

발 간 등 록 번 호

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Patent Examination Guidelines

December 2017



Korean Intellectual Property Office

(Note) This English edition of the Korean Intellectual Property Office's Patent Examination Guidelines is based on the Korean Patent Examination Guidelines published in March, 2017. If there is any inconsistency or ambiguity between the Korean edition and the English edition, the Korean edition shall prevail.

Foreword to the English Edition

We stand on the brink of a major transformation brought by the 4th Industrial Revolution. It is essential to create and obtain strong intellectual property rights (IPRs) that bring about innovation enhancing the global competitiveness of Korean industry, as considering that the 4th Industrial Revolution should be seen as an opportunity rather than a crisis.

The Korean Intellectual Property Office (KIPO) aims for high quality patent examination, moving beyond fast and efficient examination. During the past years, KIPO has made many efforts to help inventors to create strong and innovative patent rights that attract foreign investors as well as domestic investors trying to expand their businesses overseas.

“Patent Examination Guidelines”, as a compass for patent examination, guides patent examiners to conduct more accurate, consistent and unbiased examination. The Guidelines also allows patent applicants to work out an appropriate strategy for filing an application and preparing amendments in response to office actions.

We are in an environment where large shares of patent applications are now being filed by foreigners and international harmonization of the patent system and cooperative search & examination become more important. Thus, KIPO publishes an English edition of the Patent Examination Guidelines for the first time in order to have foreigners gain better understanding of the patent system of Korea.

The English edition of the Guidelines reflects recent revisions of the Patent Act of Korea (effective on March 2017), such as positive examination (Part VIII), examination by technology (Part IX), patent classification, patent application filed in a language other than Korean, etc.

Legal experts were also involved in the editing process to improve accuracy and quality of the English edition of the Guidelines.

KIPO hopes that this English edition can contribute to raising awareness of the Korean patent system beyond our borders and eventually be recognized as a world-class patent examination guidelines.

Lastly, I would like to express my appreciation to the KIPO staff, especially to patent examiners and members of the Patent System Administration Division, for their work of translating, reviewing, revising and finally publishing the English edition of the Patent Examination Guidelines.

December 2017

A handwritten signature in black ink, appearing to read "Sungyunmo". The signature is written in a cursive, flowing style.

Sung, Yunmo

KIPO Commissioner

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PART I. General Rules

Chapter 1. Capacity

1. Relevant Provisions

Article 3 (Legal Capacity of Minors, etc.)

(1) No minor person under limited guardianship, nor person under adult guardianship shall be able to file an application or a request or conduct any other proceedings relating to a patent (hereinafter referred to as "patent-related proceedings") unless represented by his/her legal representative: provided, however, that the foregoing shall not apply where a minor or a person under limited guardianship is able to engage in a legal act independently.

(2) The legal representative referred to in paragraph (1) may, without consent of a supervisor of a guardian, conduct proceedings relating to a trial or a retrial initiated by the other party or the opposition proceedings according to Article 132(2) (hereinafter referred to as "opposition proceedings").

Article 4 (Unincorporated Associations, etc.)

A representative or an administrator appointed by an unincorporated association or a foundation may become a petitioner requesting for examination of a patent application or a petitioner for opposition or a petitioner or a defendant for a trial or a retrial in the name of the unincorporated association or the foundation.

Article 5 (Patent Administrators for Overseas Residents)

(1) No person with no domicile or place of business in the Republic of Korea (hereinafter referred to as "overseas resident") shall be able to conduct any patent-related proceedings or file legal proceedings against a disposition made by an administrative authority under this Act or an order issued under this Act, unless he/she is represented by an agent with respect to his/her patent, who has a domicile or place of business in the Republic of Korea (hereinafter referred to as "patent administrator"), except where the overseas resident (or the corporate representative if the overseas resident is a corporation) sojourns in the Republic of Korea.

(2) A patent administrator shall represent the principal in all patent-related proceedings and legal proceedings filed with respect to a disposition made by an administrative authority under this Act or an order issued under this Act, within the scope of authority empowered thereto.

Article 25 (Capacity of Foreigners to Hold Rights)

No overseas-resident foreigner shall enjoy a patent or any rights relating to a patent, except in any of the following cases:

1. Where the country to which a foreigner belongs allows nationals of the Republic of Korea to enjoy a patent or any rights relating to a patent under the same terms and conditions as those applicable to the nationals of the country;

2. Where the country to which a foreigner belongs allows nationals of the Republic of Korea to enjoy a patent or any rights relating to a patent under the same terms and conditions as those applicable to the nationals of the country, if the Republic of Korea allows the foreigner to enjoy a patent or any rights relating to a patent;

3. Where a foreigner is allowed to enjoy a patent or any rights relating to a patent under a treaty or any arrangement equivalent to a treaty (hereinafter referred to as "treaty").

2. Patent-related Proceedings

(1) A patent-related proceeding under the Patent Act, the Enforcement Decree of the Patent Act and the Enforcement Rules of the Patent Act refers to filing of an application or a request or any other proceedings relating to a patent, as defined in Article 3 of the Patent Act. The patent-related proceedings are the proceedings which are carried out by an applicant, petitioner, requestor or another party (hereinafter referred to as 'an applicant, etc.')

before the Commissioner of the Korean Intellectual Property Office, an examiner, the President of the Intellectual Property Trial and Appeal Board, a presiding administrative patent judge, or an administrative patent judge (hereinafter referred to as 'the Commissioner of the Korean Intellectual Property Office, etc.')

, including the proceedings ①~③.

① Filing of an application for a patent

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 Filing of a request/petition relating to a patent

A request for examination, a request for reexamination, petitions for trial (including petition for trial filed by an examiner), request for technical evaluation, and petition for retrial, etc.

③ Other proceedings relating to a patent

Proceedings carried out by an applicant, etc. before the Commissioner of the Korean Intellectual Property Office, etc. in conjunction with the abovementioned proceedings ① and ②, and other proceedings such as a request for accelerated examination and a request for deferral of examination

(2) A patent-related proceeding excludes the proceeding carried out 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, assigning patent classification, prior art search and substantive examination), the proceeding carried out by an applicant, etc. before a court (patent court), the proceeding for an administrative trial, ordinary complaints filed by the general public, the proceeding (warning) carried out by an applicant, etc. against a third party.

3. Incompetents

3.1 Purport of System

The Civil Act defines a minor, a person under limited guardianship, or a person under adult guardianship as a person without legal capacity or an incompetent. 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, persons under limited guardianship or person under adult guardianship from conducting a patent-related proceeding unless a legal representative performs a juristic action on behalf of them, for the protection of incompetents.

3.2 Legal 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 19 (minor), ② a person who lacks the capacity to manage affairs due to mental unsoundness resulted from a disease, disability, old age and other reasons and is adjudicated to be subject to limited guardianship by a court (a person under limited guardianship) and ③ a person who continuously lacks the capacity to manage affairs due to mental unsoundness resulted from a disease, disability, old age and other reasons and is adjudged to be subject to adult guardianship by a court (a person under adult guardianship).

(2) An incompetent can conduct a patent-related proceeding 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 a person under limited guardianship can perform a juristic act independently. It defines the case where a minor or a person under limited guardianship 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 representation (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 proceeding 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.

(Note) A minor cannot conduct a patent-related proceeding without the consent of a legal representative, even when the minor is represented by an agent.

3.3 Ratification of Proceedings Conducted by Incompetent

Article 7-2 of the Patent Act provides that patent-related proceedings, conducted by a person who lacks legal capacity, the power of legal representation or the authority necessary to carry out any such proceedings, shall have effect retroactively to the time when such proceedings are performed if the proceedings are ratified by the party involved when he/she has gained legal capacity to proceed. It means that proceedings conducted by an incompetent or a person without authority of legal representation take effect retroactively from the time of the initial act by ratification of a legitimate party involved in a later time.

Where it is revealed during the formality examination process that a patent-related proceeding is conducted 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 proceeding within the designated period, the concerned patent-related proceeding shall be invalidated.

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

4. Capacity to Hold Rights by Association such as Juristic Person

4.1 Capacity to hold rights by 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 holder of rights and obligations. Therefore, a juristic person designates a representative (for example, chief executive officer) and regards the acts of the representative as those of the juristic person.

Under the Patent Act, too, the scope of capacity to hold rights by a juristic person is the same as that under the Civil Act. Where a juristic person conducts a patent-related proceeding, the name and the business address of the juristic person shall be stated.

(2) Changing a company which is a juristic person to other types of company (from a limited liability company to a corporation or from an unlimited partnership to a limited partnership, etc.) does not constitute change of the holder of substantive rights and obligations. Therefore, it shall be deemed the change of name, rather than the change of the holder.

In such a case, a written notification of the change (correction) of applicant code information (Annexed Form No.5) shall be submitted to change the type of company 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.

4.2 Capacity to Hold Rights by Nation or Local Government

(1) A nation shall serve as the holder of rights because it is deemed a juristic person even though there are no explicit 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 holder of a patent-related right.

(Note) The Patent Act does not have provisions for a person who can become the applicant 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 capacity to hold rights 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 party of the trial and lawsuit. In this case, Kyungbook National University, 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 through 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.

(2) Article 3 of the Local Autonomy Act defines that a local government shall be deemed to be a juristic person. Therefore, local governments can become the holder of rights. Types of local governments include Metropolitan City, Megalopolis, Special Autonomic City, Do, Special Self-Governing Province, 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 Unincorporated Associations

Unincorporated associations 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 conduct a patent-related proceeding, such as filing a patent application, because of their lack of capacity to hold rights.

However, where an association or a foundation which is not a juristic person has a representative or an administrator, the association or the foundation can become the party to proceedings, which are limited to a request for examination of an application, a request for technical evaluation on utility models, an opposition, a trial, a retrial.

5. Legal Capacity of Overseas Residents

A person who has neither a domicile nor a place of business in the Republic of Korea (hereinafter referred to as overseas residents) shall not be able to carry out any patent-related proceedings unless through a patent administrator. Also, the person shall not be able to 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 a domicile or a place of business domestically, patent-related proceedings shall be carried out by his/her patent administrator.

Where an overseas resident conducts a patent-related proceeding 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 to Hold Rights

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 ③where 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 a domicile 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 a domicile nor a place of business in the Republic of Korea, his/her capacity to hold industrial property rights is not recognized. However, as an exception, where a treaty or an agreement has been made 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 domicile 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 firstly filed in one of the countries under the Treaty, the Paris Convention provides that even if the first 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 a first 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.

Chapter 2. Agents

1. Relevant Provisions

Article 6 (Scope of Power of Agent)

An agent who is empowered to conduct patent-related proceedings by a principal who has a domicile or place of business in the Republic of Korea may conduct any of the following acts, only if expressly authorized to do so. The foregoing shall also apply to a patent administrator:

1. To convert, abandon or withdraw a patent application;
2. To abandon a patent;
3. To withdraw an application for registering the extension of the term of a patent;
4. To withdraw a petition;
5. To withdraw a request;
6. To claim a priority under Article 55 (1) or withdraw a priority claim;
7. To file a petition for trial under Article 132-17;
8. To appoint a sub-agent

Article 7 (Proof of Power of Agent)

A person who conduct a patent-related proceeding as an agent (including a patent administrator; hereinafter the same shall apply) shall prove his/her power in writing.

Article 7-2 (Ratification of Acts of Persons Lacking Legal Capacity, etc.)

A patent-related proceeding conducted by a person who lacks legal capacity or authority for legal representation or by a person who is not authorized to conduct the patent-related proceeding, shall take effect retroactively back to the time such proceeding was carried out, if the proceeding is ratified by the person who has gained legal capacity or legal representative

Article 8 (Survival of Authority of Agent)

The authority granted to an agent by a principal who undertakes a patent-related proceeding shall survive even in any of the following events:

1. The principal's death or loss of legal capacity;
2. The corporate principal's dissolution in the course of a merger;
3. The termination of principal's duty as a trustee;
4. The legal representative's death or loss of legal capacity;
5. The termination of, or a change in, the legal representative's authority.

Article 9 (Independence of Representation)

If a principal who conducts a patent-related proceeding is represented by at least two agents, each of them shall independently represent the principal before the Commissioner of the Korean Intellectual Property Office or the President of the Korean Intellectual Property Trial and Appeal Board.

Article 10 (Orders to Appoint or Replace Agents, etc.)

(1) If the Commissioner of the Korean Intellectual Property Office or the presiding administrative patent judge appointed under Article 145 (1) (hereinafter referred to as "presiding judge") finds that a person conducting a patent-related proceeding is unable to properly perform the proceeding or to make a statement in oral hearings or is not fitted to perform the proceeding on any other grounds, he/she may issue an order to appoint an agent who shall conduct the proceeding on behalf of the person.

(2) If the Commissioner of the Korean Intellectual Property Office or a presiding judge finds that an agent who conduct a patent-related proceeding is unable to properly perform the proceeding or to make a statement in oral hearings or is not fitted to perform the proceeding on any other grounds, he/she may issue an order to replace the agent with another agent.

(3) In cases falling under paragraph (1) or (2), the Commissioner of the Korean Intellectual Property Office or a presiding judge may order a patent attorney to represent the principal.

(4) When the Commissioner of the Korean Intellectual Property Office or a presiding judge orders a person to appoint or replace his/her agent under paragraph (1) or (2), he/she may completely or partially invalidate the patent-related proceeding conducted by the person under paragraph (1) or the agent under paragraph (2) before the Commissioner of the Korean

Intellectual Property Office or the President of the Korean Intellectual Property Trial and Appeal Board.

Article 11 (Representation for Two or More Persons)

(1) Where two or more persons jointly perform a patent-related proceeding, each of them shall represent all, except for any of the following acts: Provided, That if they appoint their representative and notify the appointment to the Commissioner of the Korean Intellectual Property Office or the President of the Korean Intellectual Property Trial and Appeal Board, only the representative may represent all of them:

1. To convert, abandon, or withdraw a patent application;
2. To withdraw an application for registering the extension of the term of a patent;
3. To withdraw an petition;
4. To withdraw a request;
5. To claim a priority under Article 55 (1) or withdraw a priority claim;
6. To file a petition for trial under Article 132-17.

(2) When a notification is filed under the proviso to paragraph (1), the appointment of the representative shall be proved in writing.

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 proceeding. The provisions of the representation system under the Patent Act include Articles 3(Legal Capacity of Minors etc.), 5(Patent Administrator for Overseas residents), 6(Scope of Power of Agent), 7(Proof of Power of Agent), 8(Survival of Authority of Agent), 9(Independence of Representation), 10(Orders to Appoint or Replace Agents, etc.) and 12(Representation for Two or More Persons).

(2) Representatives include legal representatives and contractual representatives. Legal representatives refer to those provided under the legal provisions

regardless of the principal's own intention, whereas a contractual representative holds the power granted according to the principal's own intention, including an agent empowered as defined in Article 6 and a patent administrator as defined Article 5 and a designated representative (Article 5 of the Act on a Lawsuit in which a Country is a party).

(3) As for a contractual representative, regardless of whether he or she engages in representation as a business or not, unless he or she is a patent attorney, he or she is inadmissible to represent the patent applicant according to Article 2 of the Patent Attorney Act.

The examiner shall check through the Patent Net whether any person who is neither a patent attorney nor a legal representative is appointed as a representative to the patent applicant. The examiner is able to confirm that a patent attorney is appointed by checking whether the first figure of the number assigned to the representative is 9 or not (the assigned number to the patent attorney ex: 9-2015-123456-7). The assigned number to a legal representative generally does not start with 9, but it can be confirmed by a certified copy of resident registration or a family relation certificate, which is attached to the patent application.

Where any person who is neither a patent attorney nor a legal representative represents the patent applicant, the examiner shall propose to amend thereon. Where the deficiency is not remedied by amendment, any proceedings which are not conducted by a patent attorney shall be treated as invalid.

(4) A patent attorney shall engage in the business of acting as a representative on the affairs 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 proceedings as a patent attorney. There should be punishment if that person has conducted business as a patent attorney.

Also, a patent 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 proceeding, 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 deficiencies 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 proceeding under Article 46 of the Patent Act. If deficiencies are not addressed, the proceedings for appointing 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 an invalidation action, alleging Trademark A of Party A is similar to Trademark B of Party B. However, Attorney L's acting on behalf 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

(1) A legal representative refers to a representative empowered by the legal provisions, not by principal's intention. The legal representative system is designed to protect the rights of a person who is incapable of carrying out a lawsuit.

An authority of legal representation is not affected by the way the authority is granted whether it is granted by the recognition of law or by the declaration of the offices such as the court.

Meanwhile, a representative appointed by the legal order of the court(Article 144 of the Civil Procedure Act) or by the appointment (replacement) order of the Korean Intellectual Property Office(Article 10 of the Patent Act) is a contractual representative, rather than a legal representative, because the appointment of a representative was made by the principal itself.

(2) In principle, the generation, change and extinguishment of the authority for legal representation shall be made according to the Civil Act. Where the authority of legal representation is extinguished or changed, the principal or the legal representative cannot claim the effects of the extinguishment or change of the authority unless it is notified to the counterpart according to the examples of the Civil Procedure Act. Grounds for extinguishment of the authority of legal representation include death of the principal or the legal representative, adjudication of incompetency or bankruptcy of legal representative, and resignation or removal of guardian.

Meanwhile, a patent-related proceeding 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 principal in transactions. Under the Patent Act, too, even though a legal representative conducting a patent-related proceeding on behalf of the principal does not obtain the special authority, he/she may perform an act of representation for the proceedings requiring special authorities under Article 6 of the Patent Act.

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

scopes of authority even though both are legal representatives. A person with parental authority under Article 3 of the Patent Act can conduct any patent-related proceedings including trial or retrial, let alone the proceedings requiring the special authorities, without the consent of a guardian supervisor. On the other hand, a guardian may conduct proceedings which were initiated at the request of the other party, such as trial or retrial, without the consent of the guardian supervisor. However, he/she shall obtain the consent of guardian supervisor to perform any act relating to acquisition, forfeit or alteration of a right to obtain a patent or a patent right, as well as an act of filing a petition for a trial or retrial.

(Note) Under the Civil Act, too, a guardian has more restricted authority than a person with parental authority in performing one of the following acts: ① an act to conduct business; ② an act to borrow money; ③ an act to impose an obligation; ④ an act which aims at acquisition, forfeit and alteration of right and title on immovable or important property; ⑤ an act to bring an action to the court; and ⑥ an act to discuss acceptance of succession, limited acceptance of succession or renouncement and division of inherited property. Where a guardian performs such acts in place of the person under guardianship or allows minors to perform such acts, the guardian shall obtain the consent of guardian supervisor.

(4) Where a legal representative conducts a patent-related proceeding, he/she shall state such facts in the 'Agent' box in a patent application cover sheet, 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 conduct proceedings other than the ones defined in Article 3(2) of the Patent Act, the consent of guardian supervisor shall be obtained.

Therefore, the guardian shall submit the evidential documents of the consent of guardian supervisor. Also, it is possible to secure the consent of guardian supervisor for proceedings either specifically, or generally.

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

4. Contractual Representative

(1) A contractual representative refers to a person who receives a credential of a principal and becomes a representative according to the intention of a principal. The contractual representative includes not only a representative based on a contract for empowering, but also a representative based on a contract of conduct of affairs. Patent administrators and designated representatives are also contractual representatives.

(2) The power of representation of a contractual representative is generated when a principal grants power of attorney to another person.

(3) The power of representation is extinguished when the principal withdraws the empowering 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 principal, dissolution of a corporate principal due to a merger, the termination of the duty of trust of the principal, 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 proceeding conducted by a representative without noticing the death of a principal would become invalidated and an urgent proceeding could not be conducted, leading to an unexpected damage to an

heir of the principal and adversely affecting all the examination- and trial-related proceedings. Considering all the possible problems, the Patent Act includes the provisions on the survival of power of agent.

(4) A representative empowered by a principal (except a patent administrator of an overseas resident) cannot perform any of the following acts unless he/she obtains the special authority for the proceedings as follows: the converting, abandonment or withdrawal of an application (withdrawal of application for registration of patent term extension); the abandonment of a patent right, withdrawal of a patent application, withdrawal of request, petition or withdrawal of Domestic Priority under Article 55(1) of the Patent Act and the petition 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 special authority mentioned above.

The special authority is required to represent a patent application accompanying a domestic Priority claim. The special authority is stated as in the following examples to specify a prior application.

Case	Power of Attorney of Prior Application	Power of Attorney of Domestic Priority Application
Where the special authority is granted for priority claim at filing a prior application	Any matter regarding to Application○○ (Special authority 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 authority unnecessary

Case	Power of Attorney of Prior Application	Power of Attorney of Domestic Priority Application
Where the special authority is granted for priority claim at filing an Domestic Priority application	Any matter regarding to Application○○ ※ No description on special authority related to priority claim	Any matter regarding to Application○○ (Special authority 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

(Note) A patent-related proceeding refers to application, request and the rest of the proceedings including the ones after the registration of a patent right. In the case of a utility model registration, a proceeding regarding technical evaluation after the registration of utility model, too, is included in a patent-related proceeding. Therefore, if a representative has authority regarding matters related to technical evaluation at the time of submitting a application, the agent can represent the matters regarding requests for technical evaluation.

5. Patent Administrator

(1) A person who has a domicile or place of business in the Republic of Korea can carry out a patent-related proceeding without appointing an agent. However, an overseas resident cannot carry out a patent-related proceeding or file a lawsuit against the decision made by an administrative office unless he/she sojourns 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 carry out a patent-/utility model-related proceeding, such as submission of the translation of the application, etc., even without an agent by the reference

date (the time limit set forth with regard to submission of the translation (where the time period for submission of the Korean translation is extended, the extended period included), and the date of filing a request for examination where a patent applicant files a request for examination within the period). In such a case, the overseas resident shall appoint an agent within two months from the reference date and notify the Commissioner of the Korean Intellectual Property Office of the appointment of the agent. When no notification of the appointment of an agent is made to the Commissioner of the Korean Intellectual Property Office, the international patent application shall be deemed to have been withdrawn.

(Note) Where an overseas resident carries out a patent-related proceeding without the appointment of a patent administrator, an examiner shall give the overseas resident 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 overseas resident. In such a case, addressing the deficiencies through amendments, such as appointing a patent administrator, is not acceptable.

Also, where an overseas resident's patent administrator no longer exists because of death, revocation or other reasons, an examiner shall immediately contact the principal (overseas resident) to urge him/her to carry out the proceedings for appointing a patent administrator. In such a case, until a new patent administrator is appointed, the relevant documents can be delivered to the principal 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 should be appointed and notified under Article 5(1) of the Patent Act because of the death of the previous patent administrator; and ③ subsequent proceedings shall be carried out by a patent administrator.

(2) Where an application is jointly filed by a resident and an overseas resident, a resident may solely carry out a patent-related proceeding, except for the proceedings defined in Article 11(1) of the Patent Act, whereas an overseas resident cannot carry out a patent-related proceeding alone, without appointing a patent administrator.

As for a patent-related proceeding listed in the provisions of Article 11(1) of the Patent Act, a resident shall jointly carry out the proceedings with a patent administrator appointed by an overseas resident.

(3) A patent administrator of an overseas resident can represent the principal in all the patent-related proceedings or a lawsuit on a decision made by an administrative office based on all the Patent Act or any order under the Patent Act within the scope of power. Provided, however, that as a patent administrator can carry out patent related proceedings within the scope of power entrusted, just as the normal agent who is empowered by the principal, the patent administrator can withdraw either the patent application or a petition for a trial, only when the patent administrator is given the special authority for carrying out such procedures.

6. Appointment or Replacement of Representative

6.1 Appointment of Representative

(1) An appointed representative shall submit a power of attorney and a notification of appointment of a representative to prove the appointment. A notification of revocation or change of a representative, too, shall be submitted in order to revoke or change the appointed representative. The procedures for appointment, revocation or change of a representative are specified in Article 5 of the Enforcement Rules of the Patent Act.

(2) When a representative is appointed or changed while performing such a proceeding as filing an application, etc., a notification of the appointment of a representative or a notification of change of representative shall be submitted with a power of attorney attached. Where an intermediate

proceeding such as submitting an argument is carried out by a representative with a power of attorney attached (including the case where the intention of granting all the patent-related powers of attorney is stated), the representative shall be treated to hold power only for the intermediate proceeding (when another intermediate proceeding is being taken at the same time, the concerned proceeding shall be also included). In such a case, when the representative is to continue to carry out patent-related proceedings after the intermediate proceeding, separate notification of the appointment of a representative shall be 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 appointed agent intends to continue to carry out a patent-related proceeding for an application in which the applicant has been changed, a notification of appointment 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 proceeding for the appointment of a representative as well as the proceedings taken by the representative with deficiency 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 representative and the principal, authorities empowered and the date of preparing the power of attorney. And then the principal 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 notification of appointment of a representative, a

notification of appointment of subagent or a notification of revocation of a representative, an examiner shall order an amendment to the concerned proceedings. If deficiencies are not addressed, an examiner shall invalidate the proceedings.

(Note) Where 『all matters regarding ...』 and 『all the other matters regarding ...』 are stated in the ‘Matters for Authorization’ box, it shall be deemed that special authorities 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 authorization’ box in a power of attorney attached to a request for change of an applicant, but where the proceeding after the change of the applicant is not indicated, it shall be deemed only for a request for change of the applicant.

(4) The authority of a representative (including a patent administrator) of a person who conducts a patent-related proceeding shall be proved in writing. Where evidential documents for the authority of a representative are not attached, where a power of attorney states an incorrect name of the principal 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 principal. If the power of attorney is not ratified, an examiner shall invalidate a patent-related proceeding carried out by the representative.

6.2 General Power of Attorney System

(1) The general power of attorney system is designed to grant power not only for a current specific case or but for all the future cases without specifying the case in advance to a representative of a principal conducting patent-related proceedings.

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

Where a request for the registration of general power of attorney is filed, the Commissioner of the Korean Intellectual Property Office shall grant the registration number for general power of attorney and notify the registration number to the applicant who has requested the registration of the general power of attorney. A person who intends to carry out a patent-related proceeding 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 Trial and Appeal Board.

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

Meanwhile, where a request for revocation of a representative is submitted for an application filed by the representative who has registered general power of attorney, it shall be deemed that a request for restriction of reliance on general power of attorney for the application 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 principal or a representative is recognized not to be able to perform administrative proceedings smoothly due to the lack of legal capacity to perform actions, it shall be forced to appoint a representative to protect the benefits of the principal or to order another representative to conduct a patent-related proceeding.

(2) Where a person conducting a patent-related proceeding or his/her representative is recognized not to be capable of carrying out such proceedings smoothly or making oral statements, the Commissioner of the Korean Intellectual Property Office or the President of the Intellectual Property Trial and Appeal Board can order a new representative or order *ex officio* another representative to conduct the proceedings. Also, a patent attorney can be ordered to conduct the proceedings.

Even if a patent attorney is designated to conduct a patent-related proceeding, 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 Trial and Appeal Board can order *ex officio* the appointment of another representative for administrative convenience and protection of the principal. Where a patent attorney cannot conduct a patent-related proceeding because of health conditions or where a patent attorney is incapable of making oral statements, he/she is deemed to be incapable of conducting a patent-related proceeding.

(3) The Commissioner of the Korean Intellectual Property Office or the President of the Intellectual Property Trial and Appeal Board can invalidate the proceedings conducted by the principal or the representative before the Korean Intellectual Property Office or the Intellectual Property Trial and Appeal Board in the period after the order for appointment or replacement of representative or before the appointment or replacement of representative is carried out.

6.4 Sub-agency

(1) Sub-agency refers to a representation authorized to another person by a representative in order for the representative to make the person conduct the acts within the scope of power of 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 principal or legal provisions, independently with the right of representation itself.

(2) Since a legal representative is the one to become a representative not by the intention of a principal, the authorities granted to a legal representative are generally broad. Also, a legal representative is not free to resign the position. Therefore, it is interpreted that a legal representative always holds the authority to appoint a subagent and is allowed to appoint a subagent under his/her responsibility.

A contractual representative or a patent administrator is not allowed to appoint a subagent unless he/she is granted a special power to do so.

(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 contractual representative is responsible for the payment of damages incurred to the principal only when he/she is negligent in the appointment and supervision of a subagent. Where a contractual representative has appointed a subagent who is designated by the principal, he/she shall bear responsibility only when he knew that such subagent is unfit or untrustworthy and neglected to notify the principal thereof or to revoke him/her.

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

Meanwhile, in principle, a subagent appointed by a representative is not allowed the power of appointing a further subagent. However, where the principal has granted a representative the power of attorney and power of appointing a subagent and, at the same time, has indicated that a subagent can appoint a further subagent, it is allowed that a subagent can appoint a further subagent.

A subagent shall represent the principal within the scope of his/her authority and hold the same rights and duties as the agent with respect to the principal and third parties. The principal can revoke 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 representative holds the authority to appoint a subagent by the power granted from the principal, a subagent appointed based on the authority shall be deemed to be a representative of the principal. In such a case, the evidential documents for the authority of representation, 'the document which proves that the principal 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 conduct a patent-related proceeding shall not be extinguished upon the decease or loss of legal capacity of the principal, the extinction of a juristic person of

the principal due to a merger, the termination of the duty of trust of the principal, 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 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 representative because of absence of supervision by the representative, the Korean Civil Procedure Act stipulates that the power of representation of a subagent shall not be extinguished even in case of death of a representative for the purpose of the swift and smooth execution of the proceedings. 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 proceeding shall not be extinguished in case of death of a 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 principal and where the principal have made 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 have been appointed, each of them shall independently represent the principal before the Korean Intellectual Property Office or the Intellectual Property Trial and Appeal Board.

Therefore, the principle of individual representation shall apply to the acts conducted between appointed representatives; the principal and the appointed representative; the appointed representative and the subagent; the principal and the subagent as well as the proceedings conducted by the same representative several times.

(Example) Where more than two representatives have submitted a written amendment respectively in response to a notice 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 proceeding, conducted by a person who lacks legal capacity, the power of legal representation or the authorization necessary to carry out any such proceedings, shall have effect retroactively to the time when such proceedings are performed if the proceedings are ratified by the principal when he/she has gained legal capacity. Therefore, proceedings carried out by an incompetent or an un-authorized agent shall take effect retroactively based on the ratification by a legitimate principal or legal representative. 'The principal after amendment' in this context refers to someone who was a minor when the proceeding was initially performed, but now has reached 19 years old and become a person with legal capacity.

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

Where more than two parties involved have appointed a common

representative and have notified such appointment to the Korean Intellectual Property Office, only the common representative can conduct a patent-related proceeding. Also, more than two common representatives can be appointed. Where a common representative is to be appointed, the appointed representative shall submit to the commissioner of the Korean Intellectual Property Office or the president of the Intellectual Property Trial and Appeal Board the evidential documents proving that he/she is a common representative and the power of attorney (only when a proceeding is conducted by an agent) attached to the Notification of Agent [Representative] in Annexed Form No.2 of the Enforcement Rules of the Patent Act.

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

(4) When only some of the parties involved appoint a representative, the appointed representative can conduct a patent-related proceeding on behalf of all the parties involved. However, he/she shall conduct the proceedings 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.

Chapter 3. Period

1. Relevant Provisions

Article 14 (Calculation of Periods)

The periods specified by this Act or any order issued under this Act shall be determined as follows:

1. The first day of a period shall not be counted: provided, however, that the foregoing shall not apply where a period commences at midnight;

2. If a period is expressed in months or years, it shall be counted according to the calendar;

3. If the starting day of a period does not fall on the beginning day of a month or year, the period shall expire on the day before the date in the last month or year of the period corresponding to the starting date: Provided, That if a period is counted by months or years but there is no corresponding day in the last month, the period shall expire on the last day of that month;

4. If the last day of a period for performing a patent-related proceeding falls on an official holiday (including the Workers' Day designated under the Designation of Workers' Day Act and Saturdays), the period shall expire on the next working day.

Article 15 (Extension, etc. of Periods)

(1) Upon request or *ex officio*, the Commissioner of the Korean Intellectual Property Office may extend the period for filing a petition for a trial under Article 132(17) only once by up to 30 days: Provided, however, that the number of extensions and the period may be additionally increased or extended for the benefit of a person with poor access to transport as in islands or in remote areas, as prescribed by Ordinance of the Ministry of Trade, Industry and Energy

(2) When the Commissioner of the Korean Intellectual Property Office, the President of the Korean Intellectual Property Trial and Appeal Board, a

presiding administrative patent judge, or an examiner referred to in Article 57(1) (hereinafter referred to as “examiner”) sets a period for carrying out a patent-related proceeding under this Act, he/she may shorten or extend the period, upon request, or may extend the period, ex officio. In such cases, the Commissioner of the Korean Intellectual Property Office or other competent authority shall ensure that the interests of relevant parties in the proceeding are not unfairly infringed on when determining whether to shorten or extend such period.

(3) Where a presiding administrative patent judge specifies a deadline for carrying out a patent-related proceeding under this Act, he/she may change the deadline, upon request or ex officio.

2. Type of Period

Periods are classified 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 Trial and Appeal Board, a presiding administrative patent judge or an examiner sets based on the Patent Act or any Order under the Patent Act towards a person filing an application, making a request or performing any other patent-related proceedings.

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

Statutory Period	Designated Period
<ul style="list-style-type: none"> ◦ Period for requesting withdrawal of invalidation of proceeding (Article 16) ◦ Period for retroactively recognizing the filing date of a lawful right holder (Articles 34, 35) ◦ Period in case of inventions not 	<ul style="list-style-type: none"> <input type="checkbox"/> Period designated by KIPO commissioner ◦ Period for amendment of proceeding (Article 46) ◦ In case of request for consultation on the identical invention, etc. (Articles 36, 38)

Statutory Period	Designated Period
<p>deemed to be publicly known (Article 30)</p> <ul style="list-style-type: none"> ◦ Period for amendment of description or drawings (Article 47) ◦ Period for filing a divisional application (Article 52) ◦ Period for filing a converted application (Article 53) ◦ Period for priority claim under Treaty (Articles 54,55,56) ◦ Period for request for examination of patent application (Article 59) ◦ Time for laying open an application (Article 64) ◦ Application to register the extension of term of patent right (Article 90) ◦ Appeal against the decision to reject a patent application (Article 132(17)) ◦ Time for service by public announcement coming into force (Article 219) ◦ Period for request for re-examination(Article 67(2)) 	<ul style="list-style-type: none"> ◦ In case of request made to the party involved for submission of documents and articles(Article 222) <input type="checkbox"/> Period designated by examiner ◦ When an examiner notifies a ground for rejection and provides an applicant with an opportunity to present his/her written opinions (Article 63) ◦ 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.

(3) When the starting day of the period does not coincide with the beginning day 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 proceeding, 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 proceeding. In other words, a statutory or designated period irrelevant of a patent-related proceeding 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 notice 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)).

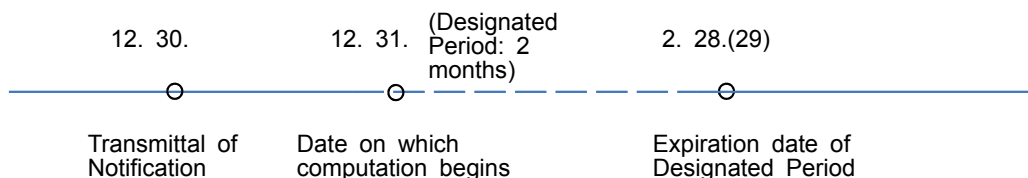
(Note) Where the day on which the calculation begins falls on a public holiday, the period shall start from the public holiday.

(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 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.

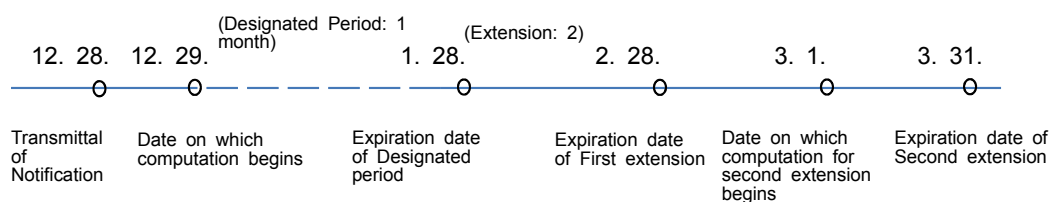
Where there is no concerned date in the last month of the period



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.

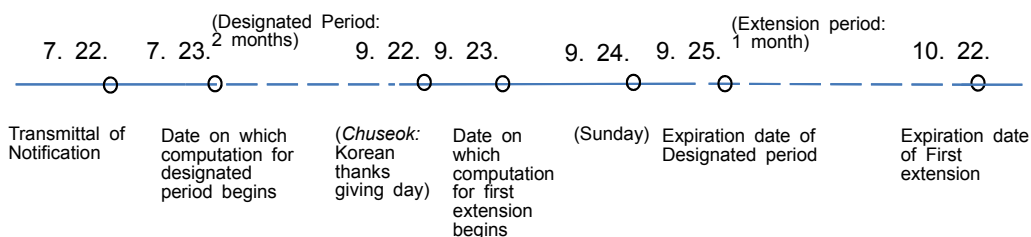
Moreover, where there is no day concerned in the last month of the period, the last day of the month shall be expiration date. As in the above case, since February 30 does not exist, the last day of that month, February 28, shall be the expiration date of the designated period.

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 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 conduct a patent-related proceeding within a statutory or designated period to carry out 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 carry out the proceeding.

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 shortening of a period was designed to allow for the shortening 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 shortened upon request by a party involved.

4.1 Extension and Acceptance of Statutory Period

Anyone can extend a statutory period for a petition for appeal to 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 a request for extension of a statutory period has been submitted, the President of the Intellectual Property Trial and Appeal Board (the Trial Policy Division) shall determine whether the requirements for extension are fulfilled and whether to accept the request.

4.2 Extension and Acceptance of Substantive Examination-related Designated Period

(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 request for extension of the period is submitted, except for the period for submission of a written argument in response to a notice 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 request for extension of the submission period for a written argument 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 argument (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 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 tests relating to grounds for rejection as well as analyzing the results of such tests.
 - 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 for 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 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 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 request. 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 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 request. 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. Shortening of Designated Period

When the period for conducting a patent-related proceeding has been set, the period can be shortened upon request. Where a request for shortening of the period is submitted, or where the intention of shortening 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.

Chapter. 4 Invalidation of Proceeding and Return of Document

1. Relevant Provisions

Article 46 (Procedural Amendments)

The Commissioner of the Korean Intellectual Property Office or the President of the Korean Intellectual Property Trial and Appeal Board shall order a relevant person to amend a patent-related proceeding within a specified period in any of the following cases. Upon receipt of such order, the person may submit an argument on the order to the Commissioner of the Korean Intellectual Property Office or the President of the Korean Intellectual Property Trial and Appeal Board during the period:

1. In case of violations of Article 3 (1) or 6;
2. In case of violation of any formality specified in this Act or any order issued thereunder;
3. In case of failures to pay any fee required under Article 82.

Article 16 (Invalidation of Proceeding)

(1) When a person ordered to make an amendment under Article 46 fails to do so within the specified period, the Commissioner of the Korean Intellectual Property Office or the President of the Korean Intellectual Property Trial and Appeal Board may invalidate the patent-related proceeding: Provided, That if a person ordered to make an amendment for his/her failure to pay fees for requesting examination under Article 82 (2) fails to pay the fees, he/she may invalidate the amendment to the specification accompanying the patent application.

(2) When a patent-related proceeding has been invalidated under paragraph (1), but it is deemed that the failure to make an amendment within the specified period was due to a cause not attributable to the person ordered to do so, the Commissioner of the Korean Intellectual Property Office or the President of the Korean Intellectual Property Trial and Appeal Board may revoke the invalidation upon receipt of a request within two months after

the relevant cause ceases to exist from the person ordered to make such amendment: Provided, That the foregoing shall not apply where one year has passed since the expiration of the specified period.

(3) When the Commissioner of the Korean Intellectual Property Office or the President of the Korean Intellectual Property Trial and Appeal Board invalidates a proceeding under the main body of, or the proviso to, paragraph (1) or revokes invalidation under the main body of paragraph (2), he/she shall give a notice of such measure to the person ordered to make an amendment

Article 17 (Subsequent Completion of Proceeding)

If a person who has conducted a patent-related proceeding fails to complete the proceeding within either of the following periods due to a cause not attributable to him/her, he/she may subsequently complete the proceeding within 2 months after the cause ceases to exist: Provided, That the foregoing shall not apply where one year has passed since the expiration of the specified period:

1. A period for filing a petition for trial under Article 132-17;
2. A period for filing a petition for retrial under Article 180 (1).

Article 67-3 (Restoration of Patent Application)

(1) If it is recognized that a patent application has been withdrawn or a decision to reject a patent application has become final and conclusive because of the patent applicant's failure to comply with any of the following time limits due to a cause not attributable to the patent applicant, the patent applicant may request the examination or re-examination of the patent application within two months from the date when such cause ceases to exist: Provided, That this shall not apply where one year has elapsed since such period expired:

1. The period during which a request for examination of a patent application may be filed pursuant to Article 59 (2) or (3);

2. The period during which a request for re-examination may be filed pursuant to Article 67-2 (1).

(2) Notwithstanding Article 59 (5), if a request for examination or re-examination of a patent application is filed pursuant to paragraph (1), the patent application shall be deemed not to have been withdrawn or the decision to reject a patent application shall be deemed not to have become final and conclusive.

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 or opposition proceeding or a trial-related document or article such as sample, etc.(hereinafter in this Article referred to as 'application documents, etc.')

under Articles 42, 90, 92-3, 132-4, 140 or 140-2 of the Patent Act falls under any of the following subparagraphs, the Commissioner of the Korean Intellectual Property Office or the President of the Intellectual Property Trial and Appeal Board 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 a document is not prepared per an application.

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 conducts a patent-related proceeding [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 indicated.

4. Where an application is not written in Korean

5. Where a specification is not attached to an application (including the case where the description of the invention is not included in the specification).

5-2. Where a specification which does not include the claims is attached to a patent application filed by the lawful holder of a right and the amendment period of the specification under Article 42(2)(ii) of the Patent Act has already elapsed.

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

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 periods stipulated 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(17) of the Patent Act or the period designated by the Commissioner of the Korean Intellectual Property Office, the President of the Intellectual Property Trial and Appeal Board, an administrative patent judge or an examiner.

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

11. Where a person not entitled to carry out a patent-related proceeding has submitted documents regarding the proceeding.

12. Where the concerned documents such as 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.*, are not clear and cannot be accepted when an application code should be granted based on

13. Where a patent application or any document submitted over a computerized network or via electronic recording device is not prepared 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)(ii) of the Enforcement Rules of the Patent Act have not been submitted within the designated period.

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 specification which does not include the claims.

16. Where a request for early publication has been submitted for a patent application attached with a description which does not include 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)(i) of the Enforcement Rules of the Patent Act.

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

19. Where a request for re-examination without amendment of a specification 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)(i) of the Enforcement Rules of the Patent Act.

20. According to proviso 1, Article 52 of the Patent Act, where the Korean translation is not yet submitted or where it is subject to Article 53(1)(ii) of the Patent Act, Article 59(2)(ii) of the Patent Act or Article 64(2)(ii) 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 Trial and Appeal Board 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)(xiv) 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.

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 Trial and Appeal Board 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 Trial and Appeal Board. 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 Trial and Appeal Board 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 Trial and Appeal Board regarding a patent-related proceeding 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 proceeding 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 Trial and Appeal Board. However, where irregularities found in formalities examinations are closely linked to substantive examinations and the 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 Proceeding

(1) Where a patent-related proceeding falls under any subparagraph of Article 46 of the Patent Act, an examiner shall request an amendment of such proceeding 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 proceeding 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 proceeding designated in a request for amendment shall be within one month.

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

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 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 proceedings in

a single request for amendment, but an amendment containing only parts of the proceedings are amended is submitted within the designated period, an examiner shall invalidate only the proceedings 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 proceeding, citing the proceeding 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 proceeding for the concerned amendment. Where irregularities indicated by the decision to invalidate the amendment proceeding are not addressed, an examiner shall invalidate the concerned proceeding.

(3) The person who can invalidate a patent-related proceeding is the Commissioner of the Korean Intellectual Property Office or the President of the Intellectual Property Trial and Appeal Board, not an examiner. Subjects of invalidation are not limited to application proceedings. All the patent-related proceedings shall be subject to invalidation.

When an examiner intends to invalidate a patent-related proceeding, he/she shall state the grounds for invalidation and notify the reasons to the person who has conducted the proceeding. A notice stating that an applicant can

conduct an administrative trial or lawsuit shall be attached to a notification of invalidation of the proceeding.

(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 proceeding 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 proceeding is invalidated, but if the failure to amend within the designated period is recognized to have been caused by reasons not attributable 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 causes 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 attributable 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 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 proceeding, except for cases where a person who has conducted a patent-/request-related proceeding 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 Trial and Appeal Board. 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.

Where a patent-related proceeding or examination is conducted during the period after the disposition of invalidation before the revocation of the disposition of invalidation, an examiner shall review the proceeding or examination and determine whether such proceeding 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 Trial and Appeal Board 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, petitioner 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 Trial and Appeal Board 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 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 Trial and Appeal Board 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 Trial and Appeal Board 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 notice 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 proceedings 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 Proceeding

(1) Where a person who conducted a patent-related proceeding has failed to comply with the period for requesting a trial under Article 132(17) or the period for demanding a retrial under Article 180(1) of the Patent Act because of a cause not attributable to the person, he/she may subsequently complete the proceeding within the designated period. It is based on the reason that where a person who conducted a patent-related proceeding is not allowed to challenge the decision or the ruling because the period for requesting a trial or retrial has expired due to a cause not attributable to the person, he/she would get harshly disadvantaged in such proceedings. 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 proceeding is within 2 months of the day when a cause not attributable to the person who performed the patent-related proceeding ceases to exist. When one year has elapsed from the day of the expiration of the period for subsequently completing a patent-related proceeding, the proceeding 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 application, 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 to reject a patent application shall be deemed not to be confirmed.(Article 67(3)(ii) of the Patent Act)

Chapter 5. Discontinuation and Resumption of Proceeding

1. Relevant Provisions

Article 18 (Succession of Procedural Effects)

The effects of a proceeding taken relating to a patent or a patent-related right shall extend to the successor to the patent or the patent-related right.

Article 19 (Continuation of Proceeding)

Where a patent or a patent-related right is transferred while a patent-related proceeding is pending before the Korean Intellectual Property Office or the Korean Intellectual Property Trial and Appeal Board, the Commissioner of the Korean Intellectual Property Office or the presiding judge may permit the successor to the patent or the patent-related right to continue the patent-related proceeding.

Article 20 (Interruption of Proceeding)

In any of the following cases, a patent-related proceeding pending before the Korean Intellectual Property Office or the Korean Intellectual Property Trial and Appeal Board shall be interrupted: provided, however, that the foregoing shall not apply where an agent has been authorized to perform the proceeding:

1. If the relevant party dies;
2. If the relevant corporate party dissolves in the course of a merger;
3. If the relevant party loses the capacity to perform the proceeding;
4. If the party's legal representative dies or loses his/her power as a legal representative;
5. If the duty of the party as a trustee terminates;
6. If the representative appointed under the proviso to Article 11 (1) excluding the subparagraphs dies or becomes disqualified;
7. If a bankruptcy trustee or a person who has intervened in the proceeding for another person in his/her name with a certain qualification becomes disqualified or dies.

Article 21 (Resumption of Interrupted Proceeding)

If a proceeding pending before the Korean Intellectual Property Office or the Korean Intellectual Property Trial and Appeal Board is interrupted under Article 20, any of the following persons shall resume the proceeding:

1. In cases falling under subparagraph 1 of Article 20: The deceased party's heir, the administrator of inherited property, or a person authorized to resume the proceeding under any Act: provided, however, that no heir may resume the proceeding during the period in which he/she can renounce inheritance;
2. In cases falling under subparagraph 2 of Article 20: The corporation established in the course of the merger or the corporation surviving the merger;
3. In cases falling under subparagraph 3 or 4 of Article 20: The party whose capacity to perform the proceeding is reinstated or a person appointed as the legal representative;
4. In cases falling under subparagraph 5 of Article 20: A new trustee;
5. In cases falling under subparagraph 6 of Article 20: A new representative or either party;
6. In cases falling under subparagraph 7 of Article 20: An equally qualified person.

Article 22 (Request for Resumption)

(1) A request for resuming a proceeding interrupted under Article 20 can be filed by a person specified in any subparagraph of Article 21. In such cases, the opposite party can request the Commissioner of the Korean Intellectual Property Office or the administrative patent judge referred to in Article 143 (hereinafter referred to as "administrative patent judge") to order the person specified in any subparagraph of Article 21 to file a request for resumption.

(2) Upon receipt of a request for resuming an interrupted proceeding under Article 20, the Commissioner of the Korean Intellectual Property Office or the presiding judge shall notify the opposite party thereof.

(3) If the Commissioner of the Korean Intellectual Property Office or the

administrative patent judge finds, after examining the request *ex officio*, that no grounds exist to accept the request for resuming the interrupted proceeding under Article 20, he/she shall determine to dismiss the request.

(4) Upon receipt of a request for resuming a proceeding interrupted after a certified copy of a decision or a ruling is served, the Commissioner of the Korean Intellectual Property Office or the administrative patent judge shall determine whether to permit the resumption of the proceeding interrupted.

(5) If a person specified in any subparagraph of Article 21 fails to resume the interrupted proceeding, the Commissioner of the Korean Intellectual Property Office or the administrative patent judge shall, *ex officio*, order the person to resume the proceeding within a specified period.

(6) If the proceeding is not resumed within the period specified in paragraph (5), it shall be deemed resumed on the day following the expiration of the period.

(7) Where the proceeding is deemed resumed under paragraph (6), the Commissioner of the Korean Intellectual Property Office or the presiding administrative patent judge shall notify all relevant parties thereof.

Article 23 (Suspension of Proceeding)

(1) If the Commissioner of the Korean Intellectual Property Office or an administrative patent judge is unable to perform any of his/her duties due to a natural disaster or other extenuating circumstances, the proceeding pending in the Korean Intellectual Property Office or the Korean Intellectual Property Trial and Appeal Board shall be suspended until such circumstances cease to exist.

(2) If a relevant party is unable to resume a proceeding pending before the Korean Intellectual Property Office or before the Korean Intellectual Property Trial and Appeal Board due to an obstacle that persists for an indefinite duration, the Commissioner of the Korean Intellectual Property Office or the administrative patent judge may determine to order the suspension of the proceeding until the obstacle is removed.

(3) The Commissioner of the Korean Intellectual Property Office or an administrative patent judge may revoke the determination made under

paragraph (2).

(4) When the Commissioner of the Korean Intellectual Property Office or the presiding administrative patent judge suspends a proceeding under paragraph (1) or (2) or revokes a determination under paragraph (3), he/she shall notify all relevant parties thereof.

Article 24 (Effects of Interruption or Suspension)

When a patent-related proceeding is interrupted or suspended, the running of the relevant period shall be interrupted, and the entire period shall start to run again from the time the resumption of the proceeding is notified or the proceeding is resumed.

2. Discontinuation of Proceeding

Discontinuation of a patent-related proceeding refers to a condition where a patent-related proceeding, such as filing an application, making a request, pending before the Korean Intellectual Property Office or the Intellectual Property Trial and Appeal Board does not legally proceed before the completion of the proceeding. The Patent Act divides the discontinuation of a patent-related proceeding into interruption of proceeding and suspension of proceeding.

Interruption of a proceeding means that when a cause for which a party involved cannot conduct the proceeding happens to the party involved, the concerned proceeding is discontinued until another party shows up and conducts the proceeding.

Suspension of a proceeding refers to the condition where a cause for which the proceeding cannot proceed happens to the Korean Intellectual Property Office or a party involved, the proceeding is suspended legally or by the decision of the Korean Intellectual Property Office.

2.1 Interruption of Proceeding

(1) A patent-related proceeding shall be interrupted because of legal

reasons regardless of intention of the Korean Intellectual Property Office or a party involved who initiates the concerned proceeding. When a proceeding is interrupted, a legitimate successor in title shall make a request for resumption of the interrupted proceeding. However, even in the presence of a cause of interruption of a patent-related proceeding, the concerned proceeding shall not be interrupted if there is a legal representative with power of attorney.

Parties who can resume the interrupted patent-related proceeding 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 proceeding

However, a successor in title shall not resume the concerned proceeding 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 capacity to conduct a patent-related proceeding, the party involved who has recovered the capacity to conduct the proceeding, or a person who has become a legal representative

④ Where a legal representative of a party involved is deceased or loses his/her power, the party involved who has recovered the capacity to conduct a patent-related proceeding or a legal representative or a person who has newly become 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

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 proceeding can be resumed by submitting a written request stating such intention of resumption. When a request for resumption of an interrupted proceeding is made, the Commissioner of the Korea Intellectual Property Office or the President of the Intellectual Property Trial and Appeal Board shall notify such request to the opposing party in the concerned proceeding.

A person who intends to request the resumption of an interrupted proceeding shall attach evidential documents of grounds for resumption to a written request for resumption of an interrupted proceeding and then submit them to the Commissioner of the Korean Intellectual Property Office or the presiding administrative patent judge of the Intellectual Property Trial and Appeal Board. Also, a resumption of an interrupted proceeding can be requested by a party who can resume the interrupted proceeding according to each paragraph under Article 21. In this case, the opposing party can request the Commissioner of the Korean Intellectual Property Office or the administrative patent judge to order the party to file a request for resumption pursuant to each paragraph of Article 21. The Commissioner of the Korean Intellectual Property Office or the administrative patent judge shall dismiss the request for resumption when a request for resumption of an interrupted proceeding is recognized to be groundless 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 proceeding 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 proceeding failed to do so, the Commissioner of the Korean Intellectual Property Office or the administrative patent judge shall order a resumption of the interrupted proceeding within a designated period. Where the interrupted proceeding is not resumed within the designated period, the interrupted proceeding 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 proceeding 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 an ordinary examination, an examiner shall conduct the examination on a patent-related proceeding without an additional investigation into whether the proceeding 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 proceeding was generated in the middle of an examination, he shall suspend the examination until the point when the proceeding is resumed under Article 21 of the Patent Act. An interrupted proceeding 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 proceeding has been addressed.

Where an examiner is aware of a ground for resumption of an interrupted proceeding, he/she shall order a resumption of the proceeding 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 proceeding 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 proceeding and continues an examination procedure, he/she shall invalidate such proceeding and conduct the proceeding 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 to reject without awareness of death of the applicant, the decision to reject is illegitimate since the proceeding for submission of a written argument 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 to reject and give an opportunity to submit a written argument by issuing a notification of grounds for rejection after resumption of the interrupted proceeding.

2.2 Suspension of Proceeding

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

(2) If a party involved is unable to pursue a proceeding 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 conducting a patent-related proceeding. 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 proceeding of a patent application is related to a trial or litigation and where conducting the examination proceeding on the concerned application after the completion of the trial or litigation proceeding is deemed appropriate, an examiner can suspend such proceeding 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 proceeding shall be resumed under Article 23(1) of the Patent Act.

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

Where a patent-related proceeding 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.

2.3 Effect of Discontinuation of Proceeding

The interruption or suspension of a patent-related proceeding shall discontinue the running of a period for such proceeding and the entire period shall start to run again from the time of the notification of the continuation or resumption or pursuit of the proceeding. 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 proceeding within one month under Article 46 of the Patent Act in the name of the Commissioner of the Korean Intellectual Property Office, but the proceeding 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 proceeding is interrupted or suspended, the Commissioner of the Korean Intellectual Property Office or an examiner shall not proceed with the proceeding.

3. Continuation of Proceeding and Succession of Effect

(1) Where a patent right or any patent-related right is transferred while a patent-related proceeding is pending before the Korean Intellectual Property Office or the Intellectual Property Trial and Appeal Board, 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 proceeding.

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

(2) Where a patent right or any patent-related right is transferred, the effect of the already-initiated patent-related proceeding shall reach the successor in title. In other words, where a patent right or any patent-related right is

transferred, the proceeding does not need to commence anew since the already-initiated proceeding is effective. Therefore, a party involved does not need to restart the patent-related proceeding 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 grounds for rejection, the examiner does not need to send a notification of grounds for rejection to the successor in title again. Also, the period for submission of a written argument shall become a period designated in the original notification of grounds for rejection.

Chapter 6. Submission and Service of Documents

1. Relevant Provisions

Article 28 (Effective Date of Submission of Documents)

(1) An application, a request, or any other document (including physical exhibits; hereafter the same shall apply in this Article) submitted to the Commissioner of the Korean Intellectual Property Office or the President of the Korean Intellectual Property Trial and Appeal Board under this Act or any order issued under this Act shall take effect from the date when it reaches the Commissioner of the Korean Intellectual Property Office or the President of the Korean Intellectual Property Trial and Appeal Board.

(2) If an application, a request, or any other document referred to in paragraph (1) is submitted to the Commissioner of the Korean Intellectual Property Office or the President of the Korean Intellectual Property Trial and Appeal Board by post, it shall be deemed received by the Commissioner of the Korean Intellectual Property Office or the President of the Korean Intellectual Property Trial and Appeal Board on the date specified in either of the following, whichever is relevant: Provided, That if documents for applying for registration of a patent or a patent-related right or documents regarding international applications defined in Article 2 (vii) of the Patent Cooperation Treaty (hereinafter referred to as "international application") are submitted by post, such documents shall take effect on the date when they are received by the Commissioner of the Korean Intellectual Property Office or the President of the Korean Intellectual Property Trial and Appeal Board:

1. If the date stamped on the post by a postal authority is clear: The date stamped thereon;

2. If the date stamped on the post by a postal authority is unclear: The date evidenced by the receipt of the post.

(3) Deleted.

(4) In addition to provisions of paragraphs (1) and (2), matters necessary for submitting documents in cases of delay of the delivery of post, loss of the post, or interruption of postal service shall be prescribed by Ordinance of the Ministry of Trade, Industry and Energy.

Article 28-3 (Proceeding for Filing Patent Applications by Electronic Documents)

(1) A person who performs a patent-related proceeding may prepare a patent application and other documents to be filed with the Commissioner of the Korean Intellectual Property Office or the President of the Korean Intellectual Property Trial and Appeal Board under this Act, in electronic form according to the method prescribed by Ordinance of the Ministry of Trade, Industry and Energy, and submit them via an information and communications network or by means of any electronic recording medium, such as a portable storage device.

(2) Electronic documents submitted under paragraph (1) shall be as valid as paper documents submitted under this Act.

(3) An electronic document submitted via an information and communications network under paragraph (1) shall be deemed received as the contents recorded in the file of the electronic information processing system used by the Korean Intellectual Property Office or the Korean Intellectual Property Trial and Appeal Board when the person who submits the document can confirm the filing number via the information and communications network.

(4) The kinds of documents that can be submitted by electronic documents under paragraph (1), the method of submission, and other matters necessary for submitting documents as electronic documents shall be prescribed by Ordinance of the Ministry of Trade, Industry and Energy.

Article 28-4 (Reporting on Use of Electronic Documents and Digital Signature)

(1) A person who intends to perform a patent-related proceeding using electronic documents shall report such use of electronic documents to the Commissioner of the Korean Intellectual Property Office or the President of the Korean Intellectual Property Trial and Appeal Board, and shall affix his/her digital signature on electronic documents submitted to the Commissioner of the Korean Intellectual Property Office or the President of the Korean Intellectual Property Trial and Appeal Board to identify the person who submits the documents.

(2) Electronic documents submitted under Article 28-3 shall be deemed submitted by a person whose digital signature is affixed thereon under

paragraph (1).

(3) Proceedings for reporting the use of electronic documents and the method of affixing a digital signature under paragraph (1), and other necessary matters shall be prescribed by Ordinance of the Ministry of Trade, Industry and Energy.

Article 28-5 (Notification, etc. via Information and Communications Networks)

(1) If the Commissioner of the Korean Intellectual Property Office, the President of the Korean Intellectual Property Trial and Appeal Board, a presiding administrative patent judge, an administrative patent judge, or an examiner intends to give notice of or serve a document (hereinafter referred to as “notification or service of documents”) to or on a person who has reported on the use of electronic documents under Article 28-4(1), he/she may do so via an information and communications network.

(2) The notification or service of documents via an information and communications network under paragraph (1) shall be as valid as notification or service in writing.

(3) The notification or service of a document under paragraph (1) shall be deemed received as the contents recorded in the file of the electronic information processing system used by the Korean Intellectual Property Office or the Korean Intellectual Property Trial and Appeal Board when the person to whom such notification or service is addressed accesses the document via the electronic information processing system used by the person.

(4) Matters necessary for the kinds and methods of notification and service via an electronic information and communications system under paragraph (1) shall be prescribed by Ordinance of the Ministry of Trade, Industry and Energy.

Article 218 (Service of Documents)

Matters necessary for the procedure for service of documents, etc. specified in this Act shall be prescribed by Presidential Decree.

Article 219 (Service by Publication)

(1) If it is impossible to serve a document on a person because his/her domicile or place of business of the person is unknown, service by publication shall be made.

(2) Service by publication shall be made by publishing the statement that the relevant document is available at any time for delivery to the person on whom it is to be served, in the Patent Gazette.

(3) Initial service by publication shall take effect two weeks after the date of publication in the Patent Gazette: provided, however, that subsequent service by publication to the same party shall take effect on the day after the date of publication in the Patent Gazette.

Article 220 (Service on Overseas Residents)

(1) Documents to be served on an overseas resident shall be served on his/her patent administrator, if the overseas resident has appointed a patent administrator.

(2) Documents to be served on an overseas resident may be posted to the overseas resident by registered airmail, if the overseas resident has not appointed a patent administrator.

(3) Documents posted by registered airmail under paragraph (2) shall be deemed served on the mailing date of the documents.

2. Submission of Documents

2.1 Effective Date of Submitted Documents

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

(1) Where applications, 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 and 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 when the documents are submitted to a post office is deemed to be the time when the documents reach the Korean Intellectual Property Office.

(2) Where applications, 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 received by 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 an argument is submitted in the examination phase, the effective date shall be determined based on the above-mentioned (1) or (2).

(4) In the events of delay of mail, or loss of mail for an international application in the international phase, the application shall be handled as prescribed by Articles 86 or 87 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 or loss of mail of an internal application, Articles 86 or 87 of the Enforcement Rules of the Patent Act shall apply.

2.2 Conducting Patent-Related Proceedings by Electronic Documents

(1) A patent-related proceeding can be conducted by using electronic documents. A person who wishes to conduct a patent-related proceeding 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 Trial and Appeal Board. 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 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 recorded in a file saved on a computer system for receipt operated by the Korean Intellectual Property Office or the Intellectual Property Trial and Appeal Board when a submitter of the documents confirms a receipt number through an information and communication network.

(3) Documents that can be submitted by a person who conducts a patent-related proceeding by electronic documents through an information and communication network or any electronic recording medium exclude a submission of articles, such as attached electronic documents, a request for correction and issuance, documents related to an international application prepared in Japanese (including submission of Annexed Forms No.35 and 51 attached with original copies of the documents), a request for ruling under Article 214(1) of the Patent Act and a 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 digitally 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 Trial and Appeal Board. In this case, 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 conducting a patent-related proceeding 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 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 proceedings which are required to be conducted at the same time by ordinance are submitted online, they shall be entered consecutively. Among two or more patent-related proceedings

required to be conducted at the same time by ordinance, where one of such proceedings are submitted online and the rest are submitted in an electronic recording medium or in writing, all of the concerned patent-related proceedings 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 proceeding 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 by 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 proceeding 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

(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, 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 publication. 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 in the manner 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 handing over 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 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 representative, the recipient shall be the representative. Where an applicant has a sub-agent or a representative appointed in the middle of a proceeding, the recipient shall be the sub-agent or the representative appointed in the middle of a proceeding, 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 conducted a proceeding related to examination, such as a proceeding for amendment or a written argument, right before the notification by an examiner.

Where there are two or more 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 first to a representative with special power of attorney.

Where a person to be served is an incompetent, documents shall be served to his/her legal representative.

Where two or more persons jointly conduct a patent-related proceeding 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 two or more parties involved or representatives and a representative is designated to receive documents and is notified to the Commissioner of the Korean Intellectual Property Office (the president of the Intellectual Property Trial and Appeal Board), any service of documents shall be made to the representative.

(6) Documents shall be served to the domicile or a place of business 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 Publication

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 publication. 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 number sharing system. Where two or more persons perform a patent-related proceeding, documents shall be served by publication when the domiciles of all of the persons cannot be identified.

An examiner shall make a service by publication 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 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 publication.

(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 service by publication and then proceeds with service by publication. 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 to make service by publication 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 Instructions on Service by Publication

(1) Where the address of an applicant has changed after documents were served by publication, the documents served by publication shall be resent to the applicant. However, where a patent-related proceeding concerning the document to be resent is terminated, such documents do not need to be resent to the applicant. Then, a designated period or statutory period shall be calculated starting from the effective date by service of documents by publication. Where service of documents by publication was made for the first time, the service shall become effective two weeks after such documents are disclosed in the patent gazette. However, any subsequent service of documents by publication to the same party involved shall take effect on the following date of the disclosure of the documents in the patent gazette.

(2) Where an examiner, after the initial service by publication, intended to deliver relevant documents to the same party involved, and no notification of change of applicant information was made despite a notice on report of change of applicant information and the grounds for return of the documents at the time of the service by publication were 'Recipient Absence', 'Moved' or 'Address Unknown', he/she shall immediately make a service by publication, 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 place of business, 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 publication. However, documents other than the above-mentioned documents for service by publication shall not be necessarily served by publication if they have little influence on the right to obtain a patent and future notifications on such proceedings 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 publication.

(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 publication.

(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 conduct the concerned proceeding.

(7) Where a party involved requests the direct delivery of documents after the service of the documents by publication, 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 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).

Chapter 7. Fees

1. Relevant Provisions

Article 82 (Official Fees)

(1) A person who performs a patent-related proceeding shall pay official fees.

(2) If the number of claims is increased by amending the specification accompanying a patent application after a person, other than the applicant, files a request for examination of the application, the applicant shall pay the fees for the request for examination of the increased claims.

(3) Official fees referred to in paragraph (1), the methods of, and deadline for the payment thereof, and other necessary matters shall be prescribed by Ordinance of the Ministry of Trade, Industry and Energy.

Article 83 (Exemption or Reduction of Patent Fees or Official Fees)

(1) Notwithstanding Articles 79 and 82, the Commissioner of the Korean Intellectual Property Office shall exempt the payment of following patent fees or official fees:

1. Official fees or patent fees for a patent application or patent that belongs to the State;
2. Official fees for a petition for an invalidation action by examiner pursuant to Article 133 (1), 134 (1) or (2), or 137 (1).

(2) Notwithstanding Articles 79 and 82, the Commissioner of the Korean Intellectual Property Office may reduce or exempt the payment of the patent fees and official fees specified by Ordinance of the Ministry of Trade, Industry and Energy imposed on a person eligible for assistance under Article 5 of the National Basic Living Security Act or a person specified by Ordinance of the Ministry of Trade, Industry and Energy for patent applications or patents granted following patent applications, filed by such persons.

(3) A person who seeks the benefit of reduction or exemption of patent fees or official fees under paragraph (2) shall submit documents specified

by Ordinance of the Ministry of Trade, Industry and Energy to the Commissioner of the Korean Intellectual Property Office.

Article 84 (Refunds of Patent Fees, etc.)

(1) Patent fees or official fees paid shall be refunded only in any of the following cases at the payer's request:

1. Patent fees or official fees paid erroneously;
2. Portions of patent fees for the years subsequent to the year in which a decision to revoke a patent under Article 132(13)(i) or a trial decision invalidating the patent becomes final and conclusive;
3. Portions of patent fees for the years subsequent to the year in which a trial decision invalidating registration of patent term extension becomes final and conclusive;
4. Official fees for filing a patent application and for claiming priority for the patent application, out of the official fees already paid where the patent application is voluntarily withdrawn or abandoned within one month after filing the patent application (excluding a divisional application, converted application, or patent application for which a request for expedited examination has been filed under Article 61);
5. Official fees already paid for a request for examination of a patent application, where the patent application is voluntarily withdrawn (including cases where a patent application is deemed to be voluntarily withdrawn under Article 53 (4) or under the main body of Article 56 (1)) or abandoned after a request for examination of the patent application is filed but before any of the following events occurs:
 - (a) The order to report the results of consultation under Article 36 (6) (limited to patent applications filed by the same applicant);
 - (b) The notice of the results of the search for prior art requested under Article 58 (1);
 - (c) The notice of grounds for rejection under Article 63;
 - (d) Service of the certified copy of a decision to grant a patent under Article 67 (2).
6. Patent fee from the following year after the patent is abandoned

7. Where a decision to reject a patent application or a decision to reject the application of the patent term extension is revoked according to Article 176(1) (including the case the revocation is made in the retrial proceedings according to Article 184 included, excluding the case the amendment under Article 47(1)(1) or (2), which is applicable mutatis mutandis in Article 170(1), is made during either a trial or retrial), the trial request fee (among all the paid fees) (in case of retrial, this means request fee for retrial. The same applied hereinafter to this Article)
 8. Where a petition for trial is dismissed by a **decision** made according to Article 141(2), and the **decision** is finalized (the case as applicable, mutatis mutandis, to the retrial proceedings according to Article 184 included), half of the trial request fee
 9. Where the petition for trial participation is withdrawn according to Article 155(1) before it is notified the review on the merits is closed (the case as applicable, mutatis mutandis, to the retrial proceedings according to Article 184 included), half of the trial participation request fee
 10. Where the petition for trial participation is rejected by decision (the case as applicable, mutatis mutandis, to the retrial proceedings according to Article 184 included), half of the trial participation request fee
 11. Where a petition for trial is withdrawn before it is notified the review on the merits is closed (the case as applicable, mutatis mutandis, to the retrial proceedings according to Article 184 included), half of the trial participation request fee
- (2) If any subparagraph of paragraph (1) applies to a patent fee or official fee paid, the Commissioner of the Korean Intellectual Property Office or the president of the Intellectual Property Trial and Appeal Board shall give notice thereof to the relevant payer.
 - (3) No claim for refund of a patent fee or official fee referred to in paragraph (1) may be filed after three years from the date when a person receives notice under paragraph (2).

2. Payment of Fees

Official fees are fees collected from a person conducting a patent-related

proceeding, such as filing a patent application or a request for examination, as a benefit in return or rewards for the service provided by the State. These fees have different properties 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 conducting the patent-related proceeding. Therefore, if a person other than or an applicant or a patentee conducts a patent-related proceeding, the person conducting the patent-related proceeding shall pay the fees (fees of a request for trial or fees for expedited examination, etc.).

However, if fees of a request for examination are increased because of amendment after the request for examination was 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 Application for Utility Model Registration, Fee for Divisional Application, Fee for Converted Application
- ② Fee for Priority Claim: Fee for Priority Claim of Patent Application

- ③ Fee for Request for Examination: Fee for Request for Patent Examination, Fee for Request for Reexamination, Fee for Request for Expedited Examination
- ④ Fee for Change of Applicant
- ⑤ Fees for Amendment
- ⑥ Fee for Extension of Statutory Period, Fee for Extension of designated 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)(vii) and 3(1)(vi) 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 deficiencies 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 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

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 local governments) or a petition for invalidation trial by an examiner.

However, where the State and a person other than the State jointly conduct a patent-related proceeding, 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 per a year 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
1. Medical Care Recipients under the National Basic Livelihood Security Act	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, Independence Patriots and the Bereaved or Family Members, War Veterans, etc.		One copy of evidential documents of the concerned qualification
3. The registered disabled person under Welfare of		Copy of the Identification Booklet for the Physically

Subject of Exemption	Requirement	Evidential Document
Disabled Persons Act		Handicapped or evidential documents of registered disabled person under Welfare of Disabled Persons Act
4. Elementary School/ Junior High School Students		Certificate of Attendance
5. A Person not younger than 6 years old and younger than 19 years old		None
6. a person in the military service or public service worker		Certificate of Military Service

(1) Recipients receiving National Basic Livelihood Security Act benefits are only limited to those who are designated as recipients under Article 12-3 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.

(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 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.

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.

Only for individuals, small and medium-sized businesses, public research institute, exclusive organization, mid-sized firm, 30% of the patent fee and the utility model registration fee of 4 to 9 years is reduced.

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

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 85% in the following cases.

In the following cases, patent application fee, examination request fee, patent fees for each year from the first to the third year and the utility model registration fee shall be reduced by 85%.

Subject for Exemption	Requirement	Evidential Document
Younger than 30 years old but not younger than 19 years old	an inventor and a patent applicant are the same	None
65 years old and over		

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.

Subject for Exemption	Requirement	Evidential Document
1. Individual	Only when the inventor is the applicant	None
2. Small Enterprise	<p>° Small Enterprises under the proviso of Article 2 of the Framework Act on Small and Medium Enterprises</p> <p>1. Food manufacturing, beverage manufacturing, clothes, clothes accessories and fur goods manufacturing; bags, leathers and shoes manufacturing; cokes, briquette and oil refined product manufacturing, chemicals and chemical product manufacturing (medicine production excluded), medical substances and medicine production industry, non-metal mineral products manufacturing, the primary metal industry, metal</p>	<p>° Evidential documents of small enterprise</p> <p>-A copy of business registration certificate</p> <p>-Document proving Small and Medium Enterprises or total assets amount/ average sales for 3 business years e.g.) financial statements, etc.</p>

Subject for Exemption	Requirement	Evidential Document
	<p>processed goods manufacturing (mechanics and furniture manufacturing excluded), electronic components, computer, image, sound and telecommunication gear manufacturing, electricity equipment manufacturing, other mechanics and equipment manufacturing, automobiles and trailer manufacturing, the furniture manufacturing industry, electricity, gas, steam and water-work business: businesses which make money, including the average revenue, of less than 12 billion won</p> <p>2. The agriculture industry, the forestry and the fishing industry, the mining industry, cigarette manufacturing, textile products manufacturing (clothing manufacturing industry excluded), lumber and wood products manufacturing (furniture manufacturing excluded), pulp and paper products manufacturing, printing and reproduction of recorded media, rubber goods and plastic goods manufacturing, medicine,</p>	

Subject for Exemption	Requirement	Evidential Document
	<p>precision machinery and optical instrument and watch producer, other transportation equipment manufacturing, other products manufacturing, construction industry, transportation business, finance and insurance industry: businesses which make money, including the average revenue, of less than 8 billion won</p> <p>3. Wholesale and retail trade, publication, image, broadcasting communications and information service: businesses which make money, including the average revenue, of less than 5 billion won</p> <p>4. Sewage and waste disposal, raw material recycle and environment restoration, real estate business and leasing service, Professional, science and technology service industry, business facilities management and business support service industry, art, sports and leisure industry: businesses which make money, including the average revenue, of less than 3 billion won</p>	

Subject for Exemption	Requirement	Evidential Document
	<p>5. Lodging and restaurant, education, hygienic services and social welfare service industry, repair and other individual service industry: businesses which make money, including the average revenue, of less than 1 billion won</p> <p>※ Business classification under the Appendix of the Enforcement Decree of the Framework Act on Small and Medium Enterprises</p> <p>※ Only in the case of employees' invention (design) · creation</p>	
3. Medium Enterprise	<p>◦ Medium Enterprises under the proviso of Article 2 of the Framework Act on Small and Medium Enterprises</p> <p>1. The manufacturing industry of clothes, clothes accessories and fur goods; the manufacturing industry of bags, leathers and shoes; pulp and paper products manufacturing, primary metal industry; the electrical equipment manufacturing industry; the furniture manufacturing industry: businesses which make money, including the average</p>	<p>◦ Evidential documents of medium enterprise</p> <p>-A copy of business registration certificate</p> <p>-Document proving Small and Medium Enterprises or total assets amount/ average sales for 3 business years e.g.) financial statements, etc.</p>

Subject for Exemption	Requirement	Evidential Document
	<p>revenue, of less than 150 billion won</p> <p>2. The agriculture industry, the forestry and the fishing industry, the mining industry, food manufacturing, cigarette manufacturing, textile products manufacturing(clothing manufacturing industry excluded), lumber and wood products manufacturing (furniture manufacturing excluded), cokes, briquette and oil refined product manufacturing, chemicals and chemical product manufacturing (medicine production excluded), rubber goods and plastic goods manufacturing, metal processed goods manufacturing (mechanics and furniture manufacturing excluded), electronic components, computer, image, sound and telecommunication gear manufacturing, other mechanics and equipment manufacturing, automobiles and trailer manufacturing, other transportation equipment manufacturing, electricity, gas, steam and water-work business, construction industry,</p>	

Subject for Exemption	Requirement	Evidential Document
	<p>wholesale and retail trade: businesses which make money, including the average revenue, of less than 100 billion won</p> <p>3. Beverage production, printing and reproduction of recorded media, medical substances and medicine production industry, nonmetal mineral products manufacturing, medicine, precision machinery and optical instrument and watch producer, other products manufacturing, sewage and waste disposal, raw material recycle and environment restoration, transportation business, publication, image, broadcasting communications and information service: businesses which make money, including the average revenue, of less than 80 billion won</p> <p>4. Professional, science and technology service industry, business facilities management and business support service industry, hygienic services and social welfare service industry, art, sports and leisure industry. Repair and other</p>	

Subject for Exemption	Requirement	Evidential Document
	<p>individual service industry: businesses which make money, including the average revenue, of less than 60 billion won</p> <p>5. Lodging and restaurant, finance and insurance industry, real estate business and leasing service, education: businesses which make money, including the average revenue, of less than 40 billion won</p> <p>※ Business classification under the Appendix of the Enforcement Decree of the Framework Act on Small and Medium Enterprises</p> <p>※ Only in case of employees' invention (design) · creation</p>	

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	<p>◦ 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</p> <p>※ Only application fee and fee for a request for examination where application or a request for</p>	<p>◦ A copy of business registration certificate of conglomerate</p> <p>◦ Evidential document of small/medium</p>

Subject of Exemption	Requirement	Evidential Document
	examination was filed after May 1, 2006	enterprise
2. Public Research Organization	<ul style="list-style-type: none"> ◦ Public research organization under the proviso of Article 2(6) of the Technology Transfer and Commercialization Promotion Act 1. National · Public research organization 2. State-funded research organization established under the Act on the Establishment, Operation, and Fostering of Government-invested Research Institutions 3. Specific research organization under the Support of Specific Research Institutes Act 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) 5. Juristic person · organization related to R&D established under the Civil Act or other acts <ul style="list-style-type: none"> - Juristic person · organization funded or supported with half of the annual research budget by the State, local governments or state-invested firms - Juristic person funded with half of the capital or wealth invested or funded by the State, local governments or state-invested firms 	<ul style="list-style-type: none"> ◦ Evidential document ◦ None ◦ None ◦ None ◦ Evidential document

Subject of Exemption	Requirement	Evidential Document
	<ul style="list-style-type: none"> - Juristic person · organizations necessary for promotion of technology transfer recognized and designated by other relevant central administrative agencies ※ Application fees, Examination request fees, Patent fees for the first three years, Utility model registration fees 	
3. Technology Transfer Task Force	<ul style="list-style-type: none"> ◦ 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 	◦ Evidential document of task force
2. Local Government	<ul style="list-style-type: none"> ◦ 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 	◦ None

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 30% in the following cases.

Subject for Exemption	Requirement	Evidential Document
Mid-sized firm	Mid-sized firm according to Article 2(1) of the Special Act with respect to growth and competitiveness of mid-sized firms	Certificate of a mid-sized firm

3.4 Proceeding 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 an application, a 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 conducting the patent-related proceeding 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 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 patent 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

° All fees paid where an application is not accepted (returned)

° 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 priority claim, etc.)

° Fees paid by mistake or in excess

° Fees in case of invalidation or disapproval of the proceeding

Where a priority claim and a request for addition of 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

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

③ The amount of patent fees for the following years after a decision

invalidating the registration for patent term extension 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 expedited 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]
- ⑤ Where a patent application is withdrawn (a withdrawal resulted from the converted application and a withdrawal resulted from a national priority claim are included) or abandoned until an order to report consultation results (only for a patent application filed by the same person) is issued or prior art search results are notified or grounds for rejection are notified or a certificated copy of decision to grant the patent is received, after requesting examination for a patent application , the paid examination request fee
- ⑥ patent fee from the following year after the patent is abandoned
- ⑦ Where a decision to reject a patent application or a decision to reject an application for patent term extension is revoked (the case as applicable, mutatis mutandis, to the retrial proceedings included, but excepting for amendment thereto), the trial request fee among all the paid fees
- ⑧ Where a petition for a trial is withdrawn before the petition for a trial is dismissed and the concerned decision has become conclusive or it is notified the review on the merits is closed (the case as applicable, mutatis mutandis, to the retrial proceedings included), half of the fee for the petition for the trial
- ⑨ Where a request for trial participation is withdrawn or a request for trial

participation is rejected by decision before it is notified the review on the merits is closed (the case as applicable, mutatis mutandis, to the retrial proceedings included), half of the trial participation request fee

(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 has been made or a decision 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 notice of invalidation with the guide for the proceeding of refund of patent fee or official fee to the concerned payer.

Chapter 8. Other Patent-Related Proceedings

1. Relevant Provisions

Article 216 (Inspection of Documents, etc.)

(1) A person who intends to obtain a certificate or a certified copy or extract of a document with respect to a patent application, opposition proceedings and trial or to inspect or photocopy the entries in the Patent Register or documents may file a request therefor with the Commissioner of the Korean Intellectual Property Office or the President of the Korean Intellectual Property Trial and Appeal Board.

(2) Even though the Commissioner of the Korean Intellectual Property Office or the President of the Korean Intellectual Property Trial and Appeal Board has received a request under paragraph (1), if he or she considers that a document falling under any of the following paragraphs should retain confidential information, he or she shall not grant permission for inspection or copy of the concerned document.

1. A document for a patent application which has not been laid open or not been registered as a patent (Where a patent application which claims priority based on the previous application under Article 55(1) has been laid open or registered as a patent , the previous application shall be excluded).
2. A document for a appeal trial to final rejection under Article 132(17) for a patent application which has not been laid open or not been registered
3. A document which may harm public health or compromise public order or morality

Article 217 (Prohibition of Disclosure, Appraisal, etc, of Documents Relating to Patent Applications, etc.)

(1) Documents relating to patent applications, examinations, opposition proceedings, trials, or retrials or the Patent Register may only be taken out in any of the following conditions:

1. Where documents relating to patent applications or examinations are taken out for the purpose of searching prior art, and etc. under Article 58

(1) or (2);

2. Where documents relating to patent applications, examinations, opposition proceedings, trials, and retrials or the Patent Register are taken out for the digitization of patent documents under Article 217(2)(i);

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

(2) No opinion, testimony, or answer to an inquiry may be given regarding a case for which a patent application, examination, opposition proceeding, trial, or retrial is pending, or regarding a decision or trial decision on whether to grant or refuse a patent, or regarding the details of a decision.

Article 226 (Divulgence of Confidential Information, etc.)

Any current or former employee of the Korean Intellectual Property Office or the Korean Intellectual Property Trial and Appeal Board who divulges or misappropriates confidential information he/she has become aware of regarding an invention of a pending patent application(including an invention of a pending international patent application) in the course of performing his/her duties shall be subject to imprisonment for not more than five years, or to a fine not exceeding 50 million won.

Article 226-2 (Executives and Employees of Specialized Agencies, etc. Deemed Public Officials)

Any current or former executive or employee of a specialized agency designated under Article 58 (1), or an agency for digitization of patent documents shall be deemed a current or former employee of the Korean Intellectual Property Office or the Korean Intellectual Property Trial and Appeal Board for the purposes of 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 request 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 Trial and Appeal Board shall not allow the inspection of documents relating to a patent application which have not been registered or disclosed yet and the documents relating to an appeal to the decision to reject the patent application or in case allowing the inspection of such documents would contravene public order or morality.

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

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. Referencing of Document

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

Referencing of the documents can be made in the following cases:

- ① A power of attorney where a patent-related proceeding is conducted by a 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 representative of more than two parties involved
- ⑤ Evidential documents of a successor in title where a person succeeding a patent right conducts proceedings of patent application, request, etc.
- ⑥ Evidential documents where a person conducting a patent-related proceeding needs permission, approval, agreement, or consent from a third party in conducting proceedings for patent applications, requests, etc.
- ⑦ Evidential documents if a patent-related proceeding is conducted by a juristic person, or a certificate of nationality or evidential documents submitted by a national of a non-member state to the Treaty where a foreigner conducts a patent-related proceeding
- ⑧ Evidential documents where a person conducting a patent-related proceeding 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 refer to the documents shall be stated in the box for attached documents. The intention of referencing shall be stated as in the following example.

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

(2) Where a person conducting a patent-related proceeding intends to make

reference to the already-submitted evidential documents, he/she can state the intention of referencing 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 representative who has made a notification of appointment of a representative under Article 5(2) of the Enforcement Rules of the Patent Act conducts a patent-related proceeding within the scope of the power of attorney

② Where a representative who has made a registration of general power of attorney under Article 5(2)(2) of the Enforcement Rules of the Patent Act conducts a patent-related proceeding 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. 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 Trial and Appeal Board. 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 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.

PART II. Patent Application

Chapter 1. Patent Application

1. Relevant Provisions

Article 33 (A Person Entitled to a Patent)

(1) A person who makes an invention or his/her successor shall be entitled to a patent under this Act: provided, however, that no employee of the Korean Intellectual Property Office or the Korean Intellectual Property Trial and Appeal Board is entitled to a patent while in office, except by inheritance or bequest.

(2) If at least two persons jointly make an invention, they are jointly entitled to a patent thereon.

Article 34 (Patent Applications Filed by Unentitled Persons and Protection of Legitimate Right-Holders)

If a patent is refused to be granted for a patent application filed by a person who is not an inventor nor a successor in title to an entitlement to a patent (hereinafter referred to as "unentitled person") pursuant to subparagraph 2 of Article 62 on the ground that the person is not entitled to a patent under the main body of Article 33 (1), the patent application filed by a legitimate right-holder subsequent to the patent application filed by the unentitled person shall be deemed filed on the date of filing of the patent application by the unentitled person: Provided, That the foregoing shall not apply where the legitimate right-holder files a patent application 30 days after the date when the patent application filed by the unentitled person is rejected.

Article 35 (Patents Granted to Unentitled Persons and Protection of Legitimate Right-Holders)

If a trial decision invalidating a patent pursuant to Article 133 (1) 2 becomes final and conclusive on the ground of the lack of the entitlement to the patent under the main body of Article 33 (1), the patent application filed by the legitimate right-holder subsequent to the patent application filed

by the unentitled person shall be deemed filed at the time the application for the invalidated patent is filed: Provided, That the foregoing shall not apply where the legitimate right-holder files a patent application 30 days after the date the trial decision becomes final and conclusive.

Article 37 (Transfer, etc. of Entitlement to Patent)

- (1) An entitlement to a patent may be transferable.
- (2) An entitlement to a patent shall not be pledged.
- (3) If an entitlement to a patent is jointly held by at least two persons, a joint holder may transfer his/her share with the consent of each of the joint holders.

Article 38 (Succession to Entitlement to Patent)

- (1) The successor to an entitlement to a patent of which the transfer is made before the filing of a patent application shall have no valid claim or defense against a third party, unless the successor files a patent application.
- (2) If at least two persons succeed to an entitlement to an identical patent from the same person, and if at least two applications for the patent are filed on the same date, the succession to the entitlement to the patent shall be effective only for the person agreed upon by patent applicants.
- (3) If at least two persons succeed to an entitlement to a patent and the registration of a utility model on an identical invention and utility innovation from the same person, and if at least two applications for the patent and for registration of the utility model are filed on the same date, the succession shall be effective only for the person agreed upon by the applicants for the patent and for registration of the utility model.
- (4) No succession to an entitlement to a patent made after a patent application has been filed shall be effective, unless a notice of the change of the patent applicant is filed, except for succession by inheritance or other universal succession.
- (5) The successor to an entitlement to a patent by inheritance or other universal succession shall notify the Commissioner of the Korean Intellectual Property Office of the succession without delay.

(6) If at least two persons succeed to an entitlement to an identical patent from the same person, and if at least two notices of the change of the patent applicant are filed on the same date regarding such entitlement, the report shall be effective only for the person agreed upon by the persons who have filed the notices.

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

Article 44 (Joint Applications)

Where the entitlement to a patent is jointly held by at least two persons, all entitled persons shall jointly file a patent application.

2. Inventor

(1) An entitlement to a patent is a right which an inventor owns 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 entitlement to a patent shall originally belong to an inventor upon creating an invention without any measures taken.

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 entitlement to a patent shall be jointly owned.

Where the application is filed by a person who is not entitled to obtain a patent for the invention 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 carry out a patent-related proceeding through a legal representative, they

can obtain a patent. To be legally treated as an inventor, he or she should make substantial contributions to creation of technical ideas.

① Cases where who should be treated as an inventor

(Ex1) Who newly presents or adds or supplements concrete conception of ideas to solve technical problems of the invention

(Ex2) Who embodies or reduces to practice novel ideas through an experiment, and etc.

(Ex3) Who provides specific means and methods to achieve the purpose and the effects of the invention

(Ex4) Who contributes to the invention through concrete advice and guidance

② Cases where who should not be treated as an inventor

(Ex1) Who simply provides basic technical problems to be solved and ideas with respect to the invention

(Ex2) Who generally manages a researcher

(Ex3) Who arranges a set of data and conducts experiments according to the directions of a researcher

(Ex4) Who supports and entrusts the creation of the invention by providing fund and equipment

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

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 in Title

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

3.1 Procedure for Succession to entitlement to a Patent

(1) Where the entitlement to obtain a patent is transferred before filing a

patent application, no special proceedings for succession of the entitlement is not required to be taken. However, the succession of the entitlement to obtain a patent after filing an application shall be effective when a notice of change of the applicant is filed, except for universal succession.

Meanwhile, the successor who received the transfer of the entitlement to a patent before a patent application is filed shall file a patent application first in order to make a valid claim on the entitlement against a third party

(2) Where the entitlement 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 a notice of change of right relations in Annexed Form 20 of the Enforcement Rules of the Patent Act before the registration of the concerned application together with each copy of the following documents: the evidential document stating the grounds for change of applicant; the evidential document of permission/approval/agreement/ consent from a third party, if necessary; or the document proving the power of a representative if a patent-related proceeding is carried out by a representative.

Where notices of change of applicant on more than two patent applications are to be filed, just one notice 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 register interests in right of applicants or successors, or where there exists a contract stating that the patent-related rights shall not be divided 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 patent application or a notice of change of right relations and submit the evidential documents.

(Note) Even when the interest in patent-related rights owned by applicants

is to be changed, a copy of the evidential document of the ground for change of interest or a copy of the document proving the power of a representative if a patent-related proceeding is carried out by a representative shall be attached to a notice 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 conducted a patent-related proceeding is deceased and the entitlement to obtain a patent has been inherited, the proceeding is interrupted under Article 20(1) of the Patent Act. Therefore, an inheritor shall resume the interrupted proceeding 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 proceeding 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 entitlement to obtain a patent is prescribed under the provisions of Part 5. Inheritance of the Civil Act.

(5) Where the entitlement to obtain a patent is transferred through bequest, a person with 'all-inclusive bequest' can resume the interrupted proceeding 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 entitlement to 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 Article 1078 of the Korean Civil Act. Therefore, the person shall acquire the 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 entitlement to obtain a patent jointly owned has an aspect of partnership-ownership. Therefore, in the cases of joint ownership of the entitlement to obtain a patent, each joint owner shall not transfer his/her interest without the consent of the other joint owners.

(Note) Joint-ownership refers to the sharing of a property right by two or more owners. In general, the jointly-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 a property right refers to the ownership of property right by several persons through partnership relationship. The person having partnership-ownership cannot transfer his/her share of property to another person without the consent of the other persons in the partnership. In other words, joint-ownership is a temporary 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 based on the same entitlement to a patent succeeded 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 regardless of time of the succession.

(2) Where two or more applications relating to the same invention are filed on the same date based on the same entitlement to a patent succeeded from the same person, only the succession to the entitlement to obtain the patent to one applicant mutually agreed upon by all the patent applicants, shall 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 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 all 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 with the evidential document of the consultations attached to the notice 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 proceeding is conducted by a representative, the result of consultations shall be submitted to the Commissioner, attached with a copy of the evidential document of the 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 based on the same entitlement to obtain a patent succeeded from the same person, the notice made by one person mutually agreed upon after consultations among all the persons who made notices, shall 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 report on the result of consultation is made within the designated period, it shall be deemed that no agreement is reached. Where no agreement is reached, the examiner shall not notice the grounds for rejection, but conduct the examination as if no reports of change of applicant have been filed.

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 proceeding is conducted by a representative, the result of consultations shall be submitted to the Commissioner attached with a copy of the evidential document of the 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 legitimate Holder of Right

The Korean Patent Act extends a greater protection to inventors, etc. with the provision for protection of a legitimate holder of the right, even when an unentitled person filed a patent application before a legitimate 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 legitimate holder of the right indicating that where a patent application is rejected or a patent is invalidated due to the lack of entitlement, a subsequent application filed by the legitimate holder of the right shall not be rejected. In such a case, 'an unentitled person' refers to a person who is neither the inventor nor the successor to the entitlement to obtain a patent. In other words, a person who failed to succeed the entitlement to obtain a patent in a legitimate manner, but acts as if he or she is the legitimate 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 entitlement to a patent from the person who filed a misappropriated application are unentitled persons.

4.1 Measures for Protection of Legitimate holder of Right

In order for a legitimate holder of the right to be protected after a patent application was filed by an unentitled person, the legitimate holder shall file an application for the same invention under Article 34 or 35 of the Patent Act. The legitimate 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 legitimate holder of right as well as the evidential document of representation (in case of the presence of a representative).

4.2 Effect of Application filed by Legitimate Holder of Right

(1) An application filed by a legitimate 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 to reject a patent is made because the application was filed by an unentitled person and a subsequent application was filed by a legitimate holder of the right; provided, however, that this shall not apply where the subsequent application is filed more than 30 days after the decision to reject a patent becomes final and conclusive.

② Where a trial decision invalidating a patent on grounds of the lack of entitlement has become final and conclusive and a subsequent application was filed by a legitimate holder of the right after the initial application was filed by the unentitled person; provided, however, that this shall not apply where the subsequent application is filed more than 30 days after the trial decision of invalidation becomes final and conclusive.

The patentability, calculation of the patent term and application of relevant provisions for an application filed by a legitimate 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 legitimate holder of the right, the application filed by the legitimate 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 legitimate 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 legitimate holder of the right.

(Note) In order to protect a legitimate 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 entitlement to a patent or utility model registration shall, in applying paragraphs (1) through (3), be deemed never to have been filed.

(2) Even when the application was filed by a legitimate holder of the right more than three years (5 years for the patent application filed before '17.3.1.) 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 legitimate 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 legitimate 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 legitimate holder of the right to be deemed legitimate, the invention disclosed in the 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 legitimate holder of the right is out of scope of the invention (where multiple inventions are included in the application filed by a legitimate holder of the right but only some of the inventions are disclosed in the application filed by an unentitled person), the filing date of the application by the legitimate holder of the right shall have no retroactive effect.

(4) Where a patent is granted to a legitimate holder of the right under Articles 34 and 35 of the Patent Act, the term of a patent owned by the legitimate 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 legitimate holder of the right is registered.

(5) As for an application filed by an unentitled person who has provided the reason for a legitimate 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 to reject. Also, after the decision to reject has become final and conclusive, the examiner shall notify the legitimate holder of the right of the decision in writing according to Article 33 of the Enforcement Rules of the Patent Act.

(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 entitlement 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. Care should be taken to ensure that an examiner of the Korean Intellectual Property Office should not grant a patent to a KIPO examiner when he or she files a patent application while he is working for KIPO. The identity of the patent applicant can be confirmed by checking the history of the patent application on the PatentNet or pop-up window displaying when granting a patent. As for the patent application filed by a KIPO examiner, an examiner shall reject the patent application by notifying the applicant of a ground of rejection in violation of Article 33(1) of the Patent Act of Korea. However, where employees of the Korean Intellectual Property Office transfer the entitlement to obtain a patent for the invention to a third party after filing an application or where a KIPO employee retires from the office after filing a patent application or where a KIPO employee files a patent application within 2 years after retirement or where an employee of the KIPO's affiliated organization, e.g. a prior art search institution, files a patent application while he is working for the institution, the examiner responsible shall request search for the patent application to an outside prior art search institution and then perform examination accordingly. If it is confirmed that the patent application in question can be granted a patent, three examiners consult each other to perform examination of the patent application and finally decide whether to allow or reject the patent application.

