

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.

Article 59 Translation of International Utility Model Application

(1) An applicant who has filed an international utility model application in a foreign language shall submit to the Commissioner of the Korean Intellectual Property Office, a Korean translation of the description, claim(s), textual matter of the drawing(s) and the abstract filed on the international filing date, within a period (referred to as "the domestic period for submitting documents") that is not more than two years and six months after the priority date as defined in Article 2(xi) of the Patent Cooperation Treaty (referred to as "the priority date"). However, if the claim(s) of an international utility model application have been amended under Article 19(1) of the Patent Cooperation Treaty, the applicant is only required to submit a Korean translation of the amended claim(s).

(2) Where a Korean translation of the description and claim(s) under paragraph(1) have not been submitted within the domestic period for submitting documents, the international utility model application is deemed to have been withdrawn.

(3) An applicant who has submitted the Korean translation referred to in paragraph(1) may submit a new translation to replace the earlier translation only within the designated domestic period for submitting documents. If the applicant has made a request under Article 23(2) or 40(2) of Patent Cooperation Treaty (referred to as "a request for domestic treatment"), this provision does not apply.

(4) Matters that were disclosed in the description, claim(s) and textual matter of the drawing(s) of an international utility model application filed on the international filing date but not disclosed in the translation under paragraphs (1) or (3) (referred to as "the translated version") submitted within the domestic period for submitting documents (or the date of the request for an examination where the applicant has made the request within the appropriate period, referred to as "the relevant date") are deemed not to have been disclosed in the description, claim(s) and textual matter of the drawing(s) of the international utility model application filed on the international filing date.

(5) An application submitted on the international filing date of an

international utility model application is deemed to be an application submitted under Article 9(1).

(6) The translated version of the description, claim(s), drawing(s) and abstract of an international utility model application (or the description, claim(s), drawing(s) and abstract submitted on the international filing date if the international utility model application is filed in the Korean language) is deemed to be the description, claim(s), drawing(s) and abstract submitted under Article 9(2).

(7) Article 63(1) and (2) does not apply where a Korean translation of the amended claim(s) has been submitted under the proviso of paragraph (1).

(8) Where a Korean translation has been submitted under the proviso of paragraph(1) only for the amended claim(s), the claim(s) submitted on the international filing date are not recognized.

Article 60 Special Provisions on Claim of Priority

(1) Articles 18(2) and 19(2) do not apply to an international utility model application.

(2) For the purpose of Article 18(4) regarding an international utility model application, "description or drawing(s) originally attached to an earlier application" reads "description, claim(s) and textual matter of the drawing(s) submitted on the international filing date under Article 59(1), and the translated version of the documents or drawing(s) (except the textual matter of the drawing(s)) of the international application submitted on the international filing date" and "laying open for public inspection" reads "laying open for public inspection or international publication under Article 21 of the Patent Cooperation Treaty".

(3) For the purpose of Articles 18(1), (3), (4) and 19(1), where the earlier application under Article 18(1) is the international utility model application or international patent application under Article 199(2) of the Patent Act, "description or drawing(s) originally attached to a model application" in Article 18(1) and (3) reads "description, claim(s) and drawing(s) of an

international application submitted on the international filing date under Article 59(1) of this Act or Article 201(1) of the Patent Act"; "description or drawing(s) originally attached to the earlier application" in Article 18(4) reads "description, claim(s) or drawing(s) of an international application concerning an earlier application submitted on the international filing date under Article 59(1) of this Act or Article 201(1) of the Patent Act"; "laying open of the earlier application for public inspection" reads "international publication concerning the earlier application under Article 21 of the Patent Cooperation Treaty"; and "one year and three months after the filing date" in Article 19(1) reads "at the relevant date under Article 59(4) of this Act or Article 201(4) of the Patent Act or one year and three months after the international filing date under Article 59(1) of this Act or Article 201(1) of the Patent Act, whichever date expires later," respectively.

(4) For the purpose of Articles 18(1), (3) and (4) or 19(1), where the earlier application under Article 18(1) is an international utility model application recognized as a utility model application or a patent application under Article 71(4) of this Act or Article 214(4) of the Patent Act, "description or drawing(s) originally attached to the application" in Articles 18(1) and (3) reads "description, claim(s) or drawing(s) of an international application as of the date regarded as the international filing date under Article 71(4) of this Act or Article 214(4) of the Patent Act" and "description or drawing(s) originally attached to the earlier application" in Article 18(4) reads "description, claim(s) or drawing(s) of an international application concerning an earlier application as of the date regarded as the international filing date under Article 71(4) of this Act or Article 214(4) of the Patent Act" and "one year and three months after the filing date of the earlier application" in Article 19(1) reads "within one year and three months of the date regarded as the international filing date under Article 71(4) of this Act or Article 214(4) of the Patent Act or at the time of making a decision under Article 71(4) of this Act or Article 214(4) of the Patent Act, whichever date expires later," respectively.

