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NEWSLETTER

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Recent IP Developments in Korea – 2025. 08

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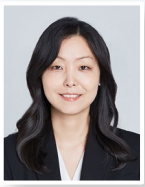

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Supreme Court Decision on Practicing Pharmaceutical and Biotechnology Patent Inventions for Research or Testing Purpose

A new Supreme Court decision (2025Da202970; rendered on May 15, 2025) set clear criteria for applying research and testing exceptions in the pharmaceutical and biological sectors.

Article 96(1)(i) of the Korean Patent Act stipulates that the effects of the Patent Act shall not extend to "practice of a patent for the purpose of research or testing (including research and testing for obtaining approval for items of medicines or reporting items of medicines under the 「Pharmaceutical Affairs Act」 or for registering pesticides under the 「Pesticide Control Act」)".

The Korean patent at issue in the decision pertains to a conjugate vaccine composition consisting of 13 types of pneumococcal serotypes. A Korean company produced a finished 13-valent pneumococcal conjugate vaccine product corresponding to the subject patent in Korea and exported it to a foreign pharmaceutical company. The foreign pharmaceutical company that received the finished vaccine product from the Korean company used it solely for non-clinical and clinical trials to obtain product approval in its country and for analytical testing to verify that the manufacturing technology for the finished vaccine was properly transferred from the Korean company. Given this scenario, the issue became whether the Korean company's production of the finished 13-valent pneumococcal conjugate vaccine product in Korea constituted the practice of a Korean patent for research or testing purposes.

In essence, this case raises three salient points of interest:

- The subject of the research and testing is a foreign pharmaceutical company, but the subject practicing the patent is a Korean company. Can the above provision be applied even when the relevant subjects differ?

- Does the research and testing stated in the above provision refer to research and testing conducted within Korea? Can the above provision not be applied when the product is manufactured for product approval in a foreign country?
- The purpose of non-clinical or clinical trials conducted abroad is to obtain product approval in a foreign country and ultimately obtain commercial benefits. Can the above provision be applied even in such cases?

In response, the Intellectual Property High Court (IP High Court) ruled that:

- The literal description of the above provision does not impose a limitation requiring that the subject of research and testing and the subject practicing the invention be the same, and, even if an exception for research and testing purposes is recognized when the subjects differ, no unreasonable consequences, such as unduly restriction of the patentee's interests, would occur.
- The literal description of the above provision does not require that the research and testing be conducted in Korea.
- The provision further does not divide the scope of its application based on the purpose of research and testing, and there is no other basis to conclude that a commercial purpose should be excluded.

Therefore, the IP High Court determined that the above provision applies in all three cases of (i), (ii), and (iii) (2023Na10914; rendered on December 3, 2024). Thereafter, the Supreme Court's decision confirmed that the IP High Court's judgment was valid.

In other words, according to the Supreme Court's decision, it was clarified that the above provision can be applied regardless of the subject, location, and purpose of the research and testing. Consequently, it is expected that in the future the application of this exception will become easier in cases involving contract manufacturing organizations (CMOs), thereby broadening the scope of CMO utilization.

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The Benefits of Filing a Korean National Trademark Application Rather Than Using the Madrid System

Although the Madrid System offers a wide range of undeniable advantages to overseas trademark filing, Korean National Trademark Applications provide distinct benefits that should not be overlooked. Expedited examinations and the option to apply for additional registrations of designated goods, for example, are advantageous procedures only possible with Korean National Trademark Applications.

1. The Expedited Examination System

The Korean Intellectual Property Office (KIPO) is currently facing a significant examination backlog. On average, it takes 18 months for a substantive examination to be initiated after filing, and, even if no grounds for rejection are found, the entire registration process including publication stages, etc., takes at least 21-22 months.

To address this problem, the KIPO operates an expedited examination system, which enables prompt acquisition of trademark rights when brand protection, infringement response, business scheduling coordination, etc., are required. Decisions regarding whether to proceed with expedited examination are rendered within 2 to 4 weeks on average, and if permitted, examination results are provided in about 45 days on average.