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

Chapter 2. Patent Application Documents

1. Relevant Provision

Article 42 (Patent Applications)

(1) A person who intends to obtain a patent shall file a patent application cover sheet stating the following information with the Commissioner of the Korean Intellectual Property Office:

1. The name and domicile of the patent applicant (if the applicant is a corporation, its name and place of business);
2. The name and the domicile or place of business of an agent, if the patent applicant is represented by an agent (if the agent is a patent firm or limited-liability patent firm, its name and place of business, and the name of the patent attorney designated for the case);
3. The title of the invention;
4. The name and domicile of the inventor.

(2) A patent application cover sheet filed under paragraph (1) shall be accompanied by a specification containing the description of the invention and the claims, necessary drawings, and an abstract.

Article 43 (Abstract)

An abstract referred to in Article 42 (2) shall be used only for technical information, and shall not be used to define the scope of the invention for which patent protection is sought.

2. Application Cover Sheet

(1) In principle, a person who completes an invention is entitled to obtain a patent for the invention. However, the act of completing an invention does not necessarily guarantee granting of a patent. Inventors, too, should carry out subsequent proceedings 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 cover sheet, a specification, drawing(s) and abstract and instructions on what and how to fill out such documents. The principle on submission of application documents shall apply to original applications as well as divisional or converted applications.

(2) An application cover sheet is a document containing the essential information on a patent application including information on a patent applicant, the person who carries out the proceeding of filing the application (a patent applicant or a representative), the indication of intent to obtain a patent, and notices of other matters.

The patent application cover sheet includes information on 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 firm); ③ the title of the invention; ④ the name and the domicile of an inventor and so on. Also, the applicant code, priority claim, claim on grace period disclosure exception and request for examination shall be indicated in a patent application cover sheet.

(3) The title of the invention in a patent application cover sheet shall be written briefly and concisely according to the subject matter of the invention relevant to the application. The title of the invention in a patent application cover sheet shall be identical with that in a specification.

(4) An inventor indicated in a patent application cover sheet refers to the actual inventor who has made the invention related to the application and the person who holds the right to be indicated as the inventor 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 include an abstract.

The abstract is required for efficient use of patent information in response to an ever-increasing number of applications filed and the sophistication of technical matters. Disclosing of the abstract at the time of filing the application allows a person who intends to utilize the information to easily search the abstract.

(2) An abstract cannot be used to define the scope of the patent protection. Under Article 97 of the Patent stipulates that the scope of patent protection shall be determined by the subject matters described in the claims. Moreover, unlike a specification considered for determining the scope of patent protection, 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 included in a patent application, the concerned application proceeding shall be subject to request for amendment. Even when an abstract is poorly prepared 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 deficiencies are not addressed despite a request for amendment, an examiner may invalidate the concerned application proceeding in accordance with Article 16 of the Patent Act.

(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 requirements for the description of an invention and the claims which constitute a specification to accomplish the role of a specification as a right document and a technical document. Guidelines on preparing the description of an invention and the claims shall be referred to Chapters 3 and 4.

(2) A specification included in a patent application at the time of filing shall contain the description of the invention and the claims according to Article 42(2) of the Patent Act. If necessary, the claims may not be submitted at the time of filing an application. However, it shall be submitted through amendment within the period specified under Article 42-2(2) of the Patent Act.

(3) The title of the invention included in a specification shall be stated briefly and concisely based on the subject matter of the invention as in the following:

① An ambiguous or wordy description shall be avoided and the title of the invention shall be stated briefly and concisely based on the subject matter of the invention.

(Example) Where the title should be 'a device of preventing vibration in a dehydrating barrel of a centrifugal dehydrator', titles such as 'a centrifugal dehydrator' or 'a centrifugal dehydrator in which the dehydrating barrel does not vibrate when the power is turned on' are inappropriate.

② The name of a person, trademark, nickname of a product, expression indicating only 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 the claims include 2 or more claims directed to different categories(product, manufacturing process, manufacturing device, usage, etc.) , the brief and concise title encompassing such multiple categories shall be used.

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

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 a subject matter of 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 in the application cover sheet.

Where the title of the invention included in the specification is different from that of the application cover sheet or is inappropriate, the examiner shall notify the applicant of the inappropriateness of the title of the invention, along with the ground for rejection if any,. 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 application cover sheet *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 proceeding 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 to reject even though it is indicated in the notice of grounds for rejection.

(Note) Where the English title of the invention included in the application cover sheet or the specification for 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 section for the brief description of drawing(s), what each drawing displays 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 in 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 described in a specification.

Drawings attached to a patent application cover sheet shall be prepared according to the guideline for drawings of Annexed Form No. 17 of the Enforcement Rules of the Patent Act. Where drawings are difficult to be prepared according to 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 include drawings when necessary. However, an application for utility model registration must include 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 the error in attachment of drawings, leads 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 practice 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 to reject.

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

Chapter 3. Description of Invention

1. Relevant Provision

Article 42 (Patent Applications)

(3) A description of an invention under paragraph (2) shall satisfy all of the following requirements:

1. To describe the invention with such clarity and in such detail that any person skilled in the art to which the invention pertains can easily practice the invention;
2. To describe the background technology for the invention.

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

③ The description of an invention under Article ①(1) shall include the followings:

1. The title of the invention
2. The technical field
3. Background Art
4. The summary of the invention in which the following sections are included
 - a. The technical task to be solved
 - b. The solution means
 - c. The effects of the invention
5. Brief description of the drawing(s)
6. Detailed description for practicing the Invention
7. Other necessary matters for a person with ordinary skill in the art to easily understand the invention

④ The sections mentioned in ③(2),(4),(5),(7) may be omitted where no corresponding descriptions can be filled out.

2. Enablement Requirement

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

2.1 Subject of Practicing the Invention

In determining whether the description of an invention fulfills the requirements under 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 pertains(hereinafter referred to as a person skilled in the art).

2.2 Definition of 「Easily practicing the Invention」

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

(2) The invention that a person skilled in the art must be enabled to practice shall be interpreted as the invention recited in the claims. Therefore, where an invention only disclosed in the description of the invention, but not in the claims, is not described enough for a person skilled in the art to be enabled to practice, it does not violate Article 42(3)(i) of the Patent Act.

(3) 'Easily practicing' means that a person skilled in the art to which the invention pertains fully understands the invention and reproduces it with the level of skill in the art at the time of filing the application based on the

specification, without adding special knowledge and undue trial and error or repetitive experimentation.

2.3 Examination Process

2.3.1 Basic Consideration

(1) Product Invention

① Where a product invention is recited in the claims, the description of the invention shall contain the clear and full explanations on the invention so that a person skilled in the art is enabled to produce the product. In general, to make manufacturing a product possible, the manufacturing method needs to be fully described (Except for the case where the product can be manufactured based on the specification and drawings with the level of skill in the art at the time the application is filed even in absence of the description of the manufacturing method). Also, the concerned product needs to be fully grasped from the whole disclosure in the 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 defined in the claims. In order for a product to be able to be used, 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 on a use of the product, the product can be used based on the specification and drawings with the level of skill in the art at the time of the application is filed.

(2) Method Invention

Where a method invention is recited in the claims, the description of the invention shall contain the clear and full explanation on the invention so that a person skilled in the art is enabled to use the method. In general, to make using a method possible, the method needs to be fully grasped from the whole disclosure in the description of the invention and the roles and

sequences of each step that specifies the process shall be described together.

(3) Manufacturing method Invention

Where a manufacturing method invention is recited in the claims, the description of the invention shall contain the clear and full explanation on the invention so that a person skilled in the art is enabled to produce a product with the manufacturing method. In general, to make manufacturing a product based on its manufacturing method possible, the manufacturing method itself needs to be fully grasped from the whole disclosure in the description of the invention and the roles and sequences of each step that specifies the manufacturing method shall be described together.

The manufacturing method 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 described. The product manufactured through the concerned method shall be clearly described, except for the case where the product not explicitly described is easily understood based on the raw materials or detailed manufacturing steps.

2.3.2 Special Cases

(1) Chemical Substance Invention

The description of chemical substance invention is not usually enabling only with the name of the concerned chemical substance or the chemical formula. It is because chemical reaction which is expected to induce the certain chemical substance, in reality, would never happen because of unexpected reactions 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 method 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 skill in the art at the time of the application is filed.

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

(2) Use (Medicine) Invention

Even though chemical inventions may vary according to the subject matter of the concerned invention and the level of skill in the art 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 reproduce the effect of the chemical invention unless the experimentation example containing the experimental data is not stated due to low predictability or reproducibility.

Therefore, chemical substance use invention can be deemed to be completed and at the same time, the description requirement of specification can be deemed to be met when the effect of the invention is disclosed in the description of the invention. Especially, as for medicinal use invention, description of medical data proving that the medicine of the invention has a certain medical effect or description detailed enough to replace such medical data shall be disclosed except for the cases such that the medical mechanism arising the medical effects described in the specification is clearly known prior to the filing of the application.

(3) Parameter Invention

① The term “parameter invention” refers to an invention including, as a part of the elements of the invention, a parameter which an applicant arbitrarily creates for indicating a certain physical-chemical characteristic and which is not generally used in the pertinent art or which is defined as the

mathematical combinations of the multiple variables in the form of formulae. In order for a parameter invention to be easily practiced, the technical content of the parameter shall be described in such a detail that a person skilled in the art can understand the detailed method of realizing the invention, the technical objective of the invention as well as the technical solution.

② The detailed technical content of the parameter to enable easy practice of 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 range when the numerical limitation of the parameter is included, (iii) the explanation on the method, condition and 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 description of the invention or drawing(s), where the content can be clearly understood considering the level of skill at the time of application filing, an examiner shall not decide that the invention cannot be easily practiced based on the above-mentioned ground.

2.4 Relationship with Lack of Description Requirement for Claims

Since the enablement requirement and the requirement that the claimed invention should be supported by the 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 skill 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 description of

the invention. Article 42(4)(i) of the same act applies when the claimed invention is not disclosed in the description of the invention or is out of scope of the description of the invention that a person skilled in the art easily recognizes.

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

(1) Article 42(4)(i) shall apply where the claims are directed to the generic invention(genus) and the description of the invention does not disclose the generic invention but only the species invention, and the generic invention cannot be clearly recognized from the species invention disclosed in the description of the invention.

Article 42(3) of the Patent Act shall apply, too, where the description of the invention discloses only a specific embodiment of the invention and, therefore, other embodiments of the invention which fall within the scope of the generic claims cannot be easily practiced.

Meanwhile, Article 42(4)(i) of the Patent Act shall apply where the claims recites the species invention and the description of the invention discloses the generic invention and the species invention recited in the claims is not clearly recognized from the description of the invention. Article 42(3)(i) of the Patent Act shall also apply, where the species invention recited in the claims cannot be easily practiced based on the description of the invention.

(Example 1) Where the claims are directed the extrusion molding method of plastic materials, but the description of the invention briefly mentions the

method of applying extrusion of plastic materials but describes in detail the manufacturing process of edible plastic material of agro-fisheries products whose main components are carbohydrate or protein 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 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 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 electroreduction”, but the claims recite “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 directed to the generic invention compared to the embodiment in the description of the invention and the generic invention of the claims is not disclosed in the description of the invention, an examiner shall notify the ground for rejection in violation of Article 42(4) (i) of the Patent Act on the grounds that the claims are not supported by the description of the invention.

(2) Where a Markush grouping is used in the claims and the description of the invention discloses only embodiments related to some of constituents of the Markush group recited in the claims and, although the rest of the constituents of the Markush group is mentioned in the description of the invention, their embodiments for the rest of the constituents are not disclosed so that a person skilled in the art cannot easily practice the invention, an examiner shall notify a ground for rejection citing the violation of Article 42(3) of the Patent Act.

(Example) Where the claims are directed to 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 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) based 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 description of the invention discloses a certain embodiment for practicing the invention and the embodiment of the invention related to the claims is deemed to be different from the embodiment disclosed in the 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 practiced only with the embodiments disclosed in the description of the invention.

(4) Where the terms used in the 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 recited in the claims is not supported by the description of the invention.

3. Description Method Requirements

Violation of description method requirements shall constitute a ground for rejection or a ground for invalidation as for the application filed before December 31, 2014, but for the application filed after January 1, 2015, it shall be subject to amendment.

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 skill in the art 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 description of the invention should include what unresolved tasks are left in what technical field and how the tasks are solved with which means. This is the method of description generally adopted by many countries around the world in terms of writing a specification.

The description method requirement was introduced 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 provides the arrangement of the description of the invention for enabling examiners or third parties to easily understand what technical advances the invention would bring, including the title of the invention, the technical field, background art, the technical objectives that the invention intends to achieve, the means for solving technical problems, the effects of the invention, brief description of the drawing(s), detailed descriptions for practicing invention and other necessary contents for a better understanding of the invention by a person skilled in the technical field to which the invention pertains.

However, the above-mentioned sections do not need to be separately prepared. Where the contents to be described in such sections are understood from the overall content of the description of the invention, it shall be deemed sufficient.

(3) Where an invention for which patent protection is sought is such that some of the sections specified under the Enforcement Rules of the Patent Act cannot be filled out, the concerned sections may be omitted.

For example, where a method of composing a new substance is invented by chance, if the new substance or the composing method can be well understood from the description without any description on the technical objectives that the invention intends to achieve and solution means, omission of those sections shall not be deemed to be the violation of the description method requirement of the description of the invention.

3.2 Detailed Method of Description

In principle, the description of the invention shall contain the following sections: [The title of the invention] , [Technical Field] , [Background Art] , [Prior Art Literature] , [Brief description of the drawing(s)] , [Summary of Invention] , [Detailed Description for Practicing Invention] , [Industrial Applicability] , [Consignment Number] and [Sequence Listing Free Text] . The description for each section shall be clear and precise enough for a person skilled in the art to easily understand the invention and reproduce it.

Under the interpretation of the provisions of Article 42(2) of the Patent Act the term “the description of the invention” refers to the rest of the sections beside the Claims, among all the sections included in the specification submitted by an applicant being attached to the cover sheet.

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.

3.2.2 Summary of Invention

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

(1) In the subsection for technical problems 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 problems to be solved based on other descriptions in a specification and the ordinary skill without any explicit description, the technical problems to be solved need not be described. Also, when technical problems to be solved cannot be assumed as in the case of an invention created based on a novel idea totally different from prior art, the description of the technical problems is not necessary.

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

Where technical problems to be solved cannot be assumed as in the case of an invention created based on a novel idea totally different from prior art, any means for solving the technical problems need not be stated.

(3) In the subsection for the effects of the invention, particular effects of the invention for patent protection is sought considered 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 Description for Practicing Invention

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

In order to figure out how the invention is being practiced, technical means for solving the problems needs to be stated. Where multiple technical means exist, how these means are inter-related 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 description for practicing the invention shall contain the functions of the technical means as well as the configuration of the invention. In fact, stating the function based on the technical field might be more appropriate than stating the configuration 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 sections for embodiments can be created and embodiments of how the invention can be practiced 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 written generically, each representative embodiment corresponding to the generic 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 generic description.

② Basic data, etc. shall be contained in the embodiments and, if necessary, comparative embodiments and alternative 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 alternative embodiments shall be specified.

③ Where embodiments are described by using drawings, reference numbers of the corresponding section on the drawings shall be indicated in parenthesis after the technical terms.

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

Also, where the invention for which patent protection is sought is described by using experiment data, test methods, test/measurement tools and test conditions shall be described in detail so that a person skilled in the art can easily reproduce the experiment results.

Where materials or devices hard to obtain are used to practice the invention, the manufacturing process or the source for obtaining them 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 applicable, the method of industrial applicability, manufacturing method or utilization method shall be stated in the section for [Industrial Applicability] .

When industrial applicability can be well inferred from other descriptions of the specification, additional description on industrial applicability may not be necessary.

4. Requirement for 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 prior art, if possible. However, a ground for rejection is not noticed even if the background art is not described.

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 description of the invention shall disclose the background art of the invention. If an applicant fails to disclose the background art in the 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 conventional art deemed beneficial in understanding technological implications of the invention and conducting prior art searches and examination.

4.2 Description Requirement for 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 limitations recited 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 problems to be solved by the invention, solutions to the technical problems and the effect of the invention.

(2) An applicant shall disclose the detailed explanation on the background art in the section [Background Art] of the 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 notice of ground for rejection can be followed (See Part 5, Chapter 3, 「5.5 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 assumed since the concerned invention is developed based on novel ideas totally 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 Examples 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 described

Where the section [Background Art] and the whole 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 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:

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 to be solved by the invention, solution to the technical problem and so on, like the case where claims is directed to “a suction nozzle of a vacuum cleaner for reducing noise”, but the section [Background Art] only discloses background art related to a cleaner with detachable wet mop

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

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

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

Where conventional art such as the technical field of the invention for which patent protection is sought is disclosed as background art, but it merely describes basic technology, it 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 problems to be solved by the invention and the technical solution disclosed in the specification.

However, in order to notify the ground for rejection citing the violation of Article 42(3)(ii) of the invention 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 obtained. Where an examiner knows the prior art literature disclosing proper background art, the examiner may suggest such prior art literature at the time of notice of the ground for rejection.

(Example 1) Where an applicant files an application of 'a suction nozzle of vacuum cleaner for reducing noise' but only discloses the general technical knowledge of vacuum cleaners in the section [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 to be solved or the technical solution of the invention exist and can be easily searched through conventional search systems, it shall not be deemed to meet the requirements for the disclosure of the invention and therefore, the invention shall be subject to notice 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 meet the requirements for the

disclosure of the invention and therefore, the invention shall be subject to notice 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 section [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 notice 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 Section [Background Art] .

4.4 Notice 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 providing information concerning Patent Applications (Article 63-2) or a ground for invalidation (Article 133(1)).

4.5 Response taken by Applicant to Notice 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 to describe background art of the invention, an applicant shall respond to the notice by making an amendment of addition of information on prior art literature disclosing proper background art in the section [Background Art] or the section [Prior Art Literature] . In such a case, it is deemed appropriate to submit a written argument 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. 10-0000-0000000 (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. 10-0000-0000000 (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 notice by explaining such intention in a written argument to the notice of the ground for rejection.

5. Other Instructions

(1) Except for the specification written in a foreign language according to Article 42(3)(i) of the Patent Act of Korea, where the terms disclosed in a specification are not written in Korean so that the description is 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 without 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 from a patent application written in a foreign language, only when failure to meet description requirements is found from 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 due to an error in translation the invention of the application has become different from that of the application filed in a first country or the content of the description in the specification has become unclear, an examiner shall not notify a ground for rejection based solely on 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 original specification of the application claiming priority under the Treaty is added, or ② the invention impossible to be practiced only with the disclosure of the specification of the application claiming priority under the Treaty has become possible to be practiced. Since the addition of new matters is highly likely, an examiner shall examine the application thoroughly.

(3) Where an invention cannot be easily practiced since the different technical terms are used in the description of the invention, 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 description of the invention and the claims are different, or the technical terms recited 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 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 obtained; 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

(1) When an examiner intends to notify a ground for rejection citing the violation of the enablement requirement and description method 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 description of the invention is provided pursuant to Article 21(3) of the Enforcement Rules of the Patent Act, but the description is not clear and detailed enough for the invention recited in the claims to be easily practiced, an examiner shall notify a ground for rejection only based on Article 42(3) of the Patent Act.

(3) Where the description of the invention does not satisfy both the enablement requirement and the description method requirement as for the application filed before December 31, 2014, an examiner shall notify a ground for rejection based on Article 42(3)(i) of the Patent Act and Article 21(3) of the Enforcement Rules of the Patent Act of Korea. However, as for

the application filed after January 1, 2015, the examiner shall notify the applicant of a ground for rejection according to Article 42(3)(i) of the Patent Act of Korea and propose amendment to the application according to Article 46 of the Patent Act of Korea.

Meanwhile, where the description method requirement under Article 21(3) of the Enforcement Rules of the Patent Act is violated, but all of the inventions recited in the claims can be easily practiced with the description of the invention, the description shall be deemed to be legitimate.

Chapter 4. Claims

1. Relevant Provisions

Article 42 (Patent Applications)

(4) Claims referred to in paragraph (2) shall state at least a claim to be protected (hereinafter referred to as "claim"), and each claim shall satisfy all of the following requirements:

1. The claim shall be supported by the description of the invention;
2. The claim shall set forth the invention clearly and concisely.

(5) Deleted.

(6) Claims referred to in paragraph (2) shall set forth the structures, methods, functions, and materials, or combinations thereof which the applicant regards necessary to distinctly define the invention to be protected.

(7) Deleted.

(8) Matters necessary for the methods of stating the claims under paragraph (2) shall be prescribed by Presidential Decree.

(9) Matters necessary for the methods of stating the description of the invention, drawings, and an abstract under paragraph (2) shall be prescribed by Ordinance of the Ministry of Trade, Industry and Energy.

Article 5 of the Enforcement Decree of the Patent Act (Methods of Stating Patent Claims)

(1) The claims under Article 42 (8) of the Act (hereinafter referred to as "claims") shall include an independent claim (hereinafter referred to as "independent claim") and may include a dependent claim which narrows or adds further limitations to specify the independent claim (hereinafter referred to as "dependent claims"). If it is necessary, other dependent claims may be included to narrow or add further limitations to specify such dependent claims.

(2) The number of claims shall be reasonable to the nature of the relevant invention.

(3) Deleted.

(4) A claim that refers to another claim shall state the number of the claim being referred to.

(5) A claim that refers to more than one other claims shall refer to such other claims in the alternative.

(6) A multiple dependent claim shall not serve as a basis for any other multiple dependent claims. The same shall apply where a multiple dependent claim refers to a claim which in turn refers to another multiple dependent claim.

(7) The claim from which other claim depends shall come ahead of such other claim.

(8) Each claim shall be entered on a new line, and serial numbers in the Arabic figure shall be given in the order of the entries.

2. Recognition of Invention

Claims hold significance in that the scope of protection of a patent right is determined based on the claims. Where the claims do 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 these points.

The invention recited in the claims are those that an applicant regards as his or her invention for which patent protection is sought among the inventions disclosed in the description of the invention according to the description method of the claims under Article 42(4) and (8) of the Patent Act. Therefore, the determination of the invention for which patent protection is sought shall be made based on the limitations recited in each of the claims in accordance with the applicant's will. The description of the invention or the disclosure in drawings shall be considered only when the claims are indefinite or the definition and meaning of the technical terms are ambiguous. The determination of the invention for which patent

protection is sought should not be made based on the invention disclosed in the description of the invention beyond the limitations 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 Description of Invention

The description of the invention serves as a written technical disclosure. When an invention not disclosed in the description of the invention is recited in the claims and is granted a patent, it would lead to an unfair result that the invention not disclosed to the public is granted a patent right. To avoid it, Article 42(4)(i) of the Patent Act specifies that the claims shall be supported by description of the invention.

Under the interpretation of Article 42(2) of the Patent Act, the description of the invention refers to the rest of the sections other than the claims among the sections included in the specification attached to the patent application cover sheet submitted by the applicant.

(1) An examiner shall determine whether an invention recited in claims are supported by the description of the invention based on whether a person skilled in the pertinent art can figure out the subject matters corresponding to the invention recited in the claims are disclosed in the description of the invention.

Whether the corresponding subject matters are disclosed in the description of the invention shall be determined by reviewing whether an invention departing from the scope grasped by a person skilled in the pertinent art based on the description of the invention is recited in claims rather than by literal identicalness between the claims and the description of the invention, considering the purport of Article 42(4)(i) of the Patent Act.

(2) Cases where an invention recited in the claims is not supported by the description of the invention include the followings:

① Where the subject matters or the limitations of the claims are neither disclosed nor implied in the description of the invention

(Example 1) Where specific numerical limitation is recited in claims, but such numbers are not disclosed in the description of the invention

(Example 2) Where the claims are directed an invention using an ultrasonic motor, but the description of the invention does not disclose the invention using the ultrasonic motor, but only discloses an invention using a direct current motor

However, where the 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 practicing the invention using an ultrasonic motor is possible based on the level of skill in the art at the time of application filing, the claims shall be deemed to be supported by the description of the invention.

② Where the terms used in the claims are different from those used in the description of the invention so that the correspondence between the description of the invention and the claims is ambiguous

③ Where the claims recite means or steps to perform particular functions, but specific configuration corresponding to such means or steps is not disclosed in the description of the invention

④ Where the disclosure of the description of the invention cannot be extended or generalized to the scope of the claimed invention based on the level of skill in the pertinent art at the time of application filing

(Example 1) Where a claim defines an invention in terms of the technical effects to be achieved, for example in terms of the scope of energy efficiency to be achieved, but the description of the invention only discloses the embodiment regarding specific means and it is deemed that the disclosed embodiment cannot be extended or generalized to the entire

scope of energy efficiency of the claimed invention even in consideration of the level of skill in the pertinent art at the time of application filing.

(Example 2) Where claims recite particular medicine with chemical compounds defined by preferred quality as effective properties, but the 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 skill in the art at the time of application filing

(Example 3) Claim 1 describes the composition as 'selective inhibitor of collagenase-3' and 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 collagenase-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 description of the invention as well as all the chemical materials meeting the above-mentioned requirement. However, the 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 skill in the art as of filing date. In such a case, claim 1 is not supported by the description of the invention.

⑤ Where claims do not recite the features explained as indispensable features to solve the technical problem in the 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 description of the invention

(Example) Where the 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 the claims recite the stuffing as just 'cream' which is deemed as fatty substance separated from milk regardless of water content.

(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

When a patent is granted to an invention whose description in claims is not clear or concise, the claims cannot serve the function of determining the scope of protection of the patented invention nor the function of providing a clear measure of what the applicants regard the invention so that it can be determined whether the claimed inventions meet the requirements of patentability. 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 set forth clearly and concisely shall be determined by a person skilled in the art to which the invention pertains based on the claims in light of the description of the invention or the disclosure of drawings as well as the level of skill in the art at the time of application filing. It should not be determined based on other parts, ignoring the claims.

(2) The requirement that an invention shall be set forth concisely does not

mean that the idea of the invention shall be concise. It means that claim language shall be concise.

(3) Cases where an invention is not set forth clearly and concisely are as follows:

① Where claim language is unclear. However, where the unclear part is a mere error in the description and the error does not lead a person skilled in the art to which the invention pertains to decide that the invention is unclear or the invention can be easily understood based on the description of the invention, drawings or the level of skill in the art at the time of application filing, the invention shall not be deemed to be unclear.

② Where each claim element is merely listed, but the relationships between the elements is not recited and therefore, the invention is unclear

③ Where the category to which the claimed invention belongs is unclear
As the Patent Act of Korea differently defines the practicing of the invention and the scope of protection depending on whether it is a product invention or it is a method invention, it is a principle that the category of the invention should be determined based on the terms or expressions used at the end of the claim, but where it is difficult to identify the category based on the subject matter of the invention, it shall be determined ambiguous. In case of a product invention, various kinds of expressions can be used to explain the structure, the function or the configurations of the product to finally define the invention. As such, in case of a method invention, to define the invention, various kinds of expressions can be used to explain the method, the act or the steps.

④ Where claim language is too lengthy, such as the repetition of the same matter, so that the subject matter for which patent protection is sought is not clear and concise

⑤ Where the claims include expressions which make the configuration of the invention unclear. However, even with the use of such unclear expressions, where the meaning thereof is clearly supported by the description of the invention and the invention is deemed to be clearly defined, the invention shall not be deemed to be unclear.

(Example 1) Where arbitrarily additional matter or optional matter is recited 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 whether to violate requirements 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 negative limitations 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 limit such as 'more than', 'less than', '0~10' or numerical limitation including 0(excluded when the composition including 0 is an arbitrary component, not necessary component) is disclosed. Or, where dual numerical limitations are disclosed within a single claim such as '120-200°C or more appropriately 150-180°C'

⇒In this context, 'arbitrary component' 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

⑥ Where the subject of indication is unclear and thus the configuration of the invention is unclear

(Example) Where many different types of gears are recited 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 configuration of the invention for which patent protection is sought is unclear since multiple technical terms of the same expression serving different functions are used in the claims without specifying different functions or indicating the corresponding reference numerals used in drawings.

⑧ Where an invention is not clear and concise since matters irrelevant of the technical configuration of the invention such as commercial benefits, regions of sale, places of sale, etc are recited.

⑨ Where the invention is defined by reference to the description of the invention or description of drawings without reciting the configuration of the invention. However, where reference to the description of the invention or description of drawings is inevitable in defining the invention, such reference 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 of the indication is not

literally identical, if it constitutes a clerical error and a person skilled in the art can understand the configuration 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 a claim recites “said OOO” and the concerned claim does not contain an earlier recitation of “OOO” and claims referred to by the concerned claim also lack antecedent basis for ‘OOO’, but the invention is clearly understood if the claims are read excluding “said” in light of the description of the invention and drawing(s)

(Example 1) Where a claim reads “in order for reference voltage to remain unchanged despite the voltage fluctuation of power supply applied through input terminal of said regulator (10), the said regulator (10) is connected to said added resistance(R6)(90)” and the claim lacks the antecedent basis for “said added resistance(R6)(90)”. However, if the claimed invention is clearly understood when read excluding “said” in light of the disclosure in the description of the invention, reading “the said regulator (10) and an added resistance (R6)(90) are connected in series in order for reference voltage to remain unchanged, the phrase “said” can be deemed as clerical error and therefore, it does not constitute the violation of Article 42(4)(ii) of the Patent Act.

☞ However, where a claim recites “said OOO”, but the concerned claims or claims from which the concerned claim depends lack antecedent basis for “OOO” and it is uncertain whether either “said” is incorrectly recited or the concerned claim refers back to the wrong claim, it does not correspond to the case (i) above, but rather be deemed as an unclear statement in violation of Article 42(4)(ii) of the Patent Act. For example, where claim 8 recites “~of claim 1, ... said subfield not doubled ...”, but “subfield not doubled” is not recited in the earlier part of claim 8 or claim 1, but is

recited in claim 6 and it is not certain whether either the claim number (claim 1) from which claim 8 depends is incorrectly indicated or “said” of “said subfield not doubled” is incorrectly stated, it shall constitute the ground for rejection, in violation of Article 42(4)(ii) of the Patent Act.

ii) Where the indicated term and the indicating term are not exactly identical, but they are deemed to correspond to each other based on the meanings

(Example) A claim reads “comprising the step in which the second node out of two nodes in the telecommunication system provides the information related to traffic condition containing cell-loading to the first node out of the said two nodes,... said node value is based on said transmitted information and the mapping information.” The “information” of “said transmitted information” can be interpreted to indicate “information related to traffic condition containing the cell-loading.” Although the phrase “transmitted” is not explicitly recited in the earlier part of the claim, the recitation “the second node providing the information related to traffic condition containing cell-loading to the first node” can be interpreted as transmitting the information in light of the description of the invention. Therefore, “said transmitted information” shall not be in violation of Article 42(4)(ii) of the Patent Act.

iii) Where some of the claims from which a claim depends are deleted, but the claimed invention is clearly understood when interpreted excluding the dependencies.

(Example) Claim 10 recites “~ 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.

☞ However, where all of the claims referred to in a claim are deleted, it

shall be deemed to be in violation of Article 42(4)(ii) of the Patent Act since which the dependencies of the claim cannot be determined and the claimed invention cannot be clearly understood. For example, claim 3 recites “~ of 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 recites “~ of 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.

The examples of i), ii), and iii) correspond to clerical errors and therefore, the examiner shall not issue the decision to reject citing the violation of Article 42(4)(ii) of the Patent Act. Where such errors are found during the examination process, the examiner shall make a decision to grant a patent with making an *ex officio* amendment if no other ground for rejection exists. 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 ground for rejection.

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 issue the notice 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 argument 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 argument or amendment in response to the ground for rejection, the examiner shall not issue 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 necessitated) 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) For a Markush type claim in which some of claim elements are selected from a group including more than one alternative, if all the inventions configured by selecting an alternative from the group possess a similar property or a function, the group of alternative species recited in such one claim does not render the claim indefinite

(Example) When three inventions, A+a, A+b, A+c, are set forth in one Markush type claim as in A+ (one of a, b, or c), if all the inventions A+a, A+b, A+c hold a similar property or function, such Markush type claim is acknowledged to meet the requirements .

For example, in case that the alternatives are related to chemical substances, a Markush type grouping of the alternatives does not render the claim indefinite if the following requirements are all met.

- ① All chemical substances containing an alternative selected from the group hold the common property or vitality
- ② All chemical substances containing an alternative selected from the group share the important chemical structure, or all the substances belong to the group of chemical substances deemed as one group in the pertinent art.

In this context, “all chemical substances containing an alternative selected from the group 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 ordinary skill in the art that each of the group of chemical substances disclosed as the subject matter is to be identically practiced in the claimed invention. In other words, it refers to the case where the same result is expected whichever is chosen among the chemical substances among the

group. The same principle can be applied in other technical fields such as machine, electricity.

(6) Where claims include functional limitations reciting the function or effect of an invention, but if the configuration of the invention is not deemed to be clear with such limitations, the claims cannot be allowed. In this context, cases where the configuration of the invention is deemed to be clear even with functional limitations refers to ① where defining claims functionally is necessary since the technical idea of the invention cannot be clearly set forth only with the existing technical configuration (There are cases where the claims cannot be defined only with the detailed description of the configuration due to the nature 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 limitations are clearly specified by the disclosure of the description of the invention and description in drawings.

Where claims include functional limitations, 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 art to which the invention pertains in light of the description of the invention or the disclosure in drawings and the level of skill in the art 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.

(7) A product claim can set forth the structure or characteristic of the product or can define a product in terms of the manufacturing method as in “a product manufactured by the method of” or as in “a product manufactured with the apparatus of.” Even when a product invention is defined by the method, if the configuration of the product is clearly understood from the method limitation, it does not render the claim indefinite.

In case that the manufacturing method recited in a product claim is unclear

even in light of the specification, drawings and the ordinary skill at the time of filing, an examiner shall notify a ground for rejection citing the violation of Article 42(4)(ii) of the Patent Act of Korea.

Further, where the structure or the nature of the product cannot be understood in light of the specification, drawings and the ordinary skill at the time of filing, the examiner can issue a notice of ground for rejection to the applicant in violation of Article 42(4)(ii). However, where the applicant cannot but define the product by process limitations due to specific circumstances or where the patent applicant proves that the process did not make any effect on the structure or the nature of the product, the examiner considers that a ground for rejection has been remedied and does not then make a decision to reject.

(8) A parameter invention refers to an invention including, as a part of the claim elements, a parameter which an applicant arbitrarily creates to indicate a certain physical-chemical characteristic and which is not generally used in the pertinent art or which is defined as the mathematical combinations of the multiple variables in the form of formula. Since, in most of cases, the technical configuration of a parameter invention having the characteristic value that the parameter represents cannot be clearly understood only from the claim limitations, the invention shall be deemed not to be set forth clearly and concisely except for ① where the definition or technical meaning of parameter is clearly understood, ② where the inevitable reason for using the concerned parameter is clearly shown, and ③ where the relationship with the level of skill at the time of application filing is understood, in light of the description of the invention or drawings as well as the level of skill.

In order for the inevitable reason for using the parameter to be clearly shown, the relationship between the parameter and effect as well as the relationship between the technical problem to be solved and the parameter as its solution shall be clearly understood through comparing examples satisfying the parameter limitations and examples not satisfying the

parameter limitations. Also, for the relationship between the parameter and the level of skill at the time of application filing to be understood, the description of the invention shall include comparative examples for known 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 should be used and the relationship with the level of skill at the time of application filing are not explicitly disclosed in the description of the invention or drawings, but if they can be clearly understood with consideration of the level of skill at the time of application filing, an examiner shall not consider the concerned invention as unclear only based on such grounds.

(9) For a claim directed to a composition reciting composition ratio as %, if the ratio has technical deficiency or contradiction such as the following ① to ④, the configuration of the claimed invention cannot be deemed to be exactly stated.

- ① The sum of maximum ratios of all components is under 100%.
- ② The sum of minimum ratios of all components is over 100%.
- ③ The sum of the maximum ratio of one component and the minimum ratios of the other components is over 100%.
- ④ The sum of the minimum ratio of one component and the maximum ratios of the other components is under 100%.

However, for open claims which may include unspecified other components as well as the components specifically recited in the claims by using a phrase, “comprising~”, even in the case of ①, the claim is deemed clear because it is possible to be 100% by including other components, and the case of ④ also meets the requirement since it is possible to be 100% by including other components.

(Example1)

[Claim 1] Composition consisting of 40-60 mass% of component A, 30-50 mass% of component B, and 20-40 mass% of component C

The sum of the maximum ratio of A and each minimum ratio of B and C is over 100%, so the invention is unclear.

(Example 2)

[Claim 1]

Epoxy resin composition for sealing semiconductor device comprising:

- a) Cresol novolac epoxy resin of 5-20 wt%
- b) Phenol novolac curing agent of 5-20 wt%
- c) Inorganic filler of 50-80 wt% selected from silica and alumina, and
- d) Amin-based curing accelerator of 0.5-1 wt%

With the minimum ratio 50 wt% of component c), the maximum ratio of component a), b), and d) makes 91 wt% in total, not reaching 100%, so the invention is deemed unclear. In this case, if it is a open type claim using “comprising~”, even though the sum of the minimum ratio of one component and the maximum ratios of the other component is below 100%, it can be 100% by including other components and thus it does not render the claim indefinite.

(10) The composition ratio can be described as parts by weight. In this case, it does not have to satisfy the requirement of (9), unlike in case of describing the ratio as percentage (%).

(Example)

[Claim 1] Resin comprising 10-30 parts by weight of component A, 20-30 parts by weight of component B, 10-20 parts by weight of component C, and 20-30 parts by weight of component D

Typically, parts by weight are used to indicate the amount of components based on one reference component. However, even without specifying the

reference component, since the amount of other components can be converted to a relative ratio based on another component, the composition ratio is deemed clear.

A claim directed to alloy should set forth the invention so that composition range of each component in alloy should be added up to be 100%. Regardless of whether the claim is stated as a close claim("consisting of") or an open claim("comprising"), the total sum of composition range should not be over or under 100%.

Since structure phase, application or property of alloy may vary according to kind or amount of additives, claims cannot be specified only by limiting main component but by limiting the other additive components.

(Example)

[Claim 1]

A copper alloy for welding comprising:

- ① 40-80% of Cu, ② 10-45% of Zn, ③ 1-5% of Sn, ④ 0.6-3% of Be,
- ⑤ 0.8-4% of Si .

With the minimum ratio 40% of component ①, each maximum ratio of the other components from ② to ⑤ can add up only to be 57%, not reaching 100%. For alloy, even though the claim is stated as an open claim by using "comprising~", it is not accepted since the sum of one minimum ratio and the other maximum ratios is under 100%. Therefore, the invention is deemed unclear.

Also, in setting forth the alloy invention in the claims, it is necessary not only to list components of alloy, but also to recite composition ranges thereof exactly. (See, Part IX Chapter 7, invention relating to alloy, 1.2 requirement of claims)

5. Description of matters deemed necessary for Specification of Invention

Article 42(6) of the Patent Act stipulates that the claims shall recite such

matters regarded necessary to specify what is sought for patent protection as structures, methods, functions and materials or combination thereof. As technology diversifies, defining 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 set forth 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 to reject based on the provision.

6. Claim Drafting Requirements

The way of drafting the claims included in a specification is prescribed in the law to make sure that it serves a role of determining the scope of protection of the claimed invention. Especially, the Korean Patent Act adopts the system of multiple claims under which one or more than two claims directed to the subject matters for which patent protection is sought can be prepared. 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 can be presented in the form of an independent claim or in the form of a dependent claim narrowing or adding further limitations to specify the independent claim.

In this context, 'narrowing or adding further limitations to specify the independent claim' means to specify an invention recited in the independent claim by adding the technical elements or by narrowing the generic concept to the species. Dependent claims mean those claims whose inventions are dependent on other claims and when the subject matters of other claims

change, the subject matters of the concerned dependent claims change accordingly.

A claim which narrow or add further limitations to specify other claim(s) in terms of the content of the invention but does not refer to the other claim(s) in terms of formality, cannot be said to be a dependent claim. To the contrary when a claim refers to an independent claim in formalities, but the claim does not narrow or add further limitations to specify the independent claim (for example: A product in which the element A of the invention of claim O is substituted with B), the claim cannot be considered as a dependent claim, either.

(Note) Article 5(1) of the Enforcement Decree of the Patent Act states that the claim that substantiates the independent claim by narrowing or adding may be presented as the dependent claim. However, it does not necessarily mean that claims substantiated by way of narrowing or adding to independent claims shall be described in the form of dependent claim. Therefore, claims substantiated by way of narrowing or adding to independent claims, too, can be described in the form of independent claim.

6.2 Article 5(1) of the Enforcement Decree of the Patent Act

(1) Independent claims shall be presented without referring to other claims in the form of standing alone. However, even independent claims can be presented with referring to 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 presented by referring to independent claims or other dependent claims. Dependent claims shall all include the limitations of the claims referred to.

(Example 1) A product of claim O,....

(Example 2) A method of ... in claim O or claim O,

Claims in the following cases shall be treated as independent claims, not dependent claims.

- ① Where claims are presented in the form of decreasing the elements of the claims referred to
- ② Where claims are presented in the form of substituting the subject matter set forth in the claims referred to 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 of claim 1, ...equipped with a belt conveyor, instead of a gear electric motor

(3) Article 5(1) of the Enforcement Decree of the Patent Act stipulates that the dependent claim ... may be entered according to Article 42(8) of the Act, which is presented as a non-binding provision 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 presented in a proper number according to the nature of the invention. This provision shall be separately treated from provisions on unity of application of Article 45 of the Patent Act.

Cases where the claims are not presented in a proper number include ① where two or more inventions of different categories are recited in one

claim, ② where the two or more subject matters are included, ③ where the same claim is presented 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 are referred to many times within a single claim, etc.

(Example 1) Where two or more subject matters are claimed 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 referring to other claims shall contain the number of the claims referred to and the number of the claims referred to 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 making reference to 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 referring to two or more claims, the claims referred to shall be numbered alternatively.

① Where the claims referred to are presented alternatively

(Example 1) A device of ... in claim 1 or claim 2

(Example 2) A device of ... in any of claims 1 to 3

(Example 3) A device of ... in any of 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 presented alternatively

(Example 1) A device of ... in claim 1, claim 2

(Example 2) A device of ... in claim 1 and claim 2 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 referring to two or more claims cannot refer to other claims referring to two or more 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 referring to two or more claims refers to another claim referring to two or more claims

(Example) Claim 4 referring to two or more claims refers to another claim (Claim 3) referring to two or more claims. Therefore, the claim violates the description method of the claims.

[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 2 or claim 3

② Where a claim referred to in the claim referring to more than two claims refers to another claim and another claim refers to other claim referring to two or more claims

(Example) Claim 5 referring to two or more claims refers to claim 4 referring to claim 3 referring to two or more claims. Therefore, the claim violates the description method of the claims.

[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 depends from claim 3, since claim 3 refers to two or more 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 referring to two or more claims' and it shall be noted that this provision cannot be applied to claims depending from only one claim. As in

the example above, claim 6 depend from 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 does not depend from two or more claims, it shall not constitute the violation of Article 5(6) of the Enforcement Decree of the Patent Act.

6.7 Article 5(7) of the Enforcement Decree of the Patent Act

A claim referred to by other claim should precede the other claim in numbering. This is to easily interpret the invention recited in the claim.

Where a claim refer to the claim itself, an examiner shall notify a ground for rejection citing that the claim referred to by other claim fails to precede the other claim, which 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 indefiniteness of the claim under Article 42(4)(ii) of the Patent Act.

6.8 Article 5(8) of the Enforcement Decree of the Patent Act

Each claim shall be presented in a new line and the claims shall be numbered in sequence.

However, to clearly define the configuration of the invention even within a single claim, a claim can be presented in several lines.

(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°C
- (B) The second procedure of forging the heated metallic materials
- (C) The third procedure of re-heating the forged materials at 600°C
- (D) The fourth procedure of quenching the re-heated materials

7. System for Deferral of Submission of Claims

(1) An applicant may attach a specification which did not include the claims

at the time of application filing to a patent application cover sheet. This system is designed to promote the protection of rights of a patent applicant by enabling the speedy filing of an application without preparation of the claims and providing enough time to effectively prepare the claims after thorough reviews of patent utilization strategies. However, as claims should be established from the perspective of a third party and for examination, the claims shall be submitted through amendments by a certain point of time (three months after the date of notification of intention of a request for examination or 1 year and 2 months(1 year and 6 months as for the patent application filed before December 31, 2014, hereinafter referred to as “the time limit for submission of claims”) from the priority date.

(2) Where an applicant who has attached a specification which did not include the claims at the time of application filing to a patent application cover sheet fails to make amendments for submitting the claims within the following deadlines, the concerned patent application shall be deemed to be withdrawn on the following day of the expiring date of the deadlines.

- ① The expiring date of the deadline for submission of claims
- ② 3 months after from the date of notification of the intention of a request for examination by a third party within deadline mentioned in ① above (when the notification is made after 11 months (1 year and 3 months where the patent application is filed before December 31, 2014) have elapsed from the date of the filing of a patent application (the earliest filing date in case of priority claim), until 1 year and 2 months (1 year and 6 months where the patent application is filed before December 31, 2014) have elapsed from the date of the filing of a patent application (the earliest filing date in case of priority claim)]

(3) An applicant can make a request for examination as long as a specification including the claims is submitted. Where an application makes a request for examination on the application attached with the specification which does not include 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 include the claims shall not be laid open for publication since it shall be deemed to be withdrawn on the following day of the expiring date of the deadline for submitting the claims.

Meanwhile, where a written request for early laid-open publication is submitted before an application attached with a specification which does not include the claims is deemed to be withdrawn, an examiner shall give an opportunity of explanation and return it to the applicant.

(5) In principle, a specification which does not include the claims can be attached to a divisional application, a converted application or an application filed by the legitimate holder of a right. On the one hand, where an amendment for submitting the claims is not made until the deadline for submission of claims, the patent application is deemed to have been withdrawn on the following day. However, where the original application is a divisional application or a converted application filed after January 1, 2015, claims can be submitted until 30 days from the date of filing a divisional application or a converted application, even after the expiration of the deadline for submission of claims.

(6) Whether the claims is included under the system for deferral of submission of claims shall be determined based on whether the identification symbols for '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 identification symbols for 'Patent Claims' is included, no matter what (for example, blanks, dots, commas, etc.) is included in the claims, deferral of submission of claims is not deemed to be employed.

Chapter 5. Unity of Invention

1. Relevant Provisions

Article 45 (Scope of Single Patent Application)

(1) A patent application shall be filed for each invention: provided, however, that a patent application may be filed for a group of inventions linked so as to form a single general inventive concept.

(2) The requirements for filing a patent application for a group of inventions under the proviso to 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 proviso to Article 45 (1) of the Act shall meet the following requirements:

1. The claimed inventions shall be technologically correlated;
2. The claimed inventions shall have the same or corresponding technological features. In such case, the technological features in the invention as a whole shall be those improved over the prior art.

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 if it is possible to file as many inventions as possible in one patent application in light of lower patent fees and patent right management. However, as for third parties, it would be beneficial if a patent application includes less inventions as possible in light of the fairness of proceedings, observation on patent rights and use of applications as prior art. Meanwhile, the Korean Intellectual Property Office

would prefer the narrower scope of one patent application in examination processes such as assigning patent 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 more 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 correspond to 「a group of inventions linked so 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 whether the inventions recited in each claim share one or more same or corresponding special technical features and thus have technical correlation as prescribed in Article 6 of the Enforcement Decree of the same act.

「The special technical features」 refer to the improved features in each invention as a whole 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 for providing elasticity in one claim is a spring, the special technical features for providing 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 the invention as a whole.

「The special technical features」 refer to the improved features 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 setting forth 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 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 requirement on the unity of inventions.

(4) Whether one group of inventions forms a single general inventive concept has nothing to do with 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 correlated inventions as presented 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

linked so as to form a single general inventive concept” depends on whether the inventions recited in each claim of the application have the same or corresponding technological features(in other words, whether the inventions are technically closely correlated) and the technological features shall refer to the improved features for each invention as a whole when compared with prior arts.

4. Determination on Unity of Invention

Basically, unity of inventions shall be determined in the following sequence.

(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 to which the invention pertains. It shall be noted that even a single invention may include multiple special technical features depending on the technical subject matter 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 second invention which serves as improvement over prior arts shall be specified by comparison with the prior arts to which the invention pertains. It shall be noted that even a single invention may include multiple special technical features depending on the technical subject matter 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 fall under the single general inventive concept.

(4) Through the steps of (2) and (3) above, it shall be determined whether the inventions have the technical correlation and thus form a single general inventive concept as stipulated in Article 6 of the Enforcement Decree of the Patent Act.

(5) The first invention shall be selected as the invention subject to examination. 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 selected as the invention subject to examination. However, an invention which is not included in any technical group because of lack of improvement over prior arts, but whose examination is terminated in the process 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 inventions do not share the same or corresponding special technical features 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 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, even if unity of invention is lacking, where examination can be completed 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. Examples 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 of claim 1, further comprising the special technical features of C

[Claim 3] : A display device of claim 1, further comprising the special technical features of D

This shall apply to dependent claims of species inventions which refer to the claims of a generic invention. In the example below, claim 1 and claims 2 and 3 are a generic invention and species inventions. 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 claim 1, wherein the acid is sulfuric acid

[Claim 3] : A method of claim 1, wherein the acid is nitric acid

(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 corresponding 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 corresponding 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 do not recite special technical features that are identical or correspond>

[Claim 1] Direct current motor control circuit A

[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 feature and 'control circuit B' is another special technical feature 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 recite special technical features which are not single>

[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 Method of the Product

(1) Unity of inventions between a product invention and the manufacturing method invention of the concerned product shall be determined based on whether the manufacturing method is 'suitable' for the manufacture of the concerned product.

In this context, 'suitable' indicates that when the manufacturing method is practiced, the product is manufactured. However, 'suitable' does not necessarily mean that the product cannot be manufactured in other methods or the manufacturing method cannot be used to manufacture other products.

(Example 1)

[Claim 1] Chemical material X

[Claim 2] Manufacturing method of Chemical material X

The manufacturing method 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 comprising the steps of charging intumescent synthetic resins into a cavity of the corrugated cardboard and heating the lamination layer.

A product created by the manufacturing method in claim 2 is a corrugated

cardboard in claim 1. Therefore, since the manufacturing method 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, comprising a special step

Since a product manufactured by the manufacturing method 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 filed as one application unless special conditions exist.

6.2 Product and Method of using the Product

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 de-insectization with Material A
'A method of de-insectization' 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)

[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 $X^{\circ}\text{C}$ 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 for 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 practiced, 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.

(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 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 practicing the Method

Where 「machinery, equipment, other products directly used for practicing the method」 is suitable for being directly used for the practicing 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 practicing 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

[Claim 2] A paint comprising rust resistant material X

‘A paint comprising rust resistant material X’ shall correspond to a product directly used for practicing the method of claim 1.

7. Special Cases

7.1 Markush-type Claim

(1) Where alternative elements are recited in the Markush style in a single

claim, if the alternative elements have corresponding qualities or functions, unity of inventions is met.

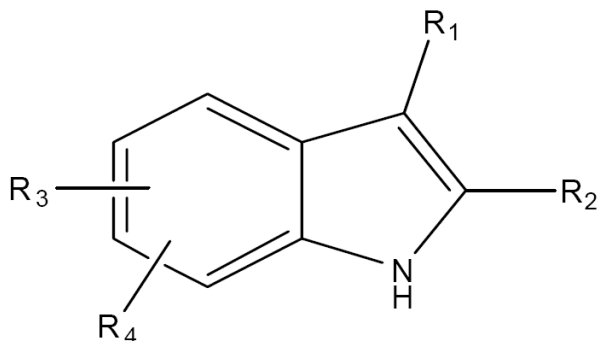
Where the Markush group includes alternative chemicals and such chemicals meet the requirement under Chapter 4 4.(4), the Markush group shall be considered to have corresponding qualities or functions.

(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



In this formula, R₁ is selected among the group comprising phenyl, pyridyl, thiazolyl, 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 RCH₂OH 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.

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 groups of chemical 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)

[Claim 1] Amorphous polymer A (Intermediate Material)

[Claim 2] Crystalline polymer A (End Product)

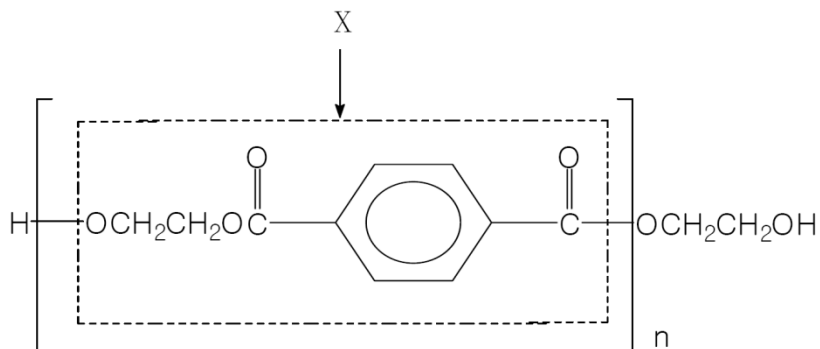
Crystalline polymer A is produced by orientating the film of polymer A. Unity of inventions is met since amorphous polymer A is used as a starting material to produce crystalline polymer A and therefore, the intermediate material and end product is related.

(Example 2)

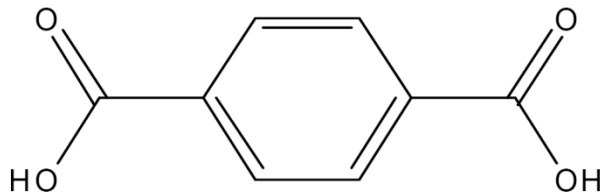
[Claim 1] High molecular compounds useful as textile materials defined

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 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 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 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 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.

Chapter 6. Application related to Microorganisms

1. Relevant Provisions

Article 2 of the Enforcement Decree of the Patent Act (Deposit of Micro-Organisms)

(1) A person who wishes to file a patent application for an invention related to a micro-organism shall deposit the micro-organism with either of the following authorities, prior to filing the patent application, in the manner prescribed and publicly notified by the Commissioner of the Korean Intellectual Property Office: Provided, That a micro-organism need not be deposited, if any person who has ordinary skill in the art to which the invention pertains can easily obtain such microorganism:

1. An authority designated under Article 58 (1) of the Patent Act (hereinafter referred to as the "Act") as an agency specializing in the storage and distribution of deposited micro-organisms (hereinafter referred to as "domestic depository authority");

2. An authority that has acquired the status as an international depository authority under Article 7 of the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Proceeding (hereinafter referred to as "international depository authority").

(2) A person who has deposited a micro-organism in accordance with paragraph (1) shall state the fact in the patent application in the manner prescribed by Ordinance of the Ministry of Trade, Industry and Energy and shall attach the document evidencing the deposit of the micro-organism (referring to a copy of the latest receipt issued under Rule 7 of the Regulations under the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Proceeding, if the micro-organism has been deposited in an international depository authority).

(3) When a new deposit number is given with respect to a micro-organism deposited under paragraph (1) after a patent application is filed, the patent applicant or patentee shall report the fact to the Commissioner of the Korean Intellectual Property Office without delay.

Article 3 of the Patent Act (Matters to be Disclosed in Patent Specification of Invention related to Micro-Organism)

A person who intends to file a patent application for an invention related to a micro-organism shall disclose the deposit number given by a domestic or international depository authority in the specification defined in Article 42 (2) of the Act (referring to the specification initially attached to the patent application), if the person has deposited the micro-organism in accordance with the main body of Article 2 (1), or the method by which the person has acquired the micro-organism, if he/she has not deposited such micro-organism in accordance with the proviso to Article 2 (1).

2. Deposit System

2.1 Purpose

An applicant shall describe the claimed invention in the description of an invention in a manner that a person with ordinary skill in the art to which the invention pertains may easily practice 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 practiced based only on the disclosure of the specification. In such cases, in order for a person with ordinary skill in the art to which the invention pertains to easily practice the invention based on the disclosure of the specification, a means of obtaining the starting material and a manufacturing method of the end product shall be disclosed in detail in the specification. In other words, the practicability 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 skill in the art to which the invention pertains can easily practice 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 Proceeding.

(2) Depositories designated by the Commissioner of the Korean Intellectual Property Office include Korean Collection for Type Cultures (KCTC), Korean Culture Center of Microorganisms (KCCM) and Korean Agricultural Culture Collection (KACC).

(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).

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 skill in the art 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 document on the deposit to the patent application. However, where a person with ordinary skill in the art to which the invention pertains can easily obtain 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 a micro-organism shall state the deposit number of the micro-organism in the original specification. When the micro-organism is not deposited, the person shall describe how to obtain the micro-organism.

(3) Where a micro-organism needs to be deposited either for an application with domestic priority claim or for a divisional application or for a converted application, the intention should be stated in the divisional application or in the converted application or in an application with domestic priority claim and the proving documents then should be attached. However, where the proving documents are the same as the ones already submitted for the original application or for the prior application and the applicant wants to make reference to the submitted documents, the requirement can be met by stating such intention instead of submitting the proving documents.

On the one hand, as for an international patent application entering the national phase, microorganism should be deposited to the international depository authority before the date of filing of the patent application and the intention then should be stated in the patent application and the proving documents be enclosed as well.

(4) 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 prior application, and the deposit number is disclosed in the specification of the prior application, the invention related to the micro-organism can benefit from the effect of priority claim when a proceeding related to the deposit of micro-organisms is undertaken for an application with domestic priority claim.

Meanwhile, where an international patent application serves as the basis of priority claim under the Paris Convention, 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 under the Paris Convention and its deposit number is stated in the specification of the international patent application.

(5) 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 proceeding is undertaken by a representative, a copy of the evidential document of the representation

4. Instructions on Examination

4.1 An application filed before December 31, 2014

(1) Where an application for which 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. However, 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 examiner, the examiner shall accept the copy and conduct examination on the application.

(2) Where the original 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 original 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 description of the invention so that a person with ordinary knowledge in the technology to which the invention pertains can easily practice 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.

4.2 An application filed after January 1, 2015

(1) Formalities Examination

Where proving documents are attached to an application without indicating an intention of filing the application as filing an application or vice versa, this case is considered to contravene the relevant rule so that amendments shall be proposed under Article 46 of the Patent Act of Korea. Where the deficiency is not remedied, however, even after the amendments being proposed, a proceeding relevant to deposit (of microorganism) shall be invalidated.

Where an application stating the intention of the invention involving a microorganism is submitted, formalities check should be performed whether microorganism stated in the proving documents is deposited before filing a patent application.

Where a patent applicant submits a patent application stating the intention of the invention involving a microorganism and the proving documents,

- ① where microorganism is not deposited before filing a patent application
- ② Where the name of the depositary authority, the depositary number and the depositary date are incorrectly stated in the patent application and the proving documents, the deficiencies shall be communicated to the patent applicant and be proposed to remedy. Where the deficiencies, however, are not remedied in response to the amendment proposal within a time limit specified, a proceeding related to the deposit of micro-organisms can be invalidated.

(2) Substantive Examination

Where there are no deficiencies identified in the documents submitted by a patent applicant, substantive examination shall be conducted.

As for a patent application for which deposit of microorganism is required, where the depositary number is stated in the specification or drawing(s) originally attached to the patent application but the intention of filing an application for the invention involving microorganism is neither stated in the patent application nor the deficiencies are remedied in response to the

amendment proposal within the time limit specified, a proceeding related to the deposit of micro-organisms can be invalidated.

On the one hand, where there are deficiencies in the proceeding related to the deposit of micro-organisms so that the proceeding is invalidated, the examiner can apply Article 42(3)(i) of the Patent Act of Korea with respect to a microorganism related invention.

The indication of depository number by depository authority shall be as follows:

		KCTC	KCCM	KCLRf	KACC
Patent Micro-organism	Domestic Deposit	KCTC No.P	KCCM No.P	-	KACC No.P
	Int'l Deposit	KCTC No.BP	KCCM No.P	KCLRf BP No.	-
General Deposit		KCTC No.	KCCM No.	KCLB No.	KACC No.

In order for a person skilled in the art to practice an invention of microorganism, the followings should be established in the specification:

① Where a person skilled in the art can easily get microorganism, the description should, in detail, establish the process of obtaining the final product microorganism from starting material, together with the process of getting microorganism, in such a way of a person skilled in the art to easily practice the invention. Accordingly, the embodiment of the invention can be supported.

② Where a person skilled in the art cannot easily get microorganism and it is difficult to establish the process of obtaining the final product microorganism from starting material in the description of the invention, in such a way of a person skilled in the art to easily practice the invention, the embodiment of the invention can be supported by depositing the final product microorganism.

However, without depositing the final product microorganism, the embodiment of the invention can be supported by specifying the process of obtaining the final product microorganism from starting material in the description in such a way of a person skilled in the art to easily practice the invention.

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 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 practiced 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 proceeding.

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 proceeding is still pending, even though a request for amendment has not been made.

PART III. Requirements for Patentability

Chapter 1. Industrial Applicability

1. Relevant Provisions

Article 29 (Requirements for Patentability)

(1) An invention having industrial applicability, other than the following, is patentable:

1. An invention publicly known or practiced in the Republic of Korea or in a foreign country prior to the filing of a patent application;
2. An invention published in a publication distributed in the Republic of Korea or in a foreign country or an invention disclosed to the public via telecommunications lines prior to the filing of a patent application.

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 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 having industrial applicability」 specifies two separate requirements, the statutory invention

requirement and the industrial applicability requirement. Therefore, under the examination guidelines, the requirements of Patent Act Article 29 paragraph (1) is defined by the requirements of statutory invention and of 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 laws of nature」, the invention shall satisfy the relevant provisions in order for a filed patent application to be eligible for patent under the Patent Act.

However, 「a highly advanced creation」 is a relative concept to differentiate 「utility innovation」 under the Utility Model Act from 「Invention」 under the Patent Act, and in practice, 「the highly advanced creation」 shall not be considered in determining the requirement of statutory invention.

4.1 List of Non-statutory Inventions

The decision of whether an invention falls under the Patent Act 2 subparagraph (1) is not easy to make, and the guidelines hereby exemplifies the types of non-statutory inventions in order to help determine whether the invention is patent-eligible.

4.1.1 Laws of nature as such

An invention is defined as a highly advanced creation of a technical idea using the laws of nature. So, laws of nature such as the second law of thermodynamics or the law of conservation of energy are 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.

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 only a new use of a known material is non-statutory, if the new use is closely related, with non-obvious inventive activities, to the newly found property, the use invention may be patentable.

4.1.3 Those contrary to laws of nature

Those contrary to laws 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.

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

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.

4.1.8 Computer programming language or computer program

A computer program is a mere list of instructions to operate a computer. 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, a computer readable medium carrying the computer program and the computer program stored in medium (applied to the patent application filed on and after July 1, 2014) are considered as a statutory invention (Refer to Chapter 10 Computer implemented invention (1.1 Claim) under Part XI).

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 reproduce 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.

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 ground for rejection under Article 42(3)(i) of the Patent Act.

4.2 Notice of grounds for rejection 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 ground for rejection shall be notified with the ground 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 Utility Innovation under Utility Model

Under the Patent Act Article 29 paragraph (1), the product (including a composition) 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 utility innovations that relate to the shape or construction of an article or a combination of articles. A utility model may be granted to utility innovations, which is not an article itself but a technical concept applied to an article recited in a claim.

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.

The simple explanation about the shape or construction of an article or a combination of articles is 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 Utility Innovations not relating to the shape or construction of an article or a combination of articles

Utility innovations on a method, a composition, chemical substance, a thing which is not fixed in a certain shape, animal variety, plant variety do not fall under a statutory utility innovation under Utility Model Act.

(Reference)

If an independent claim is a utility innovation 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 independent claim, what is claimed in the dependent claim is considered statutory.

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 notice of grounds for rejection.

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. Surgery on the human body by means of a surgical device (e.g. scalpel) or treatment of the human body with a medicine, which is not made by medical doctors (including oriental doctors) or by someone directed by medical doctors, is considered as medical activities.

However, as for the invention directed to a method of collecting various data through physiochemical measurement or analysis and inspection, if the method does not involve the clinical judgment, the method is recognized industrially applicable invention even though it is related to the diagnosis of disease. Provided that, the invention is not deemed industrially applicable if the configuration of the invention influences the human body directly and consistently.

(Note) 「Clinical judgment」 relates to mental activity judging illness or physical condition according to a clinician's opinion or based on experience. Processes which do not call for clinical judgment include 'a process detecting tumor marker A through antigen-antibody reaction in a patient's sample so as to provide information relevant to diagnosis of colon cancer.'

② A method including medical activities even in one as the part of the whole step or as indispensable 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 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 used as a business

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 clearly cannot be practiced

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 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.

Chapter 2. Novelty

1. Relevant Provisions

Article 29 (Requirements for Patentability)

(1) An invention having industrial applicability, other than the following, is patentable:

1. An invention publicly known or practiced in the Republic of Korea or in a foreign country prior to filing of a patent application;
2. An invention published in a publication distributed in the Republic of Korea or in a foreign country or an invention made available to the public via telecommunications lines prior to filing of a patent application.

(Reference)

"Inventions publicly known or practiced in the Republic of Korea" is revised into "inventions publicly known or practiced within or outside of the Republic of Korea". The revision expanded the geographical breadth of being publicly known or practiced to include the public knowledge and practice in a foreign country. The revision 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 publicly practiced (iii) inventions described in a publication, (iv) inventions made available to the public through telecommunication line do not involve novelty, and consequently they are not patentable.

3. Understanding of Provisions

3.1 Publicly Known Invention

「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」 refer 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 practiced invention

「A publicly practiced invention」 means an invention which has been practiced 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 "practicing" 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 part of technical features of an invention is kept in secret with regard to practicing of the invention, it shall not be considered as a publicly practiced invention.

(Example 1)

Conditions where the contents of the invention are considered to be publicly practiced 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 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 practiced 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.

3.3.3 Time of distribution

When the time of publication is indicated in a publication, it is presumed as follows:

- ① In 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. 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 utility innovation to be described in a distributed publication, at least the configuration of the utility innovation should be described. Therefore, if a utility innovation whose technical feature lies inside is merely exhibited in the form of photograph, it is not considered as a utility innovation described in a publication(Patent court 1992. 2. 14 1998 Heo 3767 sentence).

3.4 Inventions made available 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 skill in the art 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 「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 publicly known technology defined in the Act Article 29 paragraph (1) subparagraph (1) not as the prior art stated in the 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 made 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 made 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 made 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 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 disclosed 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 considered disclosure of technology through telecommunication lines but considered disclosure of technology through distributed publication.

(2) Invention Made Available to the Public

In order to cite an invention disclosed through telecommunication lines as prior art described in the 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 disclosed 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. (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 disclosed in the publication to be cited as prior art, thus the publication of the application 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 applications 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.

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.

(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 disclosed 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 disclosed. This shall apply to the case for prior art disclosed through telecommunication lines. In order to

recognize that the content disclosed over telecommunication lines has been disclosed 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 disclosed 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 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 notice of grounds for rejection. 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

(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 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.

	Disclosure through telecommunication line under Article 1-2 of the Enforcement Decree of the Patent Act before the revision	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	Disclosure through other telecommunication lines	
			Where credibility is recognized or actual disclosure date is confirmed	Where credibility is in doubt
Application filed before June 30, 2013 (applied with the Patent Act before the revision)	Cited as prior art under Article 29(1)(ii) of the Patent Act before revision	Cited as prior art under Article 29(1)(i) of the Patent Act before revision	Not cited as prior art	
Application filed after July 1, 2013 (applied with the revised Patent Act)	Cited as prior art under Article 29(1)(ii) of the Patent Act before revision		Not cited as prior art	

(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.

4.1 Defining invention disclosed in claims

4.1.1 General principle of defining inventions

(1) When the claim language is clear, defining the claimed invention should be made as recited 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 of the invention. The terminology should be interpreted in an objective and reasonable way by taking into consideration of its technical meaning, taken together with ordinary skill 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 description of the invention or drawings in finding technical features of invention.

Where the matters are not described in the claims but in the description of invention or drawings, an examiner should interpret the invention considering the matters as not being recited in the claims. On the contrary, where the matters are recited in the claims, an examiner should consider the matters in claims when interpreting an invention.

It is possible to consider the 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 description of the invention, novelty and inventive step should not be determined by interpreting the specific embodiments described in the description of the invention 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 description of the invention as an embodiment, as the term 'cream' generally refers to fat taken from milk, regardless of content of moisture, the claimed invention should not be interpreted to be limited to the embodiment of the description of the invention 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 description of the invention, the claimed invention should not be interpreted to be limited to the certain pattern formed in the tip of the probe in the description of the invention 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 description of the invention 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 description of the invention 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 specification(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 should examine whether the claimed invention can be grasped in view of the description of the invention, drawings and common general knowledge as of the time of filing. If the invention can be grasped, the examiner can notify the applicant the grounds for rejection on deficiency in describing specification and novelty collectively.

(5) If a claimed invention is not clear, even in view of the description of the invention in the specification, the drawings and the common general knowledge as of the time of filing, examination of novelty is not conducted and the ground for rejection due to the deficiency of the description of the invention 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 description of the invention. 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.

(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 description of the invention 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 inventions disclosed in the catalogue.

(3) A product defined by its manufacturing process (product-by-process claim)

Since product claims should be set forth in such a way that the technical configurations which is a subject matter of the invention are specified in the claim, the manufacturing process recited in product claims shall be viewed as just a means of defining the structure or properties of the final product. Therefore, in determining patentability of product-by-process claims, the claimed technical configuration should not be construed to be limited to the process itself but should be construed to be the product having certain structure or properties defined by all the claim limitations including the manufacturing process. Then novelty and inventive step shall be determined by comparing a publicly known invention with the claimed invention.

Where the manufacturing process affects the structure or properties of the product, novelty shall be determined based on the product having certain structure or properties specified by the manufacturing process. However, even though a product claim recites the manufacturing process, if the manufacturing process does not affect the structure or properties of the product, but only affect manufacturing efficiency or yield, novelty shall be determined based just on the final product itself, without considering the manufacturing process. Therefore, if an identical product can be obtained by a different process from the one recited 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 explicit intention is to limit the claimed invention to the product which is obtained only by the particular process, such as a claim reading "Z which is obtained solely by process A," the claimed invention should be treated in the same way aforementioned.

Where there is a prior art which discloses the manufacturing process identical or similar to that of the claimed invention, since it can be inferred that same or similar product can be produced based on the same or similar manufacturing process, the examiner shall define the scope of the claims to be the product manufactured by the process and then issue a notice of

grounds for rejection which must state novelty is denied due to the presence of the prior art.

In defining products in terms of the manufacturing process, where it is difficult to determine whether the manufacturing process affects the structure or properties of the product and there is a reasonable doubt that the claimed product for which the process limitations are not considered is identical to that of a prior art, the examiner shall issue a notice of grounds for rejection which must state that novelty is denied. In this case, the examiner shall take into account the written argument submitted by the patent applicant in conducting examination.

(Example 1)

In a case where the claim reads 'panel formed by cutting process using a knife in which a wave shaped blade is continuously formed in the longitudinal direction,' since the manufacturing process of a knife having a wave shaped blade does not affect the structure or properties of the panel having mixed wood grain, which is the subject matter of the invention, in determining novelty, the panel only shall be compared with the that of the prior art. When comparing the claimed invention and the prior art, both inventions show the same wave or cloud shape on the striped surface in the natural form. Therefore, the claimed invention is considered as the same with the prior art.

(Example 2)

Where a claim directed to an aluminum alloy fixture recites that the alloy fixture is formed through the processes of 1) immersing into water-soluble amine compound; and 2) thermoplastic injection molding, because the fixture having specific structure or properties obtained by the processes in terms of combining structure, shape or strength, cannot be obtained by other processes when taking into account ordinary skill in the art, novelty shall be determined by comparing a prior art with the fixture specified by manufacturing process.

(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 claim elements set forth in the preamble are not considered to be publicly known just because of the fact that they are recited in the preamble. The reason is that whether the claim elements are publically known before the time of filing is a matter of fact and the claim type cannot affect what occurred in the past. Even if all elements described in the preamble are publically known, it is not appropriate to compare only the rest of the elements in the body with a prior art because the technical concept of the invention as a whole including the publically known elements of the preamble is the subject matter for determining patentability.

(Example 1)

Where the subject matters described in the body of the Jepson type claimed invention are anticipated in the prior art reference but the subject matters of the preamble such as spark plug, ventilator are not described in the prior art reference, 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 prior art reference 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. Determining scope and content of a prior art reference

Determining the scope and content of a reference relied on in determining novelty (hereinafter referred to as "prior art reference") 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 an unspecified person without obligation of secrecy in the Republic of Korea and a foreign country before the filing of an application. Determining the scope of the disclosure of prior art reference 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 reference, 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 Practiced Invention

A "publicly practiced invention" means an invention which has been practiced under the conditions where the contents of the invention are to be publically known. However, it is not required that the invention actually becomes known to the public by the act of practicing it. Therefore, it is

enough to decide whether the invention is publically practiced without determining whether the invention is publically known.

"A publicly practiced invention" means an invention which has been practiced 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 publicly practiced invention can be determined on the basis of the subject matters embodied in machinery or systems, etc. The matters directly derivable from the publicly practiced invention in light of the ordinary skill at the time of the practicing can also be a basis for the finding of a publicly practiced 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 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 determining the scope of prior art reference

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 prior art reference and extracting the difference between them. Where there is no difference between the matters defining a claimed invention and the matters disclosed in the prior art reference, 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 disclosure of the prior art reference.

「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 prior art reference 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 disclosure of the prior art reference even when the numerical limitation is not considered.

When a claimed invention is identical to the disclosure of the prior art

reference 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 prior art reference 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 prior art reference 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 prior art reference, 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 description of the invention 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.

(3) In a case where the numerical range of invention described in the claims includes the numerical range of the prior art references, novelty can be denied at once.

(4) In a case where the numerical range of the claimed invention is different from that of prior art reference, 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 description of the invention, 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 invention disclosed in a prior art reference are identical, an examiner can wait written arguments or a certificate of experimental results after notifying the ground for rejection on lack of novelty without comparing strictly the claimed invention with the references because generally it is hard to compare the claimed invention with prior art reference regarding determining novelty on parameter invention. If the ground for rejection is no longer kept by the applicant's arguments the ground for rejection is dissolved. But if the reasonable doubt is not dissolved, an examiner should make the decision to reject the application on the ground for lack of 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 invention disclosed in the

prior art reference. ② In a case when an examiner evaluates the parameter of a prior art reference 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 description of the invention is identical to that of the prior art reference.

(5) In a case when an examiner notifies the ground for rejection 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 for 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 prior art reference 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 prior art reference 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 directed to metal and a prior art reference discloses Cu, the claimed invention is not novel.

② If a claimed invention is expressed in a specific concept and a prior art reference 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 prior art reference. 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 prior art references. Determining patentability by a combination of two or more prior art references is not related to novelty, but to inventive step. Except when a prior art reference cites a separate publication (ex: publication which provides detailed information of a technical feature), the separate publication is regarded as a part of the prior art reference and able to be relied upon in 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 ground of rejection 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 prior art reference, an 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 prior art reference is obviously drawn from more than two embodiments in considering common general knowledge.

(5) Where the patent applicant acknowledges in the specification or the written argument that the background art described in the specification of the patent application under examination is publicly known prior to the filing date of the patent application, novelty of the claimed invention can be assessed on the assumption that the background art has already been published. However, in case of special circumstances where it turns out that the applicant wrongly admitted that the invention of the prior-filed application, which has not been published as of the filing date of the application, or the technologies known only inside of a company of the applicant, have already been known to the public, such assumption can be reversed. Accordingly, where the patent applicant asserts or proves such special cases, a ground for rejection based on the assumption shall be considered to be remedied, and the examination then shall be continued.

5. Disclosure exceptions

5.1 Relevant Provision

Article 30 of the Patent Act (Disclosure Exceptions) (1) Where a person who has an entitlement 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).

(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.

(3) Notwithstanding the provision of paragraph 2, where supplementary fee is paid according to Ordinance of the Ministry of Trade, Industry and Energy, a document indicating the intent provided in paragraph 1(i) or a substantiation shall be submitted within the specific period falling under any of the following paragraphs.

1. Within the amendment period provided in Article 47(1)

2. Within 3 months from the date of receipt of a certified copy of grant for a patent according to Article 66 or of a trial decision vacating the decision of the rejection for a patent according to Article 176(1) (It is limited to a trial decision for granting a patent, but a retrial decision is included). However, where the due date for registration provided in Article 79 is to be less than 3 months, the concerned period shall be limited to that date.

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 publicly known before the invention is filed to obtain a patent, if the necessary conditions is fulfilled, the invention cannot be used 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 discloses his or her own invention and to encourage early disclosure 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 discloses 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 practiced inventions, it is necessary to allow publically known or practiced 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 patent application 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 disclosure exception

5.3.1 Where an invention is disclosed by a person with the right to obtain a patent before the filing of the patent application

(1) Although an invention is disclosed by a person with the right to obtain a patent before the filing of the patent application, the invention is not considered to be disclosed 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 disclosed 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 disclosed (if the date on

which the invention is disclosed is unspecified, the first day of the month and year of a disclosure may be applied.);

(c) the intent 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 exceptions to disclosure, 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 disclosed against the intention of a person with the right to obtain a patent

When an invention is disclosed against the intention of a person with the right to obtain a patent, it doesn't matter how the invention is disclosed. 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 disclosed, without the need to state the purport of invention to take advantage of Article 30 in the application.

5.3.3 Distinction between disclosure by a person with the right to obtain a patent, and disclosure against the intention of the person

(1) In filing a patent application claiming the exception to disclosure, 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 disclosed, and the second case is when the invention is disclosed 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 disclosed, and (ii) invention considered to be publicly known be examined on a claim by claim basis. However, there are differences in the person who disclosed the invention, the medium used for being disclosed and required documents proving the relevant facts.

(2) An invention disclosed by a person with the right to file for a patent means an invention has been disclosed by an inventor or the person's successor in title. Notwithstanding the consent of the person with the right to obtain a patent, if the invention is disclosed 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 disclosed against the intention of a person with the right to obtain a patent is considered as being disclosed against the intention of an inventor or the person's successor in title. Whether an invention is disclosed against the intention of a person with the right is determined in consideration of the right holder's clear intention to disclose the invention at the time when the invention is disclosed.

(3) Whether an invention is disclosed 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 disclosed by the person with the right to obtain a patent shall state the intention in the application. Meanwhile, a person intending to take advantage of the provision of Article 30 for the reason that the invention is disclosed 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 disclosed 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 from the date of filing. However, the proving document can be simultaneously submitted as filing the patent application. Meanwhile, where the patent application is filed on and after July 29, 2015, the proving document can be submitted within 3 months (provided, however, it shall be before the registration of a patent) from the date of receiving a certified copy of grant of patent or within the specified period set forth to amend a specification. Same regulation shall be applied to an application for registration of utility model as well.

(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 reference 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 disclosing 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 disclosed 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 is disclosed and the requirements of proving the fact are individually judged on a case by case basis. Where an invention is disclosed against the intention of a person with the right to obtain a patent under Article 30 paragraph (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 disclosed, as in the case of Article 30 paragraph (1) subparagraph (1). Therefore, the fact that the invention is disclosed 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 disclosure exception 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.

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 deficiencies.

- 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 after twelve months (six months in case of filing date being earlier than March 14, 2012) from the disclosure date of 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 disclosed; 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 proceeding under Article 30(in this case, the filing proceeding 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 proceeding.

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 disclosure exception can be confirmed in the evidential document. Matters required for examination on the requirement disclosure exception 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 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 proceeding of claiming an invention to be not to be considered to be disclosed fails because deficiencies 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 proceeding to apply Article 30 of the Patent Act to the invention shall be taken for each disclosure to be applied with disclosure exception.

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 disclosure exception is recognized. Therefore, where the intention of claiming disclosure exception is indicated in the application (by checking the box for disclosure exception in the application cover sheet) at the time of filing, even though the disclosure is not specified in the application, the disclosure exception can be applied to the disclosure if the evidential document of the disclosure is submitted within 30 days from the filing date.

If an act 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 disclosure. The disclosure which is inseparably related to one more disclosures is prescribed in Article 30 paragraph (1) subparagraph (1) and the applicable cases are as follows:

(a) a test which takes two or more days; (b) test and explanation distributed on the date of test; (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 proceeding for claiming disclosure exception has been undertaken for the initial academic disclosing activity, subsequent academic disclosing activities shall be deemed to enjoy disclosure exception. (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 disclosed and another invention (B) which is the same as invention but disclosed 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 reject the application of invention (A) for the ground of lacking novelty, except the obvious case that the disclosure of the invention (B) was made by learning from the disclosure (A).

The disclosure of invention which was made by a third person after learning from a disclosure, which is not considered to be disclosed, covers the case when a third person reproduces the invention which was disclosed by a person with the right to obtain a patent at a test, publication, announcement in an academy, and display in an exhibition. After sending an applicant a notice of grounds for rejection for the above reason, the examiner shall decide to reject the application if the applicant can't establish the fact that the a third person disclosed the invention after learning from a disclosure

which is not considered to be disclosed, 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 disclosed 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 disclosed, 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 rejection and decide the rejection 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 proceeding 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 proceeding 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 proceeding 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.

(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 disclosure, 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 disclosures to which the graced period stipulated in the provision of Article 30 paragraph (1) subparagraph (1) can be applied include a disclosure of an invention by a person with the entitlement to obtain a patent for the invention, a disclosure of an invention by a third party who is asked to so by a person with the entitlement to obtain a patent for the invention and a disclosure of an invention by a third party through referencing the invention under the permission (implied permission is also included) from a person with the entitlement to obtain a patent.

A disclosure asked by the person with the entitlement to obtain a patent covers a case where a person with the entitlement to obtain a patent entrust the disclosure (the name of inventor or the right holder is stated) of the invention to a third party, and a case where a person with the entitlement to obtain a patent sends the press release or scripts on the invention to a newspaper and the invention is disclosed; 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 made by referencing an invention of a person with the entitlement to obtain a patent for the invention covers a case where the paper or the news article written by a person, who has not the right to obtain a patent, mentions the inventor or company for which the inventor works and cites the invention, and a case where 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, among presenters who disclosed the invention, at least one presenter 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 entitlement to obtain a patent and (iii) a document proving that a person who presents an invention got permission for referencing the invention from the person entitled to obtain a patent.

(7) Even though the international application which is deemed to be filed to KIPO, does not include the declaration as to exceptions to disclosure at the date of filing an international application, if the applicant submits a document for claiming exceptions to disclosure and a supporting evidence within 30 days from the reference date under Article 200 of the Patent Act, Article 30 of the Patent Act shall apply to the international application.

As to an international patent application which has entered the national phase, where purport of such intention and supporting evidence are submitted within specified period, the international application claiming exceptions to disclosure shall be deemed to meet the requirements under Article 20, paragraph 2 of the Patent Act, then the formality check and

substantive examination thereon shall be carried out as with the application including regular claiming of exceptions to lack of novelty, without any extraordinary circumstances.

On the one hand, as to an international application, an applicant can declare exceptions to lack of novelty in the request form Box No. VIII(v) at the date of filing an international application, and according to Article 201(5) of the Patent Act of Korea, a request form of an international application submitted on the international filing date is deemed to be a application cover sheet submitted under Article 42(1) of the Patent Act of Korea, so that where it is confirmed that said declaration is included in the PCT request form, claiming exceptions to lack of novelty shall be deemed to meet the requirements under Article 30(2) of the Patent Act. In other words, where said declaration is stated in the PCT request form and a document proving the relevant facts is legitimately submitted within 30 days from the reference date, even if a document according to Article 200 of the Patent Act does not include the claiming for exceptions to lack of novelty, it shall be acknowledged that a requirement under Article 30(2) of the Patent Act is satisfied, and then examination shall be carried out (Refer to Rule 4.17 under the PCT).

(8) As to an application filed on and after July 29, 2015, even if a person entitled to obtain a patent did not state that an application is disclosed as filing an application, as taking into account that an applicant can invoke grace period within 3 months after a grant of patent being issued or during the designated period for amending the specification, drawings of claims (provided, however, it shall be before the publication of registration), the examiner shall issue a notice of all grounds for rejection at once.

By the way, where the applicant remedies grounds for rejection by claiming disclosure exception but the examiner intends to notify new grounds for rejection based on other documents laid open to public inspection, the examiner shall issue a first office action thereto.

Chapter 3. Inventive Step

1. Relevant Provisions

Article 29 (Requirements for Patentability)

(1) An invention having industrial applicability, other than the following, is patentable:

1. An invention publicly known or practiced in the Republic of Korea or in a foreign country prior to the filing of a patent application;
2. An invention published in a publication distributed in the Republic of Korea or in a foreign country or an invention made available to the public via telecommunications lines prior to the filing of a patent application.

(2) Notwithstanding paragraph (1), an invention that can be made easily by a person with ordinary skill in the art to which the invention pertains, from the invention referred in any subparagraph of paragraph (1), prior to the filing of a patent application, shall not be patentable.

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 involves an inventive step under Article 29, paragraph (2) of the Patent Act.

3. Definition of Terminologies

3.1 Prior to filing of a patent application

「Prior to filing of a patent application」does not refer to the filing date, but means the definite time, in hours and minutes of the filing of an application. For instance, if an invention is publically known outside Korea and the point of time when the invention has become publically known precedes the filing time of a patent application in Korean local time, then, this invention is considered as a prior art reference 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 in addition to "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) disclosed prior to the filing of the patent application.

4. General principles of determining the inventive step

(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 「prior art reference(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 prior art references, the invention in the claims is not considered to involve 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 grounds for rejection regarding novelty is different from notifying applicants of the grounds for rejection regarding the inventive step. However, when it is determined that an invention is not novel, it is allowed to notify applicants of the ground for rejection along with the grounds for rejection 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 grounds for rejection with regard to a certain invention, the examiner needs to precisely point out the invention along with the grounds for rejection 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 thoroughly consider the purpose, technical configuration, and advantageous effects of the invention while paying attention to the argument of the applicant, comprehensively determining whether the claimed invention involves an inventive step in consideration of its specific purpose and effectiveness, and focusing on the difficulty of the technical configuration 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 prior art reference while mainly focusing on ① whether the prior art reference 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 disclosure of the prior art and that the subject matter 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 a claimed invention. The method of specifying the claimed invention is the same with that of 「determining novelty」 in Chapter 2.

(2) The examiner specifies the scope and content of prior art references. The method of specifying the scope and content of the prior art references is the same with that of 「determining novelty」 in Chapter 2. The examiner shall specify the prior art references 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 prior art reference which is the closest to the claimed invention and makes a clear difference by comparing the prior art reference with the claimed invention. In doing so, the examiner shall take into consideration the combination of the elements of an invention. More specifically, the combined elements of an invention shall be compared as a whole (without being separated) with their corresponding elements in the prior art reference.

(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 prior art references or the common general knowledge before the filing, even though there is a difference between the claimed invention and the prior art references.

5.2. Selection of the prior art reference

(1) A prior art reference, 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 prior art reference 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 a prior art reference 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 prior art reference 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 prior art reference since both inventions relates to an apparatus for sealing or unsealing a liquid container. Hence, the eruption closure assembly is properly chosen as a prior art reference.

(Example 2)

The technical fields of an umbrella and a parasol are not exactly the same, but are 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. Prior art reference 1 relates to a method of disposing of a bore in a tree after trunk injection. Prior art reference 2 relates to a method of injecting antibiotic into trees to eradicate insects through trunk injection. As there are enough grounds to consider that prior art references 1 and 2 and the claimed invention are in the same technical field, the inventive step of claimed invention can be denied over prior art references 1 and 2.

(2) 「The closest prior art reference」means the most relevant prior art reference in relation to a claimed invention among several selected prior art references 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 prior art reference 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 prior art reference 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 prior art which teaches away the technical idea of the claimed invention, care should be taken in selecting as a prior art reference. However, notwithstanding the description in the prior art that teaches away the claimed invention, the prior art reference shall be able to be relied upon 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.

(Example 1)

The claimed invention relates to a probe card and is in the same technical field with prior art reference 1 which comprises all technical features of the claimed invention except that the prior art reference does not disclose a means to control the overall flatness. However, there is no description in the prior art reference 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 configuration. Hence, the inventive step of the claimed invention can be denied by combining the technical features of prior art reference 1 and a means of controlling the orientation of a

substrate disclosed in prior art reference 2 (which is in the same technical field as the claimed invention).

(4) Where the patent applicant admits in the specification or in the written argument that the background art described in the specification of the patent application under examination is publicly known prior to the filing date of the patent application, novelty of the claimed invention can be assessed on the assumption that the background art has indeed been publicly known. However, in case of special circumstances where it turns out that the applicant wrongly admitted that the invention of the earlier application, which has not been published as of the filing date of the application, or the technologies known only inside of a company, have been disclosed to the public, such assumption can be reversed. Accordingly, where the patent applicant asserts or proves such special cases, a ground for rejection based on the assumption shall be considered to be remedied, and the examination then shall be continued.

(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 prior art reference 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 prior art reference can be used as a prior art to determine the inventive step even if some defects exist in the description of the prior art reference 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 that a person skilled in the art

would have been led to the claimed invention based on the prior art reference; suggestions shown in the disclosures of the prior art references, 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 prior art references

Suggestions shown in the disclosures of the prior art references relevant to a claimed invention can be strong grounds 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 prior art reference discloses a method of setting up the relevant configuration of a cooling compressor in an airtight cooling apparatus. The prior art reference differs from the claimed invention only in that the prior art reference does not specifically mention a heat exchanger built in the airtight cooling apparatus of the claimed invention. If the prior art reference 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 that a person skilled in the art would have been easily made the claimed invention based on prior art references.

If the technical problems to be solved described in the claimed invention and prior art reference are not similar, 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.

(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. Prior art reference 1 relates to an animal-shaped winter cap, and prior art reference 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 prior art references 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 prior art references. Hence, there seem to be no difficulty in combining the prior art references, and therefore the claimed invention would have been readily derived from the prior art references 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 prior art reference relates to a thermo-start which is activated in accordance with a temperature change. The technical problems of both claimed and prior art references 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 prior art reference 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 prior art reference with a different problem compared to a claimed invention, if it is obvious that a person skilled in the

art can easily arrive at 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 attachment of water drops on its surface. Prior art reference 1 discloses a carbon disc brake, and prior art reference 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 prior art reference 2 with the carbon disk brake of prior art reference 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 prior art reference or between prior art references, 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 prior art reference 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. Prior art reference 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 prior art references 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 prior art references in terms of the generally required technical problems, applying the filtering part described in prior art reference 2 to the

filtering apparatus in prior art reference 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 easily made the claimed invention.

(Example 1)

If a prior art reference 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 prior art, reasoning based on known physical properties, or referring to other technical field 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 general object, optimizing a numerical value range, replacing with equivalents, a simple 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 prior art reference 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

Replacing an element of an invention with a publicly known compatible means having the same function as the replaced element is not considered as involving 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 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 the inventive step of the invention is negated.

(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 Simple modification of a design in applying a specific technology

When an invention can be merely arrived at by simple modification of design without changing the technical idea of the prior art, and it does not 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 prior art reference lies only in 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 involving an inventive step.

(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 involving 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 the inventive step can be acknowledged when the omission of some features does not affect the function of the invention or rather enhances the function beyond the expectation based on the common knowledge at the time of filing.

(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 involving an inventive step. 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 advantageous effect is not considered involving an inventive step.

(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 is only characterized in using a known technique in a closely analogous situation in order to solve a problem posed by the prior art with readily anticipated effect, is not considered involving an inventive step. On the other hand, the claimed invention may be considered involving an inventive step 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)

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 achieved by matters defining a claimed invention is advantageous in comparison with an effect of a prior art reference, 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 prior art reference 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)

If a claimed invention is made by collecting and improving publicly known and publicly practiced arts, the claimed invention is not considered to have inventive step 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 prior art reference 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 prior art references 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 prior art references, 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 prior art reference 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 description of the invention, the examiner can assess the inventive step from the argument and evidence like experiment results, if the effect is easily recognized by a person skilled in the art from the description of the invention and the structure of the invention shown in the drawings. But if such an assertion is not supported by the description of the invention and is not inferred from the description or drawings, the effect from the argument 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 involving an inventive step.

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 involving selection of a species from a genus disclosed in a prior art reference. It includes a selection of matter which is not directly disclosed in the prior art reference as an essential element.

Selection of an optimized means through experimentation from publicly known technology is not considered involving inventive step, because selecting the best or suitable means 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 achieves advantageous effect in comparison with a prior art reference, the inventive step of the selection invention can be acknowledged. In this case, all specific means included in the selection invention should have advantageous effects qualitatively different or qualitatively the same but quantitatively prominent. The description of the selection invention should precisely explain that the invention achieves an advantageous effect in comparison with the prior art reference, 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)

Both a claimed invention and a prior art reference 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 prior art reference, and the oral activity of the claimed invention achieves ten times more advantageous effects than the prior art reference, the inventive step of the claimed invention can be acknowledged.

6.4.2 Determining the Inventive Step of an Invention including Numerical Limitations

A numerical limitation invention means that some of indispensable elements of the claimed invention 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 involves an inventive step if it has more advantageous effect within the limited numerical range than the effect of the prior art reference. This advantageous effect should be a remarkably improved effect across the whole range of the numerical limitation. Also, whether the critical significance is required for the numerical limitation shall be determined under the following criteria.

(1) The critical significance of the numerical range is required with regard to any part of the numerical range if a claimed invention is in line with the prior art reference.

(2) If the two inventions each have different problems to be solved and qualitatively different effects, the critical significance of the numerical range is not required even though the two inventions have the same configurations except for the numerical limitation.

For the critical significance of the numerical range to be recognized, a remarkable change in an 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 the description of the invention, and 2) embodiments in the description of the invention or supplemental materials should prove that the upper limit and lower limit of the numerical range 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 includes 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 recognized to involve 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 prior art references, if the claimed invention is different from the prior art references 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 recognized

to involve 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 prior art reference 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 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 prior art reference 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 there are cases where the claim limitations of the parameter invention may not precisely define the subject matter for which patent protection is sought, determining the inventive step of the parameter invention should be performed only after figuring out the subject matter based on the description of the invention, 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 prior art reference 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 recognized.

(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 prior art reference, if there is a reasonable doubt that the parameter invention can be easily derived from the prior art reference, the examiner can notify the applicant of the grounds for rejection citing lack of the inventive step without having to strictly compare the claimed invention with the prior art reference and wait for the applicant's argument. If the examiner has difficulty in maintaining the grounds for rejection due to the applicant's refutation, the grounds for rejection are cancelled. If the grounds for rejection are not overcome by the applicant's argument, the examiner may make a decision to reject under Article 29, paragraph (2).

(4) The examiner might have reasonable doubt in the following cases: ① the parameter recited in the claims is converted based on a different definition and measurement method, and then the claimed invention is found to be easily derived from the prior art reference. ② the examiner evaluates the parameter of the prior art reference according to the measurement

method in the description of the invention, and then the claimed invention is proved to be similar to the prior art reference. ③ an embodiment in the description of the invention is similar or identical to that of the prior art reference.

(5) If the examiner notifies the applicant of the grounds for rejection 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 rejection 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 prior art reference having different properties or characteristics, if the claimed invention becomes similar or identical to the prior art reference 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 of the prior art reference, 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.

6.4.4 Determining the Inventive Step of a Product Invention described by its manufacturing process

(1) Since a product claim should specify the product configuration, which is the subject matter of the product invention, the manufacturing process recited in the claims of the product invention shall have a meaning as a limitation defining the structure and properties of a final product. Therefore, in determining patentability of the product-by-process claims, the claimed technical configuration should not be construed to be limited to the process

itself but should be construed to be the product having certain structure or properties defined by all the claim limitations including the manufacturing process. Then novelty and inventive step shall be determined by comparing a publicly known invention with the claimed invention.

(2) the subject matter sought for protection in the product-by-process claim is neither the manufacturing process nor the manufacturing apparatus but the final product itself. Therefore, in determining inventive step, the examiner should not determine whether the manufacturing process or the manufacturing apparatus for the product is patentable, but should determine patentability by comparing the configuration of the “product” having certain structure or properties obtained by such manufacturing method with the configuration of a publicly known product.

