

## CHAPTER VIII

### RETRIAL AND LITIGATION

#### Article 83 Request for a Retrial

(1) Any party may request a retrial against a trial decision that has become final.

(2) Articles 451 and 453 of the Civil Procedure Act apply *mutatis mutandis* to the request for a retrial under paragraph (1) of this Article.

#### Article 84 Request for a Retrial on Account of Collusion

(1) Where the parties to a trial colluded to bring about a trial ruling that damages the rights or interests of a third party, the third party may request a retrial against the trial ruling that has become final.

(2) In a retrial on account of collusion, the parties to the initial trial are the joint defendants.

#### Article 85 Restriction on the Effects of a Trademark Right Restored by a Retrial

The effects of a trademark right do not extend to the good-faith use of a trademark that is identical to the registered trademark on goods identical to the designated goods and acts referred to in Article 66(i) to (iv), after the decision concerned became final but before the request for a retrial has been registered, where:

- (i) the trademark registration or the registration for renewal of the term of the invalidated trademark right has been restored by a retrial;
- (ii) the trademark registration that had been cancelled has been restored by a retrial; or

- (iii) after a trial decision that a product was outside the scope of the trademark right became final, a decision to the contrary has been made at a retrial.

**Article 86 *Mutatis Mutandis* Application of the Patent Act**

(1) Articles 180 and 184 of the Patent Act and Article 459(1) of the Civil Procedure Act apply *mutatis mutandis* to procedures and requests for a retrial.

(2) Articles 186 to 188 and 189 of the Patent Act apply *mutatis mutandis* to litigation under this Act. Where Article 186(1) of the Patent Act applies, "action against a trial decision" means "action against a trial decision and a decision to reject an amendment under Article 17(1) as applied under Article 81(1) (including Article 184 of the Patent Act as applied under 86(1))" and "Articles 133(1), 134(1), 135(1), 137(1) and (3) and 138(1)" in Article 187 of the Patent Act means "Articles 71(1), 72(1), 72*bis*(1), 73(1) and (2), 74(1) and 75".

**CHAPTER VIII*bis***

**INTERNATIONAL APPLICATIONS UNDER THE PROTOCOL**

**Part I. International Applications etc.**

**Article 86*bis* International Applications**

A person who desires to applying for an international registration referred to in Article 2(1) of the Protocol shall file with the Commissioner of the Korean Intellectual Property Office an international application based on a trademark registration or an application for trademark registration that falls under any of the following subparagraphs:

- (i) the applicant's application for trademark registration;
- (ii) the applicant's trademark registration; or
- (iii) the applicant's application for trademark registration and the applicant's trademark registration.

#### **Article 86<sup>ter</sup> Entitlement to File**

(1) A person who falls under any of the following subparagraphs may file an international application with the Commissioner of the Korean Intellectual Property Office:

- (i) a national of the Republic of Korea; or
- (ii) a person who resides (or, if a legal entity, has a real and effective industrial or commercial establishment) in the territory of the Republic of Korea.

(2) Two or more persons who jointly file an international application shall meet the requirements for an entitlement to file as prescribed by ordinance of the Ministry of Commerce, Industry and Energy.

#### **Article 86<sup>quater</sup> Procedure for an International Application**

(1) A person filing an international application shall submit in a language prescribed by ordinance of the Ministry of Commerce, Industry and Energy a request for an international application and the documents necessary for an international application (referred to as "a request for an international application") to the Commissioner of the Korean Intellectual Property Office.

(2) The following particulars must be indicated in a request for an international application:

- (i) the name and address of the applicant (and, if a legal entity, the name and address of the business);

- (ii) indications concerning entitlement to file under Article 83ter;
- (iii) the names of the contracting states and intergovernmental organizations (referred to as "the designated states") where protection for the trademark is secured;
- (iv) the filing date and the application number of the basic application under Article 2(1) of the Protocol (referred to as "the basic application") or the registration date and the registration number of the basic registration under Article 2(1) of the Protocol (referred to as "the basic registration");
- (v) the trademark for which international registration is sought;
- (vi) goods for which international registration is sought and the classes of the goods; and
- (vii) the other particulars prescribed by ordinance of the Ministry of Commerce, Industry and Energy.

(3) Where a person filing an international application claims color as a distinctive feature of the trademark, the person shall state the fact of this claim and file a notice specifying the color or combination of colors claimed along with a request for an international application; the person shall also append color copies of the trademark to a request for an international application.