However, Article 12 of the Enforcement Decree of the Trademark Act requires one of the following qualification requirements:

- Where a trademark is being used or ready to be used for all designated goods
- Where a written warning has been received from another trademark applicant based on the previously applied trademark
- Where an objection is raised by another trademark holder
- Where a written warning is sent to another person based on the pending trademark application

- Where the relevant application is the basis for applying for an international registration under the Madrid system
- Where an application is filed for a collective mark of a corporation jointly established by small and medium enterprises
- Where the application is the basis for claiming priority under the Paris Convention
- Where a reapplication is filed for the same mark and goods after the original trademark registration for the same mark has lapsed due to expiration of the term without renewal

The most common involves cases "where a trademark is being used or ready to be used for all designated goods." Since strict proof is not required, materials such as product photos, catalogs, websites, product/service plans, and product package designs are sufficient for submission. However, at least one product from each relevant product category must be supported with evidence. For example, toys and fitness equipment, although both fall under Class 28, belong to different categories. Accordingly, proof of use must be submitted for at least one product in the toys category and one product in the fitness equipment category. If sufficient proof of use is not provided, the examiner may either request supplementary evidence or delete the goods and services lacking proof of use from the application.

A request for expedited examination may be filed either at the time of application or at any point before the examination commences. However, there will be additional attorney's fees and official fees to file a request for expedited examination.

2. Application for Additional Registration of Designated Goods

If the applicant already holds a local trademark registration in South Korea and wishes to expand its trademark rights into new goods and services, it is recommended to file an application for additional registration of designated goods.

An application for registration of additional designated goods is subject to the same procedure as a new application. However, once the registration is granted, it is managed as one trademark registration under a single registration number in conjunction with the existing trademark rights. Therefore, the additional goods are treated as part of the existing single trademark registration, and procedures like renewal, assignment, or changes to the registrant's name/address are handled collectively under a single trademark registration number, simplifying management.

When you use the application for the additional registration of designated goods, you can efficiently manage local trademarks that are already registered in South Korea in your portfolio.

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Extension of Time to File a Response and Deferred Examination for Divisional Applications

With the partial amendment of the Enforcement Rules of the Patent Act and the Utility Model Act, (i) the time for filing a response to a non-final office action has been extended from the previous two months to four months, and (ii) deferred examination for divisional applications is now permitted. These amendments have come into effect as of Friday, July 11, 2025.

1. Extension of Time to File a Response (from two months to four months)

In Korea, the time for filing a response to a non-final office action has been relatively short compared to major foreign countries. As a result, applicants who were unable to prepare a response within the given time had to file monthly requests for extension and pay additional fees. To address this issue, the time for filing a response has been extended from the previous two months to four months, aligning it with the standards in other major jurisdictions. For reference, the time for filing a response is currently three months in the United States and Japan, and four months in China and Europe.

With this amendment, applicants can now save on the fees associated with extension requests. However, unless a separate request is filed, examiners will examine responses and amendments only after the deadline has passed, which may result in a delay in the granting of rights compared to before. For applicants seeking a faster grant of rights, filing a request for shortened examination together with a response will allow for faster examination results.

2. Permission for Deferred Examination for Divisional Applications

In advanced technology fields, such as telecommunications, pharmaceuticals, and biotechnology, commercialization often requires a significant amount of time. As a result, an increasing number of applicants have been strategically seeking delayed

examination. Under the previous system, however, requests for deferred examination were not permitted for divisional applications, making it difficult to accommodate such needs.

To address this issue, the recent amendment now permits deferred examination for divisional applications. This change is expected to enable applicants filing divisional applications to establish patent registration strategies that align with their product commercialization timelines.

Specifically, applicants wishing to defer examination may designate a desired examination date within the permissible deferral period—i.e., between two years from the date of the request for examination to five years from the filing date. The request for deferred examination must be filed within nine months from the date of the request for examination. Within two months of filing the deferral request, applicants may either withdraw the deferral request or change the desired deferral date. In addition, applicants may switch to accelerated examination at any time by filing a request for expedited examination. Subsequently, the examination results will be provided within 12 months from the applicant's designated deferral date.