(3) Where the manufacturing process affects the structure or properties of the product, inventive step shall be determined for the product having certain structure or properties obtained by the manufacturing process. On the other hands, where the manufacturing process does not affect the structure or properties of the product, but only affects manufacturing efficiency or yield, even though product claims include the manufacturing process limitations, the inventive step shall be determined based only on the final product itself without considering the manufacturing process.

(4) Where it is difficult to understand the structure or properties of the product from the manufacturing process, the examiner shall define the scope of the invention in light of the whole descriptions of the specification, including experimental data and embodiments, and drawings and then issue a notice of grounds for rejection stating that inventive step of the product claims is denied over the prior art which discloses the invention identical or similar to the defined scope of the product claims.

(5) Where there is a prior art which disclose the manufacturing process identical or similar to that of the claimed invention, since it can be inferred

that same or similar product can be produced from the same or similar manufacturing process, the examiner shall define the scope of the claims to be the product manufactured by the process and then issue a notice of grounds for rejection stating that the inventive step is denied over the prior art reference.

(6) In defining a product in terms of a manufacturing process, where it is difficult to determine whether the manufacturing process affects the structure or properties of the product and there is a reasonable doubt that inventive step can be denied over the prior art reference which discloses a similar product without considering the manufacturing process, the examiner shall issue a notice of grounds for rejection for lack of inventive step. In this case, the examiner shall proceed with examination by taking into account the written argument submitted by the applicant.

Ex 1) Where the claimed invention is directed to pharmaceutical composition for treatment of gastrointestinal diseases containing jaceosidin as an active component and pharmaceutically acceptable additives, and the claim recites the steps of extracting mugwort leaves by methanol or ethanol; removing fat from the extract; eluting the extract with chloroform; obtaining a sub-fraction; charging the sub-fraction to silica gel; and then eluting the sub-fraction, since the method does not affect the composition or properties of the final product 'JACEOSIDIN', the active component shall be interpreted as a single product 'JACEOSIDIN' itself without considering the method.

Ex 2) Where the claimed invention relates to the belt coupling device for seat belt and the claim set forth the manufacturing process including the steps of; bending a part of a platelet from one side to the other side; and at the same time pushing back the bended part to the one side, since the manufacturing process affects the structure or properties of the belt coupling device, the inventive step shall be determined by comparing the belt coupling device having the structure and shape of the platelet obtained by the process with the prior art.

Ex 3) Where the claimed invention is directed a polarizing film and recites the manufacturing process, including the steps of; preparing PVA film using, as raw material, polyvinyl alcohol tip cleansed in warm water in the range of 30-90 Celsius degrees in the bath ratio by weight of over 1 and less than 100; controlling eluting amount of PVA between a range of 10~60ppm when PVA film of 10 cm square and 30-90um thick is left in 1L warm water of 50 Celsius degrees for 4 hours, since it is confirmed that by cleansing PVA tip raw materials with water prior to the manufacturing process of polarizing film and thus removing PVA likely to be eluted in the manufacturing process of PVA film within certain range, by which prevents defects from being generated in the polarizing film due to the eluted PVA, synergistic effect is achieved to obtain polarizing film having less defects in a high yield, inventive step shall be determined by comparing the prior art with the polarizing film taking into account the structure and properties obtained by the manufacturing process.

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 prior art references.

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 prior art references (well-known or commonly used art) but the combination of the references is limited to the condition where a person skilled in the art can easily combine the references at the time of filing. In this case, there is no special limit on the number of prior art references to be combined. When the examiner determines the inventive step by combining various prior arts, the examiner mainly considers whether the prior art references contain a motivation or suggestion leading to the claimed invention by combining or assembling the prior art references. 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 references is deemed to be easily made by a person skilled in the art, the examiner can deny the inventive step of the claimed invention.

(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 prior art reference 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 prior art reference 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 prior art references, the claimed invention differs from prior art reference 1 only in that the prior art reference 1 recognizes security denominations via an optical sensor, and prior art reference 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 prior art reference 2 for the optical sensor of the prior art reference 1 without difficulty. Therefore, it would have been obvious to a person skilled in the art to combine the prior art references 1 and 2, thereby arriving at the claimed invention.

(3) The determination whether a prior art disclosure contains a motivation, suggestion, or the like for a combination shall be made by synthetically assessing the following: whether the motivation, suggestion, or the like is explicitly taught in the prior art; whether the motivation, suggestion, or the like is inherent from the technical problem to be solved by the invention; or whether the motivation, suggestion, or the like is part of the common general knowledge or empirical rules of a person skilled in the art.

(Example 1)

Prior art reference 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

prior art reference 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 prior art reference 1 to the rigid plastic material of the prior art reference 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 reference referring to another reference can be considered to explicitly suggest or provide motivation of a combination in the prior art references, it is regarded as obvious to combine the two references 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 prior art reference 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 guide member of prior art reference 2 referred to in prior art reference 1, it would have been obvious to combine the prior art reference 2 with the prior art reference 1, thereby arriving at the claimed invention because the combination of the prior art references 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 recognized 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 prior art reference 1 except for a servo motor modified from a hydraulic actuator of prior art reference 1 and a bending means described in prior art reference 2 and substituted for the spindle of prior art reference 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 prior art reference 1 and the prior art reference 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 prior art reference 1, a vacuum chamber disclosed in prior art reference 2, and a mold fastening system disclosed in prior art reference 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.

(6) In determining the inventive step of a combination invention, care must be taken as the fact that one or more prior art references must be combined with the closest prior art reference in order to arrive at the claimed invention may indicate the presence of an inventive step. Also, it should be noted that the fact that the large number of prior art references should be relied upon may indicate the possibility of improper hindsight or the possibility that the rejection lacks a valid ground. 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 there is good possibility that a person with ordinary skill in the art would 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 configuration, 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 configuration. 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 argument submitted by an applicant claims that the claimed invention is not obvious for the following reasons:

(1) If a prior art reference teaches not to rely on the prior art thereof, i.e., if there is a description in the prior art reference that teaches away 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 reference is described as inferior cannot be necessarily considered as a factor that teaches away the claimed invention.

(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 step. First of all, as the inventive step should be determined based on the contents disclosed in the specification (i.e., the objective, configuration, and effect of the invention), commercial success is not to be regarded as a criteria 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 configuration 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 conceive 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 be 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.

(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 indicator 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 recognized.

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 prior art reference merely discloses 'preventing others from noticing a voice reception from a terminal', the specific technical configuration 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 prior art reference above results from improper hindsight that the examiner knows the contents disclosed in the specification.

(2) If an independent claim involves an inventive step, a claim dependent on the independent claim is deemed to involve an inventive step too. However, if an independent claim lacks an inventive step, the determination should be made for each claim dependent on the independent claim.

(3) If a product invention explicitly involves an inventive step, a process invention for making the product or a use invention for using the product also involves an inventive step in principle.

(4) For a Markush-type claim or a claim reciting multiple alternative technical features, if at least one invention of the Markush alternatives is proved to lack an inventive step based on the prior art, the applicant can be notified of the ground for rejection for the claim. In this case, the applicant can overcome the grounds for rejection by deleting the Markush alternatives which lack an inventive step. On the other hand, in determining the inventive step of a Markush-type claim or a claim reciting multiple alternative technical features, care must be taken not to expand the effect of one of the alternatives 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 prior art references 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 prior art reference is regarded as a well-known technology, then the examiner may notify the applicant of the grounds for rejection without any evidential material attached. However, it is not appropriate to regard a well-known technology as being the closest prior art reference without any evidential material.

In response to the grounds for rejection 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 argument, the examiner should in principle provide an evidential material with regard to the grounds for rejection. 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 determined case by case in accordance with the concrete scope of the claimed invention, the determination of the inventive step should not be affected by examination of precedents of other inventions. The examination results in the foreign countries which have the different legal systems and customs may be a reference but the examiner does not need to follow the examination results in the foreign countries

(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 prior art reference 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.

(9) In determining whether inventive step of the claimed invention is denied in view of the prior art, the patent examiner should be based on the matters which a person skilled in the art can reasonably recognize from the whole disclosure of the prior art rather than from certain parts of the disclosure of the prior art, which may constitute a ground for lack of inventive step. In addition, where the patent applicant presents other prior art which is either contradictory to the parts of the disclosure in the prior art or make them unclear, the examiner should determine whether a person skilled in the art can easily arrive at the claimed invention, taking into account the prior art comprehensively.

Chapter 4. Enlarged Concept of Novelty

1. Relevant Provisions

Article 29 (Requirements for Patentability)

(3) Notwithstanding paragraph (1), an invention shall not be patentable, if the invention for which a present patent application is filed is identical to an invention described in the specification or drawings as originally filed in another patent application that meets all the following requirements: Provided, That the foregoing shall not apply where the inventor of the present patent application and the inventor of another patent application are the same person, or where the applicant who has filed the present patent application and the applicant for another patent application are the same person:

1. Another patent application should be filed prior to the filing date of the present patent application;
2. Another patent application should be laid open to public under Article 64 or the patent should be registered and published under Article 87 (3) after the present patent application was filed.

(4) Notwithstanding paragraph (1), an invention shall not be patentable, if the invention for which a present patent application is filed is identical to a utility innovation described in the specification or drawings as originally filed in an application for registration of a utility model that meets all the following requirements: Provided, That the foregoing shall not apply where the inventor of the present patent application and the person who made the utility innovation of the utility model for which an application is filed to register are the same person, or where the applicant who has filed the present patent application and the applicant of the application for registration of a utility model are the same person:

1. The application for registration of a utility model should be filed before the filing date of the present patent application;
2. The application for registration of a utility model should be laid open to public under Article 64 of this Act, which shall apply mutatis mutandis

pursuant to Article 15 of the Utility Model Act, or the utility model should be registered and published under Article 21 (3) of the Utility Model Act after the present patent application was filed.

(5) In applying the provisions of paragraph (3), if another patent application is an international patent application pursuant to Article 199 (2) (including an international application deemed as a patent application under Article 214 (4)), "specification or drawings as originally filed in another patent application" in the main body of paragraph (3) shall be construed as "description of the invention, claims, or drawings submitted by the international application date," and "laid open" in subparagraph 2 of the aforesaid paragraph as "laid open or published internationally under Article 21 of the Patent Cooperation Treaty", respectively.

(6) In applying the provisions of paragraph (4), if an application for registration of a utility model is an international application for registration of a utility model under Article 34 (2) of the Utility Model Act (including an international application deemed an application for registration of a utility model under Article 40 (4) of the aforesaid Act), "specification or drawings as originally filed in an application" in the main body of paragraph (4) shall be construed as "description of a utility innovation, claims, or drawings submitted by the international application date," and "laid open" in subparagraph 2 of the aforesaid paragraph as "laid open or published internationally under Article 21 of the Patent Cooperation Treaty", respectively.

Note) The phrase "after the filing date of the present patent application" was amended to "after the present application was filed" on February 3, 2001. This amendment was made in consideration of difficulty in applying the provisions for a patent application which was filed on the same day as the publication date of another patent application but earlier in time than the publication time of another patent application. The amended requirements apply based on the time of publication rather than the date of publication. As for a patent application filed before June 30, 2001, previous provisions shall be applied.

2. Purport of Article 29(3)

For an applicant, an invention described in a specification or drawings, if not in claims, which is usually disclosed 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-filed application under Article 36 of the Patent Act, leading to possible delays of examination of a subsequent application until the examination of the prior-filed 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) to (6) of the Patent Act, the following conditions shall be met.

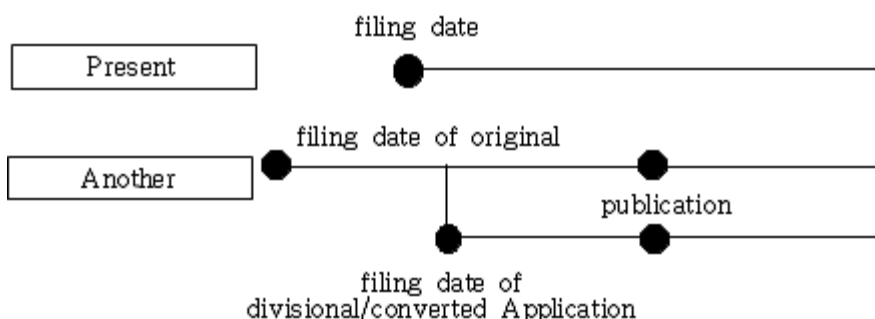
(1) Another application for a patent or for a registration of a utility (referred to as "another application" hereinafter) shall have been filed before the filing date (the filing date of the first filing country in case of the application with priority claim under the Paris Convention or the filing date of the prior-filed application in case of the application with domestic priority claim) of the present patent application (referred to as "present application" hereinafter).

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) to (6), the effective 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 (3,4), 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 relied upon as prior art if the filing date of the original application is prior to that of the present patent application.

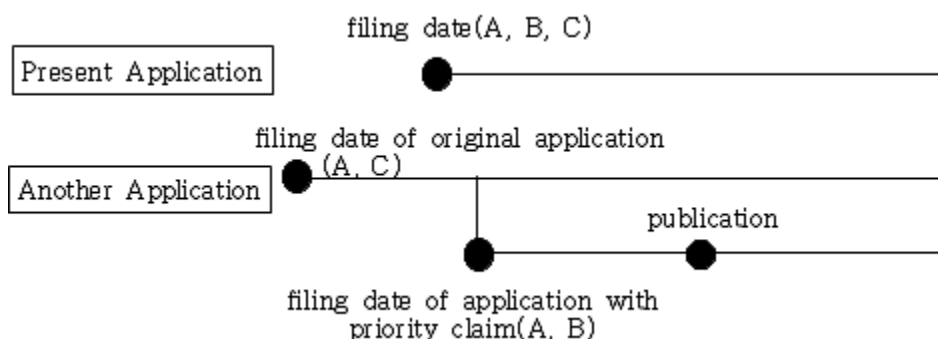


② Where another application is one with a priority claim under the Paris Convention, the filing date in the first country is deemed as the filing date of another application, for an invention commonly disclosed in the specification or drawings(referred to as an "specification, etc." hereinafter) attached to the application in the first country and in the specification or drawings as originally filed in the application with the priority claim.

(Example 1)

Invention A of another application can be relied upon as a prior art to the present patent application, because Invention A is described in the application in the first country and thus the filing date for Invention A of

another application is deemed to be the filing date of the application in the first country when applying Article 29 (3,4) of the Patent Act. Invention B cannot be relied upon as a prior art because Invention B was not disclosed in the application filed in the first country. Meanwhile, Invention C, which is described in the application filed in the first country but is not included in another application with priority claim cannot be relied upon as a prior art to the present patent application because Invention C is not filed for a patent application in Korea.



③ Where an examiner relies on an invention described in the original specification of a prior-filed application which was a basis for a domestic priority claim or an application with a domestic priority claim thereof (referred to as a "later-filed application" hereinafter) as an invention of another application under Article 29 paragraph (3) to (6), it is treated as follows:

(a) The invention commonly disclosed in the original specification of both prior-filed and later-filed applications, is deemed as another application filed on the filing date of prior-filed application and should be applied in the provision of Patent Act Article 29 paragraph (3) and (4) (Patent Act Article 55 paragraph (3) to (6)). The invention solely disclosed in the original specification, etc. of a later-filed application but not in that of prior-filed application, is deemed as another application filed on the filing date of later-filed application and should be applied in the provision of Patent Act Article 29 paragraph (3) to (6) (Patent Act Article 55 paragraph (4)). The invention solely disclosed in an original specification, etc. of prior-filed

application but not in that of later-filed application should not be applied in the provision of Patent Act Article 29 paragraph (3) to (6) (Patent Act Article 55 paragraph (4)).

A prior-filed 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-filed application (Patent Act Article 56 paragraph (1)) and is not laid open. Therefore, where a later-filed application is laid open or published, the invention commonly disclosed in the original specification of both prior-filed and later-filed applications is deemed as laid-open at the time for lay-open or publication of later-filed application. In addition, where an invention was not disclosed in the original specification of the prior-filed or later-filed applications but newly described through the amendment, the treatment above does not apply. Where an invention was not described in the original specification of later-filed application but described in the original specification of prior-filed application, the invention is not deemed to be laid open to the public. Therefore, Article 29 paragraph (3) to (6) are not applied to such an invention.

(b) In the case of (a), where a prior-filed 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-filed and later-filed applications is deemed as another application filed on the filing date of later-filed application and should be applied in the provision of Patent Act Article 29 paragraph (3) to (6) (Patent Act Article 55 paragraph (5)).

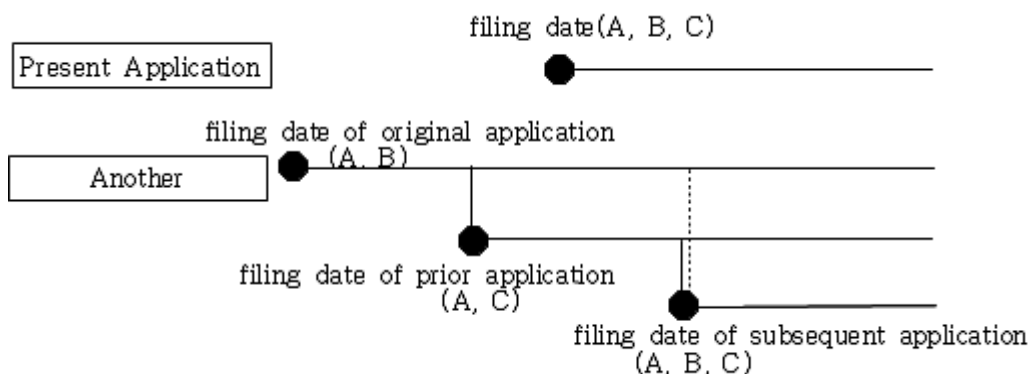
(Example 1)

As example ① shows below, where a later-filed application is filed with a priority claim based only on a prior-filed application, among the inventions A and C described in the prior-filed application, the invention A disclosed in the application filed in the first country, which is a basis of the priority claim of the prior-filed application under the Paris Convention, is considered to be

filed at the filing date of later-filed application under Article 29 paragraph (3). Therefore, invention A of the later-filed application cannot be relied upon as a reference under Article 29 paragraph (3,4) even though the invention A is described in the prior-filed application. The invention C of the prior-filed application can only be relied upon as a reference.

(Example 2)

Meanwhile, as example ② shows below, where a later-filed application was filed with priority claims based on the application filed in the first country as well as a prior-filed application, the invention A can be relied upon as a reference under Article 29 paragraph (3,4).



(Footnote)

Case ① : where a later-filed application is filed with a priority claim based only on a prior-filed application

Case ② : where a later-filed application is filed with priority claims based on the application filed in the first country as well as a prior-filed application

(2) Another application should be laid open or published for registration after the present 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 rejection 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 to reject, invalidation, withdrawal and abandonment of the application, the application cannot be relied upon as a reference under Article 29 paragraph (3).

(3) An invention described in the claims of the present application should be identical to an invention or utility innovation described in the original specification of another application

The invention described in the claims of the present application should be completely or substantially identical to an invention or utility innovation described in the original specification of another application. In addition, even if the matters which have been described in the original specification of another application are omitted by the amendment after the filing, Article 29 paragraph (3,4) is implemented.

4. Exceptions for applying the provisions of Enlarged Concept of Novelty

An application falling within the following conditions are not considered as another application under Article 29 paragraph (3) to (6).

(1) In a case where an inventor of the present application is the same as the inventor of another application

「The inventor」 of the present application and another application means the inventor described in the application cover sheet. In case of joint inventions, all inventors of present application must completely coincide with those of another application. However, even if all inventors do not completely coincide, 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 grounds for rejection, in which another application is relied upon as a reference due to the difference of the inventor, he or she has a right to request documents to prove that the inventors added or amended are true inventors.

(2) Where the applicant of the present application at the time of filing is the same as the applicant of another application

The applicants of the present application and another application should be identified and compared at the time of filing the present 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 present 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. Special Rules Where Another application is an International Application

(1) Where another application is an international application or international application considered to be patent application by decision, the following points are different when applying Article 29 paragraph (3,4), compared to another application which is not an international application.

① Where another application and the present application under examination all are filed on and before December 31, 2014 or where another application is filed on and before December 31, 2014 and the present application under examination is filed on and after January 1, 2015

a. As to another application, where another application is an international application, “laid open to public ” under Article 29, paragraph 3 shall refer to “laid open to public or international publication under Article 21 of the PCT”, “invention or utility innovation disclosed in the specification or drawings originally attached to an application” to “invention or utility innovation disclosed in the specification, claims or drawings of an international application submitted at the international filing date” in case of an application filed in Korean, but to “invention or utility innovation disclosed both in the specification, claims or drawings of an international application

submitted at the international filing date and in the translation ” in case of an application filed in foreign language.

b. Where Article 29, paragraph 3-6 applies to an international patent application claiming the domestic priority, among the inventions disclosed both in the specification, claims or drawings and in its translation of the international application submitted at the date of filing an international application, the invention disclosed in the specification or drawings of a prior-filed application based on which the domestic priority is claimed shall be deemed to have been open to public inspection with respect to the prior-filed application when the international application is published internationally under Article 21 of the PCT or published for registration of a patent.

c. Where another application is an international patent application under Article 29, paragraph 5-6, the extent that enlarged novelty of this international patent application is applied shall be the invention disclosed both in the specification, claims or drawings of the international patent application submitted at the international filing date of the international application and in its translation. However, in an instance in which another application claims domestic priority based on the prior-filed application which is an international application, where the invention of the present application is identical to the invention disclosed in the specification, claims and drawings submitted at the date of filing the prior-filed application, it shall be rejected over the specification, claims and drawings submitted at the international filing date of the prior-filed application.

② Where another application and the present patent application under examination are all filed on and after January 1, 2015

a. Where another application is an international application, “laid open to public inspection” under Article 29(3) and (4) of the Patent Act shall refer to “laid open to public inspection or international publication under Article 21 of the PCT”, and “a specification or drawings originally attached to a patent application” shall refer to “a description, claims or drawings submitted until the date of filing an international application”. However, when applying

Article 29(3) and (4) of the Patent Act, where an international patent application or a utility model application is deemed to have been withdrawn since an applicant did not submit a Korean translation of the description and claims within the specified period under Article 201(4) of the Patent Act, they cannot be relied upon as another application under Article 29(3) and (4) of the Patent Act.

b. When applying Article 29, paragraph (3)-(6) to an international patent application claiming domestic priority, among the inventions disclosed in the specification or drawings of the international application submitted at the international filing date , the invention disclosed in the specification or drawings of a prior-filed application on which the domestic priority is claimed, shall be deemed to have been laid open to public with respect to the prior-filed application, as of the international publication date of the international application under Article 21 of the PCT or the publication date for registration of a patent.

c. Where another application is an international application under Article 29, paragraphs 5 and 6, the extent enlarged novelty of the international patent application is applied is the inventions disclosed in the specification, claims or drawings of the international application submitted at the date of filing the international application. However, where another application claims the domestic priority from a prior-filed application which is an international application, if the invention of the patent application under examination is identical the invention disclosed in the specification, claims or drawings of the prior-filed application submitted at the international filing date of the prior-filed application, the patent application under examination can be rejected based on the specification, claims or drawings of the prior-filed application submitted at the international filing date of the prior-filed 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 utility innovation specified in the description or drawings in another application at its filing (hereinafter referred to as "prior art reference").

6.1 Procedure of Determination of Identicalness

(1) Determine a claimed invention of the present application. The method of determining the claimed invention is identical to that of determining novelty in chapter 2.

(2) Determine the disclosure of the prior art reference. The disclosure of the prior art reference shall be determined by the description of the specification of another application. In doing this, inherent disclosure of the specification of another application which is obvious in light of the common general knowledge might be the basis of a prior art reference under Article 29 paragraph (3) and (4).

(3) Identicalness and difference by comparing the claimed invention with the prior art reference shall be found. In this case, the claimed invention should not be compared with the invention by combining more than two prior art references.

(4) Where there is found no difference between the subject matters defining the claimed invention and the subject matters defining the prior art references, the claimed and prior art references are identical. In this case, the identicalness of the inventions includes the substantial identicalness.

6.2 Substantial Method of Determination of Identicalness

The identicalness of invention is related with determining novelty as well as inventive step (Article 29 paragraph (2)), disclosure exception (Article 30), enlarged concept of novelty (Article 29 paragraph (3), (4)), protection of lawful holder of a right (Article 33, 34), first to file (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.

(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 prior art references 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 prior art references, two inventions are not identical. Meanwhile, if there is no difference between them, the invention in the claims is identical to a prior art reference.

(3) Where the claimed invention is completely or substantially identical to a prior art reference, the claimed invention is identical to a prior art reference.

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 prior art reference, such as simple differences in expression, recognition of effects, purposes or use as well as simple change in configuration or simple differences in usage 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 configuration of both inventions as well as the effects of the inventions. Even if the technical configurations 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 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 configurations 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-filed application discloses that the invention has greater electric insulation, whereas a later-filed 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 configurations of the inventions are the same.

6.3.4 Change in Configurations

Changes in the configurations of the inventions refer to the case where the configuration of the invention is changed and the configuration 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 configuration 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 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 configuration 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 configuration 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 configuration 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 configuration 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 configuration 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 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 configuration 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 configuration 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 configurations 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 configuration 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 configurations are marked as the differences in uses and the differences in uses can be derived from the differences in the uses of other configurations.

(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 configurations of the invention.

(Example) 「A net comprising threads with flat cross sections」 and 「A fish net comprising threads with flat cross sections」

Chapter 5. First-To-File Rule

1. Relevant Provisions

Article 36 (First-to-File Rule)

(1) Where at least two patent applications for an identical invention are filed on different dates, only the applicant of the application having the earlier filing date is entitled to a patent on the invention.

(2) Where at least two patent applications for an identical invention are filed on the same date, only the person agreed upon by all patent applicants may obtain a patent on the invention: Provided, That if patent applicants fail to, or are unable to, reach agreement, none of the patent applicants is entitled to a patent on the invention.

(3) Where an invention for which a patent application is filed, and a utility innovation for which an application for registration of a utility model is filed are identical, paragraph (1) shall apply mutatis mutandis if the applications are filed on different dates, but paragraph (2) shall apply mutatis mutandis if they are filed on the same date.

(4) In either of the following cases, a patent application or application for registration of a utility model shall be deemed never filed for the purposes of paragraphs (1) through (3): Provided, That the foregoing shall not apply where a decision or trial decision to reject the patent application or application for registration of a utility model as the proviso to paragraph (2) applies (including cases to which the aforesaid proviso shall apply mutatis mutandis pursuant to paragraph (3)) becomes final and conclusive:

1. If the patent application or application for registration of a utility model is abandoned, invalidated, or withdrawn;

2. If a decision or trial decision to reject the patent application or application for registration of a utility model becomes final and conclusive.

(5) For the purposes of paragraphs (1) through (3), a patent application or application for registration of a utility model filed by a person who is not an inventor, utility innovator, nor the successor to an entitlement to the patent or the registration of the utility model shall be deemed to have never been filed.

(6) In cases falling under paragraph (2), the Commissioner of the Korean Intellectual Property Office shall order the applicants to report the results of the agreement within a specified period, and the applicants shall be deemed to fail to reach agreement under paragraph (2), if no report is submitted within the period.

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 innovation, 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:

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 configurations of the claimed inventions is found, they shall be deemed identical. Even when differences in the configurations 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 which do not have Status as Prior-filed 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 not hold the status as a prior-filed application.

However, even for an application on which a decision or trial decision to reject 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 as a prior-filed 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 decision to reject is made due to the failure of agreement among the applicants, by not granting the status of prior-filed 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 utility innovator and is not a successor in title to the right to obtain a patent or a utility model registration, too, shall not hold the status of prior-filed application under Article 36 of the Patent Act.

4. Examination Method

4.1 Acknowledgement of reference Date

(1) The reference date used to determine whether the filing dates of the present applications are the same or which is the earliest-filed application shall be recognized in the following manner:

① The reference date of an application without priority claim shall be the actual filing date.

② The reference 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 reference date shall be the earliest filing date among the filing dates of each invention.

③ The reference 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-filed 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 reference 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 reference dates even in the same claims.

④ The reference date of a divisional application and converted application shall be the filing date of the original application.

⑤ The reference 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 reference date shall not be acknowledged.

(2) For the determination of the earliest-filed application, the reference date of an international patent application shall be acknowledged in the following manner:

① Where an application is filed on and before December 31, 2014

The reference 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.

As for an international application considered to be a patent application or an application of utility model registration by decision, the reference 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.

② Where an application is filed on and after January 1, 2015

The reference date of an international application in which the Republic of Korea is a designated state shall be the date of filing the international application on an invention disclosed in the specification or drawings of the international application.

As for an international application considered to be a patent application or an application of utility model registration by decision, the reference date shall be the date of filing the invention disclosed in the specification or drawings of the international 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 different 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 innovation 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 prior-filed application is laid open or registered, the provisos of Article 29(3) and (4) of the Patent Act shall primarily apply to any later-filed application. The proviso on the enlarged novelty can be flexibly applied within the specification or drawings of another application if the application is already laid open even before the claims of the prior-filed application are confirmed.

If a prior-filed application is not laid open, the examination on a later-filed application shall be postponed until the prior-filed application is laid open or registered.

② Where the applicant of a later-filed application is the same as the applicant of the prior-filed application, or the inventors of the inventions disclosed in the prior-filed application and the later-filed 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 later-filed application relating to the same invention, the examiner shall make the decision after the scope of the claims in the prior-filed application is confirmed.

Applicants of Prior-filed/Later-filed Applications	Prior-filed Application	Start of Examination of Later-filed Application
Identical	Published	Examination started, Rejection Ground under Article 36(1) notified (Decision to grant patent after claims in prior-filed application is confirmed)
	Not Published	Examination started, Rejection Ground under Article 36(1) notified (Only application number and claimed invention in prior-filed application specified, decision to grant patent after claims in prior-filed 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-filed application

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 proceedings such as withdrawal of conflicting 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 proceedings 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 conflicting applications by changing or deleting the conflicting invention through the submission of amendment without consultation of the concerned parties.

(4) Even when an invention in a patent application and a utility innovation 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 Conflicting Applications

(1) Confirmation on Conflicting Applications

Where conflicting applications are found from search of whether more than two applications relating to the same invention are filed on the same date, it should be checked whether the patent applicant is identical.

Where an conflicting 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 an conflicting application corresponds to an application filed by an unentitled person, the concerned conflicting application cannot hold the status of a prior-filed application. Therefore, an examiner shall conduct examination considering that the conflicting application has never been filed.

(Note) In examination practices, conflicting applications whose applicant or inventor is different happen rarely, and in most cases conflicting applications

is likely to be found when an applicant incorrectly amended the claims of the original application when filing a divisional application.

(2) The applicant is different

Where no agreement can be reached because a conflicting application is granted a patent, an examiner shall conduct examination on the present application. Where a conflicting application is granted a patent and the applicant of the present application and the applicant of the conflicting application are not the same, an examiner shall notify the applicant of the conflicting 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 present application, an applicant shall indicate the fact of conflicting relation in the ground for rejection.

When consultation on conflicting applications is possible, an examiner shall check whether a request for examination on the conflicting applications is made.

① Where a conflicting application is laid open and requested for examination
Where a conflicting 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 present application and the conflicting 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 to reject.

② Where a conflicting application is yet to be laid open or requested for examination

An examiner shall notify the applicant of the present application of the intention that examination is postponed until the conflicting application is requested for examination or withdrawn or abandoned.

(3) The applicant is identical

① Where a conflicting application is granted with a patent or where a final decision to reject is made to the application on the basis of a ground for rejection specified in Article 36(2) or (3) of the Patent Act of Korea, the examiner shall issue a notice of rejection to the patent applicant under Article 36(2) or (3) of the Patent Act of Korea (if there is another ground for rejection identified, the ground should be included).

② Where a patent is yet granted to a conflicting application, the examiner shall notify the other ground for rejection to the patent applicant without reviewing a ground for rejection specified in Article 36(2) or (3) of the Patent Act of Korea. If another ground for rejection, which is notified after submission of amendment by the patent applicant, is yet remedied, a decision to reject is made.

On the one hand, where the notified ground for rejection has been remedied, when the examiner reexamined, the consequence of the conflicting application, e.g. grant or rejection, is yet decided and another ground for rejection other than a ground for rejection under Article 36(2) or (3) is yet identified, a patent is granted to the present application. However, where a patent is granted to a conflicting application as the examiner reexamined so that a ground for rejection under Article 36(2) or (3) can be

notified to the present patent application, a ground for rejection shall be notified to the present patent application under Article 36(2) or (3) of the Patent Act of Korea. In this case, if claims of the present application are amended later than the date when claims of the conflicting application is finally amended (if there are other grounds for rejection, all of them should be the final grounds for rejection), the final ground for rejection is notified, and otherwise the first ground for rejection is issued.

However, even though the consequence of a conflicting application, e.g. grant or rejection, is yet made, if it is expected that a notice of rejection should be issued to the present patent application under Article 36(2) or (3) of the Patent Act of Korea as a patent is granted to the conflicting application, a ground for rejection under Article 36(2) or (3) of the Patent Act of Korea can be notified together with other grounds for rejection. In this case, the examiner shall request consultation with the patent applicant.

(4) 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 argument as well as a designated period upon a request for consultation.

5. Instruction on Examination

(1) Where a conflicting application is registered and therefore, no consultation can be made, abandoning the patent or the utility model registration would not mean that consultation is possible or the conflicting relation is resolved. It is because that there are no such provisions to recognize the above-mentioned condition and unlike abandoning an application, abandoning a patent or a utility model registration does not mean that a conflicting application is deemed to have never been filed since it cannot enjoy retroactive effect.

(Note) 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 abandoning a patent or a utility model registration can address irregularities relating to a conflicting 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, abandoning 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 conflicting relation, it cannot be deemed that irregularities of a conflicting application are addressed.

(2) Where an application registered for a patent is determined to be invalidated, it shall be deemed never to have been filed, taking into account Article 36(4) and Article 133(3) of the Patent Act of Korea.

(Note) Where the same person filed conflicting applications on the same utility innovation on the same date and all the applications are registered, if one of the registration is invalidated, the registration of the other applications shall be maintained. The fact that these applications were initially conflicting applications does not necessarily mean that the registration of other conflicting applications should be deemed to be invalidated.

(3) It should be noted that after a patent is granted, where patent fee was not paid in due time for grant or for maintenance or for renewal, the patent application is deemed abandoned and thus shall be deemed never to have been filed.

(4) Even though there exists a conflicting application, an examiner may make a decision to reject based on other grounds for rejection instead of referring to the conflicting application or notifying a ground for rejection

based on the conflicting application. Under the Korean Patent Act, when there exists a ground for rejection, an examiner may make a decision to reject after giving an applicant an opportunity to submit a written argument. However, the act does not stipulate that an examiner shall make a decision to reject citing every possible ground for rejection.

(Note) Where more than two applications of utility model registration on the same utility innovation are filed on the same date, but the utility model lacks novelty or inventive step, making the decision to reject without conducting 'consultation proceedings, etc. among applicants' under Article 7(2) and (6) of the Utility Model Act before the revision shall be deemed legitimate.

(5) A genus invention of a later-filed application is deemed to be identical with a species invention of a prior-filed application.

(6) 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-filed application and Invention B is in a later-filed 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 later-filed application and Invention B is in a prior-filed application, but they are not substantially the same, the two inventions shall not be deemed to be identical.

Chapter 6. Unpatentable Invention

1. Relevant Provision

Article 32 (Unpatentable Inventions)

Notwithstanding Article 29 (1), no invention that violates public order or sound morals or is likely to harm public health is patentable.

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 harm 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.

(1) For the invention relating to sexual aides, i) if the product, which is a target of invention to be patented, is quite similar to a specific sexual part, etc. of human body, or ii) if the invention is expected that its practicing

can go beyond sexual morals corresponding to leading consequentially immoral act in public, it is deemed to be against the public order or morality. Provided that, the invention is expected to be conducted in a private place, since it is considered impossible to be against the public order or morality, this rule will not be applied.

(2) Inventions using human body which hurt the body consequentially when conducted, inventions blocking inhumanely the freedom of the body, and inventions damaging the dignity of a human being are deemed to be against the public order or morality.

However, the invention using natural human wastes such as urine, placenta, or blood, etc. extracted from the body artificially and safely is deemed to follow the public order or morality. Provided that, the invention related to food aimed not at the specific purpose such as cure of disease, but at daily ingestion is not accepted because ethically it is not allowed to use parts of human body or its wastes as ingredients of food.

cf) It is not allowed to use urine or placenta of human beings under Standard of Food, chapter 3, the list of 'substances unfit for food', declared by MFDS (Ministry of Food and Drugs and Safety).

(3) 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 harm 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.

**Part IV. Amendment of Specification,
Claims or Drawing(s)**

Chapter 1. Overview of Amendment

1. Article 47 of the Patent Act

Article 47 (Amendments to Patent Applications)

(1) A patent applicant may amend the specification or any drawing accompanying his/her patent application before a certified copy of a decision to grant a patent under Article 66 is served: Provided, That the patent applicant may make an amendment only during the following applicable period (referring to the time in cases falling under subparagraph 3), if he/she has already received notice of the ground for rejection under Article 63 (1) (hereinafter referred to as "notice of the ground for rejection"):

1. Where he/she has received notice of the ground for non-final rejection (excluding notice of the ground for rejection necessitated by the amendment made in response to notice of the ground for non-final rejection) or notice of the ground for rejection that does not constitute notice of the ground for rejection under subparagraph 2: The period set for submitting written arguments in the notice of the ground for rejection;

2. Where he/she has received a notice of rejection necessitated by the amendment made in response to notice of non-final rejection (Where a notice of rejection is issued under Article 66(3)(ii), previous notices issued before the concerned notice shall be excluded): The period set for submission of written arguments in the notice of rejection;

3. Where he/she files a request for re-examination under Article 67-2: The time the request is filed.

(2) An amendment to the specification or drawings under paragraph (1) shall be made within the scope of the disclosure of the specification or drawings as originally filed. An amendment to a foreign language patent application shall be made also within the scope of the disclosure of the final Korean translation (referring to the corrected Korean translation, if a correction is made under the former part of Article 42-3 (6)) or of the drawings (excluding captions in the drawings) as originally filed.

(3) An amendment to the claims made pursuant to paragraph (1) 2 and 3,

may be made only in the following cases:

1. Where the claims are narrowed by restricting or deleting claims, or adding limitations to claims;

2. Where any clerical error is corrected;

3. Where any ambiguous description is clarified;

4. Where an amendment is made to reinstate the claims presented before the amendment going beyond those permissible under paragraph (2) has been made, or to reinstate the claims presented prior to the amendment and to simultaneously amend the claims under subparagraphs 1 through 3.

(4) Where a patent application is amended during the period specified in paragraph (1) 1 or 2, all amendments made prior to the final amendment shall be deemed voluntarily withdrawn.

(5) Notwithstanding the main body of paragraph (1), the specification or drawings of a foreign language patent application may be amended only when a Korean translation has been submitted under Article 42-3 (2).

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 specification 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.

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 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 pendency of the application 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 a permissible 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 made within the voluntary amendment period before the start of an examination or within the period designated for submitting arguments on a non-final rejection. However, where an amendment is made within the period designated for submitting arguments on a notice of grounds for rejection necessitated by the previous amendment made in response to the non-final rejection and where an amendment is made upon a request for reexamination, the scope of the permissible amendment shall be further restricted by only allowing the narrowing of scope of claims, etc. as well as the prohibition of the addition of new matter.

(2) The method to handle an amendment which does not satisfy substantive requirements, too, differs based on the amendment periods. Details are stated in the following table.

Amendment Period	Scope of Amendment		Handling of Illegitimate Amendment
	Description of Invention · Drawing	Claims	
① Before Delivery of Certified Copy of Decision to Grant Patent ② Within Period for Argument Submission in reply to Non-Final Rejection	Prohibition of Addition of New Matter		During Examination: Grounds for Rejection After Registration: Grounds for Invalidation
① Within Period for Argument Submission in response to Rejection necessitated by amendment ② On Request for Reexamination	Prohibition of Addition of New Matter	Prohibition of Addition of New Matter + Further Requirements for Narrowing of Claim, etc.	During Examination: Decision to Refuse to enter Amendment After Registration: Invalidation ground (Except Requirement in Article 47(3))

4. Amendment Period

4.1 Voluntary Amendment Period

The voluntary amendment period refers to the time period before the commissioner of the Korean Intellectual Property Office serves a certified copy of a decision to grant a patent, except for the period under the subparagraphs of Article 47(1) of the Patent Act. In such a case, the time at which the commissioner of KIPO serves a certified copy of a decision to grant a patent is when an examiner sends a certified copy of a decision to grant a patent. Therefore, where an applicant submits an amendment after the examiner has sent out a copy of a decision to grant a patent without receiving the copy, the amendment shall not be admitted.

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 voluntary-amendment of the specification claims or drawing(s).

(Note) The voluntary amendment period includes the time period between applicant's reception of a non-final rejection and examiner's issuance of the rejection.

4.2 Period for Argument Submission in reply to Rejection

(1) If an applicant receives a non-final rejection under Article 63 of the Patent Act or a notice of rejection other than rejection under Article 47(1)(ii)(a notice of final rejection necessitated by amendment), the applicant may submit an amendment to the specification or drawing(s) only within the period designated for the submission of arguments in response to the 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 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) Where a notice of rejection under Article 47(1)(ii) of the Patent Act (a notice of final rejection necessitated by amendment) is received, an applicant may amend the specification or drawing(s) only within the period designated for the submission of arguments. However, the scope of the permissible amendment in this period shall be further limited.

4.3 Request for Reexamination

An applicant shall be able to request a reexamination within 30 days from the receipt of a certified copy of a decision to reject and amend the specification or drawing(s) attached to the application upon a request for reexamination.

The period designated for an appeal against a decision to reject can be extended if the requirements specified under Article 15(1) of the Patent Act are satisfied. Therefore, an applicant shall be able to make an amendment, upon a request for reexamination, within the extended period for an appeal against a decision to reject.

Chapter 2. Scope of Permissible Amendment

1. Voluntary Amendment and Amendment in reply to Non-final Rejection

Article 47(2) of the Patent Act prescribes that an amendment to the specification, or drawing(s) “shall be made within the scope of the disclosure of the specification or drawing(s) attached to the patent application.” Therefore, the introduction 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 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 introduction of New Matter

(1) ‘New matter’ refers to a matter which goes beyond the scope of the disclosure of the specification or drawing(s) as originally filed. In this context, matters in the specification or drawing(s) as originally filed (hereinafter referred to as ‘the original specification’) mean the matters which are explicitly described in the specification or drawing(s), or which without any explicit description, would be recognized by a person skilled in the art to be disclosed in the specification or drawing(s) in light of ordinary skill at the time of filing the application.

In other words, matters which a person skilled in the art would recognize not to be explicitly described in the original specification or drawing(s) but to be obvious from the disclosure of the original specification, shall not be new matter.

(Note) The previously-used term ‘change of subject matter’ has been deleted and an amendment to the 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 matter, which 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 matter, other than the matter 「within the scope」 .

(2) The subject of assessment in addition of new matter shall be the amended specification or drawing(s). The addition of new matter to any of the specification or drawing(s) shall not be permitted.

(3) The specification or drawing(s) as originally filed shall be the subject of comparison of whether new matter is added to the amended specification or drawing(s). In this context, the phrase 'as originally filed' refers to the submission of the specification or drawing(s) along with the patent application by the filing date of the application. The matter added to the specification or drawing(s) through an amendment after the filing date of the application shall not be the matters described in the specification or drawing(s) as originally filed.

As to a foreign language patent application, Chapter 5 of Part I [2. New matter in the original disclosure and new matter in the Korean translation] shall be referred to.

In the case of divisional/converted applications, 'matter described in the specification, or drawing(s) as originally filed' refers to the matter described in the specification or drawing(s) attached to the divisional/converted applications on the filing date of the divisional/converted applications. It does not refer to matter described in the specification 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 or drawing(s) shall be determined by whether matters described in the amended specification or drawing(s) (the subject of assessment) are included in the scope of the disclosure of the original specification or drawing(s) (the subject of comparison).

In this context, the phrase of being included in the scope of the disclosure of the original specification or drawing(s) does not mean being literally identical within the scope of matters described in the specification, or drawing(s) as originally filed. Also, matters that a person skilled in the art would clearly recognize from the disclosure of the specification or drawing(s) as originally filed shall be deemed as being included in the scope of the disclosure of the original specification or drawing(s).

1.2 Detailed Assessment Method of Prohibition of Addition of New Matter

(1) Since a first country application or a prior-filed application which forms the basis of the priority claim shall not correspond to the specification or drawing(s) as originally filed, 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 add new matter.

(4) Where an amendment is made to narrow a claim as from a genus to a species, unless the species is supported by the original specification and drawings, or unless one skilled in the art would readily recognize the species from the genus in light of ordinary skill in the art at the time the patent application was filed, it shall be viewed as introduction of new matter.

Ex1) Where “a transparent plastic plate with fine protrusions formed thereon for guidance” is amended to “a transparent ABS plastic plate with fine protrusions formed thereon for guidance”, unless the original specification discloses ABS resin as plastic materials or unless it is obvious to one skilled in the art that transparent plastics are normally made from ABS

resin, the amendment to insert the term “ABS” constitutes the introduction of new matter.

Ex2) Concerning a rotor control unit, where “a sensor detecting rotation of the toothed wheel of a rotor” is amended to “a proximity sensor detecting rotation of the toothed wheel of a rotor” and if one skilled in the field of rotor control device can intuitively associate a sensor detecting rotation of a toothed wheel of a rotor with a proximity sensor, the amendment shall be supported by the original specification.

(5) Where an amendment is made to broaden a claim as from a species to a genus, if the genus encompasses other species than the species disclosed in the original specification, and if the other species may have different function in addressing the problem to be solved by the invention or may accomplish different effects, the amendment shall constitute introduction of new matter. Where some limitations are deleted and the deleted limitations are described in the original disclosure as essential in solving a problem, it shall be viewed as introduction of new matter.

However, where a claim is broadened by deleting arbitrarily added limitations having nothing to do with solving problems, the amendment shall be supported by the original specification.

Ex1) Where “a connector comprising a contact protrusion having a protruded curved-convex surface and a depressed portion being v-shaped in cross section in the width direction” is amended to “a connector comprising a protruded convex-shaped portion and a depressed portion being v-shaped in cross section in the width direction”, the ‘convex-shaped portion’ is broadened to ‘curved-convex surface. Where the slope of chamfer of the convex-shaped portion becomes the same with the one of the depressed portion, electrical contact shall be changed, thereby expected effect from the original specification being changed accordingly. So, the amendment is viewed as introduction of new matter.

Ex2) Where “a traffic control method comprising steps of communicating the location of a vehicle, speed and identifying code~” is amended to “a traffic control method comprising steps of communicating the location of a vehicle and speed~”, although the traffic control method comprising a step of communicating only the location of a vehicle and speed is not disclosed in the original specification, the problems to be solved can be addressed by communicating “the location of a vehicle and speed” according to the disclosure of the original specification, and the limitation “identifying code” is an arbitrarily added limitation having nothing to do with the problems to be solved. Therefore, the amendment shall fall within the scope of the original specification.

(6) Where an amendment is made for adding or changing or narrowing numerical range, unless new numerical range is disclosed in the original specification and unless it can be derived from the description of the original specification, it shall be viewed as introduction of new matter.

Ex) Where “melting hot-melt adhesive by heating to the range of 120-220 degree Celsius” and “extrusion temperature of PE sheet at which hot-melt adhesive is adhered is in the range of 160-180 degree Celsius” are amended to “hot-melt adhesive having the melting point of 120-160 degree Celsius”, taking into account the disclosure of the original specification, hot-melt adhesive should be a liquid phase in the range of 120-220 degree Celsius; and hot-melt adhesive should be melted in the range of 160-180 degree Celsius which is the extrusion temperature of PE sheet; it is obvious in view of the law of nature that melting point of hot-melt adhesive should be lower than 160-180 degree Celsius in order for hot-melt adhesive to be melted in the range of 160-180 degree Celsius. Therefore, “hot-melt adhesive having the melting point of 120-160 degree Celsius” may not be viewed as introduction of new matter.

(7) Amendment to delete some elements from the claims (so called ‘negative limitations’) is permitted; provided, however, that such a negative

limitation does not introduce any new technical matter, which is not disclosed in the original specification. In particular, where the claimed invention relating to methods of medical treatment does not explicitly recite whether a human being or an animal is to be treated by the method, and where it is obvious from the original specification that the invention is not directed only to particular animals, the amendment to explicitly exclude a human being in the claims shall not be viewed as introduction of new matter.

Ex) Where 'treatment methods for mammals' is amended to 'treatment methods for mammals except for humans' or 'treatment methods for livestock'

(8) Where separate configurations or embodiments independently described in the original specification are combined as a single invention by an amendment, unless such a combination is described in the original specification or unless one skilled in the art can easily derive the combination taking into consideration common technical knowledge at the time of filing, it shall be viewed as introduction of new matter.

Ex) Where a refrigerator including 'a shaking lever' (the 1st embodiment) and a refrigerator including 'a conveying unit' (the 2nd embodiment) are separately disclosed, and the specification is amended to add a refrigerator including 'a shaking lever' and 'a conveying unit', because the original specification describes that a conveying unit (of the 2nd embodiment) replaces a shaking lever (of the 1st embodiment), and it does not describe that a conveying unit and a shaking lever are attached to one axis of rotation, the amendment shall be viewed as introduction of new matter.

(9) The amendment to add an embodiment or a test example shall be generally viewed as introduction of new matter; provided, however, that where the amendment is deemed to fall within the scope of the disclosure of the original specification, it shall not be viewed as introduction of new matter.

(10) The amendment to add new effects of the claimed invention shall be generally viewed as introduction of new matter; provided, however, that where one skilled in the art could easily recognize the effects from the configuration of the invention disclosed in the original specification or where it is commonly known in the relevant field that such effects can be accomplished from the configuration of the invention described in the original specification, it shall not be generally viewed as introduction of new matter.

(11) The amendment to simply add the title of prior art documents and the amendment to add both the short summaries of the prior art documents and the title of the documents shall not be viewed as introduction of new matter.

However, where the disclosure of a prior art document is added to address lack of written description requirements for the description of the invention or to complete an incomplete invention, or where the comparison between the claimed invention and the prior art are added to suggest advantages of the claimed invention, it shall be generally viewed as introduction of new matter.

Ex) With respect to the practicing of the claimed invention, where the following phrase 'the multi-directional distribution device which is an element of the claimed invention can be practiced by referring to embodiments of a bi-directional distribution device as presented in Republic of Korea Patent Application Publication No. 00' is added in the description of the invention, the amendment is related to requirements for the description of the invention such that this shall not be deemed to be just the summaries of prior art documents. Accordingly, this shall be viewed as introduction of new matter.

(12) Though the added matters through amendment are well-known prior arts, if a person skilled in the art does not clearly recognize the added matters as implicitly described in the original 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 disclosure of the specification or drawing(s).

(13) Where one skilled in the art would not only recognize the existence of the error in the specification but also recognize the appropriate correction, an amendment to correct an obvious error does not constitute introduction of new matter.

Further, where one skilled in the art clearly understands which of two or more conflicting descriptions is correct based on the disclosure of the original specification or drawing(s), the amendment of correcting the conflicting descriptions shall not be deemed as introduction of new matter.

2. Amendment in reply to Rejection necessitated by amendment or on Request for Reexamination

An amendment in reply to the rejection necessitated by a previous amendment 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 introduction of new matter under Article 47(2) of the Patent Act.

2.1 Restriction of Amending Claims

An amendment to claims among the amendments in response to the rejection necessitated by a previous amendment or upon a request for reexamination in accordance with Article 47(3) of the Patent Act shall be one of the followings: narrowing of claims by restricting 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 claim is amended, the dependent claim which refers to the independent claim shall be deemed amended.

Moreover, whether an amendment to claims corresponds to the above-mentioned cases shall be determined by comparing the claim which is under examination upon the notice of final rejection with the claim having the same claim number. However, if a claim after an amendment is clearly understood to be the same as the amended claim with the different number, the permissibility 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 legitimate as an amendment under Article 47(3) of the Patent Act. However, even in the aforementioned case, if one claim contains two or more inventions (a Markush-type claim or a claim citing multiple claims), such inventions shall be assessed individually.

(Note) Determining whether an amendment meets the requirements based on the amended term or phrase may ① raise an issue of fairness between an amendment of a whole claim (where the invention described in the claim is re-described) and an amendment made to parts of the claim,. 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 Narrowing of Claims by restricting or Deleting Claims or Adding Element to Claims

Cases of narrowing of claims under Article 47(3) of the Patent Act shall be limited to restricting a claim, deleting a claim and adding a technical element to a claim. Such cases are as follows.

(1) Restricting a claim is to internally restrict the scope of the invention recited in the claim and includes reduction of numerical range, change from genus to species and so on.

① Reduction of Numerical range

It refers to the case where the range of numerical limitation is reduced within the range recited in the original claim. However, if reduction of the numerical range and extension of the range are made simultaneously, as in the amendment from temperatures of 10~20°C to 15~30°C, it shall not be deemed as reduction of numerical scope.

② Change From Genus invention To Species invention

It refers to the case where the genus covering matters of the same class or type is changed to one of the species embraced by the genus, such as amending writing instruments to fountain pens.

③ Deletion of Elements Alternatively Recited

Where multiple elements are alternatively recited, an amendment of deleting parts of the elements constitutes the restriction of claims, recognized as a legitimate amendment. Examples of the case include deleting A or B from the elements alternatively recited, 「A or B」 .

④ Reduction of Referred Claim from Claims which refers to Multiple Claims

Deletion of parts of the referred claims from claims which refers to multiple claims shall be deemed as an amendment of limiting and restricting claims, just like the deletion of alternative element.

(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) The scope of an invention is narrowed by adding new technical features described in the description of the invention or claims. Examples of the

case include changing the description of 'a bottle opener with B attached to A' to 'a bottle 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-added or an invention is added to claims by adding alternative elements or adding a referred claim

However, the inevitable addition of a claim resulting from the reorganization of the claims shall be exempted.

(e.g.) [Before Amendment]

Claim 1: The apparatus comprising Elements A and B

Claim 2: The apparatus of Claim 1, further comprising Element C

Claim 3: The apparatus of Claim 1 or 2, further comprising
Elements D and E

[After Amendment]

Claim 1: Deleted

Claim 2 (Amended): The apparatus comprising Elements A, B and C

Claim 3 (Amended): The apparatus comprising Elements A, B, D and E

Claim 4 (Newly-added): The apparatus comprising Elements A, B,
C, D and E

※ Whether unity of the invention in the abovementioned example is maintained is out of the discussion.

② Where a claim goes beyond the original scope due to the following amendments

- Change from species to genus

e.g.) originally: ...supported by a spring...→ ...supported by an elastic body...

-Deletion of elements from a set of elements

e.g.) originally: A car comprising A, B, C and D → A car comprising A, B and C

-Addition and Deletion of elements in a set of elements

e.g.) originally: The apparatus comprising A, B and C
→ The apparatus comprising B, C, D and E

-Broadening of numerical range

e.g.) originally: at temperatures of 10~50°C → at temperatures of 10~70°C

-Replacement of element

e.g.) originally: joined with a bolt. → joined with a rivet..

-Change of numerical range

e.g.) originally: at temperatures of 10~20°C → at temperatures of 30~50°C

2.3 Correction of Clerical Errors

Correcting clerical errors 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 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 language, where the element of a claim does not match 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 redrafting 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 new matters are added on a particular stage of an amendment, an amendment for reinstating the original claim before addition of new matter shall be permitted. If such amendments were not permitted, 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 to reject, which is too harsh for an applicant.

In addition to an amendment of reinstating the original claim before addition of new matter, an amendment of amending claims according to Article 47(3)(i) to (iii) while deleting the new matter shall be permitted. 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.

Type	Amendments / Office Actions
Examination history	<p>[Before Examination] Claim 1 : The apparatus comprising A+B Claim 2 : The apparatus comprising A+B+C [Non-Final Rejection] Claim 1 lacks inventive step over the prior art reference. [After first Amendment] Claim 1 : The apparatus comprising A+B+D (D is new matter. It involves an inventive step.) Claim 2 : The apparatus comprising A+B+C [Final Rejection necessitated by the first amendment] D in Claim 1 is new matter.</p>

Example1	Amendment	[Amendment made after the final rejection necessitated by the first amendment] Claim 1 : The apparatus comprising A+B Claim 2 : The apparatus comprising A+B+C
	Assessment	[Permission of Amendment]Amendment is permitted since it has reinstated the claims just before new matter is added. [Decision to reject] A decision to reject is issued since Claim 1 lacks inventive step.
Example2	Amendment	[Amendment made after the final rejection necessitated by the first amendment] Claim 1 : The apparatus comprising A+b (b is the species of B. It involves an inventive step.) Claim 2 : The apparatus comprising A+B+C
	Assessment	[Permission of Amendment] Amendment is permitted since Claim 1 falls under the case where the claim is further limited while deleting new matter added. [Decision to Grant a Patent] A decision to grant a patent is made since no grounds for rejection are found in Claim 1 and 2.
Example3	Amendment	[Amendment made after the final rejection necessitated by the first amendment] Claim 1 : Deleted Claim 2 : The apparatus comprising A+B+C
	Assessment	[Permission of Amendment]Amendment is permitted since Claim 1 falls under the case where the claim is deleted while deleting new matter added. [Decision to Grant a Patent]A decision to grant a patent is made since no grounds for rejection are found in Claim 2.
Example4	Amendment	[Amendment made after the final rejection necessitated by the first amendment] Claim 1 : The apparatus comprising A+B+E (A+B+E is the invention within the scope of the original specification. It involves an inventive step.) Claim 2 : The apparatus comprising A+B+C

	Assessment	<p>[Permission of Amendment]Amendment is permitted since Claim 1 falls under the case where the claim is narrowed by adding E to the claim while deleting new matter added.</p> <p>[Decision to Grant a Patent]A decision to grant a patent is made since no grounds for rejection are found in Claim 1 and 2.</p>
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Chapter 3. Refusal to enter Amendment

1. Articles 51 and 63 of the Patent Act

Article 51 (Refusal to Enter Amendments)

(1) If an examiner finds that an amendment made under Article 47 (1)(ii) or (iii) violates paragraph (2) or (3) of the same Article, or that another ground of rejection necessitated by the amendment arises (excluding an amendment to delete a claim among amendments made under paragraph (3)(i) or (iv) of the same Article), he/she shall refuse to enter the amendment with a decision: Provided, however, that the foregoing shall not apply where an amendment falls under any of the following conditions:

1. *Ex-officio* amendment under Article 66(2): earlier amendment made before the *ex-officio* amendment

2. *Ex-officio* re-examination under Article 66(3): Amendment before revocation of patents granted

3. A request for re-examination under Article 67(2): Amendment before the request

(2) A decision to refuse to enter an amendment under paragraph (1) shall be made in writing, stating the grounds therefor.

(3) No appeal shall be permitted against a decision to refuse to enter an amendment under paragraph (1): Provided, however, that the foregoing shall not apply where a decision to refuse to enter an amendment (In case of *ex-officio* re-examination under Article 66(3), a decision to refuse to enter an amendment before revocation of patents granted is excluded; and where a request for re-examination is filed under Article 67(2), a decision to refuse to enter an amendment before that petition shall be excluded) is contested in an appeal to the decision to reject the claim of a patent under Article 132(17).

Article 63 (Notice of Grounds for Rejection)

(1) Under any of the following conditions, the examiner shall notify the patent applicant of a ground for rejection and give an opportunity to submit

written arguments within the specified period; provided, however, that where he intends to refuse to enter an amendment under Article 51(1), the foregoing shall not be applied;

1. Where the examiner intends to make a decision to reject the patent application under Article 62
2. Where the examiner intends to make a decision to reject the patent application based on the already notified ground of rejection before revocation of a patent granted resulted from *ex-officio* re-examination under Article 66(3)(i).

2. Requirements for Refusal to enter Amendment

(1) If an amendment made within the period for submitting arguments in reply to the final rejection necessitated by a previous amendment or an amendment upon a request for reexamination is in violation of Article 47(2) and (3) of the Patent Act or, if it is recognized that a new rejection for the application is necessitated by the amendment, the amendment shall be refused to be entered in accordance with Article 51(1).

In this context, “the case where a new rejection is necessitated by the amendment” means where a ground for rejection which did not exist prior to the amendment newly arises due to the submission of the amendment (where the amendment renders the claim indefinite or where rejection grounds of lack of novelty or inventive step are newly found and so on). Rejection grounds that were present in the application 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 rejection is necessitated by the amendment.

(2) In case of *ex-officio* amendment and *ex-officio* re-examination and

amendment upon request for reexamination, if the previous amendment which should be refused to be entered is overlooked in examination proceedings, the previous amendment shall be exempt from the assessment of whether to be refused.

(3) In assessing whether a new rejection is necessitated by amendment or not, the case where a new rejection is necessitated by deletion of a claim according to Article 47 (3)(i) or (iv) shall be exempt.

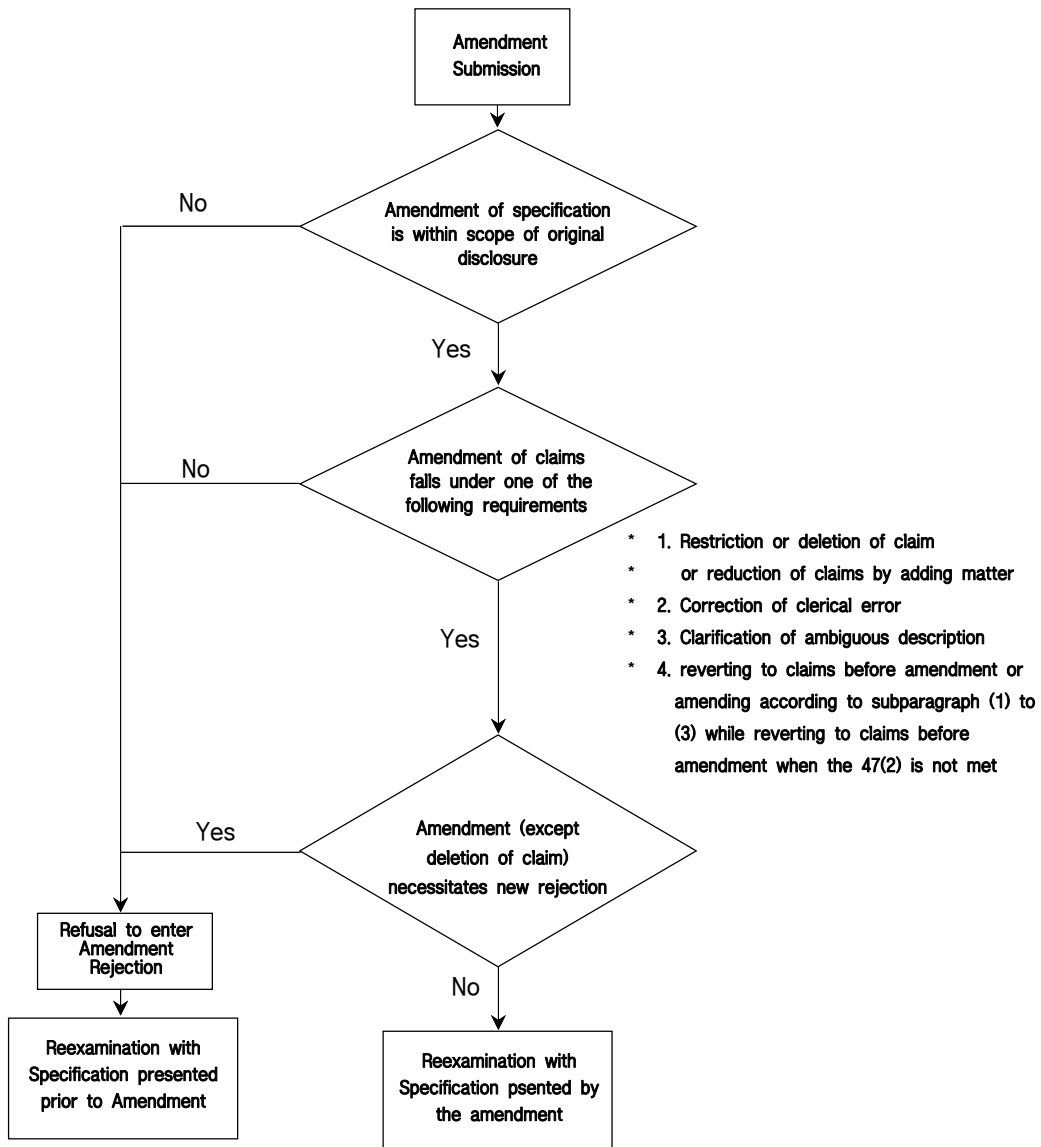
In this context, the case of 'where a new rejection is necessitated by the deletion of a claim' includes either a case where the claim is rendered indefinite by deletion of a claim without amending the dependent claim that refers to the deleted claim or a case where a claim is deleted but the dependent claim directly or indirectly referring to the deleted claim is amended to refer to a wrong claim.

(Note) Under Article 51(1) of the Patent Act of Korea, if it is confirmed that a new rejection is necessitated by an amendment, the amendment shall be rejected, but Article 51(1) of the Patent Act of Korea does not apply to deletion of a claim. The intent of the law is to expedite the examination proceedings by avoiding situations where a notice of a new ground of rejection and a further amendment in reply to the new rejection are repeated when the new rejection is necessitated by the amendment. However, in case of deletion of a claim, unlike other cases, e.g. amendment to limit or add limitation to a claim, even if a new rejection is necessitated by such amendments, examination is neither delayed nor the examiner should be overburden with examination. In this regard, the law intends to further protect the applicant by giving an opportunity for amendment in response to a notice of rejection.

3. Examination Method of Requirements for Refusal to enter Amendment

(1) Whether an amendment made after the final rejection necessitated by a previous amendment or an amendment upon a request for reexamination 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 refuse to enter the concerned amendment.



(2) Whether an amendment meets substantive requirements shall be assessed according to the following sequence.

(3) Since the applicant cannot make an appeal to a decision to refuse to enter an amendment, a decision to grant or reject a patent or a notice of non-final rejection shall be made after re-examining the specification before the amendment, along with refusal to enter the amendment.

4. Cautions for Making a Decision to refuse to enter Amendment

(1) Where an amendment containing multiple amended matters is submitted, all of the amended matters shall be assessed one by one to determine whether the concerned amendment is to be refused or not. Therefore, if any of the amended matters is in violation of Article 47(2) and (3) of the Patent Act or the amendment (except an amendment of deleting claims) or necessitates a new rejection, the whole amendment shall be refused to be entered.

In this context, the amendment which serves as a unit of refusal is divided by the submission of Form(ix) in the Enforcement Rules of the Patent Act.

(2) Where multiple amendments are made during the designated period for submission of arguments prescribed in the notice of final rejection necessitated by a previous amendment, Refusal to enter amendment shall be determined per each of the amendments irrespective of whether the amendments 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」. As to the patent application filed on and after July 1, 2013, as any other amendments submitted before the last amendment shall be deemed to have been withdrawn, refusal to enter the amendment shall

be determined based on the last filed amendment.

(3) Where a decision to reject has been revoked according to Article 176(1) and (2) and the application has been remanded to an examination bureau, the reason which leads to revocation of the decision shall be binding upon the examiner pursuant to Paragraph (3) of the same article (the disposition of an appeal decision and the findings of fact which form the premise of the decision) in the examination of the remanded patent application.

Only a decision to reject a patent or a decision to refuse to enter an amendment is revoked in the application which has been remanded to the examiner. The proceedings undertaken by the applicant before the decision during the examination and the proceedings that the examiner has taken shall remain effective. Therefore, the application remanded to the examiner shall be examined as normally as any other applications in ordinary examination proceedings [Article 176(1) of the Patent Act of Korea]. However, where the examiner notifies any rejection necessitated by the amendment made in response to a rejection issued prior to the remand, the rejection to be notified to the applicant shall be non-final, taking into account that it is very harsh for the applicant who has endured the detrimental effect of delay in the examination procedure due to a wrong decision made by the examiner and that in case of *ex-officio* re-examination, a non-final rejection is made when a rejection necessitated by the amendment made in response to the previous rejection prior to examiner's revocation of decision to grant a patent.

(4) Where an amendment submitted in reply to the final rejection necessitated by a previous amendment is refused, but then the decision to refuse to enter the amendment is revoked in an appeal decision, but new grounds for refusal to enter the amendment which have not been mentioned in the decision to refuse to enter the amendment and have not been reviewed during the appeal, the examiner may refuse to enter the amendment based on the new grounds. However, regarding the illegitimate

amendment carried out before a request for an appeal against a decision to reject under Article 170 of the Patent Act, the examiner shall not refuse to enter the amendment, but examine the amendment considering the purpose of prohibiting a decision to refuse to enter an amendment in the examination proceedings and the possibilities of giving an unexpected damage to an applicant if an examiner refused to enter the amendment by citing the grounds overlooked before.

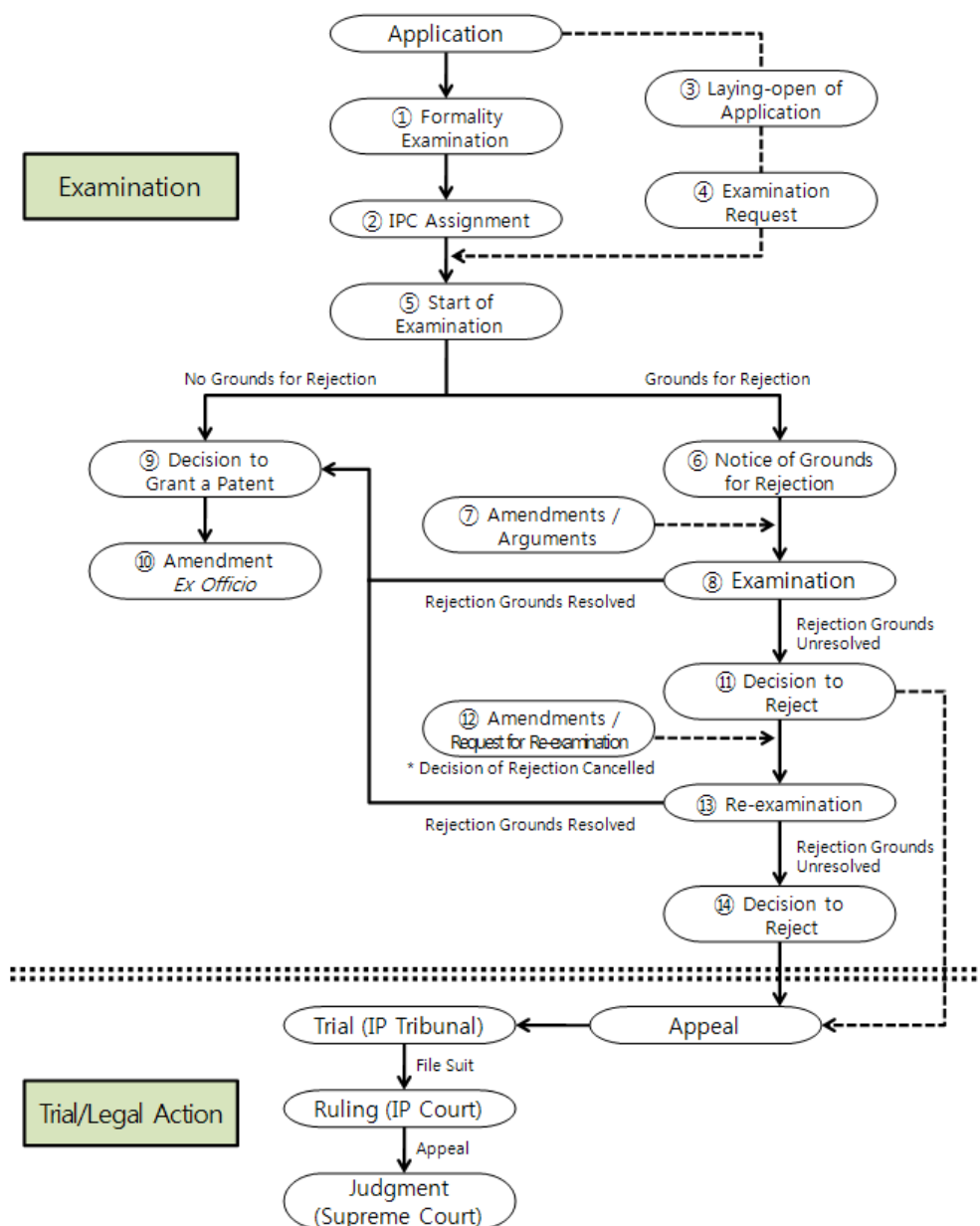
In the meantime, where the patent application filed before June 30, 2009 and undergone the proceedings for reconsideration by an examiner before a trial is revoked and returned, an amendment made thirty days before the filing date of an appeal against a decision to reject shall not be declined on the 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 refuse to enter an amendment is found, an examiner shall not refuse to enter an amendment again.

Part V. Examination Procedure

Chapter 1. General Examination Procedure

1. Overview

1.1 Flow Chart



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, formality requirements of the application, fees, whether to meet provisions on returning application documents 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 Patent Classification (CPC, IPC)

The classification of a patent application is assigned 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 expiration of a period of eighteen months from the date of filing, where priority is 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 request for examination within 3 years for a patent application (or 5 years for a patent application filed before 3.1, 2017) from the filing date.

(5) Start of Examination

The examination is to be carried out in the 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 formality requirements are not satisfied, he may invite an applicant to correct such formal deficiencies.

(6) Notice of Grounds for Rejection

Where the examiner intends to reject a patent application under any subparagraphs of Article 62, the examiner shall give to the applicant a chance to submit arguments by notifying grounds for rejection prior to the issuance of the decision to reject.

(7) Amendments/Arguments

An applicant may submit arguments in response to an examiner's notice of a rejection and may file amendments to the specification or drawing(s) within the period designated in Article 47.

(8) Examination

Taking into account of any amendments or arguments made by the applicant in reply to the 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/she decides to grant a patent.

(10) *Ex Officio* Amendment

When making a decision to grant a patent, an examiner may amend *ex officio* the obvious errors in the specification, drawing(s), or abstract. The examiner shall notify the applicant of the errors to be amended *ex officio* along with a certified copy of the decision to grant a patent. The applicant can decide whether he accept the amendment *ex officio* by the time for paying patent registration fees.

(11) Decision to Reject

When an examiner examines the application again with taking account of any amendments or arguments made in reply to the rejection and considers that the applicant fails to overcome the rejection, the examiner shall issue a decision to reject 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 application (or the extension period if the statutory period is extended). However, the reexamination request is not allowed where a decision to reject is issued after reexamination or where a notice of appeal is filed. Where there is a request for reexamination, the decision to reject the patent application issued prior to the request is deemed to have been withdrawn.

(13) Reexamination

Where a request for reexamination is made, the decision to reject the patent application issued prior to the request is deemed to have been withdrawn. 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 Reject after Reexamination

Where an examiner reconsiders the amendment made at the reexamination

stage, and still finds the grounds for rejection has not been overcome, the examiner shall decide to reject the patent application.

2. Designation of Examiner

The Commissioner of KIPO shall designate a qualified examiner to examine patent applications.

2.1 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 1 year 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 1 year. The period for assistant or joint examination can be shortened if certain requirements are satisfied.

(3) If the claimed 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. 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.

Where 2 or more related patent applications, applications for registration of utility model, or patent applications and applications for registration of utility model, which have common or corresponding technical features and are filed by the same applicants(including the case where a part of 2 or more applicants is overlapped) on the same date, have been assigned to different examiners one of the examiners can consult with the other(s).

(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.

2.2 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 office action regarding the application examination, the examiner in charge shall continue the examination of the concerned application up to the point of his or her final decision.

(3) An application either requested for reexamination or returned to the examiner (patent term extension applications included) after the revocation of an examiner's original decision to reject shall be examined by the very examiner unless there is a justifiable reason for change of examiner in charge. However, as for the patent application which had been revoked and returned more than twice, the concerned examiner who rejected the patent application can be changed to another one.

(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, or where 2 or more relevant applications of the same applicant are assigned to different examiners, the examiner responsible can be changed to another one who has been designated in consultation with the concerned examiner.

(7) Where it is recognized that exact examination is relevant for the patent

applications to which a main classification and a sub-classification is assigned, the patent examiner of sub-classification shall terminate the examination proceedings in consultation with a director general of the examination department and a director general of the patent examination planning department.

(8) With respect to a patent application subject to *ex-officio* reexamination or to a reexamination resulted from the refusal to accept *ex-officio* amendment, the patent examiner who allowed grant of a patent shall continuously perform the examination without any special circumstances whatsoever.

2.3 Internal Reporting

(1) Where the examiner allows a patent or rejects (however, a decision to reject shall be excluded if written arguments or an amendment were not submitted in response to a notice of rejection) with respect to the patent application revoked and remanded to the examiner (patent term extension applications included) or where the final disposal was revoked, the examiner shall report it to a director of the examination division (the head of the examination team included) and then to a general director of the examination bureau.

(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 (except the case where the rejection is made due to no submissions of argument and amendment), a refusal to enter an amendment, decision to grant, an invalidation disposition (excluding the case without submissions of written arguments and amendment following amendment proposal), a notice of the grounds for rejection or decision to grant for a patent or decision to reject the application on reexamination request, decision to grant or decision to reject (However, a decision to reject made without receipt of written arguments and amendment in accordance with a notice of rejection excluded), a notice of rejection to the

application rejected and returned (patent term extension applications included), dismissal of a request for expedited examination, a request for publication of correction with respect to serious errors, an amendment proposal regarding patent term extension applications, a notice of rejection, patent term extension decision or a decision to reject patent term extension applications, and third office action(a ground of rejection) with respect to deficiencies in the description.

(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 expedited examination request or notifies of the decision for the expedited examination (only if a requester of an expedited examination is not an applicant)

② Where a senior patent examiner notifies of rejection grounds, calls for supplementation regarding the expedited examination request, notifies the decision for the expedited examination (only if a requester of an expedited 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 (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.

2.4 Form and Name of Authority for Examination-related Documents

(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 expedited examination. Joint examination or examination with consultation shall be carried out under joint names of all examiners concerned.

3. Patent Classification (CPC, IPC) Assignment

The patent classification assignment has to be made in an accurate manner based on the technical subject-matter of the invention. This makes search for information and access to patent documents by an examiner and a person to use patent information easier by classifying technology.

3.1 Flow chart of Patent classification (CPC, IPC)

Reception of Application Papers and Formality Check
Request for Classification
Preliminary Assignment of Classification
Confirmation of Patent Classification → Request for Correction of
Classification → Approval/Refusal
Examination

3.2 Overview of Patent Classification

(1) The request for classification of filed application and PCT application managed by application division and international application division

respectively to a specialized classification organization is made by Patent Examination Policy Division after finishing the formality examination of those applications. The applications are classified based on each technical field, and allocated to the specific classification place of the CPC/IPC by the officer in charge of classification in the specialized classification organization. Every application except for PCT international applications filed after January, 2015 is allocated the CPC, and the IPC is also allocated automatically as classification code corresponding to the CPC. Some CPCs deal with technical subjects recognized as a necessary matter which are not found in the IPC, and those can be only used for allocation of additional information. Therefore, the CPCs are used to search prior art regardless of allocation of examiners. On the other hand, PCT international applications are allocated pursuant to the IPC.

(2) Pre-classification of ordinary applications is conducted by the specialized classification organization, and an examiner shall review whether the technical subject-matter of the claimed invention is classified appropriately pursuant to the CPC/IPC and whether the application is within the scope of his/her classification in charge before carrying out examination to make classification confirmed. However, if it is determined as inappropriate classification, i) an examiner in charge, who finds out a part of his/her classification is inappropriate, should apply for correction of the classification, ii) the application included in wrong classification should be allocated to an examiner of right classification after consultation and the examiner applies for correction of classification, or iii) where reallocation of examiner is not made properly, the examiner by him/herself should ask Patent Examination Policy Division to correct classification and to reallocate the application by changing an examiner in charge.

(3) Applications related to national defense and PCT international applications have different method to confirm classification with that of ordinary applications, which is a process of confirmation by checking pre-classification of the application on the screen of examination system for an examiner in charge

of pre-classification conducted by a specialized classification organization. An examiner shall review whether the pre-classification designated to each application is appropriate, and if appropriate, the classification is confirmed, or, if not, the classification shall be returned by designating classification symbol which is considered acceptable and stating opinion about return. The specialized classification organization carries out the process of pre-classification of the returned application by considering classification symbol designated by an examiner and his/her opinion about return. After that, the process such as review, confirmation or return is conducted again. Provided that, PCT international application is excluded from re-designation of pre-classification and the following process.

(4) If it is necessary to correct classification for accurate classification according to technical contents understood during examination, 「Correction of classification」 shall be applied for. This is for clearer classification in official gazette by searching misclassification, and essentially, ground for correction such as related claims, reference, etc. shall be stated. When an examiner applies for correction of classification through Patent Examination Policy Division, the division finally accepts or rejects the classification of application after reviewing it.

3.3 Understanding of the IPC

3.3.1 General Principle of Patent Classification Assignment

(1) On the basis of the technical contents of an application, an officer in charge of classification in specific patent classification organization and an examiner in patent office should determine the classification place among section, class, sub-class, main group, and sub-group (not required if there is no classification criteria for sub-group after main group) for the application and designate or confirm the symbol of classification place to the application.

The technical subject-matter is determined based on the matter in claims in light of the matter in the description of the invention and drawings. The technical subject-matter is classified into information of invention and

classification symbol of the matter is to be designated. If it is difficult to find out the invention stated in the claim since the claim is not clear or the submission of the claim of application is delayed, the technical subject-matter is determined by matters in the description of the invention or drawing. If the technical subject-matter of the claims is different with the matters in the description of the invention and drawing, the matters in the description of the invention and drawing will be classified into important additional information and its classification symbols will be designated.

(2) The classification shall be determined based on the essential contents of the claimed invention as a whole without being bound to the formality such as the category of invention.

(Example) 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 serve as a basis for the classification.

(3) Where multiple technical subject-matters are involved in application, core technical subject-matter representing the claimed invention as a whole is categorized as 'main 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 or the invention stated in claims is not under a group of inventions prescribed in Article 45 (1), the classification sign of the technical subject-matter in claim 1 can be referred as main classification.

3.3.2 General Rule of the IPC Assignment

(1) The IPC has two kinds of classification places: "function-oriented" place and "application-oriented" place. To classify the claimed invention pursuant

to the IPC, the judgment shall be made first for the classification places based on the technical subject-matter of the claimed invention.

① In case of Use Invention

If the claimed invention concerns single use and has an appropriate classification place for the application in the classification table of the IPC, such classification place becomes the classification basis. In the meanwhile, where the IPC has no such relevant classification place for the use, then the function-oriented classification place becomes a main classification for the invention while the similar place for the pertinent 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, while the other uses become sub-classification.

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 classification table of the IPC has no pertinent place for the function, the main use prescribed in the specification shall be a classification place.

(Example) Sub-class F16K is classified with its function only, which is independent of the valve's specific field 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) Three entries for the IPC such as 'IPC identification abbreviation'(Int. Cl.) 'classification symbols or indexing code ', and 'version' are indicated in patent documents. The classification symbols and indexing code in patent documents shall be indicated in the order of 'classification symbols describing invention information' → 'additional information (also called non-invention information)' → 'indexing code (showing additional information only)'.

The invention information and additional information shall be expressed in boldface type and regular type, respectively. Countries where a large number of applications are filed including the Republic of Korea classify patent documents using a whole classification symbol of IPC, and indicate the information in italic type in patent documents. Countries where a small number of applications are filed classify patent documents by using only main groups of IPC and express the information in not italic type but regular type.

(Example) Countries with whole classification symbols

<p>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)</p>	<p>IPC Identification Abbreviation Version Directive indicates year and month in square type Boldface type for invention information Regular(non-bold) type for additional information Italic style for extension level Indexing code used only for additional information</p>
<p>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</p>	

(3) Additional information is an option to complement invention information. The additional information can be given by either indexing code or classification symbols. Indexing code is designated based on indexing classification table categorized by technical functions (purpose, use, structure, material, manufacturing process, disposal process, control measure, etc.) not included in classification place. After designating classification symbol, the code is designated additionally for the technical subject-matter that is useful to search.

(4) If the invention described in specification is required to be confidential due to national security, such requirement shall be stated too. See Part VII, chapter 3 for more details.

(5) With regard to divisional application, converted application, domestic priority claim application, treaty priority claim application or application of

lawful holder of the right, the classification of an original application shall be identified first. Except when the classifications given to an original application obviously fail to correspond to the later-filed application, it is preferable to remain the same classification of an original application as main classification of an application while designate the newly granted classification as sub-classification.

3.3.3 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 (i.e. it is classified according to its function). And if there is no appropriate function-oriented place, then the product shall be classified based on the use of the manufactured product.

(3) Multistage Process or Plant

A multistage process or a plant consisting of a process with plural stages or a composition with plural apparatuses respectively 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 with the classification place, 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 the invention into 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 into 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 into the place for a higher hierarchic group; provided however that the inclusion into multiple groups is of little importance for search and the technical subject matter is simply relevant to the combination of elements.

(6) Compounds

The technical subject-matter of chemical compounds (organic, inorganic or polymer) shall be classified into 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 into 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 into the place.

(7) Mixtures or Compositions

Where mixtures or compositions are technical subject-matters in the claimed invention, they shall be classified into 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 of the field of use.

(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 subject of the invention related to the general method to manufacture or treat 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 '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.

(10) Classification of Compounds in Combinatorial Libraries

With regard to combinatorial libraries where a lot of compounds, biological entities or other substances are involved, IPC shall be granted to each individual compound 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).

3.4 Understanding of CPC

Cooperative Patent Classification (CPC) has been developed since the USPTO and the EPO agreed to develop it for efficiency of searching prior art in October, 2010 and after finishing the development at the end of 2012, it has been used since January, 2013. KIPO has been using the CPC since its introduction in January, 2015.

The development of the CPC was led by an examiner in the EPO. Based on the ECLA, the CPC was made by combining assistant classifications such as ICO, KW used by the EPO were combined; accepting BM part of the USPC; adding Section Y; and breaking down some classifications. The CPC has a form stating number behind the sub group according to the system of the IPC.

The CPC has advantages to make access to prior art document expanded and easier, and search of documents in various languages possible.

Also, classifying structure of the CPC consists of Class and Group like those of the IPC.

3.4.1 Structure of CPC

The CPC table is divided into three sections: Main trunk, Indexing codes (or 2000 series), and Section Y. Particularly, compared to the IPC, the CPC has 2000 series and Section Y providing additional information.

Structure of CPC Table

Section A-H	Section Y
<ul style="list-style-type: none">• Approximately 160,000 classification symbols• Invention information or additional information	<ul style="list-style-type: none">• Approximately 7,000 classification symbols• Including existing

<p style="text-align: center;">Indexing Codes – 2000 series</p> <ul style="list-style-type: none"> • Approximately 90,000 classification symbols • Included in breakdown, orthogonal code among existing ICO codes • IPC indexing codes • Attached to only additional information 	<p style="text-align: center;">USPC XRACs and digess</p> <ul style="list-style-type: none"> • Attached to only additional information
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(1) Main Trunk

Basically, the CPC has hierarchical structure, which is same with the IPC, consisting of section, class, subclass, and main group or sub group. Since the CPC has a structure where 1 to 3 digits, dashes and 2 to 6 digits according to the IPC standard are added to each subclass symbol, it allows finer classification and has more words added than IPC.

If the main trunk has the IPC classification place corresponding to the CPC classification place, generally, the title of the CPC is same with the IPC's. The information added only in the CPC because there is no corresponding classification place in the IPC is indicated in brackets { }.

(2) Indexing Codes

Indexing classification table of the CPC is introduced from the IPC indexing classification table and Indexing codes used in the EPO such as the ICO and KW. Since the symbol of group starts with 2000, it is also called 2000 Series. For reference, there are no symbols of 2000 Series in Section Y. To classify application with indexing codes is not obligatory classification as long as there is no extra direction in main trunk and its definition. Groups using the ICO consist of a group more finely broken down from main trunk group (called break down indexing codes) and another group which is orthogonal (called orthogonal indexing codes) having different principle with breakdown rule.

(3) Section Y

Section Y has been introduced to the ECLA by the EPO to deal with technical subject matter which is necessary but was not present in the IPC. Symbols of section Y are allocated as just additional information.

Structure of Section Y

Section	Title	Introduction time and contents
Y02	Technology or application - for relief of or adjustment to climate change	Due to increase of the number of applications related to clean energy technology, discussed from April, 2009 and newly made in 2011.
Y04	Information or communication technology impacting on another technical field e.g. Smart grid	
Y10	Technology included in the USPC mutual reference technology collection and written summary	Considering creation of the CPC, introduced in July, 2012.

3.4.2 Hierarchical structure of Cooperative Patent Classification (CPC)

The highest level of the CPC hierarchies is Section which has total 9 sections including 8 sections from A to H and section Y added. Each section is divided into classes. A class is divided into subclass and the subclass is also divided into main group and subgroup. Subgroup is the minimum unit for search. Unique symbol of the CPC is provided according to section, class, subclass, main group, and subgroup.

The hierarchy among sub-groups is determined by the number of dots coming ahead of each title. It is noted that hierarchy is indicated only by the level of indentation not by digits of sub-group.

E.g. A01B 1/02 · Spades; Shovels

1/04 · · with teeth

1/06 · Hoes; Hand cultivators

1/08 · · having one edge

1/10 · · having two edges

In the example mentioned above, although every sub-group has its two digits, one-dot subgroup 1/02 is a higher level than two-dots subgroup 1/04.

3.4.3 Section

The CPC has 9 sections. Sections from A to H include all technical fields, and section Y is for special technology. All of the CPC classes in a section are listed in each CPC section.

3.4.4 Subsection

Some sections include title of sub-section, which can provide useful information for grouping related classes.

3.4.5 Class

Each section is divided into 'Class' which is the second hierarchy of classification. Each class includes symbol and title, and additionally often includes index.

- 1) Class symbol: Two digits of a number are added behind of section symbol. (E.g. H01)
- 2) Class title: Content of class is described. (E.g. H01 Basic electrical element)
- 3) Class index (For the IPC)

The CPC does not use class index used in the IPC. However, the CPC also includes information of the class index described in the IPC since the CPC is based on the IPC. Some classes have index of summary to help comprehensively understand content of the class.

3.4.6 Sub-class

Under Class, there is 'Sub-class' which is the third hierarchy of classification. Each sub-class has symbol and title, and often includes sub-class index and guidance heading.

- 1) Sub-class symbol: A capitalized alphabet is added behind class symbol. (E.g. H01S)
- 2) Sub-class title: Content of sub-class is described as clearly as possible.
E.g.) H01S Device using induced emission
- 3) Sub-class index

The CPC does not use sub-class index which is used in the IPC. However, since the CPC is based on the IPC, only information stated in sub-class index of the IPC is included in the CPC. Some sub-classes have index of summary to help comprehensively understand content of the sub-class.

- 4) Residual sub-class: This is the sub-class for technology which is not categorized into another subclass.

E.g.) F21K Light source which is not categorized into any other class

3.4.7 Group

Group is the minimum unit of the CPC, and it consists of main group, sub group, and residual group, all of which are stated in the CPC classification table.

1) Main group: there is no dot or indentation. Its symbol is always finished as '/00'.

2) Sub-group: It is separated from main group and its symbol is finished as another number besides 00 behind diagonal line, /.

3) Residual main group

This is similar to miscellaneous sub-class in the USPC. Among technical subjects classified into sub-class, subjects, which are not categorized into main group, are classified into residual main group. Titles of the group mostly have expression, 'not included in any other group' or 'not classified into any other group'.

E.g.) H02S 99/00 Technology which is not classified into another group of this sub-class

There are two types of translation of title; for English version, if the title of sub-group is started with capitalized alphabet, it is deemed complete, and if not, it is deemed to be subordinated to the higher hierarchy. For Korean version, since there is no division between capital and small letter, it should be understood according to the context or English version.

(Example 1) H01S 3/00 Lasers,

3/14 · Having feature of material used as active medium

-> Title of H01S 3/14 is translated as 'Laser having feature of material used as active medium'

(Example 2) H01S 3/05 · Structure or shape of optical resonator

-> Title of H01S 3/05 is translated as 'structure or shape of optical resonator of Laser'

However, the scope of the CPC group is not overlapped since it is exclusive.

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 proceedings, 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 contribution in industrial development. In this regard, the examination on the application and its laying open are separated and the system for laying open is introduced after the prescribed period elapsed from the filing date.

4.2 Date

(1) An application shall be laid open after the expiration of a period of one year and six months from the filing date. However, as for the applications claiming priority under the treaty or making domestic priority claim, the period shall start from either the filing date of the first country application or the filing date of the prior-filed application (or the earliest filing date if the application involves more than 2 priority claims)

(2) Since a divisional application or a converted application is deemed to be filed on the same filing date as the parent application, the period for laying open shall start from the filing date of the parent application. Therefore, if the divisional or converted application is filed before one and a half year from the filing date of the parent application, the application shall be laid open after the expiration of a period of one year and six months from parent filing date. In the meanwhile, if they are filed after one and a half year from the filing 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 before the expiration of a period of one year and six months from the filing date.

4.3 Content

(1) In principle, all patent applications shall be laid open after the expiration 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 prescribed 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 does not include 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.

(Example) With regard to the prior-filed application which is a basis of a domestic priority claim, it shall be laid open if the applicant requests its early publication or if the period of one and a half year from the filing date of the prior-filed application expires (for example, the prior-filed application which claims the priority under the treaty) before it is regarded to be withdrawn (i.e., within one year and three months from the filing date of the prior-filed application)

(2) The patent application shall not be laid open 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 harm 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 warning with documents stating the claimed invention of the application to a person who has practiced the invention as a business, and may claim a compensation against the person being warned in writing or a person knowing that the invention has been laid open in an amount equivalent to what the applicant would have normally received for licensing 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 claim a 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.

5. Request for Examination

5.1 General

(1) A request for examination shall be made only for an application which is pending in KIPO. Therefore, the request for examination 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 survive even in case of losses in legal capacity or competency such as death of the requestor.

In the meanwhile, a patent applicant may request examination only if a specification including the claims is attached to the application, according to Article 59(2), or in case of a foreign language application, only if the Korean translation pursuant to Article 42-3(2) .

(2) Any person may request examination of the patent application even including the 3rd parties without interests in the application, provided however that the incompetents including minors shall carry out the proceeding of the request for examination by legal representatives.

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 examination of a patent application.

(3) A request for examination shall be filed within three years (5 years for a patent application filed on and before '17.2.28.) from the filing date of the application.

For a divisional application or a converted application, a person may request examination within thirty days from the filing date of the divisional application or the converted application, even after the expiration of the aforementioned 3-year period.

(Note) The request for examination of an international patent application shall be made within 3 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.

(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 is 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 instructed to pay the fees. If the applicant fails to make additional payment

as requested, the amendment to the pertinent specification can be invalidated.

5.3 Effects

(1) The application whose examination is requested shall be examined by an examiner. The pendency of 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 which does not include the claims in the specification, an applicant shall amend the specification to include the claims till the date prescribed in Article 42bis(2) 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) 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 whose examination is imminent in terms of examination order is one that he/she can proceed with examination. To prevent a delay of examination, the verification procedure shall be conducted as quickly as possible.

(1) The examiner shall review whether the technical subject-matter of the claimed invention is classified appropriately pursuant to the CPC and the IPC and whether the application is within the scope of his/her patent classification in charge. Pursuant to the Part V Chapter 1 Section 3 of the Guidelines, i) if an examiner is in charge of main classification, the examiner should conduct examination, ii) even though an examiner is in charge of main classification, the examiner can allocate the application to another examiner in charge of sub classification for accurate examination after consultation, iii) if an application included in wrong classification is allocated, it should be reallocated to an examiner of right classification after consultation and the examiner applies for correction of classification, or iv) where reallocation of examiner is not made properly, the examiner by him/herself should ask Patent Examination Policy Division to correct classification and to reallocate the application by changing an examiner in charge.

(2) The examiner shall review whether he/she may fall under the disqualification reasons stated in subparagraphs (i)-(v), or (vii) in Article 148 of the Patent Act, or whether he/she shall be excluded from examination because he/she with less than 2 year experience as an examiner had worked 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 disqualified, 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 per 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 notice of grounds for rejection, amendment request, request for consultation, or service of a certified copy of decision to grant a patent.

(4) If the date of examination request is identical per 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 of 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 expedited 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 prior-filed application or a conflicting application (an application claiming identical inventions filed on the same date) is not laid open or a conflicting application is not requested for examination.

