

# **EXAMINATION PROCEDURE**



**2010. 12.**

**KOREAN INTELLECTUAL PROPERTY OFFICE**

**(Note)** Followings are the English texts of the Korean Examination Guidelines (chapter. 5 Examination procedure) published in 2011. When any inconsistency or ambiguity of interpretation is found between the Korean version and its English version, the Korean version shall prevail.

## **CHAPTER 1. GENERAL**

<b>1. OVERVIEW</b>	<b>1</b>
1.1 FLOW CHART	1
1.2 EXAMINATION PROCEDURE IN GENERAL	2
<b>2. DESIGNATION OF EXAMINER</b>	<b>4</b>
2.1 QUALIFICATIONS	4
2.2 DUTIES	4
2.3 DESIGNATION AND CHANGE OF EXAMINER	4
2.4 INTERNAL REPORTING	5
2.5 FORM AND NAME OF AUTHORITY FOR EXAMINATION-RELATED DOCUMENTS	6
<b>3. IPC ASSIGNMENT</b>	<b>6</b>
3.1 FLOWCHART OF THE IPC ASSIGNMENT	7
3.2 GENERAL PRINCIPLES OF THE IPC ASSIGNMENT	7
3.3 GENERAL RULE OF THE IPC ASSIGNMENT	8
3.4 IPC ASSIGNMENT BY TECHNICAL SUBJECTS	9
3.5 CONFIRMATION OF THE IPC	11
<b>4. LAYING OPEN OF APPLICATION</b>	<b>12</b>
4.1 PURPOSE	12
4.2 DATE	12
4.3 CONTENT	12
4.4 FORM OF BEING LAID OPEN	13
4.5 EFFECTS	13
<b>5. REQUEST FOR EXAMINATION</b>	<b>13</b>
5.1 GENERAL	13
5.2 PROCEDURE	14
5.3 EFFECTS	14
<b>6. START OF EXAMINATION</b>	<b>14</b>
6.1 EXAMINATION ORDER	14
6.2 EXAMINATION TO BE DEFERRED	15
<b>7. PROCESSING DEADLINE</b>	<b>16</b>
<b>8. GENERAL PRINCIPLES FOR LAW APPLICATION</b>	<b>18</b>

## **CHAPTER 2. SEARCH FOR PRIOR ART**

<b>1. OVERVIEW OF SEARCH FOR PRIOR ART</b>	<b>19</b>
<b>2. PROCEDURE PRIOR TO SEARCH FOR PRIOR ART</b>	<b>19</b>
<b>3. SEARCH PROCEDURE</b>	<b>19</b>
3.1 SEARCH SCOPE	19
3.2 CONDITIONS UNDER WHICH SEARCH IS NOT REQUIRED OR IS LIMITED	19
3.3 TIME COVERAGE OF SEARCH	20
3.4 SUSPENSION OF SEARCH	20

3.5 GENERAL PRINCIPLE OF SEARCH .....	21
3.6 CITATION OF PRIOR ART DOCUMENTS .....	21
3.6 OTHERS .....	22
<b>4. MEASURES AFTER SEARCHING .....</b>	<b>23</b>
<b>5. SEARCH FOR PRIOR ART BY SPECIALIZED SEARCH ORGANIZATION.....</b>	<b>23</b>
5.1 SEARCH REQUEST.....	23
5.2 DELIVERY AND REVIEW OF PRIOR ART SEARCH OUTCOME.....	23

## **CHAPTER 3. EXAMINATION PROCESS**

<b>1. OVERVIEW.....</b>	<b>25</b>
<b>2. UNDERSTANDING OF INVENTION .....</b>	<b>25</b>
<b>3. REVIEW OF PRIOR ART DOCUMENTS.....</b>	<b>26</b>
<b>4. SPECIAL APPLICATION.....</b>	<b>26</b>
4.1 PRIORITY CLAIM UNDER TREATY .....	26
4.2 DOMESTIC PRIORITY CLAIM .....	28
4.3 NON-PREJUDICIAL DISCLOSURES.....	30
4.4 DIVISIONAL OR CONVERTED APPLICATION.....	31
4.5 APPLICATION BY A PERSON ENTITLED TO THE GRANT OF A PATENT .....	32
4.6 INTERNATIONAL PATENT APPLICATION .....	33
<b>5. NOTICE OF GROUNDS FOR REJECTION .....</b>	<b>35</b>
5.1 INSTRUCTIONS FOR NOTICE OF GROUND FOR REJECTION .....	35
5.2 REJECTION WITHOUT ADDITIONAL NOTICE OF GROUNDS FOR REJECTION.....	37
5.3 TYPES OF NOTICE OF GROUND FOR REJECTION .....	38
5.3.1 「Non-final Notice of Grounds for Rejection」.....	38
5.3.2 「Final Notice of Grounds for Rejection」 .....	39
5.3.3 Selection of Notice of Grounds for Rejection (Final or Non-final) .....	40
5.4 EXAMINATION ON A CLAIM-BY-CLAIM BASIS .....	40
5.4.1 Purpose.....	40
5.4.2 Instructions for Written Notice of Ground for Rejection.....	40
5.4.3 Preparation of Written Decision of Rejection .....	43
5.4.4 Instructions for Examination on Claim-to-claim Basis.....	44
5.5 DISCLOSURE OF INFORMATION ON PRIOR ART DOCUMENTS.....	45
5.5.1 Citation of Patent Documents.....	45
5.5.2 Citation of Non-patent Documents .....	46
5.5.3 Citation of Electronic Documents .....	47
<b>6. INSTRUCTIONS FOR WRITTEN ARGUMENT AND OTHERS .....</b>	<b>48</b>
6.1 EXTENSION OR REDUCTION OF DESIGNATED PERIOD .....	48
6.1.1 Extension and Approval of Designated Period for Substantive Examination .....	48
6.1.2 Extension and Approval of Period Designated for Formality Examination .....	49
6.1.3 Reduction of Designated Period and Others .....	50
6.2 INSTRUCTIONS FOR WRITTEN ARGUMENT .....	50
6.3 TREATMENT OF AMENDMENTS.....	50
6.3.1 Method to Confirm Amendment of Detailed Description, Claims and Drawings.....	50
6.3.2 Additional Matters to be considered.....	51
6.4 INSTRUCTIONS FOR REFERENCE DOCUMENT IN EXAMINATION.....	53

<b>7. ADDITIONAL SEARCH</b> .....	<b>54</b>
<b>8. EXAMINATION DEFERRAL OR EXTENSION OF PROCESSING PERIOD</b> .....	<b>55</b>
<b>9. DOCUMENT DELIVERY</b> .....	<b>56</b>
9.1 GENERAL PRINCIPLES.....	56
9.2 DELIVERY BY PUBLIC NOTIFICATION.....	56
<b>10. PERSONAL INTERVIEW</b> .....	<b>57</b>
10.1 REQUEST AND GRANT FOR PERSONAL INTERVIEW.....	57
10.2 PROCEDURE OF PERSONAL INTERVIEW.....	58
10.3. INSTRUCTIONS OF PERSONAL INTERVIEW.....	58
10.4. PERSONAL INTERVIEW ON VISIT.....	59
<b>11. AMENDMENT IN RESPONSE TO FINAL NOTIFICATION OF GROUND FOR REJECTION</b>	<b>59</b>
11.1 REMARKS RELATED TO 'FINAL NOTIFICATION OF GROUND FOR REJECTION'.....	59
11.2 EXAMINATION OF AMENDMENT.....	60
11.3 EXAMINATION AFTER ADMISSION OF AMENDMENT.....	63
11.4 EXAMINATION AFTER AMENDMENT DISMISSAL.....	63
<b>12. FINAL DECISION</b> .....	<b>64</b>
12.1 DECISION TO GRANT A PATENT.....	64
12.2 DECISION TO REJECT AN APPLICATION.....	64
12.3 ADDITIONAL NOTES.....	65
<b>13. CANCELLATION OF EXAMINATION MEASURES</b> .....	<b>65</b>

## **CHAPTER 4. REEXAMINATION**

<b>1. OVERVIEW</b> .....	<b>67</b>
<b>2. REEXAMINATION PROCEDURE</b> .....	<b>67</b>
2.1 REEXAMINATION PROCEDURE FLOW CHART.....	67
2.2 EXAMINATION OF FORMALITIES IN REEXAMINATION REQUEST.....	68
2.3 REVIEW OF AMENDMENT APPROPRIATENESS.....	69
2.4 EXAMINATION AFTER ADMISSION OF AMENDMENT.....	70
2.5 EXAMINATION AFTER DISMISSAL OF AMENDMENT.....	71
<b>3. INSTRUCTIONS FOR REEXAMINATION</b> .....	<b>71</b>

## **CHAPTER 5. AMENDMENT *EX OFFICIO***

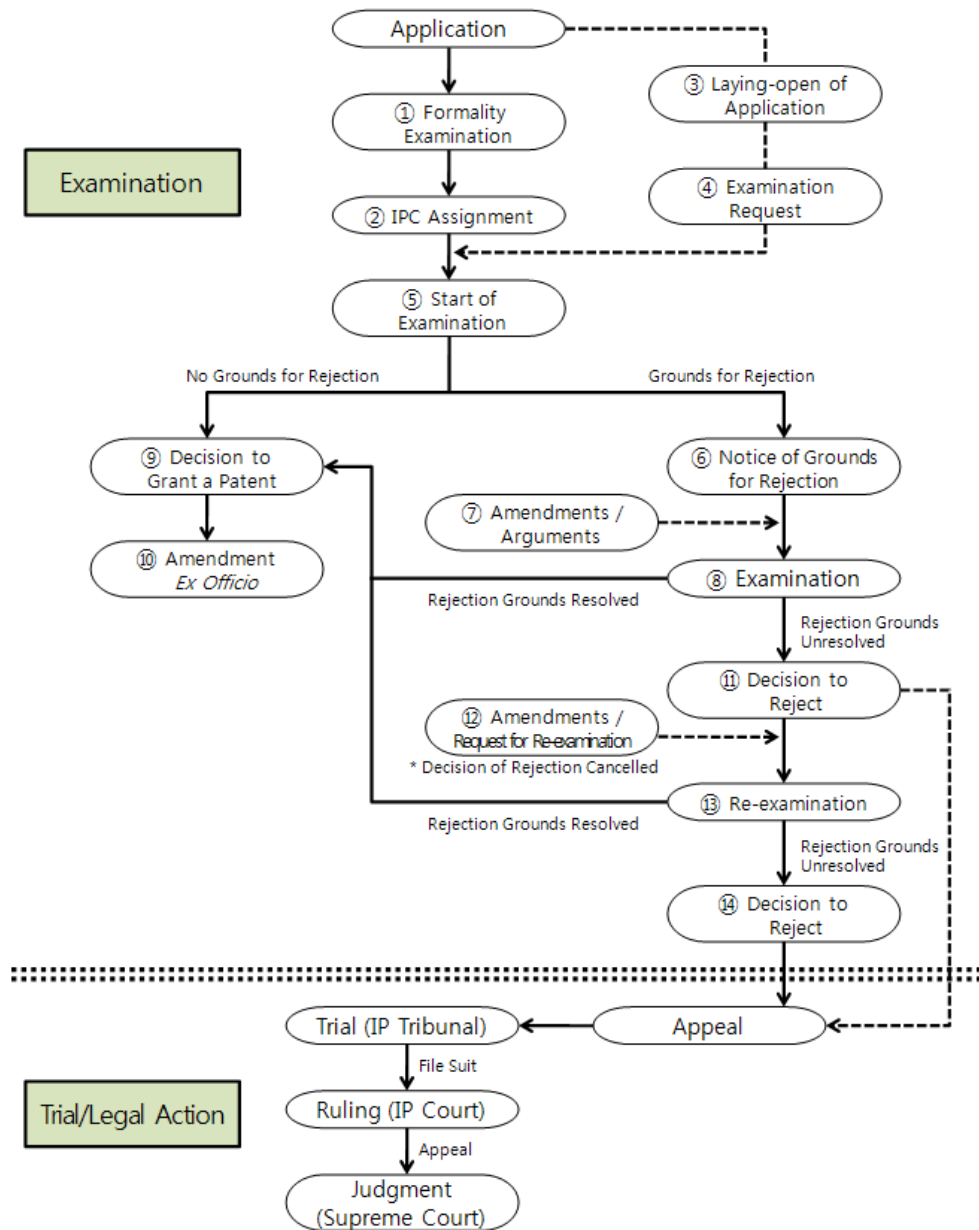
<b>1. OVERVIEW</b> .....	<b>72</b>
<b>2. MATTERS TO BE AMENDED <i>EX OFFICIO</i></b> .....	<b>72</b>
<b>3. INSTRUCTIONS OF AMENDMENT <i>EX OFFICIO</i></b> .....	<b>73</b>
<b>4. PROCEDURE OF AMENDMENT <i>EX OFFICIO</i></b> .....	<b>74</b>

# Part V. Examination Procedure

## Chapter 1.

### 1. Overview

#### 1.1 Flow Chart



## 1.2 Examination Procedure in General

This part briefly sets out the general procedure for examination as referred to the aforementioned flow chart 1.1. Detailed explanation on each stage will be dealt with in the following Part 2~ Part 6.

### (1) Examination of Formal Requirements

The examination of formal requirements is a process to check as to whether an application meets the formal requirements. The followings relates to the requirements: capacity, representation, physical requirements of the application, filing and fees, matters according to each subparagraph of the Article 11 (1) of the Enforcement Rules of the Patent Act.

A preliminary check is in principle carried out in the name of the Commissioner of KIPO by the receiving office where application documents are initially filed. When the receiving office fails to conduct the examination of formal requirements, an examiner can carry out further checks in the name of the Commissioner of KIPO.

### (2) Assignment of International Patent Classification (IPC)

The classification of a patent application is performed with taking into consideration the invention as claimed. It is necessary as an effective search tool for the retrieval of patent documents by intellectual property offices and other users. Currently, KIPO adopts the IPC, a hierarchical patent classification under the control of the World Intellectual Property Organization (WIPO) as its classification.

### (3) Laying-open of Application

The application shall be laid open in the Patent Gazette as soon as after the expiry of a period of eighteen months from the date of filing, where priority if claimed, from the earliest priority date. The application may, however, be published before the date if requested by the applicant. Some applications treated "confidential" may be excluded from publication.

### (4) Request for Examination

An application is examined only when a request for examination is filed. Any person can request for examination within 5 years for a patent application (or 3 years for a registered utility model application filed after 10.01, 2006) from the filing date.

### (5) Start of Examination

The examination is to be carried out by an order of request for examination. The purpose of examination is to ensure that the application and the invention to which it relates meet the requirements set out in the relevant Articles of the Patent Act (Article 46 or 62). The prime task of the examiner is to deal with the substantive requirement, and if he believes formalities are in correct or incomplete, he may invite an applicant to correct such formal deficiencies.

### (6) Notice of Grounds for Rejection

The examiner shall write to the applicant giving reasons for any objections he raises under any subparagraphs of the Article 62, and invite the applicant within a specified period to submit arguments before final decision to reject.

#### (7) Amendments/Arguments

An applicant may submit arguments in response to an examiner's notice of grounds for a rejection and may file amendments to the specification (including detailed description and claims) or drawing(s) within the period designated in Article 47.

#### (8) Examination

Taking account of any amendments proposed, or arguments made, by the applicant in reply to the notice of grounds for rejection, the examiner should examine the application again.

#### (9) Grant of a Patent

Where an examiner finds no grounds to reject a patent application, he decides that a Korean patent be granted.

#### (10) Amendment *Ex Officio*

When making a decision to grant a patent, an examiner may amend *ex officio* the matters in the specification, drawing(s), or abstract attached to a patent application notice that is clearly erroneous. The examiner shall notify the applicant of the matters to be amended *ex officio* along with the delivery of a certified copy of the decision to grant a patent. The applicant can decide whether they accept the amendment *ex officio* by the time for paying patent fees.

#### (11) Decision to Refusal

When an examiner examines the application again with taking account of any amendments or arguments in reply to the notice of grounds for rejection and considers that the applicant has not overcome his objections, the examiner may decide to refuse the application.

#### (12) Amendment/Request for Reexamination

An applicant may amend a specification or drawing(s) to request for reexamination within 30 days from the receipt of a certified copy of the decision to reject a patent (or the extension period if the statutory period is extended). However, the reexamination request is not allowed where there is a decision of rejection after reexamination or where there is a request for a trial against the decision for rejection. Where there is a request for reexamination, the decision to reject the patent application prior to the request is deemed to have been cancelled.

#### (13) Reexamination

In the case where a request for reexamination is made, the decision to reject the patent application prior to the request is deemed to have been cancelled. The examiner shall then take into consideration any amendment provided by the applicant and re-examine the application according to the general examination procedure.

#### (14) Decision to Refusal after Reexamination

Where an examiner considers the amendment made at the reexamination stage, and still finds the stated grounds for rejection not overcome, the examiner shall decide to reject the patent application.



## **2. Designation of Examiner**

The Commissioner of KIPO shall designate a qualified examiner to examine patent applications.

### **2.1 Qualifications**

A person eligible to become a patent examiner shall be the following public officials in KIPO or its affiliated agencies who have completed the prescribed education and training course for a trial examiner conducted by International Intellectual Property Training Institute (IIPTI); A public official of Grade V or higher in general service, a public official in general service who belongs to the Senior Civil Service, or a specialized contract-based public official.

### **2.2 Duties**

(1) Under the direction and the supervision of a director general of a bureau, a head of a division (or a team head), or a head of the examination unit, an examiner shall proceed the examination with speed and accuracy in accordance with the Patent Act and its related provisions. An examiner shall examine independently based on the legal and technical knowledge, provided however that opinions of a director general of a bureau, a head of a division (a team head), or a head of the examination unit be taken into consideration.

(2) For a proper examination, a newly appointed examiner, not more than 6 months in the job from the date of appointment, shall participate in the examination as an assistant examiner. After the assistant examiner period, the examiner shall service the examination jointly with other experienced examiner for additional 6 months. The period for assistant or joint examination can be shortened if certain requirements are satisfied.

(3) If an application for invention relates to convergence technologies mixed with several different technical aspects involved, the examiner in charge, referred to as the "primary examiner" may consult with other examiners in charge of relevant sub-technical classification. If the examiners intend to examine with consultation, the primary examiner shall notify the applicant of this fact, together with names of the consulting examiners and reason why the consultation is necessary. Documents related to the examination with consultation shall be made under the joint name of the examiners concerned while the reporting shall be mainly made by the primary examiner.

The examiner may also consult with other examiners who have an expertise of certain foreign languages such as French, Chinese, Japanese, Spanish, etc for better understanding of prior art documents written in such languages.

(4) If a director general of a bureau acknowledges a need for consulting advice in the case where the application confronts with difficulties in a unified rule application and judgment in examination, the director general may convene a joint conference consisted of more than 3 examiners for their opinions.

(5) According to a duty of confidentiality regarding the information acquired in his official capacity (Article 60 of the State Public Officials Act), the examiner shall carry out their examination duties (including interviews, teleconsulting, etc) with caution. Also, the documents related to a patent application and an examination shall not be carried out except for the purpose of prior art searches, digitization, or on-line remote performance. A response shall not be given to a request for an expert opinion, testimony or an inquiry on the contents of a patent application, examination, trial, or retrial on pending, nor on the contents of a decision of a patentability, trial decision or ruling.

### **2.3 Designation and Change of Examiner**

(1) One or more examiner shall be designated for each IPC and be in charge of the designated examination. One among which shall be designated as a primary examiner. The Patent Examination Support Division has responsibility for appointing primary examiner for each IPC at the request of the director general of the Examination Bureau.

(2) In the case where the examiner transfers to another division within the same or different Examination Bureau after the issuance of the first notification regarding the application examination, the examiner in charge shall continue the examination of the concerned application up to the point of his or her final decision.

(3) An application either requested for reexamination or returned to the examiner after the revocation of an examiner's original decision of refusal shall be examined by the very examiner unless there is a justifiable reason for change of examiner in charge.

(4) Except as deemed necessary for the purpose of expertise and efficiency, an examiner shall not be in charge of the same IPC for 5 consecutive years.

(5) An examiner who falls under the subparagraphs (i)-(v), or (vii) of Article 148 of the Patent Act, or an examiner with less than 2 years experience who is assigned for the application from his/her former employment of the previous 3 year or more right before the appointment as an examiner shall be excluded from the concerned examination. An examiner who falls under the aforementioned reasons may avoid the relevant examination with the permit from a director general of examination bureau.

(6) Notwithstanding the case where an examiner is assigned for a certain application, the designation may change if there is a special reason. For example, in case of a double patent application, the examiner of the original application can be designated as an examiner in charge (Article 15 of Instruction).

## **2.4 Internal Reporting**

(1) When an examiner issues a notification of the grounds for rejection or a decision to grant a patent (registered utility model decision included) for the application returned to the examiner after the revocation by trial against his/her original decision to reject, or if an examiner revokes his/her earlier official actions, the examiner shall report to a general director of an examination bureau following the head of the examination unit.

(2) An examiner shall report to a head of examination team or division following a head of the examination unit for the followings; a decision to reject a patent (including a decision to reject a registered utility model, but not including the case where the rejection is made due to no submissions of argument/amendment), a ruling to dismiss an amendment, an invalidation measure (excluding the case without submissions of amendment following amendment order), a notice of the grounds for rejection or a decision to grant a patent for the application on reexamination request (including a decision for utility model registration), a ruling of dismissal for accelerated examination request, a request for correction regarding serious deficiencies, a request for amendment, a notice for rejection grounds, or a decision to grant the registration of extension or to reject the extension registration regarding the registration of extension of the term of a patent right.

(3) In the case where an examiner takes measures other than the aforementioned, an examiner shall report to a head of the examination unit, provided however that depending on an examiner grade (classified into examiner, junior examiner, senior examiner and chief examiner), reporting to a head of the examination unit may be exempted under the following cases.

① Where a junior patent examiner calls for supplementation regarding the accelerated examination request or notifies of the decision for the accelerated examination (only if a requester of

an accelerated examination is not an applicant)

② Where a senior patent examiner notifies of rejection grounds, calls for supplementation regarding the accelerated examination request, notifies the decision for the accelerated examination (only if a requester of an accelerated examination is not an applicant), or orders the applicants to report on the results of the consultation where two or more applications claiming identical inventions are filed on the same date.

③ Where a chief patent examiner reports to a head of the examination unit except for the final decision to grant a patent or to reject a patent application (including a utility model registration rejection, but excluding the rejection due to no submission of argument or amendment), a ruling to dismiss an amendment, an invalidation measure, or decision to extend or reject an application to register an extension of the term of a patent right.

(Note) Grade of examiner is decided in accordance with experience in patent examination, assessment of examination performance, completion of required training program for each level. The decision is made by the advancement deliberation committee in KIPO. Qualifications for a chief examiner requires more than 10 years of examination experience, more than 7 years for a senior examiner and more than 4 years for a junior examiner, together with completion training courses. (Article 5-7 of Instruction on Operation of Patent Examiner Grade System)

## **2.5 Form and Name of Authority for Examination-related Documents**

(1) If KIPO determines a due form for a certain documents to be submitted, it is the principle to use the due form. If there is no designation of a due form, a general document form should be used in accordance with Instruction on Office Management.

