

(2) Where a patent registration certificate does not coincide with the patent register or other documents, the Commissioner of the Korean Intellectual Property Office shall reissue the patent registration certificate with amendments, or issue new letters patent upon request or *ex officio*.

(3) When a decision on a trial for amendment under Article 136(1) has become final, the Commissioner of the Korean Intellectual Property Office shall issue a new patent registration certificate in accordance with the trial decision.

## CHAPTER V

### PATENT RIGHT

#### **Article 87 Registration of the Establishment of a Patent Right and the Publication of Registration**

(1) A patent right enters into effect upon the establishment of the patent registration.

(2) Where patent fees have been paid under Article 79(1), late payment of the fees has been paid under Article 81(1), the remaining portion of the fees has been paid under Article 81*bis*(2), the patent fees or the remaining portion of the fees has been paid under Article 81*ter*(1) or where an exemption from the payment of patent fees has been granted under Article 83(1)(i) and (2), the Commissioner of the Korean Intellectual Property Office shall register the patent to establish a patent right. However, in either of the following subparagraphs, a patent right may be registered only if the utility model right concerned is abandoned:

- (i) where a utility model right has been registered for a utility model application that forms the basis of a dual application; or
- (ii) where a dual application for a utility model registration has been filed under Article 17 of the Utility Model Act on the basis of an application

for a patent, and where the utility model right has been registered for the dual application for a utility model registration.

(3) Where a registration has been made under paragraph(2), the Commissioner of the Korean Intellectual Property Office shall publish the grant of the patent with the relevant information in the Patent Gazette.

(4) The publication of a patent registration for an invention required to be treated confidentially must be reserved until the invention is declassified; upon declassification, the registration must be published immediately.

(5) The Commissioner of the Korean Intellectual Property Office shall provide the application documents and the attached application materials for public inspection for the three-month period after the date on which the registration is published.

(6) Matters to be published in the Patent Gazette concerning the publication of registration under paragraph (3) are prescribed by Presidential Decree.

### **Article 88 The Term of a Patent Right**

(1) The term of a patent right commences upon registration of the patent right under Article 87(1) and ends twenty years after the filing date of the patent application.

(2) Where a patent is granted to the lawful holder of a right under Articles 34 and 35, the term of the patent right under paragraph (1) is calculated from the day after the date on which the unentitled person files the patent application.

(3) Deleted.

(4) Where a patent application is deemed to have been filed at the time of submitting a dual application under Article 49(2), the term of a patent right under paragraph(1) of this Article commences upon registration of the patent right and remains in force for twenty years after the filing date of the utility model application that is the basis of the dual application.

### **Article 89 Extension of the Term of a Patent Right**

Notwithstanding Article 88(1), where authorization or registration under other laws or regulations is required to work a patented invention and an extended period has been taken to complete the activity test, safety tests and so on necessary to obtain the authorization or registration (referred to as "an authorization"), and where the authorization is prescribed by Presidential Decree, the term of the patent right may be extended by a period up to five years during which the patented invention could not have been worked.

### **Article 90 Application to Register an Extension of the Term of a Patent Right**

(1) A person seeking to register an extension for a patent right under Article 89 (referred to as "an applicant for registration of extension") shall submit an application to register an extension of the patent right term to the Commissioner of the Korean Intellectual Property Office, stating the following:

- (i) the name and address of the applicant for registration of extension (and, if a legal entity, the name and address of the business);
- (ii) the name and residential or business address of the agent, if any (and, if the agent is a patent legal entity, the name and address of the business and the name of the designated patent attorney);
- (iii) the number of the patent for which the extension is sought and the scope of the claim(s) of that patent;
- (iv) the period of extension sought;
- (v) the requirements for authorization under Article 89; and
- (vi) the grounds for extension as prescribed by ordinance of the Ministry of Commerce, Industry and Energy (accompanied by materials substantiating the grounds).

