



Trademark Act

Act No. 71, Promulgated on Nov. 28, 1949
As last amended by Act No. 5576, Sep. 23, 1998

TABLE OF CONTENTS

	<i>Article</i>
Chapter I:	General Provisions
	Purpose..... 1
	Definitions 2
	Persons Entitled to Register a Trademark 3
	Persons Entitled to Register a Business Emblem 4
	<i>Mutatis Mutandis</i> Application of Provisions of the Patent Act..... 5
Chapter II:	Requirements for Trademark Registration and Application Therefor
	Requirements for Trademark Registration 6
	Unregistrable Trademarks 7
	First-to-File Rule..... 8
	Application for Trademark Registration 9
	One Application for One Trademark..... 10
	[Without Title] 11
	Transfer and Partial Assignment of Application for Registration of a Trademark, etc. 12
	Amendment of Procedure 13
	Amendment Before Decision of Publication of Application..... 14
	Amendment After Decision of Publication of Application..... 15
	Material Change of Application..... 16
	Rejection of Amendment 17
	Division of Application for Trademark Registration.... 18
	Conversion of Application 19
	Priority Claim under Treaty 20
	Special Provisions as to Time of Filing an Application 21
Chapter III:	Examination
	Examination by Examiner..... 22
	Request, etc. for Inspection of Trademark by Specialized Searching Agency 22bis
	Ruling of Refusal and Notification of Reasons for Refusal 23
	Publication of Application 24
	Opposition to Trademark Registration 25
	Amendment of Reasons for Opposition to Trademark Registration 26
	Decision on Opposition to Trademark Registration 27
	Ruling of Refusal Made <i>Ex Officio</i> after Publication 28
	Concurrent Oppositions to Trademark Registration.... 29
	Ruling on Registration of Trademark..... 30
	Method of Decision..... 31
	Suspension of Examination or Litigation Proceedings.. 32
	<i>Mutatis Mutandis</i> Application of Provisions of the Patent Act..... 33



Chapter IV:	Trademark Registration Fees and Registration of Trademarks	
	Trademark Registration Fees	34
	Extension Payment Period for Trademark Registration Fees	35
	Abandonment of Application for Registration of Trademark as a Consequence of Nonpayment of Trademark Registration Fees	36
	Official Fees.....	37
	Refund of Trademark Registration Fees.....	38
	Trademark Register.....	39
	Issuance of Certificate of Registration of Trademark....	40
Chapter V:	Trademark Right	
	Registration of Establishment of Trademark Right.....	41
	Term of Trademark Right	42
	Application for Registration for the Renewal of Term..	43
	Division of Application for Registration for Renewal of Term of Trademark Right.....	44
	Ruling of Refusal of Application for Registration for Renewal of Term and Notification of Reasons for Refusal	45
	Effects of Application for Registration for Renewal of Term of a Trademark Right, etc.	46
	Application for Supplementary Registration of Designated Goods	47
	Ruling of Refusal of Application for Supplementary Registration of Designated Goods and Notification of Reasons for Refusal	48
	<i>Mutatis Mutandis</i> Application of Provisions of the Patent Act.....	49
	Effects of Trademark Right.....	50
	Limitations of Trademark Right.....	51
	Extent of Protection of Registered Trademark, etc.	52
	Relationship with Another Design Right, etc.....	53
	Assignment and Joint Ownership of Trademarks, etc... ..	54
	Division of Trademark Right	54bis
	Exclusive License	55
	Effects of Registration on Trademark Right and Exclusive License	56
	Non-exclusive License.....	57
	Effects of Registration of Non-exclusive License, etc. .	58
	Abandonment of Trademark Right.....	59
	Restriction on Abandonment of Trademark Right, etc..	60
	Effect of Abandonment	61
	Pledge	62
	Subrogation for Right of Pledge.....	63
	Extinguishment of Trademark Right.....	64
Chapter VI:	Protection of Owner of Trademark Right	
	Injunction, etc., Against Infringement.....	65
	Acts Deemed to be Infringement	66
	Presumption, etc., of Amount of Damage	67
	Presumption of Intent.....	68
	Measures for Recovery of Business Reputation of Owner of Trademark Right, etc.....	69
	Submission of Documents.....	70
Chapter VII:	Trial	
	Trial against Ruling of Refusal	70bis
	Trial against Decision of Rejection of Amendment	70ter
	Invalidation Trial of Trademark Registration.....	71



	Invalidation Trial of Registration for Renewal of Term of Trademark Right	72
	Trial for Cancellation of Trademark Registration	73
	Trial for Cancellation of Registration of Exclusive or Non-exclusive License	74
	Trial to Confirm Scope of Trademark Right	75
	Statute of Limitation	76
	<i>Mutatis Mutandis</i> Application of Provisions of the Patent Act.....	77
	[Without Title]	78
	Formal Requirements for Requesting a Trial against Examiner's Ruling of Refusal or the Decision of Rejection of Amendment	79
	[Without Title]	80
	<i>Mutatis Mutandis</i> Application of Provisions Concerning Examination in the Trial against the Ruling of Refusal	81
	Special Provisions of Trial against the Ruling of Refusal or the Decision of Rejection of Amendment....	82
Chapter VIII:	Retrial and Litigation	
	Request for Retrial	83
	Request for Retrial on Account of Collusion	84
	Restriction on Effects of Trademark Rights Restored by Retrial.....	85
	<i>Mutatis Mutandis</i> Application of Provisions of the Patent Act.....	86
Chapter IX:	Supplementary Provisions	
	Inspection of Documents, etc.	87
	Prohibition of Opening or Removal of Trademark Register and Documents Relating to the Application for Trademark, Registration Examination, Trial and Retrial	88
	Trademark Gazette.....	89
	Indication of Trademark Registration	90
	Prohibition of False Indication.....	91
	Special Provision on a Trademark etc. Similar to Registered Trademark	91
	<i>Mutatis Mutandis</i> Application of Provisions of the Patent Act.....	92
Chapter X:	Penal Provisions	
	Offense of Infringement.....	93
	Offense of Perjury	94
	Offense of False Marking.....	95
	Offense of Fraud	96
	Dual Liability	97
	Confiscation.....	97bis
	Administrative Fine.....	98
Addenda:		
	Enforcement Date	1
	[Without Title]	2 - 5

Chapter I General Provisions

Purpose

1. The purpose of this Act shall be 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.

Definitions

2.—(1) The definitions of terms used in this Act shall be as follows:

(i) “trademark” is defined as any of the following (hereinafter referred to as a “mark”) which is used on goods related to the business of a person who carries on business activities, such as producing, processing, certifying or selling such goods, for the purpose of distinguishing them from the goods of others;

(a) A sign, a character, a figure, a three-dimensional shape or any combination thereof;

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

(ii) “service mark” means a mark which is used by a person who carries on a service business for the purpose of distinguishing such business from those of others;

(iii) “collective mark” means a mark intended to be used with respect to the goods or services of members of a legal entity founded by and composed of persons who are in the same line of business and who are closely associated therein and who are controlled by the legal entity;

(iv) “business emblem” means a mark which is used by a person who carries on a nonprofit business for the purpose of indicating his business;

(v) “registered trademark” means a trademark for which a trademark registration has been granted;

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

(a) applying trademarks on goods or their packaging;

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

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



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

(3) Except as otherwise expressly provided for in this Act, the provisions in this Act relating to trademarks shall apply to service marks, collective marks and business emblems.

Persons Entitled to Register a Trademark

3. Any person who uses or intends to use his trademark in the Republic of Korea shall be entitled to trademark registration; however, employees of the Korean Industrial Property Office or employees of the Industrial Property Tribunal shall not be entitled to register trademarks during their employment at the Office except in the case of inheritance or bequest.