**Article 86quinquies Examination of the Particulars of an International Application etc.**

(1) Where the particulars appearing in a request for an international application correspond to the particulars appearing in the basic application or the basic registration, the Commissioner of the Korean Intellectual Property Office shall indicate in the request for an international application an acknowledgement of the correspondence and the date of receiving the request for an international application.

(2) After indicating the date of receipt and so on under paragraph (1), the Commissioner of the Korean Intellectual Property Office shall transmit promptly the request for an international application and the documents necessary for the international application to the International Bureau as prescribed under Article 2(1) of the Protocol (referred to as "the International Bureau") and a copy of the request for an international application to the applicant.

#### **Article 86sexies Subsequent Designation**

(1) The holder of an international registration who designates additional states or intergovernmental organizations where the protection of the internationally registered mark is sought (referred to as "a subsequent designation") may present a request for a subsequent designation to the Commissioner of the Korean Intellectual Property Office as prescribed by ordinance of the Ministry of Commerce, Industry and Energy.

(2) For the purpose of paragraph (1), the holder of an international registration may request a subsequent designation for all or some of the goods of the internationally registered trademark.

#### **Article 86septies Renewal of Term**

(1) The holder of an international registration may renew the term of the international registration for an additional period of ten years.

(2) A person renewing the term of an international registration under paragraph (1) shall present a request for renewal of the term of the international registration to the Commissioner of Korean Intellectual Property Office as prescribed by ordinance of the Ministry of Commerce, Industry and Energy.

#### **Article 86octies Recording a Change of Ownership of an International Registration**

(1) The holder of an international registration or the holder's assignee may

change the ownership of the international registration for all or some of the designated goods or the designated states.

(2) A person changing the ownership of an international registration under paragraph (1) shall present a request for recording the change of ownership to the Commissioner of Korean Intellectual Property as prescribed by ordinance of the Ministry of Commerce, Industry and Energy.

### **Article 86*novies* Payment of Official Fees**

(1) The following persons shall pay the official fees to the Commissioner of the Korean Intellectual Property Office:

- (i) a person filing an international application;
- (ii) a person requesting a subsequent designation;
- (iii) a person requesting renewal of the term of an international registration under Article 87*septies*; or
- (iv) a person requesting that a change of ownership be recorded in the international registration under Article 87*octies*.

(2) Matters necessary for paying official fees, including procedures and time limits for paying under paragraph (1), are prescribed by ordinance of the Ministry of Commerce, Industry and Energy.

### **Article 86*decies* Amendment concerning Nonpayment of Official Fees**

Where a person who falls under any subparagraph of Article 86*novies*(1) fails to pay the official fees required under Article 86*novies*(2), the Commissioner of the Korean Intellectual Property Office may instruct the person to pay the fees within a designated period.

**Article 86undecies   Invalidation of a Procedure**

Where a person who has been instructed to pay the official fees under Article 86decies fails to pay the official fees within the designated period, the Commissioner of the Korean Intellectual Property Office may invalidate the procedure.

**Article 86duodecies   Recording a Change in International  
Registration Matters**

A request for recording a change in matters concerning an international registration or in any other matters necessary for an international application are prescribed by ordinance of the Ministry of Commerce, Industry and Energy.

**Article 86terdecies   Exclusion of Business Emblems**

Article 86bis to 86duodecies does not apply to business emblems.

**Part II. Special Provisions on an International Application for  
Trademark Registration**

**Article 86quaterdecies   International Application for Trademark  
Registration**

(1) An international application that has been registered internationally under the Protocol and that designates the Republic of Korea as a designated State (including subsequent designations) is considered to be an application for trademark registration under this Act.

(2) In paragraph (1), the date of an international registration under Article 3(4) of the Protocol (referred to as "the date of the international registration") is considered to be the filing date of the application for

trademark registration under this Act. However, if an international application subsequently designates the Republic of Korea, the date (referred to as "the date of subsequent designation") on which the subsequent designation is recorded in the International Register defined in Article 2(1) of the Protocol (referred to as "the International Register") is considered to be the filing date of the application for trademark registration under this Act.

(3) Where an international application is considered to be an application for trademark registration under paragraph (1) (referred to as "an international application for trademark registration"), the name and address of the owner of the international registration (or, if a legal entity, its name and business address), the trademark, the designated goods and the classification(s) of the goods that are recorded in the International Register are deemed to be the name and address of the applicant (or, if a legal entity, its name and business address), the trademark, the designated goods and the classification(s) of the goods, respectively, under this Act.

