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Contents



CHINA: OFFICE ACTIONS

5 | How to respond to an office action concerning substantive defects of design applications in China

Yanling Zhou of **DEQI Intellectual Property** presents a case study to depict how an applicant should seek to respond to an office action of an obvious substantive defect



INDIA: PATENT CLAIMS

10 | Evaluating the restrictive nature of amending patent claims in India

Archana Shanker and **Aastha Koolwal** of **Anand and Anand** assess the strict interpretation of Section 59 of the Indian Patent Act and explore the limits of claim amendments allowed in India



JAPAN: EXAMINATION

16 | A closer look at the arguments effective for inventive step in the JPO examination

Kenji Tanaka of **Shiga International Patent Office** conducts a statistical analysis of the effectiveness of arguments for inventive step in the Japan Patent Office examination



SOUTH KOREA: ENFORCEMENT

23 | Examining the IP enforcement procedure before the KTC

Kye Young Lee of the **Korea Trade Commission** and **Hyoung Ja Park** of **FirstLaw PC** introduce the remedies that can be sought by IP holders against unfair international trade practices involving IP infringement through the KTC's proceedings

Editorial

Managing IP's 2021 Asia-Pacific IP Focus looks at a series of thought-provoking IP developments across China, India, Japan and South Korea, that have come to the forefront during the past few months.

Interaction with national patent offices is a seminal topic in this guide, as countries respond to the increasing use of enforcement and examinations, while contending with how to react to the changes under IP law.

In June 2021, China's amended patent law came into force, with notable wider protection offered for designs. Through the use of case studies, the article by DEQI Intellectual Property explains how applicants can overcome office actions concerning substantive defects of design applications.

Arguments for inventive step in the Japan Patent Office examination can be categorised into five particular groups: fact finding, matter of design, motivation, obstructive factor and effect. If an applicant can persuade the examiner to accept any one of these arguments, the rejection of inventive step is overturned. Shiga International Patent Office's article presents a statistical analysis of the effectiveness of such arguments in the examination.

The Indian Patent Office has often been seen to interpret Section 59 of the Indian Patent Act in a highly restrictive manner, thus raising barriers to amendment. The authors from Anand and Anand explore the limits of claim amendments in India and call for modification to the rules to reflect global standards.

Through a set of example cases, FirstLaw PC's article outlines the investigation procedure that can be sought by IP holders against unfair international trade practices involving IP infringement through the Korea Trade Commission's proceedings. Corrective measures, penalties and remedies for such infringement are cited in further detail.

As the investment climate bounces back in the Asia-Pacific, IP queries and research and development looks set to grow in the coming year. We hope that you enjoy hearing from the IP experts leading the progression in our Asia-Pacific IP Focus.



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Since foundation in 1985, Y. P. LEE, MOCK & PARTNERS has grown as a leading IP law firm in Korea having over 180 patent attorneys providing services on all IP-related matters.

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How to respond to an office action concerning substantive defects of design applications in China

Yanling Zhou of **DEQI Intellectual Property** presents a case study to depict how an applicant should seek to respond to an office action of an obvious substantive defect

A Chinese design patent application shall undergo preliminary examination before the design patent is granted. The preliminary examination of a design patent application includes the examination of obvious substantive defects of the application documents, and the examination of obvious substantive defects includes the examination of whether it obviously does not comply with Article 2.4 of the Patent Law.

As stipulated in Article 2.4 of the Patent Law (2008 version), ‘design’ means any new design of the shape, pattern, or their combination, or combination of the colour with shape or pattern, of a product, which creates an aesthetic feeling and is fit for industrial application.

In accordance with the provisions of ‘Guidelines for Patent Examination’, for the obvious substantive defects in the application documents that cannot be overcome by means of supplements and corrections, the examiner shall issue an office action, and analyse the fact that there are obvious substantive defects in the application documents, when necessary, in combination with relevant evidence.

In practice, regarding the office action concerning such obvious substantive defects in the sense of Article 2.4 of the Patent Law, it is common for the examiner to

only point out the existence of obvious substantive defects, and it is not common to give analysis in combination with relevant evidence in the office action. In the case of the office action, the applicant needs to make a response by way of a statement of opinions. This article explains, in combination with cases, how to overcome such defects by making a statement of opinions.

Case one

The product involved in the design patent application concerned is a cosmetic applicator, with the classification number of 28-03. The perspective view of the product is as follows:



Perspective view of design application concerned

The office action pointed out that there was a substantial defect: “The content represented by the view of the above application is a design composed of a common shape and structure in the field to which the product belongs and belongs to the conventional design of this type of product, so it is obviously not a new design in the sense of the Patent Law, does not comply with the provisions of Article 2.4 of the Patent Law, and shall not be granted a patent right.”

To make a response to the office action, the applicant provided evidence of prior art in this field, and explained that this design was obviously different from the prior art, and met the requirements of Article 2.4 of the Patent Law. The specific opinions are stated as follows: According to the prior art, the grip part (bottom cover) of this design is in the shape of an octagonal prism, which not only forms an aesthetic feeling, but is also suitable for industrial applications; moreover, the shape of the octagonal prism of the grip part is different from the design shape in the prior art, and belongs to a new design.

“This article explains, in combination with cases, how to overcome such defects by making a statement of opinions.”

In addition, the applicant entrusted the Patent Search and Consultation Center of China National Intellectual Property Administration (CNIPA) to conduct a novelty search for the design application, submitted the search report as proof materials, and compared this design with the most related prior design application number CN201530322890.3 (hereinafter referred to as Reference Design 1) in the search report.



Front view of Reference Design 1

The specific opinions are stated as follows. In the search report, the Chinese design, of which product is titled 'makeup brush', is considered as Reference Design 1 and mainly distinguished from the design concerned in the following:

- Difference in the bristle arrangement at the brush head part: bristles are arranged in clusters in the design concerned, while bristles are arranged in a plane spiral in Reference Design 1.
- Difference in the ratio of the bottom cover to the whole: the bottom cover of the design concerned is shorter, while the ratio of the bottom cover in Reference Design 1 is relatively slender.
- Difference in the shape of the end of the brush rod, the diameter of the design concerned is slightly retracted, while the diameter of Reference Design 1 is the same.
- Difference in the shape of the bottom cover: the outer edge of the design concerned has an octagonal section, while the outer edge of Reference Design 1 has a cylindrical section.

Based on the prior designs retrieved, for eyelash brush products, the shape of the bottom cover, the shape of the brush head, and the shape of the bristles are all concerned by the general consumers. Through overall observation and comprehensive determination, the design concerned and Reference Design 1 are obviously different in the specific design of the bristles and the shape of the bottom cover, which all



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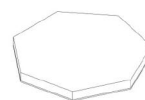
cause significant differences in the overall visual effect of the design. Therefore, the design concerned is significantly different from Reference Design 1, and the difference between the design concerned and other reference designs is more significant.

With the evidence provided and the above statement of opinions in combination with the evidences, the examiner was finally persuaded and the design application was thus granted a patent right.

It can be seen from the above case that the examiner does not combine the evidence for analysis. The applicant may provide the existing technical evidence documents and search report by himself, and compare in detail the difference between the design to be claimed and the existing design to prove that the design is a new design and complies with the provisions of Article 2.4 of the Patent Law.

Case two

The product involved in the design patent application concerned is a trampoline shade cover, with the classification number of 21-02. The perspective view of the product is as follows:



Perspective view of a heptagon shade cover

The examiner thinks that the design is a design composed of a conventional shape and pattern in the field to which the product belongs and is not a new design. In order to prove that the design is a new design, the applicant specially provided the following view of the design in use to illustrate the unique design of the shade

cover of the design.



