Patents, trade marks, copyright and designs in South Korea: overview

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PATENTS

1. What are the legal requirements to obtain a patent?

To be patentable, an invention must have:

- Industrial applicability.
- Novelty.
- Inventive step.

2. What categories are excluded from patent protection?

Categories which are excluded from patent protection are:

- Ideas not utilising the laws of nature.
- Inventions which violate public order or sound morals or which are likely to harm public health

3. Which authority registers patents? Does its website provide guidance on the application procedure?

Patents are registered by the Korean Intellectual Property Office (KIPO).

Guidance on the application procedure, can be found at www.kipo.go.kr/kpo/user.tdf?a=user.english.html.HtmlApp&c=30101&catmenu=ek03_02_01

4. On what grounds and when can third parties oppose a patent application?

Before registration, any person can provide KIPO with information that a patent application is ineligible for registration.

After registration, an interested party or examiner can file a petition for trial to seek invalidation of a patent.

The grounds under which a third party can file an information brief or an opposition with respect to a pending patent application or challenge an issued patent are that it lacks the legal elements required for patentability or other procedural requirements for patent registration.

5. When does patent protection start and how long does it last?

The term of a patent right commences at the time of its registration and ends 20 years after the application filing date. If a separate permission or registration is required pursuant to the relevant industry laws or regulations to work the patented invention, the term can be extended for up to five years.

6. On what grounds can a patent infringement action be brought?

A patent infringement action can be brought on the following grounds:

- Direct infringement:
  - making, assigning, leasing, importing, or offering for assignment or lease a patented product without consent;
  - using a patented process or the act of making, assigning, leasing, importing, or offering for assignment or lease a product which is made by the process without consent;

- Indirect infringement:
  - making, assigning, leasing, importing, or offering for assignment or lease any article used exclusively for producing a patented product;
  - making, assigning, leasing, importing or offering for assignment or lease an article used exclusively for working a patented process.

7. Which courts deal with patent infringement actions?

The first instance courts which deal with patent infringement actions are designated District Courts (for example, Seoul Central District Court, Daejeon District Court, Daegu District Court, Busan District Court and Gwangju District Court).

The second instance court is the Patent Court and the third instance is the Supreme Court.

8. What are the defences to patent infringement actions?

Defences to patent infringement actions include

- Non-infringement.
- Invalidation (defence of abuse of patent right).
9. What are the remedies in patent infringement actions?

Remedies which are available for patent infringement are:
- Preliminary injunction.
- Permanent injunction.
- Compensatory damages.
- Reinstatement of reputation of patentee.

10. Is there a fast-track and/or a small-claims procedure for patent infringement actions?

There is no fast-track and/or a small-claims procedure for patent infringement actions.

TRADE MARKS

11. What are the legal requirements to obtain a trade mark?

Any person or legal entity who uses or intends to use a trade mark in South Korea can obtain registration of the mark. For registration, the trade mark must have a distinctive feature that enables traders and consumers to distinguish the goods or services from another's goods or services.

12. Is it necessary or advisable to register trade marks?

South Korea is a first-to-file jurisdiction, and a registered trademark is presumed to be valid and serves as constructive notice of the registrant's claim of ownership of the mark. For this reason, it is highly recommended that trademark owners register their marks.

While the owner of an unregistered, well-known mark can have an actionable claim against an infringer under the Unfair Competition Prevention and Trade Secret Protection Act, the outcome in an unfair competition action is highly fact-specific and may not offer the owner of the mark an adequate remedy.

13. Which authority registers trade marks? Does its website provide guidance on the application procedure?

The registration authority for trade marks is the Korean Intellectual Property Office (KIPO). Guidance on the application procedure can be found at www.kipo.go.kr/kpo/user.tdf?a=user.english.html.HtmlApp&c=30103&catmenu=ek04_02_01

14. On what grounds can the regulatory authority refuse to register a trade mark?

The following marks are ineligible for trademark registration and will be refused registration:
- Generic terms.
- Mark customarily used on the goods or describing the features of goods.
- Conspicuous geographical term.
- Common surname or other name.
- Simple and commonplace sign.
- Marks lacking distinctiveness (marks which are identical or similar to the registered trademark of another person).

15. On what grounds and when can third parties oppose a trade mark application?

On publication of the trademark application, any person can file a formal objection with Korean Intellectual Property Office (KIPO) within two months of the date of publication. An interested party or examiner can file a petition for trial to seek invalidation or cancellation of a registered trademark.

The grounds for objection to a published mark or seeking cancellation of a registered mark can be based on the ineligibility of the mark for registration.

