

# **TRADEMARK ACT**

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# **TRADEMARK ACT**

Wholly Amended by Act No. 14033, Feb. 29, 2016

## **CHAPTER I GENERAL PROVISIONS**

### Article 1 (Purpose)

The purpose of this Act is to contribute to industrial development and to protect the interests of consumers by ensuring the maintenance of the business reputation of persons using trademarks through the protection of trademarks.

### Article 2 (Definitions)

(1) The terms used in this Act shall be defined as follows:

1. The term "trademark" means a mark used to distinguish goods (including services or goods related to the provision of services except goods on which a geographical indication is used; hereinafter the same shall apply) of one business from those of others;
2. The term "mark" means all indications used to identify the source of goods, irrespective of the composition or methods of the expression thereof, which include any sign, letter, figure, sound, smell, three-dimensional shape, hologram, movement, color, etc.;
3. The term "collective mark" means a mark intended to be used directly by a corporation jointly incorporated by persons who produce, manufacture, process or sell goods, or who provide services, or intended to be used by its members;
4. The term "geographical indication" means an indication used to identify goods produced, manufactured, or processed in a specific area in cases where a certain quality, reputation or other characteristic of goods has essentially originated from such specific area;
5. The term "homonymous geographical indication" means a geographical

indication for the same goods which shares the same pronunciation with a geographical indication of other goods, but the relevant geographical location is different from that other indication;

6. The term "collective mark with geographical indication" means a mark intended to be used directly by a corporation incorporated by persons who produce, manufacture, or process goods on which a geographical indication may be used, or is intended to be used by its members;
  7. The term "certification mark" means a mark used by a person who commercially certifies and manages the quality, place of origin, methods of production, or other characteristics of goods to certify that goods of others meet quality criteria, the place of origin, methods of production, or other characteristics;
  8. The term "certification mark with geographical indication" means a mark used by a person who commercially certifies a geographical indication to certify that goods of others meet specified geographical characteristics;
  9. The term "business emblem" means a mark used by a person who engages in not-for-profit business to identify his/her business;
  10. The term "registered trademark" means a trademark which has been registered;
  11. The term "use of a trademark" means any of the following:
    - (a) Displaying a trademark on goods or packages of goods;
    - (b) Transferring or delivering goods or packages of goods on which a trademark is displayed, or exhibiting, exporting, or importing such goods for the purpose of transfer or delivery;
    - (c) Displaying a trademark on advertisements for goods, price tags, transaction documents, or other means, and exhibiting or giving wide publicity to the trademark.
- (2) Displaying a trademark under the items of paragraph (1) 11 includes displaying a trademark through any of the following methods:
1. Displaying a trademark in the shape of a mark or by means of sound or smell;
  2. Displaying a trademark through an electronic method on information

provided through a telecommunications line.

- (3) Except as otherwise expressly prescribed by this Act, the provisions concerning trademarks shall apply to collective marks, certification marks, or business emblems.
- (4) Except as otherwise expressly prescribed by this Act, the provisions concerning collective marks with geographical indication shall apply to certification marks with geographical indication.

#### Article 3 (Persons Entitled to Registration of Trademark)

- (1) Any person who uses or intends to use a trademark in the Republic of Korea may obtain registration of his/her trademark: *Provided*, That no employee of the Korean Intellectual Property Office or the Intellectual Property Trial and Appeal Board shall obtain registration of a trademark while he/she is in office, except by inheritance or bequest.
- (2) Any corporation (in cases of a collective mark with geographical indication, limited to a corporation only comprised of persons who produce, manufacture or process goods on which such geographical indication may be used) jointly founded by persons who produce, manufacture, process or sell goods, or provide services may obtain registration of its collective mark.
- (3) Any person who may commercially certify and manage the quality, place of origin, methods of production or other characteristics of goods may obtain certification mark registration only to use it to certify that goods of others satisfy the specified quality, place of origin, methods of production, or other characteristics: *Provided*, That where he/she intends to use the certification mark on goods for his/her own business, he/she shall not obtain the certification mark registration.
- (4) Notwithstanding paragraph (3), no person who files an application for a trademark, collective mark or business emblem, or obtains registration thereof shall obtain registration of a mark identical or similar to such trademark, etc. as a certification mark.
- (5) No person who files an application for a certification mark, or obtains

- registration thereof shall obtain registration of a mark identical or similar to such certification mark as a trademark, collective mark, or business emblem.
- (6) Any person who engages in not-for-profit business in the Republic of Korea may obtain registration of his/her business emblem.

Article 4 (Legal Capacity of Minors, etc.)

- (1) A minor, a quasi-incompetent placed under the protection of a legal guardian (only applicable where there is a legal representative related to trademark rights or rights relating to trademarks) or an adult placed under protection of a legal guardian may file an application or make a request for trademark registration or follow other procedures (hereinafter referred to as "trademark-related procedures") through his/her legal representative only: *Provided*, That the foregoing shall not apply where a minor or a quasi-incompetent placed under the protection of a legal guardian can independently perform a juridical act.
- (2) A legal representative under paragraph (1) may follow procedures concerning a formal objection (hereinafter referred to as "formal objection") to trademark registration under Article 60 filed, or a trial or retrial requested by the other party without the consent of a legal guardian.

Article 5 (Unincorporated Association, etc.)

Where the representative or manager of an unincorporated association or foundation is designated, such association or foundation may become an applicant for a formal objection to trademark registration under Article 60 (1), or the party to a trial or retrial under the name of such association or foundation.

Article 6 (Trademark Manager of Non-Resident)

- (1) Except where a person who is not domiciled or does not have his/her place of business in the Republic of Korea (hereinafter referred to as "non-resident") resides in the Republic of Korea, the non-resident (in cases of a corporation, referring to the representative thereof) may follow trademark-related procedures or bring a lawsuit against measures taken by an administrative authority in accordance with this Act or an order issued under this Act only through a person who is domiciled or has his/her place

of business in the Republic of Korea (hereinafter referred to as "trademark manager") as an agent managing the trademark of the non-resident.

- (2) A trademark manager shall represent his/her principal in a lawsuit with respect to trademark-related procedures or a disposition made by an administrative authority in accordance with this Act or an order issued under this Act, within the scope of authority delegated to him/her.

#### Article 7 (Scope of Agency Authority)

No agent to whom authority to follow trademark-related procedures is delegated (including a trademark manager; hereinafter the same shall apply) by a person who is domiciled or has his/her place of business in the Republic of Korea shall perform any of the following, unless the special authority is delegated to him/her:

1. Abandonment or withdrawal of an application for trademark registration (hereinafter referred to as "application for trademark registration") under Article 36;
2. Modification of an application under Article 44;
3. Withdrawal of any of the following applications:
  - (a) An application (hereinafter referred to as "application to register the renewal of the duration") for registration to renew the duration of trademark rights (hereinafter referred to as "registration to renew the duration") under Article 84;
  - (b) An application for additional registration of goods additionally designated (hereinafter referred to as "application for registration of additional designated goods") pursuant to Article 86 (1);
  - (c) An application (hereinafter referred to as "application for registration of the conversion of the classification of goods") under Article 209 (2) for registration of the conversion of the classification of goods (hereinafter referred to as "registration of the conversion of the classification of goods") under Article 211;
4. Relinquishment of trademark rights;
5. Withdrawal of an application;

6. Withdrawal of a request;
7. Request for a trial under Article 115 or 116;
8. Appointment of a subagent.

Article 8 (Certification of Agency Authority)

The authority of an agent who follows trademark-related procedures shall be certified in writing.

Article 9 (Confirmation of Defects in Legal Capacity, etc.)

Procedures followed by a person who has no legal capacity or authority of legal representation, or who has any defect in the delegation of authority necessary to follow trademark-related procedures shall take effect retroactive to the time he/she performed an act if the party whose defect has been rectified or his/her legal representative confirms such procedures.

Article 10 (Non-Extinguishment of Agency Authority)

No authority of an agent delegated by a person who follows trademark-related procedures shall be extinguished despite any of the following grounds:

1. Death or loss of legal capacity of the principal;
2. Extinguishment of the right of representation by the merger of a corporation who is the principal;
3. Completion of the duty of trust of a trustee who is the principal;
4. Death or loss of legal capacity of the legal representative;
5. Extinguishment or alteration of the agency authority of the legal representative.

Article 11 (Individual Representation)

Where at least two agents are appointed to follow trademark-related procedures, each agent shall act for the principal vis-a-vis the Commissioner of the Korean Intellectual Property Office or the President of the Intellectual Property Trial and Appeal Board.

Article 12 (Orders, etc. to Appoint or Replace Agent)

- (1) Where the Commissioner of the Korean Intellectual Property Office or the presiding judge (hereinafter referred to as "presiding judge") designated pursuant to Article 131 (1) deems a person who follows trademark-related procedures incompetent to follow such procedures, such as he/she is

- deemed to ineffectively perform such procedures or to be unable to make a statement at an oral hearing, he/she may order such person's agent, if any, to follow the procedures.
- (2) Where the Commissioner of the Korean Intellectual Property Office or the presiding judge deems that the agent of a person who follows trademark-related procedures is incompetent to follow such procedures, such as he/she is deemed to ineffectively perform such procedures or to be unable to make a statement at an oral hearing, he/she may order such person to replace his/her agent.
  - (3) In cases falling under paragraphs (1) and (2), the Commissioner of the Korean Intellectual Property Office or the presiding judge may order a person who falls under paragraphs (1) and (2) to require a patent attorney to act for him/her.
  - (4) Where the Commissioner of the Korean Intellectual Property Office or the presiding judge orders a person who follows trademark-related procedures to appoint or replace his/her agent pursuant to paragraph (1) or (2), he/she may invalidate all or some of the trademark-related procedures followed by the person who follows the trademark-related procedures or the agent before he/she is replaced with respect to the Commissioner of the Korean Intellectual Property Office or the President of the Intellectual Property Trial and Appeal Board at the request of the person who follows the trademark-related procedures.

#### Article 13 (Representative of More than One Relevant Person)

- (1) Where at least two persons jointly apply for trademark registration or request a trial, and follow procedures related to such application or trial, each person shall represent all the persons except in any of the following cases: *Provided*, That where they have selected their representative and reported their representative to the Commissioner of the Korean Intellectual Property Office or the Chief Judge of the Intellectual Property Trial and Appeal Board, their representative shall represent all such persons:
  1. Abandonment or withdrawal of an application for trademark registration;



2. Modification of an application under Article 44;
  3. Withdrawal of any of the following applications:
    - (a) An application to register the renewal of the duration;
    - (b) An application for registration of additional designated goods;
    - (c) An application for registration of the conversion of the classification of goods;
  4. Withdrawal of an application;
  5. Withdrawal of a request;
  6. Request a trial under Article 115 or 116.
- (2) Where at least two persons report their representative pursuant to the proviso to paragraph (1), they shall certify in writing that they have selected their representative.

Article 14 (Mutatis Mutandis Application of Civil Procedure Act)

Except as otherwise expressly prescribed by this Act, PART I CHAPTER 2 SECTION 4 (Articles 87 through 97) of the Civil Procedure Act shall apply to all agents.

Article 15 (Jurisdiction over Non-Resident)

Where a trademark manager has been appointed in relation to trademark rights or rights relating to a trademark of a non-resident, the domicile or the place of business of such trademark manager shall be deemed a place where assets under Article 11 of the Civil Procedure Act are located, and where there is no trademark manager, the seat of the Korean Intellectual Property Office shall be deemed a place where assets under Article 11 of the Civil Procedure Act are located.

Article 16 (Computation of Period)

The period prescribed by this Act or an order issued under this Act shall be computed as follows:

1. The first day of the period shall not be included in the computation:  
*Provided*, That the foregoing shall not apply where the period begins from 0:00 am;
2. Where the period is set in months or years, the period shall be computed in accordance with calendar units;

3. Where the period is not computed from the beginning of a month or year, the period shall expire on the day preceding the day corresponding to the day from which the reckoning is made in the last month or year: *Provided*, That where no day corresponds thereto in the last month if the period is set in months or years, the period shall expire on the last day of such month;
4. Where the last day of a period is a public holiday (including a Saturday and the Workers' Day under the Designation Workers' Day Act) in the trademark-related procedures, the period shall expire on the day following such public holiday.

Article 17 (Extension, etc. of Period)

- (1) The Commissioner of the Korean Intellectual Property Office may extend any of the following periods only once by not exceeding 30 days at the request of a party or *ex officio*: *Provided*, That in cases of persons living in a remote area, such as islands or remote rural areas, the Commissioner of the Korean Intellectual Property Office may additionally extend the number of times and periods, as prescribed by Ordinance of the Ministry of Trade, Industry and Energy:
  1. Period for amending grounds, etc. for filing a formal objection under Article 61;
  2. Period for requesting a trial against a decision to reject amendment under Article 115;
  3. Period for requesting a trial against a decision to reject under Article 116.
- (2) Where the Commissioner of the Korean Intellectual Property Office, the President of the Intellectual Property Trial and Appeal Board, the presiding judge or an examiner (hereinafter referred to as "examiner") under Article 50 has prescribed a period during which a person shall follow trademark-related procedures pursuant to this Act, he/she may shorten or extend such period at the request of a person who follows trademark-related procedures or his/her agent, or *ex officio*. In such cases, the Commissioner of the Korean Intellectual Property Office, etc. shall determine whether to shorten or extend the period so as not to unreasonably infringe interests of persons interested in the relevant procedures.

- (3) Where the presiding judge or an examiner has prescribed a period during which a person is to follow trademark-related trademark-related procedures pursuant to this Act, he/she may change such period at the request of a person who follows trademark-related procedures or his/her agent, or *ex officio*.

#### Article 18 (Invalidation of Procedures)

- (1) Where a person ordered to make an amendment under Article 39 (including where it is applied *mutatis mutandis* in Article 212) fails to make such amendment within the designated period, the Commissioner of the Korean Intellectual Property Office or the President of the Intellectual Property Trial and Appeal Board may invalidate the relevant trademark-related procedures.
- (2) Where the Commissioner of the Korean Intellectual Property Office or the President of the Intellectual Property Trial and Appeal Board deems that a person ordered to make an amendment has failed to observe the designated period in extenuating circumstances, even though he/she has invalidated trademark-related procedures pursuant to paragraph (1), he/she may revoke the invalidation thereof at the request of the person ordered to make an amendment within two months from the date such grounds cease to exist: *Provided*, That the foregoing shall not apply where one year has elapsed from the expiration date of the designated period.
- (3) Where the Commissioner of the Korean Intellectual Property Office or the President of the Intellectual Property Trial and Appeal Board invalidates procedures under paragraph (1) or revokes the invalidation thereof under the main sentence of paragraph (2), he/she shall serve a notice of his/her action on a person ordered to make an amendment.

#### Article 19 (Subsequent Completion of Procedures)

Where a person who follows trademark-related procedures fails to observe the any of the following periods in extenuating circumstances, he/she may subsequently complete the procedures within two months from the date such grounds cease to exist: *Provided*, That the foregoing shall not apply where one year has elapsed from the expiration date of the period:

1. Period for requesting a trial against a decision to dismiss an amendment under Article 115;
2. Period for requesting a trial against a decision to reject under Article 116;
3. Period for requesting a retrial under Article 159 (1).

#### Article 20 (Succession to Effect of Procedures)

Procedures followed relating to trademark rights or rights relating to a trademark shall have effect on a successor of such trademark rights or rights relating to a trademark.

#### Article 21 (Continuation of Procedures)

Where trademark rights or rights relating to a trademark are transferred when trademark-related procedures are pending in the Korean Intellectual Property Office or the Intellectual Property Trial and Appeal Board, the Commissioner of the Korean Intellectual Property Office or the President of the Intellectual Property Trial and Appeal Board may require a successor to such trademark rights or the rights relating to such trademark to continue such procedures.

#### Article 22 (Suspension of Procedures)

Where any of the following grounds arises when trademark-related procedures are pending in the Korean Intellectual Property Office or the Intellectual Property Trial and Appeal Board, such procedures shall be suspended: *Provided*, That the foregoing shall not apply where an agent is delegated to follow the procedures:

1. Where a party dies;
2. Where a corporation who is a party is liquidated;
3. Where a party loses the capacity to follow the procedures;
4. Where a party's legal representative dies or loses his/her agency authority;
5. Where a trustee completes his/her duty entrusted by a party;
6. Where the agent under the proviso to Article 13 (1) dies or is disqualified;
7. Where a person with a certain qualification who has become a party in his/her name for another person, such as a trustee in bankruptcy, is disqualified or dies.

#### Article 23 (Resumption of Suspended Procedures)

Where procedures pending in the Korean Intellectual Property Office or the Intellectual Property Trial and Appeal Board are suspended pursuant to Article 22, any of the following persons shall resume such procedures:

1. In cases falling under subparagraph 1 of Article 22: The successor thereof, an executor of inherited property or a person who will proceed with procedures in accordance with the Act: *Provided*, That the successor shall not resume such procedures for a period during which he/she may relinquish his/her inheritance;
2. In cases falling under subparagraph 2 of Article 22: A corporation which is incorporated in the course of the merger or which survives after the merger;
3. In cases falling under subparagraphs 3 and 4 of Article 22: A party who regains his/her capacity to follow procedures or a person who becomes the legal representative;
4. In cases falling under subparagraph 5 of Article 22: A new trustee;
5. In cases falling under subparagraph 6 of Article 22: A new representative or each party;
6. In cases falling under subparagraph 7 of Article 22: A person who possesses a certain qualification, such as a trustee in bankruptcy.

#### Article 24 (Application for Resumption)

- (1) A person specified in any subparagraph of Article 23 and the other party may apply for resuming procedures suspended pursuant to Article 22.
- (2) Where the Commissioner of the Korean Intellectual Property Office or the presiding judge receives an application for resuming procedures suspended pursuant to Article 22, he/she shall notify a person specified in any subparagraph of Article 23 or the other party of the receipt thereof.
- (3) Where the Commissioner of the Korean Intellectual Property Office or an examiner (hereinafter referred to as "examiner") under Article 129 deems that no grounds exist as a result of his/her examination on an application for resuming procedures suspended pursuant to Article 22 *ex officio*, he/she shall dismiss such application by decision.
- (4) Where a person specified in any subparagraph of Article 23 fails to

- resume procedures suspended, the Commissioner of the Korean Intellectual Property Office or an examiner shall order him/her to resume such procedures, fixing a period *ex officio*.
- (5) Where a person ordered to resume procedures suspended pursuant to paragraph (4) fails to resume such procedures within the period under the foresaid paragraph, he/she shall be deemed to have taken over such procedures on the day following the expiration of the period.
  - (6) Where the Commissioner of the Korean Intellectual Property Office or the presiding judge deems that a person has resumed procedures pursuant to paragraph (5), he/she shall notify the relevant party accordingly.

#### Article 25 (Suspension of Procedures)

- (1) Where the Commissioner of the Korean Intellectual Property Office or an examiner is unable to perform any of his/her duties due to a natural disaster or other extenuating circumstances, procedures pending in the Korean Intellectual Property Office or the Intellectual Property Trial and Appeal Board shall be suspended until such circumstance ceases to exist.
- (2) Where any problem prevents a party from continuing procedures pending in the Korean Intellectual Property Office or the Intellectual Property Trial and Appeal Board, the Commissioner of the Korean Intellectual Property Office or an examiner may order the suspension of such procedures by decision.
- (3) The Commissioner of the Korean Intellectual Property Office or an examiner may revoke his/her decision under paragraph (2).
- (4) Where the Commissioner of the Korean Intellectual Property Office or the presiding judge suspends procedures under paragraphs (1) and (2) or revokes his/her decision under paragraph (3), he/she shall notify the relevant party accordingly.

#### Article 26 (Effect of Interruption or Suspension)

Where trademark-related procedures are interrupted or suspended, the running of the relevant period shall be suspended and the entire period shall recommence from the time the resumption of the procedures is notified or

such procedures are continued.

Article 27 (Legal Capacity of Foreigners to Hold Rights)

No non-resident foreigner shall be entitled to enjoy trademark rights or the rights relating to the trademark, except in any of the following cases:

1. Where a state to which such foreigner is a citizen recognizes trademark rights or the rights relating to the trademark owned by a citizen of the Republic of Korea on the same conditions as those of its citizen;
2. Where a state to which such foreigner belongs recognizes trademark rights or the rights relating to the trademark owned by a citizen of the Republic of Korea on the same conditions as those of its citizen, when the Republic of Korea recognizes trademark rights or the rights relating to the trademark owned by such foreigner;
3. Where trademark rights or the rights relating to the trademark is recognized in accordance with a treaty or equivalent thereto (hereinafter referred to as "treaty").

Article 28 (Time When Submission of Documents Takes Effect)

- (1) Any written application, written request, or other document (including goods; hereafter in this Article, the same shall apply) submitted to the Commissioner of the Korean Intellectual Property Office or the President of the Intellectual Property Trial and Appeal Board pursuant to this Act or an order under this Act shall take effect from the date such written application, written request or other document is served on him/her.
- (2) Where a written application, written request or other document under paragraph (1) is submitted to the Commissioner of the Korean Intellectual Property Office or the President of the Intellectual Property Trial and Appeal Board by mail, such written application, written request or other document shall be deemed served on him/her on the following dates: *Provided*, That where a written application for registration of trademark rights or the rights relating to the trademark is submitted by mail, such written application shall take effect from the date the written application is served on him/her:

1. Where the date indicated on the correspondence date stamp under the Postal Service statutes is clear: The date indicated;
2. Where the date indicated on the correspondence date stamp under the Postal Service statutes is unclear: The date a written application, written request or other document is submitted to a post office (referring to the date proved by a certificate of the receipt of mail).
- (3) In addition to matters provided in paragraphs (1) and (2), delay in the delivery of mail, loss or theft of mail, and matters necessary to submit documents due to the interruption of postal service shall be prescribed by Ordinance of the Ministry of Trade, Industry and Energy.

Article 29 (Entry of Identification Numbers)

- (1) Each person who follows trademark-related procedures shall file an application for an identification number with the Commissioner of the Korean Intellectual Property Office or the President of the Intellectual Property Trial and Appeal Board, as prescribed by Ordinance of the Ministry of Trade, Industry and Energy.
- (2) Where the Commissioner of the Korean Intellectual Property Office or the President of the Intellectual Property Trial and Appeal Board receives an application under paragraph (1), he/she shall allocate an identification number to the applicant and inform the applicant accordingly.
- (3) The Commissioner of the Korean Intellectual Property Office or the Presiding Judge of the Intellectual Property Trial and Appeal Board shall give, *ex officio*, identification numbers to those who have failed to apply for them under paragraph (1) and inform them of the fact.
- (4) Where a person given an identification number pursuant to paragraph (2) or (3) follows trademark-related procedures, he/she shall note his/her identification number on a document prescribed by Ordinance of the Ministry of Trade, Industry and Energy. In such cases, notwithstanding this Act or an order under this Act, he/she may choose not to note his/her address (in cases of corporations, referring to the seat of its place of business) on the relevant document.



- (5) The provisions of paragraphs (1) through (4) shall apply *mutatis mutandis* to an agent of the person who follows trademark-related procedures.
- (6) Filing an application for issuance of an identification number, issuance and notification thereof, and other matters necessary for an identification number shall be prescribed by Ordinance of the Ministry of Trade, Industry and Energy.

Article 30 (Performance of Trademark-Related Procedures by Electronic Document)

- (1) Any person who follows trademark-related procedures may electronically prepare an application for trademark registration and other documents submitted to the Commissioner of the Korean Intellectual Property Office or the President of the Intellectual Property Trial and Appeal Board in accordance with methods prescribed by Ordinance of the Ministry of Trade, Industry and Energy, and submit such electronic documents using an information and communications network (hereinafter referred to as "information and communications network") under Article 2 (1) 1 of the Act on Promotion of Information and Communications Network Utilization and Information Protection, Etc., or storing them in electronic recording medium, such as a portable storage medium.
- (2) Electronic documents submitted pursuant to paragraph (1) shall be of the same effect as documents submitted pursuant to this Act.
- (3) Electronic documents submitted via an information and communications network pursuant to paragraph (1) shall be deemed received in the content recorded in a file of the electronic data processing system for the purpose of receipt used by the Korean Intellectual Property Office or the Intellectual Property Trial and Appeal Board when a person who has submitted such electronic documents may confirm the receipt number through the information and communications network.
- (4) Types of documents that may be submitted in electronic form pursuant to paragraph (1), methods of submission, and other matters necessary to submit electronic documents shall be prescribed by Ordinance of the Ministry of Trade, Industry and Energy.