Persons Entitled to Register a Business Emblem

4. Any person who carries on a nonprofit business in the Republic of Korea shall be entitled to register a business emblem.

Mutatis Mutandis Application of Provisions of the Patent Act

5. Articles 3 to 26, Articles 28 to 28-5 of the Patent Act shall apply *mutatis mutandis* to trademarks.

Chapter II
Requirements for Trademark Registration and Application Therefor

Requirements for Trademark Registration

6.—(1) A trademark registration may be obtained except in 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 shape of 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 thereof 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;



(vii) in addition to the cases mentioned in subparagraph (i) to (vi), where the mark does not enable consumers to recognize whose goods it indicates in connection with a person's business.

(2) Even in the case of a trademark which falls under paragraph (1)(iii), (v) or (vi), where, as a result of the use of such trademark prior to the application for registration therefor under Article 9, consumers are able to conspicuously recognize whose goods it indicates in connection with a person's business, the trademark may be registered together with the designated goods (designated goods and supplementary designated goods as defined in Articles 10(1) and 47(2)(iii), the same provision being applicable hereinafter) for which the trademark has been used.

Unregistrable Trademarks

7.—(1) Notwithstanding Article 6, trademark registration may not be obtained in the following cases;

(i) trademarks which are identical with, or similar to: the national flag, the national emblem, colors, medals, decorations or badges of the Republic of Korea; the national flags or emblems of foreign nations; medals, decorations or badges of the countries party to the Paris Convention for the Protection of Industrial Property; the titles or marks of the Red Cross; Olympic or well-known international organizations; or those which are identical with, or similar to, seals or signs of the Republic of Korea or the countries party to the Paris Convention for the Protection of Industrial Property; or the public organizations thereof, used for indicating supervision or certification;

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

(iii) trademarks which are identical with, or similar to famous marks indicating a nonprofit business of a State; a public organization or agencies or public corporations thereof; or indicating nonprofit public services. However, this provision shall not apply where the State, public organization or agency or public corporation thereof, or the body of nonprofit public services, applies for the registration of such marks as their business emblems;

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

(v) trademarks comprising of a mark which 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; however, this provision shall not apply where a person who has been awarded a medal, certificate of merit or decoration has used it as a part of his trademark on the same goods for which such 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 thereof; however, this provision shall not apply where the consent of the person concerned has been obtained;

(vii) trademarks identical, or similar to another person's registered trademark whose registration was applied for prior to the filing date of the trademark applications concerned and which are to be used on goods identical, or similar to the designated goods;

(viii) trademarks identical, or similar to another person's trademark, where one year has not elapsed since the date of extinguishment of the trademark right (in the case of a trial decision invalidating a trademark registration, the date when the trial decision became final and conclusive, the same applying hereinafter in this subparagraph) and which are used on the designated goods covered by the trademark right or on similar goods;

(ix) trademarks which are identical, or similar to, another person's trademark which is well known among consumers as indicating the goods of that other person, or goods similar thereto, and which are used on goods that are identical, or similar to such goods;

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

(xi) trademarks which are liable to mislead or deceive the consumers as to the quality of the goods.

(xii) trademarks which are identical, or similar to a trademark which is recognized as indicating the goods of a particular person by customers in or outside of the Republic of Korea, and which are used for unjustful purposes of obtaining unjust profits or inflicting harms on a particular person, etc.

(xiii) trademarks consisting solely of three-dimensional shapes essential to secure the functions of goods requiring trademark registration or their packagings.

(xiv) trademarks consisting of geographical indications or including such indications with regard to the origin of wines or spirits in a member of the World Trade Organization, and which are used in connection with wines, spirits, or other similar goods.

(2) Even if a trademark falls under paragraphs (1)(vi), (ix) and (x) of this Article, the respective provisions shall not apply in the event the trademark does not fall under the respective subparagraphs at the time of application for the registration of a trademark.

(3) In the case of a trademark falling under paragraph (1)(vii) and (viii) of this Article, the respective provisions shall apply where the trademark falls under the respective subparagraphs at the time of application for registration of the trademark (this shall also apply when the registered trademark of another person is invalidated under Article 71 (3)), except where the owner of the trademark and the applicant for registration of the trademark (hereinafter referred to as the "applicant") are one and the same person after the filing of the application.



(4) The provision of paragraph (1)(viii) of this Article shall not be applicable to the following cases:

- (i) where the registered trademark has not been used for more than one year retroactively from the date the trademark right became null and void;
- (ii) where a rightful applicant makes an application for registration of the trademark, after a decision on invalidation or revocation becomes conclusive by reason that the registered trademark violates the provisions of paragraph (1)(vi), (ix), (x) and (?) or Articles 8 or 73(1)(vii); or
- (iii) where the period of six months as prescribed in the provisions of Article 43(2) expires and no application for registration for renewal of term of a trademark right has been made.

(5) Where a trial for the cancellation of a trademark registration is requested under Article 73 (1) (ii), (iii), (v) to (ix) and where any of the following subparagraphs occurs after the date for the trial for cancellation, a person having the trademark right and any person using the trademark shall not obtain a trademark registration for the trademark that is identical, or similar to the registered trademark that has been extinguished with respect to goods that are identical, or similar to the designated goods of the registered trademark that has been extinguished unless three years have elapsed since the day on which each of the following subparagraphs occurs:

- (i) where the trademark right has expired because of termination of the duration period;
- (ii) where a person having the trademark right abandons some of the trademark rights or designated goods; or
- (iii) where the trial decision on the cancellation of the registration of a trademark has become final and conclusive.

First-to-File Rule

8.—(1) Where two or more applications for trademark registration relating to identical or similar trademarks which 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 a trademark registration for the trademark.

(2) Where two or more applications for trademark registration relating to identical or similar trademarks which 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 one person agreed upon by all the applicants may obtain a 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 which shall be conducted by the Commissioner of the Korean Industrial Property Office.



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

(4) The Commissioner of the Korean Industrial Property Office shall, in the case provided for under paragraph (2) of this Article, order the applicants to notify him of any agreement they have reached, and to report the terms thereof. If such a report is not submitted within the designated period, the applicants shall be 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) and where each of the following subparagraphs occurs after the day on which the trial for cancellation is requested, only the person that the trial for cancellation may obtain a trademark registration for the trademark that is identical, or similar to the registered trademark that has been extinguished with respect to the goods that are identical, or similar to the designated goods of the registered trademark that has been extinguished for a period of three months as of the day on which each of the following subparagraphs occurs:

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

Application for Trademark Registration

9.—(1) Any person desiring to obtain a trademark registration shall file an application with the Commissioner of the Korean Industrial Property Office stating the following:

- (i) the name and domicile of the applicant for trademark registration (in the case of a legal entity, the title, place of business and the name of its representative);
- (ii) the name and domicile, or place of business, of the agent, if any;
- (iii) the trademark;
- (iv) the list of designated goods and the class of goods;
- (v) matters prescribed under Article 20(3) (only when claiming a priority right);
- (vi) the date of filing; and
- (vii) matters prescribed by the Ordinance of the Ministry of Commerce, Industry and Energy.

(2) Any person wishing to have a mark which is made up of three-dimensional shapes (including symbols, characters, designs, colors or any combination thereof) (hereinafter



referred to as “three-dimensional trademarks”) registered shall indicate the meaning of such mark on the application of registration.

