

(2) Where a common representative has been appointed and notification has been given under paragraph (1), written proof that the representative has been appointed must be presented.

#### **Article 4 *Mutatis Mutandis* Application of the Patent Act**

Articles 3 to 5, 7 to 10, 12 to 15 and 17 to 28 *quinquies* of the Patent Act apply *mutatis mutandis* to utility models. In such an operation, a person who requests an examination of a patent application under Article 4 of the Patent Act is deemed a person who requests a technical evaluation of a utility model application.

## **CHAPTER II**

### **REQUIREMENTS FOR UTILITY MODEL REGISTRATION AND UTILITY MODEL APPLICATIONS**

#### **Article 5 Requirements for Utility Model Registration**

(1) A utility model may be granted for devices that are industrially applicable and relate to the shape or structure of an article or a combination of articles, unless they fall under either of the following subparagraphs:

- (i) devices publicly known or worked in the Republic of Korea before the filing of the utility model application; or
- (ii) devices described in a publication distributed in the Republic of Korea or in a foreign country before the filing of the utility model application or made available to the public through electronic telecommunication lines under Presidential Decree.

(2) Notwithstanding paragraph (1), where a device could easily have been

made before the filing of the utility model application by a person with ordinary skill in the art to which the device pertains, on the basis of a device referred to in either subparagraph of paragraph(1), a utility model registration may not be granted to that device.

(3) Notwithstanding paragraph (1), where a device for which a utility model application is filed is identical to a device or an invention described in the description or drawing(s) originally attached to another utility model application or a patent application, and where the other utility model application was filed before the utility model application and published after registration for public inspection after the filing date of the utility model application, or where a patent application was filed before the utility model application and laid open or published after grant for public inspection after the filing date of the utility model application, a utility model may not be granted for the device of the utility model application. This provision does not apply, however, where the inventor of the utility model application and the inventor of the other utility model or patent application are the same person or where the applicant of the utility model application and the applicant of the other utility model or patent application are the same person at the time of filing.

(4) Where the other utility model or patent application under paragraph (3) is an international application deemed to be a utility model application under Article 57(1) of this Act, or an international application deemed to be a patent application under Article 199(1) of the Patent Act (including an international application considered to be a utility model or patent application under Article 71(4) of this Act or a patent application under Article 214(4) of the Patent Act), in applying paragraph(3), "laid open" reads "laid open or the subject of an international publication under Article 21 of the Patent Cooperation Treaty," and "a device or an invention described in the description or drawing(s) originally attached" reads "a device or an invention described both in the description, claim(s) or drawing(s) of the international application as of the international filing date and in the translated version".

## **Article 6 Devices Deemed to be Not Known etc.**

(1) Where a device that belongs to a person with the right to obtain a utility

model registration falls under any of the following subparagraphs, the device is not considered to fall under either subparagraph of Article 5(1) where Article 5(1) or (2) applies if the utility model application is filed within six months of the applicable date:

- (i) where a person with the right to obtain a utility model registration causes the device to fall under either subparagraph of Article 5(1) by performing any of the following acts:
  - (a) an experiment
  - (b) publication of the device in printed matter;
  - (c) publication through electric telecommunication lines under Presidential Decree;
  - (d) presentation in writing at an academic organization by ordinance of the Ministry of Commerce, Industry and Energy.
- (ii) where the device falls under either subparagraph of Article 5(1) against the intention of the person with the right to obtain a utility model registration;
- (iii) where a person with the right to obtain a utility model registration causes the device to fall under either subparagraph of Article 5(1) by displaying the device at an exhibition.

(2) A person taking advantage of paragraph (1)(i) or (1)(iii) shall submit, simultaneously with a utility model application, a written statement to that effect to the Commissioner of the Korean Intellectual Property Office, to whom the person shall also submit, within thirty days of the filing date of the utility model application, a document proving the relevant facts.

## **Article 7 Unregistrable Devices**

Notwithstanding Article 5(1) and (2), devices falling under either of the following subparagraphs are unregistrable:

- (i) devices that are identical or similar to the national flag or decorations; or

- (ii) devices liable to contravene public order or morality, or to injure public health.

### **Article 8 First-to-File Rule**

(1) Where two or more applications related to the same device are filed on different dates, only the applicant with the earlier filing date may obtain a utility model registration for the device.

(2) Where two or more applications related to the same device are filed on the same date, only the person agreed upon by all the applicants after consultation may obtain a utility model registration for the device. If no agreement is reached or no consultation is possible, none of the applicants may obtain a utility model registration for the device.

(3) Where a utility model application has the same subject matter as a patent application and the applications are filed on different dates, the applicant of the utility model application may obtain a utility model registration for the device only if the utility model application has the earlier filing date.

