

South Korea, Taiwan, Turkey: Design Law Updates

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South Korea—Broadened Scope of Designs Eligible for Registration

The Korean Intellectual Property Office recently amended its examination guidelines for registered designs, making it easier to meet the design “creativity” eligibility requirement. Effective January 1 2017, these guidelines require examiners to base any rejections citing lack of creativity on substantial evidence, and not on mere contentions that the design at issue comprises recognized geometric shapes or other assertedly minimalist shapes or patterns. This evidence could comprise cited prior art designs or evidence that the design reflects ways of expression that are common in the particular design field.

These changes follow analogous changes in 2016 to allow registration of computer screen icons and other digital graphics projected onto a fixed surface. As in the U.S., a design registration in South Korea can only issue for an actual article of manufacture or portion thereof, so the portion of the article where the icon is displayed must be identified in the application drawings.

With these changes, the recent trend in the Republic of Korea is to expand the range of registerable designs. Clients seeking international design registrations for new and novel designs, especially for

digital graphics, should consider whether these changes can help enhance their international design filing strategies.

NOTE—Just prior to publication of our newsletter, we learned that additional amendments to the Design Protection Act in the Republic of Korea were published in March and will be effective in September. Probably the most significant amendment extends the grace period to file after a public disclosure of the design from six months to one year. Moreover, the grace period exception can now be invoked at any time during pendency of the application, instead of only up to the time a response to the first action is filed. This amendment will make design filings in Korea more accessible and will help temper the effect of public disclosures of the design that are only discovered after the application has been examined.

Taiwan—Grace Period for Filing Expanded

Design registrations in Taiwan were largely subject to an “absolute novelty” standard whereby any prior public disclosure of the design before filing destroyed novelty unless the disclosure fit within narrow exceptions. These exceptions were: Printed publications disclosing the design, display of the design at a Government-recognized exhibition, or a disclosure without the applicant’s consent. Moreover, even if one of these exceptions applied, the grace period permitted for filing was only six months from the first disclosure date.

Recent amendments to the Patent Act effective for applications filed after May 1, 2017 extend this grace period to twelve months. Moreover, the range of public disclosures covered by the grace period are expanded to include disclosures that are “against the intent of the applicant.” These include disclosures resulting from a misunderstanding or negligence. Circumstances when the above apply include confidential disclosure to someone whom the applicant believes is required to keep it secret, or when the applicant’s employees or agents inadvertently disclose the design to the public. But the grace-period exception would not apply in the case of a prior published design application, as the applicant’s intent in filing the application without deferring publication would be presumed.

These changes help to excuse inadvertent public disclosures that otherwise would destroy the novelty of a design application, recognizing that oftentimes applicants are large companies with numerous potential sources from which information about a new design can be unwittingly disclosed. Moreover,

the increase of the term to twelve months affords applicants more time to discover and address any prior inadvertent disclosures.

The new amendments move the law in Taiwan closer to other more expansive grace-period exceptions in other countries. But clients should nonetheless be mindful that any prior public disclosure could destroy the novelty of a registered design, making a significant source of design protection unavailable. Close consultation with counsel to streamline design development and filing as early as possible before disclosure are crucial to avoid loss of registration opportunities.

Turkey—Unregistered Design Right Enacted

Taking note of unregistered design rights recognized elsewhere (such as the European Union), Turkey amended its Intellectual Property Code as of January 10, 2017 to recognize similar enforceable unregistered rights for new product designs that are first introduced in Turkey. The term of protection is three years from first public disclosure.

The enactment of an unregistered right is welcome news, especially given Turkey's large export-oriented textile and leather industry. However, the right is subject to many of the same strict requirements and burdens of proof applicable to unregistered design rights in Europe. Often, proving ownership and development of the design as well as priority, and avoiding any prior art challenges, prove to be too daunting for many European design owners. Moreover, the scope of rights granted are typically quite narrow so, on the whole, only infringements featuring identical copies will be actionable. As a result, in most cases a showing of intentional copying will be required based either on direct evidence of bad faith or by establishing that the infringer had ample opportunity to encounter the protected design.

Of course, Turkey also has a well-developed design registration system. However, despite its limitations and hurdles, unregistered design rights (which can co-exist in Turkey with design registrations) provide a ready enforcement tool that can be asserted promptly. This can be very helpful to shore up protections in industries where designs change constantly and where many designs are copied almost immediately after launch.

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