



DIFFERENCES IN PROSECUTION BEFORE THE USPTO AND KIPO

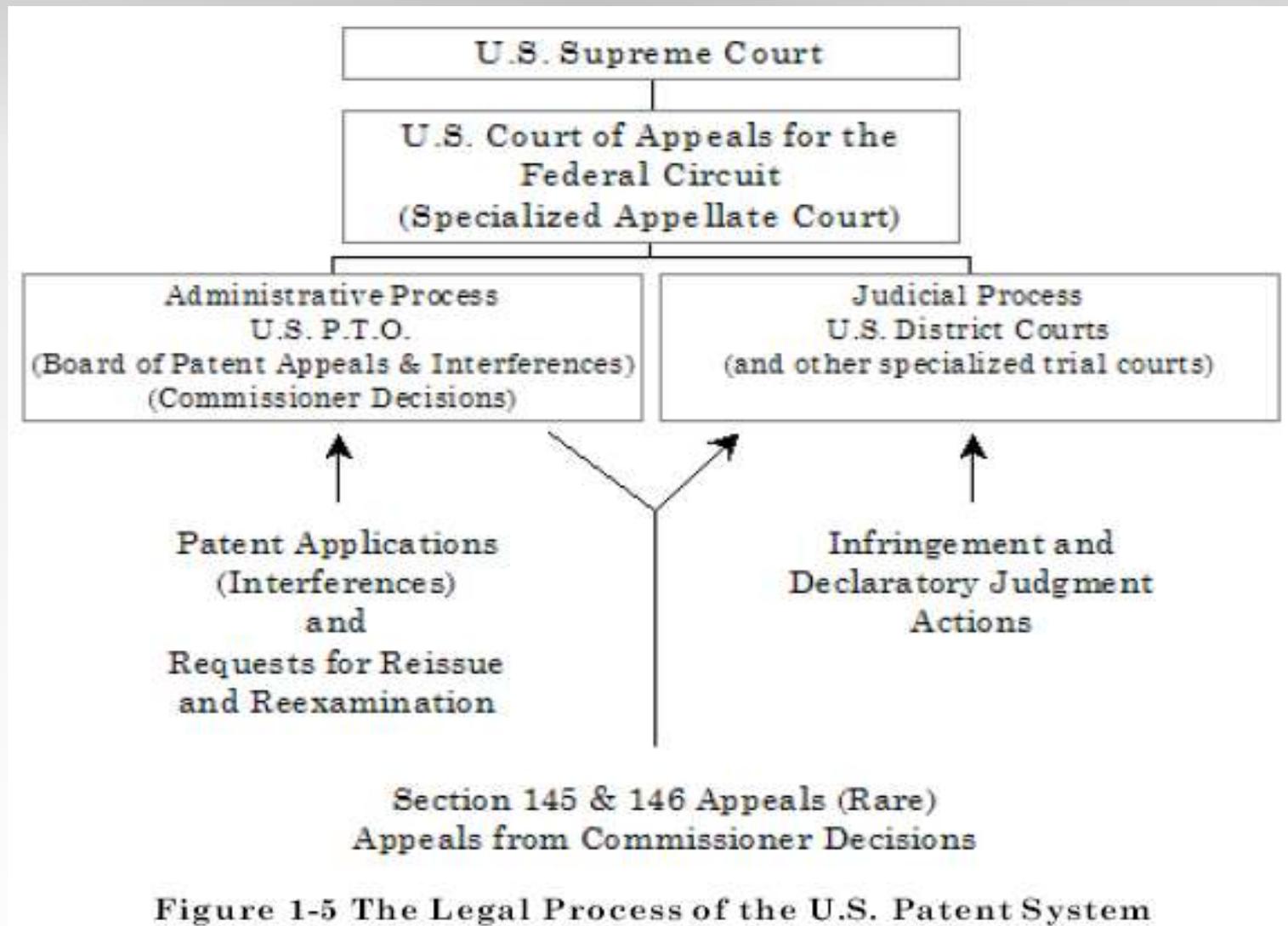
HERSHKOVITZ IP GROUP

INTA 2012 WASHINGTON, D.C.

