

TRADEMARK ACT

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CHAPTER I

GENERAL PROVISIONS

Article 1 Purpose

The purpose of this Act is to ensure the maintenance of the business reputation of persons using trademarks by protecting trademarks so as to contribute to the development of industry and to protect the interests of consumers.

Article 2 Definitions

(1) The definitions of terms used in this Act are as follows:

(i) "trademark" is defined as either of the following (referred to as "a mark") that is used on goods related to the business of a person who conducts business activities, such as producing, processing, certifying or selling such goods, to distinguish them from the goods of others;

(a) a sign, a character, a figure, a three-dimensional shape or any combination of these; or

(b) combination of color with any of the items of subparagraph (a) of this paragraph;

(ii) "service mark" means a mark used by a person who conducts a service business to distinguish the service business from the service businesses of others;

(iii) "collective mark" means a mark intended to be used by a legal entity founded in association with a person who conducts business activities such as producing, manufacturing, processing, certifying or selling goods and with a person who conducts a service business; members of the legal entity can use the mark for their goods and services;

(iii*bis*) "geographical indication" means an indication that identifies a good as originating in a certain region where a given quality, reputation or other characteristic of the good is essentially attributable to that region;

(iii*ter*) "homonymous geographical indication" means a geographical indication that has the same pronunciation as another geographical indication on the same type of goods, but which refers to a different geographical region;

(iii*quarter*) "collective mark for a geographical indication" means a collective mark intended to be used by a legal entity composed solely of persons who conduct business activities such as producing, manufacturing, processing, or selling goods; members of the legal entity can use the collective mark for their goods;

(iv) "business emblem" means a mark used by a person conducting a nonprofit business to indicate the person's business;

(v) "registered trademark" means a trademark for which trademark registration has been granted; and

(vi) "use of a trademark" means any of the following acts:

(a) using trademarks on goods or their packaging;

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(b) selling or delivering goods or their packaging on which trademarks have been used, or displaying, exporting or importing such goods or their packaging for the purposes of selling or delivering; or

(c) using a trademark on advertisements, price lists, business papers, signboards or labels, or displaying or distributing them.

(2) Acts of using a trademark on goods or their packaging, advertisements, signboards or labels under paragraph (1)(vi)(a) to (c) of this Article include the use of goods or their packaging, advertisements, signboards or labels as shapes of marks.

(3) Except as otherwise stipulated in this Act, the provisions in this Act that are related to trademarks apply to service marks, collective marks and business emblems.

Article 3 Persons Entitled to Register a Trademark

A person who uses or intends to use a trademark in the Republic of Korea is entitled to trademark registration; however, employees of the Korean Intellectual Property Office or employees of the Intellectual Property Tribunal are not entitled to register trademarks during their employment at the office or tribunal except in the case of inheritance or a bequest.

Article 3bis Persons Entitled to Register a Collective Mark

A legal entity founded in association with a person who conducts business activities such as producing, manufacturing, processing, certifying or selling goods and with a person who conducts a service business is entitled to register a collective mark. Whenever a collective mark is used as a geographical indication, use of the mark is limited to legal entities composed solely of persons who conduct business activities such as producing, manufacturing, processing or certifying goods.

Article 4 Persons Entitled to Register a Business Emblem

Any person who conducts a nonprofit business in the Republic of Korea is entitled to register a business emblem.

Article 5 *Mutatis Mutandis* Application of the Patent Act

Articles 3 to 26 and 28 to 28^{quinquies} of the Patent Act apply *mutatis mutandis* to trademarks. In such cases, "Article 132^{ter}" in Articles 6, 11(1)(iv), 15(1) and 17 of the Patent Act reads "Article 70^{bis} or 70^{ter}", "patent right and patent" in the proviso of Article 28(2) of the Patent Act reads "trademark right and trademark" and "international application under Article 2(vii) of the Patent Cooperation Treaty (referred to as an 'international application')" reads "international application under Article 2(2) of the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (referred to as 'an international application'). (The Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks is referred to as 'the Protocol').".

CHAPTER II

REQUIREMENTS FOR TRADEMARK REGISTRATION AND TRADEMARK APPLICATIONS

Article 6 Requirements for Trademark Registration

- (1) Trademark registration may be obtained except in any of the following cases:
- (i) where the mark consists solely of a sign indicating, in a common way, the usual name of the goods;
 - (ii) where the mark is customarily used on the goods;
 - (iii) where the mark consists solely of a sign indicating, in a common way, the origin, quality, raw materials, efficacy, use, quantity, shape (including the shape of the packaging) or price of the goods, or the method or time of manufacturing, processing or using them;
 - (iv) where the mark consists solely of a sign indicating a conspicuous geographical name, an abbreviation of a conspicuous geographical name or a map;
 - (v) where the mark consists solely of a sign indicating, in a common way, a common surname or name of a legal entity;
 - (vi) where the mark consists solely of a very simple and commonplace sign; or
 - (vii) in addition to the cases mentioned in subparagraphs (i) to (vi) of this Article, where the mark does not enable consumers to recognize the person whose goods are indicated by the mark.
- (2) Even if a trademark that falls under paragraphs (1)(iii) to (vi) of this Article, where, as a result of using the trademark before the application for registration under Article 9 of this Act, consumers are easily able to recognize the person whose goods are indicated by the trademark, the trademark may be registered with the designated goods for which the trademark has been used; the same applies to designated goods and supplementary designated goods as defined in Articles 10(1) and 47(2)(iii) of this Act.
- (3) Notwithstanding marks that are subject to paragraph (1)(iii) of this Article (which is limited to the producing area) or paragraph (1)(iv) of this Article, whenever a mark is used as a geographical indication on specific goods, a collective mark for a geographical indication may be registered for designated goods that use the geographical indication.

Article 7 Unregistrable Trademarks

(1) Notwithstanding Article 6, trademark registration may not be obtained in any of the following cases:

(i) trademarks that are identical or similar to the following: the national flag, the national emblem, as well as colors, medals, decorations or badges of the Republic of Korea; the national flags or emblems of foreign nations; the medals, decorations or badges of the countries party to the Paris Convention for the Protection of Intellectual Property (referred to as "the Paris Convention") or of the members of the World Trade Organization or of the contracting parties to the Trademark Law Treaty; the titles or marks of the Red Cross, Olympic organizations or well-known international organizations; titles or marks that are identical or similar to seals or signs of the Republic of Korea, or of the countries party to the Paris Convention, the members of the World Trade Organization, the contracting parties to the Trademark Law Treaty or the public organizations of these that are used for indicating supervision or certification;

(ii) trademarks that falsely indicate a connection with, or that criticize, insult or are liable to defame, any nation, race, ethnic group, public organization, religion or well-known deceased person;

(iii) trademarks that are identical or similar to well-known marks that indicate a nonprofit business of a State, a public organization or its agencies or public corporations, or a nonprofit public service; however, this provision does not apply where a nonprofit business of a State, a public organization or its agencies or public corporations, or a nonprofit public service apply to register such marks as their business emblems;

(iv) trademarks that are contrary to public order or morality;

(v) trademarks comprising a mark that is identical or similar to a medal, certificate of merit or decoration awarded at an exhibition held by or with the authorization of the Government of the Republic of Korea or at an exhibition held by or with the authorization of the government of a foreign country, unless a person who has been awarded a medal, certificate of merit or decoration has used it as part of the trademark on the same goods for which the medal, certificate of merit or decoration was awarded at the exhibition;

(vi) trademarks containing the name, title or trade name, portrait, signature or seal, famous pseudonym, professional name or pen name of well-known persons, or an abbreviation of these, unless the consent of the person concerned has been obtained;

(vii) trademarks that are identical or similar to another person's registered trademark (excluding a registered collective mark for a geographical indication) when the registration was applied for before the filing date of the trademark applications concerned and when the trademarks are to be used on goods identical or similar to the designated goods;

(vii *bis*) trademarks that are identical or similar to another person's registered collective mark for a geographical indication when the registration was applied for before the filing date of the trademark applications concerned and when the trademarks are to be used on goods identical or similar to the designated goods;

(viii) trademarks that are identical or similar to another person's registered trademark (excluding a registered collective mark for a geographical indication) when not more than a year has elapsed since the date on which the trademark right expired (that is, the date on which a trial decision became final for a trial decision invalidating a trademark registration) and when the trademarks are to be used on goods that are identical or similar to the designated goods;

(viii*bis*) trademarks that are identical or similar to another person's registered collective mark for a geographical indication when not more than a year has elapsed since the date on which the registered collective mark for a geographical indication right expired (or the date on which a trial decision became final for a trial decision invalidating a collective mark for a geographical indication) and when the trademarks are to be used on goods identical to the designated goods;

(ix) trademarks that are identical or similar to another person's trademark when that other person's trademark (excluding a geographical indication) is well known among consumers to indicate or resemble the other person's goods, and when the trademarks are to be used on goods that are identical or similar to such goods;

(ix*bis*) trademarks that are identical or similar to another person's geographical indication when that other person's geographical indication is well known among consumers to indicate or resemble a certain region's goods and when the trademarks are to be used on goods that are identical or similar to such goods;

(x) trademarks that are liable to cause confusion with the goods or services of another person because consumers easily recognize the trademark as designating the goods or services of the other person;

(xi) trademarks that are liable to mislead or deceive consumers on the quality of the goods;

(xii) trademarks that are identical or similar to a trademark (excluding a geographical indication) that consumers inside or outside the Republic of Korea easily recognize as indicating the goods of a particular person, and which are used to obtain unjust profits or to inflict harm on a particular person and so on;

(xii*bis*) trademarks that are identical or similar to a geographical indication that consumers inside or outside the Republic of Korea easily recognize as indicating the goods of a certain region, and which are used to obtain unjust profits or to inflict harm on a legitimate users of the geographical indication and so on;

(xiii) trademarks that consist solely of three-dimensional shapes that are essential for securing the functions of goods, or their packagings, that require trademark registration; or

(xiv) trademarks that consist of a geographical indication or include a geographical indication of the origin of wines or spirits in a member state of the World Trade Organization, and which are used for wines, spirits or other similar goods. However, this provision does not apply if a legitimate user of a geographical indication applies to register a collective mark for a geographical indication under Article 9(3) of this Act and the relevant goods are the designated goods.

(2) Where a trademark falls under paragraphs (1)(vi), (ix), (ix*bis*) and (x) of this Article, the respective provisions do not apply if the trademark does not fall under the respective subparagraphs when the applicant applies for trademark registration.

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(3) Where a trademark falls under paragraph (1)(vii), (vii*bis*), (viii) and (viii*bis*) of this Article, the respective provisions apply if the trademark falls under the respective subparagraphs when the applicant applies for trademark registration (or if the registered trademark of another person is invalidated under Article 71(3) of this Act), unless the owner of the trademark and the applicant for registration of the trademark (referred to as “the applicant”) are the same person after filing the application.

(4) Paragraphs (1)(viii) and (viii*bis*) of this Article do not apply to the following cases:

- (i) where the registered trademark has not been used for more than one year retroactively from the date on which the trademark right was extinguished;
- (ii) where a rightful applicant applies to register the trademark, after a decision on invalidation or revocation becomes final because the registered trademark violates paragraphs (1)(vi), (ix), (ix*bis*), (x), (xii) and (xii*bis*) of this Article or Articles 8 or 73(1)(vii) of this Act; or
- (iii) where an applicant applies to register the trademark after the period of six months as prescribed in Article 43(2) of this Act has elapsed without applying to renew the term of the registered trademark.

(5) Where a trial for the cancellation of a trademark registration is requested under Article 73(1)(ii), (iii), and (v) to (xii) of this Act, and where any of the following subparagraphs occurs after the date of requesting the cancellation trial, the owner of the trademark right and any person using the trademark may not obtain trademark registration for a trademark that is identical or similar to a registered trademark extinguished with respect to goods (the collective mark for geographical indication is limited to an identical goods) that are identical or similar to the designated goods of the extinguished registered trademark, unless three years have elapsed since the day on which each of the following subparagraphs occurs:

- (i) where the trademark right has been extinguished because the term has expired;
- (ii) where a person with the trademark right abandons the trademark right or some of the designated goods; or
- (iii) where the trial decision on the cancellation of a trademark registration has become final.

(6) Paragraph (1)(vii*bis*) (viii*bis*) and (ix*bis*) may not be applicable between the collective marks for homonymous geographical indication.

Article 8 First-to-File Rule

(1) Where two or more applications for trademark registration related to identical or similar trademarks that are to be used on identical or similar goods are filed on different dates, only the applicant filing the application with the earlier filing date may obtain trademark registration for the trademark.

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(2) Where two or more applications for trademark registration related to identical or similar trademarks that are to be used on identical or similar goods are filed on the same date, a consultation will be held among all the applicants and the person agreed upon by all the applicants may obtain trademark registration for the trademark. If no agreement is reached or no consultation is possible, the trademark registration may be obtained only by the applicant chosen by a lottery conducted by the Commissioner of the Korean Intellectual Property Office.

(3) Where an application for trademark registration has been abandoned, withdrawn or invalidated, or where an examiner's decision or trial decision to refuse trademark registration has become final, the application, for the purposes of paragraphs (1) and (2) of this Article, is deemed never to have been filed.

(4) In cases under paragraph (2) of this Article, the Commissioner of the Korean Intellectual Property Office shall instruct the applicants to give notice of any agreement they reach and to report the terms of their agreement. If they do not submit a report within the designated period, the applicants are deemed not to have reached an agreement within the meaning of paragraph (2) of this Article.

(5) Where a trial for the cancellation of a registered trademark is requested under Article 73(1)(iii) of this Act and where each of the following subparagraphs occurs after the day on which the cancellation trial is requested, only the person requesting the cancellation trial may obtain trademark registration for the trademark that is identical or similar to the registered trademark that has been extinguished because of goods that are identical or similar to the designated goods of the registered trademark that has been extinguished for a period of three months after the day on which each of the following subparagraphs occurs:

- (i) when the period under Article 43(2) of this Act expires;
- (ii) when a person with the trademark right abandons the trademark right or some of the designated goods; or
- (iii) when the trial decision on the cancellation of a trademark registration has become final.

(6) Paragraphs (1) and (2) of this Article do not apply in either of the following cases:

- (i) where the mark in two or more applications to register a collective mark for a geographical indication is identical or similar to a mark on nonidentical goods; or where the mark in an application to register a collective mark for a geographical indication and a similar or identical mark in an application to register a trademark are both identical or similar to a mark on nonidentical goods; or
- (ii) where the mark in two or more applications to register a collective mark for a geographical indication is a homonymous collective mark for a geographical indication.

(7) Paragraph (5) of this Article does not apply in either of the following cases:

- (i) where the goods referred to in an application to register a trademark are not identical to the designated goods and the mark in the application is similar or identical to the expired collective mark for a geographical indication; or

(ii) where the mark in an application to register a collective mark for a geographical indication is applicable to a collective mark for a geographical indication with an lapsed registration and a homonymous collective mark for a geographical indication.

Article 9 Application for Trademark Registration

(1) A person seeking to register a trademark shall file an application with the Commissioner of the Korean Intellectual Property Office, stating the following:

- (i) the name and address of the applicant (and, if a legal entity, the name and address of the business);
- (ii) the name and residential or business address of the agent, if any (and, if the agent is a patent legal entity, the name and address of the business and the name of the designated patent attorney);
- (iii) the trademark;
- (iv) the list of designated goods and the class of goods;
- (v) the matters prescribed under Article 20(3) (only when claiming a priority right);
- (vi) deleted;
- (vii) the matters prescribed by ordinance of the Ministry of Commerce, Industry and Energy.