(2) An application to register an extension for the term of a patent right must be filed within three months after the date on which the authorization under Article 89 was obtained; however, the application may not be filed when the unexpired length of the term prescribed in Article 88 is less than six months.

(3) Where a patent is jointly owned, an application to register an extension for the term of the patent right must be made in the name of all the owners.

(4) Where an application to register an extension for the term of a patent right has been filed, the term is deemed to have been extended, unless a decision of refusal to extend the term of a registered patent under Article 91(1) has become final.

(5) Where an application to register an extension for the term of a patent right has been filed, the Commissioner of the Korean Intellectual Property Office shall publish the information prescribed in paragraph(1) in the Patent Gazette.

(6) An applicant may amend the matter of paragraph(1)(iii) to (vi) in an application to register the extension (except the patent number of the patent right to be extended, as referred to in subparagraph (iii)) if the amendment is made before the examiner transmits a certified copy of the decision for registration or refusal of the extension.

### **Article 91 Decision of Refusal to Extend the Term of a Registered Patent**

(1) An examiner shall refuse to extend the term of a patent right when it falls under any of the following subparagraphs:

- (i) where an authorization under Article 89 is considered unnecessary for working a patented invention;
- (ii) where a patentee or a person who has an exclusive or registered nonexclusive license under the patent right has not obtained authorization under Article 89;

- (iii) where the term for which an extension is sought exceeds the period in which the patented invention could not have been worked;
- (iv) where the applicant for registration of an extension is not the patentee; or
- (v) where the application to register an extension violates Article 90(3);
- (vi) deleted.

(2) The period referred to in paragraph(1)(iii) does not include any period that has elapsed for reasons attributable to the patentee.

### **Article 92 Decision etc. on Registration for Extending the Term of a Patent Right**

(1) Where an examiner finds no grounds under any subparagraph of Article 91(1) to refuse an application to extend the term of a patent right, the examiner shall grant the extension.

(2) Where a decision to extend has been made under paragraph(1), the Commissioner of the Korean Intellectual Property Office shall register the extension of the term of the patent right in the Patent Register.

(3) Where the registration under paragraph(2) has been made, the information prescribed in the following subparagraphs must be published in the Patent Gazette:

- (i) the name and address of the patentee (if the patentee is a legal entity, the title and address of the business);
- (ii) the patent number;
- (iii) the date of registration of the extension;
- (iv) the period of the extension; and
- (v) the contents of the authorization and so on under Article 89.

### **Article 93 *Mutatis Mutandis* Application of Provisions**

Articles 57(1), 63, 67 and 148(i) to (v) and (vii) apply *mutatis mutandis* to the examination of an application to register an extension for the term of a patent right.

### **Article 94 Effects of Patent Right**

A patentee has an exclusive right to work a patented invention commercially and industrially unless the patent right is the subject of an exclusive license, in which case the exclusive licensee has an exclusive right to work the patented invention under Article 100(2).

### **Article 95 Effects of Patent Right the Term of which has been Extended**

The effects of a patent right whose term has been extended do not extend to any other acts except working the patented invention for products whose authorization was the basis for registering the extension (or where the authorization was obtained for a specific use of the product, for products adapted to the specific use).

### **Article 96 Limitations on a Patent Right**

(1) The effect of a patent right does not extend to any of the following subparagraphs:

- (i) working a patented invention for research or experimental purposes;
- (ii) vessels, aircraft or vehicles merely passing through the Republic of Korea, or machinery, instruments, equipment or other accessories used on the vessels, aircraft or vehicles; or
- (iii) articles existing in the Republic of Korea when the patent application was filed.

(2) The effects of a patent right for the invention of products used for diagnosis, therapy, alleviation, medical treatment or prevention of human disease (referred to as "medicines") that are manufactured by mixing two or more medicines, or for the invention of processes for manufacturing medicines by mixing two or more medicines, do not extend to acts of dispensing medicines under the Pharmaceutical Affairs Act or to medicines manufactured by such acts.

