventions, an examiner shall notify the ground of rejection citing the violation of the requirement of unity of inventions on all the claims. When notifying a ground for rejection citing the violation on unity of inventions, an examiner shall notify the ground for rejection by specifying that the concerned invention does not share the same or corresponding special technical features as those that characterize the first technical group.

However, unity of invention can be determined based on whether the second invention includes the same or corresponding special technical features as the first invention after specifying the special technical features of the first invention in the above-mentioned step (1) and the second invention without conducting any additional prior art search in the steps (2) and (3). Also, where, after finding the common special technical features of each invention for convenience of examination practices first and determining whether such features are improvements over prior arts, the common features are not considered to be improvement compared to prior arts, unity of inventions shall be deemed lacking.

Meanwhile, it shall be noted that lack of unity of inventions just constitutes a ground for rejection, not the actual ground for invalidation. In other words, where lack of unity of invention is deemed obvious, an examiner shall notify a ground for rejection so that an application can make amendments. However, an examiner does not need to force an applicant to make amendments or file a divisional application by notifying a ground for rejection citing the violation of unity of inventions based on the literal approach. Especially,

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even if unity of invention is lacking, where examination can be terminated without any additional examination efforts since no more prior art search is needed(for example: where novelty and an inventive step of the entire claims can be denied based on the searched prior art), an examiner may not notify a ground for rejection citing the violation of unity of inventions.

5. Case of Determination on Unity of Invention

(1) Where an independent claim has special technical features a dependent claim which refers to the independent claim includes all the special technical features. Therefore, unity of invention can be met among the claims with the common special technical features. In the below-mentioned case, if A+B is the special technical features, it means that all the claims hold the common special technical features of A+B. Therefore, unity of inventions on claim 1 and its dependent claims 2 and 3 is met.

(Example)
[Claim 1]: A display device comprising the special technical features of A+B
[Claim 2]: A display device adding the special technical features of C, in claim 1
[Claim 3]: A display device adding the special technical features of D, in claim 1

This shall apply to dependent claims of an invention with the lower concept which refers to the claims disclosed in an invention with the upper concept. In the example below, claim 1 and claims 2 and 3 are in the upper-and-lower inventive concept. Considering that the common special technical features of claims 1, 2 and 3 is the technology of processing the surface of polyethylene resin with acid, unity of inventions is met among claims 1, 2 and 3.

(Example)
[Claim 1]: A method of processing the surface of polyethylene resin with acid
[Claim 2]: A method of processing the surface of polyethylene resin with sulfuric acid in claim 1
[Claim 3]: A method of processing the surface of polyethylene resin with nitric acid in claim 1

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(2) The following examples shall be referred to regarding other cases of determination on unity of inventions.

<Where claims include the special technical features of other claims>

〔Claim 1〕 Lamp filament A
〔Claim 2〕 Lamp B comprising Lamp filament A
〔Claim 3〕 Searchlight comprising Lamp B comprising Lamp filament A and Spinning rim C

If Filament A in claim 1 is the special technical features, it is the common special technical features among all the claims, Therefore, unity of inventions is met among claims 1, 2 and 3.

<Where claims disclose contrasting special technical features>

〔Claim 1〕 A transmitter comprising a timebase expander of video signals
〔Claim 2〕 A receiver comprising a timebase compressor of the received video signals
〔Claim 3〕 A transmitting apparatus of video signals, comprising the transmitter comprising a timebase expander of video signals and the receiver comprising a timebase compressor of the received video signals

If the timebase expander of video signals of claim 1 is the special technical features and the timebase compressor in claim 2 is the special technical features and they are contrasting special technical features(sub-combination and sub-combination), unity of inventions is met among claims 1 and 2. Since claim 3 includes all the special technical features of claims 1 and 2, unity of inventions is met between claim 1 and claim 3 as well as claim 2 and claim 3(combination and sub-combination).

<Where claims disclose special technical features that are not the same or corresponding>

〔Claim 1〕 Direct current motor control circuit A

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〔Claim 2〕 Direct current motor control circuit B
〔Claim 3〕 An apparatus using a direct current motor comprising control circuit A
〔Claim 4〕 An apparatus using a direct current motor comprising control circuit B

Where the special technical features is not the fact of being used in a direct current motor and where 'control circuit A' is one special technical features and 'control circuit B' is another special technical features even though they are not relevant, unity of inventions is met between claim 1 and claim 3 or claim 2 and claim 4. However, unity of inventions is not met between claim 1 and claim 2 or claim 3 and claim 4.

<Where claims disclose special technical features whose claims do not meet unity of inventions>

〔Claim 1〕 A conveyor belt comprising Feature A
〔Claim 2〕 A conveyor belt comprising Feature B
〔Claim 3〕 A conveyor belt comprising Features A and B

Where 'Feature A' is one special technical features and 'Feature B' is another special technical features, unity of inventions is met between claim 1 and claim 3 or claim 2 and claim 3. However, unity of inventions is not met between claim 1 and claim 2.

6. Determination on Unity of Invention in special cases

6.1 Product and Manufacturing Process of the Product

(1) Unity of inventions on a product invention disclosed in claims and the manufacturing process of the concerned product shall be determined based on whether the manufacturing process is 'suitable' for the manufacture of the concerned product.

In this context, 'suitable' indicates that when the manufacturing process is worked, the product is manufactured. However, 'suitable' does not necessarily mean that the product cannot be manufactured in other processes or the manufacturing process cannot be used to manufacture other products.

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(Example 1)
〔Claim 1〕 Chemical material X
〔Claim 2〕 Manufacturing process of Chemical material X

The manufacturing process in claim 2 is suitable for manufacturing Chemical material X in claim 1. The common special technical feature of claims 1 and 2 is Chemical material X.

(Example 2)
〔Claim 1〕 A corrugated cardboard comprising a cavity in porous synthetic resins
〔Claim 2〕 A method of manufacturing a corrugated cardboard produced in the process of charging intumescent synthetic resins into a cavity of the corrugated cardboard and in the process of heating the lamination layer.

A product created by the manufacturing process in claim 2 is a corrugated cardboard in claim 1. Therefore, since the manufacturing process of claim 2 is suitable for manufacturing a corrugated cardboard in claim 1, claims 1 and 2 meet the unity of inventions.

(Example 3)
〔Claim 1〕 A golf ball comprising a core of a particular structure
〔Claim 2〕 A method of manufacturing a golf ball in claim 1, created in the special process

Since a product created by the manufacturing process of claim 2 is stated as 'a golf ball in claim 1', the manufacturing method of claim 2 is suitable for manufacturing a golf ball in claim 1.

(2) A manufacturing method shall be a method of manufacturing the concerned product in itself. Therefore, a method that is used indirectly or secondarily for the manufacturing of the product(for example, a method of analysis, etc.) shall not be deemed as one application unless special conditions exist.

6.2 Product and Method of using the Product

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An invention of the method of using a product refers to an invention of the method of using the quality, functions of the concerned product. A product invention shall include machinery, device, apparatus, compartment, circuit, etc., let alone chemical materials or compositions. For example, an invention of a device can lead to an invention of the method of operating the device or an invention of using the device.

(Example 1)
〔Claim 1〕 Material A
〔Claim 2〕 A method of deinsectization with Material A

'A method of deinsectization' in claim 2 corresponds to a method of using the quality(insecticidal property) of Material A in claim 1.

(Example 2)
〔Claim 1〕 Material A
〔Claim 2〕 A method of manufacturing soy sauce in which the creation of a fungus is suppressed by mixing Material A into soy sauce

Claim 2 discloses 'a method of manufacturing ...', but it is substantially the same with 'a method of suppressing the creation of fungus in soy sauce by mixing Material A into soy sauce'. Therefore, claim 2 shall correspond to a method of using special qualities of Material A in claim 1.

6.3 Product and Method of treating the Product

'Treating the product' means forcing the product to maintain or exert its functions by applying the external effect on the product, not changing the nature of the product. For example, transfer or storage of a product shall correspond to a method of treating the product.

(Example 1)
〔Claim 1〕 A prefabricated home with a special structure (an easily-stored or -transferred prefabricated home)

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〔Claim 2〕 A method of storing a prefabricated home with a special structure

'A method of storing ...' intends to maintain or exert 'the function of an easily-stored or –transferred prefabricated home' in claim 1. Therefore, it shall correspond to an invention of treating of the subject matter in claim 1.

(Example 2)
〔Claim 1〕 Material A
〔Claim 2〕 A method of storing Material A by covering light at the temperature of X℃ or below and the atmospheric pressure of Y atm and adding Material B in the presence of rare gases (neon, argon)

Claim 2 discloses a method of storing Material A with unstable qualities and therefore, it shall correspond to an invention of treating the subject matter in claim 1.

6.4 Product and Machinery, Device, Apparatus or Other Product of manufacturing the Product

(1) Whether machinery, device, apparatus or other products(hereinafter referred to as equipment) used for manufacturing a product is suitable for manufacturing the product shall be crucial. 「Suitable」 refers to that when the invention of the equipment for manufacturing the product is worked, the product is actually manufactured. However, 「suitable」 does not necessarily mean that the product cannot be manufacture by other equipment or that the equipment used for manufacturing the product cannot be used for manufacturing other products.

(Example)
〔Claim 1〕 Bolt A with a special structure
〔Claim 2〕 Equipment B used for manufacturing Bolt A with a special structure

Regardless of whether Equipment B in claim 2 can be used for manufacturing other products, besides manufacturing Bolt A in claim 1, Equipment B is suitable for manufacturing Bolt A. Therefore, unity of inventions is met.

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(2) Equipment refers to a device that can be used for manufacturing the product in itself. Therefore, devices that can be indirectly or secondarily used for manufacturing the product(for example, a measuring device or analytical device, etc. that can be used for manufacturing the product) cannot be filed as one application.

(3) 「Other products」 shall include chemical materials or microorganism besides equipment.

(Example)
〔Claim 1〕 Antibiotic A
〔Claim 2〕 New culture B manufacturing Antibiotic A

New culture B corresponds to 'other products' manufacturing antibiotics and therefore, unity of inventions is met.

6.5 Product and another Product using only the special nature of the Product

An invention of a product using only the special nature of the product refers to the invention whose purpose can be achieved only by using the special nature of the product and moreover, using the special nature of the product is explicitly described in the subject matter of the invention. Therefore, an invention of such products can be generally limited to chemical materials.

(Example)
〔Claim 1〕 Material A
〔Claim 2〕 Herbicide made from Material A

A herbicide in claim 2 shall correspond to a product using the weed-killing capacity of Material A in claim 1.

6.6 Product and another Product treating the Product

An invention of a product treating the other product refers to the invention of the product

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whose functions are maintained or exerted by applying the external effect on the product and the product itself is not changed.

(Example)
〔Claim 1〕 Unstable chemical material A
〔Claim 2〕 Storage device of chemical material A

A storage device in claim 2 intends to ensure Chemical material A in claim 1 maintains its function and it shall correspond to another product treating Chemical material A.

6.7 Method and Machinery, Equipment and Other Products directly used for working the Method

Where 「machinery, equipment, other products directly used for working the method」 is suitable for being directly used for the working of the special method, unity of inventions is met. In this context, 「suitable」 shall be determined based on whether the special technical features of the 「machinery, equipment, other products directly used for working the method」 are directly used for manifestation of the special technical features of the 「method」.

(Example 1)
〔Claim 1〕 A manufacturing method of Antibiotic A created by the culture of Microorganism X
〔Claim 2〕 Microorganism X

Microorganism X in claim 2 does not correspond to 'machinery, equipment, etc.' directly used for manufacturing Antibiotic A, but the role of Microorganism X when manufacturing Antibiotic A can be deemed as a manufacturing device. Therefore, it shall constitute 'other products'.

(Example 2)
〔Claim 1〕 A painting method with a paint comprising rust resistant material X through the special placement of electrodes and constant current load

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［Claim 2］ A paint comprising rust resistant material X

'A paint comprising rust resistant material X' shall correspond to a product directly used for working the method of claim 1.

7. Special Cases

7.1 Markush-type Claim

(1) Where alternative elements are disclosed in the Markush style in a single claim, if the alternative elements have corresponding qualities or functions, unity of inventions is met.

Where the Markush group includes alternative elements of components and such elements meet the requirement under Chapter 4 4.(4), the Markush group shall be considered to have corresponding qualities or functions.

(2) Regardless of either more than two alternative elements are disclosed in multiple independent claims or they are disclosed only in a single claim as in the Markush type, criteria of determination on unity of inventions shall be the same.

(3) Once at least one alternative element among the alternatives in the Markush group is determined to lack novelty over prior arts, an examiner shall review unity of inventions.

(Example 1)
［Claim 1］ Compounds in the below-mentioned formula

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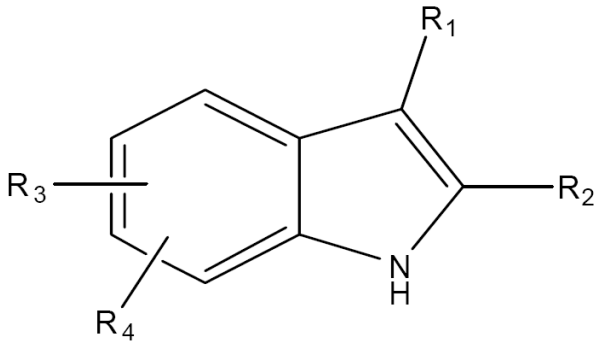

In this formula, R1 is selected among the group comprising phenyl, pyridyl, tiazolyl, triazinyl, alkylthio, alkoxy and methyl and R2-R4 are methyl, benzyl or phenyl. These compounds are effective as drugs for increasing the capacity of absorbing oxygen in blood.

[Explanation] In this case, the indole is 「the crucial structural element」 which is common among all the substituents. Since all the claimed compounds are deemed to have the same use, unity of inventions is met.

(Example 2)
〔Claim 1〕 A catalyst used for oxidizing hydrocarbon comprising (X) or (X+a) in steam

[Explanation] In this example, (X) oxidizes RCH3 with RCH2OH, and (X+a) further oxidizes RCH32 with RCOOH. These two catalysts have the common element and activation as the oxidation catalyst to RCH3. If (X+a) is used, oxidation will be more complete and continue until carboxylic acid is formed, but activation shall be the same as when (X) is used. Therefore, unity of inventions is met.

7.2 Intermediate and End Product

(1) The term 「intermediate」 refers to an intermediate material or a starting material. Such intermediate materials or starting materials have the capacity of losing their own characteristics according to physical or chemical changes and being used to produce end products.

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Where the below-mentioned ① and ② are satisfied, unity of inventions between intermediate materials and end products is deemed to be met.

① Major structural elements between intermediate materials and end products shall be identical. In other words,

(ⅰ) the basic chemical structure between intermediate materials and end products is the same, or

(ⅱ) the basic chemical structure between intermediate materials and end products is technically closely related and intermediate materials provide major structural element to end products.

② Intermediate materials and end products shall be technically closely related. In other words, end products are directly produced from intermediate materials, or the major structural elements are manufactured via a few identical intermediate materials.

(2) Where major structural elements of intermediate materials are identical, one application can be filed on more than one different intermediate material used in different processes in order to produce a single end material. However, more than two different intermediate materials used in other structures of end products cannot be filed as one patent application.

(3) In the process of producing end products from intermediate materials, if intermediate materials and end products are separated by an intermediate material which is not novel, such materials cannot be filed as one patent application.

(4) Where intermediate materials and end products are compounds, each intermediate compound shall correspond to one compound claimed in the group of end product compounds. However, since parts of end materials may not have corresponding compounds in intermediate compound group, two groups of compounds do not necessarily correspond to each other, respectively.

(Example 1)

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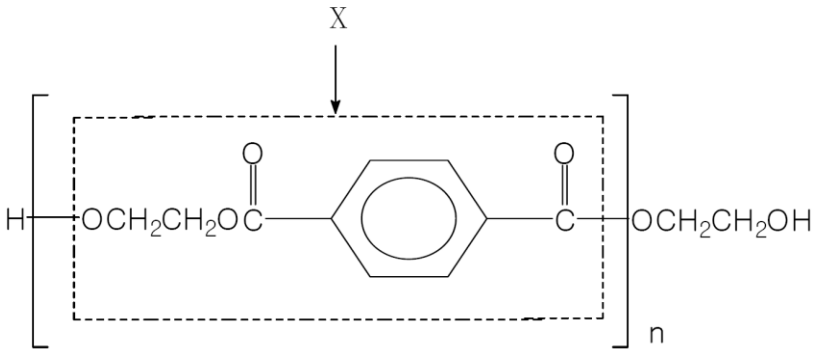
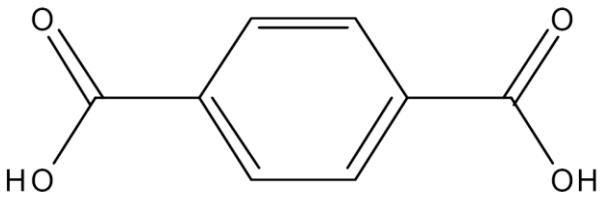
〔Claim 1〕 Amorphous polymer A (Intermediate Material)
〔Claim 2〕 Crystalline polymer A (End Product)

Crystalline polymer A is produced by orientating the film of polymer A. Unity of inventions is met since amorphous polymer A is used as a starting material to produce crystalline polymer A and therefore, the intermediate material and end product is related.

(Example 2)
〔Claim 1〕 High molecular compounds useful as textile materials defined in the below -mentioned formula (Repeating Unit X)



〔Claim 2〕 Compounds defined in the below-mentioned formula (Useful as a starting material to produce the above-mentioned high molecular compounds)



The compounds of both claim 1 and claim 2 share 「major structural elements(repeating unit X)」 and they are technically closely related. Therefore, unity of inventions is met since the invention disclosed in claim 1 and claim 2 holds the relation of intermediate materials and

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end products.

8. Instructions on Examination of Unity of Invention

(1) Unity of invention shall be first determined on independent claims. Where independent claims are deemed to meet the requirement of unity of inventions, dependent claims which refer to such independent claims shall be deemed to satisfy the requirement of unity of inventions.

(2) The requirement of unity of inventions under Article 45 of the Patent Act may constitute a ground for rejection under Article 62 of the Patent Act, but shall not serve as a ground for provision of information or invalidation(Article 133① of the Patent Act).

(3) Where a ground for rejection is to be notified under Article 45 of the Patent Act, an examiner may suggest the division of an application if it is deemed that an applicant can better respond to the ground for rejection and such response can be beneficial for the speedy and accurate examination.

(4) It shall be noted that even if the requirement of unity of inventions is met based the result of determination on unity of inventions in one particular independent claim, the concerned independent claim may be deleted or the content of the invention may change through amendments so that the requirement of unity of inventions is no longer satisfied.

(5) Unless special cases exist such as inventions out of the scope of a group of inventions are disclosed within one claim, unity of inventions shall be deemed to be met between a claim and another claim dependent upon the before-mentioned claim. Therefore, in principle, unity of inventions does not need to be determined between an independent claim and a dependent claim which depends upon the independent claim. The same also applies to where two claims are in effect in the citation relations since a claim contains all of the matters disclosed in another claim.

However, where a cited claim lacks novelty or inventive step due to the prior art and therefore, does not hold 「special technical features」, unity of inventions cannot be met

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among the claims citing the concerned claim. Therefore, whether identical or corresponding 「special technical features」 different from the prior art exist among the claims citing the concerned claim shall be additionally reviewed.

(Example) Where claim 1 is an independent claim and claims 2 to 5 are dependent upon claim 1 and the claims are compared with the prior art search result by an examiner and as in the following

〔Claim 1〕 A (A disclosed in the prior art);
〔Claim 2〕 A+B (A+B disclosed in the prior art);
〔Claim 3〕 A+C (C not disclosed in the prior art);
〔Claim 4〕 A+C+D; and
〔Claim 5〕 A+F (F not disclosed in the prior art),

since claim 1, independent claim, does not hold any improvement compared to the prior art, whether unity of inventions is met shall be determined among claims 2 to 5 dependent upon claim 1. Claim 2 does not contain 「special technical features」 and C is the 「special technical feature」 of claims 3-4 and F is the 「special technical feature」 of claim 5. In such a case, if C and F are not identical or corresponding 「special technical features」, the dependent claims are deemed to be divided into <claim 2>, <claims 3-4> and <claim 5>. If claim 1 is viewed to belong to the same invention group as claim 2 (possible to include claim 1 into all the three invention groups individually), the examiner may notify a ground for rejection citing that the three invention groups exist as shown in the followings. Also, the examiner shall deliver the outcome of the substantive examination on the Group 1(ground for rejection based on lack of novelty, inventive step, etc.) together.

Group 1: Claims 1 and 2
Group 2: Claims 3 and 4
Group 3: Claim 5

As explained in the last paragraph of (6) of 「4. Determination on Unity of Invention」, even if unity of inventions is lacking, where the above-mentioned claims 3, 4 and 5 do not need to be searched and examination can be terminated without additional efforts, the examiner

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may directly notify the ground for rejection on claims 1 to 5 based on lack of novelty, inventive step, without notifying the ground for rejection on the lack of unity of inventions.

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Chapter 6. Application related to Microorganisms

1. Relevant Provisions

Article 2 of the Enforcement Decree of the Patent Act (Deposit of Microorganisms) ① Any person who desires to make a patent application for an invention related to a micro-organism, shall deposit such micro-organism with a depository determined by the Commissioner of the Korean Intellectual Property Office or an organization which has acquired a status as an international depository under Article 7 of the Budapest Treaty on the International Recognition of the Deposit of Micro-Organisms for the Purpose of Patent Procedure (hereinafter referred to as "international depository") and append documents certifying the fact (in cases of deposit with the international depository, a copy of the latest deposit certificate of those issued under Article 7 of the Budapest Treaty on the International Recognition of the Deposit of Micro-Organisms for the Purposes of Patent Procedure) to the patent application: provided, That if a person who has ordinary knowledge in the field of technology to which the invention belongs, can easily obtain such micro-organism, it need not to be required to deposit such micro-organism.

② If a new deposit number is issued to the micro-organism deposited under paragraph (1) after a patent application is filed, a patent application or a patentee shall report it, without delay, to the Commissioner of the Korean Intellectual Property Office.

Article 3 of the Patent Act(Matters to be Entered in Patent Specifications of Invention related to Micro-Organism) Any person who intends to file a patent application for an invention related to a micro-organism shall enter in the specifications prescribed in Article (2) of the Act, the deposit number issued by the depository or the international depository when he/she has deposited the microorganism pursuant to the main sentence of Article 2(1), and the method of acquisition of the micro-organism when he/she did not deposit it pursuant to the proviso to Article 2(1).

2. Deposit System

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2.1 Purpose

An applicant shall describe the claimed invention in the detailed description of an invention in a manner that a person with ordinary knowledge in the technology to which the invention pertains may easily work the invention. When a starting material or end product includes biological materials such as micro-organisms, there are many cases where an invention cannot be easily worked only based on the content of the specification. In such cases, in order for a person with ordinary knowledge in the technology to which the invention pertains to easily work the invention based on the content of the specification, a means of securing the starting material and a manufacturing process of the end product shall be disclosed in detail in the specification. In other words, the workability of the invention can be supported by depositing micro-organisms which are starting materials or end products.

2.2 Subject of Deposit

(1) Micro-organisms subject to deposit refer to all the biological materials such as genes, vectors, germs, mold, animal cells, fertilized eggs, seeds, etc. and the type of micro-organisms eligible for deposit differs according to each depository.

(2) Even for plant-related inventions, if necessary, parent plants or seed or cells that can produce the concerned plants can be deposited so that a person with ordinary knowledge in the technology to which the invention pertains can easily work the invention.

2.3 Depository of Micro-organisms

(1) Depositories of micro-organisms refer to depositories designated by the Commissioner of the Korean Intellectual Property Office or those institutions which have acquired a status as international depository institutions (hereinafter referred to as international depository) under Article 7 of the Budapest Treaty on the International Recognition of the Deposit of Micro-Organisms for the Purpose of Patent Procedure.

(2) Depositories designated by the Commissioner of the Korean Intellectual Property

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Office include KCTC(Korean Collection for Type Cultures), KCCM(Korean Culture Center of Microorganisms), KACC(Korean Agricultural Culture Collection) according to the Directive on the Designation of Depository of Micro-Organisms(No. 2009-19 of Directive of Korean Intellectual Property Office).

(3) International depositories in Korea include KCTC (Korean Collection for Type Cultures), KCCM(Korean Culture Center of Microorganisms) and KCLRF(Korean Cell Line Research Foundation).

(4) Depositories where seeds can be deposited are KCTC(Korean Collection for Type Cultures) and KACC(Korean Agricultural Culture Collection). Depositories for deposit of plant cells include KCTC(Korean Collection for Type Cultures) and KCLRF(Korean Cell Line Research Foundation).

2.4 Micro-organisms that can be easily secured

Micro-organisms that can be easily secured under Article 2 of the Enforcement Decree of the Patent Act shall include the followings:

① Micro-organisms that are currently in sale in the market.

② Micro-organisms that are deposited at credible depositories before application filing and are confirmed to be eligible for distribution in the form of catalogs, etc. issued by a depository. In such cases, the depository of the concerned micro-organisms and the deposit number shall be disclosed in the initial specification at the time of application filing.

③ Micro-organisms that can be easily produced by a person with ordinary knowledge in the technology to which the invention pertains based on the specification.

3. Application Procedure

(1) A person who intends to file a patent application on an invention related to a micro-organism shall deposit the micro-organism to a depository and attach the evidential

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document on the deposit to the patent application. However, where a person with ordinary knowledge in the technology to which the invention pertains can easily secure the micro-organism, the concerned micro-organism may not be deposited.

(2) A person who intends to file an application on the invention related to an invention related to a micro-organism shall state the deposit number of the micro-organism in the specification. When the micro-organism is not deposited, the person shall state how to secure the micro-organism.

Where the micro-organism is deposited, the name of the depository, the date of deposit shall be additionally disclosed in the specification.

(3) When the new deposit number is granted on the deposited micro-organism after the time of application filing, the applicant shall report it to the Commissioner of the Korean Intellectual Property Office without delay. A person who intends to report a change of deposit number of the micro-organisms shall attach the following documents to a written report on change of deposit number of micro-organisms in the Annexed form No. 18 of the Enforcement Rule of the Patent Act and submit them to the Commissioner of the Korean Intellectual Property Office.

① A copy of the evidential document of new deposit number
② Where the procedure is undertaken by a legal representative, a copy of the evidential document of the legal representation

4. Instructions on Examination

(1) Where an application where a micro-organism is to be deposited includes the fact of deposit and the deposit number, but not a copy of the deposit certificate, an examiner shall consider that the micro-organism is not deposited and conduct examination on the application.

(Note) Where an applicant failed to attach a copy of the deposit certificate and then attach the copy of the deposit certificate after being notified of a ground for rejection from an

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examiner, the examiner shall accept the copy and conduct examination on the application.
(2) Where the initial specification of an application where a micro-organism is to be deposited did not state the deposit number and then the number is disclosed through amendment, it shall be deemed to be the addition of new matter.

(3) Where a micro-organism is deposited and the deposit certificate is attached before filing the application and relevant facts such as deposit numbers in the specification, but the patent classification of the deposited micro-organism is adjusted and then its name is changed, if a copy of the evidential document issued by a depository institution is submitted, it shall not be deemed to be the addition of new matter even though an amendment of changing the name of the concerned micro-organisms is made. However, where the scientific characteristic of the concerned micro-organism of the newly-adjusted patent classification which is not disclosed in the originally attached specification is stated, it shall be deemed to be the addition of new matter.

(4) Since the deposit of micro-organisms is meant to supplement the detailed description of the invention so that a person with ordinary knowledge in the technology to which the invention pertains can easily work the invention related to the micro-organisms, the deposit of the concerned micro-organisms shall be completed by the time of filing the application.

The time of the deposit of micro-organisms shall be deemed to be the date when the applicant deposits the concerned micro-organisms to a depository institution and then the depository institution receives the micro-organisms. However, where the applicant filed an application by only disclosing the deposit number on the specification and failed to submit the deposit certificate through amendment even after filing the application, it shall be deemed that the deposit has never been made on the date of deposit.

(5) Where a micro-organism needs to be deposited for an application with domestic priority claim, if the micro-organism was deposited to international or domestic depository before the date of filing the initial application and the deposit number is disclosed in the specification of the initial application, the invention related to the micro-organism can benefit from the effect of priority claim when a procedure related to the deposit of micro-organisms is undertaken for an application with domestic priority claim.

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Meanwhile, where an international patent application serves as the basis of priority claim, the application can benefit from the effect of priority claim when the micro-organism is deposited to an international depository before the date of filing the international application and its deposit number is stated in the specification of the international patent application.

5. Patent Application including Nucleic Acid Sequence or Amino Acid Sequence

(1) A person who intends to file a patent application including nucleic acid sequence or amino acid sequence(hereinafter referred to as 'sequence') shall include the sequence list written according to the method decided by the Commissioner of the Korean Intellectual Property Office(hereinafter referred to as 'sequence list') in the specification and attach the electronic file containing the sequence list (hereinafter referred to as 'electronic file of sequence list') drawn in the method set by the Commissioner of the Korean Intellectual Property Office to the patent application. However, where the sequence list drawn according to the method set by the Commissioner of the Korean Intellectual Property Office is disclosed in the specification in the electronic form, the electronic file of sequence list does not need to be attached.

(2) Details regarding the method of writing sequence list and electronic file of sequence list shall be based *the guideline for writing nucleic acid sequence or amino acid sequence* (KIPO Directive No. 2013-1).

(3) Where the sequence list disclosed in the specification and the sequence list contained in the electronic file are different, the examiner shall examine the application based on the sequence list disclosed in the specification.

(4) The above-mentioned examination guideline in the paragraphs (1) to (3) shall apply *mutatis mutandis* to amendments to the sequence list.

(5) Applications in which the sequence list is not disclosed in the specification or the

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electronic file of the sequence list is not attached shall be treated in the following manner:

① Where the sequence list is not disclosed in the specification

Where an invention disclosed in claims cannot be easily worked because the sequence list is not disclosed in the specification, an examiner shall notify a ground for rejection under Article 42(3)(i) of the Patent Act. Where the sequence list is attached to the specification based on the ground for rejection, it shall be determined based on the provision of prohibition of addition of new matter.

② Where the electronic file of the sequence list is not attached

Where the electronic file of the sequence list is not attached in the application (except for the case where the sequence list is disclosed in the specification in the electronic form), this shall be subject to amendment because of the violation of the method set by orders under the Patent Act.

Therefore, as for applications without electronic files of the sequence list, the examiner shall request an amendment under Article 46 of the Patent Act and if irregularities are not addressed, invalidate the application procedure.

The image-scanned sequence list is not the electronic file of sequence list drawn by the method set by the Commissioner of the Korean Intellectual Property Office. Therefore, where the image-scanned sequence list is attached, the examiner shall treat it as if the electronic file of sequence list is not attached.

(Note) The applicant may voluntarily amend formality irregularities of the above-mentioned application when the application procedure is still pending, even though a request for amendment has not been made.

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PART III. Requirements for Patentability

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Chapter 1. Industrial Applicability

1. Relevant Provisions

Article 29(1) of the Patent Act (Requirements for Patent Registration) Inventions that have industrial applicability are patentable unless they fall under either of the following sub-paragraphs:
(1) inventions publicly known or worked within or outside of the Republic of Korea before the filing of the patent application; or
(2) inventions described in a publication distributed in the Republic of Korea or in a foreign country before the filing of the patent application or inventions published through telecommunication lines as prescribed by Presidential Decree.

2. Purport

It is no doubt that all inventions should be industrially applicable since the purpose of the Patent Act is to contribute to the development of industry (Patent Act Article 1). In this regard, the Patent Act Article 29 paragraph (1) stipulates that an invention is patentable only if the invention is considered to industrially applicable. The term of "industry", the Patent Act Article 29 paragraph (1), shall be interpreted in a broad sense. In other words, the term industry is interpreted to cover all useful activities and practical technologies.

(Reference) **Paris Convention Article 1(3)**
Industrial property shall be understood in the broadest sense and shall apply not only to industry and commerce property, but likewise to agricultural and extractive industries and to all manufactured or natural products, for example, wines, grain, tobacco leaf, fruit, cattle, minerals, mineral waters, beer, flowers, and flour.

3. Relevant Provisions

Under Patent Act Article 29 paragraph (1), 「Invention which is industrially applicable」 is generally divided by the requirements of 「Invention」 and the requirement of the invention

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「that are industrially applicable (industrial applicability)」. Therefore, under the examination guidelines, the requirements of Patent Act Article 29 paragraph (1) is defined by the requirement of 「Invention」 and of 「subjects that involve industrial applicability」.

4. Statutory Inventions

Under the Patent Act Article 2 subparagraph (1),「Invention means the highly advanced creation of a technical idea using the rules of nature」, the invention shall satisfy the relevant provisions in order for a filed patent application to be statutory under the Patent Act.

However,「a highly advanced creation」is a relative concept to differentiate 「design device」 under the Utility Model Act from 「Invention」under the Patent Act, and in practice, 「the highly advanced creation」shall not be considered in the case of determining requirements of 「Invention」.

4.1 List of Non-statutory Inventions

The decision of whether an invention falls under the Patent Act 2 subparagraph (1) is not without challenge, and the guidelines hereby exemplifies the types of non-statuary inventions in order to help determine whether the invention is patentable.

4.1.1 A law of nature as such

An invention is defined as a highly advanced creation of a technical idea using the rules of nature. So, a law of nature such as the second law of thermodynamics or the law of conservation of energy is not considered as a statutory invention.

4.1.2 Mere discoveries and not creations

A mere discovery is not deemed to be a creation because a discovery means to find out laws which already previously existed in nature. One of the requirements for a statutory invention is to be a creation, and thus, mere discoveries, such as discoveries of natural things such as an ore or natural phenomena are not considered to be a statutory invention.

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However, if things in nature, not mere discoveries, are isolated artificially from their surroundings, the methods, the isolated chemical substances or microorganisms are considered to be a statutory invention.

A use invention, which claims a new use of a known material in accordance with its inherent but newly found property, shall be dealt with distinctively from a "mere discovery of unknown property of a known material" in the Patent Act. That is to say, though a new use of a known material is non-statutory, if the new use are closely related, with non-obvious inventive activities, to the newly found property, the use invention may be patentable.

4.1.3 Those contrary to a law of nature

Those contrary to a law of nature (e.g.: perpetual motion) are not considered as a statutory invention because an invention must utilize a law of nature. If a matter necessary to define a claimed invention involves any means contrary to a law of nature, the claimed invention is not considered to be a statutory invention (Relevant court decision: Supreme court decision 1998.9.4 98 Hu 74 sentence).

4.1.4 Those in which a law of nature is not utilized

If a claimed invention uses any laws other than a law of nature (e.g. economic laws, mathematical methods, logics, cartography etc), arbitrary arrangements (e.g. a rule for playing a game as such) or mental activities (e.g. method for doing business as such, teaching skills as such, financial insurance scheme as such, tax code as such, etc.), the claimed invention is not considered to be statutory.

Where a claimed invention does not involve logics, mathematical principle as such or method directly using them but involves technical devices or a method which gives useful, concrete and tangible result by increasing or controlling the performance of a certain technical tools with the data, if the technical devices or technical methods are considered as universal, repetitive and objective, they are deemed as a statutory invention which uses technical idea utilizing a law of nature.

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As stated above, the characteristics of the technology is to be taken into account as a whole in judging whether a claimed invention utilizes a law of nature. Therefore, even if a part of matters defining an invention stated in a claim utilizes a law of nature, when it is judged that the claimed invention considered as a whole does not utilize a law of nature, the claimed invention is deemed as not utilizing a law of nature. On the contrary, even if a part of matters defining an invention stated in a claim does not utilize a law of nature, when it is judged that the claimed invention as a whole is considered as utilizing a law of nature, the claimed invention is deemed as utilizing a law of nature.

(Example 1)
A method for designing cryptographs through the combination of Alphabets, numbers and signs.

(Example 2)
A method for creating a phonetic transcription of foreign languages comprising the step of: using the phenomena in which there is change in pronunciation formed by a set of vocal organs including the shape of throat and sound of tongue formed at pronouncing a certain word to indicate different pronunciation or characteristics of forming a phonetic transcription as the shape of lips changes.

(Example 3)
A method for comprehensive management for recycling garbage or waste comprising the steps of: distributing special bags bar-code stickers attached with personal information of a person who disposes garbage or waste to citizens; inviting the citizens to separate general waste and place garbage in special disposal bag with the bar-code stickers attached; collecting the disposal bags on a daily basis and discharging them at a waste disposal site; and sorting waste or garbage at the waste disposal site, wherein in the case of wrongly sorted garbage, the citizen who disposed garbage in a wrong disposal bag are detected by the bar-code and warned not to do it again.

4.1.5 Skill

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A personal skill which is acquired by personal practice cannot be shared with third parties as knowledge due to lack of objectivity, so it is not considered to be a statutory invention.

(Example 1)
A method of performing musical instruments, a method of throwing a spilt-fingered fast ball characterized in the way of holding the ball in fingers and throwing the same.

4.1.6 Mere presentation of information

A mere presentation of information where the technical feature resides solely in the content of the information and its main objective is to present the information is not considered as a statutory invention.

(Example 1)
An audio compact disc where the feature resides solely in the music recorded thereon, computer program listings, and image data taken with a digital camera, etc.

However, if the technical feature resides in the presentation of information, the presenting per se, the means for presentation and the method for presentation, might be considered as a statutory invention.

(Example 2)
A plastic card on which information is recorded with letters, numbers and signs embossed on it (a technical feature residing in the means for presentation)

4.1.7 Aesthetic creations

An aesthetic creation may contain a visionary feature as well as a technical feature. Therefore, its evaluation is subjectively made. An aesthetic creation itself (e.g. paintings and carvings as such) is not considered as a statutory invention. However, if the aesthetic creation is achieved by technical composition or other technical means, they are viewed as a statutory invention.

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4.1.8 Computer programming language or computer program

A computer program is a mere list of orders to have a computer operated. Therefore, a computer program is not considered as a statutory invention. However, in the case of an invention where data processing with a computer program is specifically executed using a hardware, a data processing unit (machine) operating in association with the computer program, its operating method, and a computer readable medium carrying the computer program, the invention is viewed as a statutory invention.

4.1.9 Those whose outcome of the claimed subject matter is not achievable

An invention whose outcome of the claimed subject matter is not achievable and reproducible is not considered as statutory, even if the means to achieve the goal of the invention is sufficiently described. It does not mean that the possibility of reproduction of a filed invention should account for 100%. Even with less than 100% possibility, it is construed that the invention can be reproduced if it is certain that the outcome is achievable.

4.1.10 Incomplete Invention

A statutory invention shall be complete and a complete invention is defined as an invention in which the subject matters shall be specified clearly and thoroughly objectively so that a person with ordinary skill in the art to which the invention pertains may easily replicate the invention to achieve the intended technical effect. The decision on whether an invention is complete shall be made by considering the invention as a whole such as its purpose, subject matters and operational effects of the invention indicated in the specification of patent application in accordance with the state of the art at the time of filing.

If a subject matter lacks concrete means to solve the problem to be solved or if it is clearly impossible for the subject matter to solve the problem to be solved by any means presented in a claim, the claimed invention is not considered as statutory. However, in this case, the inventor can verify that the claimed invention solves the problem to be solved by means presented in a claim with appropriate and concrete evidence such as reliable experimental data of third parties.

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As one of the requirements to gain a patent right, an examiner should distinguish between the requirement of completing an invention and that of satisfying the description requirement. An incomplete invention or an invention yet to be completed at the time of filing cannot be amended later to correct the defect after the application is filed. However, in the case of deficiency in the description, it is possible to correct the defect through the amendment because deficiency in the description applies to an invention which has improper description but is considered complete at the filing. Therefore, if it is unclear under which case the invention falls, it is desirable to preferentially notify the reason for refusal under Article 42(3)**(i) of the Patent Act.**

4.2 Notification of reason for refusal in the case of non-statutory invention

If an application falls under the scope of the non-statutory invention such as a law of nature, discovery, subject matters against the law of nature, subject matters not using the law of nature, mere presentation of information, aesthetic creations or incomplete invention, the reason for refusal shall be notified with the reason that the invention does not involve "inventions that have industrial applicability", citing the main paragraph of Article 29 paragraph (1).

4.3 Difference between statutory invention under Patent Act and device under Utility Model

Under the Patent Act Article 29 paragraph (1), the device (including a composite) and method can be a patentable subject matter. However, under the Utility Model Act Article 4 paragraph (1), a utility model may be granted only for devices that relate to the shape or construction of article or a combination of articles.

4.3.1 Article under the Utility Model Act

There is no definition prescribed about an article or articles described in Utility Model Act Article 4 paragraph (1). However, it is construed that a subject matter is generally considered as articles under Utility Model Act on condition that it is the object for trade having the shape in the space and the purpose of its use is clear.

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The simple explanation about the shape or construction of an article or a combination of articles are as follows:

(1) Shape

"Shape" is external figuration expressed in the line, the surface, and so on. For example, the shape of the cam or the tooth shape of the gear etc.

(2) Construction

"Construction" is a construction constructed spatially and 3-dimensionally. It is expressed in the contour of articles. It is also shown in a ground plan and an elevation view, and in some cases a lateral view or a cross section diagram. A circuit of electronic products may be deemed to be an article under Utility Model Act.

(3) Combination

Two or more articles are spatially separated respectively which is not related whether being used or not, have independently fixed construction or shape, and moreover, show the use value for relating to each other functionally by using those, that is called "combination." For example, the fastening tools which consist of a bolt and a nut are a kind of combination.

4.3.2 Devices not relating to the shape or construction of an article or a combination of articles

A device of which the category is a process, a device of a composition, a device of chemical material, a thing which is not fixed in a certain shape, animal variety, plant variety do not fall under the scope of a statutory device under Utility Model Act.

(Reference)
If an independent claim is a device regarding the shape or construction of an article or a combination of articles and dependent claims define a material of the subject matter of the

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independent claim, We consider the dependent claim as the device relating to the shape or construction of an article or a combination of articles.

5. Industrially inapplicable invention

The following is a list of 「industrially inapplicable inventions」. However, upon noticing that a claimed invention does not meet the requirements for industrial applicability, the ground should be indicated as specifically as possible in the notification of reasons for refusal.

5.1 Medical practice

(1) List of industrially inapplicable inventions

① A method for treatment of the human body by surgery or therapy and a diagnostic method practiced on the human body are considered to be industrially inapplicable inventions. A surgical method on the human body by means of such a surgical device (e.g. scalpel) or a method for treatment of the human body with a medicinal substance, other than medical activities by medical doctors (including oriental doctors) or someone directed by medical doctors, is considered as medical activities.

② A method including medical activities even in one as the part of the whole step or as indispensible parts in claims is not considered as industrially applicable.

③ A method having surgical operations whose purpose is both therapeutic and non-therapeutic (e.g. cosmetic effects) or a method having surgical operations in which it is difficult to separate the therapeutic effect from non-therapeutic effect is considered as a method for treatment of the human body by surgery practiced on the human body. Therefore, such method is not considered as industrially applicable.

(2) List of Industrially Applicable Inventions

① A medical device to be used in the operation practiced on the human body or to be used in medical cure and diagnosis, and medical products as such are considered to be

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classified as industrially applicable.

② A method for operating a medical device or a measurement method with the medical device, when the medical device is newly invented, is considered as industrially applicable except when the method includes mutual reactions between a human body and a medical device and practically medical activities.

③ A method for treating samples that have been extracted from a human body (e.g., blood, urine, skin, hair, cells or tissue) or discharged from a human body (such as urine, excrement, placenta, hair and nail) and a method for gathering data by analyzing such samples are considered to be industrially applicable on the assumption that they are composed of separate steps separable from medical practices.

(3) Matters to be attended to in examining inventions including medical practices

Even if it is possible for a method of treatment to be used for treatment, surgery or therapy on the human body, the method is considered to be industrially applicable if the method is limited to be practiced on the animal body excluded from being practiced on a human body.

5.2 Inventions that cannot be commercialized

An invention only for personal use, academic or experimental purposes is regarded as industrially inapplicable. On the other hand, despite inventions indicated above, an invention concerning marketable or tradable subject matter is considered industrially applicable.

5.3 Inventions that cannot be implemented

An invention which cannot be implemented or practiced is not considered as an industrially applicable invention even if it works in theory.

(Example 1)
A method for preventing an increase in ultraviolet rays associated with the destruction of the ozone layer by covering the whole earth's surface with an ultraviolet ray-absorbing

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plastic film.

Even when an invention has not been used at the time of the filing, the invention is considered as industrially applicable if it is possible to be used in the industry in the future. Under the principle of law that the invention should be industrially applicable, it is sufficient that the invention be industrially applicable in the future. The principle of law here does not mean that the invention would be deemed to be industrially applicable if it is possible to be used in the industry only because the relevant technology is gradually advanced.

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Chapter 2. Novelty

1. Relevant Provisions

Article 29(1) of the Patent Act (Requirements for Patent Registration) Inventions that have industrial applicability are patentable unless they fall under either of the following sub-paragraphs:
(1) inventions publicly known or worked within or outside of the Republic of Korea before the filing of the patent application; or
(2) inventions described in a publication distributed in the Republic of Korea or in a foreign country before the filing of the patent application or inventions published through telecommunication lines as prescribed by Presidential Decree.

(Reference)
"inventions publicly known or worked in the republic of Korea" is revised into "inventions publicly known or worked within or outside of the Republic of Korea". The revision shows that the terms of being publicly known or worked is expanded to meet the global standard. The revised term is applied to applications filed on or after 2006.10.1.

2. Purport

The purport of the Patent System is to grant an exclusive right that is a reward for the disclosure of an invention. So, an invention already disclosed to the public shall not be given exclusive rights. Under the Patent Act Article 29 paragraph (1), prior to the filing of the patent application, (i) inventions publicly known, (ii) inventions worked (iii) inventions described in a publication, (iv) inventions published through telecommunication line as prescribed by President Decree do not involve novelty, and consequently they are not patentable.

3. Relevant Provisions

3.1 Publicly Known Invention

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「A publicly known invention」means an invention the contents of which have been known to an unspecified person without obligation of secrecy in the Republic of Korea or a foreign country prior to the filing of the application. The time of filing in the「prior to the filing of the application」 refers to the exact point of time of filing, even to the hour and minute of the filing(if the invention is publicly known, the time is converted into Korean time). It does not mean the concept of the date of filling.「unspecified persons」refers to the general public who does not need to abide by secret observance duty.

(Example 1)
If an application is not laid open and is not published after registration, the invention of said application shall not be used as prior art under Article 29 paragraph (1) subparagraph (2) as the application is not a publication distributed in the Republic of Korea or a foreign country before the filing of the patent application. However, even if there is no publication of registration, the application shall be used as prior art under Article 20 paragraph (1) subparagraph (1) after decision of registration, if the application is made available for public inspection.

3.2 Publicly worked invention

「A publicly worked invention」 means an invention which has been worked under the conditions where the contents of the invention are to be publicly known or can potentially be publicly known in the Republic of Korea or a foreign country (Definition of "working" refers to the Patent Act Article 2). Also,「being public」 means a situation where it is no longer kept in secret. So, even when a small fraction of inner part of an invention is kept in secret with regard to working of the invention, it shall not be considered as a publicly worked invention.

(Example 1)

Conditions where the contents of the invention are considered to be publicly worked include, for example, a situation where a person skilled in the art may easily understand the contents of the invention by observing the manufacturing process associated with the

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invention at a plant that is exposed to an unspecified person. Conditions where the contents of the invention can potentially be considered to have been publicly worked include, for example, a situation where, although inner parts of the manufacturing facility cannot be known to an unspecified person (a visiting inspector) by merely observing its exterior view and the person cannot know the invention as a whole without knowing that inner parts, the person is allowed to observe the inner parts or can have the inner parts be explained to the person. (i.e. the request for observation or explanation is not to be refused by the plant.)

3.3 Invention Described in a Distributed Publication

3.3.1 Distributed publication

A publication is "a document, a drawing or other similar medium for the communication of information, duplicated by printing, mechanical or chemical methods, etc. for the purpose of disclosing the contents to the public through distribution". A "Distribution" in the context of the wording "disclosing the contents to the public through distribution" means placing a publication as defined above in the condition where unspecified persons can read or see it. It does not necessitate the fact of a certain person's actual access to such a publication.

Patent gazettes such as microfilm or CD-ROM should be considered as a distributed publication, since the public could refer to the contents of the film by using a display screen and obtain a copy of it.

Meanwhile, non patent documents which are stored in floppy discs, slides or presentations as well as microfilm or CD-ROM should be regarded as distributed publication, as far as they are produced to make available to the public.

3.3.2 Distribution

「A distribution」in the context of the wording "inventions described in a distributed publication" means placing a publication as defined above in the condition where unspecified persons can read or see it. It does not necessitate the fact of a certain person's actual access to such a publication.

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3.3.3 Time of distribution

When the time of publication is indicated in a publication, it is presumed as follows:

① In the case the time of publication is indicated in a publication
(a) Where only the year of publication is indicated, the last day of that year;
(b) Where the month and year of publication is indicated, the last day of the month of the year; and
(c) Where the day, month and year of publication is indicated, that date.

② Where the date of publication is not indicated in a publication
(a) The distribution date of a foreign publication is presumed in light of the period normally required to reach Korea from the country of the publication, as far as the date of its receipt in Korea is clear.
(b) Where there is a derivative publication such as a book review, an extraction or a catalog, the date of distribution of the publication in question is presumed based on the publication date of the derivative publication.
(c) Where there is a second edition or a second print of the publication, the date of distribution is presumed to be the publication date of the first edition indicated therein, provided that the contents of the second edition accords with those of the publication.
(d) Where other appropriate information is available, the date of distribution is presumed or estimated there from.

(Example 1)
We already know that companies quickly access catalogues published by rival companies in order to acquire technical information of new products home and abroad, thanks to the advancement in transportation and thriving trade among countries. It is socially accepted idea that catalogues are distributed as soon as they are published. Therefore, the claim that the published catalogues have not been distributed but kept in storage is not acceptable from our experience. In this regard, we make a decision that catalogues are distributed prior to the filing of the application as long as the evidence of bringing the cited reference into the country before the filing of the application is concrete (Supreme court decision 1992. 2.

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14 1991 Hu 1410 sentence).

3.3.4 Invention described in a publication

「An invention described in a publication」 means an invention identified by the matters described or essentially described, though not literally, in a publication.
"Matters essentially described, though not literally, in a publication" means those directly derivable from the matters described, taking into consideration the common general knowledge.

(Example 1)
In order for a device to be described in a distributed publication, at least the structure of the device should be described. Therefore, if a device whose technical feature lies inside is merely exhibited in the form of photograph, it is not considered as a device described in a publication(Patent court 1992. 2. 14 1998 Heo 3767 sentence).

3.4 Inventions distributed to the public through telecommunication line

3.4.1 Purport

With the advancement of communication technologies such as the Internet, the number of technologies published over the internet has been dramatically increasing. It is suggested that we need to reflect the technological change on the patent system since technologies published on the internet can be considered as prior art in comparison with those released by the existing printed publication, with regard to public availability, propagation speed and the level of technology except for the possibilities that due to characteristics of internet, the date and the contents of the publication may be altered after publishing.

Considering that 「Printed Publication」under Article 29 paragraph (1) subparagraph (2) defined "copied documents, drawings and photographs which aims to be published through printing or the mechanical and chemical method" (Supreme court 1992.10.27 1998 Hu 3767 sentence), technologies published over the Internet has been considered as known technology defined in the Act Article 29 paragraph (1) subparagraph (1) not as the prior art

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stated in the printed publication defined in the Act Article paragraph (1) subparagraph (2).

Under Article 29(1)(ii) of the previous Patent Act (Act No. 6411, promulgated on February 3. 2001, taken effect on July 1, 2011), inventions available to the public over telecommunication lines designated by Presidential Decree can hold the same status as disclosed invention through publications.

Moreover, the recently-revised Patent Act (Act No. 11654, promulgated on March 22, taken effect on July 1, 2013) has deleted the phrase "designated by Presidential Decree" in Article 29(1)(ii) and inventions available to the public over all telecommunication lines are applied with Article 29(1)(ii) of the Patent Act.

3.4.2 General Principles of Citation of Invention available to the Public through Telecommunication line

The revised Patent Act (Act No. 11654, promulgated on March 22, taken effect on July 1, 2013) is only applied to patent application filed after July 1, 2013 and the previous Patent Act is applied to application filed before the date (Act No. 6411, promulgated on February 3. 2001, taken effect on July 1, 2011). Therefore, the provisions applied when citing the inventions disclosed over telecommunication lines as prior art are as follows by application date.

① Patent Application filed before June 30, 2013

Among the Government, local governments, the governments or local governments of foreign countries or international organizations under Article 1-2 of the Enforcement Decree of the Patent Act before the revision (the act before the revision by Presidential Decree No. 24645, June 27, 2013), national, public schools or national, public universities in foreign countries, national, public research institutes in the Republic of Korea or foreign countries, other corporations established to serve the purpose of performing patent-information related work, if inventions become available to the public through telecommunication lines operated by one of the corporations designated and announced by the Commissioner of the Korean Intellectual Property Office shall be cited as prior art under Article 29(1)(ii) of

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the Patent Act before the revision. However, inventions available to the public over telecommunication lines other than telecommunication lines designated under Article 1-2 of the Enforcement Decree of the Patent Act constitute inventions in the state possibly known to unspecified people in the Republic of Korea or foreign countries under Article 29(1)(ⅰ) of the Patent Act before the revision and therefore, they shall be cited as prior art under Article 29(1)(ⅰ) of the Patent Act before the revision. As for disclosures through telecommunication lines designated under Article 1-2 of the Enforcement Decree of the Patent Act before the revision and disclosures through other telecommunication lines, the content of disclosures, the possibility of recognition on the time of disclosure and recognition criteria are explained in 3.4.3 below.

② Patent Application filed after July 1, 2013

Where inventions are recognized to be available to the public through telecommunication lines, they shall be all cited as prior art under Article 29(1)(ⅱ) of the Patent Act. The content of disclosures through telecommunication lines, the possibility of recognition on the time of disclosure and recognition criteria are explained in 3.4.3 below.

3.4.3 Requirement for Information available to the public through telecommunication lines under Article 29 paragraph (1) subparagraph (2) to be cited as prior art

(1) Inventions publically known to the public through Telecommunication lines

A telecommunication line includes public bulletin board, e-mail group using a telecommunication line as well as internet. Moreover, a new electric or telecommunication method which would appear in the future as the technology advances, shall also be included.

Telecommunication lines do not always need to be physical lines. The term telecommunication means transmission or reception of code, words, sound or image through wired, wireless, optic, or other electro-magnetic processes.

Information made available to the Public through a CD-ROM or a Diskette shall not be

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considered publication of technology through telecommunication lines but considered publication of technology through distributed publication.

(2) Invention Made Available to the Public

In order to cite an invention publically known to the public through telecommunication lines as prior art as in the case of the printed publications, the invention shall be "the one available to the public".

The "public" means an unspecified person who does not have to keep an invention secret and "available to the public" means the state in which the invention can be seen by an unspecified person, and "available to the public" does not require actual access of the invention.

Even if an invention is published through telecommunication lines in a case where the invention is only accessible by a specific person and the invention is restricted to the public, the invention is not considered as being available to the public.

To determine whether information is an invention made available to the public, one needs to decide whether the information is made available on a Web site with a general search engine or whether the Web Site is encoded in such a way that it cannot generally be read. Only where information is considered as being available to the public, it can be cited as a prior art.

(3) Telecommunication lines designated under Article 1-2 of the Enforcement Decree of the Patent Act before the revision (the act before the revision by Presidential Decree No. 24645, June 27, 2013)

As for patent application filed before June 30, 2013, only inventions disclosed through telecommunication lines designated by Presidential Decree shall hold the status of prior art identical with inventions disclosed in publications. Telecommunication lines designated under Article 1-2 of the Enforcement Decree of the Patent Act before the revision mean telecommunication lines operated by a person who falls under any of the following cases.

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(Even for patent applications filed after July 1, 2013, an invention disclosed over telecommunication lines operated by a person who falls under any of the followings shall hold the status of the prior art identical with the invention disclosed in publications.)

① Governments, local governments, foreign government, foreign local governments or international organizations.

Whether a certain entity falls under government or local government under enforcement decree of the patent act, relies on national government organization act or local government law.

Whether a certain entity falls under foreign government or foreign local government relies on its related Act and subordinate statute of each foreign country. For example, the telecommunication lines owned by the Korean Intellectual Property Office (hereinafter refers to KIPO) especially, cyber bulletin is a typical electric communication line under Article 29 paragraph (1) subparagraph (2).

KIPO has granted the same status on inventions disclosed on Website owned by KIPO as the inventions opened in the publication to be cited as prior art, thus publishing inventions on the Internet as well as in a CD-ROM or written form in a faster and more economical way becomes possible. Under the former Patent Act, KIPO is required to publish all inventions only in a CD-ROM or written form to include those among prior arts. Under the current Patent Act, KIPO grants the same status of prior art on the inventions disclosed on the Internet as prior art in publications.

Also the term "International organization" is defined to include intergovernmental organizations but does not include nongovernmental organizations such as Asian Patent Attorneys Association. Intergovernmental Organization includes the United Nations, World Intellectual Property Organization(WIPO), World Trade Organization (WTO) and the European Union as well as regional patent offices such as European Patent Office, African Intellectual Property Organization, OAPI and African Regional Industrial Property Organization, ARIPO.

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② National/Public schools under the Higher Education Act or foreign National/Public universities

National/public schools under Higher Education Act Article 3 refer to national schools established and run by government or public schools established and run by local self-governing groups among schools for providing higher education under Higher Education Act Article 2 (universities and colleges such as industrial college, education college, specialized college, communication college, technological college and others)

Whether a certain college falls under "foreign national/public university" relies on its related Act and subordinate statute of each foreign country.

③ National/public research institutes in our country or foreign country

National/public research institutes in our country include research institutes including the inspection center and laboratory run by local self-governing group or government-sponsored research institutes.

Whether a certain institute falls under foreign national/public research institutes, relies on its related Act and subordinate statute of each foreign country.

④ Corporation designated and publically notified by the Commissioner of Korean Intellectual Property Office

Korea Invention Promotion Association(KIPA) and Organization for Data Management Center (Korea Institute of Patent Information) are designated as "Corporations established to conduct patent information and related works" of Enforcement Decree of the Patent Act Article 1bis subparagraph (4) under public notification about managing the telecommunication line corporations regarding patent information (KIPO Directive No. 2011-21). Korea Invention Promotion Association(KIPA) and Korea Institute of Patent Information conduct delegated affairs offered by Korean Intellectual Property Office and both of the corporations are managed and governed by Korean Intellectual Property Office. Thus, the information from telecommunication line used in those corporations is reliable.

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(4) Recognition of Disclosure Content and Disclosure Time

Since data disclosed on websites can be easily updated and, in principle, its content and date can be changed later, whether the examiner can recognize that the content disclosed in searches over websites, etc. has been laid open on the indicated disclosure date is in question.

To cite prior art to notify a ground for rejection based on lack of novelty and inventive step, in principle, the examiner shall present evidence of the fact that the concerned prior art has been published. This shall apply to the case for prior art laid open through telecommunication lines. In order to recognize that the content disclosed over telecommunication lines has been laid open at the indicated disclosure time, the matter to be reviewed by the examiner varies based on the type of telecommunication lines on which the concerned information is laid open as in the following cases:

ⅰ) Since a telecommunication line defined under Article 1-2 of the Enforcement Decree of the Patent Act before the revision may be deemed to hold credibility to a certain level, if the disclosure content and time of an invention can be found on websites, etc. over the telecommunication line, the examiner can use the invention as prior art without additional confirmation procedure.

ⅱ) Even though a telecommunication line does not constitute any of the telecommunication lines defined under Article 1-2 of the Enforcement Decree of the Patent Act before the revision, but it is operated by Korean or foreign academic institutions, international non-governmental organizations, public institutions, private universities, publishers of periodicals such as newspapers or magazines or TV or radio broadcasting stations for the purpose of their own work so that no question is raised as to the disclosure content and time based on the awareness of the general public and the operation period, the examiner may accept the disclosure content and time of the invention on the website of the telecommunication line without additional confirmation procedure.

ⅲ) In the case of disclosure through a telecommunication line except for the lines

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mentioned above ⅰ) and ⅱ), the examiner shall first the credibility of the disclosure content and time of the invention considering the awareness on the telecommunication line among the general public, use frequency by the general public, credibility of operator, operation period, etc. If the disclosure of an invention is deemed to be credible based on the review, the invention can be cited as prior art. In such a case, the examiner shall indicate the logical ground for credibility of the concerned disclosure in a written notification of submission of opinion. However, where the credibility of the disclosure of the invention is in doubt, the invention can be cited as prior art only when any doubts as to the disclosure content and time are addressed through confirmation of the actual date of disclosure of the invention on the website. To check the actual disclosure date, the examiner may ask a person in charge of information disclosure on the concerned telecommunication line to confirm the disclosure, or use the data on the content and disclosure on the website run by the U.S. non-profit organization Internet Archive, www.archive.org.

The disclosure time on the telecommunication line is the point of time when the concerned invention is disclosed on the telecommunication line. Therefore, even when the already-distributed publication is disclosed through the telecommunication line, if the invention disclosed on the telecommunication line is cited, the disclosure date of the invention shall be the point of time when the invention is disclosed on the telecommunication line.

3.4.4 Method of Citation

In the case of citing electronic technical information retrieved from the telecommunication lines, the bibliographical items such as author, title, name of publication and pages (or drawings and graph) about the electronic technical information, as far as they have been known, shall be listed in the following order in compliance with WIPO Standards ST.14.

But, if a cited documentation is patented and the patented documentation is published through the Internet, an examiner is allowed to describe the cited documentation in the same way as patent official gazettes in the form of CD-ROM without having to describe the date of searching and website address.

3.4.5 Matters requiring attention in applying guidelines

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(1) Treatment of other websites hyper-linked from websites

The telecommunication lines under Article 1-2 of the Enforcement Decree of the Patent Act or well-known and long-operated telecommunication lines run by academic institutions, public institutions, publisher of periodicals, etc. are deemed reliable. However, other websites hyper-linked through the telecommunication lines shall not be considered to be the telecommunications defined under Article 1-2 of the Enforcement Decree of the Patent Act. It is because its credibility regarding the time of disclosure cannot be guaranteed since the website is run by other entities.

(2) Instruction on Examination of Applications filed before June 30, 2013 and after July 1, 2013

As explained earlier in 3.4.1, where the disclosure through telecommunication lines is used as prior art, applications filed before June 30, 2013 shall be applied with Article 29(1)(ⅱ) or (ⅰ) of the Patent Act before the revision, whereas applications filed after July 1, 2013 shall be applied with Article 29(1)(ⅱ) of the Patent Act.

To be specific, in the case of disclosures through telecommunication lines defined under Article 1-2 of the Enforcement Decree of the Patent Act before the revision, applications filed before June 30, 2013 are cited as prior art under Article 29(1)(ⅱ) of the Patent Act before the revision. Also, applications filed after July 1, 2013 shall be cited as prior art. Where disclosures are made through well-known and long-operated telecommunication lines run by academic institutions, public institutions, publisher of periodicals, etc. or other telecommunication lines(only reliable lines or lines where the actual disclosure dates are confirmed), applications filed before June 30, 2013 shall be cited as prior art under Article 29(1)(ⅰ) of the Patent Act before the revision and applications filed after July 1, 2013 shall be quoted as prior art under Article 29(1)(ⅱ) of the Patent Act.

Therefore, which article of the Patent Act is applied to notify a ground for rejection to disclosures of telecommunications depends on the application date because of the revision of the Patent Act. However, the criteria of determining which telecommunication line can be

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used to confirm disclosure content and time so that the disclosed invention can be used as prior art are technically the same regardless of application dates.

This can be summarized in the following table.

<table>
<tr><td rowspan="2"></td><td rowspan="2">Disclosure through telecommunication line under Article 1-2 of the Enforcement Decree of the Patent Act before the revision</td><td rowspan="2">Disclosure through telecommunication lines run by academic institutions, public institutions, publisher of periodicals, etc. (where no question is raised considering awareness among the general public and operation period</td><td colspan="2">Disclosure through other telecommunication lines</td></tr>
<tr><td>Where credibility is recognized or actual disclosure date is confirmed</td><td>Where credibility is in doubt</td></tr>
<tr><td>Application filed before June 30, 2013 (applied with the Patent Act before the revision)</td><td>Cited as prior art under Article 29(1)(ii) of the Patent Act before revision</td><td colspan="2">Cited as prior art under Article 29(1)(i) of the Patent Act before revision</td><td>Not cited as prior art</td></tr>
<tr><td>Application filed after July 1, 2013 (applied with the revised Patent Act)</td><td colspan="3">Cited as prior art under Article 29(1)(ii) of the Patent Act before revision</td><td>Not cited as prior art</td></tr>
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(3) Examination where opposition regarding disclosure through telecommunication lines is raised by applicant

As for citing the invention disclosed through telecommunication lines as prior art, the examiner shall consider any ground or evidence which raises questions on accessibility by the general public, disclosure content, disclosure time, etc. presented by the applicant.

Where credibility of the concerned telecommunication line or the recognition of the actual disclosure date on the telecommunication line has become doubtful because of evidence, etc. on the disclosure content and disclosure time presented by the applicant, the examiner shall search additional evidence to confirm the disclosure. If the examiner cannot find such additional evidence, the invention disclosed on the telecommunication line cannot be cited as prior art. However, if the applicant fails to present specific evidence and just argues that the telecommunication line is not reliable, the examiner does not need to consider it.

4. Determination of Novelty

(1) The examiner shall determine whether or not a claimed invention is novel by judging whether the claimed invention falls under the inventions categorized in the provision of Article 29 paragraph (1) subparagraph (1) to (2). If a claimed invention falls under the inventions categorized in the provision of Article 29 paragraph (1) subparagraph (1) to (2), the invention is not novel. If a claimed invention does not fall under the inventions categorized in the provision of Article 29 paragraph (1) subparagraph (1) to (2), the invention is novel.

(2) The claims must describe the subject matter for which protection is sought. (Article 42 paragraph (4)) So, the decision over the identicalness of invention is determined by the identicalness of the matters described in the claims

(3) When there are two or more claims in an application, the determination over novelty should be made by each claim.

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4.1 Defining invention disclosed in claims

4.1.1 General principle of defining inventions

(1) When the claim statements are clear, defining the claimed invention should be made as stated in the claim. The terminology described in the claims are interpreted as having a general meaning and scope generally accepted in the technical field with the exception of the case wherein the terminology has a specific meaning which is explicitly defined in the description. The terminology should be interpreted in an objective and reasonable way by taking into consideration of its technical meaning, taken together with the common general knowledge at the time of filing, based on the general meaning of the terminology.

(2) Where the description of claims is clearly understood, an examiner should avoid limited interpretation just by referencing the detailed description of the invention or drawings in finding technical features of invention.

Where the subject matters are not described in the claims but in the detailed description of invention or drawings, an examiner should interpret the invention as not being described in the claims. On the contrary, where the subject matters are described in the claims, an examiner should consider the subject matters in claims when interpreting an invention.

It is possible to consider the detailed description of invention or drawings in understanding the subject matters disclosed in the claims but it is noted that an examiner should not examine the claims by applying subject matters not described in the claims. For example, where the subject matters described in the claims are more comprehensive than embodiments in the detailed description, novelty and inventive step should not be determined by interpreting the specific embodiments described in the detailed description as the claimed invention.

(Example 1)
In a case where 'cream' is described in the claims and 'the highly preserved cream which contains less moisture than bean-paste' is disclosed in the detailed description as an embodiment, as the term 'cream' generally refers to fat taken from milk, regardless of

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content of moisture, the claimed invention should not be interpreted to be limited to the embodiment of the detailed description since a person skilled in the art can clearly understand the term.

(Example 2)
In a case where 'thin film type probe' is described in the claims and 'a certain pattern is formed on the tip of the probe in the longitudinal direction' is disclosed in the detailed description, the claimed invention should not be interpreted to be limited to the certain pattern formed in the tip of the probe in the detailed description since the claimed invention is clearly defined as 'thin film type probe'.

(Example 3)
In a case where the rotation direction of brush roller is not disclosed in the claims but the subject matters of brush roller which rotates around a body of rotation is found in the drawings, the claimed invention should not be interpreted to be limited to the rotation direction of brush roller just by referring to the rotation direction described in the drawings.

(3) In a case where an applicant specifically defines a term in the detailed description to the extent that it is clearly understood that the term is different from any general meaning, in order to specify the term as a specific meaning not as general meaning in the technical field to which an invention pertains, the term is interpreted as a term with the specific meaning.
However, only the description of the specific concept of the term in the claims in the detailed description and drawings, does not fall under the specific definition aforementioned.

(Note)
A term in a patent specification is interpreted with the general meaning in the technical field and should be unified over the whole specification. However, if an applicant intends to use a certain term to have a specific meaning, an applicant is allowed to define the meaning of the term. So, the term can be simply interpreted according to the specific definition when the meaning of term is defined in the description(Supreme court 1998.12.22 97 Hu 990 Sentence).

(4) In a case where a term disclosed in the claims is obscure and unclear, an examiner

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should examine whether the claimed invention can be grasped in view of the detailed description, drawings and common general knowledge as of the time of filing. If the invention can be grasped, the examiner can notify the applicant reasons of refusal on deficiency in describing specification and novelty collectively.

(5) If a claimed invention is not clear, even in view of the detailed description in the specification, the drawings and the common general knowledge as of the time of filing, examination of novelty is not conducted and the reason for refusal due to the deficiency of the detailed description is notified.

4.1.2 Principle of defining invention which includes special expression

(1) A product specified by its work, function, property, or characteristic (hereinafter referred to as the function, characteristic, etc.)

When describing claims, it is possible to state the structure, method, functions, materials or a combination of these factors for the purpose of clarifying which matters are subject to protection. When function, characteristic, etc. are disclosed in the claims to limit the subject matters of the claimed invention, an examiner should not exclude the function, characteristic, etc. from the features of the invention when interpreting the claims. When a claim includes an expression specifying a product by its function, characteristic, etc. such an expression should, in principle, be construed as every product that has such function, characteristic, etc., except when it should be construed otherwise because the expression is specifically defined in the detailed description. However, it is noted that there are also cases where a product described by its function, characteristic, etc. should not be construed as a specific product among all products that have such function, characteristic etc. by taking into account the common general technical knowledge at the time of the filing.

(Example 1)
In a case where 「means to selectively join plastic materials」is disclosed, it is appropriate that 「the means to selectively join」 mentioned here should not apply to materials such as magnetics which is difficult to join with plastic material.

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(2) The claim which includes an expression specifying a product by its use (limitation of use)

Where a claim includes an expression specifying a product by its use (i.e limitation of use), the examiner should interpret the claimed invention only as a product specially suitable for the use disclosed in the claim, by taking into account the detailed descriptions in the specification and drawings and the common general technical knowledge at the time of the filing. Even if a product includes all technical characteristics described in the claims, an examiner should not regard the product as the product described in the claim when the product is not appropriate for the relevant use or when the product needs conversion to be used. For example, 「crane hook with a shape of ~」merely indicates hook includes technical features with size and strength suitable for crane. So it is appropriate that the crane hook should be construed as a different product from 「fishing hooks」with regard to the structure.

If a product with a limitation of use is not suitable for such use by taking into account the specification, drawings and the common general technical knowledge at the time of the filing, it is construed that a limitation of use has no impact in specifying an invention, thereby the limitation of use does not have influence in the determination of novelty.

(Example 1)
Where an embossing non woven fabric used in agriculture with limitations of weight and thickness is described in the claim and an embossing non woven fabric with the same numerical limitations is disclosed in a catalogue published prior to the time of filing, if it is considered that the claimed invention is not particularly suited to be used in agriculture, a limitation of use does not have influence in defining the claimed invention thus negating novelty based on the cited inventions in the catalogue.

(3) A product defined by its manufacturing process (product-by-process claim)

A product invention should be described in such a way that the technical constitutions are directly stated in the claim, even if the manufacturing process of the product is disclosed in the product claim. Thus, an examiner should compare the claimed product itself defined by the description of the claim with a prior art published prior to the time of filing when determining novelty and inventive step, unless there is a special reason in the description of

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the claim. The special reason aforementioned should only be accepted by the Examiner in extremely exceptional cases such as when it is greatly difficult to define the product in the ordinary way in the relevant technical field.

Where a claim includes a statement defining a product by its manufacturing process, such a statement is construed as meaning a product per se unless it should be construed as different meaning according to the definition in the detailed description. If an identical product can be obtained by a different process from the one stated in the claim, the claimed invention is not novel where the product is publicly known prior to the time of filing. Thus, even if applicant's intention is to limit the claimed invention to only the product which is obtained by the particular process, such as a claim reading as "Z which is obtained solely by process A," the claimed invention should be treated in the same way aforementioned.

(Example 1)
In a case where 'panel formed by cutting process using a wave shaped blade of a knife' is described in the claims and the panel is the subject matter subject to protection, it is construed that there is no difficulty in directly specifying the structure of the panel in the technical field. It is appropriate to make a distinction between the panel defined by its manufacturing process and the claimed invention without taking into account of the manufacturing process. When comparing the claimed invention and the cited invention, both inventions show the same wave or cloud shape on the striped surface in the natural form. Therefore, the claimed invention is regarded as the same invention with the cited invention.

(4) Claims divided by the preamble and the body (Jepson type claim)

Even in the case of Jepson type claim which divides claims by the preamble and the body, an invention should be specified as a whole including the preamble because the type of claims does not change the technical scope.

However, the subject matters described in the preamble are not considered to be publicly known just because of the fact that the subject matters are described in the preamble. The

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reason is that whether the subject matters in claims are publically known before the time of filing is a matter of facts and the claim type does not show that the matter of facts has occurred. Even if all subject matters described in the preamble are publically known, it is not appropriate to compare only the subject matters of the rest of the body with a prior art because the technical idea of the whole invention including the publically known subject matters of the preamble is the subject matter in determining patentability.

(Example 1)
Where the subject matters described in the body of the Jepson type claimed invention are anticipated in the cited invention but the subject matters of the preamble such as spark plug, ventilator are not described in the cited invention, it is not appropriate that said spark plug and ventilator are treated as publically known just because those are shown in the preamble. Moreover, an object of determining the patentability is the technical idea of the claimed invention as a whole body which includes the preamble. So, an examiner should not negate novelty based on the cited invention which does not include the technical features of the preamble.

(Note)
In the case of the description type which divides claims by the preamble and the body (the type called Jepson type claim), the preamble can be construed as various meanings such as ① limiting the technical field of inventions ② limiting the product applied by the technology of invention ③ excluding the scope of the right protected given that the invention is publically known. The body which is combined with the preamble is the technical characteristics of the claimed invention subject to protection.

4.2. Finding of a cited invention

Finding an invention cited in determining novelty (hereinafter referred to as "cited invention") under the Patent Act Article 29 paragraph (1) subparagraph (1), (2) are as follow.

4.2.1 Publically Known Invention

A "publicly known invention" means an invention the contents of which have been known to

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an unspecified person without obligation of secrecy in the Republic of Korea and a foreign country before the filing of an application. Finding a cited invention is basically carried out based on the matters publically known. Taking into consideration the common general knowledge as of the filing, if a person skilled in the art can easily arrive at the matters described in the invention, the matters are considered as being publically known.

(Reference)
The common general knowledge means technologies generally known to a person skilled in the art (ex, well known art or commonly used art). "Well-known art" means technologies generally known in the relevant technical field, e.g., those appeared in many prior art documents, those widely known throughout the industry, or those well-known to the extent needless to present examples. "Commonly used art" means well-known art which is used widely.

4.2.2 Publicly Worked Invention

A "publicly worked invention" means an invention which has been worked under the conditions where the contents of the invention are to be publicly known. Therefore, it is enough to decide whether the invention is publically worked without determining whether the invention is publically known.

"A publicly worked invention" means an invention which has been worked under the conditions where the invention is or can potentially be publicly known to an unspecified person through the medium of machinery or systems, etc. Therefore, the finding an invention can be carried out on the basis of the subject matters embodied in machinery or systems, etc. The matters directly derivable from the facts in view of the common general knowledge as of the working can also be a basis for the finding of a publicly worked invention.

4.2.3 Invention Described in a Distributed Publication

"An invention described in a distributed publication" means an invention which is or potentially be described in a publication. Being potentially described in a publication means

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that a person skilled in the art can easily recognize the invention. Such an invention can be considered as an invention described in a distributed publication.

4.2.4 General considerations in finding cited inventions

A manuscript for a journal of an academic society, in general, is usually kept secret against a third party, even after the receipt of the manuscript by the academic society. Therefore, the invention described in that manuscript is not considered a publicly known invention until its contents are released.

A company produces a catalogue to promote the company or to introduce and promote its products. Therefore, if the catalogue is produced, the catalogue is considered as a publication except when the catalogue is not published due to special circumstances.

Where the filing date of a patent application is the same as the date of the publication, the claimed invention does not lose novelty under Article 29 paragraph (1) subparagraph (2) of the Patent Act, except when the filing time of application is clearly after the time of publication.

The time of publication of a thesis is the time when the thesis is distributed to an unspecified person in public or university libraries after the final thesis examination, except when the contents of the thesis are announced in an open space before the final thesis examination.

4.3 Method of Determining whether a Claimed Invention is Novel

The determination of novelty of a claimed invention is conducted by comparing the matters defining the claimed invention and the matters disclosed in the cited invention and extracting the difference between them. Where there is no difference between the matters defining a claimed invention and the matters disclosed in the cited invention, the claimed invention is not novel. Where there is a difference, the claimed invention is novel. The claimed invention is not novel when it is substantially or exactly identical to the cited invention.

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「The substantially identical invention compared with prior arts」 means that there is no newly produced effect because the difference in the concrete means for solving problems is caused by mere addition, conversion or deletion of well-known or commonly used art and the difference between the claimed invention and the cited invention does not practically affect the technical idea of the claimed invention.

4.3.1 Determining Novelty on Invention with Numerical Limitation

An invention with a numerical limitation means that some part of the subject matters of an invention described in the claims is defined by specific numerical values. Where an invention in the claims includes a numerical limitation, a claimed invention is regarded as being novel when the claimed invention is not identical to the cited invention even when the numerical limitation is not considered.

When a claimed invention is identical to the cited invention except for numerical limitation, the determination of novelty comes under the following criteria.

(1) In a case where no numerical limitation is found in the cited invention while new numerical limitation is included in the invention described in the claims, the invention is regarded as novel. However, if the numerical limitation can be chosen by a person skilled in the art or it can be hinted in a cited invention in view of the common technical knowledge, novelty of the invention is denied in general.

(2) In a case where the numerical range of the invention described in the claims is included in the numerical range disclosed in a cited invention, it does not negate novelty and the invention can be regarded novel by the criticality of the range of the numerical limitation. For the criticality of the range of the numerical limitation to be acknowledged, a remarkable change in the effect of the invention is required across the boundary of the numerical limitation and the following condition should be satisfied: 1) The technical meaning of the numerical limitation should be described in detail, 2) the embodiments in the detailed description or supplemental materials should prove that the range of the numerical limitation is critical. Generally, it should be objectively confirmed that the range is critical

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with experimental results which cover all range of the numerical limitation.

(3) In a case where the numerical range of invention described in the claims includes the numerical range of the cited inventions, novelty can be denied at once.

(4) In a case where the numerical range of the claimed invention is different from that of cited invention, novelty is regarded novel in general.

4.3.2 Determining Novelty in Parameter Invention

(1) A parameter invention is an invention in which an applicant arbitrarily creates a certain parameter which is not the standard or commonly used for a physical-chemical characteristic value, parameterizes it arithmetically by using the correlation between the plural parameters, and employs it as a part of essential element of the invention. Since a parameter invention may not precisely define the subject matter with the description of the claim itself, determination of the inventive step of the parameter invention should be performed only after figuring out the subject matter based on the detailed description, drawings and common knowledge.

(2) Novelty regarding a parameter invention is determined by interpreting the parameter itself as part of the claims, but it is important that novelty cannot be confirmed just because the parameter described in the claims is regarded as being novel. Novelty regarding an invention described in the claims is denied in general if limiting the invention with the parameter just experimentally identifies nature or characteristics of a publically known product or there is a change just in expression by using parameter.

(3) In a parameter invention, if there is a 'reasonable doubt' that the claimed invention and the cited invention are identical, an examiner can wait written arguments or a certificate of experimental results after notifying the reason for refusal on novelty without comparing strictly the claimed invention with cited references because generally it is hard to compare the claimed invention with cited invention regarding determining novelty on parameter invention. If the reason for refusal is no longer kept by the applicant's arguments the reason for refusal is dissolved. But if the reasonable doubt is not dissolved, an examiner should

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decide the refusal of patent with regard to novelty.

(4) An examiner might have aforementioned reasonable doubt in the following cases: ① In a case when the parameter described in claims is converted with different definition and measurement method, and then the claimed invention is found to be identical with the cited invention. ② In a case when an examiner evaluates the parameter of a cited invention according to the measurement method in the description and obtains the same subject matter as that of claimed invention. ③ In a case when an embodiment in the detailed description of the claimed invention is identical to that of the cited invention.

(5) In a case when an examiner notifies the reason for refusal of a parameter invention, the examiner has to concretely describe the ground of reasonable doubt, and if necessary, the examiner can propose a way to overcome the grounds of rejection.

(6) The examination criteria described in (1)-(5) are not applied to a claimed invention when the parameter of the claimed invention is standard, commonly used or proved to be easily understandable by a person skilled in the art.

4.4 General considerations in determining novelty

(1) If an invention described in the claims and the cited invention are expressed in a generic concept or a specific concept, the following items should be considered in determining novelty:

① If an invention described in the claims is expressed in a generic concept and a cited invention is expressed in a specific concept, the invention in the claims is not novel. "Generic concepts" is defined as concepts integrating matters in the same family or the same genus, or a concept integrating a plurality of matters with the common characteristic.

(Example 1)
If a claimed invention is described as metal and a cited invention is described as Cu, the claimed invention is not novel.

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② If a claimed invention is expressed in a specific concept and a cited invention is expressed in generic concept, the claimed invention has novelty. However, when an invention expressed in a specific manner can be directly derived from such a generic invention in consideration of the common general knowledge, the claimed invention's novelty is denied by defining an invention expressed in specific concept as a cited invention. An invention expressed in a specific concept cannot be derived from the inventions expressed in a generic concept, even if the invention expressed in a specific concept simply belongs to a generic concept or the elements of the specific concept can be presumable in the terms in generic concept.

(Example 1)
Silver is described in the claim as a superconducting cable material for electric power transmission and a cited documentation discloses a superconducting metal cable. If using silver as a cable material to activate super conductivity in the field of electric power transmission belongs to commonly known art, novelty of the claimed invention can be negated, as a person skilled in the art can conceive superconducting silver cable without undue difficulty.

(2) In determining novelty, the comparison shall not be conducted between a claimed invention and a combination of two or more cited inventions. Determining patentability by a combination of two or more cited inventions is not related to novelty, but to inventive step. Except when a cited invention cites a distinct publication (ex: publication which provides detailed information of a technical feature, the distinct publication is regarded as a cited invention and able to be cited as determining novelty. When a dictionary and a reference are needed to interpret a term described in the cited reference, the dictionary and the reference are regarded as a cited reference and can be cited.

(3) If one or more inventions are described in a claim such as in a Markush type claim (multiple claims or features selectively cited or described, etc.), the reason of refusal can be notified on the ground that the invention does not involve novelty and an inventive step on each invention with one single prior art.

(4) In a case where there are more than two embodiments in a cited documentation, an

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examiner should not determine novelty by combining the two embodiments. Determining patentability through combination of cited embodiments is not a matter of novelty but inventive step. However, it is exceptional when one cited invention is obviously drawn from more than two embodiments in considering common general knowledge.

(5) Where the applicant admits the background technology to be publically known in a specification or written opinion, an examiner can determine novelty concerning a claimed invention by citing the background technology.

5. Inventions not considered to be publicly known

5.1 Relevant Provision

Article 30 of the Patent Act (Inventions not Deemed to be Publicly Known, etc.) (1) Where a person who has a right to obtain a patent files a patent application for an invention **within twelve months** (six months in case of filing date being earlier than March 15, 2012) of date on which the invention falls under any of the following sub-paragraphs, the invention is considered not to fall under any of the sub-paragraphs of Article 29 paragraph (1) when Article 29 paragraph (1) or (2) applies to the invention.

1. Where a person with the right to obtain a patent causes the invention to fall under either sub-paragraph of Article 29 paragraph (1); however, this provision does not apply where a patent application is laid open or a patent registration is published in the Republic of Korea or a foreign country under a treaty or law.
2. Where, against the intention of a person with the right to obtain a patent, the invention falls under either subparagraph of Article 29 paragraph (1).
3. Deleted.

(2) A person who intends to take advantage of paragraph (1) subparagraph (1) shall submit a written statement of that intention to the Commissioner of the Korean Intellectual Property Office when filing a patent application; the person shall also submit a document proving the relevant facts to the Commissioner of the Korean Intellectual Property Office, within thirty days of the filing date of the patent application.

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5.2 Purport of the system

Under Article 29 paragraph (1), a publically known invention before the filing of the application is not novel. However, under Article 30, even if an invention is published before the invention is filed to obtain a patent, where the necessary conditions is fulfilled, if the invention is not considered to be publically known, the invention cannot be cited as a prior art in determining novelty and inventive step under Article 29 paragraph (1), (2). Under the regulation, the date of filing is not applied retroactively.

The purpose of regulation is to encourage an applicant to obtain a patent even after he or she publishes his or her own invention and to encourage early publication of an invention to help development of the national industry.

The regulation was amended on 3 March 2006. The amendment benefits an applicant when he or she publishes an invention both in the Republic of Korea or a foreign country, except for the cases such as laying-open of application and publication of registration. The reason is that with the introduction of internationalism regarding publically known or used inventions, it is necessary to allow publically known or used inventions abroad to give benefits from the exceptional cases and that applicants tend to publish their thesis on the Internet not in the existing scientific journals.

Under the Patent Act revised on December 2, 2011 reflecting the Free Trade Agreement between the Republic of Korea and the United States of America (also known as KORUS FTA), the grace period for a public disclosure has been extended from 6 months from the date of public disclosure to 12 months. The grace period of 12 months shall apply to a patent application filed after March 15, 2012.

5.3 Requirements for inventions which are not considered to be publicly known

5.3.1 Where an invention is laid open by a person with the right to obtain a patent before the filing of the patent application

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(1) Although an invention is laid open by a person with the right to obtain a patent before the filing of the patent application, the invention is not considered to be publicly known if the invention falls under either subparagraph of Article 29 paragraph (1) as prescribed in Article 30 paragraph (1) subparagraph (1) and meets the following requirements:

(a) the invention is publicly known by a person with the right to obtain a patent
(b) the invention is filed by a person with the right to obtain a patent within twelve months (six months in case of filing date being earlier than March 14, 2012) of the date on which the invention is publicly known (if the date on which the invention is publicly known is unspecified, the first day of the month and year of a disclosure may be applied.);
(c) the purpose of being applied by the provision of Article 30 must be stated in the application; and
(d) documents proving the relevant facts must be submitted within thirty days of the filing date of the application.

(2) To be considered as inventions which are not considered to be publicly known before the filing of the patent application, the inventions must meet either of the subparagraphs of Article 29 paragraph (1) along with above mentioned requirements (a) to (d).

5.3.2 When an invention is publicly known, against the intention of a person with the right to obtain a patent

When an invention is publicly known against the intention of a person with the right to obtain a patent, it doesn't matter how the invention is publicly known. However, the person with the right to obtain a patent shall also file a patent application within twelve months (six months in case of filing date being earlier than March 15, 2012) of the date on which the invention is publicly known, without the need to state the purport of invention to take advantage of Article 30 in the application.

5.3.3 Distinction between the cases when an invention is publicly known by a person with the right to obtain a patent, and when the invention is publicly known against the intention of the person

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(1) In filing a patent application claiming the exception of the claimed invention being considered to be publicly known, there may be two cases. The first case is when a person with the right to file for a patent causes the invention to be publicly known, and the second case is when the invention is publicly known against the intention of the person. Both cases have requirements in common that (i) the patent application be filed within twelve months (six months in case of filing date being earlier than March 15, 2012) of the date on which the invention is publicly known, and (ii) invention considered to be publicly known be examined on a claim by claim basis. However, there are differences in the person who publicly displayed the invention, the medium used for being publicly known and required documents proving the relevant facts.

(2) An invention being publicly known by a person with the right to file for a patent means an invention has been laid open by an inventor or the person's entitled successor. Notwithstanding the consent of the person with the right to obtain a patent, if the invention is laid open by a person who is not a successor to the right, the provision of Article 30 may not apply to the invention. Meanwhile, the case of an invention being publicly known against the intention of a person with the right to obtain a patent is considered as being publicly known against the intention of an inventor or the person's entitled successor. Whether an invention is publicly known against the intention of a person with the right is determined in consideration of the right holder's clear intention to lay open the invention at the time when the invention is publicly known.

(3) Whether an invention is publicly known by a person with the right to obtain a patent or by a person against the intention of a person with the right to obtain a patent, the type of disclosure is not restricted. In the case of disclosure by a person with the right to obtain a patent, when the application has been laid open or registered in the Republic of Korea or in a foreign country according to the treaties and laws, the provision of Article 30 cannot be applied.

(4) A person intending to take advantage of the provision of Article 30 for the reason that the invention is publicly known by the person with the right to obtain a patent shall state the intention in the application. If not, the person is not allowed to amend the application later to put the intention. Meanwhile, a person intending to take advantage of the provision

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of Article 30 for the reason that the invention is publicly known against his or her intention does not need to state the purport in the application.

5.4 The procedure to take advantage of the provision of Article 30

5.4.1 Where a person with the right to obtain a patent has laid open the invention before the filing of a patent application

(1) The patent application should be filed within twelve months (six months in case of filing date being earlier than March 15, 2012) of the date on which the provision of Article 30 paragraph (1) subparagraph (1) applies to the invention. In other words, the applicant shall state, when filing the application, that the person intends to take advantage from the provision of Article 30 paragraph (1) subparagraph (1).

(2) The applicant shall submit documents proving the fact that the provision of Article 30 applies to the invention, within thirty days of the date of filing.

(3) For an international patent application, notwithstanding Article 30 paragraph (2), a person intending to take advantage of Article 30 shall state their intention in the application and submit the documents proving the intention within thirty days after the critical date (the date for submitting domestic documents) as prescribed in Article 201 paragraph (4) (Refer to Article 200 of the Patent Act and Article 111 of Special provision).

(4) It shall be proved that a person who disclosed an invention is the person who has the right to obtain a patent. Where the person who disclosed the invention is not the inventor or applicant, the applicant shall submit documents proving that, when displaying the invention, he or she is a successor to the person with the right to obtain a patent.

5.4.2 In the case that the invention is publicly known against the intention of a person with the right to obtain a patent

A person intending to take advantage of Article 30 shall prove that the invention is disclosed or used, against the intention of the person. A claim of the fact that the invention

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is publicly known and the requirements of proving the fact are individually judged on a case by case basis. Where an invention is publicly known against the intention of a person with the right to obtain a patent under Article 30paragraph (1) subparagraph (2), it is not the case that the right holder voluntarily discloses the invention. So, there would be many cases that are difficult to prove how the invention was publicly known, as in the case of Article 30 paragraph (1) subparagraph (1). Therefore, the fact that the invention is publicly known against the intention of a person with the right to obtain a patent may be proved in various ways.

5.5 Examination to decide whether Article 30 applies to an invention

5.5.1 Formality examination

Once a patent application indicating the purport of claiming non-prejudicial disclosure is submitted, the examiner shall conduct formalities examination on whether the application is submitted within 12 months from the disclosure date (6 months for application whose filing date is before March 14, 2012) or the disclosure is made by a person with the right to obtain a patent right.

Even if a person submits a document proving that an invention is displayed at an exhibition, if it is difficult to identify the invention displayed at the mentioned exhibition, the Korean Intellectual Property Office may invite the applicant to submit a complementary document to identify the fact. However, if the organizer of the exhibition, title, date, and venue of the exhibition are in doubt, the Office may ask the applicant to add documents to prove the fact.

Notwithstanding the submission of the written intention to take advantage from the provision of Article 30, if the claim falls under any of the following subparagraphs, the office gives the applicant a notice to correct defects.

① when a person who disclosed an invention is different from the person who filed or invented the invention;
② when the patent application is filed more than twelve months (six months in case of filing

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date being earlier than March 14, 2012) after the disclosure date of laying open the invention;
③ when an applicant puts the wrong disclosure date and type of the disclosure on the application and puts incorrect information on the documents proving that the invention is not considered to be publicly known; or
④ when the submitted documents are not enough to prove the relevant fact

Notwithstanding the notification, when the applicant does not make an amendment within a designated period, the office invalidates the claiming procedure under Article 30(in this case, the filing procedure is effective).

In other words, where the presenter and the applicant (inventor) are not the same and therefore, whether the right to obtain a patent is transferred legitimately cannot be confirmed; where the application is incorrectly described or the disclosure date is incorrectly indicated due to miswriting or omission; where only documents are attached without creating the box [Intention of Application of Article 30] in the application; or where the requirement of Article 30 of the Patent Act cannot be met because of omission of part of evidential documents, the examiner shall order amendment under Article 46 of the Patent Act. Where irregularities are not addressed within the designated period despite the amendment order, the examiner shall invalidate the procedure.

As shown in ④, whether the evidential documents are sufficiently submitted shall be determined based on whether the matters required for examination on the requirement of non-prejudicial disclosure can be confirmed in the evidential document. Matters required for examination on the requirement non-prejudicial disclosure contain ⅰ) disclosure date, ⅱ) discloser, ⅲ) disclosure type, and ⅳ) content of the disclosed invention.

In the case of disclosure of the invention at an exhibition, where the evidential document of disclosure cannot specify the disclosed invention, supplementary documents which can specify the invention (such as copies of exhibition program, copies of exhibit catalog or pamphlet, photos of exhibits in display at the show booth, etc.) and explanations can be requested. Where a question is raised on the fact relation of the submitted document specifying the exhibition name, hosting party, exhibition date, exhibition venue, and

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exhibitor, supplementary document required for proving the fact relation can be requested.

5.5.2 Substantive examination

An examiner reviews all of the submitted documents and examines the invention if defects are not found in the application. The disclosures that fall under any of the provisions of Article 30 are recognized as non-prior art in the examination, where Article 29 paragraph (1) or (2) applies to the invention claimed in the patent application. However, when the procedure of claiming an invention to be not to be considered to be publicly known fails because defects are found in the application and documents, the submitted documents may be used as prior art.

5.5.3 Matters to be attended to apply Article 30 to the invention

(1) When a person with the right to obtain a patent discloses an invention several times before the filing of a patent application, in principle, the procedure to apply Article 30 of the Patent Act to the invention shall be taken for each disclosures to be applied with non-prejudicial disclosure.