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Advancing Improvements to the Patent Invalidation Trial System

The Intellectual Property Trial and Appeal Board ("IPTAB") recently announced its plans to pursue reforms to the patent invalidation trial system, aiming at reinforcing the reliability and stability of patents, which are the core assets for enterprises. This initiative aligns with the strategic vision of 'fostering and utilizing premium patents,' with a focus on refining patent invalidation trial procedures to enhance predictability and substantially guarantee the patent holder's opportunity to defend.

1. Strengthening Patent Holder Protection: Pursuing a 'Pre-Notice System for Decisions on Patent Invalidation'

A patent invalidation trial is a critical procedure that challenges the validity of a granted patent. Under the current system, there have been instances where a patent was unexpectedly invalidated by the final judgment of the trial board, despite the patent holder's utmost efforts to defend their rights throughout the entire trial process. In particular, invalidating an entire patent due to minor defects that could have been remedied through amendments is considered excessively harsh.

To address these issues and protect the legitimate rights of patent holders, the IPTAB pursues the introduction of a "Pre-Notice System for Decisions on Patent Invalidation." In essence, when the trial board reaches a preliminary conclusion after the hearing that patent invalidation is justified, rather than issuing that decision immediately, as happens under the current system, the patent holder will instead be notified.

Upon receiving a "Pre-Notice for Decisions on Patent Invalidation," a patent holder will then be granted one final opportunity to file a 'request for correction' to remedy defects in their patent specification or drawings before a final trial decision is rendered. Currently, a request for correction can only be filed within the timeframe allotted for submitting responses. However, going

forward, by reviewing the tribunal panel's preliminary judgment and making appropriate corrections accordingly, patent holders will have a final opportunity to reduce the risk of invalidation and secure a valid scope of rights.

As introducing this system requires an amendment to the Patent Act, implementation is only expected after further future discussion. By ensuring sufficient opportunities for defense, it's anticipated that patent holders will be able to not only reduce the risk of losing their rights due to unforeseen trial decisions but also manage their patent portfolios more securely and establish business plans more reliably.

2. Enhancing the Efficiency and Fairness of Trials: Pursuing Improvements to Hearing Procedures

Alongside strengthening patent holder protection, improvements to hearing procedures are being pursued to enhance the efficiency and fairness of the invalidation trial procedure itself. The objective is to prevent unnecessary prolongation of disputes and clarify the trial issues at an early stage, thereby enabling all parties to obtain predictable trial outcomes.

The IPTAB has outlined the following key areas for improvement:

First, the burden of argument and proof on the petitioner in invalidation trials will be strengthened. The IPTAB has announced its intention to discourage vague arguments regarding grounds for invalidation and conduct hearings requiring more concrete and clear evidence. This measure is expected to prevent the indiscriminate filing of invalidation trials that lack a sufficient basis and relieve patent holders from bearing unnecessary defensive burdens.

Second, the "Principle of Timely Submission," which requires strict adherence to deadlines for submitting evidence and related materials, will be emphasized. This aims to prevent delays in the proceedings caused by the late submission of new assertions or evidence in the trial proceedings. Consequently, it will become critically important for both parties, both those requesting an invalidation trial and those defending against it, to thoroughly prepare all assertions and evidence from an early stage and submit them within the prescribed timeframe.

Third, oral hearings will be conducted more efficiently, and the claim construction process will be strengthened. Oral hearings will be conducted by clarifying issues in advance, which will allow both parties to concentrate their arguments and evidence on substantive issues. Additionally, the board will recommend that parties submit their opinions on claim interpretation when filing a request for an invalidation trial, and, if there are disagreements or ambiguities regarding claim interpretation, parties will be given opportunities to provide supplementary opinions and evidence to resolve these disputes. This is expected to resolve disputes related to 'claim interpretation' at an early stage and enhance the clarity of the hearings.

These improvements to the hearing procedure will enhance the transparency and predictability of the entire invalidation trial process. Parties involved in patent disputes will be able to identify key issues and develop response strategies at an earlier stage, thereby reducing time and costs, and are expected to benefit from fairer and faster trial outcomes.