A trademark which has not been in use for at least three consecutive years can be subject to cancellation.

16. When does trade mark protection start and how long does it last?

The term of trademark protection is ten years from the registration, which is renewable every ten years.

17. On what grounds can a trade mark infringement action be brought?

The grounds on which a trade mark infringement action can be brought are:
- Using a trademark identical or similar to a registered trademark of another person on goods or services that are identical or similar to the designated goods.
- Delivering, selling, forging, imitating, or possessing a trademark identical or similar to a registered trademark of another person for the purpose of using or causing a third party to use such trademark on goods identical or similar to the designated goods.
- Manufacturing, delivering, selling or possessing equipment for the purpose of forging or imitating a registered trademark of another person or causing a third party to forge or imitate such registered trademark.
- Possessing goods identical or similar to the designated goods bearing a registered trademark of another person or any other similar trademark for the purpose of transferring or delivering such goods.

18. Which courts deal with trade mark infringement actions?

See Question 7. The same courts are used for trade mark infringement actions.
19. What are the defences to trade mark infringement actions?

Defences include that:
- The mark is not being used as a trade mark by the defendant.
- The mark is the defendant’s name.
- The mark lacks distinctiveness as a mark and thus should be invalidated.
- Prior use by the defendant.

20. What are the remedies in trade mark infringement actions?

Remedies include:
- Preliminary injunction.
- Permanent injunction.
- Compensatory damages.
- Reinstatement of the reputation of the trademark owner.

21. Is there a fast-track and/or a small-claims procedure for trade mark infringement actions?

There is no fast-track and/or a small-claims procedure for trade mark infringement actions.

COPYRIGHT

22. What are the legal requirements to obtain copyright protection?

To be granted copyright protection, the work must be a creative work which expresses human thoughts and emotions. Registration is not required to be gain protection.

23. Can copyright be registered?

Registration is available but is not required. However, statutory damages for infringement are available only to registered copyrights.

24. When does copyright protection start and how long does it last?

Copyright starts when the work is created. An individual author’s economic rights in a copyrighted work subsist during the life of the author and for 70 years after the author’s death. (In the case of joint owners, copyright continues until 70 years after the death of the later deceased author.) Copyright in a work-made-for-hire subsists for 70 years after publication or for 70 years after creation if the work is not published within 50 years of creation.

25. On what grounds can a copyright infringement action be brought?

A copyright infringement action can be based on the following grounds:
- Infringement of economic rights in the work: The right to reproduce, publicly perform, publicly transmit, distribute, lease and to make derivative works.
- Infringement of moral rights: The right to publish, attribute authorship, and to keep integrity of the work.
- Infringement of neighbouring rights which are granted to performers, phonogram producers and broadcasters.

26. Which courts deal with copyright infringement actions?

The courts deal with copyright infringement actions are as follows:
- First instance: District Courts (not limited to the five designated district courts listed in Questions 7, 18 and 35).
- Second instance: High Courts.
- Third instance: The Supreme Court.

27. What are the defences to copyright infringement actions?

Defences include:
- The allegedly infringed work is not a copyright work.
- Use constitutes one of the uses explicitly enumerated under the Copyright Act as being exempt from copyright infringement including:
  - reproduction for judicial proceedings;
  - use of political speech;
  - use of public works;
  - use of school education purposes;
  - use for current news reporting;
  - public performance and broadcasting for non-profit purposes;
  - reproduction for private use;
  - reproduction in libraries, for the visually handicapped or the hearing impaired, temporary reproduction in the course of using the work.
- Fair Use.

28. What are the remedies in copyright infringement actions?

Remedies include:
- Preliminary injunction
- Permanent injunction
- Compensatory damages
- Destruction of infringing goods or implementation of other measures necessary to prevent further infringement
- Reinstatement of the rights holder’s reputation.

29. Is there a fast-track and/or a small-claims procedure for copyright infringement actions?

There is no fast-track and/or a small-claims procedure for copyright infringement actions.
REGISTERED DESIGNS

30. What are the legal conditions to obtain a registered design right?

To obtain a registered design right, the design must possess:
- A shape, pattern, colour (or any combination of these) and font, each of which must be visually aesthetic.
- Novelty.
- Creativity.
- Industrial applicability.

31. Which authority registers designs? Does its website provide guidance on the application procedure?

The Korean Intellectual Property Office (KIPO) is the registration authority. For guidance on the application procedure, see www.kipo.go.kr/kpo/user.tdf?a=user.english.html.HtmlApp&c=93002&catmenu=ek04_02_02

32. On what grounds and when can third parties oppose a registered design application?

Before registration, any person can provide the KIPO with information that a design application is ineligible for registration.