(2) A person seeking to register a mark made up of a three-dimensional shape comprising any combination of signs, characters, figures or colors (referred to as "a three-dimensional trademark") shall indicate on the application that the mark is a three-dimensional trademark.

(3) A person seeking to register a collective mark shall file an application to register a collective mark stating the matters mentioned in the subparagraphs of paragraph (1) of this Article accompanied by the articles of association that govern the use of the collective mark, as prescribed by Presidential Decree. If the person is seeking to register the collective mark for a geographical indication under Article 2(1)(iii~~quater~~) of this Act, the person shall describe the purpose of the collective mark in the application and submit the application along with documentary evidence that the mark complies with the definition of a geographical indication under Article 2(1)(iii~~bis~~) of this Act.

(4) A person seeking to register a business emblem shall file an application to register a business emblem stating the matters mentioned in the subparagraphs of paragraph (1) of this Article accompanied by documents proving the existence of a business management.

Article 9bis According the Filing Date etc.

(1) The Commissioner of the Korean Intellectual Property Office shall decide to accord as the date of a trademark application the date of receiving a trademark application unless the application falls under any of the following paragraphs:

- (i) where the indication that trademark registration is sought is not clear;

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- (ii) where the name or the title of the applicant is not indicated, or the indication is not considered sufficient to the extent to enable the identification of the applicant;
 - (iii) where a trademark for which the registration is sought is not indicated; or the indication is not clearly discernable;
 - (iv) where the designated goods are not indicated; or
 - (v) where the application is not filed in the Korean language.
- (2) Where an application for trademark registration falls under any subparagraph of paragraph (1), the Commissioner of the Korean Intellectual Property Office shall instruct the applicant to make the required correction within a designated period.
- (3) Where an applicant supplements an application for trademark registration in accordance with the order to supplement under paragraph (2), the applicant shall submit documents for the procedure to supplement the application (referred to as "a request to supplement the procedure").
- (4) Where an applicant who has received an order to supplement under paragraph (2) does so within the designated period, the Commissioner of the Korean Intellectual Property Office shall accord as the date of the trademark application the date of receiving the request to supplement the procedure by the Korean Intellectual Property Office.
- (5) Where an applicant who has received an order to supplement under paragraph (2) does not do so within the designated period, the Commissioner of the Korean Intellectual Property Office may return the application for trademark registration on the grounds that the application is defective.

Article 10 A Single Application for a Single Trademark

- (1) A person seeking to register a trademark shall designate one or more classes of goods for the classification of goods prescribed by ordinance of the Ministry of Commerce, Industry and Energy, and file an application for each trademark. In such cases, the person may designate goods and services in a single application.
- (2) The classes of goods referred to in paragraph (1) of this Article may not be construed to limit the extent of similarity of the goods.

Article 11 Deleted

Article 12 Transfer and Partial Assignment of an Application for Trademark Registration etc.

- (1) The transfer of an application for trademark registration, except for inheritance or other general succession, is not effective against third parties without notification that a change of applicant has been recorded.

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(2) An application for trademark registration may be transferred separately for each of the goods designated in the application. In this case, designated goods that are similar must be transferred together.

(3) Deleted.

(4) For inheritance or other general succession, the successor in title shall immediately notify the Commissioner of the Korean Intellectual Property Office of the succession.

(5) Where an application for trademark registration is jointly owned, the owners may not transfer their individual share without the consent of the other owners.

(6) An application for trademark registration that is partially assigned under paragraph (2) of this Article is deemed to have been filed at the time of filing the original application, unless Articles 20(3) and (4) or 21(2) apply.

(7) An application to register a business emblem may not be transferred unless the business emblem is transferred with the business.

(8) An application for trademark registration under Article 7(1)(iii) may be transferred only with a business related to the mark referred to in the main sentence of that Article.

(9) An application to register a collective mark may not be transferred. However, for the merger of legal entities, the application may be transferred with the authorization of the Commissioner of the Korean Intellectual Property Office.

Article 13 Amendment of Procedure

The Commissioner of the Korean Intellectual Property Office or the President of the Intellectual Property Tribunal may order the amendment of an application, a request or any other procedure within a period designated by the Commissioner or President in any of the following cases:

- (i) where the requirements of Article 3(1) of this Act or Article 6 of the Patent Act, as applied under Article 5 of this Act, have not been complied with;
- (ii) where the formalities requirements prescribed in this Act or by ordinance under this Act have not been complied with; or
- (iii) where the fees required under Article 37 have not been paid.

Article 14 Amendment before Decision of Publication of Application

(1) Excluding the cases specified in Article 15, an applicant may amend a trademark or the list of designated goods in the application for trademark registration if the amendment does not cause a material change to the application.

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(2) An amendment under paragraph (1) of this Article may not be made after the transmittal of a certified copy of the examiner's decision to grant or refuse trademark registration (referred to as "a decision to grant or refuse trademark registration"). However, where a trial against a decision of refusal is requested under Article 70*bis*, an amendment may be made within thirty days of the request, or within the period in which the written opinion is to be submitted under Articles 23(2), 45(2), 46*quater*(2) or 48(2), which apply under Article 81.

Article 15 Amendment after Decision of Publication of Application

Within the period set forth under any of the following conditions, an applicant may amend or correct designated goods or a specimen, or both, in response to reasons for refusal, reasons for opposition, reasons for a decision to refuse trademark registration, or a decision to refuse supplementary registration of the designated goods as long as the subject matter is not materially changed when a rejection notice is served under Article 23(2) or Article 48(2) after the certified copy of the decision on publication of the application under Article 24 is delivered, when an opposition to the trademark registration is brought under Article 25, or when an appeal against a decision of refusal under Article 70(2) is requested against a decision to refuse trademark registration under Article 23(1) or a decision to refuse a supplementary registration of designated goods under Article 48(1):

- (i) the period designated for submitting arguments under Article 23(2) or 48(2);
- (ii) the period designated for submitting a written answer under Article 27(1); or
- (iii) thirty days after the date of the request for a trial against the decision of refusal under Article 70*bis*.

Article 16 Material Change of Application

(1) An amendment made under Articles 14 or 15 is considered not to cause a material change to an application for trademark registration if the amendment includes any of the following:

- (i) a limitation of the list of designated goods;
- (ii) a correction of errors;
- (iii) a clarification of ambiguous descriptions; or
- (iv) the deletion of any auxiliary part of the trademark.

(2) Where an amendment of an application for trademark registration or designated goods has been made before the transmittal of a certified copy of decision to publish on application and is recognized to have caused a material change after the establishment of a trademark right, the trademark application is deemed to have been filed at the time the written amendment is submitted.

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(3) Where an amendment of an application for trademark registration or designated goods has been made after the transmittal of a certified copy of the decision to publish an application and is considered to have violated Article 15 after the establishment of a trademark right, the trademark application is deemed to have been established and registered on the trademark application that has not been amended.

Article 17 Rejection of Amendment

(1) Where an amendment made under Article 14 causes a material change to an application, an examiner shall decide to reject the amendment to the application for trademark registration.

(2) An examiner may not grant or refuse the registration of a trademark application if an amendment has been rejected under paragraph (1) of this Article until thirty days after the date on which a certified copy of the decision to reject the amendment has been transmitted. Where a decision to reject an amendment has been made under paragraph (1) of this Article before a decision has been made to publish the application, the examiner may not make a decision to publish the application that is subject to the amendment.

(3) Where an applicant requests a trial under Article 70*ter* against a decision to reject an amendment under paragraph (1) of this Article, the examiner shall suspend the examination of the application for trademark registration until the trial decision has become final.

(4) Where an amendment under Article 15 regarding an application for trademark registration materially changes the application, the examiner shall decide to reject the amendment.

(5) The decision to reject an amendment under paragraph (1) or (4) of this Article must be in writing and must state the reasons for the decision.

(6) Except when a trial against a decision of refusal is requested under Article 70*bis*, a decision to reject an amendment under paragraph (4) may not be appealed.

Article 17*bis* Submission of Amended Articles of Association

Where the articles of association need to be amended, an applicant for a collective mark can submit the amended articles of association to the Commissioner of the Korean Intellectual Property Office within the period determined under Articles 14(2) or 15 of this Act.

Article 18 Division of Application for Trademark Registration

TRADEMARK ACT

(1) Where an applicant files an application for trademark registration indicating two or more goods as designated goods, the application may be divided into two or more applications within the period for amendments under Articles 14 and 15..

(2) An application that has been divided under paragraph (1) of this Article (referred to as "a divided application") is deemed to have been filed when the original application was filed, except when Articles 20(3), (4) or 21(2) apply.

Article 19 Conversion of an Application

(1) An applicant may convert an application for trademark registration into an application for service mark registration and vice versa.

(2) Where an application for trademark registration is converted under paragraph (1) of this Article (referred to as "a converted application"), the converted application is considered an application for trademark registration or service mark registration and is deemed to have been filed when the original application was filed.

(3) A converted application under paragraph (2) of this Article may not be made after a decision to grant or refuse trademark registration for an original trademark application or a trial decision on an original application for trademark registration, or after a decision to grant or refuse service mark registration for an original service mark application or a trial decision on the original application for service mark registration has become final.

(4) If a converted application referred to in paragraph (2) of this Article is filed, the original application for trademark registration or service trademark registration is considered to have been withdrawn.

(5) Applications for the registration of trademarks, collective marks and business marks or applications for the registration of service marks, collective marks and business marks may not be converted.

Article 20 Priority Claim under Treaty

TRADEMARK ACT

(1) If a national of a country who is required to recognize a right of priority for an application for trademark registration filed by a national of the Republic of Korea under a treaty or similar instrument (referred to as "a treaty") claims a right of priority for the application for trademark registration in the Republic of Korea based on the earlier application for the trademark registration filed in the national's country or in a country recognized in the treaty, the filing date of the earlier application in the foreign country is deemed under Article 8 of this Act to be the filing date in the Republic of Korea. Where a national of the Republic of Korea files an application for trademark registration in a country that recognizes, under a treaty, the right of priority for applications for trademark registration filed by nationals of the Republic of Korea, and claims the right of priority for an application for trademark registration in the Republic of Korea based on the earlier application for the trademark registration filed in that country, this provision does also apply.

(2) A person claiming the right of priority under paragraph (1) of this Article shall file the application within six months of the filing date of the earlier application that is the basis of the right of priority.

(3) When filing an application for trademark registration, a person claiming the right of priority under paragraph (1) of this Article shall specify on the application the gist of the claim, the name of the country and the filing date of the earlier application.

(4) A person claiming the right of priority under paragraph (3) of this Article shall submit to the Commissioner of the Korean Intellectual Property Office, within three months of the filing date of the application for trademark registration, a written statement certified by the government of the country where the earlier application was filed setting forth the filing date of the earlier application, the trademark and the list of designated goods.

(5) Where a person claiming the right of priority under paragraph (3) of this Article fails to submit the certified copy within the period prescribed under paragraph (4) of this Article, the claim to the right of priority is invalidated.

Article 21 Special Provisions on the Time of Filing an Application

(1) Where a person entitled to file an application for trademark registration files an application for trademark registration whose designated goods bearing the trademark have been exhibited at any of the following types of exhibitions within six months of the date of the exhibition, the application is deemed to have been filed at the time the goods were exhibited:

- (i) exhibitions held by the Government or a local government entity;
- (ii) exhibitions held by persons authorized by the Government or a local government entity;
- (iii) exhibitions held in a foreign country with the authorization of the government;
- (iv) international exhibitions held in the territory of a country party to a treaty by the government of that country or by persons authorized by the government of that country.

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(2) A person taking advantage of paragraph (1) of this Article in an application for trademark registration shall submit to the Commissioner of the Korean Intellectual Property Office a written statement of intent with the application for trademark registration and, within thirty days of the filing date of the application, a document proving the relevant facts.

CHAPTER III

EXAMINATION

Article 22 Examination by Examiner

(1) The Commissioner of the Korean Intellectual Property Office shall have applications for the trademarks registration and oppositions to trademarks registration examined by examiners.

(2) The qualifications for examiners are prescribed by Presidential Decree.

(3) Any person whose application for trademark registration falls within any subparagraph of Article 23(1) may submit to the Commissioner of the Korean Intellectual Property Office relevant information with supporting evidence.

Article 22bis Request etc. for Inspection of a Trademark by a Specialized Searching Agency

(1) Where a specialized searching agency is considered necessary for the examination of an application for trademark registration, the Commissioner of the Korean Intellectual Property Office may request such an agency to inspect trademarks.

(2) When considered necessary for the examination of an application for trademark registration, the Commissioner of the Korean Intellectual Property Office may request assistance or advice from a competent administrative agency, a person with vast knowledge and experience in trademarks, or interested persons.

(3) Where the items of an application for a collective mark for a geographical indication are subject to the Agricultural Products Quality Control Act or the Fisheries Products Quality Control Act, the Commissioner of the Korean Intellectual Property Office shall obtain an opinion on as to the mark can be considered a geographical indication from the relevant minister of either the Ministry of Agriculture and Forestry or the Ministry of Maritime Affairs and Fisheries.

(4) Criteria for the specialized searching agency and requests for the search of trademarks under paragraph (1) of this Article are prescribed by Presidential Decree.

Article 23 Decision to Refuse Trademark Registration and Notification of Reasons for Refusal

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(1) An examiner shall refuse trademark registration for an application for trademark registration under any of the following circumstances:

- (i) where the trademark is unregistrable under Articles 3, 6 to 8, 10(1), 12(2) (second sentence), (5) and (7) to (9) of this Act or Article 25 of the Patent Act as applied under Article 5 of this Act;
- (ii) where the trademark violates a treaty;
- (iii) where the trademark is identical or similar to a trademark registered in the territory of a country that is a party to a treaty and has been filed by a person who is or was an agent or a representative of the owner of the trademark, within the one-year period before the filing date, without the owner's authorization, for designated goods that are identical or similar to the designated goods covered by the owner's trademark, if an opposition has been filed or information has been submitted under Article 22(3) of this Act by the owner; or
- (iv) where the trademark does not conform to the definition of a mark under Article 2(1)(i) to (iii) or (iv) of this Act; or where, in the case of a collective mark for a geographical indication, the geographical indication and the mark do not conform to the definitions of a geographical indication or mark under paragraphs (iii*bis*) and (iii*quater*) of the Article 2(1) of this Act; or
- (v) where the applicant's articles of association prohibit a person who conducts business activities such as producing, processing or selling goods that display a geographical indication from joining or subscribing to the association, or where the articles of association prescribe conditions for subscription that are too difficult for the person to fulfill and so on; or
- (vi) where the applicant's articles of association, referred to in Article 9(3) of this Act, fail to mention all of the matters that govern the use of the collective mark as prescribed by Presidential Decree.

(2) When refusing trademark registration under paragraph (1) of this Article, an examiner shall notify the applicant of the reasons for refusal and give the applicant an opportunity to submit a written statement of arguments within a designated period.

Article 24 Publication of an Application

(1) An examiner who finds no grounds for rejecting an application for trademark registration shall decide to publish the application.

(2) Where a decision under paragraph (1) of this Article is made, the Commissioner of the Korean Intellectual Property Office shall transmit the decision to the applicant and publish the application in the Trademark Gazette.

(3) The Commissioner of the Korean Intellectual Property Office shall make the documents of the application for trademark registration and other related documents available for public inspection at the Korean Intellectual Property Office for a period of thirty days following the publication date of the application.