A view of the heptagonal shade cover in use

The applicant explained in the observation: the uniqueness of the design lies that the design is of the



shade cover for a trampoline, especially as a design of an edge of the shade cover. The edge of the shade cover of this style forms a cover and covers poles of the trampoline, thus forming a unique shade cover. Prior designs of shade covers for a trampoline in the field to which the product of the present application belongs do not have an edge of this style.

In this case, the applicant provided a view of the product in use to illustrate that the field to which the design is applied is a trampoline. The edge of the shade cover for the trampoline matches the top of the trampoline, thereby producing a unique visual effect.

As a result, the examiner was successfully persuaded and the design application was thus granted a patent right. It can be seen from this case that for a design of a component of a product that needs to be used in conjunction with other product, the applicant may consider submitting, when filing the application, a view of the design in use as a reference view, so as to help the examiner determine whether the design is a new design.

Persuading the examiner

It can be seen from the above two cases that an applicant usually needs to respond to a notification of office action of an obvious substantive defect such as those in Article 2.4 of the Patent Law by combining a statement of opinions with evidence. The evidence may take the form of a prior art evidence file, search report, reference view in a use state, etc.

“An applicant usually needs to respond to a notification of office action of an obvious substantive defect such as those in Article 2.4 of the Patent Law by combining a statement of opinions with evidence.”

The content of the statement of opinions focuses on comparing elements of designs in combination with evidence to illustrate a significant difference between the design of the present application and a prior design. Pay special attention to providing as detailed a statement of opinions as possible. Sometimes, if no appropriate evidence is found, it is also possible to explain, in the observation, in detail the design point of a design and how the design point affects the overall visual effect of the design. When necessary, even a reference view in a use state can be submitted to illustrate the design uniqueness of a design product in the field to help the examiner to understand a difference between the design and a conventional shape and structure in the field, so as to achieve the purpose of persuading the examiner.

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Evaluating the restrictive nature of amending patent claims in India

Archana Shanker and Aastha Koolwal of Anand and Anand assess the strict interpretation of Section 59 of the Indian Patent Act and explore the limits of claim amendments allowed in India

Claims determine the extent, territory or scope of protection granted to an invention. The ability to seek claim amendments is a crucial aspect of any patent regime. The reasons for effecting claim amendments can be several, before or after grant of a patent.

Under the Indian Patent Act, Sections 57-59 govern the law for amendment. The permissible amendments include:

- Disclaimer, i.e. amendments which limit the scope of the invention;
- Correction, i.e. correction of an obvious mistake; and
- Explanation (for the purpose of clarification of the scope).

Permissible amendments are of such nature that the amended specification can only claim or describe matter which is already in substance disclosed or shown in the pre-amended specification, and claims of the amended specification should fall wholly within the scope of at least one claim of the specification, as they existed before the amendment was made. Thus, the scope of the amended claims is required to fall within the scope, not of the originally filed disclosure, but of the originally filed claims, at least one claim. In essence, the assessment of whether an amendment to the claims is overreaching permissible limits or not, is performed by comparing the scope of the amended claims with the scope of the originally filed or pre-amendment claims.

An amendment would, therefore, be allowed, only if the amended claim scope lies within the scope of at least one of the unamended claims.

How flexible is Section 59?

Section 59 determines permissible amendments. Accordingly, it stands to reason that the actual flexibility afforded to applicants and patentees seeking to amend claims, would depend to a large extent on the flexibility with which the fetters placed by Section 59 can be interpreted.

Here, there is a reliance upon the application of classic rules of statutory interpretation to the text of Section 59, which finds that Section 59 is squarely couched in negative and prohibitive language leaving little if any scope for ambiguity insofar as the demands of the statute.

The Supreme Court of India, in a series of judgments, has held that a provision is couched in prohibitive or negative language, it can rarely be directory, and that the use of peremptory language in a negative form is *per se* indicative of the intent that the provision is to be mandatory (Crawford, the Construction of Statutes pp. 523-24). Owing to the mandatory nature of Section 59, the construction of claim scope assumes a very important role in any amendment exercise.

Since the majority of issues, particularly in relation to amendments, are 'scope of the claims', one needs to first determine what the said expression entails. The 'scope' of a patent has been defined in Black's Law Dictionary as "the boundaries or limits of the invention protected by the patent, which are not matters of metes and bounds and can never be defined in the definite sense employed in thinking of physical things, but must be determined by methods based upon established principles of patent law. *Smith vs Mid-Continent Inv Co*, CCA Mo, 106 F.2d 622, 624." The scope of a patent is doubtlessly equivalent to the scope of the claims of the patent which, as is well-settled under Indian law, define the territory or scope of the invention for which protection is claimed (Section 10(4)(c) of the Patents Act, 1970).

Real world observations

The mandatory fetters applicable to amendments lead to a variety of outcomes for different types of amendments and have different potential reactions of the Indian Patent Office (IPO):

Merging of claims

This is usually allowed within the confines of Section 59 and it has the effect of a disclaimer and introduces a limitation/restriction of the scope of the invention.



Introducing subject matter from the description into an existing claim

This is usually permissible as introduction of a feature from the description and reduces the scope of the invention and can be considered as being a disclaimer. While amendment(s) to pending claim(s) based on contents of the specification do usually get allowed, the decision-making lacks uniformity and may vary from the controller to controller.

Claim deletion

This is allowed, as it does not expand the claim scope at all. This is different from the deletion of any particular limitation from a claim, which might enlarge claim scope and may therefore not be allowed.

Addition of claims

In general, voluntary addition of claims dependent or independent, requires a subjective and not an objective test to assess as to whether the original 'scope of claims' is enlarged or narrowed within the meaning of Section 59.

Adding independent claims

Addition of independent claims to cover different aspect of the invention should they fall within the broadest scope of the originally filed claims ideally is permissible as the 'scope' of the claim is not altered and the said addition can be considered as being by way of explanation. This, however, is not always how the assessment is made.

Adding dependent claims

Dependent claims enable the applicant/patentee to define the invention and its scope broadly covered in an existing claim.

While the intended scope of claims can be understood with the help of preferred embodiments described in the specification, a dependent claim adds a further element to a claim or modifies and further defines an element that is already present in a claim, providing better and clearer coverage and ensuring a balance between specificity and span of claimed protection.

A dependent claim is by definition narrower in scope than the claim upon which it is dependent, since it adds at least one additional limitation to the scope of the latter. In line with Section 59, as long as a new claim does not seek to enlarge the scope of the claim and only restricts the scope of the claim which it is dependent



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Archana studied law at Delhi University and holds postgraduate diplomas in bioinformatics and pharmaceutical regulatory affairs. She is a registered patent agent and a member of Delhi High Court Bar Association and Delhi Bar Council.

upon, an objection against such an amendment ought not to be raised, assuming the other conditions enumerated in Section 59 are also satisfied. This is a disclaimer in a real sense.

Unfortunately, however, such amendments attract Section 59 objections from the IPO on a regular basis, which often leave the applicant either with severely limited options, if any, despite the invention disclosed therein being worthy of patent protection (or in the case of a granted patent, to settle for lesser clarity and specificity in claims, potentially making them harder to assert).

Case law deciphering Section 59

Some guidance from Indian courts and tribunals has been gathered from their various judgments interpreting Section 59.

In a recent judgment of the IPO, the controller objected to the addition of new claims highlighting that this was a voluntary amendment, whereby claims were amended by way of addition, and therefore would be barred Section 59 (1) of the Act. The Intellectual Property Appellate Board (IPAB) in appeal (OA/48/2020/PT/DEL) stated that to hold that "the function of the claims is to define clearly and with precision the monopoly claimed, so that others may know the exact boundaries of the area within which they will be trespassers. Their primary object is to limit and not to extend the monopoly. What is not claimed is disclaimed... A patentee who describes an invention in the body of a specification obtains no monopoly unless it is claimed in the claims."