Article 31 (Report on Use of Electronic Documents and Electronic Signature)

- (1) Any person who intends to follow trademark-related procedures in electronic documents shall file a report on the use of electronic documents with the Commissioner of the Korean Intellectual Property Office or the President of the Intellectual Property Trial and Appeal Board, and affix his/her electronic signature to documents submitted to the Commissioner of the Korean Intellectual property Office or the President of the Intellectual Property Trial and Appeal Board to enable recognition of the person who submits such documents.
- (2) Electronic documents submitted pursuant to Article 30 shall be deemed submitted by a person who has affixed his/her electronic signature under paragraph (1).
- (3) Matters necessary for procedures for reporting the use of electronic documents under paragraph (1) and methods of applying electronic signatures shall be prescribed by Ordinance of the Ministry of Trade, Industry and Energy.

Article 32 (Giving Notice, etc. Using Information and Communications Network)

- (1) Where the Commissioner of the Korean Intellectual Property Office, the President of the Intellectual Property Trial and Appeal Board, the presiding judge, a judge, the chief examiner designated pursuant to Article 62 (3) (hereinafter referred to as "chief examiner") or an examiner intends to notify and serve documents (hereafter in this Article, referred to as "notification, etc.") on a person who has filed a report on the use of electronic documents pursuant to Article 31 (1), he/she may give notice, etc. using an information and communications network.
- (2) Notification, etc. of documents under paragraph (1) shall be of the same effect as notice given in writing.
- (3) Notification, etc. of documents under paragraph (1) shall be deemed delivered in the content recorded in a file of the electronic data processing system for dispatch used by the Korean Intellectual Property Office or the Intellectual Property Trial and Appeal Board when a person

who receives such notification, etc. confirms such documents through the electronic data processing system he/she uses.

- (4) Matters necessary for types, methods, etc. of notification, etc. using an information and communication network pursuant to paragraph (1) shall be prescribed by Ordinance of the Ministry of Trade, Industry and Energy.

## **CHAPTER II REQUIREMENTS AND APPLICATION FOR TRADEMARK REGISTRATION**

### Article 33 (Requirements for Trademark Registration)

- (1) Trademark registration may be obtained, excluding the following trademarks:
1. A trademark consisting solely of a mark indicating, in a common manner, the common name of the goods;
  2. A trademark used customarily in connection with the goods;
  3. A trademark consisting solely of a mark indicating, in a common manner, the place of production, quality, raw materials, effect, usage, quantity, shape, price, method of production, method of processing, method of use or time of the goods;
  4. A trademark consisting solely of a conspicuous geographical name, the abbreviation thereof, or a map;
  5. A trademark consisting solely of a mark indicating a common surname or name according to the method in common use;
  6. A trademark consisting solely of a simple and readily available mark;
  7. In addition to trademarks under subparagraphs 1 through 6, a trademark which is unrecognizable for consumers to identify which goods related to whose business it indicates.
- (2) Even if a trademark falls under any of paragraph (1) 3 through 6, where such trademark is recognizable to consumers as a trademark indicating the

source of goods of a specific person as a result of using the trademark before filing an application for trademark registration, trademark registration may be granted limited to the goods on which such trademark is used.

- (3) Even if a mark falls under paragraph (1) 3 (limited to place of production) or 4, where such mark is a geographical indication for specific goods, an applicant may obtain registration of a collective mark with geographical indication for goods using such geographical indication as designated goods (referring to the goods designated pursuant to Article 38 (1) and the goods additionally designated pursuant to Article 86 (1); hereinafter the same shall apply).

#### Article 34 (Trademarks Ineligible for Trademark Registration)

- (1) Notwithstanding Article 33, none of the following trademarks shall be registered:
1. Any of the following trademarks, which is a national flag of a country, an insignia of an international organization, etc.:
    - (a) Any trademark identical or similar to the national flag, the national emblem, the colors, medals, decorations or insignias of the Republic of Korea, or seals or signs used for supervision or certification by the Republic of Korea or public institutions;
    - (b) Any trademark identical or similar to any national flag of a country of the Union to the Paris Convention for the Protection of Industrial Property (hereinafter referred to as the "Paris Convention"), of a member of the World Trade Organization, or of a Contracting Party to the Trademark Law Treaty (hereafter in this paragraph, referred to as "countries of the Union, etc.");
    - (c) Any trademark identical or similar to the title, abbreviated title, or mark of the Red Cross, the International Olympic Committee, or a renowned international organization: *Provided*, That where such organization has applied for trademark registration of its title, abbreviated title, or mark, trademark registration may be obtained;
    - (d) Any trademark identical or similar to coats of arms, flags, medals, decorations or badges of the countries of the Union, etc. designated by

the Commissioner of the Korean Intellectual Property Office after notification by the World Intellectual Property Organization pursuant to Article 6-3 of the Paris Convention, or titles, abbreviated titles, coats of arms, flags, medals, decorations or badges of inter-governmental international organizations which countries of the Union, etc. have joined: *Provided*, That where an inter-governmental international organization which the countries of the Union, etc. have joined applies for trademark registration of its title, abbreviated title, or mark, trademark registration may be obtained;

- (e) Any trademark identical or similar to seals or signs used for supervision or certification by countries of the Union, etc. designated by the Commissioner of the Korean Intellectual Property Office after notification by the World Intellectual Property Organization pursuant to Article 6-3 of the Paris Convention or their public organizations, which is used for the goods identical or similar to those for which such seals or signs are used;
- 2. Any trademark which falsely indicates a relationship with a state, race, ethnic group, public organization, religion, or famous deceased person, or which slanders, insults, or is likely to defame any of them;
- 3. Any trademark identical or similar to a famous mark, which is a mark indicating nonprofit business or public service of a state, public organization, or any of its agencies and a non-profit corporation: *Provided*, That where such state, etc. has applied for trademark registration of its mark, trademark registration may be obtained;
- 4. Any trademark whose meaning, content, etc. conveyed to consumers is likely to harm public order, such as being contrary to moral norms, the prevailing moral sense of ordinary people, where the trademark itself is used or the trademark is used for goods;
- 5. Any trademark consisting of a mark identical or similar to a medal, certificate of merit or decoration awarded at an exhibition held by or with the approval of the Government of the Republic of Korea or at an

exhibition held by or with the approval of the government of a foreign country: *Provided*, That where a person who has been awarded at such exhibition uses such mark as part of the trademark for the awarded goods, trademark registration may be obtained;

6. Any trademark containing the name, title, or trade name, portrait, signature, seal, literary name, stage name, pen name of a prominent person, or his/her abbreviated title: *Provided*, That where the consent of such person has been obtained, trademark registration may be obtained;
7. Any trademark used for goods identical or similar to the designated goods, which is identical or similar to the registered trademark of another person (excluding any registered collective mark with geographical indication) based on first to file;
8. Any trademark used on goods recognized as identical to the designated goods, which is identical or similar to a registered collective mark with geographical indication of another person based on first to file;
9. Any trademark identical or similar to a trademark (excluding a geographical indication) widely recognized by consumers as indicating the goods of another person, which is used on goods identical or similar to the goods of another person;
10. Any trademark identical or similar to a geographical indication of another person widely recognized by consumers as indicating the goods of a specific region, which is used on goods recognized as identical to the goods using such geographical indication;
11. Any trademark likely to cause confusion with goods or business of another person remarkably recognized by consumers or to dilute their distinctiveness or reputation;
12. Any trademark which is likely to mislead consumers about the quality of goods or deceive consumers;
13. Any trademark which is identical or similar to a trademark (excluding a geographical indication) recognized as indicating the goods of a specific person by consumers in the Republic of Korea or overseas, which is

used for unlawful purposes, such as unjust enrichment or inflicting loss on the specific person;

14. Any trademark which is identical or similar to a geographical indication recognized as indicating the goods of a specific region by customers in the Republic of Korea or overseas, which is used for unlawful purposes, such as unjust enrichment or inflicting loss on any legitimate users of such geographical indication;
15. Any trademark consisting solely of the three-dimensional shape, color, combination of colors, sound, or smell, which is essential (in cases of services, referring to cases essential for the use and purpose thereof) to secure the function of goods intended to obtain trademark registration or of the package of such goods;
16. Any trademark intended to be used on wine or distilled beverages, which consists of a geographical indication of the place of production of wine or distilled beverages or contains such geographical indication in a member of the World Trade Organization: *Provided*, That where a legitimate user of the geographical indication applies for registration of a collective mark with geographical indication under Article 36 (5) by designating the relevant goods as the designated goods, he/she may obtain trademark registration;
17. Any trademark which is identical or similar to the name of a variety registered pursuant to Article 109 of the Act on the Protection of New Varieties of Plants, which is used for goods identical or similar to the name of such variety;
18. Any trademark which is identical or similar to a geographical indication of another person registered pursuant to Article 32 of the Agricultural and Fishery Products Quality Control Act, which is used on goods recognized as identical to the goods using such geographical indication;
19. Any trademark which is identical or similar to a geographical indication of another person protected in accordance with a bilateral or multilateral free trade agreement which has come into effect, concluded by the

Republic of Korea with a foreign country or foreign countries, or which consists of or contains such geographical indication, used on goods deemed identical to the goods using such geographical indication;

20. Any trademark for the registration of which an applicant applies on goods, which is identical or similar to such trademark, while he/she is aware that another person uses or intends to use the trademark through a contractual relationship, such as partnership or employment, or business transactional relationship, or any other relationship;
  21. Any trademark for the registration of which any person who has or had a contractual relationship, such as partnership or employment, business contractual relationship, or any other relationship with a person who holds the right to the trademark registered, which is identical or similar to the trademark registered in a State party to the treaty, applies on goods by designating goods identical or similar to the goods on which the trademark is designated as the designated goods without the consent of the person who holds the right to the trademark.
- (2) Whether paragraph (1) and an applicant for trademark registration (hereinafter referred to as "applicant") correspond to another person under the relevant provision shall be determined based on the time a decision corresponding to any of the following is made (hereinafter referred to as "decision on whether to grant trademark registration"): *Provided*, That in cases falling under paragraph (1) 11, 13, 124, 20 and 21, whether an applicant corresponds to another person under the relevant provision shall be determined based on the time an application for trademark registration is filed:
1. Decision to reject trademark registration under Article 54;
  2. Decision to grant trademark registration under Article 68.
- (3) Where a trial to revoke trademark registration is requested because a trademark right holder or a person who uses a trademark of such trademark right holder falls under Article 119 (1) 1 through 3 and 5 through 9, and he/she falls under any of the following after the date such lawsuit is commenced, he/she may obtain trademark registration only



where he/she applies for registration of a trademark identical or similar to such trademark (limited to where he/she intends to obtain trademark registration again by designating identical or similar goods (in cases of a collective mark with geographical indication, referring to goods deemed identical) as the designated goods) after three years from the date he/she falls under any of the following:

1. Where trademark rights are extinguished upon expiry;
  2. Where a trademark right holder relinquishes trademark rights or abandons some of the designated goods;
  3. Where a trial decision to revoke trademark registration is final and conclusive.
- (4) None of the provisions of paragraph (1) 8 and 10 shall apply to homonymous collective marks with a geographical indication.

#### Article 35 (First to File)

- (1) Where at least two applications for trademark registration are filed on different days with respect to the same or similar trademark to be used on the same or similar goods, only the first person who files an application may obtain registration of such trademark.
- (2) Where at least two applications for trademark registration are filed on the same day with respect to the same or similar trademark to be used on the same or similar goods, only one applicant designated by agreement among the applicants may obtain registration of such trademark. When they fail to reach agreement, or are unable to do so, only one applicant determined by a lot drawn by the Commissioner of the Korean Intellectual Property Office may obtain registration of such trademark.
- (3) Where an application for trademark registration falls under any of the following, such application for trademark registration shall be deemed to have never existed when paragraphs (1) and (2) apply:
  - (a) Where the application for trademark registration is abandoned or withdrawn;
  - (b) Where the application for trademark registration is invalidated;
  - (c) Where a decision to reject trademark registration or a trial decision to the effect of rejecting the same becomes final and conclusive.

- (4) In cases falling under paragraph (2), the Commissioner of the Korean Intellectual Property Office shall order an applicant to report the terms of the agreement within a fixed period, and where the applicant fails to so report within such period, the agreement under paragraph (2) shall be deemed never reached.
- (5) The provisions of paragraphs (1) and (2) shall not apply to the following:
  1. Where at least two applications for registration of a collective mark with geographical indication, an application for registration of a collective mark with geographical indication, or an application for trademark registration with the same or similar mark is filed on goods that are not identical (including where goods are deemed identical);
  2. Where at least two applications for registration of a collective mark with geographical indication, which corresponds to the homonymous geographical indication, are filed.

#### Article 36 (Application for Trademark Registration)

- (1) Any person who intends to obtain trademark registration shall submit an application for trademark registration stating the following to the Commissioner of the Korean Intellectual Property Office:
  1. The name and address of the applicant for trademark registration (in cases of a corporation, referring to its name and the seat of its place of business);
  2. Where there is an agent of the applicant, the name, address, or the seat of his/her place of business (where the agent is a patent corporation or patent corporation (with limited liability), referring to its name, the seat of its office and the name of its patent attorney designated);
  3. A trademark;
  4. Designated goods and the category of goods prescribed by the Ordinance of the Ministry of Trade, Industry and Energy (hereinafter referred to as "category of goods");
  5. Matters under Article 46 (3) (limited to where he/she claims the priority);
  6. Other matters prescribed by Ordinance of the Ministry of Trade, Industry and Energy.

- (2) Any person who intends to obtain trademark registration shall write an explanation of such mark in an application for trademark registration in addition to matters under the subparagraphs of paragraph (1), as prescribed by Ordinance of the Ministry of Trade, Industry and Energy.
- (3) Any person who intends to obtain a collective mark shall submit articles of incorporation defining matters concerning the use of the collective mark prescribed by Presidential Decree, along with an application for collective mark registration in addition to matters under the subparagraphs of paragraph (1).
- (4) Any person who intends to obtain certification mark registration shall submit documents defining matters concerning the use of the certification mark prescribed by Presidential Decree (in cases of a corporation, referring to the articles of incorporation, and where the person is not a corporation, referring to the rules; hereinafter referred to as "articles of incorporation or the rules") and documents certifying that he/she may certify and manage the quality, place of origin, methods of production or other characteristics of goods he/she intends to certify along with an application for certification mark registration, in addition to matters under the subparagraphs of paragraph (1).
- (5) Any person who intends to obtain registration of a collective mark with geographical indication or registration of a certification mark with geographical indication shall submit documents certifying that such mark with geographical indication is consistent with the definition of the geographical indication along with an application for registration of a collective mark with geographical indication or application for registration of a certification mark with geographical indication in addition to documents under paragraphs (3) and (4), as prescribed by Presidential Decree.
- (6) Any person who intends to obtain registration of a business emblem shall submit documents certifying that he/she conducts such business along with an application for business emblem registration in addition to matters under the subparagraphs of paragraph (1).

Article 37 (Recognition, etc. of Filing Date of Application for Trademark Registration)

- (1) The date an application for trademark registration is delivered to the Commissioner of the Korean Intellectual Property Office shall be deemed the date an application for trademark registration is filed: *Provided*, That the foregoing shall not apply where an application for trademark registration falls under any of the following:
  1. Where the purpose for which an applicant intends to obtain trademark registration is not clearly indicated;
  2. Where an applicant cannot be identified because his/her name or title is not mentioned or is not mentioned clearly;
  3. Where a trademark cannot be recognized because the trademark intended to be registered is not mentioned in the application for trademark registration or matters mentioned are unclear;
  4. Where no designated goods are mentioned;
  5. Where the application is not prepared in Korean.
- (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 order a person who intends to obtain trademark registration to supplement such application within a reasonably fixed period.
- (3) Where a person ordered to supplement an application under paragraph (2) supplements this application for trademark registration, he/she shall submit a document concerning the complement of procedures (hereafter in this Article, referred to as "document concerning the complement of procedures").
- (4) Where a person ordered to complement an application under paragraph (2) complements this application for trademark registration within the designated period, the Commissioner of the Korean Intellectual Property Office shall deem the date such document concerning the complement of procedures is delivered to the Korean Intellectual Property Office to be the date his/her application for trademark registration is filed.
- (5) Where a person ordered to complement an application under paragraph (2)

fails to complement this application for trademark registration within the designated period, the Commissioner of the Korean Intellectual Property Office may return such application for trademark registration, deeming such application to be an inappropriate application.

Article 38 (One Application for One Trademark)

- (1) Any person who intends to file an application for trademark registration shall file an application for each trademark by designating at least one category of goods in accordance with the classification of goods.
- (2) Specific goods belonging to the category of goods under paragraph (1) shall be prescribed and announced by the Commissioner of the Korean Intellectual Property Office.
- (3) No classification of any category of goods under paragraph (1) shall be construed as prescribing the range of similarity of goods.

Article 39 (Amendment of Procedures)

The Commissioner of the Korean Intellectual Property Office of the President of the Intellectual Property Trial and Appeal Board shall order a relevant person to amend trademark-related procedures within a fixed period, as prescribed by Ordinance of the Ministry of Trade, Industry and Energy, if any of the following applies:

1. Where any of the procedures violates Article 4 (1) or 7;
2. Where the person fails to pay a fee required pursuant to Article 78;
3. Where any of the procedures violates any formality prescribed by this Act or any order issued hereunder.

Article 40 (Amendment before Decision to Publish Application)

- (1) Any applicant may amend items mentioned in an application for trademark registration, designated goods concerning an application for trademark registration, and a trademark to the extent that the substance of the initial application for trademark registration remains unchanged until the following time:
  1. Where a decision to publish an application under Article 57 is made:  
Until the application is published;
  2. Where no decision to publish an application under Article 57 is made:

- Until a decision to reject trademark registration under Article 54 is made;
3. Where a trial against a decision to reject under Article 116 is requested:  
Within 30 days from the date of such request;
  4. Where examination regulations are applied *mutatis mutandis* to a trial against a decision to reject pursuant to Article 123: The period for submitting a written opinion under Article 55 (1) or (3) or 87 (2) or (3).
- (2) Where an amendment made under paragraph (1) falls under any of the following, the substance of the relevant application for trademark registration shall be deemed unchanged:
1. Reduction of the scope of designated goods;
  2. Correction of written errors;
  3. Clarification of ambiguous statements;
  4. Omission of supplemental portion of the trademark;
  5. Other matters prescribed by Ordinance of the Ministry of Trade, Industry and Energy, such as explanation concerning the mark under Article 36 (2).
- (3) Where an amendment made under paragraph (1) is not deemed to fall under paragraph (2) after the establishment and registration of trademark rights, an application for such trademark registration shall be deemed filed at the time a written amendment is submitted.

Article 41 (Amendment after Decision to Publish Application)

- (1) Where any applicant falls under any of the following after a certified copy of a decision to publish an application under Article 57 (2) is delivered, he/she may amend designated goods and the trademark to the extent that the substance of the initial application for trademark registration remains unchanged within the period prescribed in the relevant subparagraph:
  1. Where he/she requests a trial under Article 116 with regard to matters mentioned in grounds for a decision to reject trademark registration under Article 54 or a decision to reject registration of additional designated goods under Article 87 (1): 30 days from the date he/she requests a trial;
  2. Where he/she intends to amend matters mentioned in grounds for rejection

- after he/she is notified of grounds for rejection under Articles 55 (1) and 87 (2): The period for submitting a written opinion on the relevant reasons for rejection;
3. Where he/she intends to amend matters mentioned in reasons for filing a formal objection when such formal objection is filed: The period for submitting a written answer under Article 66 (1).
  - (2) Where an amendment under paragraph (1) falls under Article 40 (2), the substance of an application for trademark registration shall be deemed unchanged.
  - (3) Where an amendment under paragraph (1) is deemed to fall outside of any of the subparagraphs of Article 40 (2) after registration and establishment of trademark rights, trademark rights shall be deemed registered and established concerning such application for trademark registration which has not been amended.

#### Article 42 (Dismissal of Amendment)

- (1) Where an amendment under Articles 40 and 41 falls outside of any of the subparagraphs of Article 40 (2), an examiner shall dismiss such amendment by decision.
- (2) Where an examiner makes a decision to dismiss under paragraph (1), he/she shall not decide on whether to grant trademark registration concerning an application for trademark registration until 30 days elapse from the date a certified copy of such decision is served on an applicant, and where a decision to dismiss is made under paragraph (1) before publication of the application is decided, he/she shall decide not to publish the application as well.
- (3) Where an applicant requests a trial against a decision to dismiss under paragraph (1) pursuant to Article 115, an examiner shall suspend the examination of such application for trademark registration until a trial decision becomes final and conclusive.
- (4) A decision to dismiss under paragraph (1) shall be made in writing, and reasons therefor shall be specified.

- (5) No decision of dismissal (limited to a decision to dismiss an amendment under Article 41) under paragraph (1) shall be appealed: *Provided*, That the foregoing shall not apply where an applicant requests a trial against a decision to dismiss under Article 116.

Article 43 (Submission of Amended Articles of Incorporation, etc.)

- (1) Where an applicant for collective mark registration amends the articles of incorporation under Article 36 (3), he/she shall submit the amended articles of incorporation to the Commissioner of the Korean Intellectual Property Office within a period prescribed by the subparagraphs of Article 40 (1) or the subparagraphs of Article 41 (1).
- (2) Where an applicant for certification mark registration amends the articles of incorporation or the rules, he/she shall submit the amended articles of incorporation or the amended rules to the Commissioner of the Korean Intellectual Property Office within a period prescribed under Article 40 (1) or the subparagraphs of Article 41 (1).

Article 44 (Modification of Applications)

- (1) Any applicant who has filed any of the following applications may modify the application with any of the other following applications:
1. An application for trademark registration;
  2. An application for collective mark registration (excluding an application for collective mark registration with geographical indication);
  3. An application for certification mark registration (excluding an application for certification mark registration with geographical indication).
- (2) Any applicant who has filed an application for registration of additional designated goods may modify such application to an application for trademark registration: *Provided*, That the foregoing shall not apply where a trial to invalidate a registered trademark which becomes the basis of an application for registration of additional designated goods or a trial to revoke such registered trademark is requested, or such trademark is nullified due to the aforesaid trial.
- (3) An application modified (hereinafter referred to as "modified application")



pursuant to paragraphs (1) and (2) shall be deemed filed when the first application is filed: *Provided*, That the foregoing shall not apply where the priority under Article 46 (1) is claimed or special cases at the time of an application under Article 47 (1) are applied.

- (4) No modification of an application under paragraphs (1) and (2) shall be made after a decision on whether registration based on the first application is granted or trial decision thereon becomes final and conclusive.
- (5) In cases of a modified application, the first application shall be deemed withdrawn.

#### Article 45 (Division of Application)

- (1) Where an applicant has filed an application for trademark registration for at least two kinds of goods as designated goods, such application for trademark registration may be divided into at least two applications for trademark registration within a period prescribed by the subparagraphs of Article 40 (1) and the subparagraphs of Article 41 (1).
- (2) Where an application for trademark registration divided (hereinafter referred to as "divisional application") pursuant to paragraph (1) is filed, such divisional application shall be deemed filed at the time the first application for trademark registration is filed: *Provided*, That the foregoing shall not apply where the priority under Article 46 (1) is claimed or special cases at the time of filing an application under Article 47 (1) are applied.

#### Article 46 (Claim of Priority under Treaty)

- (1) Where a citizen of a State party which recognizes the priority of an application for trademark registration filed by a citizen of the Republic of Korea in accordance with the treaty claims priority by filing an application for registration of the same trademark with the Republic of Korea after he/she has filed an application for trademark registration with the State party or other State parties, the date the application for trademark registration is filed with the State party shall be deemed the date the application for trademark registration is filed with the Republic

of Korea when Article 35 is applied. The same shall also apply where a citizen of the Republic of Korea files an application for registration of the same trademark with the Republic of Korea after he/she has filed an application for trademark registration with the State party which recognizes the priority of an application for trademark registration filed by a citizen of the Republic of Korea in accordance with the treaty.