However, the 'indication of intention' specified in Article 30(2) of the Patent Act does not necessarily need the concerned disclosure to be specified in the application but is enough if the intention that it shall be applied with non-prejudicial disclosure is recognized. Therefore, where the intention of claiming non-prejudicial disclosure is indicated in the application (by checking the box for non-prejudicial disclosure in the application form) at the time of filing, even though the disclosure is not specified in the application, the non-prejudicial disclosure can be applied to the disclosure if the evidential document of the disclosure is submitted within 30 days from the filing date.

If an acting of disclosure is inseparably related to one or more disclosures, the applicant may be exempted from the submission of a document proving the relevant facts, in the second disclosure and after the second disclosure. In this case, the period of twelve months (six months in case of filing date being earlier than March 14, 2012) prescribed in Article 30 will be calculated from the earliest date of publication. The disclosure which is inseparably

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related to one more disclosures is prescribed in Article 30 paragraph (1) subparagraph (1) and the applicable cases are as follows:

(a) an examination which takes two or more days; (b) examination and explanation distributed on the date of examination; (c) the first edition and second edition of a publication; (d) the collections and oral presentation of the collections in a society; (e) oral presentation and a lecture booklet; (f) a lecture tour; and (g) display in an exhibition and catalog of the displayed product.

Also, where one academic disclosing activity (such as publication of academic journal, presentation at academic institutions, disclosure of research report, publication of academic thesis, etc.) has been conducted on an invention created based on research result, such disclosures are not limited to the single academic presentation activity, but subsequent disclosures on the same invention are expected to follow. Therefore, the relation is regarded as inseparable with other types of academic disclosing activities of the identical invention, and thus, if a legitimate procedure for non-prejudicial disclosure has been undertaken for the initial academic disclosing activity, subsequent academic disclosing activities shall be deemed to enjoy non-prejudicial disclosure. (2011 Won 6757, 2010 Won 4635)

(2) When there are an invention (A) which is filed for claiming that it is not considered to be publicly known and another invention (B) which is the same as invention but laid open by a third person between the date of disclosing the invention (A) under Article 30 paragraph (1) subparagraph (1) and the filing date of the invention (A), an examiner shall refuse the application of invention (A) for the reason of lacking novelty, except the obvious fact: the laying open of the invention (B) was made by learning from the disclosure (A).

The laying open of invention which was made by a third person after learning from a disclosure, which is not considered to be publicly known, covers the case when a third person reproduces the invention which was publicly known by a person with the right to obtain a patent at an examination, publication, announcement in an academy, and display in an exhibition. After sending an applicant a notice of reasons for refusal for the above reason, the examiner shall decide to refuse an invention if the applicant can't establish the fact that the a third person laid open the invention after learning from a disclosure which is not

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considered to be publicly known, or that the invention is filed against the intention of the applicant.

(3) When a person filed a patent application A within twelve months (six months in case of filing date being earlier than March 15, 2012) of the date on which the invention is publicly known and took advantage from the provision of Article 30, and on the same filing date, a third person filed a patent application B with the same invention as A, Article 36 paragraph (2) applies to applications A and B. It means that A and B are related to the same invention which are filed on the same date, and the applicants of A and B should reach an agreement on who will obtain a patent for the invention. Moreover, in consideration that B is filed after the invention is publically known, B is deemed to lack novelty and therefore the applicant who filed B may not obtain a patent, without applying the provision of Article 36. In this case, the examiner shall instruct both applicants to report on the results of the consultation under Article 36 paragraph (6), not to give a notice of refusal and decide the refusal because B lacks novelty. According to the provision of Article 36, the examiner shall let both applicants know that only the person agreed upon by all the applicants after consultation may obtain a patent for the invention. Upon the examiner's instruction for consultation, where the applicant who filed the application B withdraws the filing, the applicant who filed the application A may obtain a patent.

(4) When a patent application is filed by a person with the right to obtain a patent and the application is published in the patent gazette, Article 30 of the Patent Act does not apply to the invention.

Under the normal procedure of filing a patent, the Commissioner of the Korean Intellectual Property Office shall lay open a patent application in the patent gazette after the prescribed date of filing under Article 64 paragraph (1). Where an application is laid open according to the procedure of filing, the laying open is not the voluntary intention of the applicant. In this case, therefore, the provision of Article 30 is not applied. However, before an invention is laid open, the invention may be withdrawn or revoked or finally rejected. After the procedure of filing has been completed, if the Office mistakenly lays open an invention, the disclosure of the invention is regarded as the one against the intention of the applicant. In this case, the applicant may take advantage from the provision of Article 30.

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(5) When an applicant files a patent application claiming priority under the relevant treaty, to take advantage of the provision of Article 30, the applicant shall file the patent application in the Republic of Korea, within twelve months (six months in case of filing date being earlier than March 15, 2012) of the date of acting to which Article 30 apply. However, with regard to a patent application which contains a priority claim based on a patent application filed in the Korean Intellectual Property Office, the applicant may take advantage of the provision of Article 30 if the earlier application is filed within twelve months (six months in case of filing date being earlier than March 15, 2012) of the date of publication, even though the subsequent application is not filed within the twelve months (six months in case of filing date being earlier than March 15, 2012).

(6) The provision of Article 30 paragraph (1) subparagraph (1) is also applied to the following laying-open actions: (a) when a person with the right to obtain a patent asks to disclose an invention to a third person and the invention is disclosed by the third person; and (b) when the third person discloses an invention by referring after obtaining permission from a person with the right to obtain a patent (implied consent is also approved).

Above mentioned case (a) covers the following cases: (i) when a person with the right to obtain a patent commits the disclosure of an invention to a third person, including the case when the name of inventor or the right holder is stated, and (ii) when a person with the right to obtain a patent sends the press release or script of an invention to a newspaper and the invention is laid open; in this case, although the name of inventor or the right holder is not stated, the fact that the person who wrote to the newspaper is the right holder should be proved.

Moreover, a disclosure when a person refers to an invention of a person with the right to obtain a patent covers the following cases: (i) when a person, who has not the right to obtain a patent, clarifies the inventor or company for which the inventor works in paper or article and refers to the invention, and (ii) when a company for which the inventor works discloses the invention in printed manner such as catalog.

Meanwhile, when two or more persons jointly make an invention or file an application,

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among presenters who disclosed the invention, at least one person is the same with the inventor or applicant, the provision of Article 30 may apply to the invention without any need to prove that the inventor or applicant is the person who disclosed the invention. However, if there is no relation between the inventor or applicant and the person who disclosed the invention, the applicant is required to submit the following documents: (i) a document proving the fact that a person who presents an invention is the person with the right to obtain a patent (ii) a document proving that an invention is disclosed by a request from the person with the right to obtain a patent and (iii) a document proving that a person who presents an invention got permission for referring to the invention from the person with the right to obtain a patent.

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Chapter 3. Inventive Step

1. Relevant Provisions

Article 29(2) of the Patent Act (Requirements for Patent Registration) Notwithstanding paragraph (1), if an invention could have been easily made, before the filing of a patent application, by a person skilled in the art to which the invention pertains based on an invention or inventions referred to in each subparagraph of paragraph (1), a patent for such an invention may not be granted.

2. Purport

The purport of Article 29, paragraph (2) of the Patent Act is not to grant a patent to inventions that could have been easily made by a person skilled in the art, since granting a patent to such inventions does not contribute to and even hamper the technological progress. In other words, granting a patent to slightly advanced arts leads to literally giving exclusive rights to the same prior arts. This runs counter to the purport of the Patent Act, which gives an inventor exclusive rights in exchange for the publication of a new technology, and by doing so limits the possibilities of a third party of accessing the technology.

(Reference)
The term "inventive step" is not defined in the Patent Act. However, if an invention could have been easily made, the invention does not have an inventive step. Otherwise, the invention has an inventive step under Article 29, paragraph (2) of the Patent Act.

3. Relevant Provisions

3.1 Prior to filing of a patent application

「Prior to filing of a patent application」does not refer to the simple concept of the filing date, but means the definite time, in hours and minutes at the time of filing. For instance, if an invention is publically known outside Korea and the point of time when the invention has

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become publically known precedes the filing time of a patent application in Korean local time, then, this invention is considered as a cited invention under Article 29, paragraph (1) of the Patent Act.

3.2 A person skilled in the art

"A person skilled in the art to which the invention pertains" (referred to as "a person skilled in the art" hereinafter) refers to a hypothetical person who has common general knowledge in the art to which the claimed invention pertains and the ability to use ordinary technical means for research and development (including experiment, analysis, and manufacture); who has the ability to exercise ordinary creativity in selecting materials and changing designs; and who is able to comprehend based on his/her own knowledge all technical matters regarding the state of the art in the field to which a claimed invention pertains at the time of filing a patent application. In addition, an expert in the technical field is one able to comprehend based on his/her own knowledge all technical matters in the technological field relevant to a problem to be solved by the claimed invention.

"The state of the art" at the time of filing of a patent application includes "an invention(s) referred to in any of the subparagraphs of Paragraph (1)," the common general knowledge, and other publicly known technical matters. It also relates to all types of information relevant to the technical field of the invention described in the claims, including ordinary methods to conduct daily works and experiments.

3.3 Invention that could have been easily made

「Where an invention could have been easily made by a person skilled in the art based on an invention(s) referred to in each subparagraph of paragraph (1)」refers to whether a person skilled in the art could have easily conceived the invention described in the claims by exercising ordinary creativity or based on motivation induced from the invention(s) that is(are) publically known prior to the filing of the patent application.

4. General principles of determining the inventive step

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(1) When determining the inventive step, it is decided whether 「an invention described in the claims」 as filed could have been easily made by a person skilled in the art based on an invention(s) defined in Article 29 paragraph (1) of the Patent Act (hereinafter refer to as the 「cited invention(s)」), prior to the filing of the patent application. If 「the invention in the claims」 could have been easily made by a person skilled in the art, alone or by combining the cited inventions, the invention in the claims is not considered to has an inventive step.

(2) When there are two or more claims in an application, the determination should be made for each claim.

(3) Notifying applicants of the reasons for refusal regarding novelty is different from notifying applicants of the reasons for refusal regarding the inventive step. However, when it is determined that an invention is not novel, it is allowed to notify applicants of the reason for refusal along with the reasons for refusal regarding the inventive step.

(Reference)
The inventive step of the patent application is based on whether the claimed invention is novel. Therefore, determination whether the claimed invention is novel compared to published inventions should be distinct from determination whether the claimed invention could have been easily made by a person skilled in the art. Therefore, in order to determine the inventive step of the claimed invention, determination of novelty should come first (Supreme Court's decision 1992. 6. 2. 91Ma540).

(4) Regarding a claim which contains more than two inventions including a Markush group type (including the case when multiple claims or elements are selectively recited), if the examiner notifies the applicant of the reasons for refusal with regard to a certain invention, the examiner needs to precisely point out the invention along with the reasons for refusal with regard to novelty and the inventive step.

5. Method of determining the inventive step

The examiner shall make efforts to consider the overall state of the art that a person skilled in the art would consider at the time of filing an application and, at the same time, shall

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thoroughly consider the purpose, technical structure, and advantageous effects of the invention while paying attention to the opinion of the applicant, comprehensively determining whether the claimed invention has an inventive step in consideration of its specific purpose and effectiveness, and focusing on the difficulty of the technical structure of the claimed invention.

Determination of the inventive step shall be done in consideration of ③ whether, from the point of view of one or ordinary skill the art, the claimed invention has any advantageous effects over a cited prior art while mainly focusing on ① whether the cited prior art provide any motivation to a person skilled in the art to arrive at the subject matter of the claimed invention or ② whether the difference between the subject matter of the prior art and that of the claimed invention can be considered as a mere exercise of ordinary creativity.

5.1 Procedure of determining the inventive step

The procedure of determining the inventive step is as follows.

(1) The examiner specifies an invention for which an applicant requests grant of a patent. The method of specifying the claimed invention is the same with that of 「determining novelty」 in Chapter 2.

(2) The examiner specifies cited inventions. The method of specifying the cited inventions is the same with that of 「determining novelty」in Chapter 2. The examiner shall specify the cited inventions from the point of view of a person skilled in the art, on the assumption of the common technical field and technical problems of the claimed invention.

(3) The examiner chooses a cited invention which is the closest to the claimed invention and makes a clear difference by comparing the cited invention with the claimed invention. In doing so, the examiner shall take into consideration the structural combination of the elements of an invention. More specifically, structurally combined elements of an invention shall be compared as one integrated unit (without being separated) with their corresponding elements in the cited invention.

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(4) The examiner determines whether an invention described in the claims could have been easily made by a person skilled in the art, in view of cited inventions or the common general knowledge before the filing, even though there is a difference between the claimed invention and the cited inventions

5.2. Selection of the cited invention

(1) A cited invention, which is the object of comparison with a claimed invention in the determining the inventive step, shall be, in principle, selected from the same technical field as or from a reasonably relevant technical field to the problem, effect, and use of the claimed invention. The same technical field shall refer to, in principle, the industrial field where the invention is applied, but shall also refer to the technical field that can be inferred from the effects or functions of some (or all) comprising elements of the invention. Even if the prior art is in a different technical field from the invention described in the claims, the prior art can be recognized as a cited invention if the prior art might be applied to other technical fields or used by the applicant in the process of solving a specific technical problem.

When a claimed invention is compared to the prior art in a different technical field, the examiner should take into account when citing documents the relevance of two technical fields, the close similarity of a problem to be solved, and the close similarity of a function, work or operation.

(Example 1)
The claimed invention relates to a container cap, which can seal or unseal a container for plant nutrition easily and completely. The cited invention discloses an eruption closure assembly to be used for liquids of different viscosities. The technical field of the claimed invention is similar to that of the cited invention since both inventions relates to an apparatus for sealing or unsealing a liquid container. Hence, the eruption closure assembly is properly chosen as a cited invention.

(Example 2)
The technical fields of an umbrella and a parasol are not exactly the same, but are

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considered to be proximate to each other since the upper cover can be unfolded with the supporting pole at its center. Hence, the inventive step of the umbrella can be denied by citing the parasol as a prior art.

(Example 3)
The claimed invention relates to a method of preventing damages due to harmful insects by trunk injection, which is a method of injecting medication into a tree and filling a bore after the injection. Cited invention 1 relates to a method of disposing of a bore in a tree after trunk injection. Cited invention 2 relates to a method of injecting antibiotic into trees to eradicate insects through trunk injection. As there are enough grounds to consider that cited inventions 1 and 2 and the claimed invention are in the same technical field, the inventive step of claimed invention can be denied due to cited inventions 1 and 2.

(2)「The closest cited invention」means the most relevant cited invention in relation to a claimed invention among several selected cited inventions that a person skilled in the art would choose and which discloses most of the technical features of a claimed invention. Hence, it is desirable to choose the closest cited invention from among inventions that are in proximate technical field or have the same effect, use, or relate to a technical problem to be solved that is identical or similar to that of the claimed invention.

(Example 1)
An umbrella can be the closest cited invention in denying the inventive step of a parasol because improving the portability of a foldable object by making its size smaller when folded is a common technical problem to be solved in the relevant technical field.

(3) When there is a description in a cited reference whereby the technical idea of the claimed invention cannot be easily conceived, the cited reference is not eligible as a cited invention. However, regardless of the description in the cited reference, which is a prima facie case to determine that the technical idea of the claimed invention cannot be easily conceived, the eligibility of a cited invention shall be maintained if it is possible to arrive at the technical idea of the claimed invention from other aspects such as a close relation between technical fields, a close similarity of a function, work, or operation, etc.

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(Example 1)
The claimed invention relates to a probe card and is in the same technical field with cited invention 1 which comprises all technical features of the claimed invention except that the cited invention does not disclose a means to control the overall flatness. However, there is no description in the cited invention 1 to preclude the adoption of such a means to control the overall flatness, nor it is technically difficult to introduce such a means considering its technical structure. Hence, the inventive step of the claimed invention can be denied by combining the technical features of cited invention 1 and a means of controlling the orientation of a substrate disclosed in cited invention 2 (which is in the same technical field as the claimed invention).

(4) If the applicant admits in the specification that a technology presented as prior art is publicly known prior to the filing of the application, the technology may be properly selected as a cited invention at the time of filing, in determining the inventive step of a claimed invention.

(5) Even though the prior art constitutes an incomplete invention, it can be cited in determining the inventive step

(Example 1)
The claimed invention relates to a pharmaceutical compound to treat neuro-degenerative disorders by using an estrogen compound alone. A person skilled in the art can easily recognize from the cited invention that sexual hormones such as estrogen are effective for curing neuro-derogative disorders. And if this fact is not contrary to the technical common sense at the time of filing the application, the cited invention can be used as a prior art to determine the inventive step even if some defects exist in the description of the cited invention due to insufficiently disclosed pharmaceutical effects and real experiments.

6. Concrete method of determining Inventive step

6.1 Probable cause or motivation

The following cases can be strong grounds for determining that a person skilled in the art

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would have been led to the claimed invention based on the cited invention; suggestions shown in the disclosures of the cited inventions, close similarity of a problem to be solved, close similarity of a function, work, or operation, close relevance of technical fields.

6.1.1 Suggestions shown in the disclosures of the cited inventions

Suggestions shown in the disclosures of the cited inventions relevant to a claimed invention can be strong grounds for determining that a person skilled in the art would have been led to the claimed invention.

(Example 1)
The claimed invention discloses a technical method of establishing a condenser, a motor, and a compressor in an airtight cooling apparatus. The cited invention discloses a method of setting up the relevant structure of a cooling compressor in an airtight cooling apparatus. The cited invention differs from the claimed invention only in that the cited invention does not specifically mention a heat exchanger built in the airtight cooling apparatus of the claimed invention. If the cited invention implicitly suggests the heat exchanger built in the airtight cooling apparatus, which is a relevant component of the cooling apparatus, the technical feature of claimed invention is merely a matter of design option when the general technical knowledge in the relevant field of the art is applied.

6.1.2 Close similarity of a problem to be solved

(1) A close similarity of a problem to be solved can be a strong ground for determining that a person skilled in the art would have been led to the claimed invention by applying or combining cited inventions.

If the technical problems to be solved described in the claimed invention and cited invention are not in the same technical field, the examiner decides whether the technical problem of the claimed invention is obvious in the relevant field of the art or easily deducible in light of technical common sense and whether that reasoning can be used as a ground for denying the inventive step by scrutinizing the technical problem.

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(Example 1)
The claimed invention discloses an animal-shaped winter cap which creates a unique fashion style and offers protection against cold by covering not only one's head and ears but also the areas around the neck, cheeks, and lips. Cited invention 1 relates to an animal-shaped winter cap, and cited invention 2 is directed to a mask hood to protect one's face by covering all parts of 'the face except for the eyes in the event of extremely cold weather. In this case, the technical fields of the cited inventions are identical or proximate to that of the claimed invention. Moreover, problems to be solved by the claimed invention and its solutions seem to be suggested in each of the cited inventions. Hence, there seem to be no difficulty in combining the cited inventions, and therefore the claimed invention would have been readily derived from the cited inventions by a person skilled in the art.

(Example 2)
The claimed invention is directed to a snap action diaphragm to adjust snap-action of a diaphragm by controlling the degree of a slope of an outer circumference of the diaphragm by applying power on it. The cited invention relates to a thermo-start which is activated in accordance with a temperature change. The technical problems of both claimed and cited inventions correspond to each other in that both inventions disclose a method to control the snap-action of a diaphragm. However, the two inventions differ from each other in that the diaphragm of the claimed invention is activated according to pressure changes, while that of the cited invention is set in motion in accordance with temperature changes. Nonetheless, the inventive step of the claimed invention would be denied if the difference does not have any significant influence over the gist of claimed invention and a person skilled in the art can easily apply a thermally actuated method to the pressure actuated diaphragm without exercising any creative thinking.

(2) Even in the case of a cited invention with a different problem compared to a claimed invention, if it is obvious that a person skilled in the art can easily arrive at a the claimed invention through a mere exercise of ordinary creativity, the inventive step of the claimed invention can be denied.

(Example 1)
The claimed invention relates to a carbon disc brake with grooves designed to prevent the

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attachment of water drops on its surface. Cited invention 1 discloses a carbon disc brake, and cited invention 2 shows a metal disk brake with grooves designed to remove dusts from its surface. These technical problems are not exactly the same, but a person skilled in the art would readily arrive at the carbon disk brake with grooves by simply combining the technical feature of cited invention 2 with the carbon disk brake of cited invention 1 without exercising any creative thinking, thereby the inventive step of the claimed invention can be denied.

6.1.3 Close similarity of a function, work, or operation

If a close similarity in a function, work, or operation exists between a claimed invention and a cited invention or between cited inventions, there can be a well-founded ground that a person skilled in the art would have arrived at the claimed invention.

(Example 1)
The claimed invention discloses a filtering apparatus for home use, with a specially structured filtering part. The cited invention relates to a home filtering apparatus, which is exactly the same as in the disclosure of the claimed invention except for the structure of the filtering part. Cited invention 2 is directed to a filtering apparatus for an automobile, with the same structured filtering part as that of the claimed invention. The filtering apparatuses described in cited inventions 1 and 2 are identical to that of the claimed invention with respect to their functions and operations. Considering that the claimed invention is not in a different technical field from the cited inventions in terms of the generally required technical problems, applying the filtering part described in cited invention 2 to the filtering apparatus in cited invention 1 is deemed to be obvious to a person skilled in the art.

6.1.4 Close relation of technical fields

A publically known technical means for solving the technical problem of the claimed invention in a related technical field can be a strong ground for considering that a person skilled in the art could have achieved the claimed invention.

(Example 1)

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If a cited invention discloses gloves with a similar structure to claimed socks, as gloves and socks belong to similar technical fields and they are related to each other, a person skilled in the art could easily apply the composition of socks to gloves.

6.2 Mere exercise of ordinary creativity of a person skilled in the art

A common improvement based on general applications of a known art, reasoning based on known physical properties, or referring to other technical filed to solve a known problem fall into the category of ordinary creativity of a person skilled in the art. Among exercises of ordinary creativity of a person skilled in the art are selecting an optimal material from publicly known materials in order to achieve a specific object, optimizing a numerical value range, replacing with equivalents, a workshop modification of a design in applying a specific technology, partially removing technical features and simply changing the use. When the differences between the claimed invention and the cited invention under comparison falls only under these categories, it is usually considered that a person skilled in the art could easily arrived at the claimed invention, unless there is another ground for assessing the inventive step.

6.2.1 Replacement with Equivalents

An invention consisting of a substitution in a known device of a feature with a known feature which has the same function as the substituted feature and is an equivalent thereof is not considered as having an inventive step if it fails to exhibit an unexpected advantage.

In order to acknowledge the replacement with equivalents as a mere exercise of ordinary creativity of a person skilled in the art, it should be justified that the replacement is obvious to a person skilled in the art at the filing of the application in addition to the fact that the substituted known feature functions as an equivalent. The examiner is allowed to submit evidence that the substituted feature had been known as an equivalent before the filing date of the concerned application in the same technical field.

(Example 1)
In comparison with the prior art, an invention claiming a heat exchanger is characterized by

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substitution of Sic with Aluminum which has an equivalent property. In this case, the inventive step of the invention is negated if it had been known before the time of filing the application that Sic and Aluminum are equivalents in providing a light and anti-corrodible heat exchanger.

(Example 2)
An invention discloses use of magnesium carbonate to promote crystal formation by quickening a reaction, instead of use of magnesium oxide as in the prior art. However, if it had been known that magnesium carbonate changes into magnesium oxide when the reaction temperature rises over 1,300°C, the substitution of magnesium carbonate for magnesium oxide is only considered as a replacement with equivalents, thereby nullifying the inventive step of the invention.

(Example 3)
An invention relates to a drill comprising a hydraulic motor, and the prior art relates to a drill comprising an electric motor. At the time of filing the application, the exchangeable use of a hydraulic motor and an electric motor had been very well-known so that a person skilled in the art can hardly expect an unforeseen advantage. In this case, the inventive step of the invention can be negated.

6.2.2 Workshop modification of a design in applying a specific technology

When an invention can be merely arrived at by applying normal design procedures without affecting the technical concept of the prior art, and is neither described as having nor shown to lead to any advantageous effects, the inventive step of the invention cannot be acknowledged.

For example, if the difference between the claimed invention and the cited prior art is only caused by the application of particular parameters such as size, proportion, relative dimensions, and amount from a limited range of possibilities, the inventive step cannot be acknowledged. But if the difference can lead to any particular change in any functions or reactions with an unexpected advantage, the invention can be determined as having an inventive step.

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(Example 1)
The claimed invention is provided to prevent the movement of a door of a microwave when a user tries to open or close the door, by installing movement prevention protrusions on the upper and lower sides of the door to engage with insertion grooves, which is different from the prior art in the physical structure, size, numbers, and positions of the protrusions and insertion grooves. The difference in the configuration can be obtained by a normal design procedure to adopt insertion members and engagement members. Hence, the inventive step can be negated.

(Example 2)
Compared with a microcomputer for a Kimchi refrigerator of the prior art, a control circuit for an electric massager of a claimed invention is only different in the resistance information and operation type of an electric motor which are adjusted for the electric massager. In terms of the design technology of the microcomputer at the filing time of the application, such a difference could be arrived at applying a normal design procedure. Hence, the inventive step is negated.

(Example 3)
The claimed invention is related to a level gage cover for a water tank wrapped by heat insulation. The prior art relates to a door with a sealing material on its inner surface. At the first sight, the claimed invention is likely to be arrived at by simply replacing the sealing material of the prior art with heat insulation. But adoption of heat insulation for a level gage would prevent the gage cover from freezing and cracking in case of a sudden temperature drop. In this case, the examiner has to carefully consider the effects following the design procedure in assessing the inventive step.

6.2.3 Partial removal of technical features

The claimed invention is not considered as having an inventive step, if, with regard to the state of the art, the omission of some technical features readily mentioned in the prior art causes removal of the related function and effect, and is obvious to a person skilled in the art. But regarding the common knowledge at the time of filing, the inventive step can be

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acknowledged when the omission of some features does not affect the function of the invention or rather enhances the function.

(Example 1)
The prior art is a toothpaste containing water-soluble silicate, wherein the silicate forms a teeth surface membrane having the effect of protecting sensitive teeth from a stimulus, whereas the claimed invention does not contain said water-soluble silicate to lower the manufacturing costs. At this time, the effect of silicate for coating the surface of teeth and preventing them from stimulus is also removed. For this matter, the claimed invention is not considered to be inventive.

6.2.4 Simple change and limitation of use of the invention

A claimed invention consisting merely of use of a known invention or in a further simple restriction of such use is not considered inventive. In other words, the claimed invention which is distinguished from the prior art only in a modification of its use or further extension of its use without exhibiting any advantage is not considered inventive.

(Example 1)
A synthetic oil which delays the change of lubricating properties is disclosed in the prior art, whereas the claimed invention discloses reuse of synthetic oil as cutting oil during a cutting process. In this case, if recycling of the synthetic oil as cutting oil is naturally expected from a delayed change of the lubricating properties, the inventive step is negated.

6.2.5 General application of known art

The claimed invention consists merely of use of a known technique in a closely analogous situation in order to solve a problem posed by the prior art with readily anticipated effect, which is not inventive. On the other hand, the claimed invention may be considered inventive when the application of the known technique leads to unexpected beneficial effects in combination with other components in comparison with the prior art.

(Example 1)

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The claimed invention is characterized in transforming conventional *Woowhangchungshimwon* into liquid type for administration. The inventive step can be negated if such a transformation in the administration type from a solid pill type to a liquid form for oriental medications is within common practice.

(Example 2)
The claimed invention relates to formation of a leak detecting hole in a pipe connecting joint, which is considered not inventive since the technical feature of making a penetrating hole in the outer surface to observe the inner space of an article is commonly practiced without exercising any ingenuity.

(Example 3)
The claimed invention relates to a tray for storing components of a ball grid array integrated circuit, which is not considered inventive if the pin type component for integrated circuit has already begun to be replaced with a ball grid type component at the filing time of the application, since a person skilled in the art would adopt without any special difficulty the ball grid type tray which is prevalent at the filing time of the invention.

6.3 Advantageous effects to be considered

(1) If an effect derived from matters defining a claimed invention is advantageous in comparison with an effect of a cited invention, it is taken into consideration as a fact to affirmatively support its inventive step.

(Reference 1)
Under Article 29, paragraph (2) of the Patent Act, if a claimed invention could have been easily made from the prior art before the filing of a patent application by a person skilled in the art, a patent for such an invention may not be granted. However, when an advantageous effect compared to the cited invention is so remarkable that it could not have been foreseen by a person skilled in the art from the state of the art, there may be cases where the inventive step is not denied (Supreme Court's Decision, 1997. 9. 26. 96 Hu 825).

(Reference 2)

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If a claimed invention is made by collecting and improving commonly known and commonly used arts, the claimed invention is not considered to be inventive except the case where it is difficult to colligate the arts and achieve a new advantageous effect more than that expected from the prior arts, thereby the cited invention could not have been easily made by a person skilled from the prior art, and the case where a new technical method is added to the claimed invention (Supreme Court's Decision 1997. 5. 30. 96 Hu 221 sentence).

(2) Even if the claimed invention is considered to be easily made by combining cited inventions at the first glance, if the claimed invention has an advantageous effect, qualitatively different or qualitatively the same but quantitatively prominent in comparison with those of the cited inventions, and if the advantageous effect could not have been foreseen by a person skilled in the art from the state of the art, the inventive step can be acknowledged.

Particularly, in the case of an invention in a technical field in which an effect of a product is difficult to predict from its structure like a selection invention and chemical inventions, the advantageous effect compared to the cited invention is an important factor to positively infer the inventive step.

(Reference)
The inventive step of a composition of dyes comprising more than two chemical compounds mixed in a certain ratio should be determined over the case when each of the chemical compounds solves the problem. Even though individual elements of the chemical compounds belong to different categories, the claimed invention has an inventive step if mixing the chemical compounds in a certain ratio leads to unexpected results (Supreme Court's Decision 1994. 4. 15. 90 Hu 1567).

(3) Though the advantageous effect of the claimed invention is superior to that of the prior art and is not explicitly disclosed in the detailed description, the examiner can assess the inventive step from the inventor's assertion and evidence like experiment results, if the effect is easily recognized by a person skilled in the art from the detailed description and the structure of the invention shown in the drawings. But if such an assertion is not supported by the detailed description and is not inferred from the description or drawings, the effect

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from the assertion should not be considered in assessing the inventive step.

(Example 1)
The claimed invention relates to a blood-cupping device characterized by a half-open barrel extendably installed on the lower part of an operation stick, which is aimed at easily checking the movable rubber plate inserted in the barrel and facilitating the airflow through the half-open barrel while removing of the main cup body. In this case, if the effects of the half-open barrel are remarkably ensured from the description and common knowledge by a person skilled in the art, the claimed invention can be considered inventive.

6.4 Determining the Inventive Step According to the Invention Type

6.4.1 Determining the Inventive Step of a Selection Invention

A selection invention is an invention with a more specific concept selected from a generic concept disclose in a cited invention, which includes a composition which is not directly disclosed in the cited invention as an indispensible part.

If in a claimed invention, an optimized concept is experimentally selected from publicly known technology, the inventive step of the claimed invention cannot be acknowledged because selecting the best or suitable concept from publicly known technology comes within the scope of an exercise of ordinary creativity of a person skilled in the art. However, if a selection invention generates advantageous effect in comparison with a cited invention, the inventive step of the selection invention can be acknowledged. In this case, all specific concepts included in the selection invention should have advantageous effects qualitatively different or qualitatively the same but quantitatively prominent. The detail description of the selection invention should precisely explain that the invention generates an advantageous effect in comparison with the cited invention, and needs not provide experimental materials to confirm the prominence of the effect. If the invention is rejected because of the effect is doubted, the applicant can assert the effect concretely by submitting materials relating to experimental comparisons.

(Example 1)

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Both a claimed invention and a cited invention relate to a chemical compound for protecting a nerve, which is used for curing a regressive disease of the central nervous system. If a chemical compound is selected in the claimed invention selects with a more specific concept which is not directly disclosed in the cited invention, and the oral activity of the claimed invention generates ten times more advantageous effects than the cited invention, the inventive step of the claimed invention can be acknowledged.

6.4.2 Determining the Inventive Step of an Invention including Numerical Limitations

An invention with numerical limitation defines that some parts of indispensible elements of the invention described in the claims are expressed by specific numerical values.

Experimentally selecting an optimal numerical range from the publicly known art is normally considered as an exercise of ordinary creativity of a person skilled in the art, and hence the inventive step is generally denied. However, a claimed invention has an inventive step if within a limited numerical range has more advantageous effect than the effect of the cited invention. This advantageous effect should be a remarkably improved effect regarding the overall scope of the numerical limitation. Also, determining the significance of the critical range of the numerical limitation comes under the following criteria.

(1) The significance of the critical range of a numerical limitation is required with regard to any part of the numerical range if a claimed invention is a continuation of the cited invention.

(2) If the two inventions each have different problems to be solved and qualitatively different effects, the significance of the critical range of the numerical limitation is not required even though the two inventions have the same matters defining the inventions except for the numerical limitation.

For the significance of the critical range of the numerical limitation to be acknowledged, a remarkable change in an invention effect is required across the boundary of the numerical limitation and also the following conditions should be satisfied: 1) the technical meaning of the numerical limitation should be described in detail, and 2) embodiments in the detail

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description or supplemental materials should prove that the range of the numerical limitation is critical. Generally, it should be objectively confirmed that the range is critical with experimental results which cover all range of the numerical limitation.

(Example 1)
The claimed invention discloses a numerical limitation in that the spiral, comprising that one rotation of a screw limits to the tube length which is 12 times longer than the inner diameter. However, since there is no technical explanation of limiting 12 times longer than the inner diameter in the description, it only means that the spiral of a screw is merely not too much gentle and there are no special effects. Therefore, the numerical limitation of the claimed invention is considered to be technically meaningless.

(Example 2)
The claimed invention relates to a ceramic backside material for arc welding to make back bead shape better. The technical difference of the claimed invention is a backside material comprising 0.01 - 0.7% iron-oxide. If this numerical value is merely a numerical limitation that a person skilled in the art can reach by an exercise of ordinary creativity and there is no heterogeneous remarkable effect within the range of this numerical limitation, the claimed invention is not considered to have an inventive step.

(Example 3)
Even though the manufacturing ingredients or process of the claimed invention is similar in some part or identical to those of the cited inventions, if the claimed invention is different from the cited inventions in view of its characteristics such as additives in processing or a ratio of manufacturing ingredients and thus the quality and economic efficiency of the complete goods are greatly improved, the claimed invention is considered to have an inventive step (Supreme Court's Decision, 1992. 5. 12. 91 Hu 1298).

(Reference)
If a claimed invention defines the range of technical elements of a known cited invention with numerical values, no other technical elements to prove an inventive step are added, and the numerical limitation is merely a supplemental material, and if there is no remarkable effect within the range of the numerical limitation, the claimed invention is merely a

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numerical limitation within the scope of the common practice of a person skilled in the art. In other words, if the claimed invention and the cited invention have the same problems to be solved and are different only in the limited numerical values, and if there is no mention in the description about remarkable effects in employing the limited numerical values, it is difficult to admit there is a remarkable effect within the range of the limited numerical values.

6.4.3 Determining the Inventive Step of a Parameter Invention

(1) A parameter invention is an invention in which an applicant creates a certain parameter which is not standard nor commonly used for a characteristic value in physics or chemistry, parameterizes it mathematically by using a correlation between a plurality of parameters, and employs it as a part of essential elements of the invention. Since the parameter invention may not precisely define the subject matter via the claim description, determining the inventive step of the parameter invention should be performed only after figuring out the subject matter based on the detailed description, drawings, and common knowledge.

(2) As the functions and characteristics described in the claim define the subject matter of an invention, the examiner should not compare the claimed invention with the cited invention without considering the functions and characteristics. In case of a parameter invention, the inventive step should be determined by taking into account the functions or characteristics caused by a parameter. For determining the inventive step of a parameter invention, it should be firstly considered whether a technical meaning exists in introducing a parameter. If the parameter described in claims is merely a matter of expression form different from a publicly known invention or a matter of confirming the intrinsic features of a publicly known invention, and if the cause and effect relationship between the parameter and the advantageous effect is weak, the inventive step of the parameter invention is denied. However, if the parameter invention is a type of an invention with a numerical limitation, the determination criteria of the inventive step of a numerical limitation invention can be applied. In this case, even without the technical meaning of the parameter, as long as an effect of the claimed invention caused by the numerical limitation is considered remarkable, the inventive step of the parameter can be acknowledged.

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(3) Although it is difficult to figure out or convert a certain parameter in a claim, and therefore, it is hard to compare the claimed invention with the cited invention, if there is a reasonable doubt that the parameter invention can be easily derived from the cited invention, the examiner can notify the applicant of the reasons for refusal due to the inventive step without having to strictly compare the claimed invention with the cited invention and wait for the applicant's proof statement. If the examiner has difficulty in maintaining the reasons for refusal due to the applicant's refutation, the reasons for refusal are cancelled. If the reasons for refusal are not overcome by the applicant's argument, the examiner may make a decision of refusal under Article 29, paragraph (2).

(4) The examiner might have reasonable doubt in the following cases: ① the parameter described in the claims is obtained from a different definition and measurement method, and then the claimed invention is found to be easily derived from the cited invention. ② the examiner evaluates the parameter of the cited invention according to the measurement method in the description, and then the claimed invention is proved to be similar to the cited invention. ③ an embodiment in the description of the claimed invention is similar or identical to that of the cited invention.

(5) It the examiner notifies the applicant of the reasons for refusal with regard to a parameter invention, the examiner has to concretely describe the grounds of reasonable doubt, and if necessary, the examiner can propose a solution to overcome the refusal grounds.

(6) If the parameter of the claimed invention is standard, commonly used or proved to be easily understandable by a person skilled in the art, the examination criteria described in (1)-(5) are not applied.

(Reference)
In comparing the claimed invention having certain properties or characteristics with the cited invention having different properties or characteristics, if the claimed invention becomes similar or identical to the cited invention as a result of converting the properties or characteristics of the claimed invention with different definitions and measurement methods, or if an embodiment of the claimed invention in the description is similar or identical to one

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of the cited invention, the claimed invention is not considered to be novel and have an inventive step because the two inventions should be considered to be similar or identical to each other (Supreme Court's Decision 2002. 6.28 2001 Hu 2658)

6.4.4 Determining the Inventive Step of a Product Invention described by its manufacturing process

As an applicant should specifically describe the article composition of the invention when defining a product invention, even though a manufacturing method is described in the claims of the product invention, without any exception, the examiner can determine the inventive step of the product invention by comparing the product itself defined by the description with a publicly known invention without considering the manufacturing method.

In determining the novelty and inventive step, since the object to be protected is not the manufacturing method but the product itself in the product invention described by its manufacturing method, the examiner shall compare the composition of the product itself with the composition of the publicly known product. The examiner does not have to take into account the manufacturing method or manufacturing apparatus for the product. In this case, the object of determination is a product characterized by certain properties, features, and composition based on the method description.

(Example 1)
The claimed invention is about a belt coupling apparatus for a seat belt and is described in the claims with a manufacturing method, comprising the steps of: bending a part of a plate from one lateral side to other lateral side and concurrently putting the bent part back to the first lateral side. In this case, as there is no difficulty in characterizing the seat belt via its composition, the examiner can determine the inventive step by comparing the seat belt defined by the manufacturing method with the cited invention, without considering the manufacturing method.

(Example 2)
The claimed invention relates to a method of producing cannaf tea, and it is described in the claims that the available components are the cannaf leaves whose inorganic content is

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increased by heating (60 C, 45min.) and infrared radiation (1.6 kw, 30-45 min.). In this case, if it is proved, based on the description of the specification, that the inorganic content of the cannaf leaves produced by the described method is remarkably increased, the inventive step of the cannaf tea produced by the described method is acknowledged because of the change of the tea properties.

7. Determination of the inventive step of a combination invention

(1) A combination invention is an invention comprising novel solutions by gathering technical features disclosed in the prior art as a whole in order to solve a technical problem.

The invention described in a claim is to be considered as a whole. Accordingly, the inventive step of the combination invention shall not be negated merely because each element described in a claim is deemed to be known from or obvious over the cited inventions.

That is, in the case of a claim disclosing a plurality of elements, determining the inventive step relies not upon each independent element, but upon the technical idea of the claimed invention, the respective elements of which are structurally combined as a whole. Therefore, when determining the inventive step is, the examiner shall consider the difficulty in forming structurally combined elements as a whole based on the principle of a problem solution, rather than consider whether individually dissected elements in the claim are publicly known. In addition, the examiner shall consider the unique effect that the invention has as a whole.

(2) Determining the inventive step of the combination invention can be made by combining more than two disclosures (well-known or commonly used art) but the combination of the disclosures is limited to the condition where a person skilled in the art can easily combine the disclosures at the time of filing. In this case, there is no special limit on the number of prior art disclosures to be combined. When the examiner determines the inventive step by combining various prior arts, the examiner mainly considers whether the cited inventions contain a motivation or hint leading to the claimed invention by combining or assembling the prior art disclosures. Nevertheless, taken into account the state of the art, the common general knowledge at the time of filing, the general technical problems of the technical field, the technical trend and demands in the industry, if the combination of prior art disclosure is

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deemed to be easily made by a person skilled in the art, the examiner can deny the inventive step of the claimed invention (Supreme Court's Decision 2007. 9. 6. 2005 Hu 3284).

(Reference)
Well-known art means technologies generally known in the relevant technical field like technologies widely known throughout the industry, technologies that appeared in many prior art disclosures, or technologies well known to the extent to present examples. Commonly-used art means well-known art which is used widely.

(Example 1)
The claimed invention relates to a web game server enabling users to download a game via the Web. The technical feature of the claimed invention differs from that of the cited invention only in that a game program and game data are separately downloaded in the claimed invention. In this case, if the technical difference in the game program and game data separately downloaded is deemed to have been merely a well-known art in view of the state of the art at the time of filing, the inventive step of the claimed invention is not acknowledged, as a person skilled in the art could have simply combined it with the cited invention without any difficulty.

(Example 2)
The claimed invention relates to a method of counting securities by extracting serial numbers via an image sensor. Compared to the cited inventions, the claimed invention differs from cited invention 1 only in that the cited invention 1 recognizes security denominations via an optical sensor, and cited invention 2 comprises the step of sorting currency notes via an image sensor. Considering the state of the art at the time of filing and the fact that the prior art disclosures fall under the same technical field, the difference between the invention sought to be patented and the prior art would have been obtained by substituting the image sensor of the cited invention 2 for the optical sensor of the cited invention 1 without difficulty. Therefore, it would have been obvious to a person skilled in the art to combine the cited inventions 1 and 2, thereby arriving at the claimed invention.

(3) The determination whether a prior art disclosure contains a motivation, hint, or the like for a combination shall be made by synthetically assessing the following: whether the

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motivation, hint, or the like is explicitly taught in the prior art; whether the motivation, hint, or the like is inherent from the technical problem to be solved by the invention; or whether the motivation, hint, or the like is part of the common general knowledge or empirical rules of a person skilled in the art.

(Example 1)
Cited invention 1 discloses a protective cover of a baby carriage comprising a transparent window made of a flexible plastic material, while the claimed invention describes a protective cover with a transparent window whose material is changed to a rigid plastic material disclosed in cited invention 2 in order to protect the eyesight of an infant. In this case, if a public TV program reported that a flexible plastic material used for the transparent window of a baby carriage damaged the eyesight of an infant prior to the priority date and if the fact that a rigid plastic material did not result in such a problem fell under the common general knowledge of the art to which the invention pertains, a person skilled in the art could have changed the material of the transparent window disclosed in the cited invention 1 to the rigid plastic material of the cited invention 2 without any difficulty. Therefore, the claimed invention would have been obvious to a person skilled in the art.

(4) In general, as a prior art disclosure referring to another disclosure can be considered to explicitly suggest a hint or motivation of a combination in the prior art disclosure, it is regarded as obvious to combine the two disclosures and the inventive step is therefore negated. Also, combining a plurality of technical features in the same disclosure is considered obvious, for a person skilled in the art would have combined the technical features without difficulty.

It is normally considered to be obvious to combine a well-known technology with another prior art disclosure. However, if a technical feature to be combined is a well-known technology in the art, but a combination with another technical feature results in an advantageous effect, the combination is not regarded as obvious.

(Example 1)
If cited invention 1 discloses all elements except for a leading portion of the claimed invention, and the leading portion of the claimed invention is substantially the same as the

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guide member of cited invention 2 referred to in cited invention 1, it would have been obvious to combine the cited invention 2 with the cited invention 1, thereby arriving at the claimed invention because the combination of the cited inventions 1 and 2 can be considered as being already implied.

(5) In general, if a combination invention achieves an effect by functional interaction between technical features, which is different from or greater than the sum of the effects of the individual technical features, e.g., a combined synergistic effect, the inventive step may be acknowledged since a set of technical features is considered to be a technically meaningful combination. If a combination invention described in a claim is regarded not as a meaningful combination, but merely as a juxtaposition (array) or aggregation (simple collection) of features, the inventive step of the combination invention may be denied by proving that the individual features are obvious insofar as there are no other grounds supporting the inventive step.

(Example 1)
The claimed invention is similar to the cited invention 1 except for a servo motor modified from a hydraulic actuator of cited invention 1 and a bending means described in cited invention 2 and substituted for the spindle of cited invention 1. In this case, if the modification or substitution of the elements does not lead to structural difficulties and the functional effect of new elements is not regarded as greater than the summed effects of the cited invention 1 and the cited invention 2, the claimed invention falls within an aggregation, and is therefore denied inventive step.

(Example 2)
The claimed invention corresponds to an aggregation of an ordinary injection molding machine disclosed in cited invention 1, a vacuum chamber disclosed in cited invention 2, and a mold fastening system disclosed in cited invention 3, wherein the vacuum chamber enables injection molding to be performed in vacuum and the mold fastening system facilitates work convenience. In this case, if the combination of the elements does not lead to particular difficulties, nor does the functional effect result in any remarkable difference, the aggregation is considered to be obvious to a person skilled in the art, thereby arriving at the claimed invention.

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(6) In determining the inventive step of a combination invention, care must be taken as the fact that one or more cited inventions must be combined with the closest cited invention in order to arrive at the claimed invention may indicate the presence of an inventive step. Also, it should be noted that the higher number of combined cited inventions, the more likely is that the claimed invention results from an ex post facto view or lacks a valid reason for rejection. When determining whether it would have been obvious to combine two or more other prior arts, the examiner should take into consideration of the followings: ① whether there is good possibility to combine them, ② whether the prior arts come from similar or neighboring technical fields, and ③ whether there is a reasonable basis to associate each other for the combination.

8. Other factors to be taken into account in determining obviousness

In principle, the determination of the inventive step is to consider synthetically the objective, technical constitution, and functional effect of an invention described in a claim, i.e., to determine the uniqueness of the objective and the remarkableness of the effect as a whole, mainly based on the difficulty of technical structure. However, there might be other factors in determining the inventive step. Thus, the examiner should not readily reach the conclusion that the claimed invention lacks an inventive step if a written opinion submitted by an applicant claims that the claimed invention is not obvious for the following reasons:

(1) If a prior art document teaches not referring to the prior art thereof, i.e., if there is a description in the prior art document that precludes the reasoning that a person skilled in the art would easily arrive at the claimed invention, the inventive step is not denied by the prior art despite the similarity between the prior art and the claimed invention. In addition, the fact that the prior art in a prior art document is described as inferior cannot be necessarily considered as a factor that precludes the inventive step.

(2) Commercial success or favorable comments from the industry or the fact that the claimed invention had not been implemented by anybody for a long time before the claimed invention was filed may be regarded as indicative of the inventive step as secondary evidence. However, those facts alone are not to be regarded as indicative of the inventive

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step. First of all, as the inventive step should be determined based on the contents disclosed in the specification (i.e., the objective, structure, and effect of the invention), commercial success is not to be regarded as a reference for the determination of the inventive step, provided that such success does not derive from the technical features of the invention but from other factors (e.g., improvement in sales techniques or advertising).

(Example 1)
Although a mobile video pop song accompaniment of the claimed invention made a hit in Japan with a signed two-year export contract worth $84,000,000, this cannot prove that the success is based only on the superiority of a technical structure of the claimed invention. In addition, if the success is determined as deriving from the sales techniques of a salesperson, evidence of the commercial success alone is not to be regarded as a factor in guaranteeing the inventive step.

(Example 2)
The claimed invention is related to a method of fixing metal accessories on a handrail, wherein a welding hole and a curved surface each have a size appropriate for welding so that internal welding can be performed. If the claimed invention had a better functional effect than a connection apparatus of a handrail pillar of prior external welding but the claimed invention had not been implemented before filing, then it would be regarded as non-obvious for a person skilled in the art to arrive at the claimed invention.

(Reference)
Given that the claimed device has a distinguished functional effect but has not been implemented before filing, it is deemed to be highly non-obvious to a person skilled in the art to devise the claimed device of this case (Precedent Case 99 Hu 1140).

(3) The fact that a claimed invention solves a technical problem that a person skilled in the art has attempted to solve for a long time or fulfills a long-felt need may regarded as an indication of the inventive step. In addition, such a solution of a technical problem or a need should be fulfilled by the claimed invention for the first time as a matter that has been recognized by a person skilled in the art for a long time. To accept this as an indication of inventive step, objective evidence is required.

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(4) If an invention is made by employing technical means which a person skilled in the art has abandoned due to technical prejudice interfering with the research and development of a technical problem in the relevant field of the art, thereby solving the technical problem, this is regarded as an indicators of the inventive step.

(5) If a claimed invention proposes means for overcoming technical difficulties not resolvable by other means or for solving a technical problem, this is regarded as advantageous evidence for an inventive step.

(6) If a claimed invention falls within the area of a brand-new technology and has no prior art relevant to the invention, or if the closest prior art to the invention is far away from the invention, the inventive step is likely to be acknowledged.

9. Notes on determination as to whether the claimed invention has an inventive step

(1) When determining the inventive step in the light of knowledge obtained from the matters disclosed in the specification of a patent application, which are the subject of examination, it should be noted that the examiner can rapidly conclude that it would have been obvious for a person skilled in the art to arrive at the invention described in the claims without difficulty.

(Example 1)
If the claimed invention is related to a terminal for use in an emergency situation, comprising a tapping mode blocking a voice signal reception of a receiving unit and only allowing a voice emission of a transmitting unit and if the cited invention merely discloses 'preventing others from noticing a voice reception from a terminal', the specific technical structure of the claimed invention is not obvious to a person skilled in the art. Therefore, the assessment that the claimed invention would have been obviously derivable from the description of the cited invention above results from an ex post facto analysis on the basis that the examiner knows the contents disclosed in the specification.

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(2) If an independent claim has an inventive step, a claim dependent on the independent claim is deemed to have an inventive step too. However, if an independent claim does not have an inventive step, the determination should be made for each claim dependent on the independent claim.

(3) If a product invention explicitly has an inventive step, a process invention for making the product or a use invention for using the product has also an inventive step in principle.

(4) For a claim described in a Markush form or comprising multiple selective technical features, if at least one invention of the Markush alternatives is proved not to have an inventive step based on the prior art, the applicant can be notified of the reason for refusal for the claim. In this case, the applicant can overcome the reasons for refusal by deleting the Markush alternatives which do not have an inventive step. On the other hand, in determining the inventive step of a claim described in a Markush form or comprising multiple selective technical features, care must be taken not to expand the effect of one of the selective elements to the whole effect of the claimed invention.

(Example 1)
If the claimed invention relates to neuroprotective chromanol compounds including various chemical compounds as selective elements, all of the chemical compounds must have a remarkable effect over one or more cited inventions in order for the claimed invention to be granted. Thus, it is not correct for an examiner to grant a patent based only on comparison test data concerning an alternative (formula (Ⅲ) compound) described in the specification as being significantly effective.

(5) A degenerate invention does not involve an inventive step. Granting a patent to a degenerate invention runs against the purpose of the Patent Act. Moreover, a degenerate invention is barely conducted and it would rather have a negative effect on those who use it, even if the degenerate invention is given exclusive rights by granting a patent.

(6) If the cited invention is regarded as a well-known technology, then the examiner may notify the applicant of the reasons for refusal without any evidential material attached. However, it is not appropriate to regard a well-known technology as being the closest cited

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invention without any evidential material.

In response to the reasons for refusal on the basis of a well-known technology without any evidential material attached, if an applicant claims that the invention is not a well-known technology in a written opinion, the examiner should in principle provide an evidential material with regard to the reasons for refusal. If the examiner has difficulties in providing an evidential material, the examiner may deny the inventive step by fully explaining why the invention falls under a well-known technology or pointing out why the applicant's argument is not proper.

Materials disclosing well-known technology include widely-used textbooks, introductory books, technical standards dictionaries, national standards (KS) in the field of the art to which the matter pertains, and so forth. However, it shall be noted that in the technical field with robust technical development such as information and communication technology, the content disclosed in the technical standards dictionaries or national standards (KS) cannot be perceived as well-known technology in some cases.

(7) As the inventive step of an invention is individually determined, not based on examination of precedents of other inventions, in the case of a patent application for a specific invention, examination precedents in foreign countries that differ in terms of the legal systems and customs are not taken into consideration.

(8) Although the implementation of a technical content of the claimed invention is prohibited due to the law restriction in Korea and abroad, such a restriction is not taken into consideration in determining the inventive step.

(Example 1)
If the claimed invention and the cited invention differ only in a method of lottery drawing and the method is strictly prohibited by law and cannot be readily modified by the lottery's designer, the claimed invention is obvious to a person skilled in view of its technical difficulty only and is considered to have no inventive step, for the law restriction is not taken into consideration.

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Chapter 4. Enlarged Concept of Novelty

1. Relevant Provisions

Article 29 (3), (4) of the Patent Act (Requirements for Patent Registration) (3) Notwithstanding Patent Act 29 paragraph (1), where an invention claimed in a patent application is identical with an invention or device described in the specification or drawing(s) originally attached to another application for a patent or for a registration of a utility model, which was filed prior to the date of filing of said patent application and has already been laid open or published after the filing of said patent application, the patent may not be granted for such an invention. However, this may not apply, where the inventor of the concerned patent application and the inventor of the another application for a patent or for a registration of a utility model are the same person, or where the applicant of the concerned patent application and the applicant of the another application for a patent or for a registration of a utility model are the same person at the time of the filing of the concerned patent application.

(4) In applying paragraph (3), where another patent application or a utility model registration application falls under any of the following subparagraphs, "laid open" in paragraph (3) shall be construed as "laid open for public inspection or internationally published pursuant to Article 21 of the Patent Cooperation Treaty", and "invention or device described in the specification or drawings initially attached to another patent application or a utility model registration application" shall be construed as "invention or device described in the specification, claims or drawings submitted on the international filing date" if it is applied for in the Korean language, and shall be construed as applied for in a foreign language:

1. Where another patent application is an international application which is deemed a patent application pursuant to Article 199(1) (including an international application which becomes a patent application pursuant to Article 214(4));

2. Where a utility model registration application is an international application which is

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deemed a utility model registration application pursuant to Article 34(1) of the Utility Model Act (including an international application which becomes a utility model registration application pursuant to Article 40(4) of the same act).

2. Purport of Article 29(3)

For an applicant, an invention described in a specification or drawings, if not in claims, which is usually opened to the public by the laying-open of the application or publication of registration, shall be deemed to be contributed to the society without reward.

Therefore, Article 29(3) and (4) of the Patent Act indicates that a patent shall not be granted to an invention laid open to the public since giving an exclusive right to another applicant who filed a subsequent application on the invention laid open to the public would be unreasonable and it would be inconsistent with the purpose of the Patent Act under which an exclusive right is granted to a new invention within a designated period as a reward for the disclosure.

Moreover, Article 29(3) and (4) of the Patent Act aims to prevent cases where an invention disclosed in a specification or drawings is described in the claims through amendments, the application may serve as a prior application under Article 36 of the Patent Act, leading to possible delays of examination of a subsequent application until the examination of the prior application is completed.

3. Conditions to meet the requirement of Article 29 (3) and (4)

In order to satisfy the requirements of Article 29 (3) and (4) of the Patent Act, the following conditions shall be met.

(1) Another application for a patent or for a registration of a utility (referred to as "another application" hereinafter) shall have been filed before the filing date (the filing date of the first filing country in case of the application with priority claim under the Paris Convention or the filing date of prior application in case of the application with domestic priority claim) of the concerned patent application (referred to as "concerned application" hereinafter).

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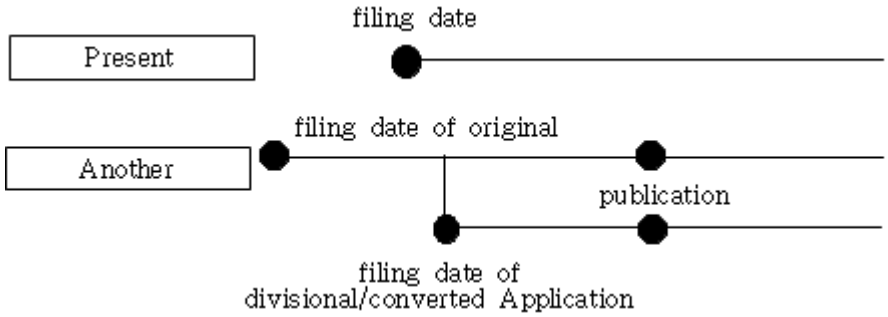
① Where another application is a divisional application or a converted application (a double application in case of the application filed prior to October 1 2006) under Article 29 (3) and (4), the critical filing date shall be the actual filing date of a divisional application or a converted application.

(Example 1)

Since the divisional application or the converted application shall not have the retroactive filing date in applying Article 29 (3), the divisional application or a converted application cannot be cited as a prior art because the filing date of such application is after the filing date of the concerned patent application. However, the original application of such application can be another application and be cited as prior art if the filing date of the original application is prior to that of the concerned patent application.



② Where another application is one with a priority claim under the Paris Convention, the filing date in the country of origin is deemed as the filing date of another application, for an invention commonly disclosed in the specification or drawings(referred to as an "specification, etc." hereinafter) attached to the application in the country of origin and in the specification or drawings originally attached to the application with the priority claim.

(Example 1)

Invention A of another application can be cited as a prior art of the concerned patent application, if the filing date of Invention A disclosed in the application filed in the country of origin as a reference is deemed to the date of filing in the country of origin when applying Article 29 (3) of the Patent Act. Invention B cannot be cited as a prior art if

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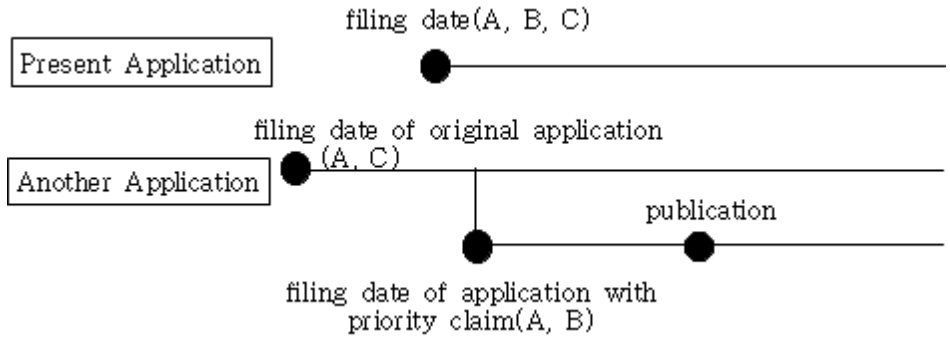
Invention B was not disclosed in the application filed in the country of first filing. Meanwhile, Invention C, which is described in the application filed in the country of first filing but is not included in the concerned application with priority claim, was not disclosed in the application filed in Republic of Korea cannot be cited as a prior art of the concerned patent application.



③ Where an examiner cites an invention initially disclosed in a specification of a prior application which was a basis for a domestic priority claim or an application with a domestic priority claim thereof (referred to as a "subsequent application" hereinafter) as an invention of another application under Article 29 paragraph (3) and (4), it is treated as follows:

(a) The invention commonly disclosed in the initial specification of both prior and subsequent applications, is deemed as another application filed on the filing date of prior application and should be applied in the provision of Patent Act Article 29 paragraph (3) and (4) (Patent Act Article 55 paragraph (3) and (4)). The invention solely disclosed in the initial specification, etc. of a subsequent application but not in that of prior application, is deemed as another application filed on the filing date of subsequent application and should be applied in the provision of Patent Act Article 29 paragraph (3) and (4) (Patent Act Article 55 paragraph (4)). The invention solely disclosed in an initial specification, etc. of prior application but not in that of subsequent application should not be applied in the provision of Patent Act Article 29 paragraph (3) and (4) (Patent Act Article 55 paragraph (4)).

An prior application is deemed to have been withdrawn when more than one year and three months(in the case of the application for a registration of a utility model filed after 2001. 7. 1, immediately applied) has elapsed after the filing date of the prior application(Patent Act

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Article 56 paragraph (1)) and is not laid open. Therefore, where a subsequent application is laid open or published, the invention commonly disclosed in the initial specification of both prior and subsequent applications is deemed as laying-open at the time for lay-open or publication of subsequent application. In addition, where an invention was not disclosed in the initial specification of the prior or subsequent applications but newly described through the amendment, the treatment above does not apply. Where an invention was not described in the initial specification of subsequent application but described in the initial specification of prior application, the invention is not deemed to be laid open to the public. Therefore, Article 29 paragraph (3) and (4) are not applied to such an invention.

(b) In the case of (a), where a prior application is an application with a domestic priority claim (including a priority claim under the Paris Convention), the invention commonly disclosed in the specification of both prior and subsequent applications is deemed as another application filed on the filing date of subsequent application and should be applied in the provision of Patent Act Article 29 paragraph (3) and (4) (Patent Act Article 55 paragraph (5)).

(Example 1)
As example ① shows below, where a subsequent application is filed with a priority claim based only on a prior application, among the inventions A and C described in the prior application, the invention A disclosed in the original application filed at the country of origin, which is a basis of the priority claim of the prior application under the Paris Convention, is considered to be filed at the filing date of subsequent application under Article 29 paragraph (3). Therefore, invention A of the subsequent application cannot be cited as a reference under Article 29 paragraph (3) even though the invention A is described in the prior application. The invention C of the prior application can only be cited as a reference.

(Example 2)
Meanwhile, as example ② shows below, where a subsequent application was filed with priority claims based on the application filed at the country of origin as well as a prior application, the invention A of the prior application can be cited as a reference under Article 29 paragraph (3).

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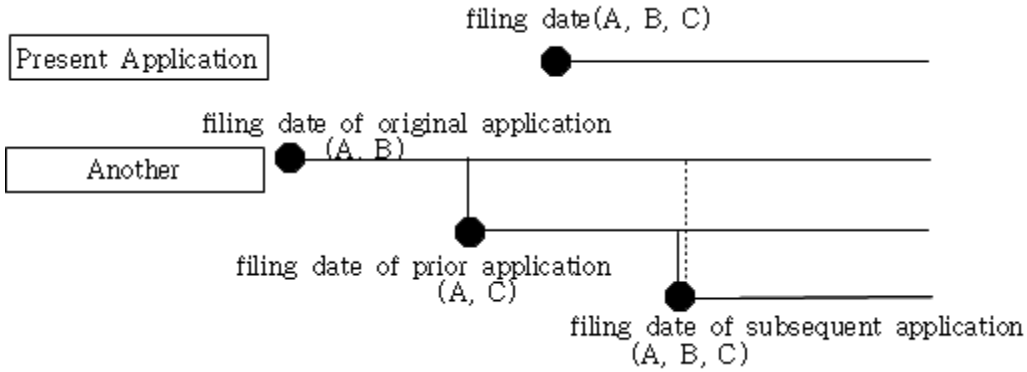

(Footnote)
Case ① : where a subsequent application is filed with a priority claim based only on a prior application
Case ② : where a subsequent application is filed with priority claims based on the application filed at the country of origin as well as a prior application

(2) Another application should be laid open or published for registration after the concerned application was filed.

Once an application is laid open or published for registration, the status of the application as another application still remains effective despite refusal or grant of a patent, invalidation, withdrawal or abandonment of the application. However, where an application is laid open to the public, after the decision of refusal, invalidation, withdrawal and abandonment of the application, the application cannot be cited as a reference under Article 29 paragraph (3).

(3) An invention described in the claims of the concerned application should be identical to an invention or device described in the initial specification of another application

The invention described in the claims of the concerned application should be completely or substantially identical to an invention or device described in the initial specification of another application. In addition, even if the matters which have been described in the initial specification of another application are omitted by the amendment after the filing, Article 29 paragraph (3) is implemented.

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4. Guidelines applying the proviso of Article 29 paragraph (3)

An application falling within the following conditions are not considered as another application under Article 29 paragraph (3) and (4).

(1) In a case where an inventor of the concerned application is the same as the inventor of another application

「The inventor」 of the concerned application and another application means the inventor described in the application document. In case of joint inventions, all inventors of concerned application must be completely identical with those of another application. However, even if all inventors do not completely correspond, if the applicant proves the fact that all inventors are practically the same, examiner can admit the applicant's argument. In a case where an applicant adds or amends an inventor of an application after an examiner notifies the applicant of the reasons for refusal, in which another application is cited as a reference due to the difference of the inventor, he or she has a right to request documents to testify that the inventors added or amended are true inventors.

(2) Where the applicant of the concerned application at the time of filing is the same as the applicant of another application

The applicants of the concerned application and another application should be identified and compared at the time of filing the concerned application to determine whether the applicants are the same. In the case of plural applicants, all of the applicants indicated in the two applications must be the same. Even in the case of the subsequent discrepancy of applicants caused by the change of name, inheritance or a merger of applicants of the present and another applications between the filing date of the concerned application and that of another application, the sameness of applicants remains effective only if the applicants of the present and another applications are substantially same.

5. International application under Article 29 paragraph (4)

Where another application is an international application or international application

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considered to be patent application by decision, the following points are different when applying Article 29 paragraph (3), compared to another application which is not an international application.

In a case where another applicant is an international application, in Article 29 paragraph (3), "laid open" refers to "laid open or international publication under PCT Article 21" and "an invention or device described in specification or drawings initially attached to the application on the filing date" means "an invention or device commonly described in a specification, claims and drawings submitted at the date of filing of the international application and its translation".

Under Article 29 paragraph (3) and (4) in the international application with the domestic priority claim, it is considered that the invention described in the specification or drawings of prior application being the basis of the domestic priority claim among inventions commonly described in a specification, claims and drawings submitted at the date of filing of the international application and its translation, is considered to be laid open to the public at the time of international publication under PCT Article 21 or publication of registration(Article 202 paragraph (2)).

Under Article 29 paragraph (4), where another application is an international application, the scope of applying enlarged concept of novelty of the international application includes the invention commonly described in a specification, claims and drawings submitted at the date of filing of the international application and its translation. However, the concerned application shall be refused by an invention described in the international application (Article 55 paragraph (4)) where the international patent application is a prior application and is the basis of domestic priority claim for another application, if the subject matter of the concerned application is the same as the invention described in the a specification, claims and drawings submitted at the date of filing of the international application,.

6. Method of Determination of Identicalness

Determining of applying Article 29 paragraph (3) and (4) refers to whether an invention described in the claimed invention is identical to the invention or device specified in the

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description or drawings in another application at its filing (hereinafter referred to as "cited invention").

6.1 Procedure of Determination of Identicalness

(1) Find an invention of the concerned application described in the claims. The method of finding invention is identical to that of determining novelty in chapter 2.

(2) The subject matters described in description of another application should be reviewed. The subject matters which can be obtained by the common general knowledge might be the basis of a cited invention under Article 29 paragraph (3) and (4).

(3) Identicalness and difference by comparing the claimed invention with the cited invention shall be found. In this case, the claimed invention should not be compared with the invention by combining more than two cited inventions.

(4) Where there is found no difference between the subject matters defining the claimed invention and the subject matters defining the cited inventions, the claimed and cited inventions are identical. In this case, the identicalness of the inventions includes the substantial identicalness.

6.2 Substantial Method of Determination of Identicalness

Novelty is determined by comparing whether the claimed invention and the cited invention are identical. The identicalness of invention is related with determining novelty as well as inventive step (Article 29 paragraph (2)), invention not considered to be publically known (Article 30), enlarged concept of novelty (Article 29 paragraph (3), (4)), protection of lawful holder of a right (Article 33, 34), prior application (Article 36), succession to the right to obtain a patent (Article 38 paragraph (2), (3), (4)), divisional application (Article 52), converted application (Article 53) and application with the priority claim (Article 54, 55). Therefore, the criteria of determining the identicalness of invention shall apply in the cases mentioned above.

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(1) Determining the identicalness of the inventions relies on identicalness and differences between the subject matter defining the claimed invention and the subject matter defining the cited inventions by comparison.

(2) In a case where there is a difference between the subject matters of the claimed invention and the subject matters of the cited inventions, two inventions are not identical. Meanwhile, if there is no difference between them, the invention in the claims is identical to a cited invention.

(3) Where the claimed invention is completely or substantially identical to a cited invention, the claimed invention is identical to a cited invention.

6.3 Where Inventions are substantially identical

Where inventions are substantially identical refers to the case where simply non-substantial matters (secondary matters), not the technical ideas of the inventions, are different in the subject matter of the claimed invention and the subject matter of the cited invention, such as differences in expression, recognition of effects, purposes or use as well as change in constitution or existence of use limitation and so on.

(Example) Determination on identicalness of the inventions regarding the enlarged concept of novelty under Article 29(3) of the Patent Act shall be made based on the identicalness of the technical constitution of both inventions as well as the effects of the inventions. Even if the technical constitutions of both inventions are different, but such differences exist in the detailed means for solving the technical issues, such as the mere addition, deletion or change of prior arts, not leading to the creation of new effects, the two inventions shall be deemed to be substantially identical (Case No. 2006 Hu 1452(Supreme Court, March 13, 2008)).

6.3.1 Difference in Expression

Differences in expression refer to expressions used in patent claims are different, but the contents are substantially the same and difference in categories shall be treated as

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difference in expressions.

(Example) 「The method of desalination of sea water」 and 「the method of concentration of sea water」 by separating water from sea water through the insertion of a refrigerant undissolved in sea water

6.3.2 Difference in Recognition of Effects

Differences in recognition of effects refer to recognition of effects of the inventions is different even though the effects of the inventions are identical because of the identicalness of the constitutions of both inventions.

(Example) As for an invention disclosing a conductor covered with polyethylene, where differences in recognition of the effects of the invention exist since a prior application discloses that the invention has greater electric insulation, whereas a subsequent application discloses that the invention exhibits better high frequency properties.

6.3.3. Difference in Purposes

Differences in purposes refer to subjective purposes of the inventions are different even though the constitutions of the inventions are the same.

6.3.4 Change in Constitutions

Changes in the constitutions of the inventions refer to the case where the constitution of the invention is changed and the constitution becomes another invention and such changes constitute mere substitution, addition or deletion of the technical means which could be easily made by a person skilled in the art as the detailed means to achieve the purpose of the invention and the changes do not lead to significant changes in the purposes and effects of the inventions. Such changes in constitution of the invention include 「mere change of means」, 「mere addition or deletion of means」, 「mere change of material or mere substitution of equivalents」, 「mere change of equal means」, 「mere limitation or

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change of figures, numbers or sequence」 and 「mere limitation or change of figures」.

(1) Mere Change of Means

Mere change of means refers to the case where the constitution of an invention is changed and therefore, it has become another invention. Where such changes do not lead to significant differences in the purposes and effects of the invention, the concerned change of constitution of the invention is a mere change of means.

(Example) 「A manufacturing process of clarifying pure fruit juice by using bentonite and then vacuum freeze drying the juice into powdered fruit juice」 and 「a manufacturing process of clarifying pure fruit juice by using diatomite then vacuum freeze drying the juice into powdered fruit juice」

(2) Mere Addition or Deletion of Means

Mere addition or deletion of means refers to the case where the constitution of an invention is changed and therefore, it has become another invention. Where such changes do not lead to significant differences in the purposes and effects of the invention, the concerned changed of the constitution of the invention is a mere change of addition or deletion of means.

(Example) 「A manufacturing process of P-nitrotoluidine by nitrifying toluene」 and 「A manufacturing process of P-nitrotoluene by nitrifying toluene and then returning it back to P-toluene」(however, 「a manufacturing process of P-toluidine by returning P-nitrotoluene back」 shall be a means).

(3) Mere Change of Material or Mere Substitution of Equivalent

Mere change of materials or mere substitution of equivalents refers to the case where the constitution of an invention is changed and therefore, it has become another invention and then such changes constitute substitution of materials or article having comparability or the same function and such changes do not lead to significant differences in the purposes and

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effects of the invention.

(Example) 「A foundation pile with blades attached on the concrete shack」 and 「a foundation pile with blades on the shack pile」

(4) Mere Change of Equal Means

Mere change of equal means refers to the case where the constitution of an invention is changed and therefore, it has become another invention and then such changes constitute changes of means having comparability or the same function and such changes do not lead to significant differences in the purposes and effects of the invention.

(5) Mere Limitation or Change of Figures, Numbers or Sequences

Mere limitation or change of figures, numbers or sequences refers to the case where the constitution of an invention is changed and therefore, it has become another invention and then such changes constitute mere limitation or change of figure, numbers or sequences that a person skilled in the art would commonly apply to based on the purpose and other constitutions and such changes do not lead to significant differences in the purposes and effects of the invention.

(6) Mere Limitation or Change of Figures

Mere limitation or change of figures refers to the case where the constitution of an invention is changed and therefore, it has become another invention and then such changes constitute mere limitation or change of figures that a person skilled in the art would commonly apply to based on the purpose and effects and such changes do not lead to significant differences in the purposes and effects of the invention.

6.3.5 Differences in Mere Use

Differences in mere uses of the invention refer to the case where the differences in two inventions having different constitutions are marked as the differences in uses and the

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differences in uses can be derived from the differences in the uses of other constitutions.

(Example) 「A plasticizer of polyvinyl chloride comprising compound B」 and 「A ultraviolet light absorber of polyvinyl chloride comprising compound B」

(Example) 「A method of spraying chemical A on the fields to repel hares (Hare Repellent A)」 and 「A method of spraying chemical A on the fields to repel deer(Deer Repellent A)」

6.3.6 Existence of Use Limitation

Existence of mere limitation of uses refers to the case where differences in two inventions are marked as whether their uses are limited or not and such uses are mere use limitation clearly derived from other constitutions of the invention.

(Example) 「A net comprising threads with flat cross sections」 and 「A fish net comprising threads with flat cross sections」

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Chapter 5. First-To-File Rule

1. Relevant Provisions

Article 36 of the Patent Act (First-to-File Rule) ① Where two or more applications relating to the same invention are filed on different dates, only the applicant of the application having the earlier filing date may obtain a patent for the invention.

② Where two or more applications relating to the same invention are filed on the same date, 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 shall obtain a patent for the invention.

③ Where a patent application has the same subject matter as a utility model registration and the applications are filed on different dates, paragraph (1) shall apply *mutatis mutandis*; whereas if they are filed on the same date, paragraph (2) shall apply *mutatis mutandis*.

④ Where a patent application or utility model registration application is invalidated, withdrawn or abandoned, or a decision or trial decision to reject the application becomes final and conclusive, such application shall, in applying paragraphs (1) through (3), be deemed never to have been filed: *Provided*, That this shall not apply where a decision or trial decision to reject to the patent application or utility model registration application becomes final and conclusive pursuant to the latter sentence of paragraph (2) (including cases where it applies *mutatis mutandis* under paragraph (3)).

⑤ A patent application or utility model registration application filed by a person who is not the inventor, creator, or successor in title to the right to obtain a patent or utility model registration shall, in applying paragraphs (1) through (3), be deemed never to have been filed.

⑥ In cases of paragraph (2), the Commissioner of the Korean Intellectual Property Office shall order the applicants to report the results of the consultation within a designated

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period. If such report is not submitted within the designated period, the applicants shall be deemed not to have reached agreement under paragraph (2).

2. Purport of Patent Act Article 36

Article 36 of the Patent Act stipulates the first-to-file system under which two or more applications relating to the same invention are filed and the person who files the earliest patent application is granted a patent right. Under the patent system, an exclusive patent right is granted to a patent applicant for a certain period of time in reward for the publication of the invention. The patent system has been introduced to realize the principle of prohibition of double patenting since granting multiple exclusivities to a single technical idea is against the nature of the patent system.

3. Application Requirement

3.1 Identical Invention

(1) The first-to-file system shall apply to the same invention disclosed in different applications. The identicalness of the invention shall be determined based on whether the claimed inventions in the applications have the same technical ideas (including the determination on identicalness of the invention and utility model, hereinafter the same).

(2) Where more than two claims exist, whether the invention in each claim is identical shall be determined.

(3) Article 36 of the Patent Act shall apply regardless of the identicalness of inventors or applicants.

(4) The identicalness of the technical ideas of the claimed inventions shall be determined by comparison of the subject matter of the inventions in the following process:

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① The inventions disclosed in claims shall be specified. The process of specifying the inventions disclosed in claims is the same as that in 「Chapter 2. Novelty」.

② Identicalness and differences on the inventions disclosed in the claims shall be identified by comparison.

③ When no difference in the compositions of the claimed inventions is found, they shall be deemed identical. Even when differences in the compositions exist, but the claimed inventions fall under 「paragraph 6 of Chapter 4. Enlarged Concept of Novelty」, the inventions shall be deemed to be the same (including substantial identicalness).

3.2 Applications without Status of Prior Application

(1) Where a patent application or an application of utility model registration is invalidated, withdrawn or abandoned or a decision or trial decision to reject an application has become final and conclusive, the patent application or the application of utility model registration shall no hold the status of prior application.

However, even for an application on which a decision or trial decision of rejection has become final and conclusive, where the application falls under the latter sentence of Article 36(2) of the Patent Act (including where the proviso of paragraph (3) applies *mutatis mutandis*) and the decision or trial decision to reject the application has become final and conclusive, the application shall hold the status of prior application (It shall apply to applications filed after March 3, 2006).

(Note) The above-mentioned provision intends to prevent the applicants from being granted a patent right by filing the application again after the ground for decision of rejection is made due to the failure of consultation among the applicants, by not granting the status of prior application when the ground for decision violates the first-to-file system.

(2) A patent application or an application of utility model registration filed by a person who is neither an inventor nor a devisor and is not a successor in title to the right to obtain a

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patent or a utility model registration, too, shall not hold the status of prior application under Article 36 of the Patent Act.

4. Examination Method

4.1 Acknowledgement of Critical Date

(1) The critical date used to determine whether the filing dates of the concerned applications are the same or which is the earliest-filed application shall be recognized in the following manner:

① The critical date of an application without priority claim shall be the actual filing date.

② The critical date of an application with priority claim under the treaty on an invention disclosed in the specification or drawings of the application serving as the basis of the priority claim shall be the filing date of the application which is the basis of the priority claim. As for an application with multiple priority claims, the critical date shall be the earliest filing date among the filing dates of each invention.

③ The critical date of an application with domestic priority on an invention disclosed in the specification or drawings of the application serving as the basis of the prior application serving as the basis of the priority claim shall be the filing date of the application which is the basis of the priority claim. As for an application with multiple priority claims, the critical date shall be the earliest filing date among the filing dates of each invention. It shall be noted that Markush type claims, etc. shall have different critical dates even in the same claims.

④ The critical date of a divisional application and converted application shall be the filing date of the original application.

⑤ The critical date of an application filed by a lawful holder of a right shall be the filing date of a misappropriated application and the misappropriated application shall be deemed to have never been filed and its critical date shall not be acknowledged.

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(2) For the determination of the earliest-filed application, the critical date of an international patent application shall be acknowledged in the following manner:

① The critical date of an international patent application in which the Republic of Korea is a designated state shall be the filing date of the international patent application on an invention disclosed in the translation of the specification, claims or drawings of the international patent application.

② As for an international application considered to be a patent application or an application of utility model registration by decision, the critical date shall be the filing date of the invention disclosed in the translation of the specification, claims or drawings of the international patent application under Article 214(4) of the Patent Act or Article 40(4) of the Utility Model Act.

4.2 Where more than two applications on the same invention are filed on different dates

(1) Where more than two patent applications relating to the same invention are filed on the same date, only the applicant of the application having the earlier filing date may obtain a patent for the invention. Even when the invention in a patent application and the utility model in an application of utility model registration are the same, only the person of the application having the earlier filing date may obtain a patent or a utility model registration for the invention.

(2) Even when more than two applications relating to the same invention are filed on different dates, an examiner shall examine the applications in the following manner:

① Where an applicant and an inventor are not the same person and the earlier application is laid open or registered, the provisos of Article 29(3) and (4) of the Patent Act shall primarily apply to any subsequent application. The proviso on the extended first-to-file system can be flexibly applied within the specification or drawings of another application if

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the application is already laid open even before the claims of the prior application are confirmed.

If a prior application is not laid open, the examination on a subsequent application shall be postponed until the prior application is laid open or registered.

② Where the applicant of a subsequent application is the same as the applicant of the prior application, or the inventors of the inventions disclosed in the prior application and the subsequent application are the same, the proviso of Article 36 of the Patent Act shall be applied since Article 29(3) or (4) of the Patent Act cannot be applied. In such a case, where an examiner intends to make a decision to reject a subsequent application relating to the same invention, the examiner shall make the decision after the scope of the claims in the prior application is confirmed.

Applicants of Prior/Subsequent Applications	Prior Application	Start of Examination of Subsequent Application
Identical	Published	Examination started, Rejection Ground under Article 36(1) notified (Decision to grant patent after claims in prior application is confirmed)
	Not Published	Examination started, Rejection Ground under Article 36(1) notified (Only application number and claimed invention in prior application specified, decision to grant patent after claims in prior application is confirmed)
Different	Published	Examination started, Rejection Ground under Article 29(3) and (4) notified (But, Article 36(1) applied in case of identicalness of inventors)
	Not Published	Examination postponed until publication of prior application

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4.3 Where more than two applications relating to the same invention are filed on the same date

(1) Where more than two patent applications relating to the same invention are filed on the same date, 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 shall obtain a patent for the invention.

(2) Where no consultation is possible means ① where no agreement can be reached since the counterpart refuses to consult and ② where one of more than two applications filed on the same invention is granted a patent (utility model registration) or where a decision or a trial decision to reject a patent or utility model registration has become final and conclusive under the latter sentence of Article 36(2) of the Patent Act (including the case where the proviso of paragraph (3) applies *mutatis mutandis*).

(3) When an agreement is reached, a report on change of right relation in Annexed Form No. 20 of the Enforcement Rules of the Patent Act shall be submitted. Also, relevant procedures such as withdrawal of contrasting applications based on the result of consultation shall be conducted at the same time. Where only a report on change of right relation is submitted but subsequent procedures based on the result of consultation are not carried out, it shall be deemed that no consultation is reached.

(Note) An applicant who received a request for consultation can address a ground for rejection on the contrasting applications by changing or deleting the contrasting invention through the submission of amendment without consultation of the concerned parties.

(4) Even when an invention in a patent application and a utility model in an application of utility model registration are filed on the same date relating to the same claims, they shall be treated as in the above-mentioned (1)~(3).

4.4 Detailed Content of Examination of Contrasting Applications

(1) Confirmation on Contrasting Applications

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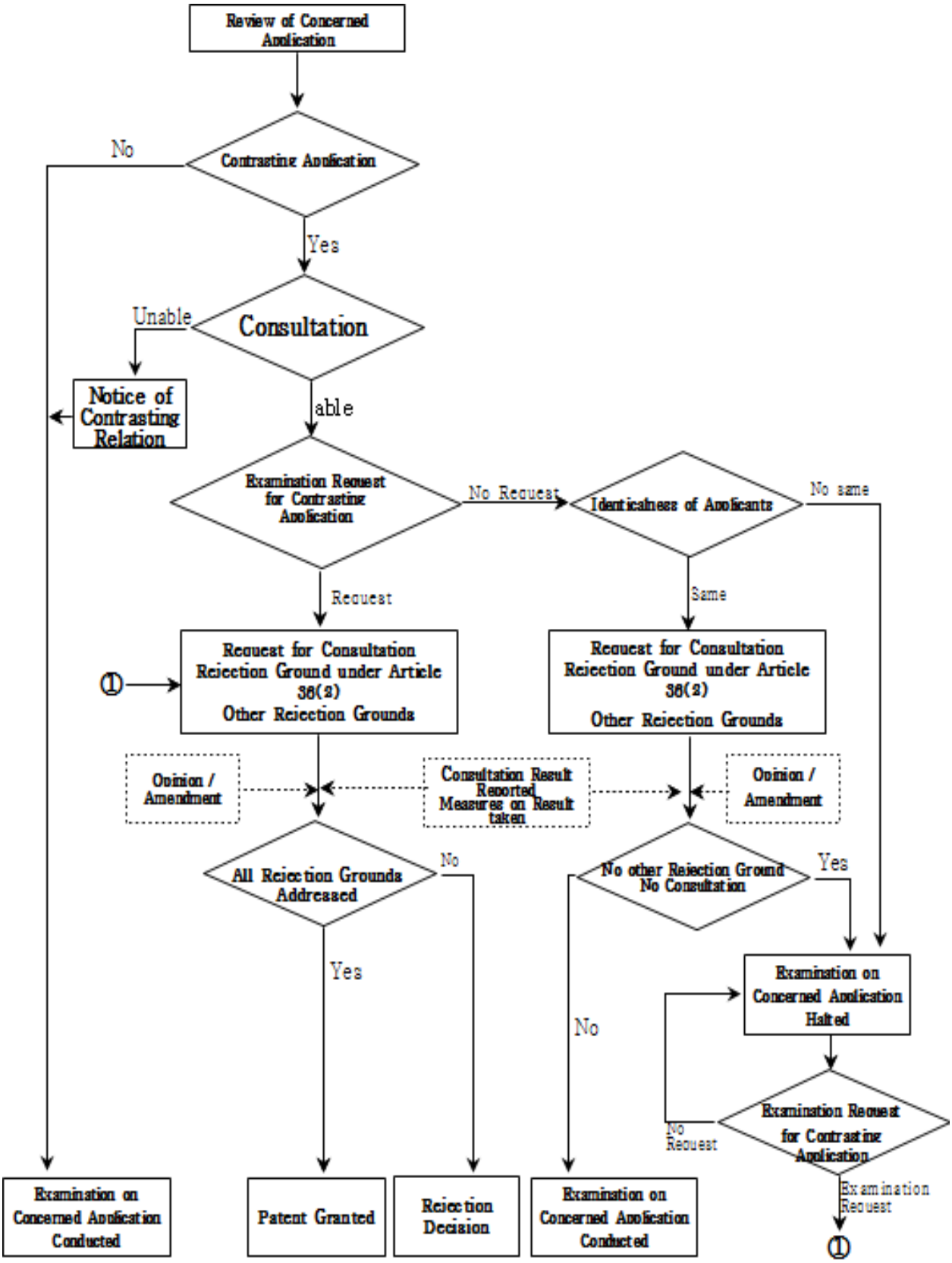
Where contrasting applications are found after searching whether more than two applications relating to the same invention are filed on the same date, any possibility on consultation between the concerned application and the contrasting application shall be checked.

Where the contrasting application is invalidated, withdrawn or abandoned, where a decision to reject based on any ground for rejection other than grounds under Article 36(2) or (3) of the Patent Act or where the application constitutes an application filed by an unentitled person, the concerned contrasting application cannot hold the status of prior application. Therefore, an examiner shall conduct examination considering that the contrasting application has never been filed.

(Note) In examination practices, contrasting applications can be found mostly when an applicant incorrectly amended the claims of the original application when filing a divisional application, not when an applicant and an inventor are different.


Review of Concerned Application
Contrasting Application
No
Yes
Consultation
Unable
able
Notice of Contrasting Relation
Examination Request for Contrasting Application
No Request
Identicalness of Applicants
No same
Same
Request
Request for Consultation Rejection Ground under Article 36(2) Other Rejection Grounds
①
Request for Consultation Rejection Ground under Article 36(2) Other Rejection Grounds
Opinion / Amendment
Consultation Result Reported Measures on Result taken
Opinion / Amendment
All Rejection Grounds Addressed
No
Yes
No other Rejection Ground No Consultation
Yes
No
Examination on Concerned Application Halted
Examination Request for Contrasting Application
No Request
Examination Request
①
Examination on Concerned Application Conducted
Patent Granted
Rejection Decision
Examination on Concerned Application Conducted

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(2) Confirmation on Possibility of Consultation

Where no agreement can be reached because a contrasting application is granted a patent, an examiner shall conduct examination on the concerned application. Where a contrasting application is granted a patent and the applicant of the concerned application and the applicant of the contrasting application are not the same, an examiner shall notify the applicant of the contrasting application of such fact through the On-nara System (referring to 'Government Electronic Document Management System). When notifying a ground for rejection to the applicant of the concerned application, an applicant shall indicate the fact of contrasting relation in the ground for rejection.

When consultation on contrasting applications is possible, an examiner shall check whether a request for examination on the contrasting applications is made.

(3) Where a contrasting application is laid open and requested for examination

Where a contrasting application is requested for examination, an examiner shall make a request for consultation under the name of the Commissioner of the Korean Intellectual Property Office within a designated period. In such a case, the examiner shall notify an applicant of a ground for rejection under Article 36(2) or (3) of the Patent Act(where other grounds for rejection exist, such grounds may be included), along with the request for consultation to the concerned application and the contrasting application. In principle, a request for consultation and a ground for rejection shall be notified in separate notices. However, only a request for consultation can be made considering examination efficiency (where the contrasting relation can be easily addressed upon a request for consultation).

After receiving a request for consultation, if an applicant addressed a ground for rejection under Article 36(2) or (3) of the Patent Act by reporting on the result of consultation and taking measures on the result of consultation within a designated period, an examiner shall make a decision to grant a patent. Where a ground for rejection exists and the ground for rejection has been already notified, an examiner shall make a decision of rejection.

(4) Where a contrasting application is yet to be laid open or requested for examination

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① Where an applicant of the contrasting application and an applicant of the concerned application are not the same, an examiner shall notify the applicant of the concerned application of the intention that examination is postponed until the contrasting application is requested for examination or withdrawn or abandoned.

② Where an applicant of the contrasting application and an applicant of the concerned application are the same, an examiner shall notify a ground for rejection under Article 36(2) or (3) of the Patent Act along with the request for consultation on the concerned application and the contrasting application (where other grounds for rejection exist, such grounds may be included). In principle, a request for consultation and a ground for rejection shall be notified in separate notices. However, only a request for consultation can be made considering examination efficiency (where the contrasting relation can be easily addressed upon a request for consultation).
An examiner shall make a decision to grant a patent when an applicant addressed a ground for rejection under Article 36 (2) or (3) of the Patent Act by reporting on the result of consultation and taking measures on the result of consultation within a designated period and no other grounds for rejection exist. Where a ground for rejection exists and the ground has been already notified and it does not constitute a ground for rejection under Article 36(2) or (3) of the Patent Act, an examiner shall make a decision of rejection.

Where any measure relating to the result of consultation has not been taken within a designated period after a request for consultation, an examiner shall notify the applicant of the concerned application of the intention that examination is postponed until the contrasting application is requested for examination or withdrawn or abandoned.

<table>
<tr><th>Applicant of Contrasting Application</th><th>Disclosure of Contrasting Application</th><th>Request for Examination on Contrasting Application</th><th>Examination on Contrasting Application</th></tr>
<tr><td rowspan="3">Identical</td><td rowspan="2">Published</td><td>Requested</td><td rowspan="3">Request for Consultation+
Article 36 (2), (3)
or Request for Consultation</td></tr>
<tr><td>Not Requested</td></tr>
<tr><td>Not</td><td>Requested</td></tr>
</table>

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	Published	Not Requested	
Different	Published	Requested	Request for Consultation
		Not Requested	Notice on Postponement of Examination
	Not Published	Requested	
		Not Requested	

(5) Extension of Designated Period after Request for Consultation

Where a request for consultation and a ground for rejection are notified at the same time, an applicant intending to extend the designated period may make a request for extension of the designated period relating to the submission of a written opinion as well as a designated period upon a request for consultation.

5. Instruction on Examination

(1) Where a contrasting application is registered and therefore, no consultation can be made, giving up the patent or the utility model registration would not mean that consultation is possible or the contrasting relation is resolved. It is because that there are no such provisions to recognize the above-mentioned condition and unlike giving up an application, giving up a patent or a utility model registration does not mean that a contrasting application is deemed to have never been filed since it cannot enjoy retroactive effect.

(Note 1) In applying Article 36(3) of the Patent Act before the revision (the act before the revision made on February 3, 2001 Act No. 6411), the argument that giving up a patent or a utility model registration can address irregularities relating to a contrasting application so that a third party can claim the effect of a patent right is groundless. Also, it can undermine the legal security since a right holder can arbitrarily select the subject and time of abandonment, leading to the right relation in an unstable condition. Eventually, giving up a patent right or a utility model registration would unfairly guarantee the retroactive effect unlike abandoning an application and moreover, abandoning a patent right is carried out just through registration, which is not the proper way of public announcement. All things considered, even though either a registered patent right or a utility model registration was abandoned by a right holder in the application is in the contrasting relation, it cannot be

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deemed that irregularities of a contrasting application are addressed (Supreme Court's decision 2007. 1. 12. 2005Hu3017).

(Note 2) Where the same person filed contrasting applications on the same utility model on the same date and all the applications are registered, even if one of the applications is invalidated, the registration of the other applications shall be maintained. The fact that these applications were initially contrasting applications does not necessarily mean that the registration of other contrasting applications should be deemed to be invalidated (Supreme Court's decision 1990. 8. 14. 89Hu31103).

(2) Even though there exists a contrasting application, an examiner may make a decision of rejection based on other grounds for rejection instead of referring to the contrasting application or notifying a ground for rejection based on the contrasting application. Under the Korean Patent Act, when there exists a ground for rejection, an examiner may make a decision of rejection after giving an applicant an opportunity to submit a written opinion. However, the act does not stipulate that an examiner shall make a decision of rejection citing every possible ground for rejection.

(Note) Where more than two applications of utility model registration on the same utility model are filed on the same date, but the utility model lacks novelty or inventive step, making the ruling of refusal without conducting 'consultation procedures, etc. among applicants' under Article 7(2) and (6) of the Utility Model Act before the revision shall be deemed legitimate (Supreme Court's decision 2000. 1. 21. 97Hu32576).

(3) Where an invention with the lower concept in a prior application is described as an invention with the upper concept in a subsequent application, the two inventions shall be deemed to be identical.

(4) Where the filing dates of Invention A and Invention B are the same, even though, on the assumption that Invention A is in a prior application and Invention B is in a subsequent application, Invention B and Invention A are deemed to be substantially the same based on the result of comparison, when both inventions are compared again considering that Invention A is in a subsequent application and Invention B is in a prior application, but they

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are not substantially the same, the two inventions shall not be deemed to be identical.