#### **Article 86*quindecies* Special Provision on Business Emblems**

The provisions for a business emblem do not apply to an international application for trademark registration.

#### **Article 86*sedecies* Special Provisions on an International Application for Trademark Registration**

(1) In applying this Act to an international application for trademark registration, the purport of the priority claim, the name of the country in which the earlier application was filed and the filing date of the earlier application recorded in the International Register are deemed to be the purport of the priority claim, the name of the country in which the earlier application was filed and the filing date of the earlier application that are kmindicated in the application for trademark registration.

(2) In applying this Act to an international application for trademark registration, the purport of a three-dimensional trademark that is recorded in the International Register is deemed to be the purport of a three-dimensional trademark indicated in the application for trademark registration.



(3) A person seeking to register a collective mark shall submit the articles of association prescribed in Article 9(3) within the period prescribed by ordinance of the Ministry of Commerce, Industry and Energy.

**Article 86*septiesdecies* Effect of an International Application for Trademark Registration of a Domestically Registered Trademark**

(1) Except for trademark registrations resulting from an international application for trademark registration, when the holder of a trademark right registered in the Republic of Korea (referred to in this Article as "a domestically registered trademark") files an international application for trademark registration, the international application is deemed to be filed on the filing date of the domestically registered trademark with respect to the overlapping scope of designated goods if all the following conditions are fulfilled:

- (i) the trademark registered in the International Register resulting from an international application for trademark registration (referred to as an "internationally registered trademark") is identical to the domestically registered trademark;
- (ii) the holder of the internationally registered trademark is identical to the holder of the domestically registered trademark;
- (iii) all the designated goods listed in the domestically registered trademark are included as the designated goods of the internationally registered trademark; and
- (iv) territorial extension under Article 3(3) of the Protocol takes effect after the registration date of the domestically registered trademark:

(2) Where the priority under the Treaty for the application for trademark registration related to the domestically registered trademark under paragraph (1) is recognized, the priority is also recognized for the international application for trademark registration under the same paragraph.

(3) Where the right of a domestically registered trademark is cancelled or extinguished under any of the following subparagraphs, the effect of the

concerned international application for trademark registration under paragraphs (1) and (2) is not recognized within the same scope of the designated goods of the cancelled or extinguished trademark right:

- (i) if a trial decision canceling the trademark registration under Article 73(1)(ii), (iii) and (v) to (ix) has become final; or
- (ii) if a trial for the cancellation of a trademark registration is requested under Articles 73(1)(ii), (iii) and (v) to (ix), and the trademark right has become extinguished due to the expiry of the trademark term or to the abandonment of some of the trademark rights or designated goods after the request date of the cancellation trial.

**Article 86*duodevicies* Special Provisions for the Transfer and Partial Assignment of an Application for Trademark Registration etc.**

(1) For an international application for trademark registration, "except for inheritance or other general succession, are not effective against third parties without recording the change" in Article 12(1) reads "are not effective against third parties without recording the change in the International Bureau".

(2) Where all or some of the designated goods of an international registration have been transferred separately by a change in the ownership of the international registration, each international application for trademark registration is deemed to have been filed by each changed holder of the international registration.

(3) Article 12(4) does not apply to an international application for trademark registration.

**Article 86*undevicies* Special Provisions for Amendments**

(1) For an international application for trademark registration, "the trademark or the list of designated goods in the application for trademark registration" in Article 14(1) reads "the list of designated goods in the application for trademark registration only when the applicant has been notified of the reasons for refusal under Article 23(2)".

(2) For an international application for trademark registration, "designated goods or a specimen, or both" in Article 15 reads "designated goods".

(3) Article 16(1)(iv) does not apply to an international application for trademark registration.

(4) For an international application for trademark registration, "an application for trademark registration or designated goods" in Article 16(2) or (3) reads "the designated goods".

**Article 86*vicies* Special Provision for the Division of Applications**

Article 18 does not apply to an international application for trademark registration.

**Article 86*unvicies* Special Provision for the Conversion of Applications**

Article 19(1) to (4) does not apply to an international application for trademark registration.

**Article 86*duovicies* Special Provision for a Priority Claim under the Paris Convention**

Article 20(4) and (5) does not apply if an applicant of an international application for trademark registration claims priority under the Paris Convention.

