

## CHAPTER V

### TRADEMARK RIGHT

#### **Article 41 Registration of Establishment of a Trademark Right**

(1) A trademark right comes into effect upon the registration of its establishment.

(2) When trademark registration fees have been paid in accordance with Article 34(1), the Commissioner of the Korean Intellectual Property Office shall authorize the registration of the trademark right.

#### **Article 42 The Term of a Trademark Right**

(1) The term of a registered trademark is for ten years after the registration date of its establishment.

(2) The term of a registered trademark may be renewed for an additional ten years upon applying to renew the term.

#### **Article 43 Application to Renew the Term of a Registered Trademark**

(1) A person renewing the term of a registered trademark under Article 42(2) shall submit an application to the Commissioner of the Korean Intellectual Property Office, including the following:

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

(2) An application to renew the term of a registered trademark must be filed within the one-year period before the date on which the term of the registered trademark expires. However, a person who does not apply to renew the term of a registered trademark within this period may do so not later than six months after date on which the registered trademark expires.

(3) Where a registered trademark is jointly owned, the owners shall jointly file an application to renew the term.

(4) In addition to paragraphs (1) to (3) of this Article, all other necessary matters required to file an application to renew the term of a registered trademark are prescribed by ordinance of the Ministry of Commerce, Industry and Energy.

#### **Article 44 Division of an Application to Renew the Term of a Registered Trademark**

(1) Where the designated goods of a registered trademark cover two or more goods, the application for renewal of the term of a registered trademark may be divided into each of the goods.

(2) In an application to renew the term of a registered trademark under Article 43(1), an applicant who designates two or more goods may divide the application into two or more applications within the amendment period prescribed in Article 14.

(3) A divisional application to renew the term of a registered trademark under paragraph (2) of this Article is deemed to have been filed when the original application to renew of the term was filed.

#### **Article 45 Refusal of Registration for Renewal of the Term and Notification of Reasons for Refusal**

(1) An examiner shall refuse to renew the term of a registered trademark under any of the following circumstances:

- (i) deleted;
- (ii) where the applicant is not the owner of the registered trademark concerned;
- (iii) where the application violates Article 43(2);

(iv) deleted;

(v) deleted;

(vi) where the designated goods of the application to renew the term of a registered trademark are not the designated goods of the registered trademark, or where the application expands the actual scope of the designated goods.

(2) An examiner who intends to refuse renewal of the term of a registered trademark under paragraph(1) of this Article shall notify the applicant of the reasons for the refusal and give the applicant an opportunity to submit a written statement of arguments within a designated period.

#### **Article 46 Effects of an Application to Renew the Term of a Registered Trademark etc.**

(1) Where an application to renew the term of a registered trademark has been filed within the period prescribed in Article 43(2), the term is deemed to have been renewed, unless a decision of refusal to renew the term of the registered trademark has become final.

(2) The registration for renewal of the term of a registered trademark commences on the day after the expiry date of the original registration.

#### **Article 46bis Application to Register the Reclassification of Goods**

(1) A trademark right owner who has obtained trademark registration, a supplementary registration of designated goods or a registration for renewal of the term of a registered trademark for designated goods in accordance with the classification of goods prescribed by ordinance of the Ministry of Commerce, Industry and Energy under the previous Article 10(1) of this Act, before enforcement of the amendment of Article 10(1) under the enactment of Act No. 5355, shall reclassify the designated goods (referred to as "the reclassification of goods"), as prescribed by ordinance of the Ministry of Commerce, Industry and Energy. However, this provision does not apply

where the person has obtained registration for renewal of the term of a registered trademark for designated goods in accordance with the classification of goods as prescribed by ordinance of the Ministry of Commerce, Industry and Energy under Article 10(1) of this Act as amended under the enactment of Act No. 5355.

(2) A person who seeks registration of the reclassification of goods under paragraph(1) (referred to as "the registration of the reclassification of goods") shall submit to the Commissioner of the Korean Intellectual Property Office a written application to register the reclassification of goods, specifying the particulars prescribed in each of the following subparagraphs; persons intending to simultaneously file an application to register the reclassification of goods and an application to renew the term of a registered trademark under Article 43(1) may instead file a single application to renew the term of a registered trademark by specifying their intention in the application as well as the particulars prescribed under subparagraph (4):

- (i) the name and address of the applicant for the reclassification of goods (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 registration number of the registered trademark; and
- (iv) the designated goods and the corresponding classification that the applicant seeks to reclassify.

(3) An application to register the reclassification of goods must be filed within the period beginning one year before the date on which the term of the trademark right expires and not later than six months after the expiry date of the term.