(4) Where a utility model application has the same subject matter as a patent application and the applications are filed on the same date, a utility model application may be registered only if an agreement is reached between the utility model applicant and the patent applicant that only the utility model application would be registered. This provision does not, however, apply to a utility model application (including a utility model application deemed to have been filed on the same date as the patent application under Article 17(3)) that is filed on the same date as the patent application if the utility model application is a dual application under Article 17.

(5) Where a utility model application or a patent application is invalidated, withdrawn or a utility model application is rejected, the application, for the purposes of paragraphs (1) to (4), is deemed never to have been filed.

(6) A utility model application or patent application filed by a person who is not the deviser, inventor or successor in title to the right to obtain a utility model registration or a patent, for the purposes of paragraphs (1) to (4), is deemed never to have been filed.

## **Article 9 Application for a Utility Model Registration**

(1) A person seeking to register a utility model shall file a utility model 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 an 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) deleted;
- (iv) the title of the device;
- (v) the name and address of the deviser; and
- (vi) deleted.

(2) A utility model application under paragraph(1) must be accompanied by an abstract, drawing(s) and a description stating the following:

- (i) the title of the device;
- (ii) a brief explanation of the drawing(s);
- (iii) a detailed description of the device; and
- (iv) the claim(s).

(3) The detailed description of the device under paragraph(2)(iii) must state the purpose, construction and effect of the device in such a manner that it may easily be carried out by a person with ordinary skill in the art to which the device pertains.

(4) The claim(s) under paragraph(2)(iv) must describe the matter for which protection is sought in one or more claims (referred to as "claim(s)"), and the

claim(s) must comply with each of the following subparagraphs:

- (i) the claim(s) must be supported by a detailed description of the device;
- (ii) the claim(s) must define the device clearly and concisely; and
- (iii) the claim(s) must define only the features indispensable for the constitution of the device.

(5) Details concerning the drafting of claim(s) under paragraph(2)(iv) are prescribed by Presidential Decree.

(6) Details concerning the description of an abstract under paragraph(2) are prescribed by ordinance of the Ministry of Commerce, Industry and Energy.

#### **Article 10 Scope of a Utility Model Application**

(1) A utility model application must relate to a single device only, unless a group of devices is linked to form a single general device concept.

(2) The requirements for a utility model application under paragraph (1) are prescribed by Presidential Decree.

#### **Article 11 Amendment of Procedure**

The Commissioner of the Korean Intellectual Property Office or the President of the Intellectual Property Tribunal shall order amendments to a utility model-related procedure within a designated period if the procedure falls under any of the following subparagraphs:

- (i) where the procedure does not comply with Article 3(1) of the Patent Act as applied *mutatis mutandis* under Articles 3*bis* or 4 of this Act;
- (ii) where the procedure does not comply with the formalities prescribed in this Act or by Presidential Decree;

- (iii) where, in violation of Article 29(2) of this Act, registration fees for the first year have not been paid; or
- (iv) where fees required under Article 30 have not been paid.

### **Article 12 Examination of Basic Requirement and Rejection of an Application**

(1) The Commissioner of the Korean Intellectual Property Office shall have a utility model application examined by an examiner to determine whether it falls any of the following subparagraphs:

- (i) where the device in the utility model application is related to the shape or structure of an article or a combination of articles;
- (ii) where the device in the utility model application is registrable under Article 7 of this Act;
- (iii) where the utility model application is drafted in accordance with Article 9(5) of this Act or meets the requirements of Article 10 of this Act;
- (iv) where the description or drawing(s) attached to the utility model application contain essential elements and are substantially clear; or
- (v) where an amendment to the description or drawing(s) attached to the utility model application complies with Article 14.

(2) An examiner may order an amendment to the description and drawing(s) attached to a utility model application within a designated period under any of the following subparagraphs:

- (i) where the device in the utility model application is not related to the shape or structure of an article or a combination of articles;
- (ii) where the device in the utility model application is unregistrable under Article 7 of this Act;

- (iii) where the utility model application does not comply with Article 9(5) of this Act or does not meet the requirements of Article (10) of this Act;
- (iv) where the description or drawing(s) attached to the utility model application do not contain essential elements or are substantially unclear; or
- (v) where the amendment of the description or drawing(s) attached to the utility model application does not comply with Article 14.

(3) Where a person who has been instructed to make an amendment under paragraph(2) fails to do so within the designated period, the examiner shall reject the utility model application; the decision to reject must be in writing and must state the reasons for the decision.