(3) Any person desiring to obtain the registration of a collective mark shall file, in addition to the matters mentioned in the subparagraphs of paragraph (1) of this Article, an application for registration of the collective mark accompanied by the statutes of the association which govern the use of such collective mark, as prescribed by the Presidential Decree.

(4) Any person desiring to obtain the registration of a business emblem shall file, in addition to the matters mentioned in the subparagraphs of paragraph (1) of this Article, an application for registration of the business emblem accompanied by documents proving the existence of a business management.

One Application for One Trademark

10.—(1) Any person who intends to file an application for trademark registration, shall designate one category or more of goods with respect to the categories of goods as prescribed by the Ordinance of the Ministry of Commerce, Industry and Energy, and make an application for each trademark. In such cases, where an application seeks registration for both goods and services at the same time, such an intent must be stated in the application.

(2) The classes of goods referred to under paragraph (1) of this Article shall not be construed to limit the extent of similarity of the goods.

[Without Title]

11. Deleted.

Transfer and Partial Assignment of Application for Registration of a Trademark, etc.

12.—(1) Transfer of an application for trademark registration, except in the case of inheritance or other general succession, shall not be effective against third parties unless the applicant reports the change in name of the applicant.

(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 shall be transferred together.

(3) Deleted.

(4) In the case of inheritance or other general succession, the successor in title shall, without delay, notify the Commissioner of the Korean Industrial Property Office.

(5) Where an application for trademark registration is owned jointly, a joint owner may transfer his shares only with the consent of all the other joint owners.



(6) An application for trademark registration which is partially assigned pursuant to paragraph (2) of this Article shall be deemed to have been filed at the time of filing of the original application, except, however, where Article 20(3) and (4) or 21(2) is applicable.

(7) An application for the registration of a business emblem may not be transferred unless the entire business is transferred.

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

(9) An application for the registration of a collective mark may not be transferred. However, it may be transferred, with the authorization of the Commissioner of the Korean Industrial Property Office, in the case of mergers of legal entities.

Amendment of Procedure

13. The Commissioner of the Korean Industrial Property Office or the presiding trial examiner may order the amendment of an application, a request, or any other procedure within an adequate time limit in any of the following cases:

(i) When the requirements of Article 3(1) of the Trademark Act or Article 6 of the Patent Act, as applied under Article 5 of the Trademark Act, have not been complied with;

(ii) When the formal requirements specified in the Trademark Act or an Ordinance thereunder have not been complied with; or

(iii) When the fees required in accordance with Article 37 have not been paid.

Amendment Before Decision of Publication of Application

14.—(1) Excluding the cases specified in Article 15, an applicant may amend the trademark or the list of designated goods in the application for trademark registration provided that the intent and purpose of the original application is not changed.

(2) The amendment under paragraph (1) of this Article may not be made after the transmittal of a certified copy of the examiner's decision. However, in the case of a request for a trial against a ruling of refusal under Article 70*bis*, an amendment may be made within thirty days from the request, or within the period in which the written opinion is to be submitted under Article 23(2), 45(2) or 48(2) which is applicable under Article 81.

Amendment After Decision of Publication of Application

15. The applicant may, within the time limit under any of the following, amend or correct the designated goods and/or the specimen as long as the subject matter is not materially changed when a notice of rejection is served under Article 23, Paragraph 2 or Article 48, Paragraph 2 after the certified copy of the decision on publication of the application is delivered, when an opposition to the trademark registration is brought under



Article 25, or when an appeal under Article 70 Paragraph 2 is brought from the rejection under Article 23, Paragraph 1 or Article 48, Paragraph 1;

- (i) Time limit designated for submitting arguments under Article 23(2) or 48(2);
- (ii) Time limit designated for submitting a written answer under Article 27(1); or
- (iii) Thirty days from the date of the request for a trial against the ruling of refusal under Article 70*bis*.

Material Change of Application

16.—(1) An amendment made under Article 14 or 15, falling under any of the following provisions, shall be deemed not to cause a material change to the application for the registration of a trademark:

- (i) Reduction in the scope of the list of designated goods;
- (ii) Correction of errors;
- (iii) Classification of ambiguous descriptions;
- (iv) Deletion of any auxiliary part of the trademark.

(2) If 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 shall be deemed to have been filed at the time the written amendment thereof is submitted.

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

Rejection of Amendment

17.—(1) Where an amendment made under Article 14 causes a material change to an application, the examiner shall reject the amendment to the application for registration of a trademark in the form of a decision.

(2) The examiner shall not make a decision with respect to an application for the registration of a trademark, where a decision to reject an amendment has been rendered under paragraph (1) of this Article, until the expiration of thirty days from the date the certified copy of such decision has been transmitted. Where a decision to reject an amendment has been made under paragraph (1) of this Article, the examiner shall also not make a decision to publish the application subject to such amendment.

(3) Where an applicant requests a trial in accordance with 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 and conclusive.

(4) Where an amendment under Article 15 regarding an application for the registration of a trademark materially changes the application, the examiner shall reject the amendment in the form of decision.

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

(6) No appeal shall be allowed for a decision to reject an amendment under paragraph (4), except in the case where a trial against a ruling of refusal is requested under Article 70^{bis}.

Division of Application for Trademark Registration

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

(2) An application which has been divided under paragraph (1) of this Article (hereinafter referred to as the “divided application”) shall be deemed to have been filed at the time of filing of the original application, except when Articles 20(3), (4) or 21(2) are applicable.

Conversion of Application

19.—(1) An applicant may convert an application for the registration of a trademark into an application for the registration of a service mark and vice versa.

(2) If an application for trademark registration is converted under paragraph (1) of this Article (hereinafter referred to as a “converted application”), the converted application shall be considered as an application for trademark registration or a service trademark registration and shall be deemed to have been filed at the time of the initial application.

(3) The converted application as referred to in paragraph (2) of this Article may not be made after a ruling or trial decision on the initial application for trademark registration or service trademark registration has become final and conclusive.

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

(5) No conversion may be made for applications for the registration of trademarks, collective marks or business marks.



Priority Claim under Treaty

20.—(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 (hereinafter referred to as a “treaty”) claims a right of priority for the application for trademark registration in the Republic of Korea on the basis of the prior application for such trademark registration filed in his country or in one of the countries recognized in the treaty, the filing date of the prior application in the foreign country shall be deemed to be the filing date in the Republic of Korea for the purposes of Article 8. Where a national of the Republic of Korea has filed an application for trademark registration in a country which 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 on the basis of the prior application for such trademark registration filed in the said country, this provision shall also apply.

(2) A person intending to claim the right of priority in accordance with paragraph (1) of this Article shall file the application within six months from the filing date of the prior application which is the basis of such right of priority.

(3) A person intending to claim the right of priority in accordance with paragraph (1) of this Article shall specify the nature, name of the country, trademark and the filing date of the prior application on the application for trademark registration at the time of filing the application.

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

(5) Where a person claiming the right of priority in accordance with paragraph (3) of this Article fails to submit the certified copy within the time limit prescribed under paragraph (4) of this Article, the claim to the right of priority shall be forfeited.

Special Provisions as to Time of Filing an Application

21.—(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 one of the following types of exhibitions within six months from the date of such exhibition, the application shall be deemed to have been filed at the time when such goods were exhibited.

(i) exhibitions held by the Government or a local government;

(ii) exhibitions held by persons authorized by the Government or a local government;

- (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 the said country or by persons authorized by the said government.

(2) Any person desiring to take advantage of paragraph (1) of this Article with respect to a trademark in an application for trademark registration shall submit a written statement to that effect in conjunction with his application for trademark registration to the Commissioner of the Korean Industrial Property Office, to whom such person shall also submit, within thirty days from the filing date of the application, a document proving the relevant facts.

