

license, the court may, upon the request of either party, order the other party to submit documents necessary for the assessment of damages caused by the infringement, unless the person who possesses the documents has justifiable reasons for refusing to submit them.

## **CHAPTER VII**

### **TRIAL**

#### **Article 70bis Trial against Decision of Refusal**

Any person dissatisfied with a decision to refuse registration of a trademark, to refuse supplementary registration of designated goods, to refuse to renew the term of a registered trademark or to refuse to registration of the reclassification of goods (referred to as "a decision of refusal") may request a trial within thirty days of the date of receiving a certified copy of the decision of refusal.

#### **Article 70ter Trial against a Decision to Reject an Amendment**

Any person dissatisfied with a decision to reject an amendment under Article 17(1) may request a trial within thirty days of the date of receiving a certified copy of the decision.

#### **Article 71 Invalidation Trial of a Trademark Registration**

(1) In the following cases, an interested person or an examiner may demand a trial to invalidate a registered trademark or the supplementary registration of designated goods. In such a case, if two or more designated goods are covered by the trademark registration, a request for an invalidation trial may be made for each of the designated goods:

- (i) the registration is in breach of Articles 3, 6 to 8, or 12(2) (second sentence), (5) and (7) to (9) or 23(1)(iv) of this Act; or Article 25 of the Patent Act, which applies under Article 5 of this Act;
- (ii) the registration violates a treaty;
- (iii) the registration has been effected on the basis of an application filed by a person who is not a successor in title to the right deriving from the trademark application;
- (iv) following registration, the owner of the trademark right is no longer capable of enjoying the right under Article 25 of the Patent Act that applies under Article 5 of this Act, or the registration no longer complies with a treaty.
- (v) following registration, the registered trademark falls under any of subparagraphs of Article 6(1) (unless Article 6(2) applies).

(2) A trial for invalidation under paragraph(1) may be requested even after the extinguishment of a trademark right.

(3) Where a trial decision invalidating a trademark registration has become final, the trademark right is deemed never to have existed. However, where a trial decision invalidating a trademark right has become final under paragraph(1)(iv) or (v) of this Article, the trademark right is deemed not to have existed from the time the trademark registration applies under paragraph (1)(iv) or (v).

(4) When applying the proviso of Article 3, where the exact date on which a registered trademark falls under paragraph(1)(iv) or (v) cannot be specified, the present trademark right is deemed not to have existed from the date on which a request for an invalidation trial under paragraph(1) is made known to the public.

(5) Where a trial under paragraph (1) of this Article has been requested, the presiding trial examiner shall notify the exclusive licensee of the trademark right and other persons who have any registered rights related to the trademark of the subject of the request.

**Article 72 Invalidation Trial for Renewal of the Term of a Registered Trademark**

(1) In the following cases, an interested person or an examiner may request a trial to invalidate the renewal of the term of a registered trademark. If two or more designated goods are covered by the renewed registered trademark, a request for an invalidation trial may be made for each of the designated goods.

- (i) Deleted;
- (ii) the registration for the renewal violates Article 43(2);
- (iii) the registration for the renewal has been applied for by a person who is not the owner of the trademark right concerned.

(2) A trial for invalidation under paragraph(1) of this Article may be requested after the extinguishment of a trademark right.

(3) Where a trial decision invalidating the renewal of the term of a registered trademark has become final, the renewed registration is deemed never to have existed.

(4) Article 71(4) applies *mutatis mutandis* to the request for an invalidation trial under paragraph (1) of this Article.

**Article 72bis Invalidation Trial of a Registration for the Reclassification of Goods**

(1) An interested person or an examiner may request a trial to invalidate a registration of the reclassification of goods where any of the following subparagraphs apply; if two or more designated goods related to the registration for the reclassification of goods exist, a request for an invalidation trial may be made for each of the designated goods:

- (i) where the registration of the reclassification of goods has been granted for designated goods not covered by the present registered trademark or where the scope of the designated goods has been expanded;

- (ii) where an application to register the reclassification of goods has been filed by a person who is not the owner of the concerned trademark right; or
- (iii) where the registration for the reclassification of goods violates Article 46*bis*(3).

(2) Article 71(2) and (5) applies *mutatis mutandis* to an invalidation trial against a registration of the reclassification of goods.

(3) Where a trial decision invalidating a registration of the reclassification of goods has become final, the registration of the reclassification of goods is deemed to have never existed.