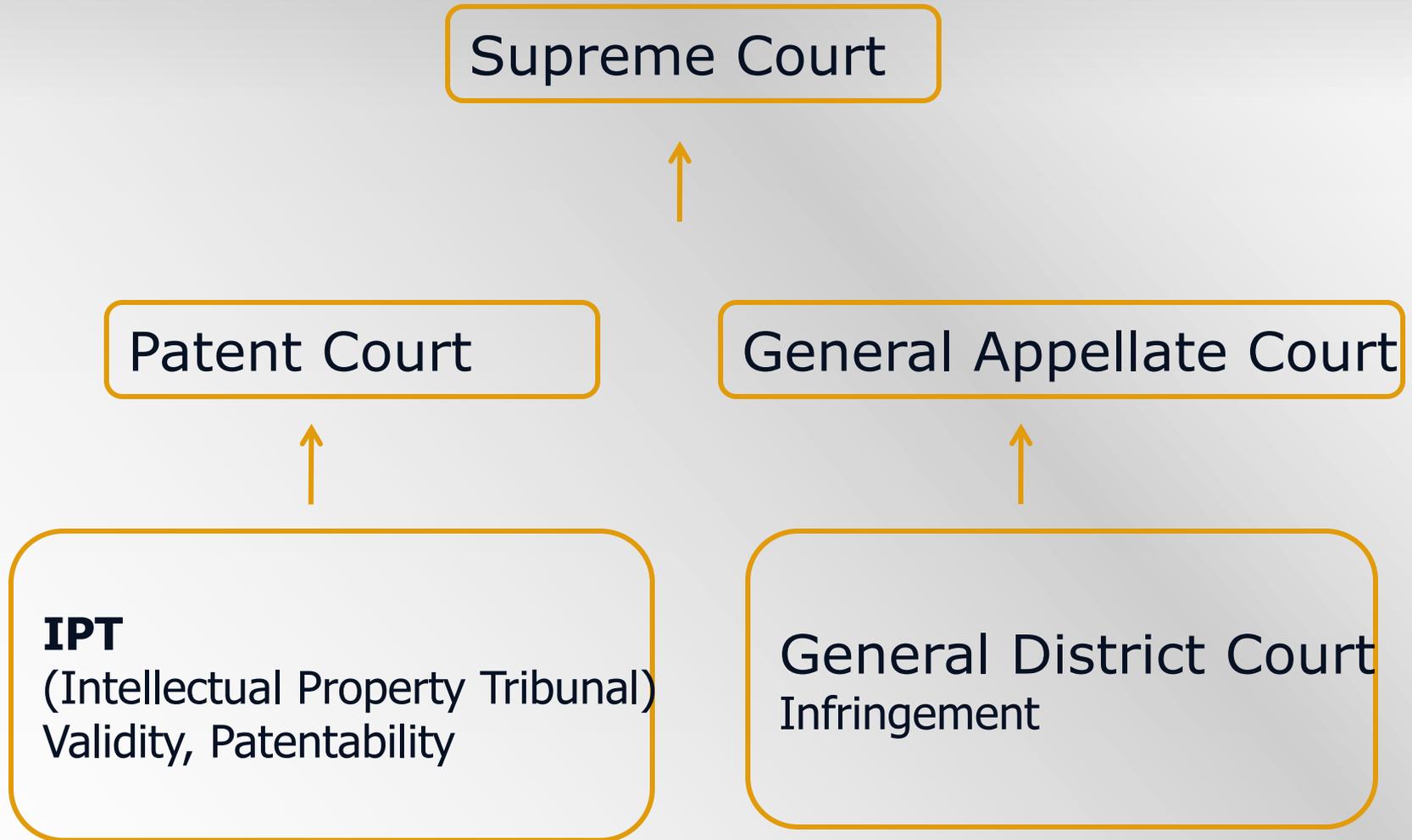
Presented by Steve Jaeyoun Kim

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Court System : US



Court System : Korea



Types of Patents

U.S.	KOREA
Utility Patent	Utility Patent Utility Model (Petty Patent)
Plant Patent	Plant Patent
Design Patent (Boat Hull Act (2005); Fashion Design Act (3 years) proposed to amend CR Act – not passed)	Design Patent

First-to-File v. First-to-Invent

- **Priority Rule – 35 U.S.C. 102(g)**
- **The first to reduce the invention to practice**
- **Filing a valid application constitutes a constructive reduction to practice and a provisional application counts as a constructive reduction to practice.**

