

**Trademark Law**

Law No. 71, Promulgated on Nov. 28, 1949
as last amended by Law No. 6414, Feb. 3, 2001

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CHAPTER I GENERAL PROVISIONS

Purpose

1. The purpose of this Law 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 Law 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 as 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 or 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 Law, the provisions in this Law 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 Intellectual Property Office or employees of the Intellectual 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 Law

5. Articles 3 to 26, 28 to 28^{quiquies} of the Patent Law shall apply *mutatis mutandis* to trademarks. In such cases, “Article 132^{ter}” in Articles 6, 11(1)(iv), 15(1) and 17 of the Patent Law shall read “Article 70^{bis} or 70^{ter}”, “patent right and patent” in the proviso of Article 28(2) of the Patent Law shall read “trademark right and trademark” and “international application under Article 2(vii) of the Patent Cooperation Treaty (hereinafter referred to as ‘international application’)” shall read “international application under Article 2(2) of the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (hereinafter referred to as ‘international application’). Hereinafter, the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks shall be referred to as the ‘Protocol’”.

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) to (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 Intellectual Property (hereinafter referred to as "Paris Convention") or a member of the World Trade Organization, or a contracting party to the Trademark Law Treaty; 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, or a member of the World Trade Organization, or a contracting party to the Trademark Law Treaty; 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 paragraph) 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 own 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 unjust 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 (xii) 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 Intellectual Property Office.



(3) Where an application for trademark registration has been abandoned, withdrawn or invalidated, or where an examiner's decision or trial decision to refuse trademark registration has become final 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 Intellectual 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 Intellectual Property Office stating the following:

- (i) the name and domicile of the applicant for trademark registration (if the applicant is a legal entity, the title and place of business);
- (ii) the name and domicile, or place of business, of the agent, if any (if the agent is a patent corporation, the title, place of business and the name of the appointed patent attorney);
- (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) Deleted; 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 articles of association which govern the use of such collective mark, as prescribed by 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.

According of the Filing Date, etc.

9bis.—(1) The Commissioner of the Korean Intellectual Property Office shall decide to accord as the date of a trademark application the date of reception of the request with respect to the trademark application unless the application falls under any of the following paragraphs:

- (i) where the indication that a trademark registration is sought is not clear;
- (ii) where the name or the title of the applicant is not indicated, or the indication is not considered sufficient to the extent to enable the identification of the applicant;
- (iii) where a trademark for which the registration is sought is not indicated; or the indication is not clearly discernable;
- (iv) where the designated goods are not indicated; or
- (v) where the application is not filed in the Korean language.

(2) Where an application for trademark registration falls under any of the subparagraphs of paragraph (1), the Commissioner of the Korean Intellectual Property Office shall invite the applicant to make the required correction, designating an adequate time limit.

(3) Where the applicant supplements the application for trademark registration pursuant to the order to supplement under paragraph (2), he/she shall submit documents for the procedure to supplement the application (hereinafter referred to as the “a request to supplement the procedure”).

(4) Where the applicant who has received an order to supplement under paragraph (2) has done so within the designated time limit, the Commissioner of the Korean Intellectual Property Office shall decide to accord as the date of the trademark application the date of reception of the request to supplement procedure by the Korean Intellectual Property Office.



(5) Where the applicant who has received an order to supplement under paragraph (2) has not done so within the designated time limit, the Commissioner of the Korean Intellectual Property Office may return the application for trademark registration on the ground that the application is defective.

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 classification 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, he/she may designate both goods and services in one 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 cases of inheritance or other general succession, shall not be effective against third parties without recordation of the change of 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 Intellectual 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 Intellectual Property Office, in the case of mergers of legal entities.

Amendment of Procedure

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

- (i) When the requirements of Article 3(1) of the Trademark Law or Article 6 of the Patent Law, as applied under Article 5 of the Trademark Law, have not been complied with;
- (ii) When the formal requirements specified in the Trademark Law 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) An amendment under paragraph (1) of this Article may not be made after the transmittal of a certified copy of the examiner's decision to grant or refuse a trademark registration (hereinafter referred to as "decision to grant or refuse a trademark registration"). However, where a trial against a decision of refusal is requested under Article 70*bis*, an amendment may be made within thirty days from the request, or within the period in which the written opinion is to be submitted under Article 23(2), 45(2), 46*quater*(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 set forth under any of the following conditions, amend or correct the designated goods and/or the specimen in response to reasons for refusal, reasons for opposition, reasons for a decision to refuse a trademark registration, or a decision to refuse supplementary registration of the designated goods as long as the subject matter is not materially changed when a notice of rejection is served under Article 23(2) or Article 48(2) after the certified copy of the decision on publication of the application under Article 24 is delivered, when an opposition to the trademark registration is brought under Article 25, or when an appeal against a decision of refusal under Article 70(2) is requested

against a decision to refuse a trademark registration under Article 23(1) or a decision to refuse a supplementary registration of designated goods under Article 48(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 decision 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 to grant or refuse trademark registration with respect to a trademark application, 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 said 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 decision 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 that has been divided under paragraph (1) of this Article (hereinafter referred to as a “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 mark 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 decision to grant or refuse a trademark registration with respect to a initial trademark application or a trial decision on the initial application for trademark registration, or after a decision to grant or refuse a service mark registration with respect to a initial service mark application or a trial decision on the initial application for service mark 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 Intellectual 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 Intellectual 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 Intellectual 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 Intellectual 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 Intellectual Property Office may request a specialized searching agency to inspect trademarks where it is deemed necessary for the examination with regard to an application of trademark registration.

(2) The Commissioner of the Korean Intellectual 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.