Article 61 Submission of Documents

(1) An applicant for an international utility model application shall submit a document to the Commissioner of the Korean Intellectual Property Office

within the domestic period for submitting documents, stating the following; furthermore, under Article 59(1), an applicant who files the application in a foreign language shall submit the document with a Korean translation:

- (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 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) deleted;
- (iv) the title of the device;
- (v) the name and residential or business address of the deviser; and
- (vi) the international filing date and the international application number.

(2) If the submission of documents falls under either of the following subparagraphs, the Commissioner of the Korean Intellectual Property Office shall order amendments within a designated period:

- (i) where the document under paragraph(1) was not submitted within the domestic period for submitting documents; or
- (ii) where the document under paragraph(1) fails to comply with the formalities prescribed in this Act or any order under this Act.

(3) Where a person who has been instructed to make an amendment under paragraph(2) fails to make an amendment within the designated period, the Commissioner of the Korean Intellectual Property Office may invalidate the international utility model registration application.

Article 62 Submission of Drawings

(1) An applicant for an international utility model application shall submit a drawing or drawings (including a brief description of the drawing(s)) to the

Commissioner of the Korean Intellectual Property Office no later than the relevant date if no drawing of the international application submitted on the international filing date is included.

(2) The Commissioner of the Korean Intellectual Property Office may require the applicant for an international utility model application to submit a drawing or drawings within a designated period when the drawing(s) under paragraph(1) have not been submitted on or before the relevant date. The same procedure applies where the Korean translation of the textual matter of the drawing(s) under Article 59(1) or (3) has not been submitted by the relevant date.

(3) The Commissioner of the Korean Intellectual Property Office may invalidate an international utility model application where the applicant required to submit the drawing(s) under paragraph(2) has failed to do so within the designated period.

(4) A drawing submitted under paragraph (1) or(2) is deemed to be an amendment under Article 13(1) of this Act. However, the period allowed for amendment under Article 13(1) of this Act does not apply to such a drawing.

Article 63 Amendment after Receipt of the International Search Report

(1) Where the claim(s) of an international utility model application have been amended after receiving the international search report under Article 19(1) of the Patent Cooperation Treaty, the applicant of the international utility model application shall submit to the Commissioner of the Korean Intellectual Property Office a Korean translation of the amendment no later than the relevant date.

(2) Where a Korean translation of an amendment has been submitted under paragraph(1), the claim(s) are deemed to have been amended under Article 13(1) by the Korean translation.

(3) Where a statement under Article 19(1) of the Patent Cooperation Treaty has been submitted to the International Bureau under Article 2(xix) of the

Treaty (referred to as "the International Bureau"), the applicant of an international utility model application shall submit to the Commissioner of the Korean Intellectual Property Office a Korean translation of the statement.

(4) If an applicant for an international utility model application has not submitted the Korean translation of the amendment or statement under paragraph(1) or (3) on or before the relevant date, the amendment or statement under Article 19(1) of the Patent Cooperation Treaty are deemed not to have been submitted.

(5) The period for an amendment prescribed in Article 13(1) does not apply to an amendment under paragraph (2).

Article 64 Amendment before Establishment of the International Preliminary Examination Report

(1) Where the description, claim(s) and drawing(s) of an international utility model application have been amended before the establishment of the International Preliminary Examination Report under Article 34(2)(b) of the Patent Cooperation Treaty, the applicant of an international utility model application shall submit to the Commissioner of the Korean Intellectual Property Office a Korean translation of the amendment no later than the relevant date.

(2) Where a Korean translation of the amendment has been submitted under paragraph(1), the description and drawing(s) are deemed to have been amended under Article 13(1) by the Korean translation.

(3) If an applicant for an international utility model application has not followed the procedure under paragraph (1) on or before the relevant date, the amendment under Article 34(2)(b) of the Patent Cooperation Treaty are deemed not to have been submitted.

Article 65 Special Provision on Amendments

(1) Notwithstanding Article 13(1), no amendment to an international utility model application (except an amendment under Articles 63(2) and 64(2))

may be made until the registration fees prescribed under Article 29(1) and the official fees prescribed under Article 30(1) have been paid, a Korean translation of the application under Article 59(1) (except the case of an international utility model application made in the Korean language) has been submitted, and the relevant date has passed.

(2) The proviso of Article 13(1) does not apply to an amendment of an international utility model application under Articles 28(1) or 41(1) of the Patent Cooperation Treaty.

(3) With regard to the scope of an amendment to an international utility model application, "the description or drawing(s) originally attached to the utility model application" in Article 14 reads "the features disclosed in the translated version of the description, claim(s) or textual matter of the drawing(s) of the international utility model application submitted on the international filing date or the drawing(s) (except the textual matter of the drawing(s)) of the international utility model application submitted on the international filing date".

