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## PATENTING IN FOREIGN COUNTRIES— SPOTLIGHT ON SOUTH KOREA

### OVERVIEW

Patent lawyers many times have to remind themselves of some of the stark differences between patent laws in the U.S. and in foreign countries. For some time South Korea has been emerging as a significant manufacturing and technology country. As a result, its patent system has likewise ascended in prominence.

A potential pitfall for inventors in the United States is to forget about preserving the ability to file in foreign countries. Although sometimes a remote possibility, it is important to discuss even the slightest interest in foreign coverage at the onset of considering patenting. Sometimes, if the issue is raised later in the process, it is too late.

South Korea has adopted a law that is more favorable to patenting than many other foreign countries as described below.

### THE GENERAL “ABSOLUTE NOVELTY” RULE FOR MOST FOREIGN COUNTRIES

The following example illustrates the pitfall. The United States allows inventors up to one year from their earliest offer for sale, sale, published article, or non-experimental use of an invention to file the U.S. application. This is known as the “one year grace period.” The policy is to allow inventors that time to discern whether spending the resources to pursue a patent is worth it. They can test the marketplace for that purpose.

Most major foreign countries do not have a grace period. To the contrary, you are ineligible to file a patent in those countries if the idea has been disclosed to anyone in the public. This includes even modest or minimal disclosures (e.g. to one person). Thus the words “absolute novelty”—before you file in a country there can be absolutely no public disclosure of it.

### THE SOUTH KOREA EXCEPTION HAS BEEN BROADENED

South Korea had been an exception to the absolute novelty rule. They had a limited 6 month grace period for certain activity. As a part of increasing collaboration between the South Korean and U.S. governments on patent issues, as of March 15, 2012, that has been extended to 1 year.

Sometimes referred to as “harmonization,” many major countries around the world are trying to align their patent systems. This has resulted in the U.S. giving up some of its uniqueness (over and above the one year grace period, the U.S. was almost singularly unique in what is sometimes called the “first to invent” rule). The “first to invent” rule gives the U.S. patent not to the person that files a patent application first but to the person that can prove they conceived the idea first. This eliminated the race to the Patent Office that is common in other countries. It is notable that as a part of the United States attempt to harmonize with the rest of the world, that first to invent rule goes away next spring 2013.

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In any event, at least with South Korea, if absolute novelty does not exist for an invention, there still might be a chance of patenting there. As with the example given previously, this means that if a U.S. inventor had sold one of the products made under his or her invention in the United States, if the South Korean patent is filed within a year of that earliest date there still may be a chance to patent it there.

## CONCLUSION

The best advice is still to keep an idea completely secret until decisions are made to file patents both in U.S. and any foreign country of potential interest. But it is notable that even if that normal absolute novelty rule might otherwise preclude filing in a foreign country such as South Korea, there are situations where it can still be filed. You should consult your patent advisor to check whether or not a country of interest otherwise ineligible under absolute novelty might still be available.

## AMERICA INVENTS ACT OF 2011 UPDATE

As previously reported here, the America Invents Act includes provisions which will go into effect at different times. Changes which go into effect on September 16, 2012 include:

**Citation of prior art.** Any person may at any time cite to the Patent Office prior art patents or publications relevant to patentability of one or more claims of a patent. This information becomes a part of the official file for the patent.

**Filing Applications by Assignees.** An assignee of an invention may file a patent application thereby simplifying the filing procedure for applications traditionally requiring the oath or declaration of an inventor.

**Supplemental Examination.** Beginning September 16, 2012, supplemental examination after issuance of a patent may be requested by a patentee to consider any issues that may affect the validity of their patent.

**Third Party Prior Art Submissions.** Any third party can submit relevant prior art in pending applications

within six months of the publication of the application (and before a notice of allowance). The third party can submit any printed publication they believe to be prior art, which must include a statement of the prior art's relevance.