The IPAB, while agreeing that it was a settled principle of law on amendment of claims that no new claim may be allowed, with respect to two of the three claims in question, held that said claims could "not be construed as 'new' claim insertions, since they were just qualifying and limiting the scope of the already defined subject matter of the independent claim. No

new feature(s), which was present in description but not claimed earlier, is being claimed through these claims."

In *AGC Flat Glass Europe vs Anand Mahajan*, the Delhi High Court allowed post-grant claim amendments where a feature was included into the claims from the

description sought on the grounds that they were clarificatory in nature and that they do not alter the scope of the claim which was not present in the original invention.

Insofar as the effect of a dependent (new or pre-existing claim) is concerned, the division bench of the Delhi High Court in *F Hoffmann-La Roche Ltd & Anr vs CIPLA Ltd* held as follows: “where claims are ‘dependent’ it incorporates by reference ‘everything in the parent claim, and adds some further statement, limitations or restrictions.”

Further, on this very same issue, Clause 05.03.16 (q) at page 43 of the Manual of the Patent Office practice and procedure clearly states that “a dependent claim derives antecedence from an independent claim and reads into it the features of the independent claim and may contain additional non-essential features and even the minute aspects and optional features.”

Therefore, when claims are dependent claims, it incorporates by reference everything in the parent claim, and adds some further statement, limitations or restrictions. Therefore, there is no reason for new dependent claims being disallowed in such circumstances.

Position pertaining to claim amendments in major patent jurisdictions: US and the EU

While the underlying understanding across jurisdictions is that an applicant should not be allowed to improve his position by adding a subject matter not disclosed in the application as filed, the approach followed by the patent office slightly varies from strict to liberal.

Article 123 of the European Patent Convention (EPC) relates to amendments. As with the Indian practice, a European patent application may not be amended in such a way that it contains a subject matter which extends beyond the content of the application as filed. Also, when making amendments it is essential to find support within specific paragraphs of the application, as filed.

The test in the EU is whether the amendment is clearly and unambiguously derivable from the application, as filed. Although using exact wording is not actually a requirement of European law, examiners are often seen to interpret the rule strictly, and by using exact wording, if possible, make prosecution easier.

While an objection to claim amendments may be



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raised by the United States Patent and Trademark Office (USPTO) and European Patent Office (EPO), such an objection would be far more common before the EPO than the USPTO. This is because in the US patent examination system, the examiner bears the initial burden of making a case that the amendments cannot be derived from the original disclosure.

In the US, the written description requirement in 35 USC 112(a) prevents claim amendments that introduce ‘new matter’ into the disclosure of the invention. To satisfy this requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention.”The proscription against the introduction of new matter in a patent application ... serves to prevent an applicant from adding information that goes beyond the subject matter originally filed” (MPEP, 2163, I, B). There is no prohibition on adding new claims or limitations if the newly added claims or claim limitations are supported in the specification through express, implicit, or inherent disclosure.

As discussed above, it appears that both the EPO and the USPTO require claim amendments to be directly derivable from the original application. The EPO additionally also requires the claim amendments to be unambiguously derivable. Nonetheless, neither jurisdiction imposes the limitation No. 4 on the in-

fringer, which curtails the ability of applicants to get their desired coverage and claim scope.

The additional requirement of the amended claim falling within the unamended claim scope is also

“The scope of a patent is doubtlessly equivalent to the scope of the claims of the patent.”

“It is unjustifiable in this day and age for India to not embrace the harmonisation of patent laws.”

onerous to international applicants and patentees which file applications in multiple jurisdictions and for who would, as far as possible, prefer to harmonise the amendments they are making to their applications throughout the world.

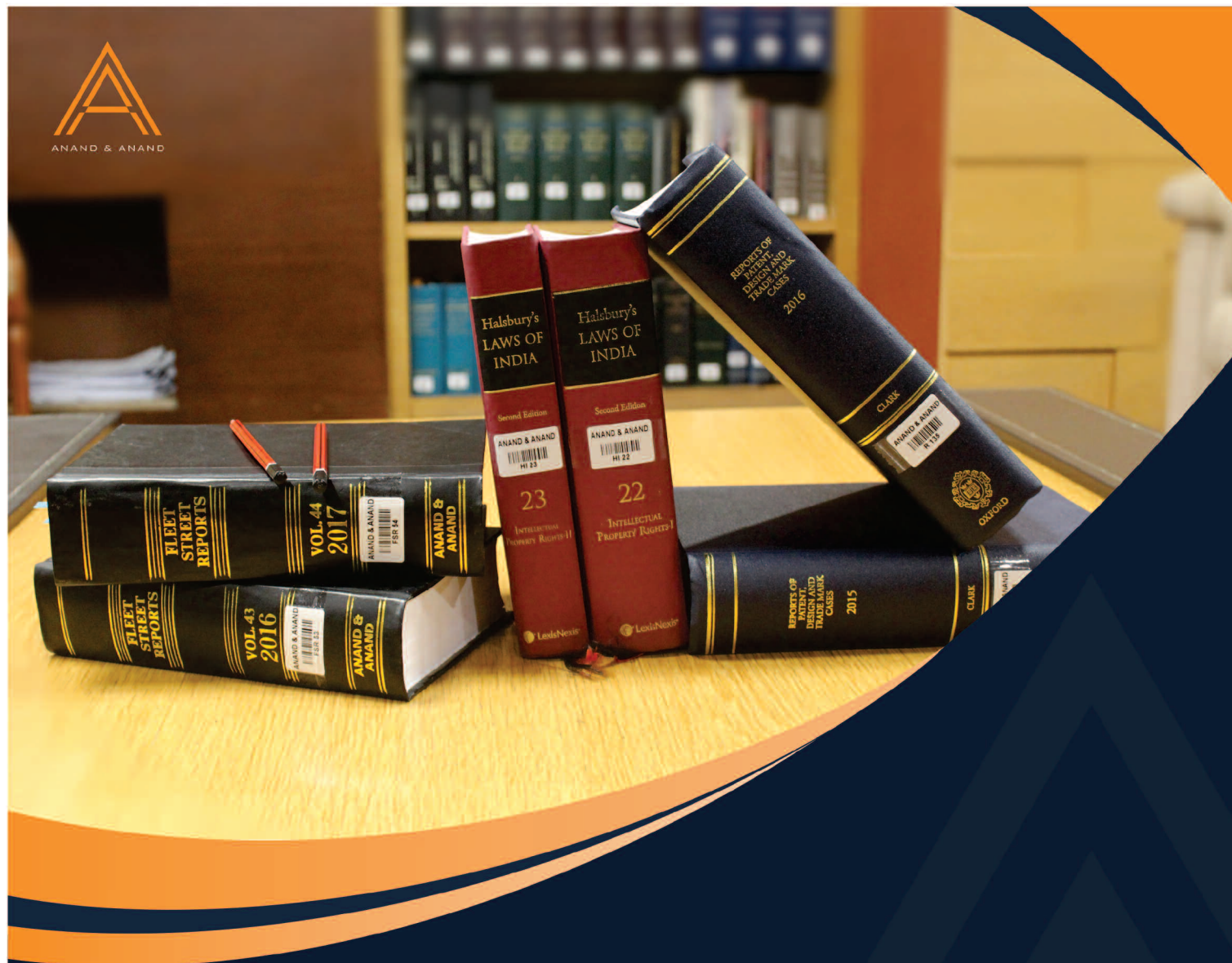
Need for modification of the Indian legal position

The present approach followed under Indian law towards claim amendments is not fully harmonised with the rest of the world. For starters, the decision-making surrounding allowing or rejecting proposed amendments to claims ought to be more subjective than objective.