Article 24*bis* Right to Demand Compensation for Loss

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(1) After an application is published under Article 24(2) (including *mutatis mutandis* application under Article 49(3) and Article 81(1)), an applicant may warn, in writing, a person who has used a trademark that is identical or similar to the trademark of the published application on goods that are identical or similar to the designated goods of the published application. However, an applicant who shows a copy of the application for trademark registration may send a written warning even before publication of the application.

(2) An applicant who has sent a warning under paragraph (1) may demand compensation equivalent to the loss of business caused by the use of the trademark from the date of the warning to the date of registration of the trademark right.

(3) The right to demand under paragraph (2) may be exercised only after the registration of a trademark right.

(4) Exercising the right to demand under paragraph (2) does not preclude exercising the trademark right.

(5) Articles 52, 66, 69 and 70 of this Act, and Articles 760 and 766 of the Civil Act apply *mutatis mutandis* to the exercise of the right to demand under paragraph (2). In such cases, "the date on which the damaged party or a legal representative became aware of such damage and the identity of the person causing it" in Article 766(1) of the Civil Act reads "the date of registration of the trademark right".

(6) Where an application for trademark registration falls under any of the following subparagraphs, the right to demand under paragraph (2) is deemed never to have existed:

- (i) where an application for trademark registration has been abandoned, withdrawn or invalidated;
- (ii) where a decision to refuse trademark registration for an application for trademark registration has become final; or
- (iii) where a trial decision to invalidate a trademark registration under Article 71 (except Article 71(1)(iv) and (v)) has become final.

Article 25 Opposition to a Trademark Registration

(1) When an application is published, any person may lodge an opposition to a trademark registration that falls under each subparagraph of Article 23(1) with the Commissioner of the Korean Intellectual Property Office within thirty days of the publication date of the application.

(2) A person making an opposition to a registered trademark shall submit to the Commissioner of the Korean Intellectual Property Office a written opposition specifying the following matters, and supporting evidence:

- (i) the name and address of the opponent to a trademark registration (and, if a legal entity, the name and address of the business);

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(*ibis*) the name and residential or business address of the agent, if any (and, if the agent is a patent legal entity, the name and address of the business and the name of the designated patent attorney);

(ii) the serial number of the application for the trademark registration;

(iii) the relevant category of goods and designated goods;

(iv) the grounds for opposing a trademark registration; and

(v) the reasons for opposing a trademark registration and indication of supporting evidence.

Article 26 Amendment of Reasons for an Opposition to a Trademark Registration

A person who has filed a notice of opposition to a trademark registration under Article 25(1) (referred to as "an opponent") may amend the reasons and evidence submitted in the notice of opposition to a trademark registration within thirty days of the expiry of the period for filing a notice of opposition.

Article 27 Decision on an Opposition to Trademark Registration

(1) Where a notice of opposition has been filed, the examiner shall transmit to the applicant a copy of the notice of opposition to the trademark registration and give the applicant an opportunity to submit an answer in writing within a designated period.

(2) After the expiry of the periods prescribed in paragraph (1) of this Article and Article 26, the examiner shall decide on the opposition to the trademark registration.

(3) Notwithstanding paragraph (1) of this Article, where an opponent fails to submit reasons and evidence, the examiner may reject the opposition to a trademark registration by decision after the period under Article 26 expires.

(4) The decision on an opposition to a trademark registration must be in writing and must state the reasons for the decision.

(5) Where a decision has been made under paragraph (2) of this Article, the Commissioner of the Korean Intellectual Property Office shall transmit a certified copy of the decision to the applicant and the opponent.

(6) An appeal may not be made against a decision on an opposition to a trademark registration.

(7) In applying paragraph (4) of this Article, where different reasons exist for the decision on the opposition to a trademark registration for two or more designated goods, the examiner shall give specific reasons for the decision for each of the respective goods.

Article 28 Decision of Refusal to Register a Trademark Made *Ex Officio* after Publication

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(1) An examiner who finds reasons for refusal after the publication of an application may make a decision of refusal *ex officio* under Article 23.

(2) An examiner who refuses an application under paragraph (1) of this Article may not decide on an opposition to a registered trademark even if the opposition has been filed under Article 25.

(3) Where a decision of refusal has been made under paragraph (1) of this Article, the Commissioner of the Korean Intellectual Property Office shall transmit a certified copy of the decision of refusal to the opponent.

Article 29 Concurrent Oppositions to Trademark Registration

(1) Where two or more oppositions have been filed, an examiner may examine and rule upon them jointly or separately.

(2) Where two or more oppositions have been filed and one of them is considered to be justified upon examination, the examiner is not required to make a ruling on the other opposition(s).

(3) The Commissioner of the Korean Intellectual Property Office shall transmit a certified copy of the decision of refusal to opponents whose oppositions were not examined under paragraph (2) of this Article.

Article 30 Decision to Grant Registration of a Trademark

An examiner who cannot find any reasons for refusing an application for trademark registration shall decide in favor of trademark registration.

Article 31 Method of Decision to Grant or Refuse Trademark Registration

(1) A decision to grant or refuse trademark registration must be in writing and must state the reasons for the decision.

(2) When an examiner decides to grant or refuse trademark registration, the Commissioner of the Korean Intellectual Property Office shall transmit a certified copy of the decision to the applicant.

Article 32 Suspension of Examination or Litigation Proceedings

(1) The examination procedure of an application for trademark registration may, if necessary, be suspended until a trial decision becomes final or litigation proceedings are concluded.

(2) The court may, if necessary in the litigation, suspend proceedings until the examiner's decision on the registration of a trademark becomes final.

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Article 33 *Mutatis Mutandis* Application of the Patent Act

Articles 142, 148(1) to (5) and (7), and 157 of the Patent Act and Articles 143, 299 and 367 of the Civil Procedure Act apply *mutatis mutandis* to the examination of applications for the registration of trademarks.

CHAPTER IV

TRADEMARK REGISTRATION FEES AND REGISTRATION OF TRADEMARKS

Article 34 Trademark Registration Fees

- (1) A person applying for a trademark registration, supplementary registration of designated goods or renewal of the term of a registered trademark shall pay the trademark registration fees.
- (2) Regardless of whether the person liable to pay the trademark registration fees is willing, any interested person may pay the trademark registration fees under paragraph (1) of this Article.
- (3) Matters related to the paying trademark registration fees under paragraph (1) of this Article, including the method and period of payment, are prescribed by ordinance of the Ministry of Commerce, Industry and Energy.

Article 34bis Abandoning Some or All Designated Goods When Paying Trademark Registration Fees

- (1) Where a person receives a decision granting registration of a trademark application with more than two designated goods, or receives a decision granting supplementary registration of designated goods in an application for supplementary registration of the designated goods, or receives a decision granting renewal of the term of a registered trademark, the person may abandon the designated goods in part after paying the trademark registration fees.
- (2) Matters necessary for the abandonment of designated goods under paragraph (1) of this Article are prescribed by ordinance of the Ministry of Commerce, Industry and Energy.

Article 35 Extension of Payment Period for Trademark Registration Fees

Upon request, the Commissioner of the Korean Intellectual Property Office may extend the period for paying trademark registration fees under Article 34(3) by not more than thirty days.

Article 36 Abandoning an Application for Trademark Registration as a Consequence of Nonpayment of Trademark Registration Fees

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Where trademark registration fees are not paid within the periods prescribed in Articles 34(3) or 35, an application for trademark registration, supplementary registration of designated goods or renewal of the term of a registered trademark is deemed to have been abandoned.

Article 36bis Supplementary Trademark Registration Fees

(1) When a person applying for registration of the establishment of a trademark right, additional registration of designated goods or renewal of the term of a registered trademark fails to pay all of the trademark registration fees within the period prescribed under Articles 34(3) or 35, the Commissioner of the Korean Intellectual Property Office shall order the person to pay supplementary trademark registration fees.

(2) A person who receives an order to pay supplementary trademark registration fees under paragraph (1) shall pay the supplementary fees within one month of receiving the order.

(3) If the period for paying supplementary trademark registration fees under Articles 34(3) or 35 has elapsed, the person required to pay supplementary trademark registration fees under paragraph (2) shall pay twice the amount of the unpaid trademark registration fees.

Article 36ter Recovery of an Application for Trademark Registration by Paying Trademark Registration Fees etc.

(1) Where an applicant who has submitted an application for trademark registration, an application for supplementary registration of designated goods, or an application to renew a registered trademark deemed to have been abandoned under Article 36, or where an applicant was unable to pay the registration fees under Article 34(3) within the payment period prescribed under Articles 34(3) or 35 due to unavoidable reasons, the applicant may pay the registration fees within 14 days of the date on which unavoidable reasons cease to exist. However, this provision does not apply where a period of six months elapses after the expiry date of the payment period prescribed under Articles 34(3) or 35.

(2) Notwithstanding Article 36, where registration fees are paid in accordance with paragraph (1), an application for trademark registration, an application for supplementary registration of designated goods or the renewal of the term of a registered trademark is deemed not to have been abandoned.

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(3) Where an application for trademark registration, an application for supplementary registration of designated goods or a registered trademark has been recovered under paragraph (2), the effect of the recovery of the application for the registration of the trademark, the application for supplementary registration of designated goods or the trademark right does not extend to using a trademark that is identical or similar to a registered trademark on goods identical or similar to the designated goods if the use occurred within a period extending from the expiry date of the payment period under Article 34(3) or 35 to the recovery date of the application for trademark registration, the application for supplementary registration of designated goods or the trademark right.

Article 37 Official Fees

(1) Except when requesting an invalidation trial by an examiner under Article 71(1) or 72(1), a person filing an application, making a demand or initiating other trademark-related procedures shall pay official fees.

(2) Matters related to paying official fees under paragraph (i) of this Article, including the method and period of payment, are prescribed by ordinance of the Ministry of Commerce, Industry and Energy.

(3) In addition to the fee referred to in paragraph (2) of this Article, a person who applies for renewal of the term of a registered trademark within the period prescribed in Article 43(2) shall pay the amount determined by ordinance of the Ministry of Commerce, Industry and Energy.

Article 38 Refund of Trademark Registration Fees

(1) Trademark registration fees and official fees that have been paid may not be refunded. However, where fees have been paid by mistake, the incorrectly paid portion of the fees must be refunded immediately upon request of the person who paid the fees.

(2) Where a person pays trademark registration fees and official fees incorrectly, the Commissioner of the Korean Intellectual Property Office shall notify the person.

(3) A person may request a refund of the trademark registration fees and official fees submitted under paragraph (2) not later than one year after the date on which notification of the fees was given.

Article 39 Trademark Register

(1) The Commissioner of the Korean Intellectual Property Office shall keep a Trademark Register at the Korean Intellectual Property Office and shall register the following matters:

(i) the establishment, transfer, modification, expiry, renewal of the term, reclassification of goods under Article 46*bis*, supplementary registration of designated goods or restriction on disposal, of a trademark right;

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(ii) the establishment, maintenance, transfer, modification, expiry, or restriction on disposal of an exclusive or nonexclusive license; and

(iii) the establishment, transfer, modification, expiry and restriction on disposal of a pledge on a trademark right for an exclusive or nonexclusive license.

(2) All or part of the Trademark Register may be stored in an electronic format such as a magnetic tape.

(3) Necessary matters related to registration and registration procedures of trademarks not stipulated in paragraphs (1) and (2) of this Article are prescribed by Presidential Decree.

Article 40 Issuance of a Trademark Registration Certificate

(1) When the establishment of a trademark right has been registered, the Commissioner of the Korean Intellectual Property Office shall issue a trademark registration certificate to the owner of the trademark.

(2) Where the trademark registration certificate does not correspond with the Trademark Register, the Commissioner of the Korean Intellectual Property Office shall correct the certificate and reissue the amended certificate or issue a new certificate upon the request of the applicant or *ex officio*.

CHAPTER V

TRADEMARK RIGHT

Article 41 Registration of Establishment of a Trademark Right

(1) A trademark right comes into effect upon the registration of its establishment.

(2) When trademark registration fees have been paid in accordance with Article 34(1), the Commissioner of the Korean Intellectual Property Office shall authorize the registration of the trademark right.

Article 42 The Term of a Trademark Right

(1) The term of a registered trademark is for ten years after the registration date of its establishment.

(2) The term of a registered trademark may be renewed for an additional ten years upon applying to renew the term.

Article 43 Application to Renew the Term of a Registered Trademark

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(1) A person renewing the term of a registered trademark under Article 42(2) shall submit an application to the Commissioner of the Korean Intellectual Property Office, including the following:

- (i) requirements under Article 9(1)(i), (ii), (iv) and (vii); and
- (ii) the registration number of the trademark concerned.

(2) An application to renew the term of a registered trademark must be filed within the one-year period before the date on which the term of the registered trademark expires. However, a person who does not apply to renew the term of a registered trademark within this period may do so not later than six months after date on which the registered trademark expires.

(3) Where a registered trademark is jointly owned, the owners shall jointly file an application to renew the term.

(4) In addition to paragraphs (1) to (3) of this Article, all other necessary matters required to file an application to renew the term of a registered trademark are prescribed by ordinance of the Ministry of Commerce, Industry and Energy.

Article 44 Division of an Application to Renew the Term of a Registered Trademark

(1) Where the designated goods of a registered trademark cover two or more goods, the application for renewal of the term of a registered trademark may be divided into each of the goods.

(2) In an application to renew the term of a registered trademark under Article 43(1), an applicant who designates two or more goods may divide the application into two or more applications within the amendment period prescribed in Article 14.

(3) A divisional application to renew the term of a registered trademark under paragraph (2) of this Article is deemed to have been filed when the original application to renew of the term was filed.

Article 45 Refusal of Registration for Renewal of the Term and Notification of Reasons for Refusal

(1) An examiner shall refuse to renew the term of a registered trademark under any of the following circumstances:

- (i) deleted;
- (ii) where the applicant is not the owner of the registered trademark concerned;
- (iii) where the application violates Article 43(2);
- (iv) deleted;
- (v) deleted;
- (vi) where the designated goods of the application to renew the term of a registered trademark are not the designated goods of the registered trademark, or where the application expands the actual scope of the designated goods.

(2) An examiner who intends to refuse renewal of the term of a registered trademark under paragraph (1) of this Article shall notify the applicant of the reasons for the refusal and give the applicant an opportunity to submit a written statement of arguments within a designated period.

Article 46 Effects of an Application to Renew the Term of a Registered Trademark etc.

(1) Where an application to renew the term of a registered trademark has been filed within the period prescribed in Article 43(2), the term is deemed to have been renewed, unless a decision of refusal to renew the term of the registered trademark has become final.

(2) The registration for renewal of the term of a registered trademark commences on the day after the expiry date of the original registration.

Article 46bis Application to Register the Reclassification of Goods

(1) A trademark right owner who has obtained trademark registration, a supplementary registration of designated goods or a registration for renewal of the term of a registered trademark for designated goods in accordance with the classification of goods prescribed by ordinance of the Ministry of Commerce, Industry and Energy under the previous Article 10(1) of this Act, before enforcement of the amendment of Article 10(1) under the enactment of Act No. 5355, shall reclassify the designated goods (referred to as "the reclassification of goods"), as prescribed by ordinance of the Ministry of Commerce, Industry and Energy. However, this provision does not apply where the person has obtained registration for renewal of the term of a registered trademark for designated goods in accordance with the classification of goods as prescribed by ordinance of the Ministry of Commerce, Industry and Energy under Article 10(1) of this Act as amended under the enactment of Act No. 5355.

