

Intellectual Property Rights Primer for Korea

A Guide for UK Companies

Hunter Rodwell Consulting
in partnership with Rouse & Co. International

Fast track to the world ^{UK}

ABOUT THE AUTHORS AND SPONSORS

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Consulting*



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Rouse & Co. International, which has contributed legal and technical advice for the guides in this series, is a global intellectual property consultancy, providing the full range of IP services to many of the world's major IP owners. It operates from 17 offices in 11 countries worldwide and is regularly ranked among the leading IP practices in the jurisdictions in which it operates. Its wide range of IP professionals includes commercial and dispute resolution lawyers, mediators, patent and trade mark attorneys, researchers and specialist IP investigators. www.iprights.com



UK Trade & Investment is the government organisation that helps UK-based companies succeed in an increasingly global economy. Our range of expert services is tailored to the needs of individual businesses, enabling them to maximise their international success by providing them with knowledge, advice and practical support.

UK Trade & Investment also helps overseas companies bring high quality investment to the UK's vibrant economy: the UK is acknowledged as Europe's best place from which to succeed in global business. We provide support and advice to investors at all stages of their business decision-making. UK Trade & Investment offers expertise and contacts through a network of international specialists throughout the UK and in British Embassies and other diplomatic offices around the world.

For further information please visit www.uktradeinvest.gov.uk or telephone +44 (0)20 7215 8000.



The **UK Intellectual Property Office** is an Executive Agency of the Department of Innovation, Universities and Skills (DIUS). It was previously known as the Patent Office and has been in existence since 1852. UK-IPO is the official government body responsible for establishing and maintaining the national framework of intellectual property rights. These include Patents, Trade Marks, Designs and Copyright.

The UK Intellectual Property Office is also responsible for raising awareness of IP across the UK, helping businesses make the most of their IP and be better prepared to compete in national and international markets. UK-IPO offers chargeable search and advisory services to help business and publicly-funded bodies take decisions about intellectual property – because we know that IP can offer both an opportunity and a threat.

For further information please visit www.ipo.gov.uk or telephone +44 (0)1633 813930.

Also in this series
Intellectual Property Rights Primers for:

Brazil

China

India

Vietnam

WELCOME TO THE INTELLECTUAL PROPERTY RIGHTS PRIMER FOR KOREA

THIS IS ONE OF A SERIES OF GUIDES BEING PUBLISHED BY THE UK INTELLECTUAL PROPERTY OFFICE AND UK TRADE & INVESTMENT TO HELP BRITISH COMPANIES IN THE MAJOR MARKETS AROUND THE WORLD WHERE THEY ARE LIKELY TO MEET PROBLEMS IN OBTAINING, PROTECTING AND ENFORCING THEIR INTELLECTUAL PROPERTY RIGHTS.

Why Korea?

Bilateral trade between South Korea and Britain now stands at more than £5 billion a year and Korea is one of UKTI's priority High Growth Markets. In order to do successful business there, British business people will need to understand how best to use, protect and enforce the rights they have over the intellectual property they will be taking to this market or creating there through investment and other activities. Despite improvements to Korea's IP laws, there remain many difficulties for local and foreign rights owners – especially in the field of online piracy.

The IPR Primer for Korea provides this basic information. It aims to make you better informed about IPR in general, as well as providing guidance on how to apply these principles internationally and locally in target markets. In this guide you will find a grounding in the relevant issues and legal framework that you will encounter in Korea.

Is this guide for you?

This guide is pitched mainly at the managers of the business, rather than its lawyers, because we recognise that most smaller businesses do not have an in-house legal team, while the use of an external law firm tends to be limited by cost. However this guide is deliberately referred to as a 'primer' and we are not suggesting that it can, or should, replace the services of IP lawyers or other professionals such as patent attorneys: there will be times when it is essential to seek the advice of experts.

A company's intellectual property portfolio may be its most valuable asset. We believe it is sensible for the managers of the business to make themselves familiar with the concepts of IP and understand how the IP rights owned by their business will be affected in overseas markets. This knowledge can save the company a great deal of money through knowing what to look out for, taking timely self-help avoidance measures, appreciating when the experts should be consulted – and being able to communicate knowledgeably with them.

Not just for exporters

The guides in this series all deal with overseas markets but they are not aimed exclusively at exporters. Being involved in other types of business activity abroad also requires a good working knowledge of the local IPR environment. A company may conduct manufacturing or sourcing overseas without exporting at all; but its intellectual property rights may be just as vulnerable as a counterpart that is exporting its products or services from its UK base.

Even companies that are not involved in overseas markets can still become the victims of IPR abuse abroad. Any product may be copied or otherwise infringed by perpetrators far away. This may not be of immediate concern to the UK-based business – until the counterfeiters start exporting their illicit goods to the UK or Europe. Such companies need to understand their position in relation to the law in the countries where the abuse originates if they are to take action successfully.

This guide should therefore be useful for managers of companies of all types, whatever their geographical span. And we hope that interested people generally, familiar or not with IPR in the UK or South Korea, may find it a valuable addition to the existing body of information on the subject.

How this guide is organised

We start by examining the basic principles of intellectual property and rights, based on the laws that apply in the UK. We go on to deal with the European and global dimensions, discussing the ways that international treaties and arrangements affect UK rights owners. The next section deals with Korea: its international IPR memberships, its laws and how practices compare with those of the UK. Finally we look at the operation of IPR in Korea, with information and advice on preparation, protection, enforcement and the law. The appendices contain aides-mémoire covering the registration of IP in the UK, EU and worldwide, enforcement options and a comparison of the main IP rights conditions in the UK and Korea.

Hyperlinks are used to direct readers to more comprehensive information in the Reference section and from there to the Internet. From the Index, click on a heading to go straight to a chosen subject, while clicking on '[index]' moves you to the Index and '[return]' takes you back to your previous place in the text.. The appendices contain aides-mémoire covering the registration of IP in the UK, EU and worldwide, enforcement options and a comparison of the main IP rights conditions in the UK and Korea.

Currency: a conversion rate of £1 to 1,930 South Korean Won is used in this guide.

The term 'Korea' is used throughout to refer to South Korea (alternative name: 'Republic of Korea') unless otherwise stated.

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1. INTELLECTUAL PROPERTY RIGHTS BASICS

1.1 OVERVIEW

Q. How exactly are intellectual property and IP rights defined? [index]

Someone who is responsible for a 'creation of the intellect' such as an inventor, author or originator creates intellectual property (IP). Like tangible property, their creation has a value and, as with all property, it needs to be protected. Intellectual property rights (IPR) give them this protection, as well as helping them exploit and control their IP. Such a person is known as a 'rights owner' or 'rights holder'.

intellectual property definitions

Q. How do I know whether I have IP? [index]

The main criterion, for all forms of IP, is whether you have been responsible for creating something novel or innovative, representing progress over what went before. The definitions vary depending on whether it is a creation in the artistic or literary fields (protected by a copyright), a new technology (patent), a product's shape or appearance (design right) or a sign to distinguish your product or service from others (trade mark) – but the principle is the same: rights cannot be granted over anything mundane or generic, or which currently exists, is already in the public domain or is owned by someone else.

do you possess IP?

novelty is the crucial test...

However, if what you created was made in company time then the chances are that your employer will be entitled to own the rights to it. Whether it is owned by you or your company, intellectual property needs protection. Apart from with copyright and certain other rights that are already protected by law and do not have to be registered – 'unregistered rights' – this means you will need to apply to register the creation and, if successful, obtain 'registered rights'; otherwise there will be no protection and others will be free to exploit your ideas and efforts.

forms of intellectual property

Registered rights have to be applied for and granted by the government. In Britain the UK-IPO is responsible for granting all registrations. There is an extensive UK-IPO website to help you.

→ *the UK Intellectual Property Office*

Q. Which are the registered and unregistered IP rights? [index]

Registered IP rights consist of patents, registered trade marks and registered design rights. In the unregistered category are copyright, (unregistered) design rights, common law trade marks, database rights and protection for know-how under laws dealing with confidential information and trade secrets.

registered and unregistered rights

There are also rights covering plant varieties, geographical indications and the design of integrated circuits, as well as protection against 'passing off' under fair trade legislation.

Q. How do the main types of IPR differ? [index]

the definitions below are based on UK law

Copyright [index]

As we have seen, this is an inherent right (which means it is not applied for) protecting creative works such as books, music, plays, films and broadcasts. Copyright protection occurs automatically once the work has first been recorded in some way, such as by printing.

copyright: protects creative works such as books, music and films

Its relevance to works in the artistic, literary and media sectors is well known but copyright also covers industrial items such as a product's instruction manual as well as its technical drawings.

The period of validity of a copyright varies depending on the type of work. For dramatic, artistic or literary works the protection period in the UK is 70 years following the author's death, while for broadcasts and sound recordings protection lasts 50 years after first broadcast.

