

**Document on grounds for refusal of trademarks**

**12. FEB, 2009**

**KOREAN INTELLECTUAL PROPERTY OFFICE**

## . **GROUND OF REFUSAL OF TRADEMARKS**

Following formal examination, the examining attorney examines whether the application meets substantive requirements. The examining attorney must deny the application for trademark registration if any of the following grounds for refusal has been met (the main clause of Art. 23 (1) of the Act), or render a decision to publish the application in the Gazette if none of the grounds for refusal are met (Art. 24 (1) of the Act).

The Act provides for grounds for refusal as in the following limited enumeration:

where any member of KIPO seeks to obtain or has obtained a trademark registration except by inheritance or bequest (the provision of Art. 3 of the Act);

where the requirements for trademark registration are not met (Art. 6 of the Act);

### **Article 6 Requirements for Trademark Registration**

(1) Trademark registration may be obtained except in any of the following cases:

- (i) where the mark consists solely of a sign indicating, in a common way, the usual name of the goods;
- (ii) where the mark is customarily used on the goods;
- (iii) where the mark consists solely of a sign indicating, in a common way, the origin, quality, raw materials, efficacy, use, quantity, shape (including the shape of the packaging) or price of the goods, or the method or time of manufacturing, processing or using them;
- (iv) where the mark consists solely of a sign indicating a conspicuous geographical name, an abbreviation of a conspicuous geographical name or a map;
- (v) where the mark consists solely of a sign indicating, in a common way, a common surname or name of a legal entity;
- (vi) where the mark consists solely of a very simple and commonplace sign; or
- (vii) in addition to the cases mentioned in subparagraphs (i) to (vi) of this Article, where the mark does not enable consumers to recognize the person whose goods are indicated by the mark.

(2) Even if a trademark that falls under paragraphs (1)(iii) to (vi) of this Article, where, as a result of using the trademark before the application for registration under Article

9 of this Act, consumers are easily able to recognize the person whose goods are indicated by the trademark, the trademark may be registered with the designated goods for which the trademark has been used; the same applies to designated goods and supplementary designated goods as defined in Articles 10(1) and 47(2)(iii) of this Act.

(3) Notwithstanding marks that are subject to paragraph (1)(iii) of this Article (which is limited to the producing area) or paragraph (1)(iv) of this Article, whenever a mark is used as a geographical indication on specific goods, a collective mark for a geographical indication may be registered for designated goods that use the geographical indication

(□) where the trademark is unregistrable (Art. 7 of the Act);

#### **Article 7 Unregistrable Trademarks**

(1) Notwithstanding Article 6, trademark registration may not be obtained in any of the following cases:

- (i) trademarks that are identical or similar to the following: the national flag, the national emblem, as well as colors, medals, decorations or badges of the Republic of Korea; the national flags or emblems of foreign nations; the medals, decorations or badges of the countries party to the Paris Convention for the Protection of Intellectual Property (referred to as "the Paris Convention") or of the members of the World Trade Organization or of the contracting parties to the Trademark Law Treaty; the titles or marks of the Red Cross, Olympic organizations or well-known international organizations; titles or marks that are identical or similar to seals or signs of the Republic of Korea, or of the countries party to the Paris Convention, the members of the World Trade Organization, the contracting parties to the Trademark Law Treaty or the public organizations of these that are used for indicating supervision or certification;
- (ii) trademarks that falsely indicate a connection with, or that criticize, insult or are liable to defame, any nation, race, ethnic group, public organization, religion or well-known deceased person;
- (iii) trademarks that are identical or similar to well-known marks that indicate a nonprofit business of a State, a public organization or its agencies or public corporations, or a nonprofit public service; however, this provision does not apply where a nonprofit business of a State, a public organization or its agencies or public corporations, or a nonprofit public service apply to register such marks as their business emblems;
- (iv) a trademark itself or, when used in goods, a trademark whose meaning and details are perceived by users as being liable to contravene public order or morality;
- (v) trademarks comprising a mark that is identical or similar to a medal, certificate of merit or decoration awarded at an exhibition held by or with the authorization of

