Information on Korean IP Law

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1. General information on Korean IP Law

(1) Patentable subject matter

The two utility patent categories are process and product.

- Processes are methods and procedures (so to speak : how to do something).
- The product categories, “machine”, “manufacture”, and “composition of matter”, are structural (so to speak : things).

Unpatentable subject matter

Korean Intellectual Property Office(KIPO) does not allow patent upon the invention of diagnosing or medical treatment **method** directed to a human being. The rejection of these inventions is based on failure to meet the industrial applicability requirement.

However, any medical object, device, agent, drug or composition may be patented even if it is directly used for a human being.

(2) Necessary Documents for Filing

(a) an application stating the applicant’s/inventor’s name and address; title of the invention; and priority date
(b) specification stating the title of invention; brief description of drawings; Detailed description of invention; and claims
(c) drawings (if any)
(d) abstract
(e) priority document if priority is claimed. The priority document needs to be submitted within 16 months from the priority date.
(f) Power of Attorney

(3) Request for examination

Request for examination should be filed within five(5) years from the Korean filing date/international filing date.

(4) Examination

(1) Formality examination
(2) Laying open in the official gazette
(3) Patentability examination
-Industrial applicability
-Novelty
-Non-obviousness
-Description requirement for specification
-Definiteness requirement for claims
(4) Examination period

(5) General requirements on claim drafting

① Independent claim

Independent claims do not refer to other claims.

Yet, for avoiding the overlapped recitations, independent claim may be arranged in a way to refer to other claims.

Example :
- The product manufactured by the method recited in claim x
- The method for manufacturing of the product recited in claim x

② Dependent claim

Dependent claims refer to other claims.

If the dependent claim refers to two or more claims, the dependent claim should specify the number of the recited claims.

Example :
- The device according to claim 1 or claim 2, …
- The device according to any one of claims 1 through 3, …

③ Definiteness Requirement

Description in patent specification needs to meet the definiteness requirement.

The following wordings are not allowed for failure to meet the definiteness requirement.

- "and/or", "preferably", "substantially", "optional", "particular", "about"
- negative expressions such as "except for", "without", etc.

④ Multiple dependent claims

A claim which refers to two or more claims (a "multiple dependent" claim) should not refer to any other multiple dependent claims.

⑤ Invention category

Two different categories such as method and product should not be contained in one claim.

(6) Office Action & Filing a Response to Office Action

(a) Office Action
(b) Filing a Response to Office Action
(c) Amendment

(7) Accelerated Examination

(1) Requirements
(2) Effects

(8) Divisional Application

(9) Patent Prosecution Highway

(10) Post Grant Publication

2. Regulations related to biological, pharmaceutical, and medical inventions

(1) Extension of patent term

According to Article 89 of the Koran Patent Law, in the event that authorization or permission under the Pharmaceutical Affairs Law is required to work a patented invention and a considerable period has been taken to complete the necessary steps such as activity test, or safety test, the term of the patent right may be extended up to five years in addition to the twenty year patent term.

(2) Limitations on patent right

① The effect of a patent right does not extend to working a patented invention for research or experimental purposes.

② The effects of a patent right *for the invention of products used for diagnosis, therapy, medical treatment, alleviation or prevention of human disease (referred to as "medicines") that are manufactured by mixing two or more medicines, or for the invention of processes for manufacturing medicines by mixing two or more medicines*, do not extend to the dispensing chemist's act under the Pharmaceutical Affairs Law.

(3) Deposit of microorganisms for the purpose of patent prosecution

(4) Examination standard for pharmaceutical inventions

The subject standard applies to the pharmaceutical inventions, which are intended to be used for a human being directly or indirectly.

(a) General requirement

An invention likely to contravene public order or morality, or to jeopardize

public health or human body may not be patentable.

* Unpatentable examples :

* Patentable examples :

(2) Description requirement

① The patent specification must disclose the effect of the pharmaceuticals which support the medical purpose or usage of the invention.

② The effective dose and method of dosage need to be disclosed in the specification.

(3) Claim drafting requirement

① The preamble of claims should refer to the category of "product" invention

[Example]
Claim 1 : A composition composed of chemical compounds A for treating disease B

② The claims need to define the usage or intended effect of pharmaceuticals.

③ The intended usage of pharmaceuticals needs to be recited in terms of the intended effectiveness relating to diagnosis of disease, medical treatment, alleviation or prevention of disease.

3. Examination standard for medical or sanitary inventions

(1) General requirement

An invention in relation to operation diagnosing, or medical treating **method** directed to a human being may not be patented.

[Patentable examples] The followings are patentable;

The method for diagnosing, operating, medical treatment, or growth expediting directed to animals excluding human beings

(2) References

With respect to the new matter "A" having an effect of anti-cancer, the claim drafting formality varies depending on countries.

In U.S.A., unlike Europe or Korea, medical treatment method directed to a human being is a patentable subject matter. Accordingly, the invention claiming medical treatment method for cancer treatment by injecting the new mater "A" may be patentable in U.S.A.

In Europe, the invention claiming usage of the new matter may be patentable.
[Example : Use of new matter for cancer treatment]

In Korea, the aforesaid claim drafting formalities are not allowable.

The claims need to be written in the form of "Medical composition(Pharmaceutical) for cancer treatment, wherein the medical composition contains the compound A as effective ingredient".

Namely, in Korea, the preamble of the claim needs to be "composition" or "pharmaceuticals"; and the medical usage of the composition or pharmaceutical needs to be indicated in claims.

(3) Matters to be attended to

Under the Korean practice, the test data on the medical effect needs to be disclosed in the original specification. Otherwise, the patent application is subject to rejection for failure of meeting the descriptiveness requirement.

Moreover, it is not allowed to subsequently amend the specification by inserting the test data after the application has been filed.

4. Patent Term

5. Final Rejection & Appeal

(1) Request for Reexamination
(2) Appeal before KIPO
(3) Appeal before Korea Patent Court