→ *UK-IPO: on copyright*

Patents [index]

Patents, a form of registered IPR, are used to protect technological inventions including processes. Although a patent doesn't automatically allow a rights owner to make or sell the item (since a product's manufacture and distribution must conform to prevailing regulations) it does protect the rights owner by preventing others from exploiting or copying the IP, so it is sometimes called a 'negative right'.

patents: protection for rights associated with technology and processes

A patent gives the inventor a monopoly right over the product and also allows him or her to license it for others to make and sell, in return for the payment of royalties. It is essential to apply for a patent early on in the process of the development of a new product or process since – in addition to the possibility of someone else copying it – a technology that is already in the public domain will not be registrable.

→ *UK-IPO: on patents*

Obtaining a patent normally involves retaining a patent attorney to draft and file a patent application. To be eligible for patent protection your invention must be new and inventive and must not be of an excluded type. A search of worldwide patent databases will be made by the national Patent Office to find out if anyone has already filed a patent or disclosed a scientific article for the same technology. If not, and if the new product is deemed to be 'novel and inventive' (that is, not just a re-working of an existing idea), then the patent may be granted and the invention is protected from unauthorised use. In the UK this can take up to four and a half years; however the process can be significantly accelerated if examination work has already been conducted at another intellectual property office.

how to go about applying for a patent

As in most countries, a UK patent is valid for up to 20 years. To maintain it, fees must be paid annually after the fifth year.

→ *renewal of patents and other IP rights*

Design Rights [index]

Design rights, as we have seen, consist of both registered and unregistered forms. The distinctions between what exactly may be protected by each, and the relative levels of protection, are complex. Expert advice is needed to choose which is appropriate.

design rights: for the appearance of an object; rights may be registered or unregistered

The more common type is the registered design, covering the appearance (that is, the shape or pattern) of a product or its packaging, as well as typefaces and graphics. To be registered in the UK a design must be distinctive and novel – it should not ‘remind an informed person of an existing design’ – as well as meeting other detailed criteria.

designs must be novel to qualify

→ UK-IPO: on design rights

Whilst there are costs involved in obtaining registered design rights (compared with relying on unregistered design rights, which are free) this form of IPR can be treated in the same way as patents – for example, by rights owners exploiting their IP through licensing – and it provides a good level of protection. A registered design right lasts for up to 25 years in the UK and must be renewed every five years.

Trade Marks [index]

Registered trade mark rights protect the signs used to identify a company’s products or services, distinguishing them from those owned by other businesses. Brand names and logos are perhaps the most familiar form of trade marks, but elements like a product’s colour or shape, or even a piece of music or (at least, in theory) a smell associated with it, can be registered as trade marks. You can also register a slogan, logo or domain name.

trade marks: signs to identify products or services

→ UK-IPO: on trade marks

Various criteria are used to decide whether a distinctive sign is registrable. The use of a generic term, for example, would not be allowed as everyone should be free to use it, while those which merely ‘designate the kind, quality, quantity, intended purpose, value, geographical origin...’ of the goods or service are disallowed as insufficiently distinctive. However if it can be shown that an otherwise mundane feature associated with a product (for example its colour) has become distinctively connected with the product, it may be allowed.

distinctiveness is an important criterion

Registration, normally using the services of a trade mark attorney, consists of filing an application with UK-IPO’s Trade Mark Registry, followed by a search and examination. Before a trade mark is granted it is advertised in the UK Trade Marks Journal and can be opposed. A renewal fee is payable every ten years. A registered trade mark will remain valid indefinitely if the rights owner continues to use and renew it. Goods are classified for registration purposes under the 45 class headings of the ‘International (Nice) Classification of Goods and Services for the Purposes of the Registration of Marks’.

→ *new rules for notifying trade mark owners about applications for similar marks*

→ *Nice classification system*

Another type is the unregistered or common law trade mark. As with unregistered design rights, this form of protection is not frequently used as it has less force and relies on the common law offence of ‘passing off’ for protection. The ‘™’ device indicates that a trade mark is subject to this type of rights, whereas a registered trade mark can use the ‘®’ symbol.

unregistered trade marks: free but less effective

The term ‘word mark’ is applied to a form of trade mark based solely on a typographic treatment of a piece of text that provides a recognised identity and branding.

word marks

Other Rights [index]

The IP rights set out above are the major ones that most companies require. There are also specific provisions for the following:

- **Domain Names.** Ownership rights for domain names may be defended as a reflection of the content involved, for example under trade mark, copyright and passing-off laws. → [domain names](#)
- **Geographical Indications (GI).** This form of rights, part of the UK Trade Mark Act, protects the identity of goods whose characteristics are attributable to their geographical origin. → [geographical indications](#)
- **Plant Varieties.** Rights covering all plant genera and species are available under the Plant Varieties Act 1997. → [plant varieties](#)
- **Semiconductor Topographies.** Rights over the designs of the layouts of semiconductors are protected as unregistered design rights in the UK. → [semiconductors](#)
- **Software.** The patenting of computer software is a problem area, depending on interpretation of the much-discussed ruling by the European Patent Office (EPO) that 'computer programs as such' are not patentable. → [European rules for software IP](#)

Q. The term 'industrial property' is sometimes used. How does this differ from 'intellectual property'? [index]

The following quotation from the World Intellectual Property Organization (WIPO), a Geneva-based United Nations agency with 184 member nations, explains this distinction and summarises the paragraphs above:

'Intellectual property refers to creations of the mind: inventions, literary and artistic works, and symbols, names, images, and designs used in commerce.'

'Intellectual property is divided into two categories: Industrial property, which includes inventions (patents), trade marks, industrial designs, and geographic indications of source; and Copyright, which includes literary and artistic works such as novels, poems and plays, films, musical works, artistic works such as drawings, paintings, photographs and sculptures, and architectural designs.'

A summary of registration procedures in the UK is provided in Appendix A.

→ [WIPO](#)

['industrial property' defined](#)

→ [UK registration procedures](#)

1.2 INTERNATIONAL CONSIDERATIONS

Q. Do these rights apply internationally? [index]

Member nations of the World Trade Organisation (WTO) are committed to include an agreed scope of IPR protection in their national laws. These requirements, akin to 'minimum standards', are set out in the Trade-Related Aspects of Intellectual Property Rights (TRIPS) Agreement, which was negotiated in 1994. TRIPS also specifies procedures for associated matters such as IPR enforcement and dispute resolution.

→ *WTO*

→ *TRIPS*

This means that if you are doing business in countries that are members of the WTO you will find a degree of similarity between local IPR laws and those in force in the UK. In theory at least, the same can be said of the local enforcement and dispute resolution procedures and practices. (Few major trading nations are not included: there are now more than 150 WTO members. An important exception is the Russian Federation, which currently has observer status).

→ *WTO membership*

Whilst this enhances international IPR protection and makes it simpler for rights owners to understand what to expect in other countries, the existence of universal minimum standards does not mean IP rights held in one country will be valid in others. It is a common and potentially dangerous misconception amongst some rights owners that their domestic IP rights automatically extend worldwide. In fact – with certain exceptions and beneficial reciprocal arrangements arising from international treaties – many IP rights must be registered for specific, designated countries. This limitation is known as territoriality.

territoriality: essential to know which rights apply internationally

Q. What are the exceptions and reciprocal arrangements? [index]

These include copyright and other IP rights that are recognised under supranational laws, treaties and extensions. There are also international agreements making it easier for rights owners to achieve recognition for their rights abroad by allowing a single registration to apply more widely within a group of contracting states, or by streamlining search and application procedures.

Copyright [index]

Copyright regulations are governed by the Berne Convention, established in 1886, and (now less important) the Universal Copyright Convention (UCC), set up as an alternative to the Berne Convention. As we have seen, WTO members are bound by TRIPS; this, in turn, means they accept the Berne Convention, which covers most trading nations: there are 163 Berne Convention signatories. However in certain countries it is advisable – and in some cases, standard practice – to make a 'recordal' even of copyright to enhance protection by ensuring its prompt and trouble-free recognition.

→ *Berne Convention*

There are several systems to harmonise intellectual property rights in the EU, just as there are in Benelux and other trading blocks such as NAFTA. It is important to know whether a particular form of IP rights applies automatically to a number of territories – 'unitary' rights – or only in those territories for which it has been specifically registered. Unitary rights enjoy the same protection across a group of states without the need to apply for the rights individually in each.

definition of 'unitary' rights

Community Trade Mark [index]

The Community Trade Mark (CTM) system, which operates alongside the national trade mark systems of EU countries, is unitary – so a single registration in one of the EU member states confers trade mark protection rights throughout the EU. CTM applications are administered by the EU's Office for Harmonisation in the Internal Market (OHIM) in Alicante.

→ [the Community Trade Mark: a unitary right within the EU](#)

Madrid Protocol [index]

The Madrid System for the International Registration of Marks ('the Madrid Protocol'), operated by WIPO, is another unitary system for trade marks. An application filed in the UK means it will be recognised as an application in other countries that have also signed up to the Madrid Protocol, as designated in the application. ('The Madrid Union' currently consists of more than 70 individual nations plus the EU and the Russian Federation).