- (2) No person who intends to claim priority pursuant to paragraph (1) shall claim such priority unless he/she files an application within six months after the date of the first application forming the basis for claiming the priority.
- (3) Any person who intends to claim the priority pursuant to paragraph (1) shall state the purpose of filing an application for trademark registration, the name of the country with which the first application for trademark registration was filed, and the filing date of the first application in the written application for trademark registration at the time of filing the application.
- (4) Any person who claims priority pursuant to paragraph (3) shall submit a document stating the filing date of an application for trademark registration recognized by the government of a State party with which he/she filed the first application for trademark registration, a trademark and a certified copy of designated goods to the Commissioner of the Korean Intellectual Property Office within three months after the filing date of an application for trademark registration.
- (5) Where a person who claims priority pursuant to paragraph (3) fails to submit documents under paragraph (4) within the period under the aforesaid paragraph, his/her claim of the priority shall lose its effect.

#### Article 47 (Special Cases at Time of Filing Applications)

- (1) Where any person who may obtain trademark registration files an application for registration of a trademark used on goods exhibited in any of the following exhibitions by designating such goods as designated goods within six months from the date the goods are exhibited, such application for trademark registration shall be deemed filed at the time of

the exhibition of the goods:

1. An exhibition held by the Government or a local government;
  2. An exhibition held by a person who obtained approval from the Government or a local government;
  3. An exhibition held outside the Republic of Korea with the approval of the Government;
  4. An international exhibition held by the government of a State party to the treaty or a person who obtained approval from such government in the territory of the State party.
- (2) Any person who intends to be subject to paragraph (1) shall submit a written application for trademark registration stating the purpose thereof to the Commissioner of the Korean Intellectual Property Office and also submit a document proving the purpose to him/her within 30 days from the filing date of the application for trademark registration.

Article 48 (Succession to and Divided Transfer of Applications)

- (1) No succession to an application for trademark registration shall take effect unless a report on the change of the applicant is filed, except in cases of inheritance and other general succession.
- (2) An application for trademark registration may be transferred by dividing such application for each of the designated goods. In such cases, similar designated goods shall be transferred en bloc.
- (3) Where an application for trademark registration is inherited or succeeded in general, the successor shall immediately report the purpose thereof to the Commissioner of the Korean Intellectual Property Office.
- (4) Where an application for trademark registration is owned jointly, no joint owner shall transfer his/her stake therein without the consent of all other joint owners.
- (5) An application for trademark registration transferred after the division thereof pursuant to paragraph (2) shall be deemed filed at the time the first application for trademark registration was filed: *Provided*, That the foregoing shall not apply where the priority under Article 46 (1) is

claimed or special cases exist at the time of filing of the application under Article 47 (1).

- (6) Any of the following applications for registration shall not be transferred: *Provided*, That where such application for registration is transferred together with affairs under the relevant subparagraph, it may be transferred:
1. An application for registration of a business emblem under Article 3 (6);
  2. An application for trademark registration under the proviso to Article 34 (1) 1 (c), the proviso to item (d) of the aforesaid subparagraph and the proviso to subparagraph 3 of the aforesaid paragraph.
- (7) No application for collective mark registration shall be transferred: *Provided*, That where corporations are merged, an application for collective mark registration may be transferred with permission of the Commissioner of the Korean Intellectual Property Office.
- (8) No application for certification mark registration shall be transferred: *Provided*, That where an application for certification mark registration is transferred together with its business to a person who may obtain a certification mark registration under Article 3-3 with the relevant certification mark, such application for certification mark registration may be transferred with the permission of the Commissioner of the Korean Intellectual Property Office.

#### Article 49 (Provision of Information)

Any person may provide the Commissioner of the Korean Intellectual Property Office or the President of the Intellectual Property Trial and Appeal Board with information to the effect that a trademark for which an application for registration was filed cannot be registered because it falls under Article 54, along with evidence.

## CHAPTER III EXAMINATION

### Article 50 (Examination by Examiners)

- (1) The Commissioner of the Korean Intellectual Property Office may require examiners to examine applications for trademark registration and formal objections.
- (2) Matters necessary for qualifications of examiners shall be prescribed by Presidential Decree.

### Article 51 (Designation, etc. of Institutions Specializing in Trademarks)

- (1) Where the Commissioner of the Korean Intellectual Property Office deems it necessary to examine applications for trademark registration, he/she may designate a specialized institution and entrust it with the following affairs:
  1. Trademark searches;
  2. Classification of goods;
  3. Other affairs such as the examination of the use of a trademark prescribed by Presidential Decree.
- (2) The Commissioner of the Korean Intellectual Property Office may seek cooperation and opinions from related administrative agencies, persons with extensive knowledge and experience in trademarks, or other relevant persons, if deemed necessary for examining applications for trademark registration.
- (3) Where an application for collective mark with geographical indication is filed on products eligible for registration of a geographical indication under the Agricultural and Fishery Products Quality Control Act, the Commissioner of the Korean Intellectual Property Office shall hear opinions of the Minister of Agriculture, Food and Rural Affairs or the Minister of Oceans and Fisheries as to whether such collective mark falls under a geographical indication.
- (4) Criteria for designation of a specialized institution under paragraph (1) and matters necessary to request trademark search, etc. shall be prescribed by

Presidential Decree.

Article 52 (Revocation, etc. of Designation of Institutions Specializing in Trademarks)

- (1) Where a specialized institution under Article 51 (1) falls under subparagraph 1, the Commissioner of the Korean Intellectual Property Office shall revoke the designation thereof, and where it falls under subparagraph 2, he/she may revoke the designation thereof or order it to suspend its business for a fixed period not exceeding six months:
  1. Where it is designated by fraud or other improper means;
  2. Where it fails to meet criteria for designation under Article 51 (4).
- (2) Where the Commissioner of the Korean Intellectual Property Office intends to revoke the designation of a specialized institution or order it to suspend its business pursuant to paragraph (1), he/she shall hold hearings.
- (3) Matters necessary for criteria, procedures, etc. for taking administrative measures under paragraph (1) shall be prescribed by Ordinance of the Ministry of Trade, Industry and Energy.

Article 53 (Order of Examination and Preferential Examination)

- (1) Applications for trademark registration shall be examined in the order said applications were filed.
- (2) Notwithstanding paragraph (1), the Commissioner of the Korean Intellectual Property Office may require examiners to examine any of the following applications for trademark registration in preference to other applications for trademark registration:
  1. Where a person who is not an applicant is deemed to use a trademark identical or similar to the trademark for the registration of which an application has been filed on the same or similar designated goods as his/her business without justifiable grounds, after an application for trademark registration has been filed;
  2. Where urgent management of an application for trademark registration is deemed necessary, which is prescribed by Presidential Decree, because an applicant uses a trademark for the registration of which an application has been filed on all the designated goods.

#### Article 54 (Decision to Reject Trademark Registration)

Where an application for trademark registration falls under any of the following, an examiner shall decide to reject trademark registration:

1. Where a trademark fails to meet the definitions of a trademark, collective mark, geographical indication, collective mark with geographical indication, certification mark, certification mark with geographical indication, or business emblem under Article 2 (1);
2. Where a trademark is in violation of the treaty;
3. Where a trademark cannot be registered pursuant to Articles 3, 27, 33 through 35, 38 (1), the latter part of Article 48 (2), paragraph (4) or (6) through (8) of the aforesaid Article;
4. Where a person is not entitled to registration of a collective mark, certification mark and business emblem under Article 3;
5. In cases of an application for registration of a collective mark with geographical indication, the articles of incorporation of an organization actually do not permit persons to join the organization as its members, such as the prohibition of persons from joining the organization in accordance with the articles of incorporation, or impracticable conditions for joining the organization are stipulated in the articles of incorporation;
6. Where all or some of the matters concerning the use of a collective mark prescribed by Presidential Decree are not stated in the articles of incorporation under Article 36 (3), or all or some of the matters concerning the use of a certification mark prescribed by Presidential Decree are not stated in the articles of incorporation or the rules under paragraph (4) of the aforesaid Article;
7. In cases of an application for registration of a certification mark, the articles of incorporation actually do not permit persons who may use such certification mark to use it, such as the prohibition of persons from using it in accordance with the articles of incorporation or the rules without justifiable grounds, or impracticable conditions of use thereof are stipulated in the articles of incorporation or the rules.

#### Article 55 (Notification of Grounds for Rejection)

- (1) Where an examiner intends to decide to reject trademark registration pursuant to Article 54, he/she shall notify an applicant of grounds for rejection (referring to grounds provided in any of the subparagraphs of the aforesaid Article; hereinafter referred to as "grounds for rejection") in advance. In such cases, the applicant may submit a written opinion about grounds for rejection within a period prescribed by Ordinance of the Ministry of Trade, Industry and Energy.
- (2) Where an examiner notifies an applicant of grounds for rejection pursuant to paragraph (1), he/she shall specify the grounds and basis for rejection of each of the designated goods.
- (3) An applicant who fails to submit a written opinion within a period under the latter part of paragraph (2) may apply for continuing trademark-related procedures and submit a written opinion addressing the grounds for rejection within two months from the expiration date of such period.

#### Article 56 (Submission, etc. of Documents)

The Commissioner of the Korean Intellectual Property Office or an examiner may request a party to submit documents and other articles necessary for any procedure other than a procedure for trial or retrial.

#### Article 57 (Publication of Applications)

- (1) Where an examiner fails to discover any grounds for rejection of an application for trademark registration, he/she shall decide to publish such application: *Provided*, That in any of the following cases, he/she may omit a decision to publish the application:
  1. Where the applicant divides his/her application for trademark registration officially announced into at least two applications for trademark registration pursuant to Article 45 after a certified copy of a decision to publish the application under paragraph (2) is served on the applicant, in which case the examiner fails to discover any grounds for rejection of such divisional application;
  2. Where a trial decision to revoke a decision to reject trademark registration



- under Article 54 is made, in which case the relevant application for trademark registration has already been officially announced and the examiner fails to discover other grounds for rejection.
- (2) Where a decision under the main sentence of paragraph (1) is made, the Commissioner of the Korean Intellectual Property Office shall serve a certified copy of such decision on the applicant and publish the application for trademark registration in the Trademark Official Gazette.
  - (3) The Commissioner of the Korean Intellectual Property Office shall make an application for trademark registration and accompanying documents available for public inspection at the Korean Intellectual Property Office for two months from the date of publication of the application pursuant to paragraph (2).

Article 58 (Right to Claim Compensation for Loss)

- (1) An applicant may issue a warning in writing to a person who uses a trademark identical or similar to the trademark concerning the relevant application for trademark registration regarding goods identical or similar to designated goods concerning the relevant application for trademark registration after publication of the application under Article 57 (2) (including where it is applied *mutatis mutandis* pursuant to Articles 8 (2) and 123 (1)) is made: *Provided*, That where the applicant presents a copy of the relevant application for trademark registration, he/she may issue a written warning even before the application is published.
- (2) An applicant who has issued a warning pursuant to paragraph (1) may claim the payment of compensation equivalent to business loss incurred in relation to the use of the relevant trademark during the period after the issuance of a warning until trademark rights are established and registered.
- (3) No right to claim under paragraph (2) shall be exercised until trademark rights to the relevant application for trademark registration are established and registered.
- (4) No exercise of the right to claim under paragraph (2) shall affect the exercise of trademark rights.
- (5) Articles 91, 108, 113 and 114, and Articles 760 and 766 of the Civil Act

shall apply *mutatis mutadis* to the scope, etc. of protection of a registered trademark where the right to claim under paragraph (2) is exercised. In such cases, "date on which the injured party or his/her legal representative becomes aware of such loss and of the identity of the person who caused it" in Article 766 (1) of the Civil Act shall be construed as "date on which the relevant trademark rights are established and registered."

- (6) Where an application for trademark registration falls under any of the following, the right to claim under paragraph (2) shall be deemed never to have occurred:
  1. Where the application for trademark registration is abandoned, withdrawn, or invalidated;
  2. Where a decision to reject trademark registration under Article 54 on an application for trademark registration becomes final and conclusive;
  3. Where a trial decision to invalidate trademark registration pursuant to Article 117 (excluding cases falling under the provisions of paragraph (1) 5 through 7 of the aforesaid Article) becomes final and conclusive.

Article 59 (Ex Officio Amendment, etc.)

- (1) Where any matter mentioned in a written application for trademark registration is clearly incorrect when an examiner decides to publish an application under Article 57, he/she may make any amendments *ex officio* (hereinafter referred to as "*ex officio* amendment").
- (2) In order for an examiner to make *ex officio* amendments pursuant to paragraph (1), he/she shall notify the applicant of such *ex officio* amendments along with a certified copy of a decision to publish an application served under Article 57 (2).
- (3) Where an applicant cannot accept all or some of the *ex officio* amendments, he/she shall submit his/her written opinion thereon to the Commissioner of the Korean Intellectual Property Office within a period under Article 57 (3).
- (4) Where an applicant submits his/her written opinion pursuant to paragraph (3), all or some of the *ex officio* amendments shall be deemed never to have

existed. In such cases, a decision to publish such application shall be deemed revoked simultaneously.

#### Article 60 (Formal Objection)

- (1) Where an application is published, any person may file a formal objection with the Commissioner of the Korean Intellectual Property Office on the grounds that such application falls under any of the following within two months from the date of publication of the application:
  1. The application constitutes grounds for rejection of a decision to reject trademark registration under Article 54;
  2. The application constitutes grounds for rejection of a decision to reject additional registration under Article 87 (1).
- (2) Any person who intends to file a formal objection pursuant to paragraph (1) shall submit a formal objection stating the following to the Commissioner of the Korean Intellectual Property Office along with necessary evidence:
  1. Name and address of the applicant (in cases of a corporation, referring to its name and the seat of its place of business);
  2. Where there is an agent of an applicant, the name and address or the seat of the place of business of such agent (where an agent is a patent corporation or patent corporation (with limited liability), referring to its name, the seat of its place of business, and the name of a patent attorney designated);
  3. An application subject to formal objection;
  4. Matters against which a formal objection is filed;
  5. Grounds for filing a formal objection and citation of necessary evidence.

#### Article 61 (Amendment of Grounds, etc. for Filing Formal Objection)

A person who raises a formal objection (hereinafter referred to as "person who raises a formal objection") to trademark registration under Article 60 (1) may amend the grounds stated in a written formal objection and evidence within 30 days after the period for filing a formal objection expires.

#### Article 62 (Examination, etc. of Formal Objections)

- (1) A collegial body of examiners (hereinafter referred to as "collegial body

- of examiners") composed of three examiners shall examine and decide on a formal objection.
- (2) The Commissioner of the Korean Intellectual Property Office shall designate examiners to form a collegial body of examiners for each formal objection.
  - (3) The Commissioner of the Korean Intellectual Property Office shall designate the chief examiner from among examiners designated pursuant to paragraph (2).
  - (4) Articles 130 (2), 131 (2), and 132 (2) and (3) shall apply *mutatis mutandis* to a collegial body of examiners and the chief examiner. In such cases, "President of the Intellectual Property Trial and Appeal Board" shall be construed as "Commissioner of the Korean Intellectual Property Office," "judge" as "examiner," "trial decision" as "examination" under Article 130 (2), "presiding judge" as "chief examiner," and "case of trial decision" as "case of formal objection" under Article 131 (2), "collegial body of judges" as "collegial body of examiners" under Article 132 (2), and "trial decision" as "examination" under Article 132 (3), respectively.

#### Article 63 (Scope of Examination of Formal Objections)

A collegial body of examiners may also examine grounds not claimed by an applicant or a person who raises a formal objection concerning a formal objection. In such cases, it shall provide an applicant or a person who raises a formal objection with an opportunity to state his/her opinion on such grounds within a fixed period.

#### Article 64 (Consolidation or Division of Formal Objections)

A collegial body of examiners may examine or decide on at least two formal objections by consolidating or dividing them.

#### Article 65 (Competition in Formal Objections)

- (1) If at least two formal objections are raised, where a collegial body of examiners deems one formal objection is found to have reasonable grounds during examination thereof, he/she may choose not to decide on the remaining formal objections.

- (2) Where a collegial body of examiners fails to decide on a formal objection pursuant to paragraph (1), the Commissioner of the Korean Intellectual Property Office shall also serve a certified copy of a decision to reject trademark registration on the relevant person who has raised the formal objection.

Article 66 (Decision on Formal Objection)

- (1) Where a formal objection is raised, the chief examiner shall serve a duplicate copy of a formal objection on an applicant, and provide him/her with an opportunity to submit a written answer within a fixed period.
- (2) A collegial body of examiners shall decide on a formal objection after the period for raising a formal objection under paragraph (1) and Article 60 (1) expires.
- (3) A decision on a formal objection shall be made in writing, and grounds therefor shall be specified. In such cases, where grounds for a decision on at least two designated goods are mutually different, grounds for the decision on each of the designated goods shall be specified.
- (4) Where a person who raises a formal objection fails to submit grounds for the formal objection or evidence within the period for raising the formal objection under Article 60 (1), notwithstanding paragraph (1), a collegial body of examiners may dismiss the formal objection by decision after the period under Article 61 expires. In such cases, it shall serve a certified copy of such decision on the person who has raised the formal objection.
- (5) Where a decision under paragraph (2) is made, the Commissioner of the Korean Intellectual Property Office shall serve a certified copy of such decision on an applicant and a person who has raised a formal objection.
- (6) An applicant and a person who has raised a formal objection may appeal a decision under paragraphs (2) and (4) according to any of the following methods:
  1. Applicant: Request for a trial under Article 116;
  2. Person who has raised a formal objection: Request for a trial to invalidate trademark registration under Article 117.

Article 67 (Decision to Reject Trademark Registration Ex Officio after Publication of Application for Trademark Registration)

- (1) Where an examiner discovers grounds for rejection after publication of an

application, he/she may decide to reject trademark registration under Article 54 *ex officio*.

- (2) Where an examiner decides to reject trademark registration pursuant to paragraph (1), he/she shall not decide on a formal objection even if the formal objection is raised.
- (3) Where an examiner decides to reject trademark registration pursuant to paragraph (1), the Commissioner of the Korean Intellectual Property Office shall serve a certified copy of a decision to reject trademark registration on a person who has raised a formal objection.

#### Article 68 (Decision to Grant Trademark Registration)

Where an examiner fails to discover grounds for rejection of an application for trademark registration, he/she shall decide to grant trademark registration.

#### Article 69 (Methods to Decide Whether to Grant Trademark Registration)

- (1) All decisions on whether to grant trademark registration shall be made in writing, and grounds therefor shall be specified.
- (2) Where a decision on whether to grant trademark registration is made, the Commissioner of the Korean Intellectual Property Office shall serve a certified copy of such decision on the applicant.

#### Article 70 (Suspension of Procedures for Examination or Legal Proceedings)

- (1) Where necessary for examining an application for trademark registration, procedures for examination of such application for trademark registration may be suspended until a trial decision becomes final and conclusive or legal proceedings are completed.
- (2) Where necessary for litigation, the court may suspend legal proceedings until a decision on whether to grant trademark registration becomes final and conclusive.

#### Article 71 (Mutatis Mutandis Application of Trial Provisions to Examination of and Decision on Formal Objections)

The provisions of Article 128, subparagraphs 1 through 5 and 7 of Article 134, Article 144 and Articles 143, 299 and 367 of the Civil Procedure Act shall apply *mutatis mutandis* to the examination of and decision on formal objections.

## **CHAPTER IV TRADEMARK REGISTRATION FEES AND TRADEMARK REGISTRATION, ETC.**

### Article 72 (Trademark Registration Fees)

- (1) Any person who intends to obtain establishment and registration of any of the following trademark rights shall pay a trademark registration fee. In such cases, where registration falls under subparagraph 1 or 2, he/she may pay a trademark registration fee in two installments:
  1. Establishment and registration of trademark rights under Article 82;
  2. Registration to renew the duration of trademark rights;
  3. Registration of additional designated goods.
- (2) An interested party may pay a trademark registration fee, irrespective of the wishes of a person liable to pay a trademark registration fee under paragraph (1).
- (3) Matters necessary for trademark registration fees under paragraph (1), methods of the payment thereof, the period for payment, payment in installments, etc. shall be prescribed by Ordinance of the Ministry of Trade, Industry and Energy.

### Article 73 (Abandonment of Some of Designated Goods When Paying Trademark Registration Fees)

- (1) Where any of the following persons pays a trademark registration fee (where he/she pays the trademark registration fee in installments pursuant to the latter part of Article 72 (1), referring to the first installment of the trademark registration fee), he/she may abandon trademark registration for each of the designated goods:
  1. A person issued a decision to grant trademark registration in relation to an application for trademark registration containing at least two designated goods;
  2. A person who receives a decision to grant registration of additional designated goods in relation to an application for registration of additional

designated goods;

3. A person who files an application to register the renewal of the duration of trademark rights.

(2) Matters necessary for abandoning designated goods under paragraph (1) shall be prescribed by Ordinance of the Ministry of Trade, Industry and Energy.

#### Article 74 (Extension of Payment Period of Trademark Registration Fees)

The Commissioner of the Korean Intellectual Property Office may extend the payment period of trademark registration fees under Article 72 (3), by up to 30 days at the request of an applicant.

#### Article 75 (Abandonment of Applications due to Failure to Pay Trademark Registration Fees)

Where an applicant falls under any of the following, he/she shall be deemed to have abandoned an application for trademark registration, application for registration of additional designated goods or application to register the renewal of the duration of trademark rights:

1. Where he/she fails to pay the relevant trademark registration fee (where he/she pays the trademark registration fee in installments pursuant to the latter part of Article 72 (1), referring to the first installment of the trademark registration fee; hereinafter the same shall apply) within the payment period under Articles 72 (3) or 74;
2. Where he/she is ordered to pay the remainder of a trademark registration fee pursuant to Article 76 (1) but fails to do so within the period prescribed therefor;
3. Where he/she falls under Article 77 (1), in which case he/she fails to pay a trademark registration fee or pay the remainder of the trademark registration fee within the relevant period.

#### Article 76 (Payment of Remainder, etc. of Trademark Registration Fees)

(1) Any person who intends to obtain establishment and registration of trademark rights, registration of additional designated goods, or registration to renew the duration of trademark rights, or a trademark right holder fails to pay part of the trademark registration fee within the payment



period under Article 72 (3) or 74, the Commissioner of the Korean Intellectual Property Office shall order him/her to pay the remainder of the trademark registration fee.

- (2) Any person ordered to pay the remainder of the trademark registration fee pursuant to paragraph (1) may do so within one month (hereinafter referred to as "period for remainder payment") after he/she receives such order.
- (3) Any person who pays the remainder of the trademark registration fee pursuant to paragraph (2) shall pay an amount prescribed by Ordinance of the Ministry of Trade, Industry and Energy not exceeding double the unpaid amount.

Article 77 (Reinstatement, etc. of Application for Trademark Registration by Payment of Trademark Registration Fees or Remainder Payment)

- (1) Where any of the following persons fails to pay a trademark registration fee within the payment period under Article 72 (3) or 74, or to pay the remainder within the period for remainder payment under Article 76 (2) in extenuating circumstances, he/she may pay such trademark registration fee or pay the remainder within two months from the date such grounds cease to exist: *Provided*, That where one year has elapsed since the expiration of the period for payment or of the period for remainder payment, whichever occurs later, he/she shall not be able to pay the trademark registration fee or pay the remainder:
  1. An applicant for trademark registration;
  2. An applicant for registration of additional designated goods;
  3. An applicant to register the renewal of the duration of trademark rights, or a trademark right holder.
- (2) Notwithstanding Article 75, any person who has paid a trademark registration fee or paid a remainder (where he/she has paid a trademark registration fee in installments pursuant to the latter part of Article 72 (1), referring to a person who has paid the first installment of a trademark registration fee or paid the remainder thereof) pursuant to paragraph (1) shall not be deemed to have abandoned such application

for trademark registration, application for registration of additional designated goods or application to register the renewal of the duration of trademark rights.

