

Article 5 *Mutatis Mutandis* Application of the Patent Act

Articles 3 to 26 and 28 to 28^{quinqüies} of the Patent Act apply *mutatis mutandis* to trademarks. In such cases, "Article 132^{ter}" in Articles 6, 11(1)(iv), 15(1) and 17 of the Patent Act reads "Article 70^{bis} or 70^{ter}", "patent right and patent" in the proviso of Article 28(2) of the Patent Act reads "trademark right and trademark" and "international application under Article 2(vii) of the Patent Cooperation Treaty (referred to as an 'international application')" reads "international application under Article 2(2) of the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (referred to as 'an international application'). (The Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks is referred to as 'the Protocol')".

CHAPTER II

REQUIREMENTS FOR TRADEMARK REGISTRATION AND TRADEMARK APPLICATIONS

Article 6 Requirements for Trademark Registration

- (1) Trademark registration may be obtained except in the following cases:
- (i) where the mark consists solely of a sign indicating, in a common way, the usual name of the goods;
 - (ii) where the mark is customarily used on the goods;
 - (iii) where the mark consists solely of a sign indicating, in a common way, the origin, quality, raw materials, efficacy, use, quantity, shape (including shape of packaging) or price of the goods, or the method or time of manufacturing, processing or using them;
 - (iv) where the mark consists solely of a sign indicating a conspicuous

geographical name, an abbreviation of a conspicuous geographical name or a map;

- (v) where the mark consists solely of a sign indicating, in a common way, a common surname or name of a legal entity;
- (vi) where the mark consists solely of a very simple and commonplace sign;
- (vii) in addition to the cases mentioned in subparagraph (i) to (vi), where the mark does not enable consumers to recognize the person whose goods are indicated by the mark.

(2) Even if a trademark that falls under paragraph (1)(iii) to (vi), where, as a result of using the trademark before the application for registration under Article 9, consumers are easily able to recognize the person whose goods are indicated by the trademark, the trademark may be registered with the designated goods for which the trademark has been used; the same applies to designated goods and supplementary designated goods as defined in Articles 10(1) and 47(2)(iii).

Article 7 Unregistrable Trademarks

(1) Notwithstanding Article 6, trademark registration may not be obtained in the following cases:

- (i) trademarks that are identical or similar to the following: the national flag, the national emblem, as well as colors, medals, decorations or badges of the Republic of Korea; the national flags or emblems of foreign nations; the medals, decorations or badges of the countries party to the Paris Convention for the Protection of Intellectual Property (referred to as "the Paris Convention") or of the members of the World Trade Organization or of the contracting parties to the Trademark Law Treaty; the titles or marks of the Red Cross, the Olympic organizations or well-known international organizations; titles or marks that are identical or similar to seals or signs of the Republic of Korea, or of the countries party to the

Paris Convention, the members of the World Trade Organization, the contracting parties to the Trademark Law Treaty or the public organizations of these that are used for indicating supervision or certification;

- (ii) trademarks that falsely indicate a connection with, or that criticize, insult or are liable to defame, any nation, race, ethnic group, public organization, religion or well-known deceased person;
- (iii) trademarks that are identical or similar to well-known marks that indicate a nonprofit business of a State, a public organization or its agencies or public corporations, or a nonprofit public service; however, this provision does not apply where a nonprofit business of a State, a public organization or its agencies or public corporations, or a nonprofit public service apply to register such marks as their business emblems;
- (iv) trademarks that are contrary to public order or morality;
- (v) trademarks comprising a mark that is identical or similar to a medal, certificate of merit or decoration awarded at an exhibition held by or with the authorization of the Government of the Republic of Korea or at an exhibition held by or with the authorization of the government of a foreign country, unless a person who has been awarded a medal, certificate of merit or decoration has used it as part of the trademark on the same goods for which the medal, certificate of merit or decoration was awarded at the exhibition;
- (vi) trademarks containing the name, title or trade name, portrait, signature or seal, famous pseudonym, professional name or pen name of well-known persons, or an abbreviation of these, unless the consent of the person concerned has been obtained;
- (vii) trademarks that are identical or similar to another person's registered trademark when the registration was applied for before the filing date of the trademark applications concerned and when the trademarks are to be used on goods identical or similar to the designated goods;