→ [the Madrid Protocol and Madrid Union membership](#)

Local trade mark authorities are allowed to challenge the filing but if they do not do so within 18 months the trade mark receives the same protection as if locally registered. In 2004 the European Community joined the Madrid Protocol, which allows a Community Trade Mark to be used as the basis of an application for trade mark registrations under the Madrid Protocol.

[18 months to challenge a filing](#)

European Patent Convention [index]

There has long been pressure within the EU for a system for patents along similar lines to the Community Trade Mark but so far negotiations have failed to achieve this. The European Patent Convention (EPC), with more than 30 contracting EU and other European nations, does not confer unitary protection and falls well short of being a 'community patent'; but it does provide useful assistance for European companies registering patents. Harmonised procedures allow you to make a single application, via the European Patent Office (EPO), for as many of the EPC countries as you need to cover. However the patents granted can then only be enforced individually, on a national basis.

→ [EPC explanation and text](#)

Patent Cooperation Treaty [index]

Similarly, an application under the 1970 Patent Cooperation Treaty (PCT), operated by WIPO, does not lead to an 'international patent' but is a streamlined procedure allowing an application for a patent in a single language to apply simultaneously in any of the more than 130 PCT contracting countries ('The PCT Union'). The process involves an 'international phase' application followed by a search to assess whether an invention is capable of being patented in the designated territories. Once this has been decided, applications may be made in the individual countries, in the 'national phase', according to local rules and procedures.

→ [further information on the PCT and its membership](#)

The main advantages of making a PCT application are that it buys extra time (about 18 months) and cuts costs by reducing duplication, helping you avoid territories where the chances of obtaining a patent are low. For the UK, the European Patent Office performs the international searches under the PCT system.

Registered Community Design [index]

A Registered Community Design (RCD) offers unitary protection throughout all the EU member states, based on a single application to OHIM, the administering authority. It lasts for up to 25 years, in a series of five-year periods.

Unregistered community designs are weaker and offer less protection than RCDs. However they may be useful in certain industries where it is not feasible to apply to register an RCD, for example in textiles.

→ *the RCD: unitary protection in the EU*

→ *unregistered community designs*

Hague Agreement [index]

Further protection for design rights is available to signatories of the Hague Agreement, administered by WIPO, which allows the protection of designs in multiple countries through a single filing in one language. As with the Madrid System, there is the possibility of refusal by national design rights authorities. There are 48 contracting states, including the European Community.

In 2007 the European Commission passed legislation linking the RCD and Hague Agreement systems. This enables companies in EU countries that have not individually signed up to the Geneva Act of the Hague Agreement to extend the coverage of an RCD into the 23 Hague Agreement states. The EC acceded to the Geneva Act on 1 January 2008.

→ *Hague Agreement and linking of the RCD*

Paris Convention [index]

The most important provision of this long-standing intellectual property treaty, dating from 1883 and now administered by WIPO, is the establishment of 'priority rights' for patent, design and trade mark applicants in respective signatory states.

This system allows applicants in one country to gain protection for their IP in another. The date of filing in the first country is counted as the effective date of filing in a second country, as long as the second filing occurs within a set period: six months for trade marks and designs; a year for patents and utility models.

→ *Paris Convention*

international 'priority rights' for patents, designs and trade marks

Rights Extensions [index]

In addition to the arrangements set out above, British companies can benefit from extensions of their IP rights in more than 40 current and former Commonwealth nations and territories.

A summary of international treaties and registration procedures is provided in Appendix B.

→ *extensions of IP rights for UK firms*

→ *international treaties and procedures*

2. KOREA

2.1 IPR OVERVIEW

Q. Which principal international IPR organisations and agreements does Korea belong to? [index]

Berne Convention (copyright) – since 1996

Hague Agreement/Geneva Act (designs) – non-member

Madrid Protocol (trade marks) – since 2003

Paris Convention (priority rights) – since 1980

Patent Cooperation Treaty (patents) – since 1984

WTO/TRIPS (IPR in general) – since 1995

Korea's membership of international IPR-related organisations

Q. How does Korea compare with Europe in terms of the protection of IPR? [index]

Korea's IPR laws are comprehensive and the IPR-related authorities and processes are becoming increasingly efficient. The protection offered to foreign and domestic rights owners is of a reasonably high standard, albeit with some notable gaps and occasional partiality where foreign interests are concerned. Many of the IPR-related duties are the responsibility of a single IPR authority that not only provides information and registration services but also has a major part to play in drafting regulations and undertaking or advising on enforcement. This contrasts with countries such as China, where the organisations responsible for various aspects of IPR are highly scattered.

comparing IPR protection in Korea and the EU

As a member of the World Trade Organisation, Korea is committed to the standards set by TRIPS (see 1.2 above). This means that the IPR environment in which UK companies operate in South Korea should seem familiar for those used to practices in the UK. There are some inherent problems for rights owners operating in South Korea, including linguistic challenges and difficulties for people from the UK used to Common Law traditions.

implications of TRIPS membership

The Internet has a massive role in the country's business and leisure – and in piracy. South Korea's is one of the world's best electronically-connected societies, with higher Internet speeds, to more people, than in most other developed countries; more than 20 million citizens are now on line. In IPR terms Korea is a victim of its own success: the scale of Internet piracy (mainly the illegal downloading and export of application programs and games) is vast and the country's IPR enforcement infrastructure struggles to keep up with this phenomenon.

advanced Internet use: a two-edged sword?

The removal of South Korea from the US 'Watch List' suggests that matters are improving. However, despite the high level of administrative efficiency, there remain pockets of concern for rights owners in certain sectors, particularly in relation to copyright piracy.

no longer on the US Watch List

Overall, practical measures such as the greater involvement of the police in IPR raids, coupled with recent improvements to South Korea's IPR laws, have helped make the protection and enforcement of all forms of IPR more straightforward for foreign rights owners than they were a few years ago.

Q. Is there an awareness amongst local people in South Korea that IPR infringement is a crime? [index]

[local attitudes towards IPR](#)

Measures to improve public education about international IPR norms have become more effective than a few years ago but they have yet to bear fruit in terms of a reduction in the widespread willingness of many locals to become involved in the infringement of IPR.

Q. Is the Korean government in earnest in fighting IPR infringement? [index]

The government appears to take infringement seriously. This results from domestic demands (most rights owners abused in Korea are Koreans) and international pressure – notably from the US. In 2004 South Korea decided to take part in the US Strategy Targeting Organized Piracy (STOP!) initiative. At the time the Minister of Trade stated: *'the protection of IPR has become one of the priorities of my government's economic policy.'*

[participation in the US STOP! initiative](#)

Q. What is the impact of free trade agreements on IPR in Korea? [index]

[the impact of FTAs](#)

South Korea has several FTAs with other countries and blocs and is negotiating others. In 2007 it signed the Korea-US Free Trade Agreement (the 'KORUS' FTA) and a similar arrangement is due to be concluded with the EU. From an IPR perspective, KORUS contains a number of improvements for rights, while the FTA with the European Union is expected to be more beneficial. The effect of these arrangements will be overall improvements in Korea's IPR conditions for citizens and foreigners alike, bringing Korea further into line with international standards.

→ [KORUS](#)

2.2 KOREA'S IPR LAWS AND PROCEDURES

Q. What are Korea's IPR laws and procedures and how do they compare with the UK's? [index]

As we have seen in International Considerations above, Korea has been a member of the World Trade Organisation since 1995. WTO accession requires member nations to establish and maintain laws whose effect is in line with the 'minimum standards' laid down by TRIPS. Consequently there are, in theory, few major differences between Korea's laws and those of other developed countries, although there are plenty of differences in detail. The legal framework of the main forms of IPR is summarised below.

[South Korea's laws and procedures](#)

Copyright [index]

Korea signed up to the Berne Convention in 1996. Korea's copyright legislation is based on the Copyright Act of 1957, known as the Korean Copyright Act, or KCA. This was amended in 2003 to conform with the WIPO Copyright Treaty (WCT) and the WIPO Performances and Phonogram Treaty (WPPT), which were drawn up specifically to take account of the Internet age. The KCA covers a range of items subject to copyright internationally: literary, dramatic and artistic works such as films, photographs, music, books, illustrations and so on. The law makes provision for artistic compilations as well as derivative works (such as translations) and deals with the eligibility of works by foreigners in accordance with the Berne Convention.

→ [Copyright Act](#)

There is no requirement to register copyright in Korea since the Berne Convention states specifically that copyrights need not be registered. However it is advisable to do so in order to prove ownership in any dispute or court case. Registration for all forms of copyright except computer software (see below) is made with the Ministry of Culture, Sports and Tourism (MCST), which has a role in IPR education, registration and regulation. These are shown in more detail in the reference section. In 2005 the government set up the semi-official Copyright Protection Center (CPC) within MCST, which has an enforcement mandate but, because of the nature of its remit, only limited effectiveness on behalf of foreign copyright holders.

no need to register copyright, but advisable to do so

→ MCST

In 2006 the law was fundamentally redrafted in anticipation of the KORUS free trade agreement. This has resulted in a number of changes in the situation for copyright owners in Korea. For example, in publishing, the period of copyright protection for authors is being extended from the Berne minimum – 50 years from an author's death – to 70 years. However this change has not yet been reflected in the Copyright Act and there may be a grace period before it is fully adopted. The longer validity period is consistent with practice in many developed nations including the UK. There are different timescales for certain other forms of copyright.

maximum effective period to be 70 years

In its 2007 report on South Korea, the International Intellectual Property Alliance (IIPA) describes some 'significant improvements' in the rewritten KCA, mainly in the areas of sound recordings and enhanced protection for works by foreigners whose authorship cannot be identified or located. But the report notes that:

'... in many other ways the copyright law reform is a disappointment, and a missed opportunity for Korea to bring its laws into closer compliance with 21st century global minimum standards.'