(2) A person who seeks registration of the reclassification of goods under paragraph (1) (referred to as "the registration of the reclassification of goods") shall submit to the Commissioner of the Korean Intellectual Property Office a written application to register the reclassification of goods, specifying the particulars prescribed in each of the following subparagraphs; persons intending to simultaneously file an application to register the reclassification of goods and an application to renew the term of a registered trademark under Article 43(1) may instead file a single application to renew the term of a registered trademark by specifying their intention in the application as well as the particulars prescribed under subparagraph (4):

- (i) the name and address of the applicant for the reclassification of goods (and, if a legal entity, the name and address of the business);
- (ii) the name and residential or business address of the agent, if any (and, if the agent is a patent legal entity, the name and address of the business and the name of the designated patent attorney);
- (iii) the registration number of the registered trademark; and
- (iv) the the designated goods and the corresponding classification that the applicant seeks to reclassify.

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(3) An application to register the reclassification of goods must be filed within the period beginning one year before the date on which the term of the trademark right expires and not later than six months after the expiry date of the term.

(4) Where a registered trademark is jointly owned, the owners shall jointly file an application to register the reclassification of goods.

Article 46ter Division of an Application to Register the Reclassification of Goods

(1) Where an applicant files an application to renew the term of a registered trademark in which the designated goods are divided under Article 44(1), the applicant shall file an application to divide the registration of the reclassification of goods.

(2) Where an application to renew the term of a registered trademark is divided under Article 44(2), the applicant shall file an application to divide the registration of the reclassification of goods, or divide the application to register the reclassification of goods that has already been filed.

(3) Where an application to register the reclassification of goods that has already been filed under paragraph (2) is divided, the concerned application for registration of the reclassification of goods will be deemed to have been filed when the original application for registration of the reclassification of goods was filed.

Article 46quater Decision to Refuse Registration of the Reclassification of Goods and Notification of the Reasons for Refusal

(1) An examiner shall refuse registration of the reclassification of goods under any of the following circumstances:

- (i) where the designated goods for which an application to register the reclassification of goods has been filed are not the goods designated under the registered trademark or where the applicant expands the actual scope of the designated goods;
- (ii) where the designated goods of an application to register the reclassification goods does not correspond with the classifications of goods prescribed by ordinance of the Ministry of Commerce, Industry and Energy;
- (iii) where the applicant is not the owner of the trademark right concerned; and
- (iv) where the application violates Article 46bis(3)

(2) An examiner who intends to refuse registration of the reclassification of goods under paragraph (1) of this Article shall notify the applicant of the reasons for the refusal and give the applicant an opportunity to submit a written response within a designated period.

Article 46quinquies Registration of the Reclassification of Goods

(1) Where an examiner decides to register the reclassification of goods under Article 30 as applied under Article 49(2), the Commissioner of the Korean Intellectual Property Office shall register the reclassification of the designated goods.

Article 47 Application for Supplementary Registration of Designated Goods

(1) The owner of a registered trademark or an applicant for trademark registration may obtain supplementary registration of designated goods to be added to the designated goods of the registered trademark or to the application for trademark registration.

(2) A person applying for supplementary registration of designated goods under paragraph (1) of this Article shall submit an application for supplementary registration of designated goods to the Commissioner of the Korean Intellectual Property Office that includes the following:

- (i) the requirements under Article 9(1)(i) to (iii), (v) and (vii);
- (ii) the registration number of the trademark or the number of the application for trademark registration; and
- (iii) the supplementary goods to be designated and the corresponding class of the classification.

Article 48 Decision to Refuse Supplementary Registration of Designated Goods and Notification of Reasons for Refusal

(1) Where an application for supplementary registration of designated goods falls under any of the following subparagraphs, the examiner shall make a decision of refusal:

- (i) the application falls under any subparagraph of Article 23(1);
- (ii) the applicant is not the owner of the trademark right or the applicant for registration of the trademark concerned;
- (iii) the trademark for the application is not identical to the registered trademark or the trademark for which a registration application has been filed; or
- (iv) the right under the registered trademark has expired or the application for trademark registration has been withdrawn, abandoned or invalidated, or a decision to refuse the application has become final.

(2) An examiner who intends to refuse an application for supplementary registration of designated goods under paragraph (1) of this Article shall notify the applicant of the reasons for the refusal and give the applicant an opportunity to submit a written statement of arguments within a designated period.

Article 49 *Mutatis Mutandis* Application of the Patent Act

(1) Articles 10(1), 13, 14, 16, 17, 22 and 30 to 32 of this Act and Article 148(i) to (v) and (vii) of the Patent Act apply *mutatis mutandis* to an application to renew the term of a registered trademark.

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(2) Articles 10(1), 13, 14, 16, 17, 22 and 30 to 32 of this Act and Article 148(i) to (v) and (vii) of the Patent Act apply *mutatis mutandis* to an application to register the reclassification of goods.

(3) Articles 9*bis*, 10(1), 13 to 17*bis*, 20 to 22 and 24 to 32 of this Act, Articles 142, 148(i) to (v) and (vii) and 157 of the Patent Act and Articles 143, 299 and 367 of the Civil Procedure Act apply *mutatis mutandis* to applications for supplementary registration of designated goods.

Article 50 Effects of a Trademark Right

The owner of a trademark right is entitled to the exclusive right to use the registered trademark for the designated goods. However, under Article 55(3), where the trademark right is the subject of an exclusive license, this provision does not apply to the extent to which the licensee has the exclusive right to use the registered trademark.

Article 51 Limitations of a Trademark Right

(1) The effects of a trademark right (excluding a collective mark for a geographical indication) do not extend to the following:

- (i) trademarks that indicate in a common way a person's own name, title or trade name, portrait, signature, seal, famous pseudonym, professional name or pen name, or a famous abbreviation of these; however, this provision does not apply where, after registration of the trademark right, the mark has been used with the intention of violating the rules of fair competition;
- (ii) trademarks that indicate in a common way the common name, origin, place of sale, quality, raw materials, efficacy, use, quantity, shape or price of the designated goods concerned or similar goods, or the method or time of manufacturing, processing or using such goods; and
- (iii) trademarks customarily used on the designated goods or goods similar to the designated goods, and marks consisting of a famous geographical name or its abbreviations or a map.
- (iv) trademarks that consist solely of three-dimensional shapes that are essential to secure the functions of the designated goods of a registered trademark or their packaging.

(2) The effects of a collective mark right for a geographical indication do not extend to any of the following:

- (i) trademarks that fall under paragraphs (1)(i), (ii) (excluding origin) and (iv) of this Article;
- (ii) trademarks customarily used for goods that are identical to the designated goods of a registered collective mark for a geographical indication;
- (iii) geographical indications or homonymous geographical indications used on goods which are identical to the designated goods of a registered collective mark for a geographical indication, and which are used by a person who conducts business activities such as producing, manufacturing, processing or certifying such goods; or

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(iv) registered trademarks used by the owner, exclusive licensee or nonexclusive licensee on the designated goods of a trademark which has been registered with an earlier filing date than any other trademark application and which includes a geographical indication that is identical or similar to a registered collective mark for a geographical indication.

Article 52 Extent of Protection of a Registered Trademark etc.

(1) The extent of protection conferred by a registered trademark is based on the trademark reproduced in the documents accompanying the application for trademark registration.

(2) The extent of protection conferred to the designated goods is based on the goods listed in the documents accompanying the application for trademark registration or the application to register the reclassification of goods.

Article 53 Relationship with Another Design Right etc.

Where the use of a registered trademark on designated goods conflicts with another person's patent right, utility model right or design right that has been applied for before the date of the application for the registration of the trademark, or with another person's copyright that has been in effect before that date, the owner of the trademark right or the exclusive or nonexclusive licensee may not use the registered trademark on the portion of the designated goods that gives rise to the conflict without a license from the owner of the earlier patent right, utility model right, design right or copyright.

Article 54 Assignment and Joint Ownership of a Trademark etc.

(1) A trademark right may be assigned separately for each of the designated goods. In such cases, the rights for similar designated goods are assigned with the assignment of the trademark.

(2) to (4) Deleted.

(5) Where a trademark right is jointly owned, the owners may not assign or pledge their individual share without the consent of the other owners.

(6) Where a trademark is jointly owned, an owner may not grant an exclusive or nonexclusive license of the trademark right without the consent of the other owners.

(7) A business emblem right may not be assigned unless the business emblem is assigned with the business.

(8) A trademark right registered under Article 7(1)(iii) may not be assigned unless assigned with the business related to the mark referred to in the main sentence of Article 7(1)(iii).

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(9) A collective mark right may not be transferred. However, for a merger of a legal entity, the collective mark may be assigned if authorized by the Commissioner of the Korean Intellectual Property Office.

(10) A pledge right may not be established for a business emblem right, a trademark right and a collective mark right under Article 7(1)(iii).

Article 54bis Division of a Trademark Right

(1) Where two or more goods are designated under a single trademark right, the trademark right may be divided for each of the designated goods.

(2) Where a request for an invalidation trial is made under Article 71(2), the division under paragraph (1) of this Article may be made until the decision of the invalidation trial becomes final even if the trademark right expires.

Article 55 Exclusive License

(1) The owner of a trademark right may grant an exclusive license on the trademark right.

(2) An exclusive license may not be granted for a business emblem or a collective mark right.

(3) An exclusive licensee granted an exclusive license under paragraph (1) of this Article has the exclusive right to use the registered trademark on the designated goods to the extent allowed in the license agreement.

(4) Exclusive licensees shall indicate their own name or title on goods.

(5) An exclusive licensee may not assign the license without the consent of the owner of the trademark right, except in the case of inheritance or other general succession.

(6) An exclusive licensee may establish a pledge or grant a nonexclusive license on the exclusive license only with the consent of the owner of the trademark right.

(7) Article 54(5) and (6) apply *mutatis mutandis* to exclusive licenses.

Article 56 Effects of Registration on Trademark Right and Exclusive License

(1) The following items have no effect unless registered:

(i) the transfer (except for inheritance or other general succession), modification, extinguishment by abandonment, renewal of the term of a registered trademark, reclassification of goods, supplement to designated goods or restriction on the disposal of these;

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(ii) the grant, transfer (except for inheritance or other general succession), modification or extinguishment by abandonment of an exclusive license, or restriction on the disposal of these; or
(iii) the establishment, transfer (except for inheritance or other general succession), modification or extinguishment by abandonment of a pledge on a trademark right or exclusive license, or restriction on the disposal of these.

(2) For inheritance or other general succession related to a trademark right, exclusive license or pledge under paragraph (1) of this Article, the Commissioner of the Korean Intellectual Property Office must be notified immediately.

Article 57 Nonexclusive License

(1) The owner of a trademark right may grant to others a nonexclusive license on the trademark right.

(2) A nonexclusive licensee granted a nonexclusive license under paragraph (1) of this Article is entitled to use the registered trademark on the designated goods to the extent allowed in the license agreement.

(3) Except for inheritance or other general succession, a nonexclusive license may not be transferred without the consent of the owner of the trademark right (or, for a nonexclusive license on an exclusive license, the owner of the trademark right and the exclusive licensee).

(4) A pledge may not be established on a nonexclusive license without the consent of the owner of the trademark right (or, for a nonexclusive license on an exclusive license, the owner of the trademark right and the exclusive licensee).

(5) Articles 54(5) and 55(2) and (4) apply *mutatis mutandis* to a nonexclusive license.

Article 57bis Right to Use a Trademark after the Term of a Patent Right Expires etc.

(1) Where a patent right under a patent application filed on or before the filing date of a trademark application conflicts with the trademark right under the trademark application and the term of the patent right has expired, the patentee is entitled to use, within the scope of the original patent right, the registered trademark or another similar trademark for the designated goods covered by the trademark application or similar goods if the registered trademark is used without intending to violate the rules of fair competition.

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(2) Where a patent right under a patent application filed on or before the filing date of a trademark application conflicts with the trademark right under the trademark application and the term of the patent right has expired, any person who has an exclusive license for the patent right or a nonexclusive license for the patent right or its exclusive license effective under Article 118(1) of the Patent Act at the time of its expiry is entitled to use, within the scope of the original right, the registered trademark or another trademark similar to the registered trademark on the designated goods or goods similar to the designated goods. However, this provision applies only where the registered trademark is used without violating the rules of fair competition.

(3) A person granted the right to use a trademark under paragraph (2) shall pay reasonable remuneration to the owner of the trademark right or exclusive licensee.

(4) The owner of a trademark or an exclusive licensee may demand a person who has a right to use the trademark under paragraph (1) or (2) to make the necessary indications to prevent confusion between the goods of the trademark owner or exclusive licensee's business and the goods of the other person's business.

(5) Except for inheritance or other general succession, the right to use a trademark under paragraph (1) or (2) may not be transferred without the consent of the owner of the trademark or the exclusive licensee.

(6) Paragraphs (1) to (5) apply *mutatis mutandis* where a utility model right, a design right under a utility model application, or a design application filed on or before the filing date of a trademark application conflict with the trademark right under the trademark application and the term of the utility model right or the design right has expired.

Article 58 Effects of Registration of a Nonexclusive License etc.

(1) The following have no effect on any third parties unless they are registered:

- (i) the grant, transfer (except for inheritance or other general succession), modification, extinguishment by abandonment of a nonexclusive license or restriction on the disposal of these;
- (ii) the establishment, transfer (except for inheritance or other general succession), modification, extinguishment by abandonment of a pledge on a nonexclusive license or restriction on the disposal of these.

(2) A registered nonexclusive license is effective against any person who subsequently acquires the trademark right or exclusive license.

(3) For inheritance or other general succession related to a nonexclusive license or a pledge under paragraph (1) of this Article, the Commissioner of the Korean Intellectual Property Office must be notified immediately.

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Article 59 Abandonment of a Trademark Right

The owner of a trademark right may abandon the trademark right for any of the designated goods.

Article 60 Restriction on Abandonment of a Trademark Right etc.

(1) The owner of a trademark right may not abandon the trademark right without the consent of the exclusive or nonexclusive licensee(s) or pledgee(s).

(2) An exclusive licensee may not abandon the exclusive license without the consent of the pledgee(s) or nonexclusive licensee(s) under Article 55(6).

(3) A nonexclusive licensee may not abandon the nonexclusive license without the consent of the pledgee(s) under Article 57(4).

Article 61 Effect of Abandonment

Where a trademark right, an exclusive license, a nonexclusive license or a pledge is abandoned, the trademark right, the exclusive license, the nonexclusive license or the pledge is extinguished.

Article 62 Pledge

Where a pledge is established for a trademark right or an exclusive or nonexclusive license, the pledgee may not use the registered trademark.

Article 63 Subrogation for Right of Pledge

A pledge may be exercised for remuneration under this Act or for goods to be received for using the trademark right; however, an attachment order must be obtained before paying the remuneration or delivering the goods.

Article 64 Extinguishment of a Trademark Right

Where an application to transfer a registered trademark is not filed by a successor in title within three years of the death of the original owner of the trademark, the trademark right is extinguished on the day after the expiry of a three-year period following the death of the original trademark owner.

Article 64bis Extinguishment of a Trademark Right in the Absence of Registration of the Reclassification of Goods

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(1) Under any of the following circumstances, a trademark right covering the designated goods of an application to register the reclassification of goods is extinguished on the expiry date of the term of the registered trademark that is contained within the period prescribed under Article 46*bis*(3) for registering the reclassification of goods.