### **Article 73 Trial for the Cancellation of a Registered Trademark**

(1) A trial may be requested to cancel a registered trademark that falls under any of the following circumstances:

- (i) deleted;
- (ii) the owner of the trademark right intentionally uses a trademark similar to the registered mark on the designated goods or uses the registered trademark or a trademark similar to the registered trademark on goods similar to the designated goods in a manner that is liable to mislead consumers on the quality of the goods or cause confusion regarding the goods of another person;
- (iii) the owner of the trademark right or the exclusive or nonexclusive licensee has not been continuously using the registered trademark for a period in excess of three years before the date of the cancellation trial for the designated goods in the Republic of Korea and no justifiable reasons exist for such nonuse;
- (iv) the trademark is contrary to Article 54(1) (second sentence), (5) and (7) to (9);

- (v) a member of an association allows a third party to use its collective mark in violation of the statutes of the association;
- (vi) when a concern exists that a collective mark could mislead consumers on the quality of goods or cause confusion regarding the goods of another person's business due to a change of the statutes of the association under Article 9(3);
- (vii) a trademark falling under Article 23(1)(iii) has been registered and the owner of the original trademark requests a cancellation trial within five years of the date of registration of the trademark;
- (viii) the exclusive or nonexclusive licensee uses the registered trademark or a similar trademark on the designated goods or similar goods, in a manner that is liable to mislead consumers on the quality of the goods or cause confusion regarding the goods of another person's business, except when the owner of the trademark right has taken reasonable care; or
- (ix) when similar trademarks belong to different persons who have a trademark right due to the assignment of a trademark right, and one of the persons misleads consumers on the quality of goods or causes confusion regarding the goods of another person by using the registered trademark on goods identical or similar to the designated goods of their own registered trademark in acts of unfair competition.

(2) Deleted.

(3) Where a cancellation trial is requested for the reasons referred to in paragraph(1)(iii) of this Article, a cancellation trial may be requested for a part of the designated goods if the designated goods covered by the registered trademark are two or more.

(4) Where a cancellation trial is requested for the reasons referred to in paragraph(1)(iii) of this Article, the owner of the trademark right does not avoid the cancellation of the registration of the trademark for the designated goods if the defendant cannot prove that the registered trademark has been

used in the Republic of Korea within a three-year period before the date of the request for a trial on one or more of the designated goods in the request, unless the defendant can provide a justifiable reason for failing to use the registered trademark.

(5) The reasons for cancellation referred to in paragraph (1)(ii), (iii), (v), (vi), (viii) or (ix) are not affected even when the facts that give rise to the request for a cancellation trial no longer exist after the request for a trial is made.

(6) A cancellation trial under paragraph (1) of this Article may be requested only by an interested person, except that a trial requested for the reasons referred to in paragraph (1)(ii), (vi), (viii) or (ix) may be requested by any person.

(7) Where a trial decision ordering the cancellation of a trademark registration has become final, the trademark right is extinguished on that date.

(8) Article 71(4) applies *mutatis mutandis* to the request for a trial under paragraph (1) of this Article.

#### **Article 74 Trial for the Cancellation of the Registration of an Exclusive or Nonexclusive License**

(1) Where an exclusive or nonexclusive licensee performs an act referred to in Article 73(1)(viii), a trial for the cancellation of the registration of the exclusive or nonexclusive license may be requested.

(2) The reasons for cancellation are not affected even when the facts that give rise to the request for a cancellation trial no longer exist after the request for a trial for the cancellation of the registration of an exclusive or nonexclusive license is made under paragraph (1) of this Article.

(3) Any person may request a trial for the cancellation of an exclusive or nonexclusive license under paragraph (1) of this Article.

(4) Where a trial decision ordering the cancellation of the registration of an exclusive or nonexclusive license has become final, the exclusive or nonexclusive license is extinguished on that date.

(5) Where a trial under paragraph (1) of this Article has been requested, the presiding trial examiner shall notify the nonexclusive licensee and other persons who have any registered rights related to the trademark right and the persons who have any registered right for the exclusive or nonexclusive license of the demand.

### **Article 75 Trial to Confirm the Scope of a Trademark Right**

The owner of a trademark right or an interested person may request a trial to confirm the scope of a trademark right.