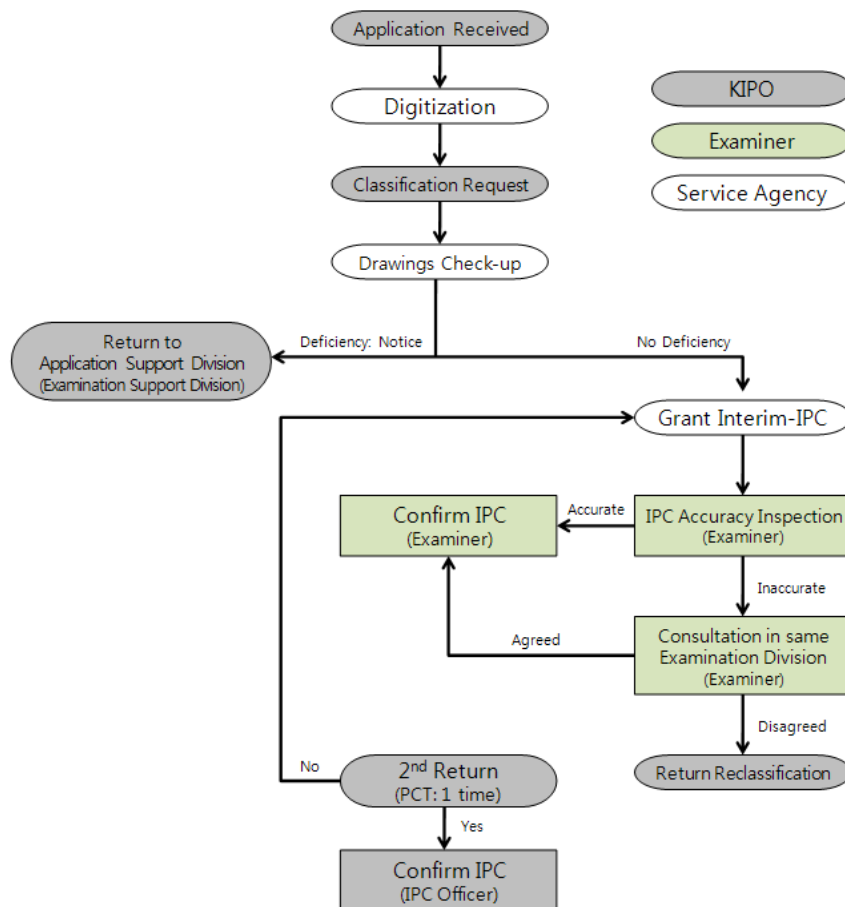
(2) If there is a document attached, the attached documents shall be listed at the end of the document body.

(3) Patent examination shall be conducted in the name of the examiner in charge except for a request for an amendment pursuant to the Article 46 of the Patent Act, invalidation measures of the Article 16, issues of returns in the Article 11 of the Enforcement Rules of the Patent Act, and matters concerning an accelerated examination. Joint examination or examination with consultation shall be carried out under joint names of all examiners concerned.

## **3. IPC Assignment**

The IPC assignment has to be made in an accurate manner based on the scope of the invention of each application since it is necessary as an effective search tool for the retrieval of patent documents by intellectual property offices and other users.

### 3.1 Flowchart of the IPC Assignment



### 3.2 General Principles of the IPC Assignment

(1) The technical subject-matter stated in the claimed invention of an application (hereinafter referred to as 'technical subject-matter') are classified into the IPC symbols comprised of section, class, sub-class, main group and sub-group(not required if there is no pertinent further classification criteria after main group). The classification shall be made on the basis of the scope of the claimed invention. However, when the scope of the invention is not clear, the classification has to be based on what is understood from the detailed description. In addition, some technical subject-matter not in the claims but only included in the detailed description can be an additional basis for the classification.

(2) Where multiple technical subject-matters are involved in application, core technical subject-matter representing the claimed invention as a whole is categorized as 'main classification', while other remaining technical subject-matters are categorized as 'sub-classification'. However, in the case where there is difficulty in separating the core technical subject-matter from the other multiple technical subject-matters, claim 1, the first claim can be referred as a basis for classification.

(3) The classification shall be determined based on the essential contents of the claimed invention as a whole without considering into consideration the category of invention.

(Ex1) In case of electronic radio circuit comprising a tuner, a demodulator, an amplifier, and an output circuit, these four parts of the circuit are not individually classified. Rather, the classification is determined based on the whole electronic radio circuit comprising the abovementioned four parts. Yet, if the core technical subject-matter of the claimed invention concerns one specific part of the circuit, such part can serve as a basis for the classification.

### 3.3 General Rule of the IPC Assignment

(1) The IPC has two kinds of classification places: "function-oriented" place and "application" place. To classify the claimed invention pursuant to the IPC, the judgment shall be made first for the classification places depending on the technical subject-matter of the claimed invention.

#### ① In case of Application Invention

If the claimed invention concerns single use and has an appropriate classification place for the application in the IPC, such classification place becomes the classification basis. In the meanwhile, where the IPC has no such relevant classification place for the application (use), then the function-oriented classification place becomes a main classification for the invention while the similar place for the pertinent application (use) becomes a sub-classification.

If the claimed invention concerns multiple uses, it is the principle that the relevant function becomes the classification place. However, if the multiple uses are mentioned only for describing the extension of the main use, the classification place of the main use becomes main classification in the IPC, while the other uses become sub-classification.

#### ② In case of Function-oriented Invention

Things "per se" characterized by their intrinsic nature or function independent of its field of use are considered as pure function-oriented invention. The function-oriented invention shall be classified based on the pertinent function place. However, if the IPC has no pertinent place for the function, the main use prescribed in the description shall be a classification place. In this case, it is advisable to state the place of main use as sub-classification.

(Ex 1) Sub-class F16K is classified with its function only, which is independent of the valve's specific filed of use. In the meanwhile, valves for pressure cooker, heart, and vehicle have classification places in A47J, A61F, and B60, respectively, which is decided in accordance with the use of valves.

(2) The IPC in patent documents has three different entries/schemes such as 'IPC identification abbreviation' 'classification symbols describing invention information/additional information or indexing code showing additional characteristics of the subject-matter to be classified', and 'version directive'. The classification symbols and indexing code in patent documents shall be stated in the order of 'classification symbols describing invention information' → 'additional information (non-invention information)' → 'indexing code (showing additional information only)'.

The invention information and additional information shall be expressed in boldface style and regular style, respectively. Patent documents in countries with extension level shall be expressed in italic type, while countries with basic level shall express in regular type.

#### (Ex1) Countries with Extension Level (Korea)

Int. Cl.	IPC Identification Abbreviation
<b><i>C04B 32/00</i></b> (2006.04)	Version Directive, write in square style for month, year
<b><i>B28B 5/00</i></b> (2006.01)	<b>Boldface style for invention information</b>
<b><i>B28B 1/29</i></b> (2007.04)	Regular(non-bold) style for additional information
<i>H05B 3/18</i> (2008.07)	<i>Italic style for extension level</i>
<i>C04B 111/10</i> (2006.10)	Indexing code used only for additional information

3 extension level classification symbols describing invention information:

C04B 32/00, B28B 5/00, B28B 1/29

1 extension level classification symbol describing additional information: H05B 3/18

1 indexing code describing additional information: C04B 111/10

(3) It is discretionary to grant additional information for the already classified invention. The additional information can be given by either indexing code or classification symbols.

With regard to classification confirmation, the classification symbol for invention information and additional information can be I (first letter of Invention) and N (first letter of Non-invention), respectively. Yet, the main classification shall always have attributes of invention information while the indexing code has those of additional information.

For the purpose of treating the technical matter not in claims but included in detailed description or drawing(s) as preferable research, the invention can be given a classification symbol for the additional information. The method of granting a classification symbol for technical subject-matter applies mutatis mutandis.

(4) Where lack of unity of invention exists, the classification place stated in subject matter stated in 'claim 1' becomes the main classification while the place for other claims becomes sub-classification.

(5) With regard to the claimed invention which requires confidentiality due to national security, is liable to contravene public order or morality or to injure public health, or relates to convergence technologies, etc., such requirement and concerns shall be stated too.

(6) With regard to divisional application, converted application, domestic priority claim, or application of lawful holder of the right, the classification of an earlier application shall be identified first. Except when the classifications given to an earlier application obviously fail to correspond to the subsequent application, it is preferable to remain the same classification of an earlier application as main classification of a subsequent application while designate the newly granted classification as sub-classification.

### **3.4 IPC Assignment by Technical Subjects**

#### **(1) Apparatus or Method**

In principle, the classification place for either an apparatus or a method shall be used if a pertinent place for either of them exists. However, if the apparatus has no classification place, then the method in the apparatus shall be used for a classification place. In the case where the classification place for a method does not exist, the place for an apparatus which performs the method shall be used. If neither an apparatus nor a method has a relevant classification place, the place for the product which was manufactured with the apparatus or the method shall be used.

#### **(2) Products**

The manufactured product shall be classified with the place pertinent to the product. If no such place exists, an appropriate function-oriented place shall be used. And if there is no appropriate function-oriented place, then the areas using this manufactured product shall be used for classification place.

### (3) Multistage Process or Plant

A multistage process or a plant such as a process with plural stages or a composition with plural apparatuses shall be classified with such of place pertinent to the composition (for example, B09B). If there is no such classification place for the composition, the place for the output produced from the composition shall be used. In the case where constituents of the composition have individual characteristics, each constituent shall be classified, too. Provided however that the composition has no intrinsic characteristics but its constituent has, the composition shall not be classified.

### (4) Specifics or Structural Parts

If structural or functional specifics or parts in the claimed invention are used only for a certain apparatus, the claimed invention shall be classified into the place for the apparatus. However, if such specifics or structural parts can be used for more than 2 apparatus, it is advisable to classify in place for that specifics or parts. In the meanwhile where there is no place for them, it shall be classified in place for the relevant apparatus.

### (5) Single Technical Subject Matters Included in Multiple Groups

In the case where a single technical subject matters is related to more than 2 groups directly and intrinsically, the technical subject matters relevant to multiple groups shall be classified in the place for all the related groups. Also, if a single technical subject matters is included in more than 2 groups of equal level under the same main group, the technical subject-matter shall be classified in the place for a higher hierarchic group; provided however that the inclusion into multiple groups is of little importance for search and the combination of elements simply arrives to this single technical subject matters. Yet, where the technical subject is related to several groups under different main groups, the subject-matter shall be classified in place for each group.

### (6) Compounds

The technical subject-matter of chemical compounds (organic, inorganic or polymer) shall be classified in the relevant place for Section C pursuant to its intrinsic characteristics of compounds (i.e. chemical structure). If the compound is also related to the field of use and the field of use is essential content of the technical subject-matter, the field of use shall be classified in the place if a pertinent place exists. However, if the technical subject-matter of the claimed invention is related to the use of the compound, only the field of use can be classified in the place.

### (7) Mixtures or Compositions

In the case where mixtures or compositions are technical subject-matters in the claimed invention, they shall be classified in the relevant place pursuant to the intrinsic features of mixtures or compositions (for example, C03C for glass composition, C04B for cement or ceramic composition, C22C for alloy composition). If there is no relevant place, they shall be classified pursuant to their use or application. And if there are essential characteristics in the use or application, the mixtures/composition per se and their application or use shall be classified into the place.

### (8) Manufacture or Treatment of Compounds

When the technical subject-matter of the claimed invention is related to the manufacture or treatment of compounds, the compounds per se shall be classified provided however that the methods of manufacture or treatment shall be also classified if pertinent places exist. Yet, the general method of manufacture or treatment of compounds shall be classified in the place if the relevant place exists.



## (9) Classification of Compounds in Markush Type

With regard to chemical compounds in Markush Type which is generally defined in a chemical formula, the general chemical formula of the compound shall be classified in the place individually if the formula has a few relevant places (for example, less than 5).

If specified compounds are things per se in the claimed invention (particularly composition), output produced from the process of claims, or their derivatives, the compounds shall be classified in each relevant place of the above mentioned. 'Specified' in this text refers to ① 'designated' of the structure of compounds by title or formula or 'inferred' from the manufacturing method of a specific reactant among selective reactants, or ② 'identified' with physical properties (for example, melting point) in the description or 'described' as an implement example where the manufacturing method is depicted in detail.

They are classified as useful information for the purpose of other searches.

## (10) Classification of Compounds in Combinatorial Libraries

With regard to combinatorial libraries where a large number of different compounds or bioactive substances are involved, each individual compound shall be classified pursuant to the same method as the classification of compound in Markush type. Provided however, the characteristics of the entire library shall be classified into the combinatorial chemistry (C40B).

### 3.5 Confirmation of the IPC

(1) When the pre-classification is assigned by an outsourcing agency and transferred to the examiner in charge, the examiner shall check as to the pre-classification has been appropriately made based on the technical subject-matter of the claim with referring to the detailed description and drawings (if necessary). If an application has been found to be incorrectly pre-classified by the agency, the examiner may reclassify the classification with appropriate classification places.

The IPC classification has a hierarchical structure consisting of IPC section → subsection → class → subclass → main group → subgroup. In consideration of the hierarchical structure, the classification shall be determined following hierarchical path from high to low level.

(2) After the pre-classification is verified or reclassified correctly, the pre-classification is confirmed as 'official classification' by the examiner in charge. If further classification is required with consultation of other examiners in the same examination division, the application is re-allocated to another examiner and reclassified by mutual agreements between the examiners concerned. The examiner receiving the application shall 'confirm' the classification.

(3) Where different examination divisions are involved for classification modification, or even if it is done within the same division but fails to reach an agreement between examiners concerned, the classification adjustment shall be requested by stating the reasons for reclassification.

(4) In the case of second request (or first request for international application) for the reclassification of the same patent application, officers in Examination Division who are responsible for modifying the classification presumably pertaining to the application shall modify the classification through mutual agreement. If the officers in charge of classification modification in the Examination Division fail to reach a mutual agreement, the classification shall be modified in the presence of a Bureau classification officer (in the case of different examination bureaus involved, all Bureaus classification officers shall attend). When there still remains disagreed, the classification modification officers in the Examination Bureau and Division shall reach an agreement for classification under the initiative of the officer in charge of pre-classification review in the Patent Examination Support Division.



(5) With regard to an application on the request for an accelerated examination and an application which requires an international search pursuant to the Patent Cooperation Treaty, the classification confirmation or reclassification request shall be made within 2 weeks from the day of application transfer or receipt. This time limit shall be extended for 1 month for applications other than the aforementioned.

## **4. Laying Open of Application**

### **4.1 Purpose**

The scheme for laying open of application was introduced along with the system for examination request. The laying open of application, regardless of examination performance, is designed to prevent overlaps in investment and research by publication of the application after the prescribed period elapsed from the filing date.

In the past when the laying open of application was not introduced, the application was not laid open until its registration. Therefore, if the examination on the application was delayed, so did its publication. This results in not only devaluation of the invention as a technical information but also failure to use the invention as common knowledge for social contribution in industrial development. In this regard, the examination on the application and its publication are separated and the system for laying open is introduced after the prescribed period elapsed from the filing date.

### **4.2 Date**

(1) The time for laying open of application shall be more than one year and six months after the application filing date. However, as for the applications on priority claim under the treaty or on domestic priority claim, the publication time shall be reckoned from either the filing date of application in the country where the initial application is filed or the filing date of the earlier application (or the earliest filing date if the application involves more than 2 priority claims)

(2) Since divisional application or converted application is accorded the same filing date as the parent application, the time for laying open is reckoned from the filing date of the parent application. Therefore, if the divisional or converted application is filed before the publication date of the parent application, the application shall be laid open later than one year and six months from parent filing date. In the meanwhile, if they are filed after the publication date of the parent application, the application shall be laid open without delay.

(3) If an applicant submits the early publication request form (Form (xxv) in the Enforcement Rules of the Patent Act), the application can be laid open within one year and six months from the filing date.

### **4.3 Content**

(1) In principle, all patent applications shall be laid open after the expiry of the period of one year and six months from the date falling under any subparagraphs in the Article 64 (1) of the Patent Act or before that date if requested by applicants. The matters to be laid open are enumerated in the Article 19 (3) of the Enforcement Decree of the Patent Act, provided however that the following application, which is in general to be laid open, shall be excluded; an application which omits the statement of scope of claims as prescribed in the Article 42 (5) of the Patent Act, an application whose registration is published, or an application which is invalidated, withdrawn, abandoned, or decided to reject.

(EX) With regard to the original application as a basis of domestic priority claim, it shall be laid open when an application requests its early publication before it is regarded to be withdrawn (i.e., within one year and three months from the filing date of the original application) or the due date for

publication arrives (for example, the original application where the priority under the treaty is claimed at the same time).

(2) The patent application shall not be disclosed in patent gazette if it contains matters which require confidentiality due to national security, or is liable to contravene public order or morality or to injure public health. (the Patent Act Article 64, the Enforcement Decree of the Patent Act Article 19 (3))

#### **4.4 Form of being Laid Open**

The application is laid open in online patent gazette on KIPO website. The same publication can be found in DVD-ROM and via KIPI website.

#### **4.5 Effects**

(1) After an application is laid open, the applicant may give a written warning that the patent application for the invention has been filed. The applicant may demand a person who has worked the field invention as a business, after the person being warned in writing 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 a registration of establishment of the patent right was made. Provided however that the right to demand compensation may not be exercised until the registration for establishment of the patent right. Exercising the right for compensation does not preclude exercising the patent right (Patent Act Article 65(1)-(4)).

(2) If the application is laid open, the claimed invention shall achieve a status as prior art pursuant to subparagraphs ( i ) and (ii) of Article 29 (1) and also can be used for another application for a patent or utility model registration pursuant to the Article 29 (3) of the Patent Act.

### **5. Request for Examination**

#### **5.1 General**

(1) The request for examination shall be filed only for an application which is pending in KIPO. Therefore, the examination request is not allowed if the application is invalidated, withdrawn, or abandoned. The request shall be made only one time for one application. Once the request is admitted, it cannot be withdrawn. Also, the valid request for examination shall continue even in case of losses in legal capacity or competency due to death of an applicant.

In the meanwhile, in the case where examination request is filed by a patent applicant, the request is allowed only when a description with the scope of claims is attached to the written application, according to the Article 59(2).

(2) Any person may request an examination of the patent application even including the 3rd parties without interests in the application, provided however that the incompetents including minors shall appoint legal representatives for a request procedure.

An association or a foundation which is not a juridical person but for which a representative or an administrator has been designated may file a request for an examination of a patent application.

(3) A request for examination shall be filed within five years (3 years for an application of a utility model registration) from the filing date of the application.

For a divisional application or a converted application, a person may request an examination within

thirty days from the filing date of the divisional application or the converted application, even after the expiry of the aforementioned 5-year period.

(Note) The request for examination of an international patent application shall be made within 5 years from the international filing date, not from the submission date of its translation to Korea pursuant to the Article 11 (3) of the PCT and the Article 199 of the Patent Act (Case No. 95 Nuh 3336 (Supreme Court, 16. June. 1998)).

(4) Where a request for examination has not been made within the prescribed period, the patent application concerned is deemed to have been withdrawn.

## **5.2 Procedure**

(1) A person filing the request for examination shall submit a written request (Form (xxii) in the Enforcement Rules of the Patent Act) to the Commissioner of KIPO and pay the examination fee (the Patent Act Article 60 (1)).

(Note) Where the number of claims increases because of amendments to the specification after the request for examination made by a person other than the applicant, the applicant shall pay the fee for the request for examination corresponding to the increased number of claims. Where the examination fees for the increased claims are not paid, the applicant is asked for the amendment. If the applicant fails to make additional payment as requested, the amendment procedure in the pertinent specification can be invalidated.

## **5.3 Effects**

(1) The application whose examination is on the request shall be examined by an examiner. The application can be terminated only by either patent registration or rejection unless it is invalidated, withdrawn, or abandoned.

(2) When the request for examination is made before the laying open of the application, the purpose of the request for examination shall be published in the patent gazette upon the publication of an application (or immediately if the request for examination is made after the laying open of application).

(3) For an application omitting the scope of claims in the specification, an applicant shall amend the specification to include the scope of claims till the date prescribed in the Article 42(5) subparagraph (ii) of the Patent Act, in response to the notification of the request for examination by the 3rd party.

(4) Where the request for an examination has been filed by a person other than the applicant, the Commissioner of KIPO shall notify the patent applicant accordingly (Patent Act Article 60(3)). Where an examiner makes a final decision (withdrawal, abandonment included) regarding the application whose examination is requested by a person other than the applicant, he/she shall notify the decision to the 3rd party accordingly. (Instruction Article 26 (4))

## **6. Start of Examination**

### **6.1 Examination Order**

An examiner shall verify whether the application received in order is appropriately allocated to him/herself in terms of the IPC, the validity of his/her function in examination, etc. To prevent an examination delay, the verification procedure shall be concluded as quickly as possible.

(1) The examiner shall review whether the technical subject-matter of the claimed invention is classified appropriately pursuant to the IPC and whether the application is within the scope of his/her IPC scope in charge. If the examiner finds the classification inappropriate, he/she shall determine the appropriate IPC pursuant to the Part V Chapter 1 Section 3 of the Guidelines and allocate the application to an examiner in charge of the re-classification after consultation.

(2) The examiner shall review whether he/she may fall under the exclusion reasons stated in subparagraphs (i)-(v), or (vii) in the Article 148 of the Patent Act, or whether he/she shall be excluded from exercising his/her functions in examination because he/she with less than 2 year experience as an examiner had serviced at the organization filing application for the last 3 years right before his/her appointment as an examiner. If an examiner has reasons to be excluded, the application shall be transferred to another examiner who is in charge of the most similar technical classification with the approval of director of the Examination Bureau.

(3) The examination starts in the order of the request for examination by the category of an examiner or classification of technical subject-matter (subclass). The start of the examination in this context refers to notice for the first time under the name of either himself/herself or the Commissioner of KIPO during the examination such as notification of grounds for rejection, amendment request, request for consultation, or delivery of a certified copy of decision to grant a patent.

(4) If the date of examination request is identical by the category of an examiner or classification of technical subject-matter, an application for a patent shall have a priority to an application for a utility model registration. If applications are in the same kind, the application with earlier filing date has priority over later application in terms of examination.

(5) A divisional or a converted application shall be examined in the order of their examination request. However, their examination starts to the order of the request for the examination of their parent application when they file after the examination request of their parent application.

In case when the parent application is divided or converted after the examination started, the examination shall start before the later date of either 3 months from the examination request for the divisional or converted application or 2 months from the receipt of application documents. Yet, in the case of a parent application on request for an accelerated examination, its divisional or converted application does not follow the aforementioned order but the order of the parent application.

## **6.2 Examination to be deferred**

(1) An examiner may defer the examination of applications under following cases;

① Where an earlier application or a competitive application (an application claiming identical inventions filed on the same date) is not laid open or a competitive application is not on the examination request.

② Where an earlier application on the domestic priority claim is prior to the withdrawal period pursuant to Article 56.

③ Where a trial or a litigation related to the relevant application is still on pending.

④ Where a search is outsourced to a specialized organization, an advice of outside specialists is requested or an examination with consultation is required.

⑤ Where the period for submitting evidential documents for priority claims under the treaty does not elapse.

⑥ Where there arises needs for an examination to be deferred

(2) When an examiner decides to defer the examination, he/she shall communicate it to the head of the examination unit and the period of deferral is less than 2 months. When the examiner considers the examination to be deferred again because the application whose examination had been deferred does not overcome the previous deferral reason or new deferral reasons occur, it shall be reported to the head of the examination division (team) following a head of the examination unit. The aforementioned reasons of (1) ④, ⑥ apply only when an examiner cannot take any responsibility for the deferral due to such reasons (ex, delivery of delay of prior art search report). The examiner can defer the examination again within 2 months.

(3) The examiner shall check whether the deferral reasons are overcome for the application whose examination had been deferred more than once a month. When the deferral reason is overcome, the examiner shall begin the examination until the deferral period is terminated.

(4) When there are two or more patent applications claiming an identical invention, the examination for the later applications shall be deferred till the application with earlier filing date, referred to as the earlier application is processed, laid open, or its publication or registration of a patent is made in Patent Gazette. However, if the both applications can be rejected by the same reason, the examination may begin without being deferred (Article 40 of the Enforcement Rules of the Patent Act).