**Article 86*tervicies* Special Provision on the Time of Filing an Application**

For an international application for trademark registration, "submit to the Commissioner of the Korean Intellectual Property Office a written statement of intent with the application for trademark registration and, within thirty days of the filing date of the application, a document proving the relevant

facts" in Article 21(2) reads "submit to the Commissioner of the Korean Intellectual Property Office a written statement of intent and a document proving the relevant facts within the period prescribed by ordinance of the Ministry of Commerce, Industry and Energy".

**Article 86*quatervicies* Special Provision for Publication of an Application**

For an international application for trademark registration, "Where an examiner finds no grounds for rejecting an application for trademark registration" in Article 24(1) reads "Where an examiner finds no grounds for rejecting an application for trademark registration within the period prescribed by ordinance of the Ministry of Commerce, Industry and Energy".

**Article 86*quinvicies* Special Provision for the Right to Demand Compensation for Losses**

For an international application for trademark registration, "a copy of the application for trademark registration" in the proviso of Article 24*bis*(1) reads "a copy of the international application".

**Article 86*sevicies* Special Provisions for an Opposition to a Trademark Registration**

For an international application for trademark registration, "serial number of the application for trademark registration" in the proviso of Article 25(2)(ii) reads "international registration number of an international application for trademark registration".

**Article 86*septiesvicies* Special Provisions for a Decision to Register a Trademark**

When applying the proviso of Article 25(2)(ii) to an international application for trademark registration, "cannot find any reasons for refusing an

application for trademark registration" in Article 30 reads "cannot find any reasons for refusing an application for trademark registration within the period prescribed by ordinance of the Ministry of Commerce, Industry and Energy".

**Article 86*duodetricies* Special Provisions for Trademark  
Registration Fees**

(1) A person filing an international application for trademark registration or renewing the term of a registered trademark that has been registered under Article 86*untricies* (referred to as 'a trademark right based on international registration') shall pay the individual fee under Article 8(7)(a) of the Protocol to the International Bureau.

(2) Matters related to paying individual fees under paragraph(1) of this Article are prescribed by ordinance of the Ministry of Commerce, Industry and Energy.

(3) Articles 34 to 36*bis* do not apply to an international application for trademark registration or to a trademark right based on international registration.

**Article 86*undetricies* Special Provision for Refunding Trademark  
Registration Fees etc.**

For an international application for trademark registration, "Trademark registration fees and official fees that have been paid" in the proviso of Article 38(1) reads "official fees that have been paid", and "fees" in the proviso of Article 38(1) and in paragraphs (2) and (3) of Article 38 reads "official fees".

**Article 86*tricies* Special Provisions for Registration in the  
Trademark Register**

(1) For a trademark right based on international registration, "the establishment,

transfer, modification, expiry, renewal of the term, conversion of the classification of goods under Article 46*bis*, supplementary registration of designated goods or restriction on disposal, of a trademark right" in Article 39(1)(i) reads "the establishment or restriction on disposal, of a trademark right".

(2) The transfer, modification, expiry or renewal of the term of a registered trademark based on international registration are based on the registration of the International Register.

**Article 86*untricies* Special Provision for Registering the  
Establishment of a Trademark Right**

For an international application for trademark registration, "When trademark registration fees have been paid in accordance with Article 34(1)" in Article 41(2) reads "When the decision on the registration of the trademark has been made".

**Article 86*duotricies* Special Provisions for the Term of a  
Trademark Right**

(1) The term of a trademark right based on international registration is from the date of registration of its establishment under Article 86*untricies* to the expiry of a ten-year period following the date of the international registration.

(2) The term of a trademark right based on international registration may be renewed for an additional ten-year period upon renewal of the term of the international registration.

(3) Where the term of a trademark right based on international registration is renewed under paragraph (2), it is deemed to have been renewed on the expiry date of the term.

(4) Articles 42 to 46*quinquies*, 49(1) and (2) and 64*bis* do not apply to a trademark right based on international registration.

**Article 86tertricies Special Provision for an Application for  
Supplementary Registration of Designated Goods**

Article 49(3) does not apply to an international application for trademark registration or to a trademark right based on international registration.

**Article 86quatertricies Special Provision for the Division of a  
Trademark Right**

Article 54bis does not apply to a trademark right based on international registration.