The complete bar on the addition of claims, independent or dependent, can cause incomprehensible prejudice and harm to applicants. However, even if the added claims are clearly within the original disclosure and the original scope of claims, applicants continue to face objections. This decision of the IPO seems not to be based on ‘determination of scope of the claims’ but on the ‘existence of a claim in the original set’.

As per the Justice Ayyangar Committee Report on Patents of 1959 notes, the ultimate goal of the fetters placed on amendment of claims appears to be to ensure that the process of amendment of claims cannot be used by an applicant to gain a larger monopoly than it already claims. Therefore, an applicant should be allowed to bring claims which indeed cover their invention, are disclosed in the specification, and satisfy the patentability criteria even though they may not have been initially claimed. It is unjustifiable in this day and age for India to not embrace the harmonisation of patent laws, and tone down its requirements for an amendment to be allowed.

It is no secret that the IPO often interprets Section 59 in a highly restrictive manner, limiting the kind of amendments that an applicant can carry out. This leaves practitioners to wonder if the flurry of Section 59 objections is the result of strict interpretation, and that there is a need to now apply the real test, which is to determine scope of a claim.



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A closer look at the arguments effective for inventive step in the JPO examination

Kenji Tanaka of **Shiga International Patent Office** conducts a statistical analysis of the effectiveness of arguments for inventive step in the Japan Patent Office examination

The applicant can make arguments from several viewpoints against a lack of inventive step indicated in an office action. However, whether such arguments can persuade an examiner is assessed on a case-by-case basis. This article explores statistical analysis on the effectiveness of arguments for inventive step in the Japan Patent Office (JPO) examination.

Five categories of arguments for inventive step in Japan

In this article, arguments without amendments for inventive step in Japan are categorised into five groups as follows.

1) Fact finding

Arguing that an examiner's interpretation of the present invention, the cited invention(s), and/or the combined invention of the cited inventions is incorrect

2) Matter of design

Arguing that a feature of the present invention which is not disclosed in the citation(s) is not a matter of design which a skilled person could have made appropriately

3) Motivation

Arguing that there is no motivation to combine the primary citation and the sub citation(s) to arrive at the present invention

4) Obstructive factor

Arguing that there is an obstructive factor against combining the primary citation and the sub citation(s)

5) Effect

Arguing that the present invention results in an unexpected and advantageous effect over the cited inventions

If the applicant can persuade the examiner to accept any one of these arguments, the rejection of inventive step is overturned.

In this article, it is assumed that arguments (3) and (4) can be made only if the examiner cites a primary citation and a sub citation(s).

If the examiner indicates a lack of inventive step with reference to only one citation (a primary citation), it means that the examiner considers that the difference between the present invention and the primary citation is merely a matter of design which a skilled person could have made appropriately. In such a case, the applicant can make arguments (1), (2), and (5).

If the examiner cites two or more citations (a primary citation and a sub citation(s)), and indicates that all the features of the present invention are disclosed in the citations, the applicant can make arguments (1) and (3) to (5).

If the examiner cites two or more citations and although there is still a remaining feature of the present invention which is not disclosed in any citations, the examiner considers that the remaining feature is merely a matter of design. In such a case, the applicant can make arguments (1) to (5).

Analysis on effectiveness of arguments

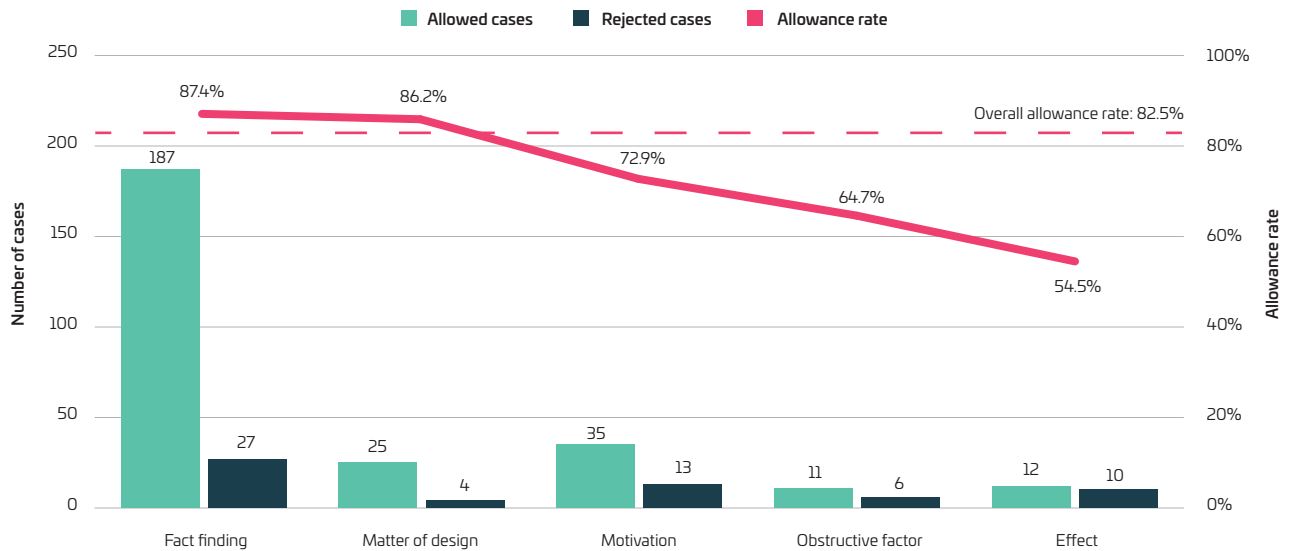
The subject of this analysis is 716 Japanese patent applications, which satisfy the following conditions (a) to (f):

- a) A request for substantive examination was filed from January to June in 2018
- b) No amendments were filed until an examination decision was issued
- c) The examiner indicated only a lack of inventive step in the first office action
- d) The applicant filed only remarks without amendments in response to the first office action
- e) A decision of allowance or rejection was issued after the response to the first office action without issuance of a second office action
- f) It is not a divisional application or an application originating from a utility model application

Although the applicant can make two or more of



Figure 1: The numbers of cases for which the applicant made only one category of argument and the allowance rate



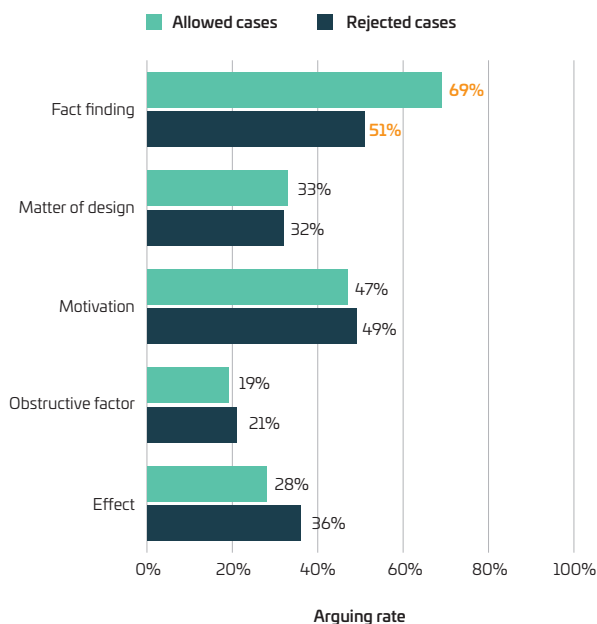
arguments (1) to (5), a decision of allowance does not include a specific explanation regarding allowance. Therefore, it is difficult to determine which argument was effective for persuading the examiner.