- the Government of the Republic of Korea or at an exhibition held by or with the authorization of the government of a foreign country, unless a person who has been awarded a medal, certificate of merit or decoration has used it as part of the trademark on the same goods for which the medal, certificate of merit or decoration was awarded at the exhibition;
- (vi) trademarks containing the name, title or trade name, portrait, signature or seal, famous pseudonym, professional name or pen name of well-known persons, or an abbreviation of these, unless the consent of the person concerned has been obtained;
- (vii) trademarks that are identical or similar to another person's registered trademark (excluding a registered collective mark for a geographical indication) when the registration was applied for before the filing date of the trademark applications concerned and when the trademarks are to be used on goods identical or similar to the designated goods;
- (vii*bis*) trademarks that are identical or similar to another person's registered collective mark for a geographical indication when the registration was applied for before the filing date of the trademark applications concerned and when the trademarks are to be used on goods identical or similar to the designated goods;
- (viii) trademarks that are identical or similar to another person's registered trademark (excluding a registered collective mark for a geographical indication) when not more than a year has elapsed since the date on which the trademark right expired (that is, the date on which a trial decision became final for a trial decision invalidating a trademark registration) and when the trademarks are to be used on goods that are identical or similar to the designated goods;
- (viii*bis*) trademarks that are identical or similar to another person's registered collective mark for a geographical indication when not more than a year has elapsed since the date on which the registered collective mark for a geographical indication right expired (or the date on which a trial decision became final for a trial decision invalidating a collective mark for a geographical indication) and when the trademarks are to be used on goods identical to the designated goods;
- (ix) trademarks that are identical or similar to another person's trademark when that other person's trademark (excluding a geographical indication) is well known among consumers to indicate or resemble the other person's goods, and when the trademarks are to be used on goods that are identical or similar to such goods;
- (ix*bis*) trademarks that are identical or similar to another person's geographical indication when that other person's geographical indication is well known among consumers to indicate or resemble a certain region's goods and when the trademarks are to be used on goods that are identical or similar to such goods;

- (x) trademarks that are liable to cause confusion with the goods or services of another person because consumers easily recognize the trademark as designating the goods or services of the other person;
  - (xi) trademarks that are liable to mislead or deceive consumers on the quality of the goods;
  - (xii) trademarks that are identical or similar to a trademark (excluding a geographical indication) that consumers inside or outside the Republic of Korea easily recognize as indicating the goods of a particular person, and which are used to obtain unjust profits or to inflict harm on a particular person and so on;
  - (xii*bis*) trademarks that are identical or similar to a geographical indication that consumers inside or outside the Republic of Korea easily recognize as indicating the goods of a certain region, and which are used to obtain unjust profits or to inflict harm on a legitimate users of the geographical indication and so on;
  - (xiii) trademarks that consist solely of three-dimensional shapes that are essential for securing the functions of goods, or their packagings, that require trademark registration; or
  - (xiv) trademarks that consist of a geographical indication or include a geographical indication of the origin of wines or spirits in a member state of the World Trade Organization, and which are used for wines, spirits or other similar goods. However, this provision does not apply if a legitimate user of a geographical indication applies to register a collective mark for a geographical indication under Article 9(3) of this Act and the relevant goods are the designated goods.
- (2) Where a trademark falls under paragraphs (1)(vi), (ix), (ix*bis*) and (x) of this Article, the respective provisions do not apply if the trademark does not fall under the respective subparagraphs when the applicant applies for trademark registration (however, the matter of whether the applicant for trademark registration pertains to another person under the provisions of paragraphs (1)(vi), (ix), (ix *bis*) and (x) of this Article is excluded from all the matters in those provisions).
- (3) Where a trademark falls under paragraph (1)(vii), (vii*bis*), (viii) and (viii*bis*) of this Article, the respective provisions apply if the trademark falls under the respective subparagraphs when the applicant applies for trademark registration (or if the registered trademark of another person is invalidated under Article 71(3) of this Act); however, the matter of whether the applicant for trademark registration (referred to as "the applicant") pertains to another person in the relevant subparagraphs is not determined on the basis of whether the applicant pertains to another person in the relevant subparagraphs when the applicant applies for the trademark registration.
- (4) Paragraphs (1)(viii) and (viii*bis*) of this Article do not apply to the following cases:
- (i) where the registered trademark has not been used for more than one year retroactively