② Where an prior-filed application for 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 pending.

④ Where a search is outsourced to an authorized prior art search institute, 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.

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.

7. Processing Deadline

(1) For the application for which the request for reexamination is made after the decision to reject and for the application remanded from the appeal against the decision to reject, an examiner in charge shall begin the examination 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 remanded, or the head of examination division/team for applications either on request for reexamination or on reconsideration by examiner before trial.

(2) With respect to an application on request of the expedited examination, the examiner shall determine as to whether the application falls under the category of the expedited 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. (However, within 4 months as for expedited examination under Article 4(3) or (4) of the Directive)

(3) Reference to other processing deadlines is as follows:

(Abbreviation: Month/M, Week/W, Day/D)

Type		Initial Date	Time	Reference	Others
Classification Examination	Confirm of classification		As initiating the examination proceedings	Instruction Article 9(2)	Considering the classification confirmed as initiating the examination proceeding without a request of

Type		Initial Date	Time	Reference	Others
					reassignment of classification
Regular Examination	Examination Start	Examination Request Date	Request Order	Enforcement Rule Article 38 Instruction Article 20	
Expedited Examination	Decision for Expedited Application	Receipt Date of Notice of Expedited Application Request	7 Ds	Instruction Article 59(1)	
		Expiration Date of Amendment Period/ Receipt Date of Amendment Documents	7Ds	Instruction Article 59(2,3)	Late Expiration Date
	Prior Art Search Request	Delivery Date of Decision	15Ds	Instruction Article 86(1)	
	Examination Start	Delivery Date of Decision	2Ms/ 4Ms	Instruction Article 66(1)	Late Expiration Date
		Receipt Date of Prior Art Search Outcome	1M		
The date of filing a request for preliminary examination		2Ms/ 4Ms			
		Receipt Date of Written Amendment	1M	Instruction Article 66(2)	
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 Remand	Examination Resume	Documents Receipt Date	1Ms	Instruction Article 55(1)	
	Amendment (revoked and returned)	Expiration date of the designated period/ the date of transmitting amendment	2Ms	Instruction Article 55(5)	Late Expiration Date

Type		Initial Date	Time	Reference	Others
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 deemed to be filed on the filing date of the parent application, the provisions of laws are applied as of the parent filing date.

For example, if the divisional application is filed on July 1, 2009 based on a patent application 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 applied 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 disclosure exceptions, the provisions of the law shall be applied as of the filing date of the application.

For example, when an applicant filed an application, claiming a priority in Korea after October 1, 2006 on a basis of the application filed in Japan before September 30, 2006, the internationalism, in which inventions publicly known or practiced 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 practiced in Japan before the filing date in Japan.

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 prior-filed 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 authorized prior art search institute 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 description of the invention and drawings if necessary.

(2) When the application cites documents in the description, the examiner shall review the 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 to the documents to take as 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 of the invention, 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 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 includes new matters 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 of inventions linked so as to form a single general inventive concept under Article 45, the invention(s) which does not subject to the examination

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 understand the inventions due to lack of written description

However, if the examiner can understand the invention despite any deficiencies in the specification, the examiner shall proceed with the search and assessment of patentability within the scope of the understanding of the 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) documents published after the filing date of the application may be used as supporting material confirming 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 any documents published between the earliest priority date and the filing date of the application are found, the examiner should first determine the reference date for each claim between the priority date and the filing date and then decide which documents to cite.

However, when there is no trouble to decide the reference date for each claim, the examiner may decide the priority date for 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 description of the invention. However, such equivalent elements are not considered only limited to the scope of technical features explicitly described in the description of the invention.

(Ex) The claimed invention relates to a device characterized by structure and function of plural parts. Where a 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) As conducting the prior art search for the independent claim(s), the examiner conducts the prior art search for all dependent claims which fall within the identical classification as that of the independent claim. Dependent claims should be interpreted as being restricted by all features of the claim(s) 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 relating to a pharmacological composition for curing nail disease and disorder, where prior art for independent claims reciting combination of main components of the claimed invention does not exist, there is no need to make a further search in respect of dependent claims reciting 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 novel 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 method invention for manufacturing an article, the examiner may determine whether the manufacturing method can be easily derived after the prior art search for the article is conducted.

(4) The search for prior art shall be made based on 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 of the invention but not included in the claim, just in case the applicant submits an amendment.

3.6 Citation of Prior Art Documents

(1) The prior art shall be relied upon in the grounds for rejection only if there are no doubts concerning the fact that it is publicly known or practiced, or described in a distributed publication.

(2) A certain situation occurs in which other documents describe the disclosure of the prior art document.

(Example) Where a prior art document is published before the filing date of the application in a language not understandable to the examiner, and a counterpart document is published after the filing date of the application written in a language understandable to the examiner, the counterpart document may be relied on as a prior art reference. In this case, the examiner may notify of the fact that the document written in a language not understandable to the examiner had been publicly known before the filing date and have such document attached to his notice for rejection.

(3) The examiner can rely on the abstract as a prior art reference for denying novelty and inventive step of the claimed invention. However, it is noted that the examiner shall notify of the grounds for rejection based on the contents disclosed in the abstract, but not on the disclosure of the whole document other than the abstract

(Note) Where the disclosures of the abstract and the full texts are different, the fact that the full texts can be obtained easily cannot be a ground that the full texts and the abstract are treated equal as a prior art reference. 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 grounds for rejection based on the disclosure of the full texts of a prior art reference where the full texts of the reference can be obtained. Where an examiner failed to obtain the full texts of the prior art reference and had to use only the abstract for determining inventive step, the examiner should notify the grounds for rejection based only on the disclosure of the abstract.

(4) The notice of rejection must be accompanied by copies of all documents relied upon, 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 applicant has easily access to the Internet, such as when the applicant has appointed an agent to undertake a patent-related proceeding 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 references 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 references 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 rely on the prior art (another application) as grounds for rejection only after its publication.

3.7 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 a document is such that when taken alone, a claimed invention cannot be considered novel or cannot be considered to involve an inventive step

② 「Y」 : In case a document is such that a claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other documents

③ 「A」 : In case a document cannot be classified as 「X」 or 「Y」 but is related with the claimed invention despite failing to fall upon

④ 「O」 : documents referring to oral disclosure, use, or exhibition

⑤ 「P」: Documents published on dates falling between the international filing date and the priority date

⑥ 「E」: Patent documents filed before the international filing date but published after the international filing

⑦ 「T」 : a document that discloses principle and theory underlying the invention or a document disclosed later than the priority date or the filing date of international application

⑧ 「L」 : a document which may throw doubt on a priority claim or negate the claimed invention or determine other contents

4. Measures after Searching

(1) The examiner prepares an examination report(ER). 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 Authorized Prior Art Search Institute

KIPO may outsource some of its prior art searches under Article 58¹ 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 authorized prior art search institute. The head of the Examination Bureau confirms the selection made by the examiner and requests the authorized prior art search institute 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 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 authorized prior art search institute.

(3) The patent examiner should request a prior art search to a prior art search institute before starting the examination proceedings of the patent application such as the application filed by an current examiner of KIPO, the application filed by a former examiner within 2 years from retirement and the application filed by a searcher of a prior art search institute supervised by KIPO. In this case, as for a patent application filed by a searcher of the authorized prior art search institute, care should be taken to ensure that a search request should not be made to that institute.

5.2 Delivery and Review of Prior Art Search Outcome

(1) The examiner conducts preliminary review before substantive examination

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.

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 authorized prior art search institute 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 authorized prior art search institute 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.

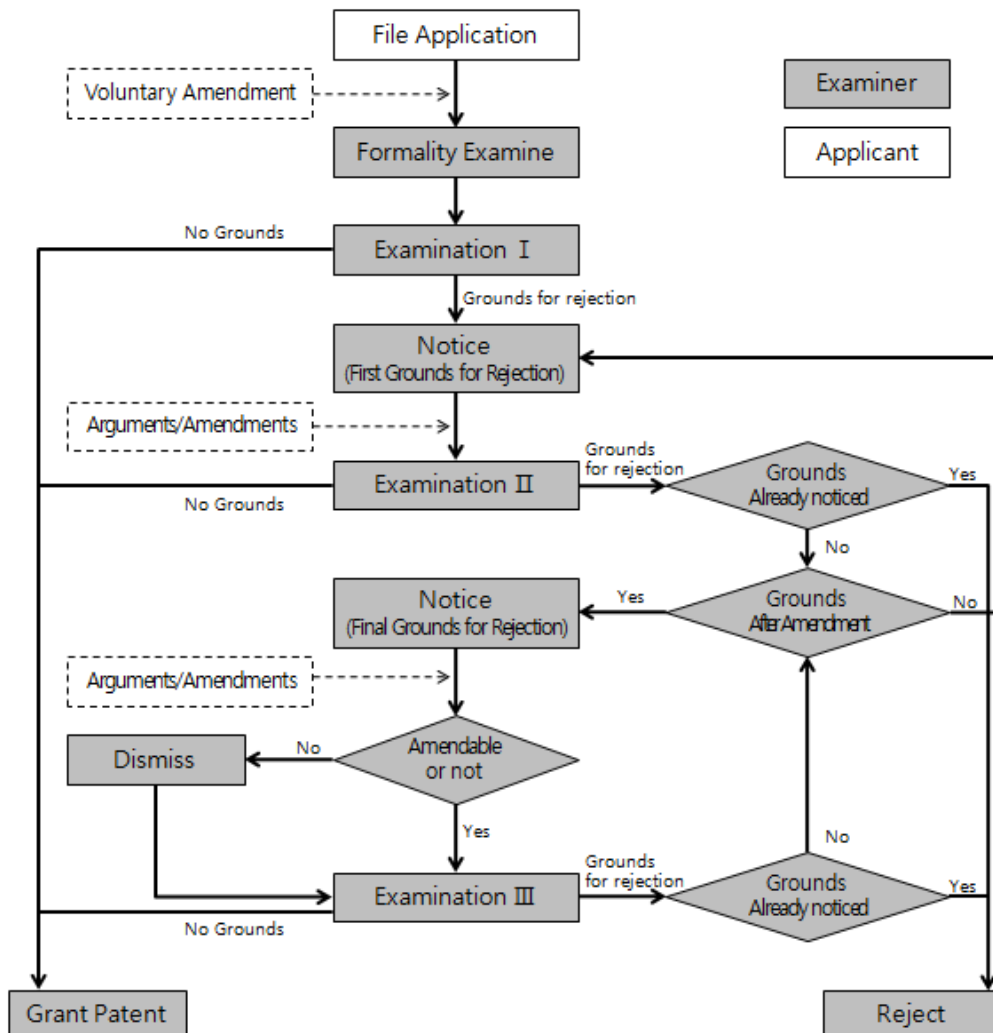
(3) As a part of confirmation review, the examiner, in the course of substantive examination, prepares analysis report illustrating the utility of the search outcomes (produced from the external search service) in accordance with its practical use on the Patent Examination Processing System.

(Note) The service contract for search for prior art contains the provision of reexamination obliged to the authorized prior art search institute in the case when the examiner evaluates the outcomes as unutilized.

Chapter 3. Examination Process

1. Overview

When the application for 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 argument in response. When the submitted written argument or an amendment still fails to traverse the notified grounds for rejection, the examiner shall make a decision to reject the patent application. The examination proceeds as shown in the following flowchart.



2. Understanding of Invention

(1) In the examination stage, the examiner shall clearly understand subject matter of the claimed invention in light of the specification by considering the problems to be solved, the means for solving the problem, which differentiates from the background art and the effects of the invention.

(2) The examination proceeds based on the specification as originally filed, but should take into account any changes from amendments made 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 construe the claimed invention as recited 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 of the invention.

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 first-to-file application.

(1) Since the publication date of the prior art document is critical to determine 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 made).

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).

"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 with a claim of a disclosure exception, 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 VI shall be referred.

(2) When the priority claim under Treaty, domestic priority claim, or claim for disclosure exceptions are found to be not complied with 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 the applicants do not coincide, 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 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 made within twelve months from the earliest filing date of the applications on which the priority claim is based.

Where the claim 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 is limited only to correction of self-evident errors, the examiner shall state such purport to the notice of the amendment request.

(3) As long as the application filed in a first country, which forms a basis of the priority claim is recognized as a regular application, the priority right shall not be influenced by the fate of the application. Therefore, even applications invalidated, withdrawn, abandoned or rejected after the filing can serve as a basis of claiming a right of priority.

The examiner shall not examine whether the application in the first country which forms a basis of the priority claim is pending.

(4) If the invention described in an application claiming a priority under the treaty is identical with the invention described in the application filed in a first country , the invention described in the application claiming a priority shall be treated as if it has been filed on the date of filing of the application in the first country, in applying the provisions prescribed in Article 29, 36 of the Patent Act.

The reference date for the purpose of determining patentability shall be determined on a claim-by-claim basis in principle and details are as follows.

① For the invention identical (substantially identical invention is included; hereinafter, the 'identical' includes 'substantially identical' in this section) to the invention of the application filed in the first country, the reference date shall be the filing date of the application in the first country.

As for the application involving 2 or more priority claims (multiple priority right), the reference date for the invention commonly described in 2 or more applications in the first country(or countries)shall be the earliest

filing date of the applications in the first country.

② For the invention which is not described in an application filed in the first country, the filing date of the application claiming a priority under the treaty shall be the reference date.

As for the application claiming priorities based on the 2 or more applications in the first country(countries), the invention obtained by combining technical matters separately included in 2 or more applications filed in the first country(countries), or the invention obtained by combining the invention included in the 2 or more applications filed in the first countries and a new technical matter shall be treated as an 「invention which is not described in an application filed in the first country」.

③ When the application filed in the first country claims the priority right based on another earlier application, the application shall not be regarded as the 「earliest application」 prescribed in Article 4 C (2) of the Paris Convention for the Protection of Industrial Property, concerning the invention described in both the application and the another earlier 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 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, it should be noted that the submission of a copy of description or drawing(s) of the invention of the application filed in the first country 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, it should be noted that the indication of the application number whose priority is claimed in the application claiming a priority may substitute for the submission of documents stating the application number of the application filed in the first country 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 priority 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 claim domestic priority is an applicant of the prior-filed application. If the applicant of the prior-filed application and the applicant of the later-filed 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 of obvious errors.

Whether such determination on whether the both applicants of the prior-filed and the later-filed applications are same or not is made as of the time when the relevant domestic priority claim has been filed. In other

words, the decision is made as of when the applicant states the priority claim in the application cover sheet 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 prior-filed 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 or the decision to reject the application has been conclusive and binding, the application hereof cannot serve as a basis of a claim of domestic priority.

If the prior-filed 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 claiming a domestic priority and those stated in the specification or drawing(s) originally attached to an prior-filed application (hereinafter 'original specification of the prior-filed application') are identical, the application concerned shall be deemed to have been filed at the time when the prior-filed 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.

① Where the invention in the original specification of the prior-filed 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 prior-filed 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 original specification of prior-filed applications, the reference date shall be the earliest filing date of the prior-filed application.

② Where the claimed invention is not stated in the original specification of the prior-filed application, the filing date of the domestic priority claim shall be the reference date.

For the domestic priority claim based on 2 or more prior-filed applications, when the invention of the priority claim is a combination of technical subject-matter separately stated in 2 or more original specification of prior-filed 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 original specification of prior-filed applications, the invention of the priority claim shall be treated as an 「invention which is not stated in the original specification of prior-filed application」 .

③ When the prior-filed 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 original specification of the prior-filed 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 prior-filed 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 original specification or drawing(s) attached to the application with domestic priority claim and those in the original specification of the prior-filed application are identical, the prior-filed application, which shall be deemed to have been 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 prior-filed 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 has become a basis for 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 prior-filed application in Article 36 may arise as problems between the prior-filed 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 prior-filed application is considered withdrawn. When the examiner carries out the expedited 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 prior-filed application is withdrawn.

4.3 Disclosure Exceptions

(1) Where an application claiming disclosure exceptions 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 statutory period, he/she requests amendments to the applicant and invalidates the claim if the deficiency is not cured. The untimely claim for disclosure exceptions is considered not overcome.

(2) Where the disclosure exception is claimed by the reason that the publication has been made by a person with an entitlement to obtain a patent, the examiner shall conduct additional examinations regarding the followings; whether a person is entitled to obtain a patent upon the public disclosure, whether the claim is made in the application, and 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 made 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 disclosure exception 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 disclosure exceptions (the box for disclosure exceptions checked) is indicated in the application and the evidential documents for each disclosure are all submitted, disclosure exceptions 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 claim for public disclosure exception 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 exception is recognized under the conditions that a certain procedural requirements are satisfied to protect a patent by recognizing novelty and to further promote industrial development. Also, this protects the public confidence and guarantees the foreseeability.

(4) For a multiple number of claims for disclosure exceptions, the legitimacy of the claim shall be judged by each claim.

(5) Where the claim for disclosure exception is recognized as legitimate, novelty and 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 within three months from the date when a certified copy of the decision to grant a patent or the trial decision revoking the decision to reject (trial decision which holds the decision to grant a patent, retrial decision is included) is served(however, the divisional application cannot be filed after the registration of the patent),

or the period designated for an appeal against the decision to reject a patent. A converted application shall be able to be filed 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 to reject is requested, a divisional application may be filed within thirty days from the date of transmittal of a certified copy of the decision to reject (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 where the decision to reject has become conclusive and binding, division or conversion shall not be made based on the application. 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 terminates 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 original specification or drawings of the parent applications. 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 preliminary 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 preliminary 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 deliver a written notice of the ground for rejection by reason of scope (division or conversion) violation. Where an argument or amendments fail to cure a scope violation, an examiner shall make a decision to reject 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 legitimate 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. Application C is deemed to be filed on the filing date of Application A if the invention of Application C is within the scope of the original disclosure of the Application A.

A converted application shall be treated in the aforementioned manner.

4.5 Application by a legitimate right holder

(1) In order for an application to be recognized as an application by a legitimate right holder as in the provisions of Articles 34 and 35 of the Patent Act, the following requirements shall be met; ① an application by the unentitled person had been filed earlier than the application of the legitimate holder of a right, ② an application by the unentitled person is either rejected or invalidated in a trial on the ground that the application is not filed by the entitled person, ③ an application by the legitimate right holder is filed within thirty days from the date when the trial decision to reject or invalidate has become conclusive and unappealable, and ④ a scope of a claimed invention in an application by the legitimate holder of a right falls within the scope of the disclosure of the application by the unentitled person.

Where an application by the legitimate right 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 legitimate right holder in the written 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 an invalidation trial has become final and conclusive.

(2) Where an application is recognized as a legitimate application by the legitimate 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 legitimate right 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 legitimate right holder, an application by the legitimate right holder shall not be rejected due to a third party's application. As aforementioned, the filing date of an application by the legitimate right 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 legitimate right holder.

(3) With regard to a request for examination for an application by the legitimate right holder after three years from the filing date of an application by the unentitled person, it is deemed valid as long as the application by the legitimate right holder and the request for an examination are filed simultaneously (or on the same date).

(4) The scope of invention in an application by the legitimate 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 legitimate right holder includes inventions, which go beyond the aforementioned scope (for example, an application by

the legitimate right 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 legitimate right 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 concept of novelty, an international patent application is treated as a regular patent application filed on the international filing date. 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.

Effects arising from submission of a translation are to be different depending on the patent filing date.

① Where the concerned patent application was filed before December 31, 2014

In this regard, the international filing date shall be considered to be the filing date in Korea, while translations of the description, claims, drawings and abstract submitted as of the filing date of the international application (as for the international patent application filed in Korean, the specification, claims, drawings and abstract submitted as of the filing date of the international application)are considered as the specification, drawings and abstract pursuant to Article 42 (2) of the Patent Act.

② Where the concerned patent application was filed after January 1, 2015

The international filing date shall be considered to be the filing date in Korea, while the description, claims, and drawings submitted as of the filing date of the international application are considered to be the specification and drawings as originally filed in the application pursuant to Article 42 (2) of the Patent Act. Further, where the abstract of the international patent

application is written in Korean, the abstract shall be deemed to be the one pursuant to Article 42(2) of the Patent Act of Korea, and where the abstract of the international patent application is written in foreign language, the Korean translation of the abstract of the international patent application filed according to Article 201(1) of the Patent Act of Korea (where a new Korean translation is filed in accordance with Article 201(3), it shall be the one of a last submitted abstract of the international patent application) shall be deemed to be an abstract under Article 42(2).

(2) An examiner who is in charge of an international application shall pay attention to the following matters.

Where an international application enters national phase 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 international application where Korea is the only designated State for obtaining a patent, the priority claim is considered as domestic priority claim, instead.

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.

In case of an international application, a person intending to claim disclosure exceptions pursuant to Article 30 (1) to the invention claimed in an international application may submit a written statement stating the purport of disclosure exception 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.

Where a prior-filed application, which serves as a basis for domestic priority

claim, is an international application, inventions commonly stated in both an application with the domestic priority claim and the prior-filed 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 prior-filed application.

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 voluntary-amended according to Article 47 of the Patent Act.

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.

(3) A special provision with respect to an enlarged concept of novelty of the international patent application shall be applied depending on the filing date of an application to be examined and of “another application”

① Where another application and the concerned application were all filed before December 31, 2014 or where another application was filed before December 31, 2014, but the concerned application was filed after January 1, 2015

Where international application filed in foreign language is relied upon as “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.

Where an international application considered to claim domestic priority is filed in a foreign language, the scope of inventions of the prior-filed application considered to be laid open or registered in patent gazette, is limited to the inventions described in the original specification or drawings of

the prior-filed application which forms a basis of a priority claim for the international patent application, out of the inventions described both in the specification , claims, or drawings submitted at the international filing date the international application and its translation.

② Where another application and the concerned application were all filed after January 1, 2015

Where an international application filed in foreign language becomes a “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 description, claims or drawings of the international application as filed.[Patent Act 29(5) and (6)]

Where an international application considered to claim domestic priority is filed in foreign language, the scope of inventions of an prior-filed application considered to be laid open or registered in patent gazette, is limited to the inventions described in the original specification or drawings of the prior-filed application which forms a basis of a priority claim for the international patent application, out of the invention described in the description, claims, or drawings submitted as of the date of filing of the international application. However, an international patent application or an international utility model registration application which has deemed to be withdrawn as the patent applicant did not file a Korean translation of the description and the claims of the invention within the specified period according to Article 201(4) of the Patent Act of Korea, cannot be “another application” in applying the provision of enlarged concept of novelty.

(4) A special provision with respect to an amendment of the international patent application shall be applied depending on the date of filing of the concerned application.

① Where the concerned application was filed before December 31, 2014

The specification or drawings of an international application filed in a foreign language can be amended within the scope the matters described in the translations of the specification, claims, or drawings (limited to description parts on drawings)of the international application, or drawings (except the

description parts on drawings) of the international application as of the international filing date.

② Where the concerned application was filed after January 1, 2015

As a specification or drawing(s) of an international patent application filed in foreign language can be amended within the scope of matters described in the original document as of the filing date of the international patent application or in its Korean translation, care should be taken in determining whether to dismiss an amendment or issuing a notice of rejection in view of an addition of a new matter.[Article 208(3) of the Patent Act of Korea]. Refer to 「2. A new matter of an original document and of a Korean translation」, Chapter 5, Part 5 as for a new matter of an original document and of a Korean translation.

5. Notice of Grounds for Rejection

(1) The Patent Act (Article 62) stipulates that the examiner, before making a 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 within 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 necessary for a judgment on patentability of 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 an application is filed by a person not 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.

③ Where it violates the provisions 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 argument shall be within two months regardless of whether an applicant is overseas resident or not. However, when a written argument requires tests and results evaluations and their time consumption is recognized, an additional period required for the tests or results evaluations may be added to the designated period hereof.

(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 in a complete manner. 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 notice in a complete manner.

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 in violations of Article 42(3), (4) without conducting prior art search or assessing 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 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 claimed invention does not constitute a statutory subject matter 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 single 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 rely on the minimum number of references deemed necessary to build a rationale for rejection grounds. An examiner shall identify the parts of the references 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 practiced before the filing of the patent application, he/she shall specifically state facts

showing that it is publicly-known or practiced.

③ Where an examiner renders a notice of rejection on the ground of failure to meet written description requirement for the description of the invention, he/she shall specify the deficient parts and stipulate the corresponding reasons.

(4) When notifying rejection on a ground for lack of inventive step, an examiner shall clearly describe the difference between the invention recited in the claims and the closest prior art reference. (See Part 3, Chapter 3, 5.1 Inventive Step Assessment Procedure) However, the examiner may not describe the difference between the invention recited in the claims and the closest prior art reference 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 prior art reference since the claimed invention is identical with the prior art reference.

(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 indicate 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.

(6) 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 argument. However, exceptions are as follows.

① Where an applicant is deemed to submit a written argument based on his/her correct understanding and interpretation of errors

② Where an applicant does not submit any arguments and the errors are just clerical errors that are not influential for an examiner's decision of grounds for rejection.

(7) Where the specification 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 voluntarily amend or amend *ex officio* (refer to 「Part VIII. Chapter 2. Amendment *Ex Officio*」).

The advice or guidance aforementioned by communication media shall be documented in 'Applicant/Agent Personal Interview' in 「Examination Report」 .

5.2 Rejection without Additional Notice of Grounds for Rejection

Where an examiner finds it appropriate to maintain the rejection which have been notified with taking any amendments into consideration, he/she should make a decision to reject without an additional notice of other rejection grounds which exists but is not notified (However, *ex-officio* amendment, Chapter 2, Part 8 and re-issuance of a notice of rejection, Chapter 3 shall be made as exceptions to the rule).

Here, 「the rejection have been notified」 refers to a case where the concerned ground for rejection in the decision to reject substantially coincides with the previously-notified rejection grounds. Decision of whether to substantially 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 arguments.

5.2.1 Determination of whether an opportunity to the applicant for submission of written arguments in view of lack of novelty and inventive step is provided

5.2.1.1 A decision to reject based on the ground of rejection notified to the same claim

Where the patent applicant has amended the patent application in view of the reference relied upon in the notice of grounds for rejection, but the claimed invention still lacks novelty or inventive step over the reference, as, an opportunity for submission of written arguments has substantially been given to the patent applicant, the examiner may make a decision to reject for the concerned claim over the reference.

In principle, where the following conditions ①-② are all satisfied, a decision to reject an application for a patent can be made.

① The concerned claim is to be rejected based on the same provision of the Patent Act on the patentability

② The concerned claim lacks novelty and inventive step over the same reference or the same combinations of the same references.

(Ex) (Before Amendment) Claim 1: An apparatus comprising A

(A notice of lack of inventive step over reference 1)

(After Amendment) Claim 1: (Correction) An apparatus comprising A and B

(A decision to reject can be made on the ground of lack of inventive step over reference 1)

※ Component B, in the above example, should be the one described only in the description of the invention before amendment.

5.2.1.2 A decision to reject based on the ground of rejection notified to other claims

(1) Where an amendment is made so that a claim becomes identical to the other claim

If a claim under examination is amended to be identical to the other claim (“substantially identical” is included) which is rejected, a decision to reject the claim can be made on the basis of the ground of rejection notified to

the other claim.

(Ex) (Before amendment) Claim 1: An apparatus comprising A

(Claim 1 is rejected on the ground of lack of novelty over reference 1)

Claim 2: An apparatus comprising A and B

(Lack of inventive step over the combination of reference 1 and reference 2 is notified)

(After amendment)

Claim 1: (Correction) An apparatus comprising compositions A and B
(A decision to reject can be made on the ground of lack of inventive step over the combination of reference 1 and reference 2)

Claim 2: Deleted

(2) Amendment adding the limitations of the other claim is made

Where an amendment to a claim under examination is made to add limitations of other claim or matters disclosed in the description of the invention, and the amended claim has overcome a ground of rejection notified thereto, but the amended claim fails to overcome a ground of rejection notified to other claim based on the same provision on the patentability, a decision to reject can be made because an opportunity for submission of written arguments regarding the claim has sufficiently been provided. However, if a new combination of the references should be relied on to reject the amended claim, a new ground of rejection, which is different from a ground of rejection previously notified, is considered to be necessitated, and, depending on the stage of examination, the second office action shall be made accordingly, or the refusal to enter the amendment to the claim shall be made and examination shall proceed with the original claim before the amendment.

(Ex) (Before amendment) Claim 1: An apparatus comprising A

(Lack of novelty is notified over reference 1)

Claim 2: An apparatus comprising A and B

(Lack of inventive step is notified over reference 1 and reference 2)

Claim 3: An apparatus comprising A and C

(Lack of inventive step is notified over reference 1 and reference 3)

(After amendment) Claim 1: (Correction) An apparatus comprising A and D

(A final rejection, lack of inventive step over reference 1 and reference 2 is necessitated by the amendment)

Claim 2: (Correction) An apparatus comprising A and E
(A decision to reject can be made on the ground of lack of inventive step over reference 1 and reference 2 or over reference 1 and reference 3)

Claim 3: (Correction) An apparatus comprising A, B and E
(A decision to reject can be made on the ground of lack of inventive step over reference 1 and reference 2 or a rejection necessitated by the amendment is notified on the ground of lack of inventive step over references 1 through to 3)

※ The above cases are intended to show a number of different cases at once, and practically even if only one claim is to be rejected, the patent application can be rejected.

(Explanation)

① As to claim 1, a rejection was made on the ground of lack of novelty, and an amendment is made to add a new element D described in the description of the invention. If, however, amended claim 1 is found to lack inventive step over cited references 1 and 2, which is a new ground of rejection, the final rejection necessitated by the amendment is notified.

② As to claim 2, a rejection was made on the ground of lack of inventive step, and if, however the amendment to claim 2 fails to overcome the ground of rejection notified to claim 2 or 3, a decision to reject can be made without any special circumstances whatsoever on the assumption that an opportunity for submission of written arguments to the patent applicant has already been supplied.

③ As to claim 3, a rejection was made on the ground of lack of inventive step, and if the amendment to claim 3 fails to overcome the ground of rejection notified to claim 2, a decision to reject can be made. But if reference 3 should be additionally relied on other than a combination of reference 1+reference 2 to reject claim 3 after amendment, a new ground of rejection is considered to be necessitated and the final rejection necessitated by the amendment shall be made.

On the one hand, where the amended claim is directed to an invention of

a claim to which a ground of rejection has not been notified, the non-final rejection should be issued. Here 'the invention of a claim to which a ground of rejection has not been notified' means an invention of the claim to which a ground of rejection has not been issued before amendment or an invention to which a limitation has been added or of which the scope has been narrowed. However, even though a claim to which a ground of rejection has not been issued has been amended, where the amended claim has become different from a claim before amendment (the other claim to which a ground of rejection has not been issued shall be included) though amendment, as a new ground of rejection has been necessitated by the amendment, the final rejection should be issued. In this case, 'the other invention' means an invention which has been changed without adding a new matter or narrowing the scope of the claim before amendment.

In case of a new claim created by amendment, as a ground of rejection had not been notified, unless the new claim has been identical to the other claim (substantial identicalness is included) to which a ground of rejection had been issued, an opportunity for submission of written arguments should be provided, and as for a notice of rejection, paragraph 5.3, Chapter 3, Part 5 should be referred to.

(Ex) (Before amendment) Claim 1: An apparatus comprising A

(Lack of inventive step over reference 1)

Claim 2: An apparatus comprising A and B

(Lack of inventive step over reference 1 and reference 2)

Claim 3: An apparatus comprising A and C

(No Rejection)

Claim 4: An apparatus comprising A and G

(No Rejection)

(After amendment)

Claim 1: (Correction) An apparatus comprising A, B and D

(A decision to reject is made on the ground of lack of inventive step over reference 1 and reference 2)

Claim 2: (Correction) An apparatus comprising A, B and C

(Non-final rejection on the ground of lack of inventive step over reference 1

and reference 2)

Claim 3: (Correction) An apparatus comprising A, C and H
(Non-final rejection on the ground of lack of inventive step over reference 1 and reference 2)

Claim 4: (Correction) An apparatus comprising A and F
(Rejection necessitated by the amendment is notified on the ground of lack of inventive step over reference 1 and reference 2)

Claim 5: (Added) An apparatus comprising A and B
(A decision to reject is made as it is identical to claim 2 before amendment)

Claim 6: (Added) An apparatus comprising A and E
(Rejection necessitated by the amendment is notified on the ground of lack of inventive step over reference 1 and reference 2)
(Explanation)

① As for claim 1 to which a ground of rejection was issued before amendment, even though an element of claim 2 to which a ground of rejection was issued and a matter described in the description of the invention have been added through amendment so as to narrow the scope of claim 1, if a ground of rejection notified to claim 2 in view of a combination of the references has not been overcome, a decision to reject shall be made considering that an opportunity for submission of written arguments has been supplied to the patent applicant.

② As for claim 2 to which a ground of rejection was notified before amendment, even though an amendment is made to add an element recited in claim 3 to which a ground of rejection was not notified, if amended claim 2 is found to be rejected for lack of inventive step, a non-final rejection is issued.

③ As for claim 3 to which a ground of rejection was not notified before amendment, even though an amendment is made to narrow the scope of claim 3, if amended claim 3 is found to be rejected for lack of inventive step, a non-final rejection is issued.

④ As for claim 4 to which a ground of rejection was not notified before amendment, because a ground of rejection for lack of inventive step has

been necessitated by amendment, rejection necessitated by the amendment shall be issued.

⑤ As for claim 5, even though it has been newly added, because it is the same with claim 2 to which a ground of rejection was issued before amendment, a decision to reject shall be made.

⑥ As for claim 6, even though it has been newly added, because it is not the same with the invention before amendment, rejection necessitated by amendment shall be issued.

5.2.1.3 Matters to be concerned in determining whether an opportunity for submission of written arguments is supplied

(1) Where the examiner intends to make a decision to reject based on reasons different from the ground of rejection notified to the claim concerned, he should carefully review whether an opportunity for submission of written arguments has been supplied to the patent applicant before making a decision to reject.

(Ex1) Where a decision to reject has been wrongly made by changing the reference when no amendment has been made

(Non-final rejection)

Claim 1: A (Lack of Inventive step: reference 1)

(Decision to Reject)

Claim 1: A (Lack of Inventive step: references 1 and 2)

※ In the above example 1, a ground of rejection based on lack of inventive step over a combination of references 1 and 2 has once been notified to a different claim before amendment.

(Ex2) Where a decision to reject has been wrongly made by changing the reference even though the scope of the claim has been broadened by amendment

(Non-final Rejection)

Claim 1: A+B+C (Lack of Inventive step: reference 1)

(Decision to Reject)

Claim 1: A+B (Lack of Inventive step: references 1+2)

※ In the above example 2, a ground of rejection based on lack of inventive

step over a combination of references 1 and 2 has once been notified to a different claim before amendment.

(2) When the patent examiner determines whether requirements for amendment made in response to the final rejection necessitated by the previous amendment or made upon a request for reexamination are met, if a ground of rejection over a new combination of the references has been necessitated by the amendment, the amendment should be refused to be entered. In the following examples, because a combination of the references had been wrongly indicated by simple errors in the rejection issued before amendment, instead of making a decision to reject, the examiner should refuse to enter the amendment necessitating a new rejection over the combination of the references.

(Ex) Where the examiner wrongly proceeds with examination even though a wrong notice has been issued over a combination of the references

(Before amendment) Claim 1: An apparatus comprising A and D

(Lack of inventive step: reference 1)

Claim 2: An apparatus of claim 1, further comprising B

(Lack of inventive step: reference 1+ reference 2)

Claim 3: An apparatus of claim 1, further comprising C

(Lack of inventive step: reference 1+ reference 2+ reference 3 → Simple error of a combination of reference 1+ reference 3)

(Rejection necessitated by the amendment)

(After amendment) Claim 1: An apparatus comprising A, B and D

Claim 2: Deleted

Claim 3: An apparatus of claim 1, further comprising C

(A decision to reject after acknowledging amendment: reference 1+ reference 2+ reference 3)

5.2.2 Determining whether an opportunity for submission of written arguments in view of deficiencies in description should be provided

5.2.2.1 A decision to reject based on the ground of rejection notified to the same claim

Even though a ground of rejection is identical, if a term or a phrase which

is found to be indefinite in the claim is changed, as the patent applicant can make an amendment without recognizing it, an opportunity for submission of written arguments is not considered to have been substantially provided. Therefore, a decision to reject cannot be made based on the notified ground of rejection without any special circumstances whatsoever.

In other words, as for the description requirements, only in case that the amended claim fails to overcome the ground of rejection notified before amendment, and the concerned claim language found to make the claim indefinite substantially coincides, a decision to reject shall be made.

(Note) where a ground of rejection applied to the concerned claim is identical, but the concerned claim language is different or where another claim which is different from the concerned claim is created, even though that claim is to be rejected for the same ground as the concerned claim, an opportunity for submission of written arguments should be provided.

(Ex) (Before amendment) Claim 1: An apparatus consisting of A

(A is indefinite)

Claim 2: An apparatus consisting of A and B

(B is indefinite)

Claim 3: An apparatus consisting of A and C

(No rejection was made)

Claim 4: An apparatus consisting of A and E

(A is indefinite)

(After amendment) Claim 1: (Correction) An apparatus consisting of A' and D
(where D is indefinite, rejection necessitated by the amendment is made)

Claim 2: (Correction) An apparatus consisting of A', B and D

(Where B which was notified to be indefinite was not amended, a decision to reject shall be made)

Claim 3: (Correction) An apparatus consisting of A' and C

(Where C is found to be indefinite, a non-final rejection shall be issued)

Claim 4: (Correction) An apparatus consisting of B and E

(Where B is indefinite, rejection necessitated by the amendment shall be issued)

Claim 5: (Added) An apparatus consisting of A
(Where A is indefinite, a decision to reject shall be made)

(Explanation)

- ① Even though amended claim 1 is still found to be indefinite, as the concerned claim language has changed from A to D which is introduced by amendment, rejection necessitated by the amendment shall be issued.
- ② Because amended claim 2 is still found to be indefinite due to the concerned claim language B which was recited in claim 2 before amendment, a decision to reject shall be made.
- ③ Because claim 3 was not rejected, a non-final rejection shall be issued.
- ④ Because claim 4 is amended to include indefinite claim language B recited in claim 2 to which a ground of rejection was notified based on claim language B, rejection necessitated by the amendment shall be issued.
- ⑤ Even though claim 5 is newly added, because claim 5 is identical to claim 1 which was notified to be indefinite, a decision to reject shall be made.

5.2.2.2 A decision to reject is made based on the ground of rejection notified to the other claim

Where the amended claim is identical to the other claim to which a ground of rejection was notified, a decision to reject shall be made.

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 rejection necessitated by the amendments made in response to the previously-issued rejection (hereinafter 'final rejection necessitated by amendment') and the other is a rejection which is made for the first time or one which is not the final rejection necessitated by amendment (hereinafter 'non-final rejection').

5.3.1 「Non-final Rejection」

(1) An examiner may issue 'non-final rejection' regardless of voluntary amendments, if it is issued for the first time since the start of an examination.

(2) Where an unamended portion of the specification includes a ground for rejection, an examiner shall issue 'non-final rejection'.

(3) Even though the description of the invention or the claims after amendment has a ground for rejection, if the concerned ground for rejection is not necessitated by amendments made in response to the previous notice of grounds for rejections but is due to the description of the invention or the claims before amendment, 'non-final notice of grounds for rejection' shall be notified.

(Example 1) In below example, an examiner has issued the non-final rejection and examines again the claim whose insignificant description deficiency (considering the description of the invention, A' is deemed to be A) is amended. During this examination, an examiner discovers a prior art for an apparatus comprised of elements A+C and decides to issue the notice of grounds for rejection. In this case, an examiner shall issue the non-final rejection, as this is related to novelty or inventive step in inventions of claims before amendments.

<u>Before Amendment</u>	<u>After Amendment</u>
【Claim 1】 : Apparatus comprising A' or B with C attached	【Claim 1】 : Apparatus comprising A or B with C attached

(Example 2) Where having notifying the rejection ground to only a part of two or more inventions specified in a single claim, and then notifying the grounds for rejection to the remaining inventions afterwards, an examiner shall issue the non-final rejection despite that the claim has been amended in response to the rejection.

(4) Where the grounds for rejection arise due to reasons other than amendments, an examiner shall issue the 'non-final notice of grounds for rejection'.

For example, when issuing the non-final rejection, no defects had been found in terms of capacity to hold a right as a foreigner. However, after amendments, a foreigner loses the capacity to hold a patent according to Article 25 of the Patent Act, this ground for rejection is not necessitated by amendments. Therefore, this is issued as a non-final rejection.

(5) In case of *ex-officio* re-examination, even for a ground of rejection necessitated by the amendment made in response to a notice of the ground for rejection before revocation of grant of a patent, the non-final rejection should be issued in this regard.

(6) As for a remanded application, the rejection which was necessitated by the amendment made in response to a notice of rejection issued before the application was remanded, shall be issued as non-final, taking into account (1) it is harsh to limit the scope of amendment again for the applicant who endured disadvantages of delays in examination proceedings as the examiner has wrongly rejected the application, and (2) where rejection necessitated by the amendment in response to a notice of rejection issued before a notice of revocation in *ex-officio* reexamination according to Article 66(3) of the Patent Act of Korea, a non-final rejection is issued.

5.3.2 'Final Rejection necessitated by amendment'

Where the ground for rejection arises from amendments made in response to the rejection having been noticed to an applicant, an examiner shall issue the final rejection. In other words, an examiner shall issue the final rejections where a rejection ground which had not been exist or does not need to be examined prior to amendments, is necessitated by the amendments.

Amendments in response to the notice of ground for rejection having

been issued previously are a prerequisite for the final rejection. In other words, the final rejection necessitated by amendment can be issued only when the written amendment has been submitted and a new rejection ground incurred in the amendment.

Specific examples regarding the final rejection necessitated by amendment are as follows.

(1) Where amendments of the specification or drawings result in adding a new matter or exceeding the permissible scope of division or conversion.

(2) Where amendments of a claim under examination cause the ground for rejection regarding novelty or inventive step. However, where the invention of an amended claim is the same as another claim never been notified for rejection ground, an examiner shall issue the non-final notice of rejection grounds.

(Example 1) In this below example, an applicant amends claim 1 in response to the notice of rejection ground (lack of novelty or inventive step) and remedies this ground. However where the addition of element D after amendment raises a need to rely on a prior art including D, it is regarded as a rejection grounds incurring from amendments. The final rejection necessitated by amendment is issued in this case.

If a claim language 'A and B' is considered indefinite because the elements are not recited alternatively, it would be the ground for reason having been existed before amendments of element D. Therefore, in this case, the final rejection necessitated by amendment cannot be issued.

Before Amendment	After Amendment
【Claim 1】 : Apparatus comprising A and B with C attached	【Claim 1】 : Apparatus comprising A and B with D attached

(Example 2) Where a claim is broadened after amendments in response to the rejection on ground of description deficiencies to result in a lack of novelty or inventive step, because an examiner is required to make prior art

search again which is necessitated by amendments, an examiner shall issue the final rejection necessitated by the amendment 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 added claim or a claim changed to the extent equivalent to new addition of a claim contains grounds for rejection regarding novelty or inventive step. However, where the concerned claim is amended to be identical 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 rejection unless all of the grounds for rejection fall under the final rejection necessitated by the amendment.

(2) Where uncertainty pertains to the selection between two types of rejection, an examiner shall issue the non-final 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 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 Report], 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 of 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.

※ Example

No	Matters Notified as Grounds for Rejection	Relevant Provision in the Patent Act
1	description of the invention	Article 42 (3)(i) (deficiency in the description of the invention)
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	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 of 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.

(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 prior art reference with the claimed invention, he/she shall specifically indicate which parts of the prior art reference is considered in the comparison with the claimed invention. Where a multiple number of prior art references are compared to each other, an examiner shall select the closest prior art reference among them, and describe technical features of the closest prior art reference that corresponds to the claimed invention. Then, the examiner points the difference between the claimed invention and the closest prior art reference, and states technical features of other prior art references 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 prior art reference pertaining to the claimed invention, and may describe differences and his or her assessment regarding inventive step. In this regard, such specification of the prior art reference 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 prior art reference to features added or limited to the dependent claim, or indicate his or her assessment on the difference between the prior art

reference and the dependent claim based on common general knowledge.

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 prior art reference, 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 prior art reference. 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 prior art references 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	Prior art reference 1 Publication in Patent Gazette No. ○○-○○○○	Prior art reference 2 US Patent No.○○○○○○○
A(Element1)	A (location of its description)	
B (Element2)	B (location of its description)	
C (Element3)		C' (location of its description)

The invention in claim1 is different from prior art reference 1 because claim 1 has element 3 as shown above. However, C in element 3 is practically the same as C' in prior art reference2. C' in prior art reference 2 can be easily combined with A and B in prior art reference1 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 prior art reference 1 and 2.

(2) Component Comparison Table and Assessment

Claim		Prior art reference 1 US Patent Publication No. ○○-○○○○	Prior art reference2 US Patent Publication No. ○○○○○○
Claim1	A(Element1)	A (location of its description)	
	B(Element2)	B (location of its description)	
	C(Element3)		C' (location of its description)
	Judgment	C in element3 is practically same as C' in prior art reference 2. As A and B in prior art reference 1 are easily combined with C' in prior art reference 2, claim 1 can be invented without difficulties using cited 1 and 2.	

(5) 「Considerations of 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 of Amendment」 as the grounds for rejection, he/she shall make notice of the ground for rejection again.

5.4.3 Preparation of Written Decision to reject

A written decision to reject 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 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 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	the description of the invention	Article 42(3)(i) (deficiency in the description of the invention)
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」 .

(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 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-by-claim Basis

(1) Even if the description of the invention has deficiency, claims, which seem to relate to such deficiency of the description of the invention 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 description of the invention having been notified, or where an examiner judges that any amendment by an applicant cannot remedy the ground for rejection in the description of the invention. In such case, in 「Considerations of Amendment」, 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 of Amendment」 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」 .

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(19xx. x. x.) Published Patent Gazette No.oo-oooo-oooooo(19xx. x. x.) Published Utility Model Gazette No.oo-oooo(19xx. x. x.) Registered Patent Gazette No.oo-oooo(19xx. x. x.)
US	US Patent No. US ooooooo (20xx. x. x.) US Patent Application Publication No. US oooo/ooooooo (20xx. x. x.) US Patent Abstract No. US ooooooo (19xx. x. x.)
Japan	JP Patent Gazette A No.ooooooo(20xx. x. x.) JP Registered Utility Model Gazette U No.ooooooo(20xx. x. x.) JP Published Patent Gazette AH No.oo-oooooo(19xx. x. x.) JP Published Patent Gazette A No.2000-oooooo(20xx. x. x.) JP Published Model Utility Gazette S No.oo-oooo(19xx. x. x.)
UK	UK Patent Publication No.ooo Abstract (class ooo)(19xx. x. x.) UK Patent Publication No.ooo Abstract(Group ooo)(19xx. x. x.) UK Patent Publication No.ooo Abstract(Heading ooo)(19xx. x. x.) UK Patent Publication No.ooo(19xx. x. x.) ※ 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)(19xx. x. x.) DE Patent Application Publication No.oo-ooo(class oo)(19xx. x. x.) DE Patent Application Publication No.oo-ooo(19xx. x. x.) ※ 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 (19xx. x. x.)

(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(19xx. x. x.)
(No. of page and drawing)

Published Patent Gazette No.oo-oooo-ooooooo(19xx. x. x.) (Speed Reduction Gear)

Published Patent Gazette No.oo-oooo-ooooooo(19xx. x. x.) (Drawing No. a, b, c)

5.5.2 Citation of Non-patent Documents

(1) Depending on periodical publication, non-patent documents are cited as follows:

Type	Citations Instructions
Periodicals, Non-Periodicals	<p>(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.</p> <p>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(,).</p> <p>(ii) Title of publication is generally not stated in abbreviations.</p> <p>(iii) Number of volumes and issues are stated as 'Volume oo, No.oo'. For English publications, 'Vol. oo, No. oo'</p> <p>(iv) Where publication date can substitute a number of volume, the statement of volume and issue numbers can be omitted.</p> <p>(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.</p> <p>(vi) For unclear publication date, the date of obtaining the documents can be stated instead, with a clear explanation for the reason.</p> <p>(vii) For a publication with no concerns for misunderstanding of its publisher, name of publisher can be omitted.</p> <p>(viii) Where a location of publication is not well known place, its</p>

	<p>country shall follow right after the location, which is distinguished with comma (.). For publications published in Korea, the location of publication is omitted.</p> <p>(ix) Name of author and title of thesis if considered unnecessary can be omitted.</p> <p>(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.</p> <p>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.</p> <p>(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.</p>
Books	<p>(i) Name of Author(or Name of Editor). Book Title. Location of Publication: Publisher. Publication Date, Number of Volume, No. of Edition, and No. of Page is the order for book citation</p> <p>For a translated book, Name of Author (or Editor), and Name of Translator are the description order.</p> <p>(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(,)</p> <p>(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.</p> <p>(iv) Book title is written in the style of italic.</p> <p>(v) Number of edition if not indicated on the book can be omitted.</p> <p>(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.</p> <p>(vii) Page Number, is stated page number with 'pp.' before numerals. Where citation involves plural pages, the rules for periodicals shall be complied with.</p>

(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. 19xx.x.x., Vol.o, No.o (pp. o or pp. o)

Hong Gil-dong. Steam Engine. Daejeon: oo Publication Co. 19xx.x.x., 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 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 notice 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 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 agent for the first time or discharge or change an agent 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-filed 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, 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.

(Note) Fees shall be refunded where a request for period extension is rejected.

6.1.3 Shortening of Designated Period and Others

(1) The period for a patent-related procedure having been designated can be shortened according to a request. Where a request for period shortening is made or where a written amendment or description stipulating the purport to shorten the designated period is submitted, the designated period is deemed to have been expired as of the submission date of a shortening request form or a written amendment.

(2) Any person can request to extend the period for requesting for an

appeal trial against decision 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 PTAB (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 any time 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 notice 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 description of the invention, an examiner may refer them to decide the patentability of the concerned application.

(3) Where an amendment is submitted after the period designated in the notice 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 description of the invention and claims upon the notice 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 description of the invention and claims. However, where the matters to be amended are disclosed only in the written argument, 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 8, Chapter 3, Re-notice of the ground for rejection))

6.3 Treatment of Amendments

6.3.1 Confirmation Method for Amended Specification

(1) Where multiple amendments are submitted voluntarily before any notice 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 notice 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 the designated period, each amendment is accumulatively reflected to determine the final specification to be examined. Where multiple amendments are submitted to the final rejection necessitated by amendment 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:

(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
Description of the invention	◇	◆		◆	◆	◆
Claim 1	○	●		●	●	●
Claim 2	□	■	■	■	■	■
Claim 3	△				△	△
-						
Claim 10	☆				☆	☆
Drawing(s)	♠	♠		♠	♠	♠

※ As seen in the above example, where an applicant amends description of the invention, 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 ((Description of the invention(◆), 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. (Description of the invention(◆), Claim 1(●), Claim 2(■), Claim 3(△), ...Claim 10(☆) and Drawing(s) (♠)).

(2) Where an amendment in response the final rejection necessitated by amendment or made upon the request for reexamination is refused to be entered pursuant to Article 52(1) of the Patent Act, an examiner considers the amendment deemed to have never been submitted. The refusal to enter amendment shall be referred to this section in 「11. Amendment in Response to Final Rejection Necessitated by Amendment」.

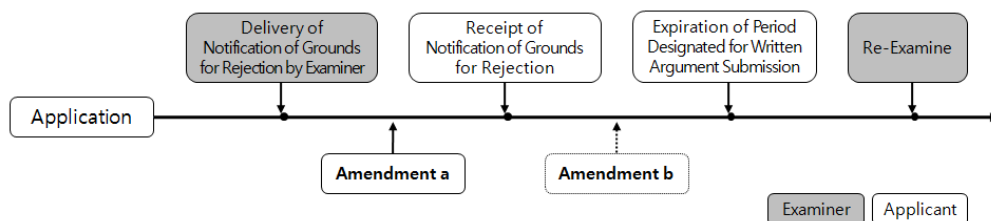
6.3.2 Additional Matters to be considered

(1) A voluntary-amendment submitted before examination starts and an amendment in response to the non-final rejection within the period (designated for 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 voluntary-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 notice 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 notice of grounds for rejection, 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, 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 but a ground for rejection incurring from Amendment b, an examiner shall notify the final rejection necessitated by amendment.

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 description of the invention by indicating paragraph number, and a written statement explaining relation among claims where an application involves enormous amount of description of the invention 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 arguments, where an applicant's claim in the written arguments is hard to understand and deemed to have serious impact on a decision for patentability.

⑦ Documents relevant to examination results of the application whose priority is claimed under the Paris Convention (Documents are excluded where it is easily retrieved through the information network system) and its Korean translation

(3) The request for documents required for examination shall be made under the name of 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 notice of the grounds for rejection. Provided, however, that, as for an international patent application, submission of a copy of the documents stated in the IPSR or ISR shall be requested in the name of the Commissioner of KIPO.

(4) Even if an applicant fails to respond the document request by an examiner, an examiner shall not invalidate an application procedure. Provided, however, that where the patent applicant has not submitted required documents or the submitted documents are deficient, the examiner shall instruct to file the documents again.

(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.

(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 for which decision to grant or to reject has been made 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.

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 prior-filed 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 a prior-filed 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 search for prior art is outsourced to an authorized prior art search institute, 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.

However, where the examination deferral or processing period is extended because prior art search is outsourced to an authorized prior art search institute, 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 requested to external institutions, but have not been secured yet.

(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 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 later-filed applications until the

prior-filed application has been processed or has been laid-open or registered. However, where the later-filed application can be rejected based on the same ground as the ground for rejection for the prior-filed application, the examiner can start examination. The detailed methods of starting examination for later-filed application are as follows:

Identicalness of Applicants of Prior-filed/Later-filed Applications	Disclosure of Prior-filed application	Start of Examination on Later-filed Application
Identical	Laid-open	Examination conducted and Ground for rejection under Article 36(1) notified (Patentability determined after confirming claims of prior-filed application)
	Not Laid-open	Examination conducted and Ground for rejection under Article 36(1) notified (Only application number of prior-filed application and invention disclosed in claims indicated, Patentability determined after confirming claims of prior-filed 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-filed application

(8) When the prior-filed application is examined or laid open or registered after examination on later-filed applications is deferred, the examiner may conduct examination on later-filed application. However, even though examination on later-filed 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-filed application is determined.

9. Document Service

9.1 General Principles

(1) The documents shall be served by registered mail except for the cases where the party or his/her agent 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 served by a special service method according to laws on postal service.

(2) The documents shall be served to a legitimate receiver, referring to an agent if appointed, sub-agent or agent appointed midway except for special cases. The special cases herein refers to the occasion where a service is made to an agent given no priority regarding notification, or where an agent or the party goes through the procedure directly related to the examination such as a written 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 agent described first in a written patent application.

For a multiple number of agents with general power, documents shall be served preferentially to the agent having appointed for the relevant case.

Where a receiver is incompetent, service shall be made to his/her legal representative.

Where two or more applicants involve in a patent application, service 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 service of documents shall be made to residential or business address of a entitled receiver unless reporting other address for service.

The change of service address shall be reported without delay.

(Note) Where a failure of service is due to rejection by a receiver without justifiable reason, the date of sending is regarded as a receiving date. More details regarding document service can be referred to 「Part 1 General Rules」 .

9.2 Service by Public Notification

When documents cannot be served because the residential or business address of the addressee is unclear, the documents shall be served 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.

Service by public notification shall be made as follows.

① Where documents are returned, an officer in general affairs division of examination 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 serve documents by public notification. If not identical, an examiner shall serve 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 served 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 service shall be made according to the Rules on Office Management and Patent Net System. However, an examiner may adopt a different service method where through case by case review an examiner finds a new service method for sure sending to a legitimate receiver.

10. Personal Interview

Where an applicant or his/her agent (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 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 an appeal 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 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 agent of the concerned application, or a person with an evidential statement showing he/she is a legitimate entrustee appointed by an agent, an applicant, or an agent with the right to elect an agent for him/herself (referred to sub-agent).

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 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 notice 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 the argument, a participant shall submit the responding documents (such as the written the argument, the amendment, and 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 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 Rejection Necessitated by Amendment

Unlike the non-final rejection, when receiving the amendment in response to the notice of the final grounds for rejection, an examiner shall determine whether to refuse to enter the amendment before assessing the requirements of patentability and confirm matters to be examined.

When submitting the written argument, an applicant may argue that the notice of the final rejection necessitated by amendment 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 rejection necessitated by amendment”, considering the applicant’s assertion in the written argument.

11.1 Remarks related to ‘Final Rejection Necessitated by Amendment’

(1) Whether the final rejection necessitated by amendment is appropriate or not shall be referred to 「5.3 Types of Notice of Grounds for Rejection」. Where an examiner judges that issuance of the final rejection necessitated by amendment 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 rejection necessitated by amendment is deemed to be inappropriate, an examiner shall not refuse to enter but admit the amendment.

Where the grounds indicated in the final rejection necessitated by amendment 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 rejection necessitated by amendment

Where an examiner notifies of final rejection necessitated by amendment but is supposed to notify of non-final grounds for rejection, and applicant submits the amendment only in response to the final rejection necessitated by amendment (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 rejection necessitated by amendment are not overcome. The type of the ground for rejection shall be decided with referral to 「5.3 Types of Notice of Grounds for Rejection」 .

② Where final rejection necessitated by amendment are notified to an applicant, but he or she makes an amendment with considering ‘the final rejection necessitated by amendment’ as ‘a non-final notice of grounds for rejection.’

Where an applicant, arguing the inappropriateness of the examiner’s issuing the final rejection necessitated by amendment, submits the amendment in response to non-final 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 rejection) as the final rejection necessitated by amendment, 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 refuse to enter the amendments in reverse order of the submission.

(2) Where the amendment in response to the final rejection necessitated by amendment 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 refused to be entered. Provided, however, that if a new ground of rejection can be cured by *ex-officio* amendment, the patent examiner shall approve the amendment and carry out the subsequent procedures. As for the matters which are subject to *ex-officio* amendment, refer to [3. Matters which are subject to *ex-officio* amendment, Chapter 2, Part 8]

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 amendment」 can be referred to the following examples.

(Example 1)

Claim 1 : Equipment comprised of A+B

[Final Rejection necessitated by amendment] Claim 1 is denied of inventive step due to prior art reference1

[Specification after Final Amendment]

Claim 1 : Equipment comprised of A+b

(still denied of inventive step due to prior art reference1)

[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 prior art reference1. The decision to reject a patent is made.

(Example 2)

Claim 1 : Equipment comprised of A+B

[Final Rejection necessitated by amendment] Claim1 is denied of inventive step due to the prior art reference1

[Specification after Final Amendment]

Claim 1 : Equipment comprised of A+B+C

(Inventive step is admitted for the prior art reference 1 but not for the prior art references 1 and 2. The prior art reference 2 is required additionally due to the addition of C)

[Amendment refused to be entered] The amendment of claim 1 generates a new ground for rejection. Therefore, the amendment is not admitted, resulting in the refusal to enter the amendment.

[Decision to Reject] Claim 1(A+B) is denied of inventive step due to the prior art reference 1.

(Example 3)

Claim 1 : Equipment comprised of A+B

Claim 2 : Equipment comprised of claim1 with C attached

[Final Rejection necessitated by amendment] Claim 1 is denied of inventive step due to the prior art reference.

[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 Rejection necessitated by amendment] Since the deletion of claim 1 in compliance with notice 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 rejection necessitated by amendment.

(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 Rejection necessitated by amendment] 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 Rejection necessitated by amendment] Claim 1 is denied of inventive step due to prior art reference1

[Specification after Final Amendment]

Claim 1 : Equipment comprised of A+B

(Prior art reference 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 prior art reference1. 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 prior art reference1

(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 refuse to enter the amendment by reason abovementioned. Note that an examiner shall admit the amendment unless there are other reasons for refusal to enter amendment, and then notify the new rejection grounds at the final rejection necessitated by amendment.

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 notice of the final rejection necessitated by amendment even after approving the amendment (see Part 2, Chapter 4, 4.(4) for detail).

(5) The decision to refuse to enter amendment shall be made in writing separately from the decision to reject an application, specifying reasons why amendment had to be refused to be entered for the subsequent procedural convenience for an applicant.

(Note) An applicant cannot appeal against a decision to refuse to enter amendment during the substantive examination, which can be dealt only in the trial against the decision to reject an application. Decisions to refuse to enter an amendment made before revocation of a patent in the course of *ex-officio* reexamination and refusal to enter an amendment made before a request for a reexamination is requested 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 Notice of Grounds for Rejection」 .

(Note) Where an examiner overlooks the fact that an inappropriate amendment in response to the final rejection necessitated by amendment is made and then makes a decision to grant a patent or notifies non-final or final grounds for rejection, he/she cannot refuse to enter the previous amendment retroactively upon his/her discovery.

11.4 Examination after Refusal to Enter Amendment

(1) After refusing to enter amendment, an examiner shall continue examining the pre-amended specification.

(2) Where reviewing the final rejection necessitated by amendment and discovering the ground not overcome, an examiner shall make a decision to reject the application. Where an examiner regards the final rejection necessitated by amendment was inappropriate and discovers no other grounds for rejection, he/she shall make a decision to grant a patent.

(3) Where an examiner discovers inappropriateness of the final rejection necessitated by amendment 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 Notice of Grounds for Rejection」 .

12. Decision to Grant or Reject

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 agent, 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.

(3) As for 1) a patent application filed by the patent examiner of KIPO, 2) a patent application filed a KIPO examiner within 2 years from retirement and 3) a patent application filed by a searcher of a prior art search institution, which is supervised by KIPO, if the patent examiner finds that the patent examination under consideration is to be registered based on the examination results, the examiner shall determine the consequences of the patent application, i.e. grant or refusal, in consultation with 3 persons including a director of the examination division or a head of the examination part.

12.2 Decision to Reject an Application

(1) Where an examiner provides an opportunity for petition to an applicant with the notice 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. Provided, however, that where a ground

of rejection which has yet been remedied may be cured by *ex-officio* amendment, the examiner shall make an *ex-officio* amendment and allow grant of a patent. As for the matters which are subject to *ex-officio* amendment, refer to [3. Matters which are subject to *ex-officio* amendment, Chapter 2, Part 8]

The written decision to reject an application shall include an application number, title of invention, name and address of applicant and agent, 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 to reject is confirmed when it cannot be revoked with methods prescribed in provisions of the Patent Act. For example, where no appeal against the decision to reject is filed within the statutory period, where a trial decision is made supporting the decision to reject in the appeal against the decision to reject, 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 to reject 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 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 legitimate right-holder without delay after confirming the decision to reject. Where the confirmation of the decision to reject requires a long time in an appeal against the decision to reject, an examiner before the confirmation of decision to reject, may notify a legitimate right-holder of his/her decision to reject an application and the appeal against the decision to reject in advance.

(3) As for the patent application, which has been revoked and returned, the examiner responsible shall consult with a director of the examination division or a head of the examination part and determine allowance or rejection.

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 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 notice 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 himself/herself, the concerned examiner shall execute the corresponding subsequent measures.

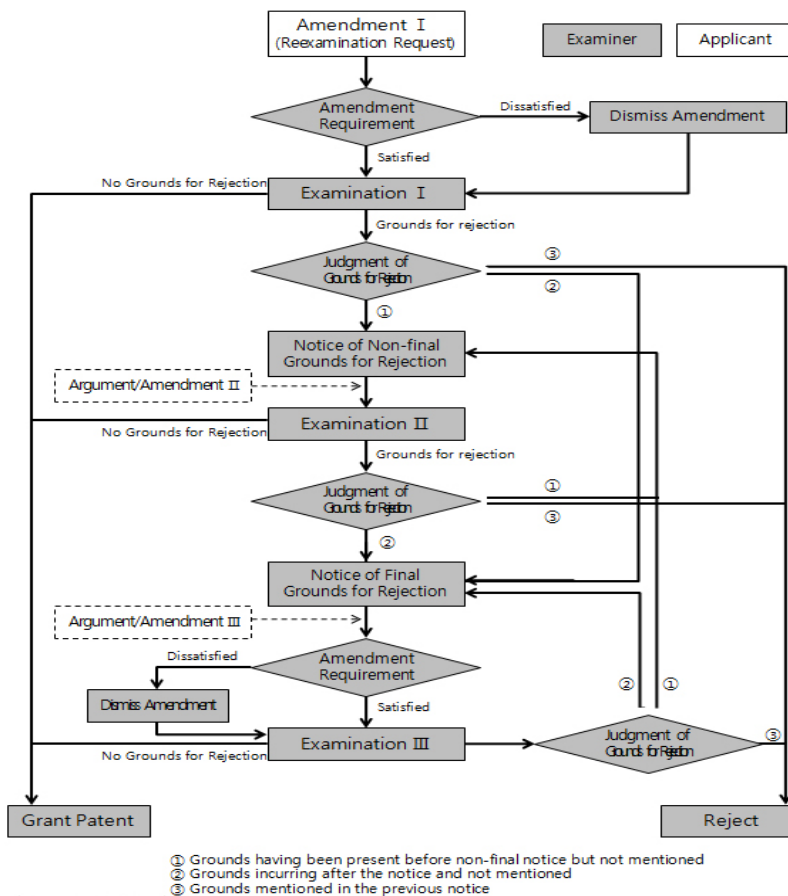
Chapter 4. Reexamination

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 an appeal 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 an appeal trial.

2. Reexamination Procedure

2.1 Reexamination Procedure Flow Chart



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 patent classification of the claimed invention shall carry out the reexamination.

(2) Requirements for reexamination are as follows: an application has not been invalidated, withdrawn or abandoned; has rejected (rejection after reexamination excluded); has not requested for an appeal trial against decision to reject; and declares the intention to request an reexamination with amendment of the specification, drawing(s), or claims. 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 requests for a reexamination prior to the decision to reject a patent application, or requests again for an additional reexamination after a rejection received from the first reexamination, an examiner shall return the written request for reexamination.

Provided that, where the examiner made a decision to reject an application after reexamination, but the decision to reject was reversed and the application was remanded to the examiner, if the examiner again makes a

decision to reject the application based on the different grounds from those of the previous decision to reject, the applicant may make request for reexamination of the application.

(4) An applicant shall not request reexamination for an application for which an appeal trial against the decision to reject has been requested. When requests for a reexamination and an appeal trial against the decision to reject 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 notice of appeal

The proviso of Article 67-2 stipulates that an applicant shall not request for reexamination where an appeal to the decision to reject have been already filed. And Regardless of whether the notice of appeal is invalidated 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 amendment to an applicant. When receiving the amendment from an examiner, an applicant may amend by withdrawing an appeal against the decision to reject 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 notice of appeal following the submission of the amendment containing the purport to request for reexamination.

As the request for reexamination by submitting the amendment is legitimate, an examiner shall regard the decision to reject having been cancelled, and proceed with the reexamination.

③ Where an applicant submit a notice of appeal and the amendment containing the purport for reexamination request, both of which are dated on the same day.

Where the submission times of a notice of appeal 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

notice of appeal, 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 an appeal trial against decision to reject. Where an applicant withdraws an appeal against the decision to reject (a notice of appeal), an examiner in the view of a request for reexamination having been valid shall proceed with the reexamination procedure. When receiving a request for returning an amendment, an examiner shall return it without delay.

④ Where an applicant submit a notice of appeal 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 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 decision to reject is deemed to have been withdrawn. Therefore, the examiner herein shall examine in the same manner as he/she have examined an application with the amendment before decision to reject was made.

However, the request for reexamination deems to withdraw only the previous decision to reject, not the other previous procedure of the examination. In other words, a patent procedure prior to decision to reject and the examination procedure conducted by an examiner (notice of the non-final rejection ground, amendment, notice of final rejection necessitated by amendment, or refusal to enter amendment), 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 refused to be entered or not.

Judgment to refuse to enter 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 rejection necessitated by amendment' 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 rejection necessitated by amendment. For the scope of amendment, Part VI Chapter 2 in this Guideline shall be referred to.

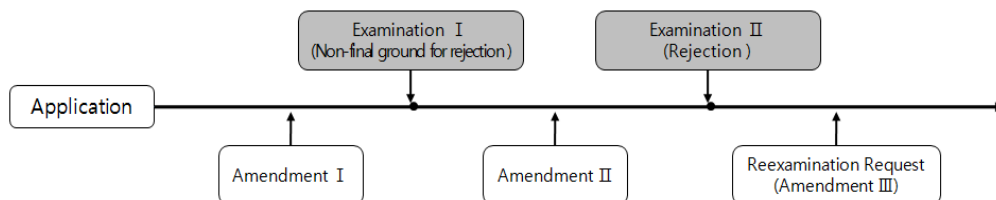
(3) In the case of request for reexamination, even if the amendment having been conducted before the reexamination request is to be refused to be entered but is disregarded, an examiner shall not refuse to enter the amendment retroactively by the foresaid reason(Patent Act Article 51① Proviso). It is designed to protect an applicant's confidence and interest in reexamination procedure which is based on the amendment made before decision to reject, of an applicant.

(4) A decision as to whether the amendment is appropriately made or not is made as follows:

① Where a decision to reject is made without refusal to enter amendment prior to request for reexamination

An examiner examines the specification reflecting the Amendment I and delivers the notice of non-final 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

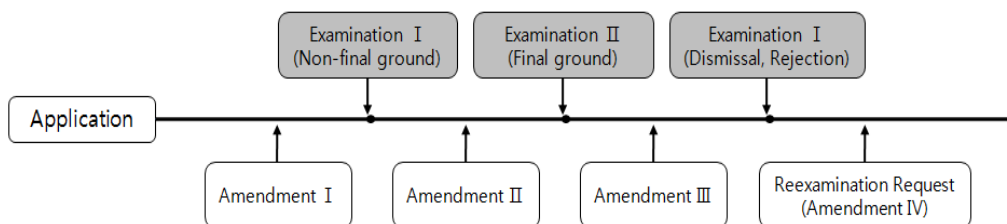
drawing(s) originally attached to the written patent application, and (b) another requirement for the amendment pursuant to Article 47 (3) shall be compared with the specification or drawing(s) having reflected the Amendment II.



② Decision to reject after the refusal to enter amendment, but before the request for reexamination

During examining the specification reflecting Amendment II, the examiner discovers another rejection necessitated by Amendment II and notify to the applicant the final rejection necessitated by the amendment thereafter. And with the judgment that the Amendment III does not meet the requirements for amendment, an examiner refuses to enter the Amendment III and examines the Amendment II. According to the examination, an examiner makes a judgment that the final rejection necessitated by amendment is not amended and accordingly makes 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 introduction of new matter pursuant to Article 47(2) of the Patent Act shall be determined by comparison 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.

In other words, since the Amendment III has been already refused to be entered and the applicant shall not appeal against the decision to refuse to enter amendment prior to a request for reexamination, 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 notice 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. In determining the consequence of the patent application under consideration, i.e. decision to grant or reject, it can be determined in consultation with 3 persons, including a patent examiner responsible.

(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 issues a non-final rejection or a final rejection necessitated by amendment or the decision to grant a patent, the amendment shall not be refused to be entered retroactively even when the inappropriateness is discovered afterwards.

2.5 Examination after Refusal to enter Amendment

(1) After refusing to enter 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 make a decision to reject. However, if the review determines that the decision to reject 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 decision to reject 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 notice of appeal against decision to reject 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 notice 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 decision to reject deems to have been withdrawn when a reexamination request is filed. Where an applicant submits a request for withdrawal of the reexamination

request, it shall 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 withdrawn. 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.

(5) In examining the application to which an amendment is made upon request for reexamination, it shall be determined whether a ground of rejection, which has been notified through a decision to reject, is remedied by amendment.

Even if the amendment made upon request for reexamination fails to remedy the other ground of rejection than the ground on which the decision to rejection is made, the examiner shall provide the applicant with an opportunity for submission of written arguments without issuing a decision to reject therefor; provided, however, that if the application amended upon request for reexamination includes a ground of rejection once overcome by the previous amendment made in response to non-final rejection, a decision to reject shall be made because the patent applicant is considered to have been given an opportunity to submit written arguments and to file relevant amendment.

Chapter 5. Patent Application filed in a language other than Korean

1. Overview

1.1 Relevant provisions

Article 42-3 (Patent Applications in Foreign Language, and etc.)

(1) If a patent applicant states his/her intention, in the patent application, to write the specification and drawings (limited to captions in drawings; the same shall apply hereafter in paragraphs (2) and (5)) in a language specified by Ordinance of the Ministry of Trade, Industry and Energy, other than Korean language, he/she may write the specification and drawings in the language.

(2) If the specification and drawings initially accompanying a patent application are written and prepared in a language provided for in paragraph (1) (hereinafter referred to as "patent application in a foreign language"), the patent applicant shall submit a Korean translation of the specification and drawings in the manner specified by Ordinance of the Ministry of Trade, Industry and Energy by not later than one year and two months from the date specified in any subparagraph of Article 64 (1), whichever is relevant: Provided, That upon receipt of a request for examination of the application under Article 60 (3), the applicant shall submit a Korean translation by not later than three months from the date when notice is served, or one year and two months from the date specified in any subparagraph of Article 64 (1), whichever comes earlier.

(3) A patent applicant who has submitted a Korean translation under paragraph (2) may submit another Korean translation in replacement of the earlier Korean translation by not later than the expiration of the period specified in paragraph (2): provided, however, that the foregoing shall not apply in the following cases:

1. Where the patent applicant has amended the specification or a drawing

(excluding an amendment deemed made under paragraph (5));

2. Where the patent applicant has filed a request for examination of the application.

(4) If a patent applicant fails to submit a Korean translation of the specification under paragraph (2), the applicant shall be deemed to voluntarily withdraw the patent application on the next day of the expiration date of the period specified in paragraph (2).

(5) If a patent applicant submits a Korean translation under paragraph (2) or another Korean translation under the main body of paragraph (3), the specification and drawings accompanying the patent application in a foreign language shall be deemed amended according to the Korean translation: Provided, That if another Korean translation is submitted under the main body of paragraph (3), all amendments that shall otherwise be deemed to amend the specification and drawings according to Korean translations submitted prior to the latest Korean translation (hereafter referred to as "final Korean translation" in this Article and the latter part of Article 47 (2)) shall be deemed never made.

(6) A patent applicant may correct any error in the final Korean translation in the manner prescribed by Ordinance of the Ministry of Trade, Industry and Energy during the period set for amendments under Article 47 (1). In such cases, paragraph (5) shall not apply to the corrected Korean translation.

(7) Where a correction is made according to the first sentence of paragraph 6, within the period set forth under Article 47(1)(i) or (ii), all of the corrections done before the last one shall be deemed not to have been made.

1.2 Purport

A foreign language patent application is introduced in order for the applicant

to get a benefit of earlier filing date by allowing a specification or drawings accompanying a patent application to be prepared in a language other than Korean. However, a specification in a foreign language (hereinafter referred to as a 'foreign language specification') shall be permitted only for the establishment of a filing date, so the Korean translations should be filed within a certain time period to file a request for examination, to lay open the application to public inspection and to file divisional and converted applications, as patent examination and establishment of a right are based on a specification in Korean.

1.3 Understanding of provisions

1.3.1 Application and abstract

Even for a foreign language patent application, an application and abstract thereof shall be described in Korean as a regular patent application filed in Korean. On the one hand, for a foreign language patent application, English shall be indicated on the application as a patent application language.

1.3.2 Specification in a foreign language

A foreign language specification attached to application thereof shall be written in a foreign language prescribed by a relevant Ordinance of the Ministry of Economy, Trade and Industry (as provided in Article 21(2) of the Administrative Instructions of the Patent Act. English only) to have the filing date of an application established.

1.3.3 Korean translation

1.3.3.1 Submission and time limit

Where a specification is prepared in a foreign language, a patent applicant shall submit the Korean translations within 1 year and 2 months from the earliest priority date. However, where the third parties file a request for examination to the Office, the applicant shall submit the Korean translations within 3 months from the filing date of examination request or within 1 year and 2 months from the earliest priority date, whichever comes earlier.

New Korean translations replacing previously submitted Korean translations shall be able to be submitted to the Office within the time period for submission of the Korean translations. However, after an applicant files a request for examination or amends a specification after submitting the Korean translations, he/she shall not be permitted to submit new Korean translations.

On the one hand, in case a divisional application or a converted application is filed in a foreign language, the Korean translations shall be submitted within 30 days from the date of a divisional or a converted application being filed, even though the period of 1 year and 2 months have already been lapsed from the filing date of the parent application.

The Korean translations shall be submitted accompanied by document submission form [Article 21(3) of the Exceptional Provisions to the Patent Act, Form No. 13], and the Korean translations of a foreign language specification (a “word-for-word translation” into Korean in accordance with the context of the foreign language specification) shall be submitted.

1.3.3.2 Where Korean translations are not submitted

① Failure to submit the Korean translations of a foreign language specification

Where the Korean translations of foreign language specification are not submitted, the patent application concerned shall be deemed to have been withdrawn.

② Failure to submit the Korean translation of drawing(s)

Where the Korean translations of drawing(s) (the text matter only) are not submitted, the patent application concerned shall not be deemed to have been withdrawn as is different from the case of a specification. However, amendment to the application shall be able to be instructed on grounds of violation of the written description requirement of drawing(s).

1.3.3.3 Effects of submission of the Korean Translations

If the Korean translations are submitted, a foreign language specification originally attached to the application thereof shall be deemed to have been

amended according to the Korean translations. In order to reduce applicant's practical burdens of preparing amendments amending the foreign language specification into Korean specification, Korean translations of the foreign language specification are awarded effects of amending the specification.

On the one hand, before the amendment of the Patent Act, where an international patent application is filed in a foreign language and then the Korean translations are submitted subsequently, the Korean translations are legally deemed as a specification. Pursuant to a patent application filed in a language other than Korean under the amended Patent Act (Enforced on January 1, 2015, Act No. 12753), however, the Korean translations submitted shall not be regarded as a specification, but a foreign language specification shall be deemed to be amended with the submission of the filed Korean translations, from the applicant's point of view.

Further, as Korean translations should be identical to a foreign language specification, new matter beyond the original disclosure of the foreign language specification shall be evaluated based on the Korean translations unless exceptional circumstances have occurred, and at the same time, introduction of new matter in the Korean translations shall also be evaluated based on the Korean translations. However, where any mistranslations in the Korean translations are corrected, a specification shall be able to be amended within the scope of the disclosure of the corrected Korean translations.

To clearly define scope of patent rights, a patent is granted after reviewing a Korean specification, and for understanding of the public, a patent application is laid open to public inspection in Korean. In this connection, only after the Korean translations being submitted, the applicant shall file a request for examination (Article 59(2) of the Patent Act), amend the specification (Article 47(5) of the Patent Act), file a divisional or a converted application (Article 52(1) of the Patent Act) and request early publication (Article 64(2) of the Patent Act).

1.4 Procedures to examine new matter introduced in a foreign language application

Examination for a foreign patent application (including the international patent application filed in a foreign language) is basically the same with the one for a regular patent application. However, either amendment to a specification and drawing(s) originally attached to the foreign language patent application or amendment based on the Korean translation has its limits resulted from the characteristics of the foreign language patent application, so introduction of new matter shall be evaluated as follows.

1.4.1 Where no correction of mistranslations is made

Where no correction of mistranslation is made, it shall be sufficient for the examiner to examine whether a specification and drawing(s) under examination are within the scope of the Korean translations, without examining whether the specification or drawing(s) amended according to the Korean translations is within the scope of the disclosure of the foreign language patent application, unless there are considerable events, such as the provision of any relevant information.

1.4.2 Where correction of mistranslations is made

Where a correction of mistranslations is made, the examiner shall closely examine whether an amendment to the specification under examination is made within the scope of the disclosure of the foreign language specification or corrected Korean translations. In other words, introduction of new matter in a specification and drawing(s) subject to examination shall be closely evaluated.

2. Introduction of new matter beyond the foreign language specification and beyond the Korean translations

2.1 Relevant provisions

Article 47 (Amendments to Patent Applications)

(2) An amendment to the specification or drawings under paragraph (1)

shall be made within the scope of the disclosure of the specification or drawings as originally filed. An amendment to a foreign language patent application shall be also made within the scope of the disclosures of the final Korean translation (referring to the corrected Korean translation, if any correction is made under the former part of Article 42-3 (6)) or of the drawings (excluding captions in the drawings) as originally filed.

Article 62 (Decision to Reject Patent Applications)

An examiner shall make a decision to reject a patent application if the patent application falls under any of the following grounds for rejection (hereinafter referred to as "grounds for rejection"):

5. If an amendment to the patent application exceeds the scope described in Article 47 (2);

Article 133 (Invalidation Trial of Patents)

(1) In any of the following cases, an interested party (in case of (ii), only a person entitled to a patent) or an examiner may file a petition for a trial to seek invalidation of a patent. In such cases, when the claim contains two or more claims, a petition for a trial for invalidation may be filed for each claim.

6. If an amendment exceeds the scope specified in the former part of Article 47 (2);

2.2 Proscription against the introduction of new matter beyond the Korean translations

To evaluate whether new matter is introduced in a specification and drawing(s) of the foreign language patent application (including an international patent application filed in a foreign language) shall basically be based on the scope of the disclosure of the Korean translations unless exceptional circumstances have occurred. Regarding special cases which require evaluating new matter based on a specification and drawing(s) of the foreign language specification, [2.3.4 a comparison between the original foreign language specification and the translation thereof] shall be referred

to. On the one hand, where the mistranslation is corrected, introduction of new matter shall be examined based on the Korean translations, but depending on appropriateness of correction of mistranslations, it shall be evaluated based on the foreign language specification.

Where an amendment to a specification or drawing(s) under examination does not comply with the requirements as provided in Article 47(2), in other words, where the amendment falls under any of the followings, it shall be considered to introduce new matter beyond the scope of the disclosure of and thus shall constitute grounds for rejection.

① Where a correction of mistranslations is not made: where any new matters, which go beyond the scope of the Korean translations as provided in Article 42(3)ii of the Patent Act, are introduced in a specification or drawing(s)

② Where a correction of mistranslations is made: where any new matters, which are disclosed in the final Korean translation, of which mistranslation has been corrected, are introduced in a specification or drawing(s)

However, where an amendment is made within the scope of disclosure of a foreign language specification but beyond the scope of the Korean translations, it shall constitute grounds for rejection but not grounds for invalidation.

2.2.1 Special handling of new matter in the Korean translations

Criteria for evaluating new matter according to Article 47(2) of the Patent Act shall be the same with the one for assessing a new matter for the regular amendment. Therefore, besides the explicit disclosure of the Korean translations, implicit or inherent disclosure of the Korean translations shall be treated as the 'disclosure of the Korean translation'.

Further, where mistranslation is corrected, introduction of new matter shall be evaluated based on the corrected Korean translations.

2.2.2 Applicant's response to a notice to proscription against the introduction of new matter in the Korean translations

Where rejection on the ground of the introduction of new matter beyond the

disclosure of the Korean translations, is issued, a patent applicant shall make a response to the rejection as follows:

- ① The applicant may submit a written argument stating that new matter is not introduced beyond the disclosure of the Korean translations. In this case, grounds of rejection shall be overcome if the examiner determines, by reviewing the written argument, it shall not constitute new matter.
- ② Just as in a regular patent application, a new matter in the Korean translations may be deleted by amending a specification and drawing(s).
- ③ As for new matter resulted from mistranslation of the Korean translations, correction of a mistranslation shall be submitted attaching any relevant documentary material, and the patent applicant shall argue that a new matter in the Korean translations shall be resolved by correction of the Korean translations.

2.3 Proscription against the introduction of new matter beyond the disclosure of the foreign language specification

2.3.1 Grounds for rejection/Grounds for invalidation

In a regular application, amendment to a specification shall be made within the scope of the contents of the original specification. If new matter can be freely introduced in the original specification even after the filing of the patent application, the effects of amendment can retroactively be applied to the filing date. So this shall be against the purport of the patent system where patentability shall be examined on the basis of the filing date.

Just as the same reason as above mentioned, in case of a foreign language patent application or international patent application filed in a foreign language, the introduction of new matter in the Korean translations beyond the disclosure of the foreign language specification submitted on the filing date or the specification and drawing(s) submitted as of the international filing date specification is not permitted or the introduction of new matter by an amendment to the specification under examination beyond the disclosure of the foreign language specification is prohibited. Such a 'new matter beyond the disclosure of the foreign language specification' constitutes grounds for rejection (Article 62(5) of the Patent Act) and

grounds for invalidation (Article 133(1)vi of the Patent Act), just as in the regular patent application.

The 'foreign language specification' of a 'new matter beyond the disclosure of the foreign language specification' as above mentioned means a 'foreign language specification or drawing(s) as originally filed', in case of foreign language patent application, and 'specification or drawing(s) of the international patent application filed as of the international filing date' as for foreign language international patent application.

2.3.2 Specific criteria for evaluating new matter beyond the foreign language specification

Criteria for evaluating new matter beyond the disclosure of the foreign language specification (including a foreign language international patent application) is the same with the one applied in a regular patent application. In other words, it shall be evaluated whether the matters described in the specification under examination are explicitly disclosed in the foreign language specification or implicitly or inherently disclosed in the foreign language specification.

Further, even if the Korean translations are filed by changing the order of the sentences in the foreign language specification and thus the specification is deemed to be amended as in the Korean translations, where new matter, which is not included in the foreign language specification, is not introduced in the specification, it shall not constitute new matter in the original text.

(Example 1) Case where new matter beyond the disclosure of the foreign language specification is not introduced

Although a foreign language specification includes embodiments 1 and 2, the specification under examination does not include embodiment 2.

(Example 2) Case which is deemed as new matter beyond the disclosure of the foreign language specification

[Ca] of a foreign language specification is mistranslated into [K or potassium]

(Explanation) As the foreign language specification only discloses [Ca], [K or

potassium] disclosed in a translated specification shall not be deemed to fall within the scope of matters described in the foreign language specification. Therefore it shall constitute new matter beyond the disclosure of the foreign language specification.

2.3.3 Examination of new matter in the original text

As for a foreign language patent application (including a foreign language international patent application), new matter in the amendment shall be examined based on the Korean translations. However, where it is doubtful of consistency between the foreign language specification and a specification for examination, both documents shall be compared each other. Where new matter is found beyond the disclosure of the foreign language specification, it shall constitute grounds for rejection.

Where new matter beyond the disclosure of the foreign language specification is found in a specification for examination, it shall constitute reasons for rejection and reasons for invalidation, but as taking into account

① Matters described in a foreign language specification are highly likely to be consistent with the ones of a specification submitted for examination

② Taking into consideration common skill in the relevant technical field and consistency with other descriptions in examining a specification submitted for examination, the examiner may find out inconsistency between the foreign language specification and the specification submitted for examination and does not have to compare the foreign language specification with the specification submitted for examination for every case. Therefore, the examiner shall have to evaluate proscription against the introduction of new matter as taking into account the foreign language specification mainly in the following cases:

2.3.4 Case where a foreign language specification needs to be compared with a specification submitted for examination

(1) Where such information is provided that a specification submitted for examination includes new matter beyond the disclosure of the foreign language specification, and there is a reasonable doubt that a specification

submitted for examination includes new matter beyond the disclosure of the foreign language specification from the review of the information.

Just as the following cases, where information on a patent application is provided or where information on introduction of new matter is acquired by reviewing written argument submitted by the applicant of the other application for a patent, which is deemed to be an prior-filed application of the same invention as provided in Article 29(3), (4) or Article 36, the examiner shall review the information and then if he/she determines that new matter, which is not disclosed in a foreign language specification, is included in a specification for examination, he/she shall issue a notice of grounds for rejection stating that amendment is made beyond the scope of the matters disclosed in the specification or drawing(s) originally attached to the written patent application.

(Example 1) Where the third parties provide information that new matter is introduced in a specification for examination, if the information is reasonable, a notice of grounds for rejection shall be issued, as the amendment is not in accordance with Article 47(2) of the Patent Act defining that an amendment to the specification or drawing(s) shall be made within the scope of the matters disclosed in the specification or drawing(s) originally attached to the written patent application.

(Example 2) Where the examiner issues a notice of grounds for rejection based on the Korean translations of the foreign language patent application in violation of patentability issue, i.e., enlarged novelty, but the applicant argues that such an invention is not disclosed in a foreign language specification (including the case that the examiner recognizes differences between the Korean translations of the foreign language patent application and the foreign language specification)

(2) Where the written argument of the international preliminary examination report of the international patent application describes new matter or where new matter is disclosed in the process of reviewing examination results of the family patent application

(Example) Where the written argument of the international preliminary

examination report of the PCT patent application describes new matter

3. Correction of mistranslation

3.1 Relevant provisions

Article 42-3 (Patent Applications in Foreign Language, etc.)

(5) If a patent applicant submits a Korean translation under paragraph (2) or another Korean translation under the main body of paragraph (3), the specification and drawings as originally filed in a foreign language shall be deemed amended according to the Korean translation: Provided, That if another Korean translation is submitted under the main body of paragraph (3), all amendments that shall otherwise be deemed to amend a specification and drawings according to Korean translations submitted prior to the latest Korean translation (hereafter referred to as "final Korean translation" in this Article and the latter part of Article 47 (2)) shall be deemed never made.

(6) A patent applicant may correct any error in the final Korean translation in the manner prescribed by Ordinance of the Ministry of Trade, Industry and Energy during the period set for amendments under Article 47 (1). In such cases, paragraph (5) shall not apply to the corrected Korean translation.

(7) Where a correction is made according to the first sentence of paragraph 6 within the period set forth under Article 47(1)(i) or (ii), all of the corrections done before the last one shall be deemed not to have been made.

Article 21(3) of the Administrative Instructions of the Patent Act (submission of the Korean translation of the foreign language patent application) ③ A person who has an intention of correcting errors of the Korean translation under Article 42(3)vi, shall submit a statement of correction of a mistranslation attaching relevant documents under the following

subparagraphs to the KIPO Commissioner and pay relevant fees according to the provisions of subparagraph 2 of Article 2(1)X relating to the payment of the national fee (hereinafter referred to as “payment provision”).

1. Statement of correction of a mistranslation
2. Power of Attorney as a patent agent is appointed

3.2 Requirements for correction of mistranslation

Where the Korean translation of the foreign language specification or drawing(s) described in a foreign language as originally attached to the patent application, is wrongly translated, a patent applicant shall correct mistranslations within a certain period of time as provided in Article 42(3) vi of the Patent Act.

However, even though the Korean translation is wrongly translated, if matters thereof can be obviously understood from the Korean translation, the mistranslation shall not have to be corrected.

On the one hand, to correct a mistranslation, a [statement of correction of a mistranslation] stating thereon shall be submitted attaching [documentary materials] describing reasons for correction. [Under paragraph 17(2) of the accompanying document to exceptional provisions]

The reason why the documentary materials are attached is ① to clarify that a mistranslation is corrected based on the foreign language specification ② to reduce burdens on the third parties or the examiner to compare the foreign language specification originally attached to the patent application and the amended documents and then to confirm appropriateness of the amendment.

Therefore, the documentary materials shall clearly describe ① the matters described in the foreign language specification originally attached to the patent application are comparable to the amendment, ② inappropriateness of the Korean translation before amendment, ③ appropriateness of the Korean translation after amendment (hereinafter referred to as ‘reasons for correction’), so that reasons for mistranslation shall be clarified, and at the same time, the person skilled in the art shall confirm correction of the

mistranslation is not beyond the matters described in the original foreign language patent application.

On the one hand, where a statement of correction of a mistranslation is not sufficiently described so that it is very hard to verify appropriateness of correction of mistranslation, amendment to the statement shall be ordered.

3.3 Effects of correction of mistranslation

(1) Criteria for evaluating permissible amendment to a specification

Where the Korean translation is corrected as it has mistranslation, introduction of new matter beyond the disclosure of the Korean translation shall be examined based on the corrected Korean documents (final version of the Korean translation).

(2) Correction of Korean translations made during the period for amending a specification or drawings is not given an amendment effect

Even though the Korean translation is corrected, the correction is not deemed to amend a specification for examination, but corrects mistranslations of the Korean translation. Further, the Korean translation, which is submitted under Article 42(3)ii, of the specification or drawing(s) in a foreign language originally attached to the patent application shall have the same effect with the amendment to the specification or drawing(s), but the corrected Korean translation due to mistranslation under Article 42(3)vi shall not have the same effect with the amendment to the specification or drawing(s).

Therefore, where the Korean translation has mistranslation, amendment to a specification for examination shall be made, irrespective of the correction of the Korean translation.

3.4 Evaluate the introduction of new matter where mistranslation is corrected

Where Korean translation is corrected, appropriateness of correction of mistranslation first shall be evaluated.

To evaluate appropriateness of correction of mistranslation, as taking into account a statement of correction of a mistranslation submitted by the

patent applicant, mistranslated portions of the foreign language specification shall be reviewed.

3.4.1 Examination Procedure

3.4.1.1 Cases where correction of mistranslation is reasonable

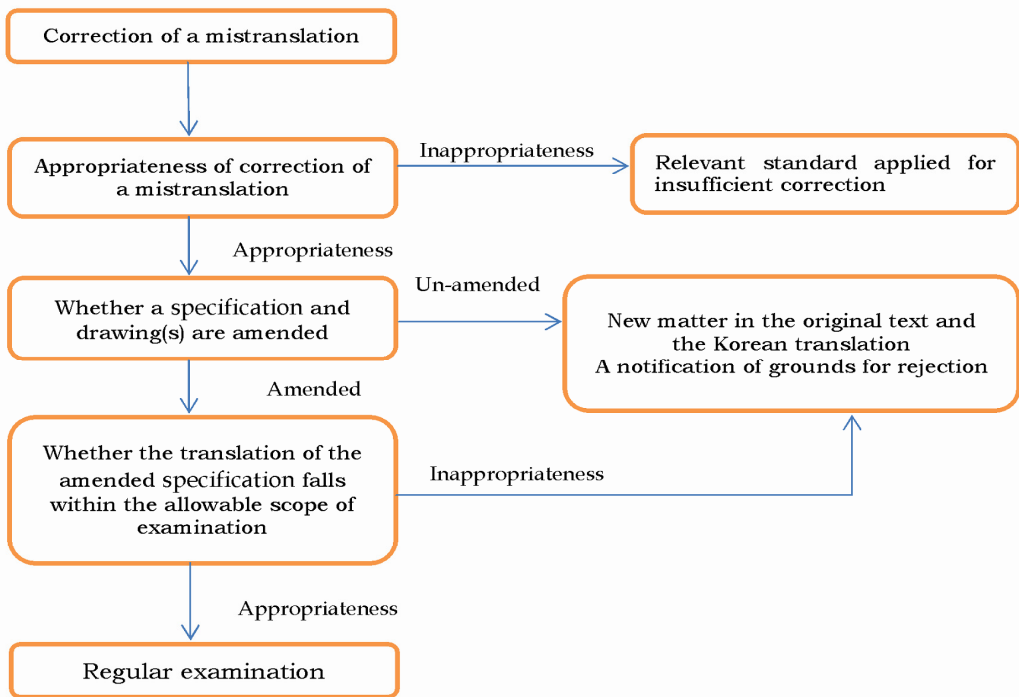
Where the corrected Korean translation sufficiently conforms to a foreign language specification as correction of mistranslation is confirmed to be reasonable, it shall be examined whether a specification for examination is amended within the scope of matters described in the corrected Korean translation. Specifically, examination process thereof is different as follows, depending on whether a specification for examination is amended or not;

① Where a specification for examination is not amended

As a specification for examination is the same with the Korean translation before its amendment, a notification of grounds for rejection shall be issued in violation of introduction of new matter beyond the disclosure of the foreign language specification and the Korean translation,

② Where a specification for examination is amended

Where a specification for examination is amended within the scope of matters described in the Korean translation, which is corrected to conform to the foreign language specification, as the specification concerned satisfies a requirement for falling within the scope of matters described in the foreign language specification and the Korean translation, the regular examination process shall be carried on thereon. However, where the amendment is beyond the scope of matters described in the corrected Korean translation, as new matter is highly likely to be introduced in the foreign language specification and the Korean translation in general, grounds for rejection thereof shall be closely reviewed.



3.4.1.2 Where correction of mistranslation is unreasonable

Where mistranslation is improperly corrected so that corrected Korean translation does not conform to a foreign language specification, examination thereof is different depending on whether a specification is amended or not.