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Chapter 6. Unpatentable Invention

1. Relevant Provision

Article 32 of the Patent Act(Unpatentable Inventions) Inventions that have risks to contravene public order or morality or to injure public health shall not be patentable, notwithstanding Article 29 (1) to (2).

2. Purport of Patent Act Article 32

For reasons of public interest, Article 32 of the Patent Act stipulates that a patent would not be granted for 「inventions that have risks to contravene public order or morality or to injure public health」 even if the invention falls within the patentable subject matter of Article 29 (1) to (2). As a result, a patent cannot be granted for an invention which falls under Article 32 without having to consider patentability requirements under Article 29 of the Patent Act.

3. Unpatentable invention

3.1 Invention likely to contravene public order or morality

An invention likely to contravene public order or morality is considered as unpatentable. In general, the two words are not separately used but more specifically, public order refers to the general interest of society or country and morality means moral sense generally accepted by society or by a particular group of people.

Therefore, it shall be noted that a patent cannot be granted for an invention likely to contravene public order or morality without having to consider the objective of the Patent Act.

An invention which falls within the subject matters under Article 32 of the Patent Act is an invention with the aim to contravene public order or morality as well as the disclosure or its

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use is against public order or morality.

However, it does not extend the case where an invention is likely to go against public order or morality as a result of improper use of the invention against its original purpose. For example, where an apparatus (Bingo) of the claimed invention is aimed at entertaining, not gambling or other gambling behavior, clearly disclosed in the specification and furthermore, it is considered that the apparatus is likely to be devised for entertainment use, not for wrongdoing, the apparatus would not contravene public order or morality just because the apparatus could be improperly used in wrongdoing.

3.2 Invention likely to injure public health

An invention likely to injure public health is equally treated as an invention to contravene public order or morality aforementioned. The determination of whether an invention harms the public health should be made in the same way that whether the invention contravenes public order and morality is determined.

Where the claimed invention is a manufacturing process invention, an examiner should consider whether the manufacturing process itself and the product made by the manufacturing process would injure public health. Even when research results in academic journals show that a product made by a manufacturing process of the claimed invention would injure public health, if the Ministry of Health and Welfare approves the manufacture of medicines under the Pharmaceutical Affairs Act, it does not necessarily mean that the invention can injure public health based on the research results of the academic journals.

Furthermore, where an invention achieves the original useful purpose but the result of the achievement would injure public health, an examiner shall consider whether a method to eliminate the harmful effect of the claimed invention exists or whether the effect of the invention is advantageous or not.

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Part IV - Amendment of Specification, Claims or Drawing(s)

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Chapter 1. Overview of Amendment

1. Article 47 of the Patent Act

Article 47 of the Patent Act (Amendment of Patent Application) ① An applicant may amend the specification or drawing(s) attached to a written patent application within the period designated in any of the subparagraphs of Article 42(5) or before the examiner issues a certified copy of a decision to grant a patent under Article 66. However, after an applicant received a notification of the grounds for rejection under Article 63(1) (hereinafter "a notice of the grounds for rejection"), the applicant may only amend the specification or drawing(s) within the periods (in the case of subparagraph (iii), at the time of a request for reexamination) designated in the following subparagraphs:

(i) where the applicant initially receives the notice of the grounds for rejection (except notices of the grounds for rejection occurring from an amendment according to a notice of the grounds for rejection) or receives a notice of grounds for rejection other than that of paragraph (ii), the period designated for submitting arguments in response to the notice of the grounds for rejection;

(ii) where the applicant receives a notice of the grounds for rejection occurring from an amendment according to a notice of the grounds for rejection, the period designated for submitting arguments in response to the notice of the grounds for rejection; or

(iii) when the applicant requests a reexamination under Article 67bis.

② An amendment to the specification or drawing(s) under paragraph (1) shall be made within the scope of the matters disclosed in the specification or drawing(s) originally attached to the written patent application.

③ An amendment to the claims under paragraphs (1)(ii) and (iii) can only be made in cases falling under one of the following subparagraphs:

(i) where the scope of claims is narrowed by specifying or deleting the claim, or adding an element to the claim;

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(ii) where a clerical error is corrected; or

(iii) where an ambiguous description is clarified.

(iv) where the amendment is beyond the scope of paragraph (2), to amend the claims so as to revert to the claims before the amendment or to amend the claims in accordance with subparagraphs (i) through (iii) while reverting to the claims before the amendment.

④ Where amendments are made within the period under Article paragraphs (1)(i) or (ii), all amendments before the final amendment in each amendment procedure shall be deemed to have been withdrawn. (Act No.11654, Revised on March 22, 2013).

2. Purport of Amendment

The amendment system of the specification or drawing(s) is designed to address incompleteness of a specification generated while a patent application is hurriedly filed under the first-to-file rule where the first person to file a patent application for the same invention is granted the patent right for the invention, and to draw measures to protect the rights of the applicant.

Where a description is amended during the designated period or under the specified conditions after filing the application, the amendment shall take effect retroactively to the original filing date.

Amendments shall be freely carried out before the start of the examination for the smooth progress of the examination. In the meantime, if an amendment was made after the start of an examination, invalidation of examination results and examination delay would be possible. Therefore, after an official notice of grounds for rejection, the amendment period is strictly limited to prevent a delay in the examination process. Moreover, if an invention not set forth in the original specification or drawing(s) was added through the amendment, the newly-added content would unfairly take effect retroactively to the original filing date. This is against the first-to-file rule and is likely to do an unexpected damage to a third party, and therefore, the scope of amendment is strictly limited.

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3. Amendment Requirements

3.1 Procedural Requirements for Amendment

(1) A person who can amend the specification or drawing(s) shall be the applicant of the patent application at the time of the amendment**.** Where two or more applicants for the same application are present, not all the applicants need to undertake the amendment proceedings but each applicant may amend the description individually.

(2) For the amendment of a specification claims or drawing(s), the patent application, which is the subject of the amendment, shall be pending before KIPO. Therefore, if the application has been invalidated, withdrawn, abandoned, or a decision to reject the application has become final and binding, the amendment shall not be made.

(Note) The case where the application is pending before KIPO refers to the conditions in which KIPO can take necessary administrative actions to grant a patent to the application (which means the registration of establishment of a patent right in accordance with Article 87(2) of the Patent Act). Therefore, if the application has been invalidated, withdrawn, abandoned, registered for establishment of right, or a decision to reject the patent application has become final and binding, the application shall not be deemed to be pending.

3.2 Substantive Requirements of Amendment

(1) The scope of an amendment to the specification or drawing(s) differs depending on the amendment periods. The addition of new matter shall be prohibited when an amendment is carried out within the self-amendment period before the start of an examination or within the period designated for submitting arguments on a non-final notice of grounds for rejection (according to 47①(i) of the Patent Act). However, where an amendment is made within the period designated for submitting arguments on a final notice of grounds for rejection (according to 47①(ii) of the Patent Act) and where an amendment is made upon a request for reexamination, the scope of the amendment shall be further restricted by only allowing the

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reduction of scope of claims, etc. as well as the prohibition of the addition of new matter to the application.

(2) The method to handle an amendment which does not fulfill substantive requirements, too, differs based on the amendment periods. Details are stated in the following table.

<table>
<tr><th rowspan="2">Amendment Period</th><th colspan="2">Scope of Amendment</th><th rowspan="2">Handling of Illegitimate Amendment</th></tr>
<tr><th>Detailed Description of Invention · Drawing</th><th>Scope of Patent Claim</th></tr>
<tr><td>① Before Delivery of Certified Copy of Decision to Grant Patent
② Within Period for Argument Submission in reply to Non-Final Notice of Rejection Ground</td><td colspan="2">Prohibition of Addition of New Matter</td><td>During Examination: Rejection Ground

After Registration: Invalidation Ground</td></tr>
<tr><td>① Within Period for Argument Submission according to Final Notice of Rejection Grounds
② On Request for Reexamination</td><td>Prohibition of Addition of New Matter</td><td>Prohibition of Addition of New Matter
+
Addition of Requirement for Reduction of Claim, etc.</td><td>During Examination: Decision to Decline Amendment

After Registration: Invalidation ground (Except Requirement in Article 47(3))</td></tr>
</table>

4. Amendment Period

4.1 Self-Amendment Period

The self-amendment period refers to the time period before the commissioner of the Korean Intellectual Property Office delivers a certified copy of a decision to grant a patent during the amendment period designated under Article 47(1) of the Patent Act, except for the period under the subparagraphs of Article 47(1) of the Patent Act. In such a case, the

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time at which the commissioner of KIPO delivers a certified copy of a decision to grant a patent is when an examiner sends a certified copy of a decision of patent. Therefore, if an applicant submits an amendment before receiving a copy of a decision of patent which the examiner has sent out, the amendment shall not be recognized.

If the time period designated in a request for consultation or a (preliminary) notice for inadmissible division according to Articles 36 and 38 of the Patent Act is before a certified copy of the decision to grant a patent is transmitted and before a ground for rejection is notified, an applicant shall address grounds for rejection or grounds for inadmissible division under Article 36 of the Patent Act through self-amendment of the specification claims or drawing(s).

(Note) The self-amendment period refers to the time period before an applicant receives a certified copy of a non-final notice of grounds for rejection which an examiner has delivered.

4.2 Period for Argument Submission in reply to Notice of Rejection Grounds

(1) If an applicant receives a non-final notice of grounds for rejection under Article 63 of the Patent Act or a notice of grounds for rejection other than rejection grounds (a final notice of grounds for rejection) under Article 47(1)(ⅱ), the applicant may submit a written amendment to the specification, claims or drawing(s) only within the period designated for the submission of arguments in response to the notification of grounds for rejection concerned.

The period designated for the submission of arguments shall be commonly two months. However, the period shall be extended on a request for the extension of the designated period by the applicant according to Article 15(2) of the Patent Act. Where the period designated for submitting a written argument exceeds four months, the period may or may not be extended based on whether an examiner permits the period extension or not.

The period designated for the submission of arguments under Article 47(1)(ⅰ) is confined to the period defined under Article 63 of the Patent Act. Therefore, the period for a request

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for consultation in Article 36(6) of the Patent Act or the period for a procedural amendment in Article 46 of the Patent Act shall not correspond to the period designated for the submission of arguments.

(2) Even where a notice of grounds for rejection (the final notice of grounds for rejection) under Article 47(1)(ⅱ) of the Patent Act is present, an applicant may amend the specification, claims or drawing(s) only within the period designated for the submission of arguments. However, the scope of the amendment in this period shall be further limited.

4.3 Request for Reexamination

An applicant shall request a reexamination within 30 days from the receipt of a certified copy of a decision of rejection and amend the specification, claims or drawing(s) attached to the application upon a request for reexamination.

The period designated for an appeal against a decision of rejection can be extended if the requirements specified under Article 15(1) of the Patent Act are fulfilled. Therefore, an applicant shall amend the description, upon a request for reexamination, within the extended period for an appeal against a decision of rejection.

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Chapter 2. Scope of Amendment

1. Amendment in reply to Self-amendment and Non-final Notice of Rejection Ground

Article 47(2) of the Patent Act dictates that an amendment to the specification, claims or drawing(s) "shall be made within the scope of matters written in the specification or drawing(s) attached to the patent application." Therefore, the addition of new matter even in the amendment under the main sentence of Article 47(1) and Article 47(1)(i) shall be prohibited. An amendment to the specification, claims or drawing(s) within the designated period has no limit to the scope of an amendment except for the prohibition of the addition of new matter.

1.1 Prohibition of Addition of New Matter

(1) 'New matter' refers to an element which is out of the scope of the specification or drawing(s) attached to the patent application. In this context, matters in the specification or drawing(s) attached to the application (hereinafter referred to as 'the original specification') mean the elements which are explicitly described in the specification or drawing(s), or which without any explicit description, a person skilled in the art would understand that are the same as the matters described in the specification or drawing(s) based on technical information at the time of filing the application.

In other words, even if elements described in the specification or drawing(s) are not expressly described, but if a person skilled in the art clearly understands through his/her assessment on the elements in the original application, claims or drawing(s) that the matters are written, such elements shall not be new matter.

(Note) The previously-used term 'change of subject matter' has been deleted and an amendment to the detailed description of the invention, or drawing(s) as well as the scope of an amendment have become restricted due to the revision of the Patent Act (carried out on July 1, 2001). Therefore, the introduction of a new concept, which

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is different from that of change of subject matter, has become necessary. To this end, a term 'new matter' has been adopted to clarify the meaning of new natter, other than the matter「within the scope」.

(2) The subject of assessment in addition of new matter shall be the amended specification, claims or drawing(s). The addition of new matter to any of the specification, claims or drawing(s) shall not be accepted.

(3) The specification, claims or drawing(s) originally attached to the patent application shall be the subject of comparison of whether new matter is added to the amended specification, claims or drawing(s). In this context, the phrase 'originally attached to the patent application' refers to the submission of the specification, claims or drawing(s) along with the patent application by the filing date of the application. The matter added to the specification, claims or drawing(s) through an amendment after the filing date of the application shall not be the elements described in the specification, claims or drawing(s) originally attached to the application.

Meanwhile, in the case of international patent applications, 'matters described in the specification, claims or drawing(s) originally attached to the application' shall be 'matters described in the description of the international patent application submitted on the international filing date, the translated version of claims or drawing(s) (only referring to the description in the drawing(s)), or the drawing(s) of the international patent application submitted on the international filing date (excluding the description in the drawing(s)).

(Note) In the case of international patent applications, a substantive examination shall be carried out based on the translated version of the application in accordance with the purport of Article 201(4), (6) of the Patent Act. Therefore, an examiner shall assess whether or not new matter is added, based on matters described in the translation (including drawing(s) of the international application).

In the case of divisional/converted applications, 'matter described in the specification, claims or drawing(s) originally attached to the patent application' refers to the element described in the specification, claims or drawing(s) attached to the divisional/converted

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applications on the filing date of the divisional/converted applications. It does not refer to matter described in the specification, claims or drawing(s) in the original application which form the basis of divisional/converted applications.

(4) Whether new matter is added to the amended specification, claims or drawing(s) shall be determined by whether elements described in the amended specification, claims or drawing(s) (the subject of assessment) are in the scope of the elements described in the specification or drawing(s) (the subject of comparison).

In this context, the phrase of being in the scope of the elements described in the specification or drawing(s) does not mean being completely and externally the same within the scope of matters described in the specification, claims or drawing(s) originally attached to the patent application. Also, matters that a person skilled in the art clearly understands based on matters described in the specification, claims or drawing(s) originally attached to the patent application shall be deemed as being in the scope of matters described in the specification or drawing(s) .

1.2 Detailed Assessment Method of Prohibition of Addition of New Matter

(1) Since an application in the country where the application was initially filed, which forms the basis of the priority claim, or a prior application shall not correspond to the specification, claims or drawing(s) originally attached to the patent application, such applications shall not be used as the basis of assessment in addition of new matter.

(2) Since an abstract shall not correspond to a specification or drawing(s), an abstract shall not be included in the specification or drawing(s) which forms the basis of assessment in addition of new matter.

(3) In the case of completing an incomplete invention, the amendment shall be deemed to contain new matter.

(4) In the case of correcting a clerical error or clarifying an ambiguous description, the amendment acknowledged being within the scope of matters described in the specification

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or drawing(s) shall not be deemed as addition of new matter.

(5) Where a person skilled in the art clearly understands which of more than two contrasting elements is right based on matters described in the specification or drawing(s), the amendment of writing the correct matters shall not be deemed as addition of new matter.

(6) Where a person skilled in the art clearly understands that the detailed description of the invention has been amended based on matters described in the drawing(s) or the claims, the amendment shall not be deemed as addition of new matter.

(7) An amendment to a so-called 'disclaimer claim' is not mostly deemed as addition of new matter. For example, where it is not specified whether the claimed invention regarding medical methods for humans or for animals, if the invention is obviously not limited only for particular animals, the amendment of deleting the parts related to humans shall not be deemed as addition of new matter.

(Example) Where 'treatment methods for mammals' are amended into 'treatment methods for mammals except for humans' or 'treatment methods for livestock'

(8) If amended matters are not clearly understood based on the matters described in the specification or drawing(s), the amendment shall be deemed as addition of new matter. Such amendments are as follows: amendment of changing the scope of numerical limitation, amendment of changing features of an invention into a generic concept or subordinate concept, amendment of changing drawing(s), amendment of adding embodiments, or amendment of adding or changing purposes or effects of an invention.

(9) Just adding the titles of prior art documents to a description shall not be deemed as addition of new matter.

However, an amendment based on the matters described in the prior art documents, or an amendment of adding matters which were originally referred to, but were only described in the prior art documents other than the original specification shall be deemed as addition of new matter when such added matters cannot be clearly understood to a person skilled in

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the art based on the specification, claims or drawing(s) originally attached to the patent application.

(10) Though the added matters through amendment are well-known prior arts, if a person skilled in the art does not clearly understand that the added matters are the same as the matters described in the specification or drawing(s) , the amendment of adding such well-known prior arts shall be deemed as addition of new matter out of the scope of the matters described in the specification or drawing(s) .

2. Amendment in reply to Final Notice of Rejection Ground or on Reexamination Request

An amendment in reply to the final notice of grounds for rejection or carried out upon a request for reexamination shall additionally satisfy Article 47(3), along with Article 47(2) of the Patent Act.

The previous section shall be referred to concerning the prohibition of addition of new matter under Article 47(2) of the Patent Act.

2.1 Restriction of Amending Scope of Claim

An amendment to claims among the amendments in response to the final notice of grounds for rejection or upon a request for reexamination in accordance with Article 47(3) of the Patent Act shall be one of the followings: reduction of scope of claims by limiting claims, correction of clerical errors, clarification of ambiguous descriptions, or deletion of new matter.

Amendment requirements under Article 47(3) of the Patent Act shall be applied only to the amended claims. In this case, if an independent clause is amended, the dependent clause which refers to the independent clause shall be deemed to be amended.

Moreover, to which of the abovementioned cases an amendment of amending claims corresponds shall be determined by comparing the claim which is the subject of an

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examination upon the final notice of grounds for rejection with the claim with the same number. However, if a claim after an amendment is clearly understood to be the same as the amended claim with the different number, the validity of the amendment shall be assessed through comparison with the claim of the different number.

Regardless of whether an applicant amends one word or the whole claim, if an amendment of the claim falls under any of the subparagraphs of Article 47(3), the amendment shall be deemed as an amendment under Article 47(3) of the Patent Act. However, even in the aforementioned case, if one claim contains more than two inventions (a Markush-type claim or a claim citing multiple claims), such inventions shall be assessed individually.

(Note) Such processes exist because of ① the possibility of violation in fairness between an amendment of the overall claims (where the inventions described in the claims are re-described) and an amendment of the claims on a section-by-section basis, if matters described in one claim are assessed by words before and after an amendment or on a section-by-section1 basis. Also, ② Article 47(3) of the Patent Act is not intended to substantially restrict the contents of an amendment, but to prevent difficulties of an examination caused by excessive amendments.

2.2 Restriction of Claims by Limiting or Deleting Claims or Adding Element to Claims

Cases of restriction of claims under Article 47(3) of the Patent Act shall be limited to restriction of claims, deletion of claims and addition of technical information to claims. Such cases are as follows.

(1) Restriction of claims is to limit the scope of the inventions described in the claims and such a case includes reduction of numerical scope, change from generic concepts to subordinate concepts and so on.

① Reduction of Numerical Scope

It refers to the case where the scope of numerical limitation is reduced within the scope initially described in a claim. However, if reduction of the numerical scope and extension of

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one end of the scope are conducted simultaneously, for example, the initially-mentioned numerical scope of temperatures of 10~20℃ is changed into 15~30℃, it shall not be deemed as reduction of numerical scope.

② Change From Generic Concept To Subordinate Concept

It refers to the case where the generic concept covering matters of the same class or type is changed into one of the subordinate concepts of the generic concept, such as amending writing instruments to fountain pens.

③ Deletion of Features Selectively Stated

Where multiple features are selectively described, an amendment of deleting parts of the features constitutes the restriction of claims, recognized as a legitimate amendment. Examples of the case include deleting A or B from the features of selective description「A or B」.

④ Reduction of Cited Claim from Claims which refers to Multiple Claims

Deletion of parts of the cited claims from claims which refers to other multiple claims shall be deemed as an amendment of limiting and restricting claims, just like the deletion of selective features.

(2) Deletion of a claim shall be recognized as a legitimate amendment since it constitutes restriction of claims

In the meantime, an amendment of changing the citation number of other claims which refer to the deleted claim or an amendment of adding the cited contents shall be deemed as an amendment of correcting an incorrect description.

(3) It refers to the case where the scope of an invention is reduced by adding new technical features described in the detailed description or claims side-by-side. Examples of the case include changing the description of 'a bottle opener with B attached to A' to 'a bottle

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opener with B attached to A and then C attached to B'.

(4) The following cases shall be deemed as amendments not falling under Article 47(3)(i) of the Patent Act.

① Where a claim is newly-established or an invention is added to claims by adding selectively-described features or adding a cited claim

However, even in the case of the new establishment of a claim, if addition of a described feature or a cited claim that happens while organizing claims is inevitable and such a case is clearly expressed in a written statement of arguments, it shall be exempted.

(e.g.) [Before Amendment]

Claim 1: The apparatus comprising Feature A and B

Claim 2: The apparatus with Feature C attached, as claimed in Claim 1

Claim 3: The apparatus with Feature D and E attached, as claimed in Claim 1 or 2

[After Amendment]

Claim 1: Deleted

Claim 2 (Amended): The apparatus comprising Feature A, B and C

Claim 3 (Amended): The apparatus comprising Feature A, B, D and E

Claim 4 (Newly-added): The apparatus comprising Feature A, B, C, D and E

※Whether unity in each claim in the abovementioned example is maintained is out of the discussion.

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② Where a claim is out of the original scope due to the following amendments

- Change of description from subordinate concept to generic concept

e.g.) initially: ...supported by a spring...→ ...supported by an elastic body...

-Deletion of features from a set of features

e.g.) initially: A car comprising A, B, C and D→A car comprising A, B and C

-Adjustment of features in a set of features

e.g.) initially: The apparatus comprising A, B and C
→ The apparatus comprising B, C, D and E

-Extension of numerical scope

e.g.) initially: at temperatures of 10~50°C→ at temperatures of 10~70°C

-Replacement of feature

e.g.) initially: joined with a bolt..→ joined with a rivet..

-Change of numerical scope

e.g.) initially: at temperatures of10~20°C→ at temperatures of 30~50°C

2.3 Correction of Incorrect Description

Correcting an incorrect description refers to the case where a description before an amendment and a description after an amendment are objectively deemed to be the same. Examples of such case include that incorrect description of claims is explicitly recognized based on matters in the description or that an incorrect description is correctly amended if

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the incorrectness is explicit based on the abovementioned features or empirical rules.

2.4 Clarification of Ambiguous Description

An ambiguous description refers to the description whose meaning in the context is not clear. Examples of such cases include where a description of a claim itself has an unclear literal meaning, where the described contents of a claim itself is unfair in relationship with other descriptions, or where an invention described in a claim is not technically specified and ambiguous even though a description of a claim itself is clear.

An amendment of re-describing the overall claim without any substantial changes shall be deemed as an amendment falling under Article 47(3)(iii) of the Patent Act since it is considered to clarify an ambiguous description, unless any other specific conditions are present.

2.5 Amendment of Deleting New Matter

Where matters are newly-added on a particular stage of an amendment, an amendment of reverting to the contents of the claim before addition of new matter shall be accepted. If such cases were not accepted, an amendment of deleting new matter in order to address grounds for rejection would be declined since it is a violation of Article 47(3) of the Patent Law. Then, it would lead to the grant of a decision of rejection, which is too harsh for an applicant.

An amendment of reverting to the content of a claim before addition of new matter as well as an amendment of amending claims according to Article 47(3)(i) to (iii) while reverting to the content of a claim before addition of new matter shall be accepted. An examiner shall assess the legitimacy of an amendment by comparing claims before addition of new matter with amended claims.

Examples of detailed examination methods are as follows.

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Type		Amendment Content/ Examination Direction
Example		[Before Examination] Claim 1 : The apparatus comprising A+B Claim 2 : The apparatus comprising A+B+C [Non-Final Notification of Grounds for Rejection] Claim 1 has no inventive step due to the cited invention. [Description after Final Amendment] Claim 1 : The apparatus comprising A+B+D (D is new matter. It has an inventive step.) Claim 2 : The apparatus comprising A+B+C [Final Notification of the Grounds for Rejection] D in Claim 1 is new matter.
Example1	Amendment	[Description after Final Amendment] Claim 1 : The apparatus comprising A+B Claim 2 : The apparatus comprising A+B+C
	Assessment	[Admission of Amendment]Amendment is accepted since it has been reverted to the claims just before new matter is added. [Decision of Rejection] A decision of rejection is granted since Claim 1 has no inventive step.
Example2	Amendment	[Description after Final Amendment] Claim 1 : The apparatus comprising A+b (b is the subordinate concept of B. It has an inventive step.) Claim 2 : The apparatus comprising A+B+C
	Assessment	[Admission of Amendment] Amendment is accepted since Claim 1 falls under the case where the claim is deleted while reverting to the claims just before new matter is added. [Decision of Patent] A decision of patent is granted since no grounds for rejection are found in Claim 1 and 2.
Example3	Amendment	[Description after Final Amendment] Claim 1 : Deleted

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		Claim 2 : The apparatus comprising A+B+C
	Assessment	[Admission of Amendment]Amendment is accepted since Claim 1 falls under the case where the claim is deleted while reverting to the claims just before new matter is added. [Decision of Patent]A decision of rejection is granted since no grounds for rejection are found in Claim 2.
Example4	Amendment	[Description after Final Amendment] Claim 1 : The apparatus comprising A+B+E (A+B+E is the invention within the scope of the original specification. It has an inventive step.) Claim 2 : The apparatus comprising A+B+C
	Assessment	[Admission of Amendment]Amendment is accepted since Claim 1 falls under the case where the claims are reduced by adding E to the claims while reverting to the claims just before new matter is added. [Decision of Patent]A decision of patent is granted since no grounds for rejection are found in Claim 1 and 2.

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Chapter 3. Rejection of Amendment

1. Articles 51 and 63 of the Patent Act

Article 51 of the Patent Act (Rejection of an Amendment) ① Where an amendment under Article 47(1)(ii) or (iii) violates paragraphs (2) or (3) of Article 47 or an examiner considers that the amendment has caused a new ground for rejection (except an amendment to delete a claim among amendments under 47(3)(i) or (iv)), the examiner must reject the amendment by decision. However, where there is a request for reexamination under Article 67*bis*, this paragraph does not apply when the amendment is made before the request.

② A decision to reject an amendment under paragraph (1) must be in writing and must state the reasons for the decision.

③ An appeal may not be made against a decision to reject under paragraph (1), except, in an appeal against a final rejection of patent under Article 132*ter*, when the final rejection is the issue of the appeal (except, when a request for reexamination under Article 67*bis* is made, a final rejection made before the request).

Article 63 of the Patent Act (Notification of Reasons for Refusal) ① An examiner who refuses a patent application under Article 62 shall notify the applicant of the reasons and give the applicant an opportunity to submit a written statement of arguments within a designated period. However, this provision does not apply if the examiner intends to make a decision of rejection under Article 51(1).

② (Omitted)

2. Requirements of Amendment Rejection

(1) If an amendment in the period for submitting a written statement of arguments in reply to the final notice of grounds for rejection or an amendment upon a request for

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reexamination is in violation of Article 47(2) and (3) of the Patent Act or if it is recognized that a new rejection ground is raised due to the amendment, the amendment shall be rejected in accordance with Article 51(1).

In this context, "the case where a new ground for rejection is raised due to the amendment" means where a ground for rejection which did not exist before is newly-created due to the submission of the amendment (where deficiencies in description are raised due to the amendment or where rejection grounds of novelty and inventive step are newly found and so on). Rejection grounds that were in the description before the amendment but were not notified as well as grounds for rejection which were notified before the concerned amendment shall not be deemed as new grounds for rejection.

Examples in Part V Chapter 3 「11.2 Examination of Amendment」 shall be referred to regarding assessment when a new ground for rejection is raised due to the amendment.

(2) In the case of an amendment carried out upon a request for reexamination, if the amendment before the request is overlooked in an examination proceedings in spite of being the subject of the dismissal, the concerned amendment shall be exempt from the assessment of whether the amendment due to the reexamination request is rejected or not.

(3) In assessing whether a new ground of rejection is raised due to amendment or not, the case where a new ground of rejection is raised due to deletion of a claim according to Article 47 (3)(i) or (iv) shall be exempt.

In this context, "where a new ground of rejection is raised due to deletion of a claim" only refers to where deficiencies in a description are created by deleting a claim, but not amending the subordinate claim that refers to the claim. Exemptions of such cases include where the deleted claim is still referred to even after an amendment of the subordinate claim, where a new ground for rejection is raised, regardless of the direct relevance with the deletion of a claim, while organizing the claims after the deletion of a claim and so on.

3. Examination Method of Requirements of Amendment Dismissal

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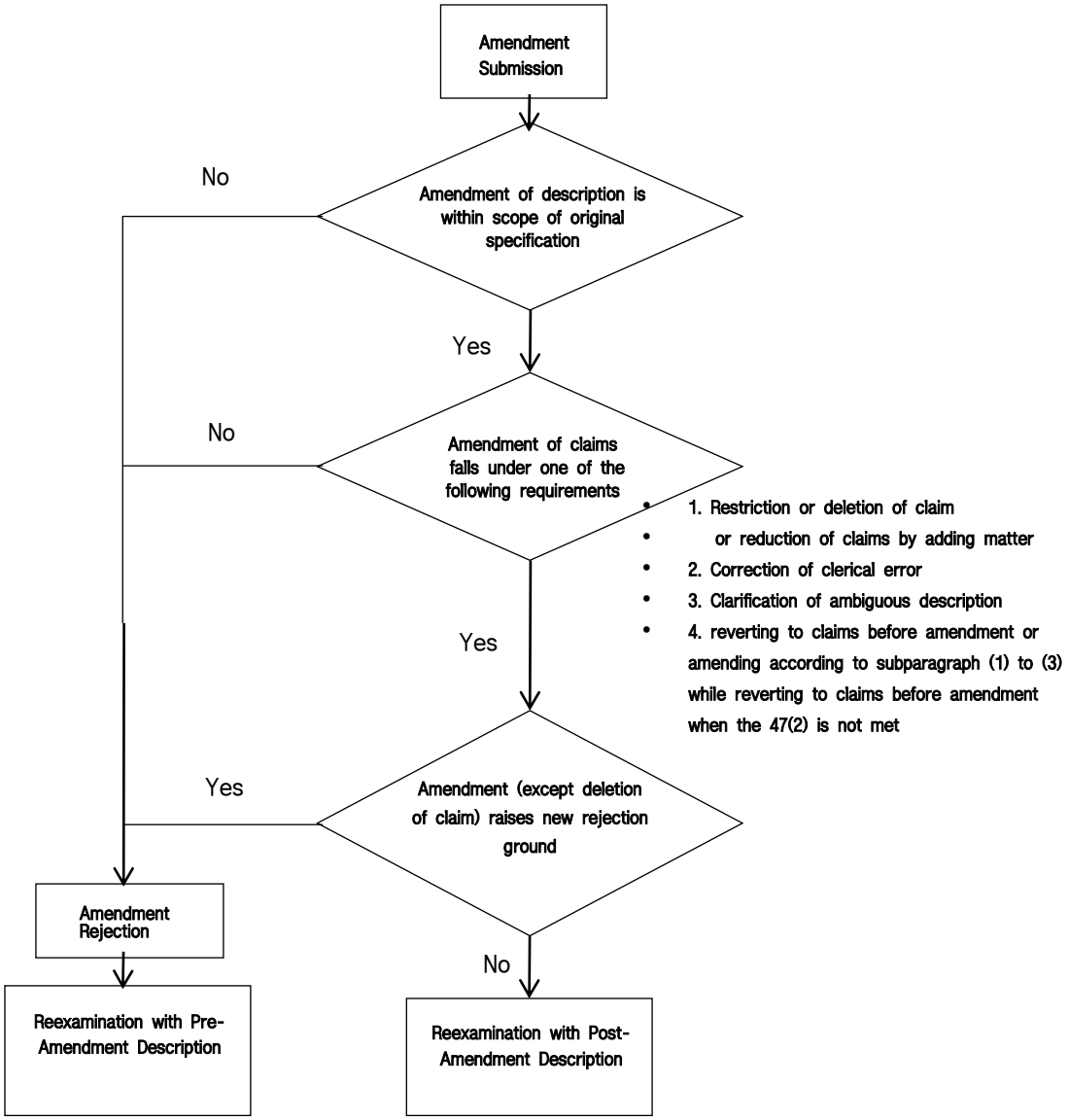
(1) Whether an amendment carried out after the final notice of grounds for rejection or an amendment upon a reexamination request meets the requirements shall be assessed regardless of an order of amendment requirements. If multiple requirements are not satisfied, an examiner shall point out as many unsatisfied requirements as possible and reject the concerned amendment.

(2) Whether an amendment fulfills substantive requirements shall be assessed according to the following proceedings.



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(3) Since methods of an appeal regarding a decision to decline an amendment are not readily arranged, a decision to grant or reject a patent or a notice of rejection grounds shall be made after re-examining the description before the amendment, along with dismissal of an amendment.

4. Cautions for Making a Decision of Amendment Rejection

(1) Where a written amendment containing multiple amended features is submitted, the overall amended features shall be assessed with a single, inseparable amendment to determine whether the concerned amendment is recognized or not. Therefore, if any of the amended features is in violation of Article 47(2) and (3) of the Patent Act or the amendment (except an amendment of deleting claims) raises a new ground for rejection, the overall amendments in the written amendment shall be rejected.

In this context, the written amendment which serves as the subject of rejection refers to the statement classified by the submission of Form(ix) in the Enforcement Rules of the Patent Act.

(2) Where multiple amendment documents are submitted in the designated period for submission of written arguments prescribed in the final notice of grounds for rejection, Refusal of amendments shall be determined based on the overall amendments of each written amendment irrespective of whether the statements are submitted on the same date. Normally, a form in which amended features are written by 'Identification subject matter' or 'Identification number' (matters to be amended) is attached to each written amendment. Therefore, matters to be amended in the concerned written amendments shall be determined by combining the written amendment submitted before with the final amendments by matters to be amended. Detailed methods of determining matters to be amended by each written amendment shall be referred to「Part V, Chapter 3. Section 6.3 Treatment of Amendments」.

(3) Where a decision of rejection has been revoked according to Article 176(1) and (2) and the application has been returned to an examination bureau, the examiner shall accept the reason which forms the basis of revocation of a ruling based on Paragraph (3) of the same

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article(the requirements which form the premise of the decision, along with the formal adjudication of the ruling shall be recognized and assessed) in the examination of the returned patent application.

Only a decision to reject a patent or a decision to decline an amendment is revoked in the application which has been revoked and returned to the examiner. The examination proceedings undertaken before the revocation decision and the proceedings that the examiner has taken shall be all effective. Therefore, the application revoked and returned to the examiner shall be examined as normally as any other applications in ordinary examination proceedings.

(4) Where an amendment submitted in reply to the final notice of grounds for rejection is declined, but then the decision to decline an amendment is revoked in a ruling, or where, as grounds for rejection which have not been mentioned in the decision to decline an amendment, an examiner finds reasons not examined or assessed in the proceedings of an appeal against a decision of rejection, the examiner is meant to decline the amendment by citing the aforementioned grounds. However, regarding the illegitimate amendment carried out before a request for an appeal against a decision of rejection under Article 170 of the Patent Act, the examiner shall not decline the amendment, but examine the amendment considering the purpose of prohibiting a decision to decline an amendment in the examination proceedings and the possibilities of giving an unexpected damage to an applicant if an examiner declined the amendment by citing the grounds overlooked before.

In the meantime, where the patent application filed before June 30, 2009 and undergone the proceedings for reconsideration by an examiner before a trial is revoked and returned, an amendment made thirty days before the filing date of an appeal against a decision of rejection shall not be declined on the examination stage since Article 51 of the Patent Act only applies an amendment under Article 47(1)(ii). Therefore, even where a new ground to decline an amendment is found, an examiner shall not decline an amendment again.

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Part V. Examination Procedure

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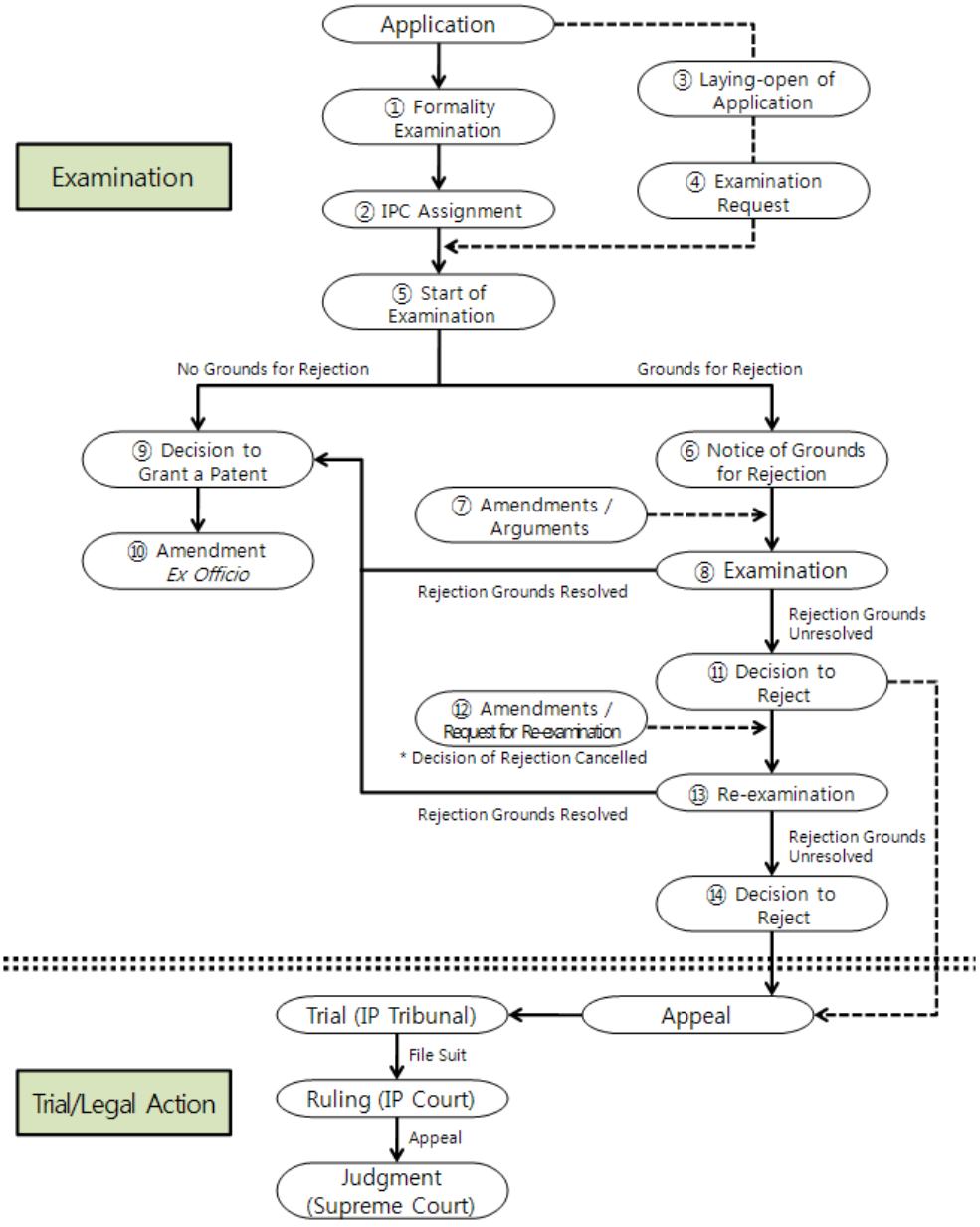
Chapter 1. General Examination Procedure

1. Overview

1.1 Flow Chart



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1.2 Examination Procedure in General

This part briefly sets out the general procedure for examination as referred to the aforementioned flow chart 1.1. Detailed explanation on each stage will be dealt with in the following Part 2~ Part 6.

(1) Examination of Formal Requirements

The examination of formal requirements is a process to check as to whether an application meets the formal requirements. The followings relates to the requirements: capacity, representation, physical requirements of the application, filing and fees, matters according to each subparagraph of Article 11 (1) of the Enforcement Rules of the Patent Act.

A preliminary check is in principle carried out in the name of the Commissioner of KIPO by the receiving office where application documents are initially filed. When the receiving office fails to conduct the examination of formal requirements, an examiner can carry out further checks in the name of the Commissioner of KIPO.

(2) Assignment of International Patent Classification (IPC)

The classification of a patent application is performed with taking into consideration the invention as claimed. It is necessary as an effective search tool for the retrieval of patent documents by intellectual property offices and other users. Currently, KIPO adopts the IPC, a hierarchical patent classification under the control of the World Intellectual Property Organization (WIPO) as its classification.

(3) Laying-open of Application

The application shall be laid open in the Patent Gazette as soon as after the expiry of a period of eighteen months from the date of filing, where priority if claimed, from the earliest priority date. The application may, however, be published before the date if requested by the applicant. Some applications treated "confidential" may be excluded from publication.

(4) Request for Examination

An application is examined only when a request for examination is filed. Any person can

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request for examination within 5 years for a patent application (or 3 years for a registered utility model application filed after 10.01, 2006) from the filing date.

(5) Start of Examination

The examination is to be carried out by an order of request for examination. The purpose of examination is to ensure that the application and the invention to which it relates meet the requirements set out in the relevant Articles of the Patent Act (Article 46 or 62). The prime task of the examiner is to deal with the substantive requirement, and if he believes formalities are in correct or incomplete, he may invite an applicant to correct such formal deficiencies.

(6) Notice of Grounds for Rejection

The examiner shall write to the applicant giving reasons for any objections he raises under any subparagraphs of Article 62, and invite the applicant within a specified period to submit arguments before final decision to reject.

(7) Amendments/Arguments

An applicant may submit arguments in response to an examiner's notice of grounds for a rejection and may file amendments to the specification (including detailed description and claims) or drawing(s) within the period designated in Article 47.

(8) Examination

Taking account of any amendments proposed, or arguments made, by the applicant in reply to the notice of grounds for rejection, the examiner should examine the application again.

(9) Grant of a Patent

Where an examiner finds no grounds to reject a patent application, he decides that a Korean patent be granted.

(10) Amendment *Ex Officio*

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When making a decision to grant a patent, an examiner may amend *ex officio* the matters in the specification, drawing(s), or abstract attached to a patent application notice that is clearly erroneous. The examiner shall notify the applicant of the matters to be amended *ex officio* along with the delivery of a certified copy of the decision to grant a patent. The applicant can decide whether they accept the amendment *ex officio* by the time for paying patent fees.

(11) Decision to Refusal

When an examiner examines the application again with taking account of any amendments or arguments in reply to the notice of grounds for rejection and considers that the applicant has not overcome his objections, the examiner may decide to refuse the application.

(12) Amendment/Request for Reexamination

An applicant may amend a specification or drawing(s) to request for reexamination within 30 days from the receipt of a certified copy of the decision to reject a patent (or the extension period if the statutory period is extended). However, the reexamination request is not allowed where there is a decision of rejection after reexamination or where there is a request for a trial against the decision for rejection. Where there is a request for reexamination, the decision to reject the patent application prior to the request is deemed to have been cancelled.

(13) Reexamination

Where a request for reexamination is made, the decision to reject the patent application prior to the request is deemed to have been cancelled. The examiner shall then take into consideration any amendment provided by the applicant and re-examine the application according to the general examination procedure.

(14) Decision to Refusal after Reexamination

Where an examiner considers the amendment made at the reexamination stage, and still finds the stated grounds for rejection not overcome, the examiner shall decide to reject the

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patent application.

2. Designation of Examiner

The Commissioner of KIPO shall designate a qualified examiner to examine patent applications.

2.1 Qualifications

A person eligible to become a patent examiner shall be the following public officials in KIPO or its affiliated agencies who have completed the prescribed education and training course for a trial examiner conducted by International Intellectual Property Training Institute (IIPTI); A public official of Grade V or higher in general service, a public official in general service who belongs to the Senior Civil Service, or a specialized contract-based public official.

2.2 Duties

(1) Under the direction and the supervision of a director general of a bureau, a head of a division (or a team head), or a head of the examination unit, an examiner shall proceed the examination with speed and accuracy in accordance with the Patent Act and its related provisions. An examiner shall examine independently based on the legal and technical knowledge, provided however that opinions of a director general of a bureau, a head of a division (a team head), or a head of the examination unit be taken into consideration.

(2) For a proper examination, a newly appointed examiner, not more than 6 months in the job from the date of appointment, shall participate in the examination as an assistant examiner. After the assistant examiner period, the examiner shall service the examination jointly with other experienced examiner for additional 6 months. The period for assistant or joint examination can be shortened if certain requirements are satisfied.

(3) If an application for invention relates to convergence technologies mixed with several different technical aspects involved, the examiner in charge, referred to as the "primary examiner" may consult with other examiners in charge of relevant sub-technical classification.

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If the examiners intend to examine with consultation, the primary examiner shall notify the applicant of this fact, together with names of the consulting examiners and reason why the consultation is necessary. Documents related to the examination with consultation shall be made under the joint name of the examiners concerned while the reporting shall be mainly made by the primary examiner.

The examiner may also consult with other examiners who have an expertise of certain foreign languages such as French, Chinese, Japanese, Spanish, etc. for better understanding of prior art documents written in such languages.

(4) If a director general of a bureau acknowledges a need for consulting advice where the application confronts with difficulties in a unified rule application and judgment in examination, the director general may convene a joint conference consisted of more than 3 examiners for their opinions.

(5) According to a duty of confidentiality regarding the information acquired in his official capacity (Article 60 of the State Public Officials Act), the examiner shall carry out their examination duties (including interviews, teleconsulting, etc.) with caution. Also, the documents related to a patent application and an examination shall not be carried out except for the purpose of prior art searches, digitization, or on-line remote performance. A response shall not be given to a request for an expert opinion, testimony or an inquiry on the contents of a patent application, examination, trial, or retrial on pending, nor on the contents of a decision of a patentability, trial decision or ruling.

2.3 Designation and Change of Examiner

(1) One or more examiner shall be designated for each IPC and be in charge of the designated examination. One among which shall be designated as a primary examiner. The Patent Examination Support Division has responsibility for appointing primary examiner for each IPC at the request of the director general of the Examination Bureau.

(2) Where the examiner transfers to another division within the same or different Examination Bureau after the issuance of the first notification regarding the application examination, the examiner in charge shall continue the examination of the concerned

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application up to the point of his or her final decision.

(3) An application either requested for reexamination or returned to the examiner after the revocation of an examiner's original decision of refusal shall be examined by the very examiner unless there is a justifiable reason for change of examiner in charge.

(4) Except as deemed necessary for the purpose of expertise and efficiency, an examiner shall not be in charge of the same IPC for 5 consecutive years.

(5) An examiner who falls under the subparagraphs (i)-(v), or (vii) of Article 148 of the Patent Act, or an examiner with less than 2 years' experience who is assigned for the application from his/her former employment of the previous 3 year or more right before the appointment as an examiner shall be excluded from the concerned examination. An examiner who falls under the aforementioned reasons may avoid the relevant examination with the permit from a director general of examination bureau.

(6) Notwithstanding the case where an examiner is assigned for a certain application, the designation may change if there is a special reason. For example, in case of a double patent application, the examiner of the original application can be designated as an examiner in charge (Article 15 of Instruction).

2.4 Internal Reporting

(1) When an examiner issues a notification of the grounds for rejection or a decision to grant a patent (registered utility model decision included) for the application returned to the examiner after the revocation by trial against his/her original decision to reject, or if an examiner revokes his/her earlier official actions, the examiner shall report to a general director of an examination bureau following the head of the examination unit.

(2) An examiner shall report to a head of examination team or division following a head of the examination unit for the followings; a decision to reject a patent (including a decision to reject a registered utility model, but not including the case where the rejection is made due to no submissions of argument/amendment), a ruling to dismiss an amendment, an invalidation measure (excluding the case without submissions of amendment following amendment order), a notice of the grounds for rejection or a decision to grant a patent for

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the application on reexamination request (including a decision for utility model registration), a ruling of dismissal for accelerated examination request, a request for correction regarding serious deficiencies, a request for amendment, a notice for rejection grounds, or a decision to grant the registration of extension or to reject the extension registration regarding the registration of extension of the term of a patent right.

(3) Where an examiner takes measures other than the aforementioned, an examiner shall report to a head of the examination unit, provided however that depending on an examiner grade (classified into examiner, junior examiner, senior examiner and chief examiner), reporting to a head of the examination unit may be exempted under the following cases.

① Where a junior patent examiner calls for supplementation regarding the accelerated examination request or notifies of the decision for the accelerated examination (only if a requester of an accelerated examination is not an applicant)

② Where a senior patent examiner notifies of rejection grounds, calls for supplementation regarding the accelerated examination request, notifies the decision for the accelerated examination (only if a requester of an accelerated examination is not an applicant), or orders the applicants to report on the results of the consultation where two or more applications claiming identical inventions are filed on the same date.

③ Where a chief patent examiner reports to a head of the examination unit except for the final decision to reject a patent application (including a utility model registration rejection decision)(However, excluding the rejection due to no submission of argument or amendment), a ruling to dismiss an amendment, an invalidation measure, or decision to extend or reject an application to register an extension of the term of a patent right.

(Note) Grade of examiner is decided by the advancement deliberation committee at KIPO. Experience in patent examination (more than 10 years of examination experience for chief examiner, more than 7 years for senior examiner and more than 4 years for junior examiner) and required training program for each level(more than 1 compulsory training, more than 1 selective training) shall be fulfilled.

2.5 Form and Name of Authority for Examination-related Documents

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(1) If KIPO determines a due form for a certain documents to be submitted, it is the principle to use the due form. If there is no designation of a due form, a general document form should be used in accordance with Instruction on Office Management.

(2) If there is a document attached, the attached documents shall be listed at the end of the document body.

(3) Patent examination shall be conducted in the name of the examiner in charge except for a request for an amendment pursuant to Article 46 of the Patent Act, invalidation measures of Article 16, issues of returns in Article 11 of the Enforcement Rules of the Patent Act, and matters concerning an accelerated examination. Joint examination or examination with consultation shall be carried out under joint names of all examiners concerned.

3. IPC Assignment

The IPC assignment has to be made in an accurate manner based on the scope of the invention of each application since it is necessary as an effective search tool for the retrieval of patent documents by intellectual property offices and other users.

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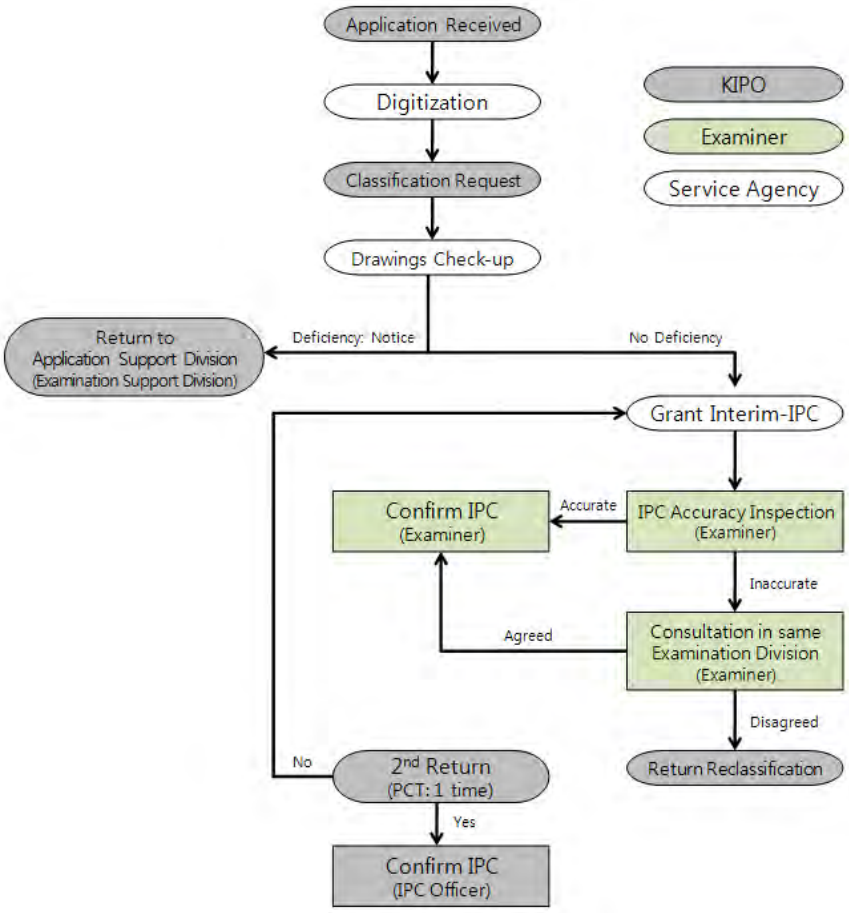
3.1 Flowchart of the IPC Assignment



3.2 General Principles of the IPC Assignment

(1) The technical subject-matter stated in the claimed invention of an application (hereinafter referred to as 'technical subject-matter') are classified into the IPC symbols comprised of section, class, sub-class, main group and sub-group(not required if there is no pertinent further classification criteria after main group). The classification shall be made on the basis of the scope of the claimed invention. However, when the scope of the invention is not clear, the classification has to be based on what is understood from the detailed description. In addition, some technical subject-matter not in the claims but only included in the detailed description can be an additional basis for the classification.

(2) Where multiple technical subject-matters are involved in application, core technical subject-matter representing the claimed invention as a whole is categorized as 'main

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classification', while other remaining technical subject-matters are categorized as 'sub-classification'. However, where there is difficulty in separating the core technical subject-matter from the other multiple technical subject-matters, claim 1, the first claim can be referred as a basis for classification.

(3) The classification shall be determined based on the essential contents of the claimed invention as a whole without considering into consideration the category of invention.

(Ex1) In case of electronic radio circuit comprising a tuner, a demodulator, an amplifier, and an output circuit, these four parts of the circuit are not individually classified. Rather, the classification is determined based on the whole electronic radio circuit comprising the abovementioned four parts. Yet, if the core technical subject-matter of the claimed invention concerns one specific part of the circuit, such part can serves as a basis for the classification.

3.3 General Rule of the IPC Assignment

(1) The IPC has two kinds of classification places: "function-oriented" place and "application" place. To classify the claimed invention pursuant to the IPC, the judgment shall be made first for the classification places depending on the technical subject-matter of the claimed invention.

① In case of Application Invention

If the claimed invention concerns single use and has an appropriate classification place for the application in the IPC, such classification place becomes the classification basis. In the meanwhile, where the IPC has no such relevant classification place for the application (use), then the function-oriented classification place becomes a main classification for the invention while the similar place for the pertinent application (use) becomes a sub-classification.

If the claimed invention concerns multiple uses, it is the principle that the relevant function becomes the classification place. However, if the multiple uses are mentioned only for describing the extension of the main use, the classification place of the main use becomes main classification in the IPC, while the other uses become sub-classification.

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② In case of Function-oriented Invention

Things "per se" characterized by their intrinsic nature or function independent of its field of use are considered as pure function-oriented invention. The function-oriented invention shall be classified based on the pertinent function place. However, if the IPC has no pertinent place for the function, the main use prescribed in the description shall be a classification place. In this case, it is advisable to state the place of main use as sub-classification.

(Ex 1) Sub-class F16K is classified with its function only, which is independent of the valve's specific filed of use. In the meanwhile, valves for pressure cooker, heart, and vehicle have classification places in A47J, A61F, and B60, respectively, which is decided in accordance with the use of valves.

(2) The IPC in patent documents has three different entries/schemes such as 'IPC identification abbreviation' 'classification symbols describing invention information/additional information or indexing code showing additional characteristics of the subject-matter to be classified', and 'version directive'. The classification symbols and indexing code in patent documents shall be stated in the order of 'classification symbols describing invention information' → 'additional information (non-invention information)' → 'indexing code (showing additional information only)'.

The invention information and additional information shall be expressed in boldface style and regular style, respectively. Patent documents in countries with extension level shall be expressed in italic type, while countries with basic level shall express in regular type.

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(Ex1) Countries with Extension Level (Korea)

Int. Cl. ***C04B 32/00*** (2006.04) ***B28B 5/00*** (2006.01) ***B28B 1/29*** (2007.04) *H05B 3/18* (2008.07) *C04B 111/10* (2006.10)	IPC Identification Abbreviation Version Directive, write in square style for month, year **Boldface style for invention information** Regular(non-bold) style for additional information *Italic style for extension level* Indexing code used only for additional information
3 extension level classification symbols describing invention information: C04B 32/00, B28B 5/00, B28B 1/29 1 extension level classification symbol describing additional information: H05B 3/18 1 indexing code describing additional information: C04B 111/10	

(3) It is discretionary to grant additional information for the already classified invention. The additional information can be given by either indexing code or classification symbols.

With regard to classification confirmation, the classification symbol for invention information and additional information can be I (first letter of Invention) and N (first letter of Non-invention), respectively. Yet, the main classification shall always have attributes of invention information while the indexing code has those of additional information.

For the purpose of treating the technical matter not in claims but included in detailed description or drawing(s) as preferable research, the invention can be given a classification

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symbol for the additional information. The method of granting a classification symbol for technical subject-matter applies mutatis mutandis.

(4) Where lack of unity of invention exists, the classification place stated in subject matter stated in 'claim 1' becomes the main classification while the place for other claims becomes sub-classification.

(5) With regard to the claimed invention which requires confidentiality due to national security, is liable to contravene public order or morality or to injure public health, or relates to convergence technologies, etc., such requirement and concerns shall be stated too.

(6) With regard to divisional application, converted application, domestic priority claim, or application of lawful holder of the right, the classification of an earlier application shall be identified first. Except when the classifications given to an earlier application obviously fail to correspond to the subsequent application, it is preferable to remain the same classification of an earlier application as main classification of a subsequent application while designate the newly granted classification as sub-classification.

3.4 IPC Assignment by Technical Subjects

(1) Apparatus or Method

In principle, the classification place for either an apparatus or a method shall be used if a pertinent place for either of them exists. However, if the apparatus has no classification place, then the method in the apparatus shall be used for a classification place. Where the classification place for a method does not exist, the place for an apparatus which performs the method shall be used. If neither an apparatus nor a method has a relevant classification place, the place for the product which was manufactured with the apparatus or the method shall be used.

(2) Products

The manufactured product shall be classified with the place pertinent to the product. If no such place exists, an appropriate function-oriented place shall be used. And if there is no appropriate function-oriented place, then the areas using this manufactured product shall be

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used for classification place.

(3) Multistage Process or Plant

A multistage process or a plant such as a process with plural stages or a composition with plural apparatuses shall be classified with such of place pertinent to the composition (for example, B09B). If there is no such classification place for the composition, the place for the output produced from the composition shall be used. Where constituents of the composition have individual characteristics, each constituent shall be classified, too. Provided however that the composition has no intrinsic characteristics but its constituent has, the composition shall not be classified.

(4) Specifics or Structural Parts

If structural or functional specifics or parts in the claimed invention are used only for a certain apparatus, the claimed invention shall be classified into the place for the apparatus. However, if such specifics or structural parts can be used for more than 2 apparatus, it is advisable to classify in place for that specifics or parts. In the meanwhile where there is no place for them, it shall be classified in place for the relevant apparatus.

(5) Single Technical Subject Matters Included in Multiple Groups

Where a single technical subject matter is related to more than 2 groups directly and intrinsically, the technical subject matters relevant to multiple groups shall be classified in the place for all the related groups. Also, if a single technical subject matters is included in more than 2 groups of equal level under the same main group, the technical subject-matter shall be classified in the place for a higher hierarchic group; provided however that the inclusion into multiple groups is of little importance for search and the combination of elements simply arrives to this single technical subject matters. Yet, where the technical subject is related to several groups under different main groups, the subject-matter shall be classified in place for each group.

(6) Compounds

The technical subject-matter of chemical compounds (organic, inorganic or polymer) shall

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be classified in the relevant place for Section C pursuant to its intrinsic characteristics of compounds (i.e. chemical structure). If the compound is also related to the field of use and the field of use is essential content of the technical subject-matter, the field of use shall be classified in the place if a pertinent place exists. However, if the technical subject-matter of the claimed invention is related to the use of the compound, only the field of use can be classified in the place.

(7) Mixtures or Compositions

Where mixtures or compositions are technical subject-matters in the claimed invention, they shall be classified in the relevant place pursuant to the intrinsic features of mixtures or compositions (for example, C03C for glass composition, C04B for cement or ceramic composition, C22C for alloy composition). If there is no relevant place, they shall be classified pursuant to their use or application. And if there are essential characteristics in the use or application, the mixtures/composition per se and their application or use shall be classified into the place.

(8) Manufacture or Treatment of Compounds

When the technical subject-matter of the claimed invention is related to the manufacture or treatment of compounds, the compounds per se shall be classified provided however that the methods of manufacture or treatment shall be also classified if pertinent places exist. Yet, the general method of manufacture or treatment of compounds shall be classified in the place if the relevant place exists.

(9) Classification of Compounds in Markush Type

With regard to chemical compounds in Markush Type which is generally defined in a chemical formula, the general chemical formula of the compound shall be classified in the place individually if the formula has a few relevant places (for example, less than 5).

If specified compounds are things per se in the claimed invention (particularly composition), output produced from the process of claims, or their derivatives, the compounds shall be classified in each relevant place of the above mentioned. 'Specified' in this text refers to ① 'designated' of the structure of compounds by title or formula or

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'inferred' from the manufacturing method of a specific reactant among selective reactants, or ② 'identified' with physical properties (for example, melting point) in the description or 'described' as an implement example where the manufacturing method is depicted in detail.

They are classified as useful information for the purpose of other searches.

(10) Classification of Compounds in Combinatorial Libraries

With regard to combinatorial libraries where a large number of different compounds or bioactive substances are involved, each individual compound shall be classified pursuant to the same method as the classification of compound in Markush type. Provided however, the characteristics of the entire library shall be classified into the combinatorial chemistry (C40B).

3.5 Confirmation of the IPC

(1) When the pre-classification is assigned by an outsourcing agency and transferred to the examiner in charge, the examiner shall check as to the pre-classification has been appropriately made based on the technical subject-matter of the claim with referring to the detailed description and drawings (if necessary). If an application has been found to be incorrectly pre-classified by the agency, the examiner may reclassify the classification with appropriate classification places.

The IPC classification has a hierarchical structure consisting of IPC section → subsection → class → subclass → main group → subgroup. In consideration of the hierarchical structure, the classification shall be determined following hierarchical path from high to low level.

(2) After the pre-classification is verified or reclassified correctly, the pre-classification is confirmed as 'official classification' by the examiner in charge. If further classification is required with consultation of other examiners in the same examination division, the application is re-allocated to another examiner and reclassified by mutual agreements between the examiners concerned. The examiner receiving the application shall 'confirm' the classification.

(3) Where different examination divisions are involved for classification modification, or even

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if it is done within the same division but fails to reach an agreement between examiners concerned, the classification adjustment shall be requested by stating the reasons for reclassification.

(4) In the case of second request (or first request for international application) for the reclassification of the same patent application, officers in Examination Division who are responsible for modifying the classification presumably pertaining to the application shall modify the classification through mutual agreement. If the officers in charge of classification modification in the Examination Division fail to reach a mutual agreement, the classification shall be modified in the presence of a Bureau classification officer (in the case of different examination bureaus involved, all Bureaus classification officers shall attend). When there still remains disagreed, the classification modification officers in the Examination Bureau and Division shall reach an agreement for classification under the initiative of the officer in charge of pre-classification review in the Patent Examination Support Division.

(5) With regard to an application on the request for an accelerated examination and an application which requires an international search pursuant to the Patent Cooperation Treaty, the classification confirmation or reclassification request shall be made within 2 weeks from the day of application transfer or receipt. This time limit shall be extended for 1 month for applications other than the aforementioned.

4. Laying Open of Application

4.1 Purpose

The scheme for laying open of application was introduced along with the system for examination request. The laying open of application, regardless of examination performance, is designed to prevent overlaps in investment and research by publication of the application after the prescribed period elapsed from the filing date.

In the past when the laying open of application was not introduced, the application was not laid open until its registration. Therefore, if the examination on the application was delayed, so did its publication. This results in not only devaluation of the invention as a technical information but also failure to use the invention as common knowledge for social

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contribution in industrial development. In this regard, the examination on the application and its publication are separated and the system for laying open is introduced after the prescribed period elapsed from the filing date.

4.2 Date

(1) The time for laying open of application shall be more than one year and six months after the application filing date. However, as for the applications on priority claim under the treaty or on domestic priority claim, the publication time shall be reckoned from either the filing date of application in the country where the initial application is filed or the filing date of the earlier application (or the earliest filing date if the application involves more than 2 priority claims)

(2) Since divisional application or converted application is accorded the same filing date as the parent application, the time for laying open is reckoned from the filing date of the parent application. Therefore, if the divisional or converted application is filed before the publication date of the parent application, the application shall be laid open later than one year and six months from parent filing date. In the meanwhile, if they are filed after the publication date of the parent application, the application shall be laid open without delay.

(3) If an applicant submits the early publication request form (Form (xxv) in the Enforcement Rules of the Patent Act), the application can be laid open within one year and six months from the filing date.

4.3 Content

(1) In principle, all patent applications shall be laid open after the expiry of the period of one year and six months from the date falling under any subparagraphs in Article 64 (1) of the Patent Act or before that date if requested by applicants. The matters to be laid open are enumerated in Article 19 (3) of the Enforcement Decree of the Patent Act, provided however that the following application, which is in general to be laid open, shall be excluded; an application which omits the statement of claims as prescribed in Article 42 (5) of the Patent Act, an application whose registration is published, or an application which is invalidated, withdrawn, abandoned, or decided to reject.

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(Example) With regard to the original application as a basis of domestic priority claim, it shall be laid open when an application requests its early publication before it is regarded to be withdrawn (i.e., within one year and three months from the filing date of the original application) or the due date for publication arrives (for example, the original application where the priority under the treaty is claimed at the same time).

(2) The patent application shall not be disclosed in patent gazette if it contains matters which require confidentiality due to national security, or is liable to contravene public order or morality or to injure public health. (the Patent Act Article 64, the Enforcement Decree of the Patent Act Article 19 (3))

4.4 Form of being Laid Open

The application is laid open in online patent gazette on KIPO website. The same publication can be found in DVD-ROM and via KIPI website.

4.5 Effects

(1) After an application is laid open, the applicant may give a written warning that the patent application for the invention has been filed. The applicant may demand a person who has worked the field invention as a business, after the person being warned in writing or knowing that the invention has been laid open, to pay compensation in an amount equivalent to what the applicant would have normally received for working the invention from the date of the warning or the date on which the person knew that the patent application of the invention had been laid open to the date on which a registration of establishment of the patent right was made. Provided however that the right to demand compensation may not be exercised until the registration for establishment of the patent right. Exercising the right for compensation does not preclude exercising the patent right (Patent Act Article 65(1)-(4)).

(2) If the application is laid open, the claimed invention shall achieve a status as prior art pursuant to subparagraphs (ⅰ) and (ⅱ) of Article 29 (1) and also can be used for another application for a patent or utility model registration pursuant to Article 29 (3) of the Patent Act.

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5. Request for Examination

5.1 General

(1) The request for examination shall be filed only for an application which is pending in KIPO. Therefore, the examination request is not allowed if the application is invalidated, withdrawn, or abandoned. The request shall be made only one time for one application. Once the request is admitted, it cannot be withdrawn. Also, the valid request for examination shall continue even in case of losses in legal capacity or competency due to death of an applicant.

In the meanwhile, where examination request is filed by a patent applicant, the request is allowed only when a description with the claims is attached to the written application, according to Article 59(2).

(2) Any person may request an examination of the patent application even including the 3rd parties without interests in the application, provided however that the incompetents including minors shall appoint legal representatives for a request procedure.

An association or a foundation which is not a juridical person but for which a representative or an administrator has been designated may file a request for an examination of a patent application.

(3) A request for examination shall be filed within five years (3 years for an application of a utility model registration) from the filing date of the application.

For a divisional application or a converted application, a person may request an examination within thirty days from the filing date of the divisional application or the converted application, even after the expiry of the aforementioned 5-year period.

(Note) The request for examination of an international patent application shall be made within 5 years from the international filing date, not from the submission date of its translation to Korea pursuant to Article 11 (3) of the PCT and Article 199 of the Patent Act (Case No. 95 Nuh 3336 (Supreme Court, 16. June. 1998)).

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(4) Where a request for examination has not been made within the prescribed period, the patent application concerned is deemed to have been withdrawn.

5.2 Procedure

(1) A person filing the request for examination shall submit a written request (Form (xxii) in the Enforcement Rules of the Patent Act) to the Commissioner of KIPO and pay the examination fee (the Patent Act Article 60 (1)).

(Note) Where the number of claims increases because of amendments to the specification after the request for examination made by a person other than the applicant, the applicant shall pay the fee for the request for examination corresponding to the increased number of claims. Where the examination fees for the increased claims are not paid, the applicant is asked for the amendment. If the applicant fails to make additional payment as requested, the amendment procedure in the pertinent specification can be invalidated.

5.3 Effects

(1) The application whose examination is on the request shall be examined by an examiner. The application can be terminated only by either patent registration or rejection unless it is invalidated, withdrawn, or abandoned.

(2) When the request for examination is made before the laying open of the application, the purpose of the request for examination shall be published in the patent gazette upon the publication of an application (or immediately if the request for examination is made after the laying open of application).

(3) For an application omitting the claims in the specification, an applicant shall amend the specification to include the claims till the date prescribed in Article 42(5) subparagraph (ii) of the Patent Act, in response to the notification of the request for examination by the 3rd party.

(4) Where the request for an examination has been filed by a person other than the applicant, the Commissioner of KIPO shall notify the patent applicant accordingly (Patent Act Article 60(3)). Where an examiner makes a final decision (withdrawal, abandonment included)

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regarding the application whose examination is requested by a person other than the applicant, he/she shall notify the decision to the 3rd party accordingly. (Instruction Article 26 (4))

6. Start of Examination

6.1 Examination Order

An examiner shall verify whether the application received in order is appropriately allocated to him/herself in terms of the IPC, the validity of his/her function in examination, etc. To prevent an examination delay, the verification procedure shall be concluded as quickly as possible.

(1) The examiner shall review whether the technical subject-matter of the claimed invention is classified appropriately pursuant to the IPC and whether the application is within the scope of his/her IPC scope in charge. If the examiner finds the classification inappropriate, he/she shall determine the appropriate IPC pursuant to the Part V Chapter 1 Section 3 of the Guidelines and allocate the application to an examiner in charge of the re-classification after consultation.

(2) The examiner shall review whether he/she may fall under the exclusion reasons stated in subparagraphs (i)-(v), or (vii) in Article 148 of the Patent Act, or whether he/she shall be excluded from exercising his/her functions in examination because he/she with less than 2 year experience as an examiner had serviced at the organization filing application for the last 3 years right before his/her appointment as an examiner. If an examiner has reasons to be excluded, the application shall be transferred to another examiner who is in charge of the most similar technical classification with the approval of director of the Examination Bureau.

(3) The examination starts in the order of the request for examination by the category of an examiner or classification of technical subject-matter (subclass). The start of the examination in this context refers to notice for the first time under the name of either himself/herself or the Commissioner of KIPO during the examination such as notification of grounds for rejection, amendment request, request for consultation, or delivery of a certified copy of decision to grant a patent.

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(4) If the date of examination request is identical by the category of an examiner or classification of technical subject-matter, an application for a patent shall have a priority to an application for a utility model registration. If applications are in the same kind, the application with earlier filing date has priority over later application in terms of examination.

(5) A divisional or a converted application shall be examined in the order of their examination request. However, their examination starts to the order of the request for the examination of their parent application when they file after the examination request of their parent application.

In case when the parent application is divided or converted after the examination started, the examination shall start before the later date of either 3 months from the examination request for the divisional or converted application or 2 months from the receipt of application documents. Yet, in the case of a parent application on request for an accelerated examination, its divisional or converted application does not follow the aforementioned order but the order of the parent application.

6.2 Examination to be deferred

(1) An examiner may defer the examination of applications under following cases;

① Where an earlier application or a competitive application (an application claiming identical inventions filed on the same date) is not laid open or a competitive application is not on the examination request.

② Where an earlier application on the domestic priority claim is prior to the withdrawal period pursuant to Article 56.

③ Where a trial or a litigation related to the relevant application is still on pending.

④ Where a search is outsourced to a specialized organization, an advice of outside specialists is requested or an examination with consultation is required.

⑤ Where the period for submitting evidential documents for priority claims under the treaty does not elapse.

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⑥ Where there arises needs for an examination to be deferred

See Part 5 Chapter 3「8. Examination to be deferred or Extension of Pendency Period」 for the detailed content regarding deferment of examination.

(2) When an examiner decides to defer the examination, he/she shall communicate it to the head of the examination unit and the period of deferral is less than 2 months. When the examiner considers the examination to be deferred again because the application whose examination had been deferred does not overcome the previous deferral reason or new deferral reasons occur, it shall be reported to the head of the examination division (team) following a head of the examination unit. The aforementioned reasons of (1) ④, ⑥ apply only when an examiner cannot take any responsibility for the deferral due to such reasons (ex, delivery of delay of prior art search report). The examiner can defer the examination again within 2 months.

(3) The examiner shall check whether the deferral reasons are overcome for the application whose examination had been deferred more than once a month. When the deferral reason is overcome, the examiner shall begin the examination until the deferral period is terminated.

(4) When there are two or more patent applications claiming an identical invention, the examination for the later applications shall be deferred till the application with earlier filing date, referred to as the earlier application is processed, laid open, or its publication of registration of a patent is made in Patent Gazette. However, if the both applications can be rejected by the same reason, the examination may begin without being deferred (Article 40 of the Enforcement Rules of the Patent Act).

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Applicant	Earlier Application	Examination of Later Application
Identical	Laid off	Notify grounds for rejection pursuant to Article 36 (1) after examination (Decide grant or rejection of a patent after confirming the scope of a claim of the earlier application)
	Not Laid off	Notify grounds for rejection pursuant to Article 36 (1) after examination (Identify the application number of the earlier application and the claimed invention stated in the claims, and decide a grant or rejection of a patent after confirming the scope of a claim of the earlier application)
Different	Laid off	Notify grounds for rejection pursuant to Article 29 (3),(4) after examination (Apply Article 36 (1) for identical inventor)
	Not Laid off	Defer examination till the earlier application is laid off

(5) Only if the earlier application is processed, laid open, registered in patent gazette after the examination deferral of the later application, the later application is allowed to begin the examination process. Notwithstanding the aforementioned, however, the final decision for the later application shall be made after confirming the scope of a claim in the earlier application pursuant to Article 36 (1) of the Patent Act.

7. Processing Deadline

(1) For the application on the request of reexamination after its rejection and the application cancelled and returned from the appeal against the decision to reject, an examiner in charge shall begin the reexamination within one month from the receipt of the application documents. Yet, if the reexamination cannot start within the prescribed one month due to unavoidable reasons, the reasons shall be reported to the head of examination bureau for applications cancelled and returned, or the head of examination division/team for applications either on request for reexamination or on reconsideration by examiner before

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trial.

(2) With respect to an application on request of the accelerated examination, the examiner shall determine as to whether the application falls under the category of the accelerated examination within 7 days from the receipt date of the request (Instruction Article 59). In the meanwhile, the examination shall begin within 2 months from the delivery of the notice of the aforementioned examiner's decision. The interim documents shall be processed within 2 months from the later date than date of document submission or that of the receipt of the relevant documents of the application. (However, within 4 months as for accelerated examination under Article 4(3) or (4) of the Directive)

(3) Reference to other processing deadlines is as follows:

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(Abbreviation: Month/M, Week/W, Day/D)

Type		Initial Date	Time	Reference	Others
IPC Classification	Definitive Classification	Receipt Date of Application Preclassification	1 M	Instruction Article 10(2)(i)	Regular
			1 WK	Instruction Article 10(2)(ii)	Priority
			2 Ds	Instruction Article 10(2)(iii)	High-Speed Application
Regular Examination	Examination Start	Examination Request Date	Request Order	Enforcement Rule Article 38 Instruction Article 20	
	Interim Documents	Expiration Date of Designated Period/ Receipt Date of Interim Documents	4 Ms	None	Late Expiration Date
Accelerated Examination	Decision for Accelerated Application	Receipt Date of Notice of Accelerated Application Request	7 Ds	Instruction Article 59(1)	
		Expiration Date of Amendment Period/ Receipt Date of Amendment Documents	7Ds	Instruction Article 59(3)	Late Expiration Date
	Prior Art Search Request	Delivery Date of Patent Decision Notice	15Ds	Instruction Article 86(1)	
	Examination Start	Delivery Date of Patent Decision Notice	2Ms (However, within 4 months as for accelerated examination under Article 4(3) or (4) of the Directive)	Instruction Article 66(1)	Late Expiration Date
		Receipt Date of Prior Art Search Outcome	1M		
		Receipt Date of Written Amendment	1M	Instruction Article 66(2)	
	Interim Documents	Expiration Date of Designated Period/ Receipt Date of Interim Documents	2Ms	Instruction Article 66(2)	Late Expiration Date
Super Accelerated Examination	Decision for High-speed Examination	Receipt Date of Notice of Accelerated Request	2Ds	Instruction Article 59(4)	
		Expiration Date of Amendment Period/ Receipt Date of Amendment Documents	2Ds	Instruction Article 59(4)	Late Expiration Date

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	Examination Start	Delivery Date of Notice of Accelerated Examination Decision	14Ds	Instruction Article 66(5)	
	Interim Documents	Expiration Date of Amendment Period/ Receipt Date of Amendment Documents	1M	Instruction Article 66(6)	Late Expiration Date
Examination Deferred	Examination Start	Examination Deferral Date/ Application Receipt Date	3Ms	Instruction Article 21bis	Late Expiration Date
Divisional/ Converted Application	Examination Start	Examination Request Date	3Ms	Instruction Article 21(1)	Late Expiration Date
		Documents Receipt Date	2Ms		
Request for Reexamination after Cancellation	Examination Resume	Documents Receipt Date	1Ms	Instruction Article 55(1)	
Extended Designation Period	Decision for Approval	Receipt Date of Term Extension Request after Expiration	2Ws	Instruction Article 23bis	Approval of Automatic Extension after Expiration

8. General Principles for Law Application

(1) Where the revision of the Patent Act is made while the application is pending, transitional measures are introduced in order to prevent disadvantages. Therefore, the provisions of the law shall be applied as of the filing date.

(2) Since the divisional or converted applications and the applications filed by lawful right holders are accorded the same filing date as the parent (earlier) application, the provisions of laws are applied as of the parent (or earlier) filing date.

For example, if the divisional application is filed on July 1, 2009 based on a patent application having filed before June 30, 2009, the Patent Act before the revision on January 30, 2009 by Act No. 9381, which entered into force on July 1, 2009, shall be enforced to the divisional application.

Meanwhile, the Patent Act shall apply to an international patent application based on the date of filing the international patent application, not the date of submission of documents under Article 203(1) of the Patent Act.

(3) For an application claiming the priority under Treaty or the domestic priority, and an application claiming purport of not-prejudicial disclosures, the provisions of the law shall be applied as of the application filing date of the original application.

For example, when an applicant filed an application, claiming a priority in Korea after

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October 1, 2006 on a basis of the original application filed in Japan before September 30, 2006, the internationalism, which inventions publicly known or worked can be used as prior art (amended to be included in Article 29 (1) (i) of the Patent Act by Act No. 7871 on March 3, 2006), can be applied to this application. The examiner may notify the applicant by the grounds that it is publicly worked in Japan before the filing date in Japan.

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Chapter 2. Search for Prior Art

1. Overview of Search for Prior Art

The search for prior art is performed during the examination stage with the objective of discovering the relevant state of the art to assess the patentability of the invention such as novelty and inventive step. The search for prior art includes the search for earlier applications prescribed in Articles 36 and 29 (3) of the same Act.

If considered necessary for examination, an examiner may outsource the search for prior art to the specialized organization pursuant to Article 58(1).

2. Procedure Prior To Search for Prior Art

(1) Before searching for prior art, an examiner shall analyze technical subject-matters of the invention. The search for prior art should be made on the basis of the claimed invention, but the examiner shall pay due regard to the detailed description/drawings if necessary.

(2) When the application cites documents in the description, the examiner shall analyze documents to find out whether the documents provide the starting point of the claimed invention, show the current status of the technology, explain other solutions for the tasks intending to resolve in the claimed invention, or describe for better understanding of the claimed invention. If considered necessary, the examiner shall refer the documents to take a starting point for search.

If the cited documents are not directly related to the claimed invention and it becomes obvious that they are just stated in the description, the examiner shall disregard those documents. When the examiner finds it that the documents are necessary to assess the patentability but are unable to acquire via a common method, he or she shall request the submission of the documents from the applicant and defer the examination till the submission.

(3) If foreign patent offices or search organizations already conducted search regarding the application of the claimed invention, the examiner shall review the search outcome to

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determine as to whether they can be used as relevant prior art.

3. Search Procedure

3.1 Search Scope

(1) The search is carried out in collections of documents or database, the contents of which are systematically accessible. There are primarily patent documents of various countries, supplemented by other various kinds of publications such as technical journals, periodicals, books, any written materials as well as microfiche, CD-ROM and DVD-ROM

(2) The search is carried out in collections of documents or database which many contain materials in all those technical fields pertinent to the invention. The search strategy should determine the sections of the documentation to be consulted covering all directly relevant technical fields, and may then have to be extended to sections of the documentation covering analogous fields, but the need for this must be judged by the examiner in each individual case, taking into account the outcome of the search in the sections of the documentation initially consulted.

3.2 Conditions under which Search is not Required or is Limited

No special search effort needs to be made for searching or search may be carried out within the necessary scope if the claimed invention falls under any of the following cases. The examiner shall notify the applicant of the fact that the application concerned does not comply with the provision of Patent Act to such an extent that a meaningful search is impossible for some or all of the claims.

① Where amendment made beyond the scope under the Patent Act Article 47

② Where the claimed invention is not patentable under Article 32

③ Where the claimed invention is incomplete or not industrially applicable under Article 29

④ Where the claims of the application do not relate to one invention only, nor to a group

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of inventions linked so as to form a single general inventive concept under Article 45

In such case, the examiner may first notify the grounds for rejection based on the lack of unity of invention and wait for the applicant's response.

⑤ Where the examiner is unable to interpret the claims due their lack of clarity and conciseness

However, if the examiner can understand the invention despite any deficiencies in the statement, the examiner shall proceed with the search and assessment of patentability within the scope of the defined invention.

3.3 Time Coverage of Search

(1) In conducting a search, the examiner should search documents published before the filing date of the application (or, for an application with a priority claim, documents published before the date of priority).

However, in exceptional cases the search can be extended to documents published after the filing date. This exception applies if documents are searched and used for the purpose of applying Article 29(3) and (4) or Article 36 of the *Patent Act*. In addition, where the validity of a priority claim under treaty or a domestic priority claim cannot be verified in the search stage, the basic reference date for the search is deemed to be the filing date of the application.

(2) A search does not normally take into consideration documents published after the filing date of the application. However some extension is necessary for specific purposes. For example, a later document describes the underlying principle or theory of the invention, which could give the examiner a better understanding of the invention, or a later document may also confirm the incorrectness or incompleteness of the of the underlying rationale or facts of the invention.

(3) For an application with a priority claim under treaty or a domestic priority, the basic reference date for the search on each claim is the filing date of the application. However, if there any documents published between the earliest prior date and the filing date of the

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application, the examiner should first identify the relevant date of each claim between the prior date and the filing date and then decide which documents to cite.

However, when there is no trouble to decide the reference date in each claim, the examiner may decide the priority date in each claim and then conduct the search for prior art by each claim.

3.4 Suspension of Search

(1) The examiner may suspend the search when he/she discovers prior art clearly demonstrating lack of novelty or inventive step in the entire subject matter of the claimed invention.

(2) In case of a particular application, it can take a substantial amount of time and energy in completing the search. Therefore, the examiner shall devise the most effective method to conduct the most thorough search for prior art within available time and cost. In this case, even if the examiner with the rational judgment fails to discover effective prior arts for search, he/she may suspend the search.

3.5 General Principle of Search

(1) The search will take into consideration prior art incorporating technical features which are equivalents to the technical features of the claimed invention, in light of the detailed description of the invention. However, such equivalent elements are not considered only limited to the scope of technical features explicitly described in the detailed description.

(Ex) The claimed invention relates to a device characterized by structure and function of plural parts. Where claim describes the parts are put together by welding, it is interpreted to include other types of combining elements such as gluing, riveting and etc. other than welding unless it is clearly stated that the technical feature of the invention only has to do with the means of welding.

(2) The search carried out in sections of the documentation to be consulted for the independent claim(s) must include all dependent claims within the identical classification. Dependent claims should be interpreted as being restricted by all features of the claim(s)

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upon which they depend. Therefore, when the patentability of the subject-matter of the independent claim is not questioned as a result of the search, there is no need to make a further search or cite documents in respect of the subject-matter of the dependent claims as such.

(Ex) For an invention comprising pharmacological composition in curing for nail disease and disorder, where prior art of independent claims describing combining method of main components for the claimed invention does not exist, there is no need to make a further search in respect of dependent claims using volatile organic solvent as a composition carrier.

(3) When the application contains claims of different categories, all these must be included in the search. However, if a product claim clearly seems to be both new and non-obvious, the examiner should make no special effort to search claims for a process which inevitably results in the manufacture of that product or for use of the product.

When the application contains only claims of one category, it may be desirable to include other categories in the search.

(Example 1) An examiner can assess novelty and inventive step with regard to final products by carrying out the search, even though invention relates to a method of chemical process.

(Example 2) In case of the process invention for manufacturing article or in case of determining whether the producing process can be easily solved after the prior art search is conducted on the claimed invention.

(4) The search for prior art shall be made on a basis of the claimed invention. Nevertheless, if no additional excessive efforts are required, the examiner may conduct the search for prior art on the based on the invention stated in the description but not included in the scope of the claim, with preparing for the amendment.

3.6 Citation of Prior Art Documents

(1) The prior art pointed as the grounds for rejection shall be cited only if there are no doubts concerning the fact that it is publicly known or worked, or described in a publication.

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(2) A certain situation occurs in which other documents ensure the accuracy of the contents underlying the prior art document.

(Example) One document of the patent family is published before the filing date of the application, but is published in a non-Korean language, whereas a different member of the same patent family is published in a Korean language but after the filing date of the application. Such same patent family written in Korean can be cited as prior art. In this case, the examiner may notify of the fact that the family document in foreign language had been publicly known before the filing date and have such document attached to his notice for rejection.

(3) The examiner can cite the abstract as prior art document for denying novelty and inventive step of the claimed invention. However, it is noted that the examiner shall notify of the grounds for rejection on basis of the contents disclosed in the abstract, but not on the ground of the whole statement of the application other than the abstract, since the abstract filed does not belong to the application.

(Note) In case of using the abstract as cited documents, an examiner needs to find out matters on whether inventive step can be assessed just by citing the invention disclosed in the full texts. As you can see previously, the main points between the abstract and the full texts are different and there is no ground that the full texts and the abstract are identical just because of the full text easily being obtained. When it comes to notifying the grounds for rejection in the process of the examination and trial, an examiner is required to notify of the reasons by specifically comparing the prior art based on the contents of documents with the full texts where documents with the full texts can be obtained. As this case shows, where an examiner failed to obtain the documents with the full text and had to use the abstract for determining inventive step due to failing of obtaining documents with the full text, the examiner should notify on the grounds of the contents disclosed in the abstract (Patent court decision 2001. 7. 19. 2000 Heo 6288).

(4) The notice for rejection must be accompanied by copies of all documents cited, except the documents which include bulky contents. In such case, the examiner can just copy the pages directly related to the ground for rejection. However, in certain circumstances the

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applicant has easily access to the Internet, such as when the applicant has appointed an agent to undertake a patent-related procedure before the office or when the applicant has filed his application in the electronic form, the examiner may state the Internet address (URL) where the applicant can find the cited documents and the publication number on the notice for rejection instead of sending copies of the documents, particularly in citing the patent documents.

Also, the examiner may just indicate the channel to find the cited document in certain circumstances he finds it difficult to attach the copies of the documents, especially non-patent literature to his notice for rejection due to paid access, prohibited copy, ban of transfer of documents and etc.

(5) When the examiner discovers prior art which is not yet laid open but considered to be used as a status of 'another application' under Article 29 (3) of the Patent Act, he/she shall defer the examination till the publication of such prior art. The examiner may cite the prior art (another application) as grounds for rejection only after its publication.

3.6 Others

Reference can be made to search reports regarding international applications under PCT or patent applications in European Patent System. The related prior art in search reports can be classified as follows depending on its relevance.

① 「X」 : In case denying novelty and inventive step can be determined by reference to just one relevant document

② 「Y」 : In case of denying inventive step when the present document is combined with one or other documents

③ 「A」 : In case the document is related with the claimed invention despite failing to fall upon 「X」 or 「Y」

④ 「O」 : documents mentioned about use, exhibition or oral disclosure

⑤ 「P」: Patent documents before the filing date of international application after the prior date.

⑥ 「E」: Patent documents disclosed before the date of international application and documents disclosed after the date of international application

⑦ 「T」 : Cited documents in order to understand principle and theory of invention or

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disclosed later than the prior date or the date of international application

⑧「L」: Documents disclosed to negate the contents of claimed applications or raise the questions of priority claims or to determine other contents

4. Measures after Searching

(1) The examiner completes an examination report(ER) right before making a final decision to grant or reject a patent application. When identifying the documents cited in the ER, the examiner should indicate the relevance of each document in the citation sheet with an X or Y annotation.

(2) The「Examination Report」may contain keywords and search history used in search for prior art. For the search history, the examiner may include title of search DB, search formula, and number of matches.

(3) The examiner may add to the「Examination Report」the examination reference found in search for prior art.

5. Search for Prior Art by Specialized Search Organization

KIPO may outsource some of its prior art searches under Article 58[1] of the Patent Act. It is designed to mitigate the heavy burden of an examiner and to shorten the examination processing period, which would eventually improve the examination quality and protect applicants' interest.

5.1 Search Request

(1) According to the monthly schedule, the examiner selects the application for the service by external organization. The head of the Examination Bureau confirms the selection made by the examiner and requests the specialized search organization for search service.

(Note) A head of the Patent Examination Support Division plans and notify the annual search request schedule for each Examination Bureau. A head of each Examination Bureau

[1] Article 58: If considered necessary for examination of a patent application (including an international search or international preliminary examination), the Commissioner of KIPO may designate a specialized organization and request it to search for prior art, make an international patent classification, and conduct other tasks prescribed by Presidential Decree.

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then allocates the search request schedule in terms of monthly and an examination team.

(2) A head of the Information Management Division provides applications selected for external search services to the specialized search organization.

5.2 Delivery and Review of Prior Art Search Outcome

(1) The examiner conducts preliminary review before substantive examination and confirmation review after substantive examination.

The examiner review delivery method of search outcome, appropriateness of searched documents, accuracy of the relevancy between searched documents and the claimed invention, balanced composition among search documents, and other issues related to the prior art search service.

(Note) The search outcome produced by the external organization shall be supplied with the format designated by KIPO.「Search Report on Prior Art」compares the technical subject-matter of each claim with its cited documents and has the number of page and line of cited documents additionally. Also, the cited documents attached to the「Search Report on Prior Art」 shows the technical subject matter in pertinent method comparing with the technical subject-matter of each claim of the application.

(2) As a part of preliminary review, the examiner reviews the whole contents of「Search Report on Prior Art」according to the list in「Delivery Statement of Prior Art Search Outcome 」and states the review outcomes in「Review Statement of Prior Art Search Outcome」. The examiner reports the review outcomes to a director of the relevant Examination Bureau following a head of the Examination Division (Team).

The director of the Examination Bureau also reports the review outcomes to both the General Services Division and the specialized search organization having conducted search service with the attachment of the「Review Statement of Prior Art Search Outcome」 and notifies the current state of the reviews to the Patent Examination Support Division.

(3) As a part of confirmation review, the examiner, in the course of substantive examination, prepares analysis report illustrating the utility of the search outcomes (produced from the

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external search service) in accordance with its practical use on the Patent Examination Processing System.

(Note) The service contract for search for prior art contains the provision of reexamination obliged to the service organization in the case when the examiner evaluates the outcomes as unutilized.

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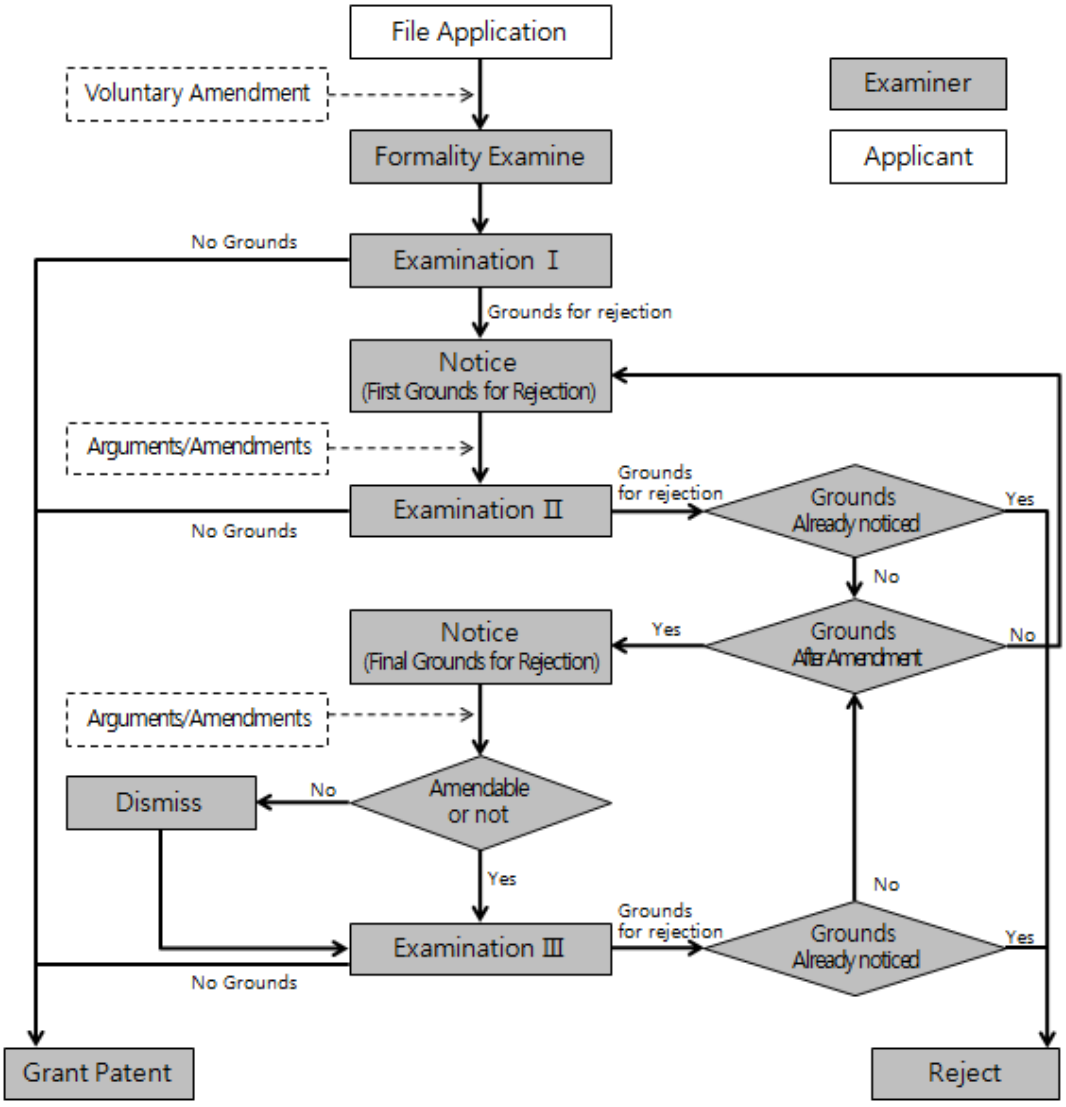
Chapter 3. Examination Process

1. Overview

When the application of a patent fails to satisfy the prescribed requirements in the Patent Act, the examiner shall notify the grounds for rejection to the applicant and provide him/her with an opportunity to submit a written statement of argument in response. When the submitted written statement of argument or amendment thereafter still fails to resolve the notified grounds for rejection, the examiner shall reject the patent application. The examination proceeds as shown in the following flowchart.