First-to-File v. First-to-Invent

- **Priority Rule – 35 U.S.C. 102(g)**
- **The first to conceive may prevail over the first to reduce to practice if the first to conceive was diligent from a time prior to the other inventor's conception through to his/her own reduction to practice (either actual or constructive).**
- **Thus, it is implied that the first to conceive and first to reduce to practice always wins without regard to diligence.**

First-to-File v. First-to-Invent

- **Priority Rule – 35 U.S.C. 102(g)**
- **Any reduction to practice that has been “abandoned, suppressed, or concealed” is disregarded.**
- **Interference proceeding : Board of Appeals and Interferences in the USPTO**
- **AIA : First-to-file system effective on or after March 16, 2013**

Non-provisional Application

- US: an applicant should present a specification, a drawing and an oath (or declaration)
- Korea: an oath or declaration is not required.

Provisional Application

- US – under 35 U.S.C. 111(b)
 - 1994 GATT legislation : to offset one disadvantage of the TRIPs-required twenty year patent term.
 - Specification, drawings
 - Cover sheet identifying the app. as a prov.
 - No claim, no oath (declaration) required

Provisional Application

- Not be examined for patentability
- Abandoned 12 months after its filing date
- Non-provisional application claims the benefit of priority (but design patent cannot make a claim for priority)
- Request to convert a prov. To a non-prov. app.
- Kept in confidence
- Recommend against the use of prov. app. Except in circumstances where the applicant has insufficient financial resources and has allowed insufficient time to prepare a non-provisional app.

Continuation Application (CA)

- Not available in Korea
- Under 37 C.F.R. 1.53(b)
- An application whose specification is the same as that of the parent application, but whose claims are different from those of the parent application
- Entitled to the parent's filing date

Continuation Application (CA)

- Some claims were finally rejected in the parent, then those claims might be cancelled from the parent, allowing other claims to be issued. The cancelled claims may be then pursued, with or without change, in the CA.

- Apparatus claim, method claim

- Example:

General rifle, Semi-automatic rifle, automatic rifle

Continuation-in-part application (CIP)

- An application that has some subject matter in common with the parent but also has new subject matter.
- If the applicant wished to add limitations to the parent claims to distinguish a reference, but the added limitations are not supported by the written description of the parent, and the examiner will not allow supporting material to be added to the written description because it introduces new matter.
- A CIP might also be filed if the applicant has improved the invention described in the parent.
- Example: Rifle

Continuing Prosecution Application (CPA)

- Under C.F.R. 1.53(d)
- While the parent is indeed abandoned, the application has the same number as its parent and no reference to the parent is inserted into the specification.
- CPA cannot be filed unless the parent is to be abandoned.
- All papers filed in the parent, except election in a divisional application, carry over into the new application.

Continuing Prosecution Application (CPA)

CA	CPA
New File is Created	Not Created
New Application No. is assigned	Not assigned
Cannot filed by Fax	Can be filed by Fax
Not automatically abandon parent	Automatically abandon
Must include a reference to the parent for domestic priority and must make a claim for foreign priority	Does not
Applicable	Not applicable after July 14, 2003- Utility and Plant (If filed, convert CPA to RCE) Applicable to design patent

Request for Continued Examination (RCE)

- (a) If prosecution in an application is closed, an applicant may request continued examination of the application by filing a submission and the fee prior to the earliest of:
 - (1) Payment of the issue fee;
 - (2) Abandonment of the application; or
 - (3) The filing of a notice of appeal
- (b) Prosecution in an application is closed:
 - appeal
 - a final action (§ 1.113),
 - a notice of allowance (§ 1.311)

Request for Continued Examination (RCE)

- (c) A submission as used in this section includes,
 - 1) an information disclosure statement,
 - 2) an amendment to the written description, claims, or drawings,
 - 3) new arguments,
 - 4) new evidence in support of patentability.
- (d) If an applicant timely files a submission and fee, the Office will withdraw the finality of any Office action and the submission will be entered and considered. If an applicant files a request for continued examination under this section after appeal, but prior to a decision on the appeal, it will be treated as a request to withdraw the appeal and to reopen prosecution of the application before the examiner.