Decision to Refuse Trademark Registration and Notification of Reasons for Refusal

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

(i) where the trademark 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 Law or 25 of the Patent Law as applied under Article 5 of the Trademark Law;

(ii) where the trademark is in violation of the provisions of a treaty;

(iii) where 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 or information has been submitted under Article 22(3) by the owner; or

(iv) where the trademark is not conform to the definition of the mark under Article 2(1)(i) to (iv).

(2) An examiner shall, when intending to make a decision to refuse 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 Intellectual Property Office shall transmit the decision to the applicant and publish the application in the Trademark Gazette.

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

Right to Demand Compensation for Loss

24bis.—(1) After an application is published under Article 24(2) (including *mutatis mutandis* application under Article 49(3) and Article 81(1)), an applicant may warn, in writing, a person who has used a trademark that is identical or similar to the trademark of said published application on goods that are identical or similar to the designated goods of said

published application. However, where the applicant show a copy of said application for trademark registration, he/she may send a warning in writing even before the publication of the application.

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

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

(4) The exercise of the right to demand under paragraph (2) shall not preclude the exercise of the trademark right.

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

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

(i) where an application for trademark registration has been abandoned, withdrawn or invalidated;

(ii) where a decision to refuse trademark registration for an application for trademark registration has become final and conclusive; or

(iii) where a trial decision to invalidate a trademark registration under Article 71 (except Article 71(1)(iv) and (v)) has become final and conclusive.

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 Intellectual 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 Intellectual 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 (if the applicant is a legal entity, the title and place of business);



(*ibis*) where such person has a legal agent, the name and the domicile or the place of business (if the agent is a patent corporation, the title, place of business, and the name of the appointed patent attorney);

- (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 Intellectual 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.



Decision of Refusal to Register a Trademark Made Ex Officio After Publication

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

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

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

Decision to Grant Registration of a Trademark

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

Method of Decision to Grant or Refuse a Trademark Registration

31.—(1) The decision to grant or refuse a trademark registration shall be made in writing and shall state the reasons therefor.

(2) Where an examiner has made a decision to grant or refuse a trademark registration, the Commissioner of the Korean Intellectual Property Office shall transmit a certified copy of the decision 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 on the registration of a trademark has become final and conclusive.

Mutatis Mutandis Application of Provisions of the Patent Law

33. Articles 148(1)(5), (7) and 157 of the Patent Law 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.

Abandonment of a Some or All the Designated Goods at the Time of Payment of the Trademark Registration Fees

34bis.—(1) A person who has received a decision granting registration of a trademark application with more than two designated goods, or has received a decision granting supplementary registration of designated goods in an application for supplementary registration of the designated goods, or has received a decision granting registration for renewal of term of a trademark right may abandon said designated goods in part when he/she pays the trademark registration fees.

(2) Matters necessary for the abandonment of designated goods under paragraph (1) of this Article 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 Intellectual 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.

*Recovery of an Application for Trademark Registration by Payment of
the Trademark Registration Fees etc.*

36bis.—(1) Where an applicant who has submitted an application for registration of a trademark, an application for supplementary registration of designated goods, or an application for registration for a renewal of term of a trademark right deemed to have been abandoned under Article 36, or where an applicant was unable to pay the registration fees under Article 34(3) within the payment period prescribed under Article 34(3) or 35, due to circumstances beyond his or her control, said applicant may pay the registration fees within 14 days from the date on which said circumstances cease to exist. However, this provision shall not apply where a period of 6 months elapses from the expiration date of the payment period prescribed under Article 34(3) or 35.

(2) Where payment of the registration fees is made in accordance with paragraph (1), the application for registration of a trademark, the application for supplementary registration of designated goods, or the application for registration for the renewal of term of a trademark shall be deemed to have not been abandoned, notwithstanding the provisions of Article 36.

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

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.—(1) 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 incorrectly paid portion of the fees shall be refunded without delay upon request by the person who made such payment.

(2) Where trademark registration fees and official fees has been paid incorrectly the Commissioner of the Korean Intellectual Property Office shall issue notification of the fact to the person who made such payment.

(3) A refund of the trademark registration fees and official fees submitted under paragraph (2) shall not be requested where one year has elapsed from the date on which notification was given of such.

Trademark Register

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

(i) the establishment, transfer, modification, expiration, renewal of the term, reclassification of goods under Article 46*bis*, 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 Intellectual 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 Intellectual 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 Intellectual Property Office shall authorize the registration 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 term of a trademark right under Article 42(2) shall submit an application to the Commissioner of the Korean Intellectual Property Office, including the following:

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

(2) 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 an Application for Registration for Renewal of
Term of a 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.

*Decision of Refusal of Registration for Renewal of Term and
Notification of Reasons for Refusal*

45.—(1) The examiner shall make a decision of refusal of 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 application expands the actual scope of the designated goods.

(2) Where the examiner intends to render a decision of refusal of registration for renewal of term of a trademark right 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 decision of refusal of registration for the renewal of term of a trademark right 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 to Register the Reclassification of Goods

46bis.—(1) A trademark right owner who has obtained a trademark registration, a supplementary registration of designated goods, or a registration for renewal of term of a trademark right for designated goods in accordance with the classification of goods prescribed by the Ordinance of the Ministry of Commerce, Industry and Energy under the previous Article 10(1) of the Trademark Law, before enforcement of the amendment thereof under the enactment of Law No. 5355, shall reclassify the designated goods (hereinafter referred to as the reclassification of goods), as prescribed by the Ordinance of the Ministry of Commerce, Industry and Energy. However, this provision shall not apply where the person has obtained registration for renewal of term of a trademark right for designated goods in accordance with the classification of goods as prescribed by the Ordinance of the Ministry of Commerce, Industry and Energy, under Article 10(1) of the Trademark Law as amended under the enactment of Law No. 5355.