(4) Where a registered trademark is jointly owned, the owners shall jointly file an application to register the reclassification of goods.

**Article 46ter Division of an Application to Register the  
Reclassification of Goods**

(1) Where an applicant files an application to renew the term of a registered trademark in which the designated goods are divided under Article 44(1), the applicant shall file an application to divide the registration of the reclassification of goods.

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

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

**Article 46quater Decision to Refuse Registration of the Reclassification  
of Goods and Notification of the Reasons for Refusal**

(1) An examiner shall refuse registration of the reclassification of goods under any of the following circumstances:

- (i) where the designated goods for which an application to register the reclassification of goods has been filed are not the goods designated under the registered trademark or where the applicant expands the actual scope of the designated goods;
- (ii) where the designated goods of an application to register the reclassification goods does not correspond with the classifications of goods prescribed by ordinance of the Ministry of Commerce, Industry and Energy;
- (iii) where the applicant is not the owner of the trademark right concerned; and

(iv) where the application violates Article 46*bis*(3)

(2) An examiner who intends to refuse registration of the reclassification of goods under paragraph(1) of this Article shall notify the applicant of the reasons for the refusal and give the applicant an opportunity to submit a written response within a designated period.

### **Article 46*quinquies* Registration of the Reclassification of Goods**

(1) Where an examiner decides to register the reclassification of goods under Article 30 as applied under Article 49(2), the Commissioner of the Korean Intellectual Property Office shall register the reclassification of the designated goods.

### **Article 47 Application for Supplementary Registration of Designated Goods**

(1) The owner of a registered trademark or an applicant for trademark registration may obtain supplementary registration of designated goods to be added to the designated goods of the registered trademark or to the application for trademark registration.

(2) A person applying for supplementary registration of designated goods under paragraph(1) of this Article shall submit an application for supplementary registration of designated goods to the Commissioner of the Korean Intellectual Property Office that includes the following:

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

**Article 48 Decision to Refuse Supplementary Registration of Designated Goods and Notification of Reasons for Refusal**

(1) Where an application for supplementary registration of designated goods falls under any of the following subparagraphs, the examiner shall make a decision of refusal:

- (i) the application falls under any subparagraph of Article 23(1);
- (ii) the applicant is not the owner of the trademark right or the applicant for registration of the trademark concerned;
- (iii) the trademark for the application is not identical to the registered trademark or the trademark for which a registration application has been filed; or
- (iv) the right under the registered trademark has expired or the application for trademark registration has been withdrawn, abandoned or invalidated, or a decision to refuse the application has become final.

(2) An examiner who intends to refuse an application for supplementary registration of designated goods under paragraph (1) of this Article shall notify the applicant of the reasons for the refusal and give the applicant an opportunity to submit a written statement of arguments within a designated period.

**Article 49 *Mutatis Mutandis* Application of the Patent Act**

(1) Articles 10(1), 13, 14, 16, 17, 22 and 30 to 32 of this Act and Article 148(i) to (v) and (vii) of the Patent Act apply *mutatis mutandis* to an application to renew the term of a registered trademark.

(2) Articles 10(1), 13, 14, 16, 17, 22 and 30 to 32 of this Act and Article 148(i) to (v) and (vii) of the Patent Act apply *mutatis mutandis* to an application to register the reclassification of goods.

(3) Articles 9*bis*, 10(1), 13 to 17, 20 to 22 and 24 to 32 of this Act,

Articles 148(1)(i) to (v) and (vii) and 157 of the Patent Act and Articles 143, 299 and 367 of the Civil Procedure Act apply *mutatis mutandis* to applications for supplementary registration of designated goods.

### **Article 50 Effects of a Trademark Right**

The owner of a trademark right is entitled to the exclusive right to use the registered trademark for the designated goods. However, under Article 55(3), where the trademark right is the subject of an exclusive license, this provision does not apply to the extent to which the licensee has the exclusive right to use the registered trademark.

### **Article 51 Limitations of a Trademark Right**

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

- (i) trademarks that indicate in a common way a person's own name, title or trade name, portrait, signature, seal, famous pseudonym, professional name or pen name, or a famous abbreviation of these; however, this provision does not apply where, after registration of the trademark right, the mark has been used with the intention of violating the rules of fair competition;
- (ii) trademarks that indicate in a common way the common name, origin, place of sale, quality, raw materials, efficacy, use, quantity, shape or price of the designated goods concerned or similar goods, or the method or time of manufacturing, processing or using such goods; and
- (iii) trademarks customarily used on the designated goods or goods similar to the designated goods, and marks consisting of a famous geographical name or its abbreviations or a map.
- (iv) trademarks that consist solely of three-dimensional shapes that are essential to secure the functions of the designated goods of a registered trademark or their packaging.