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2. Understanding of Invention

(1) In the examination stage, the examiner shall clearly understand essential features of the invention by focusing on the method of problem solving different from the background and also considering the effects of the invention.

(2) The examination is directed to the invention as originally filed, but should take into account any changes from amendments by the applicant prior to the notice of the rejection grounds, if any.

Part V. 「6.3.1 Confirmation Method for Amended Specification」can be referred for the method confirming the amended specification.

(3) The examiner should refer to the claimed invention in the manner stated in a claim. The terms described in a claim should be interpreted within the general scope and meaning of the technical field, unless they have a specific meaning that is explicitly defined in the description.

3. Review of Prior Art Documents

The examiner shall determine as to whether the prior art retrieved can provide grounds for rejection regarding novelty, inventive step, enlarged concept of novelty or earlier application.

(1) Since the publication date of the prior art document is critical to access patentability such as novelty or inventive step, the examiner shall review the bibliography to find out whether the publication date precedes the filing date (or the priority date if the priority claim is concerned).

With respect to the enlarged concept of novelty, the examiner shall check not only applicants but also inventors of the application of patent (or utility model registration application).

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"Novelty" in Chapter II of Part 2 includes the detailed information about the publication date for prior art.

(2) The examiner shall have clear understanding about technical issues disclosed in the relevant prior art documents. It is of worth to note that the examiner shall be careful not to acknowledge matters, which are not disclosed in those documents with the knowledge having acquired from the application of the claimed invention. Also, the examiner shall be cautious not to presumably over-interpret claims without logical grounds.

4. Special Application

(1) In case of application with priority claim or case of a non-prejudicial disclosure, divisional application or converted application, the examiner shall conduct the formalities examination concerning validity of priority claims or procedures prior to substantive examination.

As for the examination of formalities and method regarding procedures of claims and applications, Part IV Chapter OOO shall be referred.

(2) When the priority claim under Treaty, domestic priority claim, or claim for non-prejudicial disclosure are found to be not complied with physical requirements, the examiner shall request amendment to the applicant and may invalidate the procedure of the relevant claim if deficiency is not amended. For the divisional or converted application which does not meet requirement for applicants and period allowed for filing, the examiner shall provide the applicant with an opportunity to explain, and return the application documents to the applicant.

4.1 Priority Claim under Treaty

(1) A person who can claim the priority under the treaty is either an applicant having filed the application in the State party to the Treaty or his/her legitimate successor. Where applicants of between the original and the subsequent applications are not identical, the examiner may, if considered necessary, request for the submission of evidential documents proving his/her legitimacy as a successor.

As for the declaration by an illegitimate claimant of priority right, the examiner requests

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amendment to remedy the deficiency, and invalidates the relevant procedure later on if such deficiency is not cured.

(2) The claim of priority under the treaty shall be declared within twelve months from the first filing date of the first application on which the priority claim is based.

The declaration of the priority is made after expiration of the statutory period, the examiner shall request amendment for the deficiency, and invalidate the relevant procedure afterward if such deficiency is not cured. Since the procedural amendment in the priority claim intends to limit self-evident errors only, the examiner shall state such purport to the notice of the amendment request.

(3) If the application initially filed in the country, which forms a basis of the priority claim (hereinafter 'original application') is regarded as the first regular application, the priority right shall not be influenced by the status of the original application. Therefore, even applications invalidated, withdrawn, abandoned or rejected after filing of the original application can serve as a basis of claiming a right of priority.

The examiner shall not examine whether the original application in the country where the application was initially filed is on the process or not in the country.

(4) If the claimed invention prescribed in the priority claim under the treaty is identical with the invention in the original application in the country where the application is initially filed, the claimed invention application shall be treated as if it has been filed on the date of filing of the original application, in applying the provision prescribed in Article 29, 36 of the Patent Act.

The effects of priority claim in setting the reference date for the application concerned shall be determined on a claim-by-claim basis in principle and details are as follows.

① Where the invention of the original application in the country where the application is initially filed is identical (de facto identical invention is included; hereinafter, the 'identical' includes 'de facto identical' in this section) with the invention with the priority claim under the treaty, the reference date shall be the filing date of the original application in the country where the application is initially filed.

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As for the application involving 2 or more priority claims (complex priority right), when the invention with the priority claim is stated in 2 or more original applications in the country where the application is initially filed, the earliest filing date of the original applications shall be the reference date.

② For the invention which is not filed in the country where initially filed, the filing date of priority claim shall be the reference date.

For the priority claim based on the 2 or more original applications in the country where the application is initially filed, when the invention of the priority claim is a combination of technical subject-matters separately stated in 2 or more original applications in the country where the application is initially filed, or when the invention of the priority claim is a combination of new technical subject-matter and those separately stated in 2 or more original applications in the country where the application is initially filed, the invention of the priority claim shall be treated as an「invention which is not stated in the original application in the country where the application is initially filed」.

③ When the original application in the country where the application is initially filed (the application that forms a basis of the priority claim under the treaty) claims the priority right based on another application having filed beforehand, the original application shall not be regarded as the「earliest application」defined by Article 4 C (2) of the Paris Convention for the Protection of Industrial Property, concerning the invention described in both the original application and the another application. In this regard, the effect of the priority claim shall not be recognized. Therefore, the examination in this case shall not be conducted retroactively to the reference date and the examiner shall notify specific reason for non-retroactive application.

When the examiner during the search for prior art discovers the prior art for the invention that is not possible to apply the reference date in requirements for patent registration retroactively to the period between the earliest date and the filing date of the priority claim, the examiner shall specify the reason for non-retroactive application in the notice of grounds for rejection.

(5) Evidential documents for the priority claim shall be submitted within one year and four

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months from the earliest filing date. Where the priority right claimant fails to submit the evidential documents within the prescribed statutory period, the priority claim loses its effect.

Where the examiner during his/her review of examination records, discovers that evidential documents for the priority are not submitted, he/she requests a procedural amendment to the priority claim and invalidates the procedure afterward if the procedural deficiency is not amended. It is worthy to note that the submission of the evidential documents after the statutory period cannot cure the procedural deficiency.

In the meanwhile, officers in charge shall be aware that the submission of a copy of description or drawing(s) of the invention in the original application can be exempt, if application is filed in countries that are equipped with the on-line system for exchange of evidential documents between administrative patent agencies and agree for on-line delivery of those evidential documents through an electronic access system (Direct-attached Storage, DAS) in Japan, European Patent Organization, US, and WIPO.

Also, officers in charge shall be aware that the application number in the priority claim application may substitute for the submission of documents stating the application number of the original application in the country where the application is initially filed in accordance with Article 54 (4) (ii) of the Patent Act.

(6) If considered necessary, for example, there exists prior art during the period between the earliest date and the filing date of the application with the priority claim under the treaty, the examiner may set a time period and request the submission of translations of evidential documents for priority claim. In the case when the claimant fails to submit the translations in Korean within the prescribed period, the examiner may invalidate the priority claim procedure.

4.2 Domestic Priority Claim

(1) A person eligible to apply for domestic priority claim is an applicant of the earlier application. If the applicant of the earlier application and the applicant of the later application are not same, the examiner shall request amendments and invalidate the relevant priority claim procedure. The scope of amendment request is limited to correction

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of obvious errors.

Whether such determination on whether the both applicants of the earlier and the later applications are same or not is made upon the time when the relevant domestic priority claim has been filed. In other words, the decision is made upon when the applicant states the contents of priority claim or when the applicant makes amendments after the filing date.

(2) The domestic priority claim shall be made within one year from the filing date of the earlier application which forms a basis of the domestic priority claim.

Where the domestic priority claim is filed after the statutory period, the examiner requests amendments and invalidates the priority claim procedure if the deficiency is not cured. Since the scope of amendment request is limited to correction of obvious errors, the examiner shall state such purport to the notice of the amendment request.

(3) Divisional or converted applications shall not serve as a basis of domestic priority claim. Therefore, if the domestic priority claim is based on one of such applications, the examiner requests amendments and invalidates the priority claim procedure if the deficiency is not cured.

(4) Where the application has been invalidated, withdrawn, or abandoned or where the decision to grant a patent or utility model registration has been confirmed, the application hereof cannot serve as a basis of a claim of domestic priority.

If the earlier application falls under the aforementioned cases, the examiner requests amendments and invalidates the priority claim procedure if the deficiency is not cured.

(5) Where inventions claimed in an application containing a domestic priority claim and those stated in the specification or drawing(s) originally attached to an earlier application (hereinafter 'first specification of the earlier application') are identical, the application concerned shall be deemed to have been filed at the time when the earlier application was filed, in applying the provisions prescribed in Articles 29, 36, etc. The effects of priority claim in setting the reference date for the application concerned shall be determined on a claim-by-claim basis in principle and details are as follows.

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① Where the invention in the first specification of the earlier application and the invention in the domestic priority claim are same (de facto identical invention is included; hereinafter 'identical' includes 'de facto identical'), the reference date shall be the filing date of the earlier application which forms a basis of the relevant priority claim.

For the invention involving 2 or more domestic priority claims (complex priority right), when the invention of the priority claim is stated in 2 or more first specification of earlier applications, the reference date shall be the earliest filing date of the earlier application.

② Where the claimed invention is not stated in the first specification of the earlier application, the filing date of the domestic priority claim shall be the reference date.

For the domestic priority claim based on 2 or more earlier applications, when the invention of the priority claim is a combination of technical subject-matter separately stated in 2 or more first specification of earlier applications, or when the invention of the priority claim is a combination of new technical subject-matter and those separately stated in 2 or more first specification of earlier applications, the invention of the priority claim shall be treated as an 「invention which is not stated in the first specification of earlier application」.

③ When the earlier application which forms a basis of the domestic priority claim, claims the priority right based on another application having filed beforehand, the effect of the priority claim shall not be recognized for the invention which is stated in both the first specification of the earlier application and another priority claim. Therefore, the examination in this case shall not be conducted to the reference date when the application was filed.

When the examiner during the search for prior art discovers the prior art for the invention that is not possible to apply the reference date for patent requirement to the period between the filing date of the earlier application and that of the application with the priority claim, the examiner shall specify the reason for non-retroactive application in the notice of grounds for rejection.

(6) Where the inventions stated in the first specification or drawing(s) attached to the application with domestic priority claim and those in the first specification of the earlier application are identical, the earlier application, which shall be deemed to have been

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withdrawn when one year and three months has lapsed for the filing date, is regarded to be laid open at the time when the application with the priority claim is laid open or published in the patent gazette in applying the provision of Article 29 (3).

(7) The earlier application that served as a basis of the domestic priority claim shall be regarded withdrawn when one year and three months has lapsed for the filing date.

When the examiner discovers that the application under his examination is based on the domestic priority claim, he/she shall defer further examination.

In the meanwhile, where the domestic priority claim is invalidated due to deficiency in formalities, the examiner shall resume his examination on the application suspended and considered withdrawn. In this case, another application in Article 29 (3) of the Patent Act or the earlier application in Article 36 may arise as problems between the earlier application and the application with domestic priority claim.

(8) The decision to grant a patent on the domestic priority claim shall be deferred till the earlier application is considered withdrawn. When the examiner carries out the preferential examination on the application with the domestic priority claim, he/she shall notify the applicant that the decision to grant a patent shall be deferred till the earlier application is withdrawn.

4.3 Non-prejudicial Disclosures

(1) Where an application with the statement under the provision of Article 30(2) is filed, the examiner shall examine whether the application is filed within twelve months (six months for applications filed before March 14, 2012) from the prescribed publication date stated in the application. If the application is filed after the due period, he/she requests amendments to the applicant and invalidates the claim if the deficiency is not cured. The untimely claim for non-prejudicial disclosure is considered not overcome.

(2) Where the non-prejudicial disclosure is claimed by the reason that the publication has been made by a person with a right to obtain a patent, the examiner shall conduct additional examinations regarding the followings; whether a person has a right to obtain a patent upon the public disclosure, whether the purport is stated in the application, and

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whether the evidential document of the public disclosure is submitted within thirty days from the filing date. If the examiner discovers deficiency, he requests amendments and invalidates the claim if deficiency is not cured within the prescribed period.

In particular, the examiner shall pay special attention in following cases; where the person who carries out the public disclosure and the applicant are not same, where the type and the date of public disclosure are stated incorrectly, where the evidential documents submitted are not sufficient to specify the invention in the public disclosure, or where the evidential documents are submitted without stating the purport for the claim for the non-prejudicial disclosure in the application (only when the evidential documents are submitted on the filing date).

(3) For a multiple number of public disclosures, where the purport of non-prejudicial disclosures(the box for non-prejudicial disclosure checked) is indicated in the application and the evidential documents for each disclosure are all submitted, non-prejudicial disclosures shall be applied to each disclosure. However, in the case of inseparable relation among the disclosures, if the evidential documents for the initial disclosure are submitted, evidential documents for subsequent disclosure do not need to be submitted.

For example, when the exhibition displays an invention and sells it to the market separately, the exemption claim for public disclosure shall be made to both exhibition displays and market sales with evidential documents respectively. However, if the market sales are closely connected with the exhibition pursuant to the exhibition contract, the submission of the documents for market sales in this case can be exempt.

(Note) Under the First-to-File rule, the public disclosure requirement is exceptionally exempt, which is designed to protect a patent by recognizing novelty when a certain procedural requirements are satisfied and to further promote industrial development. Also, this protects the public confidence and guarantees the foreseeability.

(4) For a multiple number of claims for non-prejudicial disclosure, the legitimacy of the claim shall be judged by each claim.

(5) Where the claim for non-prejudicial disclosure is recognized as legitimate, novelty and

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inventive step are judged as if the concerned invention having publicly known deems not to be known publicly.

4.4 Divisional or Converted Application

(1) A person who can file a divisional or converted application is an applicant of its original application. Where applicants are not identical (all applicants shall be same if involving several applicants), an examiner shall provide an opportunity for petition and then return the concerned application back to an applicant. The scope of amendments of correcting applicants shall be limited to an obvious error.

The decision as to whether or not applicants of an original application and a divisional or converted application are same shall be made as of the time when a divisional or converted application is submitted. It is regarded as legitimate application where the name of an applicant of original application changes on the filing date of divisional or converted application.

(2) A divisional application shall be filed only during the period designated for the amendment of specification or drawing(s) or during the period designated for an appeal against the decision to reject a patent. Conversion of the application shall be made within thirty days from the date that an applicant initially receives a certified copy of decision to reject a patent (or an extended period, if an extension request has been approved).

Meanwhile, even if an appeal against the decision of rejection is requested, a divisional application may be filed within thirty days from the date of transmittal of a certified copy of the decision of rejection (where the period under Article 132(3) is extended, the extended period).

Where a divisional or converted application is filed after the statutory period expiry, an examiner shall provide an opportunity for petition to an applicant and then return the application back to an applicant pursuant to Article 11 of the Enforcement Rules of the Patent Act.

(3) Where an application has been invalidated, withdrawn, abandoned, or confirmed for decision of rejection, division or conversion shall not be made based on the application.

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Also, a converted application cannot be filed after a registration of the establishment of the patent right is made for the original application.

Where an original application falls under the abovementioned case, an examiner shall provide an opportunity for petition and then return the application to an applicant.

Where an original application procedure closes after a divisional or converted application has been filed legitimately, an examiner regards the application as valid and begins examination.

(4) Matters described in the specification or drawings of the divisional applications shall be within the scope of matters described in the specification or drawings of the original applications as of the filing. Where division or conversion is made out of such scope, the application is treated as follows depending on the filing date of an original application.

① Where an original application had been filed before September 30th, 2006, an examiner shall deliver a warning notice for inadmissible division (conversion) to an applicant. Where a written statement of argument submitted by an applicant still fails to cure this scope violation, he/she shall deliver a notice for inadmissible division (conversion). After delivering the notice for inadmissible division(conversion), an examiner conducts an examination as of a filing date of divisional (converted) application, not retroactively.

Where an application contains both a reason for inadmissible division (conversion) and a ground for rejection, an examiner shall in principle confirm the admissibility of conversion (division) before notifying the ground for rejection. However, where the ground for rejection is nothing to do with a retroactive filing date (admissibility of conversion or division), an examiner may deliver a warning notice of inadmissible division (conversion) and a notice of grounds for rejection simultaneously.

Where a notice of inadmissible division (conversion) is delivered, an examination shall be conducted as of the filing date of divisional (converted) application. However, if a violation of division (conversion) scope is legitimately cured during an examination stage, an examination shall be conducted retroactively on an original filing date.

② Where an original application had been filed after October 1st, 2006, an examiner shall

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deliver a written notice of the ground for rejection by reason of scope(division or conversion) violation. Where an argument statement or amendments fail to cure a scope violation, an examiner shall make a decision to grant a patent.

Under this circumstance, where an application contains other rejection reasons along with the scope violation, an examiner includes these grounds for rejection into the same written notice of the ground for rejection aforementioned.

(5) Where a divisional application is made legally and a claimed invention of the divisional application is identical to a claimed invention of the original application after the division, the applications shall be subject to the provision of Article 36 (2). In such case, amendments of the original application are required and it shall be made at the time of filing date of the divisional application (the Enforcement Rules of the Patent Act Article 29 (3)).

(6) Where an original application (hereinafter referred to as "Application A") is divided into a divisional application (hereinafter referred to as "Application B") and the Application B is divided into another divisional application (hereinafter referred to as "Application C"), the Application C is regarded legal and is deemed to have been filed at the time of filing of the Application A, provided that the Application B meets all the requirements for division as to the Application A, and that the Application C meets all the requirements for division as to the Application B.

A converted application shall be treated in the aforementioned manner.

4.5 Application by a Person Entitled to the Grant of a Patent

(1) In order for an application to be recognized as an application by a person entitled to the grant of Korean patent (hereafter referred to as "a lawful holder"), the following requirements shall be met; ① an application by the unentitled person had been filed earlier than by the lawful holder of a right, ② an application by the unentitled person is either rejected for a patent grant or invalidated in a trial due to illegitimacy of an applicant (an application is filed by the entitled person), ③ an application by the lawful holder is filed within thirty days from the date of rejection or invalidation confirmation (invalidation confirmation adds another requirement of 'within two years from the date for publication of

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registration' in the case of a patent application by the unentitled person), and ④ a scope of a claimed invention in an application by the lawful holder of a right falls within the invention scope in an application by the unentitled person.

Where an application by the lawful holder is filed with the Form (xiv) in the Enforcement Rules of the Patent Act (including an application where an applicant argues his/her legitimacy as the lawful holder in the written statement of argument during an examination stage), an examiner shall study the legitimacy of an application before any other grounds for rejection. If an examiner doubts an applicant's legitimacy regarding the abovementioned requirements of ①, ③ and ④, he/she shall deliver a notice stating that a filing date shall not be retroactive.

Where the requirement of ② aforementioned is not satisfied, except for special cases, an examination shall be deferred. The examination shall be resumed promptly after a decision to patentability or a invalidation trial is confirmed.

(2) Where an application is recognized as a legitimate application by the lawful holder of right pursuant to Articles 34, 35 of the Patent Act, it is deemed to have been filed at the date when an application by the unentitled person had filed. In other words, with regard to an application by the lawful holder, judgment of patent requirements, period calculation, or related provisions of the rules and regulations shall be determined as of the date that the unentitled person files an application.

For example, where an application by a third person is filed during the period between the filing date of an application by the unentitled person and the filing date of an application by the lawful holder, an application by the lawful holder shall not be rejected due to a third party's application. As aforementioned, the filing date of an application by the lawful holder is retroactive to the filing date of an application by the unentitled person, which comes earlier than the third party's application. In this case, therefore, an application by the third party is rejected based on an application by the lawful holder.

(3) With regard to a request for examination for an application by the lawful holder after five years from the filing date of an application by the unentitled person, it is deemed valid as long as the application by the lawful holder and the request for an examination are filed

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simultaneously (or on the same date).

(4) The scope of invention in an application by the lawful holder of a right is limited to the claimed inventions as well as those disclosed in the specification or drawings of the application by the unentitled person.

Where an application by the lawful holder includes inventions, which fall beyond the aforementioned scope (for example, an application by the lawful holder involves a multiple number of inventions, among which only some inventions fall within the scope of inventions in an application by the unentitled person), the filing date of an application by the lawful holder shall not be retroactive in the examination.

4.6 International Patent Application

(1) 「International Patent Application」is an international application where the filing date is established under the Patent Cooperation Treaty(PCT) and Korea is designated as a designated State for obtaining a patent.

Except for some exceptional clauses of the Act including enlarged earlier application, an international patent application is treated as an ordinary patent application filed on the international filing date. In this regard, the international filing date becomes the patent filing date, while the specification claims, and drawings having submitted at international application are considered as legitimate description and drawings pursuant to Article 42 (2) of the Patent Act.

An international application filed in foreign languages is deemed to have been withdrawn if its Korean translation is not submitted according to Article 201 of the Patent Act.

An examiner who is in charge of an international application shall pay attention to the following matters.

(2) Where an international application enters domestic stage with the Korean translation submitted, claiming a priority under the Patent Cooperation Treaty, this priority claim is treated as the priority claim under the Treaty. On the other hand, where an application which serves as a basis of the priority claim is either an application filed in Korea or an

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international application where Korea is the only designated State for obtaining a patent, the priority claim is considered as domestic priority claim, instead.

(3) Where an international application filed in foreign language becomes "another application" referred to in Article 29 (3), the application is considered to be laid open at the time of an international publication. However, the scope of inventions of another application is limited to the inventions described in the specification, claims or drawings of both the international application as of the international filing date and its translation.

(4) Where an international application serves as a basis of domestic priority claim and therefore becomes "another application" referred to in Article 29 (3), the application is considered to be laid open at the time of an international publication. However, the scope of inventions of another application is limited to the inventions described in the specification, claims or drawings of both the international application as of the international filing date and the application with domestic priority claim.

(5) In case of an international application, a person intending to apply Article 30 (1) to the invention claimed in an international application may submit a written statement stating the purport of non-prejudicial disclosure of the invention and an evidential documents within 30 days from the reference date (the period designated for documents submission in Korea, or the examination request date if such a request is filed within the designated period), even though such purport has not been stated in a written international application.

(6) Where an international application with domestic priority claim is filed in a foreign language, the scope of inventions of the earlier application, when it is laid open or registered in patent gazette, is limited to the specification, claims, or drawings having been submitted at the international filing date as well as the matters stated in both an international application and its translation.

(7) Where an earlier application, which serves as domestic priority claim, is an international application, inventions commonly stated in both an application with the domestic priority claim and the earlier application (which is limited to the specification, claims, or drawings having been submitted at the international filing date) are considered to have been filed at the international filing date of the earlier application.

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(8) Where Korean translation of the written amendment regarding the description or claims pursuant to Articles 19 and 34 of the Patent Cooperation Treaty is submitted within the reference date, an examiner proceeds the examination procedure with considering an international application to have been self-amended according to Article 47 of the Patent Act.

(9) The scope of amendments to the specification of an international application filed in a foreign language is limited to the specification, claims, or drawings (limited to explanatory parts in drawings) of its translation, or drawings (except the explanatory parts in drawings) of the international application as of the international filing.

(10) An examiner may request an applicant of an international application to submit copies of documents cited in the International Search Report or International Preliminary Examination Report. If considered necessary for an examination, an examiner under the name of the Commissioner of KIPO may request the submission within the designated period.

5. Notice of Grounds for Rejection

(1) The Patent Act (Article 62) stipulates that the examiner, before the decision to reject an application, should notify an applicant of the grounds for rejection and give him/her an opportunity to submit a written argument with specifying a designated period.

This provision is designed to prevent errors or mistakes by an examiner since he or she shall not be always expected to have the advanced knowledge requisite to a judgment to patentability in a claimed invention. And also it would be too harsh to reject a patent outright without giving an error correction opportunity under the First-to-File rule.

The grounds for rejection are as follows.

① Where a claimed invention is not patentable pursuant to Article 25 • 29 • 32 • 36 (1), (3) or 44

② Where no persons are entitled to obtain a patent according to Article 33 (1), or where an a claimed invention is not patentable pursuant to the proviso of the same Article.

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③ Where it violates the clause(s) of the Treaty

④ Where requirements in Article 42 (3)**(i),** (4), (8) or Article 45 are not satisfied.

⑤ Where an amendment is out of the scope prescribed in Article 47(2)

⑥ Where a divisional application is filed out of the scope prescribed in Article 52 (1)

⑦ Where a converted application is filed out of the scope prescribed in Article 53 (1)

(2) The period designated for submission of the ground for rejection shall be within two months regardless of whether an applicant is non-resident or not. However, the designated period hereof may add an additional period required for tests or results evaluations, when a written statement of argument requires tests and their evaluation and their time consumption is acknowledged.

(Note) The period designated by the Commissioner of KIPO (for an amendment request in accordance with Article 46 of the Patent Act) is within one month.

5.1 Instructions for Notice of Ground for Rejection

(1) Except for special cases, all the grounds for rejection having been discovered during an examination stage shall be notified collectively. Also, in order to protect a procedural interest of an applicant in his/her amendment and to expedite an examination process, an examiner shall notify grounds of rejection altogether which might be conflicting.

However, the followings are an exception for collective notice.

① Where contents of a claimed invention cannot be comprehended due to lack of clarity in the description, an examiner shall notify only the ground for rejection due to violations of Article 42(3), (4) without conducting prior art search or accessing the patentability requirements regarding Novelty and Inventive step etc..

However, where lack of clarity in description is insignificant so that understanding of a claimed invention is possible, an examiner shall conduct prior art search and review requirements within his/her comprehension of a claimed invention. Then, an examiner shall

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notify the grounds for rejection found in a prior art search and requirements review and other rejection grounds in violation of Article 42(3), (4) altogether.

② Where it is certain that a claim has a newly added matter, or where it is not certain whether there is a ground pursuant to Article 32 of the Patent Act (invention that is liable to contravene public order, etc.), or where it is clear that a claim does not constitute an invention and is not industrially applicable, an examiner shall notify the aforementioned grounds for rejection without judgment on requirements for patentability such as novelty or inventive step.

③ Where an application fails to satisfy the requirement for a single patent application pursuant to Article 45 of the Patent Act, an examiner shall conduct an examination on inventions which fall under the scope of a group and notify the grounds if discovered through the examination, along with the rejection ground regarding lack of unity.

However, where considered efficient proceeding of an examination, an examiner may notify the violation of Article 45 before judging other requirements for patentability.

(2) Where an examiner notifies the ground for rejection, he/she shall stipulate the relevant provisions of the Act or laws. Also, for two or more claims included, the grounds for rejections should be indicated on a claim by claim basis. Details shall be referred to「5.4 Examination Method by Each Claim」.

(3) The grounds for rejection shall be stated with definite, concise, normal sentences to help an applicant's better understanding. Particularly, the followings are important.

① For a prior art that is related to a judgment of inventive step, an examiner shall cite the minimum number of documents deemed necessary to build a rationale for rejection grounds. An examiner shall stipulate the part of the cited documents that are used for a basis of rejection.

② Where an examiner intends to deny novelty or inventive step by referring to the fact that the claimed invention is publicly known or worked before the filing of the patent application, he/she shall specifically state facts showing that it is publicly-known or worked.

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③ Where an examiner renders a notice of the grounds for rejection due to deficiency in detailed description of a claimed invention, he/she shall specify the deficient parts and stipulate the corresponding reasons.

(4) When notifying a ground for rejection of lack of inventive step, an examiner shall clearly describe the difference between the invention disclosed in the claims and the closest cited invention. (See Part 3, Chapter 3, 5.1 Inventive Step Assessment Procedure) However, the examiner may not describe the difference between the invention disclosed in the claims and the closest cited invention only where a ground for rejection of lack of novelty and a ground for rejection of lack of inventive step are notified together. Where two grounds for rejection are notified together, the examiner shall describe the ground for lack of novelty according to novelty assessment method (See Part 3, Chapter 2, 4. Novelty Assessment). As for the ground for lack of inventive step, the examiner may notify the ground for rejection based on the logic that a person skilled in the art to which the invention pertains can easily make the invention based on the cited invention since the concerned invention in claim O is identical with the cited invention.

(5) If considered necessary for the convenience of an applicant (in his/her responding to the notice of grounds for rejection) as well as for expeditious and accurate examination, an examiner may suggest a division or conversion of an application in the notice of rejection grounds.

However, an examiner shall stipulate in the notice that his/her suggestion has no legal effects and a decision to carry out division or conversion shall be made by the intention of an applicant.

(5) Where the written notice of rejection grounds having been issued contains errors in writing, an examiner shall issue a correct notice of grounds for rejection again, regardless of whether an applicant submits a written statement of argument. However, exceptions are as follows.

① Where an applicant is deemed to submit a written statement of argument based on his/her correct understanding and interpretation of errors

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② Where an applicant does not submit any arguments and the errors are just a simple misspelling or missed letter that are not influential for an examiner's decision of grounds for rejection.

(6) Where the description contains a self-evident error in writing, an examiner shall notify the error as 「Considerations」if there is other grounds for rejection, If there is no other grounds for rejection, an examiner shall communicate this with an applicant by telephone (or others) and may advise an applicant to self-amend or amend *ex officio* (refer to「Chapter 5. Amendment *Ex Officio*」).

The advice or guidance aforementioned by communication media shall be documented in 'Applicant/Attorney Personal Interview' in「Examination Report」.

5.2 Rejection without Additional Notice of Grounds for Rejection

Where an examiner finds that the grounds for rejection which have been notified still exist to the notice of grounds for rejection with taking any amendments into consideration, he/she should make a decision of rejection without an additional notice regardless of other rejection grounds (however, the case in (5) below shall be the exception).

Here, 「the ground for rejection have been notified」 refers to a case where the concerned ground for rejection in rejection decision primarily coincides with the previously-notified rejection grounds. Decision of whether to primarily coincide with or not shall not be confined to an expression or a sentence. It shall be evaluated in perspective of whether or not an applicant is practically given an opportunity to submit his/her opinions.

The followings are examples where primary coincidence is not admitted and therefore the notice of grounds for rejection is issued again.

(1) Where different provisions of the Act and Rules are applied to the same claim, an examiner shall issue the notice of the ground for rejection again.

For example, grounds for rejection such as absence of novelty or inventive step, claims with no supporting detailed description, and deficiency in claims and detailed description are not deemed to be primarily coincident with each other. They shall be treated as separate,

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individual ground for rejection.

However, where despite the fact that different provisions of the Act and Rules are applied, the claimed invention becomes identical (including de facto identical. Hereinafter the same shall apply) with the invention in the claim where the ground for rejection had been already notified, the grounds for rejection between these claims are regarded as primarily coincident. An examiner shall render a decision of rejection based on this ground and shall stipulate this ground in a written decision to reject.

(2) Where an examiner discovers a different type or number of cited inventions denying novelty or inventive step, except for special cases, it is deemed a new ground for rejection. An examiner, therefore, notifies the ground for rejection again. The same will apply to a case where type or number of cited inventions changes due to new combinations with other cited inventions in other claims.

For example, an examiner had denied inventive step by referring to cited invention 1 to claim 1, cited invention 1 and 2 to claim 2, and cited invention 1 and 3 to claim 3. Again an examiner, to deny inventive step in claim 3 to which technical subject matters of claim 1, 2 and 3 are combined through amendments, refers to cited invention 1, 2 and 3. This is not admitted as primarily coincidence case.

(3) Where the ground for rejection lies in a claim newly-established by amendments, an examiner, instead of issuing a rejection decision, shall deliver the notice of grounds for rejection and provide an opportunity for an applicant to submit an opinion. Where an applicant states a new invention in the claim number that had been deleted through amendments, an examiner shall treat this claim as newly established.

However, where the invention described in newly-established claim is identical with the invention in a claim to which the ground for rejection had been notified, an examiner may render a rejection decision by the rejection ground in the claim to which the rejection ground had been notified.

(4) Where an invention becomes identical with a claim in which the grounds for rejection have never been notified, except for special circumstances under which it becomes also

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identical with the invention in other claim in which notice of grounds for rejection is already notified, an examiner should render the notice of grounds for rejection again.

(Note) The judgment of whether or not amendments changes or expands the scope of invention in a claim (including de facto change or expansion) does not influence to determine the primary coincidence among grounds for rejection.

(5) Where a ground for rejection is notified and then the application is re-examined by considering the amendment, but still the before-notified ground for rejection is a ground for rejection, the examiner is supposed to make a decision of rejection without notifying a ground for rejection. However, where it is deemed that the applicant clearly indicated the intention of amendment to address the ground for rejection, but the amendment is omitted in the written amendment, the examiner may notify the same ground for rejection again in the certain condition.

The followings are the condition under which the examiner can re-notify the same ground for rejection:

① Even though the purport and content of amendment to address the notified ground for rejection are clearly indicated in the written opinion, etc.,

② the amendment is omitted from the written amendment;

③ if amendment is made to the amendment omitted in the written amendment, the concerned ground for rejection is deemed to be addressed;

④ other notified grounds for rejection are all addressed, except for ground for rejection regarding the amendment omitted from the written amendment.

The type of re-notified ground for rejection is the same as the type of ground for rejection in the initial notification of the ground for rejection. In other words, if the re-notified grounds for rejection are the initial grounds for rejection at the time of notification, the initial grounds for rejection shall be notified. Where the re-notified grounds for rejection are the final grounds for rejection at the time of notification, the final ground for rejection shall be notified.

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Meanwhile, as for application filed without a legal representative, where the applicant receives a ground for rejection, but indicates the intention of amendment only in the written opinion and submits it because the applicant does not know how to make an amendment of the specification, even though only the above-mentioned requirement ① is met (not the requirements ②, ③, and ④), the examiner may re-notify the same ground for rejection if deemed necessary to give the applicant opportunity of amendment.

5.3 Types of Notice of Ground for Rejection

Notice of grounds for rejection can be classified into two different types. Depending on the type of notice, an applicant shall comply with different restrictions in terms of scope of amendments in the specification or drawings.

One is a notice in which an examiner notifies only new rejection grounds incurring from the amendments according to the previously-issued notice of rejection grounds (hereinafter 'final notice of grounds for rejection') and the other is a notice which is received by an applicant first time or not a last time (hereinafter 'non-final notice of grounds for rejection').

5.3.1 「Non-final Notice of Grounds for Rejection」

(1) An examiner may issue 'non-final notice of grounds for rejection' regardless of self-amendments or not, if it is issued for the first time since the start of an examination.

(2) When identifying a ground for rejection in the amendment confirmation section which has not been amended yet (including an amendment confirmation number in the Form (ix) in the Enforcement Rules of the Patent Act. Hereinafter the same shall apply.), an examiner shall issue 'non-final notice of grounds for rejection'.

(3) Even when an examiner shall issue the non-final notice of grounds for rejection on the second time or more, if the grounds for rejection in this case are not necessitated by amendments made in response to the previous notice of grounds for rejections, 'non-final notice of grounds for rejection' shall be notified.

(Example 1) In below example, an examiner has issued the non-final notice of grounds for rejection and examines again the claim whose insignificant description deficiency (when

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referring to the detailed description, A' is deemed to be A) is amended. During this examination, an examiner discovers prior art for equipment comprised of Constituents A+C and decides to issue the notice of grounds for rejection. In this case, an examiner shall issue the non-final notice of grounds for rejection, as this is related to novelty or inventive step in inventions of claims before amendments.

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Before Amendment	After Amendment
【Claim 1】: Constituent A' or B with C attached	【Claim 1】: Constituent A or B with C attached

(Example 2) Where having notifying the rejection ground to only a part of two or more inventions stated in a single claim, and then notifying the grounds for rejection to the remaining inventions afterwards, an examiner shall issue the non-final notice of grounds for rejection despite that the claim has been amended according to the notice.

(4) Where the grounds for rejection are established due to reasons other than amendments, an examiner shall issue the 'non-final notice of grounds for rejection'.

For example, when issuing the first notice of grounds for rejection, no defects had been found in terms of legal competency as a foreigner. However, after amendments, a foreigner loses the right to enjoy patent according to Article 25 of the Patent Act, this ground for rejection is not generated according to amendments. Therefore, this is issued as the non-final notice of grounds for rejection.

5.3.2「Final Notice of Grounds for Rejection」

Where the ground for rejection incurs from amendments corresponding to the notice of the grounds for rejection having been noticed to an applicant, an examiner shall deliver the final notice of grounds for rejection. In other words, an examiner shall issue the final ground for rejections where a rejection ground which had not been exist or does not need to be examined prior to amendments, is caused newly or requires an examination after amendments.

Amendments according to the notice of ground for rejection having been issued previously are a prerequisite for the final notice of grounds for rejection. In other words, the final notice of grounds for rejection can be issued only when the written amendment has

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been submitted and a new rejection ground incurred in the amendment confirmation section.

Specific examples regarding the final notice of grounds for rejection are as follows.

(1) Where amendments of the description or drawings result in adding a new matter or exceeding the permissible scope of division or conversion.

(2) Where amendments of a claim that had been examined cause the ground for rejection regarding novelty or inventive step. However, where the invention of an amended claim has been stated in the other claim and the other claim has never been notified for this rejection ground, an examiner shall issue the non-final notice of rejection grounds.

(Example 1) In this below example, an applicant amends claim 1 corresponding to the notice of rejection ground (violation of novelty or inventive step) and remedies this ground. However where the addition of constituent D after amendment raises a need to cite a prior art including D, it is regarded as the rejection grounds incurring from amendments. The final notice of grounds for rejection is issued in this case.

If composition obscurity of inventions relating to constituents 'A and B' had been the ground for rejection, it would be the ground for reason having been existed before amendments of attachment D. Therefore, in this case, the final notice of grounds for rejection cannot be issued.

Before Amendment	**After Amendment**
【Claim 1】: Constituent A and B with C attached	【Claim 1】: Constituent A and B with D attached

(Example 2) Where a claim is expanded after amendments according to the notice of ground for rejection that is description deficiencies, and subsequently results in a violation of

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novelty or inventive step, an examiner is required to review prior art again by requesting amendments. In this case, an examiner shall issue the final notice of grounds for rejection despite the fact that both grounds for rejection (i.e. description deficiency and lack of novelty or inventive step, in the example above) are pertinent to the same claim.

(3) Where a newly generated claim or a substantially changed claim equivalent to newly-established claim contains grounds for rejection regarding novelty or inventive step. However, where the concerned claim is amended with an invention in another claim where notice of grounds for rejection has not been issued, an examiner shall issue the non-final notice of grounds for rejection.

(4) Where an examiner examines again after amendments and discovers grounds for rejection relating to novelty or inventive step in this amended claim which had not been examinable due to lack of clarity or addition of new matters to such claim.

5.3.3 Selection of Notice of Grounds for Rejection (Final or Non-final)

(1) Where an examiner discovers the ground for rejection after examining again, he/she shall issue the non-final notice of grounds for rejection unless all of the grounds for rejection fall under the final notice of grounds for rejection.

(2) Where uncertainty pertains to the selection between two types of notices of grounds for rejection, an examiner shall issue the non-final notice of grounds for rejection so that the applicant's opportunity of amendment may not be unreasonably limited.

5.4 Examination on a Claim-by-claim Basis

5.4.1 Purpose

An examiner examines an application filed for in compliance with the requirements of patentability. Even if only a single ground for rejection lies in an application, a patent shall not be granted based on that application. Therefore, where an examiner notifies grounds for rejection regarding an application comprised of two or more claims without full disclosure of specific reasons for each claim, an applicant, having difficulties in identifying which claim can be remediable, sometimes fails to acquire legitimate rights for claims that might have been

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patentable if identified.

Under the examination system by each claim, when notifying the ground for rejection regarding an application comprised of two or more claims, an examiner shall stipulate the concerned claim containing ground for rejection as well as the corresponding ground with more specific explanations. This enables an applicant to respond an examiner's notice without much difficulty by allowing an applicant to easily identify a claim to be deleted or amended.

5.4.2 Instructions for Written Notice of Ground for Rejection

A written notice of grounds for rejection shall include [Examination Outcomes], which is comprised of 「Claims to be Examined」, 「Relevant Provision regarding Grounds for Rejection」, 「Patentable Claims」 and [Specific Grounds for Rejection] for matters notified as grounds for rejection. Also, matters, which are not grounds for rejection but still useful for applicant's response, can be included in 「Considerations in Amendment」. Specifics for each part are as follows:

(1) 「Claims to be Examined」 stipulates the number of claims to be examined as of the date when a written notice of the grounds for rejection is prepared.

(2) 「Relevant Provisions regarding Grounds for Rejection」 specifies claims containing the grounds for rejection and its relevant provisions of the Act. If the ground for rejection is not directly related to claims, the matters containing the ground for rejection are stated herein.

Where an amendment adds new matters or is not made within the prescribed scope of a divisional or converted application, the matters either newly added or fallen out of the scope of a converted or divisional application shall be stated as grounds for rejection.

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※ Example

No	Matters Notified as Grounds for Rejection	Relevant Provision in the Patent Act
1	Detailed description of the invention	Article 42 (3)**(i)** (deficiency in detailed description)
2	Claims 6 - 8	Article 42 (8) (manner of describing the claims)
3	Claims 10 - 14	Article 45 (scope of a single patent application)
4	Claims 1, 4 and 6	Article 29 (2) (inventive step)
5	Detailed description, Claim 15	Article 52(1) (scope of divisional application)

(3) 「Patentable Claim」enumerates all claims that are not identified as the ground for rejection upon its notice.

Exceptionally, even if a claim itself has not been identified as the ground for rejection, however, the claim which falls under the following cases may not be stated under 「Patentable Claim」; where a special circumstance makes it difficult to assess patentability regarding the concerned claim upon the notice of the ground for rejection, or where a claim is judged not to be patentable due to not the claim itself but other grounds related to such claim. In this case, the reason for not-stating patentable claims shall be explained in the「Considerations in Amendment」. This is designed to help an applicant to respond to the notice of the ground for rejection without difficulties, where an examiner clearly discloses his/her opinion about the concerned claim.

It is noted that 「Patentable Claim」is not an examiner's final decision. It is only a decision at the point when the notice for the ground for rejection is issued. Therefore, where a new ground for rejection is discovered afterwards, an examiner shall notify the ground for rejection again without binding to his or her previous decision. Also, even if an examiner states that a part or whole claims can be patentable, he/she may make a final decision to reject where any of the grounds for rejection is not solved after an applicant's response.

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(4) 「Specific Grounds for Rejection」stipulates more specific reasons for matters notified as the ground for rejection, which enables an examiner to inform the ground for rejection without difficulties.

Where an examiner notifies the grounds for rejection an application involving two or more claims, he/she firstly indicates claims involving the grounds for rejection and states the specific grounds according to the claims. More specifics are as follows:

① An examiner shall specifically state to inform the grounds for rejection for each claim. To avoid redundant statement, an examiner may just indicate the aforementioned ground or collectively inform grounds regarding claims sharing practically the same ground for rejection.

② Where an examiner stipulates the grounds for rejection by comparing the cited invention with the claimed invention, he/she shall specifically indicate which parts of the cited invention is considered in the comparison with the claimed invention. Where a multiple number of cited inventions are compared to each other, an examiner shall select the closest cited invention among them, and describe technical features of the closest cited invention that corresponds to the claimed invention. Then, the examiner points the difference between the claimed invention and the closest cited invention, and states technical features of other cited inventions which supplement such difference, along with his or her assessment regarding patentability with taking the common general knowledge into consideration.

③ An examiner can directly specify a cited invention pertaining to the claimed invention, and may describe differences and his or her assessment regarding inventive step. In this regard, such specification of the cited invention shall be made in a manner that an applicant can easily understand the corresponding relations with the claimed invention.

④ Where identifying the grounds for rejection in terms of novelty or inventive step, the grounds for rejection for independent claims and those for dependent claims are separately stated. As for the grounds for rejection, an examiner may state as simply as to indicate corresponding matter of cited invention to features added or limited to the dependent claim, or indicate his or her assessment on the difference between the cited invention and the dependent claim based on common general knowledge.

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Except for special cases, the grounds for rejection of dependent claims are deemed to include all the grounds identified in claims (including independent and dependent claims) which are cited by such dependent claims.

⑤ Where considered necessary for comparing the claims and the cited invention, a component comparison table disclosed below can be prepared to show the relations between distinguishing technical components of the claimed invention and its corresponding features of the cited invention. An examiner can add in the table where the corresponding features are written in the cited document. When using the comparison table, an examiner may add his/her judgment regarding differences between the claims and the cited inventions either within the table or below the table, which enables an applicant to understand the comparison results without difficulties.

※ Examples

(1) Component Comparison Table and Assessment

Claim 1	**Cited Invention 1** **Publication in Patent Gazette No.○○-○○○○**	**Cited Invention 2** **US Patent No.○○○○○○**
A(Constituent1)	A (location of its description)	
B (Constituent2)	B (location of its description)	
C (Constituent3)		C' (location of its description)

The invention in claim1 is different from cited invention 1 because claim 1 has constituent 3 as shown above. However, C in constituent 3 is practically the same as C' in cited invention2. C' in cited invention 2 can be easily combined with A and B in cited invention1 by a person with ordinary skill in the art which the concerned technical subject matter pertains to. Subsequently, the invention in claim 1 can be easily invented by a person with ordinary skill in the pertinent art by using cited invention 1 and 2.

(2) Component Comparison Table and Assessment

Claim	**Cited Invention 1**	**Cited Invention2**

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		US Patent Publication No. ○○-○○○○	US Patent Publication No. ○○○○○○
Claim1	A(Constituent1)	A (location of its description)	
	B(Constituent2)	B (location of its description)	
	C(Constituent3)		C' (location of its description)
	Judgment	C in constituent3 is practically same as C' in cited invention 2. As A and B in cited invention 1 are easily combined with C' in cited invention 2, claim 1 can be invented without difficulties using cited 1 and 2.	

(5) 「Considerations in Amendment」states matters, which are not the grounds for rejection but those are useful to be referred for an applicant to easily respond the notice of the ground for rejection. For example, an examiner's opinion about the description, reasons not putting the claims (not notified as the ground for rejection) into the patentable claims, and other considerations for amendments except for the notified grounds for rejection shall be disclosed.

(Note) If an examiner intends to use the contents in「Considerations in Amendment」as the grounds for rejection, he/she shall make notification of the ground for rejection again.

5.4.3 Preparation of Written Decision of Rejection

A written decision of rejection is prepared with the same method as a written notice of grounds for rejection, except that 'a matter notified for the ground for rejection' in [Examination Outcomes] is replaced with ' a matter where the ground for rejection is not overcome'. Where a written statement of argument and a written amendment in response to a notice of grounds for rejection are not submitted, an examiner may not separately state [Examination Results] and [Rationale for Decision to Reject].

(1) 「Claims to be Examined」illustrates application numbers in the description which is subject to a decision to reject the application.

(2) 「Relevant Provisions for Matters Where Grounds for Rejection Not Overcome」states matters where grounds for rejection are not overcome and accordingly the decision to reject

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the application shall be made and their relevant provisions of the Act shall be disclosed.

Where a new claim is added but it still includes the already-noticed ground for rejection, it is considered that an opportunity for written argument has been given and then it is stated as matters where grounds for rejection are not overcome, provided however that a claim whose grounds for rejection have been notified before amendments and a newly added claim shall be same.

※ Examples

No	Matters Where Rejection Grounds Not Overcome	Relevant Provisions
1	Detailed description in claimed invention	Article 42(3)**(i)** (deficiency in detailed description)
2	Claims 1, 4 and 6	Article 29 (2) (inventive step)

(3) 「Patentable Claims」stipulates both claims where no grounds for rejection are notified and claims where the having-notified grounds for rejection have been overcome during the examination. Exceptionally, however, an examiner may not indicate patentable claims in the following cases; where a judgment for patent requirements is not made in the claim due to some certain reasons including an addition of a new claim, where an examiner discovers new grounds for rejection in the claim incurring from an amendment, or where the claim is judged to be unpatentable as it is related to other grounds for rejection.

Likewise, where a claim, which has not been notified as the ground for rejection, is not stipulated as patentable claim, an examiner shall explain a reason in「Considerations」. By doing so, an examiner can clarify his/her opinion about a claim which is not included as a patentable claim despite the fact that it contains no ground for rejection. This clarification helps an applicant in his or her response to an examiner's decision to reject a patent as follows: where an applicant requests for a reexamination by submitting the written amendment, an applicant may delete claims excluding patentable ones. Where an examiner judges that there are no patentable claims as of the time for decision to reject a patent, no entries are made in「Patentable Claims」.

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(4) 「Grounds for Decision to Reject」writes more specific rationale regarding the ground for rejection that have not been overcome, in order for an applicant to better understand. Where the ground for rejection is related to a claim, an examiner shall specifically state reasons for rejection by the category of each claim. If the same reasons had already been notified in the written ground for rejection, an examiner may avoid redundant statement by indicating its source, instead of stipulating the same reason herein again.

Where both a written argument and an amendment are submitted together, an examiner shall state reasons for why applicant's amendment does not overcome the ground for rejection and why the arguments made by an applicant cannot be admitted. In such case, for claims without practical amendments or for dependent claims without direct amendments, just a statement of 'the ground for rejection having notified is not overcome' would be sufficient.

Where only a written statement of argument is submitted without a written amendment, an examiner states the reasons why he/she denies an applicant's argument along with matters containing unresolved grounds for rejection.

(5) 「Considerations in Amendment Submission」states issues that are not the ground for rejection but can be referred upon submitting the written amendment in subsequent procedures such as a request for reexamination.

For example, where a decision to reject the application is rendered due to the previously-notified grounds while new grounds are also produced from addition of claims or an amendment, such can be added in 「Considerations」.

5.4.4 Instructions for Examination on Claim-to-claim Basis

(1) Even if the detailed description has deficiency, claims, which seem to relate to such deficiency of the detailed description but do not contain any grounds for rejection themselves, can be classified under [Patentable Claims]. However, it does not apply for some exceptional cases where it is difficult to make a judgment about patentability of a claim upon the notice of the ground for rejection, provide however that a claim is related to the ground for rejection in the detailed description having been notified, or where an examiner

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judges that any amendment by an applicant cannot remedy the ground for rejection in the detailed description. In such case, in「Considerations in Amendment Submission」, an examiner shall describe why he/she does not include such claims as patentable claims.

(2) Where a claim cites another claims where the violation of Article 42(4) provides the ground for rejection, an examiner shall pay special attention to whether or not the citing claim continues to have such ground for rejection of a cited claim. If adjudged to still have the ground for rejection of a cited claim, it is stated that a citing claim has the same ground for patent rejection as a cited claim. However, where a cited claim violates only the manner of describing the claims stipulated in Article 42(8) of the Patent Act and Article 5 of the Enforcement Decree on the Patent Act, it is stated that only a cited claim has the ground for rejection due to a violation of description manner.

(3) Where an examination is performed on an application involving two or more groups of inventions, an examiner normally considers the requirement for patentability regarding the inventions falling under at least one group. Therefore, when pointing out a violation of unity of invention as the ground for rejection, an examiner shall indicate claims in another group rather than the group whose patent requirements such as novelty and inventive step have been evaluated.

Also, an examiner includes claims without grounds for rejection under the [Patentable Claims] among claims falling under the group (where inventions in this group have been evaluated in terms of the patent requirements). On the other hand, if an examiner found grounds for rejection regarding novelty and inventive step for those claims, he or she shall notify the ground for rejection together with grounds for rejection regarding unity of invention for the claims in the other groups.

Where considered necessary to notify lack of unity before anything else from the perspective of examination efficiency, an examiner shall state in 「Considerations in Amendment Submission」 that he/she has not performed the patent requirements test for the invention with no ground for rejection, though it is subject to the group (where inventions subject to this group have been evaluated whether to satisfy their patent requirements). An examiner shall not include this claim in the「Patentable Claims」.

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5.5 Disclosure of Information on Prior Art Documents

Where an examiner prepares the ground for rejection in relation to the technical subject matter of a claim, he/she shall cite supporting documents for his/her rationale. Disclosure methods for information on prior art documents, which are not decided in this section, shall comply with WIPO Standard ST.14.

5.5.1 Citation of Patent Documents

(1) Where citation documents supporting the ground for rejection are patent documents, the cited patent documents shall be clearly stated in the order of publishing country (can be omitted, if Korea), title of patent documents, document number (laid-open number), and publication date (public disclosure date, if published in patent gazette).

Title and document number are stated the same as they are in the concerned patent documents. Specific examples can be found in the following table.

Publishing Country	Examples of Citations
Korea	Registered Utility Model Gazette No.oo-oooo(19××. ×. ×.) Published Patent Gazette No.oo-oooo-oooooo(19××. ×. ×.) Published Utility Model Gazette No.oo-oooo(19××. ×. ×.) Registered Patent Gazette No.oo-oooo(19××. ×. ×.)
US	US Patent No. US ooooooo (20××. ×. ×.) US Patent Application Publication No. US oooo/ooooooo (20××. ×. ×.) US Patent Abstract No. US ooooooo (19××. ×. ×.)
Japan	JP Patent Gazette A No.ooooooo(20××. ×. ×.) JP Registered Utility Model Gazette U No.oooooo(20××. ×. ×.) JP Published Patent Gazette AH No.oo-oooooo(19××. ×. ×.) JP Published Patent Gazette A No.2000-oooooo(20××. ×. ×.) JP Published Model Utility Gazette S No.oo-oooo(19××. ×. ×.)
UK	UK Patent Publication No.ooo Abstract (class ooo)(19××. ×. ×.)

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	UK Patent Publication No.ooo Abstract(Group ooo)(19××. ×. ×.) UK Patent Publication No.ooo Abstract(Heading ooo)(19××. ×. ×.) UK Patent Publication No.ooo(19××. ×. ×.) ※ In case of citing an abstract of the description, the classification of abstracts shall be stated in parenthesis ('class' refer to abstracts before 1930, 'Group' refers to abstracts from 1931 to No.940,000, 'Divisions' refer to abstracts from No.940,001, and 'Heading' is a sub-category of 'Divisions')
Germany	DE Patent No.oo-ooo(class oo)(19××. ×. ×.) DE Patent Application Publication No.oo-ooo(class oo)(19××. ×. ×.) DE Patent Application Publication No.oo-ooo(19××. ×. ×.) ※ The description of patent in Germany is classified with 'class' for the patent document published in 1955 (No. 624,334 - No. 655,806) and after 1957, which shall be stated in parenthesis. ※ The published description of patent application in Federal Republic of Germany(West Germany) has been published from January 1, 1957 (No.1,000,001). The description published between 1959 and 1960(No.1,048,241-No.1,096,300) is classified with 'class' , which shall be stated in the parenthesis.
Int. Application	International Publication WO78/ No. oooooo (19××. ×. ×.)

(2) When patent documents are cited for the grounds for rejection, an examiner shall clearly state which part of the documents are used for citation by using No. of page or drawings in the parenthesis as follows:

(Example) Published Patent Gazette No.oo-oooo-ooooooo(19××. ×. ×.) (No. of page and drawing)

Published Patent Gazette No.oo-oooo-ooooooo(19××. ×. ×.) (Speed Reduction Gear)

Published Patent Gazette No.oo-oooo-ooooooo(19××. ×. ×.) (Drawing No. a, b, c)

5.5.2 Citation of Non-patent Documents

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(1) Depending on periodical publication, non-patent documents are cited as follows:

Type	Citations Instructions
Periodicals, Non-Periodicals	(i) Order of description when citing publications is as follows; Name of Author, Title of Thesis, Title of Publication. Location of Publication: Publisher. Publication Date, Number of Volumes, Number of Issues, Page No. Name of Author, Title of Thesis, and Title of Publication shall be discerned using a period (.), while Location of Publication and Publisher is distinguished using a colon (:). Put a period(.) after Publisher. Others are divided using a comma(,). (ii) Title of publication is generally not stated in abbreviations. (iii) Number of volumes and issues are stated as 'Volume oo, No.oo'. For English publications, 'Vol. oo, No. oo' (iv) Where publication date can substitute a number of volume, the statement of volume and issue numbers can be omitted. (v) Publication date herein refers to the publication date inscribed on the documents. Where publication date in the documents do not inscribe a publication day, then month/year of the publication is sufficient. (vi) For unclear publication date, the date of obtaining the documents can be stated instead, with a clear explanation for the reason. (vii) For a publication with no concerns for misunderstanding of its publisher, name of publisher can be omitted. (viii) Where a location of publication is not well known place, its country shall follow right after the location, which is distinguished with comma (,). For publications published in Korea, the location of publication is omitted. (ix) Name of author and title of thesis if considered unnecessary can be omitted. (x) Pages in publications of periodicals or non-periodicals are indicated with the consecutive number of volumes. If the consecutive number is not indicated, the page number of the concerned issue is cited using 'pp' in front of numeral. Where citation involves plural pages, hyphen (-) shall be used between the first page and the last page number if they are consecutive pages, while comma (,) is used for discontinuous pages. (xi) Title of publication is written in the style of italics. For a publication translated in foreign languages, it is principle to write an original language with Korean in the parenthesis.
Books	(i) Name of Author(or Name of Editor). Book Title. Location of Publication: Publisher.

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	Publication Date, Number of Volume, No. of Edition, and No. of Page is the order for book citation For a translated book, Name of Author (or Editor), and Name of Translator are the description order. (ii) Name of Author and Book Title shall be discerned using a period (.), while Location of Publication and Publisher is distinguished using a colon (:). Put a period(.) after Publisher. Others are divided using a comma(,) (iii) For a lecture, collective works, or series, title of lecture or series and the number of volumes in collective works shall be stated before book title. (iv) Book title is written in the style of italic. (v) Number of edition if not indicated on the book can be omitted. (vi) Where location of publication is not well-known, its country shall follow right after the location, which is distinguished with comma (,). For a book published in Korea, the location of publication is omitted. (vii) Page Number, is stated page number with 'pp.' before numerals. Where citation involves plural pages, the rules for periodicals shall be complied with.

(2) Where a part of publication is cited for the grounds for rejection, in order to clearly stipulate which part of document is used for the ground of rejection, page number or drawing number shall be included in parenthesis.

(Example) Journal of Korean Chemistry Society. Corporation, Korean Chemistry Society. 19××.×.×., Vol.o, No.o (pp. o or pp. o)

Hong Gil-dong. Steam Engine. Daejeon: oo Publication Co. 19××.×.×., Edition o (pp. o)

5.5.3 Citation of Electronic Documents

Where citing electronic documents searched from CD-ROM, the internet, or on-line DB, an examiner shall state the general information of the cited documents along with types of search medium (state in a brace), search date (state in a brace after the publication date of the cited documents) and search site.

(Example) Joint Authorship of 3 including Hong Gil-dong and et al. Method to Promote

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Search Speed through Effective Management of Patent Documents. Korean Association of Computer, [online], February 2001, [Search on July 15, 2010], Internet: <URL: http://www.kipo.go.kr/papers>

6. Instructions for Written Argument and Others

6.1 Extension or Reduction of Designated Period

Where the Commissioner of KIPO or an examiner designates the period for a patent procedure, he/she may, upon request shorten or extend the period (hereinafter 'designated period'), or extend the period *ex officio*. In such cases, the Commissioner of KIPO etc. shall decide whether to shorten or extend the period in a way that does not unlawfully violates the interests of the interested parties involved in the relevant procedure.

6.1.1 Extension and Approval of Designated Period for Substantive Examination

(1) The extension of the designated period pursuant to Article 16 of the Enforcement Decree of the Patent Act can be requested once or twice a month. Where a request for extension period is less than one month, it is regarded as one month extension.

Except for the period designated for submission of a written argument in response to the notification of ground for rejection (hereinafter 'period designated for written argument submission), a request for period extension is deemed to be approved on its request date. However, even in this case, an examiner may approve the extension request to a partial period if considered necessary and disapprove the remaining period if considered unlawfully violating the interests of the interested parties. For the disapproved remaining period, an examiner shall deliver a warning notification for disapproval in the period extension.

(2) Where a request for extending the period designated for written argument submission is filed and the expiry date in the extended period is within four months from the original expiry date having been designated in the written notification of ground for rejection (hereinafter 'period designated for extension request'), the request for extension is deemed to be approved on its request date. However, if the designated period for extension is

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beyond the prescribed period, an examiner reviews request reasons and approves the request if considered necessary.

Where an expiry date of the extended period (designated for written argument submission) arrives later than the period designated for extension request, an examiner shall approve the extension up to expiry date of the period designated for extension request. For the remaining period, an examiner shall review reasons for extension request and approves if considered necessary as follows. After approving the period extension, an examiner delivers to a written notification to a requester where he/she explains his/her purport of approval decision and informs that an additional period extension afterwards can be requested through a petition with additional reasons.

① Where an applicant elects an attorney for the first time or discharge or change an attorney within a month from the period expiry date

② Where an applicant submits a form to change applicants within a month from the period expiry date, only when new applicants are added.

③ Where an applicant receives patent examination outcomes from foreign patent offices within two months from the period expiry date and submits the period extension request along with the aforementioned

④ Where a delivery of the written ground for rejection is delayed more than one month

⑤ Where an original or later application is pending on a trial or a litigation

⑥ Where considered necessary for testing or evaluation of test results related to the ground for rejection

⑦ Or other cases where considered unavoidable to extend the period

※ Where the period extension request is filed on an application by third party, request reasons of ① ~ ⑤ are not admitted.

(3) Where fees for period extension request are not paid, an examiner shall request an applicant to pay within a time limit (determined by an examiner). If paid within the time limit,

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the extension request is regarded as valid. However, if not paid within the time limit, an examiner invalidates the extension request. This guideline applies for both the statutory period and the period designated for substantive examination.

(4) Where a request for period extension is made after the period designated for substantive examination (or the extended period, if a request for extension having been made is approved), an examiner gives an applicant with an opportunity to petition and returns the request afterwards. In such case, the fees paid upon filing the extension request are refunded.

(Note) Fees shall be refunded where a request for period extension is rejected.

6.1.2 Extension and Approval of Period Designated for Formality Examination

(1) The period designated for amendment according to Article 46 of the Patent Act, can be extended several times for the minimum period of a month or longer upon request. Where a request for extension period is less than one month, it is regarded as one month extension.

(2) The period available for extension shall not exceed more than four months in total. However, a further extension can be made if considered necessary as follows; where reasons not liable for an applicant take place or where an international patent applicant enters domestic stage.

(3) Where an extension request does not exceed four months and the concerned fee has been paid, the request for period extension is deemed to have been approved upon filing. For a request for four-month extension, a forewarning of "no further extension will be approved afterward" attached to the written approval shall be notified of an applicant.

If an applicant makes another extension request afterwards, it shall be rejected.

(4) Where an applicant makes an overdue requests for an extension of the period designated for formality examination (or extended period, if the extension request is approved), an examiner shall provide an opportunity for petition to an applicant and return the request form. At this time, an examiner shall refund too, along with the request form.

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(Note) Fees shall be refunded where a request for period extension is rejected.

6.1.3 Reduction of Designated Period and Others

(1) The period for a patent-related procedure having been designated can be reduced according to a request. Where a request for period reduction is made or where a written amendment or description stipulating the purport to reduce the designated period is submitted, the designated period is deemed to have been expired as of the submission date of a reduction request form or a written amendment.

(2) Any person can request to extend the period for requesting for a trial against to reject a patent (a utility model) application only for once and for up to 30 days. However, the number and the period of extension may be further extended for a person residing in an area that is difficult to access. When such request is made, the President of IPT (Trial Policy Division) shall review the requirements and determine whether it is approved or not.

(3) Where the written amendment for specification or drawing(s) is submitted after the designated period, it shall be returned by reason of overdue submission. However, an amendment of application as to formalities shall be admitted anytime before invalidation.

6.2 Instructions for Written Argument

(1) Where a written argument is submitted along with an amendment, an examiner shall review both of the argument and the amendment in depth and determine as to whether the notified grounds for rejection can be overcome or not based on such argument and amendment. Also, where only a written argument is submitted without an amendment, an examiner shall consider sufficiently an argument to determine as to the notified grounds for rejection can be overcome or not.

(2) A written argument or other documents including experiment results in response to the notification of the grounds for rejection shall not be a part of the specification of the application. However, as these documents are submitted to clarify or verify the legitimacy of matters in the detailed description, an examiner may refer them to decide the patentability of the concerned application.

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(3) Where an amendment is submitted after the period designated in the notification of the grounds for rejection shall be return to an applicant. However, as for a written argument, it does not fall under cases not to be admitted (the Enforcement Rules of the Patent Act Article 11(1)), an examiner may admit it reference.

(4) Where an applicant insists matters to be amended in a written argument but fails to submit an amendment, an examination shall be made on the detailed description and claims upon the notification of the ground for rejection. Also, where contents of amendments having insisted in a written argument and the actual amendments show discrepancy, an examination shall be made based on the actual amendments to the detailed description and claims. However, where the matters to be amended are disclosed only in the written opinion, not in the amendment, indicating that certain requirements are met, the examiner may re-notify the same ground for rejection at his/her discretion. (See Part 5, Chapter 3, 「5.2 Rejection without Additional Notice of Grounds for Rejection」(5))

6.3 Treatment of Amendments

6.3.1 Confirmation Method for Amended Specification

(1) Where multiple amendments are submitted voluntarily before any notification of the ground for rejection, each amendment is accumulatively reflected on the specification to be examined. Therefore, the final specification to be examined is determined automatically through the Patent Net (Internal examination supporting tool) after reflecting amendment to the specification, claims and drawings. An amendment to the full text of the specification shall be replaced as the final specification to be examined.

However, where multiple amendments are submitted to a single notification of the ground for rejection within the designated period, applications applied with the Patent Act before the revision (before the revision of Act no. 11654 on March 22, 2013) and applications applied with the revised Patent Act (Act no. 11654, Promulgated on March 22, 2013, Taken effect on July 1, 2013) shall be handled differently as in the following manners:

ⅰ) As for applications filed before June 30, 2013 and applied with the Patent Act before the revision, where multiple amendments are submitted to the initial ground for rejection within

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the designated period, each amendment is accumulatively reflected to determine the final specification to be examined. Where multiple amendments are submitted to the final ground for rejection within the designated period, the amendments approved by the examiner among all the amendments are accumulatively reflected to determine the final specification to be examined.

ii) As for applications filed after July 1, 2013 and applied with the revised Patent Act, where multiple amendments are submitted to a ground for rejection within the designated period, all amendments submitted before the final amendment shall be deemed to have been withdrawn according to Article 47(4) of the Patent Act. Therefore, the final specification to be examined shall be reflected only with the lastly-submitted amendment.

As for applications filed before June 30, 2013 and applied with the Patent Act before the revision, the methods of determining the specification to be examined in the case of submission of multiple amendments to the ground for rejection within the designated period are as follows:

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(Example) Method to determine the specification to be examined where the 1st and 2nd written amendment having been submitted within due time.

Matters to be Amended	Initial Application	1st Written Amendment	2nd Written Amendment	2nd Amendment	2nd Amended specification	1st Amended specification
Detailed Description	◇	◆		◆	◆	◆
Claim 1	○	●		●	●	●
Claim 2	□	▒	■	■	■	▒
Claim 3	△				△	△
-						
Claim 10	☆				☆	☆
Drawing(s)	♤	♠		♠	♠	♠

※ As seen in the above example, where an applicant amends detailed description, claim 1, claim 2, and drawing(s) of a claimed invention in the 1st written amendment and submits the 2nd written amendment with claim 2 amended. the 2nd amendment is determined to be a combination of final amendments individually made in claim 1 and claim 2 ((Detailed Description(◆), Claim 1(●), Claim 2(■) and Drawing(s)(♠)), and the 2nd amended description is determined to be a combination of matters not amended in the 2nd amendment and an original description. (Detailed Description(◆), Claim 1(●), Claim 2(■), Claim 3(△), ...Claim 10(☆) and Drawing(s) (♠)).

(2) Where an amendment in response the final ground for rejection or made upon the request for reexamination is dismissed pursuant to Article 52(1) of the Patent Act, an examiner considers the amendment deemed to have never been submitted. The dismissal of amendment shall be referred to this section in 「11. Amendment in Response to Final Notification of Ground for Rejection」.

6.3.2 Additional Matters to be considered

(1) A self-amendment submitted before examination starts and an amendment in response to the non-final notification of grounds for rejection within the period (designated for

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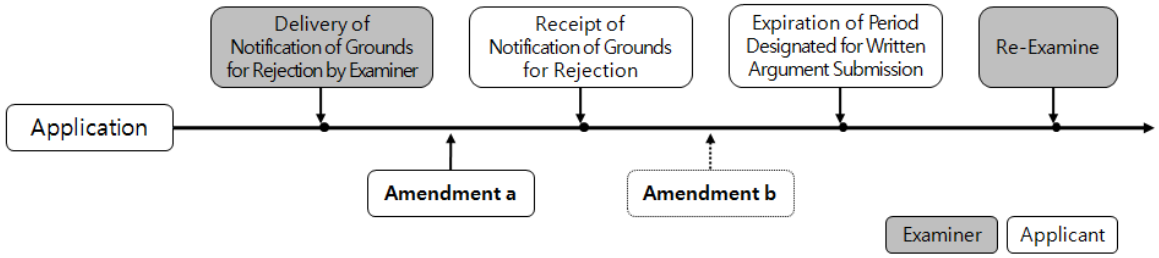
submission of a written argument) are recognized as submitted. However, as for applications filed after July 1, 2013, where amendments to the ground for rejection are submitted more than twice within the designated period, all the amendments submitted before the final amendment shall be deemed to have been withdrawn.

(2) An applicant may self-amend during the period between the delivery of the ground for rejection by an examiner and its receipt by an applicant. To expedite an examination proceeding, where an applicant submits an amendment during the period between an examiner's sending of the grounds for rejection and an applicant's receiving of it, the notification of the ground for rejection having delivered shall not be cancelled but be treated as follows.

Where a date of applicant's receipt of the grounds for rejection, which can be confirmed by the special mail (parcel) registered receipt, is the same as a date of amendment submission, an amendment is regarded as being submitted earlier than receiving the ground for rejection unless there is an evidential basis for the fact that a notification delivery precedes amendment submission. Where a written amendment identifies a delivery number of a notification for rejection ground, the notification delivery is regarded to be earlier than amendment submission.



① Where just Amendment a is submitted

An examiner shall examine again the specification that have been reflected of Amendment a.

(a) Where an examination of the amended specification discovers no ground for rejection,

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an examiner shall decide to grant a patent.

(b) Where an examination of the amended specification still discovers a ground for rejection that is not a newly generated by Amendment a but has been notified, an examiner shall decide to reject the application by reason that the amendment fails to overcome the ground for rejection.

(c) Where an examination of the amended specification discovers that the grounds for rejection having been notified are overcome but a new ground for rejection is generated due to Amendment a, or where an examination of the amended specification discovers grounds for rejection that have been existed in the original specification prior to Amendment a but have not been notified previously, an examiner shall notify the non-final ground for rejection again.

② Where Amendment a and Amendment b are submitted

An examiner shall examine again the specification that have been reflected of Amendment a and Amendment b.

(a) Where an examination of the amended specification discovers no ground for rejection, an examiner shall decide to grant a patent.

(b) Where an examination of the amended specification still discovers grounds for rejection that are not a newly generated by Amendments but have been notified, an examiner shall decide to reject the application by reason that the amendment fails to overcome the ground for rejection.

(c) Where an examination of the amended specification discovers that the ground for rejection having been notified is overcome but a new ground for rejection is generated due to Amendment a, or where an examination of the amended specification discovers a ground for rejection that have been existed in the original description prior to Amendment b but have not been notified previously, an examiner shall notify the non-final grounds for rejection again.

(d) Where an examination of the amended specification discovers no ground for rejection

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but a ground for rejection incurring from Amendment b, an examiner shall notify the final ground for rejection.

6.4 Instructions for Reference Document in Examination

(1) If considered necessary to expedite an examination proceeding, an examiner may ask an applicant to submit documents and other references required for examination.

(2) Documents or other things required for examination are as followings.

① Related documents and their translations in the case of an international application as well as examination outcomes in other patent offices where its family application has been filed, if considered necessary.

② A written statement presenting each claim's technical subject matter with its corresponding detailed description by indicating paragraph number, and a written statement explaining relation among claims where an application involves enormous amount of detailed description and a vast number of claims.

③ A written statement summarizing gist of a claimed invention, where technical subject matter of a claimed invention is too complex to comprehend within the designated period.

④ Samples or experiment results, where effects of a claimed invention cannot be verified without them, provided however, the submission of samples or experiment results shall enable to confirm that the description has been definite and sufficient upon filing an application.

⑤ A written statement explaining a process of inducing the concerned formula and definitions and meanings of technical terminology or signs, where a formula, technical terminology, or sign is not clearly understood.

⑥ A written statement clearly explaining again an applicant's claim in the written statement of arguments, where an applicant's claim in the written statement of arguments is hard to understand and deemed to have serious impact on a decision for patentability.

(3) The request for documents required for examination shall be made under the name of

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an examiner in charge. He/she shall specifically clarify which document shall be submitted. The period designated for document submission falls within the period designated for submission of a written argument. To expedite an examination proceeding, an examiner may include his/her request for documents under 「Considerations in Amendment」 in the notification of the grounds for rejection.

(4) Even if an applicant fails to respond the document request by an examiner, an examiner shall not invalidate an application procedure.

(5) Documents submitted by an examiner's request are only used for reference material, which cannot substitute or supplement the description.

(6) Where receiving the documents or samples from an applicant, an examiner shall keep a document list and store documents or samples in a file wrapper if possible, or store them separately till the examination closes.

An examiner shall refer to the following with regard to documents or samples submitted.

① For documents or samples on return request by an applicant, an examiner shall pay special attention in storing them undamaged.

② Even for documents or samples with no return request, an examiner shall also pay special attention in storing them undamaged just where those documents or samples are requested in trial

③ An examiner commences a procedure to return them right after examination closes.

(Note) Where a person who has submitted documents or samples, intends to get them back, he/she shall state the purport to the return request form. After closing the examination, an examiner shall designate the return period and notify a submitter to receive the documents or samples within that period.

Where no request has been made for return of documents or samples, or where a submitter fails to go through return proceeding within the designated period, documents or samples can be disposed of as decided by the Commissioner of KIPO.

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(7) An examiner may use evidential documents submitted for information for his/her examination according to Article 63 bis.

Where it is certain that evidential documents are periodicals or their copies, or copies of description or drawing(s) having been published before the application date, an examiner may use them as prior art without additional examination of evidence.

Where evidential documents submitted are documents other than periodicals or their copies, or copies of description or drawing(s) having been published before the application date, an examiner may use them as prior art only if an examiner is confident of the fact to be verified without examination of evidence. However, where an applicant argues the existence of the evidential fact in the written argument, an examiner shall not admit the fact unless he/she finds its admission justifiable.

(Explanation) The Patent Act has no provisions regarding an examination of evidence during examination. Therefore, where the evidential documents submitted for reference information are documents other than periodicals or their copies, or copies of description or drawing(s) having been published but the fact to be verified cannot be confirmed with confidence, an examiner shall not decide to reject the application based on this evidence.

(Note) Except for an application which has been invalidated, withdrawn, or abandoned, or whose patent grant or rejection has been decided by an examiner, anyone can provide relevant evidence to an examiner to argue that an application of the claimed invention shall not be patented. Information provision can be made by any person or corporation, except for an incompetent minor who shall appoint a legal representative for such action. In the meanwhile, an examiner may refer documents or information provided by a group or association instead of invalidating or returning them.

7. Additional Search

During the examination stage, an examiner shall conduct additional searches for the following cases.

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① Where an examiner finds through the written argument, personal interview, or information provided that his/her incomplete understanding of claimed invention results in the incomplete search.

② Where amended claims include subject matters not covered by the original search.

③ Where an examiner intends to examine the claimed invention which has been excluded from the original search due to lack of unity of invention (i.e. a group of inventions that form a single general inventive concept).

④ Where an international patent application that can be regarded as another application in terms of Article 29 (3) enters the domestic stage and its translation is expected to be submitted.

⑤ Or other cases where considered necessary for additional research

8. Examination Deferral or Extension of Processing Period

(1) An examiner may defer an examination or extend the processing period within 2 months when an application under his/her examination falls under the following cases.

Note that examination deferral or period extension of processing period is not allowed when the Commissioner of KIPO or an examiner designates the processing period for the concerned application,

① Where an earlier application or conflicting applications is (or are) not laid open or request for an examination for the conflicting applications is not made.

② Where the period, during which an earlier application serving as a basis of domestic priority claim is deemed to have been withdrawn, has not elapsed.

③ Where a patent trial or proceeding related to the application concerned is pending.

④ Where the period extension for processing is required for the circumstances that

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search for prior art is outsourced to a specialized organization, that expert opinions are inquired, or that the examination with consultation needs to be carried out.

⑤ Where the period designated for submission of evidential documents for priority right in case of an application claiming priority under the treaty has not elapsed.

⑥ Or other occasions where considered necessary to defer examination start.

(2) Deferral of examination or extension of processing period shall be reported to the head of Examination Unit, and be notified to the concerned applicant.

(3) For an application whose examination or processing has been already deferred or extended respectively, an examiner shall review more than one time a month to confirm whether the reasons causing deferral or extension have been resolved or not.

Where the review confirms all reasons for examination deferral or extension of processing period have been cleared up, an examiner shall conduct the examination by the termination date of the extension of examination deferral or processing period.

(4) Where the examiner considers the examination to be deferred and the processing period to be extended again because the application does not overcome the previous deferral or extension reason or new deferral or extension reasons occur, it shall be reported to the head of the examination division (team) following a head of the examination unit, and the deferral or extension shall be made within two months.

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However, where the examination deferral or processing period is extended because prior art search is commissioned to a specialized institution, external consultation is sought or consultation examination is required or where it is deemed to necessary to defer examination on other grounds (④ and ⑥ among the grounds for examination deferral mentioned in (1) above), the examination deferral or extension of processing period can be extended again only in the case of causes not imputable to the examiner. Reasons not imputable to the examiner include where examination cannot be conducted because the prior art search report has not been delivered or where copies of the prior art literature are

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requested to external institutions, but have not been secured yet.

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(5) Where an examiner once again decides to defer the examination or extend the processing period according to the abovementioned case (4), he/she notifies the applicant specific reasons of deferral or extension.

(6) The case of 「③ Where a patent trial or proceeding related to the application concerned is pending」 among the grounds for examination deferral specified in (1) includes where the original application is pending in the trial against decision of rejection and a divisional application the same claims as the original application is requested for examination and the divisional application has the only ground for rejection under Article 36(2) of the Patent Act (conflicting against the original application).

If a ground for rejection under Article 36(2) of the Patent Act is notified to a divisional application when no opportunity of amendment is given to the conflicting original application, it might be possible that the applicant cannot make amendment to the ground for rejection and therefore, examination referral shall be deemed necessary. However, since the above-mentioned cases do not happen to grounds for rejection other than the one under Article 36(2) of the Patent Act, the examiner shall conduct the examination.

Specifically,

ⅰ) Where a divisional application has the only ground for rejection under Article 36(2) of the Patent Act, the examiner shall defer examination until the trial against decision of rejection on the original application becomes final and conclusive, without notifying the ground for rejection.

ⅱ) Where a divisional application has other grounds for rejection than the one under Article 36(2) of the Patent Act (the ground identical with the ground for decision of rejection of the original application, etc.), the examiner shall notify the grounds for rejection other than the one under Article 36(2) of the Patent Act. Where the notified grounds for rejection are not addressed, the examiner shall make the decision of rejection based on such grounds for

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rejection. Where all the notified grounds for rejection are addressed and only the ground for rejection under Article 36(2) of the Patent Act is left, the examiner shall defer examination until the trial on the original application becomes final and conclusive.

(Note) Requests of period extension for the ground for rejection mentioned in ⅱ) above, exceeding four times, also can be approved. It constitutes 「⑤ Where the period designated for submission of evidential documents for priority right in case of an application claiming priority under the treaty has not elapsed」 among the grounds for approval of period extension in 4.2, Chapter 3, Part 1.

The case where examination is deferred since it constitutes 「③ Where a patent trial or proceeding related to the application concerned is pending」 includes where the administrative trial · litigation on the concerned application procedure is pending.

(7) As for ① among grounds for examination deferral specified in (1), where more than two patent applications are filed on the identical invention, the examiner shall defer examination for subsequent applications until the prior application has been processed or has been laid-open or registered. However, where the subsequent application can be rejected based on the same ground as the ground for rejection for the prior application, the examiner can start examination. The detailed methods of starting examination for subsequent application are as follows:

Identicalness of Applicants of Prior/Subsequent Applications	Disclosure of Prior Application	Start of Examination on Subsequent Application
Identical	Laid-open	Examination conducted and Ground for rejection under Article 36(1) notified (Patentability determined after confirming claims of prior application)
	Not Laid-open	Examination conducted and Ground for rejection under Article 36(1) notified (Only application number of prior application and invention

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		disclosed in claims indicated, Patentability determined after confirming claims of prior application)
Different	Laid-open	Examination conducted and Ground for rejection under Article 29(3)(iv) notified (Article 36(1) applied when inventors are identical)
	Not Laid-open	Examination deferred until the disclosure of prior application

(8) When the prior application is examined or laid open or registered after examination on subsequent applications is deferred, the examiner may conduct examination on subsequent application. However, even though examination on subsequent application is conducted, the examiner shall make the final decision on examination in applying Article 36(1) of the Patent Act once the scope of claim of the prior application is determined.

9. Document Delivery

9.1 General Principles

(1) The documents shall be sent by registered mail except for the cases where the party or his/her attorney receives in person or uses information network. In case of sending documents by post mail, the registration receipt shall be kept.

(Note) A trial ruling or a written decision regarding a patent trial, retrial, or cancellation of a patent right shall be delivered by a special delivery method according to laws on postal service.

(2) The documents shall be delivered to a legitimate receiver, referring to an attorney if appointed, sub-attorney or attorney appointed midway except for special cases. The special cases herein refers to the occasion where a delivery is made to an attorney given no priority

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regarding notification, or where an attorney or the party goes through the procedure directly related to the examination such as a written statement of argument or an amendment (hereinafter the same shall apply).

In case of two or more agencies, except for special cases, a legitimate receiver shall be the attorney described first in a written patent application.

For a multiple number of attorneys with general power, documents shall be delivered preferentially to the attorney having appointed for the relevant case.

Where a receiver is incompetent, delivery shall be made to his/her legal representative.

Where two or more applicants involve in a patent application, delivery shall be made to a representative if elected, or to the applicant stated first in the written application if no representative is designated, except for special cases.

(3) The delivery of documents shall be made to residential or business address of a entitled receiver unless reporting other address for delivery. The change of delivery address shall be reported without delay.

(Note) Where a failure of delivery is due to rejection by a receiver without justifiable reason, the date of sending is regarded as a receiving date. More details regarding document delivery can be referred to 「Part 1 General Rules」.

9.2 Delivery by Public Notification

When documents cannot be delivered because the residential or business address of the addressee is unclear, the documents shall be delivered by public notification. 'residential or business address of the addressee is unclear' herein refers to the case where the address of the addressee cannot be verified even using the resident registration use system. It includes the case where two or more persons go through a patent procedure and all their addresses cannot be verified.

Delivery by public notification shall be made as follows.

① Where documents are returned, an officer in general affairs division of examination

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bureau shall file the facts regarding the document returns such as return number, reason of return to a computer system and communicate to an examiner in charge.

Where an examiner is notified of the aforementioned, he/she shall verify the address of a legitimate receiver by telephone, to which an examiner shall send again the returned documents and the "Guide to Report on Information Change in Applicant" with attachment of the form to report the change of applicant's information (i.e. Form(v) in the Enforcement Rules of the Patent Act).

② Notwithstanding the procedure in ①, where the address confirmed by the Resident Registration Use System is identical with the address confirmed by telephone, an examiner shall deliver documents by public notification. If not identical, an examiner shall deliver again the documents to the address confirmed by the Resident Registration Use System according to the procedure in ①.

③ Where documents were sent again to the address confirmed through the Resident Registration Use System but returned again, documents shall be delivered by public notification with no further procedure for address confirmation.

※ Where a receiver is a corporation, the Resident Registration Use System cannot be used. In this case, an examiner shall exert most available efforts to confirm a correct address of a corporation and send documents to a legal address at least once before public notification.

(Note) The delivery shall be made according to the Rules on Office Management and Patent Net System. However, an examiner may adopt a different delivery method where through case by case review an examiner finds a new delivery method for sure sending to a legitimate receiver.

10. Personal Interview

Where an applicant or his/her attorney (hereinafter 'the party') requests or where an examiner considers necessary for a prompt and fair examination, an examiner may have a personal interview with the party as ancillary method for examination. Cases requiring a

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personal interview are as follows; where considered necessary for comparative explanation between the claimed invention and the prior art, where clarification of the ground for rejection is required, where the written argument requires explanation for clear understanding, where the subject matter of the claimed invention is so complicated and sophisticated that its understanding is difficult, or others where an examiner recognizes a need for a personal interview.

10.1 Request and Grant for Personal Interview

(1) The party, seeking to have a personal interview, communicates the purport by fax, telephone, information network including e-mail, or a written application submitted in person on his/her visit to the patent customer service center. Where a request for personal interview involves a multiple number of applications, the party shall file an interview request individually for each application. However, if a multiple number of applications are assigned to the same examiner, an applicant may file an interview request for all applications only one time.

The request for a personal interview can be filed after an examination begins, but not later than the decision to grant a patent. However, for an application decided to be rejected, the party may request an interview till a trial against the decision to reject the application is filed.

(2) If considered necessary, an examiner may request and set a date for an interview in writing, by fax or telephone. An interview request by an examiner is allowed only when the telephone discussion is not sufficient to reconcile ideas between the examiner and the applicant.

The date of a personal interview designated by an examiner may change under agreement with the party. The change of an interview schedule shall be included in a personal interview log.

(3) Where the party requests for a personal interview, an examiner should respond actively. However, where the party makes just a plain business contact, questions about an examination progress, asks general questions about patentability, or requests a personal

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interview for the same application repeatedly or for other issues unrelated to the examination, an examiner may ask the party to modify the contents of an interview request or disregard such request aforementioned.

Where communicating with the party through telephone, fax, or e-mail regarding an interview, an examiner shall include dates and persons in communications, due date and form of an interview, and a contact number in the examination report in the Patent Examination Processing System.

10.2 Procedure of Personal Interview

(1) A personal interview is face-to-face. For a face-to-face interview, it is principle to use the meeting room located in the patent customer service center. For a video phone interview, the long-distance video conference room located in the Multimedia Center of KIPO Seoul Branch (13th Floor), the video conference room in KIPO, and other facilities available for video phone interview can be used.

(2) For a personal interview to be more smooth and effective, an examiner shall in advance review the relevant documents and print out them if necessary. If the prior contact with the party confirms a discussion topic, an examiner shall review and organize the related issues in advance.

If necessary, an examiner may request the party for reference documents including document or multimedia material related to prior art in advance.

(3) Before an interview, an examiner shall confirm whether a participant in an interview is a legitimate interviewee. The legitimate participant in a personal interview is a person who can respond with authority regarding the concerned application, which includes an applicant (a representative if corporation), an attorney of the concerned application, or a person with an evidential statement showing he/she is a legitimate entrustee appointed by an attorney, an applicant, or an attorney with the right to elect an attorney for him/herself (referred to sub-attorney).

A participant with delegation limited to a personal interview shall submit a corresponding proxy statement at every interview. However, a participant may combine delegations for

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multiple interviews into one proxy statement by stating all the application number on the one proxy statement.

A legitimate interviewee may accompany an inventor or a person related to a patent.

(4) In the interview log, an examiner shall state an application number, name of an examiner and participants, and contents and result of interview. The interview log, which is sealed with signatures of an examiner and participants, shall be submitted to an officer in charge at the patent customer service center. The contents of an interview shall be included in the examination report of the Patent Examination Processing System.

When an examiner and an interviewee exchange opinions regarding the restricted issues, the opinion exchanged shall be briefly stated in the interview log by the examiner.

10.3. Instructions of Personal Interview

(1) An examiner shall proceed to the procedure swiftly on a basis of personal interviews. Also, any agreements made during a personal interview shall be conducted within the shortest time possible.

(2) A personal interview shall not be a basis for an examiner to simplify or omit requisite statements in the notification of the ground for rejection or the written decision to reject a patent.

(3) Where an examiner discovers a new ground for rejection after a personal interview and therefore intends to deliver a measure contrary to the outcome from the interview, he/she shall communicate the purport to the party by the notification of the ground for rejection, telephone, fax or e-mail and continue the examination process.

(4) An examiner may request the party to submit materials presented at the interview.

(5) It is principle that a personal interview is held one time per application. If necessary, it can be held up to two times.

(Note) Where an interview is held within the period designated for the submission of the written statement of the argument, a participant shall submit the responding documents

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(such as the written statement of the argument, the amendment, etc) in accordance with the agreement at the interview. If an applicant decides respond differently from the agreement made at the interview, he/she shall communicate the purport to the examiner in charge by telephone, fax, e-mail, or post mail.

A personal interview shall not be a basis for an applicant to simplify or omit requisite statements in the written statement of the argument.

10.4. Personal Interview on Visit

(1) An applicant may make an on-line request for an examiner to visit his/her for communication (hereinafter 'personal interview on visit').

(2) For a request of personal interview on visit, an examiner contacts by telephone to determine a need for personal interview on visit. A personal interview on visit is allowed only if communication by telephone is difficult or if deems necessary for prompt and accurate examination.

(3) A personal interview on visit is in principle carried out in a 「Regional Intellectual Property Center」which is established pursuant to Article 23 of the Invention Promotion Act. However, in some unavoidable circumstances, the interview can be carried out in places other than the business site of the party under mutual agreement.

(4) For a personal interview on visit, when changing a date of a personal interview on visit and keeping an interview log, an examiner shall comply with the procedure of general personal interview.

11. Amendment in Response to Final Notification of Ground for Rejection

Unlike the non-final notification grounds for rejection, when receiving the amendment in response to the notification of the final grounds for rejection, an examiner shall determine whether to dismiss the amendment before assessing the requirements of patentability and confirm matters to be examined.

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When submitting the written argument, an applicant may argue that the notification of the final ground for rejection issued by an examiner is inappropriate as the final ground. Where such argument is made, an examiner shall review whether it was appropriate to set it to "the final notification of grounds for rejection", considering the applicant' assertion in the written opinion.

11.1 Remarks related to 'Final Notification of Ground for Rejection'

(1) Whether the final notification ground for rejection is appropriate or not shall be referred to 「5.3 Types of Notification of Grounds for Rejection」. Where an examiner judges that issuance of the final notification of grounds for rejection is deemed to be appropriate, he or she shall review whether amendment requirements are satisfied.

(2) On the other hand, where the issuance of final notification of grounds for rejection is deemed to be inappropriate, an examiner shall not dismiss but admit the amendment.

Where the grounds for rejection indicated in the final notification are not overcome, the examiner will take proper actions according to the following cases:

① Where no amendment is made or amendment is limited to response to the final notification of the grounds for rejection

Where an examiner notifies of final grounds for rejection but is supposed to notify of non-final grounds for rejection, and applicant submits the amendment only in response to the final notification of grounds for rejection (for example, amending by reducing the claim without adding a new claim) or fails to conduct amendment, an examiner shall notify grounds for rejection again instead of making a decision to reject the application, despite that the final grounds for rejection are not overcome. The type of the ground for rejection shall be decided with referral to「5.3 Types of Notification of Grounds for Rejection」.

② Where final grounds for rejection are notified to an applicant, but he or she makes an amendment with considering 'the final notification of grounds for rejection' as 'a non-final notification of grounds for rejection.'

Where an applicant, arguing the inappropriateness of the examiner's issuing the final

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notification of grounds for rejection, submits the amendment in response to non-final notification of grounds for rejection, an examiner shall make a decision to reject the application.

For example, where an examiner notifies the deficiency in the description (which should have been notified in the non-final ground for rejection) as the final ground for rejection, an applicant argues that the deficiency had been in the application having been filed first and submits the amendment where a new claim is added (recognized as the amendment according to the first ground for rejection). In this case, an examiner shall admit the amendment and make a decision to reject a patent application afterward if the amendment still fails to remedy the deficiency in the description.

11.2 Examination of Amendment

(1) Where an applicant in response to the final notification of the grounds for rejection submits a multiple number of amendments within the period designated for the submission of written argument, an examiner shall determine whether he/she admit or dismiss the amendments in reverse order of the submission.

(2) Where the amendment in response to the final notification of the grounds for rejection fails to meet the amendment scope prescribed in Article 47(2) and (3), or where new grounds for rejection occur from the amendment in response to the notification (the amendments by deleting claims according to Article 47 (3) (i) and (iv) are excluded), the amendment shall be dismissed.

Here, the occasion of「where new grounds for rejection occur from the amendment 」refers to the occasion where the submission of the concerned amendment causes unprecedented grounds for rejection (where the concerned amendment leads to the deficiency in the description or where a new ground for rejection regarding novelty or inventive step occurs). The new ground for rejection does not include the followings; the grounds for rejection which have been noticed prior to the amendment and the grounds for rejection which have existed without notification.

The judgment for the case 「where a new ground for rejection occurs from the

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amendment」 can be referred to the following examples.

(Example 1)

Claim 1 : Equipment comprised of A+B

[Final Notification of the Grounds for Rejection] Claim 1 is denied of inventive step due to cited invention1

[Specification after Final Amendment]

Claim 1 : Equipment comprised of A+b

(still denied of inventive step due to cited invention1)

[Amendment Admitted] Since no ground for rejection is generated from the amendment of claim 1, the amendment is admitted

[Decision to Reject] Claim 1(A+b) is denied of inventive step due to the cited invention1. The decision to reject a patent is made.