- (i) where a person who is entitled to register the reclassification of goods does not file an application to this effect within period prescribed under Article 46*bis*(3);
- (ii) where the application to register the reclassification of goods has been withdrawn;
- (iii) where a procedure related to the reclassification of goods has been invalidated under Article 16(1) of the Patent Act as applied under Article 5 of this Act;
- (iv) where a decision to refuse registration of the reclassification of goods is final; or
- (v) where a trial ruling invalidating registration of the reclassification of goods under Article 72*bis*(2) is final.

(2) A trademark right covering designated goods that are the object of reclassification of goods but not indicated in a registration application under Article 46*bis*(2) is extinguished on the date on which the designated goods indicated in the application are reclassified and registered under Article 46*quinquies*.

CHAPTER VI PROTECTION OF OWNER OF A TRADEMARK RIGHT

Article 65 Injunction etc. against an Infringement

(1) The owner of a trademark right or an exclusive licensee may request a person who is infringing or is likely to infringe on the trademark right or exclusive license to discontinue or refrain from the infringement.

(2) The owner of a trademark right or exclusive licensee who is acting under paragraph (1) of this Article may demand the destruction of the infringing articles, the removal of the facilities used for the act of infringement, or other measures necessary to prevent the infringement.

Article 66 Acts Considered to be an Infringement

(1) The following acts are considered to infringe an exclusive license or a trademark right (excluding a collective mark for a geographical indication): A trademark similar to the registered trademark

- (i) acts of using a trademark that is identical to another person's registered trademark on goods that are similar to the designated goods, or using a trademark similar to the registered trademark of another person on goods that are identical or similar to the designated goods;
- (ii) acts of delivering, selling, counterfeiting, imitating or possessing a trademark that is identical or similar to the registered trademark of another person in order to use or cause a third party to use the trademark on goods that are identical or similar to the designated goods;

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- (iii) acts of manufacturing, delivering, selling or possessing instruments in order to counterfeit or imitate another person's registered trademark or to cause a third party to counterfeit or imitate the trademark; and
 - (iv) acts of possessing goods for the purpose of assignment or delivery when those goods are identical to the designated goods and display a trademark that is identical or similar to another person's registered trademark
- (2) The following acts are considered to infringe a collective mark for a geographical indication:
- (i) acts of using a trademark (excluding a homonymous collective mark for a geographical indication) that is similar to another person's registered collective mark for a geographical indication on goods that are identical to the designated goods;
 - (ii) acts of delivering, selling, counterfeiting, imitating or possessing a trademark that is identical or similar to another person's registered collective mark for a geographical indication in order to use or cause a third party to use the trademark on goods that are identical or similar to the designated goods;
 - (iii) acts of manufacturing, delivering, selling or possessing instruments to counterfeit or imitate another person's registered collective mark for a geographical indication or to cause a third party to counterfeit or imitate the trademark;
 - (iv) acts of possessing goods for the purpose of assignment or delivery when those goods are identical or similar to the designated goods and display a trademark that is identical or similar to another person's registered collective mark for a geographical indication.

Article 67 Presumption etc. of the Amount of Damages

- (1) Where the owner of a trademark right or an exclusive licensee claims compensation from a person who has intentionally or negligently infringed a trademark right or exclusive license for damages caused by the infringer's transfer of infringing articles, the amount of damages is calculated as the number of transferred articles multiplied by the profit per unit of the articles that the owner of the trademark right or exclusive licensee might have sold in the absence of the infringement. However, the compensation must not exceed an amount calculated as follows: the estimated profit per unit multiplied by the number of articles that the trademark right owner or licensee could have produced subtracted by the number of articles actually sold. If the owner of the trademark right or exclusive licensee was unable to sell the article for reasons other than infringement, a sum calculated according to the number of articles subject to the reasons must be deducted.
- (2) Where the owner of a trademark right or an exclusive licensee claims compensation for damages from a person who has intentionally or negligently infringed the trademark right or the exclusive license, the profits gained by the infringer from the infringement are considered to be the amount of damage suffered by the owner of the trademark right or exclusive licensee.

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(3) Where the owner of a trademark right or an exclusive licensee claims compensation from a person who has intentionally or negligently infringed the trademark right or exclusive license due to damages caused by the infringement, the amount of money that the owner or exclusive licensee would normally be entitled to receive by using the registered trademark may be claimed as the amount of damages suffered.

(4) Notwithstanding paragraph (3) of this Article, where the amount is in excess of the amount referred to in paragraph (3), the excess amount may also be claimed as compensation for damage. When awarding damages in such cases, the court may consider whether the person who infringed the trademark right or the exclusive license was willful or grossly negligent.

(5) In litigation related to the infringement of a trademark right or exclusive license, where the court recognizes that the nature of the facts of the case make it difficult to provide evidence proving the amount of damage that has occurred, notwithstanding paragraphs (1) to (4), the court may determine a reasonable amount based on an examination of the evidence and on a review of all the arguments.

Article 68 Presumption of Intent

A person who has infringed a trademark right or an exclusive license on a trademark marked with an indication of trademark registration in accordance with Article 90 is presumed to have known that the trademark was registered.

Article 69 Measures for Recovering the Business Reputation of the Owner of a Trademark Right etc.

Upon a request of the owner of a trademark right or an exclusive licensee, the court may, in lieu of damages or in addition to damages, order a person who has injured the business reputation of the owner of the trademark right or exclusive licensee, by intentional or negligent infringement of the trademark right or exclusive license, to take necessary measures to restore the business reputation of the owner or exclusive licensee.

Article 70 Submission of Documents

In litigation related to the infringement of a trademark right or an exclusive license, the court may, upon the request of either party, order the other party to submit documents necessary for the assessment of damages caused by the infringement, unless the person who possesses the documents has justifiable reasons for refusing to submit them.

CHAPTER VII

TRIAL

Article 70bis Trial against Decision of Refusal

Any person dissatisfied with a decision to refuse registration of a trademark, to refuse supplementary registration of designated goods, to refuse to renew the term of a registered trademark or to refuse to registration of the reclassification of goods (referred to as "a decision of refusal") may request a trial within thirty days of the date of receiving a certified copy of the decision of refusal.

Article 70ter Trial against a Decision to Reject an Amendment

Any person dissatisfied with a decision to reject an amendment under Article 17(1) may request a trial within thirty days of the date of receiving a certified copy of the decision.

Article 71 Invalidation Trial of a Trademark Registration

(1) In the following cases, an interested person or an examiner may demand a trial to invalidate a registered trademark or the supplementary registration of designated goods. In such a case, if two or more designated goods are covered by the trademark registration, a request for an invalidation trial may be made for each of the designated goods:

- (i) the registration is in breach of Articles 3 (the proviso), 6 to 8, or 12(2) (second sentence), (5) and (7) to (9) or 23(1)(iv) to (vi) of this Act; or Article 25 of the Patent Act, which applies under Article 5 of this Act;
- (ii) the registration violates a treaty;
- (iii) the registration has been effected on the basis of an application filed by a person who is not a successor in title to the right deriving from the trademark application;
- (iv) following registration, the owner of the trademark right is no longer capable of enjoying the right under Article 25 of the Patent Act, which applies under Article 5 of this Act, or the registration no longer complies with a treaty;
- (v) following registration, the registered trademark falls under any of subparagraphs of Article 6(1) of this Act (unless Article 6(2) of this Act applies); and
- (vi) following the registration of a collective mark for a geographical indication under Article 41, the geographical indication of the registered collective mark for a geographical indication ceases to be protected or is no longer used in the country of origin.

(2) A trial for invalidation under paragraph (1) of this Article may be requested even after the extinguishment of a trademark right.

(3) Where a trial decision invalidating a trademark registration has become final, the trademark right is deemed never to have existed. However, where a trial decision invalidating a trademark right has become final under paragraphs (1)(iv) or (vi) of this Article, the trademark right is deemed not to have existed from the time the trademark registration applies under paragraphs (1)(iv) or (v) of this Article.

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(4) When applying the proviso of Article 3 of this Act, where the exact date on which a registered trademark falls under paragraph (1)(iv) or (vi) of this Article cannot be specified, the present trademark right is deemed not to have existed from the date on which a request for an invalidation trial under paragraph (1) of this Article is made known to the public.

(5) Where a trial under paragraph (1) of this Article has been requested, the presiding trial examiner shall notify the exclusive licensee of the trademark right and other persons who have any registered rights related to the trademark of the subject of the request.

Article 72 Invalidation Trial for Renewal of the Term of a Registered Trademark

(1) In the following cases, an interested person or an examiner may request a trial to invalidate the renewal of the term of a registered trademark. If two or more designated goods are covered by the renewed registered trademark, a request for an invalidation trial may be made for each of the designated goods.

(i) Deleted;

(ii) the registration for the renewal violates Article 43(2);

(iii) the registration for the renewal has been applied for by a person who is not the owner of the trademark right concerned.

(2) A trial for invalidation under paragraph (1) of this Article may be requested after the extinguishment of a trademark right.

(3) Where a trial decision invalidating the renewal of the term of a registered trademark has become final, the renewed registration is deemed never to have existed.

(4) Article 71(4) applies *mutatis mutandis* to the request for an invalidation trial under paragraph (1) of this Article.

Article 72bis Invalidation Trial of a Registration for the Reclassification of Goods

(1) An interested person or an examiner may request a trial to invalidate a registration of the reclassification of goods where any of the following subparagraphs apply; if two or more designated goods related to the registration for the reclassification of goods exist, a request for an invalidation trial may be made for each of the designated goods:

(i) where the registration of the reclassification of goods has been granted for designated goods not covered by the present registered trademark or where the scope of the designated goods has been expanded;

(ii) where an application to register the reclassification of goods has been filed by a person who is not the owner of the concerned trademark right; or

(iii) where the registration for the reclassification of goods violates Article 46bis(3).

(2) Article 71(2) and (5) applies *mutatis mutandis* to an invalidation trial against a registration of the reclassification of goods.

(3) Where a trial decision invalidating a registration of the reclassification of goods has become final, the registration of the reclassification of goods is deemed to have never existed.

Article 73 Trial for the Cancellation of a Registered Trademark

(1) A trial may be requested to cancel a registered trademark that falls under any of the following circumstances:

(i) deleted;

(ii) the owner of the trademark right intentionally uses a trademark similar to the registered mark on the designated goods or uses the registered trademark or a trademark similar to the registered trademark on goods similar to the designated goods in a manner that is liable to mislead consumers on the quality of the goods or cause confusion regarding the goods of another person;

(iii) the owner of the trademark right or the exclusive or nonexclusive licensee has not been continuously using the registered trademark for a period in excess of three years before the date of the cancellation trial for the designated goods in the Republic of Korea and no justifiable reasons exist for such nonuse;

(iv) the trademark is contrary to Article 54(1) (second sentence), (5) and (7) to (9) of this Act;

(v) a member of an association allows a third party to use its collective mark in violation of the statutes of the association or a member of an association uses the collective mark in violation of the statutes of the association, in a manner that is liable to mislead consumers on the quality or the geographical origin of goods or cause confusion regarding the goods of another person's business; however, an exception is made when the owner of the collective mark right has exercised reasonable supervision of the member of the association.

(vi) when a concern exists that a collective mark could mislead consumers on the quality of goods or cause confusion regarding the goods of another person's business due to a change of the statutes of the association under Article 9(3) of this Act;

(vii) a trademark falling under Article 23(1)(iii) of this Act has been registered and the owner of the original trademark requests a cancellation trial within five years of the trademark's registration date;

(viii) the exclusive or nonexclusive licensee uses the registered trademark or a similar trademark on the designated goods or similar goods, in a manner that is liable to mislead consumers on the quality of the goods or cause confusion regarding the goods of another person's business, except when the owner of the trademark right has taken reasonable care; or

(ix) when similar trademarks belong to different persons who have a trademark right due to the assignment of a trademark right, and one of the persons misleads consumers on the quality of goods or causes confusion regarding the goods of another person by using the registered trademark on goods identical or similar to the designated goods of their own registered trademark in acts of unfair competition;

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(x) where, notwithstanding a third party's use of a collective mark, the owner of the collective mark right intentionally misleads consumers on the quality or the geographical origin of goods or causes confusion regarding the goods of another person's business by failing to take reasonable measures;

(xi) where the owner of a registered collective mark for a geographical indication prevents a person who conducts the business activities of producing, manufacturing or processing designated goods that display a geographical indication from joining or subscribing to the owner's association, or where the association's articles of association prescribe conditions for subscription that are too difficult for the person to fulfill, or where the owner admits to the association a person who is not entitled to use the geographical indication;

(x ii) where the owner of a collective mark for a geographical indication or the member of the owner's association use the collective mark in violation of Article 90bis of this Act, in a manner that is liable to mislead consumers on the quality of the goods.

(2) Deleted.

(3) Where a cancellation trial is requested for the reasons referred to in paragraph (1)(iii) of this Article, a cancellation trial may be requested for a part of the designated goods if two or more of the designated goods are covered by the registered trademark.

(4) Where a cancellation trial is requested for the reasons referred to in paragraph (1)(iii) of this Article, the owner of the trademark right does not avoid the cancellation of the registration of the trademark for the designated goods if the defendant cannot prove that the registered trademark has been used in the Republic of Korea within a three-year period before the date of the request for a trial on one or more of the designated goods in the request, unless the defendant can provide a justifiable reason for failing to use the registered trademark.

(5) The reasons for cancellation referred to in paragraphs (1)(ii), (iii), (v), (vi), and (viii) to (xii) of this Article are not affected even when the facts that give rise to the request for a cancellation trial no longer exist after the request for a trial is made.

(6) A cancellation trial under paragraph (1) of this Article may be requested only by an interested person, except that a trial requested for the reasons referred to in paragraphs (1)(ii), (v), (vi), and (viii) to (xii) of this Article may be requested by any person.

(7) Where a trial decision ordering the cancellation of a trademark registration has become final, the trademark right is extinguished on that date.

(8) Article 71(4) of this Act applies *mutatis mutandis* to the request for a trial under paragraph (1) of this Article.

Article 74 Trial for the Cancellation of the Registration of an Exclusive or Nonexclusive License

- (1) Where an exclusive or nonexclusive licensee performs an act referred to in Article 73(1)(viii), a trial for the cancellation of the registration of the exclusive or nonexclusive license may be requested.
- (2) The reasons for cancellation are not affected even when the facts that give rise to the request for a cancellation trial no longer exist after the request for a trial for the cancellation of the registration of an exclusive or nonexclusive license is made under paragraph (1) of this Article.
- (3) Any person may request a trial for the cancellation of an exclusive or nonexclusive license under paragraph (1) of this Article.
- (4) Where a trial decision ordering the cancellation of the registration of an exclusive or nonexclusive license has become final, the exclusive or nonexclusive license is extinguished on that date.
- (5) Where a trial under paragraph (1) of this Article has been requested, the presiding trial examiner shall notify the nonexclusive licensee and other persons who have any registered rights related to the trademark right and the persons who have any registered right for the exclusive or nonexclusive license of the demand.

Article 75 Trial to Confirm the Scope of a Trademark Right

The owner of a trademark right or an interested person may request a trial to confirm the scope of a trademark right.

