

July 2011

New Policy Amendments to Take Effect on July 1, 2011

Plant Variety Protection and Geographical Indication are now implemented at Korea customs for protection of intellectual property rights

Effective as of July 1, 2011, Korea Customs Office (KCO) announced that, due to the taking effect of the Korea-EU FTA Agreement and the amendment of the Korea Customs Law, products can now not only be protected for the trademark and copyrights but also for Plant Variety Protection (PVP) and Geographical Indication (GI) at customs upon being exported or imported.

In order to be protected of the relevant intellectual property right at customs, first, an applicant needs to report the relevant intellectual property right at customs for recordal. When reporting, an applicant is required to submit (1) a copy of Certificate of Registration for Intellectual Property Right, (2) a document showing the information of potential importers/exporters who are likely to infringe on the rights concerned, (3) materials that would help distinguish the genuine goods and counterfeit (catalogues, photos, documents displaying ways to distinguish the genuine goods and counterfeit), (4) in the case of Plant Variety Protection, a document certifying the license agreement for the use of the products in Korea or overseas, in relation to PVP, and (5) in the case of Geographical Indication, a document certifying that the applicant is the lawful exporter/importer of the products, in relation to GI.

Once the report for the relevant intellectual property right is filed at customs, it is effective for 3 years from the date of report, after which it can be renewed.

The KCO also announced that it was planning to include 'Patents' and 'Designs' as well in protecting intellectual property rights within the next two years.

Background art must be indicated on the Patent (Utility Model) Specification

Pursuant to the amendments in the regulations of number 2, clause 3, Article 42 of the Korea Patent Act, the Korea Intellectual Property Office (KIPO) recently made it mandatory for applicants to indicate the background art on the patent specifications for all patent applications filed at the KIPO, effective July 1, 2011, in efforts to harmonize with the international standards.

According to the amended Patent Act, an applicant is now required to indicate the background art which can be regarded as useful for the understanding, searching and examination of the invention. In addition, the applicant is required to cite the reference reflecting such art.

Also, when the indication of the background art on the patent specification is considered as insufficient during examination, the examiner may issue it as a ground of rejection and notify the applicant thereof. In response to the rejection, the applicant can resolve the ground of rejection by submitting an amendment which cites the reference of the prior art. However, if such an amendment contains newly added, detailed description of the background art, it may not be accepted as an amendment since it is perceived as an addition of new matters.

Korea-Spain Patent Prosecution Highway takes effect

The KIPO announced that the Patent Prosecution Highway (PPH) would come into force starting July 1, 2011 pursuant to the implementation of the MOU in relation to the PPH concluded between Korea and Spain on May 26, 2011. This makes Spain the ninth nation to conclude the PPH with Korea following Japan, the United States, Denmark, the United Kingdom, Canada, Russia, Finland, and Germany.

Now, the implementation of the PPH makes it possible for an applicant to request a preferential examination at the KIPO for an application for which he is claiming convention priority based on the first filing in Spain. It also enables an applicant to request a preferential examination for an application under PCT if it has entered a national phase in both Spain and Korea and if it has not been claimed of convention priority.

Upon request, the KIPO will process the preferential examination within 5 months from the filing date of a preferential examination or within 4 months from the decision date of a preferential examination.

The requirement and procedure for requesting a preferential examination based on the PPH system will remain unchanged with Spain as with the other nations.

Korea-US PCT-PPH goes into effect in Korea

The KIPO announced that Patent Corporation Treaty-Patent Prosecution Highway: PCT-PPH (entering Korea) would take effect on July 1, 2011 in accordance with the established agreement with the Chief of United States Patents and Trademark Office. Meanwhile, the PCT-PPH (entering the US) has already come into force in the United States in relation with Korea since October 6, 2010.

Therefore, now it is possible for an applicant to request a preferential examination through the PCT-PPT system in Korea for an application considered an international application under PCT, if (1) it has entered the national phase in both the U.S. and Korea, and if (2) all of its claims are identical as the claims examined as having novelty, inventive steps and industrial applicability in an international search or an international preliminary examination conducted in Korea or in the U.S.

In order to request a preferential examination, an applicant must provide as supporting materials (1) a copy and a translation of a document including all the claims examined as having novelty, inventive steps and industrial applicability in an international search or international preliminary examination, and (2) a copy and a translation of a written opinion of an international search authority, a copy and a translation of a written opinion of an international preliminary examination authority, or a copy and a translation of the international preliminary examination report, and (3) a copy of the document of the prior art cited by WO/ISR, WO/IPER or IPER.

Upon request, the KIPO will process the preferential examination within 5 months from the filing date of a preferential examination or within 4 months from the decision date of a preferential examination.

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