

CHAPTER V

UTILITY MODEL RIGHT

Article 35 Registration of Establishment of a Utility Model Right and Publication of Registration

- (1) A utility model right comes into effect upon registration of its establishment.
- (2) The Commissioner of the Korean Intellectual Property Office shall register the establishment of a utility model right unless the utility model application comes under the subparagraphs of Article 11 or the subparagraphs of Article 12, or has been abandoned or withdrawn. However, if a situation in either of the following subparagraphs applies, the Commissioner of the Korean Intellectual Property Office shall register the establishment of the utility model right only if a corresponding patent right has been abandoned:
- (i) where a patent application is the basis for a dual application, and the establishment of the patent right is registered; or
 - (ii) where a patent application is based on a utility model application under Article 53 of the Patent Act (referred to as a dual application), and the establishment of the patent right from the dual application is registered.
- (3) Where a registration has been made under paragraph(2), the Commissioner of the Korean Intellectual Property Office shall publish the registration of the utility model with relevant information in the Utility Model Gazette.
- (4) The Commissioner of the Korean Intellectual Property Office shall reserve publication of a utility model registration under paragraph(3) if the utility model application is ordered to be treated confidentially under Article 41(1) of the Patent Act as applied *mutatis mutandis* under Article 20 of this Act until it is declassified; upon declassification, the Commissioner shall immediately publish the registration.

(5) The Commissioner of the Korean Intellectual Property Office shall make application documents and attached materials available for public inspection for a period of three months after the publication date of the registration under paragraph (3).

(6) When a registration is published under paragraph (3), any person may submit to the Commissioner of the Korean Intellectual Property Office information with supporting evidence that the device falls under any subparagraph of Article 25(1).

(7) Matters to be published in the Utility Model Gazette regarding publication of registrations under paragraph (3) are prescribed by Presidential Decree.

Article 36 The Term of a Utility Model Right

(1) The term of a utility model right commences upon registration of the utility model under Article 35(1) and remains in force for ten years after the filing date of the utility model application.

(2) Where a utility model right is granted to a lawful holder of the right under Article 35 of the Patent Act as applied *mutatis mutandis* under Article 20 of this Act, the term of the utility model right under paragraph (1) is calculated from the date following the filing date of the utility model application filed by the unentitled person.

(3) Deleted.

(4) Where for a utility model right that a utility model application is deemed to have been filed at the time of filing a dual application under Article 15(2) of this Act, the utility model term under paragraph (1) commences from the utility model registration date and remains in force for ten years after the filing date of the patent application on which the dual application is based.

Article 37 Effects of a Utility Model Right

The owner of a utility model right has an exclusive right to work the registered utility model commercially and industrially. However, where the

utility model right is the subject of an exclusive license, this provision does not apply to the extent that the exclusive licensee has the exclusive right to work the registered utility model under Article 100(2) of the Patent Act as applied *mutatis mutandis* under Article 42 of this Act.

Article 38 Limitations on a Utility Model Right

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

- (i) working a registered utility model for research or experimentation;
- (ii) vessels, aircraft or vehicles merely passing through the Republic of Korea or machinery, instruments, equipment or other accessories used on the vessels, aircraft or vehicles; or
- (iii) articles existing in the Republic of Korea at the time the utility model application was filed.

Article 39 Relation between Similar Registered Utility Models

Where working a registered utility model would utilize another person's registered utility model, patented invention or registered design or a design similar to the registered design under an application filed before the filing date of the application for the registered utility model, or where a utility model right conflicts with another person's design right or trademark right under an application for design or trademark registration filed before the filing date of the application for the registered utility model, the owner of the utility model right or exclusive or nonexclusive licensee may not work the registered utility model commercially or industrially without the license of the owner of the earlier utility model, patent, design right or trademark right, unless a nonexclusive license is obtained by a trial under Article (53)(1).

Article 40 Nonexclusive License Due to Working before the Registration of a Request for an Invalidation Trial

(1) Where a person falling under any of the following subparagraphs, before

the registration of a request for an invalidation trial of a relevant registered utility model or patent, has been commercially or industrially working a device in the Republic of Korea in good faith, or has been making preparations to work the device, without knowing that the registered utility model or patent is subject to invalidation, regardless of whether the utility model registration is based on a decision of maintenance under Article 25(2) of this Act or whether the person has given substantial attention to such matters, or has been commercially or industrially working an invention in the Republic of Korea in good faith, or has been making preparation to work the invention, without knowing that the patent was subject to invalidation, the person is entitled to have a nonexclusive license on that utility model or patent right or on the exclusive license existing at the time the utility model registration or patent was invalidated. However, the nonexclusive license must be limited to the device or invention being worked or for which preparations for working are being made and to the purpose of the working or preparations:

- (i) the original owner of a utility model right, where one of two or more utility model registrations granted for the same device has been invalidated;
- (ii) the original owner of a patent right, where a registered utility model and a patented invention are the same and the patent has been invalidated;
- (iii) the original owner of a utility model right, where the original owner's utility model registration has been invalidated and a utility model registration for the same device has been granted to an entitled person;
- (iv) the original patentee, where the original patentee's patent has been invalidated and a utility model registration for the same device as the invention has been granted to an entitled person; or
- (v) in cases referred to in subparagraphs (i) to (iv), a person who, at the time of registration of the request for an invalidation trial of an invalidated utility model or patent right, has been granted an exclusive license or a nonexclusive license, or a nonexclusive

license on the exclusive license, and the license has been registered. However, a person falling under Article 118(2) of the Patent Act is not required to register the license.

(2) A person granted a nonexclusive license under paragraph(1) shall pay reasonable remuneration for the nonexclusive license to the owner of a utility model right or the exclusive licensee.

Article 41 Nonexclusive License after a Design Right Expires

(1) Where a design right filed and registered on or before the filing date of a utility model application conflicts with the utility model right, and the term of the design right has expired, the owner of the design right is entitled to have a nonexclusive license on the utility model right to the extent of the design right, or on the exclusive license existing at the time the design right expired.

(2) Where a design right filed and registered on or before the filing date of a utility model application conflicts with the utility model right, and the term of the design right has expired, a person who, at the time of expiry, has an exclusive license on the expired design right or a nonexclusive license (limited to the nonexclusive license under Article 118(1) of the Patent Act as applied *mutatis mutandis* under Article 61 of the Industrial Design Act) on the expired design right or on the exclusive license is entitled to have a nonexclusive license, to the extent of the scope of the expired right, on the utility model right or on the exclusive license existing at the time the design right expired.

(3) A person granted a nonexclusive license under paragraph(2) shall pay reasonable remuneration for the nonexclusive license to the owner of the utility model right or the exclusive licensee.

Article 42 *Mutatis Mutandis* Application of the Patent Act

Articles 97, 99 to 103, 106 to 116 and 118 to 125 and 125*bis* of the Patent Act apply *mutatis mutandis* to a utility model right.