Article 76 Term of Exclusion

- (1) A trial to invalidate a registered trademark, the renewal of the term of a registered trademark and the registration of a reclassification of goods under Articles 7(1)(vi) to (*ixbis*) and (xiv), 8, 72(1)(ii) and 72*bis*(1)(iii) of this Act may not be requested more than five years after the registration date of the trademark, after the registration date for renewal of the term of the registered trademark or after the registration date of the reclassification of goods.
- (2) A trial for the cancellation of a trademark registration and of the registration of an exclusive or nonexclusive license under Articles 73(1)(ii), (v), (vi), (viii) to (xii) and 74(1) of this Act may not be requested more than after years after the date on which the alleged facts have ceased to exist. or after the registration date of the reclassification of goods.

Article 77 *Mutatis Mutandis* Application of the Patent Act

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Articles 139, 140, 141 to 153, 153*bis* and 154 to 166 of the Patent Act apply *mutatis mutandis* to trials. In such cases, "an invalidation trial under Article 133(1), 134(1) or 137(1)" in Article 139(1) of the Patent Act reads "an invalidation trial under Article 71(1), 72(1) and 72*bis*(1), a cancellation trial under Article 73(1)", "a trial for invalidating a patent Article 133(1)" in Article 161(2) of the Patent Act reads "an invalidation trial under Article 71(1), 72(1) and 72*bis*(1), a cancellation trial under Article 73(3)", "Article 133(1), 134(1), 135 and 137(1)" in Article 165(1) of the Patent Act reads "Article 71(1), 72(1), 72*bis*(1), 73(1) and 75", and "Article 132*ter*, 136 or 138" in Article 165(3) of the Patent Act reads "Article 70*bis* or 70*ter*".

Article 78 Deleted

Article 79 Formal Requirements for Requesting a Trial against an Examiner's Decision to Refuse or Reject an Amendment

(1) A person who requests a trial against an examiner's decision of refusal under Article 70*bis* or a trial against the decision to reject an amendment under Article 70*ter* shall submit a written request to the President of the Intellectual Property Tribunal, stating the following:

- (i) the name and address of the parties (and, if a legal entity, the name and address of the business);
- (*ibis*) the name and residential or business address of the agent, if any (and, if the agent is a patent legal entity, the name and address of the business and the name of the designated patent attorney);
- (ii) the number and date of the application that is the subject of the rejection;
- (iii) the designated goods and the classes of the goods;
- (iv) the date of the examiner's decision to refuse or reject an amendment;
- (v) the identification number of the trial case;
- (vi) the purpose and reasons for the request; and
- (vii) deleted.

(2) Where a trial against an examiner's decision of refusal has been requested under Article 70*bis*, the President of the Intellectual Property Tribunal shall notify the opponent of the request for the trial if the decision of refusal was based on an opposition to the trademark registration.

Article 80 Deleted

Article 81 *Mutatis Mutandis* Application of Provisions Concerning Examination in the Trial against the Decision of Refusal

(1) Articles 15, 17, 18, 23(2), 24 to 30, 45(2), 46*quater*(2) and 48(2) apply *mutatis mutandis* to a trial against a decision of refusal; however, Article 24 does not apply where an application for trademark registration or supplementary registration of designated goods have already been published.

(2) When Article 17 is applied under paragraph (1) of this Article, "where an applicant has requested a trial against the decision to reject an amendment under Article 70ter" in Article 17(3) means "where a lawsuit is brought under Article 186(1) of the Patent Act as applied under Article 86(2) of this Act"; and "until the trial decision of the trial has become final" means "until the judgement has become final".

(3) Articles 17(4) to (6), 23(2), 45(2) 46*quater*(2) and 48(2) applied under paragraph (1) of this Article apply *mutatis mutandis* where reasons for refusal other than those contained in the decision of refusal are found.

Article 82 Special Provisions of a Trial against the Decision to Refuse or the Decision to Reject an Amendment

(1) Articles 172 and 176 of the Patent Act apply *mutatis mutandis* to a trial on the decision to refuse and the decision to reject an amendment. In this case, "132ter" in Article 176(1) of the Patent Act reads "70bis or 70ter" and "ruling of refusal to grant a patent, refusal to extend the term of a registered patent or revocation of a patent" in Article 176(1) of the Patent Act reads "decision to refuse or reject an amendment".

(2) Articles 147(1) and (2), 155 and 156 of the Patent Act, which apply *mutatis mutandis* under Article 77, do not apply to the trial against the decision of refusal referred to in Article 70bis and the decision to reject an amendment referred to in Article 70ter.

CHAPTER VIII

RETRIAL AND LITIGATION

Article 83 Request for a Retrial

(1) Any party may request a retrial against a trial decision that has become final.

(2) Articles 451 and 453 of the Civil Procedure Act apply *mutatis mutandis* to the request for a retrial under paragraph (1) of this Article.

Article 84 Request for a Retrial on Account of Collusion

(1) Where the parties to a trial colluded to bring about a trial ruling that damages the rights or interests of a third party, the third party may request a retrial against the trial ruling that has become final.

(2) In a retrial on account of collusion, the parties to the initial trial are the joint defendants.

Article 85 Restriction on the Effects of a Trademark Right Restored by a Retrial

In any of the following cases, the effects of a trademark right do not extend to the good-faith use of a trademark that is identical to the registered trademark on goods identical to the designated goods and acts referred to in Article 66(1)(i), (2)(i), after the decision concerned became final but before the request for a retrial has been registered:

- (i) where the trademark registration or the registration for renewal of the term of the invalidated trademark right has been restored by a retrial;
- (ii) where the trademark registration that had been cancelled has been restored by a retrial; or
- (iii) where a trial decision that a product was outside the scope of the trademark right became final, and a decision to the contrary was subsequently made at a retrial.

Article 86 *Mutatis Mutandis* Application of the Patent Act

(1) Articles 180 and 184 of the Patent Act and Article 459(1) of the Civil Procedure Act apply *mutatis mutandis* to procedures and requests for a retrial.

(2) Articles 186 to 188 and 189 of the Patent Act apply *mutatis mutandis* to litigation under this Act. Where Article 186(1) of the Patent Act applies, "action against a trial decision" means "action against a trial decision and a decision to reject an amendment under Article 17(1) as applied under Article 81(1) (including Article 184 of the Patent Act as applied under 86(1))" and "Articles 133(1), 134(1), 135(1), 137(1) and (3) and 138(1)" in Article 187 of the Patent Act means "Articles 71(1), 72(1), 72bis(1), 73(1) and (2), 74(1) and 75".

CHAPTER VIIIbis

INTERNATIONAL APPLICATIONS UNDER THE PROTOCOL

Part I. International Applications etc.

Article 86bis International Applications

A person who desires to applying for an international registration referred to in Article 2(1) of the Protocol shall file with the Commissioner of the Korean Intellectual Property Office an international application based on a trademark registration or an application for trademark registration that falls under any of the following subparagraphs:

- (i) the applicant's application for trademark registration;
- (ii) the applicant's trademark registration; or
- (iii) the applicant's application for trademark registration and the applicant's trademark registration.

Article 86ter Entitlement to File

(1) A person who falls under any of the following subparagraphs may file an international application with the Commissioner of the Korean Intellectual Property Office:

- (i) a national of the Republic of Korea; or
- (ii) a person who resides (or, if a legal entity, has a real and effective industrial or commercial establishment) in the territory of the Republic of Korea.

(2) Two or more persons who jointly file an international application shall meet the requirements for an entitlement to file as prescribed by ordinance of the Ministry of Commerce, Industry and Energy.

Article 86^{quater} Procedure for an International Application

(1) A person filing an international application shall submit in a language prescribed by ordinance of the Ministry of Commerce, Industry and Energy a request for an international application and the documents necessary for an international application (referred to as "a request for an international application") to the Commissioner of the Korean Intellectual Property Office.

(2) The following particulars must be indicated in a request for an international application:

- (i) the name and address of the applicant (and, if a legal entity, the name and address of the business);
- (ii) indications concerning entitlement to file under Article 83^{ter};
- (iii) the names of the contracting states and intergovernmental organizations (referred to as "the designated states") where protection for the trademark is secured;
- (iv) the filing date and the application number of the basic application under Article 2(1) of the Protocol (referred to as "the basic application") or the registration date and the registration number of the basic registration under Article 2(1) of the Protocol (referred to as "the basic registration");
- (v) the trademark for which international registration is sought;
- (vi) goods for which international registration is sought and the classes of the goods; and
- (vii) the other particulars prescribed by ordinance of the Ministry of Commerce, Industry and Energy.

(3) Where a person filing an international application claims color as a distinctive feature of the trademark, the person shall state the fact of this claim and file a notice specifying the color or combination of colors claimed along with a request for an international application; the person shall also append color copies of the trademark to a request for an international application.

Article 86^{quinquies} Examination of the Particulars of an International Application etc.

(1) Where the particulars appearing in a request for an international application correspond to the particulars appearing in the basic application or the basic registration, the Commissioner of the Korean Intellectual Property Office shall indicate in the request for an international application an acknowledgement of the correspondence and the date of receiving the request for an international application.

(2) After indicating the date of receipt and so on under paragraph (1), the Commissioner of the Korean Intellectual Property Office shall transmit promptly the request for an international application and the documents necessary for the international application to the International Bureau as prescribed under Article 2(1) of the Protocol (referred to as "the International Bureau") and a copy of the request for an international application to the applicant.

Article 86sexies Subsequent Designation

(1) The holder of an international registration who designates additional states or intergovernmental organizations where the protection of the internationally registered mark is sought (referred to as "a subsequent designation") may present a request for a subsequent designation to the Commissioner of the Korean Intellectual Property Office as prescribed by ordinance of the Ministry of Commerce, Industry and Energy.

(2) For the purpose of paragraph (1), the holder of an international registration may request a subsequent designation for all or some of the goods of the internationally registered trademark.

Article 86septies Renewal of Term

(1) The holder of an international registration may renew the term of the international registration for an additional period of ten years.

(2) A person renewing the term of an international registration under paragraph (1) shall present a request for renewal of the term of the international registration to the Commissioner of Korean Intellectual Property Office as prescribed by ordinance of the Ministry of Commerce, Industry and Energy.

Article 86octies Recording a Change of Ownership of an International Registration

(1) The holder of an international registration or the holder's assignee may change the ownership of the international registration for all or some of the designated goods or the designated states.

(2) A person changing the ownership of an international registration under paragraph (1) shall present a request for recording the change of ownership to the Commissioner of Korean Intellectual Property as prescribed by ordinance of the Ministry of Commerce, Industry and Energy.

Article 86*novies* Payment of Official Fees

(1) The following persons shall pay the official fees to the Commissioner of the Korean Intellectual Property Office:

- (i) a person filing an international application;
- (ii) a person requesting a subsequent designation;
- (iii) a person requesting renewal of the term of an international registration under Article 87*septies*; or
- (iv) a person requesting that a change of ownership be recorded in the international registration under Article 87*octies*.

(2) Matters necessary for paying official fees, including procedures and time limits for paying under paragraph (1), are prescribed by ordinance of the Ministry of Commerce, Industry and Energy.

Article 86*decies* Amendment concerning Nonpayment of Official Fees

Where a person who falls under any subparagraph of Article 86*novies*(1) fails to pay the official fees required under Article 86*novies*(2), the Commissioner of the Korean Intellectual Property Office may instruct the person to pay the fees within a designated period.

Article 86*undecies* Invalidation of a Procedure

Where a person who has been instructed to pay the official fees under Article 86*decies* fails to pay the official fees within the designated period, the Commissioner of the Korean Intellectual Property Office may invalidate the procedure.

Article 86*duodecies* Recording a Change in International Registration Matters

A request for recording a change in matters concerning an international registration or in any other matters necessary for an international application are prescribed by ordinance of the Ministry of Commerce, Industry and Energy.

Article 86*terdecies* Exclusion of Business Emblems

Article 86*bis* to 86*duodecies* does not apply to business emblems.

Part II. Special Provisions on an International Application for Trademark Registration

Article 86*quaterdecies* International Application for Trademark Registration

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(1) An international application that has been registered internationally under the Protocol and that designates the Republic of Korea as a designated State (including subsequent designations) is considered to be an application for trademark registration under this Act.

(2) In paragraph (1), the date of an international registration under Article 3(4) of the Protocol (referred to as "the date of the international registration") is considered to be the filing date of the application for trademark registration under this Act. However, if an international application subsequently designates the Republic of Korea, the date (referred to as "the date of subsequent designation") on which the subsequent designation is recorded in the International Register defined in Article 2(1) of the Protocol (referred to as "the International Register") is considered to be the filing date of the application for trademark registration under this Act.

(3) Where an international application is considered to be an application for trademark registration under paragraph (1) (referred to as "an international application for trademark registration"), the name and address of the owner of the international registration (or, if a legal entity, its name and business address), the trademark, the designated goods and the classification(s) of the goods that are recorded in the International Register are deemed to be the name and address of the applicant (or, if a legal entity, its name and business address), the trademark, the designated goods and the classification(s) of the goods, respectively, under this Act.

Article 86*quindecies* Special Provision on Business Emblems

The provisions for a business emblem do not apply to an international application for trademark registration.

Article 86*sedecies* Special Provisions on an International Application for Trademark Registration

(1) In applying this Act to an international application for trademark registration, the purport of the priority claim, the name of the country in which the earlier application was filed and the filing date of the earlier application recorded in the International Register are deemed to be the purport of the priority claim, the name of the country in which the earlier application was filed and the filing date of the earlier application that are indicated in the application for trademark registration.

(2) In applying this Act to an international application for trademark registration, the purport of a three-dimensional trademark that is recorded in the International Register is deemed to be the purport of a three-dimensional trademark indicated in the application for trademark registration.

(3) A person seeking to register a collective mark shall submit the articles of association prescribed in Article 9(3) of this Act within the period prescribed by ordinance of the Ministry of Commerce, Industry and Energy. A person seeking to register a collective mark for a geographical indication under Article 2(1)(iii~~quater~~) of this Act shall submit a document in which the purport to register a collective mark for a geographical indication is stated; as prescribed by Presidential Decree, the document should prove that the collective mark complies with the definition of a geographical indication under Article 2(1)(iii~~bis~~) of this Act as well as with the statutes of association.

Article 86~~septiesdecies~~ Effect of an International Application for Trademark Registration of a Domestically Registered Trademark

(1) Except for trademark registrations resulting from an international application for trademark registration, when the holder of a trademark right registered in the Republic of Korea (referred to in this Article as "a domestically registered trademark") files an international application for trademark registration, the international application is deemed to be filed on the filing date of the domestically registered trademark with respect to the overlapping scope of designated goods if all the following conditions are fulfilled:

- (i) the trademark registered in the International Register as a result of an international application for trademark registration (referred to as an "internationally registered trademark") is identical to a domestically registered trademark;
- (ii) the holder of the internationally registered trademark is identical to the holder of the domestically registered trademark;
- (iii) all the designated goods listed in the domestically registered trademark are included as the designated goods of the internationally registered trademark; and
- (iv) territorial extension under Article 3(3) of the Protocol takes effect after the registration date of the domestically registered trademark.

(2) Where recognition is given to a priority under the Treaty for an application for trademark registration that is related to a domestically registered trademark under paragraph (1) of this Article, the priority is also recognized for an international application for trademark registration under the same paragraph.

(3) Where the right of a domestically registered trademark is cancelled or extinguished under either of the following subparagraphs, the effect of the concerned international application for trademark registration under paragraphs (1) and (2) of this Article is not recognized within the same scope of the designated goods of the cancelled or extinguished trademark right:

- (i) if a trial decision canceling the trademark registration under Article 73(1)(ii), (iii) and (v) to (xii) of this Act has become final; or
- (ii) if a trial for the cancellation of a trademark registration is requested under Article 73(1)(ii), (iii) and (v) to (xii) of this Act, and the trademark right has become extinguished due to the expiry of the trademark term or to the abandonment of some of the trademark rights or designated goods after the request date of the cancellation trial.