- (3) Where an application for trademark registration, an application for registration of additional designated goods or a bundle of trademark rights (hereafter in this Article, referred to as "application for trademark registration, etc.") has been recovered pursuant to paragraph (2), such application for trademark registration, etc. shall not effect an act of using a trademark identical or similar to such trademark on goods identical or similar to such designated goods before the application for trademark registration, etc. is recovered after the period for payment under Article 72 (3) or 74 expires.

#### Article 78 (Fees)

- (1) Any person who follows trademark-related procedures shall pay fees: *Provided*, That where an examiner requests a trial to invalidate a trademark pursuant to Articles 117 (1) and 118 (1), he/she shall be exempted from the fees.
- (2) Matters necessary for fees under paragraph (1), methods of payment thereof, the period for the payment thereof, etc. shall be prescribed by Ordinance of the Ministry of Trade, Industry and Energy.
- (3) Any person who intends to file an application to register the renewal of the duration of trademark rights during the period under the proviso to Article 84 (2) shall pay fees under paragraph (2) in addition to an amount prescribed by Ordinance of the Ministry of Trade, Industry and Energy.

#### Article 79 (Refund of Trademark Registration Fees and Fees)

- (1) Where a trademark registration fee or a fee already paid falls under any of the following, the trademark registration fee or the fee under the following classification shall be refunded at the request of the person who has paid the trademark registration fee or the fee:
  1. Where the trademark registration fee or the fee is paid mistakenly: The trademark registration fee or the fee mistakenly paid;
  2. Where an application for trademark registration is withdrawn or abandoned

within one month such application for trademark registration is filed: An application fee for trademark registration and an application fee for priority claim among the fees already paid: *Provided*, That the foregoing shall not apply to the following applications:

- (a) Divisional applications, applications for modification, or applications for trademark registration which become the basis of divisional applications or applications for modification;
  - (b) Applications for preferential examination under Article 53;
  - (c) Applications for international trademark registration deemed applications for trademark registration under this Act pursuant to Article 180 (1));
3. Where a decision to dismiss an amendment or decision to reject an amendment is revoked pursuant to Article 156 (including where such decision is applied *mutatis mutandis* to procedures for retrial pursuant to Article 161, but excluding where there are amendments under the subparagraphs of Article 40 (1) and Article 41 (1) 1 among trials or retrials): A fee for requesting a trial among fees already paid (in cases of a retrial, referring to a fee for requesting a retrial; hereinafter the same shall apply);
  4. Where a request for a trial is dismissed by decision pursuant to Article 127 (2) and such decision becomes final and conclusive (including where such decision is applied *mutatis mutandis* to procedures for retrial pursuant to Article 161): An amount equivalent to half the fee for a request for a trial from among fees already paid;
  5. Where an application for intervention under Article 142 (1) is withdrawn before the completion of a trial is notified (including where such decision is applied *mutatis mutandis* to procedures for retrial pursuant to Article 161): An amount equivalent to half the fee for a request for intervention from among fees already paid;
  6. Where a request for intervention under Article 142 (1) is rejected by decision (including where such decision is applied *mutatis mutandis* to procedures for retrial pursuant to Article 161): An amount equivalent to

- half the fee for a request for intervention among fees already paid;
7. Where a request for a trial is withdrawn before the completion of a trial is notified (including where such decision is applied *mutatis mutandis* to procedures for retrial pursuant to Article 161): An amount equivalent to half the fee for a request for a trial among fees already paid.
  - (2) Where a trademark registration fee or fee already paid falls under any of the subparagraphs of paragraph (1), the Commissioner of the Korean Intellectual Property Office or the President of the Intellectual Property Trial and Appeal Board shall notify the person who has paid such fee of the fact.
  - (3) No claim for refund of a trademark registration fee or fee under paragraph (1) shall be filed if three years elapse from the date a person receives notification under paragraph (2).

#### Article 80 (Trademark Register)

- (1) The Commissioner of the Korean Intellectual Property Office shall keep the trademark register at the Korean Intellectual Property Office and register the following:
  1. The establishment, transfer, amendment, extinguishment, reinstatement, renewal of the duration of trademark rights, conversion of the classification of goods (hereinafter referred to as "conversion of the classification of goods") under Article 209, restrictions on addition or disposition of designated goods;
  2. The establishment, maintenance, transfer, amendment, extinguishment, or restrictions on disposition of an exclusive license or a non-exclusive license;
  3. The establishment, transfer, amendment, extinguishment, or restrictions on disposition of a pledge, the object of which is to acquire trademark rights, an exclusive license, or a non-exclusive license.
- (2) The trademark register under paragraph (1) may be prepared, fully or partially, by electronic recording media, etc.
- (3) In addition to matters prescribed in paragraphs (1) and (2), matters necessary for the items to be registered, procedures for registration, etc.

shall be prescribed by Presidential Decree.

Article 81 (Issuance of Trademark Registration Certificate)

- (1) Where trademark rights are established and registered, the Commissioner of the Korean Intellectual Property Office shall issue a trademark registration certificate to a trademark right holder.
- (2) Where a trademark registration certificate is inconsistent with the trademark register or other documents, the Commissioner of the Korean Intellectual Property Office shall withdraw such trademark registration certificate and issue a corrected trademark registration certificate or a new trademark registration certificate at the request of a trademark right holder or *ex officio*.

## **CHAPTER V TRADEMARK RIGHTS**

Article 82 (Registration and Establishment of Trademark Rights)

- (1) Trademark rights shall come into existence by obtaining trademark registration and establishing trademark rights.
- (2) The Commissioner of the Korean Intellectual Property Office shall grant trademark registration for the establishment of trademark rights, in any of the following cases:
  1. Where an applicant pays a trademark registration fee (where he/she pays the trademark registration fee in installments pursuant to the latter part of Article 72 (1), referring to the first installment of the trademark registration fee; hereafter in this paragraph, the same shall apply) pursuant to Article 72 (3) or 74;
  2. Where an applicant pays the remainder of the trademark registration fee pursuant to Article 76 (2);
  3. Where an applicant pays a trademark registration fee or pays the remainder thereof pursuant to Article 77 (1).
- (3) Where the Korean Intellectual Property Office grants trademark registration

pursuant to paragraph (2), he/she shall officially announce the trademark registration by publishing matters prescribed by Presidential Decree, such as the name, address of the trademark right holder and the trademark registration number, in the Trademark Official Gazette.

#### Article 83 (Duration of Trademark Rights)

- (1) The duration of trademark rights shall be ten years from the date of registration and establishment thereof pursuant to Article 82.
- (2) The duration of trademark rights may be renewed for another ten years by filing an application to register the renewal of the duration.
- (3) Notwithstanding paragraphs (1) and (2), in any of the following cases, trademark rights shall be extinguished where five years elapse from the date of registration and establishment of trademark rights or the date of registration to renew the duration:
  1. Where an applicant fails to pay a trademark registration fee (where he/she pays the trademark registration fee in installments pursuant to the latter part of Article 72 (1), referring to the second installment of the trademark registration fee; hereafter in the paragraph, the same shall apply) within the period for payment under pursuant to Article 72 (3) or 74;
  2. Where an applicant fails to pay the remainder of the trademark registration fee within the period for remainder payment despite being ordered to pay the remainder of the trademark registration fee pursuant to Article 76 (1);
  3. In cases falling under Article 77 (1), where an applicant fails to pay a trademark registration fee or pay the remainder thereof within the relevant period.

#### Article 84 (Application to Register Renewal of Duration of Trademark Rights)

- (1) Any person who intends to file an application to register the renewal of the duration of trademark rights pursuant to Article 83 (2) shall submit a written application to register the renewal of the duration of trademark rights stating the following to the Commissioner of the Korean Intellectual Property Office:

1. Matters under Article 36 (1) 1, 2, 4, and 6;
  2. Registration number of the registered trademark.
- (2) An application to register the renewal of the duration of trademark rights shall be filed within one year prior to the expiry of the duration of trademark rights: *Provided*, That any person who fails to apply for registering the renewal of the duration of trademark rights within this period may apply for registering the renewal of the duration of trademark rights within six months after the duration of trademark rights expires.
- (3) Where trademark rights are owned jointly, all of the joint owners shall jointly file an application to register the renewal of the duration of trademark rights.
- (4) In addition to matters prescribed in paragraphs (1) through (3), matters necessary to file an application to register the renewal of the duration of trademark rights shall be prescribed by Ordinance of the Ministry of Trade, Industry and Energy.

Article 85 (Effect of Application, etc. to Register Renewal of Duration of Trademark Rights)

- (1) Where an application to register the renewal of the duration of trademark rights is filed within the period under Article 84 (2), the duration of trademark rights shall be deemed renewed.
- (2) Registration to renew the duration of trademark rights shall take effect from the day following the date the effect of the original registration expires.

Article 86 (Application for Registration of Additional Designated Goods)

- (1) A trademark right holder or an applicant may obtain trademark registration by adding designated goods to the registered trademark or to the application for trademark registration. In such cases, the date of expiration of the duration of trademark rights of additionally registered designated goods shall be the expiration date of the duration of the registered trademark rights.
- (2) Any person who intends to obtain registration of additional designated

goods pursuant to paragraph (1) shall submit a written application for registration of additional designated goods stating the following to the Commissioner of the Korean Intellectual Property Office:

1. Matters under Article 36 (1) 1, 2, 5 and 6;
2. Trademark registration number, or application number for trademark registration;
3. Goods to be designated additionally and the category of such goods.

Article 87 (Decision to Reject Registration of Additional Designated Goods and Notification of Grounds for Rejection)

- (1) Where an application for registration of additional designated goods falls under any of the following, an examiner shall decide to reject registration of such additional designated goods:
  1. Where such application falls under Article 54;
  2. Where an applicant for registration of additional designated goods is not the relevant trademark right holder or the relevant applicant thereof;
  3. Where trademark rights of the registered trademark or an application for trademark registration fall(s) under any of the following:
    - (a) Extinguishment of trademark rights;
    - (b) Abandonment, withdrawal or invalidation of an application for trademark registration;
    - (c) Final and conclusive decision to reject trademark registration under Article 54 in relation to an application for trademark registration.
- (2) Where an examiner intends to decide to reject registration of additional designated goods pursuant to paragraph (1), he/she shall notify an applicant of grounds for rejection. In such cases, the applicant may submit a written opinion addressing grounds for rejection within a period prescribed by Ordinance of the Ministry of Trade, Industry and Energy.
- (3) An applicant who fails to submit a written opinion within a period under the latter part of paragraph (2) may request an examiner to proceed with procedures for registration of additional designated goods within two months from the expiration date of such period, and submit a written opinion about grounds for rejection within the period.



Article 88 (Provisions Applicable Mutatis Mutandis to Procedures for Filing Application to Register Renewal of Duration)

- (1) Article 39 shall apply *mutatis mutandis* to the amendment of procedures for filing an application to register the renewal of the duration of trademark rights.
- (2) Articles 37, 38 (1), 39 through 43, 46, 47, 50, 53, 57 through 70, 128, subparagraphs 1 through 5 and 7 of Article 134, Article 144, and Articles 143, 299, and 367 of the Civil Procedure Act shall apply *mutatis mutandis* to an application for registration of additional designated goods.

Article 89 (Effect of Trademark Rights)

A trademark right holder shall hold the exclusive right to use the registered trademark in relation to designated goods: *Provided*, That the foregoing shall not apply to the extent that a person has the exclusive right to use the registered trademark pursuant to Article 95 (3) when the exclusive right to use has been established on the trademark rights.

Article 90 (Extent on Which Trademark Rights Do not Have Effect)

- (1) Where trademark rights (excluding the right to a collective mark with geographical indication) fall under any of the following, trademark rights shall not effect the same:
  1. Any trademark using his/her own name, title, or trade name, portrait, signature, seal, or well-known pseudonym, stage name, pen name, and the well-known abbreviated title thereof, in accordance with generally accepted business practices;
  2. Any trademark indicating the common name, place of production, quality, raw materials, efficacy, uses, quantity, shape, price, or methods of production, methods of processing, methods of use and time of goods identical or similar to the designated goods of the registered trademark according to methods in common use;
  3. In cases of a trademark which consists of a three-dimensional shape provided in Article 9 (2), where it is impossible to recognize that such three-dimensional shape indicates goods related to whose business, any

- trademark which consists of the shape identical or similar to the three-dimensional shape of the registered trademark that is used on goods identical or similar to the designated goods of the registered trademark;
3. Any trademark used commonly on the goods identical or similar to the designated goods of the registered trademark, and trademark which consists of a distinguished geographical name and the abbreviated title thereof or a map;
  4. Any trademark which consists of a shape, color, combination of colors, sound or smell essential to secure the function of the designated goods of the registered trademark or the package thereof.
- (2) Where the right to a collective mark with geographical indication falls under any of the following, such right shall not effect the same:
1. Any trademark falling under paragraph (1) 1, 2 (excluding cases falling under place of production), or 4;
  2. Any trademark used commonly on goods deemed identical to the designated goods of the registered collective mark with geographical indication;
  3. Any geographical indication used on goods deemed identical to the designated goods of the registered collective mark with geographical indication, used by a person who engages in producing, manufacturing or processing such goods in the relevant region, or any other homonymous geographical indication;
  4. Where a trademark registered based on first to file contains a geographical indication identical or similar to a registered collective mark with geographical indication, any registered trademark used by the trademark right holder, an exclusive licensee or a non-exclusive licensee on the designated goods.
- (3) Paragraph (1) 1 shall not apply where a person uses his/her own name, title or trade name, portrait, signature, seal or well-known pseudonym, stage name, pen name and the well-known abbreviation thereof for the purpose of unfair competition after registration and establishment of

trademark rights.

Article 91 (Scope of Protection of Registered Trademarks, etc.)

- (1) The scope of protection of registered trademarks shall be determined by a trademark and items mentioned in an application for trademark registration.
- (2) The scope of protection of designated goods shall be determined by goods mentioned in an application for trademark registration or an application for registration of the conversion of the classification of goods.

Article 92 (Relationship to Design Rights, etc. of Other Persons)

- (1) Where a trademark right holder, an exclusive licensee or a non-exclusive licensee uses his/her registered trademark, in which case his/her use of the registered trademark is in conflict with another person's patent right, utility model right or design right for which the application was filed prior to the filing date of an application for such trademark registration or another person's copyright created prior to the filing date of an application for such trademark registration depending on how the trademark is used, he/she shall not use the registered trademark on designated goods in conflict with the relevant rights of others without the consent of the patentee, the holder of the utility model right, the holder of design right, or the holder of the copyright, respectively.
- (2) Where the use of the registered trademark constitutes an act of unfair competition under subparagraph 1 (j) of Article 2 of the Unfair Competition Prevention and Trade Secret Protection Act, a trademark right holder, an exclusive licensee or a non-exclusive licensee shall not use the registered trademark without the consent of others under the aforesaid item.

Article 93 (Transfer and Joint Ownership of Trademark Rights, etc.)

- (1) Trademark rights may be transferred by dividing it for each of the designated goods. In such cases, similar designated goods shall be transferred en bloc.
- (2) Where trademark rights are owned jointly, no joint owner may transfer his/her stake or establish a pledge on his/her stake without the consent of all of the other joint owners.

- (3) Where trademark rights are owned jointly, no joint owner may establish an exclusive license or a non-exclusive license on such trademark rights without the consent of all of the other joint owners.
- (4) No business emblem right shall be transferred: *Provided*, That the foregoing shall not apply where the business emblem right is transferred together with the relevant business.
- (5) No trademark rights registered pursuant to the proviso to Article 34 (1) 1 (c), the proviso to item (d) of the aforesaid subparagraph or the proviso to subparagraph 3 of the aforesaid paragraph shall be transferred: *Provided*, That the foregoing shall not apply where registered trademark rights are transferred together with affairs related to the title, abbreviation or mark under Article 34 (1) 1 (c), (d) or subparagraph 3 of the aforesaid paragraph.
- (6) No collective mark right shall be transferred: *Provided*, That in cases of a merger of corporations, a collective mark right may be transferred with the permission of the Commissioner of the Korean Intellectual Property Office.
- (7) No certification mark right shall be transferred: *Provided*, That a certification mark right may be transferred with the permission of the Commissioner of the Korean Intellectual Property Office where such certification mark right is transferred along with the relevant affairs to a person eligible to obtain registration of the relevant certification mark pursuant to Article 3-3.
- (8) No pledge the object of which is to acquire the business emblem right, trademark rights under the proviso to Article 34 (1) 1 (c), the collective mark right under the proviso to item (d) of the aforesaid subparagraph, or the certification mark right under the proviso to subparagraph (3) of the aforesaid paragraph shall be established.

#### Article 94 (Division of Trademark Rights)

- (1) Where there are at least two designated goods by trademark rights, such trademark rights may be divided for each of the designated goods.
- (2) Where a trial to invalidate a trademark under Article 117 (1) is requested,

trademark rights under paragraph (1) may be divided until a trial decision becomes final and conclusive even after the trademark rights are extinguished.

#### Article 95 (Exclusive License)

- (1) A trademark right holder may establish an exclusive license on others in relation to his/her trademark rights.
- (2) No exclusive license shall be established in relation to the business emblem right, the collective mark right, or the certification mark right.
- (3) An exclusive licensee who has obtained establishment of the exclusive license under paragraph (1) shall exclusively possess the license of the registered trademark on designated goods to the extent determined by the establishment of the exclusive license.
- (4) An exclusive licensee shall indicate his/her own name or title on the goods.
- (5) Except in cases of inheritance or other general succession, no exclusive licensee shall transfer the exclusive license without the consent of a trademark right holder.
- (6) No exclusive licensee shall establish a pledge, the object of which is to acquire an exclusive license, or a non-exclusive license without the consent of a trademark right holder.
- (7) Article 93 (2) and (3) shall apply *mutatis mutandis* to the transfer and joint ownership of the exclusive license.

#### Article 96 (Effect of Registration of Trademark Rights, etc.)

- (1) None of the following matters shall take effect unless they are registered:
  1. Transfer (excluding transfer by inheritance or other general succession), amendment, or extinguishment by abandonment of trademark rights, renewal of the duration, conversion of the classification of goods, addition of designated goods or restrictions on disposition of trademark rights;
  2. Establishment, transfer (excluding transfer by inheritance or other general succession), amendment, extinguishment (excluding cases arising due to confusion of trademark rights) or restrictions on disposition of the pledge,

the object of which is to acquire trademark rights.

- (2) In cases of inheritance of or other general succession to the trademark rights and the pledge under the subparagraphs of paragraph (1), the purpose thereof shall be immediately reported to the Commissioner of the Korean Intellectual Property Office.

Article 97 (Non-exclusive License)

- (1) A trademark right holder may establish a non-exclusive license on others pertaining to his/her trademark rights.
- (2) A non-exclusive licensee who has obtained establishment of the non-exclusive license under paragraph (1) shall have the right to use the registered trademark on the designated goods to the extent determined by the establishment of the non-exclusive license.
- (3) No non-exclusive license shall be transferred without the consent of a trademark right holder (in cases of the non-exclusive license relating to the exclusive license, referring to the trademark right holder and the exclusive licensee), except in cases of inheritance or other general succession.
- (4) No pledge the object of which is to acquire a non-exclusive license shall be established without the consent of a trademark right holder (in cases of the non-exclusive license relating to the exclusive license, referring to the trademark right holder and the exclusive licensee).
- (5) Articles 93 (2), 95 (2) and (4) shall apply *mutatis mutandis* to restrictions on the joint ownership and establishment of the non-exclusive license.

Article 98 (Right to Use Trademark after Expiration of Duration of Patent Rights, etc.)

- (1) Where patent rights registered after filing an application for the patent before the filing date of a trademark application or on the same date as the filing of a trademark application is in conflict with such trademark right, and the duration of the patent rights expires, the original patent right holder shall have the right to use a trademark identical or similar to such registered trademark on goods identical or similar to designated

- goods of the registered trademark to the extent of the original patent rights: *Provided*, That the foregoing shall not apply where the trademark is used for the purpose of unfair competition.
- (2) Where patent rights registered after filing an application for the patent before the filing date of a trademark application or on the same date as the filing of a trademark application is in conflict with such trademark rights, and the duration of the patent rights expires, a person who has the exclusive license on the patent rights which exist at the time the duration of the patent rights expires, or the non-exclusive license which has the effect under Article 118 (1) of the Patent Act on the patent rights or the exclusive license shall have the right to use a trademark identical or similar to such registered trademark on goods identical or similar to designated goods of the registered trademark to the extent of the original rights: *Provided*, That the foregoing shall not apply where the trademark is used for the purpose of unfair competition.
  - (3) Any person who has the right to use a trademark pursuant to paragraph (2) shall pay a reasonable price to the trademark right holder or the exclusive licensee.
  - (4) The relevant trademark right holder or the exclusive licensee may request a person who has the right to use the trademark pursuant to paragraph (1) or (2) to make an indication necessary to prevent confusion between goods concerning the business of the person and goods concerning his/her business.
  - (5) Where a person intends to transfer (excluding transfer by inheritance or other general succession) the right to use a trademark under paragraphs (1) and (2), he/she shall obtain the consent of the trademark right holder or the exclusive licensee.
  - (6) Where the utility model right or the design right registered after filing an application for registration thereof before the filing date of a trademark application or on the same date as the filing of a trademark application is in conflict with such trademark rights, in which case the duration of the

utility model right or the design right expires, the provisions of paragraphs (1) through (5) shall apply thereto.

Article 99 (Right to Continuously Use Trademark Based on First to Use)

(1) Any person who uses a trademark identical or similar to the registered trademark of another person on goods identical or similar to the designated goods, and meets the following requirements (including a person who succeeds to his/her position) shall have the right to continuously use the trademark on goods on which he/she uses the relevant trademark:

1. He/she shall have continuously used the trademark in the Republic of Korea before another person files an application for trademark registration without the intention of unfair competition;
2. Upon using the trademark pursuant to subparagraph 1, the trademark shall be recognized among consumers of the Republic of Korea to indicate the goods of a specific person at the time another person files an application for trademark registration.

(2) Any person who uses a means indicating the identity of his/her character, such as his/her name and trade name, as his/her trademark in accordance with generally accepted business practices, and meets requirements under paragraph (1) 1 shall have the right to continuously use the trademark on goods on which he/she uses the relevant trademark.

(3) The trademark right holder or the exclusive licensee may request a person who has the right to use the trademark pursuant to paragraph (1) to make an indication necessary to prevent the misunderstanding or confusion of the source between goods of the person and his/her goods.

Article 100 (Effect of Registration of Exclusive License, Non-Exclusive License, etc.)

(1) None of the following matters shall be effective against third parties unless they are registered:

1. Establishment, transfer (excluding transfer by inheritance or other general succession), amendment, extinguishment by abandonment or restrictions on



- disposition of the exclusive license or the non-exclusive license;
2. Establishment, transfer (excluding transfer by inheritance or other general succession), amendment, extinguishment by abandonment or restrictions on disposition of a pledge, the object of which is to acquire the exclusive license or the non-exclusive license.
  - (2) Where the exclusive license or the non-exclusive license is registered, it shall also have the effect on any person who acquires the trademark rights or the exclusive license after registration thereof.
  - (3) In cases of inheritance of or other general succession to the exclusive license, the non-exclusive license and the pledge under the subparagraphs of paragraph (1), the purpose thereof shall be immediately reported to the Commissioner of the Korean Intellectual Property Office.

#### Article 101 (Relinquishment of Trademark Rights)

The trademark right holder may relinquish trademark rights for each of the designated goods.

#### Article 102 (Restrictions on Relinquishment of Trademark Rights, etc.)

- (1) No trademark right holder shall relinquish trademark rights without the consent of the exclusive licensee, the non-exclusive licensee, or the pledgee.
- (2) No exclusive licensee shall relinquish the exclusive license without the consent of the pledgee or the non-exclusive licensee under Article 95 (6).
- (3) No non-exclusive licensee shall relinquish the non-exclusive license without the consent of the pledgee under Article 97 (4).