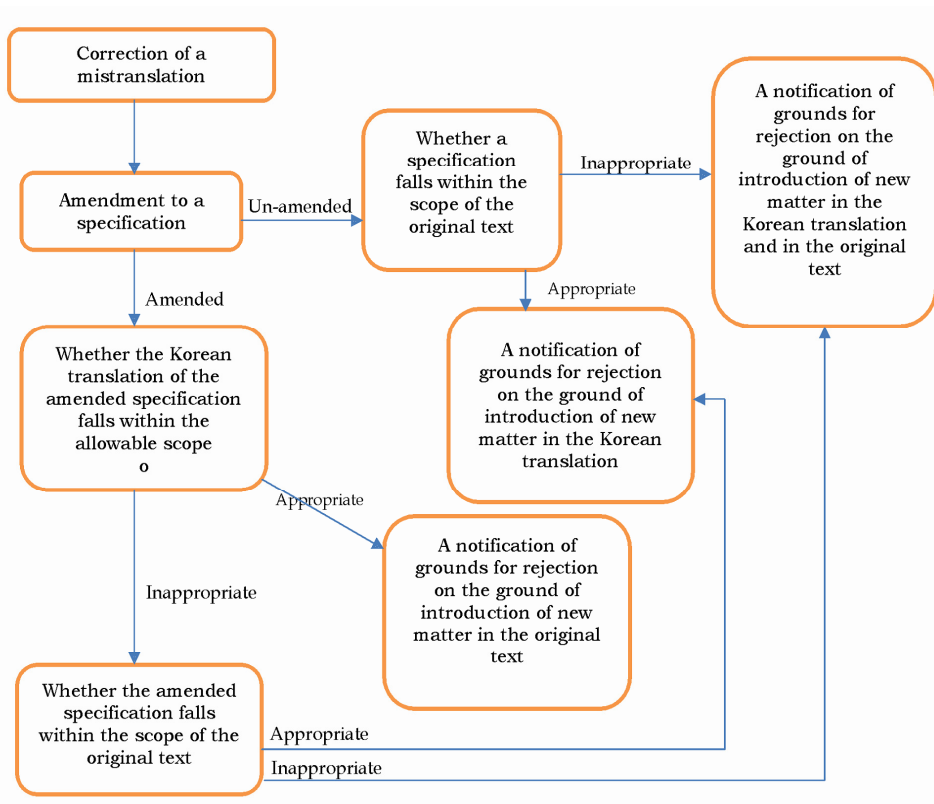
① Where a specification for examination is not amended

Where a specification for examination is not amended so it is identical with the un-corrected Korean translation, the specification for examination is not likely to fall within the scope of corrected Korean translation. Therefore, a notice of grounds for rejection shall be issued on the ground that the specification for examination does not fall within the scope of the Korean translation or original foreign language patent application.

On the one hand, in case of unnecessary correction of Korean translation, as the specification for examination is likely to fall within the scope of the original foreign language patent application, rejection shall be issued only on the ground of introduction of new matter beyond the disclosure of the Korean translation.

② Where a specification for examination is amended

Where a specification for examination is amended based on correction of mistranslation, the amended specification for examination is not likely to fall within the scope of the original foreign language patent application, thus a rejection shall be issued on the ground of introduction of new matter beyond the original foreign language patent application.



On the one hand, where the amended specification for examination is different from correction of mistranslation but falls within the scope of the original foreign language patent application, a rejection shall be issued only on the ground of amendment beyond the Korean translation, and where the amended specification for examination is different from correction of mistranslation and from the foreign language specification, a rejection shall be issued based on introduction of new matter beyond the foreign language specification and the Korean translation.

3.4.2 Amendment beyond the scope of matters described in the foreign language specification or the Korean translations

3.4.2.1 Proscription of introduction of new matter beyond the foreign language specification

(1) Where the Korean translations is corrected and a specification for examination is amended accordingly, but a specification for examination is still beyond the scope of the foreign language specification as mistranslation is improperly corrected, a rejection shall be issued on the ground of introduction of new matter beyond the foreign language specification. On the one hand, amendment shall not be separately ordered to wrong correction of mistranslation.

(Examination) ① a foreign language specification as of the filing (A), ② the specification shall be deemed to be amended (A->B) after submission of the Korean translations (B), ③ the Korean translations are corrected (B->C), ④ the specification is amended (B->C)

	Foreign language application	Submission of Korean translations	Correction of the Korean translations	Amendment to the specification for examination
Specification	A	B	-	C
Korean translations	-	B	C	-

(Explanation) Where a specification for examination and the Korean translations are amended and corrected to C through a regular amendment or correction of mistranslation because the Korean translations (B) do not conform to the foreign language specification (A),, it constitutes introduction of new matter beyond the foreign language specification as a specification for examination (C) is beyond the scope of the foreign language specification (A).

(2) Where there are no errors in the Korean translation but a specification for examination is amended based on the wrong correction, so that a specification for examination is beyond the scope of the foreign language specification, a rejection shall be issued on the ground of introduction of

new matter beyond the foreign language specification.

(Example) ① a foreign language specification as of the filing (A), ② the specification is deemed to be amended after submission of the Korean translation (A->A), ③ the Korean translations are corrected (A->B), ④ a specification is amended (A->B)

	Foreign language application	Submission of Korean translations	Correction of the Korean translations	Amendment to the specification for examination
Specification	A	A	-	B
Korean translations	-	A	B	-

3.4.2.2 Proscription of introduction of new matter beyond the Korean translation

Where there were no errors in the Korean translations but the Korean translations have become different from the foreign language specification due to unnecessary and irrelevant correction, a rejection shall be issued on the ground of introduction of new matter beyond the Korean translation.

(Example) ① a foreign language patent application as of the filing (A), ② the specification is deemed to be amended after submission of the Korean translation (A->A), ③ the Korean translations are corrected (A->B), ④ the specification is un-amended

	Foreign language application	Submission of Korean translations	Correction of the Korean translations	Amendment to the specification for examination
Specification	A	A	-	A
Korean translations	-	A	B	-

3.4.2.3 Proscription of introduction of new matter beyond the foreign language specification and the Korean translations

Where a specification for examination are amended and errors in the Korean translations are corrected as the Korean translations are different from the foreign language specification due to mistranslation, but the

correction is still different from the foreign language specification and a specification for examination are amended beyond the scope of corrected Korean translations and the foreign language specification, a rejection shall be issued on the ground of introduction of new matter beyond the foreign language specification and the Korean translations as the amendment is beyond the scope of the Korean translations and the foreign language specification.

(Example) ① foreign language specification as of the filing (A), ② the specification is deemed to be amended after submission of the Korean translations (A->B), ③ the Korean translations are corrected (B->C), ④ a specification is amended (B->D)

	Foreign language application	Submission of Korean translations	Correction of the Korean translations	Amendment to the specification for examination
Specification	A	B	-	D
Korean translations	-	B	C	-

(Explanation) As a specification for examination (D) is beyond the corrected Korean translations (C) and the foreign language specification (A), it shall constitute new matter beyond the foreign language specification and the Korean translations. The patent applicant shall need to resolve rejection on the ground of proscription of introduction of new matter beyond the foreign language specification and the Korean translations by correcting wrong correction of mistranslation (C->A) and amending a specification for examination accordingly (D->A).

3.5 Considerations as evaluating correction of a mistranslation

(1) Where a mistranslation is corrected, appropriateness and inappropriateness thereof shall not constitute reasons for rejection or reasons for amendment.

(2) Where documentary materials accompanied by a statement of correction of a mistranslation do not explain reasons for correction or where reasons

for correction are not sufficiently described so that appropriateness of correction of a mistranslation is hard to evaluate, amendment shall be ordered on the ground of insufficient reasons for correction, and the appropriateness of correction of incorrect translation shall be evaluated after translation errors are resolved through amendment.

On the one hand, where amendment cannot relieve insufficient reasons for correction, correction of mistranslations itself shall be invalidated.

(Example 1) It is argued that there are errors in the mistranslation, but there is no objective explanation why translation before amendment is unreasonable and why translation after amendment is reasonable

(Example 2) It is argued that mistranslation is resulted from errors in interpretation of context or of common general knowledge, but reasons for correction are not sufficiently described.

4. Considerations for a foreign language application

4.1 A foreign language application as prior art

4.1.1 Where a foreign language specification is searched as prior art

Where a foreign language application or official gazette thereof is searched as prior art to assess patentability issues, such as novelty and enlarged concept of novelty, as the foreign language specification and Korean translations thereof are generally identical, it is sufficiently enough only to search the Korean translations; provided, however, that where it is doubtful that the Korean translations are different from a foreign language specification, the scope of search shall have to be expanded to the specification of the foreign language patent application.

4.1.2 Considerations in reviewing enlarged concept of novelty and first-to-file rule

4.1.2.1 The scope of review

Where a foreign language patent application (including a foreign language international patent application filed on and after January 1, 2015) serves as prior art for enlarged concept of novelty, as prior art effect can be

generated on the basis of the foreign language specification, the foreign language specification should finally be reviewed even though search may be based on the Korean specification, which have been laid open to public inspection.

4.1.2.2 A method stating a notice of grounds for rejection

Where a foreign language patent application is cited as “prior art for enlarged concept of novelty”, a notice of grounds for rejection shall be stated in such a way that the foreign language specification corresponding to the Korean specification constitute reasons for rejection, with reference to the Korean specification (which are amended based on the Korean translations), which have already been laid open to public inspection.

4.1.2.3 Examiner’s response to the applicant’s arguments

Where a notice of grounds for rejection is issued based on a foreign language patent application on the ground that the foreign language patent application serves as “prior art for enlarged concept of novelty”, if the applicant can argue against and deny the examiner’s rejection that the invention under examination is not disclosed in the foreign language specification, reasons for rejection thereof shall be overcome.

Where new matter is found in the foreign language application of which is pending, a notice of grounds for rejection shall be issued to the application concerned on the ground of introduction of new matter.

4.1.3 Treatment of first-to-file rule under Article 36 of the Patent Act Concerning Foreign language patent application

Where an invention claimed in the prior-filed application or the other application filed on the same date includes new matter beyond the foreign language specification, the claimed invention cannot be relied on in issuing a rejection based on Article 36(1)-(3) of the Patent Act. New matter introduced in a prior-filed application claim cannot be a bar to a later application. Same thing shall be applied to a foreign language patent application to conform to the first-to-file rule.

4.2 Examiner's approach to special applications

4.2.1 Basic Concept

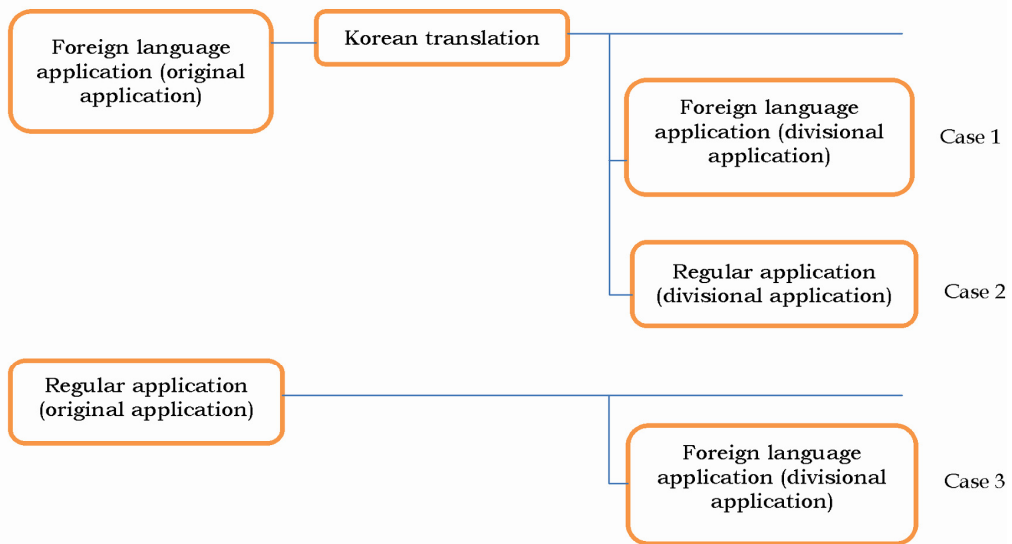
As a foreign language application is considered as a regular domestic application, the divisional application, the converted application or the application with domestic priority claim shall be permitted accordingly. Further, as the divisional application, the converted application or the application with domestic priority claim are applications so these are not different from regular applications, foreign language applications thereof are permitted just as a regular application.

As the filing date of a divisional application and a converted application is accorded retroactively to the filing date of a parent application, where the parent application is a foreign language application, the requirements for division or conversion shall be evaluated based on a foreign language specification, not on Korean translations of the parent application. In other words, as a divisional application and a converted application to which new matter is introduced beyond the disclosure of the foreign language specification of the parent application do not satisfy requirements for divisional and converted applications, filing date thereof shall not be retroactively accorded to the filing date of the parent application. Further, as for the application with domestic priority claim to a foreign language application, as the original specification of a prior-filed application is a foreign language specification, a domestic priority right shall be generated on the basis of a foreign language specification of the prior-filed application; provided, however, that as the disclosure of a foreign language specification are highly likely to coincide with Korean translations thereof, the examiner may depend on the Korean translations of an parent application (or a prior-filed application) in determining whether the filing date should be retroactively accorded to the filing date of a parent application.

4.2.2 Divisional application

4.2.2.1 Cases of divisional application

Cases of a divisional application based on a foreign language patent application are as follows:



4.2.2.2 Examination practice

(1) Where a parent application is a foreign language application (Cases 1 and 2)

Regarding a substantive requirement of a divisional application that the division application should be made within the scope of the matters described in a specification or drawing(s) originally attached to the specification of an parent application, the aforementioned scope is the one of the disclosure of the foreign language specification. By the way, as it is highly probable that a foreign language specification coincides with Korean translations thereof, in evaluating the requirements concerned, the Korean translations of a parent application shall be compared with a specification of a divisional application.

(2) Where a divisional application is a foreign language application (Cases 1 and 3)

① a specification deemed amended according to the Korean translations, rather than the foreign language specification or subsequently amended specification for examination shall be compared with a specification of an parent application and the examiner determines whether substantive requirements of a divisional application are satisfied. On the one hand,

proscription of introduction of new matter is separately evaluated by comparing a foreign language specification of a divisional application and the amended specification for examination.

② Even though a specification of a divisional application does not satisfy requirements of a divisional application, if any defects are rectified through amendment based on the Korean translations and the subsequent amendment, it shall be deemed to be a legitimate divisional application.

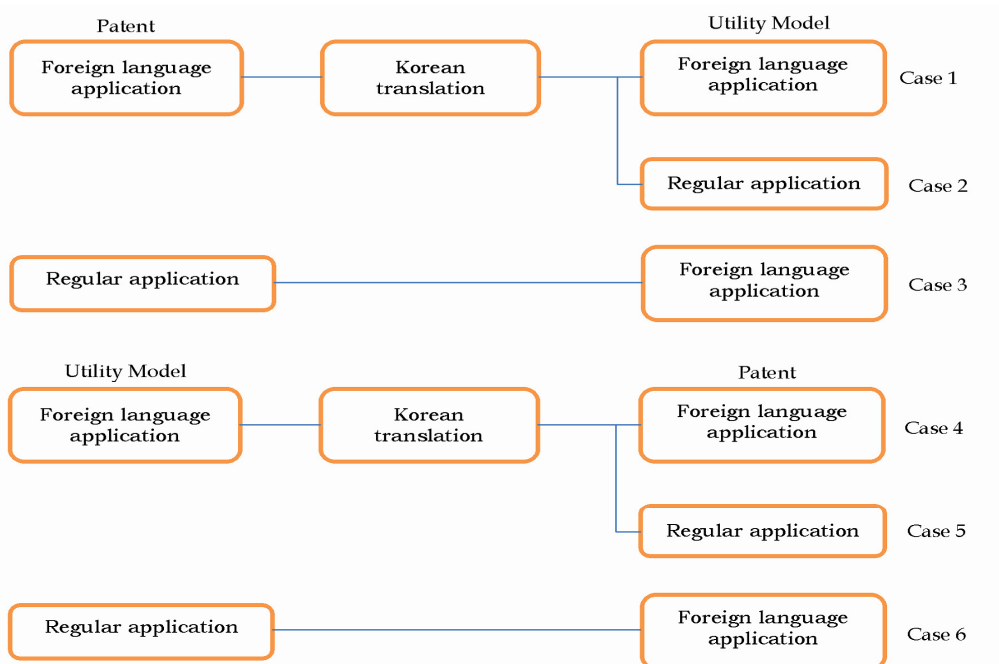
4.2.2.3 Period during which a divisional application can be filed

Where the parent application of a divisional application is a foreign language application, even though a divisional application based on a foreign language application is permitted within the same time frame applied for a regular application, a divisional application cannot be permitted before the submission of the Korean translations of a parent application.

4.2.3 Converted application

4.2.3.1 Cases of a converted application

Cases of a converted application based on a foreign language application are as follows:



4.2.3.2 Examination practice

(1) Where an original application is a foreign language application (Cases 1, 2, 4 and 5)

① A converted application shall be fall within the scope of the matters described in a specification of an original application, but where Korean translations thereof have been submitted, as it is highly probable that a specification and drawing(s) of an original application coincide with Korean translations thereof, in evaluating substantive requirements of a converted application, the Korean translations of an original application shall be compared with a specification and drawing(s) of a converted application.

② A converted application cannot be filed before submission of the Korean translations of an original application.

(2) Where a converted application is a foreign language application (Cases 1, 3, 4 and 6)

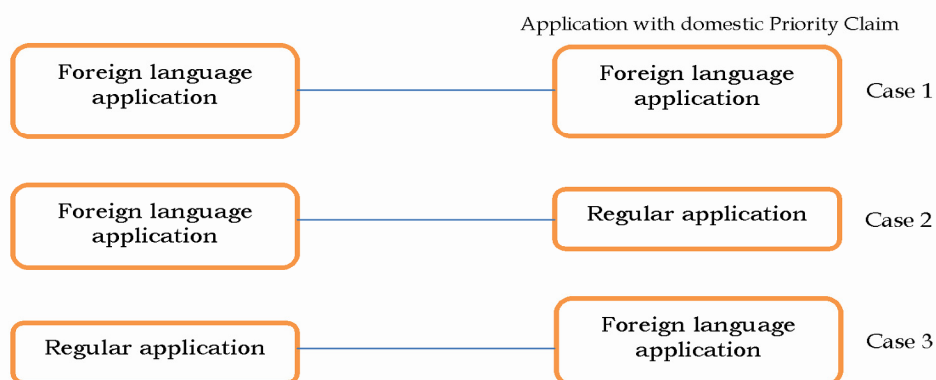
① As for a specification amended based on the Korean translations, not based a foreign language specification or subsequently amended description for examination, it shall be compared with a specification of an original application thus determining whether substantive requirements of a converted application are satisfied. Otherwise the examination process concerned shall be the same with the one for other foreign language applications. On the one hand, proscription of introduction of new matter is separately evaluated in a way of comparing a specification of a converted application and the amended specification.

② Even though a specification of a converted application does not satisfy requirements of a converted application, if any defects are rectified through amendment based on the Korean translations and the subsequent amendment, it shall be deemed to be a legitimate divisional application.

4.2.4 Application with Domestic Priority Claim

4.2.4.1 Cases of an application with domestic priority claim

Cases of application with domestic priority claim to a foreign language application are as follows:



4.2.4.2 Examination practice

(1) Cases 1 and 2

Even though domestic priority can be claimed within the scope of the matters described in a specification and drawing(s) of a prior-filed application, if Korean translations thereof have already been filed, it shall be highly probable that a specification and drawing(s) of a prior-filed application coincide with Korean translations thereof, so that effects of an application with domestic priority claim shall be evaluated in a way of comparing the Korean translations of a prior-filed application and a specification and drawing(s) of the application claiming domestic priority; provided, however, where the Korean translations of a prior-filed application are yet filed as the application claiming domestic priority is filed before submission of the Korean translations, effects of an application with domestic priority claim shall be evaluated by comparing a specification and drawing(s) of a prior-filed application and the ones of the application claiming domestic priority.

(2) Cases 1 and 3

Effects of an application with domestic priority claim shall be evaluated by comparing a specification and drawing(s) of a prior-filed application and the ones of the foreign language application claiming domestic priority, and otherwise the examination process concerned shall be the same with the one for other foreign language applications.

4.3 International patent application filed in a foreign language

International patent application filed in a foreign language shall be basically handled identically with a foreign language patent application. Further, international patent application shall also be permitted to correct mistranslation based on a specification and drawing(s) filed on the international filing date.

The international patent application filed in a foreign language shall also be invalidated or rejected on the ground of introduction of new matter in an original text, and the determination shall be based on a specification submitted until the international filing date.

Part VI. SPECIAL APPLICATIONS

Chapter 1. Divisional Application

1. Article 52 of the Patent Act

Article 52 (Divisional Patent Applications)

(1) An applicant who has filed a patent application for two or more inventions may divide a portion of the inventions into one or more applications within the scope of the disclosure of the original specification or drawings of the patent application, within either of the following periods: Provided, That if the patent application has been filed in a foreign language, it may be divided only when the Korean translation of the patent application pursuant Article 42-3 (2) has been submitted:

1. A period during which amendments can be made under Article 47 (1);
2. A period not exceeding 30 days from the date when a certified copy of the decision to reject an application for a patent is served (referring to an extended period, if the period specified in Article 132-17 has been extended under Article 15 (1));
3. A period of not more than three months from the date when the certified copy of a written decision to grant a patent under Article 66 or the certified copy of a trial decision to revoke the decision to reject a patent application under Article 176 (1) (limited to a trial decision which grant a patent registration and including a retrial decision) is served: Provided, That the period shall end on the day when the patent registration is made under Article 79 if the date of the registration falls within three months from the date when the certified copies are served.

(2) A patent application divided under paragraph (1) (hereinafter referred to as "divisional application") shall be deemed filed at the time the parent patent application was filed: provided, however, that a divisional application shall be deemed filed at the time the divisional application is filed in any of the following cases:

1. Where the divisional application constitutes another patent application referred to in Article 29 (3) of this Act or a patent application referred to in

Article 4 (4) of the Utility Model Act, and Article 29 (3) of this Act or Article 4 (4) of the Utility Model Act shall apply to the divisional application;

2. Where Article 30 (2) applies to the divisional application;
3. Where Article 54 (3) applies to the divisional application;
4. Where Article 55 (2) applies to the divisional application.

(3) A person who intends to file a divisional application under paragraph (1) shall state his/her intention and indicate the parent patent application in the divisional patent applications.

(4) A person who claims priority under Article 54 for a divisional application may submit the documents specified in paragraph (4) of the aforesaid Article to the Commissioner of the Korean Intellectual Property Office within three months from the filing date of the divisional application, even after the expiration of the period specified in paragraph (5) of the aforesaid Article.

(5) If a divisional application is filed in a foreign language, the patent applicant can submit a Korean translation under Article 42-3 (2) or another Korean translation referred to in the main body of Article 42-3 (3) by not later than 30 days from the filing date of the divisional application, even after the expiration of the period specified in paragraph (2) of the aforesaid Article: Provided, That another Korean translation is not allowed in cases specified in any subparagraph of Article 42-3 (3).

(6) If an original specification of a divisional application does not include the claims, the applicant may make an amendment to state the claims in the specification by not later than 30 days from the filing date of the divisional application, even after the expiration of the period specified in Article 42-2 (2).

2. Purport

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 'parent application'). A divisional application shall be deemed to have been filed at the filing time of the parent 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 parent 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 parent application.

The following requirements shall be met in order to be recognized that the applicant of the parent 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.

Filing Date	Patent Application	Utility Model Registration Application
'99.7.1 '01.7.1	<p>① Within one year and three months from the filing date of the parent application (the earliest filing date in case of priority claim)</p> <p>② After one year and three months from the filing date of the parent application, but no later than the service of a certified copy of decision to grant a patent</p> <ul style="list-style-type: none"> · In case of examination request · Within three months from the date of the examination notice in case of third parties' request for examination <p>· Within the period for submission of written arguments</p> <p>· Within thirty days from the date of filing a notice of an appeal against decision to reject</p>	<p>① Within one year and three months from the filing date of the parent application (the earliest filing date in case of priority claim)</p> <p>② After one year and three months from the filing date of the parent application, but no later than the service of a certified copy of decision to register a utility model</p> <ul style="list-style-type: none"> · In case of examination request · Within three months from the date of the examination notice in case of third parties' request for examination <p>· Within the period for submission of written arguments</p> <p>· Within thirty days from the date of filing a notice of an appeal against decision to reject</p>
'06.10.1	<p>① Before the service of a certified copy of decision to grant a patent, but, only during the prescribed periods in case of ② and ③</p> <p>② Within the period for submission of the concerned written argument in case of receipt of notice of grounds for</p>	<p>Within the periods of amendment prescribed in the provisos of Article 12(2) and Article 13(1) of the Utility Model Act as follows:</p> <p>① Within two months from the filing date of utility model registration application</p> <p>② Amendment period by an examiner's amendment request specified under Article 12(2) of the Utility Model Act (amendment period by KIPO commissioner's amendment</p>

<p>'09.7.1</p> <p>'15.1.1</p>	<p>rejection ③Within thirty days from the submission date of a notice of an appeal against decision to reject</p>	<p>request if an application was filed between July 1, 1999 and June 30, 2001)</p> <p>①Before the service 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 submission date of a notice of an appeal against decision to reject</p>
<p>①Before service 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 to reject after the service of a certified copy of decision to reject</p>		
<p>①Before service 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 ④ Within thirty days from the service of a certified copy of decision to reject(in case the period for filing an appeal to decision to reject is extend, within the extend period)</p>		
<p>During the period of three months (yet, prior to the patent registration) after the date of receiving a certified copy of decision to grant a patent on or after 29 July 2015.</p>		

(2) The parent 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 parent application has been invalidated, withdrawn or abandoned or the decision to reject the parent application has become final and binding, a divisional application shall not be able to be filed.

Where a division application is filed on the day when the procedure regarding the parent application has been terminated because the parent application has been withdrawn or abandoned, the divisional application shall be treated to have been filed when the parent application was pending before KIPO. It is because that if a divisional application is filed on the same day when the procedure of the parent application is terminated, it would be difficult to distinguish which proceeding is conducted first. Also, it would be reasonable to think that the proceeding for the divisional application is conducted in the applicant's awareness of the fact that the parent 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 original specification or drawing(s) of the parent 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 parent application. If even a single invention among the inventions of the divisional application is not contained in the parent application, the divisional application shall be deemed to be invalid or have grounds for rejection.

To figure out whether an invention of a divisional application is disclosed in the original specification or drawing(s) of the parent application, the examiner shall determine whether the invention in the divisional application is explicitly described in the original specification or drawing(s) of the parent application or whether the invention is obviously recognized to have been implicitly described . 「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 divisional application is the specification or drawing(s) originally attached to the parent application. Therefore, even though an invention described in the specification or drawing(s) originally attached to the parent 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 parent application through amendments is not eligible for the divisional application since it was not disclosed in the specification or drawing(s) originally attached to the parent application in the first place.

(3) When a divisional application is filed, the divisional application is deemed to have been filed when the parent application was filed. Therefore, if inventions disclosed in the claims of the divisional application are the same as those in the parent 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 parent or divisional application.

4. Procedure of Divisional Application

(1) A divisional application shall be filed 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 divisional application shall state the purport of the division and indicate the parent application which forms the basis of division.

If the parent 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 parent application by amending the indication of the parent 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 parent application to differentiate the invention described in the claims of the parent application from the claims of the divisional application. However, the parent application need not be amended if inventions described in the claims of a divisional application are disclosed only in the description of the invention or drawing(s) in the parent application.

(3) If a claim regarding disclosure exception or a 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 disclosure exception or within three months as for the application claiming priority). Where a claim for disclosure exception or a priority claim was not made at the time of filing the parent application, such claims shall not be recognized at the filing time of the divisional application. However, even when the purport of a claim regarding disclosure exception or a priority claim was set forth in the parent application, but the evidential documents were not submitted within the statutory period, if the applicant states the purport of a claim for disclosure exception or a priority claim in the divisional application and submitted the evidential documents by the prescribed date from the filing date of the divisional application, the claims shall be deemed to be legitimate (except for when the claim for disclosure exception or priority claim of the parent 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 parent application which have been already submitted since the contents of the evidential documents of both parent and divisional applications are identical, the applicant can substitute for the submission of the divisional application by stating the purport of using the parent application in the attached documents of the form.

If the evidential documents were submitted at the filing time of the parent application, and if the documents contained the same claim for disclosure exception or priority claim in a divisional application as in the parent application, it is deemed that the applicant has an intention of referring to the evidential documents of the parent application when filing the divisional application. However, Article 10(2) in the Enforcement Rules of the Patent Act stipulates that the intention of reference be stated. Therefore, if the evidential documents were not submitted and the intention of referring to the evidential documents of the parent 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 parent 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 disclosed in the specification or drawing(s) originally attached to the parent application.

However, new subject matter could be added to the specification or drawing(s) of the divisional application. It would be unfair to let the divisional application enjoy the benefit of the parent application for the new subject matter added thereto. Therefore, a divisional application shall not take the filing date of the parent 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 30(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-filed 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 parent 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 pendency of the parent application, it shall be deemed to be in violation of Article 11(1)(7) or (11) and the examiner shall give an opportunity to 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 a divisional application are allowed as long as the divisional application is pending. However, such amendments shall be limited to correcting obvious errors or deficiencies. Amendments for changing the contents of the divisional application 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 filing date as follows.

① Where the parent application was filed before September 30, 2006

Where a divisional application was filed for an invention not described in the parent application, the examiner shall issue a preliminary 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 parent application can be utilized as a prior art reference 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 parent application (whether a divisional application has been accepted or not), both the preliminary notice for inadmissible division and the notice of grounds for rejection can be simultaneously issued in the separate forms.

Meanwhile, where an invention not described in the parent application is deleted through 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 based on the filing date of the parent application.

(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 service of a notice for inadmissible division.

②Where the parent application was filed on or after October 1, 2006

When a divisional application was filed for an invention not described in the parent 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 a regular application and assess permissibility of amendments. In such a

case, the specification or drawing(s) originally 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 original 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 parent application, but excluded from the specification or drawing(s) originally attached to the divisional application.

(2) A divisional application may claim a priority under the Treaty or claim a Domestic Priority. In the example below, even when an application of No.④ claims benefits of earlier filing dates of the prior-filed applications of No.①, ③ filed in Korea and of the application of No.② filed in the first country, the divisional application of No.⑤ based on an application of No.④ shall be accepted. In such a case, the divisional application of No.⑤ shall retroactively retain the filing date of the application of No.④, but the reference date to determine patentability shall be decided based on the filing date of the prior-filed application involving the concerned invention. In other words, the reference date for Invention B is the filing date of No.② and the reference date for Invention C is the filing date of the prior-filed application of No.③. Also, the reference date for Invention D added at the time of filing the application of No.④ has the same filing date as the application of No.④.

(Note) When the same invention is described in the application of No.④ and the divisional application of No.⑤, Article 36(2) of the Patent Act shall apply.

(3) Where the parent 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

parent 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.

(4) A divisional application shall not be filed based on multiple parent applications. However, a divisional application can be filed based on a parent application claiming domestic priorities from two or more prior-filed applications.

(5) When examining a divisional application from the parent application which receives a certified copy of decision to grant a patent on or after 29 July 2015, the examiner should note the following:

① In case an applicant does not request a trial for correction of the parent application when filing a divisional application for the invention disclosed only in the description of the invention of the parent application, or for the invention recited in the claims of the parent application, examiners should note whether the claimed inventions of the divisional application is identical to the those of the parent application. If so, examiners are supposed to inform an applicant of a conflicting application when sending a notice for rejection.

② In case an applicant divides a portion of invention described in the granted parent application with requesting a trial for correction, an examination of a divisional application should be deferred until the trial for correction concludes. (See Article 3 '8. Deferral of examination or extension of examination proceedings' of Chapter 5)

Chapter 2. Converted Application

1. Article 53 of the Patent Act

Article 53 (Conversion of Applications)

(1) An applicant who filed an application for registration of a utility model may convert the application for registration of the utility model into a patent application within the scope of the disclosure in the original specification or drawings of the application for registration of the utility model: provided, however, that the foregoing shall not apply in the following cases:

1. Where 30 days (referring to an extension, if the period specified in Article 132-17 has been extended under Article 15 (1), which shall apply mutatis mutandis pursuant to Article 3 of the Utility Model Act) have passed from the date when a certified copy of the decision to reject the application for registration of the utility model was served for the first time;
2. Where the application for registration of the utility model has been filed in a foreign language under Article 8-3 (2) of the Utility Model Act, and its Korean translation required under the aforesaid paragraph had not been submitted upon filing a converted application.

(2) An application converted into a patent application under paragraph (1) (hereinafter referred to as "converted application") shall be deemed filed at the time the application for registration of the utility model was filed: provided, however, that the foregoing shall not apply in the following cases:

1. Where Article 29 (3) of this Act or Article 4 (4) of the Utility Model Act applies to the converted application as it constitutes another patent application referred to in Article 29 (3) of this Act, or a patent application under Article 4 (4) of the Utility Model Act;
2. Where Article 30 (2) applies to the converted application;
3. Where Article 54 (3) applies to the converted application;
4. Where Article 55 (2) applies to the converted application.

(3) A person who intends to file a converted application under paragraph

(1) shall state his/her intention and indicate the application for registration of the utility model to be converted in the patent application.

(4) When a converted application is filed, the application for registration of the utility model shall be deemed withdrawn.

(5) Deleted.

(6) A person who claims priority under Article 54 for a converted application may submit the documents specified in paragraph (4) of the aforesaid Article to the Commissioner of the Korean Intellectual Property Office within three months from the filing date of the converted application, even after the expiration of the period specified in paragraph (5) of the aforesaid Article.

(7) If a converted application is filed in a foreign language, the patent applicant can submit its Korean translation under Article 42-3 (2) or another Korean translation referred in the main body of Article 42-3 (3) by not later than 30 days from the filing date of the converted application, even after the expiration of the period specified in paragraph (2) of the aforesaid Article: Provided, That another Korean translation is not allowed in cases specified in any subparagraph of Article 42-3 (3).

(8) If the original specification of a converted patent application does not include the claims, the patent applicant may make an amendment to state the claims in the specification by not later than 30 days from the filing date of the converted application, even after the expiration of the period specified in Article 42-2 (2).

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 to reject (within the extended period when the period prescribed in the proviso of *Mutatis Mutandis* application of Article 33 of the Utility Model Act or Article 132(17) 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 earlier or later 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 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 original 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 original 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) originally 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.

(2) Where an applicant intends to file a converted application claiming disclosure exceptions 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 disclosure exception, 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 disclosure exception or priority has not been made at the time of filing the original application (The above does not apply to an application which is converted from the original application filed on or after 29 July 2015). However, even though the purpose of claims for disclosure exception 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 disclosure exception or priority and the concerned evidential documents are submitted until the prescribed date from the filing date of the converted application, the claim for disclosure exception or priority shall be deemed to be legitimate (except for where the procedure of the disclosure exception 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 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 first country 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 prior-filed 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.

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 preliminary 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 preliminary 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 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 service 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 make 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 original 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 original 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 drawing(s) of the original application, but not described in the original 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 converted application shall not be filed based on multiple original applications. However, it shall be possible to file a converted application after an application claiming Domestic Priority has been filed on the basis on two or more prior-filed applications.

(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.

Chapter 3. Application with Priority Claim under the Treaty

1. Article 54 of the Patent Act

Article 54 (Priority Claims Under Treaty)

(1) Where any of the following applies under a treaty, the filing date of a patent application in the contracting state of the treaty shall be deemed the filing date of the patent application in the Republic of Korea for purposes of Article 29 or 36:

1. Where a citizen of a contracting state that recognizes the priority right of a patent application for citizens of the Republic of Korea files a patent application for an invention after filing a patent application in the contracting state or in another contracting state for the same invention and claims priority;

2. Where a citizen of the Republic of Korea files a patent application in the Republic of Korea after filing a patent application for the same invention in a contracting state that recognizes the priority of a patent application for citizens of the Republic of Korea and claims priority.

(2) A person who intends to claim priority under paragraph (1) shall file a patent application within one year from the filing date of the first application which forms the basis of the priority claim is based.

(3) A person who intends to claim priority under paragraph (1) shall state in the patent application his/her intention, the name of the state in which the first application was filed, and the filing date of the first application.

(4) A person who claims priority under paragraph (3) shall submit the documents specified in subparagraph 1 or the written statement specified in subparagraph 2 to the Commissioner of the Korean Intellectual Property Office: Provided, That the written statement specified in subparagraph 2 may be submitted only for the states specified by Ordinance of the Ministry of Trade, Industry and Energy:

1. A written statement stating the filing date of the first patent application, certified copies of the specification and drawings of the relevant invention, which have been certified by the government of the state in which the first application was filed;

2. A written statement stating matters specified by Ordinance of the Ministry of Trade, Industry and Energy such as the application number of the patent application firstly filed in the state and the information which confirms the filing of the first application.

(5) Documents or written statements referred to in paragraph (4) shall be submitted within one year and four months from the earliest among the following dates:

1. The filing date of the first application in a contracting state of a treaty;
2. The filing date of the application on which the priority claim is based, where a patent application contains a priority claim under Article 55 (1);
3. The filing date of the application on which the priority claim is based, where a patent application contains a priority claim under paragraph (3).

(6) If a person who claims priority under paragraph (3) fails to submit the documents required under paragraph (4) within the period specified in paragraph (5), the priority claim shall become void.

(7) A person who claims priority under paragraph (1) and meets the requirements under paragraph (2) may amend or add a priority claim within one year and four months from the earliest date specified in paragraph (5).

2. Purport

Priority claim under the Treaty is designed to recognize the filing date in the contracting State of 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 contracting State of 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 contracting State of the treaty or another contracting State of 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, 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 the Treaty

3.1 Persons who make priority claim under the Treaty

(1) A person eligible for making a priority claim under the treaty is a national of a contracting state of the treaty or a national of a non-contracting state of the treaty who has a domicile or a real and effective industrial or commercial establishment in a contracting state. The contracting states 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

contracting state of the treaty or a national of a non-contracting state of the treaty who has a domicile or a real and effective industrial or commercial establishment in a contracting state.

(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 contracting states 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 contracting state of the treaty (the country where it was firstly filed). If an inventor did not file the first 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 first 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 firstly filed.

(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 contracting state of the treaty both at the time of filing the first 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 first 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 contracting state at the filing of an application in the country where it was originally filed, but has become a national of the contracting state 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 contracting state is allowed to transfer a priority claim to a national of a non-contracting state of the Treaty and then, the transferee can transfer the priority right back to another national of another contracting state of 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 contracting state of 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 firstly 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 contracting state of the Treaty. However, a national of a non-contracting state shall be allowed to make a priority claim under the Treaty if he/she has a domicile or a business address in a contracting state of the Treaty. A person without any nationality shall be also deemed as a national of a non-contracting state of the Treaty. It is because Article 3 of the Paris Convention stipulates that a national of a non-contracting state of the Treaty who has a domicile or a real and effective industrial or commercial establishment in a contracting state, too, shall be deemed as a national of a contracting state of 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 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 first 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 first 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 first 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 first 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 first 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 first 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 design registration or an inventor's certificate. The Paris Convention does not specify the type of the first application filed in one of the countries under the Treaty. However, according to Article 4E and 4I of the Paris Convention, the first 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 first application filed in one of the countries under the Treaty shall be regular. The relevant law of the country where the first application was filed under the Treaty shall determine whether the application is a regular application which forms a basis for a priority claim.

Whether the first 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 first 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 first application was filed under the Treaty, priority claim shall be still effective.

(3) The first 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 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 first application in one of the countries under the Treaty (a previous first 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 previous first application was filed.
- ② The previous first application shall be withdrawn, abandoned or rejected before the subsequent application is filed.
- ③ The previous first application shall not be published.
- ④ Any rights shall not be effective because of the previous first application.
- ⑤ The previous first application shall not serve as a basis for a priority claim in the same or different countries.

4. Proceedings for Priority Claim under the 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 first application in a written patent application. Also, the first 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 first 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 first 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 first 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 first application in one of the countries under the Treaty or writing the first 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 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 first 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.

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 the Treaty

Where a priority claim under the Treaty is legitimate, the same invention as the invention described in the first application filed in one of the countries under the Treaty shall retain the same filing date as the filing date of the first application in accordance with Articles 29, 36 of the Patent Act. Any invention excluded in the first application filed in one of the countries under the Treaty shall not take the same filing date as the filing date of the first 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 disclosure exception 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 first application filed in one of the countries under the Treaty.

6. Amendment to Priority Claim under the Treaty

(1) The period allowed for amendment or addition of priority claim is within one year and four months from the earliest priority date. The designated time period for multiple priority claims containing a 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 earliest priority date shall be calculated reflecting the addition or withdrawal of the priority claims under the Treaty.

(2) Article 54(7) of the Patent Act prescribes 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 indication 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 filed by another entity or an application which cannot be specified, the applicant shall not be able to 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 a decision to grant/reject an application for a patent made by the examiner becomes final and conclusive, the applicant shall not be able to 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, the addition of a priority claim made on the same date on which the withdrawal of all of the priority claims is made shall be accepted.

The time at which the decision to grant a patent becomes final and conclusive is when a certified copy of the decision to grant a patent is served to the applicant. Meanwhile, the time at which the decision to reject an application for a patent becomes final and conclusive is when thirty days have elapsed from the date on which a certified copy of the decision to reject a patent is served 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 permitted.

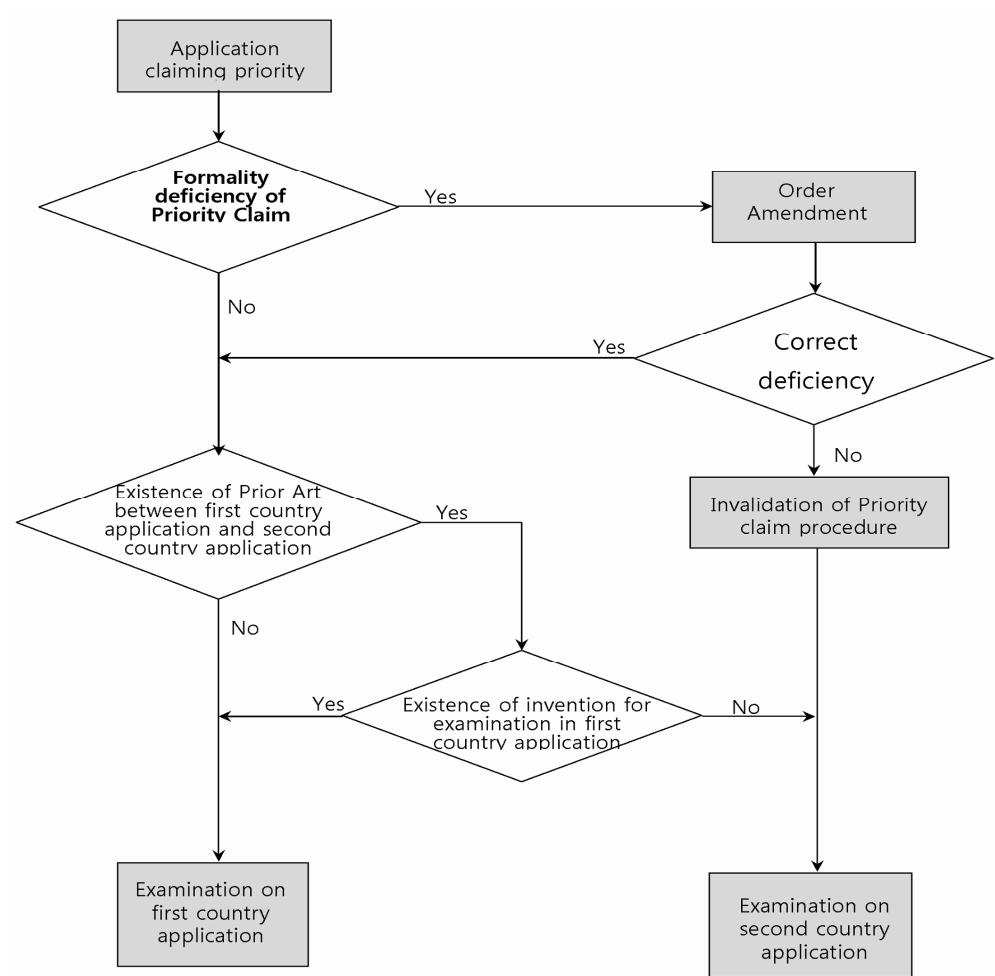
Where withdrawing priority claims and adding priority claims is to be made within the abovementioned period, an applicant need not separately submit a document for withdrawal for his/her convenience and the applicant may just submit an amendment reflecting the withdrawal and addition of the priority claims.

(5) Amendments of a priority claim after one year and four months has elapsed shall be permitted only when correcting clerical errors in the indication of the priority claim. In other words, amendments of changing the first application in one of the countries under the Treaty, amendments of specifying the first application in one of the countries under the Treaty which had not been specified before or amendments of adding the first application in one of the countries under the Treaty shall not be allowed.

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 allowed.

7. Examination of Application Claiming Priority under the Treaty

7.1 Flowchart of Examination Procedure on Priority Claim under the Treaty



7.2 Overview of Examination

(1) Once an application claiming priority under the Treaty or a written amendment to priority 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-filed application specified in Article 36 of the Patent Act is not found between the filing date of the first 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 first application in one of the countries under the Treaty. However, if any prior art exists between the filing date of the first application under the Treaty and the filing date of the application claiming priority under the Treaty, the examiner shall examine whether the invention described in the application claiming priority under the Treaty was described in the first 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 first 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 first 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 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 first application filed in one of the countries under the Treaty, the regularity of the first application, the compliance with the priority period, the description of the purport of priority claim and the submission of the evidential documents proving the priority claim.

(3) In determining whether the first application filed in one of the countries under the Treaty is the earliest application based on a regular national 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 first application without conducting the investigation to determine whether the application is the earliest filed application as a regular national 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 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 the application with 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 first 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 first 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 first 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 first 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 first application under the Treaty indicates anticorrosion 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 first 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 first 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 first 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 first

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 original specification and drawing(s) of the first 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 first 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 firstly 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 applications of the first application under the Treaty
- ③ Where a single application claiming priority under the Treaty is filed based on more than two first application under the Treaty

(Note) Even when an invention excluded from the first 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 first 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 first 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 first applications. However, when the inventions of the applications claiming priority are not recognized to be identical, the examiner can notify 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 first 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 first applications under the Treaty, where an invention in a patent application filed in Korea is based on one of the first applications, the examiner shall examine the invention based on the filing date of the first application describing the invention to determine the patentability of the invention.
- ⑤ As for an application claiming priority based on two or more first applications under the Treaty, where an invention consists of the subject matter separately described in each of the first 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 first 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 first 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 regular national 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

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.

Priority claim defined in the Paris Convention is made only based on the first application filed in one of the contracting countries 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 first 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 first 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.

③ 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 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 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 first 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 first 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.

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.

Chapter 4. Application with Domestic Priority Claim

1. Article 55 of Patent Act (Priority Claims Based on Patent Applications, etc.)

(1) A person who intends to obtain a patent may claim priority on the invention described in the original specification or drawings of an application filed earlier (hereinafter referred to as "prior-filed application") for a patent or for registration of a utility model, on which he/she is entitled to the patent or registration of a utility model: Provided, That the foregoing shall not apply in the following cases:

1. Where the relevant patent application is filed one year after the filing date of the prior-filed application;
2. Where the prior-filed application is a divisional application prescribed under Article 52 (2) (including cases to which the aforesaid provisions apply mutatis mutandis pursuant to Article 11 of the Utility Model Act) or a converted application prescribed under Article 53 (2) of this Act or Article 10 (2) of the Utility Model Act;
3. Where the prior-filed application has been abandoned, invalidated, or withdrawn at the time the relevant patent application is filed;
4. Where a decision on whether to grant a patent for the prior-filed application, a decision on whether to register the prior-filed application for registration of a utility model, or a trial decision to reject the prior-filed application becomes final and conclusive before the relevant patent application is filed.

(2) A person who intends to claim priority under paragraph (1) shall state his/her intention and indicate the prior-filed application in the patent application.

(3) In applying Article 29 (1) and (2), the main bodies of Article 29 (3) and (4), Articles 30 (1), 36 (1) through (3), 96 (1) 3, 98, 103, 105 (1) and (2), 129, and 136 (5) of this Act (including cases to which the aforesaid provisions shall apply mutatis mutandis pursuant to Article 132-3 (3) or

133-2 (4)), Articles 7 (3) and (4) and 25 of the Utility Model Act, and Articles 95 and 103 (3) of the Design Protection Act for an invention described in a patent application claiming priority under paragraph (1), which is identical to the invention described in the original specification or drawings of the prior-filed application to which priority is claimed, the patent application shall be deemed to have been filed at the time the prior-filed application was filed.

(4) In applying the main body of Article 29 (3) or (4) of this Act or the main body of Article 4 (3) or (4) of the Utility Model Act, if a patent application claiming priority to a prior-filed application under paragraph (1) is laid open or the patent is registered and published, an invention described in the original specification or drawings of the patent application, which is identical to the invention described in the original specification or drawings of the prior-filed application, is deemed laid open for the prior-filed application.

(5) In either of the following cases, paragraphs (3) and (4) shall not apply to an invention described in the original specification or drawings of the prior-filed application claiming priority to an application, which is also described in the original specification or drawings of the application to which priority is claimed:

1. Where the prior-filed application contains a priority claim under paragraph (1);
2. Where the prior-filed application contains a priority claim under Article 4-D (1) of the Paris Convention for the Protection of Industrial Property.

(6) For the purposes of paragraph (4), Article 29 (7) shall not apply even where the prior-filed application falls under either of the following:

1. Where the prior-filed application is an international patent application deemed voluntarily withdrawn under Article 201 (4);
2. Where the prior-filed application is an international application for registration of a utility model deemed voluntarily withdrawn under Article 35 (4) of the Utility Model Act.

(7) A person who claims priority which meets the requirements under

paragraph (1), may amend or add the priority claim within one year and four months from the filing date of the prior-filed application (referring to the earliest filing date, if at least two prior-filed applications have been filed).

Article 56 (Withdrawal, etc. of Prior-filed Applications)

(1) The prior-filed application to which priority is claimed under Article 55 (1) shall be deemed withdrawn at the time one year and three months have elapsed from the filing date of the prior-filed application: Provided, That the foregoing shall not apply in any of the following cases:

1. Where the prior-filed application has been abandoned, invalidated, or withdrawn;
2. Where a decision on whether to grant a patent, a decision on whether to grant registration of a utility model, or a trial decision to reject an application has become final and conclusive;
3. Where the priority claim based on the prior-filed application has been withdrawn.

(2) No applicant for a patent application claiming priority under Article 55 (1) shall withdraw the priority claim upon expiration of the period of one year and three months from the filing date of the prior-filed application.

(3) If a patent application claiming priority under Article 55 (1) is withdrawn within one year and three months from the filing date of the prior-filed application, the priority claim shall be deemed 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-filed application'), to further specify, improve or add to the prior-filed application.

Previously, where an invention which specified, improved, or added to a

prior-filed application was filed in an ordinary patent filing process, the invention was rejected since it was the same invention as in its own prior-filed application. Or, adding an improved invention to the prior-filed application by amending the specification or drawing(s) of the prior-filed application could lead to a decision to reject, 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-filed application is deemed to have been filed on the date of filing the prior-filed application and an invention newly added to the application is deemed 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-filed application (including a successor in title under Article 38(4) of the Patent Act). The applicants of both the prior-filed application and the later-filed application shall be identical at the time of filing the later-filed application.

(2) Where an application is jointly filed, the applicants of the later-filed application shall be the same as the applicants of the prior-filed application. To prove the identicalness of the applicants of both the prior-filed application and the later-filed 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 later-filed application shall be filed within one year from the filing date of the prior-filed 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-filed 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-filed 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 original application 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 later-filed application based on a divisional or converted application.

(3) The prior-filed 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.

(Note) Where the prior-filed 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-filed 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-filed 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 cover sheet of a prior-filed 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-filed 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-filed application, the applicant can state the purport and indicate the evidential documents of the prior-filed application in an application claiming a domestic priority.

If a claim of disclosure exception was not made at the time of filing a prior-filed application, such claim is not allowed at the time of filing an application claiming priority to the prior-filed application (which applies to an application filed on or before 28 July 2015)

(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 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-filed application which forms the basis of the priority claim, among the inventions in the application claiming a domestic priority, the later-filed application is deemed to have been filed at the time of filing the prior-filed 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(First to file, 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(5) of the Patent Act (Trial for a correction)

(2) Where a prior-filed 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 later-filed application would technically mean the extension of the priority period. Therefore, the priority claim of the above-mentioned invention shall not be acknowledged, whereas the effects of the priority claim shall be on inventions newly added to the prior-filed application.

(Note) To enjoy the effects of the priority claim even on the inventions disclosed in the basis application of the prior-filed application, the multiple priority claims shall be made based on the basis application of the prior-filed application in a later-filed application.

(3) The prior-filed 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-filed application. However, where the prior-filed 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-filed application has been withdrawn within one year and three months from the filing date of the prior-filed application, the prior-filed application is not deemed to have been withdrawn.

As for an application claiming a domestic priority based on multiple patent applications, the prior-filed 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-filed application.

(Note) Since only the pending applications are laid open, prior-filed

applications deemed to have been withdrawn are not laid open. Where a request for early publication of a prior-filed application is made within one year and three months from the filing date of a prior-filed application, the prior-filed application shall be laid open.

(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-filed application, the domestic priority claim cannot be withdrawn. Also, where a later-filed application is withdrawn within one year and three months from the filing date of the prior-filed application, the domestic priority claim is deemed to have been withdrawn at the same time as the withdrawal of the later-filed application.

(Note) If a later-filed application is withdrawn within one year and three months from the filing date of the prior-filed application, the priority claim is simultaneously withdrawn. Therefore, even if one year and three months has elapsed from the filing date of the prior-filed application, the prior-filed 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-filed application (the earliest filing date if two or more prior-filed 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-filed 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-filed 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-filed

applications. It is because the prior-filed 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-filed application has been filed within one year prior to the filing date of the later-filed application, ② the prior-filed application is neither a divisional application nor converted application, ③ the prior-filed application has not 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-filed application is identical to the applicant of the later-filed 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 later-filed 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-filed 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-filed 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-filed 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 copy of the amendment with all the amended features written would suffice.

7. Examination of Application of Domestic Priority Claim

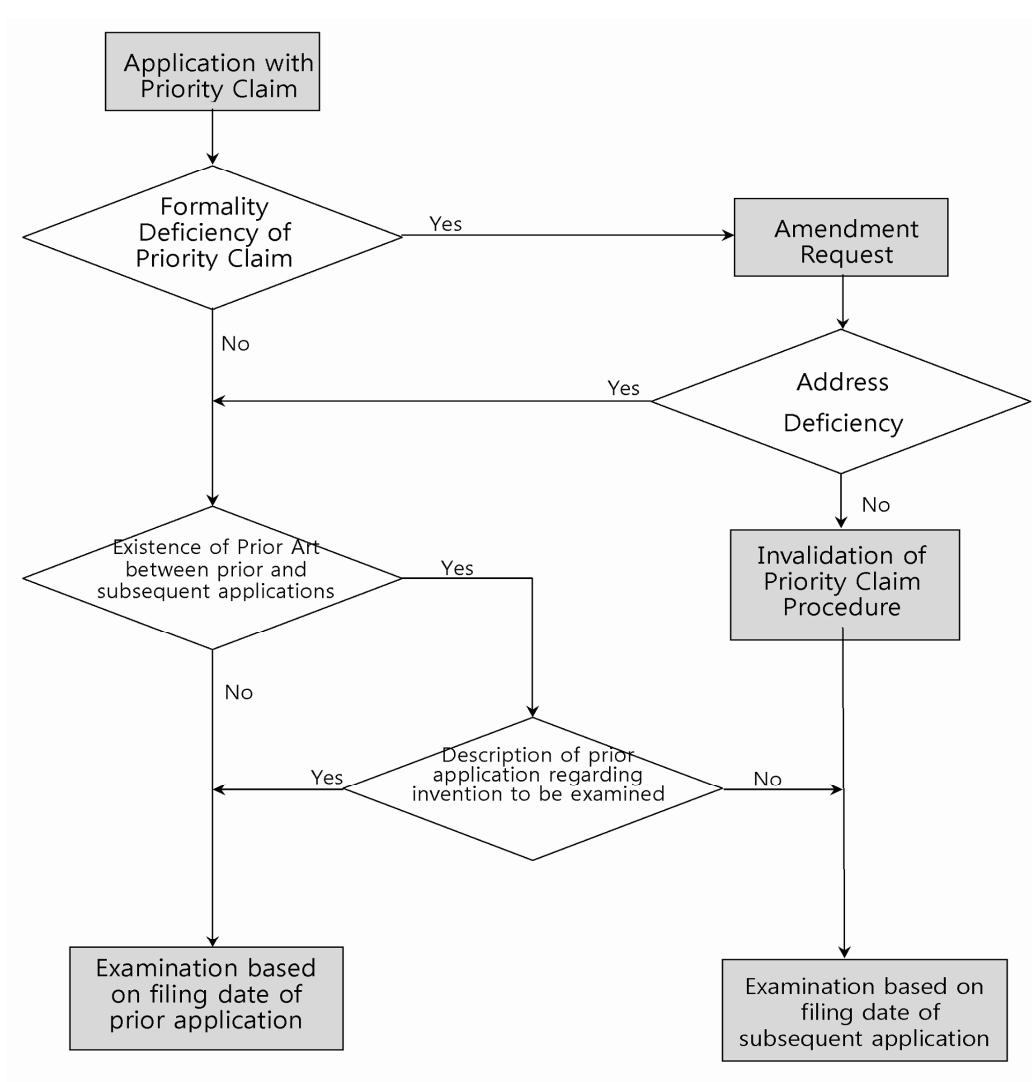
7.1 Overview of Examination

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-filed application and the later-filed application based on

the result of the prior art searches, the examiner shall determine by invention whether each of the inventions in the prior-filed application are identical to the inventions in the later-filed 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



7.3 Formality Examination of Domestic Priority claim

(1) Where a domestic priority claim exists at the time of filing a patent application, the 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-filed 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-filed 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-filed 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-filed 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 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-filed application as if the application is deemed to have been filed on the prior-filed 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-filed application, the examiner shall examine the application based on the filing date of the later-filed application.

7.5 Instruction of Examination of Application with Domestic Priority Claim

(1) As for an application claiming a domestic priority, the prior-filed 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-filed application. Therefore, the examiner shall not start the examination of the prior-filed application, but defer the examination. The same applies to where the request for expedited examination on the prior-filed application is made.

(2) A person allowed for claiming a domestic priority is the applicant of the prior-filed 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-filed application is not changed to

the name of the person filing the later-filed application before the filing date of the later-filed application (including the filing date), the priority claim shall not be valid. When the applicant of the prior-filed application is different from the applicant of the later-filed application, the examiner shall require the applicant to amend the application. If the applicant cannot prove that the applicant of the later-filed application is the successor of the applicant of the prior-filed 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 the prior-filed 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 later-filed 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-filed application can become another application under Article 29(3) of the Patent Act or a prior-filed application under Article 36 of the same act. Therefore, the examiner shall be careful in the examination. Also, the later-filed application shall be treated as a regular application without any priority claim.

PART VII. Other Examination Procedures

Chapter. 1 Patent Term Extension for Approval, etc.

1. Relevant Provisions

Article 89 (Patent Term Extension for Regulatory Approval, etc.)

(1) Notwithstanding Article 88 (1), in case the patented invention prescribed by Presidential Decree must receive an approval or be registered according to other statute (hereinafter referred to as "approval, etc.") in order to be practiced, and it takes a long time to undergo tests for efficacy, safety, etc. necessary for such approval or registration, etc., the term of a patent may be extended only once by up to five years to compensate for the period during which the invention cannot be practiced.

(2) For the purposes of paragraph (1), the period required due to a cause attributable to the person who has received approval, etc. shall not be included in "period during which the invention cannot be practiced" in paragraph (1).

Article 7 of the Enforcement Decree of the Patent Act (Invention eligible for Application for Patent Term Extension for Approval, etc.)

"Invention prescribed by Presidential Decree" in Article 89 (1) of the Act means any of the following inventions:

1. Invention on a medicine which received approval pursuant to Article 31 (2), (3) or 42 (1) of the Pharmaceutical Affairs Act in order to be practiced [limited to a medicine which received the first approval, among medicines manufactured with a new substance (referring to a substance whose active moiety exhibiting medicinal effects has a new chemical structure; the same shall apply hereafter in this Article) as an effective ingredient];
2. Invention on an agricultural chemical or raw material registered pursuant to Article 8 (1), 16 (1), or 17 (1) of the Pesticide Control Act to practice a patented invention (limited to an agricultural chemical or raw material registered first, among agricultural chemicals and raw materials manufactured with a new substance as an effective ingredient).

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, approval, registration, etc. under other Acts or subordinate statutes are required to practice such patented inventions. Also, the inventions cannot be exclusively practiced until approval or registration of such inventions is obtained, raising the issue of fairness against other patent rights.

Therefore, notwithstanding Article 88(1), where approval, registration, etc. under other Acts or subordinate statutes were required to practice a patented invention, and it has taken an extended period to complete the activity test, the safety tests, etc., necessary to obtain such approval, 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 practiced.

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 approval or registration (hereinafter referred to as “approval, etc.”) of the invention is not considered.

3.2 Applicable Law on Approval 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 approval for items] which is subject to approval 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 practiced for a certain period of time to obtain the approval 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 practiced before obtaining approval or registration under other acts or subordinate statutes shall not be subject to application for registration of an extension of the patent term.

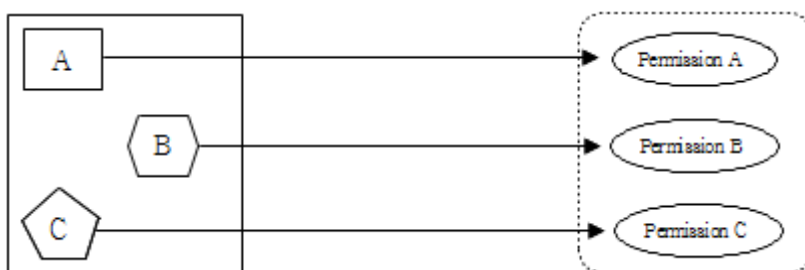
3.3 Term of Patent Right

Application for registration of an extension of the patent right by approval, 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 if not addressed, return the written application of registration for an extension of the patent term.

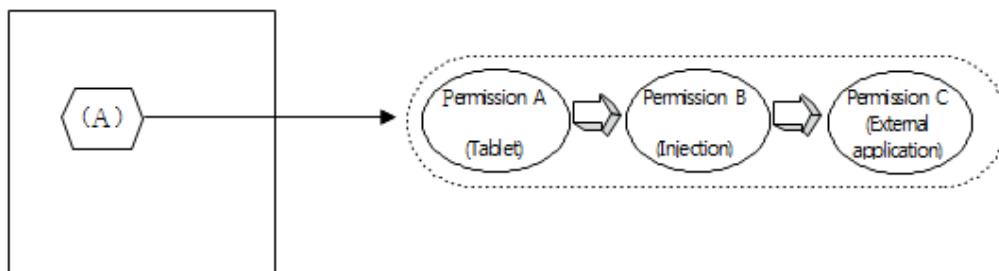
3.4 Determination of Extension of Patent Term

① Where multiple approvals are made on multiple active ingredients in a single patent, an applicant can choose just one permitted ingredient from the approvals and apply for a one-time extension of the patent term for the concerned ingredient.



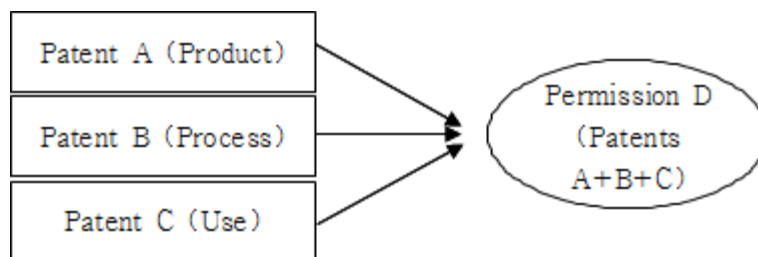
For example, as for active ingredients A, B and C disclosed in a single patent subject to the application of registration for an extension of the patent term, an applicant has obtained three separate approvals A, B and C, respectively. In that case, he/she can file an application of registration for 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 approvals 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 approval only.



For example, as for the active ingredient (a) subject to the application for registration of an extension of the patent term and Product Approval A, Active Pharmaceutical Ingredient Approval B and Dosage Form Change Approval C were obtained consecutively. Then, the patented invention can be practiced by the initial approval of Product Approval A. Therefore, application for registration of an extension of the patent term can be filed on the initial approval A only.

③ Where multiple patents are involved in a single approval, the term of each patented invention with respect to the concerned approval can be extended.



For example, where a product patent, a process patent, a use patent are each obtained for the active pharmaceutical ingredient in Approval D and where the approval is recognized to be necessary for the practicing 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 practiced. In other words, even though more than five years have elapsed to obtain approval or registration for the practicing of the patented invention, the patent term cannot be extended exceeding five years.

The period during which a patented invention cannot be practiced 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 a patent right or an applicant during the period of reviewing relevant documents of the application for approval 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 approval 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 approval 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 approval 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 Approval, etc.

5.1 Relevant Provisions

Article 90 (Applications for Registration of Patent Term Extension by Approval, etc.)

(1) A person who intends to obtain an extension of patent term under Article 89 (1) (hereafter referred to as "applicant for registration of an extension" in this Article and Article 91) shall file an application for registration of an extension of a patent with the Commissioner of the Korean Intellectual Property Office, stating the following therein:

1. The name and domicile of the applicant for registration of the term extension (if the applicant is a corporation, its name and place of business);
2. The name and domicile, or place of business of an agent, if the applicant for registration of an extension is represented by an agent (if the agent is a patent firm or a limited-liability patent firm, its name and place of business, and the name of the designated patent attorney);
3. The patent number of the patent, the term of which is to be extended, and indication of the claims for which the term is to be extended;
4. The length of extension applied;
5. Details of approval, etc. under Article 89 (1);
6. The ground for extension, prescribed by Ordinance of the Ministry of Trade, Industry and Energy (accompanied by materials substantiating the ground).

(2) An application for registration of a patent term extension under paragraph (1) shall be filed within three months from the date when approval, etc. is received under Article 89 (1): provided, however, that no application for registration of a patent term extension may be filed within six months prior to the expiration date of the patent term under Article 88.

(3) If a patent is jointly owned, an application for registration of the patent term extension shall be jointly filed by all co-owners.

(4) When an application for registration of an extension of a patent is filed

under paragraph (1), the term shall be deemed extended: provided, however, that the foregoing shall not apply where a decision to reject an application for registration of an extension under Article 91 becomes final and conclusive.

(5) Upon receipt of an application for registration of an extension of a patent under paragraph (1), the Commissioner of the Korean Intellectual Property Office shall publish information specified in paragraph (1) in the Patent Gazette.

(6) An applicant for registration of an extension may amend any matter specified in paragraph (1) 3 through 6, which are stated in the application for registration of an extension (excluding the patent number allocated to the patent, the term of which is to be extended under subparagraph 3), before the Commissioner of the Korean Intellectual Property Office serves a certified copy of a decision on registration of rejection of the extension on the applicant: Provided, That he/she may make an amendment only during the period set for submission of written arguments on the notice of the ground for rejection, if the notice of the ground for rejection, to which relevant provisions shall apply *mutatis mutandis* pursuant to Article 93, has been already served.

5.2 Applicant of Registration for Extension of Patent Term

An applicant of the application to register patent term extension shall be limited to a holder of the patent right. Where a patent right is jointly owned, an application to register patent term extension shall be made in the names of all the joint owners.

Where the person who filed an application to register patent term extension is not the holder of the patent right or where an application to register patent term extension 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 patent term extension by approval, etc. shall be filed within three months from the date of approval, 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 patent term extension was filed before approval, etc. defined under Article 89 of the Patent Act was obtained; after three months have elapsed from the date of approval, 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 patent term extension by approval, etc. to the applicant.

5.4 Application Document

(1) A person who intends to file an application to register patent term extension shall attach 'a copy of the evidential document of the ground for extension' and 'a copy of the evidential document of representation (only when the procedure is conducted by a 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 patent term extension 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 patent term extension is sought shall be written in the box for claims subject to extension. How such claims include items for approval 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) $R1=CH_3$ $R2=OH$ correspond to active pharmaceutical ingredient OOO in a popular term

④ A ground for a need to obtain approval or registration under Article 89 of the Patent Act to practice a patented invention for which an application to register patent term extension 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 period for Phase III trial conducted overseas and the period for review of document spent at an approval 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 patent term extension. However, where the period exceeds five years, the period for patent term extension shall be the number of days in five years.

⑤ In the box for the date on which an approval, etc. under Article 89 of the Patent Act is granted, the date of approval 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 approval, etc. under Article 89 of the Patent Act, the content of the relevant provisions and approval to practice a patented invention shall be written. Also, the evidential documents stating that a person who obtained an approval, 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 approval, etc.

1. As for drugs, approval 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

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, however, that where decision to reject an application for patent term extension 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 to reject an application 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 to reject a patent application, a decision to reject an application for registration for extension of term shall become final and conclusive when thirty days have elapsed from the service of a certified copy of a decision to reject if an appeal against the decision to reject an application for registration for extension of patent term was not initiated. Where an appeal against the decision to reject an application for registration for extension of patent term was initiated, the decision shall become final and conclusive when the decision of an appeal against the decision to reject an application for registration for extension of term of patent right has become final and conclusive.

5.6 Representation of Application to Register Extension of Patent Term

(1) Unlike withdrawal, etc. of an application to register patent term extension, special authorization is not required for an application to register patent term extension by approval, etc.. Therefore, even without special authorization, an application to register patent term extension can be represented by a representative. However, since the proceeding for an application of registration for patent term extension is unclear to determine whether it is a proceeding for filing an additional application or a proceeding for registration, the scope of power of representation shall be determined as in the following manner:

① When filing an application to register patent term extension, where the scope of power of representation in the evidential document of power of

representation states “all patent-related proceedings”, “all proceedings related to registration of a patent right”, or “ all proceedings related to an application to register patent term extension” and the name of the concerned representative is written in an application of registration for an extension, all of the subsequent proceedings for an application to register patent term extension(However, the abandonment of an application shall be determined based on the content of special authorization) can be represented by a representative.

② When filing an application to register patent term extension, where the evidential document of power of representation was not submitted and the scope of power of representation in the patent application or the evidential document of power of representation at the time of registration states “all patent-related proceedings”, “all proceedings related to registration of a patent right”, or “ all proceedings related to an application to register patent term extension” and the name of the concerned representative is written in an application of registration for an extension, all of the subsequent proceedings for an application to register patent term extension can be represented by a representative.

However, where the name of the concerned 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 patent term extension can be registered by a representative, the representative shall be deemed not to have a power of representation in a proceeding related to an application to register patent term extension.

③ The abandonment of an application to register patent term extension is entitled to special power of representation. Therefore, where there is no special power of representation, a representative cannot abandon an application to register patent term extension and the power of representation of a representative with general power of attorney shall be effective for an application to register patent term extension, too.

6. Examination

6.1 Relevant Provisions

Article 91 (Decision to Reject Applications for Registration of Patent Term Extension by Approval, etc.)

In any of the following cases, an examiner shall decide to reject an application for registration of patent term extension under Article 90:

1. Where it is found unnecessary to obtain approval, etc. under Article 89 (1) for practicing the relevant patented invention;
2. Where a patentee or an exclusive licensee or a registered non-exclusive licensee on the relevant patent fails to obtain approval, etc. under Article 89 (1);
3. Where the length of extension applied exceeds the period during which the relevant patent invention could not be practiced under Article 89;
4. Where the applicant for registration of an extension is not the patentee;
5. Where the application for registration of an extension is filed in violation of Article 90 (3).

Article 92 (Decision, etc. to Register Extended Patent Term by Approval, etc.)

(1) If an examiner finds that a ground set forth in any subparagraph of Article 91 does not apply to an application for registration of patent term extension under Article 90, he/she shall decide to register the term extension.

(2) When the Commissioner of the Korean Intellectual Property Office has decided to register patent term extension under paragraph (1), he/she shall register the extended term in the Patent Register.

(3) When the Commissioner of the Korean Intellectual Property Office completes the registration under paragraph (2), he/she shall publish the following information in the Patent Gazette:

1. The name and domicile of the patentee (if the patentee is a corporation, its name and place of business);
2. The patent number;
3. The date when the extension is registered;

4. The extended patent term;
5. Details of approval, etc. under Article 89 (1).

6.2 Flowchart and Overview of Examination Procedure

A procedure for examining an application to register patent term extension by approval, etc. is similar to that of a patent application. Where there exists no provision for the detailed procedure for examining an application to register patent term extension by approval, etc., the examination procedure for a patent application shall apply *mutatis mutandis*. Once an application to register patent term extension 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 patent term extension 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.

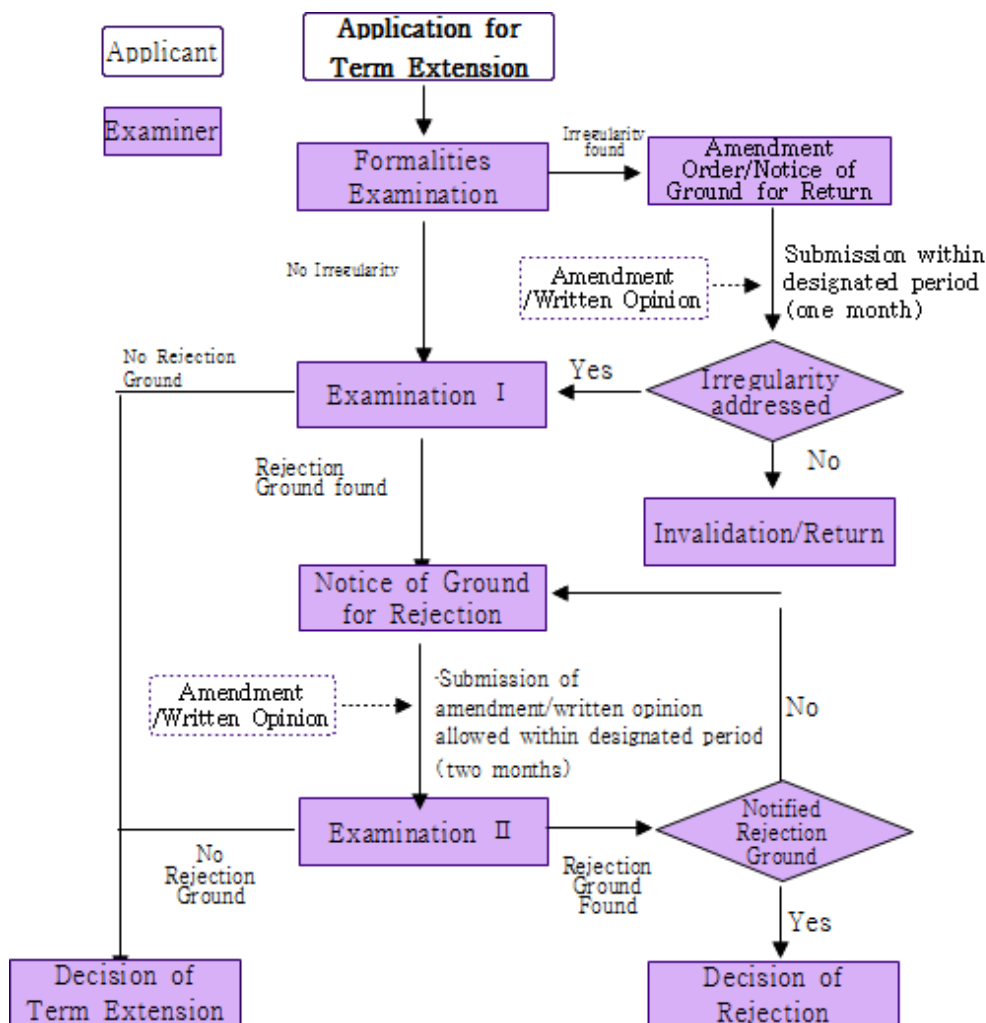
(2) Examination I

A designated examiner shall initiate a substantive examination of the application and 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 argument.

(3) Submission of Written Argument or Amendment

An applicant can submit a written argument within the period mentioned in a written notification of submission of argument designated by the examiner.

Also, the applicant can make an amendment to the application of registration for patent term extension within the period for submission of a written argument.



(4) Determination of Registration

An examiner shall re-examine the submitted application to register patent term extension, while considering the amendment and written argument. Where the application is to be rejected again after reexamination of the application, the examiner shall make a decision to reject an application for the registration. If the examiner finds no other reason to reject an

application for patent term extension, 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 patent term extension 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 patent term extension 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 patent term extension was filed before obtaining approval, etc. under Article 89 of the Patent Act, the application, too, shall be treated in the above-mentioned manner.

(2) Where an application to register patent term extension is in violation of the provision regarding a 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 patent term extension. 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 patent term extension 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 patent term extension are amended in a first amendment and the patent number and the period allowed for request for patent term extension 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 it is not deemed legitimate.

Therefore, a written application to register patent term extension only reflecting the amended matters in the first amendment shall become the subject for examination.

Items for amendment	Initial Application	1 st Amendment	2 nd Amendment	2 nd 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 patent term extension 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 approval, etc. under Article 89(1) of the Patent Act is unnecessary for practicing the patented invention

If the practicing of the patented invention is to be recognized necessary to obtain approval, etc. under Article 89(1) of the Patent Act, the following requirements shall be met: ①approval is required for the practicing, such as manufacturing or production, of the substance approved under Article 89(1) of the Patent Act; ②the composition of the patented substance shall be identical with that of the approved substance; or ③the use of the patented substance shall be identical with that of the approved substance.

Whether such requirements are met shall be determined in more detail in the following manner:

① Determination on Necessity for Approval of Patented Substance

As for a patented invention subject to an application to register patent term extension, approval under Article 89(1) of the Patent Act needs to be obtained to practice the patented invention. Therefore, unless special conditions exist, a need to obtain approval shall be recognized only based on the fact that an organization in charge of granting approval approved the concerned application.

For example, if approval 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 approval needs to be obtained under relevant provisions to manufacture the drug and may not additionally examine the necessity of approval, unless special conditions exist such as objection by a third party. However, if an examiner is unsure of the necessity of approval, he/she can conduct an additional examination (request for opinion from relevant organizations, etc.) and where approval 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 Substance and Approved Substance

A patented invention subject to an application to register patent term extension needs to be approved under the Pharmaceutical Affairs Act, etc. for the practicing of the patented invention. Therefore, the approved substance shall have the same composition as the substance recited in claims in an application to register patent term extension (where an invention set forth in claims is an invention of substance) or as the matter manufactured by the method described in claims (where an invention set forth in claims is a use invention).

Whether the substance recited in claims (or an article manufactured by the

disclosed use, etc.) has the same composition as the approved substance shall be determined in the following matter. Where the compositions of both substances 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 subject matter disclosed in claims is a substance invention, an examiner shall compare the concerned substance and the approved substance.

(ii) Where the subject matter disclosed in claims is a manufacturing method invention, an examiner shall compare the substance manufactured by the disclosed method with the approved substance. The manufacturing methods need not be compared.

③ Determination on Identicalness of Use between Patented Substance(Use Invention) and Approved substance

A patented invention subject to an application to register patent term extension needs to be approved under the Pharmaceutical Affairs Act for the practicing of the patented invention. The practicing of a patented invention refers to the practicing of use of a patented invention.

Therefore, where a patented subject matter is a use invention and the use of the approved substance is not the same with the use of the substance disclosed in a patented invention (the substance where an invention disclosed in claims is a substance invention or the substance manufactured by the claimed method if an invention disclosed in claims is a method invention), the term of a patent right shall not be extended even if the compositions of the approved substance and the patented substance are identical. However, when the use of the patented substance includes the use of the approved substance, it shall be deemed that the uses of both substances 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 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 patent term extension 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 approval, etc. under Article 89(1)

Even when only some of multiple patentees or persons who have jointly received approval, 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 it is deemed that the patentee, or a person who has an exclusive or non-exclusive license under the patent right has obtained approval, 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 patent term extension has obtained approval, 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 practiced

The term for which an extension is applied shall not exceed the period during which the patented invention could not have been practiced. 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 calendar.

(Note) Where the date on which approval 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 practiced in the period.

(4) Where the applicant for registration of extension is not the patentee

An applicant who files an application to register patent term extension 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 patent term extension 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 Notice of Ground for Rejection

Where an examiner intends to reject an application to register patent term extension by approval, 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 argument within a designated period.

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 notice 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 argument shall be submitted within two months. The period for submission of a written argument designated by an examiner can be extended. Extension of the period for argument submission can be allowed for one additional month each time and up to three times.

6.4.4 Treatment of Argument and Amendment

Where an examiner notifies an applicant of the ground for rejection for an application to register patent term extension by approval, etc., the applicant can submit a written argument or amendment.

A written argument shall be submitted within the period designated in a

notification for submission of a written argument. An amendment can be presented before delivering a copy of decision to grant registration of extension. However, after the notice of grounds for rejection made by an examiner, an applicant can submit an amendment only within the period for submission of argument according to the notice of the ground for rejection above.

(1) Where an argument is submitted, an examiner shall determine whether the ground for rejection really exists while considering the applicant's claim described in the written argument.

(Note) Even when an argument has been submitted after the period for submission of argument has elapsed or before the ground for rejection is notified, an examiner shall take the argument into consideration on examination, rather than returning the argument.

(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 refused to be entered.

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 approval, 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 allowed 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

preliminary notice for inadmissible amendment to an applicant

And give him/her an explanation to explain. A preliminary notice for inadmissible amendment can be replaced by writing the notice in a notification for submission of argument when the examiner intends to notify the ground for rejection again based on the preliminary 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 proceeding for an application for registration of extension is terminated based on general principles regarding the proceeding for filing a patent application, the amendment cannot be acknowledged. Therefore, where an application for registration of 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 patent term extension 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 universal successor in the presence of universal succession of a patent right shall not be acknowledged.

(Note 3) A person who has initiated a patent-related proceeding can amend the proceeding 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 patent term extension.

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 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) Decision to Register/Reject

Where an examiner intends to make a decision on whether to register an extension for an application to register patent term extension, he/she shall report such intention to the general of an examination division (team leader) and make and sign a written decision to register extension or to reject an application for registration of extension with the below-mentioned indications. However, items in ③, ④ need not to be written in a written decision to reject registration application of extension.

- ① Number of application for registration of extension
- ② Patent number
- ③ Period for extension
- ④ Content of approval or registration under Article 89(1) of the Patent Act: Claims for registration of extension, content of approval 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
- ⑧ Date of decision

(2) Transmittal of Decision to register extension

Where a decision to register extension is made for an application to register

patent term extension, 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 service 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 patent term extension, 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 approval, etc. under Article 89 of the Patent Act (indications such as claims for registration of extension, contents of approval or registration, ground for extension, etc.)

7.2 Appeal Trial on decision to reject registration

Where a person who has received a written decision to reject registration of extension since his/her application to register patent term extension by approval, etc. falls under the paragraphs of Article 91 of the Patent Act intends to appeal against the decision to reject, the applicant can submit a notice of appeal against a decision to reject registration of extension within thirty days from the date of receipt of a copy of the decision to reject registration of extension.

7.3 Invalidation trial on registration of extension of term of patent right

Where the registration of patent term extension with respect to an application to register patent term extension by approval, etc. falls under the paragraphs of Article 134(1) of the Patent Act, an applicant can request a trial to invalidate the registration of patent term extension.

Chapter 2. Extension of Patent Term for Delays in Registration

1. Relevant Provisions

Article 92-2 (Extension of Patent Term for Delays in Registration)

(1) When the registration of a patent right is delayed than four years from the filing date of a patent application or three years from the date on which a request for examination of an application is made, whichever comes later, the term of the relevant patent may be extended as much as the delayed period, notwithstanding Article 88 (1).

(2) In applying the provisions of paragraph (1), the period delayed due to an applicant shall be reduced from the period of patent term extension under paragraph (1): Provided, That when the period delayed due to an applicant overlaps with the period of registration delay, the period to be reduced from the period of patent term extension shall not exceed the actual period delayed due to an applicant.

(3) Matters concerning "the period delayed due to an applicant" under paragraph (2) shall be prescribed by Presidential Decree.

(4) When four years from the filing date of a patent application pursuant to paragraph (1) are calculated, any of the following dates shall be deemed the filing date of a patent application, notwithstanding Articles 34, 35, 52 (2), 53 (2), 199 (1), and 214 (4):

1. The date when a legitimate right-holder applies for a patent, in cases of a patent application by the legitimate right-holder pursuant to Article 34 or 35;
2. The date when a divisional application is filed, in cases of a divisional application under Article 52;
3. The date when a converted application is filed, in cases of a converted application under Article 53;
4. The date when a document containing the matters referred to in the subparagraphs of Article 203 (1) is submitted, as for an international

application deemed as a patent application pursuant to Article 199 (1);

5. The date when an applicant who filed an international application requests the Commissioner of the Korean Intellectual Property Office to make a decision pursuant to Article 214 (1), as for an international application deemed as a patent application pursuant to Article 214;

6. The date when a patent application is filed, in cases of a patent application which does not fall under any of the subparagraphs 1 through 5.

Article 7(2) of the Enforcement Decree of the Patent Act (Period Delayed Due to Applicants)

(1) "The period delayed due to an applicant" in Article 92-2 (3) of the Act means any of the following periods:

1. Any of the following periods in patent-related proceedings pending before the Korean Intellectual Property Office or the Korean Intellectual Property Trial and Appeal Board:

(a) Where the Commissioner of the Korean Intellectual Property Office or the presiding administrative patent judge orders that patent-related proceedings be carried out by an agent or orders the replacement of an agent under Article 10 of the Act, the period from the date when such order is issued until the date when an agent is appointed or replaced;

(b) Where a period for a petition for trial or a period for a patent-related proceeding is extended pursuant to Article 15 (1) or (2) of the Act at the request of the applicant, the extended period (when the period for a patent-related proceeding is shortened at the request from applicants under Article 15 (2) of the Act, after such period is extended, the period shortened shall be reduced)

(c) Where a date for carrying out a patent-related proceeding under Article 15 (3) of the Act is set and then such date is postponed to a later date, at the request from applicants, the period from the day after the set date to the postponed one;

(d) Where a patent-related proceeding is completed after a cause not attributable to a person who initiated a patent-related proceeding ceases to exist under the main body of Article 17 of the Act, the period from the date

when such cause ceases to exist to the date when such proceeding is completed;

(e) Where a patent-related proceeding is suspended or interrupted pursuant to Articles 20, 23 (2), 78 (1) or 164 (1) of the Act, the period during which such patent-related proceeding is suspended or interrupted;

(f) Where the Commissioner of the Korean Intellectual Property Office orders applicants to report the results of the consultation within a designated period pursuant to Article 36 (6) of the Act, such period (when a period is shortened, upon request from applicants, pursuant to Article 15 (2) of the Act, the shortened period shall be reduced);

(g) Where a specification is amended to include the claims within the period specified in Article 42 (5) 2 of the Act in accordance with the latter part of the main body of Article 42 (5) of the Act excluding the subparagraphs, the period from the date when the notification that request the examination is made for the relevant application is received to the date when such specification is amended;

(h) Where the Commissioner of the Korean Intellectual Property Office, the President of the Korean Intellectual Property Trial and Appeal Board or the presiding administrative patent judge orders amendment with designated period, pursuant to Articles 46, 141 (1) or 203 (2) of the Act, such period (when a period is shortened, upon request from applicants, pursuant to Article 15 (2) of the Act, the shortened period shall be reduced);

(i) Where a claim for a priority right is withdrawn or deemed withdrawn pursuant to Article 56 of the Act, with respect to an prior-filed application which has become the basis of a claim for a priority right under Article 55 (1) of the Act, the period from the date when a claim for a priority right based on the relevant prior-filed application is made to the date when such claim for priority right is withdrawn or deemed withdrawn;

(j) Where the determination of an expedited examination pursuant to Article 10 of the Act is delayed due to an applicant, with respect to an expedited examination under Article 61 of the Act, the delayed period;

(k) Where an examiner (referring to an examiner under Article 143 of the Act, when the provisions of Article 63 of the Act are applied mutatis

mutandis pursuant to Article 170 of the Act; hereinafter the same shall apply in this item) notifies an applicant of the grounds for rejection of a patent application and provides the applicant an opportunity to submit his/her arguments within a designated period pursuant to the main body of Article 63 (1) of the Act: Provided, That this shall not apply to cases where an examiner notifies an applicant of grounds for rejection and renders a decision to grant a patent (including cases where the provisions of Article 66 of the Act are applied mutatis mutandis under Article 170 of the Act and a decision is made to grant a patent) pursuant to Article 66 of the Act although no amendment to a specification or drawings is made in response to the rejection, the period (when the period for submission of written arguments is shortened, upon request from applicants pursuant to Article 15 (2) of the Act, the shortened period shall be reduced);

(l) Where an applicant pays patent fees (including cases where he/she pays additional patent fees under Article 81 (1) of the Act, the remaining portion of the patent fees under Article 81-2 (2) of the Act, or the patent fees or the remaining portion thereof under Article 81-3 (1) of the Act) pursuant to Article 79 (1) of the Act or is exempt from patent fees by submitting documents prescribed by Ordinance of the Ministry of Trade, Industry and Energy to the Commissioner of the Korean Intellectual Property Office pursuant to Article 83 (3) of the Act after he/she receives a certified copy of a decision to grant a patent under Article 67 (2) of the Act, the period from the date when he/she receives such copy to the date when a patent is registered pursuant to Article 87 of the Act;

(m) Where reexamination is requested under the main body of Article 67-2 (1) of the Act, the period from the date when a certified copy of the decision to reject a patent application under Article 67 (2) of the Act is served to the date when re-examination is requested;

(n) Where a request for examination or reexamination is made after a cause not attributable to a patent applicant ceases to exist under Article 67-3(1) of the Act, the period between the date when the cause ceases to exist and the date when the request for examination or reexamination is made;

(o) Where a motion for disqualification or recusal under Article 149 or 150 of the Act is not accepted in accordance with a decision made pursuant to Article 152 (1) of the Act, the period during which trial proceedings are suspended under the main body of Article 153 of the Act;

(p) Where it is concluded that the examination or preservation of evidence requested by applicants pursuant to Article 157 of the Act, the period from the date when such request is made to the date when it is concluded that such examination or preservation is unnecessary.

(q) Where review on the merits is resumed, upon request from applicants, after notification of the closing of the review pursuant to Article 162 (4) of the Act, the period from the date when such review is resumed to the date when the closing of the review is notified again pursuant to Article 162 (3) of the Act;

(r) Where a person requests a retrial under Article 178 of the Act after he/she becomes aware of grounds for retrial, the period from the date when he/she becomes aware of such grounds to the date when a retrial is requested;

(s) Where the presiding administrative patent judge grants an additional period pursuant to Article 186 (5) of the Act, the relevant period;

(t) Where service of documents or service by publication under Article 218 or 219 of the Act is delayed due to an applicant (including cases where such service is delayed because a person to be served changes his/her place to be served under Article 18 (10) and fails to report it to the Commissioner of the Korean Intellectual Property Office), the period during which such service is delayed;

2. Any of the following periods in litigation proceedings concerning a trial decision, ruling or court decision under Article 186 (1) or (8):

(a) Where a litigation proceeding is stayed pursuant to Article 78 (2) or 164 (2) of the Act, the period during which the proceeding is stayed;

(b) Where a motion for disqualification or recusal of a judge (including a technical reviewer applied *mutatis mutandis* under Article 188-2 (1) of the Act and a court clerical official of Grade V applied *mutatis mutandis* under Article 50 of the Civil Procedure Act) under Articles 41 through 43 of the Civil

Procedure Act is not accepted in accordance with a decision under Article 45 or 46 of the Civil Procedure Act, the period from the date when such motion for disqualification or recusal is made to the date when a decision to reject such motion is made or the period during which a litigation proceeding is stayed under the main body of Article 48 of the Civil Procedure Act;

(c) Where the court or the presiding judge orders correction of a proceeding, with designating a period, pursuant to Article 59 or 254 (1) of the Civil Procedure Act, the relevant period;

(d) Where a special representative is appointed pursuant to Article 62 of the Civil Procedure Act, the period from the date when such appointment is requested to the date when a special representative is appointed;

(e) Where a trial of litigation is resumed under Article 142 of the Civil Procedure Act due to an applicant, the period from the date when the resumption of the trial is ordered to the date when the resumed trial is concluded;

(f) Where the court prohibits an applicant or agent from making a statement and sets a new hearing date under Article 144 (1) of the Civil Procedure Act, the period from the date when such applicant, etc. is prohibited from making a statement to the new hearing date;

(g) Where the court orders the appointment of a lawyer pursuant to Article 144 (2) of the Civil Procedure Act, the period from the date when such order is issued to the date when a lawyer is appointed;

(h) Where a date designated by the presiding judge pursuant to Article 165 (1) of the Civil Procedure Act is postponed to a later date because of a good cause such as the request of an applicant, the period from the day after a designated date to the changed date;

(i) Where the court extends a statutory period or a period designated by the court, upon request from an applicant, under Article 172 of the Civil Procedure Act or grants an additional period, with regard to the invariable period, such extended period or additional period;

(j) Where any cause not attributable to a party ceases to exist and procedural acts are subsequently completed under Article 173 of the Civil

Procedure Act, the period from the date when such cause ceases to exist until the date when procedural acts are subsequently completed;

(k) Where the service of documents or service by publication under Article 178, 186 through 188 or 194 of the Civil Procedure Act is delayed due to an applicant, the period during which such service is delayed;

(l) Where litigation proceedings are suspended or interrupted pursuant to Articles 233 through 237, 239, 240 or 246 of the Civil Procedure Act, the period during which litigation proceedings are suspended or interrupted;

(m) Where an applicant has failed to appear on the hearing date, or failed to argue even if he/she has appeared and the presiding judge designates another date for hearing pursuant to Article 268 (1) of the Civil Procedure Act, the period from the day after the hearing date to the newly designated date;

(n) Where evidence whose examination is requested pursuant to Article 289 of the Civil Procedure Act is found unnecessary, the period from the date when such request is filed to the date when evidence is decided unnecessary;

(o) Where a petition for a retrial under Article 451 of the Civil Procedure Act is filed after the relevant party becomes aware of grounds for a retrial, the period from the date when he/she becomes aware of such grounds to a date when a petition for a retrial is filed;

3. Any of the following periods in procedures for administrative appeal or administrative litigation appealing to a disposition under Article 224-2 (2) of the Act:

(a) Where a request for disqualification or recusal under Article 10 of the Administrative Appeals Act is rejected or dismissed in accordance with a decision under Article 12 of the Enforcement Decree of the Act, the period during which an administrative appeal is suspended pursuant to Article 13 of the Decree;

(b) Where an administrative appeal is filed after an event of force majeure, such as natural disasters, wars or incidents, ceases to exist under Article 27 (2) of the Administrative Appeals Act, the period from the date when such event ceases to exist to the date when an administrative appeal

action is filed;

(c) Where the Central Administrative Appeals Commission (hereinafter referred to as the "Commission") orders correction with designating a period under the main body of Article 32 (1) of the Administrative Appeals Act, the relevant period;

(d) Where the Commission sets a deadline for supplemental brief pursuant to Article 33 (2) of the Administrative Appeals Act, the period from the date when such deadline is set to the date when a supplemental brief is submitted;

(e) Where a hearing date designated by the Commission under Article 38 of the Administrative Appeals Act is postponed, upon request from applicants, to a later date, the period from the day after the designated hearing date to the changed hearing date;

(f) Where the provisions of the Civil Procedure Act concerning service are applied mutatis mutandis under Article 57 of the Administrative Appeals Act, the period falling under subparagraph 2 (k);

(g) Where the provisions of the Civil Procedure Act are applied mutatis mutandis under Article 8 (2) of the Administrative Appeals Act, the period falling under any of the items of subparagraph 2;

4. The period prescribed by Ordinance of the Ministry of Trade, Industry and Energy, which is delayed due to an applicant in relation to the patent-related proceeding pending before the Korean Intellectual Property Office or the Korean Intellectual Property Trial and Appeal Board, litigation proceedings concerning a trial decision, ruling or court decision under Article 186 (1) or (8) of the Act or proceedings for administrative appeal or administrative litigation on appeal to a disposition under Article 224-2 (2) of the Act.

