**Republic of Korea**

**(i) A draft reference documents on the exception regarding extemporaneous preparation of medicines**

○ **National/regional laws**

**- The Korean Patent Act**

Article 96 (Limitations on Effects of Patents) ② The effects of a patent on the invention of a medicine manufactured by mixing at least two medicines (referring to products used for the diagnosis, relief, treatment, therapy, or prevention of human diseases; hereinafter the same shall apply) or on the invention of a process for manufacturing medicines by mixing at least two medicines shall not extend to the preparation of prescriptions and medicines prepared according to such prescriptions under the Pharmaceutical Affairs Act.

○ **Court case**

(1) Patent Court Decision 2002Heo3962 Decided May 21, 2004

- Summary of Decision: "An invention of manufacturing a single medicine by combining two or more medicines“ is subject to ‘exceptions to patent rights conferred’ under the Patent Act. Essentially it is a medical practice to manufacture a single medicine by combing two or more medicines as above. So the legislation is intended, for the public welfare, to prevent any person from having an exclusive right when it comes to a medical personnel’s preparation, and thereby not to harm the freedom of a pharmacist’s preparation in accordance with a doctor’s or a dentist’s prescription or of a doctor’s treatment in accordance with a patient’s condition.

**(ii) A study on various aspects of the unity of invention, including divisional application**

○ **National/regional laws**

**- The Korean Patent Act**

Article 45 (Scope of Single Patent Application) ① A patent application shall be filed for each invention: Provided, That a patent application may be filed for a group of inventions linked so

as to form a single general inventive concept.

② The requirements for filing a patent application for a group of inventions under the proviso of paragraph (1) shall be prescribed by Presidential Decree.

Article 6 (Requirements for Single Patent Application for Group of Inventions) A single patent application for a group of inventions as prescribed in the proviso of Article 45 (1) of the Act shall meet the following requirements:

1. The inventions described in the application shall be technologically correlated;

2. The inventions described in the application shall have the same or corresponding technological features. In such case, the technological features shall be those improved than the prior art in light of the invention at large.

Article 52 (Divisional Patent Applications) ① An applicant who has filed a single patent application for two or more inventions may divide the application into two or more applications within the scope of the features described in the specification or drawings accompanying the initial patent application, within either of the following periods: Provided, That if such patent application has been filed in a foreign language, it may be divided only where the patent application has been accompanied by the Korean translation required under Article 42-3 (2):

1. A period during which amendments can be made under Article 47 (1);

2. A period not exceeding three months from the date a certified copy of the ruling to reject the claim of a patent is served (referring to an extension, if the period specified in Article 132-17 has been extended under Article 15 (1));

3. A period of not more than three months from the date when the certified copy of a decision to grant a patent under Article 66 or the certified copy of a trial decision to revoke the decision to reject a patent application under Article 176 (1) (limited to a trial decision made to register a patent but including a trial decision on retrial) is served: Provided, That the period shall end on the day when it is intended to have the grant of a patent registered under Article 79, if the period up to such day is less than three months.

② A patent application divided under paragraph (1) (hereinafter referred to as "divisional application") shall be deemed filed at the time the initial patent application was filed: Provided, That a divisional application shall be deemed filed at the time the divisional application is filed in any of the following cases:

1. Where the divisional application constitutes a separate patent application referred to in Article 29 (3) of this Act or a patent application referred to in Article 4 (4) of the Utility Model Act, and Article 29 (3) of this Act or Article 4 (4) of the Utility Model Act shall apply to the divisional application;

2. Where Article 30 (2) applies to the converted application;

3. Where Article 54 (3) applies to the converted application;

4. Where Article 55 (2) applies to the converted application.

③ A person who intends to file a divisional application under paragraph (1) shall state his or her intention and indicate the patent application to be divided in the divisional patent applications.