(Example 2)

Claim 1 : Equipment comprised of A+B

[Final Notification of the Grounds for Rejection] Claim1 is denied of inventive step due to the cited invention1

[Specification after Final Amendment]

Claim 1 : Equipment comprised of A+B+C

(Inventive step is admitted for the cited invention 1 but not for the cited inventions 1 and 2. The cited invention 2 is required additionally due to the addition of C)

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[Amendment Dismissed] The amendment of claim 1 generates a new ground for rejection. Therefore, the amendment is not admitted, resulting in the dismissal of the amendment.

[Decision to Reject] Claim 1(A+B) is denied of inventive step due to the cited invention 1.

(Example 3)

Claim 1 : Equipment comprised of A+B

Claim 2 : Equipment comprised of claim1 with C attached

[Final Notification of the Grounds for Rejection] Claim 1 is denied of inventive step due to the cited invention.

[Specification after Final Amendment]

Claim 1 : Delete

Claim 2 : Equipment comprised of claim1 with C attached

[Amendment Admitted] The amendment by deleting claim 1 is regarded as the reduction of scope of the claim. Though the deletion of the claim1 causes a new ground for rejection (i.e. deficient statement of claim2), this amendment is admitted according to Article 51 (1) of the Patent Act

[Final Notification of the Grounds for Rejection] Since the deletion of claim 1 in compliance with notification of the grounds for rejection causes the deficient statement in claim 2, an examiner shall notify this deficient statement of claim 2 in the final notification of the grounds for rejection.

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(Example 4)

Claim 1 : Equipment comprised of A+B

Claim 2 : Equipment of claim 1 with C attached

Claim 3 : Equipment of claim 1 or 2 with D+E attached.

[Final Notification of the Grounds for Rejection] Claim 1 is unpatentable due to conflicting applications

[Specification after Final Amendment]

Claim 1 : Delete

Claim 2 : (Amended) Equipment comprised of A+B+C

Claim 3 : (Amended) Equipment comprised of A+B+D+E

Claim 4: (New Addition) Equipment comprised of A+B+C+D+E

[Amendment Admitted] Claim 4 is just an arrangement due to the deletion of the claim1, and substantially corresponds to pre-amendment claim 3. Claim 4 is not newly added. Since the addition of claim 4 is inevitable due to deletion and the amendment is recognized as appropriate, the amendment is admitted.

(Example 5)

Claim 1 : Equipment comprised of A

[Final Notification of the Grounds for Rejection] Claim 1 is denied of inventive step due to cited invention1

[Specification after Final Amendment]

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Claim 1 : Equipment comprised of A+B

(Cited invention 1 includes B, denying inventive step in claim 1)

[Amendment Admitted] The rejection reason having notified is that the invention in claim 1 is denied of inventive step due to the cited invention1. Where the amendment does not generate new ground for rejection, the amendment is admitted.

[Decision to Reject] Claim 1(A+B) is denied of inventive step due to the cited invention1

(3) Regarding the satisfaction of amendment requirements, an examiner may make a judgment for the convenience of the examination procedure, disregarding the order of provisions in law, or the sequence of amendment matters. Details regarding the violation of amendment requirements shall be referred to this Part IV, Chapter 2.

(4) Where the amendment was deletion of claims and subsequently generated a new ground for rejection (due to the deletion of claims, the claim referring only to the deleted claim has deficiency in the description), an examiner shall not dismiss the amendment by reason abovementioned. Note that an examiner shall admit the amendment unless there are other reasons for amendment dismissal, and then notify the new rejection grounds at the final notification of the grounds for rejection.

However, where the amendment is made to delete the claim, if the claim referring to the deleted claim as well as other undeleted claims and the claimed invention is clearly understood when interpreted excluding the deleted claim, it shall constitute a clerical error, not a ground for rejection under Article 42(4)(ii). Therefore, it is not a new ground for rejection which is the subject for the withdrawal of the amendment. Also, it shall be subject to *ex officio* amendment rather than the subject for notification of the final ground for rejection even after approving the amendment (see Part 2, Chapter 4, 4.(4) for detail).

(5) The decision to dismiss amendment shall be made in writing separately from the decision to reject an application, specifying reasons why amendment had to be dismissed

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for the subsequent procedural convenience for an applicant.

(Note) An applicant cannot appeal against a decision to dismissal of amendment during the substantive examination, which can be dealt only in the trial against the decision to reject an application. When a reexamination is requested, a decision to dismissal of amendment made prior to the reexamination request shall not be appealed.

11.3 Examination after Admission of Amendment

(1) Where the amendment is appropriately made, an examiner shall admit the amendment and determine the specification to be examined after reflecting the amendment, which is followed by proper actions such as his/her assessment of requirements of patentability, its corresponding notifications and decision to grant or reject.

(2) Where the grounds for rejection are not overcome by the amendment, an examiner shall make a decision to reject an application. Otherwise, he or she shall make a decision to grant a patent.

(3) Where the notified grounds for rejection are overcome, but other grounds for rejection are generated, an examiner shall notify an applicant of these newly found grounds for rejection. The type of the ground for rejection shall be referred to 「5.3 Types of Notification of Grounds for Rejection」.

(Note) Where an examiner overlooks the fact that an inappropriate amendment in response to the final notification of grounds for rejection is made and then makes a decision to grant a patent or notifies first or final grounds for rejection, he/she cannot dismiss the previous amendment retroactively upon his/her discovery.

11.4 Examination after Amendment Dismissal

(1) After dismissing amendment, an examiner shall continue examining the pre-amended specification.

(2) Where reviewing the final notification of grounds for rejection and discovering the ground not overcome, an examiner shall make a decision to reject the application. Where an

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examiner regards the appropriateness of issuing the final notification of the grounds for rejection and discovers no other grounds for rejection, he/she shall make a decision to grant a patent.

(3) Where an examiner discovers inappropriateness of issuing the final notification of the grounds for rejection and also discovers other grounds for rejection, he/she shall notify grounds for rejection again. The type of the ground for rejection shall be referred to 「5.3 Types of Notification of Grounds for Rejection」.

12. Final Decision

Once completing the examination, an examiner shall make a decision to grant or reject without delay.

Where an examination of formalities discovers deficiency in application procedure (claims subsequent to application, application filing procedure, etc.), the final decision shall be made after the procedural deficiency is remedied.

12.1 Decision to Grant a Patent

(1) Where no ground for rejection is discovered, an examiner shall make a decision to grant a patent in writing with rationale attached.

The written decision to grant a patent shall include an application number, title of invention, name and address of applicant and attorney, the text of the decision of patentability and its rationale, and number of claims to be patented, day/month/year of decision to grant a patent, matters having amended *ex officio*, along with an examiner's sign and seal.

(2) For a decision to grant a patent, the Commissioner of KIPO shall deliver a certified copy of the written decision to grant a patent to an applicant. The decision to grant a patent is confirmed upon the delivery of the certified copy.

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12.2 Decision to Reject an Application

(1) Where an examiner provides an opportunity for petition to an applicant with the notification of grounds for rejection, he/she shall make a decision to reject an application in writing with rationale attached if an applicant fails to overcome the grounds for rejection.

The written decision to reject an application shall include an application number, title of invention, name and address of applicant and attorney, day/month/year of notice of grounds for rejection, the text of decision and its rationale, and day/month/year of decision to reject a patent, along with an examiner's sign and seal.

(2) For decision to reject an application, the Commissioner of KIPO shall deliver a certified copy of the written decision to reject an application to an applicant. The decision of rejection is confirmed when it cannot be revoked with methods prescribed in provisions of the Patent Act. For example, where no appeal against the decision of rejection is filed within the statutory period, where a trial decision is made supporting the rejection decision in the appeal against the decision of rejection, or where a ruling or a trial decision is made to dismiss a request for a trial, the decision to reject an application is confirmed.

(3) For decision to reject an application, an examiner shall indicate his or her determination on the applicant's amendment in which the notified grounds for rejections were still not overcome and the issuable items in the written argument.

(4) For an application involving two or more claims, where any of the claims contain grounds for rejection, an examiner shall make a decision to reject an application.

(5) An examiner shall not make a decision of rejection based on unreasonable rationale other than the already notified ground for rejection, which includes additional request for new documents relating to prior art. To refer a new prior art, an examiner shall notify the very fact as a ground for rejection.

12.3 Additional Notes

When examining an application with information provided by a third party as grounds for rejection or an application filed by an unentitled person, an examiner shall take requisite

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measures before making his or her final decision.

(1) For an application with information provided by a third party as grounds for rejection, an examiner shall notify an information provider of his/her decision and whether the provided information is used or not in the examination, when the examination closes. However, where the information is provided by a person without capacity to provide information (incompetent person, or fictitious person), or where the application is abandoned, withdrawn, or invalidated prior to examination, an examiner may not notify the use of information.

(2) Where an examiner decides to reject an application based on the ground that the application is filed by an unentitled person, he/she shall deliver written notice to the lawful right-holder without delay after confirming the decision of rejection. Where the confirmation of the decision of rejection requires a long time in an appeal against the decision to reject, an examiner before the confirmation of decision of rejection, may notify a lawful right-holder of his/her decision to reject an application and the appeal against the decision of rejection in advance.

13. Cancellation of Examination Measures

Where an examiner discovers defects in his/her measures during the examination, the very examiner may cancel the measures. The cancellation of a measure loses its partial or whole validity retroactively to the very beginning.

An examiner shall review whether his/her measure during the examination stage falls under cancellation in the following cases; where an examiner resumes the once suspended or deferred application, where an examiner resumes the once closed application including a withdrawn or abandoned application, or where an examiner conducts an examination of application which is not requested for examination.

(1) Any cancellation shall be made under the name of an examiner who originally has conducted the concerned measure. For cancellation of a measure having been conducted by an examiner, the measure can be cancelled only when the concerned measure displays

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definite defects and the benefits of its cancellation far outweigh than the benefits of its maintaining. In other words, an examiner shall cancel *ex officio* only when the benefits from law compliance outweigh those from confidence protection on a basis of comparative analysis between 'the principle of law compliance' and the 'principle of confidence protection'.

(2) For notification of the ground for rejection, request for amendment, and request for supplementation, an examiner shall not cancel them because their cancellation is of less practical use compared to keeping them through amendment or error correction.

(3) A cancellation of a measure having been carried out by an examiner shall be notified to an applicant with definite and specific explanation of the measure to be cancelled and its corresponding reasons after the communication to a managing director of the Examination Bureau following a head of the Examination Part.

(4) In principle, the cancellation shall be made in the form of a notice for cancellation provided by the Patent Examination Processing System. However, 「On-nara System(EDMS: Electronic Document Management System in Korean Government)」can be used in cases as follows; where **three months** have passed after the delivery due date, where new documents are received after delivering the notice of the measure, or where a process relating to fee payment is not completed, or where the form of notice for cancellation cannot be prepared due to failures in other systems of subsequent procedure.

(5) When cancelling the measure having conducted by him/herself, the concerned examiner shall execute the corresponding subsequent measures.

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Chapter 4. Reexamination

1. Overview

Within 30 days from the date of receiving a certified copy of the decision to reject a patent application (or within the extended period if the period for a trial against a decision to reject a patent application is extended), the applicant may amend the specification or drawing(s) to request reexamination of the application. The reexamination is introduced to reduce the patent fee burden and complexity in the previous system of reexamination before a trial.

2. Reexamination Procedure

2.1 Reexamination Procedure Flow Chart

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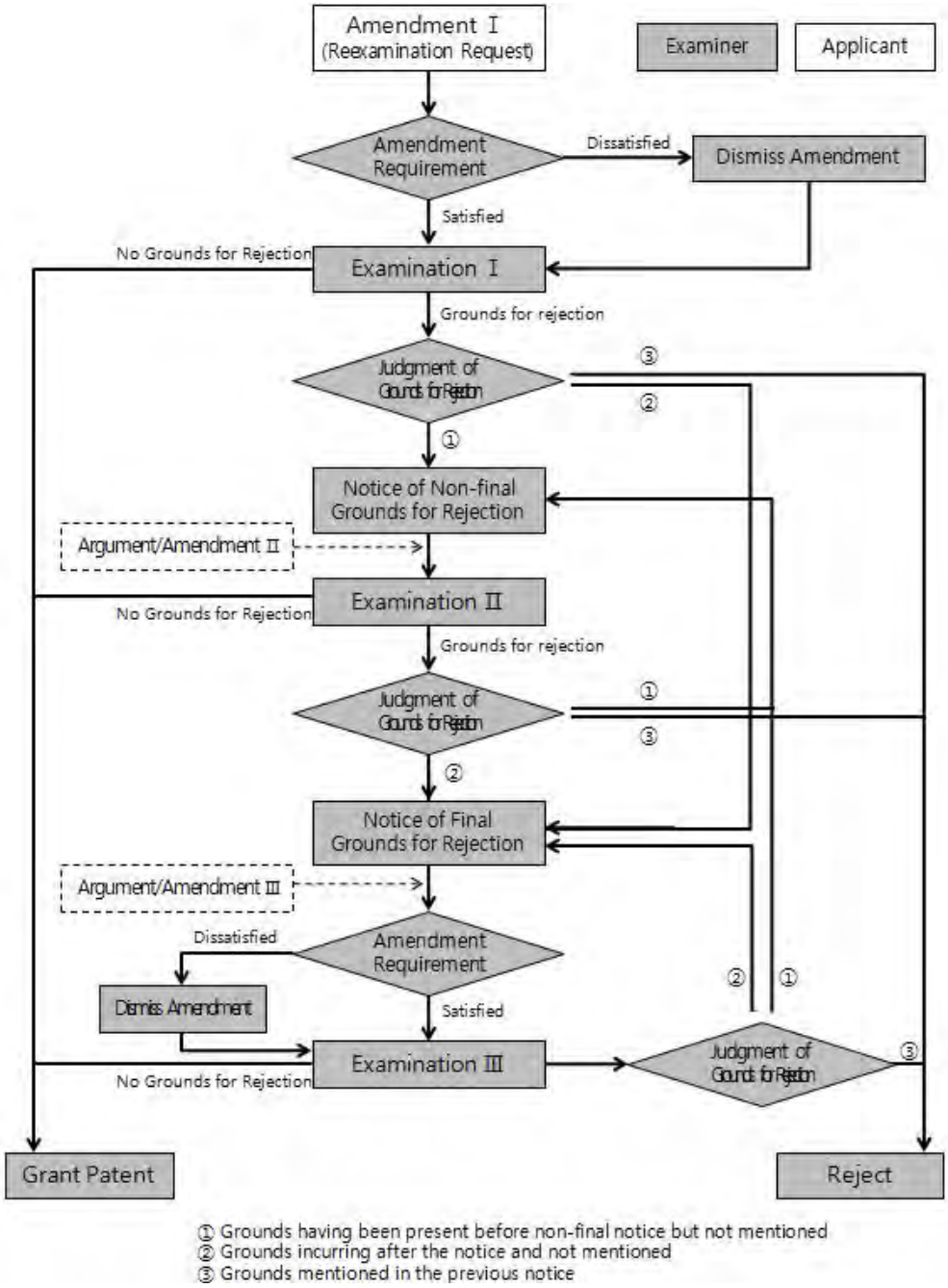

2.2 Examination of Formalities in Reexamination Request

(1) The reexamination shall be assigned to the examiner who had performed the original examination and had decided to reject an application. However, when the entrustment of reexamination to the original examiner is not appropriate as seen in the case of his/her transfer to other non-examination bureaus, an examiner in charge of the concerned

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technical classification of the claimed invention shall carry out the reexamination.

(2) Requirements for reexamination are as follows: an application ① has not been invalidated, withdrawn or abandoned, ② has rejected (rejection after reexamination excluded), ③ has not requested for a trial against decision to reject, and ④ declares the intention to request an reexamination with amendment of the specification, drawing(s) or claims.

As the amendment herein includes not only substantial amendment to the specification, drawing(s) or claims but also any amendment made in the specification.

(3) The request for a reexamination shall be made by the submission of the amendment. Therefore, the examination of formalities for reexamination request shall be made in accordance with the examination of amendment procedure. In other words, where the reexamination request is filed for an application which is not pending due to invalidation, withdrawal, or abandonment, where a person other than an applicant files an reexamination request by submitting the amendment, or where the amendment is submitted after the statutory period, the examiner shall provide an applicant with an opportunity for explanation and returns the written reexamination request.

Also, where an applicant request for a reexamination prior to the decision to reject a patent application, or request again for an additional reexamination after a rejection received from the first reexamination, an examiner shall return the written request for reexamination.

(4) An applicant shall not request reexamination for an application for which a trial against the decision of rejection has been requested. When requests for a reexamination and a trial against the decision of rejection are filed simultaneously, the following should be complied with.

① Where an applicant submits the amendment stating the purport for reexamination request following the submission of the request for a trial

The proviso of Article 67-2 stipulates that an applicant shall not request for reexamination where an appeal for a rejection decision have been already filed. And

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Regardless of whether the trial request is invalided or withdrawn as of the amendment submission date, an examiner in this case shall provide an applicant with an opportunity for explanation pursuant to Article 11(1) (XIX) of the Enforcement Rules of the Patent Act and shall return the written amendment to an applicant. When receiving the written amendment from an examiner, an applicant may amend by withdrawing an appeal against the rejection decision and file a reexamination request provided however that the prescribed period of Article 67-2 (1) shall not elapse.

② Where an applicant submits a request for a trial following the submission of the amendment containing the purport to request for reexamination.

As the request for examination by submitting the amendment is legitimate, an examiner shall regard the decision of rejection having been cancelled, and proceed with the reexamination.

③ Where an applicant submit a request for a trial and the amendment containing the purport for reexamination request, both of which are dated on the same day.

Where the submission dates of a trial request and an amendment are not confirmed (i.e., it is not clear which of the two is made first), an examiner, considering the amendment as being submitted later than the request for a trial, shall notify the reason for returning an amendment. The notice of the reason for returning an amendment shall explain in detail that an applicant may choose between a request for reexamination and a trial against decision of rejection. Where an applicant withdraws an appeal against the decision of rejection (a request for a trial), an examiner in the view of a request for reexamination having been valid shall proceed to the reexamination procedure. When receiving a request for returning an amendment, an examiner shall return it without delay.

④ Where an applicant submit a request for a trial and an amendment without stating the purport to request for reexamination, both of which are dated on the same day.

Where an amendment does not state the purport to request for examination, it shall not be regarded as being validly submitted within the amendment period (Patent Act Articles 47, 67bis①). An examiner shall regard the amendment as document being

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submitted after the prescribed period in the Patent Act or Enforcement Decree of the Patent Act (the Enforcement Rules of the Patent Act Article 11) and return the amendment after giving an opportunity for petition.

2.3 Review of Amendment Appropriateness

(1) In the case of reexamination request, the previous rejection is deemed to have been cancelled. Therefore, the examiner herein shall examine in the same manner as he/she have examined an application with the amendment before decision of rejection was made.

However, the request for reexamination deems to cancel only the previous decision of rejection, not the other previous procedure of the examination. In other words, a patent procedure prior to rejection decision and the examination procedure conducted by an examiner (notice of the non-final rejection ground, amendment, notice of final rejection ground, or amendment dismissal), shall remain valid during reexamination stage.

(2) Where the amendment is submitted in order to file a reexamination request, an examiner, before conducting reexamination, shall confirm specification be examined on a basis of his/her judgment of whether the amendment shall be dismissed or not.

Judgment to dismiss the amendment having been made upon the request for reexamination shall refer to the above-mentioned section of「11.2 Requirements for Amendment」. 'An amendment according to the final notification of ground for rejection' reads to 'an amendment conducting upon request for reexamination request'.

(Note) The scope of amendment upon the request for reexamination is the same as that of amendment according to the final notification of ground for rejection. For the scope of amendment, Part VI Chapter 2 in this Guideline shall be referred to.

(3) In the case of request for reexamination, even if the amendment having been conducted before the reexamination request is eligible to be dismissed but is disregarded, an examiner shall not dismiss the amendment retroactively by the foresaid reason(Patent Act Article 51① Proviso). It is designed to protect an applicant's confidence and interest in reexamination procedure which is based on the amendment made before decision of rejection, of an applicant.

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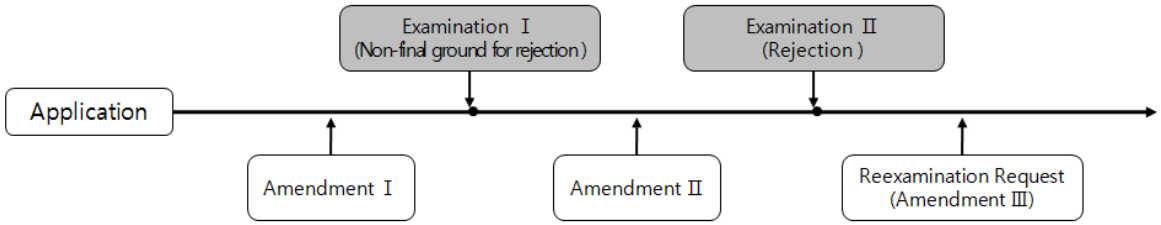
(4) A decision as to whether the amendment is appropriately made or not is made as follows:

① Where a decision of rejection is made without amendment dismissal prior to request for reexamination

An examiner examines the specification reflecting the Amendment Ⅰ and delivers the notice of first rejection ground. And after examining the specification reflecting Amendment Ⅱ, an examiner discovers that the rejection ground is not amended and accordingly delivers the decision to reject a patent to an applicant. In response, an applicant submits the Amendment Ⅲ as a procedure of reexamination request. Under this circumstance, (a) an addition to the scope of the matters pursuant to Article 47(2) of the Patent Act shall be compared with the specification or drawing(s) originally attached to the written patent application, and (b) another requirement for the amendment pursuant to Article 47 (3) shall be compared with the specification or drawing(s) having reflected the Amendment Ⅱ.



② Decision of rejection after the amendment dismissal, but before the request for reexamination

During examining the specification reflecting the Amendment Ⅱ, the examiner discovers another rejection reason incurring from the Amendment Ⅱ and notify to the applicant the final rejection reason thereafter. And with the judgment that the Amendment Ⅲ is not sufficient to cure the rejection reason, an examiner dismisses the Amendment Ⅲ and examines the Amendment Ⅱ. According to the examination, an examiner makes a judgment that the final ground for rejection is not amended and accordingly delivers a decision to reject a patent. In response, an applicant requests a reexamination with the submission of the Amendment Ⅳ. Under this circumstance, (a) an addition to the scope of the matters pursuant to Article 47(2) of the Patent Act shall be compared with the specification or drawing(s) originally attached to the written patent application, and (b) another requirement

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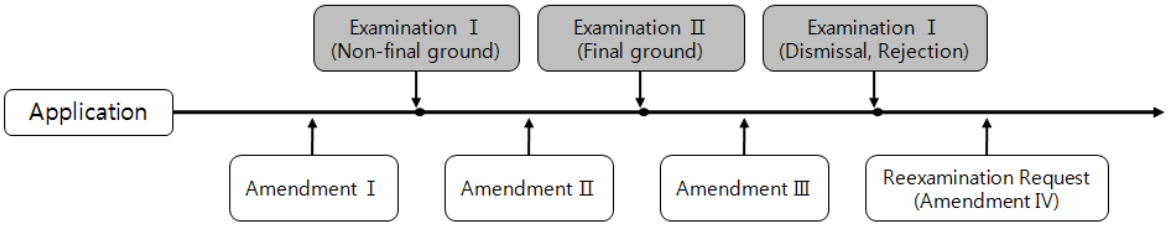
for the amendment pursuant to Article 47 (3) shall be compared with the specification or drawing(s) having reflected the Amendment Ⅱ.

In other words, since the Amendment Ⅲ has been already dismissed and the applicant shall not protest against the decision for amendment dismissal prior to a request for reexamination shall not be protested, the judgment of requirements for the amendment pursuant to Article 47 (3) shall not consider the Amendment Ⅲ.



2.4 Examination after Admission of Amendment

(1) Where the amendment is regarded as appropriate, the examiner shall admit and reflect the amendment to the specification to be examined. After confirming the specification, he/she shall decide whether there are the grounds for rejection or not, and its corresponding notification of the grounds for rejection, and make a decision to grant a patent or reject the application.

(2) Where the amendment upon the request for reexamination still fails to resolve the grounds for rejection, the examiner shall decide to reject the application. If cured, he/she shall deliver a decision to grant a patent.

(3) Where an examiner considers the amendment overcomes the notified rejection grounds but discovers other rejections grounds that were not indicated, the examiner shall notify newly found grounds for rejection to the applicant. Types of grounds for rejection can be referred to 「5.3 Types of Grounds for Rejection」.

(Note) Where the examiner disregards a partial inappropriateness in the amendment upon the request for reexamination and delivers non-final and final notice of the grounds for rejection or the decision to grant a patent, the amendment shall not be dismissed retroactively even when the inappropriateness is discovered afterwards.

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2.5 Examination after Dismissal of Amendment

(1) After dismissing the amendment, an examiner shall immediately proceed with the pre-amendment original specification.

(2) Where the grounds for rejection noticed are not amended, an examiner shall deliver a rejection of a patent. However, if the review determines that the rejection decision is not proper and discovers no other rejection grounds, an examiner shall deliver a decision to grant a patent.

(3) Where the review discovers that the rejection decision is inappropriate and there arise other rejection grounds, an examiner shall again notify the grounds for rejection. Types of grounds for rejection can be referred to 「5.3 Types of Notice of Ground for Rejection」.

3. Instructions for Reexamination

(1) Where the grounds for rejection having been notified previously are not overcome upon the reexamination request, those rejection ground shall not be regarded newly generated. Therein, an examiner shall admit the amendment but make a decision to reject a patent.

(2) Where the request for reexamination is filed, the decision to reject a patent application is regarded as cancelled. Therefore, an applicant shall not perform his/her act which can be done within thirty days from the receipt of a certified copy of the decision to reject a patent application. In other words, an applicant shall not either file a trial against decision of rejection or a divisional application. However, an applicant may file a divisional application either upon the request for a reexamination or within the period for submitting a written argument in response to the notification of grounds for rejection during the reexamination stage.

(3) Article 67-2 (3) of the Patent Act stipulates that the request for a reexamination shall not be withdrawn. This is designed to prevent procedural confusion upon the withdrawal, since the rejection ground deems to have been cancelled when a reexamination request is filed. Where an applicant submits a request for withdrawal of the reexamination request, it shall

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be regarded as uncertain type of documents (the Enforcement Rules of the Patent Act Article 11). In this case, an examiner shall provide an applicant with an opportunity for explanation and return the written request for withdrawal.

(4) Where an applicant requests a reexamination in accordance with Article 67-2 (2) of the Patent Act, the decision to reject the patent application made prior to the request shall be deemed to have been cancelled. Therefore, where the amendment stating the purport for the reexamination request dated on the same day is submitted a multiple times, any amendment from the second submission shall not be deemed to be submitted within the prescribed period (Articles 47, 67 bis (1) of the Patent Act). Since an examiner regards the subsequent amendments following the first submission as documents submitted after the statutory period according to the Patent Act or the Enforcement Decree of the Patent Act (the Enforcement Rules of the Patent Act Article 11), he/she gives an opportunity for an explanation and returns the subsequent amendments.

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Chapter 5. Amendment *Ex officio*

1. Overview

In the past, when the specification had minor deficiency, the examiner should have notified the rejection grounds and have asked the applicant to amend the deficiency. However, as the number of the notification of the grounds for rejection due to an insignificant error or omissions had increased, it became a problem to procrastinate the examination procedure.

The amendment *ex officio* by the concerned examiner is therefore introduced to solve the aforementioned problems. When an examiner during the examination discovers only obvious errors such as misspells, omissions, or inconsistent reference signs, the examiner is allowed to amend *ex officio* the clearly erroneous matters instead of notifying the ground for rejection, which accordingly prevents the examination delays and makes the description of registration without deficiency.

However, the responsibility of the description generally lies in the applicant. In consideration of Article 47 of the Patent Act, which strictly limits a person eligible for amendment, amendment period, and scope, the amendment *ex officio* shall be applied within the limited scope as a supplementary exception for the applicant's self amendment.

2. Matters to be Amended *Ex officio*

(1) 「Matters that are clearly erroneous」in the specification, drawing(s), or abstract according to Article 66-2 of the Patent Act refers to the matters that do not fall under the grounds for rejection and do not influence the substantive scope of right in the patent application, provided however, that the matters shall have no possibility of arguments in the interpretation from the context, in the confirming of the claim scope, and in the working of the invention.

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(2) Matters for amendment *ex officio* are misspelling or missing word according to standard Korean or its grammar, or inconsistent use of sign in drawing(s).

① Misspelled word in violation of Korean grammar

(a) Semiconducter → Semiconductor

(b) Boared → Board

② Missing word which is obvious in Korean grammar

(a) signal transmitted ○ line → signal transmitted to line

(b) linear ○tor → linear motor

③ Inconsistence in reference numbering

(a) When explaining in detail, [Drawing 2] Buffer (115) vs. Drawing [D2] Buffer (15)

④ Redundant writing

(a) The patent office, the patent office is → The patent office is

⑤ Error in simple explanation of drawing

(a) Number of drawing misstated

D 1 is cross section of regenerator

D 1 is side view of regenerator → D 2 is side view of regenerator

D 3 is perspective view of regenerator

(b) Misspelled Reference signs in the drawing

3...Gear 3...Motor → 3...Gear 4...Motor

⑥ Misspelling in summary table

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When the misspelling is obvious in the summary table according to the detailed explanation of the invention

⑦ Inconsistency in title between the description and the application

The examiner may amend *ex officio* the title of the invention stated in the description to correspond to that of the application. However, when the title stated in the application fails to satisfy the requirements for invention title under Section Ⅱ, Chapter 000, the examiner may amend *ex officio* the inappropriate invention title to the one which is deemed to be proper (use the correction *ex officio* button on the website of Patent Net. Com), and amend *ex officio* the title of the description correspondingly.

3. Instructions of Amendment *Ex officio*

The matters to be amended *ex officio* are limited to self-evident error. When an examiner amends *ex officio*, he/she should not alter the scope of the claim, and the amendment *ex officio* shall not be allowed if there arises any possibility of different interpretation.

(1) Where the misstatement is regarded as the ground for rejection, no amendment *ex officio* is allowed. The rejection ground shall be notified.

(2) Where the description contains both the matters that are clearly erroneous, and the grounds for rejection, the examiner shall send the notice of ground for rejection where the matters to be amended *ex officio* are stated as reference and encourage the applicant to amend the error.

(3) The examiner shall not add new matters to the first description or drawing(s) by amendment *ex officio*. In particular, the examiner shall be careful not to include an unintended new technical subject-matter during amendment *ex officio* in drawings.

(4) Where the indicated subject is unclear as in the term of the "above-mentioned" in claims and therefore, the constitution of the invention is unclear, the examiner shall not make an amendment *ex officio*.

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However, even though the matter to be indicated does not match literally, if the matter is just a clerical error and a person skilled in the art can clearly understand the constitution of the invention and recreate it, the matter does not constitute a ground for rejection under Article 42(4)(ii) of the Patent Act and therefore, is subject to ex officio amendment. (See Part 2, Chapter 4, 4.(4))

(5) The miswriting of the claim referring to the deleted claims shall not be amended *ex officio*. In such a case, which claim was meant to be cited is unknown and it is hard to clearly understand the invention and these constitute a ground for rejection. Therefore, the examiner shall not make an amendment ex officio. Rather, he/she shall address the lack of description through amendment by notifying the ground for rejection.

However, as for a claim referring to two or more claims, where part of the cited claims is deleted, but the claimed invention is clearly understood when interpreted except for the citation of the deleted claims, it shall be considered not a ground for rejection, but a clerical error. Therefore, the claimed invention shall be subject to *ex officio* amendment (See Part 2, Chapter 4, 4.(4))

(Example) Claim 10 discloses 'in any of claims 1 to 9,...', and claim 3 is deleted. Even so, where the claimed invention is clearly understood when interpreted to refer to any of claims 1, 2 and 4-9, except for claim 3, claim 10 shall be subject to *ex officio* amendment since it holds a clerical error, not a ground for rejection under Article 42(4)(ii) of the Patent Act. (2010 Won 4920)

For the use of 'the said' in the application without clear specification, the examiner shall not delete *ex officio* unless there is no possible arguments in interpretation according to the clear causation in the statement.

4. Procedure of Amendment *Ex officio*

(1) The examiner intending to amend *ex officio* shall notify the matters to be amended to the applicant with a certified copy of the decision to patentability.

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Where the matters are recognized for amendment *ex officio*, the examiner shall describe in definite and specific manners that which matters are to be amended *ex officio* in the written decision to grant a patent. The examiner shall state the reason why the matter is to be amended *ex officio* in order to help the applicant to decide to accept the amendment or not.

(Example of Notice)

1. Second line of <20> in the description; "...signal ... transmitted ..."; "...signal ... transmitted to..."; definite omission

2. 3rd line of the Claim (3); "...Semiconductor Memory"; "...Semiconductor Memory"; definite misspelling

Also, when the examiner describes where to amend *ex officio*, he/she shall stipulate specifically using ID number or relevant line in the page, so that the applicant may not confuse to determine to accept the amendment *ex officio*.

(2) When the applicant opposes to accept the amendment *ex officio* in whole or part, he/she shall submit the written statement of argument before the payment of patent fee, whereby the examiner may make selective decision for the amendment *ex officio*.

Where the applicant submits the written statement of argument regarding the amendment *ex officio*, the concerned matter under the amendment *ex officio* shall be deemed never to have existed. The description is digitized and published in the patent gazette except for the matter that the applicant rejects to accept the amendment *ex officio*.

(Note) Where the examiner amends the matter which does not fall under the category of the amendment *ex officio* and the applicant also overlooking such an illegitimate amendment by the examiner publishes the description in the patent gazette, the concerned matter having amended *ex officio* shall be deemed never to have existed unless the amendment is recognized as legitimate afterward. This is designed to prevent unexpected losses in patentees or the 3rd parties due to an illegitimate amendment by the examiner.

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Part VI – SPECIAL APPLICATIONS

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Chapter 1. Divisional Application

1. Article 52 of the Patent Act

Article 52 of the Patent Act (Divisional Application) ① An applicant who has filed a patent application comprising two or more inventions may divide the application into two or more applications within the scope of the matters disclosed in the specification or drawing(s) originally attached to the written application of the patent application within one of the following periods:

1. the amendment period prescribed under Article 47(1);
2. the period for requesting a trial under Article 132ter after the applicant received a certified copy of the decision to reject a patent application.

② A divided patent application under paragraph (1) (hereinafter referred to as "a divisional application") is deemed to have been filed when the original patent application was filed. However, when any of the following subparagraphs applies to the divisional application, the divisional application is deemed to have been filed when the divisional application was filed:

(i) where Article 29(3) of this Act or Article 4(3) of the Utility Model Act applies because the divisional application falls under another application for patent under Article 29(3) of this Act or a patent application under Article 4(3) of the Utility Model Act;

(ii) where Article 30(2) applies;

(iii) where Article 54(3) applies; or

(iv) where Article 55(2) applies.

③ A person who files a divisional application under paragraph(1) shall state the purport of the divisional application and indicate the patent application that forms the basis of the division in a written application of the divisional application.

④ When filing a divisional application, an applicant claiming a priority under Article 54 shall file the documents prescribed in paragraph(4) of Article 54 with the Commissioner of the KIPO within three months from the filing date of the divisional application, regardless of the period prescribed in paragraph (5) of Article 54.

2. Purport

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A divisional application is an application that has been filed as one or more new patent applications, divided out of a patent application comprising two or more inventions (hereinafter referred to as an 'original application'). A divisional application shall be deemed to have been filed at the filing time of the original application.

A patent application involving inventions which do not fulfill the requirement for scope of a patent application under Article 45 of the Patent Act is unpatentable. Therefore, filing a divisional application can address grounds for rejection while retaining the original filing date. Also, the divisional application system is designed to protect inventions described in a specification or drawing(s), but not disclosed in the claims at the filing time of the application, considering the purpose of the patent system in which an exclusive patent right is granted to an invention for a limited time in reward of its disclosure.

3. Requirements for Division

3.1 Persons who may file Divisional Application

Article 52(1) of the Patent Act stipulates 'an applicant... may divide...' and defines that a person who may file a divisional application is an applicant who has filed a patent application comprising two or more inventions. Therefore, a person who has the right to file a divisional application is the applicant who has filed the original application or his/her successor. Where an application is jointly filed, the applicants of the divisional application shall be identical to those who filed the original application.

The following requirements shall be met in order to recognize that the applicant of the original application and the applicant of the divisional application are identical: ① the same domicile or business address of the applicants, ② the same name or title of the applicants, and ③ the same seal of the applicants.

3.2 Time Requirement

(1) The time of filing a divisional application shall be categorized based on the filing date in the following table.

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Filing Date	Patent Application	Utility Model Registration Application
'99.7.1	①Within one year and three months from the filing date of the original application (the earliest filing date in case of priority claim) ②After one year and three months from the filing date of the original application, but no later than the delivery of a certified copy of decision to grant a patent · In case of examination request · Within three months from the date of the examination notice in case of third parties' request for examination ·Within the period for submission of written arguments ·Within thirty days from the date of request for an appeal against decision of rejection	①Within one year and three months from the filing date of the original application (the earliest filing date in case of priority claim) ②After one year and three months from the filing date of the original application, but no later than the delivery of a certified copy of decision to register a utility model · In case of examination request · Within three months from the date of the examination notice in case of third parties' request for examination · Within the period for submission of written arguments · Within thirty days from the date of request for an appeal against decision of rejection
'01.7.1	①Before the delivery of a certified copy of decision to grant a patent, but, only during the prescribed periods in case of ② and ③ ②Within the period for submission of	Within the periods of amendment prescribed in the provisos of Article 12(2) and Article 13(1) of the Utility Model Act as follows: ①Within two months from the filing date of utility model registration application ②Amendment period by an examiner's amendment request specified under Article 12(2) of the Utility Model Act (amendment period by KIPO

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<table>
<tr><td rowspan="3">'06.10.1</td><td rowspan="2">the concerned written argument in case of receipt of notice of grounds for rejection
③Within thirty days from the date of request for an appeal against decision of rejection</td><td>commissioner's amendment request if an application was filed between July 1, 1999 and June 30, 2001)</td></tr>
<tr><td>①Before the delivery of a certified copy of decision to grant a patent, but, only during the prescribed periods in case of ② and ③
②Within the period for submission of the written argument in case of notice of grounds for rejection
③Within thirty days from the date of request for an appeal against decision of rejection</td></tr>
<tr><td colspan="2">①Before delivery of a certified copy of decision to grant a patent. However, after notice of grounds for rejection, only limited to within the period specified in ② or only when a request in ③ is simultaneously made.
②Within the period for submission of the written argument in case of notice of grounds for rejection
③Upon a request for reexamination
④The period allowed for an appeal against decision of rejection after the delivery of a certified copy of decision of rejection</td></tr>
<tr><td>'09.7.1</td><td colspan="2"></td></tr>
</table>

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(2) The original application which forms the basis of a divisional application shall be pending before KIPO at the time of filing a divisional application. Therefore, if the original application has been invalidated, withdrawn or abandoned or the decision to reject the original application has become final and binding, a divisional application shall not be filed.

Where a division application is filed on the day when the procedure regarding the original application has been terminated because the original application has been withdrawn or abandoned, the divisional application shall be treated to have been filed when the original application was pending before KIPO. It is because that if a divisional application is filed on the same day when the procedure of the original application is terminated, it would be difficult to distinguish which application was first-or later-filed. Also, it would be reasonable to think that the procedure of the subsequent application is conducted in the applicant's awareness of the fact that the original application is still pending before KIPO.

3.3 Substantive Requirement

(1) An invention eligible for a divisional application is the invention within the scope of subject matter disclosed in the specification or drawing(s) initially attached to the original application. The inventions described in the specification or drawing(s) of a divisional application shall be all disclosed in the specification or drawing(s) of the original application. If even a single invention among the inventions of the divisional application is not contained in the original application, the divisional application shall be deemed to be invalid or have grounds for rejection.

To figure out whether an invention for which a divisional application is disclosed in the specification or drawing(s) initially attached to the original application, the examiner shall determine whether the invention in the divisional application is explicitly described in the specification or drawing(s) initially attached to the original application or whether the invention is obviously understood to have been described without any explicit specification. 「Scope of Amendment」in Chapter 2 of Part IV shall be referred to regarding the specific methods to determine the abovementioned cases.

(2) The specification or drawing(s) which forms the basis of validity for the scope of a

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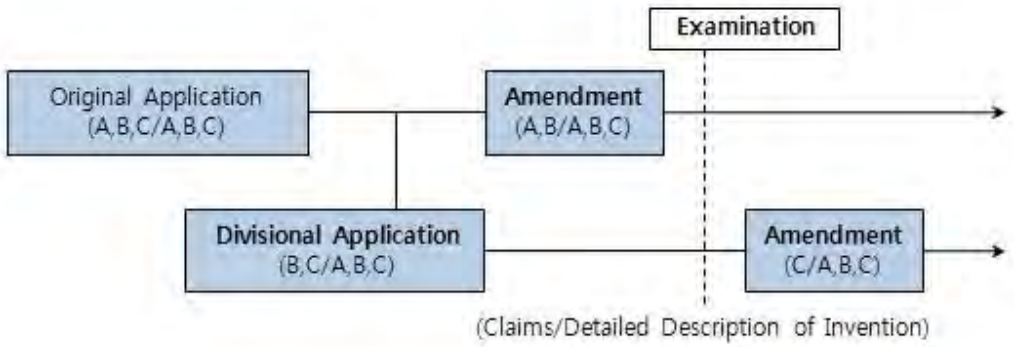
divisional application is the specification or drawing(s) initially attached to the original application. Therefore, even though an invention described in the specification or drawing(s) initially attached to the original application is deleted and not described in the amended specification, the deleted invention is eligible for a divisional application. However, an invention newly added to the original application through amendments is eligible for the divisional application since it was not disclosed in the specification or drawing(s) initially attached to the original application in the first place.

(3) When a divisional application is filed, the application is deemed to have been filed when the original application was filed. Therefore, if inventions disclosed in the claims of the original application are the same as those in the original application, it would raise the issue of double-filing of the two identical patent applications on the same date. In such a case, since the divisional application fulfills the substantive requirements, it shall be recognized and examined in accordance with Article 36(2) of the Patent Act. The same principle goes for an invention which was not identical with the invention described in the claims at the filing time of a divisional application, but has become identical with the invention in the claims of the amended original or divisional application.

(Example) Where Invention B is identically described in the claims of both the divisional and original applications, as suggested in the example below, the divisional application shall not be invalidated, nor the grounds for rejection be notified citing Invention B is out of the scope of division. Rather, consultation shall be requested according to Article 36(2) of the Patent Act.



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4. Procedure of Divisional Application

(1) A patent application shall be newly filed for a divisional application by attaching the specification or necessary documents prescribed in each paragraph to a written patent application in Form (XIV) in according to Article 29 in the Enforcement Rules of the Patent Act. In such a case, the patent application shall state the purport of the divisional application and indicate the original application which forms the basis of division.

If the original application is not indicated at the filing of the divisional application, the divisional application shall not be recognized as a legitimate divisional application. Moreover, except for obvious errors, amendments of changing the original application by amending the indication of the original application in the written divisional application after division of the application shall not be accepted.

(2) Normally, along with submission of a divisional application, the applicant is supposed to amend the original application to differentiate the invention described in the claims of the original application from the claims of the divisional application. However, the original application need not be amended if inventions described in the claims of a divisional application are disclosed only in the detailed description of the invention or drawing(s) in the original application.

(3) If a claim regarding non-prejudicial disclosure or priority claim is to be made for a divisional application, the applicant shall state the purport of the divisional application and submit the documents needed for such claims by the prescribed date from the filing date of the divisional application (within thirty days from the filing date as for the application claiming non-prejudicial disclosure or within three months as for the application claiming priority). Where a claim for non-prejudicial disclosure or priority claim was not made at the time of filing the original application, such claims shall not be recognized at the filing time of the divisional application. However, even when the purport of a claim regarding non-prejudicial disclosure or priority claim was set forth in the divisional application, but the evidential documents were not submitted within the statutory period, if the applicant states the purport of a claim for non-prejudicial disclosure or priority claim in the written divisional application and submitted the evidential documents by the prescribed date from the filing

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date of the divisional application, the claims shall be deemed to be legitimate (except for when the claim for non-prejudicial disclosure or priority claim of the original application has been invalidated before the filing of the divisional application).

Where an applicant of a divisional application intends to rely on the evidential documents of his/her original application which have been already submitted since the contents of the evidential documents of both original and divisional applications are identical, the applicant can substitute for the submission of the divisional application by stating the purport of using the original application in the attached documents of the form.

If the evidential documents were submitted at the filing time of the original application, and if the documents contained the same claim for non-prejudicial disclosure or priority claim in a written divisional application as in the written original application, it is deemed that the applicant has an intention of relying on the evidential documents of the original application when filing the divisional application. However, Article 10(2) in the Enforcement Rules of the Patent Act stipulates that the intention of reliance be stated. Therefore, if the evidential documents were not submitted and the intention of relying on the evidential documents of the original application was not stated, the examiner shall request amendment, citing violation of description formalities in relying on the evidential documents.

5. Effects of Divisional Application

A divisional application shall retain the same filing date as the original application. However, it would be unfair to give the retroactive filing date to a divisional application in the following cases. Therefore, in such particular conditions below, a divisional application shall be deemed to be filed when it is actually filed.

① Where a divisional application corresponds to 'another application' prescribed in Article 29(3) of the Patent Act or a 'patent application' specified in Article 4(3) of the Utility Model Act

Inventions in a divisional application are supposed to be stated in the specification or

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drawing(s) initially attached to the original application. However, new subject matter could be added to the specification or drawing(s) attached to a divisional application to unfairly obtain the status of the prior application. Therefore, a divisional application shall not take the filing date of the original application if it becomes another application mentioned in Article 29 (3) of the Patent Act. This, too, shall apply to the utility model registration applications.

② Where an applicant who wants the proviso of Article 1(1)(1) of the Patent Act to be applied to his/her invention in a divisional application states the purport in the patent application and submits the evidential documents to the commissioner of KIPO

③ Where an applicant who wants to file a divisional application claiming a priority under the Treaty states the purport of priority, the name of the country where his/her application was first filed and the date of the application in the patent application

④ Where an applicant who wants to file a divisional application claiming Domestic Priority states the purport of claiming a priority and the prior application in the patent application

6. Examination of Divisional Application

6.1 General Principle of Divisional Application Examination

(1) Once a divisional application is submitted, the examiner shall first examine whether the application fulfills the formality requirements for a divisional application. Then, the examiner shall determine whether the divisional application was filed by a person eligible for division of application, whether the application was submitted within the designated period for filing a divisional application, whether the prior application is properly stated in the divisional application.

Where a divisional application was filed by a person not eligible for division of application or where it was submitted after the designated period or where a divisional application was filed after the termination of the procedure on the original application, it shall be deemed to be in violation of Article 11(1)(7) or (11) and the examiner shall give an opportunity to

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explain to the applicant. If the applicant cannot give any explanation within the designated period, the written divisional application shall be returned to the applicant.

(Note) Amendments to subject matter in a divisional application are allowed as long as the application procedure is being carried out. However, such amendments shall be limited to correcting obvious errors or deficiencies. Amendments of changing subject matter shall not be accepted; therefore, if necessary, the examiner shall notify the applicant of the scope allowed for amendment in amendment request form.

(2) Examinations on the scope of application in a divisional application shall be conducted based on the periods of filing an application as follows.

①Where the original application was filed before September 30, 2006

Where a divisional application was filed for an invention not described in the original application, the examiner shall deliver a warning notice for inadmissible division to the applicant within the designated period. Where division of application is not accepted even based on the written arguments submitted, the examiner shall deliver a notice for inadmissible division and examine the application on a basis of the actual filing date of the divisional application, without giving the retroactive filing date to the application. It shall be noted that the published patent gazette on the original application can be utilized as citation documents to deny novelty or inventive step if the filing date of the divisional application cannot take effect retroactively.

If grounds for both inadmissible division and rejection are present when examining a divisional application, the examiner shall deliver a notice of grounds for rejection after confirming whether the divisional application has been accepted or not. However, if the rejection grounds are not related to whether the divisional application retains the filing date of the original application (whether a divisional application has been accepted or not), both the warning notice for inadmissible division and the notice of grounds for rejection can be simultaneously delivered in the separate forms.

Meanwhile, where an invention not described in the original application is deleted through

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amendment of the specification or drawing(s) of the divisional application while examining the divisional application without allowing the retroactive filing date to the application, the examiner shall examine the divisional application after retroactively calculating the filing date.

(Note) Even when the examiner did not retroactively count the filing date since the divisional application cannot be accepted, the examiner can make a decision to grant a patent after delivery of a notice for inadmissible division.

②Where the original application was filed on or after October 1, 2006

When a divisional application was filed for an invention not described in the original application, the examiner shall notify the applicant of grounds for rejection regarding the divisional application. The examiner shall make a decision to reject an application if the divisional application cannot be accepted even with the submission of written arguments or amendments.

6.2 Instructions on Examination of Divisional Application

(1) Amendments to the specification or drawing(s) in a divisional application are allowed only within the period prescribed in the subparagraphs of Article 47(1) of the Patent Act.

Where a divisional application fulfills the procedural and substantive requirements, the examiner shall regard the divisional application as an ordinary application and assess its legality on amendments. In such a case, the specification or drawing(s) initially attached to the divisional application shall become the patent specification which assesses the substantial requirements of the amendments. If an invention not contained in the initial specification or drawing(s) of the divisional application is newly added through amendments after filing the divisional application, the examiner shall conduct the examination in accordance with the requirement of prohibiting the addition of new subject matter. The same principle shall apply to the case of the addition of an invention which was described in the specification or drawing(s) of the original application, but excluded from the

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specification or drawing(s) initially attached to the divisional application.

(2) When a divisional application was rejected again as a result of reexamination specified in Article 67(2) of the Patent Act, an applicant shall file a divisional application within the period allowed for a request of an appeal against a decision of rejection on the divisional application. In such a case, where the identical claim of the original application is included in the divisional application and the divisional application only holds the ground for rejection under Article 36(2) of the Patent Act, the examiner shall not notify the applicant of a ground for rejection and rather defer examination until a ruling of a trial against a decision of rejection becomes final and binding. However, where other grounds for rejection exist than the one under Article 36(2) of the Patent Act, the examiner shall notify the applicant of the grounds for rejection other than the ground under Article 36(2) of the Patent Act and conduct examination. If all grounds for rejection are addressed, but the ground for rejection under Article 36(2) of the Patent Act, the examiner shall defer examination until the trial on the original application becomes final and binding.

See Part 5, Chapter 3 「8. Examination Deferral or Extension of Processing Period」 (6) for details on examination deferral of divisional applications.

It is because that if the original application was rejected again after reexamination, amendments to the specification or drawing(s) would be practically impossible, making grounds for rejection clarified in Article 36(2) of the Patent Act difficult to address. Also, whether a divisional application holds the status of the prior application mentioned in Article 36(2) and (4) of the Patent Act can be confirmed only when a ruling of an appeal against a decision of rejection becomes final and binding.

A divisional application formed on a basis of an application claiming a priority under the Treaty or claiming Domestic Priority shall be accepted. In the example below, even when an application claiming a priority of No.④ involves both the prior applications of No.①, ③ (the application claiming Domestic Priority) and the application in the country where it is initially filed of No.② (the application claiming a priority under the Treaty), the divisional application of No.⑤ based on an application claiming a priority of No.④ shall be accepted.

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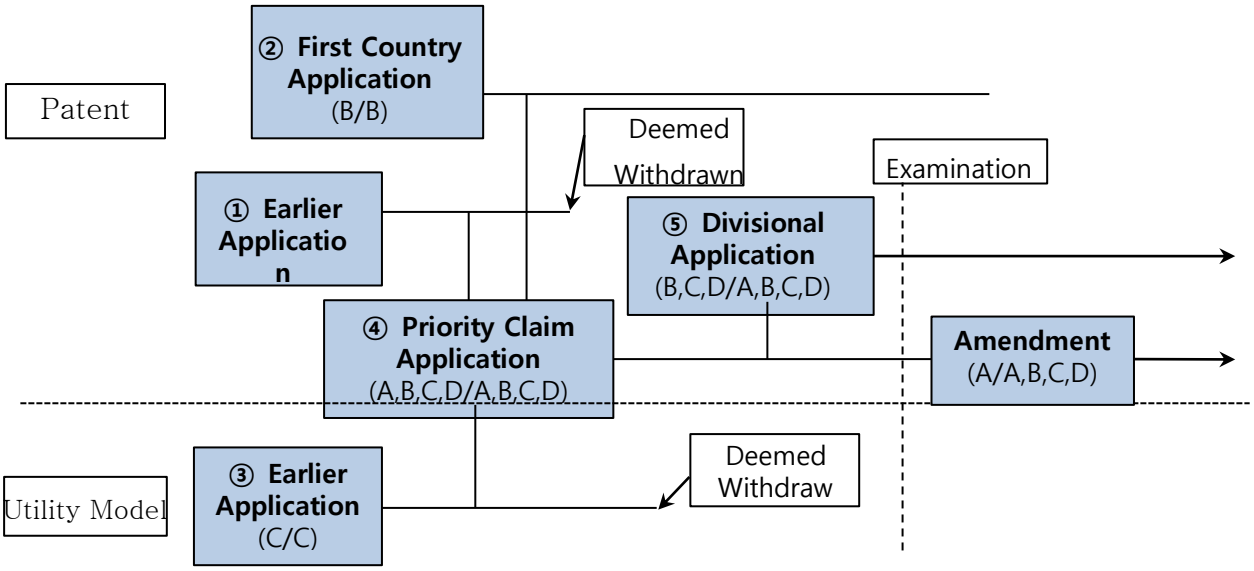
In such a case, the divisional application of No.⑤ shall retroactively take the filing date of the application claiming priority, but the reference date to determine patentability shall change based on the filing date of the prior application involving the concerned invention. In other words, Invention B takes the filing date of the application in the country where it was initially filed of No.② and Invention C retains the filing date of the prior application of No.③. Also, Invention D added at the time of filing the application claiming a priority of No.④ has the same filing date as the application claiming a priority of No.④.

(Note) When the same invention is described in the application claiming a priority of No.④ and the divisional application of No.⑤, Article 36(2) of the Patent Act shall apply.



(4) Where the original application was pending at the time of filing a divisional application, but was returned after the filing of the divisional application, the divisional application shall not retain the filing date of the original application and be examined based on the filing date when it was actually filed. When a divisional application has grounds for rejection, the examiner shall notify the applicant of the reason why the divisional application cannot take the retroactive filing date, along with grounds for rejection. In the absence of any ground for rejection, 「On-nara System(EDMS: Electronic Document Management System in Korean Government)」 shall be used to notify the reason why the divisional application cannot take the retroactive filing date.

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(5) A single divisional application shall not be filed based on multiple original applications. However, a divisional application can be filed when division of application is carried out after an application claiming Domestic Priority is filed base on two or more prior applications.

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Chapter 2. Converted Application

1. Article 53 of the Patent Act

Article 53 of the Patent Act (Converted Application) ① An applicant who files a utility model registration application may convert the utility model registration application to a patent application within the scope of the matters disclosed in the specification or drawing(s) originally attached to the written application of the utility model registration application. However, the applicant may not convert the application if thirty days have elapsed since the date on which the person received a certified copy of the first decision to reject the utility model registration application.

② Any application that is converted under paragraph (1) of this Article (referred to as "a converted application", hereinafter) is deemed to have been filed on the date on which the utility model registration application was filed unless it falls under either of the following subparagraphs:

1. where Article 29(3) of this Act or Article 4(3) of the Utility Model Act applies because the converted application falls under another application for patent under Article 29(3) of this Act or a patent application under Article 4(3) of the Utility Model Act;
2. where Article 30(2) applies;
3. where Article 54(3) applies; or
4. where Article 55(2) applies.

③ A person who files a converted application under paragraph (1) shall state the purport of the converted application and indicate the utility model registration application that forms the basis of the conversion in a written application of the converted application.

④ The utility model registration application that forms the basis of a converted application is deemed to be withdrawn when the converted application is filed.

⑤ Where the period stipulated in Article 132ter of this Act is extended under Article 15(1)

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of this Act, which applies *mutatis mutandis* under Article 3 of the Utility Model Act, the thirty-day period stipulated in the proviso of paragraph (1) is extended by the period of the extension given under Article 15(1).

⑥ In the case of the converted application, an applicant claiming a priority under Article 54 shall file the documents prescribed in paragraph (4) of Article 54 with the Commissioner of the KIPO within three months from the filing date of the converted application, regardless of the period prescribed in paragraph (5) of Article 54.

2. Purport

Conversion of an application is designed to convert the original application into more favorable type of an application, retaining the filing date of the original application, when the applicant has incorrectly chosen application formalities (patent, utility model) because he/she has hurriedly filed the application under the first-to-file rule, misunderstood the patent system, or it was difficult for the applicant to define subject matter for which an application was filed.

3. Requirement for Conversion

3.1 Persons who may file Converted Application

Article 53(1) of the Patent Act stipulates that 「an applicant who files an application for utility model registration may convert … to a patent application」and requires that the applicant of the original application be identical to the applicant at the time of filing a converted application.

3.2 Time requirement

(1) The time allowed for conversion of an application is the period between the date of filing an application for utility model registration or the date of filing a patent application and the date of the registration, and within thirty days from the date when the applicant received the first certified copy of a decision of rejection (within the extended period when

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the period prescribed in the proviso of *Mutatis Mutandis* application of Article 33 of the Utility Model Act or Article 132(3) of the Patent Act is extended by the proviso of *Mutatis Mutandis* application of Article 3 of the Utility Model Act or Article 15(1) of the Patent Act respectively).

Meanwhile, as for an international application deemed to be a patent application based on Article 199(1) of the Patent Act or an international application deemed to be a utility model registration application based on Article 34(2) of the Utility Model Act (Article 36(2) of the Utility Model Act before the revision), conversion of an application shall be allowed only when the fee specified in the provisions of Article 82(1) of the Patent Act or Article 17(1) of the Utility Model Act is paid and the translation (except for the international application written in Korean) clarified in the provisions of Article 201(1) of the Patent Act or Article 35(1) of the Utility Model Act (Article 37(1) of the Utility Model Act before the revision) is submitted.

(2) In order for a converted application to be recognized to be legitimate, the utility model registration application before conversion (including the design registration application in the case of an application filed before June 30, 1999) shall be pending before KIPO at the time of conversion of the application. Therefore, a converted application shall not be filed when the original application has been invalidated, withdrawn, abandoned or registered.

If a converted application is filed on the date when the procedure has been terminated due to the withdrawal and abandonment of the original application, the converted application shall be deemed to have been filed when the original application was pending before KIPO. It is because that distinguishing which of the applications is filed initially or subsequently is difficult if the procedure on the original application is terminated on the same date when the converted application is filed. Also, it is legitimate to consider that the procedure for the subsequent application is commenced in recognition that the original application was pending.

3.3 Substantive Requirement

Article 53(1) of the Patent Act defines the substantive requirements which a converted

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application shall fulfill to be acknowledged as a legitimate application by stipulating that 「an applicant may convert the utility model registration application to a patent application within the scope of the matters disclosed in the specification or drawing(s) originally attached to the written application of the utility model registration application」.

In other words, for a converted application to be recognized as a legitimate application, matters disclosed in the specification or drawing(s) of the converted application shall be included in the initial specification or drawing(s) of the original application. The converted application shall be deemed to be illegitimate and have ground(s) for rejection if even a single matter disclosed in the converted application is not contained in the initial specification or drawing(s) of the original application.

Whether an invention for which a converted application was filed is included in the specification or drawing(s) of the original application shall be determined by the following criteria: whether an invention in a converted application is explicitly described in the specification or drawing(s) initially attached to the original application, or whether an invention is understood to have been disclosed in the specification or drawing(s) without any explicit description. 「Scope of Amendment」in Chapter 2 of Part IV shall be referred to regarding information on determination methods.

4. Procedure of Converted Application

(1) When an applicant intends to file a converted application, he/she shall file a new application by attaching the specification or relevant documents to a patent application prescribed in Form (XIV) according to the subparagraphs of Article 30 of the Enforcement Rules of the Patent Act. Also, the applicant shall state the purport of the converted application, as well as the original application which forms the basis of conversion.

Where the original application has not been stated or incorrectly stated at the time of filing a converted application, conversion of the application shall not be deemed to be legitimate. Amendments of changing the original application by correcting the indication of the original application shall not be accepted, except for the amendment of the explicit errors.

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(2) Where an applicant intends to file a converted application claiming non-prejudicial disclosures or priority, he/she shall describe the purport of such claims in the written converted application and submit the evidential documents needed to make such claims within the prescribed period from the filing date of a converted application(within 30 days from the filing date of a converted application in the case of an application claiming non-prejudicial disclosure, within three months from the filing date of a converted application in the case of an application claiming priority). Such claims shall not be accepted if a claim for non-prejudicial disclosure or priority has not been made at the time of filing the original application. However, even though the purpose of claims for non-prejudicial disclosure or priority was described in the original application but the evidential documents were not submitted within the statutory period, if the converted application contains the purpose of the non-prejudicial disclosure or priority and the concerned evidential documents are submitted until the prescribed date from the filing date of the converted application, the claim for non-prejudicial disclosure or priority shall be deemed to be legitimate (except for where the procedure of the non-prejudicial disclosure or priority in the original application have been invalidated before filing the converted application concerned).

However, where an applicant intends to rely on the contents of the already-submitted evidential documents of the original application since the evidential documents of both the original application and the converted application are identical, he/she may state the evidential documents of the original application by stating the purport of reliance in the application documents.

5. Effect of Converted Application

(1) A converted application shall be deemed to have been filed when the original application was filed. However, if a converted application falls under in the following cases, the grant of the filing date of the original application to the converted application is unfair. In such cases, the converted application shall be deemed to have been filed when the actual procedure of the application commences.

① Where a converted application corresponds to 'another application' clarified in Article 29(3) of the Patent Act or a 'patent application' mentioned in Article 4(3) of the Utility

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Model Act

② Where a person intends to have Article 30(1)(1) of the Patent Act applied to an invention for which a converted application is filed and states the purport in a written patent application and submit the evidential documents to the commissioner of KIPO

③ Where a person intends to file a converted application claiming a priority under the Treaty and states the purport of priority claim, Korean title and filing date of the original application in a written converted patent application

④ Where a person intends to file a converted application claiming Domestic Priority and states the purport of priority claim as well as the original application in a written converted application

(2) When a converted application is filed, the utility model registration application shall be deemed to be withdrawn.

After the original application is deemed to be withdrawn because of the filing of a converted application, the original application shall not be valid even though a converted application has been invalidated, withdrawn, abandoned or a decision to reject a converted application has become final and binding, unless the converted application is returned.

6. Examination of Converted Application

6.1 General Principles in Examination of Converted Application

(1) Once a converted application is submitted, the examiner shall examine whether the application fulfills the formality requirements of conversion. The examiner shall examine whether the person eligible for the filing of a converted application filed a converted application, whether a converted application was submitted within the period allowed for conversion of an application or whether the original application is properly stated in a converted application.

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The examiner shall provide the applicant with an opportunity to explain if the application falls under in the following conditions, citing violation of Article 11(1)(7) or (11) in the Enforcement Rules of the Patent Act: where the person not eligible for the filing of a converted application filed a converted application, where a converted application was submitted after the expiration of the designated period, or where a converted application was submitted after the termination of the procedure of the original application. If the applicant fails to explain such cases within the designated period, the examiner shall return the converted application to the applicant.

(2) The examination on a converted application shall be categorized based on the time of filing an application as mentioned below.

① Where the original application was filed before July 1, 1999

If a converted application was filed for an invention not described in the original application, the examiner shall deliver a warning notice for inadmissible conversion within the designated period. When a converted application cannot be accepted even with the submission of written arguments or amendments, the examiner shall deliver a notice for inadmissible conversion and examine the converted application on the basis of the date when the application was actually filed, without giving the retroactive filing date to the converted application. It shall be noted that the published patent gazette on the original application can be cited as the documents to deny novelty or inventive step when a converted application cannot retain the same filing date as the original application.

In principle, when both grounds for inadmissible conversion and grounds for rejection exist when examining a converted application, the examiner shall notify grounds for rejection after confirming whether a converted application is accepted or not. However, if the rejection grounds are not related to whether the converted application retains the filing date of the original application (whether the converted application is accepted), the warning notice for inadmissible conversion and notice for rejection grounds can be simultaneously delivered in separate forms.

Meanwhile, while examining the converted application without calculating the filing date

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of the application retroactively, where inventions not described in the original application have been deleted while amendments of the specification or drawing(s) of the converted application, the examiner shall examine the application based on filing date of the original application.

(Note) Even where the filing date of the application is not retroactively counted since the converted application cannot be accepted, it is possible for the examiner to decide to grant a patent after the delivery of notice for inadmissible conversion if there is no ground for rejection.

② Where the original application was filed on or after October 1, 2006

When a converted application was filed for an invention not described in the original application, the examiner shall notify the applicant of the ground for rejection. When the applicant cannot address the ground for rejection even with the submission of written arguments or amendments, the examiner shall deliver a decision to reject a patent to the applicant.

6.2 Instructions on Examination of Converted Application

(1) The period allowed for amendments to the specification or drawing(s) of a converted application is within the period prescribed in the subparagraphs of Article 47(1) of the Patent Act, retroactively counted from the filing date of the original application.

Where a converted application fulfills the procedural and substantive requirements, the examiner shall regard the converted application as an ordinary application and examine its legality on amendments. In such a case, the initial specification or drawing(s) of the converted application shall serve as the specification or drawing(s) with which the substantive requirements on the amendment are examined. If an invention not contained in the initial specification of the converted application is newly added through amendments after filing the converted application, the examiner shall examine the application in accordance with the requirements of prohibiting the addition of new subject matter. This, too, shall apply to the case of the addition of the invention described in the specification or

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drawing(s) of the original application, but not described in the initial specification or drawing(s) of the converted application.

(2) An applicant can file a converted application by taking a divisional application as the original application. However, the converted application shall not be deemed to be legitimate if division and conversion of an application are carried out in the single patent procedure, such as converting a part of a patent application to a utility model registration application. Where an applicant intends to convert a part of the application to the other type of the application, he/she shall file a divisional application first in the same application form, and then file a converted application based on the divisional application.

(3) When an applicant files a converted application, along with making a request for reexamination regarding the rejected application or making an appeal against the decision to reject the application, the examiner shall accept the application if the procedure for the application is legitimate in terms of the formalities. When a request for examination is made for the converted application, the examiner shall conduct the examination. As for a request for reexamination or an appeal against the decision to reject, the examiner shall carry out the respective procedures with the original application deemed to be withdrawn according to Article 53(4) of the Patent Act (Article 10(4) of the Utility Model Act).

(4) When the original application was pending before KIPO at the time of filing a converted application, but was returned after the conversion of the application, the examiner shall examine the converted application based on the date when it was actually filed, not giving the same filing date of the original application. When the converted application has grounds for rejection, the examiner shall notify the applicant of the reason why his/her application cannot take the retroactive filing date, along with the grounds for rejection. In the absence of any rejection grounds, the examiner shall notify the applicant why the application cannot take the retroactive filing date, through 「On-nara System(EDMS: Electronic Document Management System in Korean Government)」.

(5) A single converted application shall not be filed based on multiple original applications. However, it shall be possible to file a converted application after a single application claiming Domestic Priority has been filed on the basis on two or more prior applications.

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(6) If thirty days have elapsed from the date when an applicant received a certified copy of the initial decision to reject, the applicant shall not file a converted application if the decision to rejected was cancelled through a request for reexamination or a trial decision or if thirty days have not elapsed from the date when a certified copy of the decision to reject was delivered again. It is because that the cancellation of the decision to reject an application through a request for reexamination does not necessarily mean to nullify the fact that a certified copy of the initial decision to reject was delivered for the first time.

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Chapter 3. Application with Priority Claim under Treaty

1. Article 54 of the Patent Act

Article 54 of the Patent Act (Priority Claim under Treaty) ① If a national of a State party to the treaty that recognizes under the treaty the priority for a patent application filed by a national of the Republic of Korea has filed a patent application in the State party to the treaty or another State party to the treaty and makes a priority claim for a patent application filed in the Republic of Korea for the same invention, the filing date in the State party to the treaty is deemed to be the filing date in the Republic of Korea while applying Articles 29 and 36. Where a national of the Republic of Korea who has filed a patent application in the State party to the treaty that recognizes under the treaty the priority for patent applications filed by nationals of the Republic of Korea makes a priority claim for a patent application in the Republic of Korea for the same invention, this provision also applies.

② A person making a priority claim under paragraph (1) shall file a patent application making a priority claim within one year from the filing date from the earliest application which forms a basis of a priority claim.

③ A person making a priority claim under paragraph (1) shall specify the purport of a priority claim, the name of the country in which the application was initially filed and the filing date of the application in the written patent application at the time of filing.

④ A person who has made a priority claim under paragraph (3) shall submit to the Commissioner of the KIPO the documents prescribed in paragraph (i) or the written statement prescribed in paragraph (ii). However, the written statement referred to in paragraph (ii) must be submitted only if the country is prescribed by Ordinance of the Ministry of Knowledge Economy:

1. A written statement certified by the government of the country where the application was initially filed and setting forth the filing date of the patent application and a certified copy of the specification and drawing(s) of the patent application; or
2. A written statement setting forth the application number of the patent application in the country where the application was initially filed.

⑤ Documents under paragraph (4) shall be submitted within one year and four months from the earliest priority date among those prescribed in the following subparagraphs:

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1. The date on which the application was initially filed in the State party to the treaty;
2. Where the patent application contains other priority claims under Article 55(1), the filing date of the application that would be the basis for a priority claim; or
3. Where a patent application contains other priority claims under paragraph (3), the filing date of the application that would be the basis for a priority claim.

⑥ Where a person who has made a priority claim under paragraph (3) fails to submit the document prescribed under paragraph (4) within the designated period under paragraph (5), a priority claim loses its effect.

⑦ A person who complies with the requirements of paragraph (2) among the persons who have made a priority claim under paragraph (1) may amend or add the priority claim(s) within one year and four months from the earliest priority date among those prescribed under paragraph (5).

2. Purport

Priority claim under the Treaty is designed to recognize the filing date in the State party to the treaty as the filing date in the Republic of Korea while applying Articles 29 and 36 of the Patent Act, if a national of a State party to the treaty that recognizes under the treaty the priority for a patent application filed by a national of the Republic of Korea(State parties to the Paris Convention for the Protection of Industrial Property, member states to the Trade-Related Aspects of Intellectual Property Rights agreement or TRIPS as well as the signatory states to the bilateral treaties) has filed a patent application in the State party to the treaty or another State party to the treaty and makes a priority claim for a patent application filed in the Republic of Korea for the same invention.

The multilateral international agreements under which a national of the Republic of Korea is recognized to have a priority claim include the Paris Convention for the Protection of Industrial Property (hereinafter referred to as the Paris Convention) and the WTO-TRIPS Agreement based on the Paris Convention. The bilateral treaties under which a priority claim for a patent application made by a national of the Republic of Korea and a national of the signatory state to the bilateral treaties are recognized in both of the states were signed with Spain (August 15, 1975), the Switzerland (December 12, 1977), the United Kingdom of England (February 19, 1978), the United States (February 30, 1978), Canada (February 13,

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1979) and Finland (September 13, 1979).

(Note) Since January 1, 2002 when Taiwan joined the TRIPS Agreement, a priority claim for an application filed in Taiwan has been accepted under the agreement.

3. Requirements for Priority Claim under Treaty

3.1 Persons who make priority claim under Treaty

(1) A person eligible for making a priority claim under the treaty is a national of a State party to the treaty or a national of a non-State party to the treaty who has a domicile or a real and effective industrial or commercial establishment in a State party. The State parties include the member states of the Paris Convention and the WTO.

When an application claiming a priority under the treaty is filed by two or more applicant, at least one of the applicants shall be a national of a State party to the treaty or a national of a non-State party to the treaty who has a domicile or a real and effective industrial or commercial establishment in a State party.

(Note) The signatories to the European Patent Office (EPO), the Eurasian Patent Organization (EAPO), the organisation Africaine de la Propriété Intellectuelle (OAPI), the African Regional Intellectual Property Organization (ARIPO) are the State parties to the Paris Convention. Therefore, a priority claim can be filed based on the applications filed to the abovementioned patent offices.

(2) A priority claim can be made only after an application was filed in a State party to the treaty (the country where it was initially filed). If an inventor did not file the initial application filed in one of the countries under the Treaty because he/she has granted the right to file a patent application to another person, the inventor cannot make a priority claim for the initial application filed in one of the countries under the Treaty, although it is allowable for the inventor to file a patent application without any priority claim in another country other than the country where the application was initially filed.

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(3) The right to make any subsequent filing in any of the other countries of the Treaty can be transferred to other successors.

(4) The successor eligible for filing an application claiming a priority under the treaty shall be a national of a State party to the treaty both at the time of filing the initial application in one country under the Treaty and at the time of filing any subsequent application in any of the other countries of the Treaty. However, the requirement need not be met during the period from the time of filing the initial application filed in one country under the Treaty to the time of any subsequent filing in any of the other countries of the Treaty. In other words, if a person eligible for the succession of the right to file an application claiming a priority under the Treaty was not a national of a State party at the filing of an application in the country where it was originally filed, but has become a national of the State party before the subsequent filing in any of the other countries of the Treaty, the succession of the right for the priority shall become valid. Also, a national of a State party is allowed to transfer a priority claim to a national of a non-State party to the Treaty and then, the transferee can transfer the priority right back to another national of another State party to the Treaty. In such a case, too, the priority claim shall become effective.

(5) A national of the Republic of Korea can, too, make a priority claim if he/she filed an application in a State party to the Treaty, and then filed an application for the same invention in the Republic of Korea. For example, a national of the Republic of Korea can make a priority claim in the Republic of Korea based on an application which he/she initially filed in the United Kingdom.

(6) Article 54 of the Korean Patent Act provides that a person eligible for filing a priority claim shall be a national of a State party to the Treaty. However, a national of a non-State party shall be allowed to make a priority claim under the Treaty if he/she has a domicile or a business address in a State party to the Treaty. A person without any nationality shall be also deemed as a national of a non-State party to the Treaty. It is because Article 3 of the Paris Convention stipulates that a national of a non-State party to the Treaty who has a domicile or a real and effective industrial or commercial establishment in a State party, too, shall be deemed as a national of a State party to the Treaty. Also, Article 26 of the Patent Act defines that where a treaty contains a patent-related provision that differs from this Act, the treaty

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prevails.

3.2 Time Requirement

(1) The period allowed for filing an application claiming a priority under the Paris Convention shall be as follows.

① Within one year from the filing date of the initial application filed in one of the countries under the Treaty if the priority claim is made based on a patent application or an application for utility model registration

② Within six months from the filing date of the initial application filed in one of the countries under the Treaty if the priority claim is made based on an application for design registration

(2) The time period allowed for filing an application claiming a priority under the Treaty shall be calculated from the day after the filing date of the initial application filed in one of the countries under the Treaty according to Article 4C(2) of the Paris Convention. In such a case, the filing date of the initial application filed in one of the countries of the Treaty shall be the date marked on the evidential documents certifying the priority.

The time period for filing an application claiming a priority under the Treaty shall be calculated in the same manner as calculating the period prescribed in Article 14 of the Patent Act. For example, if the initial application filed in one of the countries under the Treaty was filed on July 4, 2001, any subsequent application in the other countries of the Treaty can be filed by July 4, 2002. If July 4, 2002 is an official holiday or a day when the Korean Intellectual Property Office is not open for the filing of applications, an applicant can file an application claiming a priority under the Treaty by the day after July 4, 2002.

3.3 Substantive Requirement

(1) The initial application filed in one of the countries under the Treaty shall be one of the following applications: a patent application, an application for utility model registration or

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design registration or an inventor's certificate. The Paris Convention does not specify the type of the initial application filed in one of the countries under the Treaty. However, according to Article 4E and 4I of the Paris Convention, the initial application allowed for filing in another country under the Treaty can be translated as a patent application, an application for utility model registration or design registration or an inventor's certificate.

An application for design registration or a service mark shall not be recognized as a basis for a patent application claiming a priority because of their characteristics.

(2) The initial application filed in one of the countries under the Treaty shall be legitimate. The relevant law of the country where the initial application was filed under the Treaty shall determine whether the application is a legitimate application which forms a basis for a priority claim.

Whether the initial application filed in one of the countries under the Treaty which forms a basis for priority claim is pending does not influence the effects of priority claim under the Treaty. In other words, even when the initial application filed in one of the countries under the Treaty has been withdrawn, abandoned, invalidated or rejected, priority claim shall be still effective. Also, even for an application related to an invention for which a patent cannot be granted from a country where the initial application was filed under the Treaty, priority claim shall be still effective.

(3) The initial application filed in one of the countries under the Treaty shall be the earliest application or an application to be recognized as the earliest-filed application. For example, where an applicant filed an application on May 1, 2001 in the United States, claiming a priority based on the application filed on March 1, 2001 in the United Kingdom, and then intended to file an application on April 1, 2002 in the Republic of Korea, he/she could not obviously make a priority claim for the application filed in the United Kingdom since twelve months have elapsed since the filing date of the application in the United Kingdom. Also, even if twelve months have not elapsed from the filing date of the application filed in the United States, the applicant cannot make a priority claim for the same invention since the application filed in the United State is not the earliest application for the same invention. If the earliest application was filed in a country where priority claim cannot be made based on

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the application, the application filed in the country shall not be included in the definition of the earliest application.

(4) In some cases, a subsequent application is filed for the same invention as in the initial application in one of the countries under the Treaty (an prior application). Then, this subsequent filing is deemed to be the earliest application claiming a priority in the country concerned under the Treaty according to Article 4C of the Paris Convention. For this subsequent application to be recognized as the earliest application filed, it shall fulfill the all of the requirements below.

① The subsequent application shall be filed for the same invention in the same country where the initial application was filed.
② The prior application shall be withdrawn, abandoned or rejected before the subsequent application is filed.
③ The prior application shall not be published.
④ Any rights shall not be effective because of the prior application.
⑤ The prior application shall not serve as a basis for a priority claim in the same or different countries.

4. Proceedings for Priority Claim under Treaty

(1) A person who intends to make a priority claim under the Treaty shall write the purport of the priority claim and the country name as well as the filing date of the earliest application in a written patent application. Also, the earliest application number which forms a basis for a priority claim shall be indicated in the written application (Article 4D(5) of the Paris Convention shall be referred).

Also, a person who intends to make a priority claim shall make related payments upon making the priority claim under the Treaty.

(2) A person who has made a priority claim to under the Treaty shall submit to the commissioner of KIPO the documents containing the application date recognized by the

government of the country where the initial application was filed as well as the copy of the specification or drawing(s) of the invention within one year and four months from the priority date (the earliest priority date among the priority dates when a subsequent filing contains multiple priority claims). However, in the countries designated in the Enforcement Decree of the Patent Act, the submission of evidential documents certifying a priority claim can be replaced with submitting evidential documents containing the application numbers in the country where the initial application was filed.

When evidential documents certifying a priority claim are not submitted within the designated period, the priority claim shall lose its effects.

(3) The countries with the streamlined procedures for the submission of evidential documents certifying a priority claim currently include Japan, signatories to the European Patent Convention (EPC) and countries which have agreed upon the online delivery of evidential documents certifying the priority through the Digital Access System (DAS) of the World Intellectual Property Organization (WIPO). These countries are published in 「the official announcements on the online exchange of evidential documents for a priority claim」.

Whether a country in which an application is filed falls into the countries with the streamlined procedures for the submission of evidential documents certifying a priority claim shall be determined based on the filing date of the application in the Republic of Korea, regardless of the filing date of the initial application in any of the countries under the Treaty, the designated period for the submission of evidential documents for a priority claim, the date when additional claims for a priority are added. Where an application claiming a priority under the Treaty was filed based on an application filed in Japan after July 1, 2001 (an application filed in the signatories to the EPC, the United States and the countries with access to the DAS of the WIPO after July 1, 2007, October 14, 2008 and July 1, 2009, respectively), submitting the documents containing the application number of the initial application in one of the countries under the Treaty or writing the initial application number in a written patent application can replace the submission of the evidential documents certifying a priority claim..

(Note1) Only the application filed to the EPO can replace the evidential documents

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certifying the priority of the applications filed in the signatories to the EPC. In the meantime, the USPTO provides KIPO with the undisclosed evidential documents certifying the priority only when a written authorization to permit access to application by participating offices; PTO/SB/39) is submitted. This is possible only when the USPTO can confirm the condition in which KIPO can be provided with the concerned evidential documents certifying the priority through an electronic exchange within the period designated for the submission of evidential documents for priority claim. Also, as for the countries with access to the DAS of WIPO, since KIPO should be able to secure the concerned evidential documents from the DAS of WIPO only with the application numbers, the countries with access to the DAS of the WIPO, too, can confirm the condition in which KIPO can be provided with the concerned evidential documents certifying the priority through an electronic exchange within the period designated for the submission of evidential documents for a priority claim. For example, the requests for access to the DAS shall be made in advance in the country where the initial application was filed.

(Note2) Where multiple priority claims are made based on both the application filed in the country which has the streamlined procedure for the submission of evidential documents certifying the priority and the application filed in the country without the streamlined procedure, only the evidential documents certifying the priority in the application filed in a country with the streamlined procedure can replace the documents containing the application number. However, the evidential documents claiming a priority in the application filed in the country without the streamlined procedures for the submission of evidential documents certifying the priority shall be submitted based on the existing procedure according to Article 54(1)(1) of the Patent Act.

(4) Where an examiner, under the name of the Commissioner of KIPO, requires the applicant to submit the Korean translation of the evidential documents claiming a priority within the designated time period in order to determine the patentability in such cases as that a prior art exists between the priority date and the filing date of the application claiming a priority under the Treaty, the applicant shall submit the Korean translation of the evidential documents claiming a priority within the designated time period to the examiner. In this case, the allowed period is for two months and shall be extendable.

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Where the examiner requests the applicant to submit the Korean translation of the evidential documents claiming priority, but the translation is not submitted within the designated period, the examiner can invalidate the proceedings for the concerned priority claim under the Treaty.

(Note) Since the translation of the evidential documents certifying the priority is just a reference material for proving the priority claim, amendments to the translation shall be deemed to be valid, even with the substantial changes in the contents of the translation.

5. Effects of Priority Claim under Treaty

Where a priority claim under the Treaty is legitimate, the same invention as the invention described in the initial application filed in one of the countries under the Treaty shall retain the same filing date as the filing date of the initial application in accordance with Articles 29, 36 of the Patent Act. Any invention excluded in the initial application filed in one of the countries under the Treaty shall not take the same filing date as the filing date of the initial application even if the priority claim for the invention is valid.

(Note) Except for the certain cases mentioned in the Patent Act, the filing date of an application claiming a priority under the Treaty shall be deemed to be the actual filing date. For example, in applying the provisions regarding a claim for non-prejudicial disclosure in Article 30 of the Patent Act, if the applicant did not file an application claiming a priority under the Treaty within twelve months after the disclosure of the application, the applicant may lose novelty or inventive step for his/her invention even if the applicant filed an application claiming a priority within one year from the filing date of the initial application filed in one of the countries under the Treaty.

6. Amendment to Priority Claim under Treaty

(1) The period allowed for amendment or addition of priority claim is within one year and four months from the earliest filing date. The designated time period for multiple priority claims containing Domestic Priority claim is also one year and four months. Where additional priority claims are added under the Treaty or part of priority claims has been withdrawn, the

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earliest filing date shall be calculated reflecting the addition or withdrawal of the priority claims under the Treaty.

(2) Article 54(7) of the Patent Act dictates that a person eligible for amendments to a priority claim under the Treaty is 'the one who fulfills the requirement of paragraph(2) among the persons who have made a priority claim according to paragraph(1) of the same article'. Therefore, in order to amend or add a priority claim, an applicant shall have made a priority claim at the time of filing an application in accordance with Article 54(1) of the Patent Act and at least one of the priority claims under the Treaty made at the time of filing the application shall meet the requirement specified in Article 54(2) of the Patent Act.

Whether an applicant has made a claim for priority under the Treaty shall be determined based on whether more than one priority claim can be specified based on the description regarding the priority claim in the column 【Priority Claim】 in the written application submitted at the time of filing the application.

If a priority claim under the Treaty does not fulfill the requirements specified in Article 54(1) and (2) of the Patent Act, the priority claim shall be deemed to have uncorrectable errors. Therefore, in such a case, amendments or addition of a priority claim under the Treaty shall not be accepted.

(Note) Where an applicant filed an application claiming a priority under the Treaty based on a hypothetical application, an application which another party filed or an application which cannot be specified, the applicant shall not amend or add a priority claim since the priority claim is basically invalid.

(3) Where a priority claim under the Treaty has been withdrawn or invalidated, where an application claiming for priority under the Treaty has been invalidated, withdrawn or abandoned, where the examiner made a decision to grant/reject a patent in the application, the applicant shall not amend or add the priority claim. Also, after the applicant has withdrawn all of priority claims under the Treaty, the applicant cannot amend or add the priority claim. However, after the priority claim has been withdrawn, adding a priority claim on the same date shall be accepted.

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The time at which the abovementioned decision of patent is confirmed is when a certified copy of the decision to grant a patent is delivered to the applicant. Meanwhile, the time at which the decision to reject a patent is confirmed is when thirty days have elapsed from the date on which a certified copy of the decision to reject a patent is delivered to the applicant.

(4) Within one year and four months from the earliest filing date, the withdrawal of all priority claims, withdrawal of part of priority claims in multiple priority claims as well as the amendment of correcting clerical errors in priority claims and amendment of adding priority claims shall be accepted.

Where amendment of withdrawing priority claims and adding priority claims within the abovementioned period, an applicant need not submit a document for withdrawal for his/her convenience and the applicant can just submit a written amendment containing such contents for the priority claim to be recognized as valid.

(5) Amendments of a priority claim after one year and four months has elapsed shall be accepted when correcting clerical errors in the description of the priority claim. In other words, amendments of changing the initial application in one of the countries under the Treaty, amendments of specifying the initial application in one of the countries under the Treaty which has not been specified before or amendments of adding the initial application in one of the countries under the Treaty shall not be accepted.

However, even in the abovementioned period, the withdrawal of all of priority claims or the withdrawal of part of priority claims in multiple priority claims shall be accepted.

7. Examination of Application Claiming Priority under Treaty

7.1 Flowchart of Examination Procedure on Priority Claim under Treaty

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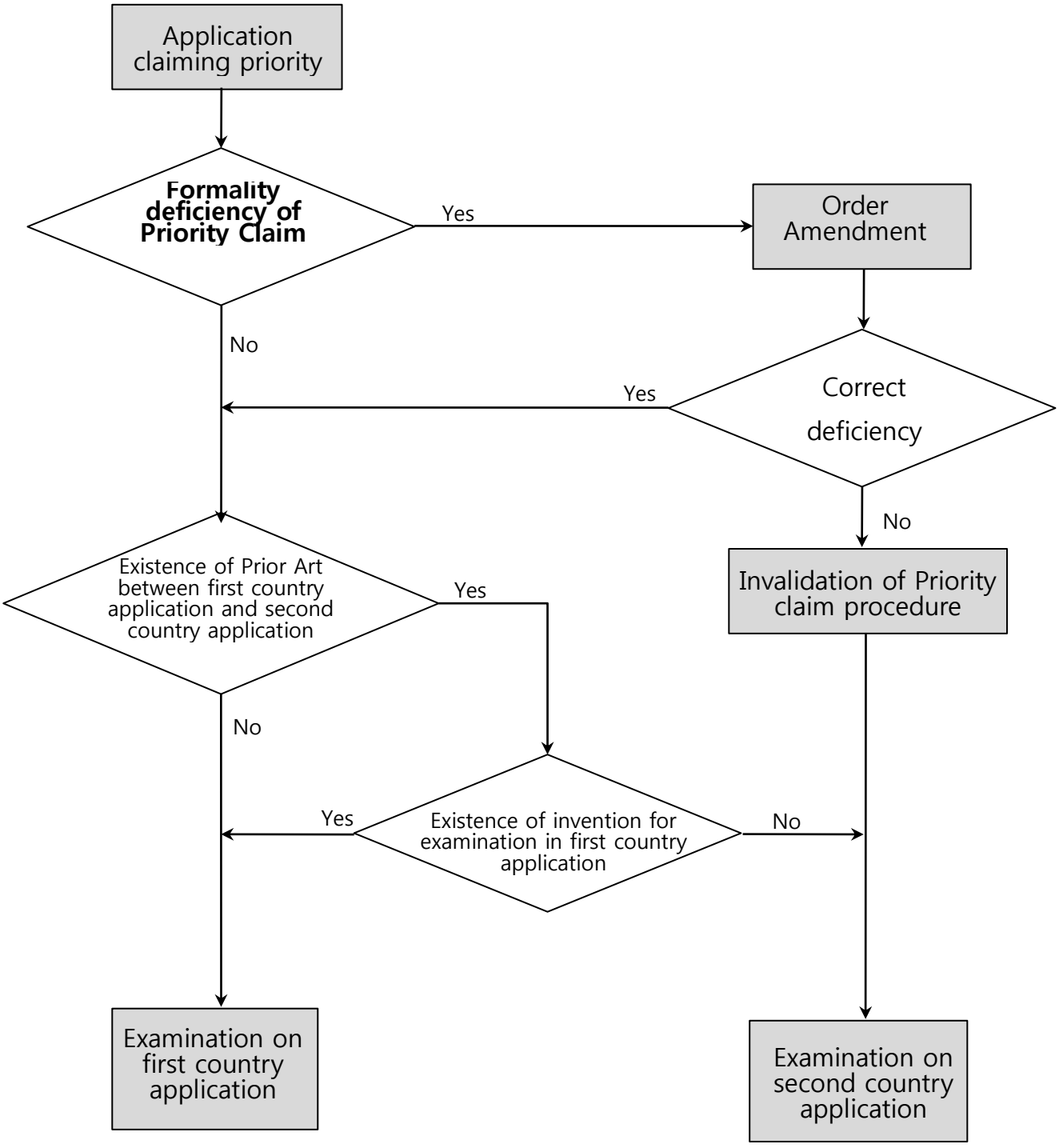

7.2 Overview of Examination

(1) Once an application claiming priority under the Treaty or a written amendment to priority

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claim under the Treaty is submitted, the examiner shall examine the formalities of priority claim based on the patent application or the written amendment. Unless any deficiency is found in priority claim, the examiner shall carry out the substantive examination procedure.

Where the prior art search in the substantive examination reveals that any prior art according to Article 29 of the Patent Act or any prior application specified in Article 36 of the Patent Act is not found between the filing date of the initial application filed in one of the countries under the Treaty and the filing date of the application claiming priority under the Treaty, the examiner shall examine the patentability prescribed in Article 29 or 36 of the Patent Act based on the filing date of the initial application in one of the countries under the Treaty. However, if any prior art exists between the filing date of the initial application under the Treaty and the filing date of the application claiming priority under the Treaty, the examiner shall examine whether the invention described for examination in the application claiming priority under the Treaty was described in the initial application filed in one of the countries under the Treaty. In such a case, the examiner can request the applicant to submit the translation of the evidential documents certifying the priority claim.

If the invention described in the application claiming priority under the Treaty is deemed to be identical with the one in the initial application filed in one of the countries under the Treaty after comparison of both applications, the examiner shall examine the patentability of the invention based on the retroactive filing date of the initial application under the Treaty. However, if inventions are not deemed to be identical through comparison, the examiner shall examine the patentability based on the filing date of the application claiming priority under the Treaty. When the examiner delivers grounds for rejection without giving a retroactive filing date, he/she shall describe the reason why the retroactive filing date has not been granted, along with the grounds for rejection.

7.3 Formality Examination of Application Claiming Priority under Treaty

(1) As for an application claiming priority under the Treaty, the examiner shall first examine the formality requirements for the priority. When the examination reveals that priority claim is found to be illegitimate, the examiner shall request an applicant to amend the application. If the applicant did not address the deficiency in the priority claim within the designated

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period, the examiner can invalidate the proceedings for the priority claim. In such a case, it should be noted that even though the proceedings for priority claim has become invalidated, an application containing priority claim shall be treated to be valid as a normal application without any priority claim.

(2) The requirements for formality examination on priority claim under the Treaty include: the identicalness of the applicants, the earliest filing date of the initial application filed in one of the countries under the Treaty, the legitimacy of the initial application, the compliance with the priority period, the description of the purport of priority claim and the submission of the evidential documents certifying the priority claim.

(3) In determining whether the initial application filed in one of the countries under the Treaty is the earliest application based on a legitimate internal application, where the examiner has noticed during the examination that the evidential documents certifying the priority state the purport of the evidential documents certifying the priority according to the Paris Convention except for any particular reasons, he/she shall accept the initial application without conducting the investigation to determine whether the application is the earliest filed application as a legitimate initial application under the Treaty.

(Note1) Where deficiencies are identified in part of multiple priority claims, the examiner shall request the applicant to amend only priority claims containing deficiencies. Where the applicant has not addressed the deficiencies within the designated period, the examiner shall invalidate priority claims whose deficiencies were not addressed, other than invalidating all of priority claims.

(Note2) The evidential documents certifying the priority in an international patent application can be checked through the evidential documents for priority claims posted onto the Patent Net (on the webpage for search on the international stage). If the evidential documents certifying the priority are not available on the Patent Net, the examiner can access the attached documents by looking up the international patent number on the WIPO website (http://www.wipo.int/pctdb/en). When the submission of the evidential documents certifying the priority is not confirmed even through the above-mentioned procedure, the examiner shall make

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a request for amendment to the applicant and then determine whether to invalidate priority claim after considering the submission of the evidential documents certifying the priority as well as the grant of the opportunity to explain to the applicant.

7.4 Substantive Examination on Application Claiming Priority under Treaty

(1) If the examiner has invalidated priority claim since the claim is illegitimate based on the result of the formality examination regarding priority claim under the treaty and amendment to priority claim, the examiner shall examine the application, regardless of the identicalness of the inventions, based on the filing date of a priority claim under the Treaty (the filing date in the Republic of Korea).

(2) Where priority claim is found to be legitimate based on the results of the formality examination regarding priority claim under the Treaty, the examiner shall determine whether to grant a retroactive filing date by invention when examining the patentability of the inventions. In other words, as for the invention identical to the one described in the documents regarding the initial application in one of the countries under the Treaty (including the specification and drawing(s)), the examiner shall examine the invention based on the filing date of the initial application in one of the countries under the Treaty in accordance with Articles 29 and 36 of the Patent Act. If the concerned invention is different from the one described in the documents regarding the initial application in one of the countries under the Treaty, the examiner shall examine the invention based on the filing date of priority claim under the Treaty.