(2) Where there exists an objective ground which is not attributable to an applicant, among grounds for delaying registration of a patent under Article 92-2 (1) of the Act, the relevant period shall be reduced from a period under paragraph (1), notwithstanding the provisions of paragraph (1).

Article 54(5) of the Enforcement Rules of the Patent Act (Periods of delay Due to Applicant) “Period prescribed 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 Trial and Appeal Board or a presiding administrative patent judge orders submission of electronic documents in writing within a designated period pursuant to Article 2-2(2) of the Enforcement Rules 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)

2. Where the Commissioner of the Korean Intellectual Property Office, the President of the Intellectual Property Trial and Appeal Board 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 Enforcement Rules 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 Trial and Appeal Board, grounds for return and period for explanation are sent under Article 11(2) of the Enforcement Rules 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(1) of the Enforcement Rules 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 elapsed from the date of filing a patent application

5. Where an examiner defers an examination on a patent application at the request of an applicant under Article 40-3(3) of the Enforcement Rules of the Patent Act, the period between the date when the applicant made a request for deferral of examination and the desired expiration date of deferring the examination (where the desired expiration date of deferring the examination is changed, the changed date shall become the new desired expiration date). However, where an applicant withdraws the request for deferring an examination, the period between the date of request for deferring the examination and the date when the request for deferring the examination is withdrawn

6. Where a court official recommends amendment of litigation documents or requests the submission of an answer brief which meets the formality requirements 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 the answer brief was made and the date when the applicant amended the litigation documents or submitted the answer brief.

7. Besides the above-mentioned periods, in a patent-related proceeding pending before the Korean Intellectual Property Office or the Intellectual Property Trial and Appeal Board, a litigation proceeding against a trial decision, a ruling or a court decision under Article 186(1) or (8) of the Patent Act, or an administrative proceeding of an administrative appeal or administrative litigation on appeal to a disposition, the length of period delayed due to any request, amendment or submission made by the applicant.

2. Purport

A patent right is created upon registration of the patent 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) introduced a new system that where a patent right is registered later than a reference date (the date four years after the filing date of a patent application or the date three years from the date of requesting examination, whichever is later, hereinafter referred to as 'the reference date for extension'), the patent term can be extended for the period of delay.

However, out of the period where the registration of a patent right is delayed, any delay attributable to an applicant other than the delay in examination within the Korean Intellectual Property Office needs not be compensated. Therefore, the periods of delay attributable to an applicant shall be reduced in calculating the period for extension.

The newly-introduced system for extending patent term due to a delay in registration of a patent right shall be applied only to patent applications filed after the KORUS FTA takes effect, in other words, to patent applications filed after March 15, 2012.

3. Period Eligible for Extension

3.1 Patents 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 a patent right shall be later than a reference date for extension. Also, since the periods of delay attributable to an applicant shall be reduced in calculating the period for extension, the actual extension equals to '(the length of the period between the reference date for extension and the date of registration of a patent right) – (the length of the period delayed due to reasons attributable to an applicant)'. Only when the length of a period exceeds zero after calculation,

it shall become eligible for extension of a patent term.

The filing dates of a divisional application, a converted application and an application filed by a legitimate right holder shall be the filing date of the parent application or the filing date of the application by an unentitled person, and as for an international application, the international filing date shall be the filing date of an international application. However, when it comes to the extension of the patent term for 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, a converted application or an application by a legitimate 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 parent application and the actual filing date of the divisional application or between the international 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 reduced from the calculation of the period of patent term extension 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 a patent right is later than the reference date for extension, whether the concerned patent is eligible for term extension and the length of a period allowed for extension are determined depending on a period 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 the patent term. 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 proceeding (Article 1(1)), a litigation proceeding regarding a trial decision, etc.(Article 1(2)), a proceeding of an administrative appeal or administrative 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 proceeding, a litigation proceeding regarding a trial decision or a proceeding for an administrative appeal or administrative 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 is attributable to the periods of delay specified under Article 7-2(1) of the Enforcement Decree of the Patent Act, if such delay is objectively recognized not attributable to an applicant considering the specific circumstances of the concerned delay, the period shall not be deemed to correspond to '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 proceeding pending before the Korean Intellectual Property Office or the Intellectual Property Trial and Appeal Board.

(1) Where an applicant extends the period for filing a petition for a trial or the designated period for a patent-related proceeding:

Since a procedural delay is caused by an applicant's extending the period for filing an appeal against a decision to reject 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 proceeding such as examination, trial, etc., is interrupted or suspended due to circumstances of an applicant:

For example, where an applicant dies while his/her application is still pending, the period between the date when the proceeding is interrupted due to death of the applicant and the date when the successor resumes the interrupted proceeding 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:

Where two or more patent applications on the same invention are filed on the same day, and 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 administrative patent judge orders amendment on irregularities in a petition for trial or formalities of a trial-related proceeding:

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 presiding administrative patent judge designated while ordering amendments shall be deemed 'the period attributable to an applicant'. However, where the order for amendment under Article 46 or Article 203(2) of the Patent Act and subsequent proceedings are completed prior to a request for examination and thus the registration of a patent right is not deemed delayed due to the above-mentioned proceedings, 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 administrative patent judge recognizes after reconsideration of the application that no irregularities were 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 a domestic priority claim to a prior-filed application is withdrawn or deemed to be withdrawn:

Where examination on an application is withheld 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 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 to be subject to expedited examination is delayed due to circumstances of an applicant:

Where a person in charge of determination of expedited examination on the

application orders amendment on a request for expedited examination or attached documents within a designated period, the designated period shall be deemed 'the period of delay attributable to an applicant'. However, if it is found out later that there were no deficiencies in the request for expedited examination, then 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 arguments under Article 63 of the Patent Act:

Where an examiner rejects a patent application on grounds that the application failed to meet the patentability requirements such as in the case that the application is directed to an unpatentable subject matters or does not meet the written description requirements of the specification, or the applicant is not entitled to a patent for the invention, the period allowed for submission of a written argument 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 traversed by the written argument or explanation submitted by the applicant without taking any other measure to address the rejection ground, such as amendment to 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 designated for submission of the written argument shall not constitute 'the period of delay attributable to an applicant'.

Where a patent administrative patent judge notified a ground of rejection and give an applicant an opportunity to submit a written argument under 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 served:

The period between the date of service 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 service 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 service of a certified copy of a decision to reject a patent application and the date when a request for reexamination is made shall be deemed 'the period of delay attributable to an applicant'.

(10) Where the service of documents is delayed because of an applicant:

Where the service of documents is delayed since the address or the address of a place of business of an applicant or a representative to whom

documents are to be served is unclear, the length of delay for service 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 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 deferred at the request of an applicant:

Where examination on a patent application is deferred at the request of an applicant, the period between the date when the applicant made the request for deferring examination and the date when the period of deferral ends (where the date when the period of deferral ends is changed, the changed date) shall be 'the period of delay attributable to an applicant'. However, where a request for deferring examination is withdrawn, only the period between the date of request for deferring 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 proceeding appealing to a trial decision on the merits or an trial decision to dismiss a petition for a trial, etc. or a litigation proceeding appealing to the decision of the litigation are the followings:

(1) Where a request for disqualification or recusal of a judge, etc. made by an applicant is not accepted:

Where an applicant made a request for disqualification or recusal of a judge, a technical advisor or a court clerk, but the request is not accepted, the period between the date when the request for disqualification or recusal was made and the date when a decision to reject is made or the period where a litigation proceeding is suspended under Article 48 of the Civil Procedure Act due to the request for disqualification or recusal of a judge, etc. shall constitute 'the period of delay attributable to an applicant'.

(2) Where a court orders amendment to litigation capabilities of the party concerned or deficiencies in the right of representation, or where a presiding judge orders amendment to deficiencies in the complaint:

Where a court orders amendment to litigation capabilities of the party concerned or deficiencies in the right of representation, or where a presiding judge orders amendment to deficiencies in the complaint 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 hearing date since an applicant failed to show up on the hearing date:

Where a presiding judge resets the hearing date since an applicant failed to show up on the designated hearing date or where, even though the applicant did show up, he/she failed to make an argument, the period between the following date of the initially-designated hearing date and the newly-designated hearing date 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 appeal 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 proceeding, a litigation proceeding against a trial decision or ruling or an administrative appeal 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 when specific circumstances 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 proceedings under Article 46 of the Patent Act were completed before the request for examination and where the domestic priority claim to an prior-filed application was withdrawn, but a request for examination on the prior-filed application has not been made yet. An example under the case ii) is where, after an amendment order or a notification of grounds for rejection, irregularities in formalities or grounds for rejection are recognized to have been traversed even without amendments to formalities or a specification, etc. Where a proceeding is interrupted because of natural disasters shall fall under the example of the case (iii).

4. Application for Registration of Patent Term Extension for Delay in Registration

4.1 Relevant Provisions

Article 92-3 (Application for Registration of Patent Term Extension for Delayed Registration)

(1) Any person who intends to apply for registration of patent term extension under Article 92-2 (hereafter referred to as "applicant for registration of extension" in this Article and Article 92-4) shall submit an application for registration of patent term extension, stating the following matters to the Commissioner of the Korean Intellectual Property Office:

1. The name and domicile of an applicant for registration of extension (if the applicant is a corporation, its name and the location of its business office);
2. The name and domicile of an agent, if any, or the location of his/her business office (if the agent is a patent firm or a limited-liability patent firm, its name, the location of its business office and the designated patent attorney's name);
3. The number of a patent whose term is subject to extension;

4. The period of application for extension;
5. Grounds for extension prescribed by Ordinance of the Ministry of Trade, Industry and Energy (materials substantiating such grounds shall be attached thereto).

(2) An application for registration of patent term extension pursuant to paragraph (1) shall be filed within three months from the date of registration of a patent right.

(3) Where a patent right is owned by joint owners, an application for registration of patent term extension shall be filed by all joint owners.

(4) Any applicant for registration of extension may amend matters falling under paragraph (1) 4 and 5, among matters stated in a written application for registration of extension, before an examiner decides whether patent term extension shall be registered: Provided, That after he/she receives a notice of grounds for rejection, which are applied mutatis mutandis under Article 93, he/she may amend such matters only during a period for submission of arguments following the relevant notice of grounds for rejection.

Article 54-2 of the Enforcement Rules of the Patent Act (Written Application for Registration of Extension of Patent Term for Delay in Registration) A person who intends to make an application for registration of patent term extension 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 representative conducts a proceeding, a power of attorney

Article 54-3 of the Enforcement Rules of the Patent Act (Ground for Extension of Patent Term for 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 registered after four years from the filing date or three years from the date of request for examination, whichever comes later.

2. The period of request for extension and the explanation that the period of delay attributable to an applicant is reduced from the period of request for extension under Article 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 for registration of patent term extension due to a delay in registration is limited to a patent right holder. Where a patent right is jointly owned, all the co-owners of the patent right shall file an application for registration of patent term extension.

Where a person who filed an application for registration of patent term extension due to a delay in registration is not a patent right holder or where the co-owners of the jointly-owned patent right failed to file an application for registration of patent term extension shall constitute a ground for rejection.

4.3 Time Limit for Application

An application for registration of patent term extension for a delay in

registration shall be filed within three months from the date of registration of a patent right.

Where an application for registration for patent term extension is filed before the date of registration of a patent right or where an application for registration for patent term extension is filed when three months have elapsed from the date of registration 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 patent term extension to the applicant.

4.4 Application Documents

(1) A person who intends to file an application for registration of patent term extension due to a delay in registration shall attach 'grounds for extension designated under Ordinance of the Ministry of Knowledge Economy and a copy of the evidential documents' and ' a copy of the evidential documents of the representation if a proceeding is conducted by a 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 include 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 co-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 years 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 argument, 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 reference 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, whichever expires later) shall be written. Also, explanations that the period of delay attributable to an applicant is reduced 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 argument) 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 Representation on Application for Registration of Extension

Unlike withdrawal of an application for registration of extension, etc., an application to register patent term extension due to a delay in registration does not require a special authorization. Therefore, an application to register an extension of the term of a patent right can be carried out without special authorization. However, since the proceeding for filing an application to register patent term extension for 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 'Representation of Application for Registration of Extension of Patent Term for Approval, etc.' under Chapter 7. 1. 5 shall

be referred to regarding the scope of representation.

5. Examination

5.1 relevant Provisions

Article 92-4 (Decision to Reject Application for Registration of Patent Term Extension for Delayed Registration)

When an application for registration of patent term extension pursuant to Article 92-3 falls under any of the following subparagraphs, an examiner shall decide to reject the application:

1. When the length of extension requested exceeds a period of extension recognized pursuant to Article 92-2;
2. When an applicant for registration of extension is not a patentee;
3. When the application for registration of extension is filed, in violation of Article 92-3 (3).

Article 92-5 (Decision, etc. to Register Patent Term Extension for Delayed Registration)

(1) When an examiner cannot find a ground falling under any of the subparagraphs of Article 92-4, with regard to an application for registration of patent term extension pursuant to Article 92-3, he/she shall decide to register such extended term.

(2) When a decision is made to register patent term extension pursuant to paragraph (1), the Commissioner of the Korean Intellectual Property Office shall register such extension with the patent register.

(3) When any registration is made pursuant to paragraph (2), the following matters shall be published in the Patent Gazette:

1. The name and domicile of a patentee (if a patentee is a corporation, its name and place of business);
2. The patent number;
3. The date when the patent term extension is registered;
4. The period of extension.

Article 93 (Provisions Applicable Mutatis Mutandis)

@Articles 57 (1), 63, 67, and subparagraphs 1 through 5 and 7 of Article 148 shall apply mutatis mutandis to examination of an application for registration of an extended term of a patent.

5.2 Flowchart and Overview of Examination Procedure

A procedure for examining an application to register patent term extension due to a delay in registration is similar to that for examination on a patent application. 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 for Registration of Extension

Where an application to register patent term extension for 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 patent term extension 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 registration of a patent right), an examiner shall indicate 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 patent term extension due to a delay in registration is in violation of the provisions regarding a 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 proceeding in the name of the Commissioner of the Korean Intellectual Property Office.

5.4 Substantive Examination of Application for Registration of Extension

5.4.1 Determination of Subject for Examination

The subject for examination is an application to register patent term extension due to a delay in registration and relevant attached documents. However, where amendment (A) was made, an examiner shall determine whether to permit 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 patent term extension filed 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 Rejection Ground

Where an application to register patent term extension 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 for registration of 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 reference 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 Article 7-2(1) of the Enforcement Decree of the Patent 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 patent term extension 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 patent term extension due to a delay in registration of the divisional

application which has been established submitted a written application to register patent term extension 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 reference 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 reference date and submitted a written application to register patent term extension due to a delay in registration, an examiner can order amendment to the written application of registration for extension.

③ Calculation of Period of Delay

The period (the number of days) from the above-mentioned reference date and the date of establishment of a patent right after patent fee payment shall be calculated. If an applicant incorrectly wrote the reference date and submitted a written application to register patent term extension 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 argument, 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 reduced 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 notice 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 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 argument.

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 Argument
2016.12. 1.	Request for Extension of Period (2 months)
2017. 2. 1.	Submission of Amendment and Argument
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.	Notice of Appeal Trial against Decision to Reject
2018. 8. 1.	Decision affirming Appeal against Decision to reject
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 reference date of calculating the period of delay shall be on 2018.1.1. The period between the reference 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 argument after the notice 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. Notice of Ground for Rejection

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 patent term extension 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 argument 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 notice of ground for rejection shall be referred to the corresponding part in PART V.

At the notice of the ground for rejection, the period for submission of a written argument shall be within two months. The period for submission of a written argument designated by an examiner is extendable. The extension of the period for submission of a written argument 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 Argument and Amendment

Where an examiner notified a ground for rejection regarding an application to register patent term extension, an applicant may submit a written argument or an amendment. However, an applicant does not necessarily have to submit a written argument or an amendment.

A written argument can be submitted within the designated period specified in a notification of submission of a written argument. 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 argument according to the notification of the concerned ground for rejection.

(1) Where a written argument is submitted, an examiner shall re-determine whether the ground for rejection is actually present, taking the claim of the applicant described in a written argument into consideration.

(Note) Even though a written argument is submitted after the period for submission of a written argument has elapsed or before the notice of the ground for rejection, an examiner shall accept the written argument 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 preliminary notice of inadmissible amendment and give an applicant an opportunity of explanation. Where an examiner notifies the ground for rejection again because of a preliminary notice of inadmissible amendment disclosing the reason why the amendment cannot be accepted, the preliminary notice for inadmissible amendment can be replaced with the notification of submission for a written argument.

Where an examiner cannot accept an amendment 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 to reject.

(Note 1) Where a proceeding for an application of registration for extension is terminated, any amendment cannot be made according to general principles of the proceeding of filing a patent application. 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 indicated in the original 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 universal successor in the case of universal succession of a patent right shall be recognized.

(Note 3) A person who initiated a patent-related proceeding can amend the proceeding 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 patent term extension 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 not 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 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) Decision to register extension · Decision to reject

Where an examiner intends to determine whether to register patent term extension 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 to register 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 representative of applicant of registration for extension, Name and Address or Business Address of Representative (Title, Business Address and Name of Designated Patent Attorney where a 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 serve a 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 patent term extension appeals the decision since the application to register patent term extension falls under any subparagraph of Article 92-4 of the Patent Act, the applicant can submit a notice of appeal trial to 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 patent term extension due to a delay in registration is determined for registration of extension, an applicant can request a trial to invalidate the patent right.

Chapter 3. Examination on National Defense-related Application

1. Relevant Provisions

Article 41 (Inventions, etc. Necessary for National Defense)

(1) The Government may prohibit filing a patent application with a foreign patent office or may order an inventor, applicant, or agent to keep confidential an invention for which a patent application has been filed, if necessary for national defense: provided, however, that a patent application may be filed in a foreign country with prior permission from the Government therefor.

(2) The Government may refuse to grant a patent, if an invention for which a patent application has been filed is necessary for national defense and may expropriate the entitlement to a patent for national defense during a war, an incident, or any similar emergency.

(3) The Government shall pay reasonable compensation for losses incurred due to prohibition against filing a patent application in a foreign country, or classification of a patent application as confidential under paragraph (1).

(4) The Government shall pay reasonable compensation if it refuses to grant a patent or expropriates the entitlement to a patent under paragraph (2).

(5) If a person violates an order prohibiting filing a patent application in a foreign country or keeping a patent application confidential under paragraph (1), the person shall be deemed to relinquish his/her entitlement to a patent on the relevant invention.

(6) If a person violates an order prohibiting filing a patent application in a foreign country or keeping a patent application as confidential under paragraph (1), the person shall be deemed to relinquish his/her entitlement

to claim for compensation for losses incurred due to prohibition against filing the patent application in a foreign country, or classification of the patent application as confidential.

(7) Procedures for prohibiting filing a patent application in a foreign country, or for classifying a patent application as confidential under paragraph (1), procedures for expropriation and the payment of compensation therefor under paragraphs (2) through (4), and other necessary matters shall be prescribed by Presidential Decree.

Article 11 of the Enforcement Decree of the Patent Act (Classification Criteria of Patent Application Related to National Defense)

The Commissioner of the Korean Intellectual Property Office shall determine the classification criteria necessary for selection of inventions to be treated as confidential under Article 41 (1) of the Act (hereinafter referred to as "classification criteria") after consulting with the Commissioner of the Defense Acquisition Program Administration.

Article 12 of the Enforcement Decree of the Patent Act (Procedure for Confidential Treatment)

(1) If a patent application filed by a person having a domicile or business place in the Republic of Korea is conformed to the classification criteria 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 it is required to classify and treat such application as confidential.

(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/she shall notify an inventor, applicant and agent of the patent application, and a person who is deemed aware of the invention (hereinafter referred to as "inventor, etc.") of such fact, and request them to maintain the confidentiality thereof.

(3) The Commissioner of the Defense Acquisition Program Administration shall, upon receiving a reference under paragraph (1), make a reply within two months, and if it is deemed necessary to treat the patent application as confidential, he/she shall request the Commissioner of the Korean Intellectual Property Office to classify and treat such patent application as confidential.

(4) Upon receiving a request to classify and treat any patent application as confidential under paragraph (3), the Commissioner of the Korean Intellectual Property Office shall take 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, and if he/she is not requested so, he/she shall notify the inventor, etc. of the patent application of a cancellation of the request for maintenance of confidentiality as referred to in paragraph (2).

(5) Upon receiving a reply of the Commissioner of the Defense Acquisition Program Administration under paragraph (3), the Commissioner of the Korean Intellectual Property Office shall promptly issue an order to classify and treat the patent application as confidential, or notify a cancellation of the request for maintenance of confidentiality 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 under Article 12 (4), the Commissioner of the Korean Intellectual Property Office shall take necessary measures after consulting twice or more each year with the Commissioner of the Defense Acquisition Program Administration on the cancellation of confidentiality, extension of confidential maintenance period or whether to change the confidential level.

(2) An inventor, etc. who is ordered to classify and treat a patent

application as confidential under Article 12 (4), may request the Commissioner of the Korean Intellectual Property Office to release it from confidential treatment, to change the confidential level or to publish or license the invention to 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 patent 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 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 application with the indication of the national defense-related application and the Korean Intellectual Property Office keeps the application secret for security reasons and transfers 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. 822 of the Directive of the Korean Intellectual Property Office. Also, an examiner shall classify 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.

Classification Standard of National Defense-related Patent Application [Annexed Form]
under KIPO Directive No.822

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,
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 proceeding 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 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 representative of 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 Policy Division for classification. Then, it shall transmit the application to the examiner in charge of the classification.

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 proceeding for handling the application in writing and then notify the inventor, applicant or 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.

4.2 Where an examiner classifies an application as national defense-related one

(1) Review on the granting of CPC, IPC and the necessity of confidentiality order

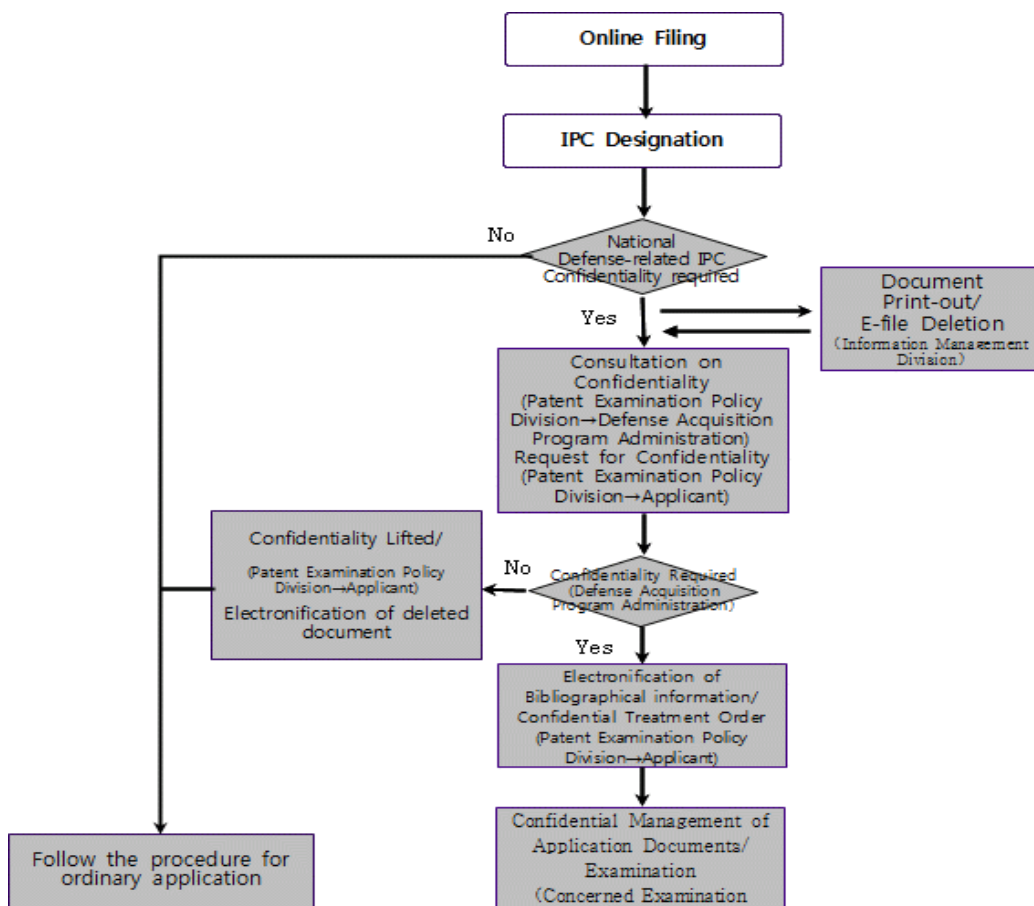
When assigning a classification code for an application under the CPC/IPC, where the section or class of the application is used as the classification code determined in the annexed form on the classification standard of a national defense related-application, the examiner shall determine whether to treat the application as a national defense-related one. Normally, when the Korea Institute of Patent Information assigns an application with a classification code and the application is entitled to be classified in the CPC/IPC code for national defense, this is notified to the examiner in charge.

Where an application falls under the CPC/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 Directive No. 822(2) 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 be 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 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 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 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.

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.

After an examiner determines patentability after examination, the examination bureau shall send the final documents of the confidential application including an amendment, a written argument 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.

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 arguments 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

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 Korea and the United States of America.

In order to get permission of filing a patent application in the United States 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:

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 States of America shall be waived (except for damages incurred because the United States of America has used or disclosed the invention without permission of the application).

Meanwhile, an applicant 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 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 representative who has received a security clearance from the Government of the United States of America and initiate a patent-related proceeding through the 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 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.

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.

Chapter 4. Expedited Examination

1. Relevant Provisions

Article 61 (Expedited Examinations)

In either of the following cases, the Commissioner of the Korean Intellectual Property Office may instruct an examiner to examine a patent application with priority to other patent applications:

1. Where it is found that any person, other than the patent applicant, is commercially or industrially practicing the invention claimed in the patent application after it is laid open under Article 64;
2. Where it is deemed necessary to urgently process a patent application specified by Presidential Decree.

Article 9 of the Enforcement Decree of the Patent Act (Cases Eligible for Expedited Examination)

"A patent application specified by Presidential Decree" in subparagraph 2 of Article 61 of the Act means a patent application designated by the Commissioner of the Korean Intellectual Property Office, among the following patent applications:

1. A patent application directed to the art of the defense industry;
2. A patent application directly related to green technology (referring to technology that minimizes emissions of greenhouse gases and pollutants by saving energy and resources and making use of them efficiently throughout the whole process of social and economic activities, such as technologies related to reducing greenhouse gas emissions, raising the efficiency of energy utilization, pollution-free production, clean energy, recycling resources, and eco-friendliness (including related convergence technology));
3. A patent application directly related to export promotion;
4. A patent application relating to 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 and 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 for the Promotion of Venture Businesses;

5-2. A patent application filed by an enterprise selected as a technology-innovative small and medium enterprise under Article 15 of the Act on the Promotion of Technology Innovation of Small and Medium Enterprises;

5-3. A patent application filed by an enterprise selected as an exemplary company in terms of the employee invention compensation system under Article 11-2 of the Invention Promotion Act;

6. A patent application relating to the results of the State project to support the development of new technology or quality certification;

7. A patent application which serves as a basis of a priority claim under treaties (limited to cases where a foreign patent application claiming priority to the concerned patent application is pending before a foreign patent office);

8. A patent application whose invention is being practiced or being prepared to be practiced by the patent applicant;

9. A patent application directly related to electronic transaction;

10. A patent application on which the Commissioner of the Korean Intellectual Property Office has agreed with the commissioner of any foreign patent office to expedite examination;

11. A patent application for which a person who intends to file a request for expedited examination requested an authorized prior art search institute designated under Article 58 (1) of the Act to conduct a search for prior art with respect to the patent application and has requested the authorized prior art search institute to notify the Commissioner of the Korean Intellectual Property Office of the results of the search.

12. A patent application filed by any one of the followings:

a. a person over 65 years old

b. a person who is not expected to be able to perform a patent-related proceeding up to decision to grant a patent or decision to reject due to serious health conditions, unless he/she can get expedited examination

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 a patent application related to medical R&D within the high-tech medical complex submitted by a tenant medical R&D institute with priority to another patent application.

2. Overview of Expedited Examination

Normally, a patent application is taken up for examination in the order of filing the request for examination thereof.

However, where a person who is not an applicant, is practicing the claimed invention after the laying-open of the patent application or the claimed invention is deemed necessary to be urgently examined for industrial development or the public interest, if those patent applications are 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 Expedited 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 expedited examination system has been expanding since its introduction in 1981. Until June 30, 1999, applications entitled to expedited 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 filed by 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 application relating to the outcomes of national projects of new technology development support or quality assurance, ⑦ patent application which serves as a basis for priority claims under the Treaty (only limited to cases where a foreign patent application claiming priority to the concerned patent application is pending before a foreign patent office) and ⑧ patent applications which are practiced or are to be practiced by a patent applicant were added to the scope of applications under the expedited 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 relating to 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 expedited examination system has been applied to applications for of utility model registration (applications for utility model registration included to the applications practiced 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 expedited 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 expedited examination is filed within two months from the application filing have been included. Also, the scope of applications eligible for expedited 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 expedited examination.

Moreover, where a person intending to request expedited examination has requested a authorized prior art search institute 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 authorized prior art search institute have been also included in the scope of application for expedited 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 expedited 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-expedited 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 expedited 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 Expedited Examination

3.1 General Criteria to be Eligible for Expedited Examination

3.1.1 Person who can request Expedited Examination

(1) Anyone, including an applicant, can make a request for expedited examination. However, only the central or local governments (including technology transfer & commercialization offices of the national and public schools) can request expedited examination of a patent application relating to the duties of the central or local governments.

(2) Where an incompetent such as a minor or a person under adult guardianship or under limited guardianship is to make a request for expedited examination, his/her legal representative shall carry out the proceeding for expedited examination on behalf. An unincorporated association can request expedited examination under the name of its representatives.

(3) An application filed by a foreigner may be entitled to expedited examination. Therefore, the request for expedited examination on the application filed by a foreigner is possible and if the application meets the requirements for expedited examination, the application shall be examined on expedited basis. Whether to examine a foreigner-filed application under the expedited 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 practicing the invention, the request for expedited examination for the invention shall be accepted on the ground of “the practicing of the invention by a third party”. Also, the request for expedited examination based on “the practicing of the invention by the applicant him/herself” can be recognized if an applicant, a licensee or a person authorized to practice the invention by the licensor has practiced the invention or is preparing to practice the invention. However, where an

applicant is a foreigner, the practicing of the invention of the foreigner means the practicing within the Republic of Korea. Therefore, the request for expedited examination based on the practicing of the invention outside the Republic of Korea shall not be accepted.

3.1.2 Applications eligible for Expedited Examination

(1) Patent applications or applications for utility model registration filed after October 1 of 2006 are eligible for expedited examination. Under Article 2(1) of the Directive concerning the request for expedited 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 expedited examination.

The expedited examination system was introduced in the amendment taken effect on October 1 of 2006 by which registration without substantive examination is changed to registration under substantive examination. Therefore, only applications for utility model registration filed after October 1 of 2006 can be eligible for expedited 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 expedited examination.

(2) Since expedited examination can be conducted on applications for which the request for examination has been already made, a requester of expedited examination shall make a request for examination before or at the same time with filing for expedited examination.

3.1.3 Reference Time for Determining Eligibility for Expedited Examination

Where an application requested for expedited examination is eligible for

expedited examination either at the time of request for expedited examination or at the time of determining whether to be accepted for expedited examination, the application shall be recognized to be eligible for expedited 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 expedited examination and the date of determining whether to be accepted for expedited examination.

For example, ① where an applicant was not a venture company at the time of filing an application or time of requesting for expedited examination, but it has become a venture company at the time when expedited examination is determined, or where an applicant was a venture company at the time of filing an application or time of request for expedited examination but its existing period has expired at the time of determining whether the application is eligible for expedited examination, such applications shall be recognized to be eligible for expedited 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 expedited 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 expedited examination if the request for expedited examination on the application was made after February 11 of 2005.

③ Even though a patent application added to the object of expedited examination under the Enforcement Decree of the Patent Act enacted on October 1 of 2006 and agreed for expedited 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 expedited examination if the request for expedited examination on the application was made after October 1 of 2006.

Where a third party was practicing the invention at the time of request for expedited examination, but the third party has stopped practicing the invention at the time of determining whether the invention is eligible for expedited examination or where the invention was not practiced by a third party at the time of request for expedited examination but the third party started practicing the invention after making a request for expedited examination, such inventions shall be recognized to be eligible for expedited examination.

3.1.4 Claims to be Determined of Eligibility for Expedited Examination

(1) In determining whether an invention is eligible for expedited examination, the invention eligible for expedited examination shall be recited in the claims. Therefore, if an invention eligible for expedited examination is described only in the description of the invention, but not in the claims, the invention is not recognized to be eligible for expedited examination. For example, where an invention practiced by the patentee is not recited in the claim but only in the description of the invention, the invention shall not become eligible for expedited examination.

(2) Whether an application is eligible for expedited examination shall be determined based on the claims amended before the time of determining the eligibility of expedited examination. Where multiple claims are present in the claims and one of the claims is recognized to be eligible for expedited examination, the application as a whole shall be accepted for expedited examination.

For example, where the application was initially eligible for expedited examination based on the claims pending at the time of requesting for expedited examination, but the claims were canceled by amendment at the

time of determining eligibility for expedited examination, the request for expedited examination on the application shall not be recognized. In the opposite cases, the request for expedited examination shall be accepted.

(3) When determining eligibility for expedited examination, only whether the claimed invention is eligible for expedited examination shall be assessed, rather than determining whether new matters are introduced or whether the application fulfills the requirement of unity of invention or inventive step.

3.1.5 Whether the Application is laid open at the time of Request for Expedited Examination

Article 61 of the Patent Act and Article 9 of the Enforcement Decree of the Patent Act define the applications eligible for expedited examination. Except for the case that the claimed invention is being practiced by a person other than the applicant, which requires the application to be laid open in order to be eligible for expedited examination under Article 61(1) of the Patent Act, the laying open or publication of the application is not required for expedited examination as in the case of the practicing of the invention by the applicant

However, as for a request for expedited examination filed based on the practicing of the invention by a person, other than the applicant, before the application is to be laid open, the determination of eligibility for expedited examination shall be deferred without the dismissal of the request for expedited examination, if the date of laying open the concerned application is approaching even though the application is not published 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 expedited 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 expedited examination, etc., once the concerned application is laid open, the examiner shall proceed with the expedited examination on the application.

3.1.6 Expedited Examination and Necessity of Urgent Proceeding

(1) Requirements 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 prescribe 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 application practiced by a person, other than the applicant, should be recognized necessary for urgent processing. Therefore, in principle, the applications eligible for expedited examination, except for the practicing of the invention by a person, other than the applicant, should be deemed necessary to be urgently processed.

Meanwhile, considering the purpose of the expedited examination system under the Patent Act, a patent application included in the objects of expedited 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 expedited 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 expedited 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 expedited 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.

As for ③, where a requester of expedited examination conducts prior art searches 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, 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 adequately provided by comparing the claimed invention and the searched prior art which should be submitted at the time of request for expedited examination.

Meanwhile, a patent application agreed for expedited 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 a patent application for which prior art search is requested 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) can be deemed that there exists explanation of patentability, Therefore, a requester of expedited examination can omit the description of the prior art search results and comparison between the claimed invention and the searched prior art in an explanation of request for expedited examination and the person in charge of determining eligibility for expedited examination shall recognize the necessity of urgent processing of the application.

(3) How to prepare Search Results and Comparative Explanation

In order for an application to be recognized necessary for urgent processing, a requester of expedited examination must describe the search process of prior arts and the comparative explanation of one prior art

closest in the search result and the claimed invention in a written explanation of request for expedited examination.

In principle, more than four searched prior arts closest to the claimed invention for expedited 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.

In the contrastive explanation, the similarities, differences and contrastive analysis between each claim of the application for expedited 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 expedited 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 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 expedited examination in Annexed Form no. 5 of the Directive on Request for Expedited Examination of Patent and Utility Model. Also, where a requester of expedited 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 representative, a report of resignation of 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 expedited 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 expedited examination shall be conducted by May 3. In other words, expedited examination shall be conducted within two months from the decision of expedited examination (only expedited 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 Expedited Examination

3.2.1 Overview of Request for Expedited Examination

Since a request for expedited examination is similar to a request for examination, where no detailed provision regarding request for expedited examination exists under the Patent Act or any decree under the Patent Act, provisions regarding request for examination shall apply.

3.2.2 Proceeding of Request for Expedited Examination

(1) A requester of expedited examination shall attach the following document and article (where the article which forms the basis for request of expedited examination exists) to a written request for expedited 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 Expedited Examination (attached with evidential documents of expedited examination in the annexed form)
- One original copy of the evidential document of representation when the

proceeding is conducted by a representative

(2) A requester of expedited examination shall pay a fee for requesting expedited 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 expedited 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 proceeding 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 expedited examination for an application under Article 4(1) of the Directive (a third party's practicing of the invention under the provision of Article 61(1) of the Patent Act) shall specify the condition under which a third party practiced the claimed invention or the utility model in a written explanation of request for expedited examination.

(4) A person who intends to make a request for expedited 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 expedited examination in Annexed Form no. 5.

※ Items to be indicated in Written Explanation of Request for Expedited Examination of Annexed Form no.5

(a) Self-search results and Contrastive explanation

(b) Ground for request of expedited examination

(c) Whether a claimed invention is being practiced (is prepared to be practiced) and whether the invention is practiced as business when expedited examination is requested on the ground that an application constitutes the claimed invention which an applicant is practicing or preparing to practice 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 expedited 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 expedited examination is requested on the ground of Article 4(2)(b) of the Directive)

(5) A person who intends to make a request for expedited examination on an application (a patent application on which the Commissioner of the Korean Intellectual Property Office agreed to make expedited examination with a commissioner of a foreign patent office) under Article 4(3) of the Directive shall fill out a written explanation of expedited examination in annexed forms no. 2, no.3 or no. 6 according to the guidelines.

(6) Where expedited examination is requested on the ground of an application under Article 4(4) of the Directive (an application for which prior

art search is requested to an authorized prior art search institute), an applicant can replace a written explanation of expedited examination under Article 5(1)(1) of the Directive by indicating that the prior art search for the concerned application has been requested to an authorized prior art search institute in a request for expedited examination under Annexed Form no. 22 of the Enforcement Rule of the Patent Act as well as the name of the authorized prior art search institute and the date of request for prior art search.

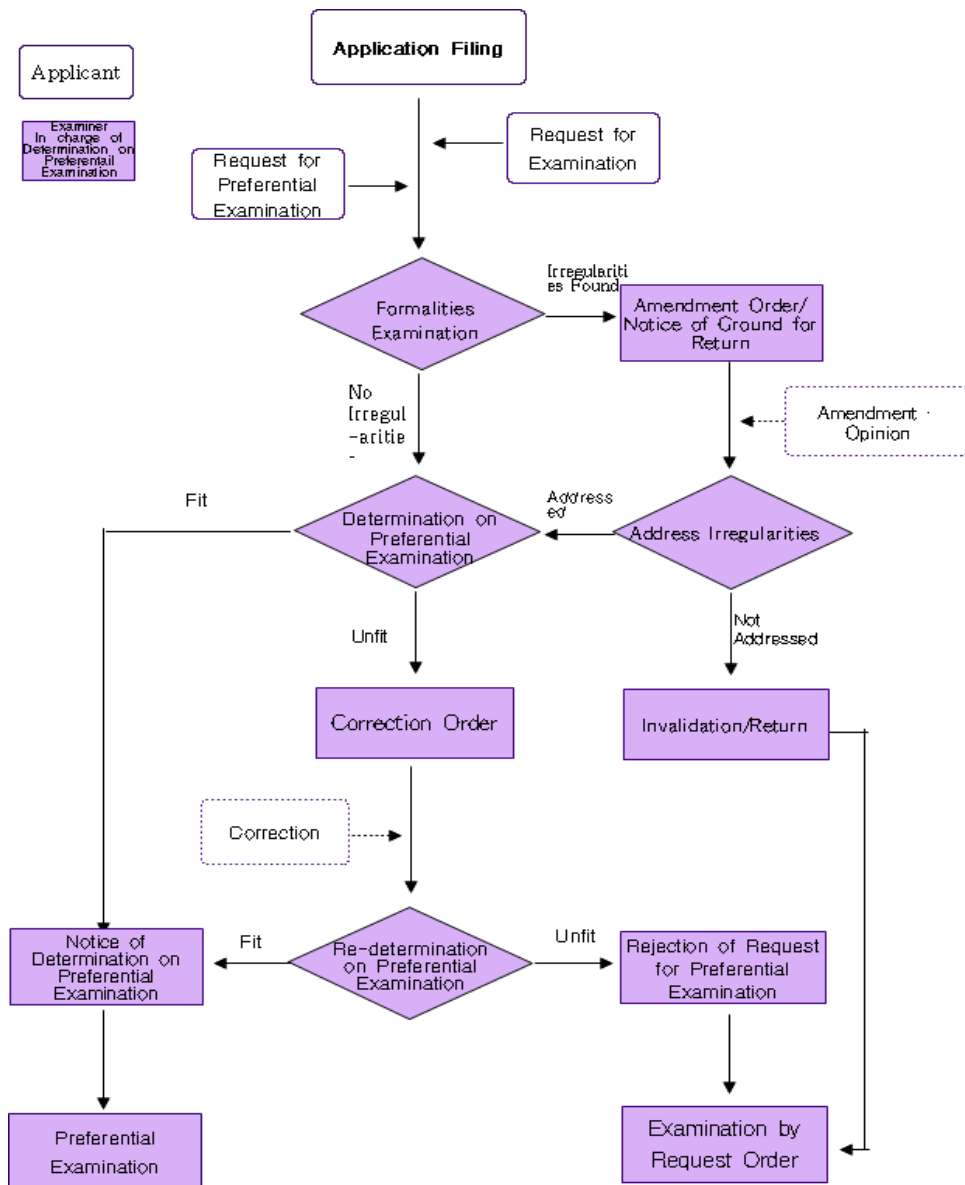
3.2.3 Availability of Withdrawal of Request for Expedited Examination

Where a notification of a decision of expedited examination has been made, a request for expedited examination shall not be withdrawn since once an examiner notifies a decision of expedited examination, the request for expedited examination takes effect and the examiner (or the Korean Intellectual Property Office) starts examination with consideration that the request for expedited examination is valid.

Once a written withdrawal of request for expedited examination is submitted after the decision of expedited examination is made, an examiner shall notify a requester of expedited examination (a person who requested withdrawal) of the intention that a written withdrawal of expedited examination cannot be accepted.

3.3 Procedure of Determination of Expedited Examination

3.3.1. Flowchart of Examination Procedure



3.3.2 Overview of Examination by Stage

3.3.2.1 Formalities Examination

The Director General of the Information & Customer Service Bureau shall complete the formalities examination on a request for expedited examination and transfer the request to the director general of the concerned examination bureau.

Once relevant documents of expedited examination are transferred from the Information & Customer Service Bureau, a person in charge of determination on expedited examination shall conduct the formalities examination on the concerned application and the written request for expedited examination. The formalities examination on a request for expedited examination shall be as follows:

(1) Amendment Order and Notice of Ground for Return

A person in charge of determination on expedited 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 expedited 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 expedited 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 argument (amendment) or a written explanation shall be one month and the argument 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 argument (amendment) or explanation submitted by an application, a person in charge of determination on expedited examination shall determine whether the concerned application is eligible for expedited examination. Where irregularities are not addressed, he/she shall invalidate the proceeding of request for expedited examination in the name of the Commissioner of the Korean Intellectual Property Office or return the documents of request for expedited examination.

Even when a requester of expedited examination has submitted a written argument (amendment) or explanation after the designated period has elapsed, a person in charge of determination on expedited examination shall treat the documents of request for expedited examination as a valid written opinion (amendment) or explanation and reassess whether irregularities are addressed or not, rather than invalidating the proceeding or returning the concerned documents, if he/she has not invalidated the proceeding of request for expedited examination or returned the documents of request for expedited examination.

(3) Fee Return

Where a person in charge of determination on expedited examination intends to invalidate the proceeding of request for expedited examination or return the documents of request for expedited examination, he/she shall make an overpayment notification additionally or send a notice on the proceeding of fee return attached to a notification on invalidation of the proceeding or return of documents.

A notice on invalidation of the proceeding of request for expedited examination or return of documents of request for expedited examination shall contain the intention to invalidate(or return) a request for expedited 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 proceeding of request for expedited examination is invalidated or documents of request for expedited examination are returned, the whole amount of fee of request for expedited examination shall be returned.

3.3.3.2 Determination on Expedited Examination

(1) IPC Assignment of Application for Expedited Examination

When the assignment of IPC is delayed, it postpones the designation of a person in charge of determination on expedited examination. Therefore, an examiner shall assign IPC on an application requested for expedited examination with priority to regular patent applications.

Therefore, where a patent examiner intends to change a patent examiner responsible, he/she can file a request for change of a patent examiner responsible, provided that it is determined whether the patent application is subject to expedited examination.

(2) Determination Deadline for Expedited Examination

A person in charge of expedited examination shall determine whether to conduct expedited examination within seven days from the transfer date of a written request for expedited 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 expedited 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 expedited examination under Article 4 of the Directive, a person in

charge of determination on expedited examination shall request consultation from relevant agencies.

(4) Complement Order of Request for Expedited Examination

Where an application requested for expedited examination is deemed not eligible for expedited examination under Article 4 of the Directive or the submitted documents cannot clarify whether an application is eligible for expedited examination, a person in charge of determination on expedited examination shall order complement a request for expedited 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 expedited examination as well as the specialized institute.

Where items necessary for determination on expedited examination are unclearly written or cannot be recognized, a person in charge of expedited examination shall order complement a written request and do not order to complement a request just because an explanation of request for expedited 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 expedited examination shall dismiss a request for expedited examination after the designated period for complementation of expedited examination has elapsed and notify such fact to a requester of expedited examination and applicant (only when an applicant is not a requester of expedited examination).

(5) Items Available for Complementation of Request for Expedited Examination

A request for expedited examination can be complemented from the time of request for expedited examination until the determination on expedited examination. Items available for complementation of request for expedited

examination are not limited. However, complementation of changing an application of request for expedited examination or a requester of expedited examination shall not be recognized.

(6) Notification of Determination on Expedited Examination

Where the concerned application is eligible for expedited examination under Article 4 of the Directive, a person in charge of determination on expedited examination shall notify such fact to the requester of expedited examination and applicant (only when an applicant is not a requester of expedited examination) immediately.

However, as for a patent application agreed for expedited examination between the Commissioner of the Korean Intellectual Property Office and a commissioner of a foreign patent office, the fact that the expedited examination on such application is determined shall not be notified.

(7) Fee Return

The proceeding for fee return after dismissal of request for expedited examination is the same with the proceeding for fee return of the case where a request for expedited examination is invalidated or returned. However, the returned fee shall amount to the request fee of expedited examination with the fee for determination on expedited examination extracted.

(8) Other Cases regarding Request for Expedited Examination

① Where a request of expedited examination is made on multiple grounds

A request for expedited examination can be made on the basis of multiple grounds for request of expedited examination. In such a case, an examiner shall not invalidate a request for expedited examination and determine and proceed expedited examination if a requester holds at least one ground for request of expedited examination.

② Where a ground of request for expedited examination which a requester did not claim exists

When making determination on expedited examination, a ground for request of expedited examination shall be assessed based on the ground for expedited examination indicated in an explanation of request for expedited examination. Therefore, whether to conduct expedited examination cannot be determined on the ground that a requester of expedited examination did not claim. However, where a ground for request of expedited examination is obvious or explained enough, it can be considered when determining whether to grant the expedited examination status.

As a result of examination on a request for expedited examination, where expedited examination cannot be conducted on the ground for request of expedited examination submitted by a requester or where other grounds for expedited examination exist, a person in charge of determination on expedited examination shall order to complement a request for expedited examination before the dismissal of the request. When a ground for expedited examination is changed after the complementation order, he/she shall determine whether to conduct expedited examination based on the newly-submitted ground for request of expedited examination.

For example, where expedited examination was requested based on the ground for the practicing by a third party and then a person in charge of determination on expedited examination ordered to complement the evidential document on the third party's practicing, but a requester of expedited examination failed to complement the evidential document on the third party's practicing and changed the ground for request of expedited 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 expedited examination shall recognize the application to be eligible for expedited examination.

③ Where multiple requests for expedited examination are made

After submission of a request for expedited examination, where a new request for expedited examination is submitted before an examiner in

charge of the application determines whether to conduct expedited examination based on the previously-submitted request, the subsequently-submitted request for expedited 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 expedited examination or after an examiner in charge of the concerned application made a decision to invalidate expedited examination, a request for expedited examination can be submitted again.

④ Availability of whether to determine expedited examination before the submission deadline based on the complementation order on request for expedited examination

Where the requirements of request for expedited examination are fulfilled through complementation such as submission of relevant documents even before the submission deadline of complementation order of request for expedited examination, expedited 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 expedited examination, determination on dismissal of expedited examination shall be made after the termination of the concerned period.

3.3.3.3 After Determination on Expedited Examination

(1) Processing Period after Determination on Expedited Examination

An examiner shall start examination on an application determined for expedited examination either within two months from the transmittal date of a written decision on expedited examination (as for an application agreed for expedited examination between the Commissioner of the Korean Intellectual Property Office and the commissioner of a foreign patent office or an application determined for expedited examination based on the

request for prior art search by authorized prior art search institute, 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 expedited 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, expedited examination shall be started within the abovementioned processing deadline or within one month from the transmittal date of the concerned amendment, whichever is later.

※ Where expedited examination cannot be conducted within the processing deadline because of a jump in requests for expedited 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 expedited examination between the Commissioner of the Korean Intellectual Property Office and the commissioner of a foreign patent office, a notification of the decision on expedited examination is not made. Therefore, the date of determination on expedited examination or the date of redetermination on expedited examination, whichever expires later, shall be deemed to be the transmittal date of the notification of the decision on expedited examination.

※ As for a patent application determined for super-expedited examination, an examiner shall start examination within fourteen days from the transmittal date of a decision on super-expedited-examination. Where examination cannot be started within the processing deadline because an amendment is submitted after transmittal of a decision on expedited examination, an examiner can change the processing deadline by reporting such fact to the director of the examination division (or team).

(2) Notification, etc. of Result of Expedited Examination

① A person in charge of determination on expedited examination shall notify a requester of expedited examination (only when a requester of expedited examination is not an applicant) of the final processing results on the application determined for expedited examination (decision to grant a patent, decision to register utility model, decision to reject a patent application, decision to reject an application for utility model registration, withdrawal, abandonment, etc.) (Article 67 of the Directive).

② Where relevant documents of expedited examination (including the original copy of the receipt of request fee of expedited examination) are not in electronic form, an examiner shall notify a requester of expedited examination of the final processing results and transmit the relevant documents of expedited 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 expedited examination are in electronic form, the abovementioned procedure can be skipped.

(3) Other Relevant Cases

① Deferral of Expedited Examination for Application filed before June 30, 2001

Where expedited 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 expedited 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 expedited 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 Expedited Examination

Where a divisional application is filed based on the parent application requested for expedited examination, but the divisional application is not requested for expedited 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 expedited examination, an examiner shall start examination on the application with the earlier examination order between the divisional application and the original application requested for expedited examination, according to the examination order.

③ Where Examination is Conducted before Transmittal of Relevant Document for Expedited Examination

Where expedited examination is requested after the start of examination on an application and the application is eligible for expedited examination, an examiner shall recognize the application to have been requested for expedited examination and conduct expedited examination on the application.

④ Where an application requested for expedited examination is a prior-filed application of an application claiming domestic priority

Where a prior-filed 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-filed application. Where a prior-filed 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-filed application is deemed to be withdrawn, a later-filed application cannot be granted a patent since the prior-filed application holds the prior right. Therefore, where an application requested for expedited examination becomes a prior-filed application of the application claiming domestic priority, it shall be treated as follows:

Where an application requested for expedited examination is confirmed to be a prior-filed application of the application claiming domestic priority before the determination on expedited examination, the application is not eligible for expedited 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 expedited examination within the designated period(with that indication that expedited examination cannot be conducted because an application requested for expedited examination does not need to be urgently processed since it is a prior-filed application of the application claiming domestic priority). After the designated period has elapsed, the examiner shall dismiss the request for expedited examination.

However, where priority claim is withdrawn before the dismissal of the request for expedited examination, an examiner shall deem it as valid request for expedited examination and conduct expedited examination.

Also, where an application eligible for expedited examination after determination on expedited examination has become a prior-filed application of the application claiming domestic priority, an examiner shall withhold examination until the application is deemed to be withdrawn.

4. Guidelines of Determination on Expedited Examination by Subject

4.1 Application being practiced by Third Party

4.1.1 Subject

Applications for an invention or utility model deemed to have been practiced as business by a 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 publication 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 expedited examination (or where a request for early publication of the application has not been filed, or the laying-open is not impending), an applicant shall make a request for early publication 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 practice 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 practice the claimed invention is obtained and just may recognize the argument made by a requester of expedited examination as it is.

(3) Definition of Practicing

“Practicing” in the practicing of the invention by a third party refers to the acts of the practicing 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 method, acts of using the method

c. In the case of an invention of a method for manufacturing a product, acts of manufacturing, using, assigning, leasing, importing, or offering for assignment or lease of, the product manufactured by the method, 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

Also, 'practicing' means the practicing of an invention in the Republic of Korea. Therefore, where an invention filed in the Republic of Korea is being practiced only in a foreign country, it shall not constitute the practicing of an invention. However, where a claimed invention produced in a foreign nation is imported to the Republic of Korea, it shall constitute the practicing of an invention.

(4) Determination on Identicalness between the Invention practiced by Third Party and the Claimed Invention

A request for expedited examination made by an applicant on the ground that a third party is practicing the applicant's invention shall clarify that the invention practiced by the third party is identical with the claimed invention of the application. Also, a requester of expedited examination shall prove the ground for identicalness of the two inventions.

A requester of expedited examination can prove the practice of the invention by a third party by submitting the below mentioned documents with the description of the detailed condition where the third party is practicing 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 practiced 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 expedited examination.

Example)-Submission of Product practiced by Third Party

-Submission of Photograph of Product, Place of Invention being practiced or Invention being sold

-In the case of content-certified mail requesting the ban on the practicing 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 practiced by a third party

An examiner shall determine on the identicalness of the concerned product practiced by 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 expedited examination. However, where identicalness cannot be determined only based on the submitted materials, an examiner may order to supplement evidential documents.

However, where it is deemed difficult for a requester of expedited examination to verify the fact that the invention is being practiced by a third party due to lack of cooperation from the person practicing the concerned invention and the possibility of the identicalness between the invention practiced by the third party and the claimed invention is pretty high, an examiner may recognize the request for expedited examination without requesting the submission of additional materials from the requester of expedited examination. That is to say that where it is not clear whether the invention or utility model practiced 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 expedited 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 expedited examination.

4.1.3. Handling of Request for Expedited Examination based on practicing of Invention by Third Party prior to Laying-open

In case of requesting expedited examination based on the fact that an invention or utility model is being practiced by a third party, the concerned application should be laid open under Article 64 of the Patent Act as of the date of determination on expedited examination. Also, an application may be laid open according to a request for early publication.

Also, as for a request for expedited examination made based on the practicing 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 expedited examination) or an applicant made a request for early publication of the application even though the concerned application has not been laid open under Article 64 of the Patent Act, an examiner shall defer the determination on expedited examination without dismissal of the request for expedited 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 deferring the decision on expedited examination, once the concerned application is laid open, an examiner shall conduct expedited examination.

4.1.4 Handling of Request for Expedited Examination in Presence of Warning from Applicant

A person who has received a warning letter on the practicing of the published invention or utility model without permission from an applicant may make a request for expedited 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 practiced) in a written explanation of request for expedited examination. An examiner shall recognize the request for expedited 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 practiced 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

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 foe 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 expedited 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 expedited examination and explain that the claimed invention or utility model constitutes the concerned item.

Even where a requester of expedited examination did not specify defense materials in a written explanation of request for expedited 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 expedited examination without making an additional correction order.

4.3 Patent Application directly related to Green Technology, Utility Model Registration Application useful for Pollution Prevention

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 expedited 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 expedited 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 expedited examination are specified under Article 4(2)(b) and (n) of the

Directive on Request for Expedited 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 expedited 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 expedited examination on green technology, a requester shall explain on what ground the claimed invention constitutes green technology in a written explanation on request for expedited examination. Then, a person in charge of determination on expedited examination shall make a decision on whether the claimed invention constitutes green technology based on the argument presented by the applicant.

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
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

<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 expedited examination gave no explanation on the claimed invention requested for expedited 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 expedited examination, an examiner shall order to correct the request of expedited examination based on such grounds.

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 Expedited 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 expedited 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 expedited examination shall decide whether to recognize the concerned application to be eligible for expedited examination based on the explanation given by a requester of expedited examination that the claimed invention constitutes green technology written in a written explanation of expedited 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 expedited examination has submitted the following evidential documents by each of the above-mentioned grounds for request of expedited examination and the applicant and the claimed invention shall be identical with 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
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 Expedited 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

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 expedited 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 expedited examination and just indicate in a written explanation of request for expedited 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 expedited examination did not specify a pollution prevention facility in a written request for expedited examination, and just indicate it as “a patent application useful for pollution prevention”, an examiner may recognize the request for expedited 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 any of the above-mentioned pollution prevention facilities, the application shall not be deemed eligible for expedited 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 expedited 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 expedited 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 expedited 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 Export

(1) Subject

Applications directly related to the promotion of export

(2) Examination Guidelines

① Evidential Documents

Applications directly related to the promotion of trade shall be determined for expedited 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 expedited 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 expedited examination. However, normally, the identicalness cannot be determined just based on the documents about the request of expedited examination. In such cases, an examiner can recognize the request of expedited 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).

(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 expedited 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 expedited 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 expedited examination(Article 3 of the Directive). Where a requester of expedited 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 expedited 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 expedited 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

(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 expedited examination shall be accepted.
- ② Where the names of the company certified as venture business and the applicant are identical, the request for expedited examination shall be accepted.
- ③ At least one of the dates among the filing date, the date of request of expedited examination or the date of determination on expedited 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 expedited examination is made even though there is no correlation between the type of the venture business and the claimed invention, the request for expedited examination shall not be accepted. Where no correlation is found, an examiner shall order to correct the request for expedited examination and when the correlation is well explained, the examiner shall accept the request for expedited 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 expedited examination along with the written explanation of request for expedited 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 expedited examination, an examiner shall order to correct the request for expedited examination.

※ 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 expedited 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 expedited examination is made by adding a venture business to an applicant after filing the application

To be eligible for expedited examination on the ground for a venture business, the applicant shall be a venture business when filing an initial application. Therefore, where an 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 expedited examination on the ground of change or addition of venture business, the application shall not be eligible for expedited examination. However, where a venture business practices the claimed invention with the right to get a patent transferred from the original applicant, a person in charge of determination on expedited examination can confirm such fact and recognize it to be eligible for expedited 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 expedited 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 expedited 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 expedited examination shall be recognized.

② Where the names of the company designated as the Inno-Biz and the applicant are identical, a request for expedited 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 expedited examination.

③ At least at one point among the date of filing an application, the date of request for expedited examination or the date of determination on expedited 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.

⑤ Where a request for expedited 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 expedited examination. Where the relevance between the claimed invention and the Inno-Biz is not confirmed, an examiner shall order the requester of the expedited examination to correct the request for expedited examination and when the relevance is well-explained, the request for expedited examination shall be recognized.

⑥ The relevance between the business type of the Inno-Biz and the claimed invention shall be confirmed with the explanation that a requester of expedited examination makes based on the evidential documents (such as business registration certificate, etc.) in a written explanation of request for

expedited 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 expedited examination, the examiner shall order to correct the explanation of request for expedited 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 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 expedited 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 expedited 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 expedited examination or date of determination on expedited 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 expedited examination is made, the invention shall not be deemed to be subject for expedited examination. Where the relevance is not recognized, the examiner shall deliver a notice to complement the request for expedited examination. Where the relevancy is explained, the examiner shall accept the request for expedited 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 content of the evidential document (business registration certificate, etc.) of the written explanation of request for expedited examination attached by the applicant. Where the relevance on the business type cannot be identified or accepted in determining whether to conduct expedited 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 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 expedited 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
- ④ Under Article 12(2) of 「Act on the Promotion of Science and Technology for Food, Agriculture, Forestry and Fisheries」 and Article 6 of Enforcement Ordinance of the same Act, a patent application regarding art accredited as new technology in the maritime and fisheries field.

(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 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 expedited 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 expedited 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 proceeding is being conducted before foreign patent offices based on the priority claim made on the concerned patent application

(2) Examination Guidelines

Where an application is filed with the Korean Intellectual Property Office and then is filed with a foreign patent office claiming priority, it shall be checked whether the application filed with the foreign patent office claims priority under the Paris Convention based on the application filed in Korea.

Where an application is filed with the Korean Intellectual Property Office and then a PCT application is filed based on the application claiming priority, a request for expedited 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.

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 expedited 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 expedited examination shall not be recognized since Application C is not the application which forms the basis of priority claim under the Treaty.

(3) Where a request for expedited 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 prior-filed application filed in the Republic of Korean and a PCT application can be deemed an prior-filed application and a later-filed application respectively. Then, the prior-filed 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 expedited examination has been made on the prior-filed application, the request shall not be recognized.

Where a request for expedited examination on a prior-filed application is filed, an examiner shall order to correct the request by indicating the ground for rejecting the request for expedited 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 The Claimed Invention of an Application practiced or to be practiced by applicant

(1) Subject

Where the claimed invention of an application is being practiced or to be practiced by an applicant and the patent application falls under any one of the followings, the patent application shall be deemed that the claimed invention of the application is being practiced or to be practiced by an applicant.

① Under Article 6 of 「Enforcement Ordinance of Act on Special Measures related to Promotion of Parts · Materials-Specialized Businesses」, a patent application filed by a company certified as a parts · materials-specialized company; provided, however, that the claimed invention shall be related to a parts · materials-specialized business, and that at least one of the patent applicants shall be a parts · materials-specialized company.

② A patent application with respect to an invention awarded in an open contest or a competition hosted/run by the government or a local government: provided, however, that the patent application shall be financially supported by the government or a local government for commercialization or for filing of a patent application.

(2) Examination Guidelines

① Definition of Practicing as a Business

a. The term “practicing” is identical with “practicing” as in the practicing by a person other than an applicant.

b. “practicing as a business” refers to “practicing as running a business”. In general, the personal/domestic practicing, the practicing for educational purposes, a practicing of one time for experiments shall not constitute the practicing as a business. Even for the one-time practicing for non-profit purposes, if the invention is being practiced as a business for the public interest, it shall constitute as the practicing as a business.

② Subject of Practicing

An applicant should practice or be practicing the invention. However, even though the practicing entity is not an applicant, if only the practicing entity engages in the agreement practicing the claimed invention with the applicant, the practicing by the practicing entity is eligible for expedited examination.

③ Determination on Practicing as a Business or Preparing to Practice as a Business

A requester of expedited examination shall explain that the claimed invention is being practiced (or being prepared to be practiced) and the practicing of the invention is carried out as a business in a written explanation of expedited examination and submit the evidential documents for both explanations.

An examiner shall conduct expedited examination on the claimed invention where the submitted explanation on expedited examination and evidential documents can confirm that the invention is being practiced or being prepared to be practiced as a business.

a. Determination on Practicing (or Preparation for Practicing) of Invention

An examiner shall recognize the practicing (or preparing for practicing) of the claimed invention where he/she can confirm that the claimed invention

is being practiced based on evidential documents such as the written explanation of expedited examination, photos of prototypes, catalogs, product manuals and samples.

b. Determination on Practicing (or Preparation for Practicing) of Invention as a Business

An examiner shall recognize the practicing(or preparing for practicing) of the claimed invention where he/she can confirm that the claimed invention is being practiced as a business based on the written explanation of expedited examination and the evidential documents. Evidential documents of the practicing of the invention as a business are the followings:

Example) Business License

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.

Agreement related to Practicing of Claimed Invention (Indication of Subject, Period, Place, and Condition of Practicing)

Lease-Rental Agreement

Evidential Document on Application of Component Material Technology Development Business

Other Evidential Document on Practicing of Claimed Invention as a Business

※ However, where a patent application is related to art which has requested to be accredited as new technology in the construction field under Article 14 of the Construction and Technology Promotion Act, as filing

a request for expedited examination, in the expedited examination request form, a document management number and concerned art should be recorded, and if a document relevant to actual inspection on the spot, for example, field-applicability or test data, is submitted as a evidential document, the patent application in question shall be deemed practiced or to be practiced. In this case, the examiner can check whether concerned art has already been requested to be accredited as new technology in the construction field, by referring to concerned data at the webpage (<http://ct.kaia.re.kr>) of the Korea Agency for Infrastructure Technology Advancement (KAIA).

⑥ Determination on Identicalness between Invention Being Practiced (or Prepared to be Practiced) and Claimed Invention

As for a request for expedited examination based on the practicing (or preparation to be practiced) of the invention, the invention being practiced and the claimed invention shall be identical. A requester of expedited 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 expedited examination as well as a written explanation of expedited examination. When the identicalness cannot be confirmed, an examiner shall order to correct a request for expedited examination.

⑤ Recognition of Application filed by Company confirmed as Component Material Technology Development Business

a. A request for expedited 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 practiced or prepared to be

practiced as a business without submission of the above-mentioned evidential documents as the claimed invention being practiced or prepared to be practiced.

b. The relevancy between parts-materials-specialized businesses and the claimed invention shall be determined based on proving documents (business license, and etc.) enclosed in the expedited examination request form, and if necessary, by referring to the total information network run by the Korea Institute for Advancement of Technology. In determining expedited examination, supplement shall be proposed if the relevancy between concerned business and the claimed invention cannot be checked or confirmed.

c. Where an application is jointly filed and one of the applicants is a component & material technology development business, the request for expedited examination on the application shall be accepted. However, the request for expedited 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 expedited examination or the date of determination on expedited 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 deemed to be identical with the original copy, the copy shall be accepted.

⑥ A patent application with respect to an invention awarded in an open contest or a competition hosted/run by the government or a local government: provided, however, that the patent application shall be financially supported by the government or a local government for

commercialization or for filing of a patent application

a. a patent application with respect to an invention which is financially supported by the government or a local government for commercialization or for filing of a patent application and which is awarded in an open contest or a competition hosted/run by the government or a local government shall be accepted for expedited examination, on the assumption that it is being practiced or to be practiced, without submission of any proving documents.

b. Determination of whether concerned application is relevant to an invention selected in an open contest or a competition host/run by the government or a local government shall be based on an expedited request form and enclosed proving documents(a certificate of merit, a certificate, a confirmation, and etc.). An invention selected in an open contest or a competition also can include creative idea or art.

c. An examiner shall determine whether the claimed invention is financially supported by the government or a local government for commercialization or for filing of a patent application on the basis of an expedited examination request form and proving documents(a confirmation, an awardee selection announcement, financial support document, and etc.): provided, however, that where all the inventions awarded in an open contest or a competition are benefited with commercialization or with patent filing and it can be proved in any other ways, the above mentioned proving documents do not have to be filed.

⑦ Determination of a patent application filed by a start-up

a. Under Article 4 of 「Support for Small and Medium Enterprise Establishment Act」, Article 11, 12 or 15 of 「Business Start-up Support Act」, in case of a patent application which is financially supported by the government with over 10 million won in view of technology development, commercialization, and etc. or which is filed by early stage startups funded by venture capital, cloud funding, angel investors, and accelerators with over 50 million won, it shall be accepted for expedited examination without submission of above mentioned proving documents, on the assumption that the claimed invention is being practiced or to be practiced.

b. Determination of whether a patent application in question is filed by a

start-up shall be based on an expedited examination request form and any proving documents, for example, a business license proving an early stage startup).

Ex1) Proving documents supporting that a patent application is filed by a startup funded by the Korea Institute of Startup & Entrepreneurship Development and the Korea Technology and Information Promotion Agency for SMEs for technology development and commercialization with over 10 million won (an agreement, affirmation documents, a project implementation confirmation, a final evaluation results confirmation, and etc.)

Ex2) Proving documents supporting that a patent application is filed by a startup funded by venture capital, cloud funding, angel investor and accelerator with over 50 million won (investment proving documents, i.e., investment performance certificate, investment confirmation, investment commitment, and etc.)

c. When it comes to a joint patent application, where name is different between a business and a patent applicant, the time period to determine proving documents shall be according to '⑤ a patent application filed by a business which was confirmed as a parts-materials-specialized business.

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 blocking access over the network, transaction verification technology, electronic signature or smart cards

④ Other patent application recognized for necessity of expedited 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 Expedited examination between KIPO Commissioner and Commissioner of Foreign Patent Office

4.14.1 Subject

A patent application for which KIPO Commissioner has agreed with the Commissioner of a foreign patent office to expedite examination, which fall under any of the followings, is eligible for expedited examination: (Note: Utility Model Registration Application is excepted) [Enforcement Decree of

the Patent Act 9(10), Internal Regulations 4(3)]

① A patent application of which the earlier date(hereinafter referred to as 'the earliest date') between the filing date of a patent application in the participating country and the priority date is identical to the earliest priority date for the patent application filed with KIPO, which fulfills the following conditions: (Participating countries: Japan, US, Denmark, England, Canada, Russia, Finland, Germany, Spain, China, Mexico, Singapore, Hungary, Austria, the European Patent Office(hereinafter referred to as the 'EPO'), Australia, Iceland, Israel, Sweden, Norway, Portugal, the Philippines)

A Ground for request	Requirements
A patent application for which KIPO Commissioner and the JPO Commissioner have agreed to conduct expedited examination	All the following conditions should be fulfilled: 1. After a patent application is firstly filed with the JPO, the same invention is filed with KIPO 2. A search report relevant to the patent application filed with the JPO can be obtained from a foreign patent office or an inter-governmental office
A patent application for which KIPO Commissioner and the Commissioner of the participating patent office have agreed to conduct expedited examination	All the following conditions should be fulfilled: 1. A patent application filed with a participating patent office(hereinafter referred to as "corresponding application") has at least one claim indicated allowable in an office action issued most recently from the date of request for examination 2. Where all the claims of a patent application filed with KIPO(hereinafter referred to as "concerned application") are identical to allowable claims of the corresponding application or where the claims of the concerned application are narrowed by either restricting or adding limitations to the allowable claims

② A patent application of which the earlier date between the filing date of an international patent application for which international search or international preliminary examination is performed in the participating country and the priority date is identical to the earliest priority date of the patent application filed with KIPO , which fulfill the following conditions: (participating countries: the Republic of Korea, US, China, Japan, Austria, Spain, Israel, the Nordic Patent Institute(NPI), Russia, the EPO, Canada, Finland, Australia and Sweden)

A Ground for request	Requirements
<p>A patent application for which KIPO Commissioner and the Commissioner of the participating patent office have agreed to conduct expedited examination according to Article 4(3)</p>	<p>All the following conditions should be fulfilled:</p> <ol style="list-style-type: none"> 1. An international patent application(hereinafter referred to as “corresponding international patent application”) for which international search or international preliminary examination is performed in the participating country, have at least one claim indicated allowable in view of novelty, inventive step and industrial applicability in the most recent results of an international phase examination , 2. Where all the claims of the concerned application are identical with allowable claims of the corresponding international application or where the claims of the concerned application are narrowed by either limiting or adding limitations to the allowable claims

4.14.2 Request for expedited examination in case that a prior art search report related to the concerned patent application is obtained from a foreign patent office or intergovernmental organization

This applies only when the application was firstly filed with the Japanese patent office and a requester of expedited examination shall submit the evidential documents corresponding to the following (1), (2), and (3).

(1) A copy of the prior art search report obtained from a foreign patent office or intergovernmental organization

Prior art search reports prepared by a foreign patent office or an intergovernmental organization (e.g., prior art cited in an office action 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 prepared by an external agency according to a request by a foreign patent office (e.g., reports prepared by the external agency according to a request by the Japanese Patent Office) shall be included.

※ A prior art search report prepared by a requester of expedited examination on his/her own or by an external agency 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 expedited 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 obtained from a foreign patent office or an intergovernmental organization.

(2) A copy of prior art document indicated in the above-mentioned prior art search report

※ Where a prior art cited in a prior art search report is a patent document, it does not need to be submitted since a patent examiner can easily obtain the patent document. As for a non-patent document, however, a requester of expedited examination is obliged to submit the concerned non-patent document and when not submitted, an examiner can order to submit the concerned non-patent document.

(3) Detailed explanation on comparison between the claimed invention and the disclosure of the above-mentioned prior art document

A requester of expedited examination shall compare the claimed invention of the concerned application and the disclosure of a prior art document and explain 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 document is cited, the explanation shall specify the cited part.

Where the content in the explanation is deemed to be insufficient, an examiner can order to supplement the explanation.

4.14.3 Request for Expedited Examination under Patent Prosecution Highway

The Patent Prosecution Highway refers to a program which enables an applicant who received positive decision on the claims from the office of first filing(OFF) that at least one claim is allowable to request expedited examination to the office of second filing(OSF) for the corresponding application which includes the claims identical to the allowable claims or the

claims narrowed by further restricting or adding limitations to the allowable claims. The PPH program allows the office of second filing to utilize the prior art search result and the examination results of the office of first filing. Where the participating country of the PPH has decided to conduct the PPH in accordance with the agreement made between the Commissioners of the concerned patent offices and subsequently posted it at its official webpage (patent/utility model system-the PPH), the country shall be acknowledged to participate in the PPH. As the participating countries can often be changed according to the agreement between the Commissioners of the concerned patent offices, it is desirable to check the information on the participating countries of the PPH on the homepage of KIPO.

※ The Republic of Korea has agreed the PPH with 25 countries (Japan, the United States of America, Denmark, England, Canada, Russia, Finland, Germany, Spain, China, Mexico, Singapore, Hungary, Austria, EPO, Australia, Iceland, Israel, Sweden, Norway, Portugal, the Philippines, Taiwan, Estonia, Colombia).

Meanwhile, from the patent applications filed for expedited examinations since January 1, 2014, as requirements for the PPH system are eased, where the earliest priority date of a patent application in a participating country(hereinafter referred to as a 'corresponding application') and the earlier priority date of a patent application filed with KIPO (hereinafter referred to as the 'concerned application') are the same, the patent application shall be eligible for the PPH program, not to mention the patent application which claims priority under the Paris convention to Korea based on the patent application filed in the first country. Specific cases for the PPH program are as follows:

- a. Where the concerned patent application claims priority under the Paris convention based on the corresponding application
- b. Where the corresponding application claims priority under the Paris convention based on the concerned patent application
- c. Where the concerned patent application and the corresponding application

share priority claim

d. Where the concerned patent application and the corresponding application are all the ones entering the national phase under the PCT without claiming priority

(1) Patent Prosecution Highway Requirements

① A patent application filed in a participating country corresponding to the concerned patent application shall contain claims that the patent office of the participating country decided to be allowable.

Claims that the patent office of the participating country decided to be allowable are as follows:

a. Claims indicated allowable in a written decision to grant a patent

b. In the absence of a written decision to grant a patent, claims indicated allowable in the most recent office action or decision to reject a patent

※ In case of a claim for which allowability is not explicitly indicated because a participating patent office did not indicate a ground for rejection, it can be deemed to have been determined to be allowable. However, in this case, a petitioner for expedited examination should explain a suitable reason in a written document.

※ Where a patent application in a participating country decided patentable by a participating patent office is not the application which serves as the basis of the priority claim, a requester of expedited examination shall explain the relation between 'the patent application in the participating country with patentable claims' and 'the patent application which serves as the basis of the priority claim for the concerned patent application filed with the Republic of Korea' in a written explanation of the request for expedited examination.

② All claims of the concerned patent application shall correspond to the claims decided allowable in a patent application filed in a participating 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 participating country recognized as allowable and it also includes where the concerned claims are narrowed by restricting or adding limitations to allowable claims of the corresponding patent application.

Where a category of claims of the concerned patent application and the corresponding application are different, the claims shall be deemed not be corresponding each other.

Where there are merely differences in translation or claim types (for example, independent claims, dependent claims), the claims of the concerned application and the corresponding application shall be deemed substantially the same.

Whether claims correspond to each other shall be determined based on a claim correspondence table that a requester of expedited examination submits with a written explanation of request for expedited examination.

③ Evidential documents necessary for request for expedited examination under PPH

A requester of expedited examination shall file a written explanation of request for expedited examination in reference to Annexed Form no. 3 of the Directive on Request for Expedited Examination on Patent · Utility Model and submit the following evidential documents.

a. 『A copy of the claims including claims that the participating patent office recognizes as allowable』 (referring to the claims pending at the time of the most recent office action by the participating patent office)

b. 『A copy of an examination-related notification on the corresponding patent application issued by the participating patent office』

※ Where an examiner can obtain 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 obtain the English or Korean translation through the information communication network, the translation do not need to be submitted.

c. A copy of prior arts relied upon in an examination-related notification (except for the case that prior arts are not relied on)

※ Where prior arts relied upon in an examination-related notification are patent documents, an examiner may easily obtain such prior arts and they do not need to be submitted. However, where prior arts are non-patent documents, a requester for expedited examination is obliged to submit the concerned non-patent documents. If not submitted, an examiner shall order a requester to submit the concerned non-patent documents.

d. Explanation on correspondence between 『Each claim of a patent application』 and 『Claims decided allowable』

Grounds for correspondence of each claim shall be indicated in a claim correspondence table. For example, when the claims of the concerned application are literal translations of those of the corresponding application, the statement that the claims are identical shall be indicated. Also, where mere differences in translation exist, correspondence of each claim despite such differences shall be indicated in a written explanation.

Unlike any other evidential documents, an explanation on claim correspondence must be submitted in any case.

4.14.4 Request for Expedited Examination under PCT-PPH

The PCT-PPH, Patent Cooperation Treaty-Patent Prosecution Highway, refers to a program where a request for expedited examination is allowed to be made for a patent application including the claims substantially identical with the claims recognized to meet the requirements for novelty, inventive step, and industrial applicability in an international search or international preliminary examination on an international application under the Patent Cooperation Treaty.

Where a patent office decides to participate in the PCT-PPH in accordance with the agreement between the Commissioners of the participating patent offices, and that the patent office posts it at its official webpage (Patent/Utility Model System-PPH), the patent office is acknowledged as a participant in the PCT-PPH program. As the participating patent office can often be changed in accordance with the agreement between the Commissioners of the patent offices, it is desirable to check the information on the participating patent offices for the PCT-PPH program at the KIPO webpage.

※ The Republic of Korea has signed the PCT-PPH with 25 countries (Republic of Korea, Japan, United States of America, Denmark, England, Canada, Russia, Finland, Germany, Spain, China, Singapore, Hungary, Austria, EPO, Australia, Israel, Sweden, Norway, Portugal, Iceland, NPI, the Philippines, Estonia, Colombia).

Meanwhile, from the patent applications filed for expedited examinations since January 1, 2014, as requirements for the PPH program are eased, all the concerned patent application which has the same earliest priority date with an international application for which international search and international preliminary examination is performed in the participating country(hereinafter referred to as a 'corresponding international application') are eligible to the PCT-PPH program. Specific cases for the PCT-PPH program are as follows:

- a. Where the concerned patent application is a national phase application of the corresponding international application
- b. Where the concerned patent application is an application which claims priority based on the corresponding international application
- c. Where the concerned patent application is a national phase application of an international application claiming priority based on the corresponding international application
- d. Where the concerned patent application is a national phase application of an international application claiming priority based on the corresponding

international application

e. A divisional application of the concerned patent application listed in A~D or an application claiming domestic priority to the concerned patent application

f. Where the concerned patent application and the corresponding international application share priority claim

(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 corresponding international application conducted in the participating countries shall include claims meeting requirements for novelty, an inventive step and industrial applicability.

※ Where the concerned patent application is not a national phase application of the corresponding international patent application, a requester of expedited examination shall explain the correlation between the concerned patent application and the corresponding international application in a written explanation on request for expedited examination.

② All the claims of the concerned patent application shall 'correspond to' the claims meeting requirements for novelty, an inventive step and industrial availability in an international search or international preliminary examination conducted by the participating countries.

The term 'correspond to' refers to the cases where both claims are substantially identical and where the claims meeting requirements for novelty, an inventive step and industrial applicability are further limited with the addition of limitations.

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.

Where a category of claims of the concerned patent application and that of claims of the corresponding international application are different, the claims shall be deemed not be corresponding each other.

Whether claims correspond to each other shall be determined based on a claim correspondence table that a requester of expedited examination submits with a written explanation of request for expedited examination.

③ Evidential Documents necessary for Request for Expedited Examination under PCT-PPH

A requester of expedited examination shall fill out a written explanation of request for expedited examination based on Annexed Form no. 6 of the Directive on Request for Expedited Examination on Patent Application · Utility Model Registration and submit the following evidential documents:

a. A copy of patent claims decided to meet requirements for novelty, inventive step and industrial applicability in an international search or international preliminary examination (The 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 on the corresponding international application

※ Where an examiner can easily obtain 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 other language than Korean or English, its translation shall be submitted as well. Where an examiner can obtain 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 document exists)

※ Where the cited prior art is a patent document, it does not need to be submitted since an examiner can easily obtain the document. However, if it is a non-patent document, a requester of expedited 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 document.

d. Explanation on correspondence between all claims of the concerned patent application and the Claims recognized to meet requirements for novelty, inventive step and industrial applicability in International Search or International Preliminary Examination

Grounds for correspondence of each claim shall be indicated in the explanation. For example, when the claims of the concerned patent application are literal translations of those of the corresponding international application, the statement that the claims are identical shall be indicated. Also, where mere differences in translation exist, correspondence of each claim despite such differences shall be indicated in a written explanation.

Unlike any other evidential documents, an explanation on correspondence 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) 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 expedited examination

When determining expedited examination on a patent application agreed for expedited 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 expedited examination. However, where a request for expedited examination is determined to be rejected, it shall be notified to a requester of expedited examination, just like any other requests for expedited examination.

A determination on expedited examination is not notified to a requester of expedited examination. Therefore, where an applicant amended, before examination is initiated after the determination on expedited examination, a specification with claims not included in the explanation on comparison with the prior art document; 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 decided to meet requirements for novelty, inventive step and industrial applicability in an international search or international preliminary examination, the examiner may instruct corrections for a request for expedited examination and re-determine whether to permit expedited examination considering the corrections made by the applicant. In such a case, an examiner may grant a correction order by designating a period of up to one month by his discretion.

Where an applicant submits a explanation on comparison between all the claims including the 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 correspondence explanation with the claims recognized to be patentable by a foreign patent office; or submit the correspondence explanation with the claims meeting requirements for

novelty, inventive step and industrial applicability in an international search or international preliminary examination, expedited examination shall be conducted without undertaking the procedure of re-determining expedited examination.

4.15 Application of utility model registration requested for examination upon filing and then requested for expedited 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 expedited 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 expedited examination once it is requested for examination upon filing the application of utility model and requested for expedited examination within two months from the filing date.

② A utility model application divided or converted from the prior-filed application cannot hold the retrospective filing date of the prior-filed application and a divisional or converted utility model application cannot be requested for expedited examination. Therefore, such applications are not eligible for expedited 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』

(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 expedited 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 expedited examination and the date of determination on expedited 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 expedited 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 expedited 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 expedited 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 specialization project are likely to be directly related and there are no special grounds, an examiner may recognize the application to be eligible for expedited examination without any further investigations.

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 expedited examination or the date of determination on expedited examination.

③ Inventions disclosed in applications requested for expedited 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 expedited examination without any further investigation.

4.18 Patent application commissioned to authorized prior art search institute for prior art search

(1) Subject

A requester of expedited examination shall request prior art search on the claimed invention to one of the authorized prior art search institute (Korea Institute of Patent Information, WIPS Co., Ltd., IP Solutions) designated by the Commissioner of the Korean Intellectual Property Office (hereinafter referred to as 'authorized prior art search institute') under Article 58(1) of the Patent Act.

① Patent applications whose search results by the concerned authorized prior art search institute is required to be notified to the Commissioner of the Korean Intellectual Property Office shall be eligible.

② The concerned authorized prior art search institute shall submit Search results under the Annexed Form no. 4 of the Directive of Request for Expedited Examination on Patent/Utility Model to the Commissioner of the Korean Intellectual Property Office within one month after the request for expedited examination.

※ Where the concerned authorized prior art search institute failed to submit a search report (for expedited examination) within one month from the date of request for expedited examination, 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 expedited examination, but also the concerned authorized prior art search institute.

(2) Basic Requirements

As for an application requested for expedited examination whose search report is submitted by an authorized prior art search institute, an examiner

shall make a determination on expedited examination. Where the claims to be examination are identical with the claims in the prior art search report, a request for expedited examination shall be recognized. Where the authorized prior art search institute failed to meet the guideline to write the report below-mentioned search report (for expedited 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 expedited examination.

Meanwhile, a written explanation of request for expedited examination shall be attached to make a request for expedited examination. However, as for a request for expedited 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 expedited examination including the information on the authorized prior art search institute and the date of request for prior art search is submitted, the ground for request of expedited examination is clearly explained and, therefore, an additional written request for expedited examination does not need to be attached.

※ Where expedited examination is determined to be conducted on a parent application based on the submitted prior art search reports by an authorized prior art search institute and all the claims of a divisional application in the search report of the parent application are already examined, a request for expedited 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 expedited examination with the contrastive explanation indicating that all the claims of the divisional application are identical with the claims of the parent

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 parent application drawn up by the authorized prior art search institute, an examiner shall make a determination on expedited 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 parent application by the authorized prior art search institute, 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 expedited examination. Where deficiencies are addressed after the correction order by submitting additional prior art search report of the authorized prior art search institute, etc., the examiner shall make a decision on expedited examination.

(3) Instructions on Drawing Prior Art Search Report (for Expedited Examination)

① Number of prior art document 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 document 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 document 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 document shall be separately described claim-by-claim in detail. However, the contents in the prior art document 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 document 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 indicated.

④ Other relevant cases

a. Where a specification is amended after a request for expedited examination is filed

Where a prior art search is commissioned to a authorized prior art search institute; a request for expedited examination is filed after the amendment to the claims; and then the prior art search is conducted by the authorized prior art search institute based on the pre-amended claims, the specification to be searched and the filed specification are different based on the time of request for expedited examination. Therefore, where a search report on the specification is re-submitted at the time of filing a request for expedited examination after the correction order, an examiner shall make a

determination on expedited examination.

b. Where a ground for request of expedited examination is changed due to the prior art search by authorized prior art search institute after the correction order of expedited examination

Since the ground for request for expedited examination can be changed while submitting the corrected documents, an examiner shall make a decision on expedited examination based on the legitimacy of the ground for change. However, since the ground for request of expedited examination is changed due to the prior art search by the authorized prior art search institute, an applicant shall indicate the date of request for prior art search and the name of the authorized prior art search institute in the corrected document and submit them. Then, the examiner in charge shall click 'Designation of Search Institution' on the window of 'Determination of Expedited Examination' so that the concerned prior art search report can be uploaded onto the system (Even when the written request for expedited examination contains the ground for request of expedited examination due to the prior art search by the authorized prior art search institute, but the written request for expedited examination does not specify the date of request for prior art search and the name of the authorized prior art search institute, an examiner shall undertake the same procedure and designate the search institution).

Meanwhile, in principle, a prior art search report for expedited examination shall be submitted within one month from the date of the request for expedited examination (as for super-expedited examination, within 10 days). Therefore, if the prior art search report is not submitted until the examiner makes a decision on expedited examination after the period for correction of the search report has elapsed, the examiner shall make a correction order once again.

4.19 A patent application filed by the aged or a terminally ill patient

(1) Target

A patent application filed by a person over 65 or a terminally ill patient as he/she may not take steps up to the final disposal, e.g. grant or refusal, of

a patent or a utility model registration without expedited examination

(2) Basic requirement

① Over 65 only is treated as the aged.

② A terminally ill patent shall be determined based on diagnosis or the doctor's note issued by a medical institution according to Article 3 of the Medical Act. However, a criteria for requirement is not specific name or seriousness of disease, but whether the health condition of a patent applicant prevents from taking steps for the examination procedure.

(Ex1) "The current health condition of the above mentioned patient is ~ , and the remaining lifespan is expected to be around 6 months" (Ex2) "The above mentioned patient is diagnosed with ~, and there is little possibility that he/she can recover from the disease."

(Ex3) "The above mentioned patient is diagnosed with ~, it is determined that he cannot follow necessary steps for examination procedures as he is under treatment."

Chapter 5. Reconsideration by Examiners before Appeal Proceedings

1. Relevant Provisions

Article 173 (Reconsideration by Examiner Prior to Appeal Proceedings)

(1) Where a person who received a decision to reject a patent application under Article 62 has submitted a notice of appeal under Article 132-3 and made an amendment in the specification or drawings attached to the application which is the subject of the request within thirty days after the submission of the notice, the President of the Intellectual Property Trial and Appeal Board shall notify the Commissioner of the Korean Intellectual Property Office before proceeding with the appeal.

(2) Where a notification referred to in paragraph (1) has been made, the Commissioner of the Korean Intellectual Property Office shall have the examiner reexamine the application which is the subject of the request.

Article 174 (Mutatis Mutandis Application of Provisions on Examination to Reconsideration by Examiner Prior to Appeal Proceedings)

(1) The provisions of Articles 51, 57 (2), 78 and subparagraph 1 through 5 and 7 of 148 shall apply mutatis mutandis to the reexamination under Article 173. In such cases, the terms "Article 47 (1) 2" and "an amendment" in Article 51 (1) shall read "Article 47 (1) 2 and 3" and "an amendment (in cases of Article 47 (1) 2, excluding an amendment that was filed before a notice of appeal against a decision to reject a patent application under Article 132-3)", respectively.

(2) The provisions of Articles 47 (1) 1 and 2 and 63 shall apply mutatis mutandis to the reexamination under Article 173 if grounds for rejection have been found that are different from those of the decision to reject a patent application. In such case, the term "it falls under Article 47 (1) 2" in the proviso of Article 63 (1) shall read "it falls under Article 47 (1) 2 or 3 (in cases of under 47 (1) 2, excluding that which was submitted before a notice of appeal against decision to reject a patent application under Article 132-3)".

(3) The provisions of Articles 66 and 67 shall apply mutatis mutandis to the reexamination under Article 173 if the notice of appeal is deemed reasonable.

Article 175 (Termination of Reexamination)

(1) If a ground for decision to reject a patent application is resolved as a result of reexamination under Article 173 (2), the examiner shall reverse his decision to reject the patent application and make a decision to grant a patent. In such cases, a notice of appeal against decision to reject a patent application shall be deemed as having been extinguished.

(2) If the examiner cannot make a decision to grant a patent as a result of reexamination under Article 173 (2), he shall report the result of his reexamination to the Commissioner of the Korean Intellectual Property Office without issuing another decision to reject the patent application. The Commissioner of the Korean Intellectual Property Office shall notify the President of the Intellectual Property Trial and Appeal Board after receipt of the report.

2. Purport

Under reconsideration by examiners before appeal proceedings, where a patent applicant files a notice of appeal against a decision to reject a patent application and submits any amendments thereto within 30 days from the filing of the notice, the case does not proceed with the appeal at once, but the examiner shall be directed to reexamine the amended invention.

Reconsideration by examiners before appeal proceedings is designed to protect inventions and to reduce the number of appeals by getting a patent granted more quickly, as grounds for rejection have been overcome through amendments, by directing an examiner who made the decision to reject the patent application to reexamine the application; provided, however, that amendments thereto shall be submitted within 30 days from the filing of the notice of appeal against a decision to reject.

(Note) A rejected patent application only can appeal against a decision

to reject. Every person who has failed to obtain a patent, namely, the patent applicant (the successor) included, can appeal against the decision to reject. Where a right for a patent is owned by joint owners, the joint owners all shall appeal against the decision to reject.

The time limit for submitting a notice of appeal against a decision to reject shall be within 30 days from a certified copy of the decision to reject being received. The President of the IPTAB can extend the time limit upon the request thereto or at his own discretion, for the convenience of the persons who live in remote areas (under Article 15 of the Patent Act). Any person who appeals against a decision to reject shall submit a "notice of appeal" in accordance with formality requirements under Article 140(2) of the Patent Act.

The patent applicant shall amend the specification or drawing(s) of a patent application within 30 days from the filing of an appeal.

3. Requirements for Reconsideration by Examiners before Appeal Proceedings

(1) A patent application subject to decision to reject only shall be reconsidered by examiners before appeal proceedings. Specifically, where a patent application is invalidated or returned, the application shall not be reconsidered by examiners before appeal proceedings.

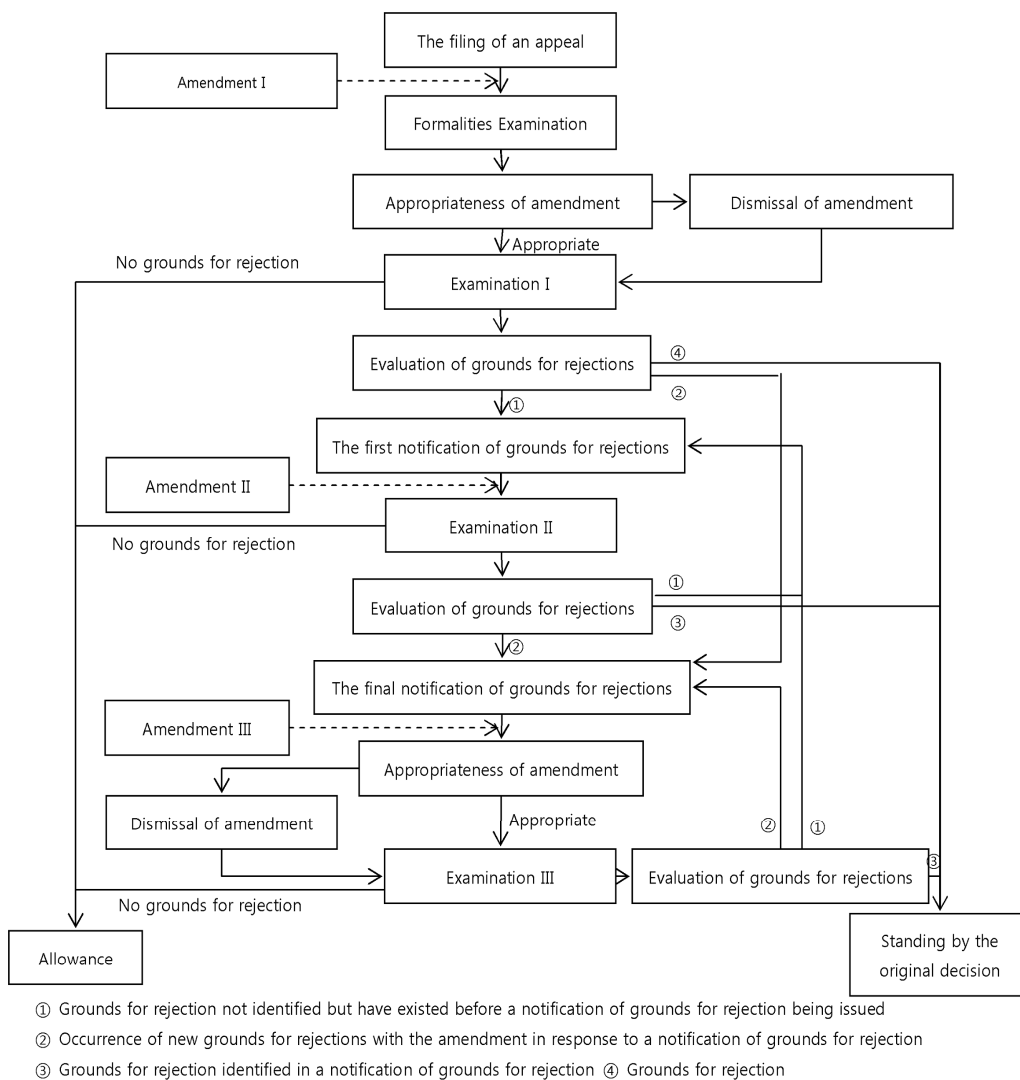
(2) A patent applicant, who received a certified copy of a decision to reject, shall request an appeal within 30 days from the reception of the certified copy under Article 132(3).

(3) An appellant shall amend the specification or drawing(s) of a patent application within 30 days from the filing of an appeal. As amendment hereto means formal amendment, even if the specification is not amended in a substantive manner, the amendment shall be subject to reconsideration by examiners before appeal proceedings.