④ If a patent application to be divided is a patent application claiming priority under Article 54 or 55, the priority shall be also claimed with regard to the divisional application at the time the divisional application is filed under paragraph (1); and if any document or written statement submitted under Article 54 (4) with respect to the patent application to be divided exists, the relevant document or written statement shall be deemed to have been submitted.

⑤ As for a divisional application deemed to claim priority under paragraph (4), all or part of the priority claim may be withdrawn within 30 days from the filing date of the divisional application, even after expiration of the period specified in Article 54 (7) or 55 (7).

⑥ A person who claims priority under Article 54 for a divisional application may submit the documents specified in paragraph (4) of the same Article to the Commissioner of the Korean Intellectual Property Office within three months from the filing date of the divisional application, even after expiration of the period specified in paragraph (5) of the same Article.

⑦ If a divisional application is filed in a foreign language, the patent applicant can submit the application translated in Korean under Article 42-3 (2) or another Korean translation under the main clause of Article 42-3 (3) not later than 30 days from the filing date of the divisional application, even after expiration of the period specified in paragraph (2) of the same Article: Provided, That another Korean translation is not allowed in cases falling under any subparagraph of Article 42-3 (3).

⑧ With respect to divisional applications filed without stating the claims in the specification accompanying the initial patent application, the patent applicant may make an amendment stating the claims in the specification not later than 30 days from the filing date of the divisional application, even after expiration of the period specified in Article 42-2 (2).

○ **Patent Examination Guidelines (March 2023)**

(1) Purpose of the System

- The provision of Article 45 of the Patent Act on scope of one patent application intends to promote the convenience for applicants, third parties and the Korean Intellectual Property Office by allowing applicants to file a single application on inventions closely related in terms of technology. For applicants, it would be beneficial if it is possible to file as many inventions as possible in one patent application in light of lower patent fees and patent right management. However, as for third parties, it would be beneficial if a patent application includes less inventions as possible in light of the fairness of proceedings, observation on patent rights and use of applications as prior art. Meanwhile, the Korean Intellectual Property Office would prefer the narrower scope of one patent application in examination processes such as assigning patent classification and prior art search. Therefore, this provision can be considered to have been introduced to make a balance on the interests of applicants who prefer including more inventions in one application as well as third parties and the Korean Intellectual Property Office who would get disadvantaged if filing multiple inventions in one application is allowed.

(2) General Consideration

- Whether inventions correspond to「a group of inventions linked so as to form a single general inventive concept(hereinafter referred to as 'unity of invention')」under Article 45(1) of the Patent Act shall be determined based on whether the inventions recited in each claim share one or more same or corresponding special technical features and thus have technical correlation as prescribed in Article 6 of the Enforcement Decree of the same act.

「The special technical features」 refer to the improved features in each invention as a whole when compared with prior arts. In this context, special technical features of the inventions do not need exactly the same. For example, if the special technical feature for providing elasticity in one claim is a spring, the special technical features for providing elasticity in another claim can be a rubber block.

-「The special technical features」are the concept specially suggested to determine the unity of inventions and shall involve novelty and inventive step compared to prior arts disclosed before the concerned patent application is filed. The unity of invention shall be determined after considering the invention as a whole.

「The special technical features」refer to the improved features when compared with prior arts. Therefore, whether the unity of inventions is satisfied or not can be determined before searching prior arts in some cases, but in general, shall be determined after considering prior arts. For example, in claims setting forth inventions A+X and A+Y, since all the claims have the invention A in common, it could be determined a priori before searching the prior arts that the claims involve the unity of inventions. However, where prior arts related to A has been searched, each claim does not have the same or corresponding special technical features distinctive from the prior arts. Therefore, the claims shall be deemed to lack the unity of invention a posteriori.

- A group of inventions may include multiple independent claims from the same category within one application or may include multiple independent claims from different categories within one application. Also, even one claim may include inventions out of the scope of one group of inventions, failing to meet the requirement on the unity of inventions.
- Whether one group of inventions forms a single general inventive concept has nothing to do with whether one group of inventions is claimed in separate claims or alternatively claimed in one claim.