- (viii) trademarks that are identical or similar to another person's trademark when not more than a year has elapsed since the date on which the trademark right expired (or the date on which a trial decision became final for a trial decision invalidating a trademark registration) and when the trademarks are used on the designated goods covered by the trademark right or on similar goods;
- (ix) trademarks that are identical or similar to another person's trademark when that other person's trademark is well known among consumers to indicate or resemble the other person's goods, and when the trademarks are used on goods that are identical or similar to such goods;
- (x) trademarks that are liable to cause confusion with the goods or services of another person because consumers easily recognize the trademark as designating the goods or services of the other person;
- (xi) trademarks that are liable to mislead or deceive consumers on the quality of the goods.
- (xii) trademarks that are identical or similar to a trademark that consumers inside or outside the Republic of Korea easily recognize as indicating the goods of a particular person, and which are used to obtain unjust profits or to inflict harm on a particular person and so on.
- (xiii) trademarks that consist solely of three-dimensional shapes that are essential for securing the functions of goods, or their packagings, that require trademark registration.
- (xiv) trademarks that consist of geographical indications or include geographical indications of the origin of wines or spirits in a member state of the World Trade Organization, and which are used for wines, spirits or other similar goods.

(2) Where a trademark falls under paragraphs (1)(vi), (ix) and (x) of this Article, the respective provisions do not apply if the trademark does not fall under the respective subparagraphs when applying for trademark registration.

(3) Where a trademark falls under paragraph (1)(vii) and (viii) of this Article,

the respective provisions apply if the trademark falls under the respective subparagraphs when applying for trademark registration (or if the registered trademark of another person is invalidated under Article 71(3)), unless the owner of the trademark and the applicant for registration of the trademark (referred to as "the applicant") are the same person after filing the application.

(4) Paragraph (1)(viii) of this Article does not apply to the following cases:

- (i) where the registered trademark has not been used for more than one year retroactively from the date on which the trademark right was extinguished;
- (ii) where a rightful applicant applies to register the trademark, after a decision on invalidation or revocation becomes final because the registered trademark violates paragraph (1)(vi), (ix), (x) and (xii) of this Article or Articles 8 or 73(1)(vii); or
- (iii) where an applicant applies to register the trademark after the period of six months as prescribed in Article 43(2) has elapsed without applying to renew the term of the registered trademark.

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

- (i) where the trademark right has been extinguished because the term has expired;
- (ii) where a person with the trademark right abandons the trademark right or some of the designated goods; or
- (iii) where the trial decision on the cancellation of a trademark registration has become final.

Article 8 First-to-File Rule

(1) Where two or more applications for trademark registration related to identical or similar trademarks that are to be used on identical or similar goods are filed on different dates, only the applicant filing the application with the earlier filing date may obtain trademark registration for the trademark.

(2) Where two or more applications for trademark registration related to identical or similar trademarks that are to be used on identical or similar goods are filed on the same date, a consultation will be held among all the applicants and the person agreed upon by all the applicants may obtain trademark registration for the trademark. If no agreement is reached or no consultation is possible, the trademark registration may be obtained only by the applicant chosen by a lottery conducted by the Commissioner of the Korean Intellectual Property Office.

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

(4) In cases under paragraph (2) of this Article, the Commissioner of the Korean Intellectual Property Office shall instruct the applicants to give notice of any agreement they reach and to report the terms of their agreement. If they do not submit a report within the designated period, the applicants are deemed not to have reached an agreement within the meaning of paragraph (2) of this Article.

(5) Where a trial for the cancellation of a registered trademark is requested under Article 73(1)(iii) and where each of the following subparagraphs occurs after the day on which the cancellation trial is requested, only the person requesting the cancellation trial may obtain trademark registration for the trademark that is identical or similar to the registered trademark that has been extinguished because of goods that are identical or similar to the designated goods of the registered trademark that has been extinguished for a period of three months after the day on which each of the following

subparagraphs occurs:

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

Article 9 Application for Trademark Registration

(1) A person seeking to register a trademark shall file an application with the Commissioner of the Korean Intellectual Property Office, stating the following:

- (i) the name and address of the applicant (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 trademark;
- (iv) the list of designated goods and the class of goods;
- (v) the matters prescribed under Article 20(3) (only when claiming a priority right);
- (vi) deleted;
- (vii) the matters prescribed by ordinance of the Ministry of Commerce, Industry and Energy.

(2) A person seeking to register a mark made up of a three-dimensional shape comprising any combination of signs, characters, figures or colors (referred to as "a three-dimensional trademark") shall indicate on the application that the mark is a three-dimensional trademark.

(3) A person seeking to register a collective mark shall file an application to register a collective mark stating the matters mentioned in the subparagraphs of paragraph(1) of this Article accompanied by the articles of association that govern the use of the collective mark, as prescribed by Presidential Decree.