4. Review process

Review process defined by this Article shall be applied only to the patent application filed on and after July 1, 2001. For the patent applications filed before June 30, 2001, as the scope of amendment is different and an

appeal against refusal to enter an amendment separately exist, in other words, different rules are applied, the Examination Guidelines applied until December 31, 2010 shall be consulted for specifics



4.1 Formalities Examination

(1) Where the trial policy division receives notification that the notice of appeal was filed against a decision to reject, it shall be input in the database and formality examination completed, and then the case forwarded to the patent examination bureau.

(2) Where a director of the primary division of the patent examination bureau receives the case from the IPTAB, he/she shall register the case in the database and hand it over to an examiner; provided, however, that this shall not apply to an electronic file.

In principle, an examiner, who made the decision to reject the patent application, should re-examine the case. However, where the examiner moves to another division so it is improper and unreasonable for the examiner to re-open the case, another examiner who is perceived as the right person for the case shall re-examine the case.

(Note) Where the notice of appeal is defective, but the President of the IPTAB misses the defect, and hands it over to an examiner to reconsider the case before appeal proceedings, the case, in principle, should be remanded to the IPTAB; provided, however, that where the defect is so minor that it can be easily rectified at the discretion of the President of the IPTAB or a Presiding Administrative Patent Judge and that the original decision stands, the President of the IPTAB or a Presiding Administrative Patent Judge shall not have to propose amendment thereon and in this case, the intent for upholding the original decision shall be communicated to the patent applicant.

4.2 Evaluation of Appropriateness of Amendment

(1) Amendment within 30 days from the filing of an appeal against a decision to reject shall be made corresponding to that of the final rejection necessitated by amendment.

① Amendment to the specification or drawing(s) within 30 days from the filing of an appeal shall be made within the scope of the matters described in the specification or drawing(s) originally attached to the patent application.

② Among amendments within 30 days from the filing of an appeal, the amendment to the scope of the claims shall fall under any of the followings:

1. Where the scope of claims is narrowed by restricting or deleting the claim, or adding an element to the claim
2. Where a clerical error is corrected

3. Where an ambiguous description is clarified

4. Where the amendment is beyond the scope of paragraph 47(2), to amend the claims so as to reinstate the claims before the amendment or to amend the claims in accordance with subparagraphs (i) through (iii) while reinstating the claims before the amendment

Criteria for evaluating requirements of and scope of amendment shall be referred to Chapter 2 of Part 4 under the Examination Guidelines.

(2) Where amendment within 30 days from the filing of an appeal against a decision to reject does not satisfy the aforementioned requirements or new grounds for rejection are arisen, the amendment shall be refused to be entered

4.3 Refusal to enter illegitimate amendment

(1) According to Article 174 of the Patent Act (applicable, mutatis mutandis, to Article 51), refusal to enter amendment within 30 days from the filing of an appeal shall fall under any of the followings:

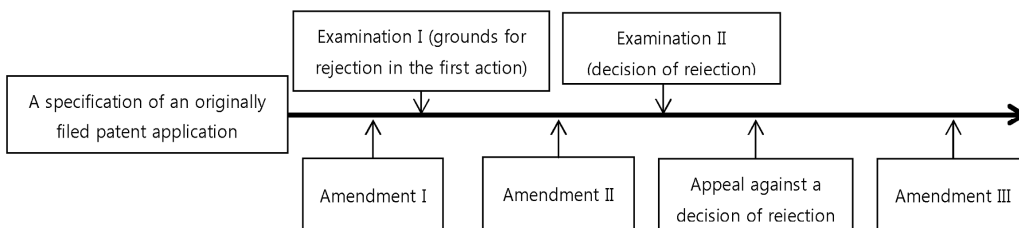
① Where the amendment does not comply with requirements for amendment under Article 47(2)-(3) of the Patent Act

② Where new grounds for rejection are deemed to be arisen from the amendment (“deletion of claim(s)” excluded among amendments according to Article 47(3), subparagraph 1-4)

(Note) Where grounds for rejection previously notified are not overcome by the amendment within 30 days from the filing of an appeal, as any new reasons for rejection are not arisen from the amendment, the amendment shall be accepted but the original decision stands. By the way, where grounds for rejection are not overcome by the amendment, but new grounds for rejection are arisen from the amendment, the amendment shall be refused to be entered and review be proceeded based on a specification before the amendment.

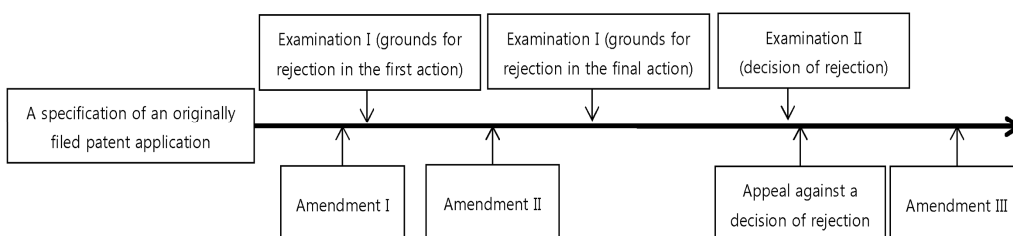
(2) An amendment as a comparison for evaluating appropriateness and inappropriateness of the amendment shall be as follows:

① Where the decision to reject is made after issuance of a notice of grounds for non-final rejection



Where examination is prosecuted based on amendment I and a notice of grounds for non-final rejection is issued, then review is proceeded based on amendment II and the decision to reject is made as notified grounds for rejection are not overcome, and that the applicant files a notice of appeal against the decision and submits amendment III subsequently, as for (a) introduction of new matter under Article 47(2) among requirements for amendment, it shall be evaluated compared with the specification or drawing(s) of the originally filed patent application, and as with (b) requirement for amendment under Article 47(3) of the Patent Act, it shall be evaluated compared with the specification or drawing(s) of amendment II. Specifically, whether the scope of claims is narrowed or not shall be determined by comparing corresponding claims between amendment II and amendment III.

② Where the decision to reject is made without refusal to enter amendment after issuance of a notice of grounds for final rejection necessitate by amendment



Where an examiner issues a notice of grounds for final rejection necessitated by amendment II, but the applicant does not submit amendment thereon, and the examiner finally rejected after review of the case, as grounds for rejection were yet overcome, and that the applicant submits amendment III by filing an appeal, the amendment concerned shall be evaluated the same as the above.

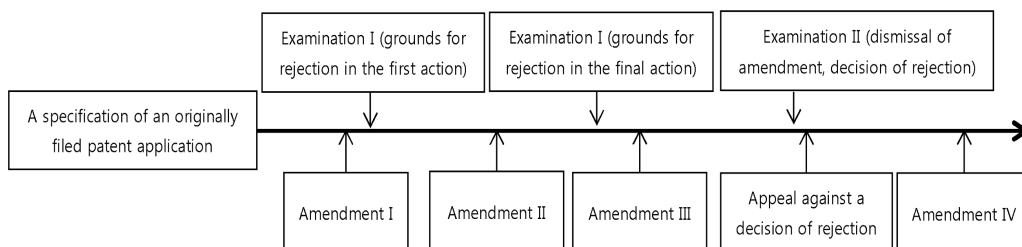
③ Where the decision to reject is made after refusal to enter amendment before filing a notice of appeal

Where as a result of review based on amendment II, a final rejection necessitated by amendment II is issued as grounds for rejection are arisen from amendment II, and as a result of review based on amendment III, it does not satisfy amendment requirements at that stage, thus it being refused to be entered, and review is proceeded again according to the claims of amendment II but grounds for rejection are determined not to be overcome, so the examiner made the decision to reject, then the applicant submits amendment IV by filing an appeal

(a) Where the applicant does not file an appeal against refusal to enter amendment, as for introduction of new matter under Article 47(2) among requirements for amendment, it shall be compared with the specification or drawing(s) of the originally filed patent application, and as with requirement for amendment under Article 47(3) of the Patent Act, it shall be evaluated compared with the specification or drawing(s) of amendment II. Specifically, whether the scope of claims is narrowed or not shall be determined by comparing corresponding claims between amendment II and amendment IV.

By the way, (b) where the applicant appeals against the decision to reject and refusal to enter amendment by indicating reasons for appeal in a notice of appeal, as for introduction of new matter under Article 47(2) among requirements for amendment, it shall be compared with the specification or drawing(s) of the originally filed patent application, and as with (b) requirement for amendment under Article 47(3) of the Patent Act, the amendment concerned shall be evaluated by comparing with the specification or drawing(s) of amendment II after finalizing amendments in combination of amended portions of amendment III and those of amendment IV.

(Notice) Where it is uncertain, as filing an appeal, whether the applicant files an appeal against refusal to enter amendment, the amendment concerned shall be evaluated with the presumption that an appeal against refusal to enter amendment is also filed.



4.4 Examination I – III

4.4.1 Criteria for issuing a notice of grounds for rejection to the patent application at the reconsideration process by examiner

According to Article 174(2) of the Patent Act applicable, mutatis mutandis, to Article 63 of the Patent Act, criteria for issuing a notice of grounds for rejection to the patent application at the reconsideration process are as follows:

(Article 63) Where an examiner is to make a decision to reject the patent application under Article 62, the patent applicant should be provided an opportunity to submit written arguments within the time provided upon the receipt of grounds for rejecting the application; provided, however, that this shall not be the case if falling under Article 47(1), subparagraph 2 or 3 (in case of subparagraph 2 of Article 47(1), “the amendment before requesting an appeal against a decision to reject a patent application under Article 132(3)” excluded) and the examiner is about to refuse to enter the amendment under Article 51(1) of the Patent Act.

The patent application at the review process shall be either notified with grounds for rejection or decided as the amendment being refused to be entered, depending on the following cases:

Amendments within 30 days after the filing of an appeal

(1) Where amendments within 30 days after the filing of an appeal are in violation of Article 47(2) or (3) of the Patent Act or new rejections are necessitated by amendments made in response to the previous report (the amendment to delete claim(s) excluded), the amendments shall be refused to be entered and review be based on a specification before the

amendment.

① Where amendments within 30 days after the filing of an appeal do not include reasons for refusal to enter amendments, but any grounds for rejection are identified during the reconsideration process which is not identified before the review, grounds for rejection shall be issued.

② In other words, where the patent application is rejected at the examination stage with any grounds for rejection not being identified, even though requirements for amendment are not satisfied, specifically, new matter is introduced before the review process, and that amendments within 30 days after the filing of an appeal do not address the grounds for rejection, the examiner shall notify grounds for rejection other than refuse to enter the amendments based on proscription of introduction of new matter.

(2) A notice of grounds for rejection at the review process

① Where any grounds for rejection exist before a first notice of grounds for rejection being issued at the examination stage, a notice of non-final rejection shall be issued,

② Where any grounds for rejection occur with the amendment in response to a first notice of grounds for rejection at or before the review process, a notice of grounds for final rejection necessitated by amendment shall be issued,

③ Where any grounds for rejection leading to both non-final and final rejection exist at the same time, a notice of grounds for non-final rejection shall be issued.

④ By the way, where the amendment responding to the examiner's report at the review process does not address any grounds that have led to the rejection, the original decision shall stand without grounds for rejection not being additionally notified.

4.4.2 Examination after notifying grounds for rejection

Examination after grounds for rejection being notified to the application at the review process shall be prosecuted in the same manner with a regular examination.

(1) As a result of reviewing the patent application at issue in consideration

of the applicant's arguments or amendments responding to a notice of grounds for rejection after the expiry of the time to respond set out when notifying grounds for non-final rejection,

① The patent application shall be determined to be allowable where grounds for rejection are addressed,

② The original decision shall stand where grounds for rejection are not resolved,

③ Where the grounds for rejection, which have existed before reasons for non-final rejection being issued, are identified again at the review process, a notice of grounds for non-final rejection shall be issued,

④ Where new grounds for rejection are introduced with the amendment responding to a notice of reasons for rejection, a notice of grounds for final rejection necessitated by amendment shall be issued.

(2) As a results of reviewing the patent application at issue in consideration of the applicant's arguments or amendments responding to a notice of grounds for rejection after the expiry of the time to respond set out when notifying grounds for final rejection necessitated by amendment,

① The patent application shall be determined to be allowable where grounds for rejection are addressed,

② Where amendments are in violation of Article 47(2) or (3) of the Patent Act or new grounds for rejection are introduced by the applicant with amendments made in response to the previous report (amendment "deletion of claim(s)" excluded), the amendments shall be refused to be entered and review be based on a specification before the amendment and where the grounds indicated in the final rejection are yet resolved, the original decision shall stand.

③ Where amendments do not include grounds for refusal to enter amendments, but grounds for rejection are yet addressed even after amendment thereon, the amendment shall be accepted, but the original decision shall stand,

④ Where any grounds for rejection, which have not been identified, are found, a non-final or final notice of grounds for rejection shall be issued.

4.5 Decision to Grant or Maintaining the Original Decision

(1) Decision to Grant

Where an examiner determines that a request for appeals is reasonable in view of the results of the reconsideration, he/she shall cancel the original decision and make a decision to grant (or decision to register the utility model), and a notice of allowance shall bear the notion of 'the original decision shall be cancelled' ahead of 'the decision to grant a patent (the utility model) is made' (Article 54(1) and (2) of the Patent Act).

(2) Maintaining the original decision

Where an examiner cannot allow a patent, he/she shall not make the decision to reject the application again, but report the results of the reconsideration to the head of the subgroup of the examination division and notify it to the applicant.

(3) Transmittal of a piece of the relevant documents or a file of the documents after examination

① Transmittal of a file of appeal documents regarding decision to grant

Where an examiner made the decision to grant a patent (to register the utility model) after the review process, he/she shall transmit a copy of a notice of allowance and a file of relevant appeal documents to the trial policy division of the IPTAB; provided, however, that this shall not be case to an electronic file (under Article 54(3) of the Patent Act).

② Transmittal of a file of appeal documents regarding maintaining the original decision

As to the patent application, which is at the reconsideration process, where a request for an appeal is withdrawn, and where the application itself is withdrawn or where the patent filing is abandoned and where the original decision stands, the examiner shall transmit a copy of results of the reconsideration and a file of trial documents to the trial policy division of the IPTAB; provided, however, that relevant electronic documents shall not have to be transmitted to the trial policy division of the IPTAB (under Article 53 and Article 54(4) of the Patent Act).

Chapter 6. *Ex-officio* re-examination

1. Relevant Provisions

Article 66-3 of the Patent Act of Korea (*Ex-officio* re-examination after grant)

(1) Where an examiner finds obvious reasons for rejection after grant with respect to a patent application in question, he/she can revoke the patent *ex-officio* and re-examine the concerned patent application(hereinafter referred to as "*ex-officio* re-examination". However, it shall not be the case if a patent application in question falls under any of the followings:

(i) Where grounds for rejection are corresponding to the requirement of Article 42(3)(ii) or (8) and Article 45

(ii) After grant, the patent is registered for establishment of right

(iii) Where the concerned patent application is withdrawn or abandoned

(2) For *ex-officio* re-examination by an examiner according to (1), the patent applicant should be notified that the decision to grant a patent shall be revoked.

(3) Before a patent applicant is notified in accordance with (2) of the same Article, where the patent application in question is subject to (1)(ii) or (iii) of the same Article, revocation of the patent shall be deemed to have not been made.

2. Summary of *ex-officio* Re-examination System

Where a patent examiner finds obvious grounds for rejection up until the registration of the patent after grant, as the patent examiner could not resume patent examination, defective patents have been registered as it were.

Ex officio re-examination by an examiner is introduced to prevent defective patents from being registered, thereby allowing a patent examiner to re-examine the granted patent if the examiner finds obvious and serious grounds for rejection even after grant.

However, as the stability of patent right can be harmed if the patent is revoked after the patent right is established by the payment of the patent

fee, *ex-officio* reexamination can be performed only before registration of establishment of right. And, as the patent examiner revokes the granted patent by *ex-officio*, the patent examiner should re-examine the concerned patent only when grounds for rejection are obvious.

3. Requirement of *ex-officio* re-examination

(1) Time-wise Requirement

If establishment of right is neither registered after grant nor the patent application is withdrawn or abandoned, the examiner can revoke the granted patent *ex-officio* and reexamine the patent in question [Article 66(3)(i) of the Patent Act of Korea]

(2) Substantive Requirement

Where a patent examiner finds obvious grounds for rejection, except for violation of background art description requirement, of description of claims and of violation of unity, with respect to an application for which decision to grant a patent is made, the examiner can reexamine the concerned patent application after revoking the decision to grant *ex-officio* [Article 66(3)(i) of the Patent Act]. The mere possibility of invalidation of a granted patent is not enough, and it is required that the granted patent should obviously be invalidated based on that ground for rejection.

4. Notes for *ex-officio* re-examination

(1) Where an examiner intends to revoke a granted patent based on an obvious ground for rejection, a patent applicant should be notified that the granted patent is revoked, with a consultation between 3 concerned persons, including a director of an examination division or a head of a concerned examination part and the other concerned person. [Article 66(3)(ii) of the Patent Act of Korea][Regulation 26(3)(i)]

(2) An examiner should issue a first office action based on an obvious ground for rejection with respect to why *ex-officio* re-examination should be performed as early as possible(7 days should not be exceeded to the maximum) from the date of notifying the revocation to a patent applicant so as for the patent applicant to file a written argument. The patent applicant

can amend a specification or drawing(s) within the scope of the specification as filed and drawing(s). [Article 47(1)(ii) of the Patent Act of Korea][Regulation 26(3)(ii)]

(3) Where a decision of reject is to be made based on the ground for rejection notified before the granted patent is revoked by *ex-officio* re-examination, a patent applicant should be notified again of a ground for rejection so as to have an opportunity to submit a written argument. [Article 63(1) of the Patent Act of Korea]

(4) Where an obvious ground for rejection is improper description of background art or where the claims is improperly formulated or where it is acknowledged that it is beyond the scope of unity of invention, *ex-officio* re-examination is not permitted. [Article 66(3)(i) of the Patent Act of Korea]

(5) Where a concerned patent application has been registered or withdrawn/abandoned before a patent applicant is notified that the granted patent is revoked, the revocation of the granted patent shall be deemed to have not been made, thereby *ex-officio* re-examination cannot be performed [Article 66(3)(iii) of the Patent Act of Korea]

(6) In case of *ex-officio* re-examination, the amendment before the revocation of the granted patent shall not be dismissed. [Article 51(1)(ii) of the Patent Act of Korea]

(7) Where relevant information is provided before its registration with respect to a granted patent, an examiner should review whether an obvious ground for rejection exists for the granted patent based on the submitted proving document(s).

PART VIII. Positive Examination Guideline

Chapter 1. Positive Examination by Suggesting Amendment

1. Overview

An Examiner may suggest amendments when notifying grounds for rejection so that an applicant can rapidly obtain a patent with a reasonable scope of protection.

2. Target Application

(1) An examiner can suggest amendments for an application meeting the following requirements ① to ③

- ① the invention should be understandable
- ② sufficient prior art search (except for the case that lack of description requirements of the specification prevents prior art search) is made
- ③ The claimed invention has a technical feature distinguished from prior art

(2) To maximize the effect of positive examination, it is recommended to focus on suggesting a proper scope of a patent rather than overcoming lack of descriptions requirements.

(3) Amendments shall be suggested simply and clearly. For an application without a representative, it shall be suggested in more detail.

3. Method to suggest amendment

When an examiner notifies the grounds for rejection, amendments are suggested in the section of the notice 'Advices on Amendment': provided, however, that the examiner should indicate related grounds for rejection in suggesting amendments in 'Advices on Amendment'.

3.1 Method to suggest amendment regarding novelty and inventive step

The examiner may suggest amendments for novelty and inventive step in the case of the following ① to ③:

① Where dependent claims are allowable, the examiner may suggest amendment of adding a technical element selected from the technical elements recited in the allowable dependent claims to a claim which needs to be amended while explaining the reason.

② Where no claim is allowable, but the description of the invention discloses a technical element which would differentiate the invention from prior art, the examiner may suggest amendments of adding the technical element disclosed in the description of the invention to a claim which needs to be amended while explaining the reason.

③ Where a dependent claim is allowable but the description of the invention discloses a technical element which would result in more reasonable scope of protection than the technical element of the dependent claim, the examiner may suggest amendments of adding the technical element disclosed in the description of the invention to a claim which needs to be amended while explaining the reason..

In case of ③, the examiner may suggest both amendments of adding the technical element disclosed in the description of the invention and the technical element of the allowable dependent claim. In this case, since redrafting of the claims may be necessary, the examiner may inform the applicant of the technical elements rather than suggest how to amend the claims in detail.

(2) The following examples show the appropriate suggestion of amendment when there are patentable dependent claims

(Example 1) Claim 2 depends from Claim 1. Only Claim 2 is patentable.

The examiner may suggest amendment of adding a technical element out of multiple technical elements recited in Claim 2 to Claim 1.

1. This is related to the grounds of rejection that Claim 1 lacks inventive step. Among the elements recited in Claim 2, a thermally-shrinkable ○○○ placed across Wale1 and Wale3, differentiates the invention from the prior art and the element will bring about the technical effect of improving ○○○ in ○○. Therefore, it is recommendable to add the element recited in Claim 2 to Claim 1 to overcome rejection for the lack of inventive step.

(Example 2) The following example shows suggestion of amendment by selecting technical element(s) from multiple elements in Claim 6 which is only patentable. Claims 1-5 lack inventive step.

1. This is related to the grounds for rejection that Claims 1-5 lack inventive steps. Among the elements stated in Claim 6, the element of ○○○ maintaining the state of rise is different with the prior art reference, and with the element, it is deemed possible to have technical effect transporting safely ○○○ without risk of damage even though the board is too thin by reducing the contraction process.

Therefore, it is recommendable to add the element stated in Claim 6 to Claim 1 to overcome the rejection for the lack of inventive step.

(3) The following examples show appropriate suggestion of amendment when no claims are allowable but there is patentable technical element(s) in the description of the invention.

(Example.1) A case to suggest amendment by selecting technical elements from the description of the invention while noticing grounds for rejection of all claims for lack of inventive step

1. This advice is related to grounds for rejection on Claims 1-5 which are rejected for lack of inventive steps. The element of ○○○ and ○○○

combining connection tube with screw (See, paragraphs [0121], [0122]) is stated in the description. With the element, not only ○○ tube is sliding with ○○ tube to possibly do assembly, but also rivet 1 and rivet 2 are not easily worn down even though they are removed from ○○ tube in several times. (See, paragraph [1023]) Therefore, it is deemed that the element is technically distinguished from the element of the prior art reference. It is recommendable to add combination of rivet with ○○ tube consisting of ○○ and ○○ to Claim 1 to overcome the rejection for the lack of inventive steps.

(Example 2) A case to suggest amendment by selecting technical element(s) from the description of the invention while noticing grounds for rejection of all claims for lack of inventive step

1. This advice is related to the grounds for rejection of Claims 1-5 without inventive steps. The effect that [000 and □□□ are separated from the body while spinning and bend toward the □□□ and to be restored, 000 is functioned as a fixer to fix itself immediately] is stated in the description of the invention. The effect is more technical than the prior art references. However, it is possible not to use the effect since Claim 1 states that the case of making it inside of body is also included. Therefore, it is considered to combine element as 000 consisted in one body by overhanging to the one side of outside of body of 000 from location formed and formation of 000 stated in paragraph [0123] and drawing 2 to 5 with Claim 1 to request for it as a independent claim.

(4) The following example shows how to select technical element and states its grounds from the disclosure of the description of the invention which has more appropriate technical element(s) to establish the scope of right than all elements of patentable dependent claims.

(Example) 1. It is related to grounds for rejection of Claim 1 without inventive step. The element that the part facing 000 in condenser

generating discharge between two 00 electrodes is thicker than the part facing 000 in one side toward the ground electrode is stated with Claim 2 (patentable claim) in the description of the invention. (See, paragraph [0012]) With the element, it is possible to get corona discharge and keep discharge of interior space from transforming ○○ mode. (For more details, see, paragraph [013]) For further amendment, it is recommendable to newly claim for invention adding said element to Claim 1 (limitation or add to existed claim or writing new claim, etc.) as well as to combine Claim 2 with Claim 1.

3.2 How to suggest amendment for indefinite claims

Amendment may be suggested to overcome rejection for indefinite claims.

(Example) 1. It is related to the deficiency in the claims pointed out in the grounds for rejection. It will be patentable if the word “high-speed” stated in Claim 1 is deleted or amended to “speed ranging from ○○ to ○○” as described in paragraph [0123] of the description of the invention.

4. Example for inappropriate suggestion of amendment

(1) The case to suggest amendment to patentable claims.

(Example) [Claim 4] (patentable) The display device according to Claim 1, wherein multiple ○○ between electrodes are equipped on transparent board and the two ○○ connected are horizontally equipped having ◇◇ in width

[Advice for Amendment]

The structure (repeatedly copied) - multiple ○○ between electrodes are equipped on transparent board and the two ○○ connected are horizontally equipped having ◇◇ in width - described in Claim 4 has no prior art related to inventive step currently. Therefore, it is recommendable to add this structure to Claim 1 to overcome the grounds for rejection under Article 4(2) of the Utility Model Act.

(2) The case to suggest amendment by excessively narrowing the scope of patent claim

(Example 1) [Advice for Amendment] It is recommendable to narrow the scope of claim by combining Claims 1 to 5 to overcome the grounds for rejection.

(Example 2) [Advice for Amendment] It is recommendable to add the element stated in paragraphs [0012]-[0020] in the description to Claim 1 to overcome the grounds for rejection.

(3) Ambiguous suggestion of amendment

(Example) Compared to the prior art reference, the present invention is characterized by oxidation unit, bubble water generator, and close connection of flow tube. Therefore, it is recommendable to combine the element with dependent claim to have inventive step.

-> The examiner suggests a way of amendment with the element of oxidation unit, bubble water generator, and close connection of flow tube, but the scope of the element is not specific. Therefore, it is not appropriate.

(4) Case to raise new grounds for rejection by following the suggestion of amendment

(Example) [Claim 2] Cutouts according to Claim 1, comprising connection piece for...

[Claim 3] Cutouts according to Claim 2, wherein the said connection piece has heat shield and ○○○ in its lower section

[Advice for Amendment]

According to the description, ○○○ effect is exerted by heat shield equipped in lower section of the connection piece. Therefore, it is

recommendable to add heat shield stated in Claim 3 to Claim 1 to resolve the grounds for rejection.

-> The suggestion of amendment possibly causes new grounds for rejection since the relation between connection piece and heat shield becomes ambiguous. Therefore, it is not appropriate. It will be more appropriate to suggest adding heat shield stated in Claim 3 to Claim 2.

(5) It is not appropriate to suggest introduction of new matter or broadening a claim when notifying the grounds for final rejection necessitated by amendment.

Chapter 2. *Ex officio* Amendment

1. Relevant regulations

Article 66-2 of the Patent Act (*Ex-officio* amendment) (1) As an examiner grants a patent according to Article 66 of the Patent Act, where he/she finds obvious errors in a specification, drawing(s) or an abstract, he/she can amend it *ex-officio* (hereinafter referred to as “*ex-officio* amendment”).

② If an examiner intends to amend a specification, drawing(s) or an abstract *ex-officio*, he/she should notify it to a patent applicant together with service of a certified copy of decision to grant in accordance with Article 67(2) of the Patent Act.

③ If a patent applicant cannot accept parts of or all of the *ex-officio* amendment, he/she should file a written argument with respect to the *ex-officio* amendment to the Commissioner of KIPO before a patent fee is paid in accordance with Article 79(1) of the Patent Act.

④ Where a patent applicant files a written argument as provided in paragraph 3, parts of or all of the *ex-officio* amendment shall be deemed not to have been made. In this case, the decision to grant shall be deemed to be revoked. However, where parts of or all of the *ex-officio* amendment with respect to an abstract attached to a patent application are only deemed to not have been made, the decision to grant shall not be deemed to be revoked.

2. Overview of *ex-officio* amendment

Where it is possible to grant a patent as a result of examination on a patent application, but obvious mistakes, such as clerical typo and inconsistency of reference numerals are found, *ex-officio* amendment by an examiner has been introduced in order to allow a patent examiner to correct simple mistakes without notifying a ground for rejection to a patent applicant and thus prevent delay in examination process and make the specification free of mistakes.

However, only obvious mistakes are allowed to be amended *ex-officio* so

that utilization and efficiency of *ex-officio* amendment were low because any ground for rejection, however simple and obvious it is, is not allowed to be resolved by *ex-officio* amendment, and particularly where any deficiencies were mistakenly introduced at the last stage of amendment even if it is an obvious mistake, the amendment shall be refused to be entered, thereby the patent application being rejected.

To solve such problems, on condition that a decision to grant shall be revoked if a patent applicant did not agree with *ex-officio* amendment, the scope of *ex-officio* amendment has been extended from March 2017 to allow an examiner to amend *ex-officio* the deficiencies which would be subject to grounds for rejection, if the deficiencies are considered obvious mistakes.

However, a patent applicant is in principle obliged to make out on the patent application, and as taking into consideration that Article 47 of the Patent Act of Korea strictly defines a person entitled to amend, time limits for and the scope of amendment, *ex-officio* amendment by an examiner should be complementally and not broadly applied as an exception to an amendment by a patent applicant.

3. Matters to be amended *ex-officio*

(1) 「Obvious mistakes」 in a specification, drawing(s) or an abstract defined by Article 66(2) of the Patent Act of Korea mean that a person skilled in the art should easily recognize that there are obvious mistakes in a specification, drawing(s) or an abstract, and that it can be easily anticipated how the patent documents are amended as the original intention of a patent applicant can be clearly understood in view of the specification, written argument and common general technical knowledge as filed.

(2) Matters to be amended *ex-officio* include standard Korean terms or a simple typo, an omitted word or inconsistency of drawing numerals and irregularities from which original intention of a patent applicant can be clearly found. Specific examples are as follows: however, if the intention of a patent applicant is not clearly understood, *ex-officio* amendment is not permitted.

- ① Misspelled word in violation of Korean grammar
 - (a) Semiconductor → 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 numerals
 - (a) In the description of the invention, Fig.2 Buffer (115) vs. In Drawings, Fig.2 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

Figure 1 is a cross section of regenerator

Figure 1 is a side view of regenerator → Figure 2 is a side view of regenerator

Figure 3 is a perspective view of regenerator
 - (b) Misspelled Reference numerals in the drawing

3...Gear 3...Motor → 3...Gear 4...Motor
- ⑥ Wrong indication of the representative figure

The representative figure is obviously wrongly indicated, considering the disclosure of the specification.
- 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 of the invention to make it correspond to that of the application. However, when the title stated in the application fails to satisfy the requirements for invention title under Part II, Chapter 2, 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.
- ⑧ Where the deleted claims are cited
 - (a) Where only a deleted claim is cited and only one antecedent claim exists

Claim 1. An apparatus including A and B

Claim 2. Deleted

Claim 3. An apparatus according to claim 2, further including C

→ An apparatus according to claim 1, further including C

(b) Where claims which have not been deleted are cited

Claim 1. An apparatus including A and B

Claim 2. Deleted

Claim 3. An apparatus according to claim 1 or claim 2, further including C

→ An apparatus according to claim 1, further including C

⑨ Where the subject matter of a dependent claim is different from the one of the citing claim

Claim 1. An apparatus including A

Claim 2. A method according to claim 1, further including B → An apparatus according to claim 1, further including B

⑩ Even though a dependent claim is combined into the cited claim, the dependent claim is not deleted

[Before amendment] Claim 1. An apparatus including A

Claim 2. An apparatus according to claim 1, further including B

[After amendment] Claim 1. An apparatus including A and B

Claim 2. An apparatus according to claim 1, further including B → Deletion

⑪ Where an identical element is referred to by using two or more terms

Claim 1. A method to form a semiconductor layer, including steps of, forming a nucleation layer and forming a silicon layer upon the nucleation layer → Claim 1. A method to form a semiconductor layer, including steps of, forming a nucleation layer and forming a silicon layer upon the nucleation layer

⑫ Where it is obvious to cite a claim wrongly

Claim 1. An apparatus including A

Claim 2. An apparatus according to claim 1, further including B

Claim 3. The apparatus according to claim 1, wherein B is C → The apparatus according to claim 2, wherein B is C

⑬ Where a literally identical claim is presented repeatedly

Claim 1. An apparatus including A and B

Claim 2. An apparatus including A and B → Deletion

⑭ Where cited claims are not indicated alternatively

a) ~ according to claims 1 and 2, → ~ according to claim 1 or 2,

b) ~according to claim 1 and at least one of claim 2 or claim 3, →
~according to any one of claims 1 to 3,

4. A procedure of *ex-officio* amendment

(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 grant a patent.

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 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 paragraph <20> in the description of the invention; "...signal ... transmitted ..."; "...signal ... transmitted to..."; obvious omission

2. 3rd line of Claim 3; "...Semiconductor Memory"; "...Semiconductor Memory"; obvious misspelling

Also, when the examiner describes where to amend *ex officio*, he/she shall indicate specifically using paragraph number or relevant line number 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 *ex officio* amendment in whole or part, he/she may submit the argument before the payment of patent fee, while selecting which matters amended *ex officio* the applicant would accept.

Where a patent applicant submits an argument, parts of or all of the *ex-officio* amendment where a written argument is filed shall be deemed to have not been made. In this case, the decision to grant a patent shall be

deemed to have been revoked so that an examiner shall reexamine a patent application concerned. However, where parts of or all of the *ex-officio* amendment made in an abstract are deemed to have not been made, the decision to grant a patent shall not be deemed to have been revoked [Article 66(2)(iv) of the Patent Act of Korea]

5. A re-examination procedure in response to non-acceptance of *ex-officio* amendment

(1) Where a patent applicant files a written argument stating that he/she cannot accept parts of or all of the *ex-officio* amendment, a patent examiner shall review the *ex-officio* amendment where a patent applicant has not accepted. In this case, where *ex-officio* amendment other than the one related to an abstract was not accepted, a patent examiner shall re-examine the patent application within 1 month from a written argument being transmitted. [Regulation 26(2)(i)]

(2) Where a patent examiner cannot find grounds for rejection by re-examination, he/she shall grant a patent or utility model registration. In this case, care should be taken that *ex-officio* amendment against which a patent applicant originally argues shall not be amended *ex-officio* again. [Regulation 26(2)(ii)]

(3) Where a patent examiner finds grounds for rejection from re-examination, he/she shall notify the grounds for rejection to a patent applicant. In this case, even though the ground for rejection had already been notified before *ex-officio* amendment, the notification shall be issued again. However, where the ground for rejection is relevant to *ex-officio* amendment where a patent applicant has not accepted and it has already been notified to a patent applicant, a patent examiner may make a decision to reject the patent application without notification.

Further, amendment before *ex-officio* amendment shall not be refused to be entered. This is to reduce the risk of unpredictability of a patent applicant who trusted that grounds for rejection have been overcome as a decision to

grant has been made.[Article 51(1)(i) of the Patent Act of Korea][Regulation 26(2)(iv)]

6. Note for *ex-officio* amendment

Obvious errors in a specification, drawing(s) or an abstract are subject to *ex-officio* amendment. Therefore, in addition to clerical errors, indefinite limitations in the claims or expressions in the description of the invention which fails to meet the description requirement may be subject to *ex-officio* amendment if it is an obvious error.[Article 66(2)(i) of the Patent Act of Korea]

(1) Care should be taken that the scope of the claims should not be changed by *ex-officio* amendment, and if there is a slightest possibility that claim terms may be construed in a different meaning, *ex-officio* amendment should not be made.

(2) When grounds for rejection are notified to a patent applicant, matters for *ex-officio* amendment should be notified all together so that a patent applicant may amend the matters accordingly. In this case, obvious errors which fail to meet description requirements shall be notified as a ground for rejection, and, a simple typo shall be notified as an advice of the examiner.

(3) The examiner should be careful not to add new matters which is not disclosed in the original 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) It is a principle that even if it is obvious that concerned matters are wrongly described, if a patent applicant's intention is not clearly understood by a specification and written arguments, *ex-officio* is not permitted.

(Ex) Where a claim is citing only deleted claims and there are plural antecedent claims, and it is not obvious which antecedent claim a patent applicant intends to cite other than a deleted claim, *ex-officio* amendment is not permitted.

(5) Where a patent applicant did not accept parts of the *ex-officio* amendment, the parts of the *ex-officio* amendment shall be deemed to have not been made in the first place, but the other parts of the *ex-officio* amendment shall be remained as it is. Therefore, care should be taken that the other parts of the *ex-officio* amendment shall not be notified as grounds for rejection. And where a decision to grant or a utility model registration decision is to be made again, it shall be confirmed that the other parts of the *ex-officio* amendment are reflected to the final amendment, and if not, *ex-officio* amendment shall be made again.

(6) As the number of claims shall be changed if a patent examiner intends to delete some claims by *ex-officio* on the ground that more than 2 claims are literally identical, the number of claims shall be corrected by *ex-officio* on the interface of the Patent Net for examination.

(7) Where a patent applicant did not or wrongly establish a main drawing with which subject matters of the claimed invention can be well explained, a patent examiner can replace the main drawing by *ex-officio* with another one with which subject matters of the claimed invention can be much well explained.

Chapter 3. Re-Notice of the Ground for Rejection

(1) Where a ground for rejection is notified and then the application is re-examined based on the amendment made in response to the rejection, but still the outstanding ground for rejection is not traversed, the examiner is supposed to make a decision to reject without notifying the ground for rejection again. However, where the applicant clearly indicated the intention of making an amendment to address the ground for rejection, but the amendment is failed to be included in the written amendment, the examiner may notify the same ground for rejection again under the certain conditions. The followings are the conditions under which the examiner can re-notify the same ground for rejection:

- ① Even though the purport and content of amendment to address the outstanding ground for rejection are clearly indicated in the written argument,
- ② the amendment is omitted from the written amendment;
- ③ if the amendment would have been included in the written amendment, the concerned ground for rejection is deemed to be overcome;
- ④ other outstanding grounds for rejection are all traversed, except for ground for rejection regarding the amendment omitted from the written amendment.

(2) The type of re-notice of the ground for rejection is the same as the type of the notice of the ground for the outstanding rejection. In other words, if the outstanding rejection is a non-final rejection, the re-notice of the ground for rejection shall be made as a non-final rejection. If the outstanding rejection is a final rejection such as a rejection necessitated by the amendment made in response to the previous rejection, the re-notice of the ground for rejection shall be made as a final rejection.

(3) Meanwhile, as for an application filed without a representative, where the applicant receives a ground for rejection, but indicates the intention of amendment only in the written argument 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.

Chapter 4. Preliminary Examination

1. Overview

Preliminary examination is a system to promote accurate examination and early allowance of a patent by sharing opinions between an examiner and an applicant on an application through interview before start of substantive examination.

By carrying out the interview, the applicant can increase possibility of a decision to grant through consultation with examiners about potential grounds for rejection and amendment before start of substantive examination. It also allows the examiner to conduct accurate examination with a help of technical explanations given by the applicant regarding the invention.

2. Details of preliminary examination

2.1 Application Eligible for preliminary examination

Preliminary examination can be carried out for an application for which an examiner has determined to expedite examination and which falls within the classification of a technical field requiring higher than average level of difficulties. Provided that, in case of an application to be examined under the PPH program, preliminary examination is conducted for an application for which an examiner has decided to expedite examination.

2.2 Persons who can request for preliminary examination

An applicant or an agent is allowed to request for preliminary examination.

2.3 Persons who can participate in preliminary examination interview

Those who are allowed to participate in the preliminary examination interview should have responsibility to respond to the application, including an applicant (If corporate, its representative), an agent for the application, or a subagent appointed by the applicant or the agent authorized to appoint a subagent.

However, for application handled by an agent, the agent shall participate in the interview. An inventor also can participate in the interview with a person having responsibility to respond to the application such as an applicant, an agent, a person approved for the interview, and so on.

Meanwhile, for an application assigned to assistant examiner, his/her supervising examiner shall participate in the interview together with the assistant examiner during the interview.

2.4 Contents of preliminary examination interview

Every matter can be discussed between applicant/inventor and examiner during the interview before substantive examination. It can help facilitating examination and also applicant/inventor to secure a proper scope of a patent.

During the interview, an applicant shall explain specific technical contents and differences with prior arts, etc. of the claimed invention to the examiner for accurate examination, and the examiner shall explain results of preliminary review on patentability of the claimed invention and deficiency of the description in the specification to the applicant so that the applicant rapidly responds by voluntary amendment, etc. before substantive examination. Also, each party shall proceed with discussion on how to amend the claimed invention to resolve grounds for rejection and to secure appropriate scope of a patent.

3. Procedure of request for preliminary examination and decision

3.1 Request for preliminary examination

Preliminary examination shall be requested within 14 days from the date of sending notice of decision on expedited examination. However, if an examiner issues office action such as notice of grounds for rejection prior to the request for preliminary examination, the interview will not be necessary. Preliminary examination should be requested for on the website, Patent-Ro (<http://www.patent.go.kr>) (Request for application → Request for preliminary examination), by the applicant. The applicant is supposed to fill in

information on petitioner, application number, desired interview date, interview participant, and contact number, etc.

Meanwhile, the applicant shall present 3 desired interview dates which fall within 3 weeks to 6 weeks (available period for interview) from date to request for preliminary examination together with candidate time period for interview, considering period for preparing presentation materials and for preview of examiner.

3.2 Decision on preliminary examination

3.2.1 Requirements to decide preliminary examination

Request for preliminary examination through the website is directly transferred to an examiner in charge.

If there is request for preliminary examination, an examiner shall decide or reject the request through the system, Patent Net, within 7 days from date to request for the interview.

Since preliminary examination is designed for accurate examination and early allowance of a patent having a proper scope of protection by sharing opinions through the interview between the examiner and the applicant, an application falling in the patent classification having high level of difficulty is eligible for preliminary examination to maximize the effect. Specific requirements for preliminary examination are as follows.

① Application having high level of difficulty

An application having higher than average level of difficulty based on degree of burden on examination is eligible for preliminary examination. It is possible for an examiner to check whether an application corresponds to one with high level of difficulty or not through determination screen of preliminary examination on Patent Net.

② Application decided for expedited examination

An application for which an examiner notified determination of expedited examination is eligible for preliminary examination. However, for an application examined under PPH program, an application for which an examiner determines to carry out as expedited examination. Also, whether to hold preliminary examination is determined considering the followings

based on contents of request for preliminary examination.

③ Date to request preliminary examination

Request for preliminary examination should be filed within 14 days from the date of sending decision on expedited examination. However, it is not permitted to request for preliminary examination when an examiner already has issued office action such as notice of grounds for rejection.

④ Interview participant

Interview participant includes an applicant, an inventor, an agent or a person authorized by the applicant or the agent for interview. If there is an agent for application, the agent is required to participate in the interview to make it more effective.

⑤ Desired interview date

To request for preliminary examination interview, it is necessary for applicant to choose 3 candidate dates falling within 3 weeks to 6 weeks from date to request interview with interview time.

⑥ Other requirements

Whether there are inappropriate reasons to carry out preliminary interview such as too broad scope of claim for interview, etc.

3.2.2. Accepting request for preliminary examination

An examiner shall accept request for preliminary examination of the application satisfying all requirements related.

An examiner shall select an interview date among desired interview dates submitted by an applicant when determining to carry out preliminary examination. After determination of preliminary examination, if an examiner requires prior art search of the application, it will be appropriate that the interview date shall be after a month from date to request preliminary examination to make preview possible based on the prior art search report before the interview. If all desired dates do not meet schedule of an examiner, it can be discussed to set a possible interview date with an applicant by phone.

Meanwhile, even though there is something which does not satisfy one of

requirements prescribed in [3.2.1 Requirements to decide preliminary examination], if possible, it will be appropriate to suggest a way to correct the grounds for return by discussing with an applicant and as such by phone. If it is decided that the grounds for return are resolved through the discussion, an examiner can ex officio accept preliminary examination without amendment of interview request form or submission of additional documents.

3.2.3 Return of request for preliminary examination

An examiner may return request for preliminary examination when the request does not meet one of the requirements prescribed in [3.2.1 requirements to decide preliminary examination], and it is not possible to correct grounds for return through consultation, etc. with applicant and as such.

Provided that, even though the request is returned, the applicant is allowed to reapply for preliminary examination interview by resolving the grounds for return during the period (within 14 days from the date of sending written decision of expedited examination) for requesting preliminary examination.

3.3 Delay or Cancellation of interview

If the interview cannot be carried out on the date due to the inevitable grounds caused by the applicant, an examiner shall give only one more chance to set up available interview date (within 3 weeks to 6 weeks from date to request preliminary examination interview) through consultation with the applicant and the change shall be notified to the applicant.

However, if an examiner determines that the grounds for delay are not acceptable, the interview can be canceled.

4. Procedure of preliminary examination interview

4.1 Preparation of interview

Before interview, an examiner shall read a claimed invention and review the requirements for patentability and deficiency in the specification, etc. The

review shall be comprehensively prepared to an extent comparable to that of substantive examination to explain clearly grounds for rejection and possible amendment to the applicant during the interview.

An examiner shall participate in the interview by preparing documents for application, result of prior art search, etc. which are necessary for interview. Also, the examiner shall prepare [Minutes of interview (for review of preliminary examination/collective examination/pre-amendment)] (Hereinafter referred to as Minutes), [Additional paper for the minutes of interview (for review of preliminary examination/collective examination/pre-amendment)] (Hereinafter referred to as Additional paper) to arrange matters discussed during the interview with applicant and as such after interview.

Meanwhile, it is appropriate to state result of preview of grounds for rejection in the minutes to give explanation to applicant and as such.

4.2 Identifying participant

Examiner shall identify each participant before beginning interview. Especially, for the unpublished application, identity of participant shall be checked by his/her identification number, etc. If participant refuses to follow the process, the interview can be limited to explanation of technology, etc. or giving result of preliminary examination within the documents prepared by the participants.

Provided that, if the interview is carried out in the government complex building, since the applicant for interview should leave their ID cards to information desk to pass the gate, it is recommended to check their identity before entering the building.

If the participant is different from the applicant who applied for the interview, the interview can be halted considering security of application documents and efficiency of interview, etc., or delayed or canceled considering period for start of examination. Or considering other participants in the interview, the scope of the interview can be limited.

4.3 Procedure in interview

Specific examples of contents discussed in the interview are as follows:

(1) Technical explanation of claimed invention (Subject: Applicant)

If it is expected to be difficult to understand the claimed invention since it is too complicated and advanced, or to be difficult to understand technical idea through only the disclosure of the specification or drawings (hereinafter, referred to 'specification, etc.')

etc., the applicant can help an examiner to understand the technology clearly by giving the examiner explanation about it directly.

At this time, the applicant is allowed to freely use prototype or multimedia materials (photo, video, etc.) etc. to help examiner understand the invention, and, if necessary, the examiner can require presentation materials mentioned above in advance and refer to them for the examination.

(2) Explanation about suggestion of preliminary amendment to specification, etc. (Subject: Applicant)

The Applicant can explain suggestion of preliminary amendment submitted in advance based on deficiency found by themselves or the result of prior art search carried out by the authorized prior art search institute.

At this time, the examiner can give opinion on the suggestion of amendment within allowed scope to be helpful to rapid and accurate examination when the applicant requires opinion on the suggestion of amendment to the specification, etc.

Meanwhile, the suggestion of preliminary amendment should be submitted to examiner in charge at least within 14 days before the interview for examiner to secure enough time for review. Therefore, the examiner may not give any opinion on the suggestion submitted after the period.

Also, voluntary amendment should be filed at least within 14 days before interview. If the amendment is filed after the period and examiner already finishes preview for preliminary examination interview, the examiner can proceed with the interview according to the specification, etc. submitted before filing of the amendment.

(3) Comparative explanation between claimed invention and prior art and argument for patentability (Subject: Applicant)

It is possible for the applicant to explain the claimed invention by comparing with prior art based on the result of prior art search submitted when requesting expedited examination or the result of prior art search conducted by the authorized prior art search institute and to argue difference between the claimed invention and prior art and patentability of the claimed invention based on the difference.

(4) Explanation of grounds for rejection to claim(s) and specification, etc.
(Subject: Examiners)

Examiners shall review about patentability of the claimed invention and deficiency in the specification, etc. before preliminary examination interview after determining whether preliminary examination is conducted or not, and the result of the review shall be explained to applicant and as such during the interview.

Also, if there is a proper way to resolve grounds for rejection, it will be appropriate for the examiner to actively suggest it to the applicant during the interview.

(5) Discussion on possible amendment to secure proper scope of patent
(Subject: Applicant/ Examiner)

The examiner and the applicant shall make effort to consult possible amendment to resolve grounds for rejection discovered in the claimed invention and to secure proper scope of a patent based on the advice on amendment and preliminary amendment proposed by each party.

Provided that, even though the examiner suggests an amendment according to his/her opinion, the examiner shall not order or lead the applicant to follow the opinion. The examiner shall explain that ① the suggestion has no legal binding force, so the final decision on amendment shall be done along with opinion and responsibility of the applicant; and ② the suggestion of the examiner can be changed according to new prior art or evidence discovered after interview, or amendment after interview.

Meanwhile, although simple contact for information, question of progress of examination, and process of patent, etc. can be included in interview

additionally, since these matters do not meet the purpose of the preliminary examination, it is not allowed for the matters to be main contents of interview.

4.4 Minutes of interview

The applicant and the examiner who participated in the interview shall prepare the minutes after finishing the interview and sign to prove checking the contents of the minutes. After signing, copy of minutes can be distributed to the applicant upon request. Meanwhile, the minutes with sign shall be uploaded to the system, Patent Net, to add it to examination history.

In the minutes of interview, interview date, place, application number, title of invention, name of participant, examiner's opinion on grounds for rejection, and suggestion of amendment discussed, etc. shall be stated.

(1) Stating opinion on grounds for rejection

'Opinion on grounds for rejection' is about results of review of the claimed invention conducted by examiner considering requirements for patentability and deficiency in the specification, etc. and applicant's response to it.

It is appropriate for the examiner to prepare the opinion on grounds for rejection in advance, and participate in the interview with it. However, it is a principle that grounds for rejection based on the result of review shall be orally explained to the applicant during the interview. Therefore, it is enough to state just the purpose of the grounds for rejection in the minutes of interview to be used as references during or after interview.

Argument of the applicant in response to the grounds for rejection stated by the examiner shall be described.

(Example) Opinion on grounds for rejection

Article	Claim	Examiner	Applicant
Art. 29(2)	1-3	It can be easily invented from the structure △△△ of cited invention 1	Accepted
	4-6	It can be easily invented based on combination of structure △△△ of prior art	It is not easy to combine prior art reference 1 with prior art reference 2 since

		reference 1 and structure ▲▲▲ of prior art reference 2	technical fields and objectives of each invention are different.
Art. 42(4) i	4	Numerical limitation of ☆☆☆ in claim 4 is beyond the numerical scope disclosed in the description of the invention. Therefore it cannot be supported by the description of the invention.	Accepted
Art. 42(4) ii	1	The meaning of ○○○ in claim 1 is ambiguous.	The meaning of ○○○ is clear since it is a widely used term in the art.

(2) Stating suggestion of amendment discussed

If the suggestion of amendment proposed by the examiner to resolve grounds for rejection is discussed by the examiner and the applicant, the result of discussion shall be stated in the minutes of interview to make it a record of examination. Although the result may include agreement on either suggestion of amendment or actual language of amendment, it is recommended to state all contents discussed and agreed in the minutes.

(Example 1) Contents stated if only suggestion of amendment agreed

1) Grounds for rejection: Related to inventive step of claim 1

Structure ◇◇◇ in claim 1 should be more specifically limited based on the description of the invention and Figure 5.

2) Grounds for rejection: Related to deficiency (Article 42(4) i) in claim 4

The numerical range of ☆☆☆ in claim 4 should be amended according to the numerical range disclosed in embodiment 1 of the description of the invention.

(Example 2) Specific language of amendment are agreed

1) Grounds for rejection: Related to inventive step of claim 1

Structure ◇◇◇ in claim 1 should be limited to a product operated with spinning of ⊙⊙⊙ combined with sawtooth on upper part of ◇◇◇ according to a sample taken by ◆◆◆.

2) Grounds for rejection: Related to deficiency (Article 42(4) i) in claim 4

the numerical range of ☆☆☆ in claim 4 should be limited to 50–60°C

Provided that, even though the examiner and the applicant have fully

discussed how to amend to resolve grounds for rejection, if there is no agreement reached, statement of amendment discussed can be omitted.

4.5 Finish of interview

The examiner may finish the interview when the object of the interview is considered to be accomplished through detailed explanations from the applicant on the claimed invention and explanations on results of preliminary examination prepared in advance, and when the minutes of the interview are prepared.

However, in the following cases, the examiner can finish the interview by notifying it to the applicant. In such a case, it is enough for examiner to fill only matters discussed before the interview is finished in the minutes of the interview.

- ① If the interview goes beyond the original purpose (If the main stream of the interview is about patent system or simple discussion on the process, regardless of application)
- ② If the applicant presents multiple preliminary suggestions of amendment and ask for examiner's opinion on them
- ③ If it is impossible to achieve agreement during the interview, or an examiner determines that there are some problems in communication
- ④ If the time of interview becomes unnecessarily longer than expected
- ⑤ If it is determined that it is impossible to have effective interview

5. Process after preliminary examination interview

5.1 Process for applicant

An agent (if not, applicant) shall prepare written amendment to the specification or arguments after interview by reflecting applicant's opinion on the amendment discussed.

The amendment stated in the minutes of the interview is a matter discussed between the examiner and the applicant. Although the examiner and the applicant discussed the amendment as indicated in the minutes of the interview, the applicant, however, can freely make amendment

regardless of the amendment stated in the minutes and submit written arguments in which applicant's opinion is stated.

If applicant wants to make amendment according to the amendment discussed during the interview (or voluntarily) before the start of substantive examination, the applicant should submit written amendment (if necessary, including written argument) within 10 days from the due date of the start of substantive examination(2 months from date to request preliminary examination (For PPH or expedited examination according to the request for prior art search conducted by the authorized prior art search institute, 4 months)) (Hereinafter referred to 'period for submitting written amendment of preliminary examination'). Provided that, if it is difficult for the applicant to submit written amendment within the period due to inevitable reason, it is allowed for the applicant to ask examiner for extension of the period by telephone.

Meanwhile, it is not permitted to present simplified arguments, assuming the discussions in the interview.

5.2 Process for examiner

5.2.1 Preparation for interview report (Adding interview minutes to examination history)

The Examiner shall prepare an interview report through patent system after finishing the interview to add the minutes prepared during the interview to the examination history.

To prepare interview report is a process that the minutes stated by examiner are computerized. Therefore, the computerized contents shall be identical to that of the minutes.

Meanwhile, in order to indicate clearly that the applicant confirms the interview contents, the minutes of the interview with a sign of the applicant shall be made as an image and added to the report prepared.

5.2.2 Start of substantive examination

The Examiner starts substantive examination based on contents (amendment discussed, etc.) stated in the minutes of interview when due date for start

of substantive examination has arrived. Provided that, the examiner shall postpone the examination until period for submitting written amendment of preliminary examination is expired.

After preliminary examination interview, if the written amendment is not submitted within the period, the examiner commences substantive examination within 2 months from date to request preliminary examination (For PPH or accelerated examination according to request for prior art search conducted by the authorized prior art search institute, 4 months).

After preliminary examination interview, if the written amendment is filed before taking up substantive examination, the examiner can proceed with examination within a month from receiving date of written amendment. [Rule 66(2)]

Principally, examiner shall proceed with examination based on amendment discussed with the applicant during the interview if any. However, after interview, if a new prior art reference was found through a new prior art search or deficiency in the specification which was not found during the interview was discovered, the examiner is allowed to make a decision which is different with contents stated in the minutes of interview. It can also be applied where it is discovered that grounds for rejection determined during the interview are wrong. Meanwhile, for simple grounds for rejection, it is possible to carry out examination after asking applicant to do voluntary amendment by telephone.

After final determination, examiner shall proceed with examination notifying grounds for rejection to the applicant as common examination process.

Chapter5. Pre-amendment communication

1. Overview

Pre-amendment communication is a system to exchange opinions on draft amendment between applicants and examiners through the interview before submitting amendment in response to the outstanding rejection. This contributes to giving applicants more opportunities to facilitate early allowance and helping examiners to carry out more accurate examination.

Two months (Period for submitting written amendment)

1 month / 1 week / 1 week / 1 week

A notice of grounds for rejection

Applicant / Examiner

Submitting draft amendment (at the same time with a request for pre-amendment communication)

Request for pre-amendment communication

Determining pre-amendment communication

Carrying out interview

Submitting written amendment

Expiration of period of amendment

2. Details of pre-amendment communication

2.1 Application Eligible for pre-amendment communication

Among applications with grounds for rejection notified by an examiner, an application for which arguments including amendment or draft amendment are submitted before a month from the expiration date of submission period for arguments may be eligible for pre-amendment communication.

2.2 Person who can request for pre-amendment communication

Applicants or agents are allowed to request for pre-amendment communication.

2.3 Person who can participate in pre-amendment interview

Persons who can participate in pre-amendment interview are as follows: A person, who is in charge of the application and can respond to office action, including an applicant (or representative of company), an agent, or a subagent appointed by the applicant or the agent empowered to appoint a subagent.

Provided that, for application represented by agent, the agent should participate in the communication. Inventor also can participate in the communication but he/she should be with an applicant, an agent, or a person empowered for the process, etc. who can respond to the office action responsibly.

Meanwhile, for application handled by assistant examiner, his/her supervising examiner also should participate in the interview.

2.4 Contents of pre-amendment interview

All matters that help to resolve grounds for rejection notified and to secure proper scope of right based on draft amendment submitted by an applicant can be discussed in the interview.

An applicant may explain that the amendment can resolve the grounds for rejection with technical explanations of the claimed invention, and an examiner may present his/her preliminary opinion on whether the draft amendment can resolve the grounds for rejection to applicant. Also, each participant proceeds with consultation about appropriate amendment to make the claimed invention secure proper scope of right.

3. Process of request for pre-amendment communication and determination

3.1 Request for pre-amendment communication.

A request for pre-amendment communication should be filed before a month from expiration date of the period for submitting written amendment pursuant to the Notice of grounds for rejection.

To file for pre-amendment communication, the applicant should visit the website, Patent-Ro (<http://www.patent.go.kr>), and fill applicant's name,

application number, desired interview date, participant, contact number, and whether to submit draft amendment, etc. in the form.

Meanwhile, considering period for preparation of explanation documents and period for reviewing draft amendment by examiners, the applicant should choose 3 days as desired interview date within 2 weeks to 3 weeks from date of request for pre-amendment communication together with the interview time.

3.2 Determination of pre-amendment communication

3.2.1 Requirements for pre-amendment communication

Request for pre-amendment communication filed via the website, Patent-Ro is transferred to the examiner in charge of the application.

If there is a request for pre-amendment communication, the examiner should accept or reject the request through the Patent Net within 7 days from the request date.

To make a decision on the request, examiner should consider the following requirements.

① Submission of draft amendment

It is necessary to submit draft amendment as in the form of amendment or argument before or at the time of request for pre-amendment communication. If there is a request for pre-amendment communication, the examiner should confirm whether amendment or an argument is submitted through prosecution history in the website, Patent Net. However, if it is impossible to check the prosecution history to confirm submission of either of the documents since it can be delayed to receive the documents in the process of formality examination, the examiner should contact Application Division or the applicant for confirmation before rejecting the request.

② Date of request

Request for pre-amendment communication should be filed before a month from the expiration date of submitting written arguments.

③ Interview participant

Interview participants may include an applicant (for corporation, representative of the company, employee of Technology development

division or division related to patent, etc. in the company), an inventor, an agent or a person empowered by the applicant or the agent for the interview process. Provided that, the agent of the application should participate in the interview, but an inventor, who is not applicant, is not allowed to participate in the interview without the applicant attending.

④ Desired interview date

A party who request for pre-amendment communication interview should present 3 interview candidate dates and the time in a request form. The date should be within 2 weeks to 3 weeks from date to request interview.

⑤ Other grounds

It should be confirmed whether there are inappropriate grounds to carry out pre-amendment communication interview such as filing for multiple pre-amendments.

3.2.2 Acceptance of request for pre-amendment communication

If the request for pre-amendment communication satisfies all requirements mentioned above, the examiner shall accept the request.

When determining to accept pre-amendment communication, the examiner chooses interview date among desired interview dates presented by the applicant. If it is impossible to carry out interview on any of the candidate dates, the examiner should make consultation about the interview date with the applicant by telephone and determine the date.

Meanwhile, even though the request does not satisfy one of the 「3.2.1 Requirements for determination of pre-amendment communication」, if it is possible to resolve the deficiency, it is appropriate for the examiner to discuss the problem with the applicant. If it is determined that the deficiency is addressed through the discussion with the, the examiner can *ex officio* accept the request for pre-amendment communication interview without amendment to a request form or submission of additional documents.

3.2.3 Return of request for pre-amendment communication

If the request for pre-amendment communication does not satisfy one of the 「3.2.1 Requirements for determination of pre-amendment communication」 and

it is not possible to resolve the deficiency through discussion with the applicant, the request can be returned.

However, it is allowed for the applicant to file for pre-amendment communication interview, which was rejected, again within the period of request for pre-amendment communication by resolving the deficiency.

3.3. Delay or cancellation of interview

If the applicant has an inevitable reason not to attend the interview, the examiner may give only one chance for the applicant to select another date among interview dates available within 15 days to 21 days from date to request interview by discussing with the applicant and the new interview date will be notified to the applicant.

However, if the examiner considers the reason inappropriate, the interview can be canceled.

4. Procedure of pre-amendment communication interview

4.1 Preparation of interview

The examiner should review whether grounds for rejection notified have been resolved, whether new grounds for rejection such as requirements for patent, deficiency in the specification, etc. occur, and so on based on draft amendment submitted. This review should be performed to an extent to comparable to examination to make it possible to explain clearly whether grounds for rejection are resolved, whether new grounds for rejection occur, and how to make an amendment, etc. to the applicant in the interview.

The examiner should participate in interview with application documents, draft amendment submitted, and results of preview, etc. which are necessary for the interview. Also the examiner should bring [written interview record for review of preliminary examination/collective examination/pre-amendment] (Hereinafter referred to written interview record) and [additional paper of written interview record for review of preliminary examination/collective examination/pre-amendment] (Hereinafter referred to additional paper) to write down matters consulted during the interview with

the applicant after the interview.

Meanwhile, it is recommended to state result of pre-amendment communication in the written interview record in advance to give appropriate explanation to the applicant in the interview.

4.2 Identification of participant

This process is same with 「4.2 Identifying interview participant」 of 「Chapter 4. Preliminary Examination」

4.3 Proceeding with interview

Specific examples discussed in the interview are as follows:

(1) Explanation of draft amendment submitted, etc. (by the applicant)

The applicant should explain draft amendment submitted to the examiner before (or at the time of) requesting for review of draft amendment. Whether grounds for rejection notified are resolved should be mainly explained and it is also possible to give technical explanations on the claimed invention and prior arts in cited references.

At this time, the applicant can freely utilize a sample or multimedia materials such as photo or video, etc. to make examiner understand the claimed invention. The examiner, if necessary, can require the interview materials in advance for examination.

(2) Explanation of result of pre-amendment review (by examiners)

After pre-amendment review is determined, the examiner should carry out preview about whether grounds for rejection are resolved based on draft amendment submitted before the interview, whether new grounds for rejection arise, and so on. The result of preview is explained to the applicant by examiner in the interview.

Also, during the interview, the examiner can suggest amendment to the applicant if the examiner believes amendment is necessary to resolve grounds for rejection or to secure appropriate scope of a patent.

(3) Consultation about amendment to secure proper scope of a patent (by applicant/examiner)

As a result of preview, the draft amendment cannot resolve grounds for

rejection notified or introduces new grounds for rejection, the examiner and the applicant should try to discuss how to amend to resolve grounds for rejection discovered and to secure proper scope of a patent for the claimed invention.

Even though the amendment proposed by the examiner is appropriate, the examiner cannot force the applicant to follow his/her opinion. Instead, the examiner should clearly explain to the applicant that ① the amendment proposed by examiner is not legally binding but only references, so final amendment should be determined by the applicant and ② the opinion of the examiner on the amendment may be altered in accordance with new prior arts or evidences discovered, or amendment after the interview.

4.4 Interview record

The applicant attending the interview and the examiner should prepare written interview record after interview and sign on the record sheet as a confirmation. Then the record with the sign should be uploaded in examination history of Patent-Net system.

Written interview record includes interview date, place, application number, title of invention, name of participant, result of pre-amendment review, and discussed amendment, etc.

(1) Stating result of pre-amendment review

'Result of pre-amendment review' includes result of preview conducted by the examiner reflecting draft amendment submitted by applicant, and response of the applicant to the result.

It is recommended that the examiner prepares written opinion about grounds for rejection of specification reflecting draft amendment in advance and brings it to the interview. Provided that, since the result of preview should be explained verbally to the applicant during the interview in principle, it can be enough, therefore, to state summary of grounds for rejection in the written interview record to be available during or after interview.

Opinion of the applicant on grounds for rejection stated in the record is response to grounds for rejection explained by the examiner during interview.

※ For stating 'Result of pre-amendment review', see example of 「4.4 Interview record」 of Chapter 4, Part VIII.

(2) Statement of discussed amendment

If the applicant agrees with the amendment proposed by the examiner to resolve grounds for rejection, the result should be stated in the written interview record to keep it in the examination history. The result can include suggestion of amendment or detailed draft amendment, etc. Therefore, it is proper to state all contents consulted and agreed in the written interview record.

※ For stating 'consulted method of amendment', see example of 「4.4 Interview record」 of Chapter 4, Part VIII.

Provided that, even though the examiner and the applicant have fully discussed how to amend to resolve the grounds for rejection, if no agreement is reached, statement of on amendment can be omitted.

4.5 Finish of interview

The examiner may finish the interview when the examiner considers the purpose of the interview such as sharing detailed opinion on draft amendment with the applicant is achieved, and when the interview record is prepared.

However, during the interview if it is considered that the interview corresponds to the following cases, the examiner may finish the interview by notifying it to the applicant. In this case, it is enough for the examiner to state only matters discussed before finishing the interview in the written interview record.

① If the interview goes beyond the original purpose (If the main stream of the interview is about patent system or simple consultation about the process which are regardless of the application)

② If the applicant suggest multiple draft amendments and ask for examiner's opinion on them

③ If it is impossible to achieve agreement during the interview, or the examiner determines that communication cannot be properly established

④ If interview time becomes unnecessarily longer than expected

- ⑤ If it is determined that it is impossible to have effective interview

5. Process after pre-amendment communication interview

5.1 Process for applicant and as such

The agent (if not, the applicant) should prepare written amendment of the specification or argument by reflecting applicant's opinion on consulted amendment after interview.

The consulted amendment stated in written interview record is a matter consulted between the examiner and the applicant. However, the applicant may freely make amendment regardless of the amendment stated in the written interview record and submit written argument in which applicant's opinion is stated.

If the applicant wants to make amendment according to the consulted amendment (or voluntarily) during the interview, the applicant should submit written amendment (if necessary, including written argument) until expiration date of period for submitting written amendment.

Meanwhile, it is not permitted to summarize the contents of written argument, assuming what is discussed in the interview.

5.2 Process for examiner

5.2.1 Preparation for interview report (Uploading written interview record on examination history)

The examiner should prepare interview report via Patent Net after finishing the interview to upload written interview record (「4.4 Interview record」) prepared during the interview on examination history.

To prepare interview report is a process that interview record prepared by the examiner is computerized, so its contents should be same with that of written interview record.

Meanwhile, to indicate clearly that the applicant confirmed the interview contents, the written interview record with a sign of the applicant should be made as an image to add to the interview report.

5.2.2 Further process of documents for office action

After interview, examiner conducts examination considering contents (consulted amendment, etc.) stated in written interview record according to the normal process and period of documents for office action.

Chapter6. Collective examination

1. Overview

Collective examination is a system to carry out examination collectively on a date an applicant desires for multiple applications of patent, utility model, trademark, and design relating to one product.

This system enables a company to obtain patents for the product at the desired time based on its strategy. So, it is possible to establish portfolio intellectual property before release of a new product to the market.

2. Details of collective examination

2.1 A person who can request for collective examination

A request for collective examination should be filed by the applicant of the application. In case there are more than 2 applicants for the application, it is necessary to select one of them as a representative in order to make a request.

2.2 Application eligible for collective examination

2 or more applications of patent, utility model, trademark and design for which substantive examination has not started yet and which satisfies the following (1) or (2), shall be eligible for collective examination. In this case, applications of patent and utility model are limited to an application for which a request for examination is made.

(1) Application relating to one product and satisfying any one of the following requirements

- ① Application that applicant is practicing or preparing for practicing
- ② Application directly related to export promotion
- ③ Application by a company confirmed as a venture business pursuant to Article 25 of 「ACT ON SPECIAL MEASURES FOR THE PROMOTION OF VENTURE BUSINESS」, or application by a company selected as a technological innovation-oriented small and medium enterprise pursuant to

Article 15 of 「ACT ON THE PROMOTION OF TECHNOLOGY INNOVATION OF SMALL AND MEDIUM ENTERPRISES」

④ Application related to development of self-employed creative enterprises pursuant to Article 11(1) of 「ACT ON THE FOSTERING OF SELF-EMPLOYED CREATIVE ENTERPRISES」

(2) Application related to development from identical national new technology development support project

3. Process of collective examination

3.1 Process flow

Applicant – Request for collective examination

Request for collective examination by designating a date for start of examination

Patent Office – Formality examination

Notifying result of the request after carrying out formality examination

Applicant + Patent Office – Presentation for collective examination

Explaining information of technology and business to examiners; in case the request for preliminary examination was made, proceeding with preliminary examination

Patent Office – Carrying out examination

Collectively Starting examination at the time applicant desires

3.2 Request for collective examination

(1) A petitioner to request for collective examination (Hereinafter referred to as 'petitioner') is required to fill out request form of collective examination via website, Patent-Ro (Request for application – Request for collective examination), and to attach additional certified documents stated in 「Notification of request for collective examination」. Provided that, documents proving applications for patent, utility model or design are being practiced or in preparations for practicing the applications may be submitted by showing them to an examiner in charge of collective

examination (Hereinafter referred to as 'Examiner in charge') during the presentation.

(2) The petitioner should designate a desired candidate date for presentation for collective examination from 7 days to 14 days after date to request collective examination. The petitioner should designate a desired date for start of collective examination after 14 days from the desired date of the presentation, and a desired date of finishing examination within a year after 3 months from desired date for start of collective examination.

(3) If an applicant wants preliminary examination, it can be allowed when filing for collective examination.

(4) After the request, it is acceptable to withdraw some applications among applications for collective examination but it is not allowed to change or add some applications.

3.3 Formality examination of collective examination

(1) Official in charge of collective examination (Hereinafter referred to as Official in charge) should confirm whether applications requested for collective examination are eligible for collective examination and the request proceeding itself satisfies the procedural requirements.

(2) Official in charge should notify that the petitioner should amend request form of collective examination within 6 days from date to request collective examination if the request does not satisfy the requirements. In this case, the official in charge should let the petitioner know that if the amendment is not made within the period, the request cannot be permitted or the application which is not amended can be excluded from the examination.

(3) Official in charge should select holding date of collective examination presentation by consulting with the petitioner and the examiner in charge based on desired candidate date proposed, and then notify the date to the petitioner and the examiner in charge.

3.4 Presentation for collective examination

(1) The petitioner should participate in collective examination presentation at the holding date confirmed, explain the application for collective examination

to examiner in charge, and explain that the application is related to one product.

(2) Official in charge of and the examiner in charge should have consultation about whether the application satisfies the requirements for collective examination, and determine whether collective examination can be conducted and which application is eligible for collective examination. Official in charge, the examiner in charge, and the petitioner can discuss and determine a starting date of examination and a finishing date of examination based on desired date for start of examination and desired date of finishing examination. Official in charge should notify matters determined to the petitioner.

(3) If there is a request for preliminary examination when filing for collective examination, process during a preliminary examination interview and after the interview is same with 「4. Procedure of preliminary examination interview」 and 「5. Process after preliminary examination interview」 of chapter 4, Part VIII.

(4) If the expected date of start of examination for application of patent or utility model is more than 3 months earlier than desired date of start of examination for each application of collective examination in the order of receipt, official in charge can require applicants to file for expedited examination of application within the period designated by official in charge. If it is more than a month earlier than expected date of start of examination for trademark/design applications, official in charge of collective examination also can require applicants to file for expedited examination of application within the period designated by official in charge.

Despite the request for expedited examination, if the request is not within the period, or an application for expedited examination is trademark application which is excluded from practicing or preparation for practicing, it is deemed to be excluded from the collective examination.

(5) If request for collective examination of applications for patent or utility model registration is filed, for expedited examination according to the applications which are practicing or in preparation for practicing, it will be acceptable to submit one of the following documents to prove its practicing

or preparation for practicing:

① Full-size photograph of test product, sample, catalog with full-size photograph, etc.

② Investment records from Venture capital firm or new technology project investment cooperative, etc.

③ Loan records from financial institution, etc.

④ Contract about practice of application technology

⑤ Other documents proving preparation of practicing

(6) If the request for expedited examination is filed for application for patent, utility model registration, or design registration filing for collective examination, submission of evidential documents proving its practicing or preparation for practicing can be substituted for being read by examiner in charge. When the examiner reads the evidential documents of application for collective examination to be substituted for submission of the documents, the examiner should state reading date, place, and the contents on the examination report.

3.5 Proceeding with collective examination

Examiner in charge should start collective examination on the expected date of start of examination. Also, the examiner should finish dealing with any documents submitted during the examination until expected date of finishing examination. There can be exceptions, however, if there are inevitable reasons such as searching prior art additionally or notifying grounds for rejection again because of new grounds for rejection discovered, etc.

Part IX. Examination Criteria by Technology

Chapter 1. Biotechnological Inventions

Revised and managed by Biotechnology Examination Division

This chapter is applied to inventions relating to genetic engineering and biological materials such as genes, DNA fragments, vectors, proteins, antibodies, microorganisms, animals, plants, etc.

1. Requirements for the Description and Claim(s)

1.1 Requirements for the description of the invention

In regard to an invention of a gene or a protein encoded by the gene, a specific, substantial and credible utility should be stated in the description of the invention.

(Note) As for an invention of chemical substances such as genes, the requirements for description under Article 42 (3) of the Patent Act involve a well-established utility of the invention. To carry out the invention of chemical substances, a person skilled in the art must be able to make and use the claimed invention in view of the level of skill in the art as of the filing date of the application, and a utility of the invention should be clearly and sufficiently stated in the description since the substance of the claimed invention cannot be used without clear and sufficient description. (See, Verdict 2007HEO5116 sentenced by the Patent Court, September 26, 2008)

1.2 Requirements for Claim(s)

(1) Genes and DNA fragments

① A gene and a DNA fragment should be described by specifying the sequence thereof.

(Note) In regard to an invention relating to a gene, which may produce a functionally different protein as a result of a single base substitution, a gene should be described in the claim by a specific polynucleotide sequence, and the expression 'a sequence having ~% homology with a specific reference sequence' in the claim is not permitted in principle. However even if broadening the scope of protection is attempted by such an expression

'sequence having ~% homology with a specific sequence' set forth in the claim, the claim language is not considered unclear in case that the description of the invention provides a solid evidence to support that a DNA sequence with a novel utility is discovered and its variants of having a certain homology with the DNA sequence contain the same activity. (See, Verdict 2001HEO1006 sentenced by Patent Court, May 30, 2002)

② A structural gene may be described by specifying the amino acid sequence of a protein encoded by said gene.

③ Genetic variants: When the expressions 'deletion', 'substitution' or 'addition' are used along with the disclosure of a sequence, the position and the content thereof should be specifically disclosed.

If examples of genetic variants are provided in the description of the invention, it is permitted to define the invention in the claim by limiting the function of the gene and the scope of the variant. However, even in this case, merely describing the actual hybridization conditions is not considered sufficient enough to specify the scope of the genetic variants. (See, Verdict 2007HEO289sentenced by Patent Court, May 29, 2008))

(2) Proteins and recombinant proteins

① A protein and a recombinant protein should be described by specifying the amino acid sequence or the nucleic acid sequence of the structural gene encoding said protein.

② A protein variant: When the expressions 'deletion', 'substitution' or 'addition' are used, the position and the content should be clearly described. If there are specific and sufficient examples of a protein variant in the description of the invention, it is permitted under exceptional circumstances to describe the invention by limiting the function of said protein and the scope of the variant. (See, Verdict 2005HEO1998 sentenced by Patent Court, March 9, 2006)

③ When a protein could not be specified by its amino acid sequence, a protein may be described in the claim by limiting all of functions, physiochemical properties, the origin or source of the protein and the method for producing said protein. In this case, there should be reasonable

grounds for that the protein cannot be specified by its amino acid sequence.

(3) Monoclonal antibodies

A monoclonal antibody should be described, in principle, by specifying the amino acid sequence in the variable region of a heavy chain and a light chain or the nucleic acid sequence encoding it, by specifying an antigen recognized by the monoclonal antibody or a hybridoma which produces the monoclonal antibody.

However, if an antigen is novel and involves an inventive step, specifying the antigen may be recognized as specifying a monoclonal antibody.

(4) Examination of application relating to plant invention filed before September 30, 2006

For applications relating to plant invention filed before September 30, 2006 under Article 31 of Old Patent Act*, a plant variety capable of asexual reproduction is the only patentable subject matter among the plant varieties. It is required for the inventions of a plant variety itself or its part to describe the method of asexual reproduction in the claim.

* Article 31 of Old Patent Act (before revised Act No. 7871, March 3, 2006): Any person who invents a plant variety capable of asexual reproduction may obtain a patent for the invention.

1.3 Unity of Invention (See Part II. Chapter5. Unity of Invention)

Whether an invention fulfills the requirements for unity of invention depends on the degree of disclosure of the prior arts.

Examples of determining unity of biotechnological inventions are as follows:

(Example 1)

[Claim 1] Bacillus DNA A consisting of SEQ ID NO. 1

[Claim 2] Bacillus DNA B consisting of SEQ ID NO. 2, of which function is different from the function of DNA A

There is no unity of invention because the same origin (Bacillus) is not considered as a special technical feature.

(Example 2)

[Claim 1] A polynucleotide consisting of nucleic acid sequences of No. 1

[Claim 2] A polynucleotide consisting of nucleic acid sequences of No. 2

According to the description of the invention, the two polynucleotides are 500bp cDNA, a part of a structural gene originated from the cDNA library of human liver tissue, but not homologous to each other. Said polynucleotides can be used as a probe to obtain a full-length cDNA, respectively. A polynucleotide isolated from human liver tissue is disclosed in prior art. In this case there is no unity of invention because there is no special technical feature shared between the two inventions.

(Example 3)

A polynucleotide consisting of SEQ ID No. 1, wherein said polynucleotide comprises one selected from the group of SNPs (Single Nucleotide Polymorphisms) located at the position A, B, C and D, respectively

- Said polynucleotide of SEQ ID No. 1 is 6500 nucleotide long, of which nucleotide sequence has been disclosed in the prior art, and a specific function of the said polynucleotide and individual features of SNPs at each position are yet to be elucidated: Since the polynucleotide of SEQ ID No. 1 is disclosed in the prior art and said SNPs are not functionally relevant to each other, inventions of each SNP located on the same gene fail to comply with the requirements for unity of invention.

- Said polynucleotide of SEQ ID No. 1 is disclosed in the prior art and each SNP is described in the description to involve a common specific function: The same or corresponding technical feature is the SNP of the polynucleotide sequence relating to the specific function. If prior art search demonstrates that such a feature does not make a contribution over the prior art and claimed SNPs may be used as an alternative to the SNP disclosed in the prior art, inventions of each SNP set out in the claim do not meet the requirements for unity of invention.

(Example 4)

An oligopeptide capable of binding to gene A, wherein said oligopeptide is at least one selected from the group of VEGFL, ADEGFL, KEGFP and

QWEGFG.

According to the description, all oligopeptides set forth in the claim are capable of binding to gene A and a common structural feature of the EGF motif in the oligopeptides plays an important role in binding to gene A. Prior art search demonstrates that there is no known oligopeptide with said structural feature and said function. In this case the same or corresponding special technical feature is the oligopeptide having the EGF motif capable of binding to gene A, which is considered making a contribution over the prior art. Therefore the claimed oligopeptides meet the requirements for unity of invention.

(Example 5)

Peptides for enhancing absorption of intestinal epithelial cells characterized by having an amino acid sequence selected from the group of CNPASSQLC, CTGPHSFHS, CSSHKSTYC and CQPMNSLTC.

If specific peptides and/or motifs that pass through the intestinal epithelium and bind to intestinal M cells are already known in the art and there are neither sequence homologies nor structural similarities among the claimed peptides, the only common technical feature shared by the claimed peptides is the function of passing through the intestinal epithelium. Since such a function is already known in the art, the claimed peptides fail to fulfill the requirements for unity of invention.

2. General requirements for patentability

2.1 Utility

In regard to inventions involving genes, DNA fragments, antisense, vectors, recombinant vectors, transformants, fused cells, proteins, recombinant proteins, monoclonal antibodies, microorganisms, animals, plants, etc., if no specific, substantial and credible utility is asserted in the specification and none is inferred therefrom, the invention is not considered to be industrially applicable as set forth in the provisions of Article 29(1) of Patent Act.

(Note) In general the object of a chemical substance invention is to provide a chemical substance which is industrially applicable, the constitution of the invention is the chemical substance itself, and its effect is to provide an

industrially applicable chemical substance. However, in case the chemical substance is a natural product such as a gene, mere discovery of its existence is hardly recognized as an invention. To be considered as industrially applicable invention, a utility is newly discovered and a novel technical matter that has not been disclosed in the prior art should be presented (See, Verdict 2007HEO5116 sentenced by Patent Court, September 26, 2008).

(1) If the specification describes a DNA fragment as a probe only for the use of obtaining a full-length DNA, the invention is regarded as having no utility. However when the DNA fragment is suggested in the description to be used as a probe for diagnosis of a specific disease or encode a specific protein, the invention is regarded as having utility.

(2) If the specification merely describes SNPs to be used in forensic medicine, the invention appears to have no apparent utility. However when the SNPs are experimentally demonstrated in the description to be useful as a diagnostic composition, etc., the invention is considered to have utility.

(3) If a full-length cDNA is deduced to be a gene of a specific protein from the sequence homology search through a publicly known database, the invention is regarded as having no utility in principle.

(4) Concerning an invention of a protein, if the specification describes the amino acid sequence only without any description of physical, chemical or biological properties of the protein, the invention is not considered to have utility.

2.2 Unpatentable Invention (See Part III. Chapter6. Unpatentable Invention)

When carrying out an invention inevitably contravenes public order or morality, the invention shall not be patentable as follows:

(1) Inventions liable to damage human beings or undermine human dignity
If carrying out an invention inevitably damages human body, binds the freedom of human body or undermines human dignity (e.g. a process for

cloning human beings, a process for modifying the germ line genetic identity of human beings, and the product thereof, etc.), the inventions would be contrary to public order or morality.

(2) Inventions of transgenic animals without excluding human beings

Chapter 2. Invention of Pharmaceutical and Cosmetics

*Revised and managed by Pharmaceutical examination division and
Biotechnology examination division*

1. Requirements for the description of the invention and the claims

1.1 Requirements for the description of the invention

(1) Pharmacological effect

① Pharmacological effect of a medicinal use invention should be described in the original specification to support its medical use. Principally, pharmacological effect should be supported by the clinical test; provided, however, that animal test or in-vitro test can be substituted with clinical practice in some inventions.

(Note) The description of the invention for a medicinal use invention should disclose the result of its test showing that a certain substance has the pharmacological effect by presenting pharmacological data or describe in great details how the substance shows the pharmacological effect, unless there is special circumstances that pharmacological mechanism by which the substance shows the pharmacological effect described in the specification is clearly known before the filing of the patent application..

(Note) Chemical compounds exhibit different pharmacological effects, therefore different measuring values, depending on a substituent of each compound. The specification of the present patent application describes great many compounds in addition to the claimed compounds and all the compounds described in the specification cannot be said to exhibit the pharmacological effect. Even if only a part of the compounds do exhibit the pharmacological effect, there is no ground that the claimed compounds are included in the part of the compounds showing the pharmacological effect. Therefore, the specification cannot be said to describe Anti-HCV effect of the claimed compounds in such details to meet the description requirements..

② For selection invention, even though the description of the invention is

not required to describe comparative test results to show in details that the selection invention has different effect qualitatively or quantitatively from that of prior art, at least, its pharmacological effect should be stated as clearly as possible for skilled person in the art to recognize it as the effect of a selection invention.

(2) Other requirements for specification

- ① Principally, effective dose and method of administration should be described in the original specification of the medicinal use invention.
- ② Dosage form should be stated in specification for skilled person in the art to conduct as easily as possible.
- ③ For the matter of toxicity test, the result of acute toxicity test may be requested during examination in case of doubting its toxicity specifically.

(3) Invention of Cosmetics

Effect of an invention on cosmetics can be confirmed by objective documents such as the result of sensory test of the Panel test, etc. Especially, functional cosmetics, etc. has biochemical or physical effect to bring functional improvement to skin. Therefore, details from objective documents should be stated to prove the functional effect.

1.2 Requirements for claims

(1) Category of pharmaceutical invention

A medicinal use invention should be recited as a product invention.

(2) Disclosure of use of pharmaceutical invention

In describing a medicinal use, comprehensive descriptions such as [medicine] or [therapeutic agent] are not allowable.

Principally, the medicinal use should be stated as pharmacological effect such as diagnosis, therapy, improvement (relief), treatment or prevention. Provided that, the medicinal use is allowed to be specified by its pharmacological mechanism, if a skilled person in the art can recognize the pharmacological mechanism as a specific pharmacological effect which indicates a clear medicinal use.

(Example 1) [Claim 1] A composition which is effective at inhibiting angiogenesis, comprising an angiogenesis inhibiting compound with general formula and pharmaceutically allowable excipient

- The phrase, effective at inhibiting angiogenesis, is clear enough to be allowed as a limitation specifying a pharmacological effect since it has been proved that the concept of angiogenesis-related disease is used in the relevant art. Therefore, it can be used as a limitation for indicating a medicinal use; provided, however, that to state inaccurate medicinal use due to lack of the concrete medicinal effect should not be permitted.

- For a medicinal use invention, since the medicinal use of specific substance is an element of the invention, the medicinal use of specific substance should be clearly stated by specifying the target disease or its effect in a claim. The medicinal use invention includes the fact that the medicinal composition has special feature prohibiting angiogenesis. Based on the fact, it identifies the effect to cure unwanted angiogenesis formed in the pathologic process or to prevent it, and its contents will be also considered clear. Therefore, Claim 1 may be deemed that it accurately states its medicinal use regardless of disclosure of correlation between angiogenesis mechanism or prohibiting mechanism and disease.

2. Requirements for Patentability

2.1 Unpatentable invention

(1) Invention under Article 32 of Patent Act

① Invention with possibility to threaten public health

If the object of the invention can definitely threaten public health, since the invention corresponds to [Invention with possibility to threaten public health], it shall be unpatentable.

(Example) Example of unpatentable invention

- Invention of medicine, cosmetics, and others using harmful amount of materials to human body, such as tranquilizer, coloring material, and coating material, etc.

※ If any harmful material is used, it should be synthetically determined whether the invention is harmful to the public health or not by comparing

harmfulness of the material with the intended effect.

- Cosmetics having expected effect produced with harmful substance which is over permissible amount

② The invention, which can be harmful or not depending on how it is practiced, is considered patentable. (E.g. an invention relating to a medicine which is not allowed to be administered to pregnant women because it may be harmful to an infant but is allowed to be administered to a normal person)

③ The invention relating to a medicine which is approved under Pharmaceutical Affairs Act, is not considered harmful to hygiene. Provided that, principally the invention related to the pharmaceuticals, which should be collected voluntarily and should not be manufactured or imported by the order of chief of Korea Food and Drug Administration, is considered harmful to the public health.

2.2 Novelty

(1) Novelty of pharmaceutical invention using same substance

The medicinal use invention using same substance cannot be considered same if it has different use. Provided that, even though the use of a cited reference and a claimed invention is stated differently, if the pharmacological effect seems to be based on same or similar action mechanism, those are considered same lacking novelty.

(Note) A 'medical use invention' relates to an invention which discovers pharmacological effects of specific material or in combination of materials, and it is expressed as (i) application to a specific illness (Ex: pharmacological composition including A as active component to treat illness B) or (ii) application to a specific illness of which administration use or volume (administration time, the order of administration, administration volume, administration area, and etc.) is defined.

(2) Novelty of invention which is identical but stated in a different manner

The two inventions in claims stated differently but having same purpose and effect are deemed identical.

- ① An invention on a device for manufacturing medicines and an invention on simple processes for manufacturing medicines with the device, etc. are deemed identical. (E.g. The subjects stated in claims are different – a process and a device for manufacturing medicines respectively -, but the other matters stated are same)
- ② An invention on medicine and an invention on simple directions of the medicine are deemed identical.
- ③ An invention on mixture and an invention on a process for manufacturing the mixture are deemed identical.

(3) Novelty of manufacturing invention with different subject stated in claim(s)

Even though the subject of the invention of a process for manufacturing medicines is stated differently, if it is based on the same pharmacological effect, it is considered identical lacking novelty.

(4) Novelty of invention with process newly added

The invention with a new additional process is deemed that it has novelty. If the additional process, which is a publicly known process or a process of traditional art, is not created but simply added to the invention, it lacks novelty.

(5) Novelty of optical isomer invention

When racemate is disclosed, if each optical isomer not disclosed literally is possibly recognized by a skilled person in the art through its specification and technical knowledge when filing, the invention can be considered publicly disclosed. Therefore, it lacks novelty.

2.3 Inventive step

A medicinal invention is deemed to have inventive step if the medicinal effect is so creative and effective that it cannot be come up with from the chemical structure of active compound or composition, or cannot be identified with action mechanism stated in a cited reference by a skilled person of the art.

(1) An invention of manufacturing pharmaceutical composition may not be considered as having inventive step, since not active compounds but auxiliary compounds are commonly used in this field, so it can be easily invented by a skilled person in the art.

(2) If an invention of manufacturing a crystal uses mixed solvents, which is well-known or commonly used art since the target substance is melted in one solvent better than in another one, it is considered as having no inventive step. Provided that, if the effect is much better than expected by a skilled person in the art compared to prior art, its inventive step should be acknowledged.

- To get more high-purity crystal through crystallization or recrystallization is a basic art in this field, and to crystallize substances, using mixed solvents when the substance is melted in one solvent better than in another one, is included in well-known or commonly used art. Therefore, the invention, which is made by combination of prior art and well-known or commonly used art, is considered to lack inventive step.

(3) Inventive step for a medical use invention shall be evaluated, considering dosage regimen or dose as its element. Inventive step may be acknowledged only for a specific dosage regimen and dose which are deemed to be worthwhile to be protected as a patent due to prominent or heterogeneous effect for which a person skilled in the art cannot expect.

(Ex1) [Claim 1] A pharmacological composition for prevention or treatment of hepatitis B; Compound A of 0.5-1.0 mg attached to the surface of a carrier disposition; To be administered once a day

(Summary: grounds for refusal) The closest prior art relates to a pharmacological composition for treatment of hepatitis B, with compound A of 0.5-2.5mg being orally administered as active component, and to improve pharmacological effects and for the convenience of administration/medicine taking, as optimization of unit administration volume and of administration method is a general technical issue in the medical field, it is sufficiently predicted to a person skilled in the art based on the closest prior art that

valid effect can be arisen even as compound A is administered only once a day with a small dosage of 1mg. Also, it cannot be considered that the claimed invention has a prominent effect as much as unpredictable based on the closest prior art. [2014hue768]

(Ex2) [Claim 1] Pharmacological composition for prevention or treatment of osteoporosis, with compound C of 100mg~around 150 mg being orally administered as active component once a month.

(Summary: grounds for refusal) As the closest prior art discloses that it is useful to treat osteoporosis with compound C of 2.5 or 5.0mg administered once a day as an active component, and that it is possible to administer compound c with 35mg every week, a person skilled in the art could easily select the option to administer compound C with 150mg every month to treat osteoporosis, and even though a patent applicant asserts that compound C with 150mg is superior to lower dosage in terms of bioavailability, and that 1 year after administration, 150mg administration per month is superior to 2.5mg administration every day in terms of bone density improvement. But, if high dosage of administration is applied to a patient, it can be sufficiently expected that higher dosage administration is superior to lower dosage administration in terms of bioavailability, and as bone density improvement 1 year after administration cannot sufficiently be expected by the closest prior art, it shall be considered that unexpectedly striking difference has been made.

(4) For invention of polymorphic crystal form, since it is commonly committed to review the polymorphic crystal form to formulate the medicinal compound, invention of crystal with claims stating compounds of specific crystal having different form of crystal from the compound in cited document is deemed to have the inventive step if it has different effect qualitatively or quantitatively with the compound in cited document.

- It is well-known in the medicinal field that compound may have various crystal forms and the pharmaceutical features such as solubility, safety, etc. can be different according to the crystal form. It is common to review the polymorphic crystal form to formulate the medicinal compound. The inventive

step of crystal form invention is allowed if it has different effect from the effect in cited document qualitatively or quantitatively. To determine the inventive step, the effect mentioned above should be stated in the description of the crystal form invention, not to the extent of the report of the comparative study with cited documents. If there is doubt to the effect, the effect should be proved by submitting documents, which applicants or patentees trust in, such as documents of comparative study after filing date.

Chapter 3. Invention of Food

*Revised and managed by Food, Agriculture, Forestry and Fisheries
Examination Division*

1. Overview

This chapter is applied to inventions directed to food having various sensory and functional effects, and a manufacturing and processing method thereof. Food includes fresh foods itself such as agricultural, livestock, forest and marine foods; a processed food which is manufactured and processed to expand the period of storage and improve its nutrition; a healthy food manufactured by using raw material or ingredient which is good for human body; and a favorite food to satisfy psychological and physiological desire. Food taken as medicine is excluded.

Considering that food is easy for the public to access and its intake is consistently made, in examining an invention directed to food, it is necessary to determine whether the food is harmful to the health of the public or not, and unique matters including how to describe sensory effects of food and functional effects of a healthy food, and a limitation on intended use as a healthy food should be considered in examining the invention relating to food.

2. Requirements for description and claim(s)

2.1 Requirements for the description of the invention

2.1.1 Sensory effect of food

Sensory quality of food such as taste, smell, appearance, texture, etc. is one of the most important factors to evaluate food. However, since the sense of human being can be affected by psychological or physiological condition and social background, etc., the effect of the invention cannot be determined by only personal sense of an inventor or a specific person. It is necessary to prove its effect objectively and scientifically through

physiochemical or mechanical analysis, or systemic sensory test, etc.

(1) Physiochemical or mechanical analysis

It is possible to check the sensory feature of food through physiochemical or mechanical analysis. The method, device, requirements, etc. should be stated specifically in the description of the invention for a skilled person in the art to understand and reproduce the invention. The detailed statement is needed to fully support sensory feature in accordance to the result of analysis.

The following examples are devices for analyzing sensory effect

- Color (Vision): colorimeter, spectrophotometer, etc.
- Scent (Smell): gas chromatography, electronic nose, etc.
- Flavor (Taste): electronic tongue, refractometer, salinity meter, pH meter, etc.
- Viscosity/Texture (Touch): viscometer, texture profile analyzer, rheometer, amylograph, etc.

(Example) (Claimed invention) [A method for manufacturing processed soybean milk with higher sweetness by adding starch hydrolysis enzyme during manufacturing steps]

Starch of bean is degraded as low molecular sugar that is respectively highly sweet, which leads to change of a refractive index. Therefore, it is deemed that sensory effect that the sweetness of soybean milk increases is confirmed by the change of Brix value of soybean milk estimated by a refractometer.

(2) Sensory test

Food sensory test is to scientifically evaluate and analyze sensory feature and favor, etc. of food by using five sense organs for vision, touch, taste, hearing, and smell. The effects of following cases need to be analyzed through sensory test.

- Sensory feature of food is described as effect of an invention without its result of instrumental analysis being presented, and the feature is not clear to a person skilled in the art.
- There is not, or little correlation between instrumental analysis result and

sensory feature.

- It is difficult to analyze food mechanically, or complicated sensory feature is insisted.