- from the date on which the trademark right was extinguished;
- (ii) where a rightful applicant applies to register the trademark, after a decision on invalidation or revocation becomes final because the registered trademark violates paragraphs (1)(vi), (ix), (*ixbis*), (x), (xii) and (*xii bis*) of this Article or Articles 8 or 73(1)(vii) of this Act; or
  - (iii) where an applicant applies to register the trademark after the period of six months as prescribed in Article 43(2) of this Act has elapsed without applying to renew the term of the registered trademark.
- (5) Where a trial for the cancellation of a trademark registration is requested under Article 73(1)(ii), (iii), and (v) to (xii) of this Act, and where any of the following subparagraphs occurs after the date of requesting the cancellation trial, the owner of the trademark right and any person using the trademark may not obtain trademark registration for a trademark that is identical or similar to a registered trademark extinguished with respect to goods (the collective mark for geographical indication is limited to an identical goods) that are identical or similar to the designated goods of the extinguished registered trademark, unless three years have elapsed since the day on which each of the following subparagraphs occurs:
- (i) where the trademark right has been extinguished because the term has expired;
  - (ii) where a person with the trademark right abandons the trademark right or some of the designated goods;
  - (iii) where the trial decision on the cancellation of a trademark registration has become final;
  - (iv) where a person requesting a cancellation trial files an application for trademark registration under Articles 8(5) and 8(6) of this Act; or
  - (v) where, under any subparagraph of Article 8(5), an application for trademark registration is filed after the expiry of the period in which a person requesting a cancellation trial may obtain a trademark registration under Article 8(5).
- (6) Paragraph (1)(*vii bis*) (*viii bis*) and (*ix bis*) may not be applicable between the collective marks for homonymous geographical indication.

(□) where the first-to-file principle is violated (Art. 8 of the Act);

**Article 8 First-to-File Rule**

- (1) Where two or more applications for trademark registration related to identical or similar trademarks that are to be used on identical or similar goods are filed on different dates, only the applicant filing the application with the earlier filing date may obtain trademark registration for the trademark.

- (2) Where two or more applications for trademark registration related to identical or similar trademarks that are to be used on identical or similar goods are filed on the same date, a consultation will be held among all the applicants and the person agreed upon by all the applicants may obtain trademark registration for the trademark. If no agreement is reached or no consultation is possible, the trademark registration may be obtained only by the applicant chosen by a lottery conducted by the Commissioner of the Korean Intellectual Property Office.
- (3) Where an application for trademark registration has been abandoned, withdrawn or invalidated, or where an examiner's decision or trial decision to refuse trademark registration has become final, the application, for the purposes of paragraphs (1) and (2) of this Article, is deemed never to have been filed.
- (4) In cases under paragraph (2) of this Article, the Commissioner of the Korean Intellectual Property Office shall instruct the applicants to give notice of any agreement they reach and to report the terms of their agreement. If they do not submit a report within the designated period, the applicants are deemed not to have reached an agreement within the meaning of paragraph (2) of this Article.
- (5) Where a trial for the cancellation of a registered trademark is requested under Article 73(1)(iii) of this Act and where each of the following subparagraphs occurs after the day on which the cancellation trial is requested, only the person requesting the cancellation trial may obtain trademark registration for the trademark that is identical or similar to the registered trademark that has been extinguished because of goods that are identical or similar to the designated goods of the registered trademark that has been extinguished for a period of six months after the date on which each of the following subparagraphs occurs (however, in the case of subparagraph (iii) of this Act, when a lawsuit is instituted in relation to a trial decision that cancels a trademark registration and the trial decision consequently becomes final as a result of the withdrawal of a lawsuit or appeal, the six month period of extinguishment begins on the date of the withdrawal of the lawsuit or appeal):
- (i) when the period under Article 43(2) of this Act expires;
  - (ii) when a person with the trademark right abandons the trademark right or some of the designated goods; or
  - (iii) when the trial decision on the cancellation of a trademark registration has become final.
- (6) Where a trial for the cancellation of a registered trademark is requested under Article 73(1)(iii) of this Act, and where an application for trademark registration that falls under either of the following subparagraphs is filed after the date of the request, only the person who requested the cancellation trial may obtain a trademark registration:
- (i) where a registered trademark for which a cancellation trial has been requested is extinguished due to the expiry of the term of the trademark right and where an application

to register a trademark which is identical or similar to the extinguished trademark and which is to be used for goods that are identical or similar to the designated goods is filed during the period stipulated in the proviso of Article 43(2); or