IIPA: reservations about Korea's IPR standards

(IIPA 'Special 301' Report: South Korea, 12 February 2007).

Specific concerns over copyright piracy in Korea include the wholesale duplication of books – with a particularly high rate of piracy of textbooks – and other printed works (offline piracy) as well as online piracy involving a wide range of material downloaded via the Internet. As IIPA states:

'South Korea is one of the most Internet-savvy countries in the world. It is thus not surprising that the copyright industries face extraordinary enforcement challenges in Korea because of the prevalence of all kinds of pirated materials online. Korea made some progress in combating online copyright piracy in 2006, but much more remains to be done.' (ibid)

hardware infringements

In hardware, circumvention devices are widely available, for example modified chips and game copiers that bypass the technological protection measures employed in video game consoles, enabling substantial entertainment software piracy.

Computer Programs and Semiconductor Integrated Circuits [index]

Rights in this field are covered by the Computer Program Protection Act and the Act Concerning the Layout-Design of Semiconductor Integrated Circuits. The authority for registration and regulation is the Ministry of Information and Communications (MIC). The non-government Korean Software Property-right Council is an influential body that is active on behalf of software copyright holders in Korea.

→ *Computer related IPR*

→ MIC

Unlike in the EU, where ‘computer programs as such’ are excluded from patentability (see the explanation of UK/European practice in 1.1 above) rights are granted for software innovations in Korea and treated as a form of copyright.

According to the Business Software Alliance’s Global Software Piracy Study for 2006 (published in May 2007) South Korea’s software piracy rate was 45 per cent, compared with the Asia Pacific average of 55 per cent.

*software piracy rate:
45 per cent*

Patents, Utility Models and Industrial Designs [index]

Korea’s patent regulations are contained in the Patent Act and the Utility Model Act. Unlike in the UK, South Korea distinguishes between patents (sometimes called ‘invention patents’) and utility models (also known as ‘minor patents’). The latter are available in many countries including France, Italy and China as well as Korea.

→ *Patent and Utility Model Acts*

Rules for utility models are similar to those for invention patents but the test of what constitutes an invention patent depends on a definition of an invention as a ‘highly advanced creation of a technical idea using the rules of nature’, whereas for a utility model, applicable to ‘devices’, the barrier is lower: a device is defined as ‘the creation of technical ideas using the rules of nature’. (Both definitions are quoted from the respective Acts). In each case the item or process must show ‘novelty, industrial applicability and inventive step’ – concepts common to most countries’ patent procedures. Registration may not be granted:

differences between invention and utility model patents

‘where an invention [or ‘device’ in the case of utility models]... could easily have been made before the filing... by a person with ordinary skill in the art to which the invention [device] pertains...’

tests for patentability

A further difference is that invention patents give protection for a maximum of twenty years, while utility models are valid for ten. In the case of invention patents, this period may be extendable by up to five years to reflect the length of any delays in being able to work the patent due to processes such as safety tests required to allow its authorisation.

maximum effective periods

UK companies are advised to consider applying for utility models in Korea, despite their lack of familiarity with this form of rights. It may be a good idea to apply to register a product as a utility model if an invention patent is not attainable. It should be noted that chemical products are ineligible as utility models in Korea. The patent law operates under the ‘first to file’ principle. As stated in Article 36 of the Patent Act:

UK companies should consider utility models

‘Where two or more applications for patent registration related to identical invention filed on different dates, only the applicant filing the application with the earlier filing date may obtain patent registration for the invention.’

‘first to file’ criterion

This is similar to UK law but different from practice in the US, where ‘first to invent’ is the critical test.

In accordance with the Paris Convention (see 1.2 above), and as in other countries, the law allows for applicants for invention and utility model patents filing in Korea to ‘enjoy a right of priority’ if they have already applied for a patent for the same item overseas within the previous 12 months.

‘right of priority’

When an invention is created in Korea by an employee as part of his or her employment the situation is more complex than in the UK, where the employer owns any resulting patents. Under Articles 39 and 40 of the Patent Act, the

employee and employer rights to an invention

employer can have a non-exclusive license for the invention, but should pay to obtain patent rights or an exclusive license based on agreement with the employee.

Industrial designs are covered by the Design Act. As in other countries, this form of rights deals with the shape or other visible attributes of a product and applications must be novel:

'design' means the shape, pattern, color or a combination of these in an article that produces an aesthetic impression in the sense of sight...'
(Design Act, Article 2)

The law confers protection for a maximum of fifteen years. The 'right of priority' for previous filings of designs overseas requires filing in Korea within six months of an overseas filing.

Korea became a signatory to the Patent Cooperation Treaty (PCT) in 1978. This means that foreign owners of patents can assess the possibility of obtaining a patent before embarking on the 'national phase' of the application within Korea – at the end of which, if the patent is granted, they will have the same protection as any other patentee in Korea.

The Korean Intellectual Property Office (KIPO) is responsible for all aspects of patents, utility models and industrial designs, including their regulation, registration and the first level of litigation through its IP Tribunal. It also provides similar services for trade marks, which are dealt with in the next section.

In his review of 2006, KIPO's Commissioner mentions a number of notable achievements that demonstrate his agency's adoption of best practice in offering a service to rights owners, for example:

'... in December 2006, we successfully reached our target of shortening the first action pendency period for patent examinations to 9.8 months – the fastest patent examination service in the world.'

[the Design Act](#)

[designs: 15-year protection](#)

[S Korea is a PCT member](#)

[→ KIPO including 2006 review](#)

Trade Marks [index]

Trade marks are regulated in Korea under the Trademark Act. The system operates in a similar way to that found in European countries, protecting designs, symbols, colours or other devices used to identify a company's products or services, including trade names. Trade mark protection has also been available for geographical indications since 2005. As in the UK, tests of registrability cover issues such as generic terms, geographical names and distinctive features.

The Korean script – in common with those of China and Japan – provides particular registration and enforcement difficulties for foreign rights owners. Different renditions for the same sound of a word (known as 'homophones') transliterated from a Latin script are possible using Korean hangul script. Korea's Trademark Examination Guidelines now specify that the meaning and the pronunciation of the name in the original alphabet must be taken into account. This is a complex area and foreigners will invariably need local advice to avoid the many pitfalls when choosing Korean brand or trade names.

Registration takes about 7-10 months and a trade mark is valid for ten years, after which it may be renewed indefinitely for further ten-year periods. If there are two or more applicants for identical or similar trade marks for the same or similar goods the one that was registered first prevails, as in the UK. Regulations

[the Trademark Act](#)

[Korean script: rights owners will need advice...](#)

[ten-year validity](#)

['first to register'](#)

about the 'right of priority' for those applying in Korea for trade marks for which applications have already been made overseas are similar to those for patents, in accordance with international practice.

'right of priority'

Korea has been a member of the Madrid Protocol since 2003. As described in Chapter 1, this provides a unitary method of reciprocal trade mark registration for UK companies, with registration based on either a national UK trade mark or a Community Trade Mark.

unitary registration under the Madrid Protocol

Under the Paris Convention, as for patents, a filing in a foreign country is valid as a filing in Korea. In the case of trade marks this must be done within six months. Trade marks that remain unused for three or more years, or which lapse for that period, may be cancelled by another company if non-use can be proved.

Paris Convention

Protection for 'well-known marks' in Korea is similar to that available in most countries: registration of such a mark by someone other than the original trade mark owner is disallowed under the terms of the Paris Convention. However the mark must be registered in Korea. This contrasts with English Common Law, where there is a degree of protection for unregistered, well-known trade marks.

protection for well-known marks

Concerns over trade mark practice in South Korea include:

- Trade mark piracy. The lack of bad faith provisions in the Trademark Act means locals can succeed in registering non-famous overseas trade marks. This shuts out the genuine trade mark owner, offering him the costly option of negotiating to buy back his mark. See the 'GarbCo' case study.
- Poor search processes within KIPO means locals may successfully register variants of well-known logos, necessitating frequent and costly opposition actions.

bad faith trade mark registrations

→ *case study*

poor search processes

Customs Recordal [index]

Trade mark owners may register (or 'make a recordal of') their marks with the Korean Customs Service. This allows the local Customs offices to check and intercept infringing goods being imported or exported. Applying for a recordal is generally done through a lawyer or local attorney and costs about £250 (although there is no official fee). The willingness of Korean Customs to intercept fakes on export is an example of good practice shared by relatively few other nations.