Applicant	Earlier Application	Examination of Later Application
Identical	Laid off	Notify grounds for rejection pursuant to the Article 36 (1) after examination (Decide grant or rejection of a patent after confirming the scope of a claim of the earlier application)
	Not Laid off	Notify grounds for rejection pursuant to the Article 36 (1) after examination (Identify the application number of the earlier application and the claimed invention stated in the scope of claims, and decide a grant or rejection of a patent after confirming the scope of a claim of the earlier application)
Different	Laid off	Notify grounds for rejection pursuant to the Article 29 (3),(4) after examination (Apply the Article 36 (1) for identical inventor)
	Not Laid off	Defer examination till the earlier application is laid off

(5) Only if the earlier application is processed, laid open, registered in patent gazette after the examination deferral of the later application, the later application is allowed to begin the examination process. Notwithstanding the aforementioned, however, the final decision for the later application shall be made after confirming the scope of a claim in the earlier application pursuant to the Article 36 (1) of the Patent Act.

## 7. Processing Deadline

(1) For the application on the request of reexamination after its rejection and the application cancelled and returned from the appeal against the decision to reject, an examiner in charge shall begin the reexamination within one month from the receipt of the application documents. Yet, if the reexamination cannot start within the prescribed one month due to unavoidable reasons, the reasons

shall be reported to the head of examination bureau for applications cancelled and returned, or the head of examination division/team for applications either on request for reexamination or on reconsideration by examiner before trial.

(2) With respect to an application on request of the accelerated examination, the examiner shall determine as to whether the application falls under the category of the accelerated examination within 7 days from the receipt date of the request (Instruction Article 59). In the meanwhile, the examination shall begin within 2 months from the delivery of the notice of the aforementioned examiner's decision. The interim documents shall be processed within 2 months from the later date than date of document submission or that of the receipt of the relevant documents of the application.

(3) Reference to other processing deadlines is as follows:

(Abbreviation: Month/M, Week/W, Day/D)

Type		Initial Date	Time	Reference	Others
<b>IPC Classification</b>	Definitive Classification	Receipt Date of Application Preclassification	1 M	Instruction Article 10(2)(i)	Regular
			2 Ws	Instruction Article 10(2)(ii)	Priority
			2 Ds	Instruction Article 10(2)(iii)	High-Speed Application
<b>Regular Examination</b>	Examination Start	Examination Request Date	Request Order	Enforcement Rule Article 38 Instruction Article 20	
	Interim Documents	Expiration Date of Designated Period/ Receipt Date of Interim Documents	4 Ms	None	Late Expiration Date
<b>Accelerated Examination</b>	Decision for Accelerated Application	Receipt Date of Notice of Accelerated Application Request	7 Ds	Instruction Article 59(1)	
		Expiration Date of Amendment Period/ Receipt Date of Amendment Documents	7Ds	Instruction Article 59(3)	Late Expiration Date
	Prior Art Search Request	Delivery Date of Patent Decision Notice	15Ds	Instruction Article 86(1)	
	Examination Start	Delivery Date of Patent Decision Notice	2Ms	Instruction Article 66(1)	Late Expiration Date
		Receipt Date of Prior Art Search Outcome	1M		
		Receipt Date of Written Amendment	1M		
Interim Documents	Expiration Date of Designated Period/ Receipt Date of Interim Documents	2Ms	Instruction Article 66(2)	Late Expiration Date	
<b>Super Accelerated</b>	Decision for High-speed	Receipt Date of Notice of	2Ds	Instruction	

<b>Examination</b>	Examination	Accelerated Request		Article 59(4)	
		Expiration Date of Amendment Period/ Receipt Date of Amendment Documents	2Ds	Instruction Article 59(4)	Late Expiration Date
	Examination Start	Delivery Date of Notice of Accelerated Examination Decision	14Ds	Instruction Article 66(5)	
	Interim Documents	Expiration Date of Amendment Period/ Receipt Date of Amendment Documents	1M	Instruction Article 66(6)	Late Expiration Date
<b>Examination Deferred</b>	Examination Start	Examination Deferral Date/ Application Receipt Date	3Ms	Instruction Article 21bis	Late Expiration Date
<b>Divisional/ Converted Application</b>	Examination Start	Examination Request Date	3Ms	Instruction Article 21(1)	Late Expiration Date
		Documents Receipt Date	2Ms		
<b>Request for Reexamination after Cancellation</b>	Examination Resume	Documents Receipt Date	1Ms	Instruction Article 55(1)	
<b>Extended Designation Period</b>	Decision for Approval	Receipt Date of Term Extension Request after Expiration	2Ws	Instruction Article 23bis	Approval of Automatic Extension after Expiration

## 8. General Principles for Law Application

(1) In the case where the revision of the Patent Act is made while the application is pending, transitional measures are introduced in order to prevent disadvantages. Therefore, the provisions of the law shall be applied as of the filing date.

(2) Since the divisional or converted applications and the applications filed by lawful right holders are accorded the same filing date as the parent (earlier) application, the provisions of laws are applied as of the parent (or earlier) filing date.

For example, if the divisional application is filed on July 1, 2009 based on a patent application having filed before June 30, 2009, the previous Patent Act before the revision on January 30, 2009 by Act No. 9381, which entered into force on July 1, 2009, shall be enforced to the divisional application.

(3) For an application claiming the priority under Treaty or the domestic priority, and an application claiming purport of not-prejudicial disclosures, the provisions of the law shall be applied as of the application filing date of the original application.

For example, when an applicant filed an application, claiming a priority in Korea after October 1, 2006 on a basis of the original application filed in Japan before September 30, 2006, the internationalism, which inventions publicly known or worked can be used as prior art (amended to be included in the Article 29 (1) (i) of the Patent Act by Act No. 7871 on March 3, 2006), can be applied to this application. The examiner may notify the applicant by the grounds that it is publicly worked in Japan before the filing date in Japan.

## **Chapter 2. Search for Prior Art**

### **1. Overview of Search for Prior Art**

The search for prior art is performed during the examination stage with the objective of discovering the relevant state of the art to assess the patentability of the invention such as novelty and inventive step. The search for prior art includes the search for earlier applications prescribed in the Article 36 and the Article 29 (3) of the same Act.

If considered necessary for examination, an examiner may outsource the search for prior art to the specialized organization pursuant to Article 58(1).

### **2. Procedure Prior To Search for Prior Art**

(1) Before searching for prior art, an examiner shall analyze technical subject-matters of the invention. The search for prior art should be made on the basis of the claimed invention, but the examiner shall pay due regard to the detailed description/drawings if necessary.

(2) When the application cites documents in the description, the examiner shall analyze documents to find out whether the documents provide the starting point of the claimed invention, show the current status of the technology, explain other solutions for the tasks intending to resolve in the claimed invention, or describe for better understanding of the claimed invention. If considered necessary, the examiner shall refer the documents to take a starting point for search.

If the cited documents are not directly related to the claimed invention and it becomes obvious that they are just stated in the description, the examiner shall disregard those documents. When the examiner finds it that the documents are necessary to assess the patentability but are unable to acquire via a common method, he or she shall request the submission of the documents from the applicant and defer the examination till the submission.

(3) If foreign patent offices or search organizations already conducted search regarding the application of the claimed invention, the examiner shall review the search outcome to determine as to whether they can be used as relevant prior art.

### **3. Search Procedure**

#### **3.1 Search Scope**

(1) The search is carried out in collections of documents or database, the contents of which are systematically accessible. There are primarily patent documents of various countries, supplemented by other various kinds of publications such as technical journals, periodicals, books, any written materials as well as microfiche, CD-ROM and DVD-ROM

(2) The search is carried out in collections of documents or database which many contain materials in all those technical fields pertinent to the invention. The search strategy should determine the sections of the documentation to be consulted covering all directly relevant technical fields, and may then have to be extended to sections of the documentation covering analogous fields, but the need for this must be judged by the examiner in each individual case, taking into account the outcome of the search in the sections of the documentation initially consulted.

#### **3.2 Conditions under which Search is not Required or is Limited**

No special search effort needs to be made for searching or search may be carried out within the necessary scope if the claimed invention falls under any of the following cases. The examiner shall



notify the applicant of the fact that the application concerned does not comply with the provision of Patent Act to such an extent that a meaningful search is impossible for some or all of the claims.

- ① Where amendment made beyond the scope under the Patent Act Article 47
- ② Where the claimed invention is not patentable under the Article 32
- ③ Where the claimed invention is incomplete or not industrially applicable under Article 29
- ④ Where the claims of the application do not relate to one invention only, nor to a group of inventions linked so as to form a single general inventive concept under the Article 45

In such case, the examiner may first notify the grounds for rejection based on the lack of unity of invention and wait for the applicant's response.

- ⑤ Where the examiner is unable to interpret the claims due their lack of clarity and conciseness

However, if the examiner can understand the invention despite any deficiencies in the statement, the examiner shall proceed with the search and assessment of patentability within the scope of the defined invention.

### 3.3 Time Coverage of Search

(1) In conducting a search, the examiner should search documents published before the filing date of the application (or, for an application with a priority claim, documents published before the date of priority).

However, in exceptional cases the search can be extended to documents published after the filing date. This exception applies if documents are searched and used for the purpose of applying Article 29(3) and (4) or Article 36 of the *Patent Act*. In addition, where the validity of a priority claim under treaty or a domestic priority claim cannot be verified in the search stage, the basic reference date for the search is deemed to be the filing date of the application.

(2) A search does not normally take into consideration documents published after the filing date of the application. However some extension is necessary for specific purposes. For example, a later document describes the underlying principle or theory of the invention, which could give the examiner a better understanding of the invention, or a later document may also confirm the incorrectness or incompleteness of the of the underlying rationale or facts of the invention.

(3) For an application with a priority claim under treaty or a domestic priority, the basic reference date for the search on each claim is the filing date of the application. However, if there any documents published between the earliest prior date and the filing date of the application, the examiner should first identify the relevant date of each claim between the prior date and the filing date and then decide which documents to cite.

However, when there is no trouble to decide the reference date in each claim, the examiner may decide the priority date in each claim and then conduct the search for prior art by each claim.

### 3.4 Suspension of Search

(1) The examiner may suspend the search when he/she discovers prior art clearly demonstrating lack of novelty or inventive step in the entire subject matter of the claimed invention.

(2) In case of a particular application, it can take a substantial amount of time and energy in completing the search. Therefore, the examiner shall devise the most effective method to conduct the

most thorough search for prior art within available time and cost. In this case, even if the examiner with the rational judgment fails to discover effective prior arts for search, he/she may suspend the search.

### **3.5 General Principle of Search**

(1) The search will take into consideration prior art incorporating technical features which are equivalents to the technical features of the claimed invention, in light of the detailed description of the invention. However, such equivalent elements are not considered only limited to the scope of technical features explicitly described in the detailed description.

(Ex) The present invention relates to a device characterized by structure and function of plural parts. In case where claim describes the parts are put together by welding, it is interpreted to include other types of combining elements such as gluing, riveting and etc. other than welding unless it is clearly stated that the technical feature of the invention only has to do with the means of welding.

(2) The search carried out in sections of the documentation to be consulted for the independent claim(s) must include all dependent claims within the identical classification. Dependent claims should be interpreted as being restricted by all features of the claim(s) upon which they depend. Therefore, when the patentability of the subject-matter of the independent claim is not questioned as a result of the search, there is no need to make a further search or cite documents in respect of the subject-matter of the dependent claims as such.

(Ex) For an invention comprising pharmacological composition in curing for nail disease and disorder, where prior art of independent claims describing combining method of main components for the claimed invention does not exist, there is no need to make a further search in respect of dependent claims using volatile organic solvent as a composition carrier.

(3) When the application contains claims of different categories, all these must be included in the search. However, if a product claim clearly seems to be both new and non-obvious, the examiner should make no special effort to search claims for a process which inevitably results in the manufacture of that product or for use of the product.

When the application contains only claims of one category, it may be desirable to include other categories in the search.

(Ex1) An examiner can assess novelty and inventive step with regard to final products by carrying out the search, even though invention relates to a method of chemical process.

(Ex2) In case of the process invention for manufacturing article or in case of determining whether the producing process can be easily solved after the prior art search is conducted on the claimed invention.

(4) The search for prior art shall be made on a basis of the claimed invention. Nevertheless, if no additional excessive efforts are required, the examiner may conduct the search for prior art on the based on the invention stated in the description but not included in the scope of the claim, with preparing for the amendment.

### **3.6 Citation of Prior Art Documents**

(1) The prior art pointed as the grounds for rejection shall be cited only if there are no doubts concerning the fact that it is publicly known or worked, or described in a publication.

(2) A certain situation occurs in which other documents ensure the accuracy of the contents underlying the prior art document.

(Ex) One document of the patent family is published before the filing date of the application, but is published in a non-Korean language, whereas a different member of the same patent family is published in a Korean language but after the filing date of the application. Such same patent family written in Korean can be cited as prior art. In this case, the examiner may notify of the fact that the family document in foreign language had been publicly known before the filing date and have such document attached to his notice for rejection.

(3) The examiner can cite the abstract as prior art document for denying novelty and inventive step of the present invention. However, it is noted that the examiner shall notify of the grounds for rejection on basis of the contents disclosed in the abstract, but not on the ground of the whole statement of the application other than the abstract, since the abstract filed does not belong to the application.

(Note) In case of using the abstract as cited documents, an examiner needs to find out matters on whether inventive step can be assessed just by citing the invention disclosed in the full texts. As you can see previously, the main points between the abstract and the full texts are different and there is no ground that the full texts and the abstract are identical just because of the full text easily being obtained. When it comes to notifying the grounds for rejection in the process of the examination and trial, an examiner is required to notify of the reasons by specifically comparing the prior art based on the contents of documents with the full texts where documents with the full texts can be obtained. As this case shows, where an examiner failed to obtain the documents with the full text and had to use the abstract for determining inventive step due to failing of obtaining documents with the full text, the examiner should notify on the grounds of the contents disclosed in the abstract (Patent court decision 2001. 7. 19. 2000 huh 6288).

(4) The notice for rejection must be accompanied by copies of all documents cited, except the documents which include bulky contents. In such case, the examiner can just copy the pages directly related to the ground for rejection. However, in certain circumstances the applicant has easily access to the Internet, such as when the applicant has appointed an agent to undertake a patent-related procedure before the office or when the applicant has filed his application in the electronic form, the examiner may state the Internet address (URL) where the applicant can find the cited documents and the publication number on the notice for rejection instead of sending copies of the documents, particularly in citing the patent documents.

Also, the examiner may just indicate the channel to find the cited document in certain circumstances he finds it difficult to attach the copies of the documents, especially non-patent literature to his notice for rejection due to paid access, prohibited copy, ban of transfer of documents and etc.

(5) When the examiner discovers prior art which is not yet laid open but considered to be used as a status of 'another application' under the Article 29 (3) of the Patent Act, he/she shall defer the examination till the publication of such prior art. The examiner may cite the prior art (another application) as grounds for rejection only after its publication.

### 3.6 Others

Reference can be made to search reports regarding international applications under PCT or patent applications in European Patent System. The related prior art in search reports can be classified as follows depending on its relevance.

① 「X」 : In case denying novelty and inventive step can be determined by reference to just one relevant document

② 「Y」 : In case of denying inventive step when the present document is combined with one or other documents

③ 「A」 : In case the document is related with the claimed invention despite failing to fall upon 「X」 or 「Y」

- ④ 「O」 : documents mentioned about use, exhibition or oral disclosure
- ⑤ 「P」: Patent documents before the filing date of international application after the prior date.
- ⑥ 「E」: Patent documents disclosed before the date of international application and documents disclosed after the date of international application
- ⑦ 「T」 : Cited documents in order to understand principle and theory of invention or disclosed later than the prior date or the date of international application
- ⑧ 「L」 : Documents disclosed to negate the contents of claimed applications or raise the questions of priority claims or to determine other contents

#### 4. Measures after Searching

(1) The examiner completes an examination report(ER) right before making a final decision to grant or reject a patent application. When identifying the documents cited in the ER, the examiner should indicate the relevance of each document in the citation sheet with an X or Y annotation.

(2) The「Examination Report」may contain keywords and search history used in search for prior art. For the search history, the examiner may include title of search DB, search formula, and number of matches.

(3) The examiner may add to the「Examination Report」the examination reference found in search for prior art.

#### 5. Search for Prior Art by Specialized Search Organization

KIPO may outsource some of its prior art searches under Article 58<sup>1</sup> of the Patent Act. It is designed to mitigate the heavy burden of an examiner and to shorten the examination processing period, which would eventually improve the examination quality and protect applicants' interest.

##### 5.1 Search Request

(1) According to the monthly schedule, the examiner selects the application for the service by external organization. The head of the Examination Bureau confirms the selection made by the examiner and requests the specialized search organization for search service.

(Note) A head of the Patent Examination Support Division plans and notify the annual search request schedule for each Examination Bureau. A head of each Examination Bureau then allocates the search request schedule in terms of monthly and an examination team.

(2) A head of the Information Management Division provides applications selected for external search services to the specialized search organization.

##### 5.2 Delivery and Review of Prior Art Search Outcome

(1) The examiner conducts preliminary review before substantive examination and confirmation review after substantive examination.

The examiner review delivery method of search outcome, appropriateness of searched documents, accuracy of the relevancy between searched documents and the claimed invention, balanced composition among search documents, and other issues related to the prior art search service.

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<sup>1</sup> Article 58: If considered necessary for examination of a patent application (including an international search or international preliminary examination), the Commissioner of KIPO may designate a specialized organization and request it to search for prior art, make an international patent classification, and conduct other tasks prescribed by Presidential Decree.

(Note) The search outcome produced by the external organization shall be supplied with the format designated by KIPO. 「Search Report on Prior Art」compares the technical subject-matter of each claim with its cited documents and has the number of page and line of cited documents additionally. Also, the cited documents attached to the「Search Report on Prior Art」 shows the technical subject matter in pertinent method comparing with the technical subject-matter of each claim of the application.

(2) As a part of preliminary review, the examiner reviews the whole contents of 「Search Report on Prior Art」according to the list in 「Delivery Statement of Prior Art Search Outcome 」and states the review outcomes in 「Review Statement of Prior Art Search Outcome」. The examiner reports the review outcomes to a director of the relevant Examination Bureau following a head of the Examination Division (Team).

The director of the Examination Bureau also reports the review outcomes to both the General Services Division and the specialized search organization having conducted search service with the attachment of the 「Review Statement of Prior Art Search Outcome」 and notifies the current state of the reviews to the Patent Examination Support Division.

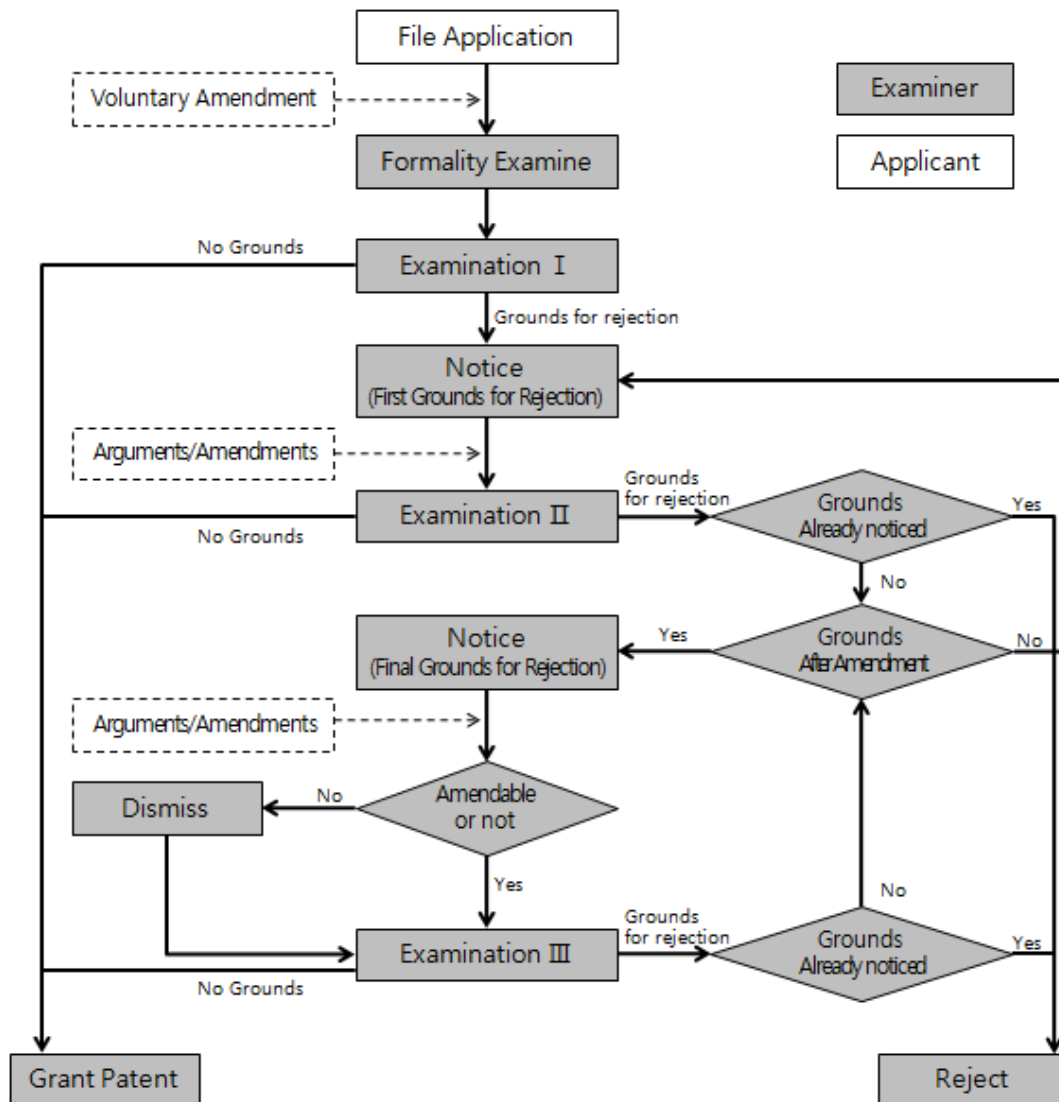
(3) As a part of confirmation review, the examiner, in the course of substantive examination, prepares analysis report illustrating the utility of the search outcomes (produced from the external search service) in accordance with its practical use on the Patent Examination Processing System.

(Note) The service contract for search for prior art contains the provision of reexamination obliged to the service organization in the case when the examiner evaluates the outcomes as unutilized.

# Chapter 3. Examination Process

## 1. Overview

When the application of a patent fails to satisfy the prescribed requirements in the Patent Act, the examiner shall notify the grounds for rejection to the applicant and provide him/her with an opportunity to submit a written statement of argument in response. When the submitted written statement of argument or amendment thereafter still fails to resolve the notified grounds for rejection, the examiner shall reject the patent application. The examination proceeds as shown in the following flowchart.



## 2. Understanding of Invention

(1) In the examination stage, the examiner shall clearly understand essential features of the invention by focusing on the method of problem solving different from the background and also considering the effects of the invention.

(2) The examination is directed to the invention as originally filed, but should take into account any changes from amendments by the applicant prior to the notice of the rejection grounds, if any.

Part V. 「6.3.1 Confirmation Method for Amended Specification」can be referred for the method confirming the amended specification.

(3) The examiner should refer to the claimed invention in the manner stated in a claim. The terms described in a claim should be interpreted within the general scope and meaning of the technical field, unless they have a specific meaning that is explicitly defined in the description.