Article 86*duodevicies* Special Provisions for the Transfer and Partial Assignment of an Application for Trademark Registration etc.

(1) For an international application for trademark registration, "except for inheritance or other general succession, are not effective against third parties without recording the change" in Article 12(1) reads "are not effective against third parties without recording the change in the International Bureau".

(2) Where all or some of the designated goods of an international registration have been transferred separately by a change in the ownership of the international registration, each international application for trademark registration is deemed to have been filed by each changed holder of the international registration.

(3) Article 12(4) does not apply to an international application for trademark registration.

Article 86*undevicies* Special Provisions for Amendments

(1) For an international application for trademark registration, "the trademark or the list of designated goods in the application for trademark registration" in Article 14(1) reads "the list of designated goods in the application for trademark registration only when the applicant has been notified of the reasons for refusal under Article 23(2)".

(2) For an international application for trademark registration, "designated goods or a specimen, or both" in Article 15 reads "designated goods".

(3) Article 16(1)(iv) does not apply to an international application for trademark registration.

(4) For an international application for trademark registration, "an application for trademark registration or designated goods" in Article 16(2) or (3) reads "the designated goods".

Article 86*vicies* Special Provision for the Division of Applications

Article 18 does not apply to an international application for trademark registration.

Article 86*unvicies* Special Provision for the Conversion of Applications

Article 19(1) to (4) does not apply to an international application for trademark registration.

Article 86*duovicies* Special Provision for a Priority Claim under the Paris Convention

Article 20(4) and (5) does not apply if an applicant of an international application for trademark registration claims priority under the Paris Convention.

Article 86^{ter}vicies Special Provision on the Time of Filing an Application

For an international application for trademark registration, "submit to the Commissioner of the Korean Intellectual Property Office a written statement of intent with the application for trademark registration and, within thirty days of the filing date of the application, a document proving the relevant facts" in Article 21(2) reads "submit to the Commissioner of the Korean Intellectual Property Office a written statement of intent and a document proving the relevant facts within the period prescribed by ordinance of the Ministry of Commerce, Industry and Energy".

Article 86^{quater}vicies Special Provision for Publication of an Application

For an international application for trademark registration, "Where an examiner finds no grounds for rejecting an application for trademark registration" in Article 24(1) reads "Where an examiner finds no grounds for rejecting an application for trademark registration within the period prescribed by ordinance of the Ministry of Commerce, Industry and Energy".

Article 86^{quin}vicies Special Provision for the Right to Demand Compensation for Losses

For an international application for trademark registration, "a copy of the application for trademark registration" in the proviso of Article 24^{bis}(1) reads "a copy of the international application".

Article 86^{se}vicies Special Provisions for an Opposition to a Trademark Registration

For an international application for trademark registration, "serial number of the application for trademark registration" in the proviso of Article 25(2)(ii) reads "international registration number of an international application for trademark registration".

Article 86^{septies}vicies Special Provisions for a Decision to Register a Trademark

When applying the proviso of Article 25(2)(ii) to an international application for trademark registration, "cannot find any reasons for refusing an application for trademark registration" in Article 30 reads "cannot find any reasons for refusing an application for trademark registration within the period prescribed by ordinance of the Ministry of Commerce, Industry and Energy".

Article 86^{duode}vicies Special Provisions for Trademark Registration Fees

(1) A person filing an international application for trademark registration or renewing the term of a registered trademark that has been registered under Article 86^{un}vicies (referred to as "a trademark right based on international registration") shall pay the individual fee under Article 8(7)(a) of the Protocol to the International Bureau.

(2) Matters related to paying individual fees under paragraph (1) of this Article are prescribed by ordinance of the Ministry of Commerce, Industry and Energy.

(3) Articles 34 to 36*bis* do not apply to an international application for trademark registration or to a trademark right based on international registration.

Article 86*undetricies* Special Provision for Refunding Trademark Registration Fees etc.

For an international application for trademark registration, "Trademark registration fees and official fees that have been paid" in the proviso of Article 38(1) reads "official fees that have been paid", and "fees" in the proviso of Article 38(1) and in paragraphs (2) and (3) of Article 38 reads "official fees".

Article 86*tricies* Special Provisions for Registration in the Trademark Register

(1) For a trademark right based on international registration, "the establishment, transfer, modification, expiry, renewal of the term, conversion of the classification of goods under Article 46*bis*, supplementary registration of designated goods or restriction on disposal, of a trademark right" in Article 39(1)(i) reads "the establishment or restriction on disposal, of a trademark right".

(2) The transfer, modification, expiry or renewal of the term of a registered trademark based on international registration are based on the registration of the International Register.

Article 86*untricies* Special Provision for Registering the Establishment of a Trademark Right

For an international application for trademark registration, "When trademark registration fees have been paid in accordance with Article 34(1)" in Article 41(2) reads "When the decision on the registration of the trademark has been made".

Article 86*duotricies* Special Provisions for the Term of a Trademark Right

(1) The term of a trademark right based on international registration is from the date of registration of its establishment under Article 86*untricies* to the expiry of a ten-year period following the date of the international registration.

(2) The term of a trademark right based on international registration may be renewed for an additional ten-year period upon renewal of the term of the international registration.

(3) Where the term of a trademark right based on international registration is renewed under paragraph (2), it is deemed to have been renewed on the expiry date of the term.

(4) Articles 42 to 46*quinquies*, 49(1) and (2) and 64*bis* do not apply to a trademark right based on international registration.

Article 86*tertricies* Special Provision for an Application for Supplementary Registration of Designated Goods

Article 49(3) does not apply to an international application for trademark registration or to a trademark right based on international registration.

Article 86*quatertricies* Special Provision for the Division of a Trademark Right

Article 54*bis* does not apply to a trademark right based on international registration.

Article 86*quintricies* Special Provisions for the Effects of a Trademark Right

(1) The transfer, modification, expiry by abandonment or renewal of the term of a registered trademark right based on international registration have no effect unless recorded in the International Register.

(2) Article 56(1)(i) (excluding the part related to the restriction on disposal) does not apply to a trademark right based on international registration.

(3) For a trademark right based on international registration, "a trademark right, exclusive license" in Article 56(2) reads "an exclusive license".

Article 86*settricies* Effects of Canceling an International Registration

(1) Where all or part of an international registration on which an international application for trademark registration is based has been cancelled, the international application for trademark registration is deemed to have been withdrawn for all or some of the designated goods to the extent of which the international registration has been cancelled.

(2) Where all or part of the international registration on which a trademark right based on international registration is based has been cancelled, the trademark right is deemed to have been extinguished for all or some of the designated goods to the extent of which the international registration has been cancelled.

(3) The effects under paragraphs (1) or (2) enter into force from the date on which the international registration in the International Register has been cancelled.

Article 86*septiestricies* Special Provisions on Abandoning a Trademark Right

(1) Article 60(1) does not apply to a trademark right based on international registration.

(2) For a trademark right based on international registration, "a trademark right, an exclusive" under Article 61 reads "an exclusive".

Article 86*duodequadrages* Special Provision on an Invalidation Trial for Renewal of the Term of a Registered Trademark

Articles 72 and 72*bis* do not apply to a trademark right based on international registration.

Part III. Special Provisions on an Application for Trademark Registration

Article 86*undequadrages* Special Provisions on an Application for Trademark Registration after Cancellation of an International Registration

(1) Where international registration of a trademark that is the subject of an international registration designating (including subsequent designations) the Republic of Korea has been cancelled under Article 6(4) of the Protocol for all or some of the designated goods, the holder of the international registration may file an application for trademark registration with the Commissioner of the Korean Intellectual Property Office for all or some of the designated goods.

(2) Where an application for trademark registration under paragraph (1) fulfills all the requirements of the following subparagraphs, the application is deemed to have been filed on the date of the international registration (or, for a subsequent designation, the date of the subsequent designation):

- (i) the application under paragraph (1) is filed within three months of the date on which the international registration was cancelled under the same paragraph;
- (ii) the designated goods of the application for the trademark registration under paragraph (1) are covered by the list of the designated goods contained in the international registration under the same paragraph; and
- (iii) the trademark for which trademark registration is sought is identical to the trademark of the cancelled international registration.

(3) Where a right of priority under a treaty is recognized for an international application for trademark registration that is filed for an international registration under paragraph (1), the right of priority is recognized for the application for the trademark registration under the same paragraph.

Article 86*quadrages* Special Provisions on an Application for Trademark Registration after Denunciation of the Protocol

(1) Where the holder of an international registration designating (including subsequent designation) the Republic of Korea is no longer entitled to file an international application under Article 15(5)(b) of the Protocol, the holder of the international registration may file an application for trademark registration with the Commissioner of the Korean Intellectual Property Office for all or some of the designated goods registered in the International Register.

(2) Article 86*undequadragies*(2) and (3) applies *mutatis mutandis* to an application for trademark registration under paragraph (1). In such cases, "within three months of the date on which the international registration was cancelled under the same paragraph" under Article 86*undequadragies*(2)(i) reads "within two years of the date on which the denunciation became effective under Article 15(3) of the Protocol".

Article 86*unquadragies* Special Provision on Examinations

Where an application for trademark registration that falls under any of the following subparagraphs (referred to as "a reapplication") is related to a trademark registered under Article 86*untricies*, Articles 23, 24, and 25 to 29 do not apply to the application:

- (i) an application for trademark registration that fulfills the requirements of all the subparagraphs of Article 86*undequadragies* (2) and is filed in accordance with Article 86*undequadragies*(1); or
- (ii) an application for trademark registration that fulfills the requirements of all the subparagraphs of Article 86*undequadragies* (2), which applies *mutatis mutandis* under Article 86*quadragies*(2) and is filed in accordance with Article 86*quadragies*(1).

Article 86*duoquadragies* Special Provision on the Statute of Limitation

Where a trademark has been registered as a result of a reapplication and the statute of limitations under Article 76(1) for the previous trademark right based on international registration has lapsed, an invalidation trial against the trademark that was registered as a result of the reapplication may not be requested.

CHAPTER IX

SUPPLEMENTARY PROVISIONS

Article 87 Inspection of Documents etc.

A person may request the Commissioner of the Korean Intellectual Property Office or the President of the Intellectual Property Tribunal for certification of an application for trademark registration, a trial certificate, a certified copy or extract of documents, or to inspect or copy the Trademark Register or other documents.

Article 88 Prohibition of Opening or Carrying Out the Trademark Register and Documents Related to an Application for Trademark Registration, Examination, Trial or Retrial

(1) Carrying out of the Trademark Register or documents related to an application for trademark registration, examination, trial or retrial is prohibited, unless the documents are related to the registration of either a trademark or a collective mark for a geographical indication or an examination and are removed in accordance with Article 22*bis*(1) to (3) of this Act.

(2) An answer may not be given to a request for an expert opinion, testimony or inquiry regarding the contents of an ongoing case involving an application for trademark registration, examination, trial or retrial, or regarding the contents of a decision to grant or refuse trademark registration.

Article 89 Trademark Gazette

(1) The Korean Intellectual Property Office shall publish the Trademark Gazette.

(2) The Trademark Gazette may be published in electronic media as prescribed by ordinance of the Ministry of Commerce, Industry and Energy.

(3) When publishing the Trademark Gazette in electronic media, the Commissioner of the Korean Intellectual Property Office shall publicize on a communication network matters regarding the Trademark Gazette's publication, main contents and service.

(4) Matters to be inserted in the Trademark Gazette are determined by Presidential Decree.

Article 90 Indication of Trademark Registration

The owner of a trademark right or an exclusive or nonexclusive licensee may use the indication "Registered Trademark" on designated goods or their packaging.

Article 90*bis* Indication of a Registered Homonymous Collective Mark for a Geographical Indication

When two or more registered collective marks for a geographical indication are homonymous, the owner of each collective mark and the members of each association may use the registered mark if the mark is accompanied by an indication that does not confuse consumers about the geographical origin.

Article 91 Prohibition of False Indication

(1) A person may not perform any of the following acts:

- (i) indicating on goods a trademark that is not registered, or for which trademark registration has not been applied for, as if the mark was a registered trademark or its registration had been applied for;
- (ii) indicating on advertisements, signboards, labels or packaging of goods or other business transaction documents and so on a trademark that is not registered or for which trademark registration has not been applied for, as if the mark was a registered trademark or its registration had been applied for; or
- (iii) marking an indication that the trademark is registered for goods other than the designated goods, or marking an indication that is liable to cause confusion if the registered trademark is used on goods other than the designated goods.

(2) Acts indicating a trademark under paragraph (1)(i) and (ii) of this Article include goods and packaging, advertisement, signboards, or labels that have become shapes of marks.

Article 91bis Special Provision on a Trademark etc. that is Similar to a Registered Trademark

(1) "The registered trademark" referred to in Articles 50, 53, 55(3), 57(2), 62, 67(2), 73(1)(iii) and (iv), 85, 90 and 91 of this Act includes trademarks that are similar to a registered trademark; if the colors of a similar trademark are the same as the colors of the registered trademark, the similar trademark is deemed identical to the registered trademark.

(2) "A trademark similar to the registered trademark" referred to in Articles 66(1)(i) and 73(1)(ii) of this Act does not include trademarks that are similar to a registered trademark if those trademarks are deemed identical to the registered trademark because the colors of the similar trademark are the same as the colors of the registered trademark.

(3) "A trademark that is similar to another person's registered collective mark for a geographical " referred to in Article 66(2)(i) of this Act does not include trademarks that are similar to a registered collective mark; if the colors of a similar trademark are the same as the colors of the registered collective mark for a geographical indication, the similar trademark is deemed identical to the registered collective mark for a geographical indication.

Article 92 Mutatis Mutandis Application of the Patent Act

Articles 218 to 220, 222 and 224bis of the Patent Act apply *mutatis mutandis* to trademarks.

CHAPTER X

PENAL PROVISIONS

Article 93 Offense of Infringement

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A person who has infringed a trademark right or an exclusive license is liable to imprisonment with labor not exceeding seven years or to a fine not exceeding 100 million won.

Article 94 Offense of Perjury

(1) Having taken an oath under law, a witness, expert witness or interpreter who makes a false statement or gives a false expert opinion or interprets falsely before the Intellectual Property Tribunal is liable to imprisonment with labor not exceeding five years or to a fine not exceeding 10 million won.

(2) Having committed an offense under paragraph (1) of this Article, a person who reveals the offense before the examination of the case is concluded, before the examiner's decision to grant or refuse trademark registration is made or before a trial decision on the case becomes final may be partially or totally exempted from the application of the penalty.

Article 95 Offense of False Marking

A person who violates Article 91 is liable to imprisonment with labor not exceeding three years or to a fine not exceeding 20 million won.

Article 96 Offense of Fraud

A person who fraudulently or unjustly obtains a trademark registration, the supplementary registration of designated goods, the registration for renewal of the term of a trademark right, the registration of the reclassification of goods or a trial decision is liable to imprisonment with labor not exceeding three years or to a fine not exceeding 20 million won.

Article 97 Dual Liability

Where a representative of a legal entity or an agent, employee or any other servant of a legal entity or natural person violates Articles 93, 95 or 96 with regard to the business of the legal entity or natural person, in addition to the offender, the legal entity is liable to a fine as prescribed in either of the following subparagraphs, and the natural person is liable to a fine as prescribed in the relevant Article:

- (i) under Article 93, a fine not exceeding 300 million won; or
- (ii) under Articles 95 or 96, a fine not exceeding 60 million won.