(Example1) An invention comprising the alcohol composed of one to ten carbon atoms has been patented in Korea. However, the specification of the invention in the initial application under the Treaty forming the basis of priority claim indicates that the alcohol contains one to five carbon atoms. In such a case, the examiner shall examine the alcohol with one to five carbon atoms based on the priority date while examining the alcohol with six to ten carbon atoms based on the date when the application was filed in Korea.

(Example2) The specification of the initial application under the Treaty indicates anticorrosion

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steel comprising chrome. However, the application claiming a priority specifies anticorrosion steel containing chrome as well as anticorrosion steel with alloy of chrome and aluminum. In such a case, the examiner shall examine anticorrosion steel containing chrome base on the filing date of the initial application under the Treaty while examining anticorrosion steel with alloy of chrome and aluminum based on the date when the application was actually filed in Korea.

(Example3) An application claiming priority specifies a tube placed between a cathode, control grid, anode, screen grid and anode; and having a third lattice sustained by a cathode and electrokinetic potential. In such a case, the examiner shall examine the tube based on the date when the application was actually filed where the specification and drawing(s) of the initial application under the Treaty only describes the tube having a cathode, control grid, anode, screen grid and anode.

(3) The requirements for the identicalness of the inventions in order to grant the retroactive priority date for patentability does not necessarily mean that the inventions described in the claims of both an application claiming priority under the Treaty and the initial application filed in one of the countries under the Treaty must be identical. Rather, it means that the invention described in the claims in the application claiming priority under the Treaty shall be identical to the invention in the specification or drawing(s) of the initial application under the Treaty. Whether the invention described in the application claiming priority under the Treaty is the same as the invention described in the initial specification and drawing(s) of the initial application under the Treaty shall be determined in applying the standard to determine the identicalness in Article 29(3) of the Patent Act.

The inventions described in the initial application under the Treaty and the application claiming priority under the Treaty shall be deemed to be identical in the following cases.

① Where an application claiming priority under the Treaty is filed for part of the application initially filed in one of the countries under the Treaty
② Where two or more applications claiming priority under the Treaty are filed based on the divisional application of the initial application under the Treaty
③ Where a single application claiming priority under the Treaty is filed based on more

than two initial application under the Treaty

(Note) Even when an invention excluded from the initial application under the Treaty which forms the basis of priority claim is described in the application claiming priority under the Treaty, priority claim shall be acknowledged for the invention included in the initial application under the Treaty. That is to say that priority claim can be or cannot be acknowledged by invention.

(4) An application claiming priority under the Treaty including more than two priority claims (multiple priority claims) shall be treated as follows.

① Where a single application claiming priority is filed based on multiple initial applications under the Treaty, the examiner shall not reject the priority claim or the application citing that the application claiming priority was filed based on two or more initial applications. However, when the inventions of the applications claiming priority are not recognized to be identical, the examiner can deliver the ground for rejection citing the violation of Article 45 of the Patent Act.

② Where the examination reveals that the application does not meet the requirement of identicalness of inventions, the applicant is allowed to divide the application. Even so, the applicant can enjoy the benefit of priority claim for each application after division.

③ Where a patent application filed in Korea has priority claim for more than two initial applications under the Treaty, the examiner shall examine the application based on the earliest filing date of each invention under the Treaty in accordance with Articles 29 and 36 of the Patent Act.

④ Despite having made priority claim based on two or more initial applications under the Treaty, where an invention in a patent application filed in Korea is based on one of the initial applications, the examiner shall examine the invention based on the filing date of the initial application describing the invention to determine the patentability of the invention.

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⑤ As for an application claiming priority based on two or more initial applications under the Treaty, where an invention consists of the subject matter separately described in each of the initial applications under the Treaty, the examiner shall examine the invention based on the actual filing date of the application in Korea. For example, in Application C claiming the multiple priority claim based on Applications A and B, claim 「a+b」 is set forth by combining 「a」 only described in Application A and 「b」only described in Application B, the examiner shall determine the patentability of Invention 「a+b」 based on the filing date of Application C.

⑥ Where a priority claim in the initial application under the Treaty having the earliest filing date has been withdrawn among more than two priority claims, the filing date of the earliest-filed application shall be deemed to be the priority date. In such a case, however, the examiner shall determine whether the initial application under the Treaty, which has newly become the earliest-filed application, meets the requirement of serving as the earliest-filed application that can be the basis of a priority claim under the Paris Convention.

7.5 Instructions on Examination of Application Claiming Priority under Treaty

(1) Countries around the world have various types of patent application systems for the protection of inventions. However, in reality, it is difficult for each patent office to review whether all of the applications submitted to their offices are legitimate domestic applications seeking priority claim under the Paris Convention. Therefore, each patent office can determine whether their applications are legitimate domestic applications seeking priority claim under the Paris Convention, and then issue the evidential documents for priority claim. As a result, the other patent offices can recognize priority claim of the concerned applications based on the content of the issued evidential documents for priority claim.

(2) An application claiming priority under the Treaty based on the application filed in the United States shall be examined as follows.

① Where a priority claim under the Treaty is based only on the continuation-in-part application (hereinafter referred to as CIP application) in the United States

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Where a priority claim was based only on the CIP application and only the specification of the CIP application was submitted as the evidential documents for priority claim, the examiner shall examine the inventions based on the date to determine the patentability without the grant of the retroactive filing date. Then, if the specification or drawing(s) of the original application is submitted, the examiner shall follow the examination guideline ②.

Where an invention for which an application claiming a priority under the Treaty was filed is only described in the specification or drawing(s) of the CIP application, the date to determine the patentability of the concerned invention shall be the filing date of the CIP application. If an invention for which an application claiming priority under the Treaty is described in the specifications of the original application as well as the CIP application in the United States, the date to determine the patentability of the concerned invention shall be the filing date of the application claiming priority under the Treaty.

② Where priority claim under the Treaty is based on the original application as well as the CIP application in the United States

Where an application claiming a priority under the Treaty is filed within one year from the filing date of the original application in the United States, the subject matter described both in the specification or drawing(s) of the original application and the CIP application among the inventions for which an application was filed in Korea shall take the filing date of the original application as the date to determine the patentability of the invention. Meanwhile, the subject matter only described in the specification or drawing(s) of the CIP application shall take the filing date of the CIP application as the date to determine the patentability of the invention. However, where an application claiming priority under the Treaty is filed when one year has elapsed from the filing date of the original application in the United States, the subject matter described in the specification or drawing(s) of the original application as well as the CIP application among the inventions for which an application was filed in Korea shall not take the retroactive date to determine the patentability for the invention. Meanwhile, the subject matter only described in the specification or drawing(s) of the CIP application shall take the filing date of the CIP application as the date to determine the patentability of the invention.

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Priority claim defined in the Paris Convention is made only based on the initial application filed in one of the State Parties under the Treaty. Therefore, as for the subject matter described in the specification or drawing(s) of the original application as well as the CIP application, the examiner shall treat the subject matter in the abovementioned manner, since the CIP application is not recognized as the initial application prescribed in Article 4C(2) of the Paris Convention.

(Explanation) Since the CIP application is filed based on the specification or drawing(s) of the original application, it is not recognized as the initial application prescribed in Article 4C(2) of the Paris Convention. Therefore, in principle, a priority claim under the Treaty of the CIP application cannot be recognized. However, the exception shall be the following case: where the copy of the specification or drawing(s) (through which the examiner can confirm the filing date, the application number and the contents of the evidential documents) of the original application (including the application number) has been submitted and the concerned application claiming priority under the Treaty is ensured to be the application claiming priority based on the subject matter described only in the specification or drawing(s) of the CIP application.

④ Where a priority claim under the Treaty is based on the provisional application or the non-provisional application in the United States

Provisional applications filed on non-provisional applications under the U.S. Patent Act include provisional applications requesting the benefit (priority claim) of non-provisional applications in accordance with Article 111(b) of the U.S. Patent Act; and provisional applications converted from non-provisional applications according to Article 119(e) of the U.S. Patent Act. Since an application that can serve as a basis of priority claim changes based on the different kinds of the provisional application, the examiner shall determine the legality based on to which application the USPTO has issued the evidential document for priority claim (priority documents, certified copy of the original application). It is because the fact that the USPTO has issued the applicant with the evidential documents certifying the priority for the provisional application means that the USPTO has recognized

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the non-provisional application as the non-provisional domestic application which serves as a basis for priority claim under the Paris Convention.

Normally, where a non-provisional application has not been filed after the filing of the provisional application, the provisional application shall serve as a basis of priority claim. Where a non-provisional application is filed after converting the provisional application, the provisional application loses its status. Therefore, a basic application for priority claim under the Paris Convention is a non-provisional application and the priority period starts on the filing date of the provisional application recognized as the filing date of the legitimate application. Where a non-provisional application has been filed while claiming the benefit (priority claim) of the provisional application, the provisional application shall be a basic application and the priority period for the application begins on the filing date of the provisional application.

(3) Where the evidential documents certifying the priority under the Treaty are not submitted within one year and four months from the earliest filing date, the concerned priority claim shall lose its effect. That evidential documents certifying the priority have not been submitted means when only the evidential documents certifying the priority are submitted, other than the specification or drawing(s).

Where the evidential documents certifying the priority have not been submitted within the one year and four month period, the examiner shall request an amendment and invalidate the priority claim procedure. In such a case, the procedural error that the evidential documents certifying the priority have not been submitted cannot be addressed. That is because the evidential documents certifying the priority is returned even though the documents are submitted within the designated period for the request for amendments, since the statutory period allowed for the submission of the evidential documents for a priority claim.

Meanwhile, even though the evidential documents certifying priority of an international patent application have not been submitted to the WIPO within one year and four months, the examiner shall grant the applicant with the opportunity to submit the evidential documents certifying priority after entering the national stage. When the evidential

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documents claiming priority are submitted in response to the amendment request, the examiner shall accept the evidential documents.

(4) Where a priority claim under the Treaty based on the initial application submitted to the country with the streamlined procedure for the submission of the evidential documents certifying priority is made and the application containing the application number is filed, the examiner shall check whether the KIPO was able to be offered with the concerned evidential documents certifying the priority through the electronic exchange, except for the application based on the applications submitted to JPO and EPO. Where the record of exchange of the evidential documents within the submission period for the documents cannot be checked, the examiner shall make a request for amendments regarding the concerned priority claim and invalidate the priority claim.

In principle, where the evidential documents certifying priority are submitted or exchanged after the designated period, the priority claim loses its effect in accordance with Article 54(6) of the Patent Act. However, where the applicant has completed all the legitimate procedures in order to exchange the evidential documents both in Korea and the country where the initial application was filed under the Treaty, the examiner shall regard the evidential documents certifying the priority submitted or exchanged after the expiration of the submission period as legitimate and recognize the concerned priority claim to be legitimate.

(5) Where one year and four months have elapsed from the earliest filing date even though the designated period has been extended because of the amendment request by the examiner, it should be noted that amendments such as addition of priority claim cannot be made.

The period allowed for amendment or addition of priority claim according to Article 54(7) of the Patent Act is statutory and it cannot be extended after one year and four months according to Article 54(7) of the Patent Act. Therefore, even if the request for amendment of priority claim has been made within one year and four months from the earliest filing date, amendments such as addition of priority claim cannot be accepted when one year and four months has elapsed from the earliest filing date.

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In such a case, the examiner can describe the purport of refusing amendments or addition of a priority claim prescribed in Article 54(7) of the Patent Act in the written request for amendment.

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Chapter 4. Application with Domestic Priority Claim

Article 55 of the Patent Act (Priority Claim Based on a Patent Application etc.) (1) An applicant for a patent may make the priority claim based on an invention disclosed in the specification or drawing(s) originally attached to a written application of an prior application for a patent or utility model registration (referred to as "an prior application", hereinafter), for which the applicant has the right to obtain a patent or utility model registration. However, this shall not apply to the cases which fall under any of the following subparagraphs:

(i) where the patent application is filed more than one year after the filing date of the prior application;
(ii) where the prior application is a divisional application under Article 52(2) (including those cases to which this Article applies *mutatis mutandis* under Article 11 of the Utility Model Act) or a converted application under Article 53 of this Act or Article 10 of the Utility Model Act;
(iii) where the prior application has been abandoned, invalidated, or withdrawn when the patent application is filed;
(iv) where an examiner's decision to grant or reject the prior application or a trial decision thereto has become final and binding, when the patent application is filed.

(2) A person making the priority claim under paragraph (1) shall state the purport of the priority claim and indicate the prior application in the written patent application when the patent application is filed.

(3) A patent application that contains a priority claim under paragraph (1) is deemed to have been filed when the prior application was filed when Articles 29(1) or (2), and (3) (main sentence), 30(1), 36(1) to (3), 96(1)(iii), 98, 103, 105(1) and (2), 129, and 136(4) (including those cases to which Article 136(4) applies *mutatis mutandis* under Article 133bis(4)) of this Act, Article 7(3) and (4) and 25 of the Utility Model Act and Articles 45 and 52(3) of the Design Law are applied to an invention that is identical to the invention that have been

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disclosed in the specification or drawing(s) originally attached to a written application of the prior application that is the basis for the priority claim.

(4) In applying the main sentence of Article 29(3) of this Act and the main sentence of Article 4(3) of the Utility Model Act, an invention disclosed in the specification or drawing(s) originally attached to a written application of a patent application containing a priority claim under paragraph (1), that is identical to an invention disclosed in the specification or drawing(s) originally attached to a written application of an prior application that is the basis for the priority claim, is deemed to have been laid open with regard to the prior application that is the basis for the priority claim at the time when the application is laid open or at the time of publication of registration.

(5) Where the prior application falls under any of the following subparagraphs, paragraphs (3) and (4) of this Article shall not apply to an invention, among inventions disclosed in a specification or drawing(s) originally attached to a written application of the prior application, disclosed in a specification or drawing(s) at the time of filing of a patent application that forms the basis of priority claim with regard to the prior application:

(i) the prior application contains a priority claim under paragraph (1); or

(ii) the prior application contains a priority claim under Article 4D(1) of the Paris Convention for the Protection of Industrial Property.

(6) In applying paragraph (4), where the prior application falls under one of the following subparagraphs, "an invention or device described in the specification, claim(s) or drawing(s) of both the international application as of the international filing date and its translation" in Article 29(4) reads "an invention or device described in the specification, claim(s) or drawing(s) of the international application as of the international filing date":

(i) the prior application is an international application that is deemed to be a patent application in accordance with Article 199(1) (including an international application that is deemed to be patent application in accordance with Article 214(4)); or

(ii) the prior application is an international application that is deemed to be a utility model registration application in accordance with Article 34(1) of the Utility Model Act (including an international application that is deemed to be a utility model

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registration application in accordance with Article 40(4) of the Utility Model Act).

(7) A person who makes the priority claim and complies with the requirements under paragraph (1) may amend or add the priority claim(s) within one year and four months from the filing date of the prior application (the earliest filing date if two or more prior applications exist).

Article 56 of the Patent Act (Withdrawal of a Prior application etc.) (1) An prior application which is the basis of the priority claim under Article 55(1) is deemed to have been withdrawn when more than one year and three months has elapsed after the filing date of the prior application. However, this shall not apply where the prior application falls under any of the following subparagraphs:

(i) if the prior application has been abandoned, invalidated, or withdrawn;
(ii) if an examiner's decision to grant or reject the prior application or a trial decision thereto has become final and binding;
(iii) if priority claims based on the concerned prior application have been withdrawn; or
(iv) deleted.

(2) The applicant of a patent application containing a priority claim under Article 55(1) may not withdraw the priority claim more than one year and three months after the filing date of the prior application.

(3) Where a patent application containing a priority claim under Article 55(1) has been withdrawn within one year and three months after the filing date of an prior application, the priority claim is deemed to have been withdrawn simultaneously.

2. Purport

Priority claim based on a patent application (hereinafter, referred to as 'Domestic Priority claim') is designed to ensure protection for an invention which has been developed, based on a patent application (hereinafter, referred to as 'prior application'), to further specify,

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improve or add to the prior application.

Previously, where an invention which specified, improved, or added to an prior application was filed in an ordinary patent filing process, the invention was rejected since it was the same invention as in its own prior application. Or, adding an improved invention to the prior application by amending the specification or drawing(s) of the prior application could lead to a decision of rejection, citing addition of new matter. Therefore, priority claim based on a patent application was introduced to address such irrationality and protect all of inventions, which are the outcomes of technological development. Through this process, an invention which is identical with the invention disclosed in the prior application is deemed to have been filed on the date of filing the prior application and an invention newly added to the application is deeded to have been filed on the date of filing the application claiming Domestic Priority.

3. Requirements for Domestic Priority Claim

3.1 Persons who can file Application Claiming Domestic Priority

(1) A person who can make a domestic priority claim is the applicant of the prior application (including a successor in title under Article 38(4) of the Patent Act). The applicants of both the prior application and the subsequent application shall be identical at the time of filing the subsequent application.

(2) Where an application is jointly filed, the applicants of the subsequent application shall be the same as the applicants of the prior application. To prove the identicalness of the applicants of both the prior application and the subsequent application, the following items shall be identical: the residential or business address of the applicants, the name or title of the applicants and the seals of the applicants.

3.2 Time Requirement

A subsequent application shall be filed within one year from the filing date of the prior

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application.

3.3 Substantive Requirement

(1) A domestic priority claim can be made based on the invention disclosed in the specification or drawing(s) originally attached to the prior application. Even the invention disclosed in the specification or drawing(s), other than in the claims, can be the basis of a domestic priority claim.

(2) The prior application shall be neither a divisional application nor a converted application. However, a divisional application or converted application can be filed based on the application claiming Domestic Priority.

(Note) The reason why a divisional application and a converted application cannot serve as the basis of a domestic priority claim is to increase the efficiency of the examination. Otherwise, in determining whether priority claim is valid or not, the examiner would have had to determine whether the applicants of both the earlier applicant and a divisional or converted application are identical and the invention described in the application claiming a domestic priority is identical with that of a divisional application or converted application. Also, the examiner would have had difficulty in calculating the period allowed for the filing of a subsequent application based on a divisional or converted application.

(3) The prior application shall not be invalidated, withdrawn or abandoned or a decision to grant a patent or utility model registration shall not become final and binding at the time of filing an application claiming a domestic priority.

The time at which the decision to grant a patent or utility model registration has become final and binding is when a certified copy of a decision to grant a patent or utility model registration is delivered to the applicant. Also, the time at which the decision to reject a patent or utility model registration has become final and binding is when thirty days have elapsed since the applicant received a certified copy of a decision to reject a patent or utility model registration.

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(Note) Where the prior application has been withdrawn or abandoned on the filing date of the application claiming a domestic priority, the priority claim is deemed to be valid. As long as it is clear that a domestic priority claim has been made earlier than the time at which the prior application was invalidated, the priority claim is deemed to be valid.

4. Procedure of Domestic Priority Claim

(1) A person making a domestic priority shall state the purport as well as the prior application in the written patent application at the time of filing an application claiming a domestic priority.

(2) The submission of the evidential document for priority is not necessary in the procedure for making a domestic priority. Whether the domestic priority claim is valid or not shall be determined based on a written prior application.

(3) When taking advantage of the provision of Article 30 of the Patent Act which has been applied at the time of filing the prior application, while filing an application claiming a domestic priority, the applicant shall state the purport and submit the evidential documents under Article 30(2) of the Patent Act within the statutory period. However, where the contents of the above-mentioned evidential documents are the same as those of the documents submitted regarding the prior application, the applicant can state the purport and indicate the evidential documents of the prior application in an application claiming a domestic priority.

Where a claim for exception to the public disclosure has not been made at the time of filing the prior application, making such claim at the filing time of an application claiming a domestic priority shall not be acknowledged.

(Note) A priority claim under the Treaty cannot take the retroactive filing date under Article 30 of the Patent Act, whereas a domestic priority claim can retain the retroactive filing date.

(4) When taking advantage of the provision of Article 55(1) of the Patent Act to file a divisional application or converted application based on an application claiming a domestic

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priority, the domestic priority claim shall be made at the time of filing the divisional application or converted application.

5. Effect of Domestic Priority Claim

(1) As for an invention identical with the one disclosed in the specification or drawing(s) of the prior application which forms the basis of the priority claim, among the inventions in the application claiming a domestic priority, the subsequent application is deemed to have been filed at the time of filing the prior application in applying the following requirements.

① Article 29(1),(2) of the Patent Act(Novelty, inventive Step)
② The main sentence of Article 29(3) of the Patent Act(Status of enlarged concept of novelty)
③ Article 30(1) of the Patent Act(Exception to the public disclosure)
④ Article 36(1) to (3) of the Patent Act(Prior application, the same purport as Article 7 (3), (4) of the Utility Model Act)
⑤ Article 96(1)(3) of the Patent Act(Scope where the effect of a patent right does not extend)
⑥ Article 98 of the Patent Act(Use of patented invention, registered utility model and registered design of another person, Conflict between a patent right with a design right, the same purport as Article 23 of the Utility Model Act and Article 45 of the Design Protection Act)
⑦ Article 103 of the Patent Act (Non-exclusive license by prior use)
⑧ Article 105(1), (2) of the Patent Act(Non-exclusive license after the expiry of the duration of the design right, the same purport as Article 52(3) of the Design Protection Act)
⑨ Article 129 of the Patent Act(Presumption of the patented process to manufacture)
⑩ Article 136(4) of the Patent Act (Trial for a correction)

(2) Where a prior application contains a domestic priority claim or a priority claim under the Paris Convention, recognizing the priority claim twice to inventions disclosed in the application which forms the basis of such claim in a subsequent application would technically mean the extension of the priority period. Therefore, the priority claim of the

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above-mentioned invention shall not be acknowledged, whereas the effects of the priority claim shall be on inventions newly added to the prior application.

(Note) To enjoy the effects of the priority claim even on the inventions disclosed in the basic application of the prior application, the multiple priority claims shall be made based on the basic application of the prior application in a subsequent application.

(3) The prior application which forms the basis of a domestic priority claim is deemed to have been withdrawn when one year and three months have elapsed from the filing date of the prior application. However, where the prior application has been invalidated, withdrawn or abandoned or a decision to grant a patent or utility model registration has become final and binding, no application is deemed to have been withdrawn since there is no application deemed to have been withdrawn. Also, when a domestic priority claim based on the prior application has been withdrawn within one year and three months from the filing date of the prior application, the prior application is not deemed to have been withdrawn.

As for an application claiming a domestic priority based on multiple patent applications, the prior applications are not deemed to have been withdrawn all at once when one year and three months have elapsed from the filing date of the earliest filing date. Rather, it is deemed that each application is withdrawn after one year and three months from the filing date of each prior application.

(Note) Since only the pending applications are disclosed, prior applications deemed to have been withdrawn are not disclosed. Where a request for early publication of a prior application is made within one year and three months from the filing date of a prior application, the prior application shall be disclosed.

(4) An application claiming a domestic priority can be withdrawn anytime. However, when one year and three months has elapsed from the filing date of the prior application, the domestic priority cannot be withdrawn. Also, where a subsequent application is withdrawn within one year and three months from the filing date of the prior application, the domestic priority claim is deemed to have been withdrawn at the same time as the withdrawal of the subsequent application.

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(Note) If a subsequent application is withdrawn within one year and three months from the filing date of the prior application, the priority claim is simultaneously withdrawn. Therefore, even if one year and three months has elapsed from the filing date of the prior application, the prior application is not deemed to have been withdrawn.

6. Amendment to Domestic Priority Claim

(1) An applicant can amend or add the domestic priority claim within one year and four months from the filing date of the prior application (the earliest filing date if two or more prior applications exist).

(Note) Where a multiple priority claim has been made based on the first country application filed in another country under the Treaty and the prior application filed domestically, adding another foreign application to the priority claim is possible within one year and four months from the earliest date between the filing date of the first county application and the domestic prior application under Article 54(7) of the Patent Act. However, adding another domestic application to the priority claim is possible within one year and four months from the filing date of the earliest-filed application among the filing dates of the domestic prior applications. It is because the prior application defined under Article 55(7) of the Patent Act refers to the application filed earlier which forms the domestic priority claim under paragraph(1) of the same article.

(2) Article 55(7) of the Patent Act stipulates that a person allowed for amending the domestic priority claim is the applicant who have fulfilled the requirements of paragraph (1) of the same article and made the priority claim. Therefore, in order to amend or add the domestic priority claim, the applicant would have made the domestic priority claim at the time of filing the application. Also, at least one of the domestic priority claims made at the time of filing the application would have satisfied the requirements of Article 55(1) of the Patent Act.

(3) The application that can be added with the domestic priority claim shall meet the requirements under Article 55(1) of the Patent Act. The requirements are as follows: ① the prior application has been filed within one year prior to the filing date of the subsequent

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application, ② the prior application is neither a divisional application nor converted application, ③ the prior application has been invalidated, withdrawn, or abandoned or a decision to grant a patent or register a utility model has not become final, ④ the applicant of the prior application is identical to the applicant of the subsequent application, and ⑤ the items related to the priority claim are written clearly enough to specify the priority claim.

The time to determine whether the above-mentioned requirements are fulfilled shall be applied differently considering the intention of the relevant provisions. That is, the time to determine when requirement ① is met is at the time of filing the subsequent application. The time to determine when requirements ③ and ④ are met is the time of amending or adding the domestic priority claim.

(Note) Where an application claiming a domestic priority is made based on a theoretical application, application of another person or application which cannot be specified, the domestic priority is inherently invalid. Therefore, the priority claim cannot be amended or added.

(4) The scope allowed for amending the domestic priority claim within one year and four months from the filing date of the prior application includes the whole or partial withdrawal of priority claims in multiple priority claims, as well as amendments of correcting clerical errors in the priority claim and of adding the priority claim. However, the priority claim cannot be withdrawn when one year and three months have elapsed from the filing date of the prior application under Article 56(2) of the Patent Act. As for multiple priority claims, whether one year and three months have elapsed from the filing date of the prior application shall be determined by calculating from the earlier filing dates of each application.

The amendment of the domestic priority claim allowed after one year and four months from the earliest filing date is only limited to clerical errors, just as the amendment of the priority claim under the Treaty.

(Note) Where an applicant intends to withdraw the priority claim and add another priority claim, the applicant doesn't need to additionally submit a written withdrawal notice. Just one

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copy of the amendment with all the amended features written would suffice.

7. Examination of Application of Domestic Priority Claim

7.1 Overview of Examination

Once an application claiming the domestic priority or a written amendment regarding the domestic priority claim is submitted, the examiner shall examine the formalities of the priority claim based on the specification and the written amendment. When no error is found in the formalities of the priority claim, the examiner shall start prior art searches.

Where any prior art related to Article 29 or 36 of the Patent Act exists between the prior application and the subsequent application based on the result of the prior art searches, the examiner shall determine by invention whether each of the inventions in the prior application are identical to the inventions in the subsequent application. As for the identical inventions, the examiner shall examine the application based on the retroactive filing date to determine the patentability of the application. When the inventions are not identical, the examiner shall notify the applicant of the reason of not giving the retroactive filing date, along with the grounds for rejection.

7.2 Flowchart of Examination of Domestic Priority

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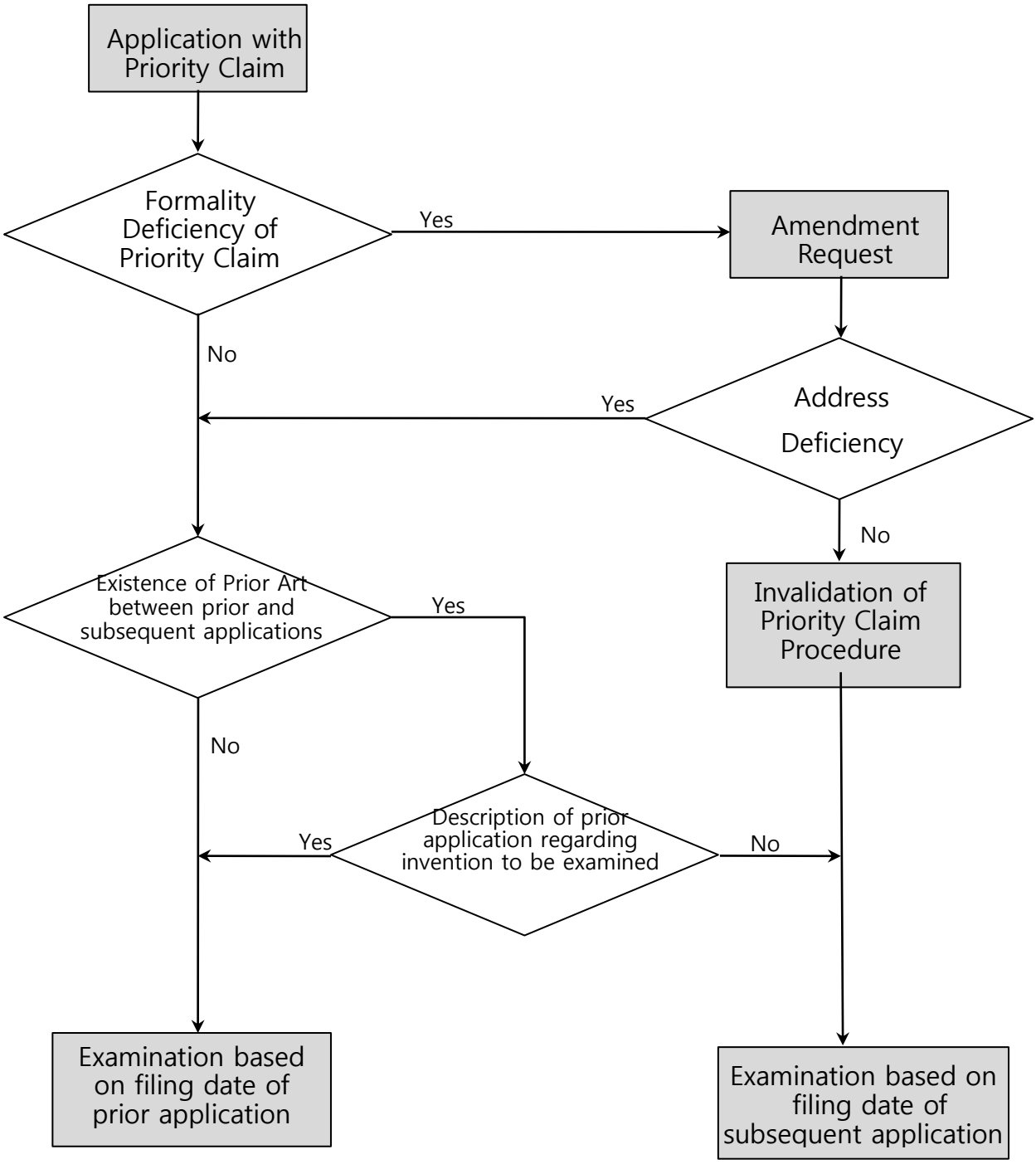

7.3 Formality Examination of Domestic Priority claim

(1) Where a domestic priority claim exists at the time of filing a patent application, the

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examiner shall examine the formalities of the priority claim. If any error is found in the formalities of the priority claim, the examiner shall request the applicant to amend the priority claim. When irregularities are not addressed even after the amendment, the examiner shall invalidate the procedure for the domestic priority claim. The scope allowed for the amendment of the domestic priority claim may change based on whether one year and four months has elapsed from the filing date of the prior application.

The subject of the formality examination in the domestic priority claim is the whole requirements of the domestic priority claim, except for unity of invention.

(2) Where an international patent application claiming priority base on a domestic patent application or an international patent application which has designated only Republic of Korea has entered the national phase, the examiner shall determine whether the prior application is pending at the time of the formality examination since the above-mentioned priority claim is deemed to be a domestic priority claim. Where the prior application has been invalidated, withdrawn or abandoned at the filing date of the international application or a decision to grant a patent has become final and binding, the examiner shall request the applicant to amend the priority claim. If the irregularities are not addressed even after the amendment, the examiner shall invalidate the priority claim.

7.4 Substantive Examination of Application with Domestic Priority claim

(1) When the domestic priority claim has been invalidated because of irregularities, the examiner shall examine the application with the domestic priority claim based on the actual filing date, rather than retroactively calculating the date to determine the patentability of the application.

Where a domestic priority claim has been invalidated, the prior application is not deemed to have been withdrawn. Therefore, the examiner shall be careful in applying Article 36 of the Patent Act.

(2) When a domestic priority claim is valid based on the results of the formality examination of the domestic priority claim, the examiner shall consider whether the dates to determine

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the patentability can be retroactively calculated by invention.

In other words, just as in the case of the priority claim under the Treaty, the examiner shall examine the inventions disclosed in the specification or drawing(s) originally attached to the prior application as if the application is deemed to have been filed on the prior application when determining the patentability under Article 29 of the Patent Act. As for the inventions not disclosed in the specification or drawing(s) originally attached to the prior application, the examiner shall examiner the application based on the filing date of the subsequent application.

7.5 Instruction of Examination of Application with Domestic Priority Claim

(1) As for an application claiming a domestic priority, the prior application which forms the basis of the priority claim is deemed to have been withdrawn when one year and three months have elapsed from the filing date of the prior application. Therefore, the examiner shall not start the examination of the prior application, but defer the examination. The same applies to where the request for accelerated examination on the prior application is made.

(2) A person allowed for claiming a domestic priority is the applicant of the prior application and his/her successor in title. Under Article 38(4) of the Patent Act, if an applicant did not file a report to change the applicant after the filing of the application, except for the succession and inheritance, the effect of the succession would not come into force. Therefore, if the name of the person who filed the prior application is not changed to the name of the person filing the subsequent application before the filing date of the subsequent application (including the filing date), the priority claim shall not be valid. When the applicant of the prior application is different from the applicant of the subsequent application, the examiner shall require the applicant to amend the application. If the applicant cannot prove that the applicant of the subsequent application is the successor of the applicant of the prior application, the examiner shall invalidate the domestic priority claim.

(3) If the examiner did not require the applicant to amend the application after determining the validity of the domestic priority claim soon after filing the application, this could make

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the prior application deemed to be unfairly withdrawn or lead the applicant to lose the opportunity to re-file the application claiming priority after withdrawing the application. Therefore, the examiner shall conduct the formality examination of the priority claim right after filing the application. As for the items exceptionally left out, the examiner shall additionally request the applicant to amend the application in the name of the commissioner of KIPO.

(4) Where the domestic priority claim is in violation of each paragraph of Article 55(1) of the Patent Act or the priority claim has been invalidated since the applicants of both the prior and subsequent applications are not identical, the priority claim would be deemed to have never been made since it has no legal effects. Therefore, the examiner shall change the status of the examination deferral and withdrawal and resume the examination.

In such a case, the prior application can become another application under Article 29(3) of the Patent Act or a prior application under Article 36 of the same act. Therefore, the examiner shall be careful in the examination. Also, the subsequent application shall be treated as a regular application without any priority claim.

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PART VII. Other Examination Procedures

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Chapter. 1 Extension of Term of Patent Right by Permission, etc.

1. Relevant Provisions

Article 89 of the Patent Act(Extension of Term of Patent Right by Permission, etc.) ① Notwithstanding Article 88(1), where permission, registration, etc. under other Acts or subordinate statutes were required to work a patented invention, and it has taken an extended period to complete the activity test, the safety tests, etc., necessary to obtain such permission, registration, etc. (hereinafter referred to as "permission, etc.") and which is prescribed by Presidential Decree, the term of the patent right may be extended by a period, up to five years, during which the patented invention could not have been worked.

② In applying subparagraph(1), the period not attributable to a patent right holder shall not be included in a period during which the patented invention could not have been worked in subparagraph (1) above.

Article 7 of the Enforcement Decree of the Patent Act (Invention subject to Application for Registration of Patent Right Duration Extension) For the purpose of Article 89 of the Patent Act, the term "invention prescribed by Presidential Decree" means any of the following inventions:

1. Invention of medicines [limited to medicines produced with the new matter (referring to new matter whose chemical structure of the active part with medicinal effect (hereinafter the same in this provision) as active ingredient and is obtained with permission for items] which is obtained with the permission for items under Articles 31(2) or (3) or 42 (1) of the Pharmaceutical Affairs Act for purpose of embodying the patented invention; and

2. Invention of agricultural chemicals or raw materials (limited to agricultural chemicals or raw materials produced with the new matter as the active ingredient and registered for the first time) thereof which are to be registered under Articles 8(1), 16(1) and 17(1) of the Agrochemicals Control Act for purpose of embodying the patented invention

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2. Purport

The term of a patent right shall commence upon registration of the patent right and lasts for 20 years from the filing date of the patent application. However, as for particular inventions such as medicines and agrochemicals, permission, registration, etc. under other Acts or subordinate statues are required to work such patented inventions. Also, the inventions cannot be exclusively worked until permission or registration of such inventions is obtained, raising the issue of fairness against other patent rights.

Therefore, notwithstanding Article 88(1), where permission, registration, etc. under other Acts or subordinate statutes were required to work a patented invention, and it has taken an extended period to complete the activity test, the safety tests, etc., necessary to obtain such permission, registration, etc. and which is prescribed by Presidential Decree, the term of the patent right may be extended by a period, up to five years, during which the patented invention could not have been worked.

Meanwhile, as for an extension of the term of a patent filed and registered before September 1, 1990, the system of request for an extension of the patent term shall apply, rather than the system of registration for an extension of the patent term.

3. Subject for Registration for Patent Term Extension

3.1 Inventions entitled to Patent Term Extension

A patented invention entitled to registration for an extension of the patent term shall be an invention defined in paragraph (1) of Article 7 of the Enforcement Decree of the Patent Act according to Article 89(1) of the Patent Act, such as a product patent, a process patent, a use patent, and a composition patent.

(Note) If an invention corresponds to an invention specified in paragraph (1) of Article 7 of the Enforcement Decree of the Patent Act, whether it took long to obtain the permission or registration (hereinafter referred to as "permission, etc.") of the invention is not considered.

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3.2 Applicable Law on Permission or Registration

An invention subject to application for registration of an extension of the patent term shall include: ① an invention of medicines [limited to medicines produced with the new matter (referring to new matter whose chemical structure of the active part with medicinal effect (hereinafter the same in this provision) as active ingredient and is obtained with permission for items] which is subject to permission for the items under Article 31(2) or (3) or 42(1) of the Pharmaceutical Affairs Act for embodying the patented invention; and ② an invention of agricultural chemicals or raw materials (limited to agricultural chemicals or raw materials produced with the new matter as the active ingredient and registered for the first time) thereof which are to be registered under Articles 8(1), 16(1), 17(1) of the Agrochemicals Control Act for purposes of embodying the patented invention. These inventions are only limited to ones that have not been worked for a certain period of time to obtain the permission or registration under the Pharmaceutical Affairs Act or the Agrochemicals Control Act. Therefore, other inventions except for the above-mentioned kinds even if they have not been worked before obtaining permission or registration under other acts or subordinate statutes shall not be subject to application for registration of an extension of the patent term.

3.3 Term of Patent Right

Application for registration of an extension of the patent right by permission, etc. can be filed only when the right of a patented invention is still valid. Therefore, where the concerned patent right has been invalidated or cancelled, or has been extinguished because of the failure of patent fee payment, the application of registration for an extension of the patent right shall not be recognized as valid. Where a trial for invalidating the concerned patent right is pending, the application of registration for an extension of the patent right can be filed.

Meanwhile, where a patent right eligible for an extension of the patent term was valid at the time of the filing of the application of registration for an extension of the patent right, but then became invalidated or cancelled, an examiner shall give an applicant an opportunity to explain under Article 11 of the Enforcement Rules of the Patent Act and then

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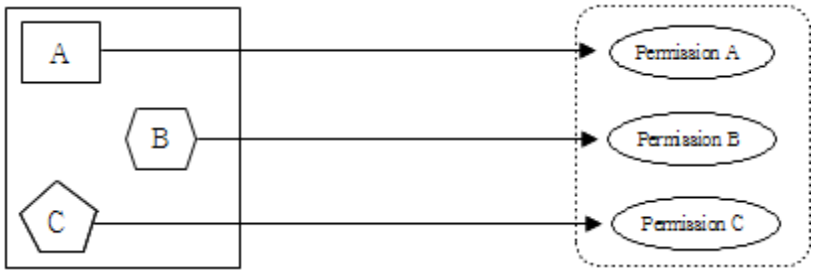
if not addressed, return the written application of registration for an extension of the patent term.

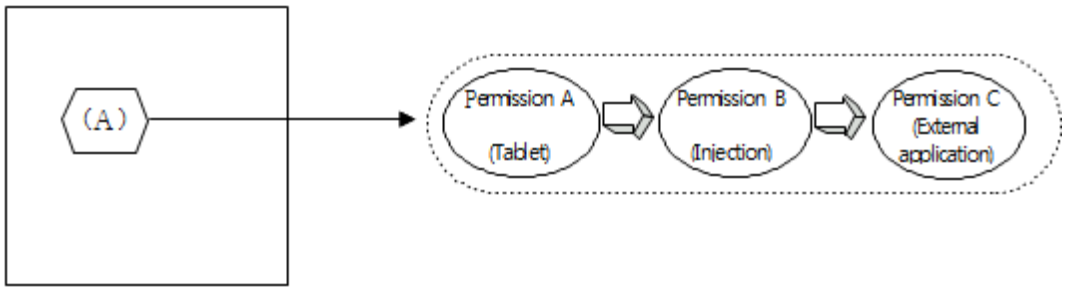
3.4 Determination of Extension of Patent Term

① Where multiple permissions are made on multiple active ingredients in a single patent, an applicant can choose just one permitted ingredient from the permissions and apply for a one-time extension of the patent term for the concerned ingredient.



For example, as for active ingredients A, B and C disclosed in a single patent subject to the application of registration for an extension of the patent term, an applicant has obtained three separate permissions A, B and C, respectively. In that case, he/she can file an application of registration for a one-time extension of the patent term by choosing just one permitted ingredient for which an extension of the patent term is sought.

② Where multiple permissions are made on the same active ingredient disclosed in a single patent, application for an extension of the patent term can be filed on the initial permission only.



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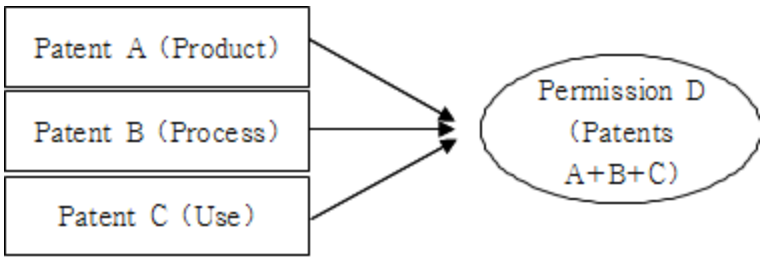
For example, as for the active ingredient (a) subject to the application for registration of an extension of the patent term and Product Permission A, Active Pharmaceutical Ingredient Permission B and Dosage Form Change Permission C were obtained consecutively. Then, the patented invention can be worked by the initial permission of Product Permission A. Therefore, application for registration of an extension of the patent term can be filed on the initial permission A only.

③ Where multiple patents are involved in a single permission, the term of each patented invention with respect to the concerned permission can be extended.



For example, where a product patent, a process patent, a use patent are each obtained for the active pharmaceutical ingredient in Permission D and where the permission is recognized to be necessary for the working of the patented invention, applications of registration for an extension of the patent term can be filed for Patent A, Patent B and Patent C separately.

4. Period allowed for Extension

The term of a patent right may be extended by a period, up to five years, during the patented invention could not have been worked. In other words, even though more than five years have elapsed to obtain permission or registration for the working of the patented invention, the patent term cannot be extended exceeding five years.

The period during which a patented invention cannot be worked shall be calculated in the following manner: only the period elapsed after the date of registration of the patent right shall be considered for calculation. However, the elapsed period attributable to the holder of

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a patent right or an applicant during the period of reviewing relevant documents of the application for permission or registration by the concerned office shall be excluded from the calculation of the period.

①The total length of the period for clinical trials conducted after obtaining approval from the Commissioner of the Korean Food and Drug Administration and the period for reviewing relevant documents for the application for permission elapsed at the Korean Food and Drug Administration to obtain items license of drugs(excluding veterinary drugs)

②The total length of the period for clinical trials conducted after obtaining approval from the Commissioner of the Animal, Plant and Fisheries Quarantine and Inspection Agency and the period for reviewing relevant documents for the application for permission elapsed at the Animal, Plant and Fisheries Quarantine and Inspection Agency to obtain items license of veterinary drugs

③The total length of the period for clinical trials conducted by test and research institutes designated under the Enforcement Decree of the Agrochemicals Control Act and the period for reviewing relevant documents for the application for permission elapsed at the Rural Development Administration to obtain registration of agrochemicals or active pharmaceutical ingredients.

5. Application of Registration for Extension of Patent Term by Permission, etc.

5.1 Relevant Provisions

Article 90 of the Patent Act (Application to Register Extension of Term of Patent Right by Permission, etc.) ① A person who intends to apply to register the extension of a patent right under Article 89(1)(hereinafter referred to as "applicant for registration of extension") shall submit an application for registration of an extension of the term of a patent right to the Commissioner of the Korean Intellectual Property Office, stating each of the following:

1. The name and domicile of an applicant for registration of extension (if the applicant is a

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legal entity, its title and the location of its place of business);
2. The name and domicile, or location of place of business, of the representative, if designated (if the representative is a patent corporation, its name, location of office and designated patent attorney's name)
3. The identification by the number of patent for which an extension is applied, and the claims of that patent;
4. The period of extension applied for;
5. The requirements for permission, etc. under Article 89(1)
6. The grounds for extension prescribed by Ordinance of the Ministry of Knowledge Economy (accompanied by materials substantiating the grounds).

②An application to register an extension of the term of a patent right shall be filed within three months from the date of permission, etc. under Article 89(1) was obtained: Provided, That such application may not be filed six months before the term of patent right provided for in Article 88 expires.

③Where a patent right is owned by joint owners, an application to register an extension of the term of a patent right shall be made in the names of all the joint owners.

④Where an application to register an extension of term of a patent right has been filed, the term shall be deemed to have been extended: Provided, That where a decision of refusal for registration of extension of term under Article 91(1) has become final and conclusive, the same shall not apply.

⑤Where an application to register an extension of the term of a patent right has been filed, the Commissioner of the Korean Intellectual Property Office shall publish the information prescribed in paragraph (1) in the Patent Gazette.

⑥An application for registration of an extension may make an amendment to the matters referred to in paragraph (1) 3 through 6, which are described in the application for registration of an extension (excluding the patent number of the patent right to be extended under subparagraph 3) until the examiner transmits a certified copy of the decision for registration or rejection of the extension: Provided, That after receiving a notice of grounds

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for registration which is applicable mutatis mutandis pursuant to Article 93, he/she may make an amendment in the period for presentation of a written opinion only, according to the relevant notice of grounds for rejection.

④ Applicant of Registration for Extension of Patent Term

An applicant of the application to register an extension of the term of a patent right shall be limited to a holder of the patent right. Where a parent right is jointly owned, an application to register an extension of the term of a patent right shall be made in the names of all the joint owners.

Where the person who filed an application to register an extension of the term of a patent right is not the holder of the patent right or where an application to register an extension of the term of a patent right was not filed in the names of all the joint owners, it shall constitute a ground for rejection.

5.3 Period allowed for Application

An application to register an extension of the term of a patent right by permission, etc. shall be filed within three months from the date of permission, etc. under the provision of Article 89 of the Patent Act. Provided, That the application cannot be filed six months before the term of patent right provided for in Article 88 expires.

Where an application to register an extension of the term of a patent right was filed before a permission, etc. defined under Article 89 of the Patent Act was obtained; after three months have elapsed from the date of permission, etc.; during the period between six months before the expiration of the term of a patent right and the expiration of the term of a patent right; or after the term of a patent right expires, an examiner shall give an applicant an opportunity to explain under Article 11 of the Enforcement Rules of the Patent Act and, if not addressed, return the application to register an extension of the term of a patent right by permission, etc. to the applicant.

5.4 Application Document

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(1) A person who intends to file an application to register an extension of the term of a patent right shall attach 'a copy of the evidential document of the ground for extension' and 'a copy of the evidential document of legal representation (only when the procedure is initiated by a legal representative)' to an application in Annexed Form No. 30 of the Enforcement Rules of the Patent Act and submit such documents to the Commissioner of the Korean Intellectual Property Office.

(2) An application to register an extension of the term of a patent right shall be written in the following manner:

①The name of the holder of a patent right shall be written in the box for applicant of registration of extension. Also, where a patent right is jointly owned, the name of all of the joint owners shall be stated

② The patent number and the application number of the patent for which an extension of the term is sought shall be written in the box for patent number and application number.

③ The name of the patented invention shall be written in the box for name of invention.

④ All the claims including active pharmaceutical ingredients for which an extension of the term of a patent right is sought shall be written in the box for claims subject to extension. How such claims include items for permission or registration under Article 89 of the Patent Act shall be clearly stated and illustrated in detail.

(Example) In claim 1, compounds in the general formulas (I) R1=CH3 R2=OH correspond to active pharmaceutical ingredient OOO in a popular term

⑤ A ground for a need to obtain permission or registration under Article 89 of the Patent Act to work a patented invention for which an application to register an extension of the term of a patent right is filed shall be written in the box for ground for extension. As for drugs, the evidential document of the ground for extension shall include a copy of clinical investigation plans, a copy of items license for drugs and the evidential document of the

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period for Phase Ⅲ trial conducted overseas and the period for review of document spent at a permission agency for the concerned drug. As for agrochemicals, the evidential document of the ground for extension shall be attached with a copy of a test application for registration of items of agrochemicals and a copy of the registration certificate for items of agrochemicals. The evidential document for raw agrochemical materials shall include a copy of test and analysis applications and a copy of registration of raw agrochemical materials.

⑥ The number of days calculated in the manner as prescribed in <4. Period allowed for Extension> of this Chapter shall be written in the box for the period for an extension of the term of a patent right. However, where the period exceeds five years, the period for an extension of the term of a patent right shall be the number of days in five years.

⑦ In the box for the date on which a permission, etc. under Article 89 of the Patent Act is granted, the date of permission of drugs (in case of veterinary drugs, the corresponding date) under Article 31(1) or Article 42(1) of the Pharmaceutical Affairs Act or the date of registration in case of agrochemicals or active ingredients in agrochemicals under Article 8(1), 16(1) or 17(1) of the Agrochemicals Control Act shall be written.

⑧ In the box for the content of permission, etc. under Article 89 of the Patent Act, the content of the relevant provisions and permission to work a patented invention shall be written. Also, the evidential documents stating that a person who obtained a permission, etc. is the exclusive licensee of a patent right of the application for registration for an extension of the term, a registered non-exclusive licensee or a patent right holder shall be attached. The following items shall be written in the box for the content of permission, etc.

1. As for drugs, permission for items' no., firm name, name of drug, dosage, efficacy and effect of active pharmaceutical ingredient

2. As for agrochemicals, registration no., firm name, name of agrochemicals, type and content of active ingredient

3. As for agrochemical raw materials, registration no., firm name, name, type and size of agrochemical raw materials

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5.5 Effect of Application of Registration for Extension of Patent Term

Where an application to register an extension of term of a patent right has been filed, the term shall be deemed to have been extended: Provided, That where decision of refusal for registration of extension of term under Article 91(1) of the Patent Act has become final and conclusive, the same shall not apply. Also, when an application to register an extension of term of a patent right has been withdrawn, invalidated or returned before decision of refusal for registration of extension of term has become final and conclusive, the term shall be deemed not to have been extended in the first place.

(Note) Like a decision refusing to grant a patent right, a decision of refusal of registration for extension of term shall become final and conclusive when thirty days have elapsed from the delivery of a certified copy of a decision of refusal of registration for extension of term if an appeal against the decision refusing registration for extension of patent term was not initiated. Where an appeal against the decision refusing registration for extension of patent term was initiated, the decision shall become final and conclusive when the ruling of an appeal against the decision refusing registration for extension of term of patent right has become final and conclusive.

5.6 Legal Representation of Application to Register Extension of Patent Term

(1) Unlike withdrawal, etc. of an application to register an extension of the term of a patent right, an application to register an extension of the term of a patent right by permission, etc. is not entitled to special authorization. Therefore, even without special authorization, an application to register an extension of the term of a patent right can be represented by a legal representative. However, since the procedure for an application of registration for an extension of the term of a patent right is unclear to determine whether it is a procedure for filing an additional application or a procedure for registration, the scope of power of representation shall be determined as in the following manner:

① When filing an application to register an extension of the term of a patent right, where the scope of power of representation in the evidential document of power of representation

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states "all patent-related procedures", "all procedures related to registration of a patent right", or " all procedures related to an application to register an extension of the term of a patent right" and the name of the concerned legal representative is written in an application of registration for an extension, all of the subsequent procedures for an application to register an extension of the term of a patent right(However, the abandonment of an application shall be determined based on the content of special authorization) can be represented by a legal representative.

② When filing an application to register an extension of the term of a patent right, where the evidential document of power of representation was not submitted and the scope of power of representation in the initial patent application or the evidential document of power of representation at the time of registration states "all patent-related procedures", "all procedures related to registration of a patent right", or " all procedures related to an application to register an extension of the term of a patent right" and the name of the concerned legal representative is written in an application of registration for an extension, all of the subsequent procedures for an application to register an extension of the term of a patent right can be represented by a legal representative.

However, where the name of the concerned legal representative is not written in an application of registration for an extension even when the initial patent application or the evidential document of power of representation at the time of registration claims that an application to register an extension of the term of a patent right can be registered by a legal representative, the legal representative shall be deemed not to have a power of representation in a procedure related to an application to register an extension of the term of a patent right.

③ The abandonment of an application to register an extension of the term of a patent right is entitled to special power of representation. Therefore, where there is no special power of representation, a legal representative cannot abandon an application to register an extension of the term of a patent right and the power of representation of a legal representative with general power of attorney shall be effective for an application to register an extension of the term of a patent right, too.

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6. Examination

6.1 Relevant Provisions

Article 91 of the Patent Act (Decision of Rejecting Application to Register Extension of Term of Patent Right by Permission, etc.) ①An examiner shall make a decision to reject an application to register an extension of the term of a patent right where it falls under any of the following situations:

1. Where it is deemed that permission, etc. under Article 89 is unnecessary for working the patented invention;

2. Where the patentee, or a person who has an exclusive or non-exclusive license under the patent right has not obtained permission, etc. under Article 89;

3. Where the term for which an extension is applied exceeds the period during which the patented invention could not have been worked;

4. Where the application for registration of extension is not the patentee;

5. Where the application for registration of extension is made in violation of Article 90(3)

Article 92 of the Patent Act (Decision, etc. to Register Extending Term of Patent Right by Permission, etc.) ① Where an examiner finds no reason under any subparagraph of Article 91(1) to reject an application for an extension of the term of a patent right, he/she shall make a decision to register the extension

②When a decision to register the extension has been made under paragraph (1), the Commissioner of the Korean Intellectual Property Office shall register the extension of the term of the patent right in the Patent Register.
③ When the registration under paragraph (2) has been made, the information prescribed in the following subparagraphs shall be published in the Patent Gazette:

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1. The name and domicile of a patentee (if the patentee is a legal entity, its title and the location of its place of business);

2. The patent number;

3. The date of registration of the extension;

4. The period of the extension;

5. The requirements for permission, etc, under Article 89

6.2 Flowchart and Overview of Examination Procedure

A procedure for examining an application to register an extension of the term of a patent right by permission, etc. is similar to that of a patent application. Where there exists no provision for the detailed procedure for examining an application to register an extension of the term of a patent right by permission, etc., the examination procedure for a patent application shall apply mutatis mutandis. Once an application to register an extension of the term of a patent right is received and transferred to an examiner, the examiner shall initiate examination on the application within four months from the date for receipt of the application document.

(1) Formalities Examination

When an application to register an extension of the term of a patent right is accepted, the division which has received the written application shall complete the formalities examination and transfer it to an examiner. If the division which has received the application failed to conduct the formalities examination, the examiner shall carry out the formalities examination under the name of the Commissioner of the Korean Intellectual Property Office.

(2) Examination I

A designated examiner shall initiate a substantive examination of the application and

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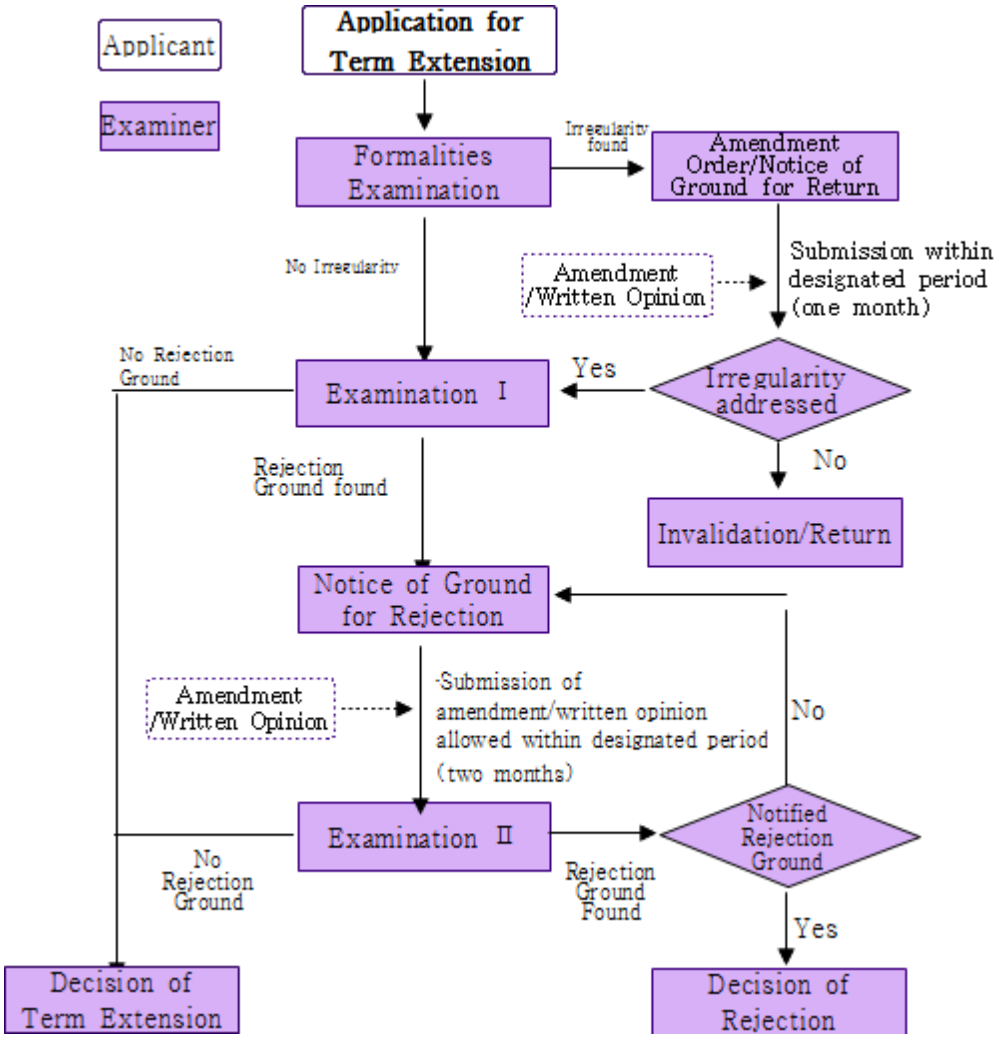
determine whether any ground for rejecting the application exists and when there is any ground for rejection, the examiner shall notify an applicant of the ground for rejection and give him/her an opportunity to submit a written opinion.

(3) Submission of Written Opinion or Amendment

An applicant can submit a written opinion within the period mentioned in a written notification of submission of opinion designated by the examiner. Also, the applicant can make an amendment to the application of registration for an extension of the term of a patent right within the period for submission of a written opinion.



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(4) Determination of Registration

An examiner shall re-examine the submitted application to register an extension of the term of a patent right, while considering the amendment and written opinion. Where the application is to be rejected again after reexamination of the application, the examiner shall make a decision to reject the registration. If the examiner finds no other reason to reject an application for an extension of the term of a patent right, the examiner shall make a decision to register the extension.

Meanwhile, where an examiner finds another ground for rejection which has not been notified after reexamination, the examiner shall notify the applicant of the newly-found ground for rejection and repeat the procedure above.

6.3 Formalities Examination of Application of Registration for Extension

Where an application to register an extension of the term of a patent right transferred from the division of receipt of document is in violation of the formalities, an examiner shall treat the application in the following manner.

(1) Where an application to register an extension of the term of a patent right was filed after the period under Article 90(2) of the Patent Act has elapsed, an examiner shall notify an applicant with indications of the intention to return the application, the ground for return and the period allowed for explanation in a written notification of ground for return under Article 11(2) of the Enforcement Rules of the Patent Act.

Where an applicant makes a request for return of the application document after notification of the ground for return or the submitted explanation is acknowledged to be groundless, an examiner shall return the relevant documents.

Where an application to register an extension of the term of a patent right was filed before obtaining permission, etc. under Article 89 of the Patent Act, the application, too, shall be treated in the above-mentioned manner.

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(2) Where an application to register an extension of the term of a patent right is in violation of the provision regarding a legal representative under Article 46 of the Patent Act; where fees have not been paid as specified under Article 46 of the Patent Act; or where it violates the formalities specified in the Act or any order thereunder, an examiner shall order to make an amendment to the application. The designated period for amendment is one month and the designated period can be extended one additional month only.

Despite a request for amendment, where the irregularities are not addressed within the designated period, an examiner shall invalidate the procedure for the application under the name of the Commissioner of the Korean Intellectual Property Office.

6.4 Substantive Examination of Application of Registration for Extension

6.4.1 Determination of Subject for Examination

Documents subject to examination include a written application and relevant attached documents of an application to register an extension of the term of a patent right. However, where amendment was made to the application, an examiner shall decide the subject for examination by determining whether the amendment is recognized to be legitimate. Where the amendment is legitimate, an examiner shall examine the application by reflecting the amended matters. Where the amendment is not recognized to be legitimate, an examiner shall deem that the amendment has never been filed in the first place and conduct examination on the application to register an extension of the term of a patent right before the concerned amendment.

Where more than two amendments are made, an examiner shall determine the amended matters based on the combination of the final amendments. The written application reflecting the final amended matters deemed to be legitimate shall be subject to examination. If two or more amendments are made, the guideline of determining the amended matter in Chapter 5 <Examination Procedure> shall be referred.

(Example) Where claims subject to an extension of the term of a patent right are amended in a first amendment and the patent number and the period allowed for request for an

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extension of the term of a patent right are amended in a second amendment, the second amendment of correcting the patent number is not recognized as an amendment of correcting clerical errors and the it is not deemed legitimate. Therefore, a written application to register an extension of the term of a patent right only reflecting the amended matters in the first amendment shall become the subject for examination.

Items for amendment	Initial Application	1st Amendment	2nd Amendment	2nd Amended Matter	Application for Examination
Patent Number of Application for Extension	Patent No. 001234	-	Patent No. 004567	Patent No. 004567	Patent No. 001234
Claims of Application for Extension	Claim 1	Claim 2		Claim 2	Claim 2
Period for Extension Request	2 Years	-	1 Year 8 Months	1 Year 8 Months	2 Years

6.4.2 Determination on Existence of Ground for Rejection

Where an application to register an extension of the term of a patent right falls under any of the following situations defined in Article 91, an examiner shall make a decision to reject the application.

(1) Where it is deemed that permission, etc. under Article 89(1) of the Patent Act is unnecessary for working the patented invention

If the working of the patented invention is to be recognized necessary to obtain permission, etc. under Article 89(1) of the Patent Act, the following requirements shall be met: ① permission is required for the working, such as manufacturing or production, of the permitted subject matter under Article 89(1) of the Patent Act; ②the composition of the patented subject matter shall be identical with that of the permitted subject matter; or ③ the use of the patented subject matter shall be identical with that of the permitted subject matter.

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Whether such requirements are met shall be determined in more detail in the following manner:

① Determination on Necessity for Permission of Patented Matter

As for a patented invention subject to an application to register an extension of the term of a patent right, permission under Article 89(1) of the Patent Act needs to be obtained to work the patented invention. Therefore, unless special conditions exist, a need to obtain permission shall be recognized only based on the fact that an organization in charge of granting permission permitted the concerned application.

For example, if permission for manufacturing items of drug was obtained under Article 31 of the Pharmaceutical Affairs Act to test activity and safety of a certain drug, an examiner can recognize that permission needs to be obtained under relevant provisions to manufacture the drug and may not additionally examine the necessity of permission, unless special conditions exist such as objection by a third party. However, if an examiner is unsure of the necessity of permission, he/she can conduct an additional examination (request for opinion from relevant organizations, etc.) and where permission is deemed not to be required based on the results of the examination, an examiner shall notify the ground for rejection.

② Determination on Identicalness of Compositions between Patented Matter and Permitted Matter

A patented invention subject to an application to register an extension of the term of a patent right needs to be approved under the Pharmaceutical Affairs Act, etc. for the working of the patented invention. Therefore, the permitted matter shall have the same composition as the matter disclosed in claims in an application to register an extension of the term of a patent right (where an invention disclosed in claims is an invention of substance) or as the matter manufactured by the method described in claims (where an invention disclosed in claims is a use invention).

Whether the matter disclosed in claims (or an article manufactured by the disclosed use, etc.)

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has the same composition as the permitted matter shall be determined in the following matter. Where the compositions of both matters are not identical, an examiner shall deem that it falls under the ground for rejection under Article 91(1) of the Patent Act and notify the applicant of the ground for rejection.

(ⅰ) Where the matter disclosed in claims is a substance invention, an examiner shall compare the concerned matter and the permitted matter.

(ⅱ) Where the matter disclosed is a use invention, an examiner shall compare the matter manufactured by the disclosed use with the permitted matter. The manufacturing processes need not be compared.

③ Determination on Identicalness of Use between Patented Matter(Use Invention) and Permitted Matter

A patented invention subject to an application to register an extension of the term of a patent right needs to be approved under the Pharmaceutical Affairs Act for the working of the patented invention. The working of a patented invention refers to the working of use of a patented invention.

Therefore, where a patented matter is a use invention and the use of the permitted matter is not the same with the use of the matter disclosed in a patented invention (the substance where an invention disclosed in claims is a substance invention or the matter manufactured by the disclosed use if an invention disclosed in claims is a use invention), the term of a patent right shall not be extended even if the compositions of the permitted matter and the patented matter are identical. However, when the use of the patented matter includes the use of the permitted matter, it shall be deemed that the uses of both matters are the same.

(Note) A patent right regarding to a manufacturing device for a final product and a catalyst used for manufacturing an intermediate and final product shall not be subject to extension of the patent term.

Acts with the purpose of securing safety, such as the Pharmaceutical Affairs Act, govern the

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manufacture and sale of a final product, not the manufacture and sale of an intermediate produced in the manufacturing process. Therefore, the working of an intermediate, etc. does not need to be approved. Therefore, where an application to register an extension of the term of a patent right of an intermediate or a catalyst and manufacturing device used for manufacturing a final product was filed on the basis of approval of a final product, an examiner shall notify an applicant of the ground for rejection under Article 91(1)(1) of the Patent Act.

(2) Where the patentee, or a person who has an exclusive or non-exclusive license under the patent right has not obtained permission, etc. under Article 89(1)

Even when only some of multiple patentees or persons who have jointly received permission, etc. obtain an exclusive or non-exclusive license under the patent right, it does not fall under grounds for rejection under Article 91(2) of the Patent Act since the it is deemed that the patentee, or a person who has an exclusive or non-exclusive license under the patent right has obtained permission, etc..

However, where the patentee or a person who has an exclusive or non-exclusive license under the patent right who was not registered at the time of filing an application to register an extension of the term of a patent right has obtained permission, etc., it shall be deemed that it falls under grounds for rejection under Article 91(2) of the Patent Act.

(3) Where the term for which an extension is applied exceeds the period during which the patented invention could not have been worked

The term for which an extension is applied shall not exceed the period during which the patented invention could not have been worked. However, the term does not need to match the period. In other words, where the term for which an extension is applied has not elapsed even if the term has been incorrectly calculated, an examiner shall acknowledge the term for which an extension is applied, rather than notifying an applicant of the ground for rejection.

Calculation of the term for which an extension is applied shall be conducted based on

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calendar.

(Note) Where the date on which permission has been granted under Article 89(1) of the Patent Act is before the date of registration for establishment of a patent right, it falls under grounds for rejection under Article 91(3) of the Patent Act since the patented invention could not be worked in the period.

(4) Where the applicant for registration of extension is not the patentee

An applicant who files an application to register an extension of the term of a patent right shall be the applicant at the time of filing an application of registration for extension. Therefore, even a person who has an exclusive or non-exclusive license under the patent right cannot become an applicant for registration of extension.

Where irregularities exist such as a person not eligible for filing an application to register an extension of the term of a patent right has filed an application for registration of extension, an examiner shall notify an applicant of grounds for rejection, rather than making an amendment request or notification for grounds for returning the application.

(5) Where the applicant for registration of extension is made in violation of Article 90(3)

Where a patent right is jointly owned, an application to register an extension of the term of the concerned patent right shall be filed by all the co-owners of the patent right. Where only some of the patent right holders files an application for registration of extension, it shall fall under grounds for rejection under Article 91(1)(5) of the Patent Act.

6.4.3 Notification of Ground for Rejection

Where an examiner intends to reject an application to register an extension of the term of a patent right by permission, etc. since the application under Article 63 of the Patent Act which applies mutatis mutandis to Article 93 of the same act falls under the paragraphs of Article 91 of the Patent Act, he/she shall notify an applicant of the ground for rejection and give the opportunity to submit a written opinion within a designated period.

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Where an examiner decides to notify an applicant of the ground for rejection, the examiner shall indicate relevant provisions or grounds for rejection precisely and concisely so that the applicant clearly understands the ground for which his/her application is rejected. Contents for notification of grounds for rejection in PART V. <Examination Procedure> shall be referred to.

At the time of delivering a ground for rejection, an examiner shall notify an applicant that a written opinion shall be submitted within two months. The period for submission of a written opinion designated by an examiner can be extended. Extension of the period for opinion submission can be allowed for one additional month each time and up to three times.

6.4.4 Treatment of Opinion and Amendment

Where an examiner notifies an applicant of the ground for rejection for an application to register an extension of the term of a patent right by permission, etc., the applicant can submit a written opinion or amendment.

A written opinion shall be submitted within the period designated in a notification for submission of a written opinion. An amendment can be presented before delivering a copy of decision of registration of extension. However, after the notification of grounds for rejection made by an examiner, an applicant can submit an amendment only within the period for submission of opinion according to the notification of the ground for rejection above.

(1) Where an opinion is submitted, an examiner shall determine whether the ground for rejection really exists while considering the applicant's claim described in the written opinion.

(Note) Even when an opinion has been submitted after the period for submission of opinion has elapsed or before the ground for rejection is notified, an examiner shall take the opinion into consideration on examination, rather than returning the opinion.

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(2) Where an amendment is submitted, an examiner shall re-examine the concerned application while reflecting the amended matters described in the amendment, as long as the amendment is not recognized to be illegitimate.

Matters eligible for amendment in an application for registration of extension under Article 90(6) of the Patent Act include ① an indication of claims for registration of extension, ② the period for extension request, ③ the content of permission, etc. under Article 89 of the Patent Act, ④ the ground for extension specified in Ordinance of the Ministry of Knowledge Economy. Therefore, amendment cannot be accepted except for amending clerical errors such as amendment of changing the applicant for registration of extension and amendment of changing the patent number of the patent right eligible for registration of extension.

Where an amendment is submitted, an examiner shall determine whether the subject for amendment is legitimate. When the subject not eligible for amendment is found to have been amended, the examiner shall deliver a warning notice for inadmissible amendment to an applicant

And give him/her an explanation to explain. A warning notice for inadmissible amendment can be replaced by writing the notice in a notification for submission of opinion when the examiner intends to notify the ground for rejection again based on the warning notice for inadmissible amendment indicating the ground for which the amendment cannot be acknowledged.

Where an amendment cannot be acknowledged despite the explanation given by an applicant, an examiner shall deliver a notification for inadmissible amendment and examine the pre-amendment application again. A notification for inadmissible amendment can be replaced by writing the notification in a notice for refusal when the examiner intends to reject the application based on a notification for inadmissible amendment indicating the ground for which the amendment cannot be acknowledged.

(Note 1) Where a procedure for an application for registration of extension is terminated based on general principles regarding the procedure for filing a patent application, the amendment cannot be acknowledged. Therefore, where an application for registration of

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extension has been invalidated, withdrawn, abandoned or returned or where the patent right which forms the basis for an application for registration of extension has been invalidated or abandoned, a written amendment cannot be submitted.

(Note 2) Under the provisions in Article 90(3) of the Patent Act, a patent right holder refers to the one at the time of filing an application for registration for extension. Therefore, if a person other than a patent right holder files an application to register an extension of the term of a patent right of a third party and makes an amendment of changing the applicant name for registration of extension in the name of the patent right holder, such amendment shall not be acknowledged.

Moreover, in case a patent right is jointly owned, where, to address grounds for rejection raised when filing an application for registration of extension, some of the co-owners make an amendment of adding an applicant who was not initially listed in the application for registration of extension, or where they make an amendment of changing the names of the registered patent right holders to match the patent right holders with the applicants for registration of extension, such amendment shall not be recognized.

Meanwhile, amendment of correcting the indication of an applicant or changing the patent applicant to a general successor in the presence of general succession of a patent right shall not be acknowledged.

(Note 3) A person who has initiated a patent-related procedure can amend the procedure as long as it is still pending before the Korean Intellectual Property Office. However, under Article 90(6) of the Patent Act, a question is raised whether a wrongly-indicated patent number can be amended since the patent number is not entitled to amendment among the contents of an application to register an extension of the term of a patent right.

Article 90 (6) of the Patent Act dictates that the contents claimed at the time of filing an application for registration of extension can be changed, but the change of a patent number is not allowed since it might alter the subject for registration of extension of the term of a patent right. Therefore, no amendment is allowed except for amendment of correcting the wrongly-indicated patent number in an application for registration of extension (where the

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indication of the patent number is recognized as a clerical error with the application number, application date, patent number, patent date, title of invention, etc. all considered).

(3) When amendment is recognized to be legitimate, an examiner shall examine the amended application while deeming that the application has been submitted at the time of filing the initial application.

6.4.5 Determination of Registration of Extension

Whether the term of a patent right in an application for registration of extension is extended shall be determined and be indicated in writing under Article 67 of the Patent Act which Article 93 of the same act applies mutatis mutandis.

(1) Determination of Registration/Rejection of Extension

Where an examiner intends to make a decision on whether to register an extension for an application to register an extension of the term of a patent right, he/she shall report such intention to the general of an examination division (team leader) and make and sign a written decision on registration of extension or refusal on registration of extension with the below-mentioned indications. However, items in ③, ④ need not to be written in a written decision on refusal of registration of extension.

① Number of application for registration of extension
② Patent number
③ Period for extension
④ Content of permission or registration under Article 89(1) of the Patent Act: Claims for registration of extension, content of permission or registration, ground for extension, etc.
⑤ Name and address of applicant for registration of extension (in case of a legal entity, title and address of its business)
⑥ In presence of an agent of applicant for registration of extension, name and address of the agent or the address of the agent's business (where an agent is a patent firm, title and address of the firm and name of the designated patent attorney)
⑦ Order of decision and ground for the decision

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⑧ Date of decision

(2) Transmittal of Decision on registration of extension

Where a decision on registration of extension is made for an application to register an extension of the term of a patent right, the Commissioner of the Korean Intellectual Property Office shall deliver a copy of such decision to an applicant. Detailed information on transmittal of a written decision shall be referred to the provisions regarding the delivery of a copy of a decision to grant a patent.

7. Other Examination Procedures

7.1 Publication in patent gazette, etc.

Where an examiner has made a decision to register an extension of the term of a patent right, he/she shall ask the registration division to include the following items for registration in a patent gazette: ① name and address of a patent right holder (in case of a legal entity, its title and business address), ② patent number, ③ date of registration of extension, ④ period for extension and ⑤ content of permission, etc. under Article 89 of the Patent Act (indications such as claims for registration of extension, contents of permission or registration, ground for extension, etc.)

7.2 Trial on decision to reject registration

Where a person who has received a written decision on rejection of registration of extension since his/her application to register an extension of the term of a patent right by permission, etc. falls under the paragraphs of Article 91 of the Patent Act intends to appeal against the decision of rejection, the applicant can make a request for appeal against a decision on rejection of registration of extension within thirty days from the date of receipt of a copy of the decision on rejection of registration of extension.

7.3 Invalidation trial on registration of extension of term of patent right

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Where the registration of an extension of the term of a patent right with respect to an application to register an extension of the term of a patent right by permission, etc. falls under the paragraphs of Article 134(1) of the Patent Act, an applicant can request a trial to invalidate the registration of an extension of the term of a patent right.

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Chapter 2. Extension of Term of Patent Right by Delay in Registration

1. Relevant Provisions

Article 92(2) of the Patent Act (Extension of Term of Patent right by Delay in Registration) ① Notwithstanding Article 88(1) of the Patent Act, where a patent right is registered later than four years from the date of filing a patent application or than three years from the date of making a request for examination, whichever expires later, the term of the patent shall be extended by the delayed length of time.

② In applying subparagraph (1), the period delayed due to an applicant shall be exempted from extension of the term of a patent right under subparagraph (1). Provided, That if the length of the period elapsed due to an applicant overlaps, the period exempted from extension of the term of a patent shall not exceed the actually-periods of delay of time due to the applicant.

③ Items regarding 'the period delayed due to an applicant' under subparagraph(2) shall be specified in Presidential Decree.

④ Notwithstanding Articles 34, 35, 52(2), 53(2), 199(1) and 212(4) of the Patent Act, in calculating four years from the date of filing a patent application under subparagraph(1), the following corresponding date shall be deemed to be the date of filing a patent application:

1. In case of a patent application filed by a lawful right holder under Article 34 or 35, the date when the lawful right holder filed the application

2. In case of a divisional application under Article 52, the date of filing the divisional application

3. In case of a converted application under Article 53, the date of filing the converted application

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4. In case of an international application deemed to be a patent application under Article 199(1), the date of submission

5. In case of an international application deemed to be a patent application under Article 214, the date when the applicant of the international application applied for the decision under Article 214(1)

6. In case of a patent application not falling under any of subparagraphs (1)-(5), the actual date of filing the application

Article 7(2) of the Enforcement Decree of the Patent Act (Period delayed due to Applicant) ① 'The period delayed due to an applicant' specified in Article 92(2)(iii) shall fall under one of the following subparagraphs:

1. The period corresponding one of the below-mentioned periods in a patent-related period pending before the Korean Intellectual Property Office or the Intellectual Property Tribunal

a. Where the Commissioner of the Korean Intellectual Property Office or the President of the Intellectual Property Tribunal orders, under Article 10 of the Patent Act, an applicant to have a patent-related procedure initiated by an agent or have an agent replaced, the period between the date of order and the date of appointment/replacement of the agent

b. Where the period for requesting a trial or initiating a patent-related procedure is extended at the applicant's request under Article 15(1) or (2) of the Patent Act, the extended length of the period (After extension of the period, where the period for initiating a patent-related procedure is shortened at the request of an applicant under Article 15(2) of the Patent Act, the shortened length of the period shall be exempt.)

c. Where the date for initiating a patent-related procedure was designated under Article 15(3) of the Patent Act and then it has been changed to the date later than the designated date at the request of the applicant, the period between the following date of the initially designated date and the changed date

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d. Where a patent-related procedure is subsequently amended after any cause not attributable to the person ceased to exist under Article 17 of the Patent Act, the period between the date when the cause ceased to exist and the date for amending the procedure

e. Where a patent-related procedure is interrupted or suspended under Articles 20, 23(2), 78(1) or 164(1) of the Patent Act, the period for interruption or suspension of the procedure

f. Where the Commissioner of the Korean Intellectual Property Office orders an applicant to report the results of the consultation within the designated period under Article 36(6) of the Patent Act, the concerned period (in case the designated period is shortened at the request of an applicant under Article 15(2), the shortened period shall be exempt.)

g. Where a specification is amended to include claims within the designated period under Article 42(2) of the Patent Act according to the newly inserted part of Article 42(5), the period between the date when the intention of a request for examination was received and the date for amendment of the specification

h. Where the Commissioner of the Korean Intellectual Property Office or the President of the Intellectual Property Tribunal orders amendment within the designated period under Articles 46, 141(1), or 203(2) of the Patent Act, the concerned period (in case the designated period is shortened at the request of an applicant under Article 15(2), the shortened period shall be exempt.)

i. As for a prior application which forms the foundation for a priority claim under Article 55(1) of the Patent Act, where the priority claim of the prior application is withdrawn or is deemed to be withdrawn under Article 56 of the Patent Act, the period between the date of claiming the priority on the prior application and the date when the priority claim is withdrawn or is deemed to be withdrawn

j. As for accelerated examination under Article 61 of the Patent Act, where making a decision on accelerated examination under Article 10 is delayed due to an application, the periods of delay

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k. Where an examiner (where Article 63 applies mutatis mutandis according to Article 170, it shall refer to a trial examiner under Article 143. It shall apply in this chapter.) notifies an applicant of the ground for rejection and gives him/her an opportunity to submit a written opinion within the designated period under the main sentences of Article 63(1) of the Patent Act [Provided, except for where an examiner notifies the ground for rejection and then makes a decision to grant a patent under Article 66 of the Patent Act without amending the specification or drawings to the notification of the ground for rejection (including where a decision to grant a patent is made under Article 66 applied mutatis mutandis under Article 170 of the Patent Act)], the concerned period (where the period for submission of a written opinion is shortened under Article 15(2) of the Patent Act at the request of an application, the shortened period shall be exempt.)

l. Where an applicant pays patent fees under Article 79(1) after the date of receipt of a copy of a decision to grant a patent under Article 67(2) of the Patent Act (including the cases the additional payment of the patent fee under Article 81(1); where the remainder payment under Article 81(2)(ⅱ); where the payment of patent fee or the remainder payment under Article 81(3)(ⅰ) of the Patent Act) or where an applicant is exempt from patent fee payment after he/she has submitted the documents designated by Ordinance of the Ministry of Knowledge Economy, the period between the date of receipt of the copy of the decision to grant a patent and the date of registration of the patent right under Article 87 of the Patent Act

m. Where a request for re-examination is made under Article 67(2)(ⅰ) of the Patent Act, the period between the date of receipt of a copy of the decision to reject a patent right under Article 67(2) and the date of request for re-examination

n. Where a request for exclusion under Article 149 of the Patent Act or a request for challenge under Article 150 failed to be accepted according to a decision under Article 152(1), the period in which the trial procedure is interrupted under the main sentence of Article 153 of the Patent Act

o. Where a request for taking or preserving evidence by an applicant under Article 157 of

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the Patent Act is recognized not to be necessary, the period between the date of the request and the date when taking or preserving evidence is recognized not to be needed

p. Where an examiner notifies an applicant of the closing of a trial under Article 162(4) of the Patent Act and then resumes the trial at the request of the applicant, the period between the date of resumption of the trial and the date of re-notification of the closing of the trial under Article 162(3) of the Patent Act

q. Where a request for retrial under Article 178 of the Patent Act is made after an applicant realized the ground for retrial, the period between the date when the applicant realized the ground for retrial and the date of request for retrial

r. Where a presiding administrative patent judge has designated an additional period under Article 186(5) of the Patent Act, the concerned period

s. Where transmittal or service by public announcement of documents under Article 218 or Article 219 of the Patent Act is delayed because of an applicant (where a place for transmittal has been changed under Article 18(10) and then the transmittal of documents is delayed since the applicant failed to notify the intention of the change of the place for transmittal to the Commissioner of the Korean Intellectual Property Office), the period of the delayed transmittal

2. In a procedure for litigation regarding a trial decision or ruling under Article 186(1) or (8) of the Patent Act, any of the following periods:

a. Where a litigation procedure is interrupted under Article 78(2) or Article 164(2) of the Patent Act, the period during which the procedure is interrupted
b. Where a request for exclusion or challenge of a judge under the provisions of Articles 41-43 of the Civil Procedure Act (a technical examiner to whom Article 188(2)(i) of the Patent Act applies mutatis mutandis and a junior administrative officer to whom Article 50 of the Civil Procedure Act applies mutatis mutandis shall be included) is not accepted due to the decision under Article 45 or Article 46 of the Civil Procedure Act, the period from the date of request for exclusion or challenge to the date of decision to reject the request or the

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period during which the litigation procedure is suspended under the main sentences of Article 48 of the Civil Procedure Act

c. Where a court or a presiding judge orders amendment within a designated period under Article 59 or Article 254(1) of the Civil Procedure Act, the concerned period

d. Where a special representative is appointed under Article 62 of the Civil Procedure Act, the period from the date of request for appointment to the date of designation of the special representative

e. Where the re-opening of a pleading under Article 142 of the Civil Procedure Act is caused by an applicant, the period from the date when the re-opening of the pleading was ordered to the date when the pleading is closed again

f. Where a court prohibits a party of a representative from speaking and sets a new date for continuing the pleadings under Article 144(1) of the Civil Procedure Act, the period from the date of prohibition of the pleading to a new date for making a pleading

g. Where a court orders the appointment of a lawyer under Article 144(2) of the Civil Procedure Act, the period between the date of order of the appointment and the date when the lawyer is designated

h. Where the date designated by a presiding judge is altered to another date later than the initially designated date due to obvious reasons such as a request made by an applicant under Article 165(1) of the Civil Procedure Act, the period between the following date of the designated date and the altered date

i. Where a court extends a statutory period or a period fixed by the court or designates an additional period in regard to the invariable period at the request of an applicant under Article 17 of the Civil Procedure Act, the extended period or the additional period

j. Where procedural acts are subsequently completed after a cause not attributable to an applicant ceased to exist under Article 173 of the Civil Procedure Act, the period between

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the date when the cause was extinguished and the date when the procedural acts are subsequently completed

k. Where transmittal or service by public announcement of documents under Article 178, Articles 186-188 or Article 194 of the Civil Procedure Act is delayed due to an applicant, the periods of delay of the transmittal of the documents

l. Where a litigation procedure is interrupted or suspended under Articles 233-237, Article 239, Article 240 or Article 246 of the Civil Procedure Act, the period during which the litigation procedure is interrupted or suspended

m. Where an applicant to a lawsuit has failed to appear on the date for pleading, or failed to plead even if he/she appeared and then the presiding judge fixes another date for pleading under Article 268(1) of the Civil Procedure Act, the period between the following date of the initial pleading and the newly-set date for pleading

n. In applying for an examination of evidence under Article 289 of the Civil Procedure Act, where the evidence is recognized to be unnecessary, the period between the date for an examination of the evidence and the date when the evidence is deemed unnecessary

o. Where an applicant filed a petition for a retrial after becoming aware of the ground for retrial under Article 451 of the Civil Procedure Act, the period between the date when the applicant has become aware of the ground for retrial and the date of filing a petition for retrial

3. In a procedure for administrative appeals or litigations initiated due to objection against a disposition under Article 224(2)(ⅱ) of the Patent Act, any of the following periods:

a. Where a request for exclusion or challenge under Article 10 of the Administrative Appeals Act is rejected or dismissed due to the decision under Article 12 of the Enforcement Decree of the Administrative Appeals Act, the period during which the concerned appeals procedure has been suspended under Article 13 of the same decree

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b. Where an appeal is brought after force majeure, such as natural disasters, war, emergency or others, no longer exists under Article 27(2) of the Administrative Appeals Act, the period between the date when such causes ceased to exist and the date on which the appeal is brought

c. Where the Central Administrative Appeals Commission (hereinafter, referred to as "commission") orders a correction within a designated period under the main sentence under Article 32(1) of the Administrative Appeals Act, the concerned period

d. Where the commission has designated the deadline for a written supplement under Article 33(2) of the Administrative Appeals Act, the period between the date of setting the deadline and the date of submission of the written supplement

e. Where a date for deliberation fixed by the commission is changed to the date later than the one designated upon request by an applicant under Article 38 of the Administrative Appeals Act, the period between the following date of the initially-fixed date to the changed date for deliberation

f. Where the provisions regarding service of documents under the Civil Procedure Act apply mutatis mutandis according to Article 57 of the Administrative Appeals Act, the period corresponding to the above-mentioned subparagraph (k) of paragraph 2

g. Where provisions of the Civil Procedure Act apply mutatis mutandis according to Article 8(2) of the Administrative Litigation Act, the period corresponding to any of the subparagraphs under paragraph 2 above

4. Beside the periods mentioned above, the periods of delay attributable to an applicant in a patent-related procedure pending before the Korean Intellectual Property Office or the Intellectual Property Tribunal, a litigation procedure against a trial decision under Article 186(1) or (8) or a procedure of administrative trial or litigation against a disposition under Article 224-2(2) of the Patent Act and designated under Ordinance of the Ministry of Knowledge Economy

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② Notwithstanding paragraph 1, where there is any ground objectively proving that the delay in registration of a patent right under Article 92-2(1) of the Patent Act is not attributable to an applicant, the corresponding period shall be exempt from the periods under paragraph 1.

Article 54(5) of the Enforcement Rules of the Patent Act (Periods of delay Due to Applicant) "Period designated by Ordinance of the Ministry of Knowledge Economy" under Article 7-2(1)(iv) of the Enforcement decree of the Patent Act shall refer to one of the following periods:

1. Where the Commissioner of the Korean Intellectual Property Office, the President of the Intellectual Property Tribunal or a presiding administrative patent judge orders submission of electronic documents in writing within a designated period, the designated period (where the period is shortened at the request of an applicant under Article 15(2) of the Patent Act, the shortened length of time shall be exempt)

2. Where the Commissioner of the Korean Intellectual Property Office, the President of the Intellectual Property Tribunal or a presiding administrative patent judge gives an applicant an opportunity to explain within a designated period when ordering the submission of evidential documents under Article 8(4) of the Patent Act, the designated period (where the period is shortened at the request of an applicant under Article 15(2) of the Patent Act, the shortened length of time shall be exempt)

3. Where documents containing the intention of returning application documents deemed illegitimate by the Commissioner of the Korean Intellectual Property Office or the President of the Intellectual Property Tribunal, ground for return and period for explanation are delivered under Article 11(2) of the Patent Act, the period for explanation (where the period is shortened at the request of an applicant under Article 15(2) of the Patent Act, the shortened length of time shall be exempt)

4. Where an examiner defers the decision to grant a patent at the request of an applicant under Article 40(2)(i) of the Patent Act, the period between the date when the applicant submitted a request for deferral of the decision and the date when twelve months have

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elapsed from the date of filing a patent application

5. Where an examiner withholds an examination on a patent application at the request of an applicant under Article 40(3)(iii) of the Patent Act, the period between the date when the applicant made a request for withholding examination and the desired expiration date of withholding the examination (where the desired expiration date of withholding the examination is changed, the changed date shall become the new desired expiration date). However, where an applicant withdraws the request for withholding an examination, the period between the date of request for withholding the examination and the date when the request for withholding the examination is withdrawn

6. Where a court official of Grade V recommends amendment or requests the submission of a correspondence which meets the formality requirements in order to supplement litigation documents according to Article 5(3) or Article 65(3) of the Civil Procedure Rules, the period between the date when the recommendation of amendment or the request for submission of a correspondence was made and the date when the applicant amended the litigation documents or submitted the correspondence

7. Besides the above-mentioned periods, in a patent-related procedure pending before the Korean Intellectual Property Office or the Intellectual Property Tribunal, a litigation procedure against a ruling or a trial decision under Article 186(1) or (8) of the Patent Act or a procedure regarding an administrative trial or litigation regarding any objection against a disposition, the delayed length of period attributable to an applicant due to any request, amendment or submission made by the applicant.

2. Purport

A patent right is created upon registration for establishment of the right and lasts for 20 years from the date of filing a patent application once the patent right is registered. Therefore, where a patent right is registered later than expected due to delayed examination, the term of a patent right is shortened by the delayed length of time, which is unfavorable to an applicant. Considering such fact, the free trade agreement between the Republic of Korea and the United States of America (hereinafter referred to as the KORUS FTA)

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introduced a new system that where a patent right is registered later than a critical date (between the date four years after the filing date of a patent application and the date three years from the date of requesting examination, whichever is later, hereinafter referred to as 'the critical date for extension'), the patent term can be extended for the length of the delay.

However, out of the period where the registration of a patent right is delayed, any delay attributable to an applicant not because of the delay in examination at the Korean Intellectual Property Office needs not be redeemed. Therefore, the periods of delay attributable to an applicant shall be exempt from calculating the period for extension.

The newly-introduced system for extending the term of a patent right due to a delay in registration of a patent right shall apply only to patent applications filed after the KORUS FTA takes effect.

3. Period Allowed for Extension

3.1 Inventions eligible for Patent Term Extension

To be eligible for extension of the patent term due to a delay in registration of a patent right, the date of registration of establishment of a patent right shall be later than a critical date for extension. Also, since the periods of delay attributable to an applicant shall be exempt from calculating the period for extension, the actual extension is for 'the length of the period between the critical date for extension and the date of registration of a patent right with the number of the delayed attributable to an applicant taken away'. Only when the length of a period exceeds zero after calculation, it shall become the subject for extension of a patent term.

The filing date of a divisional application, a converted application and an application filed by a lawful right holder shall be retroactive to the filing date of the original application or the date of filing the application by an unentitled person and an international application shall have a filing date of an international application. However, when it comes to the extension of the term of a patent right due to delay in registration, in determining 'the date four years after the date of filing a patent application', the actual filing date of a divisional application,

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a converted application or an application by a lawful right holder or the date for submission of documents under Article 203(1) of the Patent Act shall be each deemed 'the filing date of a patent application'. As for a divisional application or an international patent application, the period between the filing date of the original application and the actual filing date of the divisional application or between the filing date of an international application and the date when the application enters into the national phase is spent by an applicant's choice. Therefore, the periods of delay attributable to an applicant is exempt from the calculation for extension of the term of a patent right and the date four years after the date of filing a patent application' shall be calculated based on the actual filing date.

3.2 Implication of 'Periods of delay Attributable to Applicant'

Delays attributable to an applicant mean that procedural delays are caused by an applicant. It does not necessarily refer to the case that an applicant is responsible for all the delays.

Even when the date of registration of establishment of a patent right is later than the critical date for extension, whether the concerned inventions are eligible for extension of patent term and the length of a period allowed for extension are determined depending on periods of delay attributable to an applicant. Therefore, it is crucial to precisely calculate the period of delay attributable to an applicant in order to extend of the term of a patent right. Article 7-2 of the Enforcement Decree of the Patent Act specifies the types of procedural delays attributable to an applicant and periods of delays in a patent-related procedure (Article 1(1)), a litigation procedure regarding a court ruling, etc.(Article 1(2)), a procedure of an administrative trial or litigation(Article 1(3)) in a total of 41 subparagraphs. Also, the Enforcement Rules of the Patent Act which Article 1(4) of the Enforcement Decree of the Patent Act mandates provides a total of six subparagraphs for the types of procedural delays attributable to an applicant and periods of delays. Besides, if a procedural delay is attributable to an applicant in a patent-related procedure, a litigation procedure regarding a court ruling or a procedure for an administrative trial or litigation, it may constitute 'periods of delay attributable to an applicant' prescribed in Article 92-2(2) and (3) of the Patent Act.