### **3. Review of Prior Art Documents**

The examiner shall determine as to whether the prior art retrieved can provide grounds for rejection regarding novelty, inventive step, enlarged concept of novelty or earlier application.

(1) Since the publication date of the prior art document is critical to access patentability such as novelty or inventive step, the examiner shall review the bibliography to find out whether the publication date precedes the filing date (or the priority date if the priority claim is concerned).

With respect to the enlarged concept of novelty, the examiner shall check not only applicants but also inventors of the application of patent (or utility model registration application).

"Novelty" in Chapter II of Part 2 includes the detailed information about the publication date for prior art.

(2) The examiner shall have clear understanding about technical issues disclosed in the relevant prior art documents. It is of worth to note that the examiner shall be careful not to acknowledge matters, which are not disclosed in those documents with the knowledge having acquired from the application of the claimed invention. Also, the examiner shall be cautious not to presumably over-interpret claims without logical grounds.

### **4. Special Application**

(1) In case of application with priority claim or case of a non-prejudicial disclosure, divisional application or converted application, the examiner shall conduct the formalities examination concerning validity of priority claims or procedures prior to substantive examination.

As for the examination of formalities and method regarding procedures of claims and applications, Part IV Chapter 000 shall be referred.

(2) When the priority claim under Treaty, domestic priority claim, or claim for non-prejudicial disclosure are found to be not complied with physical requirements, the examiner shall request amendment to the applicant and may invalidate the procedure of the relevant claim if deficiency is not amended. For the divisional or converted application which does not meet requirement for applicants and period allowed for filing, the examiner shall provide the applicant with an opportunity to explain, and return the application documents to the applicant.

#### **4.1 Priority Claim under Treaty**

(1) A person who can claim the priority under the treaty is either an applicant having filed the application in the State party to the Treaty or his/her legitimate successor. In the case where applicants of between the original and the subsequent applications are not identical, the examiner may, if considered necessary, request for the submission of evidential documents proving his/her legitimacy as a successor.

As for the declaration by an illegitimate claimant of priority right, the examiner requests amendment to remedy the deficiency, and invalidates the relevant procedure later on if such deficiency is not cured.

(2) The claim of priority under the treaty shall be declared within twelve months from the first filing date of the first application on which the priority claim is based.

The declaration of the priority is made after expiration of the statutory period, the examiner shall request amendment for the deficiency, and invalidate the relevant procedure afterward if such deficiency is not cured. Since the procedural amendment in the priority claim intends to limit self-evident errors only, the examiner shall state such purport to the notice of the amendment request.

(3) If the application initially filed in the country, which forms a basis of the priority claim (hereinafter 'original application') is regarded as the first regular application, the priority right shall not be influenced by the status of the original application. Therefore, even applications invalidated, withdrawn, abandoned or rejected after filing of the original application can serve as a basis of claiming a right of priority.

The examiner shall not examine whether the original application in the country where the application was initially filed is on the process or not in the country.

(4) If the claimed invention prescribed in the priority claim under the treaty is identical with the invention in the original application in the country where the application is initially filed, the claimed invention application shall be treated as if it has been filed on the date of filing of the original application, in applying the provision prescribed in Article 29, 36 of the Patent Act.

The effects of priority claim in setting the reference date for the application concerned shall be determined on a claim-by-claim basis in principle and details are as follows.

① Where the invention of the original application in the country where the application is initially filed is identical (de facto identical invention is included; hereinafter, the 'identical' includes 'de facto identical' in this section) with the invention with the priority claim under the treaty, the reference date shall be the filing date of the original application in the country where the application is initially filed.

As for the application involving 2 or more priority claims (complex priority right), when the invention with the priority claim is stated in 2 or more original applications in the country where the application is initially filed, the earliest filing date of the original applications shall be the reference date.

② For the invention which is not filed in the country where initially filed, the filing date of priority claim shall be the reference date.

For the priority claim based on the 2 or more original applications in the country where the application is initially filed, when the invention of the priority claim is a combination of technical subject-matters separately stated in 2 or more original applications in the country where the application is initially filed, or when the invention of the priority claim is a combination of new technical subject-matter and those separately stated in 2 or more original applications in the country where the application is initially filed, the invention of the priority claim shall be treated as an「invention which is not stated in the original application in the country where the application is initially filed」.

③ When the original application in the country where the application is initially filed (the application that forms a basis of the priority claim under the treaty) claims the priority right based on



another application having filed beforehand, the original application shall not be regarded as the earliest application defined by the Article 4 C (2) of the Paris Convention for the Protection of Industrial Property, concerning the invention described in both the original application and the another application. In this regard, the effect of the priority claim shall not be recognized. Therefore, the examination in this case shall not be conducted retroactively to the reference date and the examiner shall notify specific reason for non-retroactive application.

When the examiner during the search for prior art discovers the prior art for the invention that is not possible to apply the reference date in requirements for patent registration retroactively to the period between the earliest date and the filing date of the priority claim, the examiner shall specify the reason for non-retroactive application in the notice of grounds for rejection.

(5) Evidential documents for the priority claim shall be submitted within one year and four months from the earliest filing date. Where the priority right claimant fails to submit the evidential documents within the prescribed statutory period, the priority claim loses its effect.

Where the examiner during his/her review of examination records, discovers that evidential documents for the priority are not submitted, he/she requests a procedural amendment to the priority claim and invalidates the procedure afterward if the procedural deficiency is not amended. It is worthy to note that the submission of the evidential documents after the statutory period cannot cure the procedural deficiency.

In the meanwhile, officers in charge shall be aware that the submission of a copy of description or drawing(s) of the invention in the original application can be exempt, if application is filed in countries that are equipped with the on-line system for exchange of evidential documents between administrative patent agencies and agree for on-line delivery of those evidential documents through an electronic access system (Direct-attached Storage, DAS) in Japan, European Patent Organization, US, and WIPO.

Also, officers in charge shall be aware that the application number in the priority claim application may substitute for the submission of documents stating the application number of the original application in the country where the application is initially filed in accordance with the Article 54 (4) (ii) of the Patent Act.

(6) If considered necessary, for example, there exists prior art during the period between the earliest date and the filing date of the application with the priority claim under the treaty, the examiner may set a time period and request the submission of translations of evidential documents for priority claim. In the case when the claimant fails to submit the translations in Korean within the prescribed period, the examiner may invalidate the priority claim procedure.

#### **4.2 Domestic Priority Claim**

(1) A person eligible to apply for domestic priority claim is an applicant of the earlier application. If the applicant of the earlier application and the applicant of the later application are not same, the examiner shall request amendments and invalidate the relevant priority claim procedure. The scope of amendment request is limited to correction of obvious errors.

Whether such determination on whether the both applicants of the earlier and the later applications are same or not is made upon the time when the relevant domestic priority claim has been filed. In other words, the decision is made upon when the applicant states the contents of priority claim or when the applicant makes amendments after the filing date.

(2) The domestic priority claim shall be made within one year from the filing date of the earlier application which forms a basis of the domestic priority claim.

Where the domestic priority claim is filed after the statutory period, the examiner requests amendments and invalidates the priority claim procedure if the deficiency is not cured. Since the scope of amendment request is limited to correction of obvious errors, the examiner shall state such purport to the notice of the amendment request.

(3) Divisional or converted applications shall not serve as a basis of domestic priority claim. Therefore, if the domestic priority claim is based on one of such applications, the examiner requests amendments and invalidates the priority claim procedure if the deficiency is not cured.

(4) Where the application has been invalidated, withdrawn, or abandoned or where the decision to grant a patent or utility model registration has been confirmed, the application hereof cannot serve as a basis of a claim of domestic priority.

If the earlier application falls under the aforementioned cases, the examiner requests amendments and invalidates the priority claim procedure if the deficiency is not cured.

(5) Where inventions claimed in an application containing a domestic priority claim and those stated in the specification or drawing(s) originally attached to an earlier application (hereinafter 'first specification of the earlier application') are identical, the application concerned shall be deemed to have been filed at the time when the earlier application was filed, in applying the provisions prescribed in Articles 29, 36, etc. The effects of priority claim in setting the reference date for the application concerned shall be determined on a claim-by-claim basis in principle and details are as follows.

① Where the invention in the first specification of the earlier application and the invention in the domestic priority claim are same (de facto identical invention is included; hereinafter 'identical' includes 'de facto identical'), the reference date shall be the filing date of the earlier application which forms a basis of the relevant priority claim.

For the invention involving 2 or more domestic priority claims (complex priority right), when the invention of the priority claim is stated in 2 or more first specification of earlier applications, the reference date shall be the earliest filing date of the earlier application.

② Where the claimed invention is not stated in the first specification of the earlier application, the filing date of the domestic priority claim shall be the reference date.

For the domestic priority claim based on 2 or more earlier applications, when the invention of the priority claim is a combination of technical subject-matter separately stated in 2 or more first specification of earlier applications, or when the invention of the priority claim is a combination of new technical subject-matter and those separately stated in 2 or more first specification of earlier applications, the invention of the priority claim shall be treated as an 「invention which is not stated in the first specification of earlier application」.

③ When the earlier application which forms a basis of the domestic priority claim, claims the priority right based on another application having filed beforehand, the effect of the priority claim shall not be recognized for the invention which is stated in both the first specification of the earlier application and another priority claim. Therefore, the examination in this case shall not be conducted to the reference date when the application was filed.

When the examiner during the search for prior art discovers the prior art for the invention that is not possible to apply the reference date for patent requirement to the period between the filing date of the earlier application and that of the application with the priority claim, the examiner shall specify the reason for non-retroactive application in the notice of grounds for rejection.

(6) Where the inventions stated in the first specification or drawing(s) attached to the application with domestic priority claim and those in the first specification of the earlier application are identical, the earlier application, which shall be deemed to have been withdrawn when one year and three months has lapsed for the filing date, is regarded to be laid open at the time when the application with the priority claim is laid open or published in the patent gazette in applying the provision of Article 29 (3).

(7) The earlier application that served as a basis of the domestic priority claim shall be regarded withdrawn when one year and three months has lapsed for the filing date.

When the examiner discovers that the application under his examination is based on the domestic priority claim, he/she shall defer further examination.

In the meanwhile, where the domestic priority claim is invalidated due to deficiency in formalities, the examiner shall resume his examination on the application suspended and considered withdrawn. In this case, another application in the Article 29 (3) of the Patent Act or the earlier application in the article 36 may arise as problems between the earlier application and the application with domestic priority claim.

(8) The decision to grant a patent on the domestic priority claim shall be deferred till the earlier application is considered withdrawn. When the examiner carries out the preferential examination on the application with the domestic priority claim, he/she shall notify the applicant that the decision to grant a patent shall be deferred till the earlier application is withdrawn.

#### **4.3 Non-prejudicial Disclosures**

(1) Where an application with the statement under the provision of Article 30(2) is filed, the examiner shall examine whether the application is filed within six months from the prescribed publication date stated in the application. If the application is filed after the due period, he/she requests amendments to the applicant and invalidates the claim if the deficiency is not cured. The untimely claim for non-prejudicial disclosure is considered not overcome.

(2) Where the non-prejudicial disclosure is claimed by the reason that the publication has been made by a person with a right to obtain a patent, the examiner shall conduct additional examinations regarding the followings; whether a person has a right to obtain a patent upon the public disclosure, whether the purport is stated in the application, and whether the evidential document of the public disclosure is submitted within thirty days from the filing date. If the examiner discovers deficiency, he requests amendments and invalidates the claim if deficiency is not cured within the prescribed period.

In particular, the examiner shall pay special attention in following cases; where the person who carries out the public disclosure and the applicant are not same, where the type and the date of public disclosure are stated incorrectly, where the evidential documents submitted are not sufficient to specify the invention in the public disclosure, or where the evidential documents are submitted without stating the purport for the claim for the non-prejudicial disclosure in the application (only when the evidential documents are submitted on the filing date).

(3) For a multiple number of public disclosures, the claimant shall state the purport individually by each public disclosure with the corresponding evidential documents. However, if public disclosures are closely connected each other, evidential documents for the subsequent public disclosures are not required to be submitted.

For example, when the exhibition displays an invention and sells it to the market separately, the exemption claim for public disclosure shall be made to both exhibition displays and market sales with evidential documents respectively. However, if the market sales are closely connected with the exhibition pursuant to the exhibition contract, the submission of the documents for market sales in this case can be exempt.

(Note) Under the First-to-File rule, the public disclosure requirement is exceptionally exempt, which is designed to protect a patent by recognizing novelty when a certain procedural requirements are satisfied and to further promote industrial development. Also, this protects the public confidence and guarantees the foreseeability.

(4) For a multiple number of claims for non-prejudicial disclosure, the legitimacy of the claim shall be judged by each claim.

(5) Where the claim for non-prejudicial disclosure is recognized as legitimate, novelty and inventive step are judged as if the concerned invention having publicly known deems not to be known publicly.

#### **4.4 Divisional or Converted Application**

(1) A person who can file a divisional or converted application is an applicant of its original application. Where applicants are not identical (all applicants shall be same if involving several applicants), an examiner shall provide an opportunity for petition and then return the concerned application back to an applicant. The scope of amendments of correcting applicants shall be limited to an obvious error.

The decision as to whether or not applicants of an original application and a divisional or converted application are same shall be made as of the time when a divisional or converted application is submitted. It is regarded as legitimate application in case where the name of an applicant of original application changes on the filing date of divisional or converted application.

(2) A divisional application shall be filed only during the period designated for the amendment of specification or drawing(s) or during the period designated for an appeal against the decision to reject a patent. Conversion of the application shall be made within thirty days from the date that an applicant initially receives a certified copy of decision to reject a patent (or an extended period, if an extension request has been approved).

In the meanwhile, a divisional application shall not be filed after request for an appeal against the decision of rejection is filed. However, if the concerned trial is withdrawn and the period for appeal against decision of rejection does not expire, an applicant may file a divisional application within the designated period.

Where a divisional or converted application is filed after the statutory period expiry, an examiner shall provide an opportunity for petition to an applicant and then return the application back to an applicant pursuant to the Article 11 of the Enforcement Rules of the Patent Act.

(3) Where an application has been invalidated, withdrawn, abandoned, or confirmed for decision of rejection, division or conversion shall not be made based on the application. Also, a converted application cannot be filed after a registration of the establishment of the patent right is made for the original application.

Where an original application falls under the abovementioned case, an examiner shall provide an opportunity for petition and then return the application to an applicant.

Where an original application procedure closes after a divisional or converted application has been filed legitimately, an examiner regards the application as valid and begins examination.

(4) Matters described in the specification or drawings of the divisional applications shall be within the scope of matters described in the specification or drawings of the original applications as of the filing. Where division or conversion is made out of such scope, the application is treated as follows depending on the filing date of an original application.

① Where an original application had been filed before September 30th, 2006, an examiner shall deliver a warning notice for inadmissible division (conversion) to an applicant. Where a written statement of argument submitted by an applicant still fails to cure this scope violation, he/she shall deliver a notice for inadmissible division (conversion). After delivering the notice for inadmissible division (conversion), an examiner conducts an examination as of a filing date of divisional (converted) application, not retroactively.

Where an application contains both a reason for inadmissible division (conversion) and a ground for rejection, an examiner shall in principle confirm the admissibility of conversion (division) before notifying the ground for rejection. However, where the ground for rejection is nothing to do with a retroactive filing date (admissibility of conversion or division), an examiner may deliver a warning notice of inadmissible division (conversion) and a notice of grounds for rejection simultaneously.

Where a notice of inadmissible division (conversion) is delivered, an examination shall be conducted as of the filing date of divisional (converted) application. However, if a violation of division (conversion) scope is legitimately cured during an examination stage, an examination shall be conducted retroactively on an original filing date.

② Where an original application had been filed after October 1st, 2006, an examiner shall deliver a written notice of the ground for rejection by reason of scope (division or conversion) violation. Where an argument statement or amendments fail to cure a scope violation, an examiner shall make a decision to grant a patent.

Under this circumstance, where an application contains other rejection reasons along with the scope violation, an examiner includes these grounds for rejection into the same written notice of the ground for rejection aforementioned.

(5) Where a divisional application is made legally and a claimed invention of the divisional application is identical to a claimed invention of the original application after the division, the applications shall be subject to the provision of Article 36 (2). In such case, amendments of the original application are required and it shall be made at the time of filing date of the divisional application (the Enforcement Rules of the Patent Act Article 29 (3)).

(6) Where an original application (hereinafter referred to as "Application A") is divided into a divisional application (hereinafter referred to as "Application B") and the Application B is divided into another divisional application (hereinafter referred to as "Application C"), the Application C is regarded legal and is deemed to have been filed at the time of filing of the Application A, provided that the Application B meets all the requirements for division as to the Application A, and that the Application C meets all the requirements for division as to the Application B.

A converted application shall be treated in the aforementioned manner.

#### **4.5 Application by a Person Entitled to the Grant of a Patent**

(1) In order for an application to be recognized as an application by a person entitled to the grant of Korean patent (hereafter referred to as "a lawful holder"), the following requirements shall be met; ① an application by the unentitled person had been filed earlier than by the lawful holder of a right, ② an application by the unentitled person is either rejected for a patent grant or invalidated in a trial due to illegitimacy of an applicant (an application is filed by the entitled person), ③ an application by the lawful holder is filed within thirty days from the date of rejection or invalidation confirmation (invalidation confirmation adds another requirement of 'within two years from the date for publication of registration' in the case of a patent application by the unentitled person), and ④ a scope of a claimed invention in an application by the lawful holder of a right falls within the invention scope in an application by the unentitled person.

Where an application by the lawful holder is filed with the Form (xiv) in the Enforcement Rules of the Patent Act (including an application where an applicant argues his/her legitimacy as the lawful holder in the written statement of argument during an examination stage), an examiner shall study the legitimacy of an application before any other grounds for rejection. If an examiner doubts an applicant's legitimacy regarding the abovementioned requirements of ①, ③ and ④, he/she shall deliver a notice stating that a filing date shall not be retroactive.

Where the requirement of ② aforementioned is not satisfied, except for special cases, an examination shall be deferred. The examination shall be resumed promptly after a decision to patentability or a invalidation trial is confirmed.

(2) Where an application is recognized as a legitimate application by the lawful holder of right pursuant to Article 34, 35 of the Patent Act, it is deemed to have been filed at the date when an application by the unentitled person had filed. In other words, with regard to an application by the lawful holder, judgment of patent requirements, period calculation, or related provisions of the rules and regulations shall be determined as of the date that the unentitled person files an application.

For example, where an application by a third person is filed during the period between the filing date of an application by the unentitled person and the filing date of an application by the lawful holder, an application by the lawful holder shall not be rejected due to a third party's application. As aforementioned, the filing date of an application by the lawful holder is retroactive to the filing date of an application by the unentitled person, which comes earlier than the third party's application. In this case, therefore, an application by the third party is rejected based on an application by the lawful holder.

(3) With regard to a request for examination for an application by the lawful holder after five years from the filing date of an application by the unentitled person, it is deemed valid as long as the application by the lawful holder and the request for an examination are filed simultaneously (or on the same date).

(4) The scope of invention in an application by the lawful holder of a right is limited to claimed inventions as well as those disclosed in the specification or drawings of the application by the unentitled person.

Where an application by the lawful holder includes inventions, which fall beyond the aforementioned scope (for example, an application by the lawful holder involves a multiple number of inventions, among which only some inventions fall within the scope of inventions in an application by the unentitled person), the filing date of an application by the lawful holder shall not be retroactive in the examination.

#### **4.6 International Patent Application**

(1) 「International Patent Application」is an international application where the filing date is established under the Patent Cooperation Treaty(PCT) and Korea is designated as a designated State for obtaining a patent.

Except for some exceptional clauses of the Act including enlarged earlier application, an international patent application is treated as an ordinary patent application filed on the international filing date. In this regard, the international filing date becomes the patent filing date, while the description, claims, and drawings having submitted at international application are considered as legitimate description and drawings pursuant to the Article 42 (2) of the Patent Act.

An international application filed in foreign languages is deemed to have been withdrawn if its Korean translation is not submitted according to the Article 201 of the Patent Act.



An examiner who is in charge of an international application shall pay attention to the following matters.

(2) Where an international application enters domestic stage with the Korean translation submitted, claiming a priority under the Patent Cooperation Treaty, this priority claim is treated as the priority claim under the Treaty. On the other hand, where an application which serves as a basis of the priority claim is either an application filed in Korea or an international application where Korea is the only designated State for obtaining a patent, the priority claim is considered as domestic priority claim, instead.

(3) Where an international application filed in foreign language becomes "another application" referred to in Article 29 (3), the application is considered to be laid open at the time of an international publication. However, the scope of inventions of another application is limited to the inventions described in the description, claims or drawings of both the international application as of the international filing date and its translation.

(4) Where an international application serves as a basis of domestic priority claim and therefore becomes "another application" referred to in Article 29 (3), the application is considered to be laid open at the time of an international publication. However, the scope of inventions of another application is limited to the inventions described in the description, claims or drawings of both the international application as of the international filing date and the application with domestic priority claim.

(5) In case of an international application, a person intending to apply Article 30 (1) to the invention claimed in an international application may submit a written statement stating the purport of non-prejudicial disclosure of the invention and an evidential documents within 30 days from the reference date (the period designated for documents submission in Korea, or the examination request date if such a request is filed within the designated period), even though such purport has not been stated in a written international application.

(6) In the case where an international application with domestic priority claim is filed in a foreign language, the scope of inventions of the earlier application, when it is laid open or registered in patent gazette, is limited to the description, claims, or drawings having been submitted at the international filing date as well as the matters stated in both an international application and its translation.

(7) Where an earlier application, which serves as domestic priority claim, is an international application, inventions commonly stated in both an application with the domestic priority claim and the earlier application (which is limited to the description, claims, or drawings having been submitted at the international filing date) are considered to have been filed at the international filing date of the earlier application.

(8) Where Korean translation of the written amendment regarding the description or claims pursuant to the Article 19 or 34 of the Patent Cooperation Treaty is submitted within the reference date, an examiner proceeds the examination procedure with considering an international application to have been self-amended according to the Article 47 of the Patent Act.

(9) The scope of amendments to the specification of an international application filed in a foreign language is limited to the description, claims, or drawings (limited to explanatory parts in drawings) of its translation, or drawings (except the explanatory parts in drawings) of the international application as of the international filing.

(10) An examiner may request an applicant of an international application to submit copies of documents cited in the International Search Report or International Preliminary Examination Report. If considered necessary for an examination, an examiner under the name of the Commissioner of

KIPO may request the submission within the designated period.

## 5. Notice of Grounds for Rejection

(1) The Patent Act (Article 62) stipulates that the examiner, before the decision to reject an application, should notify an applicant of the grounds for rejection and give him/her an opportunity to submit a written argument with specifying a designated period.

This provision is designed to prevent errors or mistakes by an examiner since he or she shall not be always expected to have the advanced knowledge requisite to a judgment to patentability in a claimed invention. And also it would be too harsh to reject a patent outright without giving an error correction opportunity under the First-to-File rule.

The grounds for rejection are as follows.

- ① Where a claimed invention is not patentable pursuant to Article 25 • 29 • 32 • 36 (1), (3) or 44
- ② Where no persons are entitled to obtain a patent according to the Article 33 (1), or where an a claimed invention is not patentable pursuant to the proviso of the same Article.
- ③ Where it violates the clause(s) of the Treaty
- ④ Where requirements in the Article 42 (3), (4), (8) or Article 45 are not satisfied.
- ⑤ Where an amendment is out of the scope prescribed in the Article 47(2)
- ⑥ Where a divisional application is filed out of the scope prescribed in the Article 52 (1)
- ⑦ Where a converted application is filed out of the scope prescribed in the Article 53 (1)

(2) The period designated for submission of the ground for rejection shall be within two months regardless of whether an applicant is non-resident or not. However, the designated period hereof may add an additional period required for tests or results evaluations, when a written statement of argument requires tests and their evaluation and their time consumption is acknowledged.