### **Article 97 Scope of Protection of Patented Invention**

The scope of protection conferred by a patented invention is determined by the subject matter described in the claim(s).

### **Article 98 Relation to Patented Invention etc. of Another Person**

Where working a patented invention would infringe another person's patented invention, registered utility model or registered design or similar design under an application filed before the filing date of the patent application concerned, or where a patent right conflicts with another person's design right or trademark right under an application for design or trademark registration filed before the filing date of the patent application concerned, the patentee, exclusive licensee or nonexclusive licensee may not work the patented invention commercially or industrially without a license from the owner of the earlier patent, utility model right, design right or trademark right.

### **Article 99 Assignment and Joint Ownership of a Patent Right**

(1) A patent right may be assigned.

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

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

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

### **Article 100 Exclusive License**

- (1) A patentee may grant an exclusive license of the patent right to others.
- (2) An exclusive licensee granted an exclusive license under paragraph (1) has the exclusive right to work the patented invention commercially or industrially to the extent allowed in the license contract.
- (3) Except when a license is transferred by inheritance or other general succession, an exclusive licensee may not transfer a license with the underlying business of the licensee without the consent of the patentee.
- (4) An exclusive licensee may not establish a pledge or grant a nonexclusive license on an exclusive license without the consent of the patentee.
- (5) Article 99(2) to (4) applies *mutatis mutandis* to an exclusive license.

### **Article 101 Effects of Registration of a Patent Right and an Exclusive License**

- (1) Unless the relevant patent right or exclusive license is registered, the following patent-related procedures have no effect:
  - (i) the transfer (except through inheritance or other general succession) or extinguishment by abandonment, or restriction on the disposal of a patent right;
  - (ii) the grant, transfer (except through inheritance or other general succession), modification, extinguishment (except through confusion) or restriction on the disposal of a patent right or exclusive license; or

(iii) the establishment, transfer (except through inheritance or other general succession), modification, extinguishment (except through confusion) or restriction on the disposal of a pledge on a patent right or exclusive license.

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

### **Article 102 Nonexclusive License**

(1) A patentee may grant to others a nonexclusive patent license.

(2) A nonexclusive licensee is entitled to work the patented invention commercially or industrially to the extent prescribed in this Act or allowed by the license contract.

(3) A nonexclusive license granted under Article 107 may only be transferred with the underlying business.

(4) A nonexclusive license under Article 138 of this Act, Article 53 of the Utility Model Act or Article 70 of the Industrial Design Act must be transferred with the patent right, utility model right or design right concerned and is extinguished when the concerned patent, utility model or design right concerned is extinguished.

(5) A nonexclusive license other than those described in paragraphs (3) and (4) may not be transferred without the consent of the patentee (or the patentee and the exclusive licensee for a nonexclusive license on an exclusive license), unless the transfer is made with the underlying business or through inheritance or other general succession.

(6) A pledge may not be established on a nonexclusive license other than those under paragraphs (3) and (4) without the consent of the patentee (or the patentee and the exclusive licensee for a nonexclusive license on an exclusive license).

(7) Article 99(2) and (3) applies *mutatis mutandis* to a nonexclusive license.

### **Article 103 Nonexclusive License by Prior Use**

When filing a patent application, a person who has made an invention without prior knowledge of the contents of an invention described in an existing patent application, or who has learned how to make the invention from such a person and has been working the invention commercially or industrially in the Republic of Korea in good faith or has been making preparations to work the invention is entitled to have a nonexclusive license on the patent right for the invention under the patent application. The nonexclusive license must be limited to the invention being worked, or for which preparations for working have been made, and to the purpose of such working or preparations.

