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Q244

Inventorship of multinational inventions

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I. Current law and practice

1) Please describe your law defining inventorship and identify the statute, rule or other authority that establishes this law.

a) If person A, located outside your country, directs the efforts of person B, located in your country, for making an invention in your country, under what circumstances would person A and/or person B be considered an inventor under your law?

The Korean Patent Act and its related laws do not provide a definition of inventor, and the definition of inventor in Korea has been established by case laws. According to the Korean case laws, only a person who has substantially engaged in the creative process of an invention can be considered as an inventor.

As discussed above, person A or person B can be considered as an inventor only when he/she has substantially engaged in the creative process of the invention.

Thus, person A can be an inventor when he/she has provided, added or supplemented a concrete idea to accomplish the invention. If person A has simply controlled person B (e.g. provides person B with a subject without indicating any substantial solution) or has merely provided person B with funds or facilities, person A may not be considered as an inventor in Korea.

Further, in order for person B to become an inventor, person B should have made creative

contributions to the substantive features of the invention. If person B has simply followed instructions from person A to collect data or conduct experiments, person B may not be considered as inventor in Korean.

Meanwhile, the citizenship or residence of person A and person B does not affect their inventorship in Korean.

b) Does your law defining inventorship rely on or look to a particular part of the patent application? For example, is inventorship under your law determined on a claim by claim basis, determined based on the content of the drawings or the examples, or determined on some other, and if so, what basis?

yes

Please comment:

Although the Korean laws do not provide guidance as to determining inventorship on which basis, it is generally admitted that a person can be considered as an inventor when he/she has contributed to establish a creative feature of an element (except for a known element) of an invention (i.e., a claim) included in a patent application.

2) Does your law of inventorship depend on the citizenship of the inventor(s)?

no

Please comment:

3) Does your law of inventorship depend on where the invention was made (e.g. on the residency of the inventor(s))?

no

Please comment:

4) Can the inventorship of a patent application be corrected after the filing date in your country?

yes

If yes, what are the requirements and time limits for such correction?:

Before allowance of a patent application, the inventorship can be corrected without limitations. After the allowance, the inventorship can be corrected only when the error is obvious. The obvious error includes, for example, a name change of an inventor, a wrong description of an inventor’s resident-registration number (only for Korean inventors), a repetition of a same inventor, etc.

5) What are the possible consequences of an error in the stated inventorship on a patent application in your country? Can a patent issued from such an application be invalidated or rendered not enforceable on that basis? Does it matter whether the error was intentional or unintentional?

Basically, an error in the inventorship does not affect the validity or enforceability of the patent, provided that there is no error in the applicant(s) of the patent application. That is, even when there is an error (intentional or unintentional) in the stated inventorship on the patent application, if the right to obtain a patent has been duly transferred from the inventor(s) to the applicant(s), the patent will be safe. For example, in Korea, it is common to list all members of a research team as joint inventors regardless of individual contribution to an invention. Such an intentional error in the inventorship does

not constitute a ground for invalidation of the patent, provided that the patent applicant (e.g., a company) has received the right to obtain a patent from all of the true inventors.

6) Does your law require that an application for a patent claiming an invention made in your country, whether in only one technical area or in all technical areas, be filed first in your country?

no

If no please comment:

The Korean Patent Act does not have any express provisions requiring that an invention developed in Korea be first filed in Korea or filed abroad after first obtaining a foreign filing license. That is, the Korean Patent Act does not prohibit the filing of a patent application for an invention developed in Korea, initially in a foreign country.

a) Is the law requiring first filing in your country limited to a specific area of technology or otherwise limited such that it does not apply to all inventions made in your country? If yes, please explain.

7) Does your law require that a patent application claiming an invention made, at least in part, in your country undergo a secrecy review or similar process before it can be filed in another country?

no

If no please comment:

Under the Korean Patent Act, generally, no prior "foreign filing license or approval" is required for filing a patent application in a foreign country.

However, the Korean Intellectual Property Office may prohibit a patent applicant from filing a patent application in a foreign country, if necessary for the purposes of national defense under Article 41 of the Korean Patent Act. Please note that the Korean Intellectual Property Office can determine whether to prohibit foreign filing only based upon review of a Korean patent application. In other words, if no patent application is filed in Korea, then the prohibition of Article 41 of the Korean Patent Act cannot apply.

On a related note, in connection with foreign filing, the assignment of the right to an invention (originated from Korea whether it is invented by a Korean national or by a non-Korean national) to a foreign entity may be subject to regulations related to the export of technology (subject to the technical fields of the technologies at issue) as follows:

(i) Regulation on National Core Technology under the Industrial Technology Disclosure Prevention and Protection Act ("ITDPPA")

In general, the purpose of the ITDPPA is to prevent illegal disclosure of "industrial technology" and to regulate export (e.g., the assignment and transfer) of the "National Core Technology." The National Core Technology refers to industrial technologies having a high technical or economic value, or a high growth potential in the domestic/foreign market, and whose disclosure outside of Korea poses a serious threat to the national security or economy. Although the ITDPPA does not specifically define "export," one definition of "export" may include the transfer (assignment or licensing) of an invention disclosure,

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a patent application or a patent.

