

- (iii) if priority claims based on the earlier application concerned have been withdrawn; or
- (iv) if the earlier application has been registered under Article 35(2) of the Utility Model Act.

(2) The applicant of a patent application containing a priority claim under Article 55(1) may not withdraw the priority claim more than one year and three months after the filing date of the earlier application.

(3) Where a patent application containing a priority claim under Article 55(1) is withdrawn within one year and three months of the filing date of an earlier application, the priority claim is deemed to have been withdrawn simultaneously.

## **CHAPTER III**

### **EXAMINATION**

#### **Article 57 Examination by Examiner**

- (1) The Commissioner of the Korean Intellectual Property Office shall have applications for patents and oppositions to the grant of patents examined by an examiner.
- (2) The qualifications for examiners are prescribed by Presidential Decree.

#### **Article 58 Search for Prior Art etc.**

- (1) If considered necessary for the examination process, the Commissioner of the Korean Intellectual Property Office may assign prior art searches to a specialized search organization.

(2) If considered necessary for the examination process, the Commissioner of the Korean Intellectual Property Office may request the cooperation and advice of a government agency, an organization specialized in the technology concerned or an expert with profound knowledge and experience in patent matters, and may pay them allowances or expenses for their cooperation or advice within the limits of the budget of the Korean Intellectual Property Office.

(3) Necessary matters concerning the designation of specialized search organizations, such as a standard for designation and implementation procedures for searching documents under paragraph (1), are prescribed by Presidential Decree.

#### **Article 58bis Cancellation of the Designation of a Specialized Search Organization**

Where a specialized search organization falls under either of the following subparagraphs, the Commissioner of the Korean Intellectual Property Office may cancel the designation of the search organization or order suspension of its business operations within a designated period. However, if a specialized search organization falls under subparagraph (i), the Commissioner of the Korean Intellectual Property Office shall cancel its designation:

- (i) where the search organization has obtained designation through false or unfair means; or
- (ii) where the standard for designation is improper under Article 55(3).

#### **Article 59 Request for an Examination of a Patent Application**

(1) A patent application is examined only when a person files a request for an examination.

(2) Where a patent application has been filed, a person may request the Commissioner of the Korean Intellectual Property Office for an examination of the patent application within five years of the filing date of the application.

(3) For a divisional application under Article 52(2) or a dual application under Article 53, a person may request an examination even after the expiry of the period prescribed in paragraph (2) within thirty days of the filing date of the division or the dual application.

(4) A request for an examination may not be withdrawn.

(5) Where a request for an examination has not been made within the periods prescribed in paragraphs (2) or (3), the patent application concerned is deemed to have been withdrawn.

### **Article 60 Procedure for Requesting an Examination**

(1) A person requesting an examination of an application shall submit a written request to the Commissioner of the Korean Intellectual Property Office, stating the following:

- (i) the name and address of the person making the request (and, if a legal entity, the name and address of the business);
- (ii) deleted; and
- (iii) the identification of the patent application for which the request for an examination is made.

(2) Where a request for an examination has been made before publication of an application, the Commissioner of the Korean Intellectual Property Office shall publish the gist of the request in the Patent Gazette when the application is laid open. Where a request for an examination has been made after the laying open of the application, the Commissioner shall immediately publish the gist of the request in the Patent Gazette.

(3) Where a request for an examination has been made by a person other than the applicant, the Commissioner of the Korean Intellectual Property Office shall notify the applicant.

### **Article 61 Preferential Examination**

The Commissioner of the Korean Intellectual Property Office may direct an examiner to examine an application in preference to another if the former falls under either of the following subparagraphs:

- (i) where a person other than the applicant is considered to commercially and industrially work the invention claimed in the patent application after the laying open of the application; or
- (ii) where urgent processing of the patent application is considered necessary as prescribed by Presidential Decree.

### **Article 62 Decision to Refuse a Patent**

An examiner shall refuse a patent application for any of the following reasons (referred to as "the reasons for refusal"):

- (i) where the invention is unpatentable under Articles 25, 29, 31, 32, 36(1) to (3) or 44;
- (ii) where the application is filed by a person who does not have the right to obtain a patent under Article 33(1) or where the invention is unpatentable under the proviso of Article 33(1);
- (iii) where the application violates a treaty;
- (iv) where the application does not comply with the requirements of Articles 42(3) to (5) or 45; or
- (v) where the application is amended beyond the scope of Article 47(2).

### **Article 63 Notification of Reasons for Refusal**

An examiner who refuses a patent application under Article 62 shall notify the applicant of the reasons and give the applicant an opportunity to submit a

written statement of arguments within a designated period. However, this provision does not apply if the examiner intends to make a decision of rejection under Article 51(1) as applied under Article 47(1)(ii).