Accordingly, the cases for which the applicant made only one category of argument are first extracted. Fig. 1 shows the numbers of the allowed cases and the rejected cases for which the applicant made only one category of argument and the allowance rate for each argument category.

The allowance rates for categories (1) and (2) are greater than the overall allowance rate of 716 cases, which was 82.5%. Meanwhile, the allowance rates for categories (3) to (5) are less than the overall allowance rate. Accordingly, it is speculated that argument categories (1) and (2) are effective for persuading the examiner to some extent.

However, the numbers of cases for categories (2) to (5) are too small to extract a more specific trend. Thus, a statistical analysis on the 716 cases is carried out.

Figure 2: Arguing rate for allowed cases and rejected cases in each argument category



Here, an 'arguing ratio' has been calculated for each argument category. Specifically, for each argument category, (i) in how many cases the applicant made the category of argument among all the allowed cases (arguing rate for the allowed cases); and (ii) in how many cases the applicant made the category of argument among all the rejected cases (arguing rate for the rejected cases) are calculated. Fig. 2 shows the arguing rate for the allowed cases (upper, light green bar) and the arguing rate for the rejected cases (lower, dark green bar) for each of argument categories (1) to (5).

For category (1), the applicant made arguments against fact finding in 69% of the allowed cases and 51% of the rejected cases. According to Pearson's chi-square test with a significance level of 5%, a statistically significant correlation can be found between whether the applicant made arguments against fact finding and whether the application was allowed.

Meanwhile, no significant correlation can be found between the arguments in the remarks and the examination results for the other categories of arguments.

Fig. 3 shows the breakdown of arguments against fact finding into four subgroups. The 'present invention'

JAPAN: EXAMINATION



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Kenji specialises in secondary batteries, semiconductor devices, display devices, medical equipment, and inorganic materials. He has conducted research on metal oxides such as reduced titanium oxide and nanoparticles thereof, for example, an experimental and computational discussion on electron state and spin state with first-principles calculation.

Kenji is a graduate of the University of Tokyo, and regularly writes on related IP topics in publications.

means the applicant's argument that the examiner incorrectly interprets the claimed invention of the present application. The 'primary citation' means the argument that the examiner incorrectly interprets the primary citation. The 'sub citation(s)' means the argument that the examiner incorrectly interprets the sub citation(s). The 'combined invention' means the argument that the examiner's judgment that the constitution of the present invention is obtained by combining the cited inventions is incorrect.

Among them, a significant correlation can be found between the applicant's arguments of 'sub citation(s)' and the examination results. In other words, if the applicant argues that the examiner's interpretation of the sub citation(s) is wrong, the application is more likely to be allowed.

In the allowed cases in which the applicant made arguments on the fact finding of the sub citation, many applicants argued that the examiner inappropriately interprets the sub citation, in particular that the examiner inappropriately generalises the disclosure of the sub citation.

In general, the examiner sometimes refers to only a small portion of a sub citation to complement the difference between the present invention and the primary citation. In such a case, the interpretation of the sub citation is likely to be less strict than that of the primary citation. Accordingly, the applicant should check whether the technical matter extracted from the sub citation can complement the difference between the present invention and the primary citation for sure, and

Figure 3: Breakdown of arguments against fact finding

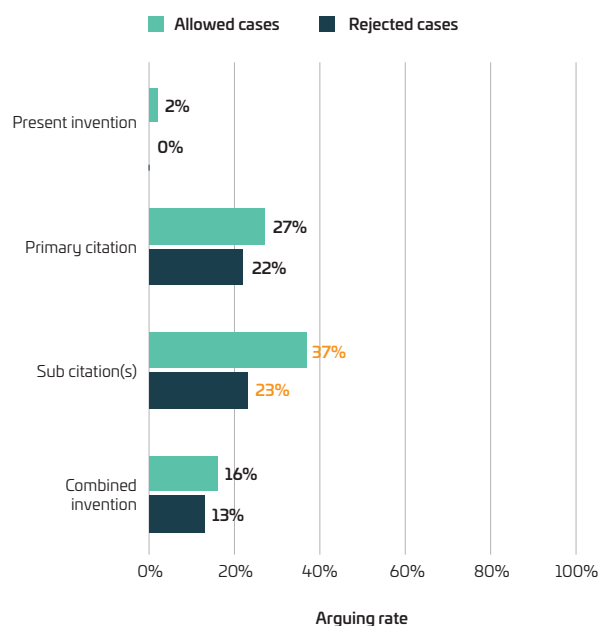


Figure 4: Arguing rate of arguments against fact finding for each technical field

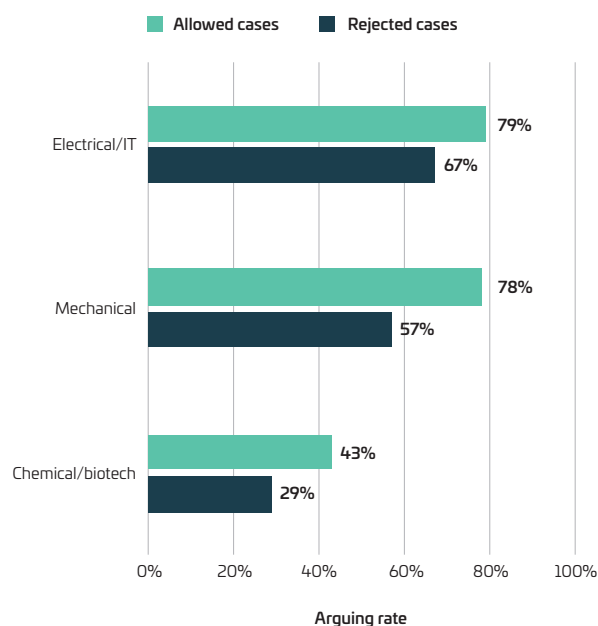
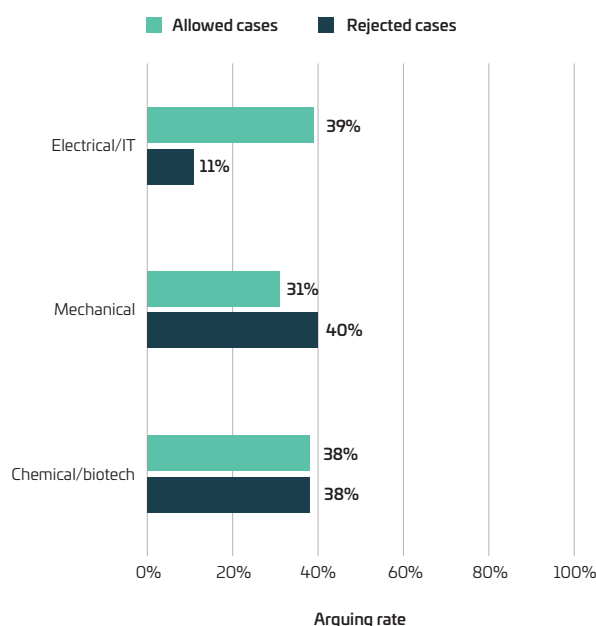


Figure 5: Arguing rate of arguments on matter of design for each technical field



whether the examiner correctly interprets the description of the sub citation in light of the entire disclosure including the problem or mechanism of the invention. The applicant should suspect that the examiner might conveniently generalise the invention of the sub citation.

Statistically speaking, checking the examiner's indications about the sub citation is the most important procedure for making arguments for inventive step without amendments.

Differences depending on technical fields

Effectiveness of arguments for each technical field, which is divided in accordance with the examination section of the JPO, has also been analysed. 127 electrical/IT cases, 279 mechanical cases, and 181 chemical/biotech cases have been statistically analysed.