### **Article 13 Amendment of a Utility Model Application etc.**

(1) A person who initiates an application for utility model-related procedures may amend the application only when the utility model application is pending in the Intellectual Property Office or the Intellectual Property Tribunal. However, the description, drawing(s) and the abstract attached to the utility model application may not be amended after a period designated by ordinance of the Ministry of Commerce, Industry and Energy after the filing date of the utility model application.

(2) Deleted.

### **Article 14 Scope of an Amendment to Descriptions etc.**

An amendment to the description or drawing(s) under Articles 12(2) and 13 of this Act must be within the scope of the features disclosed in the description or drawing(s) originally attached to a utility model application.



### **Article 15 Treatment of Amendments to a Dual Application etc.**

(1) Deleted.

(2) Where a dual application under Article 17 of this Act is determined to have escaped from the scope of the claim(s) originally attached to a patent application after the registration of the utility model right, the dual application is deemed to have been filed when the written dual application was submitted.

### **Article 16 Division of Utility Model Application**

(1) An applicant who has filed a utility model application comprising two or more devices may divide the application into two or more applications within the period prescribed in Article 12(2) and the proviso of Article 13(1) of this Act.

(2) A divided utility model application under paragraph (1) (referred to as "a divisional application") is deemed to have been filed at the time the original utility model application was filed. However, the divisional application is deemed to have been filed on the date it was submitted if any of the following subparagraphs applies:

- (i) where Article 5(3) of this Act or Article 29(3) of the Patent Act applies, when a divisional application falls under another utility model application prescribed in Article 5(3) of this Act or a utility model application prescribed in Article 29(3) of the Patent Act;
- (ii) where Article 6(2) of this Act applies;
- (iii) where Article 18(2) of this Act applies; or
- (iv) where Article 54(3) of the Patent Act as applied *mutatis mutandis* under Article 20 of this Act applies.

(3) A person who files a divisional application under paragraph (1) shall indicate the purpose of the divisional application and the utility model application that forms the basis of the division.

(4) A person claiming the right of priority for a divisional application under Article 54 of the Patent Act, as applied *mutatis mutandis* under Article 20 of this Act, may file the documents as prescribed in Article 54(4) of the Patent Act with the Commissioner of the Korean Intellectual Property Office within three months after filing the divisional application, regardless of the period prescribed in Article 54(4) of the Patent Act.

### **Article 17 Dual Application**

(1) A person who has filed a patent application may file a utility model application that is within the scope of the original description attached to the patent application (referred to as "a dual application"), if the utility model application is filed before the receipt of a certified copy of the decision to grant a patent under Article 66 of the Patent Act. However, this provision does not apply if more than 30 days (or the extended period when a period for demanding a trial against a decision of refusal under Article 132<sup>ter</sup> of the Patent Act is extended under Article 15(1) of the Patent Act as applied *mutatis mutandis* under Article 4 of this Act) have elapsed following the transmittal of the examiner's first decision to reject the patent application.

(2) A person who initiates a dual application under paragraph (1) shall indicate its purpose and the patent application that forms the basis of the dual application.

(3) Where a dual application is carried out under paragraph (1), the utility model application is deemed to have been filed on the date the patent application was filed. However, if any of the following subparagraphs apply, the utility model application is deemed to have been filed on the date the dual application was submitted:

- (i) where Article 5(3) of this Act or Article 29(3) of the Patent Act applies, when the utility model application falls under another utility model application under Article 5(3) of this Act or a utility model application under Article 29(3) of the Patent Act;
- (ii) where Article 6(2) of this Act applies;

- (iii) where Article 18(2) of this Act applies;
- (iv) where Article 54(3) of the Patent Act as applied *mutatis mutandis* under Article 20 of this Act applies.

(4) Notwithstanding Article 54(4) of the Patent Act, a person claiming the right of priority for a utility model application under paragraph(1) of this Article may file documents as prescribed in Article 54 of the Patent Act as applied *mutatis mutandis* under Article 20 of this Act to the Commissioner of the Korean Intellectual Property Office within three months of filing the dual application.

#### **Article 18 Priority Claim Based on a Utility Model Application etc.**

(1) A person seeking to register a utility model may claim the right of priority for a device claimed in a utility model application disclosed in the description or drawing(s) originally attached to a utility model application or patent application for which the person has the right to obtain a patent or utility model registration (referred to as "an earlier application"), which the person filed before the later utility model application, except under any of the following circumstances:

- (i) where the later utility model application is filed more than one year after the filing date of the earlier application;
- (ii) where the earlier application falls under any of the following subparagraphs:
  - (a) a divisional application under Article 16(1) of this Act;
  - (b) a dual application under Article 17 of this Act;
  - (c) a divisional application under Article 52(1) of the Patent Act;
  - (d) a dual application under Article 53 of the Patent Act.
- (iii) where the earlier application has been abandoned, invalidated, withdrawn or rejected when the later utility model application is filed;

- (iv) where an examiner's decision on the grant of a patent or a trial or appeal decision rejecting the earlier application has become final when the later utility model application is filed; or
- (v) where the earlier application has been registered under Article 35(2) of this Act when the later utility model application is filed.

(2) A person claiming the right of priority under paragraph (1) shall indicate the purpose of the claim when filing the utility model application and identify the earlier application in the utility model application.

(3) A person who meets the requirements for claiming priority claim under paragraph (1) may amend or add the right of priority within one year and four months of the filing date of the earlier application (or, for two or more earlier applications, the filing date of the earliest application).

(4) Where devices described in a utility model application that claims the right of priority under paragraph (1) are disclosed in the description or drawing(s) originally attached to an earlier application that is the basis for the priority claim (excluding those devices disclosed in an application that claims priority to an earlier application that also claims priority under paragraph (1) of this Article or that claims priority under Article 4D(1) of the Paris Convention for the Protection of Industrial Property), the utility model application is deemed to have been filed when the earlier application was filed for the purpose of the following: Articles 5(1), (2) and (3) (main sentence), 6(1), 8(1) to (4), 38(iii), 39 and 41(1) and (2) of this Act, Article 136(4) of the Patent Act as applied under Article 77(3) of the Patent Act as applied *mutatis mutandis* under Article 42 of this Act, Article 103 of the Patent Act as applied *mutatis mutandis* under Article 42 of this Act; Articles 36(3) and 98 of the Patent Act and Articles 45 and 52(3) of the Industrial Design Act.

(5) For devices described in the description or drawing(s) originally attached to a utility model application that claims priority under paragraph (1) and disclosed in the description or drawing(s) originally attached to the earlier application that is the basis for the priority claim (excluding those devices disclosed in an application that claims priority to an earlier application that also claims priority under paragraph (1) of this Article or that claims priority

under Article 4D(1) of the Paris Convention for the Protection of Industrial Property), the laying open or publication for public inspection of the earlier application is deemed as effected at the time of laying open after registration of the utility model right was effected under Article 5(3) of this Act or Article 29(3) of the Patent Act. For this paragraph, "the earlier application" is deemed to be an international application deemed to be a utility model application under Article 57(1) of this Act or an international application deemed to be a patent application under Article 199(1) of the Patent Act (including an international application considered to be a utility model application or a patent application under Article 71(4) of this Act or Article 214(4) of the Patent Act); and "a device or invention described in the description, claim(s) or drawing(s) of the international application as of the international filing date and in the translated version" in Article 5(4) of this Act reads "a device or invention described in the description, claim(s) or drawing(s) of the international application as of the international filing date".

#### **Article 19 Withdrawal of an Earlier Application etc.**

(1) An earlier application from which the right of priority is claimed under Article 18(1) is deemed withdrawn one year and three months after the filing date of the earlier application where the application is a patent application, or from the claimed priority date of the earlier application where the application is a utility model application unless the earlier application falls under any of the following subparagraphs:

- (i) where it has been abandoned, withdrawn, invalidated or rejected;
- (ii) where an examiner's decision on the grant of a patent, or a trial or an appellate trial decision, has become final;
- (iii) where priority claims based on the earlier application have been withdrawn; or
- (iv) where the earlier application has been registered under Article 35(2) of this Act.

(2) The applicant of a utility model application that contains a priority claim under Article 18(1) may not withdraw the priority claim more than one year and three months after the filing date of the earlier application.

(3) Where a utility model application containing a priority claim under Article 18(1) is withdrawn within one year and three months of the filing date of an earlier application, the priority claim is deemed to be withdrawn simultaneously.

### **Article 20 *Mutatis Mutandis* Application of the Patent Act**

(1) Articles 33, 37 to 41, 43 and 44 of the Patent Act apply *mutatis mutandis* to the requirements for utility model registration and utility model applications.

(2) Article 35 of the Patent Act applies *mutatis mutandis* to utility model applications. In such cases, "for lack of entitlement to obtain a patent under Article 33(1)" reads "for lack of entitlement to obtain a patent under Article 33(1) of the Patent Act as applied *mutatis mutandis* under Article 20 of this Act in Article 25(1)(ii) or Article 47(1)(ii)".

(3) Article 54 of the Patent Act applies *mutatis mutandis* to claiming priority by Treaty for utility model applications. In such cases, "a person who ... complies with the requirements of paragraph(2)" in Article 54(7) reads "before a person who complies with the requirements of paragraph(2) obtains registration under Article 35(1)", and "within one year and four months of the earliest date" reads "within one year and four months of the earliest date and before registration under Article 35(1)".