(2) If any person intends to obtain registration of reclassification of goods under paragraph (1), (hereinafter referred to as “registration of reclassification of goods”), such person shall submit to the Commissioner of the Korean Intellectual Property Office a written application to register the reclassification of goods, specifying the particulars prescribed in each of the following subparagraphs. Where a person intends to file an application to register the reclassification of goods and an application to register a renewal of term of a trademark right under Article 43(1) at the same time, he may instead file a single application for registration of renewal of term of a trademark right by specifying therein said intention and the particulars prescribed under subparagraph (4).

(i) the name and the domicile of the applicant for the reclassification of goods (if the applicant is a legal entity, the title and the place of business);

(ii) where such person has an agent, the name and the domicile or the place of business (if the agent is a patent corporation, the title, place of business and the name of the appointed patent attorney);

(iii) the registration number of the registered trademark;

(iv) the designated goods and the corresponding classification that the applicant wishes to reclassify.

(3) The application for registration of the reclassification of goods shall be filed within the period of from one year before the expiration date of the term of the trademark right to six months after the expiration date of said term.

(4) Where a trademark right is owned jointly, all joint owners shall jointly file an application for register the reclassification of goods.

Division of an Application for Registration of the Reclassification of Goods

46ter.—(1) Where an applicant files an application for registration of a renewal of term of a trademark right in which the designated goods are divided under Article 44(1), the applicant shall file an application to divide the registration of the reclassification of goods.

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

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

Decision of Refusal of Registration of the Reclassification of Goods and Notification of the Reasons for Refusal

46quater.—(1) The examiner shall render a decision to refuse registration of the reclassification of goods where any one of the following subparagraphs applies:

(i) where the designated goods for which an application to register the reclassification of goods has been filed are not the goods designated under the registered trademark or where the applicant expands the actual scope of the designated goods;

(ii) where the designated goods of an application to register the reclassification goods does not correspond with the classifications of goods prescribed by the Ordinance of the Ministry of Commerce, Industry and Energy;

(iii) where the applicant is not the owner of the trademark right concerned; and

(iv) where the application is in violation of Article 46bis (3).

(2) Where the examiner intends to render a decision to refuse registration of the reclassification of 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 a response in writing within the designated time limit.

Registration of the reclassification of Goods

46quinquies.—(1) Where the examiner renders a decision to register the reclassification of goods under Article 30 as applied under Article 49(2), the Commissioner of the Korean Intellectual Property Office shall register the reclassification of the designated goods.

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 Intellectual Property Office including the following:

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

Decision of Refusal of 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 decision 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 decision of refusal of the application has become final and conclusive.

(2) If the examiner intends to render a decision 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 Law

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

(2) Articles 10(1), 13, 14, 16, 17, 22 and 30—32 of the Trademark Law and Article 148 (i)—(v), (vii) of the Patent Law shall apply *mutatis mutandis* to applications for registration of the reclassification of goods.

(3) Articles 10(1), 13—17, 20—22 and 24—32 of the Trademark Law, Articles 148(1) (i)—(v), (vii) and 157 of the Patent Law 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 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 that are essential to secure the functions of the designated goods of a registered trademark 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 or the application for registration of the reclassification of goods.

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 Intellectual 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, a renewal of the term of trademark right, reclassification of goods, 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 Intellectual 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.

Right to Use a Trademark After Expiration of the Term of Patent Right etc.

57bis.—(1) Where a patent right under a patent application filed prior to or on the filing date of a trademark application conflicts with the trademark right under said trademark application and the term of the patent right has expired, the patentee shall have the right to use within the scope of the original patent right the registered trademark or another trademark similar thereto with respect to the designated goods covered by the trademark application or goods similar thereto. However, this provision shall apply only where the registered trademark is used without intent to violate the rules of fair competition.

(2) Where a patent right under a patent application filed prior to or on the filing date of a trademark application conflicts with the trademark right under said trademark application and the term of the patent right has expired, any person who has an exclusive license with respect to the patent right or a non-exclusive license with respect to the patent right or its exclusive license effective under the provisions of Article 118(1) of the Patent Law at the time of its expiration shall have the right to use, within the scope of the original right, the registered trademark or another trademark similar thereto on the designated goods or goods similar thereto. However, this provision shall apply only where the registered trademark is used without violating the rules of fair competition.

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

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

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

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

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 cases 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 cases 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 Intellectual 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 Law 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.

Extinguishment of the Trademark Right in the Absence of Registration of the Reclassification of Goods

64bis.—(1) Where any one of the subparagraphs apply, a trademark right covering designated goods of an application for registration of the reclassification of goods shall extinguish on the expiration date of the term of trademark right that is contained within the time limit prescribed under Article 46bis(3) for registering the reclassification of goods.

(i) where a person who is entitled to register the reclassification of goods does not file an application to this effect within time limit prescribed under Article 46bis(3);

(ii) where the application to register the reclassification of goods has been withdrawn;

(iii) where a procedure relating to the reclassification of goods has been invalidated under Article 16(1) of the Patent Law as applied under Article 5 of this Law;

(iv) where a decision to refuse registration of the reclassification of goods is final and conclusive; or

(v) where a trial ruling invalidating registration of the reclassification of goods under Article 72bis(2) is final and conclusive.

(2) A trademark right covering designated goods that are the object of reclassification of goods but not indicated in an application for registration of the under Article 46bis(2) shall extinguish on the date on which the designated goods that are indicated in said application are reclassified and registered under Article 46quinquies.