(E.g. decrease of bitter taste, decrease of astringent taste, stale smell of Kimchi, masking effect, etc.)

- As effect of an invention, preference of food is described.

A method of a sensory test, number of panels, and standards of selection, etc. should be stated in the description of the invention, and the result of the test should be described with quantity; provided, however, that it should be stated clearly and in detail to support objectively the effectiveness.

(Example) (Claimed invention) [A method for improving polish of rice by equally mixing a fixed amount of materials called X with monosodium glutamate]

Where three samples of treatment plot for monosodium glutamate, X, and mixture of monosodium glutamate and X are evaluated through sensory test by some trained panels; where the detailed method of the test and the result are described; where it is possible to distinguish objectively the effect of the mixture of monosodium glutamate and X from each effect of monosodium glutamate and X, it is deemed that the effect of the invention is confirmed.

2.1.2 Functional effect of food

Food has useful functions for health such as improvement of health or prevention of disease, etc. Those functions or new functions shall be stated in detail and clearly confirmed by using various ways including experiment in vitro, animal testing, clinical test, or biomarker, which can support its effectiveness.

Provided that if effective dose of functional raw material or ingredient publicly known is enough to identify its function without proving the functional effect again, it will be deemed that the mixture of them includes the effect of the raw material or ingredient.

Functional raw material or ingredient publicly known means functional raw material of health functional food, which shall be declared by Minister of

Food and Drug Safety; be raw material or ingredients separately recognized; or be recognized with the function by being published in publications domestically and internationally.

(Example) (Claimed Invention) [A food composition for depressing blood sugar including ingredient X as an active ingredient]

If there is an objective test result to support the function depressing blood sugar by ingredient X in the description of the invention, it is deemed to be identified that the food composition with X as an active ingredient has effect depressing blood sugar. Provided that if the effect of food composition is doubted since the content of ingredient X in the composition is very little, grounds for rejection can be notified because of deficiency in the description.

2.2 Requirements for claim(s)

Health functional foods with functions such as specific physiological activity or prevention of diseases can be described by claiming its usage, and an examiner examines it according to the following ① to ③.

① If the subject matter recited in a claim is a health functional food, the usage limiting the food is considered as a claim element.

(Note) As long as a claim is not drawn to a usage invention, even if the invention has an object or a usage which is different from that of a prior art reference, the difference in the usage does not necessarily guarantee the novelty of the claimed invention having the same composition with the prior art reference. (See, Verdict 2005HU2045 sentenced by Supreme Court, Jan. 25. 2007)

② For a use invention of a health functional food, its usage shall be specifically described by not its quality itself but its objectives to be achieved through the quality.

(Example) For improvement of hyperlipidemia, for drop in blood sugar level, for cure of obesity

(Comment) Quality means basis of a usage including property, effect, act, mechanism, etc. The term quality is not appropriate expression for usage.

A limitation expressed as 'Having activating antagonism for binding receptor

of platelet activating factor' does not specify a usage but specifies a function. Therefore, it is not a use invention. (See, Verdict 2001HEO1501 sentenced by Patent Court, Feb. 4. 2002)

③ A health functional food is manufactured and processed in a variety of forms to provide functions which are helpful to human body. Contrary to a medicinal use invention stating a usage for cure of specific diseases or symptoms, the usage may be stated with the type of function which is helpful to human body.

(Example) A claim limitation "food made from soybean milk supplying taurine and compounds of soybean milk to treat taurine deficiency disease" is deemed unclearly stated since food cannot be used as a medicinal object such as a treatment.

3. Unpatentable invention

(1) Basically, food shall be safe for human body since people intake it daily. Therefore, the invention on food shall be checked out whether its material or component, including secondary products generated during the storage and process of food, is safe for human body or not.

(2) Where safety of food material or its compound is not clear to a person skilled in the art, the invention is deemed harmful to public health. Therefore, examiner shall give a notice of grounds for rejection under Article 32 of Patent Act.

The followings are cases mentioned above.

- New material or component never consumed as food
- It is prohibited to be used as food due to its harmfulness disclosed in reports of government domestically and internationally, reports of international authorities, and relevant databases.
- Its harmfulness to human body is reported in academic journals domestically and internationally.
- Its description such as intake volume, how to intake, etc. is beyond the scope of science knowledge in technical field so that its safety is doubted.

(Example) It is natural to require submission of safety test report since the

invention separately mixed iron powder and the mixing ratio is also too high, so the said composition of food is easily expected by a person having common sense to bring harmful effect to human body. (See, Verdict 89HANGWON1063)

(3) If the ground for rejection is that it is doubtful the invention can be used as food due to its safety to human body, the applicant is able to respond by submitting written argument with objective documents to prove its safety as food. In this case, where the description of the invention is amended by adding explanation and documents on safety, it is noted that it can be considered as an addition of new matter if the matter is not clearly recognized from of the original specification. (See, Guidelines of Examination Part IV, Chapter 2, 1.2 Detailed Assessment Method of Prohibition of Addition of New Matter)

(4) Principally, health functional food to improve health and prevent disease shall have safety as food. If both health functional food and medicinal product are filed in one application, it shall be determined separately whether it can be harmful to public health.

(Example) [Claim 1] A food composition with compound X as an active compound to improve cardiovascular function

[Claim 2] A Pharmaceutical composition with compound X as an active compound to treat cardiovascular disorders

For pharmaceutical composition, it is determined whether it can be harmful to public health by comparing its expected effect with harmfulness of compound X. [See, Examination guidelines of invention of medicine] On the other hand, for food composition, even though compound X has great effect, if it is harmful to human body, it is considered as an invention to be harmful to public health.

Chapter 4. Invention of functional drinking water

*Revised and managed by Civil Engineering & Environment Examination
Division*

1. Overview

For an invention of functional drinking water such as electrolyzed reduced water, hexagonal water, magnetized water, etc., it is necessary to satisfy requirements for description including statement of medical effect of functional drinking water, statement of maintaining magnetic state of magnetized water, etc.; subject matter eligibility of invention, and determine whether the invention is possibly harmful to public health or not pursuant to Article 32 of Patent Act (Unpatentable invention).

2. Requirements for the description of the invention

(1) Considerations on the description of the invention

① For an invention of electrolyzed reduced water, if it is limited to hydrogen ion concentration, oxidation-reduction potential, active hydrogen concentration, etc., the process and its beneficial effect shall be stated. If it is not acceptable as common sense from a point of view of a person skilled in the art, reliable test result shall be submitted.

② For an invention of hexagonal water, since the word, hexagonal water, is widely used in examination and industry, the invention is considered to be specified without any other explanation. However, objective test and way of measure shall be submitted to find out producing principle or production of hexagonal water which is acceptable from a point of view of a person skilled in the art.

③ For an invention of magnetized water, if the description that magnetic state is maintained outside magnetic field is stated, objective test and way of measure should be submitted to confirm maintenance of magnetic state from a standard of a person skilled in the art.

④ If functional drinking water produced by manufacturing device or manufacturing method of electrolyzed reduced water, hexagonal water,

magnetized water, etc., has medical effect, objective data of the effect shall be stated in the description. Provided that the medical effect is included in technical common knowledge, it can be acceptable without stating objective data.

(Note 1) It is impossible to understand how far infrared ray, wavelength of plants, wavelength of magnet and copper, and vibrating sound produce hexagonal water from the disclosure of the specification of the claimed invention, and it is not confirmed if the hexagonal water is actually made or not. Also, it is not clear whether some special conditions of quantity or strength of each component mentioned above should be met in order to produce hexagonal water, or without the special conditions it can be produced. According to this, therefore, it is not deemed that a person skilled in the art can understand exactly the invention with only the specification and can easily implement it.

(Note 2) This invention includes process to produce Micro-clustered water having 170 NMR (nuclear magnetic resonance) with under 60Hz of half width by treating underground water or running water through circulation of line stabilizer and magnetizer. So, the description should be understandable for a person skilled in the art to carry out without adding specific knowledge. With only special document introduced in foreign country, it cannot be considered the technical structure is clear, and there is no evidence that the process is clear matter which does not need additional statement such as well-known art, etc.

3. Requirements for patentability

3.1 Industrial applicability

(1) Ineligible subject matter of invention (uncompleted invention)

Since manufacturing device or manufacturing method of hexagonal water made by Hyranya (hexagonal pyramid) model has no test reports or evidence to prove that hexagonal water is just made by Hyranya model, it is considered as uncompleted invention which is impossible to be accomplished. It is also unacceptable that the invention is technical idea using empirical rule discovered by experience in nature, rule established by

natural science, or causal relation that is usual and comprehensive phenomenon in nature.

(Note) It is understood that manufacturing hexagonal water through pyramid structure is just theory without scientific proof.

3.2 Unpatentable invention

(1) General principle of unpatentable invention

If invention in the field of water treatment or functional drinking water intends to make public order or faith disrupted, or to be harmful to public health, patent shall not be granted. Where the invention is about a manufacturing process, whether the result from the process as well as the process itself may be harmful to public hygiene shall be determined and considered. Also, it seems that if the invention is beneficial but it is possibly harmful to public hygiene, it is necessary to find out measures to remove the harmful part or compare its interest.

(2) Considerations on unpatentable invention

It is not appropriate to consider functional drinking water as an invention possibly harmful to public hygiene under patent act on the basis of only matters which seem beyond the water quality standards prescribed by decree related to water quality. Provided that, according to the specification, if it is clear that invention of functional drinking water will be harmful to human body, it is considered as an invention possibly harmful to public hygiene. In this case, however, if its safety is proved by submitting objective documents or test result, etc., it will be deemed to be patentable.

Chapter5. Chemical compound invention (organic/inorganic chemistry)

Revised and managed by Applied Materials Examination Division

1. Requirements for description, claim(s)

1.1 Requirements for the description of the invention

(1) Chemical compound invention

① Statement of compound characterization data and synthetic procedures

Confirmatory data to identify compounds and the preparation (synthetic procedure) shall be stated in the description of the invention.

i) Statement of compound characterization data

When it is doubted that the compound may be produced through the preparation stated in the description since the process is too complicated or undesired side reactions occur during the process, etc., compound characterization data such as elemental analysis data, nuclear magnetic resonance (NMR) data, melting point, boiling point, etc. shall be stated in the description.

To confirm polymorphic forms, characterization data such as X-ray diffraction (XRD), differential scanning calorimetry (DSC), infrared (IR) spectrometry and/or chemical/physical data, etc. shall be stated in the description of the invention to confirm polymorphic forms. .

ii) Statement of preparation of chemical compound

Except for the case that a person skilled in the art is able to prepare the compound based on the disclosure of the specification and the level of skill in the art at the time of filing even if the preparation method of a new compound is not specifically described in the specification, the preparation method shall be clearly stated in the description of the invention.

② Statement of embodiment

For an invention relating to a new chemical compound, embodiment specifying technical means shall be disclosed. Where the claim is recited generically, representative embodiment shall be disclosed by a group except

for a case that the specific content of invention can be recognized to a person skilled in the art based on the disclosure of the specification and the level of skill in the art.

1.2. Requirements for claim(s)

(1) Supported by the description of the invention

① Case not supported by the description of the invention

(Example) In a claim, a chemical compound invention is claimed and the compound is expressed as Markush type having multiple elements. On the other hand, since only detailed example of preparing compound with specific structure frame is stated in the description of the invention, if it is considered that compound with other structure frames is not clearly understood by a person skilled in the art, an examiner shall notify the grounds for rejection that claimed invention is not supported by the description by presenting the reasons for the determination.

(2) Pointing out an invention clearly and simply

① Case of determining whether the invention is set forth clearly and simply

i) If a new chemical compound is specified by its name, or structural formula, the claim shall be deemed clear.

The name of a chemical compound, structural formula and, if necessary, crystal structure shall be specified to set forth the chemical compound clearly. If structural formula is simple, however, it will be possible to state only the name of chemical compound. Where it is impossible to specify the invention with only name of the chemical compound or structural formula, but physical or chemical property can, it is allowed to define the invention with the properties. Also, if necessary, by adding preparation of compound as a part of specific means, it can be specified.

ii) In a case of where the substituent is recited as 'alkyl' and 'aryl' without stating carbon number within the claim, if specifying substituent itself does not make any problems since any variety of alkyl or aryl can be introduced based on the kind of the chemical framework, which is scaffold of chemical constitution, it is not deemed that definition of the substituent itself is unclear. However, considering chemical structure and its embodiment, if the

scope of carbon number of substituent shall be specified or embodiment which is not included in alkyl and aryl cannot support them, it is necessary to consider if it is the case that the invention is not supported by description or a person skilled in the art cannot conduct the invention easily.

Also, if the expression, 'substituted ...' which does not specify the substituent which can be introduced make the invention unclear, it is not allowed.

iii) If the scope of the compound expressed by 'derivative of ...compound', 'homologous series of ...compound', etc. is not identified clearly by considering description and general technical knowledge, it is deemed unclear.

2. Requirements for patentability

2.1 Novelty

(1) Chemical compound invention

① Chemical compound defined by specific characteristics

In a case where a claimed compound is defined by specific characteristics instead of name or structural formula, if it turns out that the claimed compound is identical with the well-known compound specified by name or structural formula, the claimed compound is deemed to lack novelty.

② Salt

A chemical compound and its conventional salt are substantially identical. Hence the salt of the known compound is deemed to lack novelty.

③ Purity of chemical compound

A known chemical compound with simply improved purity lacks novelty. Even though purity of the claimed chemical compound is improved, the claimed chemical compound is not distinguished from the known chemical compound by its distinct nature (natural properties). Therefore, it is not deemed that the claimed chemical compound is different with the publicly known chemical compound.

(2) Invention on a preparation method of a chemical compound (Method claims)

① Preparation method of a chemical compound with a use limitation

Where the claimed preparation method is the same with that of the prior art, and merely the use is limited, it is deemed to lack novelty since both are preparations for producing the substantially same compound.

Also, the claimed preparation method is the same with that of the prior art but specified by different use limitation, since both methods are substantially identical, the claimed preparation method is deemed to lack novelty.

② Preparation using starting material with specified preparation

Where the reactant used in claimed preparation is produced by particular preparation and it is merely characterized by name or physical/chemical properties in the prior preparation, if other conditions of claimed preparation are equivalent to that of the prior art, the claimed preparation is deemed to lack novelty.

2.2 Inventive step

(1) Chemical compound invention

① Determination of inventive step for chemical compound invention

Inventive step of a chemical compound invention is determined by two features: i) structural formula ii) technically special effect of the chemical compound

In a technical field in which it is not easy to predict technical effects from a configuration of a product such as a chemical compound, improved effects accomplished by the claimed compound compared to that of a prior art reference is very important in determining inventive step. An examiner should not deny the inventive step because of similar structure of a claimed chemical compound with that of publicly known chemical compound. To assess the inventive step of the claim, it should be considered whether there are unexpected technical advantages in terms of a final result, chemical feature, purpose or use.

If the chemical structure of the claimed chemical compound is different from that in the cited prior art, it involves the inventive step. Even though the chemical structures are similar, if the claimed chemical compound has unexpected or extraordinary characteristic, it is recognized as involving

inventive step.

However, even if the invention in a claim has favorable effect than that in the cited prior art, when it is logically recognized that a person skilled in the art easily comes up with the invention, the inventive step can be denied.

(Note) Inventive step of a chemical compound invention shall be determined based on peculiarity of a chemical structure and uniqueness of property or use. If the chemical compound invention has totally different chemical structure with that of publicly known compound; if the chemical compound invention has extraordinary property which cannot be predicted from publicly known compound even though both have similar chemical structure; and even though the chemical structure can be predicted from similar publicly known chemical compound, if a person skilled in the art cannot easily invent it since its property is exceptional, the inventive step shall be recognized but otherwise, it cannot be recognized. (See, Verdict 2007HEO2261 sentenced by Patent Court, Jan. 17. 2008)

② Crystalline/polymorphic forms

In a situation where a new crystal form of a known chemical compound is claimed, and a different crystal form of the chemical compound has previously been recognized or prepared, then it is considered having inventive step, insofar as its effect is qualitatively different with that of prior invention, or insofar as the effect is great different quantitatively regardless of qualitative effect.

(Note) It is well known in the technical field of medicinal compound that since compound(s) can have different crystal forms (polymorphic forms), its feature such as solubility or stability, etc. becomes different. That is why it is common to review the existence of polymorphic forms of the compound for designing medicinal compound. Therefore, invention relating to polymorphic form, which has a claim of compound with specific crystal form that is just different with the crystal form of compound published in prior art invention in medicinal compound field, is considered having inventive step if it has clearly different qualitative effect compared to the compound disclosed

in the prior art, or if it has clearly different quantitative effect compared to that in the prior art regardless of qualitative effect. Provided that in the description of the invention, the effect mentioned above shall be stated clearly even though there is no test data comparing with the prior art invention, to be considered for determination of inventive step. If the effect is doubtful, it shall be proved concretely by submitting evidences such as comparative test data which is trusted by applicant or patentee after filing date, etc. (See, Verdict 2010HU2865 sentenced by Supreme Court, July. 14. 2011)

(2) Invention of preparation of inorganic compound with specific feature

For an inorganic compound, even though the name and the chemical formula are same, it is common that physical property or its configuration, including microstructure such as crystal form, a unit surface area of particles, etc. is different. That's why the subject matter cannot be specified with only the name or chemical formula.

However, it is not easy to explain the microstructure technically. Although the claim and the description have no explanation of the microstructure, if specific property which helps to expect the microstructure is stated, it is necessary to review the actual compound from the specific property according to the statement.

Therefore, to determine inventive step of the invention of preparation of inorganic compound with specific feature, the review of specific property shall be included in the claim regardless of statement of the property. That is, it shall be determined whether it can be expected that the compound with specific property stated in the specification through adoption and combination of components is produced through the level of technology. It is not allowed to just determine it without taking account of specific property which is different since the name or chemical formula is same.

2.3 Requirements for patentability of special invention

(1) Invention limiting usage of a compound (Product by use)

① How to construe a claim

In case of a chemical compound, use of which is limited by stating 'for~'

(e.g. Chemical compound Z for Y), since the limitation is just to indicate its utility, so it is considered as a chemical compound without use limitation (e.g. Chemical compound Z).

② Determination of novelty and inventive step

If a claimed chemical compound is disclosed in the prior art, the chemical compound with use limitation is deemed to lack novelty.

(Example) Considering the disclosure of the specification and drawings, and technical knowledge at the time of filing, since expression, 'for killing insect' indicates only utility of the chemical compound, 'Chemical compound Z for killing insects' is read as 'Chemical compound Z' without limited use. Therefore, there is not novelty since 'Chemical compound Z for killing insects' is same with 'Chemical compound Z' disclosed in the prior art.

(2) Selection Invention

① Determination of inventive step

In order for selection invention involving novelty over the prior art invention disclosing only the generic concept to be recognized involving inventive step over the prior art, all the species included in the selection invention should have different effect from that of the prior art invention qualitatively or quantitatively.

(Example 1) Invention lacking inventive step since specific chemical compounds just selected among a wide range of chemical compounds.

In the case where it is not stated that the chemical compound, which is selected from a wide range of chemical compounds, has favorable effect compared to the chemical compounds of prior art, or in the case where it is stated that the chemical compound, which is selected from a wide range of chemical compounds, has favorable effect, but the chemical compound can be easily selected by a person skilled in the art since the property of chemical compound is expectable.

(Example 2) Invention comprising specific chemical compounds selected from a wide range of chemical compounds, which have unexpected favorable property.

In the case where the invention is specified that it selects specific substituent, R, disclosed in the prior art since the fact is not disclosed in

the prior art, it is not expected that a person skilled in the art can select specific chemical compounds to get favorable property as well as chemical compounds with favorable property can be made by selecting specific chemical compounds among general chemical compounds.

(3) Invention of enantiomers

① Determination of novelty

i) Invention of enantiomers

If an enantiomer is disclosed specifically in the prior art stating a racemate (racemic mixture), it is considered lacking novelty.

Even though data proving existence of an enantiomer is not stated in the prior art, if it is possible to find out the existence of an enantiomer only from the disclosure of the specification, or a person skilled in the art easily carry out the invention according to the level of technology at the time of filing, the enantiomer may be deemed to be disclosed in the prior art.

(Note 1) The claimed invention is an art manufacturing D-isomer by hydrolysis of insoluble salt after separating crystal from salt of stereoisomer through reacting racemic mixture, that is, spiro-hydantoin to alkaloid which is optically active compound in inactive organic solvents. However, if D, L sprio-hydantoin is disclosed in the prior art reference and DL isomer has been already disclosed, D-isomer can be also recognized to have been disclosed, and its preparation is same. Therefore, the invention is deemed to be same with the prior art since starting material, manufacturing, and final product have been already disclosed. (See, Verdict 83HU52 sentenced by Supreme Court, March. 25. 1986)

(Note 2) To deny novelty of a selection invention, the prior art invention should disclose species of the selection invention. Where the prior art reference explicitly discloses species of the selection invention or where species of the selection invention can be recognized by a person skilled in the art from the disclosure of the prior art reference based on general technical knowledge at the time of filing, the selection invention lacks novelty. The description of the invention of Cited reference includes descriptions: "methyl- α -(4,5,6,7-tetrahydro

thieno(3,2-C)-5-pyridyl)-o-chlorophenyl-acetate”, “since these chemical compounds have one asymmetrical carbon, it is existed as two enantiomers. Therefore, the invention is about two of each enantiomer and their mixture.” The subject matter of Cited reference 1, “methyl- α -(4,5,6,7-tetrahydro thieno (3,2-C)-5-pyridyl)-o-chlorophenyl-acetate”, can be named differently according to its order of name for substituent but it is same with the material, “methyl- α -5(4,5,6,7-tetrahydro(3,2-C)thieno pyridyl)(2-chlorophenyl)-acetate” which is in claim 1 of the claimed invention of this case. As “each enantiomer” refers to ‘dextrorotatory enantiomer’ and ‘levorotatory enantiomer’, and their mixture refers to ‘racemic mixture (racemate)’, clopidogrel in claim1 of the claimed invention, which is dextrorotatory enantiomer of the chemical compound, is disclosed in Cited reference 1. (See, Verdict 2008HU736 sentenced by Supreme Court, Oct. 15. 2009)

② Determination of Inventive step

i) Invention of enantiomers

If an enantiomer is not disclosed in the prior art in detail, its inventive step shall be determined by considering that it has extraordinary effect with its chemical and physical property compared to racemic mixture (racemate) disclosed.

ii) Use invention of enantiomers

If the use of enantiomers is not disclosed in detail, its inventive step shall be recognized by considering that it has extraordinary effect with its chemical and physical property compared to the use of racemic mixture (racemate) disclosed.

(Note) Case that inventive step of the use invention of enantiomers is recognized

It is well known that in the chemistry art if racemic mixture (racemate) is disclosed, a fixed number of enantiomers are present depending on the number of asymmetric carbon (chiral center). Therefore, a use invention of specific enantiomers can be patented only if, firstly, the prior art publications, etc. stating use of racemic mixture (racemate) do not disclose the use of the enantiomer in detail, and secondly, the enantiomer has different effect from the use of racemic mixture (racemate) disclosed qualitatively or

quantitatively based on its specific physical and chemical property. In determining whether a difference in an effect is present, if the enantiomer has various effects in relation to the use, it is not required that all of the effects of the enantiomer have differences from those of the disclosed racemate but it is enough that some of the effects of the enantiomer have differences from those of the disclosed racemate. And the difference in the effect cannot be denied even if it is possible for a person skilled in the art finds out its effect through repetition of simple test. . Even though it has been already well known that a specific enantiomer has better medicinal effect than that of racemic mixture (racemate) or other enantiomer, it cannot be expected that (S) enantiomer in claim 6 of the claimed invention has better medicinal effect than that of racemic mixture (racemate) or other (R) enantiomer which is other enantiomer of inventions stated in publications. Therefore, it may not be easy for a person skilled in the art to recognize medicinal use of claim 6 of the claimed invention based on general technical knowledge at the time of filing through medicinal use of the racemic mixture (racemate) mentioned above which is not separated in 2 enantiomers. (See, Verdict 2002HU1935 sentenced by Supreme Court, Oct. 23. 2003)

(4) Catalyst

① Determination of novelty

It is impossible to determine the patentability of catalyst without considering a reaction in which the catalyst is used, so novelty is determined based on the composition of the catalyst and the type of reaction in which the catalyst.

② Determination of inventive step

i) Case that a reaction in which a catalyst is used is not identical or same type.

Even though there is a catalyst disclosed, composition of which is identical or similar with that of the catalyst of the invention, if the reaction in which the catalyst is used is not same or the type is different, and the effect of catalyst of the invention is recognized compared to the case without catalyst, it is deemed that the invention has inventive step.

ii) Case that the composition of catalyst is not similar

If there is no catalyst disclosed which has same or similar composition for a reaction in which the catalyst of the claimed invention is intended to be used, it is deemed that the invention has inventive step by comparing an effect of the claimed catalyst with a case without the catalyst.

iii) Selection of catalyst which is supported or not supported

For catalyst system, to determine its inventive step about selection of supported or not supported catalyst, technical meaning stated in specification or its extraordinary effect shall be considered.

(Note) Although it seems that supporter of catalyst has no catalytic activity, it is used for various purposes such as to produce catalyst which is effective to catalytic reaction when it is made by active compound and enhancers, to reduce cost of preparation, and to improve mechanical property, etc. Therefore, unless its technical meaning or effect about whether the catalyst is supported or not, are stated in the specification, it is not deemed that the form and system of catalyst between supported one and unsupported one have specific differences. (See, Verdict 2008HEO13732 sentenced by Patent Court, Oct. 9. 2009)

Chapter 6. Alloy Invention

Revised and managed by Metals Examination Division

1. Overview

1.1 Scope of application

This chapter is applied to an invention relating to alloying technique (C22C). For other technical fields than alloying technique (C22C), if the invention is recognized by a person skilled in the art that alloy structure, property, and use, etc. are specified through alloying component and numerical limitation of each component, the examination guideline in this chapter will be applied.

(Example 1) The invention, “a product comprising at least one Nickel-Zirconium alloy plating layer formed by plating solution as recited in claim 1,” is not characterized in the structure or property of the alloy plating layer, but in that the plating layer is formed by the plating solution. And it also does not limit the alloying components and the composition range of the alloy plating layer. Therefore, it is not necessary to apply the examination guideline for alloy invention.

(Example 2) “A manufacturing method of alloy ~ for ~ , including steps of: heating, hot rolling, cold rolling, and annealing of steel material which consists of A: 6-9 wt%, B: 7-12 wt%, C: 10-15 wt%, balance Fe and inevitable impurities” claims a manufacturing method, but this is about the manufacturing method of specific steel material having specific alloying components and the composition range. Therefore, the examination guideline for alloy is applied.

1.2 Characteristic of alloy and alloy invention

Alloy means 「a metal that is made by mixing two or more metals together」. Alloy has its own property as well as some properties of a mixture and a compound.

Since elements comprising an alloy and their properties are already

well-known, as long as there is no new element discovered, the alloy will be obtained from combination of limited group of elements which are already well-known and structure, property or use of the alloy can be different according to the alloying composition (alloying elements and composition range of each element). Therefore, for an alloy invention, not only alloying elements but also composition range of each element should be limited to specify claim(s) and structure, property, or use, etc. may be claim elements.

2. Requirements for description and claim(s)

2.1 Requirements for description (related to Article 42(3) i of Patent Act)

2.1.1 Grounds and embodiment of numerical limitation to composition range

If a numerical limitation to a composition range is stated in claim(s), its grounds and embodiment should be described in the description of the invention. However, exception is made when it is recognized that it is possible to specify the alloy invention described in claim(s) and the invention can be carried out easily.

To limit a numerical range, the limits of maximum and minimum should be clear; use of ambiguous terms is not allowed; and in every section with limited numerical range, reasons for numerical limitation stating maximum and minimum, significant effect which can be compared to that of prior art in the whole span of the numerical limitation range, and concrete reasons for characteristic of each element having synergy effect connected with components should be described.

(Reference) If the reasons for numerical limitation to a composition range or embodiment are not disclosed, it may be difficult to understand how those alloying elements affect each other; what effect the alloy invention has in regard to solution of objectives to be accomplished by the invention; and whether there is characteristic or significant effect that can be better than that of the prior art. Failure to disclose the reasons for the numerical limitation and embodiments may lead cyclic tests or trial and error to find

out whether reproduction of invention, purpose of alloy invention, or expected performance can be achieved. Therefore, it cannot be considered to satisfy requirements for the description of the invention.

(Reference) If an claimed alloy is recognized as the alloy in common use whose composition is known, or the alloy included in industrial standard such as KS, ASTM, JIS, DIN, etc., it is not necessary to state the reasons and embodiments of numerical limitation to the composition range.

Also, since an alloy invention is one which is difficult to predict its effect from its structure compared to inventions in the field of machinery or electricity/electron, and a manufacturing method is invented through repetition of tests rather than theoretical approach, it is necessary to disclose results of tests such as embodiment, example of test, comparative example, etc. to prove effect of the alloy. Especially, if the test data is to be described, the target, method and requirements of test, and technical effect not achieved by prior art, etc. should be specifically described for a person skilled in the art to easily carry it out. (See, Verdict 2001 HU 2740, 2005HU3338, 2001HEO997)

Whether an embodiment is specified in the description of the invention is determined as follows:

- 1) If an embodiment having a composition range which is consistent with and included in the composition range recited in the claims is stated, it is deemed that it satisfies requirements of Article 42(3) i of Patent Act. That is, if there is at least one embodiment which meets the composition range in the claim(s), being an independent claim or a dependent claim, the embodiment can be recognized as one representing the claimed invention.
- 2) If an embodiment does not contain some of essential alloying elements recited in the claims or includes an alloying element not recited in the claim(s), it is deemed that there is no embodiment representing the claimed invention. However, this does not apply when the different alloying element is an inevitable impurity.
- 3) Specific content of each alloying element should be specified in the embodiment. If only a composition range of each alloying element is stated without the specific content, it is deemed that an embodiment for the

claimed invention is not disclosed.

4) Effects of an invention should be specifically stated including unique effects which the claimed invention is intended to accomplish. If it is expressed abstractly or subjectively, it is not deemed that the effect is clearly stated.

(Note) Considering only the requirements for the description of the invention, it may be enough to have just one representative embodiment disclosed. However, for an alloy invention, its significant effect can be proved through presentation of test results, so it may be difficult to prove such effect with one embodiment when technical or critical meaning of numerical limitation to a composition range in the alloy invention has become an issue.

(Note) The test was just conducted with only one embodiment having a certain composition for amended claim 1 in this case, so it is difficult to determine whether the invention may accomplish its intended effects in the whole span of the composition range for each element, especially around the maximum limit and the minimum limit of the composition range. Also, the composition of the elements comprising Heat F is included in the composition range of the elements disclosed in the prior art reference and the test was not carried out with comparison to the steel of the prior art reference. Therefore, it is not deemed that the amended invention in claim 1 of this case has better effect in creep fracture strength, high-temperature oxidation resistance or steam-corrosion resistance than that of the prior art reference. (See, Verdict 2010HEO1381 sentenced by Patent Court, October.15.2010)

2.1.2 Structure, Property, Use, etc.

If it is recognized that structure, property or use, etc. is necessary to determine whether the claim particularly points out the invention or is necessary for a person skilled in the art to carry out the claimed invention easily, those should be clearly stated in the description of the invention.

Since an alloy invention can be defined by structure, property, or use of an alloy, those of alloy can be elements of the claimed invention. Therefore, the structure, property or use, etc. should be clearly stated in the

description of the invention. However, since the use of the alloy invention or invention manufacturing the alloy rarely changes the subject matter of the invention, it is reasonable to consider that the limitation on the use does not constitute an element of the invention except for a special case.

2.1.3 Manufacturing method of alloy

Even though the claimed invention is directed to an 「alloy」 which is a product invention, the manufacturing method of the alloy such as melting, casting, heating, machining, etc. should be stated in detail in the description of the invention for a person skilled in the art to easily reproduce the alloy. A manufacturing method of an alloy can be classified into two types: One is a method by smelting or refining. Another is a method by physically or chemically changing structure, property or use of parent metal, which is already well-known, in terms of machining, heating, plating, and other metal finishing, etc. to achieve intended objectives. That is because each of them has its own specialty to be recognized as a different invention.

If a person having a patent or a license of an alloy invention does not have knowledge on a manufacturing method of the invention, the alloy cannot be easily reproduced or carried out. As a result, the ownership may become obsolete. That is also why the manufacturing method should be stated specifically.

However, if it is possible to manufacture the alloy invention with a normal method, it is allowed to be simply stated as such.

2.2 Requirements for claim(s) (related to Article 42(4) ii of Patent Act)

2.2.1 Limitation of alloy composition

Since an alloy consists of more than two types of elements, its composition which can obtain intended properties or use should be specified. If only alloying elements are recited without a composition range of each being limited, it should be considered that claim(s) is not clearly described since the structure, property, use, etc. may be changed according to the composition range even though the alloy elements are the same due to

characteristic of an alloy. Thus, except for a special case, it cannot be deemed that the claim(s) particularly points out the invention.

※ When rejection is to be issued on the ground that claim(s) does not particularly point out the invention because a composition range of an alloying element is not specified, the reasonable grounds should be stated in detail by looking through whole disclosure of the specification. (See, Part V, Chapter 3, 「5.4.2 Instructions for Written Notice of Ground for Rejection」)

(Example) Since a claim reading “Steel plate for OO consisting of C, Si, Mn, Al and Fe” specifies only alloying elements, its composition cannot be clearly determined. Therefore, alloying elements should be recited together with a composition range of each like “steel plate for OO consisting of C: a-b wt%, Si: c-d wt%, Mn: e-f wt%, Al: g-h wt%, and balance Fe and inevitable impurities”.

(Note) If the composition range is too broad (e.g. ‘steel plate (iron alloy) consisting of constituents A: 0-100%, B: 0-100%, C: 0.0001~5%’ etc.), except for a special case, it should be deemed that the claim is not clearly described since the structure, property, use, etc. of alloy can be changed by a composition range.

(Example) Here are examples of special cases: Homogeneous solid solution, amorphous alloy, commercial alloy notifying its composition, and the alloy included in Industrial Standard (KS, ASTM, JIS, DIN, etc.), etc. Regardless of an alloying composition, it is deemed that homogeneous solid solution and amorphous alloy have similar structure, property, use, etc., and it is not necessary to specify the composition range for commercial alloy notifying its composition and alloy included in Industrial Standard since they have no specialty in alloying composition.

2.2.2 Recitation of allowable range of impurity among alloying elements

It is not allowed to consider an element recited in claim(s) as an impurity except for elements which are defined as impurities through the specification or which can be considered as impurities from common knowledge in the art. Typically, even though it is not necessary to limit allowable range of

every impurity in claim(s), if possible, its allowable range should be stated in the description of the invention clearly. However, allowable range of the impurity which can make great impact on property or use of the claimed alloy should be specified in claim(s).

When manufacturing alloy, it is possible to have unnecessary elements other than essential elements, and those cannot be removed thoroughly by technology or common method.

Those elements are en bloc named as impurity, but property or use of alloy can be affected with only the least amount of them. That is why allowable range of those impurities should be specified clearly for the purpose of publication of the invention (Provided that, if it is described in KS, e.g.: regulation limiting impurity such as standard of KSD 3751). Also, where allowable range of impurity is specified, it is common to specify the upper limit. Therefore it can be expressed like 「0.3 wt% or less」

3. Addition of new matter to specification

An alloy invention is mainly a numerical-limitation invention, and since the numerical-limitation invention has clearer technical scope than that of other inventions, it is more likely to end up in an addition of new matter if the specification or drawing(s) is amended.

Considering the original specification, it is recognized as addition of new matter when amendment such as deletion of an element, addition of a new element and change of a composition range, addition or expansion of new property or use, etc. is made.

However, if there is a reduction of a composition range, and no change of property or use, it is not considered as an addition of new matter.

3.1 Case of addition of new matter

When the claim(s) is amended to include a new numerical range, if the new numerical range and the reasons for the numerical range are not disclosed in the original description of the invention, it is deemed to be addition of new matter.

(Note) For an alloy invention, alloying composition is important technical

feature specifying the invention. Therefore, amendment to add alloying element or a composition range of each element that was not stated in the original specification is deemed to be an addition of new matter since the composition range specifying the invention which was not stated in the original specification is newly added.

(Example 1) Case of amendment to limit a range which was not disclosed in the original specification.

Original application: OO alloy for OO consisting of alloying components (A) (B) (C) and balance Fe

Amended application: OO alloy for OO consisting of alloying components A (a wt%), B (b wt%), C (c wt%), and balance Fe and inevitable impurities

(Example 2) Case of amendment to expand the original numerical range

Original application: OO alloy for OO consisting of alloying components A (4-8 wt%), B (7-12 wt%), C (15-18 wt%), and balance Fe and inevitable impurities

Amended application: OO alloy for OO consisting of alloying components A (6-9 wt%), B (7-12 wt%), C (10-15 wt%), and balance Fe and inevitable impurities

3.2 Case which does not constitute addition of new matter

If it is clear that the numerical range is obvious or inherent from the disclosure of the specification and ordinary skill in the art to which the invention pertains, it can be considered as a case to correct error(s). Therefore, it is not deemed to be addition of new matter.

(Example 1) Case to reduce numerical limitation stated in claim(s)

Original application: lead alloy composition consisting of 100ppm or less Magnesium and a little Calcium amounting to 100 to 900ppm.

Amended application: lead alloy composition consisting of 1 to 80 ppm Magnesium and a little Calcium amounting to 690 to 900ppm.

☞ According to the original specification, enough Calcium is needed for lead alloy for battery, but due to oxidation, the amount of Calcium decreases. To avoid it, if content of Calcium is increased, it will lead decrease of corrosion resistance. Therefore, this invention added a little

Magnesium and it worked to prevent oxidation of Calcium, however, it also reduces corrosion resistance when the concentration of Magnesium gets higher. That is why it is stated that to choose appropriate amount of Magnesium and Calcium is necessary. Also, composition consisting of 20-58 ppm Magnesium and 690-710 ppm Calcium is stated in embodiment and comparative example of the specification. In this case, for alloy invention, if the composition range is not closely related to other property which is relating to effect of invention, the composition range can be amended by statement of specific embodiment. Therefore, it is not included in addition of new matter.

(Example 2) Case to reduce numerical limitation stated in claim(s)

Original application:

Claim

[Claim1] Hollow glass microsphere, ·····, measuring 200 to 10000 μm in diameter

Description

Glass microsphere can freely change its diameter according to the use, and generally the diameter is 200 to 10000 μm and the range from 500 to 6000 μm is more appropriate.

Amended application:

[Claim1] Hollow glass microsphere, ·····, measuring 200 to 6000 μm in diameter

☞ This amendment changes the upper limit of numerical range from 「200-10000 μm 」 to 「200-6000 μm 」, however, the amended numerical range (200-6000 μm) is already included in numerical range (diameter 200-10000 μm) stated in original specification, and the amended upper limit (6000 μm) is specified in original specification as appropriate range. Therefore, amended numerical range is included in matter stated in original specification, etc.

4. Requirements for patentability

4.1 Novelty

4.1.1 Criteria to determine identity

Identity of an alloy invention is determined by whether each element of an

alloy is identical and its composition range and structure are considered to be identical; whether its utility (property or use) is identical.

(Note) Identity of an alloy invention is determined by whether each element of alloy; its composition range; and property or use of alloy are identical. For manufacturing method of alloy, it should be determined whether there is not only identity of an alloy but also identity a manufacturing process. (See, Verdict 98Heo928 sentenced by Patent Court, Dec. 17. 1998)

Provided that, since utility of an alloy depends on the composition and structure of the alloy, its statement should be construed to specify the alloy invention so long as the utility limits a specific composition or structure of the alloy.

4.1.2 Method to determine identity

(1) Case that claimed invention with identical composition and structure of alloy has different property or use

When comparing invention stated in a claim with a prior art invention, if composition and structure of an alloy in both inventions are identical, it is clear that their effects cannot be different, and even though the perceived property is different, both inventions are deemed to be substantially identical.

When comparing invention set forth in a claim with a prior art invention, if the composition and structure of the alloy in both inventions are identical, even though the prior art invention does not disclose its use, it already has the composition range and structure which are appropriate to the use. Therefore both inventions are substantially identical since the difference between both inventions is just a difference of use or a difference on whether there is limitation of use or not.

(Note) Since the invention of claim 1 has identical technical configuration with stainless steel and its manufacturing method disclosed in the claim and the specification of the prior art reference (In the case of an alloy, it is deemed to be identical even when the composition ranges overlap partly as well as completely. If the selection of the specific composition range from the composition range disclosed in the prior art has critical meaning, it may

be acknowledged patentable. However, considering the specification, the numerical limitation of the invention of claim 1 is not considered to have critical meaning compared to that of Prior art reference 1.), the technical objectives or the effects cannot be different (In order to be acknowledged patentable based on the difference of the technical objectives in spite of identical technical configuration, the invention should correspond to a novel use invention. However, the invention of claim 1 cannot be seen to be a new use invention compared to those of cited invention 1.). Therefore, the invention of claim 1 can be considered to be anticipated by the configuration recited in the claim of prior art reference 1 or to be obvious to a person skilled in the art from the disclosure of the specification. (See, Verdict 2000Heo1542, sentenced by Patent Court, Jan. 1. 2001)

(2) Case that alloy compositions are identical but the structure is not disclosed

Typically, the structure of an alloy is dependent on a manufacturing method. That's why it is common that structure of alloy is changed according to a manufacturing method even though the alloy composition is identical. For example, steel and non-ferrous metal for heat treatment may have various metal structures by heat treatment such as heating or cooling. Accordingly, it is natural that an alloy has identical structure when the same manufacturing method is applied to the same alloy composition. Therefore, if the inventions have the same alloy composition and the same manufacturing method, the inventions are substantially identical.

(3) Case that claimed invention with identical alloy composition has different structure, property or use

Even though alloy compositions are identical, if the properties and uses are different, it cannot be recognized as the same inventions. Alloys having a specific alloy composition may have different structures and thus different properties and proper uses accordingly.

(Example) A. Fe alloy for piano wire having composition a

B. Fe alloy for cogwheel having composition a

☞ Both inventions are Fe alloys having the same alloy composition, but considering disclosure of the specification and drawing, and ordinary skill in

the art as of a filing, invention A is directed to 「Fe alloy」 having micro-lamellar structure to supply high strength to piano wire properly. On the other hand, invention B doesn't have the micro-lamellar structure. Therefore, those are different inventions.

(4) Case that alloy composition with property differently perceived has use in same scope

Even though property of an alloy having the same alloy composition is differently perceived, if the property does not produce new use but is included in existing utility, it means that the property is inherent in the alloy. Therefore, substantially, those are same inventions.

(Example) A. Heat resisting alloy	B. Electrical resistance material
Cr: 15-35%	Cr: 15-40%
Al: 5-12%	Al: 6-14%
Fe: Others	Fe: Others

☞ Invention A is a heat resisting alloy with compositions above, and in the specification, it is stated that it has a property such as high temperature oxidation resistance and high electrical resistivity; and it is used as resistance heating element and furnace structure. Invention B is electrical resistance material with compositions above, and the specification states that it has a property such as negative temperature coefficient of electrical resistance and oxidation resistance; and it is used as electric heating wire and thermistor. In this case, since alloy composition, property and use of invention B are the same with those of invention A, substantially both are same inventions.

4.2 Inventive step

4.2.1 Criteria to determine inventive step

To determine inventive step of an alloy invention, alloy composition and necessary structure; utility of the alloy (specific property or use); and specific means (manufacturing method) to obtain structure or utility of the alloy, etc. should be considered.

(1) Case of different alloy composition

Where an alloy which is a subject matter of an invention corresponds to at

least one of the following i), ii), or iii) when compared to the known alloy having the same base, the invention does not involve inventive step unless the claimed alloy has significantly improved utility compared to the known alloy..

i) Case of different composition range

ii) Case of having an additional alloying element

iii) Case of being substituted with another alloying element

For i) and ii) mentioned above, for example, if a certain alloy with 3-8 % of alloying element A is known to the public, an alloy having 1-2% or 9-15% of the A and having the same objective and property with the know alloy corresponds to i). Also, an alloy having 0.05%-0.5% of additional alloy element B corresponds to ii).

For iii) mentioned above, it is the case that if the same purpose and working effect of alloying elements A and B are known to have the same objective and working effect and a certain alloy with A is disclosed, an alloy with B instead of A has no difference with alloy with A in its working effect. (E.g. In case of substituent among constituents of one alloying element group)

(Note) The invention set forth in amended Claim 1 has no Ti or Zr except for the case of impurities, however, the prior art reference has 0.0002-0.500% of Ti and 0.0002-0.500% of Zr respectively or together. The composition ratio of Ti or Zr in the prior art reference can be included in the range of composition possibly recognized as impurities in the invention defined by amended claim 1. It does not seem technically difficult for a person skilled in the art to limit the amount of Ti or Zr of the prior art reference as amount of impurities in the invention set forth in amended claim 1 considering precipitating amount of intermetallic compound and negative effect that rough nitride is made through addition of Ti or Zr. (See, Verdict 2010HEO 1381 sentenced by Patent Court, October. 15. 2010)

(Note) The invention of Claim 1 contains 0.05 to 4.50% of Cr as an essential element, 0.0005 to 0.020% of Mg as an optional element, while the prior art reference discloses a composition consisting of 0.01~2.0% of Cr as an optional element, and 0.0002~0.0150% of Mg as an essential

element. However, both inventions can comprise Cr and Mg as alloying elements and the composition range of the inventions also overlap. Therefore, as long as both Cr and Mg are contained as alloying elements, its composition and effect hardly seem different. (See, Verdict 2009HEO8256 sentenced by Patent Court, June. 17. 2010)

(Note) the claimed invention has 1.05-1.8wt% of manganese and the prior art reference has 0.5-0.95wt% of that, so those do not overlap. ... However, considering the following three points, - ① it is known that the prior art reference also adds manganese to keep sulfur since the specification of the prior art reference mentions that it would be proper to limit the range of manganese in maraging steel from 0.5 to 0.95wt% to form manganese sulfide which facilitates machinability of elements. ② Since the specification of the claimed invention states that more than 0.55wt% of manganese or more than 0.75wt% for better effect would be appropriate for functions such as keeping sulfur etc., it means that the quantity stated in the claimed invention is not that different with that of the prior art reference. ③ Effect of manganese relating to the improvement of hardenability and reduction of quantity of ferrite is also achieved by only adding manganese, so it cannot be considered both inventions have different effects according to the adding quantity. – it is difficult to recognize that numerical limitation of the claimed invention has better technical significance for better effect than that of the cited invention. ... It is also difficult to recognize that the numerical limitation of manganese content in the claimed invention has critical significance. In conclusion, the numerical limitation in the claimed invention for manganese content is just one of proper limits which can be selected by a person skilled in the art though multiple tests. (See, Verdict 2012HEO4247 sentenced by Patent Court, November.16.2012, Verdict 2012HEO10822 sentenced by Patent Court, May.15.2013)

(Note) ① The specification of the claimed invention does not state technical significance of formula 1 or how to induce it, or any descriptions that different qualitative effect or considerable difference of quantitative effect occurs within the numerical range of parameter F defined by formula 1. ②

Numerical range defined by formula 1 depends on the content of elements such as Cr, Mo, Si, V, C, N, Ni, Mn, and Cu used as composition elements, so it means if the composition elements and the contents are the same, so is the numerical limitation. Since the composition elements included in formula 1 and their contents are the same with those of the prior art reference, the elements of the prior art reference results in the numerical range of parameter F when substituting the contents of the elements to formula 1. ③ Although the prior art reference does not disclose Nb, since Nb is an optional element and may not be included in stainless steel of the invention of Claim 1, the difference cannot be recognized. Considering the 3 points mentioned above, it is difficult to consider that formula 1 has better technical significance for better effect compared to the prior art reference, and that effect within or out of the numerical range is absolutely remarkable. (See, Verdict 2012HEO4247 sentenced by Patent Court, November.16.2012, Verdict 2010HEO1367 sentenced by Patent Court, May.15.2013)

(2) Case of different structure or utility of alloy

If the alloy has similar structure or utility when it has same composition and the manufacturing method is similar, the invention does not involve inventive step.

(Note) Since alloy structure depends on a manufacturing method, alloys having same composition range can have different structure according to the manufacturing method. Therefore, it is deemed that the utility (property, nature, use, etc.) of an alloy invention is identical if the composition range overlaps or is adjacent, and the specific manufacturing condition for the process is not different. (See, Verdict 2011HEO9849 sentenced by Patent Court, May.10.2012)

(Note) The claimed invention characterizes in that over 80% of TiB₂ precipitates are single crystal, while the prior art reference does not disclose that. ... both inventions have no practical difference in the composition range for main elements of the steel and usefulness resulted from the different manufacturing method, etc. cannot be considered different. Therefore, it seems that TiB₂ precipitates are dispersed in the matrix within

the identical range by forming a lot of tiny single crystals. ... Based on the 80% of single crystal, it does not show any result or documents proving effect or great difference. It means 'over 80% of TiB₂ precipitates are with single crystal' according to the claimed invention is just a simple numerical limitation, and the difference mentioned above can be easily found by a person skilled in the art through the corresponding structure of the prior art reference and well known or commonly used arts. (See, Verdict 2012HEO0822 sentenced by Patent Court, May.15.2013, Verdict 2011HEO9849 sentenced by Patent Court, May.10.2012)

Chapter 7. Invention of Polymers

Revised and managed by Polymer &Textile Examination Division

1. Requirements for description and Claim(s)

1.1 Requirements for the description of the invention

1.1.1 Invention of polymeric compounds

(1) A particular polymeric compound should be described with specific explanation to sufficiently support the polymeric compound defined in claim(s).

(2) In principle, it is necessary to specify the polymeric compound by requirements representing its structure. The requirements are as follows:

① repeating units, ② arrangement of repeating units (homo, random, block, graft, head-to-tail coupling, etc.), ③ molecular weight, ④ local molecular properties (degree of branching, substituents, double bonds, degree of cross-linking, terminal groups, etc.), ⑤ stereo specificity (atactic, isotactic, syndiotactic, etc.)

(Note) It is prerequisite to specify the polymeric compound since the only technical element of the invention of polymeric compounds is the polymeric compound itself. It is also necessary to specify the polymeric compound based on the requirements representing its structure, which is commonly used in the field of chemistry. In some cases, it is impossible to specify a polymeric compound completely since it consists of a group of molecules which are different in molecular configuration, molecular weight or kind of atoms for construction. However, at least, it is necessary to clearly specify the main components such as atomic groups, molecular configuration, etc. based on the requirements representing its structure. For example, a linear organic polymer whose main chain consists of repetition of an atomic group should be, at least, specified by the repeating unit and molecular weight.

(3) If it is difficult to specify the polymeric compound with the requirements representing its structure, other requirements representing its basic properties can be specified additionally. It should be noted that the requirements representing the basic properties should be described in a quantitative manner. The requirements representing the basic properties include viscosity, crystallinity, glass transition temperature, melting point, density, tensile strength, elongation, modulus of elasticity, hardness, impact strength, transparency, refractive index, etc.

(4) If it is not enough to specify the polymeric compound with the requirements representing its structure and basic properties, its manufacturing method can be added as a part of specification of the polymeric compound where it is possible to specify the polymeric compound more clearly.

(5) Identification data proving the existence of the polymeric compound should be stated specifically for a person skilled in the art to easily and clearly recognize it.

(Note 1) For example, the identification data include results of elemental analysis, results of chemical bond analysis, glass transition temperature, refractive index, molecular weight, melting point, viscosity, infrared absorption spectrum, plasticity, and other physical or chemical properties.

(Note 2) The identification data of a polymeric compound should be measured by the commonly used method in its technical field, and the measuring method should be clearly described. In case another measuring method is inevitably used, the method should be described specifically for a person skilled in the art to carry it out easily.

(6) For a person skilled in the art to easily synthesize the polymeric compound defined in the claim(s), at least, more than one manufacturing method should be specifically described with essential matters such as source materials, manufacturing conditions and, if necessary, manufacturing devices, etc.

(7) If a use of a polymeric compound is defined in the claim, it is necessary to specifically describe at least more than one example which proves that the whole polymeric compound is applicable for the use.

1.1.2 Invention of manufacturing method of polymeric compounds

An invention on a manufacturing method of polymeric compounds comprises 3 essential elements; (a) source materials, (b) processing means, (c) expected products.

(a) If the source material is a new compound, its manufacturing method should be specifically described.

(b) Processing means such as solvents, catalysts, reaction temperature, reaction pressure, reaction time, etc. should be clearly and specifically described for a person skilled in the art to easily carry out the process. Examples also should be stated with specific numerical values and other operating conditions for a person skilled in the art to easily conduct the process.

(c) If the product is a new polymeric compound, the polymeric compound should be specifically identified, and more than one of its physical or chemical properties, which clearly prove its existence, should be specifically stated for a person skilled in the art to easily recognize it.

1.1.3 Invention of polymer compositions

(1) An invention of a polymer composition is described by the matters related to the composition itself and its use.

(2) The matters related to the polymer composition itself are as follows:

(a) Source materials and their mixing ratio, etc. should be specifically described.

(b) If the polymer composition has a special feature related to its state or property, the special feature should be also specifically stated.

(c) Embodiments also should be stated with specific numerical values and other operating conditions for a person skilled in the art to easily carry it out.

(d) If the source material is a new compound, its manufacturing method should be also specifically described for a person skilled in the art to make it easily.

(3) It is necessary to describe which property can be improved or newly obtained by the polymer composition. Also, at least one use of the polymer composition should be stated to prove its utility.

(Note) The utility of the polymer composition is considered to be properly stated when applying the polymer composition to a specific use is objectively described, the use of the polymer composition is evident from the description of properties showing its use wholly, or the use of the polymer composition is obvious from the objectives and technical features of the invention without explicit description of its use.

1.2 Requirements for claim(s)

1.2.1 Invention of polymeric compounds

Claim(s) of an invention of polymeric compounds should particularly define a polymeric compound for which protection is sought.

In principle, the polymeric compound should be defined by its structure. If its structure is not enough, it can be defined by its basic properties additionally. If they are not enough to define the polymeric compound, its manufacturing method can be included as a partial means of definition

1.2.2 Invention of manufacturing method of polymeric compounds

In claim(s) of an invention of a manufacturing method of polymeric compounds, 3 essential elements and the technical relationship between them should be defined: Source materials, processing means, expected products.

1.2.3 Invention of polymer compositions

(1) Polymer compositions itself without limitation of function or use

In claim(s) of an invention of a polymer composition, components and their mixing ratio of the composition should be clearly defined. If they are not

enough to define the polymer composition, the composition's chemical or physical state, properties or a manufacturing method, etc. may be added.

(Note) Components and their mixing ratio should be defined based on the claimed polymer composition itself. If it is impossible to determine the components and their mixing ratio of the claimed polymer composition, it may be allowable to define the polymer composition by the composition of starting materials. However, if the components and their mixing ratio are different between the compositions of starting materials and product materials (In case of, mainly, the composition undergoing phase transition), it is necessary to supplement its definition by adding limitation about the phase transition process or other processing conditions, etc.

(2) Polymer compositions with limitation of function or use

Claim(s) of an invention of a polymer composition with limitation of function or use should define the function or use of the polymer composition in addition to the components and their ratio which can be understood to represent its utility overall. These kinds of claims are expressed by [Composition having a function of XX], [Composition for a use of XX] or [Composition for a use of XX agent].

(Note) The polymer composition claimed as a form of 'having a function of OO', is necessary when functional limitation needs to be added to define the composition by its properties since components and their mixing ratio are not enough to define the composition clearly. For example, if a polymer composition can be defined by its components and their mixing ratio and all polymer compositions satisfying the limitation inherently possess a function of OO, it is enough to define the polymer composition by its components and their mixing ratio without limitation of a function. In the other hand, if it is not enough to define the polymer composition by its components and their mixing ratio which are suitable to achieve the purpose of the invention, the limitation of having a function of OO is an essential element of the invention to define the claimed polymer composition clearly and separately from compositions which meet the limitation of components and their mixing ratio but do not possess the function of OO.

Chapter 8. Invention of textile industry

Revised and managed by Polymer & Textile Examination Division

1. Requirements for description

(1) For an invention relating chemical fiber characterized in material property, since the fiber manufacturing technology has feature that the characteristics of the product can be changed according to the processing conditions such as fiber spinning, drawing, post-treatment, etc., the applicant has to specifically state technical means including source material, structural characteristic of fiber, process conditions, and others to accomplish characteristics in the description of the invention. If it is expected that a person skilled in the art needs to carry out excessive test repeatedly or be in excessive trial and error to carry out the invention since the means mentioned above are not clearly described, it is recognized that the description does not provide enough explanation for a person skilled in the art to easily carry out the invention.

(2) For the invention relating to textile structure such as fabric, knit, etc., since the invention is characterized in the structure of yarn, if the structure is not a basic structure which is readily recognizable to a person skilled in the art, it is necessary for the applicant to specifically state complete characteristics of the structure including repeating unit and manufacturing methods in the description of the invention, drawing(s), etc.

2. Considerations when determining inventive step

(1) Determination on inventive step of an invention relating to fiber made of polymer

An invention using a linear polymer generally known to the public for simply manufacturing fiber without other distinctive characteristics is deemed to have no inventive step.

Provided that, if it is recognized that the invention has distinctive characteristics and utility which cannot be expected from fiber made from

the publicly known linear polymer since it selectively uses a distinctive composition or a structure of the linear polymer, it is deemed to involve inventive step.

(2) Invention of parameter

If a claim specifies an invention on man-made fiber using a new parameter, it is necessary to compare the manufacturing method mentioned in the description and material property such as fiber strength, etc. with those in the prior art to determine whether the invention involves inventive step.

(Example 1) 'Polyester fiber with dimensional stability and its manufacturing method'

Both inventions have substantially identical property value (crystallinity, double-refractive index, etc.) and their base material and specific conditions of the process are also similar or identical. Furthermore, it is already publicly known in the technical field of this invention that if take-up speed increases during the spinning process, melting point will increase within proper scope. Insofar there is no specific case, melting point of undrawn yarn in prior art reference 1 is expected to increase. Therefore, the increase of melting point of undrawn yarn in claim 1 of this invention can be recognized as a result naturally obtained by prior art reference 1 or a result that a person skilled in the art easily comes up with through prior art reference 1.

(Example 2) 'Manufacturing of fine polyester filament'

In this case, claim 1 of this invention is not claimed by concept of parameter defined above or by mathematical formula itself, but it is claimed by value calculated by the mathematical formula through a condition of spinning of fiber. Prior art reference 1 does not use the process parameter mentioned above, but discloses process variables determining value of the parameter. If the parameter is calculated by conversion of using the process variables of prior art reference 1, the calculated value of the parameter can be within the limited range in this invention; most of the process variables in this invention (for example, viscosity of polymer, density, spinning speed, number of filament, diameter of capillary tube, and head cross section area,

etc.), which influence value of the parameter, are substantially identical to those of the prior art reference 1; and most of the process variables also have fixed values. Therefore, the argument by the applicant that process variables are controlled is, in fact, simply within the range controlled in prior art reference 1.

(Example 3) 'Cellulose filament manufactured by solution spinning'

Specific time of rupture is a parameter representing how filament is fibrillated. Since tendency to fibrillation of cellulose filament manufactured by NMMO is an inherent property of cellulose filament and it has to be considered with strength, elongation at break, etc. when a person skilled in the art manufactures the said cellulose filament, it can be recognized as an invention which was already disclosed by the prior art reference before filing of claim 1 invention. Therefore, specific time of rupture is considered as just parameter describing a publicly known inherent property of the cellulose filament manufactured by NMMO in a different manner.

(3) Fiber invention specified with manufacturing method

If the invention specified by a spinning method proves its difference with the prior art through an example and a comparative example considering technical characteristics which assign a suitable property of matter to undrawn fiber formed immediately after spinning by heat treatment and drawing, the invention may be considered to be novel and to involve inventive step.

In construing a claim relating fiber material specified with a spinning method of man-made fiber to determine inventive step, the claim should not be construed to be limited by an embodiment presented in the description of the invention but should be construed to include a whole span of property of fiber material which is possible to produce according to the method specified.

(4) Textile invention with additional design feature

Textile invention with additional design feature is evaluated subjectively since it has only characteristic of exterior beauty revealed by a textile

structure or a processing method. Provided that, although effect of design is generated by merely using the textile structure or process method, if the structure or method is obvious to a person skilled in the art or if each of them is described in prior art, the invention is deemed to lack inventive step. However, if the structure of the design has new technical function, the patentability of the textile invention can be recognized.

(5) Determination of effect revealed by limited shape

Since minute different shape of a component such as ring, traveler, metallic card clothing, knitting needle, etc. may greatly influence the result, it is necessary to consider the effect from any difference between the shapes. Also, if there are some doubts to the effect from a little different shape since it is often difficult to make sure of the effect, it is necessary to consider test data or certified test results, etc.

(6) Examination of textile inventions related to traditional art

An application for traditional art is related to the industrialization of traditional knowledge which has been passed down from masters to pupils, and it may be difficult for an examiner to examine the application precisely only by searching for patent documents. Therefore it is necessary to search non-patent documents. For example, since applications for traditional art such as natural dyeing method are often filed by improving its traditional method, it is necessary to compare technical characteristic of the improved method with prior art of the field to determine inventive step.

(7) Scope of related technical fields when examining inventive step of textile machinery

Textile industry, which has long history in the industrial field, has been developed with machine engineering since Industrial Revolution. Some applications claims characteristic of the invention which is a simple change of design such as a change of chain structure to belt structure or a change of detailed design of basic elements of machine like structure of cam. Although its difference in effect has to be considered, most of all, it is

important to expand the scope of prior art search to general machinery field not limited to related IPC (D section).

Also, since non-patent documents such as a guideline of a device or a catalog which cannot be accessed by Patent Search System may be submitted as information in examination or in an invalidation trial, it is recommended for the examiner(s) to examine the invention by considering level of well-known prior art in other technical fields such as general machine.

(Example 1) When a person skilled in the art to which the invention of claim 1 relating to 'gripper band for high speed rapier loom' pertains, laminates polyester fabric and carbon fiber, molds them with epoxy resin including amid, and then produces surface layer of PTFE mixed with polyimide to improve wear resistance, durability, flexibility, and flexibility of the rapier gripper band, the person skilled in the art should consider not only technical field of gripper band for high speed rapier loom but also general chemical fields regarding PTFE/POLYIMIDE COMPOUND and manufacturing epoxy resin having imide ring .

(Example 2) A person skilled in the art of textile machinery which is the field of this application concerning 'yarn feeding device' easily resolves the incorrect order of bearing roller by combining the part imparting elasticity to the bearing seat in prior art reference 4 with the device of prior art reference 1 or the conventional invention which is stated in the description of this application because bearing in prior art reference 4 is the art commonly used in this field where a machine having part(s) supporting rotation body such as 'roller' is used.

3. How to convert certain unit used in field of textile industry

The thickness of the fiber is stated using count, and there are constant length count system and proportional count system.

Constant length count system is proportional to the fiber thickness, otherwise proportional count system is inversely proportional to the thickness.

Constant length count system: This is a terminology to describe thickness of

fiber including raw silk, rayon yarn and synthetic yarn. This is stated with weight of fiber to the standard length, and this is related to specific gravity. Typically, there are denier and tex which are units of SI.

n denier = n gram per 9000m fiber

n tex = n gram per 1000m fiber

[Related terms] kilotex (ktex), decitex (dtex)

Proportional count system: This is state with length of fiber to the standard weight to describe natural fiber such as cotton, staple, wool, etc. The standard weight depends on kind of fiber and nation (type of the UK, Continent, Germany, etc.)

Count: the number of standard skeins to make 1 pound

Standard skein: 840yd of cotton, 840yd of spun silk, 560yd of worsted, 300yd of wool

n count of cotton = n skein(s) to make 1 pound (where length of 1 skein is 840 yd)

Category	Unit (y)	Unit (x)	Transformation formula
Yarn count, fineness	Tex	Cotton count [Ne]	$y = 590.5/x$ (E.g.: $590.5\text{tex}=1\text{Ne}$)
		Metric count [Nm]	$y=1000/x$
		Kilotex [ktex]	$y=1/1000 * x$
		Decitex [dtex]	$y=10 * x$
		Militex [mtex]	$y=1000 * x$
	Denier (stated as [D], [De], [d], etc.)	Tex [tex]	$y=9 * x$
		Decitex [dtex]	$y=0.9 * x$ (E.g.: $9\text{denier}=1\text{tex}$)
Areal density	[g/m ²]	[oz/]	$y=0.04394 * x$
		[oz/]	$y=33.91 * x$
Inter-transformation of Density/denier/diameter	Diameter (D) [μm]	Density (p) [kg/m ³] Denier [denier]	$D= 11.91 \times$

Chapter 9. Invention of architectural design

Revised and managed by Residential Technology Examination Division

1. Requirements for specification

An invention on architectural design is made by combining space(s) with function(s). That is why it is necessary to state function of the space in claim(s) and the description of the invention, and where it is not the case to easily recognize the functional effect of invention with only function of the space, interaction among functions of unit spaces should be additionally stated in the description of the invention.

The invention of architectural design is stated in two ways; in general, to directly state shape and structure of thing(s), and to specify thing(s) invention by combination of interactive elements of space(s). Since to specify shape and structure of thing(s) is for specifying the space, the both ways can be seen as a same requirement. Therefore, where shape and structure of thing(s) are directly stated, function of space and interaction among the functions should be also stated in the specification.

(1) Case of unclear category of invention specified in claim(s)

In principle, inventions under Article 2(1) of Patent Act are limited to a product or a method. However, in the field of architectural design, since various expressions other than a product or a method are commonly used, it can be confused and unclear whether what is claimed is a product or a method.

For example, the subject matter of a claim such as apartment design, arrangement plan, floor plan, structure system, or plan system, etc. is considered unclear because the category of the claimed subject matter is unclear. Where a claim is intended to be directed to a product, but the claim sets forth a method invention, the category of the invention can be ambiguous.

Therefore, it is necessary to clearly specify the subject matter of the claim according to what should be protected through the invention. It needs to

clearly specify whether the invention is directed to a product such as an apartment, or a method for constructing an apartment, or a method for designing an apartment.

(Example) A method of designing a housing unit of an apartment characterized in that a living room is arranged between a first bed room and a second bed room.

What is to be claimed is not a method for designing but a product comprising a certain combination of a living room and two bed rooms. Therefore, the subject matter of the claim should be stated as an apartment or a housing unit structure, etc.

(Note) Time to distribute design documents

Design documents include design drawing, specifications, structure calculation sheet, and HVAC (Heating, Ventilation, Air Conditioning) calculation sheet. The specification is to show matters not to be stated in drawing such as construction method, types and level of materials, warnings at construction site. Since the specification is prepared for construction, if possible, distribution time can be recognized when a person (commonly general person) who is not under confidentiality can have access to the specification. For example, since submission of specification(s) to public office for permission of construction does not mean the time for disclosure to the public, distribution of the specification may not be allowed. However, documents such as official gazette for city plan, which should be open to the public in principle, shall be distributed at the time of access even though it is under the process of permission of construction.

2. Requirements for patentability

An invention of architectural design is an invention on a construction created by architectural design and a method relating to a construction, which correspond to a product and a method of designing or manufacturing a product. Thus, the invention on architectural design is not different from an invention of a normal product and a manufacturing method. However, there are some unique characteristics of architectural design distinguished from the invention of a normal product as follows: The product is specified

by division or combination of space; the effect is made by interaction among functions given to the space because the space itself cannot have its function; the space with the function given can have another function and if the function is used differently, the invention may cause unexpected result.

2.1 Subject matter eligibility

Invention of architectural design can achieve its purpose and effect with function of unit space and interaction among the functions. It means that the invention cannot be completed by just placement of unit spaces without function or combination of spaces.

Therefore, unless the function is clearly recognized by unit space or products forming unit space, the function of unit space consisting of products should be specified, and, if necessary, interaction among the functions should be specified to complete the invention.

It is noted that function itself and interaction among the functions are not an invention. That is, even though main technical concept of the invention of architectural design lies in the function and interaction among the functions, for application, a product with the function and its interaction should be claimed.

2.2 Novelty and Inventive step

Objectives and effects of an invention of architectural design are associated with function of unit space and interaction among the functions. If claim(s) is construed only in lights of a placement or combination of spaces, excluding function given to the spaces, since it is not possible to specify the invention of architectural design characterized in function of space and interaction among the functions, the scope of the claim has become too broad that its novelty or inventive step may be denied by prior art having totally different objectives and effects.. Therefore, to determine inventive step of the invention of architectural design, it is not allowed to construe the claim(s) by excluding the function, but essentially to consider function of invention and its effect based on different function of space.

(Example) Claimed invention: Housing unit consisting of bedroom, living room and clothing room

Publicly known invention: Hospital consisting of preparing room, operation room, and recovery room

☞ If the claimed invention is construed as a construction comprising the first space, the second space, and the third space by excluding its function, the claimed invention becomes the same with the publicly known invention. That is because, even though purpose and effect of those inventions are different, their components are identical. Therefore, the claimed invention becomes unreasonably an invention lacking novelty and inventive step.

Chapter 10 Computer-related inventions

Revised and updated by computer system examination division

This Chapter mainly explains matters which require special assessment or treatment in examining applications drawn to an invention which requires computer software in practicing the invention (hereinafter referred to as “computer-related inventions”).

Definitions of terminologies used in this Chapter

Software: technology moving hardware in a computer

Hardware: physical devices of which a computer is composed (ex: CPU, memory, an input device, an output device or other physical devices connected to a computer)

Step: a sequence of processes or operations connected in a time sequence to achieve an intended object

Program: a collection of instructions that performs a specific task when executed by a computer

Program listings: presentation of program codes either printed on a paper or displayed on a screen.

Computer readable medium (regarding program): having program code stored thereon to install, execute or distribute the said program

Data structure: a particular way of organizing data in a computer

Computer readable medium (regarding data): an instance of a data type having a data structure stored in a computer readable medium

1. Description Requirements for Specification

1.1 Description Requirements for Claim(s)

This section mainly explains unique determinations whether claims to computer-related inventions comply with the description requirements on the category of the invention.

1.1.1 Computer-related inventions

(1) Method invention

A computer-related invention can be claimed as a method by specifying a series of processes or operations connected in a time sequence, namely steps.

(2) Product Invention

A computer-related invention can be claimed as a product by specifying multiple functions performed thereby.

(3) Claim drawn to a computer-readable-program-recording medium

A computer-related invention can be claimed as a computer readable medium having program code recorded thereon to install, execute or distribute the said program.

(Example 1) A computer-readable medium having a program recorded thereon, wherein the program makes the computer execute procedure A, procedure B, procedure C, ...

(Example 2) A computer-readable medium having a program recorded thereon; wherein the program makes the computer operate as means A, means B, means C, ...

(Example 3) A computer-readable medium having a program recorded thereon; wherein the program makes the computer implement function A, function B, function C, ...

(4) Claim drawn to a computer readable medium having data recorded thereon

A computer-related invention can be claimed as a computer readable medium having data recorded thereon when the structure of data determines operations of the computer.

(Example) A computer-readable medium having data recorded thereon, wherein the data comprise structure A, structure B, structure C, ...

(5) A computer-related invention can be claimed as a computer program recorded in a medium to accomplish specific task or a specific need when

combined with hardware. <the application filed on and after July 1, 2014>
(Example) Computer program recorded in a medium to make a computer execute procedure A, procedure B, procedure C, ...

※ In the aforementioned example, where ‘computer program’ is replaced with the term compatible to computer program, such as application, and etc., the claim is allowed.

※ However, ‘computer program not recorded in a medium’ is not allowed as it claims a computer program per se.

1.1.2 Examples of indefinite claims

Article 42(4)(ii) of the Patent Act prescribes ‘an invention for which a patent is sought must be clearly stated.’ Examples of indefinite claims violating this Act are shown below.

(1) The claimed invention for which a patent is sought is unclear as the claim is stated using ambiguous terms

(Example) [Claim] An order-receiving method using a computer, comprising the steps of: accepting a commodity order from a customer, checking the inventory of the ordered commodity, and responding to the customer as to whether the commodity can be delivered or not depending on inventory status.

☞ The expression “using a computer, comprising the steps of” is indefinite regarding who operates each step of the method. The claim can be interpreted in the following two manners:

The order-receiving method may be construed to be operated by a human being using a computer as a mere computation tool. That is the steps can be construed as: a human being accepting a commodity order from a customer by operating computer, a human being checking the inventory of the ordered commodity by operating a computer, and a human being responding to the customer as to whether the commodity can be delivered or not depending on the inventory status by operating a computer; or

The method may be construed to be an information processing method by computer software. That is, the steps can be construed as: accepting a commodity order from a customer (by means A equipped in a computer),

checking the inventory of the ordered commodity (by means B equipped in a computer), and responding to the customer as to whether the commodity can be delivered or not depending on the inventory status (by means C equipped in a computer).

Consequently, as the two different construction of 'order-receiving method using a computer as a mere computation tool' and 'information processing method by computer software' are possible for a single claim, the claimed invention is indefinite.

(Example) [Claim] A computer readable medium having program code recorded thereon, the program comprising an order-receiving means to accept a commodity order from a customer, an inventory search means to check the availability of the ordered commodity, and a means to respond to the customer if the commodity can be delivered or not, depending on the inventory status.

☞ Program makes the computer operate as a functional means, but the program per se does not function as a means. Therefore, the claimed invention cannot be easily understood as the program per se cannot comprise a functional means. If the claim reads "A computer readable medium having program code recorded thereon, the program makes a computer operate as an order-receiving means to accept a commodity order from a customer, an inventory search means to check the availability of the ordered commodity, and a means to respond to the customer if the commodity can be delivered or not, depending on the inventory status," is the claim is definite in that the program makes the computer operate as a functional means.

(2) The claimed invention is unclear as limitations specifying the subject matter are difficult to understand

(Example) [Claim] A computer to solve a puzzle using the right-brain inference rule

※ 'The right-brain inference rule' is not defined in the description of the invention.

☞ 'The right-brain inference rule' is neither defined in the description of the

invention nor the common general knowledge as of the filing. The claimed invention is not clear as the technological meaning of the limitation defining the invention cannot be understood.

(3) The invention for which a patent is sought is unclear as technical relationship between elements defining the invention is not specified

(Example) [Claim] An information transmission medium transmitting a certain computer program.

☞ Since an information transmission medium inherently has an information transmission function, the mere statement that ‘a certain computer program is being transmitted to anywhere on the information transmission medium at any moment’ cannot technically define an information transmission medium as an invention of a product. Therefore, the invention for which a patent is sought is unclear as there is no technical relationship between elements defining the invention.

(4) The category of an invention for which a patent is sought is unclear

It is unclear which category the subject matters such as program signals, program signal sequence, program product, and program output fall into.

(5) The scope of the invention is unclear due to ambiguous expressions

(Example) [Claim] A compiler apparatus comprising a means to perform lexical analysis at high speed and a means to perform syntax analysis, wherein the both means are enabled to run in parallel.

☞ Even taking into consideration the common general knowledge, since comparison criterion or degree of ‘high speed’ is obscure, the scope of the claimed invention is unclear. If the claim reads “comprising a means to perform lexical analysis and a means to perform syntax analysis...”, the scope of the claimed invention is clear.

(6) A claim recites results to be accomplished by the invention, and it is not recognizable what is claimed (that is, specific means or product or process)even taking into account the claim elements specifying the invention

and level of skill in the art at the time of filing

(Example) [Claim] An aircraft control-computer to predict generation of “down-burst” (air current as much irregular as to impact aircraft flight) phenomena in advance.

※ The description of the invention describes specific means with which generation of “down-burst” can be predicted in advance, but nothing but the means is stated.

☞ The claimed invention is not clearly identified as a specific computer, which can predict generation of “down-burst” phenomena in advance, cannot be defined, even taking into account the common general knowledge as of the filing. As an aircraft control-computer defined only by its function of predicting generation of “down-burst” phenomena in advance, with no concrete processing contents, etc. required to have the function being defined, is not sufficiently specified from a technical perspective, it is evident that and the invention cannot be clearly identified from the statement of the claim even taking into account the statement of the description and drawings. On the one hand, the claimed invention is clear when defined by concrete means or procedure stated in the detailed description of the invention.

※ In a claim defining matter(s) as ‘function, characteristic, and etc.’ (hereafter referred to as ‘function’), how to determine whether the scope of the invention is clear or not

① Where a person skilled in the art may introduce specific matter(s) with the aforementioned function from the statement of the claimed invention, based on general knowledge of the technology as of the filing, the scope of the invention is considered to be clear.

② In this connection, where a person skilled in the art may not introduce specific matter(s) with the aforementioned function from the statement of the claimed invention, based on general knowledge of the technology as of the filing, the scope of the invention is considered generally not to be clear.

③ However, even in case the invention is unable to be understood, (i) if the specification or drawing(s) of the claimed invention can either properly be defined only with the function (ii) or where it is easily understood the

connection between the matter(s) with the function and the level of the technology as of the filing, the scope of the invention is considered to be clear.

④ The 'claim defining matter(s) with certain parameter' and the 'claim defining matter(s) with manufacture method' relate to the case where the claimed invention described in the specification or drawing(s) can properly be defined only if the invention can be defined only with (i) function. If the aforementioned case is considered to be unclear as specific matter(s) cannot be defined based on the statement, it must be unreasonable.

⑤ However, even in such a case, (ii) where it is uneasy to understand the connection between matter(s) with the function and the level of technology as of the filing, as it is hard to assess 'novelty and inventive step', 'violation', the scope of the claimed invention can be considered to be unclear as the function of the scope of the claimed invention is not assured.

1.2 Requirements for the description of the invention

1.2.1 Enablement requirement

The description of the invention shall be stated in such a manner that a person who has ability to use ordinary technical means, and has ability to exercise ordinary creative activity in the field of computer-related invention can carry out the claimed invention on the basis of the description in the specification and drawings and the common general knowledge as of the filing.

1.2.2 Examples of violations of enablement requirement

(1) Where uncommon technical terms, abbreviations, symbols, and etc. are used in the specification without definition so that the claimed invention cannot be carried out

(2) Where the description of the invention states technical steps or functions corresponding to those recited in a claim in an abstract manner does not disclose how the steps or functions can be implemented or performed by

hardware or software so that the claimed invention cannot be carried out
(Example 1) Where an information processing system to execute business methods or game rules is recited in a claim, there is no disclosure in the description of the invention on how to implement such methods or rules on a computer so that the invention cannot be carried out

(Example 2) Where a step for operating a computer are explained only based on a computer display screen (ex: Graphical User Interface (GUI)) and there is no description on how to implement the said operational step on the computer, so that the invention cannot be carried out

(3) Where hardware or software which implements the function of the invention is explained with functional block diagrams or general flow charts in the description of the invention, since the explanation is not sufficient to understand how hardware or software is structured, the invention cannot be carried out

(4) Where an invention is defined using functional terms whereas the embodiment of an invention is explained using a flow chart, the relationship between the said function defined in the claim and the said flow chart in the description of the invention is unclear, so that the invention cannot be carried out

(Example) Where an invention of an information processing system for business support is defined in a claim by specifying a multiple of functional means whereas only the work-flow for the said business is described in the description of the invention, since the relationship between the said functional means defined in the claim and the said work-flow in the detailed description of the invention is unclear, the invention cannot be carried out

1.2.3 Notes

(1) When the description of the invention is described by using functional or operational terms, particular attention must be given to whether the description of the invention is sufficiently clear and complete to the degree that the claimed invention can be carried out by a person skilled in the art on the basis of the common general knowledge as of the filing. If it is found that a person skilled in the art would not carry out the invention, the

examiner should notify the ground for rejection under the Patent Act 42(3)(i).

(2) When there is no concrete disclosure about the matters described in the description of the invention, particular attention must be given to whether the detailed explanation of the invention is sufficiently clear and complete to the degree that the claimed invention can be carried out on the basis of the common general knowledge as of the filing. If it is found that a person skilled in the art would not carry out the invention, the examiner should notify the ground for rejection under the Patent Act 42(3)(i).

(3) The specification or drawings may include a short program listing written in a computer language generally known to a person skilled in the art together with sufficient explanation for understanding of the claimed invention (A program listing can be submitted as a reference, provided that the specification cannot be amended based on the reference(s)).

2. Requirements for Patentability

This section explains requirements for subject matter eligibility and inventive step which are particularly important in examining patent applications for computer-related inventions.

2.1 Inventions subject to requirements

(1) Patentability requirements are applied to “claimed inventions”

(2) The claimed invention is defined on the basis of the language of the claim. In this case, the meanings of limitations (terms) to define the invention are interpreted taking into consideration the specification, drawing(s) and the common knowledge as of the filing.

2.2 Subject Matter Eligibility

To be qualified as a “statutory subject matter” prescribed in the Patent Act, the claimed invention shall be “a creation of technical ideas utilizing a law of nature.”

2.2.1 Basic criteria

The basic criteria to determine whether computer-related invention constitutes “a creation of technical ideas utilizing a law of nature” is as follows:

Where information processing by software is concretely implemented by using hardware resources, the information processing apparatus (machine) which cooperatively operates with the said software or operational method thereof, the computer-readable medium having the said software recorded thereon and a computer program recorded on the medium can be said to be qualified as a creation of technical ideas utilizing a law of nature.

“Information processing by software is concretely implemented by using hardware resources” means that, as a result of reading the software into the computer, the information processing apparatus (machine) or operational method thereof particularly suitable for a use purpose is constructed by concrete means in which software and hardware resources are cooperatively working so as to implement arithmetic operation or manipulation of information depending on the said use purpose.

Since “the said information processing apparatus (machine) or operational method thereof particularly suitable for the use purpose” can be said to be qualified as “a creation of technical ideas utilizing a law of nature,” where information processing by software is concretely implemented by using hardware resources, the said software is deemed to be “a creation of technical ideas utilizing a law of nature.”

※Business-related inventions generally mean new business item or business method implemented utilizing information technology, and to be included in such business-related inventions, information processing by software on a computer should be specifically implemented by using hardware.

2.2.2 Detailed examples for assessing the subject matter eligibility

The actual procedure to determine whether a computer-related invention is “a creation of technical ideas utilizing a law of nature” (statutory invention) or not is as follows:

(1) Understand the claimed invention based on the claim language.

(2) Where information processing by software is concretely implemented by using hardware in the claimed invention, in other words, when information processing equipment (machine) or its operational method particularly suitable for the use purpose is constructed by concrete means in which software and hardware resources are cooperatively working so as to include arithmetic operation or manipulation of information depending on the said use purpose, the claimed invention constitutes “a creation of technical ideas utilizing a law of nature.”

(3) Where information processing by software is not concretely implemented by using hardware resources, the claimed invention does not constitute “a creation of technical ideas utilizing a law of nature.”

(Example 1) [Claim] A computer comprising an input means to input document data, a processing means to process the inputted document data and an output means to output the processed document data; wherein said computer prepares a summary of the inputted document by using said processing means.

☞ It can be said that there exists a flow of information processing of document data on a computer in the order of input means, processing means and output means. However, since the said information processing to prepare a summary of the inputted document and the said processing means cannot be said to be cooperatively working, it cannot be said that the information processing is concretely implemented. Consequently, the claimed invention does not constitute “a creation of technical ideas utilizing a law of nature,” since the information processing by software is not concretely implemented by using hardware resources.

(Example 2) [Claim] A computer to calculate the minimum value of formula $y=F(x)$ in the range of $a<x<b$.

☞ It cannot be said that the information processing to calculate the minimum value of formula $y=F(x)$ is concretely implemented by the fact that the computer is used “to get the minimum value of formula $y=F(x)$ in the range of $a<x<b$.” This is because information processing to calculate the minimum value of formula $y=F(x)$ and the computer cannot be said to be

cooperatively working by only saying “a computer to calculate the minimum value...” Consequently, the claimed invention does not constitute “a creation of technical ideas utilizing a law of nature,” which means that it does not constitute “a statutory subject matter,” since the information processing by software is not concretely implemented by using hardware resources.

※ Examples where special assessment and treatment for computer-related inventions described above are not required in determining whether the claimed invention is statutory.

① Examples not constituting “a creation of technical ideas utilizing a law of nature”

The claimed invention does not constitute “a creation of technical ideas utilizing a law of nature” in the following cases:

- (a) Economic laws, arbitrary arrangements, mathematical formula, mental activity; or
- (b) Mere presentation of information such as image data taken with a digital camera, program for a field day prepared by a word processor, computer program listings and etc.;

② Examples which constitute “a creation of technical ideas utilizing a law of nature”

The claimed invention constitutes “a creation of technical ideas utilizing a law of nature” in the following cases:

- (a) Control of an apparatus (rice cooker, washing machine, engine, hard disk drive, etc.) or performing a processing necessary for the control; or
- (b) Information processing based on the physical or technical properties of an object (rotation rate of engine, rolling temperature, etc.);

2.2.3 Notes

(1) It should be noted that patentability is assessed based on the claimed invention. Therefore, even if an invention wherein “information processing by software which is concretely implemented by using hardware resources” is described in the description of the invention or drawings, when the same effect is not stated in a claim, the claimed invention is deemed as “non-statutory.”

(2) It should be noted that the assessment whether the claimed invention is “a creation of technical ideas utilizing a law of nature” should be made interpreting the meaning of the language (terms) to define the invention, noting that the category of the invention is irrelevant (“an invention of a process” or “an invention of a product”).

(3) When a claimed invention relates to “a program language” so that it is deemed to be an artificial arrangement, it is not “a creation of technical ideas utilizing a law of nature.”

(4) When a claimed invention refers to “program listings” so that it is deemed to be a mere presentation of information, it is not “a creation of technical ideas utilizing a law of nature.”

2.2.4 Data Recording Medium

Patentability of data structure, in other words, a computer-readable storage medium having data structure stored thereon should be assessed according to “2.2.1 Basic Concept” in this Chapter.

2.3 Inventive step

2.3.1 Basic concept

(1) Whether or not a claimed invention involves an inventive step is determined whether the reasoning that a person skilled in the art could have easily arrived at a claimed invention based on the closest prior art can be made by constantly considering what a person skilled in the art would do after precisely comprehending state of the art in the field to which the invention pertains as of the filing.

(2) Concretely, after specifying the claimed invention and one or more closest prior art, one closest prior art most suitable for the reasoning is selected. And comparison of the claimed invention with the closest prior art is made, and the identicalness and the difference in matter defining the inventions are clarified. Then, the reasoning for denying inventive step of

the claimed invention is attempted on the basis of the disclosure of the selected closest prior art, other closest prior art (including well-known or commonly used art) and the common general knowledge.

(3) The reasoning can be made from various and extensive aspects. For example, the examiner evaluates whether the claimed invention falls under a selection of an optimal material, a modification of design, a mere aggregation of features of prior art, or whether the contents of closest prior art disclose a cause or a motivation for a person skilled in the art to arrive at the claimed invention.

(4) When the reasoning can be made as a result of the above method, the claimed invention should be denied its inventive step. When the reasoning cannot be made, the claimed invention should not be denied its inventive step.

(5) Attempts are usually made in the field of software technology to combine methods or means used in different fields or apply them to another field in order to achieve an intended object. Consequently, combining technologies used in different fields or applying them to another field is usually considered to be within the exercise of an ordinary creative activity of a person skilled in the art, so that when there is no technical difficulty (technical teaching-away) for such combination or application, the inventive step is not affirmatively inferred unless there exist special circumstances (such as remarkably advantageous effects).

2.3.2 Problems to be solved by the invention

The problems in connection with “software-implementation” or “computerization” are often common to such computer technologies. “In order to improve the level of decision by using Artificial Intelligence (AI) or Fuzzy Logic,” or “in order to make input-operation easier by using Graphical User Interface (GUI)” are examples of such problems to be solved by the invention. The assessment of “inventive step” should be made taking into consideration

these generally known problems as of the filing.

2.3.3 A person having ordinary skill in the art

A person skilled in the art of a computer-related invention is expected to have common general knowledge both of the applied field of the software-related inventions and computer technology (e.g., systematization technology); to use ordinary technical means for research and development; to exercise ordinary creative activity in design modification; and to be able to comprehend all the state of the art in the field of technology to which the invention pertains (state of the art in the applied field of the said software and the computer technology) as of the filing.

In addition, a person skilled in the art is supposed to be able to comprehend as his/her own knowledge all technical matters in the field of technology relevant to a problem to be solved by an invention. In this case, it is more appropriate to think “a person skilled in the art” as “a group of persons” not as “a single person.”

2.3.4 Examples of exercising ordinary creative activity expected of a person having ordinary skill in the art

(1) Application to other fields

There are lots of cases in which steps or means for implementing the function used in computer-related inventions are often common in function or operation, regardless of the applied field to which the invention belongs. In such cases, it is within the ordinary creative activity expected of a person skilled in the art to apply such step or means of computer-related inventions used in certain applied fields to other fields to implement the same function or operation.

(Example 1) Where there exists the closest prior art on “file retrieval system”, to apply the concrete means for retrieving in said “file retrieval system” to “medical file retrieval system” as the means for retrieving, thereby creating ‘medical information retrieval system’ is deemed to be within the ordinary creative activity expected of a person skilled in the art, since the function of the means for retrieving is common to both systems.

(Example 2) Where there exists the closest prior art of “medical information retrieval system,” to apply the concrete means for retrieving in said “medical information retrieval system” to a “commodity information retrieval system” is deemed to be within the ordinary creative activity expected of a person skilled in the art, since the function of the means for retrieving is common to both systems.

(2) Addition of a commonly known means or replacement by equivalent

It is the exercise of ordinary creativity expected of a person skilled in the art to add a commonly known means for systemization as a constituent element thereof, or to replace part of constituent elements of the system with a well-known means equivalent thereof

(Example) In addition to a keyboard as an input means, to add a means for inputting numerical codes by selecting items displayed on the screen with a mouse or by bar code is deemed to be the exercise of ordinary creativity expected of a person skilled in the art.

(3) Implementation by software of functions which are otherwise performed by hardware

It is within the exercise of ordinary creativity expected of a person skilled in the art to try to implement such function, which has been so far performed by hardware, such as circuits, by means of software.

[Example] It is within the exercise of ordinary creativity expected of a person skilled in the art to implement function of code comparison, which has so far been performed by hardware, such as code comparison circuit, by software.

(4) Systematization of human transactions

There is a case where the closest prior art discloses human transactions in the field of a certain art but does not disclose how to systematize them. Even in such a situation, it is within the exercise of ordinary creativity expected of a person skilled in the art to systematize existing human transactions in the relevant field in order to implement on a computer, if the

said systematization can be implemented by a routine activity of usual system analysis method and system design methods.

☞ System development is usually performed through the processes of: Planning (preparation) -> system analysis -> system design. In the stage of system analysis, for example, the existing work is analyzed and put into written form. Human transactions can also be analyzed for systematization. In view of the actual processes of such system development, it is within the exercise of ordinary creativity of a person skilled in the art to systematize existing human transactions through the process of system analysis

(Example 1) Merely to replace a telephone or a fax with a web page in receiving orders from customers is within the exercise of ordinary creativity of a person skilled in the art.

(Example 2) Merely to change the way of running consumer to customer (C2C) markets in a magazine into a way of managing such service on the web page is within the exercise of ordinary creativity of a person skilled in the art.

(5) Reproduction of a known event in computerized virtual space

It is within the exercise of ordinary creativity of a person skilled in the art to reproduce a known event in a computerized virtual space, provided that the reproduction would have been made by a routine work by using usual system analysis and system design methods.

(Example 1) In a tennis game machine, merely to set the speed of tennis ball after bouncing on a hard court faster than the speed on a clay court is within the exercise of ordinary creativity of a person skilled in the art.

(Example 2) In a racing game machine, merely to change the probability of spinning depending on the conditions of the surface on the road is within the exercise of ordinary creativity of a person skilled in the art.

(Example 3) Merely to regenerate graphically on the computer screen the known I/O interface conditions (forms of buttons and display, and their positional relationship) of a calculator or copying machine is within the exercise of ordinary creativity of a person skilled in the art.

(6) Design modification on the basis of known facts or customs

When different features between the claimed invention and the closest prior art are based on known facts or customs, and as a result of considering other publicly known prior art and the common knowledge (including “event facts”), the different feature is of the nature to be decided at the discretion of a person skilled in the art, and there is no blocking factor for combination, the difference is no more than a design modification decided depending on the need of a person skilled in the art, therefore, it is within the exercise of ordinary creativity expected of a person skilled in the art.

(Example 1) In an electronic transaction machine having a display means, to add a message-outputting means saying “Thank you!” after receiving purchase orders is within the exercise of ordinary creativity expected of a person skilled in the art, as it is common knowledge to express one’s feeling of gratitude when a contract for sale is concluded. It is mere addition of commonly known means to add a message-outputting means to an electronic transaction machine.

(Example 2) To add such a “cooling off system” to an electronic transaction machine is within the exercise of ordinary creative activity expected of a person skilled in the art, as it is commonly known that adding a “cooling off system” is preferred for non-electronic transactions from the view point of consumer protection, and to add a “cooling off system” to an electronic transaction machine can be implemented by a person skilled in the art by using general means for system design means.

※ Under the cooling off system, the buyer can retract the purchase order in a certain period of time, even after placing the purchase order.

2.3.5 Effects of the invention

Since alleged general effects such as “can be processed quickly”, “can process a large amount of data”, “can reduce errors”, “can obtain uniform results” are often obtained as a result of computerization, the results cannot usually be said to be unforeseeable from the knowledge of the state of the art. And inventive step of the claimed invention is assessed as taking the aforementioned general effects into consideration.

2.3.6 Notes

(1) Reference to the fact of commercial success or the equivalent

The fact of a commercial success or the equivalent can be referenced as the fact effective to affirmatively infer the existence of an inventive step. However, it is limited to cases where conviction is gained to believe that the fact is based on the feature of the claimed invention according to the assertion or the proof of the applicant, rather than other causes such as marketing techniques or advertisement.

(2) Treatment of a case where a different feature merely exists in data contents

The novelty of the claimed invention cannot be affirmatively inferred when it is ascertained that a different feature between the claimed invention and the closest prior art merely exists in data contents.

(Example 1) Where there exists the closest prior art of “performance record management apparatus for processing data structure A,” since “student performance record management apparatus for processing data structure A” or “racehorse performance record management apparatus for processing data structure A,” do not change features as “a performance record management apparatus for processing ‘data structure A’,” novelty is to be denied in both cases.

(Example 2) Where there exists a prior art disclosing an “information processing apparatus including computer-readable storage medium having music C recorded thereon where the data structure is B,” since changing “the medium having music C” to “computer-readable storage medium having music D where the data structure is B” has nothing to do with the feature of “information processing apparatus including computer-readable storage medium having music recorded thereon where the data structure is B,” novelty is to be denied.

(3) Recording a program or data on a computer-readable storage medium

Where the difference between the original claimed invention and the closest prior art is within the exercise of the ordinary creativity of a person skilled

in the art, inventive step cannot be affirmatively inferred, even if a limitation of “recording a program or data on a computer-readable storage medium” is added to the claim.

(4) A medium which can transmit information

When the claimed invention is only specified by a feature inherent to the information transmission medium, for example, “a medium which transmits, or can transmit certain information,” the claimed invention cannot be patented because of a lack of “novelty” or “inventive step.”

Since the feature “a medium which can transmit certain information such as a program or data” is a feature inherent to an ordinary communication network, “a medium which can transmit certain information” is not effective to specify the “information transmission medium” as a product. There is thus no difference between the claimed invention and an ordinary communication network, causing the claimed invention to lack novelty and inventive step.

(Example 1) [Claimed invention] An information transmission medium which transmits a program which make a computer execute procedure A, procedure B and procedure C...

☞ The limitation of the claim “(a transmission medium which) transmits a program” can be interpreted to mean “can transmit a program” which is an inherent function for a usual information transmission medium. Because the claimed invention has no different features as a product from the closest prior art (any transmission medium which can transmit any computer-program) or has been easily arrived at based on the prior art reference, it cannot be patented due to lack of novelty and inventive step.

(Example 2) [Claimed invention] An information transmission medium which can transmit certain digital information at the speed of more than 128kbps.

☞ The limitation of “can transmit certain digital information” is not effective to specify the invention of “an information transmission medium which can transmit digital information at the speed of more than 128kbps,” since the performance for communication is not peculiar to “such certain information the transmission medium transmits.” Because the claimed invention has no different features as a product from the closest prior art (any information

transmission medium which has the same performance as the claimed invention) or has been easily arrived at based on the prior art reference, it cannot be patented on the ground of lack of novelty and inventive step.

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