### **Article 104 Nonexclusive License Due to Working before Registration of a Request for an Invalidation Trial**

(1) Where a person has been commercially or industrially working an invention in the Republic of Korea, or has been making preparations to work the invention, before the registration of a request for an invalidation trial of the concerned patent or utility model, without knowing that the patented invention is subject to invalidation, or where a person has been commercially or industrially working a device in the Republic of Korea or has been making preparations to work the device on the basis of a maintenance decision as prescribed in Article 25(2) of the Utility Model Act or without knowing that the registered utility model is subject to invalidation notwithstanding any due care, the person is entitled under any of the following circumstances to have a nonexclusive license on that patent right or a nonexclusive license on the exclusive license to the patent right existing when the patent or utility model registration was invalidated; however, the nonexclusive license must be limited to the invention or device being worked or for which preparations for working are being made, and to the purpose of such working or preparations:

- (i) the original patentee, where one of two or more patents granted for the same invention has been invalidated;

- (ii) the original owner of a utility model right, where a patented invention and a device registered as a utility model are the same and the utility model registration has been invalidated;
  - (iii) the original patentee, where the patent has been invalidated and a patent for the same invention has been granted to an entitled person;
  - (iv) the original owner of a utility model right, where the utility model registration has been invalidated and a patent for the same invention as the device has been granted to an entitled person; or
  - (v) in the cases referred to in subparagraphs (i) to (iv), a person who, at the time of registering a request for an invalidation trial of an invalidated patent right or utility model right, has been granted an exclusive license, a nonexclusive license or a nonexclusive license on the exclusive license and the license has been registered; however, a person falling under Article 118(2) is not required to register the license.
- (2) A person granted a nonexclusive license under paragraph (1) shall pay reasonable remuneration to the patentee or exclusive licensee.

### **Article 105 Nonexclusive License after a Design Right Expires**

- (1) Where a design right under an application that resulted in the granting of a registration filed on or before the filing date of a patent application conflicts with the patent right and the term of the design right has expired, the owner of the design right is entitled, to the extent of the design right, to have a nonexclusive license on the patent right or the exclusive license that existed when the design right expired.
- (2) Where a design right under an application that resulted in the grant of a registration filed on or before the filing date of a patent application conflicts with the patent right and the term of the design right has expired, a person who at the expiry of the term has an exclusive license on the expired design right or nonexclusive license to the design right or the exclusive license, under Article 118(1) of this Act as applied under Article 61 of the Industrial Design Act, is entitled to have a nonexclusive license on the patent right

concerned or on the exclusive license existing when the design right expired, to the extent of the expired right.

(3) A person granted a nonexclusive license under paragraph(2) shall pay reasonable remuneration to the patentee or exclusive licensee.

### **Article 106 Expropriation of Patent Right etc.**

(1) If a patented invention is necessary for national defense in time of war, incident or other similar emergency, the Government may expropriate the patent right, work the patented invention or require a person other than the Government to work the patented invention.

(2) Where a patent right is expropriated, the rights to the invention other than the patent right are extinguished.

(3) If the Government expropriates a patent right, or the Government or a person other than the Government works the patented invention under paragraph(1), the Government or that person shall pay reasonable remuneration to the patentee, exclusive licensee or nonexclusive licensee.

(4) Matters necessary for expropriating and working a patent right as well as remuneration for these acts are prescribed by Presidential Decree.

### **Article 107 Adjudication for the Grant of a Nonexclusive License**

(1) Where a patented invention falls under any of the following subparagraphs, a person who intends to work the patented invention may request the Commissioner of the Korean Intellectual Property Office to adjudicate (referred to as "an adjudication") for the authorization of a nonexclusive license; however, a request for adjudication under the following subparagraphs (i) and (ii) may only be made if consultations with the patentee or exclusive licensee is not possible or no agreement is reached at the consultation:

- (i) where the patented invention has not been worked for more than three consecutive years in the Republic of Korea, except for natural disasters, unavoidable circumstances or other justifiable reasons prescribed by Presidential Decree;
  - (ii) where the patented invention has not continuously been worked commercially or industrially in the Republic of Korea on a substantial scale during a period of three years or more without justification, or where the domestic demand for the patented invention has not been satisfied to an appropriate extent and under reasonable conditions;
  - (iii) where working the patented invention noncommercially is necessary for the interests of the public; or
  - (iv) where working the patented invention is necessary to remedy a practice determined to be unfair after the judicial or administrative process.
- (2) Paragraph (1)(i) and (ii) of this Article does not apply unless a period of four years has elapsed after the filing date of the application for the patented invention.
- (3) In adjudicating the authorization of a nonexclusive license, the Commissioner of the Korean Intellectual Property Office shall consider the necessity of each request.
- (4) In adjudicating the authorization of a nonexclusive license, the Commissioner of the Korean Intellectual Property Office shall limit the use of patented inventions through the nonexclusive license predominantly to the supply of the domestic market, unless the authorization is based on a request under subparagraph (1)(iv).
- (5) In adjudicating the authorization of a nonexclusive license set forth in subparagraph (1)(i), the Commissioner of the Korean Intellectual Property Office may take into account the need to amend unfair practices in determining the amount of remuneration.
- (6) For semiconductor technology, a request for adjudication may be made only in the cases set forth in subparagraph (1)(iii) and (1)(iv).

### **Article 108 Submission of Response**

Where a request for an adjudication has been made, the Commissioner of the Korean Intellectual Property Office shall transmit a copy of the written request to the patentee or exclusive licensee mentioned in the request and to any other persons with a registered right related to the patent, and shall give them an opportunity to submit a response within a designated period.

### **Article 109 Solicitation of Opinion from the Intellectual Property Rights Dispute Committee**

Before adjudicating, the Commissioner of the Korean Intellectual Property Office shall solicit an opinion from the Intellectual Property Rights Dispute Committee established under Article 29 of the Invention Promotion Act.

### **Article 110 Formality of Adjudication**

- (1) An adjudication must be in writing and must state the reasons for the adjudication.
- (2) The following matters must be specified in an adjudication under paragraph (1):
  - (i) the scope and duration of the nonexclusive license; and
  - (ii) the remuneration for the license and the method and time of payment.

### **Article 111 Transmittal of Certified Copies of Adjudication**

- (1) Where an adjudication is made, the Commissioner of the Korean Intellectual Property Office shall transmit a certified copy of the adjudication to the parties and to any other persons with a registered right related to the patent.
- (2) Where a certified copy of an adjudication has been transmitted to the

parties under paragraph (1), a consultation on the terms as specified in the adjudication is deemed to have been held by the parties.

### **Article 112 Deposit of Remuneration**

Under any of the following circumstances, a party obligated to pay remuneration under Article 110(2)(ii) shall deposit the remuneration:

- (i) where the party entitled to receive the remuneration refuses the remuneration or is unable to receive it;
- (ii) where an action under Article 190(1) has been brought concerning the remuneration; or
- (iii) where the patent right or exclusive license is the subject of a pledge, unless the pledgee has consented.

### **Article 113 Lapse of Adjudication**

Where a person granted an adjudication on an authorization fails to pay or deposit the remuneration (or the first installment of the payment, if the payment is to be made periodically or by installments) under Article 110(2)(ii) by the time the payment is due, the adjudication loses its effect.

### **Article 114 Cancellation of an Adjudication**

(1) Where a person is granted an adjudication on an authorization under either of the following circumstances, the Commissioner of the Korean Intellectual Property Office may cancel the adjudication *ex officio* or upon the request of any interested party. However, for subparagraph (ii), such action must protect the lawful interests of the nonexclusive license:

- (i) where working the patented invention is not within the purpose of the adjudication; or

- (ii) where the grounds for adjudicating the authorization of a nonexclusive license disappear and are considered unlikely to reoccur.

(2) Articles 108, 109, 110(1) and 111(1) apply *mutatis mutandis* to paragraph (1) of this Article.

(3) A nonexclusive license is extinguished upon cancellation of the ruling under paragraph (1) of this Article.