**Article 52 Extent of Protection of a Registered Trademark etc.**

(1) The extent of protection conferred by a registered trademark is based on the trademark reproduced in the documents accompanying the application for trademark registration.

(2) The extent of protection conferred to the designated goods is based on the goods listed in the documents accompanying the application for trademark registration or the application to register the reclassification of goods.

**Article 53 Relationship with Another Design Right etc.**

Where the use of a registered trademark on designated goods conflicts with another person's patent right, utility model right or design right that has been applied for before the date of the application for the registration of the trademark, or with another person's copyright that has been in effect before that date, the owner of the trademark right or the exclusive or nonexclusive licensee may not use the registered trademark on the portion of the designated goods that gives rise to the conflict without a license from the owner of the earlier patent right, utility model right, design right or copyright.

**Article 54 Assignment and Joint Ownership of a Trademark etc.**

(1) A trademark right may be assigned separately for each of the designated goods. In such cases, the rights for similar designated goods are assigned with the assignment of the trademark.

(2) to (4) Deleted.

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

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

(7) A business emblem right may not be assigned unless the business emblem is assigned with the business.

(8) A trademark right registered under Article 7(1)(iii) may not be assigned unless assigned with the business related to the mark referred to in the main sentence of Article 7(1)(iii).

(9) A collective mark right may not be transferred. However, for a merger of a legal entity, the collective mark may be assigned if authorized by the Commissioner of the Korean Intellectual Property Office.

(10) A pledge right may not be established for a business emblem right, a trademark right and a collective mark right under Article 7(1)(iii).

#### **Article 54bis Division of a Trademark Right**

(1) Where two or more goods are designated under a single trademark right, the trademark right may be divided for each of the designated goods.

(2) Where a request for an invalidation trial is made under Article 71(2), the division under paragraph (1) of this Article may be made until the decision of the invalidation trial becomes final even if the trademark right expires.

#### **Article 55 Exclusive License**

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

(2) An exclusive license may not be granted for a business emblem or a collective mark right.

(3) An exclusive licensee granted an exclusive license under paragraph(1) of this Article has the exclusive right to use the registered trademark on the designated goods to the extent allowed in the license agreement.

(4) Exclusive licensees shall indicate their own name or title on goods.

(5) An exclusive licensee may not assign the license without the consent of the owner of the trademark right, except in the case of inheritance or other general succession.

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

(7) Article 54(5) and (6) apply *mutatis mutandis* to exclusive licenses.

### **Article 56 Effects of Registration on Trademark Right and Exclusive License**

(1) The following items have no effect unless registered:

- (i) the transfer (except for inheritance or other general succession), modification, extinguishment by abandonment, renewal of the term of a registered trademark, reclassification of goods, supplement to designated goods or restriction on the disposal of these;
- (ii) the grant, transfer (except for inheritance or other general succession), modification or extinguishment by abandonment of an exclusive license, or restriction on the disposal of these; or
- (iii) the establishment, transfer (except for inheritance or other general succession), modification or extinguishment by abandonment of a pledge on a trademark right or exclusive license, or restriction on the disposal of these.

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

### **Article 57 Nonexclusive License**

(1) The owner of a trademark right may grant to others a nonexclusive

license on the trademark right.

(2) A nonexclusive licensee granted a nonexclusive license under paragraph (1) of this Article is entitled to use the registered trademark on the designated goods to the extent allowed in the license agreement.

(3) Except for inheritance or other general succession, a nonexclusive license may not be transferred without the consent of the owner of the trademark right (or, for a nonexclusive license on an exclusive license, the owner of the trademark right and the exclusive licensee).

(4) A pledge may not be established on a nonexclusive license without the consent of the owner of the trademark right (or, for a nonexclusive license on an exclusive license, the owner of the trademark right and the exclusive licensee).

(5) Articles 54(5) and 55(2) and (4) apply *mutatis mutandis* to a nonexclusive license.

**Article 57bis Right to Use a Trademark after the Term of a Patent Right Expires etc.**

(1) Where a patent right under a patent application filed on or before the filing date of a trademark application conflicts with the trademark right under the trademark application and the term of the patent right has expired, the patentee is entitled to use, within the scope of the original patent right, the registered trademark or another similar trademark for the designated goods covered by the trademark application or similar goods if the registered trademark is used without intending to violate the rules of fair competition.