(3) Determination on Unity of Invention

Basically, unity of inventions shall be determined in the following sequence.

(a) A first invention shall be chosen and the special technical features of the first invention which serves as improvement over prior arts shall be specified by comparison with the prior arts to which the invention pertains. It shall be noted that even a single invention may include multiple special technical features depending on the technical subject matter of the invention. In this context, the first invention refers to the main invention and has
nothing to do with the order of claims.

(b) A second invention shall be chosen and the special technical features of the second invention which serves as improvement over prior arts shall be specified by comparison with the prior arts to which the invention pertains. It shall be noted that even a single invention may include multiple special technical features depending on the technical subject matter of the invention.

(c) The technical correlation between the first invention and the second invention shall be checked by determining whether the special technical features of the first invention and the special technical features of the second invention are the same or corresponding. If there exist the special technical features which are the same or corresponding between the two

inventions, it can be concluded that the inventions fall under the single general inventive concept.

(d) Through the steps of (2) and (3) above, it shall be determined whether the inventions have the technical correlation and thus form a single general inventive concept as stipulated in Article 6 of the Enforcement Decree of the Patent Act.

(e) The first invention shall be selected as the invention subject to examination. In principle, the first invention as well as an invention belonging to the technical group(the first technical group) which forms a single general inventive concept with the first invention shall be selected as the invention subject to examination. However, an invention which is not included in any technical group because of lack of improvement over prior arts, but whose examination is terminated in the process of determination on unity of inventions shall be included. Moreover, an invention which can be examined without additional efforts because of mere differences in expressions such as different categories from the inventions belonging to the first technical group can be included to the invention subject to examination.

(f) Examination on patentability except for unity of inventions shall be conducted for the invention subject to examination. When notifying a ground for rejection citing the violation of the requirement of unity of inventions, an examiner shall notify the ground of rejection citing the violation of the requirement of unity of inventions on all the claims. When notifying a ground for rejection citing the violation on unity of inventions, an examiner shall notify the ground for rejection by specifying that the concerned inventions do not share the same or corresponding special technical features that characterize the first technical group. However, unity of invention can be determined based on whether the second invention includes the same or corresponding special technical features as the first invention after specifying the special technical features of the first invention in the above-mentioned step (1) and the second invention without conducting any additional prior art search in the steps (2) and (3). Also, where, after finding the common special technical features of each invention for convenience of examination practices first and determining whether such features are improvements over prior arts, the common features are not considered to be improvement compared to prior arts, unity of inventions shall be deemed lacking. Meanwhile, it shall be noted that lack of unity of inventions just constitutes a ground for rejection, not the ground for invalidation. In other words, where lack of unity of invention is deemed obvious, an examiner shall notify a ground for rejection so that an application can make amendments. However, an examiner does not need to force an applicant to make amendments or file a divisional application by notifying a ground for rejection citing the violation of unity of inventions based

on the literal approach. Especially,
even if unity of invention is lacking, where examination can be completed without any additional examination efforts since no more prior art search is needed(for example: where novelty and an inventive step of the entire claims can be denied based on the searched prior art), an examiner may not notify a ground for rejection citing the violation of unity of inventions.

(4) Examples of Determination on Unity of Invention
- Where an independent claim has special technical features, a dependent claim which refers to the independent claim includes all the special technical features. Therefore, unity of invention can be met among the claims with the common special technical features. In the below-mentioned case, if A+B is the special technical features, it means that all the claims hold the common special technical features of A+B. Therefore, unity of inventions on claim 1 and its dependent claims 2 and 3 is met.
(Example)
〔Claim 1〕: A display device comprising the special technical features of A+B
〔Claim 2〕: A display device of claim 1, further comprising the special technical features of C
〔Claim 3〕: A display device of claim 1, further comprising the special technical features of D