→ *KCS*

customs recordal for interception on import or export

Unfair Competition Law [index]

The Unfair Competition Prevention and Trade Secrets Protection Act (UCPA) provides protection for rights owners in addition to the Acts covering each form of IP. Included in this Act are sanctions against unfair practices including 'cybersquatting' and the infringements involving 'dead copies' of designs, together with an improved definition of the term 'trade secret'.

unfair competition

How IP Rights Parameters in the UK and Korea Compare

A comparison between the main features of IP rights in the UK and Korea, relating to timescales and the basic costs for the official processes of registering the rights, is provided in Appendix D.

→ *UK & Korean IP rights compared*

2.3 PREPARATION

Q. What steps should a company take to avoid problems? [index]

preparation is the key

The most important step is adequate preparation. This means taking advice from those who are knowledgeable about IPR in Korea, consulting publications and websites and referring to the many sources of assistance that are aimed specifically at companies doing business there. Many of these are listed in this document and referenced websites. (See also Where to Get Help in Korea below).

It is also sensible to make a special assessment of the risks to the intellectual property owned by the business. This is particularly important if you feel your IP is potentially at risk from infringers, if other companies in similar areas of business have had problems, or if your products or services have previously been exposed to infringement in other territories. Such a risk assessment might include:

make an IP risk assessment

- Performing due diligence checks on the various organisations and individuals with which you intend to have dealings in Korea.
- Seeking professional advice from lawyers and other firms that are experienced in advising on IPR in Korea, as well as local diplomatic posts and the British, American and EU Chambers of Commerce in Korea, as well as the Korea-Britain Society.
- Talking to other companies which are already doing business of the same type in Korea or operating in the same location.
- Consulting your agents, distributors, suppliers and others who are knowledgeable about local conditions for the goods or services in question.
- Checking with a trade mark or patent attorney to see whether there have been previous registrations of your own marks, or other IP, in Korea. Any prior registrations are bound to cause difficulties and putting matters straight might be expensive or, at worst, unachievable.

see reference section for details

While this is by no means a comprehensive list of the types of people and organisations you might consult, it offers some ideas on how to go about assessing the vulnerability of your IP. Such actions are a part of the overall risk assessment you will need to make when embarking on a new project overseas.

Above all, it is important to develop within your company an attitude of being true to normal instincts and sticking to familiar business methods. IPR infringement goes hand in hand with other corrupt practices, so it is essential that those new to the market are not beguiled by entreaties to 'do things differently' when overseas. Good local representation will be a key element in protecting your interests and avoiding problems of this kind.

stick to your instincts

Q. Who should take responsibility for a company's IPR protection? [index]

The simple answer is: everyone. Many companies depend on the integrity of their IP, often one of their most valuable assets, for their livelihood. So this subject should be given proper attention by the management and staff, as well as those with whom the company has relationships in other companies.

IP protection depends on everyone in the business...

It may be sensible for a manager to be nominated who will have particular responsibilities for aspects such as understanding what constitutes the IP owned by the business, which sources of assistance and information are available and how to set up measures to protect IP rights. In companies with legal departments a legally-trained manager would be the obvious choice; but in an SME without the benefit of an in-house legal team this role could still be adequately performed by a manager with sufficient interest, commitment and training.

...but consider appointing a manager with specific responsibility for IP

2.4 OPERATING IPR IN KOREA

Q. How does one go about registering IP rights? [index]

As we have seen, there are a number of possible situations:

registering your rights

- For copyright, no registration is required but registering copyrights with the copyright authorities is advisable.
- For patents (including inventions, utility models and industrial designs) individual registrations must ultimately be made in Korea, but for rights other than industrial designs the search process is eased, and extra time gained, by applying under the terms of the Patent Cooperation Treaty.
- For trade marks, the options are registration within Korea or use of the Madrid Protocol to gain unitary rights under national or Community Trade Mark registration systems; in the case of well-known brands, there is protection under the Anti-Unfair Trading Law – even if unregistered – but this is a complex area of law.
- 'Priority rights' under the Paris Convention assist in the local registration of trade marks, designs and patents by allowing rights previously registered elsewhere to become effective in Korea, if filed within a time limit.

Registration is essential in Korea (and advisable for copyright). As in the UK, if you do not register your rights you may not be able to enforce them.

registration is essential

Q. What are the steps in IP rights enforcement? [index]

There are three levels at which rights may be enforced: mediation, civil action (or litigation) and criminal prosecution.

- **Mediation.** Disputes over the enforcement of conventional copyrights and those for software and semiconductor integrated circuits are the responsibility of the Copyright/Computer Program/Layout-Design of Semiconductor Integrated Circuit Review and Mediation Committee. Patents, utility models, trade marks and industrial designs are handled by IPR Dispute Committees. In both cases the decision of the committees has a binding effect on the parties to the dispute.

mediation

- **Civil action.** The Ministry of Culture, Sports & Tourism and the Ministry of Information & Communication are responsible for both conventional and software/semiconductor integrated circuits. For patents, utility models, trade marks and industrial designs, the Intellectual Property Tribunal within KIPO handles all aspects of IPR litigation in the first instance, with the Patent Court acting as an intermediate appeal court. There are also district courts in some of the larger cities with specialist IPR knowledge. Injunctions and damages are available through civil litigation. Damages are unlimited but punitive damages are not available. Appeals may be made to the Korean Supreme Court.
- **Criminal prosecution.** Rights owners may apply for prosecutions to be brought in the criminal courts. Penalties for IPR infringements can be steep. For example, the Patent Act allows for: *'Article 225 Offense of Infringement: A person who infringes a patent right or exclusive licensee is liable to imprisonment with labor not exceeding seven years or to a fine not exceeding 100 million Won.'* [about £52,000]
- Processes in the criminal courts may be long drawn-out and appear opaque to foreign plaintiffs but the fact that penalties are readily used under the criminal code tends to have a deterrent effect against major infringement.

civil litigation

criminal prosecution

penalty for infringement: labour and a fine

As we have seen above, Korean Customs are able to make interceptions of inbound or outbound goods suspected of being counterfeit. There are also programmes to help identify genuine rights owners, including the Verified Rights Owner (VeRO) initiative, in conjunction with major brands and the Korean Intellectual Property Office, and online information helping people to distinguish between fake and genuine products. Customs has a direct role in enforcement, and may bring prosecutions when it detects IPR abuse.

Customs enforcement measures

A summary of enforcement options (not specific to Korea) and their pros and cons is provided in Appendix C.

→ *enforcement options*

Self-Help Measures

Q. Should I be reconciled to taking formal action to protect my IP? [index]

The best method of protection is avoidance, rather than expecting to initiate cases against infringers. Avoidance means taking measures that lessen the likelihood of infringement. We have covered many of these under Preparation above: getting good advice, doing risk assessment, checking IP rights registrations, performing due diligence checks, filing your applications as soon as possible, giving your intellectual property the management attention it deserves as a key element of the business and – most important – remaining true to normal business instincts, wherever you are operating.

prevention is better than cure...

There are also some particular self-help considerations for companies operating in risky territories:

- **Design:** make it harder for infringers to reverse-engineer your product.
- **Staff:** hire honest people, have effective IPR-related clauses in employment contracts, educate employees about IPR protection and require them to safeguard the IP assets of the business.

self-help measures that can help you avoid IPR infringement problems – and the need to take enforcement action

- Documents and equipment: institute sound physical protection and destruction methods for drawings, tooling, samples, machinery and so on.
- Packaging: make sure there are no 'leakages' of packaging that might be used by counterfeiters to pass off fake product in real packages.
- Production over-runs: police them to ensure that genuine product is not being sold under a different name.

Top Tips for IPR Protection in Korea [index]

tips for success

- Stick to your normal business instincts
- Prevention is better than cure – and cheaper
- Assess the risks of the market and make preparations
- Seek advice but take self-help measures to protect your IPR
- Make sure everyone in your business values its IP
- Register your IP rights – even copyright
- Forge good relationships with organisations that can help you
- If action is necessary, be resolute but consider mediation first
- If you don't show that you value your IP, who else will?

Where to Get Help in Korea [index]

Many of the links in this guide give details of organisations that can assist in various situations. In addition, the following organisations can provide advice on IPR:

- **British Embassy, Seoul.** A full range of diplomatic, consular and business-related services. UK diplomats cannot intervene with Korean legal or administrative processes but they may be able to keep a watching brief when cases are brought to the Korean courts, or lobby on your behalf if progress is slow. → [British Embassy](#)
- **British Chamber of Commerce in Korea:** a source of advice for visiting and resident British business people and a chance to meet others. → [BritCham](#)
- **The EU Chamber of Commerce in Korea:** *'The purpose of the Chamber is to help in any possible way to develop trade, commercial and industrial relations between the EU and Korea. The Chamber paves the way for and fosters contacts between interested business circles of the 25 EU member states and the Korean peninsula... [EUCCK] is made up of around 800 members from the EU, local as well as overseas business community.'* → [EUCCK](#)
- **The Korea-Britain Society (KBS)** is based in Seoul. It promotes friendship and understanding between Korea and the UK. → [Korea-Britain Society](#)
- The prohibition on foreign law firms operating in South Korea directly through their own offices has yet to be lifted, so few foreign-name law firms have set up operations. However, many UK firms – including patent and trade mark attorneys – have corresponding relationships with local law firms.