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 a trademark right or exclusive license for damages caused by the infringer's transfer of infringing articles, the amount of damages may be calculated as the number of transferred articles multiplied by the profit per unit of the articles that the owner of the trademark right or exclusive licensee might have sold in the absence of said infringement. Provided that, said compensation may not exceed an amount calculated as follows: the estimated profit per unit multiplied by the number of articles that the trademark right owner or licensee could have produced subtracted by the number of articles actually sold. However, where the owner of the trademark right or

exclusive licensee was unable to sell his or her product for reasons other than infringement, a sum calculated according to the number of articles subject to said circumstances shall be deducted.

(2) 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.

(3) Where the owner of a trademark right or an exclusive licensee claims compensation from a person who has intentionally or negligently infringed the trademark right or exclusive license due to damages caused 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.

(4) Notwithstanding paragraph (3) 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.

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

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 Decision of Refusal

70bis. Any person dissatisfied with a decision of refusal of registration of a trademark, a decision of refusal of supplementary registration of designated goods, a decision of refusal of registration of a renewal of term of a trademark right, or a decision of refusal of registration of the goods reclassification (hereinafter referred to as “decision of refusal”) may make a request for trial within thirty days from the date of receipt of a certified copy of the decision 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) or Article 23(1)(iv) of the Trademark Law or in breach of Article 25 of the Patent Law which is made applicable under Article 5 of the Trademark Law;
- (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 Law that is made applicable under Article 5 of the Trademark Law, or the registration no longer complies with a treaty.
- (v) following registration, the registered trademark falls under any one of subparagraphs of Article 6(1) (except where Article 6(2) applies).

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

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

Invalidation Trial of a Registration for the Reclassification of Goods

72bis.—(1) An interested person or an examiner may request a trial to invalidate a registration of the reclassification of goods where any of the following subparagraphs apply. In such a case, if two or more designated goods relating to the registration for the reclassification of goods exist, a request for an invalidation trial may be made for each of the designated goods:

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

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

(iii) where the registration for the reclassification of goods has been effectuated in violation of Article 46*bis*(3).

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

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

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, a registration to renew the term of a trademark right, and a registration of the reclassification of goods under Articles 7(1)(vi) to (ix), and (xiv), 8, 72(1)(ii), and 72*bis*(1)(iii) shall not be requested after five years from the registration date of the trademark, from the registration date of the renewal of the term of the trademark right or from the registration date of the reclassification of goods.

(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 Law

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

[Without Title]

78. Deleted.

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

79.—(1) A person who requests a trial against an examiner's decision 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 Intellectual Property Tribunal stating the following:

(i) the name and domicile of the parties (if a legal entity, the title, the place of business);

(*ibis*) where the agent exists, the name of the agent and the domicile or place of business of the agent (if the agent is a patent corporation, the title, the place of office and the name of the designated patent attorney);

(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 examiner's decision of refusal or rejection of an amendment;

(v) the identification number of the trial case;

(vi) the purpose and reasons for the request; and

(vii) deleted.

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

[Without Title]

80. Deleted.

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

81.—(1) Articles 15, 17, 18, 23(2), 24 to 30, 45(2), 46*quater*(2) and 48(2) shall apply *mutatis mutandis* to a trial against a decision 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 70^{ter}” in Article 17(3) shall mean “where a lawsuit is brought under Article 186(1) of the Patent Law as applied under Article 86(2) of the Trademark Law”; 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) 46^{quater}(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 decision of refusal are found.

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

82.—(1) Articles 172 and 176 of the Patent Law shall apply *mutatis mutandis* to the trial on the decision of refusal and the decision of rejection of amendment. In this case, “132^{ter}” in Article 176(1) of the Patent Law shall read “70^{bis} or 70^{ter}” and “ruling of refusal to grant a patent, refusal to grant an extension of term of a patent right, or revocation of a patent” in Article 176(1) of the Patent Law shall read “decision of refusal or decision of rejection of amendment”.

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

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 the 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. However, 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 Law

86.—(1) Articles 180 and 184 of the Patent Law 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 Law shall apply *mutatis mutandis* to litigation under the Trademark Law. Where Article 186(1) of the Patent Law applies, “action against a trial decision” shall mean “action against a trial decision and decision of rejection of amendment under Article 17(1) as applied under Article 81(1) (including Article 184 of the Patent Law as applied under 86(1))” and “Articles 133(1), 134(1), 135(1), 137(1), (3) and 138(1)” in the provisions of Article 187 of the Patent Law shall mean “Articles 71(1) 72(1) 72bis(1), 73(1) and (2), 74(1) and 75”.

CHAPTER VIII*Bis*
INTERNATIONAL APPLICATION UNDER THE PROTOCOL

Part I
International Application etc.

International Application

86bis. A person who desires to seek an international registration (hereinafter referred to as an “international registration”) as referred to in Article 2(1) of the Protocol shall file with the Commissioner of the Korean Intellectual Property Office an international application on the basis of a trademark registration or an application for trademark registration that falls under any of the following subparagraphs:

- (i) the applicant’s application for trademark registration;
- (ii) the applicant’s trademark registration; or



(iii) the applicant's application for trademark registration and his trademark registration.

Entitlement to File

86ter.—(1) A Person who falls under any of the following subparagraphs may file an international application with the Commissioner of the Korean Intellectual Property Office:

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

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

Procedure for an International Application

86quater.—(1) A person desiring to file an international application shall submit to the Commissioner of the Korean Intellectual Property Office a request for an international application and the documents necessary for an international application, which are to be prepared in a language prescribed by the Ordinance of the Ministry of Commerce, Industry and Energy (hereinafter said request for an international application shall be referred to as a “request for an international application”).

