

**REVIEW OF THE PROVISIONS OF ARTICLE 27.3(b)**

Information from Members

Addendum

REPUBLIC OF KOREA<sup>1</sup>

The present document represents the information requested by the Council for Trade-Related Aspects of Intellectual Property Rights which the Secretariat has received from the Republic of Korea, by means of a communication from its Permanent Mission, dated 11 February 1999. The information is provided in the spirit of voluntary participation of the Republic of Korea to contribute to the discussions of the Council on this Article and without prejudice to its legal status under Article 65.2 of the Agreement.

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A. PATENT PROTECTION OF PLANT AND ANIMAL INVENTIONS

1. *To what extent are inventions concerning plants or animals, whether products or processes, patentable under your country's law, if they meet the conditions for patentability stipulated in Article 27.1 of the TRIPS Agreement?*

Regarding plants, only asexually reproduced plants are patentable under Article 31 of the Patent Act. However, there is no provision in the Patent Act that explicitly denies the patentability of animal per se.

2. *Where any such inventions are not patentable, even if they meet these conditions:*

(i) *To what extent is this due to per se exclusions from patentability?*

Even though not specifically mentioned in the related Act, it is generally understood, and stipulated in the "Examination Guideline for Inventions in Specific Fields," that the following are not patentable:

- inventions concerning humans or human organs;
- inventions in which humans are a constituent of the invention;
- and methods of diagnosis, therapy, or surgical treatment for humans.

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<sup>1</sup> An illustrative list of questions prepared by the Secretariat in response to a request from the Council is available in document IP/C/W/122.

- (ii) *To what extent is this based on other grounds (for example because conditions for patentability other than those stipulated in Article 27.1 are not met or in order to protect order public or morality (see Article 27.2 of the Agreement))?*

Under Article 32 of the Patent Act, inventions that would contravene public order or morality, or be harmful to public health, shall not be patentable. Inventions lacking the description requirement are also not patentable under Article 42.3 of the Patent Act.

3. *Please describe any specific provisions, guidelines, final judicial decisions and administrative rulings of general application concerning the application of the conditions for patentability stipulated in Article 27.1 to subject matter addressed by Article 27.3(b).*

Patent Examination Guideline for the Field of Biotechnology was newly added to the Examination Guideline for Inventions in Specific Fields in March 1998 to cover the biotechnology field.

4. *Where plant varieties are not as such patentable subject-matter under your country's law, please indicate the extent to which the scope of protection under patents for inventions concerning plants can nevertheless embrace plant varieties or a botanical taxon whose plants express a trait covered by the claims of a patent.*

As mentioned in the answer to question 1 above, asexually reproduced plants are patentable under Article 31 of the Patent Act.

5. *Please provide any definitions used under your country's law with regard to subject-matter specifically excluded from patentability or specifically patentable (e.g. micro-organisms, microbiological processes, non-biological processes, plant varieties)*

See the answer to question 4 above.

6. *To what extent is subject-matter that is identical to what occurs in nature patentable under your country's law?*

Even if the subject-matter is identical to what occurs in nature, inventions that contain artificial efforts and meet the conditions for patentability, including reproducibility, according to Article 42.3, are patentable.

7. *Explain the requirements under your country's law for ensuring adequate disclosure of the patentable inventions referred to above.*

Article 42.3 stipulates that the purpose, construction, function and effect of the invention shall be described so that it may be easily carried out by a person having ordinary skill in the art to which the invention pertains.

8. *What rights are conferred upon owners of the patents referred to above? Are product and process patents subject to the same rules as other patents? Do they benefit from the same protection as stipulated in Article 28 of the TRIPS Agreement?*

A patentee shall have the exclusive right to "work" a patented invention both commercially and industrially under Article 94 of the Patent Act; "working" means any one of the following under Article 2.3 of the Patent Act:

- (a) in the case of an invention of a product, acts of manufacturing, using, assigning, leasing, importing, or offering for assigning or leasing (including displaying for the purpose of assignment or lease) the product;
- (b) in the case of an invention of a process, acts of using the process; and
- (c) in the case of an invention of a process of manufacturing a product, acts of using, assigning, leasing, importing, or offering for assigning or leasing the product manufactured by the process, in addition to the acts mentioned in subparagraph (b).

9. *Are there any specific exceptions to these rights (affecting the scope or duration of the patents referred to above)? To what extent are exceptions, available in respect of plant variety rights (e.g. those referred to under question B.4(i) below), available in respect of rights conferred upon patent owners?*

There is no specific exception.

10. *Are there any specific provisions under your country's law for compulsory licensing in respect of the patents referred to above?*

There is no specific provision.

## B. PROTECTION OF PLANT VARIETIES

1. *Does your country's law provide for the protection of plant varieties by plant breeder's right, plant patents or any other sui generis system for the protection of plant varieties?*

The Seed Industry Act, which took effect on 31 December 1997, protects the rights of new plant variety breeders.

