

(3) Article 49(4) of this Act applies *mutatis mutandis* to an opposition to the registration of a utility model.

Article 48 *Mutatis Mutandis* Application of the Patent Act

Articles 70 to 78*bis* of the Patent Act apply *mutatis mutandis* to an opposition to a utility model registration. In Article 77(3) of the Patent Act, "Articles 136(2) to 136(5)" reads "Articles 136(2), (3) and (5)", and in Article 78(1) of the Patent Act "a decision on an opposition" reads "a decision on a request for technical evaluation or a decision on an opposition".

CHAPTER VIII

TRIALS, RETRIALS AND LITIGATION

Article 49 Trial for Invalidation of Utility Model Registration

(1) Any interested party or an examiner may request a trial to invalidate a utility model registration under any of the following subparagraphs; when the registered utility model contains two or more claims, a request for an invalidation trial may be made for each claim:

- (i) where the registration of a utility model 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 the utility model has been registered to a person who is not entitled to the utility model right under Article 33(1) of the Patent Act as applied *mutatis mutandis* under Article 20 of this Act, or who may not obtain a patent under the proviso of Article 33(1) of the Patent Act;

- (iii) where the registration of a utility model violates a treaty;
- (iv) where, following the registration of the utility model, the owner of the utility model right is no longer capable of enjoying the utility model right under Article 25 of the Patent Act as applied *mutatis mutandis* to Article 4 of this Act, or the utility model registration no longer complies with a treaty;
- (ivbis) where the amendment is beyond the scope stipulated under Article 14; or
- (v) where the registration of a utility model violates the proviso of Article 35(2) of this Act.

(2) A request for a trial under paragraph(1) may be made even after the extinguishment of a utility model right.

(3) Where a trial decision invalidating a utility model registration has become final, the utility model right is deemed never to have existed; however, where a trial decision invalidating a utility model registration under paragraph(1)(iv) has become final, the utility model right is deemed not to have existed from the time the utility model registration first became subject to paragraph (1)(iv).

(4) Where a request for a trial under paragraph(1) has been made, the presiding trial examiner shall notify the exclusive licensee of the utility model right and any other persons who have registered rights related to the utility model registration of the contents of the request.

Article 49bis Correction of Utility Model Registration under Trial for Invalidation of Utility Model Registration

(1) The owner of a utility model right who demands a trial for invalidation under Article 49(1) of this Act may only request a correction of the description or drawing(s) in a utility model registration when the subparagraphs of Article 27(2) of this Act apply.

(2) A request for correction under paragraph(1) may be made within the period prescribed in Article 147(1) of the Patent Act or the proviso of Article 159(1) of the Patent Act as applied *mutatis mutandis* under Article 56 of this Act.

(3) Where a request for correction is submitted under paragraph(1), the presiding trial examiner shall transmit a certified copy of the request to the petitioner of the trial under Article 49(1).

(4) Articles 51(2) to (4), (6) to (10) and 55(1), (2) and (5) of this Act and Article 139(3) of the Patent Act as applied *mutatis mutandis* under Article 56 of this Act apply *mutatis mutandis* to a request for correction to a utility model registration under paragraph (1). In such cases, "only before a notice under Article 162(3) of the Patent Act as applied *mutatis mutandis* under Article 56 of this Act (where proceedings are reopened under Article 162(4) of the Patent Act, before issuance of the notice of concluded proceedings under Article 162(3) of the Patent Act)" in Article 51(9) of this Act reads "within the prescribed period if notice is issued under Article 51(4) of this Act".

Article 50 Trial to Confirm the Scope of a Utility Model Right

An owner of a utility model right or any interested person may request a trial to confirm the scope of a registered utility model. A trial may be requested for each claim if the registered utility model contains two or more claims.

Article 51 Trial for Correction

(1) The owner of a utility model right may request a trial for a correction of the description or drawing(s) of the registered utility model under any subparagraph of Article 27(2) unless a technical evaluation, an opposition against the registration or a trial for invalidation of a utility model registration is pending before the Korean Intellectual Property Office or before the Intellectual Property Tribunal.

(2) A correction to the description or drawing(s) under paragraph (1) must be within the scope of the features disclosed in the description or drawing(s)

attached to the utility model application. (Where a correction is made under Article 27(2)(ii), it must be within the scope of the features disclosed in the description or drawing(s) originally attached to the utility model application.)

