

The Korean Patent Attorneys Association

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I Korean Patent Attorneys Association

A. Overview

Pursuant to the Patent Attorneys Act of Korea, the Korean Patent Attorneys Association (KPAA) was established in 1961. Its predecessor organization, the Chosun Patent Attorneys Association, was a voluntary association for patent attorneys and was formed in 1946.

Under the Patent Attorneys Act, all patent attorneys in private practice must be members of the KPAA. Once the KPAA was established, all members of the Chosun Patent Attorneys Association automatically became members to the KPAA.

The Patent Attorneys Act provides three ways an individual can become a licensed patent attorney. First, a person can pass the patent attorney exam offered each year. Second, an attorney-at-law can register himself/herself as a patent attorney with the Korean Intellectual Property Office (KIPO). Third, an examiner of the KIPO can become a patent attorney after a certain amount of time (generally, after three to five years of service).

To promote communication among its members, related organizations and the public, the KPAA began to publish an official journal, *The Patents and Trademarks*, in 1967, which began as a monthly publication and is now a bi-monthly publication.

In 1980s, KPAA began to establish sisterhood relationships with patent attorneys association in other countries. The first relationship established was with the Japanese Patent Attorneys Association in 1981, followed by the French Institute of Patent and Trademarks Attorneys (CNCPI) in 1990 and the All-China Patent Agent Association (ACPAA) in 1991.

In 1997, the KPAA, with financial support from its members, bought an office located in Seocho-dong, Seoul at the cost of KRW 2 billion. In 1999, the Patent Attorneys Act was revised such that membership to the KPAA was no longer mandatory and other patent attorney associations

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² The views expressed in this article are his own and not those of Lee International IP & Law Group or the Korean Patent Attorneys Association.

could be formed. However, from 1999 to 2009, no other associations were established. In 2009, the KPAA was once again made a mandatory association for all patent attorneys.

maintains a close relationship with AIPLA of the USA, JPAA, ACPAA, CNCPI of France, CIPA of the United Kingdom, and the PAK of Germany. The KPAA is also recognized by the WIPO and regularly invited to the WIPO meetings and conferences.

B. Education of Members

Beginning in 2010, mandatory continuing legal education (CLE) for patent attorneys is expected. A bill has been proposed by the KIPO and is expected to be deliberated by the National Assembly sometime this year. According the proposed bill, patent attorneys will have to satisfy 15 hours of CLE requirements each year.

The KPAA already provides educational seminars on various topics. Since establishment of the Patent Court in 1998, civil procedure seminars are popular among the KPAA members. Other popular topics include trial preparation, conduct of trial, and the annual review of Patent Court cases. Judges of the Patent Court and professors of civil procedure are often the speakers for the KPAA seminars. The size of the audience of these seminar range from 2 to 500 people. Currently, the seminars are only offered in a live format. However, once the CLE requirement is implemented, it is expected the seminars will be available over the internet. Also, in some instances, seminars offered by organizations other than the KPAA will count as KPAA CLE education.

Also, monthly IP seminars are given at the KPAA offices. Frequent topics of these monthly seminars are developments in IP law and practice in foreign jurisdictions. Seminars on non-traditional topics, such as licensing negotiations, evaluation of IP assets and industry-specific topic on IP matters (e.g., pharmaceutical or telecommunication industry), are also held. Sometimes the speakers are foreign patent attorneys visiting Korea.

To support the KPAA's various activities, it has several task force teams, including an advisory group for Korean parties in overseas dispute on patent and trademark issues; client-friendly IPR registration system; IPR management for small-and-medium size enterprises; and committee on liberalization of the legal service market in Korea.

C. Publications

In July 1967, the KPAA first began its bi-monthly publication of the official journal, The Patent and Trademark. In addition to the journal, the KPAA also publishes an annual collection of research paper "Knowledge and Right" written by its member and non-members on IP laws.

From time to time, the KPAA updates and reflects amendments to its collection of IP Status and Regulations, and distributes this information to its members. The KPAA also gets authorization to re-print IP-related government publications, published by the KIPO or the Patent Court, for distribution to its members.

D. Pro-Bono

The KPAA prepares and files applications for students and low-income family. This service is provided free of charge to applicants. The KIPO provides financial support for this service.