Article 66 Time Restrictions on Filing a Dual Application

Notwithstanding Article 17(1), a dual utility model application that is based on an international application considered to be a patent application filed on its international filing date under Article 199(1) of the Patent Act may not be filed until the official fees prescribed under Article 82(1) of the Patent Act have been paid and a translation (except for an international patent application filed in the Korean language) under Article 201(1) of the Patent Act has been submitted. However, a dual utility model application that is based on an international application considered to have been filed on the date recognized as the international filing date under Article 214(4) of the Patent Act may not be filed until the decision under Article 214(4) of the Patent Act has been made.

Article 67 Special Provision on Oppositions against a Utility Model Registration

A person may file an opposition against the registration of an international

utility model application on the grounds that the device does not fall under either of the following subparagraphs nor under any subparagraph of Article 47(1):

- (i) the device is disclosed in the description, claim(s) or textual matter of the drawing(s) of an international application submitted on the international filing date and in the translated version; or
- (ii) the device is disclosed in the drawing(s) (excluding the textual matter of the drawing(s)) of an international application submitted on the international filing date.

Article 68 Special Provisions on an Invalidation Trial of a Utility Model Registration

A person may request a trial to invalidate a utility model registration for an international application on the grounds that the device does not fall under either of the following subparagraphs or under any subparagraph of Article 49(1):

- (i) the device is disclosed in the description, claim(s) or textual matter of the drawing(s) of an international application submitted on the international filing date and in the translated version; or
- (ii) the device is disclosed in the drawing(s) (excluding the textual matter of the drawing(s)) of an international application submitted on the international filing date.

Article 69 Time Restriction on Request for Technical Evaluation of Utility Model

With regard to a request for a technical evaluation of an international utility model application, "any person" in Article 21(1) reads "any person after the relevant date".

Article 70 Special Provisions on Paying Registration Fees

With regard to the registration fees for the first year for an international utility model application, "simultaneously with a utility model application (divisional application for a divisional application under Article 16 of this Act or dual application for a co-filing under Article 17 of this Act)" in Article 29(2) reads "within the domestic period for submitting documents under Article 59(1) (where a request for domestic treatment under Article 59(3) has been made, until the time of a request for domestic treatment)".

Article 71 International Application Considered to be a Utility Model Application by Decision

(1) Where the receiving office referred to in Article 2(xv) of the Patent Cooperation Treaty has refused to recognize an international filing date or has made a declaration of withdrawal of an international application under Article 25(1)(a) or (b) of the Patent Cooperation Treaty, or the International Bureau has made a finding that the recorded copy under Article 25(1)(a) has not been received under Article 25(1)(a) of the Patent Cooperation Treaty, for an international application that designates the Republic of Korea as a designated State, an applicant of the international application may request the Commissioner of the Korean Intellectual Property Office, as prescribed by ordinance of the Ministry of Commerce, Industry and Energy, to decide whether the refusal, declaration or finding is properly made under Article 25(2)(a) of the Treaty.

(2) A person making a request under paragraph (1) shall submit to the Commissioner of the Korean Intellectual Property Office a petition with a Korean translation of the description, claim(s), textual matter of the drawing(s) and other documents related to the international application as prescribed by ordinance of the Ministry of Commerce, Industry and Energy.

(3) Where a request under paragraph (1) has been made, the Commissioner of the Korean Intellectual Property Office shall decide whether the refusal, declaration or finding referred to in the request was properly made under the Patent Cooperation Treaty and its Regulations.

(4) Where the Commissioner of the Korean Intellectual Property Office has decided under paragraph (3) that the refusal, declaration or finding was not properly made under the Patent Cooperation Treaty and its Regulations, the relevant international application is deemed to be a utility model application filed on the date that would have been recognized as the international filing date if the refusal, declaration or finding had not been made for the international application.

(5) Articles 57(2), 58, 59(4) to (8), 60(1) and (2), 62, 65, and 67 to 70 apply *mutatis mutandis* to an international application considered to be a utility model application filed on the date that would have been recognized as the international filing date under paragraph (4).

(6) With regard to the amendment of an international application considered to be a utility model application under paragraph (4), "the filing date of the utility model application" in Article 13(1) of this Act reads "date of decision that the refusal, declaration or finding was not properly made under Article 71(4)".

Article 72 *Mutatis Mutandis* Application of the Patent Act

Articles 192 to 198*bis*, 206, 210 and 211 of the Patent Act apply *mutatis mutandis* to international utility model applications. In this situation, "request an examination of the application" in Article 210 of the Patent Act reads "a request for domestic treatment".

CHAPTER X

SUPPLEMENTARY PROVISIONS

Article 73 Utility Model Gazette

(1) The Korean Intellectual Property Office shall publish the Utility Model Gazette.