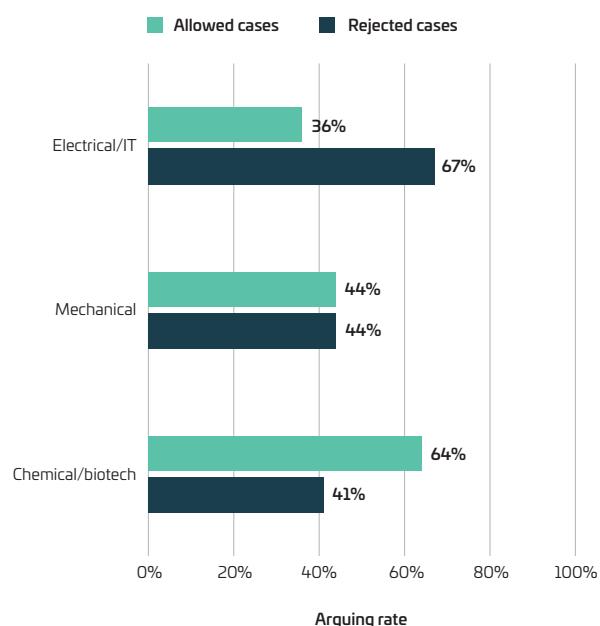
Fact finding

For all of the three technical fields, the arguing rate of fact finding in the allowed cases is higher than that of the rejected cases as shown in Fig. 4.

In particular, for the electrical/IT field and the mechanical field, a significant positive correlation has been found between the applicant's arguments on interpretation of a sub citation(s) and the examination results. In other words, the rejection of inventive step is likely to be overturned in the electrical/IT and mechanical fields if the applicant logically points out the examiner's incorrect interpretation of a sub citation(s).

On the other hand, for the chemical/biotech field, the arguing rate in both the allowed cases and the rejected cases is much lower than that of the electrical/IT and

Figure 6: Arguing rate of arguments on motivation for each technical field



mechanical fields. This may suggest that the examiner is less likely to misunderstand the inventions because the chemical/biotech inventions are likely to be specified more clearly, e.g. by the name or chemical structure of compounds, than the electrical or mechanical inventions.

Matter of design

As to arguments on matter of design, it is noteworthy that the arguing rate in the allowed cases are greater than that of the rejected cases in the electrical/IT field as shown in Fig. 5.

In particular, in many cases, the examiner's indication that the difference between the present invention and the cited invention is merely a matter of design was overturned by the applicant's argument that the difference has a remarkable technical significance.

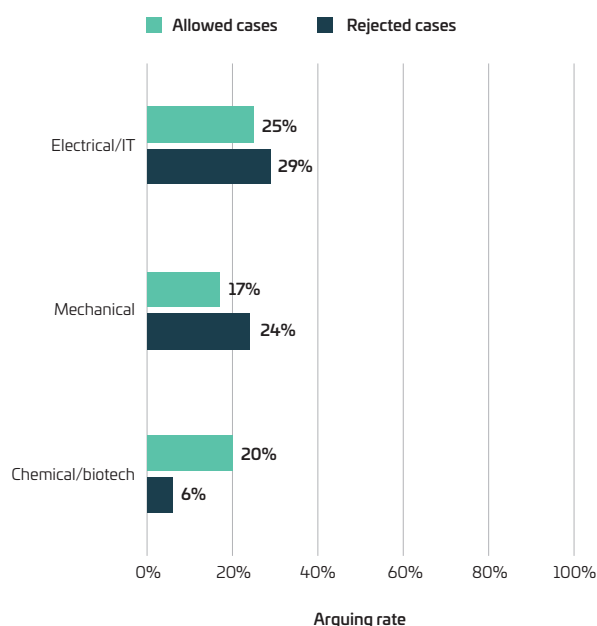
Therefore, in the electrical/IT field, if the examiner indicates a lack of inventive step with the logic of a 'matter of design' for the difference, the applicant should consider explaining in detail the technical significance of the difference, such as novelty of a problem of the present invention or remarkability of a technical effect.

Motivation

The tendency of the arguing rate of motivation has been found to depend on the technical field. As shown in Fig. 6, it seems that arguments on motivation are much more effective in the chemical/biotech field than in the electrical/IT field.

In Japan, generally speaking, a 'motivation' to combine a primary citation with a sub citation(s) is required for

Figure 7: Arguing rate of arguments on obstructive factor for each technical field



the examiner to deny inventive step. A motivation is, for example, the similarity of technical field, problem, and function between the primary citation and the sub citation(s) or between the present invention and the cited invention(s), or teaching in the citation(s).

In the electrical/IT field, the JPO examiner is likely to consider that there is a motivation for a skilled person to combine a known configuration A and a known configuration B to obtain the combined configuration A+B unless there is a specific obstructive factor. Accordingly, the applicant's arguments on a motivation are less effective in the electrical/IT field than the other technical fields.

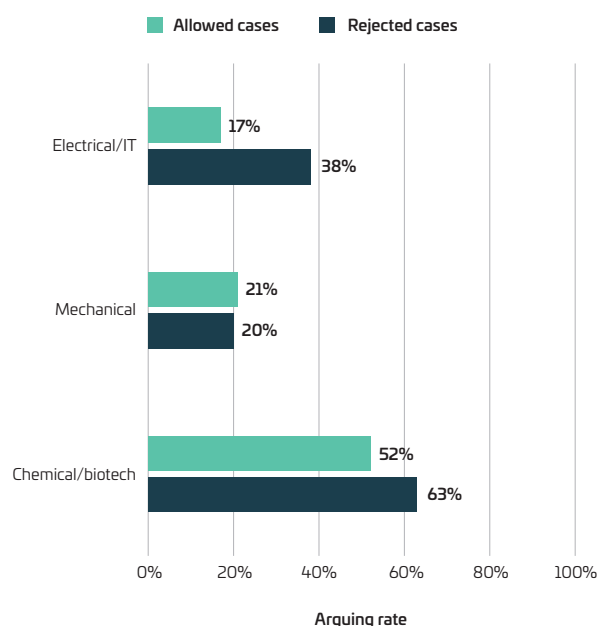
On the other hand, it seems that arguments on a motivation are effective in the chemical/biotech field, in which an unpredictable and experimentally-confirmed effect is often considered in judgment of inventive step. Since such an unpredictable effect can be linked to a 'novel' problem, the applicant can argue that the citations fail to disclose the novel problem of the present invention and thus there is no motivation for a skilled person to conceive of the present invention from the cited invention(s).

Obstructive factor

The effectiveness of arguments on an obstructive factor depends on the technical field as well. As shown in Fig. 7, the arguing rate in the allowed cases is greater than that of the rejected cases only in the chemical/biotech field.

An obstructive factor is likely to be argued in relation to the problem of the invention. For example, one of the typical arguments on an obstructive factor is that if the configuration of the sub citation(s) is applied to

Figure 8: Arguing rate of arguments on effect for each technical field



that of the primary citation, the problem of the primary citation cannot be solved and thus a skilled person could not have easily applied the sub citation(s) to the primary citation. Since the examiner is likely to consider the problem in the chemical/biotech fields as discussed above, arguments on an obstructive factor may be more effective in the chemical/biotech field than the other fields.

Effect

As shown in Fig. 8, effectiveness of arguments on a technical effect of the present invention has not been found in any technical fields.

It is thought that the examiner considers technical effect in drafting a first office action, and thus the applicant's arguments on the effect are less effective than the other arguments.

Summary

Arguments for inventive step in Japan have been categorised into five groups, (1) fact finding, (2) matter of design, (3) motivation, (4) obstructive factor, and (5) effect, and the effectiveness thereof has been statistically analysed.