### **Article 76 Statute of Limitation**

(1) A trial to invalidate a registered trademark, the renewal of the term of a registered trademark and a registration of the reclassification of goods under Articles 7(1)(vi) to (ix) and (xiv), 8, 72(1)(ii) and 72*bis*(1)(iii) may not be requested more than five years after the registration date of the trademark, after the registration date for renewal of the term of the registered trademark or after the registration date of the reclassification of goods.

(2) A trial for the cancellation of a trademark registration and of the registration of an exclusive or nonexclusive license under Articles 73(1) (ii), (v), (vi), (viii) and (ix) and 74(1) may not be requested more than after years after the date on which the alleged facts have ceased to exist.

### **Article 77 *Mutatis Mutandis* Application of the Patent Act**

Articles 139, 140, 141 to 153, 153*bis* and 154 to 166 of the Patent Act apply *mutatis mutandis* to trials. In such cases, "an invalidation trial under Article 133(1), 134(1) or 137(1)" in Article 139(1) of the Patent Act reads "an invalidation trial under Article 71(1), 72(1) and 72*bis*(1), a cancellation trial under Article 73(1)", "a trial for invalidating a patent Article 133(1)" in Article 161(2) of the Patent Act reads "an invalidation trial under Article 71(1), 72(1) and 72*bis*(1), a cancellation trial under Article 73(3)", "Article 133(1), 134(1), 135 and 137(1)" in Article 165(1) of the Patent Act

reads "Article 71(1), 72(1), 72*bis*(1), 73(1) and 75", and "Article 132*ter*, 136 or 138" in Article 165(3) of the Patent Act reads "Article 70*bis* or 70*ter*".

## **Article 78 Deleted**

### **Article 79 Formal Requirements for Requesting a Trial against an Examiner's Decision to Refuse or Reject an Amendment**

(1) A person who requests a trial against an examiner's decision of refusal under Article 70*bis* or a trial against the decision to reject an amendment under Article 70*ter* shall submit a written request to the President of the Intellectual Property Tribunal, stating the following:

- (i) the name and address of the parties (and, if a legal entity, the name and address of the business);
- (*ibis*) 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);
- (ii) the number and date of the application that is the subject of the rejection;
- (iii) the designated goods and the classes of the goods;
- (iv) the date of the examiner's decision to refuse or reject an amendment;
- (v) the identification number of the trial case;
- (vi) the purpose and reasons for the request; and
- (vii) deleted.

(2) Where a trial against an examiner's decision of refusal has been requested under Article 70*bis*, the President of the Intellectual Property Tribunal shall notify the opponent of the request for the trial if the decision of refusal was based on an opposition to the trademark registration.

## **Article 80 Deleted**

### **Article 81 *Mutatis Mutandis* Application of Provisions Concerning Examination in the Trial against the Decision of Refusal**

(1) Articles 15, 17, 18, 23(2), 24 to 30, 45(2), 46*quater*(2) and 48(2) apply *mutatis mutandis* to a trial against a decision of refusal; however, Article 24 does not apply where an application for trademark registration or supplementary registration of designated goods have already been published.

(2) When Article 17 is applied under paragraph(1) of this Article, "where an applicant has requested a trial against the decision to reject an amendment under Article 70*ter*" in Article 17(3) means "where a lawsuit is brought under Article 186(1) of the Patent Act as applied under Article 86(2) of this Act"; and "until the trial decision of the trial has become final" means "until the judgement has become final".

(3) Articles 17(4) to (6), 23(2), 45(2) 46*quater*(2) and 48(2) applied under paragraph(1) of this Article apply *mutatis mutandis* where reasons for refusal other than those contained in the decision of refusal are found.

### **Article 82 Special Provisions of a Trial against the Decision to Refuse or the Decision to Reject an Amendment**

(1) Articles 172 and 176 of the Patent Act apply *mutatis mutandis* to a trial on the decision to refuse and the decision to reject an amendment. In this case, "132*ter*" in Article 176(1) of the Patent Act reads "70*bis* or 70*ter*" and "ruling of refusal to grant a patent, refusal to extend the term of a registered patent or revocation of a patent" in Article 176(1) of the Patent Act reads "decision to refuse or reject an amendment".

(2) Articles 147(1) and (2), 155 and 156 of the Patent Act, which apply *mutatis mutandis* under Article 77, do not apply to the trial against the decision of refusal referred to in Article 70*bis* and the decision to reject an amendment referred to in Article 70*ter*.