(2) Where a patent right under a patent application filed on or before the filing date of a trademark application conflicts with the trademark right under the trademark application and the term of the patent right has expired, any person who has an exclusive license for the patent right or a nonexclusive license for the patent right or its exclusive license effective under Article 118(1) of the Patent Act at the time of its expiry is entitled to use, within the scope of the original right, the registered trademark or another

trademark similar to the registered trademark on the designated goods or goods similar to the designated goods. However, this provision applies only where the registered trademark is used without violating the rules of fair competition.

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

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

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

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

### **Article 58 Effects of Registration of a Nonexclusive License etc.**

(1) The following have no effect on any third parties unless they are registered:

- (i) the grant, transfer (except for inheritance or other general succession), modification, extinguishment by abandonment of a nonexclusive license or restriction on the disposal of these;
- (ii) the establishment, transfer (except for inheritance or other general succession), modification, extinguishment by abandonment of a pledge on a nonexclusive license or restriction on the disposal of these.

(2) A registered nonexclusive license is effective against any person who subsequently acquires the trademark right or exclusive license.

(3) For inheritance or other general succession related to a nonexclusive license or a pledge under paragraph(1) of this Article, the Commissioner of the Korean Intellectual Property Office must be notified immediately.

### **Article 59 Abandonment of a Trademark Right**

The owner of a trademark right may abandon the trademark right for any of the designated goods.

### **Article 60 Restriction on Abandonment of a Trademark Right etc.**

(1) The owner of a trademark right may not abandon the trademark right without the consent of the exclusive or nonexclusive licensee(s) or pledgee(s).

(2) An exclusive licensee may not abandon the exclusive license without the consent of the pledgee(s) or nonexclusive licensee(s) under Article 55(6).

(3) A nonexclusive licensee may not abandon the nonexclusive license without the consent of the pledgee(s) under Article 57(4).

### **Article 61 Effect of Abandonment**

Where a trademark right, an exclusive license, a nonexclusive license or a pledge is abandoned, the trademark right, the exclusive license, the nonexclusive license or the pledge is extinguished.

### **Article 62 Pledge**

Where a pledge is established for a trademark right or an exclusive or nonexclusive license, the pledgee may not use the registered trademark.

### **Article 63 Subrogation for Right of Pledge**

A pledge may be exercised for remuneration under this Act or for goods to be received for using the trademark right; however, an attachment order must be obtained before paying the remuneration or delivering the goods.

### **Article 64 Extinguishment of a Trademark Right**

Where an application to transfer a registered trademark is not filed by a successor in title within three years of the death of the original owner of the trademark, the trademark right is extinguished on the day after the expiry of a three-year period following the death of the original trademark owner.

### **Article 64bis Extinguishment of a Trademark Right in the Absence of Registration of the Reclassification of Goods**

(1) Under any of the following circumstances, a trademark right covering the designated goods of an application to register the reclassification of goods is extinguished on the expiry date of the term of the registered trademark that is contained within the period prescribed under Article 46bis(3) for registering the reclassification of goods.

- (i) where a person who is entitled to register the reclassification of goods does not file an application to this effect within period prescribed under Article 46bis(3);
- (ii) where the application to register the reclassification of goods has been withdrawn;
- (iii) where a procedure related to the reclassification of goods has been invalidated under Article 16(1) of the Patent Act as applied under Article 5 of this Act;
- (iv) where a decision to refuse registration of the reclassification of goods is final; or
- (v) where a trial ruling invalidating registration of the reclassification of goods under Article 72bis(2) is final.

(2) A trademark right covering designated goods that are the object of reclassification of goods but not indicated in a registration application under Article 46*bis*(2) is extinguished on the date on which the designated goods indicated in the application are reclassified and registered under Article 46*quinquies*.

## CHAPTER VI

### PROTECTION OF OWNER OF A TRADEMARK RIGHT

#### Article 65 Injunction etc. against an Infringement

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

(2) The owner of a trademark right or exclusive licensee who is acting under paragraph(1) of this Article may demand the destruction of the infringing articles, the removal of the facilities used for the act of infringement, or other measures necessary to prevent the infringement.

#### Article 66 Acts Considered to be an Infringement

The following acts are considered to be infringements of a trademark right or an exclusive license:

- (i) acts of using a trademark identical to the registered trademark of another person on goods identical or similar to the designated goods, or using a trademark similar to the registered trademark of another person on goods identical or similar to the designated goods;
- (ii) acts of delivering, selling, counterfeiting, imitating or possessing a trademark identical or similar to the registered trademark of another