Without amendments, it seems that the most effective argument is pointing out the examiner's wrong interpretation, in particular interpretation of the sub citation(s). Moreover, the technical field dependency of each argument has also been found.

More detailed analysis is presented in Japanese as "Effectiveness of arguments for inventive step in JPO examination", Patent, the JPAA, Vol. 74, No. 7 (2021): 74-84.



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Examining the IP enforcement procedure before the KTC

Kye Young Lee of the Korea Trade Commission and Hyoun Ja Park of FirstLaw PC

introduce the remedies that can be sought by IP holders against unfair international trade practices involving IP infringement through the KTC's proceedings

Overall structure of the KTC

The Korea Trade Commission (KTC) is a quasi-judicial agency in the Ministry of Trade, Industry and Energy, established under the Act on the Investigation of Unfair International Trade Practices and Remedy against Injury to Industry (Unfair Trade Investigation Act: UTIA) for the purpose of protecting domestic industries from unfair international trade practices, such as dumping, subsidised importation and the infringement of IP rights.

The KTC is composed of one chairperson and eight commissioners, and is supported in its administrative work by the Office of Trade Investigation, which consists of four divisions: Trade Remedy Policy Division, Damage Determination Division, Dumping Investigation Division and Unfair Trade Investigation Division.

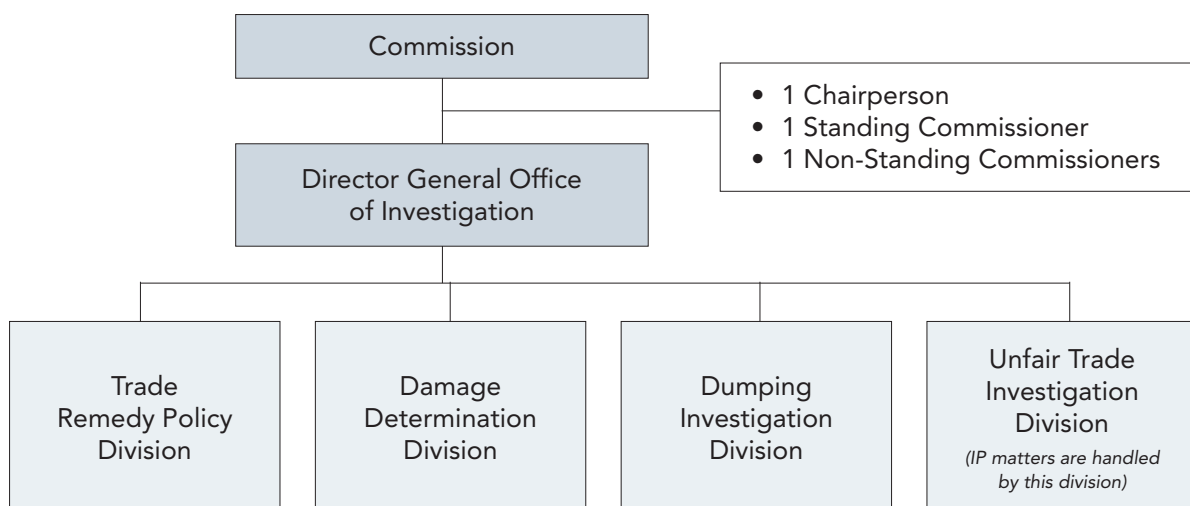
Among the four, the Unfair Trade Investigation Division handles unfair trade activities resulting from IP

infringement. The functions of the Unfair Trade Investigation Division are (i) to investigate unfair international trade practices, such as the infringement of IP rights, violation of rules of origin and other practices liable to disrupt good order in international trades; and (ii) to investigate the impact of international trades on the competitiveness of domestic industries.

Trade remedy measures

Trade remedy (TR) measures are means for protecting domestic industries under the WTO agreements, the UTIA and the Customs Act. In cases where domestic industries are suffering or are likely to suffer serious injuries as a result of unfair international trade practices, the injured parties may file a petition with the KTC seeking (i) levy of anti-dumping duties; (ii) imposition of countervailing duties; (iii) implementation of safeguard measures; or (iv) investigation of unfair international trade practices.

Figure 1: Organisation of the KTC



SOUTH KOREA: ENFORCEMENT

According to the statistics on TR measures, there have been 598 petitions (180 for anti-dumping duties, 34 for safeguard measures and 384 for unfair international trade practice investigations) filed for TR measures through May 2021 and the KTC decided to take TR measures for 294 petitions (133 for anti-dumping duties, 22 for safeguard measures and 139 for unfair international trade practice investigations).

Investigation of unfair international trade practice

Among the above TR measures, the fourth type of TR measure, i.e. investigation of unfair international trade practices, is used against the exporting or importing of IP infringing goods, as explained in detail below.

Types of unfair international trade practices

Unfair international trade practices are defined under Article 4(1) of UTIA as follows:

- i) Infringement of IP rights by importing goods violating IP rights into Korea, selling such imported goods domestically, exporting goods violating IP rights, or manufacturing such goods domestically for export;
- ii) False or misleading markings of origin by exporting or importing goods whose marks of origin are false, misleading, damaged or modified, or goods subject to origin markings but whose origins are not marked;
- iii) False or exaggerated markings of quality of exported/imported goods; and
- iv) Disrupting export/import by exporting or importing goods significantly different from those detailed in the contract to cause disputes.



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Kye Young Lee is a patent attorney and partner at FirstLaw PC. Her practice covers a variety of IP matters ranging from prosecution, litigation to due diligence.

Kye Young has extensive patent prosecution experience in electrical/software fields such as computer software, artificial intelligence, big data, wireless communication, electronic transaction, and semiconductors. She has been recently appointed as a commissioner of the Korea Trade Commission and expects to be actively involved in investigation of unfair trade practices associated with IP infringement for the three-year term.

Kye Young received her bachelor's degree in computer science and statistics, and then completed a master's degree in computer science, from Seoul National University. She also completed her LLM degree at the University of Southern California, Gould School of Law. She has been admitted to the Korean Patent Bar and the California State Bar.

Procedure for unfair international trade practice investigation

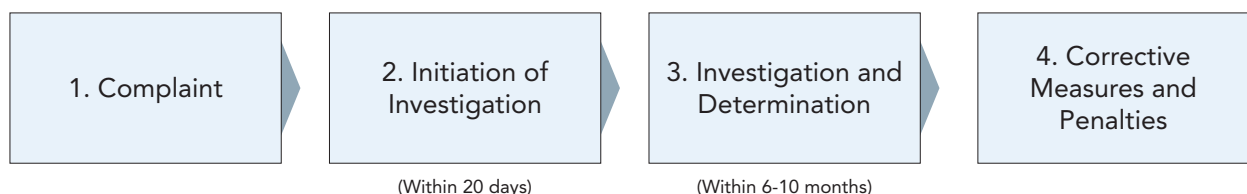
Anyone may file a petition for the investigation of unfair international trade practices with the KTC within two years from the occurrence of the act of unfair international trade. The KTC may also undertake an *ex officio* investigation, if necessary, when there is a reasonable suspicion of unfair international trade practices.

The petitioner should show that (i) the petitioner's IP rights remain valid and in force; (ii) the petitioner's IP rights have been infringed by the respondent; (iii) the respondent has conducted activities corresponding to the unfair trade practices, e.g. exporting, importing, etc.; and (iv) the activities were conducted within two years prior to the filing of the petition.

Circumstantial evidence may be sufficient for initiating the investigation by the KTC, since more concrete evidence on the infringing activities can be later supplemented by the request of the KTC to the Korea Customs Service (KCS). The KTC shall decide whether to commence the investigation within 20 days from the date of filing (Article 5 of the UTIA).