Chapter III Examination

Examination by Examiner

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

(2) The qualifications for examiners shall be prescribed by the 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 Industrial Property Office relevant information together with supporting evidence.

Request, etc. for Inspection of Trademark by Specialized Searching Agency

22bis.—(1) The Commissioner of the Korean Industrial Property Office may request a specialized searching agency to inspect trademarks where it is deemed necessary to facilitate the examination for an application of trademark registration.

(2) The Commissioner of the Korean Industrial Property Office may request assistance or hear from the competent administrative agency, a person with vast knowledge and experience in trademarks, or interested persons, where it is deemed necessary for the examination of an application for trademark registration.

(3) Criteria for the specialized searching agency and requests for the search of trademarks pursuant to paragraph (1) of this Article shall be prescribed by the Presidential Decree.

Ruling of Refusal and Notification of Reasons for Refusal

23.—(1) The examiner shall make a ruling to refuse an application for trademark registration where it falls under any of the following subparagraphs:



(i) the trademark for which registration is sought is not registrable in accordance with the provisions of Article 3, 6 to 8, 10(1), 12(2) (second sentence), (5) and (7) to (9) of Trademark Act or 25 of the Patent Act as applied under Article 5 of the Trademark Act;

(ii) the trademark for which registration is sought is in violation of the provisions of a treaty;

(iii) the trademark is identical, or similar to a trademark registered in the territory of a country which 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 one year prior to the date of filing, without such owner's authorization, for designated goods which are identical, or similar to the designated goods covered by the owner's trade-mark; however, this provision shall apply only where an opposition has been filed by the owner.

(2) An examiner shall, when intending to make a ruling of refusal of an application for trademark registration under paragraph (1) of this Article, notify the applicant of the reasons for refusal and give the applicant an opportunity to submit a written statement of applicant's arguments, designating a time limit for such submission.

Publication of Application

24.—(1) Where an examiner finds no grounds for rejecting an application for trademark registration, he shall render a decision to publish the application.

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

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

Opposition to Trademark Registration

25.—(1) When an application is published, any person may raise an opposition to a trademark registration which falls within each subparagraph of Article 23(1) with the Commissioner of the Korean Industrial Property Office within thirty days from the date of publication of the application.

(2) If any person intends to make an opposition to a trademark registration, such person shall submit to the Commissioner of the Korean Industrial Property Office a written opposition specifying matters falling under each of the following subparagraphs, together with the supporting evidence:

(i) the name and the domicile of the applicant for the opposition to a trademark registration or the agent of such person (in the case of a legal entity, the title, place of business and the name of its representative);



- (ii) serial number of the application for the trademark registration;
- (iii) relevant category of goods and designated goods;
- (iv) grounds of the application for the opposition to a trademark registration; and
- (v) reasons for the application for the opposition to a trademark registration and indication of supporting evidences.

Amendment of Reasons for Opposition to Trademark Registration

26. A person who has filed a notice of opposition to a trademark registration under Article 25(1) (hereinafter referred to as the “opponent”) may amend the reasons and evidence submitted in the notice of opposition to the trademark registration within thirty days from the expiration of the time limit for filing the notice of opposition.

Decision on Opposition to Trademark Registration

27.—(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 the designated time limit.

(2) After the expiration of the time limits prescribed in paragraph (1) of this Article and Article 26, the examiner shall render a decision on the opposition to the trademark registration.

(3) Where an opponent fails to submit reasons and evidence, the examiner may reject the opposition to the trademark registration by decision after the expiration of the time limit under Article 26, notwithstanding paragraph (1) of this Article.

(4) The decision on the opposition to a trademark registration shall be made in writing and state the reasons therefor.

(5) The Commissioner of the Korean Industrial Property Office shall, when a decision has been rendered under paragraph (2) of this Article, transmit a certified copy of the decision to the applicant and the Opponent.

(6) No appeal shall be made against the decision on the opposition to a trademark registration.

(7) In applying paragraph (4) of this Article, where there are different reasons 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.

Ruling of Refusal Made Ex Officio after Publication

28.—(1) Where an examiner finds reasons for refusal after the publication of an application, he may make a ruling of refusal *ex officio* under Article 23.



(2) Where an examiner makes a ruling to refuse an application under paragraph (1) of this Article, he shall not render a decision on the opposition to the registration of a trademark even if the opposition has been filed in accordance with Article 25.

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

Concurrent Oppositions to Trademark Registration

29.—(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 deemed to be justified upon examination, the examiner need not render a ruling as to the other opposition(s).

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

Ruling on Registration of Trademark

30. Where the examiner cannot find any reasons for refusing an application for the registration of a trademark, the examiner shall render a ruling in favor of trademark registration.

Method of Decision

31.—(1) The ruling on the registration of a trademark shall be made in writing and shall state the reasons therefor.

(2) Where an examiner has made a ruling on the registration of a trademark, the Commissioner of the Korean Industrial Property Office shall transmit a certified copy of the ruling to the applicant.

Suspension of Examination or Litigation Proceedings

32.—(1) The examination procedure of an application for the registration of a trademark may, if necessary, be suspended until a trial decision has become final and conclusive or litigation proceedings have been concluded.

(2) The court may, if necessary in the litigation, suspend proceedings until the examiner's decision has become final and conclusive.

*Mutatis Mutandis Application of Provisions of the Patent Act*

33. Articles 148(1) - (5), (7) and 157 of the Patent Act and Articles 133, 271 and 339 of the Code of Civil Procedure shall apply *mutatis mutandis* to the examination of applications for the registration of trademarks.

Chapter IV

Trademark Registration Fees and Registration of Trademarks

Trademark Registration Fees

34.—(1) A person desiring to obtain registration of a trademark right, supplementary registration of designated goods or registration for the renewal of term of a trademark right 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 payment of trademark registration fees under paragraph (1) of this Article, including the procedure and time limits for payment, shall be prescribed by the Ordinance of the Ministry of Commerce, Industry and Energy.

Extension Payment Period for Trademark Registration Fees

35. The Commissioner of the Korean Industrial Property Office may, upon request, extend the period for the payment of trademark registration fees under Article 34(3) for a period not exceeding thirty days.

*Abandonment of Application for Registration of Trademark as a
Consequence of Nonpayment of Trademark Registration Fees*

36. If the trademark registration fees are not paid within the periods provided for in Articles 34(3) or 35, the applications for registration of a trademark, supplementary registration of designated goods or registration for the renewal of term of a trademark shall be deemed to have been abandoned.

Official Fees

37.—(1) A person filing an application, making a demand or initiating other procedures with regard to a trademark shall pay official fees. However, in the event a request is made for an invalidation trial by an examiner in accordance with Article 71(1) or 72(1), such fees shall not be applicable.



(2) Matters related to the payment of official fees under paragraph (i) of this Article, including the procedure and time limits for payment of the fees, shall be prescribed by the Ordinance of the Ministry of Commerce, Industry and Energy.

(3) A person who makes an application for renewal of term registration of a trademark right within the period of time as prescribed in Article 43(2) shall pay the amount as determined by the Ordinance of the Ministry of Commerce, Industry and Energy in addition to the fee referred to in paragraph (2) of this Article.

Refund of Trademark Registration Fees

38. Trademark registration fees and official fees which have been paid shall not be refunded. However, where payment of fees have been made by mistake, the mistaken portion of the fees shall be refunded without delay upon request by the person who made such payment, where such request is made within one year from the date of the payment.