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

- (i) the name and domicile of the applicant (if the applicant is a legal entity, the title and real and effective industrial or commercial establishment);
 - (ii) indications concerning entitlement to file under Article 83ter;
 - (iii) the names of the Contracting States (including inter-governmental organizations, hereinafter referred to as “the designated states”) where protection for the trademark is secured;
 - (iv) the filing date and the application number of the basic application under Article 2(1) of the Protocol (hereinafter referred to as the basic application) or the registration date and the registration number of the basic registration under Article 2(1) of the Protocol (hereinafter referred to as the basic registration);
 - (v) the trademark for which international registration is sought;
 - (vi) goods for which international registration is sought and the classes of the goods;
- and



(vii) the other particulars prescribed by the Ordinance of the Ministry of Commerce, Industry and Energy.

(3) If a person desiring to file an international application claims color as a distinctive feature of his trademark, he shall be required to state the fact and to file with a request for an international application a notice specifying the color or the combination of colors claimed, and he shall be required to append to a request for an international application copies of said trademark in color.

Examination of the Particulars in an International Application, etc.

86quinquies.—(1) Where the particulars appearing in a request for an international application correspond to the particulars appearing in the basic application or the basic registration, the Commissioner of the Korean Intellectual Property Office shall indicate in the request for an international application an acknowledgement of the correspondence and the date of receipt of the request for an international application.

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

Subsequent Designation

86sexies.—(1) If the holder of an international registration desires to designate additional states or inter-governmental organizations where the protection of the internationally registered mark is sought (hereinafter referred to as a “subsequent designation”), he may present a request for a subsequent designation to the Commissioner of the Korean Intellectual Property Office as provided for by the Ordinance of the Ministry of Commerce, Industry and Energy.

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

Renewal of Term

86septies.—(1) The holder of the international registration may renew the term of the international registration for an additional period of 10 years.

(2) A person who desires to renew the term of the international registration under Paragraph (1) may present a request for renewal of the term of the international registration to the Commissioner of Korean Intellectual Property Office as provided for under the Ordinance of the Ministry of Commerce, Industry and Energy.



*Recordal of Change in the Ownership of
an International Registration*

86octies.—(1) The holder of the international registration or his assignee may change the ownership of the international registration in respect of all or some of the designated goods or the designated states.

(2) A person who desires to change the ownership of the international registration under Paragraph (1) may present a request for recordal of a change in the ownership of the international registration to the Commissioner of Korean Intellectual Property as prescribed under the Ordinance of the Ministry of Commerce, Industry and Energy.

Payment of Official Fees

86novies.—(1) A Person who falls under any of the following subparagraphs shall pay the official fees to the Commissioner of the Korean Intellectual Property Office.

- (i) a person who desires to file an international application;
- (ii) a person who desires to request subsequent designation;
- (iii) a person who desires to request renewal of the term of the international registration under Article 87septies; or
- (iv) a person who desires to request recordal of a change in the ownership of the international registration under Article 87octies.

(2) Matters necessary for the official fees, the procedures, the time limit for the payment of the fees, etc. under Paragraph (1) shall be prescribed by the Ordinance of the Ministry of Commerce, Industry and Energy.

Amendment concerning Non-payment of Official Fees

86decies. Where a person who falls under any of the subparagraphs of Article 86novies(1) has not paid the official fees required under Article 86novies(2), the Commissioner of the Korean Intellectual Property Office may invite that person to pay the official fees within a designated time limit.

Invalidation of Procedure

86undecies. Where a person who has been invited to pay the official fees under Article 86decies fails to pay the official fees within the designated time limit, the Commissioner of the Korean Intellectual Property Office may invalidate said procedure.

*Recordal of Change in the Matters concerning an International Registration, etc.*

86duodecies. A request for recordal of a change in the matters concerning an international registration or any to other matters necessary for an international application shall be prescribed under the Ordinance of the Ministry of Commerce, Industry and Energy.

Exclusion for Business Emblem

86terdecies. The provisions of Articles 86bis to 86duodecies shall not apply to a business emblems.

Part II**Special Provisions on an International Application for trademark Registration***International Application for Trademark Registration*

86quaterdecies.—(1) An international application that has been registered internationally under the Protocol and that designates the Republic of Korea as a designated State (including subsequent designations) shall be considered to be an application for trademark registration under this Law.

(2) For the purpose of Paragraph (1), the date of an international registration under Article 3(4) of the Protocol (hereinafter referred to as “the date of the international registration”) shall be considered to be the filing date of the application for trademark registration under this Law. However, in the event of an international application that subsequently designates the Republic of Korea, the date (hereinafter referred to as “the date of subsequent designation”) on which the subsequent designation is recorded in the International Register (which is defined in Article 2(1) of the Protocol. Hereinafter referred to as the International Register) shall be considered to be the filing date of the application for trademark registration under this Law.

(3) In the event of an international application which is considered to be an application for trademark registration under Paragraph (1) (Hereinafter referred to as an international application for trademark registration), the name and domicile of the owner of the international registration (if a legal entity, its title and place of business), the trademark, the designated goods and the classification(s) thereof that are recorded in the International Register shall be deemed to be the name and domicile of the applicant (if a legal entity, its title and place of business), the trademark, the designated goods and the classification(s) thereof, respectively, under this Law.

Special Provision on Business Emblem

86quindecies. The provisions for a business emblems shall not apply to an international application for trademark registration.