#### **Article 64 Laying Open of Application**

(1) By ordinance of the Ministry of Commerce, Industry and Energy, the Commissioner of the Korean Intellectual Property Office shall lay open a patent application in the Patent Gazette more than one year and six months after the date prescribed in any of the following subparagraphs or, upon request of the applicant, within one year and six months of the prescribed date; however, this provision does not apply where the application has already been published in accordance with Article 87(3):

- (i) where a patent application contains a priority claim under Article 54(1), the priority date;
- (ii) where a patent application contains a priority claim under Article 55(1), the filing date of the earlier application as prescribed in Article 55(1);
- (iii) the earliest filing date among the filing dates of two or more applications that are the basis for claiming a priority right in a patent application under Articles 54(1) or 55(1); or
- (iv) where a patent application does not fall under any of subparagraphs (i) to (iii), the filing date of the patent application.

(2) Where an application is laid open under paragraph(1), a person may furnish the Commissioner of the Korean Intellectual Property Office with information and evidence that the invention concerned is unpatentable under Article 62. However, if the person fails to comply with the requirements of Articles 42(5) and 45, as mentioned in Article 62(iv), this provision does not apply.

(3) Article 87(4) applies *mutatis mutandis* to the laying open of applications under paragraph (1).

(4) Matters to be published in the Patent Gazette for the laying open of applications under paragraph (1) are prescribed by Presidential Decree.

### **Article 65 Effects of Laying Open of Application**

(1) After an application is laid open, an applicant may warn a person who has commercially or industrially worked the filed invention, in writing indicating that a patent application for the invention has been filed.

(2) An applicant may demand a person who has commercially or industrially worked the filed invention, after being warned as provided in paragraph (1) or knowing that the invention has been laid open, to pay compensation in an amount equivalent to what the applicant would have normally received for working the invention from the date of the warning or the date on which the person knew that the patent application of the invention had been laid open to the date on which the patent right was registered.

(3) The right to demand compensation as provided in paragraph (2) may be exercised only after the registration of the patent right.

(4) Exercising the right to demand compensation under paragraph (2) does not preclude exercising the patent right.

(5) Articles 127, 129 and 132 of this Act, or Articles 760 and 766 of the Civil Act apply *mutatis mutandis* to the exercise of the right to demand compensation under paragraph (3). In such a case, "the time when the damaged party or his legal representative became aware of such damage and of the identity of the person causing it" in Article 766(1) of the Civil Act reads "the date of registration of the involved patent right".

(6) Where a patent application is abandoned, invalidated or withdrawn after the laying open of the application, or a decision to refuse or revoke a patent under Article 74(3), or a decision to invalidate a patent under Article 133 (unless prescribed under subparagraph (iv) of Article 133(1)) has become final, the right under paragraph (2) is deemed never to have existed.

### **Article 66 Decision to Grant a Patent**

Where an examiner does not find any reason to refuse a patent application, the examiner shall grant the patent.

### **Article 67 Formalities for a Decision of Patentability**

(1) A decision to either grant or refuse a patent (referred to as "a decision of patentability") must be in writing and must state the reasons for the decision.

(2) Where a decision of patentability has been made, the Commissioner of the Korean Intellectual Property Office shall transmit a certified copy of the decision to the patent applicant.

### **Article 68 *Mutatis Mutandis* Application of Provisions Concerning Trial to Examination**

Article 148(i) to (v) and (vii) applies *mutatis mutandis* to the examination of a patent application.

### **Article 69 Opposition to the Grant of a Patent**

(1) Under any of the following circumstances, a person may file an opposition to the granting of a patent with the Commissioner of the Korean Intellectual Property Office after the date on which the patent was registered but not later than three months after the date on which the patent registration was published. Where the patent contains two or more claims, an opposition may be filed against each claim.

- (i) Where a patent is granted in violation of Articles 25, 29, 31, 32, 36(1) to (3) or 44;
- (ii) where an application is filed by a person who is not entitled to a patent under the main sentence of Article 33(1) or where the invention is unpatentable under the proviso of Article 33(1);

- (iii) where a patent is granted in violation of a treaty;
- (iv) where a patent is granted in violation of Article 42(3) or (4);
- (ivbis) where an application is amended beyond the scope of Article 47(2); or
- (v) where a patent is granted in violation of the proviso of Article 87(2).

(2) A person who files an opposition (referred to as "the opponent") shall submit to the Commissioner of the Korean Intellectual Property Office a written opposition with the relevant evidence, stating the following:

- (i) the name and address of the opponent (and, if the opponent is a legal entity, the name and address of the business);
- (ibis) if the opponent has an agent, the name and residential or business address of the agent (and, if the agent is a patent legal entity, the name and address of the business and the name of the designated patent attorney);
- (ii) the identification of the patent to which the opposition is made; and
- (iii) the grounds for the opposition and identification of the relevant evidence.

(3) Article 133(4) applies *mutatis mutandis* to an opposition.

### **Article 70 Amendment of Grounds for an Opposition etc.**

(1) An opponent may amend the grounds and evidence of a written opposition within thirty days of the expiry of the period for an opposition.

(2) When an opposition to the grant of a patent is filed, the presiding examiner designated under Article 71(3) shall transmit a copy of the written opposition to the patentee and give the patentee an opportunity to submit a written response within a designated period.