**Change in standard for inter partes reexamination.** The standard used to determine whether or not to grant an inter partes reexamination changes from "a substantial new question of patentability affecting any claim of the patent concerned is raised by the request" to "the information presented in the request shows that there is a reasonable likelihood that the requester would prevail with respect to at least 1 of the claims challenged in the request."

For more complete information regarding the America Invents Act, please contact your MVS attorney.

## PARTNERING WITH THE U.S. CUSTOMS AND BORDER PROTECTION PATROL TO GET THE MOST OUT OF TRADEMARK AND COPYRIGHT PROTECTION

*by Christine Lebrón-Dykeman*

Recently, we have been receiving more client requests regarding registration of trademarks and copyrights with the U.S. Customs and Border Protection Patrol ("CBP"). We wrote about this topic in MVS Briefs several years back, but thought that it might make sense to provide a refresher at this time.

When a trademark or copyright is recorded with CBP, CBP officers have the power to act against counterfeits, infringing knockoffs, and even imports that are "confusingly similar" to a recorded trademark or "substantially similar" to a recorded copyright. Upon recordation, the owner's information is entered into an electronic database accessible to over 40,000 U.S. Customs officers at all 317 official ports of entry across the United States. CBP uses the information in this database to target and examine suspect shipments and seize and forfeit infringing merchandise to stop the infringing merchandise from ever entering U.S. soil. After any seizure, the CBP will contact the trademark or copyright owner and provide them with information, if

known, regarding the seizure, such as a description of the merchandise, the quantity involved, the name and address of the manufacturer, and the name and address of the importer. Also, the CBP may provide the owner with a sample of the suspected infringing merchandise in order to pursue a related private civil remedy for trademark infringement. CBP also has the authority, at their discretion, to issue monetary fines or to request that the U.S. Attorney's Office criminally prosecute those involved under the Trademark Counterfeiting Act of 1984. U.S. Customs officers located at American Embassies around the world also strive to cooperate with foreign law enforcement agencies and share information for the criminal prosecution of manufacturers and exporters of counterfeit merchandise located overseas.

Trademark and copyright recordings may be filed online with U.S. Customs' new Intellectual Property Rights e-Recordation (IPRR) online system. Before logging on to record a trademark or copyright, a trademark or copyright holder should be extremely knowledgeable with the Customs regulations found in 19 CFR Part 133, and the specific questions that will be asked on the application. Otherwise, consider consulting an experienced MVS attorney already familiar with the process.

The following is a checklist of the type of information you should have on hand before submitting your electronic trademark or copyright application.

- Description of trademark or copyright registered with the U.S. Patent & Trademark Office or U.S. Copyright Office
- U.S. Trademark or Copyright Registration Number
- Country of manufacture of protected goods bearing the trademark, or Country of manufacture of genuine copies of the protected copyright work
- Name(s) of any parent companies, subsidiaries, or other entities, that are under common control with, or share any type of ownership interest or relationship with, the U.S. trademark owner, or names of all parties authorized to use or reproduce the trademark or copyrighted work

The CBP recordings are subject to government fees in the amount of \$190 per copyright and \$190 per international classification of any trademark. After all the necessary paperwork and fees have been submitted, the applicant's

registration with the CBP is effective on the date an application for recordation is approved, as shown on the recordation notice issued by the CBP. The registration will remain in force concurrently with the registration period of the trademark at the U.S. Patent & Trademark Office. Thus, when a trademark is renewed with the U.S. Patent & Trademark Office, it must also be renewed with the CBP.

In sum, all trademark and copyright owners should at least consider CBP registration if they have any concerns about counterfeit goods. Recordation of a trademark or copyright with the CBP can help to safeguard against unauthorized imports and strengthen license and distribution agreements.