#### Article 103 (Effect of Relinquishment)

Where trademark rights, exclusive license, non-exclusive license, or pledge is relinquished, the trademark rights, exclusive license, non-exclusive license, or pledge shall be extinguished henceforth.

#### Article 104 (Pledge)

Where a pledge whose objective is to acquire trademark rights, an exclusive license, or a non-exclusive license is established, no pledgee shall use the relevant trademark rights.

#### Article 105 (Subrogation of Pledge)

A pledge may also be exercised on the price to be paid or goods to be delivered for the use of trademark rights under this Act: *Provided*, That the price or goods shall be seized before the price is paid or goods are delivered.

#### Article 106 (Extinguishment of Trademark Rights)

- (1) Where a successor fails to obtain transfer registration of the trademark rights within three years after the decease of the trademark right holder, the trademark rights shall be extinguished on the day following the date on which three years elapse after the decease of the trademark right holder.
- (2) Where a transfer registration of the trademark rights of a corporation whose liquidation procedures are being performed is not obtained by the date of registration of the completion of the liquidation of such corporation (where the process of liquidation is not substantially completed even if registration of the completion of liquidation is obtained, referring to the earlier of the date the process of liquidation is substantially completed and the date six months elapse from the date of registration of the completion of the liquidation; hereafter in this paragraph, the same shall apply), the trademark rights shall be extinguished on the day following the date of registration of the completion of liquidation.

## **CHAPTER VI PROTECTION OF TRADEMARK RIGHT HOLDERS**

#### Article 107 (Right to Seek Injunction, etc. against Infringement)

- (1) A trademark right holder or an exclusive licensee may seek an injunction requesting the prohibition or prevention of infringement against a person who infringes or is likely to infringe on his/her right.
- (2) Where a trademark right holder or an exclusive licensee makes a request

under paragraph (1), he/she may request the destruction of infringing goods, the removal of facilities provided for infringement, or other necessary measures.

- (3) Where a lawsuit requesting the prohibition or prevention of infringement under paragraph (1) is brought, the court may provisionally order an injunction on infringement, confiscation of goods, etc. used for infringement, or other necessary measures at the request of the plaintiff or complainant (limited to where a case is prosecuted pursuant to this Act). In such cases, the court may require the plaintiff or complainant to provide security.

#### Article 108 (Acts Deemed Infringement)

- (1) The following shall be deemed infringement of trademark rights (excluding the right to collective mark with geographical indication) or an exclusive license:
  1. Using a trademark identical to a registered trademark of another person on goods 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;
  2. Delivering, selling, forging, imitating, or possessing a trademark identical or similar to a registered trademark of another person for the purpose of using or causing a third party to use such trademark on goods identical or similar to the designated goods;
  3. Manufacturing, delivering, selling or possessing equipment for the purpose of forging or imitating a registered trademark of another person or causing a third party to forge or imitate such registered trademark;
  4. Possessing goods identical or similar to the designated goods bearing a registered trademark of another person or any other similar trademark for the purpose of transferring or delivering such goods.
- (2) The following shall be deemed infringement of the right to a collective mark with geographical indication:
  1. Using a trademark (excluding a homonymous geographical indication);

hereafter in this paragraph, the same shall apply) similar to a registered collective mark with geographical indication of another person on goods deemed identical to the designated goods;

2. Delivering, selling, forging, imitating or possessing a trademark identical or similar to the registered collective mark with geographical indication of another person for the purpose of using or causing a third party to use such trademark on goods deemed identical to the designated goods;
3. Manufacturing, delivering, selling or possessing equipment for the purpose of forging or imitating, or causing a third person to forge or imitate the registered collective mark with geographical indication of another person;
4. Possessing goods deemed identical to designated goods bearing a trademark identical or similar to the registered collective mark with geographical indication for the purpose of transferring or delivering such goods.

#### Article 109 (Claim for Damages)

A trademark right holder or an exclusive licensee may claim damages he/she has incurred against a person who has wilfully or negligently infringed his/her trademark rights or exclusive license.

#### Article 110 (Estimation, etc. of Damages)

- (1) Where a person who has committed infringement transfers infringing goods to a trademark right holder or an exclusive licensee claiming damages under Article 109, the amount obtained by multiplying the transferred quantity of such goods by the amount of profit per unit quantity of goods such trademark right holder or exclusive licensee may have sold unless the person has committed infringement may be regarded as the amount of damages the trademark right holder or the exclusive licensee has incurred.
- (2) The amount obtained by multiplying the quantity calculated by subtracting the quantity of goods a trademark right holder or an exclusive licensee has actually sold from the quantity of goods he/she may have produced by the amount of profit per unit quantity shall be the maximum amount of damages under paragraph (1): *Provided*, That where the trademark right

holder or the exclusive licensee could not sell his/her goods for reasons other than the relevant infringement, the amount based on the quantity he/she could not sell for reasons other than the relevant infringement shall be deducted.

- (3) Where a person who has committed infringement gains profits attributable to the infringement when a trademark right holder or an exclusive licensee claims damages under Article 109, such profits shall be estimated as the amount of damages the trademark right holder or the exclusive licensee has incurred.
- (4) Where a trademark right holder or an exclusive licensee claims damages under Article 109, he/she may claim damages by estimating an amount equivalent to that he/she may normally receive from the use of the registered trademark as the amount of damages he/she has incurred.
- (5) Notwithstanding paragraph (4), where an amount of damages exceeds an amount prescribed in the aforesaid paragraph, a trademark right holder or an exclusive licensee may also claim damages on the excess amount. In such cases, where the person has not infringed on a trademark right or an exclusive license wilfully or by gross negligence, the court may take such fact into consideration when calculating the amount of damages.
- (6) Where the court recognizes that a trademark right holder or an exclusive licensee has incurred damages in a lawsuit regarding the infringement on a trademark right or exclusive license, but it is difficult for the court to verify the facts necessary to prove the amount of such damages in the nature of the truth, notwithstanding paragraphs (1) through (5), the court may recognize a reasonable amount of damages on the basis of the meaning of all pleadings and the result of the examination of evidence.

#### Article 111 (Claim for Legal Damages)

- (1) A trademark right holder or an exclusive licensee may claim compensation for a reasonable amount to the extent not exceeding 50 million won, in lieu of claiming damages under Article 109 against a person who has wilfully or negligently infringed his/her trademark right or exclusive

license by using a trademark identical or similar to the registered trademark he/she uses on goods identical or similar to the designated goods. In such cases, the court may recognize a reasonable amount of damages in consideration of the meaning of all pleadings and the result of the examination of evidence.

- (2) A trademark right holder or an exclusive licensee who has filed a claim for damages against infringement corresponding to the former part of paragraph (1) pursuant to Article 109 may change such claim into the claim under paragraph (1) until the court closes pleadings.

#### Article 112 (Presumption of Willfulness)

Any person who has infringed trademark rights or an exclusive license of another person who indicates that it is a registered trademark pursuant to Article 222 shall be presumed to have been aware that the trademark was already registered, in relation to his/her infringement.

#### Article 113 (Recovery of Reputation of Trademark Right Holder, etc.)

The court may order a person who has damaged business reputation of a trademark right holder or an exclusive licensee by wilfully or negligently infringing the trademark rights or the exclusive license to pay damages at the request of the trademark right holder or the exclusive licensee, or order the person to take measures necessary to reinstate the business reputation of the trademark right holder or the exclusive licensee along with compensation for damages.

#### Article 114 (Submission of Documents)

In a lawsuit regarding infringement of a trademark right or an exclusive license, the court may order the other party to submit documents necessary to calculate damages caused by infringement at the request of one party: *Provided*, That the foregoing shall not apply where a person who possesses such documents has justifiable grounds for refusing to submit the documents.

## CHAPTER VII TRIAL

### Article 115 (Trial against Decision to Dismiss Amendment)

Where a person who receives a decision to dismiss an amendment under Article 42 (1) appeals against such decision, he/she may request a trial within 30 days from the date he/she is served with a certified copy of such decision.

### Article 116 (Trial against Decision to Reject)

Where a person who receives a decision to reject trademark registration, decision to reject registration of additional designated goods or decision to reject registration of the conversion of the classification of goods (hereinafter referred to as "decision to reject") under Article 54 appeals against such decision, he/she may request a trial within 30 days from the date he/she is served with a certified copy of such decision to reject.

### Article 117 (Trial to Invalidate Trademark Registration)

- (1) Where trademark registration or registration of additional designated goods falls under any of the following, an interested party or an examiner may request a trial to invalidate such trademark registration. In such cases, where at least two designated goods bearing the registered trademark exist, he/she may request a trial to invalidate the relevant trademark registration for each of the designated goods:
1. Where trademark registration or registration of additional designated goods violates Articles 3, 27, 33 through 35, the latter part of Article 48 (2), Article 48 (4) and (6) through (8), and subparagraphs 1, 2 and 4 through 7 of Article 54;
  2. Where trademark registration or registration of additional designated goods is obtained by a person who fails to succeed to the right arising from an application for such trademark registration;
  3. Where registration of additional designated goods violates Article 87 (1) 3;
  4. Where trademark registration or registration of additional designated goods

violates the treaty;

5. Where a trademark right holder becomes ineligible to enjoy the trademark rights pursuant to Article 27 after the trademark is registered or such registered trademark violates the treaty;
  6. Where a registered trademark falls under Article 33 (1) after the trademark is registered (excluding cases falling under paragraph (2) of the aforesaid Article);
  7. Where a geographical indication which constitutes a registered collective mark is no longer protected or used in the country of origin after the collective mark with geographical indication is registered pursuant to Article 82.
- (2) A trial to invalidate a trademark under paragraph (1) may be requested even after the trademark rights are extinguished.
  - (3) Where a trial decision to invalidate trademark registration becomes final and conclusive, such trademark rights shall be deemed never to have existed: *Provided*, That where the trial decision to invalidate the trademark registration becomes final and conclusive pursuant to the provisions of paragraph (1) 5 through 7, the trademark rights shall be deemed not to have existed from the time when the registered trademark falls under the same subparagraph.
  - (4) Where the proviso to paragraph (3) is applied, if it is impossible to specify the time when a registered trademark falls under paragraph (1) 5 through 7, the relevant trademark rights shall be deemed to have not existed from the time when a trial to invalidate trademark registration under paragraph (1) is requested and the content of the trial is officially announced on the original register.
  - (5) Where a trial to invalidate trademark registration under paragraph (1) is requested, the presiding judge shall notify the exclusive licensee of the relevant trademark rights and other persons who have registered rights to the trademark of the purpose thereof.

Article 118 (Trial to Invalidate Registration to Renew Duration of Trademark



### Rights)

- (1) Where registration to renew the duration of trademark rights falls under any of the following, an interested party or an examiner may request a trial to invalidate such renewal registration. In such cases, where at least two designated goods bearing a registered trademark renewed exist, he/she may request a trial to invalidate such renewal registration for each of the designated goods:
  1. Where registration to renew the duration of trademark rights violates Article 84 (2);
  2. Where a person who is not the relevant trademark right holder files an application to register the renewal of the duration of the trademark rights.
- (2) A trial to invalidate a renewal registration under paragraph (1) may be requested even after the trademark rights are extinguished.
- (3) Where a trial decision to invalidate registration to renew the duration of trademark rights becomes final and conclusive, such renewal registration shall be deemed never to have existed.
- (4) Where a trial under paragraph (1) is requested, the presiding judge shall notify the exclusive licensee of the relevant trademark rights and other persons who have registered rights to the trademark of the purpose thereof.

### Article 119 (Trial to Revoke Trademark Registration)

- (1) Where a registered trademark falls under any of the followings, a trial to revoke the trademark registration may be requested:
  1. Where a trademark right holder causes the misunderstanding of the quality of goods or confusion with goods related to another person's business among consumers by wilfully using a trademark similar to the registered trademark on the designated goods, or using the registered trademark or a similar trademark on goods similar to the designated goods;
  2. Where an exclusive licensee or a non-exclusive licensee causes the misunderstanding of the quality of goods or confusion with goods related to another person's business by using a registered trademark or a

trademark similar to the registered trademark on the designated goods, or goods similar to the designated goods: *Provided*, That the foregoing shall not apply where the trademark right holder pays considerable attention;

3. Where none of a trademark right holder, an exclusive licensee or a non-exclusive licensee has used the registered trademark on the designated goods in the Republic of Korea for at least three consecutive years without justifiable grounds before a trial to revoke the registered trademark is requested;
4. Where the registered trademark violates the latter part of Article 93 (1), and paragraphs (2), and (4) through (7) of the aforesaid Article;
5. Where similar registered trademarks belong to different respective trademark right holders due to the transfer of the trademark rights, and one of them causes the misunderstanding of the quality of goods or confusion with goods related to another person's business among consumers by using his/her trademark on goods identical or similar to the designated goods bearing his/her trademark for the purpose of unfair competition;
6. Where a person who has the right to the registered trademark falling under Article 92 (2) requests a trial to revoke the trademark registration within five years from the date the relevant trademark is registered;
7. Where a collective mark falls under any of the following:
  - (a) Where a member of the organization allows another person to use its collective mark in violation of its articles of incorporation, or causes the misunderstanding of the quality of goods or the source of a geographical indication, or confusion with goods related to another person's business among consumers by using its collective mark in violation of its articles of incorporation: *Provided*, That the foregoing shall not apply where the holder of the collective mark right pays due attention to supervise its members;
  - (b) Where the organization is likely to cause the misunderstanding of the quality of goods or confusion with goods related to another person's

business among consumers by amending its articles of incorporation under Article 36 (3) after it registers its collective mark and establishes its collective mark right;

- (c) Even where a third party causes the misunderstanding of the quality of goods or the source of a geographical indication, or confusion with goods related to another person's business among consumers by using its collective mark, the holder of the collective mark right willfully fails to take appropriate measures;
8. Where a collective mark with geographical indication falls under any of the following:
- (a) In cases of an application for registration of a collective mark with geographical indication, where the articles of incorporation of the organization actually prevents persons from joining the organization, such as prohibiting them from joining the organization or stipulating impracticable conditions for joining the organization, or allow a person ineligible to use such geographical indication to join the organization;
  - (b) Where the holder of a collective mark right with geographical indication or a member of the organization causes the misunderstanding of the quality of goods or confusion on the source of the geographical indication by using the collective mark in violation of Article 223;
9. Where a certification mark falls under any of the following:
- (a) Where the holder of the certification mark right permits the use of the certification mark, in violation of the articles of incorporation or the rules submitted pursuant to Article 36 (4);
  - (b) Where the holder of the certification mark right uses the certification mark on his/her own goods, in violation of the proviso to Article 3-3;
  - (c) Where a person permitted to use the certification mark right allows another person to use such mark, in violation of the articles of incorporation or the rules, or causes confusion concerning the quality of goods, the place of origin, methods of production or other characteristics among consumers by using the certification mark in

violation of the articles of incorporation or the rules: *Provided*, That the foregoing shall not apply where the holder of the certification mark right pays due attention to supervise any person permitted to use the certification mark;

- (d) Where the holder of the certification mark right fails to make appropriate measures though he/she is aware that a third party who fails to obtain permission to use the certification mark causes confusion concerning the quality of goods, the place of origin, methods of production or other characteristics among consumers by using the certification mark;
  - (e) Where the holder of the certification mark right actually prevents a person eligible to use the certification mark right from using the certification mark right without justifiable grounds in accordance with the articles of incorporation or the rules, or stipulates impracticable conditions for using the certification mark right in the articles of incorporation or the rules.
- (2) Where at least two designated goods bearing the registered trademark exist when a trial to revoke trademark registration is requested on the grounds that the registered trademark falls under paragraph (1) 3, a trial to revoke trademark registration may be requested in relation to some of the designated goods.
- (3) Where a trial to revoke trademark registration is requested on the grounds that the registered trademark falls under paragraph (1) 3, no trademark right holder may be exempted from the revocation of trademark registration for the designated goods related to such lawsuit unless the requested person proves that he/she has legitimately used the relevant registered trademark on at least one designated goods related to the trial to revoke trademark registration in the Republic of Korea within three years before the date the trial is requested: *Provided*, That the foregoing shall not apply where the requested person has proved justifiable grounds for using a registered trademark which he/she has not used.

- (4) Even if the fact that constitutes grounds for requesting a trial of revocation ceases to exist after the trial has been requested on the grounds falling under paragraph (1) (excluding subparagraphs 4 and 6 of the same paragraph), the absence thereof shall not affect the grounds for revocation.
- (5) Any person may request a trial to revoke trademark registration under paragraph (1): *Provided*, That a trial to revoke trademark registration on the grounds that the registered trademark falls under paragraph (1) 4 and 6 may be requested by an interested person only.
- (6) Where a trial decision to revoke trademark registration becomes final and conclusive, such trademark rights shall be extinguished henceforth: *Provided*, That where the trial decision to revoke the trademark registration on the grounds that the registered trademark falls under paragraph (1) 3 becomes final and conclusive, the trademark rights shall be deemed extinguished on the date the trial is requested.
- (7) Where a trial to revoke trademark registration under paragraph (1) is requested, the presiding judge shall notify the exclusive licensee of the relevant trademark rights and other persons who have registered rights to the trademark of the purpose thereof.

Article 120 (Trial to Revoke Registration of Exclusive License or Non-Exclusive License)

- (1) Where an exclusive licensee or a non-exclusive licensee commits an act falling under Article 119 (1) 2, the trademark right holder may request a trial to revoke registration of such exclusive license or non-exclusive license.
- (2) Even if a fact that constitutes grounds for requesting a trial to revoke registration of an exclusive license or a non-exclusive license ceases to exist after the trademark right holder files such lawsuit pursuant to paragraph (1), the non-existence of such fact shall not have an influence on grounds for revocation.
- (3) Any person may request a trial to revoke an exclusive license or a

non-exclusive license under paragraph (1).

- (4) Where a trial decision to revoke registration of an exclusive license or a non-exclusive license becomes final and conclusive, such exclusive license or non-exclusive license shall be extinguished from that time.
- (5) Where any person requests a trial to revoke registration under paragraph (1), the presiding judge shall notify the non-exclusive licensee of the relevant exclusive license, the right holder who has registered other exclusive license, or the right holder who has registered the relevant non-exclusive license of the purpose thereof.

#### Article 121 (Trial to Confirm Scope of Rights)

A trademark right holder, an exclusive licensee, or an interested party may request a trial to confirm the scope of rights of trademark rights to confirm the scope of rights of the registered trademark. In such cases, where at least two designated goods bearing the registered trademark exist, any of the aforesaid persons may request a trial to confirm the scope of rights for each of the designated goods.

#### Article 122 (Period of Exclusion)

- (1) No trial to invalidate trademark registration, registration to renew the duration of trademark rights, or registration of the conversion of the classification of goods on the grounds that the registered trademark falls under Article 34 (1) 6 through 10 and 16, Articles 35, 118 (1) 1 and 214 (1) 3 shall be requested after five years elapse from the date of trademark registration, the date of registration to renew the duration of the trademark rights, or the date of registration of the conversion of the classification of goods.
- (2) No trial to revoke trademark registration or registration of an exclusive license or non-exclusive license on the grounds that the trademark falls under Articles 119 (1) 1, 2, 5, 7 through 9 and 120 (1) shall be requested after three years elapse from the date the fact that constitutes grounds for revocation ceases to exist.

#### Article 123 (Mutatis Mutandis Application of Examination Provisions to Trial against Decision to Reject Trademark Registration )

- (1) Articles 41, 42, 45, 55, 57 through 68, 87 (2) and (3) and 210 (2) and (3) shall apply *mutatis mutandis* to trials against a decision to reject trademark registration under Article 54. In such cases, Article 57 shall not apply *mutatis mutandis* to cases where an application for trademark registration or application for registration of additional designated goods has already been announced officially.
- (2) Where Article 42 is applied *mutatis mutandis* pursuant to paragraph (1), "Where a person files a lawsuit pursuant to Article 115" in Article 42 (3) shall be construed as "where a lawsuit is commenced pursuant to Article 162 (1)," and "until the trial decision becomes final and conclusive" shall be construed as "until the judgment becomes final and conclusive," respectively.
- (3) Articles 42 (4) and (5), 55, 87 (2) and (3), and 210 (2) and (3) applied *mutatis mutandis* pursuant to paragraph (1) shall also apply *mutatis mutandis* where grounds for decision to reject the relevant trademark registration and other grounds for rejection are discovered.

Article 124 (Request, etc. for Joint Trial)

- (1) Where at least two persons request any of the following trials on the same trademark rights, they may severally or jointly request a trial:
  1. A trial to invalidate trademark registration under Article 117 (1) or registration to renew the duration of trademark rights under Article 118 (1);
  2. A trial to revoke trademark registration under Article 119 (1);
  3. A trial to revoke registration of an exclusive license or a non-exclusive license under Article 120 (1);
  4. A trial to confirm the scope of rights under Article 121;
  5. A trial to invalidate registration of the conversion of the classification of goods.
- (2) Where a person requests a trial against the holder of a trademark right under joint ownership, he/she shall file a lawsuit against all of the joint owners requested.
- (3) Notwithstanding paragraph (1), where a joint owner of the trademark rights

or the right to obtain trademark registration requests a trial concerning the rights under joint ownership, all of the joint owners shall file such lawsuit.

- (4) Where the cause for the interruption or the suspension of trial proceedings lies in a requester under paragraph (1) or (3), or one of the requested persons under paragraph (2), such interruption or suspension shall take effect on all of them.

Article 125 (Methods of Requesting Trials, such as Trial to Invalidate Trademark Registration, etc.)

- (1) Any person who intends to request a trial under the provisions of Articles 117 through 121 shall submit a written request therefor stating the following to the President of the Intellectual Property Trial and Appeal Board:
  1. Name and address of the party (in cases of a corporation, referring to its name and the seat of its place of business);
  2. Where the party has appointed an agent, the name and address of his/her agent or the seat of the place of business of his/her agent (where his/her agent is a patent corporation or patent corporation (with limited liability), referring to its name, the seat of its office and the name of a designated patent attorney);
  3. Indication of the case at trial;
  4. Purpose of and grounds for the request.
- (2) Where a person amends a written request for a trial submitted pursuant to paragraph (1), he/she shall not amend the purpose thereof: *Provided*, That the foregoing shall not apply where an amendment falls under any of the following:
  1. Where an amendment (including an addition) is made to correct items mentioned by a trademark right holder among the parties under paragraph (1) 1;
  2. Where grounds for a request made under paragraph (1) 4 are amended;
  3. Where a requester amends a trademark subject to confirmation under a written request for a trial and goods bearing such trademark to make such trademark and goods identical to the trademark used by a requested



person and goods bearing the trademark when the requested person claims that the trademark he/she actually uses and goods bearing the trademark are different from the trademark subject to confirmation under the written request for a trial and goods bearing the trademark (referring to the trademark and goods bearing the trademark of the requested person claimed by the requester) in a trial to confirm the scope of rights requested by a trademark right holder or an exclusive licensee pursuant to Article 121.

- (3) Where a person requests a trial to confirm the scope of rights under Article 121, he/she shall submit a sample of a trademark and a list of goods bearing such trademark to compare with the registered trademark.

Article 126 (Methods of Request for Trial against Decision, etc. to Dismiss Amendments)

- (1) Any person who intends to request a trial against a decision to dismiss an amendment under Article 115 or on a decision to reject under Article 116 shall submit a written request for a trial stating the following, to the President of the Intellectual Property Trial and Appeal Board:
1. Name and address of the requester (in cases of a corporation, referring to its name and the seat of its place of business);
  2. Where the requester has appointed an agent, the name and address of his/her agent or the seat of the place of business of his/her agent (where his/her agent is a patent corporation or patent corporation (with limited liability), referring to its name, the seat of its office and the name of a designated patent attorney);
  3. The filing date of the application and the application number;
  4. Designated goods and the category of designated goods;
  5. The date of decision to reject or the date of decision to dismiss an amendment made by an examiner;
  6. Indication of the case at trial;
  7. Purpose of and grounds for the request.
- (2) Where a person makes an amendment to a written request for a trial

submitted pursuant to paragraph (1), he/she shall not amend the purpose thereof: *Provided*, That the foregoing shall not apply where an amendment falls under any of the following:

1. Where he/she makes an amendment (including an addition) to correct items mentioned by a requester under paragraph (1) 1;
2. Where he/she makes an amendment to grounds for request under paragraph (1) 7.
- (3) Where a person requests a trial against a decision to reject under Article 116, the President of the Intellectual Property Trial and Appeal Board shall notify a person who has filed a formal objection of the purpose of such decision to reject when the decision to make the rejection is made due to a formal objection.

