

CHAPTER III

TECHNICAL EVALUATION

Article 21 Request for Technical Evaluation of Utility Models

(1) Any person may request a technical evaluation of registered utility model to the Commissioner of the Korean Intellectual Property Office. Where the claims of registered utility model contains two or more claims, a request must be made for all claims.

(2) A request under paragraph (1) may be made even after the extinguishment of a utility model right. However, where a utility model registration is revoked by a decision to revoke under Article 74(3) of the Patent Act as applied *mutatis mutandis* under Article 48 of this Act, or invalidated by an invalidation trial under Article 49(1) of this Act, this provision does not apply.

(3) A request under paragraph (1) may not be withdrawn.

(4) A request under paragraph (1) may be made only once. However, if an examiner cannot determine whether the utility model registration violates Articles 5(3) and (4) or 8(1) to (4) under the proviso of Article 25(2), an additional request may be made only once when the reason ceases to exist.

(5) Requisite procedures for a request for a technical evaluation of a utility model are prescribed by Presidential Decree.

Article 22 Technical Evaluation by Examiner

(1) When a request under Article 21(1) of this Act has been submitted, the Commissioner of the Korean Intellectual Property Office shall appoint an examiner to technically evaluate the utility model.

(2) Article 57(2) of the Patent Act applies *mutatis mutandis* to the qualification of examiners.

Article 23 Publication of Request for Technical Evaluation

(1) When a request for a technical evaluation of a utility model application has been made before publication of the utility model registration, the Commissioner of the Korean Intellectual Property Office shall publish the request in the Utility Model Gazette simultaneously with the publication of the registration.

(2) When a request for a technical evaluation of a registered utility model is made after publication of the registration, the Commissioner of the Korean Intellectual Property Office shall immediately publish the request in the Utility Model Gazette.

(3) Where a request for a technical evaluation has been made by a person other than the owner of a utility model right, the Commissioner of the Korean Intellectual Property Office shall notify the owner of the utility model right of the request.

Article 24 Prior Art Searches etc.

(1) Where a specialized search organization for searching prior art documents is considered necessary for the technical evaluation of a utility model, the Commissioner of the Korean Intellectual Property Office may rely on such an organization.

(2) Articles 58(2) and 58*bis* of the Patent Act apply *mutatis mutandis* to a technical evaluation of a utility model.

(3) Requisite matters concerning an assignment, such as the criteria of an assignment for a specialized search organization and the procedures for searching documents under paragraph(1), are prescribed by Presidential Decree.

Article 25 Decision on Request for Technical Evaluation

(1) An examiner shall revoke a utility model registration (referred to as 'a

decision to revoke a utility model registration"), if any of the following conditions apply in view of the results of a technical evaluation:

- (i) the utility model registration violates Article 25 of the Patent Act as applied *mutatis mutandis* under Article 4 of this Act, Articles 5, 7, 8(1) to (4) and 9(3) and (4) of this Act or Article 44 of the Patent Act as applied *mutatis mutandis* under Article 20 of this Act;
- (ii) where a person is not entitled to a patent under Article 33(1) of the Patent Act, as applied *mutatis mutandis* under Article 20 of this Act, or where a patent may not be granted under the proviso of Article 33(1);
- (iii) the utility model registration violates a treaty; or
- (iv) after registration of a utility model, the owner of the utility model right becomes incapable of enjoying the utility model right under Article 25 of the Patent Act as applied *mutatis mutandis* under Article 4 of this Act, or the utility model right no longer complies with a treaty.
- (v) the utility model registration violates the proviso of Article 35(2).
- (vi) where the amendment is beyond the scope of Article 14.

(2) If the utility model registration does not fall under any subparagraph of paragraph(1) in view of the results of a technical evaluation, an examiner shall decide to maintain the utility model registration (referred to as "a decision to maintain a utility model registration"). An examiner who cannot determine whether the utility model registration violates Articles 5(3) and (4) or 8(1) to (4) shall state such decision and the reasons for the decision.

(3) When revoking a utility model registration under paragraph(1), an examiner shall notify the requester of the technical evaluation and the owner of the utility model right of the reasons for revocation (only when the requester of the technical evaluation and the owner of the utility model right is not the same person), and provide the requester and owner with an opportunity to submit a written statement of arguments within a designated period.

(4) Where a decision to revoke a utility model registration under paragraph(1) has become final, the utility model right is deemed never to have existed. However, if a decision to revoke a utility model registration under Article 25(1)(iv) has become final, the utility model right is deemed not to have existed at the time the utility model registration first became subject to paragraph (1)(iv).

(5) An appeal may not be made against the decision to maintain a utility model registration under paragraph (2).

Article 26 Manner of Deciding on a Request for a Technical Evaluation

(1) An examiner's decision on a request for a technical evaluation must be in writing and must state the reasons for the decision.

(2) When an examiner's decision under paragraph(1) has been made, the Commissioner of the Korean Intellectual Property Office shall transmit a certified copy of the decision to the requester of the technical evaluation and the owner of the utility model right.

Article 27 Correction of Utility Model Registration in Technical Evaluation Proceedings

(1) The owner of a utility model right may request in writing a correction of the description or drawing(s) of a registered utility model within the period designated under Article 25(3) of this Act.

(2) A request for a correction under paragraph(1) may be made only for the following reasons:

- (i) to narrow a claim;
- (ii) to correct a clerical error; or
- (iii) to clarify an ambiguous description.

(3) Where a person other than the owner of a utility model right requests a correction under paragraph (1), the examiner shall transmit a copy of the written request to the requester of a technical evaluation.

(4) Article 77(3) of the Patent Act applies *mutatis mutandis* to corrections to a utility model registration.

(5) When a decision is made on the correction of a description or drawing(s) or both, the Commissioner of the Korean Intellectual Property Office shall publish the contents of the correction in the Utility Model Gazette.

Article 28 Suspension of Technical Evaluation Proceedings

(1) Proceedings for a technical evaluation may be suspended, if necessary, until a decision on an opposition against a utility model registration, or a trial decision or trial proceeding, becomes final.

(2) A presiding court may, if necessary, suspend a litigation proceeding until a decision on a technical evaluation becomes final.

(1) An appeal may not be made against the suspension under paragraphs (1) and (2).

Article 28bis *Mutatis Mutandis* Application of the Patent Act

Articles 142, 148(i) to (v) and (vii) of the Patent Act apply *mutatis mutandis* to technical evaluations of utility models.