(3) A correction to the description or drawing(s) under paragraph(1) must neither substantially expand nor modify the scope of the claim(s).

(4) A trial examiner who determines that a request for a trial under paragraph 1 does not fall under any subparagraph of Article 27(2) or that the request does not comply with paragraphs 2 or 3 shall notify the requester of the reason for the decision and give the requester an opportunity to submit a written response within a designated period.

(5) A trial for a correction under paragraph (1) may be requested even after a utility model right has been extinguished. However, where the utility model registration has been revoked by a decision to revoke under Article 74(3) of the Patent Act as applied *mutatis mutandis* under Article 25(1) or 48, or invalidated by a trial decision to invalidate, this provision does not apply.

(6) The owner of a utility model right may not request a trial for a correction under paragraph(1) without the consent of an exclusive licensee, a pledgee or a nonexclusive licensee, under Article 39(1) of the Patent Act as applied *mutatis mutandis* under Article 20 of this Act, and Articles 100(4) and 102(1) of the Patent Act as applied *mutatis mutandis* under Article 42 of this Act.

(7) Where the description or drawing(s) of a registered utility model have been corrected by a trial under paragraph(1), the President of the Intellectual Property Tribunal shall notify the Commissioner of the Korean Intellectual Property Office of the content of the correction.

(8) Where a trial decision to allow a correction to the description or drawing(s) of a registered utility model becomes final, the utility model application and registration of the establishment of the utility model right are deemed to have been made on the basis of the corrected description or drawing(s).

(9) A person who requests a trial under paragraph(1) may correct the description or drawing(s) attached to the request for a trial under

Article 55(5) of this Act only if the request is submitted before issuance of a notification under Article 162(3) of the Patent Act as applied *mutatis mutandis* under Article 56 of this Act (where proceedings have been reopened under Article 162(4) of the Patent Act, before issuance of the notification of closure of the proceedings under Article 162(3) of the Patent Act).

(10) The Commissioner of the Korean Intellectual Property Office publish a notice in the Utility Model Gazette when a notice under paragraph(7) has been given.

Article 52 Trial to Invalidate a Correction

(1) An interested party or an examiner may request a trial for an invalidation of a correction under Articles 27(1), 49*bis*(1) and 51(1) of this Act, or Article 77(1) of the Patent Act as applied *mutatis mutandis* under Article 48 of this Act, where the description or drawing(s) of a registered utility model have been corrected contrary to any of the following subparagraphs:

- (i) any subparagraph of Article 27(2);
- (ii) Article 51(2) or (3) (including cases that apply *mutatis mutandis* under Article 49*bis*(4)); or
- (iii) either paragraph (2) or (4) of Article 136 or identical provisions under Article 77(3) of the Patent Act as applied *mutatis mutandis* under Articles 27(4) or 48 of this Act.

(2) Article 49(2) and (4) applies *mutatis mutandis* to a request for a trial under paragraph (1).

(3) The owner of a utility model right who has requested a trial under paragraph(1) may request a correction to the description or drawing(s) of a utility model registration under Article 147(1) or the latter part of Article 159(1) of the Patent Act as applied *mutatis mutandis* under Article 56 of this Act within the designated period only if any subparagraph of Article 27(2) of this Act applies.

(4) Article 49bis(3) and (4) applies *mutatis mutandis* to a request for a correction under paragraph(3). In such cases, "Article 49(1)" in Article 49bis(3) reads "Article 52(1)".

(5) Where a trial decision invalidating a correction to the description or drawing(s) under paragraph(1) has become final, the correction is deemed to have never been made.

Article 53 Trial to Grant a Nonexclusive License

(1) Where the owner of a utility model right or an exclusive or nonexclusive licensee seeks permission to exercise the registered utility model under Article 39 and the other person refuses permission without justifiable reasons or permission is impossible to obtain, the owner or exclusive or nonexclusive licensee may request a trial to grant a nonexclusive license with the scope necessary to work the registered utility model.

(2) When a trial under paragraph (1) has commenced, a nonexclusive license may be granted only where the registered utility model of the later application constitutes an important technical advance that has substantial economic value in comparison to the other person's registered utility model or patented invention for which an application was filed before the filing date of the later application.