Trademark Register

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

(i) the establishment, transfer, modification, expiration, renewal of the term, supplementary registration of designated goods or restriction on disposal, of a trademark right;

(ii) the establishment, maintenance, transfer, modification, expiration, or restriction on disposal of an exclusive or non-exclusive license; and

(iii) the establishment, transfer, modification, expiration, and restriction on disposal of a pledge on a trademark right in relation to an exclusive or non-exclusive license.

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

(3) Necessary matters relating to registration and registration procedures of trademarks not provided for in paragraphs (1) and (2) of this Article shall be prescribed by the Presidential Decree.

Issuance of Certificate of Registration of Trademark

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

(2) Where the certificate of registration of a trademark does not correspond with the Trademark Register, the Commissioner of the Korean Industrial Property Office shall make a

correction on the certificate and reissue the certificate with amendments or issue a new certificate upon request by the applicant or *ex officio*.

Chapter V Trademark Right

Registration of Establishment of Trademark Right

41.—(1) A trademark right shall come into effect upon registration of its establishment.

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

Term of Trademark Right

42.—(1) The term of a trademark right shall be 10 years from the date of registration of its establishment.

(2) The term of a trademark right may be renewed for an additional 10 years upon making an application for the registration for the renewal of its term.

Application for Registration for the Renewal of Term

43.—(1) Any person desiring registration for the renewal of the term of a trademark right under Article 42(2) shall submit an application to the Commissioner of the Korean Industrial Property Office, including the following:

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

(2) The application for registration for the renewal of term of a trademark right shall be filed within one year prior to the date of expiration of the term of the trademark right. However, a person who fails to apply for registration for the renewal of term of a trademark right within this period, may do so within six months after the expiration date of the trademark right.

(3) Where a trademark right is owned jointly, all joint owners shall jointly file an application for registration for the renewal of the term.

(4) In addition to the provisions of paragraphs (1)-(3) of this Article, all other necessary matters required to file applications for registration for the renewal of term of a trademark right shall be prescribed by the Ordinance of the Ministry of Commerce, Industry and Energy.



*Division of Application for Registration for Renewal of
Term of Trademark Right*

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

(2) Where, in an application for registration for renewal of term of a trademark right under Article 43(1), the applicant designates two or more goods, he may divide the application into two or more applications within the period of time allowed for amendment as provided for in Article 14.

(3) A divisional application for registration for renewal of term under paragraph (2) under this Article shall be deemed to have been filed at the time of filing of the original application for registration for renewal of term.

*Ruling of Refusal of Application for Registration for Renewal of
Term and Notification of Reasons for Refusal*

45.—(1) The examiner shall make a ruling of refusal for an application for registration for renewal of term of a trademark right where it falls under any one of the following subparagraphs:

- (i) deleted;
- (ii) the applicant is not the owner of the trademark right concerned;
- (iii) the application is in violation of Article 43(2);
- (iv) deleted;
- (v) deleted;

(vi) where the designated goods for which the application for renewal registration of the term of the trademark right is not the designated goods of such registered trademark, or where the designated goods are not in conformity with the categories of goods as determined by the Ordinance of the Ministry of Commerce, Industry and Energy.

(2) Where the examiner intends to render a ruling of refusal for an application for renewal of term of a trademark registration under paragraph (1) of this Article, the examiner shall notify the applicant of the reasons for the refusal and give the applicant an opportunity to submit Applicant's arguments in writing within the designated time limit.

*Effects of Application for Registration for Renewal of Term of a
Trademark Right, etc.*

46.—(1) Where an application for registration for renewal of term of a trademark right has been filed within the period provided for in Article 43(2), the term of the trademark right



shall be deemed to have been renewed, except where a ruling of refusal thereof has become final and conclusive.

(2) The registration for renewal of term of a trademark right shall commence on the day following the date of expiration of the original registration.

Application for Supplementary Registration of Designated Goods

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

(2) A person intending to obtain 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 Industrial Property Office including the following:

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

Ruling of Refusal of Application for Supplementary Registration of Designated Goods and Notification of Reasons for Refusal

48.—(1) Where an application for supplementary registration of designated goods falls under any of the following subparagraphs, the examiner shall render a ruling of refusal thereof:

- (i) the application falls under any one of the subparagraphs 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 with the trademark registered or the trademark for which an application for registration has been filed; or
- (iv) the right under the registered trademark has expired or the application for registration of a trademark has been withdrawn, abandoned or invalidated, or a ruling of refusal of the application has become final and conclusive.

(2) If the examiner intends to render a ruling of refusal for an application for supplementary registration of designated goods under paragraph (1) of this Article, the



examiner shall notify the applicant of the reasons for the refusal and give the applicant an opportunity to submit Applicant's arguments in writing within the designated time limit.

Mutatis Mutandis Application of Provisions of the Patent Act

49.—(1) Articles 10(1), 13, 14, 16, 17, 22 and 30 to 32 of the Trademark Act and Article 148(i) - (v), (vii) of the Patent Act shall apply *mutatis mutandis* to applications for registration of renewal of term of a trademark right.

(2) Articles 10(1), 13 - 17, 20 - 22 and 24 - 32 of the Trademark Act, Articles 148(1) (i) - (v), (vii) and 157 of the Patent Act and Articles 133, 271 and 339 of the Code of Civil Procedure shall apply *mutatis mutandis* to applications for supplementary registration of designated goods.

Effects of Trademark Right

50. The owner of a trademark right shall have the exclusive right to use the registered trademark with respect to the designated goods. However, in accordance with Article 55(3), where the trademark right is the subject of an exclusive license, this provision shall not apply to the extent in which the licensee has the exclusive right to use the registered trademark.

Limitations of Trademark Right

51. The effects of the trademark right shall not extend to the following:

(i) trademarks indicating, 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 thereof; however, this provision shall not apply where, after registration of the establishment of the trademark right, such mark has been used with the intention of violating the rules of fair competition;

(ii) trademarks indicating, 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 goods similar thereto, or the method or time of manufacturing, processing or use of such goods; and

(iii) trademarks customarily used on the designated goods or goods similar thereto, and marks consisting of famous geographical appellation or their abbreviations or of a map.

(iv) trademarks consisting solely of three-dimensional shapes essential to secure the functions of goods requiring trademark registration or their packaging.

Extent of Protection of Registered Trademark, etc.

52.—(1) The extent of protection conferred by a registered trademark shall be determined on the basis of the trademark reproduced in the documents accompanying the application for registration of a trademark.



(2) The extent of protection conferred to the designated goods shall be determined on the basis of the goods listed in the documents accompanying the application for registration of a trademark.

Relationship with Another Design Right, etc.

53. When the use of a registered trademark on the designated goods conflicts with another person's patent right, utility model right and/or design right which have been applied for prior to the date of such application for the registration of the trademark, or with another person's copyright which has been in effect prior to that date, the owner of the trademark right, or the exclusive or nonexclusive licensee, shall not use the registered trademark on the portion of the designated goods giving rise to the conflict without a license from the owner of the earlier patent right, utility model right, design right or copyright.

Assignment and Joint Ownership of Trademarks, etc.

54.—(1) A trademark right may be assigned separately for each of the designated goods. In such case, rights with respect to similar designated goods shall be assigned together with the assignment of the trademark.

(2) to (4) Deleted.

(5) A joint owner of a trademark right may neither assign his share nor establish a pledge upon it without the consent of all the other joint owners.

(6) A joint owner may grant neither an exclusive nor a nonexclusive license of the trademark right without the consent of all the other joint owners.

(7) A business emblem right under Article 2(1)(iv) may not be assigned; however, this provision shall not apply where the business emblem is assigned together with the business.