Special Provisions on an International Application for Trademark Registration

86sedecies.—(1) In applying this Law to an international application for trademark registration, the purport of the priority claim, the name of the country in which the prior application was filed, and the filing date of the prior application recorded in the International Register shall be deemed to be the purport of the priority claim, the name of the country in which the prior application was filed, and the filing date of the prior application that are indicated in the application for trademark registration.

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

(3) A person who desires to obtain registration for a collective mark shall submit the articles of association prescribed in Article 9(3) within the time limit fixed by the Ordinance of the Ministry of Commerce, Industry and Energy.

*Effect of an International Application for Trademark Registration
where a Trademark Has Been Registered Domestically*

86septiesdecies.—(1) Where the a holder of a trademark right that has been registered in the Republic of Korea (excluding trademarks registered resulting from an international application for trademark registration. Hereinafter referred to in this Article as a “domestically registered trademark”) files an international application for trademark registration, if all the following subparagraphs are fulfilled, the international application for trademark registration shall be deemed to be filed on the filing date of the application for trademark registration concerning said domestically registered trademark with respect to the overlapping scope of designated goods:

(i) the trademark registered in the International Register resulting from an international application for trademark registration (Hereinafter referred to as a internationally registered trademark) shall be identical to the domestically registered trademark;

(ii) the holder of the internationally registered trademark shall be identical to the holder of the domestically registered trademark;

(iii) all the designated goods listed in of the domestically registered trademark shall be included as the designated goods of the internationally registered trademark; and

(iv) territorial extension under Article 3(3) of the Protocol shall take effect after the registration date of the domestically registered trademark:

(2) Where the priority under the Treaty for the application for trademark registration related to the domestically registered trademark under Paragraph (1) is recognized, the priority shall also be recognized with regard to the international application for trademark registration under the same paragraph.

(3) Where the right of the domestically registered trademark is cancelled or extinguished under any of the following subparagraphs, the effect of the concerned international application for trademark registration under Paragraphs (1) and (2) shall not be recognized within the same scope of the designated goods of the cancelled or extinguished trademark right.

(i) Where a trial decision canceling the trademark registration under Article 73(1)(ii), 73(1)(iii), and 73(1)(v) to 73(1)(ix) has become final and conclusive; or

(ii) Where a trial for the cancellation of a trademark registration is requested under Articles 73(1)(ii), 73(1)(iii), and 73(1)(v) to 73(1)(ix), and the trademark right has become extinguished due to the expiration of the trademark term or to the abandonment of some of the trademark rights or designated goods after the request date of the trial for cancellation.

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

86duodevicies.—(1) For the purpose of Article 12(1) concerning an international applications for trademark registration, “except in cases of inheritance or other general succession, shall not be effective against third parties without recordation of the change” in Article 12(1) shall read “shall not be effective against third parties without recordation of the change in the International Bureau”.

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

(3) Article 12(4) shall not apply to an international applications for trademark registration.

Special Provisions for Amendment

86undevicies.—(1) For the purpose of Article 14(1) for an international applications for trademark registration, “the trademark or the list of designated goods in the application for trademark registration” in Article 14(1) shall read “the list of designated goods in the application for trademark registration only when the applicant has been notified of the reasons for refusal under Article 23(2)”.

(2) For the purpose of Article 15 for an international applications for trademark registration, “the designated goods and/or the specimen” in Article 15 shall read “the designated goods”.

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



(4) For the purpose of Article 16(2) or (3) for an international applications for trademark registration, “an application for trademark registration or designated goods” in Article 16(2) or (3) shall read “the designated goods”.

Special Provisions for Division of Applications

86vicies. Article 18 shall not apply to an international application for trademark registration.

Special Provisions for Conversion of Applications

86unvicies. Article 19(1) to (4) shall not apply to an international applications for trademark registration.

Special Provisions for Priority Claim under the Paris Convention

86duovicies. Article 20(4) and (5) shall not apply to the case where an applicant of an international application for trademark registration claims priority under the Paris Convention.

Special Provisions as to the Time of Filing an Application

86tervicies. For the purpose of Article 21(2) for an international applications for trademark registration, “submit a written statement to that effect in conjunction with his application for trademark registration to the Commissioner of the Korean Intellectual 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” in Article 21(2) shall read “submit a written statement to that effect and a document proving the relevant facts to the Commissioner of the Korean Intellectual Property Office within the time limits prescribed by the Ordinance of the Ministry of Commerce, Industry and Energy”.

Special Provisions for Publication of Application

86quatervicies. For the purpose of Article 24(1) for an international applications for trademark registration, “Where an examiner finds no grounds for rejecting an application for trademark registration” in Article 24(1) shall read “Where an examiner finds no grounds for rejecting an application for trademark registration within time limits prescribed by the Ordinance of the Ministry of Commerce, Industry, and Energy”.

Special Provisions for the Right to Demand Compensation for Losses

86quinvicies. For the purpose of the proviso of Article 24bis(1) for an international applications for trademark registration, “a copy of said application for trademark registration” in the proviso of Article 24bis(1) shall read “a copy of said international application”.

*Special Provisions for Opposition to Trademark Registration*

86sevicies. For the purpose of the proviso of Article 25(2)(ii) for an international applications for trademark registration, “serial number of the application for the trademark registration” in Article 25(2)(ii) shall read “international registration number of an international application for trademark registration”.

Special Provisions for Decision of registration of Trademark

86septiesvicies. For the purpose of the proviso of Article 25(2)(ii) for an international applications for trademark registration, “cannot find any reasons for refusing an application for the registration of a trademark” in Article 30 shall read “cannot find any reasons for refusing an application for the registration of a trademark within time limits prescribed by the Ordinance of the Ministry of Commerce, Industry and Energy”.