3. FEEDBACK

If you have any comments about what you have read in this guide we would welcome your feedback.

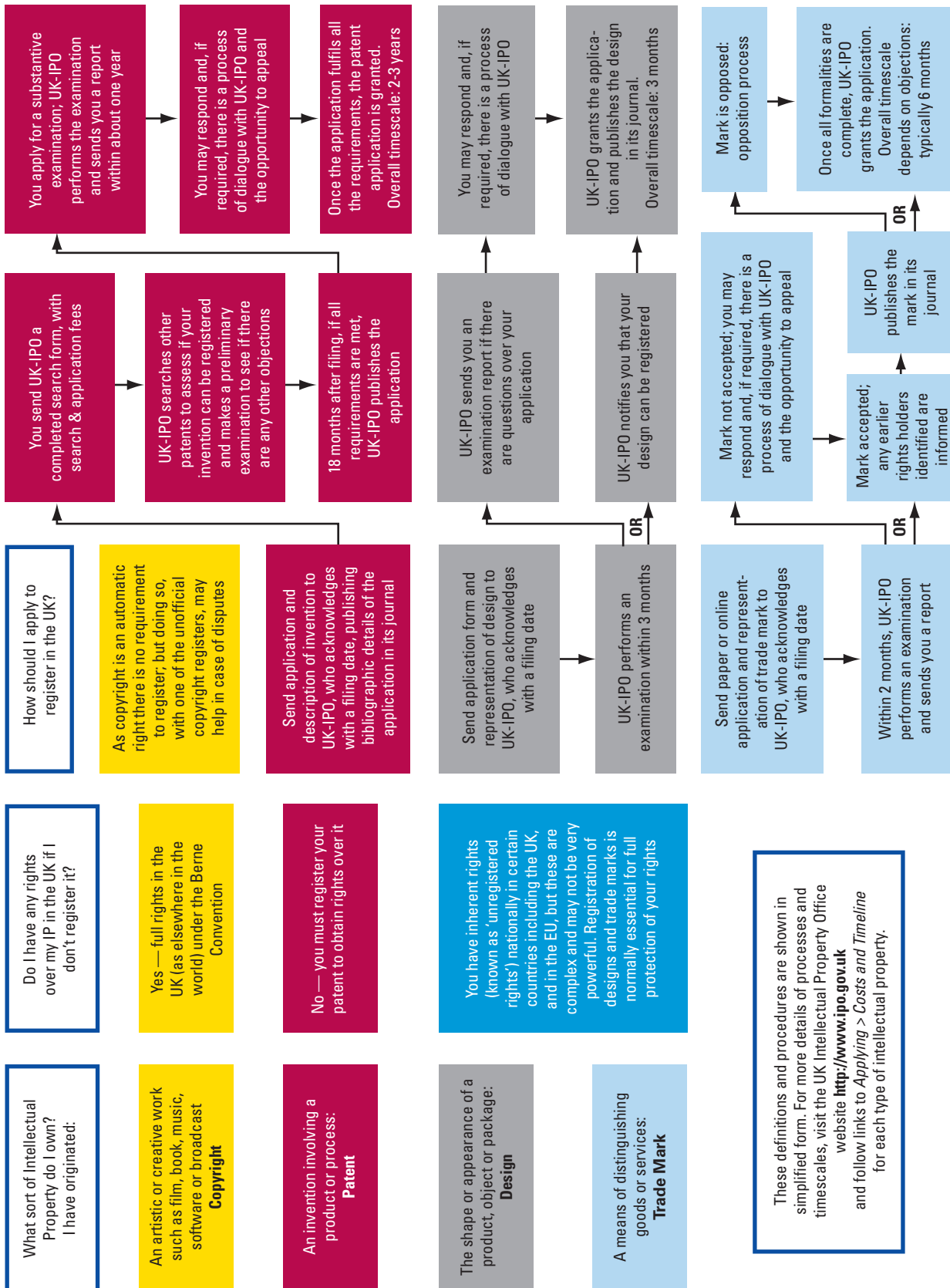
feedback

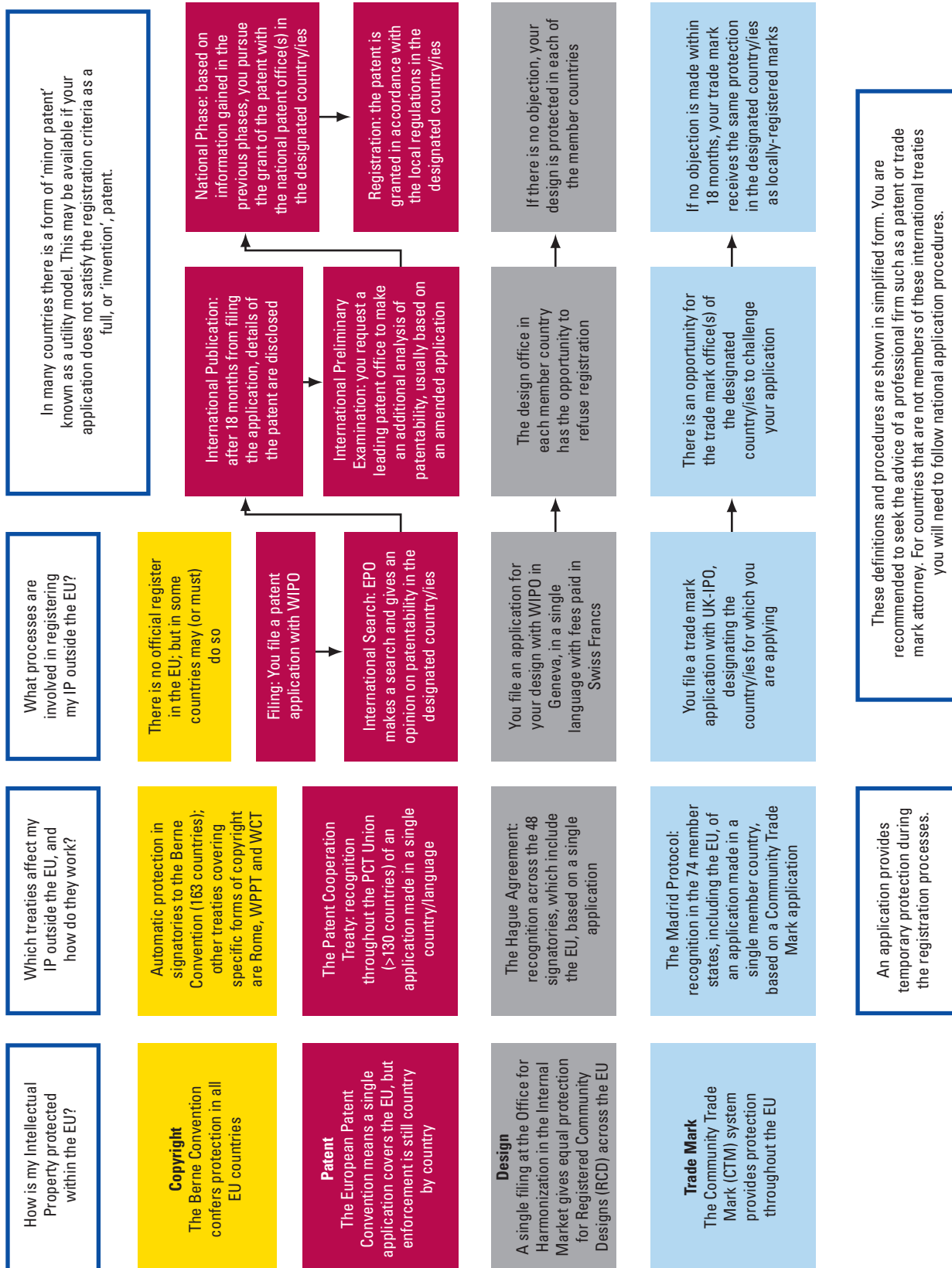
Please take a few minutes to complete our survey by clicking here. [Start survey](#)
Your opinions and suggestions will help us ensure that the IPR Primers are relevant to your needs.