This shall apply to dependent claims of species inventions which refer to the claims of a generic invention. In the example below, claim 1 and claims 2 and 3 are a generic invention and species inventions. Considering that the common special technical features of claims 1, 2 and 3 is the technology of processing the surface of polyethylene resin with acid, unity of inventions is met among claims 1, 2 and 3.
(Example)
〔Claim 1〕: A method of processing the surface of polyethylene resin with acid
〔Claim 2〕: A method of claim 1, wherein the acid is sulfuric acid
〔Claim 3〕: A method of claim 1, wherein the acid is nitric acid

**(iii) Laws and examination practices relating to the patentability of artificial intelligence (AI)-related inventions (update of document SCP/30/5)**

○ Please find the attached document of Examination Guide on AI inventions

**(iv) Each IP office has created a dedicated webpage on the accelerated examination program**

○ **National/regional laws**

**- The Korean Patent Act**

Article 61 (Accelerated Examinations) In either of the following cases, the Commissioner of the Korean Intellectual Property Office may instruct an examiner to examine a patent application in preference to other patent applications:

1. Where it is found that any person, other than the patent applicant, is practicing for business purposes the invention claimed in the patent application after it is laid open under Article 64;

2. Where it is deemed necessary to urgently process a patent application prescribed by Presidential Decree;

3. Where a patent application prescribed by Presidential Decree is deemed necessary for disaster prevention, response, recovery, etc.

Article 9 (Cases Eligible for Accelerated Examination)

① "Patent application prescribed by Presidential Decree" in subparagraph 2 of Article 61 of the Act means a patent application designated by the Commissioner of the Korean Intellectual Property Office, among the following patent applications:

1. A patent application in the area of the defense industry;

2. A patent application directly related to green technology under the Framework Act on Carbon Neutrality and Green Growth For Coping with Climate Crisis;

2-2. A patent application utilizing technologies related to the fourth industrial revolution such as artificial intelligence (AI) and the Internet of Things (IoT);

2-3. A patent application related to advanced technology that is important to the national economy and the enhancement of national competitiveness, such as semiconductors (limited to a patent application for which the Commissioner of the Korean Intellectual Property Office determines and publicly announces specific cases eligible for an expedited examination and the period for application therefor);

3. A patent application directly related to export promotion;

4. A patent application concerning the official duties of the State or local governments (including any patent application concerning the duties of the national and public schools provided for in the Higher Education Act, which is filed by the organization in charge of the technology transfer and industrialization established within the national and public schools pursuant to Article 11 (1) of the Technology Transfer and Commercialization Promotion Act);

5. A patent application filed by an enterprise confirmed as a venture business under Article 25 of the Act on Special Measures for the Promotion of Venture Businesses;

5-2. A patent application filed by an enterprise selected as a technology-innovative small and medium enterprise under Article 15 of the Act on the Promotion of Technology Innovation of Small and Medium Enterprises;

5-3. A patent application filed by an enterprise selected as an exemplary company in terms of the employee invention compensation system under Article 11-2 of the Invention Promotion Act;

5-4. A patent application filed by a small or medium enterprise with the certification for management of intellectual property under Article 24-2 of the Invention Promotion Act;

6. A patent application concerning the results of national research and development programs under subparagraph 1 of Article 2 of the National Research and Development Innovation Act;

7. A patent application which serves as a basis of a priority claim under treaties (limited to cases where a patent is being processed by a foreign patent office, upon a priority claim based on the relevant patent application);

7-2. An international patent application on which the Korean Intellectual Property Office conducts international search, as an international search agency under the Patent Cooperation Treaty pursuant to Article 198-2 of the Act;

8. A patent application under which an invention is being practiced or being prepared to be practiced by the patent applicant;

10. A patent application on which the Commissioner of the Korean Intellectual Property Office has agreed with the commissioner of any foreign patent office to preferentially examine

② "Patent application prescribed by Presidential Decree" in subparagraph 3 of Article 61 of the Act means any of the following patent applications:

1. Any of the following patent applications determined and publicly notified by the Commissioner of the Korean Intellectual Property Office:
a. A patent application directly related to goods for medical treatment and disease control under subparagraph 21 of Article 2 of the Infectious Disease Control and Prevention Act;
b. A patent application directly related to disaster safety products certified under Article 73-4 of the Framework Act on the Management of Disasters and Safety;
2. A patent application subject to public notice given by the Commissioner of the Korean Intellectual Property Office for a specified period of applying for an expedited examination to respond to an emergency situation caused by a disaster.