(8) A trademark right registered under the provisions of Article 7(1)(iii) may not be assigned; however, this provision shall not apply where it is assigned together with the business relating to the mark as referred to in the principal sentence of Article 7(1)(iii).

(9) A collective mark right may not be transferred; however, in the case of a merger of a legal entity, the collective mark may be assigned with the authorization of the Commissioner of the Korean Industrial Property Office.

(10) No pledge right shall be established in connection with the business emblem right or the trademark right and the collective mark right under the provisions of Article 7(1) (iii).

Division of Trademark Right

54bis.—(1) Where there are two or more designated goods under one trademark right, the trademark right may be divided for each of such 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 and conclusive even if the trademark right expires.

Exclusive License

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

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

(3) An exclusive licensee who has been granted an exclusive license under paragraph (1) of this Article, shall have the exclusive right to use the registered trademark on the designated goods to the extent provided for in the license agreement.

(4) An exclusive licensee shall indicate his own name or title on the 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) shall apply *mutatis mutandis* to exclusive licenses.

Effects of Registration on Trademark Right and Exclusive License

56.—(1) The following shall have no effect unless they are registered:

(i) the transfer (except in the case of inheritance or other general succession), modification, extinguishment by abandonment, renewal of term of a trademark right, supplement to designated goods or restriction on the disposal thereof;

(ii) the grant, transfer (except in the case of inheritance or other general succession), modification or extinguishment by abandonment of an exclusive license, or restriction on the disposal thereof; or

(iii) the establishment, transfer (except in the case of 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 thereof.

(2) Inheritance of, or other general succession relating to a trademark right, exclusive license and/or pledge under paragraph (1) of this Article shall be notified without delay to the Commissioner of the Korean Industrial Property Office.



Non-exclusive License

57.—(1) The owner of a trademark right may grant to others a non-exclusive license on his trademark right.

(2) A non-exclusive licensee who has been granted a non-exclusive license under paragraph (1) of this Article shall have the right to use the registered trademark on the designated goods to the extent provided for in the license agreement.

(3) A non-exclusive license may not, except in the case of inheritance or other general succession, be transferred without the consent of the owner of the trademark right (or the owner of the trademark right and the exclusive licensee in the case of a non-exclusive license on an exclusive license).

(4) A pledge may not be established on a non-exclusive license without the consent of the owner of the trademark right (or the owner of the trademark right and the exclusive licensee in the case of a non-exclusive license on an exclusive license).

(5) Articles 54(5) and 55(2) and (4) shall apply *mutatis mutandis* to non-exclusive licenses.

Effects of Registration of Non-exclusive License, etc.

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

(i) the grant, transfer (except in the case of inheritance or other general succession), modification, extinguishment by abandonment of a non-exclusive license, or restriction on the disposal thereof;

(ii) the establishment, transfer (except in the case of inheritance or other general succession), modification, extinguishment by abandonment of a pledge on a non-exclusive license, or restriction on the disposal thereof.

(2) Where a non-exclusive license has been registered, it shall also be effective against any person who subsequently acquires the trademark right or an exclusive license.

(3) Inheritance, or other general succession relating to a non-exclusive license or a pledge under paragraph (1) of this Article shall be notified without delay to the Commissioner of the Korean Industrial Property Office.

Abandonment of Trademark Right

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

Restriction on Abandonment of Trademark Right, etc.

60.—(1) The owner of a trademark right cannot abandon his trademark right without the consent of the exclusive or non-exclusive licensee(s) or pledgee(s).

(2) An exclusive licensee cannot abandon his exclusive license without the consent of the pledgee(s) or non-exclusive licensee(s) under Article 55(6).

(3) A non-exclusive licensee cannot abandon his non-exclusive license without the consent of the pledgee(s) under Article 57(4).

Effect of Abandonment

61. Where a trademark right, an exclusive or non-exclusive license, or a pledge has been abandoned, the trademark right, exclusive or non-exclusive license or pledge shall be extinguished as of the time of abandonment.

Pledge

62. Where a pledge has been established for the purposes of a trademark right or an exclusive or non-exclusive license, the pledgee may not use the registered trademark.

Subrogation for Right of Pledge

63. A pledge may be exercised in relation to the remuneration provided for under this Act or goods to be received for the use of the trademark right; however, an attachment order shall be obtained prior to the payment of the remuneration or the delivery of the goods.

Extinguishment of Trademark Right

64. Where an application for the transfer of the registration of a trademark right is not filed by a successor in title within three years following the death of the original owner of the trademark right, such trademark right shall be extinguished as of the date following the expiration of three years from the date of the death of the original owner of such trademark right.

Chapter VI
Protection of Owner of Trademark Right

Injunction, etc., Against Infringement

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

Acts Deemed to be Infringement

66. The following acts shall be deemed to be infringements on a trademark right or an exclusive license:

(i) acts of using a trademark identical to the registered trademark of another person on goods identical, or similar to the designated goods, or using a trademark similar to the registered trademark of another person on goods identical, or similar to the designated goods;

(ii) acts of delivering, selling, counterfeiting, imitating or possessing a trademark identical, similar to the registered trademark of another person for the purposes of using or causing a third party to use such trademark on goods identical, or similar to the designated goods;

(iii) acts of manufacturing, delivering, selling or possessing instruments for the purposes of counterfeiting or imitating a registered trademark of another person or causing a third party to counterfeit or imitate such trademark.

(iv) acts of possessing goods to assign or deliver, which are identical, or similar to the designated goods on which a trademark identical, or similar to the registered trademark of another person is indicated.

Presumption, etc., of Amount of Damage

67.—(1) Where the owner of a trademark right or an exclusive licensee claims compensation from a person who has intentionally or negligently infringed on the trademark right or the exclusive license due to damages caused to him by such infringement, the profits gained by the infringer by the infringement shall be presumed to be the amount of damage suffered by the owner of the trademark right or exclusive licensee.

(2) 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 to him by the infringement, the amount of money which he would normally be entitled to receive for the use of the registered trademark may be claimed as the amount of damages suffered by him.

(3) Notwithstanding paragraph (2) of this Article, where the amount is in excess of the amount referred to therein, the amount in excess may also be claimed as compensation for damage. In such case, the court may take into consideration whether there has been either willfulness or gross negligence on the part of the person who has infringed the trademark right or the exclusive license when awarding damages.

*Presumption of Intent*

68. 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, shall be presumed to have known that such a trademark was registered.

Measures for Recovery of Business Reputation of Owner of Trademark Right, etc.

69. Upon request of the owner of a trademark right or an exclusive licensee, the court may, in lieu of damages or in addition thereto, order the 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 said owner or exclusive licensee.

Submission of Documents

70. In litigation relating 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. However, this provision shall not apply where the person possessing the documents has justifiable reason for refusing to submit them.

**Chapter VII
Trial***Trial against Ruling of Refusal*

70bis. Any person dissatisfied with a ruling of refusal may make a request for trial within thirty days from the date of receipt of a certified copy of the ruling of refusal.

Trial against Decision of Rejection of Amendment

70ter. Any person dissatisfied with a decision of rejection of amendment under Article 17(1) may request a trial within thirty days from the date of receipt of a certified copy of the decision.

Invalidation Trial of Trademark Registration

71.—(1) In the following cases, an interested person or an examiner may demand a trial to invalidate the registration of a 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 the provisions of Article 3, Articles 6 - 8, or 12(2) (second sentence), (5), and (7) - (9) of the Trademark Act or in breach of Article 25 of the Patent Act which is made applicable under Article 5 of the Trademark Act;

(ii) the registration has been effected in violation of 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 such right under Article 25 of the Patent Act which is made applicable under Article 5 of the Trademark Act, or the registration no longer complies with a treaty.

