

## **CHAPTER V**

### **DESIGN RIGHT**

#### **Article 39 Registration of Establishment of a Design Right**

- (1) A design right is effective upon the registration of its establishment.
- (2) When registration fees have been paid in accordance with Article 31(1), or when an exemption from paying the fees or a reduction of payment has been granted under Article 35(1) or (2),
- (3) When a right is registered under paragraph (2), the Commissioner of the Korean Intellectual Property Office shall publish the following particulars in the Design Gazette:
  - (i) the name and address of the owner of the design right (and, if a legal entity, the title and business address);
  - (ii) the registration number of the design; and
  - (iii) the date of registration of the establishment of the right.

#### **Article 40 The Term of a Design Right**

- (1) The term of a design right is for fifteen years after the registration date of its establishment. However, the expiry date of the term of a design right related to a similar design is the expiry date of the term of the design right related to the principal design.
- (2) Where design registration is bestowed to a lawful holder under Articles 14 or 15, the term of the design right under paragraph(1) starts on the day after the date of registration of the design right previously filed by the unentitled person.

### **Article 41 Effects of a Design Right**

The owner of a design right has the exclusive right to commercially and industrially work the registered design and a similar design. However, where the design right is subject to an exclusive license, this provision does not apply to the extent that the exclusive licensee has the exclusive right to work the registered design or similar design under Article 47(2).

### **Article 42 Design Right Related to a Similar Design**

A person may incorporate a design right related to a similar design as defined in Article 7(1) in a design right related to the principal design.

### **Article 43 Scope of Protection of a Registered Design**

The scope of protection conferred by a registered design is determined by the terms of the description in the application, the design represented in a drawing attached to the application or shown in a photograph or sample attached to the application, and in the explanation of the intent and purpose of the design attached to the drawing.

### **Article 44 Limitations of a Design Right**

The effects of a design right do not extend to any of the following:

- (i) the use of a registered design for research or an experiment;
- (ii) vessels, aircraft or vehicles merely passing through the Republic of Korea or the machinery, instruments, equipment or other accessories used in the vessels, aircraft or vehicles; or
- (iii) identical products existing in the Republic of Korea at the time the application for registration of a design was filed.

### **Article 45 Relationship with another Person's Registered Design**

(1) Where working a registered design would utilize another person's registered design or design similar to the registered design, or patented invention, registered utility model or registered trademark under an application filed before the filing date of the application for the registration of the design concerned, or where a design right conflicts with another person's patent right, utility model right or trademark right under an application filed before the filing date of the application for registration of a design concerned, the owner of the design right or exclusive or nonexclusive licensee may not work the registered design commercially or industrially without the consent of the owner of the earlier patent right, utility model right or trademark right, unless Article 70 applies.

(2) Where working a design similar to a registered design would utilize another person's registered design or design similar to the registered design, or patented invention, registered utility model or registered trademark under an application filed before the filing date of the application for the registration of the design concerned, or where a design right of the design similar to the registered design conflicts with another person's registered design, patent right, utility model right or trademark right under an application filed before the filing date of the application for registration of the design concerned, the owner of the design right or exclusive or nonexclusive licensee may not work the design similar to the registered design commercially or industrially without the consent of the owner of the earlier patent right, utility model right or trademark right, unless Article 70 applies.

(3) Where working a registered design or a design similar to the registered design would utilize or conflict with another person's copyright, effective before the filing date of the application for registration of the design concerned, the owner of the design right or exclusive or nonexclusive licensee may not work the registered design or similar design commercially or industrially without the consent of the owner of the copyright.

### **Article 46 Assignment and Joint Ownership of a Design Right**

(1) A design right may be assigned. However, a design right related to a principal design and a design right related to a similar design must be assigned together.

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

(3) Where a design right is jointly owned, and unless otherwise agreed in a contract of the owners, an owner may individually work the registered design or similar design without the consent of the other owners.

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

(5) A design right registered as a multiple design may be divided and transferred for each design right.

#### **Article 47 Exclusive License**

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

(2) An exclusive licensee granted an exclusive license under paragraph (1) has the exclusive right to commercially and industrially work the registered design or similar design to the extent allowed in the license contract.

(3) An exclusive licensee may not transfer the license without the consent of the owner of the design right, except when the license is transferred with the business in which it is worked or in the case of inheritance or other general succession.

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

(5) Article 46(2) to (4) applies *mutatis mutandis* to exclusive licenses.

**Article 48 Deleted**

**Article 49 Nonexclusive License**

(1) The owner of a design right may grant a nonexclusive license on the design right.

(2) A nonexclusive licensee is entitled to work the registered design and a design similar to the registered design commercially and industrially to the extent allowed in this Act or by the license contract.

(3) Article 46(2) and (3) of this Act and Article 102(4) to (6) of the Patent Act apply *mutatis mutandis* to a nonexclusive license.

**Article 50 Nonexclusive License by Virtue of Prior Use**

When filing an application for design registration, if a person has created a design that is identical or similar to the design in an existing application, without prior knowledge of the design in the application, or has learned how to create the design from another person and has been working the design commercially or industrially in the Republic of Korea in good faith, or has been making preparations to work the design, the person is entitled to have a nonexclusive license on that registered design or similar design. The license, however, must be limited to the design being worked, or for which preparations for working have been made, and to the purpose of the working or preparations.