Meanwhile, even though a period falls under the periods of delay specified under Article 7-2(1) of the Enforcement Decree of the Patent Act, if such delay is objectively recognized to

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attributable to an applicant considering the specific condition of the concerned case, the period shall not be deemed to fall under 'periods of delay attributable to an applicant' indicated in Article 92-2(2) and (3) of the Patent Act.

3.3 Types of Periods of Delay Attributable to Applicant

The followings are some of the types of 'periods of delay attributable to an applicant' specified under Article 7-2(1)(i) of the Enforcement Decree of the Patent Act regarding a patent-related procedure pending before the Korean Intellectual Property Office or the Intellectual Property Tribunal.

(1) Where an applicant extends the period for requesting a trial or the designated period for initiating a patent-related period:

Since a procedural delay is caused by an applicant's extending the period for an appeal against a decision of rejection or the period designated by the Commissioner of the Korean Intellectual Property Office or an examiner, the length of the extended period shall be deemed the period of delay attributable to an applicant. Where an applicant extends the period and then shortens it, the length of the shortened period shall not be deemed 'the period of delay attributable to an applicant'.

(2) Where a patent-related procedure such as examination, trial, etc., is interrupted or suspended due to conditions beyond an applicant's control:

For example, where an applicant dies while his/her application is still pending, the period between the date when the procedure is interrupted due to death of the applicant and the date when the successor resumes the interrupted procedure shall be deemed 'the period of delay attributable to an applicant'.

(3) Where the result of consultation is required to be reported under Article 36(6) of the Patent Act:

As for more than two patent applications filed on the same invention at the same date,

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where the Commissioner of the Korean Intellectual Property Office orders an applicant to report the result of consultation within a designated period, the designated period shall constitute 'the period of delay attributable to an applicant'. Where the designated period is shortened at the request of an applicant, the shortened length of the period shall not be deemed 'the period of delay attributable to an applicant'.

(4) Where the Commissioner of the Korean Intellectual Property Office orders amendment on irregularities in formalities under Article 46 of the Patent Act or amendment on documents of Article 203(1) of the Patent Act according to Article 203(2) of the same act; or a presiding judge orders amendment on irregularities in a request for trial or formalities of a trial-related procedure:

Such amendments are requested because an applicant, etc. submitted documents which do not observe formalities or failed to pay the fees prescribed under the act. Therefore, the period which the Commissioner or the President designated while ordering amendments shall be deemed 'the period attributable to an applicant'. However, where procedures for amendment orders under Article 46 or Article 203(2) of the Patent Act and subsequent procedures are completed before filing a request for examination and the registration of a patent right is not recognized to be delayed due to the above-mentioned procedures, the designated period for amendment shall not be deemed 'the period attributable to an applicant'.

Meanwhile, where an amendment order is mistakenly made and the Commissioner of the Korean Intellectual Property Office or the presiding patent judge recognizes after reconsideration of the application that no irregularities are present in formalities and an applicant, etc. needs not make amendment, the period which the Commissioner or the presiding patent judge designated while ordering amendments

(5) Where an application was a basis of domestic priority claim and then the priority claim is withdrawn or deemed to be withdrawn:

Where an application is withheld from examination on the ground that it is a basis of domestic priority claim under Article 55(1) of the Patent Act and then the examination on

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the application is no longer withheld since the priority claim is withdrawn or the priority claim is considered to be withdrawn under Article 56(3) of the Patent Act, the period during which examination on the application was withheld shall be deemed 'the period of delay attributable to an applicant'.

(6) Where the determination on whether an application is subject to accelerated examination is made late because of an applicant:

Where a person in charge of granting an application accelerated examination status orders amendment on a written request for accelerated examination or attached documents within a designated period, the designated period shall not be deemed 'the period of delay attributable to an applicant'.

(7) Where an examiner notifies a ground of rejection and gives an applicant an opportunity to submit a written opinion under Article 63 of the Patent Act:

Where an examiner notifies an applicant of a ground of rejection since the applicant failed to fulfill the requirements such as he/she filed an unpatentable invention or any deficiency is found in the specification, the period allowed for submission of a written opinion shall be deemed to be 'the period of delay attributable to an applicant'. However, after an examiner notified a ground for rejection, where the examiner recognized that the ground for rejection is addressed when the applicant submitted a written opinion or explanation without taking any other measure to address the rejection ground, such as amendment on a specification or drawing(s), withdrawal/abandonment of another application or transfer of an application, and made a decision to grant a patent, the period for submission of the written opinion shall not constitute 'the period of delay attributable to an applicant'.

Where a presiding patent judge notified a ground of rejection and give an applicant an opportunity to submit a written opinion with Article 63 of the Patent Act applied mutatis mutandis according to Article 170 of the same act, the aforementioned shall apply, too.

(8) Where the payment of a patent fee is made after a certified copy of a decision to grant a patent is delivered:

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The period between the date of delivery of a certified copy of a decision to grant a patent and the date when the patent right is registered after the payment of a patent fee (including the case where an additional payment of a patent fee is made after the period for payment has elapsed; the payment of the remaining patent fee is made; or the payment of a patent fee or the remaining the patent fee is made under Article 81(3) of the Patent Act) shall constitute 'the period of delay attributable to an applicant'.

Where an applicant is exempt from the payment of a patent fee under Article 83 of the Patent Act, the period between the date of delivery of a certified copy of a decision to grant a patent and the date when the applicant is exempt from the payment of a patent fee after submitting documents specified under Ordinance of the Ministry of Knowledge Economy according to Article 83(3) of the Patent Act shall be deemed 'the period of delay attributable to an applicant'.

(9) Where a request for reexamination is made:

Where an applicant amended specification or drawing(s) and made a request for reexamination, if the previously-notified ground for rejection is addressed due to the specification or drawing(s) amended while requesting reexamination and a decision to grant a patent is made in a procedure of reexamination or trial, etc., it may be deemed that the applicant failed to address the ground for rejection through amendment and ended up requesting reexamination. Therefore, the period between the date of delivery of a certified copy of a decision to grant a patent and the date when a request for reexamination is made shall be deemed 'the period of delay attributable to an applicant'.

(10) Where the delivery of documents is delayed because of an applicant:

Where the transmittal of documents is delayed since the address or business address of an applicant or a legal representative to whom documents are to be delivered is unclear, the length of delay for transmittal of documents shall be ' the period of delay attributable to an applicant'. For example, where a copy of a decision to reject a patent was returned because the applicant failed to report a change of address to the Korean Intellectual Property Office

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and the examiner identified the new address of the applicant by using the administrative information sharing system, etc., sent the decision again and then the applicant finally received the copy, the period between the date when the applicant would have received the copy of decision if he/she had reported a change of address and the date when the applicant actually received the copy shall constitute 'the period of delay attributable to an applicant'.

(11) Where examination on a patent application is withheld at the request of an applicant:

Where examination on a patent application is withheld at the request of an applicant, the period between the date when the applicant made the request for withholding examination and the date when the desired period for withholding examination elapses (where the date when the desired period for withholding examination passes, the changed date) shall be 'the period of delay attributable to an applicant'. However, where a request for withholding examination is withdrawn, only the period between the date of request for withholding examination and the date when the request is withdrawn shall be deemed 'the period of delay attributable to an applicant'.

Also, some of the types of periods of delay attributable to an applicant specified under Article 7-2(1)(ii) of the Enforcement decree of the Patent Act regarding a litigation procedure against a decision of rejection of a court decision, a request for trial, etc. or another litigation trial against the ruling of the litigation are the followings:

(1) Where a request for exclusion or challenge of a judge, etc. made by an applicant is not accepted:

Where an applicant made a request for exclusion or challenge of a judge, an official of Grade v or a court clerk, but the request is not accepted, the period between the date when the request for exclusion or challenge was made and the date when a decision of rejection is made or the period where a litigation procedure is suspended under Article 48 of the Civil Procedure Act due to the request for exclusion or challenge of a judge, etc. shall constitute 'the period of delay attributable to an applicant'.

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(2) Where a court orders amendment to litigation capabilities of the party concerned or irregularities in the right of representation, or where a presiding judge orders amendment to irregularities in petition:
Where a court orders amendment to litigation capabilities of the party concerned or irregularities in the right of representation, or where a presiding judge orders amendment to irregularities in petition within a designated period, the designated period for such amendment shall constitute 'the period of delay attributable to an applicant.'

(3) Where a presiding judge resets the date for pleading since an applicant failed to be present on the date for pleading:

Where a presiding judge resets the date for pleading since an applicant failed to be present on the designated date for pleading or where, even though the applicant did show up, he/she failed to make a pleading, the period between the following date of the initially-designated date for pleading and the newly-designated date for pleading shall be 'the period of delay attributable to an applicant'.

(4) Where a request for evidential documents made by an applicant is not deemed necessary:

Where an applicant made a request for unnecessary evidential documents and the court considers that the request is not necessary, the period between the date of request for evidential documents and the date when such evidence is recognized not to be necessary shall constitute 'the period of delay attributable to an applicant'.

Meanwhile, the length of period delayed because the Central Administrative appeals Commission ordered amendment to a request within a designated period or designated a period for submission of supplementary documents in an administrative trial or litigation, such delayed period shall be deemed 'the period of delay attributable to an applicant'.

Also, periods delayed due to a request, amendment or submission made by an applicant in a patent-related procedure, a litigation procedure against a trial decision or ruling or an

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administrative trial or litigation shall be deemed 'the period of delay attributable to an applicant.'

3.4 Exceptions of Periods of Delay attributable to Applicant

As looked into by each item, where periods fall under any of the periods of delay attributable to an applicant' under Article 7-2(1)(i)-(iii) of the Enforcement Decree of the Patent Act and Article 54(5)(i)-(vii) of the Enforcement Rules of the Patent Act, such periods shall be deemed to correspond to periods of delay attributable to an applicant. Therefore, they shall be exempt from the calculation of the period for extension of the term of a patent right due to a delay in registration. However, where such delays are not caused by an applicant after specific conditions of the concerned periods of delay are considered, the periods of delay shall be exempt from periods of delay attributable to an applicant under the above-mentioned articles of the Enforcement Decree and Enforcement Rules of the Patent Act.

The cases where the period is exempt from periods of delay attributable to an applicant under Article 7-2(i) of the Enforcement Decree of the Patent Act in accordance with Article 7-2(ii) of the Enforcement Decree of the same act are as follows: i) where such delay was occurred before the request for examination on the application, not affecting the delay in registration of a patent right; ii) where an amendment order or notification was made by mistake of the Korean Intellectual Property Office, etc.; or iii) where such delay was caused by other reasons, such as natural disasters, not an applicant.

Examples that correspond to the case i) include where a delay in registration of a patent right is not caused since an amendment order and the subsequent procedures under Article 46 of the Patent Act were completed before the request for examination and where the domestic priority claim of a prior application was withdrawn, but a request for examination on the prior application has not been made yet. An example under the case ii) is where, after an amendment order or a notification of the submission of a written opinion, irregularities in formalities or grounds for rejection are recognized to have been addressed even without amendments to formalities or a specification, etc. Where a procedure is interrupted because of natural disasters shall fall under the example of the case (iii).

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4. Application for Registration of Extension of Patent Term due to Delay in Registration

4.1 Relevant Provisions

Article 92-3 of the Patent Act (Application for Registration of Extension of Patent Term due to Delay in Registration) ① A person who intends to file an application to register an extension of the term of a patent right under Article 92-2 of the Patent Act (in this provision and Article 92-4 of the Patent Act, referred to as 'an applicant for registration of extension') shall submit an application for registration of extension of a patent term indicating the following items to the Commissioner of the Korean Intellectual Property Office.

1. The name and address of an applicant for registration of extension (in case of a legal entity, the title and business address of the legal entity)

2. In the presence of a legal representative of an applicant for registration of extension, the name and address of the legal representative or the business address of the legal representative (in case of a patent law firm, the title and address of the firm and the name of the designated patent attorney)
3. The patent number of a patent right eligible for extension of its term

4. The period allowed for extension request

5. The ground for extension designated under Ordinance of the Ministry of Knowledge Economy (evidential documents of such grounds shall be attached)

② An application to register an extension of the term of a patent right under paragraph (1) shall be filed within three months from the date of registration for establishment of a patent right.

③ Where a patent right is jointly owned, all the owner shall jointly file an application to register an extension of the term of a patent right.

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④ An applicant for registration of extension can make an amendment to the items of (1)(iv) and (v) among the items disclosed in a written application for registration of extension before an examiner determines whether to register an extension of the term of a patent right. However, after a notification of the ground for rejection which applies mutatis mutandis under Article 93 of the Patent Act is delivered, an application is allowed to make an amendment within the period for submission of a written opinion according to the concerned notification of the ground for rejection.

Article 54-2 of the Enforcement Rules of the Patent Act (Written Application for Registration of Extension of Patent Term due to Delay in Registration) A person who intends to make an application for registration of extension of the term of a patent right under Article 92(3)(i) of the Patent Act (in this provision and Article 54-4, referred to as 'an applicant for registration of extension') shall submit a written application of Annexed Form 30-2 to the Commissioner of the Korean Intellectual Property Office with the following documents attached:

1. Ground for extension and a copy of the evidential document of the extension ground

2. Where a legal representative initiated a procedure, a copy of the evidential document of the legal representation

Article 54-3 of the Enforcement Rules of the Patent Act (Ground for Extension of Patent Term due to Delay in Registration) Grounds for extension designated under Ordinance of the Ministry of Knowledge Economy according to Article 92-3(1)(v) of the Patent Act are as follows:

1. A need to extend the term of a patent since a patent right which was filed for registration of extension was established after four years from the date of filing a patent or the date of request for examination, whichever expires later.

2. The period of request for extension and the explanation that the period of delay attributable to an applicant is exempt from the period of request for extension under Article

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92-2(2) of the Patent Act and the evidential document

3. Other necessary items to prove the ground for extension

4.2 Applicant for Registration of Extension

An applicant of the application to register an extension of the term of a patent right due to a delay in registration only refers to a patent right holder. Where a patent right is jointly owned, all the owners of the patent right shall file an application to register an extension of the term of a patent right.

Where a person who filed an application to register an extension of the term of a patent right due to a delay in registration is not a patent right holder or where the owners of the jointly-owned patent right failed to file an application to register an extension of the term of a patent right shall constitute a ground for rejection.

4.3 Period allowed for Application

An application to register an extension of the term of a patent right due to a delay in registration shall be filed within three months from the date of establishment of a patent right.

Where an application to register an extension of the term of a patent right is filed before the date of establishment of a patent right or where an application to register an extension of the term of a patent right is filed when three months have elapsed from the date of establishment of a patent right, an examiner shall give an opportunity of explanation under Article 11 of the Enforcement Rules of the Patent Act and return the application for registration of an extension of the term of a patent right to the applicant.

4.4 Application Documents

(1) A person who intends to file an application to register an extension of the term of a patent right due to a delay in registration shall attach 'grounds for extension designated

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under Ordinance of the Ministry of Knowledge Economy and a copy of the evidential documents' and ' a copy of the evidential documents of the legal representation if a procedure is initiated by a legal representative' to a patent application under Annexed Form 30 of the Enforcement Rules of the Patent Act and submit the documents to the Commissioner of the Korean Intellectual Property Office.

(2) An application for registration of extension shall be written considering the followings:

① The name of a patent right holder shall be written in the box of an applicant for registration of extension. Also, where a patent right is jointly owned, the names of all the owners shall be written.

② In the box for 'Patent Numbers', the patent number for which the extension of the term of a patent right due to a delay in registration is sought shall be written.

③ In the box for 'Period of Request for Registration of Extension', the period of delay attributable to an applicant (the number of delayed days)(F) shall be written. The periods of delay attributable to an applicant includes the date deemed to be the filing date of a patent application under Article 92-2(4) of the Patent Act; the date four after the date of filing a patent application(A); the date of request for examination; the date three years after the date of examination request(B); the later date between the date four years after the date of filing a patent application or the date three years after the date of request for examination request(C); the date of establishment of a patent right after the payment of patent fees(D); the period(number of days)(E) from 'the later date(C) of (A) and (c)' to 'the date of establishment of a patent right'(D) or the period corresponding to any paragraphs of Article 7-2(1) of the Enforcement Decree of the Patent Act(the period for submission of a written opinion, etc.). Also, the period of delay after calculation ('the period of delay (E)'-'the period of delay attributable to an applicant (F)') shall be written.

④ In the box 'Ground for Extension', the ground that an application to register an extension of the term of a patent right has to be filed because the patent right was established later than the critical date for extension(between the date four years from the date of filing a patent application and the date three years after the date of request for examination,

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whichever expires later) shall be written. Also, explanations that the period of delay attributable to an applicant is exempt under Article 92-2(2) of the Patent Act shall be written by each ground(for example, 123 days for the period of submission of written opinion) in detail in the box for 'Period for Request for Registration of Extension'. In addition, evidential documents of the ground for extension shall be attached.

4.5 Legal Representation Right on Application for Registration of Extension

Unlike withdrawal of an application for registration of extension, etc., an application to register an extension of the term of a patent right due to a delay in registration is not entitled to a specially conferred authorization. Therefore, an application to register an extension of the term of a patent right can be delegated without special authority. However, since the procedure for filing an application to register an extension of the term of a patent right due to a delay in registration is somewhat ambiguous with regard to whether it is for filing another application or it is for registration, the part for 'Legal Representation of Application for Registration of Extension of Patent Term by Permission, etc.' under Chapter 7. 1. 5 shall be referred to regarding the scope of legal representation.

5. Examination

5.1 relevant Provisions

Article 92-4 of the Patent Act (Decision to Grant Rejection of Registration for Extension of Patent Term due to Delay in Registration) Where an application to register an extension of the term of a patent right under Article 92-3 of the Patent Act falls under any of the following paragraphs, an examiner shall make a decision to reject the registration of the extension on the application:

1. Where the period of request for extension exceeds the period for extension recognized under Article 92-2

2. Where an applicant of registration for extension is not the patent right holder

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3. Where an application of registration for extension was filed in violation of Article 92-3(3) of the Patent Act

Article 92-5 of the Patent Act (Decision to Grant Rejection of Registration for Extension of Patent Term due to Delay in Registration, etc.) ① Where an application to register an extension of the term of a patent right under Article 92-3 of the Patent Act is not found to have any ground under each paragraph of Article 92-4 of the Patent Act, an examiner shall make a decision to register an extension of the term of a patent right.

② Where the decision to register an extension of the term of a patent right is made under paragraph (1) of the same article, the Commissioner of the Korean Intellectual Property Office shall register the extension of the patent term in the Patent Register

③ Where the above-mentioned registration is made, the following items shall be written in the Patent Register:

1. Name and address of the patent right holder (in case of a legal entity, the title and business address)

2. Patent number

3. Date of registration for extension

4. Period for extension

Article 93 of the Patent Act (Mutatis Mutandis Application) Articles 57(1), 63, 67, 148(1)-(5) and (7) of Patent Act shall apply mutatis mutandis to examination on an application to register an extension of the term of a patent right.

5.2 Flowchart and Overview of Examination Procedure

A procedure for examining an application to register an extension of the term of a patent right due to a delay in registration is similar to that for examination on a patent application.

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Where no provision on the detailed examination procedure is present, the procedure for examination for a patent application shall apply mutatis mutandis. Regarding the flowchart and overview of a procedure for examination, "6.2 Flowchart and Overview of Examination Procedure" of an application to register an extension of the term of a patent right under Article 7(1)(vi) of the Patent Act shall be referred.

5.3 Formality Examination on Application of Registration for Extension

Where an application to register an extension of the term of a patent right due to a delay in registration transferred from the division of document receipt is in violation of the formalities, an examiner shall treat the application in the following manners:

(1) Where an application to register an extension of the term of a patent right due to a delay in registration is filed when the period under Article 92-3(2) of the Patent Act has elapsed (within three months from the date of establishment of a patent right), an examiner shall write the intention to return the application, the ground for return and the period for explanation in a notification of ground for return and deliver it to the applicant.

After the notification of the ground for return, where an applicant make a request for return of the application documents or where the contents of the submitted explanation is recognized to be groundless, the examiner shall return the relevant documents.

(2) Where an application to register an extension of the term of a patent right due to a delay in registration is in violation of the provisions regarding a legal representative designated in Article 46 of the Patent Act; where an applicant failed to make the payment of fees; or where the application is in violation of the formalities specified in the Patent Act or Decree, an examiner shall order an amendment to the application.

Despite amendment order, where the irregularities are not addressed within the designated period, an examiner shall invalidate the patent-related procedure in the name of the Commissioner of the Korean Intellectual Property Office.

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5.4 Substantive Examination of Application of Registration for Extension

5.4.1 Determination of Subject for Examination

The subject for examination is an application to register an extension of the term of a patent right due to a delay in registration and relevant attached documents. However, where amendment (A) was made, an examiner shall determine whether to recognize the amendment and specify the subject for examination. Where the amendment is legitimate, an examiner shall examine the application with the amended content reflected. Where the amendment is not legitimate, the examiner shall deem that the amendment has never been made and examine the application to register an extension of the term of a patent right before the amendment.

Where multiple amendments are made, the examiner shall determine the amended content based on the combination of the finally-amended parts. Then, the subject for examination shall be the application that has reflected the content of the final amendments in the legitimate written amendment. Where multiple amendments are made, 'Determination Standard of Amended Content' of Chapter 5 shall be referred.

5.4.2 Determination on Existence of Rejection Ground

Where an application to register an extension of the term of a patent right due to a delay in registration falls under any paragraph of Article 92-4 of the Patent Act, an examiner shall notify the ground for rejection on the application of registration for extension.

(1) Where the period of request for extension exceeds the period for extension recognized to be legitimate under Article 92-2 of the Patent Act
The period allowed for requesting an extension is the length of the time period passed (the number of days) (E) from the date of establishment of a patent right (D) based on the critical date (C) which is the later date between the date four years after the filing date of a patent application (A) and the date three years after the date of request for examination (B) under Article 92-2(4) of the Patent Act, with the length of period of delay attributable to an applicant (F) under the paragraphs of Article7-2(1) of the Enforcement Decree of the Patent

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Act subtracted.

The detailed calculation for the period of extension is conducted in the following manners:

① Determination on 'Filing date of Patent Application'

When calculating 'four years from the date of filing a patent application' in an application to register an extension of the term of a patent right due to a delay in registration, notwithstanding Articles 34, 35, 52-2, 53-2, 199-1, 214-4 of the Patent Act, the date when a lawful patent right holder filed an application, the date of filing a divisional application, the date of filing a converted application, the date of submission of document under Article 203-1 and the date when an application of an international application requests for a decision under Article 214-1 of the Patent Act shall be considered to be the date of filing a patent application. As for a patent application which does not correspond to the above-mentioned, its filing date shall be deemed when it was actually filed.

Therefore, for example, where an applicant of an application to register an extension of the term of a patent right due to a delay in registration of the divisional application which has been established submitted a written application to register an extension of the term of a patent right due to a delay in registration after calculating four years from the date of filing a patent application based on the filing date of the initial application as the filing date of a patent application, an examiner can order amendment to the written application of registration for extension.

② Determination on Later Date of Four Years from Filing Date of Patent Application and Three Years from Date of Request for Examination

The critical date in calculating the period of delay shall be set on the later date between the date four years from the date of filing a patent application and the date three years after the date of request for examination. If an applicant incorrectly wrote the critical date and submitted a written application to register an extension of the term of a patent right due to a delay in registration, an examiner can order amendment to the written application of registration for extension.

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③ Calculation of Period of Delay

The period (the number of days) from the above-mentioned critical date and the date of establishment of a patent right after patent fee payment shall be calculated. If an applicant incorrectly wrote the critical date and submitted a written application to register an extension of the term of a patent right due to a delay in registration, an examiner can order amendment to the written application of registration for extension.

④ Calculation of Period of Delay Attributable to Applicant

All of the periods of delay attributable to an applicant (for example: the period for submission of a written opinion, etc.) which fall under any of the paragraphs under Article 7-2(1) of the Enforcement Decree of the Patent Act (including the paragraphs of Article 54-5 of the Enforcement Rules of the Patent Act) shall be added up. However, where periods for delay attributable to an applicant overlap, the period exempt from the extension of the term of a patent right shall not exceed the period of actual delay attributable to an applicant.

Moreover, even though the period of delay attributable to an applicant falls under any of the paragraphs of Article 7-2(1) of the Enforcement Decree of the Patent Act (including the paragraphs of Article 54-5 of the Enforcement Rules of the Patent Act), where there is any objectively-recognized ground that the delay in establishment of a patent right is not attributable to an applicant, such period shall be exempt from the period of delay attributable to the applicant. Such examples include where the procedure of substantive examination is not affected since it happened before an applicant made a request for examination, where an amendment order or a notification of ground for rejection, etc., was made by mistake of the Korean Intellectual Property Office or a patent court, etc., or where delays were caused by natural disasters, other than an applicant.

⑤ Calculation of Period of Request for Registration for Extension

The period allowed for request for registration of extension is the one with the period of delay attributable to an applicant in ④ subtracted from the period of delay in ③ and it

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shall become the period for extension recognized under Article 92-2 of the Patent Act. If the period of request for registration of extension written in a written application of registration for extension exceeds the above-mentioned period for extension, an examiner shall notify a ground of rejection to the applicant in accordance with Article 63 of the Patent Act which Article 93 of the same act applies mutatis mutandis and give the applicant an opportunity to submit a written opinion.

Where more than one of the above-mentioned items ①-④ is incorrectly written in a written application of registration for extension and it leads the period of request for registration of extension in ⑤ to exceed the period allowed for extension which is recognized under Article 92-2 of the Patent Act, an examiner shall notify the ground for rejection that it is in violation of Article 92-3(1) of the Patent Act. After notification, where the applicant addressed the ground for rejection through amendment of correctly writing the items of ①-⑤, the examiner shall make a decision to register an extension. Where the ground for rejection was addressed through the amendment, but any of the items ①-④ is still written incorrectly, the examiner shall order amendment to the written application of registration for extension.

The following table shows the example of calculation of the period allowed for requesting registration of extension according to the procedures above.
(Example)

Date	Process
2013. 1. 1.	Filing of Patent Application
2015. 1. 1.	Request for Examination
2016.10. 1.	Transmittal of Notification of Submission of Written Opinion
2016.12. 1.	Request for Extension of Period (2 months)
2017. 2. 1.	Submission of Amendment and Opinion

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2017. 8. 1.	Transmittal of Copy of Decision to Reject Patent
2017. 9. 1.	Request for Extension of Statutory Period
2017.10. 1.	Request for Re-examination
2017.11. 1.	Transmittal of Copy of Decision to Reject Patent
2017.12. 1.	Request for Trial against Decision to Reject
2018. 8. 1.	Affirmed Decision of Request for Appeal against Decision of Rejection
2018.10. 1.	Transmittal of Copy of Decision to Register Patent
2019. 1. 1.	Payment of Patent Fee (Establishment of Patent Right)

Since the date three years after the date of request for examination on a patent application (2018.1.1) is later than the date four years from the filing date of the application (2017.1.1), the critical date of calculating the period of delay shall be on 2018.1.1. The period between the critical date and the date of establishment of a patent right (2019.1.1) after the patent fee payment shall be for 365 days. Meanwhile, the period for submission of a written opinion after the notification of the ground for rejection by an examiner (123 days, 2016.10.1~2017.2.1), the period of delay due to a request for re-examination (61 days, 2017.8.1~2017.10.1) and the period of delay commencing from the date of transmittal of a certified copy of the decision to grant a patent right and to the date of establishment of the patent right after the patent fee payment (92 days, 2018.10.1~2019.1.1) shall constitute the period of delay attributable to an applicant (123+61+92=276 days). Therefore, the period allowed for registration of extension shall be for 89 days, with the period of delay attributable to an applicant (276 days) subtracted from the total length of period of delay (365 days).

5.4.3. Notification of Ground for Rejection

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Where an examiner intends to make a decision to reject registration for extension under Article 63 of the Patent Act which Article 93 of the same act applies mutatis mutandis since the application to register an extension of the term of a patent right falls under the subparagraphs of Article 92-4 of the Patent Act, he/she shall notify the ground for rejection to an applicant and then give the applicant an opportunity to submit a written opinion within a designated period.

When notifying a ground for rejection, an examiner shall write relevant provisions or grounds precisely and concisely so that an applicant clearly understands the ground for rejection. General information on notification of ground for rejection shall be referred to the corresponding part in PART V.

At the notification of the ground for rejection, the period for submission of a written opinion shall be within two months. The period for submission of a written opinion designated by an examiner is extendable. The extension of the period for submission of a written opinion can be made, at the request of an applicant, four times for one month each time (see '4.2 Extension and Acceptance of Substantive Examination-related Designated Period).

5.4.4 Treatment of Written Opinion and Amendment

Where an examiner notified a ground for rejection regarding an application to register an extension of the term of a patent right, an applicant may submit a written opinion or an amendment. However, an applicant does not necessarily have to submit a written opinion or an amendment.

A written opinion can be submitted within the designated period specified in a notification of submission of a written opinion. An amendment can be submitted until a certified copy of the decision to register an extension is delivered after filing the application, but after an examiner notifies the ground for rejection, the amendment can be submitted only within the period for a written opinion according to the notification of the concerned ground for rejection.

(1) Where a written opinion is submitted, an examiner shall re-determine whether the

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ground for rejection is actually present, taking the claim of the applicant described in a written opinion into consideration.

(Note) Even though a written opinion is submitted after the period for submission of a written opinion has elapsed or before the notification of the ground for rejection, an examiner shall accept the written opinion and refer to it for examination.

(2) Where an amendment is submitted, an examiner shall re-examine the application considering the amended parts disclosed in the written amendment, as long as the amendment is legitimate.

Amendable parts in an application to register an extension under Article 92-3(4) of the Patent Act include: ① the period of request for extension and ② the ground for extension designated in Ordinance of the Ministry of Knowledge Economy. Therefore, amendment of changing an applicant of registration for extension and amendment of changing the patent number of the patent right shall not be allowed, except for correcting clerical errors.

Where an amendment is submitted, an examiner shall examine whether the subject for amendment is legitimate. Where an applicant amended the part which cannot be amended in the first place, the examiner shall notify a warning notice of inadmissible amendment and give an applicant an opportunity of explanation. Where an examiner notifies the ground for rejection again because of a warning notice of inadmissible amendment disclosing the reason why the amendment cannot be accepted, the warning notice for inadmissible amendment can be replaced with the notification of submission for a written opinion.

Where an examiner cannot accept a written opinion despite the explanation given by an applicant, he/she shall make a notification of inadmissible amendment and re-examine the pre-amendment application. Where an examiner intends to reject the application based on the notification of inadmissible amendment indicating the ground for rejection, the notification of inadmissible amendment can be replaced with a written decision of rejection.

(Note 1) Where a procedure for an application of registration for extension is terminated according to general principles of the procedure of filing a patent application, any

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amendment cannot be recognized to be legitimate. Therefore, where an application of registration for extension is invalidated, withdrawn, abandoned, or returned, or where a patent right is invalidated or abandoned, an applicant cannot submit a written amendment.

(Note 2) Where a patent right is jointly owned, amendment where only some of the co-owners filed an application of registration for extension and then the names of the applicants who were not disclosed in the initial application of registration for extension are included or amendment in which the names of the registered patent right holders are changed to match the names of the patent right holders and the applicants of registration for extension so as to address the ground for rejection shall not be recognized.

Meanwhile, amendment of correcting the incorrectly-written name of an applicant or amendment of changing the name of a patent right holder to that of a general successor in the case of general succession of a patent right shall be recognized.

(Note 3) A person who initiated a patent-related procedure can amend the procedure as long as it is still pending before the Korean intellectual Property Office. However, under Article 92-3(4) of the Patent Act, the patent number is restricted from amendment among the contents of an application to register an extension of the term of a patent right due to a delay in registration. Therefore, correcting the incorrectly-written patent number raises an issue in amendment.

Article 92-3(4) of the Patent Act indicates that the period of registration for extension claimed at the time of filing an application of registration for extension can be changed, but the change of the patent number is allowed since it would change the subject for registration of extension of the term of a patent right due to a delay in registration. Therefore, where the patent number written in an application of registration for extension is a clerical error (where the indication of the patent number is a clerical error with the filing date, the patent number and the patent date considered), any amendment, except for amendment of correcting the clerical error, shall not be recognized.

(3) Once amendment is recognized to be legitimate, the amended application is recognized to have been filed in the first place. Then, an examiner shall conduct examination on the

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amended application.

5.4.5 Determination on Registration of Extension

Determination on whether to extend the term of a patent right due to a delay in registration shall be in writing under Article 67 of the Patent Act which Article 93 of the same act applies mutatis mutandis.

(1) Determination on registration for extension · Determination on rejection

Where an examiner intends to determine whether to register an extension of the term of a patent right due to a delay in registration, he/she shall report the intention to the director of the examination division (or the team head) and write and a decision of registration for extension or a decision to reject registration for extension indicating the followings and sign and seal such decision. However, a decision to reject registration for extension shall not contain the items ③ and ④ below.

① Application Number of Registration of Extension
② Patent Number
③ Period for Extension
④ Content of Period of Delay
⑤ Name and Address of Applicant of Registration for Extension (Title and Business Address in case of legal entity)
⑥ In presence of legal representative of applicant of registration for extension, Name and Address or Business Address of Legal Representative (Title, Business Address and Name of Designated Patent Attorney where a legal representative is a patent law firm)
⑦ Order and Ground for Decision
⑧ Date of Decision

(2) Transmittal of Determination on Registration for Extension

Where registration for extension of the term of a patent right due to a delay in registration is determined, the Commissioner of the Korean Intellectual Property Office shall deliver a

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certified copy of the decision. Details related to transmittal of a decision shall be referred to provisions regarding transmittal of a certified copy of a decision to grant/reject a patent right.

6. Other Examination Procedures

6.1 Publication on Patent Gazette, etc.

Where an examiner determines registration of extension of the term of a patent right due to a delay in registration, he/she shall request the Registration Division to publish ① the name and address of a patent right holder (the title and business address in case of a legal entity), ② the patent number ③ the date of registration for extension ④ the period for extension on the patent gazette.

6.2 Trial on Decision to Reject Registration of Extension

Where an applicant who has received a decision to reject an extension of the term of a patent right appeals the decision since the application to register an extension of the term of a patent right falls under any subparagraph of Article 92-4 of the Patent Act, the applicant can request an appeal trial of the decision to reject registration for extension within thirty days from the date of transmittal of a certified copy of the concerned decision.

6.3 Invalidation Trial on Patent Right Registered for Extension

Where a patent right whose term is extended falls under any paragraph of Article 134-2 of the Patent Act since the application to register an extension of the term of a patent right due to a delay in registration is determined for registration of extension, an applicant can request a trial to invalidate the patent right.

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Chapter 3. Examination on National Defense-related Application

1. Relevant Provisions

Article 41 of the Patent Act (Inventions, etc. Necessary for National Defense) ① If necessary for the national defense, the Government may order an inventor, an applicant, or a representative not to file a patent application for an invention in foreign patent offices concerned or to keep such invention confidential: Provided, That if such persons obtain permission from the Government, they may file an application therefor in foreign patent offices.

② If an invention filed with the Korean Intellectual Property Office is considered necessary for national defense, the Government may refuse to grant a patent and, for reasons of national defense, such as in time of war, uprising or other similar emergency, may expropriated the right to obtain a patent therefor.

③ The Government shall pay reasonable compensation for losses arising from the prohibition of a patent application from being filed in a foreign patent office or from the maintenance of confidentiality under paragraph (1).

④ The Government shall pay reasonable compensation in the event that a patent is not granted, or the right to obtain a patent is expropriated under paragraph (2).

⑤ If there has been a violation of an order to prohibit an application from being filed for an invention in a foreign patent office concerned or of an order to maintain confidentiality under paragraph (1), the right to obtain a patent therefor shall be deemed to be abandoned.

⑥ If there has been a violation of an order to maintain confidentiality under paragraph (1), the right request the payment of compensation for the loss arising from maintaining confidentiality shall be deemed to be abandoned.

⑦ Matters relating to the procedure, etc. for prohibiting an application from being filed in a foreign country, proceedings for maintaining confidentiality under paragraph (1), or for expropriation or payment of compensation under paragraphs (2) through (4) shall be prescribed by Presidential Decree

Article 12 of the Enforcement Decree of the Patent Act (Procedure foe Confidential

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Treatment) ① If a patent application filed by a person having a domicile or business place in Korea is conformed to the criteria for classification as prescribed in Article 11, the Commissioner of the Korean Intellectual Property Office shall refer the Commissioner of the Defense Acquisition Program Administration to whether or not it is required to classify and treat such application as confidential one.

② Where the Commissioner of the Korean Intellectual Property Office has made a reference to the Commissioner of the Defense Acquisition Program Administration under paragraph (1), he shall notify it to the inventor, the applicant and the attorney of the patent application, and a person who is deemed to be learned of the invention (hereinafter referred to as the "inventor, etc.") and request them to maintain the confidence thereof.

③ The Commissioner of the Defense Acquisition Program Administration shall, upon receiving a reference under paragraph (1), make a reply within two months

④ The Commissioner of the Korean Intellectual Property Office shall, upon receiving a request to classify and treat any patent application as confidential one under paragraph (3), take any necessary measures in conformity with the confidential service rules, and order the inventor, etc. of the patent application to classify and treat it as confidential one, and if he is not requested so, he shall notify the inventor, etc. of the patent application of a cancellation of the request for maintenance of confidence as referred to in paragraph (2).

⑤ The Commissioner of the Korean Intellectual Property Office shall, upon receiving a reply of the Commissioner of the Defense Acquisition Program Administration under paragraph (3), issue without delay an order to classify and treat the patent application as confidential one, or notify a cancellation of the request for maintenance of confidence under paragraph (4).

Article 13 of the Enforcement Rules of the Patent Act (Cancellation, etc. of Confidential Treatment) ① With respect to a patent application which is ordered to be classified and treated as confidential one under Article 12(4), the Commissioner of the Korean Intellectual Property Office shall take necessary measures after consulting twice or more times each year with the Commissioner of the Defense Acquisition Program Administration on the cancellation of confidence, extension of confidential maintenances period or whether or not the confidential classification is modified.

② The inventor, etc. who is ordered to classify and treat the patent application as confidential one under Article 12(4), may request the Commissioner of the Korean

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Intellectual Property Office to release it from confidential treatment, to modify the confidential classification or to publish or license the invention for which a patent is applied, in a specified limit.

2. Purport

National defense can be harmed if there is no measure to restrict a certain person from wielding monopoly over an invention necessary for national defense in pursuit of personal benefit or where an invention which was supposed to be classified as confidential one for national defense is published to the general public without any restrictions. Therefore, Article 41 of the Patent Act governs the treatment of inventions necessary for national defense to address such cases.

Article 41 of the Patent Act states that a patent application for an invention necessary for national defense is banned from being filed in foreign patent office; such invention be ordered to maintain confidentiality; the government does not grant a patent right; or the government may expropriate the right to obtain a patent right. Article 41 of the Patent Act is about the government restricting an invention for which a patent application was filed, whereas, in Article 106 of the Patent Act, an invention for which a patent application was filed puts a restriction on the registered patent right.

Meanwhile, Article 23 of the Constitution of the Republic of Korea stipulates that the right of property of all citizens shall be guaranteed and expropriation, use or restriction of private property from public necessity and compensation therefor shall be compensated. The Patent Act, too, dictates that any loss generated from the ban on filing a patent application in foreign paten offices shall be fairly compensated.

3. Overview of National Defense-related Application

3.1 Classification Criteria of National Defense-related Application

The criteria for classification of a national defense-related application are determined by the Commissioner of the Korean Intellectual Property Office after consulting with the

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Commissioner of the Defense Acquisition Program Administration under Article 11 of the Enforcement Decree of the Patent Act. This is stipulated in Directive No. 651 of the Korean Intellectual Property Office <Classification Criteria of Patent Application Related to National Defense>.

According to the directive, applications related to national defense are divided into two types. One is where an applicant files an application with the indication of the national defense-related application and where the Defense Acquisition Program Administration recognizes the application to be classified as a national defense-related application. In such a case, an applicant submits a written opinion with the indication of the national defense-related application and the Korean Intellectual Property Office keeps the application secret for security reasons and transfer the application to the examination division after asking the Defense Acquisition Program Administration to check whether it needs to be classified as the national defense-related application. Detailed information shall be referred to Article 14 of the Handling Rules of Application-related Work.

The other type of applications related to national defense is one that is classified in the international application under Annexed Table No. 651 of the Directive of the Korean Intellectual Property Office Also, an examiner shall classifies the application as a national defense-related application and the Defense Acquisition Program Administration, too, recognizes the necessity to treat the application as a national defense-related application. International patent classifications related to national defense include seven machinery classifications such as submarine, missile, armored vehicle and four chemistry classifications including explosive and detonator.

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Classification Standard of National Defense-related Patent Application [Annexed Form] under KIPO Directive No.651 **International Patent Classification of National Defense-related Application**
B63G 1/00, 3/00-3/06, 5/00, 6/00, 7/00-7/08, 8/00-8/42, 9/00-9/06, 11/00, 13/00-13/02 (Submarines)
C06B 21/00, 23/00-23/04, 25/00-25/40, 27/00, 29/00-29/22, 31/00-31/56, 33/00-33/14, 35/00, 37/00-37/02, 39/00-39/06, 41/00-41/10, 43/00, 45/00-45/36, 47/00-47/14, 49/00 (Explosive)
C06C 5/00-5/08, 7/00-7/02, 9/00, 15/00 (Detonating Device)
C06D 3/00, 5/00-5/10, 7/00 (Generation of pressure gas)
F41A 1/00-1/10, 3/00-3/94, 5/00-5/36, 7/00-7/10, 9/00-9/87, 11/00-11/06, 13/00-13/12, 15/00-15/22, 17/00-17/82, 19/00-19/70, 21/00-21/48, 23/00-23/60, 25/00-25/26, 27/00-27/30, 29/00-29/04, 31/00-31/02, 33/00-33/06, 35/00-35/06 (Weapons)
F41C 3/00, 3/14, 3/16, 7/00-7/11, 9/00-9/08, 23/00-23/14, 27/00, 27/06 (Weapons)
F41F 1/00-1/10, 3/00-3/10, 5/00-5/04, 7/00 (Rocket)
F41G 1/00-1/54, 3/00-3/32, 5/00-5/26, 7/00-7/36, 9/00-9/02, 11/00 (Weapon sights)
F41H 3/00-3/02, 5/00-5/20, 7/00-7/10, 9/00, 9/02, 9/10, 11/00-11/16 (Armour)
F42B 1/00-1/04, 3/00-3/28, 4/00-4/30, 5/00-5/38, 6/00-6/10, 7/00-7/12, 8/00-8/28, 10/00-10/66, 12/00-12/82, 14/00-14/08, 15/00-15/38, 17/00, 19/00-19/46, 21/00, 22/00-22/44, 23/00-23/32, 25/00, 27/00, 29/00, 30/00-30/14, 33/00-33/14, 35/00-35/02, 39/00-39/30(Explosive charges)
F42C 1/00-1/14, 3/00, 5/00-5/02, 7/00-7/12, 9/00-9/18,

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11/00-11/06, 13/00-13/08, 14/00-14/08, 15/00-15/44, 17/00-17/04, 19/00-19/14, 21/00 (Ammunition fuzes)

3.2 Application Eligible for Classification of National Defense-related Application

A patent application filed under the Patent Act as well as a utility model application which relevant provisions under the Patent Act apply mutatis mutandis are entitled to be classified as a national defense-related application. The ground for such application is that Article 11 of the Utility Model Act and Article 9 of the Enforcement Decree of the Utility Model Act apply mutatis mutandis to Article 41 of the Patent Act and Article 11 of the Enforcement Decree of the Patent Act respectively.

Meanwhile, as for an international application, a member state can take measures for national security according to Article 27(8) of the Patent Cooperation Treaty. Therefore, Article 78-2 of the Security Operational Rule of the Korean Intellectual Property Office stipulates that where an international application under the Patent Cooperation Treaty falls under "Classification Standard of National Defense-related Patent Application" of Article 11 of the Enforcement Decree of the Patent Act, the Transmittal of a record copy and a search copy under Article 12 of the Patent Cooperation Treaty to the International Bureau and the competent International Searching Authority shall be withheld and the documents shall be transferred the competent examination division.

4. Procedure for Handling National Defense-related Application

In principle, an application shall take any procedure regarding a national defense-related application in writing. However, where an applicant is unaware that his/her application is crucial to national defense, the applicant can file an application online. In such a case, an examiner can classify and specially manage the application as a national defense-related application. Most of the national defense-related applications are submitted in writing by an applicant such as the Institute for Defense Development, with indication of a national defense-related application.

4.1 Handling in Presence of Applicant's Indication of National Defense-related

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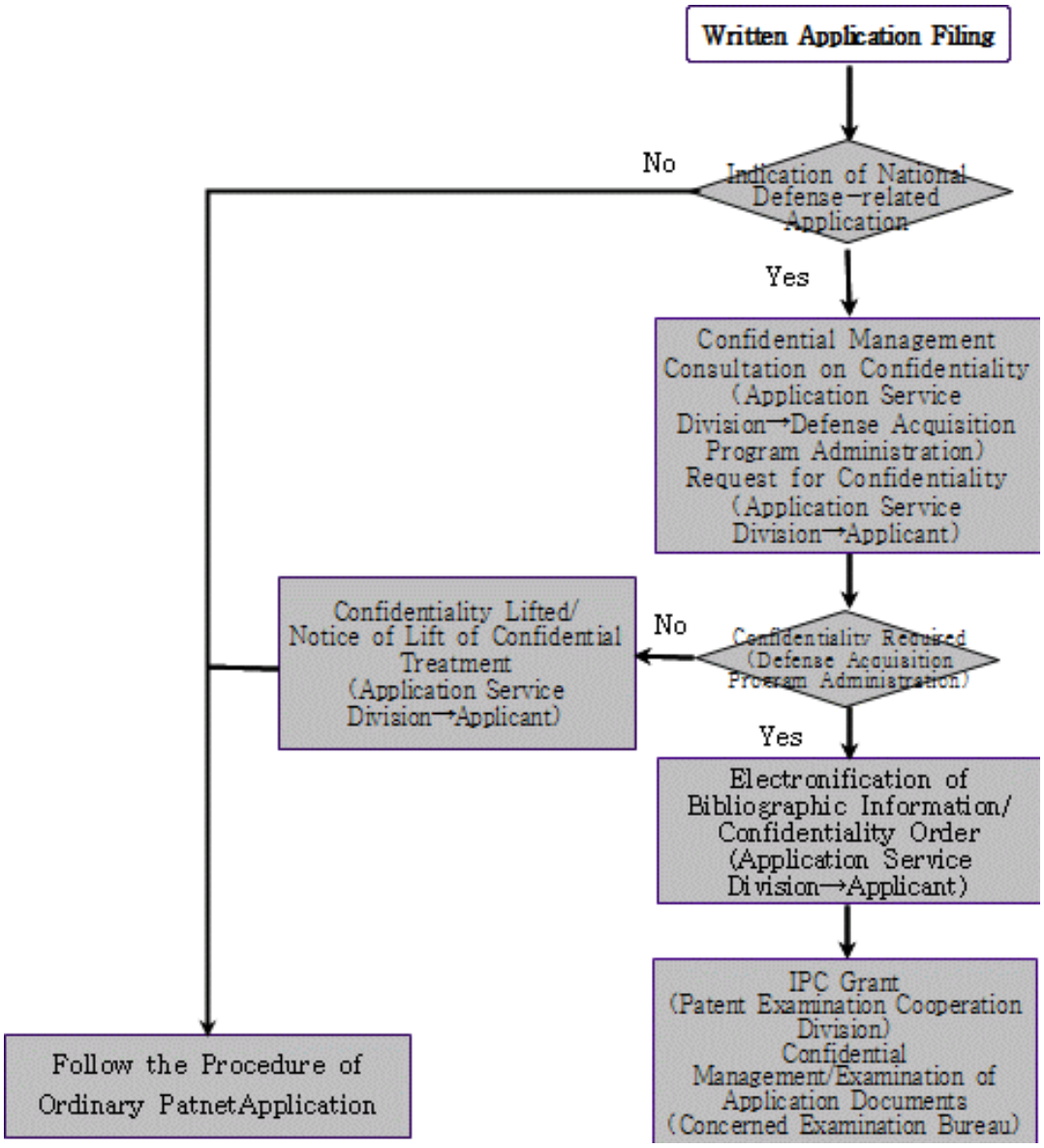
Application



(1) Where an applicant files a national defense-related application in writing

① The division which received the application documents shall keep the application secret for security reasons and transmits a copy of the application to the Commissioner of the Defense Acquisition Program Administration to find out whether the application needs to be kept confidential. Also, the division shall ask the inventor, applicant or legal representative of

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the patent application to keep the application secret.

② Where the application is asked to be kept confidential after consultation with the Defense Acquisition Program Administration, the division which received the application documents shall take security measures such as confidentiality order for an applicant, etc. according to security operational rules and enter only bibliographic data electronically and transfer the application to the Patent Examination Cooperation Division for classification. Then, it shall transmit the application to the examiner in charge.

③ Where the application does not need to be kept confidential after consultation with the Defense Acquisition Program Administration, the division which received the application documents shall lift confidentiality order from the application and initiate the procedure for handling the application in writing and then notify the inventor, application or legal representative of the patent application of the lifting of the confidentiality order from the application.

(2) Where an applicant notifies that the application is related to national defense before the application documents are transferred to the examination division

① Where an applicant (electronically) filed an application without indicating that it is related to national defense at the time of filing, but notified that the application is linked to national defense before the application documents are transferred to the examination division, the director of the Application Service Division shall ask the director of the Information Management Division to print out the electronically-filed documents.

② The director of the Information Management Division shall print out the application documents confidentially (the original and the copy and one copy of the floppy disc) and transfer them to the Application Service Division while deleting the concerned electronic documents on the PatentNet.

③ In such a case, the standard for handling a national defense-related application filed with such indication by an applicant at the time of filing shall apply to consultation, etc. with the Defense Acquisition Program Administration.

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4.2 Where an examiner classifies an application as national defense-related one

(1) Review on the granting of IPC and the necessity of confidentiality order

① When assigning an IPC code for an application under the International Patent Classification scheme, where the section or class of the application is used as the IPC code determined in the annexed form on the classification standard of a national defense related-patent application, the examiner shall determine whether to treat the application as a national defense-related one. Normally, when the Korea Institute of Patent Information assigns an application with an IPC code and the application is entitled to be classified in the IPC code for national defense, this is notified to the examiner in charge.

Where an application falls under the IPC code for national defense, in principle, the application needs to be treated as a national defense-related application. However, if there exist grounds for exception under the paragraphs of Article 651(2) of the Directive of the Korean Intellectual Property Office, the application may not be treated as a national defense-related application.

Therefore, where an applicant does not have an address or a business in the Republic of Korea; where the application does not fall under major defense materials specified under Article 35(2) of the Defense Acquisition Program Act according to Article 34(3) of the same act and Article 39 of the Enforcement Decree of the Defense Acquisition Program Act or any of the weapons systems specified under the paragraphs of Article 2 of the Enforcement Decree of the Defense Acquisition Program Act;, or where an examiner recognizes that the application can kept confidential for national defense, the application can be treated as an ordinary patent application.

Where an examiner recognizes that the application cannot be kept secret for national defense includes where a prior art identical or similar to the object matter in the application has been already disclosed; where the claimed invention is not related to national security and military secrets; or where an application supposed to be classified to be national defense-related was incorrectly classified at first, but was laid open to the public before the

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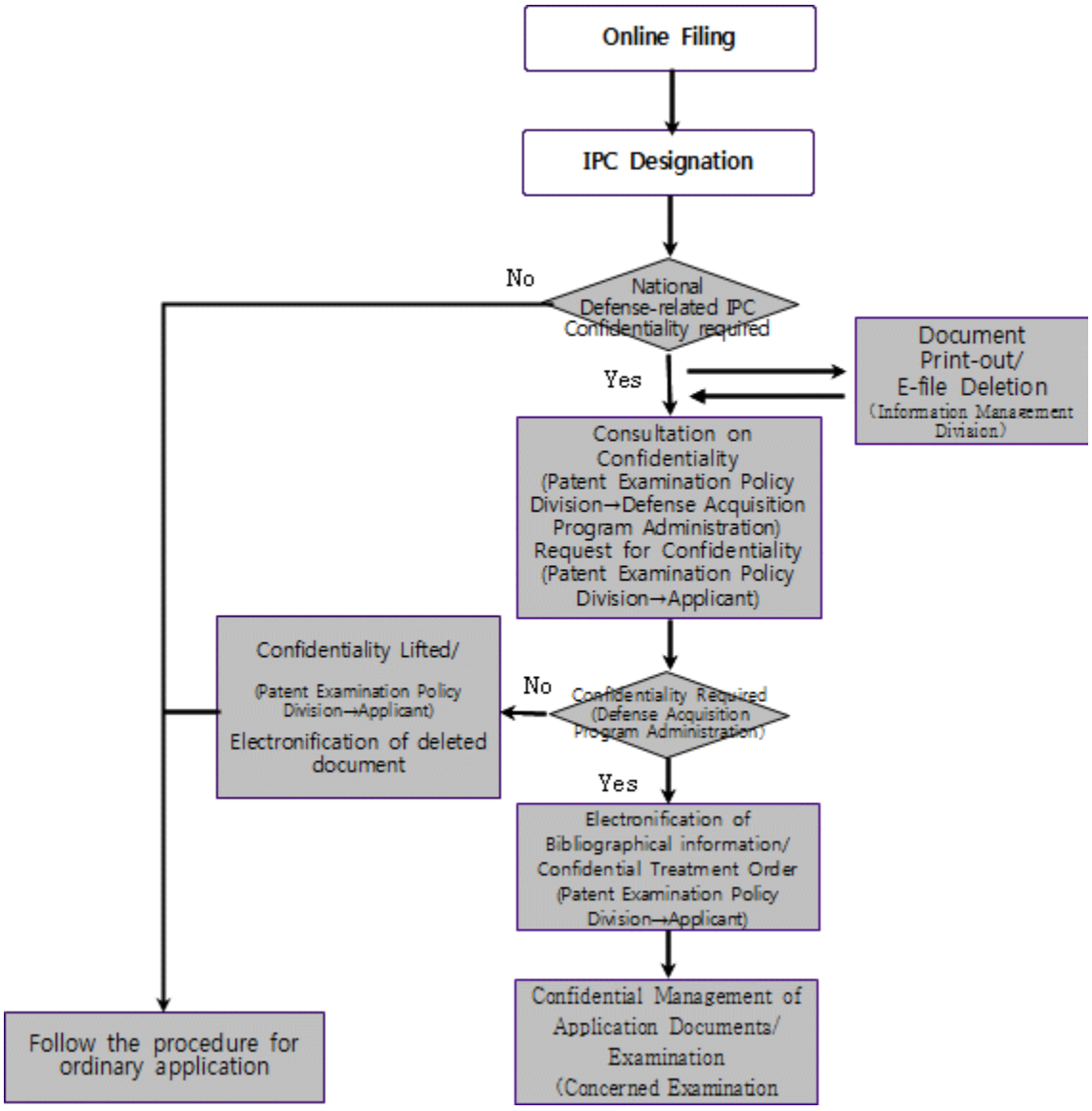
change of the classification. Where it is hard to determine whether to handle the application as a national defense-related one, an examiner may consult with the Director of the Emergency Affairs Subsection from the General Services Division, an applicant or a military expert.



Meanwhile, where an examiner found out in the process of examination of the classified application according to the examination order that the application needs to be classified as a national defense-related application and does not have any ground for exemption from national defense-related classification, the examiner shall change the IPC code of the

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application to the national defense code and proceed the confidentiality procedure for national defense.

② Where the application needs to be kept confidential based on the result of consultation, an examiner shall immediately report this to the director of the Patent Examination Policy Division with the Annexed Form 31 of Article 79 of the Administrative Instructions of the Security Operational Rule of the Korean Intellectual Property Office.

③ Where there has been a report made by an examiner, the director of the Patent Examination Policy Division shall determine whether the application meets the requirements to be classified as a national defense-related application.

(2) Consultation on Confidentiality

Where an application reported by an examiner is recognized to be legitimated for the qualification for national defense-related application, the director of the Patent Examination Policy Division shall take the following measures:

① The director of the Patent Examination Policy Division shall request the director of the Information Management Division to print out the concerned application and delete the electronic file of the application. After receiving the request, the director of the Information Management Division shall confidentially make the original and the copy and one copy of the floppy disc of the electronically-filed application and transfer the documents to the Patent Examination Policy Division and then delete the electronic file, except for the bibliographic items and application history of the patent application.

② The director of the Patent Examination Policy Division shall confidentially handle the original and the copy of the application transferred from the Information Management Division and transfer the copy to the Defense Acquisition Program Administration to confirm whether the application needs to be kept confidential. Also, the director of the Patent Examination Policy Division shall request an inventor, applicant or legal representative of the patent application or a person deemed to have knowledge of the invention to observe confidentiality under Article 12(2) of the Enforcement Decree of the Patent Act.

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③ When asked for confidentiality of the application based on the result of the consultation with the Defense Acquisition Program Administration, an examiner shall keep the application secret under Article 80 of the Administrative Instructions of the Security Operational Rule of the Korean Intellectual Property Office and transfer the application to the concerned examination bureau, so that an examiner in charge of examination on applications in the concerned IPC code can initiate examination on the application. A confidentiality order shall be made to a person who is requested to observe confidentiality as in ② under Article 12(4) of the Enforcement Decree of the Patent Act.

Meanwhile, where an application does not need to be kept secret, the director of the Patent Examination Policy Division shall lift the confidentiality order and ask the director of the Information Management Division to shift the application back to the electronically-file so that the application is examined as an ordinary application. A confidentiality order shall be lifted from a person who is requested to observe confidentiality as in ② under Article 12(4) of the Enforcement Decree of the Patent Act.

5. Examination on National Defense-related Application Transferred to Examination Bureau

Where an application is confirmed to be kept secret after consultation with the Defense Acquisition Program Administration as mentioned in 4.1 or 4.2, the examination bureau which has received the transferred application documents shall keep the documents confidential according to Article 80(3) of the Administrative Instructions of the Security Operational Rule of the Korean Intellectual Property Office.

The procedure for examining a confidential application is the same as the examination procedure of an ordinary application. Therefore, an examiner in charge of the concerned IPC code shall examine patentability of the application as an ordinary application is examined when time for examination of the confidential application is up. However, considering the application is confidential, an examiner shall be extra cautious of maintaining confidentiality in examining the application by borrowing the confidential application documents from the examination bureau.

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After an examiner determines patentability after examination, the examination bureau shall send the final documents of the confidential application including an amendment, a written opinion to the Patent Examination Policy Division if the examiner decides to grant a patent. When determined to reject a patent, the final documents shall be sent to the Information Management Division.

6. Management of Application Documents Deemed Confidential

A person in charge of the division managing confidential documents or examiners shall carefully maintain confidentiality of confidential documents in the following manners:

① The director of the Patent Examination Policy Division shall consult with the Commissioner of the Defense Acquisition Program Administration more than twice a year on measures such as the lifting of confidentiality from the previously-confidential application, extension of the period for confidentiality protection or change of confidentiality level.

② Where an examiner determines to grant (register) a patent on a confidential application, the examiner shall notify the grant/registration of a patent right to the director of the Registration Service Division and the director of the Information Management Division in writing.

③ An application classified as confidential shall be withheld from the laying-open or the publication of registration until the confidentiality order is lifted. When the confidentiality order has been cancelled, the application shall be laid open or published for registration without any delay.

④ Where an examiner determines after examining a confidential application that the technical contents of the application do not need to be kept secret, whether to lift confidentiality status can be consulted with the Defense acquisition Program Administration.

⑤ A notification on a confidential application shall be made in secret and approval and transmittal, etc. of the application shall be conducted in writing.

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⑥ Registration documents of a confidential application shall be kept by the Patent Examination Policy Division until the confidentiality order is lifted. Once the confidentiality order is cancelled, the application shall be treated as an ordinary application. The director of the Informational Management Division shall assign the management number to the application on which the decision to reject a patent is made and handle the application under the same provisions as those for any other confidential documents.

⑦ Amendments and written opinions of a confidential application shall not be assigned with the management number. The documents shall be filed all together in the original and the copy.

⑧ The copy of a confidential document shall be kept with the assigned management number apart from the original of the application.

⑨ The division in charge of handling a confidential application shall observe the following rules (Article 81 of the Administrative Instructions of the Security Operational Rule). The other details shall be referred to Article 6 'Confidential Storage and Management' of the Administrative Instructions of the Security Operational Rule of the Korean Intellectual Property Office.

1. Confidential applications cannot be stored together with ordinary patent applications. Confidential documents shall be kept in a double-layered steel container and the director of the Patent Examination Policy Division shall be primarily responsible for managing such confidential applications.
2. Confidential applications shall be kept at the confidentiality register and the management numbers shall be written in the margin of the patent register for a better identification of the applications.
3. Confidential files of patent registrations and patent rejections can be lent, but only by writing on the confidential check-out list and an authorized person cannot be allowed for the check-out of the files.

7. Prohibition and Permission of Application Filing Overseas

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7.1 Applications Banned From Filing Overseas

Under Article 41 of the Patent Act, an invention crucial for national defense can be banned from filing overseas and can be filed for patent protection overseas only when permission from the government is granted. When an invention vital for national defense has been filed in foreign countries, it shall be deemed that the applicant has abandoned the right to get a patent right for the invention. Also, the application shall pay reasonable compensation for any loss due to the violation of the ban on filing a patent application for the invention.

Applications banned from filing overseas are those classified by an examiner from KIPO as confidential or indicated by an applicant as a national defense-related application. Applications deemed necessary to be kept confidential based on the result of the consultation with the Defense Acquisition Program Administration shall be object to the ban on filing a patent application overseas.

7.2 Permission on Application Filing Overseas

Where the Korean government granted permission to file a patent application banned from filing overseas, an application may exceptionally file a patent application in foreign countries. Currently, the Republic of Korea has signed the agreement of confidentiality on national defense-related inventions with the United States of America to observe confidentiality and allow the filing of applications related to national defense between the two parties. Such applications cannot be filed in any other countries, except for the Republic of Korean and the United States of America.

In order to get permission of filing a patent application in the United Stated of America, an applicant shall submit a written request for permission of overseas application filing (Annexed Form No.21) under the Enforcement Rules of the Patent Act.

Once the Korean Intellectual Property Office accepts the request for permission of overseas application filing, where it is allowed to grant permission after consultation with the Defense Acquisition Program Administration under Article 16 of the Enforcement Decree of the Patent Act, the Office can issue a written permission to file a patent application in the United States of America in the following conditions:

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1. The content of the invention in the specification shall be clear and specific to examine the concerned application for national defense in the United States of America.
2. The right to claim damages caused by confidentiality of the invention in the United Stated of America shall be waived (except for damages incurred because the United Stated of America has used or disclosed the invention without permission of the application).

Meanwhile, an application who filed a patent application in the United States of America after receiving permission to file an application shall attach two copies of application documents, a copy of a permission to file a patent application in the United States of America issued by the Commissioner of the Korean Intellectual Property Office, a copy of the document indicating personal information of the legal representative and security clearance to the US application document and submit the documents to the Commissioner of the Defense Acquisition Program Administration. Also, a person intending to file a patent application in the United States of America shall designate a legal representative who has received a security clearance from the Government of the United States of America and initiate a patent-related procedure through the legal representative. Then, the applicant shall immediately notify the application number and the application date in the United States of America to the Commissioner of the Defense Acquisition Program Administration.

The detailed information relating to permission to file a patent application in the United States of America shall be referred to 'the Administrative Instructions of the Agreement of Confidentiality on National Defense-related Patented Inventions with the United States of America and the implementation procedure of the agreement'.

7.3 Handling of US-filed National Defense-related Application in Republic of Korea

An application kept confidential as a national defense-related application in the United States of America can be filed in the Republic of Korea. In such a case, an applicant shall file the application in writing and submit the application attached with two copies of the application three copies of the specification, abstract and drawing(s) each (one of the three copies of the specification does not need to contain the detailed description of the invention), a copy of a permission for application filing in the Republic of Korea issued from the United States of America and relevant security-related documents.

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Where the Korean Intellectual Property Office accepts the concerned application, the Office shall keep the application confidential and the detailed contents shall be referred to the above-mentioned Administrative Instructions.

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Chapter 4. Accelerated Examination

1. Relevant Provisions

Article 61 of the Patent Act (Accelerated Examination) The Commissioner of the Korean Intellectual Property Office may direct an examiner to examine one application in preference over another if the former falls under any of the following subparagraphs:

1. Where a person, other than the applicant, is commercially and industrially working the invention claimed in a patent application after the laying-open of the application;
2. Where the Commissioner of the Korean Intellectual Property Office deems it necessary to urgently process a patent application prescribed by Presidential Decree.

Article 9 of the Enforcement Decree of the Patent Act (Object of Prior Examination) The term "patent application prescribed by Presidential Decree" in subparagraph 2 of Article 61 of the Act means a patent application falling under any of the following subparagraphs, which is designated by the Commissioner of the Korean Intellectual Property Office.

1. A patent application in the area of the defense industry;
2. A patent application directly related to green technology (referring to such technology that minimizes emissions of greenhouse gases and pollutants by saving energy and resources and making use of them efficiently through the whole process of social and economic activities, such as technology related to reducing greenhouse gases, raising the efficiency of energy utilization, pollution-free production, clean energy, recycling resources, and eco-friendliness(including related convergence technology) or such);
3. A patent application which is directly related to the promotion of exports;
4. A patent application concerning the official duties of the State or local governments (including any patent application concerning the duties of the national and public schools provided for in the Higher Education Act, which is filed by the organization in charge of the technology transfer and industrialization established within the national and public schools pursuant to Article 11(1) of the Technology Transfer Commercialization Promotion Act);
5. A patent application filed by an enterprise confirmed as a venture business under Article 25 of the Act on Special Measures on the Promotion of Venture Business;
5-2. A patent application filed by an enterprise selected as a technology-innovative small

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and medium enterprise under Article 15 of the Technical Renovation of Small and Medium Enterprises Act;

5-3. A patent application of a company designated as companies with outstanding employee invention compensation system under Article 11(2) of the Invention Promotion Act

6. A patent application concerning the results of the State's project for supporting the development of new technology or quality certification;

6-2. An application of utility model registration of a company designated as companies with outstanding employee invention compensation system under Article 11(2) of the Invention Promotion Act

7. A patent application which is based on a priority right claim under treaties (limited to cases where a foreign patent office, upon receiving such priority right claim based on the relevant patent application, is in the process of taking procedures for such patent);

8. A patent-applied invention for which the applicant is in process of commercializing or is preparing to do so;

9. A patent application which is directly related to the electronic transactions;

10. A patent application on which the Commissioner of the Korean Intellectual Property Office has agreed with the commissioner of any foreign intellectual property office to preferentially examine it; and

11. A patent application for which a person intends to file an application for prior examination retained a specialized institution under Article 58 (1) of the Act to search prior arts with respect to the invention for which the patent application is pending, and requested the specialized institution to notify the results of the search to the Commissioner of the Korean Intellectual Property Office.

Article 5 of the Enforcement Decree of the Utility Model Act (Applications Eligible for Preferential Examination) The term "patent applications specified by Presidential Decree" in subparagraph 2 of Article 61 of the Patent Act as applied mutatis mutandis in Article 15 of the Act means the applications for utility model falling under any of the following subparagraphs and prescribed by the Commissioner of the Korean Intellectual Property Office:

1. Utility model application for defense industry;

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2. Utility model application useful for the prevention of pollution;
3. Utility model application directly related to the promotion of export;
4. Utility model application related to the function of the State or local governments (including the utility model application filed by an organization established within a national or public school and exclusively dedicated to the technology transfer and the promotion of commercialization thereof under Article 11(1) of the Act on the Technology Transfer and Commercialization Promotion Act among the utility model applications related to the functions of national and public schools as defined in the Higher Education Act);
5. Utility model application filed by an enterprise acknowledged as a venture business under Article 25 of the Act on Special Measures for the Promotion of Venture Businesses;
6. Utility model application filed by an enterprise selected as one of technology-innovative small and medium enterprises under Article 15 of the Act on Promotion of Technical Renovation of Small and Medium Enterprises;
7. Utility model application related to a product from the State's project for the development of new technology or quality certification;
8. Utility model application that serves as a ground for the priority right under a treaty (limited to the process for a patent application or utility model application filed and pending with a foreign patent office based on the claim of priority right);
9. Utility model application under which the applicant of the utility model application is currently working, or is at the stage of preparation for working, the device for which the application for utility model was filed;
10. Utility model application directly related to electronic transactions;
11. Utility model application filed simultaneously with a request for examination and for which a request for preferential examination is filed within two months thereafter;
12. Utility model application for which a person who intend to file an application for preferential examination retained a specialized institution under Article 58 (1) of the Patent Act, which shall apply mutatis mutandis pursuant to Article 15 of the Act, to conduct a survey on prior technology with respect to the utility model for which the utility model application is pending, and requested the specialized institution to notify the results of the survey to the Commissioner of the Korean Intellectual Property Office.
Article 36 (8) of the Act on Special Cases concerning the Regulations of the Special Economic Zones for Specialized Regional Development (Special cases concerning 「the Patent Act」) Notwithstanding Article 61 of the Patent Act, the Commissioner of the Korean

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Intellectual Property Office may order an examiner to examine one application directly related to the specialized business in preference over another.

Article 26 of the Special Act on the Designation and Support of High-Tech Medical Complex (Special cases concerning 「the Patent Act」) Notwithstanding Article 61 of the Patent Act, the Commissioner of the Korean Intellectual Property Office may direct an examiner to examine one application related to medical R&D within the high-tech medical complex submitted by a tenant medical R&D institute in preference over another.

2. Overview of Preferential Examination

Normally, a patent application is taken up for examination in the order of filing the request for examination thereof.

However, if an application that a person, not an applicant, is deemed to have been working the patented invention after the laying-open of the invention or is deemed necessary to be urgently examined for industrial development or the public interest is to be examined in the order of filing the request for examination thereof, the national interest or the protection of the invention would be compromised.

Therefore, the Preferential Examination System under the Korean Patent Act allows applications which fulfill certain requirements to be examined regardless of the order of filing the request for examination under Article 38 of the Enforcement Rules of the Patent Act.

The scope of applications eligible for the preferential examination system has been expanding since its introduction in 1981. Until June 30, 1999, applications entitled to preferential examination only included ① patent applications in the defense industry, ② patent applications useful for air pollution prevention, ③ patent applications directly related to promoting trade, and ④ patent applications related to duties of the central or local governments. Then, starting July 1, 1999, ⑤ patent applications of companies which are confirmed as to whether it may be categorized as a venture business or not under Article 25 of the Act on Special Measures For the Promotion of Venture Businesses, ⑥ patent

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application regarding the outcomes of national projects of new technology development support or quality assurance, ⑦ patent application forming priority claims under the Treaty (only limited to patent applications whose patent-related procedures for the priority claim are filed before foreign patent offices) and ⑧ patent applications which are worked or are to be worked by a patent applicant were added to the scope of applications under the preferential examination system., ⑨ patent applications directly related to electronic commerce and ⑩ patent application of companies designated as technology innovative SMEs under Article 15 of the Act on the Promotion of Technology Innovation of Small and Medium Enterprises have been each included from July 1 of 2001 and February 11 2005, respectively. Since July 1 of 2005, ⑪ patent applications regarding the duties of national and public schools, filed by technology transfer & commercialization offices within the national and public schools, have become one of the applications related to the duties of the central or local governments. Starting October 1 of 2006, the preferential examination system has been applied to applications for of utility model registration (applications for utility model registration included to the applications worked by the third party and the above ①-⑪ applications) and ⑫ patent applications that the Commissioner of the Korean Intellectual Property Office agreed for preferential examination with the commissioner of any foreign intellectual property offices and ⑬ applications for utility model registration of which the request for examination is made at the same time of filing the application and the request for preferential examination is filed within two months from the application filing have been included. Also, the scope of applications eligible for preferential examination has been expanded to contain patent application directly related to regulation special cases of specialized district business under Article 36(8) of the Act on Special Cases concerning the Regulation of the Special Economic Zones for Specialized Regional Development since April 1 of 2007. Also, since the Special Act on the Designation and Support of High-Tech Medical Complex took effect on June 29 of 2008, patent applications related to medical R&D within the High-Tech Medical Complex filed by a tenant medical R&D institute under Article 26 of the same act has become entitled to preferential examination.

Moreover, where a person intending to request preferential examination has requested a specialized institution under Article 58(1) of the Patent Act to search prior arts of the claimed invention, patent applications whose search results are required to be notified to the Commissioner of the Korean Intellectual Property Office by the concerned specialized

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institution have been also included in the scope of application for preferential examination since October 1 of 2008. In an attempt to support Low-Carbon, Green Growth pursued at the pan-governmental level, patent applications directly related to green technology (replacing patent applications useful for preventing air pollution) have become entitled to preferential examination since October 1, 2009. Especially, where the search results of patent applications directly related to green technology made by a special institution are notified to the Commissioner of the Korean Intellectual Property Office, such patent applications can be eligible for super-accelerated examination. Meanwhile, considering the enactment of the Framework Act on Low Carbon Green Growth on April 14 of 2010, patent applications directly related to green technology financially-supported and certified based the Framework Act on Low Carbon Green Growth or other national policies can become entitled to preferential examination. **From September 23, 2013, a patent application of a company designated as companies with outstanding employee invention compensation system under Article 11(2) of the Invention Promotion Act to facilitate the compensation for inventions created by employees.**

3. Objects Eligible for Preferential Examination

3.1 General Criteria to be Eligible for Preferential Examination

3.1.1 Person who can request Preferential Examination

(1) Anyone, including an applicant, can make a request for preferential examination. However, only the central or local governments (including technology transfer & commercialization offices of the national and public schools) can request preferential examination as for a patent application concerning the duties of the central or local governments.

(2) Where a minor or an incompetent makes a request for preferential examination, his/her legal representative shall initiate the procedure for preferential examination on behalf. A corporation, not an association, can request preferential examination under the name of its representatives.

(3) Where an application filed by a foreigner is entitled to preferential examination, the request for preferential examination on the concerned application shall be recognized and

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the procedure for preferential examination shall be initiated. Whether to examine a foreigner-filed application under the preferential examination system shall be determined based on the same criteria as those of application filed by a Korean.

For example, where an invention for which a patent application was filed by a foreigner is disclosed and a third party is working the invention, the request for preferential examination for the invention shall be accepted on the ground of "the working of the invention by a third party". Also, the request for preferential examination based on "the working of the invention by the applicant him/herself" can be recognized if an applicant, a licensee or a person authorized to work the invention by the licensee has worked the invention or is preparing to work the invention. However, where an applicant is a foreigner, the working of the invention of the foreigner means the working within the Republic of Korea. Therefore, the request for preferential examination based on the working of the invention outside the Republic of Korea shall not be accepted.

3.1.2 Applications eligible for Preferential Examination

(1) Patent applications or applications for utility model registration filed after October 1 of 2006 are eligible for preferential examination. Under Article 2(1) of the Directive concerning the request for preferential examination on patent applications or applications for utility model registration (hereinafter referred to as 'Directive'), patent applications as well as applications for utility model registration filed before June 30 of 1999 or after October 1 of 2006 are defined as applications and they are deemed to be applications eligible for preferential examination.

The preferential examination system was introduced in the amendment carried out on October 1 of 2006 of transition from the quick registration system of utility model to post-examination registration system. Therefore, only applications for utility model registration filed after October 1 of 2006 can be eligible for preferential examination.

Meanwhile, in the case of filing a dual application (a converted application after October 1 of 2006) which means a patent application is filed based on an application for utility model registration filed before October 1 of 2006, the concerned patent application can be entitled to preferential examination.

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(2) Since preferential examination can be conducted on applications for which the request for examination has been already made, a requester of preferential examination shall make a request for examination before or at the same time with filing for preferential examination.

3.1.3 Point of Time for Standard of Determining Eligibility for Preferential Examination

Where an application requested for preferential examination is eligible for preferential examination either at the time of request for preferential examination or at the time of determining whether to be accepted for preferential examination, the application shall be recognized to be eligible for preferential examination. Meanwhile, like an application filed by an enterprise confirmed as a venture business, where an applicant is required to meet the qualification of a venture company, the applicant shall be confirmed as a venture company between the date of request for preferential examination and the date of determining whether to be accepted for preferential examination.

For example, ① where an applicant was not a venture company at the time of filing an application or time of requesting for preferential examination, but it has become a venture company at the time when preferential examination is determined, or where an applicant was a venture company at the time of filing an application or time of request for preferential examination but its existing period has expired at the time of determining whether the application is eligible for preferential examination, such applications shall be recognized to be eligible for preferential examination if the business type of the venture company and the claimed invention are associated.

② Even though a patent application of an enterprise designated as a technology-innovative SME which was added to the object for preferential examination under Enforcement Decree of the Patent Act taken effect on February 11 of 2005 was filed before February 10 of 2005, the application shall be eligible for preferential examination if the request for preferential examination on the application was made after February 11 of 2005.

③ Even though a patent application added to the object of preferential examination under the Enforcement Decree of the Patent Act enacted on October 1 of 2006 and agreed for

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preferential examination between Commissioner of the Korean Intellectual Property Office and the commissioner of any foreign intellectual property office was filed before October 1 of 2006, the application shall be eligible for preferential examination if the request for preferential examination on the application was made after October 1 of 2006.

④ Where a third party was working the invention at the time of request for preferential examination, but the third party has stopped working the invention at the time of determining whether the invention is eligible for preferential examination or where the invention was not worked by a third party at the time of request for preferential examination but the third party started working the invention after making a request for preferential examination, such inventions shall be recognized to be eligible for preferential examination.

3.1.4 Claims Serving as Object for Determination of Eligibility for Preferential Examination

(1) In determining whether an invention is eligible for preferential examination, the invention eligible for preferential examination shall be disclosed in the claims. Therefore, if an invention eligible for preferential examination is disclosed only in the detailed description of the invention, but not in the claims, the invention is not recognized to be eligible for preferential examination. For example, where an invention entitled to working by the patentee is not disclosed in the claimed but only in the detailed description of the invention, the invention shall not become eligible for preferential examination.

(2) Whether an application is eligible for preferential examination shall be determined based on the claims amended before the time of determining the eligibility of preferential examination. Where multiple claims are present in the claims and one of the claims is recognized to be eligible for preferential examination, the application as a whole shall be accepted as the object for preferential examination.

For example, when determining based on the claims disclosed in the application at the time of requesting for preferential examination, where the application was initially eligible for preferential examination, but it was exempt from the objects for preferential examination at the time of determining eligibility for preferential examination due to amendments of the

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claims, the request for preferential examination on the application shall not be recognized. In the opposite cases, the request for preferential examination shall be accepted.

(3) When determining eligibility for preferential examination, only whether the claimed invention is eligible for preferential examination shall be assessed, rather than determining whether new claims are added or whether the application fulfills the requirement of unity of invention or inventive step.

3.1.5 Whether to Disclose Application at Request for Preferential Examination

Article 61 of the Patent Act and Article 9 of the Enforcement Decree of the Patent Act define the object for preferential examination. Except the case that an application is laid open due to the requirement for preferential examination, that is, the request for preferential examination because of the working of the invention by a person other than the applicant under Article 61(1) of the Patent Act, the laying open of other objects of preferential examination, such as the working of the invention by the applicant, is not the requirement of preferential examination.

However, a request for preferential examination filed because of the working of the invention by a person, other than the applicant, before the laying open of the application shall be withheld in determining eligibility for preferential examination without the dismissal of the request for preferential examination, where the date of laying open the concerned application is approaching even though the application is not disclosed under Article 64 of the Patent Act (an application expected to be laid open within 15 days from the date when a written request for preferential examination was transferred) or where an applicant made a request for early disclosure of the application. Except where it is confirmed that the application is not laid open early because the request for early disclosure of the invention is abandoned after withholding the determination of eligibility for preferential examination, etc., once the concerned application is laid open, the examiner shall proceed the preferential examination on the application.

3.1.6 Preferential Examination and Necessity of Urgent Proceeding

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(1) Object of Preferential Examination to be Determined for Necessity of Urgent Processing
Article 61 of the Patent Act and Article 15 of the Utility Model Act which Article 61 of the Patent Act applies mutatis mutandis indicate that the applications specified under Article 9 of the Enforcement Decree of the Patent Act and Article 5 of the Enforcement Decree of the Utility Model Act, other than the working of the invention by a person, other than the applicant, are limited to be eligible for urgent processing. Therefore, in principle, objects of preferential examination, except for the working of the invention by a person, other than the applicant, can be eligible for preferential examination only when it is deemed necessary to urgently process a patent application.

Meanwhile, considering the purpose of the preferential examination system under the Patent Act, a patent application included in the objects of preferential examination according to acts other than the Patent Act and the Utility Model Act (Article 36(8) of the Act on Special Cases concerning the Regulation of the Special Economic Zones for Specialized Regional Development and Article 26 of the Special Act on the Designation and Support of High-Tech Medical Complex) shall be eligible for preferential examination only when it is deemed necessary to urgently process the application.

(2) Ways of Determining Necessity of Urgent Processing
Whether to urgently process a patent application shall be determined by a person in charge of determining eligibility for preferential examination considering ① whether the concerned invention is crucial for national policies, ② whether the invention is vital for the protection of an applicant's interest or ③ whether the invention is certain to be granted with a patent right if it is urgently processed.

Since ① and ② are already considered when determining the objects for preferential examination under the Enforcement Decree of the Patent Act and the Enforcement Decree of the Utility Model Act, they need not be reconsidered when determining whether it is necessary to urgently process a patent application.

③ shall be considered when a requester of preferential examination searches prior arts on the claimed invention (utility model) and submits the search results on the patentability of the claimed invention to the Commissioner of the Korean Intellectual Property Office. Then,

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the examiner in charge recognizes that it is necessary to urgently process the application and utilizes search results for substantive examination.

Explanation on patentability in order to state why it is necessary to urgently process a patent application shall be determined based on whether the self-search results on prior art and the contrastive explanation are well-written in an explanation of request for preferential examination submitted at the time of request for preferential examination according to the way to write the search results and contrastive explanation.

Meanwhile, where a patent application is agreed for preferential examination between the Commissioner of the Korean Intellectual Property Office and the commissioner of any foreign intellectual property office (Article 9(10) of the Enforcement Decree of the Patent Act) and where a patent application is commissioned for prior art search to a specialized institute (Article 9(11) of the Enforcement Decree of the Patent Act and Article 9(12) of the Enforcement Decree of the Utility Model Act), it can be deemed that there exists explanation of patentability, Therefore, a requester of preferential examination can skip the description of the prior art search results and contrastive explanation in an explanation of request for preferential examination and the person in charge of determining eligibility for preferential examination shall recognize the necessity of urgent processing of the application.

(3) Process and Analysis of Description of Self-Search Results and Contrastive Explanation
In order for an application to be recognized necessary for urgent processing, a requester of preferential examination must describe the search process of prior arts and the contrastive explanation of one prior art closest to the search result and the subject matter in the claims in a written explanation of request for preferential examination.

In principle, more than four searched prior arts closest to the claimed invention for preferential examination shall be disclosed. However, where special conditions exist, such as, no relevant prior arts are found in the new technical field, less than three search results may be disclosed. Also, where the searched prior art is directly related to the technical field of the claimed invention or arts or all of components of the claimed invention, the description of the search result shall be recognized to be appropriate.

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In the contrastive explanation, the similarities, differences and contrastive analysis between each claim of the application for preferential examination and the closest prior art document to the concerned claim shall be described consecutively. The contrastive explanation of all independent claims shall be described and the contrastive explanation of dependent claims can be left out. Also, in the presence of an independent claim whose contrastive explanation is not disclosed, where the concerned independent claim involves the same components as those of an independent claim whose contrastive explanation is written, but both claims are in different categories, the independent claim whose contrastive explanation is not disclosed may be substantially deemed to be contrastively analyzed based on the independent whose contrastive explanation is written. Therefore, the independent claim whose contrastive explanation is not disclosed shall be deemed to be appropriately described.

(Note) Where there exist additional search results related to the claimed invention, such as search results made with support of local IP centers, the results may be submitted instead of search processes and search results. Even so, the contrastive explanation shall be disclosed in an application.

(4) Handling where self-search results and contrastive explanation are not submitted or inappropriately disclosed

Self-search results and contrastive explanation shall be disclosed to explain the necessity of urgent processing. However, where they are not submitted or inappropriately disclosed, an examiner shall order an applicant to supplement the application. If no response to the supplementation order is made from the applicant; self-search results and contrastive explanation are not submitted even after the response from the applicant is made; or it is recognized that self-search results and contrastive explanation are still inappropriately disclosed, an examiner shall reject the request for preferential examination.

Where self-search results are inappropriately disclosed refer to the case where any of the mandatory contents of disclosure of self-search results[① search processes of prior arts and search results (more than four results), ② contrastive explanation on independent claims] is not disclosed or inappropriately disclosed. However, that an examiner has additionally found prior arts to deny novelty and inventive step does not necessarily mean that the self-search

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was inappropriately conducted.

Self-search results and contrastive explanation would suffice if an examiner can easily comprehend the results and explanation. An applicant does not need to follow the disclosure requirements of a written explanation of request for preferential examination in Annexed Form no. 5 of **the Directive on Request for Preferential Examination of Patent and Utility Model**. Also, where a requester of preferential examination explained about special cases, such as relevant prior art of a new technical field cannot be found, and an examiner can recognize the case, self-search results and contrastive explanation can be recognized to be disclosed.

3.1.7 Reference on Processing Time

Where documents to which an examiner cannot send a notification in response, such as a report of change of applicant, a report of change of legal representative, a report of resignation of legal representative, are received, the processing time shall be calculated with the period from the receipt of the concerned documents and the acceptance of the documents excluded. For example, where a decision of preferential examination is made on February 1 and a report of change of applicant is submitted on March 20 and the application is accepted after amendment on April 20, the preferential examination shall be conducted by May 3. In other words, preferential examination shall be conducted within two months from the decision of preferential examination (only preferential examination under Article 4(1) or (2) of the Directive). However, since examination cannot be carried out during the period (for 32 days) in which a report of change of applicant is received, the processing period shall be calculated with such period in consideration.

3.2 Request for Preferential Examination

3.2.1 Overview of Request for Preferential Examination

Since a request for preferential examination is similar to a request for examination, where no detailed provision regarding request for preferential examination exists under the Patent Act or any decree under the Patent Act, provisions regarding request for examination shall apply.

3.2.2 Procedure of Request for Preferential Examination

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(1) A requester of preferential examination shall attach the following document and article (where the article which forms the basis for request of preferential examination exists) to a written request for preferential examination in Annexed Form no. 22 under the Enforcement Rules of the Patent Act and submit the documents to the Customer Service Division of the Korean Intellectual Property Office or the Application Registration Service Division of the Seoul Branch Office.

- One original copy of a Written Explanation of Request for Preferential Examination (attached with evidential documents of preferential examination in the annexed form)
- One original copy of the evidential document of legal representation when the procedure is initiated by a legal representative

(2) A requester of preferential examination shall pay a fee for requesting preferential examination under the Collection Rules of Patent Fee, etc. to national treasury receipt banks. However, where an applicant wants to use the automated fee payment system (only for electronically-filed applications), he/she does not need to pay fees of request for preferential examination. When an applicant fills out the form for automated payment, patent fees shall be automatically transferred from the applicant's bank account of a pre-registered financial institution to the national coffers.

(Note) An automated fee payment system refers to a system under which a client has patent fees transferred from the applicant's bank account of a pre-registered financial institution (only Industrial Bank of Korea available for now) to the national treasury, rather than directly paying patent fees. In order to use the automated fee payment system, the following procedure shall be carried out in advance: Go to the PatentRo website at www.patent.go.kr→ Click Fee Management→ Move onto Automated Fee Payment→ Enter Application for Automated Payment. If an applicant intends to make an automated payment of patent fees, he/she shall submit the aforementioned application in electronic form.

(3) A person who intends to make a request for preferential examination for an application under Article 4(1) of the Directive (a third party's working of the invention under the provision of Article 61(1) of the Patent Act) shall specify the condition under which a third party worked the claimed invention or the utility model in a written explanation of request

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for preferential examination.

(4) A person who intends to make a request for preferential examination for an application under Article 4(2) of the Directive (an application under Article 9(1)-(9) of the Enforcement Decree of the Patent Act, Article 5(1)-(11) of the Enforcement Decree of the Utility Model Act, Article 36(8) of the Act on Special Cases concerning the Regulation of the Special Economic Zones for Specialized Regional Development or Article 26 of the Special Act on the Designation and Support of High-Tech Medical Complex) shall fill out a written explanation of request for preferential examination in Annexed Form no. 5.

※ Items to be indicated in Written Explanation of Request for Preferential Examination of Annexed Form no.5
(a) Self-search results and Contrastive explanation
(b) Ground for request of preferential examination
(c) Whether a claimed invention is being worked (is prepared to be worked) and whether the invention is worked as business when preferential examination is requested on the ground that an application constitutes the claimed invention which an applicant is working or preparing to work as business under Article 4(2)(i) of the Directive)
(d) Whether a claimed invention is related to the type of business of a certified company (when preferential examination is requested on the ground that the applicant is a venture company, **an innovation business(INNO-BIZ), company with outstanding employee invention compensation system** or a component material technology development business)
(e) Whether a claimed invention is funded or certified in relate to green technology (when preferential examination is requested on the ground of Article 4(2)(b) of the Directive)

(5) A person who intends to make a request for preferential examination on an application (a patent application on which the Commissioner of the Korean Intellectual Property Office agreed to preferentially examine with a commissioner of a foreign patent office) under Article 4(3) of the Directive shall fill out a written explanation of preferential examination in **annexed forms no. 2, no.3 or no. 6 according** to the indication guidelines.

(6) Where preferential examination is requested on the ground of an application under

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Article 4(4) of the Directive (an application outsourced to an external specialized institute for prior art search), an applicant can replace a written explanation of preferential examination under Article 5(1)(1) of the Directive by indicating that the concerned application has been outsourced to an external specialized institute for prior art search in a request for preferential examination under Annexed Form no. 22 of the Enforcement Rule of the Patent Act as well as the name of the external specialized institute and the date of request for prior art search.

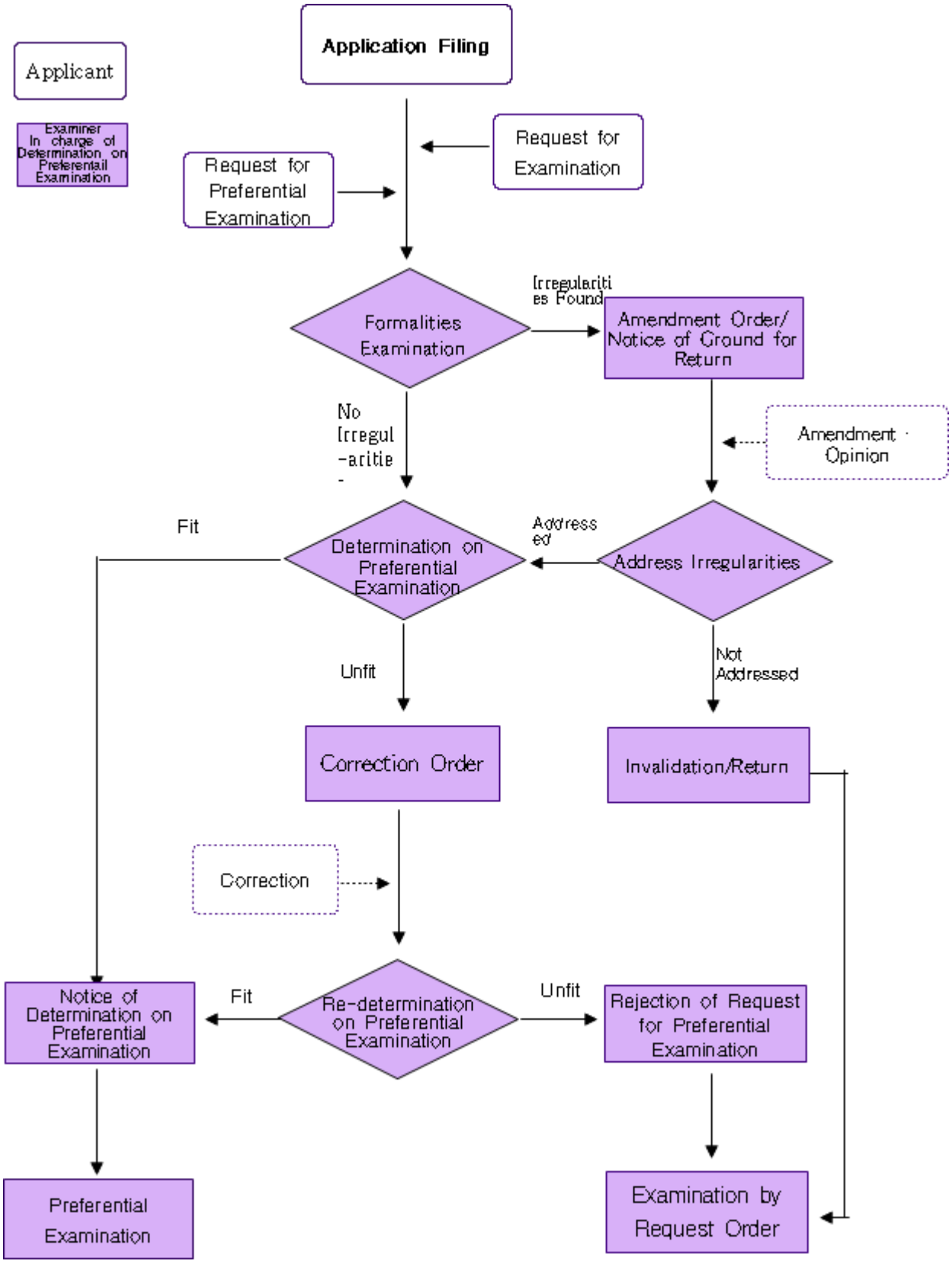
3.2.3 Availability of Withdrawal of Request for Preferential Examination

Where a notification of a decision of preferential examination has been made, a request for preferential examination shall not be withdrawn since once an examiner notifies a decision of preferential examination, the request for preferential examination takes effect and the examiner (or the Korean Intellectual Property Office) starts examination with consideration that the request for preferential examination is valid.

Once a written withdrawal of request for preferential examination is submitted after the decision of preferential examination is made, an examiner shall notify a requester of preferential examination (a person who requested withdrawal) of the intention that a written withdrawal of preferential examination cannot be accepted.