Article 127 (Dismissal of Request for Trial, etc.)

- (1) Where a written request falls under any of the following, the presiding judge shall require a requester to make an amendment with a fixed period:
  1. Where a written request violates Article 125 (1), (3) or 126 (1);
  2. Where trial proceedings fall under any of the following:
    - (a) Trial proceedings violate Article 4 (1) or 7;
    - (b) Where a requester fails to pay a fee payable pursuant to Article 78;
    - (c) Trial proceedings violate a method prescribed by this Act or an order under this Act.
- (2) Where a person ordered to make an amendment under paragraph (1) fails to make an amendment within a designated period or any matters amended violate Article 125 (2) or 126 (2), the presiding judge shall dismiss a written request or a request related to the relevant procedures by decision.
- (3) A decision under paragraph (2) shall be made in writing and grounds for such decision shall be specified.

Article 128 (Dismissal of Trial Decision on Request for Trial Unamendable)

Notwithstanding Article 133 (1), where it is impossible to amend an unlawful

defect in a request for a trial, the presiding judge may dismiss such request through a trial decision without providing a requested person with an opportunity to submit a written answer.

#### Article 129 (Judges)

- (1) The President of the Intellectual Property Trial and Appel Board shall require judges to make a trial decision if a trial is requested.
- (2) Qualification of judges shall be prescribed by Presidential Decree.
- (3) Judges shall make trial decisions independently.

#### Article 130 (Designation of Judges)

- (1) The President of the Intellectual Property Trial and Appel Board shall designate judges to form a collegial body (hereinafter referred to as "collegial body of judges") under Article 132 on each trial case.
- (2) Where any judge is unable to participate in a trial among judges under paragraph (1), the President of the Intellectual Property Trial and Appel Board may require another judge to make a trial decision.

#### Article 131 (Presiding Judge)

- (1) The President of the Intellectual Property Trial and Appel Board shall designate one person among the judges designated pursuant to Article 130 (1) as the presiding judge.
- (2) The presiding judge shall preside over affairs concerning each case at trial.

#### Article 132 (Collegial Body of Judges)

- (1) A collegial body of judges comprised of three or five judges shall make a trial.
- (2) Agreement of a collegial body of judges under paragraph (1) shall be reached by majority decision.
- (3) No agreement in a trial shall be disclosed.

#### Article 133 (Submission, etc. of Written Answer)

- (1) Where a person requests a trial, the presiding judge shall serve a duplicate copy of a written request on a requested person and provide him/her with an opportunity to submit his/her written answer within a fixed period.
- (2) Where the presiding judge receives a written answer under paragraph (1), he/she shall serve a duplicate copy of the written answer on a requester.

(3) The presiding judge may examine each party concerning a trial.

#### Article 134 (Exclusion of Judges)

Where a judge falls under any of the following, he/she shall be excluded from the trial:

1. Where a judge or person who is or was his/her spouse is a party of, an intervenor in or a person who raises a formal objection in the case;
2. Where a judge is or was a relative of a party of, an intervenor in or a person who raises a formal objection in the case;
3. Where a judge is or was a legal representative of a party of, an intervenor in or a person who raises a formal objection to the case;
4. Where a judge bears witness to the case or is or was an expert witness of the case;
5. Where a judge is or was an agent of a party of, an intervenor in or a person who raises a formal objection to the case;
6. Where a judge has participated in a decision on whether to grant trademark registration, or decision or trial decision on a formal objection as a judge or examiner in relation the case;
7. Where a judge has direct interests in the case.

#### Article 135 (Application for Exclusion)

Where a cause of exclusion under Article 134 exists, a party or an intervenor may apply for exclusion.

#### Article 136 (Challenge to Judges)

- (1) Where a party or an intervenor is unable to expect a judge to make a fair trial, he/she may file an application for challenge of such judge.
- (2) No party or intervenor shall file an application for challenge after he/she has submitted his/her statements on the case in writing or verbally: *Provided*, That the foregoing shall not apply where he/she is unaware that the cause of challenge exists or the cause of challenge occurs after he/she has made his/her statements.

#### Article 137 (Explanation of Exclusion or Challenge)

- (1) Any person who intends to apply for exclusion or challenge pursuant to

Articles 135 and 136 shall submit a document stating the ground thereof to the President of the Intellectual Property Trial and Appealing Board: *Provided*, That where a hearing is held, he/she may make a verbal statement about the cause thereof.

- (2) Any person who files an application for exclusion or challenge shall provide an explanation of the ground thereof within three days from the date he/she files such application.

Article 138 (Decision on Application for Exclusion or Challenge)

- (1) Where an application for exclusion or challenge is filed, exclusion or challenge shall be decided through a trial.
- (2) No judge against whom an application for exclusion or challenge is filed shall participate in a trial related to such exclusion or challenge: *Provided*, That he/she may state his/her opinion.
- (3) All decisions made under paragraph (1) shall be in writing, and grounds for such decision shall be stated therein.
- (4) No person shall appeal a decision under paragraph 1.

Article 139 (Suspension of Trial Proceedings)

Where an application for exclusion or challenge is filed, trial proceedings shall be suspended until a decision on such application is made: *Provided*, That the foregoing shall not apply where there is an urgent reason prescribed by Presidential Decree.

Article 140 (Abstention by Judges)

Where a judge falls under Article 134 or 136, he/she may abstain from a trial for the relevant case with the permission of the President of the Intellectual Property Trial and Appeal Board.

Article 141 (Hearings, etc.)

- (1) A hearing in a trial shall be either oral or paper: *Provided*, That where a party applies for an oral hearing, the oral hearing shall be held except where it is deemed that a decision may be made only by a paper hearing.
- (2) All oral hearings shall be open to the public: *Provided*, That the foregoing shall not apply where public order and good morals are likely to be

compromised.

- (3) Where the presiding judge holds an oral hearing for a trial pursuant to paragraph (1), he/she shall determine the date and place and serve a document stating the purport thereof on a party and an intervenor: *Provided*, That the foregoing shall not apply where he/she notifies the party and intervenor who attend the relevant trial.
- (4) Where the presiding judge holds an oral hearing for a trial pursuant to paragraph (1), he/she shall require an officer designated by the President of the Intellectual Property Trial and Appeal Board to prepare records stating the outline of the trial and other necessary matters on each date of the trial.
- (5) The presiding judge of a trial and an officer who has prepared records shall affix their signatures and seals to the records under paragraph (4).
- (6) Articles 153, 154 and 156 through 160 of the Civil Procedure Act shall apply *mutatis mutandis* to the records under paragraph (4).
- (7) Articles 143, 259, 299 and 367 of the Civil Procedure Act shall apply *mutatis mutandis* to all trials.
- (8) The presiding judge shall maintain order in the court during an oral hearing.

#### Article 142 (Intervention)

- (1) Any person entitled to request a trial pursuant to Article 124 (1) may intervene in the trial until the trial is completed.
- (2) Any intervenor under paragraph (1) may continue trial proceedings even after the party in whose favor the intervenor enters the proceedings voluntarily withdraws his/her request for the trial.
- (3) Any person who has an interest in the result of a trial may intervene in such trial to assist either party until the trial is completed.
- (4) Any intervenor under paragraph (3) may participate in all trial proceedings.
- (5) Where any cause for interruption or suspension of trial proceedings lies in an intervenor under paragraph (1) or (3), such interruption or suspension shall also effect the party in whose favor the intervenor entered the

proceedings.

Article 143 (Application for and Decision on Intervention)

- (1) Any person who intends to intervene in a trial shall submit an application for intervention to the presiding judge.
- (2) Upon receipt of an application for intervention, the presiding judge shall serve a duplicate copy of the application for intervention on the parties and other intervenors, and provide them with an opportunity to submit their written opinions within a fixed period.
- (3) Where an application for intervention is filed, such intervention shall be decided through a trial.
- (4) A decision under paragraph (3) shall be made in writing, and grounds for such decision shall be specified.
- (5) No person shall appeal a decision under paragraph (3).

Article 144 (Examination and Preservation of Evidence)

- (1) A judge may examine or preserve evidence at the request of a party, an intervenor or an interested party or *ex officio*.
- (2) The provisions concerning the examination and preservation of evidence of the Civil Procedure Act shall apply *mutatis mutandis* to the examination and preservation of evidence under paragraph (1): *Provided*, That a judge shall not determine an administrative fine, order the arrest of any person or require any person to deposit security.
- (3) An application for the preservation of evidence under paragraph (1) shall be filed with the President of the Intellectual Property Trial and Appeal Board before a request for a trial is made, and with the presiding judge when the trial is proceeding.
- (4) Where an application for preservation of evidence under paragraph (1) is filed with the President of the Intellectual Property Trial and Appeal Board before a request for a trial is made, he/she shall designate judges to participate in such application.
- (5) Where the presiding judge evaluates or preserves evidence *ex officio* pursuant to paragraph (1), he/she shall serve the result thereof on the

parties, intervenors or interested parties, and provide them with an opportunity to submit their written opinions within a fixed period.

Article 145 (Proceeding with Trial)

The presiding judge may proceed with a trial even if a party or an intervenor fails to follow procedures within a statutory period or designated period or fails to attend the trial on the date under Article 141 (3).

Article 146 (Ex Officio Hearings)

- (1) A judge may hold hearings about grounds a party or an intervenor did not mention in his/her application. In such cases, the judge shall give them an opportunity to state their opinions on such grounds.
- (2) No judge shall hold hearings about the purpose of a request not made by a requester.

Article 147 (Consolidation or Division of Hearings or Trial Decisions)

A collegial body of judges may consolidate or divide hearings or trial decisions on at least two trials in which one or both parties are the same.

Article 148 (Withdrawal of Request for Trial)

- (1) A request for a trial may be withdrawn until a trial decision becomes final and conclusive: *Provided*, That where a written answer under Article 133 (1) is submitted, one party shall obtain the consent of the other party.
- (2) Where a trial to invalidate trademark registration, etc. under Article 117 (1), 118 (1) or 214 (1) is requested in relation to at least two designated goods, a request for a trial may be withdrawn for each of the designated goods.
- (3) Where a request for a trial is withdrawn pursuant to paragraph (1) or (2), such request for a trial or a request for a trial concerning such designated goods shall be deemed never to have existed.

Article 149 (Trial Decision)

- (1) Except as otherwise expressly prescribed, a trial shall be completed upon a trial decision.
- (2) A trial decision under paragraph (1) shall be made in writing stating the following, and judges who make such trial decision shall affix their



signatures and seals to such documents:

1. Trial Number;
  2. Names and addresses of the parties and intervenors (in cases of a corporation, referring to its name and the seat of its place of business);
  3. Where an agent of a party or an intervenor exists, the name and address of his/her agent or the seat of his/her place of business [where the agent is a patent corporation or patent corporation (with limited liability), referring to its name, the seat of its office and the name of a designated patent attorney];
  4. Indication of the case at trial;
  5. Text of the trial decision;
  6. Grounds for the trial decision (including the purpose of the request and an outline of such grounds);
  7. Date of the trial decision.
- (3) When a case is due for trial decision, the presiding judge shall notify a party and an intervenor of the completion of a hearing.
- (4) If deemed necessary, the presiding judge may resume a hearing at the request of a party or an intervenor or *ex officio*, even after he/she has notified the completion of the hearing pursuant to paragraph (3).
- (5) A trial decision shall be made within 20 days from the date the presiding judge notifies the completion of a hearing under paragraph (3).
- (6) Where a trial decision or a decision is made, the presiding judge shall serve a certified copy of the trial decision or decision on a party, an intervenor and persons whose application for intervention is rejected though they have filed an application for intervention.

#### Article 150 (Prohibition against Double Jeopardy)

Where a trial decision under this Act becomes final and conclusive, no person shall re-request a trial on the case based on the same fact or evidence: *Provided*, That the foregoing shall not apply where the final and conclusive trial decision is dismissal.

#### Article 151 (Relationship with Lawsuits)

- (1) Where necessary in a trial, the presiding judge may suspend procedures *ex officio* or at the request of a party until a trial decision rendered in another trial in connection with the trial's case becomes final and conclusive or legal proceedings are completed.
- (2) Where necessary in legal proceedings, a court may suspend such legal proceedings until a trademark-related trial decision becomes final and conclusive *ex officio* or at the request of a party.
- (3) Where a lawsuit against infringement of a trademark right or an exclusive license is brought, the court shall notify the President of the Intellectual Property Trial and Appeal Board of the purpose of such lawsuit. The same shall also apply where such legal proceedings are completed.
- (4) Where in response to a lawsuit concerning infringement on trademark rights or an exclusive license under paragraph (3), a trial to invalidate such trademark rights, etc. is requested, the President of the Intellectual Property Trial and Appeal Board shall notify the court under the aforesaid paragraph of the purpose of such lawsuit. The same shall also apply where a decision to dismiss a written request for such trial, or a trial decision is made or such request is withdrawn.

#### Article 152 (Trial Expenses)

- (1) The payment of trial expenses under Articles 117 (1), 118 (1), 119 (1), 120 (1), 121 and 214 (1) shall be determined through a trial decision if a trial is completed upon a trial decision, or by decision if a trial is completed without a trial decision.
- (2) Articles 98 through 103, 107 (1) and (2), 108, 111, 112 and 116 of the Civil Procedure Act shall apply *mutatis mutandis* to trial expenses under paragraph (1).
- (3) Trial expenses under Article 115 or 116 shall be borne by a requester.
- (4) Article 102 of the Civil Procedure Act shall apply *mutatis mutandis* to expenses borne by a requester pursuant to paragraph (3).
- (5) The President of the Intellectual Property Trial and Appeal Board shall determine the amount of trial expenses at the request of a party after a

- trial decision or a decision becomes final and conclusive.
- (6) The extent, amount and payment of trial expenses and the payment of expenses incurred in performing procedures in a trial shall coincide with precedents in the relevant provisions of the Costs of Civil Procedure Act to the extent not inconsistent with the nature thereof.
  - (7) A fee paid or to be paid by a party to a patent attorney who has followed trial proceedings on behalf of the party shall be deemed trial expenses to the extent of the amount prescribed by the Commissioner of the Korean Intellectual Property Office. In such cases, even if several patent attorneys have participated in trial proceedings on behalf of the party, only one patent attorney is deemed to have followed trial proceedings on behalf of the party.

Article 153 (Title of Execution on Amount of Trial Expenses)

A final and conclusive decision concerning the amount of trial expenses determined by the President of the Intellectual Property Trial and Appeal Board shall be of the same effect as an enforceable title of execution. In such cases, a public official of the Intellectual Property Trial and Appeal Board shall grant the enforceable writ.

Article 154 (Special Rules of Trial concerning Decision to Dismiss Amendments and Decision to Reject)

The provisions of Articles 133 (1) and (2), 142 and 143 shall not apply to a trial concerning a decision to dismiss amendments under Article 115 and a decision to reject under Article 116.

Article 155 (Effect of Procedures for Examination or Formal Objection)

Trademark-related procedures followed in an examination or a formal objection shall have the effect on a trial concerning any of the following decisions to reject:

1. Decision to reject trademark registration under Article 54;
2. Decision to reject an application to register the renewal of the duration of trademark rights;
3. Decision to reject an application for registration of additional designated

goods;

4. Decision to reject registration of the conversion of the classification of goods.

Article 156 (Revocation of Decision, etc. to Dismiss Amendments)

- (1) Where a trial concerning a decision to reject an amendment under Article 115 or trial concerning a decision to reject under Article 116 is requested, where a collegial body of judges deems such request reasonable, it shall revoke such decision to dismiss the amendment or decision to reject through a trial decision.
- (2) Where a decision to dismiss an amendment or a decision to reject is revoked in a trial pursuant to paragraph (1), a trial decision that the revocation thereof will be referred to examination may be made.
- (3) Grounds that form the basis for revocation in a trial decision under paragraphs (1) and (2) shall bind the examiners to such case.

## **CHAPTER VIII RETRIAL AND LAWSUITS**

Article 157 (Request for Retrial)

- (1) Any party may request a retrial concerning the final and conclusive trial decision.
- (2) Articles 451, 453 and 459 (1) of the Civil Procedure Act shall apply *mutatis mutandis* to a request for a retrial under paragraph (1).

Article 158 (Appealing Against Trial Decision by Deception)

- (1) Where a party to a trial conspires to cause the court to reach a trial decision by deception for the purpose of infringing the right of or breaching the interest of a third party, the third party may request a retrial on the final and conclusive trial decision.
- (2) In cases of a request for a retrial under paragraph (1), the parties of a trial shall be the joint interveners.

#### Article 159 (Period of Request for Retrial)

- (1) A party shall request a retrial within 30 days from the date he/she becomes aware of the grounds for a retrial after a trial decision becomes final and conclusive.
- (2) Where a retrial is requested on the grounds of a defect in agency authority, the period under paragraph (1) shall be counted from the day following the date a requester or his/her legal representative becomes aware that a trial decision is made when he/she is served with a certified copy of the trial decision.
- (3) No retrial shall be requested where three years elapse after the trial decision becomes final and conclusive.
- (4) Where a reason for retrial arises after the trial decision becomes final and conclusive, the period under paragraph (3) shall be counted from the day following the date such reason arises.
- (5) Paragraphs (1) and (3) shall not apply where a retrial is requested on the grounds that the retrial is in conflict with the final and conclusive trial decision before the relevant trial decision.

#### Article 160 (Restrictions on Effect of Trademark Rights Reinstated through Retrial)

Where trademark rights fall under any of the following, the trademark rights shall not effect the act of using a trademark identical to the relevant registered trademark on goods identical to designated goods bearing the registered trademark in good faith before the registration of the trademark rights reinstated after the relevant trial decision becomes final and conclusive, or an act falling under any of the subparagraphs of Article 108 (1) or the subparagraphs of paragraph (2) of the aforesaid Article:

1. Where the effect of trademark rights is reinstated through a retrial after the trademark registration or registration to renew the duration of the trademark rights is invalidated;
2. Where the effect of the trademark rights is reinstated through a retrial after the trademark registration is revoked;

3. Where after a trial decision that trademark rights do not belong to the scope of rights of the trademark rights becomes final and conclusive, another trial decision contrary to the aforesaid trial decision becomes final and conclusive through a retrial.

Article 161 (Mutatis Mutandis Application of Provisions of Trial Proceedings in Retrial)

The provisions concerning trial proceedings shall apply *mutatis mutandis* to retrial proceedings to the extent not inconsistent with the nature thereof.

Article 162 (Lawsuits against Trial Decision, etc.)

- (1) A patent court shall have exclusive jurisdiction over lawsuits for trial decisions and lawsuits for decisions to dismiss an amendment and decision to reject a written request for a trial or written request for a retrial under Article 42 (1) applicable *mutatis mutandis* pursuant to Article 123 (1) (including cases applicable *mutatis mutandis* in Article 161).
- (2) A lawsuit under paragraph (1) may be brought by only the principals, intervenors or those whose application for intervention in a retrial is rejected though they have filed such application.
- (3) A lawsuit under paragraph (1) shall be brought within 30 days from the date the relevant person is served with a certified copy of a trial decision or a decision.
- (4) The period under paragraph (3) shall be fixed: *Provided*, That the presiding judge may determine an additional period to the fixed period for those in the area with poor transportation, such as islands and remote rural areas, on his/her own authority, as prescribed by Ordinance of the Ministry of Trade, Industry and Energy.
- (5) No lawsuit concerning matters on which a trial may be requested shall be brought unless such matters relate to a trial decision.
- (6) No lawsuit under paragraph (1) for a trial decision or a decision on trial expenses under Article 152 (1) shall be brought independently.
- (7) With respect to a judgment made by a patent court under paragraph (1), a final appeal may be made to the Supreme Court.

Article 163 (Standing to Be Sued)

A lawsuit under Article 162 (1) shall be brought against the Commissioner of the Korean Intellectual Property Office as defendant: *Provided*, That a lawsuit for a trial decision at the trial or the retrial thereof under Articles 117 (1), 118 (1), 119 (1) and (2), 120 (1), 121, and 214 (1) shall be brought against the requester thereof or the requested person as defendant.

Article 164 (Notification of Lawsuits Filed and Sending of Authenticated Copy of Written Judgment)

- (1) Where a lawsuit under Article 162 (1) is brought or a final appeal under paragraph (7) of the aforesaid Article is made, the court shall immediately notify the President of the Intellectual Property Trial and Appeal Board of the purpose thereof.
- (2) Where legal proceedings are completed concerning a lawsuit under the proviso to Article 163, the court shall immediately send an authenticated copy of the written judgment by the court at each level on the case to the President of the Intellectual Property Trial and Appeal Board.

Article 165 (Revocation of Trial Decision or Decision)

- (1) Where the court deems a lawsuit brought pursuant to Article 162 (1) well-grounded, it shall revoke the relevant trial decision or decision by judgment.
- (2) Where the judgment on the revocation of a trial decision or a decision becomes final and conclusive pursuant to paragraph (1), an examiner shall hold a hearing again to make a trial decision or a decision.
- (3) Grounds which have formed the basis for the revocation through the judgment under paragraph (1) shall bind the Intellectual Property Trial and Appeal Board to the outcome of case.

Article 166 (Patent Attorney's Fees and Litigation Costs)

@Article 109 of the Civil Procedure Act shall apply to patent attorney's fees for legal services performed by a patent attorney. In such cases, "attorney at law" shall be construed as "patent attorney."

# **CHAPTER IX INTERNATIONAL APPLICATIONS UNDER PROTOCOL RELATING TO THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS**

## **SECTION 1 International Applications, etc.**

### Article 167 (International Applications)

Any person who intends to obtain an international registration (hereinafter referred to as "international registration") under Article 2 (1) of the Protocol Relating to the Madrid Agreement concerning International Registration of Marks (hereinafter referred to as the "Madrid Protocol") shall file an international application with the Commissioner of the Korean International Property Office based on an application for trademark registration or trademark registration falling under any of the following:

1. Application for his/her trademark registration;
2. His/her trademark registration;
3. Application for his/her trademark registration and his/her trademark registration.

### Article 168 (Qualification of Persons Who File International Application)

- (1) A person eligible to file an international application with the Commissioner of the Korean International Property Office shall fall under any of the following:
  1. A citizen of the Republic of Korea;
  2. A person domiciled (in cases of a corporation, referring to the seat of its place of business) in the Republic of Korea.
- (2) Where at least two persons intend to jointly file an international application, applicants shall satisfy all the following requirements:
  1. A person who intends to jointly file an international application shall fall



under any of the subparagraphs of paragraph (1);

2. A person shall jointly file a basic application under Article 169 (2) 4 or jointly own the trademark rights concerning the basic registration.

#### Article 169 (International Application Procedures)

(1) Any person who intends to file an international application shall submit an international application (hereinafter referred to as "international application") prepared in the language prescribed by Ordinance of the Ministry of Trade, Industry and Energy and documents necessary to file an international application to the Commissioner of the Korean International Property Office.

(2) The following shall be stated in each international application:

1. Name and address of the applicant (in cases of a corporation, referring to its name and the seat of its place of business);
2. Matters concerning qualification of an international applicant under Article 168;
3. Country where the trademark shall be protected (including an intergovernmental organization; hereinafter referred to as "designated country");
4. Filing date of the basic application (hereinafter referred to as "basic application") and the application number thereof under Article 2 (1) of the Madrid Protocol or the date of registration of a basic registration (hereinafter referred to as "basic registration") and the registration number thereof under Article 2 (1) of the Madrid Protocol;
5. Trademark of which international registration an applicant intends to obtain;
6. Goods and the category of such goods of which international registration an applicant intends to obtain;
7. Other matters prescribed by Ordinance of the Ministry of Trade, Industry and Energy.