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

(3) Where a trial decision invalidating a trademark registration has become final and conclusive, the trademark right shall be deemed never to have existed; however, where a trial decision invalidating a trademark right has become final and conclusive under paragraph (1)(iv) of this Article, the trademark right shall be deemed not to have existed from the time when the trademark registration is made applicable under the said paragraph.

(4) 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 relating to the trademark, regarding the subject of the request.

Invalidation Trial of Registration for Renewal of Term of Trademark Right

72.—(1) In the following cases, an interested person or an examiner may request a trial to invalidate the registration for the renewal of term of a trademark right. In such a case, 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 has been effected contrary to 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 registration for the renewal of term of a trademark right has become final and conclusive, the registration for the renewal of term shall be deemed never to have existed.

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

Trial for Cancellation of Trademark Registration

73.—(1) A trial may be requested for cancellation of a registration of a trademark if the registered trademark falls under any one of the following subparagraphs:

(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 thereto, on goods similar to the designated goods in a manner which may be misleading as to the quality of the goods or which is liable to cause confusion with regards to the goods another person.

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

(iv) it is contrary to Article 54(1) (second sentence), (5), (7) - (9);

(v) a member of an association allows a third party to use its collective mark in violation of the provisions of the statutes of the association;

(vi) when a concern exists that a collective mark will mislead consumers as to the quality of goods, or cause confusion among consumers with respect to the goods of another person's business due to a change of the statutes of the association under Article 9(3);

(vii) a trademark falling under Article 23(1)(iii) has been registered and the owner of the original trademark requests a trial for cancellation within five years from the date of registration of such trademark; or

(viii) the exclusive or non-exclusive licensee uses the registered trademark, or a similar trademark, on the designated goods or goods similar thereto, in a manner that is liable to mislead consumers as to the quality of the goods or to cause confusion among consumers with respect to the goods of another person's business; however, this provision shall not apply in the event the owner of the trademark right has taken reasonable care.

(ix) similar trademarks belong to different persons having a trademark right due to assignments of a trademark right, and one of them misleads consumers as to the quality of goods or causes consumer confusion with respect to goods of another person by using his own registered trademark upon goods identical, or similar to the designated goods of his own registered trademark for the purposes of practicing unfair competition.

(2) Deleted.

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

(4) Where a trial for cancellation is requested for reasons referred to under paragraph (1)(iii) of this Article the owner of the trademark right shall 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 three years prior to the date of the request for trial on one or more of the designated goods in connection with the request; however, this provision shall not apply where the defendant can provide a justifiable reason for the failure to use the registered trademark.

(5) The reasons for cancellation referred to in paragraph (1) (ii), (iii), (v), (vi), (viii), or (ix) shall not be affected even when the facts giving rise to the request for a cancellation trial no longer exist after the request for trial is made.

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

(7) Where a trial decision ordering the cancellation of a trademark registration has become final and conclusive, the trademark right shall become extinguished from that date.

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

Trial for Cancellation of Registration of Exclusive or Non-exclusive License

74.—(1) Where the exclusive or non-exclusive licensee performs an act referred to under Article 73(1)(viii), a trial for cancellation of the registration of the exclusive or non-exclusive license may be requested.

(2) The reasons for cancellation shall not be affected even when the facts giving rise to the request for a cancellation trial no longer exist after the request for trial for cancellation of the registration of an exclusive or non-exclusive license is made under paragraph (1) of this Article.

(3) Any person may request a trial for cancellation of an exclusive or non-exclusive license under paragraph (1) of this Article.

(4) Where a trial decision ordering the cancellation of the registration of an exclusive or non-exclusive license has become final and conclusive, the exclusive or non-exclusive license shall become extinguished from that date.

(5) Where a trial under paragraph (1) of this Article has been requested, the presiding trial examiner shall notify the non-exclusive licensee and other persons who have any registered rights relating to the trademark right and the persons who have any registered right with respect to the exclusive or non-exclusive license of the demand.

Trial to Confirm Scope of Trademark Right

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

Statute of Limitation

76.—(1) A trial for invalidation of a trademark registration and the registration for the renewal of term of a trademark right under Articles 7(1)(vi) to (ix), and (xiv), 8, and 72(1)(ii) shall not be requested after five years from the date of registration of the trademark or from the date of registration for the renewal of term of the trademark right.

(2) A trial for cancellation of a trademark registration and of the registration of an exclusive or non-exclusive license under Articles 73 (1) (ii), (v), (vi), (viii) and (ix) and 74(1) shall not be requested after three years from the date on which the alleged facts have ceased to exist.

Mutatis Mutandis Application of Provisions of the Patent Act

77. Articles 139, 140 and 141 to 166 of the Patent Act shall apply *mutatis mutandis* to a trial.

78. Deleted.

Formal Requirements for Requesting a Trial against Examiner's Ruling of Refusal or the Decision of Rejection of Amendment

79.—(1) A person who requests a trial against an examiner's ruling of refusal under Article 70*bis* or a trial against the decision of rejection of amendment under Article 70*ter* shall submit his request in writing to the President of the Industrial Property Tribunal stating the following:

- (i) the name and domicile of the applicant and agent (in the case of a legal entity, the title, the place of business and the name of its representative);
- (ii) the number and date of the application which is the subject of the rejection;
- (iii) the designated goods and the classes of the goods;
- (iv) the date of the examination or decision by the examiner;
- (v) the identification number of the trial case;
- (vi) the purpose and reasons for the request; and
- (vii) the date of submission of the request.

(2) Where a trial against an examiner's ruling of refusal has been requested under Article 70*bis*, the President of the Industrial Property Tribunal shall notify the opponent of the

request for the trial if the ruling of refusal was rendered on the basis of an opposition to the trademark registration.

80. Deleted.

*Mutatis Mutandis Application of Provisions Concerning Examination
in the Trial against the Ruling of Refusal*

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

(2) In the case of Article 17 being applied under paragraph (1) of this Article, “where an applicant has requested a trial against the decision of rejection of amendment under Article 70ter” in Article 17(3) shall mean “where a Act suit is brought under Article 186(1) of the Patent Act as applied under Article 86(2) of the Trademark Act”; and “until the trial decision of the trial has become final and conclusive” shall mean “until the judgement has become final and conclusive”.

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

*Special Provisions of Trial against the Ruling of Refusal or the
Decision of Rejection of Amendment*

82.—(1) Articles 172 and 176 of the Patent Act shall apply *mutatis mutandis* to the trial on the ruling of refusal and the decision of rejection of amendment.

(2) Articles 147 (1) and (2), 155 and 156 of the Patent Act which are applicable *mutatis mutandis* under Article 77 shall not apply to the trial against the ruling of refusal as referred to in Article 70bis and the decision of rejection of amendment as referred to in Article 70ter.

**Chapter VIII
Retrial and Litigation**

Request for Retrial

83.—(1) Any party may request a retrial against a trial decision which has become final and conclusive.

(2) Articles 422 and 424 of the Code of Civil Procedure shall apply *mutatis mutandis* to the request for a retrial under paragraph (1) of this Article.

Request for Retrial on Account of Collusion

84.—(1) Where the parties to a trial acted in collusion to cause a trial ruling to be rendered for the purpose of injuring the rights or interests of a third person, such third person may request a retrial against the trial ruling which has become final and conclusive.

(2) In such a retrial, the parties to the initial trial shall be made joint defendants.