(ii) Where a lawsuit is instituted against a trial decision to cancel a registered trademark and the trial decision subsequently becomes final as a result of a withdrawal of the lawsuit or an appeal to a higher court, and where the registered trademark for which a cancellation trial is requested is extinguished accordingly, and where an application to register a trademark that is identical or similar to the extinguished trademark and intended for use on goods that are identical or similar to the designated goods is filed during the period from the date on which the trial decision becomes final to the date on which the lawsuit or appeal is withdrawn.

(7) Paragraphs (1) and (2) of this Article do not apply in either of the following cases:

(i) where two or more applications to register a collective mark for a geographical indication, or where an application to register a collective mark and an application to register a trademark for a geographical indication, are filed for identical or similar marks intended for use on nonidentical goods; or

(ii) where two or more applications to register a collective mark for a geographical indication are filed for marks that are homonymous geographical indications.

(8) Paragraph (5) of this Article does not apply in either of the following cases:

(i) where the goods referred to in an application to register a trademark are not identical to the designated goods and the mark in the application is similar or identical to the expired collective mark for a geographical indication; or

(ii) where the mark in an application to register a collective mark for a geographical indication is applicable to a collective mark for a geographical indication with an lapsed registration and a homonymous collective mark for a geographical indication.

(□) where the application is contrary to the principle of “one trademark per application” (Art. 10 of the Act);

#### **Article 10 A Single Application for a Single Trademark**

(1) A person seeking to register a trademark shall designate one or more classes of goods for the classification of goods prescribed by ordinance of the Ministry of Commerce, Industry and Energy, and file an application for each trademark. In such cases, the person may designate goods and services in a single application as prescribed by ordinance of the Ministry of Commerce, Industry and Energy.

(□) where identical designated goods are not transferred *en bloc* by a divisional transfer



of a trademark registration (the latter part of Art. 12 (2) of the Act); any fractional ownership of a jointly owned trademark application is transferred without the consent of all other joint owners (Art. 12 (5) of the Act); any business emblem is transferred (Art. 12 (7) of the Act); any nonprofit mark under the provision of the proviso of Article 7 (1) 3 of the Act is transferred (Art. 12 (8) of the Act); or any collective mark is transferred (Art. 12 (9) of the Act);

**Article 12 Transfer and Partial Assignment of an Application for Trademark Registration etc.**

- (2) An application for trademark registration may be transferred separately for each of the goods designated in the application. In this case, designated goods that are similar must be transferred together.
- (5) Where an application for trademark registration is jointly owned, the owners may not transfer their individual share without the consent of the other owners.
- (7) An application to register a business emblem may not be transferred unless the business emblem is transferred with the business.
- (8) An application for trademark registration under Article 7(1)(iii) may be transferred only with a business related to the mark referred to in the main sentence of that Article.
- (9) An application to register a collective mark may not be transferred. However, for the merger of legal entities, the application may be transferred with the authorization of the Commissioner of the Korean Intellectual Property Office.

(□) where the applicant is a foreign national and thus not entitled to a trademark registration (Art. 5 of the Act; Art. 25 of the Patent Act *mutatis mutandis*).

**Article 25 Capacity of Foreigners (the Patent Act)**

Foreigners who have neither a residential nor business address in the Republic of Korea are not entitled to enjoy patent rights or other patent-related rights, except under any of the following circumstances:

- (i) where their country allows nationals of the Republic of Korea to enjoy patent rights or other patent-related rights under the same conditions as its own nationals;
- (ii) where their country allows nationals of the Republic of Korea to enjoy patent rights or other patent-related rights under the same conditions as its own nationals when the Republic of Korea allows their country's nationals to enjoy patent rights or other patent-related rights; or
- (iii) where they may enjoy patent rights or other patent-related rights according to a treaty or the equivalent of a treaty (referred to as "a treaty").