3.3 Procedure of Determination of Preferential Examination

3.3.1. Flowchart of Examination Procedure


Application Filing
Applicant
Examiner In charge of Determination on Preferentail Examination
Request for Examination
Request for Preferential Examination
Formalities Examination
Irregularities Found
Amendment Order/ Notice of Ground for Return
No Irregul-aritie-
Amendment · Opinion
Fit
Determination on Preferential Examination
Addressed
Address Irregularities
Unfit
Not Addressed
Correction Order
Invalidation/Return
Correction
Notice of Determination on Preferential Examination
Fit
Re-determination on Preferential Examination
Unfit
Rejection of Request for Preferential Examination
Preferential Examination
Examination by Request Order

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3.3.2 Overview of Examination by Stage

3.3.3.1 Formalities Examination

The Director General of the Customer Service Bureau shall complete the formalities examination on a request for preferential examination and transfer the request to the director general of the concerned examination bureau.

Once relevant documents of preferential examination are transferred from the Customer Service Bureau, a person in charge of determination on preferential examination shall conduct the formalities examination on the concerned application and the written request for preferential examination. The formalities examination on a request for preferential examination shall be as follows:

(1) Amendment Order and Notification of Ground for Return

A person in charge of determination on preferential examination shall order amendment or notify a ground for rejection in the name of the Commissioner of the Korean Intellectual Property Office when it has been found out based on the results of the formalities examination on the transferred documents that the documents do not comply with the statutory formalities or all or part of fees have not been paid.

When irregularities fall under Article 11 of the Enforcement Rules of the Patent Act, a person in charge of determination on preferential examination shall notify a ground for rejection. As for irregularities which do not fall under the article, he/she shall order amendment.

Where a person in charge of determination on preferential examination orders amendment or notifies a ground for return due to the irregularities found from the formalities examination, the designated period for submission of a written opinion (amendment) or a written explanation shall be one month and the opinion or explanation shall specify the irregularities in detail.

(2) Determination on Addressing Irregularities and Decision

After the designated period has elapsed, where irregularities have been deemed to be addressed based on a written opinion (amendment) or explanation submitted by an application, a person in charge of determination on preferential examination shall determine

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whether the concerned application is eligible for preferential examination. Where irregularities are not addressed, he/she shall invalidate the procedure of request for preferential examination in the name of the Commissioner of the Korean Intellectual Property Office or return the documents of request for preferential examination.

Even when a requester of preferential examination has submitted a written opinion (amendment) or explanation after the designated period has elapsed, a person in charge of determination on preferential examination shall treat the documents of request for preferential examination as a valid written opinion (amendment) or explanation and reassess whether irregularities are addressed or not, rather than invalidating the procedure or returning the concerned documents, if he/she has not invalidated the procedure of request for preferential examination or returned the documents of request for preferential examination.

(3) Fee Return

Where a person in charge of determination on preferential examination intends to invalidate the procedure of request for preferential examination or return the documents of request for preferential examination, he/she shall make an overpayment notification additionally or send a notice on the procedure of fee return attached to a notification on invalidation of the procedure or return of documents.

A notice on invalidation of the procedure of request for preferential examination or return of documents of request for preferential examination shall contain the intention to invalidate(or return) a request for preferential examination, information on administrative trial or lawsuit against the decision, amount of fees to be returned or the way to apply for the fee return.

Where a procedure of request for preferential examination is invalidated or documents of request for preferential examination are returned, the whole amount of fee of request for preferential examination shall be returned.

3.3.3.2 Determination on Preferential Examination

(1) IPC Assignment of Application for Preferential Examination

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When the assignment of IPC is delayed, it postpones the designation of a person in charge of determination on preferential examination. Therefore, an examiner shall assign IPC on an application requested for preferential examination preferentially over other applications. An examiner shall confirm the IPC within one week from the transfer date of the application (in the case of request for super-accelerated examination, within two weeks) or request for re-classification.

The IPC of an application requested for preferential examination shall be automatically assigned unless it is not confirmed within one week from the transfer date of the application.

(2) Determination Deadline for Preferential Examination

A person in charge of preferential examination shall determine whether to conduct preferential examination within one week (in the case of request for super-accelerated examination, within two weeks) from the transfer date of a written request for preferential examination.

However, in the case of amendment order under Article 58 of the Examination Practice Handling Provision, correction order under Article 60 or consultation under Article 61, a person in charge of determination on preferential examination shall calculate seven days again from the date of termination of a period for amendment designated by the person in charge or the date on which the concerned documents were transferred to the person in charge, whichever expires later.

The period spent calculating the deadline shall not be included.

(3) Consultation from Relevant Institute

Where it is hard to determine whether the concerned application is eligible for preferential examination under Article 4 of the Directive, a person in charge of determination on preferential examination shall request consultation from relevant agencies.

(4) Complement Order of Request for Preferential Examination

Where an application requested for preferential examination is deemed not eligible for preferential examination under Article 4 of the Directive or the submitted documents cannot

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clarify whether an application is eligible for preferential examination, a person in charge of determination on preferential examination shall order complement a request for preferential examination within the designated period of one month. However, if the complement order is related to the outcome of prior art search, such as the failure of submission of search results, he/she shall notify such complement order to the requester of preferential examination as well as the specialized institute.

Where items necessary for determination on preferential examination are unclearly written or cannot be recognized, a person in charge of preferential examination shall order complement a written request and do not order to complement a request just because an explanation of request for preferential examination does not comply with the annexed form of the Directive.

Where irregularities are not addressed after submitting the document after complementation, a person in charge of determination on preferential examination shall dismiss a request for preferential examination after the designated period for complementation of preferential examination has elapsed and notify such fact to a requester of preferential examination and applicant (only when an applicant is not a requester of preferential examination).

(5) Items Available for Complementation of Request for Preferential Examination

A request for preferential examination can be complemented from the time of request for preferential examination until the determination on preferential examination. Items available for complementation of request for preferential examination are not limited. However, complementation of changing an application of request for preferential examination or a requester of preferential examination shall not be recognized.

(6) Notification of Determination on Preferential Examination

Where the concerned application is eligible for preferential examination under Article 4 of the Directive, a person in charge of determination on preferential examination shall notify such fact to the requester of preferential examination and applicant (only when an applicant is not a requester of preferential examination) immediately.

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However, as for a patent application agreed for preferential examination between the Commissioner of the Korean Intellectual Property Office and a commissioner of a foreign patent office, the fact that the preferential examination on such application is determined shall not be notified.

(7) Fee Return

The procedure for fee return after dismissal of request for preferential examination is the same with the procedure for fee return of the case where a request for preferential examination is invalidated or returned. However, the returned fee shall amount to the request fee of preferential examination with the fee for determination on preferential examination extracted.

(8) Other Cases regarding Request for Preferential Examination

① Where a request of preferential examination is made on multiple grounds

A request for preferential examination can be made on the basis of multiple grounds for request of preferential examination. In such a case, an examiner shall not invalidate a request for preferential examination and determine and proceed preferential examination if a requester holds at least one ground for request of preferential examination.

② Where a ground of request for preferential examination which a requester did not claim exists

When making determination on preferential examination, a ground for request of preferential examination shall be assessed based on the ground for preferential examination indicated in an explanation of request for preferential examination. Therefore, whether to conduct preferential examination cannot be determined on the ground that a requester of preferential examination did not claim. However, where a ground for request of preferential examination is obvious or explained enough, it can be considered when determining whether to grant the preferential examination status.

As a result of examination on a request for preferential examination, where preferential examination cannot be conducted on the ground for request of preferential examination submitted by a requester or where other grounds for preferential examination exist, a

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person in charge of determination on preferential examination shall order to complement a request for preferential examination before the dismissal of the request. When a ground for preferential examination is changed after the complementation order, he/she shall determine whether to conduct preferential examination based on the newly-submitted ground for request of preferential examination.

For example, where preferential examination was requested based on the ground for the working by a third party and then a person in charge of determination on preferential examination ordered to complement the evidential document on the third party's working, but a requester of preferential examination failed to complement the evidential document on the third party's working and changed the ground for request of preferential examination on the ground that the concerned application is filed by a venture company, if the claimed invention is considered to be related to the type of industry to which the venture company belongs, the person in charge of determination on preferential examination shall recognize the application to be eligible for preferential examination.

③ Where multiple requests for preferential examination are made
After submission of a request for preferential examination, where a new request for preferential examination is submitted before an examiner in charge of the application determines whether to conduct preferential examination based on the previously-submitted request, the subsequently-submitted request for preferential examination shall be subject to return.

Note: It shall be deemed the same with the case where a request for examination is submitted and then another request for examination is submitted subsequently. (Dual Requests)

After a person in charge of formalities examination returns or invalidates a request for preferential examination or after an examiner in charge of the concerned application made a decision to invalidate preferential examination, a request for preferential examination can be submitted again.

④ Availability of whether to determine preferential examination before the submission

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deadline based on the complementation order on request for preferential examination
Where the requirements of request for preferential examination are fulfilled through complementation such as submission of relevant documents even before the submission deadline of complementation order of request for preferential examination, preferential examination can be determined even within the period. However, since relevant documents can be additionally submitted within the period as for determination on dismissal of preferential examination, determination on dismissal of preferential examination shall be made after the termination of the concerned period.

3.3.3.3 After Determination on Preferential Examination

(1) Processing Period after Determination on Preferential Examination
An examiner shall start examination on an application determined for preferential examination either within two months from the transmittal date of a written decision on preferential examination (as for an application agreed for preferential examination between the Commissioner of the Korean Intellectual Property Office and the commissioner of a foreign patent office or an application determined for preferential examination based on the request for prior art search by a specialized institution, four months) or within one month from the transmittal date of the search results to the examiner under Article 8(3)(2) of the Enforcement Decree of the Patent Act(including Article 8(3)(2) of the Enforcement Decree of the Patent Act which Article 9 of the Utility Model Act applies mutatis mutandis), whichever expires later(hereinafter referred to as 'processing period').

In setting the order of examination among applications determined for preferential examination, in principle, an examiner shall conduct the application whose processing period expires first, however, the examiner may change the order of examination for the effective proceeding of examination.

Where an amendment is submitted under the main text of Article 47(1) of the Patent Act or the main text of Article 47(1) of the Patent Act which Article 11 of the Utility Model Act applies mutatis mutandis before examination, preferential examination shall be started within the abovementioned processing deadline or within one month from the transmittal date of the concerned amendment, whichever is later.

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※ Where preferential examination cannot be conducted within the processing deadline because of a jump in requests for preferential examination, it shall be reported to the director of the concerned examination division or examination team (the proviso of Article 66(1) of the Directive)

※ As for a patent application agreed for preferential examination between the Commissioner of the Korean Intellectual Property Office and the commissioner of a foreign patent office, a notification of the decision on preferential examination is not made. Therefore, the date of determination on preferential examination or the date of redetermination on preferential examination, whichever expires later, shall be deemed to be the transmittal date of the notification of the decision on preferential examination.

※ As for a patent application determined for super-accelerated examination, an examiner shall start examination within fourteen days from the transmittal date of a decision on super-accelerated-examination. Where examination cannot be started within the processing deadline because an amendment is submitted after transmittal of a decision on preferential examination, an examiner can change the processing deadline by reporting such fact to the director of the examination division (or team).

The intermediate documents of an application for preferential examination shall be processed within two months (as for super-accelerated examination, within one month) from the expiration date of the designated period or the date when the concerned documents are transmitted to an examiner, whichever is later.

(2) Notification, etc. of Result of Preferential Examination

① A person in charge of determination on preferential examination shall notify a requester of preferential examination(only when a requester of preferential examination is not an applicant) of the final processing results on the application determined for preferential examination (patent grant, utility model registration grant, patent refusal, utility model registration refusal, withdrawal, abandonment, etc.) (Article 67 of the Directive).

② Where relevant documents of preferential examination (including the original copy of the

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receipt of request fee of preferential examination) are not in electronic form, an examiner shall notify a requester of preferential examination of the final processing results and transmit the relevant documents of preferential examination to the principal director of the concerned examination bureau. The principal director shall turn the transmitted documents into electronic files. However, relevant documents of preferential examination are in electronic form, the abovementioned procedure can be skipped.

(3) Other Relevant Cases

① Deferral of Preferential Examination for Application filed before June 30, 2001

Where preferential examination is conducted for an application filed before June 30, 2001 and requested for examination by a third party, an examiner shall defer determination on preferential examination for three months after the filing date and after three months have elapsed from the filing date, he/she shall make a determination on whether to grant a patent.

It is because, when a third party makes a request for preferential examination on the concerned application filed before June 30, 2001, the application can be amended within three months from the date when the request for examination by a third party is notified to the applicant.

② Time to Start Examination on Divisional Application of Application requested for Preferential Examination

Where a divisional application is filed based on the original application requested for preferential examination, but the divisional application is not requested for preferential examination, the time to start examination on the divisional application shall be calculated based on the date of request for examination on the original application, regardless of the time of division.

However, where a divisional application is requested for preferential examination, an examiner shall start examination on the application with the earlier examination order between the divisional application and the original application requested for preferential examination, according to the examination order.

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③ Where Examination is Conducted before Transmittal of Relevant Document for Preferential Examination

Where preferential examination is requested after the start of examination on an application and the application is eligible for preferential examination, an examiner shall recognize the application to have been requested for preferential examination and conduct preferential examination on the application.

④ Where an application requested for preferential examination is a prior application of an application claiming domestic priority

Where a prior application of an application claiming domestic priority is a patent application, the application shall be deemed to be withdrawn when one year and three months have passed from the date of filing the prior application. Where a prior application is withdrawn, the prior right shall be deemed not to exist in applying Article 36 of the Patent Act. However, if a patent is granted before the prior application is deemed to be withdrawn, a subsequent application cannot be granted a patent since the prior application holds the prior right. Therefore, where an application requested for preferential examination becomes a prior application of the application claiming domestic priority, it shall be treated as follows:

Where an application requested for preferential examination is confirmed to be a prior application of the application claiming domestic priority before the determination on preferential examination, the application is not eligible for preferential examination because the ground for the urgent processing of the application under Article 61(2) of the Patent Act is not recognized. Therefore, an examiner shall order an application to complement the request for preferential examination within the designated period(with that indication that preferential examination cannot be conducted because an application requested for preferential examination does not need to be urgently processed since it is a prior application of the application claiming domestic priority). After the designated period has elapsed, the examiner shall dismiss the request for preferential examination.

However, where priority claim is withdrawn before the dismissal of the request for preferential examination, an examiner shall deem it as valid request for preferential examination and conduct preferential examination.

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Also, where an application eligible for preferential examination after determination on preferential examination has become a prior application of the application claiming domestic priority, an examiner shall withhold examination until the application is deemed to be withdrawn.

3.4 Super-Accelerated Examination on Green Technology

(1) Super-Accelerated Examination

As green technology is getting more recognition worldwide and it is closely related to policies on low carbon, green growth being pursued at the pan-government level in Korea, the Korean Intellectual Property Office has adopted the Super Accelerated Examination System under which an application can be examined earlier than other applications requested for preferential examination if it fulfills certain requirements for super-accelerated examination, in order to support the early grant of patent on Korean green technology. The system aims to provide examination result within one month from the request for super-accelerated examination.

(2) Subject for Super-Accelerated Examination

A patent application fulfilling the below-mentioned requirements A and B at the same time and requested according to the request procedure C can be eligible for super-accelerated examination.

A. A patent application which falls under Article 4(2)(b) or (n) of the Directive on Request for Preferential Examination of Patent and Utility Model.

- A patent application directly related to green technology financed or certified by the Korean government

①Patent application granted with green technology certification under the Framework Act on Low Carbon Green Growth and Article 19 of the Enforcement Decree of the same act

② Patent application of a company certified as green-tech enterprise under Article 32 of the Framework Act on Low Carbon Green Growth and Article 19 of the Enforcement Decree of the same act

③ Patent application of an applicant subsidized from the Korean central or municipal

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government under Article 31 of the Framework Act on Low Carbon Green Growth

④ Patent application of an applicant who received investment of Green Technology Investment Co., Ltd. established under Article 29 of the Framework Act on Low Carbon Green Growth and Article 16 of the Enforcement Decree of the same act

⑤ Patent application of an applicant stationed in Green Technology Industrial Cluster established under Article 34 of the Framework Act on Low Carbon Green Growth and Article 22 of the Enforcement Decree of the same act

⑥ Patent application financed or certified based on other national policies

-Article 4(2)(n) of the Directive: a patent application on green technology with the main purpose of pollution prevention or pollutant elimination designated under the environment-related statute

① Noise/vibration control facility, soundproof facility, vibration proof facility designated under Article 2 of the Noise and Vibration Control Act and Article 3 of the Enforcement Rule of the same act

② Water-pollutant prevention facility under Article 2 of the Water Quality and Ecosystem Conservation Act and Article 7 of the Enforcement Rule of the same act

③ Air pollution control facility under Article 2 of the Clean Air Conservation Act and Article 6 of the Enforcement Rule of the same act

④ Waste management facility under Article 2 of the Waste Control Act and Article 5 of the Enforcement Decree of the same act

⑤ Resource-making facility, purification facility, public treatment facility under Article 2 of the Act on Livestock Manure Treatment and Use and Article 3 of the Enforcement Rule of the same act

⑥ Recycling facility designated under Article 2 of the Act on the Promotion of Saving and Recycling of Resources and Article 3 of the Enforcement Rule of the same act

⑦ Public sewage treatment facility, livestock manure treatment facility, sewage or private waste treatment facility under Article 2 of the Sewerage Act

B. A patent application requested for prior art search for a specialized institute under Article 4(4) of the Directive

An application shall be filed by a requester of preferential examination and requested for prior art search for any of the specialized institutes for prior art search designated by the Korean Intellectual Property Office (Korea Institute of Patent Information, WIPS Co.,Ltd., IP

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SOLUTION Co.,Ltd.) under Article 58(1) of the Patent Act. Also, the concerned specialized institute shall notify the search result to the Commissioner of the Korean Intellectual Property Office within 10 days from the request for preferential examination.

C. An electronic application with an indication of intention in a written request for preferential examination

The box for Others in a written request for preferential examination shall contain the indication of 'a patent application directly related to green technology and requested for prior art search' and the name of the specialized institute for prior art search and request date based on the information on the request for prior art search. The written request for preferential examination shall be electronically filed. Meanwhile, if a request for preferential examination is submitted in writing, more time would be spent on the receipt of documents and electronization, making it impossible to start examination within one month from the submission of the written request for preferential examination. Therefore, only a patent application submitted in electronic form shall be eligible for super-accelerated examination.

(Note) Determination on attachment of a written request for preferential examination in the case of super-accelerated examinations: in order for an application to be eligible for super-accelerated examination, an applicant shall indicate in a written request for preferential examination that the concerned application is directly related to green technology and has been commissioned for prior art search to a specialized institute as well as the information on commission of prior art search by the specialized institute(the name of the specialized institute and the date of commission, etc.) and then submit a written explanation of request for preferential examination indicating that the concerned application is entitled to preferential examination for green technology (attached with the evidential documents, if necessary). Therefore, where a written explanation on preferential examination does not include such indications or an applicant fails to submit a written explanation on preferential examination, an examiner shall order a correction order. However, in the case of super-accelerated examination, since search results are submitted by a specialized institute, an applicant need not indicate the search process of prior art and any contrastive explanation on prior art in a written request for preferential examination.

(3) Processing Period of Application Requested for Super-Accelerated Examination

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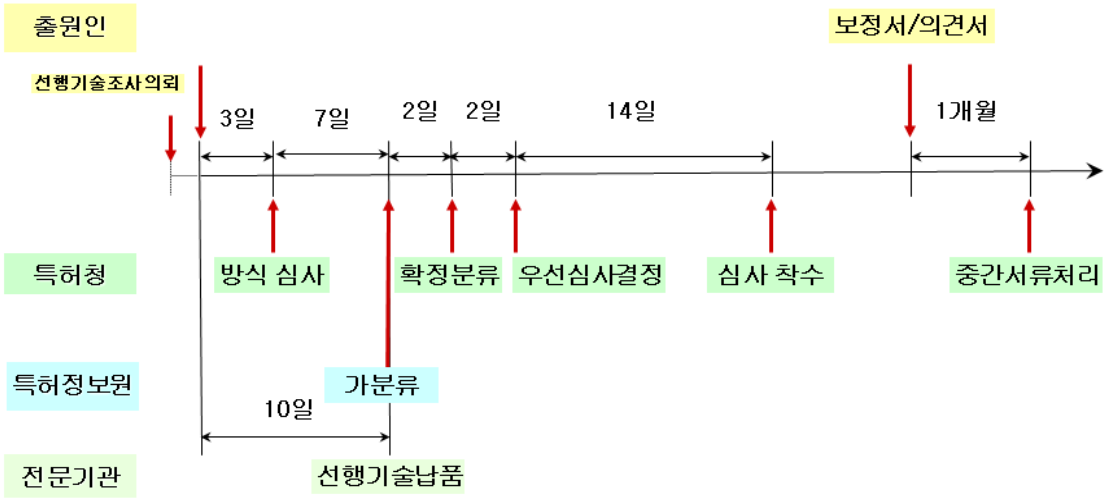

(4) Process of Determination on Preferential Examination of Application Requested for Super-Accelerated Examination

If an application is eligible for super-accelerated examination, an examiner shall determine whether to grant the preferential (super-accelerated) examination status by reviewing on the two grounds for preferential examination (application entitled to preferential examination on green technology(Article 4(2)(b) or (n) of the Directive) and the requirement of request for preferential examination based on prior art search results made by a specialized institute(Article4(4) of the Directive)) on the PatentNet website. However, an examiner shall make a correction order if either of the two grounds for preferential examination is not met and shall determine whether the concerned application is eligible for super-accelerated examination based on the subsequently-submitted documents or argument. However, where an applicant asks for only preferential examination, an examiner may directly determine to grant the preferential examination status without any correction order and even after the correction order is made, the examiner can determine to conduct preferential examination on the concerned application if the applicant wishes.

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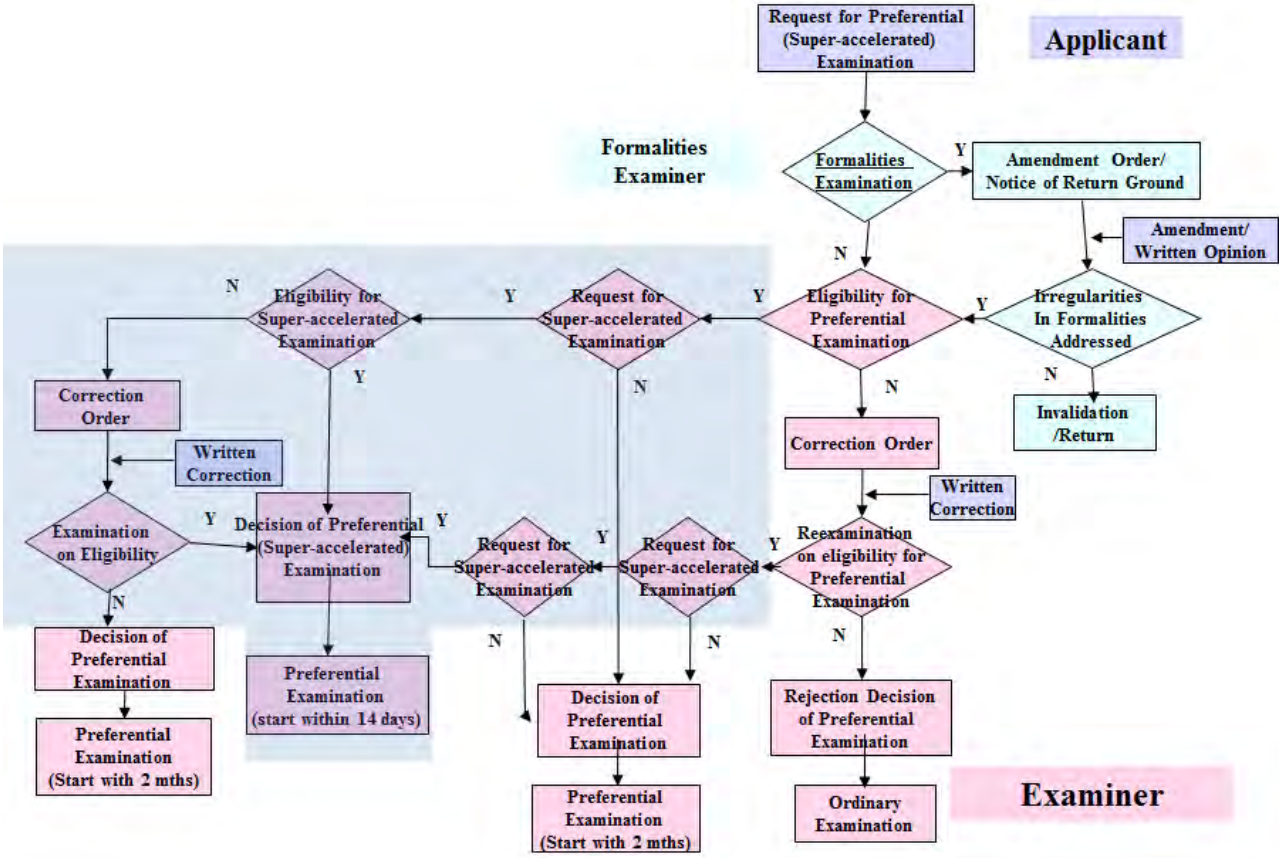

Where an application is eligible for super-accelerated examination and is determined for preferential(super-accelerated) examination, an examiner shall start examination within the designated processing period of super-accelerated examination. Where the concerned application is only determined to be preferentially examined, an examiner shall follow the procedure for preferential examination. Meanwhile, other process of determining a request for super-accelerated examination shall be referred to the process of determining preferential examination.

(5) Cases of Determination on Preferential Examination on Application requested for Super-Accelerated Examination

Where an application is eligible for super-accelerated examination but has not been filed electronically

If an applicant made a request for super-accelerated examination claiming that the two

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grounds for preferential examination(application entitled to preferential examination on green technology(Article 4(2)(b) or (n) of the Directive) and the requirement of request for preferential examination based on prior art search results made by a specialized institute(Article4(4) of the Directive))) are met, but he/she failed to file the application electronically, the concerned application shall not be returned since the application does not fall under Article 11 of the Enforcement Rules of the Patent Act. However, where an examiner orders to file an electronic application and determines to conduct a preferential examination after the correction order, or where an applicant wishes, the examiner can determine to conduct a preferential examination right away. Provided, however, that an amendment to a request for preferential examination is electronically submitted after the correction order and the above-mentioned grounds are fulfilled, an examiner may determine to conduct a super-accelerated examination on the concerned application.

(6) Comparison of Super-Accelerated Examination and Preferential Examination

The comparison of deadlines for processing super-accelerated examination and preferential examination is as follows:

	Super-accelerated examination	Preferential examination
Definitive Classification	Within two days from the date of transfer or hand-over of pre-IPC assigned application documents	**Within one week** from the date of transfer or hand-over of pre-IPC assigned application documents
Submission Period of Prior Search Report by Specialized Institution	Within 10 days from the request for preferential examination	Within one months from the request for preferential examination
Determination Process and Period of Determination on Preferential Examination	Within two days from the date of transfer of a written request for preferential examination (the date of transfer of the search results since the application falls under Article 4(4) of the Directive)	Within seven days from the date of transfer of a written request for preferential examination (the date of transfer of the search results since the application falls under Article 4(4) of the Directive)

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Pendency Period after Determination on Preferential Examination	Within 14 days from the transmittal date of a written determination on preferential examination	The later date between two months from the date of transmittal of a written determination of preferential examination(**four months as for applications agreed for preferential examination between KIPO commissioner and a commissioner of foreign patent offices or applications preferentially examined by commission of prior art search by specialized institute**) and one month from the date when the search results under Article 8(3)(2) of the Enforcement Decree of the Patent Act are delivered to examiner
Pendency Period of Interim Documents after Start of Examination	Within one month from the later date between the expiration date of the designated period and the date of transmittal of the concerned documents to an examiner	Within two months from the later date between the expiration date of the designated period and the date of transmittal of the concerned documents to an examiner

※ As for a patent application agreed for preferential examination between the Commissioner of the Korean Intellectual Property Office and the commissioner of a foreign patent office, the later date between the date of determination on preferential examination and the date of re-determination of preferential examination

4. Guidelines of Determination on Preferential Examination by Subject

4.1 Application being worked by Third Party

4.1.1 Subject

Applications for an invention or utility model deemed to have been worked as business by a

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third party after the laying-open of the application shall be included.

4.1.2 Examination Guidelines

(1) Definition of Laying-open of Application

"Laying-open of application" refers to the disclosure of an application specified under Article 64 of the Patent Act. Therefore, where an application has not been laid open as described in Article 64 of the Patent Act at the time of request for preferential examination (or where a request for early disclosure of the application has not been filed, or the laying-open is not impending), an applicant shall make a request for early disclosure of the application.

(2) Definition of Third Party

"A third party" refers to a person other than an applicant and who has not obtained the permission to work the claimed invention or utility model.

As long as no particular ground exists, an examiner does not need to additionally investigate whether the permission to work the claimed invention is obtained and just may recognize the argument made by a requester of preferential examination as it is.

(3) Definition of Working

"Working" of the working of the invention by a third party refers to the acts of the working under Article 2(3) of the Patent Act or Article 2(3) of the Utility Model Act.

a. In the case of an invention of a product, acts of manufacturing, using, assigning, leasing, importing or offering for assignment or lease (including displaying for the purpose of assignment or lease) of, the product

b. In the case of an invention of a process, acts of using the process

c. In the case of an invention of a process for manufacturing a product, acts of manufacturing, using, assigning, leasing, importing, or offering for assignment or lease of, the product manufactured by the process, in addition to the acts mentioned in the preceding paragraph (b)

d. Acts of manufacturing, using, assigning, leasing, importing, or offering for assignment or lease (including displaying for the purpose of assignment or lease) of, the product related to utility model registration

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Also, 'working' means the working of an invention in the Republic of Korea. Therefore, where an invention filed in the Republic of Korea is being worked only in a foreign country, it shall not constitute the working of an invention. However, where a claimed invention produced in a foreign nation is imported to the Republic of Korea, it shall constitute the working of an invention.

(4) Determination on Identicalness between the Invention worked by Third Party and the Claimed Invention

A request for preferential examination made by an applicant on the ground that a third party is working the applicant's invention shall clarify that the invention claimed to be worked by the third party is identical with the invention of the applicant. Also, a requester of preferential examination shall verify the ground for identicalness of the two inventions.

By submitting the below-mentioned documents, a requester of preferential examination can verify the fact of the invention being worked by a third party with the description of the detailed condition where the third party is working the requester's invention(time, place, product name, number of sales made, etc.). For example, a requester may verify the fact of the invention being worked by a third party by submitting the detailed explanation on the time and date of the purchase of the product and the correlation between the concerned product and the claimed invention or utility model by submitting a photograph of the product being sold by a third party along with a written explanation on request for preferential examination.

Example)-Submission of Product being worked by Third Party
-Submission of Photograph of Product, Place of Invention being worked or Invention being sold
-In the case of content-certified mail requesting the ban on the working of the invention by a third party being sent, submission of a copy of the content-certified mail
-Submission of other evidential documents or products of the invention being worked by a third party

An examiner shall determine on the identicalness of the concerned product being worked by

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a third party and the claimed invention or utility model by comparing them with reference to the evidential materials such as products or pictures presented by a requester of preferential examination. However, where identicalness cannot be determined only based on the submitted materials, an examiner may order to complement evidential documents.

However, where it is deemed difficult for a requester of preferential examination to verify the fact that the invention is being worked by a third party due to lack of cooperation from the person working the concerned invention and the possibility of the identicalness between the invention being worked by the third party and the claimed invention is pretty high, an examiner may recognize the request for preferential examination without requesting the submission of additional materials from the requester of preferential examination. That is to say that where it is not clear whether the invention or utility model being worked by a third party and the claimed invention or utility model are not identical after the review of both inventions or utility models, an examiner may recognize the request for preferential examination without conducting additional investigations, except for obvious cases where the two inventions or utility models are substantially not the same. However, where the two inventions or utility models are different, an examiner shall dismiss the request for preferential examination.

4.1.3. Handling of Request for Preferential Examination based on Working of Invention by Third Party prior to Laying-open

Where an invention or utility model is being worked by a third party, the concerned application shall be laid open under Article 64 of the Patent Act as of the date of determination on preferential examination. Also, an application laid open based on a request for early publication shall fall under the laying-open of the application under Article 64 of the Patent Act.

Also, as for a request for preferential examination made based on the working of the invention by a third party before the laying-open of the application, where the publication of the concerned application is imminent (an application expected to be laid open within 15 days from the date of transmittal of a written request for preferential examination) or an applicant made a request for early publication of the application even though the concerned

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application has not been laid open under Article 64 of the Patent Act, an examiner shall withhold the determination on preferential examination without dismissal of the request for preferential examination.

Except for the case where it is determined that an application is not to be laid open early through the dismissal of the request for early publication after withholding the decision on preferential examination, once the concerned application is laid open, an examiner shall conduct preferential examination.

4.1.4 Handling of Request for Preferential Examination in Presence of Warning from Applicant

A person who has received a warning on the working of the published invention or utility model without permission from an applicant may make a request for preferential examination on the claimed invention or utility model by submitting the written warning or a copy of the warning, along with the indication of the detailed condition (Date of warning, Means of Warning, Contents of Invention or Utility Model related to Warning as well as Contents of Invention or Utility Model being worked) in a written explanation of request for preferential examination. An examiner shall recognize the request for preferential examination as long as there is no special ground for the applicant's rejection to the fact that the applicant delivered a warning to the third party and the invention or utility model being worked by the person who has received the warning is not recognized to be clearly different from the claimed invention or utility model.

4.2 Application related to Defense Industry

(1) Subject
Applications related to the defense industry and applications on defense materials or the manufacturing process of the defense materials defined under Article 34 of the Defense Acquisition Program Act and Article 39 of the Enforcement Decree of the same act and Articles 27 and 28 of the Enforcement Rule of the same act
※ Defense materials under the Defense Acquisition Program Act are divided into major defense materials and general defense materials

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① Major Defense Materials
- Firearms and other fire power weapons, guided weapons, aircraft, vessels, ammunition, tanks, armored vehicles and other mobile combat equipment, radars, identification friend or for and other communication and electronic equipment, night observation devices and other optical or thermal imaging devices, combat engineering equipment, chemical, biological and radiological warfare equipment, command and control systems, or other materials that the Administrator of the Defense Acquisition Program Administration designates as recognized to be important for military strategy or tactical operations

② General Defense Materials
- Defense materials other than major defense materials

(2) Examination Guidelines
A request for preferential examination on an application related to the defense industry does not require the submission of additional evidential documents. A requester may indicate the name of at least one of the items listed under Article 4(2)(a) of the Directive (Example: Firearms and other fire power weapons under Article 35(2)(1) of the Defense Acquisition Program Administration) in a written explanation on request for preferential examination and explain that the claimed invention or utility model constitutes the concerned item.

Even where a requester of preferential examination did not specify defense materials in a written explanation of request for preferential examination and generally indicated the subject matter as "a patent application in the defense industry" under Article 9(1) of the Enforcement Decree of the Patent Act, if an examiner can determine that the subject matter falls under the defense materials defined under the above-mentioned Defense Acquisition Program Act , he/she may recognize a request for preferential examination without making an additional correction order.

4.3 Patent Application directly related to Green Technology, Utility Model Registration Application useful for Pollution Prevention

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4.3.1 Overview

Under Article 9(2) of the newly-amended Enforcement Decree of the Patent Act, a patent application useful for pollution prevention is changed to a patent application directly related to green technology and this article applies to a request for preferential examination filed since October 1 of 2009. A patent application directly related to green technology shall include a patent application useful for pollution prevention, which was eligible for preferential examination before the revision of the Patent Act.

Patent applications directly related to green technology and applications of utility model registration useful for pollution prevention which are eligible for preferential examination are specified under Article 4(2)(b) and (n) of the Directive on Request for Preferential Examination on Patent and Utility Model and can be divided into two categories:

① Patent applications on green technology financed or certified by the government, etc. (excluding applications of utility model registration)

② Applications on pollution prevention facilities and methods of pollution prevention which the facilities hold (including both patent applications and applications of utility model registration)

4.3.2 Definition and Scope of Green Technology

In order to be eligible for preferential examination, a claimed invention shall constitute green technology. In general, green technology refers to technology which minimizes the emission of greenhouse gases and pollutants by saving and effectively using energy sources in the entire course of socioeconomic activities such as greenhouse gas emission reduction technology, energy efficiency technology, cleaner production technology, cleaner energy technology, resource circulation and eco-friendly technology (including relevant convergence technology). Green technology is defined under Article 2(3) of the Framework Act on Low Carbon Green Growth and Article 9(2) of the Enforcement Decree of the Patent Act.

When requesting preferential examination on green technology, a requester shall explain on what ground the claimed invention constitutes green technology in a written explanation on request for preferential examination. Then, a person in charge of determination on preferential examination shall make a decision on whether the claimed invention constitutes green technology based on the argument presented by the applicant.

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Meanwhile, since an invention on pollution prevention facilities and methods of pollution prevention which the facilities hold constitutes environmentally-friendly technology in the definition of green technology, the invention shall be deemed as green technology.

Where there is not ground for denial that the claimed invention is a technology which saves and uses energy sources efficiently and minimizes the emission of greenhouse gas and pollutants, the invention shall be recognized as green technology. Especially, the below-mentioned technology shall constitute green technology.

<27 Major Green Technology Initiatives on Comprehensive Measures of Green Technology R&D>

1. Climate Change Forecast and Modeling Development
2. Climate Change Effect Evaluation and Adaptation
3. High Efficient, Low Cost Silicon Solar Cell Technology
4. Non-Silicon Solar Cell Mass Production and Core Technology
5. Bioenergy Production Element and System
6. Advanced Light Water Reactor Design and Construction
7. Eco-Friendly Non-Proliferation Reactor and Nuclear Fuel Cycle System Development
8. Nuclear Fusion Reactor Design and Construction
9. High Efficient Hydrogen Production and Storage
10. Next-Generation High Efficient Fuel Battery System
11. Eco Friendly Plant Growth Promotion
12. Integrated Gasification Combined Cycle
13. High Efficiency-Low Emission Vehicle
14. Intelligent Transportation and Distribution
15. Ecological Space and Urban Generation
16. Eco-Friendly and Low Energy Construction
17. Green Process considering Environmental Load and Estimation of Energy Consumption
18. LED Lights and Green IT
19. Electric Power IT and Electrical Device Efficiency Promotion
20. High Efficient Secondary Battery

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21. CO2 Capture, Storage and Processing
22. Non-CO2 Greenhouse Gases Treatment
23. Water Quality Evaluation and Management
24. Alternative Water Resources Securement
25. Waste Reduction, Recycling, Waste-to-Energy Technology
26. Harmful Substance Monitoring and Environment Purification
27. Virtual Reality

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<Green Technology from 17 New Growth Engines>

1. New and Renewable Energy Technology	Solar Battery, Hydrogen Fuel Battery, Bioenergy(Biodiesel, bioethanol, biogas, BtL(Biomass-to-Liquids), Ocean Energy(Tidal Power Generation,
2. Carbon Emission Reduction Technology	Carbon Capture & Storage(CCS), Nuclear Power, Nuclear Fusion, Technology for more efficient Fossil Fuel, Non-CO2 Gas Treatment Technology, etc.
3. Advanced Water Treatment Technology	Smart Sewage System(Energy-Efficient Membrane Purification, Intelligent Membrane Purification, etc.), Sewage and Wastewater Treatment, desalination, Aquatic Ecosystem Restoration, Soil & Groundwater Remediation, etc.
4. LED Application Technology	Eco LED, LED Smart Module, LED Lighting, etc.
5. Green Transportation System-related Technology	Green Car(Hybrid Car, Plug-in Hybrid Car, Clean Diesel Car, Fuel Cell Car, etc.), WISE Ship(Futuristic Eco-friendly Ship, Leisure Boat, etc.), Advanced Train(High-Speed Train, Tilting Train, Magnetic Levitating Train, etc.), Bicycle, etc.
6. Advanced Green City-related Technology	Ubiquitous City(U-City), Intelligent Transport System(ITS), Geographic Information System(GIS), Energy-efficient Green House, etc.

Where a requester of preferential examination gave no explanation on the claimed invention requested for preferential examination on the ground for green technology or where the claimed invention is deemed irrelevant to green technology based on the explanation given by a requester of preferential examination, an examiner shall order to correct the request of preferential examination based on such grounds.

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4.3.3. Patent Application on Green Technology Financed or Certified by State, etc.

(1) Subject

Article 4(2)(b) of the **Directive on Request for Preferential Examination on Patent and Utility Model** governs patent applications directly related to green technology and one of the following patent applications shall be eligible for preferential examination.

① Patent application certified as green technology under Article 32 of the Framework Act of on Low Carbon Green Growth and Article 19 of the Enforcement Decree of the same act

② Patent application filed by a certified green business under Article 32 of the Framework Act of on Low Carbon Green Growth and Article 19 of the Enforcement Decree of the same act

③ Patent application of an applicant subsidized by the State or local municipal governments under Article 31 of the Framework Act of on Low Carbon Green Growth

④ Patent application of an applicant who received investment from Green Technology Investment Co., Ltd. established under Article 29 of the Framework Act of on Low Carbon Green Growth and Article 16 of the Enforcement Decree of the same act

⑤ Patent application of an applicant stationed in Green Technology Industrial Cluster established under Article 34 of the Framework Act on Low Carbon Green Growth and Article 22 of the Enforcement Decree of the same act

⑥ Patent application financed or certified based on other national policies

(2) Examination Guidelines

A person in charge of determination on preferential examination shall decide whether to recognize the concerned application to be eligible for preferential examination based on the explanation given by a requester of preferential examination that the claimed invention constitutes green technology written in a written explanation of preferential examination and is financed or certified by the State, etc.(As for the eligibility of green technology, the above-mentioned guidelines shall be referred to).

When determining whether the concerned invention is financed or certified by the State, etc., an examiner shall check if a requester of preferential examination has submitted the following evidential documents by each of the above-mentioned grounds for request of preferential examination and the applicant and the claimed invention shall be identical with

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the person who got the financial support and certification for the invention from the State, etc. and the concerned technology.

<Green Technology-related Evidential Documents>

Ground for Request	Evidential Document
Green Technology Certification	Each document under Paragraphs 1 and 2 1. Explanation on the concerned technology used for green certification request 2. Certification of green technology under Article 32 of the Framework Act on Low Carbon Green Growth
Green Business	Each document under Paragraphs 1 and 2 1. Document that verifies the claimed invention and the green business belong to the same industry (Explanation on the concerned technology(business) for green certification request, sales proportion statement, etc.) 2. Certification of green technology under Article 32 of the Framework Act on Low Carbon Green Growth
Subsidization	Evidential document of subsidization from the State or local municipal governments
Investment from Green Technology Industry Co., Ltd	Evidential document of receiving investments from Green Technology Industry Co., Ltd (loan statement, etc.)
Green Technology Industrial Cluster	Evidential document that an applicant is stationed in Green Technology Industrial Cluster

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Other Financial Support Certification	Document that constitutes any of the followings 1. Evidential document of R&D financing from a state agency (Announcement on technology development program designation, etc.) 2. Evidential document of green technology-related financing from a financial institution (Loan statement, etc.) 3. Environmental mark certification, Carbon footprint labeling certification, New technology certification, Technology verification(Issuer: Ministry of Environment, Korea Environmental Industry & Technology Institute) 4. GR(Good Recycled) certification (Issuer: Korea Agency for Technology and Standards) 5. Evidential documents of financial support or certification based on other national policies

4.3.4 Application on Pollution Prevention Facilities and Method of Pollution Prevention that Such Facilities hold

(1) Subject

Article 4(2)(n) of the Directive on Request for Preferential Examination on Patent or Utility Model:

Applications whose primary purpose is to prevent or eliminate pollution and which is related to one of the following environmental pollution prevention facilities or the methods that such facilities hold:

① Noise/Vibration Control Facility, Sound proof Facility or Vibration proof Facility under Article 2 of the Noise and Vibration Control Act and Article 3 of the Enforcement Rule of the same act

② Water Pollution Preventive Facility under Article 2 of the Water Quality and Ecosystem Conservation Act and Article 7 of the Enforcement Rule of the same act

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③ Air Pollution Control Equipment under Article 2 of the Clean Air Conservation Act and Article 6 of the Enforcement Rule of the same act

※ Facilities that are to eliminate or reduce malodorant substances produced from malodor-emitting facilities under Article 2 of the Malodor Prevention Act and Article 3 of the Enforcement Rule of the same act and fall under the Annexed Form no. 4 of the Enforcement Rule of the Clean Air Conservation Act shall be deemed air pollution control equipment.

④ Waste disposal facilities under Article 2 of the Wastes Control Act and Article 5 of the Enforcement Decree of the same act

⑤ Facilities for converting into resources, sanitation facilities, public disposal facilities under Article 2 of the Act on the Management and Use of Livestock Excreta and Article 3 of the Enforcement Rule of the same act

⑥ Recycling facilities under Article 2 of the Act on the Promotion of Saving and Recycling of Resources and Article 3 of the Enforcement Rule of the same act

⑦ Public sewage treatment plant, waste treatment plant, reuse plants for water treated by public sewerage or private sewage treatment facility under Article 2 of the Sewerage Act

(2) Examination Guidelines

Where preferential examination is requested on the ground of an application related to facilities under the above-mentioned acts, a requester does not need to submit additional evidential documents upon request for preferential examination and just indicate in a written explanation of request for preferential examination that the concerned application falls under one of the above-mentioned subject for examination (example: Annexed Form 3-1. Intermediate Treatment Facility A. Combustion Facility (2) high-temperature combustion facility under Article 2 of the Wastes Control Act and Article 5 of the Enforcement Decree of the same act).

Even where a requester of preferential examination did not specify a pollution prevention facility in a written request for preferential examination, and just indicate it as "a patent application useful for pollution prevention", an examiner may recognize the request for preferential examination without any additional correction order where he/she deems that the concerned facility corresponds to one of the environmental pollution prevention facilities under the above-mentioned environment-related laws.

Also, even if the application is useful for pollution prevention, where it does not fall under

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any of the above-mentioned pollution prevention facilities, the application shall not be deemed eligible for preferential examination. Even applications related to medicine, agent or living organism directly used for the operation of the above-mentioned pollution prevention facilities shall not be eligible for preferential examination.

(3) Where the application is not related to a facility(device) directly removing pollutants or a pollution prevention facility

Where the claimed invention is directly used for pollution prevention, but the facility is not one of the pollution prevention facilities designated under the above-mentioned environment-related laws, the application shall not be deemed eligible for preferential examination.

Under the above-mentioned environment-related acts, pollution prevention facilities refer to those which are to remove or reduce pollutants emitted from the pollutant-emitting facilities. Therefore, even though the facilities directly reduce the emission of pollutants, if they are not the facilities which reduce the emission of pollutants coming from the pollutant-emitting places, the concerned facilities sometimes do not belong to pollution prevention facilities.

For example, a car is not one of the air pollutant emitters designated under Article 2(11) of the Clean Air Conservation Act and the Annexed Form no.2 of Article 5 of the Enforcement Rule of the same act. Therefore, an exhaust gas converter installed within a car which aims to reduce the emission of the air pollutants from a car shall not be eligible for preferential examination since it is not deemed to correspond to air pollution prevention facilities of Article 2(12) of the Clean Air Conservation Act and the Annexed Form no. 4 of Article 6 of the Enforcement Rule of the same act.

4.4 Applications directly related to the Promotion of Trade

(1) Subject

Applications directly related to the promotion of trade (export)

(2) Examination Guidelines

① Evidential Documents

Applications directly related to the promotion of trade shall be determined for preferential

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examination by reviewing the following documents:
1. Statement of export result
2. Evidential document of arrival of letter of credit(L/C)
3. Evidential documents of request on necessity of patent right, utility model right or design right by purchaser of exported goods
4. Evidential documents of export contract
5. Evidential documents that the procedure for adopting the concerned invention as international standards is being carried out or the invention contributes to the promotion of trade after being adopted as international standards
6. Other evidential documents that the concerned invention is directly related to trade promotion

② Determination on Identicalness of the Invention to be exported and the claimed invention
As for a request for preferential examination on application directly related to the trade promotion, the invention to be exported and the claimed invention shall be identical.
Whether the invention directly related to the trade promotion is the same as the claimed invention shall be proved by a requester of preferential examination. However, normally, the identicalness cannot be determined just based on the documents about the request of preferential examination. In such cases, an examiner can recognize the request of preferential examination without requiring the submission of additional evidential examination as long as there is a high possibility that the application directly related to trade promotion and the claimed invention are the same and no particular grounds to doubt such possibility exist.

4.5 Application on Duties of State or Municipal Governments

(1) Subject
Applications related to duties of state or municipal governments (Applications on duties of a national or public school under the Higher Education Act. Applications on an organization exclusively responsible for technical transfer and commercialization set up in national or public schools under Article 11(1) of the Technology Transfer and Communization Promotion Act shall be included).

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(2) Examination Guidelines

Duties of state or municipal governments refer to the work that the state or municipal governments are obliged to conduct. Where a requester of preferential examination is the state or municipal governments(an organization exclusively responsible for technical transfer and commercialization set up in national or public schools), the concerned application may be deemed to be related to duties of the state or municipal government(duties of national or public school under the Higher Education Act).

A request for preferential examination related to duties of state or municipal governments shall be deemed valid only when the state or municipal governments (an organization exclusively responsible for technical transfer and commercialization set up in national or public schools) make a request for preferential examination(Article 3 of the Directive). Where a requester of preferential examination is not state or municipal governments (an organization exclusively responsible for technical transfer and commercialization set up in national or public schools), an examiner shall deem the concerned request for preferential examination not valid and order to correct the request within the designated period. Where the request is not addressed within the designated period, the examiner shall dismiss the request for preferential examination.

Meanwhile, as for an application on duties of national or public schools under the Higher Education Act filed by an organization exclusively responsible for technical transfer and commercialization set up in national or public schools, the concerned application shall be treated as the same application as the one related to duties of the state or municipal governments.

A national school refers to a school established and managed by the state and a public school means one set up and run by a municipal government. An organization exclusively responsible for technical transfer and commercialization set up in national or public schools shall be a legal entity only.

4.6 Applications related to Companies Certified as Venture Businesses

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(1) Subject

An application of a business who received confirmation as a venture business under Article 25 of the Act on Special Measures for the Promotion of Venture Businesses

(2) Examination Guidelines

① Where an application is jointly filed and one of the applicants is a venture business, the request for preferential examination shall be accepted.

② Where the names of the company certified as venture business and the applicant are identical, the request for preferential examination shall be accepted.

③ At least one of the dates among the filing date, the date of request of preferential examination or the date of determination on preferential examination shall be within the valid period written on a certificate of.

④ The original copy of the confirmation of being a venture business shall be used to verify the status of venture business. However, a copy of the confirmation of being a venture business can be used if it is recognized to be the same with the original copy. A written notice on the result of evaluation for confirmation of being a venture business cannot replace the confirmation of being a venture business.

⑤ Where a request for preferential examination is made even though there is no correlation between the type of the venture business and the claimed invention, the request for preferential examination shall not be accepted. Where no correlation is found, an examiner shall order to correct the request for preferential examination and when the correlation is well explained, the examiner shall accept the request for preferential examination.

⑥ The correlation between the type of the venture business and the claimed invention shall be examined based on the explanation given by a requester of preferential examination along with the written explanation of request for preferential examination and evidential documents (business registration certificate, etc.). If necessary, the business type and the main products written on the Company Overview of the concerned business and the content of the claimed invention can be compared on the website for the system for confirmation and announcement of being a venture business(http://www.venturein.or.kr/) run by Korea Technology Finance Corporation. Where no correlation on the type of business is found or can be accepted when determining preferential examination, an examiner shall order to correct the request for preferential examination.

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※ The confirmation of being a venture business is issued by the agency or organization designated by Article 25 of the Act on Special Measure for the Promotion of Venture Businesses and Article 18(3) of the Enforcement Decree of the Act on Special Measure for the Promotion of Venture Businesses.

(3) Where the business written on the confirmation of being a venture business is not an applicant

Where an applicant cannot file an application in the name of the company under Article 4 of the Patent Act since the company indicated on the confirmation of being a venture business is not a legal entity, an examiner shall deem the concerned application as an application filed by a venture business and recognize the request for preferential examination only when the applicant and the head of the venture business indicated on the confirmation of being a venture business are the same.

For an application filed in the name of a natural person to be recognized as an application filed by a venture business, the venture business at the time of filing the application shall not be a legal entity, beside the requirement that the applicant and the head of the venture business are identical.

Where the company written on the confirmation of being a venture business is not the same as the applicant, an examiner shall order an applicant to submit business registration certificate and then determine whether the venture business is a legal entity.

(Note) Way to determine whether a venture business is a legal entity: Where the second group numbers from the registration numbers of the business registration certificate are from 81-87, the venture businesses are legal entities and the other numbers indicate they are not legal entities.

<Example>Registration Number: 000-00-00000(81-87: legal entity, other numbers: non legal entity)

(4) Where a request for preferential examination is made by adding a venture business to an applicant after filing the application

To be eligible for preferential examination on the ground for a venture business, the applicant shall be a venture business when filing an initial application. Therefore, where an

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applicant was not a venture business at the time of filing an initial application, but made a report of change of applicants(change or addition of venture business) and then made a request for preferential examination on the ground of change or addition of venture business, the application shall not be eligible for preferential examination. However, where a venture business works the claimed invention with the right to get a patent transferred from the original applicant, a person in charge of determination on preferential examination can confirm such fact and recognize it to be eligible for preferential examination. Meanwhile, the same shall apply to innovation businesses, companies with outstanding employee invention compensation system or components· materials technology developers, too.

(5) Determination on Relevance between the Claimed invention (Utility Model) and Business Type of Certified Company

Applications filed by companies certified as venture companies, innovation businesses, companies with outstanding employee invention compensation system, part·material technology development companies (hereinafter referred to as 'certified company') are themselves entitled to preferential examination, but only when the relevance between the claimed invention(utility model) and the business type of the certified company is confirmed.

Normally, when the business type of the certified company confirmed through the business registration certificate submitted by a requester of preferential examination or the announcement website related to confirmation is the same as all or part of the industrial field and the claimed invention, the relevance between the business type and the claimed invention shall be confirmed.

4.7 Application by Company designated as Innovation Business (Inno-Biz)

(1) Subject

Applications filed by the company designated as the Inno-Biz under Article 15 of the Act on the Promotion of Technology Innovation of Small and Medium Enterprises

(2) Examination Guidelines

① Where the application is jointly filed by more than two applicants and at least one of them is designated as the Inno-Biz, a request for preferential examination shall be

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recognized.

② Where the names of the company designated as the Inno-Biz and the applicant are identical, a request for preferential examination shall be recognized. Where the names of the company and the applicant are different, only applications filed by the company certified as the venture company under Paragraph 4.6. shall be eligible for preferential examination.

③ At least at one point among the date of filing an application, the date of request for preferential examination or the date of determination on preferential examination, an applicant shall constitute an Inno-Biz.

④ Documents used to confirm the Inno-Biz shall be the original copy of the Inno-Biz Confirmation issued by the Small & Medium Business Administration, except for a copy is deemed to be identical with the original document.

⑤Where a request for preferential examination is made despite no relevance between the business type of the Inno-Biz and the claimed invention, the concerned application shall not be eligible for preferential examination. Where the relevance between the claimed invention and the Inno-Biz is not confirmed, an examiner shall order the requester of the preferential examination to correct the request for preferential examination and when the relevance is well-explained, the request for preferential examination shall be recognized.

⑥The relevance between the business type of the Inno-Biz and the claimed invention shall be confirmed with the explanation that a requester of preferential examination makes based on the evidential documents (such as business registration certificate, etc.) in a written explanation of request for preferential examination. If necessary, the business type of the concerned certified company and the content of the claimed invention can be compared on the website of the Inno-Biz certified company information system at http://www.innobiz.net. Where the relevance cannot be confirmed or recognized in determining preferential examination, the examiner shall order to correct the explanation of request for preferential examination.

4.8 Applications of Company designated as Companies with Outstanding Employee Invention Compensation System

(1) Subject

A patent application filed by a company designated as companies with outstanding

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employee invention compensation system under Article 11(2) of the Invention Promotion Act. (Article 9(5-2) of the Enforcement Decree of the Patent Act)

(2) Examination Guidelines

① Where an application is jointly filed by more than two applicants and at least one of the applicants is designated as company with outstanding employee invention compensation system, a request for preferential examination shall be accepted.

② Only where the title of the company designated as company with outstanding employee invention compensation system and the name of the applicant are identical, a request for preferential examination shall be accepted. Where the title of the company and the name of the applicant are different, the examiner shall handle the application according to 'Applications related to Companies Certified as Venture Businesses'.

③ The company shall constitute the company with outstanding employee invention compensation system at least at one of the points of time of application date, date of request for preferential examination or date of determination on preferential examination.

④ The evidential document of company with outstanding employee invention compensation system shall be the original copy of 「Certificate of Company with Outstanding Employee Invention Compensation System」 issued by the Korean Intellectual Property Office. However, where a copy is deemed to be identical with the original copy, the copy can be exceptionally accepted.

⑤ Where, despite the fact that the business type of company with outstanding employee invention compensation system is not relevant to the claimed invention, a request for preferential examination is made, the invention shall not be deemed to be subject for preferential examination. Where the relevance is not recognized, the examiner shall deliver a notice to complement the request for preferential examination. Where the relevancy is explained, the examiner shall accept the request for preferential examination.
⑥ The relevance between the business type of company with outstanding employee invention compensation system and the claimed invention shall be determined based on the

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content of the evidential document (business registration certificate, etc.) of the written explanation of request for preferential examination attached by the applicant. Where the relevance on the business type cannot be identified or accepted in determining whether to conduct preferential examination, the examiner shall make a correction order.

4.9 Applications related to National New Technology Development Support Project

(1) Subject

Applications related to the outcomes of national new technology development support project and filed based on the outcomes of technology development according to the business contract signed between the head of relevant central administrative institutions and one of the following institutions mainly in charge of the project or the participating institutions

① Projects for industrial technological innovation under Article 2 of the Industrial Technology Innovation Promotion Act
② Technological innovation projects under Article 10(1) of the Act on the Promotion of Technology Innovation
③ Energy Technology Development Activities under Article 12 of the Energy Act
④ New and renewable energy development projects under Article 11 of the Act on the Promotion of the Development, Use and Diffusion of New and Renewable Energy
⑤ Industrial convergence projects under Article 24 of the Industrial Convergence Promotion Act
⑥ Information and communications technology development projects under Article 8 of the Information and Communications Industry Promotion Act
⑦ National research and development projects under Article 11 of the Framework Act on Science and Technology
⑧ Sole-proprietor creative business under Article 11(1) of the Act on the Fostering of Sole-Proprietor Creative Business
⑨ Other national new technology development support projects

Determination on other national new technology development support projects can be determined by each project. However, whether the project is financed by the government related to technology development shall be determined. If necessary, the opinion of the

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division in charge of the concerned project can be consulted.

(2) Examination Guidelines

To be recognized as applications related to the outcomes of national new technology development support projects, the applications shall be related to the direct outcome of the new technology development support projects. Even if it is hard to determine that the applications are directly related to national new technology development support projects, but where there are documents proving that the application is confirmed to be related to the outcomes of the new technology development support projects by the institution in charge of the projects or the participating institutions, the application shall be recognized to be eligible for preferential examination.

4.10 Application related to Outcome of National Quality Authentication Projects

(1) Subject

Applications related to the outcome of national quality authentication projects and corresponding to one of the followings:

① Applications related to products authenticated as new products under Article 16 of the Industrial Technology Innovation Promotion Act and Article 18 of the Enforcement Decree of the same act

② Applications related to technology certified as new technology under Article 6 of the Technology Development Promotion Act and Article 9 of the Enforcement Decree of the same act

③ Applications related to products certified as industrial convergence products under Article 13 of the Industrial Convergence Promotion Act and Article 14 of the Enforcement Decree of the same act

(2) Examination Guidelines

① New Product Authentication Project : NeP (New Excellent Product) Mark

This project authenticates products with great economic and technological impacts and high performance and quality among the commercialized products with application of the first local technology or similar substitute technology as new products. The project features written new product certification issued by the Minister of Knowledge Economy through

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examination and evaluation based on the new product authentication standards of the Korean Agency for Technology and Standards.

② New Technology Authentication Project : NeT (New Excellent Technology) Mark

The project authenticates technology that can enhance the performance of existing products and process technology which can significantly improve the productivity or quality of existing products as new technology. Such technology include completed technology whose quantitative evaluation indexes are secured by testing or operating the prototypes produced based on theoretical technology and that can be commercialized within two years. This project features new technology certification issued by the Minister of Knowledge Economy through new technology examination and evaluation of the President of the Korea Industrial Technology Association.

③ Industrial Convergence Product Authentication Project

This project authenticates products with great economic and technological impacts and high performance and quality manufactured based on the outcome of industrial convergence(activities that innovate existing industries or create new industries with social market value through the creative combination and complication between industries, between industry and technology, between technologies) as industrial convergence products. This project features the industrial convergence project certification issued by the head of the concerned central administrative institutions(central administrative institutions which govern approval, permission, certification, verification and license under the statutes related to industrial convergence products) through authentication examination.

④ Where it is unclear to determine that the claimed invention is the direct outcome of the national quality certification project, an examiner may order a requester of preferential examination to verify the correlation. However, where the claimed invention is likely to be related to the direct outcome and there exist no other special grounds, an examiner may recognize the claimed invention to be eligible for preferential examination without any other investigation.

4.11 Applications forming Basis of Priority Claim under Treaty

(1) Subject

Applications which forms the basis of priority claim under the Treaty and whose patent-related procedure is being conducted before foreign patent offices based on the priority

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claim made on the concerned patent application

(2) Examination Guidelines

1) Where an application is filed to the Korean Intellectual Property Office and then is filed to a foreign patent office claiming priority, it shall be checked whether the application filed to the foreign patent office claims priority under the Paris Convention based on the application filed in Korea.

2) Where an application is filed to the Korean Intellectual Property Office and then a PCT application is filed based on the application claiming priority, a request for preferential examination shall be recognized except for self-designation application. In such a case, priority claim can be determined based on the PCT Form PCT/RO/105.

3) Where a converted application, divisional application or application with domestic priority is filed based on the application with priority claim under the Treaty, a request for preferential examination shall not be recognized since the converted application, divisional application or the application with domestic priority is not the application which forms the basis of priority claim under the Treaty. For example, when Application A is filed in Korea, Application B is filed in the United States claiming priority under the Treaty and then Application C with domestic priority is filed based on Application A, a request for preferential examination shall not be recognized since Application C is not the application which forms the basis of priority claim under the Treaty.

4) Where a request for preferential examination is filed on an application under PCT self-designation

Where a PCT application is filed claiming priority based on an application filed in the Republic of Korea and it has indicated the Republic of Korea as a designated state, which is so called an application under PCT self-designation, when it comes to an application claiming domestic priority an early application filed in the Republic of Korean and a PCT application can be deemed an early application and a subsequent application respectively. Then, the early application in the Republic of Korea is deemed to have been withdrawn when one year and three months has elapsed from the date of filing the application. Therefore, where a request for preferential examination has been made on the early

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application, the request shall not be recognized.

Where a request for preferential examination on an early application is filed, an examiner shall order to correct the request by indicating the ground for rejecting the request for preferential examination within the designated period. Where an application under self-designation is not withdrawn within the designated period, an examiner shall dismiss the request for rejection.

4.12 Application on the claimed invention being worked or to be worked by applicant

(1) Subject
An application on the claimed invention being worked or to be worked by an applicant (including an application filed by a business certified as components and materials technology developer under Article 6 of the Enforcement Rule of the Act on Special Measures for the Promotion of Specialized Enterprises, etc. for Component and Material)

① Definition of Working as Business
a. The term "working" is identical with "working" from the working by a person other than an applicant.
b. "Working as business" refers to "working as running business". In general, the personal/domestic working, the working for educational purposes, the one-off working for experiments shall not constitute the working as business. Even for the one-time working for non profit purposes, if the invention is being worked as business for the public interest, it shall constitute as the working as business.

② Subject of Working
An applicant shall work or be working the invention. However, where an applicant is a head of the company working the invention or an applicant is different from the person working the invention, the company which was approved to work the invention or the person who is working the invention can become the subject of working the invention.

③ Determination on Working as Business or Preparing to Work as Business
A requester of preferential examination shall explain that the claimed invention is being

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worked (or being prepared to be worked) and the working of the invention is carried out as business in a written explanation of preferential examination and submit the evidential documents for both explanations.
An examiner shall conduct preferential examination on the claimed invention where the submitted explanation on preferential examination and evidential documents can confirm that the invention is being worked or being prepared to be worked as well as the claimed invention is being worked as business.

a. Determination on Working (or Preparation for Working) of Invention
An examiner shall recognize the working (or preparing for working) of the claimed invention where he/she can confirm that the claimed invention is being worked based on evidential documents such as the written explanation of preferential examination, photos of prototypes, catalogs, product manuals and samples.

b. Determination on Working (or Preparation for Working) of Invention as Business
An examiner shall recognize the working(or preparing for working) of the claimed invention where he/she can confirm that the claimed invention is being worked as business based on the written explanation of preferential examination and the evidential documents. Evidential documents of the working of the invention as business are the followings:

Example) Transaction Sheet (including that the product on sale is the claimed invention)
Delivery Confirmation
Purchase Contract (when an application sells his/her product), Product Supply Agreement
Plant Registration Certificate
Investment Performance from Enterprise Start-Up Investment Company/New Technology Project Investment Cooperative
Loan Issuance from Bank, etc.
Contract related to Working of Claimed Invention (Indication of Subject, Period, Place, and Condition of Working)
Lease-Rental Agreement
Evidential Document on Application of Component Material Technology Development Business
Other Evidential Document on Working of Claimed Invention as Business

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④ Determination on Identicalness between Invention Being Worked (or Prepared to be Worked) and Claimed Invention

As for a request for preferential examination based on the working (or preparation to be worked) of the invention, the invention being worked and the claimed invention shall be identical. A requester of preferential examination shall prove the identicalness of the two inventions.

An examiner shall determine the identicalness of the two inventions based on article, photographs or any other evidential documents submitted by a requester of preferential examination as well as a written explanation of preferential examination. When the identicalness cannot be confirmed, an examiner shall order to correct a request for preferential examination.

⑤ Recognition of Application filed by Company confirmed as Component Material Technology Development Business

a. A request for preferential examination on application filed by a company confirmed as a component & material technology development business under Article 6 of the Enforcement Rule of the Act on Special Measure for the Promotion of Specialized Enterprises, etc. for Components and Materials shall be accepted as the invention being worked or prepared to be worked as business without submission of the above-mentioned evidential documents as the claimed invention being worked or prepared to be worked.
b. The correlation between the business type of the concerned component & material technology development business and the claimed invention shall be determined according to the explanation that the requester of preferential examination made based on the written explanation of preferential examination and the evidential documents (business registration certificate, etc.). If necessary, the relevant business type of the confirmed business and the contents of the claimed invention shall be compared at the website of information on specialized components & materials companies operated by Korea Materials and Components Industry Agency (http://company.kmac.or.kr/)
c. Where an application is jointly filed and one of the applicants is a component & material

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technology development business, the request for preferential examination on the application shall be accepted. However, the request for preferential examination shall be accepted only when the names of the company confirmed as component & material technology development business and the name of the applicant. (4.6. Applications related to Venture Company shall apply *mutatis mutandis* when the names of the company and the applicant are different)

d. At one point among the date of filing a patent application, the date of request for preferential examination or the date of determination on preferential examination, an application shall be a component & material technology development business.

e. Evidential documents of component & material technology development business shall be the original copy of the confirmation of component & material technology development business. Where a copy of the confirmation of component & material technology development business is deeded to be identical with the original copy, the copy shall be accepted.

4.13 Application directly related to Electronic Commerce

(1) Subject

Applications shall be related to electronic commerce which promotes electronic transactions Article 2 of under the Framework Act on Electronic Commerce and the applications directly related to electronic commerce shall be the followings:

① Patent application related to method of electronic transaction

-Patent application related to transaction methods on technology realized for any transactions on goods or service over the network, such as auction, reverse auction, advertisement, education, etc.

② Patent application related to electronic money, payment technology for electronic transaction

-Patent application related to electronic money such as IC Card Type electronic money, Network-based electronic Money, cyber coin and payment technology using electronic money, online payment method using bank account transactions, payment method using credit cards, etc.

③ Patent application related to security or verification technology for electronic transactions

-Patent application related to security or verification technology such as technology of

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blocking access over the network, transaction verification technology, electronic signature or smart cards

④ Other patent application recognized for necessity of preferential examination for promotion of electronic transaction

-Patent application on technology recognized to be crucial for the promotion of electronic transaction such as technology developed by the government or government-funded research centers for the active promotion of electronic trade and technological development or technology developed on government funding

(2) Examination Guidelines

Applications shall be related to "electronic transaction".

Applications shall be related to electronic transaction under Article 2 of the Framework Act on Electronic Commerce as in the followings:

1. The term "electronic document" means any information prepared, transmitted, received or stored in the electronic form by the information processing system.

5. The term "electronic commerce" means any transaction of which the whole or party of good or service is made through electronic documents in transacting goods or service.

4.14 Patent Application agreed for Preferential examination between KIPO Commissioner and Commissioner of Foreign Patent Office

4.14.1 Subject

Patent Applications that the Commissioner of the Korean Intellectual Property Office has agreed for preferential examination with the commissioner of a foreign patent office and that are the followings(applications of utility model registration shall not be eligible):

① Patent applications claiming priority under the treaty filed in the Republic of Korea based on an initial patent application (an international patent application under the Patent Cooperation Treaty (hereinafter referred to as 'international application') and including international applications without any priority claim entering the national phase of the counterpart country) filed in a counterpart country (Japan, the U.S., England, Canada, Russia, Finland, Germany, Spain, China, Mexico, Singapore, Hungary, Austria) or patent applications without any priority claim which entered the national phases of both the Republic of Korea

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and the counterpart) shall be eligible and such patent applications are as follows:

a. Patent application claiming priority under the Paris Convention (hereinafter referred to as 'priority claim under the treaty') based on the patent application filed validly in the counterpart country (including an application entering the national phase of an international application)

b. International patent application without any priority claim entering the national phase and designating the Korean Intellectual Property Office and a counterpart patent office as designated offices

c. Patent application claiming priority under the treaty since it was filed on an international application without any priority claim

d. Patent application claiming multiple priorities since the priority claim under the treaty was filed on multiple patent application of a counterparty country or multiple international applications

e. Divisional application or application with domestic priority of Korean patent application which corresponds to the above-mentioned a, b, c and d

② An international application whose international search or international preliminary examination have been conducted in the concerned countries (the Republic of Korea, the United States of America, China, Japan and Austria) and which has entered the national phase of the Republic of Korea or a patent application claiming priority under the Treaty to the Republic of Korea based on international patent application whose international search or international preliminary examination have been conducted in the concerned countries shall be eligible and the eligible applications are the followings:

a. International patent application whose international search or international preliminary examination has been conducted in the concerned countries and which has entered the national phase of the Republic of Korea

b. Patent application claiming priority under the Treaty to the Republic of Korea based on the international application whose international search or international preliminary examination have been conducted in the concerned countries or forming the basis of priority claim of the international application whose international search or international preliminary examination has been conducted in the concerned countries

c. Patent application with multiple priority claims based on multiple international patent applications whose international search or international preliminary examination has been

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conducted in the concerned countries as the basis of the priority claim under the Treaty
d. Divisional application or application with domestic priority of Korean patent application that corresponds to the above-mentioned a, b and c

4.14.2 Request for preferential examination in presence of prior art search report secured from a foreign patent office or intergovernmental organization due to the relevance with the concerned patent application

It shall be eligible only when a counterpart is Japan and a requester of preferential examination shall submit the evidential documents corresponding to the following (1), (2), and (3).

(1) A copy of the prior art search report secured from a foreign patent office or intergovernmental organization
Prior art search reports drawn up by a foreign patent office or an intergovernmental organization (e.g., prior art cited on a written notification of opinion submission of a foreign patent office, PCT international search report, prior art search report of the European Patent Office) as well as prior art search reports made through commission of a foreign patent office (e.g., reports that the Japanese Patent Office commissioned an external organization for) shall be included.
※ A prior art search report drawn up by a requester of preferential examination on his/her own or by an external organization through the commissioning work shall not be recognized as a prior art search report. Therefore, where such prior art search reports are submitted, an examiner shall order to correct the request for preferential examination.
※ Even a prior art search report made by an external prior art search organization upon the request of the Korean Intellectual Property Office shall not be recognized to have been secured from a foreign patent office or an intergovernmental organization.

(2) A copy of prior art literature indicated in the above-mentioned prior art search report
※ Where a prior art cited in a prior art search report is a patent literature, it does not need to be submitted since a patent examiner can easily secure the patent literature. As for a non-patent literature, however, a requester of preferential examination is obliged to submit the concerned non-patent literature and when not submitted, an examiner can order to

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submit the concerned non-patent literature.

(3) Detailed comparative explanation between the patented invention and the invention indicated in the above-mentioned prior art literature
A requester of preferential examination shall examine the comparisons of the claimed invention of the concerned application and the invention indicated in a prior art literature and write the differences of the two inventions and the possible technical effects of the claimed invention in detail but concisely. Where a certain part of the literature is cited, the explanation shall specify the cited part.
Where the content in a comparative explanation is deemed to be insufficient, an examiner can order to correct the comparative explanation.

4.14.3 Request for Preferential Examination under Patent Prosecution Highway

The Patent Prosecution Highway refers to a system under which if the office of first filing(OFF) has assessed the patentability of a patent application, the office of second filing(OSF) ensures that the applicant is entitled to benefit from an accelerated examination for the corresponding application as well as the office of second filing can utilize the prior art search result and the examination results of the office of first filing.

The Republic of Korea has signed the PPH with 14 countries (Japan, the United States of America, Denmark, England, Canada, Russia, Finland, Germany, Spain, China, Mexico, Singapore, Hungary and Austria). The Korea-Japan PPH shall apply to a request for preferential examination filed after April 1, 2007; the Korea-US PPH after January 28, 2008; the Korea-Denmark PPH after March 1, 2009; the Korea-England PPH and the Korea-Canada PPH all after October 1, 2009; the Korea-Russia PPH after November 2, 2009; the Korea-Finland PPH after January 14 , 2010; the Korea-Germany PPH after July 1, 2010; the Korea-Spain PPH after July 1, 2011, the Korea-China PPH after March 1, 2012, the Korea-Mexico PPH after July 1, 2012, the Korea-Singapore PPH and the Korea-Hungary PPH after January 1, 2013 and the Korea-Austria PPH after March 1, 2013.

※ Where an application claiming priority under the treaty is filed in the Republic of Korea based on an initial application filed in a first country and an application claiming priority

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was filed in another country other than the country of the first filing and the Republic of Korea based on the initial application filed in the first country, and then the examination result from the patent office of the third country says that the concerned application is patentable, the concerned application is not eligible for the PPH even though the first county and the third country are counterpart countries of the PPH program. The PPH request shall be recognized only when an application claiming priority filed in the Republic of Korea based on an initial application in a first country is deemed patentable in the office of first filing. However, under the Korea-England PPH, even when an application claiming priority filed in England and the Republic of Korea based on an application in another country other than England and the Republic of Korea is recognized to be patentable in England, the concerned application shall be eligible for the PPH between Korea and England.

(1) Patent Prosecution Highway Requirements

① A patent application filed in a counterpart country corresponding to the concerned patent application shall contain claims that the patent office of the counterpart country considers to be patentable

Claims that the patent office of the counterpart country considers to be patentable are as follows:

a. Claims deemed patentable in a written decision to grant a patent

b. In the absence of a written decision to grant a patent, claims deemed patentable in the most recently-delivered notification of opinion submission or decision to reject a patent

※ "A patent application' filed in a counterpart county corresponding to the concerned patent application" includes a patent application of a counterpart country which serves as the basis of the priority claim of the patent application filed in the Republic of Korea and another patent application filed in counterpart country clearly linked to a counterpart patent application which is the basis of priority claim (for example, a divisional application, an international patent application entering the national stage early).

※ Where a patent application of a counterpart country deemed patentable by a patent office of the counterpart country is not the application which serves as the basis of the priority claim, a requester of preferential examination shall explain the relation between 'the patent application of counterpart country with patentable claims' and 'the patent application which serves as the basis of the priority claim filed in the Republic of Korea' in a written explanation of the request for preferential examination.

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② All claims of the concerned patent application shall correspond to the claims deemed patentable in a patent application filed in a counterpart country.
This means that all the claims of the concerned patent application are substantially identical with the claims of the patent application filed in a counterpart country recognized as patentable and it also includes where the concerned claims deemed patentable are specified by adding special items.
Where there are merely differences in translation or claim types (for example, independent claims, dependent claims), the claims of the concerned application and the foreign counterpart application shall be deemed substantially the same.

③ Evidential documents necessary for request for preferential examination under PPH
A requester of preferential examination shall file a written examination of request for preferential examination in reference to Annexed Form no. 3 of the Directive on Request for Preferential Examination on Patent · Utility Model and submit the following evidential documents.
a. 『A copy of the written scope of claim including claims that the counterpart patent office recognizes as patentable』 (referring to the claims at the examination-related notification most recently filed by the counterpart patent office)
b. 『A copy of an examination-related notification on the counterpart patent application filed by the counterpart patent office』
※ Where an examiner can secure the above-mentioned evidential documents ①, ② through the information communication network[example: AIPN(Japan), public PAIR(United State), PVS online (Denmark), etc.], such evidential documents do not need to be submitted.
※ Where the evidential documents ①, ② are written in a language other than Korean or English, their translation shall be submitted together. Where an examiner can fine the English or Korean translation through the information communication network, the translation do not need to be submitted.
c. A copy of prior arts cited in an examination-related notification (except for the absence of cited prior arts)
※ Where prior arts cited in an examination-related notification are patent literature, an examiner ay easily secure such prior art and they do not need to be submitted. However, where prior arts are non-patent literatures, a requester for preferential examination is

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obliged to submit the concerned non-patent literatures. If not submitted, an examiner shall order a requester to submit the concerned non-patent applications.
d. Contrastive Explanation on 『Each claim of a patent application』 and 『Claims deemed patentable』
Grounds for correspondence of each claim shall be indicated in a written contrastive relationship explanation. For example, when claims are literally translated, the identicalness of the claims shall be explained. Also, where mere differences in translation exist, correspondence of each claim despite such differences shall be indicated in a written contrastive explanation.
Unlike any other evidential documents, a contrastive explanation must be submitted in any case.

4.14.4 Request for Preferential Examination under PCT-PPH

The PCT-PPH, Patent Cooperation Treaty-Patent Prosecution Highway, refers to a system where a request for preferential examination is filed for a patent application comprising the claims substantially identical with the claims recognized to involve novelty, inventive step, and industrial applicability in an international search or international preliminary examination on an international application under the Patent Cooperation Treaty.

PCT-PPH counterparts of the Republic of Korea include the United States of America, China, Japan and Austria. The Korea-US PCT-PPH shall apply to requests for preferential examination filed after July 1, 2011 and the Korea-China PCT-PPH after March 1, 2012, the Korea-Japan PCT-PPH after July 1, 2012, and the Korea-Austria PCT-PPH after March 1, 2013, respectively.

(1) Requirements of PCT-PPH
① An international search or international preliminary examination (a written opinion from an international search authority, a written opinion or an international preliminary examination report from an international preliminary examination authority) on the concerned patent application conducted in the member countries shall include claims deemed to involve novelty, an inventive step and industrial applicability.
※ Where the concerned patent application is an international application, 'an international

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search or international preliminary examination on the concerned patent application conducted by the member countries' shall mean an international search or international preliminary examination on the international patent application. Or 'an international search or international preliminary examination on the concerned patent application conducted by the member countries' can refer to an international search or international preliminary examination on the international application where the concerned patent application claims the priority under the Treaty based on an international application.

※ Where an international search or international preliminary examination is not conducted on the concerned patent application (that is, in the international phase of the concerned patent application), a requester of preferential examination shall explain the correlation between the concerned patent application and 'the international patent application on which an international search or international preliminary examination is conducted' in a written explanation on request for preferential examination.

② All the claims of the concerned patent application shall 'correspond to' the claims deemed to involve novelty, an inventive step and industrial availability in an international search or international preliminary examination conducted by the member countries.

The term 'correspond to' refers to the cases where both claims are substantially identical and where the claims deemed to involve novelty, an inventive step and industrial applicability are limited with the addition of specified subject matter.

Where there are mere differences in translations or types of claims (e.g., independent claims, dependent claims), the two claims shall be deemed to be identical.

Whether claims correspond to each other shall be determined based on a claims correspondence table that a requester of preferential examination submits with a written explanation of request for preferential examination.

③ Evidential Documents necessary for Request for Preferential Examination under PCT-PPH

A requester of preferential examination shall fill out a written explanation of request for preferential examination based on Annexed Form no. 6 of the Directive on Request for Preferential Examination on Patent Application · Utility Model Registration and submit the following evidential documents:

a. 『A copy of patent claims deemed to involve novelty, inventive step and industrial applicability in an international search or international preliminary examination』 (The

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concerned claims refer to those subject to a written opinion of an international search authority, a written opinion of an international preliminary examination authority or an international preliminary examination report all notified most recently.)

b. A copy of a written opinion of an international search authority, a written opinion of an international preliminary examination authority or an international preliminary examination report all related to the concerned patent application

※ Where an examiner can easily secure the evidential documents a, b through the information communication network (for example, Patentscope (www.wipo.int/patentscope/en/dbsearch/)).

※ Where the evidential documents a, b are written in another language beside Korean or English, its translation shall be submitted as well. Where an examiner can secure its Korean or English translation through the information communication network, its translation does not need to be submitted.

c. 『A copy of prior art documents cited in a written opinion of an international search authority, a written opinion of an international preliminary examination authority or an international preliminary examination report』(except for where no cited prior art literature exists)

※ Where the cited prior art is a patent literature, it does not need to be submitted since an examiner can easily secure the document. However, if it is a non-patent literature, a requester of preferential examination is obliged to submit the concerned non-patent document and if not submitted, an examiner may order the requester to submit the concerned non-patent literature.

d. 『Contrastive Explanation』 of 『All claims of the Patent Application』 and 『Claims recognized to involve Novelty, Inventive Step and Industrial Applicability in International Search or International Preliminary Examination』

Grounds for correspondence of each claim shall be indicated in a contrastive explanation. For example, when claims are literally translated, the identicalness of the claims shall be explained. Also, where mere differences in translation exist, correspondence of each claim despite such differences shall be indicated in a written contrastive explanation.

Unlike any other evidential documents, a contrastive explanation must be submitted in any case.

e. Where 'opinions on an international application' (opinions related to the case where an international application is ambiguous or its claims are not well clarified in a specification)

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are indicated in Box No. Ⅷ of a written opinion of an international search authority, a written opinion of an international preliminary search authority, or an international preliminary examination report related to the concerned patent application, the intention that all the claims of the concerned patent application are not affected by 'opinions on an international application' shall be explained.
※ Explanations on the intention that all the claims of the concerned patent application are not affected by 'opinions on an international application' may include ⅰ) responses to 'opinions on an international application' ⅱ) claims that irregularities are addressed through amendments. Where such explanations are not indicated, an examiner may order to amend the application.

4.14.5 Instructions on determination/redetermination of preferential examination

When determining preferential examination on a patent application agreed for preferential examination by the Commissioner of the Korean Intellectual Property Office and the commissioner of a foreign patent office, the result of the determination shall not be notified to a requester of preferential examination. However, where a request for preferential examination is determined to be rejected, it shall be notified to a requester of preferential examination, just like any other requests for preferential examination.

A written determination on preferential examination is not delivered to a requester of preferential examination. Therefore, where an applicant amended a specification with claims not included in the contrastive explanation with the prior art literature; amended a specification with claims not substantially identical with the claims that a foreign patent recognizes to be patentable; or amended a specification with claims not substantially identical with the claims deemed to involve novelty, inventive step and industrial applicability in an international search or international preliminary examination before examination is initiated after the determination on preferential examination, the applicant may undertake the procedure for re-determining the preferential examination through the corresponding amendment. In such a case, an examiner may grant an amendment order by designating a period of up to one month by his discretion.

Where an applicant submits a contrastive explanation between all the claims including the

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ones that were amended when the claims was amended and the prior art cited in an examination-related notification of a foreign patent office; submits the contrastive explanation with the claims recognized to be patentable by a foreign patent office; or submit the contrastive explanation with the claims deemed to involve novelty, inventive step and industrial applicability in an international search or international preliminary examination, preferential examination shall be conducted without undertaking the procedure of re-determining preferential examination.

4.15 Application of utility model registration requested for examination upon filing and then requested for preferential examination within two months from the filing

(1) Subject

Since an application of utility model registration requested for examination upon filing and then requested for preferential examination within two months from the filing date of the application, a patent application shall not be eligible. Additional evidential documents do not need to be submitted.

(2) Basic Requirements

① The term of the right of a utility model registration lasts for 10 years, relatively shorter than that of a patent right (for 20 years), most of applications of utility model registration are filed by individual applicants and technologies with shorter life-cycles are filed for utility models. Considering all, a utility model is eligible for preferential examination once it is requested for examination upon filing the application of utility model and requested for preferential examination within two months from the filing date.

② A utility model application divided or converted from the earlier application cannot hold the retrospective filing date of the earlier application and a divisional or converted utility model application cannot be requested for preferential examination. Therefore, such applications are not eligible for preferential examination based on these requirements.

4.16 Patent application directly related to any specialization project under Article 36-8 of『Act on Special Cases Concerning the Regulation of the Special Economic Zones for Specialized Regional Development』

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(1) Subject

A patent application directly related to any specialization project shall be eligible. Since only patent applications are eligible, utility model applications shall not be filed for preferential examination under the act.

(2) Basic Requirements

① Where an application is jointly filed, one of the applicants shall be a person recognized by the heads of appropriate central administrative agencies to a specialization project operator or to be participating to any specialization project under the specialized regional development project in a special economic zone (hereinafter referred to as 'participant of specialization project').

② An applicant shall be designated as a specialization project operator or a participant of a specialization project at least on one of the dates among the date of filing an application, the date of request for preferential examination and the date of determination on preferential examination.

③ Determination on a specialization project operator can be found on an official gazette of the concerned central administrative agencies submitted by a requester of preferential examination. Once a person recognized by the heads of appropriate central administrative agencies to be a participant of any specialization project under the specialized regional development project in a special economic zone a participant of a specialization project submits the required documents for such recognition, he/she shall be recognized as a participant of specialization project.

④ Inventions disclosed in an application of request for preferential examination shall be directly related to the concerned specialization project. Correlation between the claimed invention and the specialization project shall be determined based on the written explanation of preferential examination and the official gazette of the regional administrative agency in charge of the concerned special economic zone. If necessary, the website of the Office of the Specialized Regional Economic Development operated by the Ministry of Knowledge Economy (http://www.mke.go.kr/sezone/conduct/list.jsp) may be referred to for checking the content of the concerned specialization project and the ground for designation of the special economic zone, etc. Where the claimed invention is not recognized to be directly related to the concerned specialization project, an examiner may order to correct the application to verify the correlation. However, where the claimed inventions and the

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specialization project are likely to be directly related and there are no special grounds, an examiner may recognize the application to be eligible for preferential examination without any further investigations.

As of July 1, 2013, 34 special economic zones are designated in the Republic of Korea.

4.17 Patent application related to Research and Development of Medical Services within the relevant high-tech medical complex filed by any resident research and development institute of medical services under Article 26 of the Special Act on the Designation and Support of High-Tech Medical Complexes

(1) Subject
A patent application directly related to research and development of medical services shall be eligible. Only a patent application, not an application of utility model registration shall be the subject.

(2) Basic Requirements
① Where an application is jointly filed, at least one of the applicants shall be a resident research and development institute of medical services under the above-mentioned act.
② An applicant shall be designated as a resident research and development institute of medical services at least on one of the dates among the date of filing the application, the date of request for preferential examination or the date of determination on preferential examination.
③ Inventions disclosed in applications requested for preferential examination shall be directly related to research and development of the concerned medical service. Therefore, where the concerned invention is hard to be recognized to have a direct relation with research and development of medical services, an examiner may order to correct the application to verify the correlation. However, where the concerned invention is likely to be directly related to research and development of medical services and there are no particular grounds, an examiner may recognize the application to be eligible for preferential examination without any further investigation.

4.18 Patent application commissioned to specialized institution for prior art search

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(1) Subject

A requester of preferential examination shall request prior art search on the claimed invention to one of the specialized institutions (Korea Institute of Patent Information, WIPS Co., Ltd., IP Solutions) designated by the Commissioner of the Korean Intellectual Property Office (hereinafter referred to as 'specialized institution') under Article 58(1) of the Patent Act.

① Patent applications whose search results the concerned specialized institution is required to notify the Commissioner of the Korean Intellectual Property Office shall be eligible.

② The concerned shall submit Search results under the Annexed Form no. 4 of the Directive of Request for Preferential Examination on Patent/Utility Model to the Commissioner of the Korean Intellectual Property Office within one month after the request for preferential examination (as for super-accelerated examination, within 10 days).

※ Where the concerned specialized institution failed to submit a search report (for preferential examination) within one month from the date of request for preferential examination(as for super-accelerated examination, within 10 days), an examiner shall make a correction order. When the examiner in charge clicks 'the failure to submit the search result' or 'the necessity of correction to the search result' as the ground for correction order on the messages window which pops up after clicking the transmittal of a request for correction' on the website, the request for correction is sent not only to the requester of preferential examination, but also the concerned specialized institution.

(2) Basic Requirements

As for an application requested for preferential examination whose search report is submitted by a specialized institution, an examiner shall make a determination on preferential examination. Where the claims to be examination are identical with the claims in the prior art search report, a request for preferential examination shall be recognized. Where the specialized institution failed to meet the guideline to write the report below-mentioned search report (for preferential examination) and the report cannot be used for examination, an examiner shall make a correction order within the designated period. Where the search report is not corrected even after the correction order, the examiner shall reject the request for preferential examination.

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Meanwhile, a written explanation of request for preferential examination shall be attached to make a request for preferential examination. However, as for a request for preferential examination on the application whose prior art search is requested to a specialized institute, the application shall be marked as the application requested for prior art search. Then, if a written request for preferential examination including the information on the specialized institution and the date of request for prior art search is submitted, the ground for request of preferential examination is clearly explained and, therefore, an additional written request for preferential examination does not need to be attached.

※ Where preferential examination is determined to be conducted on an original application based on the submitted prior art search reports by a specialized institution and all the claims of a divisional application in the search report of the original application are already examined, a request for preferential examination under Article 4(4) of the directive related to divisional applications can be filed without an additional request for prior art search since the prior art search on the divisional application is deemed to have been requested.

In such a case, where an applicant submits a request for preferential examination with the contrastive explanation indicating that all the claims of the divisional application are identical with the claims of the original application (before division) as well as a written explanation that the prior art search results on the claims of the divisional application are included in the prior art search report of the original application drawn up by the specialized institution, an examiner shall make a determination on preferential examination deeming that the prior art search report on the divisional application is already submitted. Where an examiner considers that the search results on all the claims of the divisional application are not indicated in the prior art search report on the original application by the specialized institution, the examiner shall order to correct the prior art search report on the ground for deficiency. Where deficiencies are not addressed despite the correction order, an examiner shall make a decision to reject a request for preferential examination. Where deficiencies are addressed after the correction order by submitting additional prior art search report of the specialized institution, etc., the examiner shall make a decision on preferential examination.

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(3) Instructions on Drawing Prior Art Search Report (for Preferential Examination)

① Number of prior art literature to be indicated in the search report

In principle, more than five prior art documents shall be included. However, where no close prior art does not exist when compared with the claims invention or where no relevant prior art does not exist since it is a new technical field, such grounds for the lack of the required number of prior art documents shall be stated and the indication of less than four documents shall be allowed (Paragraph (2)(c) of the instruction on drawing prior art search report shall be referred).

② Indication of 'Search Result' in the search report

Among the problems to be solved in the prior art literature which have been searched in comparison with all of the claims and the means for solving the problems (the concerned pages and lines shall be indicated), the contents related to the claimed invention shall be written consecutively.

The search results shall be indicated by searched prior art literature and the claims related to the claimed invention must be indicated in the box for 'Relevant Claims' in the search report (Paragraph (2)(c) of the instruction on drawing prior art search report shall be referred).

③ Indication of 'Contrastive Explanation' in the search report

a. Similarities and differences with the closest prior art literature shall be separately described claim-by-claim in detail. However, the contents in the prior art literature shall be indicated in detail (the concerned pages and lines, etc.) (Paragraph (2)(d) of the instruction on drawing prior art search report shall be referred).

b. The closest prior art literature to each claim shall be chosen and similarities and differences shall be explained. Each claim does not need to be compared with all prior art documents indicated in the 'search results'.

c. In principle, contrastive explanation shall be indicated to all the claims. However, as for independent claims that only differ in the dependent claims and the categories, more than two claims can be indicated together for the contrastive explanation (Paragraph (2)(d) of the Instruction on drawing prior art search report shall be referred).

d. Where novelty and an inventive step are recognized in the independent claims (where the relevance is marked as 'A'), a brief contrastive explanation on the dependent claims may be

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indicated.

④ Other relevant cases

a. Where a specification is amended after a request for preferential examination is filed

Where a prior art search is commissioned to a specialized institution; a request for preferential examination is filed after the amendment to the claims; and then the prior art search is conducted by the specialized institution based on the pre-amended claims, the specification to be searched and the filed specification are different based on the time of request for preferential examination. Therefore, where a search report on the specification is re-submitted at the time of filing a request for preferential examination after the correction order, an examiner shall make a determination on preferential examination.

b. Where a ground for request of preferential examination is changed due to the prior art search by specialized institution after the correction order of preferential examination

Since the ground for request for preferential examination can be changed while submitting the corrected documents, an examiner shall make a decision on preferential examination based on the legitimacy of the ground for change. However, since the ground for request of preferential examination is changed due to the prior art search by the specialized institution, an applicant shall indicate the date of request for prior art search and the name of the specialized institution in the corrected document and submit them. Then, the examiner in charge shall click 'Designation of Search Institution' on the window of 'Determination of Preferential Examination' so that the concerned prior art search report can be uploaded onto the system (Even when the written request for preferential examination contains the ground for request of preferential examination due to the prior art search by the specialized institution, but the written request for preferential examination does not specify the date of request for prior art search and the name of the specialized institution, an examiner shall undertake the same procedure and designate the search institution).

Meanwhile, in principle, a prior art search report for preferential examination shall be submitted within one month from the date of the request for preferential examination (as for super-accelerated examination, within 10 days). Therefore, if the prior art search report is not submitted until the examiner makes a decision on preferential examination after the period for correction of the search report has elapsed, the examiner shall make a correction order once again.

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