Disclaimer

This guide contains only a summary of IPR issues. It is not intended as a substitute for the advice of professionals such as lawyers and attorneys. You should always seek expert guidance before taking decisions that may affect your IP rights, in Korea or elsewhere.

the small print





APPENDIX C : RIGHTS ENFORCEMENT AIDE-MEMOIRE [RETURN] [INDEX]

<p>What processes can I use to enforce my IP rights?</p>	<p>Local IP Firm Advice on what can be achieved locally; an essential first step</p>	<p>Out-of-Court Procedures Increasingly used in IP cases; there are two main types</p>	<p>Administrative Action In many countries there are administrative enforcement bodies which take action at the request of rights owners; they may also inspect shops, markets and factories</p>	<p>Civil Litigation Normally a rights owner brings an action against an alleged infringer under the civil code. In some countries there are IP courts where specialist judges hear cases, assisted by technical examiners</p>	<p>Criminal Prosecution Under most penal codes the state brings a case against an alleged infringer; the degree to which a rights owner can influence the process varies from country to country</p>	<p>Tell me more ...</p>	<p>Lawyer may send infringer a 'cease and desist' letter</p>	<p>Mediation: must be attempted as a precursor to litigation in some countries. Particularly useful in cases where a dispute cannot be settled on a worldwide basis</p>	<p>Arbitration: an arbitrator is appointed by a court in the role of a judge; more binding and formal than mediation</p>	<p>Enforcement authorities can usually prosecute, set fines and arrange the destruction of illicit goods or equipment. Cases with a criminal strand are normally passed on to the police for further action</p>	<p>This is the standard enforcement method in most countries. Preliminary injunctions are often used to halt the manufacture and sale of illicit goods pending further action</p>	<p>The 'ultimate deterrent' with the widest benefits for rights owners. Dual offences (eg IP abuse as well as standard goods) may involve even more severe penalties</p>	<p>What are the typical costs and timescales?</p>	<p>Cost: low £ hundreds Timescale: a few days</p>	<p>Cost: variable, but generally far less than going to court Timescale: mediation may be arranged quickly; arbitration takes much longer</p>	<p>Cost: may be hidden; some countries seek contributions by rights owners towards cost of actions Timescale: usually weeks</p>	<p>Cost: may be expensive (£'000s) if the case is lost or costs are not awarded Timescale: highly variable; may run to several years</p>	<p>Cost: measured mainly in management time in court rather than outright cost Timescale: may be many years before first hearing</p>	<p>What are the advantages of this course of action?</p>	<p>An inexpensive starting point; may be effective against infringers who are not well organised, or (perhaps) ignorant that they are committing an offence</p>	<p>Low costs; lack of publicity may be a plus; often non-confrontational and simple, with swift results and 'win-win' outcomes in contract or licensing cases that might be beyond a court's competence</p>	<p>May be quick and simple to arrange in countries where this enforcement method is available; most helpful in trade mark infringement and copyright piracy cases</p>	<p>The rights owner has control in bringing the action, whose outcome has the force of law; cases gain public attention so are transparent and easy to pursue, publicising the abuse</p>	<p>Can involve stiff sentences with a strong enforcement effect, especially in large or public health-related cases; injunctions and worthwhile damages may be awarded</p>	<p>And the disadvantages?</p>	<p>Less effective against habitual infringers; may alert them to a possible raid, allowing them to remove stock or relocate their illegal activities</p>	<p>Little publicity often leads to minimal deterrent effect; may be difficult to enforce award of punitive damages</p>	<p>In most countries damages are low or non-existent and meaningful penalties are rare; authorities may be unable to handle complex cases such as patents, which will need to go to court</p>	<p>The sanctions may fall short of deterrence; the level of damages and/or punitive damages may be meagre; non-specialist courts may struggle with complex cases</p>	<p>It is often difficult to get criminal actions started; once under way, they may take a long time and entail costly participation of the rights owner</p>
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APPENDIX D : KOREA/UK IP RIGHTS COMPARISON [RETURN] [INDEX]

Country/Form of IP Right	Maximum Initial Term from filing date; for copyright, from author's death (eg literary work)	Cost typical official fees, excluding legal representation	Time to Register typical period, from filing date	Extension Periods total = max extension term + initial term	Notes	
UK						
Copyright	70 yrs / 50 yrs	–	–	none	term depends on type of work	
Patent	4 yrs	£200	2 – 3 yrs	16 x 1 yr (total 20 yrs)	renewal on an escalating scale	
Design	5 yrs	£60	3 months	4 x 5 yrs (total 25 yrs)	cost for first design	
Trade Mark	10 yrs	£200	6 months	10 yrs (unlimited)		
Korea						
Copyright	70 yrs	£17	4 days	none	recordal fee	
Patent	Invention	20 yrs	£76	8 – 10 months	none	
	Utility Model	10 yrs	£9	10 months	none	except for pharmaceutical items (1x5 yrs max)
Industrial Design	15 yrs	£36	6 months	none	reduced fee for electronic application	
Trade Mark	10 yrs	£34	7 months	10 yrs (unlimited)		

Refusal of Well-Known Brand Status [return] [index]

A UK/Hong Kong company ('GarbCo'), which owns a luxury fashion brand, attempted to launch its products in Korea in 2004, only to find that a local company had seen the brand on the Internet and had decided to register the trade mark for itself.

GarbCo filed invalidation proceedings with the Korean Intellectual Property Office's IP Tribunal on the basis of its own prior registration. However GarbCo had failed to register all its marks and the Korean company and its associates began systematically to register GarbCo's sub-brands and other lines.

The invalidation case was refused by the tribunal, and again by the courts on appeal. Recognition of the brand as 'well-known' was rejected; so, too, was invalidation of the infringer's marks on any other grounds.

As a result, GarbCo was unable to sell its sub-brands in Korea because of the Korean firm's ownership of its marks; and its ability to market its primary goods was severely restricted by the Korean company's launch of a substantial range of tasteless look-alike versions.

Comment: The Korean trade mark system applies the rules on well-known marks restrictively and does not refuse the registration of marks whose filing is based on bad-faith intentions. Companies planning international expansion should register their intellectual property rights early on, ensuring they file for the local protection of their rights before launching their brands in new markets. They should register all relevant trade marks – not just their principal 'house' mark.

Source: Rouse & Co. International, which represented 'GarbCo'

APPENDIX F : REFERENCES [INDEX]

1 KOREAN IPR REFERENCES [INDEX]

Organisations

Copyright Commission [index]

<http://eng.copyright.or.kr/>

Korea Customs Service [return] [index]

<http://english.customs.go.kr/>

Korean Intellectual Property Office (KIPO) [return] [index]

<http://www.kipo.go.kr/kpo2/user.tdf?a=user.english.main.BoardApp&catmenu=ek>

Annual review for 2006 by Sang-Woo Jun, Commissioner of KIPO:

http://www.kipo.go.kr/upload/efile/annualreport_2006_01.pdf

Ministry of Culture, Sports and Tourism (MCST) [return] [index]

See 'Copyrights Team': <http://www.mct.go.kr/english/bureauofOffice/culturalIndustry.jsp>

Ministry of Information and Communications (MIC) [return] [index]

<http://eng.mic.go.kr/eng/user.tdf?a=user.index.IndexApp&tc=1001>

Laws and Procedures [index]

Application Procedures [index]

Details of how to apply to register patent, utility model, industrial design and trade mark rights in South Korea:

<http://www.kipo.go.kr/kpo2/user.tdf?a=user.english.html.HtmlApp&tc=30101&catmenu=ek30101>

Computer Programs Protection Act [return] [index]

http://www.socop.or.kr/english/sub4/sub4_02_2.jsp

Copyright Act [return] [index]

http://www.socop.or.kr/english/sub4/sub4_02_1.jsp

Fee Schedules [index]

Tables showing application, examination and registration fees for patent, industrial design and trade mark applications: <http://www.kipo.go.kr/kpo2/user.tdf?a=user.english.html.HtmlApp&tc=30200&catmenu=ek30200>

Industrial Property and Competition Acts [return] [index]

Downloadable .pdf versions of the Design Act, Patent Act, Semiconductor Integrated Circuits Lay-out Design Act, Trademark Act, Unfair Competition Prevention and Trade Secret Protection Act, and Utility Model Act (follow the link to 'Library'): <http://www.cilf.co.kr/>

KORUS Free Trade Agreement [return] [index]

http://www.ustr.gov/Trade_Agreements/Bilateral/Republic_of_Korea_FTA/Section_Index.html

Search Performance of KIPO [index]

Information about the time KIPO takes to conduct patent and trade mark searches:

<http://www.kipo.go.kr/kpo2/user.tdf?a=user.english.html.HtmlApp&tc=40200&catmenu=ek40200>

2 GENERAL AND INTERNATIONAL REFERENCES

Collection of Laws for Electronic Access (CLEA) [index]

This useful site, operated by the World Intellectual Property Organization (WIPO) is *'a unique electronic database providing easy access to intellectual property legislation from a wide range of countries and regions as well as to treaties on intellectual property. It is an invaluable information resource made available by WIPO free of charge to all interested parties, including researchers, legal professionals, policy-makers, students and administrators.'*
<http://www.wipo.int/clea/en/index.jsp>

Copyright [index]

Berne Convention [return] [index]

UK Copyright Service's article *'International copyright law – The Berne Convention'*:
http://www.copyrightservice.co.uk/copyright/p08_berne_convention

Copyright in the UK [return] [index]

UK-IPO:

<http://www.ipo.gov.uk/copy.htm>

Copyright Licensing Agency (CLA) [index]

Based in the UK, CLA licenses the copying of published extracts. Its website provides practical information on many aspects of copyright:
<http://www.cla.co.uk/>

Designs

Designs in the UK [return] [index]

UK-IPO:

<http://www.ipo.gov.uk/design.htm>

Unregistered Community Designs [return] [index]

Patent and trade mark attorney Hindle Lowther's explanation:
<http://www.hindlelowther.com/design11.htm>

International IPR Organisations, Systems and Treaties [index]

Community Trade Marks (CTM) [return] [index]

CTM resource site of the Office for the Harmonization of the Internal Market (OHIM):
<http://oami.europa.eu/en/mark/default.htm>

Overview by ipr.co.uk:

http://www.ipr.co.uk/IP_conventions/community_trade_marks.html

UK-IPO:

<http://www.ipo.gov.uk/abroad/abroad-tmeurope.htm>

European Patent Convention (EPC) [return] [index]

European Patent Office site for EPC:

<http://www.epo.org/patents/law/legal-texts/epc.html>

Text of the Convention:

<http://www.european-patent-office.org/legal/epc/e/contents.html>

Hague Agreement [return] [index]

WIPO datasheet '*Hague System for the International Registration of Industrial Designs*' with link to list of parties to the agreement:

<http://www.wipo.int/hague/en/>

UK-IPO site on linking of Hague Agreement and Registered Community Design:

<http://www.ipo.gov.uk/policy/policy-issues/policy-issues-designs/policy-issues-designs-protection.htm>

and European Commission press release on the same subject:

<http://europa.eu/rapid/pressReleasesAction.do?reference=IP/05/1691&format=HTML&aged=0&language=EN&guiLanguage=en>

International Anti-Counterfeiting Coalition (IACC) [index]

<http://www.iacc.org/contact.php>

International Intellectual Property Institute (IIPi) [index]

<http://www.iipi.org/>

Madrid Protocol [return] [index]

WIPO's introduction '*Madrid System for the International Registration of Marks*':

<http://www.wipo.int/madrid/en/>

UK-IPO:

<http://www.ipo.gov.uk/abroad/abroad-tmworld.htm>

List of Madrid Protocol registrations on WIPO's site:

http://www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty_id=8

Outlaw-Com's guide to '*Registering a Trade Mark through the Madrid Protocol (international application)*':

<http://www.out-law.com/page-376>

Paris Convention [return] [index]

WIPO's '*Summary of the Paris Convention for the Protection of Industrial Property*':

http://www.wipo.int/treaties/en/ip/paris/summary_paris.html

Patent Cooperation Treaty (PCT) [return] [index]

WIPO's PCT Resources site:

<http://www.wipo.int/pct/en/>

UK-IPO:

<http://www.ipo.gov.uk/abroad/abroad-patentworld/abroad-pct.htm>

Mewburn Ellis LLP's succinct explanation and list of members:

http://www.mewburn.com/downloads/PCT_Members_States_as_at_01Jun07_-_June_2007.pdf

Registered Community Design (RCD) [return] [index] See also Hague Agreement

UK-IPO:

<http://www.ipo.gov.uk/design/d-applying/d-should/d-should-abroad/d-should-abroad-eu.htm>

Rights Extensions [return] [index]

These are listed on the UK-IPO website, with descriptions of the rules and conditions for the extension of protection for the various UK and EU IP rights:

<http://www.ipo.gov.uk/abroad/abroad-extend.htm>

TRIPS [return] [index]

Trade-Related Aspects of Intellectual Property Rights:

http://www.wto.org/english/tratop_e/trips_e/trips_e.htm

UK-IPO:

<http://www.ipo.gov.uk/policy/policy-issues/policy-issues-trips.htm>

World Intellectual Property Organization (WIPO) [return] [index]

Website gateway to a copious source of IPR information:

<http://www.wipo.int/portal/index.html.en>

World Trade Organization (WTO) [return] [index]

WTO's home page:

<http://www.wto.org/>

List of WTO members: [return]

http://www.wto.org/english/thewto_e/whatis_e/tif_e/org6_e.htm

Miscellaneous

Books [index]

The Handbook of European Intellectual Property Management

'Developing, Managing and Protecting Your Company's Intellectual Property' by Adam Jolly

ISBN 9780749449889 published July 2007

<http://www.kogan-page.co.uk/bookdetails.aspx?ISBN=9780749449889>

Knockoff: the Deadly Trade in Counterfeit Goods

'The True Story of the World's Fastest Growing Crime Wave' by Tim Phillips

ISBN: 9780749443795 published December 2005

<http://www.koganpage.com/bookdetails.aspx?ISBN=0749443790>

Enforcement of Intellectual Property Rights in the UK [index]

Kirkland & Ellis International LLP on the system in England and Wales:

http://www.buildingipvalue.com/n_eu/279_283.htm

Intellectual Property Explained ('My IP'), UK-IPO 2007 [index]

A guide covering IPR for UK companies, together with advice on protection and the steps that would-be rights owners should take:

<http://www.ipo.gov.uk/myip.pdf>

Renewal of IP Rights [return] [index]

UK-IPO:

<http://www.ipo.gov.uk/manage/manage-renew.htm>

Reports [index]

HM Treasury, 2006: *'Gowers Review of Intellectual Property'*

http://www.hm-treasury.gov.uk/media/6/E/pbr06_gowers_report_755.pdf

OECD, 2007: *'The Economic Impact of Counterfeiting and Piracy (Executive Summary)'*

<http://www.oecd.org/dataoecd/11/38/38704571.pdf>

UK-IPO website [return] [index]

Guidance on all aspects of IPR in the UK, Europe and worldwide:

<http://www.ipo.gov.uk/home.htm>

Patents [Index]

Chartered Institute of Patent Attorneys (CIPA) [index]

The CIPA site offers a wide range of advice on patents, international news and articles, together with a search facility for UK-based and international patent attorneys, searchable by region:

<http://www.cipa.org.uk/pages/home>

Patents in the UK [return] [index]

UK-IPO :

<http://www.ipo.gov.uk/patent.htm>

Software Patents [return] [index]

The European Patent Office does not *'grant patents for computer programs or computer-implemented business methods that make no technical contribution. Programs for computers as such are excluded from patentability [unless they have] the potential to cause a 'further technical effect' which must go beyond the inherent technical interactions between hardware and software'*.

See EPO regulations on this subject:

<http://www.epo.org/focus/issues/computer-implemented-inventions.html>

and Ius Mentis's article *'Software Patents under the European Patent Convention'*:

<http://www.iusmentis.com/patents/software/epc/>

UK Patent Rules [index]

UK-IPO's 'unofficial consolidation' of the Patent Rules 1995:

<http://www.ipo.gov.uk/patentrules1995.pdf>

Trade Marks [Index]

Changes in UK Trade Mark Registration Procedures [return] [index]

Reddy & Grose's description of how existing owners of trade marks are to be consulted when UK-IPO receives applications for similar marks:

<http://www.reddie.co.uk/content/view/119/49/>

Domain Names [return] [index]

The following links provide guidance on:

- domain names in the context of IP law:
http://www.waterfrontpartnership.com/ip/d_domain_names.htm
- choosing and registering a domain name:
<http://www.nominet.org.uk/registrants/register/choose/>
- legal rights relating to domain names:
<http://www.nominet.org.uk/disputes/drs/rights/>
- domain name disputes:
<http://www.out-law.com/page-5700>

Geographical Indications [return] [index]

UK-IPO's notes on GI and links to further information:

<http://www.ipo.gov.uk/patent/p-applying/p-should/p-should-otherprotect/p-should-otherprotect-geographic.htm>

Institute of Trade Mark Attorneys (ITMA) [index]

This site provides a compendium of information on trade marks, including definitions, costs, tips on registration, FAQs and listings of ITMA members, sorted by UK region:

<http://www.itma.org.uk/intro/index.htm>

Nice Classification System [return] [index]

'The countries party to the Nice Agreement constitute a Special Union within the framework of the Paris Union for the Protection of Industrial Property. They have adopted and apply the Nice Classification for the purposes of the registration of marks.'

Class definitions:

<http://www.wipo.int/classifications/fulltext/nice8/enmain.htm>

Plant Varieties [return] [index]

DEFRA's 'Guide to the Plant Varieties Act 1997':

<http://www.defra.gov.uk/planth/pvs/guides/pvsact-20050317.pdf>

Semiconductor Topographies [return] [index]

The Design Right (Semiconductor Topographies) Regulations 1989:

http://www.opsi.gov.uk/SI/si1989/Uksi_19891100_en_1.htm

Trade Marks in the UK [return] [index]

UK-IPO:

<http://www.ipo.gov.uk/tm.htm>

Where to get help in South Korea [return] [index]

British Chamber of Commerce in Korea [return] [index]

<http://www.bcck.or.kr/>

British Embassy [return] [index]

<http://www.britishembassy.gov.uk/servlet/Front?pagename=OpenMarket/Xcelerate/ShowPage&tc=Page&cid=1093348568357>

EU Chamber of Commerce in Korea [return] [index]

<http://www.eucck.org/>

Korea-Britain Society [return] [index]

<http://www.britishembassy.gov.uk/servlet/Front?pagename=OpenMarket/Xcelerate/ShowPage&tc=Page&cid=1115145912016>

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