

Main content of the revised Korean Patent Examination Guidelines (Effective as of 30 December 2021)

1. Strengthening examination criteria for the effects of an invention described in the description of the invention and for nonsensical inventions

(1) Background

Strengthening examination criteria for the description of the invention to prevent registration of a patent application in which the claimed invention's effect (medical effect or the effect of a nonsensical invention) that has not been proven is described in the description of the invention.

(2) Revised matter

- If there is a reasonable doubt about the effect of an invention described in the description of the invention, a reason for refusal requesting proof of the effect is notified, and if it is not proven, a decision to reject can be made.
- Even if an effect described in the description of the invention is not related to the invention described in a claim, the examiner may request the applicant to submit supporting data, and if it is not proven after the request, the examination can be suspended or the description of the unproven effect is deleted by an ex officio amendment.
- Inventions with an nonsensical purpose or effect that deviates from social norms, where they include unscientific actions as constitutional elements, are treated as inventions that do not use the laws of nature, and a reason for refusal in violation of the requirement for industrial applicability of the invention can be notified.

2. Reflecting recent precedent regarding the judgment of inventive step in selection invention

(1) Background

There was a recent Supreme Court judgment that the difficulty of a constitution should be considered in determining the inventive step of a selection invention (Supreme Court decision announced on 8 April 2019, Case No. 2019Hu10609).

(2) Revised matter

"Even when there is a generic invention disclosed in a prior invention regarding a claimed invention, its inventive step is not denied if the difficulty of its constitution is recognized. The Guidelines reflects the Court's ruling on the criteria for determining inventive step of a selection invention that the inventive step should not be determined based solely on the

presence or absence of significant effect without considering the difficulty of the constitution just because the generic invention had been disclosed in the cited prior invention regarding the claimed invention.

3. Reflecting revisions to the Patent Act

Revisions to the Patent Act (effective as of 18 November 2021) have been reflected in the Examination Guidelines.

(1) Ex officio amendment (Revision to the Patent Act Article 66-2)

- In issuing a grant decision, the examiner cannot make an ex officio amendment that adds new matters.
- If the examiner makes an ex officio amendment that adds new matters or that does not correct an obvious error, the ex officio amendment will be deemed not to have been made in the first place in determining the scope of protection of the granted invention in a possible patent invalidation trial or patent infringement litigation.

(2) Fee refund (Revision to the Patent Act Article 84(1))

- Even if an application is withdrawn or abandoned after notification of the result of prior art search, the full amount of the examination request fee will be refunded if the examination has not commenced.
- If an application is withdrawn or abandoned before the expiration of the deadline for submitting an Argument against the first Notice of Rejection Grounds, a third of the examination request fee will be refunded.

4. Reflecting revisions to the Patent Examination Procedures Regulations

Revisions to the Patent Examination Procedures Regulations (effective as of 23 June 2021) have been reflected in the Examination Guidelines.

(1) Extension from four months to eight months of the deadline for starting preferential examination by the examiner of an application for which prior art search has been requested

In the case of an application eligible for preferential examination for which a prior art search was requested, the examiner had to start examination within 4 months from the date of sending their preferential examination decision. Now, the deadline for starting the examination has been extended to eight months.

(2) When a third party observation is filed, the applicant is notified of the filing

In the past, the Korean Intellectual Property Office did not notify the applicant of the filing of a third party observation. But according to the amendment to the Patent Examination Procedures Regulations, the examiner notifies the applicant of the filing within one month from the date the third party observation is filed with KIPO.

(3) Strengthening the change of the examiner in charge of an application for re-examination where the examiner's final rejection decisions on the same application are overturned twice or more

- In the past, when an examiner's decision on final rejection of an application was overturned, the application was remanded to the same examiner for re-examination unless there were special reasons, but if the same examiner's decisions on final rejection of the same application were overturned twice or more, the Regulations only said that the same examiner could be replaced by another examiner for re-examination when the same application was remanded for re-examination; as such, there was some discretion on whether to replacing the examiner on the same application whose final rejections were overturned twice or more.
- In the revised Examination Guidelines, for an application that has been remanded for re-examination after an examiner's final rejection decisions have been overturned twice or more, that examiner should be replaced by another examiner, "unless there are special circumstances."

5. Strengthening examination criteria for the entry of true inventors

For an application in which a person who is not a true inventor (especially, a minor including an infant) is listed as an inventor, it is ordered to correct the application form and if not corrected, the application may be invalidated.

6. Clarifying the criteria for determining whether earlier applicants are the same as later ones in an application claiming treaty priority

- The applicant of an application (a first-filed application) that is the basis for claiming treaty priority and the applicant of an application claiming treaty priority (later filed application) must be the same at the time of filing of the later-filed application. In the case of a joint application, the applicants of the later-filed application must be completely the same as the ones of the first-filed application.
- However, even if the first and later applicants are not identical to each other, if all of the earlier applicants are included in the latter, it can be sufficiently expected that there is a separate agreement on the succession of rights between the joint applicants of the later application. Therefore, there is no need to demand a separate document for the assignment of priority from the applicants added in addition to the earlier applicants.

- On the other hand, if some of the earlier applicants are excluded from the later applicants, it is necessary to verify the succession of rights between the excluded earlier applicants and the later applicants.