(Note) The period designated by the Commissioner of KIPO (for an amendment request in accordance with the Article 46 of the Patent Act) is within one month.

### 5.1 Instructions for Notice of Ground for Rejection

(1) Except for special cases, all the grounds for rejection having been discovered during an examination stage shall be notified collectively. Also, in order to protect a procedural interest of an applicant in his/her amendment and to expedite an examination process, an examiner shall notify grounds of rejection altogether which might be conflicting.

However, the followings are an exception for collective notice.

- ① Where contents of a claimed invention cannot be comprehended due to lack of clarity in the description, an examiner shall notify only the ground for rejection due to violations of the Article 42(3), (4) without conducting prior art search or accessing the patentability requirements regarding Novelty and Inventive step etc..



However, where lack of clarity in description is insignificant so that understanding of a claimed invention is possible, an examiner shall conduct prior art search and review requirements within his/her comprehension of a claimed invention. Then, an examiner shall notify the grounds for rejection found in a prior art search and requirements review and other rejection grounds in violation of the Article 42(3), (4) altogether.

② Where it is certain that a claim has a newly added matter, or where it is not certain whether there is a ground pursuant to the Article 32 of the Patent Act (invention that is liable to contravene public order, etc.), or where it is clear that a claim does not constitute an invention and is not industrially applicable, an examiner shall notify the aforementioned grounds for rejection without judgment on requirements for patentability such as novelty or inventive step.

③ Where an application fails to satisfy the requirement for a single patent application pursuant to the Article 45 of the Patent Act, an examiner shall conduct an examination on inventions which fall under the scope of a group and notify the grounds if discovered through the examination, along with the rejection ground regarding lack of unity.

However, where considered efficient proceeding of an examination, an examiner may notify the violation of the Article 45 before judging other requirements for patentability.

(2) Where an examiner notifies the ground for rejection, he/she shall stipulate the relevant provisions of the Act or laws. Also, for two or more claims included, the grounds for rejections should be indicated on a claim by claim basis. Details shall be referred to 「5.4 Examination Method by Each Claim」.

(3) The grounds for rejection shall be stated with definite, concise, normal sentences to help an applicant's better understanding. Particularly, the followings are important.

① For a prior art that is related to a judgment of inventive step, an examiner shall cite the minimum number of documents deemed necessary to build a rationale for rejection grounds. An examiner shall stipulate the part of the cited documents that are used for a basis of rejection.

② Where an examiner intends to deny novelty or inventive step by referring to the fact that the claimed invention is publicly known or worked before the filing of the patent application, he/she shall specifically state facts showing that it is publicly-known or worked.

③ Where an examiner renders a notice of the grounds for rejection due to deficiency in detailed description of a claimed invention, he/she shall specify the deficient parts and stipulate the corresponding reasons.

(4) If considered necessary for the convenience of an applicant (in his/her responding to the notice of grounds for rejection) as well as for expeditious and accurate examination, an examiner may suggest a division or conversion of an application in the notice of rejection grounds.

However, an examiner shall stipulate in the notice that his/her suggestion has no legal effects and a decision to carry out division or conversion shall be made by the intention of an applicant.

(5) Where the written notice of rejection grounds having been issued contains errors in writing, an examiner shall issue a correct notice of grounds for rejection again, regardless of whether an applicant submits a written statement of argument. However, exceptions are as follows.

① Where an applicant is deemed to submit a written statement of argument based on his/her correct understanding and interpretation of errors

② Where an applicant does not submit any arguments and the errors are just a simple misspelling or missed letter that are not influential for an examiner's decision of grounds for rejection.

(6) Where the description contains a self-evident error in writing, an examiner shall notify the error as 「Considerations」 if there is other grounds for rejection, If there is no other grounds for rejection, an examiner shall communicate this with an applicant by telephone (or others) and may advise an applicant to self-amend or amend *ex officio* (refer to 「Chapter 5. Amendment *Ex Officio*」).

The advice or guidance aforementioned by communication media shall be documented in 'Applicant/Attorney Personal Interview' in 「Examination Report」.

## 5.2 Rejection without Additional Notice of Grounds for Rejection

Where an examiner finds that the grounds for rejection which have been notified still exist to the notice of grounds for rejection with taking any amendments into consideration, he/she should make a decision of rejection without an additional notice regardless of other rejection grounds.

Here, 「the ground for rejection have been notified」 refers to a case where the concerned ground for rejection in rejection decision primarily coincides with the previously-notified rejection grounds. Decision of whether to primarily coincide with or not shall not be confined to an expression or a sentence. It shall be evaluated in perspective of whether or not an applicant is practically given an opportunity to submit his/her opinions.

The followings are examples where primary coincidence is not admitted and therefore the notice of grounds for rejection is issued again.

(1) Where different provisions of the Act and Rules are applied to the same claim, an examiner shall issue the notice of the ground for rejection again.

For example, grounds for rejection such as absence of novelty or inventive step, claims with no supporting detailed description, and deficiency in claims and detailed description are not deemed to be primarily coincident with each other. They shall be treated as separate, individual ground for rejection.

However, where despite the fact that different provisions of the Act and Rules are applied, the claimed invention becomes identical (including de facto identical. Hereinafter the same shall apply) with the invention in the claim where the ground for rejection had been already notified, the grounds for rejection between these claims are regarded as primarily coincident. An examiner shall render a decision of rejection based on this ground and shall stipulate this ground in a written decision to reject.

(2) Where an examiner discovers a different type or number of cited inventions denying novelty or inventive step, except for special cases, it is deemed a new ground for rejection. An examiner, therefore, notifies the ground for rejection again. The same will apply to a case where type or number of cited inventions changes due to new combinations with other cited inventions in other claims.

For example, an examiner had denied inventive step by referring to cited invention 1 to claim 1, cited invention 1 and 2 to claim 2, and cited invention 1 and 3 to claim 3. Again an examiner, to deny inventive step in claim 3 to which technical subject matters of claim 1, 2 and 3 are combined through amendments, refers to cited invention 1, 2 and 3. This is not admitted as primarily coincidence case.

(3) Where the ground for rejection lies in a claim newly-established by amendments, an examiner,

instead of issuing a rejection decision, shall deliver the notice of grounds for rejection and provide an opportunity for an applicant to submit an opinion. Where an applicant states a new invention in the claim number that had been deleted through amendments, an examiner shall treat this claim as newly established.

However, where the invention described in newly-established claim is identical with the invention in a claim to which the ground for rejection had been notified, an examiner may render a rejection decision by the rejection ground in the claim to which the rejection ground had been notified.

(4) Where an invention becomes identical with a claim in which the grounds for rejection have never been notified, except for special circumstances under which it becomes also identical with the invention in other claim in which notice of grounds for rejection is already notified, an examiner should render the notice of grounds for rejection again.

(Note) The judgment of whether or not amendments changes or expands the scope of invention in a claim (including de facto change or expansion) does not influence to determine the primary coincidence among grounds for rejection.

### **5.3 Types of Notice of Ground for Rejection**

Notice of grounds for rejection can be classified into two different types. Depending on the type of notice, an applicant shall comply with different restrictions in terms of scope of amendments in the specification or drawings.

One is a notice in which an examiner notifies only new rejection grounds incurring from the amendments according to the previously-issued notice of rejection grounds (hereinafter 'final notice of grounds for rejection') and the other is a notice which is received by an applicant first time or not a last time (hereinafter 'non-final notice of grounds for rejection').

#### **5.3.1 「Non-final Notice of Grounds for Rejection」**

(1) An examiner may issue 'non-final notice of grounds for rejection' regardless of self-amendments or not, if it is issued for the first time since the start of an examination.

(2) When identifying a ground for rejection in the amendment confirmation section which has not been amended yet (including an amendment confirmation number in the Form (ix) in the Enforcement Rules of the Patent Act. Hereinafter the same shall apply.), an examiner shall issue 'non-final notice of grounds for rejection'.

(3) Even when an examiner shall issue the non-final notice of grounds for rejection on the second time or more, if the grounds for rejection in this case are not necessitated by amendments made in response to the previous notice of grounds for rejections, 'non-final notice of grounds for rejection' shall be notified.

(Ex1) In below example, an examiner has issued the non-final notice of grounds for rejection and examines again the claim whose insignificant description deficiency (when referring to the detailed description, A' is deemed to be A) is amended. During this examination, an examiner discovers prior art for equipment comprised of Constituents A+C and decides to issue the notice of grounds for rejection. In this case, an examiner shall issue the non-final notice of grounds for rejection, as this is related to novelty or inventive step in inventions of claims before amendments.

### Before Amendment

### After Amendment

【Claim 1】 : Constituent A' or B with C attached      【Claim 1】 : Constituent A or B with C attached

(Ex2) Where having notifying the rejection ground to only a part of two or more inventions stated in a single claim, and then notifying the grounds for rejection to the remaining inventions afterwards, an examiner shall issue the non-final notice of grounds for rejection despite that the claim has been amended according to the notice.

(4) Where the grounds for rejection are established due to reasons other than amendments, an examiner shall issue the 'non-final notice of grounds for rejection'.

For example, when issuing the first notice of grounds for rejection, no defects had been found in terms of legal competency as a foreigner. However, after amendments, a foreigner loses the right to enjoy patent according to the Article 25 of the Patent Act, this ground for rejection is not generated according to amendments. Therefore, this is issued as the non-final notice of grounds for rejection.

### **5.3.2 「Final Notice of Grounds for Rejection」**

Where the ground for rejection incurs from amendments corresponding to the notice of the grounds for rejection having been noticed to an applicant, an examiner shall deliver the final notice of grounds for rejection. In other words, an examiner shall issue the final ground for rejections in case where a rejection ground which had not been exist or does not need to be examined prior to amendments, is caused newly or requires an examination after amendments.

Amendments according to the notice of ground for rejection having been issued previously are a prerequisite for the final notice of grounds for rejection. In other words, the final notice of grounds for rejection can be issued only when the written amendment has been submitted and a new rejection ground incurred in the amendment confirmation section.

Specific examples regarding the final notice of grounds for rejection are as follows.

(1) Where amendments of the description or drawings result in adding a new matter or exceeding the permissible scope of division or conversion.

(2) Where amendments of a claim that had been examined cause the ground for rejection regarding novelty or inventive step. However, where the invention of an amended claim has been stated in the other claim and the other claim has never been notified for this rejection ground, an examiner shall issue the non-final notice of rejection grounds.

(Ex1) In this below example, an applicant amends claim 1 corresponding to the notice of rejection ground (violation of novelty or inventive step) and remedies this ground. However where the addition of constituent D after amendment raises a need to cite a prior art including D, it is regarded as the rejection grounds incurring from amendments. The final notice of grounds for rejection is issued in this case.

If composition obscurity of inventions relating to constituents 'A and B' had been the ground for rejection, it would be the ground for reason having been existed before amendments of attachment D. Therefore, in this case, the final notice of grounds for rejection cannot be issued.

### Before Amendment

### After Amendment

【Claim 1】 : Constituent A and B with C attached    【Claim 1】 : Constituent A and B with D attached

(Ex2) Where a claim is expanded after amendments according to the notice of ground for rejection that is description deficiencies, and subsequently results in a violation of novelty or inventive step, an examiner is required to review prior art again by requesting amendments. In this case, an examiner shall issue the final notice of grounds for rejection despite the fact that both grounds for rejection (i.e. description deficiency and lack of novelty or inventive step, in the example above) are pertinent to the same claim.

(3) Where a newly generated claim or a substantially changed claim equivalent to newly-established claim contains grounds for rejection regarding novelty or inventive step. However, where the concerned claim is amended with an invention in another claim where notice of grounds for rejection has not been issued, an examiner shall issue the non-final notice of grounds for rejection.

(4) Where an examiner examines again after amendments and discovers grounds for rejection relating to novelty or inventive step in this amended claim which had not been examinable due to lack of clarity or addition of new matters to such claim.

#### **5.3.3 Selection of Notice of Grounds for Rejection (Final or Non-final)**

(1) Where an examiner discovers the ground for rejection after examining again, he/she shall issue the non-final notice of grounds for rejection unless all of the grounds for rejection fall under the final notice of grounds for rejection.

(2) Where uncertainty pertains to the selection between two types of notices of grounds for rejection, an examiner shall issue the non-final notice of grounds for rejection so that the applicant's opportunity of amendment may not be unreasonably limited.

#### **5.4 Examination on a Claim-by-claim Basis**

##### **5.4.1 Purpose**

An examiner examines an application filed for in compliance with the requirements of patentability. Even if only a single ground for rejection lies in an application, a patent shall not be granted based on that application. Therefore, where an examiner notifies grounds for rejection regarding an application comprised of two or more claims without full disclosure of specific reasons for each claim, an applicant, having difficulties in identifying which claim can be remediable, sometimes fails to acquire legitimate rights for claims that might have been patentable if identified.

Under the examination system by each claim, when notifying the ground for rejection regarding an application comprised of two or more claims, an examiner shall stipulate the concerned claim containing ground for rejection as well as the corresponding ground with more specific explanations. This enables an applicant to respond an examiner's notice without much difficulty by allowing an applicant to easily identify a claim to be deleted or amended.

##### **5.4.2 Instructions for Written Notice of Ground for Rejection**

A written notice of grounds for rejection shall include [Examination Outcomes], which is

comprised of 「Claims to be Examined」, 「Relevant Provision regarding Grounds for Rejection」, 「Patentable Claims」 and [Specific Grounds for Rejection] for matters notified as grounds for rejection. Also, matters, which are not grounds for rejection but still useful for applicant's response, can be included in 「Considerations in Amendment」. Specifics for each part are as follows:

(1) 「Claims to be Examined」 stipulates the number of claims to be examined as of the date when a written notice of the grounds for rejection is prepared.

(2) 「Relevant Provisions regarding Grounds for Rejection」 specifies claims containing the grounds for rejection and its relevant provisions of the Act. If the ground for rejection is not directly related to claims, the matters containing the ground for rejection are stated herein.

Where an amendment adds new matters or is not made within the prescribed scope of a divisional or converted application, the matters either newly added or fallen out of the scope of a converted or divisional application shall be stated as grounds for rejection.

※ Example

No	Matters Notified as Grounds for Rejection	Relevant Provision in the Patent Act
1	Detailed description of the invention	Article 42 (3) (deficiency in detailed description)
2	Claims 6 - 8	Article 42 (8) (manner of describing the scope of claims)
3	Claims 10 - 14	Article 45 (scope of a single patent application)
4	Claims 1, 4 and 6	Article 29 (2) (inventive step)
5	Detailed description, Claim 15	Article 52(1) (scope of divisional application)

(3) 「Patentable Claim」 enumerates all claims that are not identified as the ground for rejection upon its notice.

Exceptionally, even if a claim itself has not been identified as the ground for rejection, however, the claim which falls under the following cases may not be stated under 「Patentable Claim」; where a special circumstance makes it difficult to assess patentability regarding the concerned claim upon the notice of the ground for rejection, or where a claim is judged not to be patentable due to not the claim itself but other grounds related to such claim. In this case, the reason for not-stating patentable claims shall be explained in the 「Considerations in Amendment」. This is designed to help an applicant to respond to the notice of the ground for rejection without difficulties, where an examiner clearly discloses his/her opinion about the concerned claim.

It is noted that 「Patentable Claim」 is not an examiner's final decision. It is only a decision at the point when the notice for the ground for rejection is issued. Therefore, where a new ground for rejection is discovered afterwards, an examiner shall notify the ground for rejection again without binding to his or her previous decision. Also, even if an examiner states that a part or whole claims can be patentable, he/she may make a final decision to reject in the case where any of the grounds for rejection is not solved after an applicant's response.

(4) 「Specific Grounds for Rejection」 stipulates more specific reasons for matters notified as the ground for rejection, which enables an examiner to inform the ground for rejection without difficulties.

Where an examiner notifies the grounds for rejection an application involving two or more claims, he/she firstly indicates claims involving the grounds for rejection and states the specific grounds according to the claims. More specifics are as follows:

① An examiner shall specifically state to inform the grounds for rejection for each claim. To avoid redundant statement, an examiner may just indicate the aforementioned ground or collectively inform grounds regarding claims sharing practically the same ground for rejection.

② Where an examiner stipulates the grounds for rejection by comparing the cited invention with the claimed invention, he/she shall specifically indicate which parts of the cited invention is considered in the comparison with the claimed invention. Where a multiple number of cited inventions are compared to each other, an examiner shall select the closest cited invention among them, and describe technical features of the closest cited invention that corresponds to the claimed invention. Then, the examiner points the difference between the claimed invention and the closest cited invention, and states technical features of other cited inventions which supplement such difference, along with his or her assessment regarding patentability with taking the common general knowledge into consideration.

③ An examiner can directly specify a cited invention pertaining to the claimed invention, and may describe differences and his or her assessment regarding inventive step. In this regard, such specification of the cited invention shall be made in a manner that an applicant can easily understand the corresponding relations with the claimed invention.

④ Where identifying the grounds for rejection in terms of novelty or inventive step, the grounds for rejection for independent claims and those for dependent claims are separately stated. As for the grounds for rejection, an examiner may state as simply as to indicate corresponding matter of cited invention to features added or limited to the dependent claim, or indicate his or her assessment on the difference between the cited invention and the dependent claim based on common general knowledge.

Except for special cases, the grounds for rejection of dependent claims are deemed to include all the grounds identified in claims (including independent and dependent claims) which are cited by such dependent claims.

⑤ Where considered necessary for comparing the claims and the cited invention, a component comparison table disclosed below can be prepared to show the relations between distinguishing technical components of the claimed invention and its corresponding features of the cited invention. An examiner can add in the table where the corresponding features are written in the cited document. When using the comparison table, an examiner may add his/her judgment regarding differences between the claims and the cited inventions either within the table or below the table, which enables an applicant to understand the comparison results without difficulties.

※ Examples

(1) Component Comparison Table and Assessment

Claim 1	Cited Invention 1		Cited Invention 2	
	Publication in Patent Gazette No.○○-○○○○		US Patent No.○○○○○○	
A(Constituent1)	A (location of its description)			
B (Constituent2)	B (location of its description)			
C (Constituent3)			C' (location of its description)	



The invention in claim1 is different from cited invention 1 because claim 1 has constituent 3 as shown above. However, C in constituent 3 is practically the same as C' in cited invention2. C' in cited invention 2 can be easily combined with A and B in cited invention1 by a person with ordinary skill in the art which the concerned technical subject matter pertains to. Subsequently, the invention in claim 1 can be easily invented by a person with ordinary skill in the pertinent art by using cited invention 1 and 2.

(2) Component Comparison Table and Assessment

Claim		Cited Invention 1 US Patent Publication No. 00-0000	Cited Invention2 US Patent Publication No. 000000
Claim1	A(Constituent1)	A (location of its description)	
	B(Constituent2)	B (location of its description)	
	C(Constituent3)		C' (location of its description)
	Judgment	C in constituent3 is practically same as C' in cited invention 2. As A and B in cited invention 1 are easily combined with C' in cited invention 2, claim 1 can be invented without difficulties using cited 1 and 2.	

(5) 「Considerations in Amendment」states matters, which are not the grounds for rejection but those are useful to be referred for an applicant to easily respond the notice of the ground for rejection. For example, an examiner's opinion about the description, reasons not putting the claims (not notified as the ground for rejection) into the patentable claims, and other considerations for amendments except for the notified grounds for rejection shall be disclosed.

(Note) If an examiner intends to use the contents in「Considerations in Amendment」as the grounds for rejection, he/she shall make notification of the ground for rejection again.

**5.4.3 Preparation of Written Decision of Rejection**

A written decision of rejection is prepared with the same method as a written notice of grounds for rejection, except that 'a matter notified for the ground for rejection' in [Examination Outcomes] is replaced with ' a matter where the ground for rejection is not overcome'. Where a written statement of argument and a written amendment in response to a notice of grounds for rejection are not submitted, an examiner may not separately state [Examination Results] and [Rationale for Decision to Reject].

(1) 「Claims to be Examined」illustrates application numbers in the description which is subject to a decision to reject the application.

(2) 「Relevant Provisions for Matters Where Grounds for Rejection Not Overcome」 states matters where grounds for rejection are not overcome and accordingly the decision to reject the application shall be made and their relevant provisions of the Act shall be disclosed.

Where a new claim is added but it still includes the already-noticed ground for rejection, it is considered that an opportunity for written argument has been given and then it is stated as matters where grounds for rejection are not overcome, provided however that a claim whose grounds for rejection have been notified before amendments and a newly added claim shall be same.



※ Examples

No	Matters Where Rejection Grounds Not Overcome	Relevant Provisions
1	Detailed description in claimed invention	Article 42(3) (deficiency in detailed description)
2	Claims 1, 4 and 6	Article 29 (2) (inventive step)

(3) 「Patentable Claims」 stipulates both claims where no grounds for rejection are notified and claims where the having-notified grounds for rejection have been overcome during the examination. Exceptionally, however, an examiner may not indicate patentable claims in the following cases; where a judgment for patent requirements is not made in the claim due to some certain reasons including an addition of a new claim, where an examiner discovers new grounds for rejection in the claim incurring from an amendment, or where the claim is judged to be unpatentable as it is related to other grounds for rejection.

Likewise, where a claim, which has not been notified as the ground for rejection, is not stipulated as patentable claim, an examiner shall explain a reason in 「Considerations」. By doing so, an examiner can clarify his/her opinion about a claim which is not included as a patentable claim despite the fact that it contains no ground for rejection. This clarification helps an applicant in his or her response to an examiner's decision to reject a patent as follows: where an applicant requests for a reexamination by submitting the written amendment, an applicant may delete claims excluding patentable ones. Where an examiner judges that there are no patentable claims as of the time for decision to reject a patent, no entries are made in 「Patentable Claims」.

(4) 「Grounds for Decision to Reject」 writes more specific rationale regarding the ground for rejection that have not been overcome, in order for an applicant to better understand. Where the ground for rejection is related to a claim, an examiner shall specifically state reasons for rejection by the category of each claim. If the same reasons had already been notified in the written ground for rejection, an examiner may avoid redundant statement by indicating its source, instead of stipulating the same reason herein again.

Where both a written argument and an amendment are submitted together, an examiner shall state reasons for why applicant's amendment does not overcome the ground for rejection and why the arguments made by an applicant cannot be admitted. In such case, for claims without practical amendments or for dependent claims without direct amendments, just a statement of 'the ground for rejection having notified is not overcome' would be sufficient.

Where only a written statement of argument is submitted without a written amendment, an examiner states the reasons why he/she denies an applicant's argument along with matters containing unresolved grounds for rejection.

(5) 「Considerations in Amendment Submission」 states issues that are not the ground for rejection but can be referred upon submitting the written amendment in subsequent procedures such as a request for reexamination.

For example, where a decision to reject the application is rendered due to the previously-notified grounds while new grounds are also produced from addition of claims or an amendment, such can be added in 「Considerations」.

#### 5.4.4 Instructions for Examination on Claim-to-claim Basis

(1) Even if the detailed description has deficiency, claims, which seem to relate to such deficiency of the detailed description but do not contain any grounds for rejection themselves, can be classified

under [Patentable Claims]. However, it does not apply for some exceptional cases where it is difficult to make a judgment about patentability of a claim upon the notice of the ground for rejection, provide however that a claim is related to the ground for rejection in the detailed description having been notified, or where an examiner judges that any amendment by an applicant cannot remedy the ground for rejection in the detailed description. In such case, in「Considerations in Amendment Submission」, an examiner shall describe why he/she does not include such claims as patentable claims.