### **Article 71 Collegial Body for Examination and Decision**

- (1) Three examiners constituting a collegial body shall examine and decide on an opposition.
- (2) The Commissioner of the Korean Intellectual Property Office shall designate the examiners that constitute the collegial body for each opposition.
- (3) The Commissioner of the Korean Intellectual Property Office shall designate an examiner from the collegial body referred to in paragraph (2) as the presiding examiner.
- (4) Articles 144(2), 145(2), 146(2) and (3) apply *mutatis mutandis* to the collegial body and the presiding examiner.

### **Article 72 Examination *Ex Officio* in Examination of an Opposition**

- (1) In the examination of an opposition, grounds that have not been pleaded by the patentee or the opponent may be examined provided the patentee and the opponent are given an opportunity to state their opinions within a designated period.
- (2) In the examination of an opposition, an examination may not be made on a claim that has not been submitted by the opponent.

### **Article 73 Joint or Separate Oppositions**

- (1) Where two or more oppositions have been filed, a collegial body may examine and decide upon them jointly or separately.
- (2) Deleted.
- (3) Deleted.

### **Article 74 Decision on an Opposition**

- (1) When the period designated under Article 70(1) and (2) expires, the collegial body shall decide on the opposition.
- (2) Notwithstanding Article 70(1), where an opponent fails to submit the grounds and evidence within the period for an opposition under Article 69(1), the presiding examiner may decide to reject the opposition.
- (3) Where an opposition is considered to have legitimate grounds, the collegial body shall revoke the patent (referred to as "a decision to revoke a patent").
- (4) Where a decision to revoke a patent becomes final, the patent is deemed never to have existed.
- (5) Where an opposition is considered to have no grounds, the collegial body shall decide to maintain a patent (referred to as "a decision to maintain a patent").
- (6) An appeal may not be made against the decision of an opposition if the decision is to reject or maintain the patent.

### **Article 75 Formalities of a Decision on an Opposition**

- (1) A decision on a patent opposition must be in writing and be signed and sealed by the examiner who made the decision; the decision must include the following:
  - (i) the case number of the opposition;
  - (ii) the name and address of the patentee and the opponent (if the opponent is a legal entity, the name and address of the business);  
  
(*iibis*) if the patentee or opponent has an agent, the name and residential or business address of the agent (and, if the agent is a patent legal entity, the name and address of the business and the name of the designated patent attorney);

- (iii) the identification of the patent related to the decision;
- (iv) the conclusion and grounds of the decision; and
- (v) the date of the decision.

(2) Where a decision on an opposition is made, the presiding examiner shall transmit a certified copy of the decision to the opponent and the patentee.

### **Article 76 Withdrawal of an Opposition**

(1) An opposition may not be withdrawn after a certified copy of the decision under Article 75(2) has been delivered or after a notification stating the applicant's argument has been made under the proviso of Article 72(1).

(2) Articles 161(2) and (3) apply *mutatis mutandis* to a withdrawal of an opposition.

### **Article 77 Correction of a Patent in an Opposition**

(1) A patentee may request a correction to the description or drawing(s) of a patented invention within the period designated under Article 70(2) or the proviso of Article 72(1) when it falls under any subparagraph of Article 47(3).

(2) Where a request for a correction has been made, as in paragraph(1), the presiding examiner shall transmit a copy of the request to the opponent.

(3) Articles 136(2) to (5), (7) to (9), 139(3) and 140(1), (2) and (5) apply *mutatis mutandis* to a request for a correction under paragraph(1). In such cases, "before issuance of a notification of closure of the trial examination under Article 162(3) (where the trial examination is reopened under Article 162(4), before a subsequent notification of the closure of the trial examination is issued under Article 162(3))" in Article 136(9) reads "within the designated period where a notification is issued under Article 136(5)".

(4) Where a decision is made to allow a correction of the description or

drawing(s) of a patented invention, the Commissioner of the Korean Intellectual Property Office shall publish the contents of the correction in the Patent Gazette.

### **Article 78 Suspension of Examination or Litigation Trials**

(1) The examination procedure of a patent application or an opposition to the grant of a patent may, if necessary, be suspended until a decision on an opposition or a trial becomes conclusive or litigation trials have been completed.

(2) The court may, if necessary, suspend the trials until the examiner's decision on a patent application or an opposition to the grant of a patent becomes final.

(3) An appeal may not be made against a suspension under paragraphs (1) and (2).

### **Article 78bis *Mutatis Mutandis* Application of Provisions Concerning Trials to Opposition**

Articles 142, 148(i) to (v), (vii), 154(8), 157, 165(3) to (6) and 166 apply *mutatis mutandis* to the examination and decision of oppositions.

## **CHAPTER IV**

### **PATENT FEES AND PATENT REGISTRATIONS ETC.**

#### **Article 79 Patent Fees**

(1) A patentee or a person seeking to register a patent right under Article 87(1) shall pay the patent fees.