Restriction on Effects of Trademark Rights Restored by Retrial

85. The effects of a trademark right shall not extend to the good-faith use of a trademark identical with the registered trademark on goods identical with the designated goods and the acts referred to in Article 66(i) to (iv), after the decision concerned became final and conclusive but before the request for retrial has been registered, where:

(i) the trademark registration or the registration for renewal of term of the trademark right which was invalidated has been restored by a retrial;

(ii) the trademark registration that had been cancelled has been restored by a retrial; or

(iii) after a trial decision that a product was outside the scope of the trademark right became final and conclusive, a decision to the contrary has been rendered at a retrial.

Mutatis Mutandis Application of Provisions of the Patent Act

86.—(1) Articles 180 and 184 of the Patent Act and Article 429(1) of the Code of Civil Procedure shall apply *mutatis mutandis* to procedures and requests for a retrial.

(2) Articles 186 to 188 and 189 of the Patent Act shall apply *mutatis mutandis* to litigation under the Trademark Act. In the case of Article 186(1) of the Patent Act, “Article 51(1), as applied under Article 170(1) (including, where applicable, *mutatis mutandis* application under Article 184)” shall mean “Article 17(1), as applied under Article 81(1)(including Article 86(1), and where applicable *mutatis mutandis* under Article 184 of Patent Act)” and “Articles 133(1), 134(1), 135(1), 137(1), (3) and 138(1)” in the provisions of Article 187 of the Patent Act shall mean “Articles 71(1), 72(1), 73(1) and (2), 74(1) and 75”.

Chapter IX
Supplementary Provisions

Inspection of Documents, etc.

87. A person who requires a certification as to the application for trademark registration, a certificate for trial, a certified copy or extract of documents, inspection or copy from the Trademark Register, or other documents may make a request to that effect to the Commissioner of the Korean Industrial Property Office or the President of the Industrial Property Tribunal.



Prohibition of Opening or Removal of Trademark Register and Documents Relating to the Application for Trademark, Registration Examination, Trial and Retrial

88.—(1) The removal of the Trademark Register or documents relating to the application for a trademark registration, examination, trial or retrial shall be prohibited.

(2) An answer shall not be given to a request for an expert opinion, testimony or an inquiry as to the contents of a case that is in the process of the application for trademark registration, examination, trial or retrial or as to the contents of a decision or ruling.

Trademark Gazette

89.—(1) The Korean Industrial Property Office shall publish the Trademark Gazette.

(2) The Trademark Gazette may be published by electronic media under the conditions as determined by the Ordinance of the Ministry of Commerce, Industry and Energy.

(3) In publishing the Trademark Gazette by electronic media, the Commissioner of the Korean Industrial Property Office shall make public matters relating to the publication of the Trademark Gazette, its main contents, and service by publication.

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

Indication of Trademark Registration

90. The owner of a trademark right, or an exclusive or non-exclusive licensee, may use the indication “Registered Trademark” on the designated goods or their packaging.

Prohibition of False Indication

91.—(1) No person shall be allowed to perform any of the following acts:

(i) indicating a trademark which is not registered or applied for a trademark registration, on goods as if it was a registered trademark or its registration was applied for;

(ii) indicating a trademark which is not registered or applied for a trademark registration, on advertisements, signboards, labels or packaging of goods or other business transaction documents, etc, as if it was a registered trademark or its registration was applied for; or

(iii) marking an indication that the trademark is registered with respect to goods other than the designated goods, or which is liable to cause confusion, in case 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 shall include the goods and packaging, advertisement, signboards, or labels which have become shapes of marks.

*Special Provision on a Trademark etc
Similar to Registered Trademark*

91bis.—(1) “The registered trademark” as referred to in Articles 50, 53, 55(3), 57(2), 62, 67(2), 73(1) (iii) and (iv), 85, 90 and 91 shall include trademarks, similar to the registered trademark, which will be deemed identical with the registered trademark if their colors are the same as those of the registered trademark.

(2) “A trademark similar to the registered trademark” as referred to under subparagraph 1 of Article 66 and Article 73 (1) (ii) shall not mean to include trademarks, as similar to the registered trademark, which will be deemed identical with the registered trademark if their colors are the same as those of the registered trademark.

Mutatis Mutandis Application of Provisions of the Patent Act

92. Articles 217-2 to 220, 222 and 224-2 of the Patent Act shall apply *mutatis mutandis* to trademarks.

**Chapter X
Penal Provisions**

Offense of Infringement

93. Any person who has infringed a trademark right or an exclusive license shall be liable to imprisonment with labor not exceeding five years or to a fine not exceeding 50,000,000 Won.

Offense of Perjury

94.—(1) Where a witness, expert witness, or interpreter, having taken an oath under Act, made a false statement or given a false expert opinion or interpreted falsely before the Industrial Property Tribunal, such person shall be liable to imprisonment with labor not exceeding five years or to a fine not exceeding 5,000,000 Won.

(2) Any person having committed an offense under paragraph (1) of this Article who reveals the offense prior to the conclusion of the examination of the case, prior to the examiner’s decision being rendered or prior to a trial decision on the case becoming final and conclusive may be partially or totally exempted from the application of the penalty.



Offense of False Marking

95. Any person who has violated Article 91 shall be liable to imprisonment with labor not exceeding three years or to a fine not exceeding 20,000,000 Won.

Offense of Fraud

96. Any person who has obtained a trademark registration, the supplementary registration of designated goods, the registration for renewal of term of a trademark right or a trial decision by means of a fraudulent act or any other unjustified act shall be liable to imprisonment with labor not exceeding three years or to a fine not exceeding 5,000,000 Won.

Dual Liability

97. Where a representative of a legal entity or an agent, employee or any other servant of a legal entity or natural person has committed an act in violation of Article 93, 95 or 96 with regard to the business of the legal entity or natural person, the legal entity or natural person, in addition to the offender, shall be sentenced to the fine provided for in those respective Articles.

Confiscation

97bis.—(1) Trademarks or packagings infringing on the trademark rights or exclusive use rights of another under Article 93, or obtained by such infringement actions, or machinery used for the production of goods, trademarks, or packagings shall be confiscated.

(2) Goods which may be easily detached from their trademarks or packagings for the purpose of removing the infringement and which does not effect the function and/or feature of those goods may not be confiscated, notwithstanding paragraph (1) of this Article.

Administrative Fine

98.—(1) Any person who has committed an act in violation of any of the following subparagraphs shall be subject to an administrative fine not exceeding 500,000 Won:

(i) a person who has taken an oath under Article 271(2) or 339 of the Code of Civil Procedure and has made a false statement before the Industrial Property Tribunal;

(ii) a person who was ordered by the Industrial Property Tribunal to submit or show documents or other materials with respect to the taking of evidence or for the preservation of evidence, but failed to comply with the order without justifiable reasons; or

(iii) a person who was summoned by the Industrial Property Tribunal as a witness, expert witness or interpreter but failed to comply with the subpoena or has refused to take an oath, make a statement, testify, give an expert opinion or interpret, without justifiable reasons.



(2) The administrative fine referred to in paragraph (1) of this Article shall be imposed and collected by the Commissioner of the Korean Industrial Property Office as prescribed by the Presidential Decree.

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

(4) The Commissioner of the Korean Industrial Property Office shall, upon receipt of a protest under paragraph (3) of this Article, notify the competent court without delay, which shall then adjudicate the case of the administrative fine according to the provisions of the Act on Non-Contentious Procedures.

(5) Where no objection has 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 Industrial Property Office shall collect it in accordance with the rules concerning collection of national taxes in arrears through the head of the competent tax office.

Addenda

Enforcement Date

1. This Act shall enter into force on January 1, 1999.

2 through 5. Omitted.