#### Article 170 (Time Submission of Documents Including International Application, etc. Takes Effect)

An international application and documents necessary to file such application

shall take effect from the date they are delivered to the Commissioner of the Korean International Property Office. The same shall also apply where they are submitted by mail.

Article 171 (Examination, etc. of Items Mentioned)

- (1) Where the items mentioned in an international application are consistent with those in a basic application or basic registration, the Commissioner of the Korean International Property Office shall note his/her intention to recognize the fact and the date such international application is delivered to the Korean International Property Office in the international application.
- (2) The Commissioner of the Korean International Property Office shall send an international application and documents necessary to file an international application to the International Secretariat (hereinafter referred to as the "International Secretariat") under Article 2 (1) of the Madrid Protocol and send a copy of such international application to the relevant applicant immediately after he/she writes down the date of arrival, etc. pursuant to paragraph (1).

Article 172 (Subsequent Designation)

- (1) Where a holder of an international registration (hereinafter referred to as "holder of an international registration") intends to additionally designate a designated country internationally registered (hereinafter referred to as "subsequent designation"), he/she may file an application for subsequent designation with the Commissioner of the Korean International Property Office, as prescribed by Ordinance of the Ministry of Trade, Industry and Energy.
- (2) Where paragraph (1) is applied, the holder of an international registration may subsequently designate all or some of the designated goods which are internationally registered.

Article 173 (Renewal of Duration of International Registration)

- (1) The holder of an international registration may renew the duration of an international registration every ten years.
- (2) Any person who intends to renew the duration of an international registration pursuant to paragraph (1) may file an application for renewal

of the duration of the international registration with the Commissioner of the Korean International Property Office, as prescribed by Ordinance of the Ministry of Trade, Industry and Energy.

#### Article 174 (Change of Ownership of International Registration)

- (1) The holder of an international registration or his/her successor may change the ownership of the international registration for all or some of the designated goods or the designated countries.
- (2) Any person who intends to change the ownership of the international registration pursuant to paragraph (1) may file an application therefor with the Commissioner of the Korean International Property Office, as prescribed by Ordinance of the Ministry of Trade, Industry and Energy.

#### Article 175 (Payment of Fees)

- (1) Any of the following persons shall pay a fee to the Commissioner of the Korean International Property Office:
  1. A person who intends to file an international application;
  2. A person who intends to apply for a subsequent designation;
  3. A person who intends to apply for renewal of the duration of an international registration pursuant to Article 173;
  4. A person who intends to apply for a change of ownership of an international registration pursuant to Article 174.
- (2) Matters necessary for fees, the method and period for the payment thereof under paragraph (1) shall be prescribed by Ordinance of the Ministry of Trade, Industry and Energy.

#### Article 176 (Correction for Unpaid Fees)

Where a person who falls under Article 175 (1) fails to pay a fee, the Commissioner of the Korean International Property Office may order him/her to make a correction within a fixed period, as prescribed by Ordinance of the Ministry of Trade, Industry and Energy.

#### Article 177 (Invalidation of Procedures)

Where a person who is ordered to make a correction pursuant to Article 176 fails to pay a fee within the designated period, the Commissioner of the

Korean International Property Office may invalidate the relevant procedures.

Article 178 (Registration of Change in Particulars of International Registration)

Matters necessary for applying for registration of a change in the particulars of an international registration and other international applications shall be prescribed by Ordinance of the Ministry of Trade, Industry and Energy.

Article 179 (Exclusion from Application to Business Emblem)

None of the provisions of Articles 167 through 178 shall apply to a business emblem.

## **SECTION 2 Special Cases concerning Application for International Trademark Registration**

Article 180 (Application for International Trademark Registration)

- (1) An international application that has been registered internationally in accordance with the Madrid Protocol, which has designated the Republic of Korea as a designated country (including subsequent designation), shall be deemed an application for trademark registration under this Act.
- (2) Where paragraph (1) is applied, the date of international registration (hereinafter referred to as "date of international registration") under Article 3 (4) of the Madrid Protocol shall be deemed the filing date of an application for trademark registration under this Act: *Provided*, That in cases of an international application which has designated the Republic of Korea subsequently, the date such subsequent designation is registered (hereinafter referred to as "date of subsequent designation") on the International Register (referring to the International Register under Article 2 (1) of the Madrid Protocol; hereinafter referred to as "International Trademark Register") shall be deemed the filing date of an application for trademark registration under this Act.
- (3) With respect to an international application deemed an application for trademark registration (hereinafter referred to "application for international trademark registration") under this Act pursuant to paragraph (1), the

name, address (in cases of a corporation, referring to its name and the seat of its place of business), trademark, designated goods and the category of such goods of the holder of an international registration registered on the International Trademark Register shall be construed as the name, address (in cases of a corporation, referring to its name and the seat of its place of business), trademark, designated goods and the category of such goods of an applicant under this Act.

Article 181 (Special Cases of Business Emblem)

None of the provisions concerning a business emblem shall apply to an application for international trademark registration.

Article 182 (Special Cases of Application for International Trademark Registration)

- (1) Where this Act applies to an application for international trademark registration, the purpose for claiming priority, the name of the country where the first application is filed, and the filing date of the first application registered on the International Trademark Register shall be construed as the purpose for claiming priority, the name of a country where the first application is filed, and the filing date of the first application stated in an application for trademark registration.
- (2) Where this Act applies to an application for international trademark registration, the purpose of a trademark registered on the International Trademark Register shall be construed as the purpose of the relevant trademark mentioned in an application for trademark registration.
- (3) Any person who intends to obtain collective mark registration shall submit documents and the articles of incorporation under Article 6 (1) and (3) to the Commissioner of the Korean International Property Office, and any person who intends to obtain certification mark registration shall submit documents under paragraphs (1) and (4) of the aforesaid Article to the Commissioner of the Korean Intellectual Property Office, as prescribed by Ordinance of the Ministry of Trade, Industry and Energy. In such cases, any person who intends to obtain registration of a collective mark with

geographical indication shall submit documents stating the purpose thereof, along with documents prescribed by Presidential Decree which can verify that such collective mark with geographical indication is consistent with the definition of the geographical indication under Article 2 (1) 4.

Article 183 (Effect of Application for International Trademark Registration where Domestically Registered Trademark Exists)

- (1) Where a holder of a trademark registered with and the right thereto established in the Republic of Korea (excluding a registered trademark following an application for international trademark registration; hereinafter referred to as "domestically registered trademark") satisfies all the following requirements when he/she files an application for international trademark registration, such application for international trademark registration shall be deemed filed on the filing date of an application for trademark registration relating to the relevant domestically registered trademark to the extent that designated goods overlap:
  1. The trademark registered on the International Trademark Register (hereinafter in this paragraph, referred to as "internationally registered trademark") following an application for international trademark registration shall be identical to the domestically registered trademark;
  2. The holder of an international registration concerning the internationally registered trademark shall be identical to the holder of the domestically registered trademark;
  3. All designated goods bearing the domestically registered trademark shall be included in designated goods bearing the internationally registered trademark;
  4. The effect of territory extension under Article 3-3 of the Madrid Protocol shall arise after the date of trademark registration of the domestically registered trademark.
- (2) Where the priority right under the treaty is recognized on an application for trademark registration concerning the domestically registered trademark under paragraph (1), the priority right is also recognized on an application

for international trademark registration under the aforesaid paragraph.

- (3) Where the trademark right of the domestically registered trademark is revoked or extinguished on any of the following grounds, the effect on the relevant application for international trademark registration under paragraphs (1) and (2) shall not be recognized to the same extent as designated goods of the trademark right revoked or extinguished:
  1. Where a trial decision to the effect that the trademark registration is revoked on the grounds that the trademark registration falls under the subparagraphs (excluding subparagraph 4) of Article 119 (1) becomes final and conclusive;
  2. Where a trial to revoke trademark registration is requested on the grounds that the trademark registration falls under the subparagraphs (excluding subparagraph 4) of Article 119 (1), and trademark rights are extinguished due to the expiration of the duration, or some trademark rights or designated goods are relinquished after the date of such trial is requested.
- (4) Any person who intends to file an application under Article 4-2 (2) of the Madrid Protocol shall submit a written application stating the following to the Commissioner of the Korean Intellectual Property Office:
  1. Name and address of the holder of the international registration (in cases of a corporation, referring to its name and the seat of its place of business);
  2. International registration number;
  3. Related domestically registered trademark number;
  4. Overlapping designated goods;
  5. Other matters prescribed by Ordinance of the Ministry of Trade, Industry and Energy.
- (5) Where an application under paragraph (4) is filed, an examiner shall advise the applicant whether the effect under paragraphs (1) through (3) is recognized on the relevant application for international trademark registration.

Article 184 (Special Cases of Succession to Application and Transfer of Divisional Application)

- (1) For the purposes of Article 48 (1) in relation to an application for international trademark registration, "report on the modification of an applicant excluding inheritance or other general succession" shall be construed as "report made by an applicant to the International Secretariat in order to change the ownership."
- (2) Where all or some of the designated goods of an international registration are divided and transferred following a change in the ownership of the international registration, an application for international trademark registration shall be deemed filed by each changed holder of the international registration.
- (3) Article 48 (3) shall not apply to an application for international trademark registration.

#### Article 185 (Special Cases of Modification)

- (1) For the purposes of Article 40 (1) in relation to an application for international trademark registration, "items mentioned in a written application for trademark registration, designated goods and trademark concerning an application for trademark registration" shall be construed as "designated goods concerning such application for trademark registration limited to where an applicant is notified of grounds for rejection under Article 55 (1)."
- (2) Article 40 (2) 4 shall not apply to an application for international trademark registration.
- (3) For the purposes of Article 40 (3) in relation to an application for international trademark registration, "amendment under paragraph (1) falls outside paragraph (2)" shall be construed as "amendment of designated goods falls outside paragraph (2) (excluding subparagraph 4 of the aforesaid paragraph)," and for the purposes of Article 41 (3) in relation to an application for international trademark registration, "amendment under paragraph (1) falls outside Article 40 (2)" shall be construed as "amendment of designated goods falls outside Article 40 (2) (excluding subparagraph 4 of the aforesaid paragraph)."



- (4) For the purposes of Article 41 (1) in relation to an application for international trademark registration, "designated goods and the trademark" shall be construed as "designated goods."

Article 186 (Special Cases of Modification of Application)

None of the provisions of Article 44 (1) through (4) shall apply to an application for international trademark registration.

Article 187 (Special Cases of Division of Application)

@Article 45 shall not apply to an application for international trademark registration.

Article 188 (Special Cases of Priority Claim under Paris Convention)

@Article 46 (4) and (5) shall not apply where any person who intends to file an application for international trademark registration claims priority under the Paris Convention.

Article 189 (Special Cases When Filing Application and of Preferential Examination)

- (1) For the purposes of Article 47 (2) in relation to an application for international trademark registration, "submit a written application for trademark registration stating the purpose thereof to the Commissioner of the Korean Intellectual Property Office, and documents that may prove such goods within 30 days from the filing date of an application for trademark registration" shall be construed as "documents stating the purpose thereof and documents that can prove such goods within the period prescribed by Ordinance of the Ministry of Trade, Industry and Energy."
- (2) Article 53 (2) shall not apply to an application for international trademark registration.

Article 190 (Special Cases of Notification of Grounds for Rejection)

- (1) For the purposes of the former part of Article 55 (1) in relation to an application for international trademark registration, "notify an applicant" shall be construed as "notify an applicant through the International Secretariat."

(2) Article 55 (3) shall not apply to an application for international trademark registration.

Article 191 (Special Cases of Publication of Application)

For the purposes of the main sentence of Article 57 (1) in relation to an application for international trademark registration, "where grounds for rejection cannot be discovered" shall be construed as "where grounds for rejection cannot be discovered within the period prescribed by Ordinance of the Ministry of Trade, Industry and Energy."

Article 192 (Special Cases of Right to Claim Damages)

For the purposes of the proviso to Article 58 (1) in relation to an application for international trademark registration, "copy of the relevant application for trademark registration" shall be construed as "copy of the relevant international application."

Article 193 (Special Cases of Decision to Register Trademark and Ex Officio Modification)

- (1) For the purposes of Article 68 in relation to an application for international trademark registration, "where no grounds for rejection can be discovered" shall be construed as "where no grounds for rejection can be discovered within the period prescribed by Ordinance of the Ministry of Trade, Industry and Energy."
- (2) Article 59 shall not apply to an application for international trademark registration.

Article 194 (Special Cases of Trademark Registration Fees)

- (1) Any person who intends to file an application for international trademark rights or who intends to renew the duration of trademark rights established and registered (hereinafter referred to as "internationally registered basic trademark rights") pursuant to Article 197 shall pay an individual fee under Article 8 (7) (a) of the Madrid Protocol to the International Secretariat.
- (2) Matters necessary for individual fees under paragraph (1) shall be prescribed by Ordinance of the Ministry of Trade, Industry and Energy.
- (3) None of the provisions of Articles 72 through 77 shall apply to an

application for international trademark registration or internationally registered basic trademark rights.

Article 195 (Special Cases of Refund of Trademark Registration Fees, etc.)

For the purposes of Article 79 (1) in relation to an application for international trademark registration, "trademark registration fee and fee paid" shall be construed as "fee already paid," "trademark registration fee and fee" shall be construed as "fee," and where subparagraph 1 of the aforesaid paragraph and paragraphs (2) and (3) of the aforesaid Article are applied to an application for international trademark registration, "trademark registration fee and fee" shall be construed as "fee," respectively.

Article 196 (Special Cases of Registration on Trademark Register)

- (1) Where Article 80 (1) 1 is applied to internationally registered basic trademark rights, "establishment, transfer, change, extinguishment, recovery, renewal of the duration of trademark rights, conversion of the classification of goods, addition of or restrictions on disposition of designated goods" shall be construed as "establishment of and restrictions on disposition of trademark rights."
- (2) The transfer, change, extinguishment, or renewal of the duration of internationally registered basic trademark rights shall be performed as registered on the International Trademark Register.

Article 197 (Special Cases of Registration and Establishment of Trademark Rights)

For the purposes of Article 82 (2) in relation to an application for international trademark registration, "any of the following cases" shall be construed as "cases where trademark registration is determined."

Article 198 (Special Cases of Duration, etc. of Trademark Rights)

- (1) The duration of internationally registered basic trademark rights shall remain in force until the date ten years elapse after the date of international registration from the date trademark rights under Article 197 are registered and established.
- (2) The duration of internationally registered basic trademark rights may be

renewed every ten years through the renewal of the duration of the international registration.

- (3) Where the duration of internationally registered basic trademark rights is renewed pursuant to paragraph (2), the duration of such internationally registered basic trademark rights shall be deemed renewed at the time of the expiration of the duration thereof.
- (4) None of the provisions of Articles 83 through 85, 88 (1) and 209 through 213 shall apply to internationally registered basic trademark rights.

Article 199 (Special Cases of Application for Registration of Additional Designated Goods)

The provisions of Articles 86, 87 and 88 (2) shall not apply to an application for international trademark registration or internationally registered basic trademark rights.

Article 200 (Special Cases of Division of Trademark Rights)

The provisions of Article 94 shall not apply to internationally registered basic trademark rights.

Article 201 (Special Cases of Effect of Registration of Trademark Rights)

- (1) No extinguishment of internationally registered basic trademark rights following the transfer, change or abandonment thereof or the renewal of the duration thereof shall take effect unless such extinguishment or renewal is registered on the International Trademark Register.
- (2) None of the provisions of Article 96 (1) 1 (excluding the part concerning restrictions on disposition) shall apply to internationally registered basic trademark rights.
- (3) Where Article 96 (2) is applied to internationally registered basic trademark rights, "trademark rights and a pledge" shall be construed as "pledge."

Article 202 (Effect of Extinguishment of International Registration)

- (1) Where all or some of the international registration forming the basis of an application for international trademark registration are extinguished, the relevant application for international trademark registration on all or some of the designated goods shall be deemed withdrawn to the extent of the

extinguishment thereof.

- (2) Where all or some of the international registration forming the basis of internationally registered basic trademark rights are extinguished, the relevant trademark rights to all or some of the designated goods shall be deemed extinguished to the extent of the extinguishment thereof.
- (3) The effect of withdrawal or extinguishment under paragraphs (1) and (2) shall occur from the date the relevant international registration is extinguished.

Article 203 (Special Cases of Relinquishment of Trademark Rights)

- (1) The provisions of Article 102 (1) shall not apply to internationally registered basic trademark rights.
- (2) Where Article 103 applies to internationally registered basic trademark rights, "trademark rights or exclusive license" shall be construed as "exclusive license."

Article 204 (Special Cases of Trial to Invalidate Registration to Renew Duration, etc.)

The provisions of Article 118 or 214 shall not apply to internationally registered basic trademark rights.

### **SECTION 3 Special Cases of Applications for Trademark Registrations**

Article 205 (Special Cases of Applications for Trademark Registrations after Lapse of International Registration)

- (1) Where an international registration of a trademark, which is eligible for international registration through which the Republic of Korea has been designated as a designated country (including subsequent designation), on all or some of the designated goods lapses pursuant to Article 6 (4) of the Madrid Protocol, the holder of the international registration may file an application for trademark registration on all or some of such goods

- with the Commissioner of the Korean Intellectual Property Office.
- (2) Where an application for trademark registration under paragraph (1) satisfies all the following requirements, such application shall be deemed filed on the date of international registration (in cases of a subsequent designation, referring to the date of the subsequent designation):
    1. An application for trademark registration under paragraph (1) shall be filed within three months from the expiration date of the international registration under the aforesaid paragraph;
    2. All designated goods in an application for trademark registration under paragraph (1) shall be included in designated goods in international registration;
    3. A trademark filed to obtain trademark registration shall be identical to another trademark eligible for the international registration which has lapsed.
  - (3) Where the priority under the treaty is recognized on an application for international trademark registration concerning international registration under paragraph (1), the priority shall be recognized on an application for trademark registration under the aforesaid paragraph.

Article 206 (Special Cases of Application for Trademark Registrations after Abrogation of Madrid Protocol)

- (1) Where the holder of an international registration through which the Republic of Korea has been designated as a designated country (including subsequent designation) is disqualified as an applicant pursuant to Article 15 (5) (b) of the Madrid Protocol, the holder of the relevant international registration may file an application for trademark registration on all or some of the internationally registered designated goods with the Commissioner of the Intellectual Property Office.
- (2) Article 205 (2) and (3) shall apply *mutatis mutandis* to an application for trademark registration under paragraph (1). In such cases, "within three months from the expiration date of the international registration under the aforesaid paragraph" in Article 205 (2) 1 shall be construed as "within

two years from the date the effect of abrogation occurs pursuant to Article 15 (3) of the Madrid Protocol."

#### Article 207 (Special Cases of Examination)

Where any of the following applications for trademark registration (hereinafter referred to as "reapplication") is related to the registered trademark established and registered pursuant to Article 197, the provisions of Articles 54, 55, 57, and 60 through 67 shall not apply to an application for trademark registration filed by the relevant principal: *Provided*, That the foregoing shall not apply where such application falls under subparagraph 2 of Article 54:

1. An application for trademark registration filed pursuant to Article 205 (1) because it satisfies all the requirements under the subparagraphs of Article 205-(2);
2. An application for trademark registration filed pursuant to Article 206 (1) because it satisfies all the requirements under the subparagraphs of Article 205-(2) applied *mutatis mutandis* pursuant to Article 206 (2).

#### Article 208 (Special Cases of Period of Exclusion)

Where the relevant trademark is established and registered through reapplication therefor, in which case the period of exclusion under Article 122 (1) relating to the previous internationally registered basic trademark rights has elapsed, no trial to invalidate the trademark established and registered following the reapplication shall be requested.

## **CHAPTER X REGISTRATION OF CONVERSION OF CLASSIFICATION OF GOODS**

#### Article 209 (Application for Registration of Conversion of Classification of Goods)

- (1) A trademark right holder who has obtained establishment and registration of trademark rights, registration of additional designated goods or registration to renew the duration by designating goods in accordance with the classification of the category of goods prescribed by Ordinance of the Ministry of Commerce and Industry under Article 10 (1) of the former

Act (referring to the Trademark Act before being amended by Act No. 5355) shall obtain registration after converting the relevant designated goods in accordance with the classification of the category of goods: *Provided*, That the foregoing shall not apply to a person who intends to obtain registration to renew the duration by designating goods in accordance with the classification of the category of goods prescribed by Ordinance of the Ministry of Commerce and Industry under Article 10 (1) of the Trademark Act amended by Act No. 5355.

- (2) Any person who intends to obtain registration of the conversion of the classification of goods under paragraph (1) shall submit an application for registration of conversion of the classification of goods stating the following:
  1. Name and address of the applicant (in cases of a corporation, referring to its name and the seat of its place of business);
  2. Where there is an agent for the applicant, the name and address of his/her agent or the seat of his/her agent's place of business (where an agent is a patent corporation or patent corporation (limited liability company), referring to its name, the seat of its office and the name of a designated patent attorney);
  3. Registration number of the registered trademark;
  4. Designated goods intended to be registered after conversion and the category of such goods.
- (3) An application for registration of the conversion of the classification of goods shall be filed from one year before the duration of trademark rights expires for a period not exceeding six months after the duration of trademark rights expires.
- (4) Where trademark rights are jointly owned, all joint owners shall jointly file an application for registration of the conversion of the classification of goods.

Article 210 (Decision to Reject Registration of Conversion of Classification of Goods and Notification of Grounds for Rejection)



- (1) Where an application for registration of the conversion of the classification of goods falls under any of the following, an examiner shall decide to reject registration of the conversion of the classification of goods against such application:
  1. Where non-designated goods of the relevant registered trademark are designated as designated goods in the application for registration of the conversion of the classification of goods, or the scope of designated goods is substantially extended;
  2. Where goods in the application for registration of the conversion of the classification of goods are inconsistent with the classification of the category of goods;
  3. Where an applicant for registration of the conversion of the classification of goods is not the holder of the relevant registered trademark;
  4. Where the application fails to satisfy requirements for an application for registration of conversion of the classification of goods under Article 209;
  5. Where trademark rights are extinguished, an application to register the renewal of the duration is abandoned or withdrawn, or invalidated.
- (2) Where an examiner intends to make a decision to reject registration of the conversion of the classification of goods pursuant to paragraph (1), he/she shall notify an applicant of grounds for rejection. In such cases, the applicant may submit his/her opinion regarding grounds for rejection within the period prescribed by Ordinance of the Ministry of Trade, Industry and Energy.
- (3) An applicant who fails to submit his/her opinion within a period under the latter part of paragraph (2) may file an application for continuance of procedures concerning registration of the conversion of the classification of goods within two months after such period expires, and may submit his/her opinion on grounds for rejection within the period.

#### Article 211 (Registration of Conversion of Classification of Goods)

Where a decision to register a trademark under Article 68 applied *mutatis mutandis* pursuant to Article 212 is made, the Commissioner of the Korean Intellectual Property Office shall register the conversion of the classification

of designated goods.

Article 212 (Mutatis Mutandis Application to Application for Registration of Conversion of Classification of Goods)

The provisions of Articles 38 (1), 39,40, 41 (3), 42, 50, 68 through 70, and subparagraphs 1 through 5 and 7 of Article 134 shall apply *mutatis mutandis* to an application for registration of the conversion of the classification of goods.

Article 213 (Extinguishment of Trademark Rights Where Application for Registration of Conversion of Classification of Goods is not Filed)

- (1) In any of the following cases, trademark rights to designated goods eligible for registration of the conversion of the classification of goods shall be extinguished on the day following the expiration date of the duration to which the expiration date of the period for filing an application for registration of the conversion of the classification of goods under Article 209 (3):
1. Where a person who shall obtain registration of the conversion of the classification of goods fails to file an application for registration of the conversion of the classification of goods within the period under Article 209 (3);
  2. Where an application for registration of the conversion of the classification of goods is withdrawn;
  3. Where procedures concerning the conversion of the classification of goods are invalidated pursuant to Article 18 (1);
  4. Where a decision to reject registration of the conversion of the classification of goods becomes final and conclusive;
  5. Where the trial decision to the effect that registration of the conversion of the classification of goods is invalidated becomes final and conclusive pursuant to Article 214.
- (2) Trademark rights to designated goods not mentioned in an application for registration of the conversion of the classification of goods under 209 (2), which are eligible for registration of the conversion of the classification of goods, shall be extinguished on the date the conversion of designated goods mentioned in an application for registration of the conversion of the

classification of goods is registered pursuant to Article 211: *Provided*, That where registration of the conversion of the classification of goods is obtained before the expiration date of the duration of trademark rights, trademark rights shall be extinguished on the day following the expiration date of the duration of trademark rights.