○ Accelerated Examination of COVID-19 related patent applications has terminated on June 22, 2023.

**(v) Update of document SCP/26/5 (Constraints faced by developing countries and LDCs in making full use of patent flexibilities and their impact on the access to affordable especially essential medicines for public health purposes in those countries)**

○ **KIPO has no input at this moment.**

**(vi) Update of document SCP/25/4 (Compilation of court cases with respect to client-patent advisor privilege)**

○ **Court case**

(1) Supreme Court en banc Decision 2009Do6788 Decided May 17, 2012
- Summary of Decision: The lower court upheld the decision of the first instance court, which denied the admissibility of the legal opinion of this case which included legal advice given to Defendant 5 by an attorney affiliated with the law firm of the case based on the assumption that confidential communication for the purpose of legal counsel between a lawyer and his/her client is included in the right to counsel acknowledged by Article 12(4) of the Constitution; thus, although not explicitly provided by current written law, the client has the privilege to refuse to provide confidential communication related to legal counsel. Subsequently, the court below determined that the legal opinion of this case has no

admissibility unless the lawyer (who prepared the legal opinion) establishes its authenticity, and even so, it still may not be used as evidence to establish the crime committed by the Defendants 1, 2, and 5 regardless of unlawfulness of the seizure process based on the attorney-client privilege.

Article 12(4) of the Constitution provides that "[a]ny person who is arrested or detained shall have the right to prompt assistance of counsel," and Article 34 of the Criminal Procedure Act stipulates that "[t]he defense counsel or a person who desires to be a defense counsel may have an interview with the criminal defendant or the criminal suspect who is placed under physical restraint, may deliver or receive any documents or things and may have any doctor examine and treat the criminal defendant or the criminal suspect."

Meanwhile, the Criminal Procedure Act protects the attorney-client confidentiality to a certain degree by providing that an attorney may refuse seizure of articles held in his/her custody or possession while being entrusted to handle business and which relate to secrets of other persons (Articles 112 and 219), and that an attorney may refuse to testify in respect to facts of which he/she has obtained knowledge while being entrusted to handle business and which relate to secrets of other persons (Article 149).

In light of the aforementioned provisional contents and purposes under the Constitution and the Criminal Procedure Act, the judgment of the lower court which held that a person who has yet to be considered as either a suspect or a defendant, due to criminal procedure (such as an investigation or hearing) not having begun, may nonetheless exercise the attorney-client privilege regarding legal advice during his/her everyday life, or that articles seized without the client's consent cannot be used as evidence in a criminal trial (regardless of unlawfulness of the seizure process) is unacceptable.

Therefore, the reasoning of the lower court's judgment denying the admissibility of the legal opinion of this case on the ground of attorney-client privilege is inappropriate.

**(vii) Update of document SCP/32/6 (Patent law provisions that contribute to effective transfer of technology, including sufficiency of disclosure);**

○ **National/regional laws**

**- The Korean Patent Act**

Article 42 (Patent Applications) ① A person who intends to obtain a patent shall file a patent application stating the following information, with the Commissioner of the Korean

Intellectual Property Office:

1. The name and domicile of the patent applicant (if the applicant is a corporation, its name and place of business);

2. The name and the domicile or place of business of an agent, if the patent applicant is represented by an agent (if the agent is a patent firm or limited-liability patent firm, its name and place of business, and the name of the patent attorney designated for the case);

3. The title of the invention;

4. The name and domicile of the inventor

② A patent application filed under paragraph (1) shall be accompanied by a specification containing the description of the invention and the claims, necessary drawings, and an abstract.