Article 97bis Confiscation

(1) A trademark or packaging that infringes trademark rights or the exclusive use of the rights of another under Article 93, or a trademark obtained by such an infringement, or machinery used for the production of such goods, must be confiscated.

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(2) Notwithstanding paragraph (1) of this Article, if, to remove an infringement, goods can be easily detached from their trademarks or packagings without affecting the function or feature of those goods, the goods may not be confiscated.

Article 98 Administrative Fine

(1) A person who commits any of the following acts is liable to an administrative fine not exceeding 500,000 won:

- (i) making a false statement before the Intellectual Property Tribunal after having taken an oath under Articles 299(2) and 367 of the Civil Procedure Act;
- (ii) failing to comply, without justifiable reasons, with an order of the Intellectual Property Tribunal to submit or show documents or other materials related to taking or preserving evidence;
- or
- (iii) failing to comply, without justifiable reasons, with a subpoena of the Intellectual Property Tribunal to appear as a witness, expert witness or interpreter, or refusing to take an oath, make a statement, testify, give an expert opinion or interpret.

(2) The Commissioner of the Korean Intellectual Property Office shall impose and collect the administrative fine referred to in paragraph (1) of this Article as prescribed by Presidential Decree.

(3) A person who objects to the imposition of an administrative fine under paragraph (2) of this Article may protest to the Commissioner of the Korean Intellectual Property Office within thirty days of the date of notification of the imposition.

(4) Upon receipt of a protest under paragraph (3) of this Article, the Commissioner of the Korean Intellectual Property Office shall immediately notify the competent court, which shall adjudicate the case of the administrative fine according to the Noncontentious Case Litigation Procedure Act.

(5) Where an objection has not been raised within the period prescribed in paragraph (3) of this Article and where the fine has not been paid, the Commissioner of the Korean Intellectual Property Office shall collect the fine in accordance with the rules of collecting national taxes in arrears through the head of the competent tax office.

ADDENDUM <No. 4210, January 13, 1990>

Article 1 Date of Entry into Force

This Act enters into force on September 1, 1990.

Article 2 General Transitional Measures

Except as otherwise provided in Articles 3 to 8 of this addendum, this Act applies to matters that have taken place before this Act enters into force. However, any effect taken under the previous provisions is not affected.

Article 3 Transitional Measures on the Dismissal of a Correction

A correction made before this Act enters into force is subject to the previous provisions.

Article 4 Transitional Measures on an Application for Trademark Registration etc.

The examination of an application for trademark registration, an application for renewal of the term of a registered trademark and an application for additional registration of designated goods and an appeal on a ruling of refusal made before this Act enters into force are subject to the previous provisions (excluding Article 73(1)(i)).

Article 5 Transitional Measures on the Effect of Renewing the Term of a Registered Trademark

Where a trademark is registered in the previous provisions before this Act enters into force, and the renewal of the term of a trademark right is registered under this Act, the registered trademark is deemed to have been registered under this Act.

Article 6 Transitional Measures on the Effect of a License

The effect of a license registered under the previous provisions before this Act enters into force is subject to the previous provisions.

Article 7 Transitional Measures on Trials Related to a Registered Trademark etc.

(1) A trial, appeal, retrial and lawsuit related to an invalidation trial and a trial to confirm the scope of a trademark registered by an application for trademark registration, an application for renewal of the term of a trademark right and an application for additional registration of designated goods, made before this Act enters into force, is subject to the previous provisions. However, this provision does not apply to the request referred to in the latter part of the main sentence of Article 72(1).

(2) Any trial, appeal, retrial and lawsuit on the revocation trial of a trademark registration requested before this Act enters into force is subject to the previous provisions.

(3) Any trial, appeal, retrial and lawsuit on a revocation trial of a license registered under the previous provisions before this Act enters into force is subject to the previous provisions, except for the request referred to in Article 74(3).

Article 8 Transitional Measures on the Procedures and Expenses of Trials and Compensation for Damages etc.

The previous provisions govern the procedure, expenses, compensation for damages and so on for a trial, appeal, retrial and lawsuit requested against any act committed before this Act enters into force.

ADDENDUM (Government Organization Act) <No. 4541, March 6, 1993>

Article 1 Date of Entry into Force

This Act enters into force on the date of its promulgation. (Proviso deleted.)

Articles 2 and 3 Deleted

Article 4 Amendment of Other Acts Following the New Establishment of the Ministry of Commerce, Industry and Energy

(1) and <49>Deleted

<50> The following provisions of the Trademark Act are amended as follows:

In Articles 9(1)(vii), 10(1), 34(3) and 37(2), "Decree of the Ministry of Commerce and Industry" reads "Decree of the Ministry of Commerce, Industry and Energy".

<51> or <100> Deleted

Article 5 Deleted

ADDENDUM <No. 4597, December 10, 1993>

Article 1 Date of Entry into Force

This Act enters into force on January 1, 1994.

Article 2 Transitional Measures on Applications for Trademark Registration etc.

Any appeal against a ruling of refusal and the examination of an application for trademark registration, registration for renewal of the term of a trademark right or additional registration of designated goods made before this Act enters into force is subject to the previous provisions.

Article 3 Transitional Measures on Refunding Trademark Registration Fees etc.

The refund of trademark registration fees or other fees paid by mistake before this Act enters into force is subject to the previous provisions.

Article 4 Transitional Measures on Trials Related to a Registered Trademark etc.

Any trial, appeal, retrial or litigation on a trademark registered by an application for trademark registration, renewal of the term of a registered trademark or additional registration of the designated goods made before this Act enters into force is subject to the previous provisions.

ADDENDUM <No. 4895, January 5, 1995>

Article 1 Date of Entry into Force

This Act enters into force on March 1, 1998.

Article 2 Transitional Measures on Pending Cases

(1) Any case in which a request has been made before this Act enters into force for a trial or appeal against a ruling of refusal or against a decision to dismiss a correction is deemed to be continued with the Intellectual Property Tribunal under this Act and to be pending at the Intellectual Property Tribunal.

(2) Any case in which a request has been made before this Act enters into force for an appeal against the decision of a trial or for an immediate appeal against a decision to dismiss the request is deemed to be continued with the Patent Court under this Act and to be pending at the Patent Court.

Article 3 Transitional Measures on Cases etc. that May Be Appealed

(1) With regard to a case that a decision of a trial, a decision to dismiss a request for trial, a ruling of refusal or an examiner's decision to dismiss an amendment are transmitted when this Act enters into force and that an appeal has not been brought to the Patent Tribunal, within thirty days of the enforcement date of this Act, litigation under Article 186(1) of the Patent Act as applied *mutatis mutandis* under Article 86(2) may be brought against a decision of trial and decision to dismiss a request for trial and a trial under Article 70*bis* or 70*ter* may be requested against a ruling of refusal or an examiner's decision to dismiss an amendment. However, this provision does not be applied if the period for appeal has expired under the previous provisions when this Act enters into force.

(2) When this Act enters into force, an appeal against the decision of an appeal, the decision to dismiss a request for an appeal and the decision to dismiss a correction by the appellate trial examiner may be brought to the Supreme Court within thirty days of the enforcement date of this Act. However, this provision does not apply if the period for appeal has expired under the previous provisions when this Act enters into force.

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(3) A pending case against which an appeal has been brought to the Supreme Court before this Act enters into force and any case against which an appeal is made under paragraph (2) of this Article is deemed to have been pending or to have been brought to the Supreme Court.

Article 4 Transitional Measures on Retrials

Articles 2 and 3 of this addendum apply *mutatis mutandis* to a pending retrial.

Article 5 Transfer etc. of Documents

(1) The Commissioner of the Korean Intellectual Property Office shall immediately transfer the documents of a pending case referred to in Article 2(1) of this addendum (including those applied *mutatis mutandis* under Article 4 of this addendum) to the President of the Industrial Patent Tribunal.

(2) The Commissioner of the Korean Intellectual Property Office shall immediately transfer the documents of a pending case referred to in Article 2(2) of this addendum (including those applied *mutatis mutandis* under Article 4 of this addendum) to the President of the Intellectual Property Tribunal. In this case, matters necessary for the transfer and so on of documents are prescribed by Supreme Court regulations.

ADDENDUM <No. 5083, December 29, 1995>

This Act enters into force on January 1, 1996.

ADDENDUM (Patent Act) <No. 5329, April 10, 1997>

Article 1 Date of Entry into Force

This Act enters into force on July 1, 1997. (Proviso deleted.)

Articles 2 to 4 Deleted

Article 5 Amendment of Other Acts

(1) The following provisions of the Trademark Act are amended as follows:

Article 16(2) is amended as follows, and paragraph (3) of the same Article is added as follows:

(2) Where an amendment of an application for trademark registration or designated goods has been made before the transmittal of a certified copy of decision to publish on application and is recognized to have caused a material change after the establishment of a trademark right, the trademark application is deemed to have been filed at the time the written amendment is submitted.

(3) Where an amendment of an application for trademark registration or designated goods has been made after the transmittal of a certified copy of the decision to publish an application and is considered to have violated Article 15 after the establishment of a trademark right, the trademark application is deemed to have been established and registered on the trademark application that has not been amended.

Article 89(2) becomes paragraph (4) of the same Article, and paragraphs (2) and (3) of the same Article are added as follows:

(2) The Trademark Gazette may be published in electronic format under conditions determined by ordinance of the Ministry of Commerce, Industry and Energy.

(3) When publishing the Trademark Gazette in electronic media, the Commissioner of the Korean Intellectual Property Office shall publicize on a communication network matters regarding the Trademark Gazette's publication, main contents and service.

(2) Deleted

ADDENDUM <No. 5355, August 22, 1997>

Article 1 Date of Entry into Force

This Act enters into force on March 1, 1998.

Article 2 Transitional Measures on an Application for Trademark Registration etc.

The examination of an application for trademark registration, an application for renewal of the term of a registered trademark and an application for additional registration of designated goods and a trial against a ruling of refusal before this Act enters into force are subject to the previous provisions (excluding Article 73(1)(i)).

Article 3 Transitional Measures on Trials Related to a Registered Trademark etc.

Trials, retrials and litigation on trademarks registered by an application for trademark registration, an application for renewal of the term of a registered trademark and an application for additional registration of designated trademarks before this Act enters into force are subject to the previous provisions.

Article 4 Transitional Measures on a Associated Trademark

(1) An application for an associated trademark registration or for the trademark rights on an associated trademark filed before this Act enters into force is deemed an application for trademark registration or a trademark right under this Act.

(2) Where an invalidation or revocation trial based on the grounds of violating the previous provisions of Articles 11(1) or (3) or 54(2) is pending when this Act enters into force, the trial is subject to the previous provisions.

Article 5 Transitional Measures on the Revocation Trial of a Trademark Registration

Notwithstanding amended Article 73(4), a revocation trial requested under Article 73(1)(iii) within three years of the enforcement date of this Act is subject to the previous provisions.

Article 6 Transitional Measures on Three-Dimensional Trademarks

(1) Where a person who has submitted goods with a three-dimensional trademark at an exhibition under Article 21(1) files an application for registration of the three-dimensional trademark under amended Article 2 before this Act enters into force, the enforcement date of this Act is deemed to be the submission date of the exhibited goods.

(2) Where a person who has filed an application for registration of a three-dimensional trademark with one of the parties to the treaties under Article 20 files an application for registration of the three-dimensional trademark under amended Article 2 before this Act enters into force, the enforcement date of this Act is deemed to be the filing date of the application for trademark registration filed in one of the countries to the treaty.

ADDENDUM (Patent Act) <No. 5576, September 23, 1998>

Article 1 Date of Entry into Force

This Act enters into force on January 1, 1999. (Proviso deleted.)

Articles 2 to 4 Deleted

Article 5 Amendment of Other Acts

(1) Deleted

(2) The following provisions of the Trademark Act are amended as follows:
In Article 5, "Article 28 of this Act" reads "Article 28 and Article 28(5) of this Act".
In Article 92, "Article 218 of the Patent Act" reads "Article 217(2) of the Patent Act".

ADDENDUM <No. 6414, February 3, 2001>

Article 1 Date of Entry into Force

This Act enters into force on July 1, 2001. However, amended Article 38 enters into force on the date of its promulgation, and the provisions related to the international application in amended Article 5 and amended Articles 86*bis* to 86*duoquadragies* enter into the force on the date on which the Protocol becomes effective in the Republic of Korea.

Article 2 Application Examples on the Right to Demand Compensation for Loss

Amended Article 24*bis* is applied to an application for trademark registration or an application for additional registration of designated goods filed after July 1, 2001.

Article 3 Transitional Measures on Examining Applications for Trademark Registration etc.

The examination of an application for trademark registration, an application for renewal of the term of a registered trademark, an application for additional registration of designated goods and a trial against a ruling of refusal, a retrial and litigation initiated before this Act enters into force are subject to the previous provisions.

Article 4 Transitional Measures on Trials Related to a Registered Trademark etc.

A trial, retrial and litigation on a trademark registered by an application for trademark registration, an application for renewal of the term of a registered trademark or an application for additional registration of designated goods initiated before this Act enters into force are subject to the previous provisions. However, amended Article 3 of the addendum to the Trademark Act, amended by Act No. 5355, applies to a request for a trial, a trial, retrial and litigation to revoke a trademark registration under Article 73(1)(i) after July 1, 2001.

ADDENDUM (Civil Procedure Act) <No. 6626, January 26, 2002>

Article 1 Date of Entry into Force

This Act enters into force on July 1, 2002.

Articles 2 to 5 Deleted

Article 6 Amendment of Other Acts

(1) to (12) Deleted

(13) The following provisions of the Trademark Act are amended as follows:

In Articles 33 and 49(3), "Article 133, Article 271 of the Civil Procedure Act and Article 339 of this Act" reads "Article 143 and Article 299 of the Civil Procedure Act and Article 367 of this Act".

In Article 83(2), "Article 422 of the Civil Procedure Act and Article 424 of this Act" reads "Article 451 of the Civil Procedure Act and Article 453 of this Act".

In Article 86(1), "Article 429(1) of the Civil Procedure Act" reads "Article 459(1) of the Civil Procedure Act".

In Article 98(1)(1), "Article 271(2) of the Civil Procedure Act and Article 339 of this Act" reads "Article 299(2) of the Civil Procedure Act and Article 367 of this Act".

(14) and <29> Deleted

Article 7 Deleted

ADDENDUM <No. 6765, December 11, 2002>

This Act enters into force five months after its promulgation.

ADDENDUM (Design Protection Act) <No. 7289, December 31, 2004>

Article 1 Date of Entry into Force

This Act enters into force six months after its promulgation.

Articles 2 to 4 Deleted

Article 5 Amendment of Other Acts

(1) to (12) Deleted

(13) The following provisions of the Trademark Act are amended as follows:

In the title of Article 53, "design right" [uijang] reads "design right" [dijain], and in the main text of this Article, "design right" [uijang] reads "design right" [dijain], and "holder of a design right" [uijang] to "holder of a design right" [dijain].

In Article 57*bis*(6), "design right" [uijang] reads "design right" [dijain].

(14) to <16> Deleted

ADDENDUM <No. 7290, December 31, 2004>

This Act enters into force six months after its promulgation.

In Articles 53 and 57*bis*(6) of the Korean version of this Act, the Korean term for design “uijang” has been changed to “dijain” as a more widely acknowledged term.