In case there appears to be irrevocable harm or a likelihood of irrevocable harm caused by unfair trade activities, the KTC may issue temporary relief in the form of cease-and-desist orders, including injunctions against export, manufacturing, import, sales of imported products and seizure/exclusion orders against the products, parts/raw materials and/or manufacturing facilities (Article 7 of the UTIA). In this connection, in

Figure 2: Investigation procedure



SOUTH KOREA: ENFORCEMENT



order to discourage frivolous requests for temporary relief, the petitioner is required to post a bond equivalent to the value of the expected sales amount of the infringing goods for a period of six months upon the grant of temporary relief (Article 8 of the UTIA).

The KTC shall promptly complete the investigation within six months from the commencement decision, but the investigation period may be extended twice for up to four months, (i) where a lawsuit or patent trial associated with the unfair international trade act under investigation is pending; (ii) where the petitioner or the respondent requests an extension by presenting justifiable ground(s); and (iii) in other cases deemed necessary to extend the period for unavoidable reason(s) (Article 9 of the UTIA). Therefore, it normally takes six to 10 months from commencement to reach a final decision.

Corrective measures and penalties

If there is a finding of unfair international trade practice, the KTC may issue an order for corrective measures and/or impose penalty surcharges. The corrective measures include (i) cease-and-desist orders to stop activities of unfair international trade practice; (ii) orders to prohibit entry into the market and destroy goods in stock; (iii) orders to publish an apology advertisement; (iv) orders to publicise the KTC's corrective orders; and (v) other necessary measures to correct unfair international trade practices (Article 10 of the UTIA).

Any party who violates an order for temporary relief or corrective measures shall be punished by imprisonment of up to



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Hyoun Ja Park is a partner and patent attorney at FirstLaw PC, which she joined in 1997. Her areas of technical expertise covers various aspects of electrical engineering including wireless communication, artificial intelligence, robotics, e-commerce, computer software, and semiconductors.

Being admitted to the Korean Patent Bar and the Ohio State Bar, Hyoun Ja has been actively involved not only in many important prosecution cases but also high-profile trial/litigation cases on behalf of domestic and multinational corporations. Her practice also encompasses IP due diligence, evaluation, licensing, portfolio development and management.

Hyoun Ja received her bachelor's and master's degrees in control and instrumentation engineering from Seoul National University. She obtained her JD degree at the Ohio State University, Moritz College of Law.

three years or a fine not to exceed 30 million won (approximately \$26,115) (Article 40(2) of the UTIA).

The KTC may impose upon the relevant actors (i) a penalty surcharge not exceeding an amount equivalent to 30% of the annual transaction amount averaged for the recent three years when the unfair international trade practices involve activities of infringement of IP rights, false or exaggerated markings of quality and disrupting export/import; and (ii) a penalty surcharge not to exceed 300 million won when the unfair international trade practices involve false or misleading markings of origin (Article 11 of the UTIA).

Any party who objects to the KTC's disposition may raise an objection to the KTC within 14 days from the notification of such disposition in case of temporary relief, or within 30 days from the notification of such disposition in case of corrective measures and penalty surcharge.

The KTC shall render a decision within 60 days from the opposition, and this period may be extended for up to 30 days if the decision cannot be made due to unavoidable circumstances, such as submissions of new evidence during the investigation. The party who raises an objection may file an administrative appeal before the administrative court, separately from the objection (Article 14 of the UTIC). However, the KTC decision is enforceable unless the court hearing the administrative action renders an order suspending the enforcement of the KTC decision until the outcome of its decision in the pending appeal case.

Advantages of the KTC proceedings for IP infringement

The KTC proceedings are often quick, simple and cost-effective since the petitioner can obtain the decision within about 10 months from the date of the commencement of the investigation. In particular, the KTC proceedings can be useful to secure early relief against the trafficking of goods infringing IP rights across the border, although the rights holder may eventually have to initiate court proceedings to recover damages.

The KTC's corrective measure of a cease-and-desist order will have the same effect as a preliminary injunction; and, if it is not lifted during the appeal process, will have the same effect as a permanent injunction.

“Any party who violates an order for temporary relief or corrective measures shall be punished by imprisonment of up to three years or a fine not to exceed 30 million won.”

Once the KTC finds infringement of IP rights with respect to the accused goods, an order of the KTC to prohibit entry into the market of the infringing goods can be effectuated to other parties dealing in the same goods, regardless of the name of the provider, importer, or seller thereof, through the simple procedure of having the KTC acknowledge that the goods dealt in by these entities are identical to the infringing goods.

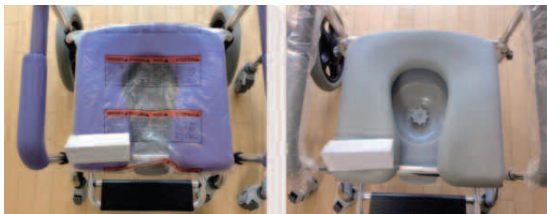
In practice, the KTC requests the KCS to provide information on the imported amount of the accused goods during its investigation. Therefore, such information is useful in determining the amount of monetary damages in a future main action.

The customers of the accused product, who wish to receive a stable supply of such goods, will be definitely affected by the prompt and strong effect of the KTC decision.

Example cases

Here are some example cases involving IP rights infringement for which an investigation of unfair international trade practice was carried out and an order for corrective measures was issued by the KTC.

Bath stool case: patent and design infringement

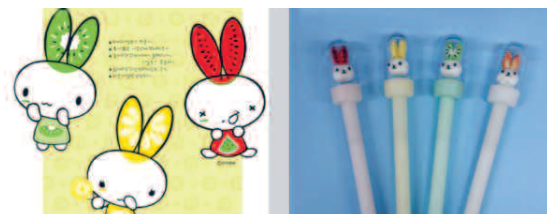


The petitioner, the owner of a patent and a design right on a bath stool, filed a petition for an unfair international trade practice investigation with regard to the respondent's activities of importing, from Taiwan, bath stools allegedly infringing its patent and design rights.

The KTC decided to initiate the investigation and carried out a review of relevant documents/evidence, as well as on-site inspections for about four months.

The KTC found that the respondent's activities constituted the unfair international trade practice of infringing the petitioner's patent and design rights, and issued an order to cease the export/import of the accused goods, destroy the accused goods, and publicise the KTC's disposition of corrective measures (January 30 2018).

Gel pen case: copyright infringement



“The KTC’s corrective measure of a cease-and-desist order will have the same effect as a preliminary injunction.”

The petitioner is a copyright holder for ‘fruits rabbit’ characters, which are rabbit figures featured with fruit-shaped ears, and the respondents imported, from China, gel pens characterised by rabbit figures with fruit-shaped ears.

The KTC conducted an investigation for six months and rendered a decision that the respondents’ importation of gel pens constituted an unfair international trade practice by infringing the petitioner’s copyright.

The KTC ordered the respondents to cease export/import of the accused goods and publicise the KTC’s disposition of corrective measures, and also imposed penalty surcharges (December 11 2019).

Snack case: trademark infringement



The petitioner owns a registered trademark for a snack, formed by a combination of two words written in a unique font type. The respondents manufactured a similar snack in Korea and exported same to Vietnam, under similar trademarks.

The KTC carried out an investigation for six months and decided that the respondent’s trademarks infringed upon the petitioner’s registered trademark, and the respondents’ activities of manufacturing and exporting the snack with the infringing marks constituted unfair international trade practice.

The KTC ordered the respondents to cease exporting the goods as well as manufacturing the goods for the purpose of exportation, destroy the goods in stock, and publicise the KTC’s disposition of corrective measures, and also imposed penalty surcharges (February 6 2020).



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