③ A description of an invention under paragraph (2) shall satisfy all of the following requirements:

1. To clearly detail the invention in such manner that any person with ordinary knowledge in the technical field of the relevant invention can easily practice the invention;

2. To state the technology used for the invention.

④ Claims referred to in paragraph (2) shall state at least a claim to be protected (hereinafter referred to as "claim"), and each claim shall satisfy all of the following requirements:

1. The invention shall be supported by the description;

2. The invention shall be clearly and concisely described.

Article 62 (Determinations to Reject Patent Applications) An examiner shall determine to reject a patent application if the patent application falls under any of the following grounds for rejection (hereinafter referred to as "grounds for rejection"):

4. If the patent application fails to meet any of the requirements prescribed by Article 42 (3), (4), or (8) or Article 45

Article 133 (Trial on Invalidity of Patents) ① In any of the following cases, an interested party (limited to those who have the right to obtain a patent in cases of the main clause of

subparagraph 2) or an examiner may file a petition for trial to seek invalidation of a patent. If the application contains two or more claims, a petition for trial for invalidation may be filed for each claim:
1. If the patent violates any of the provisions of Articles 25, 29, 32, 36 (1) through (3), 42 (3) 1, or Article 42 (4)

**(viii) A study on inventorship and patent ownership issues arising from collaborative research.**

○ **National/regional laws**

**- The Korean Patent Act**

Article 33 (Persons Entitled to Patent) ② If at least two persons jointly make an invention, they are jointly entitled to a patent thereon.

Article 44 (Joint Applications) Where the entitlement to a patent is jointly held by at least two persons, all entitled persons shall jointly file a patent application.

Article 62 (Determinations to Reject Patent Applications) An examiner shall determine to reject a patent application if the patent application falls under any of the following grounds for rejection (hereinafter referred to as "grounds for rejection"):
1. If an invention is unpatentable under any provision of Articles 25, 29, 32, 36 (1) through (3), and 44

Article 133 (Trial on Invalidity of Patents) ① In any of the following cases, an interested party (limited to those who have the right to obtain a patent in cases of the main clause of subparagraph 2) or an examiner may file a petition for trial to seek invalidation of a patent. If the application contains two or more claims, a petition for trial for invalidation may be filed for each claim:
2. If the patentee has no right to obtain the patent under the main clause of Article 33 (1) or violates Article 44.

○ **Court case**

(1) Supreme Court Decision 2009Da75178 Decided July 28, 2011

- Summary of Decision: A joint inventor must be established as being in a relationship of mutual cooperation, on an actual basis, toward completion of the invention. Accordingly, the status of a joint inventor is acknowledged when a person has contributed toward completion of the invention by more than merely providing basic tasks or ideas for the invention, providing general administration for researchers, organizing data and performing experiments upon instruction by a researcher, or supporting or commissioning completion of the invention by providing funds or equipment. Rather, a joint inventor must have contributed toward the invention by newly presenting or adding/supplementing concrete conceptions in regard to technical problems within the invention, materializing new conceptions by conducting experiments, etc., or providing concrete means and methods to achieve the purpose and utility of the invention or by providing actual advice and/or instructions that make the invention possible.

In other words, a person must have contributed toward creational activity of the technical idea to an actual extent in order to be recognized as a joint inventor. Meanwhile, in the case of chemical inventions, which take place in a field frequently referred to as "the science of experiments," notwithstanding certain disparities that may be caused by the contents and technical level of an invention in this field, there are many cases where the invention substantially lacks predictability or implementability and thus cannot be seen as a complete invention without a trial experiment to present experiment data. In such cases, the status of a joint inventor must be decided considering whether the person in question made actual contributions toward specifically defining and completing the invention in the process of experiment.