**Article 51 Nonexclusive License Due to Working before Registration of Demand for an Invalidation Trial**

(1) Where a person falling within any of the following subparagraphs has, in good faith, been commercially or industrially working a design or a similar design in the Republic of Korea, or has been making preparations to work the design, before the registration of a request for an invalidation trial of the design registration concerned, without knowing that the design registration is subject to invalidation, the person is entitled to have a nonexclusive license on that design right or on the exclusive license existing at the time the design

registration was invalidated, but the nonexclusive license must be limited to the design being worked, or for which preparations for working are being made, and to the purpose of the working or preparations:

- (i) the original owner of the design right, where one of two or more design registrations granted for the same or similar design has been invalidated;
- (ii) the original owner of the design right, where the design registration has been invalidated and design registration for the same or similar design has been granted to an entitled person;
- (iii) in the cases referred to in subparagraphs (i) and (ii), a person who, at the time of registration of the request for an invalidation trial of the design right that has been invalidated, has been granted an exclusive or nonexclusive license or nonexclusive license on the exclusive license and the license has been registered. However, a person falling under Article 118(2) of the Patent Act as applied under Article 61 of this Act is not required to register the license.

(2) A person granted a nonexclusive license under paragraph(1) shall pay reasonable remuneration to the owner of the design right or the exclusive licensee.

### **Article 52 Nonexclusive License after a Design Right Expires etc.**

(1) Where a design similar to a registered design conflicts with a design right registered on or before the date of application for registration of the design (referred to as "a primary design right"), the owner of the primary design right is entitled to have a nonexclusive license for the design right not exceeding the scope of the primary design right when the term of the primary design right expires, or a nonexclusive license for an exclusive license of the design right that exists when the term of the primary design right expires.

(2) Under paragraph (1), an exclusive licensee of a primary design right that exists when the term of the primary right expires, or a nonexclusive licensee under Article 118(1) of the Patent Act, as applied *mutatis mutandis* under

Article 61 of this Act, is entitled to have a nonexclusive license for a design right not exceeding the scope of the primary design right, or a nonexclusive license for the exclusive license of the design right that exists when the term of the primary design right expires.

(3) Paragraphs (1) and (2) apply *mutatis mutandis* where a registered design or a design similar to a registered design conflicts with a patent right or a utility model right registered on or before the date of application for registration of design, and where the term of the patent right or utility model right expires.

(4) The owner of a nonexclusive license paragraph(2) (including when (3) applies *mutatis mutandis*) shall pay reasonable remuneration to the owner of the design right or the exclusive licensee for the design right.

### **Article 53 Abandonment of a Design Right**

The owner of a design right may abandon the design right.

### **Article 54 Restriction on Abandonment of a Design Right etc.**

(1) The owner of a design right may not abandon the design right without the consent of the exclusive licensee, pledgee or nonexclusive licensee under Articles 47(4) or 49(1) of this Act or Article 39(1) of the Patent Act as applied *mutatis mutandis* under Article 24 of this Act.

(2) An exclusive licensee may not abandon the exclusive license without the consent of the pledgee or nonexclusive licensee under Article 47(4).

(3) A nonexclusive licensee may not abandon the nonexclusive license without the consent of the pledgee.

### **Article 55 Effect of Abandonment**

When a design right or an exclusive or nonexclusive license is abandoned, the design right or the exclusive or nonexclusive license on the design right is

extinguished.

### **Article 56 Pledge**

Where a design right or an exclusive or nonexclusive license is the subject of a pledge, the pledgee may not work the registered design except as otherwise provided by contract.

### **Article 57 Subrogation for the Right of a Pledge**

A pledge may be exercised against the remuneration allowed under this Act or against remuneration or goods to be received for working a design right; however, an attachment order must be obtained before the payment or delivery of the remuneration or goods.

### **Article 58 Nonexclusive License when Transferring the Design Right by Exercising the Pledge Right**

Where the owner of a design right has worked a registered design or similar design that is the subject of a pledge before the establishment of the pledge, and the design right is subsequently sold at an auction and so on, the owner is entitled to have a nonexclusive license on the registered design right; however, the owner of the design right shall pay reasonable remuneration to the pledgee.

### **Article 59 Extinguishment of a Design Right in the Absence of a Successor**

A design right is extinguished if no successor exists at the time of succession.

### **Article 60 Report on Working a Registered Design**

The Commissioner of the Korean Intellectual Property Office may require the owner of a design right or the exclusive or nonexclusive licensee to report whether the registered design has been worked, the extent of the working and



so on.

**Article 61 *Mutatis Mutandis* Application of the Patent Act**

Articles 101, 106, 118 and 125*bis* of the Patent Act apply *mutatis mutandis* to design rights.

**CHAPTER VI**

**PROTECTION OF OWNER OF DESIGN RIGHT**

**Article 62 Injunction against an Infringement etc.**

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

(2) An owner of a design right or an exclusive licensee who is acting under paragraph(1) may demand the destruction of the articles that resulted from the act of infringement, the removal of the facilities used for the act of infringement, or other measures necessary to prevent the infringement.

**Article 63 Acts Considered to be Infringing**

Acts of commercially or industrially manufacturing, assigning, leasing, importing or offering for assignment or lease (including displaying for assignment or lease) articles used exclusively for manufacturing articles to which a registered design or similar design has been applied for are shall be considered to infringe the design right or exclusive license.

**Article 64 Presumption etc. of the Amount of Damages**