(2) Where a claim cites another claims where the violation of the Article 42(4) provides the ground for rejection, an examiner shall pay special attention to whether or not the citing claim continues to have such ground for rejection of a cited claim. If adjudged to still have the ground for rejection of a cited claim, it is stated that a citing claim has the same ground for patent rejection as a cited claim. However, where a cited claim violates only the manner of describing the scope of claims stipulated in the Article 42(8) of the Patent Act and the Article 5 of the Enforcement Order on the Patent Act, it is stated that only a cited claim has the ground for rejection due to a violation of description manner.

(3) Where an examination is performed on an application involving two or more groups of inventions, an examiner normally considers the requirement for patentability regarding the inventions falling under at least one group. Therefore, when pointing out a violation of unity of invention as the ground for rejection, an examiner shall indicate claims in another group rather than the group whose patent requirements such as novelty and inventive step have been evaluated.

Also, an examiner includes claims without grounds for rejection under the [Patentable Claims] among claims falling under the group (where inventions in this group have been evaluated in terms of the patent requirements). On the other hand, if an examiner found grounds for rejection regarding novelty and inventive step for those claims, he or she shall notify the ground for rejection together with grounds for rejection regarding unity of invention for the claims in the other groups.

Where considered necessary to notify lack of unity before anything else from the perspective of examination efficiency, an examiner shall state in 「Considerations in Amendment Submission」 that he/she has not performed the patent requirements test for the invention with no ground for rejection, though it is subject to the group (where inventions subject to this group have been evaluated whether to satisfy their patent requirements). An examiner shall not include this claim in the「Patentable Claims」.

## **5.5 Disclosure of Information on Prior Art Documents**

Where an examiner prepares the ground for rejection in relation to the technical subject matter of a claim, he/she shall cite supporting documents for his/her rationale. Disclosure methods for information on prior art documents, which are not decided in this section, shall comply with WIPO Standard ST.14.

### **5.5.1 Citation of Patent Documents**

(1) Where citation documents supporting the ground for rejection are patent documents, the cited patent documents shall be clearly stated in the order of publishing country (can be omitted, if Korea), title of patent documents, document number (laid-open number), and publication date (public disclosure date, if published in patent gazette).

Title and document number are stated the same as they are in the concerned patent documents. Specific examples can be found in the following table.

Publishing Country	Examples of Citations
Korea	Registered Utility Model Gazette No.oo-oooo(19××. ×. ×.) Published Patent Gazette No.oo-oooo-oooooo(19××. ×. ×.) Published Utility Model Gazette No.oo-oooo(19××. ×. ×.) Registered Patent Gazette No.oo-oooo(19××. ×. ×.)
US	US Patent No. US ooooooo (20××. ×. ×.) US Patent Application Publication No. US oooo/ooooooo (20××. ×. ×.) US Patent Abstract No. US ooooooo (19××. ×. ×.)
Japan	JP Patent Gazette A No.ooooooo(20××. ×. ×.) JP Registered Utility Model Gazette U No.oooooo(20××. ×. ×.) JP Published Patent Gazette AH No.oo-oooooo(19××. ×. ×.) JP Published Patent Gazette A No.2000-oooooo(20××. ×. ×.) JP Published Model Utility Gazette S No.oo-oooo(19××. ×. ×.)
UK	UK Patent Publication No.ooo Abstract (class ooo)(19××. ×. ×.) UK Patent Publication No.ooo Abstract(Group ooo)(19××. ×. ×.) UK Patent Publication No.ooo Abstract(Heading ooo)(19××. ×. ×.) UK Patent Publication No.ooo(19××. ×. ×.) ※ In case of citing an abstract of the description, the classification of abstracts shall be stated in parenthesis ('class' refer to abstracts before 1930, 'Group' refers to abstracts from 1931 to No.940,000, 'Divisions' refer to abstracts from No.940,001, and 'Heading' is a sub-category of 'Divisions')
Germany	DE Patent No.oo-ooo(class oo)(19××. ×. ×.) DE Patent Application Publication No.oo-ooo(class oo)(19××. ×. ×.) DE Patent Application Publication No.oo-ooo(19××. ×. ×.) ※ The description of patent in Germany is classified with 'class' for the patent document published in 1955 (No. 624,334 - No. 655,806) and after 1957, which shall be stated in parenthesis. ※ The published description of patent application in Federal Republic of Germany(West Germany) has been published from January 1, 1957 (No.1,000,001). The description published between 1959 and 1960(No.1,048,241-No.1,096,300) is classified with 'class' , which shall be stated in the parenthesis.
Int. Application	International Publication WO78/ No. ooooooo (19××. ×. ×.)

(2) When patent documents are cited for the grounds for rejection, an examiner shall clearly state which part of the documents are used for citation by using No. of page or drawings in the parenthesis as follows:

(Ex) Published Patent Gazette No.oo-oooo-ooooooo(19××. ×. ×.) (No. of page and drawing)

Published Patent Gazette No.oo-oooo-ooooooo(19××. ×. ×.) (Speed Reduction Gear)

Published Patent Gazette No.oo-oooo-ooooooo(19××. ×. ×.) (Drawing No. a, b, c )

### 5.5.2 Citation of Non-patent Documents

(1) Depending on periodical publication, non-patent documents are cited as follows:

Type	Citations Instructions
Periodicals, Non-Periodicals	( i ) Order of description when citing publications is as follows; Name of Author, Title of Thesis, Title of Publication. Location of Publication: Publisher. Publication Date, Number of Volumes, Number of Issues, Page No. Name of Author, Title of Thesis, and Title of Publication shall be discerned using a period (.), while Location of Publication and Publisher is distinguished using a colon (:). Put a period(.) after

	<p>Publisher. Others are divided using a comma(,).</p> <p>(ii) Title of publication is generally not stated in abbreviations.</p> <p>(iii) Number of volumes and issues are stated as 'Volume oo, No.oo'. For English publications, 'Vol. oo, No. oo'</p> <p>(iv) Where publication date can substitute a number of volume , the statement of volume and issue numbers can be omitted.</p> <p>(v) Publication date herein refers to the publication date inscribed on the documents. Where publication date in the documents do not inscribe a publication day, then month/year of the publication is sufficient.</p> <p>(vi) For unclear publication date, the date of obtaining the documents can be stated instead, with a clear explanation for the reason.</p> <p>(vii) For a publication with no concerns for misunderstanding of its publisher, name of publisher can be omitted.</p> <p>(viii) Where a location of publication is not well known place, its country shall follow right after the location, which is distinguished with comma (,). For publications published in Korea, the location of publication is omitted.</p> <p>(ix) Name of author and title of thesis if considered unnecessary can be omitted.</p> <p>(x) Pages in publications of periodicals or non-periodicals are indicated with the consecutive number of volumes. If the consecutive number is not indicated, the page number of the concerned issue is cited using 'pp' in front of numeral. Where citation involves plural pages, hyphen (-) shall be used between the first page and the last page number if they are consecutive pages, while comma (,) is used for discontinuous pages.</p> <p>(xi) Title of publication is written in the style of italics. For a publication translated in foreign languages, it is principle to write an original language with Korean in the parenthesis.</p>
Books	<p>( i ) Name of Author(or Name of Editor). Book Title. Location of Publication: Publisher. Publication Date, Number of Volume, No. of Edition, and No. of Page is the order for book citation For a translated book, Name of Author (or Editor), and Name of Translator are the description order.</p> <p>(ii) Name of Author and Book Title shall be discerned using a period (.), while Location of Publication and Publisher is distinguished using a colon (:). Put a period(.) after Publisher. Others are divided using a comma(,)</p> <p>(iii) For a lecture, collective works, or series, title of lecture or series and the number of volumes in collective works shall be stated before book title.</p> <p>(iv) Book title is written in the style of italic.</p> <p>(v) Number of edition if not indicated on the book can be omitted.</p> <p>(vi) Where location of publication is not well-known, its country shall follow right after the location, which is distinguished with comma (,). For a book published in Korea, the location of publication is omitted.</p> <p>(vii) Page Number, is stated page number with 'pp.' before numerals. Where citation involves plural pages, the rules for periodicals shall be complied with.</p>

(2) Where a part of publication is cited for the grounds for rejection, in order to clearly stipulate which part of document is used for the ground of rejection, page number or drawing number shall be included in parenthesis.

(Ex) Journal of Korean Chemistry Society. Corporation, Korean Chemistry Society. 19××.×.×., Vol.o, No.o (pp. o or pp. o)

Hong Gil-dong. Steam Engine. Daejeon: oo Publication Co. 19××.×.×., Edition o (pp. o)

### 5.5.3 Citation of Electronic Documents

Where citing electronic documents searched from CD-ROM, the internet, or on-line DB, an examiner shall state the general information of the cited documents along with types of search medium (state in a brace), search date (state in a brace after the publication date of the cited documents) and search site.

(Ex) Joint Authorship of 3 including Hong Gil-dong and et al. Method to Promote Search Speed through Effective Management of Patent Documents. Korean Association of Computer, [online], February 2001, [Search on July 15, 2010], Internet: <URL: <http://www.kipo.go.kr/papers>>

## **6. Instructions for Written Argument and Others**

### **6.1 Extension or Reduction of Designated Period**

Where the Commissioner of KIPO or an examiner designates the period for a patent procedure, he/she may, upon request shorten or extend the period (hereinafter 'designated period'), or extend the period *ex officio*. In such cases, the Commissioner of KIPO etc. shall decide whether to shorten or extend the period in a way that does not unlawfully violates the interests of the interested parties involved in the relevant procedure.

#### **6.1.1 Extension and Approval of Designated Period for Substantive Examination**

(1) The extension of the designated period pursuant to the Article 16 of the Enforcement Decree of the Patent Act can be requested once or twice a month. Where a request for extension period is less than one month, it is regarded as one month extension.

Except for the period designated for submission of a written argument in response to the notification of ground for rejection (hereinafter 'period designated for written argument submission'), a request for period extension is deemed to be approved on its request date. However, even in this case, an examiner may approve the extension request to a partial period if considered necessary and disapprove the remaining period if considered unlawfully violating the interests of the interested parties. For the disapproved remaining period, an examiner shall deliver a warning notification for disapproval in the period extension.

(2) Where a request for extending the period designated for written argument submission is filed and the expiry date in the extended period is within four months from the original expiry date having been designated in the written notification of ground for rejection (hereinafter 'period designated for extension request'), the request for extension is deemed to be approved on its request date. However, if the designated period for extension is beyond the prescribed period, an examiner reviews request reasons and approves the request if considered necessary.

Where an expiry date of the extended period (designated for written argument submission) arrives later than the period designated for extension request, an examiner shall approve the extension up to expiry date of the period designated for extension request. For the remaining period, an examiner shall review reasons for extension request and approves if considered necessary as follows. After approving the period extension, an examiner delivers to a written notification to a requester where he/she explains his/her purport of approval decision and informs that an additional period extension afterwards can be requested through a petition with additional reasons.

① Where an applicant elects an attorney for the first time or discharge or change an attorney within a month from the period expiry date

② Where an applicant submits a form to change applicants within a month from the period expiry date, only when new applicants are added.

③ Where an applicant receives patent examination outcomes from foreign patent offices within two months from the period expiry date and submits the period extension request along with the aforementioned

④ Where a delivery of the written ground for rejection is delayed more than one month

⑤ Where an original or later application is pending on a trial or a litigation

⑥ Where considered necessary for testing or evaluation of test results related to the ground for rejection

⑦ Or other cases where considered unavoidable to extend the period

※ Where the period extension request is filed on an application by third party, request reasons of ① ~ ⑤ are not admitted.

(3) Where fees for period extension request are not paid, an examiner shall request an applicant to pay within a time limit (determined by an examiner). If paid within the time limit, the extension request is regarded as valid. However, if not paid within the time limit, an examiner invalidates the extension request. This guideline applies for both the statutory period and the period designated for substantive examination.

(4) Where a request for period extension is made after the period designated for substantive examination (or the extended period, if a request for extension having been made is approved), an examiner gives an applicant with an opportunity to petition and returns the request afterwards. In such case, the fees paid upon filing the extension request are refunded.

(Note) Fees shall be refunded where a request for period extension is rejected.

### **6.1.2 Extension and Approval of Period Designated for Formality Examination**

(1) The period designated for amendment according to the Article 46 of the Patent Act, can be extended several times for the minimum period of a month or longer upon request. Where a request for extension period is less than one month, it is regarded as one month extension.

(2) The period available for extension shall not exceed more than four months in total. However, a further extension can be made if considered necessary as follows; where reasons not liable for an applicant take place or where an international patent applicant enters domestic stage.

(3) Where an extension request does not exceed four months and the concerned fee has been paid, the request for period extension is deemed to have been approved upon filing. For a request for four-month extension, a forewarning of "no further extension will be approved afterward" attached to the written approval shall be notified of an applicant.

If an applicant makes another extension request afterwards, it shall be rejected.

(4) Where an applicant makes an overdue requests for an extension of the period designated for formality examination (or extended period, if the extension request is approved), an examiner shall provide an opportunity for petition to an applicant and return the request form. At this time, an examiner shall refund too, along with the request form.

(Note) Fees shall be refunded where a request for period extension is rejected.

### **6.1.3 Reduction of Designated Period and Others**

(1) The period for a patent-related procedure having been designated can be reduced according to a request. Where a request for period reduction is made or where a written amendment or description stipulating the purport to reduce the designated period is submitted, the designated period is deemed to have been expired as of the submission date of a reduction request form or a written amendment.

(2) Any person can request to extend the period for requesting for a trial against to reject a patent (a utility model) application only for once and for up to 30 days. However, the number and the period of extension may be further extended for a person residing in an area that is difficult to access. When such request is made, the President of IPT (Trial Policy Division) shall review the requirements and determine whether it is approved or not.

(3) Where the written amendment for specification or drawing(s) is submitted after the designated period, it shall be returned by reason of overdue submission. However, an amendment of application as to formalities shall be admitted anytime before invalidation.

### **6.2 Instructions for Written Argument**

(1) Where a written argument is submitted along with an amendment, an examiner shall review both of the argument and the amendment in depth and determine as to whether the notified grounds for rejection can be overcome or not based on such argument and amendment. Also, where only a written argument is submitted without an amendment, an examiner shall consider sufficiently an argument to determine as to the notified grounds for rejection can be overcome or not.

(2) A written argument or other documents including experiment results in response to the notification of the grounds for rejection shall not be a part of the specification of the application. However, as these documents are submitted to clarify or verify the legitimacy of matters in the detailed description, an examiner may refer them to decide the patentability of the concerned application.

(3) Where an amendment is submitted after the period designated in the notification of the grounds for rejection shall be returned to an applicant. However, as for a written argument, it does not fall under cases not to be admitted (the Enforcement Rules of the Patent Act Article 11(1)), an examiner may admit it in reference.

(4) Where an applicant insists matters to be amended in a written argument but fails to submit an amendment, an examination shall be made on the detailed description and claims upon the notification of the ground for rejection. Also, where contents of amendments having insisted in a written argument and the actual amendments show discrepancy, an examination shall be made based on the actual amendments to the detailed description and claims.

### **6.3 Treatment of Amendments**

#### **6.3.1 Method to Confirm Amendment of Detailed Description, Claims and Drawings**

(1) The final specification to be examined shall be determined automatically through the Patent Net (Internal examination supporting tool) after reflecting amendment to the detailed description, claims and drawings. An amendment to the full text of the specification shall be replaced as the final specification to be examined.

Refer to the following example for specific method.

(Ex) Method to determine the description to be examined where the 1st and 2nd written



amendment having been submitted within due time.

Matters to be Amended	Initial Application	1st Written Amendment	2nd Written Amendment	2nd Amendment	2nd Amended specification	1st Amended specification
Detailed Description	◇	◆		◆	◆	◆
Claim 1	○	●		●	●	●
Claim 2	□	■	■	■	■	■
Claim 3	△				△	△
-						
Claim 10	☆				☆	☆
Drawing(s)	♠	♠		♠	♠	♠

※ As seen in the above example, where an applicant amends detailed description, claim 1, claim 2, and drawing(s) of a claimed invention in the 1st written amendment and submits the 2nd written amendment with claim 2 amended. the 2nd amendment is determined to be a combination of final amendments individually made in claim 1 and claim 2 ((Detailed Description(◆), Claim 1(●), Claim 2(■) and Drawing(s)(♠)), and the 2nd amended description is determined to be a combination of matters not amended in the 2nd amendment and an original description. (Detailed Description(◆), Claim 1(●), Claim 2(■), Claim 3(△), ...Claim 10(☆) and Drawing(s) (♠)).

(2) Where an amendment in response the final ground for rejection or made upon the request for reexamination is dismissed pursuant to the Article 52(1) of the Patent Act, an examiner considers the amendment deemed to have never been submitted. The dismissal of amendment shall be referred to this section in 「11. Amendment in Response to Final Notification of Ground for Rejection」.

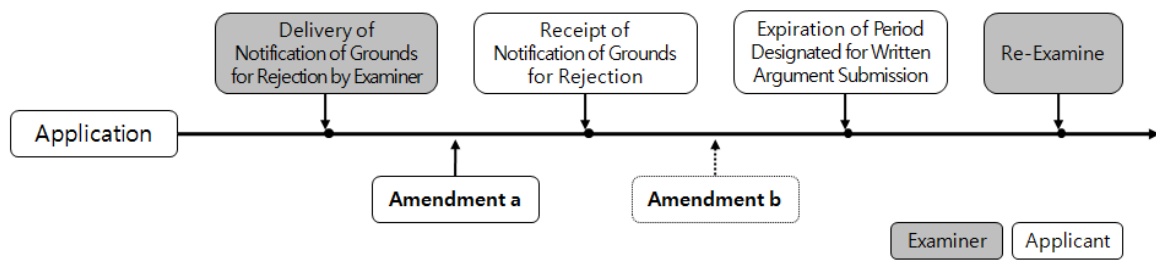
### 6.3.2 Additional Matters to be considered

(1) A self-amendment submitted before examination starts and an amendment in response to the non-final notification of grounds for rejection within the period (designated for submission of a written argument) are recognized as submitted.

(2) An applicant may self-amend during the period between the delivery of the ground for rejection by an examiner and its receipt by an applicant. To expedite an examination proceeding, where an applicant submits an amendment during the period between an examiner's sending of the grounds for rejection and an applicant's receiving of it, the notification of the ground for rejection having delivered shall not be cancelled but be treated as follows.

Where a date of applicant's receipt of the grounds for rejection, which can be confirmed by the special mail (parcel) registered receipt, is the same as a date of amendment submission, an amendment is regarded as being submitted earlier than receiving the ground for rejection unless there is an evidential basis for the fact that a notification delivery precedes amendment submission. Where a written amendment identifies a delivery number of a notification for rejection ground, the notification delivery is regarded to be earlier than amendment submission.





① Where just **Amendment a** is submitted

An examiner shall examine again the specification that have been reflected of **Amendment a**.

(a) Where an examination of the amended specification discovers no ground for rejection, an examiner shall decide to grant a patent.

(b) Where an examination of the amended specification still discovers a ground for rejection that is not a newly generated by **Amendment a** but has been notified, an examiner shall decide to reject the application by reason that the amendment fails to overcome the ground for rejection.

(c) Where an examination of the amended specification discovers that the grounds for rejection having been notified are overcome but a new ground for rejection is generated due to **Amendment a**, or where an examination of the amended specification discovers grounds for rejection that have been existed in the original specification prior to **Amendment a** but have not been notified previously, an examiner shall notify the non-final ground for rejection again.

② Where **Amendment a** and **Amendment b** are submitted

An examiner shall examine again the specification that have been reflected of **Amendment a and Amendment b**.

(a) Where an examination of the amended specification discovers no ground for rejection, an examiner shall decide to grant a patent.

(b) Where an examination of the amended specification still discovers grounds for rejection that are not a newly generated by Amendments but have been notified, an examiner shall decide to reject the application by reason that the amendment fails to overcome the ground for rejection.

(c) Where an examination of the amended specification discovers that the ground for rejection having been notified is overcome but a new ground for rejection is generated due to **Amendment a**, or where an examination of the amended specification discovers a ground for rejection that have been existed in the original description prior to **Amendment b** but have not been notified previously, an examiner shall notify the non-final grounds for rejection again.

(d) Where an examination of the amended specification discovers no ground for rejection but a ground for rejection incurring from **Amendment b**, an examiner shall notify the final ground for rejection.

## 6.4 Instructions for Reference Document in Examination

(1) If considered necessary to expedite an examination proceeding, an examiner may ask an applicant to submit documents and other references required for examination.

(2) Documents or other things required for examination are as followings.

① Related documents and their translations in the case of an international application as well as examination outcomes in other patent offices where its family application has been filed, if considered necessary.

② A written statement presenting each claim's technical subject matter with its corresponding detailed description by indicating paragraph number, and a written statement explaining relation among claims in the case where an application involves enormous amount of detailed description and a vast number of claims.

③ A written statement summarizing gist of a claimed invention, in the case where technical subject matter of a claimed invention is too complex to comprehend within the designated period.

④ Samples or experiment results, in the case where effects of a claimed invention cannot be verified without them, provided however, the submission of samples or experiment results shall enable to confirm that the description has been definite and sufficient upon filing an application.

⑤ A written statement explaining a process of inducing the concerned formula and definitions and meanings of technical terminology or signs, in the case where a formula, technical terminology, or sign is not clearly understood.

⑥ A written statement clearly explaining again an applicant's claim in the written statement of arguments, in the case where an applicant's claim in the written statement of arguments is hard to understand and deemed to have serious impact on a decision for patentability.

(3) The request for documents required for examination shall be made under the name of an examiner in charge. He/she shall specifically clarify which document shall be submitted. The period designated for document submission falls within the period designated for submission of a written argument. To expedite an examination proceeding, an examiner may include his/her request for documents under 「Considerations in Amendment」 in the notification of the grounds for rejection.

(4) Even if an applicant fails to respond the document request by an examiner, an examiner shall not invalidate an application procedure.

(5) Documents submitted by an examiner's request are only used for reference material, which cannot substitute or supplement the description.

(6) Where receiving the documents or samples from an applicant, an examiner shall keep a document list and store documents or samples in a file wrapper if possible, or store them separately till the examination closes.

An examiner shall refer to the following with regard to documents or samples submitted.

① For documents or samples on return request by an applicant, an examiner shall pay special attention in storing them undamaged.

② Even for documents or samples with no return request, an examiner shall also pay special

attention in storing them undamaged just in case where those documents or samples are requested in trial

- ③ An examiner commences a procedure to return them right after examination closes.

(Note) Where a person who has submitted documents or samples, intends to get them back, he/she shall state the purport to the return request form. After closing the examination, an examiner shall designate the return period and notify a submitter to receive the documents or samples within that period.

Where no request has been made for return of documents or samples, or where a submitter fails to go through return proceeding within the designated period, documents or samples can be disposed of as decided by the Commissioner of KIPO.

(7) An examiner may use evidential documents submitted for information for his/her examination according to Article 63 bis.

Where it is certain that evidential documents are periodicals or their copies, or copies of description or drawing(s) having been published before the application date, an examiner may use them as prior art without additional examination of evidence.

Where evidential documents submitted are documents other than periodicals or their copies, or copies of description or drawing(s) having been published before the application date, an examiner may use them as prior art only if an examiner is confident of the fact to be verified without examination of evidence. However, where an applicant argues the existence of the evidential fact in the written argument, an examiner shall not admit the fact unless he/she finds its admission justifiable.

(Explanation) The Patent Act has no provisions regarding an examination of evidence during examination. Therefore, where the evidential documents submitted for reference information are documents other than periodicals or their copies, or copies of description or drawing(s) having been published but the fact to be verified cannot be confirmed with confidence, an examiner shall not decide to reject the application based on this evidence.