In cooperation with the Association of Small-and-Medium sized Enterprises (ASME) the KPAA also provides free IP consultation services for the members of the ASME.

E. Organizational Structure

Each February, the KPAA holds its annual meeting of the General Assembly. During even-number years, a President is elected for two-year term. Usually, the Assembly authorizes the newly elected President to select seven Vice-Presidents and up to 15 Directors. In February of 2010, the Board of Council changed its name to the House of Delegates and consists of 50 delegates including the President, Vice Presidents, and Directors. The KPAA secretariat currently has 15 employees.

F. Members

Under the Patent Attorneys Act, an individual can become a licensed patent attorney to represent clients before the KIPO and the Intellectual Property Tribunal (IPT) in three different ways. As of end of 2009, there are approximately 5,300 licensed patent attorneys. However, many of them, particularly attorneys-at-law, do not actively represent clients before the KIPO or IPT. Less than half of the licensed patent attorneys (2,500) are members of KPAA. The licensed patent attorneys that are not members of the KPAA may provide clients general IP related advice, but cannot prosecute applications or litigate IP related cases.

G. Finance

KPAA's income for the year of 2009 is provided below Table 1:

<Table 1>

Income (Thousands, US\$)		(%)
- Membership Dues	1359	(85.3%)
• Membership application fee	146	(9.2%)
• Monthly due	896	(56.4%)
• Performance tax	314	(19.8%)
- Others		
• Sales of publications	24	(1.5%)
• Advertisement at KPAA journal	44	(2.7%)
• Educational service	14	(0.9%)
• Others	150	(9.4%)
Total	1588	(100%)

KPAA members are required to pay the dues as provided in Table 2:

<Table 1>

- Membership Dues
 - Membership application fee ₩1,000,000 (approx. US\$900)
 - Monthly due ₩40,000 (approx. US\$36)

- Performance tax
 - Filing a new KIPO application
 - » Patent ₩ \1000
 - » Utility model ₩ \900
 - » Design ₩\700
 - » Trademark ₩\600
 - » Appeal to patent court ₩\6000

II Attorney-Client Privilege

A. No “Discovery” available for civil cases

Under the Korean judicial system, wide disclosure of evidence during pre-trial proceedings is not available. As civil actions are lead by court, the plaintiffs are expected to file complaints with their own substantial collection of evidence. Once the defendant answers the complaints, the court hearings are held to identify the legal issues and review the evidence. Any request to disclose evidence will be addressed to the court by way of motion and the court will decide whether to issue an order as sought by the parties. Though this motion practice, parties may get additional information.

Also, Korean law does not provide for a jury trial, instead every civil action is a bench trial. This makes the admissibility of evidence less important when compared with a jury trial. Without pre-trial proceedings and a discovery process, the concept of attorney-client privilege is not fully developed in Korea, like in many civil-code jurisdictions.

Though rather limited, any confidential information delivered from the client to a patent attorney is protected under Korean law and a patent attorney has a statutory obligation to keep such information confidential.

B. Civil Procedure Act

The Civil Procedure Act prescribes the right to refuse testimony as follows:

- Art. 315 (Right to Refuse to Testify)

1) A witness may refuse to testify when s/he is being interrogated in relation to professional confidential information if s/he is:

- an attorney at law, a patent attorney, a notary public, a certified public accountant, a tax agent, a medical professional, a pharmacist, or others...

Please note that this is an obligation of the patent attorney, not of the parties. Also, its scope is limited to “professional confidential information” and not all attorney-client communications is protected, as in the US.

In addition, the Civil Procedure Act provides an exemption to an obligation to produce documents containing confidential information as provided in Art. 315 for a civil action as follows:

- Art. 344 (Obligation to Produce Document)

- Any person as prescribed below may not refuse to produce documents in his/her possession
 - iii. any designated documents prepared for the interest of the requesting party or
 - ... except:
 - c. documents containing the items as provided in Article 315 (1), and not exempt from the obligation to keep it confidential.

To date, there have been no court decisions that address the application of Article 315 and 344 of the Civil Procedure Act to attorneys-at-law or patent attorneys. Whether these protections are applicable to documents in the party's possession or control is questionable.

