

A Grace Period for Korean Patent System

:Inventions not deemed to be publicly known

7 May 2014

Jay LEE

 **HONESTY & JR PARTNERS**
INTELLECTUAL PROPERTY LAW GROUP

CONTENTS

- I. Amended History and KORUS FTA**
- II. KPA for a grace period**
- III. Requirements, Procedures and Effect**
- IV. Controversial Case**

 **HONESTY & JR PARTNERS**
INTELLECTUAL PROPERTY LAW GROUP

Amended History and KORUS FTA

1993.12.10 "Invention deem to be novel" for very limited events
such as fair exhibition

2001.02.03 "Inventions not deemed to be publicly known" for more extended
events: experimental tests, publications, predetermined web sites
and written presentations in predetermined academic institutions

2006.03.03 "Inventions not deemed to be publicly known" for all the events of
Article 29(1) and 29(2) of the Korean Patent Act ("KPA")

2011.12.02 "Inventions not deemed to be publicly known" on condition that the
patent application is filed within **12 months** from the applicable date

On March 15, 2012, The United States-Korea Free Trade Agreement (KORUS
FTA) became effective and extended the Korean grace period provisions to 12
months for public disclosures made, authorized, or derived from the patent
applicant and will apply to all patent applications filed on or after January 1, 2008.

In 2012, Japan expanded its grace period to include within its scope essentially
any form of disclosure by the inventor, including sales.

 **HONESTY & JR PARTNERS**
INTELLECTUAL PROPERTY LAW GROUP

CONTENTS

I. Amended History and KORUS FTA

II. KPA for a grace period

III. Requirements, Procedures and Effect

IV. Controversial Case

 **HONESTY & JR PARTNERS**
INTELLECTUAL PROPERTY LAW GROUP

KPA for a grace period

Article 29 (Requirements for Patent Registration)

(1) an invention lacks novelty if:

- (i) the invention was publicly known or publicly worked in Korea or a foreign country prior to the filing date of the patent application therefor; or
- (ii) the invention was described in a publication distributed in Korea or a foreign country or was made publicly available through the telecommunication lines, as prescribed by the Presidential Decree, prior to the filing date of the patent application therefor.

Article 30 (Inventions not Deemed to be Publicly Known, etc.)

(1) If a patentable invention falls under any of the following subparagraphs, in applying Article 29 (1) or (2) to the invention claimed in the patent application, on condition that the patent application therefor is filed within 12 months from the applicable date, the patent shall not be deemed to fall under any subparagraph of Article 29 (1)

1. When a person having the right to obtain a patent has caused his/her invention to fall under any subparagraph of Article 29 (1): provided that this shall exclude cases where the relevant application is laid open, or the registration of a patent for the relevant invention is published in the Republic of Korea or a foreign country pursuant to any treaty or Act;
2. When the invention falls under any subparagraph of Article 29 (1) against the intention of the person having the right to obtain a patent;

(2) Any person intending to have paragraph (1) 1 applied shall file a patent application to that effect and then submit a document proving the relevant facts to the Commissioner of the Korean Intellectual Property Office within 30 days from the filing date of the patent application.

CONTENTS

- I. Amended History and KORUS FTA
- II. KPA for a grace period
- III. Requirements, Procedures and Effect**
- IV. Controversial Case

Requirement and Legal Effect

• Requirement

A. Disclosure by the inventor

- For all the events of Article 29 (1)
- Within 12 months from the disclosed date
- With Article 29 (1) or (2) to the invention claimed in the patent application

B. Disclosure against the intention of the inventor

- For all the events of Article 29 (1)
- With Article 29 (1) or (2) to the invention claimed in the patent application

*a person claiming disclosure against the intention of the inventor has the burden of proving that the novelty-destroying event occurred against his/her intention (Supreme Court Case No. 85hu14, decided December 24, 1985).

• Legal Effect

- A patent application shall not be deemed to fall under any subparagraph of Article 29 (1)
- In light of the examination, an examiner does not consider that disclosure.

Procedure

(1) a prospective applicant must submit a written statement to the Korean Intellectual Property Office ("KIPO") Commissioner stating his or her intention to do so, when filing a patent application.

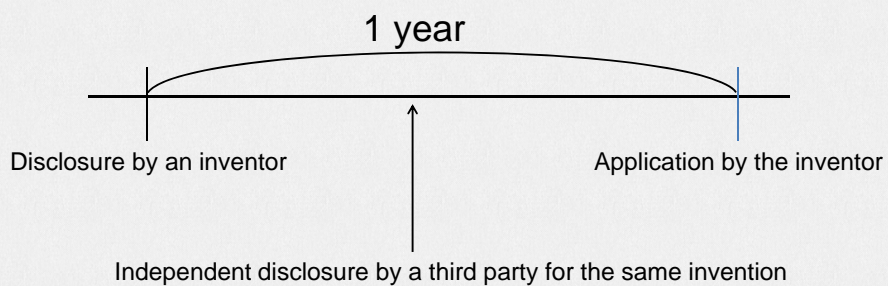
(2) If there was a voluntary novelty-destroying event (first prong), then the prospective applicant must also submit to the KIPO Commissioner supporting documents relevant to the novelty-destroying event within thirty-days of filing the patent application.

* For applications entering the Korean national phase based on a Patent Cooperation Treaty ("PCT") application, both the statement and supporting documents must be submitted to the KIPO Commissioner within thirty days of filing the request for examination in Korea, or within thirty days after the deadline for entering the Korean national phase (thirty-one months from the earliest filing date in a Paris Convention country), whichever is earlier (Article 200).

CONTENTS

- I. Amended History and KORUS FTA
- II. KPA for a grace period
- III. Requirements, Procedures and Effect
- IV. Controversial Case

Controversial Case



The above application will be rejected by the independent disclosure by a third party.

Any Questions?



 **HONESTY & JR PARTNERS**
INTELLECTUAL PROPERTY LAW GROUP