Article 214 (Trial to Invalidate Registration of Conversion of Classification of Goods)

- (1) Where registration of the conversion of the classification of goods falls under any of the following, an interested party or an examiner may request a trial to invalidate registration thereof. In such cases, where at least two designated goods relating to registration of the conversion of the classification of goods exist, a trial may be requested for each of the designated goods:
  1. Where non-designated goods bearing the relevant trademark are registered for the conversion of the classification of goods, or the scope of designated goods has been substantially extended;
  2. Where registration of the conversion of the classification of goods is obtained through an application filed by a person who is not the holder of the relevant registered trademark;
  3. Where registration of the conversion of the classification of goods violates Article 209 (3).
- (2) Articles 117 (2) and (5) shall apply *mutatis mutandis* to a trial to invalidate registration of the conversion of the classification of goods.
- (3) Where the trial decision to the effect that registration of the conversion of the classification of goods is invalidated becomes final and conclusive, the relevant registration of the conversion of the classification of goods shall be deemed never to have existed.

## CHAPTER XI SUPPLEMENTARY PROVISIONS

### Article 215 (Perusal, etc. of Documents)

Any person who desires to obtain certification concerning an application for trademark registration and the trial, a certified copy or an abstract of documents, to peruse or reproduce the Trademark Register and documents may file an application for permission for perusal, etc. of documents with the Commissioner of the Korean Intellectual Property Office or the President of the Intellectual Property Trial and Appeal Board.

### Article 216 (Prohibition of Taking out and Disclosure of Documents Relating to Application for Trademark Registration, Examination, Trial, etc.)

- (1) Any documents relating to an application for trademark registration, examination, formal objection, trial or retrial, or the Trademark Register shall not be removed except in any of the following cases:
1. Where documents relating to an application for trademark registration, application for registration of a collective mark with geographical indication, examination or formal objection are taken out for trademark search, etc. under Article 51 (1) through (3);
  2. Where documents relating to an application for trademark registration, examination, formal objection, trial or retrial, or the Trademark Register are removed to entrust the digitization of trademark documents under Article 217;
  3. Where documents relating to an application for trademark registration, examination, formal objection, trial, or retrial, or the Trademark Register are removed for online telecommuting under Article 32 (3) of the Electronic Government Act.
- (2) No expert opinion shall be provided, no testimony shall be borne or no answers shall be provided to any question concerning the details of an application for trademark registration, examination, formal objection, a case pending due to a trial or retrial, or decision on whether to grant

trademark registration, or the details of the trial decision or decision.

Article 217 (Digitization of Trademark Documents by Agency)

- (1) The Commissioner of the Korean Intellectual Property Office may conduct affairs concerning the digitization of documents concerning applications for trademark registration, examinations, trials or retrials or the Trademark register, or affairs similar thereto (hereinafter referred to as "digitization of trademark documents") by utilizing the electronic data processing system and using technology in the electronic data processing system in order to efficiently perform trademark-related procedures.
- (2) The Commissioner of the Korean Intellectual Property Office may entrust the digitization of trademark documents to a corporation equipped with facilities and human resources prescribed by Ordinance of the Ministry of Trade, Industry and Energy.
- (3) The Commissioner of the Korean Intellectual Property Office may digitize applications for trademark registrations and other documents prescribed by Ordinance of the Ministry of Trade, Industry and Energy, which have not been submitted in electronic form under Article 30 (1), pursuant to paragraph (1), and store such applications and documents in the file of the Korean Intellectual Property Office or the Intellectual Property Trial and Appeal Board.
- (4) Content stored in the file pursuant to paragraph (3) shall be deemed the same content as that stated in the relevant documents.
- (5) Methods of digitization of trademark documents and other matters necessary for the digitization of trademark documents shall be prescribed by Ordinance of the Ministry of Trade, Industry and Energy.
- (6) Where a person entrusted with digitization of trademark documents (hereafter in this paragraph, referred to as "agency for digitizing trademark documents") pursuant to paragraph (2) fails to comply with standards for facilities and human resources prescribed by Ordinance of the Ministry of Trade, Industry and Energy, the Commissioner of the Korean Intellectual Property Office may order such agency for digitizing

trademark documents to make corrections, and where the agency for digitizing trademark documents fails to comply with his/her order to make corrections, he/she may revoke the entrustment of the digitization of trademark documents.

Article 218 (Service of Documents)

Matters necessary for procedures for the service of documents prescribed in this Act shall be prescribed by Presidential Decree.

Article 219 (Service by Publication)

- (1) Where it is impossible to serve documents because the address or the place of business of a person on whom documents shall be served is unclear, service by publication shall be effected in lieu thereof.
- (2) Service by publication shall be effected by publishing the intention of delivering documents to a person on whom documents shall be served at any time in the Trademark Official Gazette.
- (3) The first service by publication shall take effect after two weeks elapse from the date the intention of delivery at any time is published in the Trademark Official Gazette: *Provided*, That service by publication to the same relevant person after this shall take effect from the day following the date on which the intention of delivery at any time is published in the Trademark Official Gazette.

Article 220 (Service on Non-Resident)

- (1) Where a non-resident has a trademark manager, any document to be served on such non-resident shall be served on his/her trademark manager: *Provided*, That the foregoing shall not apply where an examiner notifies an applicant for international trademark registration of grounds for rejection via the International Secretariat pursuant to Article 190.
- (2) Where a non-resident does not have a trademark manager, any document to be served on such non-resident may be sent by registered airmail.
- (3) Where a document is sent by registered airmail pursuant to paragraph (2), such document shall be deemed served on the date the document is sent.

Article 221 (Trademark Official Gazette)

- (1) The Commissioner of the Korean Intellectual Property Office shall publish the Trademark Official Gazette.
- (2) The Trademark Official Gazette may be published through electronic media, as prescribed by Ordinance of the Ministry of Trade, Industry and Energy.
- (3) Where the Commissioner of the Korean Intellectual Property Office publishes the Trademark Official Gazette through electronic media, he/she shall announce the publication of the Trademark Official Gazette, important contents and matters concerning service by publication using the information and communications network.
- (4) Matters to be published in the Trademark Official Gazette shall be prescribed by Presidential Decree.

#### Article 222 (Indication of Registered Trademark)

Where a trademark right holder, an exclusive licensee, or a non-exclusive licensee uses a registered trademark, he/she may indicate that the relevant trademark is the registered trademark.

#### Article 223 (Indication of Registered Collective Mark with Homonymous Geographical Indication)

Where at least two registered collective marks with geographical indication correspond to a mutually homonymous geographical indication, each collective mark right holder and its members shall use a mark that prevents consumers from being confused about the geographical source along with its registered collective mark.

#### Article 224 (Prohibition of False Display)

- (1) No person shall engage in any of the following conduct:
  1. Displaying an unregistered trademark or a trademark no application for registration of which has been filed on goods, as if such trademark is a registered trademark or a trademark of which application for registration has been filed;
  2. Displaying an unregistered trademark or a trademark no application for registration of which has not been filed on advertisements for business, signboards, labels, packages of goods or other business transaction

documents as if such trademark is a registered trademark or a trademark of which application for registration has been filed;

3. Where a registered trademark is used on goods other than designated goods, displaying the trademark registration or a mark likely to be confused therewith on such trademark.
- (2) Displaying a trademark under paragraph (1) 1 and 2 shall include the making of goods, packages of goods, advertisements, signboards, or labels in the shape of a mark.

Article 225 (Special Rules on Trademarks, etc. Similar to Registered Trademark)

- (1) "Registered trademark" under Articles 89, 92, 95 (3), 97 (2), 104, 110 (4), 119 (1) 3 and (3), 160, 222 and 224 shall be deemed to include a trademark similar to such registered trademark, in which case if the same color as that of the registered trademark is applied to such trademark, the trademark is recognized as identical to the registered trademark.
- (2) "Trademark similar to the registered trademark" under Articles 108 (1) 1 and 119 (1) 1 shall not be deemed to include a trademark similar to such registered trademark, in which case if the same color as that of the registered trademark is applied to such trademark, the trademark is recognized as identical to the registered trademark.
- (3) "Trademark similar to the registered collective mark with geographical indication" under Article 108 (2) 1 shall not be deemed to include a trademark similar to such registered collective mark, in which case if the same color as that of the registered collective mark is applied to such trademark, the trademark is recognized as identical to the registered collective mark.
- (4) None of the provisions of paragraphs (1) through (3) shall apply to a registered trademark which consists of colors or a combination of colors only.

Article 226 (Restrictions on Appeals)

- (1) No person shall appeal under any other Act against a decision to reject a modification, decision on whether to grant trademark registration, trial



decision, decision to reject a request for a trial or request for a retrial, and appeal under other Act against the disposition to which no appeal shall be filed pursuant to this Act.

- (2) The Administrative Appeals Act or the Administrative Litigation Act shall apply to an appeal against a disposition other than the disposition under paragraph (1).

Article 227 (Orders to Maintain Confidentiality)

- (1) Where one party has explained all the following grounds about trade secrets (referring to trade secrets under subparagraph 2 of Article 2 of the Unfair Competition Prevention and Trade Secret Protection Act) it possesses in a lawsuit concerning infringement on trademark rights or exclusive license, the court may, at the request of one party, order the other party (in cases of a corporation, referring to its representative), a person who brings a lawsuit on behalf of one party, or other persons who have learned such trade secrets due to such lawsuit not to use the trade secrets for any purpose other than carrying on the lawsuit, or not to disclose the trade secrets to any person other than those who have received an order under this paragraph related to the trade secrets by decision: *Provided*, That the foregoing shall not apply where the other party (in cases of a corporation, referring to its representative), a person who brings a lawsuit on behalf of one party, or other persons who have learned trade secrets due to such lawsuit have already acquired such trade secrets through a method other than the perusal of prepared documents under paragraph (1) for the taking of evidence:
  1. Trade secrets are included in prepared documents already submitted or to be submitted, or evidence already taken or to be taken;
  2. Because the use of trade secrets under subparagraph 1 for purposes other than carrying on the relevant lawsuit or the disclosure thereof is likely to interfere with one party's business, it is necessary to restrict the use or disclosure of such trade secrets.
- (2) A request for an order (hereinafter referred to as "order to maintain

confidentiality") under paragraph (1) shall be made in writing stating the following:

1. Those who are to receive an order to maintain confidentiality;
2. Facts enough to specify trade secrets subject to an order to maintain confidentiality;
3. Facts constituting grounds under the subparagraphs of paragraph (1).
- (3) Where the court decides to issue an order to maintain confidentiality, it shall serve a written decision on those who have received an order to maintain confidentiality.
- (4) An order to maintain confidentiality shall take effect from the time when a written decision is served on those who have received an order to maintain confidentiality.
- (5) One party may immediately appeal a decision to dismiss or reject a request for issuing an order to maintain confidentiality.

#### Article 228 (Revocation of Orders to Maintain Confidentiality)

- (1) Where a person who has made a request for issuing an order to maintain confidentiality or a person who has received an order to maintain confidentiality does not or fails to satisfy requirements under Article 227 (1), he/she may request the court which keeps the lawsuit records (where there is no court which keeps the lawsuit records, referring to the court which has issued an order to maintain confidentiality) to revoke an order to maintain confidentiality.
- (2) Where a decision on a request for revocation of an order to maintain confidentiality is made, the court shall serve the written decision on a person who has made the request and the other party.
- (3) Either party may immediately appeal a decision on the request for the revocation of an order to maintain confidentiality.
- (4) A decision to revoke an order to maintain confidentiality shall take effect when such decision becomes final and conclusive.
- (5) The court which has made a decision to revoke an order to maintain confidentiality shall immediately notify a person who has made a request

for the revocation of an order to maintain confidentiality or a person who has received an order to keep the relevant trade secrets confidential other than the other party, if any, of the fact that it has made a decision to revoke an order to maintain confidentiality.

Article 229 (Notification, etc. of Request for Perusal, etc. of Lawsuit Records)

- (1) Where there is a decision to restrict the perusal, etc. under Article 163 (1) of the Civil Procedure Act of the lawsuit records concerning a lawsuit in which a decision to maintain confidentiality has been made (excluding a lawsuit in which all orders to maintain confidentiality have been revoked), in which case any person who has not been ordered to maintain confidentiality in such lawsuit follows procedures for requesting the perusal, etc. of the part containing trade secrets for the other party who may peruse such trade secrets, a clerical officer of Grade IV, clerical officer of Grade V, clerical officer of Grade VI, or clerical officer of Grade VII of the court (hereafter in this Article, referred to as "clerical officer of Grade V, etc. of the court") shall notify one party (excluding a person who has made a request for the perusal thereof, etc.; hereafter in paragraph (3), the same shall apply) who requested the restrictions on the perusal, etc. pursuant to Article 163 (1) of the Civil Procedure Act of the fact that a request for perusal thereof, etc. has been made immediately after the clerical officer of Grade V, etc. of the court received such request.
- (2) In cases falling under paragraph (2), a clerical officer of Grade V, etc. of the court shall not allow a person who follows procedures for requesting the perusal, etc. to peruse the part containing trade secrets under paragraph (1) until two weeks elapse from the date a request under the aforesaid paragraph is made. In such cases, where a request for issuing an order to maintain confidentiality to a person who follows procedures for requesting the perusal, etc. is made within that period, the clerical officer of Grade V, etc. of the court shall not allow the person who follows procedures for requesting the perusal, etc. to peruse the part containing the trade secrets

under paragraph (1) until the time when a decision on such request becomes final and conclusive.

- (3) Paragraph (2) shall not apply where all of the relevant persons who have made a request for restricting the perusal, etc. pursuant to 163 (1) of the Civil Procedure Act give consent to allow a person who has made a request for the perusal, etc. pursuant to paragraph (1) to peruse the part containing trade secrets under paragraph (1).

## **CHAPTER XII PENAL PROVISIONS**

### Article 230 (Crime of Infringement)

Any person who infringes trademark rights or a exclusive license shall be punished by imprisonment with labor for not more than seven years or by a fine not exceeding 100 million won.

### Article 231 (Breaches of Orders to Maintain Confidentiality)

- (1) Any person who breaches an order to maintain confidentiality in the Republic of Korea or in a foreign country without justifiable grounds shall be punished by imprisonment with labor for not more than five years or by a fine not exceeding 50 million won.
- (2) With respect to a crime under paragraph (1), no case may be prosecuted without a criminal complaint filed by the person who has requested to issue the order to maintain confidentiality.

### Article 232 (Crime of Perjury)

- (1) Where a witness, expert witness, or interpreter who has made an oath pursuant to this Act makes any false statement, provides any false expert opinion, or gives any false interpretation before the Intellectual Property Trial and Appeal Board, he/she shall be punished by imprisonment with labor for not more than five years or by a fine not exceeding 10 million won.
- (2) Where a person who committed a crime under paragraph (1) confesses

himself/herself before a decision to grant or reject trademark registration or a trial decision of the case becomes final and conclusive, the penalty may be reduced or exempted.

#### Article 233 (Crime of False Indication)

Any person who violates Article 224 shall be punished by imprisonment with labor for not more than three years or by a fine not exceeding 20 million won.

#### Article 234 (Crime of Fraud)

Any person who obtains trademark registration, registration of additional designated goods, registration to renew the duration of trademark rights, registration of the conversion of the classification of goods, or trial decision by fraud or other improper means shall be punished by imprisonment with labor for not more than three years or by a fine not exceeding 20 million won.

#### Article 235 (Joint Penalty Provisions)

If the representative of a corporation, or an agent, employee or any other worker of a corporation or individual commits an offense under Article 230, 233 or 234 with respect to affairs of such corporation or individual, not only shall the offender be punished, but the corporation also shall be punished by the following fines and the individual shall be punished by a fine under the relevant Article: *Provided*, That the foregoing shall not apply where the corporation or individual has not neglected to pay due attention to and exercise reasonable supervision over the relevant affairs to prevent such offense:

1. Where he/she violates Article 230: A fine not exceeding 300 million won;
2. Where he/she violates Article 233 or 234: A fine not exceeding 60 million won.

#### Article 236 (Confiscation)

- (1) A trademark, mark, or goods (hereafter in this paragraph, referred to as "infringed goods") provided to infringe trademark rights or an exclusive license under Article 230 or generated from such infringement, and manufacturing tools or materials provided to be mainly used for manufacturing such infringed goods shall be confiscated.

- (2) Notwithstanding paragraph (1), where goods can be easily separated from a trademark or packing without impairing the function or appearance thereof, such goods may not be confiscated.

Article 237 (Administrative Fines)

- (1) Any of the following persons shall be subject to an administrative fine not exceeding five hundred thousand won:
  1. A person who has made an oath pursuant to Article 299 (2) or 367 of the Civil Procedure Act applied *mutatis mutandis* pursuant to Article 141 (7) but makes a false statement before the Intellectual Property Trial and Appeal Board;
  2. A person who has been ordered to produce or present documents or other things with respect to the taking of evidence or the preservation of evidence by the Intellectual Property Trial and Appeal Board but fails to comply with the order without justifiable grounds;
  3. A person who has been summoned to appear as a witness, expert witness, or interpreter by the Intellectual Property Trial and Appeal Board but fails to comply with such summons to appear without justifiable grounds or refuses to make an oath, make a statement, bear testimony, provide an expert opinion, or interpret, as otherwise requested.
- (2) Administrative fines under paragraph (1) shall be imposed and collected by the Commissioner of the Korean Intellectual Property Office, as prescribed by Presidential Decree.

## ADDENDA

**Article 1 (Enforcement Date)**

This Act shall enter into force six months after the date of its promulgation.

**Article 2 (General Transitional Measures)**

- (1) This Act shall apply beginning with the first application for trademark registration filed after this Act enters into force.
- (2) The amended provisions concerning a request for a trial of this Act shall

apply beginning with cases where a request for a trial is made after this Act enters into force: *Provided*, That the amended provisions of Article 79 (1) and (2) shall also apply to all request for a trial in which a decision to dismiss an amendment or decision to reject an amendment is revoked or withdrawn, request for a trial in which a decision on dismissal, or request for a trial in which a request for intervention is withdrawn or refused after April 28, 2016 which is the enforcement date of the Trademark Act partly amended by Act No. 13848.

**Article 3 (Applicability to Invalidation of Procedures)**

The amended provisions of the main sentence of Article 18 (2) shall also apply where trademark-related procedures are invalidated because a person who was ordered to make corrections before this Act enters into force has failed to observe the period of amendment in extenuating circumstances, in which case two months do not elapse from the date such grounds cease to exist at the time this Act enters into force.

**Article 4 (Applicability to Trademark of Which Registration Cannot Be Obtained)**

The amended provisions of Article 34 (1) (excluding the amended provisions of subparagraph 21 of the aforesaid paragraph) shall also apply where a decision to grant trademark registration for which an application was filed before this Act enters into force is made after this Act enters into force.

**Article 5 (Applicability to Amendment before Decision to Publish Application)**

The amended provisions of Article 40 (1) shall also apply to an application for trademark registration filed before this Act enters into force.

**Article 6 (Applicability to Recovery, etc. of Application for Trademark Registration through Payment of Trademark Registration Fees or Remainder Payment)**

- (1) The amended provisions of the main sentence of Article 77 (1) shall also apply where an applicant, etc. fails to pay a trademark registration fee within the period for payment of a trademark registration fee or to pay the remainder within the period for remainder payment in extenuating

circumstances before this Act enters into force, and two months do not elapse from the date such grounds cease to exist at the time this Act enters into force.

- (2) The amended provisions of the proviso to Article 77 (1) shall also apply where an applicant, etc. fails to pay a trademark registration fee within the period for payment of a trademark registration fee or to pay the remainder within the period for remainder payment in extenuating circumstances before this Act enters into force, and one year does not elapse from the later date between the expiration date of the period for payment of a trademark registration fee or the expiration date of the period for remainder payment at the time this Act enters into force.

**Article 7 (Applicability to Publication of Registrations of Trademark and Establishment of Trademark Rights)**

The amended provisions of Article 82 (3) shall apply beginning with the first case where a trademark is registered and trademark rights are established after this Act enters into force.

**Article 8 (Applicability to Dismissal of Request for Trial, etc.)**

The amended provisions of Article 127 (2) shall apply beginning with the first trial requested after this Act enters into force.

**Article 9 (General Transitional Measures)**

The former provisions shall apply to an application for trademark registration filed pursuant to the former provisions before this Act enters into force.

**Article 10 (Transitional Measures concerning Service Mark)**

Notwithstanding the amended provisions of Articles 2 (3), 3 (4) and 44 (1), the former provisions thereof shall apply where an application for service mark registration is filed or a service mark is registered pursuant to the former provisions at the time this Act enters into force.

**Article 11 (Transitional Measures concerning Incompetents)**

A person in whose case the effect of the declaration of an incompetent or a quasi-incompetent is maintained pursuant to Article 2 of Addenda of the Civil Act partly amended by Act No. 10429 shall be deemed included in an



adult placed under legal guardianship or a quasi-incompetent placed under the protection of a legal guardian under the amended provisions of Article 4 (1).

**Article 12 (Transitional Measures concerning Submission of Application for Trademark Registration)**

An application for trademark registration submitted after stating the classification of the category of goods pursuant to the former provisions as at the time this Act enters into force shall be deemed an application for trademark registration submitted pursuant to the amended provisions of Article 36 (1).

**Article 13 (Transitional Measures concerning Submission of Amended Articles of Incorporation, etc.)**

Notwithstanding the amended provisions of Article 43, the former provisions thereof shall apply where the articles of incorporation or the rules are amended before this Act enters into force.

**Article 14 (Transitional Measures concerning Institution Specializing in Examination)**

An institution specializing in examination designated pursuant to the former provisions as at the time this Act enters into force shall be deemed a specialized institution designated pursuant to the amended provisions of Article 51.

**Article 15 (Transitional Measures concerning Grounds, etc. for Notification of Decision to Reject Trademark Registration and Grounds for Rejection)**

- (1) Notwithstanding the amended provisions of Article 54, the former provisions thereof shall apply where an applicant has received notification of a decision to reject registration or grounds for rejection on the grounds that a trademark registered with a State party to the treaty or trademark similar thereto corresponds to a trademark for the registration of which an application is filed (hereafter in this Article, referred to as "relevant trademark") by designating goods identical or similar to designated goods of such trademark as its designated goods without justifiable grounds, such as where a person who is an agent or representative of a person who holds the right to such registered

trademark, or who was an agent or the representative of such person within one year before the filing date of an application for trademark registration fails to obtain consent of the person who holds the right to such goods.

- (2) Notwithstanding the amended provisions of Article 119 (1), the former provision thereof shall apply where the relevant trademark has been registered as at the time this Act enters into force, and a person who holds the right to a trademark registered with a State party to the treaty requests a trial to revoke the relevant trademark within five years from the date of registration thereof pursuant to the former provision.

**Article 16 (Transitional Measures concerning Ex Officio Amendment)**

Notwithstanding the amended provisions of Article 59, the former provisions thereof shall apply where an amendment to an application for trademark registration was made *ex officio* before this Act enters into force.

**Article 17 (Transitional Measures concerning Effect of Right to Use under Amendment of Former Act)**

The former provisions shall apply to the effect of rights to use registered pursuant to the provisions before amended (hereinafter referred to as "former provisions") by the Trademark Act (hereafter in this Article, referred to as the "aforesaid Act") before September 1, 1990 which is the enforcement date of the aforesaid Act as amended by Act No. 4210.

**Article 18** Omitted.

**Article 19 (Relationship to Other Statutes)**

Where any of the provisions of the former Trademark Act are cited in other statutes as at the time this Act enters into force, and this Act contains provisions corresponding thereto, the relevant provisions of this Act shall be deemed cited, in lieu of such former provisions.