- 2. (a) If your country is a party to the International Convention for the Protection of New Varieties of Plants (UPOV), please indicate which Act or Acts of the UPOV Convention your country has signed; which it has ratified; to which it has acceded; and to the standards of which its law conforms but to which it has not (yet) adhered.
- (b) If your country is not a party to the UPOV Convention, does the protection offered to plant varieties under your country's law conform to the standards of any of the Acts of the UPOV Convention and, if so, which?

The Republic of Korea is not a party to the UPOV Convention, but the current Seed Industry Act conforms to the 1991 Act of the UPOV Convention.

3. *Please indicate whether concurrent protection under your country's plant variety protection law and its patent law is available (see also question A.4 above).*

Protection is offered to asexually produced plants under both the current Seed Industry Act and the Patent Act. While protection of breeders' rights is offered to both asexually and sexually produced plant varieties under the Seed Industry Act, the Patent Act provides patent protection to only asexually produced plant varieties.

4. Please provide the following details of your country's *sui generis* system for the protection of plant varieties:

- (a) *the relevant laws and regulations and, if they have been notified to the Council for TRIPS, a reference to the relevant WTO documents;*

The relevant domestic law and regulation for the protection of plant protection are the Seed Industry Act and its Enforcement Regulation.

- (b) *the definition of "plant varieties";*

According to Article 2.4 of the Seed Industry Act, plant varieties are defined as "a plant grouping within a single botanical taxon of the lowest known rank, where the grouping can be distinguished from another plant grouping by the expression of at least one characteristic, and is considered as a unit with regard to its suitability for being propagated unchanged."

- (c) *the conditions required for protection;*

Under Article 12, the Seed Industry Act, protection is granted to a variety, provided that such variety has novelty, distinctness, uniformity, stability and a separate denomination.

- (d) *the extent to which subject-matter that is already known to the public or identical to what occurs in nature is protectable under your country's sui generis system for the protection of plant varieties;*

Article 13.2 of the Act provides that, among the varieties which have already been known at the time when species or genus of the plants entitled to variety protection under the Act are determined in accordance with the Ordinance of the Ministry of Agriculture and Forestry, a variety falling under any of the following category shall be entitled to protection, provided that an application for variety protection thereof is made within one year from the date of the determination.

- (i) a variety registered or specified under the past relevant laws.
- (ii) a variety whose protection rights are registered in foreign countries.
- (iii) a variety whose breeder and initial circulation date are verified.

- (e) *the extent to which protection can be based on characteristics of germplasm, as opposed to characteristics of plant varieties derived from such germplasm;*

Under the Seed Industry Act, a variety essentially derived from the protected variety is also considered to be a protected variety and, therefore, cannot be protected as a new variety.

- (f) *who is entitled to the rights;*

Those who make an application for variety protection and registered their variety protection right in accordance with the Seed Industry Act are entitled to the rights.

- (g) *the procedure for the acquisition of rights, including the authority in charge of administering the rights;*

The application for variety protection should be made to the Minister of Agriculture and Forestry, who will designate examiners to review the application. Once the application is accepted, the Minister of Agriculture and Forestry, registers the establishment of the variety protection right. Upon registration, the variety protection right comes into force.

- (h) *the rights conferred;*

Those who hold variety protection have exclusive rights to exploit the protected varieties concerned on a commercial and industrial basis.

- (i) *exemption to the rights conferred, such as:*

- *acts performed for research or experimental purposes;*
- *acts performed to develop new varieties of plants;*
- *acts performed to commercialize such newly developed varieties;*
- *any "farmer's privilege" (e.g. acts performed by a farmer on his own land in respect of seed saved from the previous harvest);*
- *acts done privately and for non-commercial purposes;*
- *compulsory licensing.*

Under Article 58 of the Seed Industry Act, the effects of a variety protection right shall not extend to any of the following:

- exploitation of the protected variety for self-consumption or for non-commercial purposes.
- exploitation of the protected variety for experimental and research purposes.
- exploitation of the protected variety with a view to breeding other varieties.
- farmers' collection of seeds of the variety for self-production purposes.

Article 68 also provides for a compulsory licensing system.

- (j) *the duration of protection;*

Under Article 56 of the Act, the variety protection right shall expire at the end of the 20th calendar year following the date of the registration of its establishment. For ornamental trees and fruit trees, the right shall expire at the end of the 25th calendar year following the date of the registration of its establishment.

(k) *transfer of rights;*

A variety protection right may be transferred by the act of assigning its share, bequeathment, or other general succession.

(l) *enforcement of the rights*

Any person who infringes the variety protection right shall be punished by imprisonment for not more than 5 years, or by a fine not exceeding 30 million won.

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