**Article 86quintricies Special Provisions for the Effects of a  
Trademark Right**

(1) The transfer, modification, expiry by abandonment or renewal of the term of a registered trademark right based on international registration have no effect unless recorded in the International Register.

(2) Article 56(1)(i) (excluding the part related to the restriction on disposal) does not apply to a trademark right based on international registration.

(3) For a trademark right based on international registration, "a trademark right, exclusive license" in Article 56(2) reads "an exclusive license".

**Article 86setricies Effects of Canceling an International Registration**

(1) Where all or part of an international registration on which an international application for trademark registration is based has been cancelled, the international application for trademark registration is deemed to have been withdrawn for all or some of the designated goods to the extent of which the international registration has been cancelled.

(2) Where all or part of the international registration on which a trademark right based on international registration is based has been cancelled, the trademark right is deemed to have been extinguished for all or some of the

designated goods to the extent of which the international registration has been cancelled.

(3) The effects under paragraphs (1) or (2) enter into force from the date on which the international registration in the International Register has been cancelled.

**Article 86*septies* Special Provisions on Abandoning a Trademark Right**

(1) Article 60(1) does not apply to a trademark right based on international registration.

(2) For a trademark right based on international registration, "a trademark right, an exclusive" under Article 61 reads "an exclusive".

**Article 86*duodequagies* Special Provision on an Invalidation Trial for Renewal of the Term of a Registered Trademark**

Articles 72 and 72*bis* do not apply to a trademark right based on international registration.

**Part III. Special Provisions on an Application for Trademark Registration**

**Article 86*undequagies* Special Provisions on an Application for Trademark Registration after Cancellation of an International Registration**

(1) Where international registration of a trademark that is the subject of an international registration designating (including subsequent designations) the Republic of Korea has been cancelled under Article 6(4) of the Protocol for all or some of the designated goods, the holder of the international registration may file an application for trademark registration with the



Commissioner of the Korean Intellectual Property Office for all or some of the designated goods.

(2) Where an application for trademark registration under paragraph(1) fulfills all the requirements of the following subparagraphs, the application is deemed to have been filed on the date of the international registration (or, for a subsequent designation, the date of the subsequent designation):

- (i) the application under paragraph(1) is filed within three months of the date on which the international registration was cancelled under the same paragraph;
- (ii) the designated goods of the application for the trademark registration under paragraph(1) are covered by the list of the designated goods contained in the international registration under the same paragraph; and
- (iii) the trademark for which trademark registration is sought is identical to the trademark of the cancelled international registration.

(3) Where a right of priority under a treaty is recognized for an international application for trademark registration that is filed for an international registration under paragraph(1), the right of priority is recognized for the application for the trademark registration under the same paragraph.

#### **Article 86<sup>quadrages</sup> Special Provisions on an Application for Trademark Registration after Denunciation of the Protocol**

(1) Where the holder of an international registration designating (including subsequent designation) the Republic of Korea is no longer entitled to file an international application under Article 15(5)(b) of the Protocol, the holder of the international registration may file an application for trademark registration with the Commissioner of the Korean Intellectual Property Office for all or some of the designated goods registered in the International Register.

(2) Article 86<sup>undequadrages</sup>(2) and (3) applies *mutatis mutandis* to an application for trademark registration under paragraph(1). In such cases,

"within three months of the date on which the international registration was cancelled under the same paragraph" under Article 86*undequadragies*(2)(i) reads "within two years of the date on which the denunciation became effective under Article 15(3) of the Protocol".

### **Article 86*unquadragies* Special Provision on Examinations**

Where an application for trademark registration that falls under any of the following subparagraphs (referred to as "a reapplication") is related to a trademark registered under Article 86*untricies*, Articles 23, 24, and 25 to 29 do not apply to the application:

- (i) an application for trademark registration that fulfills the requirements of all the subparagraphs of Article 86*undequadragies* (2) and is filed in accordance with Article 86*undequadragies*(1); or
- (ii) an application for trademark registration that fulfills the requirements of all the subparagraphs of Article 86*undequadragies* (2), which applies *mutatis mutandis* under Article 86*quadragies*(2) and is filed in accordance with Article 86*quadragies*(1).

### **Article 86*duoquadragies* Special Provision on the Statute of Limitation**

Where a trademark has been registered as a result of a reapplication and the statute of limitations under Article 76(1) for the previous trademark right based on international registration has lapsed, an invalidation trial against the trademark that was registered as a result of the reapplication may not be requested.