- (□) where the application is in violation of any provision of any treaty (Art. 23 (1) 2 of the Act);
- (□) where any person who is or was within one year prior to filing an attorney-in-fact or representative of a holder of a trademark registered with a Contracting Party, applies for the registration of said mark or a mark similar thereto in relation to goods identical or similar to the designated goods of said mark without the consent of said holder or any other just cause (only if said holder files an opposition or information has been provided under Article 22 (3) of the Act) (Art. 23 (1) 3 of the Act);

**Article 22 Examination by Examiner**

- (3) Any person whose application for trademark registration falls within any subparagraph of Article 23(1) may submit to the Commissioner of the Korean Intellectual Property Office relevant information with supporting evidence.

- (□) where the mark meets none of the definitions of trademark, service mark, collective mark and business emblem; or the geographical indication or collective mark component in the geographical collective mark for which registration is sought does not meet the definitions of geographical indication and geographical collective mark under the provisions of Articles 2 (1)(iii*bis*) and 2 (1) (iii*quarter*) of the Act (Art. 23 (1) 4 of the Act);

**Article 2 Definitions**

- (1) The definitions of terms used in this Act are as follows:
- (i) "trademark" is defined as either of the following (referred to as "a mark") that is used on goods related to the business of a person who conducts business activities, such as producing, processing, certifying or selling such goods, to distinguish them from the goods of others;
    - (a) a sign, a character, a figure, a three-dimensional shape or any combination of these; or
    - (b) other visually recognizable constructs;
  - (ii) "service mark" means a mark used by a person who conducts a service business to distinguish the service business from the service businesses of others;
  - (iii) "collective mark" means a mark intended to be used by a legal entity founded in association with a person who conducts business activities such as producing, manufacturing, processing, certifying or selling goods and with a person who conducts a service business; members of the legal entity can use the mark for their goods and services;
  - (iii*bis*) "geographical indication" means an indication that identifies a good as originating

in a certain region where a given quality, reputation or other characteristic of the good is essentially attributable to that region;

(iii~~ter~~) "homonymous geographical indication" means a geographical indication that has the same pronunciation as another geographical indication on the same type of goods, but which refers to a different geographical region;

(iii~~quarter~~) "collective mark for a geographical indication" means a collective mark intended to be used by a legal entity composed solely of persons who conduct business activities such as producing, manufacturing, processing, or selling goods; members of the legal entity can use the collective mark for their goods;

(iv) "business emblem" means a mark used by a person conducting a nonprofit business to indicate the person's business;

(□) where, in the case of an application for a geographical collective mark filed by a corporation, any person engaged in the production, manufacturing or processing of such goods as may bear the geographical indication, is prohibited from joining the collective organization under its articles of incorporation; the articles of incorporation provides for such entry requirements as may render it difficult for such person to join; or such person is otherwise effectively discouraged from joining (Art. 23 (1) 5 of the Act); and

(□) the articles of incorporation under the provisions of Article 9 (3) of the Act lack the provisions for the use of a collective mark as prescribed by the Presidential Decree (Art. 23 (1) 6 of the Act).

#### **Article 9 Application for Trademark Registration**

(1) A person seeking to register a trademark shall file an application with the Commissioner of the Korean Intellectual Property Office, stating the following:

(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) the trademark;

(iv) the list of designated goods and the class of goods;

(v) the matters prescribed under Article 20(3) (only when claiming a priority right);

(vi) deleted;

(vii) the matters prescribed by ordinance of the Ministry of Commerce, Industry and Energy.

(3) A person seeking to register a collective mark shall file an application to register a collective mark stating the matters mentioned in the subparagraphs of paragraph (1) of this Article accompanied by the articles of association that govern the use of the collective mark, as prescribed by Presidential Decree. If the person is seeking to register the collective mark for a geographical indication under Article 2(1)(iii~~quater~~) of this Act, the person shall describe the purpose of the collective mark in the application and submit the application along with documentary evidence that the mark complies with the definition of a geographical indication under Article 2(1)(iii~~bis~~) of this Act.

## < GENERAL PROCEDURES OF TRADEMARKS APPLICATIONS IN REPUBLIC OF KOREA >