(4) A person seeking to register a business emblem shall file an application to register a business emblem stating the matters mentioned in the subparagraphs of paragraph(1) of this Article accompanied by documents proving the existence of a business management.

Article 9bis According the Filing Date etc.

(1) The Commissioner of the Korean Intellectual Property Office shall decide to accord as the date of a trademark application the date of receiving a trademark application unless the application falls under any of the following paragraphs:

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

(2) Where an application for trademark registration falls under any subparagraph of paragraph(1), the Commissioner of the Korean Intellectual Property Office shall instruct the applicant to make the required correction within a designated period.

(3) Where an applicant supplements an application for trademark registration

in accordance with the order to supplement under paragraph (2), the applicant shall submit documents for the procedure to supplement the application (referred to as "a request to supplement the procedure").

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

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

Article 10 A Single Application for a Single Trademark

(1) A person seeking to register a trademark shall designate one or more classes of goods for the classification of goods prescribed by ordinance of the Ministry of Commerce, Industry and Energy, and file an application for each trademark. In such cases, the person may designate goods and services in a single application.

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

Article 11 Deleted

Article 12 Transfer and Partial Assignment of an Application for Trademark Registration etc.

(1) The transfer of an application for trademark registration, except for inheritance or other general succession, is not effective against third parties without notification that a change of applicant has been recorded.

(2) An application for trademark registration may be transferred separately for each of the goods designated in the application. In this case, designated goods that are similar must be transferred together.

(3) Deleted.

(4) For inheritance or other general succession, the successor in title shall immediately notify the Commissioner of the Korean Intellectual Property Office of the succession.

(5) Where an application for trademark registration is jointly owned, the owners may not transfer their individual share without the consent of the other owners.

(6) An application for trademark registration that is partially assigned under paragraph (2) of this Article is deemed to have been filed at the time of filing the original application, unless Articles 20(3) and (4) or 21(2) apply.

(7) An application to register a business emblem may not be transferred unless the business emblem is transferred with the business.

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

(9) An application to register a collective mark may not be transferred. However, for the merger of legal entities, the application may be transferred with the authorization of the Commissioner of the Korean Intellectual Property Office.

Article 13 Amendment of Procedure

The Commissioner of the Korean Intellectual Property Office or the President of the Intellectual Property Tribunal may order the amendment of an application, a request or any other procedure within a period designated by the Commissioner or President in any of the following cases:

- (i) where the requirements of Article 3(1) of this Act or Article 6 of the Patent Act, as applied under Article 5 of this Act, have not been complied with;
- (ii) where the formalities requirements prescribed in this Act or by ordinance under this Act have not been complied with; or
- (iii) where the fees required under Article 37 have not been paid.

Article 14 Amendment before Decision of Publication of Application

(1) Excluding the cases specified in Article 15, an applicant may amend a trademark or the list of designated goods in the application for trademark registration if the amendment does not cause a material change to the application.

(2) An amendment under paragraph (1) of this Article may not be made after the transmittal of a certified copy of the examiner's decision to grant or refuse trademark registration (referred to as "a decision to grant or refuse trademark registration"). However, where a trial against a decision of refusal is requested under Article 70*bis*, an amendment may be made within thirty days of the request, or within the period in which the written opinion is to be submitted under Articles 23(2), 45(2), 46*quater*(2) or 48(2), which apply under Article 81.

Article 15 Amendment after Decision of Publication of Application

Within the period set forth under any of the following conditions, an applicant may amend or correct designated goods or a specimen, or both, in response to reasons for refusal, reasons for opposition, reasons for a decision to refuse trademark registration, or a decision to refuse supplementary registration of the designated goods as long as the subject matter is not materially changed when a rejection notice is served under Article 23(2) or Article 48(2) after the certified copy of the decision on publication of the application under Article 24 is delivered, when an opposition to the trademark registration is brought under Article 25, or when an appeal against a decision of refusal under Article 70(2) is requested against a decision to

refuse trademark registration under Article 23(1) or a decision to refuse a supplementary registration of designated goods under Article 48(1):

- (i) the period designated for submitting arguments under Article 23(2) or 48(2);
- (ii) the period designated for submitting a written answer under Article 27(1); or
- (iii) thirty days after the date of the request for a trial against the decision of refusal under Article 70*bis*.

Article 16 Material Change of Application

(1) An amendment made under Articles 14 or 15 is considered not to cause a material change to an application for trademark registration if the amendment includes any of the following:

- (i) a limitation of the list of designated goods;
- (ii) a correction of errors;
- (iii) a clarification of ambiguous descriptions; or
- (iv) the deletion of any auxiliary part of the trademark.