After registration, an interested party or examiner can file a petition for trial to seek invalidation of the registration.

The grounds for provision of information or invalidation are the lack of the legal elements of a design (see Question 30 for where guidance is found or failure to meet procedural requirements for a design registration.

33. When does registered design protection start and how long does it last?

The term of a design right starts at the time of its registration and ends 20 years after the application date.

34. On what grounds can a registered design infringement action be brought?

A registered design infringement action can be brought for:
- Direct infringement: making, assigning, leasing, importing, or offering for assignment or lease of a product associated with a registered design or any similar design.
- Indirect infringement: making, assigning, leasing, importing, or offering for assignment or lease of articles used exclusively for producing a product associated with a registered design or any similar design.

35. Which courts deal with registered design infringement actions?

See Question 7. The same courts are used for design infringement actions.

36. What are the defences to registered design infringement actions?

Defences include:
- Non-infringement.
- Invalidation (defence of an abuse of right).
- Non-commercial use.
- Prior use.

37. What are the remedies in registered design infringement actions?

Remedies for design infringement include:
- Preliminary injunction.
- Permanent injunction.
- Compensatory damages.
- Reinstatement of reputation of rights holder.

38. Is there a fast-track and/or a small-claims procedure for registered design infringement actions?

There is no fast-track and/or a small-claims procedure for registered design infringement actions.

UNREGISTERED DESIGNS

39. What are the legal conditions for unregistered design rights to arise?

Unregistered design rights can be protected under the Protection of Unfair Competition Prevention and Trade Secret Protection Act (Unfair Competition Act), if the infringing act falls under is one of the prohibited acts described in Question 41.

40. When does unregistered design protection start and how long does it last?

Protection for unregistered designs lasts for three years following the manufacture or production of a prototype bearing the design where goods whose shape has been copied are assigned, lent, exhibited, imported or exported (see Question 40). There is no term limit for the infringing acts of unauthorised use of a design or use as a trade mark (see Question 40).

41. On what grounds can an unregistered design infringement action be brought?

The following acts are prohibited under the Unfair Competition Act:
- Assigning, lending, exhibiting, importing or exporting goods whose shape has been copied.
- Unauthorised use of another's design which has been created with substantial effort and investment.

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42. What are the defences to unregistered design infringement actions?

Defences include:
- Elapse of protection period (see Question 39).
- Common shape of the relevant goods.

43. What are the remedies in unregistered design infringement actions?

Remedies for unregistered design infringement include:
- Preliminary injunction.
- Permanent injunction.
- Compensatory damages.
- Reinstatement of the reputation of right holder.

44. What are the legal conditions for rights in confidential information to arise?

Confidential information must:
- Be unknown to the public.
- Be the subject of reasonable efforts to maintain secret.
- Have independent economic value.

45. On what grounds can an action for unauthorised use of confidential information be brought?

An action for unauthorised use of confidential information can be brought for any of the following acts:
- Acquiring trade secrets by improper means.
- Acquiring, using or disclosing trade secrets improperly, intentionally or due to gross negligence.
- Using or disclosing a trade secret knowing it was acquired improperly or being grossly negligent in not knowing.
- Using or disclosing a trade secret to obtain improper benefits or to damage the owner of the trade secret in breach of a duty to maintain secrecy.
- Acquiring using or disclosing trade secrets knowing that they have been disclosed in breach of a contractual duty or being grossly negligent in not knowing this was so.
- Using or disclosing trade secrets after acquiring them, knowing they have been disclosed in breach of a contractual duty or being grossly negligent in not knowing this was so.

46. Which courts deal with actions for unauthorised use of confidential information?

See Question 25. The same courts are used for actions for unauthorised use of confidential information.

47. What are the defences to actions for unauthorised use of confidential information?

Defences include that the:
- Information became public after disclosure by the disclosing party.
- Information was independently developed by the recipient without referencing the disclosing party’s information.
- Information was provided to a third party pursuant to a court order.
- Required legal elements to constitute a trade secret are not present.

48. What are the remedies in actions for unauthorised use of confidential information?

Remedies include:
- Preliminary injunction.
- Permanent injunction.
- Compensatory damages.
- Reinstatement of the right holder’s reputation.

49. Is there a fast-track and/or a small-claims procedure for actions for unauthorised use of confidential information?

There is no fast-track and/or a small-claims procedure for actions for unauthorised use of confidential information.

THE REGULATORY AUTHORITIES

Korean Intellectual Property Office (KIPO).

Main areas of responsibility, Government agency responsible for handling intellectual property (IP) related issues in Korea.

Guidance on application procedure.

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