Special Provisions for Trademark Registration Fees

86duodetricies.—(1) A person desiring to file an international application for trademark registration or to renew the term of a trademark right that has been registered under Article 86untricies (hereinafter referred to as a “trademark right based on the international registration”) shall pay the individual fee under Article 8(7)(a) of the Protocol to the International Bureau.

(2) Matters related to the payment of individual fees under paragraph (1) of this Article shall be prescribed by the Ordinance of the Ministry of Commerce, Industry and Energy.

(3) Article 34 to 36bis shall not apply to an international applications for trademark registrations or to a trademark rights based on the an international registration.

Special Provisions for Refund of Trademark Registration Fees, etc.

86undetricies. For the purpose of the proviso of Article 38(1) for an international applications for trademark registration, “Trademark registration fees and official fees which have been paid” in Article 38(1) shall read “official fees which have been paid”, and “fees” in the proviso of said paragraph and in paragraphs (2) and (3) of said Article shall read “official fees”.

Special Provisions for Registration in Trademark Register

86tricies.—(1) For the purpose of Article 39(1)(i) for a trademark right based on the international registration, “the establishment, transfer, modification, expiration, renewal of term, conversion of the classification of goods under Article 46bis, supplementary registration of designated goods or restriction on disposal, of a trademark rights” in Article 39(1)(i) shall read “the establishment or restriction on disposal, of a trademark right”.

(2) The transfer, modification, expiration or renewal of the term of a trademark right based on the international registration shall be based on the registration of the International Register.

Special Provisions for Registration of Establishment of Trademark Right

86untricies. For the purpose of Article 41(2) for an international applications for trademark registration, when the trademark registration fees have been paid in accordance with Article 34(1)” in Article 41(2) shall read “When the decision on the registration of the trademark has been rendered”.

Special Provisions for Term of a Trademark Right

86duotricies.—(1) The term of a trademark right based on the international registration shall be from the date of registration of its establishment under Article 86untricies to the expiry of a period of ten years from the date of the international registration.

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

(3) Where the term of a trademark right based on the international registration has been renewed under paragraph (2), the term of a trademark right based on the international registration shall be deemed to have been renewed at the time of expiry of said term.

(4) Article 42 to 46quinquies, 49(1) and (2) and 64bis shall not apply to a trademark rights based on the international registration.

Special Provisions for Application for Supplementary Registration of Designated Goods

86tertricies. Article 49(3) shall not apply to an international application for trademark registration or to a trademark rights based on the international registration.

Special Provisions for Division of Trademark Right

86quatertricies. Article 54bis shall not apply to a trademark right based on the international registration.

Special Provisions for Effects of Trademark Right

86quintricies.—(1) The transfer, modification, expiration by abandonment or renewal of a term of a trademark rights based on an international registration shall be of no effect unless it is recorded in the International Register.

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



(3) For the purpose of Article 56(2) for a trademark right based on the international registration, “a trademark right, exclusive license” in Article 56(2) shall read “an exclusive license”.

Effects of Cancellation of an International Registration

86setricies.—(1) Where all or part of an international registration on which an international application for trademark registration is based has been cancelled, the international application for trademark registration shall be deemed to have been withdrawn in respect of all or some of the designated goods to the extent of which the international registration has been cancelled.

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

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

Special Provision on Abandonment of a Trademark Right

86septiestricies.—(1) Article 60(1) shall not apply to a trademark right based on the international registration.

(2) For the purpose of Article 61 for a trademark right based on the international registration “a trademark right, an exclusive” under Article 61 shall read “an exclusive” respectively.

*Special Provision on Invalidity Trial of Registration for
Renewal of Term of Trademark Right*

86duodequadrages. Article 72 and 72bis shall not apply to a trademark right based on the international registration.

Part III

Special Provisions on an Application for Trademark Registration

*Special Provisions on an Application for Trademark Registration
after Cancellation of the an International Registration*

86undequadrages.—(1) Where the international registration of the trademark which is the subject of the international registration designating (including subsequent designations) the Republic of Korea has been cancelled with respect to all or some of the designated goods in accordance with Article 6(4) of the Protocol, the holder of said international registration

may file an application for trademark registration with the Commissioner of the Korean Intellectual Property Office in respect of all or some of said designated goods.

(2) Where an application for trademark registration under paragraph (1) fulfills all the requirements set forth in the following subparagraphs, the application shall be deemed to have been filed on the date of the international registration (in case of a subsequent designation, the date of said subsequent designation).

(i) the application under paragraph (1) shall be filed within three months from the date on which the international registration was cancelled in accordance with the same paragraph;

(ii) the designated goods of the application for the trademark registration under paragraph (1) shall be covered by the list of the designated goods contained in the international registration under the same paragraph; and

(iii) the trademark for which a trademark registration is sought shall be identical to the trademark of the cancelled international registration.

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

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

86quadrages.—(1) Where the holder of the international registration designating (including subsequent designation) the Republic of Korea is no longer entitled to file an international application in accordance with Article 15(5)(b) of the Protocol, the holder of said international registration may file an application for trademark registration with the Commissioner of the Korean Intellectual Property Office with respect to all or some of the designated goods registered in the International Register.

(2) Article 86undequadrages(2) and (3) shall apply *mutatis mutandis* to an application for the trademark registration n under paragraph (1). In such cases, “within three months from the date on which the international registration was cancelled in accordance with the same paragraph” under the provisions of Article 86undequadrages(2)(i) shall read “within, two years from the date on which the denunciation became effective in accordance with Article 15(3) of the Protocol”.

