Feedback from KIPO as a designated Contracting Party
- Substantive requirements of registration & more

Kijoong Song, Deputy Director of Trademark Examination Policy Division
The Hague Agreement

- Effect in ROK in **July 1, 2014**

- **2,296** IRs include
- **6,560** designs

- *per month*: **72** applications
  **205** designs

- **2.86** designs in an application
- **6.75** months for first OA
Statistics

Classifications
- 10 (17%)
- 12 (11%)
- 09 (7%)
- 03 (6%)
- 11 (6%)

Companies
- Swatch AG (146)
- Hermes Sellier (101)
- Result S.A.S (82)
- Harry Winston SA (75)
- Koninklijke Philips N.V. (72)

Countries
- CH (755)
- DE (400)
- FR (343)
- US (306)
- JP (184)

TOP 5 KR designated applications (2016, designs)
Statistics

Foreign design applications (2014-2016)

- Domestic
- Hague

IR designated KR (2014-2016)

- Decision of Refusal (31%)
- Withdraw of Refusal (19%)
- Grant of Protection without Refusal (50%)

Refusals by ground (2014-2016)

- Industrial applicability
- others
- Prior application
- Novelty & Ease of Creation

- 71%
- 15%
- 13%
- 1%
Declarations

1. Fees

<table>
<thead>
<tr>
<th>Substantive Exam. Track (except Locarno class 2,5, or 19)</th>
</tr>
</thead>
<tbody>
<tr>
<td>- individual designation fee</td>
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</tbody>
</table>

<table>
<thead>
<tr>
<th>Non-substantive Exam. Track (class 2,5, or 19)</th>
</tr>
</thead>
<tbody>
<tr>
<td>- Standard designation fee (level three)</td>
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</tbody>
</table>

2. Changes in ownership has no effect until KIPO receives doc. evidencing the agreement of the joint owner

3. The maximum duration of protection for designs provided by Korean national law is **20yrs from the date of international registration.**

4. Special reproductions

   - A set of articles & typeface

   **A design of a set of articles**: one view of the coordinated whole and corresponding views of each of its components

   **Typefaces**: views of the given characters, a sample sentence and typical characters

5. Period of Refusal & etc.

   - 6 months (class 2,5, or 19)
   - 12 months (except the above)
   - Overcoming Refusal grounds

   : Just in case of an unforeseen circumstance, such as a natural disaster
Priority claim to KIPO

- Available E-filing Submission of document(s) in support of a priority claim to the KIPO

  * E-filing: under ‘Priority tab’ tab, or DM/1/V

- Priority document should be submitted **at the time of filing** or directly to the KIPO within 3 months from the date of publication of the IR

Exception to lack of novelty

- Available E-filing Submission of documentation(PDF) in support of a declaration concerning exception to lack of novelty to the KIPO

  * E-filing: ‘More optional contents’ tab, or DM/1/II

- Where the application of a design is disclosed or the registration is published at home and abroad according to a law or a treaty, you shall not claim the exception to lack of novelty.
Most common grounds for Refusals from KIPO

- Design usable for an industrial purpose
- Novelty
- Ease of creation
- Related design
- Indication of Products
Design usable for an industrial purpose

© Article 33 (Requirements for Design Registration)

(1) A design usable for an industrial purpose is eligible for design registration, except:

1. A design publicly known or worked in the Republic of Korea or a foreign country before an application for design registration is filed;

2. A design described in a printed publication distributed in the Republic of Korea or a foreign country or made available for public use via telecommunications lines before an application for design registration is filed;

3. A design similar to any of the designs specified in subparagraph 1 or 2.
Design usable for an industrial purpose

discrepancies between drawings
Novelty

Design Protection Act Article 33(1)

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Self-disclosure before 6 months
Novelty

Self-disclosure before 6 months of filing date
Ease of creation

© Article 33 (Requirements for Design Registration)
(2) Notwithstanding the provisions of paragraph (1), no design (excluding a design specified in paragraph (1)) that could have been easily created by a person who has ordinary skill in the art to which the design pertains by applying any of the following methods before an application for design registration is filed, shall be eligible for design registration:

1. A design specified in paragraph (1) 1 or 2 or a combination of such designs;

2. A shape, pattern, or color, or a combination thereof, widely known in the Republic of Korea or in a foreign country.
Ease of creation

DM/086020 Watch hands

DM/086172 Push button

DM/086172 Pendant


Prior design, watch case with bracelet DM/085760, ‘15.3.3.

Design Protection Act Article(33)ii

(1) Notwithstanding the provisions of Articles 33 (1) and 46 (1) and (2), the owner of a design right or the applicant for registration of a design may have designs similar only to his/her registered design or the design claimed in the application pending for design registration (hereinafter referred to as “base design”) registered as related designs (hereinafter referred to as “related designs”), only if he/she files an application for registration of such related designs within one year from the filing date of the application for registration of the base design.

<table>
<thead>
<tr>
<th>Order of time</th>
<th>Principle design (A)</th>
<th>Related design (A’)</th>
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</thead>
<tbody>
<tr>
<td></td>
<td>Registered design</td>
<td>Subsequent application</td>
</tr>
<tr>
<td></td>
<td></td>
<td>(within 1 year from the filing date of principle design)</td>
</tr>
<tr>
<td>Antecedent application</td>
<td></td>
<td>Subsequent application</td>
</tr>
<tr>
<td></td>
<td></td>
<td>(within 1 year from the filing date of principle design)</td>
</tr>
<tr>
<td>Application filed on the same date</td>
<td></td>
<td>Application filed on the same date</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>Type of design</th>
<th>Principle design (A)</th>
<th>Related design (A’)</th>
</tr>
</thead>
<tbody>
<tr>
<td>Finished article</td>
<td>Finished article</td>
<td>Finished article</td>
</tr>
<tr>
<td>Component</td>
<td>Component</td>
<td>Component</td>
</tr>
<tr>
<td>Set of article</td>
<td>Set of article</td>
<td>Set of article</td>
</tr>
<tr>
<td>Partial design</td>
<td>Partial design</td>
<td>Partial design</td>
</tr>
</tbody>
</table>
Related Design
Related Design

DM/086172 Electric water kettle
Indication of Products

© Article 40 (One Registration Application for Each Design)

(2) A person who intends to file an application for design registration shall follow the classification of products prescribed by Ordinance of the Ministry of Trade, Industry and Energy.

GUI (Graphic User Interface) is only applicable as a partial design of a whole article, therefore the indication of Products shall be the whole article embedding the partial area for claim.

Recommendations

- display panel with animated graphical user interfaces
- Multimedia Device with GUI
- Icons [for computers]
- Display panel in which Graphical user interface is indicated
- Computer monitor in which Graphical user interface is indicated
Thank You

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