(Note) Except for an application which has been invalidated, withdrawn, or abandoned, or whose patent grant or rejection has been decided by an examiner, anyone can provide relevant evidence to an examiner to argue that an application of the claimed invention shall not be patented. Information provision can be made by any person or corporation, except for an incompetent minor who shall appoint a legal representative for such action. In the meanwhile, an examiner may refer documents or information provided by a group or association instead of invalidating or returning them.

## **7. Additional Search**

During the examination stage, an examiner shall conduct additional searches for the following cases.

- ① Where an examiner finds through the written argument, personal interview, or information provided that his/her incomplete understanding of claimed invention results in the incomplete search.

- ② Where amended claims include subject matters not covered by the original search.

- ③ Where an examiner intends to examine the claimed invention which has been excluded from the original search due to lack of unity of invention (i.e. a group of inventions that form a single general inventive concept).

④ Where an international patent application that can be regarded as another application in terms of the Article 29 (3) enters the domestic stage and its translation is expected to be submitted.

⑤ Or other cases where considered necessary for additional research

## **8. Examination Deferral or Extension of Processing Period**

(1) An examiner may defer an examination or extend the processing period within 2 months when an application under his/her examination falls under the following cases.

Note that examination deferral or period extension of processing period is not allowed when the Commissioner of KIPO or an examiner designates the processing period for the concerned application,

① Where an earlier application or conflicting applications is (or are) not laid open or request for an examination for the conflicting applications is not made.

② Where the period, during which an earlier application serving as a basis of domestic priority claim is deemed to have been withdrawn, has not elapsed.

③ Where a patent trial or proceeding related to the application concerned is pending.

④ Where the period extension for processing is required for the circumstances that search for prior art is outsourced to a specialized organization, that expert opinions are inquired, or that the examination with consultation needs to be carried out.

⑤ Where the period designated for submission of evidential documents for priority right in case of an application claiming priority under the treaty has not elapsed.

⑥ Or other occasions where considered necessary to defer examination start.

(2) Deferral of examination or extension of processing period shall be reported to the head of Examination Unit, and be notified to the concerned applicant.

(3) For an application whose examination or processing has been already deferred or extended respectively, an examiner shall review more than one time a month to confirm whether the reasons causing deferral or extension have been resolved or not. Where the review confirms all reasons for examination deferral or extension of processing period have been cleared up, an examiner shall terminate the deferral or the period extension.

(4) When the examiner considers the examination to be deferred and the processing period to be extended again because the application does not overcome the previous deferral or extension reason or new deferral or extension reasons occur, it shall be reported to the head of the examination division (team) following a head of the examination unit, and the deferral or extension shall be made within two months.

(5) Where an examiner once again decides to defer the examination or extend the processing period according to the abovementioned case (4), he/she notifies the applicant specific reasons of deferral or extension.

## 9. Document Delivery

### 9.1 General Principles

(1) The documents shall be sent by registered mail except for the cases where the party or his/her attorney receives in person or uses information network. In case of sending documents by post mail, the registration receipt shall be kept.

(Note) A trial ruling or a written decision regarding a patent trial, retrial, or cancellation of a patent right shall be delivered by a special delivery method according to laws on postal service.

(2) The documents shall be delivered to a legitimate receiver, referring to an attorney if appointed, sub-attorney or attorney appointed midway except for special cases. The special cases herein refers to the occasion where a delivery is made to an attorney given no priority regarding notification, or where an attorney or the party goes through the procedure directly related to the examination such as a written statement of argument or an amendment (hereinafter the same shall apply).

In case of two or more agencies, except for special cases, a legitimate receiver shall be the attorney described first in a written patent application.

For a multiple number of attorneys with general power, documents shall be delivered preferentially to the attorney having appointed for the relevant case.

Where a receiver is incompetent, delivery shall be made to his/her legal representative.

Where two or more applicants involve in a patent application, delivery shall be made to a representative if elected, or to the applicant stated first in the written application if no representative is designated, except for special cases.

(3) The delivery of documents shall be made to residential or business address of a entitled receiver unless reporting other address for delivery. The change of delivery address shall be reported without delay.

(Note) Where a failure of delivery is due to rejection by a receiver without justifiable reason, the date of sending is regarded as a receiving date. More details regarding document delivery can be referred to 「Part 1 General Rules」.

### 9.2 Delivery by Public Notification

When documents cannot be delivered because the residential or business address of the addressee is unclear, the documents shall be delivered by public notification. 'residential or business address of the addressee is unclear' herein refers to the case where the address of the addressee cannot be verified even using the resident registration use system. It includes the case where two or more persons go through a patent procedure and all their addresses cannot be verified.

Delivery by public notification shall be made as follows.

① Where documents are returned, an officer in general affairs division of examination bureau shall file the facts regarding the document returns such as return number, reason of return to a computer system and communicate to an examiner in charge.

Where an examiner is notified of the aforementioned, he/she shall verify the address of a legitimate receiver by telephone, to which an examiner shall send again the returned documents and

the "Guide to Report on Information Change in Applicant" with attachment of the form to report the change of applicant's information (i.e. Form(v) in the Enforcement Rules of the Patent Act).

② Notwithstanding the procedure in ①, where the address confirmed by the Resident Registration Use System is identical with the address confirmed by telephone, an examiner shall deliver documents by public notification. If not identical, an examiner shall deliver again the documents to the address confirmed by the Resident Registration Use System according to the procedure in ①.

③ Where documents were sent again to the address confirmed through the Resident Registration Use System but returned again, documents shall be delivered by public notification with no further procedure for address confirmation.

※ Where a receiver is a corporation, the Resident Registration Use System cannot be used. In this case, an examiner shall exert most available efforts to confirm a correct address of a corporation and send documents to a legal address at least once before public notification.

(Note) The delivery shall be made according to the Rules on Office Management and Patent Net System. However, an examiner may adopt a different delivery method where through case by case review an examiner finds a new delivery method for sure sending to a legitimate receiver.

## **10. Personal Interview**

Where an applicant or his/her attorney (hereinafter 'the party') requests or where an examiner considers necessary for a prompt and fair examination, an examiner may have a personal interview with the party as ancillary method for examination. Cases requiring a personal interview are as follows; where considered necessary for comparative explanation between the claimed invention and the prior art, where clarification of the ground for rejection is required, where the written argument requires explanation for clear understanding, where the subject matter of the claimed invention is so complicated and sophisticated that its understanding is difficult, or others where an examiner recognizes a need for a personal interview.

### **10.1 Request and Grant for Personal Interview**

(1) The party, seeking to have a personal interview, communicates the purport by fax, telephone, information network including e-mail, or a written application submitted in person on his/her visit to the patent customer service center. Where a request for personal interview involves a multiple number of applications, the party shall file an interview request individually for each application. However, if a multiple number of applications are assigned to the same examiner, an applicant may file an interview request for all applications only one time.

The request for a personal interview can be filed after an examination begins, but not later than the decision to grant a patent. However, for an application decided to be rejected, the party may request an interview till a trial against the decision to reject the application is filed.

(2) If considered necessary, an examiner may request and set a date for an interview in writing, by fax or telephone. An interview request by an examiner is allowed only when the telephone discussion is not sufficient to reconcile ideas between the examiner and the applicant.

The date of a personal interview designated by an examiner may change under agreement with the party. The change of an interview schedule shall be included in a personal interview log.

(3) Where the party requests for a personal interview, an examiner should respond actively. However, where the party makes just a plain business contact, questions about an examination progress, asks general questions about patentability, or requests a personal interview for the same application

repeatedly or for other issues unrelated to the examination, an examiner may ask the party to modify the contents of an interview request or disregard such request aforementioned.

Where communicating with the party through telephone, fax, or e-mail regarding an interview, an examiner shall include dates and persons in communications, due date and form of an interview, and a contact number in the examination report in the Patent Examination Processing System.

## **10.2 Procedure of Personal Interview**

(1) A personal interview is face-to-face. For a face-to-face interview, it is principle to use the meeting room located in the patent customer service center. For a video phone interview, the long-distance video conference room located in the Multimedia Center of KIPO Seoul Branch (13th Floor), the video conference room in KIPO, and other facilities available for video phone interview can be used.

(2) For a personal interview to be more smooth and effective, an examiner shall in advance review the relevant documents and print out them if necessary. If the prior contact with the party confirms a discussion topic, an examiner shall review and organize the related issues in advance.

If necessary, an examiner may request the party for reference documents including document or multimedia material related to prior art in advance.

(3) Before an interview, an examiner shall confirm whether a participant in an interview is a legitimate interviewee. The legitimate participant in a personal interview is a person who can respond with authority regarding the concerned application, which includes an applicant (a representative if corporation), an attorney of the concerned application, or a person with an evidential statement showing he/she is a legitimate entrustee appointed by an attorney, an applicant, or an attorney with the right to elect an attorney for him/herself (referred to sub-attorney).

A participant with delegation limited to a personal interview shall submit a corresponding proxy statement at every interview. However, a participant may combine delegations for multiple interviews into one proxy statement by stating all the application number on the one proxy statement.

A legitimate interviewee may accompany an inventor or a person related to a patent.

(4) In the interview log, an examiner shall state an application number, name of an examiner and participants, and contents and result of interview. The interview log, which is sealed with signatures of an examiner and participants, shall be submitted to an officer in charge at the patent customer service center. The contents of an interview shall be included in the examination report of the Patent Examination Processing System.

When an examiner and an interviewee exchange opinions regarding the restricted issues, the opinion exchanged shall be briefly stated in the interview log by the examiner.

## **10.3. Instructions of Personal Interview**

(1) An examiner shall proceed to the procedure swiftly on a basis of personal interviews. Also, any agreements made during a personal interview shall be conducted within the shortest time possible.

(2) A personal interview shall not be a basis for an examiner to simplify or omit requisite statements in the notification of the ground for rejection or the written decision to reject a patent.

(3) Where an examiner discovers a new ground for rejection after a personal interview and therefore intends to deliver a measure contrary to the outcome from the interview, he/she shall communicate the purport to the party by the notification of the ground for rejection, telephone, fax or e-mail and

continue the examination process.

(4) An examiner may request the party to submit materials presented at the interview.

(5) It is principle that a personal interview is held one time per application. If necessary, it can be held up to two times.

(Note) Where an interview is held within the period designated for the submission of the written statement of the argument, a participant shall submit the responding documents (such as the written statement of the argument, the amendment, etc) in accordance with the agreement at the interview. If an applicant decides respond differently from the agreement made at the interview, he/she shall communicate the purport to the examiner in charge by telephone, fax, e-mail, or post mail.

A personal interview shall not be a basis for an applicant to simplify or omit requisite statements in the written statement of the argument.

#### **10.4. Personal Interview on Visit**

(1) An applicant may make an on-line request for an examiner to visit his/her for communication (hereinafter 'personal interview on visit').

(2) For a request of personal interview on visit, an examiner contacts by telephone to determine a need for personal interview on visit. A personal interview on visit is allowed only if communication by telephone is difficult or if deems necessary for prompt and accurate examination.

(3) A personal interview on visit is in principle carried out in a 「Regional Intellectual Property Center」 which is established pursuant to the Article 23 of the Invention Promotion Act. However, in some unavoidable circumstances, the interview can be carried out in places other than the business site of the party under mutual agreement.

(4) For a personal interview on visit, when changing a date of a personal interview on visit and keeping an interview log, an examiner shall comply with the procedure of general personal interview.

### **11. Amendment in Response to Final Notification of Ground for Rejection**

Unlike the non-final notification grounds for rejection, when receiving the amendment in response to the notification of the final grounds for rejection, an examiner shall determine whether to dismiss the amendment before assessing the requirements of patentability and confirm matters to be examined.

When submitting the written argument, an applicant may argue that the notification of the final ground for rejection issued by an examiner is inappropriate as the final ground. Where such argument is made, an examiner shall review whether it was appropriate to set it to "the final notification of grounds for rejection", considering the applicant' assertion in the written opinion.

#### **11.1 Remarks related to 'Final Notification of Ground for Rejection'**

(1) Whether the final notification ground for rejection is appropriate or not shall be referred to 「5.3 Types of Notification of Grounds for Rejection」. In case where an examiner judges that issuance of the final notification of grounds for rejection is deemed to be appropriate, he or she shall review whether amendment requirements are satisfied.



(2) On the other hand, where the issuance of final notification of grounds for rejection is deemed to be inappropriate, an examiner shall not dismiss but admit the amendment.

Where the grounds for rejection indicated in the final notification are not overcome, the examiner will take proper actions according to the following cases:

① Where no amendment is made or amendment is limited to response to the final notification of the grounds for rejection

Where an examiner notifies of final grounds for rejection but is supposed to notify of non-final grounds for rejection, and applicant submits the amendment only in response to the final notification of grounds for rejection (for example, amending by reducing the claim without adding a new claim) or fails to conduct amendment, an examiner shall notify grounds for rejection again instead of making a decision to reject the application, despite that the final grounds for rejection are not overcome. The type of the ground for rejection shall be decided with referral to 「5.3 Types of Notification of Grounds for Rejection」.

② Where final grounds for rejection are notified to an applicant, but he or she makes an amendment with considering 'the final notification of grounds for rejection' as 'a non-final notification of grounds for rejection.'

Where an applicant, arguing the inappropriateness of the examiner's issuing the final notification of grounds for rejection, submits the amendment in response to non-final notification of grounds for rejection, an examiner shall make a decision to reject the application.

For example, where an examiner notifies the deficiency in the description (which should have been notified in the non-final ground for rejection) as the final ground for rejection, an applicant argues that the deficiency had been in the application having been filed first and submits the amendment where a new claim is added (recognized as the amendment according to the first ground for rejection). In this case, an examiner shall admit the amendment and make a decision to reject a patent application afterward if the amendment still fails to remedy the deficiency in the description.

## 11.2 Examination of Amendment

(1) Where an applicant in response to the final notification of the grounds for rejection submits a multiple number of amendments within the period designated for the submission of written argument, an examiner shall determine whether he/she admit or dismiss the amendments in reverse order of the submission.

(2) Where the amendment in response to the final notification of the grounds for rejection fails to meet the amendment scope prescribed in the Article 47(2) and (3), or where new grounds for rejection occur from the amendment in response to the notification (the amendments by deleting claims according to the Article 47 (3) (i) and (iv) are excluded), the amendment shall be dismissed.

Here, the occasion of 「where new grounds for rejection occur from the amendment」 refers to the occasion where the submission of the concerned amendment causes unprecedented grounds for rejection (where the concerned amendment leads to the deficiency in the description or where a new ground for rejection regarding novelty or inventive step occurs). The new ground for rejection does not include the followings; the grounds for rejection which have been noticed prior to the amendment and the grounds for rejection which have existed without notification.

The judgment for the case 「where a new ground for rejection occurs from the amendment」 can be referred to the following examples.

(Ex 1)

Claim 1 : Equipment comprised of A+B

[Final Notification of the Grounds for Rejection] Claim 1 is denied of inventive step due to cited invention1

[Specification after Final Amendment]

Claim 1 : Equipment comprised of A+b

(still denied of inventive step due to cited invention1)

[Amendment Admitted] Since no ground for rejection is generated from the amendment of claim 1, the amendment is admitted

[Decision to Reject] The claim 1(A+b) is denied of inventive step due to the cited invention1. The decision to reject a patent is made.

(Ex 2)

Claim 1 : Equipment comprised of A+B

[Final Notification of the Grounds for Rejection] Claim1 is denied of inventive step due to the cited invention1

[Specification after Final Amendment]

Claim 1 : Equipment comprised of A+B+C

(Inventive step is admitted for the cited invention 1 but not for the cited inventions 1 and 2. The cited invention 2 is required additionally due to the addition of C)

[Amendment Dismissed] The amendment of claim 1 generates a new ground for rejection. Therefore, the amendment is not admitted, resulting in the dismissal of the amendment.

[Decision to Reject] Claim 1(A+B) is denied of inventive step due to the cited invention 1.

(Ex 3)

Claim 1 : Equipment comprised of A+B

Claim 2 : Equipment comprised of claim1 with C attached

[Final Notification of the Grounds for Rejection] Claim 1 is denied of inventive step due to the cited invention.

[Specification after Final Amendment]

Claim 1 : Delete

Claim 2 : Equipment comprised of claim1 with C attached

[Amendment Admitted] The amendment by deleting the claim 1 is regarded as the reduction of scope of the claim. Though the deletion of the claim1 causes a new ground for rejection (i.e. deficient statement of claim2), this amendment is admitted according to the Article 51 (1) of the Patent Act

[Final Notification of the Grounds for Rejection] Since the deletion of the claim1 in compliance with notification of the grounds for rejection causes the deficient statement in the claim 2, an examiner shall notify this deficient statement of the claim 2 in the final notification of the grounds for rejection.

(Ex4)

Claim 1 : Equipment comprised of A+B

Claim 2 : Equipment of claim 1 with C attached

Claim 3 : Equipment of claim 1 or 2 with D+E attached.

[Final Notification of the Grounds for Rejection] Claim 1 is unpatentable due to conflicting applications

[Specification after Final Amendment]

Claim 1 : Delete

Claim 2 : (Amended) Equipment comprised of A+B+C

Claim 3 : (Amended) Equipment comprised of A+B+D+E

Claim 4: (New Addition) Equipment comprised of A+B+C+D+E

[Amendment Admitted] Claim 4 is just an arrangement due to the deletion of the claim1, and substantially corresponds to pre-amendment claim 3. Claim 4 is not newly added. Since the addition of claim 4 is inevitable due to deletion and the amendment is recognized as appropriate, the amendment is admitted.

(Ex5)

Claim 1 : Equipment comprised of A

[Final Notification of the Grounds for Rejection] Claim 1 is denied of inventive step due to cited invention1

[Specification after Final Amendment]

Claim 1 : Equipment comprised of A+B

(Cited invention 1 includes B, denying inventive step in claim 1)

[Amendment Admitted] The rejection reason having notified is that the invention in claim 1 is denied of inventive step due to the cited invention1. Where the amendment does not generate new ground for rejection, the amendment is admitted.

[Decision to Reject] Claim 1(A+B) is denied of inventive step due to the cited invention1

(3) Regarding the satisfaction of amendment requirements, an examiner may make a judgment for the convenience of the examination procedure, disregarding the order of provisions in law, or the sequence of amendment matters. Details regarding the violation of amendment requirements shall be referred to this Part IV, Chapter 2.

(4) Where the amendment was deletion of claims and subsequently generated a new ground for rejection (due to the deletion of claims, the dependent claim has deficiency in the description), an examiner shall not dismiss the amendment by reason abovementioned. Note that an examiner shall admit the amendment unless there are other reasons for amendment dismissal, and then notify the new rejection grounds at the final notification of the grounds for rejection.

(5) The decision to dismiss amendment shall be made in writing separately from the decision to reject an application, specifying reasons why amendment had to be dismissed for the subsequent procedural convenience for an applicant.

(Note) An applicant cannot appeal against a decision to dismissal of amendment during the substantive examination, which can be dealt only in the trial against the decision to reject an application. When a reexamination is requested, a decision to dismissal of amendment made prior to the reexamination request shall not be appealed.

### **11.3 Examination after Admission of Amendment**

(1) Where the amendment is appropriately made, an examiner shall admit the amendment and determine the specification to be examined after reflecting the amendment, which is followed by proper actions such as his/her assessment of requirements of patentability, its corresponding notifications and decision to grant or reject.

(2) Where the grounds for rejection are not overcome by the amendment, an examiner shall make a decision to reject an application. Otherwise, he or she shall make a decision to grant a patent.

(3) Where the notified grounds for rejection are overcome, but other grounds for rejection are generated, an examiner shall notify an applicant of these newly found grounds for rejection. The type of the ground for rejection shall be referred to 「5.3 Types of Notification of Grounds for Rejection」.

(Note) Where an examiner overlooks the fact that an inappropriate amendment in response to the final notification of grounds for rejection is made and then makes a decision to grant a patent or notifies first or final grounds for rejection, he/she cannot dismiss the previous amendment retroactively upon his/her discovery.

### **11.4 Examination after Amendment Dismissal**

(1) After dismissing amendment, an examiner shall continue examining the pre-amended specification.

(2) Where reviewing the final notification of grounds for rejection and discovering the ground not overcome, an examiner shall make a decision to reject the application. Where an examiner regards the appropriateness of issuing the final notification of the grounds for rejection and discovers no other grounds for rejection, he/she shall make a decision to grant a patent.

(3) Where an examiner discovers inappropriateness of issuing the final notification of the grounds for rejection and also discovers other grounds for rejection, he/she shall notify grounds for rejection again. The type of the ground for rejection shall be referred to 「5.3 Types of Notification of Grounds for Rejection」.

## 12. Final Decision

Once completing the examination, an examiner shall make a decision to grant or reject without delay.

Where an examination of formalities discovers deficiency in application procedure (claims subsequent to application, application filing procedure, etc), the final decision shall be made after the procedural deficiency is remedied.

### 12.1 Decision to Grant a Patent

(1) Where no ground for rejection is discovered, an examiner shall make a decision to grant a patent in writing with rationale attached.

The written decision to grant a patent shall include an application number, title of invention, name and address of applicant and attorney, the text of the decision of patentability and its rationale, and number of claims to be patented, day/month/year of decision to grant a patent, matters having amended *ex officio*, along with an examiner's sign and seal.

(2) For a decision to grant a patent, the Commissioner of KIPO shall deliver a certified copy of the written decision to grant a patent to an applicant. The decision to grant a patent is confirmed upon the delivery of the certified copy.

### 12.2 Decision to Reject an Application

(1) Where an examiner provides an opportunity for petition to an applicant with the notification of grounds for rejection, he/she shall make a decision to reject an application in writing with rationale attached if an applicant fails to overcome the grounds for rejection.

The written decision to reject an application shall include an application number, title of invention, name and address of applicant and attorney, day/month/year of notice of grounds for rejection, the text of decision and its rationale, and day/month/year of decision to reject a patent, along with an examiner's sign and seal.

(2) For decision to reject an application, the Commissioner of KIPO shall deliver a certified copy of the written decision to reject an application to an applicant. The decision of rejection is confirmed when it cannot be revoked with methods prescribed in provisions of the Patent Act. For example, where no appeal against the decision of rejection is filed within the statutory period, where a trial decision is made supporting the rejection decision in the appeal against the decision of rejection, or where a ruling or a trial decision is made to dismiss a request for a trial, the decision to reject an application is confirmed.

(3) For decision to reject an application, an examiner shall indicate his or her determination on the applicant's amendment in which the notified grounds for rejections were still not overcome and the issuable items in the written argument.

(4) For an application involving two or more claims, where any of the claims contain grounds for rejection, an examiner shall make a decision to reject an application.

(5) An examiner shall not make a decision of rejection based on unreasonable rationale other than the already notified ground for rejection, which includes additional request for new documents relating to prior art. To refer a new prior art, an examiner shall notify the very fact as a ground for rejection.

### 12.3 Additional Notes

When examining an application with information provided by a third party as grounds for rejection or an application filed by an unentitled person, an examiner shall take requisite measures before making his or her final decision.

(1) For an application with information provided by a third party as grounds for rejection, an examiner shall notify an information provider of his/her decision and whether the provided information is used or not in the examination, when the examination closes. However, where the information is provided by a person without capacity to provide information (incompetent person, or fictitious person), or where the application is abandoned, withdrawn, or invalidated prior to examination, an examiner may not notify the use of information.

(2) Where an examiner decides to reject an application based on the ground that the application is filed by an unentitled person, he/she shall deliver written notice to the lawful right-holder without delay after confirming the decision of rejection. Where the confirmation of the decision of rejection requires a long time in an appeal against the decision to reject, an examiner before the confirmation of decision of rejection, may notify a lawful right-holder of his/her decision to reject an application and the appeal against the decision of rejection in advance.