Special Provisions on Examination

86unquadrages. Where an application for trademark registration that falls under any of the following subparagraphs (hereinafter referred to as a “re-application”) is related to a registered trademark which has been registered under Article 86untricies, Articles 23, 24, and 25 to 29 shall not apply to said application.



(i) an application for trademark registration that fulfills all requirements of subparagraphs under Article 86*undequadragies*(2) and is filed in accordance with Article 86*undequadragies*(1); or

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

Special Provision on Statute of Limitation

86*duoquadragies*. Where a trademark has been registered resulting from re-application and the statute of limitations under Article 76(1) for the previous trademark right based on the international registration has lapsed, an invalidation trial against said trademark, which has been registered resulting from re-application, shall not be requested.

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 Intellectual Property Office or the President of the Intellectual 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 a decision to grant or refuse a trademark registration.

Trademark Gazette

89.—(1) The Korean Intellectual 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 Intellectual Property Office shall make public matters relating to the publication of the Trademark Gazette, its main contents, and service by publication through a communication network.

(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 that have become shapes of marks.

Special Provision on Trademarks, etc. That are Similar to Registered Trademarks

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 Law

92. Articles 218 to 220, 222 and 224*bis* of the Patent Law 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 seven years or to a fine not exceeding 100 million Won.

Offense of Perjury

94.—(1) Where a witness, expert witness, or interpreter, having taken an oath under law, made a false statement or given a false expert opinion or interpreted falsely before the Intellectual Property Tribunal, such person shall be liable to imprisonment with labor not exceeding five years or to a fine not exceeding 10 million 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 to grant or refuse a trademark registration 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 million 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, the registration of the reclassification of goods 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 20 million 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, in addition to the offender,

said legal entity shall be sentenced to a fine that falls any of the following subparagraphs and said natural person shall be sentenced to a fine as prescribed in the respective Articles.

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

Confiscation

97bis.—(1) A trademark or packaging that infringes 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 Intellectual Property Tribunal;
- (ii) a person who was ordered by the Intellectual 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 Intellectual 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 Intellectual 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 Intellectual Property Office within thirty days from the date of notification of the imposition.

(4) The Commissioner of the Korean Intellectual 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 Law 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 Intellectual



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.

Addendum

Date of Entry into Force

1. This Law shall enter into force on March 1, 1998.

Transitional Measures as to Application for Trademark Registration, etc.

2. The previous provisions shall apply to the application for trademark registration, the application for the registration for renewal of term of a trademark right, and the examination on the application for supplementary registration of designated goods and a trial against a ruling of refusal made before the entry into force of this Law.

Transitional Measures as to Trial against Registered Trademark, etc.

3. The previous provisions (except Article 73(1)(i)) shall apply to a trial, retrial and/or litigation with respect to the registered trademark by the application for trademark registration, the application for the registration for renewal of term of a trademark right and the application for supplementary registration of designated goods made before the entry into force of this Law.

Transitional Measures as to Associated Trademark

4.—(1) An application for the registration of an associated trademark or trademark rights with respect to associated trademarks made before the entry into force of this Law shall be regarded as an application for trademark registration of trademark rights under this Law.

(2) A pending trial for invalidation or cancellation of a trademark right on grounds of contravention of the previous provision of Article 11(1) of (3), or 54(2) at the time of the entry into force of this Law shall be governed by the previous provisions of this Law.

Transitional Measures as to Trial for Revocation of Trademark Registration

5. Despite the amended provisions of Article 73(4), the previous provisions shall apply to a trial for cancellation under Article 73(1)(iii) for three years from the date of entry into force of this Law.

Transitional Measures as to Three-Dimensional Trademark

6.—(1) Where a person displayed goods with three-dimensional trademarks in an exhibition under Article 21 (1) before entry into force of this Law, the date of entry into force of this Law shall be regarded as the date of display of such goods in an exhibition when such



person makes an application for registration of the three-dimensional trademark concerned under the amended provisions of Article 2.

(2) Where a person made an application for registration of a three-dimensional trademark in one of the contracting parties of the treaty under Article 20, the date of entry into force of this Law shall be regarded as the date of application for registration in the country party to the treaty when such person makes an application for registration of the three-dimensional trademark concerned under the amended provisions of Article 2.

Addendum

Date of Entry into Force

1. This Law shall enter into force on July 1, 2001. However, the amended provisions of Article 38 shall enter into force on and after the day of promulgation. The part of the amended provisions of Article 5 that pertain to international registrations and the amended provisions of Article 86*bis* to 86*duoquadragies* shall enter into the force on and after the day on which the Protocol became effective in the Republic of Korea.

Example of Applying to Right to Demand Compensation for Loss

2. The amended provisions of Article 24*bis* shall apply to an application for trademark registration or to an application for supplementary registration of designated goods, whichever is filed first after July 1, 2001.

Transitional Measures as to Examination, etc. on Application for Trademark Registration, etc.

3. The previous provisions shall apply to an examination of an application for trademark registration, an application for registration of a renewal of term of a trademark right, an application for supplementary registration of designated goods, a trial against a ruling of refusal, and retrial and/or litigation initiated before the entry into force of this Law.

Transitional Measures as to Trial against Registered Trademark, etc.

4. The previous provisions shall apply to a trial, retrial and/or litigation pertaining to an application for trademark registration, an application for registration of a renewal of term of a trademark right, or an application for supplementary registration of designated goods filed before the entry into force of this Law. However, the amended provisions of Article 3 of the Addendum of the Trademark Law, amended by Law No. 5355, shall apply to a request for trial, trial, retrial and/or litigation for cancellation of a trademark registration under Article 73(1)(i) after July 1, 2001.