### **Article 115 Restriction on Reasons for Objections to an Adjudication**

Where a request for an administrative trial has been filed under Article 3(1) of the Administrative Trial Act or a revocation action has been brought under the Administration Litigation Act for an adjudication, the remuneration determined in the adjudication may not be a basis for objection.

### **Article 116 Cancellation of a Patent Right**

(1) Where a patented invention has not been continuously worked in the Republic of Korea for a period of two years or more from the date of an adjudication under Article 107(1)(i), the Commissioner of the Korean Intellectual Property Office may cancel the patent right, *ex officio*, or upon the request of any interested party.

(2) Articles 108, 109, 110(1) and 111(1) apply *mutatis mutandis* to paragraph (1) of this Article.

(3) When a patent right under paragraph (1) of this Article is cancelled, the patent right is extinguished.

### **Article 117 Deleted**

### **Article 118 Effects of Registration of a Nonexclusive License**

(1) When a nonexclusive license has been registered, it is also effective

against any person who subsequently acquires the patent right or an exclusive license.

(2) A nonexclusive license granted under Articles 39(1), 81*bis*(4), 103 to 105, 122, 182 or 183 has the same effect as prescribed under paragraph(1) of this Article even if it has not been registered.

(3) The transfer, modification, extinguishment or restriction on disposal of a nonexclusive license or the establishment, transfer, modification, extinguishment or restriction on disposal of a pledge related to a nonexclusive license is not effective against a third party unless it is registered.

#### **Article 119 Restriction on Abandonment of a Patent Right etc.**

(1) A patentee may not abandon a patent right without the consent of the exclusive licensee, pledgee or nonexclusive licensee under Articles 39(1), 100(4) or 102(1).

(2) An exclusive licensee may not abandon an exclusive license without the consent of the pledgee or nonexclusive licensee under Article 100(4).

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

#### **Article 120 Effects of Abandonment**

When a patent right or an exclusive or nonexclusive license is abandoned, the patent right or a license to the patent right is extinguished.

#### **Article 121 Pledge**

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

**Article 122 Nonexclusive License Incidental to Transfer of Patent Right by Exercise of a Pledge Right**

If a patentee works a patented invention before the establishment of a pledge on the patent right, the patentee is entitled to have a nonexclusive license on the patented invention even if the patent right is transferred by an auction; however, the patentee shall pay reasonable remuneration to the person to whom the patent right is transferred by an auction and so on.

**Article 123 Subrogation of Pledge Right**

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

**Article 124 Extinguishment of a Patent Right in the Absence of a Successor**

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

**Article 125 Report on Working a Patent**

The Commissioner of the Korean Intellectual Property Office may require a patentee, exclusive licensee or nonexclusive licensee to report whether the patented invention has been worked, the extent of such working and so on.

**Article 125bis The Title of Execution on Amount of Compensation and Remuneration**

A final ruling by the Commissioner of the Korean Intellectual Property Office on the amount of the compensation or remuneration to be paid under this Act has the same effect as an enforceable title of execution; an official of the

Korean Intellectual Property Office shall give the legal writ, which has the force of execution.

## **CHAPTER VI**

### **PROTECTION OF PATENTEE**

#### **Article 126 Injunction etc. against an Infringement**

(1) A patentee or exclusive licensee may demand a person who is infringing or is likely to infringe on a patent right of the patentee or exclusive licensee to discontinue or refrain from the infringement.

(2) A patentee or an exclusive licensee acting under paragraph (1) may demand the destruction of articles by which an act of infringement was committed (including products obtained by the act of infringement in cases of a process invention for manufacturing the products), the removal of the facilities used for the act of infringement, or other measures necessary to prevent the infringement.

#### **Article 127 Acts of Infringement**

Either of the following acts is considered to infringe a patent right or an exclusive license:

- (i) an act of making, assigning, leasing, importing or offering for assignment or lease articles used exclusively for producing an invented product; or
- (ii) an act of making, assigning, leasing, importing or offering for assignment or lease articles used exclusively for working an invented process.