## MVS ATTORNEY GOES THE DISTANCE

*by Christine Lebrón-Dykeman*

This June, after many long months of intense training, I became an Ironman at the Ironman® Couer d'Alene in Couer d'Alene, Idaho. What began a few years ago as a desire to get outside and get in shape has transformed into a passion for the sport of triathlon (an athletic competition consisting of three different events: swimming, cycling, and running). Ironically, I spent my entire childhood and most of my adult life as a complete "non-athlete"—someone who virtually knew nothing about sports and certainly never played sports. However, in the summer of 2007, I had what one would consider an epiphany after watching the Hy-Vee® Triathlon in Des Moines. That day, I saw people of all ages, genders, shapes and sizes participating together in a sport where they swam in Grey's Lake, biked in downtown Des Moines and ran up to our state's Capital. In short, I was absolutely inspired and immediately set a goal of participating in that very race in 2008.

Three years later, after participating in various distances of the sport and working through numerous physical injuries, I set a new goal—a goal to participate in one of the world's most difficult distances, the Ironman® Triathlon which is an endurance race encompassing a 2.4-mile swim, a 112-mile bike ride and a 26.2-mile run. To be frank, my decision to participate in a race of this kind still shocks me as I have yet to wrap my head around the fact that I am now—at 42 years of age—an athlete. However, what I have learned over the past year of training and a day-long race in Couer d'Alene is that the primary skill set necessary to train for and compete in an Ironman is tenacity, will power and support from those around you.

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After six months of “two-a-day” training sessions, race day arrived on June 24, 2012. It is difficult to explain the awe of participating in an Ironman race. Approximately 2,700 participants began the day on the shore of Lake Couer d’Alene, standing on the edge of 57-degree water, in air temperatures of 59 degrees. Needless to say, we were a very cold group of racers. Our swim consisted of two 1.2 mile laps in the lake during which you had to exit the water and run on the beach for a few hundred yards between laps—something which surprisingly shocks your system when you have to jump back into the water for the second loop! Also for those of us, like me who are slower swimmers, we were faced with intense waves on the second loop of the swim as a storm passed by.

After exiting the swim in just under two hours, I ran into transition and straight into the warming hut with the hope of increasing my body temperature several degrees before jumping on my bike for the 112-mile ride. What a beautiful ride it was! Our course took us around Lake Couer d’Alene and then over some long rolling hills in and around the city where we had the opportunity to view some of the most beautiful pine tree lined landscape our country has to offer. The course is filled with volunteers and spectators supporting you the entire way, by screaming out cheers of encouragement or offering extra food and water. It is simply an amazing way to experience an area and the kindness of strangers.

Eight hours later at approximately 5 p.m., I was off the bike and headed out to start my marathon. This is truly where will power came into play. It is undeniably hard to start a marathon at 5 p.m. after spending an entire day already utilizing all of your muscles. Everything hurt and I still had hours to go. At that point, it became a function of mind over matter, along with a true desire to finish what I began training for those many months back! My goal was just to keep moving forward.

Before I knew it, the day was over. I was running the last several blocks, hearing the screams and cheers of hundreds of spectators and I passed the finish line to hear Ironman’s announcer, Mike Reilly, scream out “Christine Lebrón-Dykeman, you are an Ironman!” As I sit here today, I am still in awe of what our bodies can accomplish when our minds are focused on a goal.

“Ironman has always been about finishing what you have started. About being able to do what you have set out to do. Maybe not as fast as the person in front of you but certainly faster than the person that never started” - John Collins, Founder of The Ironman Triathlon.



## WE’RE THERE

### Oct. 5-6

Kirk Hartung will speak at the Iowa Intellectual Property Law Association Annual Seminar in Bettendorf, IA.

### Oct. 23-24

Kyle Coleman and Luke Holst will attend the Enterprise Institute Innovation Expo in Sioux Falls, SD.

### Oct. 25-27

Kirk Hartung will attend the LEGUS Fall meeting in Buenos Aires, Argentina.

### Nov. 15

MVS is a sponsor and members will attend the Iowa Women of Innovation event at the Marriott Hotel in downtown Des Moines, IA.

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