(2) Where an amendment of an application for trademark registration or designated goods has been made before the transmittal of a certified copy of decision to publish on application and is recognized to have caused a material change after the establishment of a trademark right, the trademark application is deemed to have been filed at the time the written amendment is submitted.

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

Article 17 Rejection of Amendment

(1) Where an amendment made under Article 14 causes a material change to an application, an examiner shall decide to reject the amendment to the application for trademark registration.

(2) An examiner may not grant or refuse the registration of a trademark application if an amendment has been rejected under paragraph(1) of this Article until thirty days after the date on which a certified copy of the decision to reject the amendment has been transmitted. Where a decision to reject an amendment has been made under paragraph(1) of this Article before a decision has been made to publish the application, the examiner may not make a decision to publish the application that is subject to the amendment.

(3) Where an applicant requests a trial under Article 70*ter* against a decision to reject an amendment under paragraph(1) of this Article, the examiner shall suspend the examination of the application for trademark registration until the trial decision has become final.

(4) Where an amendment under Article 15 regarding an application for trademark registration materially changes the application, the examiner shall decide to reject the amendment.

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

(6) Except when a trial against a decision of refusal is requested under Article 70*bis*, a decision to reject an amendment under paragraph(4) may not be appealed.

Article 18 Division of Application for Trademark Registration

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

(2) An application that has been divided under paragraph(1) of this Article (referred to as "a divided application") is deemed to have been filed when the original application was filed, except when Articles 20(3), (4) or 21(2) apply.

Article 19 Conversion of an Application

(1) An applicant may convert an application for trademark registration into an application for service mark registration and vice versa.

(2) Where an application for trademark registration is converted under paragraph(1) of this Article (referred to as "a converted application"), the converted application is considered an application for trademark registration or service mark registration and is deemed to have been filed when the original application was filed.

(3) A converted application under paragraph(2) of this Article may not be made after a decision to grant or refuse trademark registration for an original trademark application or a trial decision on an original application for trademark registration, or after a decision to grant or refuse service mark registration for an original service mark application or a trial decision on the original application for service mark registration has become final.

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

(5) Applications for the registration of trademarks, collective marks and business marks or applications for the registration of service marks, collective marks and business marks may not be converted.

Article 20 Priority Claim under Treaty

(1) If a national of a country who is required to recognize a right of priority for an application for trademark registration filed by a national of the Republic of Korea under a treaty or similar instrument (referred to as "a treaty") claims a right of priority for the application for trademark registration

in the Republic of Korea based on the earlier application for the trademark registration filed in the national's country or in a country recognized in the treaty, the filing date of the earlier application in the foreign country is deemed under Article 8 of this Act to be the filing date in the Republic of Korea. Where a national of the Republic of Korea files an application for trademark registration in a country that recognizes, under a treaty, the right of priority for applications for trademark registration filed by nationals of the Republic of Korea, and claims the right of priority for an application for trademark registration in the Republic of Korea based on the earlier application for the trademark registration filed in that country, this provision does also apply.

(2) A person claiming the right of priority under paragraph(1) of this Article shall file the application within six months of the filing date of the earlier application that is the basis of the right of priority.

(3) When filing an application for trademark registration, a person claiming the right of priority under paragraph(1) of this Article shall specify on the application the gist of the claim, the name of the country and the filing date of the earlier application.

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

(5) Where a person claiming the right of priority under paragraph(3) of this Article fails to submit the certified copy within the period prescribed under paragraph (4) of this Article, the claim to the right of priority is invalidated.

Article 21 Special Provisions on the Time of Filing an Application

(1) Where a person entitled to file an application for trademark registration files an application for trademark registration whose designated goods bearing the trademark have been exhibited at any of the following types of

exhibitions within six months of the date of the exhibition, the application is deemed to have been filed at the time the goods were exhibited:

- (i) exhibitions held by the Government or a local government entity;
- (ii) exhibitions held by persons authorized by the Government or a local government entity;
- (iii) exhibitions held in a foreign country with the authorization of the government;
- (iv) international exhibitions held in the territory of a country party to a treaty by the government of that country or by persons authorized by the government of that country.

(2) A person taking advantage of paragraph (1) of this Article in an application for trademark registration shall submit to the Commissioner of the Korean Intellectual Property Office a written statement of intent with the application for trademark registration and, within thirty days of the filing date of the application, a document proving the relevant facts.

CHAPTER III

EXAMINATION

Article 22 Examination by Examiner

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

(2) The qualifications for examiners are prescribed by Presidential Decree.

(3) Any person whose application for trademark registration falls within any