Request for Continued Examination (RCE)

- (e) The provisions of this section do not apply to:
 - (1) A provisional application;
 - (2) An application for a utility or plant patent filed
 - under 35 U.S.C. 111(a) before June 8, 1995;
 - (3) An international application filed under 35 U.S.C.
 - 363 before June 8, 1995;
 - (4) An application for a design patent; or
 - (5) A patent under reexamination.

Restriction Requirement

37 C.F.R. 1.142(a)	Article 45 of Korean Patent Act
Election	Examined together with other requirements such as novelty, non-obviousness, utility and if there is a violation of these requirements, the application will be rejected.

Publication of Filed Applications

US	Korea
18 months	18 months
Non-publication request	N/A
International application – Notify within 45 days	N/A
No requirement of publication – abandoned or government interest	Same as in the US
Early publication request	Same as in the US

Information Disclosure Statement (IDS)

- Not required in Korea
- 37 CFR 1.56(a): Each individual associated with the filing and prosecution of a patent application speaks candidly and acts in good faith when dealing with the Office
- Who is individual?

Inventor, attorney or agent, every other person who is substantially involved in the preparation of the application.

Information Disclosure Statement (IDS)

- **What is the scope of information?**
- **Any information which is “material to patentability.”**
- **The duty to disclose information extends until a patent is granted.**
- **In Korea, KIPO allows any person to submit information after publication of a filed application**

Disclosure Requirement

US	Korea
Enablement Requirement	←
Written Description	←
Best Mode Requirement	N/A
Distinctiveness (Particularly pointing out and distinctly claiming)	Distinctiveness (clearly and concisely claiming)

Requirement for Patent Registration

US	Korea
<p data-bbox="291 525 498 586">Novelty</p> <ul data-bbox="324 605 967 1119" style="list-style-type: none"><li data-bbox="324 605 967 666">- Grace period: one year<li data-bbox="324 681 967 1119">- Experimental use (Case law: City of Elizabeth v. American Nicholson Pavement Company, US Supreme Court (1878))	<p data-bbox="1045 525 1251 586">Novelty</p> <ul data-bbox="1078 605 1746 815" style="list-style-type: none"><li data-bbox="1078 605 1746 666">- Grace period: 6 months<li data-bbox="1078 681 1746 815">- Experimental use (Patent Act provides)

Requirement for Patent Registration

US	Korea
<p>Non-obviousness</p> <ul style="list-style-type: none">- Graham factors<ol style="list-style-type: none">1) the scope and content of the prior art2) differences between the prior art and the claims at issue3) the level of ordinary skill in the art- combination- obvious to try- secondary consideration<ol style="list-style-type: none">1) Commercial success2) long-felt but unresolved need3) failure of others, etc.	<p>Inventive Step</p> <ul style="list-style-type: none">- purpose, elements, effect

Requirement for Patent Registration

US	Korea
<p>Utility</p> <ul style="list-style-type: none">- useful process...- intended purpose- POSITA would immediately appreciate why the invention is useful based on the characteristic <p>-specific, substantial and credible utility</p> <ul style="list-style-type: none">- Tied to machines or transform a particular article to a different status (Bilski)	<p>Utility</p> <ul style="list-style-type: none">- Industrial applicability : future possibility to be used in a relevant industry even though it has no applicability right now

Patent Highway Program

- **Accelerated Examination**
- **Greater Efficiency : 90% of PPH cases are allowed**
- **Decreased Costs of Prosecution**
- **Reduced Pendency**
- **No Petition Fee**

First Action Interview Pilot Program

- **conduct an interview with the examiner after reviewing a Pre-Interview Communication providing the result of a prior art search conducted by the examiner.**
- **Applicant's request to participate in the program must be filed at least one day before a first Office action**
- **All utility art areas, continue until May 16, 2012**

First Action Interview Pilot Program

- **benefits: (1) the ability to advance prosecution of an application; (2) enhanced interaction between applicant and the examiner; (3) the opportunity to resolve patentability issues one-on-one with the examiner at the beginning of the prosecution process; and (4) the opportunity to facilitate possible early allowance**

Multiple Dependent Claims

US	Korea
Additional government fee \$390	No additional government fee

Thank You

■ Steve Jaeyoun Kim

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U.S. PATENT AND TRADEMARK OFFICE

The End

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