### 13. Cancellation of Examination Measures

Where an examiner discovers defects in his/her measures during the examination, the very examiner may cancel the measures. The cancellation of a measure loses its partial or whole validity retroactively to the very beginning.

An examiner shall review whether his/her measure during the examination stage falls under cancellation in the following cases; where an examiner resumes the once suspended or deferred application, where an examiner resumes the once closed application including a withdrawn or abandoned application, or where an examiner conducts an examination of application which is not requested for examination.

(1) Any cancellation shall be made under the name of an examiner who originally has conducted the concerned measure. For cancellation of a measure having been conducted by an examiner, the measure can be cancelled only when the concerned measure displays definite defects and the benefits of its cancellation far outweigh than the benefits of its maintaining. In other words, an examiner shall cancel *ex officio* only when the benefits from law compliance outweigh those from confidence protection on a basis of comparative analysis between 'the principle of law compliance' and the 'principle of confidence protection'.

(2) For notification of the ground for rejection, request for amendment, and request for supplementation, an examiner shall not cancel them because their cancellation is of less practical use compared to keeping them through amendment or error correction.

(3) A cancellation of a measure having been carried out by an examiner shall be notified to an applicant with definite and specific explanation of the measure to be cancelled and its corresponding reasons after the communication to a managing director of the Examination Bureau following a head of the Examination Part.

(4) In principle, the cancellation shall be made in the form of a notice for cancellation provided by the Patent Examination Processing System. However, 「On-nara System(EDMS: Electronic Document Management System in Korean Government)」 can be used in cases as follows; where two months have passed after the delivery due date, where new documents are received after delivering the notice of the measure, or where a process relating to fee payment is not completed, or where the

form of notice for cancellation cannot be prepared due to failures in other systems of subsequent procedure.

(5) When cancelling the measure having conducted by him/herself, the concerned examiner shall execute the corresponding subsequent measures.

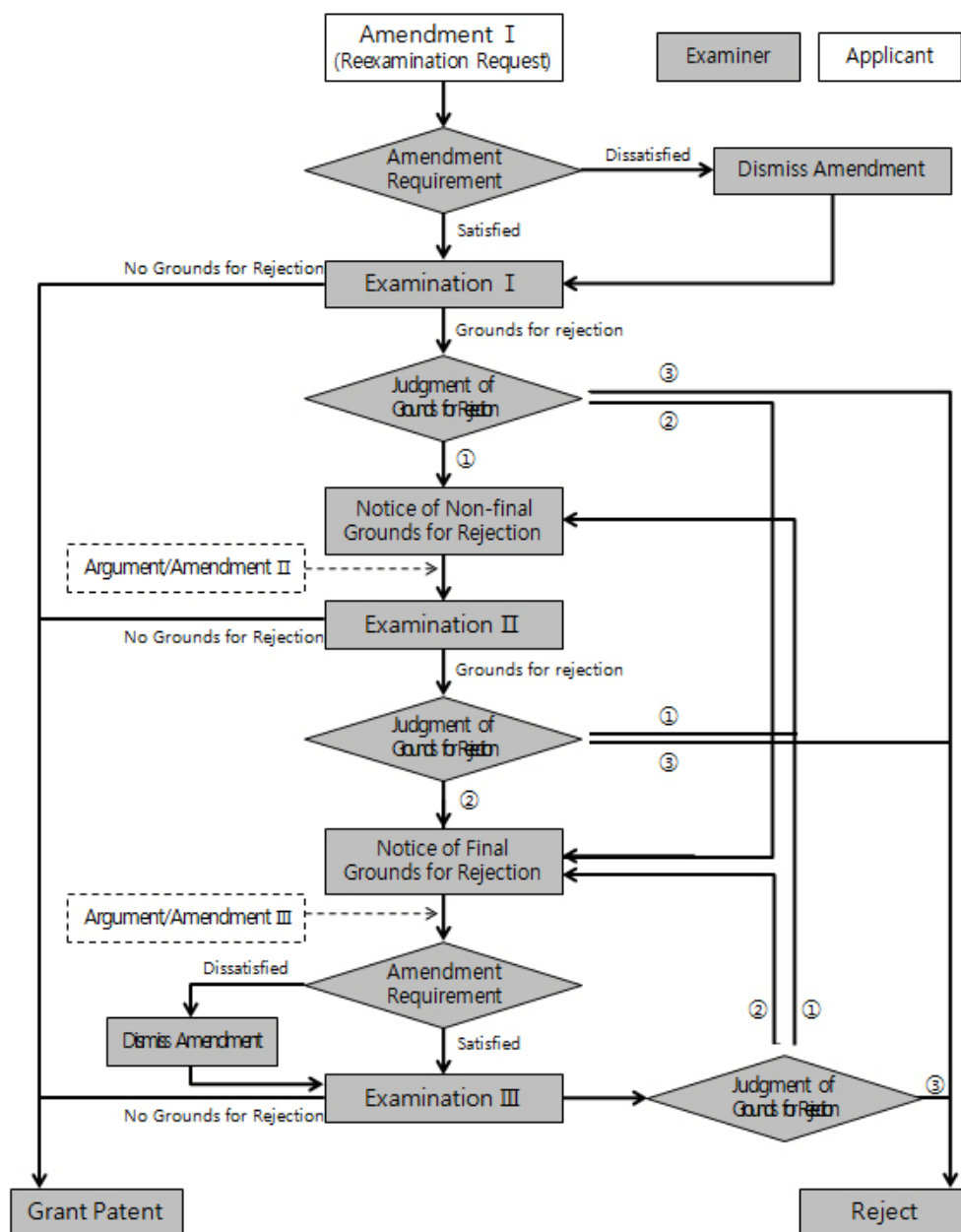
# Chapter 4. Reexamination

## 1. Overview

Within 30 days from the date of receiving a certified copy of the decision to reject a patent application (or within the extended period if the period for a trial against a decision to reject a patent application is extended), the applicant may amend the specification or drawing(s) to request reexamination of the application. The reexamination is introduced to reduce the patent fee burden and complexity in the previous system of reexamination before a trial.

## 2. Reexamination Procedure

### 2.1 Reexamination Procedure Flow Chart



- ① Grounds having been present before non-final notice but not mentioned
- ② Grounds incurring after the notice and not mentioned
- ③ Grounds mentioned in the previous notice



## 2.2 Examination of Formalities in Reexamination Request

(1) The reexamination shall be assigned to the examiner who had performed the original examination and had decided to reject an application. However, when the entrustment of reexamination to the original examiner is not appropriate as seen in the case of his/her transfer to other non-examination bureaus, an examiner in charge of the concerned technical classification of the claimed invention shall carry out the reexamination.

(2) Requirements for reexamination are as follows: an application ① has not been invalidated, withdrawn or abandoned, ② has rejected (rejection after reexamination excluded), ③ has not requested for a trial against decision to reject, and ④ declares the intention to request an reexamination with amendment of the description, drawing(s) or claims.

As the amendment herein includes not only substantial amendment to the description, drawing(s) or claims but also any amendment made in the specification.

(3) The request for a reexamination shall be made by the submission of the amendment. Therefore, the examination of formalities for reexamination request shall be made in accordance with the examination of amendment procedure. In other words, where the reexamination request is filed for an application which is not pending due to invalidation, withdrawal, or abandonment, where a person other than an applicant files an reexamination request by submitting the amendment, or where the amendment is submitted after the statutory period, the examiner shall provide an applicant with an opportunity for explanation and returns the written reexamination request.

Also, where an applicant request for a reexamination prior to the decision to reject a patent application, or request again for an additional reexamination after a rejection received from the first reexamination, an examiner shall return the written request for reexamination.

(4) An applicant shall not request reexamination for an application for which a trial against the decision of rejection has been requested. When requests for a reexamination and a trial against the decision of rejection are filed simultaneously, the following should be complied with.

① Where an applicant submits the amendment stating the purport for reexamination request following the submission of the request for a trial

The proviso of the Article 67bis stipulates that an applicant shall not request for reexamination where an appeal for a rejection decision have been already filed. And Regardless of whether the trial request is invalidated or withdrawn as of the amendment submission date, an examiner in this case shall provide an applicant with an opportunity for explanation pursuant to the Article 11(1) (XIX) of the Enforcement Rules of the Patent Act and shall return the written amendment to an applicant. When receiving the written amendment from an examiner, an applicant may amend by withdrawing an appeal against the rejection decision and file a reexamination request provided however that the prescribed period of the Article 67bis (1) shall not elapse.

② Where an applicant submits a request for a trial following the submission of the amendment containing the purport to request for reexamination.

As the request for examination by submitting the amendment is legitimate, an examiner shall regard the decision of rejection having been cancelled, and proceed with the reexamination.

③ Where an applicant submit a request for a trial and the amendment containing the purport for reexamination request, both of which are dated on the same day.

In case where the submission dates of a trial request and an amendment are not confirmed (i.e., it is not clear which of the two is made first), an examiner, considering the amendment as being submitted later than the request for a trial, shall notify the reason for returning an amendment. The notice of the reason for returning an amendment shall explain in detail that an applicant may choose between a request for reexamination and a trial against decision of rejection. Where an applicant withdraws an appeal against the decision of rejection (a request for a trial), an examiner in the view of a request for reexamination having been valid shall proceed to the reexamination procedure. When receiving a request for returning an amendment, an examiner shall return it without delay.

④ Where an applicant submit a request for a trial and an amendment without stating the purport to request for reexamination, both of which are dated on the same day.

Where an amendment does not state the purport to request for examination, it shall not be regarded as being validly submitted within the amendment period (Patent Act Articles 47, 67bis①). An examiner shall regard the amendment as document being submitted after the prescribed period in the Patent Act or Enforcement Decree of the Patent Act (the Enforcement Rules of the Patent Act Article 11) and return the amendment after giving an opportunity for petition.

### **2.3 Review of Amendment Appropriateness**

(1) In the case of reexamination request, the previous rejection is deemed to have been cancelled. Therefore, the examiner herein shall examine in the same manner as he/she have examined an application with the amendment before decision of rejection was made.

However, the request for reexamination deems to cancel only the previous decision of rejection, not the other previous procedure of the examination. In other words, a patent procedure prior to rejection decision and the examination procedure conducted by an examiner (notice of the non-final rejection ground, amendment, notice of final rejection ground, or amendment dismissal), shall remain valid during reexamination stage.

(2) In the case where the amendment is submitted in order to file a reexamination request, an examiner, before conducting reexamination, shall confirm specification be examined on a basis of his/her judgment of whether the amendment shall be dismissed or not.

Judgment to dismiss the amendment having been made upon the request for reexamination shall refer to the above-mentioned section of 「11.2 Requirements for Amendment」. 'An amendment according to the final notification of ground for rejection' reads to 'an amendment conducting upon request for reexamination request'.

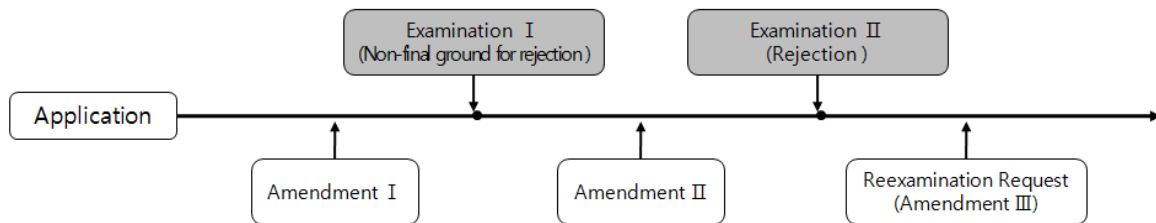
(Note) The scope of amendment upon the request for reexamination is the same as that of amendment according to the final notification of ground for rejection. For the scope of amendment, Part VI Chapter 2 in this Guideline shall be referred to.

(3) In the case of request for reexamination, even if the amendment having been conducted before the reexamination request is eligible to be dismissed but is disregarded, an examiner shall not dismiss the amendment retroactively by the foresaid reason (Patent Act Article 51① Proviso). It is designed to protect an applicant's confidence and interest in reexamination procedure which is based on the amendment made before decision of rejection, of an applicant.

(4) A decision as to whether the amendment is appropriately made or not is made as follows:

① Where a decision of rejection is made without amendment dismissal prior to request for reexamination

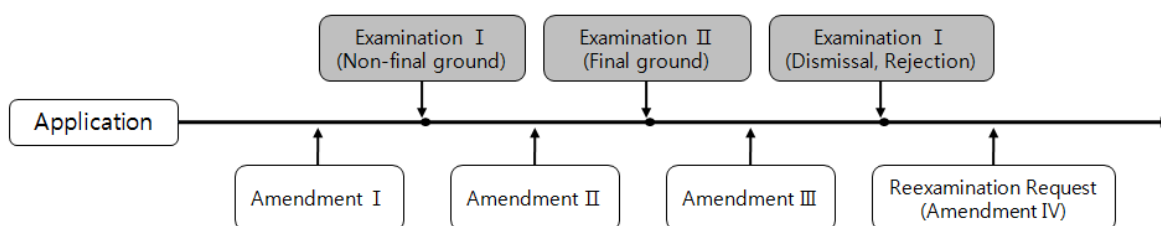
An examiner examines the specification reflecting the Amendment I and delivers the notice of first rejection ground. And after examining the specification reflecting Amendment II, an examiner discovers that the rejection ground is not amended and accordingly delivers the decision to reject a patent to an applicant. In response, an applicant submits the Amendment III as a procedure of reexamination request. Under this circumstance, (a) an addition to the scope of the matters pursuant to the Article 47(2) of the Patent Act shall be compared with the specification or drawing(s) originally attached to the written patent application, and (b) another requirement for the amendment pursuant to the Article 47 (3) shall be compared with the specification or drawing(s) having reflected the Amendment II.



② Decision of rejection after the amendment dismissal, but before the request for reexamination

During examining the specification reflecting the Amendment II, the examiner discovers another rejection reason incurring from the Amendment II and notify to the applicant the final rejection reason thereafter. And with the judgment that the Amendment III is not sufficient to cure the rejection reason, an examiner dismisses the Amendment III and examines the Amendment II. According to the examination, an examiner makes a judgment that the final ground for rejection is not amended and accordingly delivers a decision to reject a patent. In response, an applicant requests a reexamination with the submission of the Amendment IV. Under this circumstance, (a) an addition to the scope of the matters pursuant to the Article 47(2) of the Patent Act shall be compared with the specification or drawing(s) originally attached to the written patent application, and (b) another requirement for the amendment pursuant to the Article 47 (3) shall be compared with the specification or drawing(s) having reflected the Amendment II.

In other words, since the Amendment III has been already dismissed and the applicant shall not protest against the decision for amendment dismissal prior to a request for reexamination shall not be protested, the judgment of requirements for the amendment pursuant to the Article 47 (3) shall not consider the Amendment III.



**2.4 Examination after Admission of Amendment**

(1) Where the amendment is regarded as appropriate, the examiner shall admit and reflect the amendment to the specification to be examined. After confirming the specification, he/she shall decide whether there are the grounds for rejection or not, and its corresponding notification of the grounds for rejection, and make a decision to grant a patent or reject the application.

(2) Where the amendment upon the request for reexamination still fails to resolve the grounds for rejection, the examiner shall decide to reject the application.. If cured, he/she shall deliver a decision to grant a patent.

(3) Where an examiner considers the amendment overcomes the notified rejection grounds but discovers other rejection grounds that were not indicated, the examiner shall notify newly found grounds for rejection to the applicant. Types of grounds for rejection can be referred to 「5.3 Types of Grounds for Rejection」.

(Note) Where the examiner disregards a partial inappropriateness in the amendment upon the request for reexamination and delivers non-final and final notice of the grounds for rejection or the decision to grant a patent, the amendment shall not be dismissed retroactively even when the inappropriateness is discovered afterwards.

## **2.5 Examination after Dismissal of Amendment**

(1) After dismissing the amendment, an examiner shall immediately proceed with the pre-amendment original specification.

(2) Where the grounds for rejection noticed are not amended, an examiner shall deliver a rejection of a patent. However, if the review determines that the rejection decision is not proper and discovers no other rejection grounds, an examiner shall deliver a decision to grant a patent.

(3) Where the review discovers that the rejection decision is inappropriate and there arise other rejection grounds, an examiner shall again notify the grounds for rejection. Types of grounds for rejection can be referred to 「5.3 Types of Notice of Ground for Rejection」.

## **3. Instructions for Reexamination**

(1) Where the grounds for rejection having been notified previously are not overcome upon the reexamination request, those rejection ground shall not be regarded newly generated. Therein, an examiner shall admit the amendment but make a decision to reject a patent.

(2) Where the request for reexamination is filed, the decision to reject a patent application is regarded as cancelled. Therefore, an applicant shall not perform his/her act which can be done within thirty (30) days from the receipt of a certified copy of the decision to reject a patent application. In other words, an applicant shall not either file a trial against decision of rejection or a divisional application. However, an applicant may file a divisional application either upon the request for a reexamination or within the period for submitting a written argument in response to the notification of grounds for rejection during the reexamination stage.

(3) The Article 67bis (3) of the Patent Act stipulates that the request for a reexamination shall not be withdrawn. This is designed to prevent procedural confusion upon the withdrawal, since the rejection ground deems to have been cancelled when a reexamination request is filed. Where an applicant submits a request for withdrawal of the reexamination request, it shall be regarded as uncertain type of documents (the Enforcement Rules of the Patent Act Article 11). In this case, an examiner shall provide an applicant with an opportunity for explanation and return the written request for withdrawal.

(4) Where an applicant requests a reexamination in accordance with the Article 67bis (2) of the Patent Act, the decision to reject the patent application made prior to the request shall be deemed to have been cancelled. Therefore, where the amendment stating the purport for the reexamination request dated on the same day is submitted a multiple times, any amendment from the second submission shall not be deemed to be submitted within the prescribed period (Articles 47, 67 bis (1) of the Patent Act). Since an examiner regards the subsequent amendments following the first submission as documents submitted after the statutory period according to the Patent Act or the Enforcement Decree of the Patent Act (the Enforcement Rules of the Patent Act Article 11), he/she gives an opportunity for an explanation and returns the subsequent amendments.

## Chapter 5. Amendment *Ex officio*

### 1. Overview

In the past, when the specification had minor deficiency, the examiner should have notified the rejection grounds and have asked the applicant to amend the deficiency. However, as the number of the notification of the grounds for rejection due to an insignificant error or omissions had increased, it became a problem to procrastinate the examination procedure.

The amendment *ex officio* by the concerned examiner is therefore introduced to solve the aforementioned problems. When an examiner during the examination discovers only obvious errors such as misspells, omissions, or inconsistent reference signs, the examiner is allowed to amend *ex officio* the clearly erroneous matters instead of notifying the ground for rejection, which accordingly prevents the examination delays and makes the description of registration without deficiency.

However, the responsibility of the description generally lies in the applicant. In consideration of the Article 47 of the Patent Act, which strictly limits a person eligible for amendment, amendment period, and scope, the amendment *ex officio* shall be applied within the limited scope as a supplementary exception for the applicant's self amendment.

### 2. Matters to be Amended *Ex officio*

(1) 「Matters that are clearly erroneous」in the description, drawing(s), or abstract according to the Article 66bis of the Patent Act refers to the matters that do not fall under the grounds for rejection and do not influence the substantive scope of right in the patent application, provided however, that the matters shall have no possibility of arguments in the interpretation from the context, in the confirming of the claim scope, and in the working of the invention.

(2) Matters for amendment *ex officio* are misspelling or missing word according to standard Korean or its grammar, or inconsistent use of sign in drawing(s).

① Misspelled word in violation of Korean grammar

(a) Semiconductor → Semiconductor

(b) Boared → Board

② Missing word which is obvious in Korean grammar

(a) signal transmitted o line → signal transmitted to line

(b) linear o tor → linear motor

③ Inconsistence in reference numbering

(a) When explaining in detail, [Drawing 2] Buffer (115) vs. Drawing [D2] Buffer (15)

④ Redundant writing

(a) The patent office, the patent office is → The patent office is

⑤ Error in simple explanation of drawing

(a) Number of drawing misstated

D 1 is cross section of regenerator

D 1 is side view of regenerator → D 2 is side view of regenerator

D 3 is perspective view of regenerator

(b) Misspelled Reference signs in the drawing

3...Gear 3...Motor → 3...Gear 4...Motor

⑥ Misspelling in summary table

When the misspelling is obvious in the summary table according to the detailed explanation of the invention

⑦ Inconsistency in title between the description and the application

The examiner may amend *ex officio* the title of the invention stated in the description to correspond to that of the application. However, when the title stated in the application fails to satisfy the requirements for invention title under Section II, Chapter 000, the examiner may amend *ex officio* the inappropriate invention title to the one which is deemed to be proper (use the correction *ex officio* button on the web-site of Patent Net. Com), and amend *ex officio* the title of the description correspondingly.

### 3. Instructions of Amendment *Ex officio*

The matters to be amended *ex officio* are limited to self-evident error. When an examiner amends *ex officio*, he/she should not alter the scope of the claim, and the amendment *ex officio* shall not be allowed if there arises any possibility of different interpretation.

(1) Where the misstatement is regarded as the ground for rejection, no amendment *ex officio* is allowed. The rejection ground shall be notified.

(2) Where the description contains both the matters that are clearly erroneous, and the grounds for rejection, the examiner shall send the notice of ground for rejection where the matters to be amended *ex officio* are stated as reference and encourage the applicant to amend the error.

(3) The examiner shall not add new matters to the first description or drawing(s) by amendment *ex officio*. In particular, the examiner shall be careful not to include an unintended new technical subject-matter during amendment *ex officio* in drawings.

(4) The error of referring deleted claim cannot be amended *ex officio*. It falls under the grounds for rejection, and it is hard to tell which claim the applicant intends to refer. In this case, the examiner, instead of exercising the right of amendment *ex officio*, shall notify the ground for rejection and request the applicant to amend the deficiency in the description.

(5) For the use of 'the said' in the application without clear specification, the examiner shall not delete *ex officio* unless there is no possible arguments in interpretation according to the clear causation in the statement.

#### 4. Procedure of Amendment *Ex officio*

(1) The examiner intending to amend *ex officio* shall notify the matters to be amended to the applicant with a certified copy of the decision to patentability.

Where the matters are recognized for amendment *ex officio*, the examiner shall describe in definite and specific manners that which matters are to be amended *ex officio* in the written decision to grant a patent. The examiner shall state the reason why the matter is to be amended *ex officio* in order to help the applicant to decide to accept the amendment or not.

(Example of Notice)

1. Second line of <20> in the description; "...signal ... transmitted ..."; "...signal ... transmitted to..."; definite omission
2. 3rd line of the Claim (3); "...Semiconductor Memory"; "...Semiconductor Memory"; definite misspelling

Also, when the examiner describes where to amend *ex officio*, he/she shall stipulate specifically using ID number or relevant line in the page, so that the applicant may not confuse to determine to accept the amendment *ex officio*.

(2) When the applicant opposes to accept the amendment *ex officio* in whole or part, he/she shall submit the written statement of argument before the payment of patent fee, whereby the examiner may make selective decision for the amendment *ex officio*.

Where the applicant submits the written statement of argument regarding the amendment *ex officio*, the concerned matter under the amendment *ex officio* shall be deemed never to have existed. The description is digitized and published in the patent gazette except for the matter that the applicant rejects to accept the amendment *ex officio*.

(Note) Where the examiner amends the matter which does not fall under the category of the amendment *ex officio* and the applicant also overlooking such an illegitimate amendment by the examiner publishes the description in the patent gazette, the concerned matter having amended *ex officio* shall be deemed never to have existed unless the amendment is recognized as legitimate afterward. This is designed to prevent unexpected losses in patentees or the 3rd parties due to an illegitimate amendment by the examiner.