(ii) Regulation on Strategic Goods under the Foreign Trade Act ("FTA") and Technology Development Promotion Act ("TDPA")

There is another set of statutes relating to export control of technology. Under the FTA, the TDPA and the Combined Notice on the Export/Import of Strategic Goods and Technology promulgated by relevant ministries (the "Notice"), "export" of "strategic technology" is regulated. Under Article 2 of the Presidential Decree of the FTA, the definition of "export" includes: (i) transfer or grant of exclusive or non-exclusive license by a "resident" to a "non-resident" of patent rights, utility model rights, design rights, trademark rights protected by Korean laws; and (ii) transfer of intangible goods in an electronic form through information technology network from a "resident" of Korea to a "non-resident". The Notice also lists the types of technology considered to be "strategic technology." The FTA defines exports as the transfer or grant of exclusive or non-exclusive license by a "resident" to a "non-resident" of patent rights. From this, it may be reasoned that any invention conceived by a "resident" would be subject to the provisions of the FTA, TDPA and the Notice.

II. Policy considerations and proposals for improvements of the current law

8) If your law defines inventorship, is this definition sufficient to provide patent applicants with clear guidance as to who should be named as the inventor(s) of a patent application? Are there aspects of this definition that could be improved?

As discussed in 1) above, only a person who has substantially engaged in the creative process of an invention can be considered as an inventor under the Korean case laws, and the determination of inventorship is conducted on a claim-by-claim basis. It may be neither necessary nor desirable to make a uniform and more-detailed definition of inventor since it can be vary depending on the fields of technology and also on the advance in technology. In that sense, the definition of inventor established by the Korean case laws could be considered as being an appropriate definition of inventor.

9) If you have laws requiring first filing of patent applications directed to inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?

There are no requirements for the first filing in Korea under the Korean laws.

10) If you have laws requiring a secrecy review of patent applications directed to some or all types of inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?

There are no requirements for the secrecy review before a foreign filing under the Korean laws.

11) Are there other aspects of your law that could be improved to facilitate filing of patent applications having multinational inventorship? If yes, please explain.

Since no prior foreign filing license or approval is required for filing a patent application in a foreign country under the Korean laws, generally, multinational inventions originated, at least in part, from

Korea can be freely filed in a foreign country without limitations.

III. Proposals for harmonisation

12) Is harmonisation in this area desirable?

yes

Please comment.:

Such harmonization may be necessary and desirable. However, it may be difficult or even impossible since this area relates to the national interest of each country.

If yes, please respond to the following questions without regard to your national or regional laws. Even if no, please address the following questions to the extent you consider your national or regional laws could be improved.

13) Please provide a definition of inventorship that you believe would be an appropriate international standard.

As discussed in 8) above, a comprehensive and broader definition of inventor would be suitable for the international standard, such as, for example, that only a person who has substantially engaged in the creative process of an invention can be considered as an inventor, as being established by the Korean case laws.

14) Please propose a standard for correction of inventorship after a patent application is filed, together with any requirements necessary to invoke this standard (e.g. intentional versus unintentional error) and any timing requirements (e.g. during pendency of the application).

As an international standard for correction of inventorship, it may desirable to allow the correction only for unintentional errors during pendency of the patent application. As for the allowable scope of correction, it may be desirable to include addition of an omitted inventor as well as correction of any description errors on the inventorship in the patent application.

15) If you believe such a requirement is appropriate, please propose an international standard for first filing requirements that would take into account multinational inventions.

We believe that the first filing requirements are not necessary.

16) If you believe such a requirement is appropriate, please propose an international standard for secrecy review requirements that would take into account multinational inventions.

We believe that the secrecy review requirements are not necessary.

17) If you believe such a requirement is appropriate, please propose an international standard for obtaining a foreign filing license.

Since we believe that the first filing requirements are not necessary, the foreign filing license is not applicable.

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18) Please propose an international standard for an ability to cure or repair an inadvertent failure to comply with a first filing requirement or a security review requirement.

Since we believe that the first filing requirements and the secrecy review requirements are not necessary, such an international standard is not applicable.

19) Please propose any other standards relating to multinational inventions (excluding those related to inventor remuneration or ownership of the invention) that you feel would be appropriate.

Summary

As an international standard, an expansive definition of inventorship would be suitable, such as, for example, that only a person who has substantially engaged in the creative process of an invention can be considered as an inventor. Further, it is proposed to allow correction of inventorship after filing of a patent application only for unintentional errors and during pendency of the patent application. As for multinational inventions (and also for other inventions), we don't believe first filing and secrecy review requirements are necessary. Thus, we proposed, for the international harmonization, that the first filing and secrecy review requirements should be repealed in the countries that have such requirements.

Please comment on any additional issues concerning the multinational inventions you consider relevant to this Working Question.

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