C. Criminal Procedure

As criminal penalty is provided as a remedy to patent infringement in Korea, it is possible for a patentee to be involved in a criminal action, though the Patent Attorneys Act does not prescribe patent attorney's representation his client in a criminal case. Article 112 of the Criminal Procedure Act protects professional confidential information of a patent attorney from being disclosed as follows:

- Art. 112 (Professional Confidential Information and Impoundment)

An attorney at law, a patent attorney, a notary public, ..., a medical doctor... may refuse an impoundment of an item in his procession or control, which is related to another person's confidential information...

In applying the above statutory provision, similar questions remain unanswered as in civil proceedings:

1. Is this provision applicable to written opinion prepared for the purpose of criminal proceedings and prepared by an attorney?
2. Is this provision applicable to written opinion not prepared for criminal proceedings?
3. Is this provision applicable to items in the party's possession or control?

D. Regulation of Patent Attorneys

The Patent Attorneys Act provides criminal liability of a patent attorney who divulged confidential information in relation to an invention or a patent application as follows:

- Art. 22 (Crime of Divulging)

When a patent attorney or one who used to be a patent attorney divulges confidential information of an invention or patent application, which s/he came to know in her/his capacity as a professional..., s/he shall be punished by imprisonment of up to 5 years or criminal fine of up to 10 million won.

Again, there are no court decisions that address the application of Article 22 of the Patent Attorneys Act. Since the provision states "confidential information of an invention or a patent application," it is plausible to limit the provision only to technical features of the invention or

application, not legal information, including infringement opinion or prior art information.

E. International Activities of Harmonizing the Attorney

The KPAA understand the international efforts to harmonize attorney-client privilege, as discussed by AIPPI and WIPO and supports those efforts.

1. AIPPI

- 2003 : Resolution 163
- 2005 : AIPPI Submission to WIPO for a Treaty to be Established on Intellectual Property Advisor Privilege

2. WIPO

- 2008 : WIPO / AIPPI Conference on CPIPPA (Client Privilege in IP Professional Advice
- 2009 : WIPO Standing Committee on Patent (SCP) adapts CPIPPA topic

III Patent Prosecution Highway (PPH) and Accelerated Examination

A. Overview of PPH

- Patent Prosecution Highway (PPH) is a bilateral agreement to allow accelerated examination of a patent application whose corresponding application has been granted after substantive examination by another country's IP office.
- It's purpose is to avoid duplicate prior art search, as well as to expedite patent granting procedure and reduce backlog of pending patent application.
- The first implemented PPH was one agreed between USPTO - JPO in July 2006.

B PPH in Korea

In Korea, two major PPH agreements, with Japanese Patent Office(JPO) and the United Patent and Trademark Office(USPTO) are actively utilized:

1. KIPO - JPO

- Effective: April 2007
- The applicant must provide a translation of all notices issued by the first IP office, claims granted by the first IP office, claims pending before the second IP office.
- Time period to issue a first notice by JPO as a 2nd IP Office is: 3-5 months or more.
- Non-PPH : 25 months for 1st office action to be issued by JPO
- Number of applications requesting benefit of PPH based on first grant from JPO: 328 (April '08 ~ Dec '09)

2. KIPO - USPTO

- Effective: January 2008
- Time period to issue a first notice
 1. KIPO : 2 months
 2. USPTO : 3 months
- Number of applications requesting benefit of PPH based on first grant from USPTO : 161(Jan '08 ~ Dec '09)

3. Other countries with which Korea has PPH agreements are: Denmark, Canada, Russia and Finland.

C. KIPO-ISA for PCT/US

- Under an agreement between KIPO and USPTO, KIPO may be designated as an International Searching Authority(ISA) for a Patent Cooperation Treaty(PCT) applicant who files with the USPTO Receiving Office since 2006.
- Advantages of International Search Report(ISR) prepared by KIPO may be explained the three factors:
 - i) Timely ISR: usually before the international publication, 18 months from the first priority date.
 - ii) Ability to search for documents in English, Korean, and Japanese (especially for semiconductor and information technologies).
 - iii) Reasonable cost: about 30% to 50% lower than the USPTO International Search fee.
- During the last year (4) year period 2006~2009, KIPO being designated as an ISA
- KIPO/ISA model worked very well as indicated by the number of

2006:735

2007:2,853

2008:11,653

2009:13,978s