(3) If a person ordered to grant a nonexclusive license in accordance with a trial under paragraph(1) needs to work the registered utility model of the party who has been granted the nonexclusive license, and if the party refuses to give permission or if permission is impossible to obtain, the person may request a trial for the grant of a nonexclusive license with the scope necessary to work the registered utility model.

(4) A party granted a nonexclusive license under paragraphs (1) and (3) shall remunerate the owner of the utility model right, the patentee, the owner of the design right or the exclusive licensee; if payment is not possible for unavoidable reasons, the remuneration must be placed in deposit.

(5) A nonexclusive licensee under paragraph(4) may not work a registered

utility model, a patented invention or a registered design or a similar design without paying the remuneration or placing a deposit.

Article 54 Trial against a Decision to Revoke a Utility Model Registration

A person who has received a decision to revoke a utility model registration under Article 25(1) of this Act or Article 74(3) of the Patent Act as applied *mutatis mutandis* under Article 48 of this Act, and who does not agree with the ruling, may request a trial within thirty days of the date of receiving a certified copy of the ruling.

Article 54bis Trial against a Decision to Reject a Utility Model Application

Where a person who receives a decision to reject under Article 12(3) is dissatisfied with the decision, the person may request a trial within thirty days of receiving a certified copy of the decision.

Article 55 Formal Requirements of a Request for a Trial

(1) A person requesting a trial shall submit a written request to the President of the Intellectual Property Tribunal, stating the following:

- (i) the names and addresses of the parties (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) identification of the trial case; and
- (iv) the purpose and grounds of the request.

However, in a request for a trial against a decision to revoke under Article 54 of this Act or a trial against a decision to reject under Article 54*bis* of this Act, Article 140*bis*(1) of the Patent Act applies.

(2) An amendment to a request for a trial submitted under paragraph (1) may not change the intent or purpose of the request unless the grounds for the request are amended under subparagraph (1)(iv).

(3) In addition to the particulars referred to in paragraph (1), a written request for a trial under Article 53(1) must state the following:

- (i) the number and title of the utility model registration that is required to be worked;
- (ii) the number, title and date of the other party's patented invention, registered utility model or registered design to be worked; and
- (iii) the scope, duration and remuneration for the nonexclusive license for the patented invention, the registered utility model or the registered design.

(4) When a trial is requested to confirm the scope of a utility model right under Article 50, the explanation and the necessary drawing(s) that can be compared with the registered utility model must be attached to the written request.

(5) When a trial for a correction under Article 51(1) is requested, the corrected description or drawing(s) must be attached to the written request for a trial.

Article 56 *Mutatis Mutandis* Application of the Patent Act

Articles 139, 140*bis*(2), 141 to 166, 171(2), 172, 176 and 178 to 191 of the Patent Act apply *mutatis mutandis* to trials, appellate trials, retrials and litigation. In this case, "the opponent" in Article 140*bis*(2) of the Patent Act reads "a person who requests a technical evaluation or an opponent"; "the decision on a patent opposition" in Article 164(1) reads "the decision on a

request for technical evaluation or an opposition to a utility model registration", and "an examination or an opposition" in Article 172 reads "an examination, technical evaluation of a utility model or an opposition to a utility model registration".

CHAPTER IX

INTERNATIONAL APPLICATIONS UNDER THE PATENT COOPERATION TREATY

Article 57 Utility Model Application Based on an International Application

(1) Where an international application for which an international filing date has been recognized under the Patent Cooperation Treaty designates the Republic of Korea as a designated State to obtain a utility model registration, the application is considered to be a utility model application filed on its international filing date.

(2) Article 54 of the Patent Act as applied *mutatis mutandis* under Article 20 of this Act does not apply to an international application considered to be a utility model application filed on its international filing date under paragraph (1) (referred to as "an international utility model application").

Article 58 Special Provision on Devices Considered to be Novel

Notwithstanding Article 6(2), any person applying Article 6(1)(i) and (iii) to a device claimed in an international utility model application may submit a written statement to that effect and documents substantiating that the device falls under Article 6(1)(i) and (iii) to the Commissioner of the Korean Intellectual Property Office within